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THE OBSCENITY DEFENSE TO COPYRIGHT REVISITED*

INTRODUCTION

In the past, courts and commentators alike have generally presumed, without substantial question, that works of an obscene or immoral nature are beyond the purview of the protection afforded by copyright law.¹ The Court of Appeals for the Fifth Circuit, however, recently dealt a serious blow to the vitality of that presumption in *Mitchell Brothers Film Group v. Cinema Adult Theater*.² In reversing the district court's finding that the movie involved in *Mitchell Brothers* was obscene and therefore unworthy of protection,³ the court of appeals held that the copyright statute does not except obscene works from protection,⁴ that the Constitution does not require such an exception,⁵ and that no doctrine of judicial creation

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¹ See generally A. LATMAN, *HOWELL'S COPYRIGHT LAW* 45 (4th ed. 1963); 1 M. NIMMER, *ON COPYRIGHT* 2-193 (1979); Rogers, *Copyright and Morals*, 18 MICH. L. REV. 390 (1920); Note, *Immorality, Obscenity, and the Law of Copyright*, 6 S.D. L. REV. 110 (1961); Comment, *Copyright—The Obscenity Defense in Actions to Protect Copyright*, 46 FORDHAM L. REV. 1037 (1978); Comment, *Constitutional Protection of Obscene Material Against Censorship as Correlated with Copyright Protection of Obscene Material Against Infringement*, 31 S. CAL. L. REV. 301 (1958). But see Schneider, *Authority of the Register of Copyrights to Deny a Claim to Copyright on the Ground of Obscenity*, 51 CHI.-KENT L. REV. 691 (1975).

² 604 F.2d 852 (5th Cir. 1979), cert. denied, 445 U.S. 917 (1980). The *Mitchell Brothers* case involved a movie registered with the United States Copyright Office in 1973. Mitchell Brothers was granted the exclusive right to exhibit and distribute the work, which it proceeded to do in New York. The operator of Cinema Adult Theatres obtained several copies of the work and screened it in Dallas, Texas, where the litigation arose.

³ The district court found the movie, *Behind the Green Door*, to be obscene, even though no expert testimony was heard on the issue, and held that the finding precluded copyright protection. The movie was described by the trial judge as follows: "the dominant theme of the movie is the portrayal of various sexual acts by a female person with a multitude of persons, both male and female. The movie portrays the genital parts of both sexes, acts of fellatio and cunnilingus, and seminal fluid." 192 U.S.P.Q. (BNA) 138, 140 (N.D. Tex. 1976).

⁴ 604 F.2d at 854-58.

⁵ *Id.* at 858-60.

bars the granting of relief to the holder of a copyright whose obscene work has been infringed.⁶

This radical departure from preexisting law necessitates a reevaluation of the obscenity defense to copyright infringement actions. At the outset it should be noted that the issue is not whether obscene material is good or evil;⁷ rather, assuming such material to be evil, the question becomes whether the fact that a particular work is obscene is relevant to its treatment under copyright law. This comment will explore further the issues treated in *Mitchell Brothers* and will demonstrate that the rule of that case should be adopted by other courts because (1) the modern legal view of obscenity renders the defense incompatible with the purpose of copyright law, (2) the defense was erroneously established from the start, and (3) the encouragement of obscenity is one paradoxical result of the obscenity defense to copyright infringement actions. The rational starting point for such an inquiry is the historical origin of the obscenity defense in an action for infringement of copyright.

I. THE HISTORICAL BASIS FOR THE DOCTRINE

The obscenity defense to copyright infringement actions originated in England,⁸ and the first American case to consider the question was *Martinetti v. Maguire*.⁹ The plaintiff in *Martinetti* asserted that the defendants' play, *The Black Rook*, infringed on his copyright to a play entitled *The Black Crook*. The court had no difficulty in finding the former to be essentially an imitation of the latter but still denied the requested temporary injunction. The court seized upon the statutory language "dramatic composition" and "suited for public

⁶ *Id.* at 861-65.

⁷ The controversy concerning the regulation of obscenity is another subject within itself, and an analysis of the issues will not be attempted here. For a general discussion of the debate, see THE REPORT OF THE COMMISSION ON OBSCENITY AND PORNOGRAPHY 37-52 (Stein & Day ed. 1970).

⁸ For a general discussion of the development of the English rule in this regard, see E. DRONE, THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS 185-87 (1879); Phillips, *Copyright in Obscene Works: Some British and American Problems*, 6 ANGL. AM. L. REV. 138 (1977); Schneider, *supra* note 1, at 693-97.

⁹ 16 F. Cas. 920 (C.C. Cal. 1867) (No. 9,173).

representation" in finding the plaintiff's work to be outside the protection of the statute.¹⁰ The court was not satisfied with its statutory solution, however, but continued with a discussion of the constitutional limits on the power of Congress. According to the *Martinetti* court, each work in some way must promote the progress of the sciences and useful arts before copyright protection can be extended, and immoral writing was deemed incapable of promoting such progress.¹¹

¹⁰ *Id.* at 922. There is little reason to believe that the decision was based on other than statutory grounds. The court commenced its analysis by stating:

On the other hand, if this play is a "dramatic composition," within the purpose and meaning of the act of congress (4 Stat. 436; 11 Stat. 138), the motion of the complainants—Maguire et al.—for an injunction against Martinetti et al. should be allowed. But as at present advised, I do not think it such a composition. All the witnesses agree—particularly the experts—that the so-called play of the Black Crook has no originality, and that it consists almost wholly of scenic effects, or representations taken substantially from well known dramas and operas.

. . . .

But further, the act of congress provides that a "dramatic composition" to be entitled to be copyrighted, must be "suited for public representation." What is intended by the word "suited?" Simply that the composition is technically adapted to the stage, and capable of being produced upon it? While it means this, I am inclined to think it means something more; that to be suited to public representation, it must be fit to be represented.

Id.

¹¹ The strict construction imposed upon the Constitution by the *Martinetti* court is demonstrated by the following:

Hence, it expressly appears that congress is not empowered by the constitution to pass laws for the protection or benefit of authors and inventors, except as a means of promoting the progress of "science and useful arts." . . . So with a dramatic composition which is grossly indecent, and calculated to corrupt the morals of the people. The exhibition of such a drama neither "promotes the progress of science or useful arts," but the contrary. The constitution does not authorize the protection of such productions, and it is not to be presumed that congress intended to go beyond its power in this respect to secure their "authors and inventors the exclusive right" to the use of them. Upon this ground, I very much doubt whether the spectacle of the Black Crook is entitled to the benefit of copyright, even if it were admitted that it was a "dramatic composition."

Id.

In 1898 the use of the words "[s]he's the hottest thing you ever seen" rendered an otherwise proper song unprotectable, the court relying on *Martinetti*. *Broder v. Zeno Mauvais Music Co.*, 88 F. 74, 78 (C.C.N.D. Cal. 1898). In holding the "immoral" character of the song to be a defense, the court did not state a basis for its finding other than citation. *Id.* at 78-79. It appears that the court placed its primary reliance on the analysis of Professor Drone. *See E. DRONE, supra* note 8, at 181-85. In addi-

The Copyright Act of 1909¹² substantially changed the scope of copyright protection afforded. The 1909 Act removed any suggestion of content-based restriction, stating "that the works for which copyright may be secured under this Act shall include all the writings of an author."¹³ Despite this alteration, subsequent cases suggesting or holding that a copyright may not be secured for an obscene work mechanically applied *Martinetti* without considering the statutory changes.¹⁴

tion to *Martinetti*, the court referred to two English cases, *Lawrence v. Smith*, 37 Eng. Rep. 928 (Ch. 1822) (blasphemous work not copyrightable) and *Walcot v. Walker*, 32 Eng. Rep. 1 (Ch. 1802) (libelous work not copyrightable). These cases stand for the proposition that there is no property right in an immoral work. The court also referred to *Shook v. Daly*, 49 How. Pr. 366 (N.Y. Sup. Ct. 1875), presumably for the proposition that the judiciary serves the role of a conservator of public morals. No mention of the statute was made, even though it had been amended since the decision in *Martinetti*. 16 Stat. 192, 212-16 (1870) (current version at 17 U.S.C. §§ 1-810 (1976)).

The influence of *Martinetti* also may be found in two federal cases decided in New York in 1903 and 1913. In *Barnes v. Miner*, 122 F. 480 (C.C.S.D.N.Y. 1903), the court held that a sketch showing quick changes of costume, and consequently portions of human anatomy, could not constitutionally be the basis of a federal copyright, citing *Martinetti* and *Broder*. In *Hoffman v. Le Traunik*, 209 F. 375 (N.D.N.Y. 1913), the court noted that "[t]o be entitled to be copyrighted, the composition must be original, meritorious, and free from illegality or immorality," but the court cited no authority for this proposition. *Id.* at 379. *But see* *Bleistein v. Donaldson Litho. Co.*, 188 U.S. 239 (1903).

¹² Act of March 4, 1909, ch. 320, 35 Stat. 1075 (current version at 17 U.S.C. §§ 1-810 (1976)) [hereinafter cited as 1909 Act].

¹³ 1909 Act, *supra* note 12, § 4.

¹⁴ While several cases have discussed the issue of obscenity under the 1909 Act, none have decided the issue without considering the question to be one of protecting the public from its own lack of "morals" or one of equity. See note 17 *infra* for a discussion of equity's role in copyright protection. In *Simonton v. Gordon*, 12 F.2d 116 (S.D.N.Y. 1925), the court found that the play *White Cargo* infringed the copyright to the book entitled *Hell's Playground*. The latter expressed a view of morality as a relative concept, demonstrating the point by depicting interracial sex in Africa. The court acknowledged the existence of the obscenity defense and then stated:

Whatever may be the view of a prudist with respect to *Hell's Playground*, I think that the book, when judged by the standards of current literature, should not be held to be unentitled to copyright protection.

In any event, so far as morality is concerned, the play is no improvement upon the book, and for such reason I believe that any doubt as to the validity of the defense, based upon the alleged immorality of the book, should be resolved in favor of complainant.

Id. at 124. While the case primarily represents the changing view of the definition of obscenity, the court's willingness to compare the morality of the two writings is interesting. Arguably, the court viewed the rule as applicable only if the infringing work

Mitchell Brothers ended this unquestioned adherence to the *Martinetti* rule.

II. MODERN VITALITY OF THE DOCTRINE

Although the vitality of the obscenity defense had been generally accepted prior to *Mitchell Brothers*, the court in that case had little difficulty justifying its departure from precedent. An analysis of the doctrine's theoretical foundation supports the Fifth Circuit's position and further indicates that the foundation may not have been as firm as has often been presumed.

Historically, the obscenity defense has had three doctrinal bases: (1) statutory construction,¹⁵ (2) constitutional limitation of congressional power,¹⁶ and (3) the common law.¹⁷

was an attempt to "clean up" the obscene work from which it was copied, which would be consistent with the general application of the equitable maxim of unclean hands. H. McCLINTOCK, *HANDBOOK OF THE PRINCIPLES OF EQUITY* § 26 (2d ed. 1948). In *Cain v. Universal Pictures Co.*, 47 F. Supp. 1013 (S.D. Cal. 1942), the court found no infringement. By way of an aside, the court quoted the statement in *Richardson v. Miller*, 20 F. Cas. 722, 723 (C.C.D. Mass. 1877) (No. 11,791), that "[c]ourts of justice will not lend their aid to protect the authors of immoral works." 47 F. Supp. at 1018. The court did not discuss the roles of the statute or the Constitution. Another court found the subject work to have a "libidinous effect." *Khan v. Leo Feist, Inc.*, 70 F. Supp. 450, 458 (S.D.N.Y. 1947). The court again cited no authority for the existence of the obscenity defense doctrine, nor was the theoretical basis for the rule announced. In *Bullard v. Esper*, 72 F. Supp. 548 (N.D. Tex. 1947), the court's holding was that no infringement had occurred. *Id.* at 549. The court nonetheless discussed the morality of the film, which had been previously seized by local officials for indecency. See also *Dane v. M.&H. Co.*, 136 U.S.P.Q. (BNA) 426 (N.Y. Sup. Ct. 1963), involving a common law copyright.

¹⁵ See note 10 *supra* for the *Martinetti* court's statutory analysis.

¹⁶ See note 11 *supra* for the constitutional basis of the doctrine.

¹⁷ See *Schneider*, *supra* note 1, at 694-96 for a general discussion of the doctrine as a common law rule.

A fourth basis may be deduced from a line of cases which invoke the equitable maxim of unclean hands. The doctrine of unclean hands is applicable to a copyright infringement action, at least where equitable relief is sought. 3 M. NIMMER, *supra* note 1, § 13.09B. The doctrine is generally limited to instances in which the conduct complained of has a direct bearing on the transaction that forms the basis for the suit, not on some general wrong or lack of character. See *Chafee, Coming into Equity with Clean Hands*, 18 MICH. L. REV. 1065 (1949). This principle is generally borne out by the cases discussing the doctrine in the context of copyright. Thus a copyright will not be enforced where the owner has received his rights from the creator who had breached a contract with the infringing party, giving the latter exclusive rights to the copyrighted material. *T.B. Harms v. Stern*, 231 F. 645 (2d Cir. 1948). Wrongful con-

Each of these doctrinal underpinnings will be examined.

A. *Statutory Limitations*

1. *Statutory History*

The original copyright statute as enacted in 1790 was limited in scope to specifically enumerated types of writings.¹⁸ The 1790 Act was modeled after an English statute,¹⁹ the wording of which has been said to be responsible for the *Martinetti* rule.²⁰ In 1831 the copyright statute was revised and

duct which induces the infringement may preclude equitable relief. *Tempo Music, Inc. v. Myers*, 407 F.2d 503 (4th Cir. 1969); *Davis v. DuPont de Nemours & Co.*, 240 F. Supp. 612 (S.D.N.Y. 1965). *But see* *Big Sky Music v. Todd*, 388 F. Supp. 498 (S.D. Ga. 1974). The principle will apply where the holder of the copyright has falsified information to the Copyright Office. *Vogue Ring Creations, Inc. v. Hardman*, 410 F. Supp. 609 (D.R.I. 1976); *International Biotical Corp. v. Associated Mills, Inc.*, 239 F. Supp. 511 (N.D. Ill. 1964). *But see* *Neal v. Glickman*, 391 F. Supp. 1088 (N.D. Tex. 1975). The commission of fraud on the court may invoke the maxim. *Jondora Music Pub. Co. v. Melody Recordings, Inc.*, 351 F. Supp. 572 (D.N.J. 1972); *Higgins v. Baker*, 309 F. Supp. 635 (S.D.N.Y. 1969). The court may likewise consider the motive for bringing the infringement action in the course of weighing the equities of the parties. *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 311-13 (2d Cir. 1964) (Lunbard, C.J., concurring); *Nom Music, Inc. v. Kaslin*, 227 F. Supp. 922 (S.D.N.Y. 1964). The significant thread running through each of these cases is that in none was the content of a writing sufficient to invoke the doctrine; each required some specified conduct that affected the infringement.

In the few cases prior to *Mitchell Brothers* which raised the doctrine of unclean hands relative to the content of a work, the ground generally alleged was that the work was fraudulent. The issue was first raised in *Stone & McCarrick v. Dugan Piano*, 220 F. 837 (5th Cir. 1915), wherein the court stated in dictum that a work which perpetrated a fraud on the public would not be protected in a court of equity. Without discussing the doctrine of unclean hands, another court in 1939 issued an injunction notwithstanding its finding that the work was fraudulent. *Deutsch v. Fulton*, 27 F. Supp. 895 (E.D.N.Y. 1939). In 1973 the Ninth Circuit expressly declined to follow *Stone & McCarrick* and enjoined the infringement of a writing which fraudulently represented that a user could "beat the horses." *Belcher v. Tarbox*, 486 F.2d 1087 (9th Cir. 1973).

The *Mitchell Brothers* court went well beyond overruling its prior statement in *Stone & McCarrick* and strenuously argued against its vitality in the first instance. 604 F.2d at 863-64. Thus, at present, no case can be cited as authority for the proposition that the content of a work affects the equities of the parties in an infringement action.

¹⁸ Act of May 31, 1790, ch. 15, 1 Stat. 124 (current version at 17 U.S.C. §§ 1-810 (1976)).

¹⁹ An Act for the Encouragement of Learning, 8 Anne, c. 19 (1709).

²⁰ E. DRONE, *supra* note 8, at 1. A statute modeled after a prior English statute brings the English construction with it. *Pennock v. Dialogue*, 32 U.S. (7 Pet.) 1, 18

musical compositions were included within its scope.²¹ The 1831 Act was amended in 1856 to extend copyright protection "to the author or proprietor of any dramatic composition, designed or suited for public representation."²² The *Martinetti* court construed this statute to preclude the protection of a work which was "immoral." While the construction placed upon the statute by the *Martinetti* court was probably faulty from the start,²³ the troublesome question is whether this construction was later accepted by Congress, becoming by implication a part of the statute.²⁴

The copyright statutes underwent extensive revision in 1870.²⁵ The statute again enumerated specific types of writings and qualified those by the phrase "intended to be perfected as works of the fine arts."²⁶ Arguably, this revision incorporated the *Martinetti* rule, in that the term "fine arts" is considerably more suggestive of a content requirement than the deleted phrase "designed or suited for public representation." It is equally plausible, however, that Congress intended that the author's intent be the controlling factor rather than whether the work could ultimately be categorized as fine art. In any event, the Supreme Court did not agree that the phrase imposed a content-based restriction.²⁷

(1829). The more prevalent view appears to be, however, that the doctrine arises from the common law. See note 67 *infra* for a discussion of this point.

²¹ Act of Feb. 3, 1831, ch. 15, 4 Stat. 436 (current version at 17 U.S.C. §§ 1-810 (1976)).

²² Act of Aug. 18, 1856, ch. 169, 11 Stat. 138 (current version at 17 U.S.C. §§ 1-810 (1976)).

²³ The *Martinetti* court utilized the phrase "suited to public representation" and construed "suited" to be synonymous with "fit." See note 10 *supra* for the court's analysis. The statute actually read "designed or suited to public representation." Act of Aug. 18, 1856, ch. 169, 11 Stat. 138. Read as a whole, the phrase is indicative of an intent to define the term "writing," as used in the statute, from the standpoint of the technology involved. Viewed in this light, the *Martinetti* holding was erroneous, and that the court felt it necessary to discuss constitutional limitations lends credence to the argument that the court strained for its construction of the statute.

²⁴ *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1, 14 (1907) (viewing congressional silence as acquiescence to prior English and American cases on point).

²⁵ Act of July 8, 1870, ch. 230, 16 Stat. 198 (current version at 17 U.S.C. §§ 1-810 (1976)).

²⁶ *Id.* at 386.

²⁷ *Bleistein v. Donaldson Litho. Co.*, 188 U.S. 239 (1903). Justice Holmes wrote

President Theodore Roosevelt called for extensive copyright reform in 1905,²⁸ and the resulting 1909 Act differed from previous statutes by setting forth an all-inclusive grant of protection²⁹ followed by eleven categories specifically designated as nonexclusive.³⁰ The 1909 Act allowed no implication of a content-based restriction. The enumerated specifications related to the technique by which the expression occurred rather than to the relative merit of the expression itself. With no specified limitation on content, the phrase "all the writings" would appear to provide a definitive answer to the question of scope.³¹

2. Legislative History

The question is raised, however, by the Act's legislative history. The final draft of the bill was accompanied by a report³² which stated:

Section 4 is declaratory of existing law. It was suggested that the word "works" should be substituted for the word "writ-

for the Court:

The antithesis to "illustrations or works connected with the fine arts" is not works of little merit or of humble degree, or illustrations addressed to the less educated classes Certainly works are not the less connected with the fine arts because their pictorial quality attracts the crowd and therefore gives them a real use

Id. at 250.

²⁸ H.R. REP. NO. 2222, 60th Cong., 2d Sess. 12 (1909) [hereinafter referred to as 1909 Report]. See note 109 *infra* for Roosevelt's thoughts on the need for copyright law revision.

²⁹ "[T]he works for which copyright may be secured under this title shall include all the writings of an author." 1909 Act, *supra* note 12, § 4.

³⁰ Section 5, after enumerating the 11 classifications of writings, provided "[t]hat the above specifications shall not be held to limit the subject-matter of copyright as defined in section four of this Act." *Id.* § 5.

³¹ See 604 F.2d at 860. Section 5 was enacted for the convenience of the Copyright Office and was not intended to modify § 4. 1909 Report, *supra* note 28, 10. However, § 4 must be read in light of prior decisions construing the term "writings" under former statutes, and for that reason the statutory use of the term "writings" is thought to be less inclusive than its counterpart in the Constitution. SENATE COMMITTEE ON THE JUDICIARY, 86TH CONG., 2D SESS., COPYRIGHT LAW REVISION 74-75 (1960). Once it is determined that the work in question is a writing within the meaning of the statute, the statute provides that *all* such writings *shall* benefit from copyright protection. 1909 Act, *supra* note 12, § 4.

³² 1909 Report, *supra* note 28.

ings," but it was thought better to use the word found in the Constitution. It is not intended by the use of this word to change in any way the construction which the courts have given it.³³

This statement raises the question whether Congress agreed with the cases raising obscenity as a defense. The most rational response is that the quoted statement refers to only that decisional law relevant to the context in which the statement was made.³⁴ Such an analysis would preclude the argument that Congress intended that the obscenity defense implicitly be a part of the statutory scheme.³⁵ The most that can be said is that Congress did not consider the matter. There is no mention of *Martinetti* or its progeny in the report, and Congress appears to have been concerned primarily with defining the term "writings."³⁶ Thus the Fifth Circuit's holding in *Mitchell Brothers* that there exists no statutory exception based on the morality of the work is justifiable, even if not compelled.

The Copyright Act of 1976³⁷ provides even less justification for an obscenity defense in that the legislative history specifically precludes consideration of the esthetic value of a particular work³⁸ and the statute itself contains all-inclusive

³³ *Id.* at 10.

³⁴ See A. LATMAN, *supra* note 1, at 16-21.

³⁵ The *Mitchell Brothers* court noted that the use of the word "all" did not constitute silence on this point but was an affirmative statement that content was immaterial to the existence of copyright. 604 F.2d at 854. This position is supported by statements in the legislative history of the Copyright Act of 1976 to the effect that esthetic merit is not a consideration. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 51, reprinted in [1976] U.S. CODE CONG. & AD. NEWS 5659, 5664. Significantly, the language used refers to the absence of content requirements as the status quo and does not purport to change the standard. Thus, even though the 1909 Report fails to mention this issue, Congress in 1976 did not consider content to be a factor under the 1909 Act. See H.R. REP. NO. 2237, 89th Cong., 2d Sess. 42 (1966).

³⁶ See SENATE COMMITTEE ON THE JUDICIARY, 86TH CONG., 2D SESS., COPYRIGHT LAW REVISION 73-83 (1960).

³⁷ 17 U.S.C. §§ 1-810 (1976) [hereinafter referred to as 1976 Act].

³⁸ H.R. REP. NO. 1476, 94th Cong., 2d Sess. 51, reprinted in [1976] U.S. CODE CONG. & AD. NEWS 5659, 5664. Interestingly, the lack of serious literary, artistic, scientific or political value is necessary to find a work obscene in the context of criminal statutes. See text accompanying note 97 *infra* for a discussion of the test. Thus, determining the moral nature of a work requires a consideration of factors which are specifically stated to be immaterial. This fact in and of itself adds great weight to the

terminology, as did the 1909 Act.³⁹ Even if the statutory language and the corresponding history is not dispositive of the issue, an examination of analogous statutory enactments supports the view that Congress has never intended copyright law to have a censorship function.

3. *Analogous Statutory Enactments*

Morality is interposed over two other statutory schemes that are to some degree related to copyright law. Both trademark law⁴⁰ and patent law⁴¹ grant a limited legal monopoly to achieve a particular end. An examination of the role of morality in these two areas suggests several possible reasons for the absence of moral undertones in copyright law and explains Congress' failure to legislate expressly on the question.

a. *Trademark Law*

Congress has specifically provided that a trademark which is obscene or immoral may not be registered.⁴² At com-

theory that the statute precludes the obscenity defense after 1976. See note 35 *supra* for a discussion of the proposition that this constitutes no change from prior law.

³⁹ The 1976 Act substitutes the word "works" for the term "writings" found in the 1909 Act so as to avoid the need for a judicial determination of the constitutional limitations on the term "writing" as found in the Constitution. H.R. REP. No. 1476, 94th Cong., 2d Sess. 51, reprinted in [1976] U.S. CODE CONG. & AD. NEWS 5659, 5664.

⁴⁰ Langham Act, 15 U.S.C. §§ 1051-150 (1976). For an excellent treatment of the subject, see J. MCCARTHY, TRADEMARKS & UNFAIR COMPETITION (1973).

⁴¹ Patent Act of 1952, 35 U.S.C. §§ 1-293 (1976). For a general treatment of patent law, see 1 A. DELLER, WALKER ON PATENTS (2d ed. 1964).

⁴² 15 U.S.C. § 1052(a) (1976) precludes registration of any mark which "[c]onsists of or comprises immoral, deceptive, or scandalous matter." The effect of this statute is at best uncertain. While nothing immoral was found in the mark "Libido" on perfume, *Ex parte Parfum L'Orle, Inc.*, 93 U.S.P.Q. (BNA) 481 (Comm. Pat. 1952), or the title "Week-end Sex" on a magazine, *In re Madsen*, 180 U.S.P.Q. (BNA) 334 (T.M.T. & App. Bd. 1973), the mark "Bubby Trap" for brassieres was denied registration on the grounds that the authors of Webster's dictionary considered "bubby" a vulgar term for a woman's breast. *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443 (T.M.T. & App. Bd. 1971). Professor McCarthy expressed his opinion of the latter case as follows:

These nineteenth century criteria for acceptable drawing room etiquette appear curiously out of place in twentieth century advertising media, where the female anatomy and sexual double-entendre often are used to sell goods. It is hoped that the brassiere symbolized by the mark BUBBY TRAP lends more support to its users than the reasoning of the Trademark

mon law, an immoral or obscene trademark also was denied protection.⁴³ Congress felt it necessary to expressly except obscene trademarks even though the common law was in accord. This specific exception suggests that the same would have been done with copyright law had Congress felt it desirable.⁴⁴ Moreover, the two statutes' different functions serve to explain the absence of a statutory defense of obscenity in copyright infringement actions.⁴⁵ The law of copyright seeks to encourage the expression of ideas, while trademark law serves to protect the public in its utilization of the marketplace as well as to protect the entrepreneur's investment in a particular mark.⁴⁶ Thus, there is less room for the fear that censorship will defeat the purpose of trademark legislation than there is in the case of copyright.⁴⁷

Board supports its moral judgments. Given the present vague state of the law of obscenity, it is difficult to conceive of many marks which could validly be rejected as being "immoral." Perhaps the use of the word "immoral" itself renders that ground void for vagueness.

J. McCARTHY, *supra* note 41, at § 19.28. The resulting burden on the Patent and Trademark Office as well as on the entrepreneur is clear, and while the burden may be tolerable in the case of trademark registration, the effects on copyright may be considerably more serious. See Schneider, *supra* note 1, at 718-21.

⁴³ See RESTATEMENT OF TORTS § 726 (1938).

⁴⁴ That Congress felt it necessary to specify the role of obscenity in trademark registration indicates that the same would have been done with copyright had Congress thought the defense appropriate. This is particularly true since Congress could have left it to the courts simply not to enforce the trademark. See note 43 *supra* for the common law rule in trademark law. Furthermore, the mere fact that a court has imposed a given rule has not prevented Congress from codifying the rule when it concurs in the wisdom of the rule. See text accompanying notes 56-58 *infra* for an example of such a situation in the context of copyright law.

⁴⁵ See J. McCARTHY, *supra* note 40, § 2.12 for a general discussion of the distinguishing characteristics of the two statutes.

⁴⁶ The holder of a trademark is not given an absolute monopoly in that mark, but is given the right to prevent the use of similar marks which might cause confusion in the marketplace. *Prestonettes, Inc. v. Coty*, 264 U.S. 359 (1924). The end to be achieved is economic, not cultural, and is not in the furtherance of science or the useful arts. *Trademark Cases*, 100 U.S. 82 (1879). A copyright, on the other hand, grants to the author a monopoly on the expression of an idea, leaving the idea itself in the public domain. *International News Service v. Associated Press*, 248 U.S. 215 (1918).

⁴⁷ See note 98 *infra* for a discussion of the relationship of copyright law and trademark law to the policy underlying the first amendment protection of speech.

b. Patent Law

Patent law is based on the same constitutional grant of power as is copyright,⁴⁸ and in the patent area, Congress has imposed no specific exception for discoveries with an illegal or immoral purpose.⁴⁹ Courts nonetheless will deny protection in such cases.⁵⁰ At first glance, these decisions would appear to support the vitality of the *Martinetti* rule. The means by which courts find the exception, however, provides a critical distinction.

The patent statute provides for the protection of "any new and useful process, machine, or composition matter."⁵¹ The courts' finding of an obscenity defense has been based on a statutory construction argument that a device is not useful if its sole function is illegal or immoral.⁵² Since 1909, the defense in copyright has no such basis in statutory language.⁵³ The copyright statute, however, does have an analogous limitation in that the work must be original,⁵⁴ and thus, to the extent that the bare portrayal of sex is not original,⁵⁵ copyright protection could not be limited as are patents.

Furthermore, the absence of any treatment of the obscenity defense by Congress may be reasonably construed as a rejection of the rule. The doctrine of fair use, an exception to the protection afforded by the grant of a copyright, was a judicially imposed doctrine which had no basis in the copyright statute.⁵⁶ Congress noted its agreement with the reason un-

⁴⁸ U.S. CONST. art. I, § 8, cl. 8. See generally 1 A. DELLER, *supra* note 41, at 72.

⁴⁹ 35 U.S.C. §§ 1-293 (1976).

⁵⁰ See 1 A. DELLER, *supra* note 41, at 526.

⁵¹ 35 U.S.C. § 101 (1976).

⁵² See 1 A. DELLER, *supra* note 41, at 526.

⁵³ See text accompanying notes 28-31 *supra* for a discussion of the basis for the defense in the language of the statute.

⁵⁴ 1 M. NIMMER, *supra* note 1, § 2.01.

⁵⁵ See note 92 *infra* for a discussion of the originality requirement as applied to obscene material.

⁵⁶ See 1 A. LATMAN, *supra* note 1, at 151-54 for a discussion of the doctrine as it was developed by the courts. "Fair use" includes quotations from a work in critical reviews, reproduction by a teacher for educational purposes, quotations in news reports and other such employment of a copyrighted work. See H.R. REP. No. 1476, 94th Cong., 2d Sess. 65-74, reprinted in [1976] U.S. CODE CONG. & AD. NEWS 5559, 5678-88, for examples of the "fair use" exception.

derlying that doctrine⁵⁷ and specifically provided for it in the Copyright Act of 1976.⁵⁸ A similar example may be found in the case of patent law.⁵⁹ Thus, when Congress wanted to include a judicially created defense in the statute, it has done so. Because copyright law has undergone two extensive revisions since *Martinetti*, Congress has had ample opportunity to incorporate an obscenity defense into the statutory framework if one were desired.

B. *Constitutional Limitations*

Notwithstanding the dictum found in *Martinetti*,⁶⁰ there is little modern support for the theory that the Constitution prohibits the copyright of work with obscene content.⁶¹ The strict construction placed on the patent and copyright clause by the *Martinetti* court, however, finds some support in the approach taken by the courts construing federal grants of power during the same period of history.⁶²

⁵⁷ *Id.*

⁵⁸ 17 U.S.C. § 107 (1976).

⁵⁹ The patent statutes underwent extensive revision in 1952. Act of July 19, 1952, ch. 950, 66 Stat. 798 (current version at 35 U.S.C. §§ 1-293 (1976)). Prior statutes made no provision for a requirement of nonobviousness, but the courts imposed the requirement for over 100 years. SEN. REP. No. 1979, 82nd Cong., 2d Sess. 62, reprinted in [1952] U.S. CODE CONG. & AD. NEWS 2394, 2399. Congress concurred in the wisdom of the rule and codified it in the 1952 revision. 35 U.S.C. § 103 (1976).

⁶⁰ See note 11 *supra* for the *Martinetti* court's constitutional analysis.

⁶¹ Professor Nimmer has suggested that the phrase "[t]o promote the progress of science and useful arts" be read as a preamble, indicative of purpose rather than limitation. 1 M. NIMMER, *supra* note 1, at 1-30. He further asserts that the denial of copyright protection to obscene works is, in the modern view, premised on statutory rather than constitutional grounds. *Id.* at 1-31. *Accord*, A. LATMAN, *supra* note 1, at 12.

⁶² See, e.g., Trademark Cases, 100 U.S. 82 (1879), (trademark legislation could not be based on the commerce clause, U.S. CONST. art. I, § 8, cl. 3, if it did not specifically exempt intrastate activity).

While the patent and copyright clause has not involved major constitutional issues in the past, there is no sound reason to believe that the construction given other grants of federal power in modern times would not apply with equal force to its scope. J. NOWAK, R. ROTUNDA & J. YOUNG, HANDBOOK ON CONSTITUTIONAL LAW 120 (1978). The commerce clause, U.S. CONST. art. I, § 8, cl. 3, is perhaps the sharpest example of this construction. The early view required that a particular act be directly related to interstate commerce to come within the purview of federal power if the regulated activity was not in the "stream of commerce." See 100 U.S. at 96-97. *Compare* Swift & Co. v. United States, 196 U.S. 375 (1905) with United States v. E. C.

The theory that a particular work must singularly promote the progress of science to receive protection can no longer be maintained under the modern approach to constitutional law. Rather, the question should be whether the granting of protection to a work bears a reasonable relationship to a constitutionally permitted objective.⁶³ Congress could reasonably find that the best way to promote the progress of the sciences is to protect all works.⁶⁴ Congress also could find

Knight Co., 156 U.S. 1 (1895). Since 1937, the Supreme Court has allowed Congress much greater latitude in determining whether a particular act bears a reasonable relationship to the enumerated power on which it is based or whether it is necessary and proper to the exercise of that power. The Supreme Court modified its view of the federal commerce power in *NLRB v. Jones & Laughlin Steel Corp.*, 301 U.S. 1 (1937), beginning the return to the Court's original view of the power as expressed in *Gibbons v. Ogden*, 22 U.S. (9 Wheat.) 1 (1824). With the removal of the tenth amendment as a bar to federal exercise of the commerce power, *United States v. Darby*, 312 U.S. 100, 123-24 (1941), the necessary and proper clause, U.S. CONST. art. I, § 8, cl. 18, regained the efficacy given it by Chief Justice Marshall in *McCulloch v. Maryland*, 17 U.S. (4 Wheat.) 415 (1819). See L. TRIBE, *AMERICAN CONSTITUTIONAL LAW* § 5-3 (1978). The modern test is couched in terms of "affecting commerce," a far cry from the original strict construction. Compare Trademark Cases, 100 U.S. 82 (1879) with *Heart of Atlanta Motel, Inc. v. United States*, 379 U.S. 241 (1964). Under this test, the Court has gone so far as to uphold the federal regulation of a wheat crop which was completely intrastate, on the premise that the failure so to regulate would affect interstate commerce. *Wickard v. Filburn*, 317 U.S. 111 (1942). Professor Tribe refers to this as the "cumulative effect" principle:

It is now established that Congress has the power to regulate not only acts which taken *alone* would have substantial economic effect on interstate commerce . . . but also acts which might reasonably be deemed nationally significant in their *aggregate* economic effect; the triviality of an *individual* act's impact is irrelevant so long as the *class* of such acts might reasonably be deemed to have substantial national consequences.

L. TRIBE, *supra* § 5-5 (emphasis in original).

⁶³ The reason for such a rule is apparent when the history of literature vis-a-vis obscenity regulation is considered. Copyright is essentially forward-looking in its nature, concerned with the development of learning rather than with the maintenance of the status quo. Thus, if the present level of development is not to be maintained, there must be room for creativity that, although not "acceptable" at present, may be of value to tomorrow's society. For a list of examples of works condemned at one time but of great current cultural significance, see 604 F.2d at 857-58.

⁶⁴ 604 F.2d at 860. This was the basis of the *Mitchell Brothers* court's holding. The court considered the statutory language conclusive and did not consider the more difficult question of whether Congress actually made such a determination as to obscene writings. The legislative history does not disclose any such determination, other than to point out that a work need not have any particular esthetic merit to qualify for copyright protection. H.R. REP. No. 1476, 94th Cong., 2d Sess. 51, *reprinted in* [1976] U.S. CODE CONG. & AD. NEWS 5659, 5664. It is only by implication that Con-

that the failure to protect obscene works could have a negative impact on the progress of the sciences.⁶⁵ Thus, in a modern context, the Constitution poses no bar to the granting of copyright protection to the obscene or immoral work.

C. Common Law Basis

It has been suggested that the obscenity defense came to American jurisprudence from the English common law and thus exists independently of statutory law.⁶⁶ A majority of the cases denying protection or suggesting that protection would be denied were the work immoral or obscene appear to have adopted this approach.⁶⁷ The *Mitchell Brothers* court noted two potential bases for such a rule.⁶⁸ The first is the English rule that no property right exists in a work which is immoral,⁶⁹ and the second might best be stated, as one court did, that "[c]ourts of justice will not lend their aid to protect the authors of immoral works."⁷⁰ The latter approach appears to

gress has determined that obscene works of no current literary value should be copyrighted so as to encourage the development of those with value. See note 39 *supra* for a discussion of the significance of this determination in light of modern obscenity law.

⁶⁵ 604 F.2d at 860. See note 101 *infra* for a discussion of the probable effect of the obscenity defense on copyright law.

⁶⁶ Schneider, *supra* note 1, at 694-96.

⁶⁷ No case since *Martinetti* has premised the obscenity defense on statutory construction and only three later cases intimate a constitutional basis for the doctrine. *Bullard v. Esper*, 72 F. Supp. 548 (N.D. Tex. 1947); *Barnes v. Miner*, 122 F. 480 (C.C.S.D.N.Y. 1903); *Dane v. M.&H. Co.*, 136 U.S.P.Q. (BNA) 426 (N.Y. Sup. Ct. 1963). See notes 11 and 14 *supra* for a general discussion of the bases for the obscenity defense in these cases.

⁶⁸ 604 F.2d at 861. The court also noted the equitable maxim of unclean hands, treated at note 17 *supra*.

⁶⁹ The *Mitchell Brothers* court dismissed this theory in a paragraph, concluding that the doctrine had not been accepted in the United States. 604 F.2d at 861. The court, by reference, took cognizance of the fact that Massachusetts had recognized the property theory by way of dictum in *Keene v. Kimball*, 82 Mass. (16 Gray) 545 (1860). See Schneider, *supra* note 1, at 697. However, the court apparently did not consider the implicit recognition of the property theory in *Broder v. Zeno Mauvais Music Co.*, 88 F. 74 (C.C.N.D. Cal. 1898). See note 11 *supra* for a discussion of *Broder*. But see *Belcher v. Tarbox*, 486 F.2d 1087 (9th Cir. 1973) (overruling *Broder* by implication).

⁷⁰ *Richardson v. Miller*, 20 F. Cas. 722, 723 (C.C.D. Mass. 1877) (No. 11,791). The underlying philosophy appears to be that the court has a duty to protect the public from (its own?) immorality. Schneider, *supra* note 1, at 694-96. The *Mitchell Brothers* court thought the theory was best described by the court in *Shook v. Daly*,

pervade American thought on this issue.⁷¹

The precise nature of the obscenity defense is unclear, but in England it appears to have been based primarily on a concern for the integrity of the court.⁷² The principle of stare decisis has given the defense a burdensome impact.⁷³ And it is questionable whether any particular act of Congress has repealed such a common law principle, in that implicit repeal of the common law is not favored.⁷⁴ Instead, the demise of the obscenity defense as it existed at common law is best predicated on the nature of the common law itself and on the changes in society and legal attitudes since the inception of the doctrine.

The common law is in essence the legal articulation of mankind's experience.⁷⁵ It is to that extent backward-looking.⁷⁶ The courts have long recognized the need for flexibility

49 How. Pr. 366 (N.Y. Sup. Ct. 1875), to the effect that "rights of the author are secondary to the right of the public, to be protected from what is subversive of good morals." *Id.* at 368.

⁷¹ This view is justified primarily by the failure of any American case expressly to recognize the property theory in a holding. Additionally, if the statute is given its plain meaning and the common law rule is viewed to be a limitation thereon, the property theory would be in direct contradiction with the statute, in that a copyright is a property interest in the expression of an idea and extends to all works of an author.

⁷² In *Stockdale v. Onwhyn*, 108 Eng. Rep. 65 (K.B. 1826), in support of a decision to deny relief, Chief Justice Abbott stated:

But upon the plainest principles of the common law, founded as it is, where there are no authorities, upon common sense and justice, this action cannot be maintained. It would be a disgrace to the common law could a doubt be entertained upon the subject; but I think that no doubt can be entertained, and I want no authority for pronouncing such a judicial opinion.

Id. at 66.

⁷³ See generally 20 AM. JUR. 2D *Courts* § 184 (1965).

⁷⁴ *Associated Trans. v. Pusey*, 118 A.2d 362, 364 (Del. 1955); *State v. Kollenborn*, 304 S.W.2d 855, 862 (Mo. 1957); *Smith v. United Properties, Inc.*, 209 N.E.2d 142, 144-45 (Ohio 1965). Furthermore, an affirmative statutory statement without a negative does not generally repeal the common law rule. *Commonwealth v. Barnett*, 245 S.W. 874, 877 (Ky. 1922). See note 31 *supra* for a discussion of the statute as amended in 1909. But see note 38 *supra* for a possible contrary view under the 1976 Act.

⁷⁵ O. HOLMES, *THE COMMON LAW* 1-2 (1881). See also Stone, *The Common Law in the United States*, 50 HARV. L. REV. 4 (1936).

⁷⁶ See, e.g., *Moore v. United States*, 91 U.S. 270 (1876) (holding that the Court of Claims, absent congressional expression, must follow the common law rules of evidence).

in the common law, understanding that the public is not served well by rules of law which restrain the growth and development of society.⁷⁷ Thus, while stability is encouraged through the principle of stare decisis, the courts have the inherent power to discontinue a rule of law when the logical support for it has eroded⁷⁸ or when the rule was wrongly developed from the start.⁷⁹ Furthermore, a federally created right should not be abrogated by the courts through the invocation of a common law rule which has outlived its usefulness and which is no longer reflective of experience.⁸⁰ To date, only one federal court of appeals may be said to recognize the obscenity defense,⁸¹ and no Supreme Court decision is on point. The obscenity defense as a common law rule, assuming it to have been sound once, no longer serves the purpose for which it is said to exist.⁸² To continue its application in the light of current views toward public morality⁸³ and in the view of the courts' current role in the establishment of moral standards⁸⁴

⁷⁷ *Baltimore & O. R.R. v. Baugh*, 149 U.S. 368, 371 (1893).

⁷⁸ *Funk v. United States*, 290 U.S. 371, 376-82 (1933).

⁷⁹ *See, e.g., Handeland v. Brown*, 216 N.W.2d 574 (Iowa 1974); *Faber v. Creswick*, 156 A.2d 252 (N.J. 1959).

⁸⁰ *Perma Life Mufflers, Inc. v. International Parts Corp.*, 392 U.S. 134, 138 (1968); *Wiederhold v. Elgin, Joliet & Eastern Ry.*, 368 F. Supp. 1054, 1060 (N.D. Ind. 1974).

⁸¹ The cases recognizing obscenity as a defense in the Fifth Circuit are clearly overruled by *Mitchell Brothers*. Cases arising within the Ninth Circuit in accord with the common law rule appear to be of little value after the decision in *Belcher v. Tarbox*, 486 F.2d 1087 (9th Cir. 1973). While the latter case concerned a work which was fraudulent rather than obscene, the rationale used by the court in reaching the result should be equally applicable to both areas. This leaves only district court cases within the Second Circuit, none of which is as recent as *Mitchell Brothers* or *Belcher*, upholding the common law rule as applied to federal copyright law.

⁸² *See note 86 infra* for a general discussion of the reasons for the obscenity defense.

⁸³ *Compare note 84 infra* stating the older view with text accompanying note 97 *infra* stating the modern view. *See also* 604 F.2d at 857-58.

⁸⁴ Since the most recent federal case favorably discussing the obscenity defense, the treatment of obscenity by the judiciary has undergone significant change. Each of those cases was decided when obscenity was defined by the English rule, as expressed in *R. v. Hicklin*, [1868] L.R. 3 Q.B. 360, that if certain passages had a tendency to deprave and corrupt the minds of those susceptible to such influences, the work was obscene. *See United States v. Bennett*, 24 F. Cas. 1093, 1103-04 (C.C.S.D.N.Y. 1879) (No. 14,571). The first hint of a role for the first amendment came in *United States v. Harmon*, 45 F. 414 (D. Kan. 1891), *rev'd on other grounds*, 50 F. 921 (C.C.D. Kan.

is to defy the common sense of the common law.

III. DESIRABILITY OF THE OBSCENITY DEFENSE

The remaining question is whether, on a policy basis, obscene content should serve as a bar to copyright protection.⁸⁵ In the final analysis, such a restriction does more harm than good, and the absence of the restriction, if anything, would assist in the control of obscenity in the United States. While the justification given by courts which have interposed the obscenity defense into copyright law is superficially appealing,⁸⁶ once it is recognized that obscenity is different from other work which lacks literary value the absurdity of the rule becomes clear.

For the sake of illustration, a simple model is suggested.

1892), intimating that the first amendment did not protect speech which was indecent or dangerous to the public. The modern role of the first amendment in obscenity law is relatively pervasive. See text accompanying note 98 *infra* for a discussion of this topic. The modern tests are not well suited to such a common law rule, and this alone justifies a departure from the obscenity defense.

⁸⁵ A statute should be construed so as to further the purpose and spirit of congressional intent in its enactment. See *White v. United States*, 191 U.S. 545, 551 (1903). Further, a common law rule should not be applied if to do so would defeat the purpose of a legislative enactment. See text accompanying note 80 *supra* for a discussion of this principle. Thus, if the obscenity defense furthers the purpose of copyright, its existence is justified. But if it is contrary to this purpose, the court's imposition of such a defense is to some extent a dereliction of its constitutional duty. If the effect of the defense is in question, the decision more appropriately should be left to the legislature. The legislature's ability to conduct hearings on the subject and to carefully consider the effects, both economic and cultural, on the public interest is unmatched by the judiciary and its attendant adversary system.

⁸⁶ The case law demonstrates that the primary reason for the obscenity defense is to preserve the integrity of the court, not to further substantive public policy. The courts have long been aware that the failure to enforce a copyright in the case of an obscene work increases rather than decreases the dissemination of obscene materials. See *Rogers*, *supra* note 1, at 392 n.4, 394 nn.6, 9. The district court in *Mitchell Brothers* noted the existence of this rationale, but proceeded to declare that "[m]ore compelling in the court's mind is the argument that in refusing copyright protection the creator would have no guarantee of exclusiveness to his product and the rewards that flow therefrom and this would thereby tend to inhibit the creation of works which are obscene." 192 U.S.P.Q. (BNA) at 143. This reasoning fails, if for no other reason than that the decision is not made until the work has been created and distributed. 41 Op. Att'y Gen. 395, 401-02 (1958). The criminal statutes relating to obscenity are more than sufficient discouragement, thus any additional deterrence arising from the obscenity defense is clearly outweighed by the fact that such a ruling gives the pirate and all others like him a license to disseminate the obscene material.

The content of various writings may be divided into three basic categories. The first (Type I) would be those works containing no reference to sex. The second (Type II) would be materials which contain nothing but a portrayal of various forms of sexual conduct, true "hard core" pornography. The third (Type III) would be those writings that contain sexual subject matter but also express some theme or plot, which in some cases might itself relate to sex.⁸⁷ Of course, the latter group contains works having a varying degree of sexual saturation, and it is this group that creates the most difficulty.

That the obscenity defense would have no impact on Type I materials is obvious. Similarly, it is unlikely that the issue, resolved either way, would have an impact on the propagation of Type II materials.⁸⁸ The diversity of Type III materials, however, is immense, and it is on this group that an impact could be had. At one extreme, a story with an innocuous theme may be told with occasional references to sex that the author deems necessary to achieve reality.⁸⁹ Somewhere near the center of the spectrum a socially sensitive theme might be expressed with a modest amount of sexual activity actually portrayed.⁹⁰ At the other extreme, a work may ex-

⁸⁷ The line between Type II and Type III is drawn at that point where there is some attempt, however minuscule or transparent, to associate the portrayal of sex with some theme or plot. This is probably the same point at which originality begins.

⁸⁸ The appellant in *Mitchell Brothers* aptly made this point:

In the memorandum opinion the trial court expressed surprise that there has not been a plethora of cases re-examining the question of obscenity as a defense to copy right [sic] infringement actions in view of the recent inundation of works containing references to and explicitly exhibiting sexual activities. The short answer to that is, or [sic] course, that persons who are engaged in the business of promoting pornographic works are not anxious to seek copyright protection because they would then be identified with the obscene, criminal matter. Persons engaged in criminal activity are not noted for their willingness to publicly advertise their identity, and it is only those persons who believe their works are not criminal in nature who publicly acknowledge the works and seek copyright protection.

Brief for Appellant at 11, 604 F.2d 852. Type II material is characterized by underworld activity, the business generally being conducted as secretly as possible. See generally J. KILPATRICK, *THE SMUT PEDDLERS* (1960).

⁸⁹ Occasional references to sex can no longer be deemed obscene in the context of first amendment protection. Compare note 84 *supra* with text accompanying note 97 *infra*.

⁹⁰ See F. LEWIS, *LITERATURE, OBSCENITY, AND LAW* 208-14 (1976). The primary

press a sexual theme and make frequent and vivid use of sexual activity in an attempt to express the author's idea.⁹¹ The problem becomes one of line drawing. The most logical place to draw the line is, of course, between Type II and Type III materials,⁹² but such a distinction would allow the copyrighting of some works that might in some communities be obscene.⁹³ If the line is to be drawn elsewhere, a standard by which the court may do so must be ascertained.

First amendment law, unfortunately, does not furnish this standard. Both the copyright laws and the first amendment serve a similar purpose,⁹⁴ and thus the standard applied for one *should* be equally applicable to the other.⁹⁵ In *Miller*

characteristic of this type of work is that, notwithstanding its depiction of sex, the work has what may be referred to as serious literary or artistic value.

⁹¹ The movie involved in *Mitchell Brothers* may be a good example of this class of works, although the idea expressed could be considerably less serious and the work would remain in Type III. Any attempt to express an idea qualifies, for the means by which the idea is expressed is immaterial. Thus the line of demarcation between these works and those referred to in note 90 *supra* and accompanying text is no more precise than is the meaning and application of the term "serious." It is this line which marks obscenity in the constitutional sense.

⁹² The line between Type II and Type III materials is the most certain and the most conducive of clear definition. This line requires a determination of originality, whereas the obscenity defense requires a judicial determination of the meaning of the term "serious." Implicit in the latter term is the imposition of a value judgment by the court in any particular case. Consider the words of Justice Holmes in *Bleistein v. Donaldson Litho. Co.*, 188 U.S. 239 (1903): "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits," *Id.* at 251. As to copyright, the "narrow and obvious limit" should be originality. The reasons for allowing the court to make such a value judgment regarding the content under the first amendment are not present in the case of copyright. See note 98 *infra* for a treatment of the first amendment issue. The courts must find originality in copyright cases regardless of the morality of content. See 1 M. NIMMER, *supra* note 1, at § 2.01. The usefulness of this point for drawing the line is illustrated by those cases discussing the obscenity defense which in fact turned on the lack of originality. See, e.g., *Martinetti v. Maguire*, 16 F. Cas. 920 (C.C. Cal. 1867) (No. 9,173).

⁹³ See 604 F.2d at 858.

⁹⁴ See Comment, *The First Amendment Exception to Copyright: A Proposed Test*, 1977 WIS. L. REV. 1158. See also 1 M. NIMMER, *supra* note 1, § 1.10.

⁹⁵ Some commentators have argued for a national standard of obscenity in copyright cases. See Leverson, *Copyright and Obscenity: Towards a National Standard?*, 7 PERFORMING ARTS REV. 495 (1977); Comment, *Copyright—The Obscenity Defense in Actions to Protect Copyright*, 46 FORDHAM L. REV. 1037 (1978). But see note 99 *infra* for a discussion of the problems with such a standard.

v. California,⁹⁶ the Supreme Court set out a tripartite test for obscenity. Thus a work will be beyond the protection of the first amendment only if it is found that (1) the average person, applying community standards, would find the work, taken as a whole, to appeal to prurient interests; (2) the work depicts or describes sexual conduct in a patently offensive way; and (3) the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.⁹⁷ Applying this standard to the model constructed above, two points immediately become apparent. First, some portion of Type III material would be considered obscene,⁹⁸ and second, a copyright could have full effect in one area of the country and be invalid in another.⁹⁹ First amendment guidelines therefore do not provide

⁹⁶ 413 U.S. 15 (1973).

⁹⁷ *Id.* at 24-25. See generally F. SCHAUER, *THE LAW OF OBSCENITY* 96-115, 136-47 (1976).

⁹⁸ The Constitution itself makes no distinction between speech which has serious literary, artistic, political or scientific value and speech which is of no value. U.S. CONST. amend. I. The requirement of serious value arises out of a balancing of the state's interest in regulating obscenity against the first amendment interest in protecting freedom of speech. Lockhart & McClure, *Literature, the Law of Obscenity, and the Constitution*, 38 MINN. L. REV. 295, 363-68 (1954). The state has no such interest in the scope of copyright. Logically then, given the fact that both the first amendment and copyright law serve to encourage the expression of ideas and the dissemination of information, copyright should extend to the same point to which first amendment protection would extend but for the state's interest. Under this analysis, the only limit would be originality. The existence of an obscenity exception in the case of trademark law is consistent with the above comparison. See note 43 *supra* for a discussion of the exception. Trademark law is somewhat analogous to commercial speech, which receives less protection because of the economic incentive inherent in such speech. *Freidman v. Rogers*, 440 U.S. 1 (1979). See also *Heller, The End of the "Commercial Speech" Exception—Good Riddance or More Headaches for the Court?*, 67 Ky. L.J. 927 (1978-79).

⁹⁹ The argument has been made that the use of community standards will cause the copyright to be regional in scope, rather than the nationwide protection envisioned by the Constitution. Some make this argument to support a nationwide standard in the application of the obscenity defense. See *Leverson, supra* note 95. Others make the argument to point out the impropriety of an obscenity defense in the first instance. 604 F.2d at 858. The latter is the better reasoned position in that, even if a national standard could be formulated, it could not remove the original objection to the community standards approach, that being the creation of a regional copyright. The first problem which a court will face in attempting to formulate a national standard will be to determine whose standard is representative of national morality. That attitudes differ on this point throughout the states is one of the considerations which prompted the Supreme Court's move to community standards in the first amendment cases. Consider the following:

sufficient standards for copyright law.

Reasons underlying the obscenity defense themselves illustrate the need for line-drawing in this area. The obscenity defense is based upon the premise that obscenity will thereby be discouraged.¹⁰⁰ Assuming this to be true, the lack of a clear line could have serious effects. If a potential creator cannot ascertain the point at which a writing exceeds the bounds of copyright protection, and if the potential monetary reward is his motivation for creativity, then he will logically stay well clear of the line.¹⁰¹ If he does so, society will be injured in that expression of ideas which are not obscene could be discouraged. Such a chilling effect, if it occurred, would be "antitheti-

[O]ur Nation is simply too big and too diverse for this Court to reasonably expect that such standards could be articulated for all 50 States in a single formulation, even assuming the prerequisite consensus exists. . . . To require a State to structure obscenity proceedings around evidence of a *national* "community standard" would be an exercise in futility.

. . . .

It is neither realistic nor constitutionally sound to read the First Amendment as requiring that the people of Maine or Mississippi accept public depiction of conduct found tolerable in Las Vegas, or New York City.

413 U.S. at 30, 32 (emphasis in original). The converse reasoning is applicable to copyright. It is contrary to the purpose of copyright to deny the development of creative expression to the residents of Las Vegas or New York City merely because the work's value as found in their eyes is not recognized in Maine or Mississippi. This is particularly true when the forward-looking nature of copyright is considered. Congress is "[t]o promote the *progress* of science," U.S. CONST. art. I, § 8, cl. 8 (emphasis added), not lock expression into a particular time and place. The trend has been to shed the cloak of Victorian prudery, and there is no reason to believe that the trend will not continue. See F. SCHAUER, *supra* note 97, at §§ 1.3, 2.1. Thus, if a national standard is articulable, and if it is to be consistent with the objective of copyright law, the standard would need to reflect the most liberal view in the nation. Any original work probably would be copyrightable under such a standard. Even if the standard as formulated above is not co-extensive with originality, it is clear that a majority of courts would be enforcing a copyright to a work which, under community standards, would be obscene in the forum jurisdiction.

¹⁰⁰ See note 86 *supra* for a discussion of this concept.

¹⁰¹ Such a chilling effect is a possibility whenever a vague or imprecisely defined line separates the existence from the non-existence of a particular right. This legal phenomenon serves as the explanation for the *Miller* holding that an obscenity statute must define the material prohibited. See F. SCHAUER, *supra* note 97, § 8.3. Such a result will occur, however, only when the author is attempting to produce a legitimate work. For example, those persons who are engaged in the production of pornography are unlikely to change their conduct in response to requirements of copyright law when the criminal statutes do not induce such a change. See note 88 *supra* for a discussion of the effect of the obscenity defense on pornography.

cal" to the purpose of the copyright laws.¹⁰² Furthermore, a defense of obscenity has little or no effect on the creation or dissemination of Type II material.¹⁰³ Obscenity has flourished in the past, and if the defense has any effect it is to *encourage* authors to forego any attempt at creativity, settling instead for Type II categorization.

A more important reason for copyrighting works deemed to be obscene is that many factors which may influence a finding of obscenity, such as distribution, are beyond the control of the author or creator.¹⁰⁴ The reason for considering the means of distribution as a factor in the determination of the existence of a copyright is difficult to find, particularly when such considerations are not material to the existence of a copyright in a non-obscene work.

Moreover, there is no sound reason to believe that public policy would in any way be contravened by the extension of copyright to obscene works.¹⁰⁵ The existence of copyright would not hinder criminal prosecutions, and a plethora of anti-obscenity mechanisms already exist in state¹⁰⁶ and federal¹⁰⁷ law. These laws, unlike copyright laws, are directed at

¹⁰² 604 F.2d at 856.

¹⁰³ See note 88 *supra* for a discussion of the effect the obscenity defense has on Type II material.

¹⁰⁴ Such factors also include pandering, as well as whether the work is directed at minors or at a socially deviant group. See F. SCHAUER, *supra* note 97, §§ 4.1-4.6. The existence of pandering may be the deciding factor in a close obscenity case. *Ginzburg v. United States*, 383 U.S. 463 (1966). Thus, a work which standing alone may not be obscene may be so classified if distributed in such a way as to constitute "the commercial exploitation of erotica." *Id.* at 466. Distribution to minors also may alter the first amendment definition of obscenity. *Ginsberg v. New York*, 390 U.S. 629 (1968). If the obscenity defense stands, therefore, a work may be the proper subject of a copyright when created, but may lose such status because of the means of distribution, a factor over which the author may or may not have control. Even more important, the author may lose his copyright because of the way in which a pirate chooses to distribute the stolen work. This is illustrated by the facts in *Mitchell Bros.*, where only the pirate screened the film in Texas, the jurisdiction in which it was deemed obscene.

¹⁰⁵ See note 73 *supra* for the old English view on this subject.

¹⁰⁶ 604 F.2d at 862. See F. SCHAUER, *supra* note 97, at § 10.1-10.2 for a general discussion of state obscenity statutes as of 1976. See also 10 UNIFORM LAWS ANNOTATED, MODEL PENAL CODE § 251.4 (1974).

¹⁰⁷ 604 F.2d at 862. The federal government has been extremely active in the regulation of obscenity. Congress has sought to preclude the importation of obscenity

distribution. Thus, the party charged is more closely connected to the conduct which renders the work obscene. In short, there is no sound reason to clutter copyright litigation with defenses which are immaterial to the purpose and foreign to the spirit¹⁰⁸ of the law of copyright.

CONCLUSION

Despite the questionable development of and the paucity of precedent for the obscenity defense to copyright infringement actions, the defense remained alive and well until the Fifth Circuit decision in *Mitchell Brothers*. It is hoped that that decision will help bring about the total demise of the obscenity defense. Such a demise is long overdue, for the defense is a judicially created haven for the wrongdoer which countermands the mandate of Congress, serves no positive purpose, and encourages rather than discourages the dissemination of obscene materials. Should other courts adopt the Fifth Circuit's view, the law of copyright will be rid of a significant but counterproductive doctrine.

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since 1842. Act of Aug. 30, 1842, ch. 270, 5 Stat. 566, § 28 (1842). The use of mails for the dissemination also is prohibited. 18 U.S.C. § 1461 (1976). Common carriers may not be utilized for the transportation of obscenity in interstate commerce, 18 U.S.C. § 1462 (1976), and the transportation of obscenity in interstate commerce for sale or distribution is prohibited by 18 U.S.C. § 1465 (1976). See also 18 U.S.C. § 1463 (1976); 26 U.S.C. § 5723(d) (1976); 47 U.S.C. § 223 (1976). A recent concern over the use of children in pornography is reflected by the enactment of the Protection of Children Against Sexual Exploitation Act of 1977, § 2, 18 U.S.C. § 2251 (Supp. II 1978).

¹⁰⁸ The 1909 Act was prompted by President Theodore Roosevelt who in 1905 expressed his views to Congress concerning the need for revision of the copyright laws. "They are imperfect in definition, confused and inconsistent in expression; they omit provision for many articles which, under modern reproductive processes, are entitled to protection; they impose hardships upon the copyright proprietor which are not essential to the fair protection of the public . . ." 1909 Report, *supra* note 28, at 1 (emphasis added). The same considerations to some extent prompted the 1976 Act. *Copyright Law Revision: Hearings on H.R. 2223 before the Subcommittee on Courts, Civil Liberties, and the Administration of Justice of the Committee on the Judiciary, 94th Cong., 1st Sess. 91 (1975)* (testimony of John G. Lorenz, acting Librarian of Congress). Is not the obscenity defense as developed by the courts just such a burden on the modern holder of a federal copyright?