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Towards a Functional Definition of Publication in Copyright Law

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Towards a Functional Definition of Publication in Copyright Law

Thomas F. Cotter*

Abstract: The questions of whether, when, and where an author has “published” her work of authorship traditionally has given rise to, and continues to give rise to, numerous consequences, including the protectability of the work under U.S. copyright law; the running of various time periods, including a grace period for registering the copyright and the termination of copyright in works made for hire; the applicability of fair use and other exceptions to copyright liability; and the imposition of the duty to deposit two copies of the work with the Library of Congress. Although the 1976 Copyright Act, unlike its predecessors, includes a definition of “publication,” controversies continue to arise concerning the meaning of this term in new and different contexts—for example, whether an author’s posting of material on the Internet constitutes publication giving rise to all of the various rights and duties attendant thereto. In this article, I propose a redefinition of the term “publication,” consistent with the statutory definition, that reconciles some of the conflicting trends in the case law and attempts to resolve some current uncertainties.

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I. Introduction

For almost two hundred years, U.S. law required authors to affix copyright notice to every published copy of their works of authorship, or risk forfeiting their copyright interest in those works.¹ Although the United States abandoned this rule as of March 1, 1989, the date on which the Berne Convention entered into force with respect to the United States,² works published prior to that date without adequate copyright notice fell into the public domain and (subject to some exceptions) remain there today.³ As a result, cases continue to arise--and will continue to arise for another hundred years or so--in which defendants assert that authors forfeited their copyright interests by effecting publication, prior to March 1, 1989, without the requisite copyright notice. Recent cases in which defendants have raised the defense of pre-1989 publication without notice have

¹ See, e.g., *Wheaton v. Peters*, 33 U.S. 591, 661-63 (1834); *Martha Graham School & Dance Found., Inc. v. Martha Graham Center of Contemp. Dance, Inc.*, 380 F.3d 624, 632-33 & n.14 (2d Cir. 2004); *Nat'l Comics Pubs., Inc. v. Fawcett Pubs., Inc.* 191 F.2d 594, 598 (2d Cir. 1951).

² See *infra* text accompanying notes 26-29.

³ See *infra* text accompanying notes 30-31.

involved such disparate works as Dr. Martin Luther King, Jr.'s *I Have a Dream* speech;⁴ the popular New Age text *A Course in Miracles*;⁵ several of Martha Graham's choreographic works;⁶ poetry of Puerto Rico's *poeta nacional* Juan Antonio Corretjer;⁷ a yoga sequence developed by "Yogi to the Stars" Bikram Choudhury;⁸ and photographs by acclaimed fashion photographer Milton Greene.⁹

The question of whether an authorized publication occurred, and if so when, therefore remains relevant to the copyright status of many works of authorship created prior to 1989. But determining whether, when, and sometimes even *where* the first authorized publication occurred remains relevant for several other reasons as well, even with respect to works created on or after March 1, 1989. Among the many practical consequences that the fact, date, or place of publication may affect are the computation of the copyright term for works made for hire, anonymous works, and pseudonymous works; the triggering of the duty to deposit copies of the work with the Library of Congress, and of the option to terminate transfers or to file claims to the renewal term, for qualifying works; the applicability of the fair use defense and several other exceptions to copyright liability; the eligibility of the work for *any* U.S. copyright interest at all, for copyright restoration, or for exemption from the requirement that works be registered

⁴ See *Estate of King v. CBS, Inc.*, 194 F.3d 1211 (11th Cir. 1999).

⁵ See *Penguin Books U.S.A., Inc. v. New Christian Church of Full Endeavor, Ltd.*, 288 F. Supp. 2d 544, 555 (S.D.N.Y. 2003).

⁶ See *Martha Graham*, 380 F.3d 624.

⁷ See *Brown v. Latin Am. Music Co.*, ___ F.3d ___, ___ (1st Cir. 2007).

⁸ See *Open Source Yoga Unity v. Choudhury*, No. C 03-3182 PJH, 2005 WL 756558 (N.D. Cal. Apr. 1, 2005).

⁹ See *Milton H. Greene Archives, Inc. v. BPI Comm'ns, Inc.*, 378 F. Supp. 2d 1189 (C.D. Cal. 2005).

with the U.S. Copyright Office prior to the plaintiff's commencing an action for infringement; and, in the event an action for infringement is filed, the availability of statutory damages and attorneys' fees, both of which remedies are conditioned upon registration of the copyright either before the infringing act begins or within a short period of time after its first publication.¹⁰ This last issue in particular, relating to remedies, has immense importance with respect to works communicated to the general public, but not "published" in a more traditional sense of the term, on the Internet.

Given the continued importance of the term "publication" within U.S. copyright law, one might expect that term to be carefully defined in both statutory and case law. The U.S. Copyright Act, however, has included a definition of the term "publication" only since January 1, 1978, the date the 1976 Copyright Act went into effect.¹¹ Cases arising today involving works that allegedly were published prior to 1978 therefore must rely upon more ambiguous definitions derived from the pre-1978 case law. For publications allegedly occurring on or after January 1, 1978, the statutory definition provides some guidance, but it still leaves many issues, such as the status of Internet transmissions as publications, unresolved. The confusion is best illustrated by the fact that one prominent case (*Estate of King*) elicited three different opinions from an Eleventh Circuit panel as to the proper definition of publication under the law that applied at the time Dr. King delivered his speech in 1963.¹² Similarly, commentators are

¹⁰ See generally *infra* Part II.

¹¹ See Copyright Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2541, 2543, *codified at* 17 U.S.C. § 101 (definition of publication); Leon R. Yankwich, *Some Observations on "Publication" in the Law of Copyright*, 5 BULL. COPYRIGHT SOC'Y U.S.A. 329, 330 (1958) (observing that, as of 1958, "none of the American statutes have defined publication").

¹² See *Estate of King*, 194 F.3d at 1212-20 (opinion of Anderson, C.J.); *id.* at 1220-27 (Cook, J., concurring in part and dissenting in part); *id.* at 1227 (Roney, J., dissenting).

divided on the question whether another recent case, holding that Internet transmissions are publications under the 1976 Act, was correctly decided.¹³

In this Article, I make two principal claims. The first is that the rather jumbled case law involving pre-1978 publications (which, again, will continue to be relevant for some time to come) can best be reconciled by adopting a general rule that a publication occurs when the copyright owner, either personally or through an agent, either (1) distributes, or offers to distribute, at least one copy of the work to members of the general public, or (2) actually distributes at least one tangible copy of the work to at least one person (a) who is authorized to effect a distribution to the general public, and (b) who then effects such a general publication. This definition differs from the common definition of general publication--first articulated by the Ninth Circuit in *White v. Kimmell*,¹⁴ and quoted with approval by courts ever since--under which a general publication is said to occur unless, *inter alia*, the author distributes a copy or copies to a limited group, for a limited purpose, and “without the right of diffusion, reproduction, distribution or sale.”¹⁵ As I will show, despite the courts’ frequent invocation of this standard, they have declined to apply it literally when doing so would lead to perceived undesirable results.¹⁶ My second claim is that the general rule I propose should be further modified in certain discrete cases, such as cases involving personal correspondence or Internet transmissions. With respect to the latter in particular, I will argue that Internet transmissions should be equated with publications for some purposes (such as computing

¹³ See *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002).

¹⁴ 193 F.2d 744 (9th Cir. 1952).

¹⁵ *Id.* at 746-47 (emphasis added).

¹⁶ See generally *infra* Part IV.

statutory time periods and applying the fair use defense) but not for others (such as the duty to deposit and the determination of a work's country of origin).

Part II elaborates upon the consequences that currently flow from the fact, date, or place of publication, and thus better illustrates how publication continues to play an important role in U.S. copyright law. Part III canvases the existing case law and points to several extant ambiguities and contradictions. Part IV develops my thesis that “publication” can and should mean different things in different contexts, depending on the underlying policies at stake. Part V concludes.

II. Why Publication Continues to Matter

As suggested in the Introduction, publication remains an important concept, due both to the continuing stream of copyright infringement actions involving works that may have been published without notice prior to 1989, and to the consequences that follow from publication even after that date. Historically, publication without notice has probably played the more significant role. Prior to enactment of the 1976 Copyright Act, the authorized publication of a work of authorship had two principal effects. First, it resulted in the forfeiture of the author's common-law copyright, which initially vested in every original work of authorship from the moment of its creation.¹⁷ Second, publication

¹⁷ See, e.g., *Caliga v. Inter Ocean Newspaper Co.*, 215 U.S. 182, 188 (1909); *Martha Graham School & Dance Found., Inc. v. Martha Graham Center of Contemp. Dance, Inc.*, 380 F.3d 624, 632-33 & n.14 (2d Cir. 2004); *Nat'l Comics Pubs., Inc. v. Fawcett Pubs., Inc.* 191 F.2d 594, 598 (2d Cir. 1951). Under the 1909 Copyright Act, authors *could* secure federal statutory copyright protection for unpublished works, see Copyright Act of 1909, ch. 320, § 11, 35 Stat. 1075, 1080 (repealed 1976) (“copyright may also be had of the works of an author of which copies are not reproduced for sale, by the deposit, with claim of copyright, of one complete copy of such work”); Elizabeth Townsend Gard, *January 1, 2003: The Birth of the Unpublished Public Domain and Its International Implications*, 24 CARDOZO ARTS & ENTER. L.J. 687, 695-96 (2006); R. Anthony Reese, *Public but Private: Copyright's New Unpublished Public Domain*, 85 TEX. L. REV. 585, 588 n.8 (2007), but the practice of obtaining federal statutory copyright for unpublished works nevertheless appears to have been uncommon. Other countries' laws occasionally use the date of publication as the event from which the copyright term is measured, at least for certain classes of works. See, e.g., Council Directive 93/98/EEC of 29 Oct. 1993 harmonizing the term of protection of copyright

resulted in the vesting of federal statutory copyright protection, but only if every published copy bore the requisite copyright notice.¹⁸ Publication without copyright notice, in other words, resulted in forfeiture of both state and federal copyright protection, resulting in the work's falling into the public domain.¹⁹

Congress modified these results in two ways when it enacted the 1976 Copyright Act.²⁰ First, the 1976 Act eliminated state common-law copyright for original works of authorship that are fixed in a tangible medium of expression, and instead conferred federal statutory copyright upon all such works from the moment of their creation, rather than publication.²¹ (State common-law copyright protection remains viable, though rarely enforced, for original but *unfixed* works of authorship such as improvised musical or choreographic works.)²² Second, the 1976 Act softened, but did not eliminate, the rule

and certain related rights, art. 1(3) (stating that the term of protection for anonymous or pseudonymous works “shall run for seventy years after the work is lawfully made available to the public”).

¹⁸ See *Thompson v. Hubbard*, 131 U.S. 123, 149-50 (1889); *Callaghan v. Myers*, 128 U.S. 617, 651-52 (1888). Under the current version of the Copyright Act, copyright notice with respect to copies consists of “(1) the symbol © (the letter C in a circle), or the word “Copyright”, or the abbreviation “Copr.”; and (2) “the year of first publication of the work . . . and (3) the name of the owner of copyright in the work” 17 U.S.C. § 401(b). The rules are the same for phonorecords, except that the notice consists of the letter P (rather than C) in a circle. See *id.* § 402(b). “Copies,” by the way, are defined as “material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” *Id.* § 101. Moreover, “the term ‘copies’ includes the material object, other than a phonorecord, in which the work is first fixed.” *Id.* Thus, under U.S. copyright law, there are, literally, no originals, only copies (or phonorecords). “Phonorecords” are defined as “material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term ‘phonorecords’ includes the material object in which the sounds are first fixed.” *Id.*

¹⁹ See *Nat’l Comics*, 191 F.2d at 599.

²⁰ See 17 U.S.C. § 302.

²¹ See 17 U.S.C. §§ 301(a), 302(a).

²² See *id.* § 301(b)(1); *U.S. v. Rodriguez Ramirez*, 291 F.Supp.2d 266, 269 n.2 (S.D.N.Y. 2003). State common-law copyright also may still subsist in sound recordings that were fixed prior to 1972. See *Capitol Records, Inc. v. Naxos of Am., Inc.*, 830 N.E.2d 250 (N.Y. 2005).

that publication without copyright notice could result in forfeiture of federal copyright. Under the 1976 Act, forfeiture would not occur if (1) the notice was absent from only a “relatively small number of copies distributed to the public”;²³ (2) registration was made within five years of publication without notice, and the copyright owner made reasonable efforts to add the notice to all copies distributed to the public in the United States after the omission was discovered;²⁴ or (3) the omission was made in violation of an express, written condition imposed by the copyright owner upon the work’s distributor.²⁵

These modifications remained effective for only for eleven years. In 1988, the United States acceded to the 1971 Paris Act of the Berne Convention for the Protection of Literary and Artistic Works,²⁶ an international copyright treaty that, among other things, reflects an unfavorable view of copyright formalities. In relevant part, article 5(1) of the Berne Convention states that “[a]uthors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin . . . the rights specially granted by this Convention.”²⁷ Article 5(2) specifies that “[t]he enjoyment and exercise of these rights shall not be subject to any formality.”²⁸ Although these provisions of the Berne Convention literally obligate the United States

²³ 17 U.S.C. § 405(a)(1).

²⁴ *Id.* § 405(a)(2).

²⁵ *Id.* § 405(a)(3).

²⁶ *See* Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 [hereinafter BCIA].

²⁷ *See* Berne Convention for the Protection of Literary and Artistic Works, art. 5(1), Sept. 9, 1886, last revised, Paris, July 24, 1971, S. Treaty Doc. No. 99-27, 828 U.N.T.S. 221 [hereinafter “Berne Convention”].

²⁸ Berne Convention, art. 5(2).

only to eschew formalities with respect to literary and artistic works the country of origin of which is not the United States—for example, works first published in another Berne Convention member state—pursuant to the Berne Convention Implementation Act of 1988, Congress eliminated mandatory copyright notice altogether, effective March 1, 1989.²⁹ Congress did not make the amendment retroactive, however—although legislation enacted a few years later makes the amendment *potentially* retroactive with respect to *some* works of authorship, the country of origin of which is not the United States³⁰—and thus cases continue to arise in which copyright defendants argue, sometimes successfully, that the plaintiff’s U.S. copyright lapsed due to its publication without the requisite copyright notice prior to March 1, 1989.³¹

A second respect in which publication remains significant is that the Copyright Act sometimes measures the term of copyright, or the date on which certain other benefits accruing to the copyright owner terminate, from the date of first publication. As noted above, historically federal statutory copyright protection vested at the moment of publication, and thereafter it subsisted for a set period of years.³² Under the 1909 Copyright Act, for example, the standard term of protection consisted of a first term of 28 years, which the author had the option of renewing for a second 28-year term.³³

²⁹ Pub. L. No. 100-568, § 7(a), *codified at* 17 U.S.C. §§ 401(a), 402(a).

³⁰ *See infra* text accompanying notes 84-89.

³¹ *See supra* text accompanying notes 5-9.

³² *See supra* notes 17-19 and accompanying text.

³³ *See* Copyright Act of 1909 (Act of Mar. 4, 1909), ch. 320, § 23, 35 Stat. 1075, 1080 (repealed 1976). Authors were still required to file claims to the renewal term, however, until 1992, when renewal became automatic. *See* Copyright Amendments Act of 1992, Pub. L. No. 102-307, § 102(2), 106 Stat. 264, 264-65. Thus, prior to 1992, failure to file a claim to the renewal term still resulted in the work falling into the public domain at the end of the first 28-year term.

Beginning in 1962, however, Congress passed a series of bills extending the copyright term, for works that were then in their second term of protection and the copyrights to which was about to expire, for an additional 19 years, thus conferring an overall term of 75 years from the date of publication upon the works so qualifying.³⁴ Upon enactment of the 1976 Act, all works that were both created and published prior to January 1, 1978, and which had not yet fallen into the public domain as of that date, were accorded a term of 75 years, later extended to 95 years, from the date of publication.³⁵ Works created but not published prior to January 1, 1978, which had not yet fallen into the public domain as of that date, were accorded a term that under some circumstances could be extended further if the owner chose to publish the work.³⁶ Most works created on or after January 1, 1978, were accorded a copyright term consisting of the life of the author plus fifty, later extended to seventy, years.³⁷ For three classes of works created on or after January 1, 1978, however, the copyright term is instead sometimes measured from the date of

³⁴ See H.R. Rep. 94-1476, 94th Cong., 2d Sess., 134 n.14 (1976) (citing Pub. L. Nos. 87-668, 89-142, 90-141, 90-416, 91-147, 91-555, 92-170, 92-566, and 93-573), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5750 n.14.

³⁵ In 1998, Congress extended the copyright term for all works that had not yet fallen into the public domain by another 20 years. Sonny Bono Copyright Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (codified as amended in scattered sections of 17 U.S.C.). Thus, as of January 1, 1978, works that were in their first term of copyright were eligible for a second term of 47, later extended to 67, years, provided that the owner timely claimed the renewal term. See 17 U.S.C. §§ 304(a)(1)(B), (C). For works already in their second term of copyright as of January 1, 1978, Congress extended the renewal term by 19, later 39, years, for a grant total of 95 years from the date copyright was originally secured. See *id.* § 304(b).

³⁶ As noted above, prior to January 1, 1978, unpublished works enjoyed a potentially perpetual state common-law copyright. Upon publication, however, those works were thrust into the public domain unless the owner included the copyright notice on all published copies. See *supra* note ___. As of January 1, 1978, all original and fixed works were accorded federal copyright protection from the moment of creation. Works already in existence as of that date but not yet copyrighted or in the public domain were accorded a federal copyright as of January 1, 1978, that would subsist for the life of the author plus fifty (later extended to seventy) years or December 31, 2002 (i.e., a minimum 25-year federal copyright term), whichever expired later. See 17 U.S.C. § 303. Publication before December 31, 2002, extended the copyright term for another 25 (later extended to 45) years, until December 31, 2047. See *id.*

³⁷ See 17 U.S.C. § 302(a).

publication rather than creation. Specifically, the 1976 Act mandated that the copyright term for anonymous works, pseudonymous works, and works made for hire would comprise 75 years from the date of first publication or 100 years from the date of creation—later extended to 95 years from publication or 120 years from creation--whichever expires first.³⁸ Publication therefore remains and will remain the relevant date from which the term of protection is measured for a large number of works.

The date of first publication also continues to serve as the focal point from which other time periods, within which the copyright owner must act if she wishes to enjoy certain other statutory benefits, are calculated. To put these matters in context, it may be helpful to note first three default rules that apply under U.S. copyright law, absent their displacement by other rules. First, the plaintiff in a copyright infringement action must prove, among other things, that she owns a valid copyright.³⁹ Second, to recover monetary damages, the plaintiff must prove either her own lost profits or the defendant's profits attributable to the infringement; and, in accordance with the American rule, each party presumptively bears his or her own attorney's fees.⁴⁰ Third, copyright owners may

³⁸ *See id.* § 302(c). A work made for hire is any work made by an employee within the scope of his employment, or any of nine types of specially commissioned works if the parties agreed in writing that the work was to be a work for hire. *See id.* § 101. The act deems the author of a work made for hire to be the employer or commissioning party. *See id.* § 201(b). Note also that two types of specially commissioned works that can constitute works made for hire, namely supplementary works and instructional texts, are defined such that only works “prepared for publication” can so qualify. *See id.* § 101 (defining a “supplementary work” as “a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes,” and “instructional text” as “a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities”).

³⁹ *See Feist Publ'ns, Inc. v. Rural Telephone Serv. Co., Inc.*, 499 U.S. 340, 361 (1991).

⁴⁰ *See* 17 U.S.C. § 504(b), (c); *Woodhaven Homes & Realty, Inc. v. Hotz*, 396 F.3d 822, 824 (7th Cir. 2005).

freely transfer or assign their copyright rights, in whole or in part,⁴¹ as long as the transfer (other than a transfer effected by operation of law) is memorialized in a writing signed by the owner or her agent.⁴² All three of these rules can be displaced, to the benefit of the copyright owner, if she takes certain requisite steps, either before or within a specified time from the date of first publication.

The first and second of these default rules, relating to validity, ownership, and entitlement to monetary damages, are modified in the copyright owner's favor if she registers her copyright with the U.S. Copyright Office no later than a specified time period following the date of first publication. To put *this* matter in context, registration is not required as a precondition to the mere *existence* of copyright protection.⁴³ Subject to a handful of exceptions, however, registration *is* required as a precondition to commencing an action for copyright infringement.⁴⁴ An owner who registers the copyright to her work

⁴¹ See 17 U.S.C. § 201(d)(1), (2).

⁴² See *id.* § 204(a). A purported transfer that does not comply with the writing requirement is deemed to be a license—that is, a nonexclusive permission to use. See *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775-76 (7th Cir. 1996). Transfers of common-law copyrights, by contrast, do not have to be memorialized in writing. See *Martha Graham School & Dance Found., Inc. v. Martha Graham Center of Contemp. Dance, Inc.*, 380 F.3d 624, 643 (2d Cir. 2004). Whether a work was published without copyright notice therefore can determine not only whether the copyright remains in existence, but also whether a purported oral transfer of the copyright was effective. See *id.*

⁴³ See 17 U.S.C. § 408 (a).

⁴⁴ See *id.* § 411(a). There are four exceptions to this rule. First, the registration requirement only applies to “United States works,” i.e., works the country of origin of which, under the Berne Convention, is the United States. See *id.*; see also *infra* notes 62-69 and accompanying text (discussing the exemption for non-United States works). Second, if the Copyright Office refuses to register the work (for example, on the ground that it constitutes noncopyrightable subject matter), the purported copyright owner may file suit nonetheless, as long as she serves notice upon the Register of Copyright. See *id.* Third, authors claiming violations of their moral rights, in violation of Copyright Act § 106A(a), are also exempted from the registration requirement. See 17 U.S.C. § 411(a). These moral rights of attribution and integrity subsist, however, only in a small class of original works of visual art as defined by the statute. See *id.* § 101 (defining “work of visual art” as the original of a painting, drawing, print, sculpture, or photograph produced for exhibition purposes only, as well as certain limited edition copies, and excluding all other works, including *inter alia* any motion picture, any “electronic information service, electronic publication, or similar publication,” and any work made for hire). Fourth, in a small class of cases involving works consisting of sounds, images, or both, that are first fixed in a tangible medium of expression simultaneously

either before or within five years after the work's first publication, however, is entitled to a rebuttable presumption of validity and ownership.⁴⁵ This means that, in the event the claimant files suit for infringement, the burden of proving that the copyright is invalid or is owned by someone other than the claimant would fall upon the alleged infringer.

Second, copyright plaintiffs can avoid having to prove actual damages or defendant's profits, and can more readily recover attorneys' fees, if they have timely

with their transmission, the copyright owner may file suit (either before or after fixation) if she (1) "serves notice upon the infringer, not less than 48 hours before such fixation, identifying the work and the specific time and source of its first transmission, and declaring an intention to secure copyright in the work"; and (2) registers the copyright within three months of its first transmission. *See id.* § 411(b); *see also id.* § 101 (defining "[t]o 'transmit' a performance or display" as "to communicate it by any device or process whereby images or sounds are received beyond the place from which they are sent"). For discussion of this provision, *see* 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 7.16[B][3] (2006). A recent amendment to the Copyright Act permits the preregistration of certain works intended for commercial distribution not yet published. *See* 17 U.S.C. § 408(f); *see also infra* note 48.

⁴⁵ *See* 17 U.S.C. § 410(c). The evidentiary weight accorded to a certificate or registration issuing more than five years after first publication is within the discretion of the district court. *See id.* Having registered the copyright, the owner also may record the registration with the U.S. Customs Service. 19 C.F.R. 133.31. Recordation of a work in the name of a person seeking exclusion of imported goods, on the ground that the importation would violate 17 U.S.C. § 602, can provide evidence that the copyright is valid and would be infringed by the unauthorized importation. *See id.* § 603(b); 19 C.F.R. 133.43.

Note also that, for works created and published prior to January 1, 1978, and within their first term of copyright as of that date, renewal for the second copyright term (comprising, since 1998, 67 years) has been automatic since 1992. *See supra* note 33. The person or persons entitled to the renewal term, however, *see* 17 U.S.C. §§ 304(a)(1)(B), (C), may file an application to register a claim to the renewal term, *see id.* § 304(a)(3). If the application is filed within one year before the expiration of the original term, and the claim is registered, the renewal term vests in the person who was entitled to claim the renewal term at the time the application was filed; otherwise, it vests in the person who owned the copyright on the last day of the original term. *See id.* §§ 304(a)(2)(A)(i), (ii). Moreover, unless such a claim is made and registered within this one-year period, the author of "a derivative work prepared under authority of a grant of a transfer or license of the copyright that is made before the expiration of the original term of copyright" may continue to exploit the derivative work during the renewal term on the same terms as applied during the original term. *See id.* § 304(a)(4)(A). Otherwise, the derivative work author's continued exploitation of the derivative work during the renewal term for the underlying work would infringe the copyright in the underlying work. *Venegas-Hernandez v. Peer*, 2004 WL 3686337, at *24 (D. P.R. May 19, 2004), *rev'd on other grounds*, 424 F.3d 50 (1st Cir. 2005). Moreover, a certificate of registration of the renewal term made pursuant to an application filed within the aforementioned one year period serves as "prima facie evidence as to the validity of the copyright during its renewed and extended term and of the facts stated in the certificate." 17 U.S.C. § 304(a)(4)(B). All of these matters relating to the filing of a claim to the renewal term within one year of the expiration of the original term, of course, hinge upon when the original term expires; when the original term expires depends upon when the term commenced, i.e., in the case of a published work, when the work was published. *See supra* text accompanying notes 33-38; 17 U.S.C. § 305 (stating that "[a]ll terms of copyrights provided by sections 302 through 304 run to the end of the calendar year [i.e., December 31] in which they would otherwise expire").

registered their copyrights. Specifically, prevailing copyright plaintiffs may recover so-called statutory damages, ranging from \$750 to \$30,000 for each work infringed,⁴⁶ as well as attorneys' fees,⁴⁷ only if they have registered their copyrights either before the infringement began (in the case of an unpublished work) or (in the case of published works) before the infringement began or within three months of first publication.⁴⁸ According to the legislative history of the 1976 Act, the general purpose of these rules is to encourage copyright owners to provide public notice of their claims to copyright; the specific purpose of the three-month grace period for published works is to "take care of newsworthy or suddenly popular works which may be infringed almost as soon as they are published, before the copyright owner has had a reasonable opportunity to register his

⁴⁶ See 17 U.S.C. § 504(c)(1). In the event of a willful infringement, the court may increase an award of statutory damages up to \$150,000 for each work infringed. See *id.* § 504(c)(2). If the court finds that the infringement was innocent, it may reduce an award of statutory damages to as little as \$200 for each work infringed. See *id.* Publication is relevant to this last-cited provision, insofar as the presence of copyright notice "on the *published* copy or copies to which a defendant in a copyright infringement suit had access" results in no weight being given to the "defendant's interposition of a defense based on innocent infringement in mitigation of actual or statutory damages." *Id.* § 401(d); see also *id.* § 402(d) (stating the same rule for published phonorecords); § 405(b) (discussed *infra* note 59). An exception to *this* rule, which exception can result in the remission of statutory damages altogether, occurs when the defendant had reasonable (but erroneous) grounds for believing her use was a fair use; this exception is available, however, only if, *inter alia*, the defendant is employed by a nonprofit educational institution, library, archive, or public broadcasting entity. See *id.* § 504(c)(2).

⁴⁷ See *id.* § 505 ("Except as otherwise provided by this title, the court may also award a reasonable attorney's fee to the prevailing party as part of the costs"); see also *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 534 (1994) (holding that, in copyright cases, courts should award attorney's fees in an even-handed manner, and fee awards are discretionary, not automatic).

⁴⁸ See 17 U.S.C. § 412. There are a few exceptions to this rule. First, authors claiming violations of their moral rights, in violation of §106A(a), may recover statutory damages and attorneys' fees without having registered. See 17 U.S.C. § 412. Second, a recent amendment to the Copyright Act provides for the preregistration of certain works that are intended for commercial distribution but are not yet published, and which fall into a class of works which the Register of Copyright determines has a history of infringement prior to authorized commercial distribution. See *id.* § 408(f)(1), (2). Preregistration consists of filing a form claiming copyright to the work, and a preregistration fee. See Interim Regulation on Preregistration of Certain Unpublished Copyrighted Claims, 70 Fed. Reg. 61905 (Oct. 27, 2005). Within three months of first publication of the work, the owner must file with the Copyright Office an application to register the work, a deposit of the work, and an application fee. See 17 U.S.C. § 408(f)(3). An action for an infringement that occurs within two months of first publication is subject to dismissal, if the owner does not submit the application, deposit, and fee within three months of first publication or one month after learning of the infringement. See *id.* §§ 408(f)(4), 412.

claim.”⁴⁹ The practical importance of these rules can be illustrated by way of an example. Suppose that Author A creates a work and immediately posts it on his website, on February 2, 2007; that Defendant D begins infringing the work on February 10, 2007; that Author A applies to register his copyright two weeks later; and that he thereafter obtains a certificate of registration, dated May 1, 2007. If the initial Internet posting constitutes a publication, Author A has registered the work within three months of publication; and, assuming he prevails in his copyright infringement action against D, he may obtain statutory damages of up to \$30,000 as well as, possibly, attorneys’ fees.⁵⁰ If the posting does not constitute publication, however, and Author A has not otherwise timely published the work as of the date of infringement, he will be relegated to his actual damages or defendant’s profits, which may be *de minimis*,⁵¹ and he cannot recover his attorneys’ fees either.

The third default rule, relating to transferability of copyright rights, is also subject to modification in a way that potentially can operate for the benefit of copyright owners, though again only if the owner takes certain affirmative steps within a time period that is (often) measured from the date of first publication. This modification can occur in one of two ways. First, authors (or their statutory heirs) have a nonwaivable⁵² right to terminate transfers of copyright effected prior to January 1, 1978, during a five-year period of time

⁴⁹ H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 138, 158 (1976), 1976 USCCAN 5659, 5774.

⁵⁰ See *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002). Accord *Zito v. Steeplechase Films, Inc.*, 267 F. Supp. 2d 1022, 1025 (S.D.N.Y. 2003) (no statutory damages or attorney’s fees recoverable, where infringement occurred prior to publication and more than three months before registration; infringement itself does not constitute publication, because publication must be authorized by the copyright owner).

⁵¹ See, e.g., *Davis v. The Gap, Inc.*, 246 F.3d 152 (2d Cir. 2001) (holding that plaintiff was entitled to actual damages of only \$50).

⁵² See 17 U.S.C. § 304(c)(5).

beginning either 56 years from the date on which copyright was secured, or on January 1, 1978, whichever is later.⁵³ As noted above, prior to January 1, 1978, the date on which federal statutory copyright was “secured” is usually the date of first publication.⁵⁴ Second, authors (or their statutory heirs) have a nonwaivable⁵⁵ right to terminate transfers effected on or after January 1, 1978, during a five-year period beginning either (1) 35 years from the date of the transfer, or (2) “if the grant covers the right of publication of the work,” 35 years from the date of first publication or 40 years from the date of transfer, whichever ends earlier.⁵⁶

Third, publication sometimes imposes certain duties upon copyright owners, or renders their rights less robust than they otherwise would be. For example, U.S. copyright law requires the copyright owner to deposit two copies of most published works with the Library of Congress,⁵⁷ although failure to comply with the deposit

⁵³ *See id.* § 304(c)(3). The logic of this rule is that authors have a better equitable claim than do their assignees to the windfall benefit of the 19-year extension of copyright protection afforded to works still under copyright protection as of January 1, 1978. William F. Patry, *The Copyright Term Extension Act of 1995: Or How Publishers Managed to Steal the Bread from Authors*, 14 *CARDOZO ARTS & ENT. L.J.* 611, 690-91 (1996). The rule does not apply to works made for hire, however, or to transfers effected by will. *See id.* § 304(c). Note also that, when Congress enacted the Copyright term Extension Act in 1998, it provided that the author or owner of a termination right that had expired without being exercised would have a second chance to exercise that right during the five-year period beginning 75 years from the date on which copyright was secured. *See id.* § 304(d).

⁵⁴ *See supra* text accompanying notes 32-38.

⁵⁵ *See* 17 U.S.C. § 203(a)(5).

⁵⁶ *See id.* § 203(a)(3). Like the § 304(c) termination right, the § 203 termination right does not apply to works made for hire or to transfers effected by will. *See id.* § 203(a). The logic of the § 203 rule is to provide authors with a chance to benefit from any increase in the value of their works during that 35-year period. *Walthal v. Rusk*, 172 F.3d 481, 484 (7th Cir. 1999).

⁵⁷ *See* 17 U.S.C. §§ 407(a), (b) (requiring the copyright owner or owner of the exclusive right of publication, within three months of publication of a work in the United States, to deposit “in the Copyright Office for the use or disposition of the Library of Congress” two complete copies or phonorecords of the best edition of the work). The statute permits the Copyright Office to exempt certain classes of works from this requirement. *See id.* § 407(c). Among the works the Copyright Office exempts are stationary, greeting cards, tests, 3-D sculpture works, works only reproducible on dolls or in jewelry, certain catalogs, architectural blue prints, and lectures published individually. *See* 37 C.F.R. § 202.19(c). Note that deposit

requirement results only in a fine,⁵⁸ not forfeiture of copyright. And although the omission of copyright notice from published copies of a work on or after March 1, 1989, no longer results in copyright forfeiture, the inclusion of copyright notice on the copy or copies to which a defendant had access results in no weight being accorded to a “defendant’s interposition of a defense based on innocent infringement in mitigation of actual or statutory damages.”⁵⁹ Further, for works created on or after January 1, 1978, there is a statutory presumption that the author is dead 95 years from the date of first publication, or 120 years from the date of creation, whichever expires first.⁶⁰ This presumption can be useful for determining whether the copyright (which, again, subsists for seventy years following the author’s death) is still in force.⁶¹

In addition, first publication of a work within the United States typically imposes the duty, noted above, to register the copyright before commencing an action for infringement. More precisely, § 411 of the Copyright Act specifies that, subject to certain exceptions, the owner of a “United States work” must register the copyright

is also required in order to register one’s copyright, *see id.* § 408(b), subject to certain exceptions, *see id.* § 408(c), and that copies deposited for the Library of Congress may satisfy this requirement, *see id.* § 408(b).

⁵⁸ *See* 17 U.S.C. § 407(d).

⁵⁹ *Id.* § 401(d); *see also id.* § 402(d). The exception, as noted above, is that an employee of a nonprofit educational institution, library, archive, or public broadcasting entity may be entitled to a remission of statutory damages if he reasonably but erroneously believes that his use was a fair use. *See id.*; *see also* § 504(c)(2). The only time that omission would mitigate *actual*, as opposed to statutory damages, however, would be when the defendant proves that he innocently relied upon, and was misled by, the omission of notice from copies or phonorecords that were publicly distributed with the consent of the copyright owner prior to March 1, 1989. Such a person incurs no liability for actual or statutory damages for any acts committed before receipt of actual notice that registration has been effected. *See id.* § 405(b).

⁶⁰ 17 U.S.C. § 302(e).

⁶¹ The statute provides for a registry in which persons claiming an interest in a copyright may record the author’s death, or a statement that he is still alive. *See id.* § 302(d). After 95 years from the date of publication, or 120 years from the date of creation, whichever expires first, an author will be presumed dead for the past 70 years, if the Copyright Office certifies that its § 302(d) registry discloses nothing to indicate that the author is still alive or has died within the last 70 years. *See id.* § 302(e).

before instituting a civil action for infringement.⁶² A *published* work is a United States work

if the work is first published (A) in the United States; (B) simultaneously in the United States and another treaty party or parties, whose law grants a term of copyright protection that is the same as or longer than the term provided in the United States; (C) simultaneously in the United States and a foreign nation that is not a treaty party; or (D) in a foreign nation that is not a treaty party, and all of the authors of the work are nationals, domiciliaries, or habitual residents of, or in the case of an audiovisual work legal entities with headquarters in, the United States .

. . .⁶³

The statute defines a “treaty party” as “a country or intergovernmental organization other than the United States that is a party to an international agreement.”⁶⁴ An “international agreement” includes “(1) the Universal Copyright Convention; (2) the Geneva Phonograms Convention; (3) the Berne Convention; (4) the WTO Agreement; (5) the WIPO Copyright Treaty; (6) the WIPO Performances and Phonograms Treaty; and (7) any other copyright treaty to which the United States is a party.”⁶⁵ An *unpublished* work

⁶² See 17 U.S.C. § 411(a); see also *supra* note 48 (discussing two of the three exceptions to this rule).

⁶³ 17 U.S.C. § 101.

⁶⁴ *Id.* § 101.

⁶⁵ *Id.* The statute further defines the Geneva Phonograms Convention as “the Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms, concluded at Geneva, Switzerland, on October 29, 1971”; the Berne Convention as “the Convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland, on September 9, 1886, and all acts, protocols, and revisions thereto”; the WIPO Copyright Treaty as “the WIPO Copyright Treaty concluded at Geneva, Switzerland, on December 20, 1996”; and the “WIPO Performances and Phonograms Treaty” as “the WIPO Performances and Phonograms Treaty concluded at Geneva, Switzerland, on December 20, 1996.” *Id.* The WTO Agreement has “the meaning given . . . in paragraph[] (9) . . . of section 2 of the Uruguay Round Agreements Act,” *id.*, namely “the Agreement Establishing the World Trade Organization entered into on April 15, 1994,” see Uruguay Round Agreements Act, Pub. L. NO. 103-465, § 2(9), 108 Stat. 4809, 4814 (1994). The WTO Agreement therefore includes the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). See Marrakesh Agreement Establishing the World Trade Organization, art. 4, § 5, Legal Instruments – Results of the Uruguay Round, 33 I.L.M. 1125, 1146 (1994). The Copyright Act does not define the Universal Copyright Convention (UCC)—a treaty to which the United States and approximately sixty other nations are parties, see available at http://www.unesco.org/culture/copyright/html_eng/ucc52ms.pdf, but which has been eclipsed in importance by Berne and TRIPs. See TRIPs art. 9(1); UCC art. XVII & Appendix Declaration Relating to article XVII. At present, the only nation that is a party to the UCC and not a party to TRIPs, Berne, the WIPO Copyright Treaty, or the WIPO Performances and Phonograms Treaty, is Laos. See WIPO,

is a United States work if “all the authors of the work are nationals, domiciliaries, or habitual residents of the United States, or, in the case of an unpublished audiovisual work, all the authors are legal entities with headquarters in the United States.”⁶⁶ Pictorial, graphic, or sculptural works incorporated into buildings or structures located in the United States are also United States works.⁶⁷ Since the definition of “United States work” more or less tracks the definition of “country of origin” in the Berne Convention,⁶⁸ the effect is to exempt works the country of origin of which is not the United States from the registration requirement. This exemption conforms to Berne Convention article 5(2), which as noted above literally requires only that the exercise and enjoyment of copyright rights not be subject to formalities when the country of origin of a work is a country other than the country within which protection is sought.⁶⁹

A work’s status as a published work also renders the work somewhat more vulnerable to a variety of lawful but unauthorized uses, including fair uses. The fair use doctrine permits the unauthorized use of a copyrighted work in a variety of

*Contracting Parties: Berne Convention, available at http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=15; WIPO, *Contracting Parties: WCT*, available at http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=16; WIPO, *Contracting Parties: WPPT*, available at http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=20; WTO, *Understanding the WTO Organization: Members and States*, http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm; Countries that are not parties to any of these agreements—i.e., which are not “treaty parties” under the statute—include Afghanistan, Ethiopia, Iran, Iraq, and Nepal.*

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ See Berne Convention art. 5(4). I say “more or less” because, as noted *infra* at note 89, the word “published” does not necessarily have the same meaning under the Berne Convention as it does under U.S. domestic law.

⁶⁹ See *supra* text accompanying note 29.

circumstances.⁷⁰ Among the factors courts take into account in determining whether a use is fair is the “nature of the work,”⁷¹ and one aspect of the “nature of the work” that courts take into account is whether the work is published or unpublished.⁷² In the wake of the Supreme Court’s decision in *Harper & Row Publishers, Inc. v. The Nation Enterprises*,⁷³ several courts appeared to view the unpublished nature of a work as being almost dispositive in favor of the copyright plaintiff.⁷⁴ In reaction to these decisions, in 1992 Congress amended § 107 by adding the now-final sentence “The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.”⁷⁵ Courts nevertheless continue to consider the unpublished nature of the work as a factor weighing in favor of the plaintiff,⁷⁶ due both to the perceived value in protecting personal privacy⁷⁷ and to the economic value to the author of being able time the publication of her work.⁷⁸ A handful of other copyright

⁷⁰ See generally 17 U.S.C. § 107; Thomas F. Cotter, *Fair Use and Copyright Overenforcement*, available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=951839.

⁷¹ See 17 U.S.C. § 107.

⁷² See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985) (holding that a work’s status as an unpublished work militates against the unauthorized use being a fair use); Pierre Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1120 (1990).

⁷³ 471 U.S. 539, 562 (1985).

⁷⁴ See, e.g., *Wright v. Warner Books, Inc.*, 953 F.2d 731, 737 (2d Cir. 1991); *New Era Publs. Int’l, ApS v. Henry Holt & Co., Inc.*, 837 F.2d 576, 583 (2d Cir. 1989); *Salinger v. Random House, Inc.*, 81 F.2d 97, 99 (2d Cir. 1987).

⁷⁵ 17 U.S.C. § 107 (final sentence).

⁷⁶ See *Sandoval v. New Line Cinema Corp.*, 973 F. Supp. 409, 413 (S.D.N.Y. 1997); *Wright v. Warner Bros., Inc.*, 953 F.2d 731, 737 (2d Cir. 1991). See also Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005*, 156 U. PA. L. REV. ___ (forthcoming 2007), available at <http://www.bartonbeebe.com>.

⁷⁷ See *Harper & Row*, 471 U.S. at 554; cf. Rebecca Tushnet, *My Fair Ladies: Sex, Gender, and Fair Use in Copyright*, 15 AM. U. J. GENDER, SOC. POL’Y & L. 273, 291-94 (2007) (critiquing the privacy rationale).

⁷⁸ See *Harper & Row*, 471 U.S. at 554-55.

exceptions of more limited applicability also are available only to users of published works.⁷⁹

Finally, just as it may be relevant to determine *where* a work was first published to determine whether it qualifies as a “United States work” for purposes of § 411’s registration requirement, determining where a work was first published also can sometimes establish whether the work qualifies for copyright protection within the United States *at all*. According to § 104 of the Copyright Act, U.S. copyright subsists in all original *unpublished* works of authorship, fixed in a tangible medium of expression, regardless of the author’s nationality or domicile.⁸⁰ In other words, U.S. copyright subsists in unpublished works (assuming those works are original and fixed) from the moment of creation, wherever those works happen to be created. Upon publication,

⁷⁹ See 17 U.S.C. § 108(b) (permitting libraries and archives to reproduce and distribute “three copies or phonorecords of an unpublished work duplicated solely for purposes of preservation and security or for deposit for research use in another library or archives,” subject to certain conditions); *id.* § 108(c) (permitting libraries and archives to reproduce “three copies or phonorecords of a published work that is damaged, deteriorated, lost, or stolen, or if the existing format in which the work is stored has become obsolete,” subject to certain conditions); *id.* § 108(h) (permitting libraries and archives to copy, distribute, display, or perform a published work “for purposes of preservation, scholarship, or research,” during the last 20 years of copyright protection, subject to certain conditions); *id.* § 108(i) (stating that the preceding three exceptions do not apply to musical works, pictorial, graphic, or sculptural works, or motion pictures or other audiovisual works other than audiovisual works dealing with news, “except that no such limitation shall apply with respect to rights granted by [§§ 108(b), (c), or (h)] or with respect to pictorial or graphic works published as illustrations, diagrams, or similar adjuncts to works of which copies are reproduced or distributed in accordance with” § 108(d) or (e)); *id.* § 110(9) (permitting the unauthorized “performance on a single occasion of a dramatic literary work published at least ten years before the date of the performance, by or in the course of a transmission specifically designed for and primarily directed to blind or other handicapped persons,” subject to certain conditions); *id.* § 118(b) (permitting “owners of copyright in published nondramatic musical works and published pictorial, graphic, and sculptural works and any public broadcasting entities” to negotiate for compulsory license fees for certain uses by public broadcasters, subject to certain conditions, including §§ 118(d) and (f)); *id.* § 121(a) (permitting the reproduction and distribution of “copies or phonorecords of previously published, nondramatic literary work[s] . . . in specialized formats exclusively for use by blind or other persons with disabilities,” subject to conditions); *id.* § 1201(g)(2) (permitting circumvention of technological measures “as applied to a copy, phonorecord, performance, or display of a published work in the course of an act of good faith encryption research,” subject to certain conditions).

⁸⁰ See 17 U.S.C. § 104(a).

however, U.S. copyright continues to subsist in the work only if one or more of the following conditions is met. First, a published work is subject to U.S. copyright if “on the date of first publication, one or more of the authors is a national or domiciliary of the United States, or is a national, domiciliary, or sovereign authority of a treaty party, or is a stateless person, wherever that person may be domiciled.”⁸¹ Alternatively, a published work can be subject to U.S. copyright protection if it “is first published in the United States or in a foreign nation that, on the date of first publication, is a treaty party”; if “the work is a sound recording that was first fixed in a treaty party”; “the work is a pictorial, graphic, or sculptural work that is incorporated into a building or other structure, or an architectural work that is embodied in a building and the building or structure is located in the United States or a treaty party”; or “the work is first published by the United Nations or any of its specialized agencies, or by the Organization of American States.”⁸² The upshot is that a work the author of which is not a national or domiciliary of the United States and which is first published in a non-treaty party loses its U.S. copyright protection upon that first publication. Novels first published in Iran or Iraq, for example,

⁸¹ *Id.* § 104(b)(1).

⁸² 17 U.S.C. §§ 104(b)(2)-(5). Note that:

... a work that is published in the United States or a treaty party within 30 days after publication in a foreign nation that is not a treaty party shall be considered to be first published in the United States or such treaty party, as the case may be.

Id. § 104(b). This provision is consistent with Berne Convention article 4(4)(b), which provides that the country of origin for works “published simultaneously in a country outside the Union and in a country of the Union” shall be the Union country. Article 3(4) defines states that “[a] work shall be considered as having been published simultaneously in several countries if it has been published in two or more countries within thirty days of its first publication.” Finally, a published work can be subject to U.S. copyright protection if the work comes within the scope of a presidential proclamation as specified in the statute. *See* 17 U.S.C. § 104(b)(6).

neither of which nations currently are parties to any international copyright treaty, may fit within this category unless they were simultaneously published in a treaty party.⁸³

Nevertheless, under some circumstances it is possible for U.S. copyrights that were forfeited due to lack of national eligibility—or due to the copyright owner’s failure to comply with mandatory U.S. copyright formalities prior to the U.S. adherence to the Berne Convention—to be restored. Once again, however, the issue of *where* a work was first published, and thus of what constitutes publication, becomes crucial. Upon U.S. adherence to the WTO in 1994, Congress enacted Copyright Act § 104A, which restores copyrights to qualifying works of authorship subject to several conditions. Specifically, § 104A restores copyrights in works whose country of origin (using Berne Convention terminology) is a member of an international copyright agreement, other than the United States, and which would still be under copyright protection under U.S. law but for the owner’s failure to comply with formalities that were once required (such as publication with notice, or copyright renewal) or previous lack of national eligibility under § 104.⁸⁴ To qualify for copyright restoration, a published work must (among other things) have been “first published in an eligible country and not published in the United States during the 30-day period following publication in such eligible country.”⁸⁵ In addition, the work

⁸³ Saddam Hussein reportedly published at least four novels during his lifetime. See Jo Tatchell, *Saddam the Romancier*, PROSPECT (July 2004), available at <http://www.prospect-magazine.co.uk/pdfarticle.php?id=6171>. Assuming that the original, Arabic-language versions of these works were originally published in Iraq, their U.S. copyright status would depend upon whether they were simultaneously published in some other country with which the United States enjoys copyright treaty relations.

⁸⁴ See Copyright Restoration Act Pub. L. No. 103-182, 107 Stat. 2057 (1993), codified as amended at 17 U.S.C. §§ 104A, 609(a).

⁸⁵ According to the statute, unpublished works also are subject to copyright restoration. See 17 U.S.C. § 104A(h)(8)(B). There appear to be only a few situations in which this provision might apply, however. See 3 NIMMER & NIMMER, *supra* note 44, § 9A.04[A][2], at 9A-29 n.31.

may not be in the public domain in its source country through expiration of the term of protection.⁸⁶ In the case of a published work, the source country is the eligible country in which the work was first published, or if published on the same day in two or more eligible countries, the eligible country with the most significant contacts.⁸⁷ An eligible country is a country other than the United States that becomes a member of the WTO on or after December 8, 1994; or on or after that date becomes a party to the Berne Convention, the WIPO Copyright Treaty, the WIPO Performances and Phonograms Treaty; or after that date becomes subject to a relevant presidential proclamation.⁸⁸ Some potential conflict of laws issues lurking within the statute (e.g., which country's definition of "published" applies in determining whether a work was first published in an eligible country) have yet to be litigated.⁸⁹

A few hypotheticals help to illustrate how the preceding rules can have practical consequences. First, suppose that Author A, a citizen and resident of France, first made his original, fixed work of authorship available to some members of the public in France, and nowhere else, in December 1970. He next made it available in the United States in March 1971, but he omitted the copyright notice from all tangible copies. If the "making available" of the work of authorship constituted a publication, then the omission of copyright notice resulted in the forfeiture of U.S. copyright (although the copyright might

⁸⁶ *See id.* § 104A(h)(8)(6)(B).

⁸⁷ *See id.* § 104A(h)(8)(C).

⁸⁸ *See id.* § 104A(h)(3).

⁸⁹ Note that the Berne Convention's definition of "publication" differs from the U.S. Copyright Act, by expressly adopting as a criterion the availability of such copies as "to satisfy the reasonable requirements of the public, having regard to the nature of the work." Berne Convention, art. 3(3). Like the U.S. Copyright Act, however, the Berne Convention takes the position that performance, broadcasting, and display do not constitute publication. *See id.*

be subject to restoration as of January 1, 1996, the effective date of the Copyright Restoration Act.)⁹⁰ If not—if the work was and remains technically unpublished in both the United States and France, despite its having been made “available” on some basis or another—then U.S. common-law copyright subsisted from the date of creation, and was displaced by federal statutory copyright protection as of January 1, 1978. To make matters more complicated, suppose that the United States would consider the work as having been published in France (according to which country’s definition of “publication”?) without copyright notice, but that the work was never (technically) published in the United States. Did the French publication without copyright notice result in forfeiture of U.S. copyright, or is publication without notice relevant only to publications occurring within the United States?⁹¹ Alternatively, suppose that the work was not “published” in France in 1970 but *was* “published” in the United States, without copyright notice, in 1971. Under these circumstances, the U.S. copyright was forfeited and is *not* subject to restoration, because the work was first published in the United States.⁹²

Next, suppose instead that Author B, a U.S. citizen who is domiciled in Canada, first makes copies of her literary work available to members of the general public in the

⁹⁰ See *id.* § 104A(h)(2)(A).

⁹¹ The modern trend appears to support the rule that foreign publication without copyright notice does *not* result in forfeiture of the U.S. copyright. See *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162, 1166 (9th Cir. 1996); *Heim v. Universal Pictures Co.*, 154 F.2d 480, 486-87 (2d Cir. 1946); *Societe Civile Succession Richard Guino v. Beseder, Inc.*, 414 F. Supp. 2d 944, 948-50 (D. Ariz. 2006). As the Nimmer treatise notes, however, the issue has never been definitively resolved. See 2 NIMMER & NIMMER, *supra* note 44, § 7.12[D][2][a], at 7-102. The court in *Twin Books* also held that the U.S. copyright term would begin on the date of first publication with notice, whether U.S. or foreign. See *Twin Books*, 83 F.3d at 1168. The district court in *Guino*, however, as well as the Nimmer treatise, have sharply criticized this aspect of the *Twin Books* ruling. See *Guino*, 414 F. Supp. 2d at 949-51; 1 NIMMER & NIMMER, *supra* note 44, § 4.01[C][1].

⁹² See 17 U.S.C. § 104A(h)(8).

United States on May 1, 2006, and in Canada on May 15, 2006. Assuming that these events constitute “publication” for purposes of the Berne Convention, the Berne Convention would deem Canada the country of origin of the work, because the work was “simultaneously” published in both countries and Canada has a shorter term of copyright protection than does the United States.⁹³ The United States therefore would be required, under Berne Convention articles 5(1) and 5(2), to ensure that Author B’s exercise and enjoyment of her rights not be subject to any formality.⁹⁴ In conformity with these rules, the U.S. Copyright Act (probably) would not consider the work to be a “United States work,”⁹⁵ and therefore would not require Author B to register her copyright before filing

⁹³ Both the United States and Canada are members of the 1971 Paris Act of the Berne Convention. See WIPO, *Contracting Parties: Berne Convention*, available at http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=15. As noted above, under the Berne Convention a work is “considered as having been published simultaneously in several countries if it has been published in two or more countries within thirty days of its first publication.” Berne Convention art. 3(4). Article 4(a) of the Berne Convention provides that “[t]he country of origin shall be considered to be . . . in the case of works published simultaneously in several countries of the union which grant different terms of protection, the country whose legislation grants the shortest term of protection.” At present, the term of protection in Canada consists of the life of the author plus fifty years, and therefore is shorter than the standard term of protection in the United States. Canada Copyright Act, R.S.C. ch. C-42, § 6 (1985). Assuming that the work was “published,” for Berne Convention purposes, in the United States on May 1 and in Canada on May 15, the country of origin is Canada.

⁹⁴ See *supra* text accompanying notes 26-28. (The United States could, but it does not, limit Author B to the life-plus-fifty copyright term to which she is entitled in Canada. See Berne Convention art. 7(8); see also TRIPs Agreement art. 3(1) (permitting member states to continue applying this provision of the Berne Convention)).

⁹⁵ At least, that appears to be the correct result, although the Copyright Act is not as clear as it should be on this point. As noted above, with respect to published works, a “United States work” is a work first published in the United States, or “simultaneously in the United States and another treaty party . . . whose law grants a term of copyright protection that is the same as or longer than the term provided in the United States.” 17 U.S.C. § 101. The word “simultaneously” is not defined in the current version of the Copyright Act. Cf. U.S. COPYRIGHT OFFICE, COPYRIGHT LAW OF THE UNITED STATES AND RELATED LAWS CONTAINED IN TITLE 17 OF THE U.S. CODE, APPENDIX VI, DEFINITION OF “BERNE CONVENTION WORK”, available at <http://www.copyright.gov/title17/appendixvi.pdf> (noting without explanation that “[t]he WIPO Copyright and Performances Phonogram Treaties Implementation Act of 1998 deleted the definition of ‘Berne Convention work’ from” Copyright Act § 101, but that under the deleted definition a work was considered simultaneously published in a Berne and a non-Berne member nation if “its dates of publication are within 30 days of one another”). Assuming that the word “simultaneously” has the same meaning in the Copyright Act as it has in the Berne Convention, however, the work at issue in the hypothetical above, despite having been chronologically, and literally, first published in the United States, would not qualify as a United States work. *But cf.* 17 U.S.C. § 104(c).

suit for infringement.⁹⁶ If, however, the “making available” at issue does not constitute “publication,” then (at least until publication occurs) under the Berne Convention the country of origin of the work is the “country of the Union of which the author is a national,”⁹⁷ i.e., the United States; U.S. law would, consistent with the Berne Convention, consider the work to be a “United States work.”⁹⁸ Author B then would be required to register the copyright to the work prior to filing suit for infringement.⁹⁹

The situation may be even more complex if Author B made her work available by uploading it onto the Internet, rather than by making more traditional hard copies available. At present, the question of whether an Internet posting constitutes publication under U.S. law remains unresolved.¹⁰⁰ Assuming, for the sake of argument, that a

⁹⁶ *See id.* § 411(a). The United States would require Author B to register the work in a timely fashion if she wanted to obtain statutory damages or attorneys’ fees, however, *see id.* § 412; it would in most cases require her to deposit two published copies for the Library of Congress, *see id.* § 407(a); and it would permit a defendant to assert innocent infringement in mitigation of statutory damages, if the published copies to which the defendant had access did not bear copyright notice, *see id.* §§ 401(d), 402(d). The United States considers such rules as not targeting the “enjoyment or . . . exercise” of copyright rights, and therefore not in violation of the Berne Convention. *See La Resolana Architects, P.A. v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1205-06 (10th Cir. 2005).

⁹⁷ Berne Convention art. 5(4)(c).

⁹⁸ *See* 17 U.S.C. § 101 (defining an unpublished work as a “United States work” only if “all the authors of the work are nationals, domiciliaries, or habitual residents of the United States”).

⁹⁹ *See id.* § 411(a). Although some courts allow copyright plaintiffs to file suit concurrently with their filing of an application to register their copyrights, *see, e.g., Prunte v. Universal Music Group*, 484 F. Supp. 2d 32, 40 (D.D.C. 2007), or to register the copyright and then file “an amended complaint including an allegation that the copyrighted work is registered,” *Zito v. Steeplechase Films, Inc.* 267 F. Supp.2 d 1022, 1025 (N.D. Cal. 2003), many require literal compliance with the rule. *See, e.g., La Resolana Architects, P.A. v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200-01 (10th Cir. 2005); *Jennette v. United States*, No. 07-335C, 2007 WL 1771998, at *5 (Fed. Cl. June 19, 2007).

¹⁰⁰ *See infra* notes 185-97 and accompanying text. The Berne Convention also leaves this question unresolved. On the one hand, the Convention defines “published works” as “works published with the consent of their authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work”; and it goes on to state that “[t]he performance of a dramatic, dramatico-musical, cinematographic or musical work, the public recitation of a literary work, the communication by wire or the broadcasting of literary or artistic works, the exhibition of a work of art and the construction of a work of architecture shall not constitute publication.” Berne Convention art. 3(3). (Similarly, the UCC

posting *is* or *can be* a publication, under whatever country’s law governs, would the United States view the work as having been simultaneously published everywhere that it was *available* for public viewing within the first 30 days (in which case the work is not a “United States work,” and its country of origin for Berne Convention purposes would be the country with the shortest term of protection in the entire world, whatever that is),¹⁰¹ or only in countries in which it was actually downloaded within the first thirty days?

defines publication as “the reproduction in tangible form and the general distribution to the public of copies of a work from which it can be read or otherwise visually perceived.” UCC art. VI (1971).) Posting a work on the World Wide Web clearly makes the work “available” to a wide range of persons—pretty much anyone with Internet access anywhere in the world, except for countries that block access to a particular site—but it does not necessarily result in a “manufacture of . . . copies,” and thus might be better characterized as a communication or broadcast. See RayMing Chang, “Publication” Does Not Really Mean Publication: The Need to Amend the Definition of Publication in the Copyright Act, 33 AIPLA Q.J. 225, 226 (2005); see also MIHÁLY FICSOR, THE LAW OF COPYRIGHT AND THE INTERNET 207 (2002) (noting possible reluctance on the part of some nations to equate digital transmissions with distributions of tangible copies). On the other hand, one might argue that, because a person who accesses a website necessarily makes a temporary copy of the website’s content in the random access memory (RAM) of her computer, the website author *has* published the website simply by making it available for public access (“whatever the means of manufacture of the copies”). See 1 SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS § 6.25, at 277 n.160 (2d ed. 2006) (noting this possibility); see also *infra* notes 184-91 and accompanying text. *A fortiori*, if the author permits users to download the content of the website, one could argue that the author has effected a publication for purposes of article 3(3). See 1 RICKETSON & GINSBURG, *supra*, at 277-78 (arguing that making a work available for downloading over a publicly accessible website effects a publication of the work); see also *infra* text accompanying note 90. One consequence of so construing the word “publication,” however, may be that the “country of origin” of a work first “published” on the Internet would be the country with the shortest term of protection, see *infra* note 101 and accompanying text. Perhaps the “country of origin” concept itself needs to be rethought in the digital age. See 1 RICKETSON & GINSBURG, *supra*, §§ 6.59-6.64 (arguing in favor of a new rule, equating country of origin with the country of the author’s nationality or residence, in cases involving digital transmissions); Paul Edward Geller, *Conflicts of Laws in Copyright Cases: Infringement and Ownership Issues*, 51 J. COPYRIGHT SOC’Y U.S.A. 315, 363 n.217 (2004).

¹⁰¹ To be sure, members of the Berne Convention are not free to make their copyright terms as short as they wish; but the minimum terms required under the Convention are shorter than the minimum U.S. copyright term. First, the general minimum term under Berne consists of the life of the author plus fifty years, see Berne Convention art. 7(1), as opposed to the general U.S. term of life plus seventy. Second, with respect to photographs, the Berne Convention permits a minimum term of 25 years from the date of making. See *id.* art. 7(4) (permitting a minimum term, for photographs and applied art, of 25 years from the making of the work). The WIPO Copyright Treaty requires member states not to apply the Berne minimum term to photographs, see WIPO Copyright Treaty art. 9, but to date only 64 countries have ratified or acceded to that treaty. See WIPO, *Contracting Parties: WCT*, available at http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=16. Third, the Berne Convention permits member states to accord cinematographic works a minimum term of fifty years from the date “the work has been made available to the public with the consent of the author, or failing such an event within fifty years from the making of such a work, fifty years after the making”; and for anonymous and pseudonymous works a term of fifty years from the date a work “has been lawfully made available to the

To sum up, the *fact* that a work has been published means that (1) the copyright owner has or had an incentive (a) to affix copyright notice, lest she either forfeit copyright altogether or minimize her monetary recovery for infringement; and (b) to deposit copies of the work; and (2) unauthorized users of the work may be better able to invoke fair use or other exceptions to liability. In addition, in a small number of cases whether a work was published (or prepared for publication) may have a bearing on whether the work qualifies as a work made for hire or a work of visual art. Assuming that a publication has occurred, the *date* of publication can be relevant because it (sometimes or always) serves as the point from which (1) termination of the copyright term is either calculated or presumed; (2) a termination of transfer must be effected, if at all; (3) a claim to the renewal term must be filed, if it is to have maximum effect; (4) the copyright owner must register the copyright to her work, assuming she has not done so already, if she wishes to obtain various benefits (presumption of validity and ownership, the entitlement to statutory damages and attorney's fees) that are conditioned upon registration; and (5) the copyright owner must deposit copies of her work. Finally, the *place where* publication was first made can affect (1) the author's ability to claim federal statutory copyright protection at all; (2) her ability to claim exemption from having to register her copyright before filing suit; and (3) her ability to claim ownership of a

public." See Berne Convention arts. 7(2), (3); see also 1 RICKETSON & GINSBURG, *supra* note 100, § 9.48 (noting that the term "made available to the public" is not necessarily synonymous with "publication"). The TRIPs Agreement, however, clarifies that, for member states of the WTO, "[w]henever the term of protection of a work, other than a photographic work or work of applied art, is calculated on a basis other than the life of a natural person, such term shall be no less than 50 years from the end of the calendar year of authorized *publication*, or, failing such authorized publication within 50 years from the making of the work, 50 years from the end of the calendar year of making." TRIPs Agreement art. 12 (emphasis added). Since TRIPs otherwise requires member states to apply article 7(1) of the Berne Convention, see TRIPs Agreement art. 9(1), the effect of TRIPs article 12 is to require WTO members to accord a minimum term to motion pictures and to anonymous and pseudonymous works of fifty years *from publication or making*, whichever expires first, and not the more ambiguous fifty years from the date of making "available."

restored copyright. That the fact, date, and place of publication can generate so many consequences, while the meaning Congress and the courts have imposed upon the term “publication” remains elusive and contradictory, is surprising. Developing a definition that is consistent with the outcomes, if not the stated rationales, of most of the existing cases would help to rationalize the law, while providing some degree of consistency and continuity between the present and past. Moreover, to the extent that *date* of publication serves merely as a convenient marker—a timing device—from which to measure the termination of other rights and duties, developing a more rigorous set of criteria for determining whether and when publication has occurred might further reduce social costs, by lending some certainty and predictability to outcomes. Finally, to the extent that fact or place of publication serves as a proxy for some balance of substantive or political interests—e.g., of favoring users over authors, or foreign- over domestic-origin works—one might ask, again, whether a broader criterion, incorporating any communication to the relevant public whether by publication, performance, or display, would provide a better “fit” than publication alone. Before addressing these issues, however, I discuss in the following section the contours of existing case law on the definition of “publication.”

III. Statutory and Judicial Definitions of Publication

Despite the key role that publication played under the 1909 Act, neither that statute nor any earlier United States copyright act defined the term “publication.”¹⁰² In

¹⁰² The 1909 Act did define the term “date of publication” as:

In the interpretation and construction of this title “the date of publication” shall in the case of a work of which copies are reproduced for sale or distribution be held to be the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed by the proprietor of the copyright or under his authority . . .

an influential law review article published in 1956, Melville Nimmer distilled the following definition of “publication” from the case law as it then existed:

The relevant decisions indicate that *publication occurs when by consent of the copyright owner the original or tangible copies of a work are sold, leased, loaned, given away, or otherwise made available to the general public, or when an authorized offer is made to dispose of the work in any such manner even if a sale or other such disposition does not in fact occur.*¹⁰³

Nimmer went on to elaborate that although “the work need not be offered in sufficient numbers to satisfy the public demand and, indeed, may be effected by sale or other distribution of a single copy, such copies as are available must be offered to all members of the public who are interested”;¹⁰⁴ and that “a *sine qua non* of publication should be the acquisition by members of the public of a possessory interest in *tangible* copies of the work in question.”¹⁰⁵ Nimmer’s definition can still be found in the treatise now published by his son David,¹⁰⁶ and courts have repeatedly cited that definition with approval.¹⁰⁷

Unlike the 1909 Act, the 1976 Copyright Act provides a definition of the word “publication” and in general follows Nimmer’s interpretation. The Act defines publication as “the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute

Copyright Act of 1909, § 26.

¹⁰³ Melville W. Nimmer, *Copyright Publication*, 56 COLUM. L. REV. 185, 187 (1956) (emphasis in original; citations omitted).

¹⁰⁴ *Id.* at 187.

¹⁰⁵ *See id.* at 197.

¹⁰⁶ *See* 1 NIMMER & NIMMER, *supra* note 44, § 4.04, at 4-20.1 to 21; *see also id.* at § 4.07[A], at 4-43 (repeating the “*sine qua non*” language quoted above).

¹⁰⁷ *See, e.g.,* Shoptalk, Ltd. v. Concorde-New Horizons Corp., 168 F.3d 586, 590 (2d Cir. 1999); Dolman v. Agee, 157 F.3d 708, 713 (9th Cir. 1998); Brown v. Tabb, 714 F.2d 1088, 1091 (11th Cir. 1983).

copies or phonorecords to a group of persons for purposes further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.”¹⁰⁸ This definition of publication is largely contiguous with the copyright owner’s right under Copyright Act § 106(3) “to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending.”¹⁰⁹ A distribution authorized by the copyright owner therefore would appear to be equivalent to a publication. Moreover, a person who makes an unauthorized distribution, not subject to any copyright exception, would clearly be distributing the work (and thereby infringing), but he would not be publishing the work; courts unanimously have agreed with Nimmer that only publications authorized by the copyright owner count as “publications.”¹¹⁰

Courts applying the 1909 Act, and in some instances the 1976 Act, have made several other distinctions among different types of public disclosures. One issue that attracted relatively little attention until fairly recently centers on the status of works that are lawfully adapted into other (derivative) works, which derivative works are then

¹⁰⁸ 17 U.S.C. § 101. “To ‘perform’ a work means to recite, render, play, dance, or act it, either directly or by means of any device or process or, in the case of a motion picture or other audiovisual work, to show its images in any sequence or to make the sounds accompanying it audible.” *Id.* “To perform or display a work ‘publicly’ means—(1) to perform or display it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; or (2) to transmit or otherwise communicate a performance or display of the work to a place specified by clause (1) or to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times.” *Id.* “To ‘display’ a work means to show a copy of it, either directly or by means of a film, slide, television image, or any other device or process or, in the case of a motion picture or other audiovisual work, to show individual images nonsequentially.” *Id.*

¹⁰⁹ *Id.* § 106(3).

¹¹⁰ *See, e.g.*, *Harris Custom Builders, Inc. v. Hoffmeyer*, 92 F.3d 517, 520-21 (7th Cir. 1996); *Sanga Music, Inc. v. EMI Blackwood Music, Inc.*, 55 F.3d 756, 758-59 (2d Cir. 1995); *Zito v. Steeplechase Films, Inc.*, 267 F. Supp. 2d 1022, 1026 (N.D. Cal. 2003).

published under the authority of the derivative-work author. Neither the 1909 nor the 1976 Act clearly indicates whether publication of a derivative work results in publication of the underlying work.¹¹¹ The more recent decisions, however, follow the rule that publication of a derivative work also constitutes publication of so much of the underlying work as is reproduced in the derivative work.¹¹² Another distinction, first articulated by Judge Jerome Frank in *American Visuals Corp. v. Holland*,¹¹³ was between so-called “investive” and “divestive” publications. According to Judge Frank, when the copyright owner was the party urging that a publication had occurred, and hence that its work had become invested with federal copyright protection (assuming compliance with the relevant formalities), courts imposed a relatively low burden of proof on the issue of

¹¹¹ See 1 NIMMER & NIMMER, *supra* note 44, § 4.12, at 4-59 (noting “surprisingly little case authority on the question”).

¹¹² See, e.g., *Shoptalk, Ltd. v. Concorde-New Horizons Corp.*, 168 F.3d 586, 591-93 (2d Cir. 1999); *Batjac Prods. Inc. v. Goodtimes Home Video Corp.*, 160 F.3d 1223, 1233-36 (9th Cir. 1998); *Harris Custom Builders, Inc. v. Hoffmeyer*, 92 F.3d 517, 520 (7th Cir. 1996). This rule has given rise to some problems with respect to musical works incorporated into sound recordings, since industry practice up until the 1970s was not to include copyright notice on sound recordings. See 1 NIMMER & NIMMER, *supra* note 44, § 4.05[B][4]; Benjamin Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 472 & n.20 (1955). Sound recordings themselves were not subject to federal copyright protection until 1972. See Sound Recording Act of 1972, Pub. L. No. 92-140, § 3, 85 Stat. 391, 392, *codified as amended in scattered sections of 17 U.S.C.* By the late 1990s, however, the majority of lower courts addressing this issue had concluded that publication of a sound recording does indeed constitute publication of the underlying musical work. See, e.g., *La Cienega Music Co. v. ZZ Top*, 44 F.3d 813, 815 (9th Cir. 1995). Congress enacted legislation in 1997 to reverse these decisions, at least with respect to works that had not been held to be in the public domain prior to the date of the legislation. See Act of Nov. 13, 1997, Pub. L. No. 105-80, § 11, 111 Stat. 1529, 1534, *codified at 17 U.S.C. § 303(b)* (“The distribution before January 1, 1978, of a phonorecord shall not for any purpose constitute a publication of the musical work embodied therein”).

Some courts also took the position that the publication of a derivative work or a collective work that incorporated independently copyrightable underlying works needed to include separate copyright notices for those underlying works, unless the owner of copyright in both derivative (or collective) work, on the one hand, and of the underlying work, on the other, were the same, and the year of first publication of both works was the same; failure to comply with this rule could result in forfeiture of copyright in the underlying work. See, e.g., *Sanga Music, Inc. v. EMI Blackwood Music, Inc.*, 55 F.3d 756, 759-60 (2d Cir. 1995); *Goodis v. United Artists Tel., Inc.*, 425 F.2d 397, 400 (2d Cir. 1970). The Second Circuit repudiated this rule, however, in *Goodis*, and the 1976 Act repudiates it altogether. See 17 U.S.C. § 401(b)(2), 404(a). See also 2 NIMMER & NIMMER, *supra* note 44, § 7.12[C][1], at 7-94.

¹¹³ 239 F.2d 740 (2d Cir. 1956).

whether a publication occurred.¹¹⁴ When, on the other hand, the defendant was the party urging that a publication had occurred, such that the work had been divested of all copyright protection due to the owner's failure to comply with formalities, courts required a stronger showing of publication.¹¹⁵ Cases involving this set of issues also sometimes have involved the related question of whether an allegedly divestive publication was a general or limited publication, a distinction I return to below.

Two other areas of controversy involve the effects of public performance and displays, on the one hand, and the distinction between general versus limited publications, on the other. As for performances and displays, by the middle of the twentieth century most courts that had considered the issue had concluded that the public performance or display of a work of authorship did not, by itself, constitute publication of the work performed or displayed.¹¹⁶ To some courts and commentators, this rule

¹¹⁴ See *id.* at 743; *Hirshon v. United Artists Corp.*, 243 F.2d 640, 644-45 (D.C. Cir. 1957).

¹¹⁵ See, e.g., *Roy Export Co. v. Columbia Broad. Sys.*, 672 F.2d 1095, 1102-03 (2d Cir. 1982); *Am. Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1027 (9th Cir. 1981). The Nimmer treatise, however, argues that, despite the application of Judge Frank's distinction between investive and divestive publications in cases such as the preceding ones, in general that distinction has rarely been a decisive factor. See 1 NIMMER & NIMMER, § 4.13[C], at 4-75.

¹¹⁶ See, e.g., *Ferris v. Frohman*, 223 U.S. 424, 435-37 (1912); *Am. Tobacco Co. v. Werckmeister*, 207 U.S. 284, 299-300 (1907); *John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.*, 322 F.3d 26, 37 (1st Cir. 2003); *American Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1027 (9th Cir. 1981); *Nutt v. Nat'l Inst. Inc.*, 31 F.2d 236, 238 (2d Cir. 1929); *McCarthy & Fischer, Inc. v. White*, 259 F. 364, 364 (S.D.N.Y. 1919); *Tompkins v. Halleck*, 133 Mass. 32, 36 (1882); *Palmer v. Dewitt*, 47 N.Y. 532, 543-44 (1872). There were some cases to the contrary. See, e.g., *Morton v. Raphael*, 79 N.E.2d 522, 523-24 (Ill. 1948); *Keene v. Kimball*, 82 Mass. 545, 549 (1860); *Z Bar Net, Inc. v. Helena Television, Inc.*, 125 U.S.P.Q. 595, 596 (Mont. Dist. Ct. 1960); see also *Blanc v. Lantz*, 83 U.S.P.Q. 137, 139 (Cal. Super. 1949) (citing *Loew's Inc. v. Super. Ct.*, 115 P.2d 983, 985-86 (Cal. 1941)) (noting division of authority). As Nimmer and other noted, however, by the mid-1950s most U.S. courts had repudiated this view. See Nimmer, *supra* note 103, at 194-95; Herman F. Selvin, *Should Performance Dedicate?*, 42 CAL. L. REV. 40, 51 (1954). Selvin nevertheless argued that a rule equating performance with publication would be desirable; that the rule espoused by Nimmer was not quite as firmly established as Nimmer and others would have had one believe; and that, in principle, a public performance could result in dedication of the play right (the right to publicly perform a play) even if not the right to reproduce the work in tangible copies. See Selvin, *supra*, at 45. Selvin conceded, however, that the case law as of 1954 weighed against such a rule and that any change would most likely require Congressional action. See *id.* at 51.

followed from the premise that copyright generally reflects a balance of private versus public interests; thus, while the author's interest in privacy may justify potentially perpetual common-law copyright in unpublished works, once the author has forsaken privacy and sought to exploit her work by the release of tangible copies, the balance of interests shifts in favor of the more limited statutory copyright protection.¹¹⁷ This rationale is clearly vulnerable, however, to the counterargument that public performances and displays often result in the loss of any privacy or secrecy interest in the work, and may bring as much (or more) economic reward as would the distribution of tangible copies.¹¹⁸ Several practical reasons for not equating performance or display with publication nevertheless also suggest themselves. One is that a rule equating

Cases nevertheless have continued to arise on the issue of whether the deposit of a copy or copies in a public library or archive, or in a governmental office, constitutes publication. Merely depositing a copy with a library, for purposes of permitting on-premises inspection, probably is not a publication, *see* *Kramer v. Newman*, 749 F. Supp. 542, 551 (S.D.N.Y. 1990) ("It would appear . . . that in this Circuit mere presence of an otherwise unpublished work in an academic library is not the legal equivalent of publication") (citing *Wright v. Warner Books*, 748 F. Supp. 105, 108 (S.D.N.Y. 1990), and *Salinger v. Random House, Inc.*, 811 F.2d 90 (2d Cir. 1987)); *Frederick Chusid & Co.*, 326 F. Supp. 1043, 1064 (S.D.N.Y. 1971); *but see Jewelers' Mercantile Agency, Ltd. v. Jewelers' Weekly Pub. Co.*, 49 N.E. 872, 875-76 (N.Y. 1889) (suggesting that making a work available for off-premises lending to the general public constitutes a general publication); *Ladd v. Oxnard*, 75 F. 703, 730-31 (C.C. Mass. 1896) (similar). There is some tension between this rule, however, and some recent case law apparently holding that merely making copies available in such places implicates the distribution right. *See infra* note 189. Similarly, although some courts held that deposit of a work with the Copyright Office or the Library of Congress could be an investive publication, *see, e.g., Cardinal Film Corp. v. Beck*, 248 F. 368, 368 (S.D.N.Y. 1918), most held that it would not constitute a divestive publication, *see, e.g., Patterson v. Century Prods., Inc.*, 93 F.2d 489, 490-91 (2d Cir. 1937). And although many courts have come around to the view that merely depositing architectural plans with a public agency is not a publication, *see, e.g., John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.*, 322 F.3d 26, 37 (1st Cir. 2003), there is a substantial minority view, *see, e.g., DeSilva Constr. Co. v. Herrald*, 213 F. Supp. 184, 194 (M.D. Fla. 1962). A few courts also have held or suggested that the construction or public exhibition of a building constitutes publication of the underlying plans, *see, e.g., Read v. Turner*, 48 Cal. Rptr. 919, 924 (Ct. App. 1966), but others appear to have rejected this rule as well. *See Donald Frederick Evans & Assocs., Inc., Continental Homes, Inc.*, 785 F.2d 897, 901 n.7 (11th Cir. 1986); *Nucor Corp. v. Tenn. Forging Steel Serv.*, 476 F.2d 386, 390-91 (8th Cir. 1973). *See generally* 1 NIMMER & NIMMER, *supra* note 44, §§ 4.10, 4.12[C]; Arthur S. Katz, *Copyright Protection of Architectural Plans, Drawings, and Designs*, 19 L. & CONTEMP. PROBS. 224, 232-37 (1954).

¹¹⁷ *See* 1 NIMMER & NIMMER, *supra* note 44, § 4.03, at 4-19 to -20; *id.* § 4.07[A], at 4-43; Kaplan, *supra* note 112, at 470.

¹¹⁸ *See* *Blanc v. Lantz*, 83 U.S.P.Q. 137, 139-40 (Cal. Super. 1949); 1 NIMMER & NIMMER, *supra* note 44, § 4.08[B], at 4-48; Selvin, *supra* note 113, at 40-41.

performance with publication would have injected into the public domain works that were publicly performed without having first been fixed in any tangible medium of expression. There would have been no tangible copy upon which to affix copyright notice, and publication (by performance) without copyright notice would have resulted in forfeiture of common-law copyright.¹¹⁹ Alternatively, for works that were fixed in a tangible medium of expression but not distributed to the public in tangible copies, prior to their public performance or display, a rule that performance or display resulted in forfeiture of common-law copyright would have required authors to obtain statutory copyright protection by depositing a copy of the work with the U.S. Copyright Office, prior to the public performance or display.¹²⁰ Compliance with this requirement would not have been impossible, perhaps, but for many works, particularly works that were subject to revision up until the moment before their first performance, it might have seemed quite burdensome.¹²¹ Another rationale, applicable to unique works of art on

¹¹⁹ Fixation as such was not, technically, a requirement for federal copyright protection until 1978, but publication appears to have implied the existence of at least one tangible copy that could be distributed to the general public. See Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683, 719-21 (2003). Presumably, there couldn't be a federal copyright interest if there was no writing. See U.S. CONST. art. I, § 8, cl. 8. The Nimmer treatise also suggests that, in the case of mere performances, "the author has not lost the physical ability to control the dissemination an enjoyment of his work, and hence, the work has not, in a meaningful sense, been acquired by the public." 1 NIMMER & NIMMER, *supra* note 44, § 4.07[A], at 4-43. That rationale, however, may seem strained as applied to unique works of art that are put on public display; moreover, mere possession of the physical object doesn't necessarily imply the right to do whatever one wishes with that object, although the *Pushman* doctrine, see *infra* notes 207-09 and accompanying text, tended in this direction.

¹²⁰ See 1909 Act, § 12. Prior to 1909, however, even this protection was not available for unpublished works. See Kaplan, *supra* note 112, at 476-77; Selvin, *supra* note 113, at 44. Going back even farther, it was unclear until the mid-nineteenth century that even federal statutory copyright conferred upon playwrights and composers the right to enjoin the unauthorized public performance, as opposed to merely the reproduction, of their works. See Kaplan, *supra* note 112, at 474-76; Selvin, *supra* note 113, at 44. For these reasons, Selvin argued that courts should not have read *Ferris v. Frohman*, decided under the 1870 Act, as standing for the proposition that, after 1909, performance cannot effect a publication. See Selvin, *supra* note 113, at 44.

¹²¹ See 1 NIMMER & NIMMER, *supra* note 44, § 4.08[B], at 4-49; Kaplan, *supra* note 112, at 478-79.

public display, would be that requiring the author to include copyright notice on such works might have compromised their integrity.¹²² It also might have been burdensome for authors to comply with the deposit requirement in this context as well, at least until photography and other reproduction methods became more widely available, although one way around this hardship would have been simply to exempt such “published” copies from the deposit requirement.¹²³ Yet another possible rationale for not equating performances and displays with publication is administrative convenience: determining whether tangible copies of a work have been made available to the general public might seem easier than determining whether the work had merely been publicly performed or displayed.¹²⁴ To be sure, both questions may involve fine distinctions concerning whether the work has been made sufficiently accessible to the general public; at least in the former case, however, there are (or at least were, at one time) tangible copies of the work from which to base a conclusion.¹²⁵ One might argue, however, that none of these

¹²² See *Scherr v. Universal Match Corp.*, 417 F.2d 497, 503 (2d Cir. 1969) (Friendly, J., dissenting):

Under [17 U.S.C. 12], if the article sought to be copyrighted is a work of art, all that needs to be done at the outset to secure copyright is to supply a photograph, which [plaintiffs] did. The deposit of copies is required only where the work is later reproduced in copies for sale, and it is the copies that must bear the copyright notice. Hence, so long as [plaintiffs] did not publish the statue or authorize the publication of copies of it, they were under no obligation to affix the notice at all. Such a position is essential if artists are to be spared the dilemma of either defacing the work of art with a plainly visible notice or losing copyright protection.

Current Copyright Office regulations permit authors to include copyright notice on the back or on a frame of a pictorial work. See 37 C.F.R. § 201.20(i).

¹²³ See 37 C.F.R. §§ 202.19(c)(5), 202.20(c)(5) (exempting three-dimensional sculptural works from the deposit requirement); *id.* §§ 202.19 (d)(iv), 202.20(d)(iv) (permitting deposit of photographs of pictorial or graphic works existing in limited numbers).

¹²⁴ See Kaplan, *supra* note 112, at 479 n.49 (citing John Schulman, *Author's Rights*, in 7 COPYRIGHT PROBLEMS ANALYZED 19, 23-25 (1952)).

¹²⁵ Of course, the rule could be underinclusive, because there was not (and still is not) any rule that those copies survive to the date of litigation. See Lichtman, *supra* note 119, at 732-34. Moreover, public display of unique works of art, unlike public performance, necessarily implies the existence of at least one tangible

rationales should carry much weight now that copyright subsists in all original works of authorship from the moment of their creation.¹²⁶ If the law were to change, however, such that performances and displays henceforth did count as publications, one would need to be sure that the other consequences that now follow from the fact of publication are such that could or should be conditioned upon performance or display instead.

Notwithstanding the courts' general acceptance of the rule that performances and displays did not equate to publication, the application of that rule to situations in which the author might be deemed to have authorized or acquiesced in the audience's copying of the work has troubled courts for over a century. In a few cases decided under the 1909 Act, courts appeared to suggest that such performances or displays did indeed constitute publications. In *American Tobacco Co. v. Werckmeister*,¹²⁷ for example, the Supreme Court (in a bit of extended dicta) cited with approval a section of a copyright treatise stating that a public exhibition of a work of art does not constitute publication "where there are bylaws against copies, or where it is tacitly understood that no copying shall take place, and the public are admitted to view the painting on the implied understanding that no improper advantage will be taken of the privilege."¹²⁸ The negative implication appears to be that exhibition without such express or implicit restrictions on copying could, in an appropriate case, constitute publication; not surprisingly, some courts have

copy. On the other hand, patent law has long permitted public knowledge or use of an invention to "count" as prior art, without the invention having been described in a printed publication, although some form of written corroboration of public knowledge or use usually must be produced as well. See e.g., *Washburn & Moen Mfg. Co. v. Beat 'em all Barbed Wire Co.*, 143 U.S. 275, 284-85 (1892) (The Barbed Wire Patent); *Minnesota Min. & Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1301 (Fed. Cir. 2002); *Woodland Trust v. Flouertree Nursery, Inc.*, 148 F.3d 1368, 1370 (Fed.Cir.1998).

¹²⁶ See 1 NIMMER & NIMMER, *supra* note 44, § 4.08[B], at 4-49 to -50.

¹²⁷ 207 U.S. 284 (1907).

¹²⁸ *Id.* at 300 (citing J. HERBERT SLATER, THE LAW RELATING COPYRIGHT AND TRADE MARKS 92 (1884)).

interpreted *American Tobacco* in precisely this way. Thus, in *Letter Edged in Black Press, Inc. v. Public Building Commission of Chicago*,¹²⁹ the plaintiff sought a declaratory judgment that the defendant, the assignee of Pablo Picasso’s copyright in the monumental sculpture that now stands in front of the Daley Center in Chicago, Illinois, had forfeited the copyright in that work by permitting its general publication without copyright notice.¹³⁰ In particular, the plaintiff argued that the defendant, in order to publicize the work, had permitted the Art Institute of Chicago (among others) to display a maquette (model) of the sculpture—the monumental version of which had yet to be constructed--without any restriction on its being copied.¹³¹ In addition, the defendant itself had distributed 96 copies of a commemorative booklet that included photographs of the maquette, and had issued a policy statement that “no individuals shall be restricted from ‘full personal enjoyment of the sculpture, including the right to take photographs and make paintings, etchings and models of the same for personal, non-commercial purposes.’”¹³² Citing *American Tobacco*, the court concluded that the display of the maquette without copyright notice constituted a general publication,¹³³ noting that “the Commission passively and in some cases actively engaged in the distribution of uncopyrighted pictures promoting the Chicago Picasso.”¹³⁴ Given its specific facts,

¹²⁹ 320 F. Supp. 1303 (N.D. Ill. 1970).

¹³⁰ *See id.* at 1305.

¹³¹ *See id.* at 1305-06.

¹³² *Id.* at 1306-07.

¹³³ *See id.* at 1311.

¹³⁴ *Id.* at 1313. *See also* *Burke v. Nat’l Broad. Co.*, 598 F.2d 688, 691 (1st Cir. 1979) (“Publication may be found if the circumstances suggest that the public was free to copy a work on exhibit, but a prohibition against copying can be ‘tacitly understood’ or implied”); *Patterson v. Century Productions*, 93 F.2d 489, 492 (2d Cir. 1937); *Carns v. Keefe Bros.*, 242 F. 745, 746 (D. Mont. 1917).

Letter Edged in Black Press can be (and sometimes has been) interpreted as standing for the proposition that display coupled with an absence of restrictions on copying constitutes a general publication, though others (including the Nimmer treatise) argue that it should be read merely as standing for the narrow proposition that the defendant's own distribution of copies, and authorization of such distribution, constitutes a general publication.¹³⁵

A more recent case illustrating similar issues is *Estate of King v. CBS, Inc.*¹³⁶ The case involved the Dr. King's famous "I Have a Dream" speech, which he delivered in Washington, D.C. on August 28, 1963.¹³⁷ In 1994, CBS produced a documentary, titled "Martin Luther King, Jr. and the March on Washington," which included CBS television footage of about 60% of the content of the speech.¹³⁸ Dr. King's estate filed suit for copyright infringement.¹³⁹ CBS moved for summary judgment on the ground that the speech had fallen into the public domain by virtue of Dr. King's having released it for publication without the requisite copyright notice.¹⁴⁰ The district court granted the defendant's motion, reasoning that while "merely showing the general public a work through a public performance or exhibition is not necessarily a general publication, such

¹³⁵ See 1 NIMMER & NIMMER, *supra* note 44, § 4.09, at 4-52 n.7.

¹³⁶ 194 F.3d 1211 (11th Cir. 1999).

¹³⁷ See *id.* at 1213.

¹³⁸ See *id.*

¹³⁹ See *id.*

¹⁴⁰ See *id.* CBS also moved for summary judgment on First Amendment, fair use, and implied license grounds, but the district court did not reach these issues. See *Estate of King*, 194 F.3d at 1220 n.1 (Cook, J., concurring in part and dissenting in part); *Estate of King*, 13 F. Supp. 2d 1347, 1349 (N.D. Ga. 1998), *rev'd*, 194 F.3d 1211 (11th Cir. 1999).

action is treated as a general publication if it is shown to the public under such conditions that it evinces a ‘dedication without reservation of rights’ rather than just the right to view or inspect.”¹⁴¹ The march organizers’ knowledge of and encouragement of press coverage, their “studied effort . . . to secure as wide dissemination . . . as possible,” and their failure to give express (or even implicit) “limitations regarding who could film the event or the extent to which their footage could be used,” in the opinion of the district court, “almost epitomizes the definition of a general publication: it was made available to members of the public at large without regard to who they were or what they proposed to do with it.”¹⁴² In reaching this conclusion, the court expressed disagreement an earlier district court decision which had reached the opposite result on the question of the speech’s general publication.¹⁴³

The Eleventh Circuit reversed, with one judge dissenting and adopting the district judge’s rationale.¹⁴⁴ Each of the two judges in the majority wrote separately, however, to

¹⁴¹ *Estate of King*, 13 F. Supp. 2d at 1352 (quoting *Silverman v. CBS, Inc.*, 632 F. Supp. 1344, 1353 (S.D.N.Y. 1986)).

¹⁴² *Id.* at 1352-53; *see also id.* at 1354 (stating that “while performance itself may not be sufficient to constitute publication, performance coupled with such wide and unlimited reproduction and dissemination as occurred concomitant to Dr. King’s speech during the March on Washington can be seen only as a general publication which thrust the speech into the public domain”). CBS also cited evidence that (1) Dr. King had made copies of the speech available to the press on the morning of August 5, 1963, in advance of its public performance; and (2) the Southern Christian Leadership Conference (SCLC) had published the speech, in its entirety, in its September 1963 newsletter. *See id.* at 1353 n.5. The district court disregarded this evidence, however, noting that there was a genuine issue of material fact whether the speech King actually delivered was reflected in the advance copies (the King Estate having argued that much of the speech delivered was extemporaneous), and whether the publication by the SCLC was authorized by Dr. King himself. *See id.*

¹⁴³ *See King v. Mister Maestro, Inc.*, 224 F. Supp. 101 (S.D.N.Y. 1963). In *Mister Maestro*, the defendants were selling phonograph recordings of King’s August 1963 public performance of the “I Have a Dream” speech. King applied registered his claim to copyright and filed suit. The district court concluded that the speech had not been the subject of a general publication, reasoning that King’s delivery of an advance text of the speech was given to the press only. *See id.* at 107. The Estate of King filed its claim to the renewal term in 1991. *See Estate of King*, 194 F.3d at 1214 n.2.

¹⁴⁴ *See Estate of King*, 194 F.3d at 1227 (Roney, J., dissenting).

explain why he did not believe that the undisputed facts established that King had effected a general publication. In the lead opinion, Chief Judge Anderson wrote that, although “performance of a work is not a general publication,”¹⁴⁵ a general publication would result “if tangible copies of the work are distributed to the general public in such a manner as allows the public to exercise dominion and control over the work”¹⁴⁶ or “if the work is exhibited or displayed in such a manner as to permit unrestricted copying by the general public.”¹⁴⁷ Chief Judge Anderson concluded that a genuine issue of material fact existed as to whether either condition was satisfied. As for the first condition, Chief Judge Anderson reasoned that “distribution to the news media, as opposed to the general public, for the purpose of enabling the reporting of a contemporary newsworthy event, is only a limited publication,” lest otherwise an author be forced “to choose between obtaining news coverage for his work and preserving his common-law copyright.”¹⁴⁸ As for the second, he concluded that a genuine issue of fact remained on the issue of whether King had authorized the general public to copy his speech.¹⁴⁹ Senior District Judge Cook, sitting by designation, concurred in this result, but on the ground that performance never amounts to publication, unless the author has made tangible copies available to the general public.¹⁵⁰

¹⁴⁵ *Id.* at 1215.

¹⁴⁶ *Id.*

¹⁴⁷ *Id.*

¹⁴⁸ *Id.* at 1216.

¹⁴⁹ *See id.* at 1218-20.

¹⁵⁰ *See id.* at 1220-26 (Cook, J., concurring in part and dissenting in part). Compare the outcome of this case with *Public Affairs Assocs., Inc. v. Rickover*, 284 F.2d 262, 270 (D.C. Cir. 1960), in which the court (by a 2-1 majority) held that Admiral Rickover’s distribution “not only to the press but also to people

In order to avoid the harsh result of publication without notice resulting in forfeiture of copyright, courts also have long distinguished between “general” publications, which resulted in termination of common-law copyright, and “limited” publications, which did not. In what is probably the most frequently cited case on point, *White v. Kimmel*,¹⁵¹ the Ninth Circuit defined a “limited publication” as one “which communicates the contents of a manuscript to a definitely selected group and for a limited purpose, and without the right of diffusion, reproduction, distribution or sale.”¹⁵² Other courts have cited this definition with approval ever since,¹⁵³ and some applications of it are fairly uncontroversial. By most accounts, making copies available merely for review or for criticism, or performance, is not a general publication.¹⁵⁴ Similarly, delivering copies to a publisher for consideration is not a publication--at least not until the right to publish, if any, is exercised.¹⁵⁵ On the other hand, placing copies in the hands

generally who desired copies through interest in the subject of the addresses” constituted a general publication. *See infra* notes 169-70 and accompanying text; *see also* 1 NIMMER & NIMMER, *supra* note 44, § 4.14[A][3], at 4-74.4 (criticizing the *Estate of King* result on the ground that “distribution preparatory to ultimate distribution to the public constitutes general publication”); William Patry, *Martin Luther King, Jr.*, THE PATRY COPYRIGHT BLOG (Jan. 17, 2006), available at <http://williampatry.blogspot.com/2007/01/i-have-dream.html>.

¹⁵¹ 193 F.2d 744 (9th Cir. 1952).

¹⁵² *See id.* at 746-47. This definition of “limited publication” is actually first set forth in the district court opinion, authored by Judge Leon Yankwich. *See White v. Kimmel*, 94 F. Supp. 502, 505 (S.D. Cal. 1950), *rev’d*, 193 F.2d 744 (9th Cir. 1952). Judge Yankwich derived the definition from U.S. and U.K. case law dating back over a century. *See White*, 94 F. Supp. at 505 n.7; Yankwich, *supra* note 11, at 333-36.

¹⁵³ *See, e.g.*, *John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.*, 322 F.2d 26, 36 (1st Cir. 2003); *Brown v. Tabb*, 714 F.2d 1088, 1091 (11th Cir. 1983); *Continental Cas. Co. v. Beardsley*, 253 F.2d 702, 706-07 (2d Cir. 1958); *William A. Graham Co. v. Haughey*, 430 F. Supp. 2d 458, 470 (E.D. Pa. 2006); *Milton H. Greene Archives, Inc. v. BPI Comm’ns, Inc.*, 378 F. Supp. 2d 1189, 1198 (C.D. Cal. 2005); *Penguin Books U.S.A., Inc. v. New Christian Church of Full Endeavor, Ltd.*, 288 F. Supp. 2d 544, 555 (S.D.N.Y. 2003). *See also Data Cash Sys. v. JS & A Group, Inc.*, 628 F.2d 1038, 1043 (7th Cir. 1980) (“[a] limited publication is really in the eyes of the law no publication at all”).

¹⁵⁴ *See Kramer v. Newman*, 749 F. Supp. 542, 550 (S.D.N.Y. 1990); 1 NIMMER & NIMMER, *supra* note 44, § 4.13[A][3], at 4-74.3.

of a retailer is a publication, even before the copies hit the stores;¹⁵⁶ so is distributing copies to a select group the author deems worthy, if the other criteria of general publication are met.¹⁵⁷

Nevertheless, as one court recently noted, cases applying the *White v. Kimmell* definition of limited publication “are not totally consistent.”¹⁵⁸ The *White* case itself involved a manuscript, referred to as “Gaelic,” which purportedly consisted of communications transmitted from an otherworldly spirit to author Stewart Edward White, through the intermediation of Mrs. White.¹⁵⁹ Stewart White authorized the making of up to 200 mimeographed copies of the Gaelic manuscript, many of which he mailed out to persons whom he thought would be interested, or who had expressed an interest, in the

¹⁵⁵ See *Schatt v. Curtis Mgt. Group, Inc.*, 764 F. Supp. 902, 908 (S.D.N.Y. 1991) (quoting with approval 1 NIMMER & NIMMER, *supra* note 44, § 4.04, that “If an author grants to another the right to publish his work, the grant does not in and of itself constitute a publication unless and until the grantee exercises that right. Furthermore, publication does not result from mere delivery of the manuscript of a work to a publisher, even if delivery is made for the purpose of having the work printed so that it may become available to the public”); *Wright v. Warner Books, Inc.*, 748 F. Supp. 105, 110 (S.D.N.Y. 1990), *aff’d*, 953 F.2d 731 (2d Cir. 1991).

¹⁵⁶ See *Data Cash Sys., Inc. v. JS & A Group Inc.*, 628 F.2d 1038, 1043 (7th Cir. 1980) (stating that, in *Advisers, Inc. v. Wiesen-Hart, Inc.*, 238 F.2d 706 (6th Cir. 1956), “the date of publication was the date of distribution of a book to retailers, not four months later when the retailers actually distributed the books to the public”); *Nucor Corp. v. Tennessee Forging Steel Serv., Inc.*, 476 F.2d 386, 390-91 (8th Cir. 1973) (stating that “a distribution of plans to potential contractors and subcontractors for bidding purposes does not constitute general publication”); *Hirshon v. United Artists Corp.*, 243 F.2d 640, 645 (D.C. Cir. 1957); *Falk v. Gast Lithograph & Engraving Co.*, 54 F. 890, 893 (2d Cir. 1893).

¹⁵⁷ See *William A. Graham Co. v. Haughey*, 430 F. Supp. 2d 458, 470 (E.D. Pa. 2006) (citing *Penguin Books U.S.A., Inc. v. New Christian Church of Full Endeavor, Ltd.*, 288 F. Supp. 2s 544, 555 (S.D.N.Y. 2003), and *Schatt v. Curtis Mgt Group, Inc.*, 764 F. Supp. 902, 911 & n.12 (S.D.N.Y. 1991)). See also *Schatt v. Curtis Mgt. Group, Inc.*, 764 F. Supp. 902, 911 n.12 (S.D.N.Y. 1991) (rejecting argument that copies “must have been made available to all comers and not only to a class in order for the dissemination of the photographs to have been a general publication”; distribution constitutes a general publication “to the extent the recipients [are] permitted to pass the manuscript on to selected others”).

¹⁵⁸ *William A. Graham Co. v. Haughey*, 430 F. Supp. 2d 458, 470 (E.D. Pa. 2006).

¹⁵⁹ See *White*, 193 F.2d at 745.

work.¹⁶⁰ According to the court, White did not limit the recipients from passing the work on to others, even encouraging them to do so, and he expressly permitted at least one recipient to make additional copies.¹⁶¹ On these facts, the Ninth Circuit concluded that the work had been generally published, despite its relatively small circulation.¹⁶² More recently, in *Penguin Books U.S.A., Inc. v. New Christian Church of Full Endeavor, Ltd.*,¹⁶³ the court held that the circulation of (yet another) work purportedly transmitted by a spiritual being had been generally published, on facts similar to *White*.¹⁶⁴ Similarly, in *Brown v. Tabb*,¹⁶⁵ the court held that the plaintiff had made a general publication of an advertising jingle, when he delivered a tape of the jingle to three clients without express agreement concerning its use.¹⁶⁶ The court concluded that, even if the work was subject to an implicit restriction on its reproduction or distribution, it did not satisfy the other two elements of limited publication, insofar as it was not made for a limited purpose or to a limited group.¹⁶⁷ In *Public Affairs Assocs. v. Rickover*,¹⁶⁸ the court found that Admiral Rickover had effected a general publication of his speeches, by making copies available

¹⁶⁰ See *id.* at 745-48.

¹⁶¹ See *id.* at 745-46.

¹⁶² See *id.* at 745-48.

¹⁶³ 288 F. Supp. 2d 544 (S.D.N.Y. 2003).

¹⁶⁴ See *id.* at 554-58.

¹⁶⁵ 714 F.2d 1088 (11th Cir. 1983).

¹⁶⁶ See *id.* at 1091-92.

¹⁶⁷ See *id.* (stating that the “limited purpose” element was not met, because each recipient “was completely free to use the jingle for his own commercial benefit, and to broadcast the work as broadly as he wished,” and that the “limited group” element was not met because the evidence showed “that the jingle was available to any automotive dealer doing business in a market not yet exposed to the jingle who would pay the price”).

¹⁶⁸ 284 F.2d 262 (D.C. Cir. 1960).

to anyone who requested them,¹⁶⁹ and in *Continental Casualty Co. v. Beardsley*,¹⁷⁰ the court reached the same conclusion with respect to the plaintiff's insurance forms.¹⁷¹

Other cases take a much narrower view of general publication. In *Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc.*,¹⁷² for example, the Ninth Circuit concluded that the distribution of Oscar statuettes from 1929 to 1941 (before copyright notice was included on the statuettes) constituted a limited publication, despite the fact that 158 of the statuettes had been awarded during that time without any express restriction on the recipients' use or disposal of the statuettes.¹⁷³ The court concluded that the recipients were a select group; the award was given for a limited purpose of advancing the motion pictures arts and sciences; and that the recipients

¹⁶⁹ *See id.* at 270-71.

¹⁷⁰ 253 F.2d 702 (2d Cir. 1958).

¹⁷¹ *See id.* at 706 (concluding that plaintiff had effected a general distribution, by distributing forms to prospective customers, absent proof that recipients were bound by a condition that the forms not be shown to others, and given that any interested person could have obtained a copy). *See also* *Lish v. Harper's Magazine Found.*, 807 F. Supp. 1090, 1102 (S.D.N.Y. 1993). In *Lish*, the court held that, for purposes of fair use analysis, an author's letter to students in his writing seminar was confidential and therefore unpublished. The court noted that, under the 1976 Act, "publication" means, *inter alia*, "distribution . . . to the public," and it cited the legislative history of the 1976 Copyright Act as defining "the public" as "persons 'under no explicit or implicit restrictions with respect to disclosure of its contents.'" *See id.* at 1101-02 (citing H.R. Rep. No. 94-1476, 94th Cong., 2d Sess 138 (1976), 1976 USCCAN 5659, 5754). It concluded that publication therefore "turns on the question whether there were 'implicit restrictions' on further distribution or disclosure of the document's contents," and that in the case at hand there were such restrictions. *See id.* at 1102. First, the tone of the letter stressed confidentiality within the class. *See id.* Second, the court cited other decisions in which journal entries and architectural plans had been held unpublished, despite having been publicly accessible. *See id.* Third, the court stated that the distribution of the letter had been "restricted both by purpose and number," to students enrolled in the authors' class. *See id.* Another court, however, criticized this decision, holding that sale of software and a manual that was not limited to a select group was a general publication, despite confidentiality restrictions.

¹⁷² 944 F.2d 1446 (9th Cir. 1991).

¹⁷³ *See id.* at 1449. In 1941, the Academy obtained a federal copyright registration for the statuette as an unpublished work. It also began expressly requiring recipients to provide the Academy a right of first refusal before any sale of an Oscar. *See id.*

labored under an implied restriction on further distribution.¹⁷⁴ In support of this last proposition, the court cited with approval *Hirshon v. United Artists Corp.*,¹⁷⁵ a case in which the D.C. Circuit had held that the distribution of copies of a song to 2,000 radio stations for promotional purposes was a limited publication, despite a similar lack of any express restriction on distribution or copying.¹⁷⁶ In both cases, the court made much of the fact that there was no evidence of any recipient actually selling or copying the work.¹⁷⁷ Similarly, in *Brewer v. Hustler Magazine, Inc.*,¹⁷⁸ the court (again the Ninth Circuit) held that the work at issue—a photograph simulating, through the use of special effects, the photographer shooting himself through the head—had not been generally published, despite the fact that the plaintiff had distributed approximately 200 business cards bearing a small reproduction of the photograph to persons in the advertising industry, reasoning that the recipients were a “select group” and the purpose the “very

¹⁷⁴ See *id.* at 1452-54. As for limited purpose, the court rejected the argument that the Academy promoted the Oscar for its own commercial benefit,” despite the fact that “the film industry may benefit incidentally from the Oscar’s promotion.” *Id.* at 1453.

¹⁷⁵ 243 F.2d 640 (D.C. Cir. 1957).

¹⁷⁶ See *id.* at 645. The Second Circuit in *Continental Casualty Corp.* distinguished *Hirshon* on the ground that its significance, like *American Visuals Corp. v. Holland*, 239 F.2d 740 (2d Cir. 1946), lay “in the recognition that publication may more readily be found if the issue is whether the copyright statute has been complied with than if forfeiture of common law rights is involved.” See *Continental Cas. Corp.*, 284 F.2d at 702. But while *Hirshon* does cite *American Visuals* with approval for this proposition, the issue in *Hirshon*, which the court answered in the negative, was whether the plaintiff had made a divestive publication. On the other hand, other courts have agreed that merely making copies available as samples or in catalogues or ads is not a publication. See *Hub Floral Corp. v. Royal Brass Corp.*, 454 F.2d 1226, 1229 (2d Cir. 1972) (“It has long been settled that the taking of orders through employment, samples, catalogs, or advertisements of a work does not amount to publication of the work”) (citations omitted); *Dowdey v. Phoenix Films, Inc.*, 199 U.S.P.Q. 579, 584 (S.D.N.Y. July 24, 1978). Cf. *Rexnord, Inc. v. Modern Handling Sys., Inc.*, 379 F. Supp. 1190, 1197 (D. Del. 1974).

¹⁷⁷ See *Academy*, 944 F.2d at 1453-43; *Hirshon*, 243 F.2d at 645. In *Academy*, the only known sale of as Oscar occurred pursuant to an estate sale. See *Academy*, 944 F.2d at 1449.

¹⁷⁸ 749 F.2d 527 (9th Cir. 1984).

narrow” one of obtaining employment.¹⁷⁹ The court made no mention of whether the recipients were under an obligation to refrain from copying or distributing the work, however,¹⁸⁰ and in *Academy* the court interpreted the case as standing for the proposition that a limited publication can exist “even though the recipients are free to further distribute the cards.”¹⁸¹ And in *Burke v. National Broadcasting Co.*,¹⁸² the court concluded that the plaintiff had not made a general publication of his video, despite the fact that he lent it to a German professor for broadcast on German television without any express conditions imposed on its reproduction or use.¹⁸³ There is obviously more than a little result-orientation going on here.

One additional area of controversy that has only recently come to the fore involves the question of whether materials transmitted over the Internet are thereby, necessarily, published. Suppose, for example, that I upload materials onto my website; that anyone with an Internet connection, anywhere in the world, can access the site; and that at least one person, somewhere, does so. The U.S. Copyright Act is fairly clear on a number of issues relating to these facts. First, I have “transmitted” the subject work.¹⁸⁴ Second, as long as some member of the general public, somewhere, accesses the work, I

¹⁷⁹ *See id.* at 528-29.

¹⁸⁰ The court did mention that “the reduced size of the photograph, its reproduction on a business card, and its limited distribution also support the jury’s verdict” of no general publication. *Id.* at 529.

¹⁸¹ *See Academy*, 944 F.2d at 1454.

¹⁸² 598 F.2d 688 (1st Cir. 1979).

¹⁸³ *See id.* at 693.

¹⁸⁴ *See* 17 U.S.C. § 101 (defining “transmit” as “to communicate . . . by any device or process whereby images or sounds are received beyond the place from which they are sent”).

have caused a public performance or display of it.¹⁸⁵ As we have seen, however, under current U.S. law neither performance nor display alone constitutes publication. Third, the person who accesses the material automatically makes a temporary copy of it in the RAM of her computer, and according to some authorities this copying constitutes a reproduction¹⁸⁶ (albeit, in the present context, one that is authorized by the copyright owner). Fourth, as we have seen, the Copyright Act does not define the term “distribution,” but it does confer upon the copyright owner the right to distribute, and the right to authorize the distribution of, “copies or phonorecords of the work to the public by sale or other transfer of ownership, or by rental, lease, or lending.”¹⁸⁷ Moreover, “publication” is defined, as above, as “the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending,” as well as the “offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display.”¹⁸⁸ Thus, by making the work available over the Internet, have I distributed (or at least offered to distribute) tangible (RAM) copies to the general public, by transferring ownership of a tangible (RAM) copy? Have I offered to distribute RAM copies for purposes of public display? Or perhaps this analysis is more technical than necessary. The website might be thought of as the functional equivalent of a book checked out of the library. Indeed, there is some authority for the proposition that a book that is merely made available *at* a library

¹⁸⁵ See *id.* (definitions of “display,” “perform,” and “publicly”).

¹⁸⁶ See *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 518 (9th Cir. 1993); *Marobie-FI, Inc. v. Nat’l Ass’n of Fire & Equip. Distribs.*, 983 F.Supp. 1167, 1177-78 (N.D.Ill. 1997).

¹⁸⁷ 17 U.S.C. § 106(3).

¹⁸⁸ *Id.* § 101.

for temporary perusal is distributed to the public.¹⁸⁹ Changing the facts may result in the transmission appearing more or less like a publication. Suppose first that my website authorizes users to make copies (other than the RAM copies which are made as a matter of course) of the material found on the site. This might seem more like a conventional publication, because the end result is the (at least offered) release of tangible copies to the general public.¹⁹⁰ Second, suppose that my website expressly forbids the user from making copies, other than the RAM copy. If the RAM copy itself does not count as a copy that results in a distribution, then arguably there has been no distribution and no publication either. Third, if the website is streaming content, such as music, such that no

¹⁸⁹ In *Hotaling v. Church of Jesus Christ of Latter-Day Saints*, 118 F.3d 199 (4th Cir. 1997), the court appears to have held that a library's merely making an infringing work available to the public for on-site inspection constituted an unauthorized distribution, stating:

When a public library adds a work to its collection, lists the work in its index or catalog system, and makes the work available to the borrowing or browsing public, it has completed all the steps necessary for distribution to the public. At that point, members of the public can visit the library and use the work.

Id. at 203. In dissent, Judge Hall noted that, under § 106 of the Copyright Act, the copyright owner has the exclusive right to “distribute copies . . . of the copyrighted work to the public *by sale or other transfer or ownership, or by rental, lease, or lending.*” *Id.* at 205 (Hall, J., dissenting) (quoting 17 U.S.C. § 106(3)). Judge Hall was unwilling to conclude that a library “lend[s] a work each time a patron consults it,” and noted in addition that there was no evidence that anyone had even “used or looked at an infringing copy during the limitations period.” *Id.* See also *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 820 (9th Cir. 2003) (equating works appearing on the Internet with published works, for purposes of fair use analysis); *A & M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1014 (9th Cir. 2001) (holding that Napster users who uploaded file names to a search index to enable others to download the works contained in those files violated copyright owners’ distribution rights); *Arista Records LLC v. Greubel*, 453 F. Supp. 2d 961, 967-72 (N.D. Tex. 2006). Other cases, however, arguably take a narrower view. See *Perfect 10 v. Google, Inc.*, 487 F.3d 701, 718 (9th Cir. 2007) (holding that in-linking does not constitute distribution); *In re Napster, Inc. Copyright Litig.*, 377 F. Supp. 2d 796, 802-05 (N.D. Cal. 2005) (holding that Napster itself did not distribute copyrighted works merely by listing those works in an index of files available for peer-to-peer downloading); *Nat’l Conf. of Bar Examiners v. Multistate Legal Studs., Inc.*, 495 F. Supp. 34, 37 (N.D. Ill. 1980).

¹⁹⁰ See Chang, *supra* note 100, at 238.

copy is automatically made in RAM, the question would appear to turn on whether users are authorized to make copies of the streamed content.¹⁹¹

The only reported decision thus far addressing this fact pattern is *Getaped.com, Inc. v. Cangemi*.¹⁹² In *Getaped*, the plaintiff had registered its copyright after the alleged infringement began but within three months of having first made the copyrighted material available to the public on its website. The issue therefore was whether the defendant had infringed an unpublished work, in which case no statutory damages and attorneys' fees would be available for any infringement commenced before the date of registration, or of a published work, in which case the registration within three months of first publication would entitle the plaintiff to statutory damages and fees even for acts committed prior to registration. The district court concluded that the Internet transmission did constitute a publication, citing several cases holding that a defendant's unauthorized transmission of copyrighted works over the Internet constitutes a violation of the copyright owner's exclusive right to distribute tangible copies.¹⁹³ The court concluded that transmission is not merely a performance or display of a work, because

the user not only views the page but can also view—and copy—the code used to create it. In other words, merely by accessing a webpage, an Internet user acquired the ability to make a copy of that webpage Consequently, when a website goes live, the creator loses the ability to control either duplication or further distribution of his or her work. . . . Thus, when a webpage goes live on the Internet, it is distributed and “published” in the same way the music files in *Napster* or the photographs in the various *Playboy* decisions were distributed and published. . . . Under this analysis, *Getaped* did “publish” its website (and,

¹⁹¹ See *United States v. Am. Soc’y of Composers, Authors & Publishers*, 485 F. Supp. 2d 438, 433-34 (S.D.N.Y. 2007) (holding that, while streaming constitutes a public performance, downloading constitutes a reproduction, of a musical work); Chang, *supra* note 100, at 239.

¹⁹² 188 F. Supp. 2d 398 (S.D.N.Y. 2002).

¹⁹³ See *id.* at 401.

necessarily, the underlying source code) on July 15, 2000, when its modified website first became accessible on the Internet.¹⁹⁴

The *Getaped* decision has elicited different opinions. On the one hand, David Nimmer applauds the decision, reasoning that making the work available over the Internet is the functional equivalent of a lending.¹⁹⁵ On the other, Roger Schechter and Jay Thomas, as well as student commentator RayMing Chang, have argued that transmissions are not distributions but performances, and that websites that do not permit copying (other than, again, the RAM copying that is a necessary incident to viewing) do not result in any *authorized* tangible copies being made.¹⁹⁶ Thus far, the Copyright Office has not taken an official position on the matter.¹⁹⁷

IV. Redefining Publication

The preceding discussion of the case law on publication shows that, even after Congress codified a definition of the term in 1976, many interpretive puzzles remain. The cases themselves suggest that the meaning of the term is often unpredictable, and that outcomes may be driven more by the desire to achieve certain results than by conformity with settled principles. None of this would matter much if publication were

¹⁹⁴ *Id.* at 402.

¹⁹⁵ See 1 NIMMER & NIMMER, *supra* note 44, § 4.07[B].

¹⁹⁶ See ROGER E. SCHECHTER & JOHN R. THOMAS, INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS 81 (2003) (“It is clear . . . that under the statutory language now in effect there has been no distribution of copies or phonorecords . . . to the public and hence no publication when a work is disseminated electronically”); Chang, *supra* note 100, at 236 (agreeing with Schechter and Thomas); Bruce P. Keller & Jeffery P. Cunard, *Copyright Law Publication under the 1976 Act*, § 6:1.2 PLI 6-18 n.94 (2006) (stating *Getaped* is difficult to reconcile with the principle that public display of a work is not publication); Gard, *supra* note 17, at 699 (questioning whether a work posted on the Internet with copying protection would be considered published under the *Getaped* rule).

¹⁹⁷ See U.S. COPYRIGHT OFFICE, CIRCULAR 65: COPYRIGHT REGISTRATION FOR AUTOMATED DATABASES 2 (July 2006) (“It is unclear whether online availability for the user constitutes publication of the work under the copyright law”); U.S. COPYRIGHT OFFICE, CIRCULAR 66: COPYRIGHT REGISTRATION FOR ONLINE WORKS 3 (July 2006) [hereinafter ONLINE CIRCULAR] (similar).

merely a relic of a bygone approach to copyright. But the whether, where, and when of publication still has consequences, as discussed above, both with respect to older works and with respect to works being created today. In this Part, I argue that the law relating to publication could be improved in three important respects. First, I will argue that the standard definition of publication, as developed in the pre-1976 case law and as codified in 1976, is misleading; but that one can nevertheless distill certain principles from the case law that would reconcile many of the latent inconsistencies in the standard approach. Second, I will argue that, although transmitting works over the Internet plausibly *can* be viewed as publication, the better view is probably *not* to equate transmission with publication for all purposes. Third, however, I will argue that the best policy may be to define publication differently in different contexts. A broad definition of publication (that includes Internet transmission) may be sensible for such purposes of triggering the statutory damages grace period, whereas a narrower definition may be better for other purposes, such as imposing the duty to deposit and determining country of origin.

A. A General Definition of Publication

As we have seen, the 1976 Act defines publication to mean the “distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease or lending,” as well the “offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display.”¹⁹⁸ This definition is said to largely track the meaning of the term as developed in the pre-1976 case law.¹⁹⁹ Moreover, courts continue to distinguish (general)

¹⁹⁸ 17 U.S.C. § 101.

¹⁹⁹ See *supra* text accompanying notes 108-10.

publications from limited (i.e., non-) publications, even with respect to works created or (allegedly) published after 1976.²⁰⁰ A (general) publication therefore is a distribution that fails to satisfy any one of the three criteria required for a limited publication, namely a distribution (1) to a limited group, (2) for a limited purpose, and (3) “without the right of diffusion, reproduction, distribution or sale.”²⁰¹ This definition of “limited publication,” however—and the definition of “general publication” that is implicit within—leaves much to be desired.

A first problem is that is hardly obvious exactly what a “limited group” or a “limited purpose” means. “All people living in Chicago on December 1, 1998” is a limited group of all people living on earth at that date, of all people who have ever lived, and of all people who ever will live. “All people interested in reading this article” is a limited group (alas, perhaps very limited) of all legal scholars, let alone of people generally. Courts have occasionally acknowledged that what they really mean is something else. Thus, an author who distributes, or offers to distribute, copies of her work to anyone who is willing (or may be willing) to pay the asking price for it has clearly made a general publication, even if the number of such interested persons is very small.²⁰² On the other hand, some courts have held that the distribution of copies to

²⁰⁰ See *Aerospace Servs. Int’l v. LPA Group, Inc.*, 57 F.3d 1002, 1003-04 (11th Cir. 1995) (per curiam); *Logicom Inclusive, Inc. v. W.P. Stewart & Co.*, 72 U.S.P.Q.2d 1632, 1638 (S.D.N.Y. 2004); *Bouchat v. Champion Prods., Inc.*, 327 F. Supp. 2d 537, 549-51 (D. Md. 2003).

²⁰¹ See *White v. Kimmell*, 193 F.2d at 746-47.

²⁰² See *Roy Export Co. v. CBS, Inc.*, 672 F.2d 1095, 1102 n.14 (2d Cir. 1982) (stating that “availability for public sale constitutes publication, even if actual sales are minimal”); *Brown v. Tabb*, 714 F.2d 1088, 1091 (11th Cir. 1983) (distribution of jingles to three broadcasters was not made to a limited group, because the works were available to anyone who wanted them); *William A. Graham Co. v. Haughey*, 430 F. Supp. 2d 458, 470 (E.D. Pa. 2006) (distribution of proposals to “selected clients” was not made to a limited group); *Greene*, 378 F. Supp. 2d at 1198 (distribution of photographs to studios to promote motion pictures was not made to a limited group); *Continental Cas. Co.*, 253 F.2d at 706-07.

members of a given industry, in order to drum up business, is a distribution to a limited group, even though members of the group may number in the hundreds.²⁰³ The term “limited purpose” is similarly vague. Courts sometimes seem to mean that the distribution is made to effect some limited goal, such as (again) stimulating interest in the work or a related work,²⁰⁴ but in other cases the purpose appears to have been much broader. In *Burke*, for example, the author distributed his work for the purpose of allowing it to be broadcast on German television.²⁰⁵ By this logic, however, virtually any distribution coupled with some field-of-use restriction would be for a limited purpose. For that matter, unless the effect of the distribution was to dedicate the work to the public (which is often, circularly, the question the analysis is attempting to answer in the first place), one may assume that the distribution carried with it at least implicit restrictions on what the recipient could do with the work. I have no right to make unrestricted photocopies of books that I buy at the local bookstore, because those works are (for the most part) still protected by copyright. But that hardly means that the author has distributed the work for a limited purpose, because almost all distributions then are for a limited purpose, and the requirement is meaningless.

²⁰³ See, e.g., *Brewer*, 749 F.2d at 528-29 (holding that plaintiff’s distribution, to persons in the advertising industry, of 200 business cards bearing a small reproduction of the subject photograph, was made to a limited group); *Hub Floral Corp. v. Royal Brass Corp.*, 454 F.2d 1226, 1229 (2d Cir. 1972) (“It has long been settled that the taking of orders through employment of samples, catalogs, or advertisements of a work does not amount to publication of the work”); *Hirshon*, 243 F.2d at 645 (holding that distribution of \$2,000 worth of songs to broadcasting stations and professional musicians for “plugging” purposes constituted a limited publication).

²⁰⁴ See, e.g., *Brewer*, 749 F.2d at 528-29 (holding that the distribution of business cards was for the “very narrow purpose [of] obtaining employment”); *Hirshon*, 243 F.2d at 645; *Greene*, 378 F. Supp. 2d at 1199; but see *Haughey*, 430 F. Supp. 2d at 470 (distribution for pecuniary gain not made for a limited purpose); *Continental Cas. Co.*, 253 F.2d at 706-07.

²⁰⁵ See *Burke*, 598 F.2d at 688.

The third criterion, “without the right of diffusion, reproduction, distribution or sale,” is vague for the same reason. Unless the effect of the distribution itself is to thrust the work into the public domain (which it no longer does, in any event), then one would expect most distributions to be “without the right of diffusion [or] reproduction.” That is to say, absent permission from the author, or an applicable exception such as fair use, the recipient has no right to “diffuse” (assuming that diffusion means, more or less, “communicate,” and therefore incorporates such concepts as public performance and transmission)²⁰⁶ or reproduce the copyrighted work. Put another way, most distributions from author to recipient would be “without the right of diffusion [or] reproduction,” unless the author grants such permission, either expressly or implicitly. To be sure, some courts used to follow the so-called *Pushman* doctrine that, when an author made an unconditional transfer of her work she was deemed to have assigned the copyright as well, absent an express reservation of rights.²⁰⁷ As far as I can tell, however, all of the cases in which courts applied this rule involved either paintings, on the one hand, or articles or drawings sold to periodicals, on the other.²⁰⁸ In any event, both state and federal copyright law have long since repudiated the *Pushman* doctrine.²⁰⁹

²⁰⁶ As far as I can tell, neither *White v. Kimmell*, nor any court citing *White v. Kimmell*'s definition of “limited publication,” has ever clarified what exactly the word “diffusion” means in this context. The district court in *White v. Kimmell*, however, quoted extensively from *Keene v. Wheatley*, 14 F. Cas. 180 (E.D. Pa. 1861), a case which appears to use the term “diffusion” more or less as a synonym for “communication.” See *Keene*, 14 F. Cas. at 199; *White*, 94 F. Supp. 502, 505-06 (S.D. Cal. 1950), *rev'd*, 193 F.2d 744 (9th Cir. 1952). The Oxford English Dictionary defines “diffusion” to mean, in this context, “[s]preading abroad, dispersion, dissemination (of abstract things, as knowledge)”. 3 OXFORD ENGLISH DICTIONARY 346 (1933).

²⁰⁷ See *Pushman v. N.Y. Geographic Soc’y*, 39 N.E.2d 249, 251 (N.Y. 1941) ((holding that an absolute and unconditional sale of a work of art transfers the (common-law or statutory) copyright to that work, unless the artist expressly reserves the copyright).

²⁰⁸ See, e.g., *Geisel v. Poynter Prods., Inc.*, 295 F. Supp. 331, 343-44 (S.D.N.Y. 1968) (holding that Dr. Seuss's sale of cartoons to a publisher included the transfer of his common-law copyright therein, and citing other cases involving paintings, drawings, and articles appearing in periodicals); *Grandma Moses*

And yet, one might hasten to note, the definition of “limited publication” that is favored by the courts is disjunctive: it says “without the right of diffusion, reproduction, distribution *or* sale.”²¹⁰ Perhaps, then, an author who distributes copies to a limited group for a limited purpose and without conferring the right to diffuse or reproduce those copies, but *with* permission to distribute or sell them, has made a general publication. The problem with construing the definition in such a literal fashion, however, is that *normally* the “first-sale” or “exhaustion” doctrine entitles the owner of a lawfully made copy to distribute or sell that copy, without obtaining permission from the copyright owner. The Supreme Court first recognized the first-sale doctrine in federal copyright law in *Bobbs-Merrill Co. v. Straus*,²¹¹ based on its interpretation of the 1909 Act; but other courts had recognized the doctrine before²¹² and the 1976 Act expressly codifies

Properties, Inc. v. This Week Magazine, 117 F. Supp. 348, 350 (S.D.N.Y. 1953). *Pushman* itself is ambiguous regarding its reach. On the one hand, the *Pushman* court cited with approval *Parton v. Prang*, 18 F. Cas. 1273 (C.C. Mass. 1872), a case in which the court stated that “if the sale was an absolute and unconditional one, and the article was absolutely and unconditionally delivered to the purchaser, the whole property in the *manuscript or picture* passes to the purchaser, including the right of publication, unless the same is protected by copyright, in which case the rule is different.” *Id.* at 1278 (emphasis added). See *Pushman*, 39 N.E.2d at 250-51. *Parton* itself, however, involved copies of a painting, as did another case cited in both *Parton* and *Pushman*, *Turner v. Robertson*, 10 Irish Chancery Rep. 121, 143 (1860). See *Pushman*, 39 N.E. 2d at 250; *Parton*, 18 F. Cas. at 1278. On the other hand, the *Pushman* court also noted dicta from *Stephens v. Cady*, 55 U.S. 528, 531 (1852), a case involving maps, that copyright “will not pass with the *manuscript* unless included by express words in the transfer” (emphasis added). See *Pushman*, 39 N.E.2d at 251.

²⁰⁹ As for federal law, see 17 U.S.C. §§ 202, 204(a); *Dumas v. Gommerman*, 865 F.2d 1093, 1097 & n.9 (9th Cir. 1989). As for state law, see, e.g., N.Y. ARTS & CULT. AFFAIRS L. § 14.01 (McKinney 2007); *Samet & Wells, Inc. v. Shalom Toy Co.*, 185 U.S.P.Q. 36, 38-39 (E.D.N.Y. 1975).

²¹⁰ *White v. Kimmell*, 193 F.2d 744, 746-47 (9th Cir. 1952). Since a sale is one type of distribution, the very last portion of the definition seems redundant, if nothing else. For an alternate interpretation of the definition (which I reject), see *infra* note 235.

²¹¹ 210 U.S. 339, 350-51 (1908).

²¹² See *Harrison v. Maynard, Merrill & Co.*, 61 F. 689, 692 (2d Cir. 1894); *Clemens v. Estes*, 22 F. 899, 900 (C.C.D. Mass. 1885).

it.²¹³ On the other hand, it is not entirely clear that the exhaustion doctrine applies to common-law copyrights; I am not aware of any authority directly on point. One might think, however, that the policy considerations that underlie the exhaustion doctrine, such as disfavoring restraints on alienation,²¹⁴ might have appealed to common-law courts as well. Moreover, several of the recent fair use cases have involved personal correspondence or other papers, the owners of which tangible items had donated or sold to university libraries; courts have held these works to be “unpublished,” despite the transfer of ownership of the tangible copies to the library.²¹⁵ Perhaps in such instances the owners of the tangible copies themselves have violated some implicit duty of trust, owed to the copyright owner, in effecting these transfers, but to my knowledge no one has ever asserted such a claim against, say, the recipient of a letter on this basis. And in other related areas of the law, courts do not appear blithely to impose implicit duties of confidentiality, absent some sort of confidential relationship such as principal-agent or licensor-licensee. In the context of trade secret law, for example, the Restatement of

²¹³ See 17 U.S.C. § 109(a) (stating that “the owner of a particular copy or phonorecord lawfully made under this title . . . is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord”). Commentators have debated whether the first-sale doctrine is a default rule or a mandatory rule. Compare, e.g., Lothar Determann & Aaron Xavier Fellmeth, *Don't Judge a Sale by Its License: Software Transfers Under the First-Sale Doctrine in the United States and the European Community*, 36 U.S.F.L. REV. 1 (2001) (mandatory), with Raymond T. Nimmer, *Breaking Barriers: The Relation Between Contract and Intellectual Property*, 13 BERKELEY TECH. L.J. 827 (1998) (default). The legislative history of the 1976 Act suggests that breaching a promise not to resell may be remediable as a breach of contract, but that it is not a copyright violation. See Mark A. Lemley, *Intellectual Property and Shrinkwrap Licenses*, 68 S. CAL. L. REV. 1239, 1282 (1995) (stating that “Congress was explicit in the context of [Copyright Act] § 109(a) that it intended for vendors who ‘contract around’ the first sale doctrine to be limited to contract remedies”) (citing H.R. REP. NO. 94-1476, *reprinted at* 1976 U.S.C.C.A.N. 5659, 5693 (1976)).

²¹⁴ See, e.g., Glen O. Robinson, *Personal Property Servitudes*, 71 U. CHI. L. REV. 1449, 1480-92, 1496-97 (2004).

²¹⁵ See, e.g., *Wright v. Warner Books, Inc.*, 953 F.2d 731, 737 (2d Cir. 1991), *aff'g*, 748 F. Supp. 105 (S.D.N.Y. 1990); *New Era Publs. Int'l, ApS v. Henry Holt & Co., Inc.*, 837 F.2d 576, 583 (2d Cir. 1989); *Salinger v. Random House, Inc.*, 81 F.2d 97, 99 (2d Cir. 1987); *Kramer v. Newman*, 749 F. Supp. 542, 551 (S.D.N.Y. 1990).

Unfair Competition suggests imposing such a duty only when the recipient knows or should know that the disclosing party intends for the information to remain confidential, and the disclosing party is reasonable in inferring consent to this condition.²¹⁶ Contrast this approach with the courts' free and easy imposition of an implicit duty to refrain from distribution or resale in the *Academy* and *Brewer* cases.

To the extent one attempts nonetheless to make some principled distinctions, let us attempt to catalog the various possible candidates for general publication, from the easiest cases to the hardest, so that we can see precisely where the possible fault lines lie. The easiest might be the typical case in which the copyright owner (or her agent) actually distributes tangible copies (note the plural) of the work to the “general public,” meaning (as suggested above) anyone who wants it for the asking price.²¹⁷ Next easiest might be a case in which the author *offers* to distribute copies (plural) to the general public, for example by putting them on sale. Although the language of the 1976 Act, curiously, does not literally address this situation—it speaks of offers to distribute *for the purpose of* further distribution, public performance, and public display, and not for, say, the purpose of mere personal enjoyment—it seems reasonably clear from the case law that offers for sale to the general public count as publications.²¹⁸ This would be consistent with the

²¹⁶ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 41(b) (1995).

²¹⁷ I suppose there might be other variations that would amount to a distribution to the general public. For example, if I pass out pamphlets indiscriminately to anyone who will take one (or drop them from an airplane), presumably the indiscriminate nature of the distribution amounts to a general publication (despite the fact, as noted above, that the recipients are by necessity “limited” in a geographic sense).

²¹⁸ *Roy Export Co. v. CBS, Inc.*, 672 F.2d 1095, 1102 n.14 (2d Cir. 1982) (stating that, “[t]hrough the cases contain much talk of publication occurring upon the sale of single copy, such statements express the thought that availability for public sale constitutes publication, even if actual sales are minimal”) (citing *Bobbs-Merrill Co. v. Straus*, 147 F. 15, 19 (2d Cir. 1906), *aff'd*, 210 U.S. 339 (1908)); *William A. Meier Glass Co. v. Anchor Hocking Glass Corp.*, 95 F. Supp. 264, 268 (W.D. Pa. 1951) (stating that plaintiff’s design “was offered for sale and constituted a general publication whereby plaintiff abandoned and surrendered any common law property right it may have had in said design”). *But see* *Arista Records LLC*

cases stating that the sale of even a single copy can constitute a general publication, assuming that copies were available to anyone who wanted them.²¹⁹

A more difficult question would be whether a public offer to sell a single copy--say, of a unique work of art--to the highest bidder would constitute a general publication. Although the logic of the preceding cases, stating that the sale of a single copy can constitute a publication, might suggest that the *offer* to sell a single copy can also serve as a publication, the only case I am aware of that addresses this issue, *Werckmeister v. American Lithographic Co.*,²²⁰ actually draws a distinction between the offer for sale of a single copy of a *book* (which, it says, effects a publication)²²¹ and the exhibition for sale of a unique work of art,²²² stating that the latter does not constitute a publication. At first blush, the court's reasoning--that the author of a unique work of art generally seeks to

v. Greubel, 453 F. Supp. 2d 961, 969 n.11 (N.D. Tex. 2006) (stating that only an offer for purposes of further distribution, public performance, or public display constitutes a publication, according to a literal reading of § 101) (citing *In re Napster, Inc. Copyright Litig.*, 377 F. Supp. 2d 796, 804-05 (N.D. Cal. 2005)).

²¹⁹ See, e.g., *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 299-300 (3d Cir. 1991) (stating that “a general publication may be found when only one copy of the work reaches a member of the general public”) (citing *Brown v. Tabb*, 714 F.2d at 1091, and *Burke*, 598 F.2d at 691); *Roy Export*, 672 F.2d at 1102 n.14; *Werckmeister v. Am. Lithographic Co.*, 134 F. 321, 325 (2d Cir. 1904) (citing *Wheaton v. Peters*, 33 U.S. 591 (1834)). See also H.R. REP. NO. 94-1476, at 138, *reprinted at* 1976 U.S.C.C.A.N. 5659, 5754 (stating that, under the definition included in the 1976 Act, “a work is ‘published’ if one or more copies or phonorecords embodying it are distributed to the public—that is, generally to persons under no explicit or implicit restrictions with respect to disclosure of its contents”). Notice, however, one curious implication of the rule that offers made to the general public effect publications. If I were to compose a work without revealing the precise expression to anyone, and then offer to sell copies of the work (described in somewhat general terms) to the general public, presumably the offer would constitute a general publication, despite the fact that no one besides me has yet seen the actual text (or even responded to the offer). I thank David Nimmer (who agrees that the offer would constitute a general publication) for suggesting this hypothetical.

²²⁰ 134 F. 321 (2d Cir. 1904).

²²¹ See *id.* at 325 (stating that, “in case of a book,” “[t]he unrestricted offer of even a single copy to the public implies the surrender of the common-law right”).

²²² See *id.* at 326 (stating that “[t]he exhibition of a work of art for the purpose of securing a purchaser or an offer to sell does not adversely affect the right of copyright”).

profit from the sale of the original and not from reproductions²²³--seems a bit of a non sequitur,²²⁴ but perhaps there was something to it at the time. In the case of books, the distribution of copies to prospective publishers for consideration is, by all accounts, a limited publication; general publication occurs only when the authorized publisher makes copies available to the public.²²⁵ Similarly, in the case of unique works of art, the author's distribution of the original to *prospective* dealers or exhibitors presumably would be at most a limited publication as well. But whether the *authorized* dealer's exhibition of the original to the public, even if for purposes of sale, should be analogized to the authorized publisher's making copies of a literary work available to the general public, is less clear. The result of equating the two would be to require (prior to 1989) the visual artist to affix copyright notice to the original, which as noted above might have resulted in the defacement of the work.²²⁶ And while it might seem unpalatable to have different rules for different classes of works, this dichotomy may also be seen in the cases involving personal correspondence (which, in the days before e-mail, typically existed in unique copies). As we have seen, the recipients of such correspondence can shop it to libraries or archives without effecting a general publication, perhaps due to concerns that

²²³ *See id.*

²²⁴ The court also noted that copyright law at that time did not (as it now does) confer an affirmative right of exhibition or display, *see id.* at 326, but it is not so clear why, logically, this compels the result that exhibition cannot constitute publication. *Cf. Nimmer, supra* note 103, at 188-89 (arguing that the lack of copyright protection for sound recordings (prior to 1972) did not logically preclude the result that the publication of a sound recording resulted in publication of the underlying musical work). In addition, the court noted that (as in the later, but factually similar, case of *American Tobacco Co. v. Werckmeister*, 207 U.S. 284 (1907)), the gallery owner had expressly forbidden observers from copying. *See Werckmeister*, 134 F. at 326.

²²⁵ *See supra* note 155 and accompanying text.

²²⁶ *See supra* note 122 and accompanying text. In the case of paintings, however, perhaps the author could have affixed copyright notice to the back.

a contrary rule would unduly compromise authors' privacy interests.²²⁷ Perhaps the best one can do to reconcile the cases is to posit a presumption that the public offer of a single copy constitutes a general publication absent sufficient countervailing reasons such as (in the case of unique works of art offered for sale prior to 1989) the need to avoid defacement, or (in the case of personal correspondence) the desire to protect authorial privacy. In such special cases, perhaps no publication occurs unless and until the recipient is given, and lawfully exercises, the authority to make additional copies and to distribute those copies to the public.²²⁸

The next case in the factual progression developed above would be one in which the author, in the words of the 1976 Act, “offer[s] to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display.”²²⁹ According to the House Report accompanying the 1976 Act, this provision “makes clear that, when copies or phonorecords are offered to a group of wholesalers, broadcasters, motion picture theaters, etc., publication takes place if the purpose is ‘further distribution, public performance, or public display.’”²³⁰ The actual text, however, leaves some gaps. It is unclear, for example, whether the “further distribution”

²²⁷ Although such interests would normally terminate at death. See *Wright*, 738 F. Supp. at 110-11.

²²⁸ Cf. 1 RICKETSON & GINSBURG, *supra* note 100, § 6.45, at 273 (suggesting that, under the Berne Convention—which, unlike U.S. domestic law, provides that publication does not occur unless “the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of work,” Berne Convention art. 3(3)—the exhibition for sale of a unique work of art does not constitute publication, because “there is no making available of *copies* to satisfy the reasonable requirements of the public”) (emphasis added).

²²⁹ 17 U.S.C. § 101.

²³⁰ H.R. REP. NO. 94-1476, at 138, *reprinted at* 1976 U.S.C.C.A.N. 5659, 5754. Literally construed, the language might apply to a broader set of circumstances; for example, where the author has merely offers copies to some group of disciples and charges them with distributing or displaying those copies to, or performing the work therein embodied for, others. It seems unnecessary that the disciples accept the offer.

referenced in § 101 must be a distribution “to the public,” although this is probably the intended meaning. By linking the terms “further distribution, public performance, or public display,” the statutory language corresponds to Copyright Act § 106, which confers upon copyright owners the rights to “distribute copies or phonorecords of the copyrighted work *to the public* by sale or other transfer of ownership, or by rental, lease, or lending,” as well the rights to publicly perform the work and to publicly display copies.²³¹ More perplexing is that the statute does not use the term “limited group,” as in the *White v. Kimmell* definition of “limited publication,” but rather just “group.” But if the group referred to in the statutory text were a group larger than a “limited group,” then it would seem that the offer to distribute copies to that group would constitute a general publication in and of itself, regardless of the “purpose” for which the offer to distribute is made, under the analysis sketched out in the preceding paragraph, and that the statutory language would be superfluous.²³² Cases interpreting the meaning of this provision of § 101 are few and far between.²³³

The hardest case, in the sense of the one that is probably most difficult to classify as a general or limited publication, would be one in which the author (or her agent)

²³¹ 17 U.S.C. § 106(3)-(6) (emphasis added). It also might seem odd to define publication in such a way that an offer to distribute copies to a limited group of persons for purposes of further distribution to another limited group of persons falling short of the general public would nevertheless constitute a publication.

²³² See 1 NIMMER & NIMMER, *supra* note 44, § 4.04, at 4-23 (inferring that “an offer to distribute to members of the public for their own use” would constitute a publication as well).

²³³ See *Bagdadi v. Nazar*, 84 F.3d 1194, 1198-99 (9th Cir. 1996) (holding that a school constituted a “group of persons”). Building on the preceding analysis, the next question would be whether an offer to distribute multiple copies to a single person—not a group—for purposes of further distribution, public performance, or public display, constitutes a publication. Presumably, distributing a single copy of a play or musical work to a single person chosen by the author—or even to a limited group (say, of actors or musicians) for purposes—for purposes of public performance, would not be a publication; nor would distributing a single copy of a work of art for public display. Distributing a single copy to a single person, with instructions that he in turn pass it along (but not copy it) to others, on the other hand, might conceivably be a publication; I know of no authority even considering this issue, however.

distributes a single copy to a single person, without express restriction on what the person may do with that copy. Several considerations may be relevant. First, if the recipient is a person who has responded to a general offer—or, alternatively, a person indiscriminately selected by the author for receipt of the copy—then, if the analysis above is correct, it would seem that (in the general case) a publication has been effected: both the offer and the distribution were directed at the general public, and (absent other facts to the contrary) the recipient is free to sell, give away, or lend the copy to other members of the general public.²³⁴ Second, however, if the recipient is instead a “limited group” (of one)—a single person chosen by the author for a particular reason—then, under the “limited publication” analysis, the issue of whether a general publication has occurred would depend on other facts. A strict interpretation of “limited publication” would suggest that, if the recipient is free to diffuse, reproduce, distribute, *or* sell the copy, the author has effected a general publication. As noted above, however, the first-sale doctrine normally would permit the recipient to distribute or sell his copy, though not to reproduce or “diffuse” it. Courts nevertheless have striven to avoid this literal interpretation, either by inferring (from thin air, in some instances) an implicit duty against alienation or by (in the context of personal correspondence) ignoring the matter altogether. A literal interpretation also would seem to result in the general publication of plays and musical works that authors disclose to actors and musicians merely for purposes of public performance (diffusion), unless the actors and musicians were somehow considered mere agents of the author. The literal approach would also seem to cover a case in which the author transfers a copy of her work to a friend and expressly

²³⁴ See *supra* text accompanying notes 211-16.

permits the friend to make additional personal copies, even if the author enjoins distribution of those copies. And yet it strains credulity to think that permitting a friend to make extra copies of, say, a photograph or poem for personal use results in the general publication of the photograph or poem.²³⁵

Given these contradictions, I would suggest that, with respect to the question whether the distribution of a single copy to a single “limited group” recipient can constitute a general publication, a key consideration should be whether the recipient himself is free to effect a general publication in any of the ways sketched out above—i.e., by distributing or offering to distribute a copy or copies to the general public. Adoption of this definition would eliminate some of the anomalies alluded to above, under which an author who permits the recipient to make personal copies or to publicly perform or

²³⁵ Alternatively, perhaps one could argue that my exegesis of “limited publication” has been incorrect from the start, and that a publication is limited unless, *inter alia*, the author conveys to the recipient the right to diffuse, reproduce, distribute, *and* sell the work. In other words, maybe the phrase “without the right of diffusion, reproduction, distribution or sale” should be read to mean something like “without the right to do all of the following: diffusion, reproduction, distribution, or sale.” Reading the word “or” to mean, in context, “and,” is not without some precedent within the context of statutory interpretation. *See, e.g.*, *Skutt v. Dillavou*, 13 N.W.2d 322, 325 (Iowa 1944) (“The courts do not hesitate to construe ‘and’ as ‘or’ if necessary to arrive at legislative intent.”); *Robson v. Cantwell*, 141 S.E. 180 (S.C. 1928). But this definition seems to go too far in the other direction. Distributing copies—or even offering to distribute copies, if we are to credit the statutory text—to even a limited group, for the specific purpose of further distribution of those copies to the general public, would appear to be a general publication, even if the group is not authorized to *make* its own copies. More generally, it has long been common for authors to license their individual rights (to copy, to perform, etc.) to different entities, without licensing any one entity to engage in all of the activities covered by the copyright. But this definition seems to go too far in the other direction. Distributing copies—or even offering to distribute copies, if we are to credit the statutory text—to even a limited group, for the specific purpose of further distribution of those copies to the general public, would appear to be a general publication, even if the group is not authorized to *make* its own copies. More generally, it has long been common for authors to license their individual rights (to copy, to perform, etc.) to different entities, without licensing any one entity to engage in all of the activities covered by the copyright. To be sure, courts at one time applied the principle of “copyright indivisibility,” under which it was deemed impossible for copyright owners to *assign* their various rights to different entities. *See Jim Henson Productions, Inc. v. John T. Brady & Assocs.*, 16 F. Supp. 2d 259, 288 (S.D.N.Y. 1997). But they could license (i.e., permit the use of) the various rights individually. *See id.* Moreover, the 1976 Act definitively rejects the indivisibility principle, *see* 17 U.S.C. § 201(d), and some courts had begun to move away from it even earlier. *See supra* note 112 (discussing *Goodis*). Perhaps some ill-considered reliance on indivisibility lay behind both the *Pushman* doctrine and the *White v. Kimmell* formulation of “limited publication,” but the opinions themselves do not expressly mention that doctrine.

display the work would be viewed as having made a general publication. It would, rightly, cover situations in which the author has authorized the recipient to make copies for further distribution to the general public. But it would still leave open the possibility that a general publication occurs whenever the author transfers a copy to the recipient, and the recipient remains free to exercise his first-sale rights to sell or otherwise dispose of his single copy (even if not to make additional copies); or when the author transfers a copy to the recipient and authorizes the recipient to make and distribute of copies to the general public at a later time. These problems suggest that the definition should be further refined, so that the transfer of a single copy to a single recipient effects a general publication only when the recipient actually makes a lawful distribution, or offers to make a lawful distribution, to the general public. On this revised definition, a mere offer, on the part of the author, of a single copy to a single recipient, could never be a general publication, because the recipient himself cannot make a general publication until he is in actual possession of the copy.²³⁶

The main drawback of this proposed redefinition is that it might appear to be in tension with the “offering to distribute” language of § 101, which language suggests that a mere offer (at least to a group) *can* effect a general publication, if the offer is for the purpose of further public distribution, performance, or display of the work. And if a mere offer to distribute copies to such a group can effect a publication, under some

²³⁶ So construing the language would avoid making formalistic distinctions, based on number of recipients or number of copies. It would also avoid casting the offering of a single copy to a single recipient as a general publication, if the offer contemplates a general publication at some point beyond the immediate future--or, *a fortiori*, merely permits but does not request the recipient to make a general publication. In such a case, a general publication would occur only when the recipient exercises his right to make a general publication, not before. As such, it would be analogous to the rule that merely delivering a copy to a prospective publisher or to a printer is not a publication, whereas the delivery to retail stores is. *See, e.g.*, 1 NIMMER & NIMMER, *supra* note 44, § 4.13[A][1].

circumstances, even though the purpose of the proposed distribution is to effect only public performance or display, then surely an actual distribution to such a group for such a purpose should, too. Perhaps the only way out of this logical contretemps is to construe the “offering to distribute” language of § 101 as involving offers made to a “group of persons” that is more than merely a “limited group.”²³⁷ That is to say, the “group of wholesalers, broadcasters, motion picture theaters, etc.” referenced in the House Report are not a “limited group,” but rather a subset of the general public--i.e., the offer is open to anyone who is willing to pay.²³⁸ As suggested above, this interpretation tends to make the statutory language superfluous, if I am correct above in arguing that an offer to distribute copies to a (more-than-limited) group is necessarily a general publication. But perhaps the interpretation can be defended on the ground that it clarifies what the law already was and would be, even in the absence of the express statutory language.²³⁹

²³⁷ Alternatively, perhaps one could focus on the words “for purposes of”. An author who offers to distribute even a single copy to a single recipient—*a fortiori* multiple copies to multiple recipients—effects a general publication if her *purpose* is to effect, in the immediate future, the further distribution of copies to the general public, or to permit the general public to perform or display the work. (Note that, when a broadcaster transmits a performance of a work over the airwaves or over the Internet, the broadcaster has effected a public “performance” of the work. *See* 17 U.S.C. § 101 (definitions of “perform,” “publicly,” and “transmit”). A member of the general public who tunes into the broadcast also arguably “performs” the work, by means of rendering or playing it “by means of any device or process,” *see id.*, but she does not “publicly” perform it unless she happens to be playing the radio or television or accessing Internet in a place open to the general public, *see id.* She also would be publicly performing a work if she played a CD or DVD embodying that work in a public place. Whether these acts infringe would depend on the applicability of a liability exception such as fair use or 17 U.S.C. § 110(4).) But the House Report suggests that the language was intended to cover situations in which the “group of persons,” not the public, effects the further distribution, performance, or display. *See supra* text accompanying note 230.

²³⁸ Depending on the degree of vertical integration, of course, there may be only a limited number of distributors or broadcasters or theaters with whom a copy is contractually bound to deal. At least in theory, though, such exclusive dealing arrangements are open to revision from time to time. *See, e.g.,* Barry Wright Corp. v. ITT Grinnell Corp., 724 F.2d 227, 237-38 (1st Cir. 1983).

²³⁹ *See* ProCD v. Zeidenberg, 86 F.3d 1447, 1452 (7th Cir. 1996) (“To propose a change in a law’s *text* is not necessarily to propose a change in the law’s *effect*. New words may be designed to fortify the current rule with a more precise text that curtails uncertainty.”) (emphasis in original).

A final wrinkle concerns the conflicting case law on the question of performances and displays. As we have seen, some courts have stated that publication may occur when the author permits the audience to copy the work, while other authorities adhere to the narrower view--arguably adopted in the 1976 Act--that performance and display by themselves never constitute publication. There is much to be said for the view that an author who permits others to make (and, presumably, distribute) copies of her work has effected a general publication, at least once such permission has been exercised, every bit as much as one who distributes tangible copies herself. The difficulty lies more in the practical consideration of proving whether such permission has been (as will usually be argument) implicitly given; and if so, when has it been exercised. To the extent the issue can arise today only with respect to pre-1978 performances and displays, perhaps the better view is to consider such authorized copying by members of the general public to constitute a general publication, but to require cogent proof that such permission was, in fact, given.²⁴⁰ Such proof presumably will be harder to come by as the years progress, and thus this issue may fade into oblivion somewhat sooner than will some other issues relating to publication. Recall too that cases such as *Estate of King* and *Letter Edged in Black* in which performance or display was alleged to have constituted publication probably could have been disposed of on the less controversial ground that the copyright owner distributed copies to the general public.²⁴¹

²⁴⁰ Mere acquiescence on the part of the copyright owner probably shouldn't suffice, unless it rises to the level of laches; copyright owners generally are under no duty to enforce their rights. *See, e.g., Famous Music Corp. v. Bay State Harness Horse Racing & Breeding Ass'n, Inc.*, 423 F. Supp. 341, 344 (D. Mass. 1976) (holding that a plaintiff delaying five months before bringing infringement suit did not rise to the level of causing financial hardship to support defendants allegation of laches); *Greenbie v. Noble*, 151 F. Supp. 45, 60 (S.D.N.Y. 1957).

²⁴¹ *See supra* notes 135, 150 and accompanying text.

In sum, I have suggested the following rules to reconcile the competing statutory and case law definitions of publication, and to avoid undesirable results. First, a general publication occurs if the author (or her agent) distributes, or offers to distribute, at least one copy to the “general public”—that is, to a more-than-limited group, meaning to anyone who is interested, or to members of the public indiscriminately. Second, a general publication also occurs if (1) the author (or her agent) (a) actually distributes at least one copy to at least one person, and (b) authorizes that person to effect a general publication in accordance with either of the forgoing methods; and (2) the person so authorized himself actually effects a general publication in accordance with method number one. Third, in certain special cases, such as (arguably) cases involving personal correspondence or other material cloaked with substantial privacy interests, or works of art the affixation of copyright notice to which prior to 1989 would have resulted in a defacement, perhaps no general publication occurs unless the author also authorizes the recipient to copy the work, and the recipient actually exercises his authority both to copy and distribute (or offer to distribute) copies to the general public.

Applying this definition, to be sure, will not resolve all uncertainty. Some courts will be more willing than others to infer a duty on the part of the recipient *not* to effect a general publication by distributing or offering to distribute his copy or copies to the general public. Be that as it may, my proposed definition at least should help to focus courts’ attention on what really matters: whether the author herself, or the recipient of her work, has lawfully released, or offered to release, a copy or copies of the work for members of the general public to possess, distribute, perform, or display. Reasonable minds might differ, in cases such as *Academy* and *Brewer*, on the question whether the

recipients had the lawful power so to distribute; or whether, in cases such as *Hirshon* and (again) *Brewer* copies were offered to the general public; or whether, in the case of personal correspondence, recipients were authorized to copy as well as distribute. And there may still be the odd case from time to time on the question of whether performance or display, pre-1978, effected a general publication. To the extent legal doctrine still demands a definition of publication, however, that is as consistent as possible with the existing case law and that avoids bizarre outcomes, the above may be the best that can be hoped for. It still leaves open the questions, however, of pressing importance today, of whether Internet transmissions involve “distributions” and thus can be subject to the above rules at all; and whether criteria other than publication, as defined above, might provide a better fit for purposes such as measuring copyright duration, in the case of works for hire, or imposing a duty to deposit. I address these issues in the next two sections.

B. Publication by Internet?

In Part III above, I argued that, as a textual matter, the question of whether an author who transmits her work over the Internet has or has not effected a publication could be resolved either way, depending upon whether the temporary RAM copy that a user’s computer necessarily makes, whenever the user accesses a website that incorporates the work, is considered a tangible copy. As a policy matter, the question *should* be resolved in light of the consequences that follow from defining something as a publication. Among the relevant consequences of equating transmission with publication are: (1) that registration must follow within three months of transmission, in order for the author to qualify for an award of statutory damages and attorneys’ fees in the event of an

infringement preceding the registration; (2) that the author must deposit two copies of the work with the Library of Congress; (3) that the term of copyright commences from the date of uploading, if the work is a work for hire or an anonymous or pseudonymous work, and persists for 95 years; and (4) that the fair use exception would be marginally more favorable to defendants. By contrast, a rule that does not equate transmission with publication means that, unless the author effects a publication in some other manner, her work remains unpublished, which in turn means that (1) the author cannot obtain statutory damages or fees for any acts of infringement commenced before the date of registration; (2) the author need not deposit copies with the Library of Congress; (3) the term of copyright commences upon creation and, if the work is a work for hire or an anonymous or pseudonymous work, will persist for 120 years; and (4) the fair use defense would be marginally more favorable to plaintiffs. Whether the work is deemed to have been published or not, by virtue of its transmission over the Internet, also can affect such matters as protectability, eligibility for copyright restoration, and exemption from the registration requirement, assuming that the publication, if it occurred at all, first occurred in a foreign country.

Unfortunately, the policy considerations do not all point unambiguously in one direction. On the one hand, if statutory damages and fee awards are viewed as an important tool for ensuring the copyright owner an adequate return on her investment, then it might seem that equating transmissions with publication is desirable, insofar as this interpretation affords the author a three-month window of opportunity to effect the registration that is a necessary precondition for such an award. Indeed, if the reason for affording the three-month grace period is the concern that published works are more

vulnerable to copying than are unpublished works, that reason might seem equally applicable to works made available over the Internet.²⁴² In addition, neither of the rationales for according unpublished works greater protection against fair use and other copyright exceptions--deference to the author's privacy interests and to her economic interest in timing the date of publication—seems very strong when the author herself has made her work available for public access over the Internet. On the other hand, requiring all website owners to deposit copies of their work with the Library of Congress might appear both burdensome (particularly if the content of the website changes with some frequency),²⁴³ and pointless, insofar as works made available to the public over the Internet are, in the typical case, much more readily accessible as a practical matter than are hard copies residing in the Library of Congress (though of course the former can be deleted more easily as well). In addition, equating transmissions with publication would reduce the copyright term for certain works from 120 to 95 years, and would render the fair use defense marginally more tenable, both of which results might increase social (but not the individual author's) welfare.²⁴⁴ At the same time, equating the two concepts might require inquiry into where a work is first accessed to determine its country of first publication; this inquiry may be not only burdensome but also fortuitous, to the extent the

²⁴² See *supra* text accompanying note 49.

²⁴³ See ONLINE CIRCULAR, *supra* note 197, at 2 (stating that “Generally, copyrightable revisions to online works that are published on separate days *must each be registered individually*, with a separate application and filing fee,” unless it qualifies as an automated database or a serial or newsletter) (emphasis in original). Online works can be registered as literary works, pictorial works, and so on, *see id.*; but there is no separate classification for online works, and I am not aware of any statistics on the number of websites or other online works that have been registered. According to one estimate, there are over 127,000,000 websites in existence. See Netcraft, *August 2007 Web Server Survey*, available at http://news.netcraft.com/archives/web_server_survey.html.

²⁴⁴ In the vast majority of cases, however, the final 25 years of copyright protection will probably have little if any value; and the fact that a work is published is often not a determinative factor in the fair use calculus (though the converse sometimes is). Even so, these factors will have consequences in some cases.

work *could* be first accessed just about anywhere.²⁴⁵ Alternatively, if the work is available for downloading everywhere, perhaps it should be viewed as simultaneously published everywhere, on the analogy of books that are deemed published upon their first appearance on retailers' shelves, regardless of whether any consumer buys or even notices them. This would mean, however, that the country of origin of a work first uploaded in the United States by a U.S. author would be the country or countries whose copyright term is the shortest.²⁴⁶ While defensible in theory, this outcome might seem contrary to copyright owners' reasonable expectations.²⁴⁷

On balance, despite some common-sense appeal to the notion that works transmitted over the Internet are necessarily published, and despite a plausible textual basis for reaching this result, it is hardly obvious that this result would be desirable.²⁴⁸

²⁴⁵ As noted above, whether such an equation would contravene the Berne Convention presents an interesting question as well. *See supra* note 100.

²⁴⁶ *See supra* note 101 and accompanying text.

²⁴⁷ Of course, even if Internet transmissions by themselves do not constitute publications, the user's authorized downloading of material from a website may. *See supra* note 100. If so, then in such a case the work may be deemed simultaneously published in all countries in which authorized downloading is possible, and the country of origin may indeed be the country with the shortest term. *See id.* Granted, a rule effectively defining the country of origin of a work first made publicly available over the Internet as the country with the shortest term would not be disastrous. Countries such as the United States that do not take advantage of the Berne Convention's rule of the shorter term, *see* Berne Convention art. 7(8), would accord such works the full copyright term available under domestic law; and, as noted above, countries that are members of Berne and TRIPs cannot deviate from the minimum terms set forth in those agreements. *See supra* note 101. And while it is possible that the country of origin would decide, consistent with the Berne Convention, to impose formalities upon the enjoyment and exercise of copyright rights upon domestic works, failure to comply with which would result in the injection of those works into the public domain, *see supra* text accompanying notes 27-29, as a practical matter this outcome seems, at present, rather unlikely. Even so, it might seem odd to adopt a rule effectively defining the country of origin of all works "published" on the Internet as, say, Canada; and the Berne Convention's rules for determining country of origin in cases involving simultaneous publication surely were not drafted with the Internet in mind. *See generally* 1 RICKETSON & GINSBURG, *supra* note 100, §§ 6.59-6.64 (arguing for equating country of origin with country of author's nationality or residence, in cases involving digital transmissions).

²⁴⁸ In addition, the fact that copyright owners *can* register unpublished works—or effect the conventional publications of such works, register their copyrights thereafter, and still take advantage of the three-month grace period—takes some of the sting out of the grace period's applicability to published works only; and perhaps there is something to be said for enabling copyright owners themselves to determine where and

Perhaps the more fundamental insight, though, is not that the current definition of publication is too ambiguous or too narrow, but rather that too many disparate consequences now follow from the fact and place of publication. In the following section, I argue that a more rational copyright policy might condition some of these consequences upon slightly different criteria. If it were to do so, then perhaps Internet transmissions could be deemed publications for some purposes and not others.

C. Publication for Some Purposes and Not Others?

If there is any one lesson to be learned from this survey of the law of publication, it is that publication has been pressed into service for too many disparate purposes. A more rational copyright policy might focus instead on the consequences that now follow from the fact, date, or place of publication, and consider whether it would make more sense for those consequences to from other criteria. As discussed in Part II, publication sometimes serves as the event from which other time periods are measured; in other cases, rights or duties of either copyright owners or users are conditioned upon the presence or absence of publication. In still others, place of publication determines whether a work is protected at all, and if so whether the author enjoys certain benefits that are not available to other authors. In this section, I will argue that, depending on which consequence is at issue, publication may still be as good a criterion as any alternative; but that a broader or narrower definition of publication may be appropriate, depending on the purpose being served.

when their works are published, given all the consequences that flow from publication, rather than applying an unavoidable rule that every transmission necessarily effects a publication somewhere (or perhaps everywhere).

An initial question to consider, nevertheless, is whether criteria other than publication, however defined, would be a preferable trigger for some or all of the consequences that now follow from publication. For example, consider those cases in which publication now serves as the event from which other events, such as copyright duration, are now measured.²⁴⁹ An initial problem, as we have seen, is that determining exactly when publication occurs is not always an easy matter. But whether other criteria would enjoy any advantage over publication, say for purposes of reducing administrative costs, is hardly clear. One possible alternative would be to use the date of creation of the work instead,²⁵⁰ but this date is not necessarily any more precise than the date of publication. Creation may occur over many days (or months or years), and each individual draft of a work may count a separate work.²⁵¹ Creation also may span many different geographic locations, which gives rise to further complications to the extent place of creation merely replaces place of publication as a criterion for protectability or other benefits. A creation criterion also might involve nice questions of when a work, not yet fixed, was first conceived or performed.²⁵² If so, then perhaps fixation would be a

²⁴⁹ See *supra* notes 32-42 and accompanying text.

²⁵⁰ Under current law, the date of creation *is* used for some purposes. The term of copyright, for example, now commences at creation. See 17 U.S.C. § 302(a). The termination date for works for hire and for anonymous and pseudonymous works is 95 years from the date of publication or 120 from the date of creation, whichever expires first. See *id.* § 302(c).

²⁵¹ See *id.* § 101 (definition of derivative work).

²⁵² Patent law sometimes takes into consideration the date on which an inventor conceived of an invention. See *In re Jolley*, 308 F.3d 1317, 1321 (Fed. Cir. 2002) (stating that “evidence of conception must ultimately address whether the inventor formed ‘the definite and permanent idea of the complete and operative invention’ in his or her mind”) (quoting *Bosies v. Benedict*, 27 F.3d 539, 543 (Fed. Cir. 1994)). Applying this criterion in the context of patent law is difficult enough. Applying it in the context of, say, a novel or a symphony would require a court to consider how fully formed the work must be in the mind of the creator before it is conceived. Determining when an initially unfixed work was first performed would involve similar difficulties.

preferable criterion, but application of a fixation criterion would give rise to questions—perhaps no easier to answer—of when and where different versions of a work were fixed. Moreover, unless a more robust durability requirement were incorporated into the definition of fixation,²⁵³ the mere fact that a work was *once* fixed does not necessarily lead to greater certainty of application; there is no guarantee that the fixed version of a work will be in existence at some later time.²⁵⁴

Alternatively, one might seek to reduce administrative costs by retaining the publication criterion but redefining it to mean that at least one tangible copy of the work was publicly accessible. U.S. patent law has long defined the term “printed publication” along precisely these lines.²⁵⁵ Courts have held, for example, that a printed publication need only be something tangible, not literally a “printed” document,²⁵⁶ and that it need

²⁵³ The only criterion now, under U.S. law, is that an embodiment of the work “is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” 17 U.S.C. § 101.

²⁵⁴ See Lichtman, *supra* note 119, at 732-34.

²⁵⁵ Under U.S. law, an inventor is entitled to a patent only if, *inter alia*, the invention claimed was not “described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent” Under U.S. law, an inventor is entitled to a patent only if, *inter alia*, the invention claimed was not “described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent,” 35 U.S.C. § 102(a); was not “described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States,” *id.* § 102(b); and was nonobvious in light of any such printed publication or publications, as of the date of invention and more than one year prior to the date of application for a U.S. patent, *see id.* § 103(a) (“A patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains”); *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1305 (Fed. Cir. 2006); *In re Foster*, 343 F.2d 980, 984 (C.C.P.A. 1965) (holding that invention must be nonobvious in light of § 102(b) prior art, more than one year prior to filing of U.S. patent application).

²⁵⁶ See *In re Klopfenstein*, 380 F.3d 1345, 1348 n.2, 1349 n.4 (Fed. Cir. 2004) (stating that “the question to be resolved in a ‘printed publication’ inquiry is the extent of the reference’s ‘accessibility to at least the pertinent part of the public, of a perceptible description of the invention, in whatever form it may have been recorded’”; but that “an entirely oral presentation at a scientific conference that includes neither slides nor copies of the presentation is without question not a printed publication,” and that “a presentation that includes a transient display of slides is likewise not necessarily a ‘printed publication’”) (citation omitted);

not comprise anything more than a single copy that is accessible to the relevant audience.²⁵⁷ On this reasoning, even a single copy of a Ph.D. thesis that is reasonably accessible in a foreign university library can constitute a printed publication,²⁵⁸ so too can a written disclosure made in the course of a foreign patent prosecution.²⁵⁹ Among the relevant factors in determining whether a reference is sufficiently accessible to qualify as a printed publication are whether copies were distributed to the public and whether the publication was catalogued or indexed.²⁶⁰ In the case of a temporarily displayed reference that was neither distributed nor indexed, relevant factors may include “the length of time the display was exhibited, the expertise of the target audience, the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied, and the simplicity or ease with which the material displayed could have been copied.”²⁶¹ As in copyright law, however, disclosures made only to persons who

U.S. PAT. & TRADEMARK OFF., MANUAL OF PATENT EXAMINING AND PROCEDURE § 2128, at 2100-63 (8th rev. ed. Aug. 2006) (stating that “[a]n electronic publication, including an on-line database or Internet publication, is considered to be a ‘printed publication’ within the meaning of 35 U.S.C. 102(a) and (b)’”).

²⁵⁷ See *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006) (stating that a reference is “publicly accessible” if it “has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation”) (quoting *In re Wyer*, 655 F.2d 221, 226 (C.C.P.A. 1981); *Klopfenstein*, 380 F.3d at 1348 (stating that “the key inquiry is whether or not a reference has been made ‘publicly accessible’”); *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989) (stating that a reference “must have been sufficiently accessible to the public interested in the art; dissemination and public accessibility are the keys”) (quoting *Constant v. Advanced Micro-Devices, Inc.* 848 F.2d 1560, 1568 (Fed. Cir. 1988)).

²⁵⁸ *In re Hall*, 781 F.2d 897, 898-900 (Fed. Cir. 1986); cf. *Cronyn*, 890 F.2d at 1160 (holding that theses made available to defense committees consisting of four faculty members, and not meaningfully catalogued or indexed, were not sufficiently publicly accessible to count as “printed publications”).

²⁵⁹ See *Bruckelmyer*, 445 F.3d at 1377-80; see also *Wyer*, 655 F.2d at 226 (patent application available on microfilm in the Australian Patent Office counted as a “printed publication”)

²⁶⁰ See *Klopfenstein*, 380 F.3d at 1350.

²⁶¹ *Id.* See also *id.* at 1348 (stating that “a public billboard targeted to those of ordinary skill in the art that describes all of the limitations of an invention and that describes all of the limitations of an invention and that is on display for the public for months may be neither ‘distributed’ nor ‘indexed’—but it most surely is

are under an obligation of secrecy are not considered publicly accessible.²⁶² And although the case law sheds little light on the rationale for such an expansive definition, commentators have argued that a broad definition of printed publication rightly accords inventors an incentive to seek out reasonably accessible prior art, as a way of reducing the administrative and other costs of patent protection; a patent that issues on an invention that has already been disclosed in some accessible format increases social costs with few, if any, corresponding benefits.²⁶³

Adopting a similar “public accessibility” definition rule in copyright law would give rise to both benefits and costs. To be sure, the application of an accessibility criterion would hardly eliminate unpredictability and uncertainty, insofar as even the accessibility criterion would depend, as in the patent context, upon consideration of several underlying factors. On the other hand, the sheer breadth of the criterion probably would resolve many otherwise close cases in favor of publication having occurred; future cases similar to *Academy*, *Hirshon*, and *Brewer*, in which the author makes tens or even hundreds of copies available without express limitation would almost certainly be held to involve publications. Application of an accessibility criterion, however, also might mean

‘sufficiently accessible to the public interested in the art’ and therefore, under controlling precedent, a ‘printed publication’”).

²⁶² See, e.g., *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1323-24 (Fed. Cir. 2002); *Alum. Co. of Am. v. Reynolds Metals Co.*, 14 U.S.P.Q.2d 1170, 1172-73 (N.D. Ill. 1989). If a person breaches an obligation of confidentiality owed to the inventor, however, and thus renders the invention publicly accessible, the public accessibility of the invention probably will count against the inventor. See *Lorenz v. Colgate-Palmolive-Peet Co.*, 167 F.2d 423, 425-30 (3d Cir. 1948).

²⁶³ See ROBERT P. MERGES & JOHN F. DUFFY, *PATENT LAW AND POLICY: CASES AND MATERIALS* 419-21 (3d ed. 2002).

that most Internet transmissions would constitute publications²⁶⁴; so too for personal correspondence which the recipients donate to university libraries. Both of these results would be problematic. As I suggested above, a rule equating Internet transmissions with publications may make sense for certain purposes, such as applying the statutory damages grace period and measuring the copyright term. But it would also mean that works made available on the Internet are either published in the first country in which they are downloaded, or else everywhere simultaneously, neither of which results would seem to accord with copyright owners' reasonable expectations. The criterion also would impose upon website owners a duty to deposit two copies of their websites with the Library of Congress, a requirement that seems both burdensome and unnecessary. In addition, a rule equating deposit of correspondence with publication would be contrary to the case law which, thus far, has uniformly characterized such documents as unpublished.

The main problem, however, with applying a public accessibility criterion across the board may be that copyright law employs the concept of publication for too many disparate purposes. The preceding discussion suggests that, while a public accessibility criterion might make sense in certain contexts—such as for triggering the statutory damages grace period and the running of other time periods, and for enabling the wider applicability of fair use as to works that authors make available over the Internet—it would serve less well for purposes such as imposing the duty to deposit, determining the country of origin of a work, or applying the fair use doctrine with respect to personal correspondence on deposit in university libraries. But Judge Frank's opinion in

²⁶⁴ Assuming, that is, that RAM copies are sufficiently tangible embodiments. Under the 1976 Act, as we have seen, copyright law clearly cannot go as far as patent law does in equating mere displays with publication.

*American Visuals Corp. v. Holland*²⁶⁵ may suggest a way out of this dilemma. Recall that, in that case, involving the distinction between investive and divestive publications, Judge Frank (decrying what he referred to as the “one-word-one-meaning-fallacy”) observed that the word “publication” can mean different things for different purposes.²⁶⁶ Perhaps the time has come to apply this observation in a new context. Following from the preceding analysis, a broad definition of publication, which includes Internet transmissions, may be desirable for purposes of triggering the various time periods that now run from the date of first publication. It also makes sense to define Internet transmissions as publications for purposes of the fair use and other exceptions that depend in part upon the work at issue being published.²⁶⁷ For purposes of imposing the duty to deposit, on the other hand, it may make sense to apply a narrower definition. Similarly, for purposes of determining country of origin, the narrower criterion may make sense, so that a work first made available in one country by a citizen or resident of that country is not deemed to be first published in some entirely unrelated place (or everywhere). As noted above, the narrower criterion may also be more consistent with the Berne Convention’s definition of publication,²⁶⁸ and thus applying that criterion in the

²⁶⁵ 239 F.2d 740 (2d Cir. 1956).

²⁶⁶ 239 F.2d 740, 743 (2d Cir. 1956).

²⁶⁷ Some courts actually appear to be moving in this direction. *See Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 820 (9th Cir. 2003) (stating that “[p]ublished works are more likely to qualify as fair use because the first appearance of the artist’s expression has already occurred,” and that “Kelly’s images appeared on the internet before Arriba used them in its search engine,” such that the second fair use factor weighed “only slightly in favor of Kelly”); *Video-Cinema Films, Inc. v. Cable News Network*, No. 98 Civ. 7128(BSJ), 98 Civ. 7129 (BSJ), 98 Civ. 7130 (BSJ), 2001 WL 1518263, at * 7 n.17 (S.D.N.Y. Nov. 28, 2001) (holding that, for purposes of fair use analysis, either a general or a limited publication weighs in favor of the use being a fair use).

²⁶⁸ *See supra* note 100.

context of country of origin determinations is less likely to give rise to conflicting international judgments.

Adopting these suggested changes into the definition of publication would result in the following refinements to the definition of publication I proposed in Part III.A. First, a general publication would take place if the author (or her agent) distributed, or offered to distribute, at least one copy (including a RAM copy) to the “general public”—that is, to a more-than-limited group, meaning to anyone who is interested, or to members of the public indiscriminately. Second, a general publication also would occur if (1) the author (or her agent) (a) actually distributed at least one copy (including a RAM copy) to at least one person, and (b) authorized that person to effect a general publication in accordance with either of the forgoing methods; and (2) the person so authorized himself actually effected a general publication in accordance with method number one. Third, for certain special purposes--such as imposing the duty to deposit; determining the status of personal correspondence and other private documents; requiring affixation of copyright notice that might deface unique works of art; or determining country of origin--no general publication would occur unless the author also authorized the recipient to copy the work, and the recipient actually exercised his authority both to copy and distribute (or offer to distribute) copies to the general public. What this proposed redefinition loses in conciseness, it gains in terms of being more closely aligned with sound copyright policy, and serving as a better predictor of courts’ actual behavior in close cases.

Whether such a change could be effected by the courts alone, without legislative amendment, is a matter I leave to another day. A legislative overhaul may be preferable in theory, to the extent it would enable consideration of yet more nuances. Reasonable

minds may differ, for example, on the question of whether all of the statutory time periods that are now conditioned upon publication should be triggered by the first Internet transmission, or whether some should remain conditioned upon the first conventional publication. Absent a legislative resolution, however, courts themselves may have no choice but to consider the sort of framework sketched out above. As more cases similar to *Getaped* make their way through the system, courts themselves may have to decide whether Internet transmissions constitute publications for all purposes, including country of origin. The option of allowing the word to mean different things in different contexts may provide enough space to reach desirable outcomes without having to simply wish away undesirable collateral consequences.

V. Conclusion

Publication remains an elusive concept, despite two centuries of case law and a statutory definition of thirty years' standing. Its importance, though diminished in some respects since 1978, nevertheless remains; indeed, with respect to Internet uses in particular, publication has taken on new significance. Standard articulations of the meaning of publication leave many gaps and inconsistencies, however. In this article, I have attempted to reconcile the conflicting strands as well as possible, and to suggest a new way of thinking about publication that would enable courts to apply somewhat different criteria, depending upon the precise context at issue. Experience may suggest further refinements as technology continues to develop. At present, however, avoiding the one-word-one-meaning fallacy may be the best of many imperfect options for applying a publication criterion that is both reasonably predictable and that avoids undesirable results.