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## Cases of Note - Copyright

Bruce Strauch

*The Citadel*, [strauchb@citadel.edu](mailto:strauchb@citadel.edu)

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## Cases of Note — Copyright

**Acuff-Rose in the News Again — Originality v. Novelty;  
Copyright infringement—Conflict of laws— Russian copyright  
law on works-for-hire; U.S. Copyright law—Works-for-hire—  
Reverse passing off**

by **Bruce Strauch** (The Citadel) <strauchb@cofc.edu>



### Copyright - Acuff-Rose in the News Again — Originality v. Novelty

**Acuff-Rose Music, Inc. v. Jostens, Inc.**,  
\_\_\_F.3d\_\_\_ (2d Cir.1998); 47 U.S.P.Q. 2d 1810;  
1998 WL 544189.

*The Second Circuit is New York, Connecticut  
and Vermont.*

The country music song "You've Got to  
Stand for Something" repeats the lyrics  
"you've got to stand for something or you'll  
fall for anything."

**Plaintiff** music publishing company  
**Acuff-Rose** owns the copyright. **Defendant**  
**Jostens** manufactures high school class rings.  
Its national ad campaign used the words "If  
you don't stand for something, you'll fall for  
anything." The trial court judge felt there was  
a question of fact for the jury as to whether  
Jostens copied the lyrics. Both sides insisted  
the judge settle the matter right there in a  
bench trial. The judge held that although  
Jostens did copy the lyrics, they were not  
original and therefore not protected by copy-  
right. *Acuff-Rose Music*, 988 F. Supp. at 294.  
*Acuff-Rose* appealed.

Originality is required for copyright pro-  
tection. "Original" means it was (1) "inde-  
pendently created" by the author (as opposed  
to copied from other works), and (2) that it  
possesses at least some minimal degree of  
creativity." Novelty is not required. A work  
that resembles others may still be original as  
long as it was not copied. *Feist Publications v.*  
*Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

Infringement occurs only upon copying.  
Thus two artists could independently arrive  
at an identical work. Neither would be novel,  
but each would be original and therefore copy-  
rightable. *Alfred Bell Co. v. Catalda Fine Arts,*  
*Inc.*, 191 F.2d 99, 103 (2d Cir. 1951). "The  
doctrine of anticipation ... does not apply to  
copyrights ... The 'author' is entitled to a copy-  
right if he independently contrived a work  
completely identical with what went before..."  
*Sheldon v. Metro-Goldwyn Pictures Corp.*, 81  
F.2d 49, 53 (2d Cir.1936).

If this sounds weird, think of a teenage  
garage musician doing whatever one does to  
create new music on a guitar. Swearing he  
has never listened to the music of his grand-

parents, he writes the song "How Much Is  
That Doggy in the Window?" Can you really  
believe he did this on his own? Or would you  
think it more likely he heard the song some-  
where? That is the question of fact for a jury,  
or in this case, a judge.

Jostens presented extensive documenta-  
tion that the phrase had been around for a long  
time. Cited sources were the *Bible*, **Abraham  
Lincoln**, **Martin Luther King**, **Malcolm X**,  
**Ginger Rogers**, and a chaplain of the U.S.  
Senate. In 1985, **John Cougar Mellencamp**  
recorded a song using the lyrics. Their theory  
was that the lyrics in no way were original to  
the Acuff-Rose musicians. The words had to have  
been lifted from that body of "old sayings."

Acuff-Rose submitted a letter in which one  
of the authors of the song told a pal the lyrics  
were original to him. While that was some  
evidence of independent creation, the trial  
judge felt the phrase "enjoyed a robust exist-  
ence in the public domain"—so robust that it  
seemed unlikely the author had created it de-  
spite what the letter said. Which is the func-  
tion of the judge in a bench trial. Determine  
the law. Decide on the facts. The appellate  
court affirmed.

### Copyright infringement— Conflict of laws— Russian copyright law on works-for-hire

**Itar-Tass Russian News Agency v. Rus-  
sian Kurier, Inc.**, \_\_\_F.3d\_\_\_; 47 U.S.P.Q.2d  
1810, 1998 WL 544189 (2d Cir.(N.Y.))

"This is an appeal from an injunction and  
damages. **Defendant Russian Kurier** is a  
Russian language newspaper in the New York  
area with a circulation of 20,000. **Plaintiff**  
**Itar-Tass Russian News Agency** is a wire  
service formerly known as TASS (Telegraph  
Agency of the Soviet Union). Other plaintiffs  
were various newspapers with familiar names  
like *Pravda* and unfamiliar ones like *Ekho*  
*Planety*. But no individual writers were plain-  
tiffs, which becomes important.

*Kurier* admits copying individual articles  
distributed by Itar-Tass and published by a  
variety of Russian newspapers. No permis-  
sion for the copying was ever obtained. *Itar-  
Tass Russian News Agency v. Russian Kurier*  
*Inc.*, 886 F. Supp. 1120, 1131 (S.D.N.Y.1995).

Under Russian copyright law, authors re-  
tain copyright of the articles they write un-  
less they have surrendered it by contract.  
However, Russian copyright law, Art. 14(2)  
says that in the case of works-made-for-hire  
the employer has the exclusive right to "ex-  
ploit" the works. But then 14(4) excludes  
newspapers from the 14(2) coverage. *Also*  
*excluded are encyclopedias, encyclopedic*  
*dictionaries, collections of scientific works,*  
*reviews, and other periodical publications if*  
*you're curious.*

Art. 11 (1) gives a compiler—like a news-  
paper—copyright in the selection or arrange-  
ment of subject matter if it is a creative one  
(Yes, that's just like *Feist*). The authors may  
exploit the work—the individual articles—  
independently of the compilation unless they  
have contracted otherwise.

The district court granted an injunction  
and damages because the *Kurier* was copy-  
ing not just the articles but the headlines and  
photographs as well. The whole kaboodle was  
being cut out, pasted on a layout sheet and  
sent to the printer by *Kurier* for photographic  
reproduction. The judge saw this as an in-  
fringement of the Russian newspapers' head-  
line, arrangement and type-setting creativity.  
The judge also reasoned that publishers, having  
the economic incentive, would do a better job of  
preventing wholesale copying than authors.

On appeal, the Second Circuit discussed  
at length the issues of conflicts of laws—if  
Russian law on the subject is different from  
US, which applies? In the US works-for-hire  
are owned in their entirety by the compiler.

The **Berne Convention** is cited, but it does  
not settle the question of who owns the copy-  
right of the articles. Berne provides only that  
the law of the country "where protection is  
claimed" (the US in this case): "defines what  
rights are protected, the scope of the protec-  
tion; and the available remedies ..." Jane C.  
Ginsburg, *Ownership of Electronic Rights and*  
*the "Private International Law of Copyright"*,  
22 *Colum.—VLA J.L. & Arts* 165, 167-68  
(1998).

In tackling this problem, the Second Cir-  
cuit made a division between ownership and  
infringement issues.

In any question of property ownership the  
applicable law is that of the state with the most

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significant relationship to the property. In this case it would be Russia where all the work was generated.

In tort cases (like copyright infringement), the governing law is the place of the tort which if you like Latin is *lex loci delicti*. See *Hasbro Bradley Inc. v. Sparkle Toys, Inc.*, 780 F.2d 189, 192-93 (2d Cir. 1985) (applying US law to a work unprotected in its country of origin) which in this case is New York where the copying was done. Also, the infringer was a US corporation.

That sounds easy enough until you learn that US copyright law permits only the owners of an "exclusive right" to bring suit. Only the legal or beneficial owner of property has standing to sue. 17 U.S.C. § 501(b). *Logic: some other turkey—or part-owner—can't bring your lawsuit for you and then throw it away. You might not even know the suit was going on.*

So the appellate court had to use Russian law to determine who owned the copyright in the articles.

The meaning of foreign law is a question of law—i.e. one for the judge to decide. We don't put it to a jury. Fed. R. Civ. P. 44.1; *Bassis v. Universal Line, S.A.*, 436 F.2d 64, 68 (2d Cir. 1970). Dueling expert witnesses are brought in by each side of the litigation. But their demeanor—as in which one looks like he's lying and which is telling the truth—is not an issue. So appellate courts may freely reverse the trial judge based on the intellectual force of the expert opinions, *Curley v. AMR Corp.*, No. 96-9690, 1998 WL 458509, at \*6 (2d Cir. July 22, 1998), which the Second Circuit did.

Russian law gives publishers the right to exploit the compilation and prevent wholesale copying of the newspaper. Authors have the exclusive right to exploit their work independently of the publisher's whole work. So only the author has standing to bring suit for the *Kurier's* article clipping style of copyright infringement.

That left only the district judge's gut feeling that newspapers would do a better job of stopping copyright violations. The Second Circuit noted that Russian law permits organizations for the collective rights of authors when bringing rinky-dink suits by individual authors would be uneconomic. Russian Copyright Law, Art. 44(1). And indeed there exists a news reporters' union.

### US Copyright law—Works-for-hire—Reverse passing off

In contrast to the Russian rule, US Copyright Law vests all rights in the employer of a work-for-hire arrangement.

*Cleary v. News Corporation*, 30 F.3d 1255 (9th Cir.1994).

**Defendant News Corporation** owns HarperCollins which in turn owns Scott, Foresman, the publisher of the famous *Robert's Rules of Order* first published in 1876 by General Henry Robert.

**Plaintiff Dr. James Cleary** was hired in the 1960s to assist in revisions with General Robert's heirs for the 1970 edition. The royalty rate was so small that he was attracted to the work solely by the name credit. The contract stated Cleary was retained by Scott, Foresman on a work-for-hire basis.

Cleary received credit for his work in the 1970 and 1980 editions, but his name was deleted in 1990. Cleary sued under the **Lanham-Trademark Act** which prohibits false designations of origin and false representations in the sale of goods. 15 U.S.C. § 1125(a); *Smith v. Montoro*, 648 F.2d 602,603 (9th Cir.1981).

Copyright law vests all authorship rights in the employer of a work-for-hire. 17 U.S.C. & 201(b). Unless specifically provided otherwise, right to attribution is also relinquished along with the authorship rights. *Vargas v. Esquire, Inc.*, 164 F.2d 522, 524-27 (7th Cir.1947) (artist gave up right of attribution to his drawings in exchange for monthly salary); *Nelson v. Radio Corp. of Am.*, 148 F.Supp. 1 (S.D.Fla.1957) (singer had no right of attribution to songs when directly employed by recording company).

Cleary claimed work-for-hire did not apply because he was not a salaried employee. His contract, however, had an explicit work-for-hire clause. Cleary's testimony that he was orally promised attribution as an inducement to sign the contract was barred by the parol evidence rule.

This rule of evidence holds that the written agreement is the final expression of the parties and outside oral agreements are largely barred. Testimony to oral agreements made

prior to or simultaneous with the writing are inadmissible. Without this rule, written contracts would be extremely feeble and could be contradicted by any and all lies that someone wanted to tell in court. A plausible liar might be far more persuasive than a writing if the jury had difficulty understanding a written contract.

*You can hear how it would go. "Now I don't understand all this fancy lawyer writing. But where I come from, a man's word is his bond. We do business on a handshake. And what we agreed on was ..."*

Despite this, Cleary still claimed attribution under the "reverse passing off or palming off" theory. §43(a) of the Lanham Act forbids mislabeling to mask a creator's contribution. Failure to attribute authorship to a co-author falls under this. *Rosenfeld v. W.B. Saunders*, 728 F.Supp. 236, 243 (S.D.N.Y.) (citing *Lamothe*, 847 F.2d at 1407), *aff'd*, 923 F.2d 845 (2d Cir.1990).

Cleary's theory was that while he had done no work for the 1990 edition, the work was unchanged and he had always received attribution before.

The Ninth Circuit agreed the case law "suggests" that while there is no duty of attribution in Cleary's situation, he is protected against misattribution. See, e.g., *Morita v. Omni Publications Int'l, Ltd.*, 741 F.Supp. 1107, 1114 (S.D.N.Y.1990); see also 2 Paul Coldstein, *Copyright* § 15.24.2.2 (1989). But no cases dealt with a situation where the author had given away rights in a specific work-for-hire clause. And the *Vargas* case was decided before the passage of the Lanham Act.

The purpose of the Lanham Act "is to prevent individuals 'from misleading the public by placing their competitors' work forward as their own.'" *Summit Mach. Tool Mfg. Corp. v. Victor CNC Sys., Inc.*, 7 F.3d 1434, 1438 (9th Cir.1993). The test is "bodily appropriation".

Reverse passing off is express when you  
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# Questions and Answers — Copyright Column

by **Laura N. Gasaway** (Director of the Law Library & Professor of Law, CB # 3385, University of North Carolina, Chapel Hill, NC 27599; phone: 919-962-1049; fax: 919-962-1193) <laura\_gasaway@unc.edu>



**Question:** *When a university faculty member develops a distance learning course, who owns the copyright of such course when it is transmitted over television or the Internet?*

**Answer:** Since this matter has not been litigated, the law and tradition surrounding faculty-produced works generally is relevant. Many experts believe that the institution has a good claim on all copyrighted works produced by the faculty member since they are works for hire. However, the tradition in American higher education has been for the faculty member to own the copyright. Few universities claim any rights to these works even when they are textbooks or bestselling novels and there are substantial royalties involved. Sometimes, when the work is a videotape or software, the institution has asked to be reimbursed for expenses it incurred in the production of the work, but the faculty member "writes" these works as a part of their scholarly contribution. Thus, universities traditionally do not claim copyright.

Courses may present different issues. Both the faculty member and the institution have a good claim on the copyright. The course so developed is definitely within the scope of the faculty member's employment, and yet the tradition mentioned above would indicate that the faculty member should own the work.

Many universities are examining their copyright policies to deal with the ownership issue specifically because of the course development and course materials issue. The ideal solution is for joint ownership since both the school and the faculty member have a valid claim. This should be worked out in advance, however, and not after the fact when a dispute arises. Joint ownership agreements should cover continued use within the university, the faculty member's right to use the course should she move to another university, as well as the rights to market the course on the outside.

**Question:** *What should an independent business research firm do when its clients request monthly digests or synopses of news developments on various topics? This could include monitoring competitor activities that are covered in the news media or tracking issues and trends. The clients then want to distribute these summaries/synopses widely within their companies.*

**Answer:** This question indirectly raises the problem of using author or publisher produced abstracts versus doing one's own work. Published abstracts are separately copyrighted as adaptations of the original work, and the copyright belongs to the author or it may have been transferred to the publisher.

Gathering information, summarizing the factual content and producing this for a client is a fair use as long as the work the research firm does is original and does not copy extensive portions of copyrighted works. To some extent, this may be the difference in an annotation and an abstract. The annotation describes the work rather than extracts the research results. It uses phrases such as: "the author indicates that ...," "there are four pie charts that ...", and the like. Such summaries are fair use as long as they do not supplant the market for the original. Therefore, distributing them within the company should not present problems. The research firm may want to place some notice on the summary to indicate that the research product is not to be used outside the client's business.

**Question:** *Our library is trying to get copyright clearance for a 1925 article to put on reserve for students. The journal is out of print and the publisher has disappeared. Is it safe to put the article on reserve without copyright clearance?*

**Answer:** Most libraries do not seek permission to put copies of works, i.e., reproductions, for use the first semester or term. For subsequent semesters, they do seek permission based on the 1982 ALA Model Policy. Assuming that this is the second term use, the following applies.

The article may still be protected by copyright. The journal publisher copyright holder would have received 28 years of protection, so the work was definitely protected through 1953. In 1953, the publisher would have to have applied for a renewal of copyright. If it did so, the copyright would have been renewed for an additional 28 years — until 1981. By that time the Copyright Act of 1978

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remove a competitor's name or trademark from a product and stick on your own. It is implied when you obliterate the name and sell it unbranded.

You reverse palm off by slightly modifying a product and selling it under your mark. 7 F.3d at 1437 (quoting *Roho, Inc. v. Marquis*, 902 F.2d 356, 359 (5th Cir.1990)).

Put in the context of copyright, "bodily appropriation" is the "copying or unauthorized use of substantially the entire item." *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 205 (9th Cir.1989). Consistent with this, trivial changes—salting a work with a few fresh sentences—would not let you slip past the Lanham Act prohibitions.

The 1990 edition of *Robert's Rules* had fourteen areas of revision. The court found that most of Cleary's chapters had changes—sentences, paragraphs, or pages. Some of


them altered previous rules. Cleary's work was not bodily appropriated.

The Second Circuit applies a "consumer confusion" test. In *Rosenfeld v. W.B. Saunders, A Division of Harcourt Brace Jovanovich*, 728 F.Supp. 236 (S.D.N.Y.), *aff'd*, 923 F.2d 845 (2d Cir.1990), the author of a first edition of a multi-volume treatise on plastic surgery had his name dropped from the third edition.

*Rosenfeld* holds that the harm of reverse palming off is (1) the ultimate purchaser is deceived as to what he is buying, and (2) the originator of the misidentified product is robbed of the advertising value of its name and goodwill.

The editor had in the preface described the author's contribution to the first edition. The court noted that the work was not "mass market." There was no danger of purchasers casually plucking it off a shelf deluded about what they were buying. Consumers of sophisticated reference books are only too aware that treatises with new editions build upon previ-

ous works. Indeed, they are probably familiar with the earlier editions.

*At the risk of really confusing you, we've been talking about reverse passing/palming off. Straight passing off is done expressly by labeling your goods and services with someone else's trademark. It is implied if you use a competitor's advertising material to represent that your product is made by the competitor. Lamothe v. Atlantic Recording Corporation, 847 F.2d 1403 (9th Cir.1988). The Ninth Circuit has California and much of the music industry litigation.* 

*Also on the subject of works-for-hire, see Anne Jennings Cases of Note, ATG, Sept. 1995. She discusses the case of the artist Patrick Nagel versus Playboy and the question of whether a painting is a work-for-hire if Playboy did not tell the artist what it wanted in the picture.*