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ABSTRACT

This paper briefly summarizes the Copyright Act recently passed by the United States Congress as it relates to graphic arts and points out that the law ignores the major problem facing that field: the lack of copyright protection for typography and typeface designs. It then explains the reasoning used for denying protection to typography and traces the development of United States copyright law on this point, concluding with discussion of a new federal appellate court decision confirming that typography is not subject to copyright. The paper next presents an alternative way that graphic arts designers may protect their works: the "unfair competition" concept growing from a 1918 Supreme Court decision. It concludes that while typography may indeed be protected in this fashion, it can be done so only on a state-by-state basis.
(Author/FL)

THE GRAPHIC ARTS AND THE NEW COPYRIGHT ACT

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ABSTRACT

After 20 years of debate, Congress has finally enacted a new Copyright Act. Unfortunately, though, the long-awaited new law failed to resolve the major copyright problem facing the graphic arts: the lack of copyright protection for typography and typeface designs. Moreover, a Congressional review of the problem apart from the Copyright Act, seemingly promised in the House report on the new act, has not occurred in four years.

This paper briefly summarizes the Copyright Act as it relates to graphics. Next, the paper explains the rationale for denying copyright protection to typography and traces the development of American copyright law on this point, concluding with a new federal appellate court decision that affirms the non-copyrightability of typography.

However, another federal court decision on typography and copyright suggests that there is an alternate way graphic arts designers may protect their works from infringement in the absence of copyright coverage.

This paper analyzes that alternative and suggests that typography may indeed be protected in this fashion, albeit only on a state-by-state basis because of another federal court ruling.

INTRODUCTION

On Jan. 1, 1978, a new comprehensive Copyright Act went into effect, the first major revision of American copyright law since 1909.[1] The new law, which was enacted after more than 20 years of deliberations in Congress, was widely noted for its effect on the cable television industry, on photocopying, and on musicians.[2] But almost nothing has been said of what the new law did--and didn't do--for the graphic arts.

The new Copyright Act has a significant effect on graphics and the graphic artist, and on those in such related fields as advertising design, magazine and newspaper layout work, and typography. Perhaps more important, however, are the areas of silence in the new Copyright Act, which left unresolved the major uncertainties facing the graphic artist, particularly by declining to solve the problem of copyright protection for typography and typeface designs. And even worse, a recent federal appellate court decision has further clouded the copyright status of typography.[3]

This paper examines the new Copyright Act as it relates to graphics. After summarizing the highlights of the new act itself, we address the problems of typography and copyright law, exploring a possible alternative form of protection for the graphic artist denied a copyright.

THE NEW COPYRIGHT ACT - WHAT IT COVERS

The new Copyright Act continued and expanded many of the forms of copyright protection available under the old 1909 law. One may copyright a wide variety of works, as long as they evidence two

qualities: (1) creativity; and (2) originality. A work need not have very much of either quality--but there must be a little of each.[4] A work need not be novel: if two people get the same idea independently at about the same time and complete their works on their own, both may secure copyrights even though their works may be identical.[5]

There are seven major categories of creative works that may be copyrighted:

1) literary works;

2) musical works, including any accompanying words;

3) dramatic works, including any accompanying music;

4) pantomimes and choreographic works;

5) pictorial, graphic and sculptural works;

6) motion pictures and other audiovisual works;

7) sound recordings.[6]

On the other hand, there are a number of things that cannot be copyrighted, among them:

1) factual and historical information;

2) works that are not fixed in a tangible form (e.g. choreography, improvisional speeches and other performances that are neither written down nor recorded);

3) ideas, processes, methods, and devices (though some of these may be registerable under patent law);

4) works consisting entirely of information that involves no original authorship (e.g. calendars, tape measures and rules, schedules of sporting events, etc.)[7]

5) short titles, names and slogans (though some of these may be registerable as trademarks);

6) typefaces and type designs.

Obviously, for the graphic artist the most important category of copyrightable works is (5). For many years the courts and the U.S. Copyright Office regulations have recognized that such things as advertising designs, editorial layouts, drawings and sketches, diagrams, photography, and works combining various of these elements are copyrightable.[8]

On the other hand, basic shapes and designs (such as circles, squares, hexagons and other figures) cannot be copyrighted. And--of importance to the graphic artist--neither typefaces themselves nor type designs may be copyrighted.[9] However, calligraphy may be copyrightable--depending on its degree of stylization. But where does type designing end and calligraphy begin? The history, scope and possible solutions to the typeface copyright problem will be discussed more fully in the second part of this paper.

Once you have a work that is copyrightable, what must you do with it to secure a copyright?

SECURING A COPYRIGHT

Probably no aspect of the new Copyright Act is more widely misunderstood than the steps required to secure a copyright--unless it is the consequences of omitting some of those steps.

One of the major features of the new Copyright Act is a basic simplification of the system, eliminating the separate rules for protecting published and unpublished works.[10] Until 1978, there was a system called "common law copyright," which operated under the laws of the 50 states, not under federal law.

In that system, any unpublished work had automatic copyright protection, but only under state law, and there was a problem of developing good evidence to establish ownership in the event of a law suit. And once a work was published, the common law copyright was lost. On publication, if the work wasn't copyrighted under the federal system ("statutory copyright"), it fell into the "public domain;" that is, all private ownership rights were lost.

The new Copyright Act changed that completely. Under the new law, there is no common law copyright; federal copyright protection begins as soon as the work is put down on paper, recorded on film or tape, or otherwise "fixed in a tangible form." However, the time of publication is still a crucial turning point: if a work is copyrighted under the federal system, it is protected, but if it isn't it falls into the public domain as before. Nevertheless, the new system of federal copyright protection for unpublished works is a great simplification.

Under the new law, securing a copyright is very simple: one affixes the copyright notice ("copyright" or "©" followed by the year and the name of the copyright owner, as in "© 1980 by John Doe"). In graphic works, the notice can be even more brief, using the symbol ©, the year, and the owner's initials: "© 1980 JD." The notice must appear in a prominent place in the work. On graphic works, it can appear on the front or back of the work itself or even on the mounting if the work is mounted.[11]

If the copyright notice is in proper form, the work is copyrighted at that point. There is a registration procedure and there are

requirements to deposit copies of the work in the Library of Congress, but a copyright is valid without these formalities.[12]

However, if one wishes to complete the formalities, there is a form to fill out (for graphic works, the proper one is "Form VA," available from the Copyright Office, Library of Congress, Washington, DC 20559). The applicant completes the form and submits it with the required fee ($10) and two copies of the work to the Copyright Office.[13]

Although registering a copyright is optional, it does offer several advantages.[14] For one, it creates a documented record and provides evidence of the validity of the copyright for use in any subsequent legal proceeding. Another advantage of registering a copyright is that, should there be an infringement, the owner of a work registered before an infringement occurs has more legal remedies available than he otherwise would. For instance, he can sue for his attorney's fees and what are called "statutory damages" (an arbitrary sum of money the court may award). Since actual damages are often difficult to prove, the provision for automatic awards of money without proof of injury makes statutory damages attractive in many copyright law suits. In any event, if a work was not registered originally, it must be registered before the copyright owner may bring a legal action against the alleged infringer.

The Library of Congress deposit requirements are not as voluntary as the registration requirements under the new law, but the registration process usually satisfies those requirements too. If the copyright is unregistered, the Library of Congress has a right to demand completion of the deposit requirement but rarely

does so. If there is such a demand, the copyright owner has 90 days to complete the deposit after that. If he doesn't, there are possible criminal sanctions, but under no circumstance does the compliance or noncompliance with the deposit requirement affect the validity of the copyright.[15]

Exclusive Rights under the New Law

Once there is a valid copyright, the owner has the exclusive right to sell, use, alter or profit from the work for the duration of the copyright term. The new act changed the duration of a copyright from 28 years to the creator's life plus 50 years. For anonymous and corporate works, the term now runs for 75 years from the date of publication or 100 years from the date of creation, whichever is a shorter time.[16]

The copyright owner may sell (or give away) some as well as all of his rights, or he may retain them himself. It is possible to sell first reprint rights in a work and retain ownership for future uses, or to sell "all rights."

Works created "for hire" create a special problem under the new law. When an employee creates a work within the scope of his employment, the copyright belongs to the employer, a provision that is neither surprising nor controversial. However, a free-lancer may find himself caught in the pitfall of "work for hire" too, depending on how the agreement with the person who commissioned the work is worded. If there is language that says it is a "work for hire"--or words to that effect--the free-lance creator may find he has sold all ownership rights and not just the "first rights" he intended to sell.[17]

The Fair Use Doctrine

In this brief summary of the highlights of the new copyright act, there is one more concept that should be treated--fair use. Fair use is a judicially created doctrine that allows certain limited uses of copyrighted works without there being an infringement. The classic examples involve brief quotations of excerpts for the purposes of scholarly criticism, for satirical purposes; or for use of the factual information in conjunction with new research by a second author.[18]

The new act extended statutory recognition to this concept for the first time, setting up four criteria to be used in deciding if a given use of a copyrighted work is a fair one:

1) the purpose and character of the use, including whether or not it is for profit;

2) the character of the copyrighted work and the new use;

3) how much of the total work is used;

4) what effect the use will have on the market for or value of the original copyrighted work.[19]

These are broad, general guidelines that will mean little until they are interpreted through a series of court decisions. It would be safe at this point to conclude that a use which taps the same market as the original and involves taking a substantial part of the original work would not be a fair use. On the other hand, using a small portion of a lengthy work for nonprofit purposes would be more likely to rank as a fair use.

TYPOGRAPHY AND COPYRIGHT LAW

Probably the single most perplexing copyright problem for graphic arts practitioners over the years has been the on-going refusal of the Copyright Office--and Congress--to recog-nize that there is an element of both creativity and originality--the two prerequisites for copyright protection--in typeface designs.

Typography has never been protected under U.S. copyright law. The rationale has always been that type is, after all, fundamentally a utilitarian device: it does not ordinarily exist for its own intrinsic beauty but rather to communicate words and ideas. And devices that are designed in a certain way for reasons of utility and function rather than for aesthetic reasons have traditionally been regarded as beyond the scope of copyright protection.

To this argument, graphic artists have often replied that any typeface must fulfill the utilitarian purpose of com-municating, to be sure, but type designs may reflect a great variety of artistic styles as well. To ignore the artistic design considerations in selecting, for instance, Tempo Heavy Condensed type rather than Bodoni Light Italic for a given layout is to simply disregard any consideration of aesthetic values in graphic design.

Nevertheless, the Copyright Office has been steadfast in its refusal to accept the registration of any new type design under the U.S. copyright laws.

Acting under the authority of the 1909 Copyright Act, predecessor to the current law, the Copyright Office issued a regulation that goes so far as to deny copyright protection even to materials that involve "variations of typographic ornamentation, lettering or coloring."[20]

A slight ray of hope for change in this intransigent stand came in 1954 with a landmark U.S. Supreme Court decision, Mazer v. Stein.[21] That case had nothing to do with typography directly; indirectly, though, it had a great deal to do with the problem because it involved the question of copyrighting something that had both artistic and utilitarian functions: a small statuette that formed the base for a table lamp! The plaintiff in that case successfully copyrighted the statuette as a work of art and then began mass producing the figures as bases for lamps, complete with power cords, sockets, switches, light bulbs and lamp shades. The defendant copied the design and began making his own lamps.

The Supreme Court acknowledged the obvious utility of the item as a lamp base, but ruled that the object was still an item with aesthetic value apart from its utility. As a result, the court held that the copying of the lamp base statuette was a copyright infringement!

In 1955, shortly after the Mazer decision, Congress began the deliberations that ultimately led to the enactment of the new Copyright Act more than 20 years later.[22] Early in that process, Congress recognized the problems inherent in allowing typeface designs and other useful works of art to be copyrighted, but far more controversial political issues--such as the battle between

the CATV industry and the broadcasters--so bogged down the debate that little time was ever spent on the issue of typeface designs.

At one point the Senate version of the copyright revision bill contained a section creating special rights somewhat more restricted than full copyright protection for original designs of creations that were utilitarian as well as artistic. That version passed the Senate in 1962, 1963 and 1966, but never got through the House of Representatives.

Anxious to enact a copyright law in some form by the mid-1970s, the House deleted the whole portion of the bill that dealt with utilitarian objects and designs, including typefaces. The report of the House Committee on the Judiciary stated:

"The committee has considered, but chosen to defer, the possibility of protecting the design of typefaces. A 'typeface' can be defined as a set of letters, numbers or other symbolic characters, whose forms are related by repeating design elements consistently applied in a notational system and are intended to be embodied in articles whose intrinsic utilitarian function is for use in composing text or other cognizable combinations of characters. The Committee does not regard the design of typefaces, as thus defined, to be a copyrightable 'pictorial, graphic or sculptural work' within the meaning of this bill...."[23]

The language of the House Committee report implies that Congress was merely setting the issue aside for later consideration, but in the four years since the passage of the Copyright Act, the matter has not been considered, leaving typefaces in the same copyright limbo they have occupied for two centuries.

Meanwhile, a commercial typesetting equipment manufacturer who had paid a type designer $11,000 for use of some fonts in its equipment sought a court order to force the Copyright Office to register them. In Eltra Corp. v. Ringer, the firm demanded a writ of mandamus that would compel the Copyright Office

to abandon or at least revise its prohibition on copyrighting typeface designs. The federal district court refused to grant the petition, but followed a convoluted path in reaching that conclusion.[24]

First, the Eltra court conceded that a typeface could be a work of art as well as a utilitarian thing. Citing the Mazer case, the court noted that a useful thing may be copyrighted if it is also a work of art aside from its utility. Thus, the court expressed doubts about the validity of the long-standing regulation against copyrighting typefaces. Nevertheless, the court held, that regulation had been in force for many years, and Congress had acquiesced to it by taking the position that new Congressional action would be needed to extend copyright protection to typefaces. If Congress thinks a regulation is valid, it is not up to the courts to decide otherwise, the court said in effect.

Faced with this adverse ruling, Eltra appealed to the U.S. Circuit Court of Appeals--and the result was an even more unfavorable decision.[25] Not only did the higher court affirm the district court's decision against ordering copyright protection for typeface designs, but it differed with the lower court's view that a typeface could be a work of art and thus copyrightable. Analyzing the language of the Copyright Act and noting the long history of Copyright Office refusals to register typefaces, the appellate court concluded that a typeface cannot be considered a work of art. The court said:

"...It is patent that (a) typeface is an industrial design in which the design cannot exist independently and separately as a work of art. Because of this, (a) typeface has never been considered entitled to copyright....And the appellant has recognized this because over the years it, along with others in the trade, has sought repeatedly to induce Congress to amend the law in order to provide copyright protection to typeface(s). Just as consis-

tently, Congress has refused to grant the protection. The latest refusal was in connection with the 1976 revision....What Congress has refused to authorize for registration, courts cannot authorize or require."[26]

Thus, the regulation against copyrighting typefaces was upheld. However, copyright scholar Melville Nimmer has contended in his treatise on the subject that the Eltra decision is in error.[27] The traditional ban on copyrighting typefaces has never been a valid application of the 1909 Copyright Act, Nimmer believes. Congress may have never intended to acquiesce in what amounts to an incorrect interpretation of the old law on this point, since only the House Committee and not the comparable Senate Committee even addressed the issue of typefaces when the new Copyright Act was passed. The Copyright Act itself says nothing about whether typefaces can or cannot be copyrighted.

In the meantime, though, the Copyright Office is standing by its policy of refusing to register type designs.[28] However, if additional creative efforts are added to the type, as when type is combined with other elements of editorial or advertising design, copyright protection becomes available.

Some years ago, a federal court made it clear that this is true. In Amplex Manufacturing Co. v. A.B.C. Plastic Fabricators,[29] a federal court ruled that there can be a valid copyright in a graphic design involving elements besides type itself, in this case a shaded background and an arrangement of the type in the layout. That ruling may be quite helpful to the graphic designer whose main interest is in combining type with other elements. And, of course, the textual and pictorial content of a layout can be registered. But the typeface designs themselves remain in the public domain.

ALTERNATIVES TO COPYRIGHT

If typeface designs cannot be copyrighted, is there any other way to protect one's ownership rights in typography?

There is a widely recognized alternative to copyright law that has been employed in a variety of other contexts, and it may well work as a means of protecting typography. It is the concept of "unfair competition."

Unfair competition (sometimes called misappropriation) is a tort action that has been used to protect business enterprises from various forms of wrongful activities involving piracy of an idea or tangible item. The concept got its impetus from the famous news piracy case, International News Service v. Associated Press, a 1918 U.S. Supreme Court decision.[30] In that case, the high court recognized that the news could not be copyrighted, but said nonetheless that when one news service systematically engages in the practice of purloining all of its news from a competitor, the result is a civil wrong that the courts should remedy. The legal action that resulted from this ruling has since been utilized in a variety of other circumstances where copyright or patent protection was unavailable for some reason.

Although it was a federal concept at first, unfair competition has been strictly a state-level legal action since 1938, when the U.S. Supreme Court ruled in Erie R.R. Co. v. Tompkins[31] that federal courts should not become involved in a wide variety of common law legal actions such as unfair competition but should leave these areas of law to the states. In the years since then, state courts have often stepped in to protect business enterprises from piracy by competitors.

However, in 1964 the U.S. Supreme Court cast doubts on even this alternative in two famous cases, Sears Roebuck and Co. v. Stiffel[32] and Compco Corp. v. Day-Brite Lighting.[33] These cases involved mechanical designs that could not be patented rather than creative works that could not be copyrighted, but the court's language was alarmingly sweeping. The high court said the states could no longer create alternative forms of legal protection to fill in the gaps left by copyright and patent law. "...A state may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying," the Supreme Court said in Sears.[34] In effect, what the Supreme Court seemed to hold in these two cases was that the federal government had preempted the entire field of patent and copyright law, denying any role in this area to the states.

Moreover, the new Copyright Act specifically declares that the federal law preempts the field of copyright, abolishing all state laws in the area, notably the common law copyright system.[35]

On the other hand, Goldstein v. California,[36] a U.S. Supreme Court decision that involved record piracy at a time when sound recordings could not be copyrighted, narrowed the impact of Sears and Compco. In Goldstein, the Supreme Court made it clear that there can be other forms of legal protection for creative endeavors besides copyright law, and the states may indeed enforce laws in these other areas without facing preemption problems.

Two years before the Supreme Court's Goldstein decision, a lower federal appellate court had taken a similar position--but specifically on the question of typography. In that case (Bailey v. Logan Square Typographers[37]), a typography house had assembled an inventory of about 270 different typeface designs for sale

to printing firms. The typeface designs were not copyrighted, of course, but they nonetheless had commercial value and possession of all copies was carefully controlled. Somehow, the defendant (Logan) acquired sets of negatives of the typefaces without purchasing them, and Bailey sued.

In response to the law suit, Logan contended that the types were not only uncopyrighted but widely published in the public domain, since all of the shops that bought the types used them in their publications. As far as federal law is concerned, the court agreed:

"...(The) defendants have a federal right to make copies of plaintiff's letters and designs from printed matter distributed in the open market, to assemble complete alphabets from such public materials, and thereafter to use such copies in their own businesses."[38]

However, the court said that didn't settle the matter, because the issue here was the wholesale piracy of an entire catalog of typefaces, not just using published letters and numbers. The court said the inventory of types might have a value beyond that of the individual types used in publications, and a state court might well find a wrongful taking under misappropriation law:

"The common law has recognized that the owner of unpublished designs or compilations of material has a valuable interest that may be protected from wrongful invasion apart from the federal copyright and patent laws."[39]

Thus, both the Supreme Court's Goldstein decision and the federal appeals court's Bailey ruling suggest that an owner of a collection of typeface designs could bring a state unfair

competition law suit if there were an instance of systematic misappropriation, regardless of the fact that the individual type designs themselves cannot be copyrighted.

Unfortunately, such protection would be on a state-by-state basis only, and one would expect the results to vary widely from one jurisdiction to the next, but unfair competition law should offer some protection to the graphic artist.

However, in production situations probably the best protection for the graphic artist is to always incorporate enough elements besides typography in every design that the overall creation can be copyrighted. That does not prevent an imitator from purloining any original typestyles and incorporating them into his own work, but it does offer protection for the graphic artist's finished product. Moreover, as one moves from typography to highly stylized calligraphy, the likelihood of the Copyright Office accepting the lettering itself as a protectable work of art increases substantially.

In short, the greater the element of individual originality and creativity, the more likely it is that the Copyright Office will overlook the obvious functionality of graphic communications and grant copyright protection.

REFERENCES

1. 17 U.S.C. 100 et seq. (effective Jan. 1, 1978; enacted as the Copyright Act of 1976)

2. Among the major features of the new Copyright Act in these areas were the following: 1) creation of a compulsory licensing system with the payment of royalties by CATV systems; 2) establishment of a Copyright Royalty Tribunal to adjust royalties in music and other areas as necessary; 3) detailed guidelines on photocopying and copyright; 4) a statutory increase in music royalties.

3. Eltra v. Ringer, 579 F2d 294 (4th cir., 1978)

4. See, for instance, Alfred Bell & Co. v. Catalda Fine Arts, 191 F2d 99

5. In Sheldon v. Metro-Goldwyn Pictures Corp., 81 F2d 49, Judge Learned Hand made this observation about originality, uniqueness and copyright law: "If by some magic a man who had never known it were to compose anew Keats' Ode to a Grecian Urn, he would be an 'author', and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats."

6. 17 U.S.C. 102 (a)

7. See, for instance, 17 U.S.C. 102 (b); see also Copyright Revision Act of 1976, Chicago: Commerce Clearing House, Inc., 1976, section 211.

8. See, for instance, Lin-Brook Builders Hardware v. Gertler, 352 F2d 298 (9th cir., 1965)

9. 37 C.F.R. 202.1 (a)

10. 17 U.S.C. 301

11. 17 U.S.C. 401

12. 17 U.S.C. 408

13. Copyright Office, The Nuts and Bolts of Copyright, Washington: U.S. Government Printing Office #1979-311-426/25.

14. 17 U.S.C. 412

15. 17 U.S.C. 406(d)

16. 17 U.S.C. 302.

17. Crawford, Tad, The Visual Artist's Guide to the New Copyright Law, New York: The Graphic Artists Guild, c. 1978.

18. Rosemont Enterprises, Inc. v. Random House, Inc., 366 F2d 303 (2nd cir., 1966)

19. 17 U.S.C. 107

20. 37 C.F.R. 202.1(a) (This regulation remains in force in 1980)

21. Mazer v. Stein, 347 U.S. 201 (1954)

22. House Report 94-1476, pp.49-50

23. ibid., p.55

24. Eltra v. Ringer, 194 U.S.P.Q. 198 (E.D.Va. 1976)

25. Eltra v. Ringer, 579 F2d 294 (4th cir., 1978)

26. 579 F2d at 298

27. Nimmer on Copyright, sec. 2.15

29. Copyright Office loc.cit.

29. 184 F.Supp. 285 (E.D.Pa. 1960)

30. 248 U.S. 215 (1918)

31. 304 U.S. 64 (1938)

32. 376 U.S. 225 (1974)

33. 376 U.S. 234 (1964)
34. 376 U.S. at 228
35. 17 U.S.C. 301

36. 412 U.S. 546 (1973)

37. 441 F2d 47 (7th cir., 1971)

38. 441 F2d at 50

39. 441 F2d at 51.