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THE ADVERSE POSSESSION OF COPYRIGHT

Matthew W. Daus*

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I. INTRODUCTION

"Copyright law is essentially a system of property. Like property in land, you can sell it, leave it to your heirs, donate it, or lease it under any sort of conditions; you can divide it into separate parts; you can protect it from almost every kind of trespass."¹ But, can a copyright, like real property, be adversely possessed so that an infringer may acquire title to the original owner's work? This Article will thoroughly address that question.

The doctrine of adverse possession was traditionally a rule of forfeiture applied predominantly to realty;² over time, it has been extended to govern the transfer of title to personal property.³ Further extension of this real property doctrine to intangible property is a novel issue which generally has been avoided by the courts.⁴ However, a progressive federal district court, in *Gee v. CBS, Inc.*,⁵ confronted and decided this "intriguing question"⁶ in favor of expanding the adverse possession doctrine to copyright law.⁷

Part II of this Article will trace the development of adverse possession

1. WILLIAM S. STRONG, *THE COPYRIGHT BOOK: A PRACTICAL GUIDE* 1 (2d ed. 1984).

2. See PATTY GERSTENBLITH, *The Adverse Possession of Personal Property*, 37 *BUFF. L. REV.* 119, 120-21 (1988-89).

3. See *infra* note 13.

4. See *Sachs v. Cluett Peabody & Co.*, 39 N.Y.S.2d 853, 858 (N.Y. App. Div. 1943) (Callahan, J., concurring) (A patent for machinery used in the shrinking of fabrics was addressed by the majority in contract terms, namely the breach of a confidential relationship, instead of confronting the adverse possession issue), *aff'd*, 53 N.E.2d 241 (N.Y. 1944); see also *Sporn v. MCA Records, Inc.*, 448 N.E.2d 1324, 1327 (N.Y. 1983) ("[T]here is no reason to consider, at this time, the applicability of the doctrine of adverse possession to intangible property" in an action for unfair competition regarding the song "Get a Job."), *aff'g* 451 N.Y.S.2d 750, 752 (N.Y. App. Div. 1982) ("I think it premature at this point to determine whether the doctrine of adverse possession . . . should be extended to intangible personal property rights.").

5. 471 F. Supp. 600 (E.D. Pa. 1979), *aff'd*, 612 F.2d 572 (3d Cir. 1979).

6. *Id.* at 654.

7. *Id.*

from realty to personalty, and will analyze the soundness of extending the doctrine to the latter area.⁸ Part III will then scrutinize the reasoning which the *Gee* court set forth in expanding the doctrine to copyright.⁹ The feasibility of sustaining such a cause of action will be addressed in part IV, and problems that arise from the practical application of this doctrine will be pinpointed and discussed.¹⁰

Assuming that the doctrine is logically correct and can be effectively enforced, part V will argue that this state property law must be entirely preempted by federal copyright law.¹¹ Finally, part VI will confront the conflicting policies of adverse possession and copyright law, pitting state police power concepts against the authority of the United States Constitution.¹²

II. THE ADVERSE POSSESSION OF PERSONAL PROPERTY

The adverse possession of personal property is a questionable legal principle. However, this dubious extension of real property doctrine to the acquisition of title to chattels exists in theory and in application.¹³ Based on the premise that the validity of a cause of action for adverse possession of personal property is itself nebulous, it is herein contended that a further extension of the doctrine to intangible or intellectual property seems pragmatically impossible.¹⁴

The adverse possession of chattels is derived from an analogy to the doctrine pertaining to land.¹⁵ Hence, the same elements of this cause of action apply to both real and personal property.¹⁶ Further, the requisite period for which one may claim adverse possession of personalty is governed by the same time frame set forth in the statutes governing realty.¹⁷

8. See *infra* notes 13-38 and accompanying text.

9. See *infra* notes 39-82 and accompanying text.

10. See *infra* notes 83-128 and accompanying text.

11. See *infra* notes 129-200 and accompanying text.

12. See *infra* notes 201-49 and accompanying text.

13. See 2A C.J.S. *Adverse Possession* § 327 (1972).

14. It is worthy to note a relevant statement by the appellant in *Sporn*: "[I]t is an interstellar leap from adverse possession of tangible personalty (which in itself is a radical expansion of this severe real property doctrine) to intangible rights" Appellant's Reply Brief at 15, *Sporn v. MCA Records, Inc.*, 448 N.E.2d 1324 (N.Y. 1983) (No. 12536776).

15. See *supra* note 13.

16. *Id.*

17. *Id.*

"[T]he courts generally agree that possession, to be adverse so as to vest title in the possessor after the lapse of the statutory period, must be actual, open and notorious, exclusive, hostile, under a claim of right, and continuous and uninterrupted."¹⁸ First, the various problems encountered by employing the "open and notorious" element in the personal property context will be explored. Second, the potential harshness of the doctrine of adverse possession in general will be discussed.

A. *The Difficulties Surrounding Notice*

In the realm of personalty, the element of "open and notorious" possession entails fundamental complications. This requirement hinges primarily upon the provision of notice to the original owner of the adversely possessed property.¹⁹ Where land is concerned, it is assumed that a diligent owner is aware of its location and stable presence upon the immovable earth.²⁰ Therefore, the open and obvious use of land by an adverse possessor is deemed sufficient to put the original owner on notice of either a claim to her title or an unlawful trespass.

A notice problem arises where personalty is involved. Chattels, by their very nature, are movable and capable of concealment. Thus, the original owner of personalty would not automatically know where to look to reclaim it, and there would be no immediate and presumed notice of adverse possession as in the case of realty.²¹

As a result of notice complications, some courts have held that the statute of limitations necessary to establish the "continuous" possession element is tolled while the chattel is fraudulently concealed.²² Other courts have entirely dispensed with the "open and notorious" requirement

18. 2 C.J.S. *Adverse Possession* § 25 (1972).

19. See *infra* notes 96-115 and accompanying text.

20. See GERSTENBLITH, *supra* note 2. "When the subject is real property, it may be possible to assume that the reasonably diligent owner knows where his or her property is and will be apprised reasonably quickly of the existence of an adverse claimant who is occupying and using the land." *Id.* at 124. The thesis of the comment written by Professor Gerstenblith was not to disparage the mere existence of the adverse possession of personal property doctrine. Instead, that scholarly publication suggested "the most important element required [for such a cause of action] . . . is the good faith and reasonable reliance of the adverse possessor." See *id.* at 119.

21. *Id.* at 124. "When personal property is at issue, . . . the underlying paradox [is posed] that even a diligent owner may never receive notice of the adverse claim of one using his or her property as would the true owner." *Id.*

22. See 3 THOMAS E. ATKINSON ET AL., *AMERICAN LAW OF PROPERTY* § 15.16, at 835-36 (A. James Casner ed., 1952).

where the adverse possession of personal property is involved.²³ In essence, these modifications to the traditional doctrine of adverse possession reveal that its application to personal property is flawed.

The distinction between a pure statute of limitations and adverse possession may be academic. Where an owner of personal property brings an action for replevin,²⁴ if she is barred by the statute of limitations for that action,²⁵ the property cannot be recovered, possessed or utilized by her. In effect, all her legal rights to the object cease to exist.²⁶ Therefore, the property becomes abandoned, and the person in possession acquires title to the property.

The only distinction between the consequences of a statutory bar to a replevin action and the doctrine of adverse possession is that the adverse possessor must prove certain additional elements in order to vest title. However, as previously discussed, where personal property is involved, notice is difficult to establish,²⁷ due in large part to the absence of a title-recording requirement that does exist in the real property context.²⁸ As a result, the failure to prove notice—analogue to the running of the statute of limitations for a replevin action—leaves the chattel without an owner.²⁹

23. See 2A C.J.S. *Adverse Possession* § 328 (1972).

24. Replevin is “[a]n action whereby the owner or person entitled to repossession of goods or chattels may recover those goods or chattels from one who has wrongfully distrained or taken or who wrongfully detains such goods or chattels.” BLACK’S LAW DICTIONARY 1168 (5th ed. 1979).

25. The majority view amongst the states is to place the statutory period barring an action for replevin at six years. See WILLIAM F. WALSH, A TREATISE ON THE LAW OF PROPERTY 793 (2d ed. 1927).

26. See ATKINSON, *supra* note 22, at 835 (“[T]he conclusion is necessarily true as a matter of legal history and principle that the operation of the statute, and that alone, acts to divest the true owner’s title by barring his action to recover the property or its value . . .”).

27. See *supra* notes 19-23 and accompanying text.

28. Several states have enacted statutes requiring that deeds for the sale of realty be officially recorded, with notice of title transfer constituting a major consideration in most jurisdictions. See BLACK’S LAW DICTIONARY 1146 (5th ed. 1979).

29. When both of these events occur simultaneously, one might suggest that the property be labeled as abandoned, thus making title available to the first person or entity that takes possession through the concept of “acquisition by find.” See generally JESSE DUKEMINIER & JAMES KRIER, PROPERTY §§ 64-86 (2d ed. 1988). It would certainly be a valid argument that the chattel is not without an owner in this situation because the elements of abandonment must first be established to divest the original owner of title. However, although it may be technically correct that the owner lost a cause of action for replevin rather than title to the chattel, if she cannot re-gain the property from the possessor, then title would be meaningless.

Another alternative is to vest title in the state. However, this result would probably be unwise as an unconstitutionally onerous restriction on the ownership of private property. A more feasible approach, much favored by this author, would be to examine the equities involved in each

The New Jersey Supreme Court dealt with the aforementioned dilemma in the landmark case of *O'Keeffe v. Snyder*.³⁰ The plaintiff, world-renowned artist Georgia O'Keeffe, found three of her paintings that were stolen from an art gallery thirty years earlier in defendant Barry Snyder's gallery.³¹

[Instead of deciding the case by applying adverse possession doctrine to personal property, the court opted for reliance solely upon the statute of limitations for an action in replevin.] We are persuaded that the introduction of equitable considerations through the discovery rule provides a more satisfactory response than the doctrine of adverse possession. The discovery rule shifts the emphasis from the conduct of the possessor to the conduct of the owner. The focus of the inquiry will no longer be whether the possessor has met the tests of adverse possession, but whether the owner has acted with due diligence in pursuing his or her personal property.³²

Hence, the court rejected extension of adverse possession to chattels because it deemed the discovery rule more efficient in dealing with the notice difficulties that arise in locating personal property.³³ Such difficulties were apparent in the case of Georgia O'Keeffe's oil paintings, which presumably would be easier to locate due to her worldwide popularity. The pragmatic approach of the *O'Keeffe* court illustrates the narrow distinction between a statute of limitations in a replevin action and the adverse possession of personal property.³⁴

B. Strict Construction of the Adverse Possession Doctrine

In addition to notice complications, the extension of adverse possession to personal property belies the harsh and stringent treatment that courts

case and to vest title accordingly.

30. 416 A.2d 862 (N.J. 1980), *rev'g* 405 A.2d 840 (N.J. Sup. Ct. App. Div. 1979).

31. *See O'Keeffe*, 405 A.2d at 841.

32. *O'Keeffe*, 416 A.2d at 872.

33. *See also* GERSTENBLITH, *supra* note 2, at 142 ("[T]he difficulty of establishing exactly what constitutes open and notorious possession of personal property" was a basis for the *O'Keeffe* court's reasoning.) *Id.*

34. *See also* WALSH, *supra* note 25, at 793-94 (Barring an action in replevin through expiration of the statute of limitations was considered, by this property scholar, to be the functional equivalent of the vesting of title through the adverse possession of chattels; "[t]he former owner ceases to have any title, since he has no action [in replevin] by which his right to the property may be vindicated."). *See also* ATKINSON, *supra* note 22, § 15.16 at 834-838.

have consistently accorded the doctrine when applying it to realty. "The doctrine of adverse possession is to be taken strictly; that is, it must be construed strictly in favor of the owner of the title to the land. . . . It is a recognized, but not a favored, method of procuring title."³⁵ It is a defiant notion indeed to ignore this strict interpretation and extend the doctrine of adverse possession to chattels, but it is beyond logic and the rational realm of our property law to utilize a rule formulated particularly for the nature, situation and importance of land, for the acquisition of title to intangible property rights such as copyright.

Extension of the adverse possession doctrine to personal property appears tenuous at best. Stretching real property concepts to intangible property is unworkable and problematic.³⁶ The preliminary point to be recognized at this time, is that since a personal and movable object evades practical application of the doctrine, abstract intangible rights attaching to expression in an ephemeral media,³⁷ would be completely incapable of such implementation. A complete and thorough assessment of the elements of adverse possession as applied to copyright is forthcoming in the subsequent discussion of the *Gee* decision.³⁸ This analysis is reserved because *Gee* is a living example of the purported adverse possession of copyright doctrine.

III. THE VALIDITY OF *GEE V. CBS*

The only reported case which has adapted the doctrine of adverse possession to copyright is *Gee v. CBS*.³⁹ The adverse possession ruling

35. 2 C.J.S. *Adverse Possession* § 5 (citations omitted) (1972).

36. See *infra* notes 101-04 and accompanying text.

37. Judge Yates, in *Millar v. Taylor*, 4 Burr. 2303, 2361-62 (1769), colorfully described the abstract nature of an author's intangible property rights in her work:

But the property here claimed is all ideal; a set of ideas which have no bounds or marks whatever, nothing that is capable of a visible possession, nothing that can sustain any one of the qualities or incidents of property. Their whole existence is in the mind alone; incapable of any other modes of acquisition or enjoyment, than by mental possession or apprehension; safe and invulnerable, from their own immateriality: no trespass can reach them: no tort affect them; no fraud or violence diminish or damage them. Yet these are the phantoms which the author would grasp and confine to himself.

A DICTIONARY OF LEGAL QUOTATIONS 24 (Simon James & Chantal Stebbings eds., 1987).

38. See *infra* notes 39-82 and accompanying text.

39. 471 F. Supp. 600 (E.D. Pa. 1979).

in *Gee* was merely one of many issues addressed by the court.⁴⁰ The suit centered around potential property rights in the estate of the blues singer and composer, Bessie Smith, often described as the "Empress of the Blues."⁴¹

Ms. Smith died in a tragic automobile accident in 1937.⁴² Her surviving husband, Jack Gee, Sr., died in 1975.⁴³ The action was filed by Jack Gee, Jr., the purportedly adopted son of Smith and Jack Gee, Sr.⁴⁴ The original complaint sounded in copyright and alleged infringement by Columbia Phonograph Company ("Columbia") and its successors.⁴⁵ The focus of the opinion written by District Court Judge Edward R. Becker concerned a motion to dismiss filed by defendant Columbia.⁴⁶ One of the grounds urged for dismissal was that Columbia adversely possessed plaintiff's intangible property rights to certain recordings.⁴⁷

The adverse possession issue involved title to the song "At the Christmas Ball."⁴⁸ Shortly after this recording was made by Bessie Smith on November 18, 1925, it was rejected by Columbia.⁴⁹ Subsequent to Bessie Smith's death, Columbia issued the recording of "At the Christmas Ball" in 1951.⁵⁰ This track appeared on Volume 3 of an album entitled the "Bessie Smith Story—Golden Era Series."⁵¹ The same "record was re-recorded and re-issued in 1972 as part of . . . 'Nobody's Blues But Mine.'"⁵²

The first criticism which must be levied against the *Gee* court for extending adverse possession to copyright, aside from the logical impracticability of doing so, is the mode of reasoning employed to achieve the

40. The claims raised by plaintiff, giving rise to various collateral issues, were, inter alia: (1) a 42 U.S.C. § 1981 civil rights claim, *see Gee*, 471 F. Supp. at 613-40; (2) contract invalidity, *see id.* at 640-42; (3) copyright infringement, *see id.* at 642-45; (4) unfair competition, *see id.* at 645-61; (5) common law copyright, *see id.*; (6) misappropriation of property interest in Bessie Smith's name, *see id.* at 661-62.

41. *Gee v. CBS, Inc.*, 471 F. Supp. 600, 609 (E.D. Pa. 1979).

42. *Id.* at 610.

43. *Id.*

44. *Id.* The executor of Jack Gee, Sr.'s estate, William D. Harris, was later joined as plaintiff. *See id.*

45. *Id.*

46. *Gee*, 471 F. Supp. at 610.

47. *Id.* at 653-54.

48. *Id.* at 652-53.

49. *Id.* at 651. It should also be noted that no financial records were prepared or retained by Columbia regarding any payments made to Bessie Smith for this recording. *Id.*

50. *Id.*

51. *Gee*, 471 F. Supp. at 651.

52. *Id.* at 651-52.

result. This court failed to adequately recognize or address the distinguishing factors prevalent in the case law and other authorities cited in support of applying the adverse possession doctrine to copyrights.

After recognizing that the adverse possession of intangible property rights was an "intriguing question,"⁵³ Judge Becker employed only a brief analysis relying primarily upon two cases, namely, *Lightfoot v. Davis*⁵⁴ and *Priester v. Milleman*.⁵⁵ Crucial to *Gee's* analogy of the case before it to *Lightfoot* and *Priester*, was the definition of a "chose in action." The court, relying on a personal property treatise, described a "chose in action" as follows:

[M]any rights do not . . . concern specific tangible things but consist of claims against third persons which, since they may be enforced by action . . . are of value and thus entitled to be termed property in the broader sense. Bank accounts, debts generally, corporate stock, patents and copyrights are common instances of this class of [intangible] property. . . . While "choses in action" are usually "represented by a piece of paper" (i.e. savings pass-book, federal copyright certificate), the essence of a "chose in action" is a "right of property which . . . is essentially intangible in that it can ultimately only be claimed or enforced by action, not by taking physical possession."⁵⁶

Then, the court reasoned that since New York has explicitly applied the doctrine of adverse possession to "choses in action" under *Lightfoot*, the same approach should be adopted here without questioning the basis for the *Lightfoot* decision.⁵⁷

Even though the *Lightfoot* court applied the adverse possession doctrine to a "chose in action," one must remember that this decision involved bonds, not copyright certificates.⁵⁸ In *Lightfoot*, the defendant's

53. *Id.* at 654.

54. 91 N.E. 582 (N.Y. 1910).

55. 55 A.2d 540 (Pa. Super. Ct. 1947).

56. *Gee*, 471 F. Supp. at 654 (quoting RAY BROWN, BROWN ON PERSONAL PROPERTY § 7, at 11, 13 (1955)).

57. *Id.* at 654-55.

58. See *Sporn*, 448 N.E.2d 1324, in which the plaintiff's appellate brief vigorously and aptly distinguished the *Lightfoot* holding from the instant case and the *Gee* decision as follows:

Lightfoot has little relevance either to our facts or to the *Gee* facts, and for several reasons. First of all, the property sought to be adversely possessed in *Lightfoot* was a "bearer" bond. Therefore, when the *Lightfoot* court stated that one may appropriate anything "tangible", [sic] [*Lightfoot v. Davis*, 91 N.E. 582, 583 (N.Y. 1910) (quoting *Campbell v. Holt*, 115 U.S. 620 (1885))], it was referring to a bearer bond which is capable of tangible, exclusive possession. He who possesses a bearer bond may

testator converted bearer bonds from the plaintiff's bureau drawer, and collected the principal and interest once the instruments matured.⁵⁹ The *Lightfoot* court ultimately rendered judgment on behalf of plaintiff.⁶⁰ However, this result emerged only after equitable principles such as constructive trust theory were haphazardly propounded.⁶¹ Although the New York Court of Appeals accepted the concept of adverse possession of personal property,⁶² it is unclear from the language of the *Lightfoot* opinion whether the doctrine can apply to "choses in action" generally.

The essence of the analogy supporting extension of the doctrine from real to personal property, according to *Lightfoot*, is the possession of a tangible thing.⁶³ The New York Court of Appeals reasoned that since acquisition of title by possession is well grounded and recognized in the law, and because other jurisdictions have extended the doctrine to personalty, the same should be done in this instance.⁶⁴ Relying on the authority of United States Supreme Court Justice Samuel F. Miller, the following phraseology was dispositive:

Possession has always been a means of acquiring title to property. It was the earliest mode recognized by mankind of the *appropriation* of anything tangible by one person to his own use, to the exclusion of others, and legislators and publicists have always acknowledged its efficacy in confirming or creating title.⁶⁵

Notice that "the appropriation of anything tangible"⁶⁶ was the focus of Judge Miller's analysis. This emphasis is inconsistent with *Gee's* understanding of *Lightfoot* (the case that extended the doctrine of adverse

legitimately cash it, and *only it*; one may not cash a photocopy or other reproduction, as there is and may be only *one original* such bearer bond. However, in our situation, not only are the rights in a master sound recording intangible, but he who possesses one copy of a recorded performance, unlike a bearer bond, is quite capable of precise "pressing" or reproduction to the point where the original master is indistinguishable from millions of its copies—each such "copy" is in fact an "original". [sic]Consequently, *Lightfoot* stands only for the proposition that a tangible document may be appropriated to the exclusion of others.

Appellant's Brief at 44, *Sporn*, 448 N.E.2d 1324 (No. 12536/76) (alteration in original).

59. See *Lightfoot*, 91 N.E. at 582.

60. *Id.* at 586.

61. *Id.* at 585-86.

62. *Id.* at 584.

63. *Id.* at 583-84.

64. See *Lightfoot*, 91 N.E. at 583.

65. *Id.* (citing *Campbell v. Holt*, 115 U.S. 620 (1885)).

66. *Id.*

possession to "choses in action").⁶⁷

According to the *Gee* court, "choses in action" are "essentially intangible."⁶⁸ The court's failure to confront or explain the fundamental precept underlying the *Lightfoot* decision, namely the tangible nature of the bonds, thereby weakens the foundation of its conclusion. The *Gee* court should have at least mentioned the problem and reconciled it within the rules of stare decisis. Thus, this unquestioned and firm reliance upon *Lightfoot* infiltrates and flaws the *Gee* holding in all respects.

Moreover, the reference in the *Gee* decision to *Priester*⁶⁹ is without logical merit. Similar to the reliance on *Lightfoot*, a synopsis of *Gee*'s analysis is that there is nothing in *Priester*, or other case law, requiring limitation of the doctrine to tangible chattels;⁷⁰ therefore, adverse possession should be extended automatically to intangible property. This type of reasoning is circular in nature. If such a concept is accorded credence, courts would acquire unfettered authority to stretch any rule if there is no express restriction on that authority. However, the *Gee* court nevertheless disregarded the strict construction which has traditionally accompanied the doctrine of adverse possession.

In general, the *Gee* court's treatment of copyright law is inundated with unexplained and infirm premises. In support of the conclusion that no distinction or reason exists for limiting adverse possession to personal property, the court quoted from a 1937 Pennsylvania Supreme Court decision⁷¹ entitled *Waring v. WDAS Broadcasting Station*:⁷² "At common law, rights in a literary or artistic work were recognized on substantially the same basis as title to other property."⁷³ What the *Gee* court did not explicitly point out, however, is that *Waring* involved a state common law copyright claim,⁷⁴ unlike the instant case, where Bessie Smith's recordings were federally registered copyrights.⁷⁵ Therefore, *Waring* is cited entirely out of context.

The legal discussion in *Gee* is infirm for a number of reasons. First, it is not clear whether the court was applying the doctrine of adverse possession to common law copyright. The opinion's failure to cite any

67. See *Gee*, 471 F. Supp. at 654-55.

68. *Id.* at 654.

69. See *Gee*, 471 F. Supp. at 653-54.

70. See *id.* at 654.

71. *Id.* at 655.

72. 194 A. 631 (Pa. 1937).

73. *Gee*, 471 F. Supp. at 655 (quoting *Waring*, 194 A. at 634).

74. See *Waring*, 194 A. at 633-34.

75. See *Gee*, 471 F. Supp. at 610.

federal copyright statutes or case law is evidence of such an application, and remotely explains its reliance upon *Waring*. If the state theory of common law copyright infringement was the focus in *Gee*, this constitutes a significant error. Federal copyright law would preempt any state claims⁷⁶ since the songs involved were copyrights registered under federal law.⁷⁷

Second, for some unfathomable reason, the *Gee* court assumed that Bessie Smith's style and manner of performance in recording "At the Christmas Ball" was the ownership right asserted.⁷⁸ This assumption is irrelevant and unwarranted because the copyright to the sound recording itself is the only interest protected by federal copyright law.⁷⁹

The fundamental defects in the *Gee* court's analysis cripple its resulting extension of the adverse possession doctrine to copyright law. The court considered neither the feasibility of maintaining such a cause of action,⁸⁰ the possibility of preemption by federal copyright law,⁸¹ nor the underlying countervailing policies of adverse possession and federal copyright law.⁸² These are the fatal omissions which will be discussed in the remaining portions of this Article.

76. See *infra* notes 129-200 and accompanying text.

77. See *Gee*, 471 F. Supp. at 610.

78. See *id.* at 656.

79. *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), established the principle that "[a] voice is not copyrightable" under federal law. *Id.* at 462.

In *Midler*, Young & Rubicam, Inc., the advertising agency employed by the defendant Ford Motor Company, specifically retained Ula Hedwig to imitate plaintiff Bette Midler's singing style in a Ford commercial after Midler's manager, Jerry Edelstein, denied Young & Rubicam's request for Ms. Midler's performance in the project. *Id.* at 461. Although the Midler composition "Do You Want To Dance" was licensed to Young & Rubicam, "[n]either the name nor picture of Midler was used in the commercial . . ." The plaintiff sued claiming that the voice itself was protected. *Id.* at 461-62.

The Ninth Circuit concluded that even though "federal copyright law preempts much of the area," there can be recovery under the California common law tort for invasion of one's "proprietary interest" in her "identity." *Id.* at 462-63 (citing *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974)). However, the holding of the *Midler* case was limited to deliberate imitation of a professional singer's widely known and "distinctive voice." *Id.* Thus, state common law theories might be available for adverse possession purposes. However, assuming there is no preemption, the remaining arguments of this comment in opposition to the adverse possession of copyright would be equally applicable to such state theories.

80. See *infra* notes 83-128 and accompanying text.

81. See *infra* notes 129-200 and accompanying text.

82. See *infra* notes 201-49 and accompanying text.

IV. THE FEASIBILITY OF MAINTAINING A CAUSE OF ACTION FOR THE ADVERSE POSSESSION OF COPYRIGHT

The traditional elements of adverse possession cannot successfully be applied to the acquisition of a copyright because it is intangible property. First, a copyright is incapable of physical possession and the elements of "open and notorious" and "actual possession" cannot be satisfied.⁸³ As a result, the maintenance of such a cause of action would necessarily entail "use," not "possession" of the copyrighted work. Second, due to the nature of the original copyright owner's rights, the adverse possessor's use or possession can never be "exclusive."

The elements of "continuity" and "hostility" do not present inherent doctrinal flaws, and could, with some alteration, successfully be utilized in copyright situations. However, despite this accommodation, the adverse possession of copyright doctrine cannot be maintained by fulfillment of these two elements alone. A failure to prove any one element is, by itself, fatal to sustaining a cause of action for adverse possession.⁸⁴

A. *Physical Possession*

At the outset, "[t]wo types of property rights must be distinguished: (1) ownership of copyright; and (2) ownership of the material object in which the copyrighted work is embodied."⁸⁵ "The material object, [for instance a] 'copy' or 'phonorecord,' . . . is tangible and corporeal and has physical existence,"⁸⁶ unlike the underlying copyright itself, which is essentially an intangible right,⁸⁷ incapable of physical possession.

83. The late Professor Melville Nimmer, a leading authority and commentator in the area of copyright law, criticized the doctrine of adverse possession of copyright and the reasoning in *Gee* based entirely upon the problems encountered by the "possession" of intangibles:

[T]he court in *Gee* . . . held [that] . . . acts of infringement which occurred within the limitation period to be barred under a rather startling application of the doctrine of adverse possession. The *Gee* court found support for this conclusion in those cases which have applied the doctrine of adverse possession to personal as well as to real property. It nevertheless appears most questionable to apply the doctrine to an intangible such as literary property, which by its nature is incapable of possession.

MELVILLE NIMMER, NIMMER ON COPYRIGHT: A TREATISE ON THE LAW OF LITERARY, MUSICAL AND ARTISTIC PROPERTY, AND THE PROTECTION OF IDEAS § 12.05, at 12-64.14 n.3 (1990).

84. See, e.g., *Belotti v. Bickhardt*, 127 N.E. 239, 241 (N.Y. 1920).

85. HARRY HENN, HENN ON COPYRIGHT LAW: A PRACTITIONER'S GUIDE 93-94 (3d ed. 1991).

86. *Id.* at 94 n.2.

87. *Id.*

The normal avenue for enforcement or exercise of an owner's rights in physical personal property or material expression of a copyright is through an action for conversion.⁸⁸ Such an action lies where there is "[a]n unauthorized assumption and exercise of the right of ownership over goods or personal chattels belonging to another, to the alteration of their condition or to the exclusion of the owner's rights."⁸⁹

If one accepts the validity of the doctrine of adverse possession of chattels, then this cause of action is available where a material object or expression of one's copyright is involved. Of course, upon successful satisfaction of all the elements of adverse possession the new owner acquires title only to the object itself, namely the particular copy of the

88. However, the same individual or entity may have dual rights to a conversion and a copyright infringement action, based upon tangible and intangible rights, respectively. These separate, yet overlapping rights, were competently distinguished and described in a 1941 law review comment:

The author of a work, be it art, music or literature, has a twofold right. He has tangible property consisting of a canvas with paint, or paper with notes or writing on it, and he has the incorporeal right to make copies of it. If the book were taken, a conversion action would be proper as it would be wherever any tangible personal property was unlawfully taken. But where the intangible right to duplicate or to first publish is violated conversion does not lie. Specific remedies are provided for in such cases for infringement of copyright, or injunction to prevent publication.

So in this specialized field a special remedy is provided for the infringement of the incorporeal right involved. It is a tort action, as is conversion, but it is not the action of conversion.

Lester Rubin, Comment, *Conversion of Choses in Action*, 10 FORDHAM L. REVIEW 415, 430-31 (1941) (footnotes omitted).

A general rule of tort law is that no action for conversion lies where intangible property is involved. See WILLIAM PROSSER & ROBERT KEETON, PROSSER AND KEETON ON THE LAW OF TORTS 91 (5th ed. 1984). However, some courts have carved out exceptions to this principle where presented with novel situations. See *id.*

"The first relaxation of the rule was with respect to the conversion of a document in which intangible rights were merged, so that the one became the symbol of the other—as in the case of a promissory note, a check, a bond, a bill of lading, or a stock certificate." *Id.* Further extension of this qualification has led the courts to focus upon the "importance" of the intangible rights to the tangible object. See *id.*

At least where the failure of a corporation to record the transfer of stock shares are involved, the rule has been entirely abandoned to permit a conversion action for purely intangible rights without any corresponding tangible instrument of ownership. See *id.* Although limited abrogation of the general rule against intangible conversion has occurred, this slight alteration is probably due to judicial avoidance of resulting inequities, and has little doctrinal import.

89. BLACK'S LAW DICTIONARY 300 (5th ed. 1979).

work, and not to the intangible copyright privileges.⁹⁰ Hence, there are no problems of physical possession because the material object may be held by human hands.

When property rights do not arise from any physical object capable of possession, but rather manifest within a bundle of intangible rights, the doctrine of adverse possession is inappropriate. Certainly, where the unauthorized duplication, use and claim of ownership is involved, the appropriate legal recourse is an action for copyright infringement, not adverse possession.

An illustration of the preceding observations and conclusions can be found in *O'Neill v. General Film Co.*⁹¹ In *O'Neill*, the plaintiff claimed ownership in "the literary . . . [and] performing rights [of Charles Fechter's] dramatization of Alexander Dumas' novel, 'The Count of Monte Cristo.'"⁹² The court, in addressing the important distinction between intangible copyright ownership and property rights in material objects or chattels, reasoned as follows:

It is quite clear, I think, that title to a *chattel* may be acquired by adverse possession and claim of ownership, and on the evidence title to *the manuscript* by adverse possession and claim of ownership was sufficiently shown . . . but present title to the manuscript, while some evidence of the ownership of the play, if standing alone, might be insufficient to sustain the action, for the owner might have parted with possession of the manuscript without parting with his rights as an author . . .⁹³

Thus, the *O'Neill* court left the scope of the injunction sought by the plaintiff, as far as it concerned copyright law, to the federal courts.⁹⁴

90. Cf. WALLS, THE COPYRIGHT HANDBOOK 7 (1963) ("The tangible articles containing the work may be in the possession of many persons other than the copyright owner, and they may use the work for their own enjoyment, but copyright restrains them from reproducing the work without the owner's consent.").

91. 157 N.Y.S. 1028 (N.Y. App. Div. 1916).

92. *Id.* at 1030 (citations omitted).

93. *Id.* at 1036 (citations omitted). The *O'Neill* decision, decided well before *Gee*, also stated that "[n]o decision is cited, and we have found none, which holds that [a copyright] may be acquired by adverse possession and claim of ownership." *Id.* This dicta evinces a reluctance to consider and rule on the validity of the doctrine of adverse possession of copyright. One may even view this explicit avoidance of the issue, while tacitly pertinent to the plaintiff's ownership claims in the *O'Neill* case, to be an early rejection of the doctrine as an utter absurdity unworthy of further discussion.

94. See *id.* at 1040. However, the appellant's brief to the New York Court of Appeals in *Sporn v. MCA Records, Inc.*, 448 N.E.2d 1324 (N.Y. 1983), vigorously contended that the *O'Neill* decision rejected *Lightfoot v. Davis*, 91 N.E. 582 (N.Y. 1910), "as authority for the proposition

Assuming that the doctrine of adverse possession could be applied to copyright, the elements pertaining to possession must be altered. Due to the intangible nature of copyright, one could never possess its subject matter; however, it could utilize the copyright by exercising ownership rights through copying, duplication, licensing and the like. Thus, not only must possession be understood to contemplate "use," but it would probably be more appropriate to label the doctrine "adverse use of copyright."⁹⁵ Yet, even after one adopts this necessary alteration of terms, two essential elements of the traditional real property doctrine are still incongruent with the notion of copyright: (1) open and notorious, and (2) actual possession.

1. Open and Notorious Possession

In a nutshell, the "open and notorious" requirement is basically one of "notice."

It is essential to the acquisition of title by adverse possession that the true owner shall have knowledge or notice, actual or constructive, of possession by another which is hostile or adverse. The true owner must have actual knowledge of the hostile claim or the possession must be so open, visible, and notorious as to raise a presumption of notice to, or knowledge by him of the adverse claim.⁹⁶

At first glance, the supposition that notice is not a problem in an adverse

relied upon in *Gee*," Appellant's Brief at 45, *Sporn* (No. 12536/76), and that a precedent was thereby established prohibiting the adverse possession of intangibles. See *id.* The appellant was of the opinion that the *Sporn* court "need only cite *O'Neill* to hold that title to [copyright] 'cannot pass' via adverse possession." *Id.* at 46. The exact quote from *O'Neill* to which appellant Murray Sporn was referring is the statement that "[n]o decision is cited, and we have found none, which holds that [intangible] rights may be acquired by adverse possession and claim of ownership." *O'Neill*, 157 N.Y.S. at 1036.

This author disagrees with the significance attributed to *O'Neill* as represented by the appellant in *Sporn*. The court in *O'Neill* never passed on the adverse possession question, and its mention of the absence of any prior precedent on this issue is mere dicta. Since the decision was deferred to the federal courts, any additional discussion of the substance of copyright law in *O'Neill* does not constitute its holding, and is certainly not binding precedent. The arguments proffered by the defendants-respondents in *Sporn* are consistent with and support this position and interpretation of the significance of the *Lightfoot* decision. See Respondent's Brief at 24-25, *Sporn* (No.12536/76) ("The court in *O'Neill* declined on the facts before it to apply adverse possession principles to a claim involving property rights in a motion picture script. But it did not reject the notion that rights of an intangible nature might be acquired by proscription [sic]; it merely had no occasion to resolve the issue one way or the other."). *Id.*

95. This proposed term could be interpreted as a synonym for copyright infringement.

96. 2 C.J.S. *Adverse Possession* § 51 (1972).

possession of a copyright claim appears acceptable. The *Gee* court certainly thought so when it held that Columbia Records “openly and notoriously” possessed Bessie Smith’s recording of “At the Christmas Ball.”⁹⁷

Subsequent to Ms. Smith’s death, when the song in issue was apparently the property of her estate, the following statement by Columbia—appearing on the record jacket of the album containing the recording of this song—was deemed sufficient notice: “She [Bessie Smith] left behind her 160 recordings (every one of them, incidentally, the property of Columbia Records).”⁹⁸ Judge Becker could “think of no more ‘open’ or ‘notorious’ assertion of ownership than the one Columbia made.”⁹⁹

The notice given by Columbia in *Gee* appears constructive in nature. However, another form of constructive notice recognized by federal copyright law is the filing of a copyright registration certificate. Consistent with *Gee*, this method of notice would probably be sufficient for adverse possession of copyright purposes since traditional adverse possession law regards the filing of a notice of claim as proper notice.¹⁰⁰ There might be a tendency for one to acknowledge and accommodate satisfaction of the “open and notorious” element through copyright “use” by an adverse possessor. However, a fundamental dilemma exists very much akin to the problems posed by the adverse possession of personal property, and cannot be overlooked when attempting to extend the doctrine to intangibles.

a. Location of the Property

Some courts have been reluctant to extend the doctrine of adverse possession to personal property because of the difficulties encountered in proving notice.¹⁰¹ The adverse possession of real property is premised on the notion that the original owner knows the exact location of his or her land.¹⁰² Due to the immovable nature of land, the adverse possessor’s occupation of the realty is deemed sufficient to constitute notice satisfying the “open and notorious” element.¹⁰³

Personal property is capable of being transported so that the original

97. *Gee*, 471 F. Supp. at 656 (emphasis deleted).

98. *Id.* (emphasis deleted).

99. *Id.*

100. See 2 C.J.S. *Adverse Possession* § 53 (1972).

101. See, e.g., *O’Keeffe*, 416 A.2d at 870-71.

102. See *supra* note 20 and accompanying text.

103. See *supra* note 20 and accompanying text.

owner could encounter difficulty in locating the adversely possessed property.¹⁰⁴ As a result, the probability of proving adverse possession of chattels is drastically reduced. Also, the opportunity for fraudulent concealment by the adverse possessor contributes to this doctrinal defect.¹⁰⁵

If disregarding the notice difficulties accompanying the adverse possession of chattels theory was not confusing enough, extending the theory to intangibles such as copyrights complicates the matter even further. Since the abstract rights associated with copyright ownership are incapable of being physically possessed, physical location of the property is indeterminable. Further, notice of adverse use of one's copyright is difficult to prove because the infringer could be anywhere within the country.

The extension of the adverse possession doctrine to chattels might be rationalized somewhat by requiring the diligent owner to make reasonable efforts to locate the property. These attempts might include factual inquiries or newspaper advertisements in the geographical location where the property was last seen, so that information can be gathered regarding its whereabouts.

Nevertheless, the type of investigation which could be conducted to find missing chattels is unrealistic where one is attempting to locate the adverse use of his or her copyright. Because there is no single physical manifestation of adverse copyright use, unlike realty and personalty, the original owner would not know where to search. Hence, how could the law, through adverse possession of copyright, consistent with its underlying purposes, punish the owner that does not have the slightest chance (in most circumstances) to exercise diligence and enforce his or her property rights?

b. Copyright Registration

One might posit the notion that an adverse possessor's copyright registration¹⁰⁶ could function as sufficient notice. However, this sugges-

104. See *supra* note 21 and accompanying text.

105. See *supra* note 22.

106. At the outset, one must realize the distinction between "registration" and "deposit" of a work. Professor Melville Nimmer clearly explains the difference between these items as follows:

Deposit and registration under the Copyright Act are "separate though closely related." The function of deposit is to provide the Library of Congress via the Copyright Office with copies and phonorecords of all works published within the United States. The function of registration is to create a written record of the

tion must fail for a different reason, namely an improper placement of the burden to discover infringement.

The registration of a copyrighted work is a discretionary process where copyrightable expression is all that is necessary to qualify.¹⁰⁷ One may view the extent of the Copyright Register's discretion in issuing a registration certificate to be so minimal as to be ministerial in nature.¹⁰⁸ The absence of a search requirement for earlier copyrighted works supports this observation.¹⁰⁹ Yet, the effect of the registration document is crucial because it constitutes *prima facie* evidence of copyright ownership.¹¹⁰

Once the original author registers his copyright, he puts the public on "actual notice . . . to those who search the Copyright Office records,"¹¹¹ and constructive notice of ownership to all others.¹¹² Completion of the registration process relieves the original owner of her duty to check for infringement, and it should be incumbent upon the adverse possessor to search for any other preexisting and substantially similar copyrighted works.

A search of the copyright office records before the good faith adverse possessor is granted registration will disclose the original copyright registration. Although the ministerial nature of the registration process¹¹³ may result in an adverse possessor's application form slipping through the system and becoming registered, eventually, the copyright which was registered first prevails at trial and all is remedied. In sum, registration should relieve the original owner of his burden to search the copyright

copyright ownership in a work. Registration necessarily requires an accompanying deposit. Deposit, on the other hand, may be accomplished without an accompanying registration.

NIMMER, *supra* note 83, § 7.17[A] at 7-176 (footnotes omitted).

107. "Section 410(a) [of the 1976 Copyright Act] requires registration and the issuance of a certificate if the Register 'after examination' determines that 'the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements' have been met. But § 410(b) requires refusal of registration if the Register determines that 'the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason.'" *Id.* § 7.21[A] at 7-204. However, the Register cannot refuse registration pursuant to a work's lack of "originality" because this is a determination for the courts. *Id.* at 7-205.

108. *But see id.* at 7-204 n.1.

109. *See* WILLIAM F. PATRY, *LATMAN'S THE COPYRIGHT LAW* 1 (6th ed. 1986).

110. "[T]he copyright registration certificate constitutes *prima facie* evidence of the validity of the copyright and of the facts stated in the certificate." NIMMER, *supra* note 83, § 7.16[D] at 7-171 (emphasis added). The validity and facts stated in the certificate identify the owner if the author is a plaintiff in a copyright infringement action. Otherwise, ownership by any other entity (other than a work for hire) must be established through a licensing agreement.

111. *Id.* § 7.16[H] at 7-175.

112. *Id.* § 7.16[E] at 7-173.

113. *See supra* note 108.

office records for subsequently filed infringing works. Instead, fulfilling the notice requirement of adverse possession by an adverse possessor's wrongful registration places the burden back upon the original owner, which is inequitable in all respects. This defeats the purposes of the federal registration system which are to "secur[e] a comprehensive record of copyright claims,"¹¹⁴ and to assure a prima facie grant of copyright when conclusive ownership must be established in a court of law.¹¹⁵

2. Actual Possession

As previously established, it is impossible to physically possess an intangible copyright.¹¹⁶ However, one could contend that the doctrine of adverse possession, when applied to copyright, should be altered to allow for physical possession of instruments of ownership as a substitute for the element of actual possession.

For instance, consider a good faith licensee who has no idea that she has been defrauded, and who is currently and unknowingly engaging in copyright infringement. Possession of this licensing contract would constitute actual possession for adverse possession purposes. Moreover, possession of a wrongfully issued registration certificate by the copyright office would also amount to actual possession according to this argument.

The possession of documents other than a registration certificate as conclusive evidence of title for intangible property rights, however, is meager proof for depriving an original owner of his copyright. First, allowing an invalid legal instrument, which purports to extend legal rights which it cannot convey, to give rise to title by adverse possession is entirely inequitable and disregards general notions of justice and fundamental fairness.

Second, for reasons discussed earlier, possession of a material object is distinguishable from "adverse use" or the exercise of rights commensurate with copyright ownership.¹¹⁷ Consistent with this position is the *Gee* court's admonition that Columbia Records "took actual possession . . . in the only meaningful sense it could: by distributing the record and retaining for itself all monies received therefrom."¹¹⁸ However, distribution is not really possession, it is adverse use or copyright infringement. Therefore,

114. See PATRY, *supra* note 109, at 176.

115. See *supra* note 110 and accompanying text.

116. See *supra* notes 85-87 and accompanying text.

117. See *supra* notes 85-95 and accompanying text.

118. *Gee*, 471 F. Supp. at 656.

all notions of actual possession should be abandoned and "actual use" adopted as the appropriate substitute if the adverse possession of copyright doctrine is to survive.

B. Exclusive Possession

The element of exclusivity must be established by proving the absence of possession by all others:

To be effective as a means of acquiring title, the possession of an adverse claimant must be exclusive of the true owner. In other words, a claimant's exclusive possession must be such as to operate as an ouster or disseisin of the owner of the legal title, and the owner must be wholly excluded from possession by claimant.¹¹⁹

Assuming that "exclusive possession" means "exclusive use" in the copyright context, a problem is created in that adverse possession could never exclude the true owner from using the copyright.

The bundle of rights to which a copyright owner is entitled under federal law are explicitly exclusive in nature.¹²⁰ Implicit in and intertwined with the exclusive rights to publish, record, and create derivative works, is the logical inference that the owner also has a right not to do so.¹²¹ This is especially true where it is in the best interest of the copyright holder to prevent the copyrighted work from entering the market at a particular point in time.¹²² Hence, copyright use by an adverse possessor should logically be considered concurrent with, not exclusive of, the original owner's rights.

C. Continuous and Hostile Possession

The concept of "continuity" refers to the uninterrupted possession of realty or personalty for the period of the statute of limitations, thus giving rise to adverse possession.¹²³ Where copyright is implicated, continuity cannot be understood in a traditional sense. Although the court in *Gee* considered the continuity element to be the only problematic issue

119. 2 C.J.S. *Adverse Possession* § 55 (1972).

120. See *infra* note 156.

121. See *infra* note 213.

122. See *infra* notes 213-14 and accompanying text.

123. See 2 C.J.S. *Adverse Possession* § 149 (1972).

concerning the adverse possession of copyright rule,¹²⁴ this requirement is not plagued by doctrinal inconsistencies.

The problem, according to the court in *Gee*, was the definition of the terms "continuous and uninterrupted."¹²⁵ After considering a variety of criteria,¹²⁶ the court eventually defined continuous use as "availability."¹²⁷ Regardless of how courts define the term "continuous" for adverse possession of copyright purposes, the ultimate concern is when to toll the statute of limitations. This definition of "continuous" can be worked out (even if on a case-by-case basis) without presenting the quandary that the other adverse possession elements entail.

Besides the element of continuity, the only other element which could possibly be fulfilled in an adverse possession of copyright action is that of "hostility." The term "hostile" is synonymous with adversity in interest to the true owner.¹²⁸ Hence, any unauthorized use of a work made by a person or entity other than the original owner is adverse and hostile to the latter's copyright ownership interest, and does not warrant further discussion.

V. FEDERAL PREEMPTION

The adverse possession of real and personal property is exclusively a

124. See *Gee*, 471 F. Supp. at 656.

125. *Id.*

126. The *Gee* court, before deciding on any particular approach to the issue of whether defendant Columbia Records continuously possessed or used Bessie Smith's recording of "At the Christmas Ball," outlined a number of views. *Id.* at 656. Judge Becker stated as follows:

Indeed our only real question is whether defendants' actions were "continuous" and "uninterrupted" during the entire statutory period—three years in New York, six in Pennsylvania. While that concept has a readily ascertainable meaning in the case of land or tangible personalty like chattels, it is not obvious what constitutes "continuous" and "uninterrupted" use in the case of a singing performance embodied in a record. One criterion would be how long defendants continued to receive money from the sale of the record. Another criterion would be how long the record was listed in the record company's catalogue available for distribution. Another possibility would be to focus on whether the 1951 four volume album became part of the permanent collection of libraries, including the Library of Congress. In that event, the duration of its listing in library catalogues might be dispositive.

Id.

127. *Id.*

128. See 2 C.J.S. *Adverse Possession* § 59 (1972).

matter of state law enacted pursuant to the states' police power.¹²⁹ Pursuant to the Copyright Clause in the United States Constitution,¹³⁰ Congress has the authority to enact federal legislation governing the subject matter of copyright.¹³¹ In sum, the state doctrine of adverse possession as applied to copyright is preempted by existing federal copyright law.

The constitutional basis for the doctrine of federal preemption is the Supremacy Clause, which provides: "This Constitution, and the laws of the United States which shall be made in Pursuance thereof . . . shall be . . . the supreme Law of the Land; and the Judges in every State shall be bound thereby . . ." ¹³² The logical inference and plain meaning of the text of this clause indicates that, where federal and state law clash, the former controls if it is constitutionally valid.¹³³

It was assumed from the time of adoption of the Copyright Clause, and subsequently confirmed by the United States Supreme Court in *Goldstein v. California*,¹³⁴ that the states and the federal government possess concurrent powers to enact copyright laws, subject only to preemption by

129. Cf. 16A C.J.S. *Constitutional Law* § 432 (1972) ("The police power pertains to such rules and regulations relating to personal and property rights as affect the public health, public safety, and public welfare. It is the power inherent in a government to enact laws, within constitutional limits, to promote the order, safety, health, morals, and general welfare of society.")

130. U.S. CONST. art. I, § 8, cl. 8.

131. See NIMMER, *supra* note 83, § 1.02 at 1-30.

132. U.S. CONST. art. VI, § 2.

133. This interpretation applies with great force if read in conjunction with the intent of the framers of the Constitution when the Copyright Clause was adopted. There was virtually unanimous agreement amongst the framers that the copyright power should be subject to federal control. See NIMMER, *supra* note 83, § 1.01[A] at 1-3. This virtual consensus is evinced by the brief discussion of the Copyright Clause by James Madison in *Federalist Paper No. 43*, which recognized the impotence of the states to ever render effectual legal doctrine. *Id.*

A single paragraph was all that was deemed necessary by Madison to convince the ratifiers at the Constitutional Convention in 1787 of the utility of the Copyright Clause:

The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged in Great Britain to be a right of common law. The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals. The States cannot separately make effectual provision for either of the cases, and most of them have anticipated the decision of this point by laws passed at the instance of Congress.

THE FEDERALIST NO. 43 (James Madison).

The fact that a mere paragraph was written on the subject is persuasive evidence, *per se*, of the force and content of the framers' intent. Also, Madison's mention of Great Britain's common law approach to copyright, when analyzed in conjunction with the intense disdain for the English monarchy at the time of ratification, leads to a tacit conclusion that federal statutory law should preempt, in all circumstances, state common law enactments that are similar to English law.

134. 412 U.S. 546 (1973).

federal statute.¹³⁵ The doctrine of federal preemption, derived from the express language of the Supremacy Clause, was codified by Congress in 1976 in section 301 of the Copyright Act.¹³⁶ The scope of state laws subject to federal preemption is defined by this enactment.¹³⁷

Under 17 U.S.C. § 301(a), a state law is subject to federal preemption if it creates:

[L]egal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103.¹³⁸

The requirements of this statute and the law of federal preemption can be divided into four distinct elements: (1) equivalent rights; (2) a tangible medium of expression; (3) the subject matter of copyright; and (4) consistency with the requirements of the Supremacy Clause of the Constitution.¹³⁹

A. Equivalent Rights

Courts have utilized two general approaches for ascertaining whether a state right is equivalent to section 106's exclusive federal rights recognized pursuant to section 301(a). A state right is equivalent to an exclusive federal right if:

- (1) the right encompasses conduct coming within the scope of one or more of section 106's exclusive rights, and
- (2) if applicable state law requires the plaintiff to prove no more than the elements that the Copyright Act requires for proof of infringement of one or more of section 106's five exclusive

135. See NIMMER, *supra* note 83, § 1.01[B] at 1-7.

136. *Id.* § 1.01[B] at 1-8.

137. *See id.*

138. 17 U.S.C. § 301(a) (1977).

139. Professor Melville Nimmer treats federal preemption as a two part test, namely: (1) "[T]he nature of the rights granted under state law"; and (2) "[T]he nature of the work in which such rights may be claimed." NIMMER, *supra* note 83, § 1.01[B] at 1-10 to 1-11. Professor Paul Goldstein classifies the preemption doctrine as a three part test which is essentially co-extensive with the first three elements recognized in this comment. *See* PAUL GOLDSTEIN, COPYRIGHT PRINCIPLES, LAW AND PRACTICE § 15.2, at 473-74 (1989). The author of this comment adds a fourth element based upon the bare minimum constitutional requirements of the Supremacy Clause. Of course, reasonable minds can differ.

rights.¹⁴⁰

Under either of these judicial constructions of section 301(a), the state doctrine of adverse possession of copyright is equivalent to the exclusive rights existing under federal copyright law, and should therefore be preempted.

1. The General Scope or Nature of Copyright Test

The apparent intent of Congress with regard to preemption under section 301 is one of liberal deference to federal copyright law.¹⁴¹ "The 'general scope of copyright' means the full scope that Congress could have described for any particular [federal] right."¹⁴² Preemption results regardless of whether the state right is broader or narrower than the federal right.¹⁴³ Further, any mention of section 106 in the preemption statute "is by way of identification and not limitation."¹⁴⁴ "[E]ven if the precise contours of the [state] right differ from any of those contained in section 106,"¹⁴⁵ it is nevertheless subject to preemption.¹⁴⁶

Despite the elimination of provisions from the draft of the bill explicitly itemizing rights not subject to preemption,¹⁴⁷ various courts have held the following state rights not to be affected by the enactment of section 301: (1) express or implied contracts protecting ideas;¹⁴⁸ (2) fraud;¹⁴⁹ (3) breach of confidentiality;¹⁵⁰ (4) rights to privacy;¹⁵¹ (5)

140. See GOLDSTEIN, *supra* note 139, § 15.2.1 at 476.

141. See NIMMER, *supra* note 83, § 1.01[B][1] at 1-11 n.33 (citing H.R. REP. NO. 94-1476, 94th Cong., 2d Sess. 131 (1976) [hereinafter H.R. REP.]) ("The preemption is intended to be complete with respect to any work coming within the scope of the bill . . ."). But see *id.* at 1-12 n.35 (citing H.R. 4347, 89th Cong., 2d Sess. (1966)) (A change in the language of the bill from "all rights in the nature of copyright" to "all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by § 106" indicates that Congress may have intended to narrow the scope of preemption.).

142. See GOLDSTEIN, *supra* note 139, § 15.2.1.1 at 476.

143. See NIMMER, *supra* note 83, § 1.01[B][1] at 1-13; see also GOLDSTEIN, *supra* note 139, § 15.2.1.1.

144. See NIMMER, *supra* note 83, § 1.01[B][1] at 1-12.

145. *Id.*

146. *Id.*

147. See *id.* § 1.01[B][1] at 1-15 ("[B]efore its amendment into the form which appears in the Copyright Act, § 301(b)(3) set forth certain examples of rights that are not 'equivalent' to copyright.").

148. *Id.* § 1.01[B][1] at 1-16 to -16.1 n.46.

149. See NIMMER, *supra* note 83, § 1.01 [B][1] at 1-16.1 n.47.

150. *Id.* at 1-16.2 n.48.

151. *Id.* at 1-18.1 n.49.

defamation,¹⁵² and (6) the right of publicity.¹⁵³ Although extensive debate has ensued regarding the equivalency of the tort of misappropriation to copyright law,¹⁵⁴ federal preemption of adverse possession had not been addressed by Congress or the courts at that time.

The torts of conversion and trespass were dismissed by Congress as not being subject to preemption primarily because these causes of action involve tangible, not intangible property.¹⁵⁵ The exclusion of these tangible torts from preemption is an example of the broad nature and scope of copyright Congress intended for determining whether federal rights are equivalent to state rights. Following the liberal preemption approach evident from the legislative history of section 301, since the state adverse possession of copyright doctrine involves intangible property rights, it is subject to preemption under the tangible/intangible test applied by Congress to strike the torts of conversion and trespass from the bill that later became section 301. The five exclusive rights mentioned in section 106 are: (1) reproduction, (2) preparation of derivative works, (3) distribution, (4) performance, and (5) public display.¹⁵⁶ When a party claims adverse possession of another's copyright, as was the case in *Gee*, title to the entire bundle of rights pertaining to the work thereto are theoretically passed to the adverse possessor. This assertion of intangible property rights per se is entirely within the scope of federal copyright protection and must be preempted according to the "equivalency test" for two reasons.

First, once a party successfully proves adverse possession of another's copyright, he becomes the rightful owner of the copyright and may assert any of the exclusive rights mentioned under section 106. Second, in order to accomplish the above result, the adverse possessor must prove, essentially, that he infringed the original owner's copyright in a proscribed way and for a specific period of time. In other words, the general subject matter of section 301 is implicated in any adverse possession action, and preemption is thereby required according to the broad "equivalency test."

2. The "Extra-Element" Approach

"Courts generally hold that a state right is not equivalent to copyright, and thus is not subject to preemption, if the state cause of action contains

152. *Id.*

153. *Id.* at n.49.1.

154. See NIMMER, *supra* note 83, § 1.01[B][1] at 1-19 to -20.7.

155. *Id.* § 1.01[B][1] at 1-20 n.51.

156. See 17 U.S.C. § 106 (1977).

an operative element that is absent from the cause of action for copyright infringement."¹⁵⁷ Applying this formulation of the "extra-element" approach literally—by comparing adverse possession and a cause of action for copyright infringement—presents difficulties. Generally, one could view the doctrine of adverse possession as either a cause of action or an affirmative defense. This Article takes the position that the doctrine is a hybrid, depending on the manner in which it is raised according to court procedure.

Traditionally, if the original landowner brings an action sounding in trespass to dispose of the adverse possessor, then the doctrine would be raised as an affirmative defense much akin to a statute of limitations time bar in any civil action. On the other hand, the adverse possessor, upon learning the identity of the original owner, may institute suit and invoke the doctrine of adverse possession as a cause of action. Even if the original owner cannot be found, an action to quiet title would be treated similarly. These procedural distinctions have an impact on the application of the "extra-element" test depending upon how one construes this judicial approach to federal preemption.

A strict construction of the "extra-element" theory would entail only a comparison between the elements of adverse possession as a state cause of action and those of a copyright infringement action. Hence, if the doctrine of adverse possession is raised as a defense, or is considered to be a defense in disguise, it is automatically preempted.

A liberal interpretation of the "extra-element" standard would treat the classification of a state legal theory as an action or defense to be a mere formality, and would look to the underlying substance of the right. Thus, the "extra-element" would include those elements contained within both defenses and causes of action. A liberal construction would be sensible because regardless of how adverse possession is claimed, whether it be as an affirmative defense or a cause of action, the adverse possessor would possess the burden of proof, despite procedural semantics.

Although the copyright portion of the analysis refers specifically to an infringement action,¹⁵⁸ any defense or related matter which serves to preclude the institution of such a federal action should be considered when comparing federal and state rights. Under such a construction of the "extra-element" approach, the proof required under adverse possession of copyright, whether pleaded as an action or an affirmative defense, would be compared to the proof necessary to prove a *prima facie* case of federal

157. GOLDSTEIN, *supra* note 139, § 15.2.1.2 at 478.

158. *Id.*

copyright infringement as well as any applicable affirmative defenses.

This liberal construction of the "extra-element" standard appears to be the most viable alternative because it prevents state procedural classification of adverse possession from circumventing federal preemption. It would not be reasonable, under a strict construction of the "extra-element" test, to allow preemption merely because an adverse possessor brought an action before the original owner could do so. Whether a right is classified as a defense or an action, the same elements of adverse possession must be satisfied. Further, all defenses to copyright infringement should be considered elements under the "extra-element" test since they are often mutually exclusive and closely related to the elements of a prima facie case that must be established.¹⁵⁹ The only difference in most instances is that the defendant has the burden of proof where a right is classified as an affirmative defense.

Thus, regardless of which construction of the "extra-element" test is adopted, the state adverse possession of copyright doctrine must be preempted. In the following sections, the elements of a cause of action for adverse possession of copyright and a federal infringement action will be compared to demonstrate that no "extra element" exists.

a. Intent

"The question of adverse possession is one of intention; and the claim of adverse possession is founded on the intent with which the occupant has held possession."¹⁶⁰ The intent of a claimant to acquire title is essential to establish the elements of "hostile possession under a claim of right" and "exclusive possession."¹⁶¹

Under the "extra-element" approach, in order "[t]o save a state right from preemption, the extra element must relate to the economic scope of the right and not to the state of mind of the defendant."¹⁶² Hence, the adverse possession elements of "hostility" and "exclusivity" cannot be considered "extra elements" under any circumstances.

159. See, e.g., NIMMER, *supra* note 83, § 13.06 at 13-130 (The defense of "abandonment" of copyright is the functional equivalent of contesting the element of "ownership" in a cause of action for copyright infringement.).

160. 2 C.J.S. *Adverse Possession* § 26 (1972).

161. *Id.* at 681. "There can be no adverse possession without an intention to claim title coincident with the possession; and such intention is essential to make the possession adverse, hostile, and exclusive." *Id.* (footnotes omitted).

162. GOLDSTEIN, *supra* note 139, § 15.2.1.2 at 478-79.

A rationale for the above "state-of-mind" exception in favor of federal preemption stems from the nature of an action for copyright infringement. Copyright infringement certainly does not involve an intentional tort, rather, it sounds in either strict liability or negligence.

"[T]here are only two elements necessary to the plaintiff's case in an infringement action: ownership of the copyright by the plaintiff and copying by the defendant."¹⁶³ The only culpable act the plaintiff must prove is copying by the defendant. Thus, the crux of an infringement action is the act of copying by a defendant, not his state of mind. Liability for the mere commission of an act is akin to strict liability.

Also, one may view an infringement action as one of negligence—even though the defendant inadvertently copies the plaintiff's work, he is under a duty to be aware of its existence, and should check the copyright office records to prevent a future infringement. The legal reality that the "innocent intent" of the defendant is not a defense to a copyright infringement action¹⁶⁴ supports the strict liability and/or negligence classifications. Moreover, the relevance of an adverse possessor's "good faith" intention to traditional adverse possession doctrine in the real and personal property context,¹⁶⁵ and its irrelevance to copyright infringement, suggest that copyright and adverse possession are strange bedfellows, with significant theoretical distinctions.

b. Open and Notorious

"Unless, the true owner has actual knowledge of the hostile claim, it is essential to the acquisition of title by . . . adverse possession that the possession be open, . . . visible, . . . public, and notorious."¹⁶⁶ Thus, in adverse possession of copyright, the adverse possessor must utilize the original owner's work in such a way as to give the latter notice of infringement. Where the original owner does not have actual knowledge of the infringement, the doctrine of "fraudulent concealment"¹⁶⁷ is the device which precludes the open and notorious element from being

163. NIMMER, *supra* note 83, § 13.01 at 13-4 (footnotes omitted).

164. *See id.* § 13.08 at 13-137. However, the defense of innocent intent may "bear upon the remedies available against such a defendant." *Id.*

165. *See* GERSTENBLITH, *supra* note 2, at 119.

166. 2 C.J.S. *Adverse Possession* § 48 (1972) (citations omitted).

167. "American legislatures have given concrete shape to the maxim that no man should profit from his own wrong by enacting statutes precluding use of statutes of limitations when they would allow defendants to hide behind their own fraudulent acts." R.H. HELMHOLZ, *Wrongful Possession Of Chattels: Hornbook Law And Case Law*, 80 Nw. U. L. Rev. 1221, 1234 (1986).

considered an "extra element."

"It is a well settled principle of general common law . . . as well as of federal law, . . . that fraudulent concealment of a cause of action by the defendant will toll the statute of limitations."¹⁶⁸ Hence, a defendant in a copyright infringement case cannot succeed upon a statute of limitations defense if he fraudulently concealed his use of the work.

Although the element of fraud may be lacking in an adverse possession of copyright claim, one thing is certain: If the adverse possessor conceals his use of the work, the open and notorious element cannot be established. As a result, the element of open and notorious possession is partially incorporated into the fraudulent concealment doctrine, and thereby fails the "extra-element" test.

Fraudulent concealment presupposes that the plaintiff did not have actual knowledge of the adverse use. If there is actual knowledge, however, preemption would nevertheless result. Upon proof that the original owner possessed actual knowledge of adverse possession, the open and notorious element need not be established. Whether or not actual knowledge then becomes a substituted element of adverse possession, in lieu of the open and notorious requirement, is a question of semantics. If actual knowledge is not considered an element, it is subject to preemption for its failure to meet the "extra-element" test. But, even if one assumes that actual knowledge does become an element in lieu of the open and notorious possession requirement, it would not amount to an "extra element."

Under federal law, a plaintiff may be estopped from claiming copyright infringement where: (1) the plaintiff knew the facts of the defendant's infringing conduct, (2) the defendant intended that his conduct would be acted on, (3) the defendant must be ignorant of the true facts, and (4) the defendant must rely on the plaintiff's conduct to his injury.¹⁶⁹ The first element of this defense requires that the plaintiff/original owner have knowledge of the defendant/adverse possessor's use of the copyrighted work. Therefore, since one of the elements of the federal estoppel defense is equivalent to the adverse possession element of actual knowledge, the latter is not an "extra element" and thereby lends support to the preemption position.

168. *Prather v. Neva Paperbacks, Inc.*, 446 F.2d 338, 340-41 (5th Cir. 1971).

169. *NIMMER*, *supra* note 83, § 13.07 at 13-133 to -134.

c. Actual Possession

In order to prevail on a traditional adverse possession claim for real property, "there must be actual possession of some part of the premises, rather than a mere constructive possession."¹⁷⁰ Applying this doctrine to copyright becomes impossible, because one cannot physically possess something intangible.¹⁷¹ However, assuming one could adversely possess a copyright, such possession would always be merely symbolic—in the form of a copyright registration certificate or other document.¹⁷² Hence, the element of actual possession would need to be eliminated if applied to copyright, and therefore, it could not qualify as an "extra element" and would be subject to preemption.

Notwithstanding the above position, even if a copyright could be actually possessed, this element would still fall short of becoming an "extra element." "Generally speaking, actual possession may and must consist of the exercise of positive, physical acts of dominion or ownership . . ."¹⁷³ Essentially then, any dispute as to the element of actual copyright possession would be an issue of "ownership"—a primary element in proving a prima facie case of copyright infringement.¹⁷⁴ Therefore, these elements of "ownership" and "actual possession" are one in the same, actual possession does not constitute an "extra element," and it is thereby subjected to federal preemption.¹⁷⁵

170. 2 C.J.S. *Adverse Possession* § 30 (1972).

171. See *supra* notes 85-87 and accompanying text.

172. The reference here to actual and constructive possession should not be confused with the previous discussion of actual and constructive notice. See *supra* notes 106-10 and accompanying text. The former distinction merely signifies the impossibility for one to ever physically possess intangible property, except when constructively manifested in a separate and collateral legal document or instrument. Although this could be a form of possession, it is certainly not "actual possession" within the meaning of adverse possession theory.

173. 2 C.J.S. *Adverse Possession* § 33 (1972) (footnotes omitted).

174. See NIMMER, *supra* note 83, § 13.01 at 13-4.

175. Further, within the copyright infringement issue of ownership is the defense of abandonment. See NIMMER, *supra* note 83, § 13.06 at 13-130. A plaintiff's intentional and voluntary abandonment of his copyright prevents the manifestation of his cause of action due to the inability of establishing the element of ownership.

At first glance, one might equate abandonment with an original copyright owner's failure to diligently utilize his work within the framework of adverse possession and its policies (including an original owner sleeping on his rights). See *infra* part VI.B. (discussion of "demerit" theory). This concept could be classified as "constructive abandonment." However, the requirement that the copyright owner must intend "to surrender rights in his work," NIMMER, *supra* note 83, § 13.06 at 13-130, differs substantially from the intent of adverse possession.

Where adverse possession is involved, the intent of the original owner is irrelevant. See

In addition, it is important to recognize the consequence of a prima facie case of adverse possession of copyright. Under this doctrine, the ultimate result is a transfer of ownership from the original copyright owner to the adverse possessor.

One could easily conclude that the doctrine as a whole involves merely the question of ownership required to prove a prima facie case of copyright infringement. According to this reasoning, all of the elements of adverse possession relate to, and are encompassed within, the ownership element. Acceptance of this argument, of course, presumes that there are no "extra elements," and thus warrants a finding of federal preemption.

d. Continuous Possession and Section 507

"Continuity of adverse possession for the full statutory period without interruption or breach is generally considered to be an essential prerequisite to the perfection of title by adverse possession; indeed, continuity is perhaps the most important concept in this doctrine of limitations."¹⁷⁶ Therefore, the state statute of limitations is indispensable to the element of "continuity."

Similarly, under federal law, satisfaction of the statute of limitations is necessary to successfully institute an action for copyright infringement. Section 507(b) of the 1976 Copyright Act provides that "[n]o civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued."¹⁷⁷ This three year statute serves the same general purpose as state adverse possession continuity requirements and, as a result, cannot be an "extra element" escaping preemption.

Despite the generic nature of the statute of limitations as it pertains to the continuity element, it is possible to consider the state continuity requirement as going one step further than what is necessary under section 507. Not only must the original owner bring an action prior to the statute running its course, but even if the statute has expired, an interrupted or discontinued possession by the adverse possessor will invalidate his claim

supra notes 162-65 and accompanying text. Instead, an intent to abandon leaves the copyrighted work without an owner and thrusts it into the public domain, thus making adverse possession unnecessary and impossible.

176. 2 C.J.S. *Adverse Possession* § 149 (1972) (footnotes omitted).

177. 17 U.S.C. § 507(b) (1992).

to title.¹⁷⁸ Under the federal statute, no such continuity is required other than that an action be "commenced within three years after the claim accrued."¹⁷⁹ Hence, the state continuous possession requirement might be considered an "extra element" rendering federal preemption under section 507(b) inoperative. However, other inconsistent state time frames must conform to the express three year statute.¹⁸⁰

The adverse possessor's argument is tenuous in two respects: (1) it ignores the effect of "claim accrual" upon operation of the state continuity requirement; and (2) it disregards the federal policies underlying section 507. Before these two problems can be addressed, it is important to understand the difference between adverse possession of land of chattels and that of copyright.

Assuming that adverse possession of intangible property is accorded credence, since there can be no physical possession of this form of property,¹⁸¹ there must be some type of "use" of this abstract property. Therefore, the "continuous possession" element must be transformed to "continuous use." Once this distinction is noted, one can easily foresee the overlap between the federal and state statutes.

Since each separate act constitutes a separate and actionable infringement, the result is that section 507(b) prevents an infringer's use from ever being continuous. Even if an adverse possessor utilizes another's copyright continuously for three years without the original owner commencing an infringement action, on the last day before the statute runs a new cause of action would accrue, thus starting the three year statute running anew. Therefore, the continuity requirement cannot exist co-extensively with section 507, and there is, in reality, no "extra element" precluding federal preemption.

The intent of Congress in enacting the three year federal statute of limitations for copyright infringement actions was set forth in *Prather v. Neva Paperbacks, Inc.*,¹⁸² where the court rejected the plaintiff's argument

178. "Generally, under the rule necessitating continuity of adverse possession, continuous possession is possession which has not been abandoned by the claimant, and uninterrupted possession is that which has not been effectively interrupted by possession of another. So, continuous adverse possession is not established by a mere claim of title, disconnected periods of occupancy, casual or incidental acts of dominion or trespass, or sporadic acts of ownership widely scattered and not persisted in, even where such incursions cover the whole period of limitations." 2 C.J.S. *Adverse Possession* § 150 (1972) (footnotes omitted).

179. 17 U.S.C. § 507(b) (1992).

180. See *infra* note 182 and accompanying text.

181. See *supra* note 83 and accompanying text.

182. 446 F.2d 338, 340-41 (5th Cir 1971).

that the Florida Blameless Ignorance Rule should operate to toll the federal statute.¹⁸³

Circuit Judge Goldberg, writing for the *Prather* court, reasoned as follows:

Prior to 1957 there was no statute of limitations on civil suits relating to copyright infringement, and courts applied the law of the state in which the action was brought. This led to a wide divergence of time periods in which infringement suits could be brought in the various states and thus encouraged forum shopping. The Senate report on the bill which became the limitations statute leaves no doubt but that the purpose of the legislation incorporating the three year limitations period was to provide a uniform federal period of limitations applicable throughout the United States. . . . In short, the federal statute seeks to nationalize the copyright statute of limitations, but if each state can fetter, condition, and entail its effect, we end with a parochial instead of a national statute.¹⁸⁴

If state statutes of limitations were applied in adverse possession of copyright cases, the purpose of section 507 would be circumvented. Claimants would be permitted to engage in forum shopping because there is no national uniformity with regard to state adverse possession law. Thus, any state time period other than three years would be inconsistent with the provisions of section 507, would not be considered an "extra" or different element, and would thereby be subject to absolute federal preemption.

B. Tangible Medium of Expression

"Section 301 . . . expressly withhold[s] federal preemption from works 'not fixed in any tangible medium of expression.' As to such works, the states may fashion such protection as they wish, including rights which are 'equivalent' to copyright."¹⁸⁵ Examples of state rights in unfixed works that are immune from preemption were set forth in the House Report

183. *See id.* at 339-40.

184. *Id.* Here, the court in *Prather* was discussing the three year statute of limitations earmarked as 17 U.S.C. § 115(b) (1992). *See id.* at 339. Although the section number of this provision was changed to 17 U.S.C. § 507(b) (1992), the text of this statute has remained unaltered. *See* NIMMER, *supra* note 83, § 12.05 at 12-64.13 n.2. Hence, the same legislative intent underlying the adoption of § 115(b) as discussed in *Prather* survives and applies to the current § 507(b).

185. NIMMER, *supra* note 83, § 1.01[B][2][a] at 1-23.

a prima facie case of adverse possession of a work not fixed in a tangible medium of expression, under some hypothetical state law, one must show that the work was utilized only by simultaneously proving that it has now been transformed into a fixed and tangible medium of expression. Without further discussion, it is clear that this doctrine would be subject to federal preemption because the tangible expression would now fall within the ambit of federal copyright law.

C. Subject Matter of Copyright

The third requirement for federal preemption is that the state law "come within the subject matter of copyright as specified by sections 102 and 103."¹⁸⁸ Section 102 partially defines the "subject matter of copyright" by listing seven types of "works of authorship:"

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works; and
- (7) sound recordings.¹⁸⁹

Section 103 merely incorporates "compilations and derivative works" into the above categories.¹⁹⁰

It is evident that any state claim for adverse possession of copyright will come within the subject matter of copyright and thus meet this requisite for federal preemption under section 301(a). The categories which describe various works of authorship in sections 102 and 103 run the gamut of creativity, and would apply to all works under which an adverse possession claim could be made. The fact that the state adverse possession doctrine purports to grant title to federal copyright law rights is enough to establish that it would always meet the subject matter test.

Even if the adversely possessed work is not a valid copyright because it fails to comply with the federal laws, this is inconsequential for preemption purposes. If the work could have qualified for federal protection, then it is within the subject matter of sections 102 and 103. For example, if a sound recording fell into the public domain, a state law

188. 17 U.S.C. § 301(a) (1976).

189. 17 U.S.C. § 102(a) (1976).

190. See 17 U.S.C. § 103(a) (1977). "The subject matter of copyright as specified in § 102 includes compilations and derivative works." *Id.*

accompanying the passage of section 301: “[1] Choreography that has never been filmed or notated, [2] an extemporaneous speech, [3] ‘original works of authorship’ communicated solely through conversations or live broadcasts, and [4] a dramatic sketch or musical composition improvised or developed from memory and without being recorded or written down.”¹⁸⁶

The adverse possession of copyright doctrine, by definition, would always satisfy the “tangible medium of expression” requirement, and would be preempted by federal law under all circumstances. All works subject to copyright protection under federal law must be fixed in a tangible expression in order to be classified as such. Therefore, if one claims that he adversely possessed another’s otherwise valid copyright, this allegation alone admits the tangible fixation of expression; otherwise, there would be no copyright adversely to possess.

Whether states may apply adverse possession to works or ideas that would not otherwise qualify for copyright protection or be preempted due to the absence of a fixed tangible medium of expression, is a separate question not within the scope of this Article. However, brief mention of the logical impossibility of such doctrines to exist and survive is warranted.

If it is difficult to envision the adverse possession of intangible rights with regard to copyright, it becomes absurd to consider possession of another’s idea or unfixated expression. Not only is there no object to be physically possessed, there is no tangible expression that can be duplicated. The idea or unfixated expression would remain in the public domain unless a contract right pertaining thereto is violated.

Furthermore, if an adverse possessor seeks to prove the elements of adverse possession under *Gee*, she would be required to show that “use” was made of the property. In order to do so, there must be a fixed and tangible medium of expression; absent a contract for an idea, no property rights exist, and there is no title to adversely possess or use.¹⁸⁷

However, assuming the preceding action is valid, in order to make out

186. GOLDSTEIN, *supra* note 139, § 15.2.2 at 486.

187. Even if there was a contract for an idea, and the party who paid valuable consideration for this public domain matter transformed it into a tangible expression or misused the idea in breach of the contract terms, only a breach of contract action would be available to the aggrieved party. Otherwise, a proposition that one can adversely possess a contractual right would develop. Certainly, this concept is ludicrous. Persistent breaches of contract, without the non-breaching party taking legal recourse, is remedied most equitably through the concept of equitable estoppel and the statute of limitations for breach of contract. In addition, acquiescence of the non-breaching party to potential breaching activity can be used to interpret the contract itself, within the substantive framework of contract law.

granting protection to this work via adverse possession would nevertheless be subject to preemption.

The legislative history underlying adoption of the 1976 Copyright Act supports the broad interpretation that should be afforded to the subject matter of copyright. The House Report accompanying the Act states:

As long as a work fits within one of the general subject matter categories of sections 102 and 103, the bill prevents the States from protecting it even if it fails to achieve Federal statutory copyright because it is too minimal or lacking in originality to qualify, or because it has fallen into the public domain.¹⁹¹

The *Gee* court failed to recognize the significance of this preemptive scenario, although the rights at issue therein certainly came within the subject matter of copyright. In *Gee*, the controversy surrounding Bessie Smith's recording of "At the Christmas Ball" fits squarely within two of the works of authorship defining the subject matter of federal copyright law, namely, (1) a "musical work [with] accompanying words,"¹⁹² and (2) a "sound recording."¹⁹³ Thus, as illustrated in *Gee*, the state adverse possession of copyright doctrine must become one with the subject matter of copyright under all circumstances.

D. The Supremacy Clause

If the federal copyright preemption statute, 17 U.S.C. § 301, did not exist, a constitutional attack based on the Supremacy Clause of the Constitution alone would be enough to preempt the state adverse possession of copyright doctrine. Despite the Congressional codification of the policies of the Supremacy and Copyright Clauses of the Constitution into section 301, "[s]everal courts have treated [this section] and the supremacy clause as discrete sources of preemption."¹⁹⁴ Now, the policies and history surrounding the Supremacy Clause will be analyzed to demonstrate that an adverse possession of copyright theory would be preempted even in the absence of section 301.

191. H.R. REP., *supra* note 141, at 131. GOLDSTEIN, *supra* note 139, § 15.2.3 at 490; NIMMER, *supra* note 83, § 1.01[B][2] at 1-22.2 n.87.

192. 17 U.S.C. § 102(a)(2) (1977).

193. *Id.* at § 102(a)(7).

194. PAUL GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES: CASES AND MATERIALS ON THE LAW OF INTELLECTUAL PROPERTY 771 (3d ed. 1990); *see, e.g.*, Associated Film Distrib. Corp. v. Thornburgh, 614 F. Supp. 1100 (E.D. Pa. 1985), *aff'd*, 800 F.2d 369 (3d Cir. 1986).

Alexander Hamilton discussed the scope of the Supremacy Clause as follows:

[I]t will not follow . . . that acts of the larger society [the federal government] which are *not pursuant* to its constitutional powers, but which are invasions of the residuary authorities of the smaller societies, [the states] will become the supreme law of the land. These will be merely acts of usurpation, and will deserve to be treated as such. Hence we perceive that the clause which declares the supremacy of the laws of the Union, . . . only declares a truth which flows immediately and necessarily from the institution of a federal government. It will not, I presume, have escaped observation that it expressly confines this supremacy to laws made *pursuant to the Constitution*¹⁹⁵

Apparently, the import of Hamilton's argument is that powers not expressly and exclusively conferred upon Congress by the Constitution reside in the states. This inherent state domain is subject neither to the intrusions of the Supremacy Clause nor to the doctrine of federal preemption.

In the copyright area, it is clear that Congress has the express power to legislate pursuant to Article I, Section 8, Clause 8 of the Constitution.¹⁹⁶ The issue then becomes whether this express power prevents the individual states from enacting copyright related laws in the absence of federal legislation. Under a strict interpretation of the Supremacy Clause, the issue would be resolved in the affirmative.

Judging from the comments of Alexander Hamilton, the expression of one power by the federal government leads to the exclusion of other residual powers of the states,¹⁹⁷ unless the express power specifically refers to the states. This position can be inferred from Hamilton's discourse on the inapplicability of the Supremacy Clause to the taxing power.

In the area of taxation, the Constitution grants concurrent jurisdiction to the states and the federal government.¹⁹⁸ Therefore, the contention in support of a strict interpretation would focus upon the failure of the framers to include a concurrent powers provision in the Copyright Clause, while it did do so in the Taxing and Spending Clause. As a result, under this

195. THE FEDERALIST NO. 34, at 204-05 (Alexander Hamilton) (emphasis in original).

196. U.S. CONST. art. 1, § 8, cl. 8.

197. The maxim, *Expressio unius est exclusio alterius*, is obviously implicated here. "When certain persons or things are specified in a law . . . an intention to exclude all others from its operation may be inferred." BLACK'S LAW DICTIONARY 521 (5th ed. 1979).

198. See THE FEDERALIST, *supra* note 195, at 205.

construction, the adverse possession of copyright doctrine would be preempted regardless of whether any federal laws were enacted pursuant to the Copyright Clause.

Even under a liberal interpretation of the Copyright Clause, the plain language and meaning of its provision would preclude application of the state adverse possession doctrine. An expansive application of the Copyright Clause would allow the states to create law regarding matters not within the scope of federal legislation. The courts have adopted this view to a certain extent, thereby allowing state protection for ideas, facts and various other items.¹⁹⁹

Even in the absence of section 301 and any federal copyright law, the Supremacy Clause limits the states from imposing or preventing any type of monopoly available to authors for their "respective writings and discoveries,"²⁰⁰ because this power is expressly reserved to Congress by virtue of the Copyright Clause. This position is consistent with the validity of state common law copyright protection because ideas are not "writings." Therefore, under a pure constitutional approach, the state doctrine of adverse possession could never permissibly be applied where "writings" or expression are concerned, and the *Gee* decision would be constitutionally invalid even if no federal copyright law existed.

VI. THE POLICIES UNDERLYING ADVERSE POSSESSION AND FEDERAL COPYRIGHT LAW

The two primary policies advanced by the doctrine of adverse possession concern statutes of limitations and the utilization of property. These rationales acquire acceptance and strength where real and personal property are involved. However, attempting to promote these basic premises by extending the doctrine to copyright, clashes with both the policies that form the backbone of copyright law and those mandated by the Constitution.

At this point, the importance of the conflicting policies described above will be addressed. This Article contends that the policies of copyright should prevail and that the doctrine of adverse possession should never apply to copyright law. The crucial role that policy arguments play in our society cannot be understated. They cut at the very existence of each and every law and function as a skeleton that supports the rules that

199. See *supra* notes 148-54 and accompanying text.

200. U.S. CONST. art. 1, § 8, cl. 8.

The function of adverse possession is akin to that of a statute of limitations,²⁰¹ namely to avoid stale claims and to encourage "the settlement and repose of titles."²⁰² Hence, policies of stability and evasion of evidentiary problems—encountered where a lazy property owner attempts to regain access to his property—are promoted by this doctrine. Basically, inclusion of the "continuous possession" requirement in a prima facie case for adverse possession is the equivalent of a statute of limitations against the original owner of the property—its expiration bars his legal rights to reclaim the property.

Section 507 of the 1976 Copyright Act fulfills the purpose of avoiding stale claims. The three year statute of limitations for copyright infringement actions precludes the maintenance of a suit where the quality of evidence is likely to be deficient. The availability of witnesses, their fading memories, the likelihood that certain physical evidence may not have a sufficient foundation for admissibility, and the interests of judicial economy are all contributing factors justifying the presence of a statute of limitations.

Congress has expressly balanced the rights of a copyright owner in enforcing the constitutionally-limited monopoly and the interests of the public in preventing the annoyance and complications created by stale claims. Therefore, as discussed earlier, the three year federal statute of limitations preempts any state adverse possession cause of action for copyright.²⁰³

Aside from the preemption position, there is a paramount distinction which must be drawn between operation of the federal statute of limitations and the doctrine of adverse possession. A successful application of the adverse possession doctrine results in acquisition of actual title to the property in question.²⁰⁴ If the doctrine is applied to copyright law, it not only bars the original owner's right to sue for infringement, but it also vests title in the adverse possessor. Therefore, adverse possession involves more than a mere statute of limitations bar on litigation; it grants an exclusive federal right to a specific person or entity. This consequence differs from the operation of section 507.

Since section 507 bars a plaintiff from commencing an infringement suit over three years after the cause of action accrued, there would be no

201. See 2 C.J.S. *Adverse Possession* § 1 (1972). See, e.g., *Reiter v. Landon Homes, Inc.*, 287 N.Y.S.2d 724 (N.Y. Sup. Ct. 1968), *aff'd*, 295 N.Y.S.2d 103 (N.Y. App. Div. 1968).

202. 2 C.J.S. *Adverse Possession* § 2 (1972). See, e.g., *O'Hara v. Wallace*, 371 N.Y.S.2d 570 (N.Y. Sup. Ct. 1975), *modified on other grounds*, 382 N.Y.S.2d 350 (N.Y. App. Div. 1975).

203. See *supra* notes 176-84 and accompanying text.

204. See 2 C.J.S. *Adverse Possession* § 2 (1972).

federal right to a specific person or entity. This consequence differs from the operation of section 507.

Since section 507 bars a plaintiff from commencing an infringement suit over three years after the cause of action accrued, there would be no subsequent transfer of title to the defendant. In addition, copyright law would not allow the defendant to use the copyrighted materials after dismissal of such an action. If the defendant did commence activities evincing purported ownership (similar to infringement) after dismissal on statute of limitations grounds, a new cause of action for copyright infringement would accrue, and the plaintiff would be able to again bring suit to enforce his copyright.²⁰⁵

The policies underlying the limitation of actions are currently served within the copyright realm by existing law, namely section 507. Not only would the application of adverse possession to copyright be superfluous with regard to these policies, but it also transfers title to the adverse possessor. This ripening of inchoate title into actual title contravenes the very essence and purpose of copyright law, which grants a limited monopoly subject only to federal and constitutional limitations.²⁰⁶

B. The Economically Viable Utilization of Property Versus the Copyright Clause

The unique rationale for adverse possession as a doctrine of property law centers around societal preference for the maximum use of land and chattels. "[T]he specific goals of the adverse possession doctrine [are] to encourage commercial certainty and the resulting economic productivity in the utilization of various forms of property."²⁰⁷ Thus, the basic supposition is that society will ultimately benefit where property is optimized to its utmost capacity.

It is relatively easy to visualize this policy in action. For instance, where a tract of land is involved, the neighboring community would derive more utility from maintenance by a diligent owner, rather than an abandoned and useless plot. Of course, the nature of the use will differ depending upon the quality and characteristics of the tract itself and surrounding plots. For example, some land may be better suited for commercial high rise buildings or business districts; others may be better

205. See *supra* notes 176-84 and accompanying text.

206. See *infra* notes 223-25 and accompanying text.

207. GERSTENBLITH, *supra* note 2, at 120.

sued for parks, open terrain, residential dwellings or some other use. Assuming this extension of the doctrine is valid, the same rationale would apply to the adverse possession of personal property. Depending upon the characteristics of the chattel, rewarding its use by an adverse possessor might, in the long run, benefit society to a greater extent than if the original owner allowed the object to remain dormant and nonexistent for practical purposes.

There are two approaches one could adopt in exploring utilization policy: (1) a "merit" theory, and (2) a "demerit" theory. A view founded on merit awards the adverse possessor for making use of the land or chattels in question. A demerit approach would punish the original property owner for sleeping on her rights and allowing an adverse possessor to utilize the land or chattel without exercising a timely right of entry or institution of an action in the nature of replevin or conversion. Both views are a fair explanation for the policy underpinnings of the adverse possession doctrine. However, when the doctrine is applied to copyright, these policies conflict with the purposes of the Copyright Clause of the Constitution.

The Copyright Clause confers a legislative prerogative upon Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."²⁰⁸ This provision safeguards the author and benefits the public.²⁰⁹ Thus, economic, not moral reward for the author, is the established purpose of copyright.²¹⁰

The economic construction of the Copyright Clause was set forth by the United States Supreme Court in *Mazer v. Stein*.²¹¹

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." Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.²¹²

According to *Mazer*, the amount of time expended by the author in creating

208. U.S. CONST. art. I, § 8, cl. 8.

209. See NIMMER, *supra* note 83, § 1.03[A] at 1-31 to -32. "Thus the authorization to grant to individual authors the limited monopoly of copyright is predicated upon the dual premises that the public benefits from the creative activities of authors, and that the copyright monopoly is a necessary condition to the full realization of such creative activities." *Id.* at 1-32.

210. See *id.*

211. 347 U.S. 201 (1954).

212. *Id.* at 219.

a copyrightable work is rewarded by granting a limited monopoly as to the economic benefits which accrue during that period. The rationale of *Mazer* is that the potential benefit of economic award will give rise to an incentive for authors to create distinct and multiple works. This judicial construction, as well as the meaning of additional language within the Copyright Clause, underlies the concept and policies underlying the doctrine of adverse possession.

As explored earlier, the adverse possession of copyright doctrine goes far beyond being merely an affirmative defense akin to the statute of limitations. Instead, title is transferred; and in the context of copyright, all the exclusive rights of a copyright holder under section 106 are granted to the adverse possessor. However, the mere utilization of a copyright by any other person or entity than the original creator or owner destroys the incentive provided by the very existence of copyright law protection and the interpretation currently afforded the Copyright Clause.

Under the "merit" approach, the policy of rewarding the adverse possessor for economic, productive use of another's copyright is a direct affront to the purpose of copyright law. By transferring title to a non-author for the mere economic use of another's copyright, the law would create a countervailing incentive encouraging the maximum utilization of existing works, rather than promoting the creation of unique and multifarious works envisioned by the framers of the Constitution. Even under a "demerit approach rationale" for adverse possession, the policies of copyright would be fundamentally impaired and circumvented. Punishing a copyright holder for her failure to utilize and economically exhaust the work in the marketplace contradicts the nature of the rights provided under federal law.

The mirror image of the rights granted under section 106 is the right not to introduce a work to the public. In the publishing, music and entertainment business, timing is especially crucial to success. If a copyright owner deems it is in her best interest to halt the release of a book or record because of market strategy aimed at enhancing her financial return, or even to protect the author's reputation, it is her prerogative to do so.

The right to withhold one's work is consistent with the grant of a limited monopoly.²¹³ What is important for the purposes of *Mazer* is not

213. One may analogize this concept with the right of first publication granted under federal copyright law. "Ideas are free. But while the author confines them to his study, they are like birds in a cage, which none but he can have a right to let fly: for, till he thinks proper to emancipate them, they are under his own dominion." M. FRANCES McNAMARA, 2,000 FAMOUS

that the economic incentive actually encourages the author to make a copyrightable work, but that it is there if the author desires to be inspired by it. The potential a copyright's economic incentive will encourage the creativity of authors is the purpose behind that Copyright Clause. The purpose does not depend upon the creation of actual economic incentive.

The theory according to *Mazer* is that, in our society, monetary reward is currently the best way, but not the only way, to encourage progress of the arts. Regardless of whether the incentive is economic or for other reasons, the creation of new and original works is the goal. However, this goal is impeded by the adverse possession of copyright doctrine, because the confiscation and use of the works of others would be promoted. As a result, authors would lose the incentive to create, and, overall, our society would ultimately be devoid of or lacking in creativity.

A proponent of adverse possession might argue that the pecuniary underpinnings of the Copyright Clause and this ancient property doctrine are consistent. The Copyright Clause utilizes economics to confer an incentive upon authors to create works, and adverse possession rewards the party which maximizes the economic utility of the copyright if the original owner or author sleeps on her rights. Therefore, the premise of such a contention would center around the ultimate benefit society derives from the presence or availability of a work on the market.

Of course, the adverse possessor who places another's work on the market uses her own capital and expects to receive financial return from the sale and exploitation of this copyright. Pursuant to *Mazer*, the adverse possession advocate would couch her argument in terms of "advanc[ing] [the] public welfare."²¹⁴ Thus, the goal of copyright is to advance the public welfare, and this end would be achieved by awarding limited monopoly privileges to the person or entity that best markets the product. According to adverse possession proponents, effectuating the availability of a work to the general public for its enjoyment far outweighs the right of an author to conceal her work.

1. Authors

A supporter of the adverse possession of copyright doctrine would find it inevitable and inescapable that the economic incentive of the copyright clause is intended to benefit creators only, not those who merely utilize the

LEGAL QUOTATIONS 124 (1967) (citing *Millar v. Taylor*, 4 Burr. 2303, 2378 (1769) (Yates, J.)).

214. See *supra* note 129 and accompanying text.

another, the broad and expansive interpretation that the courts have undertaken²¹⁵ could not reasonably be extended to grant rights to an infringer.

Authorship currently tends to be defined in terms of originality.²¹⁶ "However, originality itself must exhibit a modicum of intellectual labor in order to constitute the product of an author."²¹⁷ Those favorable to adverse possession would claim that one's effort in utilizing or marketing another's work would be enough intellectual labor to establish authorship within the meaning of the broad constitutional interpretation afforded this term.

Although a "very minimal degree" of intellectual labor is adequate to qualify an individual as an author,²¹⁸ a position encouraging acts of infringement to establish authorship is tenuous. The entire aim of copyright is to prevent one from copying another's original product. By using another's work, nothing is added to its quality. The very notion of copyright would be vitiated if such an overbroad and expansive definition of "author" is adopted. As a result, every infringer under the Copyright Act could potentially qualify as an "author".

2. Derivative Works

A more complex question is presented where one utilizes another's work, but then builds upon or adds something of originality to it that would otherwise constitute a derivative work, absent infringement. Section 101 of the 1976 Copyright Act defines a "derivative work" as follows:

A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."²¹⁹

This detailed definition would encompass many different situations. For example, if the defendant in *Gee* took Bessie Smith's recording of "At the

215. See NIMMER, *supra* note 83, § 1.06[A] at 1-37 n.2.

216. See *id.* at 1-37.

217. *Id.* (emphasis omitted).

218. See *id.*

219. 17 U.S.C. § 101 (1977).

authorship, is a "derivative work."²¹⁹

This detailed definition would encompass many different situations. For example, if the defendant in *Gee* took Bessie Smith's recording of "At the Christmas Ball" and made material alterations in its structure by remixing the master tape and adding a synthesized keyboard track and background singers, it would qualify as a derivative sound recording under the above definition.

Nevertheless, original modifications to another's copyrighted work constitutes infringement. One of the exclusive rights conferred on a copyright owner under section 106 is the authority "to prepare derivative works based upon the copyrighted work."²²⁰ Therefore, the argument that adverse possession should be allowed with regard to derivative works—because the adverse possessor is an author in the sense that modifications made to the original work are original in nature—is expressly disposed of by this federal statute. Any original modification or addition to the underlying copyrighted work constitutes copyright infringement.

Moreover, even if section 106 did not exist, the mandate of the Copyright Clause, as construed by the courts, would probably not permit an adverse possessor's derivative work to be considered a "writing" within the meaning of this constitutional provision. Although the terms "writings" has been liberally interpreted overall, there are essentially two minimum standards which a work must meet in order to qualify: (1) it must contain "a modicum of intellectual labor;" and (2) "it must be embodied in some tangible form."²²¹

According to the aforementioned constitutional requirements, an adversely possessed derivative work might be considered a "writing" because it certainly must be in some tangible form to be adversely-possessed. Hence, a slight contribution of intellectual labor would probably be involved in any derivative type of work. However, the next step in the analysis concerns whether the rights of a copyright owner (who has either expended a great amount of intellectual labor in the work or who has paid adequate consideration for title to same) should be impaired by minor alterations or additions made by an adverse possessor.

To allow minor creative modifications to qualify a work as a "writing" under judicial construction of the Copyright Clause would frustrate the express and manifest purpose of this provision to "promote the Progress of

219. 17 U.S.C. § 101 (1977).

220. 17 U.S.C. § 106(2) (1977).

221. NEMMER, *supra* note 83, §§ 1.08[C][1]-1.08[C][2] at 1-47 to -49.

Science and useful Arts."²²² The incentive for authors to create new works would be dissipated, and instead, individuals would find it easier and more advantageous to alter preexisting works and adversely possess the original in the process. Therefore, where adverse possession is accomplished through the creation of a stealthily derivative work, the plain meaning and overriding policy of the Copyright Clause dictates that this expressly intended constitutional purpose, to promote the progress of Science and useful Arts, be given precedence over any subsequent inconsistent judicial constructions of the Copyright Clause.

3. Limited Monopoly and Property Rights

Adverse possession advocates must also realize that, by contending the general public's benefit from effective utilization of a copyright outweighs the author's rights, they arrive at the direct conflict this traditional property law doctrine has with the "for limited times"²²³ language of the Copyright Clause. The constitutional mandate is that the monopoly and title to the author's copyrighted work be "for limited times."²²⁴ According to the late Professor Melville Nimmer, "[t]his phrase creates a very real limitation upon Congressional power. A federal copyright statute which purported to grant copyright protection in perpetuity would clearly be unconstitutional."²²⁵ Hence, the doctrine of adverse possession which confers fee simple absolute title to real property would be unconstitutional if applied to copyright law.

The indefinite nature of the enjoyment of personal property, and of real property subject only to the rigors of the rule against perpetuities, has no place in copyright law due to the "for limited times" provision in Article I of the Constitution. Even if Congress desired to include the doctrine of adverse possession in the Copyright Act, it could not. The effect of doing so could impede the work's entry into the public domain for a prolonged

222. U.S. CONST. art 1, § 8, cl. 8.

223. *Id.*

224. *Id.*

225. NIMMER, *supra* note 83, § 1.05[A][1] at 1-36.2. "The 'limited times' provision does not limit the perpetual protection available to works under the state law doctrine of common law copyright, provided such state law has not been the subject of federal preemption. However, perpetual protection for such works may be invalid by reason of First Amendment limitations." *Id.* § 1.05[C] at 1-36.6 (footnotes omitted). Hence, for free speech purposes, the doctrine of adverse possession, if applied to ideas and facts, is likely to be invalid because the indefinite title which would vest could unduly restrict society's constitutional right of access to useful information.

period of time, thus frustrating the underlying purpose of the limited monopoly language. For example, if a person adversely possessed a copyright before the end of the original author's life plus fifty years, the copyright belongs to the adverse possessor for her lifetime plus another fifty years, assuming that the end of the original author's monopoly does not thrust the work into the public domain.²²⁶ In this case, the work could be denied to a vast array of potential authors who wish to capitalize upon and create new works using portions of the original work.

4. *Droit Moral*

In response to the position that adverse possession and copyright law are both based on the theory of public benefit derived from the economic utilization of works, one must remember that the law does not only protect those interests intended by the drafters. The law may also serve other unforeseen or unrecognized purposes. Even though the Copyright Clause and its judicial construction in *Mazer* suggest that economic incentive is the primary purpose of copyright, there are other factors which motivate an author to create works, such as moral rights, fame, prestige and other amorphous non-monetary rewards which may accrue to a successful author or composer.

The concept of "*droit moral*" is defined as a "[n]on-pecuniary right based upon the dual relationship between society and its artists, and the artist and his work."²²⁷ Although moral rights are not explicitly recognized in American copyright law,²²⁸ they can be seen as inextricably

226. However, a differing interpretation derived from the traditional rules of adverse possession might grant title to the adverse possessor only for the remainder of the original copyright owner's monopoly. For example, analogous to the real property realm: if A adversely possesses B's Blackacre (B possessing a life estate, remainder to C), while B is in possession, A would only be entitled to B's life estate. If applied to copyright law, the life estate would be equivalent to the federal statutory monopoly period (lifetime plus forty-nine years), and the public could be the remaindermen because under the Copyright Act, after the monopoly period, the work is available to the public for copying (public domain). Hence, under this approach, the adverse possessor would only be entitled to use for life plus forty-nine years.

227. BLACK'S LAW DICTIONARY 497 (6th ed. 1990).

228. Circuit Judge Frank's discourse on the essence of an artist's moral rights to her work reveals yet another justification for the refusal of American Courts to recognize its validity:

(a) "Moral right" seems to indicate to some persons something not legal, something meta-legal. (b) The "moral right" doctrine, as applied in some countries, includes very extensive rights which courts in some American jurisdictions are not yet prepared to acknowledge; as a result, the phrase "moral right" seems to have frightened some of those courts to such an extent that they have unduly narrowed

intertwined with the economic rights that are afforded protection.

Often, fame and self-realization accrue to an author where her work has become economically successful. The effect created by public benefit from a particular work upon the ego and attitude of its author cannot be overlooked. To theoretically separate economic from moral incentive, and to allow the law to protect only the former, is unrealistic. Therefore, even though the concept of "*droit moral*" is a predominantly European precept²²⁹ not explicitly accepted by American legal theory, it still is found in the structure of copyright law due to *droit moral*'s effect upon an author's creative incentive.

Assuming *arguendo* that an artist's moral rights are not tacitly protected by American copyright law, they should be safeguarded and recognized. While one cannot ignore the significance of the economic incentive referred to in *Mazer*, neither the language of *Mazer* nor the Copyright Clause expressly limit other incentives.²³⁰

Any law that is rationally related to furthering the general goal of the Copyright Clause, namely the provision of a limited monopoly to provide a creative incentive to authors, should be upheld.²³¹ Hence, Congress has broad discretion to decide what means it should employ to achieve this goal. The economic considerations addressed in *Mazer* are merely one of the ways of sparking the fire of creativity. There is room for including moral rights within the protectable sphere of copyright law because they promote the general purpose of the Copyright Clause.

After accepting the proposal that "*droit moral*" should be an explicitly recognized precept in American copyright law, destruction of the adverse

artists' rights.

Granz v. Harris, 198 F.2d 585, 590 (2d Cir. 1952) (Frank, J., concurring) (footnotes omitted). However, as Judge Frank's comments illustrate, this judicial reluctance and apprehension to accept the concept of "*droit moral*" and the importance attributed to the legal protection of economic rights is to be expected from a capitalist oriented nation such as the United States, where, in the minds of government officials, the almighty dollar is the only incentive that could inspire an author to create.

229. See *id.* at 590.

230. "[T]he phrase 'To promote the progress of science and useful arts . . .' must be read . . . in the nature of a preamble, indicating the purpose of the power but not in limitation of its exercise." NIMMER, *supra* note 83, § 1.03[A] at 1-34 (footnotes omitted).

231. The rational relationship standard would apply as long as the extent of the remedy (i.e., monetary damages for damage to an author's reputation as a result of copyright infringement) creates the incentive. However, where the extent of protection is enlarged (i.e., to label as infringement an entirely original work which mentions another artist's name in the lyrics and damages their reputation), the First Amendment would be implicated and the constitutional strict scrutiny standard might apply.

possession of copyright argument based on economic incentive is inevitable. While adverse possession supporters may quarrel with the premise of moral rights as a legitimate end, it is indisputable that the ultimate goal of the Copyright Clause is certainly not to allow one to accrue capital from another's stagnant copyrighted work if not in the public domain. The only support the adverse possession of copyright theory could acquire on policy grounds would be that both this doctrine and the Copyright Clause protect economic interests. However, if moral rights either inhere within the structure of these economic interests, or are accepted within the realm of copyright, this would weaken the force of the adverse possession argument.

The type of moral satisfaction, if any, that an adverse possessor would achieve by utilizing another's original work is clearly not contemplated by the traditional concept of *droit moral*. The special relationship created between an artist and society is not likely to manifest itself in an adverse possession context because it would be difficult for the public to acclaim one who did not create the work. Where art and music are involved, the natural human tendency is to recognize one for his or her artistic labor and skills.

It may be a different situation where a segment of society respects an adverse copyright possessor for his marketing and business skills in the utilization of that copyright. But, praise for keen business acumen has no place in the concept of *droit moral* or copyright, because it does not promote the creation of new works, only increased infringement. Further, an adverse possessor cannot claim *droit moral*, because he did not create the work. However, it could be argued that the adverse possessor forms a strong attachment to the copyright as a result of the intense use, marketing and sale of the work.

This type of moral, or possibly immoral, relationship between an adverse possessor and another's work is not within the scope of *droit moral*. The recognition of moral right entails the encouragement of incentive through close affiliation with and respect for the artist's labor and skill, which is reflected in the work product. Of course, the adverse possessor lacks this artistic self-worth.

Many jurists that adhere to the natural law origins of property ownership and rights would support the notion of *droit moral* and would probably reject the adverse possession of copyright doctrine as inconsistent with that fundamental precept. The logic of the natural law argument is that

the origin of property [is found in] preoccupation Pre-occupation is first possession; and this is given by creation, by production. The creator is the first possessor of that which he

creates. In labor, then, is found the origin of the right to property. Occupancy implies labor It matters not whether the labor be of the body or of the mind

Intellectual labor . . . [although] [i]ncorporeal itself, . . . is generally attached to the corporeal.²³²

This theory is a hybrid formulation of the first occupancy concept which surfaces in the writings of Hugo Grotius, Samuel Pufendorf and Sir William Blackstone (which examine legal theory back to Roman Law), and the labor-reward philosophy of John Locke.²³³

Modern property law philosophy is based primarily upon David Hume's and Jeremy Bentham's theory of utilitarianism.²³⁴ The application of a balancing test ultimately favoring a law which "promotes happiness"²³⁵ to benefit society is the essence of utilitarianism.²³⁶ This view that "property denotes a bundle of rights, a set of relations among people with respect to things"²³⁷ could permit the restriction of one's property rights if increased happiness to society would result.

Utilitarianism provides the foundation through which modern American copyright law may promote only economic interests, because, presumably, more individuals in this particular society would benefit from the monetary approach than from protecting the moral rights of authors.²³⁸ Yet, to the extent that economic and moral incentives do not conflict, society would ultimately reap the benefit and enjoyment of abundant works if a dual moral/economic incentive were to inspire the authors and composers of today. Moreover, the principles of natural justice that form the basis for *droit moral*, as previously described, were incorporated into the first copyright statute—England's Statute of Anne.²³⁹ After the American

232. EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 2-6 (1972). "The principle is as old as property itself, that what a man [or woman] creates by his [or her] own labor, out of his [or her] own materials, is his [or hers] to enjoy to the exclusion of all others. It is based not only on natural right, but also on the necessities of society, being essential to the promotion of industry." *Id.* at 4.

233. See DUKEMINIER, *supra* note 29, at 132-36.

234. See *id.* at 137-38.

235. See *id.* at 137.

236. See *id.*

237. *Id.* at 138.

238. See *supra* note 229.

239. See PATRY, *supra* note 109, at 2-4. "Our law relating to literary and artistic property is essentially an inheritance from England. It seems that from the time 'whereof the memory of man runneth not to the contrary,' the author's right to his or her manuscript was recognized on principles of natural justice, being the product of intellectual labor and as much the author's own

Revolution, "all of the colonies except Delaware passed laws to afford protection to authors."²⁴⁰ These laws were based primarily upon the Statute of Anne.²⁴¹ Although these state statutes were later superseded by national legislation resulting from adoption of the Copyright Clause,²⁴² it is reasonable to speculate that the framers may have intended to emulate the English system in this regard, including the concept of *droit moral* or natural rights recognized in Britain.

One may counter this position by referring to the intense disdain for Britain that existed in the Colonies prior to and following the Revolutionary War. However, the disfavored monarchical structure of England does not necessarily lead to the conclusion that every aspect of English law was evil. Hence, in light of the absence of debate and discussion surrounding the adoption of the Copyright Clause, this possibility remains open.

The courts should reconsider the policies underlying American copyright law so that *droit moral* can find its place within its structure. If this is accomplished, one could never rationally consider the doctrine of adverse possession as applying to copyrighted works. Doing so would defeat the entire purpose of moral rights arising from the creation of a work; rights which an adverse possessor does not possess. "[W]here the science of law has attained its highest state, there is no purer, stronger, better title to property than that acquired by production. To him [or her] belongs the harvest whose toil has produced it; to him [or her], the fruit who has planted the tree."²⁴³

5. The Essence of Constitutional Authority

An additional reason why the state doctrine of adverse possession has absolutely no place within copyright law is the nature of the authority from which such rights originate. First, adverse possession is enacted pursuant to the state police power designed to protect the general health, welfare and morals of its citizens.²⁴⁴ Although some scholars may argue that the police power is a logical implication to draw from the Tenth Amendment

property as the substance on which it was written." *Id.* at 2.

240. *Id.* at 5.

241. *See id.* at 4.

242. *See id.*

243. DRONE, *supra* note 230, at 4.

244. *See supra* note 129 and accompanying text.

of the Constitution,²⁴⁵ there is otherwise no express constitutional provision designating the existence of this power. Of course, the Federalist Papers indicate that the inherent residual powers of each sovereign state were a natural and accepted implication of the institution of a federal government.²⁴⁶

Second, Congress' authority to enact federal copyright law is expressly provided for in the Constitution.²⁴⁷ The mere fact that the framers deemed it necessary to specifically refer to the copyright power, and not to mention the police power in this much cherished and vital document, is an indication of the priority that should be afforded each respective right.

Reconciling the doctrine of adverse possession with copyright necessarily involves a clash between the police power and the Copyright Clause. Since copyright involves an express constitutional mandate and adverse possession does not, the policies underlying the former, to the extent that they conflict with the policies of the latter, should prevail.

Copyright protection encourages the very existence and proliferation of artistic works, and is a higher constitutional value in all respects. Hence, the inferior and tenuous adverse possession policies found within the sphere of a power not expressly defined anywhere in the Constitution, should be disregarded in its entirety and severed from any aspect of copyright law.

VII. CONCLUSION

The adverse possession of copyright doctrine is blemished from several viewpoints. Not only does existing federal copyright law require its rejection, but it is theoretically and practically defective. Although this traditional real property doctrine was tenuously extended to personal property, the adverse possession of an intangible copyright is preposterous.

The *Gee* decision is an unworkable aberration. Its continuing precedential value undercuts copyright concepts and could turn an ordinary lawsuit into a legal and factual quagmire. Not only does *Gee's* unfounded extension of the adverse possession doctrine vitiate the purposes and policies of copyright law, but the reasoning employed to arrive at its holding is fallacious and confused.

245. "The powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people." U.S. CONST. amend. X.

246. See 16A C.J.S. *Constitutional Law* § 432 at 390 ("[T]he term [police power] is . . . used to denote those inherent governmental powers which, under the federal system established by the Constitution of the United States, are reserved to the several states.").

247. See *supra* note 130.

Gee is corrupt precedent and should be promptly overruled, if a court of appropriate jurisdiction has the opportunity to do so. As long as this decision remains intact, defendants in copyright infringement actions will continue to possess a trump card, enabling them to harass courts with the complex issues discussed in this Article.

If a court is again presented with a cause of action or defense pleaded as adverse possession of copyright, it should not hesitate to reject it outright and dismiss the claim. If the *Gee* quandary cannot be remedied by common law action through the judicial system, Congress should take the initiative immediately. Adverse possession of copyright is currently invalid due to the existence of a federal preemption statute,²⁴⁸ and under every permissible construction and application of this enactment.²⁴⁹ Nevertheless, it is within Congressional authority under the Copyright and Supremacy Clauses to explicitly declare this diseased doctrine unconstitutional and set the record straight. In sum, the purported adverse possession of copyright doctrine is a pseudo-intellectual nuisance that must be abated and destroyed.

248. See 17 U.S.C. § 507 (1977).

249. See *supra* notes 129-200 and accompanying text.