



University of Baltimore Law Review

Volume 3
Issue 2 Spring 1974

Article 9

1974

Recent Developments: Copyright—Extensive Photoduplication of Copyrighted Scientific Journals by Libraries Does Not Constitute Copyright Infringement. *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (1973)

Judith D. O'Neill
University of Baltimore School of Law

Follow this and additional works at: <http://scholarworks.law.ubalt.edu/ublr>



Part of the [Law Commons](#)

Recommended Citation

O'Neill, Judith D. (1974) "Recent Developments: Copyright—Extensive Photoduplication of Copyrighted Scientific Journals by Libraries Does Not Constitute Copyright Infringement. *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (1973)," *University of Baltimore Law Review*: Vol. 3: Iss. 2, Article 9.

Available at: <http://scholarworks.law.ubalt.edu/ublr/vol3/iss2/9>

This Article is brought to you for free and open access by ScholarWorks@University of Baltimore School of Law. It has been accepted for inclusion in University of Baltimore Law Review by an authorized administrator of ScholarWorks@University of Baltimore School of Law. For more information, please contact snolan@ubalt.edu.

taken a narrow view of the types of probationary conditions which are unduly harsh and has thereby effectively limited the lower court's discretion in determining a proper remedy. However, the determination that the Federal Probation Act is applicable to corporations remains as a previously unexplored means of dealing with a complex and unusual type of criminal. Although the *Atlantic Richfield* court dismissed with disappointing brevity the issues of probation conditions more onerous than sentence and a defendant's right to refuse probation, the use of probation to control the corporate entity is a significant idea worthy of further use and development by the judiciary. A comprehensive view of the Federal Probation Act which encompasses restitution by the criminal to aggrieved parties, supervision of the criminal by the courts, and the eventual reformation of the criminal into a positive member of society logically includes the violations of the corporate entity. As long as other means of dealing with the illegal acts of corporations remain ineffective, the use of probation deserves further development.

Rignal W. Baldwin

COPYRIGHT—EXTENSIVE PHOTODUPLICATION OF COPYRIGHTED SCIENTIFIC JOURNALS BY LIBRARIES DOES NOT CONSTITUTE COPYRIGHT INFRINGEMENT. *WILLIAMS & WILKINS CO. V. UNITED STATES*, 487 F.2d 1345 (1973).

The speed and ease of reproduction by modern photoduplication equipment has resulted in an increase in reproduction which has posed a problem to copyright holders. Photocopying diminishes the need for the original work and impairs the protection afforded the owner of the copyright. It poses a growing threat to the balance between the constitutional right of the people to the free dissemination of information¹ and the statutory right of the copyright holder to control the use of his work.² Unfortunately, the present copyright act³ is vague

1. U.S. CONST. Art. I, § 8 provides:

The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited times to Authors and Inventors the exclusive Right to their respective writings and Discoveries.

2. 17 U.S.C. § 1(a) *et. seq.* (1970).

3. *Id.* The present Copyright Act was originally adopted in 1909. Since that time several attempts at revision have been made beginning with the amendments proposed before the Berne Convention in 1924. The Dallinger, Perkins and Vestal Bills were efforts to adhere to the Berne Convention, as a result of which copyright protection was extended to the motion picture industry. Following three more revisionary bills from 1931-39, and amendments in accord with the 1954 Universal Copyright Convention, the Copyright Act is still silent on what types and scope of copying, if any, do *not* constitute copyright infringement. For the legislative history of U.S. copyright law see SENATE SUBCOMM. ON PATENTS, TRADEMARKS, AND COPYRIGHTS, THE HISTORY OF U.S.A. COPYRIGHT LAW REVISION FROM 1901 to 1954, S. Res. 53, Study No. 1, 86th Cong., 1st Sess. 1-19 (1960).

on the rights and privileges of the parties in this situation. Therefore, until statutory clarification is effected, the issue must be settled by the courts. The first case to challenge massive reproduction of copyrighted material is *Williams & Wilkins Co. v. United States*.⁴

The Williams & Wilkins Co. (W & W) was a major publisher of medical journals, four of which were the subject of this action. The articles in these journals were submitted individually by their authors in manuscript form to W & W who compiled them into journal issues and distributed the journals by subscription. Because of the esoteric nature of the journals, they commanded a very limited reading public.⁵ Most of the revenue received from these journals came from subscriptions. Notice of W & W's copyright appeared at the beginning of every issue and occasionally preceded the individual articles. Co-defendants, the National Institute of Health (NIH) and the National Library of Medicine (NLM), were two of W & W's subscribers. NIH maintained a large technical library that, while used primarily by NIH researchers, was also available to the public. The Library had an extensive photocopying service for the benefit of the NIH staff. The library's policy was to reproduce only a single copy of an article per request, and only one article per journal issue. Exceptions to this policy were routinely made as long as substantially less than an entire journal issue was copied. The library received a sizable photocopy budget from the federal government and accordingly did not charge the consumer for the material copied.

The National Library of Medicine was established by Congress "to aid the dissemination and exchange of scientific and other information important to the progress of medicine and the public health. . . ."⁶ It participated in an interlibrary loan program and, like NIH, maintained a policy of furnishing only one copy of an article per request and substantially less than an entire journal issue on any given request. NLM, like NIH, made exceptions to their rule. It was also the policy of NLM not to copy articles from journals which were on a "readily available list" (on which list plaintiff's journals appeared) or articles published within the past five years (the oldest of plaintiff's articles at the time of photoduplication was twenty-two months). Again, exceptions were routinely made. NLM's consumers included commercial organizations, particularly drug companies, as well as students, universities, medical schools, and other libraries.⁷

The Williams & Wilkins Co. alleged that the defendant's procedure for photoduplicating its articles was wholesale copying and constituted

4. 487 F.2d 1345 (1973); *petition for cert. filed*, (U.S., Feb. 20, 1974) (No. 73-1279).

5. The most widely-subscribed to journal of the group in contest here is *Gastroenterology*, which is perhaps the leading journal on the subject in the world. It commands a subscription list of only about 7,000.

6. 42 U.S.C. § 275 (1970).

7. In 1970 N.I.H. photocopied an estimated 93,000 articles and L.L.M. filled about 120,000 requests for photocopied articles. These copies included plaintiff's articles.

copyright infringement.⁸ The Commissioner of the Court of Claims upheld this claim, but was reversed on appeal in a 4-3 decision in favor of the United States.⁹

The question in this case was did NIH and NLM infringe upon the copyright of W & W's medical journals by reproducing articles for third persons without the permission of W & W? The difficulty in the determination of that issue was that not every use of a copyrighted material without the holder's permission constitutes infringement.¹⁰ Whether the use is excused depends upon the court's interpretation of the circumstances of a given case in light of legal precedent.¹¹ Courts have been guided by such factors as the amount of the taking, how much the reproduction satisfies the need for the original, the use to which the copy is put, the potential loss to the copyright holder, and the nature of the material copied.¹² When these factors weighed in favor of the copier, the courts have ruled the taking a "fair use" and relieved the copier of infringement liability.¹³ But this formula is an oversimplification of the doctrine of fair use as the application of each factor to the facts of a case, or a body of cases, is not easily accomplished. How much is too much, what relative weight should be given each factor, and which factors come to bear on the propriety of a use are considerations which have caused Congress to avoid the issue of fair use and bewildered the courts in copyright cases.¹⁴

The application of "fair use" to library reproduction of copyrighted material is in need of resolution.¹⁵ The court in the *Williams & Wilkins* case recognized this need in what it called a "ground-breaking copyright infringement action . . . against the United States of America."¹⁶ It carefully analyzed the history of copyright law, its roots in the United States Constitution as a safeguard of the public's right to free dissemination of information, and the gradual development of the doctrine of fair use. The court synthesized the evidence and made a determination that massive photocopying by libraries of copyrighted scientific journals without the owner's permission did not constitute copyright infringement. The majority opinion was heavily influenced by the fact that the subject matter was scientific.¹⁷ The court reasoned

8. This action was brought under 28 U.S.C. § 1498(b) (1970). Prior to 1960 this section provided for only patent actions to be brought against the United States. Pursuant to the Copyright Act, it was amended to include actions against the U.S. for monetary damages for copyright infringement.
9. Judges Skelton, Kashiwa and Bennett joined in the extensive majority opinion written by Judge Davis. The dissent, written by Chief Judge Cowan and joined in by Judge Kunzig, was equally in-depth and comprehensive. Judge Nichols wrote an independent dissent.
10. *Loew's Inc. v. Columbia Broadcasting System, Inc.*, 131 F. Supp. 165, 175 (S.D. Cal. 1955); *Karll v. Curtis Pub. Co.*, 39 F. Supp. 836, 837 (E.D. Wis. 1941).
11. *Loew's Inc. v. Columbia Broadcasting System, Inc.*, 131 F. Supp. 165, 174 (S.D. Cal. 1955).
12. *Mathews Conveyor Co. v. Palmer-Bee Co.*, 135 F.2d 73, 85 (6th Cir. 1943).
13. M. B. NIMMER, *THE LAW OF COPYRIGHT* § 145 at 645-48 (1972 ed.).
14. *Id.* at 643. See also *Williams & Wilkins Co. v. United States*, 487 F.2d at 1363.
15. *Hearings on S. 1361 Before the Subcomm. on Patents, Trademarks, and Copyrights of the Senate Comm. on the Judiciary*, 93d Cong., 1st Sess., Statements at 92-97 (1973).
16. 487 F.2d at 1346.
17. *Id.* at 1357, 1358, 1359.

that the free and unobstructed dissemination of scientific information more adequately advanced the constitutional right of the people to receive the benefit from such scientific information than did the strict enforcement of the plaintiff's copyright.¹⁸ This, coupled with the fact that NIH and NLM received no profit from the copies, gave the court justification to determine that the use made was fair in spite of the fact that an entire, verbatim copy was made.¹⁹

Evidently aware of the widespread implications of its opinion and apprehensive of the possible limitations of the factual situation in *Williams & Wilkins*, the court retreated in the last paragraphs of its opinion and refused to establish a hard and fast rule. The court said that *Williams & Wilkins* was to be cited as no more than an interpretation of the particular facts of that case.²⁰ The court expressed the hope that the opinion would serve as a "holding operation"²¹ until the legislature assumes the responsibility of definition in this area, a duty which it has avoided since 1909.

Various tests of "fair use" have been employed to determine whether the taking was substantial.²² A "Gentlemen's Agreement" between publishers and consumers, discussed in the *Williams & Wilkins* dissent, included a qualification on copying which stipulated that the taking must not be so substantial as to constitute infringement.

While the right of quotation without permission is not provided in law, the courts have recognized the right to a "fair use" of book quotations, the length of a "fair" quotation being dependent upon the type of work quoted from and the "fairness" to the author's interest. *Extensive quotation is obviously inimical to the author's interest * * * It would not be fair to the author or publisher to make possible the substitution of the photostats for the purchase of a copy of the book itself either for an individual library or for any permanent collection in a public or research library. Orders for photocopying which, by reason of their extensiveness or for any other reasons, violate this principle should not be accepted.*²³

The dissenters agreed that there can be no evaluation of the elements of fair use if the copying is of an entire work. Therefore, they refused to consider the facts that the subject matter in *Williams & Wilkins* was scientific, that the defendants made no profit from the copying, and

18. *Id.* at 1359.

19. *Id.* at 1354.

20. *Id.* at 1362.

21. *Id.* at 1363.

22. *Henry Holt & Co. v. Liggett & Myers Tobacco Co.*, 23 F. Supp. 302, 303-04 (E.D. Pa. 1938).

23. 487 F.2d at 1379-80. The "Gentlemen's Agreement" was drafted in 1935 as a result of meetings between libraries and various members of the publishing industry. While it does not have the effect of law and has never been involved in judicial proceedings, it is indicative of what is reasonable and customary in the field.

that the plaintiff failed to prove actual damages. These are irrelevant factors when the discussion is one of "wholesale copying."²⁴

In spite of the court's reluctance to establish a concrete and uniform ruling which would unambiguously extend the traditional protection of the copyright holder to mass photoduplication, the decision in *Williams & Wilkins* is a landmark in copyright law, and the error of that decision should be examined.

The court erred in investigating the factors relating to fair use, since a substantial taking of an entire work precludes fair use. Different amounts of copying are allowed by the courts in different circumstances. If the material copied is scientific or educational, for example, the courts have applied a liberal standard to how much can be copied before infringement occurs.²⁵ If the entire work is copied, however, as was the case in *Williams & Wilkins*, the surrounding circumstances are irrelevant. "Wholesale" copying can never be fair use.²⁶

Copyright protection did not exist at common law.²⁷ The author had a property right in his unpublished work, but once the work was published, that right was lost and the work entered into the public domain.²⁸ The copyright protection which exists today is purely statutory.²⁹ Both parties to the action in *Williams & Wilkins* agreed that the interpretation of that statute must be based on the purpose of the constitutional provision empowering Congress to enact the law.³⁰

The purpose in granting copyright protection is "[t]o promote the Progress of Science and useful Arts"³¹ To implement that end the courts "must occasionally subordinate the copyright holder's interest in a maximum financial return to the greater public interest in the development of art, science, and industry."³² It has been suggested that the limitation of fair use on the statutory privilege of the copyright holder is based on the first and ninth amendments to the Constitution.³³ The constitutional argument is that the first amendment right of the American people to freedom of speech coupled with their ninth

24. 487 F.2d at 1366.

25. *Henry Holt & Co. v. Liggett & Myers Tobacco Co.*, 23 F. Supp. 302, 304 (E.D. Pa. 1938).

26. *Leon v. Pacific Tel. & Tel.*, 91 F.2d 484, 486 (9th Cir. 1937).

27. *Jefferys v. Boosey*, 4 H.L. Cas. 815, 24 L.J. Ex. 81 (1854). See also *Mazer v. Stein*, 347 U.S. 201, 214 (1954).

28. *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339 (1908).

29. Copyright Act of 1909, 17 U.S.C. §§ 1-216 (1970).

30. Cf. *Bleinstein v. Donaldson Lithography Co.*, 188 U.S. 239, 249 (1903). The Constitutional provision empowering Congress to enact a copyright statute is cited *supra* note 1.

31. *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 307 (2d Cir. 1966); *Mathews Conveyor Co. v. Palmer-Bee Co.*, 135 F.2d 73 (6th Cir. 1943). Some courts have stated that any reward to the copyright holder which is precipitated by the statutory protection is secondary to the main consideration of encouragement of the production of literary works. *United States v. Paramount Pictures Inc.*, 334 U.S. 131, 158 (1948). *Greenbie v. Noble*, 151 F. Supp. 45, 67 (S.D.N.Y. 1957).

32. *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 543-44 (2d Cir. 1964).

33. Brief for Nat'l Educ. Ass'n as *Amicus Curiae* at 16-17, 31-34, *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (1973).

amendment right to free dissemination of information reduce the copyright holder's protection to a privilege granted in the interest of furthering the constitutional right of the people. The reasoning is that copyright protection will encourage authors to disseminate their information so "that the world may not be deprived of improvements, nor the progress of the arts be retarded."³⁴ In no case, however, is the encouragement of the author to frustrate the very purpose for which it exists, to afford the people free and unobstructed access to information.³⁵

The defendant in *Williams & Wilkins* used the above argument to indicate that the public right to the information in the journals is more dependent upon the photocopying service they provide than it is on the protection of plaintiff's copyright.³⁶ While it cannot be denied that the purpose of copyright protection is to further the sciences and the arts, the approach of the majority opinion will limit the flow of information to the public. Free and unobstructed dissemination of copyrighted information is as dependent upon the publisher's profit in printing it as it is upon the author's decision to release it. The legislative purpose of copyright law is to encourage authors and publishers to release their work so that the people have *access* to information, pursuant to their constitutional right.³⁷ It is difficult to imagine how a publisher of medical journals cannot be involved in the "development of art, science and industry,"³⁸ nor how the American people can avail themselves of their right to access without his services. It is only reasonable, therefore, that a publisher be sufficiently compensated for those services, so that he may continue profitably to publish the information to which the people have a constitutional right. In *Mazer v. Stein*, Mr. Justice Reed stated:

"The copyright law, like the patent statutes, makes reward to the owner a secondary consideration." However, it is "intended definitely to grant valuable enforceable rights to authors, publishers, etc., without burdensome requirements; to afford greater encouragement to the production of literary (or artistic) works of lasting benefit to the world."³⁹

The cases which have addressed themselves to the constitutional purpose for copyright law have done so predominantly in support of

34. See *Henry Holt & Co. v. Liggett & Myers Tobacco Co.*, 23 F. Supp. 302, 304 (E.D. Pa. 1938).

35. Brief for Nat'l. Educ. Ass'n as *Amicus Curiae* at 10, *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (1973).

36. Brief for Defendant at 29, *Williams & Wilkins Co. v. United States*, 172 U.S.P.Q. 670 (1972).

37. Brief for Nat'l. Educ. Ass'n as *Amicus Curiae* at 53, *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (1973).

38. *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 543-44 (2d Cir. 1964).

39. 347 U.S. 201, 219 (1954) (citations omitted).

their decision to uphold the defense of fair use.⁴⁰ In those cases, the issue was the substantiality of the taking. The doctrine of "fair use" itself has been described as a judicial attempt "to bring some order out of the confusion surrounding the question of *how much* can be copied."⁴¹ In an effort to define when the defense of fair use is appropriate for examination, the courts have adopted a policy consistent with the constitutional argument. In general, when the taking is for the furtherance of the sciences or the arts, a broader range of use will be allowed in the evaluation of substantiality than will be allowed for commercial uses.⁴²

In *Henry Holt & Co. v. Liggett & Myers Tobacco Co.*,⁴³ where a tobacco company used three lines of a copyrighted medical book in an advertisement, the court finding infringement, ruled that to be a substantial taking the material used need not be the whole of even a large part thereof. The court recognized the broader scope given to substantiality in the case of scientific works, but declined to place the defendant's advertisement in that category. The court stated that neither the innocent intent of the defendant nor his acknowledgement of the authorship of the sentences used would be a valid defense where the taking was substantial.⁴⁴

In *Hill v. Whalen & Martel*,⁴⁵ which dealt with the infringing use of cartoon characters obviously resembling the copyrighted Mutt and Jeff figures, the court used as its test of fair use "whether or not so much has been reproduced as will materially reduce the demand for the original."⁴⁶ That court reasoned that if the copied work could effectively replace the original, injury must logically result to the copyright holder, giving him an action for infringement. Infringement

40. *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966) (defendant's insubstantial use of biographic information about Howard Hughes, some of which defendant's author used in production of his book on Hughes held protected); *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541 (2d Cir. 1964) (use of same meter but not lyrics as plaintiff's song in a parody created by defendant, allowed); *Greenbie v. Noble*, 151 F. Supp. 45 (S.D.N.Y. 1957) (defendant's insubstantial taking held not to constitute infringement in a book concerning a historical figure); *Mathews Conveyor Co. v. Palmer-Bee Co.*, 135 F.2d 73 (6th Cir. 1943) (copying of engineering sketches from plaintiff's copyrighted catalogue by defendant held too insubstantial to constitute infringement).

41. 14 NOTRE DAME LAWYER 443, 449 (1939) (emphasis added).

42. *Loew's, Inc. v. Columbia Broadcasting System, Inc.* 131 F. Supp. 165, 176 (S.D. Cal. 1955), *aff'd sub nom. Benny v. Loew's, Inc.*, 239 F.2d 532 (9th Cir. 1956), *aff'd by an equally divided court*, 356 U.S. 43 (1958); *Henry Holt & Co., v. Liggett & Myers Tobacco Co.*, 23 F. Supp. 302, 304 (E.D. Pa. 1938).

43. 23 F. Supp. 302, 303 (E.D. Pa. 1938).

44. *Id.* Judge Maris also noted that plaintiff was not required to show actual damages as a requisite to a judgment in his favor. *Id.* at 304. The majority opinion in the *Williams & Wilkins* case found the plaintiff's failure to prove actual damages to be influential in their decision. 17 U.S.C. § 101 provides in pertinent part:

[O]r in lieu of actual damages and profits, such damages as to the court shall appear to be just, and in assessing such damages the court may, in its discretion, allow the amounts as hereinafter stated . . .

45. 220 F. 359 (S.D.N.Y. 1914).

46. *Id.* at 360.

has been found where the details of a song were substantially similar to a copyrighted song,⁴⁷ and where the intricacies of a copyrighted dramatic expression appeared in similar form in a subsequent play.⁴⁸

Three cases clearly declared that where the taking was considered substantial, the doctrine of "fair use" would not apply. In *Leon v. Pacific Telephone & Telegraph*,⁴⁹ where the defendant rearranged telephone numbers derived from plaintiff's copyrighted directory, the court ruled conclusively on the issue of substantial taking. In response to the defense of fair use the court said:

It is not necessary in the case before us to discuss generally the question of what constitutes "fair use." Obviously, every publication copyrighted admits of many uses which do not constitute infringement. Counsel have not disclosed a single authority, nor have we been able to find one, which lends any support to the proposition that wholesale copying and publication of copyrighted material can ever be fair use. . . .

The court quoted this statement emphasizing the word "ever" in *Benny v. Loew's, Inc.*,⁵⁰ where Jack Benny asserted the defense of fair use due to years of custom in his burlesque television adaptation of the play "Gas Light." More recently in *Wihtol v. Crow*,⁵¹ whose facts more closely resemble the situation in the *Williams & Wilkins* case, the court refused to define fair use but held that "it is inconceivable . . . that the copying of all or substantially all, of a copyrighted work can be held to be a "fair use" merely because the infringer has no intent to infringe. . . ."⁵² In that case, a school music director rearranged the author's song for no profit and with no intent to infringe upon the existing copyright. He duplicated fifteen copies of the rearrangement which he distributed to the students in his choral group. He did the same for the Methodist church where he worked. He then wrote to the author asking him if he would be interested in receiving a copy, to which letter the author responded with an infringement action which was upheld on the basis of substantial taking.

The proposition that fair use is the opposite of substantial taking appears easy to apply. However, the difficulty in determining what is substantial has led courts to examine other evidence.⁵³ The potential damage to the sale of the author's work persuaded the court in one

47. *Wihtol v. Wells*, 231 F.2d 550 (7th Cir. 1956).

48. *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir. 1936), *cert. denied*, 298 U.S. 669 (1937). Judge Learned Hand made a distinction between the uncopyrightable theme and ideas of a work and the copyrightable expression of those ideas. For a discussion of court rulings on the adaptation of a theme versus the use of an expression see *Shipman v. R.K.O. Pictures, Inc.*, 100 F.2d 533 (2d Cir. 1938).

49. 91 F.2d 484, 486 (9th Cir. 1937).

50. 239 F.2d 532, 536 (9th Cir. 1956), *aff'd by an equally divided court*, 356 U.S. 43 (1958).

51. 309 F.2d 777 (8th Cir. 1963).

52. *Id.* at 780.

53. M. B. NIMMER, *THE LAW OF COPYRIGHT* § 145 at 643-48 (1972 ed.).

case,⁵⁴ while the use to which the copy was put was determinative in another.⁵⁵ In *Karll v. Curtis Publishing Co.*,⁵⁶ in which the latter element was controlling, the court found that the reproduction of the chorus of the author's Green Bay Packers theme song in a magazine article boosting the Packers was only an "incidental" use of the lines copied. The court further stated that they did not compete with the song itself, particularly in view of the absence of the music. This last consideration seems to amount to a determination of substantial use.

Combining the elements of potential damage to the author's sales with "incidental" use, the court upheld fair use where the satirized lyrics of an author's song appeared in a humor magazine⁵⁷ but rejected it where a song parody was published in a song sheet.⁵⁸ In the case of the former, the parody could not effectively fulfill the demand for the original, while in the case of the latter, it could.

Finally, it has been generally acknowledged that the defense of fair use is applicable to literary criticism regardless of how substantial the taking is.⁵⁹ This principle has been accepted because the criticism has no potential for replacing the demand for the original. In view of the fact that the defendants' copying in the *Williams & Wilkins* case was not only substantial, but complete, it would appear that the only possibility for a defense of fair use would be an unprecedented extension of the literary criticism doctrine to use for research and educational purposes. The element threatening this link is the inexhaustable and boundless reach of photocopied material which is used *entirely* as a replacement for the original. While this is the first case to be brought in the shadow of modern photocopy technology,⁶⁰ the judicial precedent and

54. See *Public Affairs Assoc., Inc. v. Rickover*, 284 F.2d 262 (D.C. Cir. 1960), *vacated for insuff. record*, 369 U.S. 111 (1962); *Hill v. Whalen & Martell, Inc.*, 220 F. 359 (S.D.N.Y. 1914).

55. *Karll v. Curtis Publishing Co.*, 39 F. Supp. 836 (E.D. Wis. 1941).

56. *Id.*

57. *Berlin v. E.C. Publications, Ind.*, 329 F.2d 541 (2d Cir. 1964).

58. *Leo Feist, Inc. v. Song Parodies, Inc.*, 146 F.2d 400 (2d Cir. 1944).

59. *Consumers Union of the United States v. Hobart Mfg. Co.*, 189 F. Supp. 275, 278 (S.D.N.Y. 1960).

60. A case involving advanced technology in cable television and its effects on copyright law is *Fortnightly Corp. v. United Artists*, 392 U.S. 390 (1968). There the Supreme Court held that the reception and distribution of television signals by a cable television system did not constitute "performance" necessary for copyright infringement. In the recent case, *Columbia Broadcasting System Inc. v. Teleprompter Corp.*, 94 S.Ct. 859 (1974), the Supreme Court again found no copyright infringement by CATV for the reception and rebroadcasting of C.B.S. signals. Mr. Justice Stewart concluded that regardless of the distance of the original transmitter from the receiving CATV, a broadcast made "public for simultaneous viewing" can be received and retransmitted by CATV without infringement upon the copyright of the original broadcaster. This decision, while not bearing directly on massive photoduplication by libraries, shows an inclination of the court to favor a public service motive to the sacrifice of copyright protection. It is not unlikely that such an inclination will prevail against the *Williams & Wilkins Co.* if the Supreme Court grants *certiorari*.

legislative purpose discussed above indicate that the extension of the literary criticism exception here seems inappropriate and unlikely.

In order to apply the argument of substantial taking to preclude the defense of fair use in the *Williams & Wilkins* case, it is necessary to determine if an article has the status of a complete copyrightable work.⁶¹ The copyright statute itself, and its interpretation by the courts, lends some insight into this determination. The pertinent section provides in part:

The copyright upon component works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if each part were individually copyrighted under this title.⁶²

Because an article is a component "part"⁶³ of a periodical capable of individual copyright protection,⁶⁴ the test of substantiality is generally applied not only to each issue of a periodical but to every article therein as well.⁶⁵ This principle is further evidenced when one realizes that the author of each manuscript may copyright his work and assign both the work and the copyright protection to the publisher, leaving the latter with a compilation of individually copyrighted works which he may then copyright in its cumulative form.

Therefore, since the test of substantiality is applicable to individual articles and since a substantial taking cannot be fair use, W & W should have prevailed. For the Court of Claims to have decided that the defendants' use of W & W's copyrighted articles was fair the court had to establish a new, and dangerous, precedent that copyright protection may be ignored when the copier is non-profit and the material copied is scientific.

The court relied heavily upon the fact that plaintiff showed no actual

61. Brief for plaintiff at 23, *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (1973).

62. 17 U.S.C. § 3 (1970), Protection of Component Parts of Works Copyrighted; Composite Works or Periodicals:

The copyright provided by this title shall protect all the copyrightable component parts of the work copyrighted, and all matter therein in which copyright is already subsisting, but without extending the duration or scope of such copyright.

The copyright upon composite works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if each part were individually copyrighted under this title.

63. See, e.g., *King Features Syndicate v. Fleischer*, 299 F. 533 (2d Cir. 1924).

64. *Markham v. A.E. Borden Co.*, 206 F.2d 199 (1st Cir. 1953). In this case defendant copied nine items of a copyrighted catalogue containing several hundred items. The court explained that if each item were not viewed as the subject of its particular copyright, the protection of the whole would be meaningless. 206 F.2d at 202.

65. *Hedeman Products Corp. v. Tap-Rite Products*, 228 F. Supp. 630, 634 (D.N.J. 1964). However, in response to a request for summary judgment, the court refused to rule conclusively on the component part issue where the defendant had photocopied the title, editorial page masthead and the leading editorial of an issue of the *Herald Tribune*. *New York Tribune v. Otis & Co.*, 39 F. Supp. 67 (S.D.N.Y. 1941).

damages and that a 1962 study found that photocopying had no adverse effects on publishers of copyrighted material.⁶⁶ The court reasoned that since students have traditionally been allowed to take notes on entire works or to photocopy a portion thereof for themselves, there is no reason not to extend this necessarily limited practice to mass and rapid photocopying by libraries upon request.⁶⁷ The difference, of course, is in the extensiveness of the copying and the increased potential that the practice will fulfill the demand of the original. In his treatise on copyright, Professor Nimmer pointed out:

There would appear to be a qualitative difference between each individual scholar performing the task of reproduction for himself, and the library or other institution performing the task on a wholesale basis for all scholars. If the latter is fair use then must not the same be said for a non-profit publishing house that distributes to scholars unauthorized copies of scientific and educational works on a national or international basis?⁶⁸

The existence of this latter situation, of course, would render all copyright law protection completely meaningless with regard to scientific or educational works. If such were the case, once the protection were eliminated, the purpose for which it was created would be eliminated, and the resulting constitutional right would be constructively eliminated, all of which would leave scientists and scholars in no better position than they were at common law.

CONCLUSION

The majority opinion in *Williams & Wilkins* is clearly erroneous as the doctrine of fair use cannot be examined where wholesale taking exists. Though the constitutional purpose of the copyright legislation has been interpreted to broaden the scope of the taking in the fields of science and art, there can be no breadth of taking wide enough to justify reproduction of an entire work. The fact that students traditionally have hand and machine copied research material, that the defendants made no profit from their photocopying services, and that plaintiff did not undertake to prove actual damages may be relevant to a determination of fair use. However, such a determination is inappropriate in the *Williams & Wilkins Co.* case because the complete taking precludes the application of the doctrine.⁶⁹

66. GEORGE FRY & ASSOC., FRY REPORT, SURVEY OF COPYRIGHTED MATERIAL REPRODUCTION PRACTICES IN SCIENTIFIC & TECHNICAL FIELDS (1962). For an opposing view see *Project—New Technology and the Law of Copyright: Reprography and Computers*, 15 U.C.L.A.L. REV. 931 (1968). See also Statement of Mrs. Andrea Albrecht, Director of Marketing Research, On Behalf of Williams & Wilkins Co., *Hearings of Senate Subcomm. on Patents, Trademarks and Copyrights*, 93d Cong., 1st Sess. 150-53 (1973).

67. *Williams & Wilkins Co. v. United States*, 487 F.2d at 1356.

68. M.B. NIMMER, *THE LAW OF COPYRIGHT* 654 (1972 ed.).

69. *Leon v. Pacific Tel. & Tel.*, 91 F.2d 484, 486 (9th Cir. 1937).

Modern technology is continuously presenting new challenges, many of which are best met by Congress in their legislative capacity and not by the courts. In an early attempt to revise copyright legislation to better suit technological advances, Congress received reports on the effect of photoduplication of copyrighted material.⁷⁰ While drawing no conclusions as to the severity or insignificance of the effect, a Congressional report suggested several legislative alternatives to the photocopying problem. One solution, which works effectively in the German Federal Republic and in Austria, is the payment of royalties to the publisher of copyrighted materials less than three years old.⁷¹ Another alternative, and the one suggested by plaintiff in the present case, is licensing of photoduplication rights. Under this scheme the subscriber pays a minimal additional amount to the publisher at the time of subscription and obtains thereby the right to photocopy the work in accordance with its own system. This alternative would also eliminate any delay in time between a request and the fulfillment thereof.⁷²

Although it is important for the courts to realize the possibility of legislative relief, it is not the court's duty to legislate, but rather to interpret the law. "It is not only contrary to law but to business ethics to appropriate the property of another for one's use without the permission of the owner of that property, whatever its nature may be."⁷³

It would be irresponsible for the Supreme Court to sieze upon the reservation of the Court of Claims and refuse to decide the matter because it relates only to the facts of *Williams & Wilkins*. Libraries all over the country have the capacity to, and are, reproducing copyrighted works in massive quantities. The courts must not cast the burden of a decision of this importance upon a legislature which has been unable to cope with the problem statutorily since its inception. A final determination of the issue is overdue while the problem compounds daily.

Judith D. O'Neill

70. SENATE SUBCOMM. ON PATENTS, TRADEMARKS AND COPYRIGHTS, THE HISTORY OF U.S.A. COPYRIGHT LAW REVISION FROM 1901 TO 1954, S. Res. 53, Study No. 1, 86th Cong., 1st Sess., 1-19 (1960).

71. SENATE SUBCOMM. ON PATENTS, TRADEMARKS AND COPYRIGHTS, COPYRIGHT LAW REVISION, S. Res. 240, Studies No. 14-16, 86th Cong., 2d Sess. 7-134 (1960).

72. SENATE SUBCOMM. ON PATENTS, TRADEMARKS AND COPYRIGHTS, PHOTODUPLICATION OF COPYRIGHTED MATERIALS BY LIBRARIES, S. Res. 240, Study No. 15, 86th Cong., 2d Sess. 49 (1960).

73. Elisha Hanson, response in COMMENTS AND VIEWS SUBMITTED TO COPYRIGHT OFFICE ON PHOTODUPLICATION OF COPYRIGHTED MATERIAL BY LIBRARIES, SENATE SUBCOMM. ON PATENTS, TRADEMARKS AND COPYRIGHTS, S. Res. 240, Study No. 15, 86th Cong., 2d Sess. 75 (1960).