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Copyright: Assignment of Author's Renewal Interest

COPYRIGHT

ASSIGNMENT OF AUTHOR'S RENEWAL INTEREST

During the original copyright term the author of a popular song assigned his renewal interest in the copyright to the plaintiff who held the original copyright by virtue of an employment contract. The author also gave the plaintiff an irrevocable power of attorney to secure the renewal and assign it to itself. On the first day of the twenty-eighth year of the original term plaintiff applied for and registered the renewal in the author's name and assigned it to itself. The author also applied for and registered the renewal which he later assigned to the defendant music company. This action was brought against the defendant for infringement of plaintiff's renewed copyright. Both the District[1] and the Circuit[2] courts held for the plaintiff and the Supreme Court granted Certiorari. Held, affirmed. The Copyright Act[3] contains no bar to such an assignment. Fred Fisher Co., Inc. v. M. Witmark & Sons, —— U.S. ——, 63 Sup. Ct. 773 (1943).

The renewal of a copyright can be registered only in the name of the author if he is living,[4] and it is settled that an assignment of the original copyright does not, of itself, assign the renewal interest.[5] Nor is a prior assignment of the renewal interest valid if the author dies before the twenty-eighth year when the right accrues.[6] However, the author can bequeath the interest and his executor can secure the renewal even though the author died before the twenty-eighth year if no widow or children survive.[7] But an administrator can not secure the renewal.[8]

Although the question of whether the renewal interest is assignable prior to the twenty-eighth year has not been clearly settled there is dicta both to the effect that such an assignment is invalid,[9] and

1. 38 F. Supp. 72 (S.D.N.Y. 1941).
2. 125 Fed. (2d) 949 (C.C.A. 2d, 1942).
3. 35 Stat. 1075 (1909), 17 U.S.C. §23 (1940) as amended 54 Stat. 51 (1940), 17 U.S.C. §23 (1940).
4. West Publishing Co. v. Edward Thompson Co., 176 Fed. 833 (C.C.A. 2d, 1910).
5. White-Smith Music Pub. Co. v. Goff, 187 Fed. 247 (C.C.A. 1st, 1911); Fox Film Co. v. Knowles, 274 Fed. 731 (E.D.N.Y. 1921) affirmed per curiam 279 Fed. 1018 (C.C.A. 2d, 1922) reversed on other grounds 261 U.S. 326 (1923); Silverman v. Sunrise Pictures Corp., 273 Fed. 909 (C.C.A. 2d, 1921); Shapiro Bernstein & Co. v. Bryan, 123 F. (2d) 697 (C.C.A. 2d, 1941); Southern Music Publishing Co. v. Bibo-Lang, Inc., 10 F. Supp. 975 (S.D. N.Y. 1935).
6. Fox Film Co. v. Knowles, 274 Fed. 731 (E.D.N.Y. 1921).
7. Fox Film Co. v. Knowles, 261 U.S. 326 (1923) overruling Silverman v. Sunrise Pictures Corp., 273 Fed. 909 (C.C.A. 2d, 1921) on this point.
8. White-Smith Music Pub. Co. v. Goff, 187 Fed. 247 (C.C.A. 1st, 1911); Danks v. Gordon, 272 Fed. 821 (C.C.A. 2d, 1921); Silverman v. Sunrise Pictures Corp., 273 Fed. 909 (C.C.A. 2d, 1921).
9. White-Smith Music Co. v. Goff, 187 Fed. 247 (C.C.A. 1st, 1911); West Publishing Co. v. Edward Thompson Co., 176 Fed. 833 (C.C.A. 2d, 1910); Silverman v. Sunrise Pictures Corp., 273 Fed. 909 (C.C.A. 2d, 1921); Fox Film Co. v. Knowles, 274 Fed. 731 (E.D.N.Y. 1921); Shapiro Bernstein & Co. v. Bryan, 123 F. (2d) 697 (C.C.A. 2d, 1941).

that it is valid.[10] Since American copyright is statutory,[11] and the Copyright Act of 1909 does not set forth the legislative intent clearly,[12] the Court resorted to the history of copyright legislation to determine the question presented.[13]

It is submitted that the court erred in its interpretation of the legislative intent.[14] The fragmentary committee reports relied upon by the majority[15] seem to support the view that a premature assignment of a renewal is invalid quite as much as, if not more than, they support the view taken by the court in the present case. In addition, the text authority cited by the court is of doubtful persuasiveness.[16] The better policy seems to be to deny the validity of premature assignment.[17] The ruling in the instant case will result only in the addition of a few words to copyright assignments, and the renewal interest created for the author's benefit will be lost to him.[18]

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10. Tobani v. Carl Fischer Inc., 98 F. (2d) 57 (C.C.A. 2d, 1938) with which compare Shapiro Bernstein & Co. v. Bryan, 123 F. (2d) 697 (C.C.A. 2d, 1941); Rossiter v. Vogel, 46 F. Supp. 749 (S.D.N.Y. 1942) and Selwyn & Co., Inc. v. Veiller, 43 F. Supp. 491 (S.D.N.Y. 1942) both following the opinion of the Circuit Court in the instant case, note 2 supra. Also see 28 Ops. Att'y Gen. 162 (1910) and Note (1939) 10 Air L. Rev. 198.
11. Wheaton v. Peters, 8 Pet. 591 (U.S. 1834).
12. The statute, note 3 supra, provides for an original term of 28 years and a renewal period of 28 years, the latter belonging to the author, the widow, the children, the executor, or the next of kin (in that order), but fails to mention assigns.
13. American Copyright originally was based upon the English Statute of Anne, 1709, 8 Anne, c. 19. This did not mention assigns (for the renewal period) but the renewal was held to be assignable. Carnan v. Bowles, 2 Bro. C.C. 80. In 1790 the first American pronouncement came in the form of a resolution passed by the Continental Congress and calling upon the states to adopt copyright laws. It was suggested that the renewal be assignable. 24 Journals of the Continental Congress, 1774-1789, 326 (1922). The Congress in 1790 enacted a copyright statute which specifically reserved the renewal to the author's assigns. 1 Stat. 124 (1790). In 1831 a new act was passed and reference to assigns was omitted . 4 Stat. 436 (1831). However, it was held that the renewal was assignable under this statute. Pierpont v. Fowle, 19 Fed. 652 (C.C. Mass. 1846); Paige v. Banks, 13 Wall. 608 (U.S. 1871). This was followed by the present act, note 3 supra.
14. See Judge Frank's dissent, 125 F. (2d) 949 (C.C.A. 2d, 1942) approved by Justices Black, Douglas and Murphy dissenting in the instant case, —— U.S. ——, 63 Sup. Ct. 773, 780 (1943).
15. 63 Sup. Ct. 773, 777, 778 (1943).
16. 63 Sup. Ct. 773, 780 (1943). Mr. Justice Frankfurter admits that only eight of the twenty referred to state the position taken in the majority opinion. It may be noted that one of these eight [Howell, "Copyright Law" (1942) 108] cites the Circuit Co. of Appeals decision in the instant case—which decision is being affirmed here.
17. See discussions in Notes (1941) 55 Harv. L. Rev. 139, (1942) 9 U. of Chi. L. Rev. 737, (1941) 15 So. Calif. L. Rev. 108, (1941) 12 Air L. Rev. 108, (1943) 6 U. of Det. L.J. 79.
18. Of course, if the author dies before the 28th year his widow or children, etc. will be entitled to the renewal. Note 6 supra.