REREADING A CANONICAL COPYRIGHT CASE: THE NONEXISTENT RIGHT TO HOARD IN FOX FILM CORP. V. DOYAL

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Shane D. Valenzi

Do copyright owners have the right to hoard their creative works? The right to exclude on an individual basis is the keystone of copyright law, yet using copyright protection to prevent all public access to a work runs counter to the very premises upon which copyright law is based. This right to exclude the world from use of a creative work—referred to as the right to “hoard” by Justice O’Connor in *Stewart v. Abend*, is commonly traced to a Lochner-era tax case: *Fox Film Corp. v. Doyal*. This Article examines the right to hoard and its origins in *Fox Film*, concluding that no such right can be properly read into the language of the case, and that the right to hoard in copyright law in fact remains an open question. Next, this Article examines the compatibility of the right to hoard with both Lockean property theory and the economic utilitarian theory that underlies copyright law, ultimately concluding that both theories emphatically reject the possibility of an authorial right to hoard. Finally, this Article posits a purely judiciary correction that could effectively eliminate the right to hoard on a domestic level without necessitating a change in the Copyright Act, as well as a potential international restriction on the right to hoard through an expansion of the appendix to the TRIPS Agreement.
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Copyright is an exclusionary right.\(^1\) It does not grant an affirmative right for a copyright owner to use his work; rather, it protects a copyright owner’s right to exclude others from the work.\(^2\) In the United States, granting this exclusionary monopoly is done for the benefit of the public, in the hope that granting authors exclusive economic control over their creative output will provide the necessary incentive for more authors to create and distribute more works to the public.\(^3\) Any benefit to an author is secondary, and rewarding an author for his creative labors is only for the benefit of

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\(^{1}\) E.g., Fox Film Corp. v. Doyal, 286 U.S. 123, 127 (1932).  
\(^{2}\) E.g., id.  
\(^{3}\) E.g., id. at 127–28.
the public, not as a means to an end itself. This “public benefit” rationale, coupled with an owner’s right to exclude others for a limited time, makes copyright law similar to patent law in both theory and practice. Ultimately, both copyright and patent law are statutory rights created by Congress, and can be modified by that body at will.

Each of the above propositions is a building block of scholarly discourse on copyright law. Scholars and judges have written extensively about each in turn. Some propositions, like the public benefit rationale underlying copyright law, are not particularly controversial. Others, like the interchangeability of copyright and patent law, are more hotly debated. But all of these propositions appeared in a single Lochner-era Supreme Court case whose citation count continues to increase exponentially with each passing year: Fox Film Corp. v. Doyal. Despite the age of this Depression-era case, Fox Film has been cited far more often in the past two decades than it ever was when the decision was fresh, most often for the proposition that copyright rewards the labor of authors in order to benefit the public.

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4 E.g., id. at 127.
5 E.g., id.
6 E.g., id.
7 See, e.g., Mazer v. Stein, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’”); Alina Ng, When Users Are Authors: Authorship in the Age of Digital Media, 12 VAND. J. ENT. & TECH. L. 853, 868–69 (2010) (“Copyright law has conventionally aimed to provide enough economic incentive for authors to encourage the creation of literary and artistic works for public benefit.”).
8 Compare, e.g., Mazer, 347 U.S. at 217 (“Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself.”), with eBay, Inc. v. MercExchange, L.L.C., 547 U.S. 388, 392 (“Like a patent owner, a copyright holder possesses ‘the right to exclude others from using his property.’” (citing Fox Film, 286 U.S. at 127)).
9 Fox Film, 286 U.S. at 127–28.
10 E.g., Sony Corp. of Am. v. Universal City Studios, 464 U.S. 417, 429 (1984); see also infra text accompanying note 87.
But *Fox Film* has increasingly stood for another proposition, one barely found in the text of the case itself: An author has the right to hoard his copyright and exclude the work from the public for the full term of copyright protection.\textsuperscript{11} Why an author would want to remove public access to his work could be moral in nature (i.e., an author may be dissatisfied with the quality of his work) or economically motivated (to increase demand of that work or another, related work, or to prevent reputational harm which could translate to decreased profitability). Two real-world examples may be instructive:

First, and perhaps most famously, Disney’s 1946 live action-animated mash-up *Song of the South* has not been available to the public in any form since 1986; despite its iconic song “Zip-ah-dee-doo-dah” and its preservation in Disney World’s Splash Mountain ride, the film itself was protested at the time it was released as being overtly racially offensive, and has been buried in the ominous “Disney Vault” for more than two decades.\textsuperscript{12} Based on the Uncle Remus stories of Joel Chandler, complaints from the NAACP during the 1940s that the film depicted an “idyllic slave-master relationship” and stereotyped “tar baby” sequences, among other controversial content, has discouraged Disney from releasing the film to the public in any form.\textsuperscript{13} Most born after 1980 or so have likely never seen the film, and those who have seen it likely did so via unlicensed and technically infringing means.\textsuperscript{14}

\textsuperscript{11} *E.g.*, Stewart v. Abend, 495 U.S. 207, 228–29 (1990) (“But nothing in the copyright statutes would prevent an author from hoarding all of his works during the term of the copyright. In fact, this Court has held that a copyright owner has the capacity arbitrarily to refuse to license one who seeks to exploit the work.” (citing *Fox Film*, 286 U.S. at 127)).
\textsuperscript{12} See John Lingan, *Bristling Dixie*, SLATE (Jan. 4, 2013, 11:36 PM), http://www.slate.com/articles/arts/books/2013/01/song_of_the_south_disney_s_most_notorious_film_by_jason_sperb_reviewed.html;
Another less familiar example concerns the script to Leonard Bernstein’s Candide. Based on Voltaire’s novel of the same name, esteemed playwright Lillian Hellman penned the original script for the 1956 Broadway premiere. This script is unavailable to modern companies and audiences, however; anyone wishing to mount a new production of Candide is limited to either the Harold Prince-produced revival from the 1970s (with a new script by Hugh Wheeler) or the late 1990’s Royal National Theatre Revival (with an even newer script by John Caird). While the later revivals were modestly successful, the original Broadway production was a flop that reviewers blamed on Hellman; as a result, Hellman insisted that her name be removed from all future productions and refused to license her script to anyone for performance, such that today few theatergoers know the script ever existed.

For years, a rumor persisted that Bill Cosby had purchased the rights to Song of the South and The Little Rascals in order to prevent the films from being shown anywhere due to their objectionable depiction of African American stereotypes. While this behavior would have been perfect for the subject of this Article, these rumors are, sadly, untrue. See, e.g., Barbara Mikkelson & David P. Mikkelson, The Little Rascals, SNOPES.COM, http://www.snopes.com/radiotv/tv/rascals.asp (last updated Aug. 8, 2007); Mikkelson & Mikkelson, supra note 13.

17 See Brooks Peters, Making Your Garden Growl: Lillian Hellman and Candide, OPERA NEWS (July 2000), available at http://www.sondheimguide.com/Candide/writings12.html ("Hellman’s contribution was whittled down until there was nothing left of her own work. By the time Hal Prince revived the show in the ’70s with a circus-like theme, in a small Brooklyn theater, Hellman was fed up with Candide. She
Can these authors (one an institutional author, the other a flesh-and-blood author) hoard their creative works in this manner once they have been released to the public? Should they? A “hoarding” right may be facially implied under the language of the 1976 Copyright Act, but both scenarios in which such hoarding could occur seem to be at odds with the underlying “public benefit” rationale of the Act. Allowing an author to restrict public access based on quality concerns does not have a place in the economic-rights foundation of the statutorily created right, and allowing a third party to restrict access during the full term of copyright protection would restrict the spread of new expression to the public.\(^{18}\) And yet, relying on Fox Film as precedent, courts (in dicta) and commentators have affirmed such a hoarding right without discussion.\(^{19}\)

This Article will trace the origins of the “right to hoard” in copyright law, concluding that, where such a right was asserted by the judiciary, it was done so through a misapplication of the questionable precedent of Fox Film. Part I will examine the actual Fox Film case and decision in detail, concluding that the “right to hoard” language was mere dicta intended to emphasize that copyright was an individual right granted by Congress and was not itself a federal instrumentality. Part I will then trace the development of the “right to hoard” precedent by examining the

\(^{18}\) See U.S. CONST. art 1, § 8, cl. 8; cf Zohar Efroni, A Momentary Lapse of Reason: Digital Copyright, the DMCA and a Dose of Common Sense, 28 COLUM. J.L. & ARTS 249, 275 (“[S]ince accessing a work is an act not equivalent to any of the section 106 exclusive rights, . . . copyright law does not secure to authors’ [sic] an access control right.”).

\(^{19}\) See, e.g., Stewart, 495 U.S. at 228–29; Peter M. Boyle, Penelope M. Lister, J. Clayton Everett, Jr., Antitrust Law at the Federal Circuit: Red Light or Green Light at the IP-Antitrust Intersection?, 69 ANTITRUST L.J. 739, 748 (2002) (“The patent and copyright laws confer upon patent and copyright owners, respectively, the right to refuse either to license or sell products embodying the protected invention or work. . . . The right to refuse to license one’s patents or copyrights or to sell patented or copyrighted products follows inherently from the right to exclude. And the courts, including the Supreme Court, have found as much.” (citing Fox Film, 286 U.S.C. at 127)).
historical evolution of cases and commentaries citing to *Fox Film*, taking special note of other landmark cases in developing the modern precedent (particularly *Stewart v. Abend*). Part II will conclude that interpreting *Fox Film* as evincing the right to hoard is an incorrect reading of the case. Part III will examine the right to hoard normatively by 1) properly framing the right as a blanket exclusion of the public following first publication, 2) analyzing the right to hoard from a copyright-as-property perspective, and 3) reconciling the normative view with the existing caselaw on the issue. Part III will conclude that such a right to hoard, properly cabined, should not exist, as it is fundamentally inconsistent with the constitutional and legislative theories underlying copyright law. Finally, Part IV will consider the practical implementation of eliminating the right to hoard, recommending both a domestic solution (encouraging courts to utilize the “judicially imposed royalty” option of *eBay*) and an international solution (the expansion of the compulsory license for creative works extended to developing countries in the Paris Convention).

I. An Introduction to *Fox Film* and Its Citation History

A. *Fox Film* in Proper Context

*Fox Film* is a tax case. In the 1932 Supreme Court decision, the titular plaintiff challenged the State of Georgia’s ability to tax its gross revenue earned from licensing copyrighted films, arguing that copyright was an instrumentality of the federal government, and therefore immune from state taxation. In the third paragraph of a ten-paragraph opinion, Justice Hughes introduced the constitutional and statutory foundations of copyright law, noting that it was based on the Progress Clause of the Constitution, that any production protected by copyright was owned by an author and not the United States, and that the copyright itself was the product of a federal

20 Fox Film Corp. v. Doyal, 286 U.S. 123, 126–27 (1932).
statute; that is, Congress created a right, rather than sanctioning a preexisting one.21 Hughes goes on to explain the exclusive rights granted to an author under the then-current Copyright Act of 1909, naming the “exclusive right for a limited period to multiply and vend copies,” in particular.22 Justice Hughes makes a point of noting that the United States had no interest in the production, exercise, or use of a copyright itself, and that Congress did not provide that the gains of the exercise (i.e., licensing or sale) of a copyright should be “free of tax.”23

Immediately following this point Hughes added the sentence that provided the foundation for the right to hoard: “The owner of the copyright, if he pleases, may refrain from vending or licensing and content himself with simply exercising the right to exclude others from using his property.”24 In the next sentence, Hughes summarized the purpose of US copyright law in the most cited assertion of the case: “The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors.”25 To conclude this single paragraph that would later prove to be a powerhouse for future citations, Hughes notes that copyright law, like patent law, functioned essentially as an exchange of benefits between the public and a creator: the public grants the creator the benefit of a copyright or patent in exchange for the public benefit conferred by such creation or invention, and to incentivize future creation and invention (which would, presumptively, also be shared with the public).26

The remaining seven paragraphs introduced the principle that a federal instrumentality cannot be taxed by a state, then

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21 See id. at 127 (citing Wheaton v. Peters, 33 U.S. 591, 661 (1834)).
23 Id.
24 Id.
25 Id.
26 See id. at 127–28.
clarified that, because the United States did not own the copyright at issue (or, in fact, any copyright whatsoever), the copyright itself as the property of a private party was subject to state taxation.\(^{27}\)

Hughes analogized ownership of a copyright to property purchased under US public land laws (which is not taxable when owned by the US but becomes taxable as soon as the land changes hands and a private party purchases it).\(^{28}\) The only hint as to why Justice Hughes elaborated on the scope of what a copyright owner may do with his rights in the context of the tax issue at issue in the case comes in the final three sentences of paragraph eight which are rarely, if ever, cited:

> After the copyright has been granted, the government has no interest in any action under it save the general one that its laws shall be obeyed. Operations of the owner in multiplying copies, in sales, in performances or exhibitions, or in licensing others for such purposes, are manifestly not the operations of the government. A tax upon the gains derived from such operations is not a tax upon the exertion of any governmental function.\(^{29}\)

Far from asserting an affirmative right to hoard, then, Justice Hughes’ intent was more likely to extrapolate an extreme use of a copyright owner’s right to exclude in order to illustrate the federal government’s complete lack of interest in the private exercise of a copyright. Justice Hughes concludes the opinion with an assertion that patents and copyrights work more or less the same, and overrules a prior Supreme Court case holding that states could not tax patent royalties.\(^{30}\)

\(^{27}\) See id. at 129 (“[T]he mere fact that a property right is created by statute to fulfill a governmental purpose does not make it nontaxable when it is held in private ownership and exercised for private advantage.”).

\(^{28}\) See id.

\(^{29}\) Id. at 130.

\(^{30}\) See id. at 131 (“[I]n this aspect royalties from copyrights stand in the same position as royalties from the use of patent rights, and what we have said as to the purposes of the government in relation to copyrights applies as well, mutatis mutandis, to patents which are granted under the same constitutional authority to promote the progress of science and useful arts. The affirmance of the judgment in the instant case cannot be reconciled with the decision in Long v. Rockwood, upon which appellant relies, and, in
A few takeaways from the full case analysis are instructive. First, the “right to exclude” language is inarguably dicta; it has very little to do with the actual issue of the case other than as a hypothetical example of the federal government’s lack of interest in private exercise of a copyright. Second, substantially more language (that has generated substantially more citations) in the case is devoted to the “public benefit” rationale of copyright protection being paramount over authorial reward or control, a principle that seems to be at odds with a draconian right to exclude. Finally, Justice Hughes explicitly characterized copyright as a property right of the author, and made no distinction between an intellectual property right and a real property right, which may help to explain his willingness to include a total right of exclusion as part of the statutorily granted rights of a copyright owner (due to the preeminence of the right to exclude in real property law).31

Despite these takeaways, Fox Film is still primarily (and exclusively) a classic Lochner-era case, limiting federal power (to prohibit state tax on federal instrumentalities) and championing personal autonomy and minimal federal involvement in both state and personal affairs.32 The following section will trace the historical treatment of the case, and, in particular, how the case evolved from being solely about state taxation power to something else entirely.

B. The Citation History of Fox Film

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31 See id at 127 (“The production to which the protection of copyright may be accorded is the property of the author and not of the United States.”); id at 128–29 (analogizing a copyright owner’s property right to both the property rights of a recipient of a US land grant and the authorized discoverer of minerals on US land).

32 See Robert Post, Federalism in the Taft Court Era: Can It Be “Revived”?, Duke L.J., 1535 (arguing that the Court at constructed at the time it decided Fox Film evinced “increasingly anxious efforts to maintain the spheres of federal and state power as distinct and mutually exclusive.”)
Courts, treatises, and law review articles have cited *Fox Film Corp. v. Doyal* for more than a half-dozen unrelated propositions. Following the Supreme Court’s citation to *Fox Film* in *Stewart v. Abend* in 1990, however, the case has enjoyed a renaissance in relevance—over 80 percent of law review citations to the case come after 1990. This Section will examine the treatment of *Fox Film* by the Supreme Court, circuit, district, and state courts, and legal commentators from the year of the decision (1932) to the present day, organized into three discrete periods of time: 1932–1956 (the “tax” era), 1957–1990 (the “pre-*Stewart*” era), and 1990–2012 (the “post-*Stewart*” era).

1. The Tax Era (1932–1956)

For the first twenty four years following the decision, neither the Supreme Court nor a single legal commentator referenced *Fox Films* as evincing the right to exclude. The Supreme Court cited *Fox Film* eleven times from 1932–1954, eight of which were to reiterate the holding of the case—that a private privilege extended by the federal government is not a federal instrumentality and thus is not exempt from state tax. 1945 marked the Court’s first departure from the purely tax holding of the case, where *Fox Film* appeared as part of a string cite in *Special Equipment v. Coe* to support the proposition that the failure of a patentee to use a patented invention doesn’t affect the validity of a patent. The Court laid the groundwork for treatment of *Fox Film* as a copyright case in 1948 in *United States v. Paramount Pictures*, an antitrust case holding that block-booking (the practice of film producers conditioning a license to display a popular film at a movie theater on that theater also

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33 *See supra* notes 1–6.
34 *Stewart v. Abend*. As of March 4, 2013, WestLaw lists 514 law journal articles referencing *Fox Film*, with 80 percent of those citations occurring after 1990. A Lexis search for the same citation reveals 406 citing references to the case, with 90 percent occurring in or after 1990.
35 *Supra* note 34.
36 *See, e.g.*, *Broad River Power Co. v. Query*, 288 U.S. 178, 180 (1933).
licensing a less popular film at a similar rate) was an improper enlargement of a copyright monopoly. The Court cited Fox Film in support of the assertion that the purpose of copyright is primarily for the benefit of the public, and any benefit to the author is a secondary consideration at best. Citing the “labor of authors” language of Fox Film, Paramount would prove to be the case that kept Fox Film alive in the public conscious for future references, as the same labor of authors language would appear again (often with reference to Paramount as well as Fox Film) in eight of the eleven Supreme Court decisions between 1948–2012 citing the case.

Similarly, the legal commentary on Fox Film from 1932–1956 is focused on tax. More than a dozen articles published in those years reference Fox Film only for its tax implications, and the small handful that do not instead use Justice Hughes’ casual overruling of Long v. Rockwood as a discussion point for the Supreme Court’s practice of overruling cases. The notable exception to this trend, and the first commentary directly addressing the issue of this Article, appeared in a Note in the Columbia Law Review in 1956, where, in a piece on parody and infringement, the author digressed (in a footnote):

The constitutional justification for the right of [a] non-user is not as obvious as that for economic rights. Indeed, the proposition that the arts are promoted by the permissive stifling of artistic works, even by their creators, seems paradoxical. The apparent inconsistency is minimized when it is considered that if this right were denied, and the author was not permitted to prevent publication of works he thinks are unworthy of perpetuation, artistic integrity and pride

38 See 334 U.S. 131, 143 (1948).
39 Id. at 158.
40 See, e.g., Eldred v. Ashcroft, 537 U.S. 186, 231 (2006); Mazer v. Stein, 347 U.S. 201, 214 (1954). Of the three cases citing Fox Film, but not for the “labor of authors” language, two of them (Stewart v. Abend and eBay v. MercExchange, LLC) will be discussed in greater detail in Part I.B.3 for their assertion of the author’s right to exclude. The third case, Nat’l League of Cities v. Usery, is another tax case. 426 U.S. 833, 866 (1976).
41 See, e.g., Note, Constitutionality of State Privilege Tax on Cotton Brokers, 43 YALE L.J. 337, 339 (1933).
would suffer and, as a result, authors would be discouraged from producing. To those authors for which the non-economic spurs to creation are the greatest, this right to protect one's artistic reputation would be particularly valuable and effective in encouraging creativity.43

This particular student author was far ahead of the time, however, as the right to exclude would not appear in commentary again until 1979,44 and wouldn't appear outside the narrow context of a footnote to a student note in the Columbia Law Review until after the Sony v. Universal decision in 1984.45

Lower courts were more varied in their use and understanding of Fox Film. Twelve of seventeen circuit court decisions citing Fox Film at this time still did so purely for its tax holding,46 while two of the remaining five noted that an inventor's nonuse47 or absolute exclusion of the public48 would not compel the loss of patent rights. Of the remaining three decisions, one was a post-Paramount decision that cited the soon-to-be-ubiquitous “labor of authors” language;49 the other two dealt with a copyright owner’s rights more directly. Interstate Hotel Co. v. Remick Music Corp. cited Fox Film for the proposition that copyright owners may exercise either the right to publish and vend their work, the right to publicly perform their work, or both.50 Notably, the case did not mention an owner’s right to exercise neither right. More directly, Leon v. Pacific Telephone & Telegraph Co., in an opinion delivered five years after

43 Parody and Copyright Infringement, 56 Colum. L. Rev. 585, 588 n.12 (1956).
44 See Celia Goldwag, Copyright Infringement and the First Amendment, 79 Colum. L. Rev. 320, 339 n.122 (1979). The fact that the only two on-point commentaries on the issue prior to the Sony case both appeared as footnotes to student notes in the same journal appears to be coincidental, as the later Note does not cite the earlier Note.
45 See infra Part I.B.3.
46 E.g., Buckley v. Comm. of Internal Revenue, 66 F.2d 394, 396 (2d. Cir. 1933).
47 Hartford-Empire Co. v. Obear-Nester Glass Co., 71 F.2d 539, 566 (8th Cir. 1934).
48 Special Equipment Co. v. Coe, 144 F.2d 497, 502 n.3 (D.C. Cir. 1944).
50 157 F.2d 744, 745 (8th Cir. 1946)
Fox Film, cited the case for the proposition that a unique arrangement of copyrighted material was not a permissible fair use merely because the holder of the copyright had not used (that is, arranged) it in that manner.51

Published district court decisions citing Fox Film in this time period were much more varied (and rare) in their uses of the case. In fact, fewer than a dozen published district court decisions during this time cited to Fox Film at all, and four of them did so in support of a copyright owner’s right to exclude.52 In Buck v. Hillsgrove Country Club, the court struck two paragraphs from a plaintiff’s complaint that ASCAP impermissibly violated antitrust laws and cited Fox Film as part of a collection of cases demonstrating that Congress failed to insert any explicit limitations on a copyright owner’s right to exclude.53 Paine v. Electrical Research Products permitted a manufacturer of equipment to play music during silent films to avoid payment on a contract with a music agent where the agent’s clients didn’t actually own the foreign distribution rights the manufacturer was paying for; Fox Films was used to support the court’s assertion that the agent’s clients need not have licensed their work at all, concluding that since they did, their representations must be accurate to compel payment under the contract.54 Loew’s, Inc. v. CBS contained a fact pattern similar to Leon and, as it was a district court case located within the Ninth Circuit, both relied on Leon as precedent and cited Fox Film for the same proposition.55 Finally, Inge v. Twentieth Century-Fox Film Corp. used the right to exclude

51 See 91 F.2d 484, 487 (9th Cir. 1937). The subject matter at issue in Leon was the arrangement of names in a phone book, famously held to be noncopyrightable more than fifty years later in Feist Publications v. Rural Tel. Svs. Co., Inc. 499 U.S. 340, 362 (1991) (citing the Leon court as having “misunderstood the [1909 Copyright Act]”). Because Feist rendered the subject matter of Leon uncopyrightable, but did not disturb the holding of Leon concerning the use (or lack thereof) of copyrighted material in the abstract, the reasoning of the Leon court is still relevant to the analysis in this Article.
52 See infra notes 53–56.
language from *Fox Film* immediately following an assertion of the plaintiff’s affirmative right to license his copyright, likely to indicate that the plaintiff, the copyright owner of a play, had the right to license or not license the right to make a film version of the play to defendants at will. Additionaly, nearly every published state case citing *Fox Film* in this era did so to support a similar tax holding.

The principal takeaway from this era of jurisprudence is that for more than two decades following the *Fox Film* decision, the overwhelming majority of decisions citing to the case treated it exclusively as a tax case. In those rare occurrences where the right to exclude was cited, it was done so 1) in dicta and 2) as part of a general affirmance of the scope of a copyright owner’s monopoly power, without any treatment or thought of what impact the exertion of a blanket right to exclude would have on the public.

2. The Pre-Stewart Era: 1957-1989

The arbitrary separation of analysis following 1956 does not follow a particular case of consequence; rather, 1956 marks a natural break in jurisprudence citing the case itself. The Supreme Court did not cite *Fox Film* from 1954–1962, no circuit court cited the case from 1950–1968, and no district court cited the case from 1956–1975. No state case cited *Fox Film* from 1956–1961. And only nine law review articles cited *Fox Film* from 1956–1979 (compared to seventy-eight articles from 1979–1990 and 413 from 1990-2012). The reasons for this lull may be temporal; the case

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56 See 143 F. Supp. 294, 298 (S.D.N.Y. 1956). Licensing the derivative right, particularly as regards “versioning,” may contain a special protection that licensing other rights do not have; see *supra* Part III.C.
60 These numbers reflect the citation references WestLaw and Lexis associate with *Fox Film*, organized by date.
would have been nearly thirty years old, and slowly replaced with more recent precedent. More interesting than its waning lack of influence with the passage of time is the case’s sudden resurgence as precedence. It was a series of fortuitous and influential citations that reversed the case’s seemingly inevitable path to obscurity.

First, the “labors of authors” language was revived by the Supreme Court in 1975 in *Twentieth Century Music Corp. v. Aiken*, which held that a radio broadcast in a restaurant did not constitute a public performance, and has become standard reading for students of copyright law.61 Although the next citation following *Aiken* was, again, a tax case,62 the Court revisited *Fox Film* extensively in *Sony Corp. of America v. Universal City Studios, Inc.*63 The Court, tasked with determining the legality of time-shifting devices (i.e., VCRs), and ultimately holding that VCRs had the potential for “substantial non-infringing uses,” which precluded a finding of contributory infringement,64 also revisited nearly ever pertinent judicial interpretation of *Fox Film* along the way. The majority quoted the language from *Paramount*, which was actually Justice Hughes’ language from *Fox Film*, noting that reward to authors is merely a secondary consideration of copyright law.65 The majority also quoted from *Aiken*, which in turn quoted *Fox Film*’s “labor of authors” language.66 Further, *Fox Film*’s tax-related holding is cited to support the proposition that “[Copyright] protection has never accorded the copyright owner complete control over all possible uses of his work.”67 Finally, the Court relies on *Fox Film* as an example of the “historic kinship” between patent and copyright law

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64 *Id.* at 456.
65 *Id.* at 429.
66 *Id.* at 432.
67 *Id.* at 432 n.13.
as a precursor to justifying the importation of the "substantial noninfringing uses" doctrine from patent jurisprudence.68

However thorough the majority's treatment of the case, Blackmun's dissent actually provides what would later become the majority reading of Fox Film. Citing it first for the carefully stated proposition that "[t]he monopoly created by copyright thus rewards the individual author in order to benefit the public,"69 and thereby emphasizing the individual reward over the public benefit, Blackmun later uses Fox Film to support his contention that "[c]opyright gives the author a right to limit or even to cut off access to his work."70 This extension of Fox Film was brand new to the Court, but would become codified in the majority opinion (which Justice Blackmun joined) in Stewart v. Abend.71

After Sony, fueled perhaps by Blackmun's dissent, citations to Fox Film as justification for the right to exclude began to manifest for the first time in legal commentary, appearing at least a half-dozen times between Sony and Stewart (1984–1990).72 After Stewart, citations to Fox Film in general skyrocketed, but before examining that decision and its impact on the right to exclude, it is worth pondering: where did the right to hoard argument come from?

The robust defense of an author's right to refuse to license to anyone most likely originated in 1977 with the Authors' League of America and an amicus brief the ALA filed in Rohauer v. Killam Shows, Inc.73 At issue in Rohauer was the grant and renewal of the underlying copyright of a literary work that had been turned into a

68 Id. at 439 & n.19.
69 Id. at 477 (Blackmun, J., dissenting).
70 Id. at 480.
72 E.g., Edward Allan Jeffords, Home Audio Recording After Betamax: Taking a Fresh Look, 36 BAYLOR L. REV. 855, 857 n.16 (1984) (arguing that Sony disagreed with Fox Film's stated right to exclude by noting that an author has no right to exclude fair uses of his work).
73 551 F.2d 484, 488 (2d Cir. 1977); see also Irwin Karp, From Roth to Rohauer: Twenty Years of Amicus Briefs, 25 BULL. COPYRIGHT SOC'Y U.S.A. 1 (1977) (describing the fervor with which the Author's League filed amicus briefs in copyright cases from 1957–1977).
movie. Though the original author had granted the studio both the initial and renewal rights in his work, her daughter (who controlled the renewal rights after the author passed away) refused to re-grant the expiring rights in the underlying literary work used in the already-released film. The Author’s League argued in their brief, according to the Second Circuit, that the “force” of the renewal rights includes the right to refrain from vending or licensing and to exclude everyone from the work. Ultimately, the court disagreed with the plaintiff and the Author’s League, holding that the owner of an underlying right cannot prevent the distribution and exercise of a derivative work based on that right, where the work was initially created with a valid license. This opinion was not cited in the final Supreme Court decision in Sony, but was cited at the circuit court level, suggesting the Sony court was familiar with it. Interestingly, despite the Ninth Circuit’s singling out of the unqualified right to exclude as a key component of the Authors’ League’s argument, the Authors’ League General Counsel at the time delivered a published address to the Copyright Society of the U.S.A. during the Rohauer deliberations specifically about the key arguments in the Rohauer amicus brief, but failed to mention protecting an author’s unqualified right to exclude as any aspect of their argument, much less the most important one. Nevertheless, it is likely that the Authors’ League brief was the first legal document to frame, consider, and advocate for a full authorial right to hoard.

Until 1990, the right to exclude appeared very little in federal jurisprudence generally, and, while the right was usually associated with Fox Film, it was hardly the proposition most associated with the

74 Rohauer, 551 F.2d at 487.
75 Id. at 486–87.
76 Id. at 488.
77 Id. at 494.
78 See Universal City Studios, Inc. v. Sony Corp. of Am., 659 F.2d 963, 972 n.10 (9th Cir. 1981).
79 See Karp, supra note 73 at 16–17.
80 At the very least, it was the first document to gain traction at the federal level, as far as this Author can tell.
case. But in 1990, Justice O’Connor’s majority opinion in *Stewart v. Abend* thrust the right to exclude, and, with it, what could be considered a misreading of *Fox Film* (or, at least, a reading out of context) back into the forefront of legal consciousness. The fact pattern of *Stewart* was similar to *Rohauer*; that is, the heirs of the author of the underlying rights to a film sought to withhold permission for their ancestor’s work to continue to be used in the film once the initial term of copyright had expired. In finding for the plaintiffs (and holding that the creators of a work used in a derivative work still control the underlying rights to the work once the initial grant of rights expires), Justice O’Connor noted in dicta: “Nothing in the copyright statutes would prevent an author from hoarding all his works during the term of copyright. . . . A copyright owner has the capacity arbitrarily to refuse to license one who seeks to exploit the work.” The only cite to support these propositions was, of course, *Fox Film*. Obviously influenced strongly by *Rohauer*, *Stewart* did not explicitly overrule the older case. Though it reached the opposite conclusion regarding control of a derivative work following the expiration of the ownership of rights in an underlying work, Justice O’Connor reframed the holding of *Rohauer* as

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81 Before 1990, *Fox Film* was more often cited for the propositions that 1) copyright is not a federal instrumentality, *e.g.*, Paris, Ky. *v.* Fed. Pwr. Comm’n, 399 F.2d 983, 987 (D.C. Cir. 1968); 2) copyright is designed for the public benefit by rewarding the labors of authors, *e.g.*, Baker-Cammack Hosiery Mills *v.* Davis Co., 181 F.2d 550, 572 (4th Cir. 1950); 3) copyright is a statutory right created by Congress, not a natural right, *e.g.*, Assoc. Film Distr. Corp. *v.* Thornburgh, 683 F.2d 808, 815 (3d Cir. 1982); and 4) patent law and copyright law are closely analogous, and provisions of one body of law can help inform the other body, *e.g.*, Sony Corp. of Am. *v.* Universal City Studios, Inc., 464 U.S. 417, 439 (1984). Even in legal commentary, which is freer to extrapolate meaning, *Fox Film* was just as often used as a discussion point for the principle of stare decisis in the 1930’s as it was as support for the right to exclude between 1932–1990. Compare Sharp, *supra* note 42 (stare decisis), with L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. Rev. 719, 749 (1989) (right to exclude).


83 Id. at 211–15.

84 Id. at 228–29 (citing *Fox Film Corp. v. Doyal*, 286 U.S. 123, 126–27 (1932)).

85 Id.
mandating a balancing of the equities based on the state of the law and the facts of the case, not prescribing a particular result.\footnote{See id. at 209, 227.}

Here, for the first time, was an explicit assertion of an author’s right to hoard. Though never again would such a right be stated so forcefully or eloquently at the Supreme Court level, the assertion would create a new and robust interest in \textit{Fox Film} as relevant precedent for the purposes of copyright law generally, along with the only precedent for a copyright owner’s right to exclude.

\textbf{3. The Post-Stewart Era: 1990–2012}

Following the \textit{Stewart} decision, citations to \textit{Fox Film} exploded. The case is primarily cited for its “labors of authors” language stating that copyright law was crafted by Congress for the benefit of the public; it has been cited more than three hundred times for this proposition in the last twenty years.\footnote{See, e.g., Golan v. Holder, 132 S. Ct. 873, 902 (2012).}  It has been used to support an author’s right to exclude a little over fifty times in that same period—a paltry number in comparison to the public benefit proposition, but exponentially more than the case had ever been used to support such a proposition before \textit{Stewart}.\footnote{These numbers were obtained through searches for citation references to \textit{Fox Film} on both Westlaw and Lexis.}  Clearly, then, the right to exclude is still not the primary use of \textit{Fox Film}, or anything close to it. But the reverse is also true: \textit{Fox Film} is, indeed, the most common citation to support an author’s right to hoard.\footnote{Where the right to exclude is mentioned without a \textit{Fox Film} cite, a citation to the more bombastic language in \textit{Stewart} usually appears in its place. See, e.g., Robert A Kreiss, \textit{Accessibility and Commercialization in Copyright Theory}, 43 UCLA L. REV. 1, 5 (1995) (citing \textit{Stewart} for the right to exclude, but not \textit{Fox Film}).}

At the Supreme Court level, \textit{Fox Film} has become a go-to citation for copyright cases. \textit{New York Times v. Tasini},\footnote{533 U.S. 483, 519 (2001).} \textit{Eldred v. Ashcroft},\footnote{537 U.S. 186, 231 (2003).} and \textit{Golan v. Holder}\footnote{132 S. Ct. 873 (2012).} all cite \textit{Fox Film} for its “labors of...
authors” language. Most importantly for the purposes of this analysis, eBay v. MercExchange, though technically establishing an analysis to determine the remedy for patent infringement, has since been extended in full to copyright infringement remedies, and cited Fox Film for the right to exclude.

The trend extends to courts of appeals as well; following Stewart, the right to exclude picked up dramatically at the circuit court level, often citing both Stewart and Fox Film. The right is not always treated favorably, either. In Data General Corp. v. Gramman Systems Support Corp., the First Circuit parsed the language in both Fox Film and Stewart, emerging with three key conclusions: 1) a copyright owner may refrain from vending and licensing because the Congressionally created system promotes consumer (i.e., public) welfare by encouraging investment; 2) although nothing in the Copyright Act itself would prevent hoarding (citing the Stewart language), nothing would prevent other acts of Congress from preventing that sort of activity, and the Sherman Act in particular could prevent hoarding where a monopolist harms consumers by refusing to license a copyrighted work to a competitor; and 3) a copyright owner’s unilateral refusal to license a copyright to a particular entity should be considered a “presumptively valid business decision” for the purposes of the Sherman Act, with the burden on the rejected licensee to prove anticompetitive practices.

Though the Data General decision is narrow in scope, and ultimately

93 See, e.g., Salinger v. Colting, 607 F.3d 68, 77 (2d Cir. 2010) (“We hold today that eBay applies with equal force (a) to preliminary injunctions (b) that are issued for alleged copyright infringement.”).
94 547 U.S. 388, 392 (2006) (“Like a patent owner, a copyright holder possesses ‘the right to exclude others from using his property.’” (citing Fox Film Corp. v. Doyal, 286 U.S. 123, 126–27 (1932))).
95 E.g., Orson v. Mirimax Film Corp., 189 F.3d 377, 390 (3d Cir. 1999) (citing Stewart and Fox Film for the proposition that a copyright owner has the capacity to refuse to license); Image Tech. Svs. v. Eastman Kodak Co., 125 F.3d 1195, 1215 (9th Cir. 1997) (noting that a copyright holder may refuse to sell or license the work, but applying the concept to patent law only, and relying on patent-exclusive citations in addition to Stewart and Fox Film).
96 See Data General Corp. v. Gramman Sys. Support Corp., 36 F.3d 1147, 1186–87 (1st Cir. 1994).
97 Id.
favored a copyright owner’s refusal to license, it set statutory limitations on the right (at least in the First Circuit), which underscores the greater point that a copyright owner’s right to exclude is far from natural or moral; it is based on a purely economic concern.

From its roots as a tax case, *Fox Film* has through a series of fortuitous citations (Paramount, Rohauer, Sony, Stewart, and eBay, in particular) reemerged and reinvented itself as a bulwark of copyright theory and policy. The unfettered right to exclude, in particular, after lying unnoticed for over half a century, emerged almost overnight as one of the central holdings of the case. But such a characterization is not necessarily fair. It is unlikely nearly sixty years of judges and scholars erred by failing to ascribe the “right to hoard” to the case before Justice O’Connor’s bit of dicta. The next Part will analyze this proposition in more detail; that is, it will argue why interpreting *Fox Film* as asserting the right to hoard is an improper reading of the case.

II. WHY *FOX FILM* DOES NOT SUPPORT A MODERN RIGHT TO HOARD

Citing *Fox Film* to support copyright owners’ rights to refuse to license their works has become common, even by esteemed copyright scholars. But is such a leap of understanding justified? This Part argues that no, it is not.

First, the right to exclude is dictum from the case. It bore no bearing on the essential holding that copyright is not a federal instrumentality and thus not exempt from state tax. A proper understanding of its presence in the opinion can be found in the (winning) Appellee’s Brief, which used the right to exclude only as

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98 *See, e.g.,* Daniel J. Gervais, *The Internationalization of Intellectual Property: New Challenges from the Very Old and the Very New, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L. J. 929, 977 (“Copyright in its most traditional form is illustrated in Fox Film Corp. v. Doyal, in which the Supreme Court stated, ‘The owner of the copyright if he pleases may refrain from vending or licensing, and content himself with simply exercising the right to exclude others from using his property.’” (footnote omitted)).
evidence that imposing a tax did not abrogate a copyright owner’s statutorily granted rights:

A tax on royalties paid under a license from the owner of a copyright . . . interferes only indirectly and remotely with the copyright, the franchise granted by the government. It lessens to some extent the amount of income which the owner of the copyright would otherwise receive from it, but it does not diminish the right given by the United States to exclude others from “making, using, or vending the thing” copyrighted. That right is just as full and complete with the tax as without it. The tax does not make the privilege less exclusive.99

The Court was not expounding on or analyzing the limits of the right to exclude in any way; this would have been overreaching. Rather, the Court was simply attempting to restate the law as it currently existed (under the Copyright Act of 1909) in order to emphasize that a state tax on royalties would not alter the fundamental character of the rights themselves. Under the Copyright Act of 1909, a copyright owner (specifically, “any person entitled thereto, upon complying with the provisions of this Act”) had “the exclusive right . . . to print, reprint, publish, copy, and vend the copyrighted work,” as well as the exclusive rights of translation and public performance.100 In addition, an “author” (as opposed to “any person entitled thereto . . .”) of an unpublished work retained a full common-law right “to prevent the copying, publication, or use of such unpublished work without his consent . . . .”101 The implication, therefore, is that there exist some circumstances in which the owner of a copyright may not exercise his right to exclude (specifically, the statute was likely referring to compulsory licensing of mechanical reproductions of music102) and, further, that the owner of a published work had no common-law right to exclude. At any rate, the contours of these rights are not closely examined by the Court,

99 Brief for Appellee, Fox Film Corp. v. Doyal, 1932 WL33528, *18 (emphasis added).
101 Id. § 2, 35 Stat. at 1076.
102 Id. § 1(e), 35 Stat. at 1075–76.
nor would it have been appropriate to do so, as the right to exclude was only mentioned to emphasize that a state tax would not affect the right one way or the other.

Further, the only support the Court cites for the right to exclude is a patent case from 1908: *Continental Paper Bag Co. v. Eastern Paper Bag Co.* Continental Paper Bag held, broadly, that unreasonable nonuse was not a qualifier of the ability of an inventor to exercise his right to exclude others from his invention during the patent term. Tracing the equitable remedy to patent infringement back to 1819, the Court explicitly rejected the argument that an inventor has a "sort of moral obligation" to make the invention available to the public as quickly as possible, noting that the monopoly was "only for a few years." Driving the property argument home, the Court declared that "patents are property, and entitled to the same rights and sanctions as other property" and analogized patent infringement to a trespass. Finally, the Court reached no holding as to whether a future court, in view of the public interest, might withhold injunctive relief for such an infringement.

This case is wholly irrelevant to a modern copyright system. Not only does the case fail to mention copyright once, even if it had it would have been citing a copyright act from 1870 (albeit with several more recent amendments). With two complete overhauls of the system since then (along with numerous small-scale revisions), a 1908 patent case can hardly serve as proper precedent for such a squirrely interpretation of a copyright owner’s right to exclude. Further, the breadth of the right to exclude granted to the patentee depended (and still depends), in the words of the Court, on public disclosure.

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103 210 U.S. 405, 422, 424 (1908).
104 *Id.* at 424, 428.
105 *Id.*
106 *Id.* at 425.
107 *Id.* at 430.
via a patent rather than relying on trade secret protection, which
would deny all public disclosure as long as the invention remained
secret. No such dichotomy or incentive exists within copyright law.
Whereas common law copyright in unpublished works existed at the
time of Continental Paper Bag and still existed under the Copyright
Act of 1909, no such separate protection of unpublished works exists
under modern copyright law; the law protects all eligible work
equally, whether it is made available to the public or kept secret and
unpublished. The analogy between the two systems, therefore, is
strained and the disadvantages of public exclusion are not as
justifiable where the need to incentivize public disclosure is absent.

Finally, the age of Fox Film and the state of the law at the time
it was decided is highly relevant. The fact that Fox Film preceded the
current Copyright Act does not, on its face, make the precedent
obsolete; plenty of pre-1976 case law remains of vital importance to
the current copyright scheme. But certain aspects of the law
relating to the alienability of rights under the 1909 Act are treated
very differently under the 1976 Act, making analogies to the modern
day system more problematic. First, authors under the 1909 Act
were not free to sell their rights separately to one or more third
parties, as they are today. Rather, an author at the time Fox Film
was decided was obligated to either sell all of the exclusive rights
granted by a copyright to a single third party or decline to sell any of
them, making such a refusal one of only two options, and therefore a
more commonly exercised activity of a copyright owner at the

110 Compare 17 U.S.C. § 301(a) (2006) (“[A]ll legal or equitable rights that
are equivalent to any of the exclusive rights within the general scope of
copyright, . . . whether published or unpublished, are governed exclusively
by this title.”), with Act of 1909, ch. 320, § 2, 35 Stat. 1075, 1076 (repealed
1976) (“[N]othing in this Act should be construed to annul or limit the right
of the author or proprietor of an unpublished work, at common law or
equity, to prevent the copying, publication, or use of such unpublished work
without his consent . . . .”)
111 See, e.g., Baker v. Selden, 101 U.S. 99, 103 (1879) (elucidating the idea-
expression distinction in copyright).
time. An author could *license* rights individually; however, the 
licensee had no legal ability to enforce those rights against the 
world. The original author was still obligated to bring suit on 
behalf of the licensee if such rights were infringed. Such a system 
would have made a refusal to license the only palatable option for 
authors who preferred not to grant their *entire* copyrights away and who faced prospective user-distributors who insisted on a transfer 
of rights, rather than a license, in order to maintain the ability to file 
infringement suits on their own behalf.

In addition, the term of copyright is much longer now than it 
was in 1932. Rather than a term of twenty-eight or fifty-six years 
(depending on whether or not the author renewed), modern 
copyright protection subsists for the life of the author plus seventy 
years (raised from life-plus-fifty years in 1998)—if an author created 
a work and died the same day, that copyright would still exist longer 
than the maximum length permissible at the time *Fox Film* was 
decided. As the Court in *Stewart* explained:

> [A]lthough dissemination of creative works is a goal of the 
> Copyright Act, the Act creates a balance between the artist's 
> right to control the work during the term of the copyright

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113 *See* Samuel Spring, *Rights and Rights* 167 (1st ed. 1952) (“Any assignment 
of the copyright is invalid unless all of the bundle of rights is transferred at 
one time . . . . But an assignment of some of the rights included in the bundle 
. . . is invalid and unenforceable [sic], except as a license.”).

114 *See id.*

115 *See id.* at 168.

116 *See id.* (“A licensee therefore can not [sic] sue an infringer in his own 
name for infringements of rights he holds as licensee. The licensor, i.e. the 
copyright proprietor, must sue for him.”).

117 *Compare* 17 U.S.C. § 302(a) (2006) (“Copyright in a work created on or 
after January 1, 1978, subsists from its creation and, except as provided by 
the following subsections, endures for a term consisting of the life of the 
author and 70 years after the author’s death.”), *with* Act of 1909, ch. 320, § 
23, 35 Stat. 1075, 1080 (repealed 1976) (“[T]he copyright secured by this 
Act shall endure for twenty-eight years from the date of first publication . . . 
. And provided further, That . . . the author of such work, if still living, or . . . his 
next of kin shall be entitled to a renewal and extension of the copyright 
in such work for a further term of twenty-eight years when application for 
such renewal and extension shall have been made to the copyright office 
and duly registered therein within one year prior to the expiration of the 
original term of copyright.”).

118 *See supra* note 117.
protection and the public's need for access to creative works. The copyright term is limited so that the public will not be permanently deprived of the fruits of an artist's labors.119

Although the Court was referring to the 1976 Act, rather than the 1909 Act, the principle remains the same. The House Report accompanying the 1909 Act reads something similar: “In enacting a copyright law Congress must consider . . . two questions: First, how much will the legislation stimulate the producer and so benefit the public; and second, how much will the monopoly granted be detrimental to the public?”120 The modern extension of the “limited times” in which a copyright subsists surely reframes the issue. The advent of the internet and digital distribution necessitates a similar reconsideration: once a work is “published” online, what effect would it have on the public to allow an author (or copyright owner) to exclude the public from accessing it?121

Taken together, these factors lead to the conclusion that the Fox Film exclusory right doctrine does not withstand the test of time. A new look at the exclusory right is needed.

III. RECONSIDERING THE RIGHT TO EXCLUDE

A. Reframing the Issue

Tackling a problem as complex as the right to exclude can be unwieldy, and certain avenues of analysis, while fruitful and important within the full scope of copyright law, will not be the focus of this particular Article. A brief mention of each may, however, be worthwhile for future scholarship.

1. Free Expression and the First Amendment

119 Stewart v. Abend, 495 U.S. 207, 228 (1990). For an extension of the “times have changed” argument to Stewart as well, see infra Part IV.A.2.
120 H.R. REP. 60-2222 at 7.
121 See Gervais, supra note 98, at 977–80.
The Supreme Court famously referred to copyright as the “engine of free expression.” Courts have generally used the free expression rationale to justify imposing structured limits on fair use (to assure speakers that their expression will be protected). Commentators often take the opposite view, arguing that the First Amendment should justify tremendous limitations on the right to exclude. There are a “veritable slew” of publications on copyright and the First Amendment, and this Article will not add to them, but to mention that such analysis does not generally touch an author’s right to first publication, and that the First Amendment can usually be used to justify an author’s right to control his own speech (by excluding others from taking it) as equally as it justifies the public’s access to that speech.

2. Antitrust Law

The Supreme Court has recognized the Sherman Act as posing an explicit limit on an author’s right to exclude. At the same time, antitrust law does not provide much of a cudgel against a copyright owner’s unilateral refusal to license; such a decision is presumptively valid under antitrust laws, and a spurned prospective licensee has the burden to prove anticompetitive practices.

123 See id.
126 Compare, e.g., Christina Bohannan, Copyright Harm, Foreseeability, and Fair Use, 85 Wash. U. L. Rev. 969, 990 (2007) (arguing that permitting a copyright owner to suppress expression that conflicts with their view would harm general First Amendment interests), with Christina Bohannan, Copyright Infringement and Harmless Speech, 61 Hastings L.J. 1083, 1149–50 (2010) (“[T]he First Amendment protects [a copyright owner’s] right to develop and refine her own message prior to communicating it to the world as well as the right to decide against communicating it altogether.”). It is coincidental but apt that the same academic author effectively used the First Amendment to argue both in favor of and against the right to exclude in respective Articles.
excluding an owner’s subjective motivation as evidence. Here, again, the ways in which antitrust law may or may not cabin the right to exclude is worthy of a separate analysis that is beyond the scope of this Article, other than to reiterate the point that unilateral refusals to deal are presumed valid under both copyright and antitrust law.

3. Publicity Law

Finally, while a publicity law analysis may be tempting, it is of little use here. Publicity and privacy law exist at common law only, and serve to fill in the gaps where copyright and trademark fail to provide protection. In this case, no such gap exists; under the

128 See In re Indep. Svs. Orgs. Antitrust Lit. (hereinafter Xerox), 203 F.3d 1322, 1329 (Fed. Cir. 2000) (“We therefore reject CSU’s invitation to examine Xerox’s subjective motivation in asserting its right to exclude under the copyright laws for pretext, in the absence of any evidence that the copyrights were obtained by unlawful means or were used to gain monopoly power beyond the statutory copyright granted by Congress.”); Data General Corp. v. Grumman Sys. Support Corp., 36 F.3d 1147, 1187 (1st Cir. 1994) (“[W]e hold that while exclusionary conduct can include a monopolist’s unilateral refusal to license a copyright, an author’s desire to exclude others from use of its copyrighted work is a presumptively valid business justification for any immediate harm to consumers.”). But see id. (“Nevertheless, although ‘nothing in the copyright statutes would prevent an author from hoarding all of his works during the term of the copyright,’ (emphasis added), the Copyright Act does not explicitly purport to limit the scope of the Sherman Act. And, if the Copyright Act is silent on the subject generally, the silence is particularly acute in cases where a monopolist harms consumers in the monopolized market by refusing to license a copyrighted work to competitors.” (internal citation omitted) (quoting Stewart v. Abend, 495 U.S. 222, 228–29 (1990))).

129 For a thorough examination of antitrust and refusals to deal in copyright along with a robust criticism of Fox Film, see Catherine Parrish, Unilateral Refusals to License Software: Limitations on the Right to Exclude and the Need for Compulsory Licensing, 68 BROOK. L. REV. 557 (2002).

130 See Data General, 36 F.3d at 1187. Much scholarship already exists on the intersection of antitrust law and unilateral refusals to deal in the patent context. See Parrish, supra note 129. See generally, e.g., Marina Lao, Unilateral Refusals to Sell or License Intellectual Property and the Antitrust Duty to Deal, 9 CORNELL J.L. & PUB. POL’Y 193 (2002) (arguing that imposing a general antitrust duty to deal on patentees could promote innovation in certain contexts).

131 See MARSHALL A. LEAFFER, UNDERSTANDING COPYRIGHT LAW § 1.14 (2010) (“In addition to these traditional forms of state law protection, the right to publicity represents a relatively new body of law having similarities to both copyright and trademark law.... State protection of intangible property
current copyright scheme and its lack of formalities, all creative works, even unpublished works, are protected by copyright by statute and so an assertion of an individual’s right to privacy would be superseded by whatever protection the Copyright Act provides. While a severe limitation on an author’s right to exclude might create a window for those same authors to make a privacy law argument, such a scenario is far beyond the purpose and scope of this Article.

B. Defining the Discussion: Considering the Unilateral Refusal to License

The final step before moving into full analysis of the right to exclude is to differentiate between exercising a unilateral right to exclude against a discrete potential user and exercising a blanket right to exclude against the world (that is, the right to hoard). The former is not only a presumptively valid exercise of a copyright owner’s exclusory power; it is also the core notion of the incentive that copyright law provides: the ability to exclude others and therefore extract more value from the publication of the work itself. Challenges to the right to exclude are almost universally

interests supplements federal protection and fills in gaps unattended by federal law.”)

133 For a brief discussion of the interplay between publicity law and the now-defunct (practically speaking) common law copyright doctrine, see Jeffrey Malkan, Stolen Photographs: Personality, Publicity, and Privacy, 75 Tex. L. Rev. 779, 798 (1997).
134 See Data General, 36 F.3d at 1187.
decided in favor of the intellectual property owner.136 Perhaps part of the reason for this phenomenon is that nearly any discrete instance of a refusal to license is part of a valid exercise of statutory power.137 Without that power a copyright owner has little chance to mine the maximum value from his work. Part of what a movie producer or book publisher bargains for is exclusivity; if an author cannot provide such a guarantee, his creative product is worth little to any individual distributor.138 Before simply accepting the right to exclude unilaterally as desirable, however, considering the basic alternative scheme of copyright protection, one based on nonexclusive compulsory licenses with no exclusory right, is a worthwhile exercise.

The alternative to this dominant free-market, maximum-control view is that by providing unlimited public access to a creative work for a statutorily determined fee, an author can receive financial remuneration for their work (thereby encouraging future creation) while at the same time providing maximum “progress” of creative works—that is, creative work would spread the furthest to the most people.139 This conceptualization fails for two reasons. First, it is entirely impractical; such a shift to completely alter the monopolistic nature of copyright law would require a complete overhaul of the Copyright Act as currently written (and, indeed, any copyright scheme existing anywhere in the world) and is extremely unlikely to ever gain traction. Second, the actual implementation of

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136 Cf. Data General, 36 F.3d at 1187 (creating a high barrier to establish anticompetitive conduct in any discrete refusal to deal in the patent context).
137 Cf. id.
138 See Nicolas Suzor, Access, Progress, and Fairness: Rethinking Exclusivity in Copyright, 15 VAND. J. ENT. & TECH. L. 297, 309 (2013) (“Exclusivity allows a commodity market in expression, and the market provides an objective method of valuing creative works. In this context, abundance models that use purely economic arguments to decouple incentives from exclusivity in copyright fail because they break the link between incentives and reward.”).
139 See Malla Pollack, What Is Congress Supposed to Promote? Defining “Progress” in Article I, Section 8, Clause 8 of the United State Constitution, or Introducing the Progress Clause, 80 NEB. L. REV. 754, 809 (2001) (“The word ‘progress’ means ‘spread.’”).
such a scheme would require a statutorily determined royalty rate for any given work: essentially a compulsory license. While there is precedence for such a scheme—a triad of royalty judges already determine the statutory rate for mechanical reproduction licenses in music\(^\text{140}\)—such an arrangement would harm all parties in the aggregate.

There are three players in the scheme whose benefits and losses determine the ultimate utility of any given copyright scheme: individual creators, creative content distributors (e.g., producers and publishers), and the public at large. There are also two types of individual creators: those with bargaining power (the “famous artists”) and those without (the “starving artists”). Those without bargaining power—the starving artists who are at risk of signing unremunerative transfers of rights and who were the targets of the old renewal-rights scheme and the current termination-rights scheme\(^\text{141}\)—are in no position to negotiate terms under the current system.\(^\text{142}\) They usually sign away all control over their rights for a standard minimum agreement.\(^\text{143}\) A statutory royalty in a given field


\(^{141}\) See Shane Valenzi, It’s Only a Day Away: Rethinking Copyright Termination in a New Era, 53 IDEA 225, 227, 237 (2013); see also Mills Music, Inc. v. Snyder, 469 U.S. 153, 172–73 (1985) ("[T]he termination right was expressly intended to relieve authors of the consequences of ill-advised and unremunerative grants that had been made before the author had a fair opportunity to appreciate the true value of his work product." (citing H.R. REP. 94-1476, at 127 (1976))).

\(^{142}\) See John M. Kemochan, The Distribution Right in the United States of America: Review and Reflections, 42 VAND. L. REV. 1407, 1433 (1999) ("In the United States, upon sale, there is a consequent and sometimes serious loss of artistic and economic control over the future of the work, especially if weak bargaining power means the artist must yield the copyright. . . .").

\(^{143}\) See Don E. Tomlinson, Everything that Glitters is Not Gold: Songwriter-Music Publisher Agreements and Disagreements, 18 HASTINGS COMM./ENT L.J. 85, 94 (1995) ("Because of the impossibility of predicting the commercial value of a work upon its creation and because of the weak bargaining position of [songwriters], they sometimes assigned their copyrights in return for very little remuneration, such as small lump-sum payments or inadequate royalty rates. . . .").
that is equal to the current minimum agreement artists sign in that field and that would guarantee the public's ability to sign nonexclusive licenses to use the work would not place those artists in any better or worse of a financial situation than they are currently in, and both systems prevent those authors from exercising any control over their work. Distributors in each field would be in a worse position under the nonexclusive compulsory license system, because they would pay the same amount (the minimum) but for less control, as anyone could license the same right to the same work. Notably, however, artists with no bargaining power also have no current market for their work, so any refusal to license is not likely to inflict any harm on the public except in the abstract (by depriving the public of part of the universe of creative expression).

On the other hand, those artists with bargaining power (i.e. the successful, famous ones) would be severely harmed by such a scheme. First, the agreements these artists sign are much higher than the minimum agreements.\textsuperscript{144} A statutory rate equal to the minimum would deprive those artists with the largest market for their works of both the revenue and the control they've bargained for through market forces.\textsuperscript{145} A statutory rate that is any lower than a given maximum will incentivize third-party facilitators to license work from more popular artists who would have, under the current free-market system, been able to bargain for a higher rate. A statutory rate that is any higher than the minimum would incentivize licensing of famous authors' work \textit{at the expense of} "starving artists" who would have otherwise agreed to a lower rate. As a result, everyone loses: the established artists lose revenue, facilitators and

\textsuperscript{144} See id. at 87–92 (describing differences between the bargaining power of successful songwriters and newly-signed songwriters when negotiating with producers, and noting that successful songwriters often become their own publishers when they are able).

\textsuperscript{145} Of course, every author begins with full control. But few authors are able to monetize their work without transferring their rights to a distributor (at least historically), and only successful authors are able to maintain control either through self-distribution or through greater bargaining power with distributors.
artists lose all control, emerging artists lose the opportunity to be discovered (because licensing their work is no cheaper than licensing work from already established creators), and the public loses in the aggregate, because such increased barriers to entry and decreased bargaining potential would discourage new artists from beginning creation and established artists from continuing to create.

This brief consideration of an alternative scheme reveals that protecting the unilateral right to exclude in turn protects the continued production of creative works. Picking and choosing who may use a given creative work makes economic sense for the creators, and in general the interests of the creators, the distributors, and the public should all be aligned—to provide as much access to creative work to the public as possible. This careful economic structure breaks down entirely, however, when either a creator or a distributor’s interests change; i.e., when one who controls access to a creative work denies all access to the world, not just to discrete individuals seeking a license on unacceptable terms.

Accepting, then, the notion that some level of control over unilateral licensing agreements is a desirable scheme, this Article will turn its exclusive attention to an author’s right to refuse to transfer or license their work to anyone—that is, the right to hoard.

C. Property Rights and the Right to Hoard

Is copyright property? The Supreme Court has asserted on multiple occasions that it is. At the same time, the Court has noted

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146 The debate centers on the amount the public should pay, which is beyond the scope of this Article.
147 Under now-defunct common law copyright, the author of an unpublished work retained the right of first publication regardless of other statutory rights surrounding it; now that statutory copyright subsists in a work from the moment of creation, however, there is no functional difference in the bundle of rights between published and unpublished works. See supra note 110. The only creative field in which an unpublished author retains slightly more control over their work than a published author is music, where a published work is subject to compulsory mechanical reproductions (i.e., recorded covers of the song). See 17 U.S.C. § 115. For the purposes of this section, then, both published and unpublished works may be analyzed together.
that copyright is a statutory right conferred by Congress and not a natural right.\textsuperscript{149} John Locke describes the right to property as a natural and fundamental right,\textsuperscript{150} which seems to place the judicial interpretation of copyright as a property right at odds with the Congressional view of copyright as a government grant to individuals for the benefit of society.\textsuperscript{151} A closer look at the full scope of Locke’s property theory reveals a common space (literally) within which to bridge the two conceptions.

Many copyright scholars are familiar with the labor-theory aspect of Locke’s proviso: that a property owner holds the moral right to exclude everyone from his property due to the labor he put

\textsuperscript{148} See, e.g., C.I.R. v. Wodehouse, 337 U.S. 369, 401 (1949) (“In the exercise of its power ‘To promote the Progress of Science and useful Arts,’ Congress, by granting copyrights, has created valuable property rights.”); Fox Film Corp. v. Doyal, 286 U.S. 123, 128 (1932); see also Loew’s Inc. v. CBS, 131 F. Supp. 165, 184 (S.D. Cal. 1955) (“After all, copyright is property . . . .”). See generally Justin Hughes, Copyright and Incomplete Historiographies: of Piracy, Propertization, and Thomas Jefferson, 79 S. CAL. L. REV. 993, 1004–46 (2006) (presenting an informal historiographical survey of references to pre-20th century copyright law, and concluding that copyright was commonly understood internationally by courts, legislatures, and academics to be a form of property). But see generally Tom W. Bell, Copyright as Intellectual Property Privilege, 58 SYRACUSE L. REV. 523 (2008) (arguing copyright is better conceptualized as a form of legislatively granted privilege, not property).

\textsuperscript{149} E.g., Sony v. Universal City Studios, Inc., 464 U.S. 417, n.10 (1984) (“In its report accompanying the comprehensive revision of the Copyright Act in 1909, the Judiciary Committee of the House of Representatives explained this balance: ‘The enactment of copyright legislation by Congress under the terms of the Constitution is not based upon any natural right that the author has in his writings . . . .’” (citing H. REP. 60-2222 (1909))).

\textsuperscript{150} See JOHN LOCKE, SECOND TREATISE ON GOVERNMENT § 25 (1890) (“[M]en . . . have a property in several parts of that which God gave to mankind in common . . . .”); § 27 (“[E]very man has a property in his own person: this no body has any right to but himself. . . . Whatsoever then he removes out of the state that nature hath provided, and left it in, he hath mixed his labour with, and joined to it something that is his own, and thereby makes it his property.”).

\textsuperscript{151} Compare id., with H. REP. 60-2222 (1909) (“The enactment of copyright legislation by Congress under the terms of the Constitution is not based upon any natural right that the author has in his writings . . . .”), and Bobbs-Merrill Co. v. Strauss, 210 U.S. 339, 346 (1908) (“Recent cases in this court have affirmed the proposition that copyright property under the Federal law is wholly statutory, and depends upon the right created under the acts of Congress passed in pursuance of the authority conferred under article 1, § 8, of the Federal Constitution . . . .”).
into cultivating that property.\textsuperscript{152} The Lockean labor theory of copyright suggests that an author deserves protection based on the effort he put into the work, which closely aligns with the moral rights justification for copyright prominent in Europe.\textsuperscript{153} If an apple grows on a property owner’s land and the owner picks it, the theory goes, then that owner should have the right to exclude anyone else from entering his land and taking his apple.\textsuperscript{154}

This principle alone is an oversimplification of the theory, however. First, such a principle presumes that equivalent apples are available for picking elsewhere.\textsuperscript{155} Second, the principle also contemplates that there exists a separate tract of land: the “commons” which all may use and which none may restrict.\textsuperscript{156} Finally, and most importantly, the principle requires the laborer to do something with the apple—a land owner may not exercise his right to exclude others from his fruit while he allows it to rot on the tree.\textsuperscript{157} While labor and moral rights theorists have traditionally

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\item[152] Locke, supra note 150 § 27 (“The labour of his body, and the work of his hands, we may say, are properly his. WHATSOEVER then he removes out of the state that nature hath provided, and left it in, he hath mixed his labour with, and joined to it something that is his own, and thereby makes it his property. It being by him removed from the common state nature hath placed it in, it hath by this labour something annexed to it, that excludes the common right of other men: for this labour being the unquestionable property of the labourer, no man but he can have a right to what that is once joined to, at least where there is enough, and as good, left in common for others.”).
\item[153] Id.
\item[154] Id.
\item[155] Id. § 33 (“Nor was this appropriation of any parcel of land, by improving it, any prejudice to any other man, since there was still enough, and as good left; and more than the yet unprovided could use. So that, in effect, there was never the less left for others because of his inclosure for himself: for he that leaves as much as another can make use of, does as good as take nothing at all.”).
\item[156] See id. § 27 (“[N]o man but he can have a right to what that is once joined to, at least where there is enough, and as good, left in common for others.”).
\item[157] Id. § 31. The relevant provision reads:
As much as any one can make use of to any advantage of life before it spoils, so much he may by his labour fix a property in: whatever is beyond this, is more than his share, and belongs to others. Nothing was made by God for man to spoil or destroy. And thus, considering the plenty of natural provisions there was a long time in the world, and the few spenders; and to how small a part of that
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used Lockean labor theory to justify an author's sacred and fundamental right to exclude others from their work, such a right is cabined by an obligation to use it in some way.

Under Lockean theory, then, the right to hoard does not exist. As long as an author uses a work in some way, by providing some sort of public access, that author is free to exclude all others, but to create but not use is tantamount to allowing your carefully cultivated creative apples to rot while excluding the creatively starved public. In addition, executing a broad right to exclude depends on a robust commons by which the public may craft their own, similar work. In copyright terms, this “commons” consists not only of public domain works, but also material that is not copyrightable (e.g., ideas, words). This creative commons made up of works currently in the public domain as well as ideas and other uncopyrightable material

provision the industry of one man could extend itself, and ingross it to the prejudice of others; especially keeping within the bounds, set by reason, of what might serve for his use; there could be then little room for quarrels or contentions about property so established.

Id. §31. A similar sentiment is expressed in §§ 37–38:

Before the appropriation of land, he who gathered as much of the wild fruit, killed, caught or tamed, as many of the beasts, as he could; he that so impoyed his pains about any of the spontaneous products of nature, as any way to alter them from the state which nature put them in, by placing any of his labour on them, did thereby acquire a property in them: but if they perished, in his possession, without their due use; if the fruits rotted, or the venison putrified, before he could spend it, he offended against the common law of nature, and was liable to be punished; he invaded his neighbour's share for he had no right, farther than his use called for any of them, and they might serve to afford him conveniences of life.

Id. § 37.

But if either the grass of his inclosure rotted on the ground, or the fruit of his planting perished without gathering, and laying up, this part of the earth, notwithstanding his inclosure, was still to be looked on as waste, and might be the possession of any other.

Id. § 38. See also id. § 48.

158 See supra note 157.

159 Not to be confused with the Creative Commons, the collection of free copyrighted material available online for use with various non-onerous license restrictions. See About, CREATIVE COMMONS, http://creativecommons.org/about (last visited Mar. 31, 2013). Unlike the real-world Creative Commons project, the Lockean creative commons does not consist of copyrighted material available for free, but rather consists only of noncopyrightable creative content.
presumes that a future user is also a creator. This storehouse of knowledge does not deplete, and copyright law does not threaten it (or, at least, it shouldn’t). Such a conception may justify a copyright owner’s blanket refusal to license derivative works; with a broad storehouse of ideas from which to draw, there’s no reason a future creator can’t rely on an idea rather than an earlier creator’s protected expression in order to create. But most users are just that: users, not creators. They want to consume, not create, and leaving these users only public domain expression to consume is inapposite to the goals of copyright anywhere, particularly where nothing new (when properly renewed) has entered the public domain since 1923, and likely won’t anytime soon.160

Under this property-rights analysis, the type of right being hoarded is relevant.161 An argument against hoarding is very strong when applied to the distribution right,162 as that right most directly affects public access to the work for consumptive purposes, and is the most obvious analogy to the work “rotting on the tree.” In contrast, this analysis does not cut strongly against an author’s (or copyright owner’s) right to refuse to license the derivative right to his work in any form163—with only an uncopyrightable idea necessary to spur authorship of a creative work, the argument that

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160 See LAWRENCE LESSIG, FREE CULTURE 214 (“Eldred would not be free to add any works more recent than 1923 to his collection until 2019. Indeed, no copyrighted work would pass into the public domain until that year (and not even then, if Congress extends the term again). By contrast, in the same period, more than 1 million patents will pass into the public domain.”).

161 The discussion infra refers to the exclusive rights embodied in 17 U.S.C. § 106 (reproduction, distribution, public display, public performance, and derivative), commonly understood as the “bundle of rights” that comprise a copyright. It does not, for example, refer to the statutory termination right contained in §§ 203 and 304. “Hoarding” the termination right is, in this author’s view, inevitable, since the right itself was intended to be inalienable. See Valenzi, supra note 141, at 225.

162 17 U.S.C. § 106(3) (“[T]he owner of copyright under this title has the exclusive right[] . . . 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.”).

163 17 U.S.C. § 106(2) (“[T]he owner of copyright under this title has the exclusive right[] . . . to prepare derivative works based upon the copyrighted work[.]”).
copyrightable expression must also be made available for alteration is nearly nonexistent.\textsuperscript{164} In Lockean terms, there is no need to compel access to privately owned apples when there are perfectly good pears in the commons.

Protecting an author’s derivative right also protects a literary author’s right to “version” his work—that is, to option a book into a movie. Compelling an author to license a work to any film company that comes calling could actually harm the value of the work. As an example, films based on the works of Stephen King run the gamut of quality; he’s licensed faithful film adaptations that were critically acclaimed (e.g., \textit{The Shawshank Redemption}, \textit{The Green Mile}), adaptations that flopped (e.g., \textit{Dreamcatcher}, \textit{Hearts in Atlantis}), and television miniseries that, while faithful, have not aged well over time (\textit{It}, \textit{The Stand}).\textsuperscript{165} King has also licensed comic books, video games, and even pop-up books derived from his works.\textsuperscript{166} He has not always been happy with the final result,\textsuperscript{167} but making decisions about which adaptations to license (a film version of \textit{The Dark Tower} series has yet to take form, for example) and the form such adaptations should take (King often prefers television miniseries, presumably because they can capture more of the source material and he can maintain more creative control) should remain purely the province of the author. Even an author who refuses to license any

\textsuperscript{164} See generally Daniel J. Gervais, \textit{The Derivative Right, Or Why Copyright Law Protects Foxes Better Than Hedgehogs}, 15 \textit{VAND. J. ENT. \\& TECH. L.} 785 (2013) (examining the derivative right’s “different normative target” from the reproduction right, and citing Jessica Litman, \textit{The Public Domain}, 39 \textit{EMORY L.J.} 965, 966 (1990) (“[T]he very act of authorship in any medium is more akin to translation and recombination than it is to creating Aphrodite from the foam of the sea.”)).

\textsuperscript{165} For a comprehensive list of King’s works and the authorized versioning of each one, see \textit{Creator: Stephen King}, TV TROPES, \url{http://tvtropes.org/pmwiki/pmwiki.php/Creator/StephenKing?from=Main.StephenKing} (last visited May 1, 2013).

\textsuperscript{166} \textit{Id.}

\textsuperscript{167} For example, King remade \textit{The Shining} after he was famously displeased with Stanley Kubrick’s loose adaptation. \textit{See id.} King also attempted to have his name legally removed from the film \textit{Lawnmower Man}, which bore no resemblance to his short story and licensed the work purely for name recognition. \textit{See id.}
derivative use of any of his works may have normative grounds to do so; J.D. Salinger, who took just such a stance during his lifetime, perhaps expressed this sentiment best through a private letter denying a prospective filmmaker the rights to adapt his work: “I see my novel as a novel and only a novel.” To put it in Lockean terms, the creative work is the author’s absolute property, and provided he has made productive use of it (by releasing it to the public as a novel), he has fulfilled whatever duty to the public he may have and should not be required to sacrifice any more of his creative control.

The importance of hoarding the remaining exclusive rights depend very much on the work in question. Hoarding the right of reproduction in a great work of art seems perfectly appropriate; less so for a great work of literature. In contrast, hoarding the right to display that same work of art would prevent the public from accessing the work in any meaningful way. Hoarding of the display right in musical or dramatic works, however, might hurt certain types of advertising but wouldn’t prevent access to the heart of those works themselves. Of course, preventing all public performance of those later two categories of works would eviscerate the creative contributions those works make to the public.

In sum, a proper Lockean analysis of property rights protects a discrete right to exclude only so far as a copyright owner makes some affirmative use of his rights to the work. Under Lockean

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169 17 U.S.C. § 106(1) (“[T]he owner of copyright under this title has the exclusive right[... to reproduce the copyrighted work in copies or phonorecords[.”].

170 17 U.S.C. § 106(5) (“[T]he owner of copyright under this title has the exclusive right[... in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly[.”].

171 17 U.S.C. § 106(4) (“[T]he owner of copyright under this title has the exclusive right[... in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly[.”].
theory, an author may still refuse to make or license a derivative of his work, but hoarding any of the remaining exclusive rights without exercising them frustrates public access to some category of protectable work.

As a final addendum, an astute reader may note that, by treating published and unpublished works together under this analysis, many types of unpublished work would be inappropriately subject to public access (diaries, confidential documents, or even simply unfinished drafts of creative work). Although technically protected by copyright, proponents of the continued secrecy of these works should, practically speaking, not be concerned about the effects of this theory on unpublished works. First, in the case of unfinished drafts, the Lockean theory supports an author’s right to tend his own garden; until a work is completed, its creator would be unable to “waste” its creation, so no public access would be required. In the case of completed-but-private works such as diaries and private papers, copyright law alone simply shouldn’t rule the day.172 Here, a privacy law analysis should come back into play, as permitting public access to these sorts of works would be damaging to a person’s “right to be let alone” in a way that copyright law was not and should not be designed to accommodate.173 Much as trademark scholars have argued that trademark law need not concern itself with evils fought by unfair competition or false advertising laws, copyright law and theory in this case need not concern itself with privacy issues protectable under the common law.174

172 The very foundations of copyright law draw a meaningful distinction between published and unpublished works. See generally M. Rose, Authors and Owners: The Invention of Copyright 79 (1993).
174 See Mark A. Lemley & Mark McKenna, Irrelevant Confusion, 62 Stan. L. Rev. 413, 427 (2010) (“We therefore propose to do away with the “sponsorship or affiliation” terminology altogether and to reframe the trademark infringement question in terms of whether the defendant’s use is likely to confuse consumers about who is responsible for the quality of the defendant’s goods or services. Uses that cause such confusion should be
D. Reconciling the Property View with the Utilitarian View

One problem with a robust property-rights analysis of the right to exclude is that the Lockean labor theory of copyright has little domestic influence. The United States has long rejected such an approach in favor of a purely utilitarian (i.e., economic) justification; in fact the Fox Film Court alludes to exactly that distinction when it notes that copyright law rewards the “labors of authors” only to benefit the public, and not for the authors’ own sake. But even in purely utilitarian terms the right to hoard sits on shaky ground.

The right to hoard is wholly incompatible with the utilitarian view of copyright. The utilitarian system of copyright is based on the effective workings of the free market. Adopting Samuel Johnson’s quip that “[n]o man but a blockhead ever wrote, except for money” as a mantra, the theory predicates awarding authors the right to exclude on the notion that authors can maximize the economic value of their works through bargaining. As detailed above, removing an author’s ability to exclude anyone from using his work as they please would decrease the economic potential of the work, and thereby decrease an author’s incentive to create. This purely economic system is equally a utilitarian system because incentivizing creation is done solely for the good of the public—to
deemed trademark infringement; those that cause confusion regarding other types of relationships should be dealt with, if at all, through something analogous to a false advertising claim.”).

175 Fox Film Corp. v. Doyal, 286 U.S. 123, 127 (1932).
176 Cf. Alina Ng, The Author’s Rights in Literary and Artistic Works, 9 J. MARSHALL REV. INTELL. PROP. L. 453, 453 (2010) (“Congress protects these specific acts of publicly disseminating works to facilitate market commercialization of creative works by preventing the general public from exercising the exclusive rights under section 106 without the permission of the author or copyright owner.”).
178 See Ng, supra note 176, at 462 (“Economic theory seeks to encourage authorship by the promise of market rewards, and through the market, authors are remunerated for their creativity.”).
179 supra Part III.B.
guarantee public access to creative works.\textsuperscript{180} Though exercising the right to exclude necessarily limits the public availability of some works, the theory goes, such protection extends only for a limited time, and the public will gain in the aggregate because every work will ultimately enter the public domain.\textsuperscript{181}

Whether copyright is treated as a privilege or a property right,\textsuperscript{182} an author who hoards a work and refuses to release it to the public takes away more “good” from society than it provides: the public loses access to the work (bad), a monopoly exists (bad), and the author earns no economic benefit, and thereby has no incentive to further create (neutral).\textsuperscript{183} The right to hoard, then, can only be justified with a view towards the public in the long term—that is, while the present public may not benefit, the future public will, because the work will enter the public domain at some point.\textsuperscript{184} Such a justification is commonly asserted in patent cases.\textsuperscript{185} It is

\textsuperscript{180}See, e.g., H.R. REP. 60-2222 (1909) (“Not primarily for the benefit of the author, but primarily for the benefit of the public, such rights are given.”).

\textsuperscript{181}See, e.g., Rebekah O’Hara, \textit{You Say You Want a Revolution: Music & Technology—Evolution or Destruction?}, 39 GONZ. L. REV. 247, 258 (2004) (“The quid pro quo for a ‘Limited Times’ monopoly is the ability of the public to access the materials after the copyright expires and falls into the public domain.”).

\textsuperscript{182}See generally Bell, supra note 148 (arguing that copyright’s property-like attributes are all qualified, and therefore can be better conceptualized as a set of privileges).

\textsuperscript{183}The system is designed to trade off the creation of monopoly power (bad) with public access (good) and additional incentive to create (good). While few would argue in modern economic terms that an author \textit{only} creates for the potential to make money, scratching a creative itch and self-actualizing through creation are not contemplated under the cold economic terms on which US copyright law is predicated. See, e.g., H. REP. 60-2222 at 7 (1909) (“The enactment of copyright legislation by Congress under the terms of the Constitution is not based upon any natural right that the author has in his writings, for the Supreme Court has held that such rights as he has are purely statutory rights, but upon the ground that the welfare of the public will be served and progress of science and useful arts will be promoted by securing to authors for limited periods the exclusive rights to their writings. . . . Not primarily for the benefit of the author, but primarily for the benefit of the public such rights are given.”).

\textsuperscript{184}See O’Hara, supra note 181.

\textsuperscript{185}E.g., In re Metoprolol Succinate Direct Purchaser Antitrust Litigation, 2010 WL 1485328 at *1 (D. Del. April 13, 2010) (“The Hatch–Waxman Amendments intend to balance two important public policy objectives: (1) prescription drug manufacturers need meaningful market protection
here that the similar theories and justifications of copyright and patent law diverge, however, due to the practical differences between the laws. Patent monopolies expire after twenty years.\footnote{35 U.S.C. § 154(a)(2).} With some fancy tricks, an inventor may extend that monopoly by a year.\footnote{SEAN B. SEYMORE, SEYMORE ON PROVISIONAL PATENT APPLICATIONS 1 note 55 (2012) (“By waiting the full year to file the nonprovisional application, applicants may effectively extend their patent term to 21 years.”) (on file with Author).} Therefore, when the Court notes at the turn of the twentieth century that “the monopoly which he receives is only for a few years,” such a sentiment remains relevant today, even though the patent term is longer than it was when the Court first asserted the justification.\footnote{Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 424 (1908).}

In contrast, nothing currently protected by copyright will enter the public domain any time soon.\footnote{See supra note 160.} Lobbying interests in copyrighted work is too strong, and the advocates of the public domain too poor, to wage a successful fight against continued extensions of the copyright term which is, after all, not based on any natural right of the public to access creative work.\footnote{Justice Breyer’s dissent in \textit{Eldred v. Ashcroft}, 537 U.S. 186, 242 (2003) (Breyer J., dissenting), contained a compelling list of quotes from the legislative history of the Copyright Term Extension Act suggesting that the notion of perpetual copyright had strong Congressional and lobbying support as of 1998: [T]he statute was named after a Member of Congress, [Sonny Bono,] who, the legislative history records, “wanted the term of copyright protection to last forever.” 144 Cong. Rec. H9952 (daily ed. Oct. 7, 1998) (statement of Rep. Mary Bono). See also Copyright Term, Film Labeling, and Film Preservation Legislation: Hearings on H.R. 989 et al. before the Subcommittee on Courts and Intellectual Property of the House Judiciary Committee, 104th Cong., 1st Sess., 94 (1995) (hereinafter House Hearings) (statement of Rep. Sonny Bono) (questioning why copyrights should ever expire); \textit{ibid.} (statement of Rep. Berman) (“I guess we could ... just make a permanent moratorium on the expiration of copyrights”); \textit{id.}, at 230 (statement of Rep. Hoke) (“Why 70 years? Why not ...”)}. As the promise incentives to encourage the development of new drugs; and (2) once the statutory patent protection and marketing exclusivity for these new drugs has expired, the public benefits from the rapid availability of lower priced generic versions of the innovator drug.”).
of the public domain is pushed further to the future, however, the present public utility decreases; the longer the term of protection, the less good is created in the present.191 Like money, access to a creative work today is worth more than access to a creative work tomorrow.192

Really, then, there is no economic justification to allow an author to hoard his works during the term of copyright. That is not to say that the right to hoard is an unreasonable extreme in copyright law generally. Indeed, the French droit de repentir is essentially a codified right to hoard published works, granting an author the right to modify or even withdraw his work from publication through the transferee.193 This right envisions publication as a continual process; at the point where a work requires some sort of modification to accurately express an author’s current frame of mind, or the author wishes to remove it from public consumption entirely, the author simply withdraws permission and the work must similarly be withdrawn.194 This Article’s objection to the right to hoard is not based on its infeasibility in any copyright system; rather, the French droit de repentir is strong evidence that the right to hoard is a moral one. Its normative bearings presume a work as an extension of an author’s personality, and attach authorial control and the right to exclude not to a property theory and

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191 See id. at 254–55 (“Using assumptions about the time value of money provided us by a group of economists (including five Nobel prize winners), it seems fair to say that, for example, a 1% likelihood of earning $100 annually for 20 years, starting 75 years into the future, is worth less than seven cents today.”).

192 Id. at 256.


certainly not to an economic justification, but rather to the idea that artistic works are personal works and should be protected as a form of bodily integrity and personal autonomy.\textsuperscript{195} Moral rights and personality theory are entirely absent in US copyright law, and it is the \textit{sole} reliance on economic justification, to the explicit exclusion of personality theories, that prevents the right to hoard from gaining any foundational traction in US copyright law.

Even though Lockean theory similarly does not comport with utilitarian theory in US copyright law, here they share similar ideals. Both are interested in a robust public domain. Neither wishes to see creative work rot on the vine. And both believe in promoting the welfare of the individual creator contingent on the impact such promotion has on the public. Utilitarianism would protect the welfare of the individual only so far as the well-being of the public increases just as much or more, while Lockean theory would protect the welfare of the individual so long as such protection does not harm another, including through the misuse of resources. While these two theories are often incompatible on issues such as control of a work and term of protection, they both should, in theory, soundly reject the right of an author to prevent all use of a copyrighted work during its term of protection.

E. Counterpoint: A Hohfeldian Analysis

The principal difficulty facing opponents of the right to hoard is the aggregate nature of the right. A Hohfeldian view of copyright highlights this problem. Hohfeld separates the traditionally vague legal use of “right” into eight distinct concepts: a right (and its opposite no-right), a privilege (and its opposite duty), a power (and its opposite disability) and an immunity (and its opposite

\textsuperscript{195} See generally id. Though personality theory in copyright is traditionally categorized as Hegelian, a handful of prominent German twentieth century philosophers, Karl Gareis and Otto Friedrich von Gierke, parsed and popularized the personality theory of artistic and literary works independent of Hegelian influence. \textit{See id.} at 27–28.
liability). Hohfeld goes on to separate rights into paucital rights—
rights asserted against an individual—and multital rights—rights
asserted against a large group in the aggregate. In parsing this
distinction, Hohfeld posits that multital rights are, in effect, simply a
collection of paucital rights; rather than a single right held against a
group, a multital right is actually an accumulation of separate
paucital rights owned by the author against each individual in the
group. Hohfeld's support for this hypothesis is grounded in
practicality; he quotes Professor Samuel Williston, who notes,
"Though legal ownership is conceived fundamentally as a right good
against all the world, actual instances of such ownership are often
much more narrowly limited."

This construction provides the strongest support for the
right to hoard. As an initial matter, a copyright embodies aspects of
all of these classifications (a right to exclude others, the privilege to
use, the power to license and sell, and the immunity from having the
copyright taken away except under certain circumstances). The
objection to the right to hoard, as established in this Article, centers
only on a blanket right asserted against the world (a multital right, to
use the Hohfeldian term), not any individual refusal to license
(which, after all, is already presumptively valid). By challenging the
nature of the multital right to a collection of discrete paucital rights,
which are each presumptively valid, the right to hoard is an illogical
but justifiable result of a series of legitimate rights not enforced
against the world, but rather enforced against each discrete member.

196 See generally Wesley Newcomb Hohfeld, Some Fundamental Legal
Conceptions As Applied in Judicial Reasoning, 23 YALE L.J. 16 (1913)
(exploring and defining the terms “right,” “privilege,” “power,” and
“immunity” in detail).
197 See Hohfeld, supra note Error! Bookmark not defined.Error!
198 See id. at 742 ("[I]t is submitted that instead of there being a single right
with a single correlative duty resting on all the persons against whom the
right avails, there are many separate and distinct rights, actual and
potential, each one of which has a correlative duty resting upon some one
person.").
199 Id. at 742 (citing Samuel Williston, Is the Right of an Assignee of a Chose
in Action Legal or Equitable?, 30 HARV. L. REV. 97, 98 (1916)).
Parsing through this quandary is a challenge. Logically, Hohfeldian analysis justifies a blanket right to hoard. Practically, Hohfeld’s 1917 analysis evinces a Lochner-era classical legal liberal view of rights and privileges, and his arguments are littered with strong individual and property rights arguments that are not wholly compatible with modern legal interactions. For example, fair use and other statutory exemptions already provide exceptions to the pure rights classification, which prevent a perfect symmetry between Hohfeld’s correlative legal concepts and the realities of copyright law.

More importantly, Hohfeld is wholly silent on the implications of a scenario in which a multital right is legally impermissible while the paucital rights making up the multital rights are not so limited. While supporters of the right to hoard may draw the conclusion that such a multital right cannot be declared impermissible under this conceptualization, this conclusion is a conjecture, nothing more. Hohfeld’s work was not intended to make policy arguments; he was merely interested in defining a consistent vocabulary for judges, law students, and scholars to discuss legal issues. Under this interpretation, Hohfeldian analysis is useful in that it provides clear, consistent definitions of “right” and “privilege,” but it is intentionally inconclusive on the normative values regarding the right to hoard.

IV. IMPLEMENTING A SOLUTION

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200 In fact, Hohfeld suggests as much in the field of real property, in contravention of Locke’s use requirement:

> Even though the land be entirely vacant and A have no intention whatever of personally using the land, his rights or claims that others shall not use it even temporarily in such ways as would not alter its physical character are, generally, of great economic significance as tending to make others compensate A in exchange for the extinguishment of his rights, or claims, or in other words, the creation of privileges of user and enjoyment.

_Id._ at 747.

201 _See id._
A. Preventing the Right to Hoard in the United States
Copyright law does not normatively support an author’s right to hoard. Preventing that sort of behavior under the current US copyright system, however, is more problematic. Congress isn’t likely to amend the Copyright Act anytime soon, and when they do it certainly won’t be to remove rights from authors.202 Rather, protecting public access from hoarding by authors can most easily be effected by the courts through careful application of the eBay standard for issuing judicial relief following a finding of infringement. Such judicial decisionmaking, however, will require careful handling of Stewart v. Abend and its strong language permitting an author the unlimited right to exclude.

1. Using eBay

*eBay v. MercExchange* established a mode of analysis for determining when to issue injunctions as relief in patent infringement cases.203 Its four step test has since been applied to copyright and trademark infringement, as well.204 Rather than imposing injunctions at every instance of infringement, *eBay* mandates a case-by-case analysis, issuing an injunction only if 1) the injury from infringement is irreparable; 2) remedies available at law (that is, monetary damages) are inadequate to compensate for the injury; 3) considering the balance of hardship between the infringer and the rightful owner, an injunction is warranted; and 4) the public interest would not be disserved by a permanent injunction.205 In setting these factors, the Supreme Court moved away from the

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202 See generally Jessica Litman, *The Copyright Revision Act of 2026*, 13 MARQ. INTELL. PROP. L. REV. 249, 255–57 (2009) (“Instead of setting out the scope of individual audience interests in explicit terms, the basic architecture of the system respected the rights of readers, listeners, and viewers by limiting the reach of copyright rights. That’s been changing, though….Copyright owners have been advancing liberal constructions of the individual copyright rights in courts, in treaty negotiations, and in their copyright rhetoric….Bottom line for consumers: their historic copyright liberties to read, view, and listen to works are shrinking fast….”).
204 E.g., Salinger v. Colting, 607 F.3d 68, 74–75 (2d Cir. 2010).
205 eBay, 547 U.S. at 391.
traditional practice of issuing injunctions in nearly every instance of patent infringement. The decision has since been used to justify courts refusing to issue an injunction against an infringer, instead awarding monetary damages equal to what a fairly priced license for the patent would have been, effectively awarding a compulsory license to the infringer.

The same analysis could be applied to cases of creative hoarding. Specifically, by following the reasoning in Part III above as part of the fourth eBay factor (public interest), a judge may easily conclude that an author’s blanket refusal to license his creative work is injurious to the public interest, and that factor alone should by the letter of the eBay rule be enough to scuttle any possibility for an injunction to issue. In this way, an author may retain his statutory right to exclude, and have that right protected judicially on a case-by-case basis, but evidence of a blanket right to exclude, perhaps via a class action suit or simply clear evidence that the author has refused to license the use of the work to anyone, despite an established market for the work, could overcome the presumptive validity of the author’s exclusionary right. By awarding the author damages equivalent to a license, a judge would effectively limit an author’s right to exclude the public while still guaranteeing appropriate compensation for the author’s creative product.

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206 E.g., MercExchange, L.L.C. v. eBay, Inc., 401 F.3d 1323, 1339 (Fed. Cir. 2005), rev’d, 547 U.S. 388 (2006) ("We therefore see no reason to depart from the general rule that courts will issue permanent injunctions against patent infringement absent exceptional circumstances.").
208 Cf. Data General Corp. v. Gramman Sys. Support Corp., 36 F.3d 1147, 1186–87 (1st Cir. 1994) (holding that a copyright holder’s unilateral right to exclude is considered presumptively valid, with the burden on the alleged infringer to establish anticompetitive conduct sufficient to overcome such a presumption).
209 Placing this sort of decision in the hands of judges would also prevent any unintended evils of the law, specifically as applied to unpublished works. An attempt to compel access to a private work or document (or an infringement suit brought by the owner of such a document) is far more likely to pass all four factors of the eBay test and yield an injunction, as the public has far less of a legitimate interest in a work not created for
This approach may in effect hoist on their own petard proponents of the right to hoard based solely on judicial precedent. The *Fox Film* Court was content to equate copyright law with patent law, and subsequent courts have been content to equate the language of that Court with the ubiquitous right to exclude.210 While this Author does not agree with either legal conclusion, accepting the easy parallelism between the two forms of law would also require acceptance of the robust availability in copyright law of compulsory licensing as a judicial remedy for a patentee’s anticompetitive refusal to deal.211 The right to exclude in patent law is checked by the


> It is true that common-law copyright was often enlisted in the service of personal privacy. In its commercial guise, however, an author’s right to choose when he will publish is no less deserving of protection. The period encompassing the work’s initiation, its preparation, and its grooming for public dissemination is a crucial one for any literary endeavor. The Copyright Act, which accords the copyright owner the “right to control the first public distribution” of his work, echoes the common law’s concern that the author or copyright owner retain control throughout this critical stage. The obvious benefit to author and public alike of assuring authors the leisure to develop their ideas free from fear of expropriation outweighs any short-term “news value” to be gained from premature publication of the author’s expression. The author’s control of first public distribution implicates not only his personal interest in creative control but his property interest in exploitation of prepublication rights, which are valuable in themselves and serve as a valuable adjunct to publicity and marketing. Under ordinary circumstances, the author’s right to control the first public appearance of his undisseminated expression will outweigh a claim of fair use.

*Id.* (internal citations omitted).


211 See, e.g., *Image Tech. Servs., Inc. v. Eastman Kodak Co.*, 125 F.3d 1195, 1219–20 (9th Cir. 1997). In *Kodak*, the Ninth Circuit affirmed the lower court’s finding of an anticompetitive refusal to license their patents:

*Kodak* photocopy and micrographics equipment requires thousands of parts, of which only 65 were patented. Unlike the other cases involving refusals to license patents, this case concerns a blanket refusal that included protected and unprotected products. From this evidence, it is more probable than not that the jury would have found Kodak’s presumptively valid business justification rebutted on the grounds of pretext.

*Id.* The court then reviewed the lower court’s grant of an injunction compelling Kodak to license its patents to the plaintiff. *Id.* at 1224 ("Last,
possibility of a court imposing a compulsory license if a patentee abuses the government-granted right; surely the same right granted to copyright owners\(^\text{212}\) should be checked by the same remedy.

2. Deposing the Stewart Dynasty

In order for a judge to apply the eBay factors to effectuate a limitation on an author’s right to hoard, that judge must also cope with the fairly explicit language in Stewart asserting that an author does, indeed, have the right to hoard his work for the entire term of copyright protection.\(^\text{213}\) Getting past this language can be accomplished in one of several ways.

First, like Fox Film, the hoarding language in Stewart is dicta incidental to the holding of the case. Further, as one commentator notes, because the case was specifically about an author’s heirs retaining the ability to exercise their renewal right, Justice O’Connor’s language can be interpreted to refer only to an author’s (or the author’s surviving heirs’) right to hoard his renewal right for the full copyright term.\(^\text{214}\) In other words, Justice O’Connor may

\(^{212}\) Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 425 (1908) ("[W]henever this court has had occasion to speak, it has decided that an inventor receives from a patent the right to exclude others from its use for the time prescribed in the statute.").


\(^{214}\) Parrish, supra note 129, at 579–80. Parrish writes:

It is possible, since the question in Stewart concerned licensing for the renewal term, that Justice O’Connor meant that an author could hoard the right of renewal. This narrow interpretation would be more in keeping with constitutional goals, because the work would already have been published and any further progress during the renewal period would be minimal. If authors were allowed to hoard their works at any time, however, progress certainly would not be promoted. It is difficult to promote progress if a work is not disseminated to the public. Justice O’Connor indicated that the
have been protecting the initial purpose of the renewal right—to allow authors a way to remove themselves and their work from unremunerative transfers and renegotiate on more favorable terms after a work is successful—by signaling that an author’s heirs may not be compelled to re-license a work’s renewal term if the provisions of the deal are not favorable enough. Even if the Stewart language was read more broadly to apply to all implicated rights, not just the renewal term, the only right at issue in the case was the renewal term of the derivative right. As established above, the right to hoard is most justified when it implicates the derivative right, but significantly less justified when it implicates any of the other rights, particularly those that cut to the heart of a given work (the display right for pictorial, graphic, or sculptural works, for example). A future court could find an author’s unwillingness to license derivative works based on their preexisting work (like J.D. Salinger) completely consistent with the Stewart holding and justified under a property rights analysis. But the same court could find that same author’s unwillingness to distribute the work to the public in any form (say, an author’s own refusal to distribute the work accompanied by a refusal to license the distribution right to a willing publisher), where such a work had already been “published” in some way (possibly by an earlier but now out-of-print release), contrary to public policy. In this later scenario, a rogue publisher who violates the author’s distribution right would still be infringing;

statutory term limit is adequate to promote progress. Yet, as copyright terms increase this provides rather flaccid protection. Id. (footnotes omitted).

215 See id.

216 See Gervais, supra note 164, at 805–10 (offering six principles and a mode of analysis to distinguish between the derivative right and the reproduction right); supra Part III.C.

217 See Salinger v. Colting, 607 F.3d 68, 81 (2010) (“The plaintiff’s interest is, principally, a property interest in the copyrighted material.”); see also Salinger v. Colting, 641 F. Supp. 2d 250, 268 (S.D.N.Y. 2009), vacated on other grounds, 607 F.3d 68 (“Just as licensing of derivatives is an important economic incentive to the creation of originals, so too will the right not to license derivatives sometimes act as an incentive to the creation of originals.”).
the court would merely assign damages in the form of a reasonable royalty with no injunctive relief, effectively sanctioning infringement in limited circumstances such as this one for the price of a fair license.

Second, the Stewart Court’s treatment of Rohauer is instructive. Although the two cases reached opposite conclusions regarding the same issue (whether legally withdrawing the underlying rights from a derivative work can prevent the derivative work author from continuing to distribute the work), Stewart declined to overrule the earlier Second Circuit case. Instead, the Court noted that “the Rohauer rule is considered to be an interest-balancing approach” and that it “ma[de] little sense when applied across the derivative-works spectrum.” By explicitly noting that, “[w]hile the result in Rohauer might make some sense in some contexts, it makes no sense in others,” the Stewart court was implicitly approving such a balancing-of-the-interests approach. In this way, Stewart would implicitly support the policy-balancing approach of eBay detailed above in determining the necessary remedy in a right-to-hoard infringement case, and would, in fact, have very little to say about the remedy itself—the Stewart language applies only to whether or not infringement occurred at all.

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218 See Stewart v. Abend, 495 U.S. 207, 227 (1990). Though Justice O’Connor is far from convinced that Rohauer was decided correctly (“[N]either the 1909 Act nor the 1976 Act provides support for the theory set forth in Rohauer”; “[T]he approach set forth in Rohauer is problematic”), she declines to overrule it, and instead minimizes its effect on the current law, (“While the result in Rohauer might make some sense in some context it makes no sense in others”; “Rohauer did not announce a ‘rule,’ but rather an ‘interest-balancing approach’” (citing Jaszi, When Works Collide: Derivative Motion Pictures, Underlying Rights, and the Public Interest, 28 UCLA L. Rev. 715, 758–61 (1981))). Ultimately, rather than overruling it, she refers to the Rohauer holding as “modest.” Id. at 230.

219 Stewart, 495 U.S. at 209.

220 The Rohauer court ruled based on the fact-specific policy interests of that case, but those same interests were different (because the facts were necessarily different) in Stewart, necessitating a different result. Id. at 227.

221 Id. at 216 (“The Court of Appeals also addressed at length the proper remedy, an issue not relevant to the issue on which we granted certiorari.”).
Finally, though nearly sixty years more recent than *Fox Film*, the *Stewart* precedent faces the same issue as the Lochner-era case: it is too old. Times have changed. The Court argues, “[I]t is not our role to alter the delicate balance Congress has labored to achieve.” Yet since that 1990 decision the balance has altered; all copyright terms were extended by twenty years in 1998, greatly reducing the present “public benefit” (i.e., value) of a work that will be unavailable to the public until it enters the public domain at the end of its copyright term. Where the balancing of the interests has changed so explicitly, and where an author is not holding out for better negotiating terms (as in *Stewart*), but instead simply issuing a blanket refusal to make their works available under any circumstances, the *Stewart* reasoning does not withstand the test of time. *Stewart* should not prove an obstacle to a court’s ability to award a reasonable royalty for the continued use of a previously hoarded work by an infringer.

B. Preventing the Right to Hoard Internationally

Although protection against hoarding would be difficult to achieve statutorily in the United States, model language for such a provision already exists internationally. Article III of the Appendix to the Berne Convention outlines an opt-in system by which developing countries may require that any work by a national of that country that is published, but not made available to the public for five years following the date of first publication (or seven years in the case of fiction, poetry, music, drama, or art books) be made available via a nonexclusive license to the public at large of that country “at a price reasonably related to that normally charged in the country for comparable works.” This provision was designed

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as a means by which authors of developing countries may derive some income where they lack the means to reproduce and distribute their work (and large-scale creative distributors are scarce), but such a provision could apply with equal force to a non-developing country as well. Countries with a strong moral rights basis for their copyright laws are less likely to adopt such a provision, as it could be viewed as taking a right away from authors (the unequivocal right to exclude), which moral rights countries (and, truthfully, utilitarian countries as well) are disinclined to do.

Nevertheless, the fact that such language already exists in an international agreement lays the groundwork for a broader limitation on an author’s right to hoard that could be implemented in the future. As currently written, Appendix Article III of Berne is protective of authors who lack the means or understanding to monetize their work. If such a scheme can be considered helpful to authors and to a national creative economy in one country, it can hardly be considered injurious to authors and users in another country, even one with a more established creative economy. After all, an author need only make his work available on his own terms within a generous seven-year time frame in order to render the provision moot; this provision, if expanded to all Berne member countries, would only go into effect (once a country were to adopt the Berne language into its own legislation) on the rare occasion that an author publishes a work but does not release it to the public. Such an experiment should lead to increased access and, most importantly for the United States’ utilitarian-based copyright scheme, an additional incentive for an author to affirmatively monetize his work.

V. Conclusion


224 Id.
Blanket hoarding of creative work does not occur very often. Copyright authors and owners are generally motivated by a desire to profit from the release of copyrighted work to the public in some form. But authors and copyright owners do remove public access to creative works from time to time, whether to increase demand for the work, respond to market forces, or simply to reflect the creative dissatisfaction of the author. Regardless of the motivation, however, the removal of public access to a creative work is undoubtedly injurious to the public, and the ever-receding moment in time where such a work will enter into the public domain offers a virtually nonexistent chance that the public will ever be able to recapture the work.

An author or copyright owner should not be permitted to prevent public access to a creative work, once published. Such behavior is contrary to a proper analysis of copyright as property and is similarly contrary to the utilitarian justifications for the US copyright scheme. The Supreme Court language ostensibly espousing an authorial right to hoard has been misinterpreted for decades and in any event has long passed the point of relevance under the current US copyright system. Judges faced with infringement suits in these circumstances should use the flexibility afforded to them in eBay to award a reasonable royalty for the distribution of a previously hoarded work, rather than preventing public distribution via an injunction. In the long term, the United States, along with its fellow Berne member countries, should consider adopting statutory language similar to the provision in Appendix Article III of the Berne Convention permitting statutory licensing of published but unavailable creative works in developing countries. Without some affirmative steps to protect the public, the increasing scope of author protection combined with the increasing term of copyright protection endangers all public access to creative work—the very premise on which US copyright law is based.