

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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THE HILL FOUNDATION, INC., :
 :
 Plaintiff, :
 : Civil 19-377
 -against- :
 CLAYTON F. SUMMY CO., :
 :
 Defendant. :
----- X

MEMORANDUM IN OPPOSITION TO
PLAINTIFF'S MOTION TO VACATE
DEFENDANT'S NOTICE TO EXAMINE
BEFORE TRIAL.

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The defendant heretofore served a notice to take the depositions of the plaintiff's assignors, Patty S. Hill and Jessica M. Hill.

The plaintiff has moved to vacate this notice upon the grounds (1) that the material allegations of the complaint are substantially admitted by the answer, their legal significance only being denied, and that there are no generally controverted issues of fact upon which the plaintiff's assignors could be examined, and (2) that the nature of the action is such that the defendant must be limited in the scope of the matters on which it seeks to make inquiry.

The Nature of the Case

The suit involves the famous song "Happy Birthday to You", of which the defendant and its predecessors have been the publishers since the music first appeared and was copyrighted in 1893 as part of a book called "Song Stories for the Kindergarten." (At that time the present words were not used, the song being called "Good Morning to All.")

The original song was the composite work of one of the plaintiff's assignors, Patty S. Hill and of her sister Mildred J. Hill, since deceased. The original copyright was taken out by Clayton F. Summy. When this copyright was approaching expiration it was renewed by the plaintiff's assignor, Jessica M. Hill, as next of kin of the then deceased Mildred J. Hill.

In the first cause of action the plaintiff seeks an accounting, alleging that the defendant has permitted the song to be used by producers of sound moving pictures and dramatic performances, without the right so to do, or without the permission of the plaintiff's assignors or the plaintiff. The plaintiff seeks an accounting for royalties received by the defendant from such producers.

In the second cause of action the plaintiff alleges that the defendant had certain licenses for the publication,

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sale and performance of various piano arrangements of the song, which required the defendant to account for all copies sold in excess of 500; that such licenses are by their terms revocable; that because of the defendant's wrongful conduct as alleged in the first cause of action, the plaintiff and its assignors have elected to cancel these licenses and to require an accounting.

In the third cause of action the plaintiff alleges that the defendant purchased from the estate of one William Wallace Hill, a brother of the composers, his interest in the copyright and that such purchase was in violation of the defendant's duty to the plaintiff's assignors; and the plaintiff therefore requests a decree that the purchase of such interest be declared null and void and that the defendant be required to convey such interest to the plaintiff.

The defendant's answer in substance puts in issue the allegations of the complaint with respect to its lack of title and the charges of wrongdoing.

I

There are controverted issues of fact upon which an examination may be had.

As will be seen by reference to the amended complaint and the answer thereto, copies of which will be handed to the

Court on the argument, there are a number of controverted issues of fact. (References to the amended complaint will be indicated by the letter C followed by the appropriate paragraph number, and to the answer by the letter A followed by the appropriate paragraph number).

As to the first cause of action. It is alleged by the plaintiff that the composers, Patty S. Hill and Mildred J. Hill, gave Clayton F. Summy (the original publisher) a license to publish and sell the book in which the song appeared, as copyrighted material in his own name (C 4). On the other hand, it is the contention of the defendant that the book was sold outright to Summy, together with all the right, title and interest of the composers (A 2).

The complaint alleges that subsequently Mildred J. Hill licensed the Clayton F. Summy Company (which succeeded Summy individually) to publish and sell certain of the songs in the book above referred to, in a new book to be entitled "Song Stories for the Sunday School", which book contained the song here in question (C 9). The defendant, on the other hand, contends that Mildred J. Hill and the said corporation entered into an agreement whereby the new book was sold, assigned and transferred to the corporation, together with all rights in and to copyright, etc. (A 5).

After alleging the renewal of the copyrights (C 12), the plaintiff goes on to allege that Patty S. Hill and Jessica M. Hill (as next of kin of the then deceased Mildred J. Hill) "acquiesced in the continued publication and sale by said Summy" of the books in question "without any express license therefor" and that Summy thereafter agreed to continue and did continue the publication thereof only upon the terms and conditions contained in and contemplated "by the express licenses" originally granted (C 14).

These allegations are denied by the defendant, which alleges that after the renewal of the copyrights the said corporation and a successor corporation, also known as Clayton F. Summy Co., and thereafter this defendant, by agreement with the Misses Hill, received from them at least all of the right, title and interest which had theretofore been granted by the plaintiff's assignors with respect to the original copyrights (A 8).

The plaintiff further alleges that these "licenses" did not contemplate the use of the song in sound motion pictures or dramatic performances or otherwise, except in sheet music form, nor did these "licenses" contemplate that Summy should have the right to permit the use of the song in sound motion pictures or dramatic performances (C 15).

These allegations are expressly denied in the answer (A 9).

The plaintiff further alleges that thereafter the present defendant was organized without notice to the plaintiff's assignors or the plaintiff that it was a newly created business entity, but that the defendant on the contrary represented that it was the same enterprise but merely under new management, and that this defendant thereupon "secretly" entered into agreements with producers of sound motion pictures and dramatic performances for the use of the song, and purported to hold itself out as having the right to do so, whereas in fact no such right had been granted to it by the plaintiff's assignors or the plaintiff; and that in consequence this defendant received substantial sums of money by way of royalties for the use of the song (C 18).

These allegations of misrepresentation to the plaintiff's assignors and the plaintiff are denied by the defendant, which further states that it is without knowledge or information as to plaintiff's allegation that the arrangements for the use of the song were made with the knowledge of the plaintiff's assignors. The defendant admits that it permitted the use of the song by the producers of sound motion pictures and dramatic performances and had received royalties therefor (A 12).

The plaintiff alleges that its assignors did not learn of the "wrongful acts and conduct of the defendant" until about November 1941 (C 19), an allegation as to which the defendant alleges that it is without knowledge or information (A 13).

Summing up the foregoing, it will be observed as to this first cause of action, that there is a sharp dispute of fact as to exactly what arrangements were made by the composers and the plaintiff's assignors with the defendant and its predecessors in the publishing business, and as to the relationship of the various parties. Most of the history of the case antedates the organization of the defendant, which can only properly prepare for trial by an examination of possibly the only living persons who know the facts, many of which occurred almost exactly fifty years ago. It is uniquely a case where an examination is imperative.

As to the Second cause of action. This cause of action depends in a sense upon the first cause of action, because it proceeds upon the theory that the "licenses" granted to this defendant by Jessica M. Hill may be terminated by the plaintiff because the defendant permitted the use of the song in moving pictures and plays. There are, however,

additional issues of fact in this cause of action.

It is alleged (C 24) that during the years 1934 and 1935 Jessica M. Hill granted to the defendant certain licenses for the publication, sale and performance of various piano arrangements of the song "in the belief that the defendant herein was the same business entity as the first and second corporations above mentioned and described, and in whom she had reposed faith, trust and confidence". The defendant admits the granting of the licenses but otherwise denies the allegations above referred to (A 18).

It is further alleged (C 29) that these licenses are by their terms revocable, an allegation which is expressly denied in the answer (A 21).

As to the third cause of action. This cause of action involves the purchase by the defendant of the interest of one of the next of kin of the deceased Mildred J. Hill, i.e., the interest of William Wallace Hill, who was one of Miss Hill's brothers.

Under this cause of action there is first of all put in issue the facts as to the survivors of the deceased Mildred J. Hill (C 32) (A 24).

Further, the plaintiff alleges that in October 1916 Patty S. Hill, Jessica M. Hill and William Wallace Hill requested the Summy corporation which was conducting the

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business, to pay all royalties payable to Mildred J. Hill to the said Jessica M. Hill, "it being the intention of the parties thereto that all the right, title and interest of the said William Wallace Hill, as one of the heirs and next of kin of the said Mildred J. Hill in and to the aforesaid copyrights and the royalties payable thereunder should be deemed assigned to his sister, Jessica M. Hill, and fixed in her as her sole property", of all of which the first corporation had due notice and in which it acquiesced (C 33).

The defendant denies any knowledge or information with respect to these allegations, except to admit the execution and delivery of a certain paper whose purport is not what is alleged by the plaintiff in the complaint (A 25).

The plaintiff thereafter alleges that William Wallace Hill died in 1933 (C 35) and that in 1939 the defendant purchased from the administrator of his estate all of the estate's interest in the copyrights in question, charging that this was done "while a relationship of trust existed between it and the aforesaid Patty S. Hill and Jessica M. Hill", and that such purchase was without their knowledge (C 39).

The defendant admits the purchase, but avers

that it is without knowledge or information as to whether or not the Misses Hill knew of the purchase, and denies the allegation with respect to the existence of any relationship of trust (A 28).

As to all three causes of action. The allegation that the plaintiff is the assignee of Patty S. Hill and Jessica M. Hill (C 22). As to this allegation the defendant denies any knowledge or information (A 16).

II

The Notice is proper and the examination should not be limited

By the provisions of Rule 26 a of the Federal Rules of Civil Procedure, after an answer has been served "the testimony of any person, whether a party or not, may be taken at the instance of any party by deposition upon oral examination or written interrogatories for the purpose of discovery or for use as evidence in the action or for both purposes."

Rule 26 b goes on to provide

"Scope of Examination. Unless otherwise ordered by the court as provided by Rule 30 b or d, the deponent may be examined regarding any matter, not privileged, which is relevant to the subject matter involved in the pending action, whether relating to the claim or defense of the examining party or to the claim or defense of any other party, including the existence, description, nature, custody, condition, and location of any books, documents, or other tangible things and the identity and location of persons having knowledge of relevant facts."

By the provisions of Rule 30 a such an examination is brought on by the service of a notice in writing.

It must be perfectly manifest that in the instant case the defendant is entitled to examine the plaintiff's assignors as to various matters alleged in the amended complaint, which have been put in issue by the defendant, not only as to the claims, course of dealings and the relationships between these assignors and the various Summy companies throughout the years, but also as to the "existence, description, nature of any books or documents" which may cast any light upon their claims with respect to the title of the song or as to the creation or existence of what the plaintiff has termed "a relationship of trust" between the defendant and its predecessors on the one hand, and the plaintiff's assignors on the other (C 39).

The defendant's notice contains no specification as to the subject matter of the examination, nor is such specification necessary or proper. In Spaeth v. Warner Bros. Pictures, Inc., 1 F.R.D. 729, 4 Fed. Rules Serv. 484 (D.C., S.D., N.Y.), Judge Hulbert said:

"It is not necessary to particularize the subject matter of the examination in the notice, and in my opinion, it should not be done, but a motion may be made before the date of the examination under Rule 30b, or after the examination has been commenced, under Rule 30d, for the relief as therein provided."

The fact that the examination may involve matters upon which the party seeking the examination does not have the affirmative is beside the point. In Laverett v. Continental Briar Pipe Co., 25 Fed. Supp. 80 (D.C., E.D., N.Y.), Judge Moscowitz said (p. 344):

"Limitations which have been placed upon deposition-taking by state courts, such as the necessity of having the affirmative upon the issue on which examination is sought, find no basis in the new rules. It will not avail a party to raise the familiar cry of 'fishing expedition.'"

To the same effect see Newcomb v. Universal Match Corp., 25 Fed. Supp. 169 (D.C., E.D., N.Y.).

Consequently, the plaintiff's criticism that "the defendant's notice is equivalent to a commission to rove at will" is not well taken. The form of the notice is precisely as provided by the rule and is sanctioned by authority.

The plaintiff also makes the criticism that the examination sought will have "the not improbable consequence that the defendant will thereby acquire information to which it is not entitled by the rules of evidence in this stage of the action". The defendant here has in mind, and so states, that this is in the main an action for an accounting. It is true that in this case the plaintiff itself previously sought an examination of the defendant as to the royalties which had been collected, but such an examination was resisted by us on the ground that the plaintiff was not entitled to inquire on that subject until it had been first demonstrated that the

plaintiff was entitled to an accounting. Our position in that respect was sustained by Judge Rifkind. However, here the defendant is endeavoring to examine upon the very issue as to whether the plaintiff is entitled to an accounting.

We seek chiefly to examine the plaintiff's assignors as to the facts and circumstances with respect to the history of the copyright, both in the early years when the plaintiff's assignors were dealing with Mr. Summy and the defendant's predecessor corporations, and as to the controverted allegations with respect to the relationships between the plaintiff's assignors and the defendant itself.

The plaintiff's remedy, should occasion arise, may be found under the provisions of Rule 30d where it is provided that at any time during the taking of the deposition the Court may terminate or limit the examination upon an appropriate showing that it is being conducted in bad faith or in such manner as unreasonably to annoy, embarrass or oppress the deponent.

Conclusion

The plaintiff's motion should be denied.

Dated February 9, 1943.

Respectfully submitted,

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