United States Supreme Court
FERRIS v. FROHMAN, (1912)
No. 44
Argued: Decided: February 19, 1912

[223 U.S. 424, 425] Messrs. Charles H. Aldrich, Charles R. Aldrich, Charles G. McRoberts, and L. E. Chipman for plaintiff in error.

[223 U.S. 424, 428] Mr. Levy Mayer for defendants in error.

[223 U.S. 424, 429]

Mr. Justice Hughes delivered the opinion of the court:

This is a writ of error to the supreme court of Illinois.

The suit was brought by Charles Frohman, Charles Haddon Chambers, and Stephano Gatti (defendants in error), to restrain the production of what was alleged to be a piratical copy of a play known as 'The Fatal Card.' Its authors were Charles Haddon Chambers and B. C. Stephenson, British subjects, resident in London, who composed [223 U.S. 424, 430] it there in 1894. The firm of A. & S. Gatti, theatrical managers of London, of which the complainant Gatti is the surviving partner, became interested with the authors and on September 6, 1894, the play was first performed in London. It was registered under the British statutes on October 31, 1894, and again on November 8, 1894. Charles Frohman of New York, by agreement of June 13, 1894, obtained the right of production in this country for five years. On March 25, 1895, Frohman acquired all the interest of Stephenson in the play in and for the United States, and it was extensively represented under his supervision. It was not copyrighted here.

George E. McFarlane made an adaptation of this play, called it by the same name, and transferred it to the plaintiff in error, Richard Ferris, of Illinois, who copyrighted it in August, 1900, under the laws of the United States, and later caused it to be performed in various places in this country. The adapted play differed from the original in various details, but not in its essential features.

The superior court of Cook county found that the complainants were the sole owners of the original play; that it had never been published or otherwise dedicated to the public in the United States or elsewhere; and that the Ferris play was substantilly identical with it. Ferris was directed to account, and was perpetually restrained from producing the adaptation which he had copyrighted. The appellate court for the first district reversed the decree (131 Ill. App. 307), but on appeal to the supreme court of Illinois this decision was reversed and the decree of the superior court was affirmed. 238 Ill. 430, -- L.R.A.(N.S.) Am. St. Rep. 135, 87 N. E. 327.

The defendants in error contest the jurisdiction of this court upon the ground that the bill was based entirely upon a commonlaw right of property, and insist that the upholding of this right by the state court raises no Federal question. But the complainants sued not simply to maintain their commom-law right in the original play, [223 U.S. 424, 431] but, by virtue of it, to prevent the defendant from producing the adapted play which he had copyrighted under the laws of the United States. They challenged a right which the copyright, if sustainable, secured. Rev. Stat . 4592, U. S. Comp. Stat. 1901, p. 3406. It was necessary for them to make the challenge, for they could not succeed unless this right were denied. Ferris stood upon the copyright. That it had been obtained was alleged in the bill, was averred in the answer, and was found by the court. The fact that the court reached its conclusion in favor of the complainants by a consideration, on common-law principles, of their property in the original play, does not alter the effect of the decision. By the decree Ferris was permanently enjoined 'from in any manner using , . . . selling, producing, or performing . . . the said defendant's copyrighted play hereinbefore referred to for any purpose.' The decision thus denied to him a Federal right specially set up and claimed, within the meaning of 709 of the Revised Statutes of the United States (U. S. Comp. Stat. 1901, p. 575). This court, therefore, has jurisdiction. Chicago, B. & Q. R. Co. v. Illinois, 200 U.S. 561, 580 , 581 S., 50 L. ed. 596, 604, 605, 26

Sup. Ct. Rep. 341, 4 A. & E. Ann. Cas. 1175; McGuire v. Massachusetts, 3 Wall. 382, 385, 18 L. ed. 164, 165; Anderson v. Carkins, 135 U.S. 483, 486 , 34 S. L. ed. 272, 274, 10 Sup. Ct. Rep. 905; Shively v. Bowlby, 152 U.S. 1, 9 , 38 S. L. ed. 331, 335, 14 Sup. Ct. Rep. 548; Northern P. R. Co. v. Colburn, 164 U.S. 383, 385 , 386 S., 41 L. ed. 479, 480, 17 Sup. Ct. Rep. 98; Green Bay & M. Canal Co. v. Patten Paper Co.172 U.S. 58, 67 , 68 S., 43 L. ed. 364, 368, 369, 19 Sup. Ct. Rep. 97.

The substantial identity of the two plays was not disputed in the appellate courts of Illinois, and must be deemed to be established. The contention was, and is, that after the public performance of the original play in London, in 1894, the owners had no common-law right, but only the rights conferred by the British statutes; and that Frohman's interest (save the license which expired in 1899) was subsequently acquired. Hence, it is said the play, not being copyrighted in the United States, was publici juris here, and the adapter was entitled to use it as common material. [223 U.S. 424, 432] Performing right was not within the provisions of 8 Anne, chap. 19, which gave to authors the sole liberty of printing their books. Coleman v. Wathen, 5 T. R. 245. The act of 1833, known as 'Bulwer-Lytton's act,' conferred statutory playright in perpetuity throughout the British dominions, in the case of dramatic pieces not printed and published; and for a stated term, if printed and published. 3 & 4 Will. IV. chap. 15. By 20 of the copyright act of 1842, 5 & 6 Vict. chap. 45, it was provided that the sole liberty of representing any dramatic piece should be the property of the author and his assigns for the term therein specified for the duration of copyright in books. The section continued: 'And the provisions hereinbefore enacted in respect of the property of such copyright, and of registering the same, shall apply to the liberty of representing or performing any dramatic piece or musical composition, as if the same were herein expressly re-enacted and applied thereto, save and except that the first public representation or performance of any dramatic piece or musical composition shall be deemed equivalent, in the construction of this act, to the first publication of any book.' Mr. Scrutton, in his work on Copyright, 4th ed. p. 77, states that it is 'probable, though there is no express decision to that effect, that the court, following Donaldson v. Beckett, 2 Bro. P. C. 129, would hold the common-law right destroyed by the statutory provisions after first performance in public.' Compare MacGillivray, on Copyright, pp. 122, 127, 128. And it may be assumed, in this case, that after the play had been performed, the right of the owners to protection against its unauthorized production in England was only that given by the statutes.

Further, in the absence of a copyright convention, there is no playright in England in the case of a play not printed and published, where the first public performance has taken place outside the British dominions. This[223 U.S. 424, 433] results from 19 of the act of 7 & 8 Vict. chap. 12, known as the international copyright act, which provides: 'Neither the author of any book, nor the author or composer of any dramatic piece or musical composition, . . . which shall, after the passing of this act, be first published out of her Majesty's dominions, shall have any copyright therein respectively, or any exclusive right to the public representation or performance thereof, otherwise than such (if any) as he may become entitled to under this act.' The provision applies to British subjects as well as to foreigners, and the words 'first published' include the first performance of a play. In Boucicault v. Delafield, 1 Hem. & M. 597, 33 L. J. Ch. N. S. 38, 9 Jur. N. S. 1282, 9 L. T. N. S. 709, 12 Week. Rep. 101, the author of the play known as 'The Colleen Bawn' filed a bill to restrain a piratical production. It appeared that the play had first been represented in New York, and by reason of that fact,-there being no copyright convention with the United States,-it was held that, under the statute above quoted, there was no playright in England. To the same effect is Boucicault v. Chatterton, L. R. 5 Ch. Div. 267, 46 L. J. Ch. N. S. 305, 35 L. T. N. S. 745, 25 Week. Rep. 287, where the author unsuccessfully sought to restrain an unauthorized performance of 'The Shaughraun,' an unprinted play which had first been represented here.

The British Parliament, in thus fixing the limits and conditions of performing rights, was dealing with rights to be exercised within British territory. It is argued that the English authors in this case, by the law of their domicil, were without common-law right and in its stead secured the protection of the British statutes, which cannot avail them here. But the British statutes did not purport to curtail any right of such authors with respect to the representation of plays outside the British dominions. They disclose no intention to destroy rights for which they provided no substitute. There is no indication of a purpose to incapacitate British citizens from holding their intellectual productions secure from interference in other [223 U.S. 424, 434] jurisdictions according to the principles of the common law. Their right was not gone simpliciter, but only in a qualified sense for the purposes of the statutes, and there was no convention under which the authors' work became public property in the United States. See Saxlehner v.

Eisner & M. Co. 179 U.S. 19, 36 , 45 S. L. ed. 60, 75, 21 Sup. Ct. Rep. 7; Saxlehner v. Wagner, 216 U.S. 375, 381 , 54 S. L. ed. 525, 528, 30 Sup. Ct. Rep. 298. When 20 of the act of 5 & 6 Vict. chap. 45, provided that the first public performance of a play should be deemed equivalent, in the construction of that act, to the first publication of a book, it simply defined its meaning with respect to the rights which the statutes conferred. The deprivation of the common-law right, by force of the statute, was plainly limited to the territorial bounds within which the operation of the statute was confined.

The present case is not one in which the owner of a play has printed and published it, and thus, having lost his rights at common law, must depend upon statutory copyright in this country. The play in question has not been printed and published. It is not open to dispute that the authors of 'The Fatal Card' had a common-law right of property in the play until it was publicly performed. Donaldson v. Beckett, 2 Bro. P. C. 129; Prince Albert v. Strange, 1 Macn. & G. 25, 1 Hall & T. 1, 18 L. J. Ch. N. S. 120, 13 Jur. 109; Jefferys v. Boosey, 4 H. L. Cas. 815, 962, 978, 3 C. L. R. 625, 24 L. J. Exch. N. S. 81, 4 Jur. N. S. 615. And they were entitled to protection against its unauthorized use here as well as in England. Wheaton v. Peters, 8 Pet. 591, 657, 8 L. ed. 1055, 1079; Paige v. Banks, 13 Wall. 608, 614, 20 L. ed. 709, 710; Bartlett v. Crittenden, 5 McLean, 32, Fed. Cas. No. 1,076; Crowe v. Aiken, 2 Biss. 208, Fed. Cas. No. 3,441; Palmer v. DeWitt, 2 Sweeny, 530, 47 N. Y. 532, 7 Am. Rep. 480.

What effect, then, had the performance of the play in England upon the rights of the owners with respect to its use in the United States? There was no statute here by virtue of which the common-law right was lost through the performance of the unpublished play. The act of August 18, 1856 (11 Stat. at L. 138, chap. 169), related only to dramatic compositions for which copyright had been [223 U.S. 424, 435] obtained in this country; its object was to secure to the author of a copyrighted play the sole right to its performance after it had been printed. Boucicault v. Fox, 5 Blatchf. 87, 97, 98, Fed. Cas. No. 1,691. The same is true of the provisions of the copyright act of July 8, 1870 (16 Stat. at L. 198, 212, 214, chap. 230, Rev. Stat. 4952, 4966, U. S. Comp. Stat. 1901, pp. 3406, 3415), and of those of the act of March 3, 1891 (26 Stat. at L. 1106, 1107, chap. 565, U. S. Comp. Stat. 1901, pp. 3406, 3407), which were in force when the transactions in question occurred and this suit was brought. The fact that the act of March 3, 1891, was applicable to citizens of foreign countries, permitting to our citizens the benefit of copyright on substantially the same basis as its own citizens (13), and that proclamation to this effect was made by the President with respect to Great Britain (27 Stat. at L. 981), did not make the British statutes operative within the United States. Nor did that fact add to the provisions of the act of Congress so as to make the latter destructive of the common-law rights of English subjects in relation to the representation of plays in this country, which were not copyrighted under that act, and which remained unpublished. These rights, like those of our own citizens in similar case, the act of 1891 did not disturb.

The public representation of a dramatic composition, not printed and published, does not deprive the owner of his common-law right, save by operation of statute. At common law, the public performance of the play is not an abandonment of it to the public use. Macklin v. Richardson, 2 Ambl. 694, 7 Eng. Rul. Cas. 66; Morris v. Kelly, 1 Jac. & W. 481, 21 Revised Rep. 216; Boucicault v. Fox, 5 Blatchf. 87, 97, Fed. Cas. No. 1,691; Crowe v. Aiken, 2 Biss. 208, Fed. Cas. No. 3,441; Palmer v. DeWitt, 2 Sweeny, 530, 47 N. Y. 532, 7 Am. Rep. 480; Tompkins v. Halleck, 133 Mass. 32, 43 Am. Rep. 480. Story states the rule as follows: 'So, where a dramatic performance has been allowed by the author to be acted at a theater, no person has a right to pirate such performance, and to publish copies of it surreptitiously; or to act it at another theater without the consent of the author [223 U.S. 424, 436] or proprietor; for his permission to act it at a public theater does not amount to an abandonment of his title to it, or to a dedication of it to the public at large.' 2 Story, Eq. Jur. 950. It has been said that the owner of a play cannot complain if the piece is reproduced from memory. Keene v. Wheatley, 4 Phila. 157, Fed. Cas. No. 7,644; Keene v. Kimball, 16 Gray, 545, 77 Am. Dec. 426. But the distinction is without sound basis and has been repudiated. Tompkins v. Halleck, 133 Mass. 32, 43 Am. Rep. 480.

And, as the British statutes did not affect the common-law right of representation in this country, it is not material that the first performance of the play in question took place in England. In Crowe v. Aiken (1870), 2 Biss. 208, Fed. Cas. No. 3,441, the play 'Mary Warner' had been composed by a British subject. It was transferred to the plaintiff with the exclusive right to its representation on the stage in the United States for five years from June 1, 1869. It had not been printed with the consent either of the author or of the plaintiff. It was first publicly performed in London in June, 1869, and afterwards was represented

here. The court (Drummond, J.) held that the plaintiff, by virtue of his common- law right, was entitled to an injunction restraining an unauthorized production. In Palmer v. De Witt (1872), 2 Sweeny, 530, 47 N. Y. 532, 7 Am. Rep. 480, the suit was brought to restrain the defendant from printing an unpublished drama called 'Play,' composed by a British citizen resident in London. The plaintiff on February 1, 1868, had purchased the exclusive right of printing and performing the play in the United States. On February 15, 1868, it was first performed in London. It was held that the common-law right had not been destroyed by the public representation, and the plaintiff had judgment. In the case last cited, and apparently in that of Crowe v. Aiken, the transfer to the plaintiff antedated the public performance, but neither decision was rested on that distinction. In Tompkins v. Halleck (1882) supra, an unpublished play called [223 U.S. 424, 437] 'The World' had been written in England, where, after being presented, it was assigned by the author to a purchaser in New York. It was acted in that city and then transferred to the plaintiffs with the exclusive right of representation in the New England states. The plaintiffs' common-law right was sustained and an unauthorized performance was enjoined.

Our conclusion is that the complainants were the owners of the original play and exclusively entitled to produce it. Their common-law right with respect to its representation in this country had not been lost. This being so, the play of the plaintiff in error, which was substantially identical with that of the complainants, was simply a piratical composition. It was not the purpose or effect of the copyright law to render secure the fruits of piracy, and the plaintiff in error is not entitled to the protection of the statute. In other words the claim of Federal right upon which he relies is without merit.

Judgment affirmed.