

Backus Vs. Gould

Backus Vs. Gould

SooperKanoon Citation : sooperkanoon.com/80083

Court : US Supreme Court

Decided On : 1849

Appeal No. : 48 U.S. 798

Appellant : Backus

Respondent : Gould

Judgement :

Backus v. Gould - 48 U.S. 798 (1849)

U.S. Supreme Court Backus v. Gould, 48 U.S. 7 How. 798 798 (1849)

Backus v. Gould

48 U.S. (7 How.) 798

ERROR TO THE CIRCUIT COURT OF THE UNITED

STATES FOR THE NORTHERN DISTRICT OF NEW YORK

SYLLABUS

By the sixth section of the Act of February 3, 1831, entitled "An act to amend the several acts respecting copyrights," the penalty of fifty cents on each sheet, whether printed or being printed or published or exposed to sale is limited to the

sheets in possession of the party who prints or exposes them to sale.

It does not apply to those sheets which he had published or procured to be published, whether they were found in his possession or not.

This was a *qui tam* action brought by Gould & Banks against Backus for an alleged invasion of their copyright in nine volumes of Cowen's Reports and the first three volumes of Wendell's Reports.

On the trial, the affidavit of John L. Wendell was read, stating that he, the deponent, was the real plaintiff, and that Gould & Banks were merely nominal plaintiffs.

In 1838, Backus published a book entitled

"A Digest of the Causes decided and reported in the Superior Court of the City of New York, the Vice-Chancellor's Court, the Supreme Court of Judicature, the Court of Chancery, and the Court for the Correction of Errors of the State of New York from 1823 to October, 1836, with Tables of the Names of the Cases and of Titles and References, being a Supplement to Johnson's Digest."

To the declaration Backus pleaded *nil debet*.

Upon the trial, the plaintiffs proved themselves entitled to the copyright of the first, second, and fifth volumes of Cowen's Reports and of the second volume of Wendell's Reports. And that from the above volumes the defendant had transferred, literally, one hundred and forty-two and a half pages, and they proved a sale by the defendant of five hundred copies of his work.

The counsel for the defendant then prayed the court to instruct the jury as follows.

1st. That John L. Wendell, and not the plaintiffs, was the owner and proprietor of the copyright to the said first, second, and fifth volumes of Cowen's, and to the said second volume of Wendell's Reports, and that, by the statute, no person but the owner or proprietor could maintain said suit for said penalty, and prayed the court so to instruct the jury. But the court decided that the suit might be maintained

in the name of William Gould and David Banks, notwithstanding the facts set forth in the affidavits of John L. Wendell, and so instructed the

Page 48 U. S. 799

jury and refused to instruct said jury as requested by defendant's counsel, to which decision, instruction, and refusal the counsel for the defendant excepted.

2d. That the said books called the first, second, and fifth volumes of Cowen's Reports and second volume of Wendell's Reports are not the subject of a copyright, and the publisher of them could acquire no exclusive right to the publication thereof, and therefore could not be unlawfully infringed, and prayed the court so to instruct the jury. But the court decided that although the opinions of the several courts, as contained in said volumes of reports, were not the subject of a copyright, yet that the indexes of said volumes, and the statement of the cases preceding the opinions, and the marginal notes, or synopsis of the case, at the head of each case, were the subject of a copyright, for any infringement of which this action would lie, and so charged and instructed the jury and refused to charge or instruct the jury as prayed by the defendant's counsel, to which decision, charge, and instruction and refusal, the defendant's counsel excepted.

3d. The defendant's counsel insisted that if the said indexes were the subject of a copyright, yet it was the duty of the proprietor thereof, who obtained the copyright, to express, in the title deposited and published, where he was not entitled to a copyright of the whole book, the matter for which he claimed such copyright; that he could not obtain a valid copyright to such matter, which was a very small portion of the work, under a general claim to a copyright to the whole book, and in this case he had not only not claimed any such copyright to the indexes, but merely a copyright to the report of the cases, and therefore had not acquired any valid copyright to such indexes, and prayed the court so to instruct the jury. But the court decided that a copyright to the whole book would secure to the proprietors the exclusive right to such matter in the book as was susceptible of a copyright, although such matter composed ever so small a portion of the book, and so instructed the jury, and refused to instruct said jury as requested by the counsel for

the said defendant, to which decision, instruction, and refusal the counsel for the defendant excepted.

4th. The counsel for the defendant also insisted that, the plaintiffs having obtained a copyright purporting to be for the whole book when they were only entitled to a copyright for a very small portion of the matter contained in such book, such copyright was wholly void, and no action would lie for any infringement of it, and prayed the court so to instruct the jury. But the court decided that such copyright would and did secure to the plaintiffs the exclusive right to such matter in

Page 48 U. S. 800

said book, whether it were more or less, as he was entitled to obtain a copyright for, and that said copyright was not void and that this action would lie for an infringement or pirating of any part of the matter in said books for which the plaintiffs were entitled to obtain a copyright, and so instructed the jury, and refused to instruct the jury as prayed by defendant's counsel, to which decision, instruction, and refusal the defendant's counsel excepted.

5th. The counsel for the defendant also further insisted that the publication of the said supplement or third volume of Johnson's Digest was not a printing or publishing of the said first, second, and fifth volumes of Cowen's Reports and second volume of Wendell's Reports of which the said plaintiffs claimed to have the copyright, within the section of either of the acts of Congress giving said penalty. That said penal sections of said acts were to be construed strictly, and did not impose any penalty for printing or publishing a small portion of the matter for which a copyright was obtained; that by the terms of the statute, the penalty was only inflicted for an unauthorized printing, reprinting, or publishing &c.;, a copy or copies of the whole of the map, chart, book or books for which the copyright had been obtained, and that for such printing, reprinting, or publishing any smaller portion than the whole, this action could not be sustained, and prayed the court so to instruct the jury. But the court decided that an action for the penalty, given by the penal section of the act, would lie for the printing, reprinting, or publishing by the defendant of any part or portion of the matter in said first, second, and fifth

volumes of Cowen's Reports and second volume of Wendell's Reports to which the plaintiffs were entitled to a copyright, and so instructed the jury, and refused to instruct the jury as prayed by the defendant's counsel, to which decision, instruction, and refusal the counsel for the defendant excepted.

6th. The defendant's counsel also insisted that the offense for the which the penalty sued for was inflicted by the act of Congress was in the nature of a criminal offense; that the penalty was inflicted by the statute, in part, as a punishment for a criminal offense, and in part as a punishment for a tortuous, if not a criminal, invasion of private property, and that the action was local; and that the act or offense for which this action was brought was committed in the State of Pennsylvania, and therefore out of the jurisdiction of this Court, and consequently the present action could not be sustained, and prayed the court so to instruct the jury. But the court decided that the action could be sustained in any state of the Union, and so charged the jury, and refused to instruct the jury as prayed by

Page 48 U. S. 801

the defendant's counsel, to which decision, charge, and refusal the defendant's counsel excepted.

7th. The counsel for the defendant also insisted that the publication by the defendant of a *bona fide* digest of the first, second, and fifth volumes of Cowen's Reports and second volume of Wendell's Reports was not an infringement of the copyright of the plaintiffs to said books; it was a benefit, and not an injury, to those books; and prayed the court so to instruct the jury that if they found from the evidence in the case that the supplement or third volume of Johnson's Digest published by the said defendant was a *bona fide* digest of the decisions of the cases contained in said volumes and was published by the defendant in good faith, and not for the purpose of furnishing to the public the matter contained in said volumes in a cheaper form or for a less price than those volumes were sold for, and that said digest was in fact a benefit instead of an injury to said volumes and would promote the sales thereof, that then said publication was no infringement of the plaintiffs' said copyright, and this action could not be sustained,

and the defendant would be entitled to their verdict. But the court refused so to instruct the jury, but did charge and instruct the jury that if the defendant had transferred to his said digest any part of the matter contained in the indexes of said first, second, and fifth volumes of Cowen's Reports or second volume of Wendell's Reports and thus availed himself of the labor of others contained in books of which the plaintiffs held the copyright, the plaintiffs were entitled to their verdict, to which refusal and charge and instruction, the defendant's counsel excepted.

8th. The counsel for the defendant also insisted that from the very nature of the work published, the same idea contained in the indexes to said volumes of reports, if correctly stated in said indexes, must necessarily be stated in the digest published by defendant, and if published in English, substantially the same words must be used, and if the work was a *bona fide* digest, and not an evasion for the purpose of furnishing the public with the work in a cheaper form than the original, the publication of said digest by the defendant could not be deemed an invasion of the plaintiffs' copyright, unless the matter in said indexes had been literally transferred to the defendant's digest, and prayed the court so to instruct the jury. But the court refused so to instruct the jury, but instructed them that if the defendant had transferred to the said digest, published by him, any part of matter contained in the indexes to said first, second, and fifth volumes of Cowen's Reports and second volume of Wendell's Reports it was an invasion of the plaintiffs' said

Page 48 U. S. 802

copyright, for which this action would lie, to which refusal and instruction the counsel for the defendant excepted.

9th. In regard to the amount of the penalty to be recovered, the defendant's counsel insisted that the plaintiffs could only recover fifty cents for every sheet of the matter transferred from said index to first, second, and fifth volumes of Cowen's Reports and second volume of Wendell's, to the said digest of said defendant, as had been proved to have been found in his possession, either

printing or printed, published, or exposed for sale, and that there was no legal proof that any such sheets of said matter had been so found in said defendant's possession, and prayed the court so to instruct the jury. But the counsel for plaintiffs insisted that they were entitled to recover fifty cents for every sheet of such matter which had been published, or procured to be published, by the defendant, whether the same were proved to have been found in the defendant's possession or not, and so the court decided and instructed the jury, and refused to instruct the jury as prayed by the counsel for the defendant; to which decision and instruction, and refusal to instruct, the defendant's counsel excepted.

And with such charge and instruction, the court submitted the cause to the jury, which, under such decisions, charge, and instruction, found a verdict for the plaintiffs for \$2,069.75 debt, and six cents costs.

Upon all these exceptions the case came up to this Court.

Page 48 U. S. 810

MR. JUSTICE Mc LEAN delivered the opinion of the Court.

An action of debt was brought by Gould & Banks to recover certain penalties alleged to have been incurred by the invasion of the copyright of the plaintiffs in twelve volumes of law reports, to-wit, nine volumes of Cowen's Reports and three of Wendell's, by the publication of a digest as a supplement or third volume of Johnson's Digest. The defendant pleaded nil debit.

On the trial, the plaintiffs proved themselves entitled to the copyright of the first, second, and fifth volumes of Cowen's Reports and of the second volume of Wendell's Reports; and that from the above volumes the defendant had transferred, literally, one hundred and forty-two and a half pages, and they proved a sale by the defendant of five hundred copies of his work.

The injury complained of consisted in copying from the above reports the marginal notes or indexes of the reporter, and publishing them in the Digest. From the first volume of Cowen's Reports forty pages were copied, from the second volume

twenty-nine, from the fifth fifty-four pages, and from the second volume of Wendell's Reports nineteen and a half pages

Page 48 U. S. 811

were copied, which included the whole of the indexes of that volume except eight and a half pages. The change in the phraseology was so great in these pages that the witness did not consider them as having been transferred to the Digest.

This is a *qui tam* action, and was brought under the sixth section of the act of 1831, entitled "An act to amend the several acts respecting copyrights."

Before the circuit court many points of law were raised, and instructions prayed, on the facts in evidence; but as the decision will turn upon the construction of the above section, under the ninth prayer of the defendant, the other questions will not be considered.

The defendant's counsel insisted

"That the plaintiffs could only recover fifty cents for every sheet of the matter transferred from said index to the first, second, and fifth volumes of Cowen's Reports and the second volume of Wendell's, to the said digest of said defendant, as had been proved to have been found in his possession, either printing or printed, published, or exposed for sale, and that there was no legal proof that any such sheets of said matter had been so found in said defendant's possession, and prayed the court so to instruct the jury."

"But the counsel for plaintiffs insisted that they were entitled to recover fifty cents for every sheet of such matter which had been published, or procured to be published, by the defendant, whether the same were proved to have been found in the defendant's possession or not; and so the court decided and instructed the jury."

And they found a verdict for plaintiffs for "two thousand sixty-nine dollars and seventy-five cents debt, and six cents costs."

The sixth section provides that

"If any person, within the term for which a copyright has been secured, shall print, publish, or import &c.;, sell, or expose to sale, or cause to be published, sold, or exposed to sale, any copy of such book, without consent in writing, such offender shall forfeit every copy of such book to the person legally entitled to the copyright thereof,"

"and shall also forfeit and pay fifty cents for every such sheet which may be found in his possession, either printed or printing, published, imported, or exposed to sale, contrary to the intent of this act."

This penalty of fifty cents of each sheet, whether printed or being printed, or published, or exposed to sale, is limited to the sheets in possession of the defendant. But under the instruction of the court, a verdict was rendered for every sheet which the defendant had published or procured to be published.

As this is a penal section, it must be construed strictly. Under it, every copy of a book published without the consent

Page 48 U. S. 812

of the person having the copyright is forfeited, in addition to the penalty of fifty cents on each sheet in his possession.

The declaration seems not to have been drawn with the view of enforcing any other penalty than that which is imposed for each sheet found in the possession of the defendant.

The judgment of the circuit court is

Reversed and the cause remanded for further proceedings.

ORDER

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and was argued by counsel. On consideration whereof, it is now here ordered and adjudged by this Court, that the judgment of the said circuit court in this cause be and the same is hereby reversed with costs, and that this cause be and the same is hereby remanded to the said circuit court with directions to award a *venire facias de novo*.

SooperKanoon - India's Premier Online Legal Search - sooperkanoon.com