

Spoken Words and Copyright Subsistence in Anglo-American Law

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ABSTRACT

This article considers the necessity and desirability of reduction to material form (*i.e.* fixation) as a requirement for subsistence of copyright in spoken words. It examines how this aspect of copyright law has evolved in the United Kingdom from before the Statute of Anne until the present day, and compares this with the law which applies in the United States. It argues that there is nothing inherent in the underlying objectives of copyright law which makes a material form requirement a necessary precondition for copyright subsistence. Indeed, the material form requirement, at least as it applies in relation to spoken words, may lead to outcomes inconsistent with copyright law's objectives. It is concluded that the law ought to recognise the potential for copyright to subsist in any perceptible expression emanating from the intellect of a person and intended to appeal to the aesthetic sense or intellect of others, regardless of the expression's materiality.

1. INTRODUCTION

1.1 Word expression in the absence of material form

Mid-way through the 1992 Robert Altman motion picture *The Player*,¹ the film studio executive Griffin Mills (GM) is the audience for a spoken "pitch" from the writer Tom Oakleigh (TO). The pitch consists of the synopsis of a screenplay for which the writer is seeking studio backing. The working title of the project is *Habeas Corpus*. The following conversation transpires between the characters in an outdoor restaurant setting:

¹ Fine Line, 1992. The film *The Player* was directed by Robert Altman and written by Michael Tolkin.

- “TO: We open outside the largest penitentiary in California: It’s night. It’s raining. A limousine comes in through the front gate past a tight knot of demonstrators holding a candlelight vigil. The candles under the umbrella make them glow like Japanese lanterns . . .
- GM: That’s nice. I haven’t seen that before. That’s good.
- TO: A lone demonstrator, a black woman, steps in front of the limousine. The lights illuminate her like a spirit. Her eyes fix on those of the sole passenger. The moment is devastating between them.
- GM: He’s the DA. She’s the mother of the person who’s being executed . . .
- TO: The DA believes in the death penalty and the execution is a hard case: black, 19 and definitely guilty . . . He swears that the next person he sees to die is going to be smart, rich and white. You, me . . . Cut from the DA to an upmarket suburban neighbourhood. A couple have a fight. He leaves in a fit, gets in a car. It’s the same rainy night. The car spins out on the road, goes into a ravine. The body is swept away. Now, when the police examine the car, they find the brakes have been tampered with. It’s murder and the DA decides to go for the big one. He’s going to put the wife in the gas chamber . . .
- GM: . . . but the DA falls in love with the wife?
- TO: Of course he falls in love with the wife! But he puts her in the gas chamber anyway. Then he finds that the husband is alive. He faked his death. The DA breaks into the prison. Runs down death row. But he gets there too late. The gas pellets have been dropped. She’s dead. I tell you, there’s not a dry eye in the house.”

Assuming the writer’s synopsis is stored solely in his memory (as it appears to be in the context of the motion picture) copyright subsistence in the pitch both in England and the United States of America would be uncertain for failure to meet the “fixation” requirement; that is, the requirement that the work be reduced to a material form.² However, there is no doubt that such a pitch constitutes a commercially valuable artistic expression emanating from the writer’s intellect. In light of the underlying objectives of copyright law, the usefulness of the material form requirement is far from certain.

This article will explore the history and treatment of the material form requirement for copyright subsistence in the context of the spoken word. It will examine the position as has evolved in England and the United States of America. In so doing, it will argue that there is nothing inherent in the underlying objectives of copyright law which requires the imposition of a material form requirement as a necessary condition for subsistence in works. Indeed, it will argue that the material form requirement can lead to outcomes contrary to those underlying objectives.

² Copyright, Designs and Patents Act 1988 (U.K.), s.3(2); Copyright Act 1976, 17 U.S.C., s.102(a). Compare the U.S. position at common law: *Estate of Ernest Hemingway v. Random House* (1968) 32 A.L.R. 3d 605.

1.2 Truisms of copyright

Two truisms of copyright law may be confidently asserted. One is that copyright is incorporeal property.³ The other is that copyright protects expressions rather than ideas.

Copyright is incorporeal property.⁴ Thus, if A writes a note to X on paper owned by X, while the property in the paper remains with X, A will (in the ordinary course of events) be the owner of copyright in the literary work comprised in the expression.⁵ There exists a separateness of the proprietary interests between X’s chattel (the paper on which the note is written) and A’s expression (the choice of words forming the note). However, if A were not to write down that expression but rather tell X, using identical words, copyright will not subsist under English or U.S. copyright legislation in such expression. This is because subsistence under these legislative regimes requires that such matter be reduced to a material form.⁶ While A’s property in copyright may exist independent of and separate to X’s property in the paper, reduction to a material form is a necessary condition for the recognition of A’s incorporeal right.

One reason for the requirement of material form for copyright subsistence may lie in the origins of statutory copyright law being protection for “books”.⁷ Another reason might be traced to, as Drone expresses, “the assumption that materiality is essential to the determination of the identity of a thing”.⁸ However, the material form requirement cannot be justified on this ground when viewed in the context of the underlying objectives of copyright law. The identity of a work in which copyright is asserted can be determined in the absence of a material form of its expression.⁹ Thus, Drone makes the point that:

³ Walker, *The Oxford Companion to Law* (Oxford University Press, 1980) defines “incorporeal property” as “legal rights relative to objects of property which have no corpus or physical existence, e.g. patent rights, copyright”.

⁴ For an exposition on the incorporeal nature of copyright, see the High Court of Australia in *Pacific Film Laboratories v. Federal Commissioner of Taxation* (1970) 121 C.L.R. 154 and 168.

⁵ *In re Dickens; Dickens v. Hawksley* [1935] 1 Ch. 267. See also Drone, *A Treatise on the Law of Property in Intellectual Productions* (1879) at 6:

“Literary property is not in the material which preserves the author’s production, and is the means of its communication to others, but in the intellectual creation, which is composed of ideas, conceptions, sentiments, thoughts . . . It is an invisible, intangible creation of the mind, fixed in form and communicated to others by language. Incorporeal itself, it is generally attached to the corporeal.”

⁶ See above, n. 2.

⁷ Macaulay, speaking in the House of Commons in 1841 in relation to the then proposed Copyright Act 1841, stated simply that the policy behind the legislation was the desirability of having “a supply of good books”: Macaulay, Speech on the Copyright Bill, February 5, 1841, in Speeches 390 (1853) (Hansard 3d series, Vol. LVI, pp. 344–57).

⁸ See above, n. 5, p. 6.

⁹ In the *Commentaries on the Laws of England*, (1783) Vol. 2 at p. 406, Blackstone states:

“The identity of a literary composition consists entirely in the sentiment and language . . . and whatever method be taken of exhibiting that composition to the ear or the eye of another, by recital, by writing or by printing, in any number of copies, or at any period of time, it is always the identical work of the author which is so exhibited; and no man (it hath been thought) can have a right to exhibit it, especially for profit, without the author’s consent.”

"Indeed, so complete may the identity of an incorporeal literary composition be, that, even when it has no existence in writing or print, it may be preserved in its entirety for ages in the memory; passing from generation to generation, from country to country."¹⁰

Drone then gives the example of the *Iliad* which was recited from memory at Greek festivals for centuries before being "imprisoned in written characters".¹¹ The same is true of musical works, as exemplified by folk tunes.¹²

Copyright protects expressions rather than ideas. Often, the requirement of reduction to material form is rationalised upon the basis that the law does not protect mere ideas. Such statements are premised on the mistaken notion that an expression, not embodied in a material form, necessarily amounts to nothing more than an idea.¹³ In the context of the introduction, the writer's screenplay synopsis is no less an expression by reason of it being merely spoken. The absence of material form of an expression does not convert the expression into a mere idea. Conversely, the reduction to writing of a mere idea does not afford copyright protection to the idea *per se*. The issues of the idea/expression dichotomy and the material form requirement are distinct.

¹⁰ See above, n. 5, p. 7.

¹¹ *ibid.* p. 8.

¹² The celebrated Australian composer, performer and eccentric, Percy Aldridge Grainger, wrote in 1915:

"When [a folk-singer of unwritten music] refuses to let himself be heard, it is, more often than not, because he regards his tunes as purely *personal property*, and does not wish to part with them to others any more than he would with his pipe or his hat. I have myself had to get under a bed to note down the singing of an old woman chary of passing on her accomplishments to any Tom, Dick or Harry."

Grainger, "The Impress of Personality in Unwritten Music" in Balough (ed.), *A Musical Genius from Australia: Selected Writings by and About Percy Grainger* (1982) p. 65.

¹³ Nimmer and Nimmer, *Nimmer on Copyright*, Vol. 1 at para. 2.02 persuasively exposes the fallacy of linking material form to the expression-idea dichotomy. It is stated:

"[T]he expression of an idea to which copyright may attach requires concreteness only in the sense that concrete is the polar opposite of abstract. In this sense an expression may be most concrete (*i.e.* specific and detailed rather than general and abstract) and nevertheless not be embodied in tangible form."

The writer's synopsis of *Habeas Corpus* is, it is suggested, a good illustration of a non-tangible yet "concrete" expression.

2. ENGLAND

2.1 Common law copyright and the Statute of Anne (1710)

The Statute of Anne was enacted in England in 1709.¹⁴ This first piece of modern copyright legislation was the product of the London Company of Stationers' desire for awards against counterfeiters to be more easily obtained and for the imposition of penalties.¹⁵ The exclusive right, limited for a fixed period, of "printing and reprinting" was reposed by the Statute in the "author of any book or books".¹⁶

Prior to the Statute of Anne, the common law of England recognised a perpetual right of property in the author's "copy" in the manuscript. As printing presses were licensed and in the hands of the Stationers' Company, the only way an author could have his or her work printed, was to assign the "copy" to a member of the Company.¹⁷ Hence, it was said that "the author's copyright had in practice no independent existence".¹⁸

Debate has occurred, however, as to whether common law rights in the copy ever existed at all. This debate is critical to any discussion of the appropriateness, as a matter of copyright history, of any legislative requirement of material form. If the Statute of Anne is best seen as creating a new form of property, then to a greater extent policy considerations may be considered free from much of the pre-1709 jurisprudence. However, if the Statute of Anne merely provided statutory recognition of an existing form of property recognised at common law, then the philosophical nature of that common law property is important in considering what end objective the material form requirement achieves.

¹⁴ 8 Anne, ch. 19.

¹⁵ *Millar v. Taylor* (1769) 4 Burr 2302 at 2317, *per* Willes J., 98 E.R. 201 at 209.

¹⁶ Section 1. The statute in summary provided:

- (i) an exclusive right of printing in authors of 14 years, and an additional 14 years if the author was still alive at the end of the term;
- (ii) the imposition of the penalties on infringers of forfeiture and fine; and
- (iii) the requirement of entry in the register-book of the Stationers' Company.

¹⁷ Birrell, *Seven Lectures on the Law and History of Copyright in Books* (1899), pp. 74-77. Reproduced there is an extract from the Stationers' Company register of books, which recorded the assignment of the copy passing from author to printer:

3rd September 1604
 MASTER WATERSON
 Entered for his copies certain copies which were Master Ponsonbie's
 (i) The Arcadia of Sir Philip Sidney
 (ii) The ffayrie quene, both parts by Spencer.

¹⁸ Birrell (see above, n. 17) p. 74.

The decisions of the King's Bench in *Millar v. Taylor*¹⁹ and of the House of Lords in *Donaldson v. Beckett*²⁰ seek to explain the relationship between common law and statutory copyright.²¹ These cases deal with two fundamental questions:

- (i) whether common law copyright existed prior to the passing of the Statute of Anne, (and if so)
- (ii) whether it continued after the passing of that Statute.²²

2.1.1 Did common law copyright exist prior to the Statute of Anne?

On the first question the majority of the King's Bench in *Millar v. Taylor* found that the common law right of authors in the copies of their own work did exist. Lord Mansfield (with whom Willes and Aston JJ. Concurred in separate judgments) stated that the common law position, both before and after publication, was that the author retained ownership of rights in respect of the copy, for the reasons that:

"It is just that an author should reap the pecuniary profits from his own ingenuity and labour. It is just that another should not use his name without consent. It is fit that he should judge when to publish or whether he ever will publish. It is fit he should not only choose the time but the manner of publication, how many, what volume, what print. It is fit he should choose to whose care he will trust the accuracy and correctness of the impression."²³

This passage clearly grounds the rationale of copyright law in the author's act of creation. Earlier in his judgment, Lord Mansfield had explained:

"I use the word 'copy' in the technical sense in which that name or term has been used for ages, to signify an incorporeal right to the sole printing and publishing of somewhat intellectual, communicated by letters . . . The property in the copy . . . is equally in incorporeal right to print a set of intellectual ideas or modes of thinking, communicated in a set of words and sentences and modes of expression. It is equally detached from the manuscript or any other physical existence whatsoever."²⁴

This may be contrasted with the minority view of Yates J., who denied the common law existence of copyright prior to the Statute of Anne, for the reason that:

¹⁹ (1769) 4 Burr 2302, 98 E.R. 201.

²⁰ (1774) 2 Brown 129, 1 E.R. 837.

²¹ The issue first came before the King's Bench in *Tonson v. Collins* (1761) 1 Black W 301 at 311, 96 E.R. 169, 173; (1762) 1 Black W 321 at 345, 96 E.R. 180 at 189. However, the Court refused to determine the case once it was learnt that the litigation was a collusion; the defendant was nominal only, its expenses paid by the plaintiff: Birrell (see above, n. 17), pp. 109–110. Coincidentally, in both *Millar v. Taylor* and *Donaldson v. Beckett* the work the subject of the litigation was James Thomson's "The Seasons". An excellent account of the early common law copyright cases is included in Lindsay, *The Future of the Fair Dealing Defence to Copyright Infringement* (November 2000) Research Paper No. 12, Centre for Media Communications and Information Technology Law, Law School, University of Melbourne.

²² If the answers to both questions were in the affirmative, members of the Stationers' Company would obtain a perpetual copyright monopoly in respect of the authors' copies of which they were assignees. Accordingly, in both cases the Company of Stationers argued the case that the common law right in the copy existed and continued subsequent to the Statute of Anne.

²³ (1769) 4 Burr at 2398, 98 E.R. at 206.

²⁴ (1769) 4 Burr at 2396, 98 E.R. at 251.

"'nothing can be an object of property, that is not capable of distinguishable proprietary marks' . . . what distinguishing marks can a man fix upon a set of intellectual ideas, so as to call himself the proprietor of them? They have no ear marks upon them; no tokens of a particular proprietor".²⁵

Yates J.'s view on the nature of copyright as property can, as a matter of law, be disregarded now. However, it echoes the concern the law has with insisting upon materiality as a condition of subsistence.²⁶

Five years later in *Donaldson v. Beckett*,²⁷ the House of Lords revisited this question. Whilst controversy surrounds the precise holdings of the House of Lords in this case²⁸ the weight of the invited advisory opinion of the judges of the King's Bench, Common Pleas and Exchequer²⁹ was in favour of the existence (both before and after publication) of a common law right of authors in their copy.³⁰ As only small portions of the speeches in the House of Lords were reported, any analysis of the reasoning is necessarily rendered speculative. Although the House of Lords is reported as voting in favour of recognising the existence of common law copyright prior to the passing of the Statute of Anne,³¹ at least two of its members doubted the existence prior to 1709 of any common law right in the copy.³² However, any view that the common law did not recognise copyright prior to 1709 seems quixotic today in light of the language of the Statute of Anne itself, which recognises in its very terms a pre-existing proprietary right. The first clause of the Statute reveals this:

"That from and after [April 10, 1710] the author of any book or books already printed, **who has not transferred to any other the copy or copies of such book or books**, share or shares thereof, or the bookseller or the booksellers, printer or printers, or other person or persons, **who has or have purchased or acquired the copy or copies of any book or books**, in order to print or reprint the same, shall have

²⁵ (1769) 4 Burr at 2365–6, 98 E.R. at 234–5.

²⁶ Compare the comments of Erle J. in *Jefferys v. Boosey* (1854) 4 H.L.C. 815 at 868 (see below, n. 58). In *Hinton v. Donaldson* (1773) Hailes 535, Scottish Law Lords provided their own opinions on the merits of the judgments in *Millar v. Taylor*. Confronted with the very same questions as were before the House of Lords in *Millar v. Taylor* and *Donaldson v. Beckett*, the Scottish Court rejected the notion that common law copyright ever existed. In so doing, Lord Auchinleck at 536 referred to the judges in *Millar v. Taylor* as "bewildered in the multiplicity of arguments". At which point Lord Hailes (who both sat on the case and reported the judgment) shared with the reader: "Lord Auchinleck told me that he had read the report of Burrows; that he understood Judge Yates's argument, but not the others. Now, said he, when I meet with a thing that I do not understand, I conclude it to be nonsense".

²⁷ (1774) 2 Brown 129, 1 E.R. 837.

²⁸ See Abrams, "The Historic Foundation of American Copyright Law: Exploding the Myth of Common Law Copyright" (1983) 29 Wayne Law Review 1119 at 1156–1171.

²⁹ Latman's *The Copyright Law* (1986) p. 4.

³⁰ Birrell (see above, n. 17), pp. 128–129.

³¹ (1774) 2 Brown 129 at 145, 1 E.R. 837 at 847 and (1769) 4 Burr 2408 at 2409–2412, 98 E.R. 257 at 258–259.

³² The portion of Lord Camden's speech which was reported indicated that his Lordship did not believe any common law rights in the copy existed whatsoever at any stage: *Cobbett's Parliamentary History*, Vol. 17 at p. 994. Similarly, Lord Chancellor Apsley, upon referring to the history of the passing of the Statute of Anne, suggested that it tended "to shew the sense of the legislature at the time of passing it to be against the right": *Ibid.* p. 1001.

the sole right and liberty of printing such book and books for the term of [21] years (emphasis added)."

Similarly, Aston J. in *Millar v. Taylor* could point to consistent references in Acts, proclamations and decrees over the centuries (including the Statute of Anne) to a species of proprietary interest being the author's copy in his or her literary work.³³

2.1.2 Did common law copyright continue after the Statute of Anne 1709?

On the second question, Lord Mansfield, speaking in the majority in *Millar v. Taylor*, stated that the Statute of Anne had no effect upon this common law right; "we are considering the common law upon principles before and independent of that Act".³⁴ Hence, the conclusion was arrived at that the Statute of Anne operated independently of any rights at common law. However, the majority in *Donaldson v. Beckett* over-turned this holding and held that this common law right had been divested by the Statute of Anne upon publication of the work. Accordingly, an author of a published work was precluded from every remedy, "except on the foundation of the said statute".³⁵ The House of Lords³⁶ had voted against any continued existence of perpetual common law copyright in published works.

Unpublished works, however, remained within the protection of the common law.³⁷ Such works attracted perpetual copyright protection until publication, at which time the author's claim to protection rested upon statute.³⁸

³³ (1769) 4 Burr at 2346, 98 E.R. at 225:

"This idea of an author's property has been so long entertained, that the copy of a book seems to have been not familiarity only, but legally used as a technical expression of the author's sole right of printing and publishing that work: and that these expressions, in a variety of instruments, are not to be considered as the creators or origin of that right or property; but, as speaking the language of a known and acknowledged right; and, as far as they are active, operating in its protection. This appears from the citations used at the Bar, from history, Acts of state, proclamations, and decrees in the Star-Chamber . . . also from the clauses in the ordinances and states antecedent to the Statute of Queen Anne; and from the expressions used in that statute too, which speaks with precision of this sort of property as a known thing; and which, with as much accuracy, supposes the licence and consent of the author or proprietor necessary to the printing of their works."

Compare the analysis by the Scottish Court of Session in *Hinton v. Donaldson* (1773) 1 Hailes 535. This case was decided after *Millar v. Taylor* and prior to *Donaldson v. Beckett*. The Scottish judges thought it absurd to suggest, in light of the Statute of Anne, that a prior common law right ever existed. Lord Kennet states at 536 that the Statute of Anne "takes not any right away. On the contrary, the rubric, the act of the legislature, looks as if there were no right to take way".

³⁴ (1769) 4 Burr at 2398, 98 E.R. at 252.

³⁵ Birrell (see above, n. 17), p. 126. In *Donaldson v. Beckett* (1774) 2 Brown 129 at 145, 1 E.R. 837 at 846 the question put to the Lords, read in part: "[I]s an author, by [the Statute of Anne] precluded from every remedy except on the foundation of the said statute, and on the terms and conditions prescribed thereby?" This was answered in the affirmative by the majority.

³⁶ Whose members included "several non-legal personages": Birrell (see above, n. 17), p. 131.

³⁷ *Jefferys v. Boosey* (1854) 4 H.L.C. 815 at 962. See also *In re Dickens; Dickens v. Hawksley* [1935] 1 Ch. 267 at 292-295.

³⁸ *In re Dickens; Dickens v. Hawksley* [1935] 1 Ch. 267 at 296. In 1911 this remaining species of common law copyright was abolished by statute: Copyright Act 1911, s. 31. However, until that time common law copyright coexisted with statutory copyright.

2.2 The position after *Donaldson v. Beckett*

As to the issue of correct characterisation of the Statute of Anne, *Millar v. Taylor* and *Donaldson v. Beckett* show that an outcome was arrived at whereby common law rights in the copy were recognised to have had an existence prior to 1709, which were supplanted by the rights provided in the Statute of Anne upon publication. The Act curtailed the term of protection but expanded remedies for infringement. So understood the Statute of Anne represents an evolutionary point in copyright law, not the starting point. Copyright law's foundations rest upon the common law right of authors in the copy. And those common law rights in turn rested upon the "laws of nature and truth".³⁹ This is well illustrated by the words of Aston J. in *Millar v. Taylor*:

"That to deprive a man of the fruit of his own cares and sweat; and to enter upon it . . . as if it were the effect of the intruder's pains and travails; is a most manifest violation of truth; it is asserting in fact, that to be his, which cannot be his".⁴⁰

However, once the Statute of Anne is regarded as a stage of evolution, founded upon the common law natural rights of the author to "the fruit of his own cares and sweat", immediate tension exists between the provisions in the Statute which requires a material form, and this underlying objective. On the one hand; *Millar v. Taylor* emphatically recognises that the rationale of copyright law lies in a natural right of an individual to the products of his or her mind which take the form of "a set of words and sentences and modes of expression".⁴¹ The Statute of Anne afforded protection only to "authors of books"; no protection was extended to any form of expression other than that taking the form of such a material embodiment.⁴² Consequently, at the passing of the Statute of Anne, works of authorship manifested purely in spoken words fell within the philosophy expressed by the majority in *Millar v. Taylor* (thereby warranting proprietary rights) but received no statutory protection by being outside the statutory formality, not taking the prescribed material form of a "book".

³⁹ (1769) 4 Burr at 2338, 98 E.R. at 220, *per* Aston J.

⁴⁰ *ibid.* See also (1769) 4 Burr at 2345, 98 E.R. at 224 where Aston J. states further:

"I do not know, nor can I comprehend any property more emphatically a man's own, nay, more incapable of being mistaken, than his literary works."

Compare the comments of Drone (see above, n. 5).

⁴¹ (1769) 4 Burr at 2398, 98 E.R. at 251.

⁴² Subsequent legislation defined "book" more widely but in a manner in which a material form was inherent (*i.e.* the Copyright Act 1842), s. 2 defined a "book" to "mean and include every Volume, Part or Division of a Volume, Pamphlet, Sheet of Letter-press, Sheet of Music, Map, Chart, or Plan").

2.3 Spoken words and copyright from the late Eighteenth Century to the late Nineteenth Century

2.3.1 *Hinton v. Donaldson* (1773)

The first judicial consideration of spoken word copyright arose by way of *obiter* statements in the Scottish decision *Hinton v. Donaldson*.⁴³ The Scottish Court of Session also had before it the issue of whether common law copyright existed prior to the Statute of Anne and continued after its enactment. The defendant, Donaldson, had reprinted in Scotland an edition of *History of the Bible* authored ostensibly by Stackhouse. The plaintiff Hinton, claimed to derive title to the work through Stackhouse and not under the Statute of Anne, but in reliance on a common law right. However, Stackhouse's work was, in turn, an "abridgment of the discourses pronounced at Mr Boyle's lecture".⁴⁴ Boyle, similar to Lord Rosebery in *Walter v. Lane*,⁴⁵ had no involvement in the litigation and no party claimed to derive any title from Boyle as the "spoken word author" of the underlying work. Whilst the majority of the Lords held that common law copyright never existed in Scotland, Lord Hailes made the following observation:

"Were we to copy the judgment of the King's Bench in the case of Miller against Tailor [sic]; were we to find that the common-law right of authors in England could be made effectual in Scotland; were we even to find that literary property was established in the law of nature and nations,—still we could not pronounce for the pursuer, unless we were to find that Stackhouse is an original author: *That I can never do*".⁴⁶

Lord Hailes indicates a view that even an abridgment of a third party's spoken words should not give rise to rights attached to authorship. This view was shared and expanded upon by the dissenting Lord Monboddo. Contrary to the majority, however, Lord Monboddo found for the existence of a common law right in literary property and that right was not taken away by the Statute of Anne.⁴⁷ His Lordship stated:

⁴³ (1773) 1 Hailes 535, this litigation is discussed in Ross, *Copyright and the Invention of Tradition* (1992) 26 Eighteenth Century Studies 1. In *Macklin v. Richardson* (1770) 2 Amb 694, 27 E.R. 451 an injunction was granted to restrain the publication, in the defendant's magazine, of a play which had been publicly performed but not published in printed form. However, this was not a "spoken word" copyright subsistence case: the author had it appears, reduced the play to a material (presumably handwritten) form: (1770) 2 Amb 694 at 695, 27 E.R. 451 at 452.

⁴⁴ (1773) 1 Hailes 535, Hailes L.J. at 537.

⁴⁵ [1900] A.C. 539, see below, 2.4.

⁴⁶ *ibid.* at 538 (emphasis added).

⁴⁷ *ibid.* at 538–539.

"No man has a property in *ideas*, but he has a *property in words*, which no man can take from him by a *mechanical operation*, without having any idea of the subject or even of the language."⁴⁸

Lord Monboddo's identification of the property in expression, as opposed to a material form of the expression, is compelling in light of *Millar v. Taylor*. It is a sentiment, however, which did not find favour with the English House of Lords over a century later in *Walter v. Lane*.⁴⁹

2.3.2 *Abernathy v. Hutchinson* (1824)

In 1824 Lord Eldon presided over *Abernathy v. Hutchinson*⁵⁰ where the question before the court was whether copyright could subsist "in sentiments and language, though not deposited on paper".⁵¹ The litigation concerned the printing and publication by a third party of medical lectures which had not been previously reduced in writing by the lecturer. When the matter first came before the Court of Chancery, Lord Eldon was of the view that *Millar v. Taylor* said a "great deal"⁵² on this point. However, his Lordship gave no opinion "upon the question of property in *language and sentiments* not put into writing "other than to say" that it is a question of mighty importance".⁵³ It is significant in itself that Lord Eldon regarded what *Millar v. Taylor* had to say on the nature of copyright as bearing upon the issue of subsistence in the spoken word.

Some six months later, when the case was again before the court, Lord Eldon denied relief based upon any form of copyright in the lecture. His Lordship is reported as stating:

"That where the lecture was orally delivered, it was difficult to say, that an injunction could be granted upon the same principle upon which literary composition was protected; because the Court must be satisfied that the publication complained of was an invasion of the written work, and this could only be done by comparing the composition with the piracy."⁵⁴

Relief was instead granted on the basis that the defendant must have obtained a transcription of the lectures from a student who was under a contract not to publish for

⁴⁸ *ibid.* at 539. It must be remembered that the case involved an underlying work which took the form of discourses given by a third party. It is in the light that Lord Monboddo's reference to "words" should be understood.

⁴⁹ [1900] A.C. 539, see below, 2.4. Lord Monboddo's proposition did not find favour with Lord Auchinleck who also sat on *Hinton v. Donaldson*. Lord Auchinleck (1773) 1 Hailes 535 at 536 stated:

"Has a man a right to the property of a *bon mot* as long as he lives, and his heirs after him? *Nescit vox missa reverti*. If once a man speaks out a sentiment, he communicates it to his hearers, and it is theirs for ever."

⁵⁰ [1824] Ch. 209.

⁵¹ *ibid.* at 217.

⁵² *ibid.*

⁵³ *ibid.* at 218.

⁵⁴ *ibid.* at 219.

profit. This was "sufficient to authorise the Court to say the defendants shall not publish".⁵⁵

The comments of Lord Eldon regarding the necessity of a work to exist in a material form so as to compare it against "the piracy" to determine infringement parallels the dubious logic sometimes used to justify an insistence on material form as a precondition to copyright subsistence—namely, that a work has no identity in the absence of a reduction to material form.⁵⁶ As previously asserted, material form is not essential for the identification of a work.⁵⁷ Further, insistence upon material form places an obstacle in the way of the underlying objective of copyright law identified in *Millar v. Taylor* as protecting, by way of proprietary right, the fruits of the intellectual expression.

The comments of Lord Eldon might be usefully contrasted with those of Erle J. in *Jefferys v. Boosey*:

"It is true that property in the order of words is a mental abstraction, but so are many other kinds of property. The notion . . . that nothing is property which cannot be earmarked, and recovered in detinue or trover, may be true in an early stage of society, when property is in its simple form, and the remedies for violation of it also simple; but is not true in a more civilised state, where the relations of life and the interests arising therefrom are complicated."⁵⁸

Also relevant is this observation of a New Zealand commentator:

"If there is a permanent recording of something it might be easier to establish whether it had been copied. But surely evidential problems are bridges that can be crossed when they have to be. If someone can overcome the obvious difficulties in establishing that a work that existed momentarily has been infringed why should they not succeed?"⁵⁹

These comments, made in support of the argument that copyright ought subsist in works which existed in a physical form momentarily, apply equally to subsistence of copyright in works never reduced to a material form.

⁵⁵ *ibid.* at 219. This is regarded as the genesis of the modern action in equity to restrain a breach of confidence.

⁵⁶ When the case first came before Lord Eldon, his Lordship entertained doubt as to whether the publication sought to be restrained could be identified with the lectures as the lectures had not been written out at full length, but were delivered orally from notes. The plaintiff produced the notes from which the lectures had been delivered, with an explanatory affidavit. This was apparently sufficient to allow identification for the purpose of liability under contract.

⁵⁷ Drone (see above, n. 5), pp. 6–8. Also *Estate of Ernest Hemingway v. Random House* (1968) 32 A.L.R. 3d 605 at 612 where the court commented (in the context of spoken words) that the difficulty of discerning the identity of a spoken work "would not be greater than in deciding other questions of degree, such as plagiarism".

⁵⁸ (1854) 4 H.L.C. 815 at 868.

⁵⁹ McLay, "Wither and Shadow: The Copyright Protection of Concepts, Characters and Titles" (1991) 21 Victoria University of Wellington Law Review 335 at 345.

2.3.3 *The Lectures Copyright Act 1835*

In 1835, some ten years after Lord Eldon denied relief in copyright for the reproduction of spoken words in *Abernathy v. Hutchinson*, "An Act for preventing the Publication of Lectures without Consent" ("The Lectures Copyright Act") was passed.⁶⁰ It provided that:

"the Author of any Lecture or Lectures, or the Person to whom he has sold or otherwise conveyed *the Copy thereof*, in order to deliver the same in any School, Seminary, Institution or other Place, or for any other purpose, shall have the sole right and liberty of printing and publishing such Lecture or Lectures".⁶¹

Forfeiture and a penalty was imposed upon infringers. However, the Act did not apply unless notice had been given to two Justices of the Peace at least two days before delivery, or if the lecture was delivered in a "public" college or university. In these cases, the saving provision that "the Law relating thereto shall remain the same as if the Act had not been passed" applied.⁶² In many respects, this piece of legislation is analogous to the Statute of Anne.⁶³ It referred to a (apparently) pre-existing proprietary right in the "copy" of a lecture.⁶⁴ It provided expanded scope for relief. It curtailed the right, not in a temporal sense, but by requiring prior notice.

The Lectures Copyright Act has received scant attention. Birrell, writing in 1899, stated that the statutory notice "is rarely if ever given".⁶⁵ In *Nichols v. Pitman*⁶⁶ and *Caird v. Syme*⁶⁷ the Act was referred to in the context of lectures which were outside its operation; the saving provision therefore applied. In the latter case the saving provision was said to give no assistance to resolving the dispute as it "professes to leave the law as it is without professing to give any hint of what it assumes the law to be".⁶⁸ However, as the Act unambiguously refers to the "Author of any Lecture" and "the Copy thereof", it would seem that the legislature took the view that the same common law rights which were reposed in authors of manuscripts immediately prior to the passing of the Statute of Anne were similarly reposed in lectures regardless of any absence of written form. Thus, a lecturer was regarded as the proprietor of the incorporeal and exclusive common law right to print and publish the words he or she delivered. The lecturer owned the "copy" in the lectures, as those words comprising

⁶⁰ 5 & 6 Will 65.

⁶¹ Section 1 (emphasis added). See above, 2.1, for an exposition of what significance was given to the concept of common law rights in the "copy" independent of statutory copyright.

⁶² Section 5.

⁶³ *Caird v. Syme* (1887) 12 H.L. (Sc) 326 at 355, where Lord Fitzgerald observes that the Act's preamble "is obviously taken" from the Statute of Anne.

⁶⁴ Again, Lord Fitzgerald in *Caird v. Syme* (1887) 12 H.L. (Sc) 326 at 356 states that "the statute seems at once in its first clause to recognise the property of the lecturer in his lecture". A comparable view was expressed by Aston J. in *Millar v. Taylor* in respect of the use of the expression "copy" in the Statute of Anne: (1769) 4 Burr at 2346, 98 E.R. at 225.

⁶⁵ Birrell (see above, n. 17), p. 192.

⁶⁶ (1884) 26 Ch. D. 374.

⁶⁷ (1887) 12 H.L. (Sc) 326.

⁶⁸ *ibid.* at 340.

the lecture were, to use the language of *Millar v. Taylor*, the "fruit of his own cares and sweat".⁶⁹

2.3.4 *Nicols v. Pitman* (1884)

Nicols v. Pitman was a lecturer case factually similar to *Abernathy v. Hutchinson* and was decided on a similar basis; the existence of *in personam* rights between lecturer and students. Kay J. held that:

"whether the lecture has been committed to writing beforehand or not the audience are quite at liberty to take the fullest notes they like for their own personal purposes, but are not at liberty, having taken those notes, to use them afterwards for the purpose of publishing the lecture for profit".⁷⁰

The Copyright Act 1842 was not considered by the court.

2.3.5 *Caird v. Syme* (1887)

Caird v. Syme,⁷¹ too, was factually similar to *Abernathy v. Hutchinson*. In this case, a lecturer sought to restrain publication of a set out of "crib" notes derived from his lectures. However, this case was decided on a somewhat different basis to *Abernathy v. Hutchinson*.

As noted earlier, even after the Statute of Anne common law copyright subsisted in unpublished works.⁷² This species of copyright was, however, readily confused by courts as rights pertaining to breach of confidence.⁷³ Lord Eldon's approach in *Abernathy v. Hutchinson* illustrates this confusion. After flirting with notions of common law copyright, ultimately his Lordship's decision can be seen as resting more on a "relational" basis of confidentiality as opposed to a "proprietary" basis of copyright.

The court in *Caird v. Syme* shared Lord Eldon's confusion. The basis upon which the House of Lords granted relief to the lecturer plaintiff in *Caird v. Syme* is not particularly clear. Whilst the majority in *Caird v. Syme* place reliance on Lord Eldon's judgment, relief appears to rest upon common law copyright subsisting in the lecture as an unpublished work. Lord Watson, speaking for the majority, refers to the delivery of a lecture by its "author" as giving rise to a "common law right of property".⁷⁴ However, to further add to the uncertainty, Lord Watson states:

⁶⁹ (1769) 4 Burr at 2338, 98 E.R. at 220, *per* Ashton J.

⁷⁰ (1884) 26 Ch. D. 374 at 381.

⁷¹ (1887) 12 H.L. (Sc) 326.

⁷² This position continued until the Copyright Act 1911 took effect.

⁷³ The confusion apparent in *Abernathy v. Hutchinson* and *Caird v. Syme* between equitable (*in personam*) rights of confidence and the common law (*in rem*) right of copyright is starkly acknowledged by section 31 of the Copyright Act 1911. In abolishing common law copyright it provided:

"nothing in this section shall be construed as abrogating any right or jurisdiction to restrain breach of trust or confidence."

Only the existence of serious confusion between the concepts would have given rise to the need for such a reservation.

⁷⁴ (1887) 12 H.L. (Sc) 326 at 350.

"Copyright, which is the exclusive privilege of multiplying copies after publication, is the creature of statute, and with that right we have nothing to do in the present case."⁷⁵

However, as confusing as the choice of language is, it was not the nature of the right which divided the court. Both majority and minority accepted that a right of common law property subsisted in the lectures.⁷⁶ The issue which did divide the House of Lords was whether the oral delivery of the lecture to the students amounted to a publication, such as to abandon common law copyright protection. Speaking for the majority, Lord Watson explains:

"The author of a lecture retains a right of property in his work which entitles him to prevent its publication by others until it has, with his consent, been communicated to the public. Since the case of *Jefferys v. Boosey* it must be taken as settled law that, upon such communication being made to the public, whether orally or by the circulation of written or printed copies of the work, the author's right of property ceases to exist."⁷⁷

His Lordship held that by delivery to his students, the lecturer did not "communicate his ideas and language to the public at large, or part with his common law right of property".⁷⁸ Accordingly, upon this proprietary right the court ordered that the lecturer could restrain "all other persons from publishing the said lectures without his consent".⁷⁹

In dissent, Lord Fitzgerald arrived at the contrary conclusion on the issue of publication, stating:

"the delivery of the lectures was a publication to the public at large, and that being such, the [lecturer] has abandoned to the public the exclusive rights which he otherwise had, and the protection which the common law would otherwise have afforded him".⁸⁰

Lord Fitzgerald acknowledged that his analysis was influenced by the policy expressed in the Lectures Copyright Act. Excluded from its protection were lectures given in a public university. The lectures the subject of the action in *Caird v. Syme* were such lectures; this suggested to his Lordship that their delivery ought be characterised as a "public" dedication.⁸¹

The outcome arrived at by the majority in *Caird v. Syme*, relying as it does upon common law copyright, accords with Lord Mansfield's conceptualisation of copyright

⁷⁵ *ibid.* at 343.

⁷⁶ Lord Fitzgerald in the minority speaks of the "exclusive rights" in the lectures "afforded by the common law": *ibid.* at 353.

⁷⁷ (1887) 12 H.L. (Sc) 326 at 343.

⁷⁸ *ibid.* at 350.

⁷⁹ *ibid.* at 360. This extract from the Form of Order indicates the proprietary characterisation of the right.

⁸⁰ *ibid.* at 353.

⁸¹ *ibid.* at 356-359.

in *Millar v. Taylor*.⁸² The result was permitted because the court was liberated from the material form requirements imposed by the statutory formulation of copyright.

2.4 *Walter v. Lane*

At the turn of the nineteenth century the issue of proprietary rights in the spoken word arose in the famous case of *Walter v. Lane*.⁸³ Public speeches of Lord Rosebery, which had never been reduced to writing by him (nor which had been the subject of statutory notice under the Lectures Copyright Act 1835) were reported verbatim in *The Times* newspaper. The defendant compiled those reports and published a book entitled *Appreciations and Addresses delivered by Lord Rosebery*. *The Times* brought an action in copyright infringement. Lord Rosebery was not a party to the litigation and no party to the litigation claimed any interest arising through him. This is not surprising. In the absence of any protection under the Lectures Copyright Act, to the extent that any common law copyright subsisted in the speeches as unpublished works, the public delivery of the speeches by Lord Rosebery rendered them "published" and thereby devoid of common law protection.⁸⁴

The tension between the rationale of copyright expressed in *Millar v. Taylor* (that the author of "a set of words and sentences and modes of expression" has property in "his own ingenuity and labour") and the operation of the law under copyright legislation (which mandated that ingenuity must take a material form to attract the rights of property) was put in sharp relief. The issue was grappled with by North J. at trial, the Court of Appeal and the House of Lords. Before North J., Scrutton, for the defendant, submitted:

"The fact that Lord Rosebery has taken no steps under the Act of 1835 to secure the copyright gives no power to reporters to acquire copyright. He is still the author, and could not be restrained by *The Times* from publishing his own speeches."⁸⁵

This found little favour with North J. who stated:

"The speaker, of course, has no copyright in the matter; copyright is the right to multiply copies of some original, and there is no original here in respect of which he could have held any copyright."⁸⁶

Rather, North J. found that copyright was reposed in the reporter who had taken down what was spoken. This could be regarded as an original work even where other

⁸² (1769) 4 Burr at 2398, 98 E.R. at 206.

⁸³ [1899] 2 Ch. 749, per North J., [1899] 2 Ch. 761, CA, [1900] A.C. 539, H.L.

⁸⁴ *Jefferys v. Boosey* (1854) 4 H.L.C. 815 at 962, *Caird v. Syme* (1887) 12 H.L. (Sc) 326 at 343.

⁸⁵ [1899] 2 Ch. 749, at 752.

⁸⁶ *ibid.* at 754. Interestingly, immediately prior to the *Walter v. Lane* litigation Lord Herschell introduced into the House of Lords a Copyright Bill, one clause of which read in part that "the author of any lecture shall be entitled to copyright therein as if the same were a book". This Bill was never passed into law: Birrell (see above, n. 17), pp. 208-211.

reporters had transcribed the same speech.⁸⁷ As to the position of the speaker *vis à vis* the reporter, North J. stated that "of course [the speaker] can publish [the speech] again either orally or in writing".⁸⁸ However, if the speaker is incapable or so doing without reproducing the reporter's transcription, North J. did not believe there to be any "hardship" in requiring the speaker to have to "get a copy of it from a person who has made a report".⁸⁹

In the Court of Appeal,⁹⁰ Birrell and Scrutton submitted as follows for the defendant.

"Transcription, however intelligent it may be, cannot confer copyright . . . These speeches were well-considered literary productions . . . There mere labour of copying words which already exist does not constitute originality. Lord Rosebery was the author of the literary composition . . . The present case is an attempt to reduce the amount of originality necessary to secure copyright to little or nothing. The plaintiffs' reports are not original; the words had been originally published by Lord Rosebery and given to the world."⁹¹

The Court of Appeal unanimously found for the defendant and overturned the ruling of North J. The Court noted that the Copyright Act 1842 (as did the Statute of Anne) conferred copyright on an "author" of a "book".⁹² Lord Rosebery could have no copyright, for speech in itself failed to fall within the "book" definition, "although he could have acquired copyright in it by putting it into writing".⁹³ The Court further held that the reporter could own no copyright in the report for failure to fall within the meaning of "author" as understood by the Court. The Court found that the reporter "has reproduced to the best of his ability not only the ideas expressed by the speaker, but the language in which the speaker expressed those ideas"⁹⁴ and held that "nowhere is [the term 'author'] used [in the Copyright Act] in the sense of a mere reporter or publisher of another man's verbal utterances".⁹⁵

The reference in the Court of Appeal to the reproduction of "the language in which the speaker expressed those ideas" underscores that a mere absence of material form does not convert oral "expression" to "idea".

The Court of Appeal's refusal to recognise copyright subsisting in the newspaper reports was a response to a failure to discern anything "intellectual" in what the reporters had done, in the sense that term is used in *Millar v. Taylor* by Lord

⁸⁷ "I do not see why each person should not have copyright, not in the speech, but the version of the speech which he has made": [1899] 2 Ch. 749, at 758, per North J.

⁸⁸ *ibid.* at 760.

⁸⁹ *ibid.* at 761.

⁹⁰ [1899] 2 Ch. 761.

⁹¹ *ibid.* at 763-6.

⁹² The Act did not define "author". Section 2 defined a "book" to "mean and include every Volume, Part or Division of a Volume, Pamphlet, Sheet of Letter-press, Sheet of Music, Map, Chart, or Plan".

⁹³ [1899] 2 Ch. 761 at 770.

⁹⁴ *ibid.* at 772 (emphasis added).

⁹⁵ *ibid.* at 770. A similar view was shared by Lord Hailes in *Hinton v. Donaldson* (1773) 1 Hailes 535 at 538.

Mansfield.⁹⁶ It is a refusal to protect under the guise of a copyright work the mechanical labours of a person who reduces to writing the expression of another; such labour falls outside the underlying policy of copyright law, anchored in the creative fruits of authorship. The Court of Appeal's refusal to recognise copyright subsisting in Lord Rosebery's speech was commanded by the legislation's insistence upon materiality; a failure of formality.

However, the outcome of the Court of Appeal's holding is that no rights whatsoever subsisted in the lectures as literary works. Lord Rosebery owned no copyright in them as he had not reduced them to a material form. *The Times* reporters, for want of originality, could not claim authorship of what they had transcribed. This seems a most peculiar result. Application of the proposition expressed by Lord Monboddo in *Hinton v. Donaldson*,⁹⁷ it is suggested, arrives at a far more satisfactory outcome: recognition that the speaker retains copyright in the words spoken, irrespective of any mechanical transcription of them.

Before the House of Lords,⁹⁸ Birrell and Scrutton put their case for the defendant one final time:

"The verbatim reporter . . . acts simply as the echo, the mocking bird, the slave of the speaker . . . To be an author one must think the thoughts, and choose the words and the order of them."⁹⁹

However, the Lords, as had North J., rejected the submission. Agreeing with the Court of Appeal that there can be no copyright reposed in Lord Rosebery for failure to satisfy the requirement of writing, their Lordships went on to state copyright did subsist in the reports of the speech. This was because "copyright has nothing to do with the originality or literary merits of the author or composer".¹ The reporter could be regarded as the "author" of the report of the speech, because:

"A reporter's art represents more than mere transcribing or writing from dictation. To follow so as to take down the words of an ordinary speaker, and certainly of a rapid speaker, is an art requiring considerable training, and does not come within the knowledge of ordinary persons."²

This view on the meaning of "authorship" renders it a mechanical concept, which may exist devoid of any true intellectual input. Lord Robertson's dissent exposes this:

"The contribution which education enables the good reporter to make to the speech is of a purely negative kind: he does not interfere, but faithfully acts as a conduit. In

⁹⁶ (1769) 4 Burr at 2396, 98 E.R. at 251.

⁹⁷ (1773) Hailes 535 at 539 (see above, n. 48).

⁹⁸ [1900] A.C. 539.

⁹⁹ *ibid.* at 542-543.

¹ *ibid.* at 552.

² *ibid.* at 554.

fact, the merit of the reports . . . is that they present the speaker's thoughts untingered by the slightest trace or colour of the reporter's mind . . . [T]he rival of a good stenographer . . . is the phonograph . . . which has no literary taste, good or bad, and no intellect, great or small, will record Lord Rosebery's speeches better than the best of reporters. The appellants think that if the owner of a phonograph publishes the speech as taken down by the phonograph he is the author of the report and entitled to copyright. I should have thought (and think) that this is a *reductio ad absurdum* of the whole argument of the appellants."³

Driving both North J. and the House of Lords to order injunctive relief was the feeling that the defendant had "reaped where it had not sown".⁴ However, such characterisation of the defendant's conduct suggests that resort was being made to copyright law to find a remedy more aptly founded in another branch of the law. Misappropriation of another's labour does not give rise to copyright subsistence. *Miller v. Taylor* establishes that the law grants a propriety interest in an expression where that expression is the fruit of a person's intellect. *Millar v. Taylor* says nothing regarding the position of the person who merely exerts labour to embody the expression emanating from another. Copyright law ought not recognise authorship in the reporters simply to prevent the reporters' labour being misappropriated by a third party. Protection of the labour which the reports themselves represent should be done (if at all) through an unfair competition doctrine.⁵

Resort was more readily able to be made to copyright reposing in the reporters in the absence of any copyright reposing the Lord Rosebery. If Lord Rosebery were treated as the proprietor of copyright in the speeches, *The Times* and its reporters are better thought of as merely implied non-exclusive licensees.⁶ That is, *The Times* and its reporters would be treated as impliedly licensed by Lord Rosebery to reproduce the speech in a material form. This licence would not, necessarily, extend to the defendant's activities in the case.

³ *ibid* at 560-561. The comparison to the phonograph had been made in submissions by Birrell and Scrutton before the Court of Appeal: [1899] 2 Ch. At 765. It is also alluded to with prescience by Lord Monboddo in *Hinton v. Donaldson* (1773) 1 Hailes 535; (see above, 2.3.1).

⁴ [1900] A.C. 539 at 552.

⁵ The following passage in *International News Service v. Associated Press* (1918) 2 A.L.R. 293 at 301-303 (in the context of the U.S. equitable doctrine of unfair competition) could apply *pari passu* to the position of *The Times* in *Walter v. Lane* (emphasis added):

"[T]he right to acquire property by honest labour or the conduct of a lawful business is as much entitled to protection [in equity] as the right to guard property already acquired . . . In doing this [the] defendant, by its very act, admits that it is taking material that has been acquired as the result of organization and the expenditure of labour, skill, and money, and which is salable by the complainant for money, and that [the] defendant, in appropriating it and selling it as its own, is endeavouring to reap where it has not sown."

⁶ Assuming the speech was given at a public setting where anyone was free to transcribe or otherwise record the speech (implied licences have been elsewhere briefly discussed in this context: Burley, "My Word" (1991) 141 N.L.J. 812).

2.5 Spoken words and Twentieth Century legislation

2.5.1 *The Copyright Act 1911*

Some years after *Walter v. Lane* the Copyright Act 1911 was enacted. It repealed⁷ both the Copyright Act 1842 and the Lectures Copyright Act 1835. Whilst abolishing common law copyright,⁸ it defined "lecture" to include "address, speech, and sermon" and treated such as an unpublished literary work to which the full rights of copyright were attached.⁹

The Act also provided that the following act was not an infringement of copyright:

"The publication in a newspaper of a report of a lecture delivered in public, unless the report is prohibited by conspicuous written or printed notice affixed before and maintained during the lecture."¹⁰

The logic in providing this express exception to infringement is that a report of a public lecture constitutes a reproduction of the literary work expressed in the lecture and so, in the absence of the exception, would be within the exclusive rights of the copyright owner, the speaker. The Act inserted an express provision that copyright subsisted in an "original" literary work.¹¹ It could thus be argued that under the 1911 Act copyright would not subsist in a mere report of a public lecture, since the report (as distinct from the lecture itself) would not be original.¹² Whether or not this view is correct remains

⁷ Copyright Act 1911, Sched. 2.

⁸ Copyright Act 1911, s.31.

⁹ Copyright Act 1911, s.1(1)(b), (2) and (3). The treatment of spoken words as a "literary" work might appear odd, given the usual connotation "literary" has with "written composition": *The Concise Oxford Dictionary* (6th ed.). However, this treatment of spoken words under the 1911 Act is indeed consistent with post-modernist analysis: van Peer, "Text" (1994) 5 *The Encyclopedia of Language and Linguistics* 4564 at 4568. Van Peer postulates a definitional framework of "text" as being "linguistic constructions" which ought not be restricted to written or printed material, because "oral texts do function in literate society too". See Pila and Christie, "The Literary Work Within Copyright Law: An Analysis of its Present and Future Status" (1999) 13 *Intellectual Property Journal* 134 at 167.

¹⁰ Copyright Act 1911, s.2(1)(v). Compare the provisions of the Lectures Copyright Act 1835 which required prior notice of the lecture to be given to two justices of the peace: see above, 2.3.3. Compare also the New York Court of Appeal in *Estate of Ernest Hemingway v. Random House* (1968) 32 A.L.R. 3d 605 at 613 (see above, 3.4):

"[I]t would, at the very least, be required that the speaker indicate that he intended to mark off the utterance in question from the ordinary stream of speech, that he meant to adopt it as a unique statement and that he wished to exercise control over its publication."

¹¹ Copyright Act 1911, s.1(1).

¹² This view was expressed by Cross J. in *Robertson v. Lewis (Trading as Virginia Music)* (1960) [1976] R.P.C. 169 at 174. See, however, *Sands & McDougall v. Robinson* (1917) 23 C.L.R. 49 at 52-57 where the High Court of Australia reached the contrary conclusion, holding that the word "original" in copyright legislation did not imply inventive originality. Under this approach, it would be enough to obtain copyright subsistence that the work is the product of something in new form as a result of the skill, labour and judgment of the reporter. This latter view has found support in *Express Newspapers v. News (U.K.)* [1990] 3 All E.R. 376 at 381.

unresolved, because there were no spoken word copyright cases under the 1911 legislation.¹³

The provisions of the 1911 Act in their treatment of the spoken word bring the law far closer to the policy of copyright as outlined in *Millar v. Taylor*, the creator of original expression being accorded the rights of proprietorship of that expression irrespective of absence of material form.

2.5.2 *The Copyright Act 1956*

These comments in respect of the 1911 Act could not be applied to the Copyright Act 1956. This Act excised all references to "lecture" and "speech", and reverted to attaching copyright only to literary works which were "made".¹⁴ Although "artistic work" was extensively defined,¹⁵ "literary work" was scantily defined to include "any written table or compilation".¹⁶ The position as to whether spoken words could constitute a literary work was left unclear, although the tenor of the Act's provisions—in particular repeated usage of "made" and "making"—suggested that subsistence was predicated upon reduction to a material form.

This view of the operation of the 1956 Act was arrived at by the 1977 Whitford Copyright Committee, which reported that:

"Speeches and lectures delivered extempore do not acquire copyright unless and until fixed."¹⁷

Further, the Committee reported that "if a speech is taken down in shorthand it is arguable that this amounts to the creation of a literary work in which the person speaking owns the copyright, the shorthand writer being a mere amanuensis".¹⁸ Later, the Committee recommended:

"We think it would be right to make it clear that, as and when [speeches and lectures are] fixed, albeit by someone else, a copyright in the material should be created which will vest in the speaker."¹⁹

¹³ There are, however, two Canadian cases on copyright in spoken words, decided under the Canadian Copyright Act RSC 1985, s. C-42, the relevant provisions of which (ss.2 and 5(1)) are essentially the same as those of the 1911 Act: *Gould Estate v. Stoddart* (1996) 74 C.P.R. 3d 206 (first instance) and (1998) 161 D.L.R. (4th) 321 (Ontario Court of Appeal and *Hager v. ECW Press* (1999) 85 C.P.R. 3d 289. Notwithstanding the insertion of an express originality requirement and the absence of an express materiality requirement in the Canadian legislation, the Canadian courts have continued to apply the principles of *Walter v. Lane* in casting biographers as the authors of quotations obtained from their subjects.

¹⁴ Copyright Act 1956, s.2. The term "made" was left undefined.

¹⁵ *ibid.* s.3(1) and 48.

¹⁶ *ibid.* s.48(1) (emphasis added).

¹⁷ Whitford Committee, *Report on Copyright* (1977) Cmnd. 6732 at para. 590. Again no speech cases arose under the 1956 Act.

¹⁸ *ibid.* para. 589 (emphasis added). Clearly this was "arguable"; it was the very argument put by Birrell and Scrutton without success before the House of Lords in *Walter v. Lane*! "Amanuensis", meaning "one who copies or writes from dictation", has its origins in "a manu" meaning "secretary" and "ensis" meaning "belonging to": *The Concise Oxford Dictionary*, 6th ed.

¹⁹ *Report on Copyright* (see above, n. 17) para. 590.

This sentiment reflects the *Millar v. Taylor* underpinning of copyright law in the fruits of the intellect, and rejects the *Walter v. Lane* application of copyright subsistence absent intellectual input. However, it also reflects the continued concern with reduction to material form. The Committee did not even consider the possibility of copyright subsisting at the time the words are spoken. The 1956 Act has re-entrenched the notion of materiality as a precondition to subsistence, and in so doing enlivened the tension between the philosophy of copyright as distilled in *Millar v. Taylor* and its statutory specification. The recommendation of the Committee only partially alleviated this tension by recognising authorship in spoken words, yet remaining wedded to the material form requirement for subsistence.

Further, the Committee recommended that there ought also be:

"a separate copyright in the recording or transcript as such, whether or not made with the consent of the speaker, such copyright to vest in the maker of the recorded version. To exploit the recorded version it would therefore be necessary to obtain the consents of the owner of the copyright in the speech or lecture and the owner of the copyright in the recorded version thereof".²⁰

Earlier the Committee had noted that the Association of Official Shorthand Writers had submitted that shorthand reporting "involves a degree of skill and/or labour which should entitle a shorthand writer to protection".²¹ Similar to the approach of the House of Lords in *Walter v. Lane*, the Committee's recommendation was based on the mistaken assumption that copyright protection ought be founded upon labour devoid of original expression. The fact that shorthand writing involves "skill and/or labour" is irrelevant. If this requires protection it should not be done through a body of law which is concerned with protection expression emanating from the human mind. As argued above, such "skill and/or labour" is more aptly protected through an unfair competition doctrine.²²

2.5.3 *The Copyright, Designs and Patents Act 1988*

In 1988 the Copyright, Designs and Patents Act was enacted. It provides that the "author", in relation to a work, means the person who creates it".²³ This definition alludes to the rationale of copyright law described in *Millar v. Taylor*. It provides a sounder basis of authorship than that in the 1956 Act of being one who "made" a work. Further, "literary work" is defined to mean "any work other than a dramatic or musical work, which is written, spoken or sung".²⁴ However, the Act then goes to great pains to require material form as a precondition to subsistence. Subsections (2) and (3) of section 3 provide as follows:

²⁰ *ibid.* para. 590.

²¹ *ibid.* para. 589.

²² See above, 2.4.

²³ Copyright, Designs and Patents Act 1988, s.9(1). Section 11(1) further provides that "the author of a work is the first owner of any copyright in it". In *Cala Homes (South) Limited v. Alfred McAlpine Homes East Limited* [1995] F.S.R. 818, Laddie J. made at 835 the following observation: "In my view, to have regard merely to who pushed the pen is too narrow a view of authorship. What is protected by copyright . . . is more than just the skill of making marks on paper or some other medium."

²⁴ Copyright, Designs and Patents Act 1988, s.3(1) (emphasis added).

"(2) Copyright does not subsist in a literary, dramatic or musical work unless and until it is recorded, in writing or otherwise; and references . . . to the time at which such a work is made are to the time at which it is so recorded.

(3) It is immaterial for the purposes of subsection (2) whether the work is recorded by or with the permission of the author, and where it is not recorded by the author, nothing in that subsection affects the question whether copyright subsists in the record as distinct from the work recorded."²⁵

Consistent with the recommendations of the Whitford Committee, the Act operates so as to retrospectively vest copyright in the speaker upon any reduction to material form. However, as to whether a separate copyright ought subsist in the record made by the person who causes reduction to a material form, the English legislature displays notable indecision ("nothing in that subsection affects the question") in leaving the matter open to further judicial exposition.

The operation of these provisions in the context of spoken words was debated in the House of Lords when the Copyright, Designs and Patent Bill was passing through the Committee stage. Lord Denning raised the issue succinctly:

"I always understood that the shorthand writer who took down a speech held the copyright. I think that position ought to be altered and I believe that in a way this Bill does it already: namely, that when a speech is recorded, copyright resides in the person who makes the speech at the time that it is recorded but not in the mere amanuensis who takes it down."²⁶

On this issue Lord Beaverbrook stated: "The Government are not convinced that the mere recording of an extempore speech in general should attract separate copyright from the speech itself."²⁷ Later he added:

"It is, I believe common ground that the author of a speech is the speaker and not the person who writes it down or records it in some other way . . . What we are now concerned with is the position of the person recording the speech, in particular a person who writes it down and so has no sound recording or film copyright he can claim. The only authority on the matter antedates the 1911 Act and ascribed copyright to a reporter. Whether the courts would still follow the precedent of *Walter v. Lane* is uncertain . . . The clause . . . would allow the possibility that the recorder

²⁵ Generally, one would expect that the reproduction which constitutes an alleged infringement of a non-material work such as spoken words will also be the reduction to a material form giving rise to subsistence. However, a contrary view is taken by Phillips, to the effect that the words "unless and until" in s.3(2) preclude a first unauthorised reduction to material form giving rise to infringement contemporaneously with subsistence: Phillips, "Copyright in Spoken Words—Some Potential Problems" [1989] E.I.P.R. 231 at 231–232.

²⁶ The parliamentary debates (Hansard), House of Lords Official Report, November 30, 1987, 838. This was clearly not lost on Lord Denning after the Bill was enacted. In 1991 his Lordship threatened resort to copyright infringement in relation to certain words appearing in a magazine article, spoken by him as an off-the-record comment in the course of an interview. The matter never proceeded to court: Burley, "My Word!" (1991) 141 N.L.J. 812.

²⁷ The parliamentary debates (Hansard), House of Lords Official Report, November 30, 1987, 837.

may have a separate copyright, leaving it to the courts to decide in any given case whether he has expended sufficient skill and sufficient effort to merit copyright."²⁸

An occasion arose in *Express Newspapers v. News (U.K.)*²⁹ for consideration of the operation of these provisions. A rival had copied another newspaper's report of the words spoken by a pregnant member of the royal family, a Miss Ogilvy.³⁰ In an application for summary judgment, Browne-Wilkinson V.-C. considered whether a "separate" copyright existed in the report. Holding that *Walter v. Lane* remained good law, the Vice-Chancellor pointed to section 3(3) of the 1988 Act reinforcing this position, referring as it did "to the possibility of the recorder of spoken words having a copyright in the record of those words as distinct from the words recorded".³¹ The circularity between the legislature and the court verges on the amusing. The legislature, albeit "not convinced that the mere recording of an extempore speech in general should attract separate copyright form the speech itself",³² leaves the question open for the courts to decide the issue. The court decides the issue in favour of a separate reporters copyright on the basis that the legislature's leaving the question open implicitly acknowledged the copyright's existence!

The 1988 Act is an improvement over both the position taken by the House of Lords in *Walter v. Lane*, and that which pertained under the 1956 Act. However, the concern with material form detracts from the Act's attempt to ensure copyright in spoken words subsists consistent with the natural law rationale for copyright expressed in *Millar v. Taylor*.³³ The justification of the material form requirement has been explained on the basis that "materiality is essential to the determination of the identity of a thing".³⁴

²⁸ The parliamentary debates (Hansard), House of Lords Official Report, March 29, 1988, 610-611.

²⁹ [1990] 3 All E.R. 376.

³⁰ *ibid.* at 378. Similar to Lord Rosebery, Miss Ogilvy was not a party to the dispute and neither party claimed any interest arising through her.

³¹ *ibid.* at 381. Further, Browne-Wilkinson V.-C. found that the skill and judgment of the reporter in taking down the words spoken by Miss Ogilvy in the context of an interview was "at least as much (and in my view greater)" than that of the reporters in *Walter v. Lane* in taking down the words spoken in public speeches of Lord Rosebery. Compare Lord Monboddoo's view in *Hinton v. Donaldson* (1773) 1 Hailes 535 at 539.

³² The parliamentary debates (Hansard), House of Lords Official Report, November 30, 1987, 837.

³³ Such insistence on materiality does not, *per se*, violate any international copyright norms. Article 2(2) of the Berne Convention for the Protection of Literary and Artistic Works (1886) provides:

"It shall, however, be a matter for legislation in the countries of the Union to prescribe that works in general or any specified categories of works shall not be protected unless they have been fixed in some material form."

See also Gendreau, "The Criterion of Fixation in Copyright Law" (1994) 159 *Revue Internationale du Droit D'Auteur* 110 at 134, where the commentator notes that the 1988 Act is not inconsistent with this Article.

³⁴ Drone (see above, n. 5), p. 6.

Identification is merely a problem of proof which can be overcome.³⁵ It is likely in spoken word litigation under the 1988 Act that the first reduction to a material form may give rise to both copyright subsistence in the literary work and an alleged infringement of that copyright.³⁶ It is pointless in this context to justify the material form requirement on an identification basis; the material embodiment may have no connection whatsoever with the author of the spoken words. The very issue in dispute might be whether the alleged reduction of the spoken words to a material form was, in fact, derived from the plaintiff's spoken words.

3. UNITED STATES OF AMERICA

3.1 Statutory copyright subsistence

In 1789 the United States' Constitution was ratified. It provides in part:

"[The Congress shall have Power] . . . [t]o 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*."³⁷

The commentary of the Copyright-Patent Clause pithily states:

"The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of the common law. The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals."³⁸

³⁵ McLay, "Wither and Shadow: The Copyright Protection of Concepts, Characters and Titles" (1991) 21 *Victoria University of Wellington Law Review* 335 at 345. See also Gendreau, "The Criterion of Fixation in Copyright Law" (1994) 159 *Revue Internationale du Droit D'Auteur* 110 at 130-131, where the Canadian commentator notes in respect of oral works:

"That they are capable of being protected is unquestionable in countries where fixation is not required. Naturally, in such countries, legal decisions are to be found in which infringement of an oral work is analyzed with the nuance that the nature of the work imposes. It is also striking to note that legal literature always mentions, though briefly, the difficulties caused, in the case of oral works, by the absence of fixation, difficulties which nevertheless are easily overcome."

³⁶ Section 3(3) of the Copyright, Designs and Patents Act 1988 states that "It is immaterial . . . whether the work is recorded by or with the permission of the author". In contrast, s.101 of the U.S. Copyright Act 1976 provides (emphasis added):

"A work is 'fixed' . . . when its embodiment in a copy or phonorecord, *by or under the authority of the author*, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."

³⁷ Art. I, para. 8, cl. 8 (emphasis added).

³⁸ *The Federalist* No. 43 at 309. This commentary is attributed to James Madison.

In 1790 the first Federal Copyright Act was adopted.³⁹ It provided a proprietary interest emanating from the authorship of "any map, chart, book or books", consistent with the approach taken in the Statute of Anne in specifying particular material fixations. However, unlike the position in England, the province of Federal statutory copyright in the U.S. is circumscribed by the terms of the Constitutions which limits copyright subsistence to "writings". *Nimmer on Copyright* notes in relation to this constitutional stipulation:

"Although there are no decisions directly so holding, it would seem that in order for a work to constitute a writing it must be embodied in some tangible form. If the word 'writings' is to be given any meaning whatsoever, it must at the very least denote 'some material form, capable of identification and having a more or less permanent endurance'."⁴⁰

In the current Copyright Act 1976, copyright is said to subsist in works "fixed in any tangible medium of expression",⁴¹ elsewhere defined to mean:

"when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived for a period of more than transitory duration".⁴²

In the absence of Constitutional amendment, there is little doubt that Federal statutory copyright protection will not extend to spoken words until those words are reduced to a material form. Importantly, unlike the position in England, the author's consent to the reduction to a material form is required. Without such agreement in the event of a third-party fixation, an oral work in the U.S. remains (as a matter of law) not "fixed in any tangible means of expression", and therefore outside statutory copyright protection.⁴³

There has been limited judicial consideration of the issue of copyright subsisting in spoken words under the 1976 Act. In *Rokeach v. AVCO Embassy Pictures*,⁴⁴ the plaintiff transcribed and then published in a book certain phrases or statements spoken by his

³⁹ Act of May 31, 1790, (1845) Ch. 15, 1 Stat. 124.

⁴⁰ *Nimmer on Copyright*, para. 1.08[C][2]. Compare *Goldstein v. California* (1973) 412 U.S. 546 at 561:

"Although the word 'writings' might be limited to script or printed material, it may be interpreted to include any physical rendering of the fruits of creative intellectual or aesthetic labor."

⁴¹ 17 U.S.C., s.102.

⁴² 17 U.S.C., s.101 (emphasis added).

⁴³ Rugha, "Ownership of Interviews. A Theory for Protection of Quotations" 67 Nebraska Law Review 675 at 677: "In theory, oral statements taped without the interviewee's knowledge or authority are unfixed". The commentator goes on to note that hitherto courts had rarely addressed the "authority distinction" which left its importance unclear: *ibid.* at 678. In *Rowe v. Golden West TV* (1982) 445 A 2d 1165 (see below, 3.5.3) the court appeared to treat fixation without authority as sufficient for the 1976 Act.

⁴⁴ (1978) 197 U.S.P.Q. 155.

psychiatric patients.⁴⁵ The plaintiff claimed that the reproduction of those statements in the defendants' play and motion picture was an infringement of copyright. Tenney J. of the District Court for the Southern District of New York held that "in no real sense can [the plaintiff] claim to have created these statements".⁴⁶ Since the plaintiff was not the author of these statements, the inclusion of them in the play and film was not an infringement of any copyright owned by the plaintiff.

Consistent with *Rokeach*, in *Suid v. Newsweek Magazine*⁴⁷ and *Craft v. Kobler*⁴⁸ the District Court of Columbia and the District Court for the Southern District of New York (respectively) held that where a speaker's words are transcribed by another, for the purposes of the 1976 Act the speaker is the author of those words.⁴⁹ In both cases the plaintiffs were parties who had interviewed famous persons and had transcribed their words. The plaintiffs were permitted to proceed in their claims for infringement upon the assignment or devolution to the plaintiffs of the speakers' copyright in the words.⁵⁰

The U.S. Copyright Office practice with respect to copyright registration under the 1976 Act is consistent with the approach taken in these cases. The Office states:

"A work consisting of an interview often contains copyrightable authorship by the person interviewed and the interviewer. Each as the right to claim copyright in his or her own expression in the absence of an agreement to the contrary."⁵¹

Thus, where spoken words are fixed (that is, reduced to a material form) in the U.S. with the authority of the speaker, statutory copyright may subsist in those words.⁵² If so, the speaker will be regarded as the author of that expression and (subject to any agreement or employment arrangements entered into) the owner of copyright in that expression.⁵³

⁴⁵ Two examples of these statements are "habeas corpus parchment round your neck" and "my spirit, it rises with the high watermark in Palestine": *ibid.* at 161.

⁴⁶ *ibid.*

⁴⁷ (1980) 503 F. Supp. 146.

⁴⁸ (1987) 667 F. Supp. 120 (SDNY).

⁴⁹ (1980) 503 F. Supp. 146 at 148; (1987) 667 F. Supp. 120 (SDNY) at 122.

⁵⁰ *ibid.*

⁵¹ *Compendium II of Copyright Office Practices* (1984), para. 317.

⁵² Questions of degree may arise in respect of fixation. For example, one commentator has observed that "interviews preserved through random notetaking probably are unfixed": Rugha, "Ownership of Interviews: A Theory for Protection of Quotations", (1988) 67 Nebraska Law Review 675 at 679.

⁵³ The erroneous approach of Kelly J. of the District Court for the Eastern District of Pennsylvania in the 1987 unreported decision *Phillips v. Inc. Magazine* [1987 U.S. Dist LEXIS 1948] must be noted. There, the words spoken by the plaintiff in consensual telephone interview to the defendant's journalist and reproduced verbatim by the defendant was held to have not been fixed so as to subsist under the 1976 Act. The court characterised the plaintiff as transferring over the telephone "unfixed ideas" which "were not copyrightable and were not protected under the copyright laws when communicated to and used by the defendant". The court's analysis has been described by one commentator as "flawed": Rugha, "Ownership of Interviews: A Theory for Protection of Quotations", (1988) 67 Nebraska Law Review 675 at 687.

3.2 Common law copyright subsistence

Unlike the position in England, in the U.S. common law copyright continues to exist together with Federal statutory protection in respect of any subject matter not falling within the scope of the Copyright Act 1976. Such copyright is relevant today to works (such as those taking the form of purely spoken words) which do not subsist in a material form.

3.2.1 *Wheaton v. Peters* (1834)

In 1834 the Supreme Court first considered the existence of common law copyright in *Wheaton v. Peters*.⁵⁴ The question before the Court was whether a suit could be brought in common law copyright in respect of an unpublished work which did not qualify for statutory copyright protection.⁵⁵ The majority opinion, delivered by Justice McLean, stated:

"That an author, at common law, has a property in his manuscript, and may obtain redress against anyone who deprives him of it, or by improperly obtaining a copy endeavours to realize a profit by its publication, cannot be doubted."⁵⁶

This accords with the position in England in relation to unpublished works after *Donaldson v. Beckett* and prior to the passing of the 1911 Act. The *Wheaton v. Peters* majority assumed that common law copyright in unpublished works continued notwithstanding the enactment of Federal copyright legislation. However, the case further established that:

- (i) English common law copyright in respect of published works was not received into the U.S.⁵⁷; and
- (ii) publication under the U.S. Copyright statute divested an author of common law copyright protection.⁵⁸

⁵⁴ (1834) 33 U.S. 591.

⁵⁵ It didn't qualify for statutory copyright protection because of a failure to comply with deposit requirements applying under the Federal statutory copyright legislation.

⁵⁶ *ibid.* at 655.

⁵⁷ The question of whether English common law relating to copyright was received into U.S. common law prior to the ratification of the Constitution is difficult to answer. The general position was that the first English settlers to America brought with them only so much of the common law as was "suited to their condition". The U.S. Supreme Court, by majority, in *Wheaton v. Peters* (1834) 33 U.S. 591 held that common law copyright of England was not "brought into the wilds of Pennsylvania by its first adventurers", it being unsuited to their condition (*ibid.* at 658-660). However, it has been noted that when applying this criterion for the reception of English law into the American colonies "the judges proceeded like housewives shopping for dinner to select what seemed tempting in the shelves of the common law market": Goebel, *Cases and Materials on the Development of Legal Institutions* (1946), p. 314. Moreover, it is important to bear in mind that there is no Federal common law in the U.S., only State common law, and the U.S. Supreme Court is not the final arbiter of the scope and content of the common law of any State, save only in those particular areas where the law may come in conflict with Federal statutes or treaties, or with the Constitution itself: *Mynard v. Syracuse RR Co.* (1877) 71 N.Y. 180 at 185-186. See generally Whicher, "The Ghost of *Donaldson v. Beckett*" (1961-2) 9 Bulletin Copyright Society of the USA 102 at 194 and Abram, "The Historic Foundation of American Copyright Law: Exploding the Myth of Common Law Copyright" (1983) 29 Wayne Law Review 1119.

⁵⁸ (1834) 33 U.S. 591 at 661; *Nimmer on Copyright* (see above, n. 13), para. 4.02[C].

3.2.2 *Oral delivery and publication*

This then begs the question whether the public delivery of spoken words constitutes a "publication" in the U.S. such as to deny to the spoken work common law protection? As has been noted previously, in England *Jefferys v. Boosey* and *Caird v. Syme* had established that public delivery of spoken words amounted to a "publication" of the work at common law. The prevailing rule in the U.S. has been and is that publication requires the original work or tangible copies thereof being made available to the public. The 1976 Act specifically provides in respect of statutory copyright that a "public performance or display of a work does not of itself constitute a publication".⁵⁹ The same rule has been applied in respect of common law copyright in the U.S., so that in the *Estate of Hemingway v. Random House*, the New York Court of Appeals stated:

"The public delivery of an address or a lecture or the performance of a play is not deemed a 'publication', and accordingly, it does not deprive the author of his common-law copyright in its contents."⁶⁰

Just as mere spoken words Constitutionally can never qualify for Federal statutory copyright protection, so too it seems that merely speaking works will not constitute a "publication" so as to divest common law protection.

3.2.3 *Residual common law copyright*

Common law copyright's relationship with statutory copyright was clarified, almost a century and a half after *Wheaton v. Peters*, in *Goldstein v. California*.⁶¹ The Supreme Court majority held that States retained concurrent jurisdiction to afford copyright protection to the works of authors⁶² so long as such protection did not conflict with Federal law. The Copyright Act 1976 Act effectively codified this *Goldstein* holding, by providing that the Act did not annual or limit any rights or remedies under the common law or statutes of any States with respect to subject matter not falling within that specified in the 1976 Act, "including works of authorship not fixed in any tangible medium of expression".⁶³ However, in the same Act the Federal legislature assumed jurisdiction for unpublished works reduced to writing⁶⁴ thereby limiting the concurrent jurisdiction of the States to works which are not "writings", or (in the language of the 1976 Act) "works of authorship not fixed in any tangible medium of expression".⁶⁵ These are explicitly designated by the Act to remain within the concurrent common law copyright jurisdiction of the States.⁶⁶ Thus, this State jurisdiction includes common law copyright protection for purely spoken words.

⁵⁹ 17 U.S.C., s.101.

⁶⁰ (1968) 32 A.L.R. 3d 605, at 611-612. See also *Williams v. Weisser* (1969) 38 A.L.R. 3d 761, at 775-6: "The oral delivery of lectures did not divest plaintiff of his common law copyright to his lectures. Nothing tangible was delivered to the students".

⁶¹ (1973) 412 U.S. 546.

⁶² The court noted that "author" has been construed to mean an "originator", "he to whom anything owes its origin": *ibid.* at 561.

⁶³ 17 U.S.C., s.301(b)(1).

⁶⁴ 17 U.S.C., s.301(a).

⁶⁵ 17 U.S.C., s.301(b)(1).

⁶⁶ *ibid.*

In reliance upon this residual common law copyright jurisdiction, California has enacted legislation purporting to protect unpublished, unfixed works:

"The author of any original work of authorship that is not fixed in any tangible medium of expression has an exclusive ownership in the representation or expression thereof as against all persons except one who originally and independently creates the same or similar work. A work shall be considered not fixed when it is not embodied in a tangible medium of expression or when its embodiment in a tangible medium of expression is not sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration, either directly or with the aid of a machine or device."⁶⁷

This provision protects within its ambit (*inter alia*) the authors of purely spoken literary works. Although this provision has not been the subject of any reported spoken word copyright litigation, American courts (and particularly those in New York) have in other contexts considered the subsistence of State common law copyright in purely spoken words.

3.3 *Jenkins and Columbia Broadcast System*

3.3.1 *Jenkins v. News Syndicate* (1926)

In *Jenkins v. News Syndicate*⁶⁸ a U.S. court had its first occasion to consider the application of the subsistence of common law copyright in purely spoken words. The New York Supreme Court had before it a case in which the plaintiff claimed the newspaper defendant had a conference with her in relation to her plans for the form and substance of articles she proposed to write for the newspaper. An oral synopsis was given solely for the purposes of negotiating a contract for the articles. The negotiations collapsed. However the newspaper, without the plaintiff's consent, published an article purporting to be an interview with plaintiff which included an accurate reproduction of the form and substance of the articles proposed, expressed in the precise language of the plaintiff. Glennon J. in an interlocutory motion refused to strike out the plaintiff's claim in common law copyright, stating:

"Assuming, as we must, that the allegations set forth in plaintiff's complaint are true, I am of the opinion that plaintiff has a right to obtain money damages from defendant. It should be borne in mind that defendant sought to buy the literary property from plaintiff . . . We find literary, dramatic, and musical creations among those which are recognized as property by the common law."⁶⁹

Glennon J. cited authority, including *Millar v. Taylor*, for the proposition that common law copyright protected the light of first publication in such works, and applied this to a work whose sole manifestation was spoken words. The citation of *Millar v. Taylor* in

⁶⁷ California Civil Code, s.980(a)(1).

⁶⁸ (1926) 219 N.Y. Supp. 196.

⁶⁹ *ibid.* at 198.

this context, with its concern for the natural rights flowing from products of the intellectual expression regardless of medium, is particularly interesting.

3.3.2 *Columbia Broadcast System Inc. v. Documentaries Unlimited* (1964)

Spoken word copyright next arose in the New York Supreme Court action of *Columbia Broadcast System Inc. v. Documentaries Unlimited*.⁷⁰ The Court restrained the defendant from distributing a phonographic record which reproduced a radio news announcement made by a broadcaster of the plaintiff. The defendant had argued that no common law copyright could subsist unless the matter possessed artistic or literary value or was "fresh" news which had not passed into the public domain. However, the Court found that the broadcaster "did not merely repeat the news releases handed to him but added to them matter of his own composition".⁷¹ Further, the Court added that "a broadcaster's voice and style of talking is, to all intents and purposes, his personality, a form of art expression, and his distinctive and valuable property".⁷² Accordingly, the defendant was found to have appropriated another's property right.⁷³

In *Columbia* the Court's connecting of "personality rights" with the common law copyright in spoken words confuses the issue. The two are discrete rights of action and ought not be run together as though they are merely different aspects of the one principle. However, this approach has been followed elsewhere.⁷⁴

3.4 *Estate of Ernest Hemingway v. Random House*

Estate of Ernest Hemingway v. Random House, although denying relief, is a high-water mark for spoken word copyright. The case was litigated twice at trial before the New York Supreme Court (for interlocutory⁷⁵ and then final relief⁷⁶) and then on appeal before the New York Court of Appeals.⁷⁷ The defendants were the publishers of a biography of Ernest Hemingway, in which the then deceased Hemingway was extensively quoted verbatim. Such quotations arose from conversations to which the author of the biography was also a party. The action, brought by Hemingway's widow,

⁷⁰ (1964) 248 N.Y.S. 2d 809.

⁷¹ *ibid.* at 811.

⁷² *ibid.*

⁷³ *ibid.* at 812. Further, the Court restated the rule that "public performance of a work, such as delivery of a speech, singing of a song, or reading of a script, whether given in public or over the radio or television, is not such a general publication as constitutes a dedication to the public or places it in the public domain, with consequent loss of copyright . . . A public performance in and of itself does not deprive an unpublished work from the protection accorded at common law": *ibid.* at 812-813.

⁷⁴ In 1964, a New York court granted to the members of the music group The Beatles a temporary injunction which restrained the defendant from commercially using a record of their spoken words: *Lennon v. Pulsebeat News* (1964) 143 U.S.P.Q. 309. Markowitz J. of the New York Supreme Court followed *Columbia Broadcasting System* in describing (at 309) the facts before him as an "analogous situation". Markowitz J. stated that "it is obvious that the defendant was motivated by the appeal the plaintiffs' unique personalities and manner of speaking would have for certain segments of the public".

⁷⁵ (1966) 268 N.Y.S. 2d 531.

⁷⁶ (1967) 279 N.Y.S. 2d 51.

⁷⁷ (1968) 32 A.L.R. 3d 605. For a note on the *Hemingway* litigation, see Williams, "The Protectibility of Spontaneous Oral Conversations Via Common Law Copyright" (1969-70) 13 IDEA 263.

included a claim for the infringement of common law copyright in the conversation of Hemingway claimed to be owned by the Hemingway Estate.

3.4.1 First instance proceedings

The application for interlocutory relief was heard before Frank J., who observed that he was:

"confronted with the novel and provocative question as to whether a person's participation in spontaneous oral conversations with friend over a course of years, in distinction to lectures or prepared dialogues, may be considered a literary work subject to a common-law copyright. It appears that this question of possible categorization of ordinary conversation as a literary work or property is one of first impression".⁷⁸

After noting that the question raised the issue of a possible limitation upon free speech, "an area pregnant with social and historical implications",⁷⁹ and therefore that social cost and public interest ought to be considered, Frank J. decided the case on an altogether different basis. He considered that the respective contributions of participants to a conversation (in this case the author of the biography and Hemingway) reflect a duality which defies "dissection or divisibility".⁸⁰ According, it was:

"difficult to see how conversation can be held to constitute the sort of individual intellectual production to which protection is afforded by way of a common-law copyright".⁸¹

The reasoning of Frank J. in denying common law copyright subsistence in Hemingway's conversations seems to be erroneously premised upon the notion that copyright can never subsist in a work of joint authorship. Under the Copyright Act 1976 the authors of a "joint work" are co-owners of copyright⁸² and a "joint work" is defined as a "work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole".⁸³ A similar approach could be taken in common law copyright to a literary work manifested in a

⁷⁸ (1966) 268 NYS 2d 531 at 536.

⁷⁹ *ibid.*

⁸⁰ *ibid.* at 537.

⁸¹ *ibid.*

⁸² 17 U.S.C., s.201(a).

⁸³ 17 U.S.C., s.101.

conversation between various parties.⁸⁴ Under U.S. statutory copyright law, each co-owner of a joint work obtains an individual ownership in the whole of the work, including any portion thereof.⁸⁵ As a general rule, a co-owner may, without reference to the other co-owners, exploit the work (or any part of the joint work) or grant non-exclusive licences to third parties.⁸⁶ Denying common law copyright upon "indivisibility" of the contributions by the participants to a conversation is neither consistent nor logical.

Similar reasoning was employed when the application for final relief came before Schweitzer J. Identifying as the "nub" of the case of the question "Can Ernest Hemingway or his representatives assert any literary property right in his oral conversations with [the author]?"⁸⁷ the court answered the question in the negative, adopting the reasoning of Frank J.,⁸⁸ and adding that no party to a conversation could ever restrain in common law copyright another party to the conversation from publishing the oral expression involved. However, the court noted by way of *obiter* that under some circumstances "such as where the speaker was in effect dictating to a passive receiver, he might have a claim to property in the recorded material".⁸⁹

3.4.2 The New York Court of Appeals

In the Court of Appeals, the Court prefaced its analysis with the observation in *Nimmer on Copyright* that:

"The underlying rationale for common law copyright (*i.e.* the recognition that a property status should attach to the fruits of intellectual labor) is applicable regardless of whether such labor assumes tangible form."⁹⁰

The Court then proceeded to critique both grounds upon which the lower courts rested their decisions. In relation to the "free speech" concerns, the Court of Appeals stated:

⁸⁴ This view has been expressed elsewhere. Hirsch, "Copyrighting Conversations: Applying the 1976 Copyright Act to Interviews", (1982) 31 The American University Law Review 1071 at 1083 states that: "a participant in a conversation should be considered a joint author of comments made by coparticipants". *Nimmer on Copyright* at para. 6.03 states that all that is required for joint authorship is that "each author at the time he creates his contribution intend that it shall constitute a part of a total work to which another shall make (or already has made) a contribution": *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.* (1944) 140 F. 2d 266. The contrary view, that each conversation the subject of the *Hemingway* case was not a work of joint authorship but two separate works of individual authorship, has been expressed: Note, "Copyright: Right to Common Law Copyright in Conversations of a Descendent" (1967) 67 Columbia Law Review 366 at 367. It should not be noted that this view largely equates with the position taken by the Copyright Office in respect of oral interviews fixed under the 1976 Act: (see above, n. 51, para. 3.1).

⁸⁵ *Nimmer on Copyright* at para. 6.06.

⁸⁶ *ibid.* at para. 6.10.

⁸⁷ (1968) 279 N.Y.S. 2d 51 at 59.

⁸⁸ In particular, Schweitzer J. included reference to the public interest: "Were anyone to have common law copyright in mere conversations (as opposed to prepared lectures or speeches), then the same right would have to extend to every-one. The effect on freedom of speech and press would be revolutionary": *ibid.* at 60.

⁸⁹ *ibid.* at 60-61.

⁹⁰ (1968) 32 A.L.R. 3d 605 at 611.

"The indispensable right of the press to report on what people have done, or on what has happened to them or on what they have said in public does not necessarily imply an unbounded freedom to publish whatever they may have said in private conversation."⁹¹

In relation to the "indivisibility of contributions" concern, the Court, by way of footnote, remarked: "In the case of some kinds of dialogue or interview, that difficulty would not be greater than in deciding other questions of degree, such as plagiarism".⁹² Concisely—and it is suggested correctly—the Court of Appeals refuted the reasoning of the two lower courts.

In its place the Court of Appeals based its decision upon the practice of Hemingway to approve during his lifetime of similar published works of the author, in which Hemingway had been extensively quoted verbatim. Any common law copyright that may subsist in the conversations and be within Hemingway's estate was held to have been impliedly licensed by Hemingway, prior to his death, to be reproduced by the author in the biography.⁹³

As to whether any common law copyright actually subsisted in the conversations, the Court found it unnecessary to express a concluded view. However it did, by way of *obiter*, consider at length in what circumstances such subsistence might arise. The Court, alluding to the philosophical underpinnings of copyright law in *Millar v. Taylor*, stated:

"Copyright, both common-law and statutory, rests on the assumption that there are forms of expression, limited in kind, to be sure, which should not be divulged to the public without the consent of their author. The purpose, far from being restrictive, is to encourage and protect intellectual labor."⁹⁴

In relation to products of such "intellectual labour" which merely take the form of spoken words, the Court stated:

"Assuming, without deciding, that in a proper case a common-law copyright in certain limited kinds of spoken dialogue might be recognized, it would, at the very least, be required that the speaker indicate that he intended to mark off the utterance in question from the ordinary stream of speech, that he meant to adopt it as a unique statement and that he wished to exercise control over its publication. Such an indication is, of course, possible in the case of speech. It might, for example, be found in prefatory words in inferred from the circumstances in which the dialogue takes place."⁹⁵

⁹¹ *ibid.* at 612.

⁹² *ibid.* (emphasis added). Compare the comments of Drone, *A Treatise on the Law of Property in Intellectual Productions* (1879), to the effect that the identity of a work may be determined in the absence of materiality.

⁹³ (1968) 32 A.L.R. 3d 605 at 613.

⁹⁴ *ibid.* at 612.

⁹⁵ *ibid.* at 613.

At which point the Court relied upon *Jenkins* as an instance where the circumstances of the delivery of the oral synopsis to the newspaper gave rise to such an indication. Further, the Court suggested an alternative approach might be to presume "that the speaker has not reserved any common-law rights unless the contrary strongly appears".⁹⁶

3.4.3 *Advantages of the Court of Appeals approach*

This analysis of the Court of Appeals is particularly insightful.⁹⁷ The Court grapples with the consequences which flow from subsistence of copyright in spoken words. It seizes upon pragmatic and intuitive means of ensuring the protection afforded is neither unwarranted nor unwieldy. The principles of this approach are two-fold:

1. It is a precondition upon any exercise of exclusive rights in spoken subject matter that, at the time the work is spoken, it must have been designated (either expressly or impliedly) as an expression in which the speaker wishes to exercise control.
2. There is a presumption that in all other spoken subject matter, the speaker has not reserved any right and the spoken subject matter may be freely used by third parties.

This approach has the particular appeal of balancing the interests of the authors of spoken words and of those who may seek to reproduce those words. It has similarity with the position in England under the Lectures Copyright Act 1835 and the Copyright Act 1911, both of which required some form of prior notice for an author to be able to assert copyright in purely spoken words.⁹⁸ Importantly though, and again similar to the English statutes of 1835 and 1911, the Court does not treat the matter of lack of material form as one going to subsistence; copyright will subsist in any event. Rather, the Court is dealing with the ability to exercise exclusive rights attached to common law copyright subsisting in spoken words.⁹⁹

3.5 The cases after *Hemingway*

Subsequently, the matter has been considered three times by American courts. On each occasion relief has been denied and no attempt has been made to build upon the analysis of the Court of Appeals in *Hemingway*.

⁹⁶ *ibid.*

⁹⁷ However, *Nimmer on Copyright*, at para. 2.02, is critical of two aspects of the Court of Appeals formulation; the introduction of the need for a "unique intellectual product" and the requirement of notice.

⁹⁸ See above, 2.3.3 and 2.5.1, respectively. Such designation may have been at least partially attributable to the transitory and intangible nature of speech.

⁹⁹ This jurisprudence could be of assistance to U.K. courts when they come to deal with the consequences of the 1988 Act, which creates *ex post facto* subsistence in spoken words upon reduction to a material form. For example, the matter of whether or not Lord Denning had designated assertion of copyright for his off-the-record comments (see above, n. 26, para. 2.5.3) might be an appropriate criterion for an English court to resolve the issue of infringement, relying upon the New York Court of Appeals in *Hemingway*.

3.5.1 *Current Audio v. RCA Corporation* (1972)

Four years after *Hemingway*, in *Current Audio v. RCA Corporation*,¹ the New York Supreme Court again had occasion to consider spoken word copyright in the context of words spoken by Elvis Presley in a press conference. Frank J. (the presiding judge for the interlocutory motion in *Hemingway*) struck out a claim based upon such copyright. The case was distinguished from *Columbia* by pointing out that the crucial feature of that case was that the broadcaster's "voice and style of talking" was a "form of art expression, and his distinctive and valuable property".² Frank J. found the case before him to be in stark contrast:

"The spontaneous 'give and take' of an unrehearsed public press conference is of a wholly different character than the delivery of a formal speech or address, or the performance of a musical or artist work."³

Echoing his "free speech" comments in *Hemingway*, Frank J. found the fact the words were expressed in the context of a press conference made denial of a common law copyright in the case all the more compelling:

"Indeed in many ways a press conference stands as the very symbol of a free and open press, using that term in its broadest sense to encompass all the media, in providing public access to, and direct communication with, the notable and newsworthy. To hold, as defendant urges, that one who has freely and willingly participated in a public press conference has some property right which supersedes the right of its free dissemination and permits such party to control or limit its distribution would constitute an impermissible restraint upon the free dissemination of thoughts, ideas, newsworthy events, and matter of public interest."⁴

Although passing reference was made to the Court of Appeals' judgment in *Hemingway*, Frank J. did not rely upon its two-step approach of affording subsistence automatically, and then looking towards the circumstances to ascertain enforceability. Rather, Frank J. simply denied subsistence due to the fluid nature of the expression and its taking place in a press conference. The former as a matter of underlying objectives should not be relevant. The latter may be relevant in going to whether, using the Court of Appeals' analysis, the author had designated the expression as one in which rights in common law copyright will be asserted.

3.5.2 *Falwell v. Penthouse International* (1981)

Equally disappointing was Turk J.'s approach in the Federal District Court in *Falwell v. Penthouse International*.⁵ The spoken words in which copyright was asserted took place in an interview between the Reverend Jerry Falwell and a reporter from *Penthouse*

¹ (1972) 337 N.Y.S. 2d 949.

² As has been observed above, this ground is properly viewed as distinct from the common law copyright issue in the case.

³ (1972) 337 N.Y.S. 2d 949 at 953.

⁴ *ibid.*

⁵ (1981) 521 F. Supp. 1204.

magazine. Falwell sought to restrain publication in (amongst other grounds) common law copyright. The Court commenced its analysis with the dubious assertion that "[t]he existence of common law copyright protection for the spoken word has not been established by any court".⁶ The court then stated:

"Plaintiff cannot seriously contend that each of his responses in the published interview setting forth his ideas and opinions is a product of his intellectual labors which should be recognised as a literary or even intellectual creation".⁷

It is unlikely that this incredulity would have been expressed if precisely the same exchange took place by way of a written series of questions, sent to Falwell, to which he provided written answers. Copyright would clearly subsist in Falwell's written responses. The position with respect to spoken responses should be no different.

Similar to *Columbia*, the Court also refers to the "spontaneous" nature of the responses and the fact they took place in the context of a magazine interview, as tending against copyright being "cognizable".⁸ Spoken words may be a rambling stream of consciousness or may be precisely thought out, arranged and chosen. Similarly, written words may be described using precisely the same dichotomy. Whether words (spoken or written) fall at one extreme or the other, or somewhere in between, ought not be the determinate of subsistence of copyright.⁹

The Court concluded its analysis with the quixotic statement that the plaintiff's spoken words "do not come within the narrow circumstances where a cause of action involving an oral expression can be sustained under a common law copyright theory".¹⁰ Precisely what those "narrow circumstances" were thought to be was not stated; no reference was made to the Court of Appeals' analysis in *Hemingway*.

3.5.3 *Rowe v. Golden West TV* (1982)

In *Rowe v. Golden West TV*¹¹ the Superior Court of New Jersey considered common law copyright in spoken words in a unique setting. The plaintiff, an inmate at a State prison, had devised an interactive dramatic presentation, known as the "Juvenile Awareness Program". This presentation was described by the Court as:

"a confrontational session which was conducted by inmates serving life sentences and attended by juveniles who had begun experiencing difficulties with the law. During the course of each session the inmates exposed the youths to the realities of

⁶ *ibid.* at 1207. The Court failed to cite both *Jenkins* and *Columbia*, both cases recognising common law copyright subsistence for the spoken word in interlocutory proceedings.

⁷ *ibid.* at 1208.

⁸ *ibid.*

⁹ An illustration of such "rambling stream of consciousness expressions" which are now regularly reduced to a material form is afforded by the Internet application *Internet Relay Chat*, which facilitates real time communications between geographically remote users. Messages are typed and sent by one user at his or her terminal, appearing moments thereafter on the screen of another user's terminal. That user may then reply. Each participant may or may not choose to save a transcript of the "conversation".

¹⁰ (1981) 521 F. Supp. 1204 at 1208.

¹¹ (1982) 445 A 2d 1165.

prison life by depicting the harshness and brutality of their incarceration in a raucous and uncensored manner. Each session differed from the other depending upon the reactions of the youths in attendance. It was the basic hope of the program that the juveniles would be 'scared straight'.¹²

The plaintiff asserted that he was the author of the program. Although the actual sessions themselves were unscripted, he gave evidence that he "instructed the inmates as to the contents of their talks with the juveniles as well as the method of conveying these thoughts to the juveniles".¹³ Rehearsals had been held "to insure that the correct message would be delivered to the children".¹⁴ A television documentary was made regarding the program. Though its makers obtained the consent of the inmates who participated, they did not obtain the consent of the plaintiff.

The Court stated that under New Jersey law, common law copyright protection was only afforded to "every new and innocent product of mental labour, which has been embodied in writing, or some other material form".¹⁵ However, in light of the limited reservation in the Copyright Act 1976,¹⁶ this material form requirement for subsistence leaves common law copyright little scope in New Jersey.¹⁷ The Court noted the plaintiff's claims, in attempting to overcome this requirement, that:

"the sessions themselves are the tangible expressions of his conceptualisation. More specifically, he maintains that the sessions are dramatizations of prison life which he has structured by instructing the inmates on what to say to the juveniles and on how to say it, and by rehearsing with them".¹⁸

Intellectual input from the plaintiff was no doubt required to realise this dramatic expression. However, the plaintiff's argument was rejected by the trial judge¹⁹ who is reported by the Appeal Court as stating "plaintiff's concept was never sufficiently fixed or frozen" to warrant copyright protection. The trial judge went on:

"The *fluid, free-flowing* education . . . program, where no script existed and audience reaction and inmate participation changed with each presentation, was not a concrete

¹² *ibid.* at 1166-7.

¹³ *ibid.* at 1167.

¹⁴ *ibid.*

¹⁵ *ibid.*

¹⁶ 17 U.S.C. s.301(b), discussed above, 3.1.

¹⁷ The only works which could fall within this concept are those which satisfy *both* of the following requirements:

- (i) they have been reduced to a tangible form without the consent of the author; and
- (ii) they have never been reduced to a material form by (or with the consent of) the author.

¹⁸ (1982) 445 A 2d 1165 at 1168.

¹⁹ The trial judge had handed down a "letter opinion".

expression of an idea of plaintiff's that rose to the level of a tangible product deserving of a common law copyright."²⁰

This conclusion was not over turned by the Appeal Court. The comments regarding the work's "fluid, free flowing" nature echo those in *Falwell* and *Current Audio* with their references to the "spontaneous" nature of speech. Further, the Appeal Court stated that even if the sessions were sufficient to warrant common law copyright protection, the plaintiff's claim in State common law copyright would fail by reason of the work falling within the ambit of the Federal Copyright Act 1976, as the work had been fixed in a tangible form by the making of the documentary. The correctness of this holding, as a matter of statutory construction of the Copyright Act 1976, must be seriously doubted.²¹

No reference was made by the Court to the analysis of the Court of Appeals in *Hemingway*.

4. CONCLUSION

A summary of the issues covered in this paper in respect of spoken words, common law copyright, material form requirements and the concept of publication in both England and the U.S. is set out in the table on the following page.

Returning to the screen play synopsis illustration from *The Player*, English and U.S. copyright law present far from straightforward answers to the question of whether copyright subsists in the spoken synopsis.

Under the English 1988 Act, the answer is no, unless there is some reduction to a material form. Once there is reduction to material form, copyright subsists in the spoken synopsis, and the copyright is owned by the speaker. This is so even if the reduction is made without the consent of the speaker. It is uncertain, however, whether a separate copyright subsists in the record of the synopsis and, if it does, who owns the copyright and what is the relationship between that copyright and the copyright in the spoken synopsis.

²⁰ (1982) 445 A 2d 1165 at 1168 (emphasis added). The comments made above regarding the irrelevance of the spontaneity or "free flow" of spoken words apply equally.

²¹ The Court held that the filming of the session for the documentary was a "fixing", thereby the work has been "created" under the Copyright Act 1976 and fell within its ambit. No reference was made to the definition in s.101 of the Act:

"A work is 'fixed' . . . when its embodiment in a copy or phonorecord, *by or under the authority of the author*, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." (Emphasis added).

However, the filming (on the express finding of the Court) took place without the plaintiff's consent.

	England before the Statute of Anne	England after the Statute of Anne, prior to the Copyright Act 1911	England under the Copyright Act 1911	England under the Copyright Act 1956 and the Copyright, Designs and Patents Act 1988	U.S. under the Copyright Act 1976 and State common law
Common law copyright in published works?	Yes	No—abolished by the Statute of Anne	No	No	Yes—possible under State common law, but only for works not “fixed” under the Copyright Act 1976
Common law copyright in unpublished works?	Yes	Yes	No—expressly abolished	No	Yes—possible under State common law, but only for works not “fixed” under the Copyright Act 1976
Requirement of reduction to material form under common law?	No	No	Not applicable	Not applicable	Generally no—however a matter for State common law
Requirement of reduction to material form under statute?	Not applicable	Generally yes—but not under the Lecturers Copyright Act 1835	Generally yes—however material form not required for “lectures”	Yes. Under the Copyright, Designs and Patents Act 1988 material form requirement is met even if reduction occurs without author’s consent	Yes—however any fixation must occur with author’s consent
Copyright subsists in spoken words not reduced to a material form that are publicly delivered?	Uncertain	Yes—under the Lectures Copyright Act 1835	Yes—if a “lecture”	No	Yes—recognisable as a matter of State common law
Copyright subsists in spoken words not reduced to a material form that are not publicly delivered?	Yes—although distinction between confidence, contract and copyright is not clear	Yes—under common law	Yes—if a “lecture”	No	Yes—recognisable as a matter of State common law

Under current U.S. copyright law, the Federal legislature is constitutionally prohibited from affording copyright protection to unfixed works of authorship. Even where a work has been reduced to a material form, it will remain unfixed under the

1976 Act if the reduction occurred without the consent of the author.²² Thus, there will be no copyright under the 1976 Act unless the synopsis has been recorded by or with the consent of the speaker.²³

There is, however, residual State jurisdiction separate from the Federal statute, which permits the subsistence of copyright in spoken words. At least one State has given statutory recognition of copyright subsistence in intangible subject matter such as speech.²⁴ Nevertheless, it must be noted that under the residual State jurisdiction:

- (i) relief has never been granted in unambiguous reliance upon such copyright;
- (ii) the circumstances in which such copyright might be asserted have been described by courts only by way of *obiter*; and
- (iii) on one occasion materiality has been (paradoxically) insisted upon.

The treatments afforded to spoken words by the copyright laws of England and the U.S. seem far removed from those which one might expect from a body of law whose underlying objectives in 1769 was anchored in protecting the fruit of the intellect. The concern with material form appears to emanate from both the historical association of copyright with “books” and the ancient notion (albeit dispelled as long ago as *Millar v. Taylor*) that property can only reside in matter able to be materially identified.

Consistent with its underlying objectives, copyright law ought recognise subsistence in any perceptible expression which emanates from the intellect of a person and is intended to appeal to the aesthetic sense or intellect of others, regardless of materiality. It can be seen that in the context of the spoken word an undue focus upon material form leads to results not consistent with the objective of allowing an author “to reap the pecuniary profits from his own ingenuity and labour”.²⁵

²² *ibid.*

²³ Ruhga, “Ownership of Interviews. A Theory for Protection of Quotations” (1988) 67 Nebraska Law Review 646 at 677.

²⁴ California Civil Code, s.980(a)(1).

²⁵ *Millar v. Taylor* (1769) 4 Burr 2302 at 2398, 98 E.R. 201 at 252.