COPYRIGHT IN PORTO RICO AND THE PHILIPPINES*

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The determination of what, if any, law now confers and protects copyrights in Porto Rico and the Philippine Islands involves a brief consideration of the political status of these Islands and their relations to the United States under the Constitution, the Treaty of Paris, and the general principles of International Law. The course of legislation in Congress and in the Island legislative bodies must also be considered.

As a result of the war with Spain, and by the Treaty of Paris, signed December 10, 1900, and ratified the following April, Spain ceded all these Islands to the United States. The Treaty provided, among other things:

> "The civil rights and political status of the native inhabitants of the territories hereby ceded to the United States shall be determined by the Congress." *Treaty of Paris*, Art. IX.

The status of both Porto Rico and the Philippines, under the Constitution and the Treaty, was thus originally precisely the same. The subsequent course of legislation in Congress, however, has been strikingly different with respect to Porto Rico from that with respect to the Philippines. As a result of this difference, while it may be said with confidence that the copyright laws of the United States are fully applicable to Porto Rico, and have been thus in force since the Organic Act of April 12, 1900, providing a civil government for Porto Rico, the situation in the Philippines is somewhat different, and depends upon different considerations.

During the existence of a state of war, and after the Treaty of Peace down to the time of the institution of civil government in these Islands under the respective Organic Acts of Congress, the territory occupied by the military forces of the United States, and all the territory subsequently ceded by Spain to the United States, was governed and administered by the executive branch of our government acting under the war powers. The law thus administered in the Islands by the military government was the general municipal law of the place, except as modified by executive orders of the military authorities and except so far as that law was political in character or inconsistent with the sovereignty of the UnitedS tates. "It is a recognized canon of international law that in the acquisition of territory, by conquest

* While in New York recently the M.S. of this valuable monograph was handed me by the author who is a specialist in copyright law, with a request for an opinion thereon. In view of the subject's importance to the people of the Philippines I am passing it on for publication there with some notes of my own.—Charles S. Lobingier, Shanghai, China.

or cession, the jurisprudence, not political but municipal in character, affecting personal property rights and domestic relations, as they existed between the people under the government from which the territory was carved, remain in full force until altered by the government of the United States. While their allegiance and relation to the former sovereign are dissolved by the acquisition, their relations to each other and their rights of property and obligations remain intact." (In re *Chavez*, 149 Fed. 73, 75.)

Thus Mr. Justice Field has said:

> "It is a general rule of public law, recognized and acted upon by the United States, that whenever political jurisdiction and legislative power over any territory are transferred from one nation or sovereign to another, the municipal laws of the country, that is, laws which are intended for the protection of private rights, continue in force until abrogated or changed by the new government or sovereign. By the cession, public property passes from one government to the other, but private property remains as before, and with it those municipal laws which are designed to secure its peaceful use and enjoyment. As a matter of course, all laws ordinances, and regulations in conflict with the political character, institutions and constitution of the new government are at once displaced ..... The laws of the country on other subjects would necessarily be superseded by existing laws of the new government upon the same matters. But with respect to other laws affecting the possession, use, and transfer of property, and designed to secure good order and peace in the community, and promote its health and prosperity, which are strictly of a municipal character, the rule is general, that a change of government leaves them in force, until, by direct action of the new government, they are altered or repealed." (*Chicago etc. R. Co. v. McGlinn*, 144 U. S. 542.)

Of course, so long as an actual state of war existed between Spain and the United States, the reciprocal rights of the Spanish inhabitants of these Islands to obtain copyright in the United States, and of the citizens of the United States to obtain copyright in the Spanish Islands under the international provisions of the Copyright Law, was wholly suspended in accordance with the well known rule that hostilities between two nations suspend intercourse and deprive citizens of the hostile nations of rights of an international character previously enjoyed. (22, *Opinions of Attorney-General*, 268.)

The question still remains, however, whether the Spanish copyright laws in force in these Islands continued in force after they came under the sovereignty of the United States, either by reason of military occupation, or by the cession made in the treaty of peace. In other words, are the copyright laws of a nation part of the general private municipal law which continues in force upon a change of sovereignty by cession or conquest until changed by action of the new sovereignty? This question, I think, should be answered in the negative. Copyrights, like patents for inventions, are in substance grants from the sovereign of a franchise or privilege. The Spanish laws previously in force in the Islands provided for such grants from the Spanish sovereign and fixing the terms and conditions upon which the same should be held and enjoyed, necessarily could not continue in force. Upon the change of sovereignty, the former sovereign could no longer grant such franchises in the

ceded territory, and of course the terms and conditions upon which the new sovereign would make such grants, if at all, depend solely upon the will of the new sovereign. This is the view taken by Mr. Harlan, attorney general for Porto Rico, who has held, that upon the change of sovereignty, the right of the Insular authorities to issue Letters Patent under the Spanish law terminated.* (*Opinion of the Attorney-General of Porto Rico*, Vol. 1, pp. 74, 181). Thus he said in an opinion dated October 29, 1902:

> "The Spanish law in for in Porto Rico contained provisions for the issuing of letters patent in the Islands, and was in force here at the time of the American occupation. But as the Insular patent system was a part of the Spanish national system for protecting property rights in inventions, it has been thought that upon the institution here of an American government the right of the Insular authorities to issue letters patent was terminated and, together with the body of Spanish legislation on that subject, ceased to be in force in the Islands. This thought is strenghtened by the suggestion that the right to issue letters patent is one that generally belongs to the sovereign, and as the sovereignty of these Islands is lodged in the government at Washington the military then in possession of the Islands were not competent to act upon such matters." (*Opinion Attorney-General of Porto Rico*, p. 182.)

This view is strengthened by a decision in the United States Court of Claims in a case coming up from the Philippines and in which it is suggested that at the time of the cession of the Archipelago only such laws were continued in force as did not involve a sovereign grant of public rights or franchises, but in which it was held that the Spanish laws for the organization of ordinary business corporations were not of this character and therefore continued in force. (*Philippine Sugar Estates Development Co.* v. *U. S.*, 39 Ct. of Cl., 225, 245-248.)

I am, therefore, of the opinion that from the time Porto Rico and the Philippine Islands came under the jurisdiction and control of the United States, the Spanish copyright and patent laws formerly in force in these Islands, ceased to be longer in force, and copyrights or patents could no longer be obtained thereunder. This conclusion is of course not at all inconsistent with the proposition that then existing copyrights and patents, which had fully vested as private property continued in force. This would be in accord with the general principles of international law, and it was specifically provided by the Treaty of Paris that this should be so. *Article XIII of the Treaty* provides:

> "The rights of property secured by copyrights and patents acquired by Spaniards in the Islands of Cuba, and in Porto Rico, the Philippines and other ceded territories, at the time of the exchange of the ratifications of this Treaty, shall continue to be respected." (See also *Decision of the Secretary of War*, 114 ?. G. 2094; *Decisions of Commissioner of Patents*, 1905, p. 565.)

* A similar opinion has been expressed in the Philippines: Willard, "Notes on the Spanish Civil Code," pp. 39, 40; Opinions of Attorney-General of Philippines, III, 453; IV, 8; U. S. v. Yam Tung Wang, Court of First Instance, Manila, May, 1910 (No. 6023). The last-named case was appealed but the point in question was not decided, the Supreme Court saying (10, *Off. Gaz.*, 13):

"The trial court based its judgment dismissing the information and discharging the defendant on the ground that no copyright law exists in the Philippine Islands and that the complaining witness could have no exclusive rights in the pamphlet in question which were subject to violation or infringement, so as to sustain a conviction under Article 539 of the Penal Code. * * * Without going into the question of the correctness of the conclusions of law upon which the trial judge based his action, we are all agreed that the government had no right of appeal from the judgment entered by the court below dismissing the information and discharging this defendant."—C. S. L.

The question then arises whether upon the termination of the operation of the Spanish copyright laws in these Islands, the American copyright laws became substituted in their stead. This question involves the status of the Islands acquired from Spain and their relations to the United States under the Constitution. In the series of decisions known as the *Insular Cases*, the Supreme Court has definitely settled the status of the Island territory acquired from Spain. While the justices were much divided in opinion and reached the result by different courses of reasoning, the net result of these cases pertinent to the question in hand may be stated as follows: By the treaty of cession, Porto Rico and the Philippines ceased forthwith to be foreign territory and became domestic territory appurtenant and belonging to the United States and subject to its jurisdiction, but not incorporated into the United States. These cases also settle that the Constitution did not of its own inherent force and in all its provisions pass to, and becon. operative in, this Island territory of the United States, but that the Constitution and the laws of the United States became applicable in this newly-acquired territory only when they were so extended by the action of Congress. This statement of the effect of the *Insular Cases* is subject to some qualifications not necessary to be considered in this connection. (*De Lima v. Bidwell*, 182 U. S. 1; *Dooley v. U. S.*, 182 U. S. 222; *The Diamond Rings*, 183 U. S. 176; *Door v. U. S.*, 195 U. S. 138.)

It follows that during the military occupation and government of these Islands, and before Congress acted in the premises, the general laws of the United States, including the copyright, trade-mark and patent laws, did not extend to these Islands, except so far as provided by the executive orders of the military government. In *Circular No. 12*, dated April 11, 1899, the War Department provided by general order as follows:

> "In territory subject to military government by the military forces of the United States, owners of patents, including design patents, which have been issued or which may hereafter be issued, and owners of trade-marks, prints and labels duly registered in the United States Patent Office under the laws of the United States relating to the grant of patents and to the registration of trade-marks, prints and labels, shall receive the protection accorded them in the United States under said laws, and an infringement of the rights secured by lawful issue of a patent or by registration of a trade-mark, print or label, shall subject the person or party guilty of such infringement to the liabilities created and imposed by the laws of the United States relating to said matters."

It was further provided in this order that a certified copy of the patent or registration should be filed with the governor of the island wherein such protection is desired, and that the rights of property in patents and trade-marks previously granted under Spanish laws should be respected "as if such laws were in full force and effect."

It will be noted that this order is silent with respect to copyrights, even where it refers to the provisions of the Treaty of Cession for the protection of existing rights of property in patents, trade-marks and copyrights. This was probably inadvertent, but I have found no order specifically extending the copyright laws to the ceded territory.

By Act of Congress of April 12, 1900, Porto Rico was organized and a civil government provided and general legislative powers were conferred upon the government of Porto Rico. *Section 14* of this Act provided as follows:

> "That the statutory laws of the United States not locally inapplicable, except as hereinbefore or hereinafter otherwise provided, shall have the same force and effect in Porto Rico as in the United States."

The effect of this legislation, in my opinion, was to extend to Porto Rico the copyright laws of the United States as then existing, and as subsequently amended or enacted. The Attorney-General of Porto Rico has held that this was the effect of the above quoted provision upon the patent laws, saying:

> "There seems to be no sound reason for doubting that the effect of this provision was to extend to Porto Rico the entire body of federal legislation in respect to letters patent and the protection of property rights thereunder. It may safely be concluded, therefore, that property rights in inventions acquired under federal legislation in that behalf, whether before or after the Treaty of Peace, must be respected in Porto Rico as other property rights are respected. Nor is it to be doubted that the federal courts in Porto Rico and elsewhere would take this view of the question. (*Opinions of the Attorney-General of Porto Rico*, Vol. 1, p. 183.)

There is no difference in this respect between patents and copyrights and therefore I conclude, that the copyright laws of the United States, since that time, have been, and are, in force in Porto Rico.

In addition it may be added that the Copyright Act of March 4, 1909, expressly confers jurisdiction upon the District Court of Porto Rico of suits arising under the copyright laws of the United States. (See §§ 26, 34 and 36.)

For completeness, reference should be made to an opinion of the Attorney-General, dated December 2, 1898, in which he states with respect to these Spanish islands:

> "Porto Rico, Cuba and Manila have not as yet been formally ceded to the United States. So far as they are subjected to the control and government of this country, they are ruled under the principles of belligerent right. They have not become entitled to the rights and privileges of citizens of the United States. In my opinion when they shall have been directly ceded by treaty to the United States, and such treaty duly ratified by the Senate, their respective inhabitants will not be entitled to the benefit of the copyright laws, unless the treaty by its terms confers such right or Congress shall afterwards extend such laws to the inhabitants of those countries." (22, *Opinions of Attorney-General*, p. 268.)

As above noted, Congress did extend the laws of the United States to Porto Rico by Act of April 12, 1900, and since that Act took effect, registration for copyright protection of books by Porto Rican authors have been permitted by the Copyright Office.

In addition, however, this opinion of the Attorney-General has been overruled in an opinion of his successor dated July 6, 1904, upon the ground that these Islands are not "a foreign state or nation" within the meaning of the copyright laws, and that, therefore, the inhabitants of these Islands are entitled to avail themselves

of the benefits of those laws *within* the United States, the copyright laws applying to all persons irrespective of nationality, except citizens or subjects of a foreign state or nation, which does not grant to our citizens reciprocal privileges of copyright. (25, *Opinions of Attorney-General*, p. 179.)

It must be noted, however, that these two opinions of the Attorney-General refer to copyright protection *within* the limits of the United States, and not to protection within the ceded island territory, which is quite a different matter. These opinions do not deal with protection within the Islands.

It is quite clear, therefore, that the existing copyright laws of the United States apply to, and confer protection in, Porto Rico.

The only legislation in Porto Rico upon the subject of either patents or copyrights appears to be a provision making it the duty of the Secretary of Porto Rico "to issue certificates for all patents filed and registered and to record such patents in proper books," and a provision fixing the fees of the Secretary "for registering certificates and issuing certificates of registration of United States patent, trademark, print, label or copyright." (Compiled Statutes and Codes of Porto Rico, §§ 2729, 2730.) There is no general local copyright or patent statute in force in Porto Rico.

By the Philippine Bill (Act of Congress, July 1, 1902) civil government was organized in the Philippines. The first section of this statute provides as follows:

> "The provisions of Section 1891 of the Revised Statutes of 1878 shall not apply to the Philippine Islands."

The section of the Revised Statutes referred to, reads as follows:

> "The constitution and all laws of the United States which are not locally inapplicable shall have the same force and effect within all the organized territories, and in every territory hereafter organized as elsewhere within the United States."

It is seen that this action is diametrically opposite to that taken in regard to Porto Rico. As the Supreme Court has said, both the Treaty with Spain and the legislation of Congress shows that Congress has carefully refrained from incorporating the Philippines into the United States, and from extending the general laws of the United States to the Philippines. (*Door v. U. S.*, 195 U. S. 138.)

Accordingly, none of the general laws of the United States are in force in the Philippines unless extended thereto, either expressly or by necessary implication. Congress, however, has complete and sovereign power over the Philippines and may legislate directly therefor, subject only to such constitutional limitations as may be applicable. All this has been fully settled in the Insular Cases to which reference has been made. The Attorney-General in an opinion dated July 28, 1903, speaking of copyright in the Philippines said:

> "Internationally, they are part of the United States, that is to say, territory under our exclusive sovereignty. But their relations with our own legal system are determinaed by other than international principles. . . . . Congress has not extended the copyright laws to the Philippines but has enacted, in setting up a separate government and institu-

> tion for said Islands that section 1891 of the Revised Statutes, extending the constitution and applicable laws to organized territories, is not to be in force in the Philippines. That a country may be a domestic country and yet not a part of "the United States" is apparent from the thirteenth amendment to the Constitution and various opinions in Insular tariff cases. The treaty and law-making power seemed to have sought to avoid incorporating the Philippines with the United States..... Whether we should regard their resulting status as excluding them from the United States generally, or treat the declaration referred to as equivalent to saying that Congress does not intend the Revised Statutes as amended, including R. S. 4946, to be construed as embracing the Philippines, I think the question presented by the Librarian of Congress should be answered in the negative."

The Attorney-General accordingly held that the provisions of the former copyright law requiring books deposited with the Librarian of Congress to be printed from type set "within the Limits of the United States" etc. was not complied with where the publications were printed from types set within the Philippine Islands. The learned Attorney-General quoted from the opinion of his predecessor, dated December 2, 1898, (22 *Opinion Attorney-General*, p. 269) as follows:

> "When they shall have been directly ceded by treaty to the United States and such treaty duly ratified by the Senate, their respective inhabitants will not be entitled to the benefit of the copyright laws unless the treaty by its terms confers such right, or Congress shall afterwards extend such laws to the inhabitants of those countries."

In a later opinion by a succeeding Attorney-General, dated July 6, 1904, while it was held that the inhabitants of the Philippines were entitled to avail themselves of the copyright laws *within* the United States because not citizens or subjects of a "foreign state or nation," to that extent overruling the Opinion of December 2, 1898, it was again held that the requirement of domestic typesetting, etc., is not complied within the case of publications printed from type set within the Philippines, and the Opinion of July 28, 1903, above cited, was expressly affirmed.

It must be noted that these opinions apply only to the copyright laws of the United States as they existed prior to the present copyright statute which is the Act of March 4, 1909, as amended. The prior copyright acts were all enacted prior to the acquisition of the Philippine Islands and when such an acquisition could not have been contemplated. They, therefore, contain nothing to show a purpose that they should apply to territory subsequently acquired by the United States, and as the Philippines are specifically excepted from the provisions of Section 1891 of the Revised Statutes, above quoted, I am of the opinion, that prior to the Act of March 4, 1909, the copyright laws of the United States were not in force in the Philippine Islands, and as the Spanish copyright law was not continued in force after the change of sovereignty, there was during this period no copyright law in force in the Philippines.

Whether or not the Philippine Commission or the Philippine Legislature as constituted by the Organic Act of July 1, 1902, has power to enact a general copyright law to be operative in the Philippine Islands, and whether Congress could constitutionally delegate the power to enact such a copyright law to the Philippine

government is at least open to some doubt. However, I have not examined this question, because a careful search of the Acts of the Philippine Commission and of the Philippine Legislature down through the year 1912, fails to disclose any attempt upon the part of the Philippine government to enact a copyright law. The laws enacted by the Philippine Commission constitute an "Executive Bureau" and further provide as follows:

> "There shall be a division of the Executive Bureau to be known as the Division of Archives, Patents, Copyrights and Trade-Marks, whose duties shall be performed under the general supervision and control of the Executive Secretary."

This is followed by a short chapter prescribing the duties of "The Division of Archives, Patents, Copyrights and Trade-Marks." The only reference to copyrights, trade-marks or patents in this section is as follows:

> "To perform such other duties in connection with the Division of Archives, Patents, Copyrights and Trade-Marks as may be prescribed by the governor-general or required by law." (See *Compiled Acts of the Philippine Commission*, 1908, §§ 47-54.)

It is possible that by some executive order such as Circular No. 12 of April 11, 1899, issued by the War Department, extending protection to United States trade-marks and patents, and requiring registration of the same in the Islands, has been issued with respect to copyrights, but I have been unable to find any record of the same. Certain it is, however, that no general copyright legislation has been had in the Philippines. There is a complete statute regulating trade-marks, trade-names and unfair competition. (See *Compiled Acts of the Philippine Commission*, §§ 55 *et seq.*), and there is an Act extending protection to United States patents provided a certified copy thereof is filed in the Division of Archives, Patents, Copyrights and Trade-Marks of the Executive Bureau. (See *Compiled Acts of Philippine Commission*, 1908, § 395, *et seq.*), but as stated before, there is no legislation as to copyrights.

The Congress, however, has jurisdiction to legislate directly for the Philippines, and has frequently enacted general laws and made the same applicable to the Philippines equally with other territories of the United States, by including therein something showing an intent to have the same operative in the Philippines. For example, the United States Trade-Mark Law of March 3, 1881, was twice held by different Attorneys-General not to apply to the Philippine Islands, in opinions dated February 19, 1902, (23-*Opinions of Attorney-General*, p. 634) and July 6, 1904, (25, *Opinions of Attorney-General*, p. 579), but the Trade-Mark Act of February 20, 1905, has been held by the Attorney-General to be applicable to the Philippine Islands because that Act expressly provides that in construing it "the United States includes and embraces all territory which is under the jurisdiction and control of the United States." The Attorney-General said that this unequivocally declares the purpose of Congress to bring within the provisions of the Act of the Philippine Islands. (27 *Opinions of Attorney-General* p. 623.)

Again the Pure Food Law (*Act of Congress, June 13, 1906*) applies to the Philippines, because in Section 12 of that Act it is provided:

> "That the term 'territory' as used in this Act shall include the Insular possessions of the United States."

So the Act of Congress of June 13, 1906, with reference to gold or silver falsely stamped is made applicable to the Philippines, because in describing its operation it uses the phrase "territory or possessions of the United States."

I am of the opinion that the United States Copyright Act of March 4, 1909, enacted long after the acquisition of the Philippine Islands and while Congress had plenary power to legislate therefor, contains provisions showing that it was intended to be operative in the Philippine Islands, as well as in all other States and Territories of the United States? The Philippines and other island possessions of the United States were clearly within the contemplation of Congress in enacting this Copyright Act, because it contains several provisions referring thereto. Thus in Section 13 it is provided that copyright deposits must be made within three months after demand "from any part of the United States except in *outlying territorial possessions* of the United States, or within six months from any *outlying territorial possession* of the United States, or from any foreign country," etc. Section 26 provides:

> "That any court given jurisdiction under Section 34 of this Act may proceed in any action, suit or proceeding instituted for violation of any provision hereof to enter judgment or decree to enforce the remedies herein provided."

The remedies provided include an injunction, the recovery of damages and profits, and the seizure of infringing copies, plates, molds, etc. Section 34 of the Act provides:

> "That all actions, suits, or proceedings arising under copyright laws of the United States shall be originally cognizable by the Circuit Court of the United States, the District Court of any Territory, the Supreme Court of the District of Columbia, the District Courts of Alaska, Hawaii and Porto Rico and the Courts of First Instance of the Philippine Islands."

Section 36 provides:

> "That any such court or judge thereof shall have power upon bill in equity filed by any party aggrieved, to grant injunctions to prevent and restrain the violation of any right secured by said laws, etc."

The rules of the Supreme Court regulating the proceedings for the seizure of infringing articles under Section 25 of the Act, which rules have the force of a statute provide for seizure proceedings in "any court given jurisdiction under Section 34 of the Act," and for the seizure of such articles by the Marshal of said Court.

Unless this Act extends to and confers copyright in the Philippine Islands, it is impossible to give any effect to the above provisions which confer jurisdiction upon the Philippine Courts of actions for infringement of copyright. It would be strange indeed if the Philippine Courts were given jurisdiction of suits for infringing acts committed within the limits of the United States, but not of similar acts committed within the Philippines. The Philippine Courts are, by the above provisions

given jurisdiction to seize and impound infringing copies, plates, molds, matrices, etc., and of course this power would be nugatory, unless such infringing copies were found within the territorial jurisdiction of these Courts, and unless this Copyright Act extends to the Philippines, such articles there situated would not be infringing articles. I am of opinion therefore, that the Copyright Law of March 4, 1909, extends to and confers copyright protection in the Philippine Islands, and of course it is not competent for the Philippine Legislature to either add to or subtract from the requirements of an Act of Congress.

I also conclude that copyrights obtained under prior Acts, and subsisting when the Act of 1909 went into effect, were by that Act made operative in the Philippines and must be there respected. Such subsisting copyrights were continued in force, renewals and extensions thereof were authorized, and it was provided that actions for infringement thereof, committed after the new Act went into effect should be prosecuted under the new Act. (Acts of March 4, 1909, § 63.) This authorizes actions for such infringement to be prosecuted in the Philippine Courts, and to that extent extends the former Copyright Acts to those Islands.

The present Act in many places uses the phrase "within the United States," or "within the limits of the United States," as, for example, in the domestic manufacture clauses (§ 15). The proper construction of such phrases, in view of the fact that the statute applies to both, Porto Rico and the Philippines, is difficult and doubtful.

Further legislation by Congress* is extremely desirable to make clear the application of the copyright laws to the "outlying territorial possessions of the United States."

Dated, February 19, 1914.

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* This is especially urgent in view of the Federal Attorney-General's opinion (XXV, 25) which, however, is not shared by the Chief of the Copyright Division of the Library of Congress, that books *printed in the Philippines* are not subject to American copyright.—C. S. L.