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## COMMENTS

### Copyright Pre-emption and Character Values: The *Paladin* Case as an Extension of *Sears and Compco*

Victor DeCosta, a Rhode Island mechanic with a fourth-grade education, traveled through the western states as a youth, and as a result of his occasional jobs as a ranch-hand he developed a "passion for all things western." He subsequently returned to Rhode Island, but maintained his avocation by appearing in horse shows, rodeos, parades, and similar events. In his public appearances he dressed as a cowboy and gave fast-draw demonstrations; and, over the course of years he developed a costume consisting of black shirt and pants, flat-crowned black hat, a St. Mary's medal, and a moustache. He also adopted the nickname "Paladin," after "an onlooker of Italian descent had hurled an epithet at him containing the word 'Paladino.'" When DeCosta found out that the word "paladin" meant "champion of knights," he took the chess knight as his symbol and had it imprinted on business cards along with the slogan, "Have Gun, Will Travel—Wire Paladin, North Court Street, Cranston, Rhode Island." DeCosta distributed the cards and photographs of himself at personal appearances, placed quantities of them in commercial establishments, and eventually gave away over 250,000 of the business cards to the general public. Despite all of these activities, however, he never charged a fee or sold a product, but sought only the entertainment of his audiences.

Some ten years after DeCosta had developed the role of Paladin, the CBS television series "Have Gun, Will Travel" appeared. The hero of this series was also called Paladin, his costume was identical to DeCosta's, and he distributed similar business cards with San Francisco substituted for Cranston, Rhode Island. The series proved to be a great success and had grossed over fourteen million dollars by the time DeCosta brought a suit for damages in the United States District Court for the District of Rhode Island, based on three causes of action: misappropriation, trade or service mark infringement, and unfair competition. The trial court reserved judgment on the defendant's motion to dismiss as to the trademark and unfair competition claims and submitted the case to the jury on instructions that DeCosta would be entitled to a verdict if he established: (1) that he had created the original "idea and character of 'Paladin, Have Gun Will Travel'"; (2) that he had not abandoned it by publication;<sup>1</sup> and (3) that the defendants had copied the "character and idea" without permission.

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1. See text accompanying notes 49-51 *infra*.

The jury returned a \$150,000 verdict for the plaintiff,<sup>2</sup> but the Court of Appeals for the First Circuit reversed,<sup>3</sup> holding that a state-created grant of protection in these circumstances was foreclosed by the rule of federal pre-emption announced by the Supreme Court in *Sears, Roebuck & Co. v. Stiffel Co.*<sup>4</sup> and *Compco Corp. v. Day-Brite Lighting, Inc.*:

[W]hen an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy, found in Art. I, Section 8 of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.<sup>5</sup>

The Supreme Court subsequently refused to grant certiorari in *Columbia Broadcasting System, Inc. v. DeCosta (Paladin)*,<sup>6</sup> thus leaving unresolved the scope of the pre-emption doctrine enunciated in *Sears* and *Compco*.<sup>7</sup>

Much of the confusion over copyright pre-emption that has followed in the wake of *Sears* and *Compco* may be due to a fundamental difference between the present patent and copyright acts. Unlike the patent law that was at issue in *Sears* and *Compco*, the federal Copyright Act<sup>8</sup> provides that the states may in limited circumstances protect literary property through the doctrine of common-law copyright. Under section 2 of the Act, a state may prevent copying of a work so long as it remains "unpublished."<sup>9</sup> An alter-

2. The trial court decision was unreported.

3. *Columbia Broadcasting Sys., Inc. v. DeCosta*, 377 F.2d 315 (1st Cir. 1967) [hereinafter referred to as the principal case].

4. 376 U.S. 225 (1964).

5. 376 U.S. 234, 237 (1964). This language is quoted in the principal case at 319.

6. 36 U.S.L.W. 3242 (U.S. Dec. 12, 1967).

7. Courts have refused to apply pre-emption based on *Sears* and *Compco* in a wide variety of cases. See, e.g., *Servo Corp. v. General Elec. Co.*, 337 F.2d 716 (4th Cir. 1964), *cert. denied*, 383 U.S. 934 (1966); *Flexitized, Inc. v. National Flexitized Corp.*, 335 F.2d 774 (2d Cir. 1964), *cert. denied*, 380 U.S. 913 (1965) (unfair competition without showing of secondary meaning); *Pottstown Daily News Publishing Co. v. Pottstown Broadcasting Co.*, 247 F. Supp. 578 (E.D. Pa. 1965) (misappropriation of news stories); *Edgar H. Wood Associates v. Skene*, 347 Mass. 351, 197 N.E.2d 886 (1964) (common-law copyright); *Columbia Broadcasting Sys., Inc. v. Documentaries Unlimited, Inc.*, 42 Misc. 2d 723, 248 N.Y.S. 2d 809 (Sup. Ct. 1964) (misappropriation, "deceptive and fraudulent practices"); *Greater Recording Co. v. Stambler*, 144 U.S.P.Q. 547 (N.Y. Sup. Ct. 1965) ("record piracy"); *American Broadcasting Co. v. Button World Mfg., Inc.*, 151 U.S.P.Q. 361 (N.Y. Sup. Ct. 1966) (public deception liberally interpreted). *But cf.* *Cable Vision, Inc. v. KUTV, Inc.*, 335 F.2d 348 (9th Cir. 1964), *cert. denied*, 379 U.S. 989 (1965); *Flamingo Telefilm Sales, Inc. v. United Artists Corp.*, 22 App. Div. 2d 778, 254 N.Y.S.2d 36 (1964). See also Comment, *Copyright—The Law of Publication*, 35 U.M.K.C.L. REV. 158 (1967).

8. 17 U.S.C. chs. 1-3 (1964).

9. 17 U.S.C. § 2 (1964):

Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor.

native ground of decision in *Paladin* was that, regardless of pre-emption under *Sears* and *Compco*, DeCosta had divested himself of any potential common-law rights in his creation through the unrestricted distribution of calling cards and photographs. In so holding, the court apparently assumed that the question of whether a divestitive publication had occurred should be determined by federal standards. But the weight of judicial opinion, at least before *Sears* and *Compco*, supports the use of state standards to determine whether common-law rights have been divested.<sup>10</sup> There is some support for this position in the text of the Copyright Act itself: since section 2 of the Act refers to state laws of literary property, it should include the state definition of divestitive publication.<sup>11</sup>

However, this approach was frequently criticized by Judge Learned Hand, who feared that the fundamental policies of the copyright clause of the Constitution<sup>12</sup> could be subverted if the states were allowed to establish independent criteria for determining what acts constitute a publication sufficient to divest the author's common-law rights. Hand's conclusion follows from the nature of copyright. Any form of copyright, whether common law or statutory, is essentially a grant of monopoly power to prevent others from reproducing and exploiting the work.<sup>13</sup> By the Constitution, only Congress is empowered to create a monopoly in intellectual property;<sup>14</sup> and, because the copyright clause provides that writings may be protected only for "limited times," Congress has created the statutory copyright in return for a subsequent dedication of the work to the public domain upon expiration of the copyright.<sup>15</sup> Clearly, state protection of a work after expiration of the federal copyright could impair this scheme and undermine the policy of allowing later authors to draw freely upon plots, characters, and other material in the public domain.<sup>16</sup> Similar undesirable results could follow if the states are allowed to establish a liberal standard of publication,

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10. See generally Bender, *Product Simulation: A Right or a Wrong?*, 64 COLUM. L. REV. 1228 (1964); Nimmer, *Copyright Publication*, 56 COLUM. L. REV. 185 (1956).

11. Kalodner & Vance, *The Relation Between Federal and State Protection of Literary and Artistic Property*, 72 HARV. L. REV. 1079, 1094 (1959).

12. U.S. CONST., art. I, § 8, cl. 8: "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . ."

13. *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86, 88 (2d Cir.), cert. denied, 311 U.S. 712 (1940).

14. *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279, 280 (2d Cir. 1929). See also *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 667 (2d Cir. 1955) (dissenting opinion).

15. *G. Ricordi & Co. v. Haendler*, 194 F.2d 914 (2d Cir. 1952); *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86, 89 (1940).

16. *G. Ricordi & Co. v. Haendler*, 194 F.2d 914 (2d Cir. 1952). In *Sears* the Supreme Court observed that "[o]bviously a State could not, consistently with the Supremacy Clause of the Constitution, extend the life of a patent beyond its expiration date or give a patent on an article which lacked the level of invention required for federal patents." 376 U.S. at 231 (footnote omitted). But cf. Bender, *supra* note 10.

permitting substantial economic exploitation without divestment, for works that could be copyrighted under the federal Act. Since the monopoly granted under common-law copyright has no fixed duration it may be considered perpetual, and under a liberal standard of publication the creator would have little incentive to seek the limited-term protection of the Act.<sup>17</sup>

Nevertheless, the court in *Paladin* could have reached the opposite result as to divestitive publication, even under a federal standard. If the creation as a whole were characterized as a dramatic work, it could have been brought within the doctrine that a performance of a work does not divest the author of his common-law rights.<sup>18</sup> The central question would then have been whether *Paladin* is the kind of character that is entitled to copyright protection; and, the answer would have been found through tests formulated primarily to deal with the problem of character piracy in novels. The terms "well-developed"<sup>19</sup> and "individualized"<sup>20</sup> are often used to denote

17. Note, "Copyright" Protection for Uncopyrightables: The Common-Law Doctrines, 108 U. PA. L. REV. 699, 704-05 (1960). Because of the possibility of perpetual monopoly, it may be asked how any common-law copyright could be recognized under the "limited-times" provision of the Constitution. It has been suggested that a monopoly limited in use or ability to exploit by the concept of divestitive publication is the functional equivalent of a time limitation. Kalodner & Vance, *supra* note 11, at 1082-83. On the question of whether courts acting under common-law principles could limit their protection to the time provisions of the federal Act, compare *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279 (2d Cir. 1952), with Kaplan, *Performer's Right and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409, 419 (1956), and Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 487 (1955).

18. *Ferris v. Frohman*, 223 U.S. 424 (1912). For a more recent application of the doctrine, see *King v. Mister Maestro, Inc.*, 224 F. Supp. 101 (S.D.N.Y. 1963). See also M. NIMMER, COPYRIGHT § 53 (1967).

19. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931) (dictum).

20. *Burns v. Twentieth Century-Fox Film Corp.*, 75 F. Supp. 986 (D. Mass. 1948). Attempts at formulating a general definition of the "well-developed" character, however, have not been notably successful. The following definition is proposed in Parish, *Statutory Copyright Protection of Fictional Characters*, 8 IDEA 455, 456 (1964) (footnote omitted):

The multiple aspects of a fictional character include the outer or objective individual and the inner or subjective person . . . . The second grouping involves such intangibles as the content of philosophical attitudes and the emotional dynamics manifested by interpersonal relationships. These revelations of the psychological aspects of the character give the reader a key to the future actions and reactions of the figure.

. . . . A sensible dividing line on the sliding scale between a well-defined character and the stock figure is the ability of the reader to discover more about the character than, for example, his name.

Perhaps no more precise method of definition can be devised than the famous example given by Judge Learned Hand in *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931):

If *Twelfth Night* were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's "ideas" in the play, as little capable of monopoly as Einstein's Doctrine of Relativity or Darwin's theory of the Origin of Species.

the type of literary character that is protected against copying under the federal statute. One reason for these requirements is the rule that an unauthorized taking or copying must be substantial to warrant judicial relief; hence, the relation of a particular character to other elements of the work, such as plot and theme, must be considered.<sup>21</sup> If it is assumed that *Paladin* is a literary character, his paramount importance to DeCosta's total creation becomes obvious and would appear to support protection.

Another policy underlying the character-development test, however, presents more difficulty. It is a familiar maxim of copyright law that only the manner of expressing an idea, and not the abstract idea itself, can be protected from infringement.<sup>22</sup> The idea or "enlightenment" elements of a work have been described as "scientific formulations, factual information, and symbols of intelligible communication," while the expression or "skill" elements are "distinguished by their order, configuration, and form."<sup>23</sup> As applied to character creations, these standards dictate that the more unoriginal or shallow a character becomes, the more it approaches public property; the stock character is, in effect, a symbol of communication that should be available for use in a wide variety of stories and contexts. Undeniably, *Paladin* could be classified as a stock character. In charging the jury, the trial court referred to the "idea and character of 'Paladin Have Gun Will Travel,'"<sup>24</sup> while the court of appeals described the principal items of his costume and performance as "hallowed shelf items" and concluded that the creation was "so slight a thing as not to warrant protection under any law."<sup>25</sup>

Such an analysis, however, may not give full cognizance to all of the relevant interests at stake in a case like *Paladin*. More specifically, the fact that *Paladin* was created and subsequently used in visual media (live performance and television series) may demand a re-examination of the type of character that should be protected. Copyright protection has frequently been given to comic strip characters that could scarcely be called "well-developed,"<sup>26</sup> although

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21. It seems rather obvious that the quality of a character's delineation and his importance to the original work will always be questions of degree. Judicial utterances on the subject, however, are frequently phrased in terms of clear-cut dichotomies. Thus in *Warner Bros. Pictures, Inc. v. Columbia Broadcasting Sys., Inc.*, 216 F.2d 945, 950 (9th Cir. 1954), *cert. denied*, 348 U.S. 971 (1955), the court examined a variety of commercial and artistic customs and practices, but then set forth the following sweeping dictum: "It is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright."

22. *See, e.g.*, *Baker v. Selden*, 101 U.S. 99 (1879); *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967).

23. Spiegel, *Intellectual Productions: A Policy Orientation*, 36 S. CAL. L. REV. 500 (1963).

24. Principal case at 318.

25. *Id.* at 320-21.

26. *See, e.g.*, *Detective Comics v. Bruns Publications*, 111 F.2d 432 (2d Cir. 1940);

perhaps they could be considered somewhat individualized by virtue of their visual representation.<sup>27</sup> Moreover, a popular hero of a comic strip is usually its most important element, and any infringement of this character is quite likely to be a substantial taking. A similar situation exists in the television industry, where the basic entity is the continuing series that establishes continuity among individual shows through its major characters. Even when a television series is derived from a copyrighted book, it is quite unlikely that much else beyond the essential aspects of the principal characters and perhaps some features of the setting will be of any substantial value to the television producer.<sup>28</sup> Professor Kaplan has noted that the process of adapting a work for presentation in a different medium may require massive changes merely to achieve the same basic effect as the original, and he has concluded that present standards of infringement may not be adequate to cope with this situation.<sup>29</sup>

There seems to be little doubt that characters per se are extremely valuable for purposes of television; one commentator has even asserted that "[t]he fictional character today is perhaps the most important commodity in the entire field of entertainment in the United States."<sup>30</sup> Devices such as re-runs, the sequel series, and "spin-off" or transfer of a popular character into a different situation in a new series expand the use of the successful character,<sup>31</sup>

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King Features Syndicate v. Fleischer, 299 F. 533 (2d Cir. 1924). A collection of similar cases may be found in Waldheim, *Mickey Mouse—Trademark or Copyright?*, 54 TRADEMARK REP. 865 (1964). *But cf.* Archie Comic Publications v. American News Co., 204 Misc. 1060, 125 N.Y.S.2d 919 (Sup. Ct. 1953), *aff'd without opinion*, 129 N.Y.S. 2d 915 (1954).

27. M. NIMMER, COPYRIGHT § 30, at 135 (1967). Most of the comics cases can be distinguished from the principal case, however, because infringement of a comic strip usually involves the taking of some part of the literary context in addition to piracy of the character itself. In *Detective Comics v. Bruns Publications*, 111 F.2d 432 (2d Cir. 1940), the court compared the personal attributes and normal plot situations of the character "Superman" to those of the infringing "Wonderman," and concluded:

So far as the pictorial representations and verbal descriptions of "Superman" are not a mere delineation of a benevolent Hercules, but embody an arrangement of incidents and literary expressions original with the author, they are proper subjects of copyright and susceptible of infringement . . . .  
*Id.* at 433-34. The virtually complete absence of any literary context for the character Paladin would thus seem to preclude the grant of protection under a traditional copyright analysis.

28. Kellman, *The Legal Protection of Fictional Characters*, 25 BROOKLYN L. REV. 3, 4 (1958).

29. B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 57 (1967):

It is often thought necessary to make drastic changes of dialogue, action, and other elements in order to keep the picture faithful to the original [novel or play]. But if it is a matter of nice artistic judgment how much change is needed to attain "sameness" in the new medium, we can anticipate difficulties in deciding what is infringement. It is surely wrong to assume that what Hollywood is content to call a dramatization or screen treatment of a novel or play would necessarily be an infringing copy if not licensed. The fundamental that "use" is not the same thing as "infringement," that use short of infringement is to be encouraged, is relevant to these transformation cases.

*See also* Wincor, *The Seven Basic Program Properties*, 47 TRADEMARK REP. 440 (1957).

30. Kellman, *supra* note 28, at 3.

31. Parish, *supra* note 20.

as does the practice of character-merchandising for a tie-in to a variety of commercial products.<sup>32</sup> This latter possibility arose in the *Paladin* case, where network officials testified that they had placed a chess-knight symbol on the hero's holster with the thought of marketing it if the series proved popular.<sup>33</sup> Significantly, it has been suggested that the type of character that gives rise to such great commercial value is not truly "well-developed" in the manner of a Shakespearian tragic hero but is in truth only slightly removed from the stereotype in terms of character depth.<sup>34</sup> DeCosta thus seems to have created the most valuable kind of television character and for that reason can assert at least a strong moral claim for legal protection.

However, a policy counterweight favors the network in *Paladin*. The behavior of an alleged infringer is relevant to the copyright function of fostering creativity. The copyist who merely duplicates by mechanical means is certainly less of a creator than one who seeks to imitate what the first author has done and thus should have less of a shield than the imitator.<sup>35</sup> Similarly, one commentator has discerned in the case law a judicial tendency to balance the first author's originality against the creative quality of the imitative use, along with a greater reluctance to protect the "ideas" of the first work if it is relatively commonplace in comparison to a more innovative achievement.<sup>36</sup> On a more practical level, the question of the value of the work taken may be incapable of rational determination where it does not have an identifiable market value, and the imitator has liberally embellished the work, embodied it in a different medium, and then disseminated it.<sup>37</sup> Certainly there would be a large element of speculation in any attempt to decide how much of the success of the series "Have Gun, Will Travel" was due to the inherent appeal of the major character, and how much was due to the plots, cast, and technical and commercial refinements added by the network.

Notwithstanding these analytical difficulties, the equities of a given case may move a court to stretch copyright doctrine and grant protection to works that would fall within the ban on monopolies for abstract ideas. Thus protection was accorded to a basic

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32. It has been estimated that the cartoon characters Mickey Mouse and Donald Duck have been associated with the sale of merchandise valued in excess of a billion dollars. Waldheim, *supra* note 26.

33. Principal case at 317.

34. Wincor, *supra* note 29.

35. Comment, *The Twilight Zone: Meanderings in the Area of Performers' Rights*, 9 U.C.L.A.L. REV. 819, 823 (1962). See also Netterville, *Copyright and Tort Aspects of Parody, Mimicry, and Humorous Commentary*, 35 S. CAL. L. REV. 225, 253 (1962).

36. Whicher, *The Ghost of Donaldson v. Beckett: An Inquiry Into the Constitutional Distribution of Powers Over the Law of Literary Property in the United States*, 9 BULL. COPYRIGHT SOC'Y 102, 124-25 (1961).

37. Cf. Havighurst, *The Right to Compensation for an Idea*, 49 NW. U.L. REV. 295, 299-300 (1954).



story idea<sup>38</sup> in *Golding v. R.K.O. Pictures*,<sup>39</sup> an action that was brought under the California intellectual property statute<sup>40</sup> and which involved facts similar to the *Paladin* case.<sup>41</sup> The plaintiff had submitted a play to a motion picture studio, and when the play later appeared in an unauthorized motion picture version, it was extensively modified. The plaintiff sought to avoid the difficult question of the substantiality of the appropriation by asserting that the only thing really valuable or original in his play was the "central dramatic situation" involving the character of a tyrannical ship's captain. In the light of testimony that the studio story editor customarily prepared brief summaries of scripts and plots presented to him, from which the management decided whether or not a given picture should be produced, the court accepted the plaintiff's argument that the "basic dramatic core" of the play should be protected, noting that "the real value of a story or play may have little to do with specific dialogues or sequences of scenes or locale . . ." <sup>42</sup> However, the *Golding* case was subsequently criticized for exceeding the bounds of common-law copyright,<sup>43</sup> and later cases in the jurisdiction have avoided the difficult problem of determining when a property right should attach to anything which falls short of generally accepted definitions of literary property.<sup>44</sup>

Clearly, the possibility of a monopoly in an entity as sweeping as a tyrannical ship's captain seems inimical to the copyright policy of free access to ideas in the public domain, regardless of the economic damage that the creator may have suffered. Yet the frequent inability of traditional copyright analysis to isolate the truly valuable elements of a work adapted to a different medium has often led wronged creators to invoke a variety of other legal theories in

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38. On the protection of ideas generally, see Callmann, *Unfair Competition in Ideas and Titles*, 42 CALIF. L. REV. 77 (1954); Havighurst, *supra* note 37; Nimmer, *The Law of Ideas*, 27 S. CAL. L. REV. 119 (1954); Warner, *Legal Protection of Program Ideas*, 36 VA. L. REV. 289 (1950).

39. 35 Cal. 2d 690, 221 P.2d 95 (1950). See also *Kovacs v. Mutual Broadcasting Sys.*, 99 Cal. App. 2d 56, 221 P.2d 108 (1950).

40. CAL. CIV. CODE § 980(a) (West 1954):

The author or proprietor of any composition in letters or art has an exclusive ownership in the representation or expression thereof as against all persons except one who originally and independently creates the same or a similar composition.

41. The principal case is factually distinguishable from *Golding* because DeCosta never submitted his creation to the network, thus precluding the use of theories of contract implied in fact or law; however, the *Golding* court did not rely heavily on the fact of submission.

42. 35 Cal. 2d at 697, 221 P.2d at 98-99.

43. *Weitzenkorn v. Lesser*, 40 Cal. 2d 778, 256 P.2d 947 (1953).

44. *Desny v. Wilder*, 46 Cal. 2d 715, 299 P.2d 257, 263 (1956):

It may be that plaintiff's concessions and arguments . . . are intended to suggest that there is some nebulous middle area between an abstract idea and a literary composition, wherein the idea has been cast in "concrete" form but not "concrete" enough to constitute a literary property. . . . However, for the purposes of this case at least, we find it unnecessary and undesirable to recognize any such hybrid . . . .

support of their claims. Prominent among these related doctrines are misappropriation and unfair competition, and, to a lesser extent, trademark infringement.<sup>45</sup> All of these theories were at issue in the *Paladin* case, although only the misappropriation claim was submitted to the jury; each raises different questions from the standpoint of copyright pre-emption.

The doctrine of misappropriation<sup>46</sup> originated in the leading case of *International News Service v. The Associated Press*,<sup>47</sup> where the Supreme Court used principles of unfair competition to prevent International News Service (INS) from using news dispatches pirated from bulletin boards and early editions of Associated Press subscribers. The protectible interest, called "quasi-property,"<sup>48</sup> existed only between the two competing news services and did not relate to the general public's right to use any of the news stories.

From this beginning, misappropriation has expanded to encompass a variety of commercial wrongs; indeed, in its present scope it has been described as the "virtual equivalent of a copyright"<sup>49</sup> and "copyright protection under another name."<sup>50</sup> The *Paladin* case illustrates this doctrinal overlap. In charging the jury on the misappropriation claim, the trial court required DeCosta to show that he had not divested his potential common-law rights through publication; but the *INS* case in no way implies that copyright tests for divestitive publication should be applied to a misappropriation action.<sup>51</sup>

The factual circumstances existing in the *Paladin* case, however, are rather far removed from the peculiar conditions that moved the Supreme Court to create the doctrine of misappropriation. The Associated Press had invested considerable capital in establishing its news-gathering network, and this socially valuable organization was threat-

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45. For a discussion of the theory that undeveloped characters resemble trademarks, see generally Waldheim, *Characters—May They Be Kidnapped?*, 12 BULL. COPYRIGHT SOC'Y 210, 217 (1965); Wincor, *supra* note 29; Note, *The Protection Afforded Literary and Cartoon Characters Through Trademark, Unfair Competition, and Copyright*, 68 HARV. L. REV. 349 (1954).

46. Developments in the Law, *Competitive Torts*, 77 HARV. L. REV. 888, 932 (1964):

Misappropriation, which shares with passing off the general label of unfair competition, is one of several legal doctrines concerning protection of intangibles of potential commercial value. These intangibles include ideas, information, formulas, designs and artistic creations, fame, goodwill, and performances of talent . . . Misappropriation consists not in taking the physical object [in which the intangible is embodied] but in copying or drawing upon the conception or underlying intangible value for the use of the appropriator.

47. 248 U.S. 215 (1918).

48. *Id.* at 236.

49. Comment, *Literary Titles—Copyrightable or Trademarkable*, 11 VILL. L. REV. 796, 813 (1966). See also Note, *supra* note 17, at 710 (1960).

50. H.R. REP. NO. 2237, 89th Cong., 2d Sess. 129 (1966).

51. In his dissent in *INS*, Justice Brandeis objected to the recognition of a doctrine that afforded protection to intellectual property without being limited by the concept of divestitive publication. 248 U.S. at 254-56.

ened with destruction by the rival service's appropriation of news releases. When misappropriation is invoked to prevent the copying of a creative work like *Paladin*, on the other hand, the state's principal interest seems to be the protection of its creators from unauthorized exploitation of their works. In this situation, it may be argued that copyright is the only proper method of rewarding the creator's "sweat of the brow" and protecting his pecuniary interests. Misappropriation analysis often fails to reach the crucial question of what impact a grant of protection will have upon the copyright policy of maintaining an expansive public domain; and, in any event, the state's interest in preventing the copying or use of a creative work should not be sufficient justification for using rather vague concepts of commercial morality to frustrate federal policies and carve monopolies out of the public domain.<sup>52</sup>

The results are undeniably harsh when the creator has struck upon a valuable commodity like *Paladin*; but, as Justice Holmes noted in his concurrence in *INS*, a property right does not arise from value alone: "Property depends upon exclusion by law from interference, and a person is not prohibited from using any combination of words merely because someone has used it before, even if it took labor and genius to make it."<sup>53</sup> Thus, the First Circuit had a sound basis in logic and policy, if not in authority,<sup>54</sup> for holding that *Sears* and *Compco* precluded the use of misappropriation doctrine to protect a creative work like *Paladin*.

Unfair competition, however, is somewhat more difficult to fit into the pre-emptive framework. In the usual unfair competition situation, the defendant is a competitor who is trying to "pass off" his product as the plaintiff's and trade on the good will that the plaintiff has established.<sup>55</sup> Thus the doctrine of unfair competition

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52. Developments in the Law, *supra* note 46, at 936: "Justice Pitney's image in *INS* of one who 'reaps where he has not sown' has become a watchword in the misappropriation vocabulary. However, a moral evaluation of the defendant's behavior seems an unsuitable analytical tool for discriminating between intangibles that should be protected and those that should not . . ."

53. 248 U.S. at 246. Of course, if the legal system becomes too oblivious to commercial mores the result may be a loss of control over the market in question. In this regard, an analogy may be drawn to the related problem of literary titles, which are generally regarded as unprotectible because of the dangers of creating monopolies in words and phrases. This policy of legal nonintervention seems to have led to the creation of extra-legal remedies for the motion picture industry, through a Title Registration Bureau with industry sanctions for violators. *Netterville & Hirsch, Piracy and Privilege in Literary Titles*, 32 S. CAL. L. REV. 101, 110 (1959). See also *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, 187 P.2d 474 (1947); *Klein, Is Unauthorized Use of Titles of Artistic Works in Unrelated Fields Actionable Piracy?*, 28 BROOKLYN L. REV. 59 (1961); Comment, *supra* note 49.

54. Several cases have held that the doctrine of misappropriation is unaffected by the *Sears* and *Compco* decisions. See, e.g., *Pottstown Daily News Publishing Co. v. Pottstown Broadcasting Co.*, 247 F. Supp. 578 (E.D. Pa. 1965); *Greater Recording Co., Inc. v. Stambler*, 144 U.S.P.Q. 547 (N.Y. Sup. Ct. 1965); *Capitol Records v. Greatest Records*, 43 Misc. 2d 878, 252 N.Y.S.2d 553 (Sup. Ct. 1964).

55. Doctrines of unfair competition have been extended to remedy a variety of

seems doubly irrelevant to the facts of the *Paladin* case, first because DeCosta did not seek any profits from his idea until the television show appeared, and second because it seems particularly unlikely that CBS through its nationwide telecasts was attempting to trade on the relatively small amount of good will generated by DeCosta in his personal appearances. But it has been held that lack of competition because of use in a different medium will not be fatal to the plaintiff's claim, since "it is the injury to the author and a fraud upon the . . . public that constitute the real offense alleged."<sup>56</sup> A basic element of the injury to the creator in the case of character infringement may result from the fact that the general public's appetite for a particular character is easily satiated, regardless of the medium through which the imitator exploits the character; the creator's market, both actual and potential, may be spoiled by indiscriminate reproduction.<sup>57</sup> In essence, this rationale appears to be a circuitous assertion that there is always competition among characters for the available audience, irrespective of whether they are written, performed, drawn, or filmed characters.

Even if it be assumed that there is a kind of derivative competition among characters like *Paladin*, a precise description of the kind of public deception that is likely to ensue remains rather speculative. In this area unfair competition and trademark analyses may coalesce, if one accepts the theory that a trademark should function primarily to identify the source of products and services.<sup>58</sup> Either doctrine, however, also creates a decided economic benefit in the proprietor of a character, giving him effective protection against copying. Danger of substantial public confusion might justify the monopoly, but little is known about the manner in which public identification of

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commercial wrongs, and a recent commentator has concluded that "[b]ecause there is no clear concept of unfair competition, there is no clear theory of unfair competition." 1 R. CALLMANN, *THE LAW OF UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 4.1 (3d ed. 1967). In *Schechter Poultry Corp. v. United States*, 295 U.S. 495, 531-32 (1935), Justice Hughes stated:

"Unfair competition," as known to the common law, is a limited concept. Primarily, and strictly, it relates to the palming off of one's goods as those of a rival trader . . . . In recent years, its scope has been extended. It has been held to apply to misappropriation as well as misrepresentation . . . . Unfairness in competition has been predicated of acts which lie outside the ordinary course of business and are tainted by fraud, or coercion, or conduct otherwise prohibited by law. [Footnote omitted]

See generally *Developments in the Law*, *supra* note 46, at 908-23.

56. *Prouty v. National Broadcasting Co.*, 26 F. Supp. 265, 266 (D. Mass. 1939).

57. *Lone Ranger, Inc. v. Cox*, 124 F.2d 650 (4th Cir. 1942); Note, *supra* note 45, at 353; Note, *supra* note 17, at 712. See also *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 101 N.Y.S.2d 483 (Sup. Ct. 1950), *aff'd per curiam*, 107 N.Y.S.2d 795 (1951); *Waring v. WDAS Broadcasting Station, Inc.*, 327 Pa. 433, 194 A. 631 (1937).

58. Arnold, *A Philosophy on the Protections Afforded by Patent, Trademark, Copyright and Unfair Competition Law: The Sources and Nature of Product Simulation Law*, 7 P.E.A.L.Q. 30, 48-50 (1967); Note, *supra* note 45.

source applies to character creations.<sup>59</sup> When both the original character and the infringing work appear in a pictorial medium such as comic strips, it may be argued that public deception will be negligible because the inherent appeal or value of the creation will be immediately self-evident, and the reader will not care about its source.<sup>60</sup> But a rather different line of authority has developed in the context of live performances and movies when an actor has evolved a distinctive character-type in repeated performances.<sup>61</sup> In this situation the performer is also the sole creator, and public identification may be directed toward him any time that the character is used in advertising. The fact of repeated performance also indicates that the character has become popular enough to attract a public following, thus increasing the likelihood of deception. But the *Paladin* court evidently felt that DeCosta had not attained this status, concluding that "[a]t some point his innate talent and eclectic poaching may enable him to attract a following, and ultimately to secure the law's protection against imitators."<sup>62</sup> This strict construction of the public deception test is also consistent with the approach taken in *Sears and Compco*, where the Supreme Court carefully scrutinized the record for evidence of the nature and extent of such confusion and then ruled that even when clear evidence of confusion is found the state may impose only the requirement that copies be labeled to indicate their source.

This encroachment of commercial and other torts into the outer reaches of the copyright area thus causes a variety of problems that may not be answered by the narrow holding of the *Sears and Compco* decisions,<sup>63</sup> for, as the doctrines range farther afield from copyright

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59. It has been suggested that a single transaction involving a product decorated with the picture of a cartoon character may be categorized either as a trademark use, a copyright use, or a combination of both. Waldheim, *supra* note 26, at 866-67.

60. This was the position taken by Judge Learned Hand in *National Comics Publications v. Fawcett Publications*, 191 F.2d 594, 603 (2d Cir. 1951) (copying of comic books):

In the case of these silly pictures nobody cares who is the producer—least of all, children who are the chief readers—; the "strips" sell because they amuse and please, and they amuse and please because they are what they are, not because they come from "Detective."

61. The performer who has developed a distinctive character may be viewed as one end of a continuum that extends at the opposite extreme to the performer who is merely acting out a role previously created by someone else. Even in the latter situation it has been argued that the creative performer is making a valuable contribution to society and should be rewarded by copyright protection. *Waring v. WDAS Broadcasting Station, Inc.*, 327 Pa. 433, 194 A. 631 (1937); Comment, *supra* note 35. But the weight of authority concludes that the performer of a pre-existing role has an interest too ephemeral to merit protection; *see, e.g.*, *Supreme Records, Inc. v. Decca Records, Inc.*, 90 F. Supp. 904, 908 (S.D. Calif. 1950). It would seem that the interpretational techniques of the performer of a pre-existing role should be regarded as a kind of universal language of the theater that should be freely available for subsequent performers to apply to other works. *Cf. O'Brien v. Chappel & Co.*, 159 F. Supp. 58 (S.D.N.Y. 1958).

62. Principal case at 320.

63. It has been argued that the references to copyright in *Sears and Compco* were

analysis, they begin to include diverse state interests—such as protection against deception of the public, breaches of confidential relationships, and emotional harm to individuals—as elements of the cause of action. Moreover, classes of works that could have been given statutory protection under Congress' copyright power, but which are outside the ambit of the present Act, are frequent candidates for state protection. Paladin is an excellent example of this type of creation, if he is considered a "pure" character, independent of any underlying work. The First Circuit felt that Congress could easily devise a system for registering character creations and implied from Congress' refusal to do so a policy of free use and dissemination of characters.<sup>64</sup> But few post-*Sears* cases have followed this line of reasoning, and the impact of *Sears* and *Compco* on this area of "unused" copyright power is proving to be quite a fertile battleground.<sup>65</sup>

It has been suggested that the courts should be allowed to interpret the congressional silence and to determine on an ad hoc basis whether the grant of protection to a given kind of work would be inimical to the federal statutory scheme.<sup>66</sup> Indeed, the whole trend toward greater use of copyright-related doctrines may be viewed as a creative and commendable judicial response to the inadequacies of the federal Act:

The bric-a-brac coverage of the copyright, trademark, and patent laws fail[s] time and again to provide for the situation. Of course, the failure of the statute would be a potent ground for nonprotection if, in truth, the copyright act was a "delicate and elaborate" preemptive structure. But there is the nagging feeling that the reason for nonprotection isn't a careful balancing on the part of Congress; rather, it is the inability of the legislators to resolve incredibly difficult problem which strike at the heart of the copyright structure . . . . The judge is faced with the type of piracy which the Constitution probably meant for Congressional action. But Congress has been unable to act.<sup>67</sup>

Under this approach, not even the passage of a revised Copyright Act would justify total pre-emption, since there is an inherent lag in congressional response as new media and art forms develop.<sup>68</sup>

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*obiter dicta*, Pottstown Daily News Publishing Co. v. Pottstown Broadcasting Co., 247 F. Supp. 578, 589 (E.D. Pa. 1965), or were included because of the remote possibility that the designs of the industrial articles in question could have been copyrighted. Kestenbaum, *The Sears and Compco Cases: A Federal Right to Compete by Copying*, 51 A.B.A.J. 935, 938 (1965). These arguments hardly seem persuasive.

64. 377 F.2d at 319.

65. See cases cited in note 7 *supra*.

66. Bender, *Product Simulation: A Right or a Wrong?*, 64 COLUM. L. REV. 1228, 1238 (1964).

67. Price, *The Moral Judge and the Copyright Statute: The Problem of Stiffel and Compco*, 14 COPYRIGHT L. SYM. 91, 113 (1966).

68. *Id.* at 116-17.

This theory of partial pre-emption with interstitial state protection raises several practical and conceptual problems. Even after *Sears* and *Compco*, it is a rare court that will conclude that a particular grant of protection is inimical to the policies of the Copyright Act. An inevitable consequence of granting this kind of discretion to the courts is inconsistency of result; yet the need for a nationally uniform copyright law was asserted by Madison in *Federalist No. 43*.<sup>69</sup> If uniformity was desirable in Madison's day, it is particularly compelling in an era of mass media,<sup>70</sup> when choice of law problems can become complex to the point of insolubility<sup>71</sup> and the most protective state standard may attain extraterritorial effect in application to national broadcasts. Moreover, there is scant likelihood that individual decisions will be correct in assessing the multifarious conflicting interests involved, since courts "must judge upon records prepared by litigants, which . . . cannot disclose the conditions of [the particular] industry, or of the others which may be involved."<sup>72</sup> Grants of unlimited monopoly protection will almost necessarily subvert the federal policy of forcing creators to seek the limited protection of the Act; the result would be that "[o]mission of property from the act would be a bonanza for those who possessed property of that kind."<sup>73</sup> The conclusion that pre-emption should extend to all classes of works not encompassed by the federal Copyright Act also draws support from the nature of the copyright power itself, for "[c]opyright, unlike commerce, is a narrow field where the presence of a compendious statute quite naturally invites the inference that rights are not to be created de hors the statute."<sup>74</sup>

For works within the confines of the granted copyright power, yet not within the ambit of the Act, this broad a doctrine of statutory pre-emption is coextensive with the doctrine of constitutional pre-emption that Judge Learned Hand advocated when he said that the copyright clause acts *ex proprio vigore* as a limit on both the states and the federal courts.<sup>75</sup> The *Sears* and *Compco* opinions, though somewhat ambiguous, may be interpreted as expounding a constitu-

69. THE FEDERALIST NO. 43, at 338 (Hamilton ed., 1868).

70. See generally Posner, *State and Federal Power in Patent and Copyright*, 14 COPYRIGHT L. SYM. 51, 70-74 (1966).

71. The court in the principal case noted the problem, observing that "[c]ounsel's failure to address it in their briefs is a tribute to its perplexity." Principal case at 319 n.7. For a discussion of the conflicts theories that have been used when privacy is invaded by the mass media, see *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481, 484-85, 493-95 (3d Cir. 1956), *cert. denied*, 351 U.S. 926 (1956); Ludwig, "Peace of Mind" in 48 Pieces Vs. Uniform Right of Privacy, 32 MINN. L. REV. 734, 759-62 (1948).

72. *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279, 281 (2d Cir. 1929).

73. *Fashion Originators Guild v. FTC*, 114 F.2d 80, 83 (2d Cir. 1940), *aff'd*, 312 U.S. 457 (1941).

74. Kaplan, *Performer's Right and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409, 430 (1956).

75. *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 667 (2d Cir. 1955) (dissenting opinion).

tional doctrine of pre-emption since they purported to base the exclusiveness of federal power on the patent and copyright system, which logically would include both the federal Act and the constitutional clause. In addition, Justice Black, the author of the *Sears and Roebuck* opinions, later cited those decisions in his dissent to *Aro Manufacturing Co. v. Convertible Top Replacement Co.* as authority for the proposition that there is a "constitutional plan of a competitive economy."<sup>76</sup>

Thus, either a broad statutory or a constitutional theory of pre-emption would extend to all kinds of creative works within the scope of Congress' power; but the minimum conditions that must be met before Congress' copyright power becomes operative have never been defined with certainty. In addition to the provision that protection be given for limited times, the portions of the copyright clause that may serve as limitations on the power conferred are the introductory phrase "to promote the progress of science and the useful arts" and the words "authors" and "writings." The key factor commonly extracted from the policy of promoting science and the arts and from the inclusion of the word "authors" has been described as "independent creation"<sup>77</sup> or "originality"<sup>78</sup> and probably does not include such additional requirements as novelty, ingenuity, or esthetic merit.<sup>79</sup> The term "writings" has similarly received a broad interpretation and is currently regarded as encompassing any expression of intellectual creation that is embodied in a tangible medium<sup>80</sup> so that it is capable of being reproduced.

Even this broad a doctrine of pre-emption, however, may not be sufficient to dispose of the *Paladin* case. DeCosta argued that Congress could not enact copyright protection for the character *Paladin*. Presumably the argument was based on the premise that the calling cards did not embody the essence of his creation; hence, disseminating them did not dedicate all of his rights in the character *Paladin*, and the state should be free to regulate the remainder as a "non-writing."<sup>81</sup> Clearly, no theory of *statutory* pre-emption, however extensive, could prevent state regulation if *Paladin* was in fact beyond the reach of the copyright power granted to Congress by the Constitution.

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76. 377 U.S. 476, 522 (1964).

77. Kalodner & Vance, *The Relation Between Federal and State Protection of Literary and Artistic Property*, 72 HARV. L. REV. 1079, 1086 (1959).

78. M. NIMMER, COPYRIGHT §§ 3.2, 6 (1967). See also *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967).

79. This is the premise of the House Judiciary Committee's Report on the Proposed Copyright Act Revision. H.R. REP. NO. 2237, 89th Cong., 2d Sess. 42-43 (1966).

80. M. NIMMER, COPYRIGHT § 8.2 (1967). But cf. Note, *Copyright—Study of the Term "Writings" in the Copyright Clause of the Constitution*, 31 N.Y.U.L. REV. 1263 (1956).

81. Compare the passing remark by Judge Learned Hand in his dissent to *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 667 (2d Cir. 1955), to the effect that the states "of course" have the power to protect "'works' that are not 'Writings.'"



To this contention the First Circuit responded that "there comes a point when what is created is so slight a thing as not to warrant protection by any law" and then stated:

[I]n view of the federal policy of encouraging intellectual creation by granting a limited monopoly at best, we think it sensible to say that the constitutional clause extends to any concrete, describable intellectual creation; and to the extent that a creation may be ineffable, we think it ineligible for protection against copying *simpliciter* under either state or federal law.<sup>82</sup>

The quoted passage seems to indicate that the copyright clause may have a pre-emptive effect beyond the confines of the granted copyright power itself. And, although it is obvious that state power must become exclusive at some point where a given entity ceases to resemble the type of creative work that copyright protects, there may be sound reasons for setting this threshold beyond the inception of the congressional power. In terms of *Sears* and *Compco*, there is at least a close parallel between saying that a state cannot prevent copying of a mechanical article so lacking in invention that it cannot be protected under the patent power, and saying that the states cannot prevent copying of a work that is so lacking in originality or tangible expression that it is ineligible for protection under the copyright power.<sup>83</sup>

The concept of pre-emption beyond the area of power granted to Congress by the copyright clause is perhaps most immediately relevant to the large gray area where copyright-based doctrines of literary property and performers' rights verge imperceptibly into the tort of invasion of privacy. An examination of the cases in this area reveals the extent of doctrinal confusion that prevails, as well as the ingenuity of courts and litigants in molding a wide variety of legal theories to fit similar fact situations.<sup>84</sup> *Paladin* is an excellent

82. Principal case at 320.

83. *But cf. Katz, The Doctrine of Moral Right and American Copyright Law—A Proposal*, 24 S. CAL. L. REV. 375, 386-87 (1951) (footnote omitted, emphasis in original): The analogy between patent law and copyright is not an apt one. . . . [T]hose objects which are patented are primarily intended to be put to a commercial or industrial use. Absolute power of disposition in the hands of the inventor or his assignor, if extended for too long a period, will create a monopoly capable of actively working against the public interest. . . . [Literary works] generally have no effect on the progress of a State's economy or welfare. Furthermore, a *valid copyright does not prevent another from using the ideas expressed* . . . . Undeniably, the threat of monopoly is greater where patents rather than copyrights are involved.

However, the Supreme Court in *Sears* apparently rejected this distinction. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231-32 (1964).

84. Some leading examples of the successful application of diverse theories to similar fact situations are *Lahr v. Adell Chem. Co.*, 300 F.2d 256 (1st Cir. 1962) (mimicry of famous voice on television commercial held to be defamation by association of performer with type of work "below his class"); *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481 (3d Cir. 1956), *cert. denied*, 351 U.S. 926 (1956) (professional boxer's "right to control the scope or reach of his own services" as embodied in film held cognizable under doctrine of unfair competition, even though he had

example of the possibility of multiple classification: in addition to theories of common-law copyright, misappropriation, unfair competition, and trademark, the character could plausibly be analyzed in terms of DeCosta's privacy rights. DeCosta in a sense *was* Paladin, since the character grew out of his youthful experiences and was probably the only name by which he was known to a sizeable number of people. And, given the fact that DeCosta sought not remuneration but rather "the entertainment of others,"<sup>85</sup> it could be argued that the most appropriate measure of damages would be the emotional harm that he suffered when CBS exploited his character and lured his audience away.

The reason for confusion between the doctrines of privacy and copyright may be found in the nature of the right to privacy as Warren and Brandeis first conceived it. To its creators, the right to privacy was the right to control the communication of personality values, and copyright doctrines were one method by which the law had sought to guarantee this sweeping right:

The common law secures to each individual the right of determining, ordinarily, to what extent his thoughts, sentiments, and emotions shall be communicated to others . . . . The existence of this right does not depend on the particular method of expression adopted. . . . Neither does the existence of the right depend upon the nature or value of the thought or emotion, nor upon the excellence of the means of expression . . . . It may exist independently of any corporeal being, as in words spoken, a song sung, a drama acted.<sup>86</sup>

In short, both copyright and privacy involve the interplay of communications media and the human personality; indeed, one com-

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long since quit the ring; privacy claim rejected); *Baez v. Fantasy Records, Inc.*, 144 U.S.P.Q. 537 (Cal. Super. Ct. 1964) (use of recorded performance several years later than anticipated impaired value of singer's current recording contract and unfairly caused her to compete with herself); *Lennon v. Pulsebeat News, Inc.*, 143 U.S.P.Q. 309 (N.Y. Sup. Ct. 1964) ("Beatles" singing group given common-law copyright in a recorded interview because "their distinctive manner of speech and expression" was valuable property); *Columbia Broadcasting Sys. v. Documentaries Unlimited, Inc.*, 42 Misc. 2d 723, 248 N.Y.S.2d 809 (Sup. Ct. 1964) (reproduction of news broadcast in phonograph record "a clear case of appropriation" since broadcaster's style of talking is "the foundation and source of employment and income" as well as "his personality, a form of art expression"); *Waring v. WDAS Broadcasting Station, Inc.*, 327 Pa. 433, 194 A. 631 (1937) (orchestra conductor's recorded musical interpretation protectible either as artistic property or under unfair competition principles; concurring judge felt that essence of complaint was invasion of privacy). *But see Shostakovich v. Twentieth Century-Fox Film Corp.*, 196 Misc. 67, 80 N.Y.S.2d 575 (Sup. Ct. 1948), *aff'd mem.* 275 App. Div. 692, 87 N.Y.S.2d 430 (1949) (Russian composer's claim that use of his uncopyrighted music in a motion picture critical of the Soviet government implied his "endorsement or participation," thereby violating his moral right as composer and his privacy right under a New York statute, as well as defaming him and inflicting injury without just cause; held insufficient to sustain a motion for injunction).

85. Principal case at §16.

86. Warren & Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 198-99 (1890).

mentator has suggested that the test which should be used to identify the type of creativity that copyright seeks to foster is whether or not the creator has succeeded in imposing his personality on a medium to such a degree that an observer can recognize aspects of the personality in the completed work.<sup>87</sup>

The law of privacy, however, has not settled on a single unifying principle like "creativity,"<sup>88</sup> perhaps because of the difficulty of classifying the ways in which media can be used and misused. Even a simple instance of medium-misuse may have a wide range of possible effects upon the individual, since a given misuse may inflict emotional harm, economic damage, or a combination of both. For example, the person who is unwillingly pictured in a product advertisement may be concerned only by the fact that he has been deprived of the economic value of the use of his photograph; his complaint is essentially one of unjust enrichment.<sup>89</sup> Additionally, the plaintiff may feel that his personal good will has been damaged by association with inferior goods, or through such saturation of the market that he appears greedy. The gravamen of the wrong could thus be derived from unfair competition, based on the implied misrepresentation that the goods in some sense emanate from or are approved by the plaintiff.<sup>90</sup> The same use of a photograph in an advertisement could also be objectionable because it is personally embarrassing to the plaintiff<sup>91</sup> or cheapens his personality;<sup>92</sup> carried to the extreme, the context or content of a photograph could be so deeply humiliating as to be defamatory.<sup>93</sup> In short, a medium of communication possesses a twofold capability for harm: it may disseminate the plaintiff's actions (or evidence of his past actions) to a wider audience or market than he had desired; and it may misrep-

87. Whicher, *The Case of the Horror Monsters: Art as Law, Art as Fact*, 9 BULL. COPYRIGHT SOC'Y 472, 479 (1962). See also Desny v. Wilder, 299 P.2d 257, 271 (1956).

88. Compare Prosser, *Privacy*, 48 CALIF. L. REV. 383 (1960), with Bloustein, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U.L. REV. 962 (1964) and Rider, *Legal Protection of the Manifestations of Individual Personality—The Identity—Indicia*, 33 S. CAL. L. REV. 31 (1959).

89. Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir.) cert. denied, 346 U.S. 816 (1953); Kalven, *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROB. 326, 331 (1966); Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROB. 203 (1954).

90. Hogan v. A. S. Barnes & Co., 114 U.S.P.Q. 314 (Pa. C.P. 1957). See also Waldheim, *Mickey Mouse—Trademark or Copyright?*, 54 TRADEMARK REP. 865, 867 (1964).

91. Sinclair v. Postal Telegraph & Cable Co., 72 N.Y.S.2d 841 (Sup. Ct. 1935).

92. H. M. McLuhan, UNDERSTANDING MEDIA: THE EXTENSIONS OF MAN 170 (Signet Books ed., 1964):

[T]he camera tend[s] to turn people into things, and the photograph extends and multiplies the human image to the proportions of mass-produced merchandise. The movie stars and matinee idols are put in the public domain by photography . . . They can be bought and hugged and thumbed more easily than public prostitutes.

93. Peck v. Tribune Co., 214 U.S. 185 (1909); Burton v. Crowell Publishing Co., 82 F.2d 154 (2d Cir. 1936); Russell v. Marlboro Books, 183 N.Y.S.2d 8 (Sup. Ct. 1959); Wade, *Defamation and the Right of Privacy*, 15 VAND. L. REV. 1093 (1962).

resent, either expressly or impliedly, the kind or quality of actions he performed.<sup>94</sup>

Furthermore, the subject matter that a medium embodies or transmits may itself be creative: for example, a work of sculpture may be embodied in a photograph. Clearly, the propriety of this kind of use should be judged by copyright principles. But when the subject matter before the camera is a human being, the distinction may not be so easy; as the *Paladin* court noted, "[a]ll human beings—and a good part of the animal kingdom—create characters every day of their lives."<sup>95</sup> Courts have occasionally come close to recognizing a copyright-privacy dichotomy in the latter situation by distinguishing between the privacy claimant who is an unprotected "actual participant" or performer in a public event and the "mere spectator" who cannot be "singled out" of the crowd by mass media.<sup>96</sup> The distinction is appealing insofar as the conscious performer is more likely to suffer economic damage than he is to experience emotional harm and hence would be less able to assert the kind of interest that the law of privacy is designed to protect. In addition, the conscious performer should have greater notice of the possible uses of his performance, which would enable him to impose contractual limitations on the use of his services. But practical application of the "actual participant" standard is far from satisfactory: for example, a literal application of the rule may prevent the publication of an esthetically pleasing candid photograph, the television use of close-ups of spectators at a public or sporting event, or the incidental depiction of the inhabitants of a city as part of a motion picture travelogue.<sup>97</sup> The possibility of deterring the use of such subject matter, and other matters more socially important, may be sufficient

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94. Compare *Gieseking v. Urania Records*, 17 Misc. 2d 1034, 1035, 155 N.Y.S.2d 171, 172 (Sup. Ct. 1956): "A performer has a property right in his performance that it shall not be used for a purpose not intended, and particularly in a manner which does not fairly represent his service." The fact that some media can embody actions and store them for later use may also cause the plaintiff embarrassment if, for example, he is a performer whose style has changed markedly in the interval between embodiment and release. *Baez v. Fantasy Records, Inc.*, 144 U.S.P.Q. 537 (Cal. Super. Ct. 1964); *McAndrews v. Roy*, 131 S.2d 256 (La. 1961).

The analysis based on widespread dissemination and fair representation may be harmonized with Dean Prosser's division of the law of privacy into the separate wrongs of intrusion, public disclosure of private facts, giving the plaintiff a false light in the public eye, and appropriation of a name or likeness. W. PROSSER, *TORTS* § 112 (3d ed. 1964). The first two of these torts seem to be based primarily upon widespread dissemination, while the false light and appropriation cases are concerned principally with unfair representation of the plaintiff's services.

95. Principal case at 320.

96. *Gautier v. Pro-Football, Inc.*, 304 N.Y. 354, 107 N.E.2d 485 (1952).

97. In *Blumenthal v. Picture Classics, Inc.*, 235 App. Div. 570, 257 N.Y.S. 800 (1932), *aff'd per curiam*, 261 N.Y. 504, 185 N.E. 713 (1933) an injunction was granted restraining the showing of a motion-picture travelogue which included an unauthorized six-second closeup of a lady street vendor. The decision was criticized for being unduly restrictive in *Sarat Habiri v. Daily Mirror, Inc.*, 162 Misc. 776, 781, 295 N.Y.S. 382, 388 (1937).

to restrict sharply the scope of the right to privacy in its application to mass media.<sup>98</sup>

Finally, the various media themselves have different characteristics<sup>99</sup> and may be used in different ways. The camera, for instance, is able to reproduce events with complete verisimilitude, while a written factual description of the same events will probably contain some subjective or interpretive elements.<sup>100</sup> The legal system has long recognized the social importance of media as conduits of information, according them a broad privilege when they are dealing with "newsworthy" events.<sup>101</sup> But even technological media such as photographic equipment have the inherent ability to distort the "truth,"<sup>102</sup> as well as the capacity to serve as a means of artistic creation.<sup>103</sup> They may, in turn, be part of a larger creative process; for example, the motion picture may combine creative photography with a written script, musical background, and selective editing.

It would seem that the creatively-used medium, of whatever nature, should have free access to a public domain that consists in part of the life histories and actions of living people. The implications of this concept have been developed most fully in cases involving the familiar medium of the written word. The multitude of types, genres, and styles of writing have in large measure frustrated the courts' attempts to establish a separate category of informational prose. In cases where the defendant has produced a biography or other work which purports to be based on factual incidents in the

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98. In *Gill v. Hearst Publishing Co.*, 40 Cal. 2d 224, 253 P.2d 441, 444 (1953) a privacy claim based on the publication of an unauthorized photograph taken in a public place was rejected, in part because of the possibility of deterring all photographs of street scenes. The court stated that any privacy rights in the pose had been waived when the plaintiffs assumed the pose in a public place:

The photograph of plaintiffs merely permitted other members of the public, who were not at plaintiffs' place of business at the time it was taken, to see them as they had voluntarily exhibited themselves. . . . [P]laintiffs' right to privacy as to this photographed incident ceased and it in effect became a part of the public domain . . . .

*Id.* at 230, 253 P.2d at 444.

99. See text accompanying notes 26-29 *supra*.

100. Compare Silver, *Privacy and the First Amendment*, 34 *FORDHAM L. REV.* 553, 566 (1966):

[I]s not biography itself, as an art form, a selection of certain "meaningful" portions of someone's life to "illustrate" the primary qualities of that life? Often, "truth" is elusive, especially when the biographer attempts to assess character, which is the heart of the average biography. To require "substantial truth," at least in this realm, would be to require too much—at least by constitutional standards.

See also *Donahue v. Warner Bros. Pictures, Inc.*, 194 F.2d 6, 19-20 (10th Cir. 1952) (dissenting opinion).

101. W. PROSSER, *TORTS* § 112, at 844-50 (3d ed. 1964).

102. See cases cited in notes 91, 93-94 *supra*.

103. As early as 1884 the Supreme Court held that a portrait photograph was a creative work eligible for copyright protection because of the photographer's originality in "selecting and arranging the costume, draperies, and other various accessories . . . arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression . . . ." *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884).

plaintiff's life, but which in fact distorts or fictionalizes some of the events, it has frequently been held that the fictionalization gives rise to an inference that the defendant is appropriating an episode of the plaintiff's life for commercial purposes.<sup>104</sup> The Supreme Court recently concluded that this type of analysis imposes too great a risk of "chilling" the dissemination of factual information which rightfully belongs in the public domain, since the line between fact and fiction is a rather tenuous one. In *Time, Inc. v. Hill*,<sup>105</sup> the Court held that a privacy action based on a factually inaccurate magazine article must meet the defamation standard of knowing or reckless falsehood. Justice Douglas, concurring in the decision, gave passing notice to the possible connection between the concepts of free dissemination of factual news and free access to the public domain for purposes of creation: "A fictionalized treatment of the event is, in my view, as much in the public domain as would be a watercolor of the assassination of a public official. It seems to me irrelevant to talk of any right of privacy in this context."<sup>106</sup> A subsequent commentator has argued that the Court did not pursue this line of reasoning far enough, since application of the knowing or reckless falsehood standard to works that do not purport to be factually accurate is artificial and fails to take cognizance of the fact that the creative work may make significant social contributions wholly apart from its factual content.<sup>107</sup> A theory of constitutional pre-emption beyond the area of power specifically granted to Congress by the copyright clause is perhaps the doctrinal bridge that is needed to define a unified and coherent territory of public domain, from which all media-users may gather the raw materials of creativity.

There are probably few instances in which a predominantly creative embodiment of individual actions inflicts significant emotional damage, and these instances may not be an unduly heavy price to pay for the existence of robust media. Moreover, the adop-

104. See, e.g., *Hazlitt v. Fawcett Publications, Inc.*, 116 F. Supp. 538 (D. Conn. 1953); *Spahn v. Julian Messner, Inc.*, 23 App. Div. 2d 216, 260 N.Y.S.2d 451 (1965), *aff'd*, 18 N.Y.2d 324, 221 N.E. 543 (1966). *Koussevitzky v. Allen, Towne & Heath*, 188 Misc. 479, 68 N.Y.S.2d 779, *aff'd*, 272 App. Div. 759, 69 N.Y.S.2d 432 (1947). This decision was subsequently vacated and remanded, 387 U.S. 239 (1967), for further consideration in the light of *Time, Inc. v. Hill* (see text accompanying notes 105-06 *supra*). The court of appeals then concluded that the use of invented dialogue and incidents in a biography for children constituted knowing falsity within the meaning of *Hill*. 36 U.S.L.W. 2438 (N.Y. Ct. App. Jan. 23, 1968). This interpretation of *Hill* seems to establish a more stringent standard of accuracy for biographical and quasi-biographical works than had the earlier New York cases. See, e.g., *Youssoupoff v. Columbia Broadcasting Sys.*, 41 Misc. 2d 42, 244 N.Y.S.2d 701 (Sup. Ct.), *aff'd mem.*, 19 App. Div. 2d 865, 244 N.Y.S.2d 1 (1963) wherein a defense of substantial accuracy, taking into account the conventions of the particular medium and genre, was successful. See also *Estate of Hemingway v. Random House, Inc.*, 49 Misc. 2d 726, 268 N.Y.S.2d 531, *aff'd mem.*, 25 App. Div. 2d 719, 269 N.Y.S.2d 366 (1966).

105. 385 U.S. 374 (1967).

106. *Id.* at 401.

107. Comment, *Privacy, Defamation, and the First Amendment: The Implications of Time, Inc. v. Hill*, 67 COLUM. L. REV. 926, 943 (1967).

tion of such a rule need not leave the individual wholly defenseless to the possible abuses of mass media. The potential for harm inherent in mixed works of fact and fiction, such as the "fictionalized" biography, could be ameliorated by using the analogy of *Sears* and *Compco* to impose strict labeling requirements, including a detailed description of the parts of the work that are nonfactual. And, in cases where the medium causes a truly outrageous distortion of the personality, the *Hill* case implies that an action for defamation is the appropriate remedy, although the concept of what constitutes a "true" representation needs further development in its application to pictorial works.

Such an approach offers far better hope for national uniformity than the less drastic alternatives. Limitations on state power such as that contained in the proposed copyright revision bill, which provides that state remedies are permissible "as long as the causes of action contain elements . . . that are different in kind from copyright protection,"<sup>108</sup> have been shown by the post-*Sears* cases to be feeble restrictions on the courts, when amorphous concepts like emotional harm and public deception can be applied mechanically to nearly any situation. Uniform treatment of the national media should be the controlling necessity; yet very possibly what is needed is selective uniformity of protection rather than total laissez faire. Copyright concepts of originality and creativity demand further exploration and may eventually encompass a greatly expanded range of personality values comparable to those secured by the civil-law doctrine of moral right.<sup>109</sup> Certainly a more comprehensive investigation of the myriad relationships that exist between individuals and communications media is imperative; but using the courts as laboratories for the piecemeal extension of copyright protection may in effect deter the mass media from popularizing new kinds and techniques of creation and dilute the impetus for development of a more comprehensive federal scheme of regulation for the creative media.

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108. H.R. REP. NO. 2237, 89th Cong., 2d Sess. 128 (1966). The relevant statutory provisions are S. 597, 90th Cong., 1st Sess. § 301 (1967); H.R. 2512, 90th Cong., 1st Sess. § 301 (1967).

109. Claims based on a theory of moral right usually have been denied by American courts. *See, e.g.,* *Vargas v. Esquire, Inc.*, 164 F.2d 522 (7th Cir. 1947). But a moral right theory may bear close relationship to accepted causes of action such as defamation or invasion of privacy. *Cf. Shostakovich v. Twentieth Century-Fox Film Corp.*, 196 Misc. 67, 80 N.Y.S.2d 575 (Sup. Ct. 1948), *aff'd mem.*, 275 App. Div. 692, 87 N.Y.S. 2d 430 (1949). On the general outlines of the doctrine of moral right, *see* M. NIMMER, COPYRIGHT § 110 (1967); Katz, *supra* note 83; Kury, *Protection for Creators in the United States and Abroad*, 13 COPYRIGHT L. SYM. 1 (1964).