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COPYRIGHT OF TEXTILE DESIGNS — CLARITY AND CONFUSION IN THE SECOND CIRCUIT

*Thomas Ehrlich**

FOR decades textile designers have sought without success to check the piracy of their patterns.¹ Numerous bills aimed at protecting designers have failed in Congress.² Until recently, the few federal courts which had considered the question had held that neither the Copyright Act nor the common law afforded protection.³ After the Supreme Court's decision in *Mazer v. Stein*,⁴ however, it seemed that relief might at last be available. In that case the Court held that the utilitarian purpose of an object did not exclude it from copyright protection. The Copyright Office revised its regulations to include textile designs within the scope of the act;⁵ yet the regulations left unanswered a number of difficult problems in the practical realization of this protection.

Judge Learned Hand, in *Cheney Bros. v. Doris Silk Corp.*, felt compelled to write that while relief had to be denied, "it would seem as though the plaintiff had suffered a grievance for which there should be a remedy. . . ."⁶ It was therefore entirely appropriate that it was also Judge Hand who wrote the first appellate opinion sustaining the copyright on a textile design, *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*⁷ The opinion has been subject to some misinterpretation,⁸ and it seems well to review exactly

* Member of the Wisconsin Bar.—Ed. I spent the past year as Law Clerk to Judge Hand, and happily acknowledge that my views on the subject of this article were tempered by his.—T.E.

¹ See generally Young, *Freebooters in Fashions: The Need for a Copyright in Textile and Garment Designs*, in ASCAP, COPYRIGHT LAW SYMPOSIUM, NUMBER NINE 76 (1958); GOTSHAL & LIEF, *THE PIRATES WILL GET YOU* (1945); Weikart, *Design Piracy*, 19 IND. L.J. 235 (1944).

² E.g., H.R. 8873, 85th Cong., 1st Sess. (1957); H.R. 2860, 80th Cong., 1st Sess. (1947).

³ E.g., *Verney Corp. v. Rose Fabric Converters Corp.*, 87 F. Supp. 802 (S.D.N.Y. 1949) (copyright); *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279 (2d Cir. 1929) (L. Hand, J.) (unfair competition).

⁴ 347 U.S. 201 (1954).

⁵ See 37 C.F.R. § 202.10 (b) (1960). It might be argued that designs were implicitly included in the former regulations.

⁶ 35 F.2d 279, 281 (2d Cir. 1929).

⁷ 274 F.2d 487 (2d Cir. 1960). Just fifty years ago, Judge Hand held that lack of artistic merit was irrelevant to the validity of a musical composition, and that although the work had only financial value, a court must protect that value. *Hein v. Harris*, 175 Fed. 875 (S.D.N.Y.), *aff'd*, 183 Fed. 107 (2d Cir. 1910). "Certainly the qualifications of judges would have to be very different from what they are if they were to be constituted censors of the arts." 175 Fed. at 877. In that *Mazer v. Stein* reflects a disinclination to weigh artistic against pecuniary value, it was foreshadowed by the *Hein* opinion.

⁸ See 73 HARV. L. REV. 1613 (1960). This Recent Case discussion fails to examine Judge Hand's reasoning or the limitation he imposed on the holding in the case.

what was decided. This article will discuss the opinion, one which followed close on its heels,⁹ and several of the problems raised.

The factual situation in *Peter Pan* may be briefly stated. The plaintiff, a converter of gray goods, owned a registered copyright on an original design. He sold bolts of printed cloth to dress manufacturers; notices of copyright were printed on the selvage next to each copy of the design. In the making of dresses, the manufacturers either cut off the notices or sewed them within seams. The plaintiff sought to enjoin an alleged infringement by the defendant, a competing converter. The defendant denied infringement and claimed that the plaintiff's copyright had been forfeited under section 10 because the notices were hidden or removed by the dressmakers.¹⁰ The court denied both contentions and affirmed a preliminary injunction. Judge Friendly dissented on the ground that the copyright had been forfeited.

In a number of cases involving literary property, Judge Hand has emphasized the difficulties in determining what are "ideas," and what "expressions."¹¹ But while he is "as aware as any one that the line, wherever it is drawn, will seem arbitrary, that is no excuse for not drawing it. . . ."¹² He reiterated these problems in *Peter Pan*, adding that "in the case of designs, which are addressed to the aesthetic sensibilities of an observer, the test is, if possible, even more intangible."¹³ Yet some focus is necessary, and Judge Hand found it in "the uses for which the design is intended, especially the scrutiny that observers will give to it as used."¹⁴ In viewing a design, one must "try to estimate how far its overall appearance will determine its aesthetic appeal when the cloth is made into a garment." Upon examination he found that while the two patterns "are not identical . . . the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same. That is enough; and indeed it is all that can be said, unless protection against in-

⁹ *H. M. Kolbe Co. v. Armigus Textile Co.*, 279 F.2d 555 (2d Cir. 1960).

¹⁰ This section provides that copyright protection is available only if a Notice of Copyright is "affixed to each copy . . . published or offered for sale . . . by authority of the proprietor." 17 U.S.C. §10 (1958).

¹¹ *E.g.*, *Fitch v. Young*, 230 Fed. 743 (S.D.N.Y. 1911). Of course, only "expressions" are copyrightable.

¹² *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (2d Cir. 1930). While still a district judge he wrote that "it has never been very satisfactorily established, and probably never can be, at what point a plagiarism ceases to copy the expression of an author's ideas and steals only the ideas themselves." *Fitch v. Young*, *supra* note 11, at 745-46.

¹³ 274 F.2d at 489.

¹⁴ *Ibid.*

fringement is to be denied because of variants irrelevant to the purpose for which the design is intended."¹⁵ Judge Hand certainly did not mean that if the "aesthetic appeal" of two designs is the same, physical distinctions should be ignored. Rather he held that if two patterns are identical except for minor variances, these variances should not be considered a new "expression."

It has been contended that this test is not sufficiently strict in light of the peculiar nature of the fashion industry. It is true that certain "themes" may predominate during a particular season, and a number of designs may be independently developed from the same "idea."¹⁶ But it would be absurd to say that minor alterations of a complex pattern, the originality of which is not in question,¹⁷ should exonerate.¹⁸ The fabrics are intended for public use; their success will depend upon their distinctive appeal to the public. Should not, therefore, the test be whether those who will wear garments made from the materials, unless they "set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same?"¹⁹ No one, least of all Judge Hand, would declare this to be a magic formula. Yet it does set the perspective within which alleged infringements are to be examined; more cannot be done.

It must be admitted that the fifty-six year copyright protection is hardly ideally suited to the spasmodic shifts of the design world, and it is therefore protection that should not be too freely granted, lest competition be smothered. But competition in the industry can best be promoted not by a strict view of the standards of infringement but rather by particular care in declaring a pattern to be "original."²⁰ In the *Peter Pan* case the question was not raised, and indeed the pattern was one of rather striking originality. But in future cases it is to be hoped that new "expressions" of "ideas" will not be too easily found.

Judge Hand's reasons for denying the defendant's claim of forfeiture are somewhat more difficult to follow, and it may simplify this discussion to begin with the position of Judge Friend-

¹⁵ *Ibid.*

¹⁶ See 73 HARV. L. REV. 1613 (1960).

¹⁷ *Millworth Converting Corp. v. Slifka*, 276 F.2d 443 (2d Cir. 1960) makes it clear that only the original elements of a design are copyrightable.

¹⁸ See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930), in which, regarding literary property, Judge Hand wrote that "the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations."

¹⁹ 274 F.2d at 489.

²⁰ It must be admitted that this approach is a deviation from some recent cases. See, e.g., *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951).

ly in his dissent. It is a requisite for copyright protection that a notice of copyright be "affixed to each copy . . . published or offered for sale . . . by authority of the . . . proprietor. . . ." ²¹ A statutory exception is specifically granted only for "omission by accident or mistake of the prescribed notice from a particular copy or copies. . . ." ²² Sales by dress manufacturers who had purchased bolts of plaintiff's cloth were certainly, wrote Judge Friendly, "by authority of" the plaintiff. It followed that, since notice did not appear on every copy of the design "offered for sale," the copyright was forfeited.

Judge Hand, apparently assuming that, on the basis of *Mazer v. Stein* and the present copyright regulations, textile designs may be "theoretically" copyrighted, admitted that "if we construe the words of section 10 with relentless literalism, dresses made out of the 'converted' cloth may be said to be 'offered for sale' without any effective notice." ²³ Judge Hand seems to have based his analysis on the thesis that it could not have been the intent of Congress to permit a commercial design to be copyrighted but yet require the immediate forfeiture of the copyright when the article is put to the very use for which copyright was sought. While it may well be argued whether Congress did intend copyright to extend to textile designs, if this is assumed, the remainder of Judge Hand's argument has a compelling force. ²⁴ Based on this thesis, Judge Hand held that an owner of a design copyright must do the best he can, consistent with commercial requirements, to see to it that notices remain on the copies after they leave his hands. As forfeiture is a defense to be proved when infringement has been established, the burden is on the defendant "to show that 'notice' could have been embodied in the design without impairing its market value." ²⁵ The defendant must therefore show that a notice worked into each repetition of a design would not alter the public's desire to purchase a garment on which the design was printed. Of course, the public's reaction to embodying notices might vary according to the garment on which the design is printed, and presumably a court must consider the likelihood that a design will be displayed on, for example, underwear rather than dresses. If the defendant

²¹ 17 U.S.C. § 10 (1958).

²² 17 U.S.C. § 21 (1958).

²³ 274 F.2d at 489.

²⁴ *Mazer v. Stein* can, however, be interpreted to mean simply that the purpose of a work is irrelevant to its copyrightability—that commercial works should be viewed with neither special solicitude nor special disfavor.

²⁵ 274 F.2d at 490.

can successfully meet his burden, the copyright has been forfeited. But if it is feasible to place notices only on the selvage of a particular design, the copyright is maintained though many of the notices are cut off or hidden when they leave the hands of the dressmakers. It may be assumed that if the defendant proves that it was feasible to embody a © with the originator's initials within the design, he must also show that it was practicable to imprint the originator's full name on the back or some other "accessible portion" of the fabric.²⁶

On two other points some confusion may be caused by Judge Hand's opinion. First, he indicates that there is some question whether a "notice" would be "affixed" to a design, within the meaning of section 10, when it is incorporated into the design rather than added to it—in other words, whether "affix" necessarily implies adding the notice to a copy after its creation and registration. But it seems hardly possible that such a semantic objection could be in any way determinative. Second, and more significant, there is some intimation in the opinion that the sales of dresses were not "by authority of" the plaintiff within the meaning of section 10. Thus Judge Friendly wrote, "I am not altogether clear whether my brothers say that the sale of the dresses was not an offer for sale with the authority of the copyright proprietor or that it was such an offer but that notice need not be affixed if this was not feasible." However, Judge Hand's holding that the defendant must prove that notice "could have been embodied in the design without impairing its market value" makes it plain that he considered the sale an authorized one. Certainly his opinion does not suggest that a different rule should be applied to dress manufacturers who convert their own fabric.

It may be argued, however, that application of the phrase "by the authority of" should be confined to those cases in which the seller is acting as agent or licensee for the copyright proprietor.²⁷ In other words, the phrase implies continuing control, and even though a proprietor may know that dress manufacturers will sell copies of his design without notices, he cannot, once he has sold the bolts of converted cloth to them, restrain their use of the fabric. This analysis avoids many of the problems raised by the majority's opinion. At the same time, it leaves the door open to decide that

²⁶ 17 U.S.C. § 19 (1958). It is doubtful whether the selvage of a fabric would qualify as an "accessible" portion.

²⁷ This was the situation in *National Comic Pubs., Inc. v. Fawcett Pubs., Inc.*, 191 F.2d 594 (2d Cir. 1951) (L. Hand, J.).

the statutory requirement is one of reasonable notice, and that notice on the selvage is insufficient because it is not likely to remain.²⁸ This approach, however, assumes as a starting point completed sales by the proprietor; yet why should the proprietor not have to secure an agreement from manufacturer that notices printed on the selvage will be visible on finished garments? The only answer is that it is commercially infeasible to exact such agreements—Judge Hand's rationale for relaxing the notice requirement. In this light, the preferable view is that adopted by both Judge Hand and Judge Friendly: "sale . . . by authority" includes situations in which the proprietor has acquiesced by inaction in the removal of notices by one who has purchased from him. Otherwise the notice provision could be too easily avoided by the use of an intermediary.

It cannot be disputed that Judge Hand was deviating from those prior decisions which called for strict compliance with the statutory requirements of notice. He admitted that this was a situation in which "a literal interpretation of the words of a statute is not . . . a safe guide to its meaning." Judge Friendly commented that "perhaps my brothers are right in thinking that Congress wished literal compliance with section 10 to be excused under such circumstances as here; but the voice so audible to them is silent to me." He wrote that he "could reconcile the majority's result with the language of section 10 if, but only if, . . . there were clear evidence that the dominant intention of Congress was to afford the widest possible copyright protection whereas the notice requirement was deemed formal or at least secondary." However, he found "nothing to support such a stratified reading of section 10." But, as noted, *if* it is assumed that Congress intended that the Copyright Act be available to commercial textile designs, it is difficult to deny protection whenever the designs are marketed, even though no more permanent notice is feasible. In other words, the application of *Mazer v. Stein* to textile designs requires a new interpretation of the notice requirements.

In further support of Judge Hand's position, it may be noted that insofar as the notice provision was enacted for the purpose of ensuring that all potential copyists will be aware of copyrights,²⁹

²⁸ The standard adopted might be similar to that in the 1955 Universal Copyright Convention, § 9 (c).

²⁹ Judge Hand has regarded this as the purpose of the notice provision. "[A]ny notice will serve which does in fact advise . . . that there is a 'proprietor' who does claim copyright, provided the notice does not affirmatively mislead." *National Comics Pubs., Inc. v. Fawcett Pubs., Inc.*, 191 F.2d 594, 602-03 (2d Cir. 1951). For a brief analysis of the

enforcement of that provision need not be as strict in the case of textile designs as it is for literary works. It may be argued that although one notice is necessary for each copy of a book, a similar rule need not be applied to textile designs because potential copyists will generally view a number of copies together, and if one notice appears, that is sufficient. And infringement by housewives who have purchased dresses made from Peter Pan's fabrics is hardly that company's chief concern; rather it is competing converters who are likely to copy. These converters know that if a notice of copyright appears at all on a dress, it will appear within a sewn seam. It is not too great a burden to require them to examine carefully the garments whose designs they wish to copy. Similarly, it seems justifiable to require converters to see to it that each dress made from their fabrics has at least one notice.³⁰

Such an approach requires, however, a rejection of *Louis DeJonge & Co. v. Breuker & Kessler Co.*,³¹ in which Mr. Justice Holmes held for the Court that one notice for every twelve reproductions of a design on Christmas wrapping paper was insufficient. Mr. Justice Holmes justified this narrow interpretation on the ground that "the appellant is claiming the same rights as if this work were one of the masterpieces of the world, and he must take them with the same limitations that would apply to a portrait, a holy family, or a scene of war."

One panel of the Second Circuit had no sooner charted the outlines of an emerging copyright law when another panel, in *H. M. Kolbe Co. v. Armigus Textile Co.*,³² shattered these outlines and left the law in complete confusion. A group of eight identical roses on a piece of fabric had been submitted for registration. Each was a reproduction of the same portion of the same "work of art,"³³ and registration had been sought and obtained under section 5 (h): "Reproductions of a work of art." One notice appeared for every eight reproductions. The defendant claimed that it was commercially feasible to embody notice in the design. District Judge Murphy rejected an offer of proof, holding as a matter of

various proposals which have been made concerning revision of the notice requirement, see *Notice of Copyright, Study No. 6, GENERAL REVISION OF THE COPYRIGHT LAW* (U.S. Copyright Office 1958) 41-55.

³⁰ It may also be contended, however, that a dress made from a number of copyrighted reproductions of a design is analogous to a volume which binds a number of copyrighted newspapers, and that since Congress specifically permitted in § 20 just "one notice of copyright in each volume . . . of a newspaper," the court was legislating when it created a similar exception for designs.

³¹ 235 U.S. 33, 37 (1914).

³² 279 F.2d 555 (2d Cir. 1960).

law that, under *Peter Pan*, notice on the selvage was sufficient.³⁴ In a *per curiam* decision, Judges Clark and Moore affirmed. Judge Friendly dissented. The full majority opinion is as follows:

PER CURIAM

For the reasons stated by Judge Murphy in his opinion below, D.C.S.D.N.Y., April 28, 1960, 184 F. Supp. 423 we conclude that plaintiff has made a prima facie showing both of the validity of its copyright and of infringement by the defendants, and hence is entitled to the injunction pending suit granted below. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 2 Cir., 274 F. 2d 487.

Affirmed

This opinion shows little else than that the Supreme Court is not alone in its malpractice of *per curiam* mystiques.³⁵

Only three "explanations" seem possible; none is rational. The first is that on its face the claim that notice "could have been embodied in the design without impairing its market value"³⁶ was frivolous. Yet from Judge Friendly's dissent, such an interpretation is most unlikely, and certainly if this is what the court meant it would not have affirmed "for the reasons stated by Judge Murphy." Second, it may be that the court intended to overrule, *sub silentio*, the exception that Judge Hand interposed to his primary rule that notice on the selvage is sufficient. It is incredible that, without explanation, such a procedure would be followed. Finally, and most probably, the court may have interpreted Judge Hand's opinion as permitting evidence concerning the feasibility of embodying notice in the design only in a suit for a permanent injunction, not in a proceeding for interlocutory relief. This interpretation seems likely from the court's use of the phrase "a prima facie showing." Yet the *Peter Pan* case involved a preliminary injunction, and there is no indication in Judge Hand's decision that notice on the selvage was, as a matter of law, sufficient for a preliminary injunction. As Judge Friendly wrote in his dissent, it is "important that the Court make its position clear and not content itself with saying that plaintiff has made a sufficient showing of validity to warrant interlocutory relief. If a temporary injunction is granted in a case like this, the plaintiff has obtained

³³ Alternate roses were inverted.

³⁴ 184 F. Supp. 423 (D.C.N.Y. 1960).

³⁵ See Brown, *Foreword: Process of Law*, 72 HARV. L. REV. 77 (1958).

³⁶ 279 F.2d at 555.

all he wants and the action will usually go no further."³⁷ Whatever its basis, the decision has left the state of the design copyright law even less certain than it was before the *Peter Pan* case.

Judge Friendly, in his dissent, rejected the lower court's interpretation of *Peter Pan*.³⁸ "If the case presented no other issues," he would have remanded for findings whether the defendant carried the burden of proving that "'notice' could have been embodied in the design." In his view, however, the complaint should have been dismissed on its face. He wrote that "the 'reproduction' was each square, not eight," interpreting section 5 (h) as limiting copyright to a single reproduction, though the subsection itself refers to "reproductions" just as all the other subsections are written in plural terms. It is difficult to believe that Judge Friendly relied on his view of section 5, however, for the problem, I think at most a semantic one, of copyrighting a number of reproductions of a work of art, may be avoided by registration under section 5 (k): "Prints and pictorial illustrations including prints on labels used for articles of merchandize." There appears no reason why, consistent with the *DeJonge* case, a number of identical figures cannot be copyrighted as a single "print."³⁹ And section 5 specifically provides that "any error in classification [shall not] invalidate or impair the copyright protection secured under this title." The point was not raised, however, in Judge Friendly's dissent.

Judge Friendly's main theme appears to be that under the *DeJonge* case, section 10 requires a notice on each copy of an artistic unit, and it is for the the court to decide what is the proper unit. Interpreting section 5 in a manner complementary to this view of section 10, he said that only one of the identical designs was copyrightable, not the whole group of eight. By this view, it is irrelevant whether copyright is sought under section 5 (h) or section 5 (k).

It seems preferable, however, first to determine what is copyrightable, and then to examine the sufficiency of notice. Neither the language of the statute nor the intent of Congress seem to forbid registration of several reproductions as a single unit. Unlike the *Kolbe* case, in *DeJonge* a reproduction of only a single figure was submitted to the Copyright Office, and the case may be read as simply requiring that there be one notice per copyrighted

³⁷ *Id.* at 557.

³⁸ *Id.* at 555-57.

³⁹ See *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142 (S.D.N.Y. 1959).

unit, not as limiting the character of such units. The mechanics of registration look toward this approach. The "work of art" which is reproduced need not be sent, and therefore those in the Copyright Office cannot know whether they have received a "reproduction." Should not whatever design or group of designs is submitted for registration be deemed copyrightable provided it meets the standards of originality? If a designer copies a "work of art" consisting of eight identical patterns, the model for each being the same still life, presumably copyright would be permitted, and only one notice required. Why should the rule be different if only one of the patterns is submitted to the Copyright Office, but it is repeated eight times? And if a number of reproductions may be considered a single unit under section 5 (h), why should not the same be true under section 10? There appears no reason why a court rather than the proprietor should determine what is the proper artistic unit. Difficult questions would inevitably arise under Judge Friendly's approach. His view would be hard to apply if a series of identical designs were grouped together, in a novel way, into a single unit. In fact, in the *Kolbe* case, alternate roses were inverted, and it may be argued that their relationship to each other was significant apart from their individual design. Such questions would be avoided by the position taken above. This position would not, however, lead to the *reductio ad absurdum* suggested by Judge Friendly in his dissent—that a whole bolt of cloth might be submitted to the Copyright Office and thereafter be protected by a single notice. It should be clear that such notice would be inadequate by analogy to cases which have held that an indistinct notice was insufficient.⁴⁰

Judge Friendly concluded his opinion by writing: "With the natural concentration of this type of litigation in the Second Circuit, a concentration not likely to be diminished by our rulings in *Peter Pan* and here, this Court's decisions make law for the textile industry in an unusual degree."⁴¹ But by its decision in *Kolbe*, the court made not law but confusion. One can only hope that the circuit will soon bring some order to its chaos.

⁴⁰ *E.g.*, *Smith v. Bartlett*, 18 F. Supp. 35 (D.C. Me. 1937).

⁴¹ 279 F.2d at 557.