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A "HANDY MAN'S" GUIDE TO COPYRIGHT INFRINGEMENT: STANDING, PUBLIC DOMAIN AND REGISTRATION

Rock and roll was born in the 1950's and exploded into prominence in the 60's. It has become such a powerful force that in the past 30 years there has been little significant change in popular music. The songs of Buddy Holly, Elvis and the Beatles are nearly as popular today as they were when they were originally recorded. Rock and roll artists of the eighties commonly remake old songs and rework old melodies. Thus, the danger exists that the stylistic and melodic similarities between modern music and early rock and roll will give rise to a plethora of infringement claims. *Jones v. Virgin Records, Ltd.*¹ illustrates such a situation.

In 1959, Jimmy Jones and Otis Blackwell composed the song "Handy Man." Jones and Blackwell then assigned their rights in the composition to Shalimar Music Corporation ("Shalimar"). In the assignment agreement² with Shalimar, Jones and Blackwell retained a number of rights in "Handy Man," including the right to receive royalties and the right to sue for copyright infringement if the assignee failed to do so.³ Later that year, Shalimar registered "Handy Man" and filed sheet music of the composition ("1959 version") with the Copyright Office. After a series of conveyances, the copyright was ultimately acquired by CBS Catalogue Partnership, a subsidiary of CBS, Inc. Printed sheet music of the 1959 version was published on two occasions.⁴

In 1960, "Handy Man" was recorded on phonorecords by Jimmy Jones ("1960 version"). The 1960 version contained additional words and music not found in the 1959 version filed with the Copyright Office.⁵

1. 643 F. Supp. 1153 (S.D.N.Y. 1986).

2. The contract of assignment of "Handy Man" was silent on the issue of derivative or altered versions of the assigned work. The court, for the purpose of the standing issue, assumed that the assignment contract contemplated all versions of the work. *Id.* at 1156 n.4.

3. Additional rights retained by the plaintiff were the right to reclaim all rights in the work upon failure of the assignee to publish or produce a phonograph record of the work within a specified period of time and the right to cancel the agreement should the assignee fail to render royalty statements to the composers, pay the royalties due, or provide access to the assignee's books. *Id.* at 1156 n.5.

4. *Id.* at 1155.

5. The 1960 addition to "Handy Man" consisted of an eight measure chorus containing the following words:

Come-a, come-a, come-a
Come-a, come, come
yeah, yeah, yeah

The song was also recorded by Del Shannon in 1964 and James Taylor in 1977.⁶ All three recordings of "Handy Man" contained additional words and music not included in the 1959 copyrighted version. Printed sheet music of the 1960 version was never published.⁷ A copyright in the 1960 version was filed in the name of CBS Catalogue Partnership on August 10, 1984.⁸

More than two decades after "Handy Man" was first recorded, Boy George and the members of his band, Culture Club wrote and recorded the song "Karma Chameleon."⁹ Jones and Blackwell asserted that the chorus of "Karma Chameleon"¹⁰ infringed the words and music added to the 1960 version of "Handy Man."¹¹ According to Jones and Blackwell, financial success of "Handy Man" was largely due to the al-

Come-a, come-a, come-a
 Come-a, come, come
 Hold on, They'll come running to me
 Yeah, Yeah, Yeah
 Yeah, Yeah, Yeah.

6. All three releases of "Handy Man" achieved wide popularity. In 1960, Jimmy Jones' performance of "Handy Man" reached number 2 on the Billboard Magazine Chart of best selling records. James Taylor's performance reached number 4 in 1977 and Del Shannon's version reached number 22 in 1964. *Jones*, 643 F. Supp. at 1155 n.1.

7. The court took judicial notice of the fact that the 1960 version was printed (with notice of copyright) on the album cover of "JT," James Taylor's 1977 recording. However, because neither party addressed the issue, the court did not consider it. *Id.* at 1158 n.11.

8. *Id.* at 1155.

9. "Karma Chameleon" was written and recorded in 1983 and reached number 1 on the national charts in 1984. *Id.*

10. The chorus of "Karma Chameleon" consisted of the words:

Karma, Karma, Karma, Karma
 Karma, Chameleon.

11. The plaintiff's musicological report concluded that:

1. The section of 'Handy Man' and the section of 'Karma Chameleon' which contain the similarities listed above are an important part of each song, constituting in each song the 'hook' or 'ear catcher.' 2. The similarity and, in some cases, the exact duplication of phonetic sounds, combined with rhythm, harmony and melody, is too close to be a coincidence. 3. The authors of 'Karma Chameleon' certainly had the opportunity of hearing 'Handy Man' and, in my opinion, consciously or subconsciously copied the section of 'Handy Man.'

After comparing the words of the two songs, the report stated that:

[a]lthough the public accepts the words in 'Handy Man' as 'com-a, com-a, com-a, com-a, com-a' and the words in 'Karma Chameleon' as 'karma, karma, karma, karma, karma,' this is probably because the public knows the name of the latter song.

I listened to the applicable sections of the three versions, and they are indistinguishable. In the Culture Club version, in the 'come and go' phrase, the 'come' and 'karm' aurally are the same.

The writer of the report, Oscar Brand, a writer and composer, advised the plaintiffs to use the rock version of "Handy Man" as sung by Jimmy Jones for comparison. The suggestion was made because the original James Taylor performance of "Handy Man" and Boy George's performance of "Karma Chameleon," in Mr. Brand's opinion, "sound very different because the arrangements are years apart." Musicological Report by Oscar Brand (Nov. 12, 1984).

legedly infringed, "ear-catching"¹² portion of the chorus which was added to the 1960 version.¹³

Blackwell and Jones instituted a copyright infringement suit against Virgin Records, Ltd. and Epic Records, issuers of the "Karma Chameleon" phonorecords; Virgin Music Publishing, Ltd. and Warner Tamerlan Music, the owners of the copyright in "Karma Chameleon;" and CBS Catalogue Partnership.¹⁴ They sought injunctive relief, actual damages, lost profits and reasonable attorney's fees.¹⁵

The defendants, Virgin Music Publishing Ltd. and Virgin Records Ltd. moved for partial summary judgment. In support of their motion, the defendants first asserted that Jones and Blackwell lacked standing to sue for infringement since they assigned their copyright to Shalimar; and in the alternative, that they failed to allege facts sufficient to establish such standing. Second, defendants contended that "Handy Man" entered the public domain because a copyright notice was not affixed to the phonorecords and the song was published without statutory copyright protection. Third, defendants maintained that the 1984 copyright registration of the 1960 version of "Handy Man" was ineffective. Finally, defendants claimed that the plaintiffs were estopped from alleging infringement because the owner of "Handy Man" and the owner of "Karma Chameleon" shared the same corporate identity.¹⁶

In March of 1986, the United States District Court for the Southern District of New York held in favor of the plaintiffs and denied summary judgment to the defendants.¹⁷ In rejecting the defendants first argument, that Jones and Blackwell relinquished their standing to sue when they assigned the copyright in "Handy Man," the court relied on *Cortner v. Israel*.¹⁸ Under *Cortner*, a composer's right to receive royalties was a

12. The plaintiff's musicological report explains that "[p]op songs are often built around a gimmick—an 'ear-catcher' that may be a repeated instrumental figure, an interesting bass run, or a catchy rhythmic refrain. In these songs, the same catchy phrase is used to catch the attention of the audience." Musicological Report by Oscar Brand (Nov. 12, 1984).

13. *Jones*, 643 F. Supp. at 1155.

14. *Id.* CBS Catalogue Partnership, the owner of the copyright in the song "Handy Man" at the time of the motion for summary judgment, was joined as a defendant because, according to the 1909 Copyright Act, a beneficial owner could bring an infringement action only after the assignee had refused to bring such an action and the beneficial owner joined the assignee as a party defendant to the action. *Id.* at 1160 n.18 (citing *Manning v. Miller Music Corp.*, 174 F. Supp. 192 (S.D.N.Y. 1959)). However, because the 1976 Act was the appropriate Act for the standing issue, it was not necessary to join the assignee as a party. See *infra* text accompanying notes 52-57.

15. *Jones*, 643 F. Supp. at 1154-55.

16. *Id.* at 1156.

17. *Id.* at 1161.

18. 732 F.2d 267 (2d Cir. 1984).

sufficient beneficial interest in the copyright to give them standing to sue under both the 1909 and 1976 Copyright Acts. The 1976 Act codified case law that developed under the 1909 Act which conferred a right to sue for infringement on the beneficial owner.¹⁹ The House Report accompanying the 1976 Act states: “[a] ‘beneficial owner’ for this purpose would include, for example, an author who had parted with legal title to the copyright in exchange for percentage royalties based on sales or license fees.”²⁰

Additionally, the *Cortner* court espoused its own justification for allowing a party receiving royalties to institute an action for infringement. It reasoned that “[w]hen a composer assigns copyright title to a publisher in exchange for the payment of royalties, an equitable trust relationship is established . . . which gives the composer standing to sue for infringement Otherwise the beneficial owner’s interest in the copyright could be diluted or lessened by a wrongdoer’s infringement.”²¹

The *Jones* court found that Jones and Blackwell had a sufficient beneficial interest in the song to maintain an action for infringement. The court’s decision was founded on the fact that in the assignment agreement with Shalimar, Jones and Blackwell had retained a number of rights in “Handy Man,” including the right to receive royalties and the right to sue for copyright infringement.²²

The court was unpersuaded by the defendants’ alternative claim that Jones and Blackwell insufficiently alleged the existence of a present beneficial interest since no evidence of a subsequent chain of ownership was produced. Although the plaintiffs did not submit evidence of a present beneficial interest in the song, they did attach the original assignment contract proclaiming the rights they retained in “Handy Man” to the affidavit in opposition to the motion for summary judgment. The court found that the attached contract was sufficient evidence to defeat a motion for summary judgment.²³

Next, the court rejected as “meritless” the defendants’ second contention that failure to affix a copyright notice to the 1960 phonorecords of “Handy Man” caused the work to be surrendered to the public do-

19. “The legal or beneficial owner of an exclusive right under a copyright is entitled, subject to the requirements of sections 205(d) and 411, to institute an action for any infringement of that particular right committed while he or she is the owner of it.” 17 U.S.C. § 501(b) (1982).

20. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 159 (1976), reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5775.

21. *Cortner*, 732 F.2d at 271.

22. *Jones v. Virgin Records, Ltd.*, 643 F. Supp. 1153, 1156-57 (S.D.N.Y. 1986).

23. *Jones*, 643 F. Supp. at 1157.

main. Section 9 of the 1909 Copyright Act required that notice of copyright be affixed to each published copy of a work to secure statutory copyright protection in that copy.²⁴ The issue then became whether a phonorecord was a "copy" for notice purposes under the 1909 Act. In 1908 the United States Supreme Court in *White-Smith Publishing Co. v. Apollo Co.*,²⁵ declared that "a music roll [for mechanical pianos] (and by extension a phonorecord) is not a copy . . . since a copy must be intelligible and in a form which can be seen or read."²⁶ The definition of "copy" set forth in *White-Smith* was adopted by the 1909 Copyright Act. Consequently, failure to affix notice to a phonorecord did not defeat any copyright protection otherwise applicable to the underlying musical work recorded therein.

Similarly, the 1976 Copyright Act does not require that a copyright notice be affixed to a phonorecord in order to protect the underlying musical work. The section 401 notice requirements for literary and musical works apply only to "copies from which the work can be visually perceived"²⁷ Since a literary or musical work embodied in a phonorecord cannot be visually perceived, there is no need to place a notice of copyright on the phonorecord in order to ensure copyright protection under the current Act.²⁸

There is also a notice requirement for sound recordings under section 402 of the 1976 Act.²⁹ However, section 402 was inapplicable because it protected sound recordings only.³⁰ Under copyright law, literary or musical works are considered separate works from sound recordings. Each separate work is protected independently. A phonorecord may embody not only a sound recording, but also other works, such as literary or musical creations. In order to avoid the possible confusion that may re-

24. *Id.* at n.6 (citing 17 U.S.C. § 9 (1909)).

25. 209 U.S. 1 (1908).

26. *Jones*, 643 F. Supp. at 1157 (citing *White-Smith*, 209 U.S. at 17).

27. Whenever a work protected under this title is published in the United States or elsewhere by authority of the copyright owner, a notice of copyright as provided by this section shall be placed on all publicly distributed copies from which the work can be visually perceived, either directly or with the aid of a machine or device.

17 U.S.C. § 401(a) (1982).

28. 2 NIMMER, NIMMER ON COPYRIGHT § 7.12[B] (1987).

29. "Whenever a sound recording protected under this title is published in the United States or elsewhere by authority of the copyright owner, a notice of copyright as provided by this section shall be placed on all publicly distributed phonorecords of the sound recording." 17 U.S.C. § 402(a) (1982).

30. "'Sound recordings' are works that result from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects, such as disks, tapes, or other phonorecords, in which they are embodied." 17 U.S.C. § 101 (1982).

sult from having the same notice requirements applying to sound recordings and to the literary and musical works they incorporate, Congress determined that the copyright notice which must be placed on phonorecords would be required only for the protection of the sound recording, not the underlying literary or musical work, embodied therein.³¹ Therefore, the failure of Jones and Blackwell to affix a notice of copyright on the phonorecords did not defeat their claim for infringement of the underlying musical composition.

The defendants also claimed that "Handy Man" was injected into the public domain because it was "published" without statutory copyright protection. However, the court concluded that the 1960 version of "Handy Man" had *not* been "published" and was, therefore, protected by a common law copyright. The *Jones* court relied on the Second Circuit's decision in *Roy Export Co. Establishment of Vaduz, Liechtenstein v. Columbia Broadcasting System, Inc.*,³² to explain the relevance of publication with regards to the 1909 Copyright Act. In *Roy Export*, the court stated that "publication" generally determines whether state [common] or federal law is the source of any available copyright protection."³³ Common law copyright protection attached from the time a work was created and continued until the work was published or was registered as a published or unpublished work. In other words, when a work was published, common law copyright protection was extinguished. In order to receive federal statutory protection after publication, the work must have been registered in compliance with the 1909 Act. If not registered, the published work entered the public domain.³⁴

In its attempt to define "publication" for the purpose of the 1909 Act³⁵ the *Jones* court relied on *Rosette v. Rainbo Record Manufacturing Corp.*³⁶ There, the court held that the recording and selling of phonorecords did not constitute publication of the underlying musical composition. That conclusion was arrived at by extending the decision of *White-Smith*.³⁷ The *Rosette* court stated that: "if the infringing music roll was not a copy of the composition . . . 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."³⁸ *Rosette* interpreted *White-Smith* to stand for the

31. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 145 (1976).

32. 672 F.2d 1095 (2d Cir. 1982), *cert. denied*, 459 U.S. 826 (1982).

33. *Id.* at 1101.

34. *Id.*

35. The 1909 Copyright Act did not include a definition of "publication."

36. 354 F. Supp. 1183 (S.D.N.Y. 1973), *aff'd per curiam*, 546 F.2d 461 (2d Cir. 1976).

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

38. *Rosette*, 354 F. Supp. at 1189.

proposition that a mechanical reproduction constituted performance, analogous to a live performance, and therefore was not a publication.³⁹ Because the 1960 version of "Handy Man" was only available to the public in the form of phonorecords, the court concluded that it was *not* "published." Consequently, the 1960 version retained its common law copyright protection as an unpublished work under the 1909 Copyright Act.

As stated above, the defendants' third argument in favor of the motion for summary judgment was that Jones and Blackwell's 1984 registration of the 1960 version of "Handy Man" was ineffective. Defendants asserted that the filing of a supplemental registration was the inappropriate procedure to reflect changes in the content of a work already registered. However, the court found that no supplemental registration was filed. Rather, in 1984, the 1960 version of "Handy Man" was registered as a derivative work.⁴⁰ The court relied on the fact that plaintiffs did nothing to suggest that the 1984 registration was supplemental rather than derivative.⁴¹

Finally, the defendants asserted that the copyright owner of "Handy Man"⁴² and the copyright owner of "Karma Chameleon"⁴³ shared a corporate identity; and therefore, Jones and Blackwell were estopped from alleging infringement since CBS itself was a participant in the infringement. Because the defendants failed to present sufficient evidence of a shared corporate identity, the court held that the plaintiffs were not estopped from alleging infringement.⁴⁴

APPROACHING A COPYRIGHT INFRINGEMENT ACTION

Before the enactment of the 1976 Act, intellectual property was protected by a dual system of copyright. Unpublished works were protected

39. *Id.*

40. A derivative work is defined as "a work based upon one or more pre-existing works, such as a . . . musical arrangement . . . [and a] work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship . . ." 17 U.S.C. § 101 (1982). Prior to the effective date of the 1976 Act, derivative works were accorded copyright protection by § 7 of the 1909 Act, and unpublished works were protected by the doctrine of common law copyright. 1 NIMMER *supra* note 28, § 3.01, 3-2 n.2.

41. *Jones v. Virgin Records, Ltd.*, 643 F. Supp. 1153 (S.D.N.Y. 1986).

42. At the time of the motion for summary judgment before the court, the copyright in "Handy Man" was owned by CBS Catalogue Partnership, a subsidiary of CBS, Inc. *Jones*, 643 F. Supp. at 1155.

43. "Karma Chameleon" was released by Epic Records, a purported division of CBS, Inc. *Jones*, 643 F. Supp. at 1160.

44. *Jones*, 643 F. Supp. at 1160.

by a common law copyright and published works that were registered were protected by statutory copyright. When Congress passed the 1976 Act, it intended to abolish the dual system of copyright and adopt a single system of federal statutory copyright.⁴⁵ Under the 1976 Act a work obtains statutory copyright protection "from 'creation,' that is, from the time a work is 'fixed' in a copy or phonorecord for the first time."⁴⁶ Any work which was already protected by a statutory or common law copyright prior to January 1, 1978, the date the 1976 Act went into effect, is given automatic statutory copyright protection under the 1976 Act.⁴⁷

It appears as if the 1976 Act ended the era of common law copyright. For most purposes, the current Act does eliminate the distinction between common law and statutory copyright. However, problems will continue to arise for some time concerning the availability of pre-1978 common law protection. Specifically, common law protection will be significant with regards to challenges to statutory copyrights, on the ground that the work entered the public domain prior to January 1, 1978. Also, there will be issues concerning pre-1978 infringement of common law rights.⁴⁸ Since a great deal of progress in rock and roll was before the enactment of the 1976 Act, pre-1978 law will impact copyright law and the music industry well into the future.

Because of the continuing significance of both the 1976 Act and pre-1978 law, it is imperative that an attorney, when dealing with copyright infringement, ascertain which Act is applicable to each issue separately before analyzing that issue. Then, when papers are submitted to the court, the conclusions as to the relevant Act should be stated to ensure a correct analysis by the court.

Standing

When faced with a copyright infringement action, the initial inquiry by an attorney and the court should be whether the plaintiff has standing to sue for the alleged infringement. A person claiming that his work was infringed must show that he has a sufficient interest in the work to maintain a copyright infringement suit. Under the 1909 Copyright Act, only the copyright proprietor possessed a sufficient interest for standing to sue

45. *Klekas v. EMI Films, Inc.*, 150 Cal. App. 3d 1102, 1109, 198 Cal. Rptr. 296 (1984) (citing 1 NIMMER, NIMMER ON COPYRIGHT § 1.01[B], at 1-8 (1983); H.R. REP. NO. 1476, 94th Cong., 2d Sess. 129-131 (1976)).

46. *Id.*

47. 17 U.S.C. § 301(a) (1982).

48. *Roy Export Co. Estab. of Vaduz v. Columbia Broadcasting Sys., Inc.*, 672 F.2d 1095, 1097 n.2 (2d Cir. 1982), *cert. denied*, 459 U.S. 826 (1982) (citing 1 NIMMER, NIMMER ON COPYRIGHT § 4.01[B] (1981)).

for copyright infringement.⁴⁹ A "copyright proprietor" was defined as an author of the work or his assignee, who owned the copyright at the time of the infringement.⁵⁰

However, the district court in *Manning v. Miller Music Corp.*⁵¹ extended the rule to allow the composers of a song to bring suit although they had assigned their copyright ownership. The *Manning* court held that the peculiar relationship between an author and his or her publisher created a fiduciary relationship.⁵² That relationship imposed "equitable obligations upon the publisher beyond those ordinarily imposed by law upon those dealing fully at arms' length, which [gave] the plaintiffs standing to sue"⁵³ But the fiduciary relationship alone was not enough for standing to maintain a copyright infringement suit. Under the 1909 Act, an assignor who retained a beneficial interest under a publication contract could sue a third party for infringement only if the assignee of the work had first refused to bring such an action and was joined as a party to the action.⁵⁴

As previously stated, the 1976 Act also allows the beneficial owner of a work to sue for copyright infringement.⁵⁵ An author who retains a right to receive royalties in an assignment contract is considered a beneficial owner for standing purposes.⁵⁶ The beneficial owner has an absolute right to bring an infringement action under the current Act. It is no longer required that the assignee refuse to bring the action and be joined as a party.

Confusion has arisen over which Act the court should apply. To the extent that a beneficial owner's standing to sue differs between the 1909 Act and the 1976 Act, the current Act should be applied to causes of action arising after January 1, 1978, even if the instrument creating the

49. 17 U.S.C. § 101 [of the 1909 Act] provides that one who infringes the copyright in any protected work shall be liable to 'pay to the copyright proprietor' damages. Section 112 [of the 1909 Act] provides for injunctive relief to 'any party aggrieved' but the 'party aggrieved' must have the right to maintain a suit under Section 101 as a 'copyright proprietor' in order to be entitled to such injunctive relief.

Manning v. Miller Music Corp., 174 F. Supp. 192, 194 (S.D.N.Y. 1959) (citing *Goldwyn Pictures Corp. v. Howells Sales Co.*, 282 F. 9 (2d Cir. 1922).

50. *Manning*, 174 F. Supp. at 194.

51. 174 F. Supp. 192 (S.D.N.Y. 1959).

52. "The law implies a promise on the [publisher's] part to endeavor to make the [work] productive, since that is the very purpose of the assignment of literary rights and the correlative obligation to pay royalties." *Manning*, 174 F. Supp. at 196 (quoting *Schisgall v. Fairchild Publications, Inc.*, 137 N.Y.S.2d 312, 318 (1955)).

53. *Manning*, 174 F. Supp. at 196.

54. 3 NIMMER, *supra* note 28, § 12.02, at 12-28.

55. 17 U.S.C. § 501(b) (1982).

56. *Cortner v. Israel*, 732 F.2d 267, 271 (2d Cir. 1984).

beneficial interest was executed before 1978.⁵⁷ Because all copyrighted works in existence prior to 1978 were given automatic statutory protection under the 1976 Act, that statutory protection is invoked for causes of action arising after the effective date of the new Act. The date the allegedly infringed work was written or recorded is irrelevant for standing, as is the date of the instrument creating the beneficial interest in the work. Common law causes of action are preserved only if they arose "from undertakings commenced before January 1, 1978."⁵⁸ "Undertakings commenced" has been construed to mean when the cause of action arose, in other words, when the infringement took place.⁵⁹

Therefore, when researching a standing issue for a copyright infringement action, an attorney must first determine when the cause of action arose. If the infringement took place before January 1, 1978, then state law should be applied. If the cause of action arose after January 1, 1978 then the 1976 Act is the applicable law. The next inquiry should be whether the plaintiff has a sufficient beneficial interest in the work to sue for infringement according to the relevant law.

The cause of action in *Jones* arose in 1983 when "Karma Chameleon" was written and recorded. The fact that the assignment contract giving Jones and Blackwell a beneficial interest in "Handy Man" was executed in 1959 is not relevant to which Act applies to the standing issue. The court in *Jones* correctly applied the 1976 Act when it determined that Jones and Blackwell had standing to sue for infringement. As a result of applying the 1978 Act, Jones and Blackwell were accurately found to have a sufficient beneficial interest in "Handy Man" to maintain an infringement action.

Public Domain

Once it is determined that the plaintiff does have standing to sue for infringement, the next issue is whether the allegedly infringed work is protected by a copyright. If a work has entered the public domain, it is no longer protected and a beneficial owner cannot sue for infringement.

Under the 1909 Act, the determination as to whether an unregis-

57. 3 NIMMER, *supra* note 28, § 12.02 at 12-28 n.20.1. According to Professor Nimmer, "Cortner v. Israel (citation omitted) erroneously applied the 1909 Act because the instrument was executed pre-1978. In affirming (citation omitted), the Court of Appeals avoided the issue of which Act applies." *Id.*

58. 17 U.S.C. § 301(b)(2) (1982).

59. See *Mention v. Gessell*, 714 F.2d 87, 90 (9th Cir. 1983); *Strout Realty, Inc. v. Country 22 Real Estate Corp.*, 493 F. Supp. 997, 1000 (W.D. Mo. 1980); *Bromhall v. Rorvik*, 478 F. Supp. 361, 366 (E.D. Pa. 1979); *Klekas v. EMI Films, Inc.*, 150 Cal. App. 3d 1102, 1109-10, 198 Cal. Rptr. 296 (1984).

tered work was in the public domain or was protected by a common law copyright depended on whether it was published or unpublished. As discussed above, if a published work was not registered, it entered the public domain and lost all copyright protection.⁶⁰ Consequently, the definition of "publication" often determined the outcome of a copyright infringement case. Because of the importance of the publication issue, the decision whether a literary or musical work was published by the sale of phonorecords embodying such work was a highly disputed issue under the 1909 Act.

The rule that public distribution of phonorecords does not constitute publication of the underlying literary or musical work was first expressed in *White-Smith*,⁶¹ just prior to the adoption of the 1909 Act. In 1976, before the 1976 Act came into effect, the court in *Rosette*⁶² followed the *White-Smith* decision. Nevertheless, most courts faced with the question decided that public sale or other distribution of phonorecords *does* constitute publication.⁶³

The rationale for declaring that distribution of phonorecords constitutes "publication" is that, in permitting records of a work to be publicly marketed, an author is engaging in a form of exploitation of his work, and should therefore have been required to seek statutory copyright protection rather than common-law copyright protection.⁶⁴ By declaring that the distribution of phonorecords is publication, a court is forcing compliance with the Copyright Act's registration requirements.

The dispute over the definition of publication was resolved by the enactment of the 1976 Act. Under the current Act, "publication" is defined as "the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending."⁶⁵ Furthermore, under section 102 of the 1976 Act, any "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device,"⁶⁶ are protected by a statutory copyright, whether or not the work is published. The effect of section 102 is to prevent publica-

60. See *supra* text accompanying notes 32-34.

61. *White-Smith Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908). See *supra* text accompanying note 25.

62. *Rosette v. Rainbo Record Mfg. Corp.*, 354 F. Supp. 1183 (S.D.N.Y. 1973), *aff'd per curiam*, 546 F.2d 461 (2d Cir. 1976). See *supra* text accompanying note 36.

63. 1 NIMMER, *supra* note 28, § 4.05[B], at 4-26. See also *id.* at n.18.

64. 1 NIMMER, *supra* note 28, § 4.05[B], at 4-26 (1987).

65. 17 U.S.C. § 101.

66. *Id.* at § 102.

tion from surrendering an unregistered work to the public domain. Thus, by enacting that section, Congress was attempting to solve the publication controversy.

Unfortunately, the 1976 Act did not completely resolve the publication dispute since pre-1978 law still is applicable in certain situations. Therefore, because of the continuing relevance of the 1909 Act, it is necessary for attorneys to determine which Act applies to the issue at hand. No work which entered the public domain prior to January 1, 1978, may be protected by a statutory copyright under the current Act.⁶⁷ The determination of whether the work was injected into the public domain before the effective date of the 1976 Act depends on whether a copyright existed as of January 1, 1978. If the work was not protected by either a common law copyright or a statutory copyright under the 1909 Act as of that date, it entered the public domain, and thus was not protected under the 1976 Act.⁶⁸ The determination whether a work was surrendered to the public domain prior to January 1, 1978 "must be made according to the copyright law as it existed before that date."⁶⁹

When analyzing whether a work entered the public domain prior to 1978, an attorney must first inquire into when the work was initially distributed on phonorecords. If the work was first distributed after January 1, 1978, then the 1976 Act would apply. If the first sales of phonorecords occurred prior to January 1, 1978, then the next question would be whether the work was registered under the 1909 Act. If the work was registered, then it was protected and did not enter the public domain.

However, if the work was not registered under the 1909 Act but pre-1978 phonorecord sales did occur then the issue becomes whether the distribution of phonorecords constitutes publication. Because of the split of authority, an attorney must research the law according to the jurisdiction in which the action is brought. If distribution of phonorecords is considered publication in the particular jurisdiction, then the work has entered the public domain and an infringement action cannot be maintained. Conversely, if in the jurisdiction, courts hold that distribution is not publication, then the work was protected by common law copyright and automatically obtained statutory protection under the 1976 Act.

In *Jones*, the court correctly applied the 1909 Act to the publication issue as the first sale of phonorecords of "Handy Man" occurred in 1960.

67. *Brown v. Tabb*, 714 F.2d 1088, 1090 (11th Cir. 1983).

68. *Id.*

69. *Id.* at 1091 (citing *Data Cash Systems, Inc. v. JS & A Group, Inc.*, 628 F.2d 1038, 1042 (7th Cir. 1980)).

The court in *Jones* applied *Rosette*,⁷⁰ a case decided in the same circuit,⁷¹ to interpret the language of the 1909 Act. However, the majority of the courts interpreting the 1909 Act do *not* hold as did the court in *Rosette* and *Jones*. Most courts have come to the contrary conclusion that the distribution of phonorecords is publication.⁷² Had the *Jones* court found that the recording and selling of "Handy Man" records did constitute publication, the song would have entered the public domain prior to January 1, 1978 and summary judgment in favor of the defendants would have been granted.

The rule in *Rosette* is useful to courts, such as *Jones*, which seek a means to enforce, under the 1976 Act, the copyright in works which were sold on phonorecords prior to January 1, 1978 and which were protected only by common law copyright.⁷³ At first blush, the *Rosette* decision may seem untenable because of the seemingly illogical conclusion that distribution of records is not publication, especially since the current Act explicitly defines publication to include the distribution of phonorecords.⁷⁴ However, upon analysis of past industry practice,⁷⁵ the outcome appears justifiable.

Often copyright owners under the 1909 Act did not obtain a statutory copyright before selling phonorecords, frequently as a deliberate omission on advice of counsel who relied on *White-Smith*,⁷⁶ to advise clients that the sale of a phonorecord would not surrender the work to the public domain. Consequently, the majority rule, that record sales constitute publication, resulted in the discharge of a substantial body of music into the public domain.⁷⁷ In order to prevent harm to those who followed industry practice, courts may wish to follow *Jones* and *Rosette*

70. *Rosette v. Rainbo Record Mfg. Corp.*, 354 F. Supp. 1183 (S.D.N.Y. 1973), *aff'd per curiam*, 546 F.2d 461 (2d Cir. 1976). See *supra* text accompanying note 36.

71. Because *Rosette* was affirmed *per curiam* by the Second Circuit, it is the most authoritative decision on the publication issue under the 1909 Act. 1 NIMMER, *supra* note 28, § 4.05[B] at 4-28 n.29.

72. 1 NIMMER, *supra* note 28, § 4.05[B] at 4-25-26. See *McIntyre v. Double A Music Corp.*, 166 F. Supp. 681 (S.D. Cal. 1958); *Shapiro, Bernstein & Co. v. Miracle Record Co.*, 91 F. Supp. 473 (N.D. Ill. 1950); *Mills Music, Inc. v. Cromwell Music, Inc.*, 126 F. Supp. 54 (S.D.N.Y. 1954); *Hemingway v. Random House, Inc.*, 53 Misc. 2d 462, 270 N.Y.S.2d 51 (Sup. Ct. 1967); *International Tape Mfrs. Ass'n v. Gerstein*, 344 F. Supp. 38 (S.D. Fla. 1972), *vacated for lack of ripeness* 494 F.2d 25 (5th Cir. 1974).

73. 1 NIMMER, *supra* note 28, § 4.05[B] at 4-28-29.

74. 17 U.S.C. § 101 (1982).

75. 1 NIMMER, *supra* note 28, at § 4.05[B] [4].

76. *White-Smith Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908). See *supra* text accompanying note 25.

77. 1 NIMMER, *supra* note 28, § 4.05[B] at 4-31.

and hold that distribution of phonorecords does not constitute publication.

Notice

When faced with an action for the infringement of a literary or musical work, the notice requirement is irrelevant. Under both the 1909 Act and the 1976 Act, notice need not be affixed to phonorecords in order to protect the underlying literary or musical work.⁷⁸ Congress was concerned that there would be confusion if the same notice requirements applied to sound recordings and to the works they incorporate; therefore, they chose to exempt literary or musical works embodied in phonorecords from the notice requirements of section 402 of the 1976 Act.⁷⁹ However, the 1976 Act could have provided for a separate, distinguishable notice requirement for underlying literary or musical works. Such a requirement would have solved the confusion problem, while at the same time given the public notice that a work was copyrighted.

Registration

After deciding that a work has not entered the public domain and is protected by a copyright, the next question is whether there has been an infringement.⁸⁰ The last issue inquires into what damages can be recovered. Although this casenote does not discuss damages for copyright infringement, the registration issue is intertwined with the damages issue since the date of registration limits the amount of damages recoverable.

A work need not be registered in order to be protected by a copyright under the 1976 Act. Section 408⁸¹ governs copyright registration in general and states that "[a]t any time during the subsistence of copyright in any published or unpublished work, the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim"⁸² Yet, registration is a prerequisite to a copyright infringement action.⁸³ In addition, statutory damages are not recoverable for infringement prior to the registration of a work.⁸⁴ For that reason, it is advisable to register a song as soon as possible.

Since the court found that "Handy Man" was protected by common

78. See *supra* text accompanying notes 24-31.

79. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 145 (1976).

80. The criteria for what constitutes an infringement is beyond the scope of this article.

81. 17 U.S.C. § 408 (1982).

82. *Id.* at § 408(a).

83. *Id.* at § 411.

84. *Id.* at § 412.

law copyright, it was automatically protected under the 1976 Act. Therefore, Jones and Blackwell's 1984 registration of the song was necessary for initiating a lawsuit, but not for copyright protection itself. If the *Jones* court had decided the remedies issue,⁸⁵ it is probable that the late registration of "Handy Man" would have limited the amount of damages recoverable to Jones and Blackwell.

CONCLUSION

Since both the 1909 and the 1976 Acts may be applicable, depending on the issue, it is easy for the courts and parties to an action to become confused. The court in *Jones* correctly used the appropriate Acts for each issue but never explained the reason for using a given Act. In order to provide better guidance for future courts, the *Jones* court should have clearly indicated which Act it was applying and why. Unfortunately, the confusion will continue since provisions of the 1909 Act will be applicable for many years to come. Therefore, it is important for attorneys, when dealing with copyright infringement, to first ascertain which Act is applicable to each issue separately. The analysis and conclusions as to the relevant Act should be stated in the papers filed with the court to ensure a correct analysis by the court.

Copyright law was developed in order to protect those persons who wish to turn their imaginations into a career. The imagination is one of the most important aspects of the human intellect. Once a work is created, it is necessary to protect that work as an incentive for future artists to make use of their creativity. The *Jones* decision will help preserve copyright protection for many of the early creators of rock and roll music.

Susan B. Frank

85. *Jones v. Virgin Records, Ltd.*, 643 F. Supp. 1153, 1161 (S.D.N.Y. 1986).

