

THE FOLKLORE OF COPYRIGHT PROCEDURE

*Shani Shisha**

ABSTRACT

Ours is an era of instant authorship. Authors today need not take any affirmative steps to claim copyright protection. Instead, copyright attaches to an original work of authorship the moment it is fixed in some tangible form. But this system of unconditional propertization bears little resemblance to copyright's original statutory scheme. Historically, copyright protection was conditioned on compliance with certain procedural formalities, such as registration, deposit, and notice. Early courts, in turn, demanded scrupulous compliance with these formalities; even minor departures from the requisite procedure led to copyright forfeiture. This familiar story of draconian formalities and unforgiving courts is a longstanding staple of the copyright canon.

It is also critically incomplete. Drawing on an exhaustive analysis of nineteenth-century caselaw, this Article uncovers copyright's long-lost history of procedural pragmatism — a decidedly flexible approach to copyright formalities. This strain of pragmatism dawned at a time when authors struggled to keep up with copyright's procedural framework: While publishers usually took steps to comply with copyright formalities, many authors failed to do so. And courts, in their zeal to prevent forfeiture, crafted a number of legal fictions to wrest copyrights out of the hands of noncompliant authors. When an author failed to clear formalities, these courts found that someone else — typically, a publisher — was the formal copyright proprietor. That was the only way, courts intuited, to prevent forfeiture at the hands of a noncompliant author. Based on these findings, this Article excavates copyright's forgotten history of procedural flexibility, explores its origins, and considers its implications for modern doctrine.

* Graduate Program Fellow, Harvard Law School; Fellow, Berkman Klein Center for Internet & Society, Harvard Law School, 2020–21. An earlier version of this Article was awarded the 2022 Irving Oberman Memorial Writing Prize in Intellectual Property at Harvard Law School. For invaluable comments and conversations, I thank Robert Brauneis, William W. Fisher, John Goldberg, William McCoy, Gali Racabi, Dan Rohde, Guy Rubinstein, Shelly Simana, Henry E. Smith, Oren Tamir, Rebecca Tushnet, and attendees at the 2021 Intellectual Property Scholars Conference at Cardozo Law School, especially BJ Ard, Michal Shur-Ofry, and Zvi S. Rosen. I am also thankful to the editors of the *Harvard Journal of Law & Technology* for their outstanding work in preparing this Article for publication, and to the Harvard Law School Graduate Program for generous financial support.

TABLE OF CONTENTS

I. INTRODUCTION.....	62
II. A BRIEF HISTORY OF COPYRIGHT FORMALITIES	68
III. NINETEENTH-CENTURY JURISPRUDENCE	74
<i>A. Equity</i>	74
<i>B. Common-Law Copyright</i>	78
IV. PRAGMATISM IN ACTION.....	79
<i>A. Copyright Assignment</i>	80
<i>B. Equitable Ownership</i>	92
V. LESSONS	100
<i>A. Normative Assessment</i>	101
<i>B. Doctrinal Drift</i>	109
<i>C. Implied License</i>	114
VI. PRAGMATISM REIMAGINED: MODERN ECHOES.....	117
VII. CONCLUSION.....	124

I. INTRODUCTION

Copyright law pervades our cultural universe. Everything “from the crayon sketch of a fourth grader to the novelist’s draft manuscript” is subject to copyright protection.¹ Every post, video, or photograph shared on social media is potentially copyrightable.² So too are text messages, emails, and memes.³ And it is easy enough to understand why copyright law has come to dominate vast swaths of everyday life. Copyright attaches to an original work of authorship the moment it is fixed in some tangible form.⁴ Authors need not take any affirmative steps to claim copyright protection; original works are protected by default.⁵ Modern copyright law is thus a system of unconditional

1. Adrienne K. Goss, *Codifying a Commons: Copyright, Copyleft, and the Creative Commons Project*, 82 CHI.-KENT L. REV. 963, 969 (2007).

2. See Dotan Oliar, Nathaniel Pattison & K. Ross Powell, *Copyright Registrations: Who, What, When, Where, and Why*, 92 TEX. L. REV. 2211, 2241 (2014) (“Every day, millions of emails, tweets, and messages are sent; blog posts and online articles are posted; still photos and videos are taken with cameras and cellphones; the vast majority of all of these are likely copyright protected.”).

3. See *id.* Because copyright protection requires only a “modicum of creativity,” copyright interests can readily attach to just about any work of authorship. See *Feist Publ’ns. Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (noting that copyright’s creativity threshold is “extremely low; even a slight amount will suffice”).

4. 17 U.S.C. § 102 (“Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . .”).

5. Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485, 494 (2004) (“[O]ur current *unconditional* copyright regime grants copyright protection to all ‘fixed’

protection — one in which copyright vests automatically.⁶ It is now harder to relinquish rights than to claim them. As one commentator put it, our current regime extends “no opportunity to decline copyright’s kind invitation.”⁷

Yet this robust vision of copyright law is far removed from copyright’s original statutory regime. The first federal copyright statute in the United States covered only a limited subset of creative works: maps, charts, and books.⁸ And, crucially, copyright protection was initially conditioned on compliance with a host of procedural formalities.⁹ Copyright did not attach automatically. Rather, putative owners were required to register their rights, deposit copies of the work, renew their rights after a brief initial term, and affix a copyright notice to each published copy of the work.¹⁰

These formalities erected a formidable barrier to copyright protection. Modern scholars agree that early courts were intolerant of procedural deficiencies.¹¹ Failure to comply with formalities typically led to copyright forfeiture.¹² In many instances, even minor deviations from the required procedure proved fatal — say, when courts refused to accept certain departures from the statutory notice template as valid.¹³ And, sometimes, judges insisted that authors had failed to satisfy copyright formalities despite clear evidence to the contrary.¹⁴ The conventional wisdom, in short, is that courts staked out a rigid view of copyright’s procedural scheme.

But the dominant narrative of strict formalities and unforgiving courts is incomplete. Drawing on a comprehensive cache of nineteenth- and twentieth-century caselaw, this Article offers a corrective to the traditional story. It shows that, in a long line of cases, courts crafted elaborate legal fictions to get around procedural hurdles. When an author failed to clear the requisite formalities, these courts found that

creative works, whether or not the author or his assigns takes any affirmative steps to claim copyright protection.”); JESSICA LITMAN, *DIGITAL COPYRIGHT* 17 (2001) (noting that copyright “vests automatically” upon fixation of an original work in tangible form); Richard A. Epstein, *The Dubious Constitutionality of the Copyright Term Extension Act*, 36 *LOY. L.A. L. REV.* 123, 124 (2002) (observing that “[b]y degrees, the copyright law has flipped over from a system that protected only rights that were claimed to one that vests all rights, whether claimed or not”).

6. Sprigman, *supra* note 5, at 494–99.

7. James Gibson, *Once and Future Copyright*, 81 *NOTRE DAME L. REV.* 167, 169 (2005); see also Dave Fagundes & Aaron Perzanowski, *Abandoning Copyright*, 62 *WM. & MARY L. REV.* 487, 490 (2020) (“In practice, though, it remains far from clear how an author can actually relinquish rights in a work.”).

8. Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124, 124 (amended 1831) [hereinafter 1790 Act].

9. See *infra* Part II.

10. See *infra* Part II.

11. See *infra* text accompanying notes 83–90.

12. See *infra* text accompanying notes 83–90.

13. See *infra* text accompanying notes 83–90.

14. See *infra* text accompanying note 88 (discussing *Merrell v. Tice*, 104 U.S. 557 (1882)).

someone else — typically, a publisher — was the formal copyright proprietor. Sometimes courts held that a noncompliant author had implicitly assigned her copyright to the publisher.¹⁵ On other occasions, courts conjured up an image of equitable ownership. They did so by holding that the publisher was the formal copyright proprietor while the author retained an equitable interest in the work.¹⁶ This was, in essence, a system of constructive trust: The publisher, being the formal owner, was a trustee acting on behalf of the author.

For much of the nineteenth century, courts relied on these devices — doctrines of implicit assignment and principles of constructive trust — to wrest copyrights out of the hands of noncompliant authors.¹⁷ And, remarkably, courts were prepared to do so even when there wasn't so much as a whiff of evidence to support these outcomes.¹⁸ Publishers and authors rarely contemplated, much less formalized, an equitable trust scheme. Likewise, an inference of implicit assignment often found little support in the facts of nineteenth-century cases. Worse still, in holding that a noncompliant author had *implicitly* assigned her rights, some cases ran headlong into the federal copyright statute, which appeared to preclude unwritten assignments.¹⁹

On the strength of these findings, this Article develops a historical account that is more subtle than the dominant narrative of unwieldy formalities and inflexible courts. It finds that, in practice, some courts enlisted doctrines of copyright assignment and equitable ownership to buck facially draconian formalities. And this account of judicial pragmatism maps rather elegantly onto the long arc of copyright history and American jurisprudence.²⁰ Early courts often operated within a parallel system of equity — a system that afforded judges significant discretion to depart from legal rules in cases where such rules led to unjust results.²¹ Perhaps unsurprisingly, some courts turned to principles of equity to cabin the effects of copyright's byzantine scheme of technical formalities.²² The history of equitable jurisprudence therefore suggests that copyright's seemingly exceptional threads of procedural pragmatism were fairly routine within the context of equity.

Of course, none of this is to say that courts of the nineteenth century were predominantly (or consistently) lenient in their approach to procedural failures. Far from it. Certainly, there is some truth to the traditional story of judicial rigidity in the face of procedural noncompliance. But there's also a great deal more nuance to that story. As this Article

15. See *infra* text accompanying note 197.

16. See *infra* Section IV.B.

17. See *infra* Part IV.

18. See *infra* Section V.C.

19. See *infra* text accompanying notes 146–67.

20. See *infra* Part III.

21. See *infra* Section III.A.

22. See *infra* Section IV.B.

demonstrates, in a subset of early cases, judges were willing to gloss over procedural defects when doing so allowed them to redeem some measure of copyright protection.

After discussing this history of robust pragmatism, I examine its broader significance.²³ First, I explore a number of interrelated factors that might explain why early courts attempted to avoid procedural forfeiture.²⁴ I argue that, in refusing to invalidate copyrights on procedural grounds, courts recognized the need for strong copyright protection at a time when authors faced two considerable obstacles: a relatively weak copyright regime and a prohibitively expensive system for distributing works. In these circumstances, an aggressively pragmatic approach — one that sought to guard against procedural forfeiture — seemed quite sensible.

Second, I show that the implicit assignment doctrine, engineered at first to curtail rigid formalities, eventually drifted away from its normative foundations.²⁵ Courts ultimately came to view every sale of a copy — even when procedural compliance was not at issue — as a default assignment of the underlying copyright. But that default rule was divorced from the principal instincts that initially drove assignment cases. At first, courts upheld implicit assignments only when doing so allowed the parties to avert forfeiture. However, under the new default rule, courts increasingly lost sight of that impulse and instead began to find that authors had parted with their copyrights even when procedural issues were not at play. The doctrine worked itself impure.

More broadly, these cases suggest that nineteenth-century courts had not yet fully recognized the now-axiomatic distinction between the physical copy and the intellectual work. It is a cornerstone principle of modern copyright law that the intangible work is distinct from the physical object in which it is embodied.²⁶ So, under current doctrine, a transfer of a physical copy need not — and, typically, should not — imply an assignment of the underlying copyright.²⁷ But, as it turns out, some early cases did not fully embrace that distinction.²⁸ The result was an overly permissive assignment doctrine.

Third, this Article offers a theory that better illuminates the rhetoric behind early cases. As a technical matter, copyright's long tradition of procedural pragmatism manifested in cases dealing with the transfer of title. This body of caselaw thus traded in the language of ownership.

23. See *infra* Part V.

24. See *infra* Section V.A.

25. See *infra* Section V.B.

26. See 17 U.S.C. § 202 (“Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied. Transfer of ownership of any material object . . . does not of itself convey any rights in the copyrighted work embodied in the object . . .”).

27. See *infra* text accompanying notes 388–94.

28. See *infra* text accompanying notes 383–87.

But getting at the analytical core of these cases takes some doing. This Article contends that although courts trafficked in the language of ownership, their decisions are best understood as reflecting an implied license framework — an inference that the author had implicitly permitted the publisher to use the copyrighted work.²⁹ When courts spoke of an assignment, they were actually hinting at an implied license. There was often little evidence, if any, that the author had intended to dispose of her ownership interest. There was, however, ample evidence to suggest the author had implicitly granted the publisher a license to release the work. Given the rhetoric and facts driving many of these cases, an implied license framework can better explain why they came out the way they did.

This, in turn, prompts a related question: If these cases are best understood as licensing disputes, why didn't courts just say so? Why bother instead with a convoluted analysis that undercuts the factual record? The answer, again, is that courts were determined to prevent copyright forfeiture. Because many authors failed to comply with formalities, courts *had* to find that someone else was, in fact, the copyright owner. Put simply, they felt like they had to speak in the register of *ownership*.

Finally, this Article not only attempts to breathe new life into a rather comatose debate about the role of procedure in copyright law, it also surfaces a new approach to resolving modern disputes.³⁰ It argues that, just as courts of the nineteenth century pursued policy objectives and employed legal fictions to settle complex disputes, so too should modern courts look for ways to meet current challenges by reorienting copyright doctrine. One way to do so, I suggest, is to introduce a more pragmatic analysis of policy objectives and community norms into the implied license doctrine. That approach is not only normatively attractive but also consistent with the history of copyright law.

To be sure, judicial interventions of this sort involve risks. As this Article illustrates, even a well-intentioned doctrine can eventually outgrow its original purpose by way of doctrinal drift. Still, judicial intervention is both inevitable and desirable. Federal copyright law governs a glut of new and emerging technologies,³¹ rests on a raft of open-

29. See *infra* Section V.C.

30. See *infra* Part VI.

31. See Robert P. Merges, *One Hundred Years of Solitude: Intellectual Property Law, 1900–2000*, 88 CALIF. L. REV. 2187, 2190 (2000) (arguing that each successive conflict between copyright and new waves of technology tends to produce (1) an initial period of instability and uncertainty, followed by (2) a period of judicial adaptation through case-by-case adjudication and, eventually, (3) legislative codification of earlier doctrinal modifications). See generally Ben Depoorter, *Technology and Uncertainty: The Shaping Effect on Copyright Law*, 157 U. PA. L. REV. 1831 (2009).

textured standards,³² and is incredibly complex.³³ The upshot is that courts will always play a central role in the copyright ecosystem.³⁴ Judicial action is inevitable. The question is not *whether* courts should adapt copyright doctrine but *how*. And the critical lesson here is that, in adapting existing doctrines, courts should pay careful attention not only to naked principles of law but also to the original rationales that inspired doctrinal intervention in the first place.

The balance of this Article proceeds in five parts. Part II offers a brisk tour of the history of copyright formalities. It provides an overview of copyright's procedural framework and briefly examines the scholarly debate around copyright formalities. Part III catalogs broader trends in early copyright jurisprudence. It explains that nineteenth-century courts often looked to equity — a flexible, results-oriented framework that empowered judges to stray from standard legal rules in specific cases. It then discusses the emergence of common-law copyright: a regime of state-law copyrights designed to protect unpublished works.

Part IV turns to the heart of the Article: an examination of copyright's procedural pragmatism. It delivers a synopsis of two related lines of early jurisprudence. One involved cases of copyright assignment, and the other arose from cases dealing with equitable ownership. By synthesizing the relevant cases and exploring how they interacted, this Part puts the pieces of the pragmatism puzzle together.

Part V offers a normative analysis of these trends. After evaluating copyright's original assignment doctrine and its progeny — the ill-conceived default assignment rule — this Part argues that principles of implied licensing, not ownership, can better explain real-world case outcomes.

Part VI applies these insights to modern copyright law. It does so by focusing on one area of bitter controversy: disputes over ownership of paparazzi photos. It demonstrates that a robust implied license doctrine, inspired by copyright's long history of procedural pragmatism, might guide courts in resolving these disputes. A brief conclusion follows.

32. See, e.g., 17 U.S.C. § 101 (defining "copies" as objects in which the work is fixed "by any method now known or later developed"); *id.* § 107 (defining "fair use" by reference to four statutory factors that courts must weigh on a case-by-case basis).

33. Ann Bartow, *A Restatement of Copyright Law as More Independent and Stable Treatise*, 79 BROOK. L. REV. 457, 457 (2014) ("Copyrights are really complicated."); Jessica Litman, *Real Copyright Reform*, 96 IOWA L. REV. 1, 3 (2010) ("The copyright statute is old, outmoded, inflexible, and beginning to display the symptoms of multiple systems failure.")

34. Of course, pragmatic judges have always exerted a significant degree of influence over the trajectory of copyright law. See Peter S. Menell, *The Mixed Heritage of Federal Intellectual Property Law and Ramifications for Statutory Interpretation*, in INTELLECTUAL PROPERTY AND THE COMMON LAW 63, 67 (Shyamkrishna Balganeshe ed., 2013); Shyamkrishna Balganeshe, *The Pragmatic Incrementalism of Common Law Intellectual Property*, 63 VAND. L. REV. 1543, 1545 (2010).

II. A BRIEF HISTORY OF COPYRIGHT FORMALITIES

The first federal copyright statute, the Copyright Act of 1790, introduced a system of conditional copyright protection.³⁵ Authors were required to comply with a host of procedural conditions — colloquially known as “copyright formalities” — to claim rights in their works.³⁶

First, the 1790 Act conditioned copyright protection on registration of the work with the clerk’s office at the local district court.³⁷ Second, the Act required that the author deposit a copy of the work with the clerk’s office.³⁸ Third, the author had to deposit an additional copy with the Secretary of State within six months of publication.³⁹ Fourth, the author was required to give notice of their copyrights.⁴⁰ The notice requirement was twofold. Initially, the 1790 Act required an author to publish proof of registration in a newspaper.⁴¹ Twelve years later, the original statute was amended to prescribe that an additional copyright notice be appended to each copy of the work.⁴² The author was thus required to “give information” about the copyright by marking each copy with a notice bearing the same proof of registration published in the newspaper.⁴³ The statute further specified that the copyright notice should be affixed to the work’s title page or the page immediately following it.⁴⁴ The prescribed notice had to include information about the author’s identity, her state of residence, and the day on which the work was deposited.⁴⁵ Fifth, copyright protection initially lapsed after a relatively short term of fourteen years but was renewable for an additional fourteen-year term.⁴⁶ To renew the copyright, the author was required to register the work anew and publish proof of registration in a newspaper.⁴⁷ Such steps had to be taken within the last six months of the initial fourteen-year term.⁴⁸

These formalities combined to establish a strict bar to copyright protection. When an author failed to register the work, deposit copies, append a notice to published copies, or give public notice in a newspaper, she would forfeit her copyright.⁴⁹ And failure to renew the

35. 1790 Act, *supra* note 8, §§ 1, 3–4.

36. *Id.*; *see also* Sprigman, *supra* note 5, at 487.

37. 1790 Act, *supra* note 8, § 3.

38. *Id.*

39. *Id.* § 4.

40. *Id.* § 3.

41. *Id.*

42. Act of Apr. 29, 1802, ch. 36, 2 Stat. 171.

43. *Id.* § 1.

44. *Id.*

45. *Id.*

46. 1790 Act, *supra* note 8, § 1.

47. *Id.*

48. *Id.*

49. *See* Sprigman, *supra* note 5, at 492–93.

copyright meant that the work would fall into the public domain after the initial fourteen-year term expired.⁵⁰

Subsequent amendments put into effect a number of notable changes. The 1831 Act extended the copyright term from fourteen to twenty-eight years⁵¹ while retaining the requirements of registration, deposit, notice, and renewal.⁵² A supplementary amendment in 1834 codified an additional requirement that authors record “deeds or instruments in writing” for the transfer or assignment of copyrights.⁵³ And the 1909 Act kept up with its statutory antecedents in preserving the registration, notice, and renewal formalities,⁵⁴ subject to several significant changes. One such change involved the renewal term, which was extended to twenty-eight years.⁵⁵ The 1909 Act also expressly conditioned copyright protection upon “publication of the work with the notice of copyright.”⁵⁶ The notice requirement thus remained constitutive: Publication without notice resulted in forfeiture. The 1909 Act likewise required that authors register the work and “promptly” deposit copies with the Copyright Office.⁵⁷ And although the registration and deposit requirements were no longer constitutive, copyright holders could not bring an infringement action until they had satisfied these formalities.⁵⁸ In short, all of the requisite conditions, though somewhat refashioned, remained operative under the 1909 Act.

But winds of change were afoot, inspired in part by the Berne Convention’s prohibition on formalities that affect “the enjoyment and the exercise” of rights in protected works.⁵⁹ Indeed, with the current copyright statute, enacted in 1976, Congress set out to remake what was once a rather complex thicket of demanding formalities. The 1976 Act, like its 1909 precursor, requires that copyright holders register the work before bringing an infringement action.⁶⁰ Yet registration under the 1976 Act, while not constitutive, does provide some nontrivial benefits: Certain remedies are only available to plaintiffs who register their

50. *Id.* at 493.

51. Act of Feb. 3, 1831, ch. 16, § 16, 4 Stat. 436, 439 (amended 1870) [hereinafter 1831 Act].

52. *Id.* §§ 2, 4, 5.

53. Act of June 30, 1834, ch. 157, § 1, 4 Stat. 728.

54. Act of Mar. 4, 1909, ch. 320, §§ 10, 19–21, 24, 35 Stat. 1075, 1075–81 (amended 1976) [hereinafter 1909 Act].

55. *Id.* § 23.

56. *Id.* § 12.

57. *Id.*; see also Sprigman, *supra* note 5, at 494 n.42.

58. The statute expressly mandated as follows: “No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with.” 1909 Act, *supra* note 54, § 12; see also Jane C. Ginsburg, *The U.S. Experience with Mandatory Copyright Formalities: A Love/Hate Relationship*, 33 COLUM. J.L. & ARTS 311, 331 (2010).

59. Berne Convention for the Protection of Literary and Artistic Works art. 5, Sept. 9, 1886, S. TREATY DOC. NO. 99-27 (1988).

60. 17 U.S.C. § 411(a).

works prior to infringement,⁶¹ and registration gives rise to a presumption of notice that the work is protected by copyright.⁶²

Other formalities, however, fared worse. Today, authors who fail to deposit copies of the work face only a fine, rather than outright forfeiture.⁶³ The 1976 Act also renders the notice requirement voluntary. Failure to attach a copyright notice no longer strips authors of their copyrights,⁶⁴ though notice may still prove advantageous in some circumstances.⁶⁵ Finally, Congress also disposed of the requirement that authors renew their rights.⁶⁶

In brief, copyright's modern-day scheme of procedural formalities is modest and largely optional. While copyright formalities have not faded entirely, they have gradually fallen into disfavor.

Scholars, in turn, are sharply divided over the virtues of copyright formalities. Some clamor for strong formalities and decry their demise. Most prominently, Christopher Sprigman has argued for the "reformatization" of American copyright law.⁶⁷ He notes that, at a time when authors had to renew their rights to maintain copyright protection, approximately fifteen percent of works were renewed, while the remaining eighty-five percent fell into the public domain after a relatively short term of initial protection.⁶⁸ Why did so many authors fail to renew their rights? Sprigman suggests an intuitive explanation: Most works were not commercially profitable over time,⁶⁹ and so their owners chose not to renew their rights. The renewal requirement, in simple terms, measured authors' "desire for protection."⁷⁰ Works that retained their value beyond the initial term of protection were renewed. Many authors, however, elected not to renew their copyrights because their works were no longer profitable. As Sprigman reports, "[t]he majority of creative works have little or no commercial value, and the value of many initially successful works is quickly exhausted."⁷¹

61. *Id.* § 412.

62. *Id.* § 410(c).

63. *Id.* § 407(d).

64. *Id.* § 401(a) (specifying that a copyright notice *may* be placed on copies).

65. The Copyright Act of 1976 precludes reliance on the "innocent infringement" defense when copies of the work were imprinted with a notice. *Id.* §§ 401(d), 402(d).

66. *See* Copyright Amendments Act of 1992, Pub. L. No. 102-307, §§ 101-102, 106 Stat. 264, 264-66.

67. Sprigman, *supra* note 5, at 490 ("[R]eformatizing copyright might restore the balance between incentives and access that the old conditional system maintained.").

68. *Id.* at 519-21.

69. *Id.* at 521 ("In a conditional system . . . only a small portion of works retains enough value at the end of an initial term to merit renewal.").

70. *Id.* at 519.

71. *Id.* at 489. Similarly, Kristelia García and Justin McCrary conclude that "the vast majority of copyrightable information goods never reach the point of commercial viability at all." Kristelia A. García & Justin McCrary, *A Reconsideration of Copyright's Term*, 71 ALA. L. REV. 351, 383 (2019). Focusing on the music industry, García and McCrary find that the average musical work declines in value rapidly, with album and song sales "falling to one-tenth of initial levels well within a year." *Id.* at 391.

On this account, copyright formalities serve a useful screening function. Because formalities present a costly obstacle to copyright protection, they deter authors of low-value works from pursuing statutory copyrights, thereby filtering out certain works and enriching the public domain.⁷² For that reason, Sprigman and others have argued that we should reintroduce mandatory formalities into our copyright system.⁷³

But some commentators believe that that would be a bad idea.⁷⁴ A growing chorus of scholars caution against strong formalities precisely because such formalities would lead to underinvestment in the production of certain types of works — in particular, works whose anticipated market value is low or uncertain.⁷⁵ On this view, the filtering function associated with strong formalities is a bug, not a feature. It threatens to deprive society of creative works that would otherwise be created. And in the long run, it would frustrate copyright's underlying objective of encouraging authors to produce creative works.

Another line of critique wrestles with the distributive effects of formalities. Several scholars have questioned whether formalities, such as they are, impose a disproportionately heavy burden on women and people of color.⁷⁶ Critics thus posit that the registration requirement stands in the way of marginalized authors seeking to enforce their rights.⁷⁷ Previous studies have also found that white authors are overrepresented in the copyright registry.⁷⁸

Some scholars also contend that, as a historical matter, formalities have privileged wealthy publishers at the expense of individual

72. Sprigman, *supra* note 5, at 502–28.

73. *Id.* at 554–55 (advocating for a system of “new-style formalities,” where formalities would remain formally voluntary but the works of noncompliant rightsholders would be subject to a default license at a predetermined rate); *see also* Gibson, *supra* note 7, at 221–31 (proposing a resurrection of mandatory formalities); LAWRENCE LESSIG, *THE FUTURE OF IDEAS* 251–52 (2001) (suggesting that copyright protection be subject to fifteen renewable terms of five years).

74. *See generally* Arthur Levine, *The End of Formalities: No More Second-Class Copyright Owners*, 13 *CARDOZO ARTS & ENT. L.J.* 553 (1995); Shira Perlmutter, *Freeing Copyright from Formalities*, 13 *CARDOZO ARTS & ENT. L.J.* 565 (1995); Ginsburg, *supra* note 58, at 348 (arguing that without a “smoothly-functioning” registration system, mandatory formalities are undesirable).

75. *See, e.g.*, David Fagundes & Jonathan S. Masur, *Costly Intellectual Property*, 65 *VAND. L. REV.* 677, 709–25 (2012). Fagundes and Masur claim that the problem is most acute with respect to a specific subset of copyrighted works: those that generate little value for their owners but a positive value for the public. They discuss, for example, freelance photographers who take hundreds of photos a week but would struggle to obtain a separate copyright for each photo. *Id.* at 720–24.

76. Miriam Marcowitz-Bitton & Emily Michiko Morris, *The Distributive Effects of IP Registration*, 23 *STAN. TECH. L. REV.* 306, 307 (2020); *see also* John Tehranian, *The Emperor Has No Copyright: Registration, Cultural Hierarchy, and the Myth of American Copyright Militancy*, 24 *BERKELEY TECH. L.J.* 1399, 1451–52 (2009).

77. Tehranian, *supra* note 76, at 1453.

78. Robert Brauneis & Dotan Oliar, *An Empirical Study of the Race, Ethnicity, Gender, and Age of Copyright Registrants*, 86 *GEO. WASH. L. REV.* 46, 59–60 (2018).

authors.⁷⁹ As discussed below, nineteenth-century authors often failed to comply with formalities.⁸⁰ Publishers, by contrast, were typically quick to register the copyrights in their own name, occasionally doing so without the author's knowledge.⁸¹ That is not surprising. Compliance with formalities required a great deal of resources and time. As Jessica Litman put it, "the three prerequisites to copyright ownership — registration of the printed title page before publication, deposit of published copies shortly following publication, and copyright notice printed on the title page — were all actions peculiarly within the competence of the publisher."⁸² So it is no accident that, in this climate, authors floundered while well-resourced publishers flourished.

Courts, meanwhile, did little to blunt the impact of copyright's seemingly unforgiving formalities. Overall, early courts urged a "rigidly positivistic concept of copyright"⁸³ and demanded "strict adherence to formalities."⁸⁴ The Supreme Court, for example, held that an omission of the word "copyright" from the copyright notice should invalidate the author's rights.⁸⁵ Judges also rejected the use of initials rather than the proprietor's full name in the copyright notice.⁸⁶ And some courts similarly found that failure to specify that the copyright was entered "in the office of the librarian of congress, at Washington" should render the notice invalid.⁸⁷ In one particularly controversial case, the Supreme Court refused to treat an unsigned deposit certificate from the Library of Congress as sufficient.⁸⁸ More broadly, the deposit requirement placed a heavy burden on some authors — think, for instance, of the first Supreme Court reporter, who was forced to submit a separate deposit for each of his eighty court reports.⁸⁹ That might explain why

79. See, e.g., Jessica Litman, *What Notice Did*, 96 B.U. L. REV. 717, 734–35 (2016).

80. See *infra* Part IV.

81. Many of the cases discussed below arose out of a familiar set of circumstances: a non-compliant author and a compliant publisher. See *infra* Part IV.

82. Litman, *supra* note 79, at 734–35.

83. Ginsburg, *supra* note 58, at 320. In *Wheaton v. Peters*, for example, the Supreme Court stressed the constitutive role of copyright formalities: "No one can deny that when the legislature are about to vest an exclusive right in an author or an inventor, they have the power to prescribe the conditions on which such right shall be enjoyed; and that no one can avail himself of such right who does not substantially comply with the requisitions of the law." 33 U.S. (8 Pet.) 591, 663–64 (1834).

84. Ginsburg, *supra* note 58, at 320.

85. *Higgins v. Keuffel*, 140 U.S. 428, 434 (1891).

86. *Smith v. Bartlett*, 18 F. Supp. 35, 36–37 (D. Me. 1937).

87. *Jackson v. Walkie*, 29 F. 15, 15–16 (C.C.N.D. Ill. 1886).

88. *Merrell v. Tice*, 104 U.S. 557 (1882). The certificate confirmed that "[t]wo copies of the [author's] publication [were] deposited December 6, 1876." *Id.* at 558. The Court held that the certificate amounted to an unsigned "memorandum" that could not constitute "competent evidence" of deposit. *Id.* at 561–62.

89. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 667 (1834) (noting that the statute mandated that the plaintiff, in his capacity as reporter, "deliver eighty copies of each volume of his reports to the department of state").

critics have long maligned copyright formalities as a “trap for the unwary.”⁹⁰

But it would be a mistake to assume that procedural flaws always led to forfeiture. At times, courts seemed quite tolerant of procedural deficiencies. For example, judges occasionally held that certain notice-related flaws need not dispossess authors of their rights.⁹¹ The 1909 Copyright Act expressly provided that “the omission by accident or mistake of the prescribed notice” might be excused if the copyright proprietor “sought to comply” with the notice requirement.⁹² And some courts were willing to overlook minor deviations from the notice requirement — say, when the notice misidentified the copyright owner by using a technically incorrect name that was close enough to the name of the actual owner.⁹³

Similar patterns were evident in cases involving the publication doctrine. Before 1989, the requirement to observe formalities arose at the moment of publication.⁹⁴ Accordingly, works could enter the public domain in one of two ways: (1) when the copyright expired, or (2) when the work was published without observance of formalities.⁹⁵ Identifying the moment of publication was thus critical to determining the status of the work. If the author of a published work failed to conform with formalities, the copyright would be lost.⁹⁶ Mindful of that risk, courts responded by “[elaborating] a parallel universe of ‘unpublished’ works.”⁹⁷ They recognized, for example, that public performance of a work did not constitute “publication” in the copyright sense, even if a sizable audience had been exposed to the work.⁹⁸

That said, one should not overstate the magnitude or significance of these trends. Though some judges were more hospitable to the plight of authors, courts typically acquiesced to a stringent view of formalities. The Supreme Court, after all, repeatedly declared in no uncertain terms that formalities are “conditions precedent to the perfection of the

90. Ginsburg, *supra* note 58, at 322.

91. *See infra* text accompanying note 229 (identifying scenarios where compliance with formalities was not necessary).

92. 1909 Act, *supra* note 54, § 20. *See generally* Lynn McLain, *The Copyright Notice Requirement in the United States: A Proposed Amendment Concerning Deliberate Omissions of Notice*, 18 LOY. L.A. L. REV. 689, 693–94 (1985).

93. STAFF OF S. SUBCOMM. ON PATS., TRADEMARKS, AND COPYRIGHTS, 86TH CONG., STUDY NO. 7, NOTICE OF COPYRIGHT 16 (Comm. Print 1957) (“The courts have generally not been strict in requiring a full statement of the name [of the proprietor], if there is sufficient identification for practical purposes.”); *see* Ginsburg, *supra* note 58, at 330–31.

94. *See* Deborah R. Gerhardt, *Copyright Publication: An Empirical Study*, 87 NOTRE DAME L. REV. 135, 141–42 (2011).

95. *Id.* at 141.

96. *Id.*

97. *See* Ginsburg, *supra* note 58, at 323.

98. *Id.*

copyright”⁹⁹ and are “essential to a perfect title.”¹⁰⁰ The conventional story, then, is one of draconian formalities and unforgiving courts.

III. NINETEENTH-CENTURY JURISPRUDENCE

To get a sense of what nineteenth-century courts were getting at, it is crucial to understand the complexity of early copyright jurisprudence — a body of caselaw that arose out of a tradition of equity and was rooted in a mix of statutory and common-law rights. Though a perfectly exhaustive history of nineteenth-century law is beyond the scope of this Article, this Part examines its broad arcs.

A. Equity

Viewed from a modern vantage point, early courts seem unruly. They wielded significant discretion and occasionally appeared to disregard statutory directives. In reality, however, they were operating in a legal environment very different than our own — a system of equity.

In the nineteenth and early twentieth centuries, equity and law worked in parallel as two separate adjudicatory systems.¹⁰¹ Courts invoked principles of equity to shore up various doctrines (such as estoppel),¹⁰² remedies (like injunctions),¹⁰³ and substantive areas of law (like trusts).¹⁰⁴ Distilled to its core, this body of equitable jurisprudence was derived from a framework of subjective or holistic reasoning. While law required strict adherence to a specific process, equity afforded judges greater leeway to depart from legal strictures in order to reach just results.¹⁰⁵ And although equity was eliminated as a separate system

99. *Callaghan v. Myers*, 128 U.S. 617, 652 (1888); *see also* *Thompson v. Hubbard*, 131 U.S. 123, 150 (1889).

100. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 665 (1834) (“All the conditions are important; the law requires them to be performed; and, consequently, their performance is essential to a perfect title.”).

101. In some states, equity was exclusively the province of separate equity courts. Other states harbored all-purpose courts that exercised separate equity jurisdiction. *See* Robert von Moschzisker, *Equity Jurisdiction in the Federal Courts*, 75 U. PA. L. REV. 287, 289 (1927) (noting that, while Pennsylvania administered equitable rights “in the absence of the court of chancery,” other states, like New Jersey, erected “[s]eparate courts of chancery”).

102. *See* Henry E. Smith, *Equity as Meta-Law*, 130 YALE L.J. 1050, 1054 (2021).

103. *See id.*

104. *See* Doug Rendleman, *Irreparability Irreparably Damaged*, 90 MICH. L. REV. 1642, 1643 (1992) (“Traditionally equitable subjects include quiet title, partition, liens and mortgages, trusts, fiduciaries, guardianship, dissolution of marriage, and adoption.”).

105. Commentators tend to describe equity as a style of open-ended reasoning that accommodates case-specific judgments and a significant degree of discretion. *See, e.g.*, Samuel L. Bray, *The System of Equitable Remedies*, 63 UCLA L. REV. 530, 536 (2016) (“[E]quity might be characterized as a model of decisionmaking that emphasizes case-specific judgment, moral reasoning, discretion, or anti-opportunism.”).

in the United States in 1938,¹⁰⁶ its legacy remains deeply embedded in our legal fabric, particularly in the guise of equitable remedies and defenses.¹⁰⁷

In a sense, equity was never entirely distinct from law. Rather, equity is better understood as “a new level of law,”¹⁰⁸ or a type of “meta-law.”¹⁰⁹ Henry Smith understands equity to stand for a higher-order system — a system to which judges turned when confronted with legal rules that generated high levels of complexity and uncertainty. In particular, Smith argues that equity kicked in when courts faced three types of cases. First, equity was deployed to resolve cases involving polycentric rights and parties.¹¹⁰ Think, for instance, of water disputes that implicate multiple parties, especially when such disputes could also impact the interests of additional, nonlitigant parties. Second, equity emerged in cases where parties asserted conflicting rights.¹¹¹ Of course, one potential way to resolve disputes between parties asserting dueling rights would be to better define such rights in the first place.¹¹² Another solution would be to “leave the presumptive rights in place and to reconcile them *ex post* based on an equitable, context-sensitive style of reasoning.”¹¹³ Third, equity seemed most poignant in situations where an opportunistic actor sought to take advantage of another party by seizing on a rule that typically functioned well.¹¹⁴

Equity, in short, was brought to bear on problems of polycentricity, conflicting rights, and opportunism. A prime example is the doctrine of good faith purchase. Consider a scenario in which Party B obtains an item from Party A by fraud and then sells it to Party C. Today, under the Uniform Commercial Code, if Party C acted in good faith and gave value for the purchased good, she obtains good title.¹¹⁵ Historically,

106. See FED. R. CIV. P. 2 (stating that “[t]here is one form of action — the civil action”); Rex R. Perschbacher & Debra Lyn Bassett, *The Revolution of 1938 and Its Discontents*, 62 OKLA. L. REV. 275, 276–77 (2008) (“The 1938 Rules . . . merged law and equity.”); see also Smith, *supra* note 102, at 1059–67 (canvassing the history of early debates over the role of equity in the United States).

107. Smith, *supra* note 102, at 1054 (“Doctrines from unconscionability to estoppel, defenses sounding in unclean hands and disproportionate hardship, remedies like injunctions and much of restitution, entire areas including trusts and corporate law, and much of our system of civil procedure all trace back to the courts of equity.”).

108. *Id.*

109. *Id.*

110. *Id.* at 1071–73.

111. *Id.* at 1073–76.

112. *Id.* at 1073.

113. *Id.*

114. *Id.* at 1076–81.

115. U.C.C. § 2-403 (AM. L. INST. & UNIF. L. COMM’N 2014). For a general review of the doctrine and its history, see Grant Gilmore, *The Commercial Doctrine of Good Faith Purchase*, 63 YALE L.J. 1057 (1954), and Grant Gilmore, *The Good Faith Purchase Idea and the Uniform Commercial Code: Confessions of a Repentant Draftsman*, 15 GA. L. REV. 605 (1981), and Alan Schwartz & Robert E. Scott, *Rethinking the Laws of Good Faith Purchase*, 111 COLUM. L. REV. 1332 (2011).

however, cases of good faith purchase were cast in terms of equity.¹¹⁶ When Party B deceived Party A, the latter acquired an equitable interest in the object. And that equitable interest entitled Party A to recover the object.¹¹⁷ Nevertheless, a good faith purchaser obtained the object free from competing equitable interests and was thus entitled to retain (or resell) it.¹¹⁸

Cases of good faith purchase bring into focus all of the problems that ordinarily trigger equitable treatment — they involve multiple parties and complex problems of sequential title, they deal with conflicting potential rights, and they often give rise to some degree of opportunism. In the face of these circumstances, judges would tap into rules of equity to prevent the law from “failing because of its generality.”¹¹⁹ When traditional rules failed — either because they could not point toward a clear solution or because they led to seemingly harsh results — judges looked to equity.

Indeed, as Smith explains, critics of equity have largely misunderstood its utility. Commentators have long railed against the arbitrariness associated with equity, warning that equitable relief ultimately boils down to a standard as capricious as the length of the “Chancellor’s foot.”¹²⁰ But that is exactly backward — equity served to mitigate the law’s arbitrariness. And even though equity cannot be reduced to a neat, uniform set of rules, it is precisely this quality that has allowed equity to occupy such a central role in our system: resolving complex and uncertain problems through a more open-textured, context-sensitive inquiry.

These insights apply with equal force to copyright disputes. In the nineteenth and early twentieth centuries, lawsuits for copyright infringement were typically dressed up as bills in equity, and most early cases were resolved in equity.¹²¹ The resort to equity seemed

116. Smith, *supra* note 102, at 1095. For an elaborate account of the doctrine’s development, see Harold R. Weinberg, *Markets Overt, Voidable Titles, and Feckless Agents: Judges and Efficiency in the Antebellum Doctrine of Good Faith Purchase*, 56 TUL. L. REV. 1 (1981).

117. Smith, *supra* note 102, at 1095.

118. See Shyamkrishna Balganes, *Copyright and Good Faith Purchasers*, 104 CALIF. L. REV. 269, 269 (2016).

119. See, e.g., *Riggs v. Palmer*, 22 N.E. 188, 189 (N.Y. 1889) (echoing this very theme and citing Aristotle’s common refrain: “[a]quitas est correctio legis generaliter late quae parte deficit” — equity corrects the law when it is defective because of its generality).

120. This line of critique is best epitomized by John Selden’s famous admonishment that equity is “roguish” because it turns on an uncertain standard measured by the length of the Chancellor’s foot. See JOHN SELDEN, *TABLE-TALK: BEING THE DISCOURSES OF JOHN SELDEN, ESQ.; BEING HIS SENSE OF VARIOUS MATTERS OF WEIGHT AND HIGH CONSEQUENCE; RELATING ESPECIALLY TO RELIGION AND STATE* 43, 43–44 (Richard Milward & Samuel W. Singer eds., J.M. Dent & Co. 1906) (1689).

121. See Bruce E. Boyden, *The Enduring Appeal of “Total Concept and Feel”* 3 (Aug. 9, 2021) (unpublished manuscript) (on file with author) (“[T]he foundational doctrines and standards of copyright law were laid down during the early twentieth century, a time when infringement cases were usually resolved in equity, not at law.”). Consider, for example, *Keene v. Wheatley*, 14 F. Cas. 180 (C.C.E.D. Pa. 1861) (No. 7,644). In *Keene*, a British

particularly appropriate in disputes over compliance with formalities. The reason is that such disputes typically involved complexities such as the presence of multiple parties asserting conflicting rights, including the author, the publisher, a third-party infringer, and potential heirs to the title.¹²² Occasionally, these disputes also led to harsh results, requiring total abrogation of the copyright for failure to comply with technical formalities. And some of these cases provided ample fodder for opportunism — most commonly when a party gratuitously pointed to procedural defects in the registration of the copyright in an effort to get around contractual obligations.¹²³

And equity not only helps explain *why* courts resolved these cases the way they did; it also explains *how* courts were able to do so. As the next Part makes plain, some judges developed a scheme of equitable ownership to settle disputes over copyright formalities. In a number of cases where the author did not comply with formalities, but some other party did, courts held that both parties were, in fact, owners: The registrant (the party that complied with formalities) was the “formal” copyright owner, while the author retained an equitable interest in the work.¹²⁴ As a result, courts suggested that the registrant was acting as a trustee on behalf of the author. The registrant was thus required to pay the author for using the copyrighted work. This was, in other words, a scheme of constructive trust.

To modern eyes, this may seem like a radical idea: Courts imagined into existence a trust scheme. But such a scheme, however peculiar by modern standards, was a rather routine equitable remedy. In a wide array of cases, courts deployed constructive trust as a means of treating a wrongdoer as a trustee for the victim’s benefit.¹²⁵ As Smith notes, when “someone commits a wrong or would be unjustly enriched, a court can exercise discretion to impose a remedy in the form of a trust on the

dramatist by the name of Tom Taylor sold his rights in a play to Laura Keene, a New York City theater owner. *Id.* at 182. Joseph Jefferson, an actor employed by Keene, created an adaptation of the play and later sold his adaptation to two theater managers based in Philadelphia. *Id.* Keene sued for infringement. *Id.* at 183–84. The court concluded that Keene did not have a *statutory* copyright in the original play because its author, Taylor, was not a U.S. resident. *Id.* at 185. Nonetheless, the court then went on to hold that Keene could claim an equitable interest in the work, stating that “[i]n the exercise of this equitable jurisdiction, rights founded in personal and professional relations of confidence are protected independently of any question of the existence or continuance of proprietary right.” *Id.* at 187.

122. Indeed, problems of complexity and uncertainty figure prominently in copyright disputes. See Henry E. Smith, *Putting the Equity Back into Intellectual Property Remedies*, 96 NOTRE DAME L. REV. 1603–04 (2021) (“[Intellectual property and its associated remedies] involve complexity and uncertainty that stem from interactions among parties, their activities, and the resources they employ to develop information.”).

123. See cases discussed *infra* Part IV.

124. See *infra* Section IV.B.

125. See, e.g., *Riggs v. Palmer*, 22 N.E. 188 (N.Y. 1889) (applying constructive trust in a criminal law case); *Marvin v. Marvin*, 557 P.2d 106 (Cal. 1976) (invoking constructive trust to resolve a case of relational dissolution).

subject matter or in contravention to the property rights that would normally hold.”¹²⁶ In enforcing a scheme of constructive trust, the court “redistributes the property in order to mitigate unjust enrichment.”¹²⁷ In sum, although the idea of constructive ownership might seem aberrant, it aligns comfortably with the jurisprudence of equity courts throughout the nineteenth century.

B. Common-Law Copyright

To properly frame nineteenth-century caselaw, it is also crucial to recognize that a great deal of early copyright jurisprudence turned on common-law rights arising under state law. In *Wheaton v. Peters*,¹²⁸ the Supreme Court directly tackled common-law copyright for the first time.¹²⁹ Henry Wheaton was the first official reporter for Supreme Court decisions.¹³⁰ His successor, Richard Peters, published an abbreviated collection of past Supreme Court decisions, including those reported by his predecessor.¹³¹ Wheaton sued for infringement, claiming that Peters infringed upon his common-law copyright — namely, his “perpetual property in the copy of his works.”¹³²

The Court declined to recognize that common-law copyrights are perpetual.¹³³ Such common-law rights, the Court concluded, were exhausted upon publication.¹³⁴ The result was a sharp divide between published and unpublished works. While published works were subject to statutory copyright law, unpublished works were protected under common-law copyright.¹³⁵ Thus, Wheaton’s common-law copyright was lost because his reports had already been published.¹³⁶ Instead,

126. Smith, *supra* note 102, at 1135; *see also* Mitsubishi Int’l Corp. v. Cardinal Textile Sales, Inc., 14 F.3d 1507, 1518 (11th Cir. 1994) (“[A] constructive trust arises where a person who holds title to property is subject to an equitable duty to convey it to another on the ground that he would be unjustly enriched if he were permitted to retain it.” (quoting 5 AUSTIN W. SCOTT, THE LAW OF TRUSTS § 462, at 3413 (3d ed. 1967))).

127. Laura Weinrib, *Reconstructing Family: Constructive Trust at Relational Dissolution*, 37 HARV. C.R.–C.L. L. REV. 207, 209 (2002) (citing 5 AUSTIN WAKEMAN SCOTT & WILLIAM FRANKLIN FRATCHER, THE LAW OF TRUSTS 304 (4th ed. 1989)).

128. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 591 (1834).

129. Zvi S. Rosen, *Common-Law Copyright*, 85 U. CIN. L. REV. 1055, 1061 (2018).

130. Craig Joyce, “A Curious Chapter in the History of Judicature”: *Wheaton v. Peters and the Rest of the Story (of Copyright in the New Republic)*, 42 HOUS. L. REV. 325, 351 (2005).

131. *Peters*, 33 U.S. at 595.

132. *Id.* at 654.

133. *Id.* at 657–58 (refusing to find “a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world”).

134. *Id.* at 657.

135. *Id.*

136. *Id.* at 662.

Wheaton was entitled to claim statutory copyrights on the condition that he complied with the requisite formalities.¹³⁷

By the mid-nineteenth century, the consensus among judges and commentators was that common-law copyrights could persist so long as the work remained unpublished. A twentieth-century study by the Copyright Office likewise described common-law copyrights as “absolute rights” in unpublished works.¹³⁸ Similarly, the 1909 Copyright Act explicitly preserved the “right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent.”¹³⁹

Whether the work had been “published,” however, remained a source of uncertainty.¹⁴⁰ As one commentator noted, “publication may reasonably be thought to mean one thing under the statute as related to published works and another under the common law as related to ‘unpublished’ works.”¹⁴¹ Given this state of uncertainty, authors faced significant risks. By publishing the work, an author would forfeit her common-law copyright. And by failing to observe formalities upon publication, she would relinquish her statutory copyright. The net result is that some authors were stripped of any legal rights in their works.

Many of the cases discussed below bear out these tensions. Some disputes draw primarily on common-law copyright: they involve a pre-publication assignment of common-law rights. Other cases center on statutory law, particularly when the work was published but the author failed to comply with copyright formalities. In such circumstances, with the risk of all-out forfeiture lurking in the background, some courts found that the noncompliant author had implicitly transferred the rights to a compliant publisher. Other times, courts painted a picture of constructive ownership, one in which the copyrights formally rest with the publisher (or anyone else who complied with copyright formalities), but the author nonetheless retains some equitable interest in the work.

IV. PRAGMATISM IN ACTION

This Part pieces together an account of the courts’ far-reaching pragmatism — a deeply contextual philosophy that pervaded early cases dealing with copyright formalities. It begins by providing an overview of nineteenth-century law on questions of copyright assignment. It then explores doctrines of equitable ownership, which enabled

137. *Id.* at 664, 667 (remanding to the circuit court with instructions to determine whether Wheaton had complied with the necessary formalities).

138. STAFF OF S. SUBCOMM. ON PATS., TRADEMARKS, AND COPYRIGHTS, 86TH CONG., STUDY NO. 29, PROTECTION OF UNPUBLISHED WORKS I (Comm. Print 1957).

139. 1909 Act, *supra* note 54, § 2.

140. STAFF OF S. SUBCOMM. ON PATS., TRADEMARKS, AND COPYRIGHTS, 86TH CONG., *supra* note 138, at 1–2.

141. *Id.* at 1.

courts to find that the publisher was holding the copyright as a trustee on behalf of the author.

A. Copyright Assignment

For much of the nineteenth century, the statutory framework controlling copyright assignment remained somewhat hazy. An 1834 amendment to the copyright statute required — or was understood to require — that copyright assignments be made in writing. In a section titled “[d]eeds of transfer to be recorded,” the amendment specified that:

[A]ll deeds or instruments in writing for the transfer or assignment of copyrights . . . shall and may be recorded in the office where the original copyright is deposited and recorded; and every such deed or instrument that shall in any time hereafter be made and executed, and which shall not be proved or acknowledged and recorded as aforesaid, within sixty days after its execution, shall be judged fraudulent and void against any subsequent purchaser or mortgagee for valuable consideration without notice.¹⁴²

The language of the 1834 amendment left something to be desired. On its face, the provision stopped short of proscribing unwritten assignments altogether. Failure to comply with the recordation requirement only rendered an assignment void against subsequent purchasers. Unrecorded assignments were thus valid as between the assignor and the assignee, but not against third parties. That seemed perfectly consistent with the goal of the recordation requirement — to put third parties (and the public at large) on notice as to the identity of the copyright owner and the existence of the rights.¹⁴³

But there’s evidence to suggest that some prominent commentators understood the amendment to categorically bar unwritten assignments. Most notably, a copyright treatise published in 1847 endorsed (if only timidly) that view. In his *Treatise on the Law of Copyright*, George Curtis opined that the 1834 amendment “seems to recognize the doctrine, that [copyright assignments] must be in writing, but it does not

142. Act of June 30, 1834, ch. 157, 4 Stat. 728, 728 (1834).

143. See Sprigman, *supra* note 5, at 500–01; Miriam Marcowitz-Bitton & Emily M. Morris, *Unregistered Patents*, 95 WASH. L. REV. 1835, 1843–44 (2020) (“Registration serves an important public-notice function providing all with information on who owns what rights.”). Relatedly, registration and recordation also lower transaction costs by making it easier to identify and obtain a license from the copyright owner. Marcowitz-Bitton & Morris, *supra*, at 1844.

expressly declare that they shall be so.”¹⁴⁴ Acknowledging that there is yet a cloud of “great doubt”¹⁴⁵ surrounding the assignment provision, Curtis nonetheless read the amendment to prohibit unwritten assignments. His view was partly informed by British caselaw, which construed similar provisions to foreclose unwritten assignments.¹⁴⁶

Moreover, other sections of the copyright statute pointed in the same direction. In 1790, the first federal copyright statute defined infringement as an act of printing, reprinting, publishing, or importing copies of the protected work “without the consent of the author or proprietor thereof, first had and obtained in writing, [and] signed in the presence of two or more credible witnesses.”¹⁴⁷ That language, borrowed from the British copyright statute, remained in effect for well over a century, until it was finally extinguished by the 1909 Act.¹⁴⁸ The requirement that any reproduction of the work be authorized in writing is instructive. If the copyright holder had to grant permission in writing when a nonowner wished simply to make a copy of the work, it is hard to see how an unlimited, perpetual assignment of the rights — a transfer of title — could be given effect without a written agreement. Any other outcome would be perverse.

And that is exactly why British courts, confronting similar language, ultimately concluded that copyright assignments must be rendered in writing. In discussing British copyright law under the Statute of Anne, Daniel Chamier’s treatise observed that “[u]nder the old Act it was established by a series of decisions, that as the consent in writing of the proprietor was required to the printing of any book by any person, the assignment, which was a greater thing, must be in writing also.”¹⁴⁹ Indeed, the first British case to reach that conclusion, *Power v. Walker*, found that assignments must be made in writing to be legally binding — a proposition the court found “almost irresistible.”¹⁵⁰ A better-known case, *Clementi v. Walker*,¹⁵¹ similarly suggested that parol assignments are void as a matter of law, although the case was eventually decided on other grounds.¹⁵² In *Clementi*, the defendant published an

144. GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF COPYRIGHT IN BOOKS, DRAMATIC AND MUSICAL COMPOSITIONS, LETTERS AND OTHER MANUSCRIPTS, ENGRAVINGS AND SCULPTURE, AS ENACTED AND ADMINISTERED IN ENGLAND AND AMERICA 233 (1847).

145. *Id.* at 219–20.

146. *Id.* at 220–24.

147. Act of May 31, 1790, ch. 15, § 2, 1 Stat. 124, 124 (amended 1831).

148. 1909 Act, *supra* note 54, § 42.

149. DANIEL CHAMIER, LAW RELATING TO LITERARY COPYRIGHT AND THE AUTHORSHIP AND PUBLICATION OF BOOKS 78 (1895).

150. *Power v. Walker*, 3 M. & S. 7, 9 (1814).

151. *Clementi v. Walker*, 2 B. & C. 861 (1824).

152. The court held that British law extends to British publications alone. *Id.* at 867–69. The privileges provided under the law, therefore, were “confined to books printed in this [British] kingdom.” *Id.* at 868. That is because the statute purported to safeguard “British interests and . . . British learning.” *Id.* at 867–68 (emphasis added).

unauthorized version of Friedrich Kalkbrenner's piano notes for the popular French composition *Vive Henri IV*.¹⁵³ At the time the defendant published the unauthorized version, Kalkbrenner had orally assigned his publication rights in England to Muzio Clementi, a publisher based in London.¹⁵⁴ Clementi sued the defendant for copyright infringement. The court, however, concluded that Clementi's rights were invalid because the assignment was not made in writing.¹⁵⁵ A parol assignment, the court declared, was "not sufficient to give to the assignee the privileges conferred by the Legislature upon the author."¹⁵⁶

American courts, by contrast, were far less resolute. Many of the cases surveyed in this Section demonstrate that courts were hesitant to address the issue head-on. They typically avoided it, and sometimes suggested, as some prominent cases did,¹⁵⁷ that the author's rights can equitably vest in another party,¹⁵⁸ so an assignment was not necessary in the first place. Still, even when courts ultimately upheld unwritten assignments, they usually did so without directly confronting the statutory language.¹⁵⁹ And some courts appeared to assume that if regular licenses ought to be entered in writing, then surely assignments must be rendered in writing as well.¹⁶⁰

Eventually, in *Callaghan v. Myers*, the Supreme Court weighed in on the issue.¹⁶¹ Interpreting the 1831 copyright statute, the Court reasoned that copyright assignments made after the author had obtained a statutory copyright — namely, after the author had complied with copyright formalities — should be in writing. To be sure, while the Court offered little in the way of analysis, it curtly stated that "after the obtaining of a copyright, a written assignment may be necessary to convey title to it, or a written license to give a right to reproduce copies of the

153. *Id.* at 861–62.

154. *Id.* at 862.

155. *Id.* at 866.

156. *Id.*

157. *See, e.g.*, *Lawrence v. Dana*, 15 F. Cas. 26, 51 (C.C.D. Mass. 1869) (No. 8,136).

158. *See infra* text accompanying notes 254–66.

159. *See, e.g.*, *Dielman v. White*, 102 F. 892 (C.C.D. Mass. 1900).

160. *Parton v. Prang*, 18 F. Cas. 1273 (C.C.D. Mass. 1872) (No. 10,784). In *Parton*, the plaintiff argued that an implicit assignment cannot be valid: the statute required that licenses be reduced to writing and signed in the presence of two witnesses, and so the same rule ought to govern copyright transfers. *Id.* at 1274. The court, however, suggested that no assignment was necessary here at all, because the type of work at issue — a picture — was not explicitly protected under the 1831 Copyright Act. As the court explained, "[m]anuscripts of every kind are embraced [by the section requiring written licenses], but pictures are not named in the provision, and cannot be regarded as entitled to that special protection . . ." *Id.* at 1275. The court, in other words, was willing to entertain the idea that the statutory section dealing with written licenses provided authors with some kind of "special protection" that was applicable more broadly to copyright assignments. Nevertheless, the court ultimately waved away the issue by finding that the work here was not covered by the statute in the first place. *See infra* text accompanying notes 230–34.

161. *Callaghan v. Myers*, 128 U.S. 617, 658 (1888).

copyrighted book.”¹⁶² The Court’s reference to a “written license” suggests that the Court followed the same line of reasoning that animated earlier British cases — that is, if mere licenses require written agreements, so do assignments.

But, again, the following Sections will show that, in cases decided both before and after *Callaghan*, lower courts equivocated on the issue. So although it seems likely that the 1834 amendment (and, arguably, earlier iterations of the copyright statute) sought to disallow unwritten assignments,¹⁶³ a review of the caselaw provides little clarity.

Ultimately, the problem was short-lived. In 1870, Congress moved to overhaul the copyright statute. In relevant part, the Copyright Act of 1870 provided that:

[C]opyrights shall be assignable in law, by any instrument of writing, and such assignment shall be recorded in the office of the librarian of Congress within sixty days after its execution, in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice.¹⁶⁴

Unlike the 1834 amendment, the language of the 1870 Act made clear that assignment can only be effectuated by a written instrument. Accordingly, in *Fred Fisher Music Co. v. M. Witmark & Sons*, the Supreme Court reiterated that assignments require recordation.¹⁶⁵ In holding that renewal terms were assignable under the 1909 Act, the Court pointed out that “[s]ince the enactment of the Copyright Act of 1870 . . . assignments of copyrights must be recorded in the office of the Register of Copyrights.”¹⁶⁶ And while some degree of confusion persisted among lower courts as to the status of unrecorded assignments,¹⁶⁷ there is little doubt that, at a minimum, the 1870 statute required that copyright assignments be executed in writing.

In conclusion, there’s a fairly strong argument that the copyright statute imposed a written-assignment requirement at least since 1834,

162. *Id.*

163. Because the federal copyright statute required that licenses be rendered in writing since 1790, one could argue that assignments of statutory copyrights have, in fact, always required a written instrument of some sort.

164. Act of July 8, 1870, ch. 230, § 89, 16 Stat. 198, 213 (repealed 1909).

165. *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643, 658 (1943).

166. *Id.*

167. Some lower courts continued to treat unrecorded assignments as enforceable unless such assignments were asserted against bona fide purchasers. *See, e.g.*, *New Fiction Pub. Co. v. Star Co.*, 220 F. 994, 995–96 (1915) (holding that an unrecorded assignment is valid against a third-party infringer); *Photo Drama Motion Picture Co. v. Soc. Uplift Film Corp.*, 213 F. 374 (S.D.N.Y. 1914), *aff’d*, 220 F. 448 (2d Cir. 1915) (holding an unrecorded assignment is not enforceable against a subsequent assignment that was properly recorded).

and possibly even before. In any event, such a requirement governed copyright assignments since 1870 at the latest. Nevertheless, as the following discussion shows, courts largely skirted the issue and instead trotted out doctrines of equity to uphold unwritten assignments as enforceable.

* * * * *

With the statutory framework properly in view, the remainder of this Section explores nineteenth- and twentieth-century jurisprudence on questions of assignment. Perhaps the most influential early case grappling with copyright assignment is *Pulte v. Derby*.¹⁶⁸ Joseph Pulte entered into a publishing agreement with H.W. Derby & Company.¹⁶⁹ The agreement granted Derby the “exclusive right to print and publish an edition of one thousand copies” of Pulte’s book, *Homœopathic Domestic Physician*,¹⁷⁰ in exchange for a 15-cent royalty per sold copy.¹⁷¹ The agreement also provided Derby with the option to issue a second edition of “as many copies as they can sell.”¹⁷²

After selling out the second edition, Derby made plans to publish another edition.¹⁷³ Pulte sued for copyright infringement, asserting that he had not authorized another edition.¹⁷⁴ Derby countersued to enjoin Pulte from publishing his own edition of the book.¹⁷⁵

The Circuit Court for the District of Ohio sided with Derby. The court first looked to the circumstances surrounding the publishing agreement.¹⁷⁶ It found that when the agreement was signed, Pulte did not hold a statutory copyright in the work.¹⁷⁷ Rather, because the book had not yet been published, Pulte only held a common-law right in his unpublished manuscript.¹⁷⁸ The court then concluded that Pulte had implicitly assigned his common-law copyright to the publisher, and the publisher then obtained a statutory copyright by publishing the work and satisfying the necessary formalities.¹⁷⁹

168. *Pulte v. Derby*, 20 F. Cas. 51 (C.C.D. Ohio 1852) (No. 11,465).

169. *Id.* at 51.

170. *Id.*

171. *Id.*

172. *Id.* (stipulating that if the publisher finds that a “second edition [is] called for,” it may “print[] as many copies as they can sell, paying to [] Pulte the sum of twenty cents for each and every copy sold”).

173. *Id.*

174. *Id.*

175. *Id.*

176. *Id.* at 52 (“We must look out of the contract, to the acts of the parties, in regard to the copyright.”).

177. *Id.*

178. *Id.* at 51 (“At the time [the agreement] was entered into no copyright had been secured; and there is no provision in the agreement, by whom it was to be acquired in future.”).

179. The court first found that Pulte’s “property . . . would be protected at common law.” *Id.* at 52. The court next concluded that this common-law right was assigned to the publisher,

In reaching that conclusion, the court recognized that this was the only way to prevent forfeiture. As the court emphasized, “[i]t was the interest of both parties to have the copyright secured.”¹⁸⁰ Thus, to prevent the work from being “abandoned . . . to the public” after publication, the publisher took steps to secure the copyright for itself; it printed a copyright notice and registered the work in its own name.¹⁸¹ Indeed, the court stressed that compliance with these formalities was a precondition to statutory protection.¹⁸²

The problem, of course, was that the written agreement here offered little support for the claim that Pulte had assigned his rights to the publisher. As the court noted, “[t]he agreement between the parties does not purport to convey the copyright. At the time it was entered into no copyright had been secured; and there is no provision in the agreement, by whom it was to be acquired in future.”¹⁸³ The court nonetheless interpreted the record as supporting an inference of implicit assignment. It found that Pulte must have been aware of Derby’s copyright notice since the notice was affixed to copies of the book.¹⁸⁴ At a minimum, the court intuited, this suggested that Pulte likely sanctioned an assignment of the rights; otherwise, he would have objected to Derby’s registration upon encountering the printed notice.¹⁸⁵

The publisher was thus able to obtain a copyright without a written assignment. By implication, the court appeared to suggest that, because the author had not yet obtained statutory copyright protection, a written assignment was not necessary.¹⁸⁶ And although the publishing agreement was silent on the issue of copyright ownership,¹⁸⁷ the court interpreted the agreement as effectuating a transfer of rights from Pulte to Derby. The court’s reasoning goes something like this: Because the parties must have intended to secure some form of copyright in the work,¹⁸⁸ and because Pulte was likely aware that the publisher would register the work in its own name — after all, the publisher’s copyright

and the latter was then able to “secure[] . . . the copyright” on the basis of this initial assignment. *Id.*

180. *Id.*

181. *Id.*

182. *Id.* As the court noted, “[u]ntil these things are done, the copyright is not perfect.” *Id.*

183. *Id.* at 51.

184. *Id.* at 52.

185. *See id.*

186. At the time the parties signed the agreement, the author “had no copyright to convey.” *Id.* Since neither party had obtained a statutory copyright at that point, the statutory requirement of a written agreement did not yet come into play.

187. *Id.* at 51–52 (“The agreement between the parties does not purport to convey the copyright . . . We must look out of the contract, to the acts of the parties, in regard to the copyright.”).

188. The parties surely meant to secure copyright in the book, the court noted, because “[w]ithout [it], the first publication of [the book] would have abandoned it to the public, and consequently, it could have been of no more value to either party than to any other publishers or authors, who might choose to revise and republish it.” *Id.* at 52.

notice was published “under the eye of the complainant”¹⁸⁹ — an inference of implicit assignment was factually sound.

I argue below that the court’s inference of an implicit assignment was flimsy at best.¹⁹⁰ But, perhaps more bafflingly, the *Pulte* court also qualified its holding by observing that the rights at issue — the statutory copyrights registered by the publisher — were mere contractual rights. The case, in other words, turned on a contractual dispute.¹⁹¹ The court understood its decision to stand for the simple proposition that copyright interests can be subject to contractual obligations. As the court put it:

[A]lthough the legal title to the copyright is in the defendants, [the court] can only consider it in them for the purposes of the contract. The right covers their interest and protects it, so long as they shall be engaged in the publication and sale of the work. Beyond this, they are not considered as having the right. They can not [sic] transfer it. They have no power to assign the copyright, nor to publish the work except upon the terms of the contract¹⁹²

This meant that, as a practical matter, the “copyrights” transferred from the author to the publisher were no copyrights at all. Instead, these rights shared a closer kinship to contractual entitlements. Subsequent courts, too, understood *Pulte* to stand for that idea. One example is *In re Rider*, a case dealing with the transfer of copyrights to the creditors of the author.¹⁹³ In *Rider*, the Supreme Court of Rhode Island noted that *Pulte v. Derby* “sustained the defendant’s claim upon the contract, and held that the legal title to the copyright was in the defendant, *but only for the purpose of the contract*; that it was not assignable; and that the complainant had no right to publish the work in disregard of the contract.”¹⁹⁴

This reading of *Pulte* suggests that the publisher’s rights were limited, unassignable, and only enforceable against *Pulte* himself. In this telling, the *Pulte* court took a middle-ground approach — it first found that the publisher owned the copyrights in the book, and then characterized these rights as contractual.¹⁹⁵

189. *Id.*

190. See *infra* text accompanying notes 403–14.

191. *Pulte*, 20 F. Cas. at 53 (“This controversy has, no doubt, arisen from an honest conviction of their rights, under the contract, by the respective parties.”).

192. *Id.*

193. *In re Rider*, 15 A. 72 (R.I. 1888).

194. *Id.* at 72 (emphasis added).

195. *Id.*

The court in *Pulte* engaged in purpose-driven adjudication. It sought to avert a scenario in which no one owned the copyright in the work. If the book were not protected by copyright at all, it would have been “abandoned . . . to the public”¹⁹⁶ — a result the court clearly wished to avoid. Since Pulte’s failure to comply with formalities doomed his copyright, the court felt compelled to find that Pulte had assigned his rights to the publisher. Indeed, although there was no evidence that Pulte had agreed to assign his copyrights, the court figured out a way to hold that someone else — the publisher — held rights in the work. Some measure of copyright-like protection was salvaged. The court found that the copyright was held by the only party that had cleared the requisite formalities.

Other courts followed suit. Consider, for instance, *White-Smith Music Publishing Co. v. Apollo Co.*¹⁹⁷ In *White-Smith*, the composer of two musical compositions granted the publisher a license to publish the works.¹⁹⁸ And although the publishing agreement did not speak to an assignment of the rights,¹⁹⁹ the publisher later registered the copyrights in its own name.²⁰⁰ Interestingly, after the rights had already been registered, the composer assigned them in writing to the publisher.²⁰¹ Claiming sole ownership of the compositions, the publisher then brought suit against a third party for selling infringing perforated music sheets.²⁰²

The primary question was whether the perforated sheets — something of a novelty at the time — constituted unauthorized copies of the underlying composition.²⁰³ But the court first had to clear a threshold question: Was the plaintiff the copyright owner?²⁰⁴ Much like *Pulte*, the court here turned to the circumstances surrounding the agreement between the original author and the publisher. And, like *Pulte*, the court again treated the issue of procedural compliance as dispositive. The main question was whether the publisher’s initial registration of the rights — at a time when the original agreement granted the publisher

196. *Pulte*, 20 F. Cas. at 52.

197. *White-Smith Music Publ’g Co. v. Apollo Co.*, 139 F. 427 (C.C.S.D.N.Y. 1905), *aff’d*, 147 F. 226 (2d Cir. 1906), *aff’d*, 209 U.S. 1 (1908).

198. *Id.* at 428–29.

199. *Id.* at 429.

200. *Id.*

201. *Id.* (“The composition was delivered to the complainant by the composer in May, with the understanding that it should be published, and subsequently, in writing, he expressly authorized complainant to copyright the same. At this time, however, the composition had already been copyrighted by complainant in accordance with the laws of the United States respecting copyrights.”).

202. *Id.* at 428.

203. *Id.* at 429–32.

204. The defendant asserted that the plaintiff, having only been granted a publishing license, did not own the copyright in the compositions. *Id.* at 428–29.

only a publishing license — was legally valid.²⁰⁵ Eventually, though the record was “not entirely free from indefiniteness,”²⁰⁶ the court held that the registration was valid because the composer had implicitly assigned his rights to the publisher.²⁰⁷ The court concluded that the composer surely knew that the rights had been registered prior to the written assignment.²⁰⁸ Similarly, the composer’s decision to later assign the rights supported an inference that the composer meant to assign the copyright under the original agreement as well.²⁰⁹ Citing *Callaghan*, the court then suggested that an assignment in writing was unnecessary here because the original author had not yet obtained a statutory copyright when the rights were transferred.²¹⁰ Further, the court was almost certainly aware that failure to find an implicit assignment here would have vitiated copyright protection in the work — absent a proper assignment, the publisher’s initial registration would have been defective.²¹¹

Once again, the court shirked the written-assignment requirement to prevent forfeiture. It did so by relying on circumstantial evidence to suggest that the publisher had acquired a common-law right, which entitled it to claim statutory copyright protection.

Occasionally, however, courts were less receptive to claims of implicit assignment, especially in circumstances where the original author had complied with the requisite formalities. Take, for instance, *Black v. Henry G. Allen Co.*²¹² The publisher, Adam & Charles Black, owned the copyright in *Encyclopaedia Britannica*, which consisted of a collection of articles on different topics.²¹³ Adam & Charles Black entered into an agreement with an author, Francis Walker, to include Walker’s book about the “political geography” of the United States in the twenty-third volume of the encyclopedia.²¹⁴ Walker owned the copyright in the book and had satisfied the mandatory formalities by registering the title of the work, delivering copies to the Librarian of Congress, and imprinting a copyright notice on the title page.²¹⁵

205. Indeed, “[t]he question [was] whether in fact there was such an assignment or transfer of the musical composition before copyrighting as to carry with it the privilege given by the statute to the composer.” *Id.* at 429.

206. *Id.*

207. *Id.*

208. *Id.*

209. *Id.*

210. *Id.*

211. The critical point is that when the publisher registered the work, the composer had not yet assigned his rights. And so the registration in the publisher’s name at that point would be defective — perhaps even fraudulent — absent a transfer of the rights. To prevent that outcome, the court had to find that the composer had implicitly transferred the rights to the publisher prior to registration.

212. *Black v. Henry G. Allen Co.*, 56 F. 764 (C.C.S.D.N.Y. 1893).

213. *Id.* at 766.

214. *Id.*

215. *Id.*

The publisher and Walker brought a copyright infringement action against Henry G. Allen Company for selling infringing copies of the encyclopedia.²¹⁶ In response, Henry G. Allen Company asserted that the copyright in Walker's book was void because the registration was in the wrong name: Walker had assigned his rights in the book to the publisher and so the registration in his name was defective.²¹⁷

The court disagreed. Although the agreement between Walker and the publisher was somewhat murky — and perhaps susceptible to capacious interpretation²¹⁸ — the court summarily dismissed any claims of implicit assignment. In a single terse paragraph, it pointed out that there is no evidence of an “entire assignment.”²¹⁹

The stark contrast between this case and *Pulte* is telling. Why was the court here reluctant to countenance claims of implicit assignment? The answer is rather straightforward: A finding of assignment here would have abrogated — rather than secured — any copyright interests in a commercially successful work. Here, as opposed to *Pulte*, the author had in fact perfected his copyright by satisfying the relevant formalities. Thus, there was no need for the court to hold that the author had assigned his rights to another party.

Over time, courts chalked out increasingly granular rules to regulate copyright assignment in particular contexts. First, courts recognized that when an artist is commissioned to create a work of art, the commissioner will typically own the rights in the resulting work — unless the parties expressly agreed otherwise. To illustrate, consider *Dielman v. White*.²²⁰ An artist named Frederick Dielman was commissioned to create a mosaic for the Library of Congress.²²¹ He created a sketch (“cartoon”), registered the rights in the sketch, and then sent it to be manufactured.²²² The sketch and the mosaic both boasted a copyright notice in Dielman's name.²²³ The correspondence between the parties made no mention of the issue of copyright ownership.²²⁴ After installing the mosaic, officials acting on behalf of the Library took pictures of the mosaic and published them.²²⁵ Dielman sought an injunction.

216. *Id.* at 766–67.

217. *Id.* at 770.

218. As the court explained, if the agreement “did not assign an interest in said copyright to said firm, it is an exclusive and irrevocable license, and said firm acquired thereby an equitable interest in the copyright, which is substantially the same whether said agreement was an assignment or a license.” *Id.* at 767.

219. *Id.* at 770.

220. *Dielman v. White*, 102 F. 892 (C.C.D. Mass. 1900).

221. *Id.* at 892.

222. *Id.* at 893.

223. *Id.*

224. *Id.*

225. *Id.*

The court found for the defendants, clarifying that “[i]n general, when an artist is commissioned to execute a work of art,” the artist bears “the burden of proving that he retains a copyright in the work.”²²⁶ More importantly, the court held that there is “a very strong implication that the work of art commissioned is to belong unreservedly and without limitation to the [commissioner].”²²⁷ And that presumption appeared to hold true even though the agreement here said nothing about copyright ownership, and even though the original author had already appended a notice in his name to the painting.²²⁸

Second, courts have meaningfully relaxed the notice requirement in the context of fine art. In *American Tobacco Co. v. Werckmeister*, the Supreme Court suggested in dicta that a copyright notice was not required for an original painting.²²⁹ This allowed courts to find that artists had transferred their rights even if they had already inscribed the painting with a notice in their name, just as the plaintiff in *Dielman* did. Accordingly, a defective notice did not terminate the copyright in the work because no notice was required in the first place. In that sense, courts have remained attuned to the risk of copyright forfeiture and continued to engage in pragmatic gamesmanship to eliminate that risk.

Third, and relatedly, courts have sometimes held that creators run the risk of transferring their rights in a copyrighted work by merely selling a copy of it. In *Parton v. Prang*, an artist sold an oil painting to a private individual, who then resold it to a lithographer.²³⁰ The lithographer created and published a lithograph of the painting and registered the rights in the name of his company.²³¹ The original artist sued for copyright infringement, alleging that he did not assign his copyright in writing, as required by the statute.²³²

The court held that the original artist had conveyed his rights by selling the painting. Because the sale of the painting was “absolute and unconditional,” the artist had transferred his copyright to the purchaser.²³³ The default, then, has flipped. The court held that any sale of an original work, unless expressly qualified, implied an assignment of the copyright. The statutory requirement of a written assignment, the court said, did not apply here because the statute did not cover paintings.²³⁴

226. *Id.* at 894.

227. *Id.*

228. *Id.* at 895; see also *Yardley v. Houghton Mifflin Co.*, 108 F.2d 28, 29 (2d Cir. 1939).

229. *Am. Tobacco Co. v. Werckmeister*, 207 U.S. 284, 293–95 (1907).

230. *Parton v. Prang*, 18 F. Cas. 1273, 1273 (C.C.D. Mass. 1872) (No. 10,784).

231. *Id.* at 1273.

232. *Id.* at 1274; see also 1831 Act, *supra* note 51, § 9.

233. *Parton*, 18 F. Cas. at 1277–78.

234. *Id.* (“[T]he court is of the opinion that the word ‘manuscript,’ as used in section 9 of the copyright act, does not include a picture, and that a purchaser of a picture . . . may acquire a title to the same by an oral contract with the lawful owner . . .”).

A few of the trends discussed above were also on display in *Grant v. Kellogg*.²³⁵ An artist was hired by Kellogg to create art for a Rice Krispies advertisement.²³⁶ He created an image depicting three gnomes named Snap, Crackle, and Pop. The parties never discussed the issue of copyright ownership.²³⁷ Kellogg eventually opted to contract with another artist to create images of gnomes for the ad.²³⁸ The original artist sued for copyright infringement, claiming that his characters had been copied.²³⁹

The court concluded that the artist had no copyright in the abstract idea of cartoon gnomes.²⁴⁰ In dicta, however, the court also found that the artist had assigned to Kellogg whatever rights he might have possessed in the first place.²⁴¹ By purchasing the art, Kellogg acquired full title to the work. The artwork, the court noted, “is personal property, transferrable by sale and delivery.”²⁴² And in the absence of any evidence that the parties agreed otherwise, the court found that the artist had transferred his rights. After all, a restriction on the transfer of rights must be “expressed and clearly imposed. Otherwise it will not be presumed.”²⁴³ The plaintiff could not show that the parties agreed on any such restriction, and so the court once again upheld a copyright assignment based on a default presumption.

Nevertheless, it would be a mistake to suggest that early courts always sided with overzealous publishers or purchasers. Sometimes courts dismissed claims of implicit assignment when both parties failed to satisfy copyright formalities. A case in point is *Mifflin v. R.H. White Co.*²⁴⁴ The publishers of a magazine argued that Oliver Wendell Holmes had licensed his work, *The Professor at the Breakfast Table*, to be published by the magazine in twelve monthly installments.²⁴⁵ The first ten installments were published without a copyright notice. The last two included a notice in the magazine’s name.²⁴⁶ Holmes later published the work as a book, which included a copyright notice in his own name.²⁴⁷

235. *Grant v. Kellogg Co.*, 58 F. Supp. 48 (S.D.N.Y. 1944), *aff’d*, 154 F.2d 59 (2d Cir. 1946).

236. *Id.* at 50.

237. *Id.*

238. *Id.* at 53. The plaintiff had previously “worked to the satisfaction” of Kellogg for a period of six years. At some point, however, the relationship between the parties soured and the plaintiff brought action for copyright infringement. *Id.* at 50.

239. *Id.* at 50.

240. *Id.* at 51–52 (intimating that the artist had no claim to the larger “gnomic field of art”).

241. *Id.* at 50–51.

242. *Id.* at 51.

243. *Id.*

244. *Mifflin v. R.H. White Co.*, 190 U.S. 260 (1903).

245. *Id.* at 262.

246. *Id.* at 261.

247. *Id.*

The Supreme Court held that the copyright in the work was void. The initial publication of the first ten installments without registration or notice vitiated any rights in the work.²⁴⁸ Subsequent registration of the last chapters was insufficient.²⁴⁹ In dicta, the Court also found that the magazine registration was in the wrong name: Holmes did not assign his copyrights to the magazine.²⁵⁰ Admittedly, the Court was sympathetic to the idea that authors might assign their rights implicitly. It acknowledged that “it might, perhaps, be inferred that the author of a book who places it in the hands of publishers for publication, might be presumed to intend to authorize them to obtain a copyright in their own names.”²⁵¹ Still, because Holmes himself later registered the rights in his own name, the Court reasoned that it was “apparent that there was no [intent to assign the rights] in this case.”²⁵²

Evidence of conflicting registration, then, weighed against an inference of implicit assignment. In this case, however, that was almost beside the point. The question of assignment was ultimately inconsequential. The Court saw no way out of the mire. The initial publication surrendered the copyrights to the public, and neither party had satisfied the necessary formalities.²⁵³ So there was little sense in finding an implicit assignment here — it would have benefited no one.

As this discussion demonstrates, courts of the nineteenth and early twentieth centuries sometimes declined to uphold claims of assignment, especially when doing so would not have allowed the parties to avoid forfeiture. At the same time, in cases where issues of procedural compliance turned out to be pivotal, judges were far more inclined to find an implicit assignment. They did so out of a desire to prevent forfeiture at the hands of noncompliant authors. And these cases were not entirely exceptional. The following Section tracks a concurrent line of cases that arrived at a similar result by invoking different doctrinal devices: equitable principles of constructive ownership.

B. Equitable Ownership

Beginning in the mid-nineteenth century, courts increasingly relied on doctrines of equitable ownership to resolve complex copyright disputes. Most prominently, these doctrines came to the fore in *Lawrence*

248. *Id.* at 263–64.

249. *Id.* at 263.

250. *Id.* at 262–63.

251. *Id.* at 263.

252. *Id.*

253. Holmes himself, after all, did not register the rights until after the first ten installments had already been published by the magazine. *Id.* The duty to register the rights and deposit a copy of the work, though, arose “before publication.” 1831 Act, *supra* note 51, § 4. This means that Holmes, too, failed to satisfy the required procedure.

v. Dana.²⁵⁴ Henry Wheaton authored a treatise on international law.²⁵⁵ After Wheaton's death, his wife Catharine petitioned his friend, W.B. Lawrence, to edit a new edition of the treatise; Lawrence agreed.²⁵⁶ The new edition was published in 1855,²⁵⁷ and the rights were registered in Catharine's name.²⁵⁸ Another edition was later prepared by Lawrence; the copyrights were again registered in Catharine's name.²⁵⁹ After Catharine died, her daughter chose to enlist a renowned author and lawyer named Richard Henry Dana to prepare a new edition.²⁶⁰

Lawrence sued for copyright infringement, alleging that Dana's new edition reproduced some of his contributions to the earlier edition.²⁶¹ As Lawrence pointed out, he had edited the previous editions for free, and the parties agreed Catharine would be the formal copyright owner but would not use his contributions in future editions without his written consent.²⁶² The parties also agreed, in a written memorandum, that Lawrence could use his notes in any way he saw fit.²⁶³ The defendants, however, claimed that the memorandum was inoperative on the ground that the copyrights were void: Lawrence did not assign his copyright to Catharine in writing, and so the registration and notice in Catharine's name were defective.²⁶⁴

Remarkably, the court found that no assignment was necessary. Catharine would "not [have] acquire[d] any thing by an assignment from the contributor,"²⁶⁵ the court held, because Lawrence's copyright simply vested in her.²⁶⁶ Although she had neither created the work nor obtained an assignment, Catharine was deemed the copyright owner.

Others have struggled to make sense of *Lawrence*.²⁶⁷ And while the picture remains deeply befogged, a number of factors help explain the court's decision. First, since Catharine did not obtain a written assignment, the validity of her registration was in doubt. The court thus felt compelled to find that an assignment was not necessary. In explaining why the arrangement between Catharine and Lawrence was valid, the court clarified:

254. *Lawrence v. Dana*, 15 F. Cas. 26 (C.C.D. Mass. 1869) (No. 8,136).

255. HENRY WHEATON, *ELEMENTS OF INTERNATIONAL LAW* (1st ed. 1836).

256. *Lawrence*, 15 F. Cas. at 29.

257. HENRY WHEATON & WILLIAM BEACH LAWRENCE, *ELEMENTS OF INTERNATIONAL LAW* (6th ed. 1855).

258. *Lawrence*, 15 F. Cas. at 29.

259. *Id.*

260. *Id.* at 30–31.

261. *Id.* at 29.

262. *Id.* at 45.

263. *Id.*

264. *Id.* at 50.

265. *Id.* at 51.

266. *Id.*

267. See, e.g., Litman, *supra* note 79, at 728 (noting that the court "rescued" the copyright by finding that it "magically" vested in Catharine).

Beyond controversy, [Catharine] took [the copyright] out by the consent of the complainant . . . [I]t is not perceived that there is any legal difficulty in upholding such a contract where, as in this case, it violates the rights of no one, and is entirely consistent with the public right . . . Having been entered into in good faith, and with a full knowledge of all the facts, it was not void; and neither the representative of the proprietor of the book, nor any other person having notice of the same, is at liberty to repudiate it, as it appears that it was knowingly acted upon in a way that the complainant would suffer serious pecuniary injury to allow it to be disproved.²⁶⁸

The premise here is clear: If the copyright or the memorandum were void, Lawrence himself would suffer “serious pecuniary injury.” For that reason, the court was determined to prevent forfeiture.

Second, the court looked to the circumstances attending Lawrence’s actions. Lawrence was a friend of Catharine’s late husband.²⁶⁹ He offered his services for free.²⁷⁰ He agreed to have the copyrights recorded in Catharine’s name. And he was aware that Catharine had been “[l]eft in moderate circumstances” in the wake of her husband’s death.²⁷¹ The court took pains to note that, in light of these circumstances, Lawrence must have agreed that his rights would vest in Catharine. Indeed, that was “necessarily implied by the terms of the arrangement.”²⁷²

Further, to support its conclusion that the contributions of Lawrence somehow “became the property of the proprietor of the book,”²⁷³ the *Lawrence* court cited a number of English cases.²⁷⁴ And while the court referenced some conflicting authorities on the question of whether a written assignment was required,²⁷⁵ it concluded that “an equitable title may vest in one person to the labors of another, where the relations of the parties are such that the former is entitled to an assignment of the production.”²⁷⁶

This excerpt suggests that the relationship between the parties was somewhat analogous to an employment relationship, where the

268. *Lawrence v. Dana*, 15 F. Cas. 26, 54 (C.C.D. Mass. 1869) (No. 8,136).

269. *Id.* at 50 (describing Lawrence as an “intimate friend” of the family).

270. *Id.* at 51.

271. *Id.* at 50.

272. *Id.* at 51.

273. *Id.*

274. *Id.*

275. *Id.* (“Certain remarks are found in the opinion of the court in the case of *Pierpont v. Fowle* [Case No. 11,152], apparently inconsistent with the views here expressed . . .”).

276. *Id.*

employer is “entitled to an assignment of the production” of the employee. The modern work-for-hire doctrine controls similar circumstances. It recognizes the employer as the owner of a work prepared by an employee within the scope of his or her employment.²⁷⁷ It is plausible, then, that the court understood Lawrence’s book to reflect a work made for hire. At the time *Lawrence* was decided, however, courts had not yet fully embraced the work made for hire doctrine.²⁷⁸ The court thus had to chart a different path.

Having found that Lawrence’s rights vested in Catharine by virtue of their relationship, the court then reasoned that Lawrence was an equitable owner of the copyright in his notations.²⁷⁹ Catharine, the court emphasized, was holding the copyrights in trust for the benefit of Lawrence.²⁸⁰ The upshot was that Catharine was the formal copyright owner — holding the rights as a trustee — while Lawrence was the equitable owner.

The court’s muddled holding can be explained as an exercise in aggressive pragmatism. The court held that the author’s rights vested in another, that the latter was acting as a trustee of the former, and that the original author was thus an equitable owner. In doing so, the court was guided by ideas of equity and policy. And it was willing to overlook the factual record to reach this outcome. More specifically, the court was well-aware that Lawrence had acted out of a sense of companionship in agreeing to deliver his services, free of charge, to the widow of a deceased friend. Lawrence then permitted Catharine to register the rights in her own name. In other words, Lawrence was no villain. Neither was Catharine. In these circumstances, the court attempted to walk a fine line. To prevent copyright forfeiture, it found that the copyrights vested in Catharine. And to protect the interests of Lawrence, the court recognized that he was an equitable owner of the rights in his notes.²⁸¹ Once again, pragmatism won the day.

The court’s reasoning here extends beyond issues of copyright assignment. It found that both parties were copyright owners; one was the formal owner, the other an equitable owner. That meant, by implication, that Catharine’s descendants were entitled to use the work on the condition they paid Lawrence.

277. 17 U.S.C. § 201(b).

278. See Litman, *supra* note 79, at 728 n.66.

279. *Lawrence*, 15 F. Cas. at 54 (“[T]he court is of the opinion that the complainant . . . is the equitable owner of the notes . . . and of the copyrights taken out by the proprietor of the book for the protection of the property, including the equitable ownership of the complainant.”).

280. *Id.*

281. Interestingly, in a separate section of the opinion, the court expressly rejected an argument that the doctrine of estoppel should prevent Lawrence from relying on the memorandum. *Id.* at 48. On the facts of the case, that is hardly surprising: Lawrence did not misrepresent the nature of the memorandum, and thus could not be estopped from relying on it. *Id.* at 48–49.

This approach found favor with other courts. In *Little v. Gould*, the court reporter for the State of New York sought an injunction to prevent the defendants from publishing copies of the reports he had edited.²⁸² But the reporter faced a hurdle. The state enacted a law in 1848 to divest court reporters from whatever copyrights they might have held in their reports.²⁸³ Consistent with that law, the reporter assigned his rights in writing to the New York Secretary of State, expressly recognizing that the copyrights would be registered in the name of the state.²⁸⁴ The Secretary later registered the rights in his own name.²⁸⁵

The court upheld the transfer of rights from the reporter to the Secretary of State.²⁸⁶ Tellingly, the court also concluded that the Secretary was holding the copyrights “in trust for the benefit of the state.”²⁸⁷ This proposition may seem innocuous. The Secretary was acting in an official capacity. And he was party to an agreement explicitly providing that the rights would be registered for the benefit of the state. So, in a sense, the court simply stated the obvious — the Secretary held the copyrights on behalf of the state.

Particularly notable, however, was the court’s recognition of equitable interests in the copyrighted work. As the court put it, “[w]hether a third person has an equitable interest in the work, derived from the author or from the legal assignment, is a question between those parties The courts will take care of those equitable interests.”²⁸⁸ The idea here was that the Secretary of State remained the formal owner of the copyright, while the State of New York held an equitable interest in the work. Considered in context, this decision reveals a fundamentally pragmatic impulse. In effect, the court harnessed the distinction between equitable and formal ownership — later deployed by *Lawrence v. Dana* — to ensure that the rights were held in equity by the state.²⁸⁹

A number of other cases centered on a similar distinction between formal and equitable owners. Consider, for example, *Fitch v. Young*.²⁹⁰ The playwright Clyde Fitch assigned the copyright in his play to a

282. *Little v. Gould*, 15 F. Cas. 612, 612 (C.C.N.D.N.Y. 1852) (No. 8,395).

283. *Id.* at 612–13. The state law provided that “[i]t shall not be lawful for the reporter, or any other person within this state, to secure or obtain any copyright for said reports of the judicial decisions of the court of appeals, but the same may be published by any person.” *Id.* at 613.

284. *Id.* at 613.

285. *Id.*

286. *Id.* (noting that, according to the agreement, “the interest of the reporter in [his reports] . . . passed to the secretary of state”).

287. *Id.*

288. *Id.*

289. So understood, the court’s decision gave effect to the relevant state law. Although the law did not explicitly reference notions of equity, it specified that “[t]he copyright of any notes or references made by the state reporter to any of said reports shall be vested in the secretary of state, for the benefit of the people of this state.” *Id.*

290. *Fitch v. Young*, 230 F. 743 (S.D.N.Y. 1916), *aff’d*, 239 F. 1021 (2d Cir. 1917).

publisher.²⁹¹ The publisher released the play in book form; it registered the rights in its own name and appended a copyright notice specifying that the dramatic rights in the play were reserved to Fitch.²⁹² A year later, the publisher assigned the rights back to Fitch.²⁹³ The assignment agreement provided that the publisher nevertheless retains the sole and exclusive right to publish the work.²⁹⁴

Fitch brought suit against a magazine for publishing a short story that allegedly infringed his rights in the play.²⁹⁵ The magazine retorted that the copyright in the play was invalid: Because Fitch reserved his dramatic rights, he never fully assigned the copyright to the publisher.²⁹⁶ The magazine thus claimed that the registration in the publisher's name was defective.²⁹⁷

The court held that, while dramatic rights are distinct from statutory copyrights, both were protected under the statute and subject to compliance with a single set of formalities.²⁹⁸ The court then concluded that the publisher was the formal owner of the dramatic rights, holding them in trust for Fitch.²⁹⁹ In reality, Fitch did not register the dramatic rights, and the publisher expressly disclaimed these rights in its copyright notice.³⁰⁰ Even so, the court was determined to ensure that Fitch's dramatic rights were protected. So it invoked the distinction between formal and equitable ownership to find that the registration in the publisher's name was sufficient to protect both sets of rights. The resulting scheme was rather strained: The publisher was classified as the formal proprietor of the dramatic rights it had expressly disclaimed.

This decision meshes neatly with the observations discussed above. The court conjured up an image of equitable ownership. It asserted that the publisher was the formal owner of the rights, holding them in trust for the original author. In doing so, the court again managed to narrowly prevent copyright termination.

Another influential case tackling questions of equity is *Dam v. Kirk La Shelle Co.*³⁰¹ Henry Dam wrote a story titled *The Transmogrification of Dan*. A magazine paid eighty-five dollars to purchase the story from Dam.³⁰² The story was published a few months later, bearing a copyright notice in the name of the magazine's publisher.³⁰³ The

291. *Id.* at 743.

292. *Id.* at 743–44.

293. *Id.* at 744.

294. *Id.*

295. *Id.* at 743.

296. *Id.* at 744.

297. *Id.*

298. *Id.*

299. *Id.*

300. *Id.* at 743–44.

301. *Dam v. Kirk La Shelle Co.*, 175 F. 902 (2d Cir. 1910).

302. *Id.* at 903.

303. *Id.*

publisher registered the copyright in the entire issue.³⁰⁴ Neither Dam nor the publisher took any steps to separately register the copyright in the story itself.³⁰⁵ A few years later, Dam brought action against the producers of a theatrical play, *The Heir to the Hoorah*, asserting an infringement of his rights in the short story.³⁰⁶ He claimed that he had not assigned his copyright in the story to the magazine's publisher; instead, Dam claimed to have merely granted the publisher a limited license to publish the story.³⁰⁷ He further asserted, echoing *Lawrence v. Dana*, that the publisher formally held the right to dramatize the story "as trustee for his benefit."³⁰⁸

The court was unimpressed. It held that the publisher had acquired a valid copyright in Dam's story.³⁰⁹ In agreeing to sell his story to the magazine, Dam made no reservations about retaining his rights.³¹⁰ The court thus refused to "read words of limitation into a transfer which the parties do not choose to use."³¹¹ And the court's reasoning was plainly driven, again, by concerns about copyright forfeiture. The court recognized that, if Dam were the owner of the copyrights in the story, the notice in the magazine's name would be defective and the work would fall into the public domain.³¹² To avoid that outcome, the court had to uphold the transfer of rights from Dam to the magazine.³¹³

Principles of equity also figured prominently in *Maurel v. Smith*.³¹⁴ The plaintiff, Fred de Gresac Maurel, authored an opera titled *The White Swan*. She collaborated with three co-contributors to write the libretto, lyrics, and music for the opera.³¹⁵ According to the contract between the parties, Maurel retained the publishing rights in the work.³¹⁶ One of the co-contributors then registered the copyright in his

304. *Id.*

305. *Id.*

306. *Id.*

307. *Id.*

308. *Id.*

309. *Id.* at 904.

310. *Id.*

311. *Id.*

312. *Id.* at 905–06.

313. *Id.* at 906. Curiously, at some point, the magazine had assigned the rights back to Dam. *Id.* at 903. It is unclear why Dam claimed that the magazine never held the copyrights in the first place; if that were true, the notice in the magazine's name would be defective and, consequently, the work would have fallen into the public domain. Indeed, the court implies that Dam's estate eventually attempted to walk back these claims. *See id.* at 904 (noting that Dam's initial claims might have been "contrary to his later claims or against his interest").

314. *Maurel v. Smith*, 220 F. 195 (S.D.N.Y. 1915), *aff'd*, 271 F. 211 (2d Cir. 1921). The district court's decision, authored by Judge Learned Hand and subsequently affirmed by the Second Circuit, was the first to recognize the then-novel doctrine of joint authorship. *See* Therese M. Brady, *Manifest Intent and Copyrightability: The Destiny of Joint Authorship*, 17 *FORDHAM URB. L.J.* 257, 260 (1989) (noting that in *Maurel v. Smith*, Judge Hand "adopted the first American definition of joint authorship").

315. *Maurel v. Smith*, 271 F. 211, 211–12 (2d Cir. 1921).

316. *Id.* at 212.

own name, although his application named Maurel and the other contributors as coauthors of the work.³¹⁷ The Second Circuit concluded that each of the co-contributors had an equal share in the copyrights, with the registrant holding the rights as a trustee on behalf of the other co-contributors.³¹⁸ Put another way, the copyright in the work was “deemed to have been taken out in the name of one as a trustee for all the true owners.”³¹⁹

Given the clear evidence, in writing, that Maurel retained the copyright in the work, it was virtually impossible for the court here to tell a story about the rights having been magically assigned to the registrant. And yet, like some of the other cases discussed above, the court was able to prevent copyright termination by relying on the principle of equitable ownership.³²⁰ In that way, the registration was held valid even though it did not properly identify all of the relevant authors. In addition, as a practical matter, the *Maurel* court set up an ex-post licensing scheme of sorts — in exchange for publishing the opera, the other co-authors were required to pay Maurel.³²¹

In sum, arguments sounding in equitable ownership were ubiquitous throughout the nineteenth and early twentieth centuries. And although these arguments occasionally failed, early courts were often prepared to entertain a distinction between equitable and formal owners. That distinction quickly gained traction. Eaton Drone, the author of a then-influential copyright treatise, reported that “[a] person who is not the author or owner of a work may take out the copyright in his own name, and hold it in trust for the rightful owner.”³²² That principle has allowed courts to find that the copyright was registered in the name of the formal trustee, thus eliminating the risk of forfeiture on procedural grounds.

As this Part demonstrates, courts sought to short-circuit copyright’s procedural scheme in one of two ways. First, in a significant subset of cases, courts held that a noncompliant author had implicitly assigned the copyright to a compliant publisher. Because the compliant publisher met all of the mandatory conditions, the author’s failure to do so was rendered irrelevant. Over time, though, courts expanded the doctrine of implicit assignment to reach cases that had little to do with issues of procedural compliance. They did so by developing a presumption of

317. *Id.* at 212–13.

318. *Id.* at 215–16.

319. *Id.* at 215.

320. As in other cases, the court here invoked the doctrine of constructive trust to prop up an equitable ownership scheme — one aimed at recognizing both formal and equitable owners.

321. *See id.* at 216 (mandating an “accounting . . . of any profits which [the defendant] may have received from the statutory copyrights”).

322. EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 260 (1879).

default assignment in circumstances where an author sold and delivered a physical copy of her work.

Second, some courts resorted to an alternative tool — the doctrine of constructive ownership — to temper the risk of forfeiture. In a series of early cases, courts held that a compliant party, such as a publisher or some other party that happened to register the rights, was the formal owner of the copyright. At the same time, however, courts insisted that the original author remained the equitable owner of the rights despite having failed to comply with formalities. This nifty distinction between formal and equitable owners allowed courts to make an end-run around copyright formalities. When an author did not comply with formalities but someone else did, these courts simply found that the compliant party was, in some limited sense, the formal owner, while the noncompliant author nonetheless retained her ownership interest as a matter of equity. This was, in other words, a legal fiction fueled by principles of equity.

V. LESSONS

The dust-up over copyright ownership during the nineteenth century is informative for a number of reasons. First, it reveals a pragmatic strain of early copyright jurisprudence. Courts bent over backward to find that authors had implicitly assigned their copyright to someone else — typically, the publisher — in circumstances where the publisher, but not the author, had complied with the necessary formalities. These gymnastics enabled courts to ward off the risk of forfeiture. Second, the preceding discussion underscores the prominence of equity in nineteenth-century caselaw. Bent on resolving complex disputes involving multiple parties, courts relied on doctrines of equity to reach results they thought to be just — and they often did so by casting the original author as an equitable owner or as an assignor of the copyrights.

What are we to make of this account of copyright's procedural pragmatism? This Part works through its implications. The first Section offers a normative assessment of the trends discussed above. Modern commentators would likely take issue with the courts' reluctance to invalidate copyright for failure to satisfy formalities. Nonetheless, I argue that the courts' procedural pragmatism was normatively defensible at a time when our copyright system was fairly weak but the costs of publishing were high. The subsequent Section, however, criticizes some of the more fraught developments that later dogged copyright's ownership jurisprudence. Originally concerned with the practical needs of mid-nineteenth-century authors, courts later lost sight of that impulse and increasingly began to uphold copyright assignments even when doing so was not necessary to protect the author's copyright. In short, what

was initially a rather sensible policy eventually mutated into an anti-author doctrine that was decoupled from its origins. This process of doctrinal drift, I argue, is cause for concern.

The third Section considers more carefully the rhetoric and facts underlying early disputes over issues of procedural noncompliance. In particular, I argue that many of the cases discussed here reflect principles of implied permission, not actual assignment. Of course, it is no surprise that courts spoke in the register of copyright ownership — they felt like they had to. They couldn't just say that the author implicitly authorized use of her work by the publisher — if that were the case, the copyright would be lost since the author failed to meet the statutory requirements. Instead, courts had to figure out a way to find that the author, having failed to register the rights, is not the formal copyright holder at all. Doctrines of assignment and equitable ownership therefore offered a path out of the morass: By reframing cases of implied permission as incidents of copyright assignment, courts could counteract the risk of forfeiture.

A. Normative Assessment

Below I explain why a markedly pragmatic approach — one that sought to hem in the risk of forfeiture — made sense as a matter of sound policy. To be clear, though, I do not mean to suggest here that early cases were particularly elegant. My assessment of the caselaw is far from rosy. Courts often papered over the factual record. They ginned up property-like schemes that the parties themselves had not considered. And they worked around statutory directives. Yet although these doctrinal maneuvers were somewhat unrefined, they reflected a sensible, pragmatic impulse.

To understand why, it would be helpful to briefly examine the state of American copyright law. Since its inception, copyright law has expanded steadily and dramatically. In 1790, the copyright statute protected only a limited panoply of creative works: maps, charts, and books.³²³ Today, however, authors possess exclusive rights covering a wide array of works that were previously beyond the ambit of copyright law, like musical compositions, sound recordings, audiovisual works, pantomimes, and architectural works.³²⁴ Further, copyright owners today wield sweeping rights that not only guard against precise reproduction, but also prevent partial copying, adaptation, and public performance or display of certain works.³²⁵ Copyright duration has also increased many times over. With few exceptions, copyright today

323. 1790 Act, *supra* note 8, § 1.

324. 17 U.S.C. § 102(a) (specifying a non-exhaustive list of protected works).

325. 17 U.S.C. § 106 (defining copyright's exclusive rights).

expires seventy years after the death of the author³²⁶ — a stunning departure from copyright’s original scheme, where creative works were shielded for a mere fourteen years from the day of publication (with the possibility of an additional fourteen years if the author was alive at the end of the initial term).³²⁷ In short, copyright owners now have more rights, these rights cover more ground, and they last longer. And while these developments have not been entirely one-directional,³²⁸ it is safe to say that, on the whole, copyright has expanded measurably in both substance and application. And that is a problem.

Properly understood, copyright law seeks to accommodate two conflicting interests. On the one hand, the law purports to incentivize authors to invest in producing creative works. It does so by granting authors a bundle of time-limited exclusive rights in their works.³²⁹ On the other hand, the ultimate goal of our copyright system is not to generate the “largest incentive possible” for creators but rather to provide an “*optimal* incentive” that would allow intellectual works to eventually enter the public domain.³³⁰

In practice, copyright law fails to strike a balance between these dueling interests. Scholars widely agree that our copyright system is overbroad.³³¹ To put it bluntly, the law is too protective of copyright owners — to the detriment of society at large.³³²

326. 17 U.S.C. § 302(a).

327. 1790 Act, *supra* note 8, § 1. Throughout the years, Congress repeatedly extended the copyright term. In 1831, the copyright term was extended to forty-two years. 1831 Act, *supra* note 51, §§ 1–2, 16. In 1909, Congress extended the duration of copyright protection to fifty-six years. 1909 Act, *supra* note 54, § 23. And, throughout the second half of the twentieth century, Congress seemed hellbent on expanding the copyright term — even for preexisting works — with increasing frequency. No fewer than eleven times in the last few decades did Congress lengthen the copyright term. See Lawrence Lessig, *The Creative Commons*, 65 MONT. L. REV. 1, 5 (2004).

328. In some respects, courts in recent decades have strengthened the primary defense against copyright infringement — the fair use doctrine. See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (holding that a parody may be legally permissible under the fair use doctrine); *Google L.L.C. v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1209 (2021) (holding that Google’s copying of a portion of Oracle’s API code was fair use).

329. See Pamela Samuelson, *Should Economics Play a Role in Copyright Law and Policy?*, 1 U. OTTAWA L. & TECH. J. 1, 3–4 (2004).

330. Mark A. Lemley, *Beyond Preemption: The Law and Policy of Intellectual Property Licensing*, 87 CALIF. L. REV. 111, 125 (1999); see also Shani Shisha, *Fairness, Copyright, and Video Games: Hate the Game, Not the Player*, 31 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 694, 774–75 (2021).

331. See generally NEIL WEINSTOCK NETANEL, COPYRIGHT’S PARADOX 54–80 (2008); LITMAN, *supra* note 5, at 77–78; LAWRENCE LESSIG, FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY (2004).

332. See, e.g., James Boyle, *The Second Enclosure Movement and the Construction of the Public Domain*, 66 LAW & CONTEMP. PROBS. 33, 38–40 (2003); Pamela Samuelson, *Intellectual Property and the Digital Economy: Why the Anti-Circumvention Regulations Need to Be Revised*, 14 BERKELEY TECH. L.J. 519, 537–46 (1999); Epstein, *supra* note 5, at 127–28; Pamela Samuelson, *The Copyright Grab*, WIRED (Jan. 1, 1996), <https://www.wired.com/1996/01/white-paper/> [<https://perma.cc/LLB3-PXGA>].

At fault for copyright's expansion are a number of interconnected forces. One is a longstanding campaign by industry groups, representing the interests of copyright owners, to further entrench and expand an already-skewed copyright system that privileges the rights of copyright owners at the expense of the public domain.³³³ A prime example is the Copyright Term Extension Act ("CTEA") of 1998, which extended the duration of copyright protection by an additional twenty years.³³⁴ The CTEA was enacted under significant pressure from Disney lobbyists, who pushed for an extension of the copyright term to prevent Disney's precious intellectual works, such as Mickey Mouse, from falling into the public domain.³³⁵ More recently, copyright holders cajoled Congress into establishing a small claims tribunal that would make copyright enforcement faster and cheaper while dispensing with many of the procedural safeguards that govern federal litigation.³³⁶ Indeed, much of the expansionist program that has engulfed our copyright regime is the product of unrelenting pressure from interest groups.

The judiciary also shares some of the blame for copyright's growth. Consider, for example, the courts' ever-expanding definition of a copyrighted work. Initially, the copyright statute was understood to protect only against near-literal copying. That is why a federal court in 1853 rejected the claim that a translation of a book constitutes unauthorized

333. See Robert Patrick Merges & Glenn Harlan Reynolds, *The Proper Scope of the Copyright and Patent Power*, 37 HARV. J. ON LEGIS. 45, 53–54 (2000).

334. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998).

335. Matthew Rimmer explains that "[t]he Sonny Bono Copyright Term Extension Act 1998 (U.S.) was literally a 'Mickey Mouse Bill'. The 1998 statute was the result of intense lobbying by a group of powerful corporate copyright holders, most visibly the Walt Disney Company, which faced the imminent expiration of copyrights on Mickey Mouse and its other famous cartoon characters." Matthew Rimmer, *The Dead Poets Society: The Copyright Term and the Public Domain*, 8 FIRST MONDAY (2003), <https://journals.uic.edu/ojs/index.php/fm/article/view/1059/979> [<https://perma.cc/9BL6-SH5S>]; see also Chris Sprigman, *The Mouse That Ate the Public Domain: Disney, the Copyright Term Extension Act and Eldred v. Ashcroft*, FINDLAW (Mar. 5, 2002), <https://supreme.findlaw.com/legal-commentary/the-mouse-that-ate-the-public-domain.html> [<https://perma.cc/FZ5B-4JR9>] ("Rather than allow Mickey and friends to enter the public domain, Disney and its friends — a group of Hollywood studios, music labels, and PACs representing content owners — told Congress that they wanted an extension bill passed."); Paul M. Schwartz & William Michael Treanor, Eldred and Lochner: *Copyright Term Extension and Intellectual Property as Constitutional Property*, 112 YALE L.J. 2331, 2338 (2003) ("Disney has been among the most aggressive advocates of expanded copyright protection."); Christopher Buccafusco & Paul J. Heald, *Do Bad Things Happen When Works Enter the Public Domain?: Empirical Tests of Copyright Term Extension*, 28 BERKELEY TECH. L.J. 1, 7 (2013) (footnotes omitted) ("The intense, well-documented lobbying efforts of Disney and other copyright owners resulted in the passage by voice vote of the CTEA.").

336. See Copyright Alternative in Small-Claims Enforcement Act of 2020, Pub. L. No. 116–260, 134 Stat. 2176 (2020). For critiques of the CASE Act, see Ben Depoorter, *If You Build It, They Will Come: The Promises and Pitfalls of a Copyright Small Claims Process*, 33 BERKELEY TECH. L.J. 711 (2018), and Pamela Samuelson & Kathryn Hashimoto, *Scholarly Concerns About a Proposed Copyright Small Claims Tribunal*, 33 BERKELEY TECH. L.J. 689 (2018).

reproduction. “A translation,” the court pronounced, “may, in loose phraseology, be called a transcript or copy of [the author’s] thoughts or conceptions, but in no correct sense can it be called a copy of [the author’s] book.”³³⁷

Nevertheless, courts gradually came to embrace the view that non-literal copying of small fragments of the work can constitute copyright infringement.³³⁸ In one case, a federal court held that a one-minute portion lifted from an hour-long movie qualified as an actionable copy.³³⁹ Today, “because courts look for copies everywhere, they see copies everywhere.”³⁴⁰ And, consequently, they increasingly find “that every appearance of any part of a work anywhere should be deemed a ‘copy’ of it, and that every single copy needs a license or excuse.”³⁴¹

Another example is the protection of fictional characters. In recent decades, courts have routinely held that characters can be protected separately from the underlying works in which they are embedded. Courts have found that Mickey Mouse,³⁴² Superman,³⁴³ James Bond,³⁴⁴ Rocky Balboa,³⁴⁵ and even objects such as the Batmobile³⁴⁶ can be protected as distinct characters. In protecting characters, courts have signaled a growing willingness to split up copyrighted works into smaller (protectable) sub-works.³⁴⁷ The result is an increase in the reach of

337. *Stowe v. Thomas*, 23 F. Cas. 201, 208 (C.C.E.D. Pa. 1853) (No. 13,514). The court’s language suggests that its holding was broadly applicable to other derivative works as well, including sequels: “All [of the plaintiff’s] conceptions and inventions may be used and abused by imitators, play-rights, and poetasters. []They are no longer her own — those who have purchased her book, may clothe them in English doggerel, in German or Chinese prose.” *Id.* The court therefore reasoned that the book could also be adapted into a play, a sequel, or a “doggerel.”

338. Traditionally, “the core of copyright was seen as the right to reproduce in print an exact copy of a text.” Oren Bracha, *Not De Minimis: (Improper) Appropriation in Copyright*, 68 AM. U. L. REV. 139, 170 (2018). Eventually, however, copyright law grew to encompass fragmented reproduction as well. The shift was driven at first by statutory amendments that extended copyright protection to various derivative works. *Id.* at 171. Courts then “gradually restated the infringement test and began to apply it in a way that captured increasingly abstract levels of expressive similarity, previously seen as outside copyright’s ambit.” *Id.*

339. *Roy Exp. Co. v. Columbia Broad. Sys. Inc.*, 503 F. Supp. 1137, 1145 (S.D.N.Y. 1980), *aff’d*, 672 F.2d 1095 (2d Cir. 1982).

340. Shani Shisha, *The Copyright Wasteland*, 47 BYU L. REV. 1721, 1769 (2022) (arguing, based on Jessica Litman’s work, that courts have been too quick to find actionable copies where none exist).

341. Jessica Litman, *Fetishizing Copies*, in COPYRIGHT LAW IN AN AGE OF LIMITATIONS AND EXCEPTIONS 107, 109 (Ruth L. Okediji ed., 2017).

342. *Walt Disney Prods. v. Air Pirates*, 345 F. Supp. 108, 116 (N.D. Cal. 1972), *aff’d*, 581 F.2d 751, 755 n.11 (9th Cir. 1978).

343. *Warner Bros. v. Am. Broad. Cos.*, 530 F. Supp. 1187, 1193 (S.D.N.Y. 1982), *aff’d*, 720 F.2d 231, 242 (2d Cir. 1983).

344. *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1296 (C.D. Cal. 1995).

345. *Anderson v. Stallone*, No. 87-0592, 1989 WL 206431, at *7 (C.D. Cal. Apr. 25, 1989).

346. *DC Comics v. Towle*, 802 F.3d 1012, 1021–22 (9th Cir. 2015).

347. See Michael Deamer, DC Comics v. Towle: *Protecting Fictional Characters Through Stewardship*, 32 BERKELEY TECH. L.J. 437, 455 (2017).

copyright law, especially in instances where tiny fragments of a work are used. In this context, too, courts tend to champion a robust conception of copyright.

Accordingly, it would be tempting to view the jurisprudence described here as yet another instance of judicial deference to the interests of copyright owners. In refusing to invalidate copyrights when authors failed to comply with formalities, courts have once again dealt a blow to the public domain. Rather than allow creative goods to enter the public domain, courts took an approach that was almost singularly calculated to prevent copyright protection from lapsing. In this sense, the strand of aggressive pragmatism sketched above could be viewed as a species of copyright protectionism. Courts were beholden to the interests of copyright holders, and consistently failed to consider the broader interest in maintaining a voluminous public domain.

Indeed, it is quite astonishing that in virtually all of the cases reviewed in the preceding Section, courts trained their energies on the interests of two parties alone — the author and the publisher. Entirely absent from the discussion was an equally important group of stakeholders: members of the public. The broader interest in ensuring public access to intellectual works drew little attention. Evaluated in this light, the courts' pragmatic streak seems troublesome.

Yet this view is partly misplaced. At least initially, cases that sought to avoid forfeiture on procedural grounds made sense as a matter of policy. It is true that copyright law has grown dramatically. But it is also true that these cases sprang from the cultural and economic landscape of the nineteenth century, a world that looked very different than the one we inhabit today. Three key differences stand out.

First, because these cases dealt not with substance but rather with procedure, courts thought little of copyright's incentive-access balance. From 1790 to the late twentieth century, copyright formalities played a central role in our federal copyright system.³⁴⁸ It is thus easy to understand why courts were so cavalier in their attempts to get around (what they perceived to be) picayune procedural requirements. It would be one thing to extend copyright protection to creative works that were never meant to be covered by the copyright statute — think, for example, of works that consist entirely of public-domain materials.³⁴⁹ Doing so would disrupt copyright's underlying balance by extending protection to a type of intellectual good that was supposed to remain in the public domain. But it is another thing altogether to recognize copyright interests in works that were always meant to fall within the reach of the copyright statute (if only their proprietor would meet certain procedural

348. *See supra* Part II.

349. A new edition of a public-domain book, for instance, would not qualify for copyright protection.

requirements). Put differently, because these cases dealt with technical procedure rather than substance, they did not bear directly on copyright's substantive balance between incentives and access.

Of course, that is not to say that copyright procedure never played a role in maintaining that balance. As discussed above, some formalities, especially the renewal requirement, had the practical effect of weeding out low-value works,³⁵⁰ thus enriching the public domain.³⁵¹ Consider a scenario where an author registers the rights in her book and publishes it. The book sparks little public interest, and few copies are ever sold. When it is time to renew the rights,³⁵² the author determines it is not worth the trouble — there is no point in renewing the copyright if the book failed to generate profits. That standard story might explain why, historically, eighty-five percent of all rights were not renewed.³⁵³ The net effect is that the renewal requirement facilitated a richer public domain by screening out a significant number of intellectual works.

Even so, most of the cases discussed here do not implicate a deliberate decision by the copyright owner to relinquish protection. Rather, they typically involve ignorance; namely, instances where the author was not fully informed about the procedural requirements preceding copyright protection. So these are *not* cases in which the proprietor made a conscious decision, based on market sales, to permit a low-value work to pass into the public domain. Quite the contrary. The parties involved — the author or the publisher — typically sought to prevent copyright protection from lapsing. In these cases, one can readily understand why judges felt at ease with the prospect of circumventing copyright formalities.

A second factor that could explain why courts engaged in aggressive pragmatism is the state of copyright law in the nineteenth century. Copyright law has consistently trended toward expansion, and our current system is overbroad and overinclusive. But in the mid-nineteenth century, copyright protection was considerably more circumscribed. It

350. By “low-value works,” I mean works that carry little market value; that is, works that did not sell. My use of the label “value” does not refer to the artistic merit or aesthetic quality of the work.

351. Sprigman, *supra* note 5, at 519–21.

352. Under the 1790 Act, the initial term of copyright protection expired after fourteen years. 1790 Act, *supra* note 8, § 1. The 1831 Act extended the initial term to twenty-eight years. 1831 Act, *supra* note 51, §§ 1, 16.

353. Sprigman, *supra* note 5, at 519–21.

did not yet reach derivative works.³⁵⁴ It expired sooner.³⁵⁵ And it depended on compliance with procedural formalities.³⁵⁶ In short, our copyright regime was not as lopsided as it is today.

Early authors also faced another hurdle: distribution. In the nineteenth century, the process of printing copies was costly and complicated.³⁵⁷ It turned on access to physical infrastructure — large, industrial-grade printing machines that produced copies.³⁵⁸ And distribution depended on the transportation of physical copies. In the horse-and-buggy era, the distribution of books was slower and more expensive.³⁵⁹

Together, these realities account for the courts' experimentation with procedural pragmatism. On the one hand, our copyright regime was far more limited than it is today. On the other hand, the process of making and distributing copies was prohibitively expensive. Consequently, courts might have reasonably believed that stronger copyright protection was necessary.³⁶⁰ The broader context hence explains why judges chose to side with copyright owners given the high costs of production and the relatively modest degree of protection afforded by the copyright statute.

Finally, one more contributing factor likely informed the judiciary's perception of the need for stronger copyright protection: the state

354. The Copyright Act of 1976 was the first to enshrine a standalone derivative work right. Previously, only specific types of derivative works were protected. *See, e.g.*, 1870 Act, *supra* note 164, § 86 (providing authors a right to control translations and dramatizations); 1909 Act, *supra* note 54, § 1(b) (codifying an exclusive right to translate the copyrighted work; dramatize a nondramatic work; convert a dramatic work into a novel; arrange or adapt a musical work; and complete, execute, and finish a model or design for a work of art). Still, “[n]ot until the Copyright Act of 1976 . . . did U.S. law grant authors a general right to control the preparation of derivative works.” Pamela Samuelson, *The Quest for a Sound Conception of Copyright's Derivative Work Right*, 101 GEO. L.J. 1505, 1509 (2013).

355. *See* sources cited *supra* note 327.

356. *See supra* Part II.

357. *See* Ernest Miller & Joan Feigenbaum, *Taking the Copy Out of Copyright*, in *THE SECURITY AND PRIVACY IN DIGITAL RIGHTS MANAGEMENT* 233, 236 (Tomas Sander ed., 2002).

358. *See id.* For an overview of the different types of printing devices developed before and during the nineteenth century, see James Mosley, *The Technologies of Print*, in *THE OXFORD COMPANION TO THE BOOK* (Michael F. Suarez & H. R. Woudhuysen eds., 2010).

359. CATHY N. DAVIDSON, *REVOLUTION AND THE WORD: THE RISE OF THE NOVEL IN AMERICA* 17 (1986). As Davidson observes, “[i]n a real sense, the rapid development of American publishing . . . after the first quarter of the nineteenth century highlights the obstacles that confronted the earlier publishers and authors — cumbersome printing techniques and inefficient methods for distribution . . .” *Id.* Davidson also explains that, during the early days of the nineteenth century, publishing was primarily a localized business. In fact, “until 1820 local printers (independent printers outside the major cities) still published over 50 percent of American fiction . . .” *Id.* at 18. And because “publishers were often small local businesses,” they struggled to distribute books “in a large land with a sparse and scattered population.” *Id.*

360. The flipside, of course, is that the threat of unauthorized copying was also diminished. After all, it was far more expensive and time-consuming to engage in unauthorized copying and distribution.

of American industry. During the nineteenth century, the American economy shifted from an agricultural system to one that depended more directly on industry and manufacturing.³⁶¹ And over the course of the twentieth century, much of the workforce turned to focus on information processing.³⁶² As a result, the significance of intellectual property protection grew. As William Fisher observes, “[d]uring the colonial period, few people stood to gain from copyright or patent protection; not surprisingly, few copyrights or patents were granted. Since that time, the demand for intellectual property protection has steadily increased.”³⁶³ Relatedly, during the twentieth century, the United States became a chief exporter of intellectual goods.³⁶⁴ Previously, Americans had primarily consumed contents produced by foreigners and imported into the United States.³⁶⁵ In the late twentieth century, however, the United States became the world’s largest exporter of intellectual goods.³⁶⁶ These shifts have prompted the U.S. government to pursue stronger intellectual property protections both domestically and abroad.³⁶⁷ There was, then, a widespread conviction that strong intellectual property protection was a matter of economic significance.

All of these factors likely had an impact on nineteenth-century copyright jurisprudence. They spawned a procedurally flexible framework that seemed sensible when considered against the relevant backdrop. Because the American economy grew to rely heavily on the production of intellectual goods, courts embraced an approach that was increasingly charitable to the interests of copyright owners. That approach

361. William W. Fisher III, *Geistiges Eigentum — ein ausufernder Rechtsbereich: Die Geschichte des Ideenschutzes in den Vereinigten Staaten*, 130 *EIGENTUM IM INTERNATIONALEN VERGLEICH* 265 (2011), translated in *THE GROWTH OF INTELLECTUAL PROPERTY: A HISTORY OF THE OWNERSHIP OF IDEAS IN THE UNITED STATES* 10–11, <http://cyber.law.harvard.edu/people/ffisher/iphistory.pdf> [<https://perma.cc/GZ5W-VDWE>].

362. *Id.* at 11.

363. *Id.* (footnote omitted).

364. See *id.*; Barbara A. Ringer, *The Role of the United States in International Copyright — Past, Present, and Future*, 56 *GEO. L.J.* 1050, 1060 (1968) (describing the eventual emergence of the United States as a “leading exporter of copyrighted works”).

365. B. Zorina Khan, *An Economic History of Copyright in Europe and the United States*, *EH.NET*, <https://eh.net/encyclopedia/an-economic-history-of-copyright-in-europe-and-the-united-states/> [<https://perma.cc/CP6M-D4E7>]. As Khan notes, “the more substantial literary works were imported,” suggesting that the United States “was long a net importer of literary and artistic works, especially from England.” *Id.*

366. See, e.g., Orrin G. Hatch, *Better Late than Never: Implementation of the 1886 Berne Convention*, 22 *CORNELL INT’L L.J.* 171, 195 (1989) (noting that Congress recognized that the United States is “the world’s foremost exporter of copyrighted material”).

367. See Clark D. Asay, *Rethinking Copyright Harmonization*, 96 *IND. L.J.* 1005, 1009–10 (2021) (arguing that “once the United States joined Europe as a net exporter of copyrighted goods, its desire to protect its nationals in foreign markets motivated it to join the copyright harmonization project”); see also Tyler T. Ochoa, *Is the Copyright Public Domain Irrevocable? An Introduction to Golan v. Holder*, 64 *VAND. L. REV. EN BANC* 123, 127 (2011) (claiming that “[b]ecause the United States was (and is) the world’s largest exporter of copyrighted works, it was in the national interest to encourage other nations to grant broad copyright protection to U.S. works”).

could also be justified in more functional terms: Judges perceived formalities as technical requirements of little significance for copyright's incentive-access balance. Another contributing factor was the publishing landscape in the nineteenth century. While the scope of copyright protection at the time was fairly modest, publishing costs were high.³⁶⁸ And courts were thus inclined to believe, somewhat reasonably, that copyright protection was vital to the interests of copyright owners.³⁶⁹ The bottom line is that procedural pragmatism, viewed in context, made a good deal of sense.

B. Doctrinal Drift

Eventually, the courts' pragmatism ran astray. Though initially grounded in a particular set of circumstances, doctrines of implicit assignment later grew significantly. Recall that, at first, courts invoked principles of implicit assignment to confront issues of procedural non-compliance.³⁷⁰ They did so in cases where the author did not comply with formalities, but the publisher did. In such cases, courts held that the author had somehow transferred her rights to the publisher. That outcome, courts intuited, redounded to the benefit of both parties — it was the only way to prevent the author, having failed to comply with formalities, from surrendering her copyright to the public domain.

Therefore, until the late nineteenth century, courts trumpeted doctrines of implicit assignment with the express goal of preventing forfeiture. And the inverse, too, was true: When procedural issues were not in play, courts were quick to dismiss claims of implicit assignment. Take, for example, two of the cases examined above. In *Black v. Henry G. Allen Co.*, the court declined to find an assignment after the author had already registered the rights in his own name.³⁷¹ There was good reason for the court to have reached that conclusion: If the author's rights were assigned to the publisher, then the registration in the author's name would be defective.³⁷² Another illustrative case is *Mifflin v. R.H. White Co.*, where the Supreme Court rejected claims of assignment after concluding that neither party had complied with formalities.³⁷³ Here, again, practical considerations suggest an explanation for the court's decision: A finding of implicit assignment would not have done any good, because neither party satisfied the statutory requirements.³⁷⁴

368. See *supra* text accompanying notes 354–60.

369. See *supra* text accompanying notes 354–60.

370. See *supra* Section IV.A.

371. *Black v. Henry G. Allen Co.*, 56 F. 764, 770–71 (C.C.S.D.N.Y. 1893).

372. See *supra* text accompanying notes 212–20.

373. *Mifflin v. R.H. White Co.*, 190 U.S. 260, 263–64 (1903).

374. See *supra* text accompanying notes 244–54.

As these examples show, the jurisprudence surrounding implicit assignments was case-specific. By and large, courts mobilized implicit assignments to stave off the risk of forfeiture. And when that risk was not present, they did not.

But that soon changed. Within a few decades, the doctrine drifted from its normative origins. What began as a nuanced, case-by-case approach eventually metastasized into a rigid default rule. In some instances, especially when works of art were at issue,³⁷⁵ judges found that the unconditional sale of a copy implied a default assignment of the copyright. As discussed above, cases like *Dielman*,³⁷⁶ *Parton*,³⁷⁷ *Kellogg*,³⁷⁸ and *Dam*³⁷⁹ all pointed to a clear presumption in favor of default assignments. That presumption was rebuttable by clear evidence to the contrary — namely, evidence that the author explicitly intended to retain the rights.³⁸⁰

And that default rule appeared to hold no matter the circumstances. It was largely irrelevant whether the author or the publisher faced issues of procedural compliance.³⁸¹ Courts have therefore turned the doctrine on its head. Rather than invoke the doctrine of implicit assignment to work around certain procedural requirements, courts instead chose to relax these very requirements (most notably, the notice requirement)³⁸² to accommodate a rule of default assignments. And that is exactly backward. The doctrine, in other words, has strayed from its original focus on circumstances where procedural formalities posed a problem.

At least in some cases, it is easy to understand why courts adopted a presumption of default assignment. When unique works of fine art (such as paintings) were at issue, a purchaser typically engaged the original artist to acquire the *only* existing copy of the work. So a presumption of assignment seemed reasonable: If an artist is willing to sell and relinquish possession of the only copy in existence, shouldn't we presume that the artist had in fact intended to surrender her rights in that work?

375. Still, although many of the cases discussed above dealt with paintings, their holdings were applicable more broadly. The court in *Parton*, for instance, referenced both paintings and manuscripts in discussing the issue of copyright assignment. *Parton v. Prang*, 18 F. Cas. 1273, 1277–78 (C.C.D. Mass. 1872) (No. 10,784). The *Dam* court likewise applied an analogous default rule in the context of manuscripts. *Dam v. Kirk La Shelle Co.*, 175 F. 902, 904–05 (2d Cir. 1910).

376. *Dielman v. White*, 102 F. 892 (C.C.D. Mass. 1900).

377. *Parton*, 18 F. Cas. 1273.

378. *Grant v. Kellogg Co.*, 58 F. Supp. 48 (S.D.N.Y. 1944).

379. *Dam*, 175 F. 902.

380. As the *Parton* court emphasized, an author may place any “qualifications, limitations, and restrictions” upon the sale and delivery of her work. “Sales,” the court noted, “may be absolute or conditional, and they may be with or without qualifications, limitations, and restrictions.” *Parton*, 18 F. Cas. at 1278.

381. In none of the cases discussed above — cases like *Dielman*, *Parton*, or *Kellogg* — were matters of compliance at issue. See *supra* Section IV.A.

382. See *supra* text accompanying note 229.

As a normative matter, however, a rule of default assignment is difficult to reconcile with the original, carefully crafted doctrine of implicit assignment. To see why, consider the justification courts offered in support of default assignments. An assumption of assignment-by-sale, courts emphasized, followed from principles of property law. In *Kellogg*, the court stated that the sale of the artist's work — a graphic depiction of fictional characters — necessarily involved an assignment of the rights because the artwork was a “personal property, transferrable by sale and delivery.”³⁸³ As a consequence, a presumption of assignment attached by default when the art was sold and delivered, unless the original owner placed “expressed and clearly imposed” restrictions on the transfer of rights.³⁸⁴ Otherwise, the court said, such restrictions “will not be presumed.”³⁸⁵ The idea here was that an artwork is just another object of “personal property.” As such, it was subject to the same default assumption that governed the sale of all other chattel.

A similar framework carried the day in *Parton*. After finding that the original owner had failed to expressly place any limits on the sale of his art, the court deemed the sale “absolute and unconditional.”³⁸⁶ And with an absolute and unconditional sale, the copyright transferred to the purchaser. As the court put it, “if the sale was an absolute and unconditional one, and the article was absolutely and unconditionally delivered to the purchaser, the whole property in the manuscript or picture passes to the purchaser.”³⁸⁷

Principles of real property, then, buttressed the presumption of default assignment. On this reasoning, the sale and delivery of “personal property” should generally result in a transfer of title, both with respect to real property and in the context of copyrighted works. When it comes to questions of assignment, the argument goes, paintings and manuscripts are no different than other chattel.

But the property framework is profoundly inadequate as a matter of copyright policy. Copyright does not protect physical property; rather, it controls intangible works of authorship.³⁸⁸ So a copyright owner may sell a physical copy of the work without necessarily dispensing with her copyright interest in the intangible work.³⁸⁹ The physical copy is distinct from the intellectual work.³⁹⁰ And although the intellectual

383. *Kellogg*, 58 F. Supp. at 51.

384. *Id.*

385. *Id.*

386. *Parton v. Prang*, 18 F. Cas. 1273, 1278 (C.C.D. Mass. 1872) (No. 10,784).

387. *Id.*

388. 17 U.S.C. § 102 (“Copyright protection subsists . . . in original works of authorship . . .”).

389. 17 U.S.C. § 202 (“Ownership of a copyright . . . is distinct from ownership of any material object in which the work is embodied.”).

390. *Id.*

work is embodied in a physical object, an unconditional sale of that object need not imply a sale of the intangible work.

Blackletter copyright law relies on the first-sale doctrine to draw this very distinction between the physical object and the copyrighted work.³⁹¹ Originally the product of courts,³⁹² the first-sale doctrine stands for the proposition that “the copyright is distinct from the property in the material object copyrighted.”³⁹³ Because the intangible creation is separate from the physical object, the purchaser of a physical book, for example, may lend it to a friend or sell it to a third party. However, she may not reproduce the underlying intellectual work — the collection of words that make up the intangible work. A bona fide purchaser owns the physical object, not the copyrighted work. And while it is undoubtedly true that the first-sale doctrine today is limited in some respects,³⁹⁴ the doctrine nonetheless points to a fundamental distinction between physical objects and the intangible creations they embody.

Given this distinction, it is hard to make sense of the default assignment rule. To say that a transfer of the physical copy necessarily triggers an assignment of the copyrighted work is to misunderstand basic principles of copyright law. And there’s a broader lesson here: If anything, the prominence of the default assignment doctrine suggests that courts of the late nineteenth century did not fully subscribe to what is now a fundamental principle of copyright law — the distinction between the copy and the work. Although the 1909 Act enshrined an early variation of the first-sale doctrine,³⁹⁵ courts of the time had not yet fully embraced that distinction and instead accommodated an overly broad default assignment doctrine.

391. 17 U.S.C. § 109(a) (specifying that “the owner of a particular copy or phonorecord lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord”).

392. See *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 350–51 (1908) (recognizing a limit on the right of a copyright owner to prevent future distribution of an already-sold physical copy).

393. The first statute to codify the first-sale doctrine, the 1909 Act, expressly recognized that principle. 1909 Act, *supra* note 54, § 41. The 1976 Act encodes a similar principle in § 202. See 17 U.S.C. § 202.

394. The doctrine is qualified in a number of ways. First, it only applies to copies “lawfully made.” 17 U.S.C. § 109(a). So, the purchaser of a copy made unlawfully cannot avail herself of the first-sale defense. Second, as the language of § 109(a) makes clear, the doctrine covers only those who *own* copies; it does not reach licensees. Third, it is unclear whether and to what extent the first-sale defense extends to digital distribution. The reason is that digital distribution — i.e., moving digital files from one location to another — involves a technical process whereby a copy of the original file is sometimes created. Thus, as a technical matter, digital distribution also implicates copying. Yet the first-sale doctrine applies only to distribution — it does not defend against unauthorized copying. See *Capitol Recs., L.L.C. v. ReDigi, Inc.*, 934 F. Supp. 2d 640, 649–50, 654–55 (S.D.N.Y. 2013), *aff’d*, 910 F.3d 649 (2d Cir. 2018).

395. 1909 Act, *supra* note 54, § 41.

Worse, a default assignment rule was wholly removed from the original justification for the case-specific implicit assignment doctrine. The original doctrine was grounded in the practical realities of the nineteenth-century publishing industry.³⁹⁶ It sought to prevent copyright forfeiture.³⁹⁷ It arose out of cases where an assignment was necessary to salvage the author's copyright.³⁹⁸ And it emerged at a time when courts believed, rather reasonably, that copyright protection was crucially important.³⁹⁹ But none of these rationales are applicable to default assignments. When courts held that the sale of a copy implied a default assignment of the copyright, they were not attempting to prevent forfeiture. Instead, they transferred the rights from one party (the original author) to another (the purchaser). A default rule is not about preventing forfeiture — it is about reallocating rights. And that has very little to do with the original objective underpinning the implicit assignment doctrine: protecting copyright owners against the risks associated with copyright formalities.

Still, to an extent, a default assignment rule fits rather easily with broader trends in American copyright jurisprudence. As others have pointed out, common-law systems tend to resist “restraints on alienation.”⁴⁰⁰ And our copyright system has long recognized “easy alienability of authors’ rights.”⁴⁰¹ Some might argue that is a good thing: The ultimate goal of our system, after all, is to induce wide dissemination of works of authorship. Easy alienability serves that purpose — it channels copyrighted works into the hands of those who can mass-distribute these works: publishers and other intermediaries.⁴⁰²

But that is hardly a justification for default assignments. There may be good reasons to favor fast and easy alienability of copyrighted works, say, by making it easier for authors to assign their rights without any restrictions. The basic idea is that we should allow authors to easily part with their copyright when they wish to do so. But even if one accepts this premise, it is unclear why courts should pursue that goal by imposing a default mandate — one that divests authors of their rights even when they do not necessarily wish to do so. If the goal is to streamline dissemination through market transactions between willing sellers and buyers, a default rule seems overdrawn.

396. *See supra* text accompanying notes 354–67.

397. *See supra* Section IV.A.

398. *See supra* Section IV.A.

399. *See supra* text accompanying notes 354–67.

400. Jane C. Ginsburg, *The Role of the Author in Copyright*, in *COPYRIGHT LAW IN AN AGE OF LIMITATIONS AND EXCEPTIONS* 60, 64 (Ruth L. Okediji ed., 2017) (quoting 61 AM. JUR. 2D *Perpetuities and Restraints on Alienation* § 90 (2002)).

401. *Id.*

402. *Id.* at 65; *see also* Jessica Litman, *The Invention of Common Law Play Right*, 25 *BERKELEY TECH. L.J.* 1381, 1382 (2010) (“[T]he architecture of the [copyright] system encourages [creators] to assign their copyrights to intermediaries . . . That’s the essence of a copyright system that is fundamentally utilitarian in its design.”).

Put crudely, this brief discussion presents a cautionary tale of a doctrine gone awry. The implicit assignment doctrine drifted from its original normative foundations. It eventually spiraled into a default rule that was objectionable as a matter of both copyright law and sound policy. Indeed, there's no denying that courts command a formidable degree of influence over the trajectory of copyright law. In developing the law, courts often adjust or adapt existing doctrines to meet new challenges. But, as this analysis suggests, doing so requires careful attention not only to naked principles of law, but also to the policy objectives that gave rise to these doctrines in the first place.

C. Implied License

One striking feature of early copyright jurisprudence is that courts were prepared to speak of an implicit assignment even where there was little direct evidence, if any, that the author had ever intended to assign her copyright. The rhetoric behind some of these cases is revealing. It suggests that concepts of implied permission, not implicit assignment, played a significant role in copyright disputes of the early nineteenth century.

Consider a few of the cases examined previously. The question in *Pulte*,⁴⁰³ for example, was whether the author, having granted a license to release the first two editions of his book, had implicitly assigned his copyright to the publisher.⁴⁰⁴ The dispute flared up because the publisher sought to release a third edition of the book (after the first two editions proved successful).⁴⁰⁵

Strictly speaking, the court concluded that the author did in fact assign his rights to the publisher.⁴⁰⁶ But the court also qualified its holding by explaining that the copyright assigned to the publisher was only valid for the purpose of the contract between the parties and hence was inapplicable for other purposes and against third parties.⁴⁰⁷ The court made clear that this was, at bottom, a contractual dispute.⁴⁰⁸ That meant, as I explained above, that the "copyrights" transferred from the author to the publisher were no copyrights at all. Rather, these rights amounted to an in personam contractual entitlement.

And that conclusion finds support not only in the court's holding; it also fits more naturally with the facts of the case. The agreement between the parties specified that the publisher would release two editions of the book. That raises a question: If the author wished to convey the

403. *Pulte v. Derby*, 20 F. Cas. 51 (C.C.D. Ohio 1852) (No. 11,465).

404. See *supra* text accompanying notes 168–96.

405. See *supra* text accompanying notes 168–96.

406. *Pulte*, 20 F. Cas. at 52.

407. *Id.* at 53.

408. See *supra* text accompanying note 192.

entire copyright to the publisher, why reference only the first two editions of the book? An assignment of the rights, after all, would entitle the publisher to release as many editions as it wished. The most plausible answer, of course, is that the author did not assign the rights to the publisher but instead granted the publisher a license to release a limited number of editions.

This reading is similarly supported by the prevalent industry practices of that era. Almost immediately after the first copyright statute was enacted in 1790, American authors and publishers “assumed that the point of having [a] property right was to be able to sell it or assign it to a publisher, who would take on all the expense and labor of putting to press and marketing the book.”⁴⁰⁹ So they shared an understanding that the copyright statute provided “the author something to sell and the printer something to buy.”⁴¹⁰ Based on these intuitions, authors and publishers would often negotiate over the price of the copyright. Sometimes, however, the price of the copyright — the projected market value of the copyrighted work — was unclear.⁴¹¹ And, on some occasions, when the value of the copyright was in doubt, authors agreed to license the work for only one or two editions,⁴¹² partly on the belief that if the first editions prove successful, subsequent editions would be published on terms more favorable to the authors.⁴¹³

While not conclusive evidence, these practices support the conclusion that, like many other authors of the time, the author in *Pulte* engaged in sequential licensing. The author initially licensed the first two editions of the book, and then authorized — if only implicitly — a third edition. In short, an implied license inference fits with the prevailing industry practices, the circumstances surrounding the agreement, and the court’s rhetoric. And recall again that although the court’s analysis was enshrouded in the language of copyright assignment, the court ultimately concluded that the publisher obtained merely a contractual entitlement. The decision in *Pulte*, then, is best characterized as reflecting a scheme of implied license. This scheme was engineered to protect the interests of the parties — namely, to prevent copyright forfeiture.

Instincts of implied permission likewise underwrite some cases dealing with equitable ownership. Take the case of *Lawrence v.*

409. James N. Green, *The Rise of Book Publishing*, in 2 A HISTORY OF THE BOOK IN AMERICA 75, 100 (Mary Kelley & Robert A. Gross eds., 2015).

410. *Id.*

411. *Id.* at 101 (“Copyright established a legal and contractual basis for author-publisher relations; but if it gave value to a title, it did not settle the question of what that value was.”).

412. As James Green explains, many “authors could sell the copyright for the full term or for just one edition, assuming that the book would be revised and a new copyright would be secured for any future edition.” *Id.*

413. An illustrative example is Hannah Adams’s 1784 book, *An Alphabetical Compendium of the Religious Sects*. Green points out that “Adams got nothing for [the first edition] in 1784; shared profits on the second edition; and sold the copyright of the third in 1801 for \$500.” *Id.*

Dana.⁴¹⁴ The author, a friend of a widow's late husband, allowed the widow to register the rights to his work in her own name.⁴¹⁵ A dispute later arose when the widow's daughter hired a third party to prepare a new edition of the work.⁴¹⁶ The author sued for copyright infringement, seeking to enjoin the release of the new edition.⁴¹⁷ The court found, somewhat oddly, that the author's copyright vested in the widow as a formal matter, but that the author himself retained an equitable interest in the work.⁴¹⁸ That meant that the widow and her heirs were the "formal" owners of the copyright, while the author remained the equitable owner. The implication was that the defendants were allowed to publish the work, subject to payment to its equitable owner — the original author.

As discussed above, the *Lawrence* court engaged in an exercise of aggressive pragmatism.⁴¹⁹ It invoked doctrines of equity to reimagine the relationship between the parties. In that way, the court allowed the original author to retain his rights in equity — a result the court clearly thought to be just. At the same time, because the copyright was already registered in the widow's name, the court simply labeled the widow a "formal" owner of the rights, suggesting she was acting as a trustee on behalf of the original author.

This involuted scheme, cloaked in the language of equity, was understandably appealing. It allowed the court to have it both ways — to find that the original author was the actual owner while also recognizing that the rights were registered in someone else's name (the "formal" owner). But there is a better way to understand *Lawrence* and its progeny. At its core, *Lawrence* appears to turn on an implied permission scheme. Indeed, what emerges from *Lawrence* is a fairly straightforward picture. One party (the author) is the owner of the rights; the other party (the widow) is acting on behalf of the owner and is required to pay for using the work. Stripped to its bones, this relationship sounds an awful lot like a standard license. The author, in other words, implicitly authorized the widow to release the book in exchange for payment. That relational structure — access in exchange for payment — reflects a license of sorts. And though that may seem overly reductive given the complexity of the facts surrounding *Lawrence*, this reading is preferable to the court's gauzy reconstruction of an equitable ownership scheme that the parties themselves likely never contemplated.⁴²⁰ Again, ideas of implied permission lingered in the background.

414. *Lawrence v. Dana*, 15 F. Cas. 26 (C.C.D. Mass. 1869) (No. 8,136).

415. *Id.* at 45.

416. *Id.* at 30–31.

417. *Id.* at 31.

418. *Id.* at 54.

419. See *supra* text accompanying notes 265–81.

420. The opinion adduces no evidence — none — to support an inference that the parties ever considered a constructive trust scheme. Indeed, although the parties memorialized their

A close study of the caselaw, therefore, demonstrates that even though principles of implied license drive many of the disputes discussed above, courts worked assiduously to repackage them in terms of assignment or equitable ownership.

Still, one may wonder: If these cases are best understood as licensing disputes, why didn't courts just say so? Why bother instead with an elaborate analysis that undercuts the factual record? As should be manifestly clear by now, the answer is that courts wished to prevent copyright forfeiture. Because many authors failed to clear formalities, courts had to find that someone else was, in fact, the copyright owner. If that were not the case, the copyright would be lost. A finding that the author merely licensed the rights would not have sufficed. Only a complete transfer of the copyright would have enabled courts to paint another party, such as a publisher, as the copyright proprietor.

VI. PRAGMATISM REIMAGINED: MODERN ECHOES

The previous Part suggested that the implied license doctrine has a long and overlooked pedigree in American copyright law: A large body of early caselaw appeared to focus on copyright ownership but was squarely grounded in an implied license framework. This Part argues that a beefed-up doctrine of implied license, one that attends more broadly to policy objectives and industry practices, would be a salutary addition to the toolkit of contemporary courts.⁴²¹

One caveat is in order here: The following discussion is far from exhaustive. Instead, this Part aims only to gesture toward potential avenues for future research by offering a high-level sketch of how a more aggressive implied license scheme might present an opportunity to settle complex copyright disputes.

To see why, consider an area of increasingly bitter controversy: paparazzi photos. A cavalcade of high-profile celebrities — including Gigi Hadid, Ariana Grande, Justin Bieber, Victoria Beckham, Nicki Minaj, Katy Perry, and Jennifer Lopez — have recently been sued for sharing paparazzi photos of themselves on social media.⁴²² In these

understanding that the rights would be registered in the plaintiff's name, they made no mention of any equitable interests that might inhere in the defendant.

421. I am not the first to advocate for a reinvigorated implied license doctrine. See Orit Fischman Afori, *Implied License: An Emerging New Standard in Copyright Law*, 25 SANTA CLARA COMPUT. & HIGH TECH. L.J. 275 (2009).

422. Ashley Carman, *Gigi Hadid Wants to Rewrite Copyright Law Around Her Instagram Account*, THE VERGE (June 24, 2019, 5:50 PM), <https://www.theverge.com/2019/6/24/18715675/> [<https://perma.cc/TRH9-23KG>]; David Mack, *Ariana Grande Is Being Sued for Posting Paparazzi Photos of Herself to Instagram*, BUZZFEED NEWS (May 14, 2019, 10:44 AM), <https://www.buzzfeednews.com/article/davidmack/ariana-grande-sued-lawsuit-paparazzi-instagram> [<https://perma.cc/9YW6-WVGT>]; Tatiana Cirisano, *Justin Bieber Quickly Settles Copyright Lawsuit Over Paparazzi Photo*, BILLBOARD (Oct. 22, 2019), <https://www.billboard.com/pro/justin-bieber-settles-copyright-lawsuit-paparazzi-photo-instagram/> [<https://pe>

cases, claims of copyright infringement seem both plausible and counterintuitive. They are plausible to the extent they involve a colorable infringement claim. By default, the photographer is the owner of the copyright in the photos she takes.⁴²³ And, as the copyright owner, the photographer can prevent others from copying, adapting, distributing, or publicly displaying her photos.⁴²⁴

That said, these episodes are also counterintuitive in that they tee up rather pointedly the disconnect between copyright law and the conventional intuition that people should be free to use their image.⁴²⁵ Laypeople may be surprised to learn that, even when they are themselves the subjects of a photo, sharing it without permission would be legally perilous. Simply put, copyright law is at odds with pervasive social conventions.

Nonetheless, unsuspecting infringers could potentially rely on three doctrines to escape liability. First, they may claim they jointly own the photo.⁴²⁶ The relationship between paparazzi and their subjects is mutually beneficial — the photographer turns a profit by selling the photo, while the subject benefits from increased public exposure.⁴²⁷ Indeed, some paparazzi photos are staged, or at least partly

rma.cc/86GE-8MEK]; Ryan Naumann, *Victoria Beckham Sued for \$150,000 Over Instagram Post*, THE BLAST (Sept. 17, 2019, 10:30 PM), <https://theblast.com/c/victoria-beckham-instagram-story-lawsuit-photographer-150000> [<https://perma.cc/SC3W-LZZJ>]; Blake Brittain, *Nicki Minaj Sued for Posting Photos of Herself to Instagram*, BLOOMBERG L. (Jan. 21, 2020, 4:23 PM), <https://news.bloomberglaw.com/ip-law/nicki-minaj-sued-for-posting-photos-of-herself-to-instagram> [<https://perma.cc/4DKU-BFN4>]; Juliette Jagger, *Katy Perry Sued for Copyright Infringement After Posting a Paparazzi Photo of Herself on Instagram*, CELEBRITY ACCESS (Nov. 1, 2019, 11:10 AM), <https://celebrityaccess.com/2019/11/01/katy-perry-sued-for-copyright-infringement-after-posting-a-paparazzi-photo-of-herself-on-instagram> [<https://perma.cc/N2QV-CESY>]; Maria Puente, *Jennifer Lopez Sued by Paparazzi for Copyright Infringement*, USA TODAY (Oct. 7, 2019, 3:53 PM), <https://www.usatoday.com/story/entertainment/celebrities/2019/10/07/3900908002> [<https://perma.cc/WK4N-J83Y>].

423. 17 U.S.C. § 201(a) (“Copyright in a work protected under this title vests initially in the author or authors of the work.”). Copyright has a long “tradition of near-presumptive copyright protection” for photographs. Eva E. Subotnik, *Originality Proxies: Toward a Theory of Copyright and Creativity*, 76 BROOK. L. REV. 1487, 1493 (2011). Some critics, however, contend that a more stringent bar for creativity would exclude from protection “most of the world’s photographs and video.” Justin Hughes, *The Photographer’s Copyright — Photograph as Art, Photograph as Database*, 25 HARV. J.L. & TECH. 339, 425 (2012).

424. 17 U.S.C. § 106.

425. Kelley Bregenzer, Note, *Modifying Co-Authorship for the Digital Age: Paparazzi Photographs as Joint Works*, 13 DREXEL L. REV. 449, 452 (2021) (arguing that “[n]otions of fairness, creativity, and profitability would seem to dictate that [celebrities], too, deserve some leeway to use photographs featuring themselves”); *see also id.* at 457 (citation omitted) (quoting Neel Chatterjee, a copyright lawyer, as saying that the rules governing photo-sharing “offend[] common sense”).

426. 17 U.S.C. § 101 (“A ‘joint work’ is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”); *see also* Thomson v. Larson, 147 F.3d 195, 199 (2d Cir. 1998) (“Joint authorship entitles the co-authors to equal undivided interests in the whole work — in other words, each joint author has the right to use or to license the work as he or she wishes, subject only to the obligation to account to the other joint owner for any profits that are made.”).

427. Bregenzer, *supra* note 425, at 454–55.

coordinated.⁴²⁸ In fact, a candid shot might prove valuable precisely because of the creative choices made by the photo's subject: the clothes they don, their choice of jewelry, the type of activity they engage in, and the like. On this view, the photographer and the subject are co-creators of the work for the simple reason that they both contribute to the creative enterprise that produces the photo.

As a matter of positive law, however, the doctrine of joint authorship presents a significant obstacle. Courts have construed the co-authorship doctrine narrowly, requiring evidence that both parties mutually intended to create a work of co-authorship.⁴²⁹ The problem is that paparazzi often labor under the assumption that they alone own the photos they take.⁴³⁰ It therefore seems unlikely that a court would be able to draw an inference of mutual intent when paparazzi photos are at issue.

Another possibility is to rely on the fair use doctrine, which excuses some unauthorized uses of copyrighted work.⁴³¹ Courts consider four statutory factors in assessing fair use: (1) "the purpose and character of the use," including whether it was "transformative,"⁴³² (2) "the nature of the copyrighted work," (3) "the amount and substantiality of the portion used," and (4) "the effect of the use upon the potential market for . . . the copyrighted work."⁴³³

Most commonly, the first and fourth factors drive the analysis.⁴³⁴ Pointing to the first factor, courts might find that a defendant's use of the photo was noncommercial and transformative, especially if the photo was posted to a private account alongside some original commentary. But that proposition is debatable. Today, it is increasingly difficult to draw a categorical distinction between private and commercial use on social media. There is indeed a bustling market for advertising by social media "influencers" — both big-name celebrities and lesser-

428. See, e.g., Seija Rankin, *The Art of the Staged Paparazzi Photo: How Celebrity Couples Look So in Love, E!* ONLINE (Mar. 1, 2017, 2:00 PM), <https://www.eonline.com/news/832995/the-art-of-the-staged-paparazzi-photo-how-celebrity-couples-look-so-in-love> [<https://perma.cc/K6MN-QS5A>].

429. E.g., *Aalmuhammed v. Lee*, 202 F.3d 1227, 1234 (9th Cir. 2000) (stating that putative coauthors must "make objective manifestations of a shared intent to be coauthors"); *Childress v. Taylor*, 945 F.2d 500, 507–09 (2d Cir. 1991) (focusing on whether the putative coauthors ever shared an intent to be coauthors).

430. Indeed, virtually all professional photographers share that view. See *infra* text accompanying note 442.

431. 17 U.S.C. § 107. For a brief glossary on the fair use doctrine, see Clark D. Asay, Arielle Sloan & Dean Sobczak, *Is Transformative Use Eating the World?*, 61 B.C. L. REV. 905, 914–21 (2020).

432. Asay, *supra* note 431, at 917–18; *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

433. 17 U.S.C. § 107.

434. See generally Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions Updated, 1978-2019*, 10 N.Y.U. J. INTEL. PROP. & ENT. L. 1, 23, 33 (2020).

known Internet personalities.⁴³⁵ Celebrities often use their social media accounts to promote businesses or sponsor products.⁴³⁶ Essentially, social media has become a popular vehicle for both commercial and non-commercial use of copyrighted works.

Similarly, in weighing potential market harm under the fourth factor, it is important to consider that a photo posted to a celebrity's social media account may well reach millions of potential users,⁴³⁷ hence decreasing the likelihood that a magazine or a website would be willing to license the photo after it had already been viewed widely. An assessment of harm would therefore have to account for the size of the celebrity's following. It would also have to consider whether the photo had already been licensed or sold by the paparazzo before it was used by its subject.

It is hard to predict with certainty how courts would weigh these factors in specific cases. The fair use inquiry is fact-sensitive and case-specific.⁴³⁸ And that is part of the problem: The fair use analysis is carried out *ex post* by a court or, in some instances, a jury. A defendant asserting fair use would have to engage in costly and uncertain litigation.⁴³⁹ In practice, many defendants might choose to settle out of court.⁴⁴⁰ Given the realities of federal copyright litigation, the fair use doctrine offers only limited reprieve.⁴⁴¹

Finally, a third possibility would be to develop a more muscular conception of the implied license doctrine. That, I argue, is the most promising approach. It finds support in the longstanding intuition that people should be able to control how and when their photos are shared. A recent study suggests that professional photographers, too, share these basic convictions. According to the study, photographers believe that they, and they alone, deserve to own the copyright in their

435. Alexandra J. Roberts, *False Influencing*, 109 *GEO. L.J.* 81, 89–96 (2020).

436. *Id.* at 90 (reporting that “[b]y most accounts, influencer marketing continues to grow steadily”).

437. In the lawsuit filed against model Gigi Hadid, for example, the plaintiff alleged that Hadid's account was followed by more than 43 million users — with more than 1.6 million users commenting on the allegedly infringing photos. Complaint at 3, *Xclusive-Lee, Inc. v. Hadid*, No. 19-cv-00520, 2019 WL 3281013 (E.D.N.Y. 2019).

438. Shisha, *The Copyright Wasteland*, *supra* note 340, at 1780–81 (“[T]he fair use doctrine rests on a statutory test that is flexible by design: Courts examine whether the defendant's use is fair on a case-by-case basis against four statutory factors.”).

439. AM. INTELL. PROP. L. ASS'N, 2017 REPORT OF THE ECONOMIC SURVEY 44 (2017) (reporting, based on a survey of practitioners, that the median cost of copyright litigation ranges from \$200,000 to \$1 million).

440. Bregenzer, *supra* note 425, at 460 (noting that “[m]ost cases” involving unauthorized reposting of paparazzi photos have “settled out of court, often for \$10,000–\$20,000”).

441. See James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 *YALE L.J.* 882, 889 (2007) (“From the *ex post* perspective of the defendant already embroiled in expensive litigation, an adaptable, equitable defense is useful. But for the prospective defendant wondering whether a given act will prove to be infringing, fair use is too ambiguous to provide much *ex ante* guidance.”).

photos.⁴⁴² Yet they also appear to see value in maintaining a relationship of trust with their subjects.⁴⁴³ The relationship photographers build with their subjects is central to their sense of professionalism. Interestingly, photographers insist that, by asserting their copyrights against third parties, they are defending their subjects against injury.⁴⁴⁴ Specifically, they seek to use their rights to enjoin unauthorized circulation of the photo in ways that would place it out of context, thereby causing harm to the subject.⁴⁴⁵ All of this suggests that the relationship between photographers and their subjects need not be acrimonious. On the contrary, photographers acknowledge that their professional duties require attending to their subjects' interests.

Of course, it is certainly possible that paparazzi photographers, as opposed to photographers operating in other fields, harbor different views on the nature of their relationship with their subjects. Even so, the study documents notions of ownership and relational fairness that most photographers appear to share.⁴⁴⁶ And these ideas hint at a possible way forward: an implied license scheme. On that approach, courts would affirm that photographers own the copyrights in the photos they take, while reimagining their relationship with their subjects as one rooted in an implied license — a license that covers any personal, non-commercial use by the direct subject of a non-commissioned photo.

That approach would permit subjects to share photos of themselves, and, critically, it would also cohere with the professional norms that pervade the relevant community. Photographers, after all, profess fidelity to two relevant principles: (1) they alone own the copyright in the work and (2) they are duty-bound to protect their subjects — to prevent harm to the subject's "identity and [to] the relationship that

442. Jessica Silbey, Eva E. Subotnik & Peter DiCola, *Existential Copyright and Professional Photography*, 95 NOTRE DAME L. REV. 263, 309–12 (2019).

443. *Id.* at 317–20.

444. *Id.*

445. *Id.* at 318–19.

446. To identify community norms, one must first define the relevant community. If the professional community consists of all professional photographers, then the norms cataloged in the study above would be applicable to paparazzi as well. In that case, one can think of paparazzi photographers as disobedient community members. They simply refuse to abide by the norms shared by the community at large. While most photographers believe they owe a certain duty of trust to their subjects, paparazzi appear to reject these views. Still, as Christopher Newman explains, an inference of implied license can arise even when a specific owner disclaims or rejects the majority default rule. Christopher M. Newman, "What Exactly Are You Implying?": *The Elusive Nature of the Implied Copyright License*, 32 CARDOZO ARTS & ENT. L.J. 501, 529 (2014). Such an inference could be seen "as reducing transaction costs for the majority." *Id.* Alternatively, one could argue that the relevant community consists only of a subgroup of paparazzi photographers. If that is so, then the norms described above would be inapplicable. For the purpose of this Article, and in light of the strong intuitions about autonomy and fairness that drive societal views about photo-sharing practices, I assume here that the broader community — one that encompasses all professional photographers — is the relevant reference group.

produced the image.”⁴⁴⁷ An implied license scheme has the benefit of reifying both norms. It would allow the photographer to retain exclusive rights, but it would also prevent the photographer from wielding these rights against the subject in a way that would unsettle the trust-based relationship between the parties.

Moreover, reliance on community norms seems uniquely appropriate in this context. As Christopher Newman explains, “[s]ometimes we infer consent from conduct not necessarily because it seems to reflect the owner’s actual intent, but because it is customary in a particular context to treat consent as the default.”⁴⁴⁸ An implied license, in short, would be desirable here both as a matter of policy and as a reflection of the norms and customs that undergird the relationship between photographers and their subjects. And it would allow courts to predictably and consistently dispose of lawsuits brought by photographers against their subjects.

It is also important to note that the precise scope of the implied license doctrine in such cases would be defined by the complex system of norms underlying the relationship between photographers and their subjects. For example, in cases where the photographer was explicitly commissioned to take photos of the subject — think, for instance, of wedding photographers — there would be no basis for an implied license inference. The existence and scope of an implied license should thus be determined based on an analysis of prevailing industry norms. These practices might support an implied license inference in some cases but not in others.

To be sure, this analysis applies more broadly to other areas of copyright law. Consider, for instance, the uptick in litigation surrounding tattoos. In a number of recent cases, tattoo artists have brought lawsuits alleging infringement of their original works — the tattoos inked on the bodies of athletes and celebrities. In one such case, a tattoo studio sued the developers of an NBA video game for recreating digital avatars of professional NBA athletes, including a depiction of the tattoos displayed on the players’ bodies.⁴⁴⁹ In an earlier case, a tattoo artist sought to bar distribution of a major motion picture, *The Hangover Part III*, on the ground that a character in the movie boasted a face tattoo that was substantially similar to a face tattoo the plaintiff had created for the boxer Mike Tyson.⁴⁵⁰

447. Silbey et al., *supra* note 442, at 319.

448. Newman, *supra* note 446, at 529.

449. *Solid Oak Sketches, L.L.C. v. 2K Games, Inc.*, 449 F. Supp. 3d 333 (S.D.N.Y. 2020). The court granted summary judgment in favor of the defendants. *Id.* at 345. In dismissing the lawsuit, the court held that the digitally recreated tattoos were not substantially similar to the plaintiff’s tattoos, and alternatively, that the plaintiff “necessarily granted the Players nonexclusive licenses to use the Tattoos as part of their likenesses.” *Id.* at 346.

450. Complaint, *Whitmill v. Warner Bros. Ent. Inc.*, No. 4:11-cv-752, 2011 WL 11819138 (E.D. Mo. Apr. 28, 2011). The case eventually settled. See Matthew Belloni, *Warner Bros.*

Here, too, an implied license framework presents an effective tool for resolving disputes. As Aaron Perzanowski observes, the relationship between tattoo artists and their subjects is governed by certain conventions.⁴⁵¹ After all, “[t]attooers must establish norms that govern not only their interactions with each other, but with clients who play an important role in the creation and use of their works as well.”⁴⁵² The upshot is that, as a matter of community norms, tattoo artists “recognize the autonomy interests of their clients both in the design of custom tattoos and their subsequent display and use.”⁴⁵³ In light of these norms, it should be easy to develop an implied license framework that would permit individuals to publicly display their tattoos, even in commercial settings, as a necessary corollary to their autonomy interests.⁴⁵⁴

Another area in need of doctrinal clarification is the use of video games in live gameplay streams. Generally speaking, gameplay streams involve a public performance of a copyrighted work — the underlying video game.⁴⁵⁵ The principal question, then, is whether the owners of the rights have authorized public performance of their games. And, as it turns out, video game developers vary significantly in their approach to streaming.⁴⁵⁶ While some developers permit streaming, others prohibit it altogether or otherwise allow only parts of the game to be streamed.⁴⁵⁷ Still others remain completely silent on the issue.⁴⁵⁸ The result is that, at least in some circumstances, gameplay streaming might constitute unauthorized public performance of a copyrighted work.

An implied license framework could prove helpful in this context as well. Given the explosive popularity of gameplay streams — buoyed by a new crop of streaming celebrities — video game developers have come to recognize that streaming is good for business. Many developers collaborate with prominent streamers, promote gameplay streams,

Settles ‘Hangover II’ Tattoo Lawsuit (Exclusive), HOLLYWOOD REP. (June 20, 2011, 1:39 PM), <https://www.hollywoodreporter.com/business/business-news/warner-bros-settles-hangover-ii-203377/> [<https://perma.cc/6ZDH-M94D>].

451. Aaron Perzanowski, *Tattoos & IP Norms*, 98 MINN. L. REV. 511 (2013).

452. *Id.* at 514.

453. *Id.* at 515; see also Aaron Perzanowski, *Jury Awards Damages to Tattoo Artist for Video-Game Depiction — Alexander v. WWE 2K*, TECH. & MKTG. L. BLOG (Oct. 6, 2022), <https://blog.ericgoldman.org/archives/2022/10/jury-awards-damages-to-tattoo-artist-for-video-game-depiction-alexander-v-wwe-2k-guest-blog-post.htm> [<https://perma.cc/Q79H-E6LS>] (“Respect for, and celebration of, bodily autonomy is at the very core of tattooing as a social and creative practice.”).

454. See, e.g., *Solid Oak Sketches*, 449 F. Supp. 3d at 346 (holding that tattoo artists had granted their subjects an implicit, nonexclusive license).

455. 17 U.S.C. § 101 (defining public performance to include “transmit[ing] or otherwise communicat[ing] a performance or display of the work . . . to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times”).

456. Shisha, *Fairness, Copyright, and Video Games*, *supra* note 330, at 767.

457. *Id.*

458. *Id.*

and even pay hefty sums to notable gamers in exchange for streaming their games.⁴⁵⁹ Streaming, in short, is a net positive: It drives up demand for the game.⁴⁶⁰ Consequently, an inference of implied license would seem intuitive: When video game developers take steps to amplify or promote streaming, there is reason to assume that they have authorized such streams, perhaps even in cases where a game's terms of service appear to preclude streaming. The existence of an implied license would thus derive from the owners' conduct. In that way, a robust implied license framework could again empower courts to resolve complex disputes.

This Part examined how an implied license framework might be reinvigorated and brought to bear on a host of current copyright disputes — paparazzi photos, tattoos, and video game streams. In doing so, this Article draws on the polychrome and surprisingly understudied history of procedural pragmatism. It suggests that, just as courts of the nineteenth century were prepared to invoke policy objectives and leverage legal fictions in an effort to resolve complex disputes, so too should modern courts look for ways to meet current challenges by reimagining contemporary doctrine. One way to do so, I argue, is to introduce an explicit analysis of policy objectives and community norms into the implied license doctrine. That approach is not only normatively sound, but also firmly embedded in the history of copyright law.

VII. CONCLUSION

My findings underscore several lessons for modern copyright scholarship. One is descriptive: The conventional story of how courts grappled with copyright formalities is critically incomplete. In the traditional telling, early courts insisted upon strict compliance with copyright's procedural framework. But while there's some truth to that familiar narrative, a more nuanced reckoning with the history of copyright suggests that courts often used elaborate legal fictions to get over issues of procedural compliance. They did so by invoking doctrines of implicit assignment and equitable ownership in cases where the author did not comply with copyright formalities, but the publisher (or someone else) did. Sometimes courts held that the author had implicitly transferred her rights to the publisher. Occasionally they held that the rights vested in the publisher as a formal matter. That outcome, courts

459. See Sarah E. Needleman, *Top 'Live-Streamers' Get \$50,000 an Hour to Play New Videogames Online*, WALL ST. J. (May 18, 2019, 9:00 AM), <https://www.wsj.com/articles/top-live-streamers-get-50-000-an-hour-to-play-new-videogames-online-11558184421> [<https://perma.cc/7HUM-6GGT>].

460. As one video game executive recently noted, “[h]aving celebrity streamers play games is an important part of the business.” *Id.*

said, accrued to the benefit of both parties — it was the only way to prevent the author, having failed to comply with the requisite procedure, from surrendering her copyright to the public domain.

These findings yield three additional takeaways. First, viewed in proper context, the courts' procedural pragmatism was normatively defensible. It arose at a time when copyright law was fairly weak but the costs of publishing were high. Second, the doctrine of implicit assignment eventually drifted from its normative core. It then morphed into a default rule, stripping authors of their rights whenever they sold a copy of their work. Third, although early cases traded in the language of copyright ownership, they were often motivated by ideas of implied licensing — in essence, an inference that the author had implicitly granted the publisher a license to publish or use the work. Courts, of course, couldn't simply say that: They had to reframe these issues in terms of copyright ownership because that was the only way to prevent forfeiture at the hands of a noncompliant author.

Finally, there is a more systemic lesson here as well. A rigorous foray into the history of copyright doctrine could open new pathways for confronting contemporary policy questions. One example is the implied license doctrine, which has a long and largely unrecognized lineage in cases involving copyright ownership. Specifically, I argue that a reinvigorated implied license framework could be brought to bear on modern disputes, such as conflicts over ownership of paparazzi photos. In this context and many others, copyright's history can and should inform its current design.