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Mark A. Bailey

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## PHONORECORDS AND FORFEITURE OF COMMON-LAW COPYRIGHT IN MUSIC

Mark A. Bailey

*Abstract:* A highly disputed issue surrounding the Copyright Act of 1909 is whether the public distribution and sale of recordings of a musical work constitutes "publication." Historically, unless the author followed the Act's formal requirements for obtaining statutory protection, publication injected the musical work irrevocably into the public domain. In a 1995 decision, *La Cienega Music Co. v. ZZ Top*, the Ninth Circuit unwisely broke from the tradition and common understanding in the music industry by holding that phonorecord distribution is a publication of musical compositions. After examining the history and purpose of the Copyright Act, as well as the legal precedents, this Comment argues that Congress did not intend phonorecords to be capable of publication. Besides being unfair to composers of original works, the court has created a split among the circuits that should be resolved.

United States copyright law recognizes the value of artistic creation and is designed to foster creative output. Authors' rights in a given work of art are defined by one of three exclusive realms: state common law, federal statute, and the public domain. The uses to which authors put their works determine which realm applies.

From its beginnings in 1790, the federal copyright scheme has recognized both the existence and vitality of common-law copyright.<sup>1</sup> Protection under the common law attached at the moment of a work's creation and granted authors the right of first publication. This meant that the work's creator held the exclusive right to decide whether and when to share the work with the world by publishing it. Because the right of first publication is perpetual, authors or their heirs could claim common-law protection indefinitely, so long as the work remained unpublished.<sup>2</sup>

Under the Copyright Act of 1909<sup>3</sup> ("1909 Act"), the publication of a work ended its common-law protection. Thus, if an author "published" a

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1. See Ralph S. Brown, Jr., *Unification: A Cheerful Requiem for Common Law Copyright*, 24 UCLA L. Rev. 1070, 1070-71 (1977). The express recognition of common-law protection prior to publication is set forth in 17 U.S.C. § 2 (1976) (repealed effective 1978).

2. The 1909 Act was repealed by the Copyright Act of 1976, making "tangible fixation," rather than publication, the dividing line between common law and federal statutory protection. Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified in scattered sections of 17 U.S.C. (1994)). Under the 1976 Act, a musical composition loses common-law protection in exchange for statutory rights at the point it is fixed in tangible form, which includes writing it down or recording its performance. 17 U.S.C. § 102 (1994). The focus of this Comment is on the 1909 Act and the traditional dichotomy between common law and statutory rights based on publication.

3. Act of March 4, 1909, ch. 320, 35 Stat. 1075, repealed by Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541.

work prior to January 1, 1978,<sup>4</sup> federal protection became the only available source of rights.<sup>5</sup> However, the 1909 Act provided federal protection only if a copyright notice appeared on all publicly distributed copies.<sup>6</sup> The failure to follow this formality placed the work irrevocably into the public domain, leaving anyone free to copy and use the work without liability.<sup>7</sup> Common law continued to protect unpublished works until the Copyright Act of 1976 ("1976 Act") preempted such protection by making "tangible fixation" the critical point at which the federal interest attaches.<sup>8</sup> But the 1976 Act offers no protection for any work deemed to have been published under the 1909 Act which did not carry the proper notice of copyright.<sup>9</sup>

"Publication" determines whether common law or federal law is the source of any available copyright protection under the 1909 Act.<sup>10</sup> Although publication is a vastly important concept to authors when determining their substantive rights, Congress declined to define the term in the 1909 Act.<sup>11</sup> Various judicial interpretations have resulted in confusion and a lack of uniformity.<sup>12</sup>

A highly disputed issue surrounding the 1909 Act is whether the public distribution and sale of phonograph records<sup>13</sup> constitutes a

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4. This is the effective date of the 1976 Act, which brought all unpublished and fixed works into its reach. Thus, many unpublished works lost common-law protection in exchange for the limited monopoly of a federal statutory copyright. See *infra* note 18 and accompanying text.

5. The U.S. Supreme Court has stated that "when the statutory right begins the common-law right ends." *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 347 (1908).

6. 17 U.S.C. § 10 (1976) (repealed effective 1978).

7. *Roy Export Co. v. Columbia Broadcasting Sys., Inc.*, 672 F.2d 1095, 1101 (2d Cir.) *cert. denied*, 459 U.S. 826 (1982). See also 37 C.F.R. § 202.2(2) (1977) ("If publication occurs by distribution of copies or in some other manner, without the statutory notice or with an inadequate notice, the right to secure copyright is lost. In such cases, copyright cannot be secured by adding the notice to copies distributed at a later date.").

8. 17 U.S.C. § 102 (1994).

9. See 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 4.05[B], at 4-24 (1995); see also 37 C.F.R. § 202.2 (1977).

10. *Roy Export*, 672 F.2d at 1101.

11. *Marx v. United States*, 96 F.2d 204, 206 (9th Cir. 1938); *Jones v. Virgin Records, Ltd.*, 643 F. Supp. 1153, 1158 (S.D.N.Y. 1986). The 1909 Act set the date of publication as the "earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed." 17 U.S.C. § 26 (1976) (repealed effective 1978). However, this language has not been interpreted as a congressional attempt to define publication. See, e.g., *Cardinal Film Corp. v. Beck*, 248 F. 368, 368 (D.C.N.Y. 1918).

12. See, e.g., *Jones*, 643 F. Supp. at 1158.

13. The issue is presented here using phonorecords for the purpose of discussion. Although most of the relevant litigation has dealt exclusively with cases involving phonorecord distribution, the

publication that divests musical compositions of common-law protection.<sup>14</sup> This is a question of statutory construction and legislative intent, but its answer will necessarily involve practical and equitable considerations.<sup>15</sup> The recording industry has evolved into a multi-billion dollar business since the advent of phonorecord technology.<sup>16</sup> It has generally acted on the assumption that the distribution of phonorecords is not a publication under the 1909 Act.<sup>17</sup> Accordingly, many artists released compositions without perceiving the need for registration or affixing of a copyright notice to their records.<sup>18</sup> If the distribution or public sale of recordings prior to January 1, 1978, is considered a publication of the musical composition, composers must have affirmatively sought federal protection upon such distribution in order to prevent their works from falling into the public domain.

The dispute survives to this day, as evidenced by the Ninth Circuit Court of Appeals' decision in *La Cienega Music Co. v. ZZ Top*,<sup>19</sup> which departs from the established rule in the Second Circuit.<sup>20</sup> Today, the definition of "publication" under the 1909 Act continues to be vitally important to composers who distributed phonorecords prior to its repeal.

This Comment argues that the Ninth Circuit's rule that the distribution of phonorecords divests the underlying musical compositions of common-law protection unjustifiably deprives artists of their property rights. The decision has created a dramatic split from the established rule in the Second Circuit, the other major center of music copyright litigation. The resulting destruction of national uniformity on this issue

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legal analysis applies equally to cassette tapes, eight-tracks and any other medium capable of capturing sounds for reproduction.

14. Melville B. Nimmer, *Copyright Publication*, 56 Colum. L. Rev. 185, 188 (1956). See also Ralph S. Brown, Jr., *Publication and Preemption in Copyright Law: Elegiac Reflections on Goldstein v. California*, 22 UCLA L. Rev. 1022, 1038 (1975).

15. *Bartok v. Boosey & Hawkes, Inc.*, 523 F.2d 941, 947 (2d Cir. 1975). See also *Cabell v. Markham*, 148 F.2d 737, 739 (2d Cir.) (Hand, Learned, J.) ("[I]t is one of the surest indexes of a mature and developed jurisprudence not to make a fortress out of the dictionary; but to remember that statutes always have some purpose or object to accomplish, whose sympathetic and imaginative discovery is the surest guide to their meaning."), *aff'd*, 326 U.S. 404 (1945).

16. The sound recording market produced more than \$10 billion in sales in 1993. *The World Almanac and Book of Facts, 1995*, at 309 (Robert Famighetti et al. eds., 1994).

17. 1 Nimmer & Nimmer, *supra* note 9, § 4.05[B][1], at 4-24.

18. See Brown, *supra* note 14, at 1039 n.92.

19. 44 F.3d 813 (9th Cir.) (holding phonorecord distribution to constitute publication), *cert. denied*, 116 S. Ct. 331 (1995).

20. *Rosette v. Rainbo Record Mfg. Corp.*, 546 F.2d 461 (2d Cir. 1976) (holding that phonorecord distribution is not a publication).

will undoubtedly encourage forum shopping and will unduly disrupt the music industry. Part I explains the unique problem of copyright protection for musical compositions. Part II discusses the leading cases representing the divergent interpretations of the 1909 Act, and part III discusses the weaknesses of the Ninth Circuit's approach. Finally, part IV offers a practical solution that achieves an appropriate balance between authors' rights and the public interest. The advocated solution allows recording artists, who distributed phonorecords without copyright notice under the 1909 Act, to retain common-law rights in their music. The proposal requires that courts hold a federal copyright to have vested in such musical works when the 1976 Act took effect, and thus protects the composer's creative efforts against infringement.

## I. PHONORECORDS AND THE UNIQUE PROBLEM OF COPYRIGHT PROTECTION FOR MUSICAL COMPOSITIONS

### A. *Overview of Copyright Protection and Publication*

The Constitution provides that Congress shall have the power "[t]o promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings."<sup>21</sup> Pursuant to this authority, Congress established the first federal copyright law in 1790.<sup>22</sup> The original subject matter of copyright was limited to maps, charts, and books but was gradually expanded to include other works, such as musical compositions<sup>23</sup> and sound recordings,<sup>24</sup> under a broad reading of the constitutional term "writings."<sup>25</sup> All of these works were protected by common-law copyright prior to publication.

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21. U.S. Const. art. I, § 8, cl. 8.

22. Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1831).

23. Act of Feb. 3, 1831, ch. 16, § 5, 4 Stat. 436 (codified at 17 U.S.C. § 5(e) (1976) (repealed effective 1978)).

24. Sound Recording Act of 1971, Pub. L. No. 92-140, 85 Stat. 391.

25. Federal protection for works of art is not as all-encompassing as the Constitution allows. The 1909 Act, which has language that mirrors the constitutional term "writings," states that "[t]he works for which copyright may be secured under this title shall include all the writings of an author." 17 U.S.C. § 4 (1976) (repealed effective 1978). However, "writings" under the 1909 Act are more limited in scope, regulating only certain specific categories of works. These categories, unlike the more generous provisions of the 1976 Act, are exclusive. 17 U.S.C. § 5 (1976) (repealed effective 1978). *See* Brown, *supra* note 14, at 1028; *see also* 17 U.S.C. § 5 (1976) (repealed effective 1978). The 1976 Act dispenses with the term "writings" and offers protection to "works of authorship," clearly delineating the difference between the statutory subject matter and the full scope of constitutional power.

The 1909 Act made federal protection available via two routes. Federal protection attached automatically when a work containing a notice of copyright was published.<sup>26</sup> Alternatively, the 1909 Act permitted an author to obtain federal protection for an unpublished work by depositing a copy with the U.S. Copyright Office.<sup>27</sup> State common law determined the author's rights in a work that was neither published nor registered as an unpublished work.

The perpetual nature of common-law protection for unpublished works stands in sharp contrast to the federal scheme. Copyright under the 1909 Act is a limited monopoly lasting for a twenty-eight-year term and carrying the possibility of an additional twenty-eight-year renewal term.<sup>28</sup> The term begins to run on the date of either first publication or registration, depending on which avenue of statutory protection was sought. The limited duration of federal protection is the necessary result of the power granted to Congress by the Constitution<sup>29</sup> and carries out the public policy of allowing other artists to freely build upon earlier works upon the expiration of copyright protection.<sup>30</sup>

Applying the apparently simple concept of publication has led to confusion in various contexts. Courts differentiate between "limited" and "general" publication in to protect authors against the unintentional relinquishment of their common-law rights.<sup>31</sup> Publication is a question of the author's intent,<sup>32</sup> and to divest an author of common-law protection, a work's public display must reach a substantial number of people.<sup>33</sup> In the case of literary works, the original focus and subject of copyright law, the acts that constituted publication were clear: the general distribution and sale of a printed book to the public. As the subject matter of copyright law expanded, along with new media of expression,

26. 17 U.S.C. § 10 (1976) (repealed effective 1978). The required notice consists of the word "Copyright," the abbreviation "Copr.," or the symbol ©, along with the name of the copyright owner and the year of first publication. 17 U.S.C. § 19 (1976) (repealed effective 1978).

27. 17 U.S.C. § 12 (1976) (repealed effective 1978).

28. 17 U.S.C. § 24 (1976) (repealed effective 1978). Under the 1976 Act, duration of statutory protection was changed to life of the author plus 50 years. 17 U.S.C. § 302(a) (1994).

29. See *supra* note 21 and accompanying text.

30. See, e.g., *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

31. See, e.g., *Nutt v. National Inst. Inc. for the Improvement of Memory*, 31 F.2d 236, 238 (2d Cir. 1929).

32. *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 101 N.Y.S.2d 483, 494 (Sup. Ct. 1950) (citing *International News Serv. v. Associated Press*, 248 U.S. 215, 240-41 (1918)), *aff'd*, 107 N.Y.S.2d 795 (App. Div. 1951).

33. See *American Visuals Corp. v. Holland*, 239 F.2d 740, 743 (2d Cir. 1956).

determining the scope of the term "publication" became increasingly difficult.<sup>34</sup>

*B. Issues Regarding Divestive and Investive Publication:*

The Second Circuit, in an effort to protect authors' rights, has stated that "[i]f all copyright in a work will be lost, the particular event might not be a publication as to that work; if one copyright will simply be exchanged for another, the same event can safely be labeled a publication for the purpose of acquiring the statutory right."<sup>35</sup> When the inquiry is whether certain acts have divested a work of common-law protection, courts generally apply a high standard of publication in order to protect the author. On the other hand, when the inquiry is whether a work has been published so as to qualify for statutory protection, the standard is relatively lower, because a finding of publication does not deprive the author of protection.<sup>36</sup>

In an effort to allow artists to reap the rewards of their labor, courts use the higher standard for "divestive" publication to protect them against both piracy and unwitting forfeiture.<sup>37</sup> In theory, a single event may be sufficient to constitute investive publication, yet insufficient to divest common-law rights.<sup>38</sup> In practice, however, courts are reluctant to find that an author unwittingly injected a work into the public domain by merely failing to observe statutory formalities, even where publication would have triggered federal protection.<sup>39</sup> The policy of leaving the

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34. Ralph S. Brown, Jr., *Unification: A Cheerful Requiem for Common Law Copyright*, 24 UCLA L. Rev. 1070, 1071-72 (1977).

35. *Roy Export Co. v. Columbia Broadcasting Sys., Inc.* 672 F.2d 1095, 1102 (2d Cir.), *cert. denied*, 459 U.S. 826 (1982).

36. These different inquiries are referred to as "divestive" and "investive" publication. The concepts refer respectively to the loss of common-law copyright and the securing of statutory protection through the act of publication. *See id.* at 1101-02; *Jones v. Virgin Records, Ltd.*, 643 F. Supp. 1153, 1159 n.13 (S.D.N.Y. 1986). The Copyright Office has spoken on the varying standards of publication, stating that:

[I]n order to accord statutory copyright, the issue of a few copies with the notice of copyright has been held, in some instances, to constitute publication; conversely, in order to preserve common law rights, in other cases, the distribution of a considerable number of copies without the copyright notice has been considered "limited" publication and, consequently, not a forfeiture of the common law rights.

William Strauss, Attorney-Advisor to the Copyright Office, *General Revision of Copyright Law: Study No. 7*, at 50 (1958).

37. *Roy Export*, 672 F.2d at 1102.

38. *Id.* at 1104. *See also* *Bartok v. Boosey & Hawkes, Inc.*, 523 F.2d 941, 945 (2d Cir. 1975).

39. *Roy Export*, 672 F.2d at 1104.

author with some form of copyright is especially appropriate in situations where the author has relied on an industry understanding that phonorecord distribution will not forfeit common-law rights. The result that would otherwise follow is antithetical to the copyright law's purpose of promoting artistic creation.

The common law's perpetual monopoly secures rights analogous to tangible forms of personal property,<sup>40</sup> the loss of which is of substantial economic consequence.<sup>41</sup> Because so many artists distributed their records without perceiving any need to include notice of copyright under the 1909 Act, defining distribution as a publication will divest many composers of their expected property rights. Under the Ninth Circuit's interpretation, entire catalogs of music released before January 1, 1978, will be held to have been unwittingly injected into the public domain. This will require music publishers to trace the history of each composition they own to determine whether copyright notice appeared on all phonorecords. Contracts for musical rights may be deemed voidable due to mistake of fact or lack of consideration if the assignor is held to have lost all rights prior to contracting. In short, the economic and practical impact on copyright owners and the courts will be immense.

### *C. The Phonorecord Captures a Performance Rather Than Copying a Musical Composition*

When Congress first extended the Copyright Act to protect musical compositions,<sup>42</sup> sheet music was the only way such works were copied and registered.<sup>43</sup> Technology had not advanced to the point where mechanical reproduction of music was possible. Sheet music was universally recognized as a copy of the musical work, and thus its public distribution and sale constituted divestive publication.<sup>44</sup>

The twentieth century has seen a dramatic shift in the principal method by which musicians introduce their works to the public for enjoyment. Numerous methods of capturing performances in fixed form have made listening to music possible at the flip of a switch, rendering

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40. Richard R. Bowker, *Copyright: Its History and Its Law* 42 (1912).

41. *See, e.g.,* Carew v. Melrose Music, Inc., 92 F. Supp. 971, 972 (S.D.N.Y. 1950).

42. *See supra* note 23 and accompanying text.

43. *See* 17 U.S.C. § 11 (1976) (repealed effective 1978). "Sheet music" is the written embodiment of a composition in musical notation.

44. *See, e.g.,* White-Smith Music Pub. Co. v. Apollo Co., 209 U.S. 1, 8 (1908).



sheet music and live performances unnecessary. Even today, however, music notation is the only way to actually copy a musical composition. A phonorecord merely captures a particular performance by musicians, whose interpretation and technique cause the performance to exist independently from the composition.

The United States Supreme Court in *Ferris v. Frohman*<sup>45</sup> established the rule that an author of a play could exploit the work forever on the stage, retaining common-law protection as long as the work was not published in print.<sup>46</sup> Implicit in this holding is the recognition that a performance is not a "copy" of a work under the plain meaning of the term. As such, a performance is not a publication and cannot divest the author of his common law rights.<sup>47</sup> The number of people who see or hear the work performed is irrelevant.<sup>48</sup> Thus, exploitation of an author's work for profit is not the touchstone for publication under the 1909 Act. Authors are free to profit from the fruits of their labor without necessarily bringing their works within the ambit of federal concern.

The rule that public performances do not affect common-law rights has been applied to presentations of an unpublished dramatic work<sup>49</sup> and exhibitions of motion pictures,<sup>50</sup> suggesting that the ephemeral nature of live performance is not the determinative factor in the publication inquiry. The rule extends equally to the musical composition.<sup>51</sup> Since the Supreme Court's opinion in *Ferris*, however, emerging technologies have spawned a number of methods to capture music for reproduction, making the treatment of musical compositions under the 1909 Act conceptually unique.

Much of the difficulty in defining "publication," as applied to musical compositions, stems from the fact that the Copyright Act was historically

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45. 223 U.S. 424 (1912).

46. *Id.* at 435.

47. *E.g.*, *Roy Export Co. v. Columbia Broadcasting Sys., Inc.*, 672 F.2d 1095, 1104 (2d Cir.), *cert. denied*, 459 U.S. 826 (1982); *Nutt v. National Inst. Inc. for the Improvement of Memory*, 31 F.2d 236, 238 (2d Cir. 1929).

48. *Patterson v. Century Prods., Inc.*, 93 F.2d 489, 491 (2d Cir. 1937) (explaining that "many thousands of people" saw a motion picture exhibited), *cert. denied*, 303 U.S. 655 (1938). *See also* *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 101 N.Y.S.2d 483, 494 (Sup. Ct. 1950) (stating that the performance of opera is not a "publication," even though it was also broadcast over a radio network), *aff'd*, 107 N.Y.S.2d 795 (App. Div. 1951).

49. *Ferris*, 223 U.S. at 435.

50. *Patterson*, 93 F.2d at 491.

51. *McCarthy & Fischer, Inc. v. White*, 259 F. 364 (D.C.N.Y. 1919).

directed toward written works.<sup>52</sup> The Universal Copyright Convention has defined “publication” as “the reproduction in tangible form and the general distribution to the public of copies of a work from which it can be read or otherwise *visually* perceived.”<sup>53</sup> Implicit in this reasoning is the assumption that phonorecord distribution is not a publication of the works they contain. When captured on a phonorecord, a musical composition can only be audibly perceived through the aid of a record player. Therefore, the general distribution of phonorecords is not a publication.

#### D. *White-Smith: The Source of the Rule That Phonorecords Are Not Copies*

Traditionally, phonorecords have not been treated as copies under federal law. The U.S. Supreme Court sowed the seeds of this statutory interpretation in *White-Smith Music Publishing Co. v. Apollo Co.*<sup>54</sup> This case involved an action for copyright infringement against the Apollo Company for manufacturing and selling perforated piano rolls of the plaintiff’s songs without authorization.<sup>55</sup> At the beginning of the century, the manufacture of piano rolls dramatically increased, threatening substantial property interests in songs and making an authoritative interpretation of the Copyright Act necessary.<sup>56</sup> *White-Smith* provided the opportunity. The validity of the plaintiff’s copyright was not questioned because the songs had been published as sheet music with notice of copyright.<sup>57</sup> The only issue was whether the plaintiff had a right to prohibit the defendant’s acts. The trial court dismissed the complaint, relying on the uniform holdings<sup>58</sup> of other courts that had rejected the notion that the Copyright Act was meant to protect copyright owners against the mechanical reproduction of their songs by others.<sup>59</sup> The U.S.

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52. See Benjamin Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. Pa. L. Rev. 469 (1955).

53. U.C.C. art. VI (Paris text) (1971) (emphasis added). Although this definition is not binding on American courts, the delegation of the United States urged the Convention to adopt the “visually perceived” limitation because it believed this view represented U.S. law. See 1 Nimmer & Nimmer, *supra* note 9, § 4.05[B][3], at 4-30 n.42.

54. 209 U.S. 1 (1908).

55. *Id.* at 8–9.

56. *Id.* at 9.

57. *Id.* at 8–9.

58. *Id.* at 17.

59. *E.g.*, *Kennedy v. McTammany*, 33 F. 584, 584 (C.C.D. Mass. 1888) (“I cannot convince myself that these perforated sheets of paper are copies of sheet music, within the meaning of the

Supreme Court affirmed,<sup>60</sup> holding that the piano roll was not a copy of the musical composition under the terms of the statute.<sup>61</sup> Thus, the defendant's manufacturing of piano rolls did not infringe on the plaintiff's exclusive right to copy his work.<sup>62</sup>

Courts have struggled with phonorecord distribution under the 1909 Act due to the lack of an express legislative definition of "publication." Before the introduction of sound reproduction devices, publication of musical works was a simple concept: the distribution and sale of sheet music published the work—public performances did not.<sup>63</sup> As new technologies for capturing musical works in fixed form developed, however, the definition of "publication" and the scope of congressional intent to regulate musical compositions became difficult to ascertain.<sup>64</sup>

In dicta, the Court in *White-Smith* noted that the same result would apply with equal force to "the record of a graphophone."<sup>65</sup> Indeed, the Ninth Circuit later applied the *White-Smith* rule to phonorecords in *Corcoran v. Montgomery Ward & Co.*<sup>66</sup> The plaintiff in *Corcoran* unsuccessfully argued that by setting his copyrighted poem to music and selling phonorecords to the public, the defendant had infringed on his exclusive statutory right to copy and vend his protected work.<sup>67</sup> The Ninth Circuit expressed misgivings about leaving the copyright owner

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copyright law. They are not made to be addressed to the eye as sheet music, but they form part of a machine."), *appeal dismissed*, 145 U.S. 643 (1892); *Stern v. Rosey*, 17 App. D.C. 562, 564–65 (1901). The *Stern* court stated:

We cannot regard the reproduction, through the agency of the phonograph, of the sounds of musical instruments playing [music] as the copy or publication of the same within the meaning of the act. The ordinary signification of the words "copying", "publishing", etc., can not be stretched to include [such reproduction devices].

60. 209 U.S. 1, 18 (1908).

61. The relevant statute at the time of the *White-Smith* decision was 17 U.S.C. § 4952 (1908) (repealed 1909). See *White-Smith*, 209 U.S. at 9.

62. *Id.* at 17. The Court stated:

It may be true that in a broad sense a mechanical instrument which reproduces a tune copies it; but this is a strained and artificial meaning. When the combination of musical sounds is reproduced to the ear it is the original tune as conceived by the author which is heard.

63. *Ferris v. Frohman*, 223 U.S. 424 (1912).

64. See *supra* notes 49–52 and accompanying text.

65. *White-Smith*, 209 U.S. at 17.

66. 121 F.2d 572, 573 (9th Cir.) ("If the question were one of first impression we might be inclined to agree [that a reproduction of music for acoustical enjoyment is a 'copy']; but [this] argument appears to be foreclosed in the decision in *White-Smith*."), *cert. denied*, 314 U.S. 687 (1941).

67. 17 U.S.C. § 1(a) (1976) (repealed effective 1978) grants the exclusive right to "print, reprint, publish, copy, and vend the copyrighted work."

with no rights against the unauthorized production and sale of phonorecords, but acknowledged that it was bound by congressional intent and held that phonorecords did not infringe any statutory right.<sup>68</sup> The court reasoned that although the U.S. Supreme Court in *White-Smith* had invited Congress to include the control of phonorecords within the statutory right to copy a work, the 1909 amendments left intact the rule that piano rolls and phonorecords were not copies.<sup>69</sup>

## II. PHONORECORDS AND PUBLICATION: DISAGREEMENT BETWEEN THE CIRCUITS

### A. *The Second Circuit's Rule: Phonorecord Distribution Is Not a Publication of Musical Compositions*

In *Rosette v. Rainbo Record Manufacturing Corp.*,<sup>70</sup> the Second Circuit decided a copyright infringement claim by a plaintiff who had sold recordings of her songs, without notice, before she sought statutory copyright. The Second Circuit affirmed the lower court's rejection of the defendant's prior publication defense, holding that the plaintiff's rights were not lost to the public domain.<sup>71</sup> Therefore, her subsequent registration for statutory copyright was valid.

The *Rosette* court properly considered the view of the copyright bar and the music industry that the distribution of phonorecords did not constitute a publication of songs under the 1909 Act. The trial court opinion recognized that a number of artists had relied upon this interpretation.<sup>72</sup> The court then went on to examine the case authorities cited by the defendant for its proposition that the plaintiff had published her songs.

The *Rosette* trial court first examined *Shapiro, Bernstein & Co. v. Miracle Record Co.*,<sup>73</sup> which involved a claim for infringement of the

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68. *Corcoran*, 121 F.2d at 574.

69. *Id.* at 573 (citing *White-Smith*, 209 U.S. at 18). Note that the 1909 Act's mechanical royalty provision, 17 U.S.C. § 1(e) (1976) (repealed effective 1978), offered the plaintiff no remedy because it applied by its terms only to musical compositions and not to poems. Section 1(e) is discussed *infra* at notes 114–19 and accompanying text.

70. 546 F.2d 461 (2d Cir. 1976).

71. *Id.* at 463.

72. *Rosette v. Rainbo Record Mfg. Corp.*, 354 F. Supp. 1183, 1190 (S.D.N.Y. 1973), *aff'd*, 546 F.2d 461 (2d Cir. 1976).

73. 91 F. Supp. 473 (N.D. Ill. 1950).

plaintiff's bass line.<sup>74</sup> The *Shapiro* court stated in dicta that the production and sale of a phonograph record is as much a publication as distribution of sheet music.<sup>75</sup> However, the ultimate judgment for the defendant rested on the finding that the plaintiff's bass line was too simple to qualify for copyright protection.<sup>76</sup> Likewise, in *McIntyre v. Double-A Music Corp.*,<sup>77</sup> the court's view that the distribution of phonorecords constituted publication was stated in dicta because the work at issue lacked sufficient originality to qualify for copyright.<sup>78</sup> Finally, in *Mills Music, Inc. v. Cromwell Music, Inc.*,<sup>79</sup> the court held that publication had resulted from the foreign distribution of recordings<sup>80</sup> and merely stated in passing that the manufacture and sale of phonograph records in the United States would constitute publication of a composition.<sup>81</sup>

None of these decisions had attempted to address the conflict with the U.S. Supreme Court's opinion in *White-Smith Music Pub. Co. v. Apollo Co.*<sup>82</sup> But the rule that phonorecords are not copies proved determinative to the trial court in *Rosette*.<sup>83</sup> The court held that the 1909 Act had left the U.S. Supreme Court's rule intact, and because phonorecords were not copies, they were not capable of publication.<sup>84</sup> Moreover, the court stated that Congress had rejected the notion that the permanency of a recording makes it more than a mere performance.<sup>85</sup>

Of all the decisions that have addressed the issue, *Rosette* provides the only fully reasoned analysis and synthesis of the statute, prior case law, and historical industry practice. The Second Circuit's opinion in *Rosette*

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74. *Id.* A "bass line" is the series of low-register notes that underlie a musical composition.

75. *Id.* at 475.

76. *Id.* at 474.

77. 166 F. Supp. 681 (S.D. Cal. 1958).

78. "The foregoing portion of this opinion assumes that plaintiff's arrangement was an original composition and therefore could have been the subject of copyright. However, I find plaintiff's composition was insufficient to qualify for either a common-law or a statutory copyright." *Id.* at 683 (emphasis added).

79. 126 F. Supp. 54 (S.D.N.Y. 1954).

80. *Id.* at 65. Distribution of recordings in foreign countries is treated differently than distribution in the United States under the Copyright Act. *Id.* at 75.

81. *Id.* at 69. In any event, the statement in *Mills Music* is no longer good law, being effectively overruled in *Rosette v. Rainbo Record Mfg. Corp.*, 546 F.2d 461 (2d Cir. 1976).

82. *White-Smith Music Pub. Co. v. Apollo Co.*, 229 U.S. 1 (1908).

83. *Rosette v. Rainbo Record Mfg. Corp.*, 354 F. Supp. 1183, 1191 (S.D.N.Y. 1973), *aff'd*, 546 F.2d 461 (2d Cir. 1976).

84. *Id.*

85. *Id.* at 1191-92.

was for years the most authoritative statement on the issue of publication through distribution and sale of phonorecords.<sup>86</sup> Until the Ninth Circuit departed from the Second Circuit's rule, and although some courts had indicated that they might arrive at a different result, no case had explicitly held that public distribution of records divested the author of common-law protection in the composition under the terms of the 1909 Act.

*B. The Ninth Circuit's Rule: Phonorecord Distribution Is a Publication*

In *La Cienega Music Co. v. ZZ Top*,<sup>87</sup> the plaintiff, as the assignee of blues artist John Lee Hooker's rights, sued the popular Texas blues-rock band, ZZ Top, claiming that their signature song, *La Grange*, infringed on Hooker's composition *Boogie Chillen*.<sup>88</sup> Hooker had followed industry practice and released phonorecords of his song in 1948 without seeking statutory protection.<sup>89</sup> He released subsequent derivative recordings in 1959 and 1970.<sup>90</sup> La Cienega later filed for federal copyright by registering each version as an unpublished work in 1967, 1970, and 1992, relying on the common understanding that the sale of Hooker's albums had not injected *Boogie Chillen* into the public domain.<sup>91</sup>

On this matter of first impression, however, the Ninth Circuit held that Hooker had published each version on the release dates of the albums.<sup>92</sup> The merits of the infringement claim were thus never reached. The Ninth Circuit affirmed the dismissal of the complaint regarding the 1948 and 1959 versions, because their twenty-eight-year terms would have expired even if statutory copyright had been secured. The case was remanded, however, to determine whether the 1970 version had been released with copyright notice, because the resulting statutory copyright term, if any, would not have expired.<sup>93</sup> In concluding that Hooker had unwittingly

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86. 1 Nimmer & Nimmer, *supra* note 9, § 4.05[B], at 4-28 n.29.

87. 44 F.3d 813 (9th Cir.), *cert. denied*, 116 S. Ct. 331 (1995).

88. *Id.* at 814.

89. *Id.*

90. *Id.*

91. *Id.* at 815.

92. *Id.* at 815-16.

93. *Id.* at 816. See also 17 U.S.C. § 9 (1976) (repealed effective 1978), which requires that upon publication, "notice of copyright . . . shall be affixed to each copy thereof published or offered for

published his song, the Ninth Circuit created a split with the Second Circuit.

The Ninth Circuit in *ZZ Top* rejected the Second Circuit's analysis for two reasons. First, it stated that *Rosette v. Rainbo Record Manufacturing Corp.*<sup>94</sup> was the minority rule and that no other circuit had followed it.<sup>95</sup> This misleading label was based on a passage in *Nimmer on Copyright*<sup>96</sup> but lacks support in case law. At the time, *Rosette* was the only appellate-level authority to address the effect of phonorecord distribution under the 1909 Act.<sup>97</sup> Professor Nimmer's "majority view" rests on the dicta of the three district court cases cited in *Rosette*,<sup>98</sup> along with four other trial court decisions.<sup>99</sup> Of these seven decisions, only one, *International Tape Manufacturers Ass'n v. Gerstein*,<sup>100</sup> expressly held that the distribution of phonorecords is publication sufficient to divest a work of common-law protection—a decision later vacated by the Fifth Circuit.<sup>101</sup> In contrast, five decisions have agreed with *Rosette* that the public sale of phonorecords is not publication under the 1909 Act.<sup>102</sup>

Second, the Ninth Circuit asserted that the *Rosette* rule reduced the incentive to submit immediately to the limitations of the 1909 Act.<sup>103</sup> *Rosette* required compositions to be registered before authors could

sale in the United States by authority of the copyright proprietor" in order to secure statutory protection.

94. 546 F.2d 461 (2d Cir. 1976).

95. *ZZ Top*, 44 F.3d at 815.

96. Professor Nimmer states: "[T]he relatively few courts which considered the question were almost unanimous in determining that public sale or other distribution of phonorecords *does* constitute a publication and hence a divestment of common law rights in the works recorded." 1 *Nimmer & Nimmer*, *supra* note 9, § 4.05[B] at 4-26.

97. *ZZ Top*, 44 F.3d at 815.

98. *See supra* notes 73-81 and accompanying text.

99. *See* 1 *Nimmer & Nimmer*, *supra* note 9, § 4.05[B] at 4-26 n.18 (citing *International Tape Mfrs. Ass'n v. Gerstein*, 344 F. Supp. 38 (S.D. Fla. 1972), *vacated*, 494 F.2d 25 (5th Cir. 1974)); *Biltmore Music Corp. v. Kittinger*, 29 Copyright Off. Bull. 32 (S.D. Cal. 1954), *modified*, 238 F.2d 373 (9th Cir.), *cert. denied*, 352 U.S. 954 (1956); *Blanc v. Lantz*, 83 U.S.P.Q. 137 (Cal. Sup. Ct. 1949); *Hemingway v. Random House, Inc.*, 268 N.Y.S.2d 531 (Sup. Ct. 1966).

100. 344 F. Supp. at 57.

101. 494 F.2d 25 (5th Cir. 1974).

102. *See Capitol Records v. Mercury Records Corp.*, 221 F.2d 657, 663 (2d Cir. 1955); *Tempo Music, Inc. v. Famous Music Corp.*, 838 F. Supp. 162 (S.D.N.Y. 1993); *Jones v. Virgin Records, Ltd.*, 643 F. Supp. 1153 (S.D.N.Y. 1986); *Dealer Advertising Dev., Inc. v. Barbara Allen Fin. Advertising, Inc.*, 209 U.S.P.Q. 1003 (W.D. Mich. 1979); *Nom Music, Inc. v. Kaslin*, 227 F. Supp. 922 (S.D.N.Y. 1964), *aff'd*, 343 F.2d 198 (2d Cir. 1965).

103. *La Cienega Music Co. v. ZZ Top*, 44 F.3d 813, 815 (9th Cir.), *cert. denied*, 116 S.Ct. 331 (1995).

sue.<sup>104</sup> The Ninth Circuit feared that, at least until they desired to bring an action for infringement, authors would indefinitely exploit their songs through public sales of records.<sup>105</sup> Thus, the Ninth Circuit argued that artists could delay compliance with the Copyright Act's requirements and receive "longer" copyright protection.<sup>106</sup>

### III. PHONORECORD DISTRIBUTION IS NOT "PUBLICATION" UNDER THE 1909 ACT

The Ninth Circuit erred in holding that the distribution and sale of phonorecords causes a forfeiture of common-law rights in musical compositions under the 1909 Act. In light of clear authoritative interpretations of the 1909 Act by the Copyright Office<sup>107</sup> and the common understanding of the recording industry, *La Cienega Music Co. v. ZZ Top*<sup>108</sup> disregards authors' reasonable expectations to intellectual property rights. The court undermined copyright law's fundamental policy of securing to authors the rewards of their creative efforts, and offered no equal countervailing policy. The *ZZ Top* holding was further unwarranted because of its glaring departure from the law in the Second Circuit, thereby creating a need for U.S. Supreme Court resolution to avoid the clear incentive for forum shopping.

#### A. Congressional Intent

The U.S. Supreme Court's opinion in 1908,<sup>109</sup> holding that a piano roll is not a copy of a musical composition, explicitly encouraged Congress to extend the Copyright Act if it wished to grant protection against the manufacture of such devices by others.<sup>110</sup> A year later, Congress

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104. *Rosette v. Rainbo Record Mfg. Corp.*, 354 F. Supp. 1183, 1193 (S.D.N.Y. 1973), *aff'd*, 546 F.2d 461 (2d Cir. 1976).

105. *ZZ Top*, 44 F.3d at 815.

106. *Id.*

107. The U.S. Copyright Office was authorized by statute to make rules and regulations for the registration of copyright claims. 17 U.S.C. § 207 (1976) (repealed effective 1978).

108. 44 F.3d 813.

109. *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908).

110. After holding that a piano roll is not a copy within the meaning of the Copyright Act, Justice Day commented:

It may be true that the use of these perforated rolls, in the absence of statutory protection, enables the manufacturers thereof to enjoy the use of musical compositions for which they pay no value. But such considerations properly address themselves to the legislative, and not the



responded and substantially revised the Copyright Act.<sup>111</sup> The 1909 Act gave music copyright owners the right to compensation for unauthorized mechanical reproductions of their works.<sup>112</sup> However, this newly created right was limited. Congress did not include phonorecords and piano rolls within the definition of "copy" under section 1(a),<sup>113</sup> which would have prohibited the mechanical reproduction of copyrighted works without the copyright owner's consent. Instead, Congress created a compulsory license, which allows phonorecord producers to use copyrighted compositions without liability, provided they pay a royalty to the copyright owner.<sup>114</sup>

The compulsory license was new and unique to U.S. copyright law, fostering extensive debate over the propriety of recognizing mechanical reproduction rights in musical compositions.<sup>115</sup> Not only did some legislators oppose this extension of copyright protection but even those in favor of the proposed provisions were divided into two groups. Some argued for granting exclusive recording rights to the copyright owner, while others favored granting only the limited right to collect royalties for the unauthorized recording and sale of protected works.<sup>116</sup>

The remedy provided by the 1909 Act affirmed Congress's choice not to treat such mechanical reproductions as copyright infringement. In creating this new remedy based on royalties, rather than infringement, Congress explicitly preserved the conceptual difference between copies and phonorecords under the *White-Smith Music Publishing Co. v. Apollo Co.*<sup>117</sup> analysis.<sup>118</sup> Section 1(e) provided for "payment to the copyright

judicial, branch of Government. As the act of Congress now stands we believe it does not include these records as copies or publications of the copyrighted music involved in these cases.

*Id.* at 18 (emphasis added).

111. Act of March 4, 1909, 35 Stat. 1075, codified at 17 U.S.C. §§ 1-216 (repealed by Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541).

112. 17 U.S.C. § 1(e) (1976) (repealed effective 1978).

113. 17 U.S.C. § 1(a) (1976) (repealed effective 1978) provides: "Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right . . . [t]o copy . . . the copyrighted work."

114. 17 U.S.C. § 1(e) (1976) (repealed effective 1978).

115. See Harry G. Henn, *General Revision of the Copyright Law: Study No. 1* (1957) (describing in detail the congressional bills introduced on the subject) [hereinafter *General Revision*]. The Report of the House Committee on Patents accompanying the successful bill, H.R. 28192, states that § 1(e) "has been the subject of more discussion and has taken more of the time of the committee [sic] than any other provision in the bill." H.R. Rep. No. 2222, 60th Cong., 2d Sess. 4 (1909).

116. H.R. Rep. No. 2222, 60th Cong., 2d Sess. 4 (1909).

117. 209 U.S. 1 (1908).

proprietor of a royalty of [two] cents on each such *part* manufactured.”<sup>119</sup> Congress did not define phonorecords as a “copy” of the musical composition anywhere in the revised Act.<sup>120</sup>

The treatment of phonorecords and piano rolls in section 1(e) was largely a compromise to avoid anti-trust issues. Anticipating a congressional grant of the exclusive right to produce such devices, the Aeolian Company contracted for these rights with more than eighty of the leading music-publishing companies in the country.<sup>121</sup> If Congress had granted copyright owners the exclusive right to make mechanical reproductions, Aeolian would have acquired a substantial monopoly. The mechanical royalty provisions of the 1909 Act clearly evince congressional intent that phonorecords remain outside the scope of the statutory term “copy.” Section 1(e) applies only to musical compositions and is independent of the exclusive right to copy in section 1(a), which prohibits unauthorized sheet music without qualification. The owner of a copyright in a musical work has no cause of action against the phonorecord manufacturer as long as the statutory royalties are paid.

Later enactments, although not controlling, illustrate Congress’s hands-off approach to musical compositions under the 1909 Act. There is no reason why Congress could not have expressly defined phonorecords as copies of the underlying musical composition. The 1971 amendments to the 1909 Act illustrate the simplicity of the task.<sup>122</sup> Congress added sound recordings to the list of copyrightable subject matter,<sup>123</sup> and

118. While the copyright law since 1909 has protected . . . musical compositions against recording and mechanical reproduction, it has not changed the ruling in *White-Smith Music Publishing Co.* that recordings were not “copies” of the musical composition or “writings” of an author within the scope of the existing copyright statute.

Harry G. Henn, *The Compulsory License Provisions of the United States Copyright Law*, in *General Revision*, *supra* note 115, at 23.

119. 17 U.S.C. § 1(e) (1976) (repealed effective 1978) (emphasis added). The House Report on the 1909 Act states: “It is not the intention of the committee to extend the right of copyright to the mechanical reproductions themselves, but only to give the composer or copyright proprietor the control, in accordance with the provisions of the bill, of the manufacture and use of such devices.” H.R. Rep. No. 2222, 60th Cong., 2d Sess. 9 (1909).

120. Note that Congress did exactly this with respect to sound recordings in the 1971 amendment. *See infra* note 124 and accompanying text.

121. *General Revision*, *supra* note 115, at vi n.44.

122. Sound Recording Act of 1971, Pub. L. No. 92-140, 85 Stat. 391 (codified at 17 U.S.C. §§ 1(f), 5(n), 19, 20, 26, 101(e) (1976) (repealed effective 1978)). *Cf.* 17 U.S.C. § 114 (1994).

123. 17 U.S.C. § 5(n) (1976) (repealed effective 1978). Sound recordings are works that result from the fixation of a series of sounds. 17 U.S.C. § 26 (1976) (repealed effective 1978). They differ from musical compositions in that it is the actual sounds recorded that are protected, under the class of sound recordings, against unauthorized sampling or dubbing.

provided that reproductions of the actual sounds are copies of this type of protected work.<sup>124</sup>

It is true that when Congress rewrote the Copyright Act in 1976,<sup>125</sup> the copyright owner was expressly given exclusive rights over “copies or phonorecords,”<sup>126</sup> but this language shows that the two terms are not synonymous. Furthermore, the 1976 Act specifically provides that copies are “material objects, *other than phonorecords*, in which a work is fixed.”<sup>127</sup> Under the 1976 Act, publication poses no threat to common-law rights, because a work must necessarily be fixed in some form, and thus already protected, before it can be published. Nevertheless, publication is expressly defined for the first time, as “the distribution of copies or phonorecords of a work to the public.”<sup>128</sup> Courts have universally accepted that the distribution of copies publishes a work under the 1909 Act,<sup>129</sup> but the inclusion of phonorecords in the 1976 Act does not reflect prior congressional intent.<sup>130</sup> Interpretation of the 1909 Act should not be influenced by the broader scope of the term “publication” in the 1976 Act, but rather should depend solely on the language, structure, and intent of the 1909 Act itself.

### B. Agency Interpretation

*ZZ Top*'s holding that a phonorecord is a copy of the musical composition that publishes the work and divests the author of common-law rights upon distribution overlooks the Copyright Office's interpretation of the 1909 Act. “Phonorecord” and “copy” are used separately throughout the 1976 Act and Copyright Office regulations. For example, a recent regulation on musical scores<sup>131</sup> provides that a musical composition can be published in “copies only, or in both copies and phonorecords.”<sup>132</sup> Another regulation provides that musical compositions, as a class of works protected by the 1909 Act, include

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124. 17 U.S.C. § 26 (1976) (repealed effective 1978).

125. See *supra* note 2.

126. 17 U.S.C. § 106(1) (1994) (emphasis added).

127. 17 U.S.C. § 101 (1994) (emphasis added).

128. 17 U.S.C. § 101 (1994).

129. *E.g.*, *Burke v. National Broadcasting Co.*, 598 F.2d 688, 692 (1st Cir.), *cert. denied*, 444 U.S. 869 (1979).

130. See 1 Nimmer & Nimmer, *supra* note 9, § 4.04, at 4-17 to 4-18.

131. The “score” is another term for sheet music.

132. 37 C.F.R. § 202.20 (1995). See also *supra* notes 126–27 and accompanying text..

“published or unpublished musical compositions in the form of visible notation.”<sup>133</sup>

The Copyright Office’s administrative staff manual<sup>134</sup> clarifies its interpretations of the 1909 Copyright Act and also merits consideration.<sup>135</sup> The manual outlines the effect of publicly disclosing works by means other than distribution of copies.<sup>136</sup> It states that “the act of distributing phonorecords does not constitute such publication as will invest a statutory copyright, except for registration as a sound recording.”<sup>137</sup> Because the act of distribution is insufficient to secure federal copyright, it should not at the same time remove protection under the common law, as the test for divestive publication is more rigorous.<sup>138</sup> The Copyright Office’s interpretation thus implies that the distribution of phonorecords will not divest the author of common-law rights in compositions. Otherwise, phonorecord distribution would unavoidably force an unpublished work into the public domain.

### C. *A Copy Is a Copy Is a Copy . . .*

Although the scope of publication depends on the context involved,<sup>139</sup> the term “copy” should have a consistent definition. The term “copy” is relevant under the 1909 Act in three contexts: infringement, registration, and publication of recorded musical compositions. As for the infringement standard, the *White-Smith* doctrine holds that mechanical reproductions are not considered copies of music.<sup>140</sup> The 1909 Act, providing the compulsory license provisions of 17 U.S.C. § 1(e), accepted this definition.

As for registration of unpublished musical compositions, the 1909 Act allowed the deposit of copies with the Copyright Office,<sup>141</sup> but applicable regulations provided that a “phonograph record . . . is not considered a

133. 37 C.F.R. § 202.8(a) (1977).

134. *Compendium of Copyright Office Practices (As of July 1, 1973)* (1973) [hereinafter *Compendium*]. See also 37 C.F.R. § 201.2(b)(3) (1977).

135. *Skidmore v. Swift & Co.*, 323 U.S. 134 (1944).

136. *Compendium*, *supra* note 134, ch. 3.1.3.

137. *Id.*, ch. 3.1.3(IV)(a), at 3-10.

138. See *supra* notes 35–39 and accompanying text.

139. See *Bartok v. Boosey & Hawkes, Inc.*, 523 F.2d 941, 945 (2d Cir. 1975); *American Visuals Corp. v. Holland*, 239 F.2d 740, 742 (2d Cir. 1956) (discussing the “one-word-one-meaning only fallacy”).

140. *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908).

141. 17 U.S.C. § 12 (1976) (repealed effective 1978).

'copy' of the compositions recorded on it, and is not acceptable for copyright registration."<sup>142</sup> Sheet music was the only medium accepted until the 1976 Act explicitly allowed phonorecords.<sup>143</sup>

Consistent with these statutory definitions of "copy" in the context of infringement and registration, a phonorecord should not be considered a copy of the musical composition that would cause a work to be published. Sound policy supports adherence to the *White-Smith* rule in the context of publication. Otherwise, it would be impossible for the author who distributes recordings of his music to secure federal protection. This is because under section 10 of the 1909 Act copyright may be secured by publication only if notice of copyright is "affixed to each *copy* thereof published."<sup>144</sup> If a phonorecord is considered a copy of the musical work, this provision would conflict with the rule that the failure to affix copyright notice to a phonorecord has no effect on author's rights.<sup>145</sup> Thus, phonorecords are not copies under section 10. Holding them to be copies in the context of publication is contradictory and should be avoided unless the Constitution or the 1909 Act itself mandates the different definition.

Courts should remain sensitive to the equities involved in stripping authors of copyright protection. Because a defendant's production of a phonorecord does not copy a protected work, a phonorecord should not be a copy that triggers publication merely because the copyright owner manufactures it.<sup>146</sup> This reasoning makes sense, as nothing in the 1909 Act indicates the contrary. However, it raises concerns regarding the Supremacy Clause<sup>147</sup> and the states' common-law power to protect recorded compositions without the time limitations imposed on statutory copyright owners.<sup>148</sup>

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142. 37 C.F.R. § 202.8(b) (1977). See, e.g., *Nom Music, Inc. v. Kaslin*, 227 F. Supp. 922, 926 (S.D.N.Y. 1964), *aff'd*, 343 F.2d 198 (2d Cir. 1965).

143. 17 U.S.C. § 408(b) (1994).

144. 17 U.S.C. § 10 (1976) (repealed effective 1978) (emphasis added).

145. E.g., *Jones v. Virgin Records, Ltd.*, 643 F. Supp. 1153, 1157 (S.D.N.Y. 1986). See also *Nom Music*, 227 F. Supp. at 926.

146. See, e.g., *Rosette v. Rainbo Record Mfg. Corp.*, 354 F. Supp. 1183, 1189 (S.D.N.Y. 1973), *aff'd*, 546 F.2d 461 (2d Cir. 1976), in which the court stated:

From this result it was logical to conclude that if the infringing music roll was not a copy of the composition so as to cast its maker in liability, the creation of a music roll by the author himself would not make it a "copy" of his work and hence not a publication of it.

147. U.S. Const., art. VI, cl.2.

148. The constitutional concern stems from the conclusion by the *Rosette* court that "it is unlikely that Congress intended that common-law rights should exceed those of statutory copyright owners"

*D. Holding Phonorecords Incapable of Publication Does Not Threaten Statutory Objectives*

Section 26 of the 1909 Act states that the “date of publication [is the] earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed.”<sup>149</sup> Nevertheless, courts widely accepted that this was not an attempt to define “publication.”<sup>150</sup> Rather, section 26 merely fixes the date from which the statutory term begins to run.<sup>151</sup> Therefore, preemption principles do not bar the exclusion of phonorecord distribution from the definition of publication.<sup>152</sup>

The Ninth Circuit in *ZZ Top* ignored the language of the 1909 Act and agency regulations, asserting what it believed to be policy justifications for its holding that phonorecord distribution is publication of musical compositions. The court hoped to discourage artists from abusing the copyright laws by delaying compliance with the federal act.<sup>153</sup> However, the common law does not threaten adherence to the 1909 Act by providing a disincentive for the recording artist to seek federal protection. The non-publishing author retains the exclusive right to print, publish, copy, or vend the work.<sup>154</sup> Furthermore, musical compositions protected by common law could not be arranged, adapted, or performed publicly without the author’s consent.<sup>155</sup> The Ninth Circuit argued that if the distribution and sale of phonograph records had no effect on these rights, then composers would avoid seeking the limited monopoly of the federal statute.<sup>156</sup> Although the Second Circuit requires registration under the 1909 Act to sue for infringement,<sup>157</sup> the Ninth Circuit feared the inequitable result that the author would wait years before registering, and

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of compositions distributed on phonorecords. 1 *Nimmer & Nimmer, supra* note 9, § 4.05[B] at 4-28 n.28 (quoting *Rosette*, 354 F. Supp. at 1193).

149. 17 U.S.C. § 26 (1976) (repealed effective 1978).

150. *See, e.g., Marx v. United States*, 96 F.2d 204, 206 (9th Cir. 1938).

151. *Patterson v. Century Prods., Inc.*, 93 F.2d 489, 492 (2d Cir. 1937) (citing *Cardinal Film Corp. v. Beck*, 248 F. 368 (S.D.N.Y. 1918)), *cert. denied*, 303 U.S. 655 (1938).

152. *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 663 (2d Cir. 1955); *Tempo Music, Inc. v. Famous Music Corp.*, 838 F. Supp. 162, 171 (S.D.N.Y. 1993).

153. *La Cienega Music Co. v. ZZ Top*, 44 F.3d 813, 815 (9th Cir.), *cert. denied*, 116 S. Ct. 331 (1995).

154. *Bowker, supra* note 40, at 45.

155. *Id.*

156. *ZZ Top*, 44 F.3d at 815.

157. *Rosette v. Rainbo Records Mfg. Corp.*, 354 F. Supp. 1183, 1193 (S.D.N.Y. 1973), *aff’d*, 546 F.2d 461 (2d Cir. 1976).

then still receive the full fifty-six-year protection provided by the 1909 Act.<sup>158</sup>

This undesirable result is avoidable without going to the extreme of holding that public sale of records without notice irrevocably injects musical compositions into the public domain. By upsetting proprietary interests in numerous compositions distributed in phonorecords pursuant to industry practice,<sup>159</sup> the Ninth Circuit's holding in *ZZ Top* is entirely unjustified. As the *Rosette* court noted, precedent should be reliable rather than a trap for the unwary, particularly in a technical field where the lawyers, assumed to be learned, guide the hand of the untutored artist.<sup>160</sup>

The crux of the position that the distribution of phonorecords divests common-law rights in the musical work is the fear that the perpetual monopoly of an exploited work will provide a disincentive to seek federal copyright, burdening the progress of the arts. However, exploitation for profit does not automatically bring a work into the sphere of federal concern.<sup>161</sup> Otherwise, for example, public performance would be publication.<sup>162</sup> This is simply not the case.<sup>163</sup> Although it may, at first glance, seem contrary to common sense to differentiate between the distribution of phonorecords and of sheet music,<sup>164</sup> the language of the 1909 Act, as well as federal policy, supports this result. By withholding copyright protection from phonorecords,<sup>165</sup> Congress has deemed them to be of federal interest under the 1909 Act only to the extent provided in the mechanical royalty provisions of 17 U.S.C. § 1(e). Even if congressional intent was not clear, musical compositions are valuable property rights that should not be divested based on an ambiguous understanding of "publication."

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158. *ZZ Top*, 44 F.3d at 815. Fifty-six years is the sum of the initial 28-year term plus the renewal period.

159. *Rosette*, 354 F. Supp. at 1188; 1 Nimmer & Nimmer, *supra* note 9, § 4.05[B], at 4-28 n.30.

160. *Rosette*, 354 F. Supp. at 1188.

161. The position of the Copyright Office is that distributing phonorecords does not publish the recorded work. *Compendium*, *supra* note 134, ch. 3.1.3(IV)(a), at 3-10.

162. Benjamin Kaplan, *An Unhurried View of Copyright* 84 (1967).

163. *Ferris v. Frohman*, 223 U.S. 424 (1912) (holding that public performance is not a publication).

164. *See RCA Mfg. Co. v. Whiteman*, 114 F.2d 86 (2d Cir.), *cert. denied*, 311 U.S. 712 (1940).

165. 37 C.F.R. § 202.8(b) (1977); *Capitol Records v. Mercury Records Corp.*, 221 F.2d 657, 660 (2d Cir. 1955).

The Copyright Act has two major purposes: to provide an incentive to create original works of art and to reward the owner's labors.<sup>166</sup> As a general rule, protecting author's rights is a secondary consideration, or a means to an end.<sup>167</sup> Intellectual property law serves the larger purpose of creating an incentive to produce works of art for the benefit of the public,<sup>168</sup> but in situations such as that presented in *ZZ Top*, where the phonorecords in question were sold to the public before the effective date of the new Copyright Act, the concern over the promotion of the arts is not present. John Lee Hooker already has shared his work with the world and securing to the author the fruits of his labor should be of singular importance in construing the 1909 Act.

The Ninth Circuit's fear that *Rosette* encourages composers to "abuse" copyright laws by exploiting their works without the exchange for the limited statutory monopoly is at best speculative. Recording artists usually enjoy the greatest commercial success when their songs are first released. If the artist declines to secure statutory protection at the outset, then statutory mechanical royalties are unavailable during the most lucrative period for most popular songs. Congress, however, left the choice up to the artist by providing the option of reliance on common-law protection. The fact that statutory protection is available does not mean that it is the exclusive source of rights. This is evident from the fact that 17 U.S.C. § 12 allowed artists to register unpublished works for statutory protection.<sup>169</sup> By declining to register the work as an unpublished work or to distribute sheet music, the author did no violence to any policy of the 1909 Act.

#### IV. A PROPOSED SOLUTION

The Second Circuit's rule that the distribution of phonorecords does not publish songs presents a partial solution to the problem of copyright protection. The rule avoids the potential inequities involved in removing rights that common industry practice has long recognized. The rule is a

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166. *E.g.*, *Williams & Wilkins Co. v. United States*, 487 F.2d 1345, 1352 (Ct. Cl. 1973), *aff'd*, 420 U.S. 376 (1975).

167. *Id.* See also *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948); *Mazer v. Stein*, 347 U.S. 201, 219 (1954) ("The copyright law . . . makes reward to the owner a secondary consideration.").

168. The House committee that recommended the 1909 Act said that copyright was "[n]ot primarily for the benefit of the author, but primarily for the benefit of the public." H.R. Rep. No. 2222, 60th Cong., 2d Sess. 7 (1909).

169. 17 U.S.C. § 12 (1976) (repealed effective 1978).



justifiable interpretation of the ambiguous language of the 1909 Act. The interpretation fulfills the statutory objective of eventual public access to works, and it protects the rights of the unwary recording artist. Although *Rosette* held that the artist had to register the musical work only if the author wanted to collect mechanical royalties or sue for infringement of a recorded song,<sup>170</sup> the court did not specify how long statutory protection would last. The Ninth Circuit apparently assumed that upon the eventual registration of the work, the author would necessarily be entitled to the full fifty-six years of statutory protection.<sup>171</sup> This is a result that is mandated neither by the *Rosette* analysis nor by the language of the 1909 Act.

The dissent in *La Cienega Music Co. v. ZZ Top*<sup>172</sup> offers the second half of the solution. According to the dissent, the unpublished work could be protected only as long as would have been possible had the author registered the work when he or she first released phonorecords.<sup>173</sup> Thus, the twenty-eight-year initial term would begin to run upon the date of distribution of phonorecords, even if one chose to rely on common-law rights rather than seeking federal statutory protection.<sup>174</sup> This result synthesizes the holding in *White-Smith*<sup>175</sup> that mechanical reproductions are not "copies" of musical works with the purpose of the 1909 Act to protect authors from infringers and pirates.

Section 2 prohibits any construction of the 1909 Act that would annul or limit common-law protection.<sup>176</sup> Although this solution might seem to violate the statute by "limiting" common-law rights in unpublished works,<sup>177</sup> it is necessary to protect authors who relied on the continuing validity of common-law protection. This solution saves a great number of musical compositions from falling into the public domain<sup>178</sup> and effectuates the copyright law's policy of rewarding artistic creation.

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170. *Rosette v. Rainbo Record Mfg. Corp.*, 354 F. Supp. 1183, 1193 (S.D.N.Y. 1973), *aff'd*, 546 F.2d 461 (2d Cir. 1976). This is assuming that the song had not been published as sheet music, which would, in and of itself, have divested common-law protection.

171. 17 U.S.C. § 24 (1976) (repealed effective 1978).

172. 44 F.3d 813 (9th Cir.), *cert. denied*, 116 S. Ct. 331 (1995).

173. 44 F.3d at 817 (Fernandez, J., dissenting).

174. *See supra* notes 28–29 and accompanying text.

175. *White-Smith Music Pub. Co. v. Apollo Co.*, 209 U.S. 1, 17 (1908).

176. 17 U.S.C. § 2 (1976) (repealed effective 1978).

177. 1 *Nimmer & Nimmer*, *supra* note 9, § 4.05[B], at 4-28.

178. *Id.* § 4.05[B], at 4-28 n.30.

Although this solution is not explicitly mandated by the statute,<sup>179</sup> it protects those whom copyright law is meant to protect. The running of the statutory term upon phonorecord distribution is a concession to the public interest of free access to artistic works after a period of protection.<sup>180</sup> In contrast, the court in *ZZ Top* created a no-win situation for the composer by holding that distribution of records without notice divested the author of common-law rights.<sup>181</sup> Because a phonorecord is not a copy, attaching notice thereto does not satisfy the 1909 Act's requirement that notice be affixed to "each copy" published.<sup>182</sup> With the notice mechanism unavailable for phonorecords, the only way a composer could safely distribute recordings of his music to the public would be to first publish or register sheet music with notice—a requirement that is inconsistent with music industry practice.<sup>183</sup> Such a requirement would penalize musicians who are not trained in musical notation or cannot afford a transcriber. Copyright law's purpose of protecting authors cannot be harmonized with the rule proposed in *ZZ Top*, which would divest common-law rights upon phonorecord distribution. This is especially true because the same act is insufficient to invest the musical work with statutory protection.<sup>184</sup>

Publication, which causes a forfeiture of common-law protection, is generally understood to be public distribution of a work in the form of copies. The phonorecord, however, can be distinguished from a copy in many contexts. Under the 1909 Act, an author secures copyright by publishing copies of a work only if notice is "affixed to each *copy* thereof published or offered for sale."<sup>185</sup> In contrast, a phonorecord need not contain a copyright notice.<sup>186</sup> In this context, the difference between

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179. Section 24 provides that the "copyright secured by this title shall endure for twenty-eight years from the date of first publication." 17 U.S.C. § 24 (1976) (repealed effective 1978).

180. Note that this concession is not made in the case of a work that is shared with the world exclusively by public performances, regardless of the number of showings. *See supra* notes 47–48 and accompanying text.

181. *La Cienega Music Co. v. ZZ Top*, 44 F.3d 813, 815 (9th Cir.), *cert. denied*, 116 S. Ct. 331 (1995).

182. 17 U.S.C. § 10 (1976) (repealed effective 1978).

183. *See supra* notes 17–18 and accompanying text.

184. *ZZ Top*, 44 F.3d at 817 (Fernandez, J., dissenting). *See also supra* notes 35–39 and accompanying text.

185. 17 U.S.C. § 10 (1976) (repealed effective 1978) (emphasis added).

186. *Nom Music, Inc. v. Kaslin*, 227 F. Supp. 922, 926 (S.D.N.Y. 1964), *aff'd*, 343 F.2d 198 (2d Cir. 1965). *See also Jones v. Virgin Records, Ltd.*, 643 F. Supp. 1153, 1157 (S.D.N.Y. 1986) ("The failure to affix notice to the phonorecord . . . did not affect any statutory or common law copyright protection otherwise applicable to the underlying work.")

phonorecords and copies is clear. Although Congress has never expressly stated that phonorecords are copies in any context, the Ninth Circuit has held that they are copies in the context of publication under the 1909 Act.<sup>187</sup> Given the severe consequences to artists who have relied on the opposite interpretation, the Ninth Circuit's rule is indefensible in the absence of clear congressional support.

## V. CONCLUSION

Many songs were distributed on phonorecords before January 1, 1978, when the 1909 Act was in effect, without the author affirmatively seeking statutory protection. The understanding of the music industry and the copyright bar was that the consequences of "publication" on common-law rights were not applicable to the distribution of phonorecords. This interpretation was settled as judicial precedent in the Second Circuit, and artists relied on its logic. This rule of law went unchallenged by other circuits until 1995. Although the issue turns on the interpretation of the 1909 Act, substantial property interests are at stake.

The Ninth Circuit rule in *ZZ Top* provides that all compositions released on phonorecords before 1978 without notice of copyright are now in the public domain. While the Ninth Circuit approves of unauthorized copying, the copier would be subject to liability for infringement in the Second Circuit. The diametrically opposed positions between the two circuits that hear the greatest number of music copyright cases must be reconciled.

A sounder rule is that a phonorecord cannot publish the musical composition because it is not a copy thereof. This interpretation of the 1909 Act reflects the intent of Congress, serves the policy of rewarding creative effort, and is consistent with music industry practice. Moreover, the commencement of the statutory term at the time of phonorecord distribution protects the public interest embodied in the "limited times" clause of the Constitution, yet still favors original creation over pirating and copying.

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187. *ZZ Top*, 44 F.3d at 815.