

# St. John's Law Review

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Volume 19  
Number 2 *Volume 19, April 1945, Number 2*

Article 2

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July 2013

## Copyright--Co-Owners

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### Recommended Citation

Kupferman, Theodore R. (1945) "Copyright--Co-Owners," *St. John's Law Review*. Vol. 19 : No. 2 , Article 2.  
Available at: <https://scholarship.law.stjohns.edu/lawreview/vol19/iss2/2>

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## COPYRIGHT—CO-OWNERS

**T**HE rights and obligations of co-owners *inter se* as well as in relation, jointly and severally, to their assigns and licensees, is a current problem in copyright.<sup>1</sup>

Co-ownership of copyright exists when there are two or more undivided interests in the copyright or the subject matter thereof. Although in the cases the terms joint owner, joint tenant, co-owner and co-tenant are variously used, the interest is considered a tenancy in common<sup>2</sup> rather than a joint tenancy<sup>3</sup> and there is no survivorship right.<sup>4</sup>

As stated in *Halsbury*<sup>5</sup>, the English rule seems to be that: "Joint authors are in the position of tenants in common and not of joint tenants." *Powell v. Head*<sup>6</sup> is cited for this

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<sup>1</sup> Recent cases dealing with the problem in some or more of its phases are: *Meredith v. Smith*, 145 F. (2d) 620 (C. C. A. 9th, 1944); *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F. (2d) 266; same, 140 F. (2d) 268; same, 140 F. (2d) 270 (C. C. A. 2d, 1944); *Piantadosi v. Loew's, Inc.*, 137 F. (2d) 534 (C. C. A. 9th, 1943); *Crosney v. Edward Small Productions*, 52 F. Supp. 559 (S. D. N. Y. 1942); *Brown v. Republic Productions*, 156 P. (2d) 40; same, 156 P. (2d) 42 (Cal. App. 1945).

<sup>2</sup> *Silverman v. Sunrise Pictures Corp.*, 273 Fed. 909 (C. C. A. 2d, 1921), *cert. denied*, 262 U. S. 758 (1923); *Klein v. Beach*, 232 Fed. 240 (S. D. N. Y. 1916), *aff'd*, 239 Fed. 108 (C. C. A. 2d, 1917); *Stuff v. La Budde Feed & Grain Co.*, 42 F. Supp. 493 (E. D. Wis. 1941); *Brown v. Republic Productions*, 156 P. (2d) 40; same, 156 P. (2d) 42 (Cal. App. 1945); *Carter v. Bailey*, 64 Me. 458 (1874); *Dunham v. Indianapolis & St. L. R. Co.*, 8 Fed. Cas. 44, No. 4151 (C. C. N. D. Ill. 1876) (patent case); see *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 42 F. Supp. 859, 865 (S. D. N. Y. 1942), *aff'd*, 140 F. (2d) 266 (C. C. A. 2d, 1944); *Lauri v. Renad*, [1892] 3 Chan. 402, 412-413; *AMDUR, COPYRIGHT LAW AND PRACTICE* (1936) 616; *COPINGER, LAW OF COPYRIGHT* (7th ed. 1936) 191; *FOX, CANADIAN LAW OF COPYRIGHT* (1944) 256; 7 *HALSBURY, LAWS OF ENGLAND* (2d ed. 1932) § 858; *HOWELL, THE COPYRIGHT LAW* (1942) 51; *WEILL, COPYRIGHT LAW* (1917) 547.

<sup>3</sup> Nowadays the law favors tenancy in common rather than joint tenancy. 2 *TIFFANY, REAL PROPERTY* (3d ed. 1939) § 421.

Some states have statutes requiring that the interest be construed a tenancy in common unless the instrument of conveyance or devise states expressly that it is to be joint, e.g., *NEW YORK REAL PROPERTY LAW* § 66. This New York statute has been interpreted as applying to personality as well as realty. *Page v. Hoxie*, 104 F. (2d) 918 (C. C. A. 1st, 1939).

<sup>4</sup> *Stuff v. La Budde Feed & Grain Co.*, 42 F. Supp. 493 (E. D. Wis. 1941); see *Lauri v. Renad*, [1892] 3 Chan. 402, 412-413; *COPINGER, LAW OF COPYRIGHT* (7th ed. 1936) 191; *SHAFTER, MUSICAL COPYRIGHT* (2d ed. 1939) 170. *But see Marzials v. Gibbons*, 30 L. T. 666, 667 (Chan. 1874); *Levy v. Rutley*, L. R. 6 C. P. 523, 531 (1871). In the *Stuff* case, *supra*, the court found nothing to show a joint estate or words of survivorship in the copyright notice, which was in the names of two people, or in the copyright certificate. If there had been such indicia, the result might have been different.

<sup>5</sup> *Op. cit. supra* note 2.

<sup>6</sup> 12 Ch. D. 686 (1879).

proposition. There, Sir George Jessel, M. R., stated:

In this case you have two assignees, two ladies who became assignees of this opera, or the right of representing it at different times, and therefore they were strictly tenants in common or part-owners of the right of representation, . . .<sup>7</sup>

Obviously, this dictum was a determination based on the absence of the joint tenancy requirement of *unity of time*,<sup>8</sup> and was not an absolute finding in favor of a tenancy in common in copyright co-ownership cases. Yet the lower court in the later case of *Lauri v. Renad*<sup>9</sup> decided the matter had been foreclosed.

#### OWNERSHIP IN COMMON

Co-ownership of copyright or literary property can arise in the following ways and with legal and equitable interests:

(1) From the production by two or more authors of a joint work. We have such a joint work not only when there is a pre-existing common design and a fused finished product,<sup>10</sup> but when it is intended that each of independently created and separable contributions be ". . . enjoyed and performed together; unlike the parts of a 'composite work', each of which is intended to be used separately, and whose only unity is that they are bound together."<sup>11</sup> Concerted action in production plus interdependence of finished product, or mere purpose of the authors, either can be determinative of a joint work.

<sup>7</sup> *Id.* at 689.

<sup>8</sup> A joint tenancy requires four unities, *i.e.*, unity of interest, title, time and possession. This means that the interest must be the same and equal, accrue by the same conveyance or have a common inception, commence at the same time, and be held by undivided possession. 2 TIFFANY, REAL PROPERTY (3d ed. 1939) § 418.

<sup>9</sup> See *Lauri v. Renad*, [1892] 3 Chan. 402, 412-413.

<sup>10</sup> *Maurel v. Smith*, 271 Fed. 211 (C. C. A. 2d, 1921); see Kupferman, *Renewal of Copyright—Section 23 of the Copyright Act of 1909* (1944) 44 COL. L. REV. 712, 732.

It might be well here to cite the lower court opinion in the *Maurel* case, 220 Fed. 195 (S. D. N. Y. 1915), as Learned Hand, J., is fond of his opinion there. See *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F. (2d) 266, 267 (C. C. A. 2d, 1944).

<sup>11</sup> See *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F. (2d) 266, 267 (C. C. A. 2d, 1944). Cf. COPYRIGHT ACT, 1911, 1 & 2 Geo. V, c. 46, § 16(3): "For the purposes of this Act, 'a work of joint authorship' means a work produced by the collaboration of two or more authors in which the contribution of one author is not distinct from the contribution of the other author or authors."

A composite work,<sup>12</sup> e.g., a periodical or a cyclopedia, contains distinguishable portions, but may be copyrighted separately or *in toto*. The authors of the portions do not have a moiety of the whole, but only rights solely in their individual works; there is no ownership in common.

There is no ownership in common where one person originates the idea and the other embodies it.<sup>13</sup> The one who gives it concrete written form is the sole owner.<sup>14</sup> Similarly, there is no ownership in common in the whole for the person who suggests<sup>15</sup> or makes slight changes in someone else's work.<sup>16</sup>

Difficulties sometimes arise, where statutory copyright is involved, on the question of co-ownership when one who may not be an author or co-author, is given credit to that effect on the published work or on the certificate of copyright registration. It has been held that if one gives another authorship credit on the published work, he may be estopped from later denying the other's interest.<sup>17</sup> It has also been held that certificates of copyright registration,<sup>18</sup> for works

<sup>12</sup> See *Harris v. Coca-Cola Co.*, 73 F. (2d) 370, 371 (C. C. A. 5th, 1934), cert. denied, 294 U. S. 709 (1935); *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F. (2d) 266, 267; same, 140 F. (2d) 268, 269 (C. C. A. 2d, 1944).

<sup>13</sup> *Tate v. Thomas*, [1921] 1 Ch. D. 503; *Bagge v. Miller*, Mac G. Cop. Cas. (1917-23) 179 (Ch. D. 1920); see *Tate v. Fullbrook*, [1908] 1 K. B. 821, 826 (C. A.); *Fox*, *op. cit. supra* note 2, at 252; 7 HALSBURY, *loc. cit. supra* note 2.

<sup>14</sup> Of course, the originator of the idea may at the same time be employing the author, and therefore, in the absence of an agreement to the contrary, entitled to authorship and ownership by virtue of being "... an employer ... for hire." 35 STAT. 1070 (1909), 17 U. S. C. §62 (1940). *Von Tilzer v. Jerry Vogel Music Co.*, 53 F. Supp. 191 (S. D. N. Y. 1943); see *HOWELL*, *op. cit. supra* note 2, at 52.

<sup>15</sup> *Marx v. United States*, 96 F. (2d) 204 (C. C. A. 9th, 1938).

<sup>16</sup> *Levy v. Rutley*, L. R. 6 C. P. 523 (1871); see 7 HALSBURY, *loc. cit. supra* note 2. But see *G. Ricordi & Co. v. Columbia Gramophone Co.*, 258 Fed. 72, 75 (S. D. N. Y. 1919), appeal dismissed, 263 Fed. 354 (C. C. A. 2d, 1920). Cf. *Maurel v. Smith*, 220 Fed. 195, 199 (D. C. N. Y. 1915), *aff'd*, 271 Fed. 211 (C. C. A. 2d, 1921). These "accessions" are said to adhere to the original work and become the property of the owner thereof. *Keene v. Wheatley*, 14 Fed. Cas. 180, No. 7, 644 (C. C. E. D. Pa. 1861); see *AMDUR*, *op. cit. supra* note 2, at 618. If the person making the changes collaborates on such changes with the author of the original, he may possibly be considered a joint owner. See *Levy v. Rutley*, *supra*, at 529, 530; cf. *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F. (2d) 266, 268 (C. C. A. 2d, 1944).

<sup>17</sup> See *Kupferman*, *supra* note 10, at 731 and cases cited therein at note 114.

<sup>18</sup> Copyright under the modern act is secured by publication plus notice and nothing further is required. 35 STAT. 1070 (1909), 17 U. S. C. §9 (1940); see *Washingtonian Publishing Co., Inc. v. Pearson*, 306 U. S. 30, 37 (1939),

copyrighted after July 1st, 1909,<sup>19</sup> are *prima facie* evidence of the facts stated therein.<sup>20</sup> Recently, the question was presented as to which of these two rules would take precedence. Plaintiff's assignee registered a song for copyright claiming exclusive authorship, at the same time filing the necessary printed copies of the composition, recognizing thereon another as a co-author. The district court gave the copyright certificate its evidentiary weight and held that this was not overcome by the admission on the printed copy. The circuit court<sup>21</sup> affirmed, not being persuaded that the lower court finding was "clearly wrong".

(2) From the inheritance by two or more persons, either by will or intestate succession, of undivided shares in a copyright or in unpublished literary property owned by the decedent.

(3) From the succession of spouse and children or next of kin to the renewal right as provided for in Sections 23 and 24 of the Copyright Act of 1909.<sup>22</sup> If the author does not survive to apply for renewal in the twenty-eighth year of the statutory copyright, then his widow or children may apply,

*rehearing denied*, 306 U. S. 668 (1939). However, no action may be maintained for infringement until the work has been registered. 38 STAT. 311 (1915), 17 U. S. C. § 12 (1940).

<sup>19</sup> Before the passage of the Copyright Act of 1909, the certificate had no such effect. *Bosselman v. Richardson*, 174 Fed. 622 (C. C. A. 2d, 1909); *Saake v. Lederer*, 174 Fed. 135 (C. C. A. 3d, 1909); see *Jerry Vogel Music Co. v. Forster Music Publisher*, 147 F. (2d) 614, 615 (C. C. A. 2d, 1945).

<sup>20</sup> See note 17 *supra*.

Compare the following provision from the English Act: "if a name purporting to be that of the author of the work is printed or otherwise indicated thereon in the usual manner, the person whose name is so printed or indicated shall, unless the contrary is proved, be presumed to be the author of the work"; COPYRIGHT ACT, 1911, 1 & 2 Geo. V, c. 46, § 6(3)(a). In *Bagge v. Miller* it was held that the facts of the case negated this statutory presumption. *Mac G. Cop. Cas.* (1917-23) 179 (Ch. D. 1920).

<sup>21</sup> *Jerry Vogel Music Co. v. Forster Music Publisher*, 147 F. (2d) 614 (C. C. A. 2d, 1945).

This case also held, construing the "Dead Man Statute" [N. Y. C. P. A. § 347], that, when one of the purported co-authors is dead and no testimony is offered on behalf of the deceased with reference to his transactions or communications with the other, the testimony of the living party as to communications or transactions between them is not admissible. The registration certificate was not considered to be testimony on behalf of the deceased as to the transaction.

<sup>22</sup> 35 STAT. 1075 (1909), 17 U. S. C. § 23 (Supp. 1943), 17 U. S. C. § 24 (1940).

taking as tenants in common.<sup>23</sup> In the event of the non-existence of the other applicants provided for, the next of kin as a class may secure the renewal.<sup>24</sup>

(4) From the assignment of an undivided portion of the entire copyright or one of the statutory divisions thereof.<sup>25</sup> The assignee must receive an undivided share, no matter how small, of a whole right. Receiving less is a license and not an assignment.<sup>26</sup>

The interest of the co-owner can be equitable.<sup>27</sup> This may occur when the court finds a constructive trust as in the case where a co-owner copyrights in his own name either with permission<sup>28</sup> or in an effort to derogate from the rights of the other co-tenant,<sup>29</sup> or when one co-author renews and the court finds he holds the legal title for the benefit of himself and his co-author or the latter's successors in interest.<sup>30</sup> In

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<sup>23</sup> See Kupferman, *Renewal of Copyright—Section 23 of the Copyright Act of 1909* (1944) 44 COL. L. REV. 712, 717. The Regulations of the Copyright Office place them all in one category. C. II, tit. 37, C. F. R. § 201.24(2).

<sup>24</sup> *Silverman v. Sunrise Pictures Corp.*, 273 Fed. 909 (C. C. A. 2d, 1921); same, 290 Fed. 804 (C. C. A. 2d, 1923), *cert. denied*, 262 U. S. 758 (1923).

<sup>25</sup> A right to royalties does not make you a co-owner. An author who transfers his copyright subject to royalties based on a percentage of the income from the copyright retains no right in the copyright itself. *Rude v. Wescott*, 130 U. S. 152 (1889) (patent case); *Stringfield v. Warner Brothers Pictures, Inc.*, 51 F. Supp. 746 (S. D. N. Y. 1943); *Krieger v. McFadden Publications*, 43 F. Supp. 170 (S. D. N. Y. 1941); *Ehrlich v. Mills, Inc.*, 215 App. Div. 116, 213 N. Y. Supp. 395 (1st Dep't 1926), *aff'd without opinion*, 248 N. Y. 598, 162 N. E. 539 (1928). However, the copyright may be subject to a lien in the nature of an equitable servitude where the author would otherwise be deprived of even his right to royalties. *In re Waterson, Berlin & Snyder Co.*, 48 F. (2d) 704 (C. C. A. 2d, 1931).

<sup>26</sup> *Egner v. Schirmer Music Co.*, 139 F. (2d) 398 (C. C. A. 1st, 1943), *cert. denied*, 322 U. S. 730 (1944); *Public Ledger v. New York Times*, 275 Fed. 562 (S. D. N. Y. 1921), *aff'd per curiam*, 279 Fed. 747 (C. C. A. 2d, 1922), *cert. denied*, 258 U. S. 627 (1922); *New Fiction Pub. Co. v. Star Co.*, 220 Fed. 994 (S. D. N. Y. 1915); see *Goldsmith v. Comm'r of Internal Revenue*, 143 F. (2d) 446, 467 (C. C. A. 2d, 1944); *Widenski v. Shapiro, Bernstein & Co.*, 147 F. (2d) 909, 910 (C. C. A. 1st, 1945); cf. XII-2 CUM. BULL. 134 (1933).

<sup>27</sup> See *Silverman v. Sunrise Pictures Corp.*, 273 Fed. 909, 914 (C. C. A. 2d, 1921), *cert. denied*, 262 U. S. 758 (1923); *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 42 F. Supp. 859, 865 (S. D. N. Y. 1942), *aff'd*, 140 F. (2d) 266 (C. C. A. 2d, 1944).

<sup>28</sup> See *Quinn-Brown Pub. Corp. v. Chilton Co.*, 15 F. Supp. 213, 214 (S. D. N. Y. 1936).

<sup>29</sup> *Maurel v. Smith*, 271 Fed. 211 (C. C. A. 2d, 1921); cf. *Bisel v. Ladner*, 1 F. (2d) 436 (C. C. A. 3d, 1924).

<sup>30</sup> *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F. (2d) 266 (C. C. A. 2d, 1944); *Von Tilzer v. Jerry Vogel Music Co.*, 53 F. Supp. 191 (D. C. S. D. N. Y. 1943).

the renewal co-ownership case, the second circuit has raised but left unanswered the question of whether the second interest is legal or equitable where the application makes it obvious that there are co-authors.<sup>31</sup>

#### LICENSE BY A CO-OWNER

The uniform American rule is that one co-owner can grant a license for the use of the work by a third party without the consent of the remaining co-owners.<sup>32</sup> He can also use the work himself,<sup>33</sup> and the other co-owners may not

<sup>31</sup> In *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F. (2d) 268, it was said: "... some doubt may be raised whether the legal title does not run to both authors jointly, when as in this case, it appears on the very face of the application that there are two [the renewal application named his co-author as having 'written' the song and stated that he had 'composed' it] ... It is not necessary to decide the point as will appear; but for argument we will assume that, when, as here, one of the joint authors asks for and gets the renewal in his own name, the legal right goes to him alone, and the other author's interest is equitable." 140 F. (2d) at 269.

<sup>32</sup> *Meredith v. Smith*, 145 F. (2d) 620 (C. C. A. 9th, 1944); *Piantadosi v. Loew's, Inc.*, 137 F. (2d) 534 (C. C. A. 9th, 1943); *Klein v. Beach*, 232 Fed. 240 (S. D. N. Y. 1916), *aff'd*, 239 Fed. 108 (C. C. A. 2d, 1917); *Talbot v. Quaker-State Oil Refining Co.*, 104 F. (2d) 967 (C. C. A. 3d, 1939) (patent); *Blackledge v. Weir & Craig Mfg. Co.*, 108 Fed. 71 (C. C. A. 7th, 1901) (patent); *Lalance & Grosjean Mfg. Co. v. National Enameling & S. Co.*, 108 Fed. 77 (C. C. S. D. N. Y. 1901) (patent); *Pusey & Jones Co. v. Miller*, 61 Fed. 401 (C. C. D. Del. 1894) (patent); *Dunham v. Indianapolis & St. L. R. Co.*, 8 Fed. Cas. 44, No. 4151 (C. C. N. D. Ill. 1876) (patent); *Clum v. Brewer*, 5 Fed. Cas. 1097, No. 2909 (C. C. D. Mass. 1855) (patent); *Brown v. Republic Productions*, 156 P. (2d) 40; same, 156 P. (2d) 42 (Cal. App. 1945); *Nilsson v. Lawrence*, 148 App. Div. 678, 133 N. Y. Supp. 293 (1st Dep't 1912); *Herbert v. Fields*, 152 N. Y. Supp. 487 (Sup. Ct. N. Y. Co. 1915); *see Silverman v. Sunrise Pictures Corp.*, 273 Fed. 909, 914 (C. C. A. 2d, 1921), *cert. denied*, 262 U. S. 758 (1923); *Crosney v. Edward Small Productions*, 52 F. Supp. 559, 561 (S. D. N. Y. 1942); *Rainbow Rubber Co. v. Holtite Mfg. Co.*, 20 F. Supp. 913, 915 (D. Md. 1937) (patent); *First Security Trust Co. v. Mitchell*, 294 Mass. 468, 472, 2 N. E. (2d) 196, 197 (1936) (patent); *Kirke La Shelle Co. v. Armstrong Co.*, 263 N. Y. 79, 88, 188 N. E. 163, 167 (1933); *De Witt v. Elmira Nobles Mfg. Co.*, 66 N. Y. 459, 462 (1876) (patent); *AMDUR, COPYRIGHT LAW AND PRACTICE* (1936) 834; *BALL, LAW OF COPYRIGHT AND LITERARY PROPERTY* (1944) 587-588; *ELLIS, PATENT ASSIGNMENTS AND LICENSE* (2d ed. 1943) § 473, p. 512; *WEIL, COPYRIGHT LAW* (1917) 547.

<sup>33</sup> *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F. (2d) 266; same, 140 F. (2d) 270 (C. C. A. 2d, 1944); *Drake v. Hall*, 220 Fed. 905 (C. C. A. 7th, 1914), *rehearing denied* (1915) (patent); *Blackledge v. Weir & Craig Mfg. Co.*, 108 Fed. 71 (C. C. A. 7th, 1901) (patent); *Von Tilzer v. Jerry Vogel Music Co.*, 53 F. Supp. 191 (S. D. N. Y. 1943); *Lalance & Grosjean Mfg. Co. v. National Enameling & S. Co.*, 108 Fed. 77 (C. C. S. D. N. Y. 1901) (patent); *Aspinwall Mfg. Co. v. Gill*, 32 Fed. 697 (C. C. D. N. J. 1887) (patent); *Clum v. Brewer*, 5 Fed. Cas. 1097, No. 2909 (C. C. D. Mass. 1855) (patent); *Brown v. Republic Productions*, 156 P. (2d) 40; same, 156 P. (2d) 42 (Cal. App. 1945); *Carter v. Bailey*, 64 Me. 458 (1874); *Nilsson v. Lawrence*, 148 App. Div. 678, 133 N. Y. Supp. 293 (1st Dep't 1912); *see*

bring infringement actions against him<sup>34</sup> or his licensees<sup>35</sup> for such use. However, by contract, the co-owners may vary these rights *inter se*,<sup>36</sup> although, of course, the rights of a licensee without notice of such an arrangement cannot be effected.<sup>37</sup>

The English rule is *contra*, and one co-owner cannot

Crosney v. Edward Small Productions, 52 F. Supp. 559, 561 (S. D. N. Y. 1942); Rainbow Rubber Co. v. Holtite Mfg. Co., 20 F. Supp. 913, 915 (D. Md. 1937) (patent); Dunham v. Indianapolis & St. L. R. Co., 8 Fed. Cas. No. 4151 at 45 (C. C. N. D. Ill. 1876) (patent); First Security Trust Co. v. Mitchell, 294 Mass. 468, 472, 2 N. E. (2d) 196, 197 (1936) (patent); De Witt v. Elmira Nobles Mfg. Co., 66 N. Y. 459, 462 (1876) (patent); ELLIS, *op. cit. supra* note 32, at § 171, p. 194; FROHLICH AND SCHWARTZ, THE LAW OF MOTION PICTURES (1918) 41; WEIL, *loc. cit. supra* note 32. *Cf.* Osborn v. Schenck, 83 N. Y. 201 (1880) (personalty).

<sup>34</sup> Meredith v. Smith, 145 F. (2d) 620 (C. C. A. 9th, 1944); Edward B. Marks Music Corp. v. Jerry Vogel Music Co., 140 F. (2d) 266; same, 140 F. (2d) 270 (C. C. A. 2d, 1944); Lalance & Grosjean Mfg. Co. v. National Enameling & S. Co., 108 Fed. 77 (C. C. S. D. N. Y. 1901) (patent); Aspinwall Mfg. Co. v. Gill, 32 Fed. 697 (C. C. D. N. J. 1887) (patent); *see* Rainbow Rubber Co. v. Holtite Mfg. Co., 20 F. Supp. 913, 915 (D. Md. 1937) (patent); Dunham v. Indianapolis & St. L. R. Co., 8 Fed. Cas. No. 4151 at 45 (C. C. N. D. Ill. 1876) (patent). *Contra*: Pitts v. Hall, 19 Fed. Cas. 758, No. 11,193 (C. C. N. D. N. Y. 1854).

The fact that a co-owner cannot be sued for infringement does not preclude other theories of recovery from being utilized. See discussion of ACCOUNTING TO A CO-OWNER, *infra*.

<sup>35</sup> Meredith v. Smith, 145 F. (2d) 620 (C. C. A. 9th, 1944); Piantadosi v. Loew's, Inc., 137 F. (2d) 534 (C. C. A. 9th, 1943); Talbot v. Quaker-State Oil Refining Co., 104 F. (2d) 967 (C. C. A. 3d, 1939) (patent); Dunham v. Indianapolis & St. L. R. Co., 8 Fed. Cas. 44, No. 4151 (C. C. N. D. Ill. 1876) (patent); Brown v. Republic Productions, 156 P. (2d) 40; same, 156 P. (2d) 42 (Cal. App. 1945); *see* Crosney v. Edward Small Productions, 52 F. Supp. 559, 561 (S. D. N. Y. 1942); Rainbow Rubber Co. v. Holtite Mfg. Co., 20 F. Supp. 913, 915 (D. Md. 1937) (patent); WALKER, PATENTS (Dellar's ed. 1937) § 364. *But see* note 70, *infra*; De Witt v. Elmira Nobles Mfg. Co., 66 N. Y. 459, 462 (1876) (patent).

<sup>36</sup> Talbot v. Quaker-State Oil Refining Co., 104 F. (2d) 967 (C. C. A. 3d, 1939) (patent); Lalance & Grosjean Mfg. Co. v. National Enameling & S. Co., 108 Fed. 77 (C. C. S. D. N. Y. 1901) (patent); Gould v. Banks, 8 Wend. 562 (N. Y. 1832); *see* Meredith v. Smith, 145 F. (2d) 620, 621 (C. C. A. 9th, 1944); Cohan v. Comm'r of Internal Revenue, 39 F. (2d) 540, 543 (C. C. A. 2d, 1930); Clum v. Brewer, 5 Fed. Cas. No. 2909 at 1103 (C. C. D. Mass. 1855) (patent); Carter v. Bailey, 64 Me. 458, 463 (1874); De Witt v. Elmira Nobles Mfg. Co., 66 N. Y. 459, 462 (1876); Nillson v. Lawrence, 148 App. Div. 678, 680, 133 N. Y. Supp. 293, 295 (App. Div. 1st Dept. 1912); Herbert v. Fields, 152 N. Y. Supp. 487, 490 (Sup. Ct. N. Y. Co. 1915); FROHLICH AND SCHWARTZ, *loc. cit. supra* note 33; WEIL, *op. cit. supra* note 32, at 167.

<sup>37</sup> Meredith v. Smith, 145 F. (2d) 620 (C. C. A. 9th, 1944); Talbot v. Quaker-State Oil Refining Co., 104 F. (2d) 967 (C. C. A. 3d, 1939) (patent). *But see* Crosney v. Edward Small Productions, 52 F. Supp. 559, 561 (S. D. N. Y. 1942).



grant a license<sup>38</sup> nor use the work himself<sup>39</sup> without the assent of the other co-owners. If there is such use, both he<sup>40</sup> and his licensee<sup>41</sup> can be sued by any co-owner or co-owners for infringement. However, recovery in such a suit is limited to that portion of the damages to which complainant's individual interest entitles him.<sup>42</sup>

The conflicting rules on this point stem from a different philosophical approach.

In the British view, if the rule were otherwise, ". . . a part owner would be at the mercy of his co-owners, each of whom, and they might be any number, might issue as many, as large, and as cheap editions as he chose, thus completely ruining the value of the copyright."<sup>43</sup> They find it more rational to allow each co-owner to act only in regard to his own share.<sup>44</sup>

In this country, the contrary view has for its basis a diametrically opposed rationale:

. . . if none be allowed to enjoy his legal interest without the consent of all, then one, by withholding his consent, might practically destroy the value of the whole use.<sup>45</sup>

Scylla and Charybdis must have been co-owners.

<sup>38</sup> Powell v. Head, 12 Ch. D. 686 (1879); see COPINGER, LAW OF COPYRIGHT (7th ed. 1936) 191; FOX, CANADIAN LAW OF COPYRIGHT (1944) 256; HALSBURY, LAWS OF ENGLAND (2d ed. 1932) § 858.

<sup>39</sup> Cescinsky v. George Routledge & Sons, Ltd., [1916] 2 K. B. 325 (1915).

<sup>40</sup> *Ibid.*; COPINGER, *op. cit. supra* note 38, at 191-192.

<sup>41</sup> Powell v. Head, *supra* note 38.

<sup>42</sup> *Ibid.*; COPINGER, *loc. cit. supra* note 38. In a footnote thereto, Copinger has the following statement: "*Quaere*, whether he could not recover the full amount of damages, subject to a liability to account to his co-authors."

<sup>43</sup> "In my opinion, the old common law rule as to the right of a co-owner to use the common property has no application to such a property as a copyright. It seems to me that a sole right of reproducing, though divisible as to title, must be indivisible as to exercise." Cescinsky v. George Routledge & Sons, Ltd., [1916] 2 K. B. 325, 330 (1915).

Another basis, a purely technical one, is that the Interpretation Section of the English Copyright Act states that the singular includes the plural, so if the consent of the owner is needed, *mutatis mutandis*, the consent of the co-owners is needed. *Ibid.*; Powell v. Head, 12 Ch. D. 686 (1879).

<sup>44</sup> Powell v. Head, *supra*, at 688-689; SHAFER, MUSICAL COPYRIGHT (2d ed. 1939) 165.

<sup>45</sup> Carter v. Bailey, 64 Me. 458, 463 (1874). *Accord*, Dunham v. Indianapolis & St. L. R. Co., 8 Fed. Cas. 44, No. 4151 (C. C. N. D. Ill. 1876) (patent); *cf.* Silverman v. Sunrise Pictures Corp., 273 Fed. 909 (C. C. A. 2d, 1921), *cert. denied*, 262 U. S. 758 (1923), where one of the bases of the court's determination that one of the next of kin could renew for the benefit of all, was the injustice if one refused to sign or could not be located.

## ACCOUNTING TO A CO-OWNER

Accepting the preceding observations to the effect that one co-owner can use the subject matter of the common copyright ownership or license others to use it, all without the consent of the other co-owners, the question arises as to the interest of the co-owners *inter se* in the proceeds from such use or license. This matter seemed early settled with a laissez-faire solution. Each co-owner was allowed to retain his own profit from the use of the copyright and his income from licenses without accounting therefor, although not without speculative statements about what the proper rule should be. More recently there have been cases taking the opposite view. An examination of the authorities<sup>46</sup> will reveal that the matter can be reopened for determination.

The patent law had first drawn a distinction between a co-owner who himself engaged in business making a profit out of the patent, and one who merely licensed the patent. In the latter situation it was considered proper for the co-owners to share, while in the former it was thought inequitable for those who risked no losses and supplied no capital

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<sup>46</sup> Cases for an accounting: *Maurel v. Smith*, 271 Fed. 211 (C. C. A. 2d, 1921); *Klein v. Beach*, 232 Fed. 240 (S. D. N. Y. 1916), *aff'd*, 239 Fed. 103 (C. C. A. 2d, 1917); *Von Tilzer v. Jerry Vogel Music Co.*, 53 F. Supp. 191 (S. D. N. Y. 1943); *Crosney v. Edward Small Productions*, 52 F. Supp. 559 (S. D. N. Y. 1942); *see Pusey & Jones Co. v. Miller*, 61 Fed. 401 (C. C. D. Del. 1894) (patent); *Aspinwall Mfg. Co. v. Gill*, 32 Fed. 697 (C. C. D. N. J. 1887) (patent); *Kirke La Shelle v. Armstrong Co.*, 263 N. Y. 79, 88, 188 N. E. 163, 167 (1933); *Brown v. Republic Productions*, 156 P. (2d) 40, 41; same, 156 P. (2d) 42, 43 (Cal. App. 1945); *cf. Cohan v. Comm'r of Internal Revenue*, 39 F. (2d) 540, 543 (C. C. A. 2d, 1930).

Cases against an accounting: *Drake v. Hall*, 220 Fed. 905 (C. C. A. 7th, 1914), *rehearing denied* (1915) (patent); *Blackledge v. Weir & Craig Mfg. Co.*, 108 Fed. 71 (C. C. A. 7th, 1901) (patent); *Carter v. Bailey*, 64 Maine 458 (1874); *see Silverman v. Sunrise Pictures Corp.*, 273 Fed. 909, 914 (C. C. A. 2d, 1921), *cert. denied*, 262 U. S. 758 (1923); *Rainbow Rubber Co. v. Holtite Mfg. Co.*, 20 F. Supp. 913 (D. C. D. Md. 1937) (patent); *Dunham v. Indianapolis & St. L. R. Co.*, 8 Fed. Cas. No. 4151 at 45 (C. C. N. D. Ill. 1876) (patent); *First Security Trust Co. v. Mitchell*, 294 Mass. 468, 472, 2 N. E. (2d) 196, 197 (1936) (patent); ELLIS, PATENT ASSIGNMENTS AND LICENSES (2d ed. 1943) § 473, p. 512, § 171, p. 194; FROHLICH AND SCHWARTZ, LAW OF MOTION PICTURES (1918) 41; WALKER, PATENTS (Dellar's ed. 1937) §§ 344, 363; WEIL, COPYRIGHT LAW (1917) 547.

In *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F. (2d) 266 (C. C. A. 2d, 1944), the court specifically left the question open: "This appeal does not raise the question whether each might call the other to an accounting, bringing his own profits into hotchpot." *Id.* at 268.

to share in the proceeds of the enterprising co-owner.<sup>47</sup> The *Blackledge* case determined that there was no basis for the distinction for each could use the invention and individual initiative would return to each the "fruits of his endeavors" and with no accountability whatsoever.<sup>48</sup> This seems to be the current rule in patent law.<sup>49</sup> While in this field, the patent law is considered akin to copyright law,<sup>50</sup> there have been copyright cases granting an accounting without examining the applicable patent law.

A frequent objection by co-owners seeking an accounting is that the other co-tenant has so used or licensed the use of the subject matter as to cause the destruction thereof.<sup>51</sup> This complaint occurs largely in cases where a motion picture is created, the idea being that mass showings will surfeit the public taste for that subject matter. Although there is authority for its acceptance, this objection has been rejected,<sup>52</sup>

<sup>47</sup> See *Dunham v. Indianapolis & St. L. R. Co.*, 8 Fed. Cas. No. 4151 at 45 (C. C. N. D. Ill. 1876).

<sup>48</sup> *Blackledge v. Weir & Craig Mfg. Co.*, 108 Fed. 71 (C. C. A. 7th, 1901).

<sup>49</sup> See ELLIS, *loc. cit. supra* note 46; WALKER, *loc. cit. supra* note 46.

<sup>50</sup> *Piantadosi v. Loew's, Inc.*, 137 F. (2d) 534 (C. C. A. 9th, 1943); see *Silverman v. Sunrise Pictures Corp.*, 273 Fed. 909, 910, 914, *cert. denied*, 262 U. S. 758 (1923); *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 42 F. Supp. 859, 865 (S. D. N. Y. 1942), *aff'd*, 140 F. (2d) 266 (C. C. A. 2d, 1944). *Accord*, *Sheldon v. Metro-Goldwyn Pictures Corp.*, 309 U. S. 390 (1940). *But cf.* *Widenski v. Shapiro, Bernstein & Co.*, 147 F. (2d) 909 (C. C. A. 1st, 1945).

<sup>51</sup> The general rule of joint ownership is that one co-tenant may not so use the subject matter of the tenancy as to cause its destruction. See *Osborn v. Schenck*, 83 N. Y. 201, 204 (1880). Similarly, there cannot be an ouster of a co-tenant or other denial of rights. See *In re Limberg's Estate*, 281 N. Y. 463, 465, 24 N. E. (2d) 127, 128 (1931).

<sup>52</sup> *Brown v. Republic Productions*, 156 P. (2d) 40; same, 156 P. (2d) 42 (Cal. App. 1945); *Herbert v. Fields*, 152 N. Y. Supp. 487 (Sup. Ct. N. Y. Co. 1915); see AMDUR, *COPYRIGHT LAW AND PRACTICE* (1936) 617, 834; *cf.*, *Klein v. Beach*, 232 Fed. 240, 246 (S. D. N. Y. 1916), *aff'd*, 239 Fed. 108 (C. C. A. 2d, 1917). *Contra*: *Crosney v. Edward Small Productions*, 52 F. Supp. 559 (S. D. N. Y. 1942), discussed elsewhere *infra*; *cf.* *Manners v. Morosco*, 252 U. S. 317 (1920); *Frohman v. Fitch*, 149 N. Y. Supp. 633, 164 App. Div. 231 (1st Dep't 1914).

In *Manners v. Morosco*, it was held that, when stage rights have been granted, the owner of the reserved rights, in the absence of a contract permitting it [*Macloon v. Vitagraph, Inc.*, 30 F. (2d) 634 (C. C. A. 2d, 1929)], cannot use them to the detriment of the granted stage rights and therefore cannot make a motion picture, quoting Judge Hough's statement in *Harper Bros. v. Klaw* [232 Fed. 609 at 613 (S. D. N. Y. 1916)]: "Admittedly, if Harper Bros. . . . permitted photoplays of Ben Hur to infest the country, the market for the spoken play would be greatly impaired, if not destroyed." 252 U. S. at 327. It is submitted that today the contrary is true. The motion picture is good publicity stimulating public desire for the play.

on the ground that you cannot analogize a case of physical destruction to an incorporeal entity. Besides, experience has shown that motion pictures are many times remade and with different casts, depending, of course, on the public's whim and fancy.<sup>53</sup>

There would be no point in considering the question of the destruction of the copyright or literary property unless the rule were established that there could be no accounting in the absence of extraordinary circumstances.

In *Maurel v. Smith*, it was said:

Where two or more persons have a common interest in a property, equity will not allow one to appropriate it exclusively to himself or to impair its worth as to others. The settlement of rights between joint tenants or joint owners of property is the subject matter of equity jurisdiction, and we think that such rights are involved in this litigation.<sup>54</sup>

The *Maurel* case was not the usual co-ownership situation. There a co-author had taken the copyright in his own name and was seeking to profit therefrom. The court declared that the legal title was held in trust for the omitted co-author and granted an accounting for the appropriate co-owner's share.<sup>55</sup> Obviously, the complainant there had no other recourse; with the legal title in another's name, she could not have gathered "fruit" on her own initiative.<sup>56</sup>

In *Klein v. Beach*,<sup>57</sup> plaintiff, a dramatist, at the request of a producer, dramatized defendant's novel, the two, having a contract between them to share royalties on the play, then granting the right to the producer to present it upon the stage. The rights reverted to the two because the play was not produced a sufficient number of times. Thereafter, the

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<sup>53</sup> In their own self-interest and in order to prevent cheap competitive versions, motion picture companies generally seek to acquire all rights outstanding. See KUFFERMAN, *op. cit. supra* note 23, at 726.

<sup>54</sup> See *Maurel v. Smith*, 271 Fed. 211, 216 (C. C. A. 2d, 1921). Cited for this statement was a case which involved evident fraud and breach of a fiduciary relationship, *Jackson v. Ludeling*, 21 Wall. 616 (U. S. 1874).

<sup>55</sup> SHAFTER, *loc. cit. supra* note 44, states that an omitted co-author will share in profits.

<sup>56</sup> Compare the situation in *Meinhard v. Salmon* [249 N. Y. 458, 164 N. E. 545 (1928)], where the managing co-adventurer took advantage of his position to reap a business reward of which his joint adventurer had no knowledge and the court imposed a constructive trust.

<sup>57</sup> 232 Fed. 240 (S. D. N. Y. 1916), *aff'd*, 239 Fed. 108 (C. C. A. 2d, 1919).

defendant Beach, author of the novel, gave permission to make a movie. After dismissing the action against the defendant motion picture company, the court stated there was a duty to account to one's co-owner, citing two cases, *Nilsson v. Lawrence*<sup>58</sup> and *Lalanc & Grosjean Mfg. Co. v. National Enameling & S. Co.*,<sup>59</sup> both of which hold only that a co-owner, in the absence of a modifying contract, may license without his co-tenant's permission. Further, the court stated, the accounting would depend on whether or not the motion picture company utilized the dramatization, inasmuch as the plaintiff had no right in the novel. Plaintiff appealed the dismissal as against the licensee. It was affirmed on the ground that the motion picture rights were in the defendant novelist.

With reference to the accounting problem, the circuit court stated: "As Beach has not appealed, we do not wish to be understood as holding that the complaint states a cause of equity against him."<sup>60</sup>

In *Brown v. Republic Productions*,<sup>61</sup> the lower court granted an accounting against the co-owners and dismissed the case against the licensee, a motion picture company. The plaintiff appealed the adverse decision as to the licensee's liability, and it was affirmed. In a dictum the appellate court acknowledged the right to an accounting,<sup>62</sup> citing *Herbert v. Fields*,<sup>63</sup> which has neither holding nor dictum in accord therewith, holding only that a co-owner can license and that the making of a motion picture is not a destructive use of the copyright. This case is similar to *Klein v. Beach*.

In *Von Tilzer v. Jerry Vogel Music Co.*<sup>64</sup> without discussing the point, an accounting was granted to the co-owner of a renewal right, his co-tenant having been held a constructive trustee of the renewal for him. This case involved a situation similar to that in *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, where the circuit court specifically reserved the question,<sup>65</sup> and is akin to the *Maurel* case, *supra*,

<sup>58</sup> 148 App. Div. 678, 133 N. Y. Supp. 293 (1st Dep't 1912).

<sup>59</sup> 108 Fed. 77 (C. C. S. D. N. Y. 1901) (patent).

<sup>60</sup> 239 Fed. at 110.

<sup>61</sup> 156 P. (2d) 40, 156 P. (2d) 42 (Cal. App. 1945).

<sup>62</sup> 156 P. (2d) at 41.

<sup>63</sup> 152 N. Y. Supp. 487 (Sup. Ct. N. Y. Co. 1915).

<sup>64</sup> 53 F. Supp. 191 (S. D. N. Y. 1943).

<sup>65</sup> See note 46 *supra*.

in the circumstance of the co-owner being without a legal title.<sup>66</sup>

The case of *Crosney v. Edward Small Productions*<sup>67</sup> came up on a motion to dismiss, and the facts, although ambiguous, were admitted for that purpose. The defendant motion picture company through a trustee in bankruptcy and by mesne conveyances acquired a one-half interest in the motion picture and other rights in and to a certain play, subject to plaintiff's share in those same rights of one-half of its 50% interest but only in the United States and Canada. The defendant itself produced a movie. *Held*: Defendant is a co-owner, not a licensee,<sup>68</sup> who destroyed the subject matter by making a motion picture, and therefore the plaintiff is entitled to an accounting, citing *Nilsson v. Lawrence, supra*, which is not authoritative for the proposition. That such use does not amount to a destruction has been considered *supra*. The Court does not take into consideration the defendant's investment and risk in the making of the motion picture. It is submitted that the decision in this case is not well reasoned.

It is difficult to view the matter in its proper perspective. We allow a co-owner to use or license someone else to use the whole of a right and all of its parts, when he owns only an undivided portion and could sell or assign only that share. It must be remembered, however, that the right is mutual.<sup>69</sup>

It would seem reasonable that as long as the co-owners have an equal opportunity to dispose of the rights involved and in the absence of special circumstances such as unfair dealing,<sup>70</sup> that they be allowed to retain their own income

<sup>66</sup> Cf. *Minion v. Warner*, where it was said, ". . . as between tenants in common who hold their estate through descent or under a will there is a quasi trust relationship." 238 N. Y. 413, 417, 144 N. E. 665, 666 (1924) (realty). The renewal right in a copyright might be classified in this category.

<sup>67</sup> 52 F. Supp. 559 (S. D. N. Y. 1942).

<sup>68</sup> *Query*, his rights being limited geographically, to the United States and Canada, was he an assignee? See note 26 *supra*.

<sup>69</sup> It has been suggested that inasmuch as it is preferable a licensee be free of all claims, good policy might require the licensor to account to his co-owner. See *Pusey & Jones Co. v. Miller*, 61 Fed. 401, 404 (C. C. D. Del. 1894) (patent).

<sup>70</sup> Compare *Kirke La Shelle Co. v. Armstrong*, 263 N. Y. 79, 188 N. E. 163 (1933); *Underhill v. Schenck*, 238 N. Y. 7, 143 N. E. 773 (1924).

Where a suit is started by all the co-owners against an infringer, and one accepts a settlement, the right of the other co-owners to recover is not destroyed. *Lalance & Grosjean Mfg. Co. v. Haberman Mfg. Co.*, 93 Fed. 197 (C. C. S. D. N. Y. 1899); see *De Witt v. Elmira Nobles Mfg. Co.*, 66 N. Y. 459, 462

and profits.<sup>71</sup> If the co-owners would have it otherwise, they can do so by contract.<sup>72</sup>

The alternative view means that by becoming an assignee, and therefore a co-owner, you subject yourself to the requirement of accounting of profits,<sup>73</sup> although you may invest your own capital and risk losses, while if you become a licensee you can avoid this responsibility.<sup>74</sup> The law should not place a premium on subterfuge.

#### JURISDICTION AND NECESSARY PARTIES

This section contains some thoughts on the problems of where to sue and who can sue to protect the rights of a co-owner.

The federal courts have exclusive jurisdiction<sup>75</sup> over cases involving statutory copyright,<sup>76</sup> and an infringement suit based on a statutory copyright could not be maintained in a state court.<sup>77</sup> However, when the suit is for breach of a fiduciary relationship,<sup>78</sup> or breach of contract,<sup>79</sup> it may also be brought in the state court, and where the suit is against a co-owner for breach of contract as to the use of the joint

(1876); WALKER, *op. cit. supra* note 46, at § 364. The co-owner is entitled, in addition, to an accounting from his co-tenant. *Lalanc & Grosjean Mfg. Co. v. Haberman Mfg. Co.*, 107 Fed. 487 (C. C. S. D. N. Y. 1901).

<sup>71</sup> Under the English rule, *supra*, you do not have the problem of accounting to a co-owner as discussed herein, for infringement suits against co-owners are permissible, and the accounting can be obtained in such a suit. *See* 7 HALSBURY, *op. cit. supra* note 38, at § 917; COPINGER, *op. cit. supra* note 38, at 159.

<sup>72</sup> See note 36 *supra*.

<sup>73</sup> See note 67 *supra*.

We are not dealing with a partnership situation here for mere co-tenancy is insufficient to raise a presumption of partnership. *See* Note (1944) 150 A. L. R. 1003, 1004.

<sup>74</sup> See note 61 *supra*.

<sup>75</sup> 36 STAT. 1160 (1911), 28 U. S. C. § 371 (1940). The Federal District Courts have original jurisdiction by virtue of 36 STAT. 1092 (1911), 28 U. S. C. § 41(7) (1940); 35 STAT. 1078 (1909), 17 U. S. C. § 34 (1940).

<sup>76</sup> For published works, statutory copyright is secured if the proper copyright notice is affixed. *See* note 18 *supra*. For unpublished works, there is a special provision for registration to attain statutory copyright. 37 STAT. 488 (1912) 17 U. S. C. § 11 (1940).

<sup>77</sup> *Leo Feist, Inc. v. Song Parodies*, 146 F. (2d) 400 (C. C. A. 2d, 1944); *Loew's, Inc. v. Superior Court*, 18 Cal. (2d) 419, 115 P. (2d) 983 (1941); *Cohan v. Robbins Music Corp.*, 244 App. Div. 697, 280 N. Y. Supp. 571 (1st Dep't 1935).

<sup>78</sup> *Underhill v. Schenck*, 238 N. Y. 7, 143 N. E. 773 (1924).

<sup>79</sup> *Condon v. Associated Hospital Service*, 287 N. Y. 411, 40 N. E. (2d) 230 (1942).

copyright, the federal court has no jurisdiction unless the proper allegations of diversity of citizenship and amount can be made.<sup>80</sup>

In the past it has been held that suit under the Copyright Statute must be in the name of the copyright proprietor<sup>81</sup> and the proprietor must be a party.<sup>82</sup> The present Federal Rules of Civil Procedure<sup>83</sup> require that all actions be “. . . prosecuted in the name of the real party in interest; . . .”<sup>84</sup> A licensee is not such a party,<sup>85</sup> but a person with an equitable title, including an equitable co-owner, would seem to be,<sup>86</sup> and suit in his name would probably be sufficient to satisfy the requirements of the Copyright Act, provided the owner of the legal interest were joined.

Where one co-owner brings a suit for infringement against a stranger, the question is whether his co-tenant is an indispensable party.<sup>87</sup> It may happen that the co-tenant

<sup>80</sup> *Meredith v. Smith*, 145 F. (2d) 620 (C. C. A. 9th, 1944); *cf. Wade v. Lawder*, 165 U. S. 623 (1897) (patent). *But cf. Wooster v. Crane*, 147 Fed. 515 (C. C. A. 8th, 1906). Inasmuch as an infringement suit cannot be brought against a co-owner, note 34 *supra*, there is no choice between a cause of action *ex contractu* or one for infringement as there would be against your own licensee. *E.g.*, against a licensee, *Metro-Goldwyn-Mayer Distributing Corp. v. Bijou Theatre Co.*, 59 F. (2d) 70 (C. C. A. 1st, 1932).

<sup>81</sup> *Goldwyn Pictures Corp. v. Howell Sales Co.*, 287 Fed. 100 (C. C. A. 2d, 1923), *cert. denied*, 262 U. S. 755 (1923); *Stephens v. Howell Sales Co.*, 16 F. (2d) 805 (S. D. N. Y. 1926); *Independent Wireless Telegraph Co. v. Radio Corp.*, 269 U. S. 459 (1926) (patent); *see Waterman v. Mackenzie*, 138 U. S. 252, 255 (1891) (patent).

<sup>82</sup> *Goldwyn Pictures Corp. v. Howell Sales Co.*, 282 Fed. 9 (C. C. A. 2d, 1922), *cert. denied*, 262 U. S. 755 (1923); *Independent Wireless Telegraph Co. v. Radio Corp.*, 269 U. S. 459 (1926) (patent); *Local Trademarks v. Powers*, 56 F. Supp. 751 (E. D. Pa. 1944); *Society of European Stage Authors and Composers, Inc. v. WCAU Broadcasting Co.*, 1 F. R. D. 264 (E. D. Pa. 1940); *Stephens v. Howell Sales Co.*, 16 F. (2d) 805 (S. D. N. Y. 1926); *see Widenski v. Shapiro, Bernstein & Co.*, 147 F. (2d) 909, 910 (C. C. A. 1st, 1945); *Hoffman v. Santly-Joy*, 51 F. Supp. 778, 779; *same*, 51 F. Supp. 779, 780, 781 (S. D. N. Y. 1943).

<sup>83</sup> Rule 81(a) provides that the Federal Rules become applicable to copyright cases if made so by Supreme Court rule. In accordance with § 25 of the Copyright Law, 35 STAT. 1075 (1909), 17 U. S. C. § 25 (1940) the Supreme Court amended Rule 1 of the Copyright Rules of Practice to provide that the Federal Rules should apply. *Society of European Stage Authors and Composers v. WCAU Broadcasting Co.*, 1 F. R. D. 264 (E. D. Pa. 1940).

<sup>84</sup> FED. RULES CIV. PROC., Rule 17(a). Old Equity Rule 37 was similarly worded. 28 U. S. C. § 723 (App.).

<sup>85</sup> *See* note 81 *supra*; HOWELL, *THE COPYRIGHT LAW* (1942) 144.

<sup>86</sup> *See Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F. (2d) 268, 269 (C. C. A. 2d, 1944); *Hoffman v. Santly-Joy*, 51 F. Supp. 778, 779; *same*, 51 F. Supp. 779, 781 (S. D. N. Y. 1943).

<sup>87</sup> FED. RULES CIV. PROC., Rule 19(b).



is unknown or unavailable. This may be a frequent occurrence in the renewal co-ownership cases, for the renewal does not begin until the twenty-ninth year after the original publication of the work.

If the co-tenants cannot be served in order to make them parties, the non-joinder is not fatal.

These parties are not indispensable within Rule 19(b); because their rights can be reserved in the judgment; the action can be finally decided as to the plaintiff without them, if they cannot be served. On this record we cannot say whether they can be served or not, because we do not know who or where they are. But, even assuming that it rests upon the plaintiff to show that they cannot be served, the objection is nevertheless not good, because the defendant was obliged to take it by motion or by answer (Rule 12(h)), which it did not do.<sup>88</sup>

The plaintiff can receive his proportionate share of the statutory damages or profits, and, in lieu of statutory damages, his actual damages.<sup>89</sup>

It is submitted that allowing a proceeding to continue in the absence of a co-tenant as a party would seem to be in consonance with the thesis that the co-owners are independent of each other and not entitled to an accounting *inter se*. Strangely enough the patent cases have used the thesis to deny independent recovery, going so far in the argument that the co-owners are "at the mercy of each other" as to find the problem of non-joinder a substantive question rather than a procedural one, thereby denying the co-owner the possibility of bringing a recalcitrant co-tenant into court as a party defendant under Rule 19(a).<sup>90</sup>

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<sup>88</sup> Edward B. Marks Music Corp. v. Jerry Vogel Music Co., 140 F. (2d) 268 at 269-270 (C. C. A. 2d, 1944). *Accord*, Stuff v. La Budde Feed & Grain Co., 42 F. Supp. 493 (E. D. Wis. 1941); Powell v. Head, 12 Ch. D. 686 (1879); *see* Lauri v. Renad, [1892] 3 Chan. 402, 413 (C. A.). *Contra*: Nillson v. Lawrence, 148 App. Div. 678, 133 N. Y. Supp. 293 (1st Dep't 1912).

<sup>89</sup> Edward B. Marks Music Corp. v. Jerry Vogel Music Co., 140 F. (2d) 268 (C. C. A. 2d, 1944); Powell v. Head, 12 Ch. D. 686 (1879).

<sup>90</sup> Gibbs v. Emerson Electric Mfg. Co., 29 F. Supp. 810 (W. D. Mo. 1939); Rainbow Rubber Co. v. Holtite Mfg. Co., 20 F. Supp. 913 (D. Md. 1937); *see* WALKER, PATENTS (Dellar's ed. 1937) § 364 (Supp. 1944).