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# Kurlan v. CBS: Justice Carter's Prescient Dissent— A Glimpse into the Future of Copyright Protection in the Entertainment Industry

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# THE GREAT DISSENTS OF THE “LONE DISSENTER”

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*Justice Jesse W. Carter’s Twenty Tumultuous  
Years on the California Supreme Court*

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# *KURLAN v. CBS: JUSTICE CARTER'S PRESCIENT DISSENT— A GLIMPSE INTO THE FUTURE OF COPYRIGHT PROTECTION IN THE ENTERTAINMENT INDUSTRY*

*By Marc H. Greenberg\**

## **Introduction**

A scholar of intellectual property law quickly learns that complacency, and the privilege of working in a largely static and unchanging body of law, is not a benefit available to those who labor in this endlessly fascinating but fast-paced and always changing field. The 1953 decision of the California Supreme Court in *Kurlan v. CBS*<sup>1</sup> (hereinafter “*Kurlan*”), provides yet another example of this principle. Many of the assumptions found in the majority decision have long been abandoned or substantially revised.

Justice Carter’s dissent, however, contains the seeds of those revisions, and is prescient in its understanding of the need to: 1) eliminate copyright formalities regarding whether a work is deemed “published” resulting in divestiture of ownership; 2) determine whether characters should be separately subject to copyright protection; and 3) confirm that the judiciary should interpret and limit licenses of works to the media platform identified in the license, rather than affording a multi-platform license to licensees to the detriment of copyright holders.

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\* Professor of Law and the Founding Director of the Law School’s Intellectual Property Law Program (2002–2007). He dedicates this chapter to his mother, Anita Greenberg, who fondly remembers *My Sister Eileen*.

1. *Kurlan v. Columbia Broad. Sys.*, 40 Cal. 2d 799 (1953).

## Background: The Tale of Two Stories, and the Majority's Decision

Arthur Kurlan was a California-based independent writer and producer of motion pictures, television and radio shows during the 1940s and 50s. In the early 1940s he became interested in a popular book written by Ruth McKenny, entitled *My Sister Eileen*, which had spawned a popular theatrical production that ran on Broadway, a motion picture photoplay, as well as other copyrighted writings, which had also featured the main characters from the book.<sup>2</sup> These characters were Ruth and Eileen, two sisters living in an apartment in New York City. Ruth is described as having average intelligence, and is the more sober, “balance wheel” of the pair, while Eileen is described as “semi-moronic, scatterbrained, impulsive, naive, completely thoughtless and oblivious to the consequences of most of her acts.”<sup>3</sup> Most of those acts arose from what was characterized as Eileen’s condition of being “man-crazy,” which led her to get involved in a series of scrapes and situations which also involved Ruth, and which Ruth had to extricate the two of them from, much to her embarrassment.<sup>4</sup>

Kurlan wanted to obtain the rights to *My Sister Eileen* to create a serial radio or television program using the Ruth and Eileen characters, and adding in several background characters of his own creation. These were two media areas where the characters and story had not been presented. In March 1946, he entered into a license agreement with Ruth McKenny in which she assigned the radio and television rights to her stories and characters to him.<sup>5</sup>

Kurlan produced, for audition purposes, a wax recording for a radio program utilizing the McKenny characters, and submitted it in June 1946, to the Columbia Broadcasting System (CBS) for consideration of their acquisition of

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2. *Id.* at 801. Additional background facts are drawn from the case summary in *Kurlan v. Comm’r of Internal Revenue*, 343 F. 2d 625, 627 (1965) (hereinafter “*Kurlan Tax Case*”). A discussion of the relation of this case to the *Kurlan* case is found in note 26 and accompanying text, *infra*.

3. *Id.* at 804. Interestingly, Kurlan had cast Lucille Ball, then known primarily as a movie actress, who was under contract to him, for the role of Ruth. *Id.* Her later work in the long running series of shows she did with Desi Arnaz cast her in the screwball comedy part more in league with the character of Eileen.

4. *Id.* While the reader may cringe at the sexism of a term like “man-crazy,” it is probably fair to say that this kind of plot-line can still be found in any number of television network situation comedies still popular in the present era, *viz* *Sex in the City*, *Lipstick Jungle*, and *The Cashmere Mafia*, to name a few.

5. See *Kurlan Tax Case*, 343 F. 2d at 625.

the program.<sup>6</sup> According to Kurlan, after extensive negotiation, CBS declined to acquire the program, and instead informed Kurlan that they “‘intended to use’” his idea, characters, and format “‘without compensation therefore by merely changing the names of the characters and describing the leading female characters as girl friends instead of sisters’”; and, in this way, CBS intended to be free of any obligation to pay Kurlan for the rights to the work.<sup>7</sup> A month later CBS announced its forthcoming new radio and television show, entitled *My Friend Irma*, a show CBS ultimately released in both of those formats in April 1947.<sup>8</sup>

The plot-line of *My Friend Irma* featured two women, Irma and Jane, who are roommates, not sisters, living in New York City. Jane is a smart woman, while Irma is characterized as being “stupid.” Irma gets the two women into trouble due to her stupid antics, and Jane tries to get them out of trouble, with each episode reaching, as was common for that era, a happy ending.<sup>9</sup>

Kurlan filed suit against CBS in state court in Los Angeles, California.<sup>10</sup> He alleged a variety of claims, including that the *My Friend Irma* productions violated an implied agreement between him and CBS, that CBS would pay him if it used his program idea.<sup>11</sup> An additional count alleged violation of industry custom and practice that CBS would not be allowed to use any part of Kurlan’s program without his consent, and yet another count raised claims in tort for the misappropriation of Kurlan’s personal property, consisting of his radio program idea and format.<sup>12</sup>

CBS responded to the complaint by filing a demurrer, arguing that the various counts of Kurlan’s complaint failed to state facts sufficient to constitute valid causes of action. The trial court agreed, and sustained the demurrers without leave to amend.<sup>13</sup> Kurlan appealed the subsequent judgment against him, and the California Supreme Court, in a plurality opinion, reversed the Los Ange-

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6. *Id.* at 627.

7. *See Kurlan*, 40 Cal. 2d at 803 (quoting Kurlan’s complaint).

8. *See Kurlan Tax Case*, 343 F. 2d at 627.

9. *See Kurlan*, 40 Cal. 2d at 804–05.

10. *Id.* at 803.

11. *Id.*

12. *Id.* at 803.

13. *Id.* at 803. This seems a bit of a harsh result, since California courts liberally construe pleadings, and generally grant leave to amend in response to a first demurrer. *See, e.g.* Robert I. Weil, Ira A. Brown, Jr. & William F. Rylaarsdam, CAL. PRAC. GUIDE CIV. PRO. BEFORE TRIAL CH. 7:131, Comment (2008) (“Leave to amend (i.e., to cure the defect) will almost certainly be granted.”). Kurlan made the argument that the trial court’s refusal to allow him to amend was an abuse of discretion: however, this issue was not addressed by the

les County Superior Court, and remanded the case with instructions that CBS would now have to answer the complaint.<sup>14</sup>

The issues in the case, while it was an appeal, proved daunting for the Supreme Court, which was unable to muster a unified majority. Instead, the first section of the Supreme Court's opinion was written by Justice Edmonds, in which he was joined by Chief Justice Gibson and Justice Shenk.<sup>15</sup> Justice Schauer wrote a brief concurrence.<sup>16</sup> Justice Traynor wrote a concurring opinion, in which Justice Spence joined, agreeing with the conclusion that the breach of contract claim survived the demurrer, but disagreeing with the majority's conclusion that the plagiarism claim should also survive.<sup>17</sup> Finally, Justice Carter dissented, concurring with the result, but rejecting the rationale of the other two justices.<sup>18</sup>

The majority opinion acknowledged and agreed with the trial court's determination that a key point in CBS' favor is the fact that in allowing her book, and the play and movie based on it, to be published, the provisions of section 983 of the California Civil Code mandated that protection of the core dramatic aspects of Ruth McKenny's work had been lost to the public domain.<sup>19</sup> This Code section provided and still provides: "[i]f the owner of a product of the mind intentionally makes it public, a copy or reproduction may be made public by any person, without responsibility to the owner, so far as the law of this state is concerned."<sup>20</sup>

The trial court found that having allowed her story to be published first as a book, then as a play and a motion picture, McKenny had, for purposes of Sec-

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Supreme Court since it reversed the trial court on other grounds. See *Kurlan*, 40 Cal. 2d at 811.

14. See *Kurlan*, 40 Cal. 2d at 811. While the case was pending in the Superior Court on remand from the Supreme Court, a settlement was negotiated between Kurlan and McKenny on the one hand, and CBS on the other. CBS paid a total of \$75,000 to Kurlan in return for a release, from both Kurlan and McKenny, of all claims, whether for violation of literary property, infringement of copyright, or breach of contract, arising from CBS' past or further production of *My Friend Irma*, and of a dismissal of the action with prejudice. *Kurlan Tax Case*, 343 F. 2d at 628.

15. See *Kurlan*, 40 Cal. 2d at 801–11.

16. *Id.* at 811–12.

17. *Id.* at 812–15.

18. *Id.* at 815–23.

19. *Id.* at 807.

20. *Id.*; see also CAL. CIV. CODE §983 (West 2007) (In 1949 the existing section became subd. (a) and subd. (b) was added, a 1982 amendment deleted subd. (a), and the subdivision designations). It is important to note that the publication, in order to forfeit control over rights of reproduction, must be *intentional*. *Id.* An analogous situation would be placing a software program or similar content into a "freeware" site.

tion 983, intentionally allowed her literary property to go into the public domain. As such, the majority held, “[t]herefore, as a matter of law, there is no protectible property in the ‘basic dramatic core’ of the story, its characters and their relationships, or the form and manner of its expression.”<sup>21</sup> This left, therefore, very little content in Kurlan’s radio show that would be entitled to any protection.

The majority opinion did, however, note that Kurlan pled ownership of a new radio production format and radio production idea. Acknowledging that the radio industry was complicated, and that it was beyond the ability of the court to take judicial notice of all of the different ways a radio program could be presented, the Court found that it could not have been determined by the trial court, upon demurrer, that there was no protectible property in those formats and ideas, and for that reason held that the demurrers could not properly have been sustained.<sup>22</sup>

This same rationale was applied by the majority to the rest of the causes of action in Kurlan’s complaint. The Court found that the plagiarism count should not have been dismissed, as evidence might exist that the program format was new and original, and that the concepts in the two programs, each involving a “smart” girl and a “dumb” girl, sharing an apartment in New York, “present questions of fact for a jury as to the contractual provisions, access, similarity and copying.”<sup>23</sup>

In accordance with this reasoning, Justices Edmonds, Gibson, and Shenk, ordered the trial court decision reversed as to each cause of action. The matter was remanded with directions to permit the defendants to answer.<sup>24</sup>

Justice Traynor concurred with the result on the grounds that Kurlan should be allowed to proceed with the litigation based on his breach of contract claim (whether implied or express), but dissented with respect to the majority’s suggestion that any portion of the literary rights held by McKenney were protectible, per Section 983, once they had been intentionally published.<sup>25</sup>

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21. See *Kurlan*, 40 Cal. 2d at 807.

22. *Id.* at 809.

23. *Id.* at 810.

24. *Id.* at 811.

25. *Id.* at 814–15. Justice Traynor felt that a companion section of the Civil Code, § 980, which required protection for works that remained in the author’s physical possession, meant that even unpublished works “might be lost by a transfer of possession of the manuscript even without actual publication.” *Id.* at 814. Given that § 983 refers to the intentional publication of a work as the trigger for a loss of protection, it seems reasonable to assume that Justice Traynor, in making this observation, was also speaking of intentional transfers of unpublished works, an act which usually results in loss of ownership per the “work for

Justice Carter dissented, and in his dissent, offered a strong criticism of the majority's rationale, as well as Justice Traynor's dissent. His arguments, while not embraced by his colleagues on the bench, signaled the approach later courts and the legislature would take on these critical issues in intellectual property law.

## DISSENT

CARTER, J. I dissent.

I concur in the reversal of the judgment but I cannot concur in the greater part of the reasoning and law propounded in the majority opinion.

It is stated by the majority that "Kurlan's complaint shows that any property interest which McKenney may have had in either the story or characters of 'My Sister Eileen' has been lost by publication." The pleading shows that the story and characters were made public in a play, picture, magazines and books. It also shows that the stories had never been presented on the air and that by written agreement plaintiff's assignor had expressly reserved the sole and exclusive right to use for radio broadcasting purposes these leading female characters. "The owner of the common-law copyright has a perpetual right of property and the exclusive right of first general publication, and may, prior thereto, enjoy the benefit of a restricted publication without forfeiture of the right of general publication. Thus, he may communicate the contents of his work under restrictions without forfeiture of the right. *This communication of contents under restriction, is known as a restricted or limited publication.*" (Emphasis added; *Bobbs-Merrill Co. v. Straus*, 147 F. 15, 18.)...

"It is well settled that the public performance of a dramatic or musical composition is merely a limited publication which does not confer upon the hearer or spectator any title to the manuscript, or any right to a copy which may have been obtained surreptitiously, or which may have come into his possession accidentally; because only a publication of the manuscript will amount to an abandonment of the rights of the author and a consequent transfer of them to the public domain, and *no such publication occurs as long as the author exercises control over his manuscript, or has a right to such control.* (*Crowe v. Aiken*, Fed.Cas. 3441; *Keene v. Clark*, 5 Robertson (28 N.Y. Super.Ct.) 38; *Keene v. Kimball*, 16 Gray (Mass.) 545, 77 Am.Dec. 426; *Brown v. Ferris*, 122 Misc. 418,

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hire" doctrine under Federal Copyright law. Currently 17 U.S.C. §201(b) (2006). See also CAL. CIV. CODE §983(b) (West 1953) ("intentionally").

204 N.Y.S. 190.) Consequently a special public use of it by the author for his own benefit is no evidence of abandonment of his property therein, because such a use is entirely consistent with his exclusive right to its control. Thus, the reading, recital or stage representation of a manuscript play in public for profit, with the consent of the author, does not constitute any evidence of abandonment to the public of any rights arising from the authorship of the play; nor does it deprive him of his right to copyright the play. (*Boucicault v. Fox*, 3 Fed.Cas. 977.)

....

*If the author of a play were not entitled to claim the protection of the law to secure to him the profits resulting from public performances of his composition, dramatists would soon cease to write plays for the amusement and entertainment of the public, unless subsidized by government or aided by private patronage: for the revenue derived from the sale of published copies of a popular drama would be negligible in comparison with the box-office receipts. (Werckmeister v. American Litho. Co., 134 F. 321 [69 C.C.A. 553, 68 L.R.A. 591].)*

....

“Where the intent of the owner is to give the public merely a right to a limited use of his literary property or to use it in a particular way, the owner’s act does not constitute an abandonment of all his property; but the *public acquires a right to use it only to the extent of the dedication. (Aronson v. Baker, 43 N.J.Eq. 365, 12 A. 177.)*” (Ball, Law of Copyright and Literary Property, 1944, §61, p. 135.) (Emphasis added.)

It is common practice to reserve the dramatizing rights on the sale of a book and these rights are respected and upheld by the courts. (*Ford v. Charles E. Blaney Amusement Co.*, 148 F. 642). Section 1(b) of the 1909 Copyright Act expressly confers upon the copyright proprietor the exclusive right to transform the work by translation, dramatization, adaptation, and by making other versions embodying material and substantial parts of the original in order to enable the author to reap the profits of his work in every field of intellectual property in which it can be exploited advantageously by vending copies or by public performance for profit. (*O’Neill v. General Film Co.*, 157 N.Y.S. 1028). This section has been literally construed by the courts to cover any adaptation of a literary work which tells the same story as the original, whether the resulting drama be adapted for presentation in the form of a stage play or for exhibition on the screen (*Kalem Co. v. Harper Bros*, 222 U.S. 55 [56 L.Ed. 92, Ann.Cas. 1913A 1285]; *International Film S. Co. v. Affiliated Distributors*, 283 F. 229).

For the purpose of the demurrer, all allegations of the complaint must be taken as true. It is alleged in the complaint here that on or about the 11th day of March, 1946, Ruth McKenney and plaintiff entered into an agreement in writ-

ing, wherein Ruth McKenney did grant to plaintiff the sole and exclusive right to use for radio broadcasting purposes the leading female characters created by her and featured or portrayed in "said stories, stage play and motion picture entitled 'My Sister Eileen,' and said Ruth McKenney did furthermore grant to said plaintiff Arthur Kurlan all radio broadcasting rights therein and thereto *which had theretofore been expressly reserved by said Ruth McKenney in connection with each and all of said prior licenses and uses of said characters in connection with said stories, play and motion picture hereinbefore mentioned.*" (Emphasis added.) It is further alleged that after the expiration of the original term of the agreement the time was extended by the parties, Ruth McKenney and plaintiff; that Ruth McKenney reserved and retained the right to receive royalties in connection with the production of any and all radio programs licensed under the agreement. Hence, plaintiff's assignor reserved all radio rights in the two leading characters, and it cannot be true, as is stated in the majority opinion, that "as a matter of law, there is no protectible property in the 'basic dramatic core' of the story, its characters and their relationships, or the form and manner of its expression" because there has been a publication. The allegations of the complaint show that the publication was a limited one with certain rights reserved.

It has been recognized that different types of rights may be reserved in literary works and that publication may be restricted so as to preserve those rights. See *Manners v. Famous Players-Lasky Corp.*, 262 F. 811; *L. C. Page & Co. v. Fox Film Corp.*, 83 F.2d 196; *Gogniat v. Universal Pictures Corp.*, 35 U.S. Pat.Q. 117; *Casino Productions v. Vitaphone Corp.*, 163 Misc. 403 [295 N.Y.S. 501]; (remaining citations omitted).

At the time Kurlan's cause of action arose, §980 of the Civil Code provided protection for "any product of the mind ... *and* in the representation or expression thereof." (Emphasis added.) The majority says, however, that the two leading characters involved were unoriginal and unworthy of protection inasmuch as any property right in them had been lost by publication. As I have heretofore stated, it is my opinion that the publication was a limited one, with the radio rights expressly reserved and that there was a protectible property interest involved. The statute reads, for our purposes, as it did when this court decided *Golding v. R.K.O. Pictures, Inc.*, 35 Cal.2d 690 [221 P.2d 95], wherein a basic, dramatic core with one important dramatic figure was held to constitute a protectible interest.

Characters and characterizations which are products of the mind *should* be held to be protectible property interests. The radio industry is a large one, and radio programs are frequently based upon a single character, personality or characterization. To illustrate the extremely valuable theatrical-radio proper-

ties which are in existence one only must look as far as the radio column in his daily paper to note the programs, built around a single character, or family, which continue from day to day, week to week, and year to year.\* It should be apparent to even the least intelligent that these programs are as valuable as the most gilt-edged security listed on the Stock Exchange. No court would hesitate to extend its protection to the lawful owner of a security, and yet equally valuable "character-types" are not given the same protection. It is surely a subject of judicial notice that California is the center of the motion picture industry of the world and if its laws are inadequate for the protection of the individual creative writer who must find a market for his work, then those laws should be amended. It is axiomatic that the movie industry could not exist without the writer and yet, if the present trend continues, the writer will vanish from the scene. The same is true of the radio industry. A writer submits his work to either industry in the hope and rightful expectation that if his work is used, he will be paid its value, but, under presently existing conditions, and court decisions, these industries may make minor changes in the play, or manuscript, and escape liability and any obligation to pay any consideration therefor. As Goldsmith wrote (*Enquiry into the Present State of Polite Learning*) as an epitaph to the memory of his friend, Ned Purdon, an author:

"Here lies poor Ned Purdon, from misery freed,  
Who long was a bookseller's hack;  
He led such a damnable life in this world,  
I don't think he'll wish to come back!"

The statement attributed to *Stanley v. Columbia Broadcasting System, Inc.*, 35 Cal.2d 653 [221 P.2d 73, 23 A.L.R.2d 216], found in the majority opinion here is misleading so far as this case is concerned. That statement is "Kurlan's radio program idea was to capitalize upon a famous and successful story, play and motion picture by producing it on the radio. The court may take judicial notice of the fact that there is nothing new and novel in this idea which might constitute protectible property." We said there that there

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\* Sherlock Holmes; The Thin Man; The Fat Man; Michael Shane; Count of Monte Cristo; Crime Doctor; The Whistler; Mr. District Attorney; A Date with Judy; Adventures of Bulldog Drummond; Adventures of Ellery Queen; Adventures of the Falcon; Jack Armstrong; Blondie; Captain Midnight; The Lone Ranger; Stella Dallas; Ma Perkins; The Great Gildersleeve; Perry Mason; Superman; Young Dr. Malone; The Cisco Kid; Fibber McGee and Molly; Mr. and Mrs. North; One Man's Family; The Aldrich Family; Amos 'n' Andy; Edgar Bergen and Charlie McCarthy; Burns and Allen; and many others. (Footnote from the original dissent of Justice Carter).

was “nothing new in a play broadcast over the air.” There is nothing new in a play broadcast over the air, but there is something new in a play broadcast by someone else over the air for the first time *if* the author of that play has reserved the radio rights thereto, because the play is being used in a medium new to it....

Section 426(3) of the Code of Civil Procedure now provides that the copy of the production as to which the infringement is claimed and a copy of the alleged infringing production must be attached to the complaint. This permits the trial court, upon demurrer, to decide in the first instance whether or not there is similarity between the two productions. Heretofore, the question of similarity has been considered to be one of fact (*Stanley v. Columbia Broadcasting System, Inc.*, 35 Cal.2d 653 [221 P.2d 73, 23 A.L.R.2d 216]; *Golding v. R.K.O. Pictures, Inc.*, 35 Cal.2d 690 [221 P.2d 95]); (*remaining citations omitted*) and the test to be that impression received by the average reasonable man upon a comparative reading of the two works. There should be no change in the test to be used under the new code section. It should still be that of the reasonable man. In other words, *if reasonable minds could differ as to whether or not there is similarity between the two works, then the question is still one of fact for the jury.*

....

The briefs show that in describing the radio program entitled “My Friend Irma,” the New York Herald-Tribune, on March 22, 1948, stated in a dramatic criticism and review of the program: “The *central idea*, that of two young girl roommates, one bright, the other one almost intolerably innocent of all knowledge, was *taken almost intact from a very funny play entitled ‘My Sister Eileen.’*” (Emphasis added.) The question of similarity between the two productions is most assuredly one on which reasonable minds might differ as can be seen from the above quoted dramatic review and the fact that three justices of the District Court of Appeal (see (Cal.App.) 233 P.2d 936) as well as myself feel that within the common knowledge of the average reader, observer, spectator or listener there are sufficient similarities to induce the belief that copying has taken place. It is true that there are differences between the two programs, but as Mr. Justice Edmonds said in the *Golding* case “such differences go to the quality of the plagiarism, and not to its existence or nonexistence.” (*Golding v. R.K.O. Pictures, Inc.*, 35 Cal.2d 690, 699 [221 P.2d 95].)

No test other than the reasonable minds one has ever been laid down for determining the question of similarity between the alleged infringed and infringing productions and there is no reason why, in determining the matter upon a demurrer, the trial court should apply any other rule. As I read the majority opinion in this case and in that of *Weitzenkorn v. Lesser, ante*, p. 778 [256 P.2d 947] (this day filed) I do not find that any test has been proposed

other than that of “substantial similarity.” In *Weitzenkorn v. Lesser, supra*, it is said “if some substantial similarity between the compositions reasonably could be found, the issues of similarity and of copying are to be determined by the trier of the fact” and in the instant case it is said that “If, from a comparison of the productions, a question of fact is shown to exist, the cause should be submitted to the jury.” In my opinion, these statements are not the equivalent of saying that the question is one for the jury if reasonable minds could differ on whether or not the two productions are similar.

I would reverse the judgment with directions to the trial court to overrule the demurrer as to all counts and permit defendants to answer if they be so advised.

## Comment

### A Copyright Case in State Court

Any contemporary student or scholar of intellectual property law, coming upon the decision in *Kurlan v. CBS*, will immediately wonder why the case was filed, and remained, in the state court system. Federal Copyright Law, both in the 1909 and 1976 versions of the Act, have always maintained a pre-emption doctrine, found in Section 301 of the Act, which provides that actions based on copyright ownership fall within the exclusive jurisdiction of the federal court system.<sup>26</sup> There is no reference in the decision of the majority, or in any of the concurring opinions or in Justice Carter’s dissent that provide any clues to the answer to this mysterious decision by Kurlan and his counsel to eschew the use of the federal courts and Copyright law in this case.

However, the decision in the tax case filed ten years after the *CBS* case does contain some clues that offer at least partial explanation for the choice of venue.<sup>27</sup> In its discussion of the facts and procedural history of the case, the Court

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26. See The Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified at 17 U.S.C. § 101 (2008)); William F. Patry, 5 PATRY ON COPYRIGHT § 18:3 (2008) (discussing the 1909 Act; the 1909 dual system of state law protection for unpublished (“private”) and federal protection for published works); § 2:2 (comparing the 1909 and 1976 Acts); see also 17 U.S.C.A. § 301 (West 2008) (Historical and Statutory notes discuss the 1976 Act).

27. See *Kurlan Tax Case*, at 343 F. 2d at 625.

of Appeals opinion, written by Circuit Judge Friendly, offered a possible reason why the case was not filed in a federal court:

But the California decision, made on a demurrer, was an authoritative determination only as to those claims which Kurlan had pleaded in the California action, not as to what he had but did not plead.

What Kurlan may well have had in addition were infringement claims to vindicate the radio and television rights secured by McKenny's federal copyright. It is immaterial whether Kurlan's attorney omitted these claims in the California complaint because he lacked faith in them or because he feared that they were outside state court jurisdiction. (citation omitted). Although the federal copyright did not confer a monopoly of the pretty-but-dumb and plain-but-bright combination, which was in the public domain, CBS' presentation may have approached the McKenny characters and their development so closely as to have infringed. (citations omitted). CBS evidently thought so: its lawyers insisted on a broad release of all claims for infringement, in which McKenny joined.

....

... The Settlement did not convey to CBS any interest in the copyright; Kurlan and McKenny simply released claims for past infringement and allowed similar future radio or television use by CBS, retaining their rights against all others.<sup>28</sup>

While the Court's discussion of the reasons why the case was not filed in Federal Court suggest that Kurlan's counsel agreed with the conclusions reached by the state courts—that the publication of McKenny's works had placed the characters and their story lines into the public domain, another doctrine of copyright law, known as *scenes a faire*, may also have led Kurlan and his counsel to hew to the contract, quasi-contract, and tort theories of misappropriation as the basis for the complaint. The doctrine of *scenes a faire* precludes a grant of copyright protection if the work in question is principally composed of common genre elements, as opposed to new, creative expressions. The doctrine is well summarized by the Ninth Circuit in its opinion in *Ets-Hokin v. Skyy Spirits, Inc.*<sup>29</sup> Chief Judge Schroeder, writing for the unanimous Court in that case, explained the doctrine thusly: “[W]hen similar features of a work

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28. *Id.* at 629–30.

29. *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F. 3d 763 (9th Cir. 2003).

are ‘as a practical matter indispensable, or at least standard, in the treatment of a given idea, they are treated like ideas and are therefore not protected by copyright.’”<sup>30</sup>

While we may never know exactly why Kurlan and his counsel chose not to pursue remedies in federal court, one benefit of that decision was that it gave Justice Carter an opportunity to review and consider these issues, an opportunity rarely afforded to state court judges given the preemption doctrine which limits adjudication of copyright law issues to the federal court system.<sup>31</sup>

A significant benefit resulting from Judge Carter’s analysis of this case is his discussion of the impact the doctrine of “limited publication” has on Kurlan’s claim. As the majority noted, Section 983 of the California Civil Code divests creators of works of their rights of control where they intentionally offer the work to the public.<sup>32</sup> However, Justice Carter argued that where the evidence establishes that the creator of the work licensed its use subject to restrictions as to the scope of the license, such a publication is “known as a restricted or limited publication.”<sup>33</sup>

## The Doctrine of Limited Publication

The doctrine of limited publication, like other copyright doctrines (fair use, for example), is a doctrine laden with controversial, conflicting, and often inconsistent applications. Courts struggle with whether face patterns suggest that an author intended to retain rights to their work or to fully dedicate their work to public domain.

A classic example of this struggle is found in the cases which dealt with ownership of the rights to the famous and historic *I Have a Dream* speech, delivered by Dr. Martin Luther King, Jr. on August 28, 1968, during the March

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30. *Id.* at 765–66 (citing *Apple Computer v. Microsoft Corp.*, 35 F. 3d 1444 (9th Cir. 1994)).

31. See Patry, *supra* note 25 at § 18:3 (discussing federal preemption under the 1909 Copyright Act). The preemption doctrine only applies to works which are subject to protection under the Federal Copyright Law. If Ruth McKenney failed to register her work with the Copyright Office, or published it without notice, she would not be entitled to avail herself of the protection of the federal statute, and would instead have to rely on common law copyright protection—another possible reason why Kurlan, as her assignee, did not sue in federal court. For a further discussion of the problems created by the formality requirements of the Copyright Act of 1909, see Marc H. Greenberg, *Reason or Madness: A Defense of Copyright’s Growing Pains*, 7 J. MARSHALL REV. INTELL. PROP. L. 1, 7, 34–35 (2007).

32. See *Kurlan*, 40 Cal. 2d at 807.

33. *Id.* at 816 (citing *Bobbs-Merrill v. Straus*, 147 F. 15, 18 (1908)).

on Washington and sponsored by the Southern Christian Leadership Conference (SCLC) to promote the civil rights movement. The SCLC, which wanted wide press coverage of the March and the speech, sent copies of the text of the speech to media outlets, and allowed live broadcasts of the speech on television and radio.

Shortly after the speech was delivered, an enterprising record company manufactured and distributed sound recordings of the speech. Dr. King brought a copyright infringement action, *King v. Mister Maestro, Inc.*, 224 F. Supp. 101 (S.D.N.Y. 1963) to enjoin the sale of the recordings. The district court found that the widespread distribution to the press and broadcast, and general media coverage, of the speech did not constitute “publication” for purposes of Copyright law, and granted the injunction.<sup>34</sup>

This decision has, for many years, been subject to severe criticism. One commentator characterized the efforts made by the district court as “pretzel-like contortions to avoid forfeiture” and noted: “A more results-oriented law and facts be damned opinion would be hard to find.”<sup>35</sup> It took 35 years before the legal system would get a second opportunity to clarify the limited publication doctrine as it applied to the King speech.

In 1998 the King Estate, relying on the *Maestro* decision, sought another injunction, this time against CBS, Inc., alleging that in producing a video documentary that used excerpts of the speech without authorization CBS had infringed on the copyright to the work held by the Estate. The district court granted summary judgment for CBS, finding that the distribution to the media, and subsequent broadcast of the speech, was a general publication that placed the speech into the public domain.<sup>36</sup>

The district court erred, however, by asserting in part that Dr. King’s public delivery of the speech in Washington was a factor in determining that a general publication of the work had occurred. The district court should have considered Justice Carter’s dissent in *Kurlan*, wherein he stated the long-established principle that the public performance of a work, without any concurrent distribution of hard copies that could be retained by the public, is not a general publication and does not give rise to a forfeiture.<sup>37</sup>

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34. *King v. Mister Maestro, Inc.*, 224 F. Supp. 101 (S.D.N.Y. 1963).

35. William Patry, *Martin Luther King, Jr.* THE PATRY COPYRIGHT BLOG, Jan. 17, 2006, available at <http://williampatry.blogspot.com/2006/01/martin-luther-king-jr.html> (last visited Nov. 19, 2008).

36. *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, 13 F. Supp. 2d 1347 (N.D. Ga. 1998).

37. See *Kurlan*, 40 Cal. 2d at 816–18.

The King Estate appealed, and the Eleventh Circuit Court of Appeals reversed the district court, holding that sufficient issues of fact existed as to whether the nature and extent of the distribution of copies of the work would constitute evidence of a general publication that dedicated the work to the public domain.<sup>38</sup> Citing the *Maestro* decision, among others, the court held that the distribution of copies to the press was a limited, and not a general, publication.<sup>39</sup> The case was remanded for further proceedings in the district court,<sup>40</sup> and the parties later entered into a private settlement of the matter.

The importance and validity of the doctrine of limited publication, whose application was urged by Justice Carter in his *Kurlan* dissent, was therefore reaffirmed by the Eleventh Circuit in this decision, suggesting that Justice Carter was right to support its application in *Kurlan*, and that his dissenting viewpoint should have been adopted by the majority.

### A Prescient Approach—Characters Deserve Separate Protection

When the subject of a literary work, television show, or motion picture includes a story line that focuses on a distinctive character, such as Arthur Conan Doyle's Sherlock Holmes, or Patricia Cornwell's Kay Scarpetta, it creates an interesting question for copyright law—can the character be granted copyright protection separate from the story in which they appear?

In *Kurlan*, the majority opinion sidesteps this issue, stating:

It is suggested, however, that McKenney retained the right to use the characters “Ruth” and “Eileen” in sequels to the original stories. The implication is that no one else could acquire this right. But even if we assume that characterizations may be protectable, these characters were products of the mind which intentionally had been made public. Under the circumstances, there was nothing to prevent McKenney or anyone else from utilizing them in other productions.<sup>41</sup>

In his dissent, Justice Carter made a strong argument that characters should be the subject of separate protectible property interests:

Characters and characterizations which are products of the mind *should* be held to be protectible property interests. . . . It is surely a sub-

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38. *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, 194 F.3d 1211 (11th Cir. 1999).

39. *Id.* at 1215–17.

40. *Id.* at 1220.

41. See *Kurlan*, 40 Cal. 2d at 807–08.

ject of judicial notice that California is the center of the motion picture industry of the world and if its laws are inadequate for the protection of the individual creative writer who must find a market for his work, then those laws should be amended.<sup>42</sup>

Once again, Justice Carter was ahead of his time. The issue of whether to grant separate copyrights to characters had first been addressed in 1930 by Judge Learned Hand, in his opinion in the case of *Nichols v. Universal Pictures Corp.*<sup>43</sup> Judge Hand noted that a case in which an effort is made to separately protect the copyright in characters in a literary work “has never arisen,” and went on to add that if such a claim were made, it would only be valid if the characters were well developed: “It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.”<sup>44</sup>

The importance of “distinctiveness” to the entitlement to copyright protection for a character, first articulated here by Judge Hand, is implicitly echoed by Justice Carter’s discussion of this issue. While Justice Carter does not specifically address this point, he gives a list of then popular characters as examples of the value they have to their creators and owners. Some of those listed are still extremely valuable today (e.g., Superman, Sherlock Holmes, and Blondie)—and have, because of their distinctiveness, obtained the protection of copyright which Justice Carter believed they were entitled to.<sup>45</sup>

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42. *Id.* at 819–20.

43. *Nichols v. Universal Pictures Corp.*, 45 F. 2d 119 (1930). The *Nichols* case dealt with a dispute between plaintiff, author of the play *Abie’s Irish Rose*, and defendant Universal Pictures, which produced a film entitled *The Cohens and The Kellys*. Both works were derivative of Shakespeare’s *Romeo and Juliet*, although with a more appropriate focus on the immigrant issues of the day—a Jewish boy falls in love with an Irish Gentile girl, and their respective parents’ bigotry keeps them apart—unlike Shakespeare’s tragedy, a Hollywood happy ending marks these two works. *Id.* at 120–21.

44. *Id.* at 121.

45. There is an extensive body of literature and case law which has developed over the years since Justice Carter made his plea that characters deserve separate protection. The widow and daughter of Jerome Siegel, creator and author of Superman (along with Joseph Shuster, the artist who created the visual appearance of the character), recently won a decades-long battle over ownership of the rights to the character in *Siegel v. Warner Bros., Time Inc., D.C. Comics*, No. CV-04-8400-SGL (U.S.D.C. C. D. Cal., Mar. 26, 2008). For a short discussion of the relevant law, see Lloyd L. Rich, *Protection of Fictional Characters* (The Publishing Law Center 1998), available at <http://www.publaw.com/fiction.html>. For a more extensive treatment of these issues, see Jasmina Zecevic, *Distinctly Delineated Fictional Characters That Constitute The Story Being Told: Who Are They And Do They Deserve Independent Copyright Protection?* 8 VANDERBILT J. OF ENTMT’T & TECH. L. 365 (2006).

## Prescient Again—New Media Delivery Formats Require Separate Licenses

Over the past 35 years, the ubiquitous proliferation of personal computers, and related items incorporating digital technology, have led to the creation of a number of different media delivery platforms through which we can watch, listen to, and even interact with creative entertainment content. One of the challenges these developments pose for copyright law is whether rights granted for use of a work in one media platform are transferable to a newly developed platform, or whether the new platform requires a new license or permission to use the work. This question has been raised in a case where the creator of the children's story character Curious George sued a video producer for infringement when he manufactured and sold video copies of a series of short television programs depicting the character;<sup>46</sup> in a case where the release of a famous Alfred Hitchcock/Jimmy Stewart film, *Rear Window*, was released on videocassette;<sup>47</sup> and in a case where freelance writers for the New York Times Magazine successfully established that the conversion of articles they wrote and published in the magazine to an online digital archive created by the Times was a separate use for which a separate license should have been obtained.<sup>48</sup>

Once again, in his dissent in *Kurlan*, Justice Carter anticipated this developing body of law, and correctly assessed its outcome—in case after case which followed his dissent, courts have held that new media creates new rights for authors. As Justice Carter put it:

There is nothing new in a play broadcast over the air, but there is something new in a play broadcast over the air for the first time *if* the author of that play has reserved the radio rights thereto, because the play is being used in a medium new to it.<sup>49</sup>

Justice Carter understood that when a work of the mind was presented in different mediums, the creator and owner of that work was entitled to control the circumstances of that new presentation, and to be compensated fairly for this new use.

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46. *Rey v. Lafferty*, 990 F.2d 1379 (1st Cir. 1993) *cert. denied*, 510 U.S. 828 (1993).

47. *Stewart v. Abend*, 495 U.S. 207 (1990).

48. *N.Y. Times Co. v. Tasini*, 533 U.S. 483 (2001).

49. *See Kurlan*, 40 Cal. 2d at 820.

## Conclusion

As noted at the beginning of this brief chapter, state courts rarely address issues relating to copyright law—a body of law primarily encountered in federal court. What is even more rare is for a judge, in a dissenting opinion, to express prescient views regarding important issues that were in their nascent stages at the time of the drafting of his opinion. Justice Carter’s well deserved reputation for insightful and creative approaches to the law is further bur-nished by his dissent in the *Kurlan* case.