Kentucky Law Journal

Volume 27 | Issue 4 Article 2

1939

Copyright Protection of Advertising

Joseph S. Freeland

COPYRIGHT PROTECTION OF ADVERTISING

By JOSEPH S. FREELAND*

I

So rapid, in recent years, has been the development of the art of advertising, and so great has become its importance as a factor in the economic scheme, that it is not surprising that legal questions of considerable interest have developed in connection therewith. Even the most casual observer of the economic scene cannot help but note the tremendous effect which the adroit and skillful appeals at present practiced by the exponents of the art exercise upon mass buying habits and, through these, upon the economic structure as a whole. Never before, surely, in the history of the human race has there been seen the spectacle of whole populations buying and using commodities which they, without some external pressure, would not want, and which in many instances are either absolutely worthless or definitely deleterious to the health and welfare of the consumer.[1] Through print, billboards, and the radio the American people (to say nothing of the less fortunate races whom necessity forces to reside in foreign parts) are exposed to a constant flood of psychological suggestions, entreaties, and commands to purchase this or that article of commerce. The combined effect is overwhelming: millions of those whose best friends would not tell them hasten to make themselves fragrant and beautiful; millions of those who seek the radiant glow of health hasten to purchase the latest product of the breakfast food institutes; millions more who shudder lest they fall behind in the transportation parade hasten to equip themselves with the newest creation of the Detroit assembly lines. Economic crisis has only served to intensify the process; it has heightened the competition among advertisers for a greater share of the consumer's shrunken dollar.

Nor is this all. Advertising has created and now sustains social institutions of the greatest importance. Such powerful

*LL. B., Univ. of Ky. 1938; now practicing law in Paducah, Ky.

[1] See any issue of the monthly bulletins published by Consumers' Research or Consumers' Union.

molders of public opinion as the daily press,[2] the group of weekly periodicals typified by the *Saturday Evening Post*, and the radio broadcasting industry, could scarcely exist were it not for the life-giving flow of advertising revenue; without it they would annually run a deficit which would make that of the federal government seem scarcely worth worrying about. Furthermore, advertising has created vested interests of considerable power and tenacity, which, because of the hold a popularized trade name has upon the public mind, in many cases approach monopoly.[3] Every student of business practices is familiar with the capitalization of intangible assets as "good will"; although "good will" often includes other elements the nature of which is not even remotely suggested by the term employed to cover them, "good will" nearly always includes that vested interest in public purchasing habits which is built up by the judicious use of advertising.[4]

Such considerations as these, it would seem, should be sufficient to establish the economic importance of the art of advertising, and therefore, it naturally follows, its legal importance as well; since litigation seems to be most plentiful where the most money is involved. It would seem, therefore, that to the practicing lawyer, particularly the lawyer whose clientele is drawn from among those corporate enterprises which advertise extensively, a knowledge of the various legal rights and liabilities involved in advertising should be most important. It is with this fact in view that this paper has been written; and although its scope is necessarily limited to a very narrow field, that of copyright, it may perhaps be suggestive of other problems which lie beyond its range.

II

To what extent is advertising copyrightable? In the United States, at least, the answer to this question very largely

[2] This does not, of course, apply to newspapers subsidized by political groups from one source or another; e. g. the Communist dailies in New York, Chicago, and San Francisco, the former of which alone, with a circulation of approximately 40,000 and almost no advertising, incurs an annual deficit of $90,000.

[3] So much so that, in some instances, as in the case of snapshot cameras and gelatine desserts, the trade name of the most widely advertised brand of such products has virtually ousted the actual name of the commodity from the average vocabulary.

[4] See Veblen, The Vested Interests and the State of the Industrial Arts (1919), 71.

turns upon the construction of a section of the United States Constitution, for it is from that source that the power of Congress to provide for the grant of copyrights and patents is derived. The Constitution provides that Congress shall have power[5]

"To promote the Progress of Science and usful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

Thus empowered, Congress has from time to time enacted copyright legislation, that in force at the present time being Title 17 of the United States Code.[6] The statute itself is silent on the question of whether advertising is copyrightable;[7] the answer to our question must therefore be sought in the pages of the reported cases.

Generally, it appears, material which may be made the subject of copyright must possess originality,[8] at least in the "legal" sense,[9] and, as the foregoing section of the Constitution would

[5] U. S. Const. Art I, §8, cl. 8.

[6] The act now in force is that of March 4, 1909, c. 320, as subsequently amended.

[7] U. S. C. A. tit. 17, §4. "The works for which copyright may be secured under this title shall include all the writings of an author."

Id. §5. "The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs:

(a) Books, including composite and cyclopedic works, directories, gazetteers, and other compilations;
(b) Periodicals, including newspapers;
(c) Lectures, sermons, addresses (prepared for oral delivery);
(d) Dramatic or dramatico-musical compositions;
(e) Musical compositions;
(f) Maps;
(g) Works of art; models or designs for works of art;
(h) Reproductions of a work of art;
(i) Drawings or plastic works of a scientific or technical character;
(j) Photographs;
(k) Prints and pictorial illustrations;
(l) Motion-picture photoplays;
(m) Motion pictures other than photoplays.

The above specifications shall not be held to limit the subject matter of copyright as defined in section 4 of this title, nor shall any error in classification invalidate or impair the copyright protection secued under this title."

[8] Gray v. Russell, Fed. Cas. No. 5,728 (C. C. Mass., 1839); Jollie v. Jaques, Fed. Cas. No. 7,437 (C. C. N. Y., 1850); Hoffman v. Le Traunik, 209 Fed. 375 (N. D. N. Y., 1913); American Code Co. v. Bensinger, 282 Fed. 829 (C. C. A. 2d., 1922); Roe-Lawton v. Hal E. Roach Studios, 18 F. (2d) 125 (S. D. Cal., 1927).

[9] Boucicault v. Fox, Fed. Cas. No. 1,691 (C. C. N. Y., 1862); Henderson v. Tompkins, 60 Fed. 758 (C. C. Mass., 1894); Jewelers' Circular Pub. Co. v. Keystone Pub. Co., 281 Fed. 83 (C. C. A. 2d, 1922), *cert.*

seem to indicate, it must bear some relation to "the Progress of Science and useful Arts."[10]

The earliest American case involving the copyright of advertising matter appears to be that of *Collender* v. *Griffith*,[11] decided in 1873. The plaintiff, a manaufacturer of billiard tables, sought to restrain infringement of a copyright obtained by him in an engraving of such a table, used for advertising purposes. The court, though holding that there had been no infringement, said that "The engraving claimed to be the subject of copyright is not a work of art, print, lithograph, or engraving having any value or use as such. It is a mere copy of what the plaintiff had patented as a design, and constitutes the mode in which the complainant advertises his tables", and accordingly it should not be copyrightable.

Following this came the case of *Ehret* v. *Pierce*,[12] decided in 1880. The plaintiff therein had copyrighted an advertising card, of a type no doubt familiar to the reader, to which were affixed square bits of paper colored to represent the various colors of paints which the plaintiff offered for sale, with accompanying descriptive and commendatory printed matter. An injunction to restrain the defendant from publishing similar cards advertising his own paints was denied, the court holding that such a card could not be the subject of copyright, not having a book, map, chart, musical composition, print or engraving within the meaning of the act of 1831.[13] "True," the court observed, "it has lithographic work upon it, and also words and sentences; but it has none of the characteristics of a work of art or of a literary production. It is an advertisement, and nothing more.[14] Furthermore, assuming that a valid copyright could be acquired by the plaintiff, the defendant's card was not an infringement thereon, since it did not reproduce the plaintiff's card, but only his method of advertising. An exclusive right to employ a particular *method* of advertising, the court held, can-

denied Keystone Pub. Co. v. Jewelers' Circular Pub. Co., 259 U. S. 581, 42 Sup. Ct. 464, 65 L. Ed. 1074 (1922).

[10] Higgins v. Keuffel, 140 U. S. 428, 11 Sup. Ct. 731, 35 L. Ed. 470 (1891); Dymow v. Bolton, 11 F. (2d) 690 (C. C. A. 2d, 1926); Note (1922) 17 A. L. R. 760, 774.

[11] Fed. Cas. No. 3,000 (C. C. S. D. N. Y., 1873).

[12] 10 Fed. 553 (C. C. E. D. N. Y., 1880).

[13] 4 Stat. 436 (1813).

[14] 10 Fed. 553, 554.

not be acquired under the copyright laws. And in *Lamb* v. *Grand Rapids School Furniture Co.*,[15] decided nine years later, a federal circuit court in Michigan, refusing an injunction on the ground that there had been no infringement of the plaintiff's copyright of a catalogue containing engravings of church furniture of plaintiff's manufacture, stated that it was a matter of so much doubt whether the engravings were intrinsically valuable as works of art, or whether they were simply for trade purposes in aid of sales, that an injunction ought to be denied. In *S. S. White Dental Co.* v. *Sibley*,[16] also decided in 1889, involving the copyright of an advertising chart of artificial teeth, the court, without discussing the validity of the copyright, held simply that there had been no infringement.

In *Mutual Advertising Co.* v. *Befo*,[17] the plaintiff had copyrighted a pamphlet containing advertising and coupons which, when presented to the merchants comprising the advertising association, were good for certain premiums. The defendant issued a pamphlet resembling plaintiff's in its advertising but differing in its coupon scheme. The court held that there was no infringement, as the advertising could not be the subject of copyright, and the coupon scheme, which could be, was not infringed.

In *Raggins* v. *Keuffel*,[18] a United States Supreme Court case, the plaintiffs sought to enjoin use of a label containing the words "waterproof drawing ink," on the grounds that they had obtained a copyright therein under the federal statute. The Court affirmed the decree of the circuit court dismissing the bill. The constitutional provision authorizing grants of copyrights has no reference to labels which simply describe the articles to which they are attached, and which have no value when separated therefrom and no possible influence upon science or the useful arts. "To be entitled to a copyright the article must have by itself some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached."[19] Even were

[15] 39 Fed. 474 (C. C. W. D. Mich., 1889).
[16] 38 Fed. 751 (C. C. E. D. Pa., 1889).
[17] 76 Fed. 961 (C. C. S. C., 1896).
[18] 140 U. S. 428, 11 Sup. Ct. 731, 35 L. Ed. 470 (1891).
[19] *Id.* at 431. The Court cited Scoville v. Toland, Fed. Cas. No. 12, 553 (C. C. Ohio, 1848), in which the court, holding that a copyright could not be obtained in a label reading "Dr. Rodgers Compound Syrup

such a label a proper subject of copyright, no such right was here acquired, the Court held, since plaintiffs had failed to conform to the statutory formalities of registration.

Although the language quoted above from the *Keuffel* case seems broad enough to include all forms of advertising, it should be noted that what was actually decided was the validity of a copyright of a *label* intended to be attached or pasted to an article intended for sale, and not an *advertisement* thereof in the true sense. While, on principle, there should be no difference in the degree of protection, if any, accorded an attractive and original poster in a grocer's window, and the same attractive and original design on the label of the canned product on his shelves, the federal copyright act does differentiate between them to some extent, requiring labels to be registered in the Patent Office and specifically stating that they shall not be entered under the copyright law.[20] Accordingly, it has been held that a copyright of a design (the picture of a young woman) which was later lithographed and used as a cigar box label was void as an attempt to evade the provisions of the "print and label" law.[21]

In the case of *J. L. Mott Iron Works* v. *Glow*,[22] the plain-

of Liverwort and Tar. A safe and certain cure for consumption of the lungs, spitting of blood, coughs, colds, asthma, pain in the side, bronchitis, whooping-cough, and all pulmonary affections", said that "As a composition distinct from the medicine [this label] can be of no value. . . . This is not the case with other compositions which are intended to instruct and amuse the reader, though limited to a single sheet or page." At the present time, it might be observed, the author of such a label would not only be denied a copyright, but would run afoul of the Pure Food and Drug Act.

[20] U. S. C. A., tit. 17, §63 (June 18, 1874). In Marsh v. Warren, Fed. Cas. No. 9,121 (C. C. S. D. N. Y., 1877), it was held that no person is entitled to a copyright in any print, or label designed to be used for any other article of manufacture than pictorial illustrations connected with the fine arts, unless he has complied with the act of 1874 requiring a copy of the article in which copyright is claimed to be registered in the patent office before publication. *Cf.* Fargo Merc. Co. v. Brechet & Richter Co., 295 Fed. 823 (C. C. A. 8th, 1924), holding that copyright of a label was secured by publication with notice of copyright, followed by registration in the patent office under the "print and label" law, where the label was of such character as to be properly the subject of copyright. *Accord:* Golden Rule, Inc. v. B. V. D. Co., 242 Fed. 929 (C. C. A. 8th, 1917); Hoague-Sprague Corp. v. Frank C. Meyer Co. (on motion) 27 F. (2d) 176 (E. D. N. Y., 1928), (same case on final hearing) 31 F. (2d) 583 (E. D. N. Y., 1929).

[21] Schumacher v. Wogram, 35 Fed. 219 (C. C. S. D. N. Y., 1888). The court distinguished the case of Schumacher v. Schwencke, note 29 *infra*, on the ground that in that case the picture was not primarily intended to be used as a label.

[22] 82 Fed. 316 (C. C. A. 7th, 1897).

tiffs, manufacturers of various articles of necessity and convenience in the way of plumbing, had published and copyrighted a catalogue containing cuts or prints representing their wares. The defendants issued a similar catalogue purporting to advertise their own products, but actually copying directly several cuts or prints from plaintiff's catalogue. The court refused to enjoin infringement of the alleged copyright. The illustrations, the court thought, were not of subjects capable of artistic treatment, nor was the letterpress of literary merit or even of scientific interest, since it contained no information as to the process of construction. The constitutional provision relating to copyright was intended to promote the dissemination of learning: "it is not designed as a protection to traders in the particular manner in which they might shout their wares."[23] And in *Royal Sales Co.* v. *Gaynor*[24] the court held that a monogram composed of the letters "T A F T" in distinctive arrangement intended for use as a campaign badge for the presidential contest of 1908 was not copyrightable, not being a "cut, print, or engraving," or a pictorial illustration "connected with the fine arts" as required by the statute.

III

The first American case to intimate that advertising matter, if of sufficient originality and artistic merit, might be the subject of copyright, is *Yuengling* v. *Schile*.[25] There the plaintiff sought to restrain infringemnt of a copyright allegedly obtained by him in a "chromo" entitled "Gambrinus and his followers."[26] The chromo, "designed as a symbolic glorification of lager beer drinking," was intended by plaintiff to be used in advertising, and was so used, having plaintiff's name printed thereon in large letters. The defendant, a rival brewer of the foaming bock, had promulgated a somewhat similar pictorial proclamation.

[23] *Id.* at 319.

[24] 164 Fed. 207 (C. C. S. D. N. Y., 1908).

[25] 12 Fed. 97 (C. C. S. D. N. Y., 1882).

[26] Gambrinus, for the information of those whose knowledge of beverages is more practical than theoretical, was the legendary inventor of the Teutonic nectar, lager beer.

Brown, J., though refusing an injunction on other grounds[27] observed that[28]

"The plaintiff's chromo in the present case is not a mere engraving or print of any article which the complainant offers for sale. It is a work of the imagination, and has such obvious artistic qualities as, in my judgment, render it fairly a subject of copyright, without regard to the use which the plaintiff has made or may intend to make of it. When the work in question is clearly one of artistic merit, it is not material, in my judgment, whether the person claiming a copyright expects to obtain his reward directly through a sale of the copies, or indirectly through an increase of profits to be obtained through its gratuitous distribution."

In *Schumacher* v. *Schwencke*[29] an injunction was actually granted against infringement of a copyright obtained by the complainant in a painting of a newsboy with a cigar stub in his mouth, lithographed copies of the same having been sold for use as cigar box labels. It was not established, however, that this was the sole use intended to be made of the painting, and there was, in fact, evidence to the contrary. The court, observing that the subject of the copyright was a painting, executed with considerable artistry, and of itself entitled to copyright, said that "The fact that copies may be utilized for advertising purposes does not change the character of the original."[30]

It remained, however, for the Supreme Court, in *Bleistein* v. *Donaldson Lithographing Co.*,[31] to establish definitely, in the face of virtually all the prior law on the subject, that advertising may be the subject of copyright. In that case the plaintiffs had copyrighted[32] three circus posters of the customary gaudiness of

[27] These being that, first, there was no showing that plaintiff held his copyright under the original author of the chromo, it being only "authors and inventors" who under the Constitution are directly entitled to copyright; and, second, that there was no infringement, since it did not appear that defendant had copied plaintiff's picture, but that both had copied the same foreign original, which was not copyrighted.

[28] *Id.* at 100.

[29] 25 Fed. 466 (C. C. S. D. N. Y., 1885).

[30] *Id.* at 467.

[31] 188 U. S. 239, 23 Sup. Ct. 298, 47 L. Ed. 460 (1918).

[32] Under the provisions of the former statute on the subject, Rev. Stat. §4952 (1875). The pertinent section reads as follows: "Sec. 4952. The author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same. . . . In the construction of

color and extravagance of design, representing respectively a ballet, a trick bicycle act, and a group of "living statues", all intended as advertisements of acts performed by persons connected with the Wallace Shows. An action was brought by the plaintiffs to recover the statutory damages for infringement. The Circuit Court of Appeals, affirming the judgment of the trial court,[33] had held[34] that this material was not copyrightable, since as a "mere advertisement" it was not "promotive of the useful arts" within the meaning of the constitutional provision. The court cited and followed *J. L. Mott Iron Works* v. *Clow*,[35] and distinguished *Yuengling* v. *Schile*[36] and *Schumacher* v. *Schwencke*.[37]

On appeal to the Supreme Court of the United States, this Judgment was reversed (Justices Harlan and McKenna dissenting), and the posters were held copyrightable. Said Mr. Justice Holmes, speaking for the Court:[38]

"The act, however construed, does not mean that ordinary posters are not good enough to be considered within its scope. The antithesis to 'illustrations or works connected with the fine arts' is not works of little merit or of humble degree, or illustrations addressed to the less educated classes; it is 'prints or labels designed to be used for any other articles of manufacture.' Certainly works are not the less connected with the fine arts because their pictorial quality attracts the crowd and therefore gives them a real use—if use means to increase trade and to help to make money. A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement."

It is now well recognized that the *Bleistein* case established a new rule in regard to the copyright of advertising, although for some time thereafter the courts tended to attempt to distinguish the older cases and explain them away.[39] For illustration, there is the case of *Da Prato Statuary Co.* v. *Giulinani Statuary Co.*,[40] wherein the plaintiff, having copyrighted its

this act the words 'engraving', 'cut', and 'print' shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent office."

[33] 98 Fed. 608 (C. C. Ky., 1898).

[34] Courier Lithographing Co. v. Donaldson Lithographing Co., 104 Fed. 993 (C. C. A. 6th, 1900).

[35] *Supra*, note 22.

[36] *Supra*, note 25.

[37] *Supra*, note 29.

[38] 188 U. S. 239, 251.

[39] Note (1922) 17 A. L. R. 760, 774.

[40] 189 Fed. 90 (C. C. Minn., 1911).

catalogue containing photographic illustrations of church statuary which it offered for sale, sought to enjoin infringement if its copyright by the defendant, which had copied some of plaintiff's cuts in its own catalogue. The court held that the illustrations were proper subjects of copyright, citing the *Bleistein* case. *Iron Works* v. *Clow*[41] was distinguished, the court saying that "the objects there illustrated [wash bowl, bath tub, slop jar, etc.] are very different from the objects illustrated in the calalogue in this case."[42] Aside from the sacred purposes to which church statuary is dedicated, it does not seem that the difference referred to by the court is necessarily very great; it has been the experience of the writer that much church statuary is as highly conventionalized and as lacking in real artistic merit or distinction as the bathroom appliances vended by the plaintiff in the *Clow* case; and it is, of course, relation to the useful arts, and not dedication to sacred purposes, which renders a work copyrightable. It would appear, therefore, that the earlier cases have, in effect, been overruled.

IV

Since *Bleistein* v. *Donaldson Lithographing Co.* there have been a number of decisions in which the federal courts have upheld the validity of advertising copyrights. In *National Cloak and Suit Co.* v. *Kaufman,*[43] the court, sustaining a copyright of a publication containing fashion plates used as advertisements, cited the *Bleistein* case as denying the defendant's contention that if a picture has no other use than that of a "mere advertisement", and no value aside from the function, it would not be promotive of the useful arts within the meaning of the Constitution, although it was said in the opinion that the plaintiff's pictures were more than "mere advertisements" of wearing apparel, having recognizable artistic merit.

Similarly, in *J. H. White Mfg. Co.* v. *Shapiro*[44] the defendant's contention was that a catalogue of brass electric fixtures was merely a trade list of articles of general merchandise, and as such not a proper subject for copyright protection. The

[41] *Supra*, note 22.
[42] 189 Fed. 90, 93.
[43] 189 Fed. 215 (C. C. M. D. Pa., 1911).
[44] 227 Fed. 957 (S. D. N. Y., 1915).

court held the illustrations copyrightable, relying on the *Bleistein* case. Augustus N. Hand, J., said: "These decisions [*Lamb* v. *Furniture Co.* and *Iron Works.* v. *Clow*] are not without much basis in reason; but I cannot see that distinction made by them in respect to catalogues for advertising is warranted by the strict language of the statute . . . Neither the merit nor the purpose of the print seems to be regarded by the language of the act."[45]

Thus, the court in *Stacher Lithographic Co.* v. *Dunston Lithographic Co.*[46] granted an injunction and accounting on a copyright obtained by the plaintiff therein in certain chromos or lithographs of ordinary garden vegetables (carrots, beats, etc.) which were used for advertising purposes. Defendant had a right to make lithographs of the identical vegetables, and to use them for advertising purposes, but it had no right to adopt plaintiff's copyrighted portrayals. "It makes no difference that the pictures in suit are intended for advertising articles of commerce . . . or that they possessed little artistic merit."[47] The court further held that the "print and label" law (Section 3 of the Act of 1874)[48] does not apply to chromos, but only to "engravings, cuts, and prints", and that therefore it was not necessary that plaintiff have registered its copyright in the Patent Office. In *Golden Rule, Inc.* v. *B. V. D. Co.*,[49] decided in 1917, wherein the plaintiff had copyrighted a print of a youthful Adonis wearing a suit of the underwear manufactured by plaintiff and had used the print for advertising purposes, the court ruled that the validity of the copyright was not in issue upon the pleadings, and held that the copyright had been infringed.

The question was again presented to the Supreme Court in the case of *L. A. Westerman Co.* v. *Dispatch Printing Co.*,[50] where the plaintiff, having copyrighted pictures of women's styles for newspaper advertising, sued for damages for infringement of the copyright. The Court did not discuss the validity of the copyright, but necessarily assumed it in holding that the defendant was liable.

---

[45] *Id.* at 958.
[46] 233 Fed. 601 (W. D. N. Y., 1916).
[47] *Id.* at 603.
[48] U. S. C. A., tit. 17, §63; see *supra* note 20.
[49] 242 Fed. 929 (C. C. A. 8th, 1917).
[50] 249 U. S. 100, 39 Sup. Ct. 194, 63 L. Ed. 499 (1919).

Again, in *Campbell* v. *Wireback*,[51] where the plaintiffs had copyrighted catalogues of orthopedic devices[52] manufactured by them, which catalogues were tastefully illustrated by engravings of these products (which must have been of considerable interest to the public, in view of the then recent conclusion of the Great War), it was held that the illustrations were copyrightable, it appearing that they had been executed by persons of "skill and artistic capacity." From this it might be inferred that had the engravings been the work of unskilled persons of no artistic capacity, they would not have been copyrightable. Such a conclusion, if that is what the court meant, would seem entirely incorrect, in view of the *Bleistein* and later cases, in which the courts have upheld the validity of copyrights of circus posters, of ordinary photographs of brass electric fixtures[53] and of statuary,[54] and of lithographs of common or garden vegetables.[55] It seems safe to say that had the plaintiff in *Campbell* v. *Wireback* copyrighted photographs of its products taken by an office boy of ordinary ability rather than engravings made by persons of "skill and artistic capacity" the copyright thus secured would have been sustained by the courts.

V

Thus far, it will have been observed, the cases which have been discussed in which advertising has been held a proper subject of copyright have all been cases in which the copyrighted matter has been of a pictorial or illustrative nature. That letterpress used for advertising is copyrightable has not been so clear,[56] but there appears little reason for making a distinction. It would appear that the right to copyright advertising letterpress would be most valuable where a manufacturer or dealer has made use of advertising containing striking or original phraseology of information which is of intrinsic value in addition to its selling effect. Such a case was *No-Leak-O Piston Ring Co.* v. *Norris*,[57] where the plaintiff had compiled a pamphlet contain-

[51] 269 Fed. 372 (C. C. A. 4th, 1920).
[52] Artificial legs, to the non-orthopedic laity.
[53] J. H. White Mfg. Co. v. Shapiro, *supra* note 44.
[54] Da Prato Statuary Co. v. Giuliani Statuary Co., *supra* note 40.
[55] Stecher Lith. Co. v. Dunston Lith. Co., *supra* note 46.
[56] Note (1922) 17 A. L. R. 760, 774.
[57] 277 Fed. 951 (C. C. A. 4th, 1921).

ing a list of the different makes of automobiles, with the size and type of piston ring required for each, designed primarily for advertising purposes but necessarily containing much technical information of use in repair shops and garages, and had copyrighted the same. To detect infringements, the plaintiff employed the interesting device of including in the list certain fictitious non-existing "trap" models, and caught defendant in the trap. It was held that the pamphlet was subject to copyright, being an original compilation of useful facts from primary sources, and much more than an ordinary price list.

In *Fargo Mercantile Co.* v. *Brichet and Richter Co.*[58] the plaintiff claimed copyright in a label on which was printed a fanciful emblem, the plaintiff's name, other printed advertising matter, and certain recipes for using plaintiff's product. The infringement complained of was the copying of these recipes by the defendant. Further infringement was restrained by the court and damages awarded. It was doubted whether that part of the label containing the emblem, etc., was copyrightable, this being a "mere advertisement"; but the court held that clearly the recipes were copyrightable, being "original compositions" which "serve a useful purpose, apart from the mere advertisement of the article itself." While the decision is doubtless correct in sustaining the copyright of the recipes, the language of the court is just as clearly wrong when it speaks of a "mere advertisement" as being uncopyrightable; such language harks back to the earlier decisions prior to the *Bleiestsin* case, which have now been virtually repudiated. It may well have been that the court in speaking thus was regarding the "emblem" referred to in the reported case as something in the nature of a trade mark. However, it was subsequently held in *Hoague-Sprague Corp.* v. *Frank C. Meyer Co.*[59] that the inclusion of a trade mark as part of an advertisement or label does not prevent the acquisition of a copyright to the whole. Sustaining a copyright of a shoe box label which it called artistically designed, the court in that case further said:[60]

"If, however, there was any doubt about that statement, *i. e.*, that the label was of original and artistic design, the copyright would still be valid, as it clearly is not a copy of any of the prior art offered in

[58] 295 Fed. 823 (C. C. A. 8th, 1924).
[59] 27 F. (2d) 176 (on motion, E. D. N. Y., 1928); 31 F. (2d) 583 (on final hearing, E. D. N. Y., 1928).
[60] 31 F. (2d) 583, 586.

evidence, and the originality required in case of copyright means little more than a prohibition of actual copying."

Such a view was also taken by the court in *Ansehl* v. *Puritan Pharmaceutical Co.*,[61] in which the plaintiff had copyrighted a newspaper advertisement consisting of photographs of toilet articles symmetrically arranged, with accompanying laudatory letterpress. The copyright was sustained as to the whole advertisement. The opinion includes an exhaustive review of the authorities, and recognizes that the *Bleistein* case "established a new and liberal standard with respect to the originality or artistic merit required to entitle illustrated advertising matter—now frequently referred to as 'commercial art'—to the protection of copyright statutes."[62]

VI

The English cases bearing on the subject of copyright of advertisements should be of interest to the American student of the problem, although it should be observed that that problem is not the same in the two countries. Because the power of Parliament to enact copyright legislation is not, as in the United States, restricted by constitutional provisions, there is no requirement that copyrighted material bear any relation to "science and the useful arts", and all that appears to be required is some slight degree of originality.[63] It would be expected, therefore, that the British courts would experience less difficulty than those of the United States in holding advertising copyrightables, and such, in fact, has been the case.

Earliest of the English cases appears to be *Hotten* v. *Arthur*,[64] decided in 1863. The plaintiff, a bookseller, had copyrighted a catalogue of "old and curious books", which contained not only a list of the books but also accounts of their histories and contents and anecdotes respecting them, all these being, accord-

[61] 61 F. (2d) 131 (C. C. A. 8th, 1932); *cert. denied* 287 U. S. 655, 53 Sup. Ct. 224, 77 L. Ed. 574 (1932). Discussed in (1932) 46 Harv. L. Rev. 332; (1933) 27 Ill. L. Rev. 827; (1933) 17 Minn. L. Rev. 327.

[62] *Id.* at 134.

[63] Note (1922) 17 A. L. R. 760, 774. It is interesting to note that the court in J. L. Mott Iron Works v. Clow, *supra* note 22, distinguished the English cases on this ground, i. e., that the British Parliament, unlike Congress, is restrained by no constitutional provisions on the subjects of patents and copyrights.

[64] 1 Hem. & M. 603, 71 Eng. Rep. 264 (Ch. 1863).

ing to the plaintiff, "the emanations of his own mind" and original with him. The court enjoined infringement of the copyright. The catalogue was not "mere dry lists of books" but contained material of intrinsic value which was the result of mental exertion and therefore copyrightable. Nor, the court opined, was it any defense that the copyrighted work was not itself offered for sale, but was merely used to promote the sale of the books mentioned in it.

In *Cobbett* v. *Woodward*,[65] however, where the plaintiff had copyrighted a catalogue containing engravings of furniture sold by him, with descriptive remarks thereon, the court refused to restrain the defendant from publishing a similar work in which many of plaintiff's engravings and a portion of his letterpress was copied outright. There is no copyright in an advertisement, the court held, and an injunction will not lie to restrain imitation of one except where the defendant attempts to pass off his goods as those of the plaintiff. This was merely an "illustrated inventory" of the plaintiff's goods, and the law, since it allows the defendant to sell the same articles, allows him to use the same advertisement. As to the letterpress, wherever it "bears the trace of original composition, it is entitled to protection, but not where it simply describes the contents of a warehouse, the exertions of the proprietor, or the common mode of using familiar articles."[66] *Hotten* v. *Arthur*[67] was not cited by counsel or referred to by the court, and appears to have been completely overlooked.

Three years later, in *Grace* v. *Newman*,[68] the English court, relying on *Hotten* v. *Arthur* and declining to follow *Cobbett* v. *Woodward*, sustained the validity of a copyright of a catalogue containing sketches of tombstones and intended to advertise the work of a monument mason. Since the court did not specifically overrule *Gobbett* v. *Woodward*, the English law remained in a state of uncertainty until the decision in *Maple and Co.* v. *Junior Army and Navy Stores*,[69] which sustained a copyright of an illustrated furniture advertising catalogue. Overruling *Cobbett* v. *Woodward*, the court held that advertising is copyrightable;

[65] L. R. 14 Eq. 407 (1872).
[66] *Id.* at 414.
[67] *Supra*, note 64.
[68] L. R. 19 Eq. 623 (1875).
[69] 21 Ch. D. 369 (1882). *Accord:* Davis v. Benjamin, [1906] 2 Ch. 491.

that "originality", not skill or merit, is the test whether a work is subject to copyright. A directory consisting of a collection of advertisements was held copyrightable in *Lamb* v. *Evans*,[70] but the court held that only the copyright of the headings was in the publisher, that of the advertisements themselves being in the advertisers. Otherwise, the court said, those who advertise for situations in the *Times* could not lawfully advertise in any other paper. Although the English cases seem to deal primarily with the copyright of catalogues, it appears also that advertising posters should be copyrightable in that country.[71] However, "cut-out" advertising show cards reproduced by litography have been held not to be copyrightable, being designs intended to be multiplied by an identical process and therefore capable of registration under the Patents and Designs Act, 1907, so that the Copyright Act of 1911 does not apply to them.[72]

VII

In general, the problems arising out of infringement of advertising copyrights and the solutions of those problems are sufficiently similar to the problems presented by infringement of other copyrights and the solutions thereof as to require little special study. However, some of the holdings of the courts in regard to infringement of advertising copyrights present distinctive features which should be of interest to the student of the subject. For example, it has been held no infringement of a copyright of an advertising card (with attached squares of paper to represent various colors of paints) to publish a similar card advertising one's own paints; this being a duplication, not of the plaintiff's card, but only of his method of advertising.[73] An exclusive right to employ a particular *method* of advertising cannot be acquired under the copyright laws. So, where the defendant did not copy plaintiff's dental advertising chart, but simply employed the same plan of advertising his own manufactures, there was no infringement; the plaintiff could not secure a monopoly of this plan through copyright.[74] Copyright

[70] [1892] 3 Ch. 462.
[71] Copinger, The Law of Copyright (7th ed., 1936) 67.
[72] Con Planck, Ltd. v. Kolynox, Inc., [1925] 2 K. B. 804.
[73] Ehret v. Pierce, 10 Fed. 553 (C. C. E. D. N. Y., 1880).
[74] S. S. White Dental Supply Co. v. Sibley, 38 Fed. 751 (C. C. E. D. N. Y., 1889).

of a catalogue containing cuts of designs for letterheads, etc., could not have the effect of prohibiting publication of other catalogues containing cuts of designs; the plaintiff could not copyright a system or method of selling a product, but could only copyright a set of original symbols or designs used to effect sales.[75]

Furthermore, there is no infringement where both the copyrighted matter and that allegedly infringing thereon were both copied or adapted from a common uncopyrighted source and the defendant did not in fact copy the plaintiff's advertisement.[76] The same is true where the defendant's work is an independent effort from the same general instructions as those given the plaintiff, and neither in fact copied from the other.[77] And there is, of course, no infringement where the defendant does not copy plaintiff's advertisement, but while ignorant of its existence makes one of his own which is similar.[78] But the defendant is guilty of infringement where he copies from the work of another who in turn has copied the copyrighted work of the plaintiff, even though the defendant has no knowledge that such is the fact.[79]

Of course, where the copyrighted advertisement (if a picture) represents some actual, visible person or thing; the plaintiff cannot monopolize the right to picture it; the defendant may make his own reproduction of the original, being precluded only from copying that of the plaintiff.[80] "Others are free to copy the original. They are not free to copy the copy."[81] It appears also that where the defendant has an equal right with the plaintiff to manufacture or sell the identical goods the advertisement of which plaintiff has copyrighted, it is no infringement for the defendant to publish his own advertisement illustrating his own goods, providing his illustrations are not in fact copied

[75] Kaeser & Blair v. Merchants' Assn., 64 F. (2d) 575 (C. C. A. 6th, 1933).

[76] Yuengling v. Schile, 12 Fed. 97 (C. C. S. D. N. Y., 1882).

[77] McCarthy v. L. Adler Bros. & Co., 227 Fed. 630 (S. D. N. Y., 1915).

[78] S. S. White Dental Supply Co. v. Sibley, *supra* note 74.

[79] Norris v. No-Leak-O Piston Ring Co., 271 Fed. 536 (Md. 1921).

[80] Bleistein v. Donaldson Lithographing Co., 188 U. S. 239, 23 Sup. Ct. 298, 47 L. Ed. 460 (1903); National Cloak & Suit Co. v. Kaufman, 189 Fed. 215 (C. C. M. D. Pa., 1911); J. H. White Mfg. Co. v. Shapiro, 227 Fed. 957 (S. D. N. Y., 1915); Stecher Lith. Co. v. Dunston Lith. Co., 233 Fed. 601 (W. D. N. Y., 1916).

[81] Bleistein v. Donaldson Lithographing Co., 188 U. S. 239, 249.

from the plaintiff's copyrighted advertisement.[82] And this is true even though the defendant's goods were in fact designed from plaintiff's copyrighted illustrations; the plaintiff cannot, by copyrighting his advertisements, create a monopoly in the manufacture or sale of unpatentable articles.[83]

The test of infringement of a copyrighted advertisement or label is whether the defendant's label would mislead an ordinarily prudent purchaser into buying the defendant's goods for those of the plaintiff.[84] It is not necessary, to constitute infringement, that the infringing advertisement be identical with that which is infringed; paraphrasing may be an infringement, or, in the case of pictures, a picture which is substantially similar although not an exact copy of the copyrighted picture.[85] Nor is it necessary that the defendant have copied the whole composition; a copy of a substantial part constitutes infringement,[86] and where the plaintiff has copyrighted an entire catalogue, each cut contained therein is entitled to protection.[87] Separate publications of the same copyrighted advertising matter by the same defendant amount to separate infringements, one for each publication.[88] Unauthorized use by a jobber of a manufacturer's copyrighted print for the purpose of advertising the manufacturer's own product has been held an infringement of the copyright; had the print been merely registered as a trade mark, the use would have been proper.[89]

Remedies given by the Copyright Act for infringement are threefold: injunction, accounting for profits arising out of the infringement, and damages.[90] Where actual damages cannot be ascertained, then, under the statute, damages are such "as to

[82] Collender v. Griffith, Fed. Cas. No. 3,000 (C. C. S. D. N. Y., 1873); Lamb v. Grand Rapids School Furniture Co., 39 Fed. 474 (C. C. W. D. Mich., 1889); National Cloak and Suit Co. v. Standard Mail Order Co., 191 Fed. 528 (C. C. S. D. N. Y., 1911).

[83] Lamb v. Grand Rapids School Furniture Co., *supra* note 82.

[84] William Faehndrich, Inc. v. Wheeler Riddle Cheese Co., 34 F. (2d) 43 (E. D. N. Y., 1929).

[85] Ansehl v. Puritan Pharmaceutical Co., 61 F. (2d) 131 (C. C. A. 8th, 1932), *cert. denied* 287 U. S. 666, 53 Sup. Ct. 224, 77 L. Ed. 574 (1932).

[86] *Ibid.*

[87] Da Prato Statuary Co. v. Giuliani Statuary Co., 189 Fed. 90 (C. C. Minn., 1911).

[88] L. A. Westermann Co. v. Dispatch Printing Co., 249 U. S. 100, 39 Sup. Ct. 194, 63 L. Ed. 499 (1919).

[89] Golden Rule, Inc. v. B. V. D. Co., 242 Fed. 929 (C. C. A. 8th, 1917).

[90] U. S. C. A., tit. 17, §25.

to the court shall appear just'' in the particular case, considering the nature of the copyright, the circumstances of the infringement, and the like.[91] In such a case, the compensation to which the plaintiff is entitled is virtually within the discretion of the trial judge.[92]

In awarding these remedies, the ''clean hands'' doctrine of equity has, at least once, been applied. In *Stone and McCarrick* v. *Dugan Piano Co.*[93] the plaintiff, having copyrighted a book of advertisements constituting a selling scheme to be used by dealers in connection with sales of pianos, which advertisements contained extravagant statements calculated to mislead the public, sued for an injunction, an accounting, and damages for infringement. The court dismissed the bill, saying that ''if in any case mere advertisements are copyrightable, the law should extend its protection to those only that speak the truth, and certainly not to that class of advertising matter the effect of which is to mislead and deceive the public.'' The decision seems sound and in accordance with equitable principles, although it appears to have no specific statutory authorization.

VIII

To what extent copyright is utilized as a device to protect advertising, the writer is not prepared to say. Most advertising, no doubt, is not copyrighted at the present time, although there is probably some reason to believe that the proportion of copyrighted advertising is increasing, and that it will continue to do so in the future. If so, and the law of advertising copyrights continues to develop, will it be too much to expect that the doctrine of *Stone and McCarrick* v. *Dugan Piano Co.* will be followed, and that the owners of such copyrights will be required to come into court with clean hands?

---

[91] *Ibid.*, L. A. Westermann Co. v. Dispatch Printing Co., *supra* note 88.

[92] No-Leak-O Piston Ring Co. v. Norris, 277 Fed. 951 (C. C. A. 4th, 1921).

[93] 220 Fed. 837 (C. C. A. 5th, 1915).