

SILENT SIMILARITY

JESSICA LITMAN

Abstract

From 1909 to 1930, U.S. courts grappled with claims by authors of prose works claiming that works in a new art form—silent movies—had infringed their copyrights. These cases laid the groundwork for much of modern copyright law, from their broad expansion of the reproduction right, to their puzzled grappling with the question how to compare works in dissimilar media, to their confusion over what sort of evidence should be relevant to show copyrightability, copying and infringement. Some of those cases—in particular, *Nichols v. Universal Pictures*—are canonical today. They are not, however, well-understood. In particular, the problem at the heart of most of these cases—how to imagine a work consisting entirely of pictures as infringing a work made entirely of words—has largely vanished from our consciousness. A better understanding of these early cases casts into clearer light copyright doctrines and practices we take for granted today.

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INTRODUCTION

Many copyright and intellectual property casebooks introduce the concepts of “improper appropriation” and “substantial similarity” by focusing on the opinion of Judge Learned Hand in *Nichols v. Universal Pictures*.¹ The *Nichols* case involved the alleged infringement of a wildly successful stage play by a 1926 silent movie. It required the court to ascertain whether a film embodied almost entirely in images² infringed the copyright in a script written exclusively in words.³ Learned Hand's famous analysis of the similarities in the expression of the two works includes neither any examination of Anne Nichols's dialogue nor any description of the silent film's images. Rather, Judge Hand analyzed the works' expression at a what he might have termed a higher level of abstraction, comparing descriptive summaries of the plot and characters of the play and the movie, derived from but with no mention of the words of the first or the images of the second. Copyright students reading the case

* John F. Nickoll Professor of Law and Professor of Information. David McGowan, Robert Brauneis, Tony Reese, Jennifer Rothman, Rebecca Tushnet, Tony Reese, and David Nimmer made very useful comments on earlier drafts. Mark Rose both commented on an earlier draft and shared his copy of the trial transcript for *Nichols v. Universal Pictures*. Jon Weinberg helped me find some of the missing pieces lurking in the story and significantly improved my expression of them.

1. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930); *See, e.g.*, RALPH BROWN & ROBERT DENICOLA, COPYRIGHT 189 (10th ed. 2009); JULIE E. COHEN, LYDIA PALLAS LOREN, RUTH L. OKEDIJI, & MAUREEN O'ROURKE, COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 303–06 (3d ed. 2010); PAUL GOLDSTEIN & R. ANTHONY REESE, COPYRIGHT, PATENT, TRADEMARKS AND RELATED STATE DOCTRINES: CASES AND MATERIALS ON THE LAW OF INTELLECTUAL PROPERTY 897–902 (7th ed. 2012); ROBERT A GORMAN, JANE C GINSBURG, & R. ANTHONY REESE, COPYRIGHT: CASES AND MATERIALS 583–88 (8th ed. 2011); CRAIG JOYCE, MARSHALL LEAFFER, PETER JASZI, TYLER OCHOA, & MICHAEL CARROLL, COPYRIGHT LAW 658–65 (9th ed. 2013); ROBERT P. MERGES, PETER MENELL, & MARK A. LEMLEY, INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 527–34 (5th ed. 2010); MELVILLE B. NIMMER, PAUL MARCUS, DAVID A MYERS, & DAVID NIMMER, CASES AND MATERIALS ON COPYRIGHT 464–70 (8th ed. 2012); ALFRED YEN & JOSPEH LIU, COPYRIGHT LAW: ESSENTIAL CASES AND MATERIALS 62 (2d ed. 2011). *See also* ROBERT BRAUNEIS & ROGER E. SCHECHTER, COPYRIGHT: A CONTEMPORARY APPROACH 125–33 (2012) (using case to illustrate “Abstraction and ‘Ideas’”).

2. The film had title cards, but the plaintiff did not allege that the words on the cards derived from her dialogue.

3. Federal copyright law then, as now, offered no protection to performances that had not been fixed in tangible form.

may be unaware (and copyright teachers may have forgotten) that *The Cohens and Kellys* was a silent movie.⁴

When Congress enacted the 1909 Copyright Act, the nascent American film industry had only just begun to clash with that era's legacy entertainment businesses over copyright law, and Congress addressed the treatment of film in copyright without seeking the advice of filmmakers or their lawyers.⁵ A few years later, filmmakers sent lawyers to Congress to seek copyright amendments, but those amendments tinkered around the edges of the 1909 Act rather than rethinking its fundamental strategies.⁶ From 1909, then, until the 1976 Copyright Act took effect on January 1, 1978, courts faced the problem of interpreting language written with little or no attention to motion pictures to infringement cases in which the scope and nature of copyright in the context of motion pictures were key questions. In the early decades of that effort, courts struggled to fit motion pictures into a template designed for books, plays, paintings, maps, charts and songs.

As many scholars have observed, this is a common problem with copyright law.⁷ Even when Congress tries to craft the language of copyright statutes to apply to tomorrow's technology, its ability to imagine what might happen in the future is limited by what members of Congress can see happening at the time. Courts, inevitably, must apply the law's language to circumstances Congress didn't envision. In the early 1930s, the Supreme Court addressed the application of the 1909 Act's public performance right to the new technology of radio broadcasting.⁸ In subsequent years, the court revisited that decision repeatedly to sort out whether and to what extent the principles it discerned applied to different

4. Most copyright casebooks don't mention this detail. Brauneis and Schechter is the exception. See Brauneis & Schechter, *supra* note 1, at 127 (“FYI: Although you wouldn't know it from Judge Hand's description, “The Cohens and the Kelleys” was a silent movie, and much of the story line was told through purely visual action on screen”).

5. Pub. L. 60-349, 35 Stat. 1075, H.R. 28192, enacted March 4, 1909 [“1909 Act”]. See Jessica Litman, Copyright and Technological Change, 68 OR. L. Rev. 275, 284 & n43 (1989).

6. See Townsend Copyright Amendment: Complete File of Arguments on H.R. 15263 and H.R. 20596 Before the House Comm. On Patents Commencing January 24, 1912, 62d Congress 19-20, 99 (1912).

7. See, e.g., Peter DiCola and Matthew Sag, An Information-Gathering Approach to Copyright Policy, 34 Cardozo L. Rev. 173, 180 (2012); Jane C. Ginsburg, Copyright and Control Over New Technologies of Dissemination, 101 Colum. L. Rev. 1613, 1619-26 (2001); Trotter Hardy, The Copyrightability of New Works of Authorship: “xml Schemas” As An Example, 38 Hous. L. Rev. 855, 858-60 (2001); Deborah Tussey, Technology Matters: The Courts, Media Neutrality and New Technologies, 12 J. Intell. Prop. L. 427, 427-30 (2005).

8. See *Buck v. Jewell-La Salle Realty Co.*, 283 U.S. 191, 196-200 (1931).

uses of broadcast media.⁹ In the 2013 term, the Supreme Court faced the problem of understanding what the current public performance right means in connection with personal transmissions of television programming, which required it to apply statutory language written before the Internet to behavior that is only possible using networked digital technology.¹⁰ Courts have split on whether the 1976 Act right “to distribute copies to the public by sale or other transfer of ownership or by rental, lease or lending,” should be construed to extend beyond the transfer of tangible copies to making files available for public download.¹¹ The Copyright Office has launched a contentious study seeking to sort the matter out.¹²

Similar confusions arise when Congress expressly revises the law to adjust it to a new era. Every time Congress has extended copyright protection to new classes of works, or expanded copyright rights to encompass new sorts of infringement, courts have struggled to decide what expressive elements copyright protected and what behaviors constituted infringement. When Congress granted the owners of copyright in dramatic works a new exclusive right to “act, perform, or represent” the work “on any stage or public place” in 1856,¹³ courts had difficulties interpreting the new right.¹⁴ More than three decades following the extension of copyright protection to computer programs, courts are still struggling to understand what parts of a computer program are protected by copyright and what similarities would infringe them.¹⁵ In 1990, following the U.S. accession to the Berne Convention, Congress added architectural works to the list of subject matter entitled to copyright.¹⁶ Courts have not yet resolved the nature or scope of copyright in building designs.¹⁷ The same year,

9. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 157–60 (1975); *Teleprompter Corp. v. Columbia Broad. Sys., Inc.*, 415 U.S. 394, 405–09 (1974); *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390, 398–401 (1968).

10. *Am. Broad. Companies, Inc. v. Aereo, Inc.*, 134 S. Ct. 2498, 2507–10 (2014).

11. 17 U.S.C.A. § 106(3). Compare, *e.g.*, *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153, 166–74 (D. Mass. 2008) with, *e.g.*, *Atl. Recording Corp. v. Howell*, 554 F. Supp. 2d 976, 981–86 (D. Ariz. 2008).

12. See U.S. Copyright Office, *Making Available Study*, http://www.copyright.gov/docs/making_available/ (last visited Apr. 10, 2015).

13. Act of Aug. 18, 1856, 11 Stat. 138, 139.

14. See, *e.g.*, *Daly v. Palmer*, 6 F. Cas. 1132, 1135–38 (C.C.S.D.N.Y. 1868); *Boucicault v. Fox*, 3 F. Cas. 977, 980–82 (C.C.S.D.N.Y. 1862); *Keene v. Wheatly*, 14 F. Cas. 180, 185–87 (C.C.E.D. Pa. 1861); See generally Jessica Litman, *The Invention of Common Law Play Right*, 25 BERKELEY TECH. L.J. 1381, 1403–10, 1425 (2010).

15. See, *e.g.*, *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1364–72 (Fed. Cir. 2014); *Softel, Inc. v. Dragon Med. & Scientific Commc'ns, Inc.*, 118 F.3d 955, 963–67 (2d Cir. 1997); *Lot. Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 813–19 (1st Cir. 1995) *aff'd*, 516 U.S. 233 (1996).

16. Architectural Works Copyright Protection Act, Pub. L. No 101-650, 104 Stat. 5089, 5133 (1990), codified at 17 U.S.C.A. §§ 101, 102, 120.

17. See, *e.g.*, *Leicester v. Warner Bros.*, 232 F.3d 1212, 1217–20 (9th Cir. 2000); *Zalewski v. T.P. Builders, Inc.*, 875 F. Supp. 2d 135, 153–54 (N.D.N.Y. 2012) *aff'd sub nom. Zalewski v. Cicero Builder*

Congress enacted narrow rights of integrity for works of visual art.¹⁸ More than 20 years into the VARA experiment, the Visual Artists Rights Act cases still display a remarkable amount of floundering.¹⁹

The story of silent movie copyright infringement cases is, in that sense, a very familiar story. What makes it especially interesting is that the doctrines that evolved in the silent film infringement cases as particular responses to idiosyncratic issues later became iconic and mainstream examples of copyright analysis.²⁰

My account proceeds in chronological order. In Part I, I summarize the copyright law prior to the enactment of the 1909 Copyright Act, and discuss the application of that law to a case alleging infringement of a novel and play by the 1907 motion picture *Ben Hur*. I then turn to the 1909 Act's provisions and explore some of the silent movie cases filed in the teens. Part II describes some of the cases decided in the 1920s. Part III explores the *Nichols* case in detail. Part IV looks at some of the silent film cases decided after *Nichols*, focusing particularly on the last of the silent film infringement cases, involving Harold Lloyd's famous movie, *The Freshman*.²¹

One lesson to draw from the story is that what we think of as bedrock, essential principles of copyright may in fact have been deeply contingent, the product of personality, bad lawyering, or idiosyncratic facts. Another insight is that legal actors' expectations and assumptions limit their capacity to imagine a world beyond their experience. We assume that remote situations are more similar to the ones we know than they really are; we see only what we know to look for. Congress, when it looks to the future; courts, when they apply old statutory language to new fact patterns; and scholars, when they read past statutes and judicial opinions all fall into this trap. Copyright professors who have been teaching or citing the *Nichols* case for years may be surprised to learn or be reminded that *The*

Dev., Inc., 754 F.3d 95 (2d Cir. 2014); *Shine v. Childs*, 382 F. Supp. 2d 602, 609–11, 615–16 (S.D.N.Y. 2005).

18. Visual Artists Rights Act, Title VI of the Judicial Improvements Act of 1990, Pub. L. No. 101–650, 104 Stat. 5089P (1990), codified at 17 U.S.C.A. § 106A.

19. See, e.g., *Kelley v. Chicago Park Dist.*, 635 F.3d 290, 300–06 (7th Cir. 2011); *Massachusetts Museum of Contemporary Art Found., Inc. v. Buchel*, 593 F.3d 38, 50–63 (1st Cir. 2010).

20. Learned Hand's analysis of infringing similarity in *Nichols*, for example, has been followed by courts deciding infringement of novels, See *Allen v. Scholastic, Inc.*, 739 F. Supp. 2d 642, 661 (S.D.N.Y. 2011), cookbooks, See *Lapine v. Seinfeld*, 92 U.S.P.Q. 2d (BNA) 1428 (S.D.N.Y. 2009), *aff'd*, 375 Fed. Appx. 81 (2d Cir. 2010), computer software, See *Autoskill, Inc. v. Nat'l Educ. Support Sys., Inc.*, 994 F.2d 1476, 1491–92 (10th Cir. 1993); *Computer Associates. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706–07 (2d Cir. 1992), and Halloween decorations, See *Winfield Collection, Ltd. v. Gemmy Indus., Corp.*, 147 F. App'x 547, 553–54 (6th Cir. 2005).

21. THE FRESHMAN (Harold Lloyd Corp., 1925).

Cohens and Kellys was a silent movie because they had assumed without much reflection that it was a movie of the sort they found familiar. The world of 1930, though, was not the one we know, and the lessons the court found in that case are not the ones we see today.

I. BACKGROUND: THE EXCLUSIVE RIGHTS TO PRINT, COPY, PERFORM AND EXHIBIT

At the beginning of the 20th century, the copyright reproduction right secured the right to manufacture printed copies, and the scope of the dramatization, translation, and public performance rights were unclear.²² Courts had not yet resolved what evidence might be relevant to show that a work was not copyrightable, and were just beginning to develop doctrine on how to compare two works to ascertain whether one infringed the other.²³ There had been relatively little litigation charging that a work of authorship in one medium plagiarized a work in a different medium. In the first third of the century, courts and lawyers articulated much of the doctrine that 21st century scholars see as intrinsic to copyright and firmly cemented in copyright's core.

Significant chunks of that body of law developed in cases charging that silent movies had been plagiarized from copyrighted stories, novels or

22 . See generally E.B. Brylawski & Abraham Goldman, Legislative History of the 1909 Act (1976); See, e.g., *Hein v. Harris*, 183 F. 107, 108 (2d Cir. 1910); *Bloom & Hamlin v. Nixon*, 125 F. 977, 978-79 (C.C.E.D. Pa. 1903).

23 . Cases invoking the doctrine of substantial similarity showed up as the printing right expanded to cover more than verbatim copies. See *Springer Lithographing Co. v. Falk*, 59 F. 707, 712 (2d Cir. 1894) (suit by photographer against lithographers for copying the details of her photograph in a lithograph: “the case was mainly tried on the question whether or not there was a substantial similarity”). By the early 20th century, courts used the phrase, if not often, in connection with comparing two works where the alleged reproduction was not verbatim. See, e.g., *Chautauqua Sch. of Nursing v. Nat'l Sch. of Nursing*, 211 F. 1014, 1015 (W.D.N.Y. 1914) (finding instruction sheet on administering medicines to infringe copyrighted lecture on administering medicines), rev'd, 238 F. 151 (2d Cir. 1916). In *Dam v. Kirke La Shelle Co.*, 166 F. 589, 591–92 (C.C.S.D.N.Y. 1908), aff'd 175 F. 902 (2d Cir. 1910), the author of a story sued the producer of a stage play claiming that the play infringed his dramatization right under section 4952 of the Revised Statutes. The trial court held that the play would infringe the dramatization right in story if there was a substantial similarity between the story and the play. *Id.* What made a play substantially similar to a story?

“[I]f the copyrighted literary composition, or the theme or subject thereof, was dramatized by another without the consent of the author, and reproduced by dialogue spoken by play actors, and scenes and incidents are introduced, coupled with stage situations, by which the kernel of the literary composition is emphasized, then it may be fairly supposed that the playwright, in giving a public performance of the drama, endeavored to reap a profit or gain out of another's industry, against which a court of equity has power to grant relief.”

Id. Nineteenth Century copyright treatises explored the concept of improper appropriation, but only infrequently under that name. Compare DAVID CHAMIER, LAW RELATING TO LITERARY COPYRIGHT AND THE AUTHORSHIP AND PUBLICATION OF BOOKS (1895), with GEORGE TICKNOR CURTIS, TREATISE ON THE LAW OF COPYRIGHT 236–40, 253–65 (1847) and EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS 383–86, 407–08 (1879).

plays. From the first reported silent movie case²⁴ (filed early in the 20th Century) to the last (decided in the 1930s),²⁵ courts struggled to evaluate claims that works consisting solely of pictures infringed the copyrights in works consisting only of words. Most of these cases involved courts sitting in equity as finders of fact, looking at a remarkable assortment of evidence (much of which would have been deemed irrelevant by 21st century courts) introduced to prove or disprove copyrightability, copying-in-fact, and infringing similarity. Early in that period, courts struggled to determine whether making or showing silent movies infringed the contemporary precursors of the reproduction, adaptation, distribution, or public performance right. The 1909 Act had adopted the strategy of specifying copyright rights for particular classes of works.²⁶ Both the adaptation right under section 1(b) and the public performance right under section 1(d) were particularized by class of work²⁷. The specification turned out to be too narrow to accommodate new technologies and new uses.²⁸ Over the course of three decades, courts expanded the substantive scope of the reproduction right, defined in the 1909 Act as the exclusive right to “print, reprint, publish, copy, and vend the copyrighted work,” beyond Congress's original understanding to encompass adaptations and transformations, which later

24. The earliest reported cases involved claims that one film infringed the copyright in an earlier film. *Edison v. Lubin*, 119 F. 993, 993 (C.C.E.D. Pa 1903), *rev'd* 122 F. 240 (3d Cir. 1904), raised the then-novel question whether a motion picture could be protected as a photograph under the copyright statute. *Am. Mutoscope & Biograph Co. v. Edison Mfg. Co.*, 137 F. 262 (C.C.D.N.J. 1905) denied a preliminary injunction to the owner of a film copyright seeking to enjoin an independently filmed movie that showed similar scenes. The earliest case I found charging that a motion picture infringed the copyright in a book or dramatic composition is *Harper & Bros. v. Kalem Co.*, 169 F. 61 (2d Cir. 1909) *aff'd*, 222 U.S. 55 (1911), filed in 1908. *See infra* section I.B. For an immensely readable account of early motion picture copyright cases, *See* PETER DECHARNEY, *HOLLYWOODS COPYRIGHT WARS: FROM EDISON TO THE INTERNET*, 11–107 (2012).

25. The latest reported decision I have found addressing copyright infringement by a silent movie is *Harold Lloyd v. Witwer*, 65 F.2d 1 (9th Cir. 1933), *rev'g* 46 F.2d 792 (S.D. Cal. 1930), cert. dismissed, 296 U.S. 669 (1934), alleging infringement by Harold Lloyd's 1925 movie *The Freshman*.

26. *See* 1909 Act §§ 1(b), 1(d); *See generally* Jessica Litman, *Copyright Legislation and Technological Change*, 68 OR. L. REV. 275, 280–81, 301–05 (1989).

27. Section 1(b) gave owners of copyrights in non-dramatic works the exclusive right to dramatize them, owners of copyrights in dramatic works the exclusive right to convert the works into novels, owners of copyrights in musical works the exclusive right to arrange or adapt them, and owners Of copyrights in designs the exclusive right to complete, execute, and finish them. Section 1(d) gave the owners of copyrights in dramatic works exclusive rights to perform the works publicly, to transcribe the works, and to exhibit them. 1909 Act §§ 1(b), 1(d).

28. This problem was not unique to copyright owners who found their works appropriated by the new motion picture industry. Authors of books, poems and stories found the absence of any right to license public performances inconvenient when radio broadcasting became popular. *See, e.g.*, *Kreymborg v. Durante*, 21 U.S.P.Q. (BNA) 557 (S.D.N.Y. 1934); 75 Cong. Rec. 11062 (1932) (remarks of Rep. Sirovich). Poet Austin Corcoran found his statutory translation right too narrow to allow him to recover when a stranger set the words of his poem, “Plain Bull,” to music, recorded the resulting song, and sold the records to the public. *See Corcoran v. Montgomery Ward*, 121 F. 2d 572, 573–74 (9th Cir. 1941).

courts would call “substantially similar copies.”²⁹ This expansion of the reproduction right appears to have been the courts' response to the narrow wording of the adaptation and public performance rights.

A. *Pre-1909 Act law*

From 1873 until 1909, section 4952 of the Revised Statutes granted authors of books, stories, and dramatic compositions, and their assigns, the “sole liberty of printing, reprinting, publishing completing, copying, executing, finishing, and vending” their works.³⁰ As construed by the courts, the right to print was limited to the making of “a written or printed record of the work in intelligible notation,” and did not include control over other imitations of the author's intellectual conception.³¹ In addition to the printing right, the statute gave authors of dramatic compositions the sole liberty of publicly performing or representing them, and granted authors of books and stories exclusive rights to “dramatize and translate their works.”³² The earliest silent film copyright cases arose under section 4952.

B. *Kalem v. Harper Brothers*

Lew Wallace's *Ben Hur* (1880) and Klaw & Erlanger's *Ben Hur* (1899)
v. Kalem Company's *Ben Hur* (1907)

In 1880, Harper Brothers published Lew Wallace's novel, *Ben Hur: A Tale of the Christ*, which became an immediate best seller, replacing the

29. See generally Julie Cohen, Lydia Loren, Ruth Okediji & Maureen O'Rourke, Copyright in a Global Information Economy 302–37 (3d ed. 2010); Robert Gorman, Jane Ginsburg, & R. Anthony Reese, Copyright 572–625 (8th ed. 2011); Alfred Yen & Joseph Liu, Copyright Law: Essential Cases and Materials 240–74 (2d Ed. 2011).

30. As amended in 1891, Rev. Stat. § 4952 provided:

The author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and, in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others; and authors or their assigns shall have exclusive right to dramatize and translate any of their works for which copyright shall have been obtained under the laws of the United States.

31. White-Smith Music Pub. Co. v. Apollo Co., 209 U.S. 1, 17–18 (1908).

32. Rev Stat § 4952. As initially enacted, section 4952 entitled authors “to reserve the right to dramatize ... their own works.” See, e.g., Boucicault v. Hart, 3 F. Cas. 983, 984–85 (C.C.S.D.N.Y. 1875). Congress first extended a public performance right to dramatic compositions in 1856. See generally Jessica Litman, The Invention of Common Law Play Right, 25 Berkeley Tech. L.J. 1381 (2010).

earlier *Uncle Tom's Cabin* at the top of the list of best selling American fiction. Wallace was reluctant to license the dramatic rights to his novel, because he believed that it would be sacrilegious for a human actor to portray Jesus Christ. Theatrical producer Abe Erlanger persuaded Wallace to license the dramatic rights in the book to Erlanger and his partner Marc Klaw by promising to use a shaft of light, rather than an actor, to represent Jesus.³³ Playwright William Young wrote the dramatization, and Ernest Albert designed an elaborate \$100,000 set with treadmills and a cyclorama to simulate a chariot race, and electric lighting to produce the shaft of light and other divine effects.³⁴ The play was hugely successful. Klaw & Erlanger revived it several times on Broadway and produced road tours throughout the United States and in London, Canada, Australia, and the Netherlands.³⁵

In 1907, the recently formed Kalem Company Film Studio asked Gene Gautier, an actress and screenwriter who had starred in several short silent films and had written the screenplays for *Tom Sawyer* and *Why Girls Leave Home*, to read the Wallace novel and write a scenario suitable for filming.³⁶ Even though the Kalem Company was located in New York City, and Klaw and Erlanger had revived the play on Broadway both in 1903 and in 1907, the Kalem Company insisted that it hadn't known that the novel had been adapted for the stage.³⁷ Kalem used Gautier's scenario to produce a 15-minute silent film culminating in a race featuring live horses dragging chariots,³⁸ and sold hundreds of copies of the film to movie theaters. Klaw and Erlanger sent Kalem a cease and desist letter. Kalem responded that its picture was based on Wallace's book, not the play, and that it was completely unlike the play. Kalem suggested, however, that its film would have great advertising value for Klaw & Erlanger's dramatic production.³⁹ Klaw and Erlanger got in touch with Harper Brothers, and, together with

33. Experiences with Ben Hur, NY Times, Jan. 31, 1926, at 171. Klaw & Erlanger were principals in the notorious syndicate that controlled the booking of touring theatrical productions throughout the United States in the early 20th century. See Alfred L. Bernheim, *The Business of the Theatre* 46–63 (1964).

34. Experiences with Ben Hur, *supra* note 33; Internet Broadway Database, Ben Hur (1899), <http://www.ibdb.com/production.php?id=5293> (last visited Apr. 10, 2015).

35. Experiences with Ben Hur, *supra* note 33.

36. Internet Movie Database, Gene Gauntier, <http://www.imdb.com/name/nm0310155/> (last visited Apr. 10, 2015); Stipulation of Facts, *Harper & Brothers v. Kalem Co.*, No. 2–160 (SDNY Filed Nov. 2, 1908), in Transcript of Record, *Kalem v. Harper Brothers*, 222 U.S. 55 (1911), at 20. See Gene Gautier, *Blazing the Trail*, 55 *Womens Home Companion* #10, October 1928 at 7, 184, 186. For some reason, Justice Holmes referred to Ms. Gauntier as “a man.” *Kalem Co. v. Harper Bros.*, 222 U.S. 55, 60 (1911).

37. See Transcript of Record, *Kalem v. Harper Bros.*, *supra* note 36, at 20.

38. *BEN HUR* (Kalem Company 1907). The film depicts four incidents drawn from the book in sixteen short scenes. To modern eyes, it has no discernible plot or characterization.

39. Stipulation of Facts, *supra* note 36.

Wallace's estate, they filed a complaint in equity under section 4952 of the Revised Statutes. The district court enjoined Kalem from “producing, playing, exhibiting, printing, publishing, copying, translating, advertising, or causing or licensing to be produced” the book, the play, or any of its “characters, scenes, incidents, plot or story.”⁴⁰ Kalem appealed.

The Court of Appeals for the Second Circuit agreed with Kalem that *making* the film did not violate plaintiff's rights under section 4952:

The series of photographs taken by the defendant constitutes a single picture, capable of copyright as such...and as pictures only represent the artist's idea of what the author has expressed in words (Parton v. Prang., 3 Cliff. 537), they do not infringe a copyrighted book or drama, and should not as a photograph be enjoined. This distinction between infringement of a copyright of a book and of the performing rights is like the distinction in respect to an infringement between perforated music rolls and sheet music discussed in the case of White Smith Co. v. Apollo Co....⁴¹

The court, however, agreed with plaintiffs that *exhibiting* the film violated the publisher's dramatization right and the producers' public performance right:

When a film is put on an exhibiting machine, which reproduces the action of the actors and animals, we think it does become a dramatization, and infringes the exclusive right of the owner of the copyrighted book to dramatize it, as well as his right as owner of the copyrighted drama, and of Klaw & Erlanger's right as owners of the performing right publicly to produce it. In other words, the artist's idea of describing by action the story the author has written in words is a dramatization.⁴²

40. Harper & Bros v. Kalem Co., No. 2–160 (S.D.N.Y. Nov. 2, 1908), reprinted in Transcript of Record, Kalem v. Harper Brothers, *supra* note 36, at 23–24.

41. Harper & Bros. v. Kalem Co., 169 F. at 63.

Parton v. Prang, 18 F. Cas. 1273, 3 Cliff. 537 (CCD Mass 1872), was an unsuccessful suit claiming that an unauthorized chromolith infringed the copyright in a painting; the court held that the artist had conveyed the copyright in the painting when he sold the painting itself. In the course of a long disquisition on the differences under copyright law between pictures and manuscripts, the court had this to say:

Whatever conclusion the reader of the manuscript may form, it is but an ideal picture, made in his own mind from the written description of the object, and necessarily calls into exercise all the creative faculties of the mind. No such operation of the mind is involved, where the picture or painting of the object is presented to the observer, as the object itself in a secondary form, "drawn in colors," is presented externally to the sense of sight. In the latter case, no ideal of the mind is necessary, as the thing itself is presented physically to the natural eye. Briefly stated, the picture is the thing itself, but the manuscript is only the description of it in language, and leaves the mind of the reader to make the picture, or, in other words, the picture presents, at a glance, all the characteristics of the object exactly as it exists, but the manuscript only enumerates and describes those characteristics one by one, imposing upon the mind of the reader the labor of aggregating the same into a whole and presenting to his perceptions an ideal of the described object.

Id. at 1276.

42. Harper & Bros. v. Kalem Co., 169 F. at 63.

Because Kalem did not itself exhibit the movie, it was not liable as a direct infringer. Since it produced the film, advertised it, and sold it to movie theaters so that they could exhibit it publicly for profit, the court held that Kalem was liable for contributory infringement.⁴³ Kalem appealed to the Supreme Court.

Before the Supreme Court, none of the parties questioned the 2d Circuit's conclusion that the film was not an infringing copy of the book. Rather, their arguments focused on the question whether showing the film violated the dramatization and public performance rights of the publisher and producers. Justice Holmes, writing for a unanimous court, concluded: "We are of the opinion that Ben Hur was dramatized by what was done."⁴⁴ Since Kalem "not only expected but invoked by advertisement the use of its films for dramatic reproduction of the story," it was liable as a contributory infringer.⁴⁵

From a 21st Century vantage point, this analysis looks unnecessarily oblique. We have grown used to treating an unlicensed film adaptation as an infringing reproduction.⁴⁶ In the years surrounding the enactment of the 1909 Act, though, the reproduction right was construed more narrowly. The sole liberty under section 4952 of the Revised Statutes of "printing, reprinting, publishing, completing, copying, executing, finishing and vending" and the exclusive rights under 1(a) of the 1909 Act to "print, reprint, publish, copy, and vend" were rights to manufacture and sell copies; "copies" meant material objects produced for sale and stamped with copyright notices.

The Kalem Company did not dispute that it used the Wallace novel as the basis for its film, nor that it advertised the movie as "Adapted from General Lew Wallace's Famous Book Ben Hur;"⁴⁷ it sought instead to persuade the courts that motion pictures, like piano rolls, could not infringe the copyrights of any books or stories that inspired them, because they were not copies.⁴⁸ None of the courts deciding the *Kalem* case, therefore, took the opportunity to explore the question how to ascertain infringing similarity between a work consisting entirely of words and another work consisting only of pictures.

43. *Id.* at 64.

44. *Kalem Co. v. Harper Bros.* 222 U.S. at 61.

45. *Id.* at 63.

46. *See, e.g., Randolph v. Dimension Films*, 634 F. Supp. 2d 79, 790 (S.D. Tex. 2009), *aff'd*, 381 Fed. Appx. 449 (5th Cir. 2010).

47. Exhibit F: Advertisement postcard, *Kalem Record*, *supra* note 36, at 20.

48. Brief for Appellant at 11-18, *Kalem v. Harper Brothers* (No. 184).

C. The 1909 Act: section 1(b) and 1(d)

Jack London's *Just Meat* (1906) v. D.W. Griffith's *For Love of Gold* (1908)

Robert Stoddard's *The Woodsman* (1911) v. William Russell's *The Strength of Donald MacKenzie* (1916)

While Kalem's appeal was pending, Congress enacted the 1909 Copyright Act, a comprehensive revision of the copyright law. As enacted, Section 1(a) of the 1909 Act gave copyright owners the “exclusive right...to print, reprint, publish, copy and vend the copyrighted work.” Section 1(b) gave the owners of copyright in nondramatic works the exclusive right to dramatize them, and gave owners of copyright in dramatic works the exclusive right to convert them into novels or other nondramatic works. Section 1(d) gave the owners of copyright in dramatic works the exclusive right “to perform or represent the copyrighted work publicly,” and the exclusive right “to make or to procure the making of any transcription or record thereof by or from which, in whole or in part, it may in any manner or by any method be exhibited, performed, represented, produced, or reproduced; and to exhibit, perform, represent, produce, or reproduce it in any manner or by any method whatsoever...”⁴⁹ This last exclusive right,

49. The text of section 1 of the 1909 Act provided:

That any person entitled thereto, upon complying with the provisions of this Act, shall have the exclusive right:

- (a) To print, reprint, publish, copy, and vend the copyrighted work;
- (b) To translate the copyrighted work into other languages or dialects, or make any other version thereof, if it be a literary work; to dramatize it if it be a nondramatic work; to convert it into a novel or other nondramatic work if it be a drama; to arrange or adapt it if it be a musical work; to complete, execute, and finish it if it be a model or design for a work of art;
- (c) To deliver or authorize the delivery of the copyrighted work in public for profit if it be a lecture, sermon, address, or similar production;
- (d) To perform or represent the copyrighted work publicly if it be a drama or, if it be a dramatic work and not reproduced in copies for sale, to vend any manuscript or any dramatic record whatsoever thereof; to make or to procure the making of any transcription or record thereof by or from which, in whole or in part, it may in any manner or by any method be exhibited, performed, represented, produced, or reproduced; and to exhibit, perform, represent, produce, or reproduce it in any manner or by any method whatsoever;
- (e) To perform the copyrighted work publicly for profit if it be a musical composition and for the purpose of public performance for profit; and for the purposes set forth in subsection (a) hereof, to make any arrangement or setting of it or of the melody of it in any system of notation or any form of record in which the thought of an author may be recorded and from which it may be read or reproduced: *Provided*, That the provisions of this Act, so far as they secure copyright controlling the parts of instruments serving to reproduce mechanically the musical work, shall include only compositions published and copyrighted after this Act goes into effect, and shall not include the works of a foreign author or composer unless the foreign state or nation of which such author or composer is a citizen or subject grants, either by treaty, convention, agreement, or law, to citizens of the United States similar rights: *And provided further, and as a condition of extending the copyright control to such mechanical reproductions*, That whenever the owner of a musical copyright has used or permitted or knowingly acquiesced in the use of the copyrighted work upon the parts of instruments serving to

which I will refer to as the exhibition right, was added to section 1(d) of the 1909 Act shortly before its enactment, in the wake of the court of appeals decision in *Kalem*. Its drafters, Representative Frank Dunklee Currier of New Hampshire and Ligon Johnson, lobbyist for the National Association of Theatrical Producing Managers, believed that the language of this provision would be capacious enough to protect dramatists from infringement by the nascent film industry.⁵⁰ The new exhibition right, however, did not extend to the owners of copyrights in non-dramatic works.⁵¹ That left the owners of copyrights in stories and novels to resort

reproduce mechanically the musical work, any other person may make similar use of the copyrighted work upon the payment to the copyright proprietor of a royalty of two cents on each such part manufactured, to be paid by the manufacturer thereof; and the copyright proprietor may require, and if so the manufacturer shall furnish, a report under oath on the twentieth day of each month on the number of parts of instruments manufactured during the previous month serving to reproduce mechanically said musical work, and royalties shall be due on the parts manufactured during any month upon the twentieth of the next succeeding month. The payment of the royalty provided for by this section shall free the articles or devices for which such royalty has been paid from further contribution to the copyright except in case of public performance for profit: *And provided further*, That it shall be the duty of the copyright owner, if he uses the musical composition himself for the manufacture of parts of instruments serving to reproduce mechanically the musical work, or licenses others to do so, to file notice thereof, accompanied by a recording fee, in the copyright office, and any failure to file such notice shall be a complete defense to any suit, action, or proceeding for any infringement of such copyright.

In case of the failure of such manufacturer to pay to the copyright proprietor within thirty days after demand in writing the full sum of royalties due at said rate at the date of such demand the court may award taxable costs to the plaintiff and a reasonable counsel fee, and the court may, in its discretion, enter judgment therein for any sum in addition over the amount found to be due as royalty in accordance with the terms of this Act, not exceeding three times such amount.

The reproduction or rendition of a musical composition by or upon coin-operated machines shall not be deemed a public performance for profit unless a fee is charged for admission to the place where such reproduction or rendition occurs.

50. Townsend Copyright Amendment: Complete File of Arguments on H.R. 15263 and H.R. 20596 Before the H. Comm. on Patents Commencing Jan, 24, 1912, 62d Cong. 19–20, 99 (1912).

51. In response to the Supreme Court's 1911 decision in the *Kalem* case, lawyers for the motion pictures industry persuaded Congress to enact an amendment to the copyright law limiting the amount of damages that could be recovered for infringing motion pictures. The original version of the Townsend Amendment of 1912 would have limited the liability of infringing motion pictures to \$100. Dramatists and theatrical producers objected vehemently. *See id* 4–6, 27–42. As enacted, the law provided for the registration of motion picture copyrights and limited the damages awards in motion picture cases,

...in the case of the infringement of an undramatized or nondramatic work by means of motion pictures, where the infringer shall show that he was not aware that he was infringing, and that such infringement could not have been reasonably foreseen, such damages shall not exceed the sum of one hundred dollars; and in the case of an infringement of a copyrighted dramatic or dramatico-musical work by a maker of motion pictures and his agencies for distribution thereof to exhibitors, where such infringer shows that he was not aware that he was infringing a copyrighted work, and that such infringements could not reasonably have been foreseen, the entire sum of such damages recoverable by the copyright proprietor from such infringing maker and his agencies for the distribution to exhibitors of such infringing motion picture shall not exceed the sum of five thousand dollars nor be less than two hundred and fifty dollars...

Pub. L. 62-303, 37 Stat. 488 (August 24, 1912). The Senate Report accompanying the bill suggested that a movie was unlikely to harm the copyright of an undramatized work, but that the likely damage to the owner of a dramatic work by an infringing movie would be much higher. S. Rep. 906, 62d Cong. 3 (July 8, 1912).

to claims for infringement of their adaptation and dramatization right under section 1(b).⁵²

In one early case, Jack London sued the Biograph Film Company, claiming that D.W. Griffith's nine-minute 1908 film, *For Love of Gold*,⁵³ infringed his 1906 short story, *Just Meat*.⁵⁴ As in the *Ben Hur* case, Griffith's use of London's story appears to have been deliberate, without thought to any potential liability under copyright law.⁵⁵ The district court enjoined the film and awarded London \$250 in damages. The court of appeals reversed. After a detailed comparison of the plot of the movie with the plot of the story, the court determined that London's copyright "cannot protect the fundamental plot, which was common property long before the story was written; it will protect the embellishments with which the author added elements of literary value to the old plot, but it will not operate to prohibit the presentation by someone else of the same old plot without the particular embellishments."⁵⁶

During the First World War, film studios shifted much of their production from single-reel short films to multi-reel, feature-length movies.⁵⁷ Studios began looking to the commercial theatre for both talent and raw material, and began to purchase motion pictures rights in plays, novels and stories.⁵⁸ D.W. Griffith's first feature length film, *Judith of Berhulia*,⁵⁹ was adapted from Thomas Baily Aldrich's 1904 tragedy of the same name.⁶⁰ Cecil B. DeMille's first film, *The Squaw Man*,⁶¹ was a feature-length western based on the popular 1905 melodrama of the same

52. See, e.g., Complaint at 3, *London v. Biograph*, (1914) (No. 11-149) (alleging unlawful dramatization), rev'd, 231 F. 696 (2d Cir. 1916).

53. FOR LOVE OF GOLD (Biograph 1908).

54. Jack London, *Just Meat*, 42 *Cosmopolitan* #5 (Mar. 1907) at 535-42, available at <http://carlbell-2.baylor.edu/~bellc/JL/JustMeat.html>. London brought the suit in equity. I have been unable to ascertain which, if any, statutory section London relied on in his suit. The district court opinion was unpublished and my efforts to unearth it have so far failed. The court of appeals decision doesn't say.

55. See Linda Arvidson Griffith, *When the Movies Were Young* 60 (1925) ("Rainy August Days forced us to work in the studio. Mr. Griffith had read a story by Jack London called 'Just Meat.' He changed the name to 'For Love of Gold' and let it go at that. We had no fear of lawsuits from fractious authors in those days.").

56. *London v. Biograph*, 231 F. 696, 698-99 (2d Cir. 1916); cf. *Eichel v. Marcin*, 241 F. 404, 411 (S.D.N.Y. 1913) (finding no infringement after detailed comparison of plots of stage plays "Wedding Presents" and "Cheating Cheaters" because similarities are "general features and subjects . . . clearly open to common use").

57. See Tino Balio, *United Artists: The Company Built By the Stars* 8-11 (1976); Robert S. Birchard, *Images of America: Silent-Era Filmmaking in Santa Barbara* 37 (2007).

58. See, e.g., Robert M. Henderson, *D. W. Griffith: his life and work* (1972); Sumiko Higashi, *Cecil B. DeMille and the Lasky Company: Legitimizing Feature Film as Art*, 4 *Film History* #3, 1990 at 181; Siva Vaidhyanathan, *Copyrights and Copyrights* 98-99 (2001).

59. JUDITH OF BERTHULIA (Biograph 1914).

60. Cooper C. Graham, Steven Higgins, Elaine Mancini & Joao Luiz Cveira, *D.W. Griffith and the Biograph Company* 210 (1985); See Thomas Baily Aldrich, *Judith of Berthulia* (1905).

61. THE SQUAW MAN (Famous Players-Lasky 1914).

name by Edwin Milton Royle.⁶² Some uses of books, stories or plays were, like Griffith's use of *Just Meat*, both unauthorized and deliberate. Others may have been only coincidentally similar.

Both *Kalem* and *London* had evaluated infringing similarity by comparing the plots of the two works before the courts. Later courts, without much reflection, also relied on detailed comparisons of plot and of particular scenes, citing earlier cases over allegedly infringing plays.⁶³ This choice isn't obvious. Infringement suits pitting novels against plays or plays against each other require comparison of works written in words. Infringement suits claiming that movies—most of them short and all of them silent—infringe the copyright in plays, novels, or stories require the comparison of works written in words with works created entirely with pictures. The courts had experience with comparing allegedly similar images in copyright suits involving photographs,⁶⁴ paintings⁶⁵ and sculptures,⁶⁶ and could have relied on those precedents to analyze infringement by silent movies. In many cases, the films, scripts and stories were made part of the record; in at least one case, counsel presented and

62. See Simon Louvish, Cecil B. DeMille, *A Life in Art* 58, 466 (2007).

63. Compare, e.g., *Stephens v. Howell Sales*, 16 F.2d 805 (S.D.N.Y. 1926) (holding movie, "Vendetta," to infringe Archibald Clavering Gunter's novel, "Mr Barnes of New York," because "a comparison of . . . scenes. . . shows many of them to be identical"), and *Stodart v. Mutual Film*, 249 F. 507 (S.D.N.Y. 1917) (finding movie, "The Strength of Donald MacKenzie," to be a direct copy from the plot of Robert Stodart's play, "The Woodsman"), with *Chappell v. Fields*, 210 F. 864 (2d Cir. 1914) (finding infringement on the basis of a single scene appearing in both plays in which villagers mistake a movie company's filming of an invasion scene for an actual invasion), and *Daly v. Webster*, 56 F. 483 (2d Cir. 1892) (finding infringement on basis of a scene in both plays which a character is fastened to railroad tracks in the path of an oncoming train and rescued at the last minute); compare also, e.g., *Bobbs Merrill v. Equitable Motion Pictures*, 232 F. 791 (S.D.N.Y. 1916) (denying preliminary injunction to publisher of John Breckinrige Ellis's novel "Fran," in suit against the movie "A Circus Romance" despite "marked similarities" in plot and setting), with *Underhill v. Belasco*, 254 F. 838 (S.D.N.Y. 1918) (finding David Belasco's play, "Marie Odile" did not infringe Gregorio Sierra's play, "The Cradle Song," despite similarities in convent setting, foundling theme, and some dialogue and language), with *Frankel v. Irwin*, 34 F.2d 142 (S.D.N.Y. 1918) (finding no infringement of Joseph William Frankel's play, "Three Months Abroad" by Leroy Scott's play "13 Washington Square" despite similar premise), with *Stevenson v. Harris*, 238 F. 432 (S.D.N.Y. 1917) (finding that play "Arms and the Girl" by Grant Stewart and Robert Baker did not infringe copyright in Burton Egbert Stevenson's novel "Little Comrade" despite similar plot details), and *Vernon v. Sam S. & Lee Shubert, Inc.*, 220 F. 694 (S.D.N.Y. 1915) (holding that play, "At Bay," did not infringe play "Threads of Destiny," despite similar premise, characters and phraseology because the theories of the two plays were different).

64. See, e.g., *Gross v. Seligman*, 212 F. 930, 931 (2d Cir. 1914) ("[T]he many close identities of pose, light, and shade, etc., indicate very strongly that the first picture was used to produce the second"); See also *Springer Lithographing Co. v. Falk*, 59 F. 707, 712 (2d Cir. 1894) (affirming jury instruction).

65. See, e.g., *Beifeld v. Dodge Publishing Co.*, 198 F. 658 (C.C.N.Y. 1911) (finding a sketch to infringe a Maxfield Parrish painting: "[t]he subject is the same, the number, position, and sex of the figures are the same, and the differences are only as to the treatment of certain minor details.")

66. See, e.g., *Pellegrini v. Allegrini*, 2 F.2d 610, 611 (E.D. Pa. 1924) (comparing two statuettes); See also *King Features v. Fleischer*, 299 F. 533 (2d Cir. 1924) (finding a toy to infringe a cartoon).

testified about still photographs from the silent films.⁶⁷ But, after *Kalem*, neither courts nor lawyers seem to have challenged the idea that the test for infringement for films should track the tests for novels and scripts. Courts analyzed allegedly infringing movies as if they were plays, dissecting the stories they told without playing explicit attention to the absence of dialogue or the presence of pictures on the screen. As scholars Rebecca Tushnet, Olufunmilayo Arewa, and Rob Kasunic have noted in other contexts,⁶⁸ copyright law is most comfortable with words and with works expressed in words. In determining whether silent movies infringed stories, books and, later, stage plays, courts created (or invited counsel to create) word descriptions of the works before them, and then compared the synopses.⁶⁹ Why did the courts take the approach of reducing both works to plot synopses and comparing the synopses? Movies were still very new. Courts weren't yet sure what parts of movies counted as copyrightable expression. Plot was familiar, so it may have been easiest to focus on the stories told by the books, plays and movies.

In 1916, the American Film Company released *The Strength of Donald MacKenzie*, starring William Russell.⁷⁰ The scenario of the five-reel movie was credited to J. Edward Hungerford, from a story credited to Russell Smith. Both Hungerford and Smith were by then established screenwriters.⁷¹ Playwright Robert Stodart sued for infringement of his public performance right, claiming that the film had in fact been adapted from his play, *The Woodsman*.⁷² Stodart testified that he had given the script of *The Woodsman* to Smith and asked him to arrange to sell the movie rights. The film studio claimed that it had based the movie on a

67. *Nichols v. Universal*, 34 F. 2d 145 (S.D.N.Y. 1929), *aff'd* 45 F.2d 119 (2d Cir. 1930), cert. denied, 282 US 902 (1931); *See* Trial Record on Appeal to the 2d Circuit at 474, *Nichols v. Universal Pictures*, 45 F. 2d 119 (2d Cir. 1930) (No. 4) ["Nichols Trial Record"]; Appendix to Brief for the Respondents in Opposition to Certiorari, *Nichols v. Universal Pictures*, (Jan. 23, 1931) (No. 612).

68. *E.g.*, Olufunmilayo Arewa, *Writing Rights: Copyright's Visual Bias and African American Music*, U.C. Irvine School of L. Research Paper No. 2012-9 (2012), *available at* <http://ssrn.com/abstract=2010024>; Rob Kasunic, *The Problem of Meaning in Non-Discursive Expression*, 57 *J. Copyright Soc'y* 399 (2010); Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright Law*, 125 *Harv. L. Rev.* 683 (2012).

69. *See, e.g.*, *Stephens v. Howell Sales*, 16 F.2d 805 (SDNY 1926); *Stodart v. Mutual Film*, 249 F. 507 (S.D.N.Y. 1917).

70. THE STRENGTH OF DONALD MCKENZIE (American Film Company 1916).

71. *See* Internet Movie Database, Russel E Smith, <http://www.imdb.com/name/nm0809834/> (last visited Apr. 10, 2015); Internet Movie Database, J. Edward Hungerford,

<http://www.imdb.com/name/nm0402239/> (last visited Apr. 10, 2015); *See also* Around the Council Table: A Correction, 5 *The Bulletin of the Authors League of America*, No. 2, (May 1917) at 11 (clarifying that the screenwriter named J. Edward Hungerford is not the same writer as the "well known author" Edward Hungerford, who "has been subjected to a great deal of annoyance because of the similarity of the film writer's name").

72. *Stodart*, 249 F. at 507. Stodart sued for infringement of his public performance right under section 1(d) by "performing the [play] upon the screen." *See id.* at 508.

story titled *The Guide*, which it had purchased from Smith. Neither Stodart nor the film studio called Smith as a witness.⁷³ After reviewing the plot of Stodart's play in detail, and characterizing it as “trite and conventional in the extreme,” Judge Learned Hand concluded that the movie infringed the copyright in Stodart’s play:

The characters are the same. The hero is a woodsman guide with a turn for poetry, a strong father, and a poetic mother. The heroine is betrothed to a rascal in the city, who lives upon the income of foul and illegal tenements. The lady and the villain go with her father to the north woods of Maine, and there encounter the hero guide, for whom she develops a sentimental leaning, to the discomfiture of her betrothed. He thereupon suborns a half-breed villain to change the direction of a sign upon a trail upon which the lady and the hero are to leave on the morrow. The hero mistakes the trail by virtue of the sign, is compelled to spend the night with the lady in the open, to the great horror of all the respectable people who form the party and who go out in search of them. The hero's motives are at once misunderstood, both by the lady and by an imbecile father; the villain's tool is about to die from a wound, just as in the original; he repents and discloses the artifices of the villain, and the villain is thus exposed, to the eternal justification of the respectable nonentities. There are some incidents in the play which are not in the film, and some incidents in the film which are not in the play; but they are trivial and do not concern the plot.⁷⁴

Why did Stodart sue for infringement of his public performance right, rather than the dramatization right recognized by the Supreme Court as infringed by the exhibition of an unlicensed film version in *Kalem*? The answer lies in the language of section 1(b) of the 1909 Act. Section 1(b), the precursor of the current section 106(2), gave the copyright owner the exclusive right

(b) To translate the copyrighted work into other languages or dialects, or make any other version thereof, if it be a literary work; *to dramatize it if it be a nondramatic work*; to convert it into a novel or other nondramatic work if it be a drama; to arrange or adapt it if it be a musical work; to complete, execute, and finish it if it be a model or design for a work of art...⁷⁵

The right to dramatize was limited in terms to nondramatic works. Dramatic works received only a right “to convert it into a novel or other nondramatic work”.⁷⁶ Since making and showing a film did not infringe the

73. *Id.* at 510–11; *See* Motion Picture Suit, 5 The Bulletin of the Authors League of America, No. 1, April 1917, at 19.

74. Stodart, 249 F. at 509.

75. 1909 Act § 1(b) (emphasis added).

76. *Id.* This formulation was inadvertently narrower than the earlier formulation under section 4952 of the Revised Statutes as amended by the 1891 Chace Act, which provided that “authors or their assigns shall have exclusive right to dramatize and translate any of their works for which copyright shall have been obtained under the laws of the United States.” *See* H. R. Rep. No. 2222, at 4 (1909)

right to “print, reprint, publish, copy, and vend,”⁷⁷ playwrights sued for infringement of their performance and exhibition right under section 1(d).⁷⁸

II. THE 1920S

Jame Curwood's *The Valley of the Silent Men* (1920) v. Edwin Carewe's *I am the Law* (1922)

James Curwood's *The River's End* (1919) v. Edwin Carewe's *I am the Law* (1922)

Archibald Gunter's *Mr. Barnes of New York* (1887) v. Georg Jacoby's *Vendetta* (1919)

The influx of film money into stage productions gave the American commercial theatre its most successful and last successful decade.⁷⁹ It also encouraged plagiarism litigation.⁸⁰ The proliferation of cases bred diversity in the evidence that lawyers introduced to prove or disprove infringing similarity. Litigators submitted their own synopses of the allegedly infringed and infringing works.⁸¹ They introduced scripts, screenplays and scenarios,⁸² motion picture stills,⁸³ expert testimony as to the originality, novelty, uniqueness and value of both plaintiffs' and

(“Paragraph b in the section contains certain new legislative features, but is consistent with the existing law as construed by the courts”).

77. See sources cited notes 42–46.

78. 1909 Act § 1(d) conferred “the exclusive right....

To perform or represent the copyrighted work publicly if it be a drama or, if it be a dramatic work and not reproduced in copies for sale, to vend any manuscript or any record whatsoever thereof; to make or to procure the making of any transcription or record thereof by or from which, in whole or in part, it may in any manner or by any method be exhibited, performed, represented, produced, or reproduced; and to exhibit, perform, represent, produce, or reproduce it in any manner or by any method whatsoever....

79. See, e.g., Bernheim, *supra* note 33, at 73–109.

80. See Channing Pollack, *Stop Thief!*, 14 Green Book Magazine, Oct. 1915, at 649; Channing Pollock, *Making Authors Pay*, Pittsburgh Press, June 1, 1930, at 1, 2; See, e.g., *Prize Play Called Plagiarism in Suit*, N.Y. Times, June 6, 1925, at 15; *Plagiarism Suit Fails*, N.Y. Times, Apr. 27, 1927, at 10; *Finds Fool No Plagiarism*, N.Y. Times, Mar. 19, 1927, at 23; *Priest Says He Wrote “O’Brien Girl” Story*, N.Y. Times, June 17, 1926, at 21; *Suit Over “The Gorilla,”* N.Y. Times, July 1, 1925, at 16; *Suit on Hitchcock’s Play*, N.Y. Times, Jan. 3, 1914, at 3; *Simonton v. Gordon*, 12 F.2d 116 (S.D.N.Y. 1925); *Frankel v. Irwin*, 34 F.2d 142 (S.D.N.Y. 1918); *Underhill v. Belasco*, 254 F. 838 (S.D.N.Y. 1918).

81. See, e.g., *International Film Service v. Affiliated Distributors*, 283 F. 229, 231–33 (S.D.N.Y. 1922); *Brief for Appellant* at 4–5, *Dymow v. Bolton*.

82. See, e.g., *Rush v. Oursler*, 39 F.2d 468, 469–70 (SDNY 1930); *Simonton v. Gordon*, 12 F.2d 116, 117 (S.D.N.Y. 1925); *Curwood v. Affiliated Distributors, Inc.*, 283 F. 223, 223 (S.D.N.Y. 1922).

83. *Record on Appeal* at 474, *Nichols v. Universal Pictures*, 45 F. 2d 119 (2d Cir 1930) (No. 4); see, e.g., *id.* at 923–27 (testimony of Moses Malevinsky)..

defendants' works;⁸⁴ earlier examples of similar characters, plot or literary devices;⁸⁵ and literary theories speaking to what sorts of similarities should be actionable.⁸⁶ They invited judges to read book jackets, prefaces, programs, advertisements, and reviews,⁸⁷ attend productions of plays,⁸⁸ and to watch allegedly infringed and infringing films.⁸⁹ Trial courts sitting in equity as finders of fact appear not to have focused on the relevance or admissibility of this evidence; rather, they seem to have allowed counsel to present whatever proof they chose, and give it such weight as specific judges believed it warranted.

In *International Film v. Affiliated Distributors*,⁹⁰ for example, the assignee of motion picture rights in James Curwood's novel, *The Valley of Silent Men*,⁹¹ sued the producer of a seven-reel film titled *I am the Law*,⁹² claiming that the film was an infringing adaptation of Curwood's novel. Defendants argued that any similarities derived from the use of stock devices and common basic plot developments:

[I]t is suggested, and properly so, that Curwood has no monopoly upon Canadian Northwest stories, and no pre-emption of Royal Mounted Police as characters to act therein. These are admittedly subjects of literary material well within the public domain.

But, while this is true, such subject-matter may be so utilized, as to setting, atmosphere, sequence of events, and detail of narrative, as to constitute an infringement upon the work of one who, while using old and well-known means, has created a novel situation.

After comparing the synopses of the novel and the movie submitted by counsel for both parties, reading the book jacket of the novel and reviews of the film, watching both defendants' film and plaintiff's film based on Curwood's novel, and considering the wisdom of a book, proffered by

84. See, e.g., *Simonton v. Gordon*, 297 F. 625, 626 (S.D.N.Y. 1924).

85. See, e.g., *Roe-Lawton v. Hal E. Roach Studios*, 18 F.2d 126, 127 (S.D. Cal. 1927); *Stephens v. Howells Sales, Inc.*, 16 F.2d 805, 808 (S.D.N.Y. 1926); *Curwood v. Affiliated Distributors, Inc.*, 283 F. 223, 227 (S.D.N.Y. 1922); *Stephenson v. Harris*, 238 F. 432, 435–36 (S.D.N.Y. 1917); *Bobbs-Merrill Co. v. Equitable Motion Pictures Corp.*, 232 F. 791 (S.D.N.Y. 1916); Brief for Appellant at 19–21, *Dymow v. Bolton*. Defendants filled the record with many prior similar works because the strategy proved effective. See, *infra* notes 128–157 and accompanying text.

86. See, e.g., *Simonton*, 297 F. at 626 (S.D.N.Y. 1924); Brief for Appellee at 10–11, *Dymow v. Bolton*.

87. See, e.g., *Rush*, 39 F.2d at 470 (S.D.N.Y. 1930); *Simonton v. Gordon*, 12 F.2d 116, 117 (S.D.N.Y. 1925); *International Film Service*, 283 F. at 233.

88. See, e.g., *Simonton*, 12 F.2d at 117.

89. See, e.g., *Int'l. Film Service v. Affiliated Distributors*, 283 F. 229, 234 (S.D.N.Y. 1922).

90. *Id.*

91. James Oliver Curwood, *The Valley of Silent Men* (1920). Plaintiff produced a film, also titled *The Valley of Silent Men*, filmed in the Canadian Rockies. See Internet Movie Database, *The Valley of Silent Men*, <http://www.imdb.com/title/tt0013727/> (last visited Apr. 10, 2015).

92. *I am the Law* (Edwin Carewe Productions 1922) (filmed in California, see 283 F. at 233). See also *Curwood v. Affiliated Distributors*, 283 F. 223 (SDNY 1922), where Curwood claims that a scene in the same movie involving a “Chinese Den” infringed the copyright in his earlier novel.

defendants, purporting to list the 36 essential plots of a dramatic play,⁹³ the court concluded that defendants' film infringed the dramatization right in the Curwood book.

I am constrained to believe that the theme or subject of the [novel] has in part, at least, been dramatized by defendants in their picture; that it has been reproduced through scenes and incidents coupled with situations by which one of the kernels of Curwood's composition is emphasized.⁹⁴

In a related case,⁹⁵ Curwood himself claimed that a scene in *I am The Law* involving a "Chinese Den" infringed the copyright in his different, earlier novel, *The River's End*.⁹⁶ The same judge concluded that the evidence supported the inference that the scene in Curwood's novel had inspired the Chinese den scene in the movie. Nonetheless, the similarities were not infringing:

My opinion is, however, that, even assuming the book to have suggested the Chinese den feature to the writer of the scenario, he has brought about such a material alteration in the constituent parts of the series of events, and in the sequence of the events in the series, as to escape the charge of plagiarism with respect thereto.⁹⁷

In *Stephens v. Howells*,⁹⁸ the owner of the copyright in *Mr. Barnes of New York*, a novel first published in 1887, and the assignee of the motion picture rights in the novel, sued the importers and exhibitors of the German film *Vendetta*.⁹⁹ Plaintiffs claimed that the importation and exhibition of the film violated their dramatization right. Defendants argued that the revenge plot was old, and could not be copyrighted.¹⁰⁰ The court agreed that the subject of a vendetta was not copyrightable, but insisted that the author's particular treatment of the subject was protected. "It is true that an old plot could not be copyrighted, and this plot is old, but a new treatment of an old plot may be protected by copyright."¹⁰¹ The court compared the film with the book and concluded that the film had been based on the book's particular treatment of the revenge plot:

The plot in the moving picture "Vendetta" is so strikingly like the book "Mr. Barnes of New York" in general plan and detail as to plainly lead one to conclude that they were conceived by the same mind and that the

93. Georges Polti, *The Thirty-Six Dramatic Situations* (1916); *See* Curwood, 283 F. at 233.

94. 283 F. at 234. The court ordered defendants to excise the infringing portions of the film before further exhibiting it. *Id.* at 235. The judge declined to award damages, concluding that plaintiff's monetary loss was very small. *Id.*

95. *Curwood v. Affiliated Distributors*, 283 F. 223 (S.D.N.Y. 1922).

96. JAMES OLIVER CURWOOD, *THE RIVER'S END* (1919).

97. 283 F. at 228.

98. *Stephens v. Howells*, 16 F.2d 805, 806 (S.D.N.Y. 1926).

99. *VENDETTA* (UFA 1919).

100. 16 F.2d at 808.

101. *Id.* (citing *Fisher v. Dillingham*, 298 F. 145 (S.D.N.Y. 1924)). Defendants had introduced Balzac's *Vendetta* and Merrimee's *Columbia* in an unsuccessful effort to show that the plot of *Mr. Barnes of New York* could not be protected. *Id.*

picture infringes the book. There is a duel between an English naval officer and a Corsican (French) army officer; the Corsican is killed; his sister, the heroine, swears to avenge his death; she searches for the Englishman; she nurses in a hospital in Alexandria, Egypt, and there falls in love with her patient, an Englishman; they meet later in Monte Carlo; love conquers her oath of vengeance and they get married in Corsica. The villain, her guardian and suitor, tries to incite her to kill her husband in their bridal chamber, having got the apparent proof that it was he who killed her brother; she wavers, torn between the two passions of love and hatred; love again triumphs, whereupon the old Tomasso, the family servant, seizes the dagger and stabs through the curtains at, he thinks, the approaching bridegroom, but instead kills the villain, who had hidden there to see his rival killed. The scenes are laid in the same places -- Ajaccio, Corsica, Alexandria, Egypt, Monte Carlo, and back to Corsica. The names of the principal characters are the same, with the exception that "Marina" becomes "Marianna" and "Mr. Barnes of New York" becomes "Gladwin Irving."¹⁰²

The court enjoined defendants from exhibiting the motion picture and ordered that all prints of the film be destroyed.¹⁰³

By the end of the 1920s, courts had decided dozens of copyright infringement cases involving silent films, yet they were still analyzing infringement by comparing plot synopses. To some degree, these cases illustrate that what one can see is constrained by what one knows to look for. Judges had to learn to be able to see the images on the screen when they were looking for copyright infringement, and that didn't happen right away, or even in the few two or three decades.

III. NICHOLS V. UNIVERSAL

Anne Nichols's *Abies Irish Rose* (1922) v. Harry Pollard's *The Cohens and Kellys* (1926)

The most famous of the silent film copyright infringement cases is *Nichols v. Universal*.¹⁰⁴ *Nichols* shows up in most copyright casebooks.¹⁰⁵ Copyright texts present it as a classic, iconic example of how courts go about determining infringing similarity.

Anne Nichols grew up in Dales, Georgia, and was raised as a Baptist.¹⁰⁶ At sixteen, she ran away to Philadelphia to be an actress and got a chorus role in Wright Lorimer's *The Shepherd King*. She acted in two

102. *Id.*

103. *Id.* at 812.

104. *Nichols v. Universal*, 34 F. 2d 145 (S.D.N.Y. 1929), *aff'd* 45 F.2d 119 (2d Cir. 1930).

105. *See supra* notes 1,4.

106. Ted Merwin, *The Performance of Jewish Ethnicity in Anne Nichols' Abies Irish Rose*, *J. Amer. Ethnic History* (2001), *available at*

<http://www.accessmylibrary.com/article-1G1-74583427/performance-jewish-ethnicity-anne.html>.

silent films,¹⁰⁷ toured in vaudeville, and, in 1915, married Henry Duffy, a fellow vaudevillian and an Irish Catholic.¹⁰⁸ Nichols started writing vaudeville sketches in the teens, coauthored a modestly successful farce with Adelaide Matthews,¹⁰⁹ and collaborated on two musicals.¹¹⁰ She wrote her first solely-authored, full-length play, *They Should Worry*, in 1919, and struggled to find a producer. Finally, she persuaded Oliver Morosco to produce the play in California under the title *Abie's Irish Rose* if she agreed to repay any losses.¹¹¹ The Los Angeles and San Francisco runs were successful, but Nichols could not convince any producer to mount a New York production. She mortgaged her home, rented a Broadway theater, and produced the play herself.¹¹² Initial reviews of the production ranged from lukewarm¹¹³ to scathing.¹¹⁴ The play hobbled along for a few weeks, found its audience, and became an enormous hit, breaking all Broadway records for commercial success and length of run.

In 1925, Universal offered to buy the film rights to *Abie's Irish Rose*.¹¹⁵ Nichols refused to sell at the price Universal offered to pay, believing she could do better. She was right: in 1927, she sold the film rights to Famous Players-Lasky (later Paramount Pictures) for a reported \$300,000 plus a percentage of the film's profits.¹¹⁶ Wikipedia lists the resulting movie as the 15th top grossing silent film in the United States.¹¹⁷

107. Internet Movie Database, Anne Nichols, <http://www.imdb.com/name/nm0629532/> (last visited Apr. 10, 2015).

108. See Merwin, *supra* note 106.

109. Internet Broadway Database, Just Married (1921), <http://www.ibdb.com/production.php?id=9064> (last visited Apr. 10, 2015).

110. Internet Broadway Database, Linger Longer Letty (1919), <http://www.ibdb.com/production.php?id=6726> (last visited Feb. 8, 2015); Internet Broadway Database, Love Dreams (1921), <http://www.ibdb.com/production.php?id=12662> (last visited Apr. 10, 2015).

111. Abe Laufe reports that the script bore an interim title, "Marriage in Triplicate," and that Morosco claimed to have significantly revised Nichols's script. Abe Laufe, Anatomy of a Hit 28 (1966).

112. Broadway Reviews: Abie's Irish Rose, *Variety*, May 26, 1922, at 15.

113. E.g., Theater Review: Abie's Irish Rose, *NY Times*, May 24, 1922, available at http://theater.nytimes.com/mem/theater/treview.html?_r=1&id=1077011429005&html; Mr. Hornblow Goes to the Play, 35 *Theatre Magazine*, August, 1922 at 93, 95.

114. Broadway Reviews: Abie's Irish Rose, *Variety*, May 26, 1922, at 15 ("It played without visible confusion and ran smoothly enough except for the overacting"); Life Drama: Confidential Guide, *Life Magazine*, Aug. 17, 1922, at 18 ("couldn't be much worse"). See What Critics Said About "Abie," *Weekly Variety*, May 20, 1925, at 7; See also "Abie's Irish Rose" to Go Into Movies, *N.Y. Times*, Jan. 12, 1927 (quoting reviews).

115. *Nichols v. Universal Pictures*, 34 F.2d 145, 150 (S.D.N.Y. 1929).

116. "Irish Rose" Film Sets Sales Record: Anne Nichols in Deal Closed Yesterday Likely to Get More than \$1,000,000, *N.Y. Times*, Feb. 27, 1927. Interestingly, this sale was after the release of *The Cohens and Kellys*. In 2014 dollars, \$300,000 would be more than \$4 million. See http://www.bls.gov/data/inflation_calculator.htm.

117. Silent Film, Wikipedia, http://en.wikipedia.org/wiki/Silent_film (last visited Apr. 10, 2015). *Abie's Irish Rose* is number 15 on a list of 15. *The Cohens and Kellys* is not on the list. It isn't clear that

Meanwhile, though, Universal had paid \$8500 to buy the film rights to a less successful play, Aaron Hoffman's *Two Blocks Away*,¹¹⁸ and had purported to use it as the raw material for a silent feature film that it released under the name "*The Cohens and Kellys*," and advertised as an "*Abie's Irish Rose* for the screen."¹¹⁹

Nichols sued for violation of her reproduction, distribution and public performance rights under subsections 1(a) and (d) of the 1909 Act.¹²⁰ The evidence of copying-in-fact was compelling. Universal had sought to purchase film rights to Nichols' play. Witnesses testified that when Universal's E.M. Asher bought the film rights from Aaron Hoffman, Asher had remarked that he planned to use the script as a vehicle to make a film version of *Abie's Irish Rose*.¹²¹ Corroborating that testimony was the fact that the plot of *The Cohens and Kellys* was far more like the plot of *Abie's Irish Rose* than it was like *Two Blocks Away*.

As all copyright students know, both *Abie's Irish Rose* and *The Cohens and Kellys* involve a Jewish family and an Irish Catholic family whose children fall in love to the consternation of their fathers, secretly marry, and bear a child (or two). The Jewish fathers discover that their children have married Irish Catholics, and disown them. Eventually, however, the families reconcile. Hoffman's *Two Blocks Away* contained none of this.

Two Blocks Away is about a Jewish shoemaker named Nate Pomerantz and an Irish carpenter named Bill Lewis, who are related by marriage. Nate and Bill have no children, but have somehow become co-foster parents to a young woman named "Jane," who calls them "Daddy Nate" and "Daddy Bill."¹²² A corrupt lawyer who wants to marry Jane tells Daddy Nate that he's inherited a fortune. Nate takes the money and buys a big mansion, two blocks away from the old neighborhood, sends Jane off to France to finishing school, and is suddenly too good for his old friends. Act II takes place a year later. Jane comes back, all finished, but still in love with Tom, her boyfriend from the old neighborhood. Daddy Nate thinks she's now too good for Tom, but he doesn't make a big deal of

Abie's Irish Rose should be considered a purely "silent" film, since the studio released both a silent version and a version with some synchronized sound.

118. Aaron Hoffman, *Two Blocks Away* (1925).

119. Mark Rose includes a copy of one of the ads for *The Cohens and Kellys* in his recently published essay on the Nichols case. Mark Rose, *Criticism in the Courtroom: Nichols v Universal* (1930) and the Determination of Infringement, 5 W.I.P.O J. 65, 67 (2013).

120. Reply Brief for Appellant Nichols at 21, *Nichols v. Universal*, 45 F.2d 119 (2d Cir. 1930)

121. Asher Deal Figures in Nichols Suit, N.Y. Times, Dec. 27, 1928, at 16.

122. Jane appears to be a Gentile. She has a boyfriend from the neighborhood, who at one point mentions sitting with her in church – but there's no indication whether the church is Catholic or Protestant.

it. She refuses to marry the lawyer, whereupon the lawyer reveals that Daddy Nate didn't actually inherit the money; the money in fact belongs to Daddy Bill. Jane immediately tells Nate. As soon as Nate finds out, he goes over to Bill's house and gives him the money. Bill forgives Nate for having been a snob.

Hoffman's characters don't appear to care even a little bit about religion or ethnicity. There is no apparent animosity between Jews and Catholics. There is no secret romance or secret marriage. No grandchildren are born. All of that was added by the screenwriters at Universal. Moreover, there was testimony, which the trial judge appears to have believed, that the screenwriters studied the script of Nichols's play in writing the scenario for *The Cohens and Kellys*.¹²³ Although witnesses for Universal denied that the studio had any intention of copying *Abie's Irish Rose* and insisted that the studio had never tried to purchase the film rights to Nichols' play,¹²⁴ the judge appears to have discounted their testimony.

Universal's lawyers didn't rely on persuading the court that no copying had occurred, or that similarities were coincidental. They concentrated, instead, on challenging the validity of Nichols's copyright. Universal alleged that Nichols had lost her copyright because she had failed to comply strictly with statutory formalities.¹²⁵ It also argued that none of the similarities between the play and film were protected by copyright, because all of them had been anticipated in what Universal referred to as "the prior art."¹²⁶ It directed major efforts to finding as many works as possible that resembled *Abie's Irish Rose*.

123. See 34 F.2d at 150.

124. Judge in Nichols Suit Sees Loveless Movie, NY Times, Jan. 11, 1929, at 9; Ignored Reviews Says Anne Nichols, N.Y. TIMES, Dec. 25, 1928, at 26.

125. See Brief for Appellee Universal Pictures, Nichols v. Universal (2d Cir.), at 85-95 ["Universal's 2d Circuit Brief"].

126. See, e.g., Universal's 2d Circuit Brief, *supra* note 125, at 82. The principle that a copyrightable writing need not be new or novel was well-established in US copyright law by the mid-19th century; See, e.g., Emerson v. Davies, 8 F. Cas. 615, 620 (C.C.D. Mass. 1845) ("It is a great mistake to suppose, because all the materials of a work or some parts of its plan and arrangements and modes of illustration, may be found separately, or in a different form, or in a different arrangement, in other distinct works, that therefore, if the plan or arrangement or combination of these materials in another work is new, or for the first time made, the author, or compiler, or framer of it, (call him which you please,) is not entitled to a copy-right. The reverse is the truth in law, and, as I think, in common sense also."). Infringement trials during this era nonetheless focused on disputes over whether the similar elements in plaintiffs' and defendants' works were sufficiently original to be protected by plaintiffs' copyrights; See cases cited *supra* note 85; Harold Lloyd Corp. v. Witwer, 65 F.2d 1, 90 (9th Cir. 1933) ("The copyright of a story only covers what is new and novel in it, so that the question of infringement involves a consideration of what is new and novel in the story to which the author has acquired a monopoly which has been misappropriated by another.").

The infringement trial began on December 20, 1928 and lasted well into January. The daily newspapers printed summaries of the previous days' testimony.¹²⁷ From the New York Times, we learn that counsel for Universal read passages from *Krausmeyer's Alley*, *The Rabbi and the Priest*, *Joe Lewis and Son*,¹²⁸ and *Romeo and Juliet* aloud.¹²⁹ In her testimony, Nichols denied having read or seen any of them.¹³⁰ Universal's lawyer asked Nichols about a magazine story published in 1924 under her byline in which she claimed to have based the play on a real story told to her by Fiske O'Hara about a friend of his who had tried to pass his Irish-Catholic wife off as Jewish to his observant parents, and had made up a Hebrew name for her.¹³¹ Nichols denied having written the article, having read it, or indeed, having known about it at all.¹³² She conceded, however, that a story Fiske O'Hara told her had inspired her to write the play.¹³³ Defense lawyers called playwrights who had authored allegedly similar plays as defense witnesses, and entered their scripts into the record.¹³⁴ Both sides presented the testimony of purported literary experts speaking to what in Nichols's script was new, and what echoed examples from earlier literature,¹³⁵ as well as experts claiming to compare and contrast the movie with the play.¹³⁶ Plaintiff's lawyer Moses Malevinsky called himself as an expert witness and testified for seven days.¹³⁷ Universal's lawyers introduced seventy different works that they claimed reflected the fundamental plot and constituent elements found in *Abie's Irish Rose*.¹³⁸ The trial judge read Nichols's play, watched Universal's movie, watched an expurgated version of Universal's movie with all of the scenes featuring the young lovers deleted, and also watched the Famous Players-Lasky movie of *Abie's Irish Rose*, which had been released in the interim, after Nichols

127. *E.g.*, Anne Nichols Suit for "Piracy" Opens, N.Y. Times, Dec. 21, 1928, at 18.

128. Ignored Reviews *supra* note 124 at 26.

129. Shakespeare Read in "Abie's Rose" Suit, N.Y. Times, Dec. 28, 1928, at 10.

130. Suit for "Piracy" *supra* note 127, at 18; Ignored Reviews *supra* note 124 at 26.

131. Anne Nichols, The Million Dollar Hit, Theatre Magazine, July, 1924, at 19.

132. Nichols Trial Record, *supra* note 67, at 102–03. See Suit for "Piracy" *supra* note 127.

133. Nichols Trial Record, *supra* note 67, at 108; See Says 'Abie's Irish Rose' Was Taken from Life, N.Y. Times, Dec. 22, 1928, at 9.

134. Nichols Trial Record, *supra* note 67, at 1339–1555; See "Abie" Not Unique, Professor Finds, N.Y. Times, Jan. 5, 1929, at 15.

135. Testifies 70 Works Have "Abie" Theme, NY Times, Jan. 6, 1929, at 16; "Abie" Not Unique, Professor Finds, N.Y. Times, Jan. 5, 1929, at 15.

136. See Nichols Trial Record, *supra* note 67, at 1339–1555.

137. Nichols Trial Record, *supra* note 67, at 183–1294. See "Abie's Irish Rose" Suit Invokes Dictionary, N.Y. Times, Jan. 4, 1929, at 14; "Abie's Rose" Read to Crowded Court, NY Times, Dec. 29, 1928, at 9; Emotion Valuation Issue in "Abie" Suit, NY Times, Jan. 3, 1929, at 33.

138. Appendix to Brief for Respondent Universal Pictures in opposition to certiorari, Nichols v. Universal, No 612, October Term 1930, filed Jan. 23, 1931, 83.

filed suit.¹³⁹ But what ate up most of the time was the testimony of so-called literary experts.

Plaintiff called the first expert: her lawyer, Moses Malevinsky. Malevinsky had written a couple of unsuccessful plays himself,¹⁴⁰ and had recently published a tome on “The Science of Playwriting.”¹⁴¹ Malevinsky argued that every play could be reduced to an algebraic formula, and that comparison of two plays' algebraic formulae would establish conclusively whether one of the plays infringed the other.¹⁴² Unfortunately for Anne Nichols, he decided to center the case he presented at trial around his theory.¹⁴³ Rather than focusing on the similarities in the expressive details of Nichols's play and MGM's film, Malevinsky sought to apply his theory to reduce the two works to their essences and compare the result¹⁴⁴. It is difficult to assess how much Malevinsky's arrogant, self-aggrandizing and flamboyant approach hurt Nichol's case at trial, but it seems safe to suggest that his behavior did not predispose Judge Goddard to rule in Nichols's favor.¹⁴⁵

Universal countered with the testimony of Columbia English Professor Harrison Steeves, who criticized Malevinsky's method and theory, and identified seventy literary works that reflected the elements that

139. Judge in Nichols Suit Sees Loveless Movie, NY Times, Jan. 11, 1929; Says 'Abie's Irish Rose' Was Taken from Life, N.Y. Times, Dec. 22, 1928. Nichols had filed suit in April of 1926, a few weeks after the theatrical release of *The Cohens and Kellys*. She sold *Abie's Irish Rose* to Famous Players-Lasky in January of 1927. See Brief for Appellee Universal Pictures Corp. in opposition to certiorari, *Nichols v. Universal*, No. 612 (filed Jan. 23, 1931). Paramount-Famous-Lasky released the movie version of *Abie's Irish Rose* on November 3, 1928, the month before Nichols's suit against Universal went to trial. Internet Movie Database, *Abie's Irish Rose*,

<http://www.imdb.com/title/tt0018613/> (last visited Apr. 10, 2015).

140. Moses L. Malevinsky & Dorothy Malevinsky, *A Man's Family: A Satiric Comedy-Drama in Three Acts* (1918), <http://www.archive.org/details/mansfamily00male>; Moses L. Malevinsky, *The Mill: A Drama in Four Acts* (1914), <http://www.archive.org/details/milldramainfoura00male>.

141. Moses L. Malevinsky, *The Science of Playwriting* (1925).

142. *Id.* at 38–42.

143. Complainant's Trial Brief on the Law and the facts, *Nichols v. Universal Pictures* (SDNY). See *Nichols Trial Record*, *supra* note 67, at 1680 (Pl. Ex.12).

144. See *Rose*, *supra* note 119, at 68–72, for a detailed account of Malevinsky's analysis.

145. An example of Mr. Malevinsky's combative style: You will recall that in the Second Circuit opinion, Judge Learned Hand explains that Nichols' characters are not copyrightable with a reference to the characters of Sir Toby Belch and Malvolio in *Twelfth Night*. See 45 F.2d at 121. As one of the grounds for Nichols's unsuccessful petition for certiorai, Malevinsky wrote the following:

The Circuit Court of Appeals probably erred in its opinion and decision for the reason that it is obvious from the opinion that said Court does not understand and is hopelessly at sea in respect to the laws of organic, dramatic construction in respect to a play or picture, evidenced by the reference made to two purely incidental characters, namely Malvolio and Toby in “TWELFTH NIGHT”, for as much as “TWELFTH NIGHT” obviously presents in its primary conflicts and organic dramaturgy, the comedy of love existing between Viola, Sebastian, her twin brother, the Duke of Orsino, and Olivia.

Nichols, 45 F. 2d at 119, petition for cert. filed, 51 S.Ct. 216 (Dec. 27, 1931) (No. 612). Mark Rose suggests that Malevinsky's pretentiousness also annoyed Judge Learned Hand in connection with the appeal to the Second Circuit. See *Rose*, *supra* note 119, at 73–74.

Nichols claimed were infringed by *The Cohens and Kellys*.¹⁴⁶ Malevinsky elected to cross-examine Steeves himself, apparently at some length.¹⁴⁷

Universal also offered testimony by the authors of three of the plays that Steeves had identified as resembling or anticipating *Abie's Irish Rose*.¹⁴⁸ Issac Levy, the author of *Krausmeyer's Alley*, testified that he had written his play two decades earlier, and had played the role of Krausmeyer himself and made a million dollars doing so. During the First World War, he had changed Krausmeyer from a German character to a Jewish character because of wartime prejudices, and called the second act “Levi's Christening” instead of “Krausmeyer's Christening.”¹⁴⁹ Milton Goldsmith, the author of a book titled *The Rabbi and the Priest*, which had been adapted into a play named *The Little Brother*, testified that his play had opened on Broadway in 1918 and played for twenty-two weeks.¹⁵⁰ Henry Doblin testified that he and Charles Dickson had coauthored *Joseph Lewis & Son*, which had been produced in New York in 1890, and revived under the title of *The Matchmaker* in 1915.¹⁵¹ Nichols's lawyers disputed the relevance of all of this testimony,¹⁵² but Universal responded that the evidence was probative of the scope of Nichol's copyright, and that Malevinsky had opened the door to evidence of the prior art by characterizing himself as a literary expert, and insisting that aspects of Nichol's play were new.¹⁵³

146. “Abie” Not Unique, Professor Finds, N.Y. Times, Jan. 5, 1929; Testifies 70 Works Have “Abie” Theme, N.Y. Times, Jan. 6, 1929; Says Krausmeyer Netted a Million, N.Y. Times, Jan. 9, 1929, at 27. Defense counsel referred to these works as “the prior art.” See Nichols Trial Record, *supra* note 67, at 1655.

147. Nichols Trial Record, *supra* note 67, at 1461–1553. See Says Krausmeyer Netted a Million, N.Y. Times, Jan. 9, 1929 (“Professor Steeves was cross-examined by Mr. Malevinsky himself, who questioned him on many points of his criticism”).

148. See Says Krausmeyer Netted a Million, N.Y. Times, Jan. 9, 1929 (describing testimony of Billy Watson, author of “Krausmeyer's Alley”); “Abie” Not Unique, Professor Finds, N.Y. Times, Jan. 5, 1929 (describing testimony of Henry Doblin, author of “Joe Lewis & Son,” and of Milton Goldsmith, author of “The Rabbi and the Priest”).

149. Nichols Trial Record, *supra* note 67, at 1327–38. See Says Krausmeyer Netted a Million, N.Y. Times, Jan. 9, 1929. Levy performed under the stage name “Billy Watson.” Calling *Krausmeyer's Alley* a play may be misleading. What probably alerted Universal to Levy's work was a short piece in the June 1924 issue of *The American Mercury* magazine by critic George Jean Nathan, which describes *Krausmeyer's Alley* as a burlesque sketch. Nathan writes that “[w]hat Anne Nichols has done in 'Abie's Irish Rose' is simply to elaborate the “Krausmeyer's Alley” sketch into a three act play and to doll it up a bit—a very small bit.” H.L. Mencken & George Jean Nathan, *Abie Krausmeyer's Irish Rose*, *American Mercury*, June 1924, at 185.

150. Nichols Trial Record, *supra* note 67, at 1324–27. See “Abie” Not Unique, Professor Finds, N.Y. Times, Jan. 5, 1929; Internet Broadway Database, *The Little Brother* (1918), <http://www.ibdb.com/production.php?id=6977> (last visited Apr. 10, 2015).

151. Nichols Trial Record, *supra* note 67, at 1320–24. See “Abie” Not Unique, Professor Finds, NY Times, Jan. 5, 1929; Testifies 70 Works Have “Abie” Theme, N.Y. Times, Jan. 6, 1929.

152. Brief on Behalf of Appellant Anne Nichols at 18–21, *Nichols v. Universal Pictures* (2d Cir.) [“Nichols's 2d Circuit Brief”].

153. Universal's 2d Circuit Brief, *supra* note 125, at 82–83.

After listening to the testimony, viewing a performance of Nichols play, watching the defendants' movie twice, watching the recently-released movie version of *Abie's Irish Rose*, and examining at least some of the earlier works defendant introduced into the record, Judge Goddard concluded that "The Cohens and Kellys' differs quite substantially in its themes, scenes, episodes, and expression of ideas, although both make use of common property, such as Jewish and Irish characters, marriage meeting with strong parental opposition, and final reconciliation."¹⁵⁴ Although he credited evidence tending to show copying in fact,¹⁵⁵ he was persuaded by the evidence of prior similar works that Anne Nichol's copyright did not extend to the material Universal copied:

The fundamental plot in "Abie's Irish Rose" is not new and is common property in the "public domain." The theme of the secret marriage, meeting parental opposition because of prejudice, racial or otherwise, with an Irish-Jewish background, is not new. A similar idea is found in a number of plays, including "Joseph Lewis & Son," copyrighted in 1890, where the father, an orthodox Jew, also has a son whom he wishes to take into his business, and whose predominating ambition is to have his son marry an orthodox Jewess, but who does marry a Gentile, and parental opposition is finally overcome by his love of progeny. "Krausemeyer's Alley" presents an Irishman and his son, and a Jew and his daughter, and the marriage of the girl and boy. Originally it was a German family and an Irish family, but during the war the German family was represented as a Jewish family. There is a strong opposition to the marriage on the part of both parents, because of their racial antipathy. Eventually there is a reconciliation upon the christening of a child which has been born to the young couple." "The Rabbi and the Priest," also known as "The Little Brother," was produced in 1918. The scenes in this play are laid in New York's East Side, and the father of the girl, Judith, is, like Solomon Levy, a widower deeply attached to his only child, and strongly opposed to his daughter marrying anyone but an orthodox Jew; but she falls in love with a devout young Catholic, they are married, each are disowned by their parents, but are subsequently reconciled after the birth of children.

Many of the ideas in these plays and in others, which have been examined, but which are unnecessary to refer to, are similar to those found in "Abie's Irish Rose."¹⁵⁶

Before continuing the story, it's worth taking a moment to note that Universal's litigation strategy had worked: Judge Goddard concluded that Nichols had no copyright in the aspects of her play that Universal had

154. 34 F.2d at 148-49.

155. Id. at 150.

156. Id. at 149.

copied, because earlier works that Nichols claimed she had never seen had also contained those aspects.¹⁵⁷

Nichols appealed to the Second Circuit,¹⁵⁸ which affirmed on the ground that *The Cohens and Kellys* was “too unlike” *Abie's Irish Rose* to be an infringement.¹⁵⁹ Judge Learned Hand wrote the famous opinion, included in all copyright casebooks as the quintessential formulation of the distinction between idea and expression:

It is of course essential to any protection of literary property, whether at common-law or under the statute, that the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations. That has never been the law, but, as soon as literal appropriation ceases to be the test, the whole matter is necessarily at large, so that, as was recently well said by a distinguished judge, the decisions cannot help much in a new case. . . . But when the plagiarist does not take out a block in situ, but an abstract of the whole, decision is more troublesome. Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the

157. Contrast Judge Learned Hand's opinion, handed down six years later, in *Sheldon v. Universal Pictures*, 81 F.2d 49 (2d Cir. 1936):

We are to remember that it makes no difference how far the play was anticipated by works in the public demesne which the plaintiffs did not use. The defendants appear not to recognize this, for they have filled the record with earlier instances of the same dramatic incidents and devices, as though, like a patent, a copyrighted work must be not only original, but new. . . . Borrowed the work must indeed not be, for a plagiarist is not himself pro tanto an "author"; but if by some magic a man who had never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an "author," and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's.

Sheldon involved another claim that the copyright in a script was infringed by a movie, but this movie included both spoken dialogue and a sung gaucho song.

158. The Record on Appeal included the script of *Abie's Irish Rose*, a print of *The Cohens and Kellys*, a second print of *The Cohens and Kellys* with the scenes between the lovers excised, detailed synopses of both works from both parties, diagrams of the alleged similarities and 658 still photographs from *The Cohens and Kellys*. See Universal's 2d Circuit Brief, *supra* note 125, at 15–16.

159. 45 F.2d at 119–20; See also *id.* at 122:

The only matter common to the two is a quarrel between a Jewish and an Irish father, the marriage of their children, the birth of grandchildren and a reconciliation.

If the defendant took so much from the plaintiff, it may well have been because her amazing success seemed to prove that this was a subject of enduring popularity. Even so, granting that the plaintiff's play was wholly original, and assuming that novelty is not essential to a copyright, there is no monopoly in such a background. Though the plaintiff discovered the vein, she could not keep it to herself, so defined, the theme was too generalized an abstraction from what she wrote. It was only a part of her "ideas."

Nor does she fare better as to her characters. It is indeed scarcely credible that she should not have been aware of those stock figures, the low comedy Jew and Irishman. The defendant has not taken from her more than their prototypes have contained for many decades. If so, obviously so to generalize her copyright, would allow her to cover what was not original with her. But we need not hold this as matter of fact, much as we might be justified. Even though we take it that she devised her figures out of her brain *de novo*, still the defendant was within its rights.

Three paragraphs later, Hand writes, “We assume further that, so far as it has been anticipated by earlier plays of which she knew nothing, that fact is immaterial.” But, of course, he doesn't mean it. He has, after all, just explained that defendant's copying of Nichols's characters isn't actionable because those details have characterized the low comedy Jew and Irishman for decades.

incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his "ideas," to which, apart from their expression, his property is never extended. ... Nobody has ever been able to fix that boundary, and nobody ever can. In some cases the question has been treated as though it were analogous to lifting a portion out of the copyrighted work ... but the analogy is not a good one, because, though the skeleton is a part of the body, it pervades and supports the whole. In such cases we are rather concerned with the line between expression and what is expressed.

Judge Hand doesn't tell us how to go about abstracting, but, once we concede that even deliberate copying will be excused if the similarities are too abstract, the result in the particular case should be unsurprising. Plaintiff wrote the script for a play. Defendant filmed a silent movie. There was no allegation that any of Nichols's dialogue appeared in the movie as titles or mimed speech.¹⁶⁰ Rather, Nichols claimed that Universal had copied her theme, her story, and her characters' emotions.¹⁶¹ A silent movie telling in pictures even a very similar story to that told by a play will show similarities only at some higher level of abstraction. By casting Nichols's case as one proved by similarities in the distilled essence of the two works, rather than in particular expressive details, Nichols's lawyers invited the conclusion that the works were similar only at too high a level of abstraction. Reading the *Nichols* opinion through 21st Century eyes, we imagine that we know just what Judge Hand is talking about. We understand Hand's reference to abstractions as a suggestion for other courts struggling with the idea/expression distinction rather than as a response to a claim a silent film infringed a stage play because the two works shared the same distilled essence.

Similarly, a 21st Century perspective on Judge Hand's complaint about the expert testimony at trial leads us to generalize, perhaps too far. Hand wrote:

We cannot approve the length of the record, which was due chiefly to the use of expert witnesses. Argument is argument whether in the box or at the bar, and its proper place is the last. The testimony of an expert upon such issues, especially his cross-examination, greatly extends the trial and contributes nothing which cannot be better heard after the evidence is all submitted. It ought not to be allowed at all; and while its admission is not a ground for reversal, it cumpers the case and tends to confusion, for the more the court is led into the intricacies of dramatic craftsmanship, the less likely it is to stand upon the firmer, if more naïve,

160. 34 F.2d at 147.

161. 45 F.2d at 122–23; 34 F.2d at 147–48; Nichols's 2d Circuit Brief, *supra* note 153, at 28–34.

ground of its considered impressions upon its own perusal. We hope that in this class of cases such evidence may in the future be entirely excluded, and the case confined to the actual issues; that is, whether the copyrighted work was original, and whether the defendant copied it, so far as the supposed infringement is identical.¹⁶²

That, we think, must be where the courts got the idea that infringing similarity should be assessed through the naïve eyes of an ordinary observer.¹⁶³ We don't appreciate that Judge Hand was complaining about a record containing thousands of pages of the testimony of supposed literary experts.

IV. THE END OF THE SILENT MOVIE ERA

Don Gabriel De Barbadillo's *Christ of the Alley* (1912) v. Samuel Goldwyn's *The Night of Love* (1927)

H.C. Witwer's *The Emancipation of Rodney* (1915) v. Harold Lloyd's *The Freshman* (1925)

In addition to struggling with what evidence was probative, courts during this period appear to have disagreed whether the purpose of analyzing the similarities in plaintiffs' and defendants' works was to ascertain whether defendant had copied its film from plaintiff's work, or to determine whether the similarities represented expression protected by plaintiff's copyright. Disputes over what elements of works were protected by copyright and what sorts of similarities counted as infringement pervaded the courts' analyses. Courts expressed a wide range of views on whether copyright protected only the elements of plaintiff's work that were new or novel, and the degree to which the existence of "prior art" might invalidate or limit copyright protection. They also struggled with what evidence might be probative on which issues. Courts then, as now, privileged words over images, and tended to see only that expression as they could reduce to verbal formulation.

Subsequent silent film infringement cases relied on similar determinations that asserted similarities between works written in words and silent motion pictures comprised only uncopyrightable material.

¹⁶² 45 F.2d at 123. What did the judge mean by "so far as the supposed infringement is identical"?

¹⁶³ See *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946); Dana Bullen, *The Role of Literary Experts in Plagiarism Trials*, 7 *Amer. U. L. Rev.* 55 (1958). Mark Lemley has criticized this approach to deciding infringement cases as "exactly backwards." Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 *J. Copyright Soc'y U.S.A.* 719, 736 (2009). The "ordinary observer" standard was well-established before *Nichols*. See, e.g., *Dymow v. Bolton*, 11 F.2d 690, 692 (1926); *Falk v. Donaldson*, 57 F. 32, 35 (C.C.S.D.N.Y. 1893); *Martinetti v. Macguire*, 16 F. Cas. 920 (C.C. Ca. 1867); Leon R. Yankwich, *Legal Protection of Ideas: A Judge's Approach*, 43 *Va. L. Rev.* 375 (1957).

Barbadillo v. Goldwyn,¹⁶⁴ for example, was a suit against Samuel Goldwyn's 1927 film, *The Night of Love*, by the Mexican coauthors of a miracle play. *Christ of the Alley, A Page of Thirteenth Century Spanish History*, written by Don Gabriel de Barbadillo and Phillis Waters de Barbadillo, featured the story of Don Pedro the Cruel of Castille.¹⁶⁵ A particular climatic scene had a young woman whom Don Pedro had wronged pausing on the way to her execution to pray to a statue of Jesus. In response to her prayer, the statue's hand miraculously detached and fell upon her head, which somehow facilitated her rescue.¹⁶⁶ The Barbadillos claimed to have submitted the script to Goldwyn in 1922.¹⁶⁷ They sued Goldwyn and screenwriter Lenore Coffee over a scene from *Night of Love* depicting an analogous miracle. In the movie, the heroine watched her lover about to be burned at the stake on the orders of an evil Spanish Duke, and prayed to a statue of the Virgin Mary. Inexplicably, the statue's robe fell into our heroine's hands. She donned the robe, impersonated the Virgin Mary, and when her condemned lover asked the Virgin to point to the truly guilty party, raised her hand to point to the evil duke. With the exception of the miracle scene and the historical Spanish setting the two works shared little in common. Lawyers for Goldwyn presented the court with a collection of works that showed, they insisted, that de Barbadillo's miracle scene was not original.¹⁶⁸ These works included a poem¹⁶⁹ and several histories of Spain.¹⁷⁰ The court described these works in some detail before announcing that it would assume that "plaintiffs' composition is copyrightable, and that it was not taken from common sources to the extent claimed by the defendants' counsel."¹⁷¹ Judge Sawtelle concluded:

I think there has been no proof of reproduction or appropriation by defendants of plaintiffs' composition, and that there are no real actionable similarities between plaintiffs' composition and the defendants' photoplay. This being so, there can be no infringement, and if there has been no infringement, it would seem unnecessary to consider

164. 42 F.2d 881 (S.D. Cal. 1930). Released in August, this California district court case was in fact decided before the Second Circuit's opinion in *Nichols*, which did not come down until November.

165. Don Pedro the Cruel appears to have ruled Castille from 1350 to 1369, which would make the miracle play a page of fourteenth century history. See Peter of Castille, Wikipedia, http://en.wikipedia.org/wiki/Peter_of_Castile (last visited Apr. 10, 2015). Perhaps the Barbadillos used different century-numbering conventions.

166. 42 F.2d at 882–83.

167. *Syracuse Herald*, May 20, 1928, at 48.

168. 42 F.2d at 883–84.

169. Jose Zorilla, *A Buen Juez, Mejor Testigo*, 1 *Obreas Poeticas Y Dramaticas* (1847). See 42 F.2d at 883–84.

170. 42 F.2d at 883–84. Judge Sawtelle cites Charles Morris, *Peter the Cruel and Free Companies*, in *Historical Tales* 156 (1908); and James A. Harrison, *History of Spain* 221 (1881) (citing Jean Froissart, *Chronicles*).

171. 42 F.2d at 885.

in this opinion the issue of common sources, common errors, and other questions discussed in the briefs. although I have given them careful consideration before reaching a conclusion in the case.¹⁷²

We know that trial judges and some appellate judges actually watched the accused movies, because their opinions say so. What we can't tell from reading the published decisions is whether the courts reached their determinations that similarities were or were not infringing on the basis of their comparison of the verbal summaries included in their opinions, or whether they decided the question based on their experience watching defendants' films and reading plaintiffs' scripts, novels and stories, but used the verbal summaries to explain and justify their decisions. My own, unverifiable, suspicion is that because judges were looking for similarities in plot and story, that is what they noticed, whether they were reading synopses, viewing the movies, or examining scripts or still photos. In any event, it turned out to matter whether judges saw their task as determining whether the similarities supported an inference of copying-in-fact or as ruling whether the similarities reflected copyright-protected expression. Where judges focused on similarities in order to ascertain whether defendant's film was in fact copied from plaintiff's play, story, or book, plaintiffs tended to win their suits; where instead, courts examined similarities to figure out whether they represented copyrightable material, defendants tended to prevail.

One of the last silent film infringement cases involved claims that Harold Lloyd's 1925 movie *The Freshman*¹⁷³ infringed the copyright in H. C. Witwer's 1915 story *The Emancipation of Rodney*.¹⁷⁴ Both works featured a college freshman who found popularity by playing and improbably winning an important college football game. Lloyd had apparently planned for some years to make a movie with football scenes. Witwer had met with Lloyd and pitched the story, but Lloyd claimed that although he had accepted the copy of the magazine, he had never read it. Lloyd testified that he had described the story, as Witwer had explained it, to the head of his scenario department, who dismissed it as unsuitable.¹⁷⁵ At trial, the judge read Witwer's story and watched Lloyd's film. "From a

172. Id. at 885–86.

173. THE FRESHMAN (Harold Lloyd Corp. 1925). See a ten minute clip from the film at <http://www.youtube.com/watch?v=yqq15HD1wMs> (last visited Apr. 10, 2015), or a 2013 trailer for a recently-restored version at <http://www.youtube.com/watch?v=1ntrhlDr8MU> (last visited Apr. 10, 2014).

174. Harry Charles Witwer, *The Emancipation of Rodney*, 38 Popular Magazine 5 (Nov. 20, 1915).

175. See Peter Decharney, *Hollywoods Copyright Wars: From Edison to the Internet* 76–84 (2012) for a detailed account of the case.

comparison of the two,” he concluded, “I am convinced that plaintiff’s charge of plagiarism is well-founded.”¹⁷⁶

A divided Court of Appeals for the 9th Circuit reversed. The majority opinion, running more than 100 pages, included detailed summaries of the plots of both story and film, copious quotation from the testimony given at trial, a detailed account of the differences between the story and the movie, and extensive quotation from legal treatises and earlier court decisions. The majority found the inference of copying drawn by the trial court from the similarities between the two works to be incredible,¹⁷⁷ and also concluded that an audience who read the story and then viewed the film would not conclude that Lloyd’s film was a dramatization of Witwer’s story.¹⁷⁸ The majority opinion expressed doubt that many of the similarities between the works were entitled to copyright protection.

In the case at bar, if it be assumed that there are such similarities between the story and the play as to provoke in the casual observer the consciousness that there is such a similarity between them, and that copying may be inferred therefrom, we are still confronted with the fact that mere similarity does not necessarily involve literary piracy or an infringement of a copyright. Such similarities then as exist would require further analysis to determine whether or not they are novel in the story and thus copyrightable. The copyright of a story only covers what

176. *Witwer v. Harold Lloyd Corp.*, 46 F.2d 792, 793 (S.D. Cal. 1930), rev’d 65 F.1 (9th Cir. 1933), cert. dismissed, 296 U.S. 69 (1933):

The first issue to be disposed of is that of infringement. The original story published in 1915 in the *Popular Magazine* was placed in evidence. The photoplay “The Freshman” was reproduced in the courtroom. From a comparison of the two, I am convinced that plaintiff’s charge of plagiarism is well founded. The features common to both are a country boy ambitious to be a popular athletic college hero. He is of nonathletic type. He practices college yells before a mirror in the privacy of his room. He has the college letter inscribed upon his sweater, and admires it in secrecy. He meets a girl to whom he tells exaggerated stories of his athletic prowess and who is sympathetic. He longs to be called by a familiar name. He studies the literature of athletics. In his actual athletic work he is pitifully weak. The coach in the one case and the upper class bully in the other are compared unfavorably with Simon Legree, the latter in one case being a “good samaritan” in comparison and in the other a “well mannered master.” He inspires in the students feelings ranging from contempt to grudging toleration. He is generously allowed to think himself a member of the college athletic team when in reality he is not a part of it. He enjoys the bliss of this deception for a brief period. Finally realizing that he is an object of ridicule and contempt, he resolves to throw away pretense and be his real self. The photograph picturing himself as an athletic hero is discarded. He decides that his only hope for athletic eminence and consequent popularity is to take part in the football game with his college’s traditional rival. The game is going badly against the home team. The team is reduced to the last available man. He grasps the coach in appeal and argument to be allowed to enter the play. He forces his way into the game. By an extremely unusual play he wins for the home team. The girl justifies her faith in him, in the one case telling his rival, “Didn’t I tell you Rod would do it?” and in the other to him, “I knew you could do it.” He is the hero of the hour, attains the coveted nickname, and naturally successful in his suit.

The foregoing is the substance or plot of the infringed and of the infringing production. One is the counterpart of the other. A comparison produces conviction that “The Freshman” is borrowed from “The Emancipation of Rodney” and the work of Witwer appropriated by the defendants.

177. 65 F.2d at 57–59.

178. *Id.* at 106–07.

is new and novel in it, so that the question of infringement involves a consideration of what is new and novel in the story to which the author has acquired a monopoly which has been misappropriated by another.¹⁷⁹

Assessing infringing similarity between different types of works, the majority remarked, was vexing:

There is still another question to be considered in dealing with the subject of copying a story in a play where the form of expressing ideas is not by repeating the words and forms of expression contained in the story, but where the expression of ideas is in the form of theme, scenes, and sequence of events shown by silent moving pictures.

The only thing in the play approximating a duplication of a scene in the story is that in which the hero argues with the coach in reference to participating in the final plays of the football game. In each case there is an argument, but the scene, considered independently from the story and the play merely as a scene or a subordinate sequence of events, is utterly commonplace and incapable of copyright monopoly. It is immaterial, therefore, whether or not there is copying.

Each case must be determined on its own facts, and much that has been said in the discussion with reference to similarities of theme, ideas, scenes, sequence of events, etc., is said with a view of laying a foundation for weighing the circumstantial evidence of copying derived from comparison. The difficulty of determining in this manner whether there has been copying when there is no copying of the text of a story or play is very great...¹⁸⁰

In the end, the combination of the absence of novelty in the story with the testimony that Lloyd never read the story and the implausibility that a great filmmaker like Harold Lloyd would steal an obscure short story rather than purchasing it persuaded the majority there was no infringement:

We are of opinion that such similarities as exist between the play and the story, and there are many, are such as require analysis and critical comparison in order to manifest themselves. The outstanding feature, the climax of both story and play, is the football game, with necessarily some similarity, but there is nothing new and novel in that other than the unusual participation of the heroes in their respective games, and on analysis these are neither identical nor similar in scene nor in conception of the two productions, but, if this be doubted, as was done by the trial court, then it is clear that there is no such similarity as overcomes the positive testimony that there was in fact no copying. The circumstantial evidence derived from comparison of the two productions is not forceful or weighty enough to overcome the direct and positive and persuasive evidence to the contrary ...¹⁸¹

District Judge McCormick, sitting by designation, began his 83 page dissenting opinion with his own account of the facts,¹⁸² followed by his

179. *Id.* at 89–90.

180. *Id.* at 104–05.

181. *Id.* at 107.

182. *Id.* at 113–26.

competing, lengthy summaries of the story and film,¹⁸³ and his tally of the many similarities between them.¹⁸⁴ The dissenting judge read the trial testimony differently from the majority, finding 'incriminating discrepancies' in Lloyd's account. He concluded that the trial court's determination of infringement should be affirmed:

The picture under consideration in this appeal does not merely take ideas from the story which would be permissive, and not infringement. ... It substantially copies concrete forms that were conceived, developed, arranged, and put into shape by Witwer to express the ideas of his story. This is nothing less than the appropriation of the intellectual product of Witwer which is the entity that is protected by copyright law. *Dymow v. Bolton* (C.C.A. 2) 11 F.(2d) 690. In other words, the literary property that is safeguarded from appropriation does not lie in the ideas per se that are expressed or diffused by literature, but in the particular form in which ideas are embodied in the work of an author when such form is novel and unique.¹⁸⁵

Thus, Judges Wilbur and Sawtelle found Witwer's story unimpressive and the allegation that Lloyd had copied it implausible. For Judge McCormick, the testimony that nobody in Lloyd's company had read the story seemed unbelievable, given the similarities between the two works. Once he concluded that the trial court had appropriately found copying, he insisted that the copied expression was within the scope of copyright protection. Although both the majority and the dissent cast their disagreement in terms of the copyright protection afforded to the similarities, the crux of their dispute appears to have been on the question of copying in fact. The majority believed that Lloyd had not copied Witwer's story; the dissent concluded that he or his employees had. Those conclusions shaped their competing accounts of similarity.

In 1927, *The Jazz Singer* premiered.¹⁸⁶ Talkies began to eclipse silent films by 1929. Readers who don't pay very close attention, though, will have a difficult time distinguishing the courts' analyses of infringement by silent movies from their treatment of infringement by movies with synchronized sound. As they ignored images to focus on plot in the teens and twenties, many courts ignored both images and dialogue to focus on plot in the 1930s and 1940s.¹⁸⁷ Ironically, though, as dialogue grew in

183. *Id.* at 127–51.

184. *Id.* at 152–57.

185. *Id.* at 157–58.

186. *The Jazz Singer* (Warner Brothers 1927).

187. *See, e.g., Sheldon v. MGM*, 81 F.2d 49 (2d Cir.), cert. denied, 298 U.S. 669 (1936); *O'Rourke v. RKO*, 44 F. Supp. 480 (D. Mass 1942); *De Montijo v. 20th Century Fox Film Corporation*, 40 F. Supp. 133 (S.D. Cal 1941). In *Dellar v. Samuel Goldwyn, Inc.*, 104 F. 2d 661 (2d Cir. 1939),

importance in movies, some courts began to consider the pictures as well as the words.¹⁸⁸ They gradually gave up on assessing the originality of plaintiffs' works by scrutinizing the alleged prior art. Courts stopped worrying about whether unauthorized motion pictures versions of books, plays and stories infringed the section 1(b) adaptation right or the section 1(d) public performance and exhibition right.

CONCLUSION

The 1976 Act's expression of exclusive rights in broad terms has saved modern courts the trouble of evading narrow specific boundaries, but left us with a confounding overlap between the reproduction right and the right to prepare derivative works. The breadth of evidence introduced in copyright infringement cases has narrowed significantly. The use of prior art to narrow the scope of copyright protection has morphed into the *scenes a faire* doctrine.¹⁸⁹ But courts remain confused by whether their comparisons of plaintiffs' and defendants' works should seek to resolve the question of copying in fact or determine whether extant similarities represent protected expression. They continue to disagree about what elements of copyrighted works are entitled to copyright protection. Even today, courts seem inclined to see words more clearly than pictures.¹⁹⁰

defendant submitted a synopsis of the allegedly infringing film and moved to dismiss the complaint on the basis of a comparison of the synopsis with plaintiff's play. The trial judge granted the motion, holding that even if defendant copied the play in every respect in which the play and the synopsis were similar, the copying of those elements was not infringement. Plaintiff appealed, arguing that it was improper to dismiss the complaint without even viewing the allegedly infringing film. The second circuit agreed that it was improper to dismiss the complaint without first ruling that the synopsis was a faithful account of the film. If it was, however, there was no need to actually watch the movie:

In the case at bar we see no reason why, if the "continuity" really is a reasonably fair synopsis of the film in words, the judge should see the film, though he may find it easier to test that issue by a direct view.

104 F. 2d at 662.

188. In *Stonesifer v. Twentieth Century Fox Film Corp.*, 48 F. Supp. 196 (S.D. Cal. 1942), aff'd 140 F.2d 579 (9th Cir. 1944), both the district court and the court of appeals examined the dialogue of both works, the furniture arrangement in both the stage set and the film, and the images that appeared on the screen, and found that the film infringed the play. In *Borden v. General Motors*, 28 F. Supp. 330 (S.D.N.Y. 1939), the authors of a book titled "How to Win a Sales Argument" sued General Motors over a training film for GM salesmen titled "Smooth Sale-ing." The court analyzed the language of the book and the settings and dialogue in the film before dismissing the case on the ground that the authors had assigned the copyright to a publisher and therefore lacked standing to sue. 28 F. Supp. at 334.

189. Judge Leon Yankwich first gave the *scenes a faire* doctrine its name in *Schwartz v. Universal Pictures*, 85 F. Supp. 270 (S.D. Cal 1945), a case claiming that a motion picture infringed the copyright in an unpublished manuscript.

190. See Tushnet, *supra* note 68.