28 S.Ct. 319
Supreme Court of the United States.

WHITE-SMITH MUSIC PUBLISHING COMPANY, Appt.,

v.

APOLLO COMPANY.

Nos. 110, 111.
|
Argued January 16 and 17, 1908.
|
Decided February 24, 1908.

Opinion

Mr. Justice **Day** delivered the opinion of the court:

These cases may be considered together. They are appeals from the judgment of the circuit court of appeals of the second circuit (77 C. C. A. 368, 147 Fed. 226), affirming the decree of the circuit court of the United States for the southern district of New York, rendered August 4, 1905 (139 Fed. 427), dismissing the bills of the complainant (now appellant) for want of equity. Motions have been made to dismiss the appeals, and a petition for writ of certiorari has been filed by appellant. In view of the nature of the cases the writ of certiorari is granted, the record on the appeals to stand as a return to the writs. Montana Min. Co. v. St. Louis Min. & Mill. Co. 204 U. S. 204, 51 L. ed. 444, 27 Sup. Ct. Rep. 254.

The actions were brought to restrain infringement of the copyrights of two certain musical compositions, published in the form of sheet music, entitled respectively, 'Little Cotton Dolly' and 'Kentucky Babe.' The appellee, defendant below, is engaged in the sale of piano players and player pianos known as the 'Apollo,' and of perforated rolls of music used ***9** in connection therewith. The appellant, as assignee of Adam Geibel, the composer, alleged compliance with the copyright act, and that a copyright was duly obtained by it on or about March 17, 1897. The answer was general in its nature, and upon the testimony adduced a decree was rendered, as stated, in favor of the Apollo Company, defendant below, appellee here.

The action was brought under the provisions of the copyright act, § 4952 (U. S. Comp. Stat. Supp. 1907, p. 1021), giving to the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical ****320** composition the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending the same. The circuit courts of the United States are given jurisdiction under § 4970 (U. S. Comp. Stat. 1901, p. 3416) to grant injunctions according to the course and principles of courts of equity in copyright cases. The appellee is the manufacturer of certain musical instruments adapted to be used with perforated rolls. The testimony discloses that certain of these rolls, used in connection with such instruments, and being connected with the mechanism to which they apply, reproduce in sound the melody recorded in the two pieces of music copyrighted by the appellant.

The manufacture of such instruments and the use of such musical rolls has developed rapidly in recent years in this country and abroad. The record discloses that in the year 1902 from seventy to seventyfive thousand of such instruments were in use in the United States and that from one million to one million and a half of such perforated musical rolls, to be more fully described hereafter, were made in this country in that year.

It is evident that the question involved in the use of such rolls is one of very considerable importance, involving large property interests and closely touching the rights of composers and music publishers. The case was argued with force and ability, orally and upon elaborate briefs.

Without entering into a detailed discussion of the mechanical ***10** construction of such instruments and rolls, it is enough to say that they are what has become familiar to the public in the form of mechanical attachments to pianos, such as the pianola, and the musical rolls consist of perforated sheets, which are passed over ducts connected with the operating parts of the mechanism in such manner that the same are kept sealed until, by means of perforations in the rolls, air pressure is admitted to the ducts which operate the pneumatic devices to sound the notes. This is done with the aid of an operator, upon whose skill and experience the success of the rendition largely depends. As the roll is drawn over the tracker board the notes are sounded as the perforations admit the atmospheric pressure, the perforations having been so arranged that the effect is to produce the melody or tune for which the roll has been cut.

Speaking in a general way, it may be said that these rolls are made in three ways. First. With the score or staff notation before him the arranger, with the aid of a rule or guide and a graduated schedule, marks the position and size of the perforations on a sheet of paper to correspond to the order of notes in the composition. The marked sheet is then passed into the hands of an operator who cuts the apertures, by hand, in the paper. This perforated sheet is inspected and corrected, and when corrected is called 'the original.' This original is used as a stencil and by passing ink rollers over it a pattern is prepared. The stenciled perforations are then cut, producing the master or templet. The master is placed in the perforating machine and reproductions thereof obtained, which are the perforated rolls in question. Expression marks are separately copied on the perforated music sheets by means of rubber stamps. Second. A perforated music roll made by another manufacturer may be used from which to make a new record. Third. By playing upon a piano to which is attached an automatic recording device producing a perforated matrix from which a perforated music roll may be produced.

It is evident, therefore, that persons skilled in the art can take such pieces of sheet music in staff notation, and, by means ***11** of the proper instruments, make drawings indicating the perforations, which are afterwards outlined and cut upon the rolls in such wise as to reproduce, with the aid of the other mechanism, the music which is recorded in the copyrighted sheets.

The learned counsel for the parties to this action advance opposing theories as to the nature and extent of the copyright given by statutory laws enacted by Congress for the protection of copyright, and a determination of which is the true one will go far to decide the rights of the parties in this case. On behalf of the appellant it is insisted that it is the intention of the copyright act to protect the intellectual conception which has resulted in the compilation of notes which,

when properly played, produce the melody which is the real invention of the composer. It is insisted that this is the thing which Congress intended to protect, and that the protection covers all means of expression of the order of notes which produce the air or melody which the composer has invented.

Music, it is argued, is intended for the ear as writing is for the eye, and that it is the intention of the copyright act to prevent the multiplication of every means of reproducing the music of the composer to the ear.

On the other hand, it is contended that while it is true that copyright statutes are intended to reward mental creations or conceptions, that the extent of this protection is a matter of statutory law, and that it has been extended only to the tangible results of mental conception, and that only the tangible thing is dealt with by the law, and ****321** its multiplication or reproduction is all that is protected by the statute.

Before considering the construction of the statute as an independent question the appellee invokes the doctrine of *stare decisis* in its favor and it is its contention that in all the cases in which this question has been up for judicial consideration it has been held that such mechanical producers of musical tones as are involved in this case have not been considered to be within the protection of the copyright act; and that, if within the power of Congress to extend protection to such subjects, ***12** the uniform holdings have been that it is not intended to include them in the statutory protection given. While it may be that the decisions have not been of that binding character that would enable the appellee to claim the protection of the doctrine of *stare decisis* to the extent of precluding further consideration of the question, it must be admitted that the decisions so far as brought to our attention in the full discussion had at the bar and upon the briefs have been uniformly to the effect that these perforated rolls operated in connection with mechanical devices for the production of music are not within the copyright act. It was so held in Kennedy v. McTammany, 33 Fed. 584. The decision was written by Judge Colt in the first circuit; the case was subsequently brought to this court, where it was dismissed for failure to print the record. 145 U. S. 643, 36 L. ed. 853, 12 Sup. Ct. Rep. 983. In that case the learned judge said:

'I cannot convince myself that these perforated strips of paper are copies of sheet music within the meaning of the copyright law. They are not made to be addressed to the eye as sheet music, but they form part of a machine. They are not designed to be used for such purposes as sheet music, nor do they in any sense occupy the same field as sheet music. They are a mechanical invention made for the sole purpose of performing tunes mechanically upon a musical instrument.'

Again the matter was given careful consideration in the court of appeals of the District of Columbia in an opinion by Justice Shepard (Stern v. Rosey, 17 App. D. C. 562), in which that learned justice, speaking for the court, said:

'We cannot regard the reproduction, through the agency of a phonograph, of the sounds of musical instruments playing the music composed and published by the appellants, as the copy or

publication of the same within the meaning of the act. The ordinary signification of the words ‘copying,’ ‘publishing,’ etc., cannot be stretched to include it.

‘It is not pretended that the marks upon the wax cylinders can be made out by the eye or that they can be utilized in any other way than as parts of the mechanism of the phonograph.

***13** ‘Conveying no meaning, then, to the eye of even an expert musician, and wholly incapable of use save in and as a part of a machiine specially adapted to make them give up the records which they contain, these prepared wax cylinders can neither substitute the copyrighted sheets of music nor serve any purpose which is within their scope. In these respects there would seem to be no substantial difference between them and the metal cylinder of the old and familliar music box, and this, though in use at and before the passage of the copyright act, has never been regarded as infringing upon the copyrights of authors and publishers.’

The question came before the English courts in Boosey v. Whight [1899] 1 Ch. 836, 80 L. T. N. S. 561, and it was there held that these perforated rolls did not infringe the English copyright act protecting sheets of music. Upon appeal Lindley, Master of the Rolls, used this pertinent language [1900] 1 Ch. 122, 81 L. T. N. S. 265:

‘The plaintiffs are entitled to copyright in three sheets of music. What does this mean? It means that they have the exclusive right of printing or otherwise multiplying copies of those sheets of music,—*i. e.*, of the bars, notes, and other printed words and signs on those sheets. But the plaintiffs have no exclusive right to the production of the sounds indicated by or on those sheets of music; nor to the performance in private of the music indicated by such sheets; nor to any mechanism for the production of such sounds or music.

‘The plaintiffs' rights are not infringed except by an unauthorized copy of their ‘sheets of music.’ We need not trouble ourselves about authority from the plaintiffs; no question turning on the meaning of that expression has to be considered in this case. The only question we have to consider is whether the defendants have copied the plaintiffs' sheets of music.

‘The defendants have taken those sheets of music and have prepared from them sheets of paper with perforations in them, and these perforated sheets, when put into and used with properly constructed machines or instruments, will produce or ***14** enable the machines or instruments to produce the music indicated on the plaintiffs' sheets. [In this sense the defendant's perforated rolls have been copies from the plaintiffs' sheets.]

‘But is this the kind of copying which is prohibited by the copyright act; or rather, is the perforated steet, made as above mentioned, ****322** a copy of the sheet of music from which it is made? Is it a copy at all? Is it a copy within [the meaning of] the copyright act? A sheet of music is treated in the copyright act as if it were a book or sheet of letter press. Any mode of copying such a thing, whether by printing, writing, photography, or by some other method not yet invented, would no doubt be copying. So, perhaps, might a perforated sheet of paper to be sung or played from in the same way as sheets of music are sung or played from. But to play an instrument from a sheet of music which appears to the eye is one thing; to play an instrument

with a perforated sheet which itself forms part of the mechanism which produces the music is quite another thing.'

Since these cases were decided Congress has repeatedly had occasion to amend the copyright law. The English cases, the decision of the District of Columbia court of appeals, and Judge Colt's decision must have been well known to the members of Congress; and although the manufacture of mechanical musical instruments had not grown to the proportions which they have since attained, they were well known, and the omission of Congress to specifically legislate concerning them might well be taken to be an acquiescence in the judicial construction given to the copyright laws.

This country was not a party to the Berne convention of 1886, concerning international copyright, in which it was specifically provided:

'It is understood that the manufacture and sale of instruments serving to reproduce mechanically the airs of music borrowed from the private domain are not considered as constituting musical infringement.'

But the proceedings of this convention were doubtless well ***15** known to Congress. After the Berne convention the act of March 3, 1891, was passed. Section 13 of that act provides ([26 Stat. at L. 1110, chap. 565] U. S. Comp. Stat. 1901, p. 3417):

'Sec. 13. That this act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as its own citizens; and when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may, at its pleasure, become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the President of the United States by proclamation made from time to time as the purposes of this act may require.'

By proclamation of the President July 1, 1891 [27 Stat. at L. 981], the benefit of the act was given to the citizens of Belgium, France, British possessions, and Switzerland, which countries permitted the citizens of the United States to have the benefit of copyright on the same basis as the citizens of those countries. On April 15, 1892, the German Empire was included. [27 Stat. at L. 1021.] On October 31, 1892, a similar proclamation was made as to Italy. [27 Stat. at L. 1043.] These countries were all parties to the Berne convention.

It could not have been the intention of Congress to give to foreign citizens and composers advantages in our country which, according to that convention, were to be denied to our citizens abroad.

In the last analysis this case turns upon the construction of a statute, for it is perfectly well settled that the protection given to copyrights in this country is wholly statutory. Wheaton v. Peters, 8 Pet. 591, 8 L. ed. 1055; Banks v. Manchester, 128 U. S. 244, 253, 32 L. ed. 425, 429, 9 Sup. Ct.

Rep. 36; Thompson v. Hubbard, 131 U. S. 123, 151, 33 L. ed. 76, 86, 9 Sup. Ct. Rep. 710; American Tobacco Co. v. Werckmeister, 207 U. S. 284, ante, 72, 28 Sup. Ct. Rep. 72.

Musical compositions have been the subject of copyright protection since the statute of February 3, 1831 (4 Stat. at L. 436, chap. 16), and laws have been passed including them since that time. ***16** When we turn to the consideration of the act it seems evident that Congress has dealt with the tangible thing, a copy of which is required to be filed with the Librarian of Congress, and wherever the words are used (copy or copies) they seem to refer to the term in its ordinary sense of indicating reproduction or duplication of the original. Section 4956 (U. S. Comp. Stat. 1901, p. 3407) provides that two copies of a book, map, chart, or musical composition, etc., shall be delivered at the office of the Librarian of Congress. Notice of copyright must be inserted in the several copies of every edition published, if a book, or, if a musical composition, etc., upon some visible portion thereof. Section 4962, copyright act ([18 Stat. at L. 78, chap. 301] U. S. Comp. Stat. 1901, p. 3411). Section 4965 (U. S. Comp. Stat. 1901, p. 3414) provides in part that the infringer 'shall forfeit . . . every sheet thereof, and . . . one dollar for every sheet of the same found in his possession,' etc., evidently referring to musical compositions in sheets. Throughout the act it is apparent that Congress has dealt with the concrete, and not with an abstract, right of property in ideas or mental conceptions.

****323** We cannot perceive that the amendment of § 4966 by the act of January 6, 1897 ([29 Stat. at L. 481, chap. 4] U. S. Comp. Stat. 1901, p. 3415), providing a penalty for any person publicly performing or representing any dramatic or musical composition for which a copyright has been obtained, can have the effect of enlarging the meaning of the previous sections of the act which were not changed by the amendment. The purpose of the amendment evidently was to put musical compositions on the footing of dramatic compositions, so as to prohibit their public performance. There is no complaint in this case of the public performance of copyrighted music; not is the question involved whether the manufacturers of such perforated music rolls when sold for use in public performance might be held as contributing infringers. This amendment was evidently passed for the specific purpose referred to, and is entitled to little consideration in construing the meaning of the terms of the act theretofore in force.

***17** What is meant by a copy? We have already referred to the common understanding of it as a reproduction or duplication of a thing. A definition was given by Bailey, J., in West v. Francis, 5 Barn. & Ald. 743, quoted with approval in Boosey v. Whight, supra. He said: 'A copy is that which comes so near to the original as to give to every person seeing it the idea created by the original.'

Various definitions have been given by the experts called in the case. The one which most commends itself to our judgment is perhaps as clear as can be made, and defines a copy of a musical composition to be 'a written or printed record of it in intelligible notation.' It may be true that in a broad sense a mechanical instrument which reproduces a tune copies it; but this is a strained and artificial meaning. When the combination of musical sounds is reproduced to the ear it is the original tune as conceived by the author which is heard. These musical tones are not a copy which appeals to the eye. In no sense can musical sounds which reach us through the sense of hearing be said to be copies, as that term is generally understood, and as we believe it was intended to be understood in the statutes under consideration. A musical composition is an

intellectual creation which first exists in the mind of the composer; he may play it for the first time upon an instrument. It is not susceptible of being copied until it has been put in a form which others can see and read. The statute has not provided for the protection of the intellectual conception apart from the thing produced, however meritorious such conception may be, but has provided for the making and filing of a tangible thing, against the publication and duplication of which it is the purpose of the statute to protect the composer.

Also it may be noted in this connection that if the broad construction of publishing and copying contended for by the appellants is to be given to this statute it would seem equally applicable to the cylinder of a music box, with its mechanical arrangement for the reproduction of melodious sounds, or the record of the graphophone, or to the pipe organ operated by ***18** devices similar to those in use in the pianola. All these instruments were well known when these various copyright acts were passed. Can it be that it was the intention of Congress to permit them to be held as infringements and suppressed by injunctions?

After all, what is the perforated roll? The fact is clearly established in the testimony in this case that even those skilled in the making of these rolls are unable to read them as musical compositions, as those in staff notations are read by the performer. It is ture that there is some testimony to the effect that great skill and patience might enable the operator to read this record as he could a piece of music written in staff notation. But the weight of the testimony is emphatically the other way, and they are not intended to be read as an ordinary piece of sheet music, which, to those skilled in the art, converys, by reading, in playing or singing, definite impressions of the melody.

These perforated rolls are parts of a machine which, when duly applied and properly operated in connection with the mechanism to which they are adapted, produce musical tones in harmonious combination. But we cannot think that they are copies within the meaning of the copyright act.

It may be true that the use of these perforated rolls, in the absence of statutory protection, enables the manufacturers thereof to enjoy the use of musical compositions for which they pay no value. But such considerations properly address themselves to the legislative, and not to the judicial, branch of the government. As the act of Congress now stands we believe it does not include these records as copies or publications of the copyrighted music involved in these cases.

The decrees of the Circuit Court of Appeals are affirmed.

Mr. Justice **Holmes,** concurring specially:
In view of the facts and opinions in this country and abroad to which my brother Day has called attention, I do not feel ***19** justified ****324** in dissenting from the judgment of the court, but the result is to give to copyright less scope than its rational significance and the ground on which it is granted seem to me to demand. Therefore I desire to add a few words to what he has said.

The notion of property starts, I suppose, from confirmed possession of a tangible object, and consists in the right to exclude others from interference with the more or less free doing with it as one wills. But in copyright property has reached a more abstract expression. The right to exclude is not directed to an object in possession or owned, but is *in vacuo*, so to speak. It restrains the

spontaneity of men where, but for it, there would be nothing of any kind to hinder their doing as they saw fit. It is a prohibition of conduct remote from the persons or tangibles of the party having the right. It may be infringed a thousand miles from the owner and without his ever becoming aware of the wrong. It is a right which could not be recognized or endured for more than a limited time and therefore, I may remark, in passing, it is one which hardly can be conceived except as a product of statute, as the authorities now agree.

The ground of this extraordinary right is that the person to whom it is given has invented some new collocation of visible or audible points,—of lines, colors, sounds, or words. The restraint is directed against reproducing this collocation, although, but for the invention and the statute, anyone would be free to combine the contents of the dictionary, the elements of the spectrum, or the notes of the gamut in any way that he had the wit to devise. The restriction is confined to the specific form, to the collocation devised, of course, but one would expect that, if it was to be protected at all, that collocation would be protected according to what was its essence. One would expect the protection to be coextensive not only with the invention, which, though free to all, only one had the ability to achieve, but with the possibility of reproducing the result which gives to the invention its meaning and worth. A ***20** musical composition is a rational collocation of sounds apart from concepts, reduced to a tangible expression from which the collocation can be reproduced either with or without continuous human intervention. On principle anything that mechanically reproduces that collocation of sounds ought to be held a copy, or, if the statute is too narrow, ought to be made so by a further act, except so far as some extraneous consideration of policy may oppose. What license may be implied from a sale of the copyrighted article is a different and harder question, but I leave it untouched, as license is not relied upon as a ground for the judgment of the court.