EDWARD B. MARKS MUSIC CORPORATION v. JERRY VOGEL MUSIC CO., Inc.

No. 187.

Circuit Court of Appeals, Second Circuit.
Jan. 26, 1944.

1. Copyrights ⇐33

The renewal of a copyright upon a joint work taken in the name of one of the authors is valid, but the renewal is held upon a constructive trust for the other authors. Copyright Act of 1909, §§ 23, 24, 17 U.S.C.A. §§ 23, 24.

2. Copyrights ⇐33, 41

Where the words and music of a song copyrighted as a musical composition were written and composed by different authors, the song was a "joint work" and not a "composite work", even though the authors did not work in concert, and a renewal of copyright by one of the authors was a renewal of the whole which inured to the benefit of both. Copyright Act of 1909, §§ 23, 24, 17 U.S.C.A. §§ 23, 24.

See Words and Phrases, Permanent Edition, for all other definitions of "Composite Work" and "Joint Work".

3. Copyrights ⇐41

"Joint authorship", within meaning of rule that a copyright taken in the name of one of several authors upon a work which is the product of joint authorship inures to the benefit of all, means a joint labor in furtherance of a common design. Copyright Act of 1909, §§ 23, 24, 17 U.S.C.A. §§ 23, 24.

See Words and Phrases, Permanent Edition, for all other definitions of "Joint Authorship".

4. Copyrights ⇐33

Where a copyrighted musical composition is the product of joint authors, a renewal in the name of one inures to the benefit of the others, whether or not the authors work in concert or even knew each other, and it is enough that they mean their contributions to be complementary in the sense that they are embodied in a single work to be performed as such. Copyright Act of 1909, §§ 23, 24, 17 U.S.C.A. §§ 23, 24.

5. Copyrights ⇐33

Where the author of the words of a copyrighted musical composition obtained renewal of copyright in his own name, such renewal inured to the benefit of the composer of the music and his assignee, and author's assignee could not enjoin composer's assignee from exploiting the subject matter of the copyright. Copyright Act of 1909, §§ 23, 24, 17 U.S.C.A. §§ 23, 24.

Appeal from the District Court of the United States for the Southern District of New York.

Action by the Edward B. Marks Music Corporation against Jerry Vogel Music Company, Inc., for infringement of a renewed copyright upon a song. From a judgment dismissing the complaint, 47 F. Supp. 490, plaintiff appeals.

Affirmed.

See, also, D.C., 42 F.Supp. 859; 140 F. 2d 268; 140 F.2d 270.

Arthur E. Garmaize, of New York City, for appellant.

Arthur F. Driscoll, of New York City, for appellee.

Before L. HAND, CHASE, and FRANK, Circuit Judges.

L. HAND, Circuit Judge.

The plaintiff appeals from a judgment, dismissing its complaint after trial in an action for the infringement of the copyright of a song. The infringement is conceded, but the defendant justifies on the ground that it is in equity a joint owner of the copyright. The facts, which are not in dispute, are as follows. In the year 1893, one, Edward B. Marks, composed the words for a song entitled, "December and May," which he took to a publisher of songs, named Harding, who bought it. Harding, without Mark's knowledge, engaged one Loraine, to compose music for the words, which Loraine did; and on November 9, 1893, Harding duly complied with the requirements of the then existing copyright law, published the song, and secured the copyright upon it as a "musical composition." Marks and Loraine never met until years later, and had not therefore worked in conjunction, except that Marks intended the words to be set to music which someone else should compose, and that Loraine understood that he was composing music for those particular words. On November 11, 1920, within the

year before the copyright expired, Marks applied for a renewal of the copyright upon the song as a "musical composition", and procured a certificate of renewal to himself as author; and this renewed copyright is now vested by assignment in the plaintiff. Loraine never applied for renewal, but he assigned all his rights in the song to the defendant on July 20, 1940.

[1] We decided in Maurel v. Smith, 2 Cir., 271 F. 211, that if one of several authors took out the copyright in his own name upon a joint work, the copyright was valid, but the copyright owner held it upon a constructive trust for the other authors. This we extended to the renewal of a copyright in Silverman v. Sunrise Pictures Corporation, 2 Cir., 273 F. 909, 19 A.L.R. 289. Carter v. Bailey, 64 Me. 458, 18 Am.Rep. 273, turned upon the fact that there was no equity in the plaintiff's bill, but assumed that the co-tenant might be liable at law, as he always has been in equity (Minion v. Warner, 238 N.Y. 413, 144 N.E. 665, 41 A.L.R. 1412); it accords with what we have held. Hence, if the song was the joint work of Marks and Loraine, when Marks took out the renewed copyright, it was valid, but he held it upon a constructive trust for Loraine, as does the plaintiff, his assignee. There only remains to be decided whether the song was a joint work, or a "composite", as that phrase is used in §§ 23 and 24 of the Copyright Act, 17 U.S.C.A. §§ 23, 24. The plaintiff says that it was the second, and that therefore Marks could and did separately renew the copyright upon the words.

[2-4] As we have said, the original copyright was of the song as a "musical composition," and the renewal was in the same terms, the work being described as a "song and cho." (song and chorus). So far as appears, Marks therefore never meant to renew the copyright for the words alone, though we will assume that that made no difference, if he was entitled to do so. He was not; the song was not a "composite" work, and it had to be renewed as a whole, or not at all, for it was the indivisible product of "joint authors." So far as we know, the first definition of "joint authorship" is in Levy v. Rutley, L.R. 6 C.P. 523: "a joint laboring in furtherance of a common design" (per Keating, J., p. 529); an agreement "to write a piece, there being an original joint design," (per Montague Smith, J., p. 530). This definition I accepted in Maurel v. Smith, D.C., 220 F. 195, when that case was before me in the district court, and we accept it now. If so, it makes no difference whether the authors work in concert, or even whether they know each other; it is enough that they mean their contributions to be complementary in the sense that they are to be embodied in a single work to be performed as such. That was the case here: Marks wrote the words as words for a song; Loraine composed the music as music for that song. It is true that each knew that his part could be used separately; the words, as a "lyric"; the melody, as music. But that was not their purpose; the words and the music were to be enjoyed and performed together; unlike the parts of a "composite work," each of which is intended to be used separately, and whose only unity is that they are bound together. This comports also with the practical aspects of the situation, as I observed at some length in Maurel v. Smith, supra, 220 F. 195. The popularity of a song turns upon both the words and the music; the share of each in its success cannot be appraised; they interpenetrate each other as much as the notes of the melody, or separate words of the "lyric." The value of the privilege of renewal is measured by the survival of their combined power to please the public taste. To allow the author to prevent the composer, or the composer to prevent the author, from exploiting that power to please, would be to allow him to deprive his fellow of the most valuable part of his contribution; to take away the kernel, and leave him only the husk. It is quite beside the point that, if the first part is composed without any common design, its author retains power to forbid publication of the joint work. Whatever popularity the second author's contribution may have added to the first's, which will survive their divorce, he must be content to release to the first author; whatever popularity his own contribution has gained from the association, he must be content to lose. Not so, when both plan an undivided whole; in that case unless they stipulate otherwise in advance, their separate interests will be as inextricably involved, as are the threads out of which they have woven the seamless fabric of the work.

Harris v. Coca-Cola Co., 5 Cir., 73 F.2d 370, is easily distinguishable on the facts.

The copyright of the first edition, which contained the Church and Moser pictures, expired on November 23, 1908, and was renewed on August 12, of that year; the renewal would have been invalid to extend the copyright of the edition of August 27, 1895. It is true that the court refused to pass on that question, but still the opinion lends no color to the plaintiff's position; for, even though Harris could be said to have composed the script in a joint design with Church and Moser, he clearly could not then have had in mind Frost's illustrations, made fifteen years later. Though he may have been a "joint author" with Church and Moser, he was not with Frost, for there was no change in the text.

[5] For the foregoing reasons we hold that, when Marks took out the renewal of the song, he took it for the benefit of himself and Loraine, and that the legal title which he so acquired he held in trust for Loraine and Loraine's assignee. If so, he could not forbid that assignee from exploiting the subject matter of their right. This appeal does not raise the question whether each might call the other to an accounting, bringing his own profits into hotchpot.

Judgment affirmed.

EDWARD B. MARKS MUSIC CORPORATION v. JERRY VOGEL MUSIC CO., Inc.

No. 183.

Circuit Court of Appeals, Second Circuit.

Jan. 26, 1944.

1. Copyrights ⇐33

Where a song copyrighted as a musical composition was the joint work of two authors, and not a composite work which could be renewed in parts, a renewed copyright taken in name of composer of music alone was valid as to entire song.

2. Copyrights ⇐81

The holder of the legal title to a copyright may sue for infringement without joining others who have an equitable interest in the copyright. Federal Rules of Civil Procedure, rules 17(a), 19(b), 28 U.S.C.A. following section 723c.

3. Copyrights ⇐76

Where copyright for musical composition was renewed by composer of the music alone without joining the author of the words, the assignee of the renewed copyright, although not the only "real party in interest", was entitled to bring action to enjoin infringement and was entitled to recover its share of the damages and defendant's profits without joining other author's successors, since they were not "indispensable parties" and their rights could be reserved in the judgment. Federal Rules of Civil Procedure, rule 17(a), 19(b), 28 U.S.C.A. following section 723c.

See Words and Phrases, Permanent Edition, for all other definitions of "Indispensable Party" and "Real Party in Interest".

4. Copyrights ⇐81

Under federal rule, the objection that action cannot be maintained in absence of indispensable parties, and that plaintiff had failed to establish that such parties could not be served, must be taken by motion or by answer. Federal Rules of Civil Procedure, rules 12(h), 19(b), 28 U.S.C.A. following section 723c.

Appeal from the District Court of the United States for the Southern District of New York.

Action by the Edward B. Marks Music Corporation against Jerry Vogel Music Company, Inc., to enjoin infringement of the renewed copyright in a musical composition and for injunction and damages. From a judgment for plaintiff, 47 F.Supp. 490, defendant appeals.

Judgment modified and affirmed as modified.

See, also, 42 F.Supp. 859.

Arthur F. Driscoll, of New York City, for appellant.

Arthur E. Garmaize, of New York City, for appellee.

Before L. HAND, CHASE, and FRANK, Circuit Judges.

L. HAND, Circuit Judge.

This appeal is from a judgment for the plaintiff in an action to enjoin infringement of the renewed copyright in a song, en-