

2008

## Toward a Functional Definition of Publication in Copyright Law

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### Recommended Citation

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## Article

# Toward a Functional Definition of Publication in Copyright Law

Thomas F. Cotter<sup>†</sup>

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<sup>†</sup> Professor of Law and Solly Robins Distinguished Research Fellow, University of Minnesota Law School. I thank David Nimmer for comments and criticism and Sharada Devarasetty, Kendra Hinton, and Phillip Kitzer for research assistance. Any errors that remain are mine. Copyright © 2008 by Thomas F. Cotter.

For almost two hundred years, U.S. law required authors to affix copyright notice to every published copy of their works of authorship, or risk forfeiting their copyright interest in those works.<sup>1</sup> Although the United States abandoned this rule as of March 1, 1989, the date on which the Berne Convention entered into force with respect to the United States,<sup>2</sup> works published prior to that date without adequate copyright notice fell into the public domain and (subject to some exceptions) remain there today.<sup>3</sup> As a result, cases continue to arise—and will continue to arise for another hundred years or so—in which defendants assert that authors forfeited their copyright interests by effecting publication, prior to March 1, 1989, without the requisite copyright notice. Recent cases in which defendants have raised the defense of pre-1989 publication without notice have involved such disparate works as Dr. Martin Luther King, Jr.'s "I Have a Dream" speech,<sup>4</sup> the popular New Age text *A Course in Miracles*,<sup>5</sup> several of Martha Graham's choreographic works,<sup>6</sup> poetry of Puerto Rico's *poeta nacional* Juan Antonio Corretjer,<sup>7</sup> a yoga sequence developed by "Yogi to the Stars" Bikram Choudhury,<sup>8</sup> and photographs by acclaimed fashion photographer Milton Greene.<sup>9</sup>

The question of whether an authorized publication occurred, and if so when and where, therefore remains relevant to

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1. See, e.g., *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 661–66 (1834); *Martha Graham Sch. & Dance Found., Inc. v. Martha Graham Ctr. of Contemporary Dance, Inc.*, 380 F.3d 624, 632–33 & n.14 (2d Cir. 2004); *Nat'l Comics Publ'ns, Inc. v. Fawcett Publ'ns, Inc.*, 191 F.2d 594, 597–98 (2d Cir. 1951); 1 WILLIAM F. PATRY, *PATRY ON COPYRIGHT* § 1:21 (2007); 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, 381–82, 388–89 (2005). Arguably, this duty to affix notice applied only to copies published in the United States and not to copies published elsewhere. See *infra* note 106 (discussing *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162, 1166 (9th Cir. 1996)).

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

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

4. See *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, 194 F.3d 1211, 1213–14 (11th Cir. 1999).

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

6. See *Martha Graham*, 380 F.3d at 630–31.

7. See *Brown v. Latin Am. Music Co.*, 498 F.3d 18, 20 (1st Cir. 2007).

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

9. See *Milton H. Greene Archives, Inc. v. BPI Commc'ns, Inc.*, 378 F. Supp. 2d 1189, 1196–97 (C.D. Cal. 2005).

the copyright status of many works of authorship created prior to 1989. But these questions remain relevant for several other reasons as well, even with respect to works created on or after March 1, 1989. Copies of a work published in the United States, for example, normally must be deposited with the Library of Congress. More importantly, the place of *first* publication can affect the eligibility of the work for *any* U.S. copyright interest at all, for copyright restoration, or for exemption from the requirement that works be registered with the U.S. Copyright Office prior to the plaintiff's commencing an action for infringement. In addition, the date of publication continues to determine such matters as the copyright term for works made for hire, anonymous works, and pseudonymous works; the time within which, for certain qualifying works, copyright owners may terminate transfers of copyright; the applicability of fair use and other defenses to copyright liability; and the availability of statutory damages and attorneys' fees, both of which remedies are conditioned upon registration of the copyright either before the infringing act begins or within a short period of time after its first publication.<sup>10</sup> This last issue in particular, relating to remedies, has immense importance with respect to works communicated to the general public, but not "published" in a more traditional sense of the term, on the Internet.

Given the continued importance of the term "publication" within U.S. copyright law, one might expect both statutory and case law to carefully define that term. The U.S. Copyright Act, however, has included a definition of the term "publication" only since January 1, 1978, the date the 1976 Copyright Act went into effect.<sup>11</sup> Cases arising today involving works allegedly published prior to 1978 therefore must rely upon more ambiguous definitions derived from pre-1978 case law. For publications allegedly occurring on or after January 1, 1978, the statutory definition provides some guidance, but it still leaves many issues, such as the status of Internet transmissions, unresolved. The confusion is best illustrated by *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, which elicited three different opinions

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10. See generally *infra* Part I.

11. See Copyright Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2541, 2543 (codified as amended at 17 U.S.C. § 101 (2000 & Supp. V 2007)) (defining publication); *id.* § 301(a), 90 Stat. at 2572 (codified as amended at 17 U.S.C. § 301(a) (2000)) (providing the Copyright Act's date of effectiveness); Leon R. Yankwich, *Some Observations on "Publication" in the Law of Copyright*, 5 BULL. COPYRIGHT SOC'Y U.S.A. 329, 330 (1958) (observing that, as of 1958, "none of the American statutes have defined publication").

from an Eleventh Circuit panel as to the proper definition of publication under the law that applied at the time Dr. King delivered his speech in 1963.<sup>12</sup> Similarly, commentators are divided on the question of whether another recent case, holding that Internet transmissions are publications under the 1976 Act, was correctly decided.<sup>13</sup>

In this Article, I make two principal claims. The first is that the rather jumbled case law involving pre-1978 publications can best be reconciled by adopting a general rule that a publication occurs when the copyright owner either (1) distributes, or offers to distribute, at least one copy of the work to the general public; or (2) actually distributes at least one tangible copy of the work to at least one person (a) who is authorized to effect or authorize a distribution to the general public, and (b) who then (either personally or through an agent) actually distributes or offers to distribute at least one copy of the work to the general public. This definition differs from the common definition of general publication, which the Ninth Circuit first articulated in *White v. Kimmell*<sup>14</sup> and courts have quoted with approval ever since. In *White*, the court held that a general publication occurs unless, inter alia, the author distributes a copy or copies to a limited group, for a limited purpose, and “without the right of diffusion, reproduction, distribution or sale.”<sup>15</sup> As I will show, despite the courts’ frequent invocation of this standard, they have declined to apply it literally when doing so would lead to perceived undesirable results.<sup>16</sup> My second claim is that the general rule I propose should be further modified in certain discrete cases, such as cases involving personal correspondence or Internet transmissions. With respect to the latter, I will argue that Internet transmissions should be equated with publications for some purposes (such as computing statutory time periods and applying the fair use defense) but not for others (such as the duty to deposit and the determination of a work’s country of origin).

Part I elaborates upon the consequences that currently flow from the fact, date, or place of publication, and thus better

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12. See *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, 194 F.3d 1211, 1214–20 (11th Cir. 1999); *id.* at 1220–27 (Cook, J., concurring in part and dissenting in part); *id.* at 1227 (Roney, J., dissenting).

13. See *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 401–02 (S.D.N.Y. 2002).

14. 193 F.2d 744 (9th Cir. 1952).

15. *Id.* at 746–47.

16. See generally *infra* Part II.4.

illustrates how publication continues to play an important role in U.S. copyright law. Part II canvases the existing case law and points to several extant ambiguities and contradictions. Part III develops my thesis that publication can and should mean different things in different contexts, depending on the underlying policies at stake.

## I. WHY PUBLICATION CONTINUES TO MATTER

Publication remains an important concept, due both to the continuing stream of copyright infringement actions involving works that may have been published without notice prior to 1989 and to the consequences that follow from publication even after that date. In this Part, I elaborate on the many effects that can stem from the fact that publication occurred, either on or before a specific date, or at a specific place. The fact that so many consequences continue to hinge on the fact, date, and place of publication may seem surprising, given the number of unresolved interpretive issues, discussed in Part III, surrounding the meaning of the term publication.

### A. CONSEQUENCES STEMMING FROM THE FACT THAT PUBLICATION OCCURRED ON OR BEFORE A SPECIFIC DATE

Historically, the most important consequence that stemmed from publication of a work was that the work lost its common-law copyright protection and gained its federal copyright protection from that date forward if, but only if, the owner complied with the requisite copyright formalities. More recent legislation has retained the significance of the date of publication for a variety of purposes, including measuring the copyright term for certain works and calculating the time within which the copyright owner must act to take advantage of other features of copyright protection. This Section discusses those consequences, keyed to the date of publication, that remain relevant today.

#### 1. The Duty to Affix Copyright Notice

Prior to enactment of the 1976 Copyright Act, the authorized publication of a work of authorship had two principal effects. First, it resulted in the forfeiture of the author's common-law copyright, which initially vested in every original work of

authorship from the moment of its creation.<sup>17</sup> Second, publication resulted in the vesting of federal statutory copyright protection, but only if every published copy bore the requisite copyright notice.<sup>18</sup> Publication without copyright notice, in other words, resulted in forfeiture of both state and federal copyright protection, resulting in the work's falling into the public domain.<sup>19</sup>

Congress modified these results in two ways when it enacted the 1976 Copyright Act.<sup>20</sup> First, the 1976 Act eliminated state common-law copyright for original works of authorship

17. See, e.g., *Caliga v. Inter Ocean Newspaper Co.*, 215 U.S. 182, 188 (1909); *Martha Graham Sch. & Dance Found., Inc. v. Martha Graham Ctr. of Contemporary Dance, Inc.*, 380 F.3d 624, 632–33 (2d Cir. 2004); *Nat'l Comics Publ'ns, Inc. v. Fawcett Publ'ns, Inc.*, 191 F.2d 594, 598 (2d Cir. 1951). Under the 1909 Copyright Act, authors *could* secure federal statutory copyright protection for unpublished works, see Copyright Act of 1909, ch. 320, § 11, 35 Stat. 1075, 1078 (repealed 1976) (“[C]opyright may also be had of the works of an author of which copies are not reproduced for sale, by the deposit, with claim of copyright, of one complete copy of such work . . . .”); Elizabeth Townsend Gard, *January 1, 2003: The Birth of the Unpublished Public Domain and Its International Implications*, 24 CARDOZO ARTS & ENT. L.J. 687, 695–96 (2006); R. Anthony Reese, *Public but Private: Copyright's New Unpublished Public Domain*, 85 TEX. L. REV. 585, 588 n.8 (2007), but the practice of obtaining federal statutory copyright for unpublished works nevertheless appears to have been uncommon.

18. See *Thompson v. Hubbard*, 131 U.S. 123, 149–50 (1889); *Callaghan v. Myers*, 128 U.S. 617, 651–52 (1888). Under the current version of the Copyright Act, copyright notice with respect to copies consists of “(1) the symbol © (the letter C in a circle), or the word ‘Copyright’, or the abbreviation ‘Copr.’; and (2) the year of first publication of the work; . . . and (3) the name of the owner of copyright in the work.” 17 U.S.C. § 401(b) (2000). The rules are the same for phonorecords, except that the notice consists of the letter P (rather than C) in a circle. See *id.* § 402(b) (2000). “Copies” are defined as “material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” *Id.* § 101 (2000 & Supp. V 2007). Moreover, “[t]he term ‘copies’ includes the material object, other than a phonorecord, in which the work is first fixed.” *Id.* Thus, under U.S. copyright law, there are, literally, no originals, only copies (or phonorecords). “Phonorecords” are defined as

material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term “phonorecords” includes the material object in which the sounds are first fixed.

*Id.*

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

20. See Copyright Act of 1976, Pub. L. No. 94-553, § 302, 90 Stat. 2541, 2572–73 (codified as amended at 17 U.S.C. § 302 (2000)).

that are fixed in a tangible medium of expression, and instead conferred federal statutory copyright upon all such works from the moment of their creation, rather than publication.<sup>21</sup> (State common-law copyright protection remains viable, though rarely enforced, for original but *unfixed* works of authorship such as improvised musical or choreographic works.)<sup>22</sup> Second, the 1976 Act softened, but did not eliminate, the rule that publication without copyright notice could result in forfeiture of federal copyright. Under the 1976 Act, forfeiture would not occur if (1) the notice was absent from only a “relatively small number of copies . . . distributed to the public”;<sup>23</sup> (2) the copyright owner registered the copyright within five years of publication without notice, and made reasonable efforts to add the notice to all copies distributed to the public in the United States after discovering the omission;<sup>24</sup> or (3) the work’s distributor made the omission in violation of an express, written condition imposed by the copyright owner.<sup>25</sup>

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

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21. See *id.* §§ 301(a), 302(a), 90 Stat. at 2572 (codified as amended at 17 U.S.C. §§ 301(a), 302(a) (2000)).

22. See *id.* § 301(b)(1), 90 Stat. at 2572 (codified as amended at 17 U.S.C. § 301(b)(1) (2000)); *United States v. Rodriguez Ramirez*, 291 F. Supp. 2d 266, 269 n.2 (S.D.N.Y. 2003). State common-law copyright also may still subsist in sound recordings that were fixed prior to 1972. See *Capitol Records, Inc. v. Naxos of Am., Inc.*, 830 N.E.2d 250, 262–64 (N.Y. 2005).

23. Copyright Act of 1976 § 405(a)(1), 90 Stat. at 2578 (codified as amended at 17 U.S.C. § 405(a)(1) (2000)).

24. *Id.* § 405(a)(2), 90 Stat. at 2578 (codified as amended at 17 U.S.C. § 405(a)(2)).

25. *Id.* § 405(a)(3), 90 Stat. at 2578 (codified as amended at 17 U.S.C. § 405(a)(3)).

26. See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853.

27. See Berne Convention for the Protection of Literary and Artistic Works art. 5(1), July 24, 1971, 1161 U.N.T.S. 31 [hereinafter *Berne Convention*].



any formality.”<sup>28</sup> Although these provisions of the Berne Convention literally obligate the United States only to eschew formalities with respect to literary and artistic works when the country of origin is not the United States—for example, works first published in another Berne Convention member state—pursuant to the Berne Convention Implementation Act of 1988, Congress eliminated mandatory copyright notice altogether, effective March 1, 1989.<sup>29</sup> Congress did not make the amendment retroactive, however—although legislation enacted a few years later makes the amendment *potentially* retroactive with respect to *some* works of authorship, the country of origin of which is not the United States.<sup>30</sup> Thus, cases continue to arise in which copyright defendants argue, sometimes successfully, that the plaintiff’s U.S. copyright lapsed due to its publication without the requisite copyright notice prior to March 1, 1989.<sup>31</sup>

In addition, although the omission of copyright notice from published copies of a work on or after March 1, 1989, no longer results in copyright forfeiture, if the defendant had access to a copy or copies that included a copyright notice, the court will accord no weight to a “defendant’s interposition of a defense based on innocent infringement in mitigation of actual or statutory damages, except as provided in the last sentence of section 504(c)(2).”<sup>32</sup> Furthermore, if the defendant proves that he innocently relied upon, and was misled by, the omission of notice from copies or phonorecords publicly distributed with the consent of the copyright owner prior to March 1, 1989, he incurs no liability for actual or statutory damages for any acts committed before receipt of actual notice that registration has been effected.<sup>33</sup>

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28. *Id.* art. 5(2).

29. Berne Convention Implementation Act § 7(a), 102 Stat. at 2857 (codified as amended at 17 U.S.C. §§ 401(a), 402(a) (2000)).

30. See *infra* text accompanying notes 98–103.

31. See *supra* text accompanying notes 4–9.

32. 17 U.S.C. § 401(d) (2000); see also *id.* § 402(d) (2000). It seems doubtful, however, that the “interposition of a defense based on innocent infringement” *could* mitigate actual, as opposed to statutory, damages, with respect to a work published on or after March 1, 1989; there is nothing in the Copyright Act that would appear to permit this. See 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.02[C][3] (2007).

33. See 17 U.S.C. § 405(b) (2000).

## 2. Measuring the Copyright Term

Another respect in which publication remains significant is that the Copyright Act sometimes measures the term of copyright, or the date on which certain other benefits accruing to the copyright owner terminate, from the date of first publication. Historically, federal statutory copyright protection vested at the moment of publication, and thereafter subsisted for a set period of years.<sup>34</sup> Under the 1909 Copyright Act, for example, the standard term of protection consisted of a first term of twenty-eight years, which the author had the option of renewing for a second twenty-eight-year term.<sup>35</sup> Beginning in 1962, however, Congress passed a series of bills extending the copyright term, for works that were then in their second term of protection and the copyrights to which were about to expire,<sup>36</sup> for an additional nineteen years, thus conferring an overall term of seventy-five years from the date of publication upon the works so qualifying.<sup>37</sup> Upon enactment of the 1976 Act, all works that were both created and published prior to January 1, 1978, and that had not yet fallen into the public domain as of that date, were accorded a term of seventy-five years, later extended to ninety-five years, from the date of publication.<sup>38</sup> Works created but not published prior to January 1, 1978, which had not yet fallen into the public domain as of that date,

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34. See *supra* notes 17–19 and accompanying text.

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

36. See H.R. REP. NO. 94-1476, at 134 n.1 (1976) (citing Pub. L. Nos. 87-668, 89-142, 90-141, 90-416, 91-147, 91-555, 92-170, 92-566, and 93-573), as reprinted in 1976 U.S.C.C.A.N. 5659, 5750 n.1.

37. See JULIE E. COHEN ET AL., COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 154–56 (2d ed. 2006) (discussing the evolution of U.S. copyright law).

38. In 1998, Congress extended the copyright term for all works that had not yet fallen into the public domain by another twenty years. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified as amended in scattered sections of 17 U.S.C.). Thus, as of January 1, 1978, works that were in their first term of copyright were eligible for a second term of forty-seven (later extended to sixty-seven) years, provided that the owner timely claimed the renewal term. See 17 U.S.C. § 304(a)(1)(B)–(C) (2000). For works already in their second term of copyright as of January 1, 1978, Congress extended the renewal term by nineteen, later thirty-nine, years, for a grand total of ninety-five years from the date copyright was originally secured. See *id.* § 304(b) (2000).

were accorded a term that under some circumstances could be extended further if the owner chose to publish the work.<sup>39</sup> Most works created on or after January 1, 1978, were accorded a copyright term consisting of the life of the author plus fifty (later extended to seventy) years.<sup>40</sup>

For three classes of works created on or after January 1, 1978, however, the copyright term is instead sometimes measured from the date of publication rather than creation. Specifically, the 1976 Act mandated that the copyright term for anonymous works, pseudonymous works, and works made for hire would comprise seventy-five years from the date of first publication or a hundred years from the date of creation—later extended to 95 years from publication or 120 years from creation—whichever expires first.<sup>41</sup> Other countries' laws also occasionally use the date of publication, or making available to the public, as the event from which the copyright term is measured, at least for certain classes of works.<sup>42</sup> Further, for works created on or after January 1, 1978, U.S. law recognizes a statutory presumption that the author is dead 95 years from the date of first publication, or 120 years from the date of creation,

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39. As noted above, prior to January 1, 1978, unpublished works enjoyed a potentially perpetual state common-law copyright. Upon publication, however, those works were thrust into the public domain unless the owner included the copyright notice on all published copies. See *supra* notes 17–18 and accompanying text. As of January 1, 1978, all original and fixed works were accorded federal copyright protection from the moment of creation. Works already in existence as of that date, but not yet copyrighted or in the public domain, were accorded a federal copyright as of January 1, 1978, that would subsist for the life of the author plus fifty (later extended to seventy) years or to December 31, 2002 (i.e., a minimum twenty-five-year federal copyright term), whichever expired later. See 17 U.S.C. § 303 (2000). Publication before December 31, 2002, extended the copyright term for another twenty-five (later extended to forty-five) years, until December 31, 2047. See *id.*

40. See 17 U.S.C. § 302(a) (2000).

41. See *id.* § 302(c) (2000). A work made for hire is any work made by an employee within the scope of his employment, or any of nine types of specially commissioned works if the parties agreed in writing that the work was to be a work for hire. See *id.* § 101 (2000 & Supp. V 2007). The act deems the author of a work made for hire to be the employer or commissioning party. See *id.* § 201(b) (2000). Note also that two types of specially commissioned works that can constitute works made for hire, namely supplementary works and instructional texts, are defined such that only works “prepared for publication” can so qualify. See *id.* § 101.

42. See, e.g., Council Directive 93/98/EEC, art. 1(3), 1993 O.J. (L 290) 9, 11 (EC) (stating that the term of protection for anonymous or pseudonymous works “shall run for seventy years after the work is lawfully made available to the public”).

whichever expires first.<sup>43</sup> This presumption can be useful for determining whether the copyright (which, again, for works other than works for hire and anonymous and pseudonymous works, subsists for seventy years following the author's death) is still in force.<sup>44</sup> Publication therefore remains and will remain a relevant date for determining the protectability of a large number of works.

### 3. Triggering Other Relevant Time Periods

The date of first publication also continues to serve as the focal point from which other time periods, within which the copyright owner must act if she wishes to enjoy certain other statutory benefits, are calculated. To put these matters in context, it may be helpful to note first three default rules that apply under U.S. copyright law, absent their displacement by other rules. First, the plaintiff in a copyright infringement action must prove, among other things, that she owns a valid copyright.<sup>45</sup> Second, to recover monetary damages, the plaintiff must prove either her own lost profits or the defendant's profits attributable to the infringement; and, in accordance with the American rule, each party presumptively bears her own attorneys' fees.<sup>46</sup> Third, copyright owners may freely transfer or assign their copyright rights, in whole or in part,<sup>47</sup> as long as the transfer (other than a transfer effected by operation of law) is memorialized in a writing signed by the owner or her agent.<sup>48</sup>

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43. 17 U.S.C. § 302(e) (2000).

44. The statute provides for a registry in which persons claiming an interest in a copyright may record the author's death or a statement that he is still alive. *See id.* § 302(d) (2000). After 95 years from the date of publication, or 120 years from the date of creation, whichever expires first, an author will be presumed dead for the past 70 years, if the Copyright Office certifies that its § 302(d) registry discloses nothing to indicate that the author is still alive or has died within the last 70 years. *See id.* § 302(e).

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

46. *See* 17 U.S.C. § 504(b)–(c) (2000 & Supp. V 2007); *Woodhaven Homes & Realty, Inc. v. Hotz*, 396 F.3d 822, 824 (7th Cir. 2005).

47. *See* 17 U.S.C. § 201(d)(1)–(2) (2000).

48. *Id.* § 204(a) (2000). A purported transfer that does not comply with the writing requirement is deemed to be a license—that is, a nonexclusive permission to use. *See I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775 (7th Cir. 1996) (describing a nonexclusive license as the negative implication of the statutory written requirement for copyright transfer). Transfers of common-law copyrights, by contrast, do not have to be memorialized in writing. *Martha Graham Sch. & Dance Found., Inc. v. Martha Graham Ctr. of Contemporary Dance, Inc.*, 380 F.3d 624, 643 (2d Cir. 2004). Whether a work was published without copyright

All three of these rules can be displaced, to the benefit of the copyright owner, if she takes certain requisite steps, either before or within a specified time from the date of first publication.

The first and second of these default rules, relating to validity, ownership, and entitlement to monetary damages, are modified in the copyright owner's favor if she registers her copyright with the U.S. Copyright Office no later than a specified time period following the date of first publication. Registration is not required as a precondition to the mere *existence* of copyright protection,<sup>49</sup> although (subject to a handful of exceptions) registration generally *is* required as a precondition to commencing an action for copyright infringement.<sup>50</sup> An owner who chooses to register her copyright either before or within five years after her work's first publication, however, is entitled to a rebuttable presumption of validity and ownership.<sup>51</sup> This

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notice therefore can determine not only whether the copyright remains in existence, but also whether a purported oral transfer of the copyright was effective. *See id.* at 643–45.

49. *See* 17 U.S.C. § 408(a) (2000) (“[R]egistration is not a condition of copyright protection.”).

50. *Id.* § 411(a) (2000 & Supp. V 2007). There are four exceptions to this rule. First, the registration requirement only applies to “United States works.” *Id.*; *see infra* notes 82–91 and accompanying text. Second, if the Copyright Office refuses to register the work, the purported copyright owner may file suit nonetheless, as long as she serves notice upon the Register of Copyright. 17 U.S.C. § 411(a). Third, authors claiming violations of their moral rights, in violation of Copyright Act § 106A(a), are also exempted from the registration requirement. *Id.*; *see id.* § 106A(a) (2000). Fourth, in a small class of cases involving works consisting of sounds, images, or both, that are first fixed in a tangible medium of expression simultaneously with their transmission, the copyright owner may file suit if she (1) “serves notice upon the infringer, not less than 48 hours before such fixation, identifying the work and the specific time and source of its first transmission, and declaring an intention to secure copyright in the work;” and (2) registers the copyright within three months of its first transmission. *See id.* § 411(b) (2000); *see also id.* § 101 (2000 & Supp. V 2007). For a discussion of § 411(a), *see* 2 NIMMER & NIMMER, *supra* note 32, § 7.16[B][3]. A recent amendment to the Copyright Act permits the preregistration of certain works intended for commercial distribution but not yet published. *See* 17 U.S.C. § 408(f) (Supp. V 2007); *see also infra* note 62.

51. 17 U.S.C. § 410(c) (2000). The evidentiary weight accorded to a certificate or registration issuing more than five years after first publication is within the discretion of the district court. *Id.* Having registered the copyright, the owner also may record the registration with the U.S. Customs Service. 19 C.F.R. § 133.31 (2007). Recordation of a work in the name of a person seeking exclusion of imported goods, on the ground that the importation would violate 17 U.S.C. § 602, can provide evidence that the copyright is valid and would be infringed by the unauthorized importation. *See* 17 U.S.C. § 603(b) (2000) (describing what proof may be required to exclude such importation); *see also* 19

means that, in the event the registrant files suit for infringement, the burden of proving that the copyright is invalid or is owned by someone other than the registrant would fall upon the alleged infringer.

In addition, for works created and published prior to January 1, 1978, and within their first term of copyright as of that date, renewal for the second copyright term (comprising, since 1998, sixty-seven years) has been automatic since 1992.<sup>52</sup> The statute nevertheless directs that the person or persons entitled to the renewal term<sup>53</sup> *may* file an application to register a claim to the renewal term.<sup>54</sup> If the application is filed within one year before the expiration of the original term, and the claim is registered, the renewal term vests in the person who was entitled to claim the renewal term at the time the application was filed.<sup>55</sup> Otherwise, it vests in the person who owned the copyright on the last day of the original term.<sup>56</sup> A certificate of registration of the renewal term made pursuant to an application filed within the aforementioned one-year period serves as “prima facie evidence as to the validity of the copyright during its renewed and extended term and of the facts stated in the certificate.”<sup>57</sup> Moreover, unless such a claim is made and registered within this one-year period, the author of “a derivative work prepared under authority of a grant of a transfer or license of the copyright that is made before the expiration of the original term of copyright may continue” to exploit the derivative work during the renewal term on the same terms as applied during

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C.F.R. § 133.43 (2007) (detailing the procedure to be employed when a copyright owner suspects the importation of infringing copies).

52. See *supra* notes 35, 38.

53. 17 U.S.C. § 304(a)(1)(B)–(C) (2000) (clarifying who is entitled to the renewal term).

54. *Id.* § 304(a)(3) (stating that such an application is not required for an extension).

55. *Id.* § 304(a)(2)(A)(i)–(ii).

56. *Id.* No claims to the renewal term made on or after January 1, 2006, will have this effect, however, because any works that were within their first term of copyright as of January 1, 1978, necessarily are in their second term, if any, as of January 1, 2006—i.e., twenty-eight years from the last possible date on which the first-term copyright was initially secured. See Registration of Claims to Copyright—Renewals, 72 Fed. Reg. 16,306–07 (proposed Apr. 4, 2007) (to be codified at 37 C.F.R. pt. 202) (describing that after 1992 renewal could “vest without registration”). Questions nevertheless will arise into the foreseeable future concerning whether persons entitled to file claims to renewal terms prior to January 1, 2006, in order to obtain the statutory benefits mentioned above, properly did so.

57. 17 U.S.C. § 304(a)(4)(B).

the original term.<sup>58</sup> All of these matters relating to the filing of a claim to the renewal term within one year of the expiration of the original term, of course, hinge upon when the original term expires. When the original term expires depends upon when the term commenced—i.e., in the case of a published work, when the work was published.<sup>59</sup>

Furthermore, copyright plaintiffs can avoid having to prove actual damages or defendants' profits and can more readily recover attorneys' fees, if they have timely registered their copyrights. Specifically, prevailing copyright plaintiffs may recover so-called statutory damages, ranging from \$750 to \$30,000 for each work infringed,<sup>60</sup> as well as attorneys' fees,<sup>61</sup> only if they have registered their copyrights either before the infringement began (in the case of an unpublished work) or before the in-

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58. See *id.* § 304(a)(4)(A). Otherwise, the derivative work author's continued exploitation of the derivative work during the renewal term for the underlying work would infringe the copyright in the underlying work. See *Venegas-Hernandez v. Peer*, Nos. Civ. 01-1215(JAF), 01-2186(JAF), 2004 WL 3686337, at \*24 (D.P.R. May 19, 2004), *rev'd on other grounds*, 424 F.3d 50 (1st Cir. 2005).

59. 17 U.S.C. § 305 (2000) ("All terms of copyrights provided by sections 302 through 304 run to the end of the calendar year[, i.e., December 31,] in which they would otherwise expire."); see *supra* text accompanying notes 34–40.

60. 17 U.S.C. § 504(c)(1) (2000 & Supp. V 2007). In the event of a willful infringement, the court may increase an award of statutory damages up to \$150,000 for each work infringed. *Id.* § 504(c)(2). If the court finds that the infringement was innocent, it may reduce an award of statutory damages to as little as \$200 for each work infringed. *Id.* Publication is relevant to this last-cited provision, insofar as the presence of copyright notice "on the *published* copy or copies to which a defendant in a copyright infringement suit had access" results in no weight being given to the "defendant's interposition of a defense based on innocent infringement in mitigation of actual or statutory damages." *Id.* § 401(d) (2000) (emphasis added); see also *id.* § 402(d) (2000) (stating the same rule for published phonorecords); *id.* § 405(b) (2000) (stating that innocent infringers will not be held liable for actual or statutory damages if they are able to prove that they were misled by a copy or phonorecord that did not have an attached copyright notice before the effective date of the Berne Convention Implementation Act of 1988). An exception to *this* rule, which exception can result in the remission of statutory damages altogether, occurs when the defendant had reasonable (but erroneous) grounds for believing her use was a fair use; this exception is available, however, only if, *inter alia*, the defendant is employed by a nonprofit educational institution, library, archive, or public broadcasting entity. *Id.* § 504(c)(2).

61. See 17 U.S.C. § 505 (2000) ("Except as otherwise provided by this title, the court may also award a reasonable attorney's fee to the prevailing party as part of the costs."); see also *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 534 (1994) (holding that, in copyright cases, courts should award attorneys' fees in an even-handed manner, and that fee awards are discretionary, not automatic).

fringement began or within three months of first publication (in the case of published works).<sup>62</sup> According to the legislative history of the 1976 Act, the general purpose of these rules is to encourage copyright owners to provide public notice of their claims to copyright.<sup>63</sup> The specific purpose of the three-month grace period for published works is to “take care of newsworthy or suddenly popular works which may be infringed almost as soon as they are published, before the copyright owner has had a reasonable opportunity to register his claim.”<sup>64</sup>

The practical importance of these rules can be illustrated by way of an example. Suppose that Author *A* creates a work and immediately posts it on his website on February 2, 2007. Defendant *D* begins infringing the work on February 10, 2007. Author *A* then applies to register his copyright on February 26, 2007, and obtains a certificate of registration on May 1, 2007, effective February 26, 2007.<sup>65</sup> If the initial Internet posting constitutes a publication, Author *A* has registered the work within three months of publication. Assuming he prevails in his copyright infringement action against *D*, he may obtain statutory damages of up to \$30,000 as well as, possibly, attorneys’ fees.<sup>66</sup> If the posting does not constitute publication, however, and Author *A* has not otherwise timely published the work as of the date of infringement, he will be relegated to his actual

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62. 17 U.S.C. § 412 (2000 & Supp. V 2007). There are a few exceptions to this rule. First, authors claiming violations of their moral rights under § 106A(a) may recover statutory damages and attorneys’ fees without having registered. *See id.* Second, a recent amendment to the Copyright Act provides for the preregistration of certain works intended for commercial distribution but not yet published and which fall into a class of works that the Register of Copyright determines has a history of infringement prior to authorized commercial distribution. *See id.* § 408(f)(1)–(2) (Supp. V 2007).

63. H.R. REP. NO. 94-1476, at 158 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5774.

64. *Id.*

65. Although it can take a few months to obtain a registration, *see* U.S. Copyright Office, Registering a Work, <http://www.copyright.gov/help/faq/faq-register.html> (last visited Apr. 27, 2008), once granted, the effective date of the registration is the date “an application, deposit, and fee . . . have all been received in the Copyright Office,” 17 U.S.C. § 410(d) (2000).

66. *See* *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002); *see also* *Zito v. Steeplechase Films, Inc.*, 267 F. Supp. 2d 1022, 1025–26 (N.D. Cal. 2003) (holding that no statutory damages or attorneys’ fees were recoverable, where infringement occurred prior to publication and more than three months before registration, and that infringement itself does not constitute publication, because publication must be authorized by the copyright owner).



damages or defendant's profits, which may be de minimis,<sup>67</sup> and he cannot recover his attorneys' fees either.

The third default rule, relating to transferability of copyright rights, is also subject to modification in a way that potentially can operate for the benefit of copyright owners, though again only if the owner takes certain affirmative steps within a time period that is (often) measured from the date of first publication. This modification can occur in one of two ways. First, authors (or their statutory heirs) have a nonwaivable right<sup>68</sup> to terminate transfers of copyright effected prior to January 1, 1978, during a five-year period of time beginning either fifty-six years from the date on which copyright was secured, or on January 1, 1978, whichever is later.<sup>69</sup> Prior to January 1, 1978, the date on which federal statutory copyright was "secured" is usually the date of first publication.<sup>70</sup> Second, authors (or their statutory heirs) have a nonwaivable right<sup>71</sup> to terminate transfers effected on or after January 1, 1978, during a five-year period beginning either (1) thirty-five years from the date of the transfer or (2) "if the grant covers the right of publication of the work," thirty-five years from the date of first publication or forty years from the date of transfer, whichever ends earlier.<sup>72</sup>

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67. See, e.g., *On Davis v. Gap, Inc.*, 246 F.3d 152, 161 (2d Cir. 2001) (suggesting that the plaintiff may have been entitled to actual damages totaling only \$50).

68. 17 U.S.C. § 304(c)(5) (2000 & Supp. V 2007).

69. See *id.* § 304(c)(3). The logic of this rule is that authors have a better equitable claim than do their assignees to the windfall benefit of the nineteen-year extension of copyright protection afforded to works still under copyright protection as of January 1, 1978. William F. Patry, *The Copyright Term Extension Act of 1995: Or How Publishers Managed to Steal the Bread from Authors*, 14 CARDOZO ARTS & ENT. L.J. 611, 690–91 (1996). The rule does not apply to works made for hire, however, or to transfers effected by will. See 17 U.S.C. § 304(c). Note also that, when Congress enacted the Sonny Bono Copyright Term Extension Act in 1998, it provided that the author or owner of a termination right that had expired without being exercised would have a second chance to exercise that right during the five-year period beginning seventy-five years from the date on which copyright was secured. See *id.* § 304(d) (2000).

70. See *supra* text accompanying notes 36–41.

71. 17 U.S.C. § 203(a)(5) (2000).

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

#### 4. Fair Use and Other Exceptions

A work's status as a published work, prior to the date of a defendant's alleged act of infringement, also renders the work somewhat more vulnerable to a handful of defenses, including fair use. The fair use doctrine permits the unauthorized use of a copyrighted work in a variety of circumstances.<sup>73</sup> Among the factors courts take into account in determining whether a use is fair is the "nature of the work,"<sup>74</sup> and one aspect of the nature of the work that courts take into account is whether the work is published or unpublished.<sup>75</sup> In the wake of the Supreme Court's decision in *Harper & Row Publishers, Inc. v. Nation Enterprises*, some courts appeared to view the unpublished nature of a work as being almost dispositive in favor of the copyright plaintiff.<sup>76</sup> In reaction to these decisions, Congress amended section 107 in 1992 by adding the now-final sentence: "The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors."<sup>77</sup> Courts nevertheless continue to consider the unpublished nature of the work as a factor weighing in favor of the plaintiff,<sup>78</sup> due both to the perceived value in protecting personal privacy<sup>79</sup> and to the economic value to the author of being able to time the publication of her work.<sup>80</sup> A few other copyright

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73. See 17 U.S.C. § 107 (2000); Thomas F. Cotter, *Fair Use and Copyright Overenforcement* 6–17 (Univ. of Minn. Law Sch. Legal Studies Research Paper Series, Research Paper No. 06-96, 2006), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=951839](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=951839).

74. See 17 U.S.C. § 107.

75. See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 564, 569 (1985) (holding that a work's status as an unpublished work militates against the unauthorized use being a fair use); Pierre Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1120 (1990).

76. See *New Era Publishers Int'l, ApS v. Henry Holt & Co., Inc.*, 873 F.2d 576, 583 (2d Cir. 1989); *Salinger v. Random House, Inc.*, 811 F.2d 90, 97 (2d Cir. 1987). But see *Wright v. Warner Books, Inc.*, 953 F.2d 731, 737–38 (2d Cir. 1991) (concluding that this factor was not dispositive).

77. 17 U.S.C. § 107.

78. See *Wright*, 953 F.2d at 737; *Sandoval v. New Line Cinema Corp.*, 973 F. Supp. 409, 413 (S.D.N.Y. 1997), *aff'd*, 147 F.3d 215 (2d Cir. 1998); see also Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549, 612–15 (2008) (discussing the inquiry surrounding a work's publication status).

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

80. See *Harper & Row*, 471 U.S. at 554–55 (discussing the importance of an author's control of the timing of publication).

exceptions of more limited applicability also are available only to users of published works.<sup>81</sup>

## B. CONSEQUENCES STEMMING FROM THE PLACE OF PUBLICATION

The place where publication occurs, or first occurs, also can be important for a variety of reasons. To cite one example, U.S. copyright law requires the copyright owner to deposit with the Library of Congress two copies of most works that are published in the United States,<sup>82</sup> although failure to comply with

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81. See 17 U.S.C. § 108(b) (2000) (permitting libraries and archives to reproduce and distribute “three copies or phonorecords of an unpublished work duplicated solely for purposes of preservation and security or for deposit for research use in another library or archives,” subject to certain conditions); *id.* § 108(c) (2000) (permitting libraries and archives to reproduce “three copies or phonorecords of a published work . . . that is damaged, deteriorating, lost, or stolen, or if the existing format in which the work is stored has become obsolete,” subject to certain conditions); *id.* § 108(h) (2000) (permitting libraries and archives to copy, distribute, display, or perform a published work “for purposes of preservation, scholarship, or research,” during the last twenty years of copyright protection, subject to certain conditions); *id.* § 108(i) (2000 & Supp. V 2007) (stating the limitations of the preceding three exceptions); *id.* § 110(9) (2000 & Supp. V 2007) (permitting the unauthorized “performance on a single occasion of a dramatic literary work published at least ten years before the date of the performance, by or in the course of a transmission specifically designed for and primarily directed to blind or other handicapped persons,” subject to certain conditions); *id.* § 118(b) (2000 & Supp. V 2007) (permitting “owners of copyright in published nondramatic musical works and published pictorial, graphic, and sculptural works and any public broadcasting entities” to negotiate for compulsory license fees for certain uses by public broadcasters, subject to certain conditions); *id.* § 121(a) (2000) (permitting the reproduction and distribution of “copies or phonorecords of . . . previously published, nondramatic literary work[s] . . . in specialized formats exclusively for use by blind or other persons with disabilities,” subject to certain conditions); *id.* § 1201(g)(2) (2000) (permitting circumvention of technological measures “as applied to a copy, phonorecord, performance, or display of a published work in the course of an act of good faith encryption research,” subject to certain conditions).

82. See 17 U.S.C. § 407(a)–(b) (2000) (requiring the copyright owner or owner of the exclusive right of publication, within three months of publication of a work in the United States, to deposit “in the Copyright Office for the use or disposition of the Library of Congress” two complete copies or phonorecords of the best edition of the work). The statute permits the Copyright Office to exempt certain classes of works from this requirement. See *id.* § 407(c) (2000). Among the works the Copyright Office exempts are stationery, greeting cards, tests, 3-D sculptural works, works only reproducible on dolls or in jewelry, certain catalogs, architectural blueprints, and lectures published individually. See 37 C.F.R. § 202.19(c) (2007). Note that deposit is also required in order to register one’s copyright, 17 U.S.C. § 408(b) (2000), subject to certain exceptions, *id.* § 408(c) (2000), and that copies deposited for the Library of Congress may satisfy this requirement, *id.* § 408(b).

the deposit requirement results only in a fine, not forfeiture of copyright.<sup>83</sup> More importantly, *first* publication of a work within the United States typically imposes a duty to register the copyright before commencing an action for infringement. More precisely, section 411 of the Copyright Act specifies that, subject to certain exceptions, the owner of a "United States work" must register the copyright before instituting a civil action for infringement.<sup>84</sup> A *published* work is a United States work if

the work is first published—

(A) in the United States;

(B) simultaneously in the United States and another treaty party or parties, whose law grants a term of copyright protection that is the same as or longer than the term provided in the United States;

(C) simultaneously in the United States and a foreign nation that is not a treaty party; or

(D) in a foreign nation that is not a treaty party, and all of the authors of the work are nationals, domiciliaries, or habitual residents of, or in the case of an audiovisual work legal entities with headquarters in, the United States.<sup>85</sup>

The statute defines a "treaty party" as "a country or inter-governmental organization other than the United States that is a party to an international agreement."<sup>86</sup> An "international agreement" includes "(1) the Universal Copyright Convention; (2) the Geneva Phonograms Convention; (3) the Berne Convention; (4) the WTO Agreement; (5) the WIPO Copyright Treaty; (6) the WIPO Performances and Phonograms Treaty; and (7) any other copyright treaty to which the United States is a party."<sup>87</sup> An unpublished work is a United States work if "all the

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83. See 17 U.S.C. § 407(d) (2000).

84. *Id.* § 411(a) (2000 & Supp. V 2007); see also *supra* note 62 (discussing two of the three exceptions to this rule).

85. 17 U.S.C. § 101 (2000 & Supp. V 2007).

86. *Id.*

87. *Id.* The statute further defines the Geneva Phonograms Convention as "the Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms, concluded at Geneva, Switzerland, on October 29, 1971"; the Berne Convention as "the Convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland, on September 9, 1886, and all acts, protocols, and revisions thereto"; the World Intellectual Property Organization (WIPO) Copyright Treaty (WCT) as "the WIPO Copyright Treaty concluded at Geneva, Switzerland, on December 20, 1996"; and the WIPO Performances and Phonograms Treaty (WPPT) as "the WIPO Performances and Phonograms Treaty concluded at Geneva, Switzerland, on December 20, 1996." *Id.* The World Trade Organization (WTO) Agreement has "the meaning[] given . . . in paragraph[] (9) . . . of section 2 of the Uruguay Round Agreements Act," *id.*, namely "the Agreement Establishing the World Trade Organization entered into on April 15, 1994," Uruguay Round Agree-

authors of the work are nationals, domiciliaries, or habitual residents of the United States, or, in the case of an unpublished audiovisual work, all the authors are legal entities with headquarters in the United States.”<sup>88</sup> Pictorial, graphic, or sculptural works incorporated into buildings or structures located in the United States are also United States works.<sup>89</sup> Because the definition of “United States work” more or less tracks the definition of “country of origin” in the Berne Convention,<sup>90</sup> the effect is to exempt works the country of origin of which is not the United States from the registration requirement. This exemption conforms to Berne Convention article 5(2), which, as noted above, literally requires only that the exercise and enjoyment of copyright rights not be subject to formalities when the country of origin of a work is a country other than the country within which protection is sought.<sup>91</sup>

In addition, determining where a work was first published also can sometimes establish whether the work qualifies for copyright protection within the United States *at all*. According to section 104 of the Copyright Act, U.S. copyright subsists in all original *unpublished* works of authorship, fixed in a tangible medium of expression, regardless of the author’s nationality or domicile.<sup>92</sup> In other words, U.S. copyright subsists in unpublished works (assuming those works are original and fixed) from the moment of creation, wherever those works happen to be created. Upon publication, however, U.S. copyright continues to subsist in the work only if one or more of the following conditions is met. First, a published work is subject to U.S. copyright if, “on the date of first publication, one or more of the authors is a national or domiciliary of the United States, or is a

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ments Act, Pub. L. No. 103-465, § 2(9), 108 Stat. 4809, 4814 (1994) (codified as amended at 19 U.S.C. § 3501 (2000 & Supp. III 2005)). The WTO Agreement therefore includes the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). See Marrakesh Agreement Establishing the World Trade Organization art. 4, § 5, Apr. 15, 1994, 1867 U.N.T.S. 157; Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 108 Stat. 4809, 1869 U.N.T.S. 299 [hereinafter TRIPs Agreement]. The Copyright Act does not define the Universal Copyright Convention (UCC). See 17 U.S.C. § 101.

88. 17 U.S.C. § 101.

89. *Id.*

90. See Berne Convention, *supra* note 27, art. 5(4). I say “more or less” because the word “published” does not necessarily have the same meaning under the Berne Convention as it does under U.S. domestic law. See *infra* note 103.

91. See *supra* notes 28–29 and accompanying text.

92. See 17 U.S.C. § 104(a) (2000).

national, domiciliary, or sovereign authority of a treaty party, or is a stateless person, wherever that person may be domiciled.”<sup>93</sup> Alternatively, a published work can be subject to U.S. copyright protection if it “is first published in the United States or in a foreign nation that, on the date of first publication, is a treaty party”; if “the work is a sound recording that was first fixed in a treaty party”; if “the work is a pictorial, graphic, or sculptural work that is incorporated into a building or other structure, or an architectural work that is embodied in a building and the building or structure is located in the United States or a treaty party”; or “the work is first published by the United Nations or any of its specialized agencies, or by the Organization of American States.”<sup>94</sup> The upshot is that if the author of a work is not a national or domiciliary of the United States, the work loses its U.S. copyright protection if it is first published in a nontreaty party. Novels first published in Iran or Iraq, for example, neither of which currently are parties to any interna-

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93. *Id.* § 104(b)(1) (2000).

94. *Id.* § 104(b)(2)–(5). Note that “a work that is published in the United States or a treaty party within 30 days after publication in a foreign nation that is not a treaty party shall be considered to be first published in the United States or such treaty party, as the case may be.” *Id.* § 104(b). This provision is consistent with Berne Convention article 5(4)(b), which provides that the country of origin for works “published simultaneously in a country outside the Union and in a country of the Union” shall be the Union country. Berne Convention, *supra* note 27, art. 5(4)(b). Article 3(4) states that “[a] work shall be considered as having been published simultaneously in several countries if it has been published in two or more countries within thirty days of its first publication.” *Id.* art. 3(4). Finally, a published work can be subject to U.S. copyright protection if the work comes within the scope of a presidential proclamation as specified in the statute. *See* 17 U.S.C. § 104(b)(6).

Apropos of “an architectural work that is embodied in a building . . . located in the United States or a treaty party,” *id.* § 104(b)(4), protection for architectural works applies to

any architectural work that, on the date of the enactment of [the Architectural Works Copyright Protection Act], is unconstructed and embodied in *unpublished* plans or drawings, except that protection for such architectural work under title 17, United States Code, by virtue of the amendments made by this title, shall terminate on December 31, 2002, unless the work is constructed by that date,

Architectural Works Copyright Protection Act, Pub. L. No. 101-650, 104 Stat. 5089, 5134 (1990) (codified as amended in scattered sections of 17 U.S.C.) (emphasis added). The fact and date of publication of plans or drawings therefore may continue to play a role in determining the protectability of some architectural works.

tional copyright treaty,<sup>95</sup> may fit within this category unless they were simultaneously published in a treaty party.<sup>96</sup>

Nevertheless, under some circumstances it is possible for U.S. copyrights that were forfeited due to lack of national eligibility—or due to the copyright owner's failure to comply with mandatory U.S. copyright formalities prior to the U.S. adherence to the Berne Convention—to be restored. In determining whether a work is eligible for restoration, however, the issue of where a work was first published again becomes crucial. Upon U.S. adherence to the World Trade Organization (WTO) in 1994, Congress enacted Copyright Act section 104A,<sup>97</sup> which restores copyrights to qualifying works of authorship subject to several conditions. Specifically, section 104A restores copyrights in works whose country of origin is a member of an international copyright agreement, other than the United States, and which would still be under copyright protection under U.S. law but for the owner's failure to comply with formalities that were once required (such as publication with notice or copyright renewal) or previous lack of national eligibility under section 104.<sup>98</sup> To qualify for copyright restoration, a published work must (among other things) have been "first published in an eligible country and not published in the United States during the 30-day period following publication in such eligible country."<sup>99</sup> In addition, the work may not be in the public domain in its source country through expiration of the term of protection.<sup>100</sup> In the case of a published work, the source country is the eligible country in which the work was first published, or if published on the same day in two or more eligible countries, the eligible country with the most significant con-

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95. See *supra* note 87.

96. Saddam Hussein reportedly published at least four novels during his lifetime. See Jo Tatchell, *Saddam the Romancier*, PROSPECT, July 2004, at 72, 72, available at <http://www.prospect-magazine.co.uk/pdfarticle.php?id=6171>. Assuming that the original, Arabic-language versions of these works were originally published in Iraq, their U.S. copyright status would depend upon whether they were simultaneously published in some other country with which the United States enjoys copyright treaty relations.

97. COHEN ET AL., *supra* note 37, at 151.

98. See 17 U.S.C. § 104A(a), (h)(3), (h)(6) (2000 & Supp. V 2007).

99. *Id.* § 104A(h)(6)(D). According to the statute, unpublished works also are subject to copyright restoration. See *id.* § 104A(h)(8)(B). There appear to be only a few situations in which this provision might apply, however. See 3 NIMMER & NIMMER, *supra* note 32, § 9A.04[A][2] n.31.

100. See 17 U.S.C. § 104A(h)(6)(B).

tacts.<sup>101</sup> An eligible country is a country other than the United States that becomes a member of the WTO on or after December 8, 1994; or on or after that date becomes a party to the Berne Convention, the WIPO Copyright Treaty, or the WIPO Performances and Phonograms Treaty; or after that date becomes subject to a relevant presidential proclamation.<sup>102</sup> Some potential conflict of laws issues lurking within the statute (for example, which country's definition of "published" applies in determining whether a work was first published in an eligible country) have yet to be litigated.<sup>103</sup>

A few hypotheticals help to illustrate how the preceding rules can have practical consequences. First, suppose that Author A, a citizen and resident of France, first made his original, fixed work of authorship available to some members of the public in France, and nowhere else, in December 1970. He next made it available in the United States in March 1971, but he omitted the copyright notice from all tangible copies. If the "making available" of the work of authorship constituted a publication, then the omission of copyright notice resulted in the forfeiture of U.S. copyright (although the copyright might be subject to restoration as of January 1, 1996, the effective date of the Copyright Restoration Act).<sup>104</sup> If not—if the work was and remains technically unpublished in both the United States and France, despite its having been made available on some basis or another—then U.S. common-law copyright subsisted from the date of creation and was displaced by federal statutory copyright protection as of January 1, 1978.<sup>105</sup> To make matters more complicated, suppose that the United States would consider the work as having been published in France (according to which country's definition of "publication"?) without copyright notice, but that the work was never (technically) published in the United States. Did the French publication without

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101. *See id.* § 104A(h)(8)(C).

102. *See id.* § 104A(h)(3).

103. Note that the Berne Convention's definition of "publication" differs from the U.S. Copyright Act by expressly adopting as a criterion the availability of such copies as "to satisfy the reasonable requirements of the public, having regard to the nature of the work." *Compare* Berne Convention, *supra* note 27, art. 3(3), *with* 17 U.S.C. § 101 (2000 & Supp. V 2007). Like the U.S. Copyright Act, however, the Berne Convention takes the position that performance, broadcasting, and display do not constitute publication. *Compare* Berne Convention, *supra* note 27, art. 3(3), *with* 17 U.S.C. § 101.

104. 17 U.S.C. § 104A(h)(2)(A).

105. *Cf.* COHEN ET AL., *supra* note 37, at 155–56 (explicating the contours of copyright duration).



copyright notice result in forfeiture of U.S. copyright, or is publication without notice relevant only to publications occurring within the United States?<sup>106</sup> Alternatively, suppose that the work was not published in France in 1970 but *was* published in the United States, without copyright notice, in 1971. Under these circumstances, the U.S. copyright was forfeited and is *not* subject to restoration, because the work was first published in the United States.<sup>107</sup>

Next, suppose instead that Author *B*, a U.S. citizen who is domiciled in Canada, first makes copies of her literary work available to members of the general public in the United States on May 1, 2006, and in Canada on May 15, 2006. Assuming that these events constitute publication for purposes of the Berne Convention, the Berne Convention would deem Canada the country of origin of the work, because the work was “simultaneously” published in both countries and Canada has a shorter term of copyright protection than does the United States.<sup>108</sup> The United States therefore would be required, under Berne Convention articles 5(1) and 5(2), to ensure that Author *B*’s exercise and enjoyment of her rights not be subject to any

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106. The modern trend appears to support the rule that foreign publication without copyright notice does *not* result in forfeiture of the U.S. copyright. See *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162, 1166–67 (9th Cir. 1996); *Société Civile Succession Richard Guino v. Beseder, Inc.*, 414 F. Supp. 2d 944, 948–50 (D. Ariz. 2006). As the Nimmer treatise notes, however, the issue has never been definitively resolved. See 2 NIMMER & NIMMER, *supra* note 32, § 7.12[D][2][a]. The court in *Twin Books* also held that the U.S. copyright term would begin on the date of first publication with notice, whether U.S. or foreign. See *Twin Books*, 83 F.3d at 1168. The district court in *Beseder*, however, as well as the Nimmer treatise, have sharply criticized this aspect of the *Twin Books* ruling. See *Beseder*, 414 F. Supp. 2d at 949–51; 1 NIMMER & NIMMER, *supra* note 32, § 4.01[C][1].

107. See 17 U.S.C. § 104A(h)(6)(D), (h)(8).

108. Both the United States and Canada are members of the 1971 Paris Act of the Berne Convention. See WIPO, Contracting Parties, Berne Convention, [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=15](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=15) (last visited Apr. 27, 2008). Under the Berne Convention, a work is “considered as having been published simultaneously in several countries if it has been published in two or more countries within thirty days of its first publication.” Berne Convention, *supra* note 27, art. 3(4). Article 5(4)(a) of the Berne Convention provides that “[t]he country of origin shall be considered to be[,] . . . in the case of works published simultaneously in several countries of the union which grant different terms of protection, the country whose legislation grants the shortest term of protection.” *Id.* art. 5(4)(a). At present, the term of protection in Canada consists of the life of the author plus fifty years, and therefore is shorter than the standard term of protection in the United States. Copyright Act, R.S.C., ch. C-42, § 6 (1985), amended by 1993 S.C., ch. 44, § 58 (Can.).

formality.<sup>109</sup> In conformity with these rules, the U.S. Copyright Act (probably) would not consider the work to be a United States work,<sup>110</sup> and therefore would not require Author *B* to register her copyright before filing suit for infringement.<sup>111</sup> If, however, the “making available” at issue does not constitute publication, then (at least until publication occurs) under the Berne Convention the country of origin of the work is the “country of the Union of which the author is a national,”<sup>112</sup> i.e., the United States. United States law would, consistent with the Berne Convention, consider the work to be a “United States

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109. See *supra* text accompanying notes 26–28. The United States could, but it does not, limit Author *B* to the life-plus-fifty copyright term to which she is entitled in Canada. See Berne Convention, *supra* note 27, art. 7(8); see also TRIPs Agreement, *supra* note 87, art. 3(1) (permitting member states to continue applying this provision of the Berne Convention).

110. That appears to be the correct result, although the Copyright Act is not as clear as it should be on this point. As noted above, with respect to published works, a United States work is a work first published in the United States, or “simultaneously in the United States and another treaty party . . . whose law grants a term of copyright protection that is the same as or longer than the term provided in the United States.” 17 U.S.C. § 101 (2000 & Supp. V 2007). The word “simultaneously” is not defined in the current version of the Copyright Act. Cf. U.S. COPYRIGHT OFFICE, COPYRIGHT LAW OF THE UNITED STATES AND RELATED LAWS CONTAINED IN TITLE 17 OF THE U.S. CODE app. L (2007), available at <http://www.copyright.gov/title17/92appl.pdf> (noting without explanation that “[t]he WIPO Copyright and Performances Phonograms Treaties Implementation Act of 1998 deleted the definition of ‘Berne Convention work’ from” Copyright Act section 101, but that under the deleted definition a work was considered simultaneously published in a Berne and a non-Berne member nation if “its dates of publication are within 30 days of one another”). Assuming that the word “simultaneously” has the same meaning in the Copyright Act as it has in the Berne Convention, however, the work at issue in the hypothetical above, despite having been chronologically and literally first published in the United States, would not qualify as a United States work. *But cf.* 17 U.S.C. § 104(c) (2000 & Supp. V 2007) (clarifying that the provisions of the Berne Convention do not affect the substance or scope of protection under the Copyright Act).

111. See 17 U.S.C. § 411(a) (2000 & Supp. V 2007). The United States would require Author *B* to register the work in a timely fashion if she wanted to obtain statutory damages or attorneys’ fees. See *id.* § 412 (2000 & Supp. V 2007). It would in most cases require her to deposit two published copies for the Library of Congress, see *id.* § 407(a) (2000), and it would permit a defendant to assert innocent infringement in mitigation of statutory damages if the published copies to which the defendant had access did not bear copyright notice, see *id.* §§ 401(d), 402(d) (2000). The United States considers such rules as not targeting the “enjoyment and . . . exercise” of copyright rights and therefore not in violation of the Berne Convention. See *La Resolana Architects, P.A. v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1205–06 (10th Cir. 2005).

112. Berne Convention, *supra* note 27, art. 5(4)(c).

work.”<sup>113</sup> Author *B* then would be required to register the copyright to the work prior to filing suit for infringement.<sup>114</sup>

The situation may be even more complex if Author *B* made her work available by uploading it onto the Internet, rather than by making more traditional hard copies available. At present, the question of whether an Internet posting constitutes publication under U.S. law remains unresolved.<sup>115</sup> The Berne Convention similarly leaves this question unresolved. On the one hand, the Convention defines “published works” as “works published with the consent of their authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work.”<sup>116</sup> The Berne Convention goes on to state that “[t]he performance of a dramatic, dramatico-musical, cinematographic or musical work, the public recitation of a literary work, the communication by wire or the broadcasting of literary or artistic works, the exhibition of a work of art and the construction of a work of architecture shall not constitute publication.”<sup>117</sup> Posting a work on the World Wide Web clearly makes the work “available” to a wide range of persons—nearly anyone with Internet access anywhere in the world—but it does not necessarily result in a “manufacture of . . . copies,” and thus might be better characterized as a communication or broadcast.<sup>118</sup> On the other hand, one might argue that, because a

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

114. See *id.* § 411(a). Although some courts allow copyright plaintiffs to file suit concurrently with the filing of an application to register their copyrights, see, e.g., *Prunte v. Universal Music Group*, 484 F. Supp. 2d 32, 39–40 (D.D.C. 2007), or to register the copyright and then file “an amended complaint including an allegation that the copyrighted work is registered,” *Zito v. Steeplechase Films, Inc.*, 267 F. Supp. 2d 1022, 1025 (N.D. Cal. 2003), many require literal compliance with the rule, see, e.g., *La Resolana Architects*, 416 F.3d at 1200–01; *Jennette v. United States*, 77 Fed. Cl. 126, 131 (2007).

115. See *infra* Part II.B.5.

116. Berne Convention, *supra* note 27, art. 3(3).

117. *Id.* The UCC similarly defines publication as “the reproduction in tangible form and the general distribution to the public of copies of a work from which it can be read or otherwise visually perceived.” Universal Copyright Convention as Revised at Paris on 24 July 1971 art. VI, July 24, 1971, 25 U.S.T. 1341, 943 U.N.T.S. 178.

118. See RayMing Chang, “Publication” Does Not Really Mean Publication: The Need to Amend the Definition of Publication in the Copyright Act, 33 AIP-LA Q.J. 225, 226 (2005); see also MIHÁLY FICSOR, THE LAW OF COPYRIGHT AND

person who accesses a website necessarily makes a temporary copy of the website's content in the random access memory (RAM) of her computer, the website author *has* published the website simply by making it available for public access.<sup>119</sup> A fortiori, if the author permits users to download the content of the website, one could argue that the author has effected a publication for purposes of article 3(3) of the Berne Convention.<sup>120</sup> One consequence of so construing the word "publication," however, may be that the country of origin of a work first published on the Internet would be the country with the shortest term of protection. Perhaps the "country of origin" concept needs to be rethought in the digital age.<sup>121</sup> Assuming, nevertheless, that a posting *is* or *can be* a publication, under whatever country's law governs, would the United States view the work as having been simultaneously published everywhere that it was *available* for public viewing within the first thirty days?<sup>122</sup> Or would the United States view the work as having been published only in countries in which it was actually downloaded within the first thirty days?

To sum up, the fact, date, and place of publication all continue to have significant effects for copyright owners. The date of publication remains relevant to the question of whether the author had a duty to affix copyright notice to all published copies, lest she forfeit copyright altogether. In addition, date of publication can be relevant because it (sometimes or always) serves as the point from which (1) termination of the copyright term is either calculated or presumed; (2) a termination of transfer must be effected, if at all; (3) a claim to the renewal term must have been filed, if it were to have maximum effect;

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THE INTERNET 207 (2002) (noting possible reluctance on the part of some nations to equate digital transmissions with distributions of tangible copies).

119. See 1 SAM RICKETSON & JANE C. GINSBURG, *INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS* § 6.52 n.160 (2d ed. 2006) (noting this possibility); see also *infra* notes 196–203 and accompanying text.

120. See 1 RICKETSON & GINSBURG, *supra* note 119, § 6.52 (arguing that making a work available for download over a publicly accessible website effects a publication of the work); see also *supra* text accompanying note 103.

121. See *infra* note 122 and accompanying text; see also 1 RICKETSON & GINSBURG, *supra* note 119, §§ 6.59–.64 (arguing in favor of a new rule, one equating country of origin with the country of the author's nationality or residence in cases involving digital transmissions); Paul Edward Geller, *Conflicts of Laws in Copyright Cases: Infringement and Ownership Issues*, 51 J. COPYRIGHT SOC'Y U.S.A. 315, 363 n.217 (2004).

122. In this case, the work is not a United States work and its country of origin for Berne Convention purposes would be the Berne Convention country with the shortest term of protection in the entire world, whatever that is.

and (4) the copyright owner must register the copyright to her work if she wishes to obtain various benefits (presumptions of validity and ownership and the entitlement to statutory damages and attorneys' fees). In addition, if the defendant's use preceded publication, it is less likely that fair use or other defenses would immunize the use from liability. In a small number of cases, whether a work was published (or prepared for publication) may have a bearing on whether the work qualifies as a work made for hire or a protected architectural work. Finally, the *place* where publication was made can affect (1) the author's duty to deposit copies of her work; (2) her ability to claim federal statutory copyright protection at all; (3) her ability to claim exemption from having to register her copyright before filing suit; and (4) her ability to claim ownership of a restored copyright.

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

## II. STATUTORY AND JUDICIAL DEFINITIONS OF PUBLICATION

### A. A GENERAL DEFINITION OF PUBLICATION

Despite the key role that publication played under the 1909 Copyright Act, neither that statute nor any earlier United States copyright act defined publication.<sup>123</sup> In an influential law review article published in 1956, Melville Nimmer distilled the following definition of "publication" from the case law as it then existed:

The relevant decisions indicate that publication occurs when by consent of the copyright owner the original or tangible copies of a work are sold, leased, loaned, given away, or otherwise made available to the general public, or when an authorized offer is made to dispose of the work in any such manner even if a sale or other such disposition does not in fact occur.<sup>124</sup>

Nimmer went on to elaborate that although "the work need not be offered in sufficient numbers to satisfy the public demand and, indeed, may be effected by sale or other distribution of a single copy, such copies as are available must be offered to all members of the public who are interested."<sup>125</sup> Furthermore, "a *sine qua non* of publication should be the acquisition by members of the public of a possessory interest in *tangible* copies of the work in question."<sup>126</sup> Nimmer's definition can still be found in the treatise now published by his son David,<sup>127</sup> and courts have repeatedly cited that definition with approval.<sup>128</sup>

Unlike the 1909 Act, the 1976 Copyright Act provides a definition of publication and in general follows Nimmer's interpretation. The Act defines publication as

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123. The 1909 Act defined the term "date of publication" as follows:

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

Copyright Act of 1909, ch. 320, § 26, 35 Stat. 1075, 1087 (repealed 1976).

124. Melville B. Nimmer, *Copyright Publication*, 56 COLUM. L. REV. 185, 187 (1956) (footnotes omitted).

125. *Id.*

126. *Id.* at 197.

127. See 1 NIMMER & NIMMER, *supra* note 32, § 4.04; see also *id.* § 4.07[A] (repeating the "*sine qua non*" language quoted above).

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

the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.<sup>129</sup>

This definition of publication is largely contiguous with the copyright owner's right under the Copyright Act "to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending."<sup>130</sup> A distribution authorized by the copyright owner therefore would appear to be equivalent to a publication. Moreover, a person who makes an unauthorized distribution, not subject to any copyright exception, would clearly be distributing the work (and thereby infringing), but he would not be publishing the work. Courts have agreed with Nimmer that only publications authorized by the copyright owner count as "publications."<sup>131</sup>

129. 17 U.S.C. § 101 (2000 & Supp. V 2007).

To "perform" a work means to recite, render, play, dance, or act it, either directly or by means of any device or process or, in the case of a motion picture or other audiovisual work, to show its images in any sequence or to make the sounds accompanying it audible.

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To perform or display a work "publicly" means—

(1) to perform or display it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; or

(2) to transmit or otherwise communicate a performance or display of the work to a place specified by clause (1) or to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times.

*Id.* "To 'display' a work means to show a copy of it, either directly or by means of a film, slide, television image, or any other device or process or, in the case of a motion picture or other audiovisual work, to show individual images non-sequentially." *Id.*

130. *Id.* § 106(3) (2000 & Supp. V 2007). The definition of publication may not be *entirely* contiguous with the right of distribution, however. Some offers to distribute copies may constitute publications under section 101, but the better view is probably that they do not constitute distributions. See *London-Sire Records, Inc. v. Doe 1*, No. 04cv12434-NG, 2008 WL 887491, at \*9–10 (D. Mass. Mar. 31, 2008); The Patry Copyright Blog, <http://williampatry.blogspot.com/2008/04/recent-making-available-cases.html> (Apr. 3, 2008, 22:29 EST) (discussing *London-Sire Records, Elektra Entertainment Group, Inc. v. Barker*, No. 05-CV-7340 (KMK), 2008 WL 857527 (S.D.N.Y. Mar. 31, 2008), and *Atlantic Recording Corp. v. Brennan*, 534 F. Supp. 2d 278 (D. Conn. 2008)).

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

## B. SOME SPECIFIC APPLICATIONS

Courts applying the 1909 Act, and in some instances the 1976 Act, have made several other distinctions among different types of public disclosures. Among these are the status of works that have been published, if at all, only by incorporation into a subsequent derivative work; the distinction between investive and divestive publications; the effects of public performances and displays; the distinction between general and limited publications; and (only under the 1976 Act, for obvious reasons) the effect of Internet transmissions.

### 1. Derivative Works

One issue that attracted relatively little attention until fairly recently centers on the status of works that are lawfully adapted into other (derivative) works and are then published under the authority of the derivative-work author. Neither the 1909 nor the 1976 Act clearly indicates whether publication of a derivative work results in publication of the underlying work.<sup>132</sup> The more recent decisions, however, follow the rule that publication of a derivative work also constitutes publication of as much of the underlying work as is reproduced in the derivative work.<sup>133</sup> This rule has occasionally given rise to problems with respect to musical works incorporated into sound recordings, since industry practice up until the 1970s was not to affix copyright notice to sound recordings.<sup>134</sup> By the late 1990s, the majority of lower courts addressing this issue had concluded that publication of a sound recording does indeed constitute publication of the underlying musical work.<sup>135</sup> Congress nevertheless enacted legislation in 1997 to reverse these decisions as applied to sound recordings, at least with respect to

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132. See 1 NIMMER & NIMMER, *supra* note 32, § 4.12 (noting "surprisingly little case authority on the question").

133. See, e.g., *Shoptalk*, 168 F.3d at 591-93; *Batjac Prods. Inc. v. Goodtimes Home Video Corp.*, 160 F.3d 1223, 1233-36 (9th Cir. 1998); *Harris Custom Builders*, 92 F.3d at 520.

134. See 1 NIMMER & NIMMER, *supra* note 32, § 4.05[B][4]; Benjamin Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 472 & n.20 (1955). Sound recordings themselves were not subject to federal copyright protection until 1972. See Sound Recording Act of 1971, Pub. L. No. 92-140, § 3, 85 Stat. 391, 392 (codified as amended in scattered sections of 17 U.S.C.).

135. See, e.g., *La Cienega Music Co. v. ZZ Top*, 44 F.3d 813, 815 (9th Cir. 1995).



works that had not been held to be in the public domain prior to the date of the legislation.<sup>136</sup>

## 2. Investive and Divestive Publications

Another distinction, which Judge Jerome Frank first articulated in *American Visuals Corp. v. Holland*, was between so-called investive and divestive publications.<sup>137</sup> According to Judge Frank, when the copyright owner was the party urging that a publication had occurred, and hence that its work had become invested with federal copyright protection, courts imposed a relatively low burden of proof on the issue of whether a publication occurred.<sup>138</sup> When, on the other hand, the defendant was the party urging that a publication had occurred, such that the work had been divested of all copyright protection due to the owner's failure to comply with formalities, courts required a stronger showing of publication.<sup>139</sup> Cases involving this set of issues also sometimes have involved the related question of whether an allegedly divestive publication was a general or limited publication, a distinction I return to in Part III.B.4 below.

## 3. The Effects of Public Performances and Displays

By the middle of the twentieth century, most courts that had considered the issue concluded that the public performance or display of a work of authorship did not, by itself, constitute publication of the work performed or displayed.<sup>140</sup> To some

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136. See Act of Nov. 13, 1997, Pub. L. No. 105-80, § 11, 111 Stat. 1529, 1534 (codified as amended at 17 U.S.C. § 303(b) (2000)) ("The distribution before January 1, 1978, of a phonorecord shall not for any purpose constitute a publication of the musical work embodied therein.").

137. 239 F.2d 740, 743 (2d Cir. 1956).

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

139. See, e.g., *Roy Exp. Co. Establishment of Vaduz, Liech. v. Columbia Broad. Sys.*, 672 F.2d 1095, 1102-03 (2d Cir. 1982); *Am. Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1027 (9th Cir. 1981). The Nimmer treatise, however, argues that, despite the application of Judge Frank's distinction between investive and divestive publications in cases such as the preceding ones, in general that distinction has rarely been a decisive factor. See 1 NIMMER & NIMMER, *supra* note 32, § 4.13[C].

140. See, e.g., *Ferris v. Frohman*, 223 U.S. 424, 435-37 (1912); *Am. Tobacco Co. v. Werckmeister*, 207 U.S. 284, 299-300 (1907); *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 37 (1st Cir. 2003); *Am. Vitagraph*, 659 F.2d at 1027; *Nutt v. Nat'l Inst. Inc. for the Improvement of Memory*, 31 F.2d 236, 238 (2d Cir. 1929); *McCarthy & Fischer, Inc. v. White*, 259 F. 364, 365 (S.D.N.Y. 1919); *Tompkins v. Halleck*, 133 Mass. 32, 36 (1882); *Pal-*

courts and commentators, this rule followed from the premise that copyright generally reflects a balance of private versus public interests. Thus, while the author's interest in privacy may justify potentially perpetual common-law copyright in unpublished works, once the author has forsaken privacy and sought to exploit her work by the release of tangible copies, the balance of interests shifts in favor of the more limited statutory copyright protection.<sup>141</sup>

This rationale is clearly vulnerable, however, to the counterargument that public performances and displays often result in the loss of any privacy or secrecy interest in the work and may bring as much (or more) economic reward as would the distribution of tangible copies.<sup>142</sup> Several practical reasons for

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mer v. De Witt, 47 N.Y. 532, 543-44 (1872). *But see, e.g.*, Morton v. Raphael, 79 N.E.2d 522, 523-24 (Ill. App. Ct. 1948); Keene v. Kimball, 82 Mass. (16 Gray) 545, 549 (1860); Z Bar Net, Inc. v. Helena Television, Inc., 125 U.S.P.Q. (BNA) 595, 598 (Mont. Dist. Ct. 1960); *but see also* Blanc v. Lantz, 83 U.S.P.Q. (BNA) 137, 138 (Cal. Super. Ct. 1949) (citing Loew's Inc. v. Superior Court, 115 P.2d 983, 985-86 (Cal. 1941)) (noting division of authority). As Nimmer and others noted, however, by the mid-1950s, most U.S. courts had repudiated this view. *See* Nimmer, *supra* note 124, at 194-95; Herman F. Selvin, *Should Performance Dedicate?*, 42 CAL. L. REV. 40, 51 (1954).

Cases nevertheless have continued to arise on the issue of whether the deposit of a copy or copies in a public library or archive or in a governmental office constitutes publication. Merely depositing a copy with a library, for purposes of permitting on-premises inspection, probably is not a publication. *See* Kramer v. Newman, 749 F. Supp. 542, 551 (S.D.N.Y. 1990); Frederick Chusid & Co. v. Marshall Leeman & Co., 326 F. Supp. 1043, 1064 (S.D.N.Y. 1971). *But see* Ladd v. Oxnard, 75 F. 703, 730-31 (C.C. Mass. 1896); Jewelers' Mercantile Agency, Ltd. v. Jewelers' Weekly Publ'g Co., 49 N.E. 872, 875-76 (N.Y. 1889). Similarly, although some courts held that deposit of a work with the Copyright Office or the Library of Congress could be an investive publication, *see, e.g.*, Cardinal Film Corp. v. Beck, 248 F. 368, 368 (S.D.N.Y. 1918), most held that it would not constitute a divestive publication, *see, e.g.*, Patterson v. Century Prods., Inc., 93 F.2d 489, 490-91 (2d Cir. 1937). And although many courts have come around to the view that merely depositing architectural plans with a public agency is not a publication, *see, e.g.*, John G. Danielson, Inc. v. Winchester-Conant Props., Inc., 322 F.3d 26, 37 (1st Cir. 2003), there is a substantial minority view, *see, e.g.*, DeSilva Constr. Co. v. Herrald, 213 F. Supp. 184, 198 (M.D. Fla. 1962). A few courts also have held or suggested that the construction or public exhibition of a building constitutes publication of the underlying plans, *see, e.g.*, Read v. Turner, 48 Cal. Rptr. 919, 924 (Dist. Ct. App. 1966), but others appear to have rejected this rule as well, *see, e.g.*, Donald Frederick Evans & Assocs., Inc. v. Cont'l Homes, Inc., 785 F.2d 897, 901 n.7 (11th Cir. 1986).

141. *See* 1 NIMMER & NIMMER, *supra* note 32, §§ 4.03, 4.07[A]; Kaplan, *supra* note 134, at 470.

142. *See* Blanc v. Lantz, 83 U.S.P.Q. (BNA) 137, 139-40 (Cal. Super. Ct. 1949); 1 NIMMER & NIMMER, *supra* note 32, § 4.08[B]; Selvin, *supra* note 140, at 40-41.

not equating performance or display with publication nevertheless also suggest themselves. One is that a rule equating performance with publication would have injected into the public domain works that were publicly performed without having first been fixed in any tangible medium of expression. There would have been no tangible copy upon which to affix copyright notice, and publication (by performance) without copyright notice would have resulted in forfeiture of common-law copyright.<sup>143</sup> Alternatively, for works that were fixed in a tangible medium of expression but not distributed to the public in tangible copies prior to their public performance or display, a rule that performance or display resulted in forfeiture of common-law copyright would have required authors to obtain statutory copyright protection by depositing a copy of the work with the U.S. Copyright Office, prior to the public performance or display.<sup>144</sup> Compliance with this requirement would not have been impossible, perhaps, but for many works, particularly works that were subject to revision up until the moment before their first performance, it might have seemed quite burdensome.<sup>145</sup>

Another rationale, applicable to unique works of art on public display, would be that requiring the author to include copyright notice on such works might have compromised their integrity.<sup>146</sup> It might have been burdensome for authors to

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143. Fixation as such was not, technically, a requirement for federal copyright protection until 1978, but publication appears to have implied the existence of at least one tangible copy that could be distributed to the general public. See Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683, 719–21 (2003). Presumably, there could not be a federal copyright interest if there was no writing. See U.S. CONST. art. I, § 8, cl. 8.

144. See Copyright Act of 1909, ch. 320, § 12, 35 Stat. 1075, 1078 (repealed 1976). Prior to 1909, however, even this protection was not available for unpublished works. See Kaplan, *supra* note 134, at 476–77; Selvin, *supra* note 140, at 44.

145. See 1 NIMMER & NIMMER, *supra* note 32, § 4.08[B]; Kaplan, *supra* note 134, at 478–79.

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

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

*Id.*

comply with the deposit requirement in this context as well, at least until photography and other reproduction methods became more widely available, although one way around this hardship would have been simply to exempt such "published" copies from the deposit requirement.<sup>147</sup> Yet another possible rationale for not equating performances and displays with publication is administrative convenience: determining whether tangible copies of a work have been made available to the general public might seem easier than determining whether the work had merely been publicly performed or displayed.<sup>148</sup> To be sure, both questions may involve fine distinctions concerning whether the work has been made sufficiently accessible to the general public; at least in the former case, however, there are (or at least were, at one time) tangible copies of the work from which to base a conclusion.<sup>149</sup> One might argue, however, that none of these rationales should carry much weight now that copyright subsists in all original works of authorship from the moment of their creation.<sup>150</sup> If the law were to change, however, such that performances and displays henceforth did count as publications, one would need to be sure that the other consequences that now follow from the fact of publication are such that they could or should be conditioned upon performance or display instead.

Notwithstanding the courts' general acceptance of the rule that performances and displays did not equate to publication, the application of that rule to situations in which the author might be deemed to have authorized or acquiesced in the audience's copying of the work has troubled courts for over a century. In a few cases decided under the 1909 Act, courts appeared to suggest that such performances or displays

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Affixation on the back of the work of art, however, may have sufficed even under the 1909 Act. See *Coventry Ware, Inc. v. Reliance Picture Frame Co.*, 288 F.2d 193, 194–95 (2d Cir. 1961). Current Copyright Office regulations permit authors to include copyright notice on the back or on a frame of a pictorial work. See 37 C.F.R. § 201.20(i)(1) (2007).

147. See 37 C.F.R. §§ 202.19(c)(6), 202.20(c)(2)(xi)(B)(5) (2007) (exempting three-dimensional sculptural works from the deposit requirement); *id.* §§ 202.19(d)(2)(iv), 202.20(c)(2)(iv) (permitting deposit of photographs of pictorial or graphic works existing in limited numbers).

148. See Kaplan, *supra* note 134, at 479 n.49 (citing John Schulman, *Author's Rights*, in 7 COPYRIGHT PROBLEMS ANALYZED 19, 23–25 (1952)).

149. Of course, the rule could be underinclusive, because there was not (and still is not) any rule that those copies survive to the date of litigation. See Lichtman, *supra* note 143, at 732–34.

150. See 1 NIMMER & NIMMER, *supra* note 32, § 4.08[B].

constituted publications. In *American Tobacco Co. v. Werckmeister*, for example, the Supreme Court (in a bit of extended dicta) cited with approval a section of a copyright treatise stating that a public exhibition of a work of art does not constitute publication “where there are bylaws against copies, or where it is tacitly understood that no copying shall take place, and the public are admitted to view the painting on the implied understanding that no improper advantage will be taken of the privilege.”<sup>151</sup>

The negative implication of *American Tobacco* appears to be that exhibition without such express or implicit restrictions on copying could, in an appropriate case, constitute publication. Not surprisingly, some courts have interpreted the case in precisely this way. Thus, in *Letter Edged in Black Press, Inc. v. Public Building Commission of Chicago*, the plaintiff sought a declaratory judgment that the defendant, the assignee of Pablo Picasso’s copyright in the monumental sculpture that now stands in front of the Daley Center in Chicago, Illinois, had forfeited the copyright in that work by permitting its general publication without copyright notice.<sup>152</sup> In particular, the plaintiff argued that the defendant, in order to publicize the work, had permitted the Art Institute of Chicago, among others, to display a maquette (model) of the sculpture—the monumental version of which had yet to be constructed—without any restriction on its being copied.<sup>153</sup> In addition, the defendant itself had distributed ninety-six copies of a commemorative booklet that included photographs of the maquette and had issued a policy statement that “no individuals shall be restricted from ‘full personal enjoyment of the sculpture, including the right to take photographs and make paintings, etchings and models of the same for personal, non-commercial purposes.’”<sup>154</sup> Citing *American Tobacco*, the court concluded that the display of the maquette without copyright notice constituted a general publication,<sup>155</sup> noting that “the Commission passively and in some cases actively engaged in the distribution of uncopyrighted pictures promoting the Chicago Picasso.”<sup>156</sup> Given its specific facts,

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151. 207 U.S. 284, 300 (1907) (citing JOHN HERBERT SLATER, *THE LAW RELATING TO COPYRIGHT AND TRADE MARKS, TREATED MORE PARTICULARLY WITH REFERENCE TO INFRINGEMENT* 92 (London, Stevens and Sons 1884)).

152. See 320 F. Supp. 1303, 1305 (N.D. Ill. 1970).

153. See *id.* at 1305–06.

154. *Id.* at 1307.

155. See *id.* at 1311.

156. *Id.* at 1313; see also *Burke v. Nat’l Broad. Co.*, 598 F.2d 688, 691 (1st

*Letter Edged in Black Press* can be (and sometimes has been) interpreted as standing for the proposition that display coupled with an absence of restrictions on copying constitutes a general publication, though others argue that it should be read merely as standing for the narrow proposition that the defendant's own distribution of copies, and authorization of such distribution, constitutes a general publication.<sup>157</sup>

A more recent case illustrating similar issues is *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*<sup>158</sup> The case involved Dr. King's famous "I Have a Dream" speech, which he delivered in Washington, D.C., on August 28, 1963.<sup>159</sup> In 1994, CBS produced a documentary, titled "Martin Luther King, Jr. and the March on Washington," which included CBS television footage of about sixty percent of the content of the speech.<sup>160</sup> Dr. King's estate filed suit for copyright infringement.<sup>161</sup> CBS moved for summary judgment on the ground that the speech had fallen into the public domain by virtue of Dr. King's having released it for publication without the requisite copyright notice.<sup>162</sup> The district court granted the defendant's motion, reasoning that, while

merely showing the general public a work through a public performance or exhibition is not necessarily a general publication, such action is treated as a general publication if it is shown to the public under such conditions that it evinces a "dedication without reservation of rights" rather than just the right to view or inspect.<sup>163</sup>

The march organizers' knowledge of and encouragement of press coverage, their "studied effort . . . to secure as wide dissemination . . . as possible," and their failure to give express (or even implicit) "limitations regarding who could film the event

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Cir. 1979) ("Publication may be found if the circumstances suggest that the public was free to copy a work on exhibit, but a prohibition against copying can be 'tacitly understood' or implied." (citing *Am. Tobacco Co. v. Werckmeister*, 207 U.S. 284, 300 (1909))); *Patterson v. Century Prods.*, 93 F.2d 489, 492 (2d Cir. 1937); *Carns v. Keefe Bros.*, 242 F. 745, 746 (D. Mont. 1917).

157. See 1 NIMMER & NIMMER, *supra* note 32, § 4.09 n.7.

158. 194 F.3d 1211 (11th Cir. 1999).

159. See *id.* at 1213.

160. See *id.*

161. See *id.*

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

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

or the extent to which their footage could be used," in the opinion of the district court, "almost epitomizes the definition of a general publication: it was made available to members of the public at large without regard to who they were or what they proposed to do with it."<sup>164</sup> In reaching this conclusion, the court expressed disagreement with an earlier district court decision that reached the opposite result on the question of the speech's general publication.<sup>165</sup>

The Eleventh Circuit reversed, with one judge dissenting and adopting the district judge's rationale.<sup>166</sup> Each of the two judges in the majority wrote separately, however, to explain why he did not believe that the undisputed facts established that King had effected a general publication. In the lead opinion, Chief Judge R. Lanier Anderson III wrote that, although "performance of a work is not a general publication," a general publication would result "if tangible copies of the work are distributed to the general public in such a manner as allows the public to exercise dominion and control over the work" or "if the work is exhibited or displayed in such a manner as to permit unrestricted copying by the general public."<sup>167</sup> Chief Judge Anderson concluded that a genuine issue of material fact existed as to whether either condition was satisfied.<sup>168</sup> As for the first

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

165. *See King v. Mister Maestro, Inc.*, 224 F. Supp. 101, 108 (S.D.N.Y. 1963). In *Mister Maestro*, the defendants were selling phonograph recordings of King's August 1963 public performance of the "I Have a Dream" speech. King registered his claim to copyright and filed suit. The district court concluded that the speech had not been the subject of a general publication, reasoning that King's delivery of an advance text of the speech was given to the press only. *See id.* at 107. The King Estate filed its claim to the renewal term in 1991. *See Estate of King*, 194 F.3d at 1214 n.2.

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

167. *Id.* at 1215 (majority opinion).

168. *Id.* at 1216–17.

condition, Chief Judge Anderson reasoned that “distribution to the news media, as opposed to the general public, for the purpose of enabling the reporting of a contemporary newsworthy event, is only a limited publication,” lest otherwise an author be forced “to choose between obtaining news coverage for his work and preserving his common-law copyright.”<sup>169</sup> As for the second, he concluded that a genuine issue of fact remained on the issue of whether King authorized the general public to copy his speech.<sup>170</sup> Senior District Judge Deborah L. Cook, sitting by designation, concurred in this result, but on the ground that performance never amounts to publication, unless the author has made tangible copies available to the general public.<sup>171</sup>

#### 4. General and Limited Publications

In order to avoid the harsh result of publication without notice resulting in forfeiture of copyright, courts also have long distinguished between “general” publications, which resulted in termination of common-law copyright, and “limited” publications, which did not. In what is probably the most frequently cited case on point, *White v. Kimmell*, the Ninth Circuit defined a limited publication as one that “communicates the contents of a manuscript to a definitely selected group and for a limited purpose, and without the right of diffusion, reproduction, distribution or sale.”<sup>172</sup> Other courts have cited this definition with

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169. *Id.* at 1216.

170. *See id.* at 1218–20.

171. *See id.* at 1220–26 (Cook, J., concurring in part and dissenting in part). Compare the outcome of this case with *Public Affairs Associates, Inc. v. Rickover*, 284 F.2d 262, 270 (D.C. Cir. 1960), *vacated on other grounds*, 369 U.S. 111 (1962) (per curiam), in which the court (by a 2-1 majority) held that Admiral Rickover’s distribution “not only to the press but also to people generally who desired copies through interest in the subjects of the addresses” constituted a general publication. *See also* *Cont’l Cas. Co. v. Beardsley*, 253 F.2d 702, 706 (2d Cir. 1958) (concluding that general publication occurred through distribution to prospective customers); 1 NIMMER & NIMMER, *supra* note 32, § 4.13[A][3] (criticizing the *Estate of King* result on the ground that “distribution preparatory to ultimate distribution to the public constitutes general publication”); The Patry Copyright Blog, <http://williampatry.blogspot.com/2006/01/martin-luther-king-jr.html> (Jan. 17, 2006, 09:42 EST).

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



approval ever since,<sup>173</sup> and some applications of it are fairly uncontroversial. By most accounts, making copies available merely for review or for criticism, or performance, is not a general publication.<sup>174</sup> Similarly, delivering copies to a publisher for consideration is not a publication—at least not until the right to publish, if any, is exercised.<sup>175</sup> On the other hand, placing copies in the hands of a retailer is a publication, even before the copies hit the stores.<sup>176</sup> Distributing copies to a select group the author deems worthy is also a publication, if the other criteria of general publication are met.<sup>177</sup>

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173. See, e.g., *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 36 (1st Cir. 2003); *Brown v. Tabb*, 714 F.2d 1088, 1091 (11th Cir. 1983); *Cont'l Cas. Co. v. Beardsley*, 253 F.2d 702, 706–07 (2d Cir. 1958); *William A. Graham Co. v. Haughey*, 430 F. Supp. 2d 458, 470 (E.D. Pa. 2006); *Milton H. Greene Archives, Inc. v. BPI Commc'ns, Inc.*, 378 F. Supp. 2d 1189, 1198 (C.D. Cal. 2005); *Penguin Books U.S.A., Inc. v. New Christian Church of Full Endeavor, Ltd.*, 288 F. Supp. 2d 544, 555 (S.D.N.Y. 2003); see also *Data Cash Sys., Inc. v. JS&A Group, Inc.*, 628 F.2d 1038, 1042–43 (7th Cir. 1980) (concluding that “a ‘limited publication’ is really in the eyes of the law no publication at all”).

174. See *Kramer v. Newman*, 749 F. Supp. 542, 550 (S.D.N.Y. 1990); 1 NIMMER & NIMMER, *supra* note 32, § 4.13[A][3].

175. See *Schatt v. Curtis Mgmt. Group, Inc.*, 764 F. Supp. 902, 908 (S.D.N.Y. 1991) (quoting with approval 1 NIMMER & NIMMER, *supra* note 32, § 4.04, that, “[i]f an author grants to another the right to publish his work, the grant does not in and of itself constitute a publication unless and until the grantee exercises that right. Furthermore, publication does not result from mere delivery of the manuscript of a work to a publisher, even if delivery is made for the purpose of having the work printed so that it may become available to the public”); *Wright v. Warner Books, Inc.*, 748 F. Supp. 105, 110 (S.D.N.Y. 1990), *aff'd*, 953 F.2d 731 (2d Cir. 1991); see also *Nucor Corp. v. Tenn. Forging Steel Serv., Inc.*, 476 F.2d 386, 390–91 (8th Cir. 1973) (“[A] distribution of plans to potential contractors and subcontractors for bidding purposes does not constitute general publication.”); *Hirshon v. United Artists Corp.*, 243 F.2d 640, 645 (D.C. Cir. 1957) (citing *Falk v. Gast Lithograph & Engraving Co.*, 54 F. 890, 893 (2d Cir. 1893)) (stating that “the sending of samples to dealers for the purpose of enabling them to give orders” is not a general publication).

176. See *Data Cash Sys.*, 628 F.2d at 1043 (stating that, in *Advisers, Inc. v. Wiesen-Hart, Inc.*, 238 F.2d 706 (6th Cir. 1956) (per curiam), “the date of publication was the date of distribution of a book to retailers, not four months later when the retailers actually distributed the books to the public”).

177. See *William A. Graham Co.*, 430 F. Supp. 2d at 470 (citing *Penguin Books U.S.A.*, 288 F. Supp. 2d at 555, and *Schatt*, 764 F. Supp. at 911 & n.12); see also *Schatt*, 764 F. Supp. at 911 n.12 (rejecting the argument that copies “must have been made available to all comers and not only to a class in order for the dissemination of the photographs to have been a general publication” and finding that distribution constitutes a general publication “to the extent the recipients [are] permitted to pass the manuscript on to selected others”).

Nevertheless, as one court recently noted, cases applying the *White v. Kimmell* definition of limited publication "are not totally consistent."<sup>178</sup> The *White* case itself involved a manuscript, referred to as "Gaelic," which purportedly consisted of communications transmitted from an otherworldly spirit to author Stewart Edward White, through the intermediation of Mrs. White.<sup>179</sup> Stewart White authorized the making of up to two hundred mimeographed copies of the Gaelic manuscript, many of which he mailed out to persons whom he thought would be interested, or who had expressed an interest, in the work.<sup>180</sup> According to the court, White did not limit the recipients from passing the work on to others, even encouraging them to do so, and he expressly permitted at least one recipient to make additional copies.<sup>181</sup> On these facts, the Ninth Circuit concluded that the work had been generally published, despite its relatively small circulation.<sup>182</sup>

More recently, in *Penguin Books U.S.A., Inc. v. New Christian Church of Full Endeavor, Ltd.*, a district court held that the circulation of (yet another) work purportedly transmitted by a spiritual being had been generally published, on facts similar to *White*.<sup>183</sup> Similarly, in *Brown v. Tabb*, the Eleventh Circuit held that the plaintiff had made a general publication of an advertising jingle when he delivered a tape of the jingle to three clients without express agreement concerning its use.<sup>184</sup> The court concluded that, even if the work was subject to an implicit restriction on its reproduction or distribution, it did not satisfy the other two elements of limited publication, insofar as it was not made for a limited purpose or to a limited group.<sup>185</sup> In *Public Affairs Associates, Inc. v. Rickover*, the D.C. Circuit found that Admiral Rickover had effected a general publication of his speeches by making copies available to anyone who re-

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178. *William A. Graham Co.*, 430 F. Supp. 2d at 471.

179. *See White v. Kimmell*, 193 F.2d 744, 745 (9th Cir. 1952).

180. *See id.* at 745-48.

181. *See id.* at 745-46.

182. *See id.* at 745-48.

183. *See* 288 F. Supp. 2d 544, 554-58 (S.D.N.Y. 2003).

184. 714 F.2d 1088, 1091-92 (11th Cir. 1983).

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

quested them,<sup>186</sup> and in *Continental Casualty Co. v. Beardsley*, the Second Circuit reached the same conclusion with respect to the plaintiff's insurance forms.<sup>187</sup>

Other cases take a much narrower view of general publication. In *Academy of Motion Picture Arts & Sciences v. Creative House Promotions, Inc.*, for example, the Ninth Circuit concluded that the distribution of Oscar statuettes from 1929 to 1941 (before copyright notice was included on the statuettes) constituted a limited publication, despite the fact that 158 of the statuettes had been awarded during that time without any express restriction on the recipients' use or disposal of the statuettes.<sup>188</sup> The court concluded that the recipients were a select group, the award was given for a limited purpose of advancing the motion picture arts and sciences, and the recipients labored under an implied restriction on further distribution.<sup>189</sup> In support of this last proposition, the court cited with approval *Hirshon v. United Artists Corp.*, a case in which the D.C. Circuit held that the distribution of copies of a song to two thousand radio stations for promotional purposes was a limited publication, despite a similar lack of any express restriction on distribution or copying.<sup>190</sup> In both cases, the courts made much of the

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186. See 284 F.2d 262, 270-71 (D.C. Cir. 1960), *vacated on other grounds*, 369 U.S. 111 (1962) (per curiam).

187. See 253 F.2d 702, 706 (2d Cir. 1958) (concluding that the plaintiff had effected a general publication by distributing forms to prospective customers, absent proof that the recipients were bound by a condition that the forms not be shown to others and given that any interested person could have obtained a copy); see also *Lish v. Harper's Magazine Found.*, 807 F. Supp. 1090, 1102 (S.D.N.Y. 1993). In *Lish*, the court held that, for purposes of fair use analysis, an author's letter to students in his writing seminar was confidential and therefore unpublished. *Id.* at 1101-02. The court noted that, under the 1976 Act, "publication" means, inter alia, "distribution . . . to the public," and it cited the legislative history of the 1976 Copyright Act as defining "the public" as "persons 'under no explicit or implicit restrictions with respect to disclosure of its contents.'" See *id.* (citing H.R. REP. NO. 94-1476, at 138 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5754). It concluded that publication therefore "turns on the question whether there were 'implicit restrictions' on further distribution or disclosure of the document's contents," and that in the case at hand there were such restrictions. See *id.* at 1102.

188. See 944 F.2d 1446, 1449 (9th Cir. 1991). In 1941, the Academy obtained a federal copyright registration for the statuette as an unpublished work. See *id.*

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

190. See 243 F.2d 640, 645 (D.C. Cir. 1957). The Second Circuit in *Continental Casualty Co.* distinguished *Hirshon* on the ground that its significance,

fact that there was no evidence of any recipient actually selling or copying the work.<sup>191</sup> Similarly, in *Brewer v. Hustler Magazine, Inc.*, the court (again the Ninth Circuit) held that the work at issue—a photograph simulating the photographer shooting himself through the head through the use of special effects—had not been generally published, despite the fact that the plaintiff had distributed approximately two hundred business cards bearing a small reproduction of the photograph to persons in the advertising industry, reasoning that the recipients were a “select group” and the purpose the “very narrow” one of obtaining employment.<sup>192</sup> The court made no mention of whether the recipients were under an obligation to refrain from copying or distributing the work, however,<sup>193</sup> and in *Academy* the court interpreted the case as standing for the proposition that a limited publication can exist “even though the recipients were free to further distribute the cards.”<sup>194</sup> And in *Burke v. National Broadcasting Co.*, the First Circuit concluded that the plaintiff had not made a general publication of his video, despite the fact that he lent it to a German professor for broadcast on German television without any express conditions imposed on its reproduction or use.<sup>195</sup> One need not be a cynic to

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like *American Visuals Corp. v. Holland*, 239 F.2d 740 (2d Cir. 1956), lay “in the recognition that ‘publication’ may more readily be found if the issue is whether the copyright statute has been complied with than if forfeiture of common law rights is involved.” See *Cont’l Cas. Co.*, 253 F.2d at 707. But while *Hirshon* does cite *American Visuals* with approval for this proposition, the issue in *Hirshon*, which the court answered in the negative, was whether the plaintiff had made a divestive publication. See *Hirshon*, 243 F.2d at 645–46. On the other hand, other courts have agreed that merely making copies available as samples or in catalogues or ads is not a publication. See *Hub Floral Corp. v. Royal Brass Corp.*, 454 F.2d 1226, 1229 (2d Cir. 1972) (“It has long been settled that the taking of orders through employment of samples, catalogs, or advertisements of a work does not amount to publication of the work.” (citations omitted)); *Dowdey v. Phoenix Films, Inc.*, 199 U.S.P.Q. (BNA) 579, 584 (S.D.N.Y. 1978). But cf. *Rexnord, Inc. v. Modern Handling Sys., Inc.*, 379 F. Supp. 1190, 1197 (D. Del. 1974) (finding that promotional distribution, absent conditions on “use . . . or further communication” of the materials, constitutes publication).

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

192. See 749 F.2d 527, 528–29 (9th Cir. 1984).

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

194. See *Academy*, 944 F.2d at 1454.

195. See 598 F.2d 688, 693 (1st Cir. 1979).

conclude that there seems to be more than a little result-orientation going on in some of these cases.

#### 5. Internet Transmissions

One additional area of controversy that only recently has come to the fore involves the question of whether materials transmitted over the Internet are thereby, necessarily, published. Suppose, for example, that I upload materials onto my website; that anyone with an Internet connection, anywhere in the world, can access the site; and that at least one person, somewhere, does so. The U.S. Copyright Act is fairly clear on a number of issues relating to these facts. First, I have “transmitted” the subject work.<sup>196</sup> Second, as long as some member of the general public, somewhere, accesses the work, I have caused a public performance or display of it.<sup>197</sup> As discussed above, however, under current U.S. law, neither performance nor display alone constitutes publication. Third, the person who accesses the material automatically makes a temporary copy of it in the RAM of her computer, and according to some authorities this copying constitutes a reproduction<sup>198</sup> (albeit, in the present context, one that is authorized by the copyright owner). Fourth, as we have seen, the Copyright Act does not define the term “distribution,” but it does confer upon the copyright owner the right to distribute, and the right to authorize the distribution of, “copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending.”<sup>199</sup> Moreover, publication is defined, as above, as “the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending,” as well as the “offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display.”<sup>200</sup>

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196. See 17 U.S.C. § 101 (2000 & Supp. V 2007) (defining “transmit” as “to communicate . . . by any device or process whereby images or sounds are received beyond the place from which they are sent”).

197. See *id.* (defining “display,” “perform,” and “publicly”).

198. See *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 518 (9th Cir. 1993) (referring to the transfer of computer software into a computer’s RAM as effecting a “copying” for purposes of copyright law”); *Marobie-FL, Inc. v. Nat’l Ass’n of Fire Equip. Distribs. & Nw. Nexus, Inc.*, 983 F. Supp. 1167, 1177–78 (N.D. Ill. 1997) (finding that the copying of clip art images into the RAM of users’ computers creates a “copy” of the material under the Copyright Act).

199. 17 U.S.C. § 106(3) (2000 & Supp. V 2007).

200. *Id.* § 101.

By transmitting a work over the Internet, therefore, I may cause people in distant places to copy, display, or perform the work; but have I also *distributed*—or offered to distribute—tangible (RAM) copies to the general public, by transferring ownership of RAM copies to them? Have I offered to distribute RAM copies for purposes of public display? Or should one view the user who accesses my website as the functional equivalent of a patron consulting a book at a library? (Note, however, that there is some authority for the proposition that merely making a book available *at* a library for temporary perusal effects a distribution to the public.)<sup>201</sup> Changing the facts may result in the transmission appearing more or less like a publication. Suppose first that my website authorizes users to make copies (other than the RAM copies which are made as a matter of course) of the material found on the site. This might seem more like a conventional publication, because the end result is the (at least offered) release of tangible copies to the general public.<sup>202</sup> Second, suppose that my website expressly forbids the user from making copies, other than the RAM copy. If the RAM copy itself does not count as a copy resulting in a distribution, then arguably there has been no distribution and no publication either. Third, if the website contains streaming content, such as music, such that no copy is automatically made in RAM, the question would appear to turn on whether users are authorized to make copies of the streamed content.<sup>203</sup>

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201. In *Hotaling v. Church of Jesus Christ of Latter-Day Saints*, 118 F.3d 199, 203 (4th Cir. 1997), the court appears to hold that a library's act of merely making an infringing work available to the public for on-site inspection constituted an unauthorized distribution, stating that,

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

In dissent, Judge Kenneth K. Hall noted that, under section 106 of the Copyright Act, the copyright owner has the exclusive right to "distribute copies . . . of the copyrighted work to the public *by sale or other transfer of ownership, or by rental, lease, or lending.*" *Id.* at 205 (Hall, J., dissenting) (quoting 17 U.S.C. § 106(3)). Judge Hall was unwilling to conclude that a library "lend[s] a work each time a patron consults it," and noted in addition that there was no evidence that anyone had even "used or looked at an infringing copy during the limitations period." *Id.* Other cases, however, take a narrower view. *See, e.g., Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1162–63 (9th Cir. 2007) (holding that in-linking does not constitute distribution); *see also supra* note 130 (citing other relevant cases).

202. *See Chang, supra* note 118, at 238.

203. *See United States v. Am. Soc'y of Composers, Authors & Publishers*,

The only reported decision thus far addressing this fact pattern is *Getaped.com, Inc. v. Cangemi*.<sup>204</sup> In *Getaped*, the plaintiff registered its copyright after the alleged infringement began, but within three months of having first made the copyrighted material available to the public on its website.<sup>205</sup> The issue therefore was whether the defendant either had infringed an unpublished work, in which case no statutory damages and attorneys' fees would be available for any infringement commenced before the date of registration, or had infringed a published work, in which case the registration within three months of first publication would entitle the plaintiff to statutory damages and fees even for acts committed prior to registration.<sup>206</sup> The district court concluded that the Internet transmission did constitute a publication, citing several cases holding that a defendant's unauthorized transmission of copyrighted works over the Internet constitutes a violation of the copyright owner's exclusive right to distribute tangible copies.<sup>207</sup> The court concluded that transmission is not merely a performance or display of a work, because

the user not only views the page but can also view—and copy—the code used to create it. In other words, merely by accessing a webpage, an Internet user acquires the ability to make a copy of that webpage . . . . Consequently, when a website goes live, the creator loses the ability to control either duplication or further distribution of his or her work. . . . Thus, when a webpage goes live on the Internet, it is distributed and “published” in the same way the music files in *Napster* or the photographs in the various *Playboy* decisions were distributed and “published.” Under this analysis, *Getaped* did “publish” its website (and, necessarily, the underlying source code) on July 15, 2000, when its modified website first became accessible on the Internet.<sup>208</sup>

The *Getaped* decision has elicited different opinions. On the one hand, David Nimmer applauds the decision, reasoning that making the work available over the Internet is the functional equivalent of a lending.<sup>209</sup> On the other, Roger Schechter and Jay Thomas, as well as student commentator RayMing Chang, have argued that transmissions are not distributions

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485 F. Supp. 2d 438, 442–44 (S.D.N.Y. 2007) (holding that, while streaming constitutes a public performance, downloading constitutes a reproduction of a musical work); Chang, *supra* note 118, at 239.

204. 188 F. Supp. 2d 398 (S.D.N.Y. 2002).

205. *Id.* at 401.

206. *Id.* at 400.

207. *See id.* at 401.

208. *Id.* at 402 (footnote omitted).

209. *See* 1 NIMMER & NIMMER, *supra* note 32, § 4.07[B].

but performances, and that websites that do not permit copying (other than, again, the RAM copying that is a necessary incident to viewing) do not result in any *authorized* tangible copies being made.<sup>210</sup> Thus far, the Copyright Office has not taken an official position on the matter.<sup>211</sup>

As the preceding discussion suggests, the meaning of publication remains, in many circumstances, fuzzy, despite—or perhaps because of—more than one hundred years of case law exposition. Questions such as what counts as a limited publication, whether performance or display prior to 1978 could *ever* count as a publication, and whether Internet transmissions constitute publications (and if so, what consequences therefore follow) still often admit of no clear answer. And while publication is, in one respect, less significant today than it once was, given that publication without notice no longer casts a work into the public domain, publication remains important for all of the many other reasons discussed above in Part II. In the following Part, I propose a redefinition of publication that attempts to reconcile the existing case law to the extent possible, and to provide a principled basis for addressing new issues, including questions relating to Internet transmissions.

### III. REDEFINING PUBLICATION

The preceding discussion of the case law on publication shows that, even after Congress codified a definition of the term in 1976, many interpretive puzzles remain. The cases themselves suggest that the meaning of the term is often unpredictable, and that outcomes may be driven more by the de-

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210. See BRUCE P. KELLER & JEFFERY P. CUNARD, COPYRIGHT LAW: A PRACTITIONER'S GUIDE § 6:1.2 n.94 (2007) (stating that *Getaped* is difficult to reconcile with the principle that public display of a work is not publication); ROGER E. SCHECHTER & JOHN R. THOMAS, INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS 81 (2003) ("It is clear . . . that under the statutory language now in effect there has been no distribution of copies or phonorecords . . . to the public and hence no publication when a work is disseminated electronically."); Chang, *supra* note 118, at 236 (agreeing with Schechter and Thomas); Gard, *supra* note 17, at 699 (questioning whether a work posted on the Internet with copying protection would be considered published under the *Getaped* rule).

211. See U.S. COPYRIGHT OFFICE, CIRCULAR 65: COPYRIGHT REGISTRATION FOR AUTOMATED DATABASES 2 (2006) ("It is unclear whether online availability for the user constitutes publication of the work under the copyright law."); U.S. COPYRIGHT OFFICE, CIRCULAR 66: COPYRIGHT REGISTRATION FOR ONLINE WORKS 3 (2006) [hereinafter ONLINE CIRCULAR] ("The definition of 'publication' in the U.S. copyright law does not specifically address online transmission.").



sire to achieve certain results than by conformity with settled principles. None of this would matter much if publication were merely a relic of a bygone approach to copyright. But the whether, where, and when of publication still have consequences, as discussed above, both with respect to older works and with respect to works being created today.

In this Part, I argue that Congress or the courts could improve the law relating to publication in three important respects. First, I will argue that the standard definition of publication, as developed in the pre-1976 case law and as codified in 1976, is misleading, but that one can nevertheless distill certain principles from the case law that would reconcile many of the latent inconsistencies in the standard approach. Second, I will argue that, although transmitting works over the Internet plausibly *can* be viewed as publication, the better view is probably *not* to equate transmission with publication for all purposes. Third, however, I will argue that the best policy may be to define publication differently in different contexts. A broad definition of publication (that includes Internet transmission) may be sensible for such purposes of triggering the statutory damages grace period, whereas a narrower definition may be better for other purposes, such as imposing the duty to deposit and determining country of origin.

#### A. A (NEW AND IMPROVED) GENERAL DEFINITION OF PUBLICATION

As we have seen, the 1976 Act defines publication to mean the “distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending,” as well the “offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display.”<sup>212</sup> This definition is said to largely track the meaning of the term as developed in the pre-1976 case law.<sup>213</sup> Moreover, courts continue to distinguish (general) publications from limited (i.e., non-) publications, even with respect to works created or (allegedly) published after 1976.<sup>214</sup> A (general) publication therefore is a distribution

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212. 17 U.S.C. § 101 (2000 & Supp. V 2007).

213. See *supra* text accompanying notes 123–28.

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

that fails to satisfy any one of the three criteria required for a limited publication, namely a distribution (1) to a limited group, (2) for a limited purpose, and (3) "without the right of diffusion, reproduction, distribution or sale."<sup>215</sup> This definition of limited publication, however—and the definition of general publication that is implicit within—leaves much to be desired.

A first problem is that it is hardly obvious exactly what a "limited group" or a "limited purpose" means. "All people living in Chicago on December 1, 1998," is a limited group of all people living on earth at that date, of all people who have ever lived, and of all people who ever will live. "All people interested in reading this Article" is a limited group (alas, perhaps very limited) of all legal scholars, let alone of people generally. Courts have occasionally acknowledged that what they really mean is something else. Thus, an author who distributes, or offers to distribute, copies of her work to anyone who is willing (or may be willing) to pay the asking price for it has clearly made a general publication, even if the number of such interested persons is very small.<sup>216</sup> On the other hand, some courts have held that the distribution of copies to members of a given industry, in order to drum up business, is a distribution to a limited group, even though members of the group may number in the hundreds.<sup>217</sup>

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215. See *White v. Kimmell*, 193 F.2d 744, 746–47 (9th Cir. 1952).

216. See *Brown v. Tabb*, 714 F.2d 1088, 1091 (11th Cir. 1983) (stating that the distribution of jingles to three broadcasters was not made to a limited group because the works were available to anyone who wanted them); *Roy Exp. Co. Establishment of Vaduz, Liech. v. Columbia Broad. Sys., Inc.*, 672 F.2d 1095, 1102 n.14 (2d Cir. 1982) ("[A]vailability for public sale constitutes publication, even if actual sales are minimal."); *Cont'l Cas. Co. v. Beardsley*, 253 F.2d 702, 706–07 (2d Cir. 1958); *William A. Graham Co. v. Haughey*, 430 F. Supp. 2d 458, 470 (E.D. Pa. 2006) (noting that the distribution of proposals to "selected clients" was not made to a limited group); *Milton H. Greene Archives, Inc. v. BPI Commc'ns, Inc.*, 378 F. Supp. 2d 1189, 1198 (C.D. Cal. 2005) (observing that the distribution of photographs to studios to promote motion pictures was not made to a limited group).

217. See, e.g., *Brewer v. Hustler Magazine, Inc.*, 749 F.2d 527, 528–29 (9th Cir. 1984) (holding that the plaintiff's distribution of two hundred business cards bearing a small reproduction of the subject photograph to persons in the advertising industry was made to a limited group); *Hub Floral Corp. v. Royal Brass Corp.*, 454 F.2d 1226, 1229 (2d Cir. 1972) ("It has long been settled that the taking of orders through employment of samples, catalogs, or advertisements of a work does not amount to publication of the work."); *Hirshon v. United Artists Corp.*, 243 F.2d 640, 645 (D.C. Cir. 1957) (holding that the distribution of \$2000 worth of songs to broadcasting stations and professional musicians for "plugging" purposes constituted a limited publication).

The term "limited purpose" is similarly vague. Courts sometimes seem to mean that the distribution is made to effect some limited goal, such as (again) stimulating interest in the work or a related work,<sup>218</sup> but in other cases the purpose appears to have been much broader. In *Burke*, for example, the author distributed his work for the purpose of allowing it to be broadcast on German television.<sup>219</sup> By this logic, however, virtually any distribution coupled with some field-of-use restriction would be for a limited purpose. For that matter, unless the effect of the distribution was to dedicate the work to the public (which is often, circularly, the question the analysis is attempting to answer in the first place), one may assume that the distribution carried with it at least implicit restrictions on what the recipient could do with the work. I have no right to make unrestricted photocopies of books that I buy at the local bookstore, because those works are (for the most part) still protected by copyright. But that hardly means that the author has distributed the work for a limited purpose, because almost all distributions then are for a limited purpose, and the requirement is meaningless.

The third criterion, "without the right of diffusion, reproduction, distribution or sale," is vague for the same reason. Unless the effect of the distribution itself is to thrust the work into the public domain (which it no longer does, in any event), then one would expect most distributions to be "without the right of diffusion [or] reproduction." That is to say, absent permission from the author, or an applicable exception such as fair use, the recipient has no right to "diffuse" (assuming that diffusion means, more or less, "communicate," and therefore incorporates such concepts as public performance and transmission)<sup>220</sup> or

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218. See, e.g., *Brewer*, 749 F.2d at 528–29 (holding that the distribution of business cards was for the "very narrow purpose [of] obtaining employment"); *Hirshon*, 243 F.2d at 645; *Milton H. Greene Archives*, 378 F. Supp. 2d at 1199. But see *William A. Graham Co.*, 430 F. Supp. 2d at 470 (noting that distribution for pecuniary gain was not made for a limited purpose); *Cont'l Cas. Co.*, 253 F.2d at 706–07.

219. See *Burke v. Nat'l Broad. Co.*, 598 F.2d 688, 693 (1st Cir. 1979).

220. As far as I can tell, neither *White v. Kimmell*, nor any court citing *White v. Kimmell*'s definition of "limited publication," has ever clarified what exactly the word "diffusion" means in this context. The district court in *White v. Kimmell*, however, quoted extensively from *Keene v. Wheatley*, 14 F. Cas. 180 (C.C.E.D. Pa. 1861) (No. 7644), a case that appears to use the term "diffusion" more or less as a synonym for "communication." See *White*, 94 F. Supp. 502, 505–06 (S.D. Cal. 1950), *rev'd*, 193 F.2d 744 (9th Cir. 1952); *Keene*, 14 F. Cas. at 199. The Oxford English Dictionary defines "diffusion" to mean, in this

reproduce the copyrighted work. Put another way, most distributions from author to recipient would be "without the right of diffusion [or] reproduction," unless the author grants such permission, either expressly or implicitly. To be sure, some courts used to follow the so-called *Pushman* doctrine that, when an author made an unconditional transfer of her work, she was deemed to have assigned the copyright as well, absent an express reservation of rights.<sup>221</sup> As far as I can tell, however, all of the cases in which courts applied this rule involved either paintings, on the one hand, or articles or drawings sold to periodicals, on the other.<sup>222</sup> In any event, both state and federal copyright law have long since repudiated the *Pushman* doctrine.<sup>223</sup>

And yet, one might hasten to note, the definition of limited publication that courts favor is disjunctive: it says "without the right of diffusion, reproduction, distribution or sale."<sup>224</sup> Per-

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context, "[s]preading abroad, dispersion, dissemination (of abstract things, as knowledge)." 3 OXFORD ENGLISH DICTIONARY 346 (1933).

221. See *Pushman v. N.Y. Graphic Soc'y, Inc.*, 39 N.E.2d 249, 251 (N.Y. 1942) (holding that an absolute and unconditional sale of a work of art transfers the (common-law or statutory) copyright to that work, unless the artist expressly reserves the copyright).

222. See, e.g., *Geisel v. Poynter Prods., Inc.*, 295 F. Supp. 331, 343-44 (S.D.N.Y. 1968) (holding that Dr. Seuss's sale of cartoons to a publisher included the transfer of his common-law copyright therein, and citing other cases involving paintings, drawings, and articles appearing in periodicals); *Grandma Moses Props., Inc. v. This Week Magazine*, 117 F. Supp. 348, 350 (S.D.N.Y. 1953). *Pushman* itself is ambiguous regarding its reach. On the one hand, the *Pushman* court cited with approval *Parton v. Prang*, 18 F. Cas. 1273 (C.C.D. Mass. 1872) (No. 10,784), in which the court stated that,

if the sale was an absolute and unconditional one, and the article was absolutely and unconditionally delivered to the purchaser, the whole property in the *manuscript or picture* passes to the purchaser, including the right of publication, unless the same is protected by copyright, in which case the rule is different.

See *Pushman*, 39 N.E.2d at 250 (quoting *Parton*, 18 F. Cas. at 1278) (emphasis added). *Parton* itself, however, involved copies of a painting, as did another case cited in both *Parton* and *Pushman*: *Turner v. Robinson*, (1860) 10 Ir. Ch. R. 121, 143 (Rolls C.). See *Pushman*, 39 N.E.2d at 250; *Parton*, 18 F. Cas. at 1278. On the other hand, the *Pushman* court also noted dicta from *Stephens v. Cady*, 55 U.S. (14 How.) 528, 531 (1852), a case involving maps, that copyright "will not pass with the *manuscript* unless included by express words in the transfer." See *Pushman*, 39 N.E.2d at 251 (emphasis added).

223. As for federal law, see 17 U.S.C. §§ 202, 204(a) (2000) and *Dumas v. Gommerman*, 865 F.2d 1093, 1097 & n.9 (9th Cir. 1989). As for state law, see, for example, N.Y. ARTS & CULT. AFF. LAW § 14.01 (McKinney 1984) and *Samet & Wells, Inc. v. Shalom Toy Co.*, 185 U.S.P.Q. (BNA) 36, 38-39 (E.D.N.Y. 1975).

224. *White v. Kimmell*, 193 F.2d 744, 746-47 (9th Cir. 1952) (emphasis

haps, then, an author who distributes copies to a limited group for a limited purpose and without conferring the right to diffuse or reproduce those copies, but with permission to distribute or sell them, has made a general publication. The problem with construing the definition in such a literal fashion, however, is that normally the “first-sale” or “exhaustion” doctrine entitles the owner of a lawfully made copy to distribute or sell that copy, without obtaining permission from the copyright owner. The Supreme Court first recognized the first-sale doctrine in federal copyright law in *Bobbs-Merrill Co. v. Straus*, based on its interpretation of the 1909 Act.<sup>225</sup> Other courts, however, had recognized the doctrine before,<sup>226</sup> and the 1976 Act expressly codifies it.<sup>227</sup> Cases since the early twentieth century appear to support the proposition that the exhaustion doctrine applies to common-law copyrights as well.<sup>228</sup> Moreover, in other related areas of the law, courts do not appear blithely to impose implicit duties of confidentiality. In the context of trade secret law,

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added). Since a sale is one type of distribution, the very last portion of the definition seems redundant, if nothing else. For an alternate interpretation of the definition (which I reject), see *infra* note 248.

225. 210 U.S. 339, 350–51 (1908).

226. See *Harrison v. Maynard, Merrill & Co.*, 61 F. 689, 691–92 (2d Cir. 1894); *Clemens v. Estes*, 22 F. 899, 900–01 (C.C.D. Mass. 1885).

227. See 17 U.S.C. § 109(a) (2000) (“[T]he owner of a particular copy or phonorecord lawfully made under this title . . . is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord.”).

228. An early case recognizing this principle, *Baker v. Libbie*, 97 N.E. 109 (Mass. 1912), involved a suit against a person who planned to auction off personal correspondence authored by Christian Science founder Mary Baker Eddy. According to the court,

[t]his exact question has never been presented for adjudication, so far as we are aware. . . . But on principle it seems to flow from the nature of the right transferred by the author to the receiver and of that retained by the writer in ordinary correspondence, that the extent of the latter’s proprietary power is to make or to restrain a publication, but not to prevent a transfer. The rule . . . is that in the absence of some special limitation imposed either by the subject-matter of the letter or the circumstances under which it is sent, the right in the receiver of an ordinary letter is one of unqualified title in the material on which it is written. He can deal with it as absolute owner subject only to the proprietary right retained by the author for himself . . . to the publication or nonpublication of ideas in its particular verbal expression.

*Id.* at 112; accord *Salinger v. Random House, Inc.*, 811 F.2d 90, 95 (2d Cir. 1987) (“Having ownership of the physical document, the recipient (or his representative) is entitled to deposit it with a library and contract for the terms of access to it.”); *McCormick’s Estates*, 80 Pa. D. & C. 413, 414 (Orphans’ Ct. Pa. 1952); Comment, *Property Rights in Letters*, 46 YALE L.J. 493, 494–95 & nn.6–7 (1937).

for example, the *Restatement (Third) of Unfair Competition* suggests imposing such a duty only when the recipient knows or should know that the disclosing party intends for the information to remain confidential, and the disclosing party is reasonable in inferring consent to this condition.<sup>229</sup> Contrast this approach with the free and easy imposition of an implicit duty to refrain from distribution or resale of the Oscar statuette in the *Academy* case.<sup>230</sup>

To the extent one attempts nonetheless to make some principled distinctions, let us attempt to catalog the various possible candidates for general publication, from the easiest cases to the hardest, so that we can see precisely where the possible fault lines lie. The easiest might be the typical case in which the copyright owner (or her agent) actually distributes tangible copies (note the plural) of the work to the “general public,” meaning (as suggested above) anyone who wants it for the asking price. The next easiest might be a case in which the author offers to distribute copies (plural) to the general public, for example by putting them on sale. Although the language of the 1976 Act, curiously, does not literally address this situation—it speaks of offers to distribute for the purpose of further distribution, public performance, and public display, and not for, say, the purpose of mere personal enjoyment—it seems reasonably clear from the case law that offers for sale to the general public count as publications.<sup>231</sup> This would be consistent with the cases stating that the sale of even a single copy can constitute a general publication, assuming that copies were available to anyone who wanted them.<sup>232</sup>

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

230. See 944 F.2d 1446, 1452–54 (9th Cir. 1991).

231. Roy Exp. Co. Establishment of Vaduz, Liech. v. Columbia Broad. Sys., Inc., 672 F.2d 1095, 1102 n.14 (2d Cir. 1982) (“Though the cases contain much talk of publication occurring upon the sale of a ‘single copy,’ . . . such statements express the thought that availability for public sale constitutes publication, even if actual sales are minimal.” (citing *Bobbs-Merrill Co. v. Straus*, 147 F. 15, 19 (2d Cir. 1906), *aff’d*, 210 U.S. 339 (1908))); *William A. Meier Glass Co. v. Anchor Hocking Glass Corp.*, 95 F. Supp. 264, 268 (W.D. Pa. 1951) (stating that the plaintiff’s design “was offered for sale and constituted a general publication whereby the plaintiff abandoned and surrendered any common law property right it may have had in said design”). *But see* *Arista Records LLC v. Greubel*, 453 F. Supp. 2d 961, 969 n.11 (N.D. Tex. 2006) (citing *In re Napster, Inc. Copyright Litig.*, 377 F. Supp. 2d 796, 804–05 (N.D. Cal. 2005)) (stating that only an offer for purposes of further distribution, public performance, or public display constitutes a publication, according to a literal reading of section 101).

232. See, e.g., *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277,

A more difficult question would be whether a public offer to sell a single copy—say, of a unique work of art—to the highest bidder would constitute a general publication. Although the logic of the preceding cases might suggest that the *offer* to sell a single copy can also serve as a publication, the only case I am aware of that addresses this issue, *Werckmeister v. American Lithographic Co.*, actually draws a distinction between the offer for sale of a single copy of a book, which effects a publication,<sup>233</sup> and the exhibition for sale of a unique work of art, which does not.<sup>234</sup> At first blush, the court's reasoning—that the author of a unique work of art generally seeks to profit from the sale of the original and not from reproductions<sup>235</sup>—seems a bit of a non sequitur,<sup>236</sup> but perhaps there was something to it at the time. In the case of books, the distribution of copies to prospective publishers for consideration is, by all accounts, a limited publi-

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299–300 (3d Cir. 1991) (“[A] general publication may be found when only one copy of the work reaches a member of the general public . . .” (quoting *Brown v. Tabb*, 714 F.2d 1088, 1091 (11th Cir. 1983))); *Roy Export*, 672 F.2d at 1102 n.14; *Werckmeister v. Am. Lithographic Co.*, 134 F. 321, 325 (2d Cir. 1904) (citing *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834)); see also H.R. REP. NO. 94-1476, at 138 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5754 (stating that, under the definition included in the 1976 Act, “a work is ‘published’ if one or more copies or phonorecords embodying it are distributed to the public—that is, generally to persons under no explicit or implicit restrictions with respect to disclosure of its contents”). Notice, however, one curious implication of the rule that offers made to the general public effect publications. If I were to compose a work without revealing the precise expression to anyone, and then offer to sell copies of the work (described in somewhat general terms) to the general public, presumably the offer would constitute a general publication, despite the fact that no one besides me has yet seen the actual text (or even responded to the offer). I thank David Nimmer (who agrees that the offer would constitute a general publication) for suggesting this hypothetical.

233. See *Werckmeister*, 134 F. at 325 (“[I]n case of a book, . . . [t]he unrestricted offer of even a single copy to the public implies the surrender of the common-law right.”).

234. See *id.* at 326 (“The exhibition of a work of art for the purpose of securing a purchaser or an offer to sell does not adversely affect the right of copyright . . .”).

235. See *id.*

236. The court also noted that copyright law at that time did not (as it now does) confer an affirmative right of exhibition or display, see *id.*, but it is not so clear why, logically, this compels the result that exhibition cannot constitute publication. Cf. Nimmer, *supra* note 124, at 188–89 (arguing that the lack of copyright protection for sound recordings (prior to 1972) did not logically preclude the result that the publication of a sound recording resulted in publication of the underlying musical work). In addition, the court noted that (as in the later, but factually similar, case of *American Tobacco Co. v. Werckmeister*, 207 U.S. 284, 287 (1907)), the gallery owner had expressly forbidden observers from copying. See *Werckmeister*, 134 F. at 326–27.

cation; general publication occurs only when the authorized publisher makes copies available to the public.<sup>237</sup> Similarly, in the case of unique works of art, the author's distribution of the original to *prospective* dealers or exhibitors presumably would be at most a limited publication as well. But whether the *authorized* dealer's exhibition of the original to the public, even if for purposes of sale, should be analogized to the authorized publisher's making copies of a literary work available to the general public, is less clear. The result of equating the two would be to require (prior to 1989) the visual artist to affix copyright notice to the original, which as noted above might have resulted in the defacement of the work.<sup>238</sup> And while it might seem unpalatable to have different rules for different classes of works, this dichotomy is also evident in cases involving personal correspondence, which, in the days before e-mail, typically existed in unique copies. As we have seen, the owners of such correspondence can shop it to libraries or archives without effecting a general publication, perhaps due to concerns that (prior to 1989) a contrary rule would have unfairly burdened the letter writer with a duty expressly to restrain the recipient from offering to transfer title to the physical copy.<sup>239</sup> Perhaps the best one can do to reconcile the cases is to posit a presumption that the public offer of a single copy constitutes a general publication absent sufficient countervailing reasons such as (in the case of unique works of art offered for sale prior to 1989) the need to avoid defacement, or (in the case of personal correspondence) the desire to protect unique authorial privacy or other interests. In such special cases, perhaps no publication oc-

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237. See *supra* note 175 and accompanying text.

238. See *supra* note 146 and accompanying text.

239. That is, given the unique circumstances surrounding personal correspondence—the author retains the copyright but rarely, if ever, retains the physical copy—a rule equating the recipient's offer to sell the work with publication might have undermined the author's copyright and privacy interests all too easily. See *Wright v. Warner Books, Inc.*, 748 F. Supp. 105, 111 (S.D.N.Y. 1990) (stating that, in the context of fair use, "what motivated the Court of Appeals in *Salinger v. Random House, Inc.*, 811 F. 2d 90 (2d Cir. 1987)], at least in part, was concern over J.D. Salinger's right to privacy," but that given Richard "Wright's death in 1960, those concerns . . . are absent here"), *aff'd*, 953 F.2d 731 (2d Cir. 1991); *Baker v. Libbie*, 97 N.E. 109, 111–12 (Mass. 1912) (suggesting that public knowledge of the letters at issue in that case would not have violated "delicate feelings," but that letter writers are entitled as much as other authors to enjoy the fruits of their labor). But see Comment, *supra* note 228, at 503–04 (questioning whether letter writers' interests in privacy or in enjoying the fruits of their labor justifies continued recognition of their common-law copyrights post-mortem).



curs unless and until the recipient is given, and lawfully exercises, the authority to make additional copies and to distribute those copies to the public.<sup>240</sup>

The next case in the factual progression developed above would be one in which the author, in the words of the 1976 Act, "offer[s] to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display."<sup>241</sup> According to the House Report accompanying the 1976 Act, this provision "makes clear that, when copies or phonorecords are offered to a group of wholesalers, broadcasters, motion picture theaters, etc., publication takes place if the purpose is 'further distribution, public performance, or public display.'"<sup>242</sup> The actual text, however, leaves some gaps. It is unclear, for example, whether the "further distribution" referenced in section 101 must be a distribution "to the public," although this is probably the intended meaning. By linking the terms "further distribution, public performance, or public display," the statutory language corresponds to Copyright Act section 106, which confers upon copyright owners the rights to "distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending," as well the rights to publicly perform the work and to publicly display copies.<sup>243</sup> More perplexing is that the statute does not use the term "limited group," as in the *White v. Kimmell* definition of "limited publication,"<sup>244</sup> but rather just "group." But if the group referred to in the statutory text were a group larger than a limited group, then it would seem that the offer to distribute copies to that group would constitute a general publication in and of itself, regardless of the "purpose" for which the offer to distribute is made, and the statutory language would be superfluous.<sup>245</sup> Cases interpreting the

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240. Cf. 1 RICKETSON & GINSBURG, *supra* note 119, § 6.45 (suggesting that, under the Berne Convention—which, unlike U.S. domestic law, provides that publication does not occur unless "the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work," Berne Convention, *supra* note 27, art. 3(3)—the exhibition for sale of a unique work of art does not constitute publication, because "there is no making available of copies to satisfy the reasonable requirements of the public" (emphasis added)).

241. 17 U.S.C. § 101 (2000 & Supp. V 2007).

242. H.R. REP. NO. 94-1476, at 138 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5754.

243. 17 U.S.C. § 106(3)–(6) (2000 & Supp. V 2007) (emphasis added).

244. See *supra* Part II.B.4.

245. See 1 NIMMER & NIMMER, *supra* note 32, § 4.04 (inferring that "an of-

meaning of this provision of section 101 are few and far between.<sup>246</sup>

The hardest case, in the sense of the one that is probably most difficult to classify as a general or limited publication, would be one in which the author (or her agent) distributes a single copy to a single person, without express restriction on what the person may do with that copy. Several considerations may be relevant. First, if the recipient is a person who has responded to a general offer—or, alternatively, a person indiscriminately selected by the author for receipt of the copy—then it would seem that a publication has been effected: both the offer and the distribution were directed at the general public, and (absent other facts to the contrary) the recipient is free to sell, give away, or lend the copy to other members of the general public.<sup>247</sup> Second, however, if the recipient is instead a limited group of one—a single person chosen by the author for a particular reason—then, under the limited-publication analysis, the issue of whether a general publication has occurred would depend on other facts. A strict interpretation of limited publication would suggest that, if the recipient is free to diffuse, reproduce, distribute, or sell the copy, the author has effected a general publication. As noted above, however, the first-sale doctrine normally would permit the recipient to distribute or sell his copy, though not to reproduce or “diffuse” it. Courts nevertheless strive to avoid this literal interpretation, either by inferring (from thin air, in some instances) an implicit duty against alienation or by ignoring (in the context of personal correspondence) the matter altogether. A literal interpretation also would seem to result in the general publication of plays and musical works that authors disclose to actors and musicians merely for purposes of public performance (diffusion), unless the actors and musicians were somehow considered mere

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fer to distribute to members of the public for their own use” would constitute a publication as well).

246. Cf. *Bagdadi v. Nazar*, 84 F.3d 1194, 1198–99 (9th Cir. 1996) (holding that a school constituted a “group of persons”). Building on the preceding analysis, the next question would be whether an offer to distribute multiple copies to a single person, and not a group, constitutes a publication. Presumably, distributing a single copy of a play or musical work to a single person chosen by the author—or even to a limited group (say, of actors or musicians)—for purposes of public performance, would not be a publication; neither would distributing a single copy of a work of art for public display. Distributing a single copy to a single person, with instructions that she in turn pass it along (but not copy it) to others, on the other hand, might conceivably be a publication.

247. See *supra* text accompanying notes 224–29.

agents of the author. The literal approach would also seem to cover a case in which the author transfers a copy of her work to a friend and expressly permits the friend to make additional personal copies, even if the author enjoins distribution of those copies. And yet it strains credulity to think that permitting a friend to make extra copies of, say, a photograph or poem for personal use results in the general publication of the photograph or poem.<sup>248</sup>

Therefore, with respect to the question of whether the distribution of a single copy to a single limited-group recipient can constitute a general publication, a key consideration should be whether the recipient himself is free to effect a general publication in any of the ways sketched out above—that is, by distributing or offering to distribute a copy or copies to the general public. Adoption of this definition would eliminate some of the anomalies alluded to above, under which an author who permits the recipient to make personal copies or to publicly perform or display the work would be viewed as having made a general publication. It would, rightly, cover situations in which the author has authorized the recipient to make copies for further distribution to the general public. Still, it would leave open the possibility that a general publication occurs whenever the author transfers a copy to the recipient and the recipient remains free to exercise his first-sale rights to sell or otherwise dispose of his single copy, or when the author transfers a copy to and authorizes the recipient to make and distribute copies to the general public at a later time.

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248. Alternatively, perhaps one could argue that my exegesis of limited publication has been incorrect from the start, and that a publication is limited unless, *inter alia*, the author conveys to the recipient the right to diffuse, reproduce, distribute, *and* sell the work. In other words, maybe the phrase “without the right of diffusion, reproduction, distribution or sale” should be read to mean something like “without the right to do all of the following: diffusion, reproduction, distribution, or sale.” Reading the word “or” to mean, in context, “and,” is not without some precedent within the context of statutory interpretation. *See, e.g.,* *Skutt v. Dillavou*, 13 N.W.2d 322, 325 (Iowa 1944) (“The courts do not hesitate to construe ‘and’ as ‘or’ if necessary to arrive at legislative intent.”); *Robson v. Cantwell*, 141 S.E. 180, 184 (S.C. 1928). But this definition seems to go too far in the other direction. Distributing copies—or even offering to distribute copies, to credit the statutory text—to even a limited group for the specific purpose of further distribution of those copies to the general public would appear to be a general publication, even if the group is not authorized to *make* its own copies. More generally, it has long been common for authors to license their individual rights (to copy, to perform, etc.) to different entities, without licensing any one entity to engage in all of the activities covered by the copyright.

These problems suggest that the definition should be further refined, so that the transfer of a single copy to a single recipient effects a general publication only when the recipient actually makes a lawful distribution, or offers to make a lawful distribution, to the general public. On this revised definition, the author's mere offer of a single copy to a single recipient could never be a general publication, because the recipient himself cannot make a general publication until he is in actual possession of the copy.<sup>249</sup>

The main drawback of this proposed redefinition is that it might appear to be in tension with the "offering to distribute" language of section 101, which language suggests that a mere offer (at least to a group) *can* effect a general publication if the offer is for the purpose of further public distribution, performance, or display of the work. And if a mere offer to distribute copies to such a group can effect a publication under some circumstances, even though the purpose of the proposed distribution is to effect only public performance or display, then surely an actual distribution to such a group for such a purpose should be a publication. Perhaps the only way out of this logical contretemps is to construe the offering-to-distribute language of section 101 as involving offers made to a group of persons that is more than merely a limited group.<sup>250</sup> That is to say, the

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249. So construing the language would avoid making formalistic distinctions, based on number of recipients or number of copies. It would also avoid casting the offering of a single copy to a single recipient as a general publication, if the offer contemplates a general publication at some point beyond the immediate future—or, a fortiori, merely permits but does not request the recipient to make a general publication. In such a case, a general publication would occur only when the recipient exercises his right to make a general publication, not before. As such, it would be analogous to the rule that merely delivering a copy to a prospective publisher or to a printer is not a publication, whereas the delivery to retail stores is. *See, e.g.*, 1 NIMMER & NIMMER, *supra* note 32, § 4.13[A][1].

250. Alternatively, perhaps one could focus on the words "for purposes of." An author who offers to distribute even a single copy to a single recipient effects a general publication if her *purpose* is to effect, in the immediate future, the further distribution of copies to the general public or to permit the general public to perform or display the work. (Note that, when a broadcaster transmits a performance of a work over the airwaves or over the Internet, the broadcaster has effected a public "performance" of the work. *See* 17 U.S.C. § 101 (2000 & Supp. V 2007) (defining "perform," "publicly," and "transmit").) A member of the general public who tunes into the broadcast also arguably "performs" the work, through rendering or playing it "by means of any device or process," *see id.*, but she does not "publicly" perform it unless she happens to be playing the radio or television or accessing Internet in a place open to the general public, *see id.* She also would be publicly performing a work if she

“group of wholesalers, broadcasters, motion picture theaters, etc.,” referenced in the House Report are not a limited group, but rather a subset of the general public—the offer is open to anyone who is willing to pay.<sup>251</sup> As suggested above, this interpretation tends to make the statutory language superfluous, if I am correct in arguing that an offer to distribute copies to a more-than-limited group is necessarily a general publication. But perhaps the interpretation can be defended on the ground that it clarifies what the law already was and would be, even in the absence of the express statutory language.<sup>252</sup>

A final wrinkle concerns the conflicting case law on the question of performances and displays. As we have seen, some courts have stated that publication may occur when the author permits the audience to copy the work, while other authorities adhere to the narrower view—arguably adopted in the 1976 Act—that performance and display by themselves never constitute publication. There is much to be said for the view that an author who permits others to make and distribute copies of her work has effected a general publication, at least once such permission has been exercised, every bit as much as one who distributes tangible copies herself. The difficulty lies more in the practical consideration of proving whether such permission has been implicitly given, and, if so, when has it been exercised. To the extent the issue can arise today only with respect to pre-1978 performances and displays, perhaps the better view is not to consider such authorized copying by members of the general

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played a CD or DVD embodying that work in a public place. *See id.* Whether these acts infringe would depend on the applicability of a liability exception such as fair use or 17 U.S.C. § 110(4). *See id.* § 110(4) (2000 & Supp. V 2007) (providing an exception to liability for unauthorized public performances of nondramatic literary or musical works where no purpose of commercial advantage exists and fees are not collected). But legislative history suggests that the language was intended to cover situations in which the “group of persons,” not the public, effects the further distribution, performance, or display. *See supra* text accompanying note 242.

251. *See* H.R. REP. NO. 94-1476, at 138 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5754. Depending on the degree of vertical integration, of course, there may be only a limited number of distributors or broadcasters or theaters with whom a copy is contractually bound to deal. At least in theory, though, such exclusive dealing arrangements are open to revision from time to time. *See, e.g.,* *Barry Wright Corp. v. ITT Grinnell Corp.*, 724 F.2d 227, 237–38 (1st Cir. 1983).

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

public to constitute a general publication, but to require cogent proof that such permission was, in fact, given.<sup>253</sup> Such proof presumably will be harder to come by as the years progress, and thus, this issue may fade into oblivion somewhat sooner than will some other issues relating to publication. Recall that cases such as *Estate of King* and *Letter Edged in Black Press*, in which performance or display was alleged to have constituted publication, probably could have been disposed of on the less controversial ground that the copyright owner distributed copies to the general public.<sup>254</sup>

In sum, this Article suggests the following rules to reconcile the competing statutory and case law definitions of publication, and to avoid undesirable results. First, a general publication occurs if the author (or her agent) distributes, or offers to distribute, at least one copy to the general public—that is, to a more-than-limited group (anyone who is interested) or to members of the public indiscriminately. Second, a general publication occurs if (1) the author (a) actually distributes at least one copy to at least one person, and (b) authorizes that person to effect or authorize a general publication; and (2) the person so authorized, or someone that person himself authorizes, actually distributes or offers to distribute at least one copy to the general public. Third, in certain special cases, perhaps no general publication occurs unless the author also authorizes the recipient to copy the work, and the recipient actually exercises his authority both to copy and distribute (or offer to distribute) copies to the general public. These special cases may involve such matters as personal correspondence or other material cloaked with substantial privacy or other unique interests, or works of art the affixation of copyright notice to which prior to 1989 might have resulted in a defacement.

Applying this definition, to be sure, will not resolve all uncertainty. Some courts will be more willing than others to infer a duty on the part of the recipient *not* to effect a general publication by distributing or offering to distribute his copy or copies

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253. Mere acquiescence on the part of the copyright owner probably should not suffice, unless it rises to the level of laches; copyright owners generally are under no duty to enforce their rights. See, e.g., *Famous Music Corp. v. Bay State Harness Horse Racing & Breeding Ass'n, Inc.*, 423 F. Supp. 341, 344 (D. Mass. 1976) (holding that the plaintiffs' delay of five months before bringing an infringement suit did not rise to the level of causing financial hardship to support the defendants' allegation of laches), *aff'd*, 544 F.2d 1213 (1st Cir. 1977).

254. See *supra* notes 157, 171 and accompanying text.

to the general public. This proposed definition, however, at least should help to focus courts' attention on what really matters: whether the author herself, or the recipient of her work, has lawfully released or offered to release a copy or copies of the work for members of the general public to possess, distribute, perform, or display. Reasonable minds might differ, in cases such as *Academy* and *Brewer*, on the question of whether the recipients had the lawful power so to distribute. They may differ on whether, in cases such as *Hirshon* and *Brewer*, copies were offered to the general public. Furthermore, reasonable minds might differ on whether, in the case of personal correspondence, recipients were authorized to copy as well as distribute. And there may still be the odd case on the question of whether performance or display pre-1978 effected a general publication. To the extent legal doctrine still demands a definition of publication, however, that is as consistent as possible with the existing case law and that avoids bizarre outcomes, the above may be the best that can be hoped for. It still leaves open the questions, however, of pressing importance today: whether Internet transmissions involve "distributions" and thus can be subject to the above rules at all; and whether criteria other than publication, as defined above, might provide a better fit for purposes such as measuring copyright duration, in the case of works for hire, or imposing a duty to deposit. The next two Sections address these issues.

#### B. PUBLICATION BY INTERNET?

Part III.A argued that, as a textual matter, the question of whether an author who transmits her work over the Internet has effected a publication could be resolved either way, depending upon whether the temporary RAM copy that a user's computer necessarily makes whenever the user accesses a website that incorporates the work is considered a tangible copy. As a policy matter, the question *should* be resolved in light of the consequences that follow from defining something as a publication. Among the relevant consequences of equating transmission with publication are (1) that registration must follow within three months of transmission, in order for the author to qualify for an award of statutory damages and attorneys' fees in the event of an infringement preceding the registration; (2) that the author must deposit two copies of the work with the Library of Congress; (3) that the term of copyright commences from the date of uploading, if the work is a work for hire or an

anonymous or pseudonymous work, and persists for ninety-five years; and (4) that the fair use exception would be marginally more favorable to defendants.

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

Unfortunately, the policy considerations do not all point unambiguously in one direction. On the one hand, if statutory damages and fee awards are viewed as an important tool for ensuring the copyright owner an adequate return on her investment, then it might seem that equating transmissions with publication is desirable, insofar as this interpretation affords the author a three-month window of opportunity to effect the registration. Indeed, if the reason for affording the three-month grace period is the concern that published works are more vulnerable to copying than are unpublished works, that reason might seem equally applicable to works made available over the Internet.<sup>255</sup> In addition, neither of the rationales for according unpublished works greater protection against fair use and other copyright exceptions—deference to the author's privacy interests and to her economic interest in timing the date of publication—seems very strong when the author herself has made her work available for public access over the Internet.

On the other hand, several observations suggest caution in equating transmission with publication. First, requiring all website owners to deposit copies of their work with the Library of Congress appears both burdensome (particularly if the con-

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255. See *supra* text accompanying note 64.



tent of the website changes with some frequency),<sup>256</sup> and pointless, insofar as works made available to the public over the Internet are much more readily accessible as a practical matter than are hard copies residing in the Library of Congress. Second, equating the two concepts might require inquiry into where a work is first accessed to determine its country of first publication. This inquiry may be not only burdensome but also fortuitous, to the extent the work *could* be first accessed just about anywhere.<sup>257</sup> Alternatively, if the work is available for downloading everywhere, perhaps it should be viewed as simultaneously published everywhere, on the analogy of books that are deemed published upon their first appearance on retailers' shelves, regardless of whether any consumer buys or even notices them. This would mean, however, that the country of origin of a work first uploaded in the United States by a U.S. author would be the country or countries whose copyright term is the shortest.<sup>258</sup> While defensible in theory, this outcome might seem contrary to copyright owners' reasonable expectations.<sup>259</sup> Third, equating transmissions with publication would reduce the copyright term for certain works from 120 to 95 years, and would render the fair use defense marginally more tenable. Both of these results might increase social welfare, but could have some marginal negative impact on the welfare of individual authors.<sup>260</sup>

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256. See ONLINE CIRCULAR, *supra* note 211, at 2 (stating that, "[g]enerally, copyrightable revisions to online works that are published on separate days *must each be registered individually*, with a separate application and filing fee," unless the work qualifies as an automated database or a serial or newsletter). Online works can be registered as literary works, pictorial works, and so on, *see id.*, but there is no separate classification for online works, and I am not aware of any statistics on the number of websites or other online works that have been registered. According to one estimate, there are over 165,000,000 websites in existence. Netcraft, April 2008 Web Server Survey, [http://news.netcraft.com/archives/web\\_server\\_survey.html](http://news.netcraft.com/archives/web_server_survey.html) (last visited Apr. 27, 2008).

257. As noted above, whether such an equation would contravene the Berne Convention presents an interesting question as well. See *supra* note 117 and accompanying text.

258. See *supra* note 122 and accompanying text.

259. Even if Internet transmissions by themselves do not constitute publications, the user's authorized downloading of material from a website may. See *supra* notes 196–211 and accompanying text. If so, then the work may be deemed simultaneously published in all countries in which authorized downloading is possible, and the country of origin may indeed be the country with the shortest term. See *supra* Part II.B.5.

260. In the vast majority of cases, however, the final twenty-five years of copyright protection will probably have little if any value, and the fact that a

On balance, despite some common-sense appeal to the notion that works transmitted over the Internet are necessarily published, and despite a plausible textual basis for reaching this result, it is hardly obvious that this result would be desirable. In addition, the fact that copyright owners *can* register unpublished works—or effect the conventional publications of such works, register their copyrights thereafter, and still take advantage of the three-month grace period—takes some of the sting out of the grace period's applicability to published works only; and perhaps there is something to be said for enabling copyright owners themselves to determine where and when their works are published, given all the consequences that flow from publication, rather than applying an unavoidable rule that every transmission necessarily effects a publication somewhere (or perhaps everywhere). Perhaps the more fundamental insight, though, is not that the current definition of publication is too ambiguous or too narrow, but rather that too many disparate consequences now follow from the fact and place of publication. The following Section argues that a more rational copyright policy might condition some of these consequences upon slightly different criteria. If it were to do so, then perhaps Internet transmissions could be deemed publications for some purposes and not others.

### C. PUBLICATION FOR SOME PURPOSES AND NOT OTHERS?

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

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work is published is often not a determinative factor in the fair use calculus.

native. But a broader or narrower definition of publication may be appropriate, depending on the purpose being served.

An initial question to consider, nevertheless, is whether a criterion other than publication, however defined, would be a preferable trigger for some or all of the consequences that now follow from publication. For example, consider those cases where publication now serves as the event from which other events, such as copyright duration, are now measured.<sup>261</sup> An initial problem, as we have seen, is that determining exactly when publication occurs is not always an easy matter. But whether other criteria would enjoy any advantage over publication, say for purposes of reducing administrative costs, is hardly clear. One possible alternative would be to use the date of creation of the work instead,<sup>262</sup> but this date is not necessarily any more precise than the date of publication. Creation may occur over many days (or months or years), and each individual draft of a work may count a separate work.<sup>263</sup> Creation also may span many different geographic locations, which gives rise to further complications to the extent place of creation merely replaces place of publication as a criterion for protectability or other benefits. A creation criterion also might involve nice questions of when the author first conceived or performed a work that was initially unfixed.<sup>264</sup> If so, then perhaps fixation would be a preferable criterion, but application of a fixation criterion would give rise to questions—perhaps no easier to answer—of when and where different versions of a work were fixed. Moreover, unless a more robust durability requirement

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261. See *supra* notes 34–48 and accompanying text.

262. Under current law, the date of creation *is* used for some purposes. The term of copyright, for example, now commences at creation. See 17 U.S.C. § 302(a) (2000). The termination date for works for hire and for anonymous and pseudonymous works is 95 years from the date of publication or 120 from the date of creation, whichever expires first. *Id.* § 302(c) (2000).

263. See 17 U.S.C. § 101 (2000 & Supp. V 2007) (defining derivative work).

264. Patent law sometimes takes into consideration the date on which an inventor conceived of an invention. See *In re Jolley*, 308 F.3d 1317, 1325 (Fed. Cir. 2002) (“[E]vidence of conception must ultimately address whether the inventor formed ‘the definite and permanent idea of the complete and operative invention’ in his or her mind.” (quoting *Bosies v. Benedict*, 27 F.3d 539, 543 (Fed. Cir. 1994))). Applying this criterion in the context of patent law is difficult enough. Applying it in the context of, say, a novel or a symphony would require a court to consider how fully formed the work must be in the mind of the creator before it is conceived. Determining when an initially unfixed work was first performed would involve similar difficulties.

were incorporated into the definition of fixation,<sup>265</sup> the mere fact that a work was *once* fixed does not necessarily lead to greater certainty of application. There is no guarantee that the fixed version of a work will be in existence at some later time.<sup>266</sup>

Alternatively, one might seek to reduce administrative costs by retaining the publication criterion but redefining it to mean that at least one tangible copy of the work was publicly accessible. United States patent law has long defined the term “printed publication” along precisely these lines.<sup>267</sup> Courts have held, for example, that a printed publication need only be something tangible, not literally a “printed” document.<sup>268</sup> Furthermore, a printed publication need not comprise anything more

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

266. See Lichtman, *supra* note 143, at 732–34.

267. Under U.S. law, an inventor is entitled to a patent only if, *inter alia*, the invention claimed was not “described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent,” 35 U.S.C. § 102(a) (2000); was not “described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States,” *id.* § 102(b); and was nonobvious in light of any such printed publication or publications, as of the date of invention and more than one year prior to the date of application for a U.S. patent, *see id.* § 103(a) (“A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”). See also *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1305 (Fed. Cir. 2006), *aff’d in part, rev’d in part on other grounds*, 498 F.3d 1307 (Fed. Cir. 2007); *In re Foster*, 343 F.2d 980, 987–88 (C.C.P.A. 1965) (holding that an invention must be nonobvious, in light of § 102(b) prior art, more than one year prior to filing of a U.S. patent application).

268. See *In re Klopfenstein*, 380 F.3d 1345, 1348 n.2, 1349 n.4 (Fed. Cir. 2004) (stating that “the question to be resolved in a ‘printed publication’ inquiry is the extent of the reference’s accessibility to at least the pertinent part of the public, of a perceptible description of the invention, in whatever form it may have been recorded”; but that “an entirely oral presentation at a scientific conference that includes neither slides nor copies of the presentation is without question not a ‘printed publication,’” and that “a presentation that includes a transient display of slides is likewise not necessarily a ‘printed publication’” (citation omitted) (internal quotation marks omitted)); U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 2128 (8th rev. ed. 2007) (“An electronic publication, including an on-line database or Internet publication, is considered to be a ‘printed publication’ within the meaning of 35 U.S.C. 102(a) and (b) . . .”).

than a single copy accessible to the relevant audience.<sup>269</sup> On this reasoning, even a single copy of a Ph.D. thesis that is publicly accessible in a foreign university library can constitute a printed publication;<sup>270</sup> so too can a written disclosure made in the course of a foreign patent prosecution.<sup>271</sup> Among the relevant factors in determining whether a reference is sufficiently accessible to qualify as a printed publication are whether copies were distributed to the public and whether the publication was catalogued or indexed.<sup>272</sup> In the case of a temporarily displayed reference that was neither distributed nor indexed, relevant factors may include “the length of time the display was exhibited, the expertise of the target audience, the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied, and the simplicity or ease with which the material displayed could have been copied.”<sup>273</sup> As in copyright law, however, disclosures made only to persons who are under an obligation of secrecy are not considered publicly accessible in patent law.<sup>274</sup> And although the case law sheds lit-

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

270. *In re Hall*, 781 F.2d 897, 898–900 (Fed. Cir. 1986); cf. *In re Cronyn*, 890 F.2d at 1159–61 (holding that theses made available to defense committees consisting of four faculty members, and not meaningfully catalogued or indexed, were not sufficiently publicly accessible to count as “printed publications”).

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

272. See *In re Klopfenstein*, 380 F.3d at 1350.

273. *Id.*; see also *id.* at 1348.

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

tle light on the rationale for such an expansive definition, commentators have argued that a broad definition of printed publication rightly accords inventors an incentive to seek out accessible prior art, reducing the administrative and other costs of patent protection; a patent that issues on an invention that has already been disclosed in some accessible format increases social costs with few, if any, corresponding benefits.<sup>275</sup>

Adopting a similar "public accessibility" definition rule in copyright law would give rise to both benefits and costs. To be sure, the application of an accessibility criterion would hardly eliminate unpredictability and uncertainty, as even the accessibility criterion would depend, as in the patent context, upon consideration of several underlying factors. On the other hand, the sheer breadth of the criterion probably would resolve many otherwise close cases in favor of publication having occurred. Future cases similar to *Academy*, *Hirshon*, and *Brewer*, in which an author makes tens or even hundreds of copies available without express limitation, would almost certainly be held to involve publications. Application of an accessibility criterion, however, also might mean that most Internet transmissions would constitute publications;<sup>276</sup> so too for personal correspondence that recipients donate to university libraries. Both of these results would be problematic. As I suggested above, a rule equating Internet transmissions with publications may make sense for certain purposes, such as applying the statutory damages grace period and measuring the copyright term. But it would also mean that works made available on the Internet are either published in the first country in which they are downloaded, or else everywhere simultaneously, neither of which results would seem to accord with copyright owners' reasonable expectations. The criterion also would impose upon website owners a duty to deposit two copies of their websites with the Library of Congress, a requirement that seems both burdensome and unnecessary. In addition, a rule equating deposit of correspondence with publication would be contrary to the case law which, thus far, has uniformly characterized such documents as unpublished.

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275. See ROBERT PATRICK MERGES & JOHN FITZGERALD DUFFY, *PATENT LAW AND POLICY: CASES AND MATERIALS* 417–19 (4th ed. 2007).

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

The main problem, however, with applying a public-accessibility criterion across the board may be that copyright law employs the concept of publication for too many disparate purposes. The preceding discussion suggests that, while a public-accessibility criterion might make sense in certain contexts—such as for triggering the statutory damages grace period and the running of other time periods, and for enabling the wider applicability of fair use for works that authors make available over the Internet—it would serve less well for purposes such as imposing the duty to deposit, determining the country of origin of a work, or applying the fair use doctrine with respect to personal correspondence on deposit in university libraries. But Judge Frank's opinion in *American Visuals Corp. v. Holland* may suggest a way out of this dilemma.<sup>277</sup> In *Holland*, which involved the distinction between investive and divestive publications, Judge Frank observed that the word "publication" can mean different things for different purposes.<sup>278</sup> Perhaps the time has come to apply this observation in a new context. Following from the preceding analysis, a broad definition of publication, which includes Internet transmissions, may be desirable for purposes of triggering the various time periods that now run from the date of first publication. It also makes sense to define Internet transmissions as publications for purposes of the fair use and other exceptions that depend in part upon the work at issue being published.<sup>279</sup> For purposes of imposing the duty to deposit, on the other hand, it may make sense to apply a narrower definition. Similarly, for purposes of determining country of origin, the narrower criterion may make sense, so that a work first made available in one country by a citizen or resident of that country is not deemed to be first published in some entirely unrelated place. As noted above, the narrower criterion may also be more consistent with the Berne

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277. 239 F.2d 740 (2d Cir. 1956).

278. *Id.* at 742–43.

279. Some courts actually appear to be moving in this direction. See *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 820 (9th Cir. 2003) (stating that "[p]ublished works are more likely to qualify as fair use because the first appearance of the artist's expression has already occurred," and that "Kelly's images appeared on the internet before Arriba used them in its search engine," such that the second fair use factor, nature of the copyrighted work, weighed "only slightly in favor of Kelly"); *Video-Cinema Films, Inc. v. Cable News Network, Inc.*, Nos. 98 Civ. 7128(BSJ), 98 Civ. 7129(BSJ), 98 Civ. 7130(BSJ), 2001 WL 1518264, at \*7 n.17 (S.D.N.Y. Nov. 28, 2001) (holding that, for the purposes of fair use analysis, either a general or a limited publication weighs in favor of the use being a fair use).

Convention's definition of publication,<sup>280</sup> and thus applying that criterion in the context of country-of-origin determinations is less likely to give rise to conflicting international judgments.

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

Whether such a change could be effected by the courts alone, without legislative amendment, is a matter I leave to another day. A legislative overhaul may be preferable in theory, to the extent it would enable consideration of yet more nuances. Reasonable minds may differ, for example, on the question of whether all of the statutory time periods that are now conditioned upon publication should be triggered by the first Internet transmission, or whether some should remain conditioned upon the first conventional publication. Absent a legislative resolution, however, courts themselves may have no choice but to consider the sort of framework sketched out above. As more cases similar to *Getaped* make their way

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280. See *supra* notes 116–18 and accompanying text.



through the system, courts may have to decide whether Internet transmissions constitute publications for all purposes, including country of origin. The option of allowing the word to mean different things in different contexts may provide enough space to reach desirable outcomes without having to simply wish away undesirable collateral consequences.

### CONCLUSION

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