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HAPPY BIRTHDAY STATUTE OF ANNE: THE DANCE BETWEEN THE COURTS AND CONGRESS¹

Hon. M. Margaret McKeown[†]

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It is an honor to give the David Nelson Memorial Lecture.² I thank Elizabeth Nelson and the family for the opportunity to address this remarkable gathering of copyright scholars, thinkers, and practitioners. It is also heartening to see so many students who represent the next generation of copyright experts.

I was thrilled to find out that we are having a birthday cake at the end of this session because that validates the title of my talk, “Happy Birthday to the Statute of Anne.” Although I have been involved in copyright for more than thirty-five years—just a fraction of copyright’s 300 years of history—the last few decades represent an acceleration and sea change in the copyright world.

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† Judge McKeown sits on the United States Court of Appeals for the Ninth Circuit. She thanks Jake Linford (University of Chicago Law School, J.D. 2008, law clerk to Judge McKeown 2009–2010, Assistant Professor at the Florida State University College of Law) for his research assistance, and Derek Ettinger (Columbia Law School, J.D. 2008, law clerk to Judge McKeown 2009–2010) and Juliana Herman (Yale Law School, J.D. 2012, judicial extern to Judge McKeown 2010) for their editing assistance.

1. This article is adapted from the David Nelson Memorial Lecture given on April 9, 2010, at the Copyright @ 300 Conference sponsored by the Berkeley Center for Law and Technology. In a nod to law journal style, humor, cartoons, and anecdotes from the speech have been deleted.

2. David Nelson started his practice in Silicon Valley in the 1960s with the firm that became Morrison & Foerster LLP. He was renowned not only for his knowledge of and interest in high tech law, but also for his remarkable memory for popular culture trivia. J.L. Pimsleur, *David E. Nelson*, SFGATE.COM, Feb. 4, 1999, http://articles.sfgate.com/1999-02-04/news/17678718_1_morrison-foerster-mr-nelson-douglas-s-nelson (last visited June 29, 2010).

When I started college, I had a job analyzing snowflakes on a mainframe computer that used IBM punch cards. When I started practicing law, it was the cusp of the digital revolution, and by the time I became a judge, the Internet had been in common currency for only a few years. Google had just been incorporated and “mashup” at that time just meant potatoes.

Viewing technological innovation and copyright law from a judicial perspective, the relationship between Congress and the courts resembles a dance where it is unclear which partner is taking the lead. Taking a cue from Justice Holmes, who once said “a page of history is worth a volume of logic,”³ I first address the history of this dance between the courts and Congress, and then offer some thoughts on what I see as the next frontiers from my knothole as a judge.

The cases that choreograph the dance fall into two groups: the first where courts take the lead and Congress follows, and the other where Congress takes the lead and the courts follow. In the development of the Statute of Anne—the mother ship of copyright law—we see both dance steps.

The Statute of Anne,⁴ enacted in 1710,⁵ is considered by many to be the first English copyright statute, a view that is not entirely accurate.⁶ It is, however, “the foundation upon which the concept of modern copyright was built.”⁷ The statute gave the general public, rather than the Stationers’ Guild of the day, the ability to secure a copyright right for a limited term of fourteen years, while the author obtained a renewal term of fourteen additional years.⁸ Even at this early stage of copyright protection, technology was the moving force. The Statute of Anne would have been unnecessary but for the innovation of the moveable type press, which made the mass production of books possible.

Lord Mansfield provided an early judicial analysis of the statute in *Millar v. Taylor*, where he held that common law copyright protection outlasted the

3. *New York Trust Co. v. Eisner*, 256 U.S. 345, 349 (1921). Justice Ginsburg referenced this phrase in analyzing the history of Congressional extensions of copyright duration in *Eldred v. Ashcroft*, 537 U.S. 186, 200 (2003).

4. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19 (1710) (Gr. Brit.).

5. Lionel Bentley & Jane C. Ginsburg, “*The Sole Right . . . Shall Return to the Authors*”: *Anglo-American Authors’ Reversion Rights from the Statute of Anne to Contemporary U.S. Copyright*, 25 BERKELEY TECH. L.J. 1475 (2010).

6. LYMAN R. PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 12 (1968).

7. *Id.*

8. 8 Ann., c. 19. For works already in print, authors or owners could secure protection for a single twenty-one-year term.

limited duration of the Statute of Anne.⁹ Five years later, the House of Lords essentially reversed Lord Mansfield's ruling in *Donaldson v. Beckett* and concluded that common law copyright protection did not last beyond the Statute of Anne's fourteen-year grant.¹⁰ This decision was the first time that a lawmaking body overruled a judicial interpretation of a copyright statute in the modern world. So began the dance between the courts and the legislature in the copyright arena.

I. WHEN COURTS LEAD AND CONGRESS FOLLOWS

History provides several examples where courts in the United States determine the scope of copyright protection for a new technology, and Congress decides how (and whether) to respond. When I think about courts or judges taking the lead in interpreting copyright statutes, I think of Justice Holmes, who repeatedly interpreted statutory protections broadly enough to reach new uses of copyrighted works in new media. Justice Holmes' general philosophy with regard to copyright law is best captured in the case of *Herbert v. Shanley*, in which he concluded, "there is no need to construe the [copyright] statute so narrowly."¹¹ In *Herbert*, Justice Holmes stepped into a dispute between hotels that played music to dining patrons and the newly minted American Society of Composers, Authors and Publishers ("ASCAP"). ASCAP sought licensing fees for the performance of live music. The copyright act of the day granted the author the exclusive right "to perform the copyrighted [musical] work publicly for profit."¹² The defendants, a hotel and a restaurant, argued that because they did not charge for the music, the performance was not "for profit" and therefore did not violate the statute. Ruling in ASCAP's favor, Justice Holmes seized on a now common refrain: "If music did not pay it would be given up."¹³ That same theme frames the debate we are having a century later.

Justice Holmes' copyright legacy began in 1903 with his first copyright opinion, *Bleistein v. Donaldson Lithographing Co.*¹⁴ There, Justice Holmes wrote

9. *Millar v. Taylor*, (1769) 98 Eng. Rep. 201 (K.B.) 232, 252.

10. *Donaldson v. Beckett*, (1774) 1 Eng. Rep. 837 (H.L.). While it is disputed whether the Law Lords narrowly recommended sustaining or rejecting a perpetual common law copyright, the House of Lords voted twenty-two to eleven to reject perpetual copyright protection. See PAUL GOLDSTEIN, *COPYRIGHT'S HIGHWAY: FROM GUTENBERG TO THE CELESTIAL JUKEBOX* 50 (1994).

11. *Herbert v. Shanley Co.*, 242 U.S. 591, 594 (1917).

12. 17 U.S.C. § 1(e) (1909) (current version at 17 U.S.C. § 106 (2006)).

13. *Herbert*, 242 U.S. at 595. Holmes continued, "If it pays it pays out of the public's pocket. Whether it pays or not the purpose of employing it is profit and that is enough." *Id.*

14. 188 U.S. 239 (1903).

for the Court as it expanded the reach of copyright protection from a statutory provision covering only those engravings, cuts, prints, or chromolithographs (a method for making multicolor prints) that are “pictorial illustrations or works connected with the fine arts”¹⁵ to reach more than mere illustrations in the text of a book.¹⁶ He interpreted the phrase “connected with the fine arts” as sufficiently broad to include works with a “pictorial quality [that] attracts the crowd and therefore gives them a real use—if use means to increase trade and to help to make money. A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement.”¹⁷ It is no surprise that the iconic phrase “a picture is worth a thousand words” also emerged as a popular American phrase in the early twentieth century.¹⁸

Equally interesting is Justice Holmes’ concern that in trying to determine which works were “connected with the fine arts,” judges were ill-suited “to constitute themselves final judges of the worth of pictorial illustrations.” Justice Holmes suggested that at “one extreme some works of genius would be sure to miss appreciation” while “[a]t the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.”¹⁹ This discomfort about the limits of judicial competence is echoed often by courts in copyright cases. Judges must make a decision on cases put before them and yet there is some disquiet about making technological as well as artistic assessments in the judicial forum.

Justice Holmes also extended existing copyright law beyond its express reach to cover motion pictures in a 1911 case, *Kalem Co. v. Harper Brothers*.²⁰ The defendants first created a screenplay from the novel *Ben Hur* without authorization, and then filmed the action. The silent film was purchased by various theaters and shown to the public. The copyright statute of the day gave authors the exclusive right to dramatize their works,²¹ but Congress had not yet expressly extended copyright protection to motion pictures. The plaintiffs argued that the film violated the authors’ dramatization rights, but the defendants countered that dramatization rights extended only to a performance where the actors were present, and that a motion picture was

15. *Id.* at 250.

16. *Id.* at 251.

17. *Id.*

18. This phrase is commonly attributed to Fred Barnard, an advertising manager who used variations on the theme on streetcars in the 1920s. FRANK LUNTZ, WORDS THAT WORK: IT’S NOT WHAT YOU SAY, IT’S WHAT PEOPLE HEAR 7–8 (2007).

19. *Id.* at 251–52.

20. 222 U.S. 55 (1911).

21. 17 U.S.C. § 1(d) (1909) (current version at 17 U.S.C. § 106 (2006)).

more like an exhibition, in pictures, of some of the ideas in the novel, which would fall outside the dramatization right.²²

Likening a motion picture to the special effect occasionally used in the theater of projecting the mirror image of the actor on stage as a ghostly special effect, Justice Holmes stepped in to bridge the gap between statutory coverage and technological innovation. He noted that in both cases, there was a real actor at the heart of the dramatization, and whether the actor was simply offstage or his performance was committed to film, the infringement of the dramatization right was the same.²³

The film version of *Ben Hur* became a blockbuster both as a box office hit and a prize on the copyright scoreboard. Justice Holmes might have been surprised to learn that in our day, books are cheap but movie rights are expensive. Derivative works and licensing have become an important battlefield in the copyright world.

Justice Holmes' generous interpretation of copyright provisions to protect the ability of copyright holders to exploit new technological formats did not always win the day. Stepping back in time to 1908, the Supreme Court, in *White-Smith Music Publishing Co. v. Apollo Co.*, elected not to extend copyright protection to perforated piano rolls for use with player pianos.²⁴ The Court held that the copyright statute barred the unauthorized copying of a musical composition "in intelligible notation," and that it would be "strained and artificial" to consider musical sounds coming from an instrument to be a copy.²⁵ If the perforated piano roll was "not intended to be read as an ordinary piece of sheet music, which to those skilled in the art conveys, by reading, in playing or singing, definite impressions of the melody," then it was not a copy as defined by the statute.²⁶ Because a piano roll was not like sheet music, copyright protection did not apply. This is a classic case of the Court considering a new technology and reasoning through analogy that it does not fall within the reach of the existing statute.

The *Apollo* case is also interesting because the Court essentially sent a missive to Congress, inviting Congress to correct course legislatively. The Court made note of three key facts: First, Congress knew of player pianos, and several lower court opinions which held that creating player piano rolls did not constitute copyright infringement, but had not corrected that "error" despite having multiple opportunities to amend the current copyright

22. *Kalem*, 222 U.S. at 55–57.

23. *Id.* at 61–63.

24. 209 U.S. 1 (1908).

25. *Id.* at 17.

26. *Id.* at 18.

statute.²⁷ Second, the Berne Convention explicitly declined protection against the manufacture and sale of instruments that mechanically reproduced music, and while the United States was not a party, Congress must have understood that U.S. artists abroad would have no protection against such mechanical reproduction. Thus, “[i]t could not have been the intention of Congress to give to foreign citizens and composers advantages in our country which according to [the Berne C]onvention were to be denied to our citizens abroad.”²⁸

Finally, the Court noted that the sale and use of player pianos had become widespread, with roughly 1.5 million rolls sold in 1902 to play on about 75,000 player pianos.²⁹ Copyright scholar Paul Goldstein speculates that the Court was reluctant to step in because it recognized that “a finely tuned law was needed, not the blunt instrument of a judicial injunction that would disrupt the expectations of thousands of people who owned [player pianos].”³⁰

Justice Holmes concurred with the result in *Apollo*, although he made clear as a policy matter that he thought copyright protection should extend to anything that can “mechanically reproduce[] that collocation of sounds” that makes a musical composition, whether or not that reproduction requires “continuous human intervention.”³¹ Justice Holmes naturally agreed with the Court’s recommendation that Congress should step in if the Court construed the statute too narrowly.³² Congress intervened almost immediately. Just one year after *Apollo*, Congress enacted the Copyright Act of 1909, pulling both musical compositions played on player pianos and phonograph players within the scope of authors’ rights.³³

Due to a surprising dearth of technology-driven Supreme Court copyright opinions in the mid-twentieth century,³⁴ we fast forward roughly

27. *Id.* at 12–14.

28. *Id.* at 14–15.

29. *Id.* at 9.

30. GOLDSTEIN, *supra* note 10, at 66.

31. *Apollo*, 209 U.S. at 20 (Holmes, J., concurring).

32. *Id.*

33. 17 U.S.C. § 1(e) (1909) (current version 17 U.S.C. § 106 (2006)). Congress also established a two cent mechanical reproduction license, once the copyright holder used, permitted, or knowingly acquiesced in the use of the copyrighted work on instruments capable of mechanically reproducing the work. *Id.* The license ostensibly mitigated a potential corner on the market by Aeolian, the leading company in the player piano market, by allowing competitors to enter the market if they were willing to pay the mechanical license. GOLDSTEIN, *supra* note 10, at 67.

34. There are a few exceptions. In *Buck v. Jewell-La Salle Realty Co.*, 283 U.S. 191, 200–01 (1931), the Court held that rebroadcast of musical compositions received from a radio

fifty years from the Holmes era to a pair of landmark cases where the Court undertook to “read the statutory language of 60 years ago in the light of drastic technological change.”³⁵ Two cases, *Fortnightly Corp. v. United Artists Television, Inc.*,³⁶ and *Teleprompter Corp. v. CBS*,³⁷ dealt with the retransmission of television broadcasts without permission under the 1909 Act. That Act granted copyright holders an exclusive right to perform works, a right exercised by licensed broadcasters.³⁸

In *Fortnightly*, Fortnightly ran a community antenna television system in West Virginia, running cables from broadcasting stations to subscribers who otherwise had difficulty receiving the broadcast signals.³⁹ The Court concluded that viewers in their homes did not “perform” the works broadcast into their homes and thus did not infringe the authors’ performance right.⁴⁰ In holding that Fortnightly’s cable television service (“CATV”) did not infringe the performance right either, the Court characterized Fortnightly more like a viewer than a broadcaster because it did nothing more than enhance viewers’ ability to receive a broadcaster’s programs. “CATV equipment is powerful and sophisticated, but the basic function the equipment serves is little different from that served by the equipment generally furnished by a television viewer.”⁴¹ The only difference between CATV and the viewer running the cable to the broadcast tower herself was that here, “the antenna system is erected and owned not by its users but by an entrepreneur.”⁴² Thus, just as in the *Apollo* case, the Court reasoned by analogy and distinguished the new technology from those covered by the statute. The Solicitor General invited the Court to make a

broadcast throughout the hotel by means of public speaker system was a “performance” under 17 U.S.C. § 1(e), in part because “complicated electrical instrumentalities [were] necessary for its . . . reception and distribution.” The Court held in *Manners v. Morosco*, 252 U.S. 317, 325–26 (1920), that a contract that explicitly conveyed only the right to represent the play as a spoken drama did not convey the right to represent the play in moving pictures. The Court sidestepped another technology-driven question when an equally divided Court affirmed in a one-line opinion the decision of the Court of Claims dismissing the publisher’s copyright infringement claim on the ground that photocopies made in government libraries for the exclusive professional use of researchers were fair use, and not copyright infringement. *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (Ct. Cl. 1973), *aff’d by an equally divided court*, 420 U.S. 376 (1975) (per curiam).

35. *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390, 396 (1968).

36. *Id.*

37. 415 U.S. 394 (1974).

38. 17 U.S.C. § 1(d) (1909) (current version at 17 U.S.C. § 106 (2006)).

39. *Fortnightly*, 392 U.S. at 391–92.

40. *Id.* at 398–400.

41. *Id.* at 399–400.

42. *Id.* at 400.

compromise ruling, such as implementing a compulsory license Congress enacted for music performances, but the Court demurred, stating that such a maneuver was for Congress, and that it would instead “take the Copyright Act of 1909 as we find it.”⁴³

Justice Fortas dissented in a hand-wringing lament about the Court’s limited capacity to decide disputes involving technology. According to Justice Fortas, applying the 1909 Act to the recent development of cable television was a role for which the Court was not suited, as it “call[ed] not for the judgment of Solomon but for the dexterity of Houdini.”⁴⁴

The Court returned to the topic in *Teleprompter*,⁴⁵ holding that the distance traversed by CATV providers in bringing signals to consumers was immaterial, and even over long distances, the signals, already released to the public, were merely carried by the CATV systems to consumers who might not normally have received them.⁴⁶ Once again, the Court invited Congress to provide detailed regulation.

Congress responded, like in the aftermath of *Apollo*, with another compulsory license, apparently concluding that cable operators should be required to pay royalties to the owners of copyrighted programs retransmitted by their systems, but that the transaction costs for direct negotiations would be too high. Section 111 of the 1976 Act thus permits cable systems to retransmit distant broadcast signals without securing permission from the copyright owner and, in turn, requires each system to pay royalty fees to a central royalty fund based on a percentage of its gross revenues.⁴⁷

This judicial-legislative interplay typifies cases where Congress jumps in to correct the courts’ interpretation of the copyright law.⁴⁸ These cases also

43. *Id.* at 401–02.

44. *Id.* at 402–03 (Fortas, J., dissenting). Justice Fortas was also concerned that the *Fortnightly* holding conflicted with *Buck v. Jewell-LaSalle Realty Co.*, 283 U.S. 191 (1931). *Id.* at 404–05.

45. 415 U.S. 394 (1974).

46. *Id.* at 412–13.

47. 17 U.S.C. § 111 (2006). Section 111 also resolves the *Buck* question, *see Buck*, 283 U.S. at 191, explicitly excepting secondary transmission by “the management of a hotel . . . of signals transmitted by a broadcast station licensed by the [FCC], within the local service area of such station, to the private lodgings of guests or residents of [the hotel].” § 111(a)(1).

48. Congress has also stepped in to correct perceived missteps by the courts in copyright disputes that are not driven by new technologies. Justice Grier held, as a circuit judge, that the copyright statute of his day did not give an author the exclusive right to control translations of a copyrighted work. *Stowe v. Thomas*, 23 F. Cas. 201, 206 (C.C.E.D. Pa. 1853) (No. 13,514). Congress later decided to correct this step and revised the copyright

highlight an additional form of congressional-judicial dialogue—the Supreme Court invited action by Congress. Congress does not always step in right away, perhaps in part because courts often become the incubator for legal disputes ahead of the policy debate, allowing Congress to observe how things develop, then step in once the lay of the land begins to take shape.

It is a truism that “[i]t is emphatically the province and duty of the judicial department to say what the law is,”⁴⁹ but that refrain fails to elucidate how to construe the Copyright Act in a manner consistent with its underlying constitutional principles. *Apollo*, *Fortnightly*, and *Teleprompter* can all be read as cases where the Court read the Copyright Act narrowly and resisted the urge to expand its reach. The notion that courts should take a hands-off approach is not universal, particularly when it comes to the question of whether old statutory provisions should reach new technological innovations.

Shortly after the passage of the Copyright Act of 1976, the Seventh Circuit considered, in *WGN Continental Broadcasting Co. v. United Video, Inc.*, whether the copyright in a news program—an audio-visual work under the statute—also covered “teletext” that accompanied the news program.⁵⁰ The court analyzed the breadth of the term “audiovisual work” in § 101, as well as the legislative history, to conclude that teletext was part of the audiovisual work, and that a licensee cable company could not replace the broadcaster’s teletext with information of the cable company’s choosing. In reaching that conclusion, the Seventh Circuit observed that “Congress probably wanted the courts to interpret the definitional provisions of the [Copyright Act of 1976] flexibly, so that it would cover new technologies as they appeared, rather than to interpret those provisions narrowly and so force Congress periodically to update the act.”⁵¹ The Seventh Circuit followed that logic in a later case as well, *Midway Mfg. Co. v. Arctic International, Inc.*⁵² Arctic sold “speed-up” kits to modify arcade games like those owned by Midway so the elements moved faster, making the game more challenging. In holding that Arctic infringed Midway’s copyrights, the court “stretched” the language of § 101 of the Copyright Act to “accommodate speeded-up video games”

statute in 1891, granting to “authors or their assigns . . . exclusive right to dramatize and translate any of their works for which copyright shall have been obtained under the laws of the United States.” 26 Stat. 1107 (1891) (codified at R.S. § 4952).

49. *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 177 (1803).

50. 693 F.2d 622 (7th Cir. 1982). Teletext is “the use of the vertical blanking interval [in an analog television picture] to carry material intended for the television viewer” and can include subtitles or other textual information. *Id.* at 623–24

51. *Id.* at 627.

52. 704 F.2d 1009 (7th Cir. 1983).

within the definition of “derivative work.”⁵³ Several papers presented at this conference shared evidence indicating that statutory expansion of this nature happens frequently in the courts, but one might also ask, is this how the Copyright Act *should* be interpreted?

The “Betamax” case, *Sony Corp. of America v. Universal City Studios, Inc.*,⁵⁴ is perhaps the most prominent recent example of the Court choosing a more restrained approach to reading the Copyright Act in light of technological change.

In *Sony*, the Court rested its finding of no infringement on the notion that the Betamax video tape recorder was capable substantial noninfringing uses.⁵⁵ The Court said to rule otherwise would “block the wheels of commerce,”⁵⁶ and thus declined to enjoin Sony’s marketing of the Betamax. Congress did not step in and modify the result, instead letting the case law and technology play out and develop. The Supreme Court also often acts in this manner, letting cases develop and incubate in the lower federal courts to see what disputes percolate up.⁵⁷ We can see the percolation concept in practice by comparing the Ninth Circuit’s decision in *A&M Records, Inc. v. Napster, Inc.*⁵⁸ with the Supreme Court’s eventual take on the question of peer-to-peer file sharing services in *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*⁵⁹ Both cases provide nice examples of courts grappling with copyright

53. *Id.* at 1014 (citing 17 U.S.C. § 101 (1976)).

54. 464 U.S. 417 (1984).

55. *Id.* at 442. The substantial noninfringing uses test comes from the Patent Act, which expressly provides that the sale of a “staple article or commodity of commerce suitable for substantial noninfringing use” does not expose the seller to liability for contributory infringement. *Id.* at 440 (citing 35 U.S.C. § 271(c)). The Court concluded that it could import the substantial noninfringing use test due to the similarities between patent and copyright law, because “in both areas the contributory infringement doctrine is grounded on the recognition that adequate protection of a monopoly may require the courts to look beyond actual duplication of a device or publication to the products or activities that make such duplication possible.” *Id.* at 442.

56. *Id.* at 441–42, (quoting *Henry v. A. B. Dick Co.*, 224 U.S. 1, 48 (1912), *overruled on other grounds by* *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 517 (1917)).

57. Peter L. Strauss, *One Hundred Fifty Cases Per Year: Some Implications of the Supreme Court’s Limited Resources for Judicial Review of Agency Action*, 87 COLUM. L. REV. 1093, 1107 (1987) (“The Supreme [Court] . . . [recognizes] that an important conflict between two or more lower courts is a virtual necessity for (but no guaranty of) securing review.”); Ernest A. Young & Erin C. Blondel, *Does the Supreme Court Follow the Economic Returns? A Response to a Macrotheory of the Court*, 58 DUKE L.J. 1759, 1779 n.84 (2009) (noting that “the Court’s discretionary certiorari policy . . . encourages the Court not to take the *first* case from a court of appeals raising a given issue, but rather to wait until a circuit split develops”).

58. 239 F.3d 1004 (9th Cir. 2001).

59. 545 U.S. 913 (2005).

and new technology.⁶⁰ In *Napster*, the Ninth Circuit affirmed the district court's grant of preliminary injunction, concluding that the district court did not err in finding that the plaintiffs were likely to prevail in establishing that Napster was liable for contributory⁶¹ and vicarious copyright infringement.⁶² No petition for certiorari followed the Ninth Circuit's decision in *Napster*.⁶³ Without direct Supreme Court review, *Napster* functioned as the law of the land and had a dramatic effect on filesharing. By focusing on the centralized nature of the central indexing system, *Napster* arguably "offered a roadmap for software designers seeking to limit their potential liability as secondary infringers."⁶⁴ KaZaa, Grokster, and other peer-to-peer software providers shifted to a decentralized indexing system⁶⁵ unlike the centralized Napster system.⁶⁶ The Ninth Circuit applied the *Napster* principles to what it thought was distinguishable services provided by the *Grokster* defendants, because, "as

60. Napster provided users with MusicShare software that allowed them to use the Napster system to make MP3 files stored on the user's computer available for copying by other Napster users, search for MP3 files stored on other users' computers, and transfer exact copies of other users' MP3 files from computer to computer via the Internet. *Napster*, 239 F.3d at 1011. Napster used a centralized indexing system, and users seeking a file would submit a search request to the Napster server. *MGM Studios, Inc. v. Grokster Ltd.*, 380 F.3d 1154, 1159 (9th Cir. 2003), *rev'd*, 545 U.S. 913 (2005). Like Napster, Grokster and co-defendant StreamCast provided free software that allowed users to share files. *Id.* However, unlike Napster, Grokster and StreamCast did not host a centralized indexing system. *Id.* Grokster used a supernode model, where a number of select computers on the network operated as indexing servers. *Id.* StreamCast instead used a decentralized index model, where users searching for content conduct a search of all the computers in the network. *Id.*

61. *Napster*, 239 F.3d at 1019–22. The Ninth Circuit held that the record supported the district court's finding that Napster had knowledge requisite for contributory liability because "Napster ha[d] actual knowledge that specific infringing material [was] available using its system, that it could block access to the system by suppliers of the infringing material, and that it failed to remove the material." *Id.* at 1022.

62. *Id.* at 1022–24 (finding the record supported injunctive relief for vicarious liability because Napster financially benefitted where the availability of infringing material could draw customers in, and where Napster had the right and ability to supervise its users' conduct).

63. While Napster did not petition for writ of certiorari, Aimster, another peer-to-peer file sharing service, did petition after losing in the Seventh Circuit. *In re Aimster Copyright Litigation*, 334 F.3d 643 (7th Cir. 2003). The Supreme Court denied Aimster's petition for certiorari in *Deep v. Recording Industry Ass'n of America, Inc.*, 540 U.S. 1107 (2004), perhaps because it was not yet done letting the scope of groundbreaking Internet file sharing take shape.

64. Randal C. Picker, *Revolving Sony: The Evolving Product, Phoning Home and the Duty of Ongoing Design*, 55 CASE W. RES. L. REV. 749, 760 (2005). Picker summarizes the advice software providers might glean from *Napster* as: "Don't be at the center of the [peer-to-peer] network and be sure not to have any ability to police the network. Intentionally relinquish control over the software." *Id.*

65. See *Grokster*, 380 F.3d at 1159; *Napster*, 239 F.3d at 1011–12.

66. See *Grokster*, 380 F.3d at 1163.

the district court observed, even if the [*Grokster* defendants] ‘closed their doors and deactivated all computers within their control, users of their products could continue sharing files with little or no interruption.’⁶⁷ The Supreme Court reversed, concluding unanimously that the *Grokster* defendants intentionally induced infringement,⁶⁸ but disagreeing as to the applicability of the *Sony* substantial noninfringing uses test⁶⁹ or the proper analysis of contributory and vicarious liability.⁷⁰ Congress has not stepped in to offer a competing view in the aftermath of *Grokster*.

Congress makes the most overt corrections on those rare occasions when it passes legislation in the middle of litigation, as it did during the dispute that erupted over the CleanFlicks and ClearPlay business models. CleanFlicks sold edited movies to consumers over the Internet, while ClearPlay sold a set-top box that edited obscenity from movies as users watched them.⁷¹ While these cases were being litigated, Congress intervened and passed the Family Entertainment Copyright Act (“FECA”),⁷² which exempted from liability technologies like ClearPlay that edited movies on the fly, but not the CleanFlicks practice of editing, copying, and selling the edited copies of movies. The passage of FECA was a direct response to the business models that were being tested in the marketplace and the litigation percolating in the courts.

Throughout this history of technological innovation, the courts often take the first step, sometimes tentatively, and sometimes confidently. Where

67. *Id.* (quoting *MGM Studios, Inc. v. Grokster, Ltd.*, 259 F. Supp. 2d 1029, 1041 (C.D. Cal. 2003)).

68. *MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913, 940 (2005) (“The unlawful objective [of the defendants] is unmistakable.”).

69. *Id.* at 941 (distinguishing *Sony*); *id.* at 942 (Ginsburg, J., concurring) (arguing that the Ninth Circuit misapplied *Sony* and that there is at least a genuine issue of material fact regarding the defendants’ liability for contributory infringement); *id.* at 956–57, 965–66 (Breyer, J., concurring) (arguing that the Ninth Circuit correctly applied *Sony* and that Justice Ginsburg’s reading of *Sony* would restrict technological innovation).

70. *Id.* at 937 (majority opinion) (“[M]ere knowledge of infringing potential or of actual infringing uses would not be enough here to subject a distributor to liability.”); *id.* at 948 (Ginsburg, J., concurring) (“On this record, the District Court should not have ruled dispositively on the contributory infringement charge by granting summary judgment to *Grokster* and *StreamCast*.”); *id.* at 956 (Breyer, J., concurring) (citing favorably to *Doe v. GTE Corp.*, 347 F.3d 655, 661 (7th Cir. 2003) (“A person may be liable as a contributory infringer if the product or service it sells has no (or only slight) legal use”).

71. *See Clean Flicks of Colorado, LLC, v. Soderbergh*, 433 F. Supp. 2d 1236, 1238 (D. Colo. 2006) (describing the business model of declaratory judgment plaintiffs and similarly situated businesses); Second Amended Complaint and Jury Demand at 4, *Huntsman v. Soderbergh*, No. 02-M-1662(MJW), 2002 WL 32153735 (D. Colo. Oct. 28, 2002).

72. 17 U.S.C. § 110(11) (2006).

Congress perceives a misstep, it pulls the courts back, most often when it sees the courts failing to provide copyright holders with the ability to control the use of existing works in new media and on new technological platforms.

II. WHEN CONGRESS LEADS AND THE COURTS FOLLOW

In contrast to the courts being in the vanguard, there are times when Congress takes the first step legislatively in dealing with a new technology or innovation, and the courts follow Congress's lead, considering whether Congress is constitutionally permitted to strike out in a new direction—or farther in the same direction.

A snapshot of the legislative evolution of copyright legislation provides an instructive overview of the push and pull between the courts and Congress and among competing interest groups, industry, and industrial policy. The 1909 Act was amended twenty-five times in sixty-eight years. The 1976 Act has been amended sixty times—the staggering rate of an amendment every 209 days since the Act took effect.

Many of the post-1976 amendments focus on copyright piracy and a trip through these amendments is, in many ways, a trip through American industrial policy. For example, Congress tasked the National Commission on New Technological Uses of Copyrighted Works (“CONTU”) with analyzing whether computer programs were copyrightable subject matter. CONTU recommended explicitly extending copyright protection to computer programs, and Congress codified the recommendation in the Computer Software Copyright Act of 1980,⁷³ a mere two years after the 1976 Act took effect.⁷⁴ While there was some initial disagreement in the courts over issues like the copyrightability of object code and whether copyright protected computer programs against non-literal infringement,⁷⁵ the field stabilized somewhat when the Third Circuit upheld the 1980 amendments in a case where Franklin Computer Corporation copied verbatim Apple Computer's operating system.⁷⁶ Franklin resurrected the argument embraced by the Supreme Court in *Apollo*, namely that object code was not copyrightable because it could not be read by a human. The Third Circuit ruled in favor of

73. 17 U.S.C. § 101, 117 (2006); see also J. Corey Asay, *Patching the Loophole: How Copyright Can Help Solve § 271(f)'s Patently Obvious Problem with Computer Software*, 17 U. BALT. INTELL. PROP. L.J. 1, 14 (2008).

74. The Copyright Act of 1976 took effect on January 1, 1978, pursuant to section 102 of Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified as amended at 17 U.S.C. § 101 et seq. (2006)).

75. MARK A. LEMLEY ET AL., *SOFTWARE AND INTERNET LAW* 3–4 (3d ed. 2006).

76. *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240 (3d Cir. 1983).

Apple, noting that Congress made clear in the 1976 Copyright Act that copyright extends to works fixed in a tangible medium of expression which can be perceived “either directly or with the aid of a machine or device.”⁷⁷

Congress followed the Computer Software Copyright Act with a multitude of amendments to the 1976 Copyright Act, including the Record Rental Amendment of 1984,⁷⁸ the Semiconductor Chip Protection Act of 1984,⁷⁹ the Satellite Home Viewer Act of 1988,⁸⁰ the Computer Software Rental Amendments Act of 1990,⁸¹ the Audio Home Recording Act of 1992,⁸² the Uruguay Round Agreements Act (“URAA”),⁸³ the Digital Performance Right in Sound Recordings Act of 1995,⁸⁴ the No Electronic Theft (NET) Act (“NET Act”),⁸⁵ the Digital Millennium Copyright Act (“DMCA”),⁸⁶ the Digital Theft Deterrence and Copyright Damages Improvement Act of 1999,⁸⁷ the Small Webcaster Settlement Act of 2002,⁸⁸ the Fraudulent Online Identity Sanctions Act,⁸⁹ the Artists’ Rights and Theft Prevention Act of 2005,⁹⁰ the Family Movie Act of 2005,⁹¹ and most recently, the Webcaster Settlement Acts of 2008⁹² and 2009.⁹³

77. *Id.* at 1247 (quoting 17 U.S.C. § 102(a)).

78. Pub. L. No. 98-450, 98 Stat. 1727 (1984) (codified in scattered sections of 17 U.S.C.).

79. Pub. L. No. 98-620, Title III, 98 Stat. 3335, 3347 (1984) (codified at 17 U.S.C. § 901 et seq. (2006)).

80. Pub. L. No. 100-667, Title II, 102 Stat. 3935, 3949 (1988) (codified in scattered sections of 17 U.S.C.).

81. Pub. L. No. 101-650, Title VIII, 104 Stat. 5089, 5134 (1990) (codified at 17 U.S.C. § 101, 109, 205 (2006)).

82. Pub. L. No. 102-563, 106 Stat. 4237 (1992) (codified in scattered sections of 17 U.S.C.).

83. Pub. L. No. 103-465, Title V, 108 Stat. 4809, 4973 (1994) (codified in scattered sections of 17 U.S.C.).

84. Pub. L. No. 104-39, 109 Stat. 336 (1995) (codified in scattered sections of 17 U.S.C.).

85. Pub. L. No. 105-147, 111 Stat. 2678 (1997) (codified in scattered sections of 17 & 18 U.S.C.).

86. Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified in scattered sections of 17 U.S.C.).

87. Pub. L. No. 106-160, 113 Stat. 1774 (1999) (codified at 17 U.S.C. § 504 (2006)).

88. Pub. L. No. 107-321, 116 Stat. 2780 (2002) (codified at 17 U.S.C. § 114 (2006)).

89. Pub. L. No. 108-482, § 203, 118 Stat. 3912, 3916 (2004) (codified at 17 U.S.C. § 504(c) (2006)).

90. Pub. L. No. 109-9, Title I, 119 Stat. 218 (2005) (codified in scattered sections of 17 U.S.C.).

91. Pub. L. No. 109-9, Title II, 119 Stat. 218, 223 (2005) (codified at 17 U.S.C. § 110 & 15 U.S.C. § 1114 (2006)).

92. Pub. L. No. 110-435, 122 Stat. 4974 (2008) (codified at 17 U.S.C. § 114 (Supp. 2008)).

With each amendment, Congress took the lead, making copyright policy through legislative force. Perhaps the earliest example of Congress taking the lead occurred when it extended copyright protection to photographs in 1865.⁹⁴ Nearly twenty years later in 1884, the Supreme Court held in *Burrow-Giles Lithographic Co. v. Sarony* that this subject matter extension was within the reach of the Copyright Act.⁹⁵ Sarony was a photographer who took a portrait of Oscar Wilde. Burrow-Giles reproduced the photo in a lithograph without permission. Burrow-Giles argued that Congress could not extend copyright protection to photographs because “a photograph [is] a reproduction on paper of the exact features of some natural object or of some person, [and thus] is not a writing of which the producer is the author.”⁹⁶ The Court held instead that photographs were indistinguishable from “maps, charts, designs, engravings, etchings . . . and other prints,” to which statutory protection was extended in the first two iterations of a copyright statute in 1790 and 1802.⁹⁷ The Court reasoned that if the legislators contemporary with the formation of the Constitution extended protection to maps, charts, and artistic prints, there was no ground for denying protection to photographs.⁹⁸ The Court looked at the developing technology and concluded it was analogous to the technology extant near in time to the passage of the Constitution and thus “that the Constitution is broad enough to cover an act authorizing copyright of photographs, so far as they are representatives of original intellectual conceptions of the author.”⁹⁹

More than a century later, *Eldred v. Ashcroft*¹⁰⁰ provides another example of the Court approving Congressional exercise of its Article I power to provide monopoly rights to authors. Our Constitution is relatively brief. I carry it in my purse. You can contrast this small booklet with the draft European Constitution, which is several hundred pages and fifteen times the length. Despite its brevity, our Constitution explicitly empowers Congress “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective

93. Pub. L. No. 111-36, 123 Stat. 1926 (2009) (codified at 17 U.S.C. § 144 (2006 & Supp. 2009)).

94. Ch. 126, 13 Stat. 540–41 § 1 (1865).

95. 111 U.S. 53 (1884).

96. *Id.* at 56.

97. *Id.* at 57.

98. The Court suggested that the only reason photographs were not included in the act of 1802 “is probably that they did not exist, as photography as an art was then unknown, and the scientific principle on which it rests, and the chemicals and machinery by which it is operated, have all been discovered long since that statute was enacted.” *Id.* at 58.

99. *Id.*

100. 537 U.S. 86 (2003).

Writings and Discoveries.”¹⁰¹ Congress exercised a frequently questioned aspect of its legislative authority under the Copyright Clause when it passed the 1998 Sonny Bono Copyright Term Extension Act (CTEA), extending for twenty years the grant of copyright protection.¹⁰² In *Eldred*,¹⁰³ the Court concluded that Congress had a rational basis for extending the duration of the monopoly grant. The Court’s reasoning in *Eldred* was similar to its rationale in *Burrow-Giles*. In both cases, the Court looked to Congress’s historical behavior, concluding that because Congress had repeatedly exercised its authority to extend the duration of copyright protection, there was nothing inconsistent about it doing so again.¹⁰⁴

Eldred is exemplary of the Court’s deference to Congress’s authority in the copyright demesne, and that deference is not surprising. Promoting the progress of science is a very big tent for rational basis analysis,¹⁰⁵ and lower courts have concluded, following *Eldred*, that they are not permitted to interfere with the exercise of Congressional authority, so long as there is a rational basis for that exercise.¹⁰⁶

The Digital Millennium Copyright Act (“DMCA”)¹⁰⁷ is another landmark exercise of Congressional authority. It could be called “the Copyright Lawyer Relief Act” because it will keep the courts and lawyers busy for years to come. We saw the tip of the iceberg in the last presidential campaign, with John McCain’s campaign using “Running on Empty” in campaign appearances, and Jackson Browne complaining.¹⁰⁸ The Associated Press sued Shepard Fairey over his use of a copyrighted photograph to create the iconic Obama “Hope” posters, presenting the question of whether Fairey’s use of the photo was fair use.¹⁰⁹ Copyright disputes have also emerged during the 2010 election cycle, as Don Henley recently prevailed in a motion for summary judgment against Charles DeVore, a candidate for the Senate from

101. U.S. CONST. art. I, § 8, cl. 8.

102. Pub. L. No. 105-298, Title I, 112 Stat. 2827 (1998) (codified at 17 U.S.C. §§ 108, 203, 301–04 (2006)).

103. 537 U.S. 186 (2003).

104. *Id.* at 204–05.

105. *Id.* at 208.

106. *Golan v. Gonzales*, 501 F.3d 1179, 1187 (10th Cir. 2008) (“The clear import of *Eldred* is that Congress has expansive powers when it legislates under the Copyright Clause, and [courts] may not interfere so long as Congress has rationally exercised its authority.”).

107. Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified in scattered sections of 17 U.S.C.).

108. Complaint, *Browne v. McCain*, No. 08-05334 (C.D. Cal. Aug. 14, 2008).

109. Complaint, *Fairey v. Assoc. Press*, No. 09-1123 (S.D.N.Y. Feb. 9, 2009).

California who rewrote a Henley song to mock incumbent Barbara Boxer.¹¹⁰ The first salvo during the internet era was fired during the 2004 campaign, when JibJab's parody video of George Bush and John Kerry insulting one another to the tune of "This Land is Your Land" led to a cease and desist letter from the putative copyright owner, Ludlow Music.¹¹¹ Once Ludlow learned the copyright in "This Land is Your Land" had expired, the suit settled somewhat amicably.¹¹²

In some ways, the notion of campaigns and copyright has also taken on a whole new meaning as a result of the DMCA. The ability under the DMCA to fire off takedown notices to websites that host content has automated the process and led to some surprising results. For example, during the 2008 presidential election, CBS, Fox, and the Christian Broadcasting Network sent takedown notices to YouTube over McCain campaign videos that included snippets from the broadcasters' programming, and NBC targeted Obama campaign videos with its own takedown notices.¹¹³ We have also seen the election machine vendor Diebold use DMCA takedown notices to remove e-mails posted by students that discussed defects in Diebold voting machines.¹¹⁴

What lessons can we learn in stepping back from this back and forth between the courts and Congress? First, as noted before, the courts have given substantial deference to Congress in the copyright area, as *Eldred* evidences.¹¹⁵

Second, statutory construction tools are often not very useful when talking about the basic provisions of copyright law like the § 106 rights or the enumerated fair use factors in § 107, because those provisions are drafted in a minimalistic fashion.¹¹⁶ There is hardly anything to interpret or to occasion

110. *Henley v. DeVore*, No. 09-481, 2010 WL 2533388 (C.D. Cal. June 10, 2010); Ben Sheffner, *It's Official: Don Henley Wins Summary Judgment Over Chuck DeVore on Copyright Claims*, COPYRIGHTS & CAMPAIGNS, June 14, 2010, <http://copyrightsandcampaigns.blogspot.com/2010/06/its-official-don-henley-wins-summary.html> (last visited Aug. 22, 2010).

111. Bill Thompson, *Keeping How the Net Works Open to All*, BBC NEWS, Sept. 3, 2004, <http://news.bbc.co.uk/2/hi/technology/3624798.stm> (last visited July 1, 2010).

112. Katie Dean, *JibJab Is Free for You and Me*, WIRED, Aug. 24, 2004, <http://www.wired.com/entertainment/music/news/2004/08/64704> (last visited July 5, 2010).

113. *TV Networks Must Stop Blocking Election Videos on YouTube: Public Interest Coalition Outlines Steps to Protect Online Political Speech*, ELECTRONIC FRONTIER FOUNDATION, Oct. 20, 2008, <http://www.eff.org/press/archives/2008/10/20> (last visited July 1, 2010).

114. *Online Policy Grp. v. Diebold, Inc.*, 337 F. Supp. 2d 1195 (N.D. Cal. 2004).

115. *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

116. I do not mean to say the statute favors a "copyright minimalist" approach as compared to a "copyright maximalist" approach. See, e.g., Jessica Litman, *Billowing White Goo*,

the application of these fancy rules of construction. The later amendments are different in kind. Many of these statutes are very complicated, and just as the law is amended, it is outstripped by technology.¹¹⁷ Courts are thus often tasked with taking a complicated amendment and definitions and trying to shoehorn new technology into those definitions, when their applicability is often far from clear. Perhaps this conundrum is among the reasons the Seventh Circuit concluded Congress could not have intended courts to wait for an amendment before applying the Copyright Act to new technologies.¹¹⁸

In *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*,¹¹⁹ the Second Circuit recently wrestled with this same difficulty, considering whether Cablevision's proposed Remote Storage Digital Video Recorder (RS-DVR), which would record programs broadcast to Cablevision subscribers and store the recordings remotely, directly infringed the plaintiffs' exclusive right to copy and publicly perform their programming. The RS-DVR features a streaming buffer which captures authorized broadcast content in tenth-of-a-second increments, continually rewriting the buffers as the program progresses. When recording, the RS-DVR runs content from the streaming buffer to an off-site storage system so the subscriber can watch it later.¹²⁰ The issue in *Cartoon Network* was whether this streaming buffer constituted a fixation

31 COLUM. J.L. & ARTS 587, 600 (2008) (assuming for the sake of argument that the stereotypical "copyright maximalist favors unbounded exclusive rights and a small, flexible fair use privilege . . . [while the] copyright minimalist favors bounded exclusive rights and a broad and encompassing fair use privilege."). Provisions like 17 U.S.C. § 107, which governs fair use, could be considered minimalist in the sense they leave significant room for interpretation. An earlier draft copyright bill left even more to interpretation, stating in its entirety that "Notwithstanding the provisions of section 106, the fair use of a copyrighted work is not an infringement of copyright." H.R. 4347, 89th Cong. (1st Sess. 1965) (quoted in William A. Patry and Shira Perlmutter, *Fair Use Misconstrued: Profit, Presumptions, and Parody*, 11 CARDOZO ARTS & ENT. L.J. 667, 678 n.53 (1993)); S. 1006, 89th Cong. (1st Sess. 1965) (same). Some copyright scholars complain that as a result, the fair use provision protects less speech than it should. See, e.g., Robert Kasunic, *Preserving the Traditional Contours of Copyright*, 30 COLUM. J.L. & ARTS 397, 403–04 (2007) ("The uncertainty of the fair use defense, at a minimum, forces users toward a minimalist approach even if First Amendment interests support more expansive use. . . . As a result, fair use tends to promote careful, minimalist speech rather than robust free speech.").

117. See, e.g., Joseph P. Liu, *Regulatory Copyright*, 83 N.C. L. REV. 87, 126–32 (2004) (discussing how the 1976 Copyright Act and later amendments incorporate complex industry-specific exemptions); David Nimmer, *Appreciating Legislative History: The Sweet and Sour Spots of the DMCA's Commentary*, 23 CARDOZO L. REV. 909, 988 n.447 (2002) ("[O]f late, the Copyright Act has attracted technically complex amendments even more often than once a year.").

118. See *Midway Mfg. Co. v. Arctic Int'l, Inc.*, 704 F.2d 1009 (7th Cir. 1983); *WGN Cont'l Broad. Co. v. United Video, Inc.*, 693 F.2d 622 (7th Cir. 1982).

119. 536 F.3d 121 (2d Cir. 2008).

120. *Id.* at 124–25.

sufficient to infringe the content owners' exclusive right under 17 U.S.C. § 106(1) to copy their programs. To decide that question, the court had to determine whether the work was fixed as it passed through the buffer. Fixation has two elements: it must be embodied in a way that it can be perceived or reproduced, and the embodiment must be "for a period of more than transitory duration."¹²¹ The court concluded that while an entire program would run through the buffer, no part of the program would be there for more than 1.2 seconds, and thus the embodiment was only for a transitory duration.¹²² Certainly this case required the exercise of both the wisdom of Solomon and the dexterity of Houdini! The fine art of statutory interpretation takes on a new meaning in this context.

Third, when courts send a message to Congress, as we often do, such as, "we're not sure; this isn't our arena, Congress, it's yours," by and large, Congress listens to that message and there is often a direct response, with the court calling out and the Congress answering. Courts are willing to step up to the plate on the many novel and uncharted issues that come before the judicial branch but there is always a nagging discomfort about some of the downstream consequences. In some cases, the courts are less well suited than Congress to weigh the competing interests of copyright holders and technology innovators. When considering injunctive relief, as we often do in copyright litigation, courts must balance the needs of the parties against the public interest,¹²³ but that is not a determination that comes with crystal clarity, in part because we lack the means to gather crucial information regarding the "public interest."

Finally, courts and copyright aficionados should beware of the judicial entrenchment factor, where an early case or an early refrain becomes repeated so often that the mantra becomes the law of the land. Two examples serve to illustrate this point. *Zippo Manufacturing Co. v. Zippo Dot Com, Inc.* was one of the first cases to rule on the question of personal jurisdiction based on an internet presence.¹²⁴ The court in *Zippo* used the framework of active versus passive websites to determine whether a website had sufficient contacts with the forum state to support personal

121. 17 U.S.C. § 101 (2006).

122. *Cartoon Network*, 536 F.3d at 130.

123. *See eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006) (holding that the well-established rules of equity, including a determination that "the public interest would not be disserved by a permanent injunction," should be applied in patent litigation); *Salinger v. Colting*, 607 F.3d 68 (2d Cir. 2010) (holding that the *eBay* standard applies with equal force to preliminary injunctions issued in copyright litigation).

124. 952 F. Supp. 1119 (W.D. Pa. 1997).

jurisdiction.¹²⁵ The active-passive test was relatively easy to articulate and soon courts across the country were measuring every website against the active-passive rubric, regardless of whether it bore any relation to what the website was actually doing.¹²⁶ Once launched, that framework became the jurisdictional mantra¹²⁷ that continued to prevail, even as the technology and application changed around it.

Another oft-repeated trope in copyright law is that copyright protection incentivizes the creation of expressive works. This incentives mantra gets repeated by courts and scholars ad infinitum, with some voices challenging statutory provisions because they could not possible create incentives to innovate¹²⁸ and others defending those same provisions as capable of incentivizing meaningful creation.¹²⁹ When these tropes become entrenched,

125. *Id.* at 1124.

126. *Zippo* has been cited by every court of appeals and followed, as Lexis defines the term, in 217 cases. *See also* Toys “R” Us, Inc. v. Step Two, S.A., 318 F.3d 446, 452 (3d Cir. 2003) (“The opinion in [*Zippo*] has become a seminal authority regarding personal jurisdiction based upon the operation of an Internet web site.”).

127. For example, a mere eleven months after the *Zippo* decision, the Ninth Circuit adopted it, noting that “[c]ourts that have addressed interactive sites have looked to the ‘level of interactivity and commercial nature of the exchange of information that occurs on the Web site’ to determine if sufficient contacts exist to warrant the exercise of jurisdiction.” *Cybersell, Inc. v. Cybersell, Inc.*, 130 F.3d 414, 418 (9th Cir. 1997) (quoting *Zippo*, 952 F. Supp. at 1124); *see also, e.g.*, *Lakin v. Prudential Secs., Inc.* 348 F.3d 704, 711 (8th Cir. 2003) (holding that *Zippo* applies in cases where the court must determine whether there are “minimum contacts”); *Toys “R” Us*, 318 F.3d at 452 (adopting the *Zippo* reasoning in the Third Circuit); *ALS Scan, Inc. v. Digital Serv. Consultants, Inc.*, 293 F.3d 707, 713–14 (4th Cir. 2002) (same); *Neogen Corp. v. Neo Gen Screening, Inc.*, 282 F.3d 883, 890–91 (6th Cir. 2002) (same); *Soma Med. Int’l v. Standard Chartered Bank*, 196 F.3d 1292, 1296–97 (10th Cir. 1999) (same); *Mink v. AAAA Dev. LLC*, 190 F.3d 333, 336–37 (5th Cir. 1999) (same).

128. *See, e.g.*, Robert P. Merges, *One Hundred Years of Solicitude: Intellectual Property Law, 1900–2000*, 88 CAL. L. REV. 2187, 2236 (2000) (“The Sonny Bono Copyright Term Extension Act of 1998 is a prime example of legislation that strongly favored a narrow class of copyright owners, broadly but mildly affected many present and future consumers, was intensively lobbied, and became law with little opposition. . . . From an incentive point of view, the Act is virtually worthless.”).

129. *See, e.g.*, *Luck’s Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1264 (D.C. Cir. 2005). The court stated:

[C]hanges in the law of copyright cannot affect the structure of incentives for works already created. But the knowledge that Congress may pass laws like the URAA in the future does affect the returns from investing time and effort in producing works. All else equal, the expected benefits of creating new works are greater if Congress can remedy the loss of copyright protection for works that have fallen accidentally into the public domain. . . . To be sure, the extra incentive afforded by [the URAA] is meager. But to the extent that Eldred required any direct incentive, it plainly need not be great.

Id.

either by Congressional fiat or through the accretion that comes from our common law practice of reasoning by analogy, extra effort is required to make sure that, to the extent that this dance with Congress leaves us with a central role in shaping copyright law, we shape it consistent with its constitutional *raison d'être*—to promote the progress of science and useful arts.

III. CHALLENGES AND ISSUES FOR THE COURTS IN THE COMING YEARS

Courts often must fit the square peg of innovation into the round holes Congress has provided us in the Copyright Act, as demonstrated in cases like *Apollo*¹³⁰ and *Cartoon Network*.¹³¹ Indeed, the development of law and the development of technology often move in different directions. Courts rule incrementally, reasoning by analogy from precedent. Cutting edge technology can burst on to scene in dramatic fashion, and the best innovation often does not resemble that which came before. In dealing with change, technology looks forward and the courts look backward to precedent and past conduct or events. Technological development is about realizing what has never been done before, while reasoning by analogy requires determining how new phenomena fit in with things we readily understand. This inherent tension will remain with us, and as courts, we must be cognizant of our institutional handicaps in discerning how best to deal with new technologies.¹³²

130. See *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908).

131. See *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F.3d 121 (2d Cir. 2008).

132. See Richard A. Posner, *Against Constitutional Theory*, 73 N.Y.U. L. Rev. 1, 12 (1998) (“The capability of the courts to conduct scientific or social scientific research is extremely limited, and perhaps nil.”); Timothy L. Skelton, *Internet Copyright Infringement and Service Providers: The Case for a Negotiated Rulemaking Alternative*, 35 SAN DIEGO L. REV. 219, 223, 340 (1998) (arguing that courts are ill-suited to resolve copyright disputes over internet behavior because “even the best informed judges cannot be expected to render consistent decisions when they are presented with an intensely technical and constantly evolving factual setting, which they are then required to apply to a statutory framework that has been outpaced by technology”); Jane Winn & Nicolas Jondet, *A New Deal for End Users? Lessons from a French Innovation in the Regulation of Interoperability*, 51 WM. & MARY L. REV. 547, 557 (2009) (reporting the conclusion of French lawmakers that the civil courts were unsuited to enforce interoperability requirements “because they would lack the expertise, speed, and secrecy required to deal with highly sensitive and fast-evolving technologies”); see also Susan D. Ross, *A Decade After Divestiture: Regional Bells, Video Programming and the First Amendment*, 21 RUTGERS COMPUTER & TECH. L.J. 143, 156 (1995) (noting that courts attempting to determine how new communication media match established First Amendment categories “must either apply unsuitable First Amendment doctrine to new technologies possessing a hybrid of characteristics, or they must craft new doctrine”).

It is nevertheless unsurprising to see courts reasoning by analogy in a technology case because our other tools are limited. Our traditional tools have been supplemented by economic and policy analysis done by Pamela Samuelson and others.¹³³ Those tools are enormously helpful to the extent they allow the courts to think about the law on multiple levels, constrained of course by precedent, analogy, and our incrementalist nature.

We also often look to lawyers for assistance, particularly in providing technical tutorials, technical expertise, and elaboration of the practical ramifications of potential decisions. Courts are looking for rules and principles that make sense going forward. Often during oral argument, we invite counsel to tell us how they would write the rule or decision. I am stunned when lawyers shrink from the opportunity. The beauty of the advocacy system is that lawyers help advance the law and assist the courts in crafting rules and principles. It is crucial for counsel to articulate the downstream effects of the position they endorse, and the ripples that might spread outward from the opinion we will write to resolve the case before us. To be sure, lawyers do not write our opinions, but our system is geared to synthesize the perspective that each side marshals in its favor.

Justice Breyer's disagreement with Justice Ginsburg over how to apply *Sony* in the *Grokster* case highlights both our concrete need for assistance from counsel in understanding new technologies, and the occasional difficulty of this task.¹³⁴ Justice Breyer pointed out that content owners argued that an add-on could easily filter out infringing content, while *Grokster* argued it was neither easy nor efficient to do so.¹³⁵ Justice Breyer noted that judges have no specialized technical ability to answer the questions, either about present or future technological feasibility and commercial viability.¹³⁶ At the same time, technology professionals, engineers, and venture capitalists themselves often radically disagree, and technological feasibility may shift, depending on whether you focus on the time the product is first developed, or when it is ready for distribution. It is

133. See, e.g., Pamela Samuelson & Suzanne Scotchmer, *The Law and Economics of Reverse Engineering*, 111 YALE L.J. 1575, 1626–27 (2002).

134. *MGM Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 949 (2005) (Breyer, J., concurring) (agreeing with the plurality opinion that *Grokster* and *StreamCast* were potentially liable for inducing infringement, but disagreeing with Judge Ginsburg's concurrence and arguing that the Ninth Circuit correctly applied the *Sony* test in granting *Grokster's* motion for summary judgment based on the substantial capacity of the peer-to-peer service to be used for noninfringing purposes).

135. *Id.* at 958 (arguing that under the correct reading of *Sony*, a judge need not make a determination regarding which account to credit).

136. *Id.*

significant that Justice Breyer, whose tenure work as a professor was in the copyright area,¹³⁷ so aptly captures that discomfort faced by the courts.

Apart from the precedent that develops in intellectual property cases, we often see technology issues first emerge in criminal and constitutional cases. A good example is provided by *Kyllo v. United States*, the thermal imaging case, which involved the use of a device that detected heat signatures emanating from buildings to look for telltale signs of marijuana cultivation.¹³⁸ The Supreme Court considered whether the technology should be conceptualized as going *through* the wall, like walking through the house, or conceptualized as if it goes *off* the wall.¹³⁹ Justice Scalia said the rule that we adopt must take into account both systems already in play, and more sophisticated systems in development.¹⁴⁰ We must also consider the next technological step when we resolve intellectual property disputes.

We also see some overlap in the technical issues involving the dissemination of child pornography and the term “distribution” as it is defined in the Copyright Act. In attempting to persuade the district court to adopt the “making available” definition of the distribution right, i.e., that an individual violates the copyright owner’s exclusive right to distribute the copyrighted work by putting the work online where it can be downloaded, Capitol Records invited the district court to interpret the Copyright Act in light of the statute addressing criminal penalties for distributing child pornography, which defined “distribute” to include placing pornographic material in a shared folder on a peer-to-peer network.¹⁴¹ The court concluded there that the plain meaning of “distribution” in the Copyright Act did not include making available, but instead required actual dissemination.¹⁴²

Courts and scholars are currently trying to fit the Electronic Communications Privacy Act of 1986 (“ECPA”)¹⁴³ to the new realities of the

137. Stephen G. Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281 (1970).

138. 533 U.S. 27 (2001).

139. The dissent argued that there was a principled distinction between “off-the-wall” observations and “through-the-wall” surveillance. *Id.* at 43–44 (Stevens, J. dissenting). The majority disagreed, holding that while the crude status of current technology prevented “through-the-wall” surveillance, using that metric “would leave the homeowner at the mercy of advancing technology—including imaging technology that could discern all human activity in the home.” *Id.* at 35–36 (majority opinion).

140. *Id.* at 36.

141. *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210, 1218 (D. Minn. 2008) (comparing 17 U.S.C. §§ 101 and 106(3) with 18 U.S.C. § 2252A(a)(2)).

142. *Id.* at 1218–19.

143. Pub. L. No. 99-508, 100 Stat. 1848 (1986) (codified in scattered sections of 18 U.S.C. (2006)).

Internet. For example, ECPA was written in an era when users downloaded e-mails to their personal computers from servers. The provision allowing the government to access e-mails stored 180 days with only an administrative or grand jury subpoena made some sense, as a user who had not downloaded the e-mail effectively abandoned it.¹⁴⁴ This 180 day window makes little sense in a world where much important, and arguably private information—and nearly every e-mail—is stored remotely.¹⁴⁵

Recently, my good friend Chief Judge Kozinski and I debated the scope of the Communications Decency Act of 1996 (the “CDA”)¹⁴⁶ in *Fair Housing Council of San Fernando Valley v. Roommates.com, LLC*.¹⁴⁷ Roommates.com was sued for violating the Fair Housing Act.¹⁴⁸ Roommates.com provided rental listings, with profiles assembled and housing recommendations made based on each user’s disclosures about gender and whether the user would bring children to the household, along with each user’s preferences for roommates in these various categories. Chief Judge Kozinski and I disagreed about whether CDA, which immunizes providers of interactive computer services against liability arising from content created by third parties,¹⁴⁹ also immunized Roommates.com from liability for the format of its rental questionnaire and how responses to it shaped apartment listings.¹⁵⁰

These non-intellectual property cases are important to the future of copyright law because they provide an insight into judicial reasoning in the technology arena and also are so numerous that they dwarf in number and dimension the technology-driven cases dealing with intellectual property disputes.

A second set of challenges revolves around educating the courts and keeping pace with technology, both through inside education and outside education. Consider the following with respect to inside education: If a judge does internet research on a factual matter in connection with a pending

144. Matt Tokson, *Automation and the Fourth Amendment*, 96 IOWA L. REV. (forthcoming 2011).

145. *Id.*

146. 47 U.S.C. §§ 230, 560, 561 (2006).

147. 521 F.3d 1157 (9th Cir. 2008) (en banc).

148. 42 U.S.C. § 3601 et seq.

149. 47 U.S.C. § 230(c).

150. *Compare* 521 F.3d at 1164–65 (Kozinski, C.J.) (holding Roommates.com is both a service provider and a content provider because it selected the questions users would answer and filtered search results based on roommate-seekers’ preferences and the characteristics of prospective roommates), *with id.* at 1177 (McKeown, J., dissenting in part) (arguing that the majority misconstrued the CDA, as “Congress intended . . . the collection, organizing, analyzing, searching, and transmitting of third-party content . . . to be beyond the scope of traditional publisher liability”).

matter, is that background research, or is it extra-record evidence? The Code of Conduct for United States Judges, and similar provisions found in state codes, state that judges may not have “initiate, permit, or consider ex parte communications . . . that are made outside the presence of the parties or their lawyers.”¹⁵¹ Outside ex parte consultation is prohibited, which is why we cannot call up a professor and ask what she thinks about a pending case—we may, however, call on special masters and experts. This principle is not new, but the Internet makes volumes of information easily accessible. But what happens if I want to find out how the Slingbox really works, and I cannot divine it from the briefs, or I want to figure out how Google Scholar functions, or how the new iPad technology interfaces with the iPhone applications? Can I use the Internet and find out a little background information that would enhance my understanding so I could make a more informed decision?¹⁵² Recently, the Second Circuit answered that question in the affirmative, concluding that a district judge’s internet search to confirm his intuition about the variety of yellow rain hats available for sale was not reversible error in a criminal trial.¹⁵³ But in federal courts the issue is far from clear and judges, scholars, and lawyers are not in agreement.

The U.S. Patent and Trademark Office provides some guidance on internet searches. The Patent Office cut off the practice of examiners using Wikipedia, due to concerns about its reliability.¹⁵⁴ The Trademark Trial and Appeal Board did essentially the same thing.¹⁵⁵ I suggest to you that the problem does not stop with Wikipedia. The general accessibility of information on the Internet, much of which is not vetted, raises the same concerns. Courts have not yet tackled the question of what internet research, if any, is permissible, and what the role of the Internet can and should play, as a “treatise,” in deciding intellectual property cases. The lines blur between

151. CODE OF CONDUCT FOR UNITED STATES JUDGES Canon 3(A)(4).

152. See generally David H. Tennant & Laurie M. Seal, *Judicial Ethics and the Internet: May Judges Search the Internet in Evaluating and Deciding a Case?*, PROF. LAW., Spring 2005.

153. *United States v. Bari*, 599 F.3d 176, 180–81 (2d. Cir. 2010).

154. Peter Lattman, *PTO on Wikipedia: Patently Unreliable*, WALL ST. J. LAW BLOG (Aug. 25, 2006), <http://blogs.wsj.com/law/2006/08/25/pto-on-wikipedia-patently-unreliable/tab/article/> (last visited Apr. 22, 2010).

155. See Trademark Manual of Examining Procedure (TMEP) § 710.01(b), (c) (6th ed. May 2010). The Trademark Trial and Appeal Board has also recognized the “inherent problems regarding the reliability of Wikipedia entries” in particular “because Wikipedia is a collaborative website that permits anyone to edit the entries.” Evidence from Wikipedia is treated as having limited probative value, and should be corroborated. *In re IP Carrier Consulting Group*, 84 U.S.P.Q.2d 1028, 1032 (T.T.A.B. 2007). The Board has also refused to take judicial notice of online dictionary definitions not available in printed form, due to concerns about reliability. See *In re Red Bull GmbH*, 78 U.S.P.Q.2d 1375, 1378 (T.T.A.B. 2006).

importing information ex parte on the one hand and the court taking judicial notice or simply enhancing its background knowledge on the other hand.

Let me address now outside education, by which I mean efforts by those who are outsiders to educate the court. We have seen a proliferation of groups that appear as amici in the technology-driven copyright cases. We always have had the old line groups, like the Motion Picture Association of America, with which Jack Valenti was closely identified for so many years, or the Business Software Alliance, or the Software & Information Industry Association. Now we see organizations that did not exist twenty years ago, like the Electronic Frontier Foundation, Public Knowledge, the Sunlight Foundation, or IP Justice. To understand the proliferation of amici, one need only consider *Eldred*, where forty-two different amicus briefs were filed, or *Grokster*, where fifty-three were filed.¹⁵⁶ I view this increased interest and participation as a positive development. By constitutional necessity, our jurisdiction is constrained by standing principles, A v. B, or several As v. several Bs. We often contemplate the broader consequences of particular rulings, although we can only decide the case before us. These organizations provide the courts with valuable perspectives to the extent they supplement the analysis and information conveyed by the parties, explain downstream consequences, and provide valuable context.

Law schools and their students are new and valuable participants in the amicus process. The Samuelson Law, Technology & Public Policy Clinic at Berkeley, the Berkman Center for Internet & Society at Harvard University, the Stanford Center for Internet and Society, the University of San Francisco Internet and Intellectual Property Justice Clinic, and the Intellectual Property Law Clinic at Maine Law, among others, provide law students an opportunity to participate in intellectual property and cyberlaw clinics. Like the civil rights organizations in the 1950s and 1960s, these organizations are growing into litigation machines. They are not only training lawyers, but they are incubators for new and different kinds of cases. But as Paul Goldstein has said, “[c]opyright is about money,”¹⁵⁷ so I would not endow copyright

156. Further, during the 2003 Supreme Court term, a record 107 briefs were filed in *Grutter v. Bollinger*, 539 U.S. 306 (2003) and *Gratz v. Bollinger*, 539 U.S. 244 (2003), “while an impressive 33 amicus briefs were filed in . . . *Lawrence v. Texas*], 539 U.S. 558 (2003)].” Kelly J. Lynch, *Best Friends? Supreme Court Law Clerks on Effective Amicus Curiae Briefs*, 20 J. L. & POL. 33, 33–34 (2004); see Joseph D. Kearney & Thomas W. Merrill, *The Influence of Amicus Curiae Briefs on the Supreme Court*, 148 U. PA. L. REV. 743, 749, 754 (2000) (reporting that from 1946 to 1995, amicus brief filings increased 800%, and that in the last decade of the study, a mean of 4.23 briefs were filed per case). The dozens of amicus briefs filed in *Eldred* and *Grokster* represent a significant range of filings.

157. GOLDSTEIN, *supra* note 10, at 4.

litigation with the same moral stature as civil rights litigation. It is fair to say, however, that the role of academic institutions as the test bed for frontier litigation is the wave of the future.

I cannot close without looking to coming attractions that courts will see in the coming years. One key area that will be a blockbuster is metadata. We started with *Feist Publications, Inc. v. Rural Telephone Service Co.*¹⁵⁸ and learned from the Supreme Court what compilations in data meant and the extent to which they fall outside the scope of copyrightable subject matter. We now see cases where the generation of data raises questions about how much protection various copyrighted works get online. The Google Books dispute is a pending matter,¹⁵⁹ so I cannot comment other than to note it raises the metadata issue. Another recently decided case also illustrates the issue. The website Turnitin.com collected papers from high school and college students for grading purposes, but also checked whether the papers were plagiarized by comparing them to other works in the database. The students disliked the inclusion of their papers in the plagiarism database, so they sued. The Fourth Circuit concluded that the papers just added grist to the plagiarism detection mechanism, and thus Turnitin.com did not infringe the student's copyright because including their papers in the database to detect plagiarism was a transformative use.¹⁶⁰ What is transformative has bedeviled the courts for years and I think it will continue to do so in a more sophisticated way in the metadata context.

Although much of the emphasis today is about intellectual property rights, another phenomenon to focus on is the accelerated evolution of distribution mechanisms. Copyright cases historically turn on whose ox is gored. Even in the courts, we see cases played out like movie scripts with the white hats and the black hats, authors versus pirates, or individuals versus big business. Certainly, when I stood before the jury to argue a case, I tried to figure out a moral theory that would highlight the merits of my client's case.

It is natural to focus on the extent of intellectual property rights, but economists have long reminded us that optimal bargains can emerge from any set of property rights.¹⁶¹ Inefficient transactions and market exchanges, however, can make it difficult to bargain and contract efficiently.¹⁶² Like any

158. 499 U.S. 340 (1991).

159. Author's Guild, Inc. v. Google Inc., No. 05-8136 (S.D.N.Y. filed Sept. 20, 2005).

160. A.V. ex rel. Vanderhye v. iParadigms, LLC, 562 F.3d 630, 641 (4th Cir. 2009).

161. See generally Ronald H. Coase, *The Nature of the Firm*, 4 *ECONOMICA* 386 (1937).

162. Oliver Williamson has extensively explored the implications of these transaction costs. See generally OLIVER E. WILLIAMSON, *THE ECONOMIC INSTITUTIONS OF CAPITALISM: FIRMS, MARKETS, RELATIONAL CONTRACTING* (1985).

system that distributes property, the copyright system has its own inefficiencies, both with regards to presumptions of infringement and traditional licensing regimes. Transactions between potential licensors and licensees may be too slow or too costly. The information available to market participants may be flawed. Contracts may not be effectively enforceable. Institutions that simplify transaction problems, such as stock markets and commodities future markets, illustrate how market institutions are created to address these challenges. In the coming years, copyright lawyers and scholars can count on the development of innovative transaction and distribution models. Legal analysts should pay as much attention to the transaction innovations as they do to the development of property rights at issue.¹⁶³

As the frequency of technological change accelerates, the debate may also shift from rights to principles of competition, antitrust, and practices that unfairly impact consumers. We may continue to see moral dilemmas of “good vs. bad,” but insofar as copyright cases can be understood through the lens of competition policy, we can then analyze them with our well-known and well-tread principles from the antitrust and unfair competition arenas. Antitrust laws have not been amended as often as the copyright laws in order to keep pace with technology, and courts are quite comfortable in dealing in markets, antitrust, and anticompetitive issues. Competition law is an area where courts have deeper experience and we may see more attempts to understand or justify copyright law by looking through the lens of competitive effects.

The final challenge I suggest to you is in the international arena. For centuries, our law has been characterized by physical boundaries, whether political frontiers or even physical barriers. Extraterritorial application of domestic law has always been the exception, but the Internet is changing the landscape. We still have national courts, but the Internet is a medium that knows no bounds. This reality is manifest in the ongoing skirmish between China, which hopes to control what its populace can learn online, and Google, which became so uncomfortable with its role in China’s censorship policies that it backed away from the relationship.¹⁶⁴

163. *See generally* PETER F. COWHEY & JONATHAN D. ARONSON, *TRANSFORMING GLOBAL INFORMATION AND COMMUNICATIONS MARKET: THE POLITICAL ECONOMY OF INNOVATION* (MIT Press 2009).

164. *See, e.g.*, Miguel Helft & Michael Wines, *Google Faces Fallout as China Reacts to Site Shift*, N.Y. TIMES, Mar. 23, 2010, http://www.nytimes.com/2010/03/24/technology/24google.html?_r=1&hp (last visited June 30, 2010); Nicholas D. Kristof, *China and Google*, N.Y. TIMES BLOGS, Mar. 24, 2010, <http://kristof.blogs.nytimes.com/2010/03/24/china-and-google/> (last visited Aug. 6, 2010).

One case recently before the Ninth Circuit, *Yahoo! Inc. v. La Ligue Contre Le Racisme et L'Antisemitisme*,¹⁶⁵ captures the complexities of the combination of the Internet, competing principles of free speech, foreign law, domestic courts, and jurisdiction. In that case, the court considered the promotion, advertisement, and sales of Nazi memorabilia online, which pitted First Amendment rights under the U.S. constitution against French law making those sales flatly illegal. The Internet is not designed to distinguish between French consumers and others who might see this merchandise online.¹⁶⁶ Nevertheless, two French anti-racism groups¹⁶⁷ successfully sued Yahoo! in the Tribunal de Grande Instance de Paris, securing an interim order requiring Yahoo! to “take all necessary measures to dissuade and render impossible any access” to Nazi memorabilia from France.¹⁶⁸ Yahoo! sought declaratory relief in the United States, and the Ninth Circuit affirmed the district court’s exercise of jurisdiction in a fractured opinion.¹⁶⁹ The *Yahoo!* case is emblematic both of the difficulty of ascertaining jurisdiction in a world where the Internet has created a global marketplace, and the substantive issues our courts must be prepared to resolve under conflicting legal regimes.

In another example, European newspapers have successfully obtained injunctions against¹⁷⁰ or negotiated licenses with¹⁷¹ Google in disputes over whether Google can post headlines, photographs and news summaries without permission. This principle runs counter to Ninth Circuit precedent in *Perfect 10, Inc. v. Amazon.com, Inc.*, where we concluded that the inline linking of images was not infringement.¹⁷² Again, when it comes to downloading or linking to websites, the Internet does not distinguish between news stories generated in Belgium or Germany, and those generated within the United States.

165. 433 F.3d 1199 (9th Cir. 2006) (en banc).

166. *Id.* at 1202.

167. La Ligue Contre Le Racisme et L'Antisemitisme (“LICRA”) and L'Union des Etudiants Juifs de France (“UEJF”).

168. *Yahoo!*, 433 F.3d at 1202.

169. A majority of the en banc panel held that the district court properly exercised personal jurisdiction over LICRA and UEJF, while a plurality concluded the case was not ripe. *Id.* at 1201.

170. *Copiepresse v. Google, Inc.*, No. 06/10.982/C (Court of First Instance Feb. 2, 2007). The Court of First Instance “ruled that ‘Google had infringed the copyright of Belgian newspapers by publishing links to their stories on Google News.’” Dan Tammuz, *On the Perils of Inadequate Analogies*, 2008 DUKE L. & TECH. REV. 4, 27 (internal quotation marks and citation omitted).

171. Caroline McCarty, *Agence France-Presse, Google Settle Copyright Dispute*, CNET NEWS, Apr. 6, 2007, http://news.cnet.com/Agence-France-Presse,-Google-settle-copyright-dispute/2100-1030_3-6174008.html (last visited June 30, 2010).

172. 487 F.3d 701 (9th Cir. 2007).

It is also important for courts, lawyers and scholars to understand that for intellectual property, the concept of a “global economy” is not mere rhetoric. The Internet is global, and so is access to copyrighted works via the Internet. Michael Traynor, President Emeritus of the American Law Institute (“ALI”), has suggested that as we prepare for a future where the laws of the United States will begin to bump against foreign law, that we “[d]evelop the principle . . . of identifying and eliminating ‘false conflicts’ in significant part through the forum’s restrained and enlightened view of forum law.”¹⁷³ The goal of a “restrained and enlightened view” is to “use restraint in the determination of the content and scope of [forum] policies, and to apply principles common to [all] the [fora] involved in a particular case.”¹⁷⁴ We cannot make the mistake of concluding that the United States is the global court for the Internet, or for other international disputes that may find their way before our courts. Not long ago, the ALI drafted principles of international intellectual property jurisdiction.¹⁷⁵ This important document lays the framework for how U.S. courts might begin to handle international intellectual property cases in a way that is consistent with our jurisprudence, but also recognizes our responsibility to fairly consider the regimes and systems of other fora.

These are but a handful of the challenges that the judiciary will face in the coming decades. Before long, *Napster*, *Grokster*, and *Cartoon Network* will be historical references in some treatise. The rapid pace of technological change will undoubtedly transform copyright law accordingly. I trust that all of you, with your excellent scholarship, commitment to the rule of law, and enthusiasm, will keep us sharp in the courts and help us negotiate law on the cutting edge of technology. We don’t mind going to the cutting edge in our dance with Congress, but don’t let us fall off.

173. Michael Traynor, *The First Restatements and the Vision of the American Law Institute, Then and Now*, 32 S. ILL. U. L.J. 145, 152 (2007) (referencing Brainerd Currie, *Married Women’s Contracts: A Study in Conflict-of-Laws Method*, 25 U. CHI. L. REV. 227 (1958)).

174. Michael Traynor, *Conflict of Laws: Professor Currie’s Restrained and Enlightened Forum*, 49 CAL. L. REV. 845, 855 (1961).

175. See INTELLECTUAL PROPERTY PRINCIPLES GOVERNING JURISDICTION, CHOICE OF LAW, AND JUDGEMENTS IN TRANSNATIONAL DISPUTES (2008).

THE COPYRIGHT PRINCIPLES PROJECT: DIRECTIONS FOR REFORM

Pamela Samuelson and Members of The CPP[†]

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[†] This article was jointly authored by the members of The Copyright Principles Project (The CPP), including the group's convenor, Pamela Samuelson (Berkeley Law School). For a complete list of authors, see page 1180, *infra*. The CPP also benefited from visits with Marybeth Peters, the Register of the U.S. Copyright Office, the Honorable Margaret McKeown, Ninth Circuit Court of Appeals Judge, and Professor Molly van Houweling, Berkeley Law School, as well as from discussions with Paul Geller and Randall Davis. Thomas Kearney provided support for the CPP at most meetings.

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PREAMBLE

Copyright law performs a number of important functions. It facilitates public access to knowledge and a wide range of uses of creative works of authorship, and, in so doing, it helps educate our populace, enrich our culture, and promote free speech, free expression, and democratic values. It provides opportunities for rights holders to recoup investments in creating and disseminating their works and to enjoy the fruits of whatever success arises from the public's uses of their works. In the process, copyright also plays a role in regulating new technologies and services through which creative works may be accessed.

A well-functioning copyright law carefully balances the interests of the public in access to expressive works and the sound advancement of knowledge and technology, on the one hand, with the interests of copyright owners in being compensated for uses of their works and deterring infringers from making market-harmful appropriations of their works, on the other. Copyright law should enable the formation of well-functioning markets for creative and informative works that yield benefits for all stakeholders.

At this level of generality, agreement is easy to reach. Disagreements tend to arise over how to implement these goals in statutory language and actual practice.

The Copyright Principles Project (CPP), whose Report appears below, was formed in 2007 out of a collective sense among its members that although copyright law today works reasonably well in some domains, it can be improved and should be refined in light of dramatic technological advances. The twenty people who joined the CPP have various kinds of expertise and experience with copyright law and policy. Among us are law professors, lawyers from private practice, and lawyers for copyright industry firms. The goal of the CPP was to explore whether it was possible to reach some consensus about how current copyright law could be improved and how the law's current problems could be mitigated.

Copyright law is, for many reasons, under considerable stress today. The most obvious and perhaps most significant source of this stress is the radical transformation of public access to information that has been brought about by changes in computing and communications technologies and accessibility of information through global digital networks. The Internet and World Wide Web, in particular, have destabilized many copyright industry sectors as the economics of creating, publishing, and disseminating information-rich works have dramatically changed. New business models have not always proven successful. It may take some time and patience to allow disrupted copyright sectors to consider, experiment with, and develop other or more refined models and approaches with which they will be reasonably comfortable.

One important development has been the phenomenal growth and profusion of user-generated content. Copyright has, of course, always touched and enriched untold ordinary people, as well as specialists, by fostering the provision of entertainment, education, and other information goods and services, but until recently copyright law was relatively invisible to the general public. Amateurs as well as professional artists and authors are now encountering copyright issues on a regular basis. Copyright rules implicate many daily activities of ordinary people. Copyright has thus suddenly become significant not only to industry insiders who are steeped in this law's complexities, but also to the millions of people who access information on the Internet and who often share this information with others.

Another important development has been the widespread use of peer-to-peer file-sharing technologies to exchange copies of copyrighted works, particularly music and movies. The willingness of millions of people to engage in such file-sharing has understandably frustrated the entertainment industry and generated a sense of crisis. Efforts to address this phenomenon through litigation have shut down some services and resulted in some compensation to rights holders, but the phenomenon itself has not abated. Efforts to encourage or require intermediaries, especially technology and telecommunications companies, to control or impede infringing activities have met with limited success.

There is, in addition, a more general problem that affects copyright law today: technological advances often pose questions that Congress did not and could not have anticipated in the mid-1970s when the last copyright reform effort reached fruition. Patchwork amendments to the copyright law since then have contributed further to the complexity of current copyright law. Due to this complexity, it has sometimes been difficult for judges to

glean the powerful normative principles that ought to illuminate how copyright law should be applied in particular instances.

At the outset of this project, we spent a considerable amount of time discussing the scope and objective of our efforts. We considered a range of possible outputs, from a simple statement of normative principles to the formulation of a detailed blueprint for comprehensive copyright reform. Although the group was broadly representative of different viewpoints and each of us had opinions about particular strengths and weaknesses of the existing copyright system, our ability to propose a substantial and comprehensive reform of U.S. copyright law was limited, partly because we met only three times a year for three years. We believe that we have succeeded in mapping the terrain of copyright law and policy and in articulating both where we agree and where and why we disagree about particular aspects of U.S. copyright law. We believe, moreover, that we have accomplished these objectives in a way that has avoided the climate of recrimination that has characterized so many copyright debates in recent years. The significance of this achievement should not be understated. We are not, however, in a position to offer a comprehensive and detailed set of reform proposals.

What can and should be done to address the difficulties that attend today's copyright law? There is, of course, no one "silver bullet" that can relieve all the stresses, maintain or renew public confidence in copyright, and bring calm to copyright industries disrupted by new technologies. CPP members are not uniformly of one mind about various steps that could lead to improvements. Some CPP members are relatively content with the existing legal framework, yet accept the desirability of making some adjustments to fix certain problems. Other CPP members believe that copyright law can only be saved by very substantial reforms that many copyright industry groups would regard as radical. These changes would include dramatically shortening copyright's duration, cutting back on the scope of protection, privileging private, non-commercial uses of protected works, and reinstating copyright rules that provide the public with better notice of copyright claims than the law today requires.

During the course of this project, some of us have generated ideas about broader reform proposals, but those ideas are not part of this group project. It is to be expected that future work by some of our members will explore those ideas and contribute further to a more general conversation that we think should occur about copyright reform.

The deliberations of the CPP on new ideas and perspectives on copyright law were conducted in the spirit of open discussion and dialogue. The views expressed in this Report are, however, those of the individuals involved; they

should not be ascribed to the members' institutions, organizations, clients, or employers. Individual participation in this project should, moreover, not be interpreted as an endorsement of each and every proposal discussed in this document. In fact, various members of the group maintain reservations and even objections to some proposals described as recommendations in this Report.

While various proposals elicited enough support within the group that it was deemed constructive to style them as recommendations, we do not intend affirmative statements or the use of phrases, such as "we recommend" or "we believe," to suggest that the group as a whole was uniformly in support of each particular view stated. It is a tribute to the collegiality of the group and our collective desire to foster a constructive dialogue about copyright law that there was enough agreement among us to set forth recommendations in this manner.

Despite our strong differences on some issues, CPP members have, over the course of three years, collectively decided that it would be beneficial to articulate some principles of a "good" copyright law, to analyze respects in which existing copyright law does or does not comport with these principles, and to recommend changes to copyright law that would bring it into greater conformity with the principles. Making changes recommended in this Report would overcome some dysfunctions we perceive in current law and put it on a sounder normative foundation. Even where we disagree, recording the nature of our disagreements could advance discourse on copyright issues by others. Some changes recommended in this Report can only be brought about by legislative action, while others can be accomplished through common law evolution. We hope that this Report will contribute to a wider and more effective conversation about how to improve copyright law and policy. We further hope that this Report will lead to follow-on activities to assess, refine, and implement our recommendations.

We end this preamble with one last observation. Too much discourse about copyright law in the past fifteen years has been burdened by rhetorical excesses and an unwillingness to engage in rational discourse with those having differing perspectives. The CPP has proven that it is possible for persons of good will with diverse viewpoints and economic interests to engage in thoughtful civil discourse on even the toughest and most controversial copyright issues. After three years of conversations, the CPP members all came away from this project believing that a better copyright law is possible. We hope our work will inspire others to imagine the same and bring that vision to fruition.

The following persons are members of the Copyright Principles Project:

Pamela Samuelson, Berkeley Law School (convenor)

Jon A. Baumgarten, Proskauer Rose LLP

Michael W. Carroll, American University, Washington College of Law

Julie E. Cohen, Georgetown University Law Center

Troy Dow, The Walt Disney Co.

Brian Fitzgerald, Queensland University of Technology

Laura Gasaway, University of North Carolina School of Law

Daniel Gervais, Vanderbilt Law School

Terry Ilardi, IBM Corp.

Jessica Litman, University of Michigan School of Law

Lydia Pallas Loren, Lewis & Clark Law School

Glynn Lunney, Tulane University School of Law

Tyler Ochoa, Santa Clara University School of Law

R. Anthony Reese, University of California, Irvine, School of Law

Jule Sigall, Microsoft Corp.

Kate Spelman, Cobalt LLC

Christopher Sprigman, University of Virginia School of Law

Michael Traynor, President Emeritus, American Law Institute

Tara Wheatland, Berkeley Law School

Jeremy Williams, Warner Bros. Entertainment Inc.

I. GUIDING PRINCIPLES

A well-functioning copyright law carefully balances the interests of the public and of copyright owners. To do this in a way that is both efficient and fair, copyright law should be informed by the following principles:

1. Copyright law should encourage and support the creation, dissemination, and enjoyment of works of authorship in order to promote the growth and exchange of knowledge and culture.
 - 1.1. A successful copyright “ecosystem” should nurture a diverse range of works. It should encourage creators to make and disseminate new works of authorship and support readers, listeners, viewers, and other users in experiencing those works.
 - 1.2. To accomplish these goals most effectively, copyright law should embody rules that are clear and sensible, yet flexible enough to apply in a changing environment.
2. Copyright law should promote the creation and dissemination of new works in three distinct and complementary ways: by encouraging the provision of capital and organization needed for the creation and dissemination of creative works; by promising creators opportunities to convey their works to their intended audiences; and by limiting control over uses of creative works, as appropriate, to aid education, cultural participation, the creation of new works, and the development of new forms of creative output.
3. Copyright law should facilitate the provision of capital and organization for creative works by providing a set of rights over which parties can reliably transact.
 - 3.1. To further this purpose, copyright law should articulate clear and sensible rules for identifying which works and parts of protected works can be protected by copyright law, in whom copyright ownership initially vests, and which rights the copyright owner enjoys.
 - 3.2. Copyright law should support owners in the exercise of their rights by articulating clear and sensible rules about what constitutes infringement of those rights and by providing clear and appropriate remedies for infringement.
4. Copyright law should give creators opportunities to convey works to their intended audiences by vesting exclusive rights, as an initial matter, in the authors of works and encouraging authors to explore different ways of reaching audiences for the works.

- 4.1. To further this purpose, copyright law should enable the licensing or assignment of some or all of the copyright exclusive rights to intermediaries.
- 4.2. Copyright law should also support owners who choose to reach audiences directly, using either conventional or “open” licensing models.
5. Copyright law should limit control over uses of creative works by setting boundaries on the rights of copyright owners and on remedies for infringement.
 - 5.1. To further this purpose, copyright law should articulate clear and sensible rules about limitations on copyright owners’ power over uses of creative works that correspond to the purposes of the copyright system, and that take into account the reasonable needs and interests of users of copyrighted works, including follow-on creators.
 - 5.2. Copyright law should protect original expression, but should not protect ideas, systems, processes, or facts, regardless of whether they are original.
6. Copyright law should support opportunities for innovation and competition in technologies for disseminating and experiencing creative works; it should also support rights holders’ reasonable interests in effective protection of their rights in the face of technological change.
 - 6.1. Copyright law should recognize that new technologies may create new opportunities to infringe copyrights as well as new opportunities to transact over copyright rights and new opportunities to distribute and use copyrighted works. Some, but not all, of these opportunities should be subject to copyright owners’ control.
 - 6.2. Deciding whether a particular type of use should be within the scope of copyright’s exclusive rights requires balancing the sometimes-competing interests of creators, distributors, consumers, and the public.
7. Copyright law should recognize that the system in which creative activity occurs and in which creative works are circulated is increasingly global.
 - 7.1. The United States should develop its copyright law in a manner that respects the global system in which creative activity occurs.

- 7.2. The United States should seek to ensure that international law leaves room to allow domestic laws to fully comport with these principles.

II. HOW CONSISTENT WITH GOOD COPYRIGHT PRINCIPLES IS U.S. COPYRIGHT LAW TODAY?

U.S. copyright law is fully consistent with some principles set forth in Part I, partly consistent with others, but inconsistent with a few of them. This Part considers U.S. copyright law in light of these principles. Insofar as U.S. copyright law diverges from good copyright principles, this Report suggests some reforms intended to bring U.S. copyright law into better alignment with good copyright principles. Part III sets forth more details about possible reforms.

A. THE SUBJECT MATTER OF COPYRIGHT: ORIGINAL WORKS OF AUTHORSHIP

We applaud the simplicity and elegance of that part of U.S. copyright law that extends copyright protection to authors of newly created works of authorship that have been fixed in a tangible medium of expression. These works must be “original” not only in the sense that they owe their origin to the person claiming to be the author, but also in the sense that they exhibit some creativity in the expression of whatever ideas or information the works embody.

Although some countries extend copyright protection to creations that are not fixed in a tangible medium (for example, live jazz improvisations), we believe that U.S. law’s fixation requirement is consistent with good copyright principles because fixation facilitates achieving the cultural goal of making extant copies of the work available for future generations and because it provides a workable basis for differentiating those works that are the subject of copyright protection and those that are not. It is also consistent with the U.S. Constitution, which identifies the “writings” of authors as the subject matter of copyright.

Original designs of useful articles are not protected by U.S. copyright law.¹ Members of the CPP believe withholding conventional copyright protection from the designs of useful articles insofar as their designs are inextricably interconnected with the functionality of the articles is a sound rule because it promotes robust competition in the market for useful

1. Some countries protect original industrial designs either by copyright law or by a copyright-like design right.

products, such as chairs and kitchen tools. Thus, we support that part of the statute that excludes from copyright pictorial, sculptural, and graphic works that have intrinsic utilitarian functions if the original expression in their designs is not separable from their utilitarian aspects.

B. DURATION OF COPYRIGHT PROTECTION

The U.S. Constitution directs that legal protection for original writings should last only “for limited times.”² This constitutional norm has meant that works of authorship enter the public domain upon expiration of their copyright terms and become available for free uses of all kinds.

Between 1790 and 1978, U.S. copyright law measured the duration of protection in a standard way: the law granted the author an initial term of protection that was renewable if an author (or other relevant rights holder) took the simple step of renewing his or her claim of copyright for an additional term. The 1790 Act granted authors fourteen years of protection, which could be renewed, if the author was alive and wished to do so, for another fourteen years. By the twentieth century, this duration had doubled, making a twenty-eight-year initial term plus a twenty-eight-year renewal term the statutory duration through three-quarters of that century.

Several societal benefits accrued from this model for copyright duration. Authors enjoyed a substantial period of protection against market-harmful appropriations of their works, a situation that enabled them, if their works proved to be commercially successful, to recoup the costs of creation and to support continued production of creative works. It was also relatively easy to determine whether a work was in-copyright by looking at the date of publication and doing a little math, or by checking Copyright Office records as to whether the copyright was renewed. Yet, there was sometimes confusion and ambiguity about when, whether, or where a particular work was “published,” which complicated the calculation of term under the old U.S. system.

In 1976, Congress adopted a life-of-the-author-plus-fifty-years model for measuring copyright duration for works by identified individual authors, and a term-of-years model (seventy-five years from first publication or one hundred years from first creation, whichever expires first) for anonymous, pseudonymous, and corporate-authored works. This change in U.S. copyright duration had at least two benefits: first, it brought U.S. law into conformity with the international standard established in the Berne Convention for the Protection of Artistic and Literary Works, and second, it

2. U.S. CONST. art. I, § 8, cl. 8.

gave creators greater assurance that they could receive many years of rewards from their creative labors. In 1998, copyright terms were extended an additional twenty years.³

While we understand some reasons why copyright terms have become so long and recognize that some CPP members believe longer terms to be justified, most CPP members believe that the duration of copyright nowadays is longer than is needed to achieve the normative goals of a good copyright regime, and indeed, that the overlong duration of copyright is impeding some important goals of the copyright regime. The switch to a life-plus-years model and the twenty-year extension have contributed, for example, to a growing societal problem; namely, those wishing to license older works often cannot locate the rights holders even after a reasonably diligent search (often referred to as the “orphan works” problem). This problem inhibits appropriate reuses of older works that may be important to preserve as part of our cultural heritage.

We were not able to reach consensus on shortening the copyright term or restoring the “initial term of years plus renewal term of years” model for measuring duration, as some of us would prefer. We could, however, reach consensus on some duration-related issues. To mitigate one of the social harms arising from the lengthened term of copyrights, we suggest in Part III some new incentives for registering copyrighted works, which would make it easier than it is today to locate rights holders for licensing purposes. We also support legislation to allow uses of “orphan works,” that is, works that are still in copyright, but whose rights holders cannot reasonably be identified or located in order to obtain permission to make use of the works. A third measure that would help mitigate the social costs of lengthened copyright durations would be to adopt an easy procedure for authors to dedicate their works to the public domain. Part III sets forth some reform proposals as to registration incentives, orphan works, and public domain dedication to make duration-related rules more consistent with good copyright principles.

C. FORMALITIES: NOTICE, REGISTRATION, AND DEPOSIT

Authors today are under no obligation to give notice to the world about their claims of copyright, either by placing notices on individual copies of their works or by registering their claims of copyright with a government office. This rule has some beneficial effects because the law should not erect unreasonable hurdles to obtaining copyright protection. Nor should rights be entirely forfeited, as in the past, if a work’s authors or other rights holders or

3. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified in scattered sections of 17 U.S.C.).

licensees failed to comply with some fine detail of notice or registration requirements.

However, inadequacies in notice about copyright claims and reduced incentives to register copyright claims have contributed to substantial difficulties in tracking down who owns which rights in which works. These difficulties impede many socially desirable uses, including some that would be licensed if it were easier to find the appropriate rights holder.

The current law's relative indifference to notice and registration contrasts sharply with the two hundred-year U.S. tradition of requiring authors to give public notice of their claims of copyright and to register those claims and deposit copies of their works with a centralized government office, such as today's U.S. Copyright Office. For many years, copyright notices (such as the familiar "©" symbol, name of author, and year of publication notice typically found in books) were required to appear in prominent places on published copies of protected works. Authors who were motivated by copyright incentives could easily "opt-in" to the copyright system by complying with these rules. The fact that many creators continue to employ some form of copyright notice despite its optional nature indicates that it is important to authors and owners to give practical signals to the world about their claims of ownership.

Registration and notice made it relatively simple for persons who were interested in licensing certain uses of protected works to check the central registry for contact information about the copyright owner. Works that were created with no expectation of or need for copyright protection would, under a notice-based regime, generally be outside of the copyright system.

The move to an automatic protection regime puts current law in tension with the principle that there should be reasonable ways for the public to get information about who owns which rights in which works and whether works are or are not available for use or are in the public domain. Many documents and other works that do not really need copyright protection have it anyway, which blocks some of these works from being creatively reused or distributed freely because of risks of copyright lawsuits.

Despite the existence of some incentives to register copyright claims with the Copyright Office, relatively few authors actually do so, which means that the public does not have access to useful information about who the owners are and how to track them down to seek permission. Part III discusses some ideas about how U.S. copyright law might reinvigorate registration, notice, and similar opt-in features to U.S. copyright law to make it more compatible with good copyright principles. Advances in technology and networks should be harnessed to facilitate better notice and registration practices and policies.

This change would help to create more clear and simple boundaries for copyright that are easily understood by owners and users alike.

Current copyright law continues the long U.S. tradition of requiring rights holders to deposit copies of protected works with a government office. Much of the massive collection of the Library of Congress consists of books and other works submitted to the U.S. Copyright Office in compliance with copyright registration and deposit rules. Deposit requirements are consistent with the preservation of cultural heritage and with copyright's constitutional copyright purpose to "promote the progress of science," by which the Founders meant knowledge.

Yet, because few works are registered with the Copyright Office these days, relatively few copies are actually deposited with the Office. Although the Librarian of Congress has authority to demand deposit copies, he does not routinely do so. If deposit continues to serve important public purposes—and we think it may—then implementing changes to the law that will induce greater compliance with this requirement needs to be given serious consideration. Also, serious thought should be given to updating and modifying deposit requirements to accommodate the digital age and deposits of works that were "born digital."

D. GRANTS OF EXCLUSIVE RIGHTS

Ownership of copyright in a work means that the law has conferred on the work's author a set of rights to control exploitations of the expression in the work. When the subject matter of copyright was restricted to books, maps, and charts, as it was in the eighteenth century, the law gave authors exclusive rights to control the printing, reprinting, and selling of their books, maps, and charts. By the late twentieth century, the subject matter of copyright had expanded to encompass many types of artistic and literary works, including photographs, motion pictures, sound recordings, and computer programs. As modes of commercialization and technological means of exploitation of works expanded, so did the rights granted to authors, often tailored to the primary marketplaces appropriate for the works.

U.S. law now grants authors rights to control the reproduction of their works in copies, the making of derivative works (e.g., a movie version of a novel), distribution of copies to the public, and (in most cases) public performance and public display of protected works. These rights are said to be "exclusive" because they allow the author, or a person or firm authorized by the author, to exclude (that is, stop or prevent) unlicensed persons from doing things that fall within the granted right. The exclusive rights also provide authors with power to bargain with firms that want to exploit their

works by performing a song at a concert, making a motion picture of a novel, or reproducing a photograph in a magazine.

Members of the CPP deliberated at considerable length about the exclusive rights provisions of current U.S. copyright law. We have concluded that it may be desirable to refine these rights. For reasons explained in Part III, we believe that the reproduction and derivative work rights, as now embodied in U.S. law, are insufficiently well-defined. The reproduction right has become particularly problematic insofar as it is susceptible to an interpretation that would give rights holders control over every access to and use of copyrighted works in digital form because of copies automatically made during access and use (e.g., RAM copies). Congress did not anticipate in 1976 the digital networked environment in which we now live, nor did it craft the reproduction right with this environment in mind. Part III discusses a recommendation that copyright owners be required to prove commercial harm when they make claims of infringement other than those involving exact or near-exact copies that operate in the same market as the allegedly infringed work. We offer some suggestions about other possible refinements of exclusive rights in Part III.

While our main concerns are with the reproduction and derivative work rights, some refinement would also be desirable as to the distribution and public performance rights so they are more coherent and consistent with international practice. In particular, we suggest that cable and satellite retransmissions, along with digital transmissions via the Internet, should probably fall within a right of communication to the public, as is common in other jurisdictions, rather than being treated, as they sometimes are today, as performances or distributions, or both. We also note that U.S. law is unique in having a public display right, and the boundaries of this right are quite uncertain. We are unsure whether it is serving a useful purpose in U.S. copyright law, but to the extent that it is, that purpose might better be achieved through a right of communication to the public, as in other countries.

Finally, one category of exclusive rights that U.S. copyright law does not currently protect is the “moral rights” of authors. The two most widely accepted of these rights outside the U.S. are the right of attribution (chiefly, to be identified as the author of a work one has created) and the right of integrity (chiefly, the right to prevent destruction, mutilation, or similar harms to the work). At present, only authors of works of visual art—a term that is narrowly defined—qualify for the rights of attribution and integrity. Because attribution has become a more accepted social norm in the U.S. in recent years, we recommend that Congress give serious consideration to granting authors a right of attribution. This would better align U.S. law with

norms prevalent in many authorial communities and many other countries. Yet, we recognize that it may be complicated to reach agreement on the scope of this moral right and define it with exactitude in the statute. A reasonableness limitation on the attribution right should, as in other nations, avert most problems that some U.S. commentators have predicted would occur if the U.S. adopted an attribution right. Even without congressional action, there is, we believe, some leeway for courts to take attribution interests into account in infringement cases.

We recognize that redefining exclusive rights to address our concerns will not be easy to accomplish, and we could not reach consensus about exactly how to redraw the boundaries of the rights. Redefinition of rights could introduce new areas of ambiguity and complexity to copyright law and undermine the overarching principle of making copyright law clearer and more sensible. We nevertheless believe that it is desirable to start a conversation about the exclusive rights provisions of U.S. copyright law and to consider possible refinements.

E. AUTHORIAL OWNERSHIP AND RIGHTS TO LICENSE AND SELL
COPYRIGHT INTERESTS

Copyright law grants rights initially to authors and allows them considerable freedom to contract with others to exploit their works. Authors often take advantage of this freedom because they lack the expertise, equipment, and capital to commercialize their works successfully. The exclusive rights that copyright law confers on authors enable them to license or sell their rights to those who do have the appropriate expertise, equipment, and capital.

Authors can assign (that is, sell) their copyrights outright to others. They can also license (that is, authorize) many exploitations of their works. Such licenses may be exclusive (e.g., I will allow only this company to sell copies of my work) or non-exclusive (e.g., I will license public performance of my music to anyone who wants to play it at a club or for television broadcast). Non-exclusive licenses can be express (e.g., by written or oral agreement) or implied from the dealings of the parties. If, for instance, one author makes a video that he knows another author intends to use in a television news program, the first author must have intended to license the use, even if there is no written contract saying so, and so, a license can be implied from the circumstances. Authors often negotiate up-front fees for licensing of their works; they may also negotiate for a royalty stream to be paid over a period of years. If a work has more than one author, any one author can license an exploitation of the work, subject to a duty to account to her co-authors for

their shares of the compensation. These freedoms of authors to license or sell their rights are consistent with principles of good copyright law.

Also consistent with the principles, however, are some limits aimed at protecting authors. Out of concern that authors should not lose control over exploitations of their works unless there is evidence that they really meant to relinquish this control, U.S. copyright law requires that copyright assignments and exclusive licenses be in writing and signed by the author whose rights are being transferred.

U.S. law also protects independent contractors, such as freelance writers and graphic artists, from having their works be deemed works made for hire, under which the party commissioning the work would be considered the “author” of the work and the owner of copyright. We think these rules, too, are consistent with good copyright principles.

We have no quarrel with the rule that grants employers copyrights in works prepared by an employee within the scope of employment, nor with identifying certain categories of specially commissioned works that can qualify for treatment as works made for hire if contracts so specify. Part III considers whether additional categories of works should be eligible for specially commissioned work for hire status.

The copyright transfer rules about which we have the gravest reservations are those that currently allow individual authors or their heirs to terminate transfers, including exclusive and non-exclusive licenses and assignments, after a certain number of years. Most, but not all, of us believe that the policy underlying the termination of transfer rules is well intentioned: to allow authors who might have licensed or assigned their rights for a pittance in an early stage of their careers to reclaim their copyrights and license the rights anew in order to capture a larger share of whatever commercial value the works still have. Part III explains why we think the termination of transfer rules are too complicated and formalistic to achieve the desired objective of allowing authors to have new opportunities to control uses of their works. It goes on to suggest how such rules might be reformed.

F. COPYRIGHT LAW PROTECTS EXPRESSION, NOT FACTS, IDEAS, OR FUNCTIONS

Copyright law protects the way that authors have expressed themselves in their works but not the ideas, facts, or functional designs depicted therein. Ideas and facts, once made public, are in the public domain and free for everyone’s use. Functional designs depicted in publicly available copyrighted works may also be freely reused unless the designs have been patented.

The expression protected by copyright law certainly includes the exact words an author uses in her text, the notes of her song, the lines she draws, and the way in which she arranges data in a compilation. In the early years of modern copyright law, only exact or near-exact copying of the whole of a copyrighted work, which would obviously undermine the primary market for authorized copies of the author's work, was deemed an infringement of copyright.

Over time, courts decided that those who made only minor changes (such as slight rewordings or paraphrasing in a text or use of different colors in a painting) should be treated as infringers as well. As proximate markets evolved—such as the markets for motion picture versions of short stories, translations of texts from one language to another, and rearrangements of music—the conception of “expression” expanded. Some of us believe this concept has become too amorphous and that follow-on creations are too often deterred because the scope of copyright protection, tied to the concept of “expression,” is so uncertain.

Copyright case law is also confusing and sometimes incoherent because courts use several different tests for determining when an accused work is similar enough to a copyrighted work to constitute infringement. Some frameworks for infringement analysis focus on analytic dissection of similarities and differences between the works at issue, while others rely heavily on lay observer impressions. Nor is the case law clear about the roles that experts can and cannot play in the assessment of infringement claims.

In Part III, we offer suggestions about how courts could develop better and more consistent tests for infringement and for distinguishing between protectable expression and unprotectable elements in copyrighted works, such as ideas, information, and functional designs.

Part III also offers some refinements to copyright preemption rules to ensure that important purposes of U.S. copyright law will not be frustrated by application of state law rules in a manner that would confer copyright-like protection on works of authorship.

While there was consensus that it was worthwhile to consider reforms in these areas, there was not consensus about whether refinements are really necessary and whether reforms would do more good than harm, particularly in the area of revising preemption rules.

G. FAIR USE AND OTHER LIMITS ON COPYRIGHT PROTECTION

Fair use is an important limiting principle of U.S. copyright law. This doctrine grew out of judicial recognition that if copyright rules are applied too strictly, they would thwart rather than promote the ongoing progress of knowledge creation and dissemination, contrary to the constitutional purpose

of copyright. In the context of critical commentary on an earlier work, for instance, it is often reasonable and sometimes necessary to quote from a pre-existing work to criticize or explain it effectively.

Current copyright law states that making fair use of a copyrighted work is not an infringement. The statute identifies certain uses, such as criticism, commentary, news reporting, research, scholarship, and teaching, as exemplary purposes that may be fair. It sets forth four factors that courts should take into account in particular cases when considering whether a use is fair or unfair: the purpose of the defendant's use, the nature of the copyrighted work, the amount and substantiality of the taking, and the likelihood that the use will harm the market for the copyrighted work if the use is deemed fair. All factors must be balanced together, and no one factor is dispositive. Congress did not mean for these factors to be exhaustive. Courts may and do apply fair use as an equitable rule of reason. The Supreme Court has pointed to the fair use doctrine, as well as to the idea/expression distinction, as elements of copyright law that contribute to that law's consistency with First Amendment protections of freedom of speech and freedom of expression.⁴

We believe that the fair use doctrine is generally consistent with the copyright principles set forth in Part I, although some fine-tuning of fair use may be warranted to ensure that courts recognize that fair use serves a broader array of policy purposes than the current provision acknowledges. Part III also addresses whether personal use copying of copyrighted works should be regulated by the fair use doctrine or exempted more explicitly from the scope of copyright, as it is in some other countries.

Current U.S. copyright law also contains numerous other exceptions and limitations on copyright's scope. The first sale rule, for example, generally allows those who buy a copy of a copyrighted work to resell, lend, rent, give away, and even destroy that copy. This rule enables used bookstores, archives, libraries, video rental stores, and other entities to redistribute copies of protected works. A complex set of rules also regulates uses of copyrighted materials by libraries. These rules are consistent with the principles of a good copyright law, although as we explain in Part III, we think the library exception provisions need to be updated to make them better attuned to the current technological environment and to other changes in norms and practices since the mid-1970s.

Still other copyright exceptions allow teachers and their pupils, in the course of non-profit classroom activity, to recite copyrighted poems, to show

4. *See, e.g., Eldred v. Ashcroft*, 537 U.S. 186, 219–20 (2003).

pictures of copyrighted images to study them, and to perform copyrighted dramatic plays. Public broadcasters have the right to make certain uses of copyrighted materials beyond what fair use might allow, in order to promote broader public access to information and culture. Limits on copyright's reach that promote similar public policies are found in many national copyright laws and are consistent with the principles set forth in Part I.

We finish this section with a separate and important observation. It seems obvious to us that the existing set of exceptions and limitations in today's U.S. copyright statute is more a product of legislative compromise than of principled assessment of how far the law should extend to regulate certain kinds of uses of copyrighted materials. Part III speculates about institutional design principles that might aid in the accomplishment of a more principled approach to limiting principles of copyright law.

H. COPYRIGHT AND TECHNOLOGY

Copyright law has been seriously challenged by the rise of digital technology, and in particular by the advent and explosive growth of global digital networks. In the past, it was only possible to engage in widespread, unauthorized copying and distribution of copyrighted works if one had made commercial-scale capital investments (e.g., buying a printing press and housing it in a building). It is by now well recognized that ordinary users of computer networks, with little or no investment or even significant effort, can accomplish widespread, unauthorized copying and distribution. Unauthorized activities such as peer-to-peer file-sharing of copyrighted works are understandably viewed as a serious threat to the financial incentives that the copyright system is designed to give to professional authors as well as to those who invest in the creation and publication of their works.

Yet, advances in digital technologies have also contributed greatly to the achievement of copyright's core goal of stimulating the creation and dissemination of new works, such as user-generated content. Millions of network users now have access to tools that allow them to produce and publish their own creations and share them with others. Advances in digital technologies have also enabled copyright industries to introduce new formats for distributing creative works. A good copyright law must consider both the benefits and the problems resulting from digital networks.

Since new technology is a significant contributor to the infringement problem, many copyright owners have responded with technological solutions. Widely discussed and increasingly deployed technical approaches include the use of encryption and other technical measures, designed to limit unauthorized access and copying, and the adoption of filtering technologies

by service providers, designed to limit unauthorized distribution or performance of protected works. Many copyright owners believe that such technological solutions are essential—or at least must be tried—if widespread infringement of complete works is to be meaningfully prevented or reduced. They also believe that the legal system should prohibit circumvention of technological protection measures and dissemination of circumvention tools, and should encourage the design and deployment of infringement-inhibiting measures by those in a position to do so.

While recognizing the significant threat posed by widespread infringement, many representatives of the consumer electronics and information technology industries, as well as members of academic and user communities, have expressed concerns about these technological solutions. One concern is that innovation will be hampered if technology producers must design products and systems that contain or respond to copyright protection technology. Another is that measures such as filtering will prevent not only infringing activity, but also a large amount of user activity that is lawful, such as fair uses, or to which copyright owners do not or cannot legitimately object. There are also questions about who should properly bear the costs and burdens of deploying and maintaining such solutions and about the societal costs of creating or maintaining a legal regime that, by the threat of serious monetary liability, in some cases inhibits technological innovation and the creative and lawful activity of users. Yet, many in the consumer electronics, computer, and service industries have contributed to the development of innovative technical measures and participated in the introduction of new products and services thereby enabled.

We believe that in this, as in other circumstances, a good copyright law must strike a balance between protecting authors and other copyright owners from infringement, on the one hand, and encouraging innovation, creative expression and public access to works, on the other. Technological protection measures can play a role in preventing infringement, and in encouraging new forms of commercial distribution. Experimentation with such measures has a place in the copyright system, as do reasonably designed legal principles that prevent circumventing them. Serious efforts need to be made to design and deploy measures that are both commercially reasonable and “smart,” measures that interfere as little as possible with other types of innovation and with lawful activity. The results should be evaluated in an ongoing fashion, and copyright law may well have to be adjusted from time to time—by Congress through statutory amendments or by the courts in individual cases—to get the balance right.

If properly limited in scope, principles of primary and secondary liability should continue to play a role in encouraging technology and service

providers to participate in deploying reasonable measures and discouraging widespread infringement. We believe that “safe harbors” are an important legal device that can be used both to limit liability in appropriate ways and to encourage those providers to help reduce widespread infringement.

U.S. copyright law currently recognizes at least five safe harbors for firms that facilitate, even if not intentionally so, the infringing acts of others. The first and perhaps best known of these safe harbors is for makers of technologies that have substantial non-infringing uses. The Supreme Court created this safe harbor in the *Sony Betamax* case.⁵ There is, however, some uncertainty in the scope of this safe harbor because of disagreements over how “substantial” non-infringing uses must be, as well as over which uses are, in fact, non-infringing.

Four other safe harbors were created for Internet service providers (ISPs) in 1998 as part of the Digital Millennium Copyright Act (DMCA).⁶ These safe harbors allow ISPs (1) to transmit digital content from one user to another free from concern about whether the transmitted material is or is not infringing, (2) to store digital content on behalf of customers, (3) to cache digital content to make it more accessible to customers, and (4) to facilitate users’ queries to locate information of interest to them. The latter three safe harbors are subject to “notice and take down” rules, which provide that upon receiving notice from a copyright owner that specific infringing materials exist on the ISP’s site or a search engine is linking to infringing materials, the ISP or search engine has an obligation, as a condition of the safe harbor protection, to remove the infringing materials or not link to them. These safe harbors are also contingent on ISPs having rules to prevent abuse by restricting access to the Internet by repeat infringers. We believe that the safe harbor rules in copyright law today, while not perfect, are nonetheless generally consistent with the good copyright principles set forth in Part I.

We suggest in Part III that Congress consider creating a new safe harbor that would insulate from copyright liability those firms that undertake reasonable measures to prevent copyright infringement. We do not, as a group, intend for this safe harbor to create a duty on the part of technology developers or service providers to adopt such measures.

I. REMEDIES WHEN INFRINGEMENT OCCURS

It is a fundamental legal norm that when the law confers a right and that right is violated, the owner of the right is entitled to a remedy. Copyright law

5. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

6. Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified in scattered sections of 17 U.S.C.).

gives judges the power to order an infringer to cease the infringing conduct. It also allows rights holders to be compensated for the losses they suffered because of the infringement, such as a lost license fee or lost profits on sales that they would have made but for the infringement. A successful plaintiff can disgorge from an infringer any profits it made that are attributable to the infringement. This extra monetary remedy is aimed at deterring infringement. Without such a rule, people might be tempted to infringe thinking that if their unauthorized exploitation is detected, they will only have to pay the price of a lost license fee for the infringing activity, that is, the same price they would have had to pay if they had sought permission in advance.

An infringer may also have to pay the costs of the lawsuit, including the plaintiff's attorney fees. To deter overzealous copyright claims, courts also allow defendants to recover attorney fees from plaintiffs when their defenses to infringement are successful. Courts can also order infringing copies to be seized and destroyed. We regard these remedies as generally consistent with the good copyright principles set forth in Part I.

However, some aspects of the current law's remedial scheme are in some respects inconsistent with good copyright principles. Current law allows copyright owners who have promptly registered their claims of copyright to elect, at any time until final judgment, to recover what are known as "statutory damages," in any amount between \$750 and \$150,000 per infringed work that the court deems "just," as an alternative to the actual damages plus defendant's profits remedies. While statutory damages may be an important remedial mechanism for providing some compensation to copyright owners when damages are difficult to prove and deterring infringement, we are troubled that statutory damage awards sometimes appear arbitrary or grossly excessive in comparison with a realistic assessment of actual damages incurred. We recommend in Part III some changes to address the defects of the current statutory damages regime. This could be accomplished either by adopting guidelines to make statutory damages more consistent and equitable or by replacing statutory damages with a regime in which actual damages might be doubled or trebled to deter or punish egregious infringements.

A second remedial reform recommended in Part III is greater use of damage awards instead of injunctive relief in copyright cases, in line with Supreme Court precedents.⁷

7. *See, e.g.*, *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 n.10 (1994) (noting that the purposes of copyright may better be served in some cases by awards of damages instead of injunctive relief).

A third remedial reform discussed in Part III concerns the presumption of irreparable harm in copyright cases, either at the preliminary or permanent injunction stage, upon a finding of a likelihood of success on the merits or actual success on the merits. As the Supreme Court made clear in *eBay Inc. v. MercExchange, L.L.C.*, injunctions in intellectual property cases should only issue in accordance with traditional principles of equity.⁸

A fourth remedial reform addressed in Part III responds to problems arising when high costs of litigation make it effectively impossible to justify vindicating one's rights in court, as when the actual monetary harm suffered is small relative to the costs of litigation. Part III considers whether Congress should establish a low-cost adjudication procedure to allow copyright disputes to be resolved without the need for highly expensive federal court litigation.

III. COPYRIGHT REFORM PROPOSALS

Twenty-five reform proposals are set forth in this section of the CPP Report. The four most ambitious are these: First, we recommend a substantial reinvigoration of copyright registration so that it becomes easier to know who owns what rights in which works, which would also facilitate reuses and licensing. Second, we recommend some changes in the role of the Copyright Office to modernize its functions and to take on some new roles that we think would be beneficial. Third, we recommend some refinements to the exclusive rights that copyright law grants to authors and to the tests courts use for judging infringement. Fourth, we recommend a new safe harbor for those who undertake reasonable measures to inhibit copyright infringement.

Other possible reforms discussed in this section pertain to a wide array of other copyright matters, such as attribution interests of authors, fair use and library privileges, the public domain, orphan works, statutory damages, and injunctive relief.⁹ In some cases, we were able to reach consensus on proposed reforms, while in other cases, we set forth various views that informed our deliberations and reasons for not achieving consensus. As noted in the Preamble, various proposals elicited enough support within the CPP group that it was deemed constructive to style them in this Report as recommendations. However, we do not intend affirmative statements or the

8. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391–94 (2006).

9. The copyright reforms considered in Part III do not, of course, exhaust the list of issues about which some reform proposals should be considered.

use of phrases such as “we recommend” to suggest that the group as a whole was uniformly in support of each particular view stated.

A. REINVIGORATING COPYRIGHT REGISTRATION

Recommendation #1: Copyright law should encourage copyright owners to register their works so that better information will be available as to who claims copyright ownership in which works.

Copyright law in the United States has long included a system of procedural mechanisms, often referred to collectively as “copyright formalities,” that helped to maintain copyright’s traditional balance between providing private incentives to authors and preserving a robust stock of public domain works from which future creators could draw. These formalities included requirements to give notice of one’s copyright claim by placing copyright notices on copies of protected works and registering with the U.S. Copyright Office to qualify for a renewal term.

Under current law, copyright protection arises the moment a creative work is fixed in a tangible medium of expression. Authors are under no obligation to register their interest in copyright or put notices on copies distributed in the marketplace. Although current law attempts to induce registration by conditioning the ability to recover attorney’s fees and statutory damages on prompt registration, relatively few copyright owners register their works at all, let alone within three months of publication.¹⁰

This “deformalization” of U.S. copyright law has obviously had some advantages for authors and those who exploit copyrighted works, for there is no longer a risk that failure to put notices on copies of works or to register claims of copyright will cause the work to go into the public domain. However, deformalization has also harmed creators, follow-on users, and social welfare more generally because it is more difficult than it should be to determine who owns what rights in which works and how to locate the rights holders to ask permission for uses. Deformalization inhibits reuses of many works because there is no simple way to distinguish between those works whose authors care about copyright protection and those who do not.

The vast majority of copyrighted works created each year have little or no commercial value. Billions of works, such as e-mails and business memos, are created without the incentive of copyright and lack independent commercial value as expressive works. Many other works that people create, such as blog posts, are subject to copyright, although their authors intend to distribute

10. See, e.g., Christopher Sprigman, *Reform(aliz)ing Copyright Law*, 57 STAN. L. REV. 485, 495–96 (2004).

them without restraint or with fewer restraints than the default rules of copyright impose. Many works are created with the intent to exploit their commercial value as expression, but lack that value at inception or perhaps enjoy evanescent commercial value that endures for a much shorter period than the current copyright term.

These types of works are similar in one important respect. They are not producing revenues. For this reason, continued copyright protection serves no real economic interest of the author. Copyright does not, of itself, create commercial demand for protected works. In a deformalized, opt-out copyright system, commercially “dead” works cannot safely be reused as building blocks for potentially valuable new works. The costs of locating the rights holder and obtaining permission will often be prohibitively expensive. In such instances copyright is unbalanced: its potential benefits are absent or depleted, and it therefore imposes only social costs.

To respond to the overly expansive copyright regime now in place, there emerged strong interest within the CPP group for “reformatizing” copyright law. Copyright law should not just re-introduce the formalities from the past. However, a more robust registration system would be desirable. Non-compliance with this registration procedure would not, as in the past, consign a work into the public domain. Instead, it would affect the rights and/or remedies available to the rights holder, so as to reduce certain liability risks for reusing unregistered works. The law presently does this in part by making the availability of statutory damages and attorney fee awards dependent on prompt registration, but this inducement to registration has not sufficed.

We believe that a reinvigorated registry regime would comply with U.S. obligations under the Berne Convention and the subsequent Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), which incorporates by reference many of Berne’s provisions.

The core idea is to make copyright registration an attractive and easy option for copyright owners so that members of the public can have better information about the works currently protected by copyright and about those works’ respective owners. This idea can be implemented by restructuring the availability of certain rights and remedies depending on the rights holders’ registration of the work with a registry service. Advances in information technologies and networks will, we believe, substantially assist copyright owners in complying with an updated registration system. We describe some of these advances and how they might be used to construct a more effective and user-friendly registration system in Section III.B in connection with our discussion of the administrative reforms to the U.S. Copyright Office.

As explained further in Section III.B, we do not envision that the Office itself would retain all registration responsibilities; instead, we envision a series of registries that would meet the needs of particular authorial communities and industry participants and that could compete for business from copyright owners, as has occurred with the domain name registration system. Creative Commons, for instance, could become a registry for authors of works who prefer to allow wider uses of their works, but want control over commercial distributions of them. The Office would take on new responsibilities to set standards for registries, which should include requirements for interoperability of key registration data.

This new registration system would provide meaningful incentives to register works that authors or other rights holders expect to have commercial value, ease user access to registered works, and reduce the consequences of infringement for unregistered works. A subgroup of the CPP developed some possible implementations of a new copyright registration regime that would distinguish between rights and remedies available to registered and unregistered copyright owners. Owing to constraints of time, among other things, we were not able to articulate all details of this new regime, but we offer here a few suggestions about how it would work and why it would be beneficial.

The class of unregistered works would obviously include both works that already exist and works that will be created after the new registration regime is adopted. There should be a grace period to allow owners of existing works for whom copyright incentives are important to register under the new regime to enjoy the benefits it would provide. Authors of newly created works would similarly be encouraged to register works if they expect the works to have commercial value and they created the works with copyright incentives in mind.

Unregistered works would still be protected by copyright law against exact or near-exact copying that would cause commercial harm, but fair uses might well be broader as to such works. Moreover, certain remedies, such as statutory damages and attorney fees, would not be available if unregistered works were infringed. Millions of works, such as blogs, YouTube videos, fan fiction tales, Flickr photos, and Twitter streams, if unregistered, would be fair game for follow-on creators and archivists to reuse in non-commercial ways without fear of copyright damage awards because of the inference that non-registration would create.

Registration, by contrast, would signal to the world that copyright incentives are important to the owner of rights in a particular work and would help potential reusers and follow-on creators to locate the person who owns the rights and possibly the conditions under which licenses might be

available. Because we envision that registries would be obliged to make registration data available through an interoperable networked system, it should be possible for potential reusers to find rights holders more easily.

Benefits of registration would mainly flow from the greater accessibility of copyright ownership information but would also potentially include a more extensive set of rights and remedies. Termination of transfer rights could, for example, be granted to registered rights holders but not unregistered ones. One could also allow infringement to be found for copying of non-literal elements of registered works but not for such copying as to unregistered works. Registered rights holders might also be able to sue to stop certain non-commercial exploitations of a work likely to have market-impairing effects. Authors who initially did not register their works could do so later, but they would only enjoy the extra rights and remedies arising from registration as to future reusers.

Owners of rights should also be obliged to inform the registry about updated information, such as assignments of copyright or the death of the author and the identity of the author's successor in interest, so that the registry has current information. Failure to provide this sort of updated information could result in a loss of registration benefits.

A more effective registry system would tailor copyright to provide more appropriate protections in a wide range of circumstances. It would do so by identifying those rights holders who place significant value on their works and who wish to obtain the widest range of protections; it would ease the identification of rights holders; it would encourage voluntary transactions; and it would reduce the penalties for infringement of, and thereby ease access to, unregistered works (i.e., works which, on the whole, owners do not value highly enough to invest in registration). For this large class of works, the copyright system can permit wider public access and use without harming author interests. Limiting the scope of rights and/or remedies available to those rights holders who do not register their works encourages rights holders to identify themselves, thereby facilitating licensing by those who wish to make use of a work.

Lest this proposal seem unduly radical, we wish to point out that it is, in many ways, a logical extension of the private registry regimes that already exist, such as ASCAP, BMI, and the Copyright Clearance Center, which have taken on increased importance in the years since the removal of copyright's formalities. The new registry regime we envision would allow for private registries to exist for particular communities of copyright owners, and ideally, public and private registries would be able and have incentives to share information about registered works, thereby increasing the social value of all of the registries.

Registration regimes are, moreover, common in many areas. Compliance with the domain name registration system, for instance, is necessary to obtain a website address, and many thousands of ordinary people have been able to take advantage of this registration system without undue difficulty. Similarly, it is common to require registration of cars, professional licenses, and real property interests, just to name a few.

Authors and other owners of copyright interests should have the ability to comply without undue difficulties as long as the registration system is carefully designed and incentives exist to steer them toward registration when that suits their interests and needs. The new registration regime would need to be carefully designed so that it did not inadvertently lead to abuses, such as enabling conflicting claimants to register the same work with different registries or burdening copyright owners with multiple registry requirements. It is a risk of establishing a reinvented registration regime in the U.S. that some other nations might be induced to adopt registries in a manner that would disadvantage U.S. copyright owners. Attention must be paid to the practical details as to how this new registry regime would work internationally.

B. ADMINISTRATIVE REFORMS

The U.S. Copyright Office has played a critical role in the development and administration of copyright law for over a century. Its current functions include, among other things: operating a voluntary registration system for copyright claimants; administering statutory licenses; promulgating regulations and conducting rulemakings; providing the public with information about copyright; and engaging in policymaking and providing advice to Congress and the other branches on international and domestic copyright matters.

The Office has generally executed these functions admirably. However, the landscape around copyright law has changed dramatically in the past two decades, primarily owing to the rapid development and dissemination of technology that allows copyrighted works to be copied and distributed quite easily. As a consequence, nearly every copyright-related industry sector is in the midst of profound changes that affect all actors in those copyright ecosystems—authors, publishers, distributors, users, and consumers, among others. Many of these actors rely on the Copyright Office for various services and information. It should not come as a surprise that the rapid changes happening in the copyright world might require change to how and what the Copyright Office does.

It is in that spirit that we offer the following ideas for modernizing the role and functions of the Copyright Office. The overarching purpose of

these suggestions is to help ensure that the Office is in the best position to accommodate the rapid pace of change and thereby continue to serve its important role in the future. These suggestions are neither comprehensive nor definitive—they are primarily designed to surface important points of discussion and debate that ideally will lead to a more robust, concrete, and specific set of recommendations that would be supported by all stakeholders in a well-functioning Copyright Office.

Recommendation #2: The Copyright Office should transition away from being the sole registry for copyrighted works and toward certifying the operation of registries operated by third parties, both public and private.

This is perhaps the most radical of our proposals, but also the most important. The reality of the digital age is that it has greatly increased expectations about access to information. The information that the Office currently collects and administers as part of the registration system is the kind that everyone expects to be accessible through something like a simple web search. More importantly, transactions involving copyrighted works often take place in the same hyper-efficient environment, and the parties to those transactions require access to copyright information at a speed and in a format that matches that efficiency.

While the Office has observed and anticipated these developments and has moved many of its functions and services online, the reality is that the functionality of the registry remains woefully behind what leading-edge search and database technologies permit. As a consequence, the creators and users of copyrighted works have had to develop their own systems to generate and disseminate copyright information that is relevant to their activities. These databases often supplant the information in the Copyright Office registration records. For example, information about who is currently able to license the copyright in a particular photograph is much more accessible in commercial databases operated by Corbis and Getty than in the records of the Copyright Office. Similarly, Creative Commons has developed an efficient means for copyright owners to provide more information to users about what uses are permitted for their works, information that is valuable to users but that the Copyright Office registration system as it currently operates does not facilitate.

The basic idea of any reform in this area would be to shift the Copyright Office away from day-to-day operation of the copyright registry and toward a role of setting standards for and superintending a system of separate but networked and interoperable private registries.

The first step would be to authorize the Copyright Office to set standards for acceptable private registries—i.e., both technical standards and also specifications determining what kinds of copyright information a compliant registry *must* and *may* ask for from users and place into its database. The Office would need to be empowered to make sure any private registry meets important public interest requirements regarding transparency and efficient searches through multiple services, so as to minimize burdens on both copyright owners and users on accessing the data and benefits of these services. Once these standards are established, the Copyright Office would accept applications from firms seeking to operate as private registries and would certify that private registries (of many different types) meet and continue to adhere to the registry standards.

The end result, if this task is done properly, would be an environment in which private firms compete to obtain copyright registration information from rights holders. Competition should lead to lower costs and innovations in registry design. And if the registries operate according to compatible technical standards, user searches for copyright information will be able to draw upon the data stored in all of the networked private registries. The result would be a system that is in reality decentralized but that is architected and managed to provide a “search once, search everywhere” experience to users. The model is similar to the domain name registration system, where multiple private parties provide services and access to the database of domain names.

There are many potential benefits to this reform, for both owners and users. For owners, this new approach acknowledges that they often already use registration-like systems in their business dealings, whether through collecting societies, online services, or other means of tracking their copyrights. These existing systems could become part of the network of registries, allowing owners to participate in registration systems that are more tailored to their business practices and are not as burdensome as the Copyright Office’s practices can be. For example, photographers who sell their images through an online service could, provided that service becomes a certified registry, enjoy the benefits of registration with essentially the same activity that they already undertake to monetize their works. For users, provided the private registries comply with a good set of requirements of transparency and efficiency, the benefits would be development of search tools and technology by private vendors that will be more useful than the current Copyright Office systems. Competition among registries should keep registration fees at reasonable levels; some registries, such as Creative Commons, might choose to charge minimal or no fees for registration.

To be sure, there are potential costs and pitfalls with this approach that would need to be addressed. Specifically, procedures would need to be developed to prevent false claims of ownership or overclaiming of copyright. Likewise, making the data interoperable among different entities may present technological and legal challenges, and procedures to ensure that the private registries are meeting their public interest obligations would need to be developed, including reporting, auditing, and re-certification requirements. Also, provisions anticipating that a private registry might cease operations would be required to ensure that the copyright ownership and licensing data remain accessible to the public.

Moreover, there are many ramifications of this change that need to be considered. A primary issue is how the Library of Congress continues to use the registration system to help build its collections. This would be an important aspect of the Copyright Office regulation of private registries: to develop a means to facilitate deposit of works for the Library's benefit. Other similar effects of this reform should be identified and discussed.

Recommendation #3: The Copyright Office should develop additional policy expertise and research capability, particularly in the area of economics and technology.

The Copyright Office's policymaking and legislative advisory function would be improved by the consistent application of certain expertise that the Office currently lacks. It would be desirable for the Office to undertake an economic analysis of the effects of copyright law and proposed law and policy changes. Also desirable would be a better understanding of the relationship between copyright law and proposed law and policy changes to the technological environment in which copyright law operates. Understanding of both economics and technology is critical to the Copyright Office's policymaking function.

Copyright in the United States is a social welfare tool. It is deeply economic in nature, and it requires a sensitive balance of both public and private interests. Additionally, the way in which copyright rules play out in the real world is influenced directly by the technological environment in which the law must function—an environment that is itself always changing. For all these reasons, copyright policy cannot and should not be made based solely on the interactions of lawyers, legislators, and interested parties. Some additional expertise is required.

Accordingly, we recommend that two new positions be created in the Copyright Office—(1) Chief Economist, and (2) Chief Technologist. We suggest that these positions should not be filled by permanent Copyright Office employees, but rather should be posts that will be filled by a new

occupant for a relatively short term, such as two or three years. In our conception, the Copyright Office would recruit individuals with significant economic and technical expertise from academia, other government agencies (e.g., the Federal Trade Commission, the Federal Communications Commission, the Office of Management and Budget, the Antitrust Division of the Department of Justice), and the private sector. We hope that a temporary but prestigious posting of this kind would attract first-rate candidates and also ensure a regular infusion of fresh thinking.

The expertise and policy-making function of the Copyright Office could also be improved by consulting with experts in other fields related to production of copyrighted works, such as individuals with experience in media studies and other disciplines related to the creation and dissemination of culture. The Office could, for example, convene *ad hoc* panels of such experts to address particular issues. It would also be desirable for the Office to develop better capabilities to conduct empirical research to support a thorough analysis of policy issues and recommendations.

Recommendation #4: The Copyright Office should give serious consideration to developing some mechanism(s) through which users could receive guidance on “fair use.”

The fair use provision of U.S. copyright law is perhaps the most important limitation on copyright’s exclusive rights. This doctrine functions, among other things, as a mechanism for reconciling copyright law with the First Amendment, for ensuring that copyright’s exclusive rights do not impose significant restrictions on expression, and for freeing up a range of uses that do not threaten rights holders’ ability to obtain an adequate return from their works.

The fair use doctrine is not a set of discrete rules. It is structured, instead, as a general standard. As a consequence, it is not self-enforcing. Rather, assessing whether a particular use will eventually be deemed fair by a court involves a complex and context-specific analysis, requiring judges to balance evidence pertinent to four statutory factors, plus whatever other facts may enter into a court’s equitable analysis. Such analysis often can be undertaken only with the assistance of competent counsel, and, even when a user relies on counsel, it poses significant residual risk of liability.

It would be desirable for the Copyright Office to consider providing the public with more guidance about what constitutes “fair use” and what does not. One alternative discussed by the CPP group was having the Office provide fair use “opinion letters.” Individuals or firms considering whether a contemplated use of a copyrighted work would qualify as a fair use could submit a request to the Copyright Office for an opinion. The request would

provide the relevant facts describing the contemplated use. The Copyright Office would meet with the applicant and elicit further information. When the Copyright Office felt informed enough to do so, it would undertake a fair use analysis and issue an opinion letter. It is hoped that these letters would provide guidance in specific cases, and, over time and as a whole, provide guidance more generally regarding the contours of permissible fair use.

These letters would be similar in concept to the “business review letters” that are issued by the Antitrust Division of the Department of Justice, wherein firms considering a course of conduct that might affect competition in a relevant antitrust market apply to the Antitrust Division for guidance regarding whether the conduct is permissible under the antitrust laws.

The Copyright Office would have discretion regarding which applications for fair use opinions it would act on. Our expectation is that discretionary jurisdiction would allow the agency to conserve its resources and focus them on the most difficult and significant fair use questions.

There were, however, some reservations about this proposal within the CPP. Some questioned whether the opinion letter procedure would provide any real benefit to users, given its non-binding nature and the Office’s discretionary jurisdiction. To perform this function, the Office would have to add new staff and expertise to its ranks. Such a system might also be too “conservative,” for some well-known fair use cases have been departures from what most lawyers would have predicted from extant case law. The procedure might also become complicated insofar as it included participation by the relevant copyright owner and led to judicial review of the Office’s determination. The Office might also find it difficult to issue such letters in light of the “collective impact” one letter might have on a wide range of activity involving copyrighted works.

We considered some alternatives to the opinion letter approach, including having the Copyright Office develop procedures for certifying “best practices” for fair use, such as those developed recently in the documentary film sector. Also, the Office could develop some form of “guidebook” for fair use determinations to help users seeking additional information about the boundaries of this critical exception.

Recommendation #5: A small claims procedure should be available for resolving small-scale copyright disputes.

Another area of potential administrative reform is to create within the Copyright Office (or elsewhere if serious doubts exist about the constitutionality of housing this process within the Office) a procedure for efficient resolution of small-scale copyright claims.

Current U.S. law requires copyright owners to engage in expensive federal court litigation to enforce their copyright through legal process, a costly means of protecting copyright that is often effectively inaccessible to individual owners because of the modest damage amounts at issue. Developing a balanced small claims procedure would provide obvious benefits to these copyright owners; it would also help potential users by providing a more rational and predictable scope of remedies for “ordinary” types of infringement that is not widespread and not at the level sometimes referred to as “piracy.”

Many details about how such a procedure would work need to be developed, but we envision that the Copyright Office could receive and decide “small” infringement claims (that is, claims of less than a certain dollar amount). This procedure would be part of the overall civil enforcement structure of copyright law and would rely on an interface with the general civil remedies and litigation system. It would require the Office to be able to receive submissions, decide them in an efficient fashion, publish the rulings, and generally administer the procedure. Because a central component of the procedure would limit the submission of evidence to paper submissions and would not require hearings, discovery, or extensive written opinions, it is anticipated that this function would not require the Office to need extensive additional resources.

While the focus of such a system would be individual or small business copyright owners, such a system should also be designed to allow even large-scale copyright owners to avail themselves of its benefits, provided that the claims adjudicated remained “small” and the system could not be abused to provide inappropriately large collective damage awards. It would also be beneficial if the system could be used by individuals to help vindicate non-monetary remedies, such as addressing breaches of attribution conditions of copyright licenses.

It may also be possible to develop a small claims process for copyright disputes in other venues. Some federal district courts already have well-developed alternative dispute resolution programs, and these could be used for certain kinds of copyright matters.

C. REFINEMENT OF COPYRIGHT’S EXCLUSIVE RIGHTS PROVISIONS

The most extensive discussions among CPP members concerned the exclusive rights of copyright and how various members of the group thought they might be refined. We were able to reach consensus on some matters, but by no means on all.

One option considered at some length was the possibility of articulating one exclusive right as the “core” right to encompass not only the wide range

of activities now regulated under the exclusive rights provisions, but also new uses that might develop over time that would not fit easily within the existing exclusive rights framework. Various ways exist to articulate such a core right. The law might, for example, grant authors an exclusive right to control the appropriation of commercial value of the expression in a copyrighted work. Or the law could grant authors an exclusive right to disseminate their works to the public or an exclusive right to commercialize their works.

Arguments in favor of what we called “the big lumpy right” included that it might crystallize the sets of acts that copyright owners should be able to control, it would avoid intellectually sterile debates about whether this exclusive right or that should apply to conduct not envisioned when the law was enacted, and it seemed flexible enough to adapt to changing circumstances. While such a broad exclusive right might, on its face, seem simpler than the existing exclusive rights regimes, we came to the conclusion that it would likely introduce new ambiguities and hence uncertainties, and it was also out of synch with international norms and practices. We ultimately concluded that it would be better to direct our efforts to consider how existing exclusive rights could be refined to make their application more predictable.

Recommendation #6: Commercial use or commercial effect should be given weight in assessing whether an exclusive right has been infringed.

Maintaining a balance between a copyright owner’s exclusive rights and the public’s right to use such works free from copyright owner control is critical for a well-designed copyright law. Such a balance allows copyright law to provide the proper incentive to encourage authors and their financial backers to create and to distribute new works, while permitting users and follow-on creators to engage in activities that further knowledge and progress.

The scope of the exclusive rights granted to a copyright owner under U.S. copyright law is a function of not only the grant of rights provision, but also of the nature and scope of the limitations placed on those rights. Initially, copyright law conferred on authors the rights to print, reprint, publish, and vend, and the statutory limitations on those rights were virtually non-existent. Over time, the rights granted to copyright owners expanded to include a right to control the creation of an adaptation of the work, later fashioned as a right to control the creation of derivative works. Rights were also added to control public performances and public displays of copyrighted works.

As the rights of authors expanded, a need for limitations on those rights was recognized, at first in the courts and later in Congress. The fair use doctrine, which began as a judicially created doctrine and is now codified in the statute, is an important ingredient in the shape of the rights granted to copyright owners. The specific express limitations codified in the current copyright law also play an important role in shaping the rights of copyright owners. To deal with new types of uses beyond those contemplated by Congress in 1976 when it adopted these specific limitation provisions, defendants have often had to rely on fair use or perceived limits on boundaries of exclusive rights to justify their uses.

Current copyright law in the U.S. strikes the balance between the owner's and the public's rights by first broadly defining the owner's rights to reproduce, adapt, publicly distribute, publicly perform, or publicly display the work of authorship for any purpose, and then subjecting these broad rights of control to a variety of limitations and exceptions that range from the flexible doctrine of fair use to very specific uses for particular classes of works.

In practice, many copyright owners tolerate a range of unauthorized uses of their works. Imprecision in the scope of exclusive rights often makes copyright owners reluctant to sue those whom they reasonably believe to be infringers, owing in part to the cost and uncertainty of litigation. At the same time, the current legal structure makes it possible for an aggressive copyright owner to overclaim rights and to force good faith users or follow-on creators to defend a use as falling within the complex web of existing limitations and exceptions. Overclaiming can impose high litigation costs, including risks of statutory damage awards, and thereby chill some uses that if challenged would ultimately be found non-infringing. A well-functioning copyright law would deter overclaiming imbalances. At the same time, any attempt to correct the balance must recognize the risk of burdening the copyright owner's ability to enforce its rights, particularly against a user who has simply disregarded those rights altogether.

Currently, the copyright owner need not prove that a use has commercial effect in order to succeed on a claim of copyright infringement. Commercial harm is only a factor as part of a fair use defense. A putative fair user must argue either that his use does not cause harm to the copyright owner's market(s) or that if any such harm exists, the other fair use factors still favor the use.

The CPP group discussed two principal approaches to refining the copyright owner's exclusive rights to take commercial harm into account. One approach would differentiate between uses of all or virtually all of a work and uses of only some parts of a work because of the different

probabilities that the latter uses will cause commercial harm to the copyright owner's interests as well as because of the different probabilities that the user has engaged in a socially productive use. A second approach would redefine the copyright owner's exclusive rights so that commercial distribution or commercial dissemination would be an element of the right.

Under the first proposal, copyright law would recognize that reproducing or publicly distributing, performing, or displaying all or virtually all of a copyrighted work without a license has a greater likelihood of causing harm to the copyright owner because it interferes with a core right of the copyright owner. Use of less than all or virtually all of a work is less likely to cause harm to the copyright owner and is more likely to include creative contributions by the user, and thus should be seen as a subsidiary right because creative reuses are less threatening to a copyright owner's core interests. Consequently, for unlicensed uses of less than all or virtually all of a work, copyright law should require the copyright owner to prove commercial harm in order to prove infringement of the owner's exclusive rights.

This first proposal would alter how the copyright owner's exclusive rights would be influenced by the actual or potential commercial effect of an unlicensed use on the copyright owner. Unless a defendant was using all or virtually all of the copyrighted work, the copyright owner would be obliged to prove that the defendant's use has caused or is likely to cause commercial harm. Commercial use by the defendant would not be a substitute for proof of commercial harm to the copyright owner, as not all commercial uses necessarily cause commercial harm. Additionally, a mere desire by the copyright owner to charge the defendant a license fee for the defendant's use should not suffice to demonstrate commercial harm.

Commercial harm to the copyright owner would include harm to traditional and economically plausible and appropriate licensing markets. Yet, the user might still assert fair use as a defense. The fair use analysis then would be directed at weighing the degree of commercial harm to the owner against the social value of the use. In this way, the fair use defense would also remain for cases involving use of all or virtually all of a copyrighted work. This division between a core right of a copyright owner and subsidiary rights would help to address the risk of overclaiming and its resultant chilling effects on users while preserving a copyright owner's ability to get meaningful relief without undue burden.

The second approach we discussed would redefine the copyright owner's exclusive rights so that commercial distribution or commercial dissemination would be an element of the right. Under this second approach, the adaptation right, for example, would be recalibrated to strike the balance between the copyright owner and the public with greater specificity. The

principal right would be redefined as the exclusive right to prepare adaptations, arrangements, and continuations of the copyrighted work for commercial dissemination to the public by reproduction and distribution of copies, public performance, or public display. An adaptation would be defined as the transposition into another artistic medium of all or virtually all of the expression of the copyrighted work. An arrangement would be defined as the fixation in a tangible medium of expression of a new version of the copyrighted work in the same medium of expression that includes all or virtually all of the expression of the copyrighted work plus additional protectable expression. And a continuation, for fictional works, would be defined as an extension of the story being told in the original copyrighted work.

The right to prepare adaptations, arrangements, and continuations would not encompass adaptations, arrangements, and continuations for non-commercial dissemination, nor would it encompass the preparation of adaptations, arrangements, or continuations for private, personal, or non-profit educational use. However, in cases where it is not reasonably apparent from the circumstances, the copyright owner should have the right to require that such adaptations, arrangements, and continuations be identified as unauthorized by the copyright owner. Finally, the second proposal also contemplates distinct exclusive rights of translation and merchandising. The copyright owner would have ten years to work the translation right or it would lapse.

Under this second proposal, the reproduction right would likewise be redefined as the right to reproduce the copyrighted work for commercial distribution to the public, and the rights of public performance and display would be redefined in parallel. This would change the default in today's copyright law which posits that an owner controls the reproduction, public distribution, public performance, and adaptation of the work. Absent a license, the defendant must fit any of those activities into an exception to that control, including the fair use exception. This reform would alter that default principle in a material way, at least in principle, by removing control over a potentially large category of non-commercial uses. Support for that change would rest on an instrumental view of copyright as a means of providing an economic incentive for the creation of works.

Because the underlying purpose of the copyright grant is to reserve to the owner the right to earn money from commercial exploitation of the work, the scope of the right would encompass some exploitations, ostensibly for non-commercial distribution, that would frustrate that purpose (e.g., a website offering first-run movies for free). However, the rights would not extend to reproductions, performances, or communications for private or

personal use, those intended for distribution to a small circle of family or friends, or other types of limited uses that do not cause commercial harm to the copyright owner. For example, unless a work was produced or marketed primarily for use in educational institutions, the reproduction right would not extend to a reproduction of that work for limited distribution in a non-profit educational setting. Unless a work is produced or marketed for distribution within business settings on a per-user basis, the reproduction right would not extend to a reproduction of that work for limited distribution to one or a small number of professional colleagues. As before, the fair use doctrine would be available for some commercial use cases in which social value would be weighed with the potential for commercial harm to the copyright owner.

While recognizing the arguments in favor of making commercial harm an element of a copyright plaintiff's claim, some members of the CPP group have reservations about it. First, they are concerned that courts might place too much weight on the shift in the burden of proving commercial harm and thus set the bar too high. Proving either actual or likely harm to existing markets should suffice, and harm to likely future markets should be considered along with harm to present ones. The commercial nature of the defendant's use may indicate harm, but it is not a necessary factor in determining that the plaintiff's market may be harmed. Second, some of us believe that many members of the public, and certainly most creators, are likely to have a dose of "natural rights" theory in their perception about copyright law, under which authors would have at least some control over the use of their works even if the use is non-commercial—and especially when the use is commercial.

The concerns articulated above suggest consideration of a more modest reform. Under it, the plaintiff would have the burden of proving commercial harm only if the defendant's activity was not undertaken for commercial gain. If the defendant is using the plaintiff's work for commercial gain and claims the use will not hurt the plaintiff's market, it may be reasonable to ask the defendant to show why. This approach would still meet the key objective of shielding a vast amount of "for fun" uses that have become the hallmark of the Internet age, as well as many kinds of research uses. It would leave commercial users in the position they are in now, having to demonstrate that their activity should be treated as non-infringing. Copyright industries may be more amenable to this than to a more general shift in the burden on the issue of harm or the exclusion of non-commercial uses from the copyright owner's bundle of rights.

Proponents of the more general burden-shifting and exclusion of non-commercial uses do not believe these proposals would materially reduce the

protection of works from much activity that would be considered infringing today. Rather, its purpose is to shield non-harmful activity from the threat of overly zealous copyright claims, thus reducing the chilling effect that threat tends to generate. Put another way, it is hoped that this reform would not generate a substantial new jurisprudence about harm or otherwise create undue “empirical” burdens on plaintiffs. To others in the group, the danger of that happening is inherent in the proposal and should be carefully weighed in evaluating its merits.

Recommendation #7: Copyright owners should have the exclusive right to control communications of their protected works to the public, whether by transmission or otherwise.

Prior to the 1976 Act, transmissions of copyrighted works were not generally included within the public performance right. The drafters of the 1976 Act decided to graft the right to control cable company retransmissions of broadcast television signals onto the performance right as part of the compromise to resolve an intense controversy over the copyright significance of cable transmission of broadcast programs. Today, some transmissions are dealt with through the public performance right, some through the distribution of copies to the public right, some through the public display right, and some through the reproduction right. It would simplify the law and make it conceptually more coherent to treat commercially significant transmissions under the rubric of a right of communication to the public.

Separate from the exclusive right to perform a work in a public or semi-public place, copyright owners should have the exclusive right to communicate their works to the public by means of a transmission whereby members of the public who receive the transmission can perceive or reproduce the work. Communicating protected works to the public should include transmitting them to different members of the public in different places or at different times. For these purposes, “the public” should include any subset of the public, but should not include a transmitting party’s family and immediate or close circle of friends.

This proposal would be a substitute for the existing transmission prong of the public performance/display right. We believe it would be wise to separate communications to the public by means of transmission from the “performance in a public/semi-public place” right for two principal reasons. First, this change would bring U.S. copyright law into closer conformity with the copyright laws of other nations. Second, it would make U.S. law more coherent.

We recognize that the communication right may be somewhat broader than the transmission prong of the public performance right in that it would

include transmissions where the recipient stores the work instead of only viewing or listening to it. But transmissions to store would likely be covered by the distribution or reproduction rights, so we do not regard this proposal as an expansion of the scope of copyright.

Recommendation #8: There should be greater coherence and consistency in the tests courts use to determine infringement of the reproduction right.

Courts have used a variety of approaches when analyzing whether the exclusive right to reproduce a work in copies has been infringed. Making this determination is, of course, relatively straightforward when the case involves exact or near-exact copies. But when copying is non-literal, or when there are arguably substantial differences between the works at issue, the inquiry is more difficult. The commercial harm/use limitation suggested above would help to make non-literal infringement decisions more predictable, but there is still a substantial problem with the inconsistent ways in which courts analyze infringement in these cases.

A common theme of existing judicial approaches is to search for “substantial similarity in expression” between the defendant’s and the plaintiff’s works, and to conclude infringement exists if there is substantial similarity in expression and the defendant copied the expression from the plaintiff. Some courts use Judge Learned Hand’s “patterns of abstractions” approach. It seemingly calls for construction of a complex hierarchy of abstractions of the two works so that inquiry can be made as to whether similarities are at abstract levels (e.g., a cross-ethnic romance disapproved of by the lovers’ parents) and hence constitute “ideas,” or are sufficiently detailed (e.g., exact plot sequences even with different dialogue) so they should be considered protectable “expression.”¹¹

Even more analytically dissective is the “abstraction-filtration-comparison” test widely used in judging computer software infringement. Like Judge Hand’s test, it begins with construction of a hierarchy of abstractions, then directs that all unprotectable elements (such as efficient designs, commonly used building blocks, or elements whose design is constrained by the hardware or software with which the program must operate) be eliminated from consideration, and then compares the “golden nuggets” of expression remaining to discern whether infringement has occurred.¹²

11. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (Hand, J.).

12. *See, e.g., Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706–11 (2d Cir. 1992).

Yet, some courts reject a dissective analysis of similarities and differences, and direct that infringement should be determined on a lay observer's impression about the similarities or the "total concept and feel" of the two works.¹³

The Ninth Circuit Court of Appeals has arguably sought to blend the two approaches by directing a two-step analysis, under which an "extrinsic" analysis of similarities and differences is undertaken, followed by an "intrinsic" analysis that takes a more subjective approach.¹⁴ But it is very difficult to predict how this test will be applied in different contexts.

The non-standardization of infringement tests and analysis contributes to uncertainties about copyright's boundaries and to chilling effects on follow-on creators. We believe it is possible to develop a more coherent and predictable analytic framework, and we suggest that if the judiciary cannot reach consensus on this matter, other institutions, such as the American Law Institute, might work on refining tests for copyright infringement.

D. SAFE HARBOR FOR THOSE WHO DEPLOY REASONABLE MEASURES
TO DETER INFRINGEMENT

Recommendation #9: Online service providers that deploy reasonable, effective, and commercially available measures to minimize infringement should be eligible for a safe harbor from liability for the infringing acts of others.

Part II noted that technology may have a role to play in preventing widespread, unauthorized distribution and performance of copyrighted works. Online service providers, whose facilities make such activity possible, may sometimes be in the best practical position to deploy preventive technological measures. This proposal would create a new safe harbor for online service providers that undertake to do so.

The ISP safe harbor rules added to U.S. copyright law as part of the DMCA were aimed at achieving two goals: (1) protecting service providers from excessive liability arising from the activities of their users, and (2) encouraging those providers to participate in the reduction of infringement. To achieve those goals, Congress created four safe harbors that encourage service providers to take certain steps, such as responding to takedown notices, in exchange for substantial freedom from liability.

13. *See, e.g.*, Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., 602 F.3d 57, 66 (2d Cir. 2010); Roth Greeting Cards v. United Card Co., 429 F.2d 1106, 1110 (9th Cir. 1970) (coining the phrase "total concept and feel").

14. *See, e.g.*, Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1162–67 (9th Cir. 1977).

Since the enactment of the DMCA, technologies have become much better at recognizing and filtering out infringing copies of works available on or being distributed via the Internet. Most of this technology has been developed by small entrepreneurs who see a potential market for the technology among service providers and content companies. The technology is increasingly “smart,” that is, capable of determining, for example, how much of a copyrighted movie is contained in a given online file and even whether the file combines video or audio tracks from the movie with new material. As with the DMCA safe harbors, the proposed new safe harbor would encourage service providers to use such new technology (or a technology later developed) if that technology constitutes a reasonable, effective, and commercially available measure for deterring infringement.

For a measure to be deemed “reasonable,” it should take appropriate account of limitations on the exclusive rights of copyright owners, such as fair use, as well as the privacy interests of users and perhaps other social considerations. Reasonableness must be assessed with due consideration for the cost of deployment, the scale of the enterprise that would deploy it, the private and public value which the enterprise or technology generates, as well as the magnitude of harm to copyright owners which the measure is likely to prevent or reduce. Copyright owners should bear a share of the costs of such measures, particularly with respect to producing information about what works may or may not be distributed over the ISP’s networks.

The requirement that the measure be “commercially available” is intended to avoid the implication that technology must be designed in the first instance to prevent infringement. If, however, commercially available technology can be deployed in an existing system, such as an online network, in a commercially reasonable way and it would be effective in reducing significant infringing activity, the system operator’s failure to deploy it would be relevant to whether the safe harbor protection from liability should be afforded to that party.

A practical problem arises when one considers adoption of such a safe harbor; namely, how to encourage the use of reasonable measures while discouraging the use of measures that do not take adequate account of the other side of the equation, including permitting lawful uses and protecting privacy. There is a risk that a service provider would elect to deploy a very “blunt” filter in the hope of obtaining the safe harbor, with little regard for its adverse effects, although service providers may be economically disinclined from use of such blunt instruments insofar as doing so would cause customer dissatisfaction.

We reached no consensus on a solution to this practical problem, but one approach that is worthy of further consideration is to call upon a regulatory

agency, such as the Federal Trade Commission, to assess whether a particular technical measure is, indeed, reasonable, effective, and commercially available. The safe harbor would then apply only to certified measures. The burden of proof that the measure meets the reasonableness, effectiveness, and commercial availability standard would be on firms wanting to encourage its use.

Failure to adopt such measures should not, by itself, give rise to liability for infringement, although it could be considered in assessment of secondary liability if other evidence establishes an actual intent to cause infringement. The potential for reasonable measures to mitigate infringement is already, we believe, leading researchers in development labs around the world to explore such solutions. A governmental agency may not be able to respond as quickly as the marketplace when new and better solutions become available. Thus, we hope the safe harbor would encourage service providers to adopt reasonable measures voluntarily, as they become available.

Any proposal to encourage deployment of technological measures should also be cognizant of the collateral consequences of their use. Incorporation of technological measures in an online service or network does have an effect on design and development of those networks and relevant technologies. This may well have implications for the kinds of innovations firms are willing to undertake, although it is difficult to assess at this point whether there will be a chilling effect on some beneficial innovations, or whether some beneficial innovations will occur, in part, because of the safe harbor. Accordingly, it is important that the safe harbor definition of “service provider” focus on those providers as to which the positive and negative effects of uses of technical measures are relatively well known and understood.

Most discussions around reasonable measures have focused on two main types of services: (1) internet access providers and the use of those services by peer-to-peer file-sharing services that are designed and used for infringement, and (2) online video services that allow users to upload video content that is often infringing. The reasonable measures proposal discussed here was developed with those types of reasonably well known services in mind but still raise important questions about their propriety and effectiveness.

Whether a similar safe harbor proposal should cover other types of services, computer networks, mobile devices and their networks, personal computers, and other technologies may raise very different questions with very different answers. A prudent approach would start with small steps and learn from those before applying these concepts to other services and

technologies. This uncertainty is one reason to support a voluntary safe harbor approach rather than a mandatory one.

Furthermore, no matter how “smart” any technology is, determination of what is and is not copyright infringement is often not susceptible to a simple, binary choice but instead requires assessment of issues such as fair use that will be beyond any technology. Any safe harbor must have provisions for users to receive notice of and opportunity to contest the application of a reasonable measure to their circumstance to correct for any “false positives.”

While a majority of the CPP group favors the non-mandatory safe harbor approach set forth above, a few members believe that a mandatory approach should at least be considered. This approach would impose an obligation on ISPs to deploy reasonable measures. In their view, a safe harbor is meaningful only to the extent that it shields firms from potential liability. At present, intermediaries usually face potential liability under secondary liability doctrines, such as vicarious and contributory infringement. Those doctrines require proving that some party is the direct infringer, which in turn often points the threat of liability at individual users of online systems. Moreover, the secondary liability approach raises difficult-to-answer questions about when intermediaries should be liable for acts of their customers—questions that involve tricky issues of knowledge, inducement, control, and the like, and on which courts have divided.

Those favoring a possible mandatory approach would prefer to reduce the dependence on the secondary liability doctrines, thus avoiding the difficulties just noted. They believe that the law should simply require the deployment of reasonable measures as part of online service systems that create the danger (and fact) of widespread, consumptive copyright infringement. Proponents of the mandatory approach believe that the contours of reasonable measures outlined above are themselves so “reasonable” that mandatory deployment is not likely to prove damaging to the economic interests of intermediaries or the digital economy generally. If such a proposal were adopted, the key questions would be the administrative ones already mentioned in the context of creating a safe harbor. Alternatively, if secondary liability doctrines continue to be used to address ISP liability, they suggest that failure to adopt reasonable measures to prevent known infringements should be considered as an element supporting the imposition of secondary liability.

Yet, some CPP members regard even a non-mandatory safe harbor as posing some risks. Instead of insulating ISPs from liability, creating such a safe harbor might eventually lead to an expansion in the scope of secondary copyright liability. A safe harbor makes sense only to protect against a corresponding liability. Congress enacted § 512’s safe harbors, in particular,

to insulate ISPs from liability for infringing content stored on their systems as a direct response to judicial recognition of potential contributory and vicarious liability for ISPs.¹⁵ There has been no corresponding judicial recognition of secondary liability based upon a failure to employ so-called “reasonable” technological matters alone. Enacting a safe harbor, even a non-mandatory one, may implicitly suggest that ISPs should be liable for failing to adopt reasonable technological measures. Given the likely expense and uncertainty associated with guessing whether any given measure will ultimately be found “reasonable,” recognition of the proposed non-mandatory safe harbor may push ISPs to adopt unreasonable technological measures in order to avoid any risk of liability.

One important objective of the non-mandatory safe harbor proposal would be to focus attention more on the “gatekeepers” who can make the greatest impact on infringement and less on individual users. Service providers can do more to inhibit infringement and may bear some legal responsibility for infringement when they do nothing to mitigate it, as when they know infringing materials are on their sites and do not take them down after being notified by the copyright owners. Service providers must, of course, be free to provide their essential services and innovate on those services without undue economic risk. The present proposal is an attempt to find a middle ground and to stimulate thoughtful consideration of the role technology might play in preventing infringement.

E. REFORMS PERTAINING TO STATUTORY DAMAGES

Recommendation #10: If copyright law is to retain the right to elect to recover statutory damages in lieu of actual damages, guidelines for awarding statutory damages in a consistent, reasonable, and just manner should be developed.

Copyright owners have long been entitled to be compensated for pecuniary harms that infringement inflicts on them, such as the license fee the owner would have charged, a royalty stream the owner would have gotten, or profits the owner would have made but for the infringement. Copyright law also allows successful plaintiffs to force infringers to disgorge any profits attributable to that infringement. This disgorgement plays a crucial role in deterring infringement and preventing unjust enrichment. These remedies, taken together, remove or substantially diminish the

15. *See* Religious Tech. Ctr. v. Netcom On-Line Comm’n Servs., Inc., 907 F. Supp. 1361, 1369 n.12 (N.D. Cal. 1995); WIPO COPYRIGHT TREATIES IMPLEMENTATION AND ONLINE COPYRIGHT INFRINGEMENT LIABILITY LIMITATION, H.R. REP. NO. 105-551, pt. 1, at 11 (1998).

incentive that a potential infringer might otherwise have to force the owner into an involuntary exchange of the right for only a compensatory award, such as a license fee. These core parts of the current copyright remedial scheme are sound.

Present law also allows copyright owners who have promptly registered their claims of copyright to choose, in lieu of an award of actual damages and infringer's profits, an award of "statutory damages" in an amount ranging from \$750 to \$30,000 per infringed work in the ordinary case, and up to \$150,000 per infringed work in cases of willful infringement, as the court deems "just." Courts can reduce statutory damages to \$200 when an infringer proves that he was not aware of and had no reason to believe his conduct was infringing, and to \$0 if the good faith user is affiliated with a non-profit educational institution. In practice, however, the lower level of statutory damages is hardly ever used.¹⁶

Statutory damages sometimes provide reasonable compensation when actual damages and infringer profits are difficult or expensive to prove or when damages and profits are low. At the higher end of the scale, statutory damages are thought to provide extra deterrence or punishment for egregious infringement.

However, the wide numerical range of permitted awards, coupled with the lack of standards or guidelines for awards, the ability of the plaintiff to unilaterally elect an award of statutory damages at any time in the litigation, and the willingness of courts and juries to decide that infringement was willful if the defendant should have realized his acts were infringing, has too often led to awards that seem arbitrary and capricious, inconsistent with awards in similar cases, and sometimes grossly excessive or disproportionate when compared with a realistic assessment of actual damages and profits.¹⁷ The unpredictability of statutory damages sometimes has an undesirable chilling effect on some conduct that, if challenged, would be lawful.

It would be possible for Congress to develop guidelines to ensure that statutory damage awards are just. Courts could also, through case-by-case analysis, build a principled jurisprudence on statutory damage awards, but this has not happened thus far. If statutory damages are to be retained in U.S. copyright law, guidelines for their just application should be developed.

Recommendation #11: An alternative way to achieve the deterrent or punitive functions of statutory damages would be to give courts

16. See, e.g., Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439, 474–75 (2009).

17. *Id.* at 480–91.

discretion to award up to three times the amount of actual damages and infringer profits in exceptional cases as long as the copyright owner registered the infringed work(s) before the infringement commenced.

CPP members considered an alternative to statutory damage awards for dealing with egregious infringements. It would authorize courts to award up to three times the amount of actual damages/infringer profits to provide an extra degree of deterrence or punishment for egregious infringement. This alternative would preserve and clarify some of the deterrent or punitive goals that statutory damages were partly intended to serve, while ensuring that awards are more commensurate with the infringers' behavior and proportionate to the actual harm inflicted on the owners.

The independence of this proposed remedy from the recovery of actual damages and profits aims to correct one of the fundamental structural failings of the current statutory damages provision, namely, the melding of two distinct types of objectives in one statutory provision: the perceived need for some compensation when damages and profits are difficult to prove, on the one hand, and the need for some higher level of possible awards to be imposed on egregious infringers, on the other. The multiplier-based approach to enhanced damages is also consistent with the approach to damages in other areas of intellectual property law, such as patent and trade secrecy law, as well as consistent with the Supreme Court's mandate that punitive damages should bear a reasonable relationship to the actual harm caused in a particular case.¹⁸

This proposal would entrust the decision whether to award enhanced damages in a particular case to the discretion of the court, rather than to the sole election of the plaintiff, as under the current statutory damage provision. Consistent with our formalities proposal above, we would limit the application of the enhanced damage award to those rights holders who have registered their works.

While this proposal would address concerns about predictability and proportionality in statutory damage awards, some of us had reservations about this proposal because it may not adequately address one of the animating purposes of the current statutory damage regime: to provide some meaningful recovery in cases where actual damages are difficult to prove. It is important that damage awards in copyright cases accomplish not just the deterrent, but also the compensatory purposes of copyright law.

18. *See, e.g., BMW of N. Am., Inc. v. Gore*, 517 U.S. 559 (1999) (striking down a punitive damage award as so excessive as to constitute a due process violation).

F. REFORMS RELATED TO INJUNCTIVE RELIEF

Issuance of injunctive relief is a long-standing remedy in U.S. copyright law, and that is as it should be. Injunctions are especially important and necessary in cases where harm to the copyright owner will be irreparable unless an injunction issues. Harm may be irreparable for many reasons, as when an award of monetary damages would be insufficient to rectify the wrong. Such an insufficiency may exist when it is difficult to ascertain the proper amount of monetary compensation due. Harm may also be irreparable when it tends either to undermine the plaintiff's business to a significant extent or to compromise its ability to obtain a money judgment. While injunctive relief is often appropriate, it sometimes is not. The recommendations below address two sets of issues involving injunctive relief: the need for application of traditional principles of equity before copyright injunctions issue, and circumstances in which injunctive relief may not be appropriate as compensation will rectify harm caused by infringement.

Recommendation #12: Courts should have discretion to issue both preliminary and final injunctions in copyright infringement cases, but should apply traditional equitable principles before doing so.

Following the Supreme Court's recent decision in *eBay Inc. v. MercExchange, L.L.C.*,¹⁹ courts have renewed their attention to the equitable underpinnings of injunctive relief in copyright and other intellectual property cases.²⁰ Sound copyright principles support the principle recognized in *eBay*, that injunctions should not issue automatically. We believe that it is appropriate for courts to possess the authority to enter injunctive relief in copyright cases. Full attention to the traditional equitable principles will further the underlying goals of the copyright law. The *eBay* decision suggests that copyright owners should demonstrate that they will suffer irreparable harm and that the remedies provided at law are inadequate to compensate for the harm in order to qualify for injunctive relief. Use of equitable principles can help ensure that the goals of copyright law are not thwarted by too-frequent awarding of injunctive relief.

A separate question exists about whether courts should presume irreparable harm in copyright cases in which plaintiffs have sought preliminary or permanent injunctions. It has become quite common for courts to issue preliminary injunctions in copyright cases once rights holders have shown a reasonable likelihood of success on the merits without also requiring the rights holders to prove that they will suffer irreparable harm

19. 547 U.S. 388, 391–94 (2006).

20. *See, e.g., Salinger v. Colting*, 607 F.3d 68 (2d Cir. 2010).

unless the preliminary injunction issues. Harm in these cases is often presumed to be irreparable. Also common is presuming irreparable harm once infringement has been found. The viability of these presumptions in the aftermath of the *eBay* decision, especially as to preliminary injunctions, has been questioned in some post-*eBay* case law, although some courts continue to invoke the presumptions. However, an automatic presumption of irreparable harm in every case is troubling.

A presumption of irreparable harm is particularly troublesome in cases involving transformative uses of existing works, such as parodies, remixes, and mashups, because free expression and free speech interests of creative users are at stake and transformative use cases often raise plausible non-infringement defenses.

On the other hand, the bar to establishing irreparable harm should not be raised so high as to preclude injunctions against clear and obviously harmful infringements. For example, injunctions are appropriate against counterfeiters or those who make unauthorized derivative works that would compete with the rights holders' intended works. Harm in these types of cases is likely to be irreparable.

We considered two options for responding to these concerns. One would eliminate the presumption of irreparable harm in all copyright cases. Under this approach, copyright owners would have to prove each equitable element to qualify for injunctive relief in each case. The goal would be to develop a jurisprudence that would both adequately protect the reasonable exercise of copyright owner interests and the free expression interests of follow-on creators. A second approach would allow a presumption of irreparable harm in some cases, such as those involving counterfeiting and other straightforward infringement, but would require plaintiffs to prove irreparable harm in other cases. In straightforward infringement cases, a presumption of irreparable harm may well serve the interests both of equity and judicial efficiency.

In light of the *eBay* decision, copyright plaintiffs should also show that the balance of the hardships weighs in their favor, and courts should explicitly consider the effect on the public interest when determining whether to enter an injunction. These final considerations should focus the court's attention on the effect an injunction may have not only on the defendant, but also on society as a whole. This would encourage explicit consideration of the First Amendment and of copyright's constitutional goal of promoting widespread dissemination of knowledge.

Recommendation #13: Courts should avail themselves of the discretion they have to fashion alternative remedies in lieu of injunctive relief.

The Supreme Court has repeatedly recognized the authority of courts to permit the defendant to continue to engage in an activity determined to be infringing conditioned upon payment of a specified amount, either a lump sum or an on-going royalty, and/or satisfaction of other conditions the court deems reasonable under the circumstances.²¹ Courts should continue to develop guideposts for when such alternative relief should be granted.

Lower courts have thus far been reluctant to grant relief that permits a defendant to continue to engage in activity found to be infringing, even upon payment of a license fee. Such relief can be viewed as imposing a compulsory license and as encouraging infringement on a theory that putative defendants will calculate the risks differently *ex ante*. We do not believe that this result necessarily follows from the availability of the alternative remedy. If courts effectively articulate the situations in which alternative relief may be imposed, the possibility of such alternative relief being awarded will not result in encouraging egregious infringement. On the contrary, the real possibility of such alternative relief in appropriate cases should, in fact, lead to more appropriate bargaining between the copyright owners and the putative infringers.

Alternative relief may be appropriate in a number of situations. Consider, for example, a case in which a defendant has used a copyrighted work without authorization in the creation of a new work, but the copyrighted work is only a small part of the work while other factors played more significantly in the creation of the new work. In such situations, it may be appropriate for a court to permit continued exploitation of the new work upon payment to the copyright owner. The ability of the copyright owner to threaten court-ordered cessation of further exploitation of the new work may create an inappropriate hold-out potential that can skew negotiations in settling the dispute. On the other hand, it would be appropriate for a copyright owner to use such a hold-out potential against a putative defendant who is using the copyrighted work in its entirety, without authorization, with little or no added authorship.

Cases involving close questions of substantial similarity or fair use cases may also be cases in which, even though the court has determined there is infringement, an injunction against further use is inappropriate. This would be particularly appropriate when the case implicates free speech/free

21. *See, e.g.,* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 578, n.10 (1994).

expression concerns. It is important, however, that the availability of such alternative relief not affect the determination of the infringement which is, and should remain, a separate inquiry. A defendant's intent, and in particular, a lack of awareness of copying, should also factor into a court's willingness to impose alternative injunctive relief.

Alternative relief may also be appropriate in cases where there is a collective action problem or a market failure due to high transaction costs which leads to a difficulty in clearing all of the rights necessary from a multitude of copyright owners. Again, the power possessed by one copyright owner to put an end to a much larger project as a result of the entry, or even mere threat of entry, of a complete injunction may lead to the cessation of a project, or even prevent the inception of such a project, due to the disproportionate leverage one copyright owner may be able to exert.

In determining whether to enjoin the infringing activity or to permit the activity conditioned upon the payment of a license fee or other conditions, the court should consider relevant factors, such as

- (1) the public benefit of the use engaged in by the defendant;
- (2) the additional authorship added to the infringing work by the defendant;
- (3) the close nature of the substantial similarity inquiry;
- (4) the strength of the defendant's unsuccessful fair use or other defenses;
- (5) the plaintiff's non-economic motivations for seeking injunctive relief; or
- (6) the defendant's intent.

A court should also consider the potential for the leverage power of a complete injunction to be disproportionate to the level of benefit gained by the defendant in using the copyrighted work and to the level of harm to the plaintiff caused by such use.

In determining the appropriate monetary compensation that would allow the defendant to continue to engage in infringing activity, it may be appropriate for the award to reflect compensation for only the amount copied that is in excess of fair use or in excess of otherwise permissible copying (e.g., in a close question of substantial similarity). Finally, it is important to be sensitive to the incentive effects that such an alternative to injunctive relief may cause. It may be appropriate in certain cases to require payment of a licensing fee that is in excess of what a reasonable royalty would have been, had it been negotiated prior to the infringing activity.

G. PUBLIC DOMAIN REFORMS

Recommendation #14: Once information resources become part of copyright's public domain, they must remain in the public domain.

The public domain encompasses many information resources that are not subject to the exclusive rights of copyright. Public domain resources are generally available for free use by all, although contract law can sometimes be used to control access and use of these resources, subject to copyright law's preemption doctrine. In the American context, bedrock principles of freedom of expression and freedom of competition, as well as the constitutional objective of promoting the progress of science, underlie the policy of copyright's public domain. Because of this, we think that information resources that are in copyright's public domain should remain so.

Creative works and information resources can become part of the public domain in several different ways. Some creations, such as the design of useful articles (e.g., a chair), are ineligible for copyright protection in the U.S. and hence are in the public domain upon their disclosure to the public (unless they are patented). Some works, such as the white pages of telephone directories, lack a creative spark that would satisfy copyright's originality standard; upon publication, they become public domain resources as well. After expiration of copyright terms, works of authorship join other unprotected works in the public domain. Many works created before 1989 are also in the public domain for failure to give proper notice of copyright claims. Even works protected by copyright contain information, ideas, principles, and the like that are in the public domain.

Recommendation #15: Copyright law should make it easy for copyright owners to dedicate their work to the public domain.

Copyright's public domain can also include works of authorship whose rights holders have chosen to dedicate the work to the public domain. Scholars might, for example, be interested in making their out-of-print books freely available in a digital library. Public domain dedication is not expressly provided for by the current Copyright Act, although it has been recognized by the courts. To make such a dedication requires an overt affirmative act or statement by the copyright owner from which an intent to surrender copyright is manifest.

While judicial recognition of public domain dedications should continue, it would be desirable for there to be a statutory provision making it easy for copyright owners to achieve this goal. Once a copyright owner has dedicated her work to the public domain, it is and must remain free from exclusive rights control. The copyright statute should make clear that public domain

dedication is not a transfer of copyright that is subject to copyright's terminations of transfer rules.

H. COPYRIGHT LIMITATIONS AND EXCEPTIONS

Recommendation #16: More elements in copyrighted works than just ideas and information should be excluded from the scope of copyright's protection for original works of authorship.

Important limitations on copyright law are set forth in Section 102(b) of the 1976 Copyright Act. This provision is a partial embodiment of good copyright principles insofar as it characterizes ideas, concepts, and principles, along with procedures, processes, and methods of operation, as unprotectable elements of copyrighted works.

We recommend an amended provision that is more reflective of the many types of elements of copyrighted works that copyright law does not and should not protect. Although we did not reach consensus on precise legislative language to accomplish this objective, this example illustrates the concept:

Copyright protection extends to an author's expression, but not to any (a) ideas, concepts, or principles; (b) facts, data, know-how, or knowledge; (c) stock elements typical in works of that kind; (d) laws, regulations, or rules; (e) systems, processes, procedures, methods of operation, or functions, regardless of how any of these elements may be embodied in protected works. Nor is copyright protection available to a work or an element of a work if there is only one or a very small number of ways to express that idea or other unprotectable element. Elements identified in (a) through (d) should be regarded as in the public domain and available for free copying and reuse when the work has been made available to the public such that it cannot be claimed as a trade secret. The elements identified in (e) may also be in the public domain after publication of a work in which they are explained or embodied unless protected by a utility patent.

Recommendation #17: Copyright law should recognize that there are more fair use purposes than is recognized in the current statute.

Another important limitation on U.S. copyright law is embodied in its fair use provision. Fair uses of copyrighted works are not infringements. The Supreme Court has recognized that fair use helps to mediate tensions that would otherwise exist between copyright and free speech and expression values.²² It also helps to ensure that second authors can build on pre-existing works so as to promote the progress of science. Fair use law, in fact, serves a

22. *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003).

wider variety of policies than this, and we think an improved fair use provision would more accurately reflect the range of social policy purposes for which fair use is often used in practice.

Fair use has often been found when:

- (1) a second author uses the first work to criticize it or create a parody, or otherwise transformatively recasts the work in the course of making a new work;
- (2) a second author productively uses some or all of an earlier work in the course of news reporting, teaching, scholarship, artistic expression, or the like;
- (3) a second author makes incidental copies that enhance access to information, such as by reverse engineering computer programs to get access to information necessary to create an interoperable program;
- (4) a competitor uses part of the author's work to engage in comparative advertising or otherwise to promote fair competition;
- (5) a person makes private non-commercial uses that do not compete with or otherwise undermine the author's market;
- (6) market failures prevent the development of a viable market for clearing rights;
- (7) administrative, legal, or other governmental use of the work is necessary to carry out legitimate government purposes;
- (8) courts are faced with a use not contemplated by Congress and where the fair use balancing process will result in an interpretation of the law consistent with copyright purposes.

The amount and substantiality of the taking and the likelihood of harm to the author's market should, as now, be given due weight in determining whether a use is fair or unfair.

Recommendation #18: Personal uses of copyrighted works should be privileged to some degree.

One difficult question that the CPP group discussed at length is how copyright law should treat personal use copying of copyrighted materials. We did not reach consensus on this issue. Some of us think that personal use should continue to be dealt with under the fair use rubric; others thought that exclusive rights should be drafted so that most personal use copying would not fall within the scope of the right; still others supported a carefully-crafted personal use exception. Creating some room for personal uses is consistent with the copyright principle endorsing meaningful limits on copyright owner control.

Several reasons can be proffered in support of an exemption of certain personal uses of copyrighted works from the realm of activities that copyright law regulates.

For one thing, copyright's main job is to provide authors with a means of controlling commercial exploitations of their works, as these are the acts by which copyright owners typically recoup their investments in producing their creative works. Personal uses, by definition, do not involve such exploitations.

Second, members of the public often express themselves through personal uses of copyrighted works—some of which may be transformative in nature and some non-transformative—and copyright law should respect user self-expression as well as the interests of authors in protecting their works.

Third, many, though certainly not all, personal uses happen in the privacy of a home, automobile, or other spaces as to which people have reasonable expectations of privacy. Respect for privacy interests support exempting personal uses from the scope of copyright.

Fourth, even leaving aside privacy concerns, it is generally infeasible to regulate personal uses of copyrighted works because it would be difficult and costly to enforce copyrights in spaces where personal uses take place.

Fifth, ordinary people do not think copyright applies to many common personal uses of copyrighted works and would not find acceptable a copyright law that regulated all uses they might make of copyrighted works. It would thus undermine the public's perception of copyright's legitimacy for it to extend to forbidding personal uses of protected works. If we want members of the public to respect copyright law and to abide by it, we should craft it to be a law that they will respect.

However, some copyright owners regard personal uses as implicating the same core reproduction right as commercial uses do. Insofar as there is a commercial demand for personal use copies, copyright owners may want compensation. For example, consumers typically pay one price for one copy of proprietary computer software and expect to pay more for extra copies for different machines, and certainly expect to pay additional sums for copies to be shared with friends. As copyright owners pursue new business models in a changed technological and economic environment, these new models may be focused on serving the personal use copy market. Motion picture studios, for instance, have begun to offer multiple home video release offerings, with additional copies of movies formatted for computers and portable devices among the enhanced features on premium discs. Rights holders perceive these and other offerings as fairly within the exclusive rights of copyright and directed toward markets that are reasonable and likely to be developed. They

also argue that adoption of a personal use exemption might well lead to higher prices for copyrighted goods to compensate rights holders for the extra copies purchasers may make, regardless of whether these purchasers actually make or value extra copies.

While there was no consensus within the group on how personal uses should be treated, we discussed at least four ways in which personal uses could be exempted from copyright: through a general personal use exception, a set of specific personal use exceptions, the fair use doctrine, and a careful crafting of exclusive rights.

Some nations (Japan and Switzerland, for instance) have personal use exemptions in their copyright laws. Article 30 of the current Japanese Copyright Act provides, “[i]t shall be permissible for a user to reproduce by himself a [copyrighted] work . . . for the purpose of his personal use, family use or other similar uses within a limited circle”²³ Some personal use exceptions in national laws require reasonable compensation in the form of levies on recording devices and/or blank media.

Other nations exempt certain specific personal uses but do not have a general personal use exception. U.S. copyright law, for example, exempts backup copying of computer programs and non-commercial consumer uses of analog and certain digital copies of recorded music under the Audio Home Recording Act (AHRA).²⁴ The fair dealing provisions of U.K. and Canadian copyright laws encompass some of what would fall within the penumbra of a general personal use exception. Some nations allow certain kinds of personal use copying but require payments of levies to recompense rights holders for this copying. The AHRA does this as well.

Although the United States does not have a general personal use exception, there is a reasonable consensus, at least among U.S. academics, that many personal uses would, if litigated to final judgment, be held fair and non-infringing uses of copyrighted works. Although there is very little copyright case law on personal use copying, the Supreme Court in *Sony Corp. of America v. Universal City Studios, Inc.*, ruled that making copies of movies shown on broadcast television for time-shifting purposes was a fair use, largely because of the private, non-commercial nature of the copying.²⁵ Backing up the contents of one’s hard drive would likely be fair use as well, even though there is no statutory exemption for doing so except as to computer programs. Some scholars have argued that other personal uses are

23. Copyright Act of Japan, Law No. 48 of 1970, art. 30.

24. Audio Home Recording Act, Pub. L. No. 102-563, 106 Stat. 4237 (1992) (codified at 17 U.S.C. §§ 1001–1010).

25. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

fair, although the precise scope of fair personal uses is contested. Of course, the fact that a use is personal does not, by itself, render the use fair; other factors must be considered as well.

Exclusive rights can also be crafted to leave personal uses unregulated. One could, for instance, limit exclusive rights so that they extended only to uses that are commercially harmful, as suggested above. Or authors could be granted a core exclusive right to disseminate their works to the public, which would leave personal uses outside copyright's scope.²⁶ U.S. copyright law already limits exclusive rights of performance, display, and distribution to those that are "public," seemingly immunizing, albeit implicitly, many personal use performances. A reproduction or derivative work/adaptation right might be designed to exclude personal uses by requiring a showing of intent to distribute the copies into the right (e.g., "reproduce a work in copies with the intent to distribute the copies"). It would be important to make more explicit the underlying policy reasons for leaving such personal uses unregulated.

There are several disadvantages to addressing the personal use issue through the fair use doctrine: First, it may be unpredictable, cumbersome, and expensive to adjudicate. Second, courts often give considerable weight these days to the "transformative" character of a defendant's use, leaving iterative personal use copying vulnerable to challenge. Third, fair use is arguably already doing too much work in U.S. copyright law, and exempting personal uses would relieve this law of one significant burden. Fourth, many forms of personal use do not cause copyright owners more than de minimis harm, and hence they will so often be fair uses that an exemption seems appropriate on that ground. Finally, an express personal use exception in copyright would demonstrate that the law conforms to reasonable public expectations and appropriately balances public and private interests.

Retention of fair use as a way of shielding personal uses would, however, be better than trying to name and write a specific rule as to every possible personal use that should be exempted, a task that seems impossible to perform well, especially given the fact that technology is constantly changing the realm of possible uses.

Recommendation #19: Copyright exceptions for libraries, archives, and museums should be updated to better enable preservation and other legitimate uses in light of ongoing technological change.

26. See, e.g., Paul Geller, *Beyond the Copyright Crisis: Principles for Change*, 55 J. COP. SOC'Y 168 (2008).

Libraries, archives, and museums are cultural institutions created to serve the public good by making books, journals, ephemera, artifacts, and other materials available in order to increase knowledge, taste, and culture and to enhance the ability of citizens to interact with the world around them. The public has a strong interest in the preservation of the cultural record. Libraries, archives, and museums have the institutional mission to perform this critical function. The public shares a similarly strong interest in access to works, information, and artifacts preserved by these institutions. Libraries, archives, and museums are generally willing to undertake this task only if they can make these preserved copies available to the public.

Copyright law should encourage libraries, archives, and museums to fulfill their missions, while also taking into account the effect of such policies on the market for copyrighted works. Providing access to copyrighted works, reproducing portions of works upon the request of a user so the user can make a non-infringing use of the material, and encouraging research and scholarship are critical not only to these institutions, but also to society. Moreover, these activities further the ultimate constitutional purpose to promote the progress of science.

Although the exact contours of library, archive, and museum exceptions need to be carefully defined, these institutions undertake many activities that copyright law should enable to some extent and with appropriate safeguards to protect the rights of copyright holders. These include the following:

- (1) reproducing copies of lawfully acquired copyrighted materials for the purposes of preservation and security;
- (2) curating and preserving collections of publicly available online content based on the needs and interests of local communities, and making them available to users;
- (3) replacing copies of lawfully acquired copyrighted works that have been lost or stolen or that are damaged or deteriorating;
- (4) converting the format of works when the equipment for perceiving the work is obsolete and the copyright holder has not distributed the work in the newer format;
- (5) making both preserved and replaced copies available to users under the same conditions as the original copies when original copies and replacement copies are not reasonably available; and
- (6) reproducing single copies of small portions of all types of works, regardless of format, for purposes such as scholarship, research, or private study, upon the request of a user.

In addition, libraries, archives, and museums should be able to outsource these privileged acts as long as adequate safeguards are in place to protect copyright owners.

Recommendation #20: Limitations and exceptions to copyright law ought to be based on principles, rather than being largely the product of successful lobbying.

An examination of the numerous exceptions and limitations to U.S. copyright law reveals an odd assortment of rules whose underlying normative justifications are not always easy to discern. Some exceptions and limitations do, we believe, have a principled basis, including the fair use and library provisions mentioned above, as well as the first sale limitation on copyright owner control of distributions of copies and exceptions allowing those engaged in non-profit educational institutions to perform copyrighted works in the course of instruction. Yet, it is puzzling that horticultural fairs have an exemption when other types of fairs do not. Several exceptions resolve inter-industry disputes (such as the exception for secondary transmission of broadcast signals by cable television systems) or establish compulsory licensing rules for situations when Congress has been convinced that market forces will not yield appropriate results.

While it is beyond the scope of the CPP inquiry to do a thorough review of exceptions and limitations of copyright and articulate the principled basis on which these provisions can be justified, we do think that future copyright reform efforts should undertake to articulate such principles.

I. ORPHAN WORKS LEGISLATION

Recommendation #21: Congress should limit remedies as to those who reuse in-copyright works whose rights holders cannot be found after a reasonably diligent search.

Copyright terms today are, in comparison with historical practices, exceptionally long—ninety-five years from first publication for corporate-authored works and life of the author plus seventy years for individually-authored works—owing to numerous copyright term extensions by Congress. Only rarely are works from the 1920s through 1960s still commercially available. Yet, copyrights may still be in force long after the commercial life of a work has ended. Many of these works do have considerable value, however, for historical and other research purposes, but reuses for these purposes are limited because of copyright constraints. Especially problematic are the inhibitions on reuses of these works when the rights holder cannot be located after a reasonably diligent search.

The U.S. Copyright Office has recognized this “orphan works” problem and has recommended legislation to enable those who make reasonable

efforts to locate rights holders to use them, both to make orphan works available in their original form (e.g., on a website containing historical documents) and to make derivative uses of them (e.g., a movie based on a short story from the 1930s).²⁷ This legislation would substantially limit remedies against good faith reusers if the owner of a particular work later comes forward. Works that are true orphans would be freely reusable by all.

The CPP supports legislation to allow reuses to be made of orphan works in line with the Office's recommendations. Until this legislation passes, we hope that courts will consider efforts to locate the appropriate rights holder and the out-of-commercial-circulation nature of works as part of their fair use analysis in cases involving the reuse of older works.

The orphan works problem should be significantly ameliorated if the copyright registration regime is substantially reinvigorated, as discussed above. A presumption might well be established that if a work has not been registered within a certain period of years (e.g., fourteen years after creation), it could be presumed an orphan and available for reuses. A later registration by the appropriate rights holder might preclude some future non-transformative uses, but this should not prevent a good faith reuser from enjoying the fruits of his or her own creation based upon use of an underlying work that he or she reasonably believed to be an orphan.

J. REFINING COPYRIGHT'S PREEMPTION DOCTRINE

Recommendation #22: Courts should be more careful in assessing federal preemption of contractual provisions and state statutory rights insofar as they alter the balance of user and copyright owner rights and insofar as their enforcement would frustrate the purposes of copyright law.

The U.S. Constitution provides that federal law is "supreme" over other laws. This has been interpreted to mean that when state law conflicts with federal law, either expressly or implicitly, or when state law attempts to regulate in a field in which the Constitution or Congress provides that federal law is exclusive, state law will be preempted. The Constitution gives Congress the power to grant exclusive rights to authors in their writings in order to "promote the progress of science." The founders' main purpose in giving Congress this power was to ensure that copyright law would be uniform throughout the nation. Copyright is thus a legal domain in which federal law is exclusive. States cannot, in other words, pass copyright laws of

27. See U.S. COPYRIGHT OFFICE, REPORT ON ORPHAN WORKS 92–127 (2006), available at <http://www.copyright.gov/orphan/orphan-report.pdf>.

their own. If they did, those state laws would be preempted by federal copyright law. The same preemption principle also applies insofar as state courts apply their laws in a manner that extends copyright-like protections to in-copyright works or to works or aspects of works that federal copyright law regards as unprotectable by copyright law, such as unoriginal compilations of data or news of the day. The federal preemption principle also applies when an interpretation of state law would frustrate the purposes of federal copyright law.

The CPP group discussed the inclination of some federal judges to brush aside arguments that enforcement of certain contract provisions should be preempted because they would frustrate copyright purposes. Some members think that judges too often act as though contract provisions cannot be preempted because the parties agreed to them and that a more serious analysis should be conducted. Other members think that the perceived problems with this judicial approach are more theoretical than real and that the proposed refinement risk undermining laudable uses of contract that make the copyright system work in practice.

Despite this lack of consensus, we have included the proposed preemption refinement here to advance the dialogue and study of this issue. Some factors that courts might usefully consider in determining whether preemption applies include the following:

- (1) the extent to which the contractual provision at issue alters the scope of protection copyright would otherwise provide;
- (2) whether the contractual provision accompanies a work that is published or otherwise publicly distributed;
- (3) whether the contractual provision is individually negotiated or part of a uniform, mass market license;
- (4) whether the idea or information that is the subject of contractual protection is otherwise readily available from other sources without similar contractual restrictions;
- (5) whether enforcing the contract would establish legal control over ideas or information that copyright leaves unprotected in ways that would unreasonably inhibit future authorship or create undue monopolization;
- (6) whether the contract would stifle the dissemination of new creative works, such as works that criticize or comment on existing works;
- (7) the copyright owner's purpose in including the challenged provision in the contract;

- (8) whether failure to enforce the contractual provision would frustrate efficient, practical enforcement of the copyright owner's rights; and
- (9) whether the contract would restrict access to works that are no longer protected by copyright.

These factors are not intended as a multi-part balancing test or for statutory codification, but rather as suggestions for some considerations relevant to resolving, through case-by-case development, the ultimate question of whether enforcing a given contract right in a given set of circumstances will frustrate copyright's purposes.

In the absence of meaningful judicial scrutiny, the balance of interests that copyright seeks to achieve may be vulnerable to disruption by license or other contractual conditions that inhibit activities that copyright law seeks to promote. Courts should, of course, not adopt categorical rules, such as one that would render unenforceable any term of a mass market license prohibiting use of a copyrighted work that otherwise would be a fair use. Instead, contractual provisions that forbid undertaking activities that copyright law would otherwise permit or that require action, such as giving attribution, that copyright law otherwise does not expressly require should be subject to implied preemption analysis in appropriate cases. That analysis could usefully focus on the factors suggested above. This principle respects the general freedom of contract and the role of state contract law in furthering copyright's purposes by supplying means for enforceable transfers or licenses of federal rights while also addressing the danger that contract law's flexibility can be abused to undermine copyright's purpose in particular instances.

We also recognize that some contracts that alter copyright's scope do not frustrate its purposes. Consider, for example, a contractual provision that prohibits the reverse engineering of software or the extraction and reuse of facts or ideas from a database or other works. Despite altering the scope of protection copyright provides, such contractual clauses do not in every case frustrate the purposes of copyright and may in fact promote them. For example, a software company may include a no-reverse-engineering clause in the contract that accompanies custom designed software which is distributed to only a single customer for purposes of evaluation. Or an author may include a "no copying of facts or ideas" clause in a contract that accompanies a script proposal. In each case, the clause at issue may prove material in ensuring that both the initial disclosure and the eventual public dissemination of the work occur. Rather than frustrating the purposes of copyright, using such complementary contract protections may further copyright's goals of encouraging authorship and the dissemination of original works.

Yet, inclusion of those clauses in contracts in different circumstances may pose a more direct threat to copyright's fundamental balance. Under copyright law, the copyright owner has the exclusive right to those aspects of her work that are both original and expressive. She does not, however, own every aspect of her work. Under copyright law, she does not have the exclusive right to the facts and ideas in her work, even where they are original. As a matter of policy, copyright leaves these aspects of a work unprotected and available for others to use both to avoid undue monopolization and to leave room for future authorship.

Allowing state contract law to restrict reuse of facts and ideas through contracts that bind everyone with access to the work may disrupt the balance copyright strikes between what an author owns and what she does not. Later authors could not as readily write their own works, or publish competing works, if they faced a plausible threat of breach of contract suit under state law whenever their works happened to include or explore some of the same facts or ideas found in an earlier work. In such a case, enforcing under state law a contractual prohibition on copying or reverse engineering would frustrate copyright's purpose of leaving room for future programmer authorship and competition.

Enforcement of state law contract rights might frustrate copyright's purposes in other circumstances as well. For example, a defining and constitutionally required feature of copyright is that it has a limited term. Attempts to extend copyright's term through the use of contractual restrictions on use and copying would fundamentally alter the balance that copyright strikes. Additionally, copyright, through the fair use doctrine, seeks to promote new works that comment, critique, or parody existing works. Attempts to limit criticism, comment, or parody through contractual provisions may impede the creation of such works and frustrate copyright's purposes.

K. REFINING THE SPECIALLY COMMISSIONED WORK FOR HIRE RULES

Recommendation #23: Contributions to computer programs should be considered as a new category of specially commissioned work eligible for treatment as works made for hire.

U.S. copyright law has special rules for vesting copyrights when works have been made "for hire." When a work has been created by an employee within the scope of his or her employment, U.S. law treats the employer as "the author" of the work, and the copyright automatically vests in the employer. We do not suggest any change to current law with respect to this kind of work for hire.

A second type of work for hire arises when someone who is not in an employment relationship with the putative author commissions the latter to create a work or contribute to a work, as long as the commissioned party agrees in a signed writing that the commissioned work should be treated as a work for hire in which the commissioning party will own the copyright.

Current law provides that only nine types of works, such as contributions to motion pictures, to encyclopedias, and to atlases, are eligible for treatment as specially commissioned works for hire. It is somewhat difficult to discern a principled basis for the nine categories established in the law. But the qualifying works seem generally to have in common that they involve collaborations among more than a small number of individual contributors for the purpose of preparing one work that would most efficiently be made available by one copyright owner who holds all of the rights. The one rights holder is best situated to coordinate the contributions, supervise creation of the final product, and make the whole work commercially available to its intended audience.

One advantage of treating specially commissioned works with multiple contributors as works for hire is that the works' copyright term will be more certain than if each contributor was considered a joint author (the last surviving contributors might die decades after others, contributing to uncertainty about duration). Such works can also still be exploited without risk that one contributor would terminate the transfer after thirty-five years and make the work as a whole unavailable to future users.

By limiting the classes of works for which the specially commissioned work for hire rule is available, Congress clearly intended—and we agree this is appropriate—that works prepared by independent contractors should not be treated as works for hire. Independent contractors may well assign their rights to a commissioning party, but they are entitled to terminate this transfer during the window of time that U.S. copyright law permits terminations.

Our discussion of the specially commissioned work for hire category led us to articulate the above rationales for this rule. We also considered whether any new categories of specially commissioned works should be added to this rule. There was interest among CPP members in the possibility of adding computer programs as a tenth category of specially commissioned works for hire, as the rationale above would seem to support this in situations in which independent programmers were contributing parts to a large program.

That software was not initially included in the list of eligible specially commissioned works has historically not been a serious problem since software often has an economically useful life of something less than thirty-five years. Notwithstanding that fact, many firms now instruct that the

development of certain software must be done by employees to avoid the termination of transfer problem, which creates its own problems. As the software industry continues to mature, however, it is becoming more common for software to include bits and pieces of code that are more than thirty-five years old (for example, in mainframe operating systems). The fact that efficient creation of software has pushed vendors to create increasingly modularized systems that reuse components will only increase the presence of older software in the newest products. Moreover, economic exigencies have encouraged manufacturers to increasingly hire third parties for important pieces of software. The economic ramifications of allowing programmers to terminate their copyright interest in a valuable piece of software could be significant, leading to increased costs or, worse yet, interruption of its continued use.

There may well be other categories of works that should also be considered for inclusion in the work for hire exception, and we discussed whether a procedure should exist for adding new categories to this rule. We considered, for instance, whether the U.S. Copyright Office should be given rule-making authority to add computer software contributions or other types of works to the specially commissioned work for hire rule. We did not reach consensus on this approach.

An alternative approach to the list of specific types of works eligible for the specially commissioned work for hire rule would be to allow all works to be eligible for this treatment as long as there was a contract reflecting an agreement on the work-for-hire issue between the commissioning and commissioned parties, and so long as that contract was not unconscionable and enforcement of its terms would not offend public policy. The proposed limit on enforceability would recognize that the author/creator and the commissioning party may be in unequal bargaining positions and the commissioning party may try to dictate terms that exploit that difference in an unfair manner. However, there was little support within the CPP group for this approach, as unconscionability is very difficult to prove. This policy is also inconsistent with congressional choice in 1976 of allowing independent contractors to recapture transfers of copyrights through termination after a period of years.

L. REFORMING TERMINATION OF TRANSFER RULES

Recommendation #24: Termination of transfer rules should be revised to make them less formalistic.

Since at least 1831, Congress has provided some mechanism by which an author or his heirs could reclaim ownership of a copyright at some point even though it had been transferred to another person. Initially, this was

achieved by providing authors with an opportunity to claim a second term of copyright protection, even if they had assigned rights under the first term to another person. Current law achieves a similar goal through rules allowing authors to terminate assignments or licenses to others after thirty-five years.

Copyright's reversion mechanism has some important advantages. Copyrighted works may be long-lived. New and often unforeseeable ways to use those works are likely to arise over the life of the copyright. It is often difficult for authors to bargain effectively about unforeseen future exploitations. As a result, authors may systematically be unlikely to share (or to share fairly) in the benefits that new technological means of exploitation create. When new media arise, reversion may allow authors to exploit their works in those new media when their grantees, particularly if they are old-media incumbents, may not be willing or well positioned to do so. Reversion may allow for clarification and consolidation of rights in new media. If contracts are unclear as to who has rights in the new media (as is often the case), then reversion of rights to the author would usually clarify that the author (or her successors) has those rights and can upon reversion clearly grant them.

The current mechanism for reversion is a termination of transfer procedure, which applies to all post-1977 transfers by authors to others. This mechanism is so cumbersome and complicated that most authors will not realistically have a meaningful opportunity to terminate these transfers. Termination can be effected only during a five-year window. Calculating the dates on which that window opens and closes can be difficult, so authors may inadvertently miss opportunities to terminate. Indeed, in some cases an author may only learn of her termination right after the window has closed and the right has expired. In addition, the requirement that notice of termination be served not more than ten, and not less than two, years before the effective date of termination may also cause some authors to lose their ability to terminate a transfer through mistake or inadvertence.

When an author has died before the termination window arrives, the current system permits termination by statutorily-specified successors (generally a surviving spouse, children, or grandchildren). But because the statute divides the termination interest among the successors it names and then requires majority action by those interest holders in order to terminate a transfer, it creates opportunities for deadlock and miscalculation. The statute repeats those problems when it requires that those holding the divided interests in the terminated rights again act by a majority to make any further grant of those rights; in that situation, the danger of deadlock poses the risk that the reclaimed rights will not be regranted at all, potentially diminishing the use of the work.

The termination of transfer provisions of current law were the subject of considerable discussion at CPP meetings. We were able to reach consensus that the existing rules are too complicated and formalistic, and that some reform of them would be beneficial. But when it came to specific proposals to improve these rules, there was substantial disagreement.

There was some sentiment in favor of elimination of termination rights altogether, in part because current provisions are too complicated to be useful to most authors, and in part because termination reflects a paternalistic effort to protect authors. Others preferred to reform termination in order to create a simplified copyright reversion mechanism that would be easier for authors to actually use.

One example of a simpler termination mechanism is to limit the termination right to the author himself during his lifetime. Under one implementation of this approach, the author would have an unwaivable, inalienable right during his lifetime to terminate a copyright grant after some period of years after that grant. But only the author would have the power to terminate a transfer. After the author's death, the statutory termination right would be unavailable.

Because this approach would allow only the author to terminate, those favoring this approach thought that the opportunity to terminate should become available at a much earlier date than under current law. Fifteen or twenty years after a grant could well be an appropriate time at which the termination window would open. Marketing cycles for many different sorts of works have gotten much shorter in the three decades since Congress enacted the 1976 Act, and new media offering unforeseen opportunities for exploiting older works are emerging more frequently.

Even after a termination occurred, the grantee or the grantee's successor in interest should be permitted, as under current law, to continue to exploit any existing adaptation/derivative work according to the terms of the terminated grant. Perhaps it would even be appropriate to offer more protection to a grantee's interest in derivative works by expanding this privilege so that the grantee would also retain a non-exclusive license to prepare new derivative works under the terms of the terminated grant.

The reversion approach discussed here would retain many features of the current termination provisions. For example, termination rights would be unavailable as to works made for hire. In addition, an author could terminate both transfers and grants of non-exclusive licenses, and termination would not be automatic. Any termination would affect only rights arising under U.S. copyright law and not other rights that the author may have transferred. But the most cumbersome aspects of the current termination system would be

altered to make it easier for authors to terminate their transfers if they wish to do so.

Although we were not able to reach consensus on specific reforms to the termination of transfer rules, we have taken the trouble to set forth several ideas on which we deliberated, as they may be informative for future conversations about terminations of copyright transfer rules.

M. EXTENDING ATTRIBUTION RIGHTS TO MORE THAN VISUAL ARTISTS

Recommendation #25: Serious consideration should be given to extending to authors of works, other than those made for hire, a right to be identified as authors of their works.

Being properly identified as the author of literary and artistic works is an interest that predates the emergence of the formal regime of copyright, which has focused mainly on the grant of economic rights to control the making and dissemination of copies of protected works. Attribution is a norm in many cultures and legal systems and is reflected in a variety of ways, including through well-established norms against plagiarism. A modern manifestation of this interest is the widespread use of Creative Commons licenses that require reusers of CC-licensed works to acknowledge the authorship of the reused work.

Attribution interests of authors are recognized in the Berne Convention for the Protection of Artistic and Literary Works, which the United States joined in 1989. Article *6bis* of that treaty says: “Independently of the author’s economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work.”²⁸ This right is supposed to last for the author’s lifetime and under Berne, should be maintained “at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed.” Although attribution interests are sometimes protected in the United States by contracts, union rules, state laws, fair use rulings that take into account whether authorship attribution has or has not been acknowledged, or laws protecting against misrepresentations and deception, U.S. copyright law has not yet provided general protection to authors as to their attribution interests.²⁹

The CPP group debated at some length whether U.S. copyright law should extend the right of attribution to authors more generally. An

28. Berne Convention for the Protection of Literary and Artistic Works art. *6bis*, Sept. 9, 1886, 1 B.D.I.E.L. 715.

29. See 17 U.S.C. § 106A (2006) (granting rights of attribution and integrity only to authors of works of visual art).

attribution right would serve two main purposes. One would be to bring U.S. law into greater compliance with the Berne Convention. A second would be increased legal recognition of authors' desires to be given credit for their creations, particularly in circumstances in which others make legal but unlicensed uses of their works. Many of us favored such an extension of rights, but we also recognized that doing so would require resolving a thicket of practical issues. Hence, our recommendation is for serious consideration to be given to general recognition of a right of attribution for authors of copyrighted works, other than those created as works made for hire.

Among the important practical questions are these: First, must the name of the author appear on each copy of a work? Many countries have adopted reasonableness limits on the attribution right, which would allow consideration of factors such as the context in which a work appears, business practices and exigencies affecting attribution, and whether the work was so well-known as to be, in essence, self-attributing. A reasonableness limit would ensure that an attribution right would not be too zealously or mechanistically applied.

Second, should the law protect against misattribution (i.e., allowing an author to insist that a work not be attributed to her)? The misattribution interest might be protectable under principles of tort law. It is worth noting, however, that the Supreme Court has ruled that a reuser of a public domain work did not violate a false designation of origin law when it made and sold copies of that work without attributing authorship to the owner of the now-expired copyright.³⁰

Third, should the attribution right be waivable by contract? Granting an attribution right to authors may not effectively protect that interest if authors will routinely be subject to demands for waiver by those in negotiating positions far stronger than most creators, thereby undermining and possibly eviscerating the right. Counterbalancing that concern, however, is the strong U.S. policy in favor of freedom of contract. Research should be conducted to determine if there are some legitimate interests of commercial exploiters of protected works in allowing the work to be made available without attribution.

Fourth, should the right of attribution be available to all categories of works, or should there be some exclusions (e.g., for computer software)?

Fifth, what remedies should be available for violation of the attribution rights? It may be difficult to assess damages caused by failure to attribute

30. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

authorship. Carefully tailored injunctions may be an important remedy to address non-attribution and misattribution problems.

Sixth, should an attribution right be limited to the life of the author, as it is under the Visual Artists Rights Act, or extended to the full copyright term, in keeping with other exclusive rights and the Berne Convention?

IV. CONCLUSION

In numerous respects, copyright law today serves well the interests of authors, those to whom authors assign or license their rights, and the public, but in some important respects, this law is askew. The last few decades have witnessed dramatic changes in the copyright landscape, especially with the advent of global digital networks and technological tools that are widely used to access and interact with copyrighted content, so it is not surprising that courts and Congress have found it difficult to adapt the law in a coherent and principled way. This project addresses those changes and difficulties and the ways in which current copyright law does not serve well the interests of those it affects. By articulating principles of a good copyright law and examining existing U.S. copyright law in light of those principles, members of the CPP have sought to achieve two main goals. The first is to explain the normative grounding of particular copyright rules that do comport with these principles. The second is to offer recommendations for change so that copyright law can better be adapted to meet the challenges of the day in a way that is principled and balanced, and that would command respect from the public as well as from copyright owners.

THE UNTOLD STORY OF THE FIRST COPYRIGHT SUIT UNDER THE STATUTE OF ANNE IN 1710

H. Tomás Gómez-Arostegui[†]

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† Associate Professor of Law, Lewis & Clark Law School. This article was first presented during a conference at the University of California, Berkeley School of Law, celebrating the 300th anniversary of the Statute of Anne. It later benefited from comments received during an IP workshop at the University of Michigan Law School. I would like to thank Isabella Alexander, John Barnard, Hamilton Bryson, Brienne Carpenter, David Levy, Nancy Mace, Joe Miller, Mark Rose, and Simon Stern for their comments on earlier versions of this article or for otherwise assisting in its preparation. Special thanks are due to Maureen Bell, who has been incredibly generous in reviewing my article and sharing her knowledge of the book trade with me. Susanne Jenks came to my aid several times, helping me track down documents in London when I was away. Rachel Cosgrave of Lambeth Palace Library, Liz Hore and Tim Padfield of the National Archives, Andrew Mussell of Gray’s Inn, and Jane Ruddell of the Mercers’ Company were also gracious and helpful in addressing my many questions. As always, I owe much to Lynn Williams’s ability to track down difficult-to-find sources. Research at the National Archives, Parliamentary Archives, London Metropolitan Archives, Guildhall Library, British Library, Lambeth Palace Library, and Cambridge University Library was made possible by a gift from Kay Kitagawa and Andy Johnson-Laird. I thank them both for their generous support. Documents from the National Archives are crown copyrighted and reproduced here with permission.

I also must acknowledge the following incredibly valuable findings aids prepared by bibliographers and book historians. See WILLIAM T. MORGAN & CHLOE S. MORGAN, A BIBLIOGRAPHY OF BRITISH HISTORY 1700–1715 (1934–1942); F.F. MADAN, A CRITICAL BIBLIOGRAPHY OF DR. HENRY SACHEVERELL (W.A. Speck ed., 1978); WILLIAM P. WILLIAMS, INDEX TO THE STATIONERS’ REGISTER 1640–1708 (1980); D.F. MCKENZIE & MAUREEN BELL, A CHRONOLOGY AND CALENDAR OF DOCUMENTS RELATING TO THE LONDON BOOK TRADE 1641–1700 (2005); ALISON SHELL & ALISON EMBLOW, INDEX TO THE COURT BOOKS OF THE STATIONERS’ COMPANY 1679–1717 (Robin Myers ed., 2007). References to “ESTC Nos.” are to books in the English Short Title Catalogue, <http://estc.bl.uk>.

The bill of complaint in *Tonson v. Baker* remains in relatively good condition today, despite being 300 years old. Nevertheless, it does suffer from a large fungal stain, making some parts of the text difficult to read under ordinary light. I would like to thank Mr. Johnson-Laird for training me in a special UV photographic technique, and Kostas Ntanos at the National Archives for permitting me to utilize it, which revealed all in the bill.

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I. INTRODUCTION

Three hundred years ago, on April 5, 1710, the Parliament of the Kingdom of Great Britain enacted a statute that ushered in the modern form of copyright law. The Statute of Anne, as it is often called, promised authors of new books a copyright of fourteen years from publication, with a possible second term of the same duration.¹ A milestone, the statute was the first dedicated exclusively to copyright and the first to mention authors as beneficiaries by name. It was also the first to express (though not necessarily achieve for over sixty years) a utilitarian rationale for copyright—*viz.*, that a

1. Statute, 1710, 8 Ann., c. 19.

limited monopoly would be given to encourage authorship. That rationale formed the bedrock for the Anglo-American legislation that followed.

This is the story of *Tonson v. Baker*,² the first lawsuit filed under the statute. Brought in the Court of Chancery three months after the statute went into effect, *Tonson* is a fascinating suit that has not received the attention it deserves. The case was never reported and as a consequence has been largely inaccessible and overlooked by those studying the field of copyright history.

Tonson pitted the most famous publisher of the day, Jacob Tonson Sr., a strong proponent of copyright protection, against a gang of notorious book pirates led by John Baker, a publisher known for dealing in books (many of them dangerous) on behalf of outspoken but anonymous authors, including Daniel Defoe. The dispute centered around the right to print the trial proceedings of Henry Sacheverell, Doctor of Divinity, who had been impeached by the House of Commons and tried in the House of Lords for high crimes and misdemeanors. Tonson received the exclusive right to print the trial from the Lords in March 1710, and later registered his forthcoming work pursuant to the statute in June. One month after Tonson published his account, Baker published his own book on the whole Sacheverell affair. Baker's edition copied the trial portions directly from Tonson's.

The suit was over soon after it started and never led to a decree or judgment. But it nevertheless remains important because, among other things, the suit offers contemporaneous evidence of how book pirates reacted to the Statute of Anne, how the greatest publisher of the period interpreted the statute immediately after its enactment, and how the Court of Chancery handled the preliminary stages of an early copyright lawsuit. It also demonstrates that, contrary to the hopes of right holders, the statute could not and did not instantaneously halt book-trade piracy. Moreover, as part of the dissection of *Tonson v. Baker* and its antecedents, other important and previously unknown facts about copyright before the arrival of the statute are revealed. We learn, for example, that Baker may have been the impetus for the parliamentary petition that led to the Statute of Anne. And we also discover that Baker convinced the Court of Chancery in another case filed just before the statute that courts of equity had no power to award the disgorgement of a defendant's profits earned from copyright infringement.

This Article has three components. The first, and largest, reconstructs the lawsuit and the circumstances surrounding it from the ground up. The objective has been to create the fullest account possible from the surviving records. To do so properly required several trips to London to review

2. C9/371/41 (Ch. 1710).

materials stored at the National Archives, Parliamentary Archives, London Metropolitan Archives, Guildhall Library, and British Library, among other places. I have also consulted sources from repositories in the United States. Though the number of court records from the suit is meager, over 100 other manuscript sources, and hundreds of published primary sources, have made it possible to breathe new life into the dispute, the litigants, and even the lawyers. This account thus extends far beyond the legal machinations of *Tonson v. Baker*. It also embraces the London book trade of the period and includes rich portraits of the major players in this infringement drama.

The second component demonstrates why copyright history, including the Statute of Anne and *Tonson v. Baker*, still matters today. I use the statute and *Tonson* as historical examples to help critique the Supreme Court's decision in *Feltner v. Columbia Pictures Television, Inc.*³ There, the Court held that litigants have a constitutional right to a jury trial on all issues relating to statutory damages under the Copyright Act of 1976, including on the willfulness of the infringement and the amount of the award. Though the Court reached the correct outcome, it committed some errors in its analysis of English law. Most importantly, the Court, the litigants, and the amici curiae failed to spot the easiest way to demonstrate that the 18th century analogue to statutory damages—*viz.*, the penalties available under the Statute of Anne—could only be had at law, and was thus subject to a jury trial. The errors do not inspire confidence in the Court's ability to investigate the historical antecedents that it often says are so important to modern doctrine.

Lastly, given the inaccessibility of *Tonson*, I have included an appendix in which I transcribe all the pertinent manuscript documents.

II. THE REGULATORY FRAMEWORK TO 1710

Much has already been written about the Statute of Anne and the history of British copyright law before 1800.⁴ Those prior works obviate the need to

3. 523 U.S. 340 (1998).

4. The principal surveys of the subject are, in order of their appearance, AUGUSTINE BIRRELL, *SEVEN LECTURES ON THE LAW AND HISTORY OF COPYRIGHT IN BOOKS* (London, Cassell & Co. 1899); HARRY RANSOM, *THE FIRST COPYRIGHT STATUTE* (1956); BENJAMIN KAPLAN, *AN UNHURRIED VIEW OF COPYRIGHT* ch. 1 (1967); LYMAN RAY PATTERSON, *COPYRIGHT IN HISTORICAL PERSPECTIVE* (1968); Joyce Helene Brodowski, *Literary Piracy in England from the Restoration to the Early Eighteenth Century* (1973) (unpublished D.L.S. dissertation, Columbia University); Howard B. Abrams, *The Historic Foundation of American Copyright Law: Exploding the Myth of Common Law Copyright*, 29 WAYNE L. REV. 1119 (1983); MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* (1993); JOHN FEATHER, *PUBLISHING, PIRACY AND POLITICS: AN HISTORICAL STUDY OF COPYRIGHT IN BRITAIN* (1994); BRAD SHERMAN & LIONEL BENTLY, *THE MAKING OF*

re-examine the subject here, but it helps to summarize the regulatory framework that preceded the statute as well as the relevant terms of the statute itself. This backdrop places *Tonson v. Baker* in the proper context. Moreover, some of what appears below is based on new research and has not been treated elsewhere.

A. BEFORE THE STATUTE OF ANNE

It has often been said that the Statute of Anne was the first copyright statute. This is true insofar as we use the term “copyright” in its more modern sense. But the Statute of Anne was not the first system to regulate copyrights, nor was it the first statute to do so. Before 1710, there were several sources of exclusive printing rights, some regulated by statute, some not, and some that even went by the terms “copy right” or “copyright.”

1. *Royal Privilege*

The most established exclusive right to print was a *Royal Privilege* which the Crown granted on petition by letters patent and sometimes solely by license to a publisher, printer, or (less often) an author.⁵ Privileges were either work specific or gave the holder the right to print and sell a whole class of works. Most privileges were for a term of years or for the life of the grantee, but due to renewals and reversions, many privileges (especially class patents) were effectively perpetual. One of the most valuable class patents—granted to the Company of Stationers for the printing of primers, psalms, almanacs, and the like—was perpetual by its own terms.⁶

The earliest printing-patent disputes were adjudicated in the Court of Assistants of the Company of Stationers, where they were arbitrated, as well as in the Court of Star Chamber and the Court of High Commission, where they were litigated.⁷ In the years before 1710, printing patents were also

MODERN INTELLECTUAL PROPERTY LAW (1999); RONAN DEAZLEY, ON THE ORIGIN OF THE RIGHT TO COPY (2004); Oren Bracha, *Owning Ideas: A History of Anglo-American Intellectual Property* ch. 3 (June 2005) (unpublished S.J.D. dissertation, Harvard Law School); ISABELLA ALEXANDER, *COPYRIGHT LAW AND THE PUBLIC INTEREST IN THE NINETEENTH CENTURY* (2010).

5. Arnold Hunt, *Book Trade Patents, 1603–1640*, in *THE BOOK TRADE & ITS CUSTOMERS 1450–1900*, at 27, 38, 40–54 (Arnold Hunt et al. eds., 1997); Shef Rogers, *The Use of Royal Licenses for Printing in England, 1695–1760*, 1 *LIBR.* 133, 148–53 (7th Ser. 2000).

6. Hunt, *supra* note 5, at 45.

7. H. Tomás Gómez-Arostegui, *What History Teaches Us About Copyright Injunctions and the Inadequate-Remedy-at-Law Requirement*, 81 *S. CAL. L. REV.* 1197, 1250–62 (2008).

upheld and enforced at law in the Courts of Common Pleas and King's Bench⁸ and as part of favorable decrees in equity in the Court of Chancery.⁹

2. *Parliamentary Privilege*

A second exclusive right stemmed from *Parliamentary Privilege*, a subject that is not usually treated in works on copyright history because of its relative obscurity. This type of privilege is particularly important to the recounting of *Tonson v. Baker*. Each House in Parliament—the Commons and the Lords—claimed to hold in its corporate capacity a right to control the publication of its votes, speeches, debates, and proceedings. No person was permitted to publish these matters, not even members themselves, unless expressly permitted or appointed.¹⁰

Both Houses granted permission to print matters from their proceedings from time to time.¹¹ In the course of doing so, the Houses often made the right exclusive to a particular person or group of persons, either by naming the person or nominating another to do so. In this way, the Houses granted a form of copyright. For example, when trials occurred in the House of Lords, the Lords sometimes ordered that the proceedings be printed and that the Lord Chancellor in his capacity as Speaker or Lord Steward should choose the printer.¹² This form of privilege offered a broader protection than ordinary copyrights. Works created independently of the right holder's work were still prohibited. The printing rights recorded in the journals of Parliament state no expiration date; it is therefore unclear whether the appointed publishers were given a right to print the work *ad infinitum*, for a single printing run only, until replaced by another publisher, or otherwise.

Both Houses of Parliament considered a breach of privilege to be contemptuous and punishable by some combination of censure, arrest, commitment until the end of a parliamentary session, or destruction of the

8. *E.g.*, *Stationers v. Marlowe*, 1 Lilly's Mod. Entries 63, *cit.* 2 Show K.B. 261 (C.P. 1680); *Stationers v. Wright*, *cit.* Skinner 234–35 (K.B. 1683/4).

9. *E.g.*, *Hills v. Lee*, *sub nom.* *Hills v. Wright*, C33/261, ff. 282^v–283^r (Ch. 1683/4); *Stationers v. Lee*, *sub nom.* *Stationers v. Wright*, C33/262, f. 260^{r-v} (Ch. 1683/4).

10. *E.g.*, 7 H.C. JOUR. 638 (Apr. 13, 1659); 16 H.L. JOUR. 391 (Feb. 27, 1698/9).

11. *See generally* SHEILA LAMBERT, *PRINTING FOR PARLIAMENT, 1641–1700* (1984); *Orders to Print, House of Lords, 1640–1800* (F.W. Torrington & J.C. Sainty eds., 1972), *Parliamentary Archives BOOK/3371* (typescript).

Similar printing privileges were exercised by others, such as the Lord Mayor who claimed a right to control the printing of proceedings held at the Old Bailey. *See* Michael Harris, *Trials and Criminal Biographies: A Case Study in Distribution, in SALE AND DISTRIBUTION OF BOOKS FROM 1700*, at 1, 7–15 (Robin Myers & Michael Harris eds., 1982).

12. *E.g.*, 13 H.L. JOUR. 709 (Dec. 9, 1680); 15 *id.* at 216, 272 (Feb. 6, Mar. 3, 1692/3); 16 *id.* at 429 (Mar. 31, 1699).

offending books.¹³ Breaches were usually handled within one or both Houses or by a committee on privileges.¹⁴ Parliament regularly censured persons for printing proceedings without leave, at least when it was politically convenient to do so, but the offense was usually the publication per se, and not that the person had published matters that had already been exclusively assigned to another. This occurred, for instance, in 1698/9, when the Lords censured John Churchill, a bookseller, for publishing case reports from the House of Lords without permission.¹⁵ There are other examples before 1710.¹⁶

3. *Stationers' Copyright*

A third exclusive printing right also originated from the Crown, but it stemmed from a royal charter granted in 1557 to the Company of Stationers, the guild governing printers, booksellers, and others in the book trade. Internal customs of the Company established a system whereby a *Stationers' Copyright* would presumptively inure to a member who had registered a book, so long as that book was not already protected by a privilege or prior registration. The exact contours of the custom and what a Stationer was required to do to obtain exclusive printing rights varied over the years.¹⁷ But registration was countenanced by the Star Chamber in 1637,¹⁸ and remained central thereafter (if not already before), as was illustrated by the following lawsuit from 1657:

[T]he usage amongst the Society of Stationers being that when a Coppy is Entred in any Members Name the same Cannott be printed by any other member unlesse hee in whose Name it be soe Entred will dispence therewith & Authorize the Warden of the

13. THOMAS ERSKINE MAY, *A TREATISE UPON THE LAW, PRIVILEGES, PROCEEDINGS AND USAGE OF PARLIAMENT* 49–50, 56 (London, Charles Knight & Co. 1844).

14. MAURICE F. BOND, *GUIDE TO THE RECORDS OF PARLIAMENT* 124 (1971).

If the book contained a seditious libel—a concept broadly construed—the Houses might choose to instead refer the matter to the Attorney General to prosecute the offender at law. CARL F. WITTKÉ, *THE HISTORY OF ENGLISH PARLIAMENTARY PRIVILEGE* 31 (1970).

15. 16 H.L. JOUR. 389, 391 (Feb. 24 & 27, 1698/9).

16. See John Feather, *The Book Trade in Politics: The Making of the Copyright Act of 1710*, 8 PUB. HIST. 19, 25–28 (1980).

17. PATTERSON, *supra* note 4, at 55–64; Peter Blayney, *The Publication of Playbooks*, in *A NEW HISTORY OF EARLY ENGLISH DRAMA* 383, 396–405 (J.D. Cox & D.S. Kastan eds., 1997).

18. *A DECREE OF STARRE-CHAMBER, CONCERNING PRINTING* § 7 (London, R. Barker 1637).

Company to Enter the same as that other Persons Copy that will
print it¹⁹

This custom was later incorporated in the Printing Act of 1662²⁰ and, after the first lapse of that Act, was memorialized as an ordinance of the Company of Stationers in 1681.²¹

There is some disagreement as to whether persons other than freemen of the Company of Stationers, such as members of other guilds or authors, were permitted to register. Some scholars have said that only Stationers could register,²² but others have found evidence to the contrary.²³ I will not presume to address the matter for all the years in which the Company was operating. But the period from 1675 to 1709, which is roughly the time during which the parties in *Tonson v. Baker* operated before the Statute of Anne, does require comment, if only because the lead defendant, John Baker, was not a freeman of the Company.²⁴ If an outsider like Baker was unable to become a member of the Stationers' copyright "club," it would certainly make any anti-copyright views that Baker expressed more understandable.

The ordinance of 1681 spoke of registration only by members, and the general practice seems to have been that registration was in fact limited to freemen of the Company; authors or members of other guilds could not directly partake in it.²⁵ It is true that there were exceptions, but my review of

19. *Dring v. Leybourne*, C6/134/53 (Ch. 1657). This a fascinating suit which, to my knowledge, has not been discussed elsewhere. In 1656, William Leybourne, a Stationer, entered two books in the register in trust for the "Author or such as hee should Nominate." The author, Edmund Wingate of Gray's Inn, nominated his son, Button Wingate of Gray's Inn. Neither were Stationers. William Foster of the Middle Temple, also not a Stationer, then purchased the copyrights from the son for 100 pounds, and the rights were later sold by Foster to Thomas Dring, a Stationer, for an unknown sum. In April 1657, Dring sought enforcement of the trust and an assignment of the registrations from Leybourne to himself. *Id.* I found no orders in the case, but the suit may have influenced Leybourne because he assigned both copyrights to Dring on February 23, 1657/8. See 2 A TRANSCRIPT OF THE REGISTERS OF THE WORSHIPFUL COMPANY OF STATIONERS 1640–1708 A.D. 71, 78, 166–67 (G.E. Briscoe Eyre et al. eds., 1913) [hereinafter STATIONERS' REGISTERS].

20. Statute, 1662, 13 & 14 Car. 2, c. 33, § 5.

21. 1 A TRANSCRIPT OF THE REGISTERS OF THE COMPANY OF STATIONERS LONDON 1554–1640 A.D. 20, 22–23 (London, s.n., Edward Arber ed., 1875) (Aug. 17, 1681) [hereinafter STATIONERS' REGISTERS].

22. BIRRELL, *supra* note 4, at 73; ROSE, *supra* note 4, at 4.

23. ADRIAN JOHNS, *THE NATURE OF THE BOOK* 229 (1998); PATTERSON, *supra* note 4, at 65.

24. See *infra* text accompanying notes 251–86.

25. See 1 STATIONERS' REGISTERS, *supra* note 21, at 22–23 (1681 ordinance). This was also demonstrated by annotations in the register book, see 3 STATIONERS' REGISTERS, *supra* note 19, at 4 (Sept. 24, 1675) ("Master Love being noe freeman, this is entered againe to

all the entries during the relevant period indicates that the exceptions were so few and far between that they were likely allowed only by special dispensation. Only 1.89% of the titles were registered by non-freemen.²⁶

The Stationers' copyright was perpetual in the sense that no work ever fell into the public domain, as we understand that term today. The same work could be held by several Stationers over the course of numerous years, even 100 years, and works were often shared in this way. This form of copyright persisted under the auspices of several Star Chamber decrees from 1566 to 1641, parliamentary ordinances and statutes during the Civil War and Interregnum from 1643 to 1660, and then under the Printing Act of 1662 after the Restoration. The Printing Act lapsed between March 1678/9 and June 1685 and then expired on May 3, 1695.²⁷ These lapses of protection (1679–1685 and 1695–1710) constituted statutory copyright interregnums—a time when copyright was not supported by statute—and I will label them as such.

While under the auspices of the instruments noted above, the Stationers' copyright was usually enforced in the Court of Assistants of the Company of Stationers. The Assistants served as the Company's governing body and as a forum to mediate and arbitrate disputes among members.²⁸ The court was also empowered to discover and seize illicit books and presses, which largely obviated the need for litigants to seek aid in the principal courts. But the statutory lapses robbed the Assistants of much of their power. Though cases could still be arbitrated during the statutory lapses, Stationers turned to the Court of Chancery, the principal equity court, to litigate their copyright

Nicholas Hooper."); *id.* at 156 (May 19, 1683) ("This book is to be printed by me for Richard Bentley, he not being free of the Company it is entered in my name in trust for him."), and elsewhere, see Letters and Papers, SP29/396, No. 167 (Sept. 19, 1677) (declaring that Daniel Major, a Stationer, had entered a book in trust for Samuel Lee because Lee was not a freeman of the Company). A 1694 ordinance of the Company also spoke of registration only by "members." Court Book F, f. 205^r (Ct. Ass. May 14, 1694).

26. The register books from July 1675 to March 1708/9 contain approximately 423 persons who registered books. See generally 3 STATIONERS' REGISTERS, *supra* note 19. Of those, 385 were at the time of registration freemen of the Company; widows (some known, others suspected) of former freemen, see CYPRIAN BLAGDEN, THE STATIONERS' COMPANY: A HISTORY, 1403–1959, at 162 (1960) ("It was an ancient custom of the City that the widow of a freeman became a freewoman."); or persons who entered their copies in partnership with at least one freeman. The 38 persons remaining entered only 72 of the approximately 3,800 entries during that time—just 1.89%. The figures become smaller if we subtract from the list those who registered works at a time when they were apprenticed (formally or informally) to a freeman of the Company (12) and those who were related to a freeman or apprentice (5). The remaining 21 "outsiders" entered 45 titles or 1.18%. Only four of the works were registered by their authors.

27. Gómez-Arostegui, *supra* note 7, at 1216–18.

28. See generally *id.* at 1256–62.

claims—sometimes with less than optimal results,²⁹ and at other times obtaining interlocutory injunctions that may have effectively ended the disputes.³⁰ A few cases were also brought on the equity side of the Court of Exchequer.³¹ Not being supported by any statutory authority or privilege, these Chancery and Exchequer cases were typically brought under a purported copyright at common law. Some suits referred to the common law expressly, others to the customs of the trade, and still others to copyrights as a form of property. Several also alleged or argued that the suit in equity would enable a subsequent action at law for damages.³² As I will discuss later,³³ all of the parties involved in *Tonson v. Baker* had prior experiences litigating copyright cases in the Court of Chancery during the statutory lapses.

Notably, with one known exception that apparently never proceeded past the pleading stage,³⁴ Stationers did not venture to the common-law courts to enforce their copyrights before the Statute of Anne. They were thus unable to argue that a copyright—one that existed independently of any statutorily supported right or printing privilege—had been fully adjudicated and expressly recognized at common law before 1710. This absence of a recognized common-law right provided some cover, though not necessarily the moral high ground, for literary-property pirates during the statutory interregnums.

B. THE STATUTE OF ANNE OF 1710

Though the Stationers put on a brave face and continued to comport themselves after 1695 as if their works remained protected in perpetuity by the customs of the Company and the common law of the realm, they also strongly agitated for the previous laws to be revived and then, upon failing in that task, lobbied for a new copyright statute to be enacted.³⁵ Matters became particularly acute following the union of Scotland and England in 1707 and the abolition of the Privy Council of Scotland in 1708, which had been the

29. *E.g.*, *Pawlett v. Lee*, C10/202/96, C10/209/62, C33/258, f. 85^v (Ch. 1681); *Pawlett v. Lee*, C10/211/60, C33/262, ff. 323^v–324^r (Ch. 1683/4).

30. *E.g.*, *Chiswell v. Lee*, C10/209/24, C33/257, ff. 174^v, 71^r, 100^r, 112^{r-v} (Ch. 1681–1682).

31. *E.g.*, *Keble v. Parker*, E112/836/804 (Exch. 1704/5); *Keble v. Onley*, E112/836/802 (Exch. 1705).

32. These suits—there are at least sixteen in number—are the subject of a new paper. H. Tomás Gómez-Arostegui, *Copyright at “Common Law” Before 1710* (working paper).

33. *See infra* Part IV.A.

34. *Ponder v. Braddill*, 1 Lilly’s Mod. Entries 67 (K.B. [1679/80]). Dating this case is difficult as I have yet to find the original declaration in the records. Special thanks to Susanne Jenks for pointing out that the action would have been filed in the King’s Bench.

35. DEAZLEY, *supra* note 4, at 1–37; RANSOM, *supra* note 4, at 76–92; Feather, *supra* note 16.

primary grantor of Scottish printing privileges.³⁶ English publishers worried about a flood of books imported from Scotland, and their Scottish counterparts worried about having no copyright protection whatsoever.³⁷

The Statute of Anne became effective on April 10, 1710, and created a new statutory copyright for books first published after that date. The right inured to the author of a work and her assigns and ran for fourteen years from first publication, with a possible reversion and additional term to the author of another fourteen years if she was still living at the expiration of the first term.³⁸ A legacy clause grandfathered in previously published works for a period of twenty-one years from the effective date of the statute.³⁹

Most important for our subsequent discussion of *Tonson v. Baker* are the remedial and jurisdictional clauses of the statute:

[If any person] shall print reprint or Import or Cause to be printed reprinted or Imported any such Booke or Bookes without the Consent of the Proprietor . . . \or/ knowing the same to be \so/ printed or reprinted . . . shall sell publish or expose to Sale [the same] . . . Then such offender . . . shall fforfeit such Booke or Bookes and all and every sheet or sheets . . . to the proprietor . . . who shall forthwith damaske and make wast paper of them[.] And fforther that every such offender . . . shall fforfeit one penny for every sheet which shall be ffound in his her or their Custody either printed or printing published or exposed to sale Contrary to the true intent and meaning of this Act, the one Moiety thereof to the Queens Most Excellent Majestie . . . and the other Moiety thereof to any person or persons that shall sue for the same to be recovered in any of her Majesties Courts of Record at Westminster by Action of debt Bill plaint or Information⁴⁰

Another clause made recovery of the penalties and forfeitures depend on entry of the book before publication in the register book of the Company of Stationers.⁴¹ Notably, one did not need to be a Stationer to register a book—a departure from prior practice. And though not expressly tied to

36. ALASTAIR J. MANN, *THE SCOTTISH BOOK TRADE 1500–1720*, at 122–24 (2000); see also Hector MacQueen, *Intellectual Property and the Common Law in Scotland c1700–c1850*, in *THE COMMON LAW OF INTELLECTUAL PROPERTY* 21 (Lionel Bently et al. eds., 2010).

37. MANN, *supra* note 36, at 122–23.

38. Statute, 1710, 8 Ann., c. 19, § 1. For more on the second fourteen-year term, see Lionel Bently & Jane C. Ginsburg, “*The Sole Right . . . Shall Return to the Authors*”: *Anglo-American Authors’ Reversion Rights from the Statute of Anne to Contemporary U.S. Copyright*, 25 *BERKELEY TECH. L.J.* 1475 (2010).

39. 8 Ann., c. 19, § 1.

40. *Id.* (text from the Parliamentary Archives, <http://www.copyrighthistory.org>).

41. *Id.* § 2.

registration, the right holder was also required to deposit nine copies of the book, upon the best paper, before publication.⁴²

The statute applied in England, Wales, and Scotland, but not in Ireland, a fact that is also relevant to the recounting of *Tonson v. Baker*.⁴³ Moreover, the statute did not “prejudice or confirme any right that . . . any person or persons have or Claime to have, to the printing or reprinting any booke or Copy already printed or hereafter to be printed.”⁴⁴ Some who believed in perpetual copyrights at common law for published works, including Justice Aston, thought this broad language was inserted to preserve those rights.⁴⁵ Ray Patterson and Ronan Deazley have argued, however, that Parliament probably inserted the clause to preserve or, more neutrally, to not disturb the royal printing-privilege system.⁴⁶ Whether the clause was intended to affect parliamentary privileges—be it the right to grant a printing privilege or the duration of any privilege so granted—is less clear, but it seems safe to assume that Parliament did not curtail its own right to grant.

Particularly revealing is the fact the House of Lords exercised its privilege during the Sacheverell affair, just two weeks before enacting the statute. And as it so happens, the Sacheverell affair was otherwise entwined with the enactment of the statute and, importantly, the first suit filed under it.

III. THE CASE WITHIN THE CASE: DR. SACHEVERELL

At its heart, *Tonson v. Baker* was a dispute about the reporting of another legal proceeding. The underlying case was the impeachment and trial of Dr. Henry Sacheverell. The doctor was a High Church advocate and religious conservative who preached not only against “all those who dissented from the Established Church, but even those adherents of the Church who favored a policy of comprehension or a moderate union between the Church and certain sects of Dissenters.”⁴⁷ In two sermons in 1709, Sacheverell directed his ire at the incumbent Whig ministry of Great Britain and indirectly against Queen Anne. Under one interpretation of his sermons,

42. *Id.* § 5.

43. Parliament and the Crown claimed superintendence over Ireland in 1710, but British legislation did not always govern it. See 2 JUSTIN MCCARTHY, *THE REIGN OF QUEEN ANNE 165–85* (1902); Joanna Innes, *Legislating for Three Kingdoms: How the Westminster Parliament Legislated for England, Scotland and Ireland, 1707–1830*, in *PARLIAMENTS, NATIONS AND IDENTITIES IN BRITAIN AND IRELAND, 1660–1850*, at 15, 19 (Julian Hoppit ed., 2003).

44. 8 Ann., c. 19, § 9.

45. *Millar v. Taylor*, 4 Burr. 2303, 2351–52 (K.B. 1769) (Aston, J.).

46. PATTERSON, *supra* note 4, at 148–49; DEAZLEY, *supra* note 4, at 40 & n.42.

47. ABBIE TURNER SCUDI, *THE SACHEVERELL AFFAIR* 32–33 (1939).

Sacheverell had accused the Whigs of neglecting the Church of England through the secularization of government and the toleration of other religions. He also allegedly preached that the Glorious Revolution of 1688, which formed the basis for the laws under which the Queen ascended to the throne, had been illegal.⁴⁸

Sacheverell's greatest mistake was publishing the sermons.⁴⁹ His printer, Henry Clements, printed around 40,000 of the more inflammatory sermon—*The Perils of False Brethren*—and subsequent printings (some of which were pirated copies) brought the total to nearly 100,000 copies in print.⁵⁰

A. IMPEACHMENT AND TRIAL OF DR. SACHEVERELL

The Whigs in Parliament did not take the insult lightly. Rather than prosecute Sacheverell in the Queen's Bench for seditious libel, or imprison him until the end of the session for offending the dignity of the Commons,⁵¹ the Commons resolved on December 14, 1709 to impeach him for high crimes and misdemeanors and to try him in the House of Lords.⁵² Sitting as the High Court of Parliament, the Lords had more power than the Commons acting alone and could bar Sacheverell from holding religious office for life, imprison him for the same period, and impose a staggering fine.⁵³

The Commons created a committee to draft the charging document and manage the prosecution. Among those appointed were Spencer Cowper, the younger brother of the Lord Chancellor, and Sir Joseph Jekyll, a serjeant at law and Queen's serjeant.⁵⁴ These two men would later, in a private capacity, represent Jacob Tonson in his suit against John Baker for infringing Tonson's exclusive right to print the trial. Four articles of impeachment were approved and read to Sacheverell in the Upper House on January 12, 1709/10. Sacheverell then presented his written answer to the Lords on

48. *Id.* at 38–39, 45–47.

49. *See, e.g.*, ESTC Nos. T77902, T43864.

50. GEOFFREY HOLMES, *THE TRIAL OF DOCTOR SACHEVERELL* 74–75 (1973). Just days after *The Perils of False Brethren* appeared in print the Rev. Ralph Bridges, an ally of Sacheverell, lamented the decision to publish it. “I think Dr. S[acheverell] had better have let printing his sermon . . . alone. . . . It is all what he says truth, but perhaps a little too unseasonable.” Letter from R. Bridges to Sir Wm Trumbull (Nov. 29, 1709), *in* 1 REPORT ON THE MANUSCRIPTS OF THE MARQUESS OF DOWNSHIRE 884 (E.K. Purnell ed., 1924).

51. HOLMES, *supra* note 50, at 83, 88.

52. 16 H.C. JOUR. 241–42 (Dec. 14, 1709).

53. HOLMES, *supra* note 50, at 83.

54. *Id.* at 97 n.*.

January 25 and to the Commons the next day. The replication of the Commons was approved on February 2.⁵⁵

The resulting trial was a cause célèbre, largely because Sacheverell stood as a proxy for the policies of the High Church advocates and Tories in Parliament. On the other side were the contrasting policies of the Whigs, which can also be said to have been on trial.⁵⁶ It is difficult to overstate the impact of the Sacheverell affair on the populace of England and elsewhere. As one contemporary noted: “[This] town is in so great a ferment at present upon the tryall of Dr. Sacheverell as I beleeve never was known. . . . In short men’s eyes and minds are wholly turnd upon this affaire, so that here is a sort of stopp to all businesse.”⁵⁷ Another correspondent wrote before the trial began that the “great amusement of this town is the affair of Sacheverell, about which all companys squabble and box, as they find themselves inclined.”⁵⁸

The fiery issues were stoked further because the trial was held in the more public venue of Westminster Hall rather than at the bar of the House of Lords. Members of the Tory party, led by William Bromley, and some moderate Whigs insisted that all members of the House of Commons be permitted to attend the trial as a “Committee of the whole House.”⁵⁹ They knew this would require a much larger and more public venue than the Lords’ chamber, and they hoped to capitalize on a growing perception of an iniquitous prosecution.⁶⁰ These Sacheverellites also knew, and indeed probably desired, that an open venue would more likely lead to printed accounts of the trial favorable to the doctor.⁶¹ It was perhaps for that reason that the Commons ordered on February 24, 1709/10, that “nothing, that shall be said by any Member of this House, or by any Person, that shall be produced as a Witness in behalf of the Commons of *Great Britain*, in the Trial of Doctor *Henry Sacheverell*, be printed, or published, without the Leave of this House.”⁶²

55. 19 H.L. JOUR. 32–33 (Jan. 12, 1709/10); 16 H.C. JOUR. 277, 279, 291 (Jan. 25–26, Feb. 2, 1709/10).

56. For an excellent summary of the parties’ platforms between 1690 and 1715, see 1 D.W. HAYTON, *THE HOUSE OF COMMONS 1690–1715*, at 462–79 (2002).

57. Letter to the Countess of Lindsey (Feb. 23, 1709/10), *in* REPORT ON THE MANUSCRIPTS OF THE EARL OF ANCASTER 439 (S.C. Lomas ed., 1907).

58. Letter from Roger Kenyon to Mrs. Kenyon (Jan. 14, 1709/10), *in* THE MANUSCRIPTS OF LORD KENYON 444 (London, Her Majesty’s Stationery Office 1894).

59. 19 H.L. JOUR. 58 (Feb. 6, 1709/10).

60. HOLMES, *supra* note 50, at 111–13.

61. *See, e.g.*, HIGH-CHURCH DISPLAY’D 11 (London, s.n. 1711) (“The Doctor’s Answer was . . . sold publickly to incense the People, and prepossess them in his favour . . .”).

62. 16 H.C. JOUR. 337 (Feb. 24, 1709/10).

Special stands had to be constructed in the Hall to accommodate the number of people expected to attend the trial.⁶³ The members of the Commons were given one side of the Hall, and the Lords their own section.⁶⁴ Seven spectator tickets were also allocated to each Lord who planned to attend the trial.⁶⁵ Additionally, members of the public without tickets from a Lord could purchase their own at a costly three to five guineas.⁶⁶ Though the Hall could hold about two thousand people,⁶⁷ records suggest the trial was crowded, with spectators encroaching on seats reserved for others. The serjeant at arms had to regularly remove and arrest “strangers” who had taken seats reserved for the Commons.⁶⁸

William Cowper, the Lord Chancellor, presided over the trial, which began on February 27 and lasted about two weeks. The prosecution presented its case, as did Sacheverell’s counsel, and Sacheverell then spoke in his own defense. The case was submitted to the Lords for their consideration and judgment in their own chamber, during which several of the Lords (in particular, the Bishops) made rousing speeches, many of which would later reach the print market. The Lords convicted Sacheverell, largely along party lines, on March 20, 1709/10.⁶⁹ Many who voted to convict then defected or absented themselves when the sentence was considered and a proposed ban on preaching for seven years and imprisonment were rejected.⁷⁰ Instead, on March 23, the Lords banned Sacheverell for three years, imposed no imprisonment whatsoever, and ordered his two sermons of 1709 burnt.⁷¹

It did not take long for the result to reveal itself as a pyrrhic victory for the Whig ministry.⁷² Within the course of the next six months, Queen Anne prorogued the Whig-dominated Parliament numerous times, dismissed some Whig ministers, unintentionally caused others to resign (including Lord Chancellor Cowper), and dissolved Parliament on September 21.⁷³ The Parliament that began on November 25 after new elections was decidedly

63. Copy of Letter of Sir Christopher Wren (Feb. 8, 1709/10), WORK 11/24/1.

64. A TRUE AND EXACT VIEW AND DESCRIPTION OF THE COURT FOR THE TRYAL OF DR. HENRY SACHEVERELL, IN WESTMINSTER-HALL ([London], John Baker 1710).

65. 19 H.L. JOUR. 77 (Feb. 23, 1709/10). Lords could attend without tickets of course.

66. HOLMES, *supra* note 50, at 125–26.

67. *Id.*

68. 16 H.C. JOUR. 341–49 (Feb. 28 to Mar. 9, 1709/10).

69. 19 H.L. JOUR. 115 (Mar. 20, 1709/10).

70. *Id.* at 118 (Mar. 21, 1709/10); HOLMES, *supra* note 50, at 227–29.

71. 19 H.L. JOUR. 121–22 (Mar. 23, 1709/10).

72. SCUDI, *supra* note 47, at 123–24.

73. *Id.* at 134–35.

Tory.⁷⁴ Historians recognize that it was the impeachment and trial of Sacheverell that played the pivotal role in the fall of the Whigs.⁷⁵ Importantly, the hundreds of print publications that appeared during the Sacheverell affair, both those for and against the doctor and the policies he supported, also garnered much of the credit.⁷⁶

B. DR. SACHEVERELL AND THE COPYRIGHT STATUTE

But what of the Statute of Anne? It is easy to lose sight of the fact that Parliament had the new copyright law to consider during the same parliamentary session. The petition for leave to bring a new copyright bill had been submitted to the Commons on December 12, 1709, only days before the Commons announced its impeachment of Sacheverell. The bill was then submitted on January 11, 1709/10, the day before the Commons approved the articles of impeachment against him. The House was able to twice read and consider the bill in committee in the weeks between the impeachment and the start of the trial, but only after several delays. The third reading and passage of the bill with some amendments occurred on March 14.⁷⁷

The first reading of the statute in the Lords occurred on March 16, 1709/10, the same day they debated the first article of impeachment. It was then read a second time on March 24, the day after judgment in the Sacheverell affair. From then on, it did not take long to consider the statute. After some amendments, and a third reading, the Lords passed the bill on April 4. The Commons agreed to all the amendments but one, which the Lords did not resist, and the Queen assented on April 5, 1710. Notably, the effective date of the statute had to be changed from March 25 to April 10, demonstrating that passage of the bill took longer than Parliament had anticipated.⁷⁸

Though other reasons may have played a part in the “miserable havock” occasioned by the statute’s textual problems, neglect might help explain why the statute contained several ambiguities and errors, many of which were apparent on their face.⁷⁹ As Gilbert Burnet, Bishop of Salisbury, noted in his

74. 1 HAYTON, *supra* note 56, at 227–30.

75. *E.g.*, A.S. TURBERVILLE, THE HOUSE OF LORDS IN THE XVIIITH CENTURY 95 (1927) (“His impeachment is the most important turning-point in the reign of Anne.”).

76. *See* Mary Ransome, *The Press in the General Election of 1710*, 6 CAMBRIDGE HIST. J. 209 (1939).

77. 16 H.C. JOUR. 240, 260–61, 264, 294, 300, 320, 332, 339, 369 (Dec. 12, 1709; Jan. 11, 14, Feb. 4, 9, 16, 21, 25, Mar. 14, 1709/10).

78. 19 H.L. JOUR. 109–10, 123, 140–41, 143–44 (Mar. 16, 24, 1709/10; Apr. 4, 5, 1710); 16 H.C. JOUR. 394–95, 396 (Apr. 5, 1710).

79. Deazley has recounted many of the problems. *See* DEAZLEY, *supra* note 4, at 31, 47–50. I would add one more. The statute nonsensically provided that its statutory remedies

memoirs, “the great business of th[e] session, that took up most of their time, and that had great effects in conclusion, related to Dr. Sacheverel.”⁸⁰

As an author and a beneficiary of the statute after its enactment,⁸¹ Sacheverell might have lamented the indirect role he played in complicating it. Nevertheless, Sacheverell probably would have relished the second role that he played in the history of copyright. It was the printing and pirating of accounts of his trial that spawned *Tonson v. Baker*.

C. APPOINTMENT OF JACOB TONSON SR.

On the same day judgment was entered against Sacheverell, the House of Lords ordered that an account of the trial be published: “It is ORDERED, by the Lords Spiritual and Temporal in Parliament assembled, That the Lord High Chancellor of *Great Britain*, do give Order for the printing and publishing the Trial of *Henry Sacheverell* Doctor in Divinity; and that no other Person do presume to print the same”⁸² Whoever received the rights would be in an enviable position. The trial was sure to be a bestseller, and the publisher could hope to make a tidy sum.

Lord Chancellor Cowper appointed Jacob Tonson Sr. to print the trial and simultaneously forbade others from doing so. I was unable to find documentation of the appointment in the records of the Chancery, Parliament, the State Papers Domestic, or in the private diary of Lord Chancellor Cowper. We know of Tonson’s selection, however, because Tonson made sure to insert a note about it on the first leaf of nearly every edition that he printed.⁸³ Though the exact date of his appointment is unknown, it likely occurred a few days after judgment.

Tonson was the most famous publisher in England at the beginning of the 18th century. Born in 1655⁸⁴ and made a freeman of the Company of

(penalties and forfeitures) were available during the first fourteen years of the copyright but not during the fourteen-year renewal term. This seems to have been an oversight, with the likely culprit being that the Lords added the renewal term as a last-minute amendment. Remarkably, this provision was sewn onto the original parchment roll as a separate piece.

80. 5 BISHOP BURNET’S HISTORY OF HIS OWN TIME 420 (Oxford, Clarendon Press 1823).

81. Stationers’ Co., A Register of the Copies of Books MS, pp. 12–13 (1710–1746) (registration of several books under the Statute of Anne) [hereinafter Register Book MS].

82. 19 H.L. JOUR. 122 (Mar. 23, 1709/10); see also Minutes of the House of Lords MS, HL/PO/JO/5/1/45 (Mar. 23, 1709/10) (“House moved That the Tryall be printed & \published/ . . .”).

83. E.g., ESTC No. T152340 sig. π 1^v.

84. KATHLEEN M. LYNCH, JACOB TONSON KIT-CAT PUBLISHER 5 (1971). Lynch mistakenly states that Tonson was baptized on November 12, 1655. He was born on the

Stationers in 1677/8,⁸⁵ Tonson published the works of John Milton, William Shakespeare, and John Dryden, among others. In addition to owning a lucrative stockpile of copyrights from which he derived most of his wealth, Tonson also owned a bookshop and in later years ran a printing house with John Watts.⁸⁶ Tonson was well respected in the trade, and his biographers have surmised it was “unlikely that he ever published pirated works.”⁸⁷

I have yet to find an infringement suit in the principal courts at Westminster in which he was named as a defendant, which is not surprising. Tonson was a strong supporter of copyright, had lobbied for a new statute during the second statutory interregnum,⁸⁸ and argued during the interregnums that works remained protected at common law.⁸⁹

Nevertheless, Tonson’s hands were not entirely clean as he had, in fact, been twice accused of pirating works in the Court of Assistants of the Company of Stationers, and at least once accused outside that forum.

In *Saunders v. Tonson*,⁹⁰ for example, Francis Saunders accused Tonson of infringing a copyright in poems of the late Earl of Rochester, which Saunders had registered in 1690.⁹¹ No record of the outcome appears in the court books, but in 1691 Tonson published a collection of the Earl’s poems that contained some (but not all) of the poems Saunders claimed were his by registration and others that Saunders had not registered. Perhaps the parties settled their differences.⁹² In another dispute in 1715, the Company stopped paying dividends to Tonson and his nephew Jacob Tonson Jr. (with whom Tonson likely partnered c.1703)⁹³ until they compensated the Company for

12th and baptized the 18th. See Register of Baptisms, St. Andrew Holborn, Guildhall MS 6667/4 (Nov. 1655).

85. D.F. MCKENZIE, STATIONERS’ COMPANY APPRENTICES 1641–1700, at 9, No. 224 (1974).

86. Michael Treadwell, *London Printers and Printing Houses in 1705*, 7 PUB. HIST. 5, 40 (1980).

87. LYNCH, *supra* note 84, at 96; accord Hale Sturges, *The Publishing Career of Jacob Tonson, the Elder, 1678–1720*, at 26 (1936) (unpublished Ph.D. dissertation, Yale University).

88. 15 H.C. JOUR. 313 (Feb. 26, 1706/7); 16 *id.* at 240 (Dec. 12, 1709).

89. See *infra* text accompanying notes 197–200. Tonson sometimes hedged his bets, however, and sought a royal privilege by license. *E.g.*, Entry Books, SP44/353, pp. 105–06 (Dec. 3, 1705); *id.* SP44/353, pp. 118–19 (Feb. 5, 1705/6); *id.* SP44/353, pp. 508–09 (Nov. 19, 1709).

90. Court Book F, f. 146^v (Ct. Ass. 1690).

91. 3 STATIONERS’ REGISTERS, *supra* note 19, at 377 (Nov. 19, 1690).

92. Starting in 1714, Tonson began including the poems he had previously excluded. For more on Tonson’s publication of the poems, albeit without mention of this dispute, see Nicholas Fisher, *Jacob Tonson and the Earl of Rochester*, 6 LIBR. 133 (7th Ser. 2005).

93. LYNCH, *supra* note 84, at 108.

printing a book in violation of its right in school books.⁹⁴ Lastly, in a dispute that I will revisit,⁹⁵ Tonson copied engravings from a book published by John Baker, albeit without suffering more than a public shaming. These are the transgressions we know of; there may have been others.

Outside of the trade, Tonson was best known for being a founding member and principal convener of the Kit-Cat Club, a literary and political club that had been associated with the Whig party from the club's inception.⁹⁶ Several powerful Whigs were members, and the decision to seek the impeachment of Sacheverell was allegedly made in part during meetings of the club.⁹⁷ Tonson's close connections to the dominant Whig party would have played a critical role in receiving the Lord Chancellor's appointment to print the trial. Indeed, those connections had kept him busy printing for various departments of the Whig ministry in the years leading to his appointment.

Tonson and his nephew began printing *The London Gazette*, the official newspaper of the government, in 1707/8.⁹⁸ In the same year, the Speaker of the House of Commons appointed Tonson and three others as the exclusive printers of the *Votes of the House of Commons*.⁹⁹ The *Votes* was a daily sheet of the proceedings of the Commons and was, until the official journal began being published in 1742, the only official account of its decisions.¹⁰⁰ Tonson had also worked for Lord Chancellor Cowper; he and his nephew had provided stationery for the Chancery since 1705.¹⁰¹ Tonson even had a prior experience printing a trial in the House of Lords. Lord Chancellor Somers, Cowper's Whig predecessor, appointed Tonson in 1699 to print the trials of Edward, the Earl of Warwick and Holland, and Charles Mohun.¹⁰²

94. *In re Tonson*, Court Book G, ff. 219^r, 235^r (Ct. Ass. 1714–1715).

95. *See infra* text accompanying notes 299–329.

96. OPHELIA FIELD, THE KIT-CAT CLUB 32–34 (2009).

97. HOLMES, *supra* note 50, at 87; LYNCH, *supra* note 84, at 37, 61–62.

98. P.M. HANDOVER, A HISTORY OF THE LONDON GAZETTE 37–43, 48–50 (1965).

99. LYNCH, *supra* note 84, at 111.

100. BETTY KEMP, VOTES AND STANDING ORDERS OF THE HOUSE OF COMMONS 2, 20 (1971).

101. Hanaper in Chancery: Declared Accounts, E351/1715B (Oct. 21, 1705 to Sept. 30, 1706); *id.* AO1/1396/249 (Sept. 30, 1706 to Sept. 29, 1708); *id.* E351/1717 (Sept. 30, 1708 to Aug. 10, 1710). Cowper had become Lord Keeper on October 11, 1705.

102. THE SEVERAL TRYALS OF EDWARD EARL OF WARWICK AND HOLLAND, AND CHARLES LORD MOHUN, BEFORE THE HOUSE OF PEERS IN PARLIAMENT sig. π 1^v (Savoy, Jacob Tonson 1699). On Tonson's friendship with Somers, see FIELD, *supra* note 96, at 13–15.

D. REGISTRATIONS AND IRRITATIONS

Following his appointment, Tonson chose not to rely solely on his parliamentary privilege to protect his rights. He also opted to enter his upcoming account of the trial in the register book created by the Company of Stationers pursuant to the Statute of Anne. He registered his account twice, which was unusual, with the first entry appearing at a time when he had not finalized the title and was not yet close to completing the book for publication. The first entry was dated May 15, 1710, and was for a book entitled “The Whole proceedings, with the Speeches on both sides, at the Tryal of Dr Henry Sacheverell.”¹⁰³

Tonson probably felt pressured to prematurely register his book by the large number of short tracts and pamphlets relating to the trial that had quickly emerged for public consumption.

Between the impeachment and the beginning of the trial, for instance, an anonymous printer, likely Edmund Curll, published the answer Sacheverell submitted to Parliament.¹⁰⁴ The text purported to be a translation of an account from the *Leiden Gazette* to avoid censure.¹⁰⁵ In the midst of the trial, Henry Clements published a book—*Collections of Passages*—containing excerpts from the doctor’s answer, along with a collection of passages the doctor submitted into evidence.¹⁰⁶ And on the day the Lords announced they had reached a verdict, another short tract entitled *The Speech of Henry Sacheverell, D.D. upon his Impeachment at the Bar of the House of Lords* was anonymously advertised.¹⁰⁷ The latter two publications were noticed by the House of Lords, and it ordered on March 23 that Clements and any other offender be arrested and brought to the bar of the House.¹⁰⁸ The House of Commons, having been offended as well, then ordered that Clements’s *Collections of Passages* be burnt.¹⁰⁹

The action of the two Houses was largely ineffective. Numerous other books and pamphlets continued to appear after the trial concluded. Abigail Baldwin, for example, advertised on April 7, 1710 that she was offering for sale “The Bishop of Salisbury’s Speech in the House of Lords on the First

103. Register Book MS, *supra* note 81, at 24.

104. *E.g.*, ESTC No. T21971.

105. F.F. MADAN, A CRITICAL BIBLIOGRAPHY OF DR. HENRY SACHEVERELL 49–50 (W.A. Speck ed., 1978) (concluding that the reference to the *Leiden Gazette* was fictitious).

106. THE POST BOY (London), No. 2313, Mar. 9–11, 1709/10, at 2; *e.g.*, ESTC No. T79.

107. THE POST BOY (London), No. 2317, Mar. 18–21, 1709/10, at 2; *e.g.*, ESTC No. T49659.

108. 19 H.L. JOUR. 122 (Mar. 23, 1709/10).

109. 16 H.C. JOUR. 383–84 (Mar. 24, 1709/10).

Article of the Impeachment of Dr. Henry Sacheverell.”¹¹⁰ Benjamin Bragg announced that he was selling for six pence a book containing the speech of Sacheverell at the bar of the House of Lords, along with reflections thereon by an anonymous commentator.¹¹¹ And on May 2, 1710, an anonymous advertisement by the “Booksellers of London and Westminster” announced a broadsheet that listed the Lords and members of Parliament who had supported Sacheverell during the proceedings.¹¹² That these publications appeared without censure from Parliament, which was not in session after April 5, may have further stirred Tonson to first register in mid-May.

Tonson’s second registration occurred on June 3, 1710.¹¹³ He had by that time settled on the title of his book and was nearly ready to publish it.

Ironically, the first advertisements for Tonson’s book were specious. The following appeared in the June 10 issue of *The Daily Courant*:

Next Tuesday will be Publish’d,
The Tryal of Doctor Henry Sacheverell before the House of Peers
for high Crimes and Misdemeanours. Price 7 s.

At the same time will be Publish’d,
An Impartial Account of what pass’d most Remarkable in the last
Session of Parliament relating to the Case of Dr. Henry
Sacheverell, Done on such another Paper and Letter, and may
therefore be bound up with the Tryal of the said Doctor. Printed
for Jacob Tonson at Gray’s-Inn-Gate. Price 1 s.¹¹⁴

Similar advertisements appeared in other newspapers as well.¹¹⁵

None of the advertisements had been sanctioned by Tonson, which he soon made clear in an advertisement appearing in *The Daily Courant* on June 12:

Whereas on Saturday last an Advertisement brought by an
unknown Person was inserted in the News-Papers, That the Tryal
of Dr. Henry Sacheverell wou’d be publish’d on Tuesday next ; and
that at the same time wou’d be publish’d an Impartial Account of

110. THE DAILY COURANT (London), No. 2638, Apr. 7, 1710, at 2; *e.g.*, ESTC No. T171992.

111. THE DAILY COURANT (London), No. 2639, Apr. 8, 1710, at 2; *see* ESTC No. T34905.

112. THE POST BOY (London), No. 2335, Apr. 29 to May 2, 1710, at 2; *see* ESTC No. T21300.

113. Register Book MS, *supra* note 81, at 36.

114. THE DAILY COURANT (London), No. 2693, June 10, 1710, at 2.

115. *E.g.*, THE POST=MAN (Old Bailey), No. 1895, June 8–10, 1710, at 2; THE TATLER (London), No. 183, June 8–10, 1710, at 2.

what pass'd most remarkable in the last Session of Parliament relating to the Case of Dr. Henry Sacheverell, and therefore might be bound up with the Tryal of the said Doctor, printed for Jacob Tonson at Gray's-Inn-Gate. This is to give Notice, That no such Book is printed or to be publish'd by Jacob Tonson, but his Name without his knowledge is put to a Spurious Pamphlet which contains only an imperfect Extract of the Journals of the Houses of Lords and Commons relating to the said Dr. Henry Sacheverell ; and that the Tryal of the said Dr. Henry Sacheverell only, without the said Extract, is printed for Jacob Tonson, and will be publish'd on Thursday next.¹¹⁶

The next day, Tonson announced that the culprit was Abel Roper. Roper had, according to Tonson, entered the *Impartial Account* in the register book of the Company of Stationers.¹¹⁷ This was true. Roper's signature can be seen in the register beneath an entry dated June 12, 1710.¹¹⁸

Roper responded through a proxy—John Morphew—in *The Post Boy* of June 13, a newspaper that Roper published.¹¹⁹ Morphew, a trade publisher and bookseller supporting Tory interests, announced that he would be selling the *Impartial Account*, and he took umbrage at Tonson's advertisement:

This is to give Notice that Mr. *Jacob Tonson*, who caus'd the said Advertisement to be inserted in the *Courant*, could not have seen the said *Impartial Account*, &c. for neither is it pretended to be printed for *Jacob Tonson* at *Gray-Inn-Gate*; nor is it, as Mr. *Tonson* has falsly and maliciously asserted, an *imperfect Extract of the Journals of the Lords and Commons* ; but as *perfect and impartial* an *Account* as is alleg'd in the *Title* ; as any Person will judge, who is pleas'd to peruse it.¹²⁰

What happened next illustrates the sharp practices of the time. In the same column of that very issue, an advertisement appeared announcing that the *Impartial Account* had just been printed for Jacob Tonson at Gray's-Inn-Gate. Moreover, every London edition of the *Impartial Account*—and there were numerous impressions—listed Tonson and not Roper or Morphew on the imprint.

116. THE DAILY COURANT (London), No. 2694, June 12, 1710, at 2.

117. *Id.* No. 2695, June 13, 1710, at 2. Tonson's complaint also appeared elsewhere. *See* THE POST=MAN (Old Bailey), No. 1896, June 10–13, 1710, at 2; THE TATLER (London), No. 184, June 10–13, 1710, at 2; THE LONDON GAZETTE, No. 4704, June 13–15, 1710, at 2.

118. Register Book MS, *supra* note 81, at 40.

119. HENRY R. PLOMER, A DICTIONARY OF THE PRINTERS AND BOOKSELLERS WHO WERE AT WORK IN ENGLAND, SCOTLAND AND IRELAND FROM 1668 TO 1725, at 257–58 (1922).

120. THE POST BOY (London), No. 2353, June 10–13, 1710, at 2.

The sixteen-page *Impartial Account* was, as Tonson alluded to, largely a reproduction of his daily sheets of proceedings in the House of Commons.¹²¹ Thus, most of it concerned the impeachment rather than the trial. In this respect, the *Impartial Account* infringed the printing privilege that the Commons had granted to Tonson. But the account went further and recounted certain proceedings not in the daily sheets, such as trial deliberations that would be subject to the privilege granted by the House of Lords. More irksome, Roper spun the facts to favor Sacheverell, which would have astonished no one, least of all Tonson. Roper was a committed Tory, as his polling shows.¹²² Indeed, a contemporary later acknowledged that the *Impartial Account* was “[s]uppos’d to be Printed and Publish’d by *Abel Roper*, as a design’d Vindication of the Doctor.”¹²³

The *Impartial Account* must have irritated Tonson, and Roper was eventually called to account for his breach.¹²⁴ But Tonson’s more immediate concern was preparing his own full account of Sacheverell’s trial.

E. PUBLICATION OF JACOB TONSON’S *TRYAL*

The exact day on which Tonson made his book¹²⁵ (Fig. 1) available to the public has become a bit muddled. White Kennett, an opponent of Sacheverell, wrote in 1715 that Tonson’s book became available on April 11, 1710.¹²⁶ Had Kennett been correct, it would have made for an interesting back story. Being the day after the Statute of Anne went into effect, one could have surmised that Tonson waited to publish his book until just after the effective date to ensure it was eligible for the potentially longer term of twenty-eight years, rather than twenty-one years under the legacy clause. Kennett, however, was mistaken.

121. See VOTES OF THE HOUSE OF COMMONS, IN THE SECOND SESSION OF THE SECOND PARLIAMENT OF GREAT BRITAIN 59–210 (London, Jacob Tonson et al. 1709) (compilation).

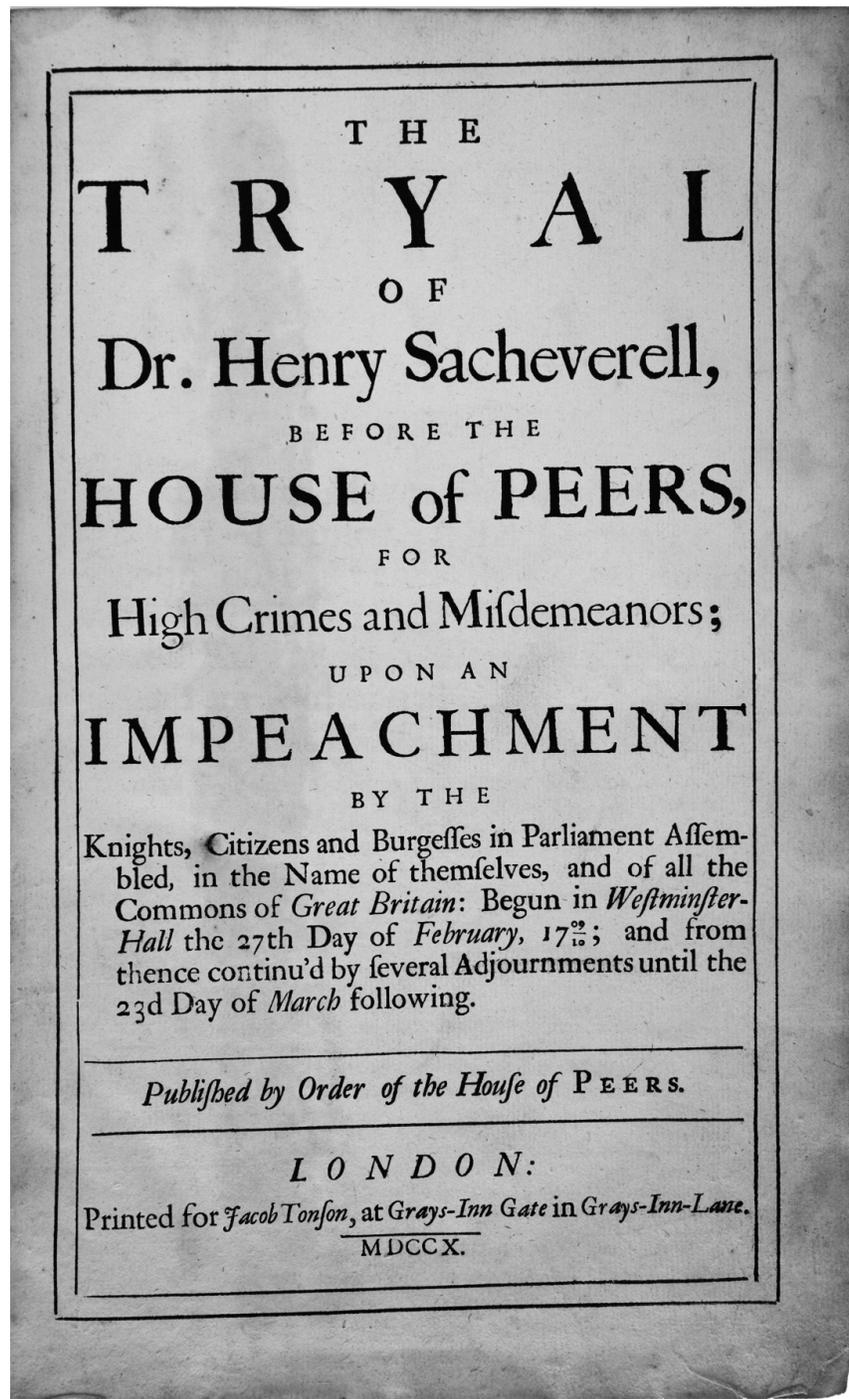
122. THE POLL OF THE LIVERY-MEN OF THE CITY OF LONDON 142 (London, John Morphew 1710); LONDON POLITICS, 1713–1717, at 113 (W.A. Speck & W.A. Gray eds., 1981).

123. WHITE KENNETT, THE WISDOM OF LOOKING BACKWARD 27 (London, J. Roberts 1715). An annotated copy of the *Impartial Account* at Yale describes it in contemporary hand as a “Pamphlet falsely intituled, for it is in many particulars a more False and Partial Account.” Beinecke, Brit Tracts 1710 Im7.

124. See *infra* text accompanying notes 147–50.

125. THE TRYAL OF DR. HENRY SACHEVERELL, BEFORE THE HOUSE OF PEERS, FOR HIGH CRIMES AND MISDEMEANORS (London, Jacob Tonson 1710); see ESTC No. T152340.

126. KENNETT, *supra* note 123, at 27.

Figure 1: Jacob Tonson's *Tryal* in folio

Tonson claimed in *Tonson v. Baker* that he first “published” the book on June 5, 1710.¹²⁷ Though publication is typically synonymous with making a work available to the public, he probably was referring to publication for Parliament. Tonson was obligated to provide sufficient numbers in folio to both Houses so that each member and Lord could have a copy if they desired.¹²⁸ Arthur Maynwaring, for instance, a member of the House of Commons and a close friend of Tonson,¹²⁹ probably received his copy on or soon after June 5. In a quasi-fictional set of letters, published together in a small tract, Maynwaring purportedly wrote on Thursday, June 15, 1710 to a correspondent in the country that he had “last Week” sent him a copy of the trial.¹³⁰

If a report in a Dutch journal is to be believed, Tonson initially planned to distribute the folio edition to Parliament only, and to sell a smaller and cheaper octavo edition to the public.¹³¹ If so, Tonson soon changed his mind, probably because Parliament had been prorogued on April 5, 1710, and few members of Parliament were still in London in June.¹³² The first notice announcing that the folio was “This Day . . . Published [Thursday, June 15]” for public consumption appeared in *The London Gazette*, a newspaper printed, as I already noted, by Tonson and his nephew.¹³³ The folio seems to have

127. *Tonson v. Baker*, C9/371/41, m. 1, l. 10 (Ch. 1710).

128. This information comes from a separate lawsuit brought by Thomas Wibergh, serjeant at arms of the House of Commons, against Tonson. *See Wibergh v. Tonson*, C10/324/12, m. 2 (Ch. 1711/2). Wibergh alleged that Tonson failed to provide 558 copies of the book in folio for Wibergh’s distribution to House members, and that with respect to the books Tonson did deliver, Tonson had failed to bind them in calves leather with gilt lettering as expected. Wibergh also sued Tonson at law and had him arrested. *Id.* It appears that neither the suit nor the action proceeded much further. I am indebted to Joyce Brodowski for bringing this related suit to my attention. *See Brodowski, supra* note 4, at 319–20.

129. Henry L. Snyder, *Daniel Defoe, Arthur Maynwaring, Robert Walpole, and Abel Boyer: Some Considerations of Authorship*, 33 HUNTINGTON LIBR. Q. 133, 140 (1970).

130. ARTHUR MAYNWARING, FOUR LETTERS TO A FRIEND IN NORTH BRITAIN, UPON THE PUBLISHING THE TRYAL OF DR. SACHEVERELL 1–6 (London, s.n. 1710).

131. A correspondent in London reported to his editor in the Netherlands as follows: “On a imprimé *in folio* le Procès du Docteur Sacheverl ; mais seulement pour les deux Chambres du Parlement, & l’on travaille à une autre Edition in 8. qui sera pour le Public. On y a mis tous les discours pour & contre, & toutes les Pieces du Procès.” 38 LETTRES HISTORIQUES: CONTENANT CE QUI SE PASSE DE PLUS IMPORTANT EN EUROPE 68 (The Hague, Adrian Moetjens 1710).

132. *Wibergh*, C10/324/12, mm. 1–2.

133. THE LONDON GAZETTE, No. 4704, June 13–15, 1710, at 2; *accord id.* No. 4703, June 10–13, 1710, at 2; THE DAILY COURANT (London), No. 2696, June 14, 1710, at 2. Tonson had also advertised his book as being published “this Month” in the May edition of a monthly magazine. 12 THE HISTORY OF THE WORKS OF THE LEARNED 316–17 (London, H. Rhodes et al. 1710). But we do not know the month in which the magazine was actually slated to appear and thus whether by “this Month” Tonson meant May or June.

then made its way to bookshops in Oxford by June 18, as a diary entry by Thomas Hearne suggested.¹³⁴ That the folio was offered to the public, and not just to Parliament, is made clear by the fact it was advertised with a price. Members of the Commons and the Lords were not required to purchase their own copies. Instead, records indicate that Tonson hoped for a bulk payment directly from the Treasury.¹³⁵ A copy of the folio in the Madan collection at the British Library, which is inscribed “15 June 1710 price 7^s” and “R Symervell” on its first leaf, is further proof the folio was sold to the public.¹³⁶ No member or Lord of Parliament went by that name in 1710.

The base price for Tonson’s folio was seven shillings, and in the context in which it was advertised it appears that binding the book was charged separately. For one, the advertisement failed to state that binding was included.¹³⁷ Moreover, though not necessarily dispositive, Tonson himself stated in response to a related suit that the *Tryal* copies he provided to the members and Lords of Parliament were “Stiched in Sheets and not bound.”¹³⁸ That so many other works were advertised as suitable for being bound up with the *Tryal* also suggests the book was not necessarily bound when sold. Because binding of the book in calves leather was an extra expense, it would have added *at least* two shillings to the retail price.¹³⁹ When one included the speeches of the Bishops, which customers often desired and therefore purchased separately for eight pence in folio to supplement the

134. 3 REMARKS AND COLLECTIONS OF THOMAS HEARNE 15 (Oxford, Clarendon Press, C.E. Doble ed., 1889) (June 18, 1710) (“There is just publish’d in Folio the Tryal of Dr. Henry Sacheverell. Price 7s.”).

135. *Wibergb*, C10/324/12, m. 2 (but he claimed he had not been paid). The method by which publishers were compensated seems to have fluctuated. In c.1714, on an unrelated matter, Tonson acknowledged he would only be paid by the Treasury for copies of reports printed for the House of Commons if the sale of the reports to the public was insufficient to cover the costs of the printing run. *See* Treasury Papers, T1/179A, No. 50 (c.1714). But in subsequent years, Tonson and his nephew seem to have been paid for reports regardless of the recoupment of costs. Treasury Papers, T1/233, No. 19 (Jan. 25, 1720/1 & Dec. 20, 1721); Treasury Order, Yale Osborn MS Box 15093 (Sept. 19 & 30, 1721). Notably, the Treasury distinguished the ordinary printing of the daily votes and proceedings of the Commons from reports and special proceedings. For the former, the Treasury declined to pay the publisher at all. Treasury Papers, T29/26, pp. 242, 283 (July 29, 1729 & Jan. 7, 1729/30).

136. British Library Sach. 446(1).

137. THE LONDON GAZETTE, No. 4703, June 10–13, 1710, at 2.

138. *Wibergb*, C10/324/12, m. 2.

139. *See* A GENERAL NOTE OF THE PRICES OF BINDING ALL SORTS OF BOOKS IN CALVES-LEATHER (London, John Whitlock 1695) (listing wholesale prices), *reprinted in* MIRIAM M. FOOT, STUDIES IN THE HISTORY OF BOOKBINDING 48 (1993).

Tryal,¹⁴⁰ Tonson's book would have cost at least ten shillings. In today's currency, that would amount to approximately thirty-seven pounds.¹⁴¹

Tonson's *Tryal* came in at 335 pages in folio of principal text, though the last page is numbered 327. In their rush to prepare the first edition for printing, Tonson's compositors forgot to number eight of the pages.

The *Tryal* began its account with the first day of the trial on February 27, and therefore did not discuss the process of impeachment in the Commons. The book reads like a transcription of what was said during the trial. It includes the arguments of counsel on both sides, documents that the clerk read into evidence, the speech of Sacheverell, the judgment and sentence imposed, and certain post-judgment motions in which the doctor sought to arrest the judgment.

Who actually wrote the account? One can only speculate today, as Tonson's personal papers relating to the *Tryal* have not survived. But it seems unlikely Tonson employed his own shorthand writers during the trial to keep track of the proceedings, though this later became a common practice. Records in the National Archives state that the Treasury compensated (and thus likely hired) two shorthand writers for the duration of the trial.¹⁴² Additionally, had Tonson hired those writers or hired additional writers in anticipation of a forthcoming appointment as the publisher of the trial, he probably would have mentioned that fact in *Tonson v. Baker*. Other evidence suggests that Tonson may have also received the opening statements of some participants in writing.¹⁴³

After Tonson's book went on sale, the market continued to be inundated with other accounts of the trial. Two days later, for example, John Baker announced that he had just published a detailed account of certain post-trial debates that did not appear in Tonson's *Tryal*. Baker stressed that "[t]his true

140. THE DAILY COURANT (London), No. 2699, June 17, 1710, at 2; see ESTC No. T22851.

141. A copy of the second, corrected printing of Tonson's *Tryal* in folio is held in the Parliamentary Archives. It is bound in leather with gilt lettering on its spine and omits the speeches of the Bishops. A contemporary hand indicates its price was 10s. Parliamentary Archives LGC/9/2/1. It is unclear whether this price included binding.

In *Wibergh v. Tonson*, Wibergh claimed that Tonson wanted as much as "fifteen shillings or some such sume" for each folio bound in calf letter with gilt lettering on the spine to be delivered to the House of Commons. C10/324/12, m. 1. Tonson denied "he Charged or ever expected to be paid Fifteen Shillings per book for such [558] Tryalls." *Id.* at m. 2.

142. Treasury Entry Books, T53/21, p. 83 (May 18, 1711); Treasury Order Books, T60/8, p. 59 (May 24, 1711 & June 7, 1711).

143. See HOLMES, *supra* note 50, at 181.

Copy is only to be had of J. Baker.”¹⁴⁴ In the nature of a supplement, Baker’s *Proceedings* was only eight pages.¹⁴⁵ It seems that Tonson thought little of it, as he never filed a grievance in any forum. But he might have acted otherwise had he learned on that day that Baker would later incorporate the shorter tract into a fuller account of the trial.

Most of the other tracts that appeared were also short (ten to thirty pages) or broadsheets. Though many technically infringed Tonson’s parliamentary privilege, it appears he was not seriously concerned about them, as he again filed no claims. None of the tracts purported to be an account of the whole trial, and besides there were too many to stop them all. Any effort to shut down even a few would have been futile given the short length of these works. It would have been easy for one printer to pick up a baton dropped by another and reprint a tract. Moreover, Tonson’s principal biographer, Kathleen Lynch, believes Tonson probably welcomed many of these pamphlets because they often advertised that they were suitable for binding alongside Tonson’s own edition of the trial.¹⁴⁶

Indeed, apart from Parliament’s action against Clements, which likely was done *sua sponte* because of his insolence in printing a tract during the trial, I know of only one other short-work publication that was pursued in the months following the trial: Roper’s *Impartial Account*. *The Post Boy* announced in early July that “[w]e are inform’d, that Abel Roper is bound over, for Printing and Publishing a Book, entitul’d *An Impartial Account of what pass’d most Remarkable in the last Session of Parliament, relating to the Case of Dr. Hen Sacheverell*.”¹⁴⁷ Henry Boyle, Secretary of State for the Northern Department, had ordered Roper arrested, probably following a complaint from Tonson.¹⁴⁸ Roper was released upon executing a penal recognizance of 100 pounds to ensure his subsequent appearance in the Queen’s Bench “to answer to such matters as shall be objected against him.”¹⁴⁹ Unfortunately, what became of Roper’s breach is unknown, and it may have simply ended with this recognizance.¹⁵⁰

144. THE POST=MAN (Old Bailey), No. 1898, June 15–17, 1710, at 2.

145. THE PROCEEDINGS OF THE HOUSE OF PEERS (London, John Baker 1710).

146. LYNCH, *supra* note 84, at 113.

147. THE POST BOY (London), No. 2362, July 1–4, 1710, at 2.

148. ABEL BOYER, THE HISTORY OF THE REIGN OF QUEEN ANNE, DIGESTED INTO ANNALS YEAR THE NINTH 420 (London, Thomas Ward 1711).

149. Entry Books, SP44/77, p. 97 (July 3, 1710).

150. On the use of arrests and recognizances as a means of press control, see LAURENCE HANSON, GOVERNMENT AND THE PRESS 1695–1763, at 28–29, 62 (1967).

F. AN IRISH REPRINT OF TONSON'S *TRYAL*

Though Tonson may have been able to ignore some of the shorter accounts on the market, he undoubtedly would have taken notice of full-length accounts of the trial. One such account was produced by John Baker, and I will come to that in a moment. But before I do, there remains the matter of an Irish reprint that may have been an unauthorized reprinting of Tonson's *Tryal*. If so, it would have been an early example of a difficulty that copyright holders from Great Britain would confront on a regular basis and yet another annoyance for Tonson.

On June 24, nine days after Tonson began selling his *Tryal* to the public in London, the following appeared in *The Dublin Intelligence*:

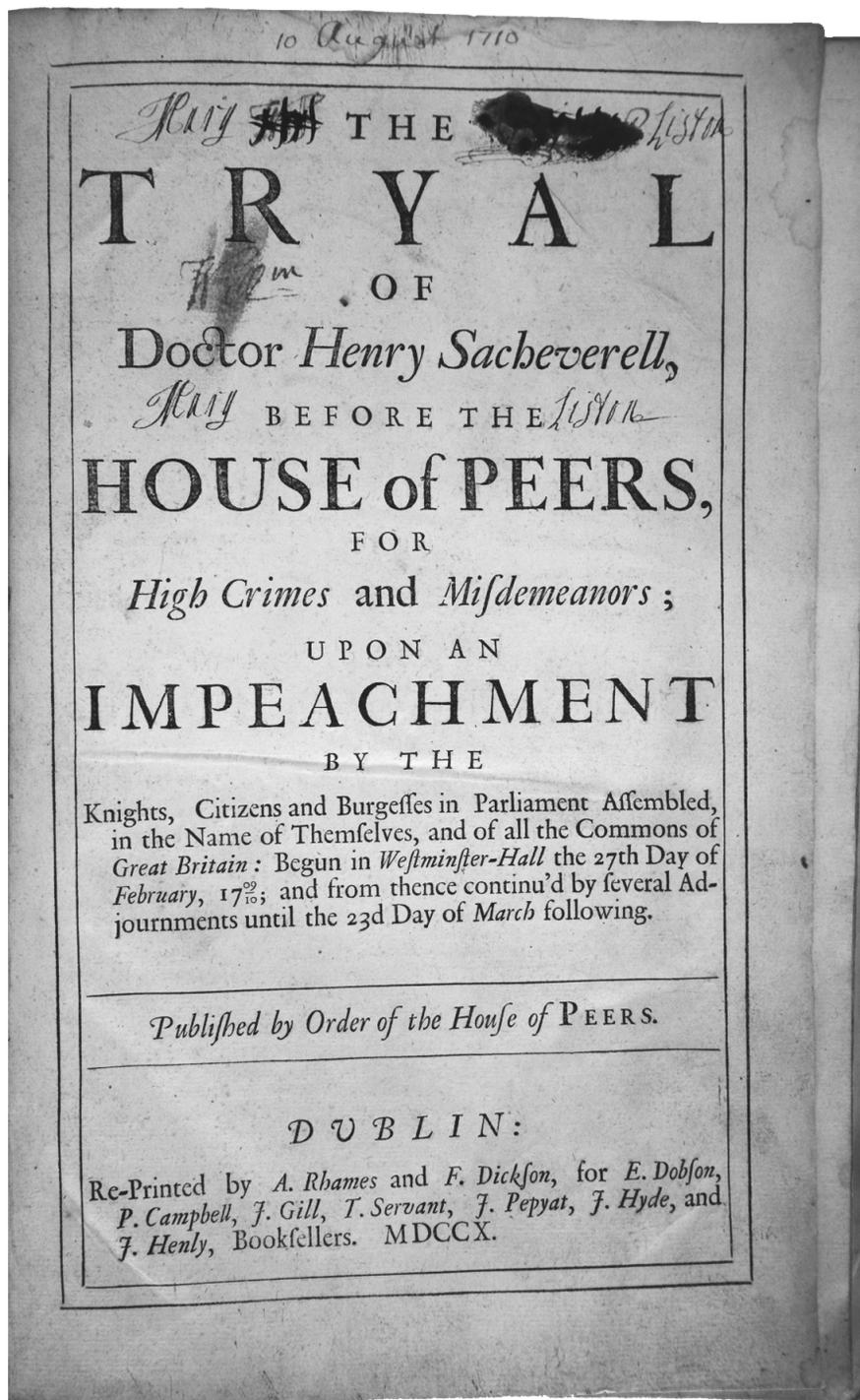
* The *TRYAL* of Doctor *Henry Sacheverell*, Published by Order of the *HOUSE of PEERS*, containing in the *London* Original Eighty six Sheets ; is now Re-Printing with all Expedition in *Dublin*, and will contain upwards of Seventy Sheets. It being so very large, 'tis design'd not to Print many more than what shall be Subscribed for : Therefore Subscriptions are desired to be hastned in. The Book will be afforded to Subscribers for Six Shillings each, paying down one half, and the other on Delivery ; and to others for Seven Shillings ; All well Bound in Calves Leather. Subscriptions are taken in *Dublin*. by *E. Dobson, P. Campbell, J. Gill, T. Servant, J. Pepyat, and J. Hyde*, Booksellers : [and listing other subscription locations throughout Ireland].¹⁵¹

The book that ultimately appeared in Dublin on August 10, 1710¹⁵² (Fig. 2) was nearly identical to Tonson's with the exceptions that it was printed on smaller folio paper with smaller type, so its pagination differed; it omitted the order stating that Tonson had been appointed the sole printer of the trial; some paragraph breaks differed in one section of the account; it contained a one-page index to its contents; and it appended four speeches of the Bishops from the debates. The additions were touted in the table of contents at the end of the book.¹⁵³

151. FRANCIS DICKSON, *THE DUBLIN INTELLIGENCE*, No. 646, June 24, 1710; *see also id.* No. 648, July 1, 1710; *THE DUBLIN GAZETTE*, No. 541, June 24–27, 1710, at 2.

152. *THE TRYAL OF DOCTOR HENRY SACHEVERELL, BEFORE THE HOUSE OF PEERS, FOR HIGH CRIMES AND MISDEMEANORS* (Dublin, A. Rhames & F. Dickson 1710). Relying on advertisements, Madan and Speck state that the reprint was published on August 26, *see* MADAN, *supra* note 105, at 138, but my personal copy of the Dublin edition has a contemporary annotation by the original owner that dates the book "10 August 1710."

153. *TRYAL*, *supra* note 152, at tbl. ("Note, *This Table, and the four Speeches at the latter end, were not in the London Edition.*").

Figure 2: Dublin reprint of Tonson's *Tryal*

I have qualified my statement that the Irish reprint may have been an illicit comprint because it remains plausible that Tonson authorized it. The conventional wisdom for many years was to presume that all Irish reprints in the 18th century were unauthorized until express evidence from the British copyright holders proved otherwise.¹⁵⁴ Scholars presumed as much because the Statute of Anne did not apply in Ireland and because numerous booksellers and authors in London and Dublin, mostly in the mid-to-late 18th century but even in 1710, discussed actual or potential business losses due to Irish reprints.¹⁵⁵ In the last fifty years, however, scholars have discovered in correspondence and imprints new evidence of collaborations between English publishers and their Dublin counterparts.¹⁵⁶ The presumption of unauthorized copies is therefore no longer as strong as it once was, but it is not entirely dead. Even in the face of this new evidence, Mary Pollard has noted that “[a]ttempting to sell London copy in Dublin was probably not a particularly common practice.”¹⁵⁷

In the matter of the *Tryal*, circumstantial evidence suggests that Tonson could have collaborated with the Dublin publishers in 1710. Three one-sheet pamphlets appeared in Dublin in 1708 and 1709 bearing imprints with Tonson’s name alongside Francis Dickson’s, one of the printers of the Dublin *Tryal*. Each pamphlet relates to the war in the Low Countries and the imprints all state the following or something like it: “*London, Printed by J. Tonson at Grays-Inn Gate. DUBLIN, Re-Printed by Francis Dickson at the UNION Coffee-House on Cork-Hill.*”¹⁵⁸ Dickson was a committed Whig partisan and was printing the votes of the House of Commons in Ireland, just as Tonson was in Great Britain.¹⁵⁹ It remains unclear, however, whether Dickson named Tonson to describe an actual affiliation or merely to credit the source.

154. See JAMES W. PHILLIPS, PRINTING AND BOOKSELLING IN DUBLIN, 1670–1800: A BIBLIOGRAPHICAL ENQUIRY 107–08 (1998) (1952); La Tourette Stockwell, *The Dublin Pirates and the English Laws of Copyright*, 12 DUBLIN MAGAZINE 30 (1937).

155. RICHARD CARGILL COLE, IRISH BOOKSELLERS AND ENGLISH WRITERS 1740–1800, at 1–21 (1986); ADRIAN JOHNS, PIRACY: THE INTELLECTUAL PROPERTY WARS FROM GUTENBERG TO GATES 145–77 (2009); M. POLLARD, DUBLIN’S TRADE IN BOOKS 1550–1800, at 68, 87–90 (1989); RICHARD B. SHER, THE ENLIGHTENMENT & THE BOOK 444–49 (2006).

156. PHILLIPS, *supra* note 154, at 107–22; POLLARD, *supra* note 155, at 97–101; James E. Tierney, *Dublin-London Publishing Relations in the 18th Century: The Case of George Faulkner*, in THE BOOK TRADE, *supra* note 5, at 133, 133–35.

157. POLLARD, *supra* note 155, at 101; accord COLE, *supra* note 155, at 1, 21.

158. ESTC No. T229489; see also ESTC Nos. T221096, T29214.

159. MARY POLLARD, A DICTIONARY OF MEMBERS OF THE DUBLIN BOOK TRADE 1550–1800, at 152–53 (2000).

The other potential proof of collaboration is that the Tonsons subsequently worked with John Hyde, one of the publishers of the reprint. In late 1708, the Tonsons had published the London edition of Matthew Prior's *Poems on Several Occasions*.¹⁶⁰ Correspondence between Prior and Jonathan Swift—the former a client of Hyde—indicates that ten years later in 1719 Hyde arranged with the Tonsons to print the poems in Dublin.¹⁶¹ Unfortunately, one cannot consider this working arrangement, coming nine years after the 1710 printing of the *Tryal*, dispositive of a collaboration on the *Tryal* itself. The Tonsons may have simply resigned themselves to deal directly with Hyde in spite of an act of unauthorized printing in 1710. Sadly, whether the Dublin reprint was authorized or not seems to be a fact that will forever be lost to history.

Importantly, if the Irish reprint was unauthorized, there seems to be little Tonson could have done about it. Because the Statute of Anne did not apply in Ireland, the Dublin publishers were free under the statute to reprint and sell the book without having to pay any copyright holders for the privilege of doing so. It also is unclear whether Tonson could have enforced his parliamentary privilege to stop an illicit Dublin reprint. Precedent for such a maneuver did not appear until 1736,¹⁶² and there is no evidence in the records of the two Parliaments suggesting that Tonson had tried. The journals of the Commons and Lords in Great Britain, along with the concomitant journals for Ireland, make no mention of the Dublin reprint.¹⁶³

The reprint would have devastated Tonson's ability to sell his *Tryal* in Ireland. The reprint sold to subscribers for six shillings six pence (the six pence having been added later for including the Bishops' speeches),¹⁶⁴ already bound in calf leather. Tonson's edition comparably equipped sold for at least ten shillings in London. When one adds the expense of shipping books from London to Ireland, Tonson's edition would probably have cost even more in Ireland, thus effectively shutting him out of that market.

Notably, it seems unlikely that Tonson would have competed with the reprint in London. The Statute of Anne by its own terms prohibited the

160. ESTC No. T75652.

161. PHILLIPS, *supra* note 154, at 109–10; ESTC No. T42640.

162. 2 JOHN NICHOLS, LITERARY ANECDOTES OF THE EIGHTEENTH CENTURY 475–76 (London, Nichols, Son & Bentley 1812).

163. That having been said, the Irish Parliament was not in session from August 29, 1710 until July 9, 1711. See D.W. Hayton, *Introduction: The Long Apprenticeship*, in THE IRISH PARLIAMENT IN THE EIGHTEENTH CENTURY: THE LONG APPRENTICESHIP 1, 23 (D.W. Hayton ed., 2001). The Parliament at Westminster was not in session from April 6 to November 24, 1710. See 1 HAYTON, *supra* note 56, at 227–30.

164. FRANCIS DICKSON, THE DUBLIN INTELLIGENCE, No. 664, Aug. 26, 1710.

importing of books written in English into Great Britain without the consent of the proprietor.¹⁶⁵ But that is incidental. Many considered the provision to be toothless,¹⁶⁶ and others believed (wrongly) that the statute did *not* prohibit importing books from Ireland,¹⁶⁷ leading Parliament to later enact a more comprehensive statute, with greater penalties, in 1739.¹⁶⁸ Rather, finding the Dublin reprint in London was unlikely because the book's printing run was mostly limited to subscribers. Additionally, cost overruns on the book, mentioned in Dublin newspapers,¹⁶⁹ made it improbable that imports would threaten sales in Great Britain.

In any case, if Tonson was in fact irritated by the June 24 announcement of a forthcoming Irish reprint, things were about to get worse.

G. PUBLICATION OF JOHN BAKER'S *COMPLEAT HISTORY*

This Day is published,

‡‡‡ A Compleat History of the whole Proceedings of the Parliament of Great Brittain against Dr Henry Sacheverell, with his Tryal before the Peers for High Crimes and Misdemeanors The Reasons of those Lords that entered their Protests, and the Speeches of several Lords before judgment was given. N.B. Besides the Speeches of the Bishops of Salisbury, Oxon, Lincoln and Norwich, it contains those of several other Peers, not printed with the Tryal [published by Jacob Tonson] nor with any of the other things that are bound with it ; its printed in 8vo on very good Paper and New Letter, Pr. Bd in Calves Leather, 5 s. Printed for J. Baker at the Black Boy in Pater Noster Row: Any Gentleman that buys it of him, shall have his Money returned if he dislikes it, and will return it in 3 Days.¹⁷⁰

The preceding advertisement appeared in the July 6–8 issue of *The Post=Man*, and it must have given Tonson reason to worry. Baker's book¹⁷¹ (Fig. 3) was, in many ways, a fuller account of the proceedings. Apart from recounting the trial itself, Baker's *Compleat History* also included accounts of the impeachment proceedings in the House of Commons and of certain pre-trial motions (Baker copied this portion of his book almost verbatim from

165. Statute, 1710, 8 Ann., c. 19, §§ 1, 7.

166. POLLARD, *supra* note 155, at 71.

167. *Id.* at 74.

168. Statute, 1739, 12 Geo. 2, c. 36, § 1.

169. FRANCIS DICKSON, *THE DUBLIN INTELLIGENCE*, No. 652, July 15, 1710 (margin); *id.* No. 654, July 22, 1710 (margin); *THE DUBLIN GAZETTE*, No. 546, July 11–15, 1710, at 2.

170. *THE POST=MAN* (Old Bailey), No. 1897, July 6–8, 1710, at 2.

171. *A COMPLEAT HISTORY OF THE WHOLE PROCEEDINGS OF THE PARLIAMENT OF GREAT BRITAIN AGAINST DR. HENRY SACHEVERELL* (London, J. Baker 1710).

Abel Roper's *Impartial Account*);¹⁷² the speeches of the Bishops of Salisbury, Oxford, Lincoln, and Norwich; a fuller account of post-trial matters taken from Baker's *Proceedings*; and, in one variant, the separate speech of Lord Haversham and an index. None of the above appeared in Tonson's folio edition of the *Trial*. When combined with the fact Baker's book was published in a more compact 502-page octavo edition, and was already bound, it made for a much better value; hence, no doubt, the money-back guarantee. Its price of five shillings in 1710 would amount to about nineteen pounds today.

The text of Baker's book, along with the bibliographical evidence, suggests that Baker produced his book in two parts, employing two separate teams of compositor and printer to copy one half each of Tonson's *Trial*. This was probably done to help rush the book to market.

The *Compleat History*, for instance, is paginated in two parts. The first half is numbered 1 to 232 and covers the impeachment and an account of the trial through the sixth day. The book then resets the numbering to 1 and continues to page 256 (or page 264 in the variant with Lord Haversham's speech). This second half comprises the remainder of the trial, the speeches of the Bishops during the post-trial debates, and Baker's own fuller account of other post-trial matters. Perhaps Baker gave one team pages 1 to 186 of Tonson's *Trial* to copy and another pages 187 through 327. Each part would be set by the respective compositors and printed. Because the compositor of the second part might not know the exact page on which the compositor of the first part would finish, the second part had to restart with page 1.

The collation of the book also suggests that the work was undertaken by two printers. In the 18th century, books were printed by hand press on "large sheets of paper with a number of pages on each side, which were later folded up to make groups of leaves."¹⁷³ These sheets, after being folded, had to be arranged in the correct order, and "to this end each sheet was signed on the first page with a letter of the alphabet so that they could readily be arranged in alphabetical order."¹⁷⁴ The alphabet was modified slightly—A to Z, but omitting I or J, U or V, and W—and once those had been exhausted, the letters would be repeated with the same omissions thusly, Aa to Zz, then Aaa to Zzz, and so on. Had the *Compleat History* been undertaken at a single printing house, one would have expected a collation akin to A–Z, followed by Aa–Kk or the like. Instead, the first half of the book, paginated 1 to 232,

172. A fact that he later admitted. *See infra* text accompanying note 372.

173. PHILIP GASKELL, A NEW INTRODUCTION TO BIBLIOGRAPHY 51 (1972).

174. *Id.*

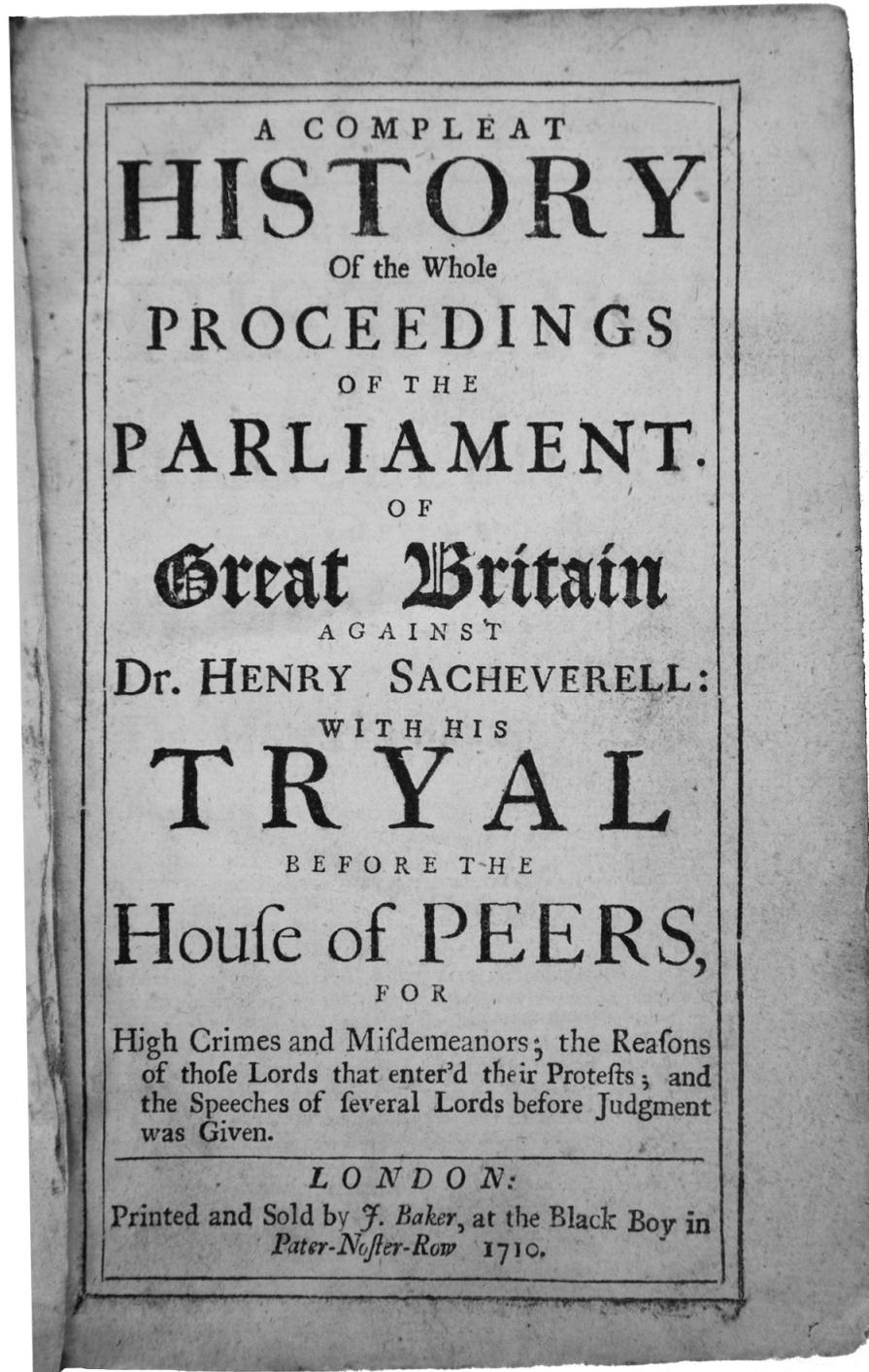


Figure 3: John Baker's *Compleat History*

ends prematurely at P and then just as the pagination resets to 1 for the second half of the book, so does the signature, starting at Aa.¹⁷⁵

Let us turn now to the text of the *trial* as it appears in Baker's book. It also suggests that different printers produced each half of the book, but more important for our purposes is its similarity to Tonson's account. The two books differ, but not in many respects. Indeed, anyone who compares them will quickly conclude, as Tonson undoubtedly did, that Baker had copied the trial portions of his book from Tonson's and had not employed his own shorthand writers at the trial.

The changes Baker made in the first part of his trial account were mostly superficial. The paragraph breaks were, with a few exceptions, copied verbatim. Baker's compositor (likely working with a markup of Tonson's *Tryal*) then changed the narrative from first person, which is how it appeared in the *Tryal*, to third person. A few other words were changed sporadically throughout. The biggest changes were that Baker moved his recital of the articles of impeachment, and Sacheverell's answer thereto, to the preliminary matters of his book, rather than embedding them in the trial portion as Tonson had. He also chose not to reproduce the text of Sacheverell's two sermons and he abridged several of the documents the clerk had read into evidence, all of which appeared in full in Tonson's *Tryal*. A few other minor omissions in this part seem to have been by mistake rather than design.

The second half of Baker's account saw changes similar to the first, but the style of composing it further suggests that it had been prepared separately. As with the first half, this part copied the text almost verbatim, changing, once again, the presentation from first person to third person. But the compositor of the second half was not as concerned about staying true to all the paragraph breaks, and he regularly combined shorter paragraphs into larger ones. A few introductory and closing sentences for each day of the trial were also omitted or editorialized. The most significant change from Tonson's text was that Baker chose not to reproduce two acts of Parliament and two proclamations, all of which had appeared in full in Tonson's edition.

IV. *TONSON V. BAKER*

Tonson did not wait long to take action against Baker. He immediately hired Marmaduke Horsley to solicit a suit in the Court of Chancery. Horsley had five months prior been admitted to Gray's Inn and called to the bar.¹⁷⁶

175. 8^o: A–O⁸ P⁴ Aa–Oo⁸ Pp⁴ Qq⁸ Rr⁴ Ss–Tt⁴.

176. THE REGISTER OF ADMISSIONS TO GRAY'S INN, 1521–1889, at 357 (London, Hansard Publ'g Union, Ltd., Joseph Foster ed., 1889); 2 THE PENSION BOOK OF GRAY'S

But it appears he had already been practicing as a solicitor, given that his marriage to Judith Roberts at Gray's Inn Chapel in 1697 listed him as a "lawyer."¹⁷⁷ Horsley thus has the honor of being the first lawyer to file a lawsuit under the Statute of Anne.

Horsley drafted a bill of complaint (Fig. 4) and filed it on July 8, 1710.¹⁷⁸ As with other bills of the period, it was written on parchment and deposited in one of the divisions of the Six Clerks' Office. It also followed the pattern typical of copyright complaints. It set forth the plaintiff's right and how the defendants had infringed it, and then requested a discovery of material matters, an injunction, and a writ of subpoena ad respondendum.

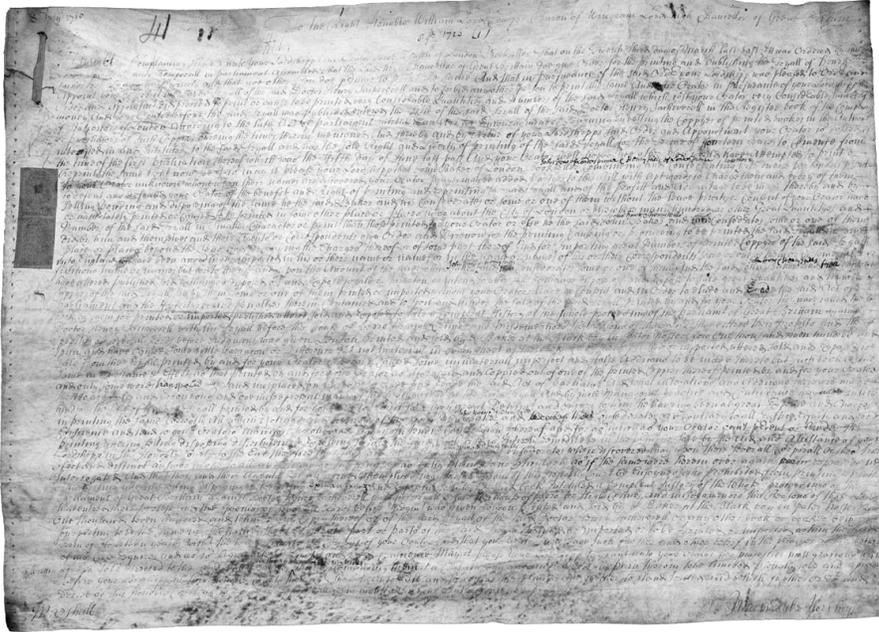


Figure 4: Bill of complaint, C9/371/41, m. 1 (Ch. 1710)

I will turn to the particulars of the claim in a moment, but I will first treat the other players in the case—the three defendants. Each of them has an interesting story. Two tussled with Tonson before, and John Baker in particular clashed with Tonson and his nephew over disputed copyrights

INN 1669–1800, at 153 (Reginald J. Fletcher ed., 1910) (calling him six days after admitted). The manuscript Pension Order Book indicates that Horsley was called to the bar by grace rather than by standing. Pension Order Book, Gray's Inn MS PEN/1/2 (Feb. 10, 1709/10) (“Ordered that Mr Mar’d’ Horsley a Member of this Society be Admitted to the Barr ex gratia.”).

177. REGISTER, *supra* note 176, at lv.

178. Tonson v. Baker, C9/371/41, m. 1 (Ch. 1710).

before *Tonson v. Baker*. The narratives below also provide a snapshot of the book trade just before the Statute of Anne through the eyes of these defendants, all of whom were very active in the trade.

A. THE DEFENDANTS

The first defendant of course was John Baker; his name was on the imprint. The others—John How and Henry Hills Jr.—were added to the bill with interlineations, meaning Tonson must have discovered their involvement after the bill was engrossed but before Horsley submitted it to the court. No allegations in the bill are specifically directed to any of the defendants; they are instead alleged to have acted in concert. Tonson identifies Baker as a “bookseller” and How and Hills as “printers.”¹⁷⁹ That Tonson named three defendants instead of one is to be expected, as it would have been obvious to Tonson that Baker had not worked alone. Baker was a trade publisher, not a printer, and though not specifically mentioned in the bill of complaint, the division of labor in the printing of the book would have been immediately apparent to Tonson.

Apart from Baker, whose involvement was obvious, we are left to wonder why Tonson named How and Hills as the printers from among the roughly sixty others working in London at the time.¹⁸⁰ I suspect that Tonson had informants in the trade who, on this occasion, provided the information he desired.¹⁸¹ But he may have also used circumstantial evidence to point himself in the right direction. Unfortunately, conjecture is all that remains for us today.

1. *Henry Hills Jr.*

It would have come as no surprise to the trade that Tonson sued Henry Hills Jr. for copyright infringement. Hills was the son of Henry Hills Sr., one of the holders of the office of King’s Printer during the reigns of Charles II and James II and a respected member and former master of the Stationers’ Company.¹⁸² But the apple fell far from the tree, and Hills Jr. was destined to become the most despised printer in London in the early 1700s.

179. *Id.* at l. 11.

180. *See generally* Treadwell, *supra* note 86.

181. *Cf.* Letter from an Informant to Jacob Tonson Jr. (Aug. 29, 1734), British Library Add. MS 28,275, f. 319 (concerning the pirating of Shakespeare’s *The Merry Wives of Windsor*).

182. Richmond P. Bond, *The Pirate and the Tatler*, 18 LIBR. 257, 263–73 (5th Ser. 1963). Which is not to say that Hills Sr. did not have his own problems. *See, e.g.*, *Lady Bergavenny v. Hills*, Harvard Law School MS 1071, f. 7^v ([K.B.] 1686) (50£ libel verdict); *see also* Ian Gadd, *Hills, Henry, Senior*, in OXFORD DICTIONARY OF NATIONAL BIOGRAPHY (2008).

Hills Jr.'s career had an inauspicious start. His first known venture in printing, which occurred in India in 1674 under the auspices of the East India Company, was a failure.¹⁸³ Having brought only English type to India, Hills found himself unable to print works in the local language. Accused of mismanaging the accounts as well, he returned in disgrace to London in 1679 and then became a freeman of the Company of Stationers by patrimony.¹⁸⁴

Nothing in his early history indicates a predilection toward piracy. Indeed, it appears Hills respected copyrights when first starting out. He registered several works for copyright in the 1680s, for example, including six during the first statutory interregnum.¹⁸⁵ But his life and career took a turn for the worse in 1688. He accepted a job as messenger of the press—a police-like position whose task was to enforce censorship licensing—which probably made him few friends among Stationers and authors.¹⁸⁶ More importantly, his father largely disinherited him for refusing to convert to Roman Catholicism. Hills Sr.'s lucrative share in the patent for the office of King's Printer, which could have offered a steady stream of income to his first son, went instead to Hills Jr.'s stepmother and his younger siblings.¹⁸⁷

Hills did not break out as a pirate until after he unsuccessfully petitioned to recover a share of the patent. He alleged that his siblings' shares were forfeited on account of being Papists, and he thus prayed in 1691 and 1698 that the King might grant him "the said Forfeitures & forfeited Shares of the remaining term" of the patent.¹⁸⁸ The petitions were taken under advisement, but it appears that they were never acted upon. Hills's younger brother Gilham continued to be named as a plaintiff, and as a holder of the patent, from 1696 to 1725 in over forty lawsuits brought for infringement.¹⁸⁹ Though it may be only a coincidence, perhaps it was Hills's inability to secure the patent that led him to the book-trade piracy for which he became known.

183. J.B. Primrose, *A London Printer's Visit to India in the Seventeenth Century*, 20 LIBR. 100, 100–03 (4th Ser. 1939).

184. *Id.* at 102–03; MCKENZIE, *supra* note 85, at 79, No. 2128 (freedom of the Stationers' Company).

185. 3 STATIONERS' REGISTERS, *supra* note 19, at 134–35, 190, 218, 270, 276, 293, 316, 333, 362, 394 (registrations from 1682/3 to 1691).

186. *See, e.g.*, Entry Books, SP44/337, p. 392 (Feb. 11, 1687/8); *id.* SP44/56, p. 406 (Feb. 22, 1687/8); *id.* SP44/338, pp. 448–49 (Sept. 2, 1689); Court Book F, f. 105^r (Ct. Ass. 1688).

187. Will of Henry Hills Sr., PROB 11/398, f. 45^r (will Dec. 10, 1688; probate Jan. 21, 1689/90); Entry Books, SP44/238, pp. 228–29 (June 9, 1698).

188. Entry Books, SP44/238, pp. 228–29 (June 9, 1698); *see also id.* SP44/235, p. 171 (Aug. 13, 1691).

189. H. Tomás Gómez-Arostegui, Register of Copyright Infringement Suits and Actions From c.1560 to 1800, <http://www.oldcopyrightcases.org>.

Hills's disrespect of the supposed printing rights of others before the Statute of Anne was notorious. According to John Nichols, compiler of *Literary Anecdotes of the Eighteenth Century*, Hills had become infamous for pirating "every good Poem or Sermon that was published."¹⁹⁰ Richmond Bond, in his study of Hills's practices,¹⁹¹ recounts the pejorative Stationers and authors directed at Hills in the early 1700s: John Castaing stated in November 1709 that Hills was "Notorious for Pyrating Booksellers Copies, to their exceeding Loss";¹⁹² John Dunton called him an "ARCH-PIRATE, and hard'ned Wretch" in 1710;¹⁹³ and Adam Addlestaff in the same year complained that authors who "hope[d] to reap the Fruit of their Labours, by communicating to the World the Product of their Brain, [were] immediately set upon by a Gang of Pyrates, with H.H. for Captain, who rob[bed] them of their Cargo."¹⁹⁴

Chancery records confirm that Hills was enough of an irritant to have been sued three times for infringement in 1706 and 1708. In one suit, Hills suffered the humiliation of being sued by his own brother for infringing the patent for the office of the Queen's Printer.¹⁹⁵ The other two suits were based on a purported common-law copyright.¹⁹⁶

Notably, Jacob Tonson was the plaintiff in one of those suits. The circumstances of the case bear recounting in some detail because they further illuminate Tonson and Hills's views on literary property in the years just before the Statute of Anne and *Tonson v. Baker*.

In *Tonson v. Hills*,¹⁹⁷ Tonson claimed to have purchased from an author the "Originall Coppy and Coppy right or propriety of Coppy" of *An Epistle from the Elector of Bavaria to the French King: After the Battel of Ramillies*. Tonson published the poem without having previously registered it with the Stationers' Company.¹⁹⁸ Unable to cite the customs of the Company, Tonson relied directly on a copyright at common law. He posited that "according to the Lawes & Customes of this Realme [he] ought to have the sole Impression and first utterance [i.e., sale] of the sayd Book and of all Coppys of the

190. 8 NICHOLS, *supra* note 162, at 168.

191. Bond, *supra* note 182, at 257, 263–73.

192. British Library Harley 5995 No. 84.

193. JOHN DUNTON, *ATHENIANISM*, at xv (London, Thomas Darrack 1710).

194. ADAM ADDLESTAFF, *THE INDIAN'S PETITION* 12 (London, Tho. Harrison & J. Baker 1710) (the author's name is likely a pseudonym).

195. *Bill v. Hills*, C5/592/22 (Ch. 1706).

196. *Rogers v. Hills*, C5/342/64 (Ch. 1708); *Tonson v. Hills*, C8/623/33 (Ch. 1706).

197. C8/623/33, m. 1 (Ch. 1706).

198. *See* ESTC No. T62160.

Originall Coppy.”¹⁹⁹ Tonson further alleged that Hills had printed the same work,²⁰⁰ save for the absence of a title page and dedication. And because Hills had printed his with “Smaller Character” on “Course paper,” and had paid “Nothing for the Coppy of the sayd booke or Poem,” Tonson alleged that Hills was able to “very much undersell” Tonson’s edition of the poem.

In his answer,²⁰¹ Hills professed ignorance of whether Tonson had bought anything from the author, and whether as a consequence Tonson had the sole right to print the work according to the laws and customs of the realm. He confessed, however, that he had paid nothing for the work, and criticized Tonson for printing his edition in folio, large character, and large margins. According to Hills, this “unreasonably . . . swelled or raised up [the poem] to so great a rate or price as twelve pence a peice.” Hills admitted it was his goal that the “people of this Kingdome . . . should have the said poem for a little money.”²⁰² He confessed to printing 1,500 copies, 1,000 of which had already been sold to street hawkers who offered them for half a penny. Hills then stated he had only made ten shillings thus far.

Unfortunately, the orders in the case reveal little about the outcome. The Master of the Rolls permitted Hills to proceed *in forma pauperis* and assigned as his barrister none other than Spencer Cowper.²⁰³ Moreover, even though Tonson had requested an injunction in his complaint, he never moved for one in open court and thus never obtained one.²⁰⁴ Perhaps he was wary of pressing a claim based on an unconfirmed right at common law. The infringement may have been of relatively little consequence and not worth the risk of testing the right. Notably, one month after Hills filed his answer, Tonson and several other booksellers petitioned Parliament for a new copyright statute.²⁰⁵ One must wonder whether Hills was the impetus.

199. *Tonson*, C8/623/33, m. 1. That Tonson limited his own right to distribute the work to its first sale may, perhaps, imply an early understanding and application of what we now call the first-sale or exhaustion doctrine.

200. *See* ESTC No. N66101.

201. *Tonson*, C8/623/33, m. 2 (Ch. 1706/7).

202. This claim is consistent with his mantra, which appeared in the early 1700s on the imprints of pirated pamphlets, that he had printed them for the benefit of the poor. As one commentator noted, it made for a “good slogan, even if ‘the Poor’ meant Henry Hills himself.” Mildred L. McCracken, *Henry Hills, Pirate Publisher: The Significance of his Pamphlets* 1 n.2 (June 1942) (unpublished Ph.D. dissertation, University of Texas).

203. *Tonson*, C33/308, f. 139^v (Ch. 1706/7).

204. For injunction prerequisites, see Gómez-Arostegui, *supra* note 7, at 1228–33, 1235–36.

205. 15 H.C. JOUR. 313 (Feb. 26, 1706/7). The expense of the petition was borne in part if not *in toto* by the Stationers’ Company. Court Book G, f. 138^v (Ct. Ass. Mar. 1, 1706/7).

Nothing more occurred in the case after Hills answered, and sometime later in 1708 Tonson reissued the epistle as part of a larger collection in folio.²⁰⁶

Tonson must have had other reasons to suspect that Hills should be named as a co-defendant in *Tonson v. Baker*, apart from Hills's reputation as a pirate and their previous clash. Chief among them was probably that Hills had worked with John Baker before. For how long, we do not know. It was not common for a trade publisher like Baker to identify in the imprints of his books which printer he had utilized. We do know, however, that Hills and Baker had worked together in December 1709 when they printed and published a pirated compilation of the periodical *The Tatler*.²⁰⁷ They also seem to have partnered, at least informally, when Baker published *Hudibras*.²⁰⁸ Ironically, the best evidence of their collaborations appears in the register book created by the Company of Stationers following the Statute of Anne. Hills entered several books after 1710, including two in partnership with John Baker on June 12 and October 4, 1710.²⁰⁹ Though the *Compleat History* was not among them—Baker registered that book in his name alone—Tonson may have nevertheless relied on the June partnership as evidence of Hills's close association with Baker and his involvement in the *Compleat History*.

Hills never responded to the complaint in *Tonson v. Baker* and was dead by 1712.²¹⁰ After his death, *The Evening Post* advertised his illicit stock and noted there would “never be any of the same, or any in the like manner, reprinted after these are gone, there being an act of Parliament to the contrary.”²¹¹ A large part of his old stock was purchased by Thomas Warner,²¹² who later began a partnership in 1716 with our John Baker in Paternoster Row.²¹³ Though it is sometimes presumed that the Statute of Anne was responsible for halting Hills's piratical ways, the book trade may have actually had his death to thank for that.

2. John How

Tonson also named John How as a defendant in *Tonson v. Baker*. How never responded to the suit either, and thus we have no admission of his

206. ESTC No. N27926.

207. Bond, *supra* note 182, at 266.

208. *See infra* text accompanying note 302.

209. Register Book MS, *supra* note 81, at 40, 54, 76, 97.

210. Administration of Henry Hills Jr., PROB 6/88, f. 46^r (Mar. 29, 1712).

211. 1 NICHOLS, *supra* note 162, at 72.

212. Edward Solly, *Henry Hills, the Pirate Printer*, in 11 THE ANTIQUARY 151, 152–53 (London, Elliot Stock 1885). This article should be used with caution as it contains errors.

213. Michael Treadwell, *London Trade Publishers 1675–1750*, 4 LIBR. 99, 111 (6th Ser. 1982).

purported role in printing the *Compleat History*. We do know, however, that How had previously partnered with Baker on other books, just as Henry Hills Jr. had. In 1707, a “J. How” worked with John Baker at the Sun and Moon in Cornhill.²¹⁴ Moreover, soon after the Statute of Anne was enacted, but before Baker published his *Compleat History*, John How registered two copyrights in partnership with Baker (then at Paternoster Row).²¹⁵ We also know that How dealt in at least two other books with Baker in 1710.²¹⁶ This information, and other bits that have since been lost to history, likely helped point Tonson’s compass in How’s direction.

John How had a sharp streak in him, much as Hills had, but How’s character was not as clear cut. How was both a pirate *and* a champion of copyright, which makes his purported involvement here most interesting.

How became a frequent defendant in Chancery starting a few years after he completed his apprenticeship in 1680.²¹⁷ In 1682, Edward Atkins and others sued him for infringing the patent for law books.²¹⁸ And in the same year, the Stationers’ Company sued How for violating its patent for printing primers, psalms, almanacs, and the like.²¹⁹ In both cases, interlocutory injunctions were entered against him. In 1684, Blanch Pawlett sued How and his brother Job during the statutory interregnum for infringing what Pawlett alleged was a copyright in Richard Allestree’s *The Whole Duty of Man*,²²⁰ but it appears the suit was ultimately unsuccessful.²²¹ How was then ordered arrested in 1684 for printing dangerous works,²²² and then narrowly avoided being sued in 1685 for printing *The XV Comforts of Rash and Inconsiderate Marriage*.²²³ He was not sued again, apparently, until 1703, when the holders of the office of King’s Printer named him as a person who had violated their patent.²²⁴

214. ESTC No. T61370. For more on the Sun and Moon shop and John Baker’s affiliation with it, see *infra* text accompanying notes 281–85.

215. Register Book MS, *supra* note 81, at 35, 36.

216. See ESTC Nos. N13670, T22305. The latter book was published anonymously, but an upset author identified the culprits as “John How, Printer, and John Baker, Bookseller.” AN ALPHABETICAL CATALOGUE OF AN EXTENSIVE COLLECTION OF THE WRITINGS OF DANIEL DE FOE 24 (London, Whitmore & Fenn 1829).

217. MCKENZIE, *supra* note 85, at 73, No. 1957 (freedom of the Stationers’ Company).

218. Atkins v. Bassett, *sub nom.* Atkins v. Harris, C33/259, f. 62^r (Ch. 1682).

219. Stationers v. Boddington, C33/260, f. 37^v (Ch. 1682). The Company had previously fined him 20 nobles. *In re* How, Court Book E, f. 153^r (Ct. Ass. 1682).

220. Pawlett v. Lee, C10/211/60, C33/262, ff. 323^v–324^r (Ch. 1683/4).

221. Gómez-Arostegui, *supra* note 7, at 1238–39.

222. Entry Books, SP44/335, p. 406 (Dec. 30, 1684).

223. Heyrick v. How, Court Book F, f. 42^v (Ct. Ass. 1685).

224. Bill v. How, C5/592/21 (Ch. 1703). What he was doing in the interim years, or not doing, is not readily apparent. See PLOMER, *supra* note 119, at 162. He was still working,

The seemingly incorrigible How also ran into trouble with Daniel Defoe.²²⁵ How printed an unauthorized collection of Defoe's works in 1703,²²⁶ a time when Defoe was trying to maintain a low profile with the government. Defoe had recently been convicted and imprisoned for publishing an anti-government tract that had been read literally, though he had in fact intended it sarcastically.²²⁷ Defoe complained about How's collection, albeit without expressly naming him, in Defoe's own corrected edition of the collection. He labeled How a "Piratical Printer, as such are very rightly called, who unjustly print other Mens Copies."²²⁸ Defoe complained again later that it was a "most aggravated Theft . . . as it was invading his Right."²²⁹

How apparently grew tired of being a pirate, and being pirated himself, because he urged Parliament to enact a new copyright statute not long afterward. Deazley believes that How was the author of a one-sheet pamphlet dated c.1706 and entitled *Reasons Humbly Offer'd for a Bill for the Encouragement of Learning, and Improvement of Printing*.²³⁰ The author complained of "divers Persons having of late taken upon them[selves] to Reprint very Uncorrectly such Copies [of others]."²³¹ Towing a utilitarian line, the pamphlet claimed that copyright protection was necessary to help "Propagat[e] the most useful Parts of Knowledge and Literature."²³²

Three years later, How wrote the short tract *Some Thoughts on the Present State of Printing and Bookselling* in which he again urged Parliament to "secure Property in Books by a Law."²³³ The practices of publishers and printers during the statutory interregnums had become chaotic. Most everyone, How claim-

though, as he had registered several copyrights from 1684 to 1690/1 and was charged by presentment in 1699 for printing *The Weekly Comedy*. 3 STATIONERS' REGISTERS, *supra* note 19, at 249, 369, 373, 379 (copyright registrations); City of London, Sessions Papers, LMSLPS150110066 (July 14, 1699), <http://londonlives.org>.

225. MAXIMILLIAN E. NOVAK, DANIEL DEFOE: MASTER OF FICCTIONS 199–201 (2001).

226. A COLLECTION OF THE WRITINGS OF THE AUTHOR OF THE TRUE-BORN ENGLISH-MAN (London, [John How] 1703); *see also* JOHN R. MOORE, A CHECKLIST OF THE WRITINGS OF DANIEL DEFOE 22–23 (2d ed. 1971) (attribution of book to John How).

227. PAULA R. BACKSCHEIDER, DANIEL DEFOE: HIS LIFE 125–27 (1989).

228. DANIEL DEFOE, A TRUE COLLECTION OF THE WRITINGS OF THE AUTHOR OF THE TRUE BORN ENGLISH-MAN sig. A3^v (London, s.n. 1703).

229. DANIEL DEFOE, A SECOND VOLUME OF THE WRITINGS OF THE AUTHOR OF THE TRUE-BORN ENGLISHMAN sig. A4^r (London, s.n. 1705).

230. DEAZLEY, *supra* note 4, at 32–33 (citing Lincoln's Inn MP102, f. 312).

231. REASONS HUMBL Y OFFER'D FOR A BILL FOR THE ENCOURAGEMENT OF LEARNING, AND IMPROVEMENT OF PRINTING (s.l.n. c.1706), <http://copyrighthistory.org>.

232. *Id.*

233. JOHN HOW, SOME THOUGHTS ON THE PRESENT STATE OF PRINTING AND BOOKSELLING 3 (London, John How 1709).

ed, pirated the works of others, but he lamented that the wealthy publishers had become very good at it: “[I]he great Traders can make what Impressions of *Books* they please, and can vend them with as much Ease and Privacy as they printed them.”²³⁴ How further protested that whereas the wealthy publishers could pursue the poorer ones in court, the converse was not always true. Notably, he twice complained of the practices of Henry Hills Jr.²³⁵

Recognizing he would be labeled a hypocrite, How responded as follows:

Some People perhaps will ask how long I have been of this Opinion, and why I did not practice it sooner? In Answer to which, I say ‘tis not my Opinion now, for I act against my Principle, and am herein an *Occasional Conformist*,²³⁶ made so by the Practice of some of the greatest Men of the Trade, and not by the Byass of a vitious Inclination ; and I hope by this Means to discourage some from proceeding in this Way, by animating others to engage heartily in the good Work of securing Property by a Law²³⁷

This frankness is consistent with John Dunton’s assessment, made four years earlier, that How was “*Generous and Franck*, and speaks whatever he thinks; which, in Spight of the HIGH-FLYERS, has given him an *Honest Character*.”²³⁸ In essence, How was claiming that the market had forced him to pirate, but he was also admitting, quite frankly, that piracy was now doing him more harm than good. He was pledging to conform if the rest of the market would, and this, he posited, would only be possible with the enactment of copyright legislation. The remainder of How’s tract contained specific legislative proposals.²³⁹ Chief among them was that he wanted copyright enforcement to occur in a specialized tribunal that could move quickly and more economically.²⁴⁰

It is vexing that How would choose to infringe a book so soon after the Statute of Anne. Perhaps he was unhappy with the statute’s final form. The statute still called for enforcement in regular courts, a costly venture, thereby retaining a system that disadvantaged the less wealthy traders.

234. *Id.* at 4.

235. *Id.* at 10, 12.

236. A reference to those who only occasionally took communion in the Church of England in order to qualify for public office under the Test Acts of the 17th century.

237. *Id.* at 11.

238. JOHN DUNTON, *THE LIFE AND ERRORS OF JOHN DUNTON LATE CITIZEN OF LONDON* 297 (London, S. Malthus 1705) (recollections of the London book trade).

239. HOW, *supra* note 233, at 11–16.

240. *Id.* at 13–15.

If his activities in the years after *Tonson v. Baker* are any indication, How remained recalcitrant. He was sued at least twice after *Tonson*.

In 1716, How was sued for printing the new version of the psalms of David.²⁴¹ The suit is fascinating because it was probably the first brought by an author for a work protected under the legacy clause of the Statute of Anne.²⁴² How admitted he had printed the book around four years prior for booksellers, including John Baker, and he invoked the statute in his own defense, claiming he was free to print the psalms because the authors and co-owners of the copyright in the work had failed to register it.²⁴³ The Court of Chancery read the statute and overruled the demurrer as an interlocutory matter, assuring How and a co-defendant that by answering they would not “Subject themselves to the penalyes in the [statute].”²⁴⁴

In another suit, also filed in 1716, How was sued by the King’s Printers, including by Henry Hills’s brother Gilham, for violating their patent.²⁴⁵ The Court of Chancery enjoined How from printing Bibles in violation of the patent,²⁴⁶ and nearly two years later, in July 1718, ordered him imprisoned for breaching the injunction.²⁴⁷ He died not long after in September 1719,²⁴⁸ robbing us of further exploits in the book trade.

3. *John Baker*

We come now to John Baker, the only defendant who revealed himself on the imprint of the *Compleat History*. Compared to Jacob Tonson, who has

241. *Stationers v. White*, C11/749/6, m. 1 (Ch. 1716).

242. The plaintiffs’ book was NAHUM TATE & NICHOLAS BRADY, A NEW VERSION OF THE PSALMS OF DAVID (London, Company of Stationers 1696). Tate, Brady, and the Stationers’ Company each owned shares in the work. (Partnership with the Company was necessary because the work, as a psalm, fell within the Company’s patent. *See supra* text accompanying note 6. Had Tate and Brady published the book on their own, they would have exposed themselves to a suit. *See, e.g.*, *Stationers v. Partridge*, 10 Mod. Rep. 105 (K.B. 1712).) Though Tate was dead by the time the suit was filed in 1716, Brady was still alive and was named as a plaintiff alongside the Stationers’ Company and several others.

243. *Stationers*, C11/749/6, m. 2, C11/751/16 (Ch. 1716–1716/7). Notably, it appears that Nahum Tate considered suing Baker as early as December 1711. Tate offered “to Contribute to the Charge of prosecuting a Suite against” Baker for publishing the psalms without Tate’s permission. Court Book G, f. 196^r (Ct. Ass. Dec. 20, 1711); *cf. also* ESTC No. T91872.

244. *Stationers*, C33/328, f. 37^v (Ch. 1716). For more on registration as a prerequisite for copyright protection, see *infra* note 407.

245. *Baskett v. How*, C11/2610/12 (Ch. 1716).

246. *Id.* at C33/327, f. 2^v (Ch. 1716).

247. *Id.* at C33/329, f. 385^r (Ch. 1718).

248. Register of Burials, St. Benet Gracechurch, Guildhall MS 5671 (Sept. 16, 1719).

been treated to four separate studies of his life and businesses,²⁴⁹ relatively little is known of Baker. He left a shorter paper trail than Tonson, which is not surprising given the circles in which they traveled. Whereas Tonson's closest associates ran the country, Baker's did not. Apart from that deficit, previous attempts by scholars to outline Baker's practices and to correctly identify him as part of larger studies on the book trade have also been hampered by the lack of online resources that are available today, such as the English Short Title Catalogue, Early English Books Online, Eighteenth Century Collections Online, and the British Book Trade Index.²⁵⁰ Making matters worse, John Baker was an extremely common name in London. Thus, those who have traced Baker have rightfully been unsure of his guild affiliation, if any,²⁵¹ and of where and when he first began working in the London book trade.²⁵²

Baker could conceivably have been a Stationer, given the nature of the work he performed. A John Baker was admitted to the freedom of the Company of Stationers and the City of London in April 1694, after serving as an apprentice to Brabazon Aylmer.²⁵³ There was also a John Baker who bound himself as an apprentice to Henry Playford in March 1701/2, though he was never freed.²⁵⁴ But one did not need to be a member of the Company to work as a bookseller or publisher. Rules regulating the book trade had sometimes required as much from booksellers, but they were gone by 1695.²⁵⁵ Apart from those industry-specific rules, only those engaged in manual

249. See generally HARRY M. GEDULD, *PRINCE OF PUBLISHERS* (1969); LYNCH, *supra* note 84; G.F. PAPALI, *JACOB TONSON, PUBLISHER* (1968); Sturges, *supra* note 87.

250. See respectively <http://estc.bl.uk>; <http://eebo.chadwyck.com>; <http://gale.com/ecco>; <http://www.bbt.bham.ac.uk>. I hope I will be forgiven for mentioning my own as well, a register of copyright suits before the year 1800, <http://oldcopyrightcases.org>.

251. KARL TILMAN WINKLER, *HANDWERK UND MARKT* 384 n.85, 395 n.131 (1993).

252. PLOMER, *supra* note 119, at 14–15; Treadwell, *supra* note 213, at 109, 111–12.

253. MCKENZIE, *supra* note 85, at 5, No. 105 (company freedom); List of Freemen 1681–1699, LMA COL/CHD/FR/03/02/001, No. 90 (Apr. 1694) (freedom of the City).

254. D.F. MCKENZIE, *STATIONERS' COMPANY APPRENTICES 1701–1800*, at 275, No. 6412 (1978). There were other John Bakers who were members of the Company, but they either predeceased our Baker or continued to work long after he died.

255. The Printing Act of 1662 largely limited bookselling to members of the Company, those who were otherwise brought up in the book trade, or those specially licensed. Statute, 1662, 13 & 14 Car. 2, c. 33, §§ 7, 20. For a time, the Company also exerted stronger controls on bookselling by non-Stationers as a consequence of a new Charter obtained in 1684. The Charter was withdrawn in 1688 and declared void in 1690, so the new powers were short lived. Michael Treadwell, *The Stationers and the Printing Acts at the End of the Seventeenth Century*, in 4 *THE CAMBRIDGE HISTORY OF THE BOOK IN BRITAIN* 755, 768–69 (John Barnard et al. eds., 2002); Cyprian Blagden, *Charter Trouble*, 6 *BOOK COLLECTOR* 369, 374–75 (1957).

occupations were supposed to have apprenticed in their occupational field.²⁵⁶ Baker neither made his own paper, printed his own books, nor bound them; he merely arranged for others to do so and sold the goods wholesale and retail. As a retailer in the City of London, Baker was required by the custom of the City to be a freeman of a guild and of the City itself.²⁵⁷ But he could just have easily been a member of a guild unrelated to the book trade. Or he might have even skirted joining for as long as he could get away with it.²⁵⁸

The recent work of genealogist Cliff Webb, who has indexed the apprenticeship records of nearly sixty City companies in the last fifteen years,²⁵⁹ coupled with the use of additional indices and records, has now made it possible to determine John Baker's guild affiliation. The first piece of the puzzle comes from a libel case brought in 1713 against Daniel Defoe in which Baker testified. Baker identified himself as a bookseller on Paternoster Row, but provided no guild affiliation.²⁶⁰ Fortunately, a chap named William Boreham testified in the same case that he was Baker's apprentice.²⁶¹ Working backward from that testimony, and utilizing Webb's indices and others, a single match appears among the apprenticeship records. On April 26, 1710, a William Boreham of London had become an apprentice to a John Baker of the Company of Upholders (i.e., upholsterers).²⁶²

If there was any doubt as to whether our Baker is the Upholder identified here, it is dispelled by Baker's own freedom records. Baker was made a freeman of the Upholders' Company by patrimony on April 26, 1710,²⁶³ meaning that his father (also named John) was an Upholder. No additional biographical information is provided in the Company records, but the freedom records of the City of London are more complete. To qualify for admission by patrimony, Baker was required to produce six men to swear that he was born to a freeman of the City, and that his birth occurred after

256. WILLIAM BOHUN, *PRIVILEGIA LONDINI* 115–19 (London, D. Brown & J. Walthoe 1702). Even this requirement seems to have waned by the reign of Queen Anne.

257. GILES JACOB, *CITY-LIBERTIES* 85–87, 109 (London, E. Nutt et al. 1732).

258. See J.R. Kellet, *The Breakdown of Guild and Corporation Control over the Handicraft and Retail Trade in London*, 10 *ECON. HIST. REV.* 381, 385–86 (1958) (noting that the custom had lost much of its punch in the early 1700s, leading to an ordinance in 1712 reconfirming it).

259. See 1–48 CLIFF WEBB, *LONDON LIVERY COMPANY APPRENTICESHIP REGISTERS* (1996–2008).

260. Information of John Baker, KB33/5/5, f. 3^{r-v}, SP34/21, ff. 30^v–32^r (Apr. 10, 1713).

261. Information of William Boreham, KB33/5/5, f. 4^r, SP34/21, f. 32^{r-v} (Apr. 10, 1713).

262. Upholders' Co., Presentments, 1704–1772, Guildhall MS 7142/1, p. 40 (Apr. 26, 1710).

263. Upholders' Co., Freedom Admissions, Guildhall MS 7142/1, p. 38 (Apr. 26, 1710); Upholders' Co., Minute Books, Guildhall MS 7141/2, p. 91 (Apr. 26, 1710).

his father had himself become free. Tellingly, two of Baker's guarantors were Stationers, one of whom was his regular partner John How.²⁶⁴ Baker was later elected to the livery of the Upholders' Company in April 1712, and accepted it in May 1712,²⁶⁵ which made him eligible to vote in City parliamentary elections. But he was not otherwise active within the Company.

Notably, Baker bound one other apprentice—one who appears, by fate or coincidence, to have spawned another rebellious bookseller and who thus bears mentioning. A William Carnan, originally of Reading, bound himself to Baker in 1713.²⁶⁶ Though I have found no dispositive evidence, this might be the William Carnan who later became the printer and publisher of *The Reading Mercury* newspaper.²⁶⁷ If so, it was Carnan's son, Thomas, who returned to London to work in the trade in the mid-18th century and became the firebrand who busted the Company of Stationers' 160-year-old patent for the printing of almanacs.²⁶⁸

So how and when did Baker come to work in the book trade? It has previously been presumed that he started selling books at Mercers' Chapel in Cheapside in 1702 or 1703.²⁶⁹ A John Baker did begin selling books at that location in February 1701/2²⁷⁰ after marrying its proprietor Mary Fabian.²⁷¹ But this was not our Baker. The marriage license allegation between Baker and Fabian demonstrates that in February 1701/2, Baker was thirty years old.²⁷² Our John Baker, who we know was married to Shirley Baker née

264. Freedom Admission Paper, LMA COL/CHD/FR/02/0268, No. 121 (Apr. 1710); see also List of Freeman, 1700–1712, LMA COL/CHD/FR/03/02/002, No. 278 (Apr. 1710).

265. Upholders' Co., Minute Books, Guildhall MS 7141/2, p. 114 (Apr. 10, May 7, 1712).

266. Upholders' Co., Presentments, 1704–1772, Guildhall MS 7142/1, p. 59 (Sept. 9, 1713); Inland Revenue Book of Stamps: Apprenticeships, IR1/2, f. 122^v (Oct. 5, 1713).

267. K.G. BURTON, *THE EARLY NEWSPAPER PRESS IN BERKSHIRE, 1723–1855*, at 100–03 (1954). As a publisher of several newspapers, Baker would have provided Carnan excellent training on periodical publication. But because Baker was not a *printer*, Carnan would have obtained that training elsewhere. This is not outside the realm of possibilities, given that Baker died three and a half years after Carnan was bound to him, meaning that Carnan was likely turned over to another master in London or he moved back to Reading.

268. See *Stationers v. Carnan*, 2 Black. W. 1004 (C.P. 1775); Cyprian Blagden, *Thomas Carnan and the Almanack Monopoly*, 14 *STUDIES IN BIBLIOGRAPHY* 23 (1961).

269. See sources cited *supra* note 252.

270. *THE POST BOY* (London), No. 1055, Feb. 17–19, 1701/2, at 2 (first advertisement).

271. Register of Marriages, Mercers' Hall Chapel, RG4/4436, p. 17 (Feb. 1701/2). Fabian took over the shop from her previous husband, Stationer and bookseller, Thomas Fabian c.1698.

272. Marriage Allegations, Vicar General, Lambeth Palace Library (Feb. 3, 1701/2).

Palmer at the time of his death in 1717,²⁷³ had married his wife in October 1703.²⁷⁴ Their marriage allegation, which I learned of thanks to the notes of book-trade historian Michael Treadwell, indicates that the Baker on Paternoster Row was twenty-four years old and a bachelor when he married;²⁷⁵ his admission paper to the City of London further shows that he was thirty in 1710.²⁷⁶ These were two different men.

It seems likely that the Baker at Mercers' Chapel was the Stationer who had apprenticed to Brabazon Aylmer and was freed in 1694. It would have behooved Mary Fabian to marry another Stationer after her previous husband died. To do otherwise would have meant forfeiting the copyrights entered in her husband's name, at least under ancient regulations of the Stationers' Company.²⁷⁷ Moreover, many apprentices were twenty-one years old when freed, and Baker would have been around that age in 1694. Baker also had other connections to Aylmer, including, among other things, having published a book previously held by him.²⁷⁸ In any case, this doppelgänger appears not to have been much of a businessman, as he lost his lease on the shop in Mercers' Chapel in late 1715, after falling £35 in arrears on rent.²⁷⁹

So if our Baker did not start working as a bookseller at Mercers' Chapel as previously thought, when did he do so? He was certainly not the Baker who began working for Henry Playford in March 1701/2. That Baker's father was named Thomas.²⁸⁰ Rather, the bibliographical evidence and contemporaneous newspaper accounts suggest that our Baker probably started working in the trade as a bookseller in early 1707 when he joined Richard Burrough at a bookshop called the Sun and Moon in Cornhill.²⁸¹ Though Burrough was a Stationer,²⁸² he never bound Baker as an apprentice.

273. Treadwell, *supra* note 213, at 111 (citing Administration of John Baker, PROB 6/93, f. 73^r (Apr. 27, 1717)); *see also* Register of Burials, St. Mary of Islington, f. 118^v (Apr. 16, 1717).

274. Register of Marriages, All Hallows London Wall, Guildhall MS 5087 (Oct. 29, 1703).

275. Marriage Allegations, Diocese of London, Guildhall MS 10091/39 (Oct. 29, 1703).

276. *See* sources cited *supra* note 264.

277. Maureen Bell, *Women in the English Book Trade 1557–1700*, 6 LEIPZIGER JAHRBUCH ZUR BUCHGESCHICHTE 13, 13–14 (1996); PATTERSON, *supra* note 4, at 47–48.

278. *See* ESTC Nos. R216401, T118815. Additionally, before he was at Mercers' Chapel, Baker seems to have sold books near the King's Arms in Little Britain. The one book we know he sold there has advertisements for books offered by Aylmer. *See* ESTC No. R218994.

279. JEAN IMRAY, *THE MERCERS' HALL 189–90* (1991).

280. MCKENZIE, *supra* note 254, at 275, No. 6412.

281. *THE DAILY COURANT* (London), No. 1497, Jan. 31, 1706/7, at 2.

282. MCKENZIE, *supra* note 85, at 127, No. 3416.

Burrough's name mysteriously disappears from the tax assessments for the property²⁸³ and from the trade entirely c.1708, cutting short whatever working relationship they enjoyed. Baker then operated, apparently alone, out of a shop in Grocers-Alley in the Poultry from 1708 to 1709.²⁸⁴ And starting in mid-1709, he moved to the Black-Boy on Paternoster Row.²⁸⁵

The fact Baker was unaffiliated and then an Upholder is important because it pits him as the ultimate outsider. Not being a Stationer, he was never eligible to directly participate in the registration system that predated the Statute of Anne (as delicate and underutilized as it admittedly was during the second statutory interregnum). Nor could he have taken advantage of the Company's communal culture which, when functioning properly, would have shielded unregistered works. Conversely, the fact he was unable to partake in the advantages of membership also meant he was free of its disadvantages. Baker would not have been subject to the jurisdiction of the Company and its ordinances. Though the Company's powers had been weakened by the lapse and then expiration of the Printing Act of 1662—exhibits A and B were its inability to constrain the likes of Henry Hills Jr. and John How—it could sometimes still exert pressure on its members. Baker would have operated outside those customs. Further cementing his status as an outsider, Baker probably entered the trade in 1707, meaning that he was brought up having never worked with the statutory copyrights that existed before 1695.

Predictably, Baker showed considerable disdain for the purported copyrights of others. This was especially evident during the statutory copyright interregnum before the Statute of Anne. He brazenly printed the works of others and clashed more than once with Jacob Tonson.

283. See Land Tax Assessment Books, Guildhall MS 11316/28, 31 (1708–1709) (Cornhill ward).

284. THE POST=MAN (Old Bailey), No. 1957, Sept. 4–7, 1708, at 2; THE POST BOY (London), No. 2164, Mar. 26–29, 1709, at 2.

285. See, e.g., THE DAILY COURANT (London), No. 2392, June 24, 1709, at 2; see also James Raven, *Location, Size, and Succession: The Bookshops of Paternoster Row Before 1800*, in THE LONDON BOOK TRADE 89, 97, 118 (Robin Myers et al. 2003) (identifying book shops on Paternoster Row before 1800 and offering the probable location of Baker's shop).

That the John Bakers at the Sun and Moon and Grocers-Alley shops are the same is suggested by the fact *A Collection of Divine Hymns and Poems on Several Occasions* was printed for J. Baker at the Sun and Moon in 1707, and then reprinted for J. Baker in Grocers-Alley in 1709. See ESTC Nos. T167210, T125422. Other works connect him to Paternoster Row. *Lay Baptism Invalid* was printed for J. Baker at the Sun and Moon in 1708, and reprinted for J. Baker on Paternoster Row in 1709. See ESTC Nos. N19355, N11639. Similarly, *The New Metamorphosis* was printed for R. Burrough and J. Baker in 1708, and then reprinted for J. Baker on Paternoster Row in 1709. See ESTC Nos. N41653, T116537.

From the start, in 1707, Baker began working with Edmund Curll, a pirate whose infamous reputation later surpassed that of Henry Hills Jr.²⁸⁶ Like Baker, Curll was not a member of the Stationers' Company.²⁸⁷ Their inaugural publication appears to have been Matthew Prior's *Poems on Several Occasions*, a work in which Jacob Tonson Sr. claimed to hold the copyrights.²⁸⁸ Tonson responded in the press, as he was wont to do, that "all the Genuine Copys of what Mr. Prior has hitherto written, do of right belong, and are now in the hands of Jacob Tonson, who intends very speedily to publish a correct Edition of them."²⁸⁹ Tonson did not sue Curll or Baker. He instead published his own authorized edition in 1708, albeit with a 1709 imprint.²⁹⁰

Whether this was Tonson's first run-in with Baker is not known, but it would not be his last. He confronted Baker at least twice more before 1710.

In June 1709, for instance, the Tonsons published a six-volume collection of William Shakespeare's plays.²⁹¹ Soon after, it was announced in *The Daily Courant* that a seventh volume with poems by Shakespeare would soon be published, and it is clear from the advertisement that John Baker was involved.²⁹² Baker took subscriptions in July,²⁹³ and when the volume was finally published under the imprint of Edmund Curll,²⁹⁴ the advertisements indicated it could be purchased at Baker's shop at the Black-Boy.²⁹⁵ Notably, Curll's volume criticized Tonson's as including plays that could not be attributed to Shakespeare, simply to "swell the Volume and the Price."²⁹⁶ It appears, however, that Tonson could not (and thus probably did not) claim the copyrights to the works in Curll's volume.²⁹⁷ Tonson shrugged off the en-

286. PAUL BAINES & PAT ROGERS, EDMUND CURLL, BOOKSELLER 27–28, 315 (2007).

287. Pat Rogers & Paul Baines, *Edmund Curll, Citizen and Liveryman: Politics and the Book Trade*, 62 PUB. HIST. 5, 5–7 (2007) (Curll was a member of the Company of Cordwainers).

288. BAINES & ROGERS, *supra* note 286, at 27–28; LYNCH, *supra* note 84, at 79.

289. THE DAILY COURANT (London), No. 1491, Jan. 24, 1706/7, at 2.

290. See source cited *supra* note 160.

291. Alfred Jackson, *Rowe's Edition of Shakespeare*, 4 LIBR. 455, 455 (4th Ser. 1930); see ESTC No. T138296.

292. THE DAILY COURANT (London), No. 2392, June 24, 1709, at 2 ("N.B. To make the Notes as perfect as possible, any Gentleman that will please to communicate any thing of that kind, shall receive a Gratification from J. Baker at the Black Boy in Pater-Noster-Row.").

293. *Id.* No. 2410, July 15, 1709, at 2.

294. THE WORKS OF WILLIAM SHAKESPEAR, VOLUME THE SEVENTH (London, E. Curll 1710).

295. THE DAILY COURANT (London), No. 2455, Sept. 6, 1709, at 2.

296. WORKS, *supra* note 294, at ii.

297. DON-JOHN DUGAS, MARKETING THE BARD 159, 162 (2006).

croachment and later worked with Curll (but not Baker) to issue a new nine-volume edition,²⁹⁸ one that carefully omitted the criticism of Tonson.

In late 1709, Baker clashed again with Tonson and his nephew in a dispute that unambiguously turned on a copyright. The dispute bears recounting in detail because it became particularly unpleasant and suggests an additional motivation, other than money, for Baker's subsequent decision to pirate Jacob Sr.'s *Tryal*. It also has never been discussed before and reveals interesting tidbits about copyrights before the Statute of Anne.

The book at issue was Samuel Butler's *Hudibras*, which had first been published in three parts with imprints dated 1663, 1664, and 1678, respectively.²⁹⁹ The book was immensely popular and went through many editions. In early May 1709, five years after the series had last been printed, a new edition in octavo was published by a syndicate of publishers.³⁰⁰ One of them was George Wells, a right holder who held a copyright share in part two, and another was Thomas Horne, who held the entire copyright in part three.

Baker seized an opportunity to publish a budget, pocket edition in octodecimo on November 21, 1709 (Fig. 5a). In addition to copying the text, Baker added original engravings to his edition, which he touted as "about 20 Cuts designed and engraven by the best Masters, with the Authors Effigies taken from the Original."³⁰¹ A handbill, probably distributed the first few days of December 1709, noted that Baker's edition was available at his shop at the Black-Boy and at the shop of Henry Hills Jr. in Black-Fryers.³⁰²

As it turns out, Tonson's nephew, most likely in partnership with Tonson himself, had purchased George Wells's copyright share in *Hudibras* just one month prior on October 22, 1709, as part of a larger purchase of over 300

298. LYNCH, *supra* note 84, at 131–32; see ESTC No. T26042.

299. John Wilders, *Textual Introduction—Early Editions*, in SAMUEL BUTLER, *HUDIBRAS*, at xlviii–liii (John Wilders ed., 1967).

300. THE POST=MAN (Old Bailey), No. 1738, Apr. 30 to May 3, 1709, at 2 ("Just published a new Edit."); see ESTC No. T1717.

301. THE POST=MAN (Old Bailey), No. 1819, Nov. 17–19, 1709, at 2 (book available on Monday, November 21st); see ESTC No. T117165.

Some of Baker's engravings may have been inspired by *Hudibras* paintings by Francis Le Piper (c.1637–1695). See L.H. Cust & Antony Griffiths, *Le Piper, Francis*, in OXFORD DICTIONARY OF NATIONAL BIOGRAPHY (2004); 3 JOHN NICHOLS & GEORGE STEEVENS, *THE GENUINE WORKS OF WILLIAM HOGARTH* 321 (London, Nichols, Son & Bentley 1817).

302. British Library Harley 5995 No. 90.

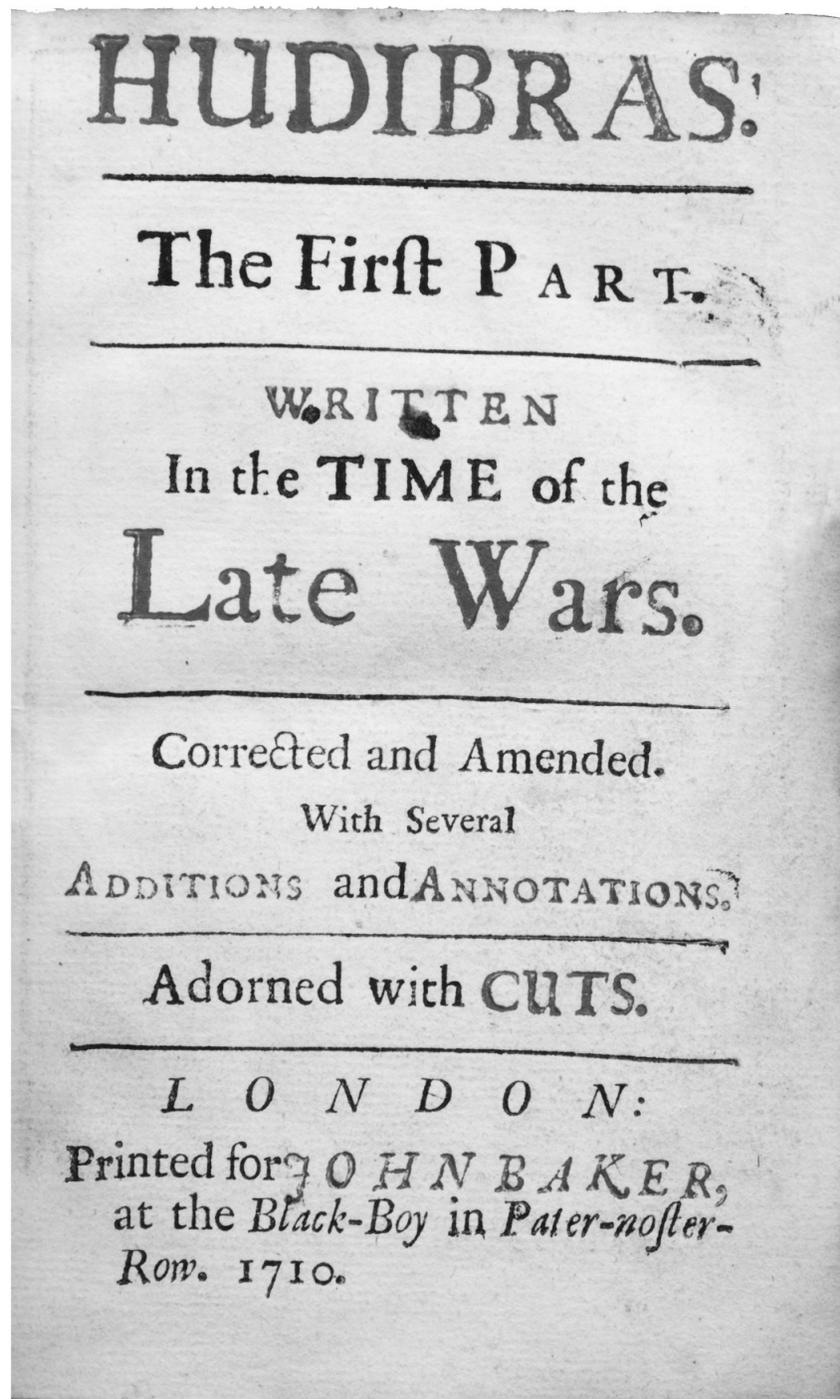
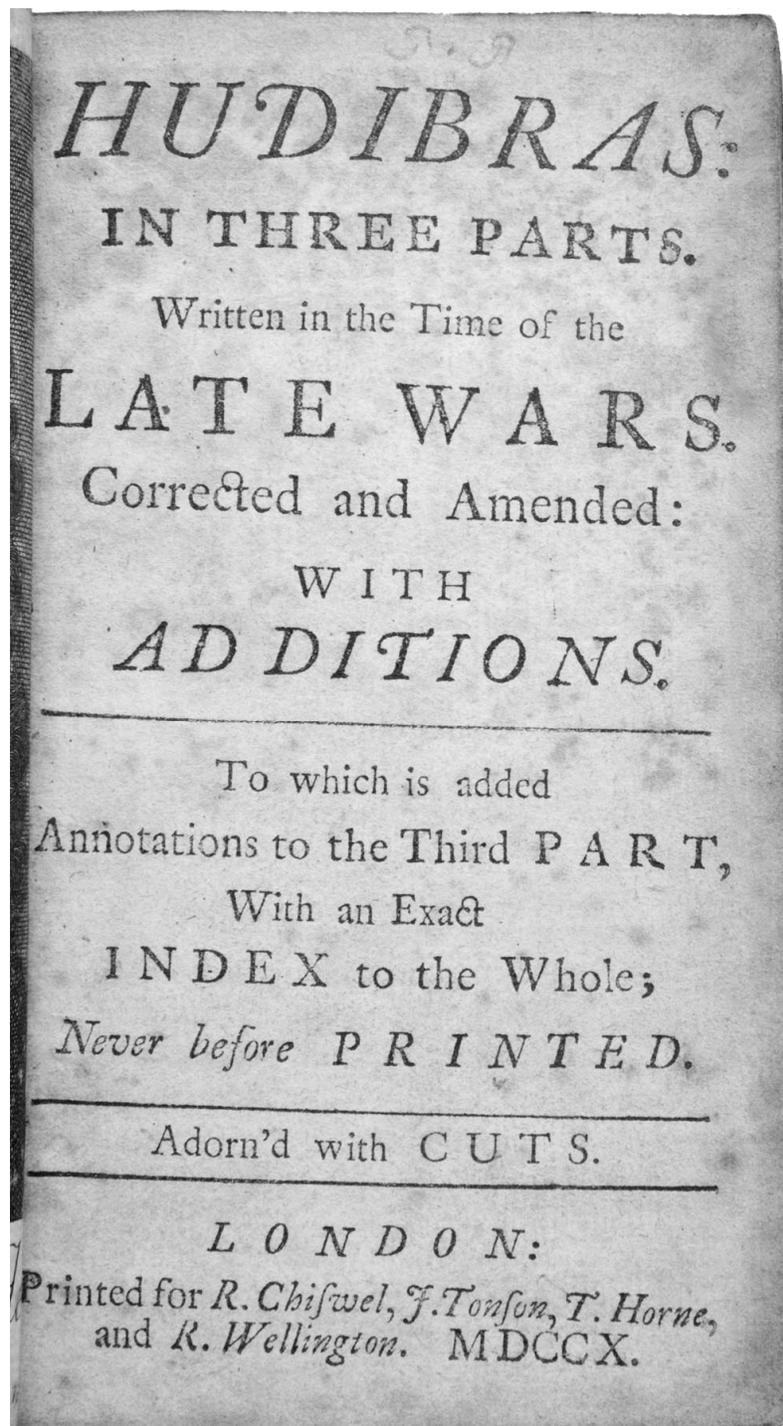


Figure 5a: Title page of the first part of Baker's *Hudibras*

Figure 5b: Title page of Tonson's *Hudibras*

copyrights for 100 pounds.³⁰³ Whether the Tonsons and their partners had previously planned to publish their own pocket edition I do not know (it seems unlikely), but Baker's edition forced them to do so:

Whereas there is lately published by John Baker an Edition of a Book, Entituled, Hudibras, in three Parts ; which Book is very Uncorrect, and printed upon bad Paper, and by a Person, having no Right to the Copy thereof : This is therefore to give Notice, That there is now in the Press, and will be speedily publish'd with great Care, a very Correct and Curious Edition of the said Book in a small Pocket Volume ; Printed upon Extraordinary Paper, and with a new *Brevier* Letter, after the same manner with the best Elzever Editions ; with several Cuts design'd and engrav'd by the best Hands : To which will be added Annotations to the 3d Part, never before printed. This Edition will be printed for Jacob Tonson, and the rest of the Proprietors in the Copy, and will be sold for Paper and Print.³⁰⁴

The Tonson edition that subsequently appeared (Fig. 5b) in late January 1709/10 was as small as Baker's, included an index not present in Baker's edition, annotations to the third part (as promised), and copies of the engravings that first appeared in Baker's book.³⁰⁵ The Tonsons' obvious intention was to return the favor and undercut Baker's sales.³⁰⁶

Baker's response did not pull any punches. He distributed two handbills soon after the Tonsons advertised their pocket edition in November. In one, Baker claimed the "false Insinuations of Mr. *Jacob Tonson* . . . [were] design'd only to hinder the Sale" of his book.³⁰⁷ Baker doubted Tonson would sell his edition at cost, as was claimed, given that Tonson had "always imposed on the VWorld by extravagant Prizes, wide Matter, and large Characters." The

303. Folger Shakespeare Library MS S.a.160 (Oct. 22, 1709). Jacob Sr. is not named as a purchaser in the assignment, but evidence indicates that he owned half of Jacob Jr.'s share in *Hudibras*, along with half of the other 300 plus copyright shares purchased by his nephew from Wells. This follows because when Jacob Sr. transferred all of his copyrights to his nephew before retiring c.1722, he included "all that half part or share in the Several Copies of books parts or shares in Copies of Books which were purchased of George and Mary Wells." Rosenbach Museum & Library EMs 417/10 (Sept. 17, 1718). Though it is unclear when Jacob Sr. obtained his share in *Hudibras* and the other works, it seems safe to conclude it occurred at the time of the initial purchase. I suspect that he probably put up half or more of the purchase money. *Accord* DUGAS, *supra* note 297, at 133.

304. THE LONDON GAZETTE, No. 4617, Nov. 22–24, 1709, at 2.

305. *See id.* No. 4643, Jan. 21–24, 1709/10, at 2 (publication); *see* ESTC No. T1919.

306. For more on the use of predatory pricing by right holders, see WILLIAM ST CLAIR, THE READING NATION IN THE ROMANTIC PERIOD 154, 699–700 (2004).

307. British Library Harley 5995 No. 167; *see also id.* No. 81 (identical in all material respects).

second handbill continued the attack, claiming that Tonson generally sold his books at a 25% premium over other booksellers because of the expensive formats Tonson unnecessarily favored.³⁰⁸ These accusations, though perhaps true in other instances, were specious here. But because Tonson's edition had not yet been published, Baker probably sought to mislead the public into thinking that Tonson's latest book, when released, would be expensive like the others. Hoping to direct the public to his own book, Baker offered to sell his at five shillings bound in three volumes, or four shillings if bound in one volume. Importantly, Baker also questioned how it was that Tonson and his partners had any more right to print the book than anyone else.³⁰⁹

After Tonson's book went on sale in January 1709/10, and Baker had a chance to review it, Baker criticized the workmanship. He alleged that Tonson "made Gross Blunders in the Printing Part" and noted that the engraving of Butler in particular seemed "to be taken from an Original Chimney-Sweeper"—by which Baker likely was referring to the darkness of the portrait.³¹⁰ Moreover, "notwithstanding [Tonson's] Boasting" of new cuts, Baker complained that Tonson had "Coppied all the Cutts from John Baker's" and did so poorly. Having reviewed both books—courtesy of private collector Andy Johnson-Laird—I can confirm that the Tonsons and their partners did copy the engravings (Figs. 6a, b), but the claim they did so badly was exaggerated. In any case, Baker hoped that "all Gentlemen [would] compare them before they buy, and give Encouragement to that which deserves best." He then promised to sell his "as cheap as" Tonson's.

Baker was sued on December 15, 1709 for infringing a common-law copyright in *Hudibras*, but not by the Tonsons.³¹¹ Rather, it was Thomas Horne who led the charge, claiming that Baker had infringed the copyright in part three that Horne's father received from Samuel Butler in 1679.³¹² Additionally, just three days before filing the complaint, Horne, along with Jacob Tonson, Richard Chiswell (who also held a share in *Hudibras*), and thirteen other booksellers, petitioned Parliament to enact new copyright legislation.³¹³ The timing may only be a coincidence, but Baker was probably

308. *Id.* No. 132.

309. *Id.*

310. THE POST BOY (London), No. 2313, Jan. 24–26, 1709/10, at 2.

311. *Horne v. Baker*, C5/290/70, m. 1 (Ch. 1709). A subpoena for Baker had issued on December 3, 1709. *Id.* at C33/313, f. 90^v (Ch. 1709).

312. See 3 STATIONERS' REGISTERS, *supra* note 19, at 86–87 (Aug. 4 & 8, 1679) (assignment and registration of part three). Thomas Horne later registered the book in his own name on March 5, 1694/5. *Id.* at 452. Notably, Horne and his counsel make no mention of these registrations in the bill of complaint brought against Baker.

313. 16 H.C. JOUR. 240 (Dec. 12, 1709).



Figure 6a: An engraving from Baker's *Hudibras*



Figure 6b: An engraving from Tonson's *Hudibras*

the straw that broke the camel's back, and thus he may deserve much of the credit for triggering what would eventually become the Statute of Anne.

The lawsuit over *Hudibras* reveals a nastiness in Baker that almost makes one feel sorry for his opponents. Horne alleged that Baker, working with John How, Edmund Curll, and others, had threatened him with financial "ruin." According to Horne, Baker was being indemnified by his partners, and those partners had "raisd or are to raise a [litigation] fund" and would "expend great summes[,] they being many and [m]e but one."³¹⁴ Horne then claimed that he had received an anonymous letter stating that he would be undersold on *Hudibras*. More ominously, Baker also threatened that he would print other works supposedly held by Horne in order to "vanquish" him.

Baker demurred to the complaint on January 9, 1709/10³¹⁵ and, as we will soon see, scored a major victory—one that probably emboldened him to continue to infringe copyrights after the enactment of the Statute of Anne.

During the demurrer hearing on May 10, 1710, which came after the statute went into effect,³¹⁶ the parties argued over the purported copyright and the type of relief sought. Spencer Cowper, representing Baker at the hearing, acknowledged that "the late \Act/ of parliament doth prohibitt us," but he stressed that the "booke [was] printed before the Act" and that Horne had no right to challenge its printing.³¹⁷ Horne's barrister, Sir Joseph Jekyll, countered that the statute did not affect Horne's copyright, and that the principal thrust of the bill was to obtain discovery to support an action at law:

[T]he Act lately made Doth not take away our right & our Bill is to have a Discover[y] [of] what agreements have been made about printinge & Sellinge our Booke to enable us to bring an action for evadinge our propertye for they vend the Books by obscure persons & not in publicke shoppes for then could send any person to buy the Books[.]³¹⁸

Cowper retorted on behalf of Baker with several points: (1) Horne could have "noe action" at law, presumably because the infringements had occurred before the statute and could only be supported by a non-existent copyright at common law; (2) even if Horne could have an action for the

314. *Horne*, C5/290/70, m. 1.

315. *Id.* at m. 2 (Ch. 1709/10).

316. It is unclear from the record why it took so long for the demurrer to be heard. It might have been because the Lord Chancellor was occupied with the Sacheverell affair.

317. *Id.* at C37/853 (Ch. Cause Book May 10, 1710).

318. *Id.*

infringement of a copyright at common law, the Chancery should “not enforce a Discovery to make evidence”; and (3) that the suit was for more than just discovery, but for relief in equity as well.³¹⁹ Turning to the relief, the parties then disagreed on whether the Lord Chancellor had the power to discover and disgorge the profits that Baker had earned.

A report of the hearing prepared by William Melmoth of Lincoln’s Inn, one of Horne’s counsel, sheds more light on the argument and suggests that the Lord Chancellor was most concerned about the remedy and discovery sought, rather than the copyright per se, as it makes no mention of a disputed copyright at common law.³²⁰ The Lord Chancellor stated: “To make the defendant account for the proffits of what he has sold, is going too far ; for the injury that the plaintiff has sustained ought to be the measure of the damage, & not the proffit, which the defendant has made.”³²¹ The remedy of ordinary damages was to be had at law. But he then refused to permit a discovery of Baker’s sales and printing arrangements even insofar as the discovery was to be used to “recover greater damages at law.” The Lord Chancellor explained:

I dont know, that this Court ever went so far : Suppose a trespass was done, would you come here against the trespasser to discover how many Cattle he put in to the land, & what damage he has done! I am not willing to carry this matter so far, especially now the late act of parliament has given another remedy in respect of the property in Coppies of Books.³²²

According to the official court minutes, Lord Chancellor Cowper ended the hearing by first suggesting that he would be open to revisiting the matter if Horne and his counsel could find relevant precedent: “Cur[;] Lett itt be contynued & if can find a parrallell case as this is where hath releife hath [*sic*] been given may apply to the Court[.]”³²³ The next entry in the minutes indicates that the court then granted the demurrer without costs. The two

319. *Id.*

320. A prior case also suggests that the Lord Chancellor might have felt comfortable proceeding in *Hudibras* on a copyright at common law. In December 1709, he had no difficulty, at least as an interlocutory matter, addressing infringement in a suit involving a copyright at common law. *Wellington v. Levi*, C33/314, ff. 54^v–55^r (Ch. 1709).

321. *Horne v. Baker*, Lincoln’s Inn Misc. MS 10, p. 1 (Ch. 1710).

322. *Id.*

323. *Horne*, C37/853.

statements are not necessarily inconsistent, but it may have been that the Lord Chancellor became less equivocal.³²⁴

It is debatable whether the case also implicated the legacy clause of the Statute of Anne. Horne had not moved for an interlocutory injunction, and as a consequence no court order prevented Baker from selling *Hudibras* after April 10, 1710, if in fact he had not already sold his copies before then. The arguments at the hearing suggest, however, that the parties were mostly (if not only) concerned about common-law transgressions. Baker's counsel, Cowper, all but stated as much. Though Jekyll's statements are less clear, it seems probable, given his discovery request, that he too was limiting himself to a claim based on a copyright at common law. To request a discovery to enforce a penalty under the Statute of Anne would have been frivolous.³²⁵ And though the Lord Chancellor rejected Jekyll's request for a discovery to enable an action for damages, with some indignation I might add, that request was at least sensible. Bills seeking similar discovery had been brought under a common-law copyright and related contexts before.³²⁶ The fact the Lord Chancellor was unaware of parallel cases and had asked (at least initially) for precedent further suggests the case did not implicate the statute. It would have been odd to ask for precedent under a statute that was only one month old and of which the Lord Chancellor would have likely already been aware. Moreover, he stated that the injury that Horne had sustained would be the proper measure of recovery, a statement that would be inconsistent with expecting the plaintiff to recover a penalty.

Though the suit had not been brought under the Statute of Anne, and probably did not implicate it, the ruling may have nevertheless encouraged Baker. He probably inferred that the remedial rulings would apply equally to suits filed under the statute. The court had refused to create a new monetary

324. The part of the manuscript asking for precedent has two diagonal lines stricken through it. Typically a strikeout in this context means that the in-court ruling has been transferred to the C33 order-and-decree book. But there are no relevant orders in the C33 book.

325. See *infra* text accompanying note 399.

326. E.g., *Herringman v. Clerke*, C33/257, f. 608^v, C33/259, ff. 427^r, 278^v–279^r (Ch. 1682–1682/3) (copyright at common law; overruling a demurrer and repeated objections to a discovery request designed to enable an action for damages at law); *Keble v. Onley*, British Library Add. MS 22,610, f. 13^v (Exch. 1705/6), *reprinted in* EQUITY CASES IN THE COURT OF EXCHEQUER 1660 TO 1714, at 556, 556–57 (W.H. Bryson ed., 2007) (copyright by “custom”; overruling a demurrer and enforcing a discovery request; damages to be recovered at law not equity); *Stationers v. Lee*, *sub nom. In re The Company of Stationers*, 2 Chan. Cas. 66, 66, C33/258, f. 138^r (Ch. 1681) (copyright by letters patent; overruling a demurrer to a discovery request to support an action at law). The same objection was overruled in cases involving the trading patent of the East India Company. *East India Co. v. Evans*, 1 Vern. 305, 307–08 (Ch. 1684/5); *East India Co. v. Sandys*, 1 Vern. 127, 129–30 (Ch. 1682/3).

remedy in equity for infringement of a common-law copyright—a disgorgement of the defendant’s profits. Thus, a plaintiff hoping to obtain reparation for past harms would have to resort to an action at law for damages and, according to Lord Chancellor Cowper, would have to do so without the benefit of any useful discovery in equity—a significant hardship on plaintiffs. From these rulings, it would not have been much of a stretch to infer that the Lord Chancellor would also refuse a disgorgement of profits in a suit brought under the statute. When seen in this light, the ruling in *Horne* may further explain Baker’s willingness to infringe Tonson’s *Trial* so soon afterward.

I found no order on the demurrer in the order-and-decree book, which suggests that Horne informed Baker soon afterward that he was voluntarily abandoning the suit. To hazard a guess, Horne wanted to avoid a precedent. One must wonder whether the Tonsons had urged him to drop it as well.³²⁷

As for why Baker did not sue the Tonsons and their partners for infringing his engravings, that is easier to discern. Engravings were not protected by statute until 1735,³²⁸ and Baker had not sought a royal privilege to protect them, which he could have done.³²⁹ It also would have been against his interests to claim a common-law copyright in the engravings. To do so would have only strengthened the claim against him. Thus, whether the Tonsons and Horne perceived it or not, the decision to copy Baker’s engravings was not only a shrewd business tactic but a shrewd legal one as well.



It must have taken substantial moxie to pit oneself against Jacob Tonson Sr., the greatest publisher of the day. Baker’s peers shared this assessment and he became the conduit of the outspoken. Daniel Defoe, for example, had selected Baker to be his primary publisher for tracts large and small c.1709 because of Baker’s recalcitrance.³³⁰ And when the printer of Defoe’s periodical, the *Review*, was kidnapped by a mob in 1710, Defoe also replaced him with Baker, stating:

[W]e have now remov’d [the *Review*] from the usual Place of Publication, and put it into Hands, that will not be bias’d, terrify’d, or any way prevail’d upon to keep it back ; and from henceforward,

327. It appears that it was not until 1737 that the Chancery began to award prevailing copyright plaintiffs a disgorgement of the defendant’s profits. See DEAZLEY, *supra* note 4, at 65–69 (citing *Gay v. Walker, sub nom. Baller v. Watson*, C33/369, ff. 315^v–316^v (Ch. 1737)).

328. Engraving Copyright Act, 1735, 8 Geo. 2, c. 13.

329. See Rogers, *supra* note 5, at 139.

330. NOVAK, *supra* note 225, at 458.

this Paper will be publish'd by Mr. *Baker*, as is printed at the Bottom in the usual Place.³³¹

Defoe must have valued this characteristic above all others, as he would have had to overlook Baker's propensity to ignore the purported copyrights of others. Defoe was a great champion of copyright before the 1710 statute.³³²

Other authors and copyright holders also chose Baker as their publisher, and he became one of the most active trade publishers of his period.³³³ A trade publisher was one who regularly arranged for the publication and distribution of English books, pamphlets, and periodicals on behalf of others. Unlike other publishers who usually held the copyrights in the works they published (such as Tonson), trade publishers, when acting as such, did not. The property was instead held by another person who, for purposes of concealment or convenience, preferred to publish their works under the imprint of another. Concomitantly, trade publishers might not front the capital for the work; that might be borne by the client. Often, an incidental role of a trade publisher was to deflect the initial inquiries of authorities away from his clients; the fact Baker was arrested numerous times for printing seditious works indicates he did so successfully.³³⁴ In *Tonson v. Baker*, as we will shall soon see, it appears that Baker acted for himself rather than as a trade publisher for someone else.



So why did Baker choose Tonson's *Trial* to pirate? Money, for one. Any account of the Sacheverell trial was sure to be a best seller. The subject matter also was not much of a stretch for Baker, as he already specialized in religious and political works.³³⁵ Yet, it also seems more than possible that the seed for Baker's *Compleat History* could have been planted by spite. What better way to skewer an opponent than to steal what should, by all

331. 7 DANIEL DEFOE, A REVIEW OF THE STATE OF THE BRITISH NATION 50, Apr. 25, 1710 (London, s.n. 1711), reprinted in 17 DEFOE'S REVIEW 50 (Arthur W. Secord ed., 1938).

332. ROSE, *supra* note 4, at 34–41; DEAZLEY, *supra* note 4, at 31–36.

333. On trade publishers generally, see Treadwell, *supra* note 213, at 100–04, 114–17. For Treadwell's discussion of John Baker, see *id.* at 106, 111–14.

334. For some of his arrests and penal recognizances, see Entry Books, SP44/78, p. 65 (Oct. 22, 1709); *id.* SP44/78, p. 63 (Nov. 11, 1709); *id.* SP44/77, pp. 95, 93 (May 23 & 24, 1710); *id.* SP44/77, pp. 129, 126 (Oct. 12 & 16, 1711); *id.* SP44/77, pp. 151, 153 (July 2 & 17, 1714); *id.* SP44/79A, p. 12 (Aug. 21, 1714).

335. See Don-John Dugas, *The London Book Trade in 1709 (Part One)*, 95 PAPERS BIBLIOGRAPHICAL SOC'Y AM. 31, 50 (2001) (analyzing the specializations of persons in the book trade in 1709).

expectations, be an excellent source of trade profit? Baker was certainly not in it to promote another viewpoint of the trial, despite the fact he had incorporated Abel Roper's pro-Sacheverell *Impartial Account* into the *Compleat History*. For one, Roper and Baker disliked each other.³³⁶ But more importantly, Baker was likely anti-Sacheverell himself. He supported the Whigs,³³⁷ and he published periodicals with a Whig viewpoint. Apart from Defoe's *Review* in 1710, he published *The Protestant Post Boy* starting in 1712, and *The Medley* in 1712.³³⁸ Baker may have inserted the *Impartial Account* as much to skewer Roper as Tonson, though it seems more likely here that he included the work to offer the fullest account possible of the Sacheverell affair.

B. THE COPYRIGHT CLAIM

Now that we have some sense of the parties, their prior working relationships and disputes, their views on copyright before the Statute of Anne, and even their possible motivations for infringing Tonson's *Tryal*, let us return to the merits of *Tonson v. Baker*. The sections that follow discuss the copyright claimed by Tonson, the infringement, and the proceedings in the Court of Chancery. Because the case never passed the pleading stage, I also offer my thoughts on how the case might have turned out had it proceeded.

1. *The Copyright*

Tonson's bill relied on two forms of copyright. The first stemmed from the Lord Chancellor's decision to appoint him to print the trial. That appointment, Tonson alleged, was exclusive and "forbid any other person" from printing the same.³³⁹ Second, Tonson alleged he had registered the book with the Company of Stationers before its publication on June 5 "[a]ccording to the late Act of parliament Intituled an Act for Encouragement of Learning."³⁴⁰ Notably, Tonson did not, and could not, allege that he had deposited nine copies of the *Tryal* with the Company, as the statute required him to do.³⁴¹ In any case, by virtue of combining both rights, Tonson summarized that he was entitled to the "Sole Right and Liberty of printing of the said Tryall for the Terme of ffourteen yeares to Comence from the time

336. See THE HISTORY OF DOCTOR SACHEVERELL 11, 25–26 (London, A. Baldwin 1711).

337. LONDON POLITICS, *supra* note 122, at 68 (John Baker, upholder, polling record of 1713).

338. See generally W.R. & V.B. MCLEOD, GRAPHICAL DIRECTORY OF ENGLISH NEWSPAPERS AND PERIODICALS, 1702–1714 (1982).

339. *Tonson v. Baker*, C9/371/41, m. 1, l. 4 (Ch. 1710).

340. *Id.* at ll. 6–8.

341. See Register Book MS, *supra* note 81, at 24, 36.

of the first publication.”³⁴² Additionally, he sought injunctive relief for a period of only fourteen years.³⁴³

The last two statements are fascinating. First, they implicitly acknowledge that insofar as there previously had been no durational limit on parliamentary printing rights, the Statute of Anne seemingly created one. More importantly, Tonson’s position seems to contradict a mantra later used by booksellers in the mid-to-late 18th century—after Tonson was dead—that not only were copyrights separately protected as a matter of common law in perpetuity before the Statute of Anne, but the passage of the statute did not affect those common-law rights.³⁴⁴ Here we have the most eminent copyright holder of his day—someone who believed in a perpetual copyright at common law *before* the statute and had lobbied for a statute securing those rights—appearing to acknowledge that copyright durations were limited after the statute.

It would have been uncontroversial to ask for an injunction without any mention of a durational limit, and yet Tonson seems to have gone out of his way to expressly foreclose a term that could exceed the statutory term. This evidence requires us to question the view of some historians, formed years later, that the publishers who agitated for the statute had “certainly not anticipated” that it would lead to term limits.³⁴⁵

One might be tempted to attribute these two statements to Horsley, Tonson’s solicitor. But given Tonson’s experience and sophistication, and particularly his understanding of copyrights, I am not inclined to do so. Had Tonson believed otherwise, he could have instructed Horsley to omit them.

2. *The Infringement*

Turning to infringement, Tonson alleged that the *Compleat History* had been “Coppied out of one of the printed Coppies [of the *Trial*] . . . printed by and for your Orator.”³⁴⁶ He acknowledged that Baker’s book was not identical to his, but he nevertheless argued that it was the “Same in Substance & Effect as that printed by and for your Orator.”³⁴⁷ Baker’s book had been published in “Smaller Character or print,”³⁴⁸ for example, and the titles

342. *Tonson*, C9/371/41, m. 1, ll. 9–10.

343. *Id.* at ll. 38–44.

344. *See generally* DEAZLEY, *supra* note 4, at 57–65, 115–32, 169–90.

345. 2 GEORGE HAVEN PUTNAM, BOOKS AND THEIR MAKERS DURING THE MIDDLE AGES, 1500–1709, at 472 (New York, G.P. Putnam’s Sons 1897). *But see* A.S. COLLINS, AUTHORSHIP IN THE DAYS OF JOHNSON 54 (1927) (“It seems hardly credible that ‘the trade’ in 1710 can have believed that this perpetuity was any longer theirs at law . . .”).

346. *Tonson*, C9/371/41, m. 1, l. 29.

347. *Id.* at l. 29.

348. *Id.* at l. 16.

differed. With respect to the content, Tonson posited that the variations were immaterial: “[They] have caused Some little variacion or Difference tho not materiall in every Sheet of the book soe by them printed or . . . sold.”³⁴⁹ The variations are not laid out in detail, rather, Tonson simply states that some words were “transposed and misplaced on purpose” and “what Alterations and Addicions” were made thereto were “false and Erroneous and [did] misrepresent many of the proceedings at the said Tryall.”³⁵⁰ I have already been through both books, and described the differences between them,³⁵¹ and Tonson cannot be said to have exaggerated his claim. In any case, he concluded that the above variations were designed to “elude and Evade the [Statute of Anne] and the fforfeitures and penaltyes therein Contained.”³⁵²

Naturally, Tonson further alleged that Baker’s version would “Spoil and hinder the sale of the said Tryall printed by and for your Orator.”³⁵³ Tonson had the twice-the-price folio edition to consider, as Baker’s octavo would certainly undercut it. And though not mentioned in the complaint, Tonson undoubtedly worried about the sale of his own octavo edition of the *Tryal* that he had been preparing for the press. Tonson’s octavo would also have to compete with Baker’s, and Baker had already beat him to the market.

3. *The Proceedings*

As I previously noted, Tonson’s solicitor Marmaduke Horsley filed the bill of complaint on Saturday, July 8, 1710. Horsley then handed a brief of the case to two barristers for the purpose of seeking a temporary restraining order (TRO). The two chosen to represent Tonson were Sir Joseph Jekyll and Spencer Cowper. Having two barristers was not unusual on motions of importance, and having one as eminent as Jekyll meant the motion would take precedence over those of nearly every other counsel,³⁵⁴ precedence would have been critical on a motion seeking immediate relief.

Both barristers were quite accomplished. Jekyll was called to the bar in 1687 and created a serjeant at law in 1700.³⁵⁵ He also happened to be a close associate of Tonson. As John Barnard has pointed out, Jekyll was one of the

349. *Id.* at l. 27.

350. *Id.* at ll. 30–31.

351. *See supra* Part III.G.

352. *Tonson*, C9/371/41, m. 1, ll. 22–23.

353. *Id.* at l. 23.

354. DAVID LEMMINGS, GENTLEMEN AND BARRISTERS: THE INNS OF COURT AND THE ENGLISH BAR 1680–1730, at 119, 130 (1990) (discussing precedence of barristers).

355. 1 H.A.C. STURGESS, REGISTER OF ADMISSIONS TO THE HONOURABLE SOCIETY OF THE MIDDLE TEMPLE 201 (1949); JOHN SAINTY, A LIST OF ENGLISH LAW OFFICERS, KING’S COUNSEL AND HOLDERS OF PATENTS OF PRECEDENCE 24 (1987).

first subscribers, and a patron, of Dryden's *Virgil*, which Tonson published in 1697.³⁵⁶ The subscription was a costly five guineas, and one of the plates of the book was dedicated to Jekyll. Spencer Cowper was no slouch either. The younger brother of the Lord Chancellor, Cowper was called to the bar in 1693.³⁵⁷ Both Jekyll and Cowper were also members of the House of Commons during the Sacheverell affair and managers of the prosecution.³⁵⁸

To obtain the TRO, Tonson's counsel had to obtain a certificate from the Six Clerk's office showing he had filed a complaint. Moreover, given how quickly the TRO was requested after the complaint, Tonson had to prove by affidavit that he held a copyright in the work and that the defendants had infringed it.³⁵⁹ The motion itself would be made *ex parte* in open court and without the written motions we are accustomed to today. If granted, the TRO would last until the defendants had put in a "full and perfect" answer, after which counsel could move to convert the TRO into a preliminary injunction.³⁶⁰

The TRO hearing occurred on Tuesday, July 11. The motion was fifth on the calendar, following motions by Sir Thomas Powys who by virtue of being a prime serjeant at law had precedence over Jekyll.³⁶¹ Lord Chancellor Cowper was hearing motions that day, but the minutes (Fig. 7) indicate he recused himself when Jekyll began to argue *Tonson v. Baker*. "Mr Serjeant Jekyll pro Querente moves for an Injunction to stay their Printing Dr Sacheverells Tryall[,] Cur[:] move this before the Master of Rolls."³⁶² Cowper did not recuse himself because his younger brother was on the case. Spencer regularly argued in front of the Lord Chancellor, including in the very case that preceded *Tonson*³⁶³ and during the demurrer hearing on *Hudibras*. Rather, the Lord Chancellor must have felt uncomfortable ruling on the motion because he had appointed Jacob Tonson as the publisher of the trial. As a consequence, the case was heard by the Master of the Rolls, John Trevor.

356. John Barnard, *Dryden, Tonson, and the Patrons of The Works of Virgil (1697)*, in JOHN DRYDEN: TERCENTENARY ESSAYS 174 (Paul Hammond & David Hopkins eds., 2000).

357. ARTHUR R. INGPEN, THE MIDDLE TEMPLE BENCH BOOK 236 (1912).

358. See *supra* text accompanying notes 54–55.

359. Gómez-Arostegui, *supra* note 7, at 1229.

360. *Id.* at 1235–36, 1229–30.

361. SAINTY, *supra* note 355, at 34 & n.1 (Powys).

362. *Tonson v. Baker*, C37/860, f. 2^r (Ch. 1710).

363. *Pye v. Gorge*, C37/860, ff. 1^v–2^r (Ch. 1710).

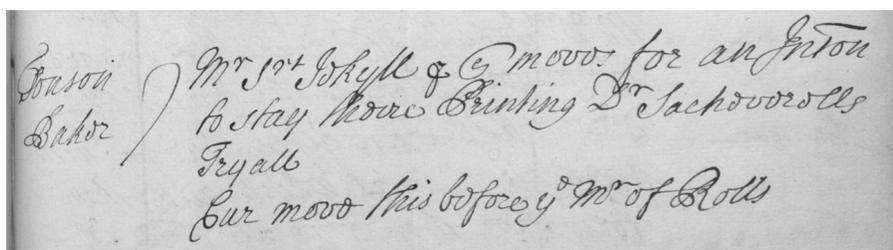


Figure 7: Hearing on the TRO before the Lord Chancellor, C37/860, f. 2^r (Ch. July 11, 1710)

Unfortunately, the affidavits in the case have not survived, and we therefore no longer have the sworn evidence that supported Tonson's case. But the order on the TRO (Fig. 8) has endured, and it indicates that Jekyll and Spencer Cowper parroted the arguments of the complaint. The order recites the appointment of Tonson by the Lord Chancellor and notes that Tonson registered the book before publication, as required by the Statute of Anne. By virtue of the foregoing, Tonson allegedly "became intitled to the sole \right of/ Printing the said Tryall for fourteen yeares."³⁶⁴ The Master of the Rolls next reviewed the now-lost affidavit of Tonson which showed, according to the court, that Baker's "booke [wa]s the very same in Substance with very little difference or variation from the tryall of Doctor Henry Sacheverell printed by the plaintiff."³⁶⁵ The court then enjoined the defendants, their agents, and workmen from printing or selling Baker's *Compleat History* until they answered and the court took other order to the contrary.³⁶⁶

It is unclear how soon after the hearing Baker received notice of the TRO, but presumably Tonson's counsel served it quickly. Baker's most immediate response was to register his book the following day, July 12, with the Company of Stationers, where he also deposited nine copies as required by the Statute of Anne.³⁶⁷ The move seems to have been more reactive than proactive, given that the registration came after publication and thus Baker was too late to obtain the statutory remedies under the Statute of Anne. It is unclear whether Baker nevertheless believed that his book still might be protected by the statute, albeit without its statutory remedies, despite having registered the work after publication.³⁶⁸

364. *Tonson*, C33/314, f. 375^v, ll. 10–11 (Ch. 1710).

365. *Id.* at ll. 16–17; *see also id.* at C37/860, f. 7^r (Ch. 1710) ("Affidavit of Jacob Tonson read.").

366. *Id.* at C33/314, f. 375^v, ll. 19–25.

367. Register Book MS, *supra* note 81, at 48.

368. *See infra* note 407 and accompanying text.

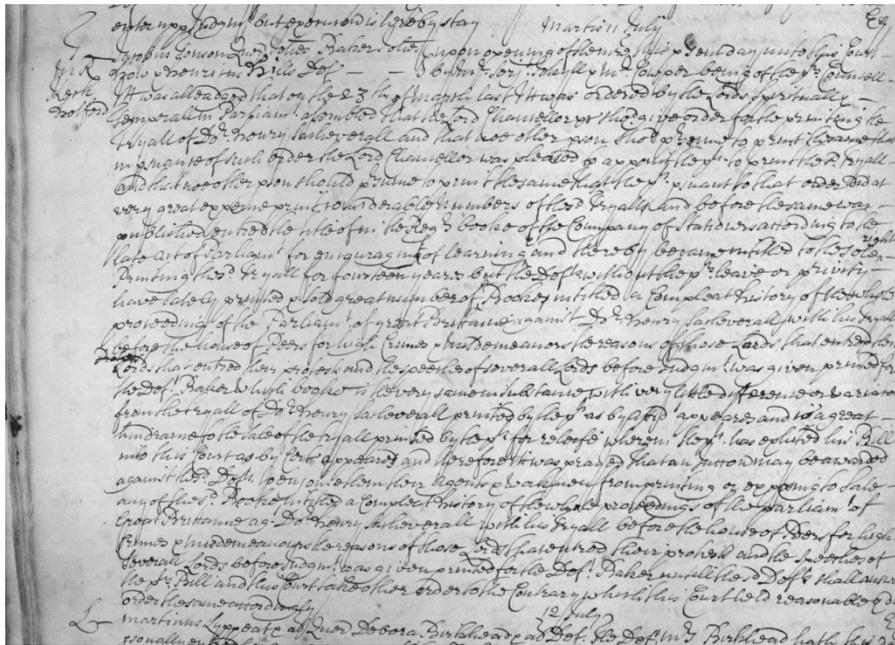


Figure 8: Temporary restraining order,
C33/314, f. 375^v (Ch. July 11, 1710)

The next day, Tonson advertised that he would soon be publishing his own octavo edition and he further warned that Baker's book was unlawful:

N. B. There is an Imperfect Copy of the said Tryal lately Published by one J. Baker, under the Title of *A Compleat History of the whole Proceedings of the Parliament of Great Britain against Doctor Sacheverell*: And the High Court of Chancery having granted an Injunction prohibiting the Publishing, Selling and Exchanging the said Book, Notice is hereby given to prevent all Persons from incurring the Penalty of the said Injunction.³⁶⁹

The legal warning was designed in part to warn those subject to the injunction—*viz.*, bookselling agents of the defendants. But it also sought to bring others within the scope of the Statute of Anne. By informing the trade that Baker's *Compleat History* was a piracy, Tonson made it easier to sue others under the statute for selling a book “*knowing* the same to be . . . printed”

369. THE LONDON GAZETTE, No. 4716, July 11–13, 1710, at 2; *see also id.* No. 4717, July 13–15, 1710, at 2.

without the consent of the proprietor of the book.³⁷⁰ Placing such a notice in *The London Gazette*, as Tonson did, ensured its large circulation.³⁷¹

Baker placed his own advertisement in *The Evening Post*. Given the date on the issue, July 11–13, it is unclear whether he submitted the advertisement before or after receiving notice of the TRO. In any case, it differed slightly from what Baker had advertised before, mostly in that he admitted to incorporating Abel Roper's *Impartial Account*:

Just publish'd

|| A compleat History of the whole Proceedings of the Parliament of Great Britain against Dr. Henry Sacheverell, with his Trial before the House of Peers for High Crimes and Misdemeanors, the Reasons of those Lords that enter'd their Protests, and the Speeches of several Lords before Judgment was given. N.B. This History has in it, besides the Trial at large, The Impartial Account, the Bishops Speeches, the Debates of the Lords, and the Lords Proceedings above-mention'd. Printed in 8vo, on fine Paper and new Letter. price 5 s.³⁷²

The timing of the remaining process is a bit uncertain. But it appears Baker soon obtained the services of Richard Shelley as his solicitor and Samuel Mead as his barrister in Chancery. Shelley had previously defended Baker in the lawsuit over *Hudibras*. Originally of Lewes, Sussex, Shelley was a member of the Middle Temple and called to the bar in 1690.³⁷³ Though admitted as a barrister, it is not unusual that he took up soliciting duties here.³⁷⁴ Mead was also admitted to the Middle Temple and was called to the bar in 1699.³⁷⁵ David Lemmings's study of barristers has shown that Mead was one of the most prolific and sought after barristers in Chancery.³⁷⁶ Mead had also been appointed to aid Baker on *Hudibras*,³⁷⁷ though he never argued at the demurrer hearing in the case.

370. Statute, 1710, 8 Ann., c. 19, § 1 (emphasis added).

371. See English Gazette Account, June 1–13, 1710, SP34/12, pp. 126–27 (print run 8,500).

372. THE EVENING POST (London), No. 143, July 11–13, 1710, at 2.

373. 1 STURGESS, *supra* note 355, at 210.

374. Regrettably, his will gives no inkling of his practice. Will of Richard Shelley, PROB 11/553, f. 288^r (will Mar. 8, 1710/1; codicil May 11, 1716; probate Aug. 11, 1716).

375. 1 STURGESS, *supra* note 355, at 236.

376. See LEMMINGS, *supra* note 354, at 142, 291. Mead later moved to Lincoln's Inn and died a rich man in 1733. 1 THE RECORDS OF THE HONORABLE SOCIETY OF LINCOLN'S INN: ADMISSIONS FROM A.D. 1420 TO A.D. 1799, at 374 (s.l.n. 1896). His will dispersed over £1.6 million in cash (converted to present-day values). Will of Samuel Mead, PROB 11/658, f. 26^v (will Apr. 14, 1731; codicil Aug. 25, 1731; probate Mar. 31, 1733).

377. *Horne v. Baker*, C33/313, f. 90^v (Ch. 1709).

Baker was not required to pay either lawyer because he successfully petitioned the court to certify him *in forma pauperis*.³⁷⁸ Neither the petition nor the supporting affidavit survives, but this is no loss, as their contents would have been pro forma. Baker was required to swear that after paying all debts and excluding his wearing apparel he was worth less than five pounds.³⁷⁹ Whether that was indeed his net worth is difficult to say. Petitions of this sort seem to have been granted unless cause was shown against them, and Tonson did not move to dispauper Baker. Thus, Baker's request may not have reflected his true net worth. On the other hand, it may have been that Baker was so invested in the publication of his *Compleat History* that he owed more to his creditors at the time than he had money on hand.

Probably encouraged by his victory on *Hudibras*, Shelley had submitted a demurrer on Baker's behalf on July 15. Some of it is rote, and the document is relatively short compared to demurrers that appear in other copyright cases. But the few punches it throws are fascinating. Its principal thrust was that the court lacked jurisdiction to hear the case under either the Statute of Anne or the order of the House of Lords.

Shelley first tackled the statute. Whether Baker was "guilty of any offence against the said Act of parliament" was, according to Shelley, "only inquireable and determinable in a Court of Law and not in a Court of Equity."³⁸⁰ He also challenged the court's ability to award the remedies under the statute by positing that the penalties under the statute were recoverable only in "her Majestys Courts of Record at Westminster" and therefore could not be had in Chancery or "any other Court of Equity."³⁸¹ Shelley then argued that the court could not compel Baker to discover information that could later be used to obtain the penalty in the common-law courts.

Turning to the order of the House of Lords, Shelley argued that insofar as Tonson's right was linked thereto, the infringement of that right should be left to the decision of the Lords: "The only question founded upon that must be whether this Defendant has been guilty of a breach or Contempt of that Order which is a thing inquireable and determinable not in and by this Honorable Court but only in and by the House of Lords who made that Order."³⁸² As he had done with the statute, Shelley complained that the

378. *Tonson v. Baker*, C33/314, f. 421^v (Ch. 1710).

379. WILLIAM BOHUN, *CURSUS CANCELLARIAE: OR, THE COURSE OF PROCEEDINGS IN THE HIGH COURT OF CHANCERY* 487–89 (Savoy, J. Nutt 1715); *THE PRACTICE OF THE HIGH COURT OF CHANCERY* 31–32, 34 (London, Bernard Lintott 1706).

380. *Tonson*, C9/371/41, m. 2, ll. 11–13 (Ch. 1710).

381. *Id.* at ll. 8–10.

382. *Id.* at ll. 13–15.

discovery sought could be used to determine whether he had breached the order.

Shelley never pressed the demurrer to a hearing, and it was therefore de facto overruled.³⁸³ Nothing further occurred in the case. Baker did not answer, and Henry Hills Jr. and John How never responded at all. As a consequence, the TRO previously entered, which was to last until the defendants had answered, technically remained in effect for an indefinite period of time. Unlike injunctions for the stay of lawsuits in other courts, which automatically dissolved after three terms,³⁸⁴ injunctions of this sort did not. Moreover, the rule that a TRO would automatically be dissolved *nisi causa* fourteen days after the filing of a response, applied only where the defendant's response was an *answer*.³⁸⁵

So what happened? One can only speculate. Tonson could have moved to force Baker to answer and for Hills and How to do the same. But having obtained his TRO, Tonson was not required to proceed further until the defendants answered. They did not, so he did not. Perhaps he felt the TRO would suffice or, less likely, the parties settled their differences. What is known for certain is that Tonson published his octavo edition on July 29,³⁸⁶ and on August 1–3, probably in retaliation, Baker advertised his book once more.³⁸⁷ But, as far as I have been able to discover, Baker never again advertised his *Compleat History* in any newspapers. Moreover, the book did

383. See Gómez-Arostegui, *supra* note 7, at 1242 & n.234.

384. Ordinances Made by the Lord Chancellor Bacon, in THE GENERAL ORDERS OF THE HIGH COURT OF CHANCERY 1, 14 (London, Reed & Hunter, John Beames ed., 1815).

385. 1 PRAXIS ALMAE CURIAE CANCELLARIAE: BEING A COLLECTION OF PRECEDENTS 508 (London, A. Roper 2d ed. 1704); BOHUN, *supra* note 379, at 441.

Lord Keeper Heneage Finch wrote in his personal manual of chancery practice c.1673–1675 that “[w]here the bill charges no matter necessary for the plaintiff’s defence at law, there injunctions till answer are to be dissolved as well upon filing pleas or demurrers as putting in of answers.” LORD NOTTINGHAM’S “MANUAL OF CHANCERY PRACTICE” AND “PROLEGOMENA OF CHANCERY AND EQUITY” 147 (D.E.C. Yale ed., 1965) (c.1673–1675). He believed that the “old distinction between answer and plea and demurrer as to this purpose ought to cease.” *Id.* From the context in which this statement was made, however, it appears that he was speaking of injunctions to stay actions at law. If he was hoping to create a principle of general application, he did not succeed. See BOHUN, *supra* note 379, at 443 (noting that an injunction “until answer and further order” would be dissolved *nisi causa* after the filing of a plea or demurrer only if the plea or demurrer had been *granted*); cf. also *Osborn v. Cowper*, Mos. Rep. 198, 198 (Ch. 1729) (plea treated as an answer by *order* of the court at the plea hearing).

386. THE LONDON GAZETTE, No. 4723, July 27–29, 1710, at 2; THE DAILY COURANT (London), No. 2734, July 28, 1710, at 2 (to be published tomorrow).

387. THE EVENING POST (London), No. 152, Aug. 1–3, 1710, at 3.

not appear in a pamphlet he prepared, not long after the suit, listing books he had for sale.³⁸⁸

The lawsuit was probably affected by the long vacation after Trinity term. The last case heard in the Court of Chancery during the summer was on August 13, 1710,³⁸⁹ and before that date cases were heard only sporadically.³⁹⁰ The court only began hearing cases again in earnest in mid-October 1710.³⁹¹ Much of the legal community in London would have decamped to the country during the vacation,³⁹² and Tonson himself may have taken leave of the city. This suspension could have hurt Baker and his agents because the injunction would have still been in place during that time. The market for Baker's book would have fallen off greatly by the time court sessions resumed. Thus, Tonson's TRO might have been nearly as effective as a final injunction, and it might not have been worth it for Baker to continue the fight.

If the demurrer had been heard by the court, would the court have granted it? It is impossible to know for certain, but if the pre-statute cases and the cases that followed are any indication, it seems unlikely. Though some of Shelley's arguments had merit, the court may have allowed the suit to proceed with conditions.

Shelley's argument that the Court of Chancery had no jurisdiction to adjudge infringement under the Statute of Anne would probably have failed. The statute did not proscribe equity jurisdiction *in toto*, and the cases supported jurisdiction. In suits brought under a purported common-law copyright, for instance, before the statute was enacted, the court (including Lord Chancellor Cowper) had no qualms about addressing infringement when deciding whether to continue an interlocutory injunction.³⁹³ Years later, in cases brought under the statute itself, the court continued to address infringement at interlocutory stages of litigation³⁹⁴ and also went so far as to adjudge infringement in cases that resulted in decrees for final injunctions.³⁹⁵

388. BOOKS PRINTED FOR J. BAKER AT THE BLACK-BOY IN PATER-NOSTER-RROW (s.l.n. c.1711).

389. C37/862 (Ch. Trin. Term 1710).

390. C37/859, 860, 861 (Ch. Trin. Term 1710).

391. C37/863, 864, 865, 866 (Ch. Mich. Term 1710); C37/871 (Ch. Cause Book 1710).

392. DAVID LEMMINGS, PROFESSORS OF THE LAW 56 (2000).

393. *Wellington v. Levi*, C33/314, ff. 54^v–55^r (Ch. 1709) (Cowper, L.C.); *Chiswell v. Lee*, *sub nom.* *Chiswell v. Braddill*, C33/257, ff. 100^r, 112^{r-v} (Ch. 1681–1682).

394. *Sael v. Leadbeater*, *sub nom.* *In re Leadbetter*, 4 Ves. Jun. 681, 681 (Ch. 1799); *Carnan v. Paterson*, C33/465, ff. 449^v–450^r (Ch. 1786); *Trusler v. Evans*, *sub nom.* *Trusler v. Cummings*, C33/440, f. 284^r (Ch. 1773).

395. *Mason v. Murray*, C33/452, ff. 486^r–487^r (Ch. 1779); *Nicoll v. Simpson*, C33/430, ff. 251^v–252^v (Ch. 1768); *Millar v. Taylor*, C33/426, f. 60^{r-v} (Ch. 1765) (*The Complaint*); *Gay*

It was only if a dispute arose over the right or title in the work that the court sometimes felt compelled to refer that issue to a court of law to be determined. This was true in cases brought under printing patents and purported copyrights at common law prior to the statute³⁹⁶ as well as in cases brought under the statute.³⁹⁷

Shelley's arguments regarding the statutory remedies were much stronger but might not have led to dismissal. As I discuss in greater detail below,³⁹⁸ his first argument—that the Chancery was without jurisdiction to award the statutory penalties—was undoubtedly correct. Suffice it to say, the penalties could only be recovered in the law courts at Westminster. This would not, however, have prevented the Chancery from hearing the case and granting injunctive relief. Besides, Tonson's bill did not ask for the Chancery to award the penalties.

Shelley was also right to argue that the court could not compel Baker to provide information that might then lead to an award of the statutory penalties in one of the common-law courts. A rule prohibiting self-incrimination of this sort was already well established in equity by 1710.³⁹⁹ But once again, this argument would not necessarily have led to dismissal of the suit. A plaintiff could avoid dismissal by waiving the right to pursue, in a subsequent action at law, the penalties or forfeitures available by statute. Typically, a plaintiff would do so *ex ante* by waiving in the bill of complaint the right to pursue the penalties. Indeed, this later became routine in cases brought under the Statute of Anne.⁴⁰⁰ Tonson's solicitor failed to do this, but the court might have allowed him to amend the complaint to add a waiver or required him to disclaim, under pain of contempt and an injunction, the penalties under the Statute of Anne.⁴⁰¹

v. Walker, *sub nom.* Baller v. Watson, C33/369, ff. 315^v–316^v (Ch. 1737); Knaplock v. Curll, C33/339, f. 12^{r-v} (Ch. 1722).

396. Stationers v. Parker, C33/288, f. 202^r (Ch. 1696/7) (printing patent); Pawlett v. Lee, C33/262, ff. 323^v–324^r (Ch. 1683/4) (copyright at common law).

397. Beckford v. Hood, C33/497, f. 583^{r-v}, C33/500, f. 33^r (Ch. 1797); Millar v. Taylor, C33/426, ff. 68^v–69^r (Ch. 1765) (*The Seasons*).

398. *See infra* Part V.

399. MICHAEL R.T. MACNAIR, *THE LAW OF PROOF IN EARLY MODERN EQUITY* 68–73 (1999); *accord* BOHUN, *supra* note 379, at 112.

400. *See* Gómez-Arostegui, *supra* note 7, at 1243, 1271–72.

401. *Cf.* Gosling v. Walthoe, C33/331, f. 83^v (Ch. 1718) (overruling plea and requiring a pledge not to pursue penalties under a copyright by letters patent); Knaplock v. Curll, C33/339, f. 12^{r-v} (Ch. 1722) (reminding the plaintiff not to pursue the penalties under the Statute of Anne despite having already waived the penalties in the bill of complaint). If a plaintiff reneged on a waiver and later sought the penalties at law, the Chancery could enjoin

Less clear is whether the arguments described above would have applied to the extent that Tonson's right was based on the order of the House of Lords. Would the Chancery have held that only the Lords could hear a claim based on a violation of their privilege? The Lords certainly had jurisdiction to hear complaints of this type and had been known to claim *exclusive* jurisdiction over certain types of privileges (typically those protecting members).⁴⁰² Yet the Lords had never claimed an exclusive jurisdiction to adjudicate the infringement of a printing privilege granted to another.

Notably, in several cases after *Tonson*, the Chancery did not hesitate to rule on claims based in whole or in part on special printing privileges. In *Manby v. Owen*, for instance, the court granted an interlocutory injunction based solely on the breach of a printing privilege that had been granted by the Lord Mayor, and the court then decreed a perpetual injunction in the same case based on the privilege and the Statute of Anne.⁴⁰³ In *Bathurst v. Kearsley*, the court granted an interlocutory injunction in a case involving a parliamentary printing privilege identical to the one at issue in *Tonson*.⁴⁰⁴ The complaint had made no mention of the statute.⁴⁰⁵ The issue was then treated in a reported case in 1807, *Gurney v. Longman*, where the Lord Chancellor seemed content to adjudge the infringement of a parliamentary privilege, though not necessarily its validity.⁴⁰⁶

This invites the further question of how to classify *Tonson v. Baker*. Would the court have considered the case to depend on the Statute of Anne, on the privilege granted by the House of Lords, or both? Relatedly, could the claim under the statute have proceeded even without the order from the Lords? Arguably, Tonson was only made the "author" or assignee of the work by virtue of the order. But putting that wrinkle aside, he had registered the work before publication—which some litigants early on believed was required to obtain a copyright (including, it seems, Jacob Tonson)⁴⁰⁷—and Baker's

the action. *Accord* Atty-Gen. v. Smith (Exch. 1705), *reprinted in* EQUITY CASES, *supra* note 326, at 527, 528.

402. MAY, *supra* note 13, at 113–30.

403. C33/404, f. 164^v (Ch. 1755), C33/410, f. 396^{r-v} (Ch. 1758).

404. *See* C33/445, f. 577^v (Ch. 1776).

405. *Id.* at C12/1046/9, m. 1 (Ch. 1776).

406. 13 Ves. Jun. 493, 504–09 (Ch. 1807).

407. *See supra* text accompanying notes 340–42. The Chancery first rejected the argument that registration was required for copyright in 1716, as an interlocutory matter, when it was raised by John How. *See supra* text accompanying notes 241–44; *cf. also* DEAZLEY, *supra* note 4, at 53–55 (discussing the 1716 suit); HOW, *supra* note 233, at 13 (arguing before the Statute of Anne was enacted that registration should be a prerequisite for copyright protection under any new legislation). Other defendants continued to raise it in

account of the trial was undoubtedly copied from Tonson's. Resort to the parliamentary privilege for protection (rather than as evidence of standing) may have only become essential if Baker had produced his trial account independently, such as by hiring his own writers. But as that had not occurred, it seems that *Tonson* could have stood on the statutory infringement alone.

To be sure, on this very same point, the court in *Gurney* ostensibly held the contrary in 1807. There, the Chancery broadly stated that the right to print a trial in pursuance of an order of the House of Lords should not be considered a form of literary property under the Statute of Anne, but as arising solely from the parliamentary privilege awarded to the plaintiff.⁴⁰⁸ Yet, upon closer inspection, including a review of the original records in *Gurney*, it becomes clear that the case is materially distinguishable. The plaintiffs in *Gurney* were shorthand writers who obtained the exclusive right to print the trial of Lord Melville. As they were preparing to take their book to market, the defendants published their own account.⁴⁰⁹ The defendants' account was

Chancery, unsuccessfully, on other occasions. *E.g.*, *Nicoll v. Simpson*, C33/430, ff. 251v–252v (Ch. 1768), *reported in* THE ANNUAL REGISTER 105 (London, J. Dodsley 1768) (decreeing a final injunction and a disgorgement of the defendant's profits despite the fact the work was registered approximately two months *after* the plaintiff's first publication). In *Millar v. Taylor*, the majority thought that the unimportance of registration to the Chancery meant that the court was *not* operating under a statutory copyright but under a copyright at common law. 4 Burr. 2303, 2319, 2348 (K.B. 1769). Justice Yates disagreed. *Id.* at 2380 (Yates, J., dissenting). After statutory copyright prevailed in *Donaldson v. Becket*, 4 Burr. 2408, 2 Bro. PC 129, 17 Cobb. Parl. Hist. col. 953 (H.L. 1774), the Chancery continued to doubt whether registration was required for copyright protection and asked for the issue to be resolved at law. *E.g.*, *Rippon v. Crosby*, C33/494, f. 202v (Ch. 1796), *reported in* THE MORNING CHRONICLE (London), No. 8250, Mar. 18, 1796, at 3; *Beckford v. Hood*, C33/497, f. 583r–v, C33/500, f. 33r (Ch. 1797). When the King's Bench reached the issue in 1798, it held that registration was required only if one sought to recover the penalties or forfeitures provided under the statute, but not for statutory protection itself and thus for other remedies such as damages at common law. *See Beckford v. Hood*, 7 T.R. 620, 627 (K.B. 1798); *see also* *Tonson v. Collins*, 1 Black. W. 321, 330 (K.B. 1761) (Mansfield, C.J.) (*obiter dictum*). Conversely, in Scotland, the Court of Session had taken a different view and in effect had held that registration was required for copyright protection. *E.g.*, *Midwinter v. Hamilton*, 2 Kam. Rem. 154, 158–59 (Sess. 1748); *Payne v. Anderson*, Law Steuart Craigie 524, 527–28 (Sess. 1787). The House of Lords later agreed with the King's Bench in a case appealed from Scotland, thus settling the split of authorities in Great Britain. *Cadell v. Robertson*, 5 Paton's App. Cases 493 (H.L. 1811).

408. *Gurney*, 13 Ves. Jun. at 507; *accord* GEORGE T. CURTIS, A TREATISE ON THE LAW OF COPYRIGHT 129 (Boston, Charles C. Little & James Brown 1847); CHARLES STEWART DREWRY, A TREATISE ON THE LAW AND PRACTICE OF INJUNCTIONS 210 (London, S. Sweet 1841); ROBERT HENLEY EDEN, A TREATISE ON THE LAW OF INJUNCTIONS 271 (London, Joseph Butterworth & Son 1821).

409. *Gurney v. Longman*, C13/2079/51, m. 1 (Ch. 1806).

based on the work of their *own* shorthand writers.⁴¹⁰ Therefore, the defendants were not alleged to have copied the plaintiffs' work, as occurred in *Tonson*, and the plaintiffs could not, and did not, invoke the statute. It thus seems that the holding in *Gurney* might best be characterized as *obiter dictum*.

Interestingly, in 1716, the Tonsons had encountered a situation similar to that presented in *Gurney* and opted to forgo a Chancery suit, instead pursuing their claim in Parliament. Lord Chancellor Cowper had appointed Jacob Tonson Jr. to print the trial of George Earl of Wintoun in the House of Lords.⁴¹¹ Before Tonson's book became available on April 19,⁴¹² Edmund Curll and his partners published their own abbreviated tract of the trial on April 10.⁴¹³ Curll's version was not a copy of Tonson's trial, but was instead based on a different account prepared for publication in the *Leiden Gazette*. Triggered by Tonson's complaint, Curll and his confederates were hauled before the House of Lords and punished for breach of the privilege.⁴¹⁴



It is difficult to avoid hindsight distortion when one stands 300 years away from an event, and I have tried my best to keep that in mind in offering my views. It is truly a shame that *Tonson v. Baker* did not proceed, as the case could have explored numerous issues under the Statute of Anne immediately after its passage. Among other things, the Chancery, or a common-law court by referral from the Chancery, could have discussed how the statute interacted with other privileges, whether deposit of a book was required for protection under the statute, and whether Baker's changes to the trial were fair or not. It could have also broached the issue, had it been raised, of whether a work had to be "original"—i.e., independently created—and if so, whether Tonson's work qualified given that all of what he published in his account originated from the speeches, and thus authorship, of others. Instead, it took many years before these issues were addressed by courts.⁴¹⁵

410. *Id.* at C13/2084/12 (Ch. 1807).

411. It is often assumed that Jacob Sr. received this appointment. *See* RALPH STRAUS, *THE UNSPEAKABLE CURLL* 65 (1928); Sturges, *supra* note 87, at 26. But the register book indicates that Jacob Jr. claimed it. Register Book MS, *supra* note 81, at 234 (Apr. 19, 1716).

412. *THE DAILY COURANT* (London), No. 4522, Apr. 18, 1716, at 2.

413. *THE FLYING=POST* (London), No. 3786, Apr. 7–10, 1716, at 2.

414. BAINES & ROGERS, *supra* note 286, at 76–79.

415. *See, e.g.*, *Gurney v. Longman*, 13 Ves. Jun. 493 (Ch. 1807) (privileges); *University of Cambridge v. Bryer*, 16 East 317 (K.B. 1812) (legal deposit); *Gyles v. Barlow*, *sub nom.* *Gyles v. Wilcox*, 2 Atk. 141 (Ch. 1740/1) (fair abridgment); *Skillern v. Longman* (K.B. 1793), *reported in* *THE WORLD* (London), No. 2176, Dec. 18, 1793, at 3 (originality and creativity).

C. POSTSCRIPT

In the fall of 1718, a few years before his retirement, Tonson assigned all of his copyrights to his nephew Jacob Tonson Jr. The transfer listed many of the titles by name, including works by John Dryden, John Milton, and Matthew Prior. Other works were incorporated by referring to previous copyright assignments. The rest were assigned with a catch-all clause: Tonson assigned to his nephew “all and every other Copies Shares or parts of Copies of books whatsoever which doth of right belong unto the said Jacob Tonson the Elder at the time of the sealing and delivery hereof.”⁴¹⁶ This assignment undoubtedly included the rights to *The Tryal of Dr. Henry Sacheverell*, and many years later Jacob Jr. still claimed to own the copyright in the work.⁴¹⁷

Jacob Jr. never saw a market for republishing the *Tryal* as a stand-alone work, but he instead made it part of a new multi-volume collection of notable State trials that he published in partnership with several booksellers and printers. The first edition appeared in 1719,⁴¹⁸ and a second, which included the speeches of the Bishops for the first time, appeared in 1730.⁴¹⁹ Jacob and his partners quarreled over allegations of irregular accounting, leading to years of litigation.⁴²⁰ Jacob died in November 1735 while the suit was pending, predeceasing his uncle by just over three months; Jacob Sr. died in March 1735/6.⁴²¹ For those who are curious, Marmaduke Horsley, the pioneering solicitor, was dead and buried by January 23, 1722/3.⁴²² It appears he was struck with a sudden illness. His will, which said he was of “weak body,” was very short and was signed less than a week before he died.⁴²³

The *Tryal* lived on in subsequent editions of the *Complete Collection of State Trials* up through its final official publication in 1812.⁴²⁴ The last edition that

416. Rosenbach Museum & Library EMs 417/10 (Sept. 17, 1718). Jacob Sr. assigned the last of his printing rights, *viz.*, his half share of certain public-office printing, to his nephew in October 1722. Folger Shakespeare Library MS C.c.1 No. 60 (Oct. 12, 1722).

417. See Vincent v. Walthoe, C11/779/47, m. 2 (Ch. 1733) (mentioning the copyright).

418. ESTC No. T108672.

419. ESTC No. T108500.

420. See generally *In re State Tryalls*, Court Book H, pp. 395–97, 399, 400, 404–05 (Ct. Ass. 1730/1) (failed mediation of the dispute); Vincent v. Walthoe, C11/695/13, C11/779/47, C11/696/42, C11/783/36 (Ch. 1731–1736); Walthoe v. Vincent, C11/797/36, C11/798/1, C11/861/82 (Ch. 1731–1736).

421. LYNCH, *supra* note 84, at 173–74.

422. Register of Burials, St. Dunstan in the West, Guildhall MS 10350 (Jan. 23, 1722/3).

423. Will of Marmaduke Horsley, PROB 11/686, f. 219^v (will Jan. 17, 1722/3; probate Feb. 15, 1722/3).

424. 15 A COMPLETE COLLECTION OF STATE TRIALS, AND PROCEEDINGS FOR HIGH TREASON AND OTHER CRIMES AND MISDEMEANORS cols. 1–522 (London, Longman,

bore a Tonson name on the imprint—that of Jacob Tonson III and Richard Tonson, both the sons of Jacob Jr.—had appeared in 1742.⁴²⁵

As far as is known, the *Tryal* was never blatantly copied again without authorization of the proprietors. The closest candidate appeared in 1711, under the title *High Church Display'd*.⁴²⁶ The work was based in part on Tonson's *Tryal*, but it was much abridged and it reorganized the trial so that the speeches were grouped together by order of the articles of impeachment, rather than in strict chronological order. In hindsight, it is likely that this was a fair abridgment and permissible under the Statute of Anne, but it undoubtedly infringed Tonson's parliamentary privilege.

An account of the “trial at large” was then supposed to have appeared in 1737, as part of a new weekly magazine, but it never materialized.⁴²⁷ Instead, or coincidentally, a 164-page abridged copy of Baker's *Compleat History* appeared that year under an anonymous imprint.⁴²⁸

The copier had become the copied. Had Baker still been alive, I am sure that he would have appreciated the irony. It certainly makes for an interesting end to a fascinating story.

V. A DOCTRINAL LESSON

Most historians will be quick to point out that history for the sake of history is a noble cause. I agree, of course, and not simply because I do not wish to bite the hand that feeds me. *Tonson v. Baker* unquestionably holds an important place in the history of copyright. It was the first lawsuit filed under the Statute of Anne and it pitted some of the most interesting and complicated characters of the London book trade against one another. On those grounds alone, *Tonson* deserved a full and critical account, and this Article could very well have ended here. But copyright history can, and often does, matter for so much more when legal rules are at issue. It can, for one, serve as a historical crutch to support normative arguments.⁴²⁹ But it can also affect doctrinal outcomes. I have previously argued, for example, that

Hurst, Rees, Orme & Brown, T.B. Howell ed., 1812). Apart from the Bishops' speeches, this edition also included Abel Roper's *Impartial Account*, which immediately preceded the *Tryal*.

425. ESTC No. T148933.

426. HIGH-CHURCH DISPLAY'D (London, s.n. 1711).

427. R.M. WILES, SERIAL PUBLICATION IN ENGLAND BEFORE 1750, at 71, 310 (1957).

428. A COMPLEAT HISTORY OF THE WHOLE PROCEEDINGS OF THE PARLIAMENT OF GREAT BRITAIN, AGAINST DR. HENRY SACHEVERELL (London, s.n. 1737).

429. See generally Kathy Bowrey & Natalie Fowell, *Digging Up Fragments and Building IP Franchises*, 31 SYDNEY L. REV. 185 (2009); Justin Hughes, *Copyright and Incomplete Historiographies: Of Piracy, Propertization, and Thomas Jefferson*, 79 S. CAL. L. REV. 993 (2006).

English copyright history and practices c.1789 can be profoundly important today when deciding whether to grant injunctive relief or compensatory remedies in lieu thereof.⁴³⁰

In this section, I wish to explore the doctrinal significance of copyright history to the constitutional right to a jury trial. The subject of my critique is the Supreme Court's decision in *Feltner v. Columbia Pictures Television, Inc.*⁴³¹ There, the Court held that the Seventh Amendment guarantees a right to a jury trial for all issues relating to an award of statutory damages under § 504(c) of the Copyright Act of 1976.⁴³² Using the Statute of Anne and *Tonson v. Baker* as contemporary foils, I aim in the pages that follow to demonstrate that *Feltner* would have been much easier to decide if the Court had more fully understood the history of copyright litigation and the practices of the equity courts. Several errors in the Court's opinion will also be highlighted.

The facts of *Feltner* are familiar to any student of U.S. copyright law.⁴³³ The plaintiff owned copyrights in several television programs and licensed them for broadcast on Elvin Feltner's television stations. The stations did not pay the royalties due, and the plaintiff terminated the license. Feltner then brazenly broadcast the programs and was sued for infringement. Judge Edward Rafeedie granted partial summary judgment for the plaintiff on liability and held a bench trial on statutory damages. He then awarded \$8.8 million over the objection of Feltner who argued, for purposes of awarding statutory damages, that he was entitled to a jury trial under the Seventh Amendment on the willfulness of his infringement and the amount of the award. The Ninth Circuit affirmed in relevant part,⁴³⁴ but Feltner pressed his case to the Supreme Court with the help of the future Chief Justice of the United States, John Roberts. The Court sided with Feltner, but it was a hollow victory because on remand the jury held him liable for \$31.68 million.⁴³⁵

The reasoning of the Supreme Court tracked its usual approach in deciding cases under the Seventh Amendment. The principal objective was to determine whether the statutory-damage remedy was more akin to an action at law or a suit in equity around the year 1791—the year the Seventh

430. H. Tomás Gómez-Arostegui, *Prospective Compensation in Lieu of a Final Injunction in Patent and Copyright Cases*, 78 *FORDHAM L. REV.* 1661 (2010); Gómez-Arostegui, *supra* note 7.

431. 523 U.S. 340 (1998).

432. 17 U.S.C. § 504(c) (1988).

433. *See generally* *Columbia Pictures Television, Inc. v. Krypton Broad. of Birmingham, Inc.*, 106 F.3d 284, 288 (9th Cir. 1997), *rev'd*, 523 U.S. 340 (1998).

434. *Id.* at 297.

435. *Columbia Pictures Television, Inc. v. Krypton Broad. of Birmingham, Inc.*, 259 F.3d 1186, 1189–91 (9th Cir. 2001).

Amendment became operative.⁴³⁶ Whereas courts of law heard claims with the aid of a jury, the equity courts operated without one. This task required the Court to look to English law and, insofar as probative material was available, law from the states and the newly established legislature and judiciary of the United States.

Undertaking that review, the Court noted that § 504(c) had several analogues in the late 18th century. Starting with English law, the Court stated that a common-law right of first publication in manuscripts had been recognized in England by the middle of the 17th century.⁴³⁷ This type of right, the Court alleged, was subject to a recognized remedy in damages that “w[as] tried in courts of law in actions on the case.”⁴³⁸ The Court then turned to the Statute of Anne which, the Court posited, was enacted to protect published books. The Court’s analysis of the statute was as follows:

Under the Statute of Anne, damages for infringement were set at “one Penny for every Sheet which shall be found in [the infringer’s] custody, either printed or printing, published, or exposed to Sale,” half (“one Moiety”) to go to the Crown and half to the copyright owner, and were “to be recovered . . . by Action of Debt, Bill, Plaint, or Information.” § 1. Like the earlier practice with regard to common-law copyright claims for damages, actions seeking damages under the Statute of Anne were tried in courts of law. *See Beckford v. Hood*, 7 T.R. 621, 627, 101 Eng. Rep. 1164, 1167 (K.B. 1798) (opinion of Kenyon, C.J.) (“[T]he statute having vested that right in the author, the common law gives the remedy by action on the case for the violation of it.”).⁴³⁹

Lastly, the Court examined state and federal legislation in the United States. Twelve states had enacted copyright statutes between 1783 and 1786, and according to the Court each “provided a cause of action in damages” and “none made any reference to equity jurisdiction.”⁴⁴⁰ The Court took this to mean these remedies were only recoverable at law, where they would be heard by a jury, and cited one state-law case as an example of this principle in action.⁴⁴¹ The Court then noted that the federal Copyright Act of 1790 mimicked the English practice: for published works, the statute provided a

436. *Feltner*, 523 U.S. at 347–48.

437. *Id.* at 349 (citing *Stationers v. Patentees*, Carter 89 (C.P. 1666) (should be H.L. 1669)).

438. *Id.* (citing *Millar v. Taylor*, 4 Burr. 2303, 2396–97 (K.B. 1769)).

439. *Id.* at 349–50.

440. *Id.* at 350.

441. *Hudson v. Patten*, 1 Root 133 (Conn. Super. 1789).

penalty to be recovered by an “action of debt in any court of record,”⁴⁴² and for unpublished manuscripts it entitled the owner to a “special action on the case [for damages] . . . in any court having cognizance thereof.”⁴⁴³ The Court cited no federal or state cases applying the 1790 Act,⁴⁴⁴ but instead cited cases that had asked juries to assess a similar penalty for published works under the Copyright Act of 1831.⁴⁴⁵

In all, the Court spent over eight pages demonstrating why the statutory-damages provision of § 504(c) was a legal remedy rather than an equitable one. The Court’s efforts are laudable and it reached the correct outcome. But the Court made some mistakes regarding English copyright and common law and thus missed an opportunity to more easily and correctly dispatch the argument that the relief was equitable. Those errors and omissions would not have occurred if the Court had been better apprised of English legal history. First, I will treat the errors, which though largely incidental must still be corrected. I will then turn to the omission. I will expend much more space than the Court would have had to. Notably, the principles discussed below exist independently of *Tonson v. Baker*, and thus could have been discovered and applied without knowledge of the case. Nevertheless, as we will soon see, one principle in particular, which the Court omitted entirely, also appears in *Tonson*.

In the first of its errors, the Court cited *Stationers v. Patentees* for a proposition that it does not support. *Stationers* did not hold or otherwise state in 1666, as the Court alleged, that the “common law recognized” an author’s right to prevent the unauthorized publication of her manuscript. It appears

442. Act of May 31, 1790, ch. 15, § 2.

443. *Id.* § 6.

444. The Court did not cite and perhaps was unaware of a case decided under the 1790 Act in the Circuit Court of the District of New York in 1798. The case is *Morse v. Reid* and it appears in 5 COLLECTIONS OF THE MASSACHUSETTS HISTORICAL SOCIETY FOR THE YEAR MDCCXCVIII 123 (Boston, Samuel Hall 1798). The district court granted a final injunction and ordered the disgorgement of the defendant’s profits, but did not purport to award the plaintiff the penalties under the 1790 Act. *Id.* at 124; *see also* John D. Gordan, *Morse v. Reid: The First Reported Federal Copyright Case*, 11 LAW & HIST. REV. 21 (1993).

Kilty v. Green is another case that went unmentioned by the Court. 4 H & McH. 345 (Md. Gen. 1799). There, the plaintiff sued in an action of assumpsit for the infringement of a copyright he had registered under the 1790 Act. The issue was whether the plaintiff could recover from the defendant “the sum of money for which the said [infringing] 101 copies . . . were sold.” *Id.* at 346. Though that would have been an interesting remedy indeed, the Maryland court did not reach the issue. It held that the plaintiff’s work was uncopyrightable because it was merely a collection of statutes. It also does not appear that the plaintiff sought the penalties available under the 1790 Act.

445. *Feltner*, 523 U.S. at 352.

the Court misunderstood the following sentence: “No man can print a book till it be licensed.”⁴⁴⁶ The word “license” referred not to obtaining a license from the author to publish, but to obtaining a pre-publication allowance from the censorship authorities.⁴⁴⁷ To be sure, authors did come to hold a right to prevent the unauthorized publication of their manuscripts, but this concept was not, as far as is known, applied in equity until 1732⁴⁴⁸ and was not recognized by a common-law court until 1769 in *obiter dictum*.⁴⁴⁹

In another part of its analysis, the Supreme Court also improperly relied on *Beckford v. Hood*.⁴⁵⁰ According to the Court, the Statute of Anne provided “damages” of a penny a sheet, half of which would go to the Crown and the other to the copyright owner.⁴⁵¹ The Court then cited *Beckford* for the proposition that the “damages” remedy under the statute was available in a court of law in an action on the case. *Beckford*, however, said nothing of the sort. The issue in *Beckford* was whether a copyright owner could bring an action for a remedy outside the terms of the statute. The King’s Bench held

446. *Stationers v. Patentees*, Carter 89, 91 (H.L. 1669).

447. See Statute, 1662, 13 & 14 Car. 2, c. 33, § 2.

448. *Webb v. Rose*, C33/358, ff. 308^v–309^r (Ch. 1732) (Jekyll, M.R.); see also *Millar v. Taylor*, 4 Burr. 2303, 2397–98 (K.B. 1769) (Mansfield, C.J.) (“Before 1732, the case of piracy before publication never existed: it never was put, or supposed. There is not a syllable about it to be met with any where. . . . [T]he cases in Westminster-Hall, all relate to the copy of books after publication by the authors.”). In an earlier case from 1721, the Chancery enjoined the translation of a work that had previously been printed by the proprietor for private circulation only. *Burnett v. Chetwood*, 2 Mer. 441, 442–43 (Ch. 1721). For a discussion of whether this might be the first pre-publication suit acted upon in equity, see Simon Stern, *From Author’s Right to Property Right* 11–13 (working paper). Notably, there is an earlier suit where similar relief was sought. *Burnet v. Took*, C11/15/4 (Ch. 1716).

449. *Millar*, 4 Burr. at 2330–31 (Willes, J.); *id.* at 2340 (Aston, J.); *id.* at 2356, 2378–79 (Yates, J., dissenting); *id.* at 2396–98 (Mansfield, C.J.). Counsel mentioned this right in *Tonson v. Collins*, 1 Black. W. 301, 302–03, 330–34, 338 (K.B. 1761).

I would be remiss if I failed to note a citation error in the Court’s opinion. Despite the Court’s reference to the contrary, the *Stationers* opinion did not come from the Common Pleas in 1666, but from the House of Lords in 1669. The report states it was decided “In Parliament.” *Stationers*, Carter at 89. Admittedly less accessible is the date of the decision. The report is undated and the cases preceding it are listed as 18 Car. 2, Mich., thus suggesting the correct year was 1666. But Sir John Baker, using manuscript reports, has shown that the Lords ruled on the case in 1669. See John H. Baker, *English Law Books and Legal Publishing*, in 4 THE CAMBRIDGE HISTORY OF THE BOOK IN BRITAIN, *supra* note 255, at 474, 486–87.

450. 7 T.R. 620 (K.B. 1798).

451. See *supra* text accompanying note 439. Incidentally, the latter part of this statement is incorrect. The statute does not specifically provide that the other half would go to the copyright owner. Rather, it would go to whoever sued for the infringement. In practice this was always, as far as is known, the copyright owner, but recovery could in theory be had by any common informer. See Gómez-Arostegui, *supra* note 7, at 1270.

that an action on the case for *ordinary damages*—rather than an action on the statute for the penalties—could be brought in a common-law court.⁴⁵²

More important than the errors is a glaring omission in the Court's analysis of the Statute of Anne. The principal reason why the penalties under the statute were only available at law, and not in equity, went entirely unnoticed by the Court. By its own terms, the statute made the penalties recoverable only in “any of her Majesties *Courts of Record* at Westminster by Action of debt Bill plaint or Information.”⁴⁵³ But neither the Court, the litigants, nor the amici curiae inquired into whether “courts of record” was a term of art and, if so, what meaning Parliament, courts, and litigants would have ascribed to it from 1710 through 1791. Indeed, the Court thought the phrase so unimportant that an ellipsis was substituted for it when quoting the Statute of Anne.⁴⁵⁴ That was unfortunate. A cursory examination of English legal history would have revealed that courts of equity were not courts of record. This was also demonstrated in *Tonson v. Baker*.

The term “court of record” was not meant to include every court that kept a record of its proceedings. Several characteristics of a court of record held sway at one time or another, including a court: (1) whose record was considered conclusively authentic; (2) that enrolled its records on a parchment roll in Latin; (3) that had the power to fine and imprison; (4) whose judgments could be appealed by writ of error; and (5) that strictly followed the course and precedent of the common law.⁴⁵⁵ Many of these criteria were questionable when posited, often because they had been twisted to suit the needs of a proponent or opponent of the court under consideration.⁴⁵⁶ Others became obsolete in the course of time.⁴⁵⁷ Yet long after these criteria were uttered, the labels attributed early on to certain courts as being “of record” and other courts as “not of record” persisted in many areas.

452. *Beckford*, 7 T.R. at 627–29. Even that holding has an interesting back story. See Gómez-Arostegui, *supra* note 7, at 1275–77.

453. See *supra* note 40 for the text of the statute (emphasis added).

454. See *supra* text accompanying note 439.

455. 5 WILLIAM HOLDSWORTH, A HISTORY OF ENGLISH LAW 157–61 (3d ed. 1945).

456. *Id.* at 160; see also 6 JEREMY BENTHAM, THE WORKS OF JEREMY BENTHAM 185 (Edinburgh, William Tait, John Bowring ed., 1843) (criticizing authenticity standards).

457. For example, from 1651 to 1660, and from 1733, all court proceedings were ordered to be in English. See An Act for Turning the Books of the Law, and All Proces and Proceedings in Courts of Justice, Into English (Nov. 22, 1650), 2 ACTS & ORDINANCES OF THE INTERREGNUM, 1642–1660, at 455, 456 (C.H. Firth & R.S. Rait eds., 1911) (eff. 1651 to 1660); Statute, 1731, 4 Geo. 2, c. 26 (eff. Mar. 25, 1733).

The four regular courts at Westminster Hall—the King’s Bench, Common Pleas, Exchequer, and Chancery—all qualified to some extent as courts of record, but while some were exclusively so, others were hybrids.

The King’s Bench and Common Pleas, for example, were always understood to be courts of record.⁴⁵⁸ These were the principal common-law courts in England and satisfied the criteria noted above. The penalties under the Statute of Anne, and subsequent copyright statutes with similar language, were unquestionably available in the King’s Bench and Common Pleas. Had the stakeholders or the Court in *Feltner* investigated English copyright law further, they would have discovered a handful of reported cases in which litigants pursued the statutory remedies in these two common-law courts.⁴⁵⁹ Indeed, these cases could have been cited independently of the “court of record” issue.

The Courts of Exchequer and Chancery, on the other hand, were hybrid courts. Each had multiple sides to its judicial business, some of which occurred in a court of record and some of which occurred in a court not of record. I treat the development of each court and side below. But given the greater doctrinal importance of the Court of Chancery to our system of laws in the United States, I will say more of its development than I do of the Exchequer.

A. COURT OF EXCHEQUER

The Court of Exchequer’s judicial business first developed at law and heard claims relating to its officers and the royal revenue.⁴⁶⁰ Plea rolls exist in the Exchequer from 1236.⁴⁶¹ On a separate procedural and clerical track, the court began to develop an equitable jurisdiction in the mid-16th century to better enable it to collect revenue for the crown.⁴⁶² The jurisdiction on the law and equity sides later expanded to claims that indirectly affected the revenue, and later still, through the use of fictional allegations, to most civil claims at law and in equity.⁴⁶³ With some exceptions, the records on the

458. See THOMAS WOOD, AN INSTITUTE OF THE LAWS OF ENGLAND 470 (London, W. Strahan & M. Woodfall 10th ed. 1772).

459. *Coleman v. Wathen*, 5 T.R. 245 (K.B. 1793); *Brooke v. Milliken*, 3 T.R. 509 (K.B. 1789); *Trusler v. Murray*, *cit.* 1 East 360 n.(b) (K.B. 1789); *Sayer v. Dicey*, 3 Wils. K.B. 60 (C.P. 1770). Less accessible is the case of *Watson v. Sayer*, Mansfield MS f. 478^r (K.B. 1776), reprinted in 1 JAMES OLDHAM, THE MANSFIELD MANUSCRIPTS 744 (1992).

460. 6 SIR JOHN BAKER, THE OXFORD HISTORY OF THE LAWS OF ENGLAND, 1483–1558, at 161–69 (Sir John Baker ed., 2003).

461. SELECT CASES IN THE EXCHEQUER OF PLEAS, at xxxix (Hilary Jenkinson & Beryl E.R. Formoy eds., 1932).

462. W.H. BRYSON, THE EQUITY SIDE OF THE EXCHEQUER 16, 31 (1975).

463. EQUITY CASES, *supra* note 326, at xi–xii.

common-law side before 1733 were all in Latin, while those on the equity side were in English.⁴⁶⁴

When Sir Edward Coke called the Exchequer “an ancient court of record” he was referring to its law side.⁴⁶⁵ The equity side was no court of record. Thomas Wood, author of a major treatise on the laws of England, stated as much when describing the courts that sat in Westminster. The Exchequer, he wrote in 1724, was a court of record, “[e]xcept [for] the Equity-side.”⁴⁶⁶ A similar comment was made by Giles Jacob in 1733: “[T]he Court of Equity, like the Chancery, is no Court of Record.”⁴⁶⁷ And in c.1809, Jeremy Bentham wrote that “[a]s to the Court of Exchequer, being a sort of motley court, one side of it a law side, the other an equity side, it must, according to principle, be neither a court of record only, nor a court not of record only, but both together.”⁴⁶⁸

I know of no copyright cases having been brought in the Exchequer for the penalties under the Statute of Anne, but in light of the foregoing it appears clear that any such claim would have been brought on the law side and not on the equity side. This meant it would have been heard by a jury.⁴⁶⁹

B. COURT OF CHANCERY

The Court of Chancery also began as a common-law court but unlike the Court of Exchequer, it always conducted the vast majority of its adjudication on the equity side. The law side originated in the Chancery’s ancient practice

464. BRYSON, *supra* note 462, at 90.

465. 2 EDWARD COKE, *INSTITUTES OF THE LAWS OF ENGLAND* 551 (London, E. & R. Brooke 1797) (c.1630).

466. THOMAS WOOD, *AN INSTITUTE OF THE LAWS OF ENGLAND* 472 (Savoy, E. Nutt et al. 3d ed. 1724).

467. GILES JACOB, *THE COMMON LAW COMMON-PLAC’D* 160 (Savoy, E. Nutt et al. 2d ed. 1733).

468. 2 JEREMY BENTHAM, *RATIONALE OF JUDICIAL EVIDENCE SPECIALLY APPLIED TO ENGLISH PRACTICE* 630 n.* (London, Hunt & Clarke, John Stuart Mill ed., 1827) (c.1809).

469. The Exchequer suits under the Statute of Anne, of which I am aware, were brought on the equity side for injunctive relief and disgorgement of the defendant’s profits, and not for the penalties under the statute. *E.g.*, Longman v. Forster, E112/1746/4924 (Exch. 1791); Forster v. Longman, E112/1724/4329 (Exch. 1788); Rennett v. Haxby, E112/1718/4152 (Exch. 1785); Longman v. Rennett, E112/1718/4165 (Exch. 1785); Longman v. Fielding, E112/1684/3268 (Exch. 1783); Rennett v. Longman, E112/1758/5277 (Exch. 1780).

I am indebted to Nancy Mace for bringing these suits to my attention. *See* Nancy A. Mace, *Litigating the Musical Magazine: The Definition of British Music Copyright in the 1780s*, in 2 *BOOK HISTORY* 122 (Ezra Greenspan & Jonathan Rose eds., 1999); Nancy A. Mace, *Charles Rennett and the London Music-Sellers in the 1780s: Testing the Ownership of Reversionary Copyrights*, 129 *J. ROY. MUSICAL ASS’N* 1 (2004); Nancy A. Mace, *Haydn and the London Music Sellers: Forster v. Longman & Broderip*, 77 *MUSIC & LETTERS* 527 (1996).

of issuing the original writs that were required to initiate an action in the Courts of King's Bench and Common Pleas.⁴⁷⁰ The original writ was a form letter drafted by the office of the Chancery in Latin. The letter issued in the name of the King, stated the cause of the plaintiff's complaint, and commanded the defendant to satisfy the claim or appear in the King's Bench or Common Pleas to defend himself.⁴⁷¹ Gradually the writs became templates, to be reused in like cases, and they were collected by the Chancery in a register of writs for that purpose. The Chancery thus initiated the process of litigation at law but did not decide the case.

The court also developed a limited adjudicative role at common law. Due to a jurisdictional privilege, the officers and employees of the Chancery could not sue or be sued in any other court.⁴⁷² Any action at law had to be brought by or against these officials in the Court of Chancery where the Chancellor would then follow the rules and procedures of the common-law courts. If there was an issue of fact to be decided, the case was transferred to the King's Bench to have that issue tried by a jury.⁴⁷³ In some cases, the Chancellor also sought the assistance of a law judge.⁴⁷⁴ A limited set of other areas also fell under the common-law jurisdiction of the Chancellor, including the revoking and amending of any letters patent that had previously been enrolled in the Chancery.⁴⁷⁵ Because proceedings on this "petty bag" side of the court typically generated records in Latin, many called it the Latin side.⁴⁷⁶

The equitable jurisdiction of the Chancery began to develop in the 13th century, largely because of the rigidity of the original writ system, and it adjudicated equitable claims in its own right by the 14th century.⁴⁷⁷ Cases were presented by bill, where the plaintiff recited the facts and the wrong and prayed for the Chancellor to do what was right. Bills were recorded on pieces of parchment rather than on "rolls." And though the earliest pleadings were first submitted to the court in French or Latin, by the middle of the 15th

470. FLETA bk. 2, ch. 13, at 123 (H.G. Richardson & G.O. Sayles eds. & trans., 1955) (1290).

471. A.H. MARSH, HISTORY OF THE COURT OF CHANCERY 17 (Toronto, Carswell 1890).

472. W.J. Jones, *An Introduction to the Petty Bag Proceedings in the Reign of Elizabeth I*, 51 CAL. L. REV. 882, 892-93 (1963); *see also, e.g.*, Sewell v. Hill, *cit.* 3 Ves. Jun. 596 (Ch. Petty Bag 1797).

473. Jones, *supra* note 472, at 886-87.

474. *E.g.*, Anonymous (Ch. Petty Bag 1715), *reprinted in* SIR JOHN RANDOLPH'S KING'S BENCH REPORTS 1715 TO 1716, at 51, No. 55 (W.H. Bryson ed., 1996).

475. *See generally* Jones, *supra* note 472, at 891-92, 897-99.

476. *E.g.*, 1 A GENERAL ABRIDGMENT OF CASES IN EQUITY 129 (Savoy, Henry Lintot 4th ed. 1756); *Dominius Rex v. Cary*, 1 Vern. 131, 131 (Ch. Petty Bag 1682).

477. J.H. BAKER, AN INTRODUCTION TO ENGLISH LEGAL HISTORY 101-05 (4th ed. 2002).

century they were in English.⁴⁷⁸ The orders and decrees, which survive beginning in 1544, were recorded in English on paper in register books.⁴⁷⁹ The equity side of the court was thus sometimes referred to as its English side. Additionally, because the court operated according to “conscience,” and not by the strict course of the common law or even its own precedent, observers accused it of arbitrariness and hardly worthy of being a court of record. Though this was true during the court’s early periods, in the course of time, equity generally followed the common law and in cases where it did not, equity developed its own body of precedents just as the law courts had.⁴⁸⁰

The prevailing view in England, long before and after the Statute of Anne was enacted, was that the equitable side of the Court of Chancery was not a court of record. There was an early disagreement by the common-law judges in the 15th century on the extent to which the Chancery qualified,⁴⁸¹ but the Chancery’s designation on the equity side soon settled. John Hales stated it was not of record in 1514.⁴⁸² And by the time of Elizabeth I, it was clear that the Chancery was not on the “same footing as King’s Bench or Common Pleas [because it] had not achieved general recognition as a court of record.”⁴⁸³ The same was true in the reign of James I, with the greatest advocate for this view being Coke, whose dislike of the equity side of the Chancery was notorious. He wrote in c.1630 that though the law side of the Chancery was of record, the equity side was not: “[T]he court of chancery . . . which proceedeth according to the course of the common law, as in case of [jurisdictional] privilege . . . is a court of record, but as to the proceeding by English bill in course of equity, it is no court of record”⁴⁸⁴

Indeed, the distinction was so fundamental that it was nearly always mentioned in the most important works on the laws and judiciary of England. Wood, for instance, described the distinction in every edition of his

478. SELECT CASES IN CHANCERY A.D. 1364 TO 1471, at xxv, xxiv (London, Bernard Quaritch, William P. Baildon ed., 1896).

479. The early register books did have some Latin scattered throughout, however. *E.g.*, C33/1 (Ch. 1544). Final decrees were sometimes enrolled in the Chancery on parchment in C78.

480. BAKER, *supra* note 477, at 109–11.

481. *Reynolde v. Knott*, Y.B. 37 Hen. VI, pl. 3, f. 13^r, Seipp 1459.003 (Ct. Exch. Chamb. 1459), reprinted in SELECT CASES IN THE EXCHEQUER CHAMBER BEFORE ALL THE JUSTICES OF ENGLAND 1377–1461, at 147, 150–52 (M. Hemmant ed., 1933).

482. John H. Baker, *Introduction*, in 2 THE REPORTS OF SIR JOHN SPELMAN 75 (J.H. Baker ed., 1978), translating Gray’s Inn MS 25, f. 292^v (1514).

483. W.J. JONES, THE ELIZABETHAN COURT OF CHANCERY 488 (1967).

484. 3 COKE, *supra* note 465, at 71. He repeated the argument in Parliament. See 1 H.C. JOUR. 594 (Apr. 27, 1621). Sir Henry Finch concurred. See HENRIE FINCH, LAVV, OR, A DISCOVERSE THEREOF, IN FOURE BOOKS 238–39 (London, Societie of Stationers 1627).

Institute on the Laws of England from 1720 to 1772,⁴⁸⁵ a book that practitioners often recommended to aspiring lawyers.⁴⁸⁶ Every treatise on the Court of Chancery to discuss whether the court was of record recognized the distinction as well.⁴⁸⁷

Copyright litigants understood that the “Courts of Record at Westminster” referred to in the Statute of Anne excluded the equity side of the Chancery, and that the statutory penalty was only available in the common-law courts. Describing the practice of the English courts in copyright cases, the counsel for Daniel Midwinter and others in a Scottish suit remarked in 1747 that the penalties under the statute were only recoverable “at Law.”⁴⁸⁸ Moreover, a decision in the same case in Scotland noted that “every action that can be commenced in pursuance of [the Statute of Anne] must go before the Courts of common law, and be determined by a jury.”⁴⁸⁹ Consistent with this understanding, Justice Willes stated in *Millar v. Taylor* in 1769, albeit with an agenda favoring a copyright at common law, that “a bill in Chancery is not given [by the statute]; and consequently could not be brought upon this Act.”⁴⁹⁰

We can also see this principle at work in *Tonson v. Baker*. As the demurrer demonstrates, Baker’s counsel Richard Shelley was fully aware of this limitation and hoped to be the first to make use of it in a case invoking the Statute of Anne. Shelley acknowledged that the statute imposed “certain penaltys” on persons who printed a book without the consent of the proprietor of the copyright.⁴⁹¹ He demurred to this relief, however, in large part because the

penaltys [are] by the same Act to be recovered in any of her
Majestys Courts of Record at Westminster by Action of Debt Bill

485. *E.g.*, 2 THOMAS WOOD, AN INSTITUTE OF THE LAWS OF ENGLAND 787, 792 (Savoy, Eliz. Nutt & R. Gosling 1720); WOOD, *supra* note 458, at 458, 460.

486. LEMMINGS, *supra* note 392, at 136–37, 341–42.

487. *E.g.*, HARDING GRANT, QUESTIONS AND ANSWERS ON THE PRACTICE OF THE COURT OF CHANCERY 1, 49–50 (London, A. Maxwell 1839); 2 HENRY MADDOCK, A TREATISE ON THE PRINCIPLES AND PRACTICE OF THE HIGH COURT OF CHANCERY 840 (London, J. & W.T. Clarke 3d ed. 1837); JOHN WYATT, THE PRACTICAL REGISTER IN CHANCERY 102 (London, A. Strahan 1800); ROGER ACHERLEY, THE JURISDICTION OF THE COURT OF CHANCERY AS A COURT OF EQUITY RESEARCHED 36 (London, Joel Stephens 3d ed. 1736); 2 JOHN LILLY, THE PRACTICAL REGISTER 607 (Savoy, E. Nutt & R. Gosling 1719); PRAXIS ALMAE CANCELLARIAE 46 (London, E. Wilkinson & A. Roper 1695).

488. PETITION FOR DANIEL MIDWINTER ET AL. 6 (1747), *reprinted in* THE LITERARY PROPERTY DEBATE: SEVEN TRACTS 1747–1773 (Stephen Parks ed., 1974).

489. *Midwinter v. Hamilton*, 2 Kam. Rem. 154, 161 (Sess. 1748).

490. *Millar v. Taylor*, 4 Burr. 2303, 2319 (K.B. 1769) (Willes, J.).

491. *Tonson v. Baker*, C9/371/41, m. 2, ll. 5–7 (Ch. 1710).

plaint or Information[.] And there is nothing in the said Act that gives this Honorable Court or any other Court of Equity a Cognisance of any thing done in breach thereof⁴⁹²

Notably, the statute that had previously governed copyrights, the Printing Act of 1662, expressly excluded the Chancery from the courts in which penalties could be recovered. The penalties were solely to be had “by Action of Debt Bill Plaint or Information in any of his Majesties Courts of Record held att Westminster called the Kings Bench Common Pleas or Exchequer.”⁴⁹³

The only case I know of in Chancery that awarded one of the statutory remedies—albeit not the penalties—was *Knaplock v. Curll* in 1722.⁴⁹⁴ There, the court decreed after a full hearing that the defendant was to present the infringing books to a master in ordinary so that the said “Master do see the same Damasked.”⁴⁹⁵ I have previously posited that insofar as this order was made pursuant to the Statute of Anne it was erroneous.⁴⁹⁶ But perhaps the court felt it was able to do so because, strictly read, the language of the statute only limited recovery of the *penalties* to courts of record. Or perhaps the court took solace in an earlier case involving a copyright by letters patent where the court had ordered the defendant’s infringing books damasked, though admittedly that had been done at the suggestion of the defendants.⁴⁹⁷ In any case, the order in *Knaplock* was an anomaly, and I have yet to find any similar order emanating from the Chancery in any other infringement case.⁴⁹⁸

It was not until 1843 that we learn of litigants arguing that a court of equity should be considered a court of record under the copyright statutes, but the Court of Chancery did not need to reach the question.⁴⁹⁹ The concept was then shaken in another context in 1846,⁵⁰⁰ and eventually it no longer mattered. In 1854, a statute empowered the common-law and equity courts with the powers normally reserved to the other, and in 1873–1875 the Judicature Acts abolished the Courts of Chancery, King’s Bench, Common Pleas, and Exchequer as separate institutions, and merged them into a single High

492. *Id.* at ll. 8–10.

493. Statute, 1662, 13 & 14 Car. 2, c. 33, § 5.

494. C33/339, f. 12^{r-v} (Ch. 1722).

495. *Id.*

496. Gómez-Arostegui, *supra* note 7, at 1268 n.395; cf. DEAZLEY, *supra* note 4, at 57–59.

497. *Hills v. Lee*, *sub nom.* *Hills v. Symons*, C33/261, f. 640^v (Ch. 1684). If in fact the court even knew of this order.

498. *Accord* *Tonson v. Collins*, 1 Black. W. 321, 329–30 (K.B. 1761).

499. *Colburn v. Simms*, 2 Hare 543, 558–59 (Ch. 1843).

500. *See* *Heming v. Swinnerton*, 1 Coop. t. Cott. 386, 413–18 (Ch. 1846); FRANCIS RUSSELL, A TREATISE ON THE POWER AND DUTY OF AN ARBITRATOR 57–58 (London, V. & R. Stevens et al. 2d ed. 1856); *see also* *Lister v. Lister*, 2 H & T.W. 174, 175–76 (Ch. 1850).

Court of Justice as the court of first instance in England.⁵⁰¹ These changes do not take away from the fact, however, that for the entire time the Statute of Anne was in effect, courts of equity were not “courts of record” within the meaning of the statute and therefore that the penalties had to go to a jury.



But what about U.S. copyright law? Looking back at the 1790 Copyright Act, we can see that the penalties under the Act were also only available by an action of debt in any “court of record.”⁵⁰² Yet, once again, the *Feltner* Court did not inquire whether the term excluded courts of equity. Had it done so, the Court would have discovered the answer to be more complicated on this side of the pond. The legislative history of the 1790 Act is meager, and it is unclear whether Congress intended the concept to differ from the English approach. Referring to federal courts generally, Justice Story stated in 1840 that they were all courts of record, regardless of whether sitting at law or in equity,⁵⁰³ but he offered no citation for his assertion and it can probably be best characterized as an extra-judicial fiat. Additionally, the general practices of the state courts c.1790, which were also permitted to hear claims under the 1790 Act,⁵⁰⁴ cannot be easily discerned today. With some exceptions,⁵⁰⁵ most state courts did not decide whether to treat their equity courts as being of record until the mid-19th century, at which time most said that they were.⁵⁰⁶ So in the end, one cannot really fault the Court for choosing to ignore the “court of record” language of the 1790 Act.



This doctrinal lesson, though of no consequence in a case that already reached the correct outcome, nevertheless demonstrates that courts and litigants must take history more seriously. It would be far too strong to call the outcome in *Feltner* dumb luck. But given the several errors in the Court’s

501. THEODORE PLUCKNETT, A CONCISE HISTORY OF THE COMMON LAW 211–12 (5th ed. 1956).

502. Act of May 31, 1790, ch. 15, § 2.

503. JOSEPH STORY, COMMENTARIES ON EQUITY PLEADINGS § 778, at 600 n.5 (Boston, Charles C. Little & James Brown 2d ed. 1840) (also recognizing that the rule differed in England).

504. 1 WILLIAM PATRY, PATRY ON COPYRIGHT § 1:22 (2009).

505. Tennessee made its equity courts “of record” by statute in 1787. See HENRY R. GIBSON, A TREATISE ON SUITS IN CHANCERY § 10, at 8–9 (Knoxville, Ogden Bros. & Co. 1891).

506. E.g., *Payne v. McCabe*, 37 Ark. 318, 321 (1881); *State v. Iron Cliffs County*, 20 N.W. 493, 522 (Mich. 1884); *Baylor’s Lessee v. Dejarnette*, 13 Gratt. 152, 173 (Va. 1856).

opinion, and the failure to recognize that equity courts in England were not “courts of record,” it seems fair to call the outcome fortuitous. Additionally, it bears repeating that the Court had reversed the Ninth Circuit Court of Appeals, which had, along with several other courts, concluded that statutory damages were equitable in nature and thus that the constitutional right to a jury did not attach.⁵⁰⁷ Those courts had little to no sense of the relevant history despite the fact the Supreme Court had held many years before that a historical inquiry was important to determining the right to a jury trial.⁵⁰⁸ Courts must demand more from litigants and of themselves. If they are not willing to do so, then courts must discard the historical inquiries altogether.

VI. CONCLUSION

I feel privileged to have had the opportunity to write about *Tonson v. Baker* 300 years after the suit was filed—an amazing coincidence indeed—and to have been able to demonstrate the doctrinal relevance of copyright history to modern cases. It is a testament to the wonderful work done by archivists in England and elsewhere that so many records survive relating to *Tonson* and the circumstances surrounding it. Though *Tonson* has been overlooked in the past due to its inaccessibility, I am hopeful that the case can now take its rightful place in the annals of copyright history.

VII. APPENDIX: TRANSCRIPTION OF DOCUMENTS

The following pages transcribe, in chronological order, the surviving records in *Tonson v. Baker* that were of any legal consequence. The second and third entries are from printed sources, but the remaining sources are all from manuscripts. I have transcribed every textual marking. I have silently expanded any contractions but otherwise left the spelling, capitalization, and punctuation (or lack thereof) unchanged. Interlineations are represented with two slash marks, e.g. \insert/, in the place where the scribe sought to insert the new text. Strikethroughs are represented as one would ~~expect~~. I have also separately numbered [in brackets] every line of principal text in the lengthier documents to improve our ability to refer to them. Additionally, I have inserted footnotes where appropriate to clarify points of interest.

507. *Columbia Pictures Television, Inc. v. Krypton Broad. of Birmingham, Inc.*, 106 F.3d 284, 293 (9th Cir. 1997) (citing cases), *rev'd*, 523 U.S. 340 (1998).

508. *E.g.*, *Curtis v. Loether*, 415 U.S. 189, 192–98 (1974).

[1]

**Minutes of the House of Lords, HL/PO/JO/5/1/45
Parliamentary Archives**

Adhuc 23^o Martij 1709[/10]

...

[Left margin]: L Chancellor to Print Tryall

House moved That the Tryall be printed & \published/ that the Lord Chancellor to give order therein

[2]

19 Journal of the House of Lords, p. 122

[23 March 1709/10]

[Left margin]: Doctor Sacheverel's Trial to be printed.

It is ORDERED, by the Lords Spiritual and Temporal in Parliament assembled, That the Lord High Chancellor of *Great Britain*, do give Order for the printing and publishing the Trial of *Henry Sacheverell* Doctor in Divinity; and that no other Person do presume to print the same; and further, that the last mentioned Resolution and Order agreed on this Day be printed at the End of the said Trial.

[3]

**The Tryal of Dr. Henry Sacheverell, Before the House of Peers, for
High Crimes and Misdemeanors sig. π 1^v (London, Jacob Tonson
1710)**

[n.d.]

In Pursuance of an Order of the House of PEERS, of the Twenty Third Day of *March* 1709/10, I do Appoint *Jacob Tonson* to Print the Tryal of Doctor *Henry Sacheverell*, and do Forbid any other Person to Print the same.

COWPER C.

[4]

**A Register of the Copies of Books, 1710 to 1746, p. 24
Archives of the Company of Stationers**

Shares May 15th 1710

Jacob Tonson	The Whole	Then entred for his Copy, a Book called The Whole proceedings, with the Speeches on both sides, at the Tryal of Dr
--------------	-----------	--

Henry Sacheverell, printed by order of the
House of Peers.

/s/ Jacob Tonson New⁵⁰⁹

[Right margin]: vj⁵¹⁰

[5]

A Register of the Copies of Books 1710 to 1746, p. 32
Archives of the Company of Stationers

	[Shares]	June 3d [1710]
Jacob Tonson	The whole	Then entred for his Copy, The Tryal of Dr Henry Sacheverell before the House of Peers, for High Crimes & Misdemeanors, upon an Impeachment, by the Knights, Citizens & Burgesses in Parliament assem'bled, in the Name of themselves, & of all the Commons of Great Britain: begun in Westminster Hall the 27th day of February 1709/10 & from thence continued by several adjournments until the 23d day of March following, Published by order of the House of Peers

/s/ Jacob Tonson

[Right margin]: vj

509. This signifies that the work was not previously published or registered.

510. This signifies that the Stationers' Company received six pence as a registration fee.

[6]
Bill of Complaint, C9/371/41, m. 1
The National Archives (TNA)

8^o Julij 1710

To the Right Honorable William Lord Cowper Baron of Wingham Lord high
Chancellor of Great Brittain

Suffeild⁵¹¹ 8 per 1726 (1)⁵¹²

^[1] Humbly Complaining sheweth unto Your Lordshipp your Orator Jacob Tonson of London Bookseller That on the Twenty third day of March last past Itt was Ordered by the ^[2] Lords Spirituall and Temporall in parliament Assembled That the Lord high Chancellor of Great Brittain doe give Order for the printing and publishing the Tryall of henry ^[3] Sacheverell Doctor in Divinity and that noe other person doe presume to print the same And that in pursueance of the said Order your Lordshipp was pleased to Order and ^[4] Appoint your \Orator/ to print the said Tryall of the said Doctor Henry Sacheverell and to forbid any other person to print the same And your Orator in pursueance of your Lordships ^[5] Order and Appointment did proceed to print or cause to be printed very Considerable Quantities and Numbers of the said Tryall which cost your Orator very Considerable Summes of ^[6] money And your Orator before the said Tryall was published entered the Title of the said Tryall of the said Doctor Henry Sacheverell in the Register book of the Company ^[7] of Stationers of London According to the late Act of parliament Intituled an Act for Encouragement of Learning by vesting the Coppys of printed bookes in the Authors ^[8] or purchasers of such Coppys dureing the times therein menconed And thereby and by Virtue of your Lordships said Order and Appointment your Orator is possessed of ^[9] interested in and Intituled to the said Tryall and has the Sole Right and Liberty of printing of the said Tryall for the Terme of ffourteen yeares to Comence from ^[10] the time of the first publication thereof which was the ffifth day of June last past And your Orator well hoped noe other person would have Attempted to print or ^[11] Reprint the same But now soe it is may it please your Lordshipp that John Baker of London Bookseller \John How of London printer & Henry Hills of London Printer/ Combineing and Confederating \together &/ with diverse persons at present ^[12] to your

511. John Suffeild was the Six Clerk in Chancery chosen by Jacob Tonson's counsel.

512. This is a contemporary cataloging reference. Each set of pleadings in the C9/371 bundle contains a similar reference, with the set number appearing in the parenthesis (*n*).

Orator unknown whom when their names are discovered your Orator prayes may be added partyes to this Bill with Apt words to Charge them and every of them ^[13] to defeat and defraud your Orator of the benefit and Right of printing and reprinting the said Tryall and of the profitt and Advantage to be made thereby and by ^[14] selling vending and disposeing of the same he the said Baker and his Confederates or some or one of them without the leave privity or Consent of your Orator have ^[15] or hath lately printed or Caused to be printed in some other place or places in or about the City of London or elsewhere many hundred or other Great Quantities and ^[16] Numbers of the said Tryall in Smaller Character or print than those printed for your Orator or else he the said John Baker \John Howe & Henry Mills [*sic*]/ and their⁵¹³ Confederates some or one of them ^[17] did by him and themselves and their Agents or Correspondents give Order and Direction for the printing Causeing or procureing to be printed the said Tryall in some ^[18] place or places beyond the Seas and for paying the Charges thereof or of some part thereof And for Importing great Numbers of printed Coppyes of the said Tryall ^[19] into England which have been accordingly imported in his or their name or names or in the name or names of his or their Correspondents some or one of them or in some false or ^[20] fictitious name or names but for to the use and upon the Account of the said John Baker \John How & Henry Hills/ and their Confederates some or one of them And the said John Baker \John How & Henry Hills/ and their Confederates ^[21] have uttered published sold Exchanged disposed of and Exposed to sale or threaten or intend to utter sell Exchange dispose off and Expose to sale great Quantities and Number of ^[22] Coppyes of the said Tryall soe by them some or one of them printed or imported without your Orators leave or Consent and in Order to elude and Evade the said Act of ^[23] parliament and the fforfeitures and penalytes therein Contained and to Spoil and hinder the sale of the said Tryall printed by and for your Orator they have called the said ^[24] book by them soe printed or imported published uttered sold and Exposed to sale a Compleat History of the whole proceeding of the parliament of Great Brittain against ^[25] Doctor Henry Sacheverell with his Tryall before the house of peers for high Crimes and Misdemeanors the Reasons of those Lords that entred their protests and the ^[26] Speeches of Severall Lords before Judgment was given London printed and sold by J. Baker at the Black boy in pater noster Row One thousand seven hundred and ^[27] tenn and have caused Some little variacion or Difference tho not materiall in every Sheet of the book soe

513. Though not apparent from my transcription, the possessive pronouns used to refer to the defendants were changed. Pronouns referring to one defendant (e.g., his) were rubbed out and replaced with plurals (e.g., their).

by them printed or imported uttered sold and Exposed to ^[28] Sale from the Tryall printed by and for your Orator and have Caused Some immateriall imperfect and ffalse Addicions to be made thereto but such book is the ^[29] Same in Substance & Effect as that printed by and for your Orator as aforesaid and Coppied out of one of the printed Coppies thereof printed by and for your Orator ^[30] and only Some words transposed ~ and misplaced on purpose to Elude and Evade the said Act of parliament And what Alterations and Addicions there are made ^[31] thereto are false and Erroneous and doe misrepresent many of the proceedings at the said Tryall And by such Management practice and Contrivance they have much ^[32] hindred the Sale of the said Tryall printed by and for your Orator which is a very great Detriment and Injury to him he haveing been at great Expence and Charges ^[33] in printing the Same Correctly All which Actings and doeings of the said John Baker \John How & Henry Mills [*sic*]/ and ~~the Rest~~ their Confederates are Contrary to all Justice Equity and good ^[34] Conscience and tend to your Orators manifest wrong and Injury In Tender Consideracion whereof and for as much as your Orator can't prevent or hinder the ^[35] printing uttering selling disposeing distributeing & Exposeing to Sale the said book and is Intirely remedillesse in the premisses Save by the Aid and Assistance of your ^[36] Lordshipp in this Honorable Court To the End therefore that the said John Baker \John How & Henry Mills [*sic*]/ and their Confederates when discovered may upon their Severall Corporall Oathes true ^[37] perfect and distinct answer make to all and Singular the premisses as fully plainly and particularly as if the Same were herein over again ~~~⁵¹⁴ repeated and ^[38] Interrogated And that they and their Agents Servants and Accomplices may by the Injuncion of this Honorable Court be Enjoyned and prohibited from printing reprinting ^[39] or importing uttering Selling disposeing distributing Exchangeing and Exposeing to Sale the said book Intituled a Compleat History of the Whole proceedings of the ^[40] parliament of Great Brittain against Doctor Henry Sacheverell with his Tryall before the house of peers for High Crimes and misdemeanors the Reasons of those Lords ^[41] that entred their protest and the Speeches of Severall Lords before Judgment was given London printed and Sold by J. Baker at the Black boy in pater noster Row ^[42] One thousand seven hundred and tenn or any Copsy thereof or of the said Tryall of the said Doctor Henry Sacheverell or any other book or bookes being or ^[43] purporting to be the Same in Substance Sheet or Sheets part or parts of the said Tryall printed or imported or to be printed or imported within the said ^[44] Term of ffourteen yeares without the leive

514. Stricken text illegible.

licence or Consent of your Orator And that your Orator may have Such further and other releif in the premisses as the nature ^[45] of his [*sic*] Case requires and as is Agreeable to Equity and good Conscience May it please Your Lordshipp to grant unto your Orator her Majesties most gracious Writt ^[46] \or Writts/ of Subpoena to be directed to the said John Baker \John Howe & Henry Mills [*sic*]/ thereby Comanding them at a Certain day and under a Certain pain therein to be limitedt personally to be and appear ^[47] before your Lordshipp in this Honorable Court then and there to Answer all and Singular the premisses and further to stand to and abide such further order and ^[48] Decree of this Honorable Court as to your Lordshipp shall seem meett And your Orator shall ever pray &c

Marshall⁵¹⁵/s/ Marmaduke Horsley⁵¹⁶

[7]

Bill Booke Anno 1710, TNA IND1/2149

Termino Trin 1710

...

Suff:Marshall Tonson contra Baker & alios Immediate⁵¹⁷

[8]

Hearing on Temporary Restraining Order, TNA C37/860, ff. 1^r, 2^r[1^r]Martis 11^o Die Julij 1710

Lord Chancellor

Second General Seal

Mr Keck⁵¹⁸

after

Sr Richard Holford⁵¹⁹

Trinity Terme

1710

...

515. Marshall (first name unknown) was a Sworn Clerk within John Suffeild's Six Clerks division and was the person who actually accepted the filing of the bill of complaint. Marshall is also named in the relevant bill book, as is noted in the document that follows.

516. Marmaduke Horsley was Jacob Tonson's solicitor.

517. This signifies that the subpoena ad respondendum was returnable immediately and therefore that the subpoenaed defendants lived in London or within ten miles of it.

518. Samuel Keck was a Master in Ordinary.

519. Richard Holford was another Master in Ordinary.

[2^r]

Tonson } Mr Srt Jekyll⁵²⁰ pro Querente moves for an Injuncon
 Baker } to stay their Printing Dr Sacheverells
 Tryall

Cur move this before the Master of Rolls

[9]

Hearing on Temporary Restraining Order, TNA C37/860, f. 7^r

[Martis 11^o Die Julij 1710]

[Master of the Rolls]⁵²¹

Tonson } Cowper⁵²² pro Querente moves for an Injuncon
 Baker } to stay the Defts printing Dr Sacheverells
 Tryall wee are appointed to print
 it by Order of House of Lords
 Mr Srt Jekyll pro Querente Vernon⁵²³
 Affidavit of Jacob Tonson read
 The Order of the House of Peers read
 Cur take an Injuncon

[10]

Temporary Restraining Order, TNA C33/314, f. 375^v

Martis 11 Julij [1710]

[Left margin]: T—⁵²⁴
 MR⁵²⁵
 Keck
 Holford

Jacobus Tonson Querente Johannes Baker Johannes }
 How & Henricus Hills Defendants }

520. Sir Joseph Jekyll served as the lead barrister for Jacob Tonson on this motion.

521. The Master of the Rolls was John Trevor.

522. Spencer Cowper served as the second barrister on this motion.

523. Thomas Vernon appears to have stood pro forma but did not argue.

524. This signifies that the surname of the first named plaintiff begins with the letter T.

525. Master of the Rolls.

^[1] Upon Opening of the mattre this present day unto this Court ^[2] by Mr Serjeant Jekylls & Mr Cowper being of the plaintiffs Councell ^[3] Itt was alleadged that on the 23th [*sic*] of March last Itt was ordered by the Lords Spirituall & ^[4] Temperall in Parliament assembled That the Lord Chancellor &c should give order for the printing the ^[5] Tryall of Doctor Henry Sacheverell and that noe other person should presume to print the same that ^[6] in persuance of such order the Lord Chancellor was pleased to appoint the plaintiff to print the said Tryall ^[7] and that noe other person should presume to print the same that the plaintiff persuant to that order did at ^[8] very great expence print considerable numbers of the said Tryall and before the same was ^[9] published entred the title of in the Register booke of the Company of Stationers according to the ^[10] late Act of Parliament for encouraging of learning \&c/ and thereby became intitled to the sole \right of/ ^[11] Printing the said Tryall for fourteen yeares but the Defendants without the plaintiffs leave or privity ^[12] have lately printed & sold great number of \a/ Bookes intitled a Compleat History of the whole ^[13] proceedings of the Parliament of great Brittain against Doctor Henry Sacheverell with his Tryall ^[14] before the house of Peers for high Crimes & Misdemeanors the reasons of those Lords that entred their ^[15] \Protests/ Lords that entred their protests [*sic*] and the speches of severall Lords before Judgment was given printed for ^[16] the Defendant Baker & which booke is the very same in Substance with very little difference or variation ^[17] from the tryall of Doctor Henry Sacheverell printed by the plaintiff as by Affidavit appears and is a great ^[18] hindrance to the Sale of the tryall printed by the plaintiff for releife wherein the plaintiff has exhibited his Bill ^[19] into this Court as by Certificate appears and therefore Itt was prayed That an Injuncion may be awarded ^[20] against the said Defendants to enjoine them their Agents & Workmen from printing or exposing to Sale ^[21] any of the said Booke intitled a Compleat History of the whole proceedings of the parliament of ^[22] Great Brittain against Doctor Henry Sacheverell with his Tryall before the house of Peers for high ^[23] Crimes & Misdemeanors the reasons of those Lords that entred their protests and the speches of ^[24] Severall Lords before Judgment was given printed for the Defendant Baker untill the said Defendants shall answer ^[25] the plaintiffs Bill and this Court take other order to the Contrary which this Court held reasonable & doth order the same accordingly/

EG⁵²⁶

526. Edward Goldsbrough was a deputy to Thomas Lord Jermyn, the Registrar of the Court of Chancery, and was the person who entered this order in the register book.

[11]

A Register of the Copies of Books 1710 to 1746, p. 48
Archives of the Company of Stationers

Shares July 12th 1710

John Baker	The Whole	Then entred for his Copy, a Book called A compleat History of the whole Proceedings of the Parliament of Great Britain against Dr Henry Sacheverell; with his Tryal before the house of Peers for High Crimes, & Misdemeanor, the Reasons of those Lords that entred their Protests, & the Speeches of several Lords before Judgment was given.
------------	-----------	---

Received .9.⁵²⁷ New

/s/ John Baker

[Right margin]: vj

[12]

Demurrer, TNA C9/371/41, m. 2

[15 July 1710]

Highlord⁵²⁸

The severall Demurrer of John Baker one of the Defendants to the Bill of Complaint of Jacob Tonson Complainant

^[1] This Defendant by protestation not acknowledging or confessing all or any the Matters and things in the said Bill contained to be true ^[2] in such sort manner and fforme as the same are therein and thereby sett forth and alleadged Doth demurr in Law thereto and to all ^[3] Discovery and Releif thereby sought And for Cause of such his Demurrer saith That by the Act of parliament in the Bill mentioned ^[4] and whereby the Complainant claimes title to the Tryall in the same Bill mentioned and to the sole Right and Liberty of printing ^[5] the same for the terme of fourteen years in the Bill likewise mentioned certain penaltys in the same Act mentioned are imposed ^[6] on such person or persons as shall print or reprint or cause to be printed

527. This signifies that the Stationers' Company received nine copies of the book for deposit as required by the Statute of Anne.

528. John Highlord was the Six Clerk in Chancery who was assigned to John Baker.

or reprinted published or exposed to Sale any Book without ^[7] the Consent of such person or persons as is or are the proprietor or proprietors thereof according to the same Act the ^[8] pecuniary part of which penaltys is by the same Act to be recovered in any of her Majestys Courts of Record at Westminster by ^[9] Accion of Debt Bill plaint or Information And there is nothing in the said Act that gives this Honorable Court or any ^[10] other Court of Equity a Cognisance of any thing done in breach thereof Nor ought this Defendant in a Court of Equity ^[11] to \be obliged to/ discover whether he has been guilty of any offence against a penal Statute But whether he has been guilty of any offence ^[12] against the said Act of parliament is only inquireable and determinable in a Court of Law and not in a Court of ^[13] Equity And as to the order of the House of Lords in the Bill mentioned The only question founded upon that must be ^[14] whether this Defendant has been guilty of a breach or Contempt of that Order which is a thing inquireable and ^[15] determinable not in and by this Honorable Court but only in and by the House of Lords who made that Order And all ^[16] the discovery sought by the Bill is only whether this Defendant and the other Defendants in the Bill named or any of ^[17] them have or hath been guilty of a breach of the said Act of parliament or of the said Order of the House of Lords ^[18] neither of which are or is examinable \determinable/ cognizable or relievable in this Honorable Court The which and for many ^[19] other Errors Defects and Insufficiencies of and in the said Bill this Defendant doth demurr in Law thereto and to the ^[20] discovery \& releife/ thereby sought And humbly prays the Judgement of this Honorable Court thereupon and to be hence dismissed ^[21] with his Costs.

Birk: Cheveley⁵²⁹ /s/ Richard Shelley⁵³⁰

529. The first name is probably John Birkhead who was a Sworn Clerk working within John Highlord's Six Clerks division. The second name is Jerningham Cheveley who at the time was either a waiting clerk working under Birkhead, or was already a Sworn Clerk, and would have been the one to physically accept the filing of the demurrer. Cheveley, "of the six clerks office," was later admitted to Lincoln's Inn. *See* 1 RECORDS OF THE HONORABLE SOCIETY OF LINCOLN'S INN, *supra* note 376, at 383 (Feb. 1718/9). Cheveley is also named in Highlord's cause book, as can be seen in the Appendix item that follows this one.

530. Richard Shelley was Baker's solicitor in Chancery.

[13]**Highlord and Pollexfen Six Clerk Cause Book, TNA IND1/4163**

Termino Sancti Trinitatis Anno Domini 1710

...

Suff Marshall

Chevely Jacob Tonson q. Johannes Baker Def mor:⁵³¹ 15 July 1710

...

[14]**IFP Certification, TNA C33/314, f. 421^v**

Lunae 17 Julij [1710]

[Left margin]: T+⁵³²
pauper

Jacobus Tonson Querente Johannes Baker Defendant The Defendant in respect of poverty whereof Affidavit is made this day admitted by the right Honorable the Master of the Rolles to defend this Suite in forma pauperis and Mr Mead⁵³³ & Mr Shelley are assigned for his Councill & Mr Highlord for his Sixe Clerke RP⁵³⁴

531. Moratur in lege (demurrer). Thanks to Hamilton Bryson for deciphering this abbreviation.

532. This signifies that the surname of the first named plaintiff begins with the letter T.

533. Samuel Mead was Baker's barrister.

534. Richard Price was also a deputy to the Registrar of the Court of Chancery and was the person who entered this order in the register book.

ALL CHANGE FOR THE DIGITAL ECONOMY: COPYRIGHT AND BUSINESS MODELS IN THE EARLY EIGHTEENTH CENTURY

Isabella Alexander[†]

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I. INTRODUCTION: ANALOGUE AND DIGITAL WORLDS

In 1998, the United States Congress labelled the current era the “digital millennium” when it passed a copyright act of that title.¹ Eleven years later, the United Kingdom echoed that language when the Department for Culture, Media and Sport published the Digital Britain Report in June 2009.² The Report examines the country’s communications infrastructure, public sector broadcasting, broadband access and take-up. It also addresses the effect of digitization on the “creative content industries,” wherein lies its specific relevance to the law of copyright. In light of the Report, the

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† Newton Trust Lecturer in Law, University of Cambridge, Beachcroft LLP Fellow in Law and Director of Studies in Law, Robinson College, Cambridge. All errors are of course my own, but I am grateful to H. Tomás Gómez-Arostegui for advice and assistance in researching the eighteenth century material, as well as helpful comments on the draft.

1. Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998).

2. DEP’T FOR CULTURE, MEDIA & SPORT & DEP’T FOR BUS. INNOVATION & SKILLS, DIGITAL BRITAIN FINAL REPORT, Cm 7650 (2009) [hereinafter DIGITAL BRITAIN FINAL REPORT], *available at* <http://www.culture.gov.uk/images/publications/digitalbritain-final-report-jun09.pdf>.

Government introduced the Digital Economy Bill, which passed into law in April 2010, just days before Parliament was dissolved in preparation for the next General Election.³

The Digital Britain Report opens with an “inspirational” quote from the then British Prime Minister, Gordon Brown: “Only a Digital Britain can unlock the imagination and creativity that will secure for us and our children the highly skilled jobs of the future.”⁴ Where the Prime Minister looked forwards, Lord Carter’s⁵ foreword to the Report looked backwards, beginning with an historical comparison:

On 26 August 1768, when Captain James Cook set sail for Australia, it took 2 years and 320 days before he returned to describe what he found there.

Yesterday, on 15 June 2009, 20 hours of new content were posted on YouTube every minute, 494 exabytes of information were transferred seamlessly across the globe, over 2.6 billion mobile minutes were exchanged across Europe, and millions of enquiries were made using a Google algorithm.⁶

In the analogue world, information traveled slowly and was dependent on physical means of transport and human agents; in the digital world, it moves instantaneously, through wires, sea beds and air waves. The scope of the technological changes can hardly be over-emphasised, but their impact on copyright laws requires further investigation. The assumption frequently made, by legislators and others, is that this brave new digital world requires brave new copyright laws, because the terrain has shifted and the parties involved have changed.

In his recent book, *Moral Panics and the Copyright Wars*,⁷ William Patry advances the thesis that the debates over copyright (or “copyright wars,” as he evocatively calls them) are essentially the product of outdated business models being threatened by innovators. The success of these innovators, he argues, is resented by the established copyright industries, which then turn to the courts and the legislature⁸ to seek protection against the newcomers. Patry focuses on litigation as a means of protection, considering it “a poor

3. Digital Economy Act, 2010, c. 24 (U.K.).

4. DIGITAL BRITAIN FINAL REPORT, *supra* note 2, at 7.

5. Lord Carter is the former Minister for Communications, Technology and Broadcasting.

6. DIGITAL BRITAIN FINAL REPORT, *supra* note 2, at 3.

7. WILLIAM F. PATRY, *MORAL PANICS AND THE COPYRIGHT WARS* (2009).

8. For more on the role played by interest groups and the legislature in the last century, see JESSICA LITMAN, *DIGITAL COPYRIGHT* (2001).

long-term strategy, serving only to delay the inevitable failure of the old business model.”⁹ Patry notes that the Copyright Wars began in the United Kingdom with the Battle of the Booksellers in the 1730s and finished in 1774. The Wars presumably ended with *Donaldson v. Becket*,¹⁰ the landmark decision of the House of Lords which rejected the existence of a common law copyright and asserted the primacy of the Statute of Anne. However, Patry’s central concern is with the most recent fifty or so years, and, his implicit assumption is that this is a new, or at least a much more serious problem, today. Citing statements made by Lord Macaulay in 1841, he calls for a return to the “correct” and fundamental purpose of copyright law, which is to further the interests of the public.¹¹

The purpose of this Article is to argue that, in fact, this struggle between competing economic interests and different business models has existed since before the Statute of Anne was passed. Contrary to Patry’s argument, this tension is not a new aspect of copyright law or litigation. Likewise, contrary to the assumptions of legislators and policy-makers, technological change has not altered the fact that copyright law is a site of contest between market incumbents and new entrants. Rather, technological change has merely created new opportunities for the latter and threats to the former. However, the object of this Article is not to critique Patry’s thesis, but to extend it backwards to an earlier time period. By taking a very small slice of copyright’s history, I want to examine some of the ways that these “battles” were conducted at the birth of copyright and in its infant years. Cases brought before the Court of Chancery in the early to mid-eighteenth century reveal the ways in which those with vested interests in the established system of regulating the market for printed books sought to use the law as a tool to attack new market entrants. While use of the law to attack new market entrants might be seen as unfortunate, it is important to recognize that it is a constant element in the development of copyright law that continues to the present day. This, in turn, should lead us to be wary of claims that legislation introduced to address perceived problems raised by new technologies (and lobbied for by those with interests in furthering or suppressing such technology) will provide simple solutions or produce more coherent copyright laws. Before turning to consider these cases, it is useful to consider the social and economic background against which they arose.

9. PATRY, *supra* note 7, at 2.

10. *Donaldson v. Beckett*, [1774] 1 Eng. Rep. 837 (H.L.).

11. PATRY, *supra* note 7, at 37.

II. THE ECONOMY AND THE BOOK TRADE IN THE EIGHTEENTH CENTURY

Like the twenty-first century, the eighteenth century was a period of great social and economic change for Britain. Demographic change began slowly. At the start of the century the population was static at slightly over six million; by 1756 it had risen to a little over five million (17% in sixty years); in the following fifteen years it grew another 15%, and from 1791 through the first three decades of the nineteenth century it grew at a rate of 1.32% per year (compared with 0.2% between 1681–1741).¹² As Michael Suarez has pointed out, in book trade terms, this meant that the number of potential buyers for books was increasing six times faster in the early nineteenth century than at the start of the eighteenth century.¹³ The population growth was accompanied by equally remarkable economic growth. Between 1680 and 1820, the British Gross Domestic Product rose approximately 246%.¹⁴ During a similar period, 1700 to 1830, literacy rates also steadily increased. Accounting for population growth, by 1830 the adult reading public had grown by 234.8%.¹⁵

Other factors also stimulated the growth of the book market during this period. Foremost amongst these were improvements in transport networks. Overland transport became faster, cheaper, and more reliable due to improvements in road quality, coach and wagon design and the breeding of more reliable horses. London booksellers could supply the provinces faster and more effectively, lowering transaction costs and possibly assisting in making credit arrangements more reliable. Although the railways did not begin their march across the countryside until the early nineteenth century, canals and other navigable waterways became important elements of transport infrastructure in the mid-eighteenth century.¹⁶

The improvement in transport networks directly affected the growth of the Post Office, which expanded considerably during the century. Improved delivery networks and faster mail coaches assisted in distribution throughout the countryside. Moreover, the franking system provided further incentives for distribution.¹⁷ The Six Clerks of the Road had franking privileges and

12. Michael F. Suarez, *Introduction* to *THE CAMBRIDGE HISTORY OF THE BOOK IN BRITAIN VOLUME V: 1695–1830*, at 1, 3 (Michael F. Suarez S.J. & Michael L. Turner eds., 2009).

13. *Id.* at 3–4.

14. *Id.* at 4.

15. *Id.* at 12.

16. *Id.* at 12–15.

17. The franking system allowed post to be sent for free. *See id.* at 15–16.

could therefore send newspapers for free to provincial postmasters who paid them and were, in turn, allowed to sell or circulate newspapers for their own gain.¹⁸ Other networks of distribution included chapmen (itinerant sellers of cheap books),¹⁹ religious groups, and the popular and ubiquitous coffee-houses, where men would gather to discuss news, business, and politics, as well as to purchase and exchange books.²⁰

Prior to the late seventeenth century, only the wealthiest could afford to spend money regularly on the purchase of such luxury items as books. However, book possession and collection in personal and domestic libraries increased during the 1690s, and even more so after the 1740s. Demand grew fastest amongst the middling classes.²¹ Despite the fact that there were no major technological developments in printing until the early decades of the nineteenth century, the scale of production of books increased exponentially over the eighteenth century. Fairly crude estimates indicate that publications grew annually by about 2% per annum from 1740 to 1800.²² Moreover, the second half of the eighteenth century saw a remarkable growth in conspicuous consumption, and print played a significant role in the creation of this “consumer society.”²³ Not only did books promote consumerism through printed advertisements of consumer goods, but books themselves became desired commodities and ornaments. James Raven contends that during this period, books began to be treated as market commodities by both traders and buyers.²⁴ Historians have observed that the eighteenth century heralded a “consumer revolution.”²⁵ It was not the desire to spend that was new, but the ability to do so.²⁶ The effects on the book trade were significant, and it is not hard to see parallels with the effects of the new technologies of the late twentieth century on the print media of today.

18. *Id.*

19. *Id.* at 18.

20. *Id.* at 18–24.

21. James Raven, *The Book as a Commodity*, in *THE CAMBRIDGE HISTORY OF THE BOOK IN BRITAIN: VOLUME V, 1695–1830*, at 85, 86 (Michael F. Suarez, S.J. & Michael L. Turner eds., 2009).

22. Before 1700, about 1,800 titles were produced annually; by 1830 it was up to 6000. *Id.* at 92.

23. See *THE BIRTH OF A CONSUMER SOCIETY: THE COMMERCIALIZATION OF EIGHTEENTH-CENTURY ENGLAND* (Neil McKendrick, John Brewer & John Harold Plumb eds., 1983).

24. Raven, *supra* note 21, at 85.

25. Neil McKendrick, *Introduction* to *THE BIRTH OF A CONSUMER SOCIETY: THE COMMERCIALIZATION OF EIGHTEENTH-CENTURY ENGLAND 2* (Neil McKendrick, John Brewer & John Harold Plumb eds., 1983).

26. *Id.* at 2.

As new sections of the population became increasingly able and willing to purchase books, new markets opened up for the print trade. How did the booksellers react to this transformation of their familiar world? To answer this question, it is necessary to take a brief excursion back to 1695 and the final lapse of the Licensing Act of 1662.

III. THE PASSAGE OF THE STATUTE OF ANNE AND CHANGES IN ECONOMIC CONTROL OF THE BOOK TRADE

Events occurring in the late seventeenth century and early eighteenth century brought about substantial changes in the control of the book trade in Britain. Prior to 1695, printing had been regulated by the mutually advantageous relationship between the Stationers' Company, a London guild, and the Crown.²⁷ The Crown's objective was to control print media and, in so doing, control political and religious dissent.²⁸ The Stationers' Company's objective was to regulate the trade and concentrate power among its members.²⁹

The two objectives were enforced by numerous legislative instruments, including decrees of the Star Chamber. In 1662, Charles II's Restoration Parliament passed a Licensing Act which, like the Star Chamber decrees, provided for pre-publication censorship.³⁰ This Act shored up the position of the Stationers' Company in the trade, by providing that: all books had to be entered in the Company's register,³¹ that only members of the Company could enter the book trade,³² that no printing presses could operate without permission of the Company,³³ that the number of master printers, presses and apprentices and other employees would be restricted,³⁴ and that the Stationers' Company had the power to carry out searches of premises suspected of housing unauthorized printing and binding.³⁵ Parliament

27. See Michael Treadwell, *The Stationers and the Printing Acts at the End of the Seventeenth Century*, in *THE CAMBRIDGE HISTORY OF THE BOOK IN BRITAIN: VOLUME IV, 1557–1695*, at 755, 756 (John Barnard & D.F. Mackenzie eds., 2002).

28. *Id.*

29. *Id.*

30. Licensing of the Press Act, 1662, 3 & 4 Car. 2, c. 33 (Eng.).

31. *Id.* § 3.

32. *Id.* § 8.

33. *Id.* § 10.

34. *Id.* §§ 11–13.

35. *Id.* § 14.

renewed the Act several times before William III's second Parliament allowed it to lapse in 1695.³⁶

The Stationers' Company lobbied for new legislation to protect their interests, but made little progress.³⁷ One significant source of opposition flowed from a general and widespread distrust of monopolies. By the time of James I, the royal use of monopolies had become one of Parliament's main grievances.³⁸ This distrust was intensified in the first two decades of the seventeenth century, when the economy sank into a deep recession that many blamed on patents and monopolies.³⁹ In 1624, Parliament passed the Statute of Monopolies, which declared patents void but made exceptions for inventions and printing.⁴⁰ Notwithstanding this measure, anti-monopoly feeling extended to the book trade. A temporary financial downturn in the 1690s intensified concerns that the Stationers' Company was abusing its power through the use of State-granted patents.⁴¹ A group of independent booksellers, printers and bookbinders presented a petition to Parliament in February 1693, complaining that the Act prevented them from exercising their trades.⁴² Thus, while the Stationers may have been lobbying for legislation to protect their interests after 1695, other members of the book trade were clearly less favorably disposed to the Licensing Act's renewal.⁴³

The lapse of the Licensing Act in 1695 is sometimes presented as giving birth to the "public domain"—a halcyon period when all were "free to do with the work as they wished."⁴⁴ However, this view overlooks the practical operation of the book trade at the time, and the strength of the non-statutory

36. See Ronan Deazley, *Commentary on the Licensing Act 1662*, in PRIMARY SOURCES ON COPYRIGHT (1450–1900) (L. Bently & M. Kretschmer eds., 2008), available at [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabeCom/"uk_1662"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabeCom/).

37. RONAN DEAZLEY, ON THE ORIGIN OF THE RIGHT TO COPY: CHARTING THE MOVEMENT OF COPYRIGHT LAW IN THE EIGHTEENTH CENTURY (1695–1774), at 1–30 (2004).

38. MARK KISHLANSKY, A MONARCHY TRANSFORMED: BRITAIN 1603–1714, at 98–99 (1996).

39. *Id.* at 99.

40. Statute of Monopolies, 1623, 21 Jac. 1, c. 3 (Eng.). For more on the role of monopolies, see Oren Bracha, *Owning Ideas: A History of Anglo-American Intellectual Property* (June, 2005) (S.J.D. dissertation, Harvard Law School), available at <http://www.obracha.net/oi/oi.htm>.

41. JAMES RAVEN, THE BUSINESS OF BOOKS: BOOKSELLERS AND THE ENGLISH BOOK TRADE 1450–1850, at 86 (2007).

42. Raymond Astbury, *The Renewal of the Licensing Act in 1693 and its Lapse in 1695*, 33 LIBR. 296, 301 (1978).

43. Treadwell, *supra* note 27, at 770.

44. RONAN DEAZLEY, RETHINKING COPYRIGHT: HISTORY, THEORY, LANGUAGE 162 (2006).

mechanism that shored up the booksellers' monopolies. While the lapse of the Licensing Act may have further eroded the power of the Stationers' Company, there was no sudden throwing open of the gates of culture and learning. Instead, a new structure emerged, replacing the established authority of the Stationers' Company. This system was based on a form of trade organization known as "congers."⁴⁵ A contemporary definition of a conger was "a Set or Knot of Topping Book-Sellers of London who agree . . . that whoever of them Buys a good Copy, the rest are to take off such a particular number . . . in Quires, on easy Terms."⁴⁶ In other words, the leading London booksellers would meet to discuss problems and further projects for the book trade, including the purchase and ownership of the most valuable copyrights, which they would then own cooperatively in shares.⁴⁷

The congers were a response to changes in the book trade, particularly to the uncertainty over its future regulation.⁴⁸ Conger membership overlapped significantly with the senior ranks of the Stationers' Company, demonstrating that although the organizational power base may have changed, those holding the power had not.⁴⁹ Because ownership of copyrights and books was shared between conger members, there would be fifteen or sixteen victims if a conger work was pirated.⁵⁰ The conger could then retaliate by refusing to supply the pirate with books or purchase from him. These actions

45. The word "conger" is sometimes claimed to derive from the conger eel, which swallowed up all the smaller fish. A. S. COLLINS, *AUTHORSHIP IN THE DAYS OF JOHNSON: BEING A STUDY OF THE RELATION BETWEEN AUTHOR, PATRON, PUBLISHER AND PUBLIC, 1726-1780*, at 19 (1927) (quoting the late seventeenth and early eighteenth century bookseller John Nichols). More recent commentators suggest it is more likely to derive from the word "conjure," or sworn agreement, of the kind which guilds had used to preserve their "mysteries" or trade secrets. WILLIAM ST CLAIR, *THE READING NATION IN THE ROMANTIC PERIOD* 95 (2004).

46. NORMA HODGSON & CYRIAN BLAGDEN, *THE NOTEBOOK OF THOMAS BENET AND HENRY CLEMENTS (1686-1719): WITH SOME ASPECTS OF BOOK TRADE PRACTICE* 67, 76, 86 (1956).

47. *Id.* at 67-68.

48. *Id.* at 76-77. Booksellers were not alone in seeking to manage trade instability in this period. Other industries were also developing risk sharing schemes, such as simple insurance against fire and marine disasters, and joint stock companies were also appearing on the scene. *See* Treadwell, *supra* note 27, at 773-74.

49. This is revealed by an examination of the dates upon which the various members became free of the Stationers' Company (indicating their seniority), given in HODGSON & BLAGDEN, *supra* note 46, app. 12, at 215, as well as by comparing these lists of conger members with the lists of the Masters and Wardens of the Stationers' Company in D.F. MCKENZIE, *STATIONERS' COMPANY APPRENTICES 1701-1800*, at 403-05 (1978). However, it is also the case that the precise history of the congers and their membership remains somewhat uncertain and incomplete. *See* HODGSON & BLAGDEN, *supra* note 46, at 80-100.

50. *Id.* at 77.

could cause considerable damage to an individual business, and possibly even close it down.⁵¹ Congers also provided other benefits to their members. Given the high risk levels associated with printing ventures, due to factors such as the costliness of paper and lack of market awareness, the system of shared ownership practiced by the congers was effective in spreading and minimizing the risk to participants.⁵² Additionally, congers helped to create stability in the book trade by controlling prices.⁵³

Although the congers gave the leading booksellers economic control over the London book trade, they had less control over provincial piracy, or the importation of reprints printed in Continental Europe. The booksellers therefore continued to lobby Parliament for new legislation, emphasizing trade regulation rather than censorship.⁵⁴ In 1710, their efforts were rewarded by the passing of an Act that famously became known as the Statute of Anne.⁵⁵ The main features of this Act were to: sever the relationship between censorship and trade regulation, by only concerning itself with the latter; to open up the trade to non-members of the Stationers' Company by providing that *anyone* could print a book;⁵⁶ to provide that books were to be registered at the Stationers' Company, but that the clerk could not refuse to register any title;⁵⁷ and to mandate that copies of all published books had to be delivered to certain libraries.⁵⁸ Most significantly, it limited the periods of protection for such printed books to fourteen years, plus another fourteen years if the author should still be living at the expiry of the first period.⁵⁹ The statute thus revolutionized the legal conditions under which the booksellers operated.

However, while legal standards changed dramatically, it seems that in the years following its enactment the statute had little effect on the book trade. After an initial period of compliance with the registration and library deposit

51. *See id.* If as a group, conger members refused to supply to and buy books from an offender "they would have fashioned an economic weapon which was almost irresistible." *Id.*

52. *Id.* at 85, 97–98.

53. *Id.* at 70–74, 80.

54. JOHN FEATHER, PUBLISHING, PIRACY AND POLITICS: AN HISTORICAL STUDY OF COPYRIGHT IN BRITAIN 56–60 (1994); LYMAN RAY PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 142–43 (1968); MARK ROSE, AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT 35–36 (1993).

55. An Act for the Encouragement of Learning (Statute of Anne), 1710, 8 Ann., c. 19 (1710) (Gr. Brit.).

56. *Id.* § 2.

57. *Id.* §§ 2–3.

58. *Id.* § 5.

59. *Id.* § 11.

provisions, both activities declined.⁶⁰ While some authorial contracts recognized the new limited period of fourteen years,⁶¹ many did not.⁶² Nor does it appear that the prices offered and paid for shares of books amongst the booksellers changed in response to the fixed period of duration of the right.⁶³ The booksellers could afford to ignore the Statute of Anne due to the stabilizing effect the Congers had on the book trade at that time.

Although the membership of the congers and their duration cannot be precisely mapped due to a lack of historical evidence, it seems that the original congers continued in operation into the early decades of the eighteenth century.⁶⁴ Other new congers also existed, some of which were concerned with specialist books, such as law books.⁶⁵ Historians speculate that by the second half of the century, the term “conger” had come to be used loosely as a synonym for partnership.⁶⁶ Thus, during the time period with which we are concerned, namely, the first half of the eighteenth century, the book trade was dominated by a small number of wealthy and powerful booksellers, almost all of whom were wholesalers who did not necessarily run retail operations.⁶⁷

The conger system has been criticized for its monopolistic tendencies.⁶⁸ However, despite the strong hold it exercised over the trade, the conger system can be seen as a realistic response to prevailing market conditions. Printing and bookselling served a luxury market which was particularly vulnerable to vicissitudes of fortune among its customers, and therefore to unstable economic and social conditions. The eighteenth century economy revolved around delicate webs of credit between producers, distributors, consumers, masters and apprentices.⁶⁹ In good times this was unproblematic,

60. DAVID MCKITTERICK, *CAMBRIDGE UNIVERSITY LIBRARY: A HISTORY: THE EIGHTEENTH AND NINETEENTH CENTURIES* 29 (1986).

61. For example, Alexander Pope's contract for the sale of *The Iliad*, entered into in 1713 or 1714, was expressly limited to “such time and terme of years as he or his heirs enjoyed such rights.” See ST CLAIR, *supra* note 45, at 92; Lionel Bently & Jane C. Ginsburg, “*The Sole Right . . . Shall Return to the Authors*”: *Anglo-American Authors' Reversion Rights from the Statute of Anne to Contemporary U.S. Copyright*, 25 *BERKELEY TECH. L.J.* 1475 (2010).

62. For examples, see ST CLAIR, *supra* note 45, at 94.

63. Cyrian Blagden, *Booksellers' Trade Sales 1718–1768*, 5 *LIBR.* 243, 255 (1951).

64. HODGSON & BLAGDEN, *supra* note 46, at 85, 91, 94–96.

65. *Id.* at 95–96.

66. *Id.* at 96.

67. TERRY BELANGER, *BOOKSELLERS' SALES OF COPYRIGHT: ASPECTS OF THE LONDON BOOK TRADE, 1718–1768*, at 1–3 (1970).

68. ST CLAIR, *supra* note 45, at 106.

69. John Brewer, *Commercialization and Politics*, in *THE BIRTH OF A CONSUMER SOCIETY: THE COMMERCIALIZATION OF EIGHTEENTH-CENTURY ENGLAND* 205 (Neil McKendrick, John Brewer & John Harold Plumb eds., 1983).

but when the bubble burst, as in the South Sea case,⁷⁰ major liquidity crises ensued.⁷¹ In such cases, tradesmen, shopkeepers and retailers would be hardest hit, because they found it most difficult to realize their assets.⁷² In the days before high street banks, an economy based on credit depended on individual relationships of trust.⁷³ Those who could demonstrate such relationships were best served in such a financial atmosphere, and it was beneficial for others to be associated with them.⁷⁴ The congers created such relationships and thus brought advantages to their members as well as those dealing with them. Conger groupings also aided distribution of books, as each share-owner received a certain number of copies, which he could then sell himself, pass on to retailers, or exchange for the books of other retailers and other conger groups.⁷⁵

One response of the book trade to changes in economic and social conditions was, then, to turn to greater levels of trade cooperation and the formation of ad hoc monopolies. Another response was to seek first legislative, and then judicial, confirmation of the booksellers' view that their rights to print their books, or shares of books, were perpetual, rather than limited to a maximum of twenty-eight years as the Statute of Anne suggested.⁷⁶ These efforts culminated in the well-known cases of *Millar v. Taylor*,⁷⁷ and *Donaldson v. Becket*,⁷⁸ with the House of Lords holding in the latter case that there was no perpetual common law copyright. The London booksellers' response to the reprint or pirate book trade has been well documented and analyzed elsewhere, in particular by Ronan Deazley,⁷⁹ so it will not be discussed in any further detail here. Instead, this Article will

70. *Id.* at 209. Speculation in the South Sea Company led to an economic bubble that famously collapsed in 1720, causing financial ruin for many investors. *See, e.g.*, JOHN CARSWELL, *THE SOUTH SEA BUBBLE* (1960).

71. Brewer, *supra* note 69, at 205.

72. *Id.* at 209–11.

73. James Raven, *The Book Trades, in* BOOKS AND THEIR READERS IN EIGHTEENTH CENTURY ENGLAND: NEW ESSAYS 1, 10 (Isabel Rivers ed., 2001).

74. *Id.*

75. HODGSON & BLAGDEN, *supra* note 46, at 68, 71–72, 97.

76. An Act for the Encouragement of Learning (Statute of Anne), 1710, 8 Ann., c. 19, §§ 1, 11 (1710) (Gr. Brit.).

77. *Millar v. Taylor*, (1769) 98 Eng. Rep. 201 (K.B.).

78. *Donaldson v. Becket*, [1774] 1 Eng. Rep. 837 (H.L.).

79. RONAN DEAZLEY, *ON THE ORIGIN OF THE RIGHT TO COPY: CHARTING THE MOVEMENT OF COPYRIGHT LAW IN THE EIGHTEENTH CENTURY (1695–1774)* (2004) (tracing the various cases brought before the courts of law and equity by the London booksellers seeking to establish that they held a perpetual copyright at common law and focusing on the period between the Statute of Anne and the House of Lords' finding in *Donaldson v. Becket* that no such common law copyright existed).

examine another area of the book trade that the Statute of Anne did not address: partial or altered copying of books. In so doing, this Article seeks to highlight another area in which the booksellers sought to shape the law in a way that would further their own interests.

IV. PARTIAL TAKING AND THE STATUTE OF ANNE

The Statute of Anne referred repeatedly to the “copy or copies” of books and to the “right and liberty of printing such book and books,” and set out penalties for those who might “print, reprint, or import, or cause to be printed, reprinted, or imported, any such book or books without the consent of the proprietor.”⁸⁰ However, it made no mention of those who might print or reprint only *part* of a book, or who might print it in a slightly altered form.

By the middle of the eighteenth century, a rule had emerged from the Court of Chancery stating that an abridgement of a book would not amount to a breach of the Statute.⁸¹ In the nineteenth century, the courts developed this principle to hold that certain categories of use (such as fair quotation, criticism and review) would not be infringements of copyright.⁸² But by the mid-nineteenth century, the abridgement rule was being subjected to sustained criticism by legal treatise writers⁸³ and others.⁸⁴ Such critics viewed the judgments finding an abridgement to be allowable to be wrong in law. Walter Copinger, for example, writes that “[t]he rule appears very unreasonable, and has been the subject of criticism by late writers.”⁸⁵ George Curtis says that the abridgement rule is “wrong in principle.”⁸⁶ Contemporary scholars have debated whether the Statute of Anne *ought* to have been interpreted by the courts to cover abridgements and other partial takings; if

80. 8 Ann., c. 19, § 1.

81. *Gyles v. Barlow sub nom. Gyles v. Wilcox*, (1740) 26 Eng. Rep. 489; 27 Eng. Rep. 682; 22 Eng. Rep. 586 (Ch.).

82. For further discussion of these developments, see ISABELLA ALEXANDER, *COPYRIGHT LAW AND THE PUBLIC INTEREST IN THE NINETEENTH CENTURY* 155–233 (2010).

83. See WALTER COPINGER, *THE LAW OF COPYRIGHT, IN WORKS OF LITERATURE AND ART* 36 (1st ed., London, Stevens and Haynes 1870); GEORGE TICKNOR CURTIS, *A TREATISE ON THE LAW OF COPYRIGHT IN BOOKS, DRAMATIC AND MUSICAL COMPOSITIONS, LETTERS AND OTHER MANUSCRIPTS, ENGRAVINGS AND SCULPTURE, AS ENACTED AND ADMINISTERED IN ENGLAND AND AMERICA* 269–81 (London, Maxwell & Son 1847).

84. The dramatist, Charles Reade was critical of the abridgement rule. See CHARLES READE, *THE EIGHTH COMMANDMENT* 152 (Boston, Ticknor & Fields 1860), cited in Ronan Deazley, *The Statute of Anne and the Great Abridgement Swindle*, *HOUS. L. REV.* (forthcoming 2010).

85. COPINGER, *supra* note 83, at 36.

86. CURTIS, *supra* note 83, at vii.

so, then the judges are cast as the defenders of the interests of copyright users.⁸⁷ If, however, the Statute was intended to cover only reprints of entire works, then the judiciary can be seen as expanding what was only a very limited right by insisting that derivative works fall into a specific category in order to be exempted from the Statute's operation.⁸⁸

In order to assess the Statute's intention regarding the inclusion of abridgements, Ronan Deazley points out that it is essential to examine contemporary attitudes of the book trade concerning abridgements.⁸⁹ The question that must be asked is whether abridgements were perceived as a significant problem by those with an interest in the matter (such as booksellers or book purchasers) or whether they were a normal part of publishing activity. David Vaver, for example, asserts that "[o]ld practices died hard. Even after the first Copyright Act of 1710, British publishers frequently abridged one another's works without thinking to ask for anyone's permission."⁹⁰ Unfortunately, the question of whether booksellers were indeed accustomed to making abridgements of works owned by other booksellers, either before or after the Statute of Anne, has not been extensively examined by book trade historians. One person who has done so is William St Clair, who asserts that the decades between 1600 and 1774 saw a clamp-down on derivative works such as abridgements, translations and anthologies.⁹¹ Conversely, Deazley points out that there is little corroborating evidence for St Clair's claim, and considerable evidence that undermines it.⁹²

The emphasis of this Article is slightly different: it focuses on the actions taken by leading members of the book trade when faced with the Statute's silence on the question of partial takings. The first strategy they employed was legislative reform; the second was litigation. Before turning to discuss these efforts, however, it is necessary to consider some of the same evidence examined by Deazley and St Clair in asking whether the leading members of

87. See, e.g., WILLIAM F. PATRY, *THE FAIR USE PRIVILEGE IN COPYRIGHT LAW* (2d ed. 1995); David Bradshaw, "Fair Dealing" as a Defence to Copyright Infringement in UK Law: An Historical Excursion from 1802 to the *Clockwork Orange* Case, 1993 DENNING L.J. 67 (1995); James L. Oakes, *Copyrights and Copyremedies: Unfair Use and Injunctions*, 18 HOFSTRA L. REV. 983 (1990); K. K. Puri, *Fair Dealing with Copyright Material in Australia and New Zealand*, 13 VICTORIA U. WELLINGTON L. REV. 277 (1983); David Vaver, *Abridgements and Abstracts: Copyright Implications*, 17 EUR. INTEL. PROP. REV. 225 (1995).

88. See Robert Burrell, *Reining in Copyright Law: Is Fair Use the Answer?*, 4 INTEL. PROP. Q. 361 (2001).

89. Deazley, *supra* note 84.

90. Vaver, *supra* note 87, at 225.

91. ST CLAIR, *supra* note 45, at 72.

92. Deazley, *supra* note 84, at 4.

the book trade *cared* about abridgement and other kinds of partial taking and, if so, what they did about it.

There is clearly some evidence in favor of St Clair's argument. The Stationers' Company and others were conscious that derivative works could have an adverse effect on the sales of the original version and there are several records of printers being fined for printing imitation and abridgements of books owned by the Company.⁹³ In 1631, Archbishop Laud refused a license to Robert Young to publish an abridgement of John Foxe's *Book of Martyrs* on the grounds that "abridgements, by their brevity and their cheapness, in short time work out the authors themselves."⁹⁴ Abridgements and other kinds of partial taking were forbidden by a 1678 Company ordinance, which forbade the printing of any book "or any part of any Book" without the consent of the owner.⁹⁵ In 1681, a second ordinance was passed which strengthened this prohibition.⁹⁶

However, there is also considerable evidence that undermines St Clair's assertion that an effective regime controlling abridgements was "fully in place" by the 1630s.⁹⁷ In the first decades of the eighteenth century, such popular works as *The Pilgrim's Progress*, *Robinson Crusoe*, *Moll Flanders* and *Gulliver's Travels* were all published in abridged form, many times over.⁹⁸ Deazley provides further examples of abridgements published during the period without any apparent complaint.⁹⁹ A large part of the work of "garetteers," or hired writers, consisted of identifying the works that were or would become popular, and reproducing them in altered forms.¹⁰⁰ Richard Savage, an insolvent poet and friend of the author and lexicographer Samuel Johnson, described his career as one of Edmund Curl's hired writers as such: "Sometimes I was Mr. John Gay, at other times Burnet or Addison; I

93. For example, on 9 May 1615 John Budge was fined for "printing a booke called the mirror of Matr, taken out of the booke of Martirs w^{ch} belonge to the Company." WILLIAM A. JACKSON, RECORDS OF THE COURT OF THE STATIONERS' COMPANY 1602-1640, at 456 (1957).

94. Arnold Hunt, *Trade Patents*, in *THE BOOK TRADE AND ITS CUSTOMERS 1450-1900*, at 33 (Robin Myers et al. eds., 1997).

95. Any person who did so was penalized by being refused admittance as a Pensioner of the Society. 1 A TRANSCRIPT OF THE REGISTERS OF THE COMPANY OF STATIONERS OF LONDON, 1554-1640, at I16 (Edward Arber ed., London, privately printed 1875).

96. *Id.* at I23.

97. ST CLAIR, *supra* note 45, at 73; *see also* Deazley, *supra* note 84, at 5-6.

98. Pat Rogers, *Classics and Chapbooks*, in *BOOKS AND THEIR READERS IN EIGHTEENTH-CENTURY ENGLAND* 27 (Isabel Rivers ed., 1982).

99. Deazley, *supra* note 84, at 5-6.

100. 2 A.S. COLLINS, *AUTHORSHIP IN THE DAYS OF JOHNSON: BEING A STUDY OF THE RELATIONSHIP BETWEEN AUTHOR, PATRON, PUBLISHER AND THE PUBLIC 1726-1780*, at 26 (1927).

abridged histories and travels, translated from the French what they never wrote, and was expert in finding new titles for old books. I was the Plutarch of the notorious thief.”¹⁰¹

Deazley’s examination of the royal privileges, or licenses, granted at this time is also revealing. Although a license would not be granted for a book that had already received one, an enterprising way of circumventing the controls of the Stationers’ Company was to apply for a license for an abridgement of an existing book.¹⁰² Some licenses were expressly drafted to cover the right to print abridgements of the works applied for.¹⁰³ However, by the reign of Queen Anne, less than one third of royal licenses granted did so.¹⁰⁴

By the early eighteenth century, a market for abridgements both existed and was being supplied. Pat Rogers observes that abridgements of books such as *Robinson Crusoe* and *Moll Flanders* enjoyed “real currency at the lower end of the market.”¹⁰⁵ The market for printed material was also changing through the growing activity in producing new types of printed works for new types of markets. Literary periodicals, such as the *Spectator* and the *Tatler* had popularized the periodical essay, and were soon joined in the market by magazines that incorporated news of the day, literature and poetry.¹⁰⁶ Although such magazines were not printed in large editions, their circulation and readership were far larger than the edition size suggested, due to the popularity of coffee houses where a single issue might find many readers.¹⁰⁷ Amongst the magazines and newspapers of the eighteenth century, the popular miscellany format required a constant stream of new material which was frequently reprinted from other serial publications or extracted from

101. *Id.*

102. For example, in 1624 Gilbert Diglen was granted a twenty-one year patent for an abridgement of Camden’s *Britannia*. See Hunt, *supra* note 94, at 33.

103. For example on May 19, 1607 a patent was granted to Thomas Wilson and Percival Golding to print the “manie works of great volume and importance” translated by Arthur Golding and Thomas Wilson, together with any other works which Wilson might in future translate, and any abridgements of the said works. Hunt, *supra* note 94, at 42–44, 47.

104. Deazley, *supra* note 84, at 12. Of all the privileges granted by Anne, only seven (less than one third) specifically prohibited printing and sale of variant forms of the book in question.

105. Rogers, *supra* note 98, at 29.

106. James Tierney, *Periodicals and the Trade 1695–1780*, in 5 THE CAMBRIDGE HISTORY OF THE BOOK IN BRITAIN 1695–1830, at 479, 485–86 (Michael F. Suarez, S.J. & Michael L. Tuner eds., 2009).

107. RICHARD D. ALTICK, THE ENGLISH COMMON READER: A SOCIAL HISTORY OF THE MASS READING PUBLIC, 1800–1900, at 47 (1957).

novels and other popular works.¹⁰⁸ Books issued in parts on a weekly or monthly basis made large works more affordable and accessible. Newspaper circulation was also increasing. The first successful daily newspaper, *The Daily Courant*, appeared in 1702, and was soon followed by other papers. Another important agent of change was the circulating library. London had its first circulating library in 1740.¹⁰⁹ In the following decades, the number of such establishments rapidly increased, suggesting the emergence of a growing class of new readers.¹¹⁰

It seems likely that the emergence of new markets for different and cheaper literary materials increased pressure on the booksellers to clamp down on derivative works if they wished to retain their historic control over the trade. The leading booksellers of the day were not always averse to abridgements—if they were the ones producing them. Pat Rogers points out that the first abridgement of *Robinson Crusoe* that included all three volumes in a single book was sold by Bettesworth, Brotherton, Meadows and Midwinter, all of whom were important members of the trade.¹¹¹ Nonetheless, it is apparent that not all members of the book trade considered such practices to be inevitable or natural. Daniel Defoe himself complained of the harm done by the abridgements of “mercenary Booksellers.”¹¹² In 1719, when Thomas Cox had published an abridgement of *Robinson Crusoe*, Defoe’s publisher, William Taylor, printed a notice in the *St James Gazette* threatening legal action. He also included an advertisement in *The Farther Adventures of Robinson Crusoe*, warning against “pretended Abridgements.”¹¹³ The suit does not appear to have progressed far (if it was ever commenced), as there is no further evidence of it. Furthermore, the flow of abridgements was unstemmed.

The leading booksellers were clearly concerned with the prospect of free-riding activity that abridgements and partial copying made possible. In the 1730s, these booksellers included clauses seeking to address the issues of partial taking, abridgements, and translations while lobbying for new

108. See ROBERT D. MAYO, *THE ENGLISH NOVEL IN THE MAGAZINES 1740–1815*, at 11–69, 159–272 (1962).

109. CHARLOTTE A. STEWART-MURPHY, *A HISTORY OF BRITISH CIRCULATING LIBRARIES* 14 (1992).

110. IAN WAIT, *THE RISE OF THE NOVEL: STUDIES IN DEFOE, RICHARDSON AND FIELDING* 44 (1963).

111. Rogers, *supra* note 98, at 32.

112. Deazley, *supra* note 84, at 7 (citing DANIEL DEFOE, *AN ESSAY ON THE REGULATION OF THE PRESS* 27 (London, 1704)).

113. Deazley, *supra* note 84, at 8 (citing DANIEL DEFOE, *THE FARTHER ADVENTURES OF ROBINSON CRUSOE* (Taylor, 1719)).

legislation to extend the term of the rights given under the Statute of Anne. The resulting Bill of 1737 addressed both partial copying and altered copying problems¹¹⁴ Partial taking was included in the definition of the right as applying to “any Book, Pamphlet, or Writing or any *Sheet* of such Book, Pamphlet, or Writing.”¹¹⁵ A second clause prohibited any person from printing an abridgement or translation of a book within three years of its publication without the consent of the author or proprietor.¹¹⁶ This clause might suggest that the drafter of the Bill considered that abridgements and translations were currently permitted by law, but that they should be prevented for long enough to give the author or owner some lead time in the market. This, in turn, indicates they were perceived as economically damaging to the booksellers’ interests. However, it is interesting to note that the draftsman did not go so far as to ban abridgements completely. The bill, however, failed to pass through the House of Lords.¹¹⁷

When these legislative efforts went nowhere, the booksellers turned to the Court of Chancery.¹¹⁸ The two cases on which this Article focuses were brought before the Lord Chancellor, Lord Hardwicke, on the same day, August 7, 1739, and used the same counsel.¹¹⁹ Both plaintiffs were groups of powerful conger member booksellers and the defendants were trade outsiders. These cases, and those following them, illustrate that litigation was a tool of the London booksellers that ultimately failed to rid the market of derivative works in the short-term, but perhaps successfully limited the scope of allowable derivative works in the long-term.

114. GR. BRIT. PARLIAMENT, A BILL FOR THE BETTER ENCOURAGEMENT OF LEARNING BY THE MORE EFFECTUAL SECURING THE COPIES OF PRINTED BOOKS TO THE AUTHOR OR PURCHASERS OF SUCH COPIES, DURING THE TIMES THEREIN TO BE MENTION (1737) (on file with British Library and House of Lords Parchment Collection).

115. *Id.* (emphasis in original).

116. *Id.*

117. DEAZLEY, *supra* note 44, at 107–08. Deazley suggests that the failure of the bill might be due to the fact that the changes introduced by the House of Commons meant that it lost the support of the booksellers. *Id.*

118. Even before the final lapse of the Licensing Act and the decline in the power of the Stationers’ Company, the Court of Chancery had sometimes been used as an alternative venue to the Court of Assistants for dispute resolution. For a full discussion of the fora in which copyright issues were adjudicated prior to the Statute of Anne, see H. Tomás Gómez-Arostegui, *What History Teaches Us About Copyright Injunctions and the Inadequate-Remedy-at-Law Requirement*, 81 S. CAL. L. REV. 1197 (2008).

119. *Austen v. Cave*, (1739) 22 Eng. Rep. 440; C11/1552/3, m.1; C33/371, f.493^r (Ch.); *Hitch v. Langley*, (1739) 22 Eng. Rep. 440; C11/1559/23, m.1; C33/371, f.493^r (Ch.).

V. THE FIRST CASES

The first defendant was Edward Cave, proprietor of the ground-breaking *Gentleman's Magazine*. Although the *Gentleman's Magazine* operated in the well-worn footsteps of the traditional historical and literary miscellanies, it was the first that sought to cover current events. By claiming it was only reprinting the news, it managed to avoid the stamp tax, giving it a significant economic advantage.¹²⁰ It drew its material from a broad range of sources. Despite Cave's claims to be the father of the British miscellany, the *Gentleman's Magazine* was not the only serial publication to publish extracts and pieces already published in other magazines, journals, and books.¹²¹ It was, however, far and away the most successful and popular of such publications.¹²²

Cave's offense was printing extracts from a book of four sermons by Joseph Trapp, entitled, *The Nature, Folly and Danger of Being Righteous Overmuch*.¹²³ The sermons attacked the Methodist leader George Whitefield and sparked a prolonged and bitter exchange which received considerable press attention, as well as the publication of further responses from both the Methodist and anti-Methodist camps.¹²⁴ It is clear why Cave would wish to publish such a newsworthy item, but he found himself the subject of a suit brought by Stephen Austen¹²⁵ and Lawton Gilliver,¹²⁶ both of whom were conger members,¹²⁷ and John Clark.¹²⁸ It is noteworthy that Clark was one of the proprietors of Cave's closest rival, *The London Magazine*, which had been set up specifically to compete with the *Gentleman's Magazine* and was itself

120. MAYO, *supra* note 108, at 159.

121. *Id.* at 209. All of these miscellanies published "reviews" and epitomes of the latest works of fiction and other books, which sometimes increased in size to become abridgements, as well as extracts. *Id.* at 170–71, 235–53

122. *Id.* at 162, 168–69.

123. Austen v. Cave, (1739) C11/1552/3, m.1 (Ch.).

124. *Id.* It is of coincidental interest to note that Trapp was also the trial manager for Dr. Sacheverell, discussed in H. Tomás Gómez-Arostegui's article in this volume. H. Tomás Gómez-Arostegui, *The Untold Story of the First Copyright Suit Under the Statute of Anne*, 25 BERKELEY TECH. L.J. 1247 (2010).

125. Stephen Austen was a London bookseller who dealt mainly in law books and theology. HENRY ROBERT PLOMER, A DICTIONARY OF PRINTERS AND BOOKSELLERS WHO WERE AT WORK IN ENGLAND, SCOTLAND AND IRELAND FROM 1726 TO 1775, at 10 (1932).

126. Lawton Gilliver was a London bookseller, best known as being one of Alexander Pope's publishers. *Id.* at 102–03.

127. HODGSON & BLAGDEN, *supra* note 45, app. 14, at 215.

128. John Clark was a London bookseller. PLOMER, *supra* note 125, at 52.

extensively involved in copying extracts and abridgements from other magazines, newspapers and books.¹²⁹

The defendant in the second case was Batty Langley, a gardener by profession who turned to architectural publishing in the 1730s.¹³⁰ Langley was, like William Hogarth, a vociferous critic of the popular Palladian style of architecture supported by Burlington and practiced by Inigo Jones and others.¹³¹ Langley's printing operation involved drawing on his own vast collection of architectural books and prints, both old and new, to churn out books issued in parts or whole to carpenters, joiners, glaziers, masons, cabinet-makers and other members of the building trades, who eagerly snapped them up.¹³² One of his books, *The Builder's Jewel*, ran to fourteen editions, including one in America.¹³³ Langley, like Cave, had clearly tapped a new readership market. But, he too had to answer a complaint of having printed engravings copied from two books by the prominent architect James Gibbs, another target of Langley's harsh criticism in the *Grub-Street Journal*.¹³⁴

Gibbs had originally published his *Book of Architecture* in 1728 by subscription in order to advertise his own architectural work.¹³⁵ He obtained a royal license for fourteen years on May 19, 1732.¹³⁶ The book was hugely successful, earning him £1,500. His second book, *Rules for Drawing the Several Parts of Architecture*, was equally popular. In 1738, he sold the right to print both books and the plates therein to the publishers Arthur Bettesworth,¹³⁷ Charles Hitch,¹³⁸ William Innys,¹³⁹ Richard Manby,¹⁴⁰ John Knapton and Paul

129. Dr. Johnson described the *London Magazine* as "supported by a powerful association of Booksellers, and circulated with all the cunning of the trade." Samuel Johnson, *Edward Cave*, in *BIOGRAPHIA BRITANNICA* 313, 314–15 (Andrew Kippis ed., 2d ed. 1784).

130. EILEEN HARRIS WITH NICHOLAS SAVAGE, *BRITISH ARCHITECTURAL BOOKS AND WRITERS 1556–1785*, at 264 (1990).

131. *Id.* at 265.

132. *Id.* at 268.

133. See Eileen Harris, *Batty Langley: A Tutor to Freemasons (1696–1751)*, 119 *BURLINGTON MAG.* 327, 335 (1977).

134. Terry Friedman, *Gibbs [Gibb], James (1682–1754)*, in *OXFORD DICTIONARY OF NATIONAL BIOGRAPHY* (Oxford Univ. Press 2008) (2004), available at <http://www.oxforddnb.com/view/article/10604>.

135. HARRIS WITH SAVAGE, *supra* note 130, at 209.

136. See Shef Rogers, *The Use of Royal Licenses for Printing in England, 1695–1760: A Bibliography*, 1 *LIBR.* 133, 163 (2000) (citing SP44/363, 372–74).

137. Arthur Bettesworth was a London bookseller who specialised in divinity publications. His daughter married Charles Hitch. HENRY ROBERT PLOMER, *A DICTIONARY OF PRINTERS AND BOOKSELLERS WHO WERE AT WORK IN ENGLAND, SCOTLAND AND IRELAND FROM 1688 TO 1725*, at 34 (1922).

138. Charles Hitch was a London bookseller who was Master of the Stationers' Company in 1758. PLOMER, *supra* note 125, at 127.

Knapton¹⁴¹ for £400.¹⁴² These men were all leading booksellers and conger members and, with the exception of Bettsworth who died in 1739, were the plaintiffs in the suit against Langley.¹⁴³

This was not the first case in Chancery involving Gibbs' books on architecture. In 1733, Gibbs himself brought a suit against Benjamin Cole who had given notice of his intention to print a book that Gibbs alleged would be a copy, abridgement or abstract of his *Rules for Drawing*.¹⁴⁴ Cole, who was an engraver by trade,¹⁴⁵ denied his book would be a copy, abridgement or abstract, and asserted that it was a different work, compiled from books other than Gibbs'.¹⁴⁶ After hearing affidavits, the injunction initially granted to Gibbs was made perpetual, and Cole was ordered to pay the plaintiff's costs.¹⁴⁷ Lord Chancellor Talbot held that "a small variation of the invention would not entitle the defendant to break in upon the patent," and that it was not material that some whole paragraphs of Gibbs' book had been taken from other authors.¹⁴⁸ Gibbs based his own claim on both his royal license and the Statute of Anne. Cole also argued that Gibbs had not fulfilled the Statute's conditions of registration and delivery.¹⁴⁹

The case against Langley, however, proceeded differently. Langley's Answer engaged more directly with the scope of the rights granted in 1710. Both Langley and Cave expressed surprise in their Answers to the complaints, contending that such practices as theirs had never been considered to be a breach of the Statute of Anne. Cave began by entering a

139. William Innys was a London bookseller who was Master of the Stationers' Company in 1747–48. *Id.* at 137.

140. Richard Manby was a London bookseller who was Master of the Stationers' Company in 1765. *Id.* at 161.

141. John Knapton and Paul Knapton were brothers who were London booksellers. John Knapton was Master of the Stationers' Company in 1742, 1743 and 1745. *Id.* at 148.

142. HARRIS WITH SAVAGE, *supra* note 130, at 211.

143. HODGSON & BLAGDEN, *supra* note 45, app. 13–14. Although Manby is not listed as a member of a specific conger, he was in partnership with Innys. PLOMER, *supra* note 125, at 161.

144. *Gibbs v. Cole*, (1734) 24 Eng. Rep. 1051; C11/261/60 (Ch.). I am very grateful to H. Tomás Gómez-Arostegui for both alerting me to the existence of this case through his database of early copyright litigation, available at <http://oldcopyrightcases.org>, and for providing images of the proceedings and the royal privilege.

145. It is noteworthy that Cole, like Langley, was involved in freemasonry, being the official engraver for the Grand Lodge of Freemasons between 1745 and 1767. *See Gibbs v. Cole*, (1734) C 11/261/60, m.1 (Ch.); PLOMER, *supra* note 125, at 56.

146. *Gibbs v. Cole*, (1734) C11/261/60, m.1 (Ch.).

147. *Gibbs v. Cole*, (1734) C33/365 f.222^{r-v} (Ch.).

148. *Gibbs v. Cole*, (1734) 24 Eng. Rep. 1051, 1052 (Ch.).

149. *Gibbs v. Cole*, (1734) C11/261/60, m.1 (Ch.).

demurrer that challenged the complainants' title.¹⁵⁰ He then admitted that he had copied but said he had condensed thirty pages out of sixty-nine into three and one half pages and, furthermore, that he had been carrying out similar exercises for years without complaint.¹⁵¹ He said that he did so "not with an Intent to prejudice the Proprietors of such Books or Pamphlets in the Sale of them on the Contrary this Defendant believes his Publishing such Extracts have many times if not mostly been agreeable to the Proprietors of the Books and the same hath never been Complained of by them as being contrary to the Said Act of Parliament or detrimental to them."¹⁵² He also appealed to the intention of the Legislature, stating that he humbly:

[A]pprehends it was not in the meaning or intention of the said Act of Parliament to restrain any Person from Extracting any Passage or Passages out of the Works of any Author and submits it to the Judgment of this Honourable Court whether such a Construction would not be greatly prejudicial to the spreading of knowledge and learning.¹⁵³

Langley also began by challenging the complainants' title, alleging that Gibbs was not the author at all, but that it was his draughtsman, John Borlack.¹⁵⁴ Like Cave, he emphasized the smallness of his copying, claiming he had taken only fourteen prints from Gibbs' book, which made up fewer than four pages of his own book.¹⁵⁵ Langley likewise claimed that his object was the education of builders, and said he had published "with a view as well to the improvement of builders and their workmen as to the Adorning this Kingdom in General with Buildings and ornaments truly beautiful and grand."¹⁵⁶ He also alleged that works such as his were not in breach of the Statute of Anne "most Especially as Compiling all Kinds of Learning have been Deemed Lawfull and Advantagious to the Community."¹⁵⁷

150. *Austen v. Cave*, (1739) C11/1552/3, m.2 (Ch.).

151. *Id.*

152. *Id.*

153. *Id.*

154. *Hitch v. Langley*, (1739) C11/1559/23, m.2 (Ch.).

155. *Id.*

156. *Hitch v. Langley*, (1739) C11/1559/23, m.1 (Ch.).

157. *Id.* Both Cave and Langley were passionate about their publishing ventures. The author and lexicographer, Samuel Johnson, who would become the century's best known man of letters, and whose talent Cave had spotted early, wrote frequently for the *Magazine*. He said of Cave that "his resolution and perseverance were very uncommon; in whatever he undertook neither expence [sic] nor fatigue were able to repress him." Johnson, *supra* note 129, at 315. He further noted that Cave "continued to improve his magazine and had the satisfaction of seeing its success proportionate to his diligence." *Id.* In Langley's case, his financial incentives were bolstered by his commitment to freemasonry and his devotion to the fraternity gave rise to his other activities, such as providing lessons in drawing, geometry,

Cave was unsuccessful in his Answer and the plaintiffs were granted their injunction prohibiting the printing of the book “or any part thereof.”¹⁵⁸ We have only a scrap of reasoning from Lord Hardwicke, which quotes him as saying “[i]t is not material what Title you give the Book, nor whether you print it all at once or not.”¹⁵⁹ The meaning of this is not entirely clear, but it seems to respond to the plaintiffs’ claim that Cave would print the rest of the book in future editions of the *Magazine*. Thus, it does not address the reality of the situation, which was that Cave had not printed the entire work and, moreover was extremely unlikely to do so, given the nature of the *Magazine*. Nor does it appear that the injunction had any broader effect on Cave or any other of the miscellany magazines, which continued their practice of reprinting extracts and abridgements from a wide variety of printed sources.¹⁶⁰

Langley was appointed a counsel in forma pauperis,¹⁶¹ but his case proceeded no further than his Answer. As his books ran to many further editions, it is possible that he reached some kind of agreement with his accusers. However, the booksellers may have taken other measures to compete with Langley on his own terms. From May 1738 they had been issuing *Rules for Drawing* in twenty-one weekly numbers at one shilling each.¹⁶² A second edition of the *Book of Architecture* was printed in 1739 at the price of three guineas—one guinea lower than the previous price.¹⁶³

No legal principle, then, clearly emerges from these early cases on partial taking. However, one important consequence flowed from Cave’s unsuccessful case, and this was that his cause was taken up by Samuel Johnson.¹⁶⁴ Johnson characterized Cave’s publication as an abridgement rather than an extract, and argued such abridgements should be allowed.¹⁶⁵ Johnson claimed that, once sold, copies of the book became the property of the buyer “who purchases with the book the right of making such use of it as

architecture and garden design, as well as inspiring his self-appointment as spokesman for the Crafts. Harris, *supra* note 133, at 329.

158. *Austen v. Cave*, (1739) C33/371, f.493^r (Ch.).

159. *Austen v. Cave*, (1739) 22 Eng. Rep. 440 (Ch.).

160. See MAYO, *supra* note 108, at 159–272.

161. *Hitch v. Langley*, (1739) C33/371, f.541^v (Ch.).

162. HARRIS WITH SAVAGE, *supra* note 130, at 211.

163. *Id.*

164. Samuel Johnson, *Considerations [by the late Dr. Samuel Johnson] on the Case of Dr. T[rapp]’s Sermons*, GENTLEMAN’S MAG., July 1787, at 555. Although it does not appear to have been published until 1787, the editor of the magazine at the time, John Nichols, assured the reader that the article was written upon the occasion of the law suit, as “on all difficult occasions, Johnson was Cave’s oracle.” *Id.* at 555.

165. *Id.*

he shall think most convenient, either for his own improvement or amusement, or the benefit and entertainment of mankind.”¹⁶⁶ Johnson concluded that “every book, when it falls into the hands of the reader, is liable to be examined, confuted, censured, translated and *abridged*; any of which may destroy the credit of the author, or hinder the sale of the book.”¹⁶⁷

Johnson argued that the existence of countless abridgements, and the lack of complaint prior to *Austen v. Cave*, showed that abridgements had been considered legal. As well as trade custom, reason dictated that abridgements should be allowed. The aim of an abridgement was, “to benefit mankind by facilitating the attainment of knowledge, and by contracting arguments, relations, or descriptions, into a narrow compass; to convey instruction in the easiest method, without fatiguing the attention, burdening the memory, or impairing the health of the student.”¹⁶⁸ He added that although abridgements may diminish the original author’s value and the profits of the publisher, these considerations should give way to the “advantage received by mankind from the easier propagation of knowledge.”¹⁶⁹

Johnson’s eloquent defense was of little use to Cave, but it may have influenced subsequent defendants in emphasizing that their works were abridgements.¹⁷⁰ The first to do so was James Hodges, against whom the London printer and James Read brought a suit in April 1740 for printing a book called *The Life and Reign of Czar Peter the Great Emperor of all Russia and Father of his Country*. Read claimed this book was “almost wholly taken and copied” from his own book, entitled *The History of the Life of Peter the First Emperor of Russia*.¹⁷¹ Unlike the previous two cases, which involved leading members of the trade taking on outsiders, both Read and Hodges were established members of the book trade. Read had been made free of the Company in 1701 and was best known for his publication, the long-running *Read’s Weekly Journal*.¹⁷² Hodges was a bookseller who had made his fortune in chapbooks. He was one of the Court Assistants to the Stationers’ Company,

166. *Id.*

167. *Id.* at 556 (emphasis added).

168. *Id.*

169. *Id.*

170. However, this argument depends on the extent to which Johnson’s article was circulated at the time of its writing.

171. *Read v. Hodges*, (1740) C11/538/36, m.1; C33/374 f.153^v, f.250^v, f.255^v, ff.275^v–276^r (Ch.).

172. MCKENZIE, *supra* note 49, at 378; Michael Treadwell, *London Printers and Printing Houses in 1705*, 7 PUB. HIST. 5, 35–36 (1980).

and was knighted in 1758.¹⁷³ The book had been sold to many well-known London booksellers and may have been a conger book.¹⁷⁴

Read claimed that Hodges' aim was to undercut his market by selling the work more cheaply.¹⁷⁵ Hodges countered by claiming that his book was an abridgement, that only a small amount had been taken, and that not one page appeared without variation. Hodges also sought to separate the parts of the work that might belong to Read from that to which he could not lay claim, pointing out that much of the book consisted of tracts, manifestos and public papers which had been in print before Read's book was compiled.¹⁷⁶ Hodges claimed that his book targeted a different audience, "of more ordinary and mean readers."¹⁷⁷ Finally, he argued that his book was not a piracy because "it is not the same as the Plaintiff's book on History but it is of a different Nature and humbly insists that it is in the Nature of an Abridgement."¹⁷⁸ The case was referred to a Master, who considered Hodge's answer sufficient, and the initial injunction was dissolved. Read, however, immediately sought a further injunction from Chancery, disputing Hodge's claim that his book was an abridgement. This injunction was granted and continued until the hearing of the cause.¹⁷⁹ The case continued through several more phases, before finally coming to rest in Read's favor.¹⁸⁰

The following year, a similar case came before Lord Hardwicke LC.¹⁸¹ Fletcher Gyles and two other booksellers sought an injunction in respect of Sir Matthew Hale's *Pleas of the Crown, or Historia Placitorum Coronae*, against Wilcox (a bookseller), Nutt (a printer), and Barlow (the alleged compiler). Barlow's counsel conceded that the plaintiff would be entitled to claim

173. 3 JOHN NICHOLS, LITERARY ANECDOTES OF THE EIGHTEENTH CENTURY 406 (London, Nichols, Son and Bentley 1812).

174. Hodges stated in his answer that he sold the book for two shillings six pence to those who bought a number of copies at once, and three shillings for retail. Those who had bought the book included Charles Hitch, Thomas Longman, John Brotherton, the Knaptons and Stephen Austen. *Read v. Hodges*, (1740) C11/538/36, m.1 (Ch.).

175. *Id.*

176. *Read v. Hodges*, (1740) C11/538/36, m.2 (Ch.).

177. *Id.*

178. *Id.*

179. *Read v. Hodges*, (1740) C12/1796/41; C33/374 f.299^{r-v} (Ch.).

180. Hodges was served with a subpoena, but Read died before the matter could progress further, and the cause abated. Read's widow, Mary, having been granted probate, then brought a bill to Chancery requesting that the injunction be revived, pending hearing of the cause. *Read v. Hodges*, (1740) C12/1796/41 (Ch.). When Hodges made no answer, the Master of the Rolls revived the injunction, and the matter does not appear to have been continued. *Read v. Hodges*, (1740) C33/374/379 (Ch.).

181. *Gyles v. Wilcox*, (1740) C33/375 ff.274^v-275^r; 26 Eng. Rep. 489; 27 Eng. Rep. 682; 22 Eng. Rep. 586 (Ch.).

property in Hale's book if he had made a "transcript" of the whole or "great part" of it.¹⁸² However, Barlow claimed that he had made an abridgement that contained new material.¹⁸³ Wilcox also claimed that the book, in which the French and Latin quotations were translated into English, was an abridgement, stating: "[t]he Defendant never understood such Abridgements or Translations were within the words and meaning of the Act or were understood or construed to be."¹⁸⁴ It was in this case that Lord Hardwicke enunciated the principle that an abridgement was not a breach of the Statute of Anne rights.¹⁸⁵ The Lord Chancellor stated "where the second Book has been an Abridgement of the former, it has been understood not to be the same Book, and therefore to be out of the Act."¹⁸⁶

Therefore, the practice of partial taking and abridgement continued, and objections continued to be made. In 1743, Cave was again the defendant in litigation when Francis Cogan sought an injunction against him for printing parts of a book that was currently causing a scandal in society.¹⁸⁷ Cave claimed he had published an abridgement and the injunction was dissolved.¹⁸⁸ Cave's Answer echoed the claims of Samuel Johnson's polemic, arguing that:

as he is the Author and Composer of the said Abridgment the same is no Injury to the Complainant's Title if any he had to the said Book and that he this Defendant hath a Right to print and

182. *Gyles v. Wilcox*, (1740) C33/375 f.274^v (Ch.).

183. *Id.*

184. *Gyles v. Wilcox*, (1740) C33/375 ff.274^v–275^v (Ch.).

185. *Gyles v. Wilcox*, (1740) 26 Eng. Rep. 489, 490; 27 Eng. Rep. 682, 682 (Ch.).

186. *Gyles v. Wilcox*, (1740) 27 Eng. Rep. 682, 682 (Ch.).

187. *Cogan v. Cave*, (1743) C12/2204/24 (Ch.). The book told the sensationalized story of James Annesley, kidnapped by his uncle and sent to America in order to inherit his peerage. Annesley returned to claim his peerage, but died before the case was resolved. JAMES ANNESLEY, *MEMOIRS OF AN UNFORTUNATE YOUNG NOBLEMAN* (London, printed for J. Freeman 1743). The book was sometimes attributed to James Annesley as the author, but if Cogan is correct in his Complaint, the actual author was Eliza Haywood, an actress and prolific author of scandalous memoirs, as well as novels and periodicals. *Cogan v. Cave*, (1743) C33/2204, m.1 (Ch.). However, since J. Freeman is clearly a pseudonym, it seems that neither Cogan nor Haywood was prepared to put their names to the edition. Cave argued in his Answer that he could not have been expected to be aware of copyright claims in the absence of correct authorial or printing attribution and noted that the book had not been entered at Stationer's Hall. *Id.* at m.2. In the absence of a reasoned decision, it is not possible to know for certain whether the injunction was dissolved for this reason, or because the abridgement argument persuaded the court.

188. *Cogan v. Cave*, (1743) C33/379 f.547^r (Ch.); *see also* *Tonson v. Walker*, (1752) 36 Eng. Rep. 1017, 1019 (Ch.).

publish the said Abridgment without being accountable to or hindered by the Complainant.¹⁸⁹

In 1759, when Samuel Johnson's *The Idler* had been appearing for several months in the *Universal Chronicle*, the publishers of that publication lost patience and inserted a notice stating:

The Proprietors of this Paper having found their Essays, entitled *The Idler*, are inserted in the News-Papers and Magazines with so little Regard to Justice or Decency, that this Chronicle, in which they first appear, is not always mentioned, think it necessary to declare to the Publishers of those Collections, that however patiently they have hitherto endured these Injuries, made yet more Injurious by Contempt, they have determined to endure them no longer.¹⁹⁰

The Idler's publishers threatened to start seizing copies of the offending publications, reprinting them in whole, selling them, and using the profits to support "Penitent Prostitutes."¹⁹¹

Two years later, Samuel Johnson was again the victim of abridgement by another serial publication, the *Grand Magazine of Magazines*. A suit was brought by Dodsley, assignee of his copyright against the magazine's publisher Kinnersley for printing extracts from *Rasselas, Prince of Abyssinia, a Tale*.¹⁹² Jacob Tonson and two other booksellers presented evidence that the sale of the book had been prejudiced by its appearing in the magazine, while the defendant argued that it was usual in the trade to print extracts of new books in magazines without asking permission of the authors.¹⁹³ He also pointed out that the plaintiffs had published a larger extract of the same book in the *Annual Register* and the *London Chronicle*. The Master of the Rolls, Sir Thomas Clarke, took heed of this evidence. He observed that "[t]he Court must take notice of the springs flowing from trade; and though they cannot regard customs of the trade as binding, yet will consider the consequences of them."¹⁹⁴ He considered it material that the plaintiffs had published an abstract and refused the injunction.

It appears, then, that if we were to characterize the London booksellers as setting out to rid the market of derivative works like abridgements and the monthly miscellanies by bringing selected cases before the Court of

189. *Cogan v. Cave*, (1743) C12/2204/24, m.2 (Ch.).

190. MAYO, *supra* note 108, at 398 n.1.

191. *Id.* at 399 n.1.

192. *Dodsley v. Kinnersley*, (1761) 27 Eng. Rep. 270 (Ch.).

193. *Id.*

194. *Id.* at 271.

Chancery, the London booksellers clearly failed in such an objective. They were, however, frequently successful in obtaining interim injunctions that applied not just to reprinting an entire book, but also to printing “any part thereof.”¹⁹⁵ While the specific category of abridgement may have been acceptable, the booksellers did manage to extend the Statute of Anne’s prohibition on printing and reprinting to cover partial reprinting in other cases. We can therefore view Chancery litigation as one of a range of tools that the booksellers employed in their endeavors to drive their rivals from the market, or, at the very least, to make it more expensive for them to operate. The leading London booksellers wished to partake in the new opportunities offered by the new markets that were opening up, but they were not always the first to identify them. While they may not have succeeded in exercising complete control over the market for derivative works in the short term, their success in limiting the kinds of permissible derivative uses of books may appear over a longer time frame. The cases brought by the booksellers during the mid-eighteenth century can be seen as beginning the long process of leading the courts to develop an approach to infringement that went beyond the literal meaning of the Statute of Anne, and required defendants not just to prove that they were not reprinting the entire book, but that their work fitted a particular category of use.¹⁹⁶

VI. CONCLUSION

Having given a very small snapshot of copyright law at a particular point in the early eighteenth century, one might well be tempted to quote, if somewhat tritely, “the past is a foreign country: they do things differently there.”¹⁹⁷ That is of course quite true. But while none of us would feel at home in the early eighteenth century, certain similar conditions as well as social and economic pressures appear very familiar. Numerous commentators have observed the present-day tendency of copyright owners to join together and use both litigation and legislative lobbying to alter copyright laws in ways that favor their own interests.¹⁹⁸ Similar tactics can be identified in the years immediately before and after the passing of the Statute of Anne. Today it may be less about social and economic changes than

195. *See* *Walthoe v. Walker*, (1736) C33/368 f.127^r (Ch.); *Austen v. Cave*, (1739) C33/371 f.493^r (Ch.); *Hitch v. Langley*, (1739) C33/371 f.493^r (Ch.); *Cogan v. Cave*, (1743) C33/379 f.485^v (Ch.).

196. *See also* Burrell, *supra* note 88; ALEXANDER, *supra* note 82, at 155–233.

197. L.P. HARTLEY, *THE GO-BETWEEN* 1 (1953).

198. *See, e.g.*, PATRY, *supra* note 7; *see also* PETER DRAHOS WITH JOHN BRAITHWAITE, *INFORMATION FEUDALISM: WHO OWNS THE KNOWLEDGE ECONOMY?* (2002); LITMAN, *supra* note 8.

technological advancement that causes copyright owners to feel under pressure. However, their responses are the same. And it is not just the film and music industries that are under threat, but also traditional print publishing—as is evident in the opposition of some book publishers to Google Books.¹⁹⁹

As noted at the start of this article, the United Kingdom Parliament recently enacted the Digital Economy Act which provides for the obligation of policing copyright infringement to be placed upon internet service providers.²⁰⁰ The bill was subject to considerable discussion in the House of Lords, before being hastily pushed through the House of Commons in the pre-election “wash-up.”²⁰¹ Some of the discussion in the Lords focussed on what it was that the Government was seeking to achieve by such legislation. One exchange involved the complaints regarding downloading of the recently-released blockbuster, *Avatar*. To quote Lord Lucas, a Tory peer, is instructive:

My Lords, I suspect that we are not going to agree on “Avatar.” It seems to me that the industry is being peculiarly stupid about it—it got 300,000 free advertisements. “Avatar” is something that you cannot consume sensibly on a small screen: you need the big-screen experience to appreciate all the work that they have put into it. The immediate consumption of it created an enormous demand for going to the cinema, which has benefited the film enormously. That is the fundament of this—we must get the industry to see this as *an opportunity and not as a threat*.

We must get the industry to be in there selling these downloads. If the industry had been in there selling at a dollar a time, it would be better off for it and it would still get the advertising. Its refusal to deal with the way that the world has moved on and with what technology makes possible, and its attempt to stick to old ways of doing things and to the idea that you can release a film in the United States today and wait six months to release it in the UK, is a *looking-backwards attitude* which we should not support through legislation.²⁰²

The point this Article has sought to make is that “the copyright industries,” whether they are printers, booksellers, publishers or record and film companies, have long taken a “looking backwards attitude” and sought

199. See Pamela Samuelson, *Google Book Search and the Future of Books in Cyberspace*, MINN. L. REV. (forthcoming 2010), available at <http://ssrn.com/abstract=1535067>.

200. Digital Economy Act, 2010, c. 24, §§ 2–18 (U.K.).

201. This is the name given to the last few days in which Parliament sits after an election has been called but before it is officially dissolved.

202. 76 PARL. DEB., H.L. (5th ser.) (2010) 1309 (U.K.) (emphasis added).

to fight off new innovators with both litigation and legislation. New markets may be discovered by new entrants, and the existing players struggle to catch up. Copyright law has, therefore, always been just as much, if not more, about struggles between competing economic interests, or clashes of business models, as it is about public interest or encouraging creativity. That is not to say that the public interest and creativity are not important, nor that they should not be the central organizing principles of copyright law: in my view, they should be. However, it is important to recognize that litigation will inevitably arise when business models clash, and that the courts hearing such disputes will be constrained by the context of such disputes and the ways that the facts are presented to them. Moreover, since new copyright legislation is always a combination of what has gone before, combined with some tweaking for new conditions, we need to be aware that by focussing solely on resolving tensions between different business models created, or exacerbated, by the rise of new technologies, we may be moving ever further away from that goal.

THE INVENTION OF COMMON LAW PLAY RIGHT

Jessica Litman[†]

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A dramatic composition is capable of two distinct public uses. It may be printed as a book and represented as a drama. . . . The exclusive right of multiplying copies is called copyright. But this does not embrace the right of representation. . . . The sole liberty of publicly performing a dramatic composition might more properly be called dramatic right or acting right. . . . I have adopted playwright as being, in my judgment, the best name for the purpose. It is a convenient euphonious word, and its formation is analogous to that of copyright. As the latter word literally means the right to copy a work, or the right to the copy, so playwright means the right to play a drama, or the right to the play.

—Eaton Sylvester Drone¹

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[†] John F. Nickoll Professor of Law, University of Michigan. I’m grateful to Pam Samuelson for thinking up this conference and inviting me to do this research, and to Jon Weinberg, Jody Kraus, Jane Ginsburg, Becky Eisenberg, and H. Tomás Gómez-Arostegui for their helpful comments on earlier drafts.

1. EATON S. DRONE, TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 553 (1879). Copyright in both Britain and the United States was initially limited to the right to print and sell copies. The

I. INTRODUCTION

American copyright law nominally vests exclusive rights in “authors.”² “Authors” in America, as often as not, are the employers of the individuals who actually create copyrightable works.³ Even when the law vests copyright in creators, the architecture of the system encourages them to assign their copyrights to intermediaries, who are motivated by potential profits to disseminate the works to the public.⁴ Employers and assignees stand in the authors’ shoes and may control a work’s exploitation to the exclusion of the individuals who created it.⁵ That’s the essence of a copyright system that is fundamentally utilitarian in its design. With the narrow exceptions of painters and sculptors, American authors have no enforceable attribution or integrity rights.⁶ The originality standard for “meriting” copyright protection is low, and follow-on creators who add even a little creativity to authorized adaptations of copyrighted works are entitled to exclusive rights in their versions of those works. This is the American version of copyright law in a nutshell.⁷

In stark contrast to that model, consider the American playwright: the playwright keeps her copyright, rather than assigning it. In the United States, playwrights license public exploitation, and pay the intermediary exploiters with a share of the proceeds rather than ownership of the copyright.⁸ Playwrights assert strong, apparently enforceable rights to attribution and integrity.⁹ Playwrights, finally, insist that other creators who contribute

British Parliament and United States Congress later expanded copyright to encompass other rights. *See infra* notes 106–18, 134–38, 213–15, 261 and accompanying text.

2. *See* 17 U.S.C. § 201(a) (2006).

3. *See* U.S. Copyright Office, *Works Made for Hire Under the 1976 Copyright Act*, Circular 9 (revised Apr. 2010).

4. *See* Jessica Litman, *Real Copyright Reform*, 96 IOWA L. REV. (forthcoming 2010) (on file with author).

5. *See, e.g.*, *Okla. Natural Gas Co. v. Larue*, Copyright L. Rep. (CCH) ¶ 27,814 (10th Cir. 1998); *Gross v. Seligman*, 212 Fed. 930 (2d Cir. 1914).

6. *See* ROBERTA KWALL, *THE SOUL OF CREATIVITY: FORGING A MORAL RIGHTS LAW FOR THE UNITED STATES* 23–35 (2009).

7. *See* ARTHUR R. MILLER & MICHAEL H. DAVID, *INTELLECTUAL PROPERTY: PATENTS, TRADEMARKS, AND COPYRIGHT IN A NUTSHELL* 296–304, 383–404 (4th ed. 2007).

8. *See, e.g.*, DONALD C. FARBER, *PRODUCING THEATRE* 1–33 (3d rev. ed. 2006).

9. *See, e.g.*, DONALD C. FARBER, *FROM OPTION TO OPENING: A GUIDE TO PRODUCING PLAYS OFF BROADWAY* 21 (5th ed. rev. 2005); Samuel G. Freedman, *Who’s to Say Whether a Playwright is Wronged*, N.Y. TIMES, Dec. 23, 1984, at E6; United Press Int’l, *Albee Seeking to Close All-Male “Woolf,”* N.Y. TIMES, Aug. 3, 1984, at C5; Dramatists Guild of Am., *Dramatists Bill of Rights*, <http://www.dramatistsguild.com/billofrights/> (last visited Aug. 3, 2010); Dramatists Play Service, *Frequently Asked Questions (FAQs)*,

significant creative expression to licensed productions of their scripts have added no authorship and should receive no copyright protection for their additions.¹⁰

What accounts for the differences? There's no obvious language in the copyright statute suggesting that dramatists or their plays be treated as unique legal beasts. The current copyright statute includes several relatively minor provisions that single dramatic works out for more favorable treatment in particular narrow contexts.¹¹ In general, the category of dramatic works (which Congress doesn't even bother to define) is treated the same way as other subject matter categories. Federal copyright cases involving dramatic works are surprisingly scant.

For most of the 18th, 19th, and 20th centuries, the contours of federal statutory copyright and the formal prerequisites for perfecting it fit dramatic works poorly. Until 1978, American copyright law focused chiefly on works that had been published—for most works, publication was the *quid pro quo*

<http://www.dramatists.com/faqsmanager/applications/faqsmanager/> (last visited Aug. 3, 2010).

10. See, e.g., John Weidman, *Protecting the American Playwright: The Seventh Annual Media and Society Lecture*, 72 BROOK. L. REV. 639, 641–42 (2007); Ralph Sevush, *The Urinetown Papers: The U.S. Copyright Office Debunks the Notion of a "Directors Copyright,"* THE DRAMATIST, Mar.–Apr. 2009, at 30; Dramatists Guild of Am., *Dramatists' Copyright & Intellectual Property Rights*, Apr. 2000, http://www.dramatistsguild.com/about_statements_copyright.aspx (last visited Feb. 2, 2010); see also *Thomson v. Larsen*, 147 F.3d 195 (2d Cir. 1998) (holding dramaturg was not a joint author of musical because composer/dramatist did not intend to share authorship credit); *Erickson v. Trinity Theatre*, 13 F.3d 1061 (7th Cir. 1994) (holding actors were not joint authors of three plays because their contributions were not independently copyrightable); *Childress v. Taylor*, 945 F.2d 500 (2d Cir. 1991) (holding actress not a joint author of one-woman play because dramatist did not intend to share authorship credit). But see, e.g., Carrie Ryan Gallia, Note, *To Fix or Not to Fix, Copyright's Fixation Requirement and the Rights of Theatrical Collaborators*, 92 MINN. L. REV. 231, 264 (2007) (“By transforming a stack of pages into a live performance, a director demonstrates sufficient originality.”); Margit Livingston, *Inspiration or Imitation? Copyright Protection for Stage Directions*, 50 B.C. L. REV. 427, 486 (2009) (“[A] straightforward application of traditional copyright law would dictate that stage directions are subject to copyright protection.”).

11. Section 110 expressly limits some of its exemptions for noncommercial performances or displays to “non-dramatic literary or musical works,” excluding dramatic works, choreographic works, pictorial graphic and sculptural works, motion pictures and other audiovisual works and architectural works. Section 118 limits the scope of the statutory noncommercial broadcasting license to “published nondramatic musical works and published pictorial, graphic and sculptural works.” Section 121 limits the scope of the exemption for reproduction and distribution of copies or phonorecords in formats accessible for people with disabilities to “previously published, non-dramatic literary work.” Those distinctions, though, don't begin to explain the more fundamental differences in copyright ownership and control described in the text accompanying notes 8–10.

for statutory copyright protection.¹² The vast majority of plays, even those that were exploited commercially, were never published as U.S. copyright law defined it.¹³ Playwrights in America until 1909 faced a choice of arranging to publish their scripts to secure federal statutory protection or relying on whatever copyright protection state courts might afford unpublished works.¹⁴ That dilemma persuaded Congress in 1909 to permit copyright registration for unpublished plays.¹⁵ While thousands of unpublished play scripts were registered,¹⁶ very few of them became involved in federal litigation.¹⁷ Important questions about how the copyright statute applied to works registered as unpublished, such as the duration of rights for unpublished works,¹⁸ remained unresolved for years.¹⁹

Instead of relying on federal statutory copyright, lawyers for dramatists claimed that their clients' work was better protected under state "common law copyright."²⁰ The 1909 Copyright Act expressly preserved "the right of the author or proprietor of an unpublished work, at common law or in

12. L. Ray Patterson, *Free Speech, Copyright and Fair Use*, 40 VAND. L. REV. 1, 2–12, 33–34 (1987); Pamela Samuelson, *CONTU Revisited: The Case Against Copyright Protection for Computer Programs in Machine-Readable Form*, 1984 DUKE L.J. 663, 705–06.

13. See, e.g., BARRETT H. CLARK, 1 AMERICA'S LOST PLAYS v–vi (1940).

14. See *Revision of the Copyright Laws: Hearings on Pending Bills to Amend and Consolidate the Acts Respecting Copyright Before the House and Senate Comm. on Patents*, 60th Cong. 21–41 (1908) (testimony of witnesses representing the American Dramatists Club and the National Association of Theatrical Managers); 1 LIBRARY OF CONG. COPYRIGHT OFFICE, *DRAMATIC COMPOSITIONS COPYRIGHTED IN THE UNITED STATES 1870 TO 1916*, at 1 (1918).

15. Copyright Act of Mar. 4, 1909 § 11, 35 Stat. 1075, 1078 (later § 12).

16. See LIBRARY OF CONG., FIFTY-FOURTH ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS FOR THE FISCAL YEAR ENDING JUNE 30, 1951, at 2 (1952); LIBRARY OF CONG., REPORT OF THE REGISTER OF COPYRIGHTS FOR THE FISCAL YEAR 1924–25, at 196–97 (1925); LIBRARY OF CONG., REPORT OF THE REGISTER OF COPYRIGHTS FOR THE FISCAL YEAR 1918–19, at 138–39 (1919).

17. See, e.g., *Rosen v. Loew's, Inc.*, 162 F.2d 785 (2d Cir. 1947) (holding the authors of "The Mortal Storm" did not copy "The Mad Dog of Europe"); *Marx v. United States*, 96 F.2d 204 (9th Cir. 1938) (affirming criminal conviction for infringement of radio script); *Davis v. E.I. DuPont De Nemours & Co.*, 240 F. Supp. 612 (S.D.N.Y. 1965) (holding play based on novel "Ethan Frome" to be infringed by TV movie).

18. See *Marx v. United States*, 96 F.2d 204 (9th Cir. 1938) (holding that twenty-eight year duration for published works should also apply to registered unpublished work, but the date of deposit should be deemed the date of publication).

19. William S. Strauss, *Protection of Unpublished Works* (1957), in 1 COPYRIGHT SOCIETY OF THE USA, *STUDIES ON COPYRIGHT* 190, 196 (1963).

20. See, e.g., HOUSE COMM. ON THE JUDICIARY, 88TH CONG., *COPYRIGHT LAW REVISION PART 2: DISCUSSION AND COMMENTS ON THE REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW* 312 (Comm. Print 1963) (letter from Irwin Karp, May 29, 1961); PHILIP WITTENBERG, *THE PROTECTION AND MARKETING OF LITERARY PROPERTY* 11–14 (1937); Benjamin Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 473–79 (1955).

equity, to prevent the copying, publication, or use of such unpublished work without his consent”²¹ A 1957 Copyright Office study of state common law copyright described it as giving authors “absolute rights in an unpublished work”²² that were “not subject to the limitations imposed by the statute upon copyright.”²³ The rights “continue perpetually as long as the work remains unpublished, unless . . . the owner voluntarily chooses to secure statutory copyright by registration in the Copyright Office.”²⁴ The scope of the playwrights’ common law right was perceived to be broader than the common law copyright at issue in *Wheaton v. Peters*,²⁵ encompassing what we would today identify as adaptation and public performance rights as well as reproduction and distribution rights. In 1879, treatise author Eaton Drone dubbed the common law public performance right in unpublished dramatic works “playright,”²⁶ and, at least for a time, the usage enjoyed favor.²⁷

This Article explores playwrights’ common law “play right.” Since this conference celebrates the 300th birthday of the Statute of Anne, I begin in England in the 17th Century. I find no trace of a common law playwright’s performance right in either the law or the customary practices surrounding 17th and 18th century English theatre. I argue that the nature and degree of royal supervision of theatre companies and performance during the period presented no occasion (and, indeed, left no opportunity) for such a right to arise. I discuss the impetus for Parliament’s enactment of a performance

21. Copyright Act of Mar. 4, 1909 § 2, 35 Stat. 1075, 1075.

22. Strauss, *supra* note 19, at 191 (citing DRONE, *supra* note 1, at 8).

23. *Id.* at 194.

24. *Id.* at 191; see George A. Warp, *The Position of the Dramatist in Copyright Law*, 22 B.U. L. REV. 528, 529–30 (1942).

25. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834); see L. RAY PATTERSON, *COPYRIGHT IN HISTORICAL PERSPECTIVE* (1968). See generally Craig Joyce, *The Story of Wheaton v. Peters: A Curious Chapter in the History of Judicature*, 42 HOUS. L. REV. 325 (2006).

26. DRONE, *supra* note 1, at 553. Drone used the single word “playright” because of its parallel to “copyright” and the courts following Drone did so as well. In this essay, I use “play right” unless I am quoting to minimize confusion.

27. See, e.g., *Fitch v. Young*, 230 F. 743, 744 (S.D.N.Y. 1916) (Hand, J.) (“I think that play right and copyright are quite distinct under the statute, in spite of the fact that printed publication will forfeit both, and that one statutory copyright will protect both.”); R.R. BOWKER, *COPYRIGHT: ITS HISTORY AND ITS LAW* 162 (1912) (“[T]he new American code provides not only for copyright, but for playwright or right of performance.”); WILLIAM MORRIS COLLES & HAROLD HARDY, *PLAYRIGHT AND COPYRIGHT IN ALL COUNTRIES* 1 (1906) (“The playwright is more valuable, as a rule, than the copyright in a play. . . .”); Charles Collins, *Playright and the Common Law*, 15 CALIF. L. REV. 381, 381 (1926–1927) (“Playright is a word coined by Mr. Drone It has been adopted by the Supreme Court of the United States, and is accordingly preferred” (citation omitted)); Warp, *supra* note 24, at 546 (“[T]he term ‘playright’ refers to the exclusive right to present dramatic works.”).

right statute in 1833, and its decision, nine years later, to adopt a law that scuttled any nascent tendencies supporting the development of a common law performance right by equating public performance with publication for the purposes of copyright.

I then cross the Atlantic to the United States, and note that the colonies and the young nation imported their actors, managers, plays, and customary theatrical practices from England. I again find no trace of a common law play right before 1856. That year was the year that Congress followed the British example and enacted a statutory public performance right for the authors and proprietors of dramatic compositions.²⁸ The first common law performance right cases show up shortly thereafter, as courts sought to respond to formal defects in the copyrights of claimants seeking to enforce their rights under the new statute.²⁹

In 1879, Eaton Drone relied on an expansive natural rights theory about the true nature of copyright to draw from these cases a generous depiction of play right as a perpetual entitlement without exceptions.³⁰ Courts adopted Drone's version of common law play right and followed it for the next thirty years.³¹ The availability of a strong natural right claim, however, made little difference to actual playwrights, who were deemed to have assigned their rights to the producers of their plays.

The strong copyright-like rights that playwrights enjoy today are chiefly contractual, secured for them in 1926 by the collective action of members of the Dramatists' Guild, who claimed to be a labor union and thus entitled to an antitrust exemption.³² Courts would later rule that the exemption was not available to the Guild,³³ but its members and the theatre producers it contracts with continued to behave, most of the time, as if they were bound by Guild contracts. Meanwhile, the broad Drone view of natural rights copyright fell out of fashion, to be replaced, first, by a utilitarian public-interest account³⁴ and later by a utilitarian broad property rights account.³⁵

28. Act of Aug. 18, 1856, 11 Stat. 138.

29. *E.g.*, Keene v. Wheatley, 14 F. Cas. 180 (C.C.E.D. Pa. 1861).

30. DRONE, *supra* note 1, at 553–600; *see infra* notes 173–89 and accompanying text.

31. *See, e.g.*, Frohman v. Ferris, 87 N.E. 327 (Ill. 1909), *aff'd*, 223 U.S. 424 (1912); Tomkins v. Halleck, 133 Mass. 32 (1882).

32. *See An Arbitrator to Keep Peace in Theatre*, N.Y. TIMES, Mar. 23, 1926, at 24; *infra* notes 238–45 and accompanying text.

33. Ring v. Spina, 148 F.2d 647 (2d Cir. 1945); *see text accompanying infra* notes 252–60.

34. *See, e.g.*, Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors*, 82 COLUM. L. REV. 1600, 1602 (1982) (“The ultimate goal is not author remuneration, however, but the advancement and dissemination

The evolution of attitudes about the nature of copyright made no appreciable change in playwrights' lives or livelihoods.

II. PLAY RIGHT IN ENGLAND

Since our conference is celebrating the 300th birthday of the Statute of Anne, we should begin by examining the common law literary property rights that playwrights enjoyed in the century preceding the enactment of the Statute of Anne. If playwrights' "play right" derives from common law sources, one might expect to be able to find the sources of a common law play right in the case law of the 17th and early 18th century. The examination need not keep us for long, because it seems evident from all sources that playwrights enjoyed no literary property rights in their scripts. Playwrights' common law rights are apparently of more recent origin.

First, some common ground: the notion that common law copyright predated statutory copyright in England was first advanced by members of the stationers' guild, after the enactment of the Statute of Anne, to press claims for perpetual printing monopolies.³⁶ The evidence they offered to support their theory of perpetual common law copyright was longstanding "stationers' copyright," a naked horizontal restraint of trade under which members of the Worshipful Company of Stationers agreed not to reprint any text first claimed by another member.³⁷ Stationers treated members' assertions of exclusive rights to a text as perpetual, permitting them to be sold to or inherited by other members of the Guild.³⁸ Since stationers commonly (although not invariably) paid the owner of a manuscript something in return for the privilege of printing it, they claimed that they

of culture and knowledge." See generally Lloyd L. Weinreb, *Copyright for Functional Expression*, 111 HARV. L. REV. 1149, 1215–16 (1998) (remarking trend).

35. See, e.g., Robert Merges, *Contracting Into Liability Rules: Intellectual Property Rights and Collective Rights Organizations*, 84 CALIF. L. REV. 1293 (1996). See generally Neil Netanel, *Why Has Copyright Expanded? Analysis and Critique*, in 6 NEW DIRECTIONS IN COPYRIGHT LAW 3 (Fiona MacMillan ed., 2007) (criticizing trend); Diane Leenheer Zimmerman, *Copyright As Incentives: Did We Just Imagine That?*, 12 THEORETICAL INQUIRIES IN LAW (forthcoming 2010) (arguing that research in psychology and behavioral economics cast doubt on incentive theory of copyright).

36. E.g., Howard Abrams, *The Historic Foundation of American Copyright Law: Exploding the Myth of Common Law Copyright*, 29 WAYNE L. REV. 1119, 1129–47 (1983). See generally RONAN DEAZLEY, *ON THE ORIGINS OF THE RIGHT TO COPY* 191–210 (2004).

37. See JOHN FEATHER, *PUBLISHING, PIRACY AND POLITICS: AN HISTORICAL STUDY OF COPYRIGHT IN BRITAIN* 15–36 (1994); Edward S. Rogers, *Some Historical Matter Concerning Literary Property*, 7 MICH. L. REV. 100, 105–09 (2008).

38. See DON-JOHN DUGAS, *MARKETING THE BARD: SHAKESPEARE IN PERFORMANCE AND PRINT 1660–1740*, 93–94 (2006); MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* 12 (1993).

must by their payment have purchased a perpetual common law literary property right.³⁹ Stationers argued unsuccessfully in court that this perpetual common law right survived the enactment of the Statute of Anne.⁴⁰

Copyright historians have examined the evidence supporting the existence of a common law literary property right in 17th century England and persuasively debunked it.⁴¹ To the extent that common law literary property rights may be said to have existed in some place and at some time, they did not precede the enactment of the Statute of Anne. For most purposes, the inquiry is of only academic interest, because the British courts ultimately held that even if there had been such a common law right, the enactment of the Statute of Anne had abrogated it for all published works.⁴² Such a right, had it existed, might have offered protection to unpublished scripts, but the British Parliament eventually decided that a play's first public performance should be equated with publication for copyright purposes.⁴³

39. See, e.g., PATTERSON, *supra* note 25, at 47–78; Pamela Samuelson, *Copyright and Freedom of Expression in Historical Perspective*, 10 J. INTELL. PROP. L. 319, 323–38 (2003). Paying the owner of a manuscript was not, of course, the same as paying the author. See, e.g., LEO KIRSCHBAUM, *SHAKESPEARE AND THE STATIONERS* 5–7 (1955).

40. See PATTERSON, *supra* note 25, at 172–80; ROSE, *supra* note 38, at 67–91.

41. See, e.g., DEAZLEY, *supra* note 36, at 73–74, 195–210; RONAN DEAZLEY, *RETHINKING COPYRIGHT* 63–65 (2006); 1 WILLIAM F. PATRY, *PATRY ON COPYRIGHT* § 1:11 (2009); ROSE, *supra* note 38, at 22 (“[T]here is no evidence that copyright was ever recognized as a common law right of an author in the sixteenth or seventeenth centuries.”); Abrams, *supra* note 36, at 1134 (“As a matter of historical fact, the common law never developed any law of copyright.”). *But see* H. Tomás Gómez-Arostegui, *The Untold Story of the First Copyright Suit Under the Statute of Anne in 1710*, 25 BERKELEY TECH. L.J. 1247 (2010) (suggesting that complaints filed in Chancery before 1710 to vindicate stationer's copyright claims may provide some evidence of common law copyright).

42. *Donaldson v. Beckett*, 1 Eng. Rep. 837, 845 (1774); see DEAZLEY, *supra* note 36, at 191–220.

43. 1842 Copyright Law Amendment Act, 5 & 6 Vict. c. 45, § XX. The 1842 Copyright Law Amendment includes the first post-mortem copyright term, the first express work-made-for-hire provision, and the first compulsory license for reprinting out-of-print books. See generally Ronan Deazley, *Commentary on Copyright Amendment Act 1842*, PRIMARY SOURCES ON COPYRIGHT (1450–1900) (L. Bently & M. Kretschmer eds., 2008), http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabeCom/%22uk_1842%22. Section 20 of the Act extended the dramatic performance right initially enacted in 1833 to musical compositions, and provided that “the first public Representation or Performance of any Dramatic Piece or Musical Composition shall be deemed equivalent, in the Construction of this Act, to the first Publication of any Book.” The 1842 Act also permitted the registration of unpublished but publicly performed dramas and musical compositions, without depositing any copies, through recording the title, the name and place of abode of the author or composer, the name and place of abode of the copyright proprietor, and the time and place of the first public performance. 1842 Copyright Law Amendment Act, § XX. The Act also provided that the assignment of the right to print and public a script or musical

More fundamentally, however, proponents of common law copyright conceived of it as a printing right, limited to control over the printing and sale of copies. In the 18th century, not even the most ardent defender of common law copyright suggested it extended to control over public performances of works.⁴⁴ Thus, a playwright's common law rights in a script, had they existed, would have empowered the dramatist to sell that script to a printer for publication, or withhold it from publication. It would have given the playwright no recourse, however, if players chose to perform the unpublished script without a license.

A. ENGLISH THEATRE BEFORE THE STATUTE OF ANNE

We tend to view historical facts through a contemporary lens. When we see a practice that looks familiar, we assume that its context must have matched, or at least resembled, its contemporary analog. Thus, much speculation about common law play right seems to begin by recognizing landmarks that would characterize such a right in recent times, and assuming the context must have followed familiar patterns. A serious exploration of the English theatre before the enactment of the Statute of Anne, though, reveals a context starkly different from one we would recognize. The most fundamental difference is the degree to which, from the 16th through the 18th centuries, all aspects of theatrical performance were regulated by the crown.⁴⁵ A monarchy that reacted to the seditious potential of the printing press by licensing all printing appreciated the subversive possibilities of public theatrical performance.⁴⁶ The crown responded by criminalizing unlicensed theatrical presentations, limiting the legal theatres to companies owned and run by friends and courtiers, and requiring all scripts to be approved by the royal censor before the initial public performance.⁴⁷ As the theatre in Tudor and Restoration England existed only by dint of royal privilege, the crown was called upon to decide disputes between rival theatres, and it did so: allocating plays, playwrights, or actors to one company

composition did not also assign the public performance right unless it said so explicitly. *Id.* § XXII.

44. See DEAZLEY, RETHINKING, *supra* note 41, at 154–56.

45. See generally OSCAR G. BROCKETT & FRANKLIN L. HILDY, HISTORY OF THE THEATRE 114–16, 211–14, 220–21 (9th ed. 2003).

46. JOHN RUSSELL STEPHENS, THE CENSORSHIP OF ENGLISH DRAMA 1824–1901, at 7 (2010).

47. See, e.g., Judith Milhous, *Theatre Companies and Regulation*, in 2 THE CAMBRIDGE HISTORY OF BRITISH THEATRE 108 (Joseph Donahue ed., 2004) [hereinafter Milhous, *Theatre Companies and Regulation*].

rather than another.⁴⁸ In that sphere, questions of common law literary property seem to be beside the point.

The Elizabethan and Restoration eras of British theatre history have been the subject of extensive study, but extrapolating from surviving documentary evidence requires guesswork and intuition. Current theatre historians have concluded that Elizabethan theatre companies paid playwrights for their services in essentially the same way they paid actors: playwrights received a salary, or participated as partners in the profits of the company, collecting a share of net receipts, or both.⁴⁹ At least some playwrights (like actors and managers) who were “sharers” or partners in theatre companies were able to earn a living from the theatre, if not from writing plays.⁵⁰ Play scripts were deemed to belong to the company, which decided when to produce them, revive them, or sell them to stationers for printing.⁵¹ After an initial reading of the script to the full cast, companies had scribes copy individual actors’ “parts” or “sides”—pages interspersing a single actor’s lines with a few words of cues from the end of the immediately preceding lines.⁵² Actors learned their lines from the parts, and did not see the entire play until they came together at the end of the rehearsal period for group rehearsal.⁵³ Companies were reluctant to authorize printers to publish play scripts while

48. See, e.g., JUDITH MILHOUS, THOMAS BETTERTON AND THE MANAGEMENT OF LINCOLN’S INN FIELDS 1695–1708, at 15–19, 66–68, 115–16, 201–02, 209–21 (1979) [hereinafter MILHOUS, THOMAS BETTERTON]; Judith Milhous & Robert D. Hume, *The Silencing of Drury Lane in 1709*, 32 THEATRE J. 427 (1980) [hereinafter Milhous & Hume, *The Silencing of Drury Lane*].

49. See PAULINA KEWES, AUTHORSHIP AND APPROPRIATION: WRITING FOR THE STAGE IN ENGLAND 1660–1710, at 17 (2004); Judith Milhous & Robert D. Hume, *Playwrights’ Remuneration in Eighteenth Century London*, 10 HARV. LIBR. BULL. 1 (Summer–Fall 1999) [hereinafter Milhous & Hume, *Playwrights’ Remuneration*]; Mary I. Oates & William J. Baumwol, *On the Economics of the Theater in Renaissance London*, 74 SWED. J. ECON. 136, 149, 156–58 (1972).

50. See, e.g., PETER THOMPSON, SHAKESPEARE’S PROFESSIONAL CAREER 27, 82–100 (1992); PETER THOMPSON, SHAKESPEARE’S THEATRE 19–35, 58–87 (2d ed. 1992).

51. Judith Milhous concludes that theatre companies treated the physical manuscripts of plays as carrying with them the license to produce them. MILHOUS, THOMAS BETTERTON, *supra* note 48, at 16–17. While one could argue that that practice manifests some precursor common law public performance right in unpublished scripts, the reason is likely more prosaic. Throughout this period, theatrical performances required a license from the Master of the Revels confirming that the play script had met the censor’s approval. The Master of the Revels affixed his license stamp to the promptbook, so a company’s possession of a promptbook with license stamp was essential evidence of the lawfulness of a production. See JOSEPH LOEWENSTEIN, BEN JOHNSON AND POSSESSIVE AUTHORSHIP 31 (2002).

52. See TIFFANY STERN, REHEARSAL FROM SHAKESPEARE TO SHERIDAN 10–12, 149–51 (2000); Judith Milhous, *The First Production of Rowe’s “Jane Shore,”* 38 THEATRE J. 309, 312 (1986).

53. See STERN, *supra* note 52, at 61–79.

they were still part of the active repertory, but were more eager to publish in years in which the theatres were closed because of political unrest, royal death, plague, or fire.⁵⁴ Unauthorized printings were common and typically rife with errors.

The Protestant Revolution closed the theatres completely in 1642, and they remained closed until Charles II was restored to the throne in 1660.⁵⁵ King Charles granted royal patents⁵⁶ to two courtiers to run theatre companies in London, and prohibited competing theatrical performances.⁵⁷ Charles had enjoyed attending theatrical performances during his exile in France, and ordered his new English theatres to cast women in female roles, after the French fashion.⁵⁸ The crown drew up a list of extant plays and allotted them exclusively to one company or the other, prohibiting each company from performing plays granted to the other.⁵⁹ The division was unequal. Thomas Killigrew's King's Company received most of the popular plays. William Davenant's Duke's Company was less fortunate.⁶⁰ Davenant, therefore, needed to commission new scripts. As the Duke's Company staged new plays, the King's Company found that it needed to find new

54. See LOEWENSTEIN, *supra* note 51, at 29–31; MILHOUS, THOMAS BETTERTON, *supra* note 48, at 16–17; Milhous & Hume, *Playwrights' Remuneration*, *supra* note 49, at 35. Scholars have surmised that some of the unauthorized editions were pieced together from actors' parts and actors' memory. See, e.g., GEORGE IAN DUTHIE, THE "BAD" QUARTO OF HAMLET: A CRITICAL STUDY 29–36 (1941); W. Mathews, *The Piracies of Love a La Mode*, 10 REV. ENG. STUD. 311, 315 (1934); see also 1 JOHN BERNARD, RETROSPECTIONS OF THE STAGE 128 (Boston, Carter & Hendee 1832).

55. During this period, theatre companies that had previously refused to publish their scripts made them available to printers. See KEWES, *supra* note 49, at 183.

56. Royal letters patent were monopoly privileges conferred by the king or queen. They were not limited to technological inventions. See generally CHRISTINE MACLEOD, INVENTING THE INDUSTRIAL REVOLUTION: THE ENGLISH PATENT SYSTEM 1660–1800, at 10–39 (1988).

57. See Joseph Donahue, *The Theatre from 1600 to 1800*, in THE CAMBRIDGE HISTORY OF BRITISH THEATRE, *supra* note 47, at 3, 4–8. Ireland also had a single theatre company by dint of a royal patent granted in 1661. Scotland had none. See Gorel Garlick, *Theatre Outside London, 1660–1775*, in THE CAMBRIDGE HISTORY OF BRITISH THEATRE, *supra* note 47, at 165–70.

58. See generally ELIZABETH HOWE, THE FIRST ENGLISH ACTRESSES: WOMEN AND DRAMA 1660–1700, at 19–24 (1992); MILHOUS, THOMAS BETTERTON, *supra* note 48, at 4–7.

59. See Robert D. Hume, *Theatres and Repertory*, in THE CAMBRIDGE HISTORY OF BRITISH THEATRE, *supra* note 47, at 53, 55.

60. See KEWES, *supra* note 49, at 13–15; MILHOUS, THOMAS BETTERTON, *supra* note 48, at 4–20. Killigrew's company had a much larger proportion of established actors who had been well-known before the revolution. Milhous speculates that Killigrew may have staked his claim to the lion's share of extant English repertory on the basis of his actors' prior connections to those plays. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 17.

scripts to compete for audiences.⁶¹ As before, the new scripts appear to have become the property of the company that first staged them.⁶² Playwright compensation, however, was no longer by salary or ownership share unless the playwright was also a member of the acting company. Rather, both companies appear to have settled on a compensation system under which the playwright would receive the net proceeds of a single performance, typically the third night, and, if the production proved to run longer than a few days, might be offered the net proceeds of an additional performance or two.⁶³ While the benefit performance might earn a lot of money for an exceptionally successful play, the receipts were usually more modest. The division of the repertory between the companies meant that neither theatre company needed to worry that a competing theatre would perform its scripts. Perhaps as a result, the companies seem to have grown more interested in printing and publishing plays after their initial run. In at least some cases, the companies allowed the playwright to pocket the stationer's payment for the script.⁶⁴ The amount of money printers paid for play scripts, though, was not substantial.⁶⁵

Despite the royal constraints limiting competition, the two companies were unable to sustain their operations. By 1682, the King's Company was insolvent, and the Duke's Company absorbed its remnants, including its

61. See KEWES, *supra* note 49, at 13–20. Lacking a ready-made popular repertory, Davenant's Duke's company appears to have competed by offering productions featuring more impressive changeable scenery and special effects. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 20–25. That strategy proved to be successful; Killigrew shortly had to build a new theatre to accommodate new audience demand for expensive sets. *Id.* at 12.

62. ROBERT D. HUME, *THE RAKISH STAGE: STUDIES IN ENGLISH DRAMA 1660–1800*, at 277 (1983); KEWES, *supra* note 49, at 15; MILHOUS, THOMAS BETTERTON, *supra* note 48, at 15–16. Throughout this period, companies freely adapted plays in their repertory to respond to changing audience tastes, more stringent crown censorship, or changes in acting personnel.

63. See KEWES, *supra* note 49, at 13–20; Milhous & Hume, *Playwrights' Remuneration*, *supra* note 49, at 4. Because the recipient of the benefit paid the costs attributable to that performance, managers could stage benefit performances at little risk to company finances. By the end of the 17th century, theatre companies also offered benefit performances to star actors, as bonuses in addition to or in lieu of salary. See Judith Milhous, *United Company Finances, 1682–1692*, 7 *THEATRE RES. INT'L* 37 (1982) (reconstructing the finances of the theatre company formed in 1682 by combining the Kings Company and the Duke's Company into a single "United Company") [hereinafter Milhous, *United Company Finances*].

64. See Judith Milhous & Robert D. Hume, *Dating Play Premieres from Publication Data 1660–1700*, 22 *HARV. LIBR. BULL.* 374, 395–96 (1974) [hereinafter Milhous & Hume, *Dating Play Premieres from Publication Data*] (quoting Colley Cibber's 1696 contract).

65. See KEWES, *supra* note 49, at 24.

theatre building and its repertory of plays.⁶⁶ The United Company was now the sole licensed theatre in London, with an ample stock of established drama. The company's theatrical seasons were heavily dominated by revivals from that repertory, and it was well placed to turn a profit.⁶⁷ The inheritors of shares of the patent for the original companies, now sharers in the United Company, were able to attract investors to buy their interests.⁶⁸ The investors brought in new management with no theatrical experience.⁶⁹ The new manager (a lawyer) sought to increase the United Company's profit margins, by reforming practices that seemed to him to be economically unsound. He sought to retire aging actors and cast younger performers in their roles, to present fewer shows, to reduce the compensation and benefits the company traditionally paid its actors, and to rein in spending for popular scenery and special effects.⁷⁰

The actors rebelled. In 1694, fifteen of the United Company's best-known actors petitioned the Lord Chamberlain to hear their complaints, explaining that they found current management of the company was "soe intolerable & heavy that unless relieved wee are not able to act any longer."⁷¹ The Lord Chamberlain granted the rebels permission to withdraw from the United Company and form a rival company licensed to perform "all manner of Comdyes & Tragedyes, Playes, Interludes & Opera's and to performe all other Theatricall and musicall Entertainments of what kind soever."⁷² The United Company got to keep the theatre buildings, costumes, sets, special effects equipment, and the Killigrew and Davenant patents, but its most famous actors had left, taking with them royal permission to perform any play in the United Company's repertory.⁷³

66. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 31–37. Milhous places most of the blame for the King Company's demise on Killigrew, whom she characterizes as a poor theatrical manager. *Id.* at 37.

67. See generally Milhous, *United Company Finances*, *supra* note 63, at 37 (assessing the "startling amount of money [that] flowed through the United Company").

68. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 40–43, 51–62; Milhous, *Theatre Companies and Regulation*, *supra* note 47, at 114.

69. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 59, 62; PAUL SAWYER, CHRISTOPHER RICH OF DRURY LANE: THE BIOGRAPHY OF A THEATRE MANAGER 9–18 (1986).

70. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 59–66; WATSON NICHOLSON, THE STRUGGLE FOR A FREE STAGE IN LONDON 7–9 (1966).

71. See The Petition of the Players, *reprinted in* MILHOUS, THOMAS BETTERTON, *supra* note 48, at 225, 226.

72. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 64–67.

73. See *id.* at 67–72.

The rebel actors formed a rival company as an actors' cooperative, while the manager of the patent company continued to treat it as a business investment.⁷⁴ Both companies relied heavily on productions from their repertory, mounting relatively few new scripts.⁷⁵ Occasionally they competed by trying to usurp one another's plays,⁷⁶ but the strategy proved commercially unrewarding.⁷⁷

Neither company prospered. The actors' company lacked the capital to build or renovate a suitable theatre, and its sharers, though famous, were aging.⁷⁸ Meanwhile, whether because of mismanagement or fraud, the patent company was unable to pay its investors, its actors or its rent.⁷⁹ Audience tastes were changing—increasingly, the crowds preferred spectacle, music, dance, and circus acts to drama or comedy.⁸⁰ At the turn of the century, British moral reformers targeted theatres as particular dens of vice and indicted actors for onstage indecency.⁸¹ Both the actors' company and the patent company let bills go unpaid. Actors and investors complained that the managers of both companies were pocketing money rather than honoring their obligations.⁸²

Queen Anne's Lord Chamberlain intervened repeatedly in efforts to reconfigure the two companies into a viable theatre.⁸³ In 1708, he reunited the acting company. He ordered that operas might be performed exclusively in one theatre, that tragedies and comedies might be performed exclusively in the other, and that nobody except for the managers of the two theatres

74. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 68–97; Milhous, *Theatre Companies and Regulation*, *supra* note 47, at 114–15; SAWYER, *supra* note 69, at 25–31.

75. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 97–112, 139–50.

76. Thus, in November of 1704, both companies appear to have staged revivals of Shakespeare's *Henry IV*. See *Season of 1704–1705*, in 1 THE LONDON STAGE 1660–1800: PART 2: 1700–1729, at 179, 192, 195–96 (Judith Milhous & Robert D. Hume eds., interim version 2001) (1960), available at <http://www.personal.psu.edu/hb1/London%20Stage%202001/lond1704.pdf>.

77. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 131–32, 174.

78. *Id.* at 88, 113–24, 161.

79. *Id.* at 124–25, 154–68; SAWYER, *supra* note 69, at 40.

80. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 133–44, 188; SAWYER, *supra* note 69, at 31–35, 43–44.

81. See *Season of 1704–1705*, *supra* note 76; Milhous, *Theatre Companies and Regulation*, *supra* note 47, at 116.

82. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 161–62, 167; Milhous, *Theatre Companies and Regulation*, *supra* note 47, at 117–18.

83. See NICHOLSON, *supra* note 70, at 8–19; STERN, *supra* note 52, at 126–28.

would be permitted to produce theatrical entertainment.⁸⁴ The opera theatre soon found that its expenses dwarfed its receipts; the manager of the dramatic theatre refused to pay his actors full salaries. In 1709, the actors again petitioned the Lord Chamberlain to intervene. This time, the Lord Chamberlain ordered the patent theatre to close down.⁸⁵ He ousted the patent company's manager, and reorganized the company under different managers. To lessen inter-company competition, he restricted each company's performance dates.⁸⁶

The picture that emerges from a look at 16th and 17th English century theatre history is of an industry closely supervised by the crown, which licensed theatre companies, play performance, and play printing, and intervened in disputes over repertory, personnel, performance schedule, competition, and compensation. Theatre managers valued playwrights as they valued actors, and paid them in the same fashion. Scripts once acquired entered a theatre company's repertory, where they could be revived, adapted, rewritten, performed, and printed without any further license from the writer.⁸⁷ Although there is some evidence suggestive of a custom that actors presumptively owned an interest in continuing to play the parts they had performed in the past,⁸⁸ the limited competition in the English theatre during these years, together with the royal restrictions forbidding actors to defect to rival companies without royal permission, make it difficult to verify whether the custom had much force. It seems clear, though, that at the time Parliament adopted the Statute of Anne, playwrights enjoyed no common

84. See MILHOUS, THOMAS BETTERTON, *supra* note 48, at 189–221; Robert D. Hume, *The Sponsorship of Opera in London 1704–1720*, 85 MOD. PHILOLOGY 420, 423–29 (1988); Milhous & Hume, *The Silencing of Drury Lane*, *supra* note 48, at 430–32.

85. See Milhous & Hume, *The Silencing of Drury Lane*, *supra* note 48, at 435–40.

86. See *id.* at 435–47.

87. See, e.g., STERN, *supra* note 52, at 129–31, 241–45 (George Villier's *The Rehearsal* written in 1664 and then rewritten repeatedly between 1667 and 1776 to revamp its protagonist to parody different contemporary dramatists); see also COLLEY CIBBER, THE TRAGICAL HISTORY OF KING RICHARD III (1700) (cut-and-paste job of Shakespeare's Henry VI and Richard III with Cibber's additional dialogue).

88. See STERN, *supra* note 52, at 149–51 (reporting that actors were deemed to own their parts); see also MILHOUS, THOMAS BETTERTON, *supra* note 48, at 17 (reporting that in 1660 the King's company laid claim to most of the preexisting repertory on the ground that its veteran actors had performed those plays). The apparent custom may represent no more than the practical difficulty of preventing an actor from continuing to perform a role once she had memorized her part. *But see* Morris v. Kelly, 37 Eng. Rep. 451 (1820) (enjoining actress from performing play at a theatre other than the one that alleged ownership of the copyright and could prove ownership of the promptbook).

law literary property right in their scripts,⁸⁹ and the pervasive regulation of theatre left little room for such a right to arise.

The Statute of Anne made no immediate observable difference in the lot of dramatists.

B. ENGLISH THEATRE FROM THE STATUTE OF ANNE TO THE 1833
DRAMATIC LITERARY PROPERTY ACT

Queen Anne died in 1714, to be succeeded by George I. The Hanover kings were not particularly interested in theatre, and actors were no longer deemed even honorary members of the royal household.⁹⁰ Throughout the 18th century, small theatre companies sprang up to compete with the two patent theatres, but extensive government regulation and uncertain finances kept them from gaining a foothold.⁹¹ In 1737, Parliament passed the Licensing Act, which limited performance of legitimate drama to the two patent theatre companies and required that any script be vetted by the Lord Chamberlain before its first performance.⁹² Theatre historians report that the licensing act essentially shut down opportunities for playwrights to place new scripts, and many dramatists shifted their efforts to poetry or novels. Even

89. See, e.g., GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF COPYRIGHT 104–05 (1847); DEAZLEY, RETHINKING, *supra* note 41, at 155; 2 JAMES APPLETON MORGAN, THE LAW OF LITERATURE 286–87 (1875).

90. See, e.g., Hume, *supra* note 59, at 57.

91. See HUME, *supra* note 62, at 279–307. Debate over the continuing validity of the royal patents, which had not been officially confirmed by Parliament, apparently emboldened several managers to open unlicensed theaters in or near London. The holders of interests in the two theatre patents went to court repeatedly to close these efforts down and to prevent performers from defecting to unlicensed venues. See BROCKETT & HILDY, *supra* note 45, at 220–21. Further afield, a Dublin theatre successfully fended off a lawsuit seeking to enjoin its production of Sheridan's *Duenna* brought by the patent theatre that claimed to have purchased all rights from Sheridan. See *The Monthly Chronologer: Ireland – Dublin, April 26*, THE LONDON MAGAZINE, OR, GENTLEMEN'S MONTHLY INTELLIGENCER, May 1770, at 279 (reporting Chancery decision that plaintiff was not entitled to an injunction). I am indebted to Tomás Gómez-Arostegui for bringing this case to my attention.

92. Theatrical Licensing Act of June 21, 1737, 10 Geo. II c. 28. See DAVID THOMAS, DAVID CARTER, & ANNE ETIENNE, THEATRE CENSORSHIP FROM WALPOLE TO WILSON (2007). According to Brockett, within a few years, managers began to evade the Licensing Act by selling tickets to concerts and offering dramatic entertainment for free. See BROCKETT & HILDY, *supra* note 45, at 221. By the 1780s, some of the larger towns outside of London had persuaded Parliament to license theatres in their towns, or empower local magistrates to do so. *Id.*

though the vast majority of productions came from the extant repertory, though, the two patent companies produced several new scripts every year.⁹³

With their opportunities at home constrained, some British actors formed companies to tour in the New World. Others sought to perform outside of London or in venues on the outskirts of the city, in competition with the patent companies, avoiding the prohibition by styling their productions as “concerts” or “burlettas” rather than dramas, comedies, or plays.⁹⁴

Toward the end of the 18th century, theatre companies began to contract with some authors to allow them to keep their statutory copyrights, and contract directly with stationers, in return for less money.⁹⁵ In 1794, the two patent theatres started paying flat fees rather than benefits.⁹⁶ Both companies had built larger houses to accommodate larger audiences, and they imposed the change to limit the amounts they needed to pay playwrights for new scripts. Historians Judith Milhous and Robert Hume have examined the account books of one of the patent theatres and concluded that, on average, playwrights collected more money under the new system than they would have under the old.⁹⁷ By the end of the 18th century it was becoming possible for at least some playwrights to earn a living writing for the theatre.

C. STATUTORY PLAY RIGHT IN ENGLAND

Edward Bulwer-Lytton is known to modern American audiences as the author of the phrase “[i]t was a dark and Stormy night,”⁹⁸ and the namesake of an annual contest for overwrought prose.⁹⁹ Bulwer-Lytton was a popular novelist, a poet, a baron, and a Member of Parliament.¹⁰⁰ By the late 1820s, the patent theatres were deeply in debt and smaller, competing theatres had

93. See Hume, *supra* note 59, at 67–70; HUME, *supra* note 62, at 307–11; Milhous, *Theatre Companies and Regulation*, *supra* note 47, at 108, 122–24.

94. See JOHN RUSSELL STEPHENS, *THE CENSORSHIP OF ENGLISH DRAMA 1824–1901*, at 7–9 (1980).

95. See Milhous & Hume, *Playwrights’ Remuneration*, *supra* note 49, at 35–43; 3 ALLARDYCE NICOLL, *A HISTORY OF ENGLISH DRAMA 1660–1900*, at 47 (1952).

96. HOUSE OF COMMONS, *REPORT FROM THE SELECT COMM. ON DRAMATIC LITERATURE WITH MINUTES OF EVIDENCE* (1832), http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/%22uk_1832%22; Milhouse & Hume, *Playwrights’ Remuneration*, *supra* note 49, at 6–7.

97. Milhouse & Hume, *Playwrights’ Remuneration*, *supra* note 49, at 26–27.

98. EDWARD GEORGE BULWER-LYTTON, *PAUL CLIFFORD* 13 (1830).

99. THE BULWER-LYTTON FICTION CONTEST, <http://www.bulwer-lytton.com> (last visited Feb. 15, 2010).

100. See generally LESLIE MITCHELL, *BULWER LYTTON: THE RISE AND FALL OF A VICTORIAN MAN OF LETTERS* (2003).

sprung up.¹⁰¹ Licensed by the crown to perform musical entertainment and burlettas, they insisted that they could produce dramas, comedies, and melodramas so long as they interspersed them in bills with non-dramatic entertainment. The managers of the patent companies claimed that the non-patent theatres bore significant responsibility for patent companies' financial troubles and pursued legal campaigns to shut the non-patent theatres down.¹⁰² In 1832, residents of London presented a petition protesting the prosecutions of upstart theatre companies. Bulwer-Lytton moved to establish a Select Committee on Dramatic Literature.¹⁰³ Appointed chairman of the Committee, he held hearings, inviting testimony from playwrights, actors, managers, and government officials.¹⁰⁴ The picture that the witnesses presented portrayed a lively environment of non-patent theatres operating under limited licenses but producing dramas and comedies in defiance of the patent companies' assertions of exclusive rights.¹⁰⁵ Play scripts were readily available. In order to claim copyright under the extant statute, it was necessary to publish and register a play as a book. Once published, however, a play could be performed by any theatre that could get its hands on a script—the performance rights in published plays were universally understood to be in the public domain.¹⁰⁶

When there had been only two theatre companies, the risk from competition was small, since the companies appear to have followed an informal practice of declining to poach each other's scripts or actors. In those circumstances, publication of a new play netted the company or playwright some extra money from the publisher without threatening performance revenues. As new theaters sprang up, though, they helped themselves to the plays in the patent companies' repertoires.¹⁰⁷ Forgoing

101. See Jane Moody, *The Theatrical Revolution, 1776–1843*, in *THE CAMBRIDGE HISTORY OF BRITISH THEATRE*, *supra* note 47, at 199, 200–10.

102. See REPORT FROM THE SELECT COMM. ON DRAMATIC LITERATURE, *supra* note 96, at 21–116; see, e.g., *Morris v. Kelly*, (1820) 37 Eng. Rep. 451. A complicating factor was that managers of the patent theatres mortgaged their shares and defaulted on the loans, giving creditors control of the companies. The creditors frequently failed to pay the actors what they had promised, so the actors had significant incentives to seek additional or alternative work. See *id.*

103. See Ronan Deazley, *Commentary on Dramatic Literary Property Act 1833*, PRIMARY SOURCES ON COPYRIGHT (1450–1900) (L. Bently & M. Kretschmer, eds., 2008), http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabeCom/%22uk_1833%22.

104. See *id.*; NICHOLSON, *supra* note 70, at 325–34.

105. See generally REPORT FROM THE SELECT COMM. ON DRAMATIC LITERATURE, *supra* note 96, at 9 (reproducing hearing transcripts).

106. E.g., DEAZLEY, *RETHINKING*, *supra* note 41, at 154–55.

107. See REPORT FROM THE SELECT COMM. ON DRAMATIC LITERATURE, *supra* note 96, at 149 (testimony of David Edward Morris, proprietor, Haymarket Theatre).

publication was no longer a feasible long term option: publishers were notorious for sending stenographers to attend unpublished plays and write down all the dialogue, so that they could publish unlicensed printed versions of the scripts.¹⁰⁸ Since unpublished plays were not subject to copyright protection, the publishers risked little.¹⁰⁹ Bulwer-Lytton asked all of his witnesses whether the theatre would be improved if the patent theatres lost their monopoly, and whether better plays would result if all theatre companies needed to compensate playwrights for performing plays.¹¹⁰ Witnesses answered variously,¹¹¹ but Bulwer-Lytton intended to pursue both reforms.

In August of 1832, the Committee delivered a report calling for the expansion of copyright in dramatic literature to give writers control of public performances of their plays, and the termination of the patent theatres' monopoly.¹¹² Both measures passed the House of Commons, but the House of Lords rejected the limitation on the patent theatres' monopoly, viewing the legislation as an affront to crown prerogative.¹¹³ As of 1833, however, the Dramatic Literary Property Act¹¹⁴ enabled authors or their assignees to enjoin unlicensed productions. Despite the new law, play writing did not suddenly become more remunerative. First, both theatres and publishers claimed to be

108. *See id.* at 143 (testimony of Thomas Morton, reader, Drury Lane theatre); *id.* at 171 (testimony of Charles Mathews, proprietor, Delphi Theatre).

109. Authority on this point is not crystal clear. In *Macklin v. Richardson*, (1770) 27 Eng. Rep. 451, the author of the unpublished farce *Love a la Mode* had succeeded in enjoining the publication of the script in a magazine on the strength of his common law copyright in his unpublished script. *Macklin* was decided after the King's Bench decision in *Milar v. Taylor*, (1769) 98 Eng. Rep. 201, had recognized a perpetual common law copyright in printed, published texts that survived the Statute of Anne, but before the House of Lords' decision in *Donaldson v. Beckett*, (1774) 1 Eng. Rep. 837, rejected *Milar v. Taylor*. After *Donaldson v. Beckett* repudiated the notion of perpetual common law copyright in published texts, it would in theory have been possible to argue, as playwrights later did in the United States, that so long as the script remained unprinted and unpublished, the common law right had not been abrogated by the statute. The reported cases don't reflect such an argument's being made with success in the period between *Donaldson* and the 1932 hearings, and Parliament's later decision to equate performance with publication prevented the argument from succeeding later.

110. *See, e.g.*, REPORT FROM THE SELECT COMM. ON DRAMATIC LITERATURE, *supra* note 96, at 156–59 (testimony of Douglas Jerrold, author); *id.* at 170 (testimony of Charles Mathews, proprietor, Adelphi Theatre).

111. *See, e.g., id.* at 176 (testimony of W. Thomas Montcrieff, playwright); *id.* at 182 (testimony of George Bartley, actor).

112. *Id.* at 4–6.

113. *See* Deazley, *supra* note 103; Dewey Ganzel, *Patent Wrongs and Patent Theatres: Drama and Law in the Early Nineteenth Century*, 76 P.M.L.A. 384, 391–92 (1961).

114. 3 & 4 Will.IV, c. 15 (1833).

the authors' assignees in whom the new performance right vested. In *Cumberland v. Planché*, the court agreed that the publisher of the play owned the new performance right as part of its prior purchase of the copyright.¹¹⁵ As importantly, the overall economic climate for theatre in mid-19th century London was not at all playwright-friendly.¹¹⁶

In 1842, Parliament enacted a revised copyright statute, which provided that the dramatic performance right could be assigned separately from the copyright,¹¹⁷ and equated the first public performance of a dramatic work with publication.¹¹⁸ Literary property rights for plays were limited, at least from the time of the first public performance, to the rights available under the copyright statute. Even if one were to credit an argument that at some time in the past, dramatists in England, or the theatres they wrote for, could have claimed some literary property rights at common law to control the performance of their plays (and, as the past discussion indicates, I have concluded they could not), the enactment of the 1842 Act abrogated any such rights going forward. Since performance was the equivalent of publication for performance rights, and publication forfeited any non-statutory copyright, British playwrights lost any common law public performance rights in their scripts upon the initial public performance.

III. PLAY RIGHT IN AMERICA

Across the Atlantic Ocean, the story developed differently. The early plot is similar. Congress enacted the first copyright statute in 1790, including only reproduction and distribution rights for books, maps, and charts.¹¹⁹ American publishers argued that that law did not abrogate their perpetual common law copyright.¹²⁰ In *Wheaton v. Peters*, the Supreme Court held that it was doubtful that perpetual common law copyright had ever existed in England, but, if it had, the colonists didn't bring it with them when they emigrated to

115. *Cumberland v. Planché*, (1834) 110 Eng. Rep. 1329; Deazley, *supra* note 103. Eight years later, Parliament enacted a revised copyright law that required assignment of the dramatic public performance right to be separately registered. *See supra* note 43 and accompanying text.

116. Deazley, *supra* note 103. Deazley suggests several reasons for the poor fortunes of dramatists following the enactment of the 1833 law, including poor management of theatre companies, high actor salaries and excessive production costs. *Id.*

117. *See* sources cited *supra* note 43.

118. British courts read the law to forfeit common law rights upon public performance even if that performance occurred in the United States. *Boucicault v. Chatterton*, (1867) 5 Ch.D. 267.

119. Act of May 31, 1790, at ch. 15, 1 Stat. 124.

120. *See, e.g., Abrams, supra* note 36, at 1178–85.

Pennsylvania, and, if they had, Congress had abrogated it for printed books when it enacted the 1790 Copyright Act.¹²¹ (And, had Congress not, the common law right had never been imagined to include public performance rights.) Dramatic works could be protected as books, and some were, but Congress did not add a dramatic performance right to the copyright law until 1856.¹²²

A. EARLY AMERICAN THEATRE

Early American theatre was chiefly a British import.¹²³ British actors formed touring companies to play in the New World, bringing their plays with them.¹²⁴ Several American colonies, especially in the north, prohibited all theater as immoral,¹²⁵ but the southern colonies were more receptive to visiting British performers.¹²⁶ During the Revolution, the Continental Congress passed resolutions banning theatrical performances as displays of “extravagance and dissipation.”¹²⁷ Once independent, the new country had no international copyright relations with any European nation. All British, French, and German scripts, therefore, were free for the taking.¹²⁸ Most theatre performed in the United States during the first half of the 19th century was old British repertory, new British imports, and American adaptation of scripts that had succeeded in Britain, France, and Germany. Copying was the norm.¹²⁹

It’s not surprising that since America imported its actors and plays from England, it also imported its customary practices. Actors and managers claimed that their payment to a playwright for a script purchased all rights in

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

122. Act of Aug. 18, 1856, 11 Stat. 138.

123. ALFRED L. BERNHEIM, *THE BUSINESS OF THE THEATRE: AN ECONOMIC HISTORY OF THE THEATRE 1758–1932*, at 5–7 (1932).

124. *Id.*

125. *See id.* at 6.

126. *See id.* at 6–7.

127. Resolution of Oct. 20, 1774, cl. 8.

128. *See* BERNHEIM, *supra* note 123, at 20. British courts, for their part, ruled that if a play was initially performed in America before being copyrighted in Britain, the initial performance should be deemed a foreign publication, which forever forfeited any British copyright. *Boucicault v. Delafield*, (1863) 71 Eng. Rep. 261; *Boucicault v. Chatterton*, (1877) 5 Ch.D. 267.

129. THOMAS JAMES WALSH, *PLAYWRIGHTS AND POWER: A HISTORY OF THE DRAMATISTS GUILD* 14 (1996); *see* BEN GRAF HENNEKE, *LAURA KEENE: A BIOGRAPHY* 51–52 (1990) (explaining that theatre managers and courts interpreted US law before 1856 to permit a manager “to produce any play in print without permission from, or fee to, the author so long as she named him”); THOMAS KITTS, *THE THEATRICAL LIFE OF GEORGE HENRY BOKER* 116–17 (1994) (“Most touring stars played published texts and were therefore not obligated to seek permission or pay royalties.”).

the script unless a written contract reserved some printing or performance rights to the dramatist.¹³⁰ Playwrights sold all rights in a script for an initial flat fee, and, sometimes, the promise of a benefit performance.¹³¹ The middle of the nineteenth century saw the rise of American dramatists and the immigration of British ones choosing to become American residents and citizens. Both groups of writers complained about their treatment under U.S. law as compared with the law of Britain or France.¹³²

B. THE 1856 DRAMATIC COPYRIGHT ACT

Nineteenth century American theatre involved artists who traveled frequently between the United States and Europe. English actors starred in American productions. American actors spent a season acting in London. American managers went to London or Paris to acquire scripts to adapt.¹³³ Shortly after the enactment of the English Dramatic Literary Property Act in 1833, American writers began to lobby for a similar law here.¹³⁴ Dion

130. See CLEMENT E. FOUST, *THE LIFE AND DRAMATIC WORKS OF ROBERT MONTGOMERY BIRD* 145–47 (1919) (recounting Bird’s consulting with lawyer in unsuccessful attempt to reclaim his copyrights from Edwin Forrest).

131. WALSH, *supra* note 129, at 10; see BERNHEIM, *supra* note 123, at 20 (“Payments to dramatists did not generally burden our managers of the first half of the nineteenth century.”); HENNEKE, *supra* note 129, at 129 (all rights to *Our American Cousin* purchased for \$1000). Royalties were not unheard of: Henneke reported that Keene offered to pay royalties for American scripts as early as the mid 1850s, HENNEKE, *supra* note 129, at 51–52, and George Henry Boker is believed to have demanded a 5% royalty on all performances of his plays from the 1850s on. WALSH, *supra*, at 10–11. A royalty arrangement was not necessarily more remunerative. Boker’s *Leonor de Guzman* opened in 1852 in Philadelphia to excellent reviews and then moved to Broadway. Kitts tells us that Boker’s 5% royalty on the initial run summed to \$159.09. KITTS, *supra* note 129, at 87.

132. See generally Oren Bracha, *Commentary on the U.S. Copyright Act Amendment 1856*, PRIMARY SOURCES ON COPYRIGHT (1450–1900) (L. Bently & M. Kretschmer eds., 2008), http://www.copyrighthistory.org/cgi/bin/kleioc/0010/exec/ausgabeCom/%22us_1856%22; sources cited *infra* note 134.

133. See, e.g., 1 *THE CAMBRIDGE HISTORY OF AMERICAN THEATRE* 7–16 (Christopher Bigsby & Don B. Wilmetts eds., 1999); Simon E. Williams, *European Actors and the Star System in the American Theatre 1752–1870*, in *THE CAMBRIDGE HISTORY OF AMERICAN THEATRE*, *supra*, at 303; *infra* notes 134–35, 147–68 and accompanying text.

134. See FOUST, *supra* note 130, at 147–51; KITTS, *supra* note 129, at 116–18. Two of the most prolific and litigious playwrights of the 19th century were Dionysus Boucicault, an Irish playwright who became an American citizen, and Augustin Daly, a theatre manager from North Carolina. Boucicault and Daly collided in the most famous of 19th century us copyright cases, *Daly v. Palmer*, 6 F. Cas. 1132 (C.C.S.D.N.Y. 1868), in which the court found that Boucicault, the author of *After Dark*, had plagiarized the railroad rescue scene from Daly’s *Under the Gaslight*. Together with Laura Keene, an expatriate Briton who became an American theater manager, and Charles Frohman, an American theatre manager who cornered the market for U.S. rights to produce of British scripts, they were responsible for most of the theatre-related copyright litigation in the 19th and early 20th century.

Boucicault, an Irish playwright who later became a U.S. citizen, claimed at least partial credit for persuading the U.S. Congress to enact the 1856 Dramatic Copyright Act during his initial tour of the States.¹³⁵ Boucicault may have had some role in acquainting home-grown authors of the differences between U.S. and European laws. The work of persuading Congress, though, appears to have been shouldered by American-born writers George Henry Boker, Robert Taylor Conrad and Robert Montgomery Bird, who convinced Senators Charles Sumner and William Seward to shepherd a bill through the Senate.¹³⁶ The 1856 Act gave the author or proprietor of a copyrighted work, or his heirs or assigns, “the sole right . . . to act, perform, or represent” the work.¹³⁷ As with its British counterpart, the act was initially invoked to vindicate the rights of authors’ assignees.¹³⁸

C. COMMON LAW RIGHTS

In another part of the forest, the 19th century also saw the rise of the American legal treatise.¹³⁹ Early treatises were essentially case digests, but their authors began to view their task more ambitiously. 19th century legal treatises sought to organize and explicate entire regions of law, usually by aligning their principles with the principles of natural law.¹⁴⁰ The first U.S. copyright treatise is usually deemed to be Curtis’s.¹⁴¹ Curtis articulated a

135. See Dion Boucicault, *Leaves from a Dramatist’s Diary*, 149 N. AM. REV. 228, 230 (1889). Oren Bracha doubts that Boucicault had much to do with it. See Bracha, *supra* note 132. Bracha notes that contemporary sources credit playwrights George Henry Boker, and Robert Montgomery Bird and New York Senator William Henry Seward as the forces behind the amendment. *Id.* Dr. Bird wrote to Boker in 1853 to encourage his efforts to persuade Congress to enact a dramatic copyright bill, but it is unlikely that he was directly involved in drafting the bill. Bird’s health was poor, and he died in 1854. See FOUST, *supra* note 130, at 147–50 (reprinting letter); *id.* at 150–52 (describing Bird’s final illness and death). Bracha speculates, however, that Bird might have been behind an 1841 effort to secure performance rights for playwrights. Bracha, *supra* note 132. Boucicault also claimed to have established the entitlement of European playwrights to royalties for performances of their plays. See Boucicault, *supra*, at 229.

136. See KITTS, *supra* note 129, at 118–26; *Dramatic Copyright*, N.Y. TIMES, Aug. 1, 1856, at 4.

137. Act of Aug. 18, 1856, 11 Stat. 138, 139.

138. See, e.g., *Martinetti v. Maguire*, 16 F. Cas. 920 (C.C.D. Cal. 1867); *Roberts v. Myers*, 20 F. Cas. 898 (C.C.D. Mass. 1860).

139. A.W.B. Simpson, *The Rise and Fall of the Legal Treatise: Legal Principles and the Forms of Legal Literature*, 48 U. CHI. L. REV. 632, 671–74 (1981).

140. *Id.*

141. CURTIS, *supra* note 89. Curtis’s treatise was later plagiarized by the British treatise author Walter A Copinger, who liberally incorporated Curtis prose into his 1870 book, COPINGER’S LAW OF COPYRIGHT. See *id.*; Ronan Deazley, *Commentary on Copinger’s Law of Copyright (1870)*, PRIMARY SOURCES ON COPYRIGHT (1450–1900) (L. Bently & M. Kretschmer eds., 2008), <http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/>

natural rights basis for literary property, deriving from the author's initial exclusive possession of the work that he created. Curtis insisted, however, that the right was inherently limited to "the exclusive multiplication of copies of that particular combination of characters, which exhibits to the eye of another the ideas that he intends shall be received."¹⁴² The legislative truncation of its term (from forever to a term of years) was appropriate, he wrote, because after two or three generations, administering it would be too difficult for society to tolerate.¹⁴³ Curtis also thought that a dramatist's common law right in a published play would not extend to "the sole right of presentation upon the stage."¹⁴⁴

The first reported American cases claiming common law performance rights in plays followed the enactment of a statutory performance right for dramatic works and were initially cast as copyright suits brought under the provisions of the 1856 Act. Plaintiffs claimed copyrights in their plays, but had failed to satisfy the statutory prerequisites. The earliest cases excused the failure to meet statutory formalities,¹⁴⁵ but later courts held that the statute's performance right was available only for properly registered works that met all statutory requirements.¹⁴⁶

Dion Boucicault followed the practice of registering and depositing the title page of his plays without publishing his scripts.¹⁴⁷ In England, this would

ausgabeCom/%22uk_1870%22. Because negotiations on international copyright protection had stalled, there was not yet anything illegal about such appropriation.

142. CURTIS, *supra* note 89, at 13.

143. *Id.* at 24.

144. *Id.* at 104.

145. *See* Roberts v. Myers, 20 F. Cas. 898, 899 (C.C.D. Mass. 1860).

146. The 1831 Copyright Act made copyright available to authors who were U.S. citizens or residents, or the authors' assigns, upon recording of the title of the work, deposit of the title page before publication, publication, payment of a fifty-cent recording fee, notice inserted on the title page of all published copies, and deposit within three months of publication of a copy of the work with the clerk of the court. Act of Feb. 3, 1831, at ch. 16, 4 Stat. 436 §§ 1, 4, 5. Congress replaced the 1831 Act with the general revision of 1870. The major innovations of the 1870 Act were transferring registration and recording functions from the clerks of the courts to the Library of Congress, and expanding copyright rights to allow authors to reserve the exclusive right to dramatize or translate their own works. Copyright remained available only to authors (or the assigns of authors) who were U.S. citizens or residents, and continued to require recordation, a fifty-cent fee, publication, deposit, and notice as prerequisites. Act of July 8, 1870, ch. 230, 16 Stat. 198 §§ 86, 90, 92, 93, 97.

147. *See, e.g.*, Boucicault v. Wood, 3 F. Cas. 988 (C.C.N.D. Ill. 1867); Boucicault v. Fox, 3 F. Cas. 977 (C.C.S.D.N.Y. 1862); *see also supra* notes 134–35 and accompanying text. Dionysus Boucicault was an extremely prolific playwright born in Ireland who immigrated to the United States in the latter half of the 19th century. Copyright nerds know him as the author of *After Dark*, the play found to have plagiarized the railroad rescue scene from *Under*

have sufficed to secure statutory copyright.¹⁴⁸ In the United States, however, most courts ultimately insisted that the publication of printed copies was a condition of statutory copyright.¹⁴⁹ Early suits to enforce the new performance right succeeded even with defects in copyright registration. In *Roberts v. Myers*, the purported assignee of Dion Boucicault's copyright in *The Octoroon* sought a preliminary injunction under the 1856 Act to prevent an unlicensed production.¹⁵⁰ It transpired that Boucicault had registered the title page of the play with the clerk of the court, but neglected to deposit the required printed copies.¹⁵¹ Indeed, he had not yet published the play. Judge Sprague read the statutory language to permit him to grant the preliminary injunction: "The statute requires that such copy shall be deposited within three months after publication. That time has not arrived. There has been no publication."¹⁵²

In a later lawsuit over the same play, the judge expressed more concern that Boucicault had not perfected his statutory copyright.¹⁵³ Judge Shipman nonetheless read *Roberts v. Myers* to stand for the proposition that Boucicault could either rely on a statutory copyright or he could recover on the basis of common law rights in his unpublished manuscript.¹⁵⁴ In *Boucicault v. Hart*, however, Judge Hunt ruled the purported copyright registration of another Boucicault play invalid. The judge explained:

[T]o secure a copyright of a book or a dramatic composition, the work must be published within a reasonable time after the filing of the title page, and two copies be delivered to the librarian. These two acts are, by the statute, made necessary to be performed, and we can no more take it upon ourselves to say that the latter is not

the Gaslight. See *Brady v. Daly*, 175 U.S. 148 (1899); *Daly v. Webster*, 56 F. 483 (2d Cir. 1892); *Daly v. Palmer*, 6 F. Cas. 1132 (C.C.S.D.N.Y. 1868). Both Boucicault and Daly faced multiple charges of plagiarism in their careers. Many of their plays were adapted or revised versions of material written by others.

148. See *supra* note 43.

149. *Koppel v. Downing*, 11 App. D.C. 93 (1897); *Carillo v. Shook*, 5 F. Cas. 68 (C.C.S.D.N.Y. 1876); *Boucicault v. Hart*, 3 F. Cas. 983 (C.C.S.D.N.Y. 1875); *Benn v. LeClercq*, 3 F. Cas. 201 (C.C.D. Mass. 1873). But see *Roberts*, 20 F. Cas. at 899 (enjoining performance of unpublished script).

150. *Roberts*, 20 F. Cas. at 899.

151. *Id.* at 898–99.

152. *Id.* at 899.

153. *Boucicault v. Fox*, 3 F. Cas. 977 (C.C.S.D.N.Y. 1862).

154. *Id.* at 980–81.

an indispensable requisite to a copyright, than we can say it of the former.¹⁵⁵

Finding that Boucicault had failed to secure a copyright in his play, the court dismissed the case. Judge Hunt expressed the view that defendant had invaded Boucicault's "common law right of ownership in his dramatic composition." Because the parties were citizens of the same state, though, the federal court had no jurisdiction to grant the remedy to which Boucicault was entitled under common law.¹⁵⁶

Laura Keene, a New York actor-manager and the assignee of the American rights to Tom Taylor's *Our American Cousin*,¹⁵⁷ sued a competitor under the copyright statute to enjoin an unlicensed performance. The court found Keene's copyright invalid because it derived from an author who was neither a citizen nor a resident of the United States.¹⁵⁸ The court allowed Keene to recover damages on a breach of confidence theory: defendants had suborned one of Keene's actors and caused him to reveal all of the alterations Keene had made to the script and all of the stage business performed in her production.¹⁵⁹

As an alternative ground, the court suggested, Keene should be able to recover on a common law literary property theory.¹⁶⁰ The common law cause of action Judge Cadwalader announced was peculiarly cramped. If the proprietor of a play authorized publication, and the printed script enabled a competitor to mount an unlicensed performance, then, absent statutory copyright, the performance was not actionable. Similarly, if the proprietor

155. 3 F. Cas. 983, 986 (C.C.S.D.N.Y. 1875); *accord* Koppel v. Downing, 11 App. D.C. 93 (1897); Carillo v. Shook, 5 F. Cas. 68 (C.C.S.D.N.Y. 1876); Benn v. LeClercq, 3 F. Cas. 201 (C.C.D. Mass. 1873).

156. *Boucicault*, 3 F. Cas. at 987–88. The December 17, 1876 issue of the *New York Times* reports that the case settled out of court. *Court Notes*, N.Y. TIMES, Dec. 17, 1876, at 10.

157. The play is best known for being the play being performed at the Ford Theatre the night that John Wilkes Booth assassinated President Lincoln.

158. *Keene v. Wheatley*, 14 F. Cas. 180, 185, 191 (C.C.E.D. Pa. 1861). Taylor was British. Keene was not yet an American citizen but had been a U.S. resident for many years. She had registered the copyright under the title *Our Country Cousin*, in her own name as proprietor on October 2, 1858. *See* HENNEKE, *supra* note 129, at 91, 129–43. (Keene had also failed to publish the script as a printed book and deposit copies with the clerk of the court, but the judge excused that on the same reasoning adopted in *Roberts v. Myers*, *see Keene*, 14 F. Cas. at 185). Contemporary legal writers interpreted the opinion to hold that a resident alien could not copyright the works of a non-resident alien. *See* James Appleton Morgan, *An International Copyright Law*, 3 FORUM 35, 37–38 (1875). Professor Henneke claimed that the case motivated Keene to become a naturalized US citizen to avoid future copyright problems. *See* HENNEKE, *supra* note 129, at 111.

159. HENNEKE, *supra* note 129, at 188.

160. *Keene*, 14 F. Cas. at 201–08.

authorized a public performance, and that performance enabled an unlicensed production, that production was lawful unless the proprietor had a valid statutory copyright in the script. Where, however the public performance was not what enabled the defendant to present an unauthorized production, the proprietor's reserved literary property rights would support a lawsuit.¹⁶¹

Keene then filed a state court action to enjoin a second unlicensed production of *Our American Cousin* at the Boston Museum, relying on Massachusetts common law.¹⁶² The state court cited Judge Cadwalader's analysis with approval, but dismissed the case nonetheless, holding that

[t]hese principles sustain the demurrer to the plaintiff's bill. She has publicly represented the play, *Our American Cousin*, before audiences consisting of all persons who chose to pay the price charged for admission to her theatre. She has employed actors to commit the various parts to memory; and unless they are restrained by some contract, express or implied, we can perceive no legal reason why they might not repeat what they have learned, before different audiences, and in various places. If persons, by frequent attendance at her theatre, have committed to memory any part or the whole of the play, they have a right to repeat what they heard to others. We know of no right of property in gestures, tones, or scenery, which would forbid such reproduction of them by the spectators as their powers of imitation might enable them to accomplish.¹⁶³

*Crowe v. Aiken*¹⁶⁴ involved a second Tom Taylor script, this one titled *Mary Warner*. Taylor wrote the play for the actress Kate Bateman, and

161. *Id.* at 207.

The case recapitulated stands thus: The complainant having the literary proprietorship of this comedy, but no statutory copyright in it, and having publicly performed it at her theatre, with an intention to continue its public performance there, the defendants, against her will, performed it repeatedly at their theatre, without having been, directly or secondarily, enabled so to do through its impression upon the memory of any of her audience. This was an infraction of a proprietary right retained by the complainant. Independently also of such right, she is entitled to redress, because the defendants enabled themselves to represent the play by knowingly taking advantage of a breach of confidence committed by a person in her employment.

Id.

162. *Keene v. Kimball*, 82 Mass. (16 Gray) 545 (1860).

163. *Id.* at 551.

164. 6 F. Cas. 904 (C.C.N.D. Ill. 1870).

assigned the U.S. stage rights to her husband.¹⁶⁵ After Bateman performed the play in London, she and her husband traveled to New York and performed the play there. Neither Taylor nor plaintiff's husband sought registration under the U.S. copyright statute, nor authorized the play's publication. Defendant purchased a copy of the script and sought to stage the play in Chicago. Bateman's husband sued to enjoin him, "based not upon any copyright statutes, but on the principles of the common law and of equity." Judge Drummond examined the copy of the script, and found it suspicious. "It is not in the usual form of a published play, but consists of printed slips fastened together in pamphlet form, with plats and stage directions as if for dramatic use only."¹⁶⁶ Concluding that the defendant's script was created in some unauthorized or wrongful way, and not by memory only, the court entered a preliminary injunction.¹⁶⁷

Finally, in 1878, a New York trial court enjoined a San Francisco production of an unpublished English adaptation of a French play at the behest of the assignee of the assignees of the British adapters, relying on the common law rights attaching to unpublished manuscripts.¹⁶⁸

Copyright Office records before 1978 are neither as complete nor as reliable as one might wish,¹⁶⁹ but a Copyright Office publication listing every dramatic composition registered between 1870 and 1916 suggests that many dramatists may have sought to register their copyrights without publishing

165. Why the husband? Parliament didn't enact the Married Women's Property Acts until later. *See* Married Women's Property Act, 1870, 33 & 34 Vict., c. 93 (Eng.); Married Women's Property Act, 1882, 45 & 46 Vict., c. 75 (Eng.).

166. *Id.* at 905.

167. *Id.* at 907. The rule that it was not copyright infringement to reproduce a script from memory (as distinguished from stenography or purloined parts) persisted, showing up in statutory as well as non statutory play right cases. *See, e.g.*, Shook v. Rankin, 21 F. Cas. 1337 (C.C.D. Minn. 1875). The durability of the rule supports an inference that many 19th century courts continued to view copyright as conferring rights related to making and distributing material objects rather than rights in intangible works of authorship. For a different piece of evidence supporting that inference, see Edward S. Rogers, *The Law of Dramatic Copyright*, 1 MICH. L. REV. pt. 2, 179, at 184 (1902) ("The reason why public performance of an unpublished uncopyrighted play is not a dedication, may be very briefly stated: The author does not part with his manuscript, and no copies are made so that the public can have access to the work itself.")

168. French v. Maguire, 55 How. Pr. 471 (N.Y. Sup. Ct. 1878). The plaintiff, Samuel French, founded the Samuel French dramatic licensing agency in 1830. *See* SAMUEL FRENCH, INC., <http://www.samuel french.com> (last visited July 31, 2010). Other cases during this time frame upheld common law first printing rights for unpublished manuscripts. *See, e.g.*, Palmer v. DeWitt, 47 N.Y. 532 (1872) (upholding an injunction against the printing of an unpublished play).

169. *See* Robert Brauneis, *Copyright and the World's Most Popular Song*, 56 J. COPR. SOC'Y 335, 423–26 (2009).

their scripts, despite the fact that the statute did not permit it until 1909. The preface explains:

Under the legislation in force from July 8, 1870 to July 1, 1909, it was customary to file the title-page of the drama in advance of the deposit of copies and subsequently deposit the required copies. The result has been that a great many titles were filed for registration which were not followed by the deposit of copies. This was especially so in the case of dramas, and it is estimated that in more than 20,000 cases, while the title has been recorded, no copies have been received.¹⁷⁰

We don't know how many of those 20,000 plays were claimed by authors or proprietors who didn't know they needed to print, publish and deposit copies to perfect their rights, how many were deliberately not published to discourage unlicensed performance, and how many simply went through a title change before they were finalized. It seems likely, though, that Boucicault, Keene, and Bateman were not alone in believing themselves to have secured federal copyright protection.¹⁷¹

Thus, by the late-1870s, the health of a common law public performance right in plays was not yet robust. The claim that common law literary property extended far enough to permit dramatists and their assigns to control public performances had initially been raised as an afterthought to failed statutory copyright claims.¹⁷² Courts had recognized common law performance rights where statutory copyrights were defective, but cabined them with odd limits. Few cases had arisen, and no general rule had yet

170. 1 LIBRARY OF CONG. COPYRIGHT OFFICE, DRAMATIC COMPOSITIONS COPYRIGHTED IN THE UNITED STATES 1870 TO 1916, at i (1918).

171. See also *Frankel v. Irwin*, 34 F.2d 142, 143 (S.D.N.Y. 1918) (dismissing suit for infringement of "unprinted play, copyrighted in 1901" on other grounds).

172. During the same fifteen-year time period, only five reported cases with copyrights adjudged to be satisfactory sought to vindicate the 1856 performance right for plays. Three of the five involved unpublished Dion Boucicault plays. See *Boucicault v. Wood*, 3 F. Cas. 988 (C.C.N.D. Ill. 1867); *Boucicault v. Fox*, 3 F. Cas. 977 (C.C.S.D.N.Y. 1862); *Roberts v. Myers*, 20 F. Cas. 898, 899 (C.C.D. Mass. 1860). One, the infamous *Daly v. Palmer*, 6 F. Cas. 1132 (C.C.S.D.N.Y. 1868), involved a copyright in a published play claimed by an American playwright. The fifth involved a translation of a French play that appears not to have been published in print. The assignees of the copyright produced a copyright certificate and an assignment from the copyright proprietor, and neither defendants nor the court appear to have raised the issue of invalidity due to the failure of the registrant to publish and deposit copies. See *Shook v. Rankin*, 21 F. Cas. 1337 (C.C.D. Minn. 1875). Evidence from published copyright office records suggests that many playwrights and their assignees continued to register the title of their plays without perfecting their copyright with publication and deposit of copies. See *supra* text accompanying note 170.

presented itself.¹⁷³ Eaton Sylvester Drone, though, was about to publish a magisterial treatise that would change that.

D. EATON DRONE'S NATURAL LAW PLAY RIGHT

Thirty years after Curtis's treatise, Eaton Drone published his thicker treatise. His goal was more ambitious than Curtis's:

The task of the juridical writer is to set forth the true principles which govern the law; to point out the proper meaning of the statutes; to show what decisions are rights and what are wrong; to explain what is doubtful or obscure; and, generally, to give the law in a form as true, clear, systematic and harmonious as it is in his power to do. He is without authority to say what construction shall be given to statutes, and he is without power to overrule erroneous decisions. But he may point out the true meaning of the law, and show wherein it has been wrongly interpreted. When this has been done, the judicial affirmance of what is right and the rejection of what is wrong will be in many cases but a question of time.¹⁷⁴

Drone's view of the scope of copyright law was more capacious than the narrow right described by Curtis.¹⁷⁵ Drone's theory was that literary property rights were natural rights, and, as such, both perpetual and without limitation.¹⁷⁶ Such rights could be expressly abrogated by statute, but not by courts.¹⁷⁷ Beginning with the premise that the author's natural right to his literary property comported with the best theoretical principles and had not been effectively disproved by its doubters, he then considered whether proponents of any restriction of those common law rights had made an effective case for the validity of the limitation.¹⁷⁸ Drone rejected as ill-reasoned cases like *Donaldson v. Beckett*,¹⁷⁹ *Wheaton v. Peters*,¹⁸⁰ and *Stowe v. Thomas*.¹⁸¹ Unfortunately, he explained, the British Parliament had abrogated playwrights' common law rights in England by declaring that public

173. See generally MORGAN, *supra* note 89, at 267–370 (summarizing cases); Herman F. Selvin, *Should Performance Dedicate?*, 42 CALIF. L. REV. 40, 48–50 (1954).

174. DRONE, *supra* note 1, at vii.

175. Compare, e.g., *id.* at 2–26, with CURTIS, *supra* note 89, at 5–25.

176. DRONE, *supra* note 1, at 8–20, 101–15.

177. *Id.* at 20–26, 116–27.

178. See, e.g., *id.* at 22–26, 47–53; see also R.R. BOWKER, COPYRIGHT: ITS LAW AND LITERATURE 2 (1886) (“Property right in unpublished works has never been effectively questioned—a fact which in itself confirms the view that intellectual property is a natural inherent right.”).

179. (1774) 1 Eng. Rep. 837; see DRONE, *supra* note 1, at 42–43.

180. 33 U.S. 591 (1834); see DRONE, *supra* note 1, at 43–48.

181. *Stowe v. Thomas*, 23 F. Cas. 201 (C.C.E.D. Pa. 1853); see DRONE, *supra* note 1, at 450–55.

performance amounted to publication.¹⁸² The United States Congress, however, had not yet done any such thing, and indeed, the *Octoroon* case had held that performance is not publication.¹⁸³ Thus, Drone argued, common law play right survived in all its glory.¹⁸⁴

Drone's treatise sought to be comprehensive. It was nearly 800 pages long, and cited and discussed most of the copyright cases ever decided. Drone, did not, however, rely on judicial reasoning to tell him what the law was. Rather, he derived what the law should be from first principles of natural law, and then criticized the cases that departed from it.¹⁸⁵ That allowed him to expound on the proper scope of common law play right, and the proper scope according to Drone was exceptionally broad.¹⁸⁶

Here, for example, is Drone on the effect of public performance on common law rights:

The true principle which governs the question relating to the effect of public representation on the owner's exclusive rights in a manuscript dramatic composition has been wholly overlooked in the recent judicial discussions of the subject. If such rights are lost, restricted, or prejudiced by public representation, it must be either by force of the common law or by operation of some statute. It has been shown elsewhere in this work that by the common law no rights in an intellectual production are forfeited by a publication of any kind. The property in a literary work is not, by the common law, prejudiced even by its publication in print. As far as the common law is concerned, the owner's rights are the same after publication in print as they were before. The now settled doctrine that there can be no copyright after publication except under the statute is based on the ground, not that publication is by the common law an abandonment of the author's rights, but that the common law property in a published work is taken away by operation of the statute.

182. DRONE, *supra* note 1, at 575–76.

183. *Id.* at 555 (citing *Boucicault v. Fox*, 3 F. Cas. 977 (C.C.S.D.N.Y. 1862)).

184. DRONE, *supra* note 1, at 573–74. Common law play right cases, Drone cautioned, could be brought only in state court unless diversity existed. *Id.* at 585.

185. Thus, Drone spent four pages discussing opinions stating that it was lawful to perform a play if one reproduced it entirely from memory, DRONE, *supra* note 1, at 558–62, and seven pages refuting the reasoning underlying the distinction, *id.* at 566–72.

186. *E.g., id.* at 565–74, 582–84. Contemporary reviews criticized Drone for elevating his own theories over judicial decisions. See *Culture and Progress: Drone on Copyright*, 17 SCRIBNERS MONTHLY 911 (Feb. 1879) (“Mr Drone has no slavish reverence for precedents; he reverses decisions right and left.”); *Mr. Drone's Treatise on Copyright*, 6 INT'L REV. 699, 702 (1879) (“The chief difficulty . . . is that he does not, for a lawyer, sufficiently distinguish between his own views of what the law ought to be and what the courts have declared it to be.”).

It is then clear, both on principle and authority, that the property in a manuscript play is not injuriously affected by authorized public representation, unless by the operation of some statute. Now, in the United States, there is no statute which can have this effect, because there has been no legislation relating to manuscript dramatic compositions. Statutory playwright is secured in published compositions alone, and representation is not publication within the meaning of the statute. When a dramatic composition is published in print, the owner's common-law rights are destroyed by operation of the statute, to which he must look for protection. But property in a manuscript play is governed exclusively by the common law, and is in no wise affected by any statute. Hence in the United States, the owner's rights in a manuscript play are not prejudiced by its authorized public representation.¹⁸⁷

Armed with Drone's analysis, the proprietors of scripts filed suit in state court (claiming ownership by assignment of playwright's rights).¹⁸⁸ Courts followed Drone. Drone originated the name of "playright." He also invented its scope.¹⁸⁹

In *Tomkins v. Halleck*,¹⁹⁰ the Massachusetts Supreme Court reexamined its ruling in *Keene v. Kimball*, and overruled it.¹⁹¹ Orlando Tompkins, one of the managers of the Boston Theatre, purchased the exclusive right to present a British melodrama in New England from its New York producer, who had bought American rights and commissioned a revision to suit American audiences.¹⁹² During the play's New York run, two individuals ("one Byron and one Mora") attended the play repeatedly. Byron memorized as much as

187. DRONE, *supra* note 1, at 574.

188. Drone advised that the owner of the common law playwright in an unpublished play could transfer his or her rights "either in whole or in part . . . by parol." *Id.* at 581.

189. Thus Drone concluded, on the basis of reasoning not clear to me, that the authorized print publication of a manuscript play *anywhere in the world* would abrogate the common law play right of a U.S. rights holder who purchased his exclusive rights prior to the publication. *See* DRONE, *supra* note 1, at 577–83. When such a case arose, the New York State court followed Drone, and held that the common law rights in the manuscript play had been destroyed by a subsequent German publication. *Daly v. Walrath*, 57 N.Y.S. 1125 (App. Div. 1899).

190. 133 Mass. 32 (1882).

191. *Id.* at 46.

192. *The World*, a melodrama by Paul Merrit, Henry Pettit, and Augustus Harris, received an elaborate production that ran from March 21, 1882, for eleven weeks. Orlando Tompkins was the senior manager of the Boston Theatre. EUGENE TOMKINS, *THE BOSTON THEATRE 1854–1901*, at 290 (1908). Thomas Halleck was the proprietor of the Alhambra Theatre, also in Boston. DONALD C. KING, *THE THEATRES OF BOSTON: A STAGE AND SCREEN HISTORY* 67–68 (2005).

he could, and dictated his recollection to Mora.¹⁹³ Byron sold the resulting script to Thomas Halleck, who produced it at his Alhambra Theatre. Tompkins filed suit in state court against Halleck, who insisted that reproducing a script from memory, as Byron and Mora had done, was expressly permitted by *Keene v. Kimball*. Noting Drone's objection that the privilege to reproduce from memory made no sense, the court repudiated the exception.¹⁹⁴

The most Drone-ish common law play right decision is the United States Supreme Court's opinion in *Ferris v. Frohman*, decided in 1912.¹⁹⁵ The case concerned a melodrama, *The Fatal Card*, written by British authors Charles Haddon Chambers and BC Stephenson, performed in London in September of 1894. The authors registered their British copyright in the play in November of 1894 at Stationers Hall. American manager Charles Frohman bought the rights of one of the coauthors, and produced it first in New York and then as a touring production.¹⁹⁶ George MacFarlane adapted the British play and sold it to theatre manager Richard Ferris, who registered the copyright in the adaptation.¹⁹⁷ Ferris's production of the MacFarlane

193. *Tompkins*, 133 Mass. at 32.

194. *Id.* at 43–44.

195. *Ferris v. Frohman*, 223 U.S. 424 (1912) (applying pre-1909 Act law).

196. *See New Bills of the Week*, N.Y. TIMES, Dec. 30, 1894, at 10; *The Fatal Card Tonight*, DAILY KENNEBEC J., Dec. 1, 1895, at 1, col. 4; *Theatrical Gossip*, N.Y. TIMES, Jan. 14, 1895, at 8. Ultimately, Frohman licensed the script to the Famous Players Film Company, who made it into a motion picture starring John Mason and Hazel Dawn. *See The Fatal Card*, THE INTERNET MOVIE DATABASE, <http://www.imdb.com/title/tt0005305/> (last visited Mar. 4, 2010).

197. There is no indication in any of the reported opinions that Ferris actually published the MacFarlane adaptation, so his copyright may have been defective on that ground as well as on the ground that it infringed Frohman's common law rights. *See* text accompanying *supra* note 146. According to the special master, the MacFarlane adaptation changed the original script in many ways, and renamed all of the characters, but retained substantial parts of the original plot and dialogue. *Ferris v. Frohman*, 131 Ill. App. 307, 307 (1907), *rev'd*, 87 N.E. 327 (Ill. 1909), *aff'd*, 223 U.S. 424 (1912). Adapting European scripts for the American stage without permission of the original plays' owners was common throughout the 18th and 19th centuries, *see supra* notes 128–29 and accompanying text, and nothing in the American copyright statute made it illegal unless the plays had been validly registered in the United States (which became possible in 1891, under the Chace Act, *see infra* note 213 and accompanying text). Ferris's brief to the U.S. Supreme Court made this argument at some length. *See* Brief for Petitioner-Appellant in Error at 40–68, *Ferris v. Frohman*, 223 U.S. 424 (1912) (No. 44). Frohman's brief argued that the common law performing right was subject to no such exceptions, and that the only issue for decision was whether the public performance of the play in England forfeited its common law copyright protection worldwide. Brief of Respondant-Appellee in Error at 13–37, *Ferris v. Frohman*, 223 U.S. 424 (1912) (No. 44).

adaptation toured the Midwest to enthusiastic reviews.¹⁹⁸ Frohman filed suit in Illinois state court to enjoin Ferris's production on the basis of his common law play right. The trial court referred the case to a special master, who recommended a verdict for the defendant.¹⁹⁹ The trial court instead found for Frohman, entered an injunction and ordered an accounting of profits.²⁰⁰

Ferris appealed, and the court of appeals reversed.²⁰¹ The appellate court reasoned that since British law treated public performance as equivalent to publication, the public performance of the play in London had terminated the authors' common law rights, and left them with only their statutory copyright. The authors, therefore, had no common law rights to sell to Frohman.²⁰²

Frohman appealed, and the Illinois Supreme Court reversed.²⁰³ The court held, relying on *Drone*, that at common law, an author had "an absolute property right in his production which he could not be deprived of so long as it remained unpublished, nor could he be compelled to publish it."²⁰⁴ Statutory copyright, however, remained unavailable to works that had not been printed and published. Since there was no provision for securing copyright for unpublished plays, common law protection remained available and was not waived by public performance.²⁰⁵ Ferris appealed to the U.S.

198. See, e.g., *Another Big Hit: The "Fatal Card" Proves the Strongest Play Yet Seen at Low Prices*, CEDAR RAPIDS REPUBLICAN, Aug. 30, 1900, at 1, col. 3.

199. See *Ferris*, 131 Ill. App. at 308–09.

200. See *Ferris*, 223 U.S. at 430.

201. *Ferris*, 131 Ill. App. at 314.

202. *Id.* at 312–14:

When the authors published the play at the Adelphi Theatre, London, it was with their consent, as the record shows, That act was done and assented to under the law there in force, which expressly provided that it should be the legal equivalent "to the first publication of any book."

....

It follows, we think, that the English authors of this play had no property rights in the United States, which they could confer upon the appellee, Frohman . . . at any time subsequent to the publication in London. We are, therefore, of the opinion that appellees, complainants below, failed to establish an exclusive right to produce the play in the United States . . .

203. *Ferris*, 87 N.E. at 332.

204. *Id.* at 328 (citing *DRONE*, *supra* note 1, at 101 *et. seq.*).

205. *Id.* (citing *DRONE*, *supra* note 1, at 119). The 1909 Act made it possible for the first time to register copyright in an unpublished play. See *infra* note 215 and accompanying text. The facts of the Frohman case preceded the enactment of the 1909 Act, even though the Supreme Court's eventual decision was handed down three years later. Nothing in the language of Justice Hughes' opinion, however, suggests that the unavailability of statutory copyright for unpublished works before 1909 figured in the U.S. Supreme Court's reasoning.

Supreme Court, which, in a unanimous opinion by Justice Hughes, affirmed.²⁰⁶

The basis for the Supreme Court's jurisdiction was not straightforward. The Illinois Supreme Court had decided the case entirely as a matter of Illinois state common law, and Frohman objected that the appeal raised no federal question.²⁰⁷ Justice Hughes held, however, that the fact that Ferris had registered a copyright in MacFarlane's adaptation provided a federal basis for appellate jurisdiction, because the decision denied Ferris a right otherwise secured by federal copyright law.²⁰⁸ Beginning with the observation that "[i]t is not open to dispute that the authors of 'The Fatal Card' had a common law right of property until it was publicly performed," the Court held that neither the English performance nor the English statute had forfeited that right. "The public representation of a dramatic composition, not printed and published, does not deprive the owner of his common law right, save by operation of statute. At common law, the public performance of the play is not an abandonment of it to the public use."²⁰⁹

The British statutes, the Court continued, did not affect common law rights in the United States, so the authors were free to convey it to Frohman.²¹⁰ That being the case, MacFarlane's adaptation "was simply a piratical composition," and not entitled to federal copyright protection.²¹¹

As Drone had, the Court began with the premise that authors had unqualified common law rights and asked whether something had happened to take those rights away.²¹² Finding that no statute had done so, the Court skipped right past the question of the appropriate scope of the common law right to the determination that defendants had necessarily invaded it.

Common law play right was a kluge. Courts had invented it to fill gaps in statutory protection, which applied only to printed, published works by United States citizens or residents. Drone expanded it because it represented a nearly blank canvas on which to paint his theories of the appropriate scope of natural-law based common law literary property. Courts followed Drone both because his treatise seemed comprehensive and because they were

206. *Ferris v. Frohman*, 223 U.S. 424 (1912).

207. *Id.* at 430–31.

208. *Id.* at 431.

209. *Id.* at 434–35.

210. *Id.* at 436–37.

211. *Id.* at 437. None of the published opinions in the case addressed the similarities between the original script and the MacFarland adaptation, so it is difficult to know whether Ferris's "piratical composition" was more similar to Frohman's than the successful Daly and Boucicault adaptations had been similar to their European antecedents.

212. *Id.* at 434–37.

drawn, during the period, to the concept of a theoretically coherent body of natural law that expressed itself in the particulars of common law. Congress, however, had already begun to address the gaps that had made common law play right seem necessary.

In 1891, after heavy and long lobbying by playwrights, Congress passed the Chace international copyright bill, extending copyright to foreign nationals so long as they complied with statutory procedures still including registration, publication with notice, and deposit of copies.²¹³ In 1897, Congress passed a law imposing criminal penalties for unauthorized public performance of dramatic or musical compositions.²¹⁴ In 1909, in connection with the general revision of copyright, Congress finally enacted a provision enabling the author or proprietor of a dramatic composition not reproduced for sale to secure federal copyright protection through registration and deposit.²¹⁵ Thus, the United States had finally added to its law the sort of provisions that playwrights argued were necessary to protect their work. For dramatists who preferred it, moreover, there was the potentially boundless and perpetual protection of common law play right a la Eaton Drone.²¹⁶

E. WHOSE PLAY RIGHT?

The reader who has been paying attention will have noticed that very few of the complainants in the cases thus discussed were actual playwrights.²¹⁷ Both common law and statutory claims were pressed on behalf of proprietors who bought all rights from authors, typically for a flat fee. Except for playwrights who managed their own theatre companies, neither American nor European dramatists controlled the American rights to their plays.²¹⁸ By the early 20th century, the law may have become playwright-friendly, but customary theatre practice had not.

213. Act of Mar. 3, 1891, ch. 565, 26 Stat. 1106.

214. Act of Jan. 6, 1897, ch. 4, 29 Stat. 481.

215. Act of Mar. 4, 1909, § 11, 35 Stat. 1075, 1078. The 1909 Act also expressly preserved the right of an “author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent.” *Id.* § 2.

216. *See, e.g.*, *O’Neill v. Gen. Film Co.*, 157 N.Y.S. 1028 (App. Div. 1916).

217. Two of the more litigious claimants, Augustin Daly and Dionysus Bouciault, were in fact playwrights some of the time, but they were also theatre managers. And Daly, although apparently terrifically prolific, appears not to have written many of the plays that he claimed. *See generally* MARVIN FELHEIM, *THE THEATER OF AUGUSTIN DALY: AN ACCOUNT OF THE LATE NINETEENTH CENTURY AMERICAN STAGE* 122–40, 144, 220–22 (1956) (identifying some of Daly’s unattributed collaborators).

218. *See, e.g.*, WALSH, *supra* note 129, at 32–34 and sources there cited.

By the end of the 19th century, theatre managers had discovered that rather than maintaining a stock company to present a season of plays in repertory at a single theatre, it was more profitable to open a show in New York City with a bankable star, run it until audience attention flagged, and then tour it to cities throughout the country.²¹⁹ The principal actors and the scenery would need to be transported from city to city, but the managers of local houses could provide extra actors and crew.²²⁰ Under this model, the economics of an efficient touring route became more important than the script, which was often merely a vehicle for the bankable star of the day. Theatrical producers focused on leasing or purchasing theatres in cities to facilitate lucrative tours. Charles Frohman allied himself with producers Abe Erlanger, Marc Klaw, Al Hayman, Samuel Nixon, and Fred Zimmerman to pool their theatres into a national chain and book tours through a central office.²²¹ Within a short time, the syndicate had an effective monopoly over American play houses, and began to demand concessions from actors, copyright owners, rival managers, and booking agents.²²² Unhappy managers formed a splinter association of producers headed by the Shubert brothers to do battle with the trust.²²³ Both groups competed by acquiring and building new playhouses, investing in vaudeville and novelty attractions, and seeking the allegiance of each others' members.²²⁴ By the time of the first World War, there were a glut of theatres, and too few attractions to fill them.²²⁵

Empty playhouses and demand for more economical entertainment helped motion pictures eclipse live theatre more quickly than anyone would have believed possible.²²⁶ Movies had two huge advantages over stage productions: they appealed to broader audiences and their tickets were much

219. See BERNHEIM, *supra* note 123, at 28–31; OWEN DAVIS, MY FIRST FIFTY YEARS IN THE THEATRE 27–41 (1950); HENNEKE, *supra* note 129, at 84–96, 175–92; JERRY STAGG, THE BROTHERS SHUBERT 14–16 (1968).

220. See BERNHEIM, *supra* note 123, at 28–29, 34–37.

221. See *id.* at 40–50; WALSH, *supra* note 129, at 19–31.

222. See BERNHEIM, *supra* note 123, at 44–63; GLENN HUGHES, A HISTORY OF AMERICAN THEATRE 1700–1950, at 317–18 (1951); GEORGE MIDDLETON, THESE THINGS ARE MINE: THE AUTOBIOGRAPHY OF A JOURNEYMAN PLAYWRIGHT 53–55 (1947); STAGG, *supra* note 219, at 16–17, 29–51; Sean P. Holmes, *All The World's a Stage! The Actors' Strike of 1919*, 91 J. OF AM. HIST. 1291, 1292–95 (2005); Steve Travis, *The Rise and Fall of the Theatrical Syndicate*, 10 EDUC. THEATRE J. 35 (1958).

223. See BERNHEIM, *supra* note 123, at 64–67.

224. See *id.* at 67–74.

225. See *id.* at 75–84.

226. See *id.* at 85–92; HUGHES, *supra* note 222, at 319; MIDDLETON, *supra* note 222, at 374–76.

cheaper.²²⁷ By the 1920s, the motion picture industry had triumphed, and, at least outside of New York City, theatre was already in decline.²²⁸

The war between the syndicate and the independent producers, meanwhile, had not been kind to working conditions for actors or playwrights.²²⁹ The commercial producers' focus on theatre buildings and famous stars had led to steady erosion in the perceived importance of ordinary actors and dramatists, and their bargaining power as individuals was modest.²³⁰ In 1919, New York City actors formed a union, and, in August they went on strike, paralyzing Broadway theaters for a month.²³¹ When performances resumed, the Actors Equity Association had managed to negotiate a minimum contract for its members. In response, playwrights formed a labor union of their own, and started talking about persuading producers to accept a minimum dramatists' contract.²³² They compared the different contracts that they had signed, and found wide variation. Some playwrights wrote scripts as works made for hire, or were required to invest their own money in productions of their plays.²³³ The Charles Frohman Company insisted on the playwright's ceding at least half of the stock performance and motion picture rights and performance rights in any music.²³⁴ Many producers felt no compunction about rewriting lines or miscasting roles. Yet efforts to persuade playwrights to band together to insist on better pay or more artistic control had so far failed.²³⁵

What brought matters to a head was the question of what we now refer to as subsidiary rights. Producers insisted on controlling licensing of the plays they purchased and sharing any earnings after its initial production.²³⁶ They were particularly eager to sell their scripts to the new movie industry. The

227. BERNHEIM, *supra* note 123, at 88.

228. *See id.* at 85–92; BARNARD HEWITT, *THEATRE U.S.A.* 383 (1959); MIDDLETON, *supra* note 222, at 376–77.

229. *See* MIDDLETON, *supra* note 222, at 45, 53, 60, 68–70, 138–39 (describing problems for playwrights); WALSH, *supra* note 129, at 32–34 (describing problems for playwrights); Holmes, *supra* note 222, at 1293–95 (describing poor working conditions for actors).

230. *See* BERNHEIM, *supra* note 123, at 67–79. Both the Syndicate and the Shubert allies had invested heavily in vaudeville to fill their theatres, *see id.* at 67–69, further diminishing the importance of dramatic actors and scripts.

231. *See* HUGHES, *supra* note 222, at 377; Holmes, *supra* note 222, at 1299–1315.

232. *See* Thomas James Walsh, *Playwrights and Power: The Dramatists' Guild Struggle for the 1926 Minimum Basic Agreement*, in ART, GLITTER AND GLITZ: MAINSTREAM PLAYWRIGHTS AND POPULAR THEATRE IN 1920S AMERICA 107, 108–113 (Arthur Gewirtz & James J. Kolb eds., 2004).

233. *See id.*; MIDDLETON, *supra* note 222, at 311–13.

234. *See* Walsh, *supra* note 232 at 108–09.

235. *See* MIDDLETON, *supra* note 222, at 304–09.

236. *See* Walsh, *supra* note 232, at 107–09.

Fox Film Corporation approached several major producers, offering to pay the producers a salary in return for giving Fox both a say in the plays they produced and an option to purchase the movie rights.²³⁷ Playwrights argued that if they did not gain control of their copyrights, the only plays any theater would be willing to produce would be the plays that seemed suitable for film.²³⁸ They devised a minimum basic agreement under which the dramatist would keep the copyright to the play and creative control of the production; the producer would agree to pay a royalty in the form of a percentage of the gross box office receipts from the production; and the author would receive not less than half of the proceeds from a motion picture sale. The dramatists agreed with one another that they would refuse to give permission to stage any of their scripts to a producer who did not agree that henceforth, he would use the minimum contract for all American dramatists and all New York productions.²³⁹ Producers objected to the playwrights' insistence on copyright ownership and creative control.²⁴⁰ After a significant amount of blustering, and some preliminary skirmishing in court,²⁴¹ though, the producers agreed.²⁴²

Why did the producers go along? Both the idea that theatrical entertainment was exempt from the antitrust laws and the claim that the Dramatists Guild should be treated as a labor union were more colorable in the 1920s than they are today.²⁴³ The majority of established playwrights insisted they would refuse to sign any production contract with a manager who had not agreed to be bound by the Guild's minimum basic agreement

237. *See id.* at 108–10.

238. *See* MIDDLETON, *supra* note 222, at 308. Other developments had exacerbated the problem. In 1910, *Dam v. Kirk La Shelle Co.*, 175 F. 902 (2d Cir. 1910), had held that the initial assignee of a copyright was the sole copyright owner, and that an author could not, consistently with the statute, assign some exclusive rights but retain others. Under this ruling, copyrights were not divisible and the first producer of a play claimed not only the public performance rights, but the book publishing and motion picture rights as well. *See Copyrights: Hearings on H.R. 11258 Before the H. Comm. on Patents*, 68th Cong. 45, 48 (1925) (statement of Ellis Parker Butler, Authors' League of America).

239. *See* MIDDLETON, *supra* note 222, at 298–331.

240. *See* WALSH, *supra* note 129, at 114–19.

241. *See Shuberts Seek Stay on Authors' Guild: Producers to Carry Fight on "Tyrannical" Practices to Supreme Court Monday*, N.Y. TIMES, Apr. 23, 1927, at 15; *Shuberts Start War on Dramatists: Ask Injunction Against Guild Charging Secondary Boycott*, N.Y. TIMES, Apr. 22, 1927, at 9.

242. *See* MIDDLETON, *supra* note 222, at 322–32; STAGG, *supra* note 219, at 250.

243. *See* Hart v. B. F. Keith Vaudeville Exch., 12 F.2d 341, 344 (2d Cir. 1926) (dismissing antitrust suit against agent for vaudeville performers because “the business of acting in a theater is purely a state affair”); *People v. Klaw*, 106 N.Y.S. 341, 354 (Crim. Ct. 1907) (dismissing antitrust indictment because “I have failed to find any decision, nor has my attention been directed to any decision, classifying theatrical amusements as articles of ‘trade’ and ‘commerce.’”)

(“MBA”).²⁴⁴ The actors’ strike had demonstrated that collective action could close theatres. The new infusion of money from movie studios was significant, playwrights would be necessary parties to the sale of new scripts to the film companies, and producers may have believed them when they threatened to withhold their work. Perhaps, even then, it was clear that the money involved in movies would eventually dwarf the money to be made from live theatre, and devising a way to share the proceeds from the sale of film rights seemed important enough to make compromises on issues of creative control and copyright ownership worthwhile. Or, it may be that playwright/producer relations were always friendlier and less antagonistic than actor/producer relations. A playwright could, after all, take the next play elsewhere.²⁴⁵ In any event, by the fall of 1927, all major commercial producers had agreed with the dramatists’ terms.

Ironically, the 1926–1927 season represented the historical peak for new play production on Broadway, with 188 new plays.²⁴⁶ Broadway productions of new plays have declined steadily since; in 2007–2008, only seven new plays opened on Broadway.²⁴⁷

The MBA was renegotiated in 1931, 1936, 1941, 1946, 1955, 1961, and 1985,²⁴⁸ but the essential terms remained the same. Playwrights keep ownership of their copyrights and creative control of stage productions of their scripts.²⁴⁹ Producers pay playwrights a minimum percentage of box office receipts.²⁵⁰ Producers and playwrights share subsequent earnings and split the receipts from sales of film rights.²⁵¹ There has been controversy, and

244. William Klein II, *Authors and Creators: Up By Their Own Bootstraps*, 14 COMM. & L. 41, 61–62 (1992).

245. The fledgling Guild was careful to recruit the most lucrative playwrights from each producer’s stable. See MIDDLETON, *supra* note 222, at 316.

246. TODD LONDON, BEN PESNER & ZANNIE GIRAUD VOSS, *OUTRAGEOUS FORTUNE: THE LIFE AND TIMES OF THE NEW AMERICAN PLAY* 23–34 (2009).

247. *Id.* at 24.

248. See WALSH, *supra* note 129, at 134–38 (comparing 1931 and 1936 contracts with 1926 contract); *id.* at 160–63 (explaining 1955 contracts); Alvin Deutsch, *MBPC: Resquiescat in Pace – APC: Quo Vadis*, 3 ENT. & SPORTS LAW. 3 (Spring 1985) (comparing 1985 APC with 1961 MBPC); Klein, *supra* note 244, at 41, 61–62 (1992) (comparing 1954 MBA with earlier contracts); Michael G. Yamin, *Legal Problems in Broadway Theatrical Productions*, 21 BUS. L. 453 (1966) (explaining 1961 MBPC). The Guild has more recently also promulgated contracts for smaller, nonprofit, and regional theatres. See WALSH, *supra* note 129, at 190–209; Klein, *supra* note 244, at 64–65; Mervyn Rothstein, *Dramatists Guild Writes a Contract for its Members*, N.Y. TIMES, Aug. 30, 1989, at C19.

249. See, e.g., Approved Production Contract for Plays §§ 1.06, 8.01, *reprinted in* FARBER, *supra* note 8, at 177, 179, 201–02.

250. See *id.* §§ 4.01–4.04, at 184–91.

251. See *id.* §§ 11.01–11.08, at 216–26.

litigation. Producers filed antitrust suits claiming that the Dramatists Guild violates the antitrust laws.²⁵² In 1945, the Court of Appeals for the Second Circuit agreed,²⁵³ but ended up dismissing the case on the ground that the plaintiff had shown no damage.²⁵⁴ In 1982, producers sued again on similar claims.²⁵⁵ The Guild filed a counterclaim asserting that the producers had themselves violated the antitrust laws by conspiring to fix playwright compensation at an artificially low level.²⁵⁶ The litigation settled before anything too final could happen.²⁵⁷ When a new round of contract negotiations raised the specter of a new antitrust suit in 2002, famous

252. See, e.g., *Drama Guild Sued to End 'Monopoly'*, N.Y. TIMES, Mar. 12, 1941, at 23.

253. *Ring v. Spina*, 148 F.2d 647 (2d Cir. 1945) (preliminary injunction); see also *Ring v. Author's League of Am.*, 186 F.2d 637 (2d Cir. 1951) (appeal after jury verdict).

254. *Author's League of Am.*, 186 F.2d 637. After the Second Circuit ruled that plaintiff independent producer had made a prima facie showing of an antitrust violation and ordered the trial court to enter a preliminary injunction, *Spina*, 148 F.2d at 651–54, the trial court submitted the question whether the Guild was a labor union (and thus entitled to the labor antitrust exemption) to the jury, which concluded that it was not, and that the Guild had violated the antitrust laws. *Author's League*, 186 F.2d at 639. Both *Ring* and the Authors' League appealed. In an apparent attempt to limit the damage of ruling the Guild to be illegal, Judge Learned Hand declined to revisit the antitrust issue:

[T]he League is naturally concerned that it shall not be held to be a conspiracy in violation of the Anti-Trust Acts. It vigorously protests its innocence and its beneficence; it is conscious of no wrongdoing, and asserts that its existence is essential to the protection of authors and composers. Such purposes would of course not protect it, if it is in fact a combination in restraint of trade or an attempted monopoly; but they are relevant in deciding whether we should decide issues in which the plaintiff has only the most shadowy interests. We hold therefore that the judgment should not have decided that, if the authors revive the play they must give the plaintiff an opportunity to "produce" it on an equal footing with anyone else, and that it should have contained no injunction. However, we hasten to add that we leave open all legal questions which such issues involve; we wish to make it entirely clear that we are not to be understood either to throw any doubt upon, or to affirm, what we said when we granted the temporary injunction; we merely decide that the necessity for such affirmance does not arise.

Id. at 643.

255. *Barr v. Dramatists Guild, Inc.*, 573 F. Supp. 555 (S.D.N.Y. 1983); see Carol Lawson, *Dramatists Guild Sued Over Royalty Payments*, N.Y. TIMES, July 28, 1982, at C19, col. 1.

256. *Barr*, 573 F. Supp. at 558–59.

257. Leslie Bennett, *Writers and Producers Reach Contract Accord*, N.Y. TIMES, Feb. 27, 1985, at C21; see WALSH, *supra* note 129, at 176–89 (describing negotiations that resulted in the settlement of the litigation). The Guild and League of American Theatres and Producers agreed to characterize the 1985 Approved Production Contracts as recommended rather than mandatory, but the Guild continues its policy of disciplining members who sign a contract that does not substantially comply with the Guild's approved minimum terms. Members who are expelled from the Guild or who resign to avoid being expelled from the Guild may rejoin after a year.

playwrights persuaded Senators Hatch and Schumer to introduce the Playwrights Licensing Relief Act.²⁵⁸ The bill would have exempted playwrights from antitrust liability for participating in discussions or negotiations to facilitate a standard form contract with producers.²⁵⁹ Senators Hatch and Kennedy and Representative Coble reintroduced the bill in the following Congress, where it received a hearing, but no further action.²⁶⁰

The enactment of the 1976 Copyright Act has, in theory, completely obliterated any copyright distinction between published and unpublished plays. To the extent a common law performance right existed at some time under the 1870 or 1909 Acts, the 1976 Act makes the right a thing of the past. The elimination of publication or registration as a condition of statutory copyright also enabled other creative contributors to claim copyright in their authorship as part of any production that is fixed in tangible form.²⁶¹

258. S. 2082, 107th Cong. (2002); see Jesse McKinley, *Legislation to Help Playwrights Negotiate*, N.Y. TIMES, Apr. 12, 2002, at E6, col. 1.

259. Section 2 of the Bill would have provided:

(a) IN GENERAL- Subject to subsection (c), the antitrust laws shall not apply to any joint discussion, consideration, review, action, or agreement for the express purpose of, and limited to, the development of a standard form contract containing minimum terms of artistic protection and levels of compensation for playwrights by means of—

- (1) meetings, discussions, and negotiations between or among playwrights or their representatives and producers or their representatives; or
- (2) joint or collective voluntary actions for the limited purposes of developing a standard form contract by playwrights or their representatives.

(b) ADOPTION AND IMPLEMENTATION- Subject to subsection (c), the antitrust laws shall not apply to any joint discussion, consideration, review, or action for the express purpose of, and limited to, reaching a collective agreement among playwrights adopting a standard form contract developed pursuant to subsection (a) as the participating playwrights sole and exclusive means by which participating playwrights shall license their plays to producers.

(c) AMENDMENT OF CONTRACT- A standard form of contract developed and implemented under subsections (a) and (b) shall be subject to amendment by individual playwrights and producers consistent with the terms of the standard form contract.

S. 2082, § 2.

260. See generally *The Playwrights Licensing Antitrust Initiative Act: Safeguarding the Future of American Live Theater: Hearing on S. 2349 Before the S. Judiciary Comm.*, 108th Cong. (2004). Representative Coble reintroduced the Bill in the 109th Congress. See H.R. 532, 109th Cong. (2005). It died there.

261. See 17 U.S.C. §§ 102(a), 103 (2006). Some commentators have argued that a derivative author owns no copyright in a licensed derivative work unless the owner of the copyright in the underlying work has authorized it. See, e.g., William Patry, *Copyright in Stage Directions?*, PATRY COPYRIGHT BLOG, (Jan. 29, 2006, 8:42 AM),

Directors and other collaborators have asserted copyright ownership of their contributions,²⁶² to be met with protests from the Guild.²⁶³ The Dramatists Guild insists that recognizing any other contributor as an author would mean the death of drama as we know it.²⁶⁴ Although some of these disputes led to litigation, most of the lawsuits have also settled.²⁶⁵

<http://williampatry.blogspot.com/2006/01/copyright-in-stage-directions.html> (“If, as Einhorn apparently represented to the Copyright Office, his work is a derivative work of the play script, under Section 103, he is unlikely to be able to have a valid copyright without the playwright’s permission, which presumably here would be denied.”). This is careless reading. So long as the derivative work is created lawfully, sections 102 and 103 provide for automatic copyright protection, regardless of the copyright owner’s permission. *See also* H.R. REP. NO. 99-1476, at 58 (1976) (“Under this provision, copyright could be obtained as long as the use of the preexisting work was not ‘unlawful,’ even though the consent of the copyright owner had not been obtained.”). Were this not the case, there would be no need to provide expressly in section 115(a)(2) that when a sound recording is made pursuant to a statutory compulsory license (as distinguished from a negotiated license or a Harry Fox license), the new musical arrangement authorized by the statute will not be protected by copyright unless the owner of the copyright in the underlying musical composition consents.

262. Jesse Green, *Exit, Pursued by A Lawyer*, N.Y. TIMES, Jan. 29, 2006, at Section 2: Arts & Leisure 1, col. 5; *see, e.g.*, *Mullen v. Soc’y of Dirs. & Choreographers*, No. 06 C 6818, 2007 U.S. Dist. LEXIS 75235 (N.D. Ill. Sept. 28, 2007) (suit over copyright in direction, choreography and scenic design of *Urinetown*); *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189 (S.D.N.Y. 2006) (suit over copyright in Edward Einhorn’s direction of *Tam Lin*); *Mantello v. Hall*, 947 F. Supp. 92 (S.D.N.Y. 1996) (suit over copyright in Joe Mantello’s direction of *Love!Valour!Compassion!*).

263. *See* Dramatists Guild of Am., *Statement: Dramatist Copyright and Intellectual Property Rights*, http://dramatistsguild.com/about_statements_copyright.aspx (last visited Apr. 2, 2010):

The Council of the Guild has become aware that directors, dramaturgs and other theatrical collaborators have from time to time claimed copyright and other ownership interests in any such changes or contributions for which they claim to be responsible. They have attempted to establish their claims, among other means, by videotaping performances or filing with the Copyright Office the dramatist’s script with changes, notations and other additions claimed by these collaborators. Such claims and actions infringe on the rights of dramatists to own and control their plays, and may inhibit the opportunities of other professionals, and audiences, to participate in the re-creation and enjoyment of the play.

Id.

264. *E.g.*, Weidman, *supra* note 10. The Guild argues that its members’ contracts require the playwright’s approval of any changes to the script, and oblige the producer to assign ownership of any changes to the playwright. Since the production is licensed subject to that clause, the producer has no right to enter into contracts with directors or designers that permit them to retain copyright in their contributions. The Stage Directors and Choreographers Society, which represents directors, has negotiated collective bargaining agreements with Broadway, Off-Broadway, regional, and stock theatres under which both directors and choreographers retain copyright in their contributions. *See* Stage Dirs. & Choreographers Soc’y, *SDC Contracts: Collectively Bargained Agreements*,

Today, playwrights in America retain both copyright ownership and creative control in their plays. Those strong copyright rights have not, however, made playwriting remunerative. A 2009 study by the Theatre Development Fund concluded that it is no longer possible for even the most successful playwrights to earn a living from productions of their plays.²⁶⁶ Working playwrights need to supplement their incomes with teaching or with writing scripts for film or television under work made for hire contracts.

Meanwhile, the Drone-ish form of common law copyright has entirely died out, forgotten by everyone but the record labels who claim it for their pre-1972 recordings.²⁶⁷

IV. CONCLUSION

What lessons can we draw from the history of common law play right in America? Several lessons seem evident. Most obviously, for all of the author-centric rhetoric pervading the cases and secondary literature, common law play right was never a playwright's right—it was asserted almost exclusively by and on behalf of the theatre managers and publishers who claimed to be the playwright's assigns. We can miss important information when we take author's rights language at face value, without asking ourselves who is speaking the language and what, exactly, he or she seeks to accomplish.

Second, for legal scholars, a particularly interesting subplot in this story represents what Ann Bartow has termed “the Hegemony of the Copyright Treatise.”²⁶⁸ Eaton Drone was able to write a thick, comprehensive treatise because, instead of deriving legal principles from statutes and judicial decisions, he created his legal principles out of whole cloth and discussed judicial decisions to demonstrate where they were consistent and inconsistent with the principles he announced. That allowed Drone to have answers for many questions courts had not addressed, and to pick the winners when

http://sdcweb.org/index.php?option=com_content&task=view&id=40&Itemid=96 (last visited Apr. 2, 2010).

265. See, e.g., Andrew Gans, *Akron Urinetown Lawsuit Settled*, PLAYBILL.COM, July 2, 2008, <http://www.playbill.com/news/article/119148-Akron-Urinetown-Lawsuit-Settled>; Campbell Robertson, *A Urinetown Suit is Settled*, N.Y. TIMES, Dec. 1, 2007, at B8; Lisa Jo Sagolla, *Dance/Movement: Should Stage Direction Be Copyrightable?*, BACKSTAGE, May 20, 2008, http://www.backstage.com/bsa/eseach/article_display.jsp?vnu_content_id=1003805591.

266. LONDON, PESNER & VOSS, *supra* note 246, at 47–96.

267. See *Capitol Records v. Naxos of Am., Inc.*, 372 F.3d 471 (2d Cir. 2004) (certifying common law copyright question to N.Y. Court of Appeals); *Capitol Records, Inc. v. Naxos of Am., Inc.*, 4 N.Y.2d 540 (2005) (holding that N.Y. common law copyright protects sound recordings made before 1972 even if they are in the public domain in their country of origin).

268. Ann Bartow, *The Hegemony of the Copyright Treatise*, 71 U. CIN. L. REV. 1 (2004).

court decisions demonstrated a conflict of authority. Drone didn't hide his method, or pretend that he was merely describing the law, rather than seeking to reshape it. Courts and other writers nonetheless relied on Drone as a dependable account of what the law was, rather than an argument about what Drone believed the law ought to become.²⁶⁹

Third, the fact that common law performance rights in both England and America did not precede statutory performance rights but followed them, growing up in response to perceived gaps in the rights under the statute, parallels the history of common law printing rights. This history should probably count as another nail in the coffin of the story of copyright's natural right origins in the days of primordial ooze. Further, the histories of the two different flavors of common law copyright suggest that what rights that we perceive as inherent or natural are fundamentally contingent on what rights already have names and a path to enforcement.

Finally, the story reminds us that, for most people, the customs that grow up around what people believe the law to be matter more than what the law really is. Dramatists were able to get exceptional authors' rights through collective action that was not tied to any statute or judicial decision, and they have retained those rights despite (and maybe even in defiance of) later statutes or judicial decisions. Of the 20,000 dramatists who registered the title of their plays without depositing copies and thought they had thereby perfected a federal copyright, most of them got an apparent copyright that probably worked as well for them as the real thing would have. Today, the strong attribution and integrity rights that playwrights claim, and their insistence on denying that their collaborators author contributions, have everything to do with customs and contracts, and very little to do with copyright law.

269. The most disturbing example, in my view, is probably William S. Strauss's uncritical parroting of Drone in the 1957 copyright office study on protection for unpublished works. See Strauss, *supra* note 19. Because the series of studies was in general so meticulous, scholars who came after believed Strauss's description was apt. Strauss may have had a reform agenda. In a law review article published at around the same time, he argued that U.S. common law in general, and common law copyright in particular, provided protection of authors' rights that was substantially equivalent with the *droit morale* required under article 6bis of the Berne Convention. See William S. Strauss, *The Moral Right of the Author*, 4 AM. J. COMP. L. 506, 538 (1955). That article, with some additions, became the Copyright Office's 1959 study on moral rights. See WILLIAM S. STRAUSS, STUDY NO. 4: THE MORAL RIGHT OF THE AUTHOR, *reprinted in* S. COMM. ON THE JUDICIARY, 86TH CONG., COPYRIGHT LAW REVISION: STUDIES PREPARED FOR THE SUBCOMM. ON PATENTS, TRADEMARKS AND COPYRIGHTS OF THE S. COMM. ON THE JUDICIARY (Comm. Print 1960); LIBRARY OF CONG., SIXTIETH ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS FOR THE FISCAL YEAR ENDING JUNE 30, 1957, at 9–10 (1957).

THE ADVENTURES OF THE STATUTE OF ANNE IN THE LAND OF UNLIMITED POSSIBILITIES: THE LIFE OF A LEGAL TRANSPLANT

Oren Bracha[†]

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I. INTRODUCTION

We are so used to thinking of the Statute of Anne¹ as the source of Anglo-American copyright law that we often miss the fact that in the United States it functioned as a legal transplant.² The arrival of the Statute of Anne in the United States at the end of the eighteenth century was a clear case of a legal regime that was lifted from one legal culture and transferred to another where the legal, social, and cultural context was quite different. When the early American copyright regime is examined from this perspective and

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† Professor of Law, The University of Texas School of Law.

1. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19 (1710) (Gr. Brit.).

2. *See generally* ALAN WATSON, LEGAL TRANSPLANTS: AN APPROACH TO COMPARATIVE LAW (2d ed. 1993) (describing the process of legal transplantation).

against the backdrop of the rich theoretical legal transplants literature, several insights and questions emerge.

First, the sheer degree of identity, at least on the formal level, between the British Statute of 1710 and the American copyright regime, ushered in by the state statutes of the 1780s and consolidated in the federal 1790 Copyright Act,³ is striking. While the influence of the Statute of Anne on early American copyright legislation is widely known, scholars often overlook the scale of duplication on the level of ideological purposes, concepts, technical legal arrangements, and specific text. When these identical features are examined closely, the genesis of the American copyright system appears to be a major operation of international plagiarism.

Second, the contrast between the close duplication of legal forms and the obvious disparities in relevant social and cultural conditions between the originating and receiving jurisdiction gives rise to several questions. Why did Americans who were, to a large extent, drawing the plans for their new copyright system on a clean slate, choose to adopt an eighty-year-old statute deeply rooted in the economic conditions and political-ideological debates of the Imperial power whose dominion they had just overthrown? Why did they copy, with only minor changes and omissions, a regulatory scheme that was ambiguous and occasionally sloppy at the time it was created, and whose silence on some of the more vexing and important copyright questions of the time was growing increasingly apparent by the end of the eighteenth century?

Americans turned to the Statute of Anne for two main reasons. First, the Statute was a relatively familiar and accessible template for governing a field whose regulation seemed desirable or necessary. The availability of such a ready-made regulatory scheme was in itself a considerable source of attraction to the new post-revolutionary nation. In this regard, the adoption of the Statute of Anne fits within the larger context of American resort to British common law and statutory law. Second, in the eyes of Americans, Britain was a leading nation in the cultural and scholarly fields. This prestige enhanced the attractiveness of the British legal regime associated with these fields and facilitated its transfer to the United States.

Moreover, there is the question of the success or survivability of the legal transplant. In light of the circumstances described above, the Statute of Anne may appear to have been an unlikely candidate for a successful and enduring transplantation in the United States. And yet, at least as a matter of the statute book, the basic framework borrowed from Britain in 1790

3. Act of May 31, 1790, ch. 15, 1 Stat. 124.

survived in the United States at least until the second half of the nineteenth century, a series of statutory amendments and revisions notwithstanding. Even after the major revision of 1870⁴ and several significant modifications in the preceding decades, the old foundations could still be seen under the new layers. What accounts for this success, or at least this survivability? Was there something in the basic features of the Statute of Anne or the subject matter to which it applied that made it particularly portable? Was it the nature of the relationship between the British and the American legal cultures or cultures in general? Or was it perhaps something in the process of transplantation and reception that explains the longevity of the old Statute in the new nation, even in the face of changed economic and social conditions?

Much of the success of the Statute of Anne in the United States can be explained by recent approaches to legal transplantation as a dynamic process that involves adaptation and transformation rather than simple duplication. The migration of the Statute of Anne to the United States makes a fascinating test case for the process of reception of a legal transplant. Comparative law scholars have been debating for decades the nature of legal transplantation and the variables affecting it.⁵ While many questions pertaining to these debates are far from settled, many of these scholars have adopted various models of the legal transplant as a process of translation.⁶ Like translation, the legal transplant is seen not as a mechanical process of exact duplication, but rather as a dynamic and creative process in which a preexisting legal form acquires new meaning by placement in a new environment. Because the exact content and function of a legal form is shaped, in part, by the other elements of the legal and cultural system in which it operates, a legal transplant is likely to be transformed by the transplantation process. Because the legal transplant is a new element in the receiving system, it is likely to affect preexisting elements and the system itself.

The naturalization of the Statute of Anne regime in America was just such a process. The early American statutory framework closely followed the

4. Act of July 8, 1870, ch. 230, 16 Stat. 198.

5. See Michele Graziadei, *Comparative Law as the Study of Transplants and Receptions*, in THE OXFORD HANDBOOK OF COMPARATIVE LAW (M. Reimann & R. Zimmerman eds., 2006).

6. The translation metaphor is used by Máximo Langer. See Máximo Langer, *From Legal Transplants to Legal Translations: The Globalization of Plea Bargaining and the Americanization Thesis in Criminal Procedure*, 45 HARV. INT'L L.J. 1, 29–35 (2004). Others take a similar approach to legal transplants while not necessarily using the translation metaphor. See, e.g., Graziadei, *supra* note 5, at 469–70.

Statute of Anne, and for a long period of time, it appeared to change relatively little. This static appearance, however, is misleading. From a very early stage, various elements of the American copyright regime were reinterpreted and new elements were developed and added. For a long period, this adaptation process happened mainly through case law, thus leaving the basic statutory infrastructure almost untouched. This process of adaptation through judicial development involved yet another layer of ongoing transplantation because American courts often resorted to the English case law, which was itself in the process of development. This layer was also dynamic and creative rather than merely duplicative since American judges often reshaped the precedents they were importing from England, even as they professed to be implementing the precedents' principles. In the first century of American copyright, judicial development and creation dealing with the scope of protection, entitlements, concept of authorship, and remedies was at least as important in shaping the copyright regime as the basic statutory framework imported from Britain and the later statutory amendments. Thus, by the late nineteenth century, American copyright law was different from the original Statute of Anne regime far beyond the degree betrayed by the simple comparison of statutory texts.

If American courts responding to developing demands and ideological constraints radically changed the regime imported from Britain, in what way, if at all, did the Statute of Anne leave an imprint on the American copyright system? Was there any enduring effect to the early massive "plagiarism" or were the specific arrangements copied from Britain merely fleeting forms whose actual effect eroded relatively quickly? The enduring effect consisted of a series of path dependencies and features that became entrenched in the American copyright system. Some of these are substantive, while others are mainly illustrative anecdotes. A non-exhaustive list of these features includes: the early shift to a general statutory regime, duration, formalities, renewal, and statutory damages. In all of these contexts, the Statute of Anne left its mark on American copyright, at times even after the relevant features faded or were abandoned in Britain.

This article proceeds in five parts. Part II provides background about the Statute of Anne, which is necessary for understanding its later influence in the United States. It describes briefly the regulatory framework that preceded the Statute, the circumstances surrounding its legislation, the competing purposes and interests underlying it, and the new regime it created. Part III shifts the focus to the United States. It describes the deep influence of the Statute of Anne in four post-independence American contexts: early lobbying for protection by authors and their allies, the 1780s state copyright

statutes, the intellectual property clause of the U.S. Constitution, and the 1790 Copyright Act. Part IV discusses the possible reasons that led Americans to rely heavily on the old and imperfect British Statute. Part V analyzes the transfer of the Statute of Anne to America as a creative and adaptive process. This Part describes how, while statutory law seemed to closely duplicate the original legal forms, the legal regime was changed and developed mainly through the case law. Part VI concludes the article by looking at the flipside of this dynamic process. It sketches some of the ways in which, despite the changes, the legal forms and concepts imported from the Statute of Anne have had an enduring effect in the United States.

II. THE BIRTH OF THE STATUTE OF ANNE

Modern scholars disagree about the exact purposes and motivating forces behind the Statute of Anne. The Statute is commonly known for embodying the moment at which authors were recognized as the proper focal point of copyright protection and for establishing authors' legal rights and their ability to bargain for better terms in the marketplace.⁷ Many scholars espouse other views. For instance, Lyman Patterson described the Statute as primarily an attack on the monopoly of the Stationers' Company, the London publishers' guild, in which the figure of the author was used rhetorically as a pretext for breaking this monopoly power and regulating the book trade.⁸ Ronan Deazley, while not necessarily disagreeing with Patterson, emphasized that the Statute's motivation was to strike a deal between the author, the bookseller, and the reading public that was designed to maximize the production and dissemination of useful books.⁹ John Feather, on the other hand, described the Statute's purpose and effect as an attempt by the Stationers' Company to retain as much of its power and privileges in a changed world.¹⁰ In this account, the author figure's growing ideological

7. See VICTOR BONHAM-CARTER, 1 AUTHORS BY PROFESSION 16 (1978) (arguing that the Statute of Anne "established the author's right to his own property, and thereby gave him the power to bargain for better terms").

8. LYMAN RAY PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 143–44 (1968).

9. RONAN DEAZLEY, ON THE ORIGIN OF THE RIGHT TO COPY: CHARTING THE MOVEMENT OF COPYRIGHT LAW IN EIGHTEENTH CENTURY BRITAIN (1695–1775) 45–46 (2004) [hereinafter DEAZLEY, ORIGIN OF THE RIGHT TO COPY]; Ronan Deazley, *The Myth of Copyright at Common Law*, 62 CAMBRIDGE L.J. 106, 108 (2003).

10. JOHN FEATHER, A HISTORY OF BRITISH PUBLISHING 74–75 (1988) [hereinafter FEATHER, BRITISH PUBLISHING]; JOHN FEATHER, PUBLISHING, PIRACY AND POLITICS: AN HISTORICAL STUDY OF COPYRIGHT IN BRITAIN 61–63 (1994) [hereinafter FEATHER, PIRACY

value serviced the London booksellers, rather than the interests of the public or the authors.¹¹ Which of these seemingly inconsistent accounts is right? As recently suggested by Isabella Alexander, the most probable answer is: all of them.¹² To see why and in order to understand some of the Statute of Anne's fundamental features that are relevant to its later history in America, a brief description of its background is necessary.

The Statute of Anne's enactment was the result of the decline of the framework for regulating book-publishing rights that had been employed in England for over a century and a half. This framework consisted of two main mechanisms, both of which created publishers' rather than authors' rights. The first was the printing patent.¹³ Printing patents, awarded since the early sixteenth century, were royal discretionary privilege grants.¹⁴ Issued under the Crown's prerogative power, they bestowed upon a specified printer or publisher the exclusive right of printing and selling a particular book or category of books, usually for a limited time.¹⁵ Printing patents were issued for some of the more commercially valuable and popular printed works,¹⁶ and thus, they were highly coveted and often caused unrest within the book trade.¹⁷ They were, however, never the norm; most books published in England were not covered by printing patents.¹⁸ Printing patents continued to exist after the Statute of Anne,¹⁹ but during the eighteenth century, for

AND POLITICS]; *see also* BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 8–9 (1967).

11. FEATHER, BRITISH PUBLISHING, *supra* note 10, at 17; FEATHER, PIRACY AND POLITICS, *supra* note 10, at 61–63; *see also* BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 8–9 (1967).

12. ISABELLA ALEXANDER, COPYRIGHT LAW AND THE PUBLIC INTEREST IN THE NINETEENTH CENTURY 18 (2009).

13. On the printing patent, *see* FEATHER, PIRACY AND POLITICS, *supra* note 10, at 10–14; PATTERSON, *supra* note 8, at 78–113; Leo Kirschbaum, *Author's Copyright in England Before 1640*, in 40 THE PAPERS OF THE BIBLIOGRAPHICAL SOCIETY OF AMERICA 43 (1946); Oren Bracha, *Owning Ideas: A History of Anglo-American Intellectual Property* 12–129 (2005) (unpublished S.J.D. dissertation, Harvard Law School), *available at* <http://www.obracha.net/oi/oi.htm>.

14. PATTERSON, *supra* note 8, at 78.

15. *Id.* at 79.

16. FEATHER, PIRACY AND POLITICS, *supra* note 10, at 12; PATTERSON, *supra* note 8, at 78, 80.

17. *See* PATTERSON, *supra* note 8, at 90–106 (describing the conflict caused by printing patents).

18. FEATHER, PIRACY AND POLITICS, *supra* note 10, at 14.

19. The Statute of Anne explicitly disclaimed any effect on the validity of printing patents. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19, § 9 (1710) (Gr. Brit.).

various reasons, they were subjected to growing restrictions, and their significance steadily declined.²⁰

The other more immediate ancestor of the Statute of Anne was an internal regulation of the London publishers' guild—the Stationers' Company²¹—that came to be known as the “stationer's copyright.”²² The stationer's copyright was rooted in an overlap between the guild's commercial interests and government's political ones. The basic deal involved a facilitation of censorship in return for tight control of the trade and broad enforcement powers. The 1557 Charter, given to the Company by Philip and Mary I, established the Company's national monopoly and bestowed various search and enforcement powers upon it.²³ Later decrees increased the Company's powers and responsibilities.²⁴ The complete licensing framework that expressed the government-guild symbiosis and dominated this field for more than a century was solidified, however, in the Star Chamber Decree of 1586.²⁵ The heart of this framework was a prior licensing regime under which any book printed in England had to be submitted to the Company, licensed by specified office holders, and then

20. See Bracha, *supra* note 13, at 146–57. The reasons for the decline of the printing patents included growing unrest in the trade over the concentration of wealth and power they created, the general disdain of monopoly patents in English political discourse, and the taking over by the Stationers' Company of the printing rights of many of the valuable works covered by patents. *Id.*

21. For more information about the Stationers' Company, see CYPRIAN BLAGDEN, *THE STATIONERS' COMPANY: A HISTORY, 1403–1959* (1977); Graham Pollard, *The Company of Stationers Before 1557*, 18 *LIBR.* 1 (4th ser. 1937).

22. On the stationer's copyright, see John Feather, *From Rights in Copies to Copyright: The Recognition of Authors' Rights in English Law and Practice in the Sixteenth and Seventeenth Centuries*, in *THE CONSTRUCTION OF AUTHORSHIP: TEXTUAL APPROPRIATIONS IN LAW AND LITERATURE* 191, 201–02 (Martha Woodmansee & Peter Jaszi eds., 1994); PATTERSON, *supra* note 8, at 42–77; see also MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* 12–16 (1993); Bracha, *supra* note 13, at 129–45.

23. See PATTERSON, *supra* note 8, at 28–30; ROSE, *supra* note 22, at 12–13; Bracha, *supra* note 13, at 136. The Charter is reproduced in 1 *A TRANSCRIPTION OF THE REGISTERS OF THE COMPANY OF STATIONERS OF LONDON, 1554–1640 A.D.*, at xxx–xxxii (London, Edward Arber ed., 1876) [hereinafter *TRANSCRIPT OF THE REGISTERS*].

24. For a list and explanation of later decrees, see PATTERSON, *supra* note 8, at 36–41, 114–38; Bracha, *supra* note 13, at 136–39.

25. *THE NEWE DECREES OF THE STARRE CHAMBER FOR ORDERS IN PRINTINGE* (1586), reprinted in 2 *TRANSCRIPT OF THE REGISTERS*, *supra* note 23, at 807 [hereinafter *1586 DECREE*]; see also PATTERSON, *supra* note 8, at 115–19; Ronan Deazley, *Commentary on Star Chamber Decree 1586*, in *PRIMARY SOURCES ON COPYRIGHT (1450–1900)* (Lionel Bently & Martin Kretschmer eds., 2008), available at www.copyrighthistory.org (detailing the background of the Star Chamber Decree).

registered in the Company's register.²⁶ It was prohibited to print a book contrary to any law, decree, patent, or company regulation, and extensive enforcement powers were given to the Company. This system remained in force under various Star Chamber decrees and acts until 1695.²⁷

Even though it probably predated the Charter by a few years, the stationer's copyright was deeply rooted in this licensing system. The Crown's main interest was in the licensing and censorship system and in the concentration of the printing trade that facilitated it, rather than any exclusive commercial printing rights.²⁸ It was the licensing system, however, that enabled and nourished the exclusive rights created and enforced by the Stationers' Company as an internal trade regulation. The stationers understood this connection well, and in their lobbying efforts to maintain their powers, perfected arguments based on it to a degree of an art. One of their petitions phrased the connection as follows:

The first and greatest end of order in the Presse, is the advancement of wholesome knowledge, and this end is merely publike: But that second end which provides for the prosperity of Printing and Printers, is not meerly private, partly because the benefit of so considerable a Body is of concernment to the whole; and partly because the compassing of the second end does much conduce to the accomplishing of the first.²⁹

The essence of the stationer's copyright was that any member of the Company who was the first to register a book in its register obtained an exclusive, perpetual right to print that book.³⁰ The Company itself enforced violations of this right, and its internal tribunal usually handled disputes.³¹ Like the printing patent, the publishers rather than the authors received the stationer's copyright.³² But unlike the patent, the stationer's copyright was perpetual.³³ Finally, the stationer's copyright regulation was more universal

26. 1586 DECREE, *supra* note 25, § 4.

27. For subsequent acts and decrees, see PATTERSON, *supra* note 8, at 119–39.

28. See ROSE, *supra* note 22, at 12.

29. *The Humble Remonstrance of the Company of Stationers to the High Court of Parliament*, April 1643, in 1 TRANSCRIPT OF THE REGISTERS, *supra* note 23, at 584–85.

30. There are some doubts whether registration was constitutive of the right. Both Patterson and Feather conclude that registration was both mandatory and a strong evidence of copyright, but that it was possible to acquire copyright by way of first publication without registration, at least during the early years of the system. Feather, *supra* note 22, at 201–02; PATTERSON, *supra* note 8, at 55–64.

31. PATTERSON, *supra* note 8, at 47.

32. *Id.* at 43.

33. ROSE, *supra* note 22, at 12.

and standardized than the patent. The stationer's copyright was limited only to guild members, but within these confines, it was issued upon registration as a matter of routine and not on the basis of ad hoc discretionary decisions.³⁴

The Statute of Anne originated in the stationers' attempts to renew their familiar form of protection after the last extension of the 1662 Licensing Act lapsed in 1695. At first, the stationers lobbied for a new legislative scheme in the traditional pattern. The justifications offered in support of such legislation were many, but censorship was the most important and conspicuous one.³⁵ The stationers, however, were to learn that they lived in a changed ideological and political climate. The proposed bills for renewing the licensing regime were defeated one after another.³⁶ There were three recurring reasons, offered by opponents of these bills, for resisting the renewal of the licensing regime: opposition to censorship, at least in the format of a comprehensive licensing regime and prior restraint; concerns over the monopolistic powers of the Stationers' Company; and claims that the traditional system served the interests of publishers at the expense of those who should be its legitimate beneficiaries, namely authors.³⁷ One opponent of extending the Licensing Act in the House of Lords succinctly summed up all three objections when he claimed that the Act "subjects all Learning and true Information to the arbitrary Will and Pleasure of a mercenary, and perhaps ignorant, Licenser; destroys the Properties of Authors in their Copies; and sets up many Monopolies."³⁸

After numerous failed attempts to renew the Licensing Act, the stationers changed their strategy. The watershed moment came in 1707 with a petition to Parliament premised on the following argument:

many learned Men have spent much Time, and been at great Charges, in composing Books, who used to dispose of their Copies upon valuable Considerations, to be printed by the Purchasers . . . but of late Years such Properties have been much invaded, by other Persons printing the same Books . . . to the great Discouragement of Persons from writing Matters, that might be of great Use to the Publick, and to the great Damage of Proprietors.³⁹

34. Bracha, *supra* note 13, at 139–43.

35. FEATHER, PIRACY AND POLITICS, *supra* note 10, at 51–54; ROSE, *supra* note 22, at 34.

36. See PATTERSON, *supra* note 8, at 139–41.

37. Bracha, *supra* note 13, at 178–82.

38. 15 H.L. JOUR. (1693) 280.

39. 15 H.C. JOUR. (1707) 313.

Much of the substance of this argument was not new. In fact, an almost identical version of it appeared in the 1643 petition entitled *Remonstrance of the Company of Stationer's*.⁴⁰ The strategic change consisted in eliminating all references to censorship and shifting the gravity center of the argument to the protection of authors and the encouragement of learning. This strategy responded to all three strands of opposition. Since licensing was no longer the basis for the proposed legislation, anti-censorship sentiments became moot.⁴¹ The claim that the protection would serve the public good by encouraging useful writings countered monopoly concerns. Finally, stationers now presented authors as the prime beneficiaries of the regime rather than its victims, although what the stationers really had in mind was the indirect protection of authors' interests through publishers' rights.⁴²

This new strategy eventually led to the 1710 Statute of Anne.⁴³ This does not mean that the stationers got everything they wanted. The Statute was a compromise that contained various elements reflecting the contending interests and concerns behind it: the interests of stationers in securing their economic rights, fears of the Company's monopoly and of the power of its prominent members including by smaller booksellers, attempts to secure the public interest referred to as "the encouragement of learning," and an emerging concern for authors. The basic features of the Statute reflected this amalgam of competing forces.

The heart of the Statute was two matching entitlements. In regard to "Book or Books already Printed," there was a twenty-one-year exclusive right to print given to the author, or in the more likely case that the author "[t]ransferred to any other the Copy or Copies of such Book or Books," to the bookseller, printer or "Person or Persons, who hath or have Purchased or Acquired the Copy or Copies . . . in order to Print or Reprint the same."⁴⁴ In regard to new books, there was a fourteen year exclusive right to print

40. *Remonstrance of the Company of Stationer's* (1643), in 1 TRANSCRIPT OF THE REGISTERS, *supra* note 23, at 587.

41. Indeed, in a complete reversal of their former position, later petitions by stationers listed the absence of licensing as one of the merits of the legislation they promoted. See *The Booksellers Humble Address to the Honourable House of Commons in Behalf of the Bill of Encouraging Learning* (1710), cited in ROSE, *supra* note 22, at 43.

42. FEATHER, PIRACY AND POLITICS, *supra* note 10, at 56–57.

43. For a review of the legislative history, see DEAZLEY, ORIGIN OF THE RIGHT TO COPY, *supra* note 9, at 31–50; FEATHER, PIRACY AND POLITICS, *supra* note 10, at 59–63; ROSE, *supra* note 22, at 42–48.

44. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19, § 1 (1710) (Gr. Brit.).

given to “the Author . . . and his assignee or assigns.”⁴⁵ Thus, the stationers received their familiar exclusive printing rights initiated by the familiar procedure of registration in the stationers’ register, though these rights were limited in time.⁴⁶ The stationers also received recognition of authors’ past and future assignment of their rights to publishers. Other interests seen as crucial by stationers, such as a ban on the importation of English books and the inclusion of Scotland, the growing center of provincial competition, were also included.⁴⁷

At the same time, a host of the Statute’s features were responsive to the anti-monopoly and the encouragement of learning concerns. Making the rights available to any author and assignee meant the stationers lost their exclusivity. The time limitations were seen as the standard means for blunting the pernicious effects of monopolies since the early seventeenth century.⁴⁸ It was also a mechanism crucial to the Statute’s “encouragement of learning” purpose by effectively creating what is known today as the public domain.⁴⁹ The Stationers’ Company lost its enforcement and adjudication powers, and general courts received jurisdiction over all actions under the Statute.⁵⁰ Rights owners were also subjected to a price control mechanism supposedly triggered in cases of exorbitant prices,⁵¹ extensive requirements for the deposit of copies with English and Scottish libraries,⁵² and an exemption for the importation of books in foreign languages,⁵³ which were usually seen as inadequately supplied by English booksellers.

45. *Id.*

46. *Id.* §§ 1–2.

47. *Id.* §§ 1, 6.

48. *See infra* text accompanying notes 202–11.

49. *See* Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215, 223 (2003) (“[I]mplicit in the Statute of Anne was the principle that when the limited term expired, the work could be published by anyone without restraint.”). There are two important qualifications. *See* Jane Ginsburg, “*Une Chose Publique*”? *The Author’s Domain and the Public Domain in Early British, French and U.S. Copyright Law*, 65 CAMBRIDGE L.J. 636, 642 (2006) (stating that the legal regime created by the Statute did not clearly define which works were in the public domain because “[t]he Statute of Anne may have separated the waters from the lands, but it did not clearly tell us which was which”); Mark Rose, *Nine-Tenths of the Law: The English Copyright Debates and the Rhetoric of the Public Domain*, 66 LAW & CONTEMP. PROBS. 75, 77 (2003) (“[E]ven after the passage of the Statute, the major London booksellers continued to treat literary property . . . as perpetual properties.”).

50. 8 Ann., c. 19, § 1.

51. *Id.* § 4.

52. *Id.* § 5.

53. *Id.* § 7.

Finally, two features of the Statute expressed the new central status of authors in an unprecedented way. First, for the first time, authors, rather than publishers, were the original owners of the rights.⁵⁴ Second, the Statute recognized a reversionary interest of authors, possibly intended to mitigate cases of inequitable treatment by publishers, by providing that after the first term of protection, the exclusive rights would return to a surviving author for a second term of fourteen years.⁵⁵

The new regime created by the Statute of Anne fundamentally transformed the regulation of the book trade and introduced important innovations. The three most important of these innovations were universalizing the former guild protection system and opening it up to all, making the author rather than the publisher the initial bearer of the rights, and limiting the duration of the right.⁵⁶ At the same time, the Statute incorporated much of the preexisting framework. The exclusive right it created was the same as the one protected by the printing patents and the stationer's copyright, namely, the narrow right of making and selling reprints of specified texts.⁵⁷ The registration system implemented was that of the Stationers' Company, although it was now commandeered for general use, including by those who were not Company members. The limited term of protection was routinely used in printing patents and was one of the fundamental legal requirements for valid royal patents in general for over a century under the Statute of Monopolies⁵⁸ and the common law.⁵⁹ The deposit provision and the exemption for imported foreign language copies had antecedents in the 1662 Licensing Act.⁶⁰

Beyond continuity with the past, what was absent from the new regime is also important. Although the Statute vested new rights in authors, it contained no criterion for identifying authors or works of authorship. Protectable subject matter was limited to the traditional regulation of the book trade, namely, the product of the printing press, or in the words of the Statute: "books."⁶¹ Despite several references to "Property" and

54. *See id.* § 1.

55. *Id.* § 11.

56. *See id.* § 1.

57. *See id.*

58. Statute of Monopolies, 1624, 21 Jac. 1, c. 3 (Eng.).

59. *See* Oren Bracha, *The Commodification of Patents 1600–1836: How Patents Became Rights and Why We Should Care*, 38 LOY. L.A. L. REV. 177, 197–98 (2004); Tyler T. Ochoa & Mark Rose, *The Anti-Monopoly Origins of the Patent and Copyright Clause*, 49 J. COPYRIGHT SOC'Y U.S. 675, 677–79 (2002).

60. Licensing Act, 1662, 13 & 14 Car. 2, c. 33, § 17 (Eng.).

61. 8 Ann., c. 19, § 1.

“Proprietor,” the Statute contained no new concept of ownership of intellectual works. Its scope of protection was limited to the traditional publisher entitlement, namely, the making and selling of exact reprints.⁶² To a large extent, the new regime was the old stationer’s privilege, except it was universalized, capped in time, and formally conferred upon authors rather than publishers.

In practice, the Statute of Anne’s immediate innovations were even more limited. For a long time, the effect on the author’s economic status and the publisher-author relationship was minimal and limited to exceptional cases. Ordinarily, publishers kept acquiring the full copyright in books for a lump sum paid to the author at the outset, just as they did under the old system.⁶³ There are some reasons to suspect that the reversion right was not always observed after the first fourteen year term of protection,⁶⁴ and, at any rate, it soon received a restrictive judicial interpretation.⁶⁵ The concentrated economic power of the wealthiest members of the Stationers’ Company was not quickly undermined. They continued to rely on various economic arrangements in order to ensure concentrated control of the book market, at least in London.⁶⁶ Moreover, for a long period, this economic power allowed the stationers to continue treating many of their most valuable works, including those that had formally fallen into the public domain, as if they were under perpetual protection. This was evidenced by the prices of the printing rights for those works in trade auctions.⁶⁷ Thus, much of the actual economic-social change instigated by the Statute, such as establishing the author’s status or breaking up the old book trade monopolies, was painfully slow, and it continued to unfold throughout the eighteenth century and beyond.

62. *Id.*

63. Bracha, *supra* note 13, at 190–91.

64. Lionel Bently & Jane C. Ginsburg, “The Sole Right . . . Shall Return to the Authors”: *Anglo-American Authors’ Reversion Rights from the Statute of Anne to Contemporary U.S. Copyright*, 25 BERKELEY TECH. L.J. 1475 (2010) (discussing some evidence that reversion right was ignored by publishers).

65. *Carnan v. Bowles*, (1786) 29 Eng. Rep. 45 (Ch.) (allowing the author to assign the second term in advance and interpreting certain language as constituting such conveyance).

66. ALEXANDER, *supra* note 12, at 27–28; Terry Belanger, *Booksellers’ Trade Sales, 1718–1768*, 30 LIBR. 281 (5th Ser. 1975) (describing the practices of the London book trade sales).

67. Terry Belanger, *Publishers and Writers in Eighteenth Century England*, in BOOKS AND THEIR READERS IN EIGHTEENTH CENTURY ENGLAND 5, 16 (Isabel Rivers ed., 1982); Terry Belanger, *Tonson, Wellington and the Shakespeare Copyrights*, in STUDIES IN THE BOOK TRADE IN HONOUR OF GRAHAM POLLARD 195, 195 (R.W. Hunt et al eds., 1975).

The Statute of Anne was thus the product of a great transformation that incorporated much of the preexisting institutional framework. It was a significant step toward universalizing the copyright system by detaching the system from the guild and censorship apparatus that remained deeply rooted in the specific concerns, interests, politics, and ideological concepts of early eighteenth century England. Finally, the Statute was an early model of general authors' rights still pervaded by the old machinery of the booksellers' privilege. When seen in this light, it is somewhat surprising that eighty years later, Americans would copy it, almost to the letter, as the template for their first copyright regime.

III. THE STATUTE OF ANNE GOES WEST

A. EARLY AMERICAN LOBBYING

Americans discovered the Statute of Anne soon after the Revolution, at about the same time they began to take interest in copyright as a general regime of authors' rights. During colonial times, there was no general copyright regime in the colonies. The Statute of Anne did not apply to the colonies. Given the embryonic state of printing and publishing during most of the relevant period, it is unsurprising that there were no equivalent local statutory frameworks. The only protection for the product of the press was in the form of very sporadic printing privilege grants issued by colonial legislatures to publishers or printers.⁶⁸ These were rudimentary local versions of the English printing patent.

An interest in authors' rights began to appear at the very end of the colonial period⁶⁹ and intensified after the Revolution. During this period, a gradually growing number of authors, sometimes aided by others, lobbied state legislatures for legal protection of their works. The most famous case is that of Noah Webster, who in the early 1780s traveled to various states in an attempt to convince the local legislatures to provide him exclusive rights to

68. The conventional wisdom is that only one such printing privilege was issued during the colonial period—a 1672 grant by Massachusetts to John Ushers. There were, however, other legislative grants occasionally issued by other colonies. See Oren Bracha, *Early American Printing Privileges. The Ambivalent Origins of Authors' Copyright in America*, in PRIVILEGE AND PROPERTY: ESSAYS ON THE HISTORY OF COPYRIGHT 89, 97–100 (Ronan Deazley et al. eds., 2010) (describing other colonial printing privileges).

69. An important landmark is the legislative privilege granted to William Billings by the Massachusetts legislature in 1772 for his psalms book. The grant was vetoed by the Governor. See Rollo Silver, *Prologue to Copyright in America: 1772*, 11 STUDIES IN BIBLIOGRAPHY 259 (1958).

his *Grammatical Institute of the English Language*,⁷⁰ but there were many other cases as well.⁷¹ What those authors were petitioning for and what some states, starting with Connecticut,⁷² began to legislate were not general copyright statutes, but rather discretionary, ad hoc legislative privileges. These legislative privileges were the equivalents of the colonial printing privileges that were now sometimes granted to authors instead of publishers. In some cases, however, some lobbying authors began to advocate for general legislative regimes of authors' rights.⁷³ It was in this context and in connection to the clamor for general legislation in particular that Americans first turned to the Statute of Anne.

Knowledge of the exact details of lobbying for copyright protection during the first decades of the republic and the kinds of arguments used is fragmentary. The incomplete information, however, is still sufficient to show that Americans derived their arguments justifying the protection of author rights from two sources: the Statute of Anne and the literary property debate. The literary property debate was a series of litigated cases accompanied by a vibrant public debate that took place in Britain from the early 1740s to 1774.⁷⁴ The debate revolved around the claim that copyright was a (perpetual) common law property right. It originated in the battle of the stationers for continued perpetual protection irrespective of the limited statutory duration, but it generated voluminous theoretical literature. For decades, jurists, pamphleteers, thinkers, and speakers wrestled with the notion of "literary property" and with the fundamental principles underlying and justifying copyright. The debate left behind a mass of arguments, concepts, and assumptions that became incorporated into copyright thought. Although the House of Lords finally rejected common law copyright in 1774 in *Donaldson v. Beckett*,⁷⁵ much of the intellectual residue left by the episode

70. See BRUCE W. BUGBEE, *THE GENESIS OF AMERICAN PATENT AND COPYRIGHT LAW* 106–08 (1967); Noah Webster, *Origin of the Copy-right Laws of the United States*, in *A COLLECTION OF PAPERS ON POLITICAL, LITERARY AND MORAL SUBJECTS* (1843).

71. See Bracha, *supra* note 68, at 101–13; BUGBEE, *supra* note 70, at 110.

72. An Act for the Encouragement of Literature and Genius, 1783, in *ACTS AND LAWS OF THE STATE OF CONNECTICUT IN AMERICA* 133 (New London, Conn., Timothy Green, 1784).

73. See cases cited *infra* notes 76–83.

74. The literature on the literary property debate is voluminous. *E.g.*, DEAZLEY, *ORIGIN OF THE RIGHT TO COPY*, *supra* note 9, at 115–210; FEATHER, *PIRACY AND POLITICS*, *supra* note 10, at 69–96; PATTERSON, *supra* note 8, at 151–79; ROSE, *supra* note 22, at 67–112; BRAD SHERMAN & LIONEL BENTLY, *THE MAKING OF MODERN INTELLECTUAL PROPERTY LAW, THE BRITISH EXPERIENCE, 1760–1911*, at 19–42 (1999).

75. (1774) 1 Eng. Rep. 837 (H.L.).

concerned copyright as a property right in the product of the intellect. Arguments that had their genesis in the justification of the Statute of Anne's statutory scheme and those that originated in claims about copyright as a perpetual natural property right were not necessarily incongruent or contradictory. If there was any tension, it did not stop late eighteenth century Americans from freely mixing these arguments together.

Thus, in 1782, when Samuel Stanhope Smith, then a professor of theology in the College of New Jersey, provided Webster with a recommendation letter for purposes of lobbying for protection of his work, he observed that: "Men of industry or of talents . . . have a right to the property of their production; and it encourages invention and improvement to secure it to them by certain laws."⁷⁶ Smith did not indicate whether the "certain laws" he recommended were ad hoc legislative privileges or general copyright regimes. He did mention that such legislation "has been practiced in European countries with advantage and success."⁷⁷ Smith was most likely referring to the Statute of Anne.

The most explicit and elaborate reliance on the Statute of Anne in support of copyright legislation came the following year from Joel Barlow.⁷⁸ In January 1783, Barlow wrote Elias Boudinot, the president of the Continental Congress, about what he described as "the embarrassment which bears upon the interests of literature & works of genius in the United States."⁷⁹ Probably working under the assumption that the Continental Congress had no power to enact copyright protection on the national level, Barlow tried to obtain from it a recommendation to the states to legislate in this area.

Like Smith, Barlow used a combination of utilitarian and natural property rights arguments. As to the former, Barlow observed that in other countries

[t]he Historian, The Philosopher, the Poet & the Orator have not only been considered among the first ornaments of the age & country which produced them; but have been secured in the profits arising from their labor, and in that way received encouragement in

76. Webster, *supra* note 70, at 173.

77. *Id.*

78. Barlow was Webster's classmate at Yale. After wartime service as a chaplain for the Massachusetts brigade he settled in Hartford, where he failed to find a patron to support his writing. See JAMES WOODRESS, *YANKEE'S ODYSSEY: THE LIFE OF JOEL BARLOW* 74–77 (1958).

79. *IV PAPERS OF THE CONTINENTAL CONGRESS, 1774–1789*, No. 78, at 369 (1783).

some proportion to their merit in advancing the happiness of mankind.⁸⁰

Echoing the “encouragement of learning” rationale of the Statute of Anne, Barlow argued that “we are not to expect to see any works of considerable magnitude, (which must always be works of time & labor), offered to the Public till such security be given.”⁸¹ To this he added the following natural property rights argument:

There is certainly no kind of property, in the nature of things, so much his own, as the works which a person originates from his own creative imagination: And when he has spent great part of his life in study, wasted his time, his fortune & perhaps his health in improving his knowledge & correcting his taste, it is a principle of natural justice that he should be entitled to the profits arising from the sale of his works.⁸²

Barlow buttressed these arguments with a fairly detailed reference to the Statute of Anne and a recommendation for the adoption of similar statutes by the states:

In England, your Excellency is sensible that the copy-right of any book or pamphlet is holden by the Author & his assigns for the term of fourteen years from the time of its publication; &, if he is then alive, for fourteen years longer. If the passing of statutes similar to this were recommended by Congress to the several States, the measure would be undoubtedly adopted, & the consequences would be extensively happy upon the spirit of the nation⁸³

The efforts by Barlow and others who petitioned Congress on the matter were successful. The petition was referred to a three person committee, who submitted a report that echoed Barlow’s argument by concluding that “nothing is more properly a man's own than the fruit of his study, and that the protection and security of literary property would greatly tend to encourage genius, to promote useful discoveries and to the general extension of the arts and commerce”⁸⁴ Based on this report, Congress issued a resolution in the form of a recommendation that did not mention the Statute

80. *Id.*

81. *Id.*

82. *Id.*

83. *Id.*

84. 24 JOURNALS OF THE CONTINENTAL CONGRESS 1774–1789, at 326 (Gaillard Hunt ed., 1922).

of Anne but closely tracked its outline. It recommended that the states “secure to the authors or publishers of any new books not hitherto printed, being citizens of the United States, and to their executors, administrators and assigns, the copyright of such books,” for a minimum term of fourteen years, once renewable by a surviving author.⁸⁵

Thus, the Statute of Anne was first introduced into public discourse in the United States as part of the effort to convince authorities to extend general protection to authors. The Statute was appealed to as a successful precedent from a civilized European country. Alongside the literary property debate, it was the source for substantive arguments in favor of authors’ rights. It also provided a basic model to implement in the new nation. When the states responded to the lobbying and began to legislate copyright enactments, the reliance on the Statute of Anne went even deeper. Rather than just a general model for a regime of authors’ rights, it became a concrete doctrinal template, with many of its details closely replicated by the American statutes.

B. THE STATE STATUTES

Connecticut, Massachusetts, and Maryland enacted copyright statutes prior to the Continental Congress resolution.⁸⁶ By 1786, all the states except Delaware (which would remain the holdout) had passed such enactments.⁸⁷ These statutes differed from each other in regard to many of the details, but they were all miniature versions of the Statute of Anne.⁸⁸ Whether all state drafters were working directly from the British Statute or some of them simply copied from other states’ statutes, they all tracked the Statute of Anne closely, sometimes to the degree of duplicating substantial parts of its text.

85. *Id.* at 326–27.

86. ACTS AND LAWS OF THE STATE OF CONNECTICUT IN AMERICA, *supra* note 72; An Act Respecting Literary Property, in LAWS OF MARYLAND, MADE AND PASSED AT A SESSION OF ASSEMBLY: BEGUN AND HELD AT THE CITY OF ANNAPOLIS, ON MONDAY THE TWENTY-FIRST OF APRIL, IN THE YEAR OF OUR LORD ONE THOUSAND SEVEN HUNDRED AND EIGHTY-THREE ch. 34 (1783); An Act for the Purpose of Securing to Authors the Exclusive Right and Benefit of Publishing their Literary Productions, for Twenty-one Years, in THE PERPETUAL LAWS OF THE COMMONWEALTH OF MASSACHUSETTS 369–70 (Boston, Mass., Adams and Nourse, 1789).

87. PATTERSON, *supra* note 8, at 183–84.

88. For a general survey of the state statutes, see Francine Crawford, *Pre-Constitutional Copyright Statutes*, 23 BULL. COPYRIGHT SOC. 11 (1975); *see also* Oren Bracha, *Commentary on: Connecticut Copyright Statute, USA (1783)*, in PRIMARY SOURCES ON COPYRIGHT (1450–1900), (L. Bently & M. Kretschmer eds., 2008), available at www.copyrighthistory.org.

The similarity pervaded the statutes, from the titles and the preambles to some of the more technical details.

The Statute of Anne's title coupled its public policy purpose with its proprietary rights means. It was officially named "An Act for the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, During the Times therein mentioned."⁸⁹ Some state statutes' titles, such as Pennsylvania's "An act for the encouragement and promotion of learning by vesting a right to the copies of printed books in the authors or purchasers of such copies, during the time therein mentioned,"⁹⁰ maintained this duality. Other titles emphasized either the public policy or the vesting of rights element, but not both. Connecticut's "An Act for the Encouragement of Literature and Genius"⁹¹ was an early example of the former. Two months later, Massachusetts named its statute "An Act for the Purpose of Securing to Authors the exclusive Right and Benefit of publishing their Literary Productions for Twenty-one Years,"⁹² thereby focusing exclusively on the property rights element of the Statute of Anne's title. The Maryland statute's title exhibited an even stronger influence of the literary property debate. It was called simply "An Act respecting literary property."⁹³ The titles of all the other state statutes followed one of those strategies.

A similar division exhibiting the combined influence of the Statute of Anne and the literary property debate can be seen in the statutes' preambles. The Statute of Anne's preamble read as follows:

Whereas printers Booksellers and other Persons have of late frequently taken the liberty of Printing, Reprinting and Publishing or causing to be Printed, Reprinted, and Published Books, and other Writings, without the Consent of the Authors or Proprietors of such Books and Writings, to their very great Detriment, and too often to the Ruin of them and their Families: For Preventing

89. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19, pmb1 (1710) (Gr. Brit.).

90. An Act for the Encouragement and Promotion of Learning, 1784, in LAWS ENACTED IN THE SECOND SITTING OF THE EIGHTH GENERAL ASSEMBLY, OF THE COMMONWEALTH OF PENNSYLVANIA, WHICH COMMENCED AT PHILADELPHIA, ON TUESDAY THE THIRTEENTH DAY OF JANUARY, IN THE YEAR OF OUR LORD, ONE THOUSAND SEVEN HUNDRED EIGHTY AND FOUR 306 (Phila., Penn., Thomas Bradford, 1784) [hereinafter COMMONWEALTH OF PENNSYLVANIA].

91. ACTS AND LAWS OF THE STATE OF CONNECTICUT IN AMERICA, *supra* note 72.

92. THE PERPETUAL LAWS OF THE COMMONWEALTH OF MASSACHUSETTS, *supra* note 86.

93. LAWS OF MARYLAND, *supra* note 86.

therefore such Practices for the future, and for the Encouragement of Learned Men to Compose and Write useful Books⁹⁴

This text reflected the new lobbying strategy the stationers adopted in 1707.⁹⁵ It was composed of language taken from several of the newer stationers' petitions and contained all the elements of their new case: no appeal to censorship, a complaint of the economic damage caused to publishers by reprints, a recognition of the author's interest and motivations, and an explicit connection between the protection of printing rights and the public policy of encouraging learning.

Strikingly, two of the American state statutes replicated the stationers' exact argument over seventy years later. The Pennsylvania enactment simply copied the Statute of Anne's preamble almost to the letter, alongside a reference to the Continental Congress resolution.⁹⁶ The Maryland preamble was somewhat condensed, but still a very similar version of the Statute of Anne's preamble.⁹⁷

Other states were a little more creative in the preambles of their statutes, but they all still employed various mixes of the encouragement of learning rationale from the Statute of Anne and the natural property right argument traceable to the literary property debate. The two basic models were the early statutes of Connecticut and Massachusetts. Connecticut's preamble read:

Whereas it is perfectly agreeable to the Principles of natural Equity and Justice, that every Author should be secured in receiving the Profits that may arise from the Sale of his Works and such Security may encourage Men of Learning and Genius to publish their Writings; which may do Honour to their Country, and Service to Mankind.⁹⁸

The Massachusetts preamble repeated the same combination of arguments but stated the natural right argument in somewhat stronger terms, similar to terms used by Barlow in his petition to the Continental Congress:

Whereas the improvement of knowledge, the progress of civilization, the publick weal of Commonwealth, and the advancement of human happiness, greatly depend on the efforts of learned and ingenious persons in the various arts and sciences: As the principle encouragement such persons can have to make great

94. 8 Ann., c. 19, pmb.

95. *See supra* Part II.

96. COMMONWEALTH OF PENNSYLVANIA, *supra* note 90, at 306.

97. LAWS OF MARYLAND, *supra* note 86, at pmb.

98. ACTS AND LAWS OF THE STATE OF CONNECTICUT IN AMERICA, *supra* note 72.

and beneficial exertions of this nature, must exist in the legal security of the fruits of their study and industry to themselves, and as such security is one of the natural rights of all men, there being no property more peculiarly man's own than that which is produced by the labour of his mind.⁹⁹

All the other statutes that had preambles (South Carolina and Virginia did not) copied, though sometimes with minor modifications, either the Connecticut or the Massachusetts preambles.¹⁰⁰

The borrowing did not stop with titles and preambles, but rather encompassed all aspects of the states' copyright regimes. Despite the differences between the statutes on many of the specifics, they were all variants on the main themes of the Statute of Anne. The subject matter covered by the state statutes consisted of variations of the Statute of Anne's "book or books."¹⁰¹ As in the Statute of Anne,¹⁰² registration of a protected work was required in most states.¹⁰³ In contrast to the extensive deposit requirement in Britain (nine copies),¹⁰⁴ only Massachusetts and North Carolina required deposit of copies.¹⁰⁵ The entitlements protected by the acts were different variations on the Statute of Anne that identified an infringer as anyone who would "Print, Reprint, or Import, or cause to be Printed, Reprinted, or Imported" or "knowing the same to be so Printed or Reprinted, without the Consent of the Proprietors shall Sell, Publish, or Expose to Sale, or cause to be Sold, Published, or Exposed to sale" a protected book.¹⁰⁶ All states limited the term of protection. With one exception, the duration consisted of different variations on the Statute of

99. THE PERPETUAL LAWS OF THE COMMONWEALTH OF MASSACHUSETTS, *supra* note 86, at 369.

100. The Massachusetts model was followed by New Hampshire and Rhode Island. The Connecticut one was adopted by North Carolina, Georgia, and New York. New Jersey's preamble was a curious combination of both.

101. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19, § 1 (1710) (Gr. Brit.); *see also* Crawford, *supra* note 88, at 18–21.

102. 8 Ann., c. 19, § 2.

103. *See* Crawford, *supra* note 88, at 23–25.

104. 8 Ann., c. 19, § 5.

105. THE PERPETUAL LAWS OF THE COMMONWEALTH OF MASSACHUSETTS, *supra* note 86, § 2; An Act for Securing Literary Property § 1, *in* LAWS OF THE STATE OF NORTH CAROLINA: PUBLISHED, ACCORDING TO ACT OF ASSEMBLY, BY JAMES IREDELL, NOW ONE OF THE ASSOCIATE JUSTICES OF THE SUPREME COURT 563 (Edenton, N.C., Hodge and Wills, 1791).

106. 8 Ann., c. 19, § 1; *see* Bracha, *supra* note 88.

Anne's terms.¹⁰⁷ The Statute of Anne provided only two remedies: the forfeiture and destruction of infringing copies, and a per-sheet punitive sum that was to be divided between the crown and “any person or persons that shall sue for the same.”¹⁰⁸ The state statutes showed creativity here, but all of them remained within the framework of a penalty/damages sum defined by a statutory formula.¹⁰⁹

Two other features of several state statutes are particularly illustrative of the influence of the Statute of Anne. One feature was an attempt by five of the state statutes to give specific expression to the anti-monopoly concerns expressed in the Statute of Anne. Four states required copyrighted books to be sold in sufficient copies and at reasonable prices,¹¹⁰ and one limited itself to a reasonable price requirement.¹¹¹ Underlying these requirements was the view elaborated by the Georgia Statute that “it is equally necessary for the encouragement of learning that the inhabitants of this State be furnished useful books &c. at reasonable prices.”¹¹² Exorbitant prices and insufficient supply were the economic ills traditionally associated with monopolies in English political discourse since the beginning of the seventeenth century.¹¹³ Like the Statute of Anne,¹¹⁴ the five state statutes created a procedure meant to deal with violations of the supply and price requirements by an author or

107. 8 Ann., c. 19, § 1; *see* Crawford, *supra* note 88, at 21–23. New Hampshire created the original duration of twenty years. *See* An Act for the Encouragement of Literature and Genius, and for Securing to Authors the Exclusive Right and Benefit of Publishing their Literary Productions for Twenty-One Years, *in* THE PERPETUAL LAWS OF THE STATE OF NEW HAMPSHIRE 161, 162 (Portsmouth, N.H., John Melcher, 1789).

108. 8 Ann., c. 19, § 1.

109. *See* Crawford, *supra* note 88, at 31–33.

110. ACTS AND LAWS OF THE STATE OF CONNECTICUT IN AMERICA, *supra* note 72, at 134; An Act for Encouragement of Literature and Genius, *in* A DIGEST OF THE LAWS OF THE STATE OF GEORGIA: FROM ITS FIRST ESTABLISHMENT AS A BRITISH PROVINCE DOWN TO THE YEAR 1798, INCLUSIVE, AND THE PRINCIPAL ACTS OF 1799: IN WHICH IS COMPREHENDED THE DECLARATION OF INDEPENDENCE; THE STATE CONSTITUTIONS OF 1777 AND 1789, WITH ALTERATIONS AND AMENDMENTS IN 1794. ALSO THE CONSTITUTION OF 1798, at 323, § 3 (Phila., Ga., R. Aitken, 1800); An Act for the Encouragement of the Arts and Sciences, 1784, *in* ACTS, ORDINANCES, AND RESOLVES OF THE GENERAL ASSEMBLY OF THE STATE OF SOUTH CAROLINA, PASSED IN THE YEAR 1784, at 49, 50–51 (Charleston, S.C., J. Miller, 1784); An Act to Promote Literature, *in* LAWS OF THE STATE OF NEW-YORK: PASSED BY THE LEGISLATURE OF SAID STATE, AT THEIR NINTH SESSION 99, § 3 (N.Y., N.Y., Samuel Loudon and John Loudon, 1786).

111. LAWS OF THE STATE OF NORTH CAROLINA, *supra* note 105, § 2.

112. DIGEST OF THE LAWS OF THE STATE OF GEORGIA, *supra* note 110, § 3.

113. *See* CHRISTINE MACLEOD, INVENTING THE INDUSTRIAL REVOLUTION: THE ENGLISH PATENT SYSTEM 1660–1800, at 15–16 (1988).

114. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19, § 4 (1710) (Gr. Brit.).

publisher. South Carolina, Georgia, and New York followed the procedure introduced by the Connecticut Statute.¹¹⁵ The procedure was based on a complaint to local judicial authorities. These authorities were authorized to impose fixed quantities and prices on the copyright owner, and in the case of failure or refusal to meet these requirements, to authorize reprints by the complainant. North Carolina's judicial procedure for enforcing its reasonable prices requirement was similar, but it included no compulsory license element. Like the Statute of Anne, it relied instead on a monetary penalty against copyright owners who violated judicially fixed prices.¹¹⁶ Thus, five states seriously implemented the Statute of Anne's price-fixing procedure. Four of those expanded it to include cases of insufficient copies and attempted to reform the Statute of Anne's enforcement mechanism.

The other feature that merits particular interest is the saving clauses included in the statutes of Connecticut, Georgia, and New York.¹¹⁷ The Connecticut provision is representative. It provided that "nothing in this Act shall extend to affect, prejudice or confirm the Rights which any Person may have to the printing or publishing of any Book, Pamphlet, Map or Chart, at Common Law, in Cases not mentioned in this Act."¹¹⁸ One may be tempted to conclude that these state legislatures were taking a strong position on the questions of the literary property debate that swept England: the existence of common law copyright and the relationship between it and the statutory framework. A closer look shows otherwise. The result of the no "affect, prejudice or confirm" language was neutrality in regard to the existence of any common law rights. Moreover, these provisions were clearly the result of a misreading of section nine of the Statute of Anne.¹¹⁹ They used language almost identical to that section, except that the original did not mention common law rights and was intended to avoid any effect on the royal printing patents of the universities and of others.¹²⁰ It had nothing to do with

115. ACTS AND LAWS OF THE STATE OF CONNECTICUT IN AMERICA, *supra* note 72, at 134; DIGEST OF THE LAWS OF THE STATE OF GEORGIA, *supra* note 110, § 3; LAWS OF THE STATE OF NEW-YORK, *supra* note 110, § 3; ACTS, ORDINANCES, AND RESOLVES, *supra* note 110, at 50–51.

116. 8 Ann., c. 19, § 4; LAWS OF THE STATE OF NORTH CAROLINA, *supra* note 105, § 2.

117. ACTS AND LAWS OF THE STATE OF CONNECTICUT IN AMERICA, *supra* note 72, at 134; DIGEST OF THE LAWS OF THE STATE OF GEORGIA, *supra* note 110, § 4; LAWS OF THE STATE OF NEW-YORK, *supra* note 110, § 4.

118. ACTS AND LAWS OF THE STATE OF CONNECTICUT IN AMERICA, *supra* note 72, at 134.

119. 8 Ann., c. 19, § 9.

120. PATTERSON, *supra* note 8, at 189. It is possible that the source of the mistake was the fact that some proponents of common law copyright in England offered a similar

common law copyright. It was a classic case of an element of a transplanted law whose meaning was lost in translation.

The practical significance of the state statutes was not large. As far as we know, they were not extensively used, and it is possible that two of them never even went into effect.¹²¹ They were also soon superseded in practice by the federal regime. The importance of the statutes was on two other planes. First, the statutes and the deliberative process surrounding them spurred Americans to think about copyright, ponder its purposes, and articulate its justifications. Second, the specific enactments formed an institutional precedent: a detailed model of a regime for protecting authors' rights that was bound to influence any future attempt to achieve the same goal. The Statute of Anne played a cardinal role in regard to both of these dimensions.

C. THE CONSTITUTIONAL CLAUSE

The next big step for copyright in America was the shift to the national level. This came with the Constitution, which granted Congress the power "To promote the Progress of Science and useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."¹²² Questions about the exact meaning of the constitutional clause and its sources are beyond the scope of this essay. It is worthwhile to sketch briefly, however, some obvious connections between the clause and the Statute of Anne.

One such connection is the "limited times" element. By the end of the eighteenth century, the principle of limited duration of monopolies had been a staple of English political thought for two centuries. According to this principle, monopolies usually seen as reprehensible could be tolerated in exceptional cases where they served the public good, provided the monopolies were kept within certain safeguards. Chief among these safeguards was limited duration.¹²³ A written exchange between James Madison and Thomas Jefferson shortly after the ratification of the Constitution demonstrates the extent to which Americans internalized this

misreading of section nine of the Statute of Anne in support of their claim that common law copyright existed and was not taken away by the Statute. *See* *Millar v. Taylor*, (1769) 98 Eng. Rep. 201, 227 (K.B.).

121. The statutes of Pennsylvania and Maryland suspended their operation until all states legislated similar enactments, a condition that never came about due to Delaware's holdout. *See* COMMONWEALTH OF PENNSYLVANIA, *supra* note 90, § 7; LAWS OF MARYLAND, *supra* note 86, § 6.

122. U.S. CONST. art. I, § 8, cl. 8.

123. *See* Bracha, *supra* note 59, at 197–98.

outlook. Jefferson, who was absent from the convention due to his position as the American minister to France, wrote Madison that “it is better . . . to abolish . . . Monopolies, in all cases, than not to do it in any.” He added that “saying there shall be no monopolies lessens the incitement to ingenuity, which is spurred on by the hope of a monopoly for a limited time, as of 14 years; but the benefit even of limited monopolies is too doubtful to be opposed to that of their general suppression.”¹²⁴ Madison took exception:

In regard to Monopolies, they are justly classed among the greatest nuisances in Government. But is it clear that as encouragements to literary works and ingenious discoveries, they are not too valuable to be wholly renounced? Would it not suffice to reserve in all cases the right to the public to abolish the privilege at a price to be specified in the grant of it?¹²⁵

In reply, Jefferson, who now reluctantly accepted the congressional power to grant such monopolies, suggested that the future Bill of Rights would provide that “Monopolies may be allowed to persons for their own production in literature, and their own inventions in the arts for a term not exceeding — years, but for no longer term, and for no other purpose.”¹²⁶ The concepts of tolerated beneficial monopolies as the exception, and of limited duration as an essential safeguard, were derived mainly from the context of the Statute of Monopolies and related common law.¹²⁷ The Statute of Anne, however, had the same principle at its foundation and was probably an important secondary source. Given the strong English tradition and the newer precedents from the states—copyright enactments and ad hoc printing privilege grants—it is hardly a surprise that the constitutional clause included a limited duration restriction.

Another connection between the Statute of Anne’s legacy and the constitutional clause—the latter’s focus on authors—may seem too trivial to mention. It is not. By 1789, it may have been a foregone conclusion that any rights created by Congress in this field would be given to authors, rather than

124. Letter from Thomas Jefferson to James Madison, (July 31, 1788), in 1 THE REPUBLIC OF LETTERS: THE CORRESPONDENCE BETWEEN THOMAS JEFFERSON AND JAMES MADISON, 1776–1826, at 545 (James Morton Smith ed., 1995) [hereinafter REPUBLIC OF LETTERS].

125. Letter from James Madison to Thomas Jefferson (Oct. 17, 1788), in REPUBLIC OF LETTERS, *supra* note 124, at 566.

126. Letter from Thomas Jefferson to James Madison (Aug. 28, 1789), in REPUBLIC OF LETTERS, *supra* note 124, at 630.

127. See Ochoa & Rose, *supra* note 59, at 691. On the Statute of Monopolies background and the origin of patent law, see Bracha, *supra* note 59, at 191–200.

publishers. An important part of the reason for this consensus on the status of authors by 1789, however, was the preceding decade of authorship that saw vigorous campaigns for authors' rights as well as legislation of authors' rights regimes across the nation, all under the inspiration of the Statute of Anne. Thus, if at the beginning of the decade the Statute of Anne's principle of authors' rights was presented as a model for imitation, close to its end, it was already taken for granted.

Finally, the most important concept connecting the clause to the Statute of Anne is the constitutional grant of power to "Promote the Progress of Science and useful Arts."¹²⁸ As explained, the basic notion that monopolies should be tolerated in the exceptional cases where they serve the public good is traceable to early seventeenth century England. The concrete formula, however, appears to be more closely linked to the Statute of Anne, as the promotion of science in the constitutional clause was actually synonymous with the "encouragement of learning" in the Statute of Anne. Several of the state statutes' titles replaced or supplemented "encouragement" (of learning or literature) with "promotion" or "to promote."¹²⁹ The term "science" was understood to mean learning or knowledge,¹³⁰ and indeed the South Carolina Statute was called "An Act for the encouragement of arts and sciences."¹³¹ The clause and the Statute of Anne shared then the goal of encouraging learning/promoting science. To be sure, the concept's precise meaning was different in early eighteenth century England and in the first years of the American republic almost a century later. The American concept put more emphasis on broad dissemination of knowledge throughout society,¹³² and tended to understand the ideal mainly as a political one closely related to the health and virtue of the polity.¹³³ Still, the general ideal entrenched in the

128. U.S. CONST. art. I, § 8, cl. 8.

129. See, e.g., An Act for the Promotion and Encouragement of Literature, 1783, in ACTS OF THE GENERAL ASSEMBLY OF THE STATE OF NEW JERSEY 325–26 (Trenton, N.J., Peter Wilson, 1784); LAWS OF THE STATE OF NEW-YORK, *supra* note 110; COMMONWEALTH OF PENNSYLVANIA, *supra* note 90.

130. Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution*, 2 J. INTELL. PROP. L. 1, 51 (1994); see also Karl B. Lutz, *Patents and Science: A Clarification of the Patent Clause of the U.S. Constitution*, 32 J. PAT. OFF. SOC'Y 83, 84 (1952).

131. ACTS, ORDINANCES, AND RESOLVES, *supra* note 110.

132. See Dianne Leenheer Zimmerman, *The Statute of Anne and Its Progeny: Variations Without a Theme*, 47 HOUS. L. REV. (forthcoming 2010) (manuscript at 4–5, on file with author).

133. See Oren Bracha, *The Ideology of Authorship Revisited: Authors, Markets, and Liberal Values in Early American Copyright*, 118 YALE L.J. 186, 243–44 (2008).

American constitutional clause was the same as the ideal from the British Statute.

Unsurprisingly, given the nature of the document, the lines that connect the constitutional clause to the Statute of Anne operate on an abstract, conceptual level. Soon after the ratification of the Constitution, however, the new Congress exercised its power and enacted a federal copyright act, which reintroduced more direct forms of textual and doctrinal plagiarism.

D. THE 1790 COPYRIGHT REGIME

To put it bluntly, America's first federal copyright enactment—the 1790 Copyright Act¹³⁴—is the Statute of Anne phrased in somewhat more modern language and featuring a few omissions, additions, and modifications. As with the state statutes, the similarity is felt on every level, including structure, legal technicalities, and specific text. It is possible that the Statute of Anne influenced the 1790 Act indirectly through the texts of some of the state statutes. Yet, there are some indications that the drafters of the 1790 Act worked directly from a version of the Statute of Anne.

The similarity begins with the title. The Statute of Anne was named “An Act for the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, during the Times therein mentioned.”¹³⁵ The title of the 1790 Act was “An Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.”¹³⁶ The 1790 Act dispensed with the preamble of the Statute of Anne, but everything that followed was almost identical.

Both acts applied to existing, published works and to unpublished and future works, although the Statute of Anne, unlike the American Act, prescribed a longer term of twenty-one years for the former category.¹³⁷

The Statute of Anne defined an offender as the person who

shall Print, Reprint, or Import, or cause to be Printed, Reprinted, or Imported any such Book or Books, without the Consent of the Proprietor or Proprietors thereof first had and obtained in Writing, Signed in the Presence of Two or more Credible Witnesses; or knowing the same to be so Printed or Reprinted, without the

134. Act of May 31, 1790, ch. 15, 1 Stat. 124.

135. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19 (1710) (Gr. Brit.).

136. Act of May 31, 1790, ch. 15, 1 Stat. 124.

137. 8 Ann., c. 19, § 1; 1 Stat. 124 § 1.

Consent of the Proprietors, shall Sell, Publish, or Expose to Sale, or cause to be Sold, Published, or Exposed to Sale, any such Book or Books, without such Consent first had and obtained, as aforesaid.¹³⁸

The American Statute defined an offender as a person who

shall print, reprint, publish, or import, or cause to be printed, reprinted, published, or imported from any foreign Kingdom or State, any copy or copies of such map, chart, book or books, without the consent of the author or proprietor thereof, first had and obtained in writing, signed in the presence of two or more credible witnesses; or knowing the same to be so printed, reprinted, or imported, shall publish, sell, or expose to sale, or cause to be published, sold or exposed to sale, any copy of such map, chart, book or books, without such consent first had and obtained in writing as aforesaid.¹³⁹

Unlike the Statute of Anne, the American Statute explicitly provided protection to manuscripts.¹⁴⁰ Like some of the state statutes that supplied similar statutory protection, this may have been the result of awareness of the 1741 decision, *Pope v. Curl*,¹⁴¹ which provided protection to unpublished works as a logical extension or an auxiliary to the statutory protection of published works.

The only remedies in the 1790 Act were those in the Statute of Anne: forfeiture of infringing copies and a statutory penalty calculated on a per-sheet basis to be divided between the plaintiff and the Crown or the United States. There was an interesting divergence in regard to the identity of such a plaintiff. The Statute of Anne awarded half the sum of the statutory penalty to “to any Person or Persons that shall Sue for the same”¹⁴²—possibly a contemplation of *qui tam* actions.¹⁴³ H.R. 10,¹⁴⁴ the first bill that resulted in

138. 8 Ann., c. 19, § 1.

139. 1 Stat. 124 § 2.

140. *Id.* § 6.

141. 26 Eng. Rep. 608 (1741).

142. 8 Ann., c. 19, § 1.

143. *Qui tam* actions in which plaintiffs with no direct interest in the case—a “common informer”—could bring actions and enjoy compensation were common enforcement mechanisms in England and its colonies. On *qui tam* actions, see Note, *The History and Development of Qui Tam Actions*, 1972 WASH. U .L.Q. 81, 83–91 (1972); J. Randy Beck, *The False Claims Act and the English Eradication of Qui Tam Legislation*, 78 N. C. L. REV. 539, 550–55 (2000).

144. H.R. 10 was a joint copyright-patent Bill. No known copy of it has survived. Available texts of the Bill are based on a later typescript of the original. The Bill is reproduced in 4 DOCUMENTARY HISTORY OF THE FIRST FEDERAL CONGRESS, 1789–1791,

the 1790 Act, retained the *qui tam* action approach by splitting the penalty sum between “the author . . . or the proprietor” and “any person or persons who shall sue for the same.”¹⁴⁵ The final Act, however, dispensed with this mechanism and split the fine between the United States and “the author or proprietor of such map, chart, book or books who shall sue for the same.”¹⁴⁶

The American Copyright Act followed the British Statute in requiring registration and deposit of the protected work, although it modified and liberalized some of the technical details of these requirements. In contrast to the nine deposited copies required by the Statute of Anne,¹⁴⁷ the Copyright Act required only one copy to be deposited with the Secretary of State.¹⁴⁸ The legislative history of the registration sections strongly supports the conclusion that the American drafters borrowed directly from the Statute of Anne. The British Statute ordered registration in the “Register-Book of the Company of Stationers.”¹⁴⁹ It also provided for a complex mechanism for resolving cases in which the Clerk of the Stationers’ Company “shall Refuse or Neglect” to register works.¹⁵⁰ The reason for this unusual concern was that the Statute of Anne dissolved the long-held monopoly on publishing the Stationers’ Company members enjoyed and turned the Company’s register book into a public record open to any person entitled to copyright protection under the new regime.¹⁵¹ Against this background, there was a palpable concern that the Company might not cooperate and refuse to register works of non-members. This concern was absent in the United States seventy years later where registration was committed to the clerks of the federal district courts. Nonetheless, the drafters of H.R. 10 unwittingly retained a similar mechanism for dealing with refusals to register.¹⁵² Only in later drafts was this anachronistic provision eliminated from the Statute.

There were some other interesting modifications. Missing from the 1790 Act was the Statute of Anne’s price control procedure, which was intended to deal with cases of “unreasonable” prices charged by copyright owners.¹⁵³ It is unknown whether the American drafters simply saw this provision as

at 519 (Linda Grant De Pauw et al. eds., 1986). Citations here are to the original typescript available in the Copyright Office [hereinafter H.R. 10].

145. *Id.* at 2.

146. Act of May 31, 1790, ch. 15, 1 Stat. 124 § 2.

147. 8 Ann., c. 19, § 5.

148. 1 Stat. 124 § 4.

149. 8 Ann., c. 19, § 2.

150. *Id.* § 3.

151. *See supra* Part II.

152. H.R. 10, *supra* note 144, at 3.

153. 8 Ann., c. 19, § 4.

unnecessary or unworkable, or if they were aware that in Britain it was repealed in 1739, probably without having been used.¹⁵⁴ The American Statute broadened the Statute of Anne's explicit allowance of the importation and sale of any foreign language books¹⁵⁵ to exclude from protection "the importation or vending, reprinting or publishing within the United States" of any work "written, printed, or published by any person not a citizen of the United States, in foreign parts or places without the jurisdiction of the United States."¹⁵⁶ Finally, the Statute of Anne's right of reversion given to the author was bundled with renewal. H.R. 10 repeated the Statute of Anne's arrangement that after the expiration of the first fourteen year term, the right "shall return" to a surviving author for another term of fourteen years.¹⁵⁷ The 1790 Act, however, conditioned the second term upon a procedure of re-registration that was performed within the six months prior to expiration.¹⁵⁸

As becomes apparent from this brief survey, the 1790 Copyright Act closely followed the Statute of Anne. In a few cases, it made omissions or inserted interesting modifications, but in essence, the statutory framework and much of its details remained the same.

IV. WHY THE STATUTE OF ANNE?

What accounts for this massive duplication on the state and federal level? Why would Americans, at a moment of great national enthusiasm, turn to an almost century old British Statute deeply rooted in the context of the English book trade, despite America's lack of the constraints of previously existing institutions and norms?

One possible answer is based on a denial of the last premise of this question. The Statute of Anne arguably represented a moment of universalization. Its main innovation was exactly in detaching the copyright regime from its entanglement with the guild institutional context and the censorship apparatus, thereby creating a general template for the protection of authors' rights. Such a general template, being free from the specifics of a particular society and culture, was highly transportable. That is to say, it was particularly suited for being borrowed and implemented in other societies, even those with very different social and cultural conditions. The argument could be recast in terms of the legal transplants literature. An important

154. Printing Act 1739, 8 Geo. 2, c. 36 (Gr. Brit.).

155. 8 Ann., c. 19, § 7.

156. Act of May 31, 1790, ch. 15, 1 Stat. 124 § 5.

157. Compare 8 Ann., c. 19, § 11, with H.R. 10, *supra* note 144, at 4.

158. 1 Stat. 124 § 1.

argument from this literature is that the likelihood of a transplantation of a legal institution and the likelihood of the success of such transplantation is correlated with the extent to which that legal institution is embedded in local social, cultural, and political structures.¹⁵⁹ Thus, by way of generalization, one should expect less transplantation and more resistance to transplantation in fields, like family law, that tend to be highly immersed in local social-cultural context. On the other hand, one should expect more successful, resistance-free transplantation in fields that tend to be relatively less entangled in such local context, such as commercial law.¹⁶⁰ Arguably, the Statute of Anne pushed the English copyright regime from one end of the scale to the other. A regime that was once deeply embedded in local political-ideological power structures (the licensing system) and in local social-economic institutions (the Stationers' Company) was severed from all of those entanglements and thus became particularly suitable for transplantation elsewhere.

This explanation is partial at best. To be sure, detaching the English copyright regime from the censorship and guild context was a necessary condition for making it an even plausible source of inspiration for late eighteenth century Americans. Nevertheless, in many respects, the Statute of Anne remained deeply rooted in its local social, political, and institutional context. As explained, the Statute expressed a compromise between the specific conflicting interests and ideological forces of early eighteenth century England: the demands of powerful members of the Stationers' Company; the interests of smaller members of the book trade; hostility towards monopolies and the concentrated power of the Company; the decline of the censorship system; a new interest in the well-being and rights of authors; and a rising concern for the encouragement of learning.¹⁶¹ Furthermore, the means of implementing the compromise incorporated much of the preexisting institutional framework and retained much of the prior arrangements in the field. What was not in the Statute is just as important. It did not create the conceptual vocabulary necessary for the new authors' rights framework, but simply relied on the traditional form of the publisher's economic privilege. In short, the Statute of Anne was still deeply embedded in the peculiarities of the society and culture that produced it.

Two other elements may help to explain America resorting to the British Statute. First is the mere fact that it was there. The existence of a detailed and

159. O. Khan-Freund, *On Uses and Misuses of Comparative Law*, 37 MOD. L. REV. 1 (1974).

160. Ron Harris and Michael Crystal, *Some Reflections on the Transplantation of British Company Law in Post-Ottoman Palestine*, 10 THEORETICAL INQUIRIES IN LAW, 561, 562 (2009).

161. See *supra* text accompanying notes 43–55.

accessible template that could be taken “off the shelf” and implemented in a field whose regulation was desired was not a trivial thing. Despite any anti-British sentiments, the new states relied heavily on British law in general. The common law was broadly adopted,¹⁶² and various strategies were employed for revising and implementing British statutes.¹⁶³ There were a variety of reasons for this, including inertia, the need for continuity, demand for the English liberties that were denied beforehand, and the overwhelming task of governing and managing the many aspects of a new nation.¹⁶⁴ Having an organized, ready-made, and somewhat familiar body of law for dealing with the many immediate needs at hand was extremely valuable, whether it was simply implemented or used as a platform for modifications and revisions. Against this backdrop of widespread reliance on British law, the wholesale copying of the Statute of Anne appears a little less remarkable.

The second relevant element was Americans’ vision of England as a bastion of culture and civilization. Comparative law scholars have long identified “prestige” as an important influence on the likelihood of legal transplantation. To the extent the nation in which a particular legal institution originates is perceived as successful, advanced, superior, or enviable, the higher the chance that other nations will transplant that legal institution into their own laws.¹⁶⁵ In the field of literature, culture, and learning, England was the ultimate object of admiration and aspiration for early Americans. When Americans expressed their thoughts about this subject, two themes kept recurring: looking up to the established European nations that were seen as the peak of cultural cultivation and the need for the new nation to achieve its own status among those old powerhouses. In the 1779 preface of his *United States Magazine*, Hugh Henry Brackenridge declared the need to disprove the predictions that Americans would “sink down to so many Ouran-Outans of the wood, lost to the light of science which, for the other side of the Atlantic, had just began to break upon us.”¹⁶⁶ Barlow, in his letter to the Continental Congress, observed that “America has convinced the world of her importance in a political & military line by the wisdom, energy & ardor

162. LAWRENCE M. FRIEDMAN, *A HISTORY OF AMERICAN LAW* 109–15 (2d ed. 1985); William B. Ewald, *The American Evolution and the Evolution of Law*, 42 AM. J. COMP. L. SUPP. 1, 13 (1994).

163. ELIZABETH GASPAR BROWN, *BRITISH STATUTES IN AMERICAN LAW, 1776–1836*, at 23–45 (1964).

164. *Id.* at 23–24; FRIEDMAN, *supra* note 162, at 109–10.

165. *See* Michele Graziadei, *supra* note 5, at 457–59.

166. *THE UNITED STATES MAGAZINE: A REPOSITORY OF HISTORY, POLITICS AND LITERATURE* 3–4 (1779).

for liberty which distinguish the present era. A literary reputation is necessary in order to complete her national character.”¹⁶⁷ Early Americans saw establishing the place of their republic among the civilized and cultivated nations as a project of high national priority. They were looking up to the old world nations in this respect, and their foremost target for envy and imitation was England. This helps explain why, when these hopes were translated to legal means, the British legislation associated with the nourishment of the cultural and scholarly field enjoyed a high status in America.

V. TRANSPLANTING THE STATUTE OF ANNE AS LEGAL TRANSLATION

If the Statute of Anne was a less than obvious candidate for transplantation in the United States in the first place, it may also appear that once transplanted, it did not have high prospects of being a successful, or at least long-surviving, transplant. The book trade in the United States was about to undergo an extensive transformation in the early nineteenth century. Technological and economic developments related to the production and dissemination of books, together with the spread of literacy, laid the foundation for an emerging national market in books.¹⁶⁸ New patterns of organization, operation, and marketing appeared in the publishing industry.¹⁶⁹ By the second half of the century, copyright would gradually become relevant to other industries beyond the traditional context of the book trade.¹⁷⁰ The Statute of Anne was, in this regard, yesterday’s news. It was tailored to deal with the early eighteenth century English book trade and was based on the centuries old stationer’s economic privilege. It was completely silent on some of the issues that would become the most important in the era of a new publishing industry and a focus on authors.

And yet, the Statute of Anne’s statutory framework, imported in the late eighteenth century, survived for a remarkably long period in the United States. The first half of the nineteenth century saw several amendments to the Copyright Act and one general revision in 1831.¹⁷¹ Nevertheless, until the second half of the century, the heart of the statutory copyright regime was

167. IV PAPERS OF THE CONTINENTAL CONGRESS, 1774–1789, No. 78, at 370 (1783).

168. See JOHN WILLIAM TEBBEL, A HISTORY OF BOOK PUBLISHING IN THE UNITED STATES 206–07 (1972); see also James Gilreath, *American Book Distribution*, in 95 PROC. AM. ANTIQUARIAN SOC’Y 501 (1986).

169. See Bracha, *supra* note 133, at 210–12.

170. *Id.* at 213.

171. Act of Apr. 29, 1802, ch. 36, 2 Stat. 171; Act of Feb. 15, 1819, ch. 19, 3 Stat. 481; Act of Feb. 3, 1831, 4 Stat. 436, 436–39.

very much the one created in 1790. The term of copyright protection was extended and certain features were added or modified along the edges, but the Statute of Anne's basic structure and arrangements were still the flesh and bones of the statutory text. Only in the second half of the century, with a few amendments in the 1850s and 1860s¹⁷² that added new entitlements and subject matter and with the new Copyright Act of 1870,¹⁷³ did a significant shift in the statutory framework become visible.

How can this remarkable longevity be explained? The short answer is that the statutory text reflected only part, and not necessarily the most important part, of what copyright law was and meant in America. Some of the insights of the legal transplants literature may help explain this. At one point, scholars devoted much energy to debating the question of whether the concept of a legal transplant in the strict sense is ever possible in reality.¹⁷⁴ The attack on the possibility of transplantation was based on the claim that a legal institution, norm, or concept never acquires meaning standing alone.¹⁷⁵ Rather, a legal element is always part of a system. Its meaning and function are determined, in part, not just by its internal features but also by its relationships with other elements in that system. These other elements include other formal parts of the legal system, modes of operation of the legal system, and more general cultural and social elements that interact with the legal field. Understood in this light, the claim that a transplant is impossible means that the duplication of the exact meaning and function of a legal element taken from one society and culture to another is impossible. While a legal form could be closely duplicated, it is unlikely that the entire system, both legal and socio-cultural, from which a legal element derives its meaning, could be transferred to another society.¹⁷⁶ Much ink had been spilled over this debate, but most comparative lawyers today seem to have settled on various versions of a position that recognizes both the prevalence

172. Act of Aug. 18, 1856, ch. 169, 11 Stat. 138 (1856) (adding a public performance entitlement to dramatic works); Act of Mar. 3, 1865, 13 Stat. 540 (adding photographs as protectable subject matter).

173. Act of July 8, 1870, ch. 230, 16 Stat. 198 (1870).

174. See Graziadei, *supra* note 5, at 465–70.

175. *Id.*

176. Pierre Legrand, *The Impossibility of 'Legal Transplant,'* 4 MAASTRICHT J. EUR. & COMP. L. 111 (1997); Pierre Legrand, *The Same and the Different,* in *COMPARATIVE LEGAL STUDIES 240 passim* (Pierre Legrand & Roderick Munday eds., 2003).

of legal transplants and the fact that exact duplication almost never happens.¹⁷⁷

Thus, Máximo Langer proposed the metaphor of legal translation.¹⁷⁸ Essentially, just like translation, legal transplantation is a creative process that always involves the creation of new meaning rather than just mechanical duplication. Because of the interaction between the transferred legal element and the different legal and socio-cultural system in which it is placed, transplantation is always a creative and dynamic process. The transplanted element usually adapts to its new environment: its meaning and function transform by its interaction with the local elements, even if on the textual-formal level the duplication seems complete.¹⁷⁹ At the same time, the receiving system often accommodates the new element—the interaction between the existing elements and the new one tend to create new meanings and practices with repercussions throughout the system.¹⁸⁰

Transplanting the Statute of Anne in America is best understood as such a process of translation. Despite the close duplication of the statutory text, 1710 English copyright was not simply recreated in America. Rather, in a dynamic and ongoing process, the interaction between the imported form and local needs, interests, and influences produced a new body of copyright law. Much of this process happened through case law. A full survey of how American copyright law gradually acquired meaning during its first century cannot be undertaken here. It may be useful, however, to point out some of the main dimensions in which the regime of the Statute of Anne was developed and transformed, while the statutory scheme was hardly touched.

One dimension concerned the legal criterion for identifying authors and works of authorship. As in the Statute of Anne and the state statutes, the constitutional clause and the 1790 Act focused on authors as the primary right owners.¹⁸¹ But, unsurprisingly for a text that was still immersed in the forms of the stationer's privilege, the statutory scheme contained no attempt to define either authors or works of authorship. Beginning in the 1820s, the courts began to face questions about what could be legitimately included within the purview of copyright protection as works of authorship. Gradually

177. Michele Graziadei, *Legal Transplants and the Frontiers of Legal Knowledge*, 10 THEORETICAL INQUIRIES IN LAW 723, 728–29 (2009); Graziadei, *supra* note 5, at 470. *See generally* ADAPTING LEGAL CULTURES (David Nleken & Johannes Fest eds., 2001).

178. Langer, *supra* note 6.

179. *Id.* at 33–34.

180. *Id.* at 34–35.

181. *See supra* Sections III.C, III.D.

they developed what came to be known as the originality requirement.¹⁸² There were conflicting approaches to questions such as the degree of novelty required by a protected work (if any) or the extent to which courts would police copyright protection on the basis of the substantive content or the nature of the work. In the latter part of the nineteenth century, a minimalist version of originality that rejected both a demanding novelty criterion and close scrutiny of the work's content became dominant.¹⁸³ Most importantly, however, is that by the end of the century, originality came to be viewed as a fundamental part of copyright law and a body of rules and principles consolidated around it, while leaving hardly any trace in the statutory text.

A second important, mostly non-statutory development was the fundamental transformation of the principles that defined the scope of copyright protection. The statutory scheme inherited from the Statute of Anne had little to say about this subject except a reference to the "sole Right and Liberty of Printing" and the actions of printing, reprinting, selling, and importing the protected book.¹⁸⁴ This was the traditional entitlement of the stationer that was understood to be the exclusive right of making verbatim copies of a text in print.¹⁸⁵ In the nineteenth century, this narrow understanding of the scope of copyright protection came under increasing pressure. The courts gradually moved away from the reprint concept by developing legal tests that focused on increasingly abstract levels of similarity, and thereby protected the copyright owner's interest in a widening sphere of secondary markets.¹⁸⁶ As courts deserted the traditional boundaries created by the reprint concept, new mechanisms had to be created for limiting the scope of copyright protection. These were the fair use doctrine, which was first developed by Justice Joseph Story in the 1830s and 1840s,¹⁸⁷ and the idea/expression dichotomy, which was developed toward the end of the

182. See Bracha, *supra* note 133, at 201–09.

183. See *id.* On the later part of this process, see Diane L. Zimmerman, *The Story of Bleistein v. Donaldson Lithographing Company: Originality as a Vehicle for Copyright Inclusivity*, in INTELLECTUAL PROPERTY STORIES (Rochelle Cooper Dreyfuss & Jane C. Ginsburg eds., 2006); Robert Brauneis, *The Transformation of Originality in the Progressive-era Debate over Copyright in News*, 27 CARDOZO ARTS & ENT. L.J. 321, 334 (2009).

184. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19, § 1 (1710) (Gr. Brit.).

185. See Bracha, *supra* note 13, at 188–89.

186. See KAPLAN, *supra* note 10, at 27–32; Bracha, *supra* note 133, at 201–09.

187. See R. Anthony Reese, *The Story of Folsom v. Marsh: Distinguishing Between Infringing and Legitimate Uses*, in INTELLECTUAL PROPERTY STORIES, *supra* note 183, at 259; John Tehranian, *Et Tu, Fair Use? The Triumph of Natural-Law Copyright*, 38 U.C. DAVIS L. REV. 465 (2005); Bracha, *supra* note 133, at 229–30.

century.¹⁸⁸ This fundamental change in the character of copyright protection also took place mainly in the case law. Only in the second half of the century did it receive some statutory expression in the form of additional entitlements, such as translation,¹⁸⁹ dramatization,¹⁹⁰ and public performance,¹⁹¹ that were slowly being added through statutory amendments.

Perhaps somewhat less central to the fundamental nature of copyright, but at least as important in practical terms, was the issue of remedies. The remedial options in the statutory scheme were very limited.¹⁹² Like the Statute of Anne, the only remedies in the 1790 Act were forfeiture of infringing copies and a per-sheet penalty.¹⁹³ There is little information available about the remedial practice of American courts in early copyright cases, but even the little information available shows that in practice courts did not limit themselves to the statutory remedies. In the first reported copyright case in the United States, the 1798 decision *Morse v. Reid*, the circuit court for the District of New York virtually ignored the statutory remedy.¹⁹⁴ In this infringement case involving Jedidiah Morse's *American Geography*, the court ordered an accounting of the defendant's profits arising from the infringement and a monetary relief based on these profits.¹⁹⁵ The remedy was the equitable one of disgorgement of defendant's profits, but the extremely loose way in which the court calculated the profits blurred the distinction between disgorgement of profits and damages.¹⁹⁶ Explicit equity jurisdiction over copyright and patent cases was given to the circuit courts in 1819,¹⁹⁷ but

188. Pamela Samuelson, *The Story of Baker v. Selden: Sharpening the Distinction Between Authorship and Invention*, in INTELLECTUAL PROPERTY STORIES, *supra* note 183, at 159; Bracha, *supra* note 133, at 235–38.

189. The translation and dramatization rights were added in the 1870 Act. See Act of July 8, 1870, ch. 230, 16 Stat. 198 (1870) § 86.

190. *Id.*

191. A public performance entitlement was first extended to dramatic works in 1856 and then to musical compositions in 1897. See Act of Aug. 18, 1856, ch. 169, 11 Stat. 138 (1856); Act of Jan. 6, 1897, ch. 4, 29 Stat. 481 (1897). See generally Zvi Rosen, *The Twilight of the Opera Pirates: A Prehistory of the Exclusive Right of Public Performance for Musical Compositions*, 24 CARDOZO ARTS & ENT. L.J. 1157 (2007).

192. See *supra* Section III.B.

193. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19, § 1 (1710) (Gr. Brit.); Act of May 31, 1790, ch. 15, 1 Stat. 124 § 2.

194. A report of the case can be found in 5 COLLECTIONS OF THE MASSACHUSETTS HISTORICAL SOCIETY 123 (1798).

195. *Id.* at 124.

196. See John D. Gordan, *Morse v. Reid: The First Reported Federal Copyright Case*, 11 L. & HIST. REV. 21, 33–36 (1993).

197. Act of Feb. 15, 1819, ch. 19, 3 Stat. 481. It is unknown whether federal courts also issued injunctions in copyright cases prior to the 1819 explicit authorization to do so.

here was a court in 1798 freely awarding account of profits and perhaps damages as a matter of routine. In post-1819 cases, the award of defendant's profits was a standard remedy. *Morse v. Reid* gives a reason to suspect that was so even prior to 1819.

It is unclear to what extent early nineteenth century courts were willing to formally award common law damages, but American nineteenth century commentators flatly asserted the applicability of non-statutory remedies with little discussion or support. For example, Joseph Story in his *Commentaries on Equity Jurisprudence* seems to take for granted that both the common law remedy of damages and the equitable one of account were available in copyright infringement cases.¹⁹⁸ George Ticknor Curtis asserted in his 1847 treatise that: "No action on the case for damages is provided by statute; but there can be no doubt that here, as well as in England, such an action lies at common law."¹⁹⁹ He gave no reason whatsoever to this confident assertion. Only in 1908, when the question was of much less practical importance, did the Supreme Court reject common law remedies and rule that copyright protection was limited to the remedies provided in the statute.²⁰⁰

The list could be extended, but the point should be clear by now. While the basic statutory framework changed very little during the first half of the nineteenth century and only gradually during the second half, some of the most fundamental elements of the copyright regime were radically changed during this period. When looking only at the formal statutory record, the process of receiving the Statute of Anne in the United States may look like simple duplication. The extent to which the transplant was adapted and transformed within its new environment becomes apparent, however, when one looks at the case law that applied, supplemented and extended the statutory scheme.

Two more general insights about the process of legal transplantation arise from this discussion. First, the process is often dynamic and extends over time. A statutory text was transplanted in the United States in 1790. However, the process of elaborating what this text would mean and how it would function in practice in its new environment continued for many decades. Second, sometimes even the transplantation in the technical sense—

198. 2 JOSEPH STORY, COMMENTARIES ON EQUITY JURISPRUDENCE IN ENGLAND AND AMERICA 210, § 932 (2d ed. 1839).

199. GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF COPYRIGHT 313 (1847).

200. *Globe Newspaper Co. v. Walker*, 210 U.S. 356, 362–67 (1908) (“[T]he purpose of Congress was not only to create the right granted in the statute, but also to create the specific remedies by which alone such rights may be enforced.”).

the transfer of legal elements from one jurisdiction to another—happens not in one fell swoop but as a prolonged process. That was exactly the case with Anglo-American copyright. Unsurprisingly, in Britain too, copyright did not freeze in 1710. During the time the Statute of Anne framework was copied in the United States and later, when it acquired its meaning there, it was also being developed and transformed at home.²⁰¹ The legal agents of transplantation in America—people like Justice Story or the treatise writers George Ticknor Curtis and Eaton Drone—kept the importation channel open. In adapting and developing the American copyright framework, they kept injecting legal materials such as court decisions and commentators' analyses from England. This aspect of the transplantation process too did not consist of mere duplication, but contained important adaptive and creative dimensions. Americans borrowed selectively, sometimes misinterpreted (on purpose or by mistake) what they borrowed, and did not hesitate to extend and synthesize what they took. The general picture of transplantation as it emerges from this process is one of an ongoing transatlantic conversation and exchange of ideas, rather than a sudden introduction of a transplant surrounded by disconnect between the two legal cultures.

VI. SOME ENDURING EFFECTS AND PATH DEPENDENCIES

At this point in the discussion, one may develop heretical thoughts about the point of analyzing the early American copyright regime as a legal transplant. If the framework of the Statute of Anne was not simply duplicated and if the actual meaning and operation of the copyright regime was fundamentally changed in its new environment, then were there any lasting significant effects of the transplantation? In the big scheme of things, did it matter at all that in the late eighteenth century Americans plagiarized the British statutory scheme, or would things have been exactly the same absent such copying? The answer is that the enduring effect of the Statute of Anne is most apparent in a series of path dependencies. Various elements that were introduced at an early stage, often elements that are traceable to the peculiar social context of the Statute of Anne, were entrenched and kept exerting their power even when the reasons for their initial appearance were

201. See ALEXANDER, *supra* note 12 (surveying the development of British copyright law during the nineteenth century); CATHERINE SEVILLE, LITERARY COPYRIGHT REFORM IN EARLY VICTORIAN ENGLAND: THE FRAMING OF THE 1842 COPYRIGHT ACT (1999) (describing the 1842 Copyright Act and its context).

long gone and forgotten. Some of these path dependencies were merely anecdotal, while others had a more significant influence on central features of American copyright throughout the years. A few examples serve to demonstrate this logic of path dependence.

One obvious example is the talismanic power enjoyed by multiples of the number fourteen for almost two hundred years in American copyright law. We have no direct evidence why the limited term of protection in the Statute of Anne was fourteen years. There is, however, strong circumstantial evidence that it originated in the 1624 Statute of Monopolies.²⁰² Early in the seventeenth century, when common law courts began to lay restrictions on the royal prerogative power of granting monopoly privileges, they created an exception that later would become the basis for modern patent law.²⁰³ A monopoly grant, the courts held, was lawful and could be tolerated if it was given to the inventor of a new and useful manufacture into the realm, and provided that it was limited in time.²⁰⁴ When Parliament legislated a general ban on royal monopoly grants in 1624, it adopted the common law's distinction between harmful and unlawful monopolies and the exception of a monopoly beneficial to the public.²⁰⁵ Accordingly, the Statute of Monopolies had numerous exemptions from the ban, including one for patents to "the true and first inventor" of "any manner of new manufacture."²⁰⁶ Following the common law, the Statute of Monopolies required a limited term to such grants, but it went further and set a specific cap of fourteen years.²⁰⁷ Edward Coke, the authoritative commentator on the Statute of Monopolies, later explained that the source of this duration was the traditional length of the apprenticeship period: seven years.²⁰⁸ The logic was that the public could not be hurt and English freemen's freedom to exercise a lawful trade was not impinged by a monopoly grant for a new manufacture if no one else practiced that trade in England at the time. The apprenticeship period was used as a rough estimate of the point at which locals learned the new trade covered by the grant and acquired a legitimate claim for practicing it.²⁰⁹ Coke

202. See Statute of Monopolies, 1624, 21 Jac. 1, c. 3, § 6 (Eng.).

203. Bracha, *supra* note 59, at 191–200.

204. *Darcy v. Allin*, (1602) 74 Eng. Rep. 1131, 1139 (Q.B.); *Clothworkers of Ipswich Case*, (1615) 78 Eng. Rep. 147, 148 (K.B.).

205. Bracha, *supra* note 59, at 196.

206. Statute of Monopolies, § 6.

207. *Id.*

208. 3 EDWARD COKE, INSTITUTES OF THE LAWS OF ENGLAND 181 (1644).

209. This idea appeared earlier in common law decisions. See *Clothworkers of Ipswich Case*, 78 Eng. Rep. at 148. The court held that invention patent grants must be limited in time because

was not entirely happy. He thought that the limited duration should have been identical to the apprenticeship period rather than double that length.²¹⁰ Eighty years later, one of the main concerns in the public debate surrounding the Statute of Anne was that of the monopoly power of the Stationers' Company and its more prominent members. The limited duration introduced into the Act was one of the main expressions of this concern.²¹¹ Against this backdrop, it seems implausible that the choice of the number fourteen in the Statute of Anne bore no connection to the well-established anti-monopoly tradition.²¹²

Although late-eighteenth-century Americans tended to think about the role of time limitation on monopolies in terms similar to the English ones, they were not obliged, of course, to follow the fourteen-year term. Indeed, New Hampshire adopted a twenty-year duration in its copyright enactment.²¹³ The other states, however, stuck to variations on the theme of fourteen. Likewise, the drafters of the federal act adopted the original figure.²¹⁴ From that point, until the shift to a life plus term in the 1976 Copyright Act²¹⁵ (and the interim extensions of duration prior to it), inertia had exerted its power. The duration of copyright protection was extended in 1831 (to an initial term of twenty eight years followed by a renewal term of fourteen years)²¹⁶ and in 1909 (to two twenty-eight-year terms),²¹⁷ but the power of fourteen endured. Apparently, Americans simply stuck with the familiar, even when the reasons for the original arrangement were long forgotten and long after the British commitment to the number fourteen

at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it; but when the patent is expired, the King cannot make a new grant thereof, for when the trade has become common, and others have been bound apprentices in the same trade, there is no reason why such should be forbidden to use it.

Id.

210. COKE, *supra* note 208, at 181.

211. *See* ALEXANDER, *supra* note 12, at 24.

212. *See* ROSE, *supra* note 22, at 47. As Deazley points out the choice of the number fourteen was not inevitable and other terms for copyright were proposed prior to the Statute of Anne. DEAZLEY, ORIGIN OF THE RIGHT TO COPY, *supra* note 9, at 42–43.

213. PERPETUAL LAWS OF THE STATE OF NEW HAMPSHIRE, *supra* note 107, at 162.

214. Act of May 31, 1790, ch. 15, 1 Stat. 124 § 1.

215. 17 U.S.C. § 302(a) (2006).

216. Act of Feb. 3, 1831, 4 Stat. 436, 436–39 §§ 1–2.

217. Act of Mar. 4, 1909, ch. 320, § 23, 35 Stat. 1075.

started to crumble with the introduction of a post-mortem term in the 1842 Copyright Act.²¹⁸

Another possibly significant effect (although not necessarily “enduring” in any meaningful sense) was the early shift in the United States from ad hoc privileges to general legislative regimes. The possible effect of the Statute of Anne was not so much on the shift to general regimes (a development that from a historical perspective was over-determined), but on the early timing of it. As explained, the only antecedents of copyright in America prior to the Revolution were occasional ad hoc legislative printing privileges rather than a general copyright regime.²¹⁹ A similar situation applied to patents for inventions.²²⁰ It was by no means preordained that when interest in these fields intensified after independence, there would be an immediate shift to general statutory regimes. Indeed, until the end of the eighteenth century, the states issued many ad hoc printing and invention privileges and most known petitions to the states by inventors and authors were for ad hoc privileges rather than general enactments.²²¹ In Britain, the shift to a general copyright regime was rooted in a specific context that was absent in the United States. When, at the end of the seventeenth century, the old framework for regulating the book trade collapsed, there was almost a century and a half of a general standardized regime, albeit one that was limited to the inner workings of the guild.²²² Against this backdrop, taking the existing guild framework and generalizing it was a natural option.

In the United States, there was no such prior background. When American inventors and authors began clamoring for protection, the natural thing to do was to issue specific privileges. There was no apparent reason why the states could not rely on ad hoc individual acts, which they continued to rely on with corporate charters for decades.²²³ The intervening factor in this dynamic was the existence of the Statute of Anne. It was both a precedent for creating a general regime and a ready-made template for it. It is likely that this was a crucial factor in channeling the states in that direction.

218. 5 & 6 Vict., c. 45, § 3. Under the Act, copyright lasted for seven years after the death of the author, subject to a minimal duration of forty-two years.

219. *Supra* text accompanying note 68.

220. See P.J. Federico, *Colonial Monopolies and Patents*, 11 J. PAT. OFF. SOC'Y. 358; Walterscheid, *supra* note 130.

221. See BUGBEE, *supra* note 70, at 84–103, 107, 110.

222. See *supra* Part II.

223. The states began to shift from ad hoc corporate charters to general incorporation regimes in the 1840s in a gradual process that lasted for decades. See RONALD E. SEAVOY, *ORIGINS OF THE AMERICAN BUSINESS CORPORATION, 1784–1855: BROADENING THE CONCEPT OF PUBLIC SERVICE DURING INDUSTRIALIZATION* (1982).

The story may have been more complex on the federal level. The constitutional clause gave no hint about whether its framers had ad hoc grants or general statutory regimes in mind. It is quite possible, however, that it was understood from the outset that a busy national legislature would be unable to deal on an individual basis with the sheer magnitude of petitions that were likely to stream in from an entire nation. If this was a consideration, however, the existence of institutional precedents, from Britain and from the states, made the choice of a general regime an easy one. Soon after Congress met for the first time, it was bombarded by inventors and authors seeking individual protection.²²⁴ While examining the petitions on an individual basis at first, Congress quickly changed its strategy and appointed a committee charged with drafting general copyright and patent regimes.²²⁵ Their work resulted in the 1790 Copyright Act and the 1790 Patent Act.²²⁶

Ironically, one outcome was that the United States had a general statutory patent regime prior to Britain. In Britain, copyright and patents followed separate tracks. Patents were issued as ad hoc individual discretionary grants from the Crown (within limitations imposed by the Statute of Monopolies and the common law) well into the nineteenth century. While the system was standardized during the eighteenth century, there was simply no such thing as a general patent regime or patent rights in Britain.²²⁷ In the United States, which was relatively free from the separate institutional histories of patents and copyright that framed the process in Britain, the two kindred subjects could be treated in a parallel fashion. The first sign was the South Carolina copyright statute that attempted to create an equivalent general protection for patents.²²⁸ The two subjects were then merged in the constitutional clause and in the early stages of the federal legislation in which the first bill, H.R. 10, was a joint copyright-patent bill.²²⁹ By the time copyright and patents were decoupled during the legislative process,²³⁰ not passing a general patent statute was not a viable option. Thus, ironically, one of the effects of the Statute of Anne's influence was that the United States had legislated a general statutory patent regime decades before Britain.

224. BUGBEE, *supra* note 70, at 131–42.

225. U.S. House Journal, 1st Cong., 1st Sess., Apr. 20, 1789, at 18.

226. Act of Apr. 10, 1790, ch. 7, 1 Stat. 109.

227. Bracha, *supra* note 13, at 56–63, 88–96.

228. ACTS, ORDINANCES, AND RESOLVES, *supra* note 110.

229. *Compare* U.S. CONST. art. I, § 8, cl. 8, *with* H.R. 10, *supra* note 144.

230. 1 ANNALS OF CONG. 1080 (1789).

Another deep mark left by the Statute of Anne on the American copyright system related to formalities. Registration and deposit were preexisting elements that were incorporated into the Statute of Anne.²³¹ Registration had been the practice of the Stationers' Company for more than a century,²³² and deposit with various libraries was included as part of the government-stationers deal embodied in the 1662 Licensing Act.²³³ In the United States, these elements were adopted as a natural part of a copyright regime, although there was, of course, no necessary connection between general protection of authors' rights and such requirements.²³⁴ Both elements changed their form and exact function throughout the years, but they remained an important part of copyright in America.

A similar observation applies to statutory damages. That the Statute of Anne's remedies were limited to forfeiture and per-sheet penalty is unsurprising, given its origin in the Stationers' Company regulation.²³⁵ Under the regulatory system of the Company, which usually kept disputes out of the general court system, alongside specific settlements often worked out by the Company's Court of Assistants,²³⁶ those were the common enforcement mechanisms since the Star Chamber Decree of 1566.²³⁷ This limited array of remedies was imported into the Statute. As described, in the face of what probably seemed like an inadequate selection of remedial options, American courts quickly expanded the remedies available to copyright owners.²³⁸ There

231. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19, §§ 2, 5. (1710) (Gr. Brit.).

232. For information on entrance into the registers, see PATTERSON, *supra* note 8, at 51–55.

233. Act for Preventing the Frequent Abuses in Printing Seditious, Treasonable, and Unlicensed Books and Pamphlets; and for the Regulating of Printing and Printing Presses 1662, 14 Car. 2, c. 33, § 17.

234. Act of Apr. 10, 1790, ch. 7, 1 Stat. 109 §§ 3–4.

235. 8 Ann., c. 19, § 1.

236. See PATTERSON, *supra* note 8, at 33–34.

237. The Star Chamber Decree of 1566 created the strong bond between the governmental licensing system and the Stationers' Company and bestowed broad enforcement powers on the Company. The sanctions imposed by the decree included the forfeiture of unlawful books that were to be brought to the company and destroyed, and a per-copy fine to be divided equally between the crown and the person who seized the books or made the complaint. See *Ordinances Decreed for Reformation of Divers Disorders in Printing and Uttering of Bookes* (1566), in 1 TRANSCRIPT OF THE REGISTERS, *supra* note 23, at 322, ¶¶ 2–4. The sanctions and enforcement powers were intended by the government to be used in the service of censorship, but in practice, the Company used them mainly to enforce its members' commercial printing rights. See Cyprian Blagden, *Book Trade Control in 1566*, 13 LIBR. 287, 290 (5th Ser. 1958).

238. *Supra* text accompanying notes 194–200.

was a flipside, however. The mechanism of penal damages was introduced at the very genesis of the regime and was a natural, available option. In the second half of the century, various interests discovered the attractiveness of monetary relief detached from the need to establish damage. When Congress added a public performance entitlement to dramatic works in 1856, it backed it by a remedy of minimal statutory sums of damages on a per performance basis.²³⁹ The source of this remedy was most probably pressure from lobbying playwrights concerned about effective enforcement.²⁴⁰ In 1897, likely due to lobbying by music publishers, the public performance entitlement and the statutory damages remedy were extended to music.²⁴¹ Statutory damages were then included in the 1909 Act as a general remedy²⁴² and went on to have a long and complicated career in American copyright law.²⁴³ Thus, what started as a left-over from the seventeenth century guild regulatory framework was turned into one of the most important, often controversial, and somewhat unique remedial elements of American copyright.

One last example of the enduring effect of the Statute of Anne in the United States is the institution of reversion²⁴⁴ and renewal. The last section of the Statute of Anne, almost as an afterthought, provided that at the end of the first term of protection, the right would return to a surviving author for a second fourteen-year term.²⁴⁵ The early bill, H.R. 10, simply copied this arrangement.²⁴⁶ The final American Act, however, introduced a new element. It conditioned the second term of protection on re-registration by the surviving author within six months prior to the expiration of the first term.²⁴⁷

239. Act of Aug. 18, 1856, ch. 169, 11 Stat. 138 (1856). The amendment set a minimum of \$100 for the first and \$50 for subsequent unauthorized performances.

240. See Oren Bracha, *Commentary on the U.S. Copyright Act Amendment 1856*, in PRIMARY SOURCES ON COPYRIGHT (1450–1900) (L. Bently & M. Kretschmer eds., 2008), available at www.copyrighthistory.org.

241. Act of Jan. 6, 1897, ch. 4, 29 Stat. 481 (1897); see also Rosen, *supra* note 191, at 1200–16. The amendment also created for the first time explicit criminal liability (for cases of willful infringement for profit of the public performance entitlement) and separated it from the statutory damages.

242. Act of Mar. 4, 1909, ch. 320, § 23, 35 Stat. 1075 § 2.

243. See Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439 (2009).

244. For a detailed account of the history of the reversion right in Britain and the United States, see Bently & Ginsburg, *supra* note 64.

245. Act for the Encouragement of Learning (Statute of Anne), 8 Ann., c. 19, § 11 (1710) (Gr. Brit.).

246. H.R. 10, *supra* note 144, at 4.

247. Act of May 31, 1790, ch. 15, 1 Stat. 124 § 1.

This was the birth of renewal. It is unknown whether this was intended merely as a mechanical drafting correction or if the drafters were aware of and aiming for the separate function executed by the renewal procedure they created. Whatever the intentions, what probably started in the Statute of Anne as a pure reversion right designed to protect the interest of authors²⁴⁸ acquired an additional function: filtering. Renewal ensured that those works that lost commercial value or had no sufficient protection interest to owners fell into the public domain after the first term of protection. The second term only applied to those works in which the owners revealed sufficient interest in continued protection by going through the renewal procedure.²⁴⁹ The reversion right survived in various incarnations in American copyright law uninterrupted,²⁵⁰ even when it disappeared from British law for almost a century.²⁵¹ Renewal and its filtering function survived as a somewhat unique feature of American copyright until the United States shifted to a unitary term with the 1976 Copyright Act.²⁵² Whether this fundamental feature of the American copyright system that lasted almost two centuries was first introduced as a “translation” accident or if a conscious purpose was originally at work remains shrouded in obscurity.

In these ways and others, the Statute of Anne left its mark on American copyright, even as many of its specific arrangements were deserted or bypassed. Its enduring effects were usually manifested by the phenomenon of inertia and the often ironic logic of path dependence.

VII. CONCLUSION

The Statute of Anne has had strange adventures in the United States, although perhaps adventures not uncharacteristic of many other legal transplants. It started its American career as a somewhat unlikely candidate for transplantation. The cultural prestige of its native country and the considerable advantages for the new American Republic of a readymade regime for regulating a field of increased public interest made the Statute of Anne a star overnight. It was appealed to as a role model by early advocates of copyright in America. Its principles were relied on and it was copied,

248. Bently & Ginsburg, *supra* note 64, at 1478–82.

249. See Christopher Sprigman, *Reform(alz)ing Copyright*, 57 STAN. L. REV. 485, 519–23 (2004).

250. Bently & Ginsburg, *supra* note 64, at 1522–50.

251. The 1814 Copyright Act shift to a unitary term eliminated the right of reversion in Britain. 54 Geo. 3, c. 156, § 4.

252. 17 U.S.C. § 302(a) (2006).

sometimes very closely, in all of the early constitutive documents of copyright in America.

And yet, the Statute of Anne's regime was not simply duplicated in the United States. Rather, the American adventures of the Statute of Anne nicely demonstrate the dynamics of translation, which are characteristic of legal transplants in general. Despite the close similarity of the statutory forms and the endurance of these forms, American copyright developed its own specific meaning by responding to local pressures and influences. This process extended over a long period of time and involved an ongoing conversation with the British copyright system that was itself experiencing change. At the same time, the introduction of the Statute of Anne as the foundation of American copyright had enduring and significant effects. It initiated a host of path dependencies and introduced entrenched elements that helped shape American copyright law throughout the centuries. When looked at from this perspective, the first British copyright statute left deep marks on American copyright, some of which can still be seen three hundred years after it was passed into law in the eighth year of the reign of Queen Anne.

**“THE SOLE RIGHT . . . SHALL RETURN TO THE
AUTHORS”¹: ANGLO-AMERICAN AUTHORS’
REVERSION RIGHTS FROM THE STATUTE OF ANNE
TO CONTEMPORARY U.S. COPYRIGHT**

Lionel Bently[†] & Jane C. Ginsburg^{††}

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[†] Herchel Smith Professor of Intellectual Property Law, University of Cambridge; Professorial Fellow, Emmanuel College, Cambridge. Special thanks to Yin Harn Lee, University of Cambridge, LLM Class of 2009–2010, for her excellent research assistance, which was funded by the Herchel Smith Intellectual Property Research Fund at Emmanuel College, Cambridge; and to Tomás Gómez-Arostegui for his help in relation to obtaining information relating to various eighteenth-century legal proceedings. Professor Bently is the author of Part II of this study.

^{††} Morton L. Janklow Professor of Literary and Artistic Property Law, Columbia University School of Law. Thanks to Mark Musico, Columbia Law School, Class of 2011, for his excellent research assistance. Thanks also for comments and suggestions to Prof. Jessica Litman and to the members of the Columbia Law School faculty workshop. Professor Ginsburg is the author of Part III of this study.

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I. INTRODUCTION

The rise in the seventeenth and eighteenth centuries of a professional class of writers stimulated authors' demands for better remuneration from their writings.² The increase in authors who sought to live from their work,

2. The emergence of a profession of authors in the eighteenth century was recognized by contemporaries. See, e.g., 5 JAMES BOSWELL, BOSWELL'S LIFE OF JOHNSON, TOGETHER WITH BOSWELL'S JOURNAL OF A TOUR OF THE HEBRIDES AND JOHNSON'S DIARY OF A JOURNEY INTO NORTH WALES 59 (G.B. Hill ed., 1934); Oliver Goldsmith, "Letter LXXXIII from Lien Chi Altangi, to Fum Hoam, first President of the Ceremonial Academy at Peking, in China," in OLIVER GOLDSMITH, 2 LETTER FROM A CITIZEN OF THE WORLD TO HIS FRIENDS IN THE EAST 127, 130 (J. & R. Childs pub., Bungay 1820) (1762) ("At present, the few poets of England no longer depend on the great for subsistence; they have now no other patrons but the public, and the public, collectively considered, is a good and generous master, . . ."); Q.R.S., *On the Expediency of Instituting a Literary Society on a Prudential and Permanent Plan*, WESTMINSTER MAG., 1773, at 368, 370 ("literary patronage among the Great has ceased . . . literary property has risen upon its ruins . . ."); Letter from Philistor John Pinkerton to the People of Great Britain, in 58 THE GENTLEMAN'S MAGAZINE: AND HISTORICAL CHRONICLE 125, 126 (London, John Nichols 1788) (describing booksellers as "the sole patrons of literature in this country," and suggesting that some level of patronage by "the Great" might be desirable in order to allow publication of works of high importance even though they would not meet with "public taste"); *On the History of Authors by Profession*, BEE, LITERARY WEEKLY INTELLIGENCER, May 11, 1791, reprinted in 3 THE BEE, OR LITERARY WEEKLY INTELLIGENCER, CONSISTING OF ORIGINAL PIECES, AND SELECTIONS FROM PERFORMANCES OF MERIT, FOREIGN AND DOMESTIC 13 (James Anderson ed., Edinburgh, Mundell and Son) (recognizing shift, but arguing, however, that authors were "subjected to a new dependence," that is, upon publishers); A VINDICATION OF THE EXCLUSIVE RIGHT OF AUTHORS TO THEIR OWN WORKS: A SUBJECT NOW UNDER CONSIDERATION BEFORE THE TWELVE JUDGES OF ENGLAND 38–40 (London 1762) [hereinafter VINDICATION], in PRIMARY SOURCES ON COPYRIGHT (1450–1900) (L. Bently & M. Kretschmer eds., 2008) [hereinafter PSOC], http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/%22uk_1762b%22.

Historians of literature have confirmed the claim, though with different emphases on the timing and extent of the shift. See, e.g., VICTOR BONHAM-CARTER, *AUTHORS BY PROFESSION* (1978); RICHARD B. SHER, *THE ENLIGHTENMENT & THE BOOK: SCOTTISH AUTHORS & THEIR PUBLISHERS IN EIGHTEENTH-CENTURY BRITAIN, IRELAND, & AMERICA* ch. 3 (2006) (acknowledging that "the professionalization of authorship . . . increased dramatically during the eighteenth century" but highlighting that the changes did not represent a simple shift from "aristocratic patronage" to patronage by booksellers or the public); John Feather, *John Nourse and His Authors*, 34 STUD. BIBLIOGRAPHY 205 (1981) ("[I]t was in the eighteenth century that authorship, for the first time, became a viable profession for a substantial number of practitioners."); Dustin Griffin, *The Rise of the Professional Author?*, in 5 CAMBRIDGE HISTORY OF THE BOOK: 1695–1830, at 132 (Michael F. Suarez & Michael L. Turner eds., 2009); see also JAMES G. HEPBURN, *THE AUTHOR'S EMPTY PURSE AND THE RISE OF THE LITERARY AGENT* (1968) (noting that Alexander Pope "was possibly the first eminent writer earning his living by his pen who was freely able to do so"); Peter Lindenbaum, *Author and Publishers in the Late Seventeenth Century, II: Brabazon Aylmer and the Mysteries of the Trade*, 3 LIBR. 32 (2002) [hereinafter Lindenbaum, *Brabazon Aylmer*]; Peter Lindenbaum, *John Milton and the Republican Mode of Literary Production*, 21 Y.B. ENG. STUD. 121

rather than from patronage or personal fortune, likely provided at least one impulse for the author-protective provisions of the 1710 Statute of Anne. Under the regime of printing privileges that preceded the Statute of Anne, authors generally received from publisher-booksellers a one-time payment,³ made when the authors surrendered their manuscripts for publication.⁴ Authors whose works enjoyed particularly high demand might negotiate additional payments for new editions or for new printings of a work that had done well,⁵ or they might extract a higher price per sheet for their next work,⁶ but neither law nor custom generally assured authors remuneration reflective of their works' sales. As a result, few authors participated in the continued success of their works.

(1991) (arguing that Milton began writing within a system of aristocratic patronage, but broke free of it).

3. In discussing the period prior to 1800, we use the terms "bookseller" and "publisher" interchangeably. *See, e.g.*, Terry Belanger, *From Bookseller to Publisher: Changes in the London Book Trade, 1750–1850*, in *BOOK SELLING AND BOOK BUYING: ASPECTS OF NINETEENTH CENTURY BRITISH AND NORTH AMERICAN BOOK TRADE* 7 (Richard Langdon ed., 1978); John Feather, *The Commerce of Letters: The Study of the Eighteenth-Century Book Trade*, 17 *EIGHTEENTH CENTURY STUDS.* 409 n.18 (1984). William Strahan, printer-turned-bookseller, who himself operated no retail outlets, explained to his American correspondent that "[w]hat constitutes a Bookseller is having Property in Copies." R.D. Harlen, *William Strahan: Eighteenth-Century London Printer and Publisher* 236 n.58 (1960) (unpublished Ph.D. dissertation, University of Michigan).

4. The Upcott manuscripts contain at least three relevant documents from before 1710. Additional Manuscripts in the British Library, BL Add. Mss. 38727–38730 [hereinafter BL Add. Mss.], 1 THE UPCOTT COLLECTION, ORIGINAL ASSIGNMENTS OF MANUSCRIPTS BETWEEN AUTHORS AND PUBLISHERS, 1705–1810 (DRAMATIC AUTHORS), BL Add. Mss. 38727, at [204], [120] [hereinafter 1 UPCOTT]; 2 THE UPCOTT COLLECTION, ORIGINAL ASSIGNMENTS OF MANUSCRIPTS BETWEEN AUTHORS AND PUBLISHERS, 1707–1810 (MATHEMATICAL & ELEMENTARY WORKS), BL Add. Mss. 38729, at [110] (Assignment of March 20, 1706/7) [hereinafter 2 UPCOTT]; *see also* Letter from Tonson to Pope (Apr. 20, 1706), BL Add. Mss. 4807, fol. 172^v.

5. Milton received additional payments for subsequent editions of *Paradise Lost*. Juan Christian Pellicer, *Harleian Georgic from Tonson's Press: The Publication of John Philip's Cyder*, 29 *June 1708*, 7 *LIBR.* 185, 187 (2006) (noting a 1707 contract between publisher Jacob Tonson and John Philips's for the latter's poem *Cyder* also providing for the possibility of an eventual second edition, which would have brought him another £10).

6. *See, e.g.*, Peter Lindenbaum, *Authors and Publishers in the Late Seventeenth Century: New Evidence of Their Relations*, 17 *LIBR.* 250, 262 (1995) (explaining that a bookseller agreed in 1689 to pay John Locke 10s for each sheet of text of his *Essay Concerning Human Understanding*; and in subsequent agreements in 1693/94 and 1699, the booksellers agreed to pay Locke 10s per sheet for any *additional* material he wished to provide for subsequent editions).

While many debate the extent to which the Statute of Anne in fact departed from the prior regime of printing monopolies,⁷ one feature of the Act that distinguished it from prior regulatory practices was the vesting of exclusive rights in authors, rather than in publishers.⁸ Moreover, the last clause of the Statute, granting authors a contingent reversionary right, was both unprecedented and, as enacted, manifestly a measure favoring authors. Section 11 stated:

Provided always, [t]hat after the expiration of the said term of fourteen years, the sole right of printing or disposing of copies shall return to the Authors thereof, if they are then living, for another [T]erm of fourteen years.⁹

The Statute of Anne thus conditioned the duration of exclusive rights on the author's survival. More importantly, the Statute designated the author as the beneficiary of the additional term of years. In theory, the second fourteen years should have enabled the author to grant rights anew from a stronger bargaining position should her work have earned a substantial audience. By focusing on the "encouragement of learned men to . . . write useful books"¹⁰ and vesting the "copies" in them, the Statute of Anne shifted the law's emphasis toward authorship, but in this the law did not entirely innovate: even under the prior regime authors occasionally obtained privileges (which they subsequently transferred to booksellers).¹¹ By contrast, the Statute broke

7. Compare HARRY H. RANSOM, *THE FIRST COPYRIGHT STATUTE: AN ESSAY ON AN ACT FOR THE ENCOURAGEMENT OF LEARNING, 1710* (1956), and RONAN DEAZLEY, *Commentary on the Statute of Anne 1710* (2008), available at PSOC, *supra* note 2, http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabeCom/%22uk_1710%22 (emphasizing author-oriented aspects of statute), with JOHN FEATHER, *PUBLISHING, PIRACY AND POLITICS: AN HISTORICAL STUDY OF COPYRIGHT IN BRITAIN* (1994) (emphasizing continuity between the Statute of Anne and the prior regime), and LYMAN R. PATTERSON, *COPYRIGHT IN HISTORICAL PERSPECTIVE* (1968) (viewing Statute of Anne as a trade regulation device designed to restore order to the book trade).

8. See, e.g., Laura Moscati, *Lo Statuto di Anna e le origini del copyright*, in *FIDES HUMANITAS LUS. STUDI IN ONORE DI LUIGI LABRUNA*, VI, at 3671–88 (2007) (tracing history of author-orientation of Statute of Anne but also emphasizing the Statute's aim to restrain the power of the Stationers' company); cf. BRAD SHERMAN & LIONEL BENTLY, *THE MAKING OF MODERN INTELLECTUAL PROPERTY LAW: THE BRITISH EXPERIENCE, 1760–1911*, at ch. 10 (1999) (criticizing the tendency to attribute the origin of modern copyright to the Statute of Anne, and preferring to identify the emergence of copyright as part of modern intellectual property law in the mid-nineteenth century).

9. Statute of Anne, 8 Ann., c. 19, § 1 (1710) (Gr. Brit.).

10. *Id.*

11. See, e.g., SAMUEL DANIEL, *THE COLLECTION OF THE HISTORIE OF ENGLAND* (1618), available at PSOC, *supra* note 2, http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/%22uk_1618%22; MARJORIE PLANT, *THE ENGLISH BOOK*

new ground when it not only gave the author the rights at the outset, but also (providing she survived) “return[ed]” them to her for a second time.

This study of author’s reversion rights begins with the Statute of Anne and the debates that led up to the adoption of section 11. It then will address the impact of the author’s reversion right on publishing practice and authors’ welfare in the United Kingdom through the eighteenth century to the demise of the reversion right in 1814.¹² We will suggest that the apparent lack of use of the reversion right by authors in the eighteenth century was a result of a host of factors, including but not limited to the common (but by no means universal) contractual practice which purported to confer on a publisher the entirety of an author’s rights. In addition, we call attention to the multiple and shifting interpretations of what was required by section 11, as well as the social and economic limitations on an author’s capacity to take advantage of the reversion. The second half of this study turns to the law and publishing practices in the United States, where reversion rights have proved more enduring if not always more beneficial to authors.

II. THE REVERSION RIGHT IN BRITAIN FROM 1710 TO 1814

A. STATUTE OF ANNE: ORIGINS OF SECTION 11

As is clear now from the many treatments of the subject, relatively little specific detail is known about the passage of the Statute of Anne itself,¹³ let alone the circumstances in which section 11 was enacted.¹⁴ In part, this is because the matter of the regulation of the book trade was not considered one of great public interest. It is also because parliamentary debates were not reported systematically until late in the eighteenth century—indeed reporting

TRADE: AN ECONOMIC HISTORY OF THE MAKING AND SALE OF BOOKS 109 (1939) (giving examples of a 1589 patent to Dr. Bright for works in shorthand and such other works as he might compile, and a 1592 grant to John Norden for *Speculum Britanniae*).

12. Parliament reinstated a reversion right in the 1911 Imperial Copyright Act, but the history of that reversion and its adoption in the countries of the British Empire is beyond the scope of this study.

13. RANSOM, *supra* note 7, at ch. 7; MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* 42–48 (1993); John Feather, *The Book Trade in Politics: The Making of the Copyright Act of 1710*, in *PUBLISHING HISTORY* 8, 19–44 (1980).

14. Patterson, for example, merely cites section 11 and then proceeds to argue that the Statute was a “trade regulation statute.” PATTERSON, *supra* note 7, at 146. John Feather takes this argument further asserting that the Act “says nothing and implies little about the rights of authors,” characterizing section 11 merely as providing for an extension of term on re-registration. FEATHER, *supra* note 7, at 5, 62, 70. In fact, there is nothing in the section about re-registration.

was a matter of “parliamentary privilege” and therefore required prior authorization.¹⁵ Thus we are left to work from the skeletal offerings of the *Journals of the Lords and Commons*,¹⁶ as well as some surviving bills, tracts,¹⁷ and commentaries,¹⁸ particularly those of the writer and keen supporter of the Bill, Daniel Defoe.¹⁹

The introduction of the 1710 Bill followed a petition to the House of Commons in December 1709 by a group of booksellers, headed by Henry Mortlock, and the case was backed up with a further petition to Parliament the following February from printers and bookbinders.²⁰ The Bill, the preparation of which was entrusted to Edward Wortley, Samuel Compton and Craven P(e)yton, was introduced into the Commons in January 1709/10.²¹ At this stage, the Bill did not contain any clause similar in nature to section 11—in fact, it contained no clause at all relating to term.²²

15. For an overview, see Jason Peacey, *The Print Culture of Parliament, 1600–1800*, 26 PARLIAMENTARY HIST. 1, 1–16 (2007). For an example of publication authorized by Parliament, see H. Tomás Gómez-Arostegui, *The Untold Story of the First Copyright Suit Under the Statute of Anne in 1710*, 25 BERKELEY TECH. L.J. 1247 (2010) (discussing *Tonson v. Baker*).

16. 16 H.C. JOUR. (Jan. 11, 1709/10) 260 (First Reading), (Feb. 9, 1709/10) 300 (Second Reading), (Feb. 21, 1709/10) 332 (Committee); 19 H.L. JOUR. (Mar. 16, 1709/10) 109, (Mar. 24, 1709/10) 123, (Mar. 30, 1710) 134, (Apr. 3, 1710) 138–39, (Apr. 4, 1710) 140–41. Prior to the 1752, the calendar year formally began on Lady Day, March 25. *See* 24 Geo. 3, c. 23. So, formally, December 1709 was followed by January, February and March 1709, and April 1710. However, it was also common to refer to the first three months of the year by a joint reference, and it is that convention that we follow here.

17. *See, e.g.*, JOHN HOW, SOME THOUGHTS ON THE PRESENT STATE OF PRINTING AND BOOKSELLING (London 1709) (proposing protection of booksellers based on registration, though he also proposed protection for prints, maps, charts, pictures, and sculptures).

18. 2 LUCUBRATIONS OF ISAAC BICKERSTAFF, Nov 29, 1709, at 264 (complaining about “pirates” and the affect on authors’ remuneration, noting that he himself could obtain more from “palmistry and astrology” than from writing); TATLER, Dec 1709. The passage of the Act is reported in the *London Gazette* on April 4, 1710 and an abridged version was included in the issue for May 2, 1710.

19. *See generally* *Review of the State of the British Nation*, Dec. 6, 1709, Feb. 2, 1709/10 (praising the proposed law to prevent “barbarity and piracy” and famously describing the book as “the author’s property, ’tis the child of his inventions, the brat of his brain”), Feb. 11, 1709/10 (reviewing criticisms of the bill that it would raise the price of books), and Feb. 18, 1709/10. On Defoe, see MAXIMILLIAN E. NOVAK, DANIEL DEFOE: MASTER OF FICTIONS 278 (2001) (“one of the Act’s most enthusiastic supporters”). *See generally* RONAN DEAZLEY, ON THE ORIGIN OF THE RIGHT TO COPY: CHARTING THE MOVEMENT OF COPYRIGHT LAW IN EIGHTEENTH-CENTURY BRITAIN (1695–1775), at ch. 2 (2004) (discussing Defoe’s writings on literary piracy).

20. FEATHER, *supra* note 7, at 60.

21. A copy of the Bill is held at Lincoln’s Inn Library. *See* Bodleian Library Manuscript, Bodleian MS Rawl D.922. fols. 380–86.

22. A Bill for the Encouragement of Learning, and for the Securing the Property of Copies of Books to the Rightful Owners Thereof, *available at* PSOC, *supra* note 2,

Prepared with the interests of the major booksellers in mind, the Bill offered perpetual protection. But this was not acceptable to either of the Houses of Parliament.²³ Consequently, during passage through the Commons—probably at the Committee stage, which Compton chaired—the broad assertion of a perpetual property was replaced with a fixed term: in the case of extant works of twenty-one years, and for those created after the Act would come into force a period of only fourteen years.²⁴ When the Bill went to the Lords, a second term of fourteen years was added,²⁵ in what the literary historian Harry Ransom referred to as “perhaps the most significant amendment.”²⁶ Who proposed the amendment is unknown.²⁷ In the manuscript version of the Act, section 11 is physically “tacked on” to the Bill.²⁸

1. *The Purpose of the Contingent Reversion*

What was the purpose of the clause? Why have two terms of fourteen years rather than a single term of twenty-eight years (as would be adopted, fifty-seven years later, for engravings)? Various possible explanations have been suggested by modern commentators.²⁹ Frank Curtis speculates that the term “return” was intended to mean “recur” and that “the failure to mention assigns in the second-term proviso was an inadvertent lapse by the Lords in amending the basic legislation drafted by the Commons.”³⁰ For Curtis, the clause was not meant to protect the author from his assignee, but merely to confer a second term, should he be living, at the end of the first term.³¹ But

http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/%22uk_1710a%22.

In December 1709, Daniel Defoe had proposed an Act with only two clauses, the effect of which would also have been to create a perpetual right. See DEAZLEY, *supra* note 19, at 35–36.

23. 16 H.C. JOUR. (1709/10) 260 (First Reading).

24. 16 H.C. JOUR. (1709/10) 332 (Committee).

25. 19 H.L. JOUR. (1710) 140–41 .

26. RANSOM, *supra* note 7, at 96; ROSE, *supra* note 13, at 46–47.

27. W. Cornish, *The Statute of Anne 1709–10: Its Historical Setting*, in GLOBAL COPYRIGHT: THREE HUNDRED YEARS SINCE THE STATUTE OF ANNE, FROM 1709 TO CYBERSPACE 23 (L. Bently, U. Suthersanen & P. Torremans eds., forthcoming 2010) (“How exactly this provision found its way into the Act is far from clear . . .”).

28. PSOC, *supra* note 2.

29. Frank R. Curtis, *Protecting Authors in Copyright Transfers: Revision Bill § 203 and the Alternatives*, 72 COLUM. L. REV. 799, 802 (1972) (“The meagre legislative history of the Statute does not reveal why the Lords added a separate second term instead of simply lengthening the original term.”).

30. *Id.* at 803. Some support for this interpretation can be found in the decision of Yates, J., in *Millar v. Taylor*, (1769) 98 Eng. Rep. 201 (using the term “recur” to describe the effect of the section).

31. See also FEATHER, *supra* note 7, at 5, 62, 70; John Draper, *Queen Anne’s Act: A Note on English Copyright*, 36 MODERN LANGUAGE NOTES 146, 147 (1921) (“The copyright was

why, then, have two periods? Curtis sees this as a reflection of a desire to ground the right in the act of composing the work: the term was only to be extended “if the source of such rights and the primary beneficiary of Parliament’s largesse” was still alive.³² While Curtis may be right to see the framing of the clause as consistent with the framework that Parliament had adopted, it would have been equally consistent to simply extend the term from fourteen to twenty-eight years, the author being the source of those rights.

Mark Rose has argued that the bifurcated term reflected the perceived need to align the term of protection with that in the Statute of Monopolies, which was the source of the fourteen-year limit in the first place. This 1624 law limited the powers of the Crown to grant monopolies, but created an exception relating to any “manner of new manufacture” as long as the monopoly did not exceed a specified limited term: twenty-one years for extant grants; fourteen years for future grants.³³ When the Commons looked for a suitable period to which to limit the rights of authors, the Statute of Monopolies was an obvious model to which to turn.³⁴ When the Lords wanted to lengthen the term, Rose argues “they were reluctant in the light of the Jacobean Statute of Monopolies’ provision against any monopoly terms longer than fourteen years simply to declare a longer term.”³⁵

Although there is a startling parallel between the terms in the Statute of Monopolies and those of the Statute of Anne, what is less clear is what we can infer from this about the Lords’ extension. Were the two terms of fourteen years chosen to pay lip-service to the established model, or chosen because it was believed to be problematic to confer a longer term? There seems to be a number of problems with Rose’s analysis. First, the regulation of the book trade, even via printing patents, had been exempted from the Statute of Monopolies.³⁶ Even had the legislators conceived of the Statute of

vested in the author or his assigns for fourteen years with the right of extension to twenty eight.”).

32. Curtis, *supra* note 29, at 802 (“In weighing the need for protection against the costs of the copyright monopoly, the Lords evidently concluded that a further period of protection was needed, but only if the source of such rights and the primary beneficiary of Parliamentary largesse—the author himself—were still alive.”).

33. Statute of Monopolies, 1624, 21 Jac., c. 3 (Eng.); *see, e.g.*, CHRISTINE MACLEOD, *INVENTING THE INDUSTRIAL REVOLUTION: THE ENGLISH PATENT SYSTEM, 1660–1800*, at 15 (1988) (discussing Statute of Monopolies).

34. ROSE, *supra* note 13, at 45.

35. *Id.* at 47; *see also* DAVID FOXON, *POPE AND THE EARLY EIGHTEENTH-CENTURY BOOK TRADE* 238 (1991) (“the [Statute of Monopolies] must have provided the framework of regulation underlying the 1709/10 Act”).

36. Statute of Monopolies, 1624, 21 Jac., c. 3, § 10 (Eng.).

Anne as conferring a “standing patent for authors,” as Lord Chancellor Hardwicke would later put it,³⁷ this was a “standing patent” over printing and reprinting particular books and technically would have fallen outside the Statute of Monopolies. Second, the Statute of Monopolies was just that—a statute—and could have been repealed, implicitly or explicitly, by a later statute, such as the Statute of Anne, with respect to its application to monopolies over particular books. The 1624 Act did not create some sort of constitutional norm. Almost two hundred years later, in 1814,³⁸ when the statutory term of copyright was extended to twenty-eight years, or, if the author survived, for his or her life, not a single person raised the question of compatibility with the 1624 statute.³⁹ Third, the legislature clearly regarded it as open to grant longer terms, as it did on a number of occasions in relation to mechanical inventions.⁴⁰ The Statute of Monopolies may have been a precedent from which the Commons were working in 1710, but it was certainly not a straitjacket.

Rose also acknowledges that the Lords’ amendment might have been influenced by the philosopher John Locke’s “suggestion that, after first publication, the right to reprint should revert to the author.”⁴¹ Rose here relies on Raymond Astbury,⁴² who claims that Locke suggested during a discussion in 1695 of the proposed legislation that would replace the Licensing Act in 1695, that authors should have the sole right to reprint a work “for a certain number of years after the publication of the first edition.” Astbury argues that this idea “anticipated the terms” of the Statute of Anne.

37. See *Millar v. Taylor*, 98 Eng. Rep. at 211 (reporting Lord Hardwicke’s characterization); see also DANIEL DEFOE, AN ESSAY ON THE REGULATION OF THE PRESS 21 (London 1704) (“The Clause in the Law is a Patent to the Author . . .”).

38. 54 Geo. 3, c. 156, § 4 (Gr. Brit.); see also INFORMATION FOR ALEXANDER DONALDSON AND JOHN WOOD 58 (1773), available at PSOC, *supra* note 2, http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/%22uk_1773b%22 (mentioning “a standing universal patent”).

39. Nor indeed did anyone raise this issue in 1767 when the term of copyright for engravers was made twenty-eight years. See 7 Geo. 3, c. 38 (Gr. Brit.).

40. E.g., Act for the Incouragement of a New Invention by Thomas Savery for Raising Water and Occasioning Motion to All Sortes of Mill Worke by the Impellant Force of Fire, 1699, 10 Will. 31. (Eng.) (extending standard fourteen year patent, No. 356 of July 5, 1698, by a further twenty-one years); see also James Watt’s Fire Engines Patent Act, 1775, 15 Geo. 3, c. 61 (Eng.), the lobbying for which is carefully analyzed in Eric Robinson, *Matthew Boulton and the Art of Parliamentary Lobbying*, 7 HIST. J. 209 (1964).

41. ROSE, *supra* note 13, at 45–46.

42. Raymond Astbury, *The Renewal of the Licensing Act in 1693 and Its Lapse in 1695*, 33 LIBR. 296, 313 (1978) (citing a letter from Locke to Freke dated Mar. 18 1695). The letter is available at Bodleian MS Locke b. 4, fol. 78.

However, a closer look at Locke's text suggests that Astbury, and, in turn, Rose may be making too much of this. Locke wrote:

And be it farther enacted that noe book[s] pamphlet[s] pourtraiture or paper printed with the name of the Author or publisher upon it shall within ___ years after its first edition be reprinted with or without the name of the Author to it without Authority given in writeing by the Author or Somebody intituled by him, for soe doeing under the penalty of the forfeiture of all that shall be soe reprinted to the Author his Executors Administrators or Assignes.⁴³

Even if we assume that Locke's manuscript comments circulated widely enough to have influenced the formulation of the Statute of Anne,⁴⁴ it is by no means obvious that Locke was proposing a *reversion* to the author here. The proposal envisages consent to reprinting being given not only by the author but by "somebody intituled," and the benefit of the remedy is conferred not just on the author but also his or her "Assignes." Moreover the consent is only required if the proposal is to reprint the work *within* a period of time. Even if understood as empowering the author, the author is given that power only *for* a limited number of years, rather than, as with the reversion, *after* a given number of years.

Whatever the source of the author-centric orientation of section 11, the text of the Statute supports the inference that the purpose of the additional contingent term was to assist authors. Were the objective otherwise, for example to prolong the printer's monopoly, there would be no point dividing the "sole right" into two periods, nor tying the second to the author's survival, much less designating the author as the person to whom the exclusive right shall "return." Both Harry Ransom and the copyright historian Ronan Deazley agree that the provision was, in fact, designed to benefit the author.⁴⁵ Harry Ransom, writing in 1957, referred to section 11 as

43. 5 THE CORRESPONDENCE OF JOHN LOCKE 795 (Esmond Samuel de Beer ed., 1976–1989) [hereinafter CORRESPONDENCE OF LOCKE] (transcribing John Locke, Printing 94/5: Amendments to the Draft Bill (Mar. 18, 1695)) (unpublished manuscript) (the original of which is held at the Bodleian Library in Oxford, Bodleian MS Locke b. 4, fol. 78).

44. Clearly, Locke's now famous proposal on term ("for those who purchase copies from the Author that now live and write it may be reasonable to limit their property to a certain number of years after the death of the Author or the first printing of the book as suppose 50 or 70 years") was not so influential. See John Locke, Printing 94: Criticisms of the Licensing Act of 1662 (Dec. 1694) (unpublished manuscript) (on file with Bodleian Library, Oxford, MS Locke b. 4, fol. 75–76, *transcribed in* 5 CORRESPONDENCE OF LOCKE, *supra* note 43, at 785–91).

45. DEAZLEY, *supra* note 19, at 43; DEAZLEY, *supra* note 7; cf. Zechariah Chafee, Jr., *Reflections on Copyright Law: II*, 45 COLUM. L. REV. 719, 722 (1945) ("It could not have been

part of a systematic attempt in Parliament to further the interest of the writer as distinguished from that of the bookseller Fourteen years would demonstrate the value of a book. If it failed, the author could either improve its usefulness by revision or quietly forget it. If its value had grown meanwhile, the author could sell the copyright a second time.⁴⁶

Deazley is in accord:

Had [the Lords] simply chosen to introduce a longer term, this would, in practice, have meant control of the work remaining with the [owner of the book, who would more than likely be a bookseller]. Rather, the use of the divided term, albeit reminiscent of the earlier statute, was designed to ensure that the control of the work would in fact return to the author if still alive. Given that this was the only section within the final Act to make reference solely to the author, it seems likely that the [Lords fully] intended to benefit the author and only the author.⁴⁷

This understanding that section 11 was intended to protect writers is also consistent with what we know about the extra-parliamentary attitudes and behaviour of some of those involved in the Lords' amendments. For example, the President of the Council, Baron John Somers, who was also in the Lords Committee charged with the Bill,⁴⁸ was described by writer Jonathan Swift as "a great Patron of Learning."⁴⁹ Indeed, many writers during this period dedicated their works to him, including Swift himself. The dedication in Swift's *Tale of a Tub*, for example, was that he would not "desire any other Help, to grow an Alderman, than a Patent for the sole Privilege of dedicating to your Lordship."⁵⁰ It seems plausible, then, that Somers might well have been involved in the addition of section 11 to the Bill.

One contemporary account, at least, supports the Deazley-Ransom interpretation.⁵¹ In the issue dated February 11, 1709/10,⁵² the journal *The*

the object of the Statute of Anne, because the renewal privilege there belongs to the *owner* of the copyright who was almost always a bookseller.").

46. RANSOM, *supra* note 7, at 97, 104.

47. DEAZLEY, *supra* note 19, at 43.

48. 19 H.L. JOUR. (1710) 138.

49. WILLIAM L. SACHSE, LORD SOMERS: A POLITICAL PORTRAIT 198 (1975).

50. For a discussion of Somers literary connections, see *id.* at ch. 10.

51. Although Deazley does not refer to these, it was he who first drew our attention to them. See Ronan Deazley, *What's New About the Statute of Anne? Or Six Observations in Search of an Act*, in GLOBAL COPYRIGHT, *supra* note 27, at 46–47.

52. OBSERVATOR (LONDON), Feb. 11, 1709/10 (accessible electronically via 17TH AND 18TH CENTURY BURNEY COLLECTION NEWSPAPERS). In an earlier issue, *The Observer* indicated its support for statutory protection of books. *Id.* On Wednesday, February 1,

Observer discussed a proposal to protect authors through the journalistic device of a dialogue between the “Observer” and his “Countryman,” Roger. The Countryman referred to a suggested amendment of the Bill (then in the Commons), “which is design’d as a Kindness to us Authors,” namely

[t]hat the Bookseller shall have a Property in the Copy only for a limited Time, after which it shall revert to the Author or his Assignees. This they say will be an Encouragement to Learning, and a Security to Authors against being ill treated or impos’d upon by Booksellers, who run away with the Profits of their Labours . . . ; so that Authors not being able to foresee this, because Copies are like Ships put to Sea, whose prosperous or unfortunate Voyage is not to be foreseen, they have nothing more than their first Copy-Money, let the Book sell ever so well.⁵³

The “Observer” responded by criticizing this well-meaning proposal, predicting that it would in fact be “detrimental to [authors].”⁵⁴ It argued that the bookseller, given such a limited right, would offer less to authors, and, if the book proved successful, the bookseller would “print so many before his Time expire, as will make the [r]everision of little or any Profit to the Author or his Assignees.”⁵⁵ In any case, the Observer argued that it was open to authors who wished to achieve the same effect, to restrict the sale of the copyright or “agreeing for so much for every future impression.”⁵⁶

These discussions preceded, and clearly foreshadowed, the Lords’ amendment, effected in early April 1710, that became section 11. The significance of the comments in *The Observer* lies in the fact that they indicate that the idea of a provision protecting authors was already in circulation, and that providing for “reversion” was one way of achieving this end.

2. *Why a Reversion Right Rather Than Regulation of Author-Publisher Contracts?*

An alternative strategy which the Lords could have taken would have been to amend the Bill to extend the copyright term to twenty-eight years, while protecting the author by providing that no assignment that purported

1709/10 the it approved the Bill and described piracy as “as unjust robbing on the Highway, or breaking up our Houses, and carrying off our Goods and Provisions, that should accommodate and maintain us and our Families.” OBSERVATOR (LONDON), Feb. 1, 1709/10.

53. OBSERVATOR (LONDON), Feb. 11, 1709/10.

54. *Id.*

55. *Id.*

56. *Id.*

to transfer such a right would be effective in so far as the term of the contract exceeded fourteen years. Contractual limitations were known in English law, both at common law and under statute. The formalities for entering certain contracts, for example those relating to the sale of land, were regulated by the Statute of Frauds,⁵⁷ and a contract that failed to comply with the standards it set were treated as void or unenforceable.⁵⁸ Similarly, the terms of certain contracts were controlled by laws setting prices of bread,⁵⁹ wages,⁶⁰ and limits on interest.⁶¹ Moreover, courts of equity would intervene to protect borrowers from onerous terms in mortgages,⁶² while courts of law held void and unenforceable agreements in restraint of trade.⁶³ Indeed the

57. An Act for the Prevention of Frauds and Perjuries, 1677, 29 Car. 2, c. 3 (Eng.). Rather like the Statute of Anne, there has been much debate over the proper dating of the Statute of Frauds. See G.P. Costigan, *The Date and Authorship of the Statute of Frauds*, 26 HARV. L. REV. 329 (1913).

58. The original purpose of the statute was to provide evidence of contracts and to reduce the temptations of perjury. See, e.g., G.H.L. Fridman, *The Necessity for Writing in Contracts Within the Statute of Frauds*, 35 U. TORONTO L.J. 43 (1985); Lionel Summers, *The Doctrine of Equitable Estoppel Applied to the Statute of Frauds*, 79 U. PA. L. REV. 440 (1931).

59. An Act to Regulate the Price and Assize of Bread, 1710, 8 Ann., c. 18 (Gr. Brit.) (constituting the Act directly preceding the Statute of Anne in the statute book); 1714, 1 Geo., c. 26 (Gr. Brit.) (continuing and modifying the rules on the pricing of bread). The assize of bread was abolished in London in 1815, and nationwide in 1836. For background and commentary, see Sidney Webb & Beatrice Webb, *The Assize of Bread*, 14 ECON. J. 196 (1904).

60. Statute of Artificers, 1563, 5 Eliz., c. 4 (Eng.); Act for Regulating Journeymen Tailors, 1720, 7 Geo., c. 13 (Eng.) (setting hours of work and wages of tailors); see also R. Keith Kelsall, *WAGE REGULATION UNDER THE STATUTE OF ARTIFICERS* (1938) (describing wage regulation primarily through setting maximum wage); R. Keith Kelsall, *A Century of Wage-Assessment in Herefordshire*, 57 ENG. HIST. REV. 115 (1942); MASTERS, SERVANTS AND MAGISTRATES IN BRITAIN AND THE EMPIRE, 1562–1955, at 81 (Douglas Hay & Paul Craven eds., 2004) (wage regulation continued in many parts of the country until the middle decades of the eighteenth century).

61. An Act to Reduce the Rate of Interest Without Any Prejudice to Parliamentary Securities, 1713, 13 Ann., c. 15 (Gr. Brit.) (setting the permitted interest rate at 5%. Any claim above this rendered the contract void and would have rendered the lender vulnerable to a penalty of three times the value of the loan). The usury laws were not repealed until 1854, (1854) 17 & 18 Vic. c. 90 (Gr. Brit.), though various legal devices had long been deployed to avoid their impact. Coincidentally, the 1713 Act was sometimes referred to as “the Statute of Anne.” See, e.g., M.M. Long, *Trends in Usury Legislation—Current Interest Overdue*, 34 U. MIAMI L. REV. 325, 326–27 (1980).

62. Bruce Wyman, *The Clog on the Equity of Redemption*, 21 HARV. L. REV. 459 (1908) (describing Equity’s recognition of a right to redeem a mortgage as having emerged in the seventeenth century and calling it a “violent . . . interference with the rights of parties to a mortgage to agree as they please”). For a recent assessment of English law, see M.P. Thompson, *Do We Really Need Clogs?*, 65 CONVEYANCER 502 (2001).

63. A key development in the doctrine of restraint of trade occurred only a year after the enactment of the Statute of Anne. In *Mitchel v. Reynolds*, Lord Macclesfield introduced the

Statute of Anne itself limited the ability of the author or proprietor to grant licences to reprint the book by requiring the author or proprietor's consent in writing signed by two witnesses, and by containing "price control" provisions.⁶⁴ In short, as of 1710, there was no ideological reason preventing Parliament, had it desired to do so, from protecting writers by interfering with their contracts with publishers. In fact, twenty-seven years later, a Bill was circulated which proposed that no assignment of copyright should be valid in so far as it purported to last for more than ten years.⁶⁵ Although the Bill was not passed, its circulation indicates that regulation of contractual terms was considered a plausible legislative response to the informational asymmetries and differences in bargaining power that informed author-

distinction between general restraints and partial (or geographically restricted) restraints, the former being automatically void, whereas the latter were valid if reasonable. *Mitchel v. Reynolds*, (1711) 24 Eng. Rep. 347; *see, e.g.*, JOHN DYSON HEYDON, *THE RESTRAINT OF TRADE DOCTRINE* 1–36 (1971); MICHAEL J. TREBILCOCK, *THE COMMON LAW OF RESTRAINT OF TRADE* 9–16 (1986); Harlan M. Blake, *Employee Agreements Not to Compete*, 73 HARV. L. REV. 625, 629–46 (1960).

64. Statute of Anne, 8 Ann., c. 19, § 1 (1710) (Gr. Brit.) (stating that "without the consent of the proprietor or proprietors thereof first had and obtained in writing signed in the presence of two or more credible witnesses").

65. An Act for the Encouragement of Learning (Draft) 9 (1737), *available at* PSOC, *supra* note 2, http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/-%22uk_1737b%22. The draft states:

And forasmuch as the true Worth of Books and Writings is, in many Cases, not found out [until] a considerable Time after the Publication thereof, and Authors, who are in Necessity, may often be tempted absolutely to sell and alienate the Right, which they will hereby have to the original Copies of the Books which they have composed, before the Value thereof is known, and may there[fore] put it out of their Power to alter and correct their Compositions, upon maturer Judgment and Reflection; Therefore, be it enacted by the Authority aforesaid, That from and after the said Twenty fourth Day of Junne, One thousand, seven hundred and thirty seven, no author shall have power to sell, alienate, assign, or transfer, except by his last Will and Testament, the Right hereby vested in him to the original Copy of any Book, Pamphlet, or Writing, to any Person or Persons whatsoever, for any longer Time than Ten Years, to commence from the Date of such Sale, Alienation, Assignment, or Transfer; and all Sales, Alienations, Transfers, Assignments, and all Covenants for any Sale, Alienation, Assignment or Transfer, for any longer Time, or to commence from any future Date, and all Bargains and Covenants for Renewal of the same, before the first Term is expired, shall be utterly void and of none effect.

Id. The Bill is discussed by Ronan Deazley, *Commentary on the Booksellers' Bill (1737)*, *available at* PSOC, *supra* note 2, at n.59 (speculating about the possibility that the revolutionary ten year term was Swift's suggestion); *see also* James McLaverty, *Pope and Copyright*, in FOXON, *supra* note 35, at 245.

publisher relations. And, if regulation of contracting was a plausible strategy, why did the House of Lords choose not to limit the term of the contract to protect the author rather than creating a second reversionary term? Why did they choose a “proprietary” technique rather than a “contractual” one?

One explanation might be that at the time the Act was being passed the potential object of regulation, that is, “publishing agreements” between authors and publishers, was not a sufficiently stable category of business relations to make such regulation readily conceivable. Although we know that authors did enter into arrangements with publishers transferring “copies” before 1710,⁶⁶ the exact legal basis for such contracts was unclear. Indeed, the Stationers’ supposed “rights” in copies were in large part founded on entry in the Stationers’ Company’s register, rather than on consensual derivation of the copy from the author.⁶⁷ It was only as a consequence of the Statute of Anne that the foundation of the publishers’ properties was clarified, for future works, as authorship (i.e., composition of the text, rather than mere possession of the manuscript).⁶⁸ Consequently, the idea of regulating contracts between authors and publishers would not have suggested itself to the legislature in 1710 before the Statute of Anne because it was only as a consequence of the Statute that publishing contracts became *legally* necessary. Indeed, it is interesting to observe that the Statute contained a provision regulating the granting of consent to print and publish a work, but made no specific provision for transfer or assignment of the statutory right itself. In short, the Statute of Anne was primarily concerned with establishing and securing a “property,” and thus was a logical precursor to “contract.” Author-protective sentiments thus found expression more easily through the grant of additional, contingent, proprietary rights, rather than through controlling contract terms.

Two more mundane (but perhaps more persuasive) explanations can be suggested for the preference of a reversionary term over the regulation of contracts. First, the idea of a reversionary term was already circulating and thus readily available to legislature seeking to offer additional protection to writers. Certainly, the limited evidence that survives does not suggest that the

66. See *supra* notes 5–7.

67. MARJORIE PLANT, *THE ENGLISH BOOK TRADE: AN ECONOMIC HISTORY OF THE MAKING AND SALE OF BOOKS* 117 (2d ed. 1965); Astbury, *supra* note 42, at 297. *But see* Lindenbaum, *Brabazon Aylmer*, *supra* note 2, at 255–56 (deducing, from a surviving document under which the publisher Joseph Watts paid John Milton’s widow, Elizabeth, for permission to republish Milton’s works, that mere entry in the register book could not have been regarded as sufficiently to secure the rights in a work).

68. Cf. PATTERSON, *supra* note 7, at 69–70 (claiming that stationers recognized the rights of authors in manuscripts).

idea of contractual limitations had been raised, whereas the idea of the second reversionary term was had been discussed publicly in *The Observer* while the Bill was moving through the Commons.⁶⁹ Secondly, a reversionary term could be easily incorporated within the structure of the Bill that had passed through the Commons; modifying the Bill by adding a contingent reversion was in fact achieved, as we have seen, by way of a simple proviso. In contrast, adding provisions regulating contractual assignments would likely have required considerable restructuring; after all, the Bill did not even address the question of formalities necessary to transfer copies. The property approach, then, interfered less with the Bill that had been passed through the Commons than a contractual one would have. In light of the fact that the consideration of the Bill in the Lords came very close to the end of the session,⁷⁰ the ready availability and ease of incorporation of such a provision may have taken on particular importance.

B. IMPACT OF SECTION 11 ON AUTHORS AND BOOKSELLERS

If the 1710 Act was, as the evidence suggests, intended as an author protective measure, what was its impact? Did publishers, as *The Observer* predicted, merely attempt to get around the restriction? Were assignments couched to assign the second term? Were they effective in achieving that result? If not, were writers able to take advantage of the additional bargaining power offered by the reversion? Were authors able to negotiate improved deals with their existing publisher or offer their works to other publishers on more favourable terms?

69. Of course, this begs the question why contemporaries had only developed “proprietary” rather than “contractual” solutions to the problem of providing authorial protection. It may be that the emphasis on the effects of piracy on the welfare of authors and their families, evident in the petitions that preceded the legislation, made various devices for protecting landed families from creditors more obvious models than the laws that regulated the prices of bread, wages or interest rates. For discussion of such family-protecting rules, see Claire Priest, *Creating an American Property Law: Alienability and Its Limits in American History*, 120 HARV. L. REV. 385 (2006).

70. The Parliamentary session ended on April 5, 1710. The Bill was brought up from the Commons and given its first reading in the Lords on March 16, 1709/10, receiving its second reading on March 24. The Report from the Committee, proposing amendments, took place on April 4, 1710, the day before the session came to an end. On the final day of the session, the House of Commons had to decide whether to accept the Lords’ amendments. It did so with one exception: the Lords had proposed to remove the provision regulating book prices, and the Commons regarded this as important. In order to reach an agreement a committee was formed to draw up an explanation for the disagreement, and this was conveyed to the House of Lords. In turn, it was reported that “[t]he Lords do not insist upon their Amendment.” See 19 H.L. JOUR. (Mar. 16, 1709/10) 109, (Mar. 24, 1709/10) 123, (Apr. 4, 1710) 140, 16 H.C. JOUR. (Apr. 5, 1710) 394–96.

The conventional wisdom is that the reversion right was ineffective to secure additional rewards to writers (and composers) because the dominant practice was the ritual assignment to publishers of copyright in perpetuity and for a single lump sum. Book historian Harry Ransom, for example, wrote that “[t]he true intention of this proviso was ignored from the start: authors continued to sell their books outright.”⁷¹ Additionally, music historian Nancy Mace argues that the booksellers (and music-sellers, with whom she is primarily concerned) invariably took assignments and assumed these applied to both the initial term and the reversionary period.⁷² Legal historians Bill Cornish and Ronan Deazley also reiterate this orthodox view that writers assigned the reversionary term when they agreed to publish, and thus lost any power to renegotiate in the event of a work selling well and received no additional remuneration beyond the lump sum paid by the bookseller for the right to publish the work.⁷³

While the conventional wisdom that writers and composers did not benefit substantially from the introduction of the reversion right is probably correct, the mechanisms by which the intent of the reversionary term was nullified are much more complex than the conventional account supposes. In the first place, one may doubt the claim that all writers ritually assigned copyright in perpetuity. The historical archive, which comprises a substantial body of post-1710 author-publisher documents, reveals a much more diverse set of practices.⁷⁴ Secondly, even if such assignments were commonplace, the effect of such assignments on the reversionary term depended on how the legal operation of that reversion was understood. More specifically, the effect of such assignments depended on whether the law regarded the reversionary term to be assignable, and, if so, by what mechanisms. Prior to the decision in *Millar & Dodsley v. Taylor* in 1765, and even perhaps right through to the

71. RANSOM, *supra* note 7, at 104; *see also* Griffin, *supra* note 2, at 134 (noting “as any careful historian of copyright observes, eighteenth-century authors almost always immediately sold their owner’s right to a bookseller”).

72. Nancy Mace, *Charles Rennett and the London Music Sellers in the 1780s: Testing the Ownership of Reversionary Copyright*, 129 J. ROYAL MUSICAL ASS’N 1, 2 (2004).

73. Cornish, *supra* note 27, at 23 (noting that “initial contracts between author and entrepreneur tended expressly to include a grant of rights for both periods”); Deazley, *supra* note 51, at 48 (“For the most part, however, booksellers would simply purchase an author’s copyright outright, including the author’s reversionary interest set out within s.11 of the Statute of Anne.”).

74. *See infra* Section II.B.1; JAMES RAVEN, *THE BUSINESS OF BOOKS: BOOKSELLERS AND THE ENGLISH BOOK TRADE* 242, 316–17 (2007) (pointing out that there were many cases of author-publication, profit-sharing, and single-edition contracts).

1780s, this was a matter of legal speculation.⁷⁵ After 1785, and the decisions in *Rennett v. Thomson*, *Rennett v. Longman*, and *Carnan v. Bowles*,⁷⁶ it seems, the better view was that the reversionary term could be assigned by express terms only.⁷⁷ In light of this, we can safely say that only some—certainly not all—of the surviving author-publisher documents would have been effective in transferring the reversion.⁷⁸

The conclusion that not all documents would have been regarded as effective to transfer copyright, however, leads us to the third component of this complex reality: whether writers were conscious of their legal rights, and, if they were, their practical capacity to take advantage of the reversion. The evidence here suggests that, whatever their legal rights may have been, few writers in fact took advantage of their reversionary rights.⁷⁹ In part, this can be explained by reference to the fact that few works would have had a substantial market fourteen years after first publication, and, in a good number of those that did attract continued demand, the author may well not have survived the first fourteen year term.⁸⁰ But, in the few cases in which the reversion right related to works for which there remained continuing demand, the right would only have had value if a writer were conscious of his or her legal rights and able to interest other publishers in such rights. With regard to consciousness, it seems likely that many writers would have looked to the literal terms of their contracts with publishers for guidance, rather than to the 1710 Act. Consequently, they likely would not have appreciated their legal rights under section 11. Moreover, some writers may have shared the view, widely advocated by publishers after the 1740s, that copyright was really a matter of common law and that it existed in perpetuity, therefore their rights had been assigned effectively in perpetuity as well (whatever the Statute may or may not have said).⁸¹ Furthermore, particularly after 1774 (when it came to be understood that rights in published works were determined wholly according to the terms of the 1710 Act),⁸² one may doubt

75. See *infra* Section II.B.2.b (discussing perceptions prior to the unreported case of *Millar & Dodsley v. Taylor* in 1765 and the uncertain status of that decision).

76. See *infra* Section II.B.2.e.

77. See *infra* Section II.B.2.e (discussing *Carnan v. Bowles*, (1785) 29 Eng. Rep. 45 (Ch.)).

78. See *infra* Section II.B.1.

79. See *infra* Section II.B.2.

80. Some famous examples serve to illustrate the point: James Thomson, author of the poem *Liberty*, published by Andrew Millar in 1735, died in 1748; Henry Fielding, author of *Joseph Andrews* (published in 1742), and *Tom Jones* (published in 1748–49) died in 1754; Oliver Goldsmith, author of *The Vicar of Wakefield*, which was published in 1766, died in 1774; Samuel Johnson, author of *Lives of the Poets*, published between 1779 and 1781, died in 1784.

81. See *infra* Section II.B.2.

82. See *infra* Section II.B.2.d.

how much scope there might have been for using the reversionary term to negotiate better terms, either with the existing publisher or a new publisher. Some writers would likely have been bound to their publisher through more than a single deal, and the ability to utilize the reversion to negotiate with other booksellers would have been circumscribed by the realities of a continuing, and frequently positive, relationship.⁸³ Even where this was not the case, there is considerable evidence that the book market remained relatively uncompetitive even after the House of Lords decision in 1774 in *Donaldson v. Beckett*⁸⁴ (rejecting the booksellers' claim to a perpetual right at common law) and possibly well into the nineteenth century.⁸⁵ It is unclear what, if any, scope authors would have had in practice to switch publishers, and thus to renegotiate the terms of the original publishing agreement.

1. *Contractual Practice After 1710*

The main assumption that underpins Ransom's claim as to the irrelevance of the reversionary right is that, even after the passage of the Statute of Anne, writers continued to assign all rights in full, and that this practice effectively assigned the reversion.⁸⁶ In this section, we suggest that the evidence indicates that while outright assignments were common, they were by no means the universal practice. Moreover, as it is unclear that such purported assignments would have been regarded as effective to assign the reversion, a closer analysis of contractual practice is warranted.

In order to make any assessment of contractual practice, it is first necessary to say something about the evidence available from which we can work. There is a surprising amount of surviving documentation relating to

83. Richard Sher gives many examples of authors who had continuing relationships with specific publishers, and circumstances where publishers would "compensate" authors for bad bargains with additional gratuitous payments or increased payments on later works. SHER, *supra* note 2, at 244–45.

84. *Donaldson v. Beckett*, (1774) 98 Eng. Rep. 257; 17 COBBETT'S PARLIAMENTARY DEBATES 998, *passim* (1774) (House of Lords).

85. RAVEN, *supra* note 74, at 232 (stating that "changes before the 1774 pronouncement and continuities after it suggest less a 'watershed' than a point in a much longer and more complex course of development . . . [C]heap reprinting had flourished for several decades . . . and leading booksellers' de facto extended copyright continued as securely as ever . . ."); Michael Suarez, *To What Degree Did the Statute of Anne (8 Anne, c. 19, [1709]) Affect Commercial Practices of the Book Trade in Eighteenth Century England? Some Provisional Answers About Copyright, Chiefly from Bibliography and Book History*, in GLOBAL COPYRIGHT, *supra* note 27, at 61 (noting that "[e]ven after *Donaldson v. Becket*, the established London trade continued to conduct its business in many of the same ways it had in the 1680s, behaving in 1800 largely as if copyright was perpetual").

86. The limited surviving evidence of contractual practice before 1710 reveals a similar trend.

author-publisher relationships in the eighteenth century. For this study, we have analysed over three hundred British author-publisher documents. The most substantial collection of such documents is *The Upcott Collection*, compiled by William Upcott (1779–1845), an antiquary and autograph collector, and currently held at the British Library. In addition, there are also some collections of documents relating to individual publishers, including eleven contracts with bookseller Robert Dodsley, from 1743 to 1753,⁸⁷ as well as archives, collections of correspondence, and biographical accounts of individual authors.⁸⁸

Three caveats are worth noting about the usefulness of these sources. First, they tend to relate primarily to the authors who were regarded retrospectively as successful. Secondly, the surviving contracts represent only a limited number of publishers (and the bulk of them come from before

87. These are contained in the Egerton Manuscripts at the British Library, BL Eg. Mss. 738. See also THE PUBLISHING FAMILY OF RIVINGTON 60–61, 57, *passim* (Septimus Rivington ed., London, Rivington, Percival & Co. 1894); CHARLES WELSH, A BOOKSELLER OF THE LAST CENTURY: BEING SOME ACCOUNT OF THE LIFE OF JOHN NEWBERY, AND OF THE BOOKS HE PUBLISHED, WITH A NOTICE OF THE LATER NEWBERYS 52–53 (Cambridge Univ. Press 2010) (1885).

Other collections, which we have not consulted, or have not consulted systematically for the purposes of this paper, are (i) the Longman archive, University of Reading, which contains at least two contracts (assignment of copyright by Sir James Steuart to Andrew Millar for *Inquiry into Principles of Political Oeconomy*, June 15, 1767, MS 1393/26/2 (d), University of Reading Library; contract between Alexander Adam and Strahan, Cadell, and Creech, June 30, 1794, Ms 1393, 26/8); (ii) the Strahan Archive in the British Library (which contains a contract between Blair and the three publishers Creech, Strahan & Cadell, 1780, in Strahan Archive, BL Add. Mss. 48901, fol. 20); (iii) the archives of George Robinson, publisher, held at Manchester Public Library (on which, see G.E. Bentley, Jr., *Copyright Documents in the George Robinson Archive: William Godwin and Others 1713–1820*, 35 *STUD.* 67, 67–110 (1982)); (iv) the collection of music contracts of the firm in BL Add MS 63814; (v) the Murray Archive in the National Library of Scotland; (vi) the Houghton Library collection at Harvard University; and (vii) the examples in the Osborne manuscripts in the Beinecke Library at Yale. Another source that we have not utilized systematically is surviving court records.

88. Often the archives or originals are in private hands, but printed transcriptions are available. See, e.g., JEAN MARTEILHE, THE MEMOIRS OF A PROTESTANT CONDEMNED TO THE GALLEYS OF FRANCE FOR HIS RELIGION, at xv (Oliver Goldsmith trans., 1895) (representing a receipt for sale from Goldsmith to Edward Dilly, January 11, 1758, relating to translation of the work); JAMES PRIOR, THE LIFE OF OLIVER GOLDSMITH, M.B. FROM A VARIETY OF ORIGINAL SOURCES (London, 1837); TOBIAS G. SMOLLETT, LETTERS OF TOBIAS SMOLLETT 26, 64–66 (Edward S. Noyes ed., 1926); Receipt for sale of rights from Adam Ferguson to Cadell for Ferguson's *Essay on the History of Civil Society* (Apr. 10, 1767), (on file with Beinecke Library, Yale), reprinted in 1 ADAM FERGUSON, THE CORRESPONDENCE OF ADAM FERGUSON 71–72 (Vincent Merolle ed., 1995); Memorandum from Adam Ferguson to Strahan, Cadell & Creech (Feb. 28, 1782) (on file with CE French Papers, Massachusetts Historical Society), reprinted in 2 FERGUSON, *supra*, at 576.

1770). This presents problems particularly in relation to tracking the evolution of contractual practice, because the main sources for particular periods are frequently just one or two publishers. Thirdly, the archives contain a range of author-publisher documents. About two thirds of the surviving documents take the form of receipts, that is, acknowledgments of money received from a publisher. About one quarter of the documents are more formal, purporting to assign copyright from authors, or, in the case of married women, their spouses,⁸⁹ or occasionally descendants,⁹⁰ to publishers; while one in twelve documents is an agreement to write, compile or translate a work. The variety of documents makes generalization hazardous. One particular difficulty in having so many receipts is inferring whether there would have been a lengthier, more formal contract accompanying such a receipt, or whether these rudimentary written documents operated in lieu of such formal documents. We know that there are cases where both receipts and more formal documentation exist in relation to the same transaction,⁹¹ but there are good reasons to believe that in many cases (particularly relating to transactions of lower value), the surviving receipts were the only documents. Indeed, some of such receipts specifically provide that further documents will be entered if necessary—implying that the receipt was the only document.⁹² Moreover, in some of the litigation in the 1780s, music publishers seemed to admit that they relied on such receipts to transfer all rights (including the reversionary interest)—importantly, for our purposes, indicating that there frequently would be no other documents evidencing the terms of a transaction.⁹³

89. *E.g.*, 2 UPCOTT, *supra* note 4, at [31], [35].

90. *E.g.*, RIVINGTON, *supra* note 87, at 60–61; 1 UPCOTT, *supra* note 4, at [37], [119].

91. Note, for example, the range of documents that survive in relation to Milton's works. For the post 1710 period, see, e.g., the various documents relating to Goldsmith's *Natural History*, including the agreement to write the work, receipts for payments on delivery of various volumes, and an assignment of the copyright, in 2 PRIOR, *supra* note 88, at 200–01 (referring to an agreement dated February 29, 1769 with William Griffin that Goldsmith would write eight volume *Natural History*), 218 (receipt), 340 (referring to assignment as in same terms as contract).

92. 1 UPCOTT, *supra* note 4, at [32], [110] (stating “I promise to assign the above mentioned copy over to John Watts on Demand,” March 3, 1732, between John Watts and Wm Havard); 2 UPCOTT, *supra* note 4, at [172] (explaining how on June 12, 1723, Thomas Marshall gave receipt to Hook and promised “to sign a Bill of Sale for the same upon demand”).

93. *See* Answer of Samuel Thompson, Ann Thompson and Peter Thompson, E112/1705/3808 (1785) (which can be found at the National Archive, Kew) (stating “it has always been the usage and custom in the purchase of such kind of Musical Compositions to take a Receipt from the Author or Composer thereof which was meant or expressed to be in full for the purchase of all the Right Interest and Property whatsoever of such Author or

There are a host of documents that appear to say nothing about copyright at all.⁹⁴ Of the 130 or so documents in volume 1 of *The Upcott Collection*, for example, eighty take the form of receipts. Of these, about fifty specify they are for the “copyright” or “copy” or “property,” but around thirty do not specify that the consideration was paid for the property, as opposed to permission to publish or services provided. Many of the surviving receipts for transactions involving publisher Edmund Curll, for example, say nothing about the “copy.” One signed by Thomas Foxton, dated January 1, 1725, mentions payment “being in full for translating *Laus Ululae* or the Praise of Owls,”⁹⁵ while another, three months later, signed by Thomas Cooke, is expressed to be “in full for writing *Mr Marvells Life*, procuring some of his letters & publishing his works.”⁹⁶ The same is true for a host of the receipts that Oliver Goldsmith signed for his publishers in the 1760s.⁹⁷ Moreover, a number of the contracts in the small collection relating to the bookseller Robert Dodsley also say nothing about rights.⁹⁸ An example is the agreement dated October 15, 1748 with historian John Campbell (1708–1775). Campbell agreed to write a book *The Geography, Natural History and Antiquities of England & Wales* between sixty and eighty sheets in length within a period of ten months, and for Dodsley to pay him two guineas per sheet and to print the work. No reference was made in the agreement at all

Composer in or to such Work or Composition”). In *Millar v. Taylor*, C33/426, fol. 60^{r-v} (Ch. 1765) (also at the National Archive), the co-plaintiff, James Dodsley, relied on receipts signed by Edward Young to Robert Dodsley from 1743 and 1744 in order to substantiate his claim, perhaps suggesting that no other documents existed. There is no suggestion in the summary of the court that a separate assignment had occurred but that the document had not survived.

94. OLIVER GOLDSMITH, *THE COLLECTED LETTERS OF OLIVER GOLDSMITH* 73, n.3 (Katherine C. Balderston ed., 1928) (referencing a receipt from Goldsmith relating to payment by James Dodsley “for writing and compiling” his *History of England*, August 8, 1764); 1 UPCOTT *supra* note 4, at [52], [56], [102], [103], [121], [196].

95. 1 UPCOTT, *supra* note 4, at [102].

96. 2 UPCOTT, *supra* note 4, at [52]. According to the English Short Title Catalogue, *Laus Ululae* was written by Conradus Goddeus, and the translation by Foxton appeared in volume 2 of Curll’s *Miscellanea* in 1725. ENGLISH SHORT TITLE CATALOGUE [hereinafter ESTC], available at <http://estc.bl.uk/>. The Catalogue also includes a 1726 edition of *The Works of Andrew Marvell*, published by Curll and edited by Thomas Cooke.

97. Compare 1 PRIOR, *supra* note 88, at 388, 392, 397, 407, 473, 490, 2 PRIOR, *supra* note 88, at 130 (receipts for money received from John Newbery), and 1 PRIOR, *supra* note 88, at 465 (contract between Goldsmith and James Dodsley for the *Lives of Eminent Persons*), with 1 PRIOR, *supra* note 88, at 397 (receipt from Goldsmith for payment by John Newbery for “the copy” of *The Chinese Letters*), and 2 PRIOR, *supra* note 88, at 131 (receipt for payment for “the copy”), 218 (receipt for payment by William Griffing coupled with promise to assign copyright).

98. BL Eg. Mss. 738, *supra* note 87.

about the transfer of the “copy” (i.e., copyright). The same is true of an agreement Dodsley entered into on August 22, 1749 with Thomas Salmon (1679–1767) to write *The Tradesman’s Directory*,⁹⁹ and with Joseph Wharton, on March 7, 1749/50, to translate Virgil’s *Georgicks*.¹⁰⁰ Yet other Dodsley contracts, with Henry Baker, Fellow of the Royal Society, (1698–1774) and William Duncan, Professor of Philosophy at the University of Aberdeen (1717–1760), are quite specific on the matter of copyright.¹⁰¹ Looked at in the round, these documents suggest that the assumption that after 1710 copy was universally assigned from authors to publishers in full upon the initial sale of the manuscript is something of an exaggeration.

Moreover, individual biographical studies record that authors sometimes retained copyright in their works.¹⁰² Some authors published their own works, with booksellers being offered a commission on sale, while other authors granted publishers limited licenses to print only the first edition. The scientist James Ferguson (1710–1776) adopted the former strategy, publishing his *Astronomy Explained* in 1756 before assigning copyright to Andrew Millar in 1758,¹⁰³ while Oliver Goldsmith published his own translation of *Memoirs of a Protestant*.¹⁰⁴ The philosopher David Hume (1711–1776) retained copyright in his *History of England*, initially permitting Midwinter to publish only a single edition, before he later chose to sell the copyright to publisher Thomas Cadell and printer-publisher William Strahan.¹⁰⁵ There is some suggestion that the London publishers particularly resented authorial self-publication. For example, Tobias Smollett (1721–1771) “incurred the hostility of several important publishers by retaining the

99. BL Eg. Mss. 738, *supra* note 87, fol. 8 (describing the payment as “copy money”). The ESTC, *supra* note 96, contains no such book of that title either being published by Dodsley or written by Salmon.

100. The ESTC, *supra* note 96, contains no record of this.

101. *See infra* note 160. Many of these arrangements where there is no reference to copyright relate to translations, and one possibility is that it might have been assumed that no copyright subsisted. Having said this, Lintot’s famous contract with Alexander Pope related to Pope’s translation of Homer. On the latter, see *infra* note 117.

102. RAVEN, *supra* note 74, at 242, 316–17; SHER, *supra* note 2, at Ch. 3 (both pointing out that there were many cases of author-publication, profit-sharing, and single-edition contracts).

103. JOHN R. MILLBURN, WHEELWRIGHT OF THE HEAVENS: THE LIFE AND WORK OF JAMES FERGUSON, FRS 90 (1988); SHER, *supra* note 2, at 217.

104. Henry Dobson, *Introduction*, in MARTEILHE, *supra* note 88, at xiv (Goldsmith published himself).

105. SHER, *supra* note 2, at 240–41; *see also* 2 UPCOTT, *supra* note 4, at [144] (where author had published work himself and sold copies and “right of re-printing” to bookseller).

whole of the copyright to *Peregrine Pickle* in 1751.¹⁰⁶ However, many of the London publishers in fact facilitated such activities, for example by printing and selling the works. In any case, such hostility did not prevent authors from continuing to self-publish, often with success. In the 1760s, Vinerian Professor of Civil Law, William Blackstone (1723–1780), arranged for Oxford University Press to print his *Commentaries*, only selling the copyright to William Strahan, the bookseller, after the book had been in print for eight years. Then in the 1790s James Boswell (1740–1795) famously retained copyright in his *Life of Johnson*.¹⁰⁷

Even so, Ransom is correct that, in the majority of cases, a publisher would purport to take an assignment of the rights in the “copy.” However, as we will see, the details of these documents vary rather dramatically. This variety may well have had much greater significance than Ransom recognized. This is because considerable uncertainty surrounded the question of whether the reversionary right was capable of assignment at all, and, if so, by what means. The former question would be resolved in 1765 and again in the 1780s by a series of cases (the most famous of which is *Carman v. Bowles*¹⁰⁸) which held that the reversionary term could be assigned by a transaction effected during the initial term.¹⁰⁹ But those cases did not resolve, at least with any clarity, the question of *precisely what was required* to assign the reversion. Here, at least two matters deserve careful attention. First, what was the required *form* of the document: was a deed required, or at least writing attested to by two credible witnesses, or would any writing do? Second, precisely what form of *expression* would be effective to indicate an agreement to transfer the reversion: would a mere transfer of the “copy” or “copyright” be sufficient, or would that be regarded as effective only to assign the first term? Would the reversionary term be transferred by assignment forever, or was it necessary to refer, explicitly, to the reversion? Was it necessary to express an intention to override the protective aims of the statute, or would some indication that the author was to retain no claim or interest be

106. Harlen, *supra* note 3, at 67; LEWIS M. KNAPP, *TOBIAS SMOLLETT: DOCTOR OF MEN AND MANNERS* 118–19 (1949) (stating that the advertisement for the 1758 edition explained that certain booksellers had tried to stifle the novel at birth, and speculating that this was because “they disapproved of Smollett’s independent reservation of the whole copyright”); SHER, *supra* note 2, at 218–19 & n.53.

107. Boswell made £1555 profit on the first edition. *THE CORRESPONDENCE OF JAMES BOSWELL WITH DAVID GARRICK, EDMUND BURKE AND EDMOND MALONE* 410 (George M. Kahrl ed., 1986); SHER, *supra* note 2, at 220–24.

108. *Carman v. Bowles*, (1785) 29 Eng. Rep. 45 (Ch.); see case discussion, *infra* Section II.B.2.e.

109. See case discussion, *infra* Section II.B.2.e.

effective.¹¹⁰ While many of these matters remained undecided right until the repeal of the reversion right in 1814, the precise form and content of the contract was clearly all-important—a matter which Ransom and others have frequently failed to recognize.

a) Formalities

The Statute of Anne said nothing about transferring the first term of copyright, let alone the reversionary term. The Act did, however, indicate formalities which any licensee would have to satisfy to escape an accusation of infringement by the author or proprietor: the licensee would need to demonstrate his or her consent in writing, signed, and witnessed by two credible witnesses.¹¹¹ Presumably, given that the legal effect of an assignment is more serious than the grant of a licence, an effective transfer of the first term required compliance with at least the same formalities. Moreover, given its author-protective intent, this must have been all the more the case with the reversionary term. Certainly, some thought a deed was necessary.¹¹²

Of the surviving cache of documents, only a small proportion is under seal,¹¹³ while most are merely written and signed by the author alone. There are seventeen contracts under seal, signed by two witnesses, in volume 1 of *The Upcott Collection*, and ten in the second volume. Of these, most (thirteen) related to transactions with printer-turned-publisher John Watts.¹¹⁴ Two sealed transactions have only one witness.¹¹⁵ Most of the remaining documents are merely signed, but not witnessed: only seven are also witnessed (one by two witnesses).¹¹⁶ It is perhaps of significance that of the deeds, the majority were created in the 1720s and 1730s, and only five derive from after 1750, suggesting, possibly, that the perceived need to comply with statutory formalities faded as belief in common law copyright became more widespread.¹¹⁷ However, assignments by deed also survive in the Strahan

110. These questions also came to be posed in the U.S. caselaw. *See infra* text accompanying notes 378, 417–20.

111. Statute of Anne, 1710, 8 Ann., c. 19, § 1 (1710) (Gr. Brit.).

112. *See infra* Section II.B.2.a (describing the view of Alexander Pope).

113. For example, those between Pope and Lintot. *See* discussion, *infra* Section II.B.1.e.

114. 1 UPCOTT, *supra* note 4, at [43], [45], [142], [146], [148], [150], [152], [155], [169], [161], [200], [206], [210] (dating from between 1727 and 1744).

115. 1 UPCOTT, *supra* note 4, at [29] (dating from 1731); 2 UPCOTT, *supra* note 4, at [28] (dating from 1742).

116. 2 UPCOTT, *supra* note 4, at [40], [56], [152], [208].

117. In addition, three surviving Pope contracts, all with Bernard Lintot, were made under seal. Egerton Charters, BL Eg. Ch. 128 (over translation of *The Iliad*), Ch. 129 (relating to a collection of Pope's Works, this contract from 1717 was witnessed by Henry Lintot and William Fortescue and bears the signature of Lintot, but not that of Pope), BL Eg. Ch. 130

Archive, relating, inter alia, to Hugh Blair's *Sermons* (dated December 21, 1780) and William Buchan's *Preventive Medicine* (dated March 5, 1781).¹¹⁸

One response to the uncertainty over formalities was to include within the contract an agreement to do anything necessary at any stage to perfect the title of the transferee. A good example is provided by an agreement, dated March 15, 1734, between actress and writer, Eliza Haywood (1693–1756), and two publishers, Francis Cogan and John Nourse, relating to Haywood's *The History of British Theatre*.¹¹⁹ The agreement recites that in return for £16 and four shillings, Haywood acknowledged that she had

sold unto the said Francis Cogan & John Nourse, the Copy Right . . . & at the request of the said Francis Cogan & J Nourse the said Eliza Haywood shall immediately assign over to them all her the said Eliza Haywood's Right Title Interest Claim Demand or preference whatsoever to the Copy and Copy Right of the said Book for ever by such instrument *as they shall be advised is proper & sufficient for the purpose*.¹²⁰

A measure of this sort would, on its face, have enabled the purchaser to call for the perfection of an assignment (including an assignment of the reversionary interest), should that have proved necessary.¹²¹ Less elaborate clauses, requiring the author to “execute an assignment of the . . . copy on demand,” can be found in quite a number of documents, including some that are agreements to write works, and some that acknowledge receipt of

(relating to a proposed translation of Homer's *The Odyssey*, dated February 18, 1723). The Dodsley dealings also include some in the form of deeds. *E.g.*, BL Eg. Mss. 738, *supra* note 87, fol. 2, (addressing an agreement under seal dated June 3, 1744 between Henry Baker and Robert Dodsley, relating to publication of *A Treatise on Microscopes*).

118. Strahan Archive, BL Add. Mss. 48901, *supra* note 87, at fol. 20 (Blair), fol. 22 (Buchan).

119. 1 UPCOTT, *supra* note 4, at [112]; 2 UPCOTT, *supra* note 4, at [20] (containing a contract, dated January 4, 1733, in similar terms with Theodore Barlow for the publication of a legal treatise on the Duty and Office of a Justice of Peace); *see also* 1 UPCOTT, *supra* note 4, at [192] (noting a contract between John Shebbeare and John Nourse, dated January 22, 1754, where Shebbeare undertook “to secure to [Nourse] said Property against all persons who may have pretensions” to it); 2 UPCOTT, *supra* note 4, at [28] (indicating a contract between Nourse and Barlow, dated August 8, 1744). Poet James Thomson's agreement with Andrew Millar for the poem *Liberty*, dated December 16, 1734, contains an undertaking to do “all and every such further and other lawfull and reasonable act and acts thing and things assignments and assurance whatsoever.” JAMES THOMSON: LETTERS AND DOCUMENTS 89 (A. McKillop ed., 1958).

120. 1 UPCOTT, *supra* note 4, at [112] (emphasis added).

121. *See infra* Section III.E.2.c.

payment.¹²² A further strategy was to require the author to refrain from doing anything that would undermine the effect of the agreement.¹²³ This, it was hoped, would have prevented an author from taking advantage of any flaws in the title conferred on the publisher, for example by assigning the rights to a third party publisher or even giving another publisher consent to republish the work. In so far as such devices were attempts to undercut the statutory policy underpinning both the requirement of formalities, and section 11, it must have been unclear whether the courts would have enforced them.

b) Interest Transferred

The precise language used to indicate what, if anything, was transferred from author to bookseller varied significantly. Over the century under review, a range of terms are used: “right,” “title,” “property,” “interest,” “copy,” and “copy right,” either alone or in combination (as, for example, “whole and sole right and property”).¹²⁴ During the thirty years following the Statute of Anne, the language of “sole right and title to the copy” appears in over one quarter of the documents.¹²⁵ In the following thirty years, from 1740 to 1770, the term “copy right” is used to identify the subject of the transfer in over one third of the documents we have examined.¹²⁶ More elaborate

122. 1 UPCOTT, *supra* note 4, at [32], [110] (stating “I promise to assi[g]n the above mentioned copy over to John Watts on Demand,” contract between John Watts and Wm Havard, dated March 3, 1732); 2 UPCOTT, *supra* note 4, at [200–01] (referring to an agreement dated February 29, 1769 with William Griffin that Goldsmith would write eight volume *Natural History*), [218] (receipt of £500 for five volumes of *Natural History* with promise to assign), [432] (receipt for £250 in relation to *History of Greece* coupled with promise to assign).

123. *E.g.*, 2 UPCOTT, *supra* note 4, at [140] (featuring a contract between John Hill and Thomas Osborne, dated Dec 21, 1752, in which Hill undertook not to do anything “whereby it may in any way [b]e a [p]rejudice to this [u]ndertaking”).

124. For examples of “the copy,” see 1 UPCOTT, *supra* note 4, at [157] (between Curll and Charles Molloy (d. 1767), dated April 23, 1718, for the play *The Coquet*); *see also id.* at [37], [102], [49], [163], [38]. For “right and property,” see, for example., *id.* at [189] (a contract between John Watts and George Sewell, dated January 9, 1718, for a Tragedy entitled *Sir Walter Raleigh*).

125. *E.g.*, 1 UPCOTT, *supra* note 4, at [120] (relating to a play entitled *The Tragedy of King Henry the Fourth of France*, and a translation of *Rapin’s Xtn*, a contract between Curll and Charles Beckingham, dated Nov. 13, 1710); *see also id.* at [185], [34], [41], [187], [127], [188], [197]; Agreement Between Jacob Tonson and Matthew Prior (1718), *in* RIVINGTON, *supra* note 87, at 58–59.

126. The publishing contracts entered by John Nourse and Thomas Lowndes frequently merely indicate the transfer of the “copy” or “copyright.” 2 UPCOTT, *supra* note 4, at [79] (featuring a contract dated March 21, 1746 between John Nourse and James Dodson for “the whole and entire Copy & all his Right and Title of the first Volume of a Work called and entitled *The Mathematical Repository*”); *see also* 1 UPCOTT, *supra* note 4, at [113], [192]; 2

variations on the language of “right and title,” such as “whole right, title and property” or “right, title and claim” also become more prevalent. Henry Fielding’s agreement with Andrew Millar for *Joseph Andrews*,¹²⁷ dated April 13, 1742, transferred “all his Title Right and property” for £199 6s, and his agreement for *Tom Jones*, dated June 11, 1748 for £600 was in similar terms (though it did indicate the transfer was “for ever”).¹²⁸ In two agreements in 1743 and 1744 with bookseller Robert Dodsley,¹²⁹ Henry Baker purported to:

[S]ell transfer and assign to the said Robert Dodsley the said Book Copy or Treatise . . . together with all the *right property Benefit and Interest* of the said Henry Baker of and in and to the same To Hold the same to the said Robert Dodsley his Executors Administrators and Assigns as his and their own proper Goods and Chattles [sic] for ever more.¹³⁰

Others were more extensive still, such as that dated December 21, 1752, according to which John Hill, in return for £472,

Granted, Bargained, Sold, Assigned, Transferred and set over . . . unto . . . Thomas Osborne his Executors Administrators & Assigns *all that the Copy Right or Priviledge* of Printing reprinting Publishing Vending & Selling in any Volumes and under any Title whatsoever of all those Books compiled or written by the said Dr John Hill Entitled *A General Natural History* . . . and *all Benefit Profit Gain and advantage of the said* Several Books and Every of them or to be had or made by them & Every of them and *also the Estate Right Title Interest Property Claim & Demand whatsoever both at Law and in Equity or otherwise howsoever of him the said John Hill of in and to the said Copy Right*

UPCOTT, *supra* note 4, at [80], [158], [172] (featuring a contract dated June 12, 1723 between Hook and Thomas Marshall “for the Copy right of Juvenal & Persius with notes by me”).

127. The contract is contained in the Forster Collection at the Victoria & Albert Museum in London. See Austin Dobson, *Fielding and Andrew Millar*, 7 LIBR. 177 (1916).

128. G.M. GODDEN, HENRY FIELDING: A MEMOIR 183, 304–05 (1910); Dobson, *supra* note 127, at 184 (citing a letter from Horace Walpole to George Montagu (May 18, 1749), in 2 HORACE WALPOLE, THE LETTERS OF HORACE WALPOLE, FOURTH EARL OF ORFORD 160 (London, Richard Bently & Son pub., 1891)). The Appendix to Dobson’s article contains a transcription of the formal contract, dated 25 March 1749, which is in the JP Morgan Library in New York.

129. BL Eg. Mss. 738, *supra* note 87, fol. 2 (June 3, 1744, *A Treatise on Microscopes*), fol. 3 (August 22, 1743, *An Attempt Towards A Natural History of the Polype*). According to the ESTC, *supra* note 96, Dodsley published three works on microscopes by Baker: *Microscope Made Easy* (1742, 1743, 1744, 1754, 1769), *Employment For the Microscope* (1735, 1753, 1764) and *Of Microscopes* (1760, 1785), as well as *The Polype*. In a further agreement, Will Duncan agreed to translate *Caesar’s Commentaries*, “the Property of the said Book shall be vested in the said Robert Dodsley and his Heirs for ever.” BL Eg. Mss. 738, *supra* note 87, fol. 6. The ESTC, *supra* note 96, lists this as published by Dodsley, J & R and Tonson and S. Draper in 1753.

130. BL Eg. Mss. 738, *supra* note 87, fol. 2 (emphasis added).

*of the said Books and Every of Them. To have & to hold the said Copy Right or Priviledge of Printing Vending or Selling the said Books and Every of Them and all benefit or advantage to be had or made thereby unto the said Thomas Osborne his Executors Administrators and Assigns to & for his and their own proper use and Benefits and as his and their own Proper Goods & Chattels from henceforth for ever.*¹³¹

However, while some documents use every conceivable term to describe the interest being transferred, many—indeed most—are more rudimentary. These various formulae may, in law, have had more significance than contemporaries appreciated. Were a court to demand evidence of a “specific intent” to convey the reversionary interest, as opposed to “general words,”¹³² there would have been significant doubt over whether and, if so, which, of these less elaborate verbal formulae sufficed. As we will see, one possibility was that the term “interest” indicated an intent to convey the expectancy as opposed to the vested right (which would have been included in the term “right” or “property”). But only about one in ten documents used that term to describe the subject of the transfer.

c) Duration of Transfer

Most surviving documents that refer to the transfer of the “copy” purport to transfer rights “for ever.” For example, the deeds between Bernard Lintot and Alexander Pope (to which we will return), as well as between publisher Jacob Tonson and the poet Matthew Prior (1664–1721), indicate that they had intended to transfer rights “for ever.”¹³³ Contracts purporting to convey rights “for ever” continued to be common throughout the century.¹³⁴ Some documents seem to confer the same open-ended power

131. 2 UPCOTT, *supra* note 4, at [140] (emphasis added). The ESTC, *supra* note 96, indicates that the book was published by Thomas Osborne in parts between 1748 and 1752. Hill had issued a proposal for a subscription in 1746, a copy of which remains in the Wellcome Institute.

132. See discussion of the interpretation of *Carnan v. Bowles* (1785), *infra* Section II.B.2.e.

133. RIVINGTON, *supra* note 87, at 57–59, sets out the agreement between Jacob Tonson and Matther Prior, 1718 (contracting “to have and to hold all the said Copy of the said Poems . . . unto the said Jacob Tonson his heirs and assigns for ever”) and between John Gay and Bernard Lintot and Jacob Tonson, Jan 28, 1719 (“He the said John Gay doth hereby promise and agree to assign unto the said Bernard Lintot and Jacob Tonson the copy of all and singular the several new pieces which shall be printed in this edition to go equally share and share and alike unto the said Bernard Lintot and Jacob Tonson their heirs and assigns for ever.”).

134. 2 UPCOTT, *supra* note 4, at [135]. See also, for example, the arrangement between the writer Thomas Stackhouse (d. 1750) and the bookseller Stephen Austein, relating to Stackhouse’s commentaries on the Bible, dated 1740, set out in *Information for Messrs John*

in a different way, that is, by conferring on the grantee the right to reprint the work as many times as he (it usually was a man) “thinks fit.”¹³⁵

Nevertheless, a significant number of documents say nothing about the term of any transfer, typically referring merely to the transfer of the “copy,”¹³⁶ or the “copy right.”¹³⁷ It could not have been completely clear that such transfers indicated an intent to transfer both terms of protection, and it was certainly not obvious that the courts would interpret them in such a way.

d) Exclusion of Statute

Some contracts explicitly sought to negate the reversionary effect of the second term by providing for the transfer of all interests, notwithstanding the existence of “any statutory provision to the contrary.” For example, the printer-turned-bookseller John Watts frequently stipulated that his authors give over full and sole rights to their work “for ever, any Law or Statute to the contrary thereof in any wise notwithstanding.”¹³⁸ The first of these is a contract dated February 5, 1727, over poet and playwright John Gay’s (1685–1732) comic ballad opera, *The Beggar’s Opera*. Here, Watts combined with Jacob Tonson to purchase the rights, with John Gay giving them:

all the sole Right & Title of in and to the Copys & Copy Right of
Two books [*Fifty Fables* and *The Beggars Opera*], with Copys & Copy
Right of the said two Books . . . equally share & share alike & to

Hinton et al 2–3 (1773), available at PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"uk_1773a](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/)". One peculiar agreement attempted to transfer the rights for “the life” of the author, the idea presumably being to give the benefit of the remainder to the author’s family. 1 UPCOTT, *supra* note 4, at [37], (Feb. 17, 1718–19) (conveying to “Mr. Curll Full Satisfaction for a Copy of a Novel called *The German Atlantis*, or *Hanover Tales for the life of the Author*. Robert Busby”).

135. As was the case with James Thomson’s contract with Andrew Millar for “Spring” signed on Jan 16, 1729/30. Houghton Library, Harvard, reproduced in JAMES THOMSON, *supra* note 119, at 69.

136. *E.g.*, 1 UPCOTT, *supra* note 4, at [157] (between Curll and Charles Molloy, dated April 23 1718, for the play *The Coquet*); see also *id.* at [37], [38], [49], [102], [163].

137. *E.g.*, 2 UPCOTT, *supra* note 4, at [172] (documenting the June 12, 1723 contract between Hook and Thomas Marshall “for the Copy right of Juvenal & Persius with notes by me”). In 1724, Edmund Curll contracted with Ann Browne for her husband’s translation of a French story entitled, *The German Apothecary*. The contract conveyed “all my own right, Property and Interest to and in the following Copies” which “shall for the future be invested in the said Mr Edm: Curll, and his Assigns.” 1 UPCOTT, *supra* note 4, at [37] (dated Mar. 3, 1724/5).

138. 1 UPCOTT, *supra* note 4, at [43] (citing a contract between Watts and Colley Cibber, on September 14, 1727, for *The Provok’d Husband*, or, *A Journey to London* by Sir John Vanbrugh and Colley Cibber); see also *id.* at [29], [45], [142], [146], [148], [150], [152], [155], [159], [161], [200], [206].

their heirs and assigns equally share & share alike *for ever any Law in being now to the Contrary notwithstanding*.¹³⁹

The only law that might have been conceived as “to the Contrary” was section 11 of the Statute of Anne. Such contracts, then, without explicitly referring to any reversionary right, appear to have recognized such right, or “expectancy,” and attempted to exclude its operation. Interestingly, perhaps, this language does not appear in all the surviving documents that involve Watts in this period: some just refer to the “whole and sole right in the copy.”¹⁴⁰ This perhaps suggests a targeted use of the clause. It is also worth observing that while Watts was the first to use this device, a few other publishers used similar clauses, though they are rare after the middle of the century.¹⁴¹ Whether a court would regard such a clause as effective to nullify the author-protective effect of section 11 of the Statute must have been anything but clear.

e) Explicit Reference to the Reversionary Term

Only three surviving author-publisher documents from the first three quarters of the eighteenth century make explicit reference to the reversionary term, in each case seeking then to override its operation. All three contracts involved the poet Alexander Pope and the publisher Bernard Lintot: the first related to Pope’s agreement to translate Homer’s *Iliad* in 1713/14;¹⁴² the second, dated December 28, 1717, underpinned publication of a collection of Pope’s works that had previously been individually published by Jacob

139. *Id.* at [107] (emphasis added).

140. *Id.* at [110] (with William Havard, March 3 1732 for the “whole & sole right of the copy of a Tragedy call’d Scanderberg”); *see also id.* at [32], [41], [52], [104], [121], [126], [181], [199].

141. *Id.* at [129] (a contract dated November 25, 1735, the bookseller John Gray purchased the copyright in a play, *The London Merchant, or the History of George Barnwell*, by George Lillo (1693–1739) for £105).

142. Egerton Charters, *supra* note 117, Ch. 1288. The contract has been transcribed by James McLaverty, *The Contract for Pope’s Translation of Homer’s Iliad: An Introduction and Transcription*, 15 LIBR. 206 (1993). This one is less explicit in its reference to the Statute than the next two. Pope grants “the sole and absolute property” to Lintot

for and dureing all such time terme and termes of yeares and in as large ample and beneficiall manner to all intents and purposes as he the said Alexander Pope his Executors or Administrators or any or either of them may can might or could have use or enjoy the Same

Id.

Although there is no reference to the reversionary term as such, the document is alluding to the Statute of Anne in its reference to “such time term and *termes of years*.” *Id.* The contract purports to assign all Pope’s rights, present or future (through the language “may can might or could have”). *Id.*; *see also* FOXON, *supra* note 35, at ch. 2.

Tonson and Lintot;¹⁴³ and the third, dated February 18, 1723, related to a proposed translation of Homer's *The Odyssey*.¹⁴⁴

The second contract is the most explicit in its reference to the reversion of term in the Statute of Anne.¹⁴⁵ The document recites:

Whereas by an Act of Parliament made in the Eighth year of the reign of Her Majesty Queen Anne It is enacted that the Author of any Book or Books his Assignee or Assigns shall have the sole Liberty of Printing and Reprinting such Book or Books for the Term of fourteen years to commence from the first Day of publishing the same And that after the Expiration of the said Term of fourteen years the sole Right of printing and disposing of Copyes shall return to the Authors thereof if they are then living for another Term of fourteen¹⁴⁶

The deed purports so far as is permissible to convey both statutory terms. The rights are assigned:

for and during the Terme of fourteen years next ensuing the publication of the said book for all and every other term or terms as far as the said Alexander Pope now hath or hereafter may have any Right Power and Authority by the said Act of Parliament or otherwise to grant and sell the same.¹⁴⁷

Moreover Pope undertook, for himself, his heirs, executors and assigns, both not to sell the rights to anyone else,¹⁴⁸ and more positively, should he be alive at the end of fourteen years, to transfer the reversionary right to Lintot.¹⁴⁹

143. Egerton Charters, *supra* note 117, Ch. 129. The document is sealed, witnessed by Henry Lintot and William Fortescue and bears the signature of Lintot, but not that of Pope.

144. *Id.* Ch. 130. The contract is reproduced in GEORGE SHERBURN, *THE EARLY CAREER OF ALEXANDER POPE* 313–16 (1934). McLaverty observes that it shows “specific awareness of the Queen Anne Act.” FOXON, *supra* note 35, at 241.

145. McLaverty refers to it as “the strangest” of Pope’s agreements. FOXON, *supra* note 35, at 240.

146. Egerton Charters, *supra* note 117, Ch. 129.

147. *Id.*

148. Pope undertook that he would not at the end of the fourteenth year next after the publishing of the said book nor at any time or times whatsoever here after grant or sell the Liberty or Priviledge of printing reprinting or selling the said book or any of the poems or works therein contained (except as before excepted) to any person or persons whatsoever other than to him the said Bernard Lintott.”

Id.

149. *Id.*

These three contracts, then—uniquely amongst all those seen from before 1774—referenced the fact that the statutory assignable term was, on its face, only fourteen years. The contracts attempted to ensure that any subsequent term, statutory or otherwise, was also conveyed. At the same time they recognized that there were doubts over an author’s ability to convey the reversionary term and included language that attempted nevertheless to secure such assignment.

Much later in the century, contracts referring to the fourteen-year term make a revival. The Strahan archive contains a number of deeds, dating at least from 1780, in which the author undertakes that were they to be living at the end of fourteen years from publication, they will “assign and set over such further rights and property in and to the said work as by any Law Custom or Use the said [author] shall be entitled to do.”¹⁵⁰

f) Other Aspects of Contracts

The majority of surviving documents involved a flat fee,¹⁵¹ though the payments varied enormously in size.¹⁵² In the early decades, at least from the evidence in *The Upcott Collection*, few payments are above double figures. The first such payment was in 1727, from John Watt to Colley Cibber (1671–1757) for *The Provok’d Husband*. After the middle of the century, payments (at least at the upper end) increased significantly. David Hume received £1200 from Gavin Hamilton and John Balfour for agreeing to the publication of a single edition of his *History of Great Britain*.¹⁵³ For some time, this was regarded as the high-water mark of payment.¹⁵⁴ However, in the late 1760s, the publisher William Strahan started paying even larger sums for historical works.¹⁵⁵ In 1768, the Scottish historian William Robertson (1721–1793)

150. BL Add. Mss. 48901, *supra* note 87, fol. 20 (addressing the contract dated 1780 between Blair and Creech, Strahan & Cadell).

151. See ROBERT DODSLEY, *THE CORRESPONDENCE OF ROBERT DODSLEY 1733–1764*, at 30–34 (James Tierney ed., 1988).

152. Letter from David Garrick to Jean Baptiste Antoine Suard (Mar. 7, 1776), in David Garrick, *THE LETTERS OF DAVID GARRICK* 989 (David M. Little & George M. Kahl eds., 1963) (a dramatists “profits, with his copy-moey, have sometimes risen to 8 or 9 hundred, and sometimes a thousand pounds”).

153. DAVID HUME, *LETTERS OF DAVID HUME TO WILLIAM STRAHAN* 15, 33 (G.B. Hill ed., Oxford, Clarendon Press 1888); 2 SAMUEL JOHNSON, *JOHNSONIAN MISCELLANIES* 349 n.7 (G.B. Hill ed., 1897) (receiving £1940 for the first two volumes of the *History of England*).

154. It should be contrasted with the 60 guinea fee that John Newbery paid Oliver Goldsmith for *The Vicar of Wakefield*. See ELIZABETH E. KENT, *GOLDSMITH AND HIS BOOKSELLERS* 68 (1933); WELSH, *supra* note 87, at 58.

155. Letter from James Beattie to Sylvester Douglas (Aug. 14, 1775), in 2 *THE CORRESPONDENCE OF JAMES BEATTIE* 308–09 (Roger Robinson ed., 2004) (recognizing Strahan’s generosity).

received £3400 for his *History of Charles V*;¹⁵⁶ in 1772, William Blackstone was paid £2000 for copyright in the *Commentaries on the Laws of England* (which had been first published in 1765);¹⁵⁷ while in 1773, journalist and essayist John Hawkesworth (1720–1773) received £6000 for the *Voyages of Captain Cook*.¹⁵⁸

156. JAMES A. COCHRANE, DR JOHNSON'S PRINTER: THE LIFE OF WILLIAM STRAHAN 40 (1964); HUME, *supra* note 153, at 15 (Hill's analysis); Stewart J. Brown, *William Robertson (1721–1793) and the Scottish Enlightenment*, in WILLIAM ROBERTSON AND THE EXPANSION OF EMPIRE 7, 28 (Stewart J. Brown ed., 1997) [hereinafter ROBERTSON] (putting figure at £3500 plus another £500 if the book went into a second edition); Harlen, *supra* note 3, at 102 (putting price at £4000); Richard B. Sher, *Charles V and the Book Trade: An Episode in Enlightenment Print Culture*, in ROBERTSON, *supra*, at 164–65 (stating that “the eighteenth century equivalent of a six-figure deal, worth at least £200,000 or \$300,000 in late twentieth century British and American currencies”). For the view that Robertson was unusually successful, see Letter from Hume to Morellet (July 10, 1769), in 2 THE LETTERS OF DAVID HUME 203 (J.Y.T. Greig ed., 1934) (“the greatest price that was ever known to be given for any book”); Letter from John Douglas to Alexander Carlyle (Apr. 6, 1771) (on file with Edinburgh University Library, Dc 441 no 19), *cited in* Sher, *supra*, at 166. Sher tells us that Strahan shared the copyright with Cadell and John Balfour, and that the publishers earned something like £15,000 from the sale of five editions. *Id.* at 178. Henry Brougham had put the figure at £50,000. 1 HENRY BROUGHAM, LIVES OF MEN OF LETTERS AND SCIENCE WHO FLOURISHED IN THE TIME OF GEORGE III 210 (Kessinger Publishing 2006) (1846).

In 1759, Robertson had received £600 from Andrew Millar and Thomas Cadell for his debut book, *History of Scotland During the Reigns of Queen Mary and King James VI till His Access to the Crown of England*. Letter from Robertson to John Jardine (Apr. 20, 1759), *reprinted in* 1 BROUGHAM, *supra*, at 278–79 (“more than was ever given for any book except David Hume's”); Letter from W. Robertson to Andrew Fletcher and Lord Milton (Apr. 10 1758) (on file with Saltoun Papers, MS 16707, fol. 98–99, NLS), *cited in* Stewart J. Brown, *William Robertson (1721–1793) and the Scottish Enlightenment*, in ROBERTSON, *supra*, at 7, 19; Jeffrey Smitten, *Robertson's Letters and the Life of Writing*, in ROBERTSON, *supra*, at 36, 41; BL Add. Mss. 48800, *supra* note 87, at 107, *cited in* Harlen, *supra* note 3, at 101. According to Robertson, Strahan and Cadell made £6000 from it, though Sher indicates that Millar and Cadell made these profits, whilst Strahan benefited from the printing work. 3 BOSWELL, *supra* note 2, at 334.

In 1777, Strahan, Cadell and Boswell contracted with Robertson for rights in his *History of America*, on the same terms as *Charles V*. Harlen, *supra* note 3, at 207. Overall, Richard Sher claims Robertson's publishing income was “more than £700,000 or well over \$1 million in early twenty-first century money.” SHER, *supra* note 2, at 214.

157. Strahan nevertheless made profits from the work to the tune of £1768. BL Add. Mss. 48800, *supra* note 87, at B, and BL Add. Mss. 48889, *id.*, *cited in* Harlen, *supra* note 3, at 189.

158. JOHN HAWKESWORTH, AN ACCOUNT OF THE VOYAGES UNDERTAKEN BY THE ORDER OF HIS PRESENT MAJESTY FOR MAKING DISCOVERIES IN THE SOUTHERN HEMISPHERE (1773). Hawkesworth was appointed by the Government to write the account in 1771 and supplied with the journals of the relevant ships, but was permitted to retain “the property of the work.” *Id.* He sold this to Strahan and Cadell (in preference to Thomas Becket, seemingly at the cost of Hawkesworth's friendship with David Garrick). 2 BOSWELL, *supra* note 2, at 247 n.5; JOHNSON, *supra* note 153, at 349; JOHN LAWRENCE ABBOTT, JOHN HAWKESWORTH: EIGHTEENTH-CENTURY MAN OF LETTERS 147 (1982) (stating that this

The historian Edward Gibbon was paid £726 by William Strahan and Thomas Cadell for the right to publish the first edition of his *Decline and Fall of the Roman Empire* in 1776, the publishers only finally securing the copyright in the first three volumes, for £4000, in 1780; and, the final three volumes, in 1787, for the same sum.¹⁵⁹ These payments were, of course, for tried-and-tested authors. Many contracts offered the writer a fee based on the number of sheets in the published volume.¹⁶⁰ The rates varied, but the eventual income was not always insignificant: Tobias Smollett, for example, who was paid by publisher James Rivington at a rate of three guineas per sheet, may have received over £1000 for his four-volume *A Complete History of England*.¹⁶¹

Many contracts included an entitlement to copies of the printed book,¹⁶² and in some cases these could be quite valuable. The agreement between the poet Alexander Pope and his publisher Bernard Lintot on March 23, 1713(/14), whereby Pope undertook to translate Homer's *The Iliad* into

was "the largest payment of its kind during the whole of the century"). According to Abbott, Strahan complained to Hume that he had overpaid. Letter from Strahan to Hume (Apr. 9, 1774), in HUME, *supra* note 153, at 283–84 (noting that "the event of which purchase, if it does not cure Authors of their delirium, I am sure will have the proper effect upon booksellers"); see Letter from Hawkesworth to Garrick (May 6, 1773), BL Add Ms 28, 104 fol. 45–46, reprinted in DAVID GARRICK, *THE PRIVATE CORRESPONDENCE OF DAVID GARRICK WITH THE MOST CELEBRATED PERSONS OF HIS TIME* 535 (James Boaden ed., London, Colburn & Bentley 1831).

159. EDWARD GIBBON, *THE MEMOIRS AND LIFE OF EDWARD GIBBON* 194–95; SHER, *supra* note 2, at 259 n.161 (Gibbon received over £9000 for *The Decline and Fall*); BL Add. Mss. 44805 "G" and BL Add. Mss. 48809, at 49, cited in Harlen, *supra* note 3, at 203–04; Letter from E. Gibbon to T. Cadell (Dec. 16, 1786 & Feb. 24, 1787), in EDWARD GIBBON, 3 *THE LETTERS OF EDWARD GIBBON* (J.E. Norton ed., 1956) [hereinafter GIBBON LETTERS] (commenting on the fact "that so important a transaction will have been concluded in the first instance by three minutes of conversation, and in the second by three lines of a letter, a memorable example in the annals of authors and booksellers"); BL Add. Mss. 34887, at 5, 10.

160. See, e.g., the following contracts entered by bookseller Robert Dodsley: BL Eg. Mss. 738, *supra* note 87, fol. 2 (June 3, 1744 with Henry Baker for *A Treatise on Microscopes*, 1 guinea per sheet), fol. 4 (August 22, 1743 with Henry Baker for *An Attempt Towards A Natural History of the Polype* at 2 guineas a sheet), fol. 4 (October 15, 1748 with John Campbell for *The Geography, Natural History and Antiquities of England & Wales* at 2 guineas a sheet); fol. 6 (with Will Duncan for translation of Caesar's Commentaries at £111s and 6d per printed sheet), fol. 8 (August 22, 1749 with Thomas Salmon of Temple for *The Tradesman's Dictionary* at 1.5 guineas/sheet); SHER, *supra* note 2, at 215 (speculating that Duncan must have realized several hundred pounds from his dealing with Dodsley).

161. SHER, *supra* note 2, at 215.

162. E.g., 1 UPCOTT, *supra* note 4, at [188] (between Curll and Robert Samber, dated February 20, 1723 whereby Samber received 4 Guineas and 12 copies); see also SHER, *supra* note 2, at 220 (describing William Buchan's arrangement with publishers Cadell, Strahan, Creech and Balfour, under which Buchan was to receive £50 or 100 copies of any new edition of *Domestic Medicine*).

English (to be published in six volumes), gave Pope a fee of £1290 (200 guineas per volume), as well as 750 copies of each volume which Pope intended to sell by subscription.¹⁶³ Lintot was to allow Pope one month in which he could dispose of the copies free of any competition, whereafter Lintot could print and sell the work. Pope made a fortune from the deal.¹⁶⁴ Another example is the contract between the publishers Thomas Longman, John Nourse and Dr. William Lewis (1708–1781), dated January 16, 1746. Lewis would prepare a book *A New English Dispensatory* in which the booksellers would gain copyright, in return for which Lewis would receive £105 and one hundred copies.¹⁶⁵ Four years later, Nourse entered an agreement to publish a work by James Dodson (d. 1757) entitled *The Accountant Method of Bookkeeping*, paying £12 and 12 shilling and “fifty printed copies” for the copyright.¹⁶⁶ William Robertson, the historian, said he chose to publish his history of *Charles V* with Strahan rather than Becket, who had been recommended by Garrick, in part because Strahan included in the arrangement twenty-five copies, worth £75.¹⁶⁷ Similarly, the 1774 contract between Captain Phipps and bookseller John Nourse relating to Phipps’ voyages involved a payment of £200 and “as many copies for [sic] in sheets as he shall want not exceeding eighty.”¹⁶⁸

163. COCHRANE, *supra* note 156, at 39; MAYNARD MACK, ALEXANDER POPE: A LIFE 267, *passim* (1985). The agreement was varied by the parties by a deed dated February 10, 1715, in relation to the second edition: Lintot was entitled to the subscription money on the 750 copies, in return for giving Pope a lump sum of £200 (over and above the contractual 200 guineas for the second volume). See BL Eg. Mss. 1951, fol. 3 (witnessed by William Waters and John Dighton).

164. According to Peter Quennell the contract “laid the foundations of a modest personal fortune” for Pope. PETER QUENNEL, ALEXANDER POPE: THE EDUCATION OF GENIUS 1688–1728, at 99 (1968). The contract turned out to be an unfortunate one for Lintot, and he even considered a legal action with a view to extricating himself from it. REGINALD H. GRIFFITH, ALEXANDER POPE: A BIBLIOGRAPHY 41–42, 121–22 (1922); WILLIAM WARBURTON & JOHN KNAPTON, POPE’S LITERARY LEGACY: THE BOOK-TRADE CORRESPONDENCE OF WILLIAM WARBURTON AND KNAPTON WITH OTHER LETTERS AND DOCUMENTS, 1744–1780, at lv (Donald W. Nichol ed., 1992).

165. 2 UPCOTT, *supra* note 4, at [152]. The work went into numerous editions, with Nourse reprinting the 1753 work in 1765 (“second edition with large additions”), 1770, 1781, 1785 (a fifth edition carefully revised and improved after the authors death), and Nourse’s successor adding a further edition in 1799. *Id.*

166. 2 UPCOTT, *supra* note 4, at [80]. The ESTC, *supra* note 96, contains only one edition published by Nourse in 1750 under the title *The Accountant*. See 2 UPCOTT, *supra* note 4, at [53], [81], [82].

167. GARRICK, *supra* note 158, at 535.

168. 1 UPCOTT, *supra* note 4, at [177].

Sometimes, an additional fee was paid to the author on the sale of a specified number of copies,¹⁶⁹ or on a reprinting.¹⁷⁰ In one agreement, dated May 1, 1752, between the bookseller Joseph Pole, and the surgeon George Aylett, relating to *The Gentleman's Farriery or Treatise on the Diseases of Horses*, the latter assigned copyright for £10, with a further sum of £10 payable once 750 copies were sold, with a further proviso that:

[I]f the said Book come to a second or third Impression Seven hundred & Fifty copies & no more to be printed of the first & second edition of the said book, the said Geo Aylett is to receive the like sum of Ten pounds in books in manner as above mentioned for his Receiving & Allowing each of the said second and third edition the Copy right of the said Book on the [?] of these Conditions being and recognising at all times the sole Right and Property of the said Jos Pole his Executors etc.¹⁷¹

Frequently, provision for further payment was conditional upon the author updating the work for issuance as a second edition. An example is an agreement dated July 23, 1753 between William Lewis and publisher John Nourse relating to Lewis's two volume treatise, *New Practice of Physick*. Lewis agreed to "assign over the Copy right of the said Work" to Nourse for £157, with Nourse agreeing "to pay to W. Lewis thirty one pound ten shillings, in case he shall print a second edition of the above mentioned work, twenty one pound upon a third seventy one pound upon a fourth edition. Each edition to consist of one thousand copies."¹⁷²

In some circumstances, an early form of the "out of print" clause appears with the author purporting to retain rights to reprint the work should the bookseller choose not to issue a second edition. For example, on June 3,

169. See, e.g., 1 UPCOTT, *supra* note 4, at [157], [198]; 2 UPCOTT, *supra* note 4, at [12].

170. See, e.g., 1 UPCOTT, *supra* note 4, at [38], [125], [147], [183]; 2 UPCOTT, *supra* note 4, at [54], [55], [132], [161], [164], [197], [206], [208], [231]; BL Eg. Mss. 738, *supra* note 87, fol. 2 (June 3, 1744 between Henry Baker and Robert Dodsley, *A Treatise on Microscopes*, whereby Baker was to receive 1 guinea/sheet on a first edition of 1000 copies, and half a guinea/sheet on each subsequent edition of 1000), fol. 3 (August 22, 1743 between Henry Baker and Robert Dodsley relating to *An Attempt Towards A Natural History of the Polype*, whereby Baker was to receive 5 guineas for each new impression), fol. 6 (between Dodsley and Will Duncan for his translation of *Caesar's Commentaries* according to which Duncan was to receive 10 shillings & 6d per sheet for a second edition). Where such arrangements did not specify the size of an edition, publishers may have been tempted to print greater umbers than normal. See SHER, *supra* note 2, at 220 (describing very large editions of William Buchan's *Domestic Medicine*).

171. 2 UPCOTT, *supra* note 4, at [12]; see also *id.* at [54], [164].

172. *Id.* at [161]; see also *id.* at [26] (relating to a June 15, 1734 payment from Francis Cogan and John Nourse to Theodore Barlow for revising *Parish-Lan*).

1744, the publisher Robert Dodsley agreed to publish Henry Baker's *A Treatise on Microscopes*.¹⁷³ Their contract purported to transfer the copyright "for ever more," with Baker to receive a payment on any new edition.¹⁷⁴ The contract went on to provide that:

[I]n case the said Robert Dodsley shall not reprint the same within two years next after the Sale of the books of the first impression Then the Sole Property of the said Copy or Treatise shall at the Expiration of such Two years revert to and be reinvested in the said Henry Baker his Executors Administrators or Assigns and upon being paid by him or them one half of the charge that he the said Robert Dodsley shall have been at for the said Copper plates and engraving thereof reassign the said Book and Plates to him or them and all the property and Interest of the said Robert Dodsley in and to the same.¹⁷⁵

Thirty years later, in 1774, Captain Constantine John Phipps (later Lord Mulgrave) (1744–1792) agreed that John Nourse should publish the *Voyage towards the North Pole*, allowing Nourse "to make an impression of 1500 copies at his own risque & charges upon such paper & type as shall be approved of" and giving him a right of printing a second Edition "in all respects equal to the first edition."¹⁷⁶ Phipps also specified that "[i]f upon the first Impression being out of print or rising in price & J. Nourse declines to publish a second Edition Captain Phipps reserves to himself a power of giving to any other person such 2nd Edition."¹⁷⁷

Occasionally, a contract provided for profit-sharing between author and publisher,¹⁷⁸ or involved assignment of only a portion of the copyright.¹⁷⁹ A

173. BL Eg. Mss. 738, *supra* note 87, fol. 2.

174. *Id.*

175. *Id.*

176. 1 UPCOTT, *supra* note 4, at [177]. According to the ESTC, *supra* note 96, a 1774 edition was issued not by Nourse but by F. Newbery. *See also* Memorandum between Adam Ferguson and Strahan, Cadell & Creech, (Feb. 28, 1782) (on file with CE French Papers, Massachusetts Historical Society), *reprinted in* 2 FERGUSON, *supra* note 88, at 576 (according to which Ferguson was obliged to purchase copies that were unsold after eighteen months and, on so doing, the publishers would "reassign the Copy Right").

177. *Id.*

178. 2 UPCOTT, *supra* note 4, at [23], [120], [150]; *see also* SHER, *supra* note 2, at 236; R.B. Sher, *New Light on the Publication and Reception of The Wealth of Nations*, 1 ADAM SMITH REV. 3, 3–29 (2004); Letter from SHER, *supra* note 2, at 236; Adam Smith to William Strahan (Nov. 13, 1776), *in* ADAM SMITH, CORRESPONDENCE OF ADAM SMITH 221 (1776) (Letter No. 179); Letter from William Strahan to Adam Smith (Nov. 26, 1776), *in* SMITH, *supra*, at 222 (Letter No. 180).

good example is the agreement made on September 18, 1747 between Abraham Le Moine (d. 1757), writer of *A Treatise on Miracles*, and John Nourse. The agreement recounted that Nourse had printed 750 copies at his own expense, and undertook that once those expenses had been paid “the Profits arising from the sale of the remaining Copies are to be equally divided between the two said Parties.”¹⁸⁰ Another, dated October 30, 1800, between Rev. John Farrer (1735–1808) and J. and G. Rivington, relating to a volume of *Sermons on the Parables* gave the Rivingtons “one half of the copy right” and required them to print 750 copies and pay Farrer half the profits on the sale of those copies (and any subsequent impressions).¹⁸¹

2. *How Was the Reversion Understood?*

Given the wide variation in contractual provisions that we have identified, a key question arises as to how these clauses would have been understood as affecting the reversion right. Was the reversionary term seen as overriding contractual attempts to assign the copyright or not? Or was the second term assignable? If so, in what circumstances? It is only with an understanding both of contractual practice and law (or perception of law) that we can assess whether section 11 secured any benefits for authors during the eighteenth century. However, prior to the decision of the Court of Chancery in *Millar & Dodsley v. Taylor* in 1765 there are no clear answers to these questions. Even after that date, and after further court decisions in the 1780s confirming the assignability of the reversion, the legal requirements that needed to be satisfied remained largely a matter of conjecture. Throughout the eighteenth century, there was little discussion of the question of the assignability of the reversion in the few textbooks and commentaries. Our sources comprise a few brief letters, notes, and the contracts themselves. Moreover, even though the Statute of Anne was applicable throughout Britain, for much of the eighteenth century different answers were given to these questions in Scotland as opposed to England.¹⁸²

179. 2 UPCOTT, *supra* note 4, at [31] (discussing a sale by Alexander Blackwell to John Nourse, dated September 28, 1737, of one third share in a book created by his wife, Elizabeth); *see also id.* at [35], [38].

180. *Id.* at [150]. The ESTC, *supra* note 96, refers to one edition published by Nourse in 1747.

181. 2 UPCOTT, *supra* note 4, at [120].

182. *See* DEAZLEY, *supra* note 19, at 182 (discussing the Act of Union 1707, and the question of common law rights), 189 (“The legal plurality of a politically united British state allowed for legitimisation of two fundamentally opposed concepts of copyright, one in the north and one in the south.”).

a) 1710–1765: A Plurality of Interpretations

In the period before 1765, there were at least three interpretations of the law: first, that the reversion was personal and non-assignable; second, that it was assignable, but this required some indication of an explicit intention to do so and, possibly, the use of a deed; third, that the reversion was subsumed within, and assignable along with, the perpetual common law right.

The view that the reversion was not assignable at all seems to have widest recognition in Scotland.¹⁸³ A letter from Ronald Crawford to George Ross, dated November 28, 1754, discussing whether Robert Foulis, a Scottish publisher, had infringed rights in Pope's works, argued that in relation to work in which a second term of fourteen years had begun to run before Pope's death, no action could be brought.¹⁸⁴ Crawford explained that "yet I have a doubt If on his Death, such Privilege is assignable for what part of the 2d term may be then to run. It seems to be only personal, to the Author himself, but not to his Executors or Assigns."¹⁸⁵ Crawford's legal opinion thus suggests that the second term itself was personal and not assignable. The basis for such a claim was the close, textual reading of the Statute of Anne. The section granting the initial term described the right that was conferred on authors or their assignees as "the sole liberty of printing and reprinting such *book*,"¹⁸⁶ whereas the clause granting the reversionary term to authors related to "the sole right of printing or disposing of *copies*."¹⁸⁷ Crawford, it seems, was arguing that the different descriptions of the beneficiaries ("authors or their assignees" v. "authors") and objects ("books" and "copies") implied different interests, in particular, that the reversion gave only a personal right, not a proprietary one. Therefore, it appeared, on a technical reading of the statute, that the right was non-assignable *even after* the right fell into possession. This view certainly had some circulation in

183. A similar doubt appears to have existed in the mind of the author of Pope's contracts with Lintot. This transferred rights for "as long as the said Alexander Pope hath any right power and authority by the said Act of Parliament or otherwise to grant or sell the same" and added a promise, were the immediate transfer not effective, on Lintot's request, to "without further Consideration or Reward whatsoever . . . make any new or further grant of the said Book and the Poems and . . . for and during another Term of fourteen years and for and during all and every other Term or Terms *as far as the said Alexander Pope hath any Right power and authority by the said Act of Parliament or other wise to grant or sell the same.*" (emphasis added). See sources cited *supra* note 117.

184. Letter from Ronald Crawford to George Ross (Nov. 28, 1754), BL Eg. Mss. 1959, fols. 23–24, reproduced in WARBURTON & KNAPTON, *supra* note 164, at 102.

185. *Id.*

186. Statute of Anne, 8 Ann., c. 19, § 1 (1710) (Gr. Brit.) (emphasis added).

187. *Id.* § 11 (emphasis added).

Scotland, but ultimately fell to be rejected by the Court of Session in *Cadell v. Anderson* (1787).

A second view was that the reversionary term was assignable, but only by way of express terms in a deed (that is, a promise under seal). This seems to have been the view of Alexander Pope, decipherable from a note scribbled on the back of a letter:

I never alienated, intentionally, any Copy for ever, without expressly giving a Deed in forms, to witness & that the Copy right was to subsist after the Expiration of the 14 years in Queen Ann's Act, which then was understood generally to be the [c]ase, unless covenanted to the Contrary.¹⁸⁸

Although somewhat ambiguous, Pope seems to imply that it was generally understood that a “deed” or “covenant” was required to establish that the purported transferee was vested with the whole copyright, the contingent interest otherwise reverting to the author. While the Statute of Anne said nothing about a deed, Pope's views might have reflected provisions in some royal privileges requiring that consent be by deed, or the fact that famous contracts from before the Statute, most notably that between Milton and Simmons, were by deed. Whatever the reason, Pope was of the view that a number of his works that had been printed by Jacob Tonson Junior, and had been published in 1712 and 1714, had reverted to him in 1726 and 1728: “the property is therefore reverted to Me from that time, unless I covenanted to the contrary; which will appear by the writing I gave. & by which I am ready to be determined.”¹⁸⁹ Although he acknowledged that he could not recollect the details of the transactions, Pope was convinced that he had not alienated the reversion to Tonson, “because the Mony I receivd was a very trifling Sum, no way proportioned to a Perpetuity.”¹⁹⁰

If Pope's understanding of the interaction of section 11 of the Statute of Anne and contractual practice was widely held, then Ransom's claim that the

188. BL Eg. Mss. 1951, *supra* note 163, fols. 17, 18, 19; ALEXANDER POPE, THE CORRESPONDENCE OF ALEXANDER POPE 222–24 (George Sherburn ed., 1956). McLaverty says the note reveals “a fiercely protective attitude to literary property and a close knowledge of the legislation.” FOXON, *supra* note 35, at 238.

189. POPE, *supra* note 188, at 223.

190. *Id.* at 224. Given what went before (in particular, Pope's observation that books published prior to 1710 were now “no man's property but common” suggesting that Pope thought that the statutory terms governed), this reference to “perpetuity” was probably not an indication that he believed (as some booksellers did) that there was a “perpetual” common law right, but rather, merely, that he could, and had in some circumstances, transferred the potentially twenty-eight year term in full.

reversionary right was useless because of the continued practice of assignment in perpetuity looks particularly dubious. If a deed were really required to assign the reversionary term, very few of the surviving documents—maybe one in ten—would have actually been effective to do so. However, Pope's view may have been idiosyncratic or unusually well-informed. Or, his view may have prevailed in the period from 1710 to 1740, only to be replaced by a more flexible view. The contractual practice revealed by *The Upcott Collection* can be interpreted as reflecting such a change in understanding after 1740.

The third view was that the reversion was assignable. This was held by Pope's literary executor, William Warburton. Warburton was one of the first to resuscitate the claim to perpetual copyright (which some of the booksellers had themselves claimed before 1710).¹⁹¹ As is well known,¹⁹² Warburton published in 1747 *A Letter from an Author to a Member of Parliament Concerning Literary Property*, developing from first principles an argument in support of "the right of property in AUTHORS to their works."¹⁹³ The same argument was simultaneously being made (albeit inconclusively) in an action in Scotland against some Scottish reprinters,¹⁹⁴ and was echoed fifteen years later by the author of *A Vindication of the Rights of Authors* (1762) in parallel with another inconclusive action in England.¹⁹⁵ In practice Warburton acted as many booksellers did, as if the statutory terms meant nothing. Not insignificantly, this practice extended to acts that were not self-serving. For example, Warburton gave shares in the 1751 edition of Pope's works to Tonson and Lintot, even though the statutory twenty-eight-year terms in works in which they had any interest (all published before 1723) would have lapsed. In a letter to Mercy Dodderidge, in 1759, he explained, "If the work

191. Jacob Tonson the Elder, the leading publisher in the reign of Queen Anne, held such views before the enactment of the statute, but may well have concluded that the Statute replaced the common law. See Gómez-Arostegui, *supra* note 15.

192. Warburton's authorship has sometimes been questioned. See, e.g., INFORMATION FOR ALEXANDER DONALDSON, *supra* note 38, at 66. But, it is clear from his letter to Knapton, on August 26, 1747, BL Eg. Mss. 1954, *supra* note 87, fol. 1, in WARBURTON & KNAPTON, *supra* note 164, at 13.

193. WILLIAM WARBURTON, A LETTER FROM AN AUTHOR TO A MEMBER OF PARLIAMENT, CONCERNING LITERARY PROPERTY (1747).

194. *Midwinter v. Hamilton* (1743–48) and *Millar v. Kincaid* (1749–51) BL 18th century reel, 4065/03, 04. The litigation is explained in DEAZLEY, *supra* note 19, at ch. 5(1).

195. VINDICATION, *supra* note 2. The parallel litigation was *Tonson v. Collins*, which is described in DEAZLEY, *supra* note 19, at ch. 5(2).

was written within fourteen years, the property is secured by Act of Parliament; when that time elapsed, it is then claimed by common law.”¹⁹⁶

The reversionary term seems to have made no impression on Warburton’s consciousness. For those educated to believe in common law copyright, the terms of the contract, rather than section 11 of the Statute, may have been believed to govern the mutual rights of authors and publishers. According to Boswell, writing in 1763, “it has always been understood by the trade, that he who buys the copy-right of a book from another, obtains a perpetual property; and upon that belief, numberless bargains are made to transfer that property after the expiration of the statutory term.”¹⁹⁷

b) *Millar & Dodsley v. Taylor* (1765): The First Ruling on Assignability

The first legal ruling on the reversion right issued from the Court of Chancery in the mid-1760s in the suit *Millar & Dodsley v. Taylor*.¹⁹⁸ The case involved Edward Young’s poem *The Complaint or Night-Thoughts on Life, Death and Immortality*. A work of nine parts, *The Complaint* had been published in stages during the 1740s, and two publishers Andrew Millar and James Dodsley sought in 1763 first to prevent Alexander Donaldson, the Edinburgh and London publisher, from reprinting, and Robert Taylor, who operated in the south west of England,¹⁹⁹ from selling the book.²⁰⁰ Although

196. Letter from Warburton to Mercy Dodderidge (Mar. 8, 1759) (on file with Historical Society of Pennsylvania, Dreer Collection); Letter from Robert Foulis to William Murray (Dec. 20, 1754), BL Eg. Mss. 1959, *supra* note 184, fol. 20, in WARBURTON & KNAPTON, *supra* note 164, at 105.

197. 1 BOSWELL, *supra* note 2, at 437 (entry for July 20, 1763). According to Boswell, Johnson stated that “the term of fourteen years is too short; it should be sixty years.” *Id.*

198. *Millar & Dodsley v. Taylor*, C33/426 (Ch. 1765). The case was never reported, and the following account is based on the original court documents held at the National Archive at Kew.

199. C111/166 (May 5, 1766) (explaining he sold copies in Bristol, Exeter, Taunton, Salisbury and Bridgewater).

200. The Bill of complaint by Millar against Donaldson, dated May 2, 1763, is C12/515/13. We are grateful to Tomás Gómez-Arostegui for supplying us with a copy of this. Affidavits were lodged in relation to the action against Donaldson by Millar, Dodsley & William Nicoll, the latter of St. Pauls Churchyard, and dated May 2, 1763. Nicoll attested to having purchased a copy of *The Complaint*, printed by Donaldson & Reid in Edinburgh in 1761, from Donaldson for two shillings and six pence. *See* C31/148, 270. An interim injunction was awarded on May 3, 1763. C33/420 at 244. The Answer, dated May 9, 1763, is located at C12/405/18. Significantly, perhaps, Donaldson’s demurrer was argued successfully, and the injunction was dissolved by a provisional order on March 18, 1766, made absolute on April 24, 1766. C33/426 at 158, 245. An order was made permitting amendment of the plaintiff’s complaint on June 7, 1766, but it is not clear that the matter was pursued any further. C33/426 at 383.

Donaldson entered a general demurrer, Taylor did not deny selling the work, 150 copies of which he had acquired from Donaldson. Instead, Taylor explained that Donaldson had “informed . . . [him] . . . that the said doctor Young had never sold or assigned the copy right of the said Poems but was pleased with every person who published the same for the public and general benefit of mankind”²⁰¹ In addition to asserting his ignorance as to Millar and Dodsley’s title, Taylor asserted that neither Dodsley nor Millar had any subsisting interest in the poem, the first fourteen years having lapsed. In essence, Taylor did not deny the illegitimacy of his acts, but rather the right of the claimants to object: if anyone was to bring such an action, Taylor argued, it was Edward Young himself. The defendant:

humbly insists and is advised that the Authors of Books of genius and Compositions of the Brain or the assignees have not vested in them by law a perpetual indefinite right or property to the Copies of such Books but that the sole liberty given to Authors or their Assigns of Printing or reprinting such Books is limited are restrained to the Term of ffourteen Years with this exception that in case the Author of such Book be living after the Expiration of such Term of ffourteen years the sole Right of printing and disposing of Copies of such Books reverts and returns to them for another Term of ffourteen years and this Defendant humbly insists with great submission to the Judgment of honourable Court that the Sale and Assignment of the Books set forth in the Bill (if any such there was) was not good and valid in law for any greater or longer term than ffourteen Years And also humbly insists that the Term of ffourteen years which commenced from the first publication of the said Books being some time since expired and the said Doctor Young being the Author thereof being still alive (as this Defendant believes) the sole property of printing and disposing of the Copies did return to and is now vested in the said Dr Edward Young and him only clean and discharged from the

The Bill against Robert Taylor, dated May 31, 1763 is C 12/517/43 m.1. Affidavits were supplied by Millar, dated May 25, 1763, and James Easton, dated May 26, 1763. Millar attested to his and Dodsley’s joint title, while Easton, of Salisbury in Wiltshire, gave evidence that he had purchased a copy of *The Complaint*, printed by Donaldson & Reid in Edinburgh in 1761, from Taylor for two shillings and seven pence on May 20, 1763. See C31/148 at 254, 275. After an ex parte hearing at which the plaintiff was represented by the Attorney General, an interim injunction was awarded on June 3, 1763. C33/420 at 307. Taylor’s answer was much slower in coming, dated February 1, 1764. C12/517/43 m.2. The Answer was taken by Jacob Kirbey and John Lean on February 1, 1764, at the Fountain Tavern in Bristol. Further orders, for Taylor to produce witnesses or show cause to why publication should not pass, were made on May 11, 1765 and June 7, 1765. C33/424 at 226, 299.

For the best published account, see DEAZLEY, *supra* note 19, at 172–73.

201. C12/517/43 m.2.

original Sale and unaffected by any mesne assignment of the right of printing such Books. . . . And this Defedant humbly insists upon and hopes he shall have the benefit of the Act of the Eighth of Queen Anne ch. 8 . . . in like manner as if he had pleaded the same to the Complainant's Bill of Complaint. . . .²⁰²

The Master of the Rolls, Thomas Sewell, reviewed the evidence and granted an injunction. Examining the contracts, the Court found that the first five parts had been published in 1743 by Robert Dodsley, who had purchased for £168 “the sole right to him and his heirs forever of the Copy.”²⁰³ Dodsley had also purchased “the sole right of Printing” the sixth part in January 1744, Young giving a written receipt for £52.²⁰⁴ The rights in the remaining three parts were purchased in 1749 by Andrew Millar, for £63, in a deed which conveyed “all that the said Edward Young's sole right and property in and to” the second volume of the work “forever.”²⁰⁵ When Robert Dodsley gave up business as a publisher in 1759, rights in Young's work had been transferred to James Dodsley, and thus he and Millar controlled the rights to the work jointly. Following “debate of the matter,” the Master of the Rolls affirmed the grant of an injunction:

to stay the defendant from printing, publishing and vending the Books in question . . . for the remainder of the two terms of fourteen years and fourteen years during which the said Doctor Young as Author of the said Work and the Plaintiffs as standing in his place had a right to the sole printing publishing and vending of the said Books.²⁰⁶

Moreover, the Master of the Rolls referred the calculation of an account of profits to the Master.²⁰⁷

The decision thus indicates that the Court regarded the reversionary term as transferrable, and, indeed, that an agreement to transfer the reversionary

202. *Id.*

203. C33/426.

204. The receipt is contained in the Houghton Library, Harvard University, and is reproduced in EDWARD YOUNG, THE CORRESPONDENCE OF EDWARD YOUNG 597 (Henry Pettit ed., 1971).

205. *Id.* at 598.

206. C33/426.

207. In his response to interrogatories, Taylor persisted in his claim that he had only sold 150 copies, and that he had gained these in exchange for certain other books (Milton's *Paradise Lost* and *Paradise Regained*, Bunyan's *Pilgrims Progress*) which he gave Donaldson. Taylor argued that he made, at most six pence on each sale, so that the profits for which he should account were a measly £315 shillings. C111/166 (May 5, 1766).

term could be entered into prior to the vesting of that term.²⁰⁸ Thus Ronan Crawford's view, that the reversion created a purely personal right, was rejected. Although the reasoning remains unknown, the holding highlights the limitations of the statutory approach. By conceptualizing the author-protective measure in proprietary terms, in 1710 Parliament placed the right within the more general logic of property. One aspect of that logic was, and remains, that property rights are typically assignable.

Moreover, it is an irresistible conclusion from the facts of the case that the Court considered that it was unnecessary to refer explicitly to the reversionary interest or to attempt to override the effect of section 11 through some sort of exclusion clause (such as that pioneered by John Watts). Beyond that, however, it is difficult to draw any precise conclusions as to what the court regarded as *necessary* to assign the reversionary term. Although Dodsley was relying on rather rudimentary documentation, the holding does not imply that this was, of itself, sufficient to transfer the reversionary term. This is because the Court would have been able to base its conclusion that an injunction should be granted on the rights in the final three parts of *The Complaint*, which Millar had secured by way of a deed. All we can be certain of is that a deed in that form was sufficient to transfer the reversion, at least where the dispute was between the alleged transferee and a third party (rather than between the alleged transferee and the intended beneficiary of the statutory reversion, the author).

c) 1765–1774: Common Law Copyright and the Redundancy of the Reversion Right

The 1765 *Millar & Dodsley v. Taylor* decision, significant as it looks in retrospect, seems to have attracted little attention at the time, for booksellers and authors were consumed by a much more significant question: that of common law copyright. Following the 1762 action in *Tonson v. Collins*, which had been dismissed on the basis that the defendant's fees were in fact being paid by the claimant, the issue of an author's rights at common law had been fully argued but lay tantalisingly unresolved.²⁰⁹ The eyes of the booksellers

208. One question mark must have hung over the decision: how could Taylor, the seller, be liable if Donaldson, the publisher, was not? *See supra* note 200.

209. *Tonson v. Collins*, (1762) 96 Eng. Rep. 108. Perhaps the arguments in *Tonson* also informed Millar and Dodsley's decision to pursue Taylor and Donaldson over Young's work. Joseph Yates, counsel for Collins, had argued that there could be no perpetual right in the author on the basis that it was inconsistent with section 11: "The Limitation of Time is still farther proof of the same: It commences at a future day; It endures for fourteen years; if the author be living, the right returns to him for fourteen years more. Why only fourteen? Why not to his Representatives, as well as himself?" *Id.*

and authors were thus, from 1763, firmly fixed on the other *Millar v. Taylor*, the case involving James Thomson's *The Seasons*. When the Court of King's Bench held in 1769 that an author, and his assigns, had a perpetual copyright at common law, the limitations that Parliament had imposed on copyright through the Statute of Anne, including the reversionary right, were implicitly redundant.²¹⁰ A common law right existed that, like any other, was assignable in full. Indeed, the common law right in that case may have arisen in Thomson's *The Seasons* as a result of his original efforts, but the action was brought by Andrew Millar, who had himself acquired the rights in three of the four poems from Thomson's original publisher, John Millan. The original agreement between Thomson and Millan was embodied in a written receipt, dated July 18, 1728, purporting to confer on Millan "the intire Right and Property . . . for ever."²¹¹ The recognition of the common law right, then, not only undermined the "reversion,"²¹² but may have also resolved the uncertainty that clearly existed over the precise form and content of an assignment. Absent special regulation, common law property in "copies" was assignable like any other property.²¹³

d) 1774–1785: Attention Returns to the Statute of Anne

Common law copyright, however, did not survive for long. On February 22, 1774, in the great case of *Donaldson v. Beckett*,²¹⁴ the House of Lords held that once a work was published, the existence of copyright depended solely on the terms of the Statute of Anne. The decision thus clarified the existence of a legal public domain of books in which copyright had lapsed and in

210. *Millar v. Taylor*, (1769) 98 Eng. Rep. 201.

211. The original receipt is in the Houghton Library, Harvard University, but is reproduced in THOMSON, *supra* note 119, at 63. Millan's assignment of the rights to Millar also survives and is reproduced *id.* at 120.

212. Indeed, for this reason, several members of the Scottish Court of Session declined to follow the King's Bench ruling: Lord Kennet said that the reversionary provision "would have been absurd, if authors were understood to have that sole right *ab antè*" while the Lord President said the reversion was "proof that no previous right was understood to exist." THE DECISION OF THE COURT OF SESSION UPON THE QUESTION OF LITERARY PROPERTY IN THE CAUSE OF JOHN HINTON, LONDON, BOOKSELLER AGAINST ALEXANDER DONALDSON AND JOHN WOOD, BOOKSELLER OF EDINBURGH AND JAMES MEUROSE, BOOKSELLER, KILMARNOCK 2, 36 (James Boswell pub., 1774).

213. That said, Andrew Millar's claim in the 1769 case would not have been affected had the courts required a deed. This is because he had acquired the "sole and exclusive property and right of printing" in the fourth poem, *Spring*, by way of a deed, attested by two witnesses, on January 16, 1729/30. The original is in the Houghton Library, Harvard University, and is reproduced in THOMSON, *supra* note 119, at 69.

214. (1774) 98 Eng. Rep. 257; COBBETT'S, *supra* note 84, at 993, *passim*.

relation to which legitimate competition could exist.²¹⁵ At the same time, the decision re-focused attention (of English publishers and authors) on the bifurcated, contingent, term, and, in turn, the issue of assignability. Reporting on the decision, the *Annual Register* observed:

The English booksellers have now no other security in future for any literary purchases they make but the statute of the 8th of Queen Anne, which secures to author's assigns an exclusive property for 14 years, to revert again to the author and vest in him for 14 years more.²¹⁶

After 1774,²¹⁷ publishers' concern with, and authors' consciousness of, the reversion increased.²¹⁸ David Hume, for example, offered to assign to his publisher, William Strahan, copyright in the revisions of his works, in order to extend the term:

As to my writings, I think it will be possible for me to prolong your lease of them, even according to the Statute. I have never made a new edition without Alterations, and even Additions, sometimes of a considerable length. If it were thought worth while, I could transfer you anew the Property of these; and if Nobody can reprint

215. But, the London booksellers continued to protect themselves by "honorary copyright." 3 BOSWELL, *supra* note 2, at 370; Harlen, *supra* note 3, at 198.

216. *Annual Register*, XVII.i.95, *quoted in* 2 JOHNSON, *supra* note 153, at 443.

217. Letters between David Hume and publisher William Strahan indicate that the latter did not think the decision in Donaldson would or should affect the prices paid to authors for copyright. Writing on April 2, 1774, Hume suggested that the decision would not alter publishers' practices because they could, as previously, operate "a tacite Convention among" themselves. Strahan replied on April 9 that he would "not take into account the present uncertain state of literary property in general" because the "simple question" of remuneration turned on how many copies a book would sell at a particular price "in a few years." HUME, *supra* note 153, at 80, 283–84. Contrast the views of James Beattie in a letter to Edward Dilly, March 29, 1774, who described the decision as one "attended with bad consequences not to Booksellers only, but to authors also, and to Literature in general" and also in a letter to Thomas Blacklock, dated May 23, 1774 (discussing apparent rejection of Blacklock's book by the bookseller Davis), *in* 2 BEATTIE, *supra* note 155, at 261 (Letter No. 514), 269 (Letter No. 550).

218. In 1786, the historian, William Robertson discussed the decision of his publisher to issue a new edition of his *History of Scotland* explicitly in terms of the bifurcated copyright: "Messrs Strahan & Cadell intend to close the second fourteen years of their Copyright property by printing two elegant editions of the Book, one in quarto and the other in octavo." Letter from Robertson to Hardwicke (Jan. 30, 1786), BL Add. Mss. 35350, fol. 73, *cited in* Smitten, *supra* note 156, at 48. Likewise, Gibbon referred to the possibility of providing a revision of his *Decline and Fall* to Cadell so that the latter would "renew your copy-right at the expiration of the last fourteen years." Letter from E. Gibbon to T. Cadell (Feb. 11, 1789), *in* 3 GIBBON LETTERS, *supra* note 159, at [721].

these passages during fourteen Years after the first publication, it would effectively secure you so long from any pirated edition.²¹⁹

While attention was refocused on the Statute of Anne, including section 11, the earlier Chancery decision of *Millar & Dodsley v. Taylor* seems to have been forgotten by authors, booksellers and (at least some) lawyers alike.²²⁰

Author Samuel Johnson, for example, clearly had no appreciation of the decision. Considering the possibility of legislative reform of the limited period of protection granted by the Statute of Anne, he wrote to his publisher Strahan on March 7, 1774 with the following suggestions:

1. That an Authour should retain during his life the sole right of printing and selling his work
2. That the authour be allowed, as by the present act, to alienate his right only for fourteen years. A shorter time would not procure a sufficient price, and a longer would cut off all hope of future profit, and consequently all solicitude for correction or addition.
3. That when after fourteen years the copy shall revert to the authour, he be allowed to alienate it again for only seven years at a time. After fourteen years the value of the work will be known, and it will be no longer bought at hazard. Seven years possession will therefore have an assignable price. It is proper that the authour be always incited to polish and improve his work, by that prospect of accruing interest which those shorter periods of alteration will afford.
4. That after the authour's death his work should continue an exclusive property capable of bequest and inheritance, and of conveyance by gift or sale for thirty years.²²¹

While Dr. Johnson's proposal is interesting, not least because Johnson would have not only reinstated but reinforced the author-protective provisions from section 11, what is more significant about this letter, from our perspective, is Johnson's interpretation of the effect of the section, namely, that it only permitted alienation of copyright for fourteen years. According to

219. Hume to Strahan, Mar. 1774, 2 HUME, *supra* note 156, (Letter No. 496), at 286; *see also* Adam Smith to Thomas Cadell, March 14, 1786, SMITH, *supra* note 178 (Letter No. 257) (“[T]he eight and twenty years property are now expired [in *The Theory of Moral Sentiments*]. But I hope to be able to secure you the property for at least fourteen years more.”). Smith was planning a substantially revised edition.

220. *But see infra* text accompanying notes 235–36 (counsel for Carnan's reference to “*Millar v. Taylor*”).

221. 2 JOHNSON, *supra* note 153, at 442–46 (citing from an original then in the possession of R.B. Adam of Buffalo) (emphasis added).

Johnson, even with a deed and an express intention to override the statutory protection, alienation of the reversionary term was impossible until it had fallen into possession.

Moreover, the practices of at least some publishers seem to have altered after 1774 in a way that suggest that they no longer recalled, or trusted, the 1765 decision. Several of the publishing contracts entered by William Strahan (the addressee of Dr Johnson's letter) in the early 1780s are made by deed, suggesting that Strahan had started to think, as some publishers had in the 1720s and 30s, that such formality was required. In addition, in a number of these contracts the authors promised, after the fourteen year period had lapsed, to do whatever was necessary to perfect the publisher's title. This implies that the booksellers doubted that even the use of deeds had been effective to achieve that goal.²²²

The legal profession, too, had new doubts about the assignability of the reversionary term. Barrister and law reporter Charles Ambler, King's Counsel, for example, advised the music publishers, Longman & Broderip, in 1783, that transfers that they believed they had received in the 1760s might not have been fully effective with respect to the contingent reversion.²²³ As later recounted in litigation, the Ambler opinion stated that the words of the Statute of Anne were "general" so that it appeared that, if living, the author was entitled to the second term of protection "even against his own Act."²²⁴ He said he could not "call to mind any Judicial determination upon [the issue]."²²⁵ As a reporter of Chancery decisions from the late 1730s onwards (1737–1783), albeit one without an outstanding reputation,²²⁶ he would have been in a good position to know.²²⁷ Clearly, *Millar & Dodsley v. Taylor*, being unreported and having attracted little attention, had quickly disappeared from memory.

222. BL Add. Mss. 48901, *supra* note 87, fol. 20 (Blair), fol. 22 (Buchan), fol. 39 (Mackenzie).

223. Mace, *supra* note 72, at 9, contains Rennett's answer to Longman & Broderip's complaint against him, E112/1702, No. 3728.

224. Mace, *supra* note 72, at 9.

225. *Id.*

226. John Wallace complained that in "many instances the language of the Judges was so erroneously reported that false ideas were given of the points decided." JOHN WILLIAM WALLACE, *THE REPORTERS ARRANGED AND CHARACTERIZED* 513 (1882). Van Vechten Veeder was more damning still. V.V. Veeder, *The English Reports, 1202–1865*, 15 HARV L. REV. 1, 114–15 (1901) (stating that "their statement of facts is often defective, their reports of the arguments of counsel are far from lucid, and sometimes they give an incorrect report of the decree").

227. Eldon LC said that he had "a very considerable knowledge of the decisions of his own time." *Clarke v. Parker*, (1812) 34 Eng. Rep. 419, 423.

- e) 1785–1787: Judicial Interpretation of Section 11 in *Rennett v. Thompson*, *Rennett v. Longman & Broderip*, *Carnan v. Bowles*, and *Cadell v. Anderson*

The issue of whether, and if so, when and how the reversionary term could be transferred fell finally for decision in four cases in the mid-1780s, two before the four Barons in Exchequer,²²⁸ one in Chancery,²²⁹ and one in the Scottish Court of Session.²³⁰ None concerned works of high literature. The first two cases, *Rennett v. Thompson* and *Rennett v. Longman and Broderip*, in Exchequer, concerned music,²³¹ a subject matter that courts had only in 1777, explicitly recognized as falling within the scope of the Statute of Anne's protection of "books."²³² The third, *Carnan v. Bowles*, was about very different subject matter, namely maps,²³³ while the fourth case, *Cadell v. Anderson*, concerned Blackstone's *Commentaries*.²³⁴

228. *Rennett v. Thompson* (unreported, 1785) and *Rennett v. Longman and Broderip* (unreported, 1785). The processes seem to have been similar, though Exchequer was often speedier. See generally W.H. BRYSON, *THE EQUITY SIDE OF THE EXCHEQUER: ITS JURISDICTION, ADMINISTRATION, PROCEDURES, AND RECORDS* (1975); Henry Horwitz, *Chancery Equity Records and Proceedings, 1600–1800*, 55 *CAMBRIDGE L.J.* 146 (1996); Henry Horwitz, *Chancery's "Younger Sister": The Court of Exchequer and Its Equity Jurisdiction, 1649–1841*, 72 *HIST. RES.* 161, *passim* (1999); Judith Milhous & Robert Hume, *Eighteenth Century Equity Lamsuits in the Court of Exchequer as a Source for Historical Research*, 70 *HIST. RES.* 231 (1997).

229. *Carnan v. Bowles*, (1785) 29 *Eng. Rep.* 45 (Ch.).

230. *Cadell v. Anderson*, No. 340 (July 17, 1787), in *DECISIONS OF THE COURT OF SESSION: FROM NOVEMBER 1781 TO AUGUST 1787*, at 522 (A. Law, W. Steuart & R. Craigie eds., 1788) [hereinafter *COURT OF SESSION*].

231. The cases are thoroughly described in Mace, *supra* note 72, at 13–22.

232. *Bach v. Longman*, (1777) 98 *Eng. Rep.* 1274 (K.B.). See Michael Carroll, *The Struggle for Music Copyright*, 57 *FLA. L. REV.* 907, 935–45 (2005).

233. *Thompson and Carnan* are linked by a curious geographical coincidence: Carrington Bowles and Charles Thompson occupied adjacent premises in St. Paul's Churchyard. RAVEN, *supra* note 74, at 184. James Raven wrote:

Of Donaldson's Churchyard neighbours, Charles Thompson's music printing shop stood to the north of the great West door of the [St. Paul's] Cathedral, almost adjoining Thomas and Carington Bowles, printsellers and wholesalers, and for a long time the greatest print and cartoon shop in the country. Thomas Bowles traded at no 69, next to the Chapter House, from about 1712 to 1767. His nephew, Carington, son of his brother John, who had been in the trade since about 1720, continued the business until his own death in 1793.

Id. One might wonder whether Bowles was tempted to transact with Paterson because he knew of Rennett's assertion of the reversion rights against his neighbour, Charles Thompson.

234. *Cadell v. Anderson*, (July 17, 1787), Case No. 340, in *COURT OF SESSION*, *supra* note 230, at 522.

In the two *Rennett* decisions, the claimant, Charles Rennett, a barrister-turned-music seller,²³⁵ had purchased reversionary terms in certain works from their composers, the celebrated Charles Dibdin and John Garth,²³⁶ before pursuing action for infringement against two music publishers, Thompson and the partnership of James Longman and Francis Broderip, who claimed to be acting under the authority of the original transfer. Both claims were unsuccessful. According to a newspaper report, in the first case, *Rennett v. Thompson*, the Barons expressed their “disapprobation of the Plaintiff’s conduct in departing from his profession for that of a Dealer in Musick” before dismissing the Bill unanimously on the basis that the “suit was frivolous and vexatious.”²³⁷ In the second case, *Rennett v. Longman*, the Barons, after reviewing Rennett’s case, and “without hearing one word of the evidence on the part of Messrs Longman and Broderip,” ruled against Rennett.²³⁸ The two cases are damning judgments against Rennett, but it is difficult to draw much from them. Although *Rennett v. Thompson* was referred to in argument in *Carnan*, neither it nor the subsequent Rennett action against his former employer, Longman and Broderip, was fully reported, and the reasoning will have remained a mystery to contemporaries.²³⁹ Not surprisingly, therefore, *Carnan v. Bowles* has long been regarded as the key authority.

Carnan v. Bowles (1786) concerned rights in the book *A New and Accurate Description of All the Direct and Principal Cross-roads in Great Britain*, compiled by Daniel Paterson, the assistant to the Quarter Master General of His Majesty’s Forces. On January 7, 1771, Paterson entered into a publishing agreement with Thomas Carnan, a bookseller at St. Paul’s Churchyard in London. In return for £50 and 300 copies of the book, Paterson:

did Bargain and Sell unto your Orator his Executors
Administrators and Assigns the said Book . . . and all his the said

235. The complaint described Rennett as “of the Inner Temple” (one of the Four Inns of Court). Rennett operated his music selling from 80 Haymarket.

236. The Garth piece was “Six Sonatas for the Harpsichord, Pianoforte and Organ (assigned on October 20, 1784). The Dibdin works were operas called “The Padlock,” “The Recruiting Serjeant,” and “The Jubilee,” and were assigned on July 28, 1784. Mace, *supra* note 72, at 10, 12.

237. The decree is at E126/33/Trin 1785/26, *cited in* Mace, *supra* note 72, at 21 n.50; ST JAMES CHRONICLE, June 28–30, 1784, at 4d.

238. The decree is at E126/33/Mich 1785/6 and a report of the hearing appeared in TIMES, Dec. 13, 1785, *both cited in* Mace, *supra* note 72, at 21 n.51.

239. One particular difficulty with interpreting the holding in the Longman & Broderip case derives from the fact that Rennett had learned about the vulnerability of Longman’s title while he was employed by the music-sellers as a legal advisor. He would hardly have appeared as having “clean hands.”

Daniel Paterson's right of copy title interests and Property of in and to the same together with the sole right of printing publishing and vending the same to the only proper use benefit and advantage of your Orator, his Executors, Administrators and Assigns.²⁴⁰

Carnan entered the title on the Stationers' register and published and sold many thousands of copies at two shillings each. In due course Paterson corrected and added to the work for a further four editions (in 1772, 1776, 1778, and 1781), each time being paid by Carnan between £10 and £16. Carnan registered each new edition at Stationers Hall. The fifth transaction read as follows: "3d September 1781. Received of Mr Carnan Ten Pounds ten shillings for improving and correcting the fifth edition of the Description of the Roads. Dan Paterson."²⁴¹

As the first period of fourteen years was coming to an end, Paterson entered discussions with a map and printseller, Carrington Bowles, also of St. Paul's Churchyard, as to the possibility of publishing a map book accompanied by copper-plate illustrations. They seem to have understood that the first term of copyright in the Carnan publication would expire on January 1, 1785. As Bowles was willing to offer Paterson £263 13 shilling and 2 pence, plus fifty copies, it is not surprising that Paterson agreed, and in due course Bowles published *Paterson's British Itinerary, being a New and accurate Delineation and Description of the Direct and Principal Crossroads of Great Britain in Two Volumes*, with some 360 copper plates. The work sold for 2 guineas a copy, twenty-one times the price of the Carnan volume.²⁴²

Soon after, Carnan brought an action. Carnan's Bill alleged that the agreements entitled him to

the sole right and property of the said book or pamphlet with additions or improvement so made thereto for a second term of fourteen years commencing and to be computed from the expiration of the first term or from the said 3d day of September 1781 the date of the said last mentioned receipt of the said Daniel Paterson or from the time of his publishing such fifth edition as aforesaid and entering the same in the said Register Book of the stationers Company.²⁴³

Such "receipts," Carnan charged, "were and are transfers and sales respectively and the last thereof was and is a transfer of all of such copyright

240. The Bill and Answer can be found in the National Archives at Kew, London, at C12/133/25m. The Orders are contained in C33/465 at 449 and C33/467 at 23, 393, 429.

241. *Id.*

242. *Id.*

243. *Id.*

for the term of fourteen years from the dates thereof respectively or at all events of the additions and improvements." These improvements were said to be "numerous and of great value."²⁴⁴ Consequently, Carnan claimed both to be the assignee of the second term in the work embodied in the first edition, and of any rights over improvements made in each subsequent edition, so that any arrangement between Paterson and Bowles was ineffective to vest any rights in Bowles. The Bill went on to assert that the book published by Bowles infringed Carnan's right, and to deny Bowles and Patersons' claim that they had published a "different and distinct work and composition."²⁴⁵ Carnan claimed that it was "the same book" and that any variations were "colourable," and sought an answer, an injunction and an account of all the profits made by Bowles.²⁴⁶

The Answers of both Paterson and Bowles denied the charges, claiming that the term of copyright conferred by the statute was fourteen years "and no longer," that it had come to an end the previous January, and, in any case, that the book was not the same book, varying from Carnan's in a "very great number of essential particulars."²⁴⁷ In particular, Paterson submitted:

[T]hat he had not power to renew the said complainant's right of printing and publishing the said work so sold to him by this Defendant or his assignor or to enforce his term therein beyond the aforesaid term of 14 years this Defendant being disabled as this Defendant humbly apprehends by the said Act of the Eighth Year of the Reign of Queen Anne from selling or assigning the said Copy right for a longer term or number of years than Four teen Years only.²⁴⁸

In July 1785, the Solicitor General, Archibald MacDonald, supported by Madocks and Needham, put the case for Carnan, that the contract by Paterson, purporting to convey "all his . . . right," must convey the contingent interest in the second term of fourteen years, as well as the absolute interest in the first fourteen.²⁴⁹ The power to assign must be co-extensive with the right given by the Act.²⁵⁰ In effect, this was a direct appeal to the proprietary logic implicated in the form of the statutory

244. *Id.*

245. *Id.*

246. *Id.*

247. *Id.*

248. *Id.*

249. *Carnan v. Bowles*, (1786) 29 Eng. Rep. 45 (Ch.).

250. *Id.* at 46. Carnan featured some of the leading barristers of the time, with one contemporary account noting that "[t]here was a vast quantity of talents exercised on this object." *THE WORLD, & FASHIONABLE ADVERTISER*, July 20, 1787.

provision: the author was given two rights, two properties, and because each was a property, each was assignable.

Carnan's counsel also appealed to authority. They cited in support the decision in *Millar v. Taylor*, as well as that of the Court of Exchequer in *Rennett v. Thompson*. The report says that the Solicitor-General argued that "[i]t was understood in the case of *Millar v. Taylor*, 4 Burrow, 2303, that Millar took the whole right for twenty-eight years, if the author should be alive at the end of the first fourteen,"²⁵¹ but the reporter, William Brown, seems to have confused the Kings Bench decision with the 1765 Chancery case, mistakenly inserting the reference to the former.²⁵² Counsel further urged that the case was governed by *Rennett*, where an assignee of the reversionary term was held not to be entitled to injunctive relief as against the initial purchaser on the grounds that "the whole right" had been passed by "the first grant."²⁵³

Counsel for Bowles, Mansfield and Stanley, argued that Paterson "meant to convey only what he had absolutely, the right of sole printing for fourteen years."²⁵⁴ Moreover, they observed that "the expression in the [A]ct meant to secure something to authors, even against their own acts."²⁵⁵ After fourteen years, it says, "the right shall *return to the authors* (not their assigns), if living; so that it is a personal bounty to the authors only. In selling the right, the author sells all that is in him, not the contingent right that may return to him."²⁵⁶ The Solicitor-General's reply sought to account for the language in the statute: the "*return* is only between the public and the author, not between him and his assignee. There are no negative words in the act to prevent his assigning that, as well as his other rights. In many cases, if he could not assign it, the disability would be productive of great inconvenience."²⁵⁷

The Master of the Rolls,²⁵⁸ sitting for the Lord Chancellor, seems to have found the latter arguments persuasive, treating the whole question not as one

251. Carnan v. Bowles, 29 Eng. Rep. at 46.

252. Indeed counsel for the defendant was also wrong-footed, observing, "[i]n *Millar v Taylor*, if Thompson had lived, the question would have been between them, not upon the common law right. No argument can be drawn from that case as to this question." *Id.* Counsel clearly was thinking of the case concerning James Thompson's *The Seasons*, rather than Edward Young's, *The Complaint*.

253. *Id.*

254. *Id.*

255. *Id.*

256. *Id.* (emphasis in original).

257. *Id.* at 46–47 (emphasis in original).

258. William Brown's report attributes the Lord Chancellor, but the Order Book, C33/465 at 449, suggests that the order was made by the Master of the Rolls.

of whether the author *could* convey the contingent interest, but whether, on the facts, he *had* done so. To ascertain this, Lord Kenyon looked at both the wording of the 1771 grant and its context. The reference to transfer of all “interest,” he explained, indicated an intention to transfer the contingent interest (leaving unclear whether the other terms—“right of copy, title, . . . and property”²⁵⁹—would have had a similar effect). Moreover, the context of the agreement supported such an inference. As the contract was entered between the decision of the Court of King’s Bench in *Millar v. Taylor* (1769) and that in *Donaldson v. Becket* (1774), the parties would have assumed a common law right in perpetuity:

[T]he contingent interest must pass by the word interest in the grant. He conveys all his interest in the copyright: the assignment must have been made upon the idea of perpetuity; and it is probable not a syllable was said or thought of, respecting the contingent right. They merely followed the old precedents of such conveyances. It must I think be considered as conveying his whole right. If he had meant to convey his first term only, he should have said so.²⁶⁰

The decision as to the similarities between the works was to prove more problematic. When the Master of the Rolls, Lloyd Kenyon, heard the case, on July 23, 1785, he referred the question of the similarities between the works to Master Wilmot, who reported on May 29, 1786, that while the works were not the same book, differing significantly, nevertheless there were similarities in the roads described.²⁶¹ On June 20, 1786, the Master of the Rolls awarded an injunction, taking the view that adding pictures did not mean that Bowles could escape liability: “the mere act of embellishing could not divest the right of the owner in the text.”²⁶² But, on appeal, in November 1786, Lord Thurlow, Lord Chancellor, found that the report of the Master was not sufficiently clear, and should be referred back to him to determine whether the Bowles work was “a new and original work and in any and what particulars.”²⁶³ The Master reported on May 19, 1787, in a manner favorable to the defendant. As a result, it seems that no final injunction was granted.²⁶⁴

259. See discussion *supra* II.B.1.b.

260. *Carnan v. Bowles*, (1786) 29 Eng. Rep. 45 (Ch.), 47.

261. *Carnan v. Bowles*, (1786) 29 Eng. Rep. 1168.

262. *Carnan v. Bowles*, (1786) 29 Eng. Rep. 45 (Ch.), 47–48; C33/465 at 449.

263. *Carnan v. Bowles*, (1786) 29 Eng. Rep. 45 (Ch.), 48 n.1; *Carnan v. Bowles*, (1786) 29 Eng. Rep. 1168; C33/467 at 23 (Nov. 24, 1786).

264. C33/467 at 393 (Lord Chancellor ordering that effect be given to the report of the Master unless the plaintiff showed good cause why it should not); *id.* at 429 (June 4, 1787)

f) 1787–1814: Deciphering *Carnan v. Bowles*

Lord Kenyon's analysis of the question of the reversionary right might thus, in strict precedential terms, have been considered "obiter." It did not matter, for the purposes of the suit, whether Carnan owned the copyright: even if he did, there was no infringement. But this is too narrow and meticulous an analysis of what, to contemporaries, would have been regarded as the leading decision on the effect of section 11—given that the two *Rennett* cases lacked published reasons and remained largely unreported. *Carnan* established three points clearly: that the reversionary term could be assigned; that this assignment could occur in advance, that is before it vested; and that no deed (in the sense of a document signed *and sealed*) was required to do so. On the first two points, the view that had prevailed in some circles in Scotland was firmly rejected south of the border—and in *Cadell v. Anderson*, the Court of Session came to the same conclusion for Scotland.²⁶⁵ On the third point, the Court clarified something that had been unclear to contemporaries, from Pope onwards (and had not been resolved in *Millar & Dodsley v Taylor* (1765)). As the *Rennett* cases and *Cadell* also seem to have not involved "deeds," they, too, affirmed this point.²⁶⁶ Indeed, in one of the *Rennett* cases, the successful defendants, Longman and Broderip, had maintained that it had been the habitual practices of publishers of music and books merely to give receipts in return for copyright.²⁶⁷ But, those three clarifications apart, the judgment in *Carnan* (and the unexplained holdings in the other cases) left unclear precisely what it was that was effective to convey the reversionary term. Three possible interpretations suggest themselves.

On one reading of *Carnan*, Lord Kenyon may be thought to have said that the reversion was only retained in a case where the author expressly reserved his or her rights: after all, the judge explained, "[i]f he had meant to convey his first term only, he should have said so."²⁶⁸ Such a conclusion would have removed the statutory protection, placing the onus on the author to establish his or her rights expressly in the contract. It seems unlikely that, so soon after *Donaldson v. Becket* had emphasised the importance of statutory law that a judge would feel justified in ignoring it.

(requiring plaintiff's objections be argued within 4 days or to be dismissed). As there are no further references, we can assume that the plaintiffs did not pursue the matter further.

265. *Cadell v. Anderson* (July 17, 1787), Case No. 340, in COURT OF SESSION, *supra* note 230, at 522.

266. *Rennett's* bill of complaint did, however, state that his assignment of the reversionary term, which occurred once the contingent term had vested in the composer John Garth was "by Indenture." See Mace, *supra* note 72, at 10, 12.

267. Mace, *supra* note 72, at 15–22.

268. *Carnan v. Bowles*, 29 Eng. Rep. at 47.

An alternative understanding of *Carnan* is that the contingent reversion was transferred because the document used “the word *interest* in the grant.”²⁶⁹ If so, the implication might be that the alternative terms of “right,” “property,” or “copyright” (terms that might have implied a vested interest rather than an expectant one) would not themselves have sufficed. On this reading, an effective transfer required that a transferee ensure that there were special words in the contract. Such an understanding would have placed undue emphasis on what might appear to be the chance inclusion of one noun amongst many alternatives. As our review of *The Upcott Collection* makes clear, many transactions use the terms right, property, and copyright but not “interest.” However, given that Lord Kenyon went on to conclude that the transaction was to “be considered as conveying his whole *right*,”²⁷⁰ it seems unlikely that he intended the transfer of the reversion to depend on such a technicality. Although the subsequent *Cadell* case gives no guidance, as the precise terms of the initial assignment from Blackstone to Cadell, Strahan and Creech are unspecified,²⁷¹ the *Rennett* cases support the view that it was not merely a question of the use of the precise term “interest”: *Rennett*, who purported to be the assignee of the reversion in some of the musical works of Charles Dibdin there failed to establish that the initial transfer had not itself conveyed the reversion to the transferee even though the document had merely specified that the money Dibdin received was “for my property” in the music, with no further elaboration.²⁷²

A third reading of Lord Kenyon’s judgment would view the interpretation as reflecting the specific assumptions of the parties at a particular time in legal history. The Judge explained that “the assignment must have been made upon the idea of perpetuity.”²⁷³ This assumption seems plausible given that the date of the contract between Paterson and Carnan on January 7, 1771 preceded the House of Lords decision in *Donaldson v. Becket* on February 22, 1774. If so, it is unclear whether the reasoning would only have applied to contracts made after April 20, 1769, the date of the judgment of the court of King’s Bench in *Millar v. Taylor*, or ones made in England before that date (given that different assumptions might have applied in

269. *Id.*

270. *Id.*

271. *Cadell v. Anderson*, No. 340 (July 17, 1787), in *COURT OF SESSION*, *supra* note 230, at 522.

272. *Rennett’s Bill of Complaint*, asserted that on June 23, 1769, the composer John Garth did “sell assign and set over the said Opera or Musical Work unto Peter Welcker of Gerrard Street Soho in the City of Middlesex Music Seller together with all his said John Garth’s Right and Interest therein.” E112/1705 No. 3808.

273. *Carnan v. Bowles*, 29 Eng. Rep. at 47.

Scotland)? Rennett's failed action against Longman and Broderip was, however, inconsistent with this technical interpretation. Although, as regards Garth's works, Longman's defense was based on a contract from June 1769, but the Dibdin contracts were said to have occurred in January 1769 and thus preceded the King's Bench decision in *Millar v Taylor*.²⁷⁴ Of course, it might be that the parties' expectation even before *Millar v Taylor* was that there was a perpetual common law right. If this was the real basis of the *Carman* decision, then presumably these same types of contracts would have had a very different effect where they were entered into after February 22, 1774.

In fact, it seems that after *Carman v Bowles*, the interpretation of section 11 that was most widely adhered to was that in order to transfer the second fourteen year period to the original publisher, the contract must have expressed an intention specifically to convey the reversionary term. This was how Lord Chancellor, Lord Scott, who had appeared as counsel successfully in both the *Rennett* cases and in *Carman v Bowles*, interpreted the law in *Rundell v Murray* (1821).²⁷⁵ He explained: "I conceive that an author will not be taken to have assigned his contingent right in case of his surviving the fourteen years, unless the assignment is so expressed as to purport to pass it."²⁷⁶ An 1808 Bill that would have abolished the reversionary term prospectively also contained a transitional clause that reflected this understanding of the position under section 11,²⁷⁷ giving the author the sole liberty of printing and reprinting such Book and "the power of assigning and disposing of such additional right and liberty, any general words in any former Agreement or Assignment to the contrary notwithstanding."²⁷⁸ This provision appears to be an affirmation of the interpretation, consistent with (if not specified in)

274. The *Rennett v. Thompson* case was based on rights in the works of John Garth a composer of keyboard sonatas, which too, had originally been published in the late 1760s, with the sold to publisher Peter Welcker before finding their way into the hands of Thompson. Rennett's complaint asserted that Garth's sale of rights to Peter Welcker occurred on June 23, 1769, and thus that the rights reverted in June 1783. The Dibdin operas on which the complaint was also based, that is, *The Padlock*, *The Recruiting Serjeant*, and *The Jubilee*, were said to have been created and published "in or about" January 1769. E112/1705 No. 3808. Mace dates their composition as 1768 (*The Padlock*), 1769 (*The Jubilee*), and 1770 (*The Recruiting Serjeant*). Mace, *supra* note 72, at 10.

275. (1821) 37 Eng. Rep. 868, 870.

276. *Id.*

277. A Bill for the Further Encouragement of Learning in the United Kingdom of Great Britain and Ireland, by Securing to the Libraries of the Universities, and Other Public Libraries, Copies of All Newly Printed Books, and Books Reprinted with Additions; and by Further Securing the Copies and Copyright of Printed Books to the Authors of Such Books, or Their Assigns, for a Time to Be Limited, 1808, H.C. Bill [314] (Gr. Brit.) [hereinafter 1808 Bill]. The Bill was considered in Committee on June 22, 1808. (1808) H.C. JOUR. 461.

278. 1808 Bill, H.C. Bill [314], at 3.

Carman, that “general words” were not effective to assign the reversionary term.

The case law of the 1780s, then, preferred the idea of an author’s proprietary autonomy to the sort of paternalistic view that seems to have motivated the legislature in 1710, the Booksellers Bill in 1737, or Johnson’s remarks in 1774.²⁷⁹ Such an approach may well have been informed by the famously lucrative payments many authors had received in the 1770s from publishers such as Cadell and Strahan. These indicated that some authors could negotiate well for themselves, and that, in many cases it was publishers who took the risk. When Johnson famously stated that Andrew Millar had “raised the price of literature,”²⁸⁰ he was referring approvingly to these increased payments to authors rather than objecting, as might have been traditional, to the exorbitant prices that the booksellers charged. Elsewhere, discussing payment he had himself received from the collective of booksellers who funded the production of his famous dictionary, Johnson observed that the “booksellers are generous liberal-minded men.”²⁸¹

3. *Evidence of Use of the Reversion*

If perceptions of the law were such that many of the contractual arrangements originally made by authors with their publishers would not have successfully transferred the reversion, what evidence is there of these authors using the reversionary term to extract further remuneration? The answer is that, as far as we can tell, there is very little.²⁸² None of the contracts in *The Upcott Collection* appear to be assignments of the second fourteen-year term. This fact, perhaps, is rather telling evidence of the comparative rarity of reversionary term contracts. But individual biographical records do tell us of at least four occasions where an author seems to have taken advantage of the reversion.

The first case, perhaps not surprisingly, concerned Alexander Pope. In 1740, Pope was anticipating the lapse of a fourteen-year assignment of rights in *The Dunciad*, which he had assigned, indirectly, to Lawton Gilliver in

279. Cornish, *supra* note 27, at 23 (“In an age when freedom of contract was gaining an increasing hold, the judges were not willing to read an ambiguous section of the Statute as imposing a mandatory construction in the hope of protecting authors against the booksellers . . .”).

280. 1 BOSWELL, *supra* note 2, at 288.

281. *Id.* at 304–05.

282. We have relied on THE UPCOTT COLLECTION, *supra* note 4, and biographical accounts. One important primary source we have yet to investigate is the Strahan ledgers in the British Library. As we will see, this includes at least one reference to a payment being made for the reversionary term. Further work might reveal other entries of this sort.

1728.²⁸³ As far as Pope was concerned, the assignment related only to the first fourteen-year period under the Statute,²⁸⁴ and thus the rights in the work would revert to him in 1742.²⁸⁵ However, Pope then heard that Gilliver (whose relationship with Pope had deteriorated) had assigned his right to another publisher, Henry Lintot (son of Bernard Lintot, who had published some of Pope's early works).²⁸⁶ Pope feared that if Lintot now republished *The Dunciad*, this would undermine Pope's plans for a new edition "with diverse alterations, additions and improvements thereto."²⁸⁷ Lintot wrote to Pope in January 1740/41, primarily about *The Iliad* and *The Odyssey*, but Pope's notes on the letter—transcribed by George Sherburn from the originals in the Egerton Manuscripts—are revealing²⁸⁸:

[S]ee Gilliver's assignment Lords.

Silend: The dunciad, qu. Of Lintot, Gillivers Property is expir'd or expires next year or this not to purchase it²⁸⁹

Pope's reference to "Lords" is almost certainly to the very peculiar circumstances by which Gilliver came by the rights: Pope had initially assigned the copyright to three Lords, to shield his identity from the public, and then had them assign the rights to Gilliver.²⁹⁰ The rest of the note is self-

283. The details are recounted in the pleadings in the case of *Pope v. Lintot*, which survive in the National Archive. C11/549/39 (Feb. 16, 1743). The complaint from Pope is dated February 16, 1742/3 and the answer from Lintot is dated April 19, 1743. Some aspects of the litigation are discussed in Howard P. Vincent, *Some Dunciad Litigation*, 18 *PHILOLOGICAL Q.* 285 (1939).

284. The bill of complaint explains that the agreement was for the "purchase of copy or sole right of printing and publishing the said Book or Poem for a Term of Fourteen Years pursuant to the Regulations and Provisions made in and by an Act of Parliament in the Eight Year of her late Majesty Queen Ann. . . ."

285. The pleadings in fact leave a number of gaps where the relevant dates were to appear. James McLaverty notes that "Pope [was] very uncertain about when he had disposed of the copyright." James McLaverty, *Lawton Gilliver: Pope's Bookseller*, 32 *STUD. BIBLIOGRAPHY* 101, 104 (1979).

286. Henry Lintot's answer suggests that he bought a one third share indirectly, via a printer named Clarke and another publisher, John Osborne, on January 18, 1739/40, and then two thirds directly from Gilliver on December 15, 1740. For Pope's contracts with Bernard Lintot, see *supra* note 117.

287. National Archive C11/549/39 (Feb. 16, 1743).

288. BL Eg. Mss. 1951, *supra* note 163, fols. 17, 18, 19; 4 POPE, *supra* note 188, at 222–24.

289. Egerton Charters, *supra* note 117, Ch. 738.

290. As Pope's bill of complaint explained, "a Treaty of Agreement was thereupon set on foot by and between your Orator or others on your Orators behalf . . . with your Orator's privity and consent." See National Archive, C11/549/39 (Feb. 16, 1743). On the

explanatory: as far as Pope was concerned, Gulliver's rights were about to lapse and thus should not be assigned. Unfortunately, the transaction was completed and Lintot went ahead with his reprinting of the poem, as Pope had feared. Pope thereupon brought a claim in Chancery, relying simultaneously on the limited terms of the contract and the proviso contained in section 11 of the Statute of Anne. In the claim, Pope alleged that the property in the copy had reverted to him "not only in consequence of the said assignment or bill of Sale and the express agreement therein contained but also of the express proviso in the said Act of Parliament."²⁹¹ The pleading suggests that Lintot had offered three reasons for refusing to comply: first, that it was not clear that Pope was the author or owner; secondly, that the assignment was of the perpetual "author's right"; and thirdly, that Lintot was unaware of the limitation. In his answer, Lintot acknowledged Pope's authorship of *The Dunciad*, and relied only on his assignment of whatever interest Gulliver possessed, alleging he was ignorant of the existence and or extent of any limitation on that right. The answer thus did not squarely address the question of the statutory reversion.

For reasons that remain unclear, the case did not proceed to a hearing. There is no record on the *English Short Title Catalogue* of a Lintot edition of *The Dunciad*, so it is likely that he conceded the validity of Pope's claim, in return for which Pope dropped the suit.

The other three examples come from later in the eighteenth century. Anecdotal evidence suggests that a number of high profile authors, including Sir William Blackstone, Adam Smith, and Dr. Samuel Johnson (1709–1784), dealt explicitly with the reversion: Johnson retained the reversion rights, while Blackstone and Smith explicitly assigned the right once it had fallen into possession.

The William Blackstone example relates to his *Commentaries on the Laws of England*.²⁹² This classic text is in four volumes, and each volume was published at different times, the first on November 18, 1765 at eighteen shillings and with a print run of 1,500. Blackstone retained the copyright and had the book printed by Oxford University Press.²⁹³ The *Commentaries* was an

background, see James Sutherland, *The Dunciad of 1729*, 31 MODERN LANGUAGE REV. 347 (1936).

291. C11/549/39.

292. *Cadell v. Anderson*, No. 340 (July 17, 1787), in COURT OF SESSION, *supra* note 230, at 522.

293. Harry G. CARTER, A HISTORY OF OXFORD UNIVERSITY PRESS 406–08 (1975); WILFRID R. PREST, WILLIAM BLACKSTONE: LAW AND LETTERS IN THE EIGHTEENTH CENTURY 217 (2008); JAMES PRIOR, THE LIFE OF EDMOND MALONE, EDITOR OF

immediate success.²⁹⁴ In 1772, the copyright was assigned to Daniel Prince, William Strahan, and Thomas Cadell for £2000.²⁹⁵ When the first fourteen-year period of copyright in the first volume came to an end, Blackstone, who was still alive, assigned the reversionary term to Cadell.²⁹⁶ The Strahan ledgers,²⁹⁷ which feature the initial payment of £2000, do not suggest that any additional payment was made. Blackstone had been a well-known advocate for perpetual copyright,²⁹⁸ and it may be that, at the time he first contracted with Cadell and Strahan (when the 1769 King's Bench decision in *Millar v. Taylor* that recognized a perpetual common law copyright was the governing authority), he had believed he was transferring the rights to the publishers in perpetuity. If so, he may well have thought it proper in 1769 to transfer the second term, so as to give effect, as far as possible, to the agreement he had intended to make in 1772.

The Johnson dealings concerned *The Lives of the Poets*.²⁹⁹ William Cook, the author of *The Life of Samuel Johnson with occasional remarks on his writings*, says that:

[T]he booksellers on going to press with the third edition of the *Lives* offered Johnson £200 for his reversion of the copyhold; but the Doctor, meeting the offer with the same generosity, after pausing some time replied, "Why, let me see—fourteen years hence, why I shall be but eighty-six—no—I'll even keep the reversion as a nest egg for old age."³⁰⁰

SHAKESPEARE 431 (London, Smith, Elder & Co. 1860) (anecdote suggesting Blackstone made £14,000 and his bookseller made £10,000).

294. PREST, *supra* note 293, at 219–20 ("enormous success").

295. IAN G. DOOLITTLE, WILLIAM BLACKSTONE: A BIOGRAPHY 100 (2001); C.S. ELLER, THE WILLIAM BLACKSTONE COLLECTION IN THE YALE LAW LIBRARY 2–3 (1993); PREST, *supra* note 293, at 217–19, app. 2 (transcribing details of annual income from the book); R.D. Harlen, *Sale and Profits of Some Early Editions of Sir William Blackstone's Commentaries*, 58 PAPERS BIBLIOGRAPHICAL SOC'Y AM. 156, 156–59 (1964); Harlen, *supra* note 3, at 188. There is no surviving Blackstone archive.

296. BL Add. Mss. 48807, *supra* note 87.

297. *Id.* (relating to Blackstone's *Commentaries*).

298. Blackstone was counsel for Tonson in *Tonson v. Collins*, (1762) 96 Eng. Rep. 180, and for Millar in *Millar v. Taylor*, (1769) 98 Eng. Rep. 201, and later one of the eleven judges in *Donaldson v. Becket*, (1774) 98 Eng. Rep. 257.

299. SAMUEL JOHNSON, THE LIVES OF THE MOST EMINENT ENGLISH POETS: WITH CRITICAL OBSERVATIONS ON THEIR WORKS (R. Lonsdale ed., 2006).

300. WILLIAM COOK, THE LIFE OF SAMUEL JOHNSON WITH OCCASIONAL REMARKS ON HIS WRITINGS 65 (Kearsley pub., 1785), *quoted in* 1 JOHNSON, *supra* note 153, at 433.

As matters turned out, Johnson's decision to retain his rights was of no consequence. He died the next year, well within the first fourteen-year term, so the contingent term never came into being.

The final example concerns Adam Smith and *The Wealth of Nations*, which was first published in 1776 by Strahan and Cadell on a profit-share basis.³⁰¹ Twelve years later, and after four successful editions, the publishers purchased the copyright from Smith for £300.³⁰² In the spring of 1790, the first term was approaching its end, and the publishers were keen to secure the reversion. Smith, who was sick and dying, was—it seems—also eager to sell the property so that he could make suitable provision for his nephew, David Douglas.³⁰³ Consequently, in April 1790, Smith conveyed the reversionary term for a further £300. Details of the transaction are recorded in Strahan's ledgers,³⁰⁴ and were recalled by Thomas Cadell in a letter two years later.³⁰⁵ The transaction was just in the nick of time: Smith passed away three months later on July 17, 1790.³⁰⁶

The limited evidence of use of the reversion may seem surprising, but is less so when placed in the context of late eighteenth-century author-publisher relations. The demand for most books would dissipate after a short time, and, where they did not do so, the author frequently passed away before the contingent term was in operation.³⁰⁷ Moreover, many of the books that were marketable after fourteen years retained that quality as a result of repeated updating and amendment. Such alterations not only induced new sales, but also created new copyrights. Writing in 1774 to his co-publisher William Creech, William Strahan justified the publisher's generous gift of copies of books to their author: "His constant Corrections will merit such a

301. SHER, *supra* note 2, at 236; Sher, *supra* note 178; Letter from Adam Smith to William Strahan (Nov. 13, 1776), in SMITH, *supra* note 178, at 221 (Letter no. 179); Letter from William Strahan to Adam Smith (Nov. 26, 1776), SMITH, *supra* note 178, at 222 (Letter no. 180).

302. SHER, *supra* note 2, at 236; Sher, *supra* note 178.

303. Sher, *supra* note 178, at 8.

304. BL Add. Mss. 48814A, fol. 7, reproduced in Sher, *supra* note 178, at 7 fig.2.

305. Letter from Thomas Cadell, the elder, to Henry Mackenzie (Dec. 21, 1792) (letter No. 95), in HENRY MACKENZIE, LITERATURE AND LITERATI 177 (H.W. Drescher ed., 1989).

306. Donald Winch, *Smith, Adam (bap. 1723, d. 1790)*, OXFORD DICTIONARY NAT'L BIOGRAPHY, Sept. 2004, online ed. Oct. 2007, available at <http://www.oxforddnb.com/view/article/25767> (last accessed June 21, 2010).

307. Of those that had a continuing market, a substantial proportion related to works published within fourteen years of the authors death: *The Wealth of Nations* turned fourteen just months before Smith died, but Goldsmith wrote *The Vicar of Wakefield* seven years before his death, while Johnson died only three years after publication of his magnum opus, *The Lives of the Poets*. See 1 UPCOTT, *supra* note 4, at [129] (indicating that George Lillo's *The London Merchant* was first published in 1731, only eight years before Lillo's death).

Present, and tend much as well to the Preservation of Property as to the sale of it.”³⁰⁸ In the context of a work that had been amended on a number of occasions during the first fourteen-year term, reversion would only have enabled the sale of rights in the text as originally conceived. A new publisher would not be entitled to use the revisions. This meant that the reversion would be of limited value, really only relevant where the new assignee had some vision of a transformed work (as in *Carnan v. Bowles*) or where there were no revisions (as, for example, with pieces of music).

The practice of revising editions reminds us, too, that the author-publisher relationship was often one characterised by continuity—a continuity which a decision to exercise the reversion might well have disrupted. This continuity had, in some cases, a social element and, in many cases, a commercial one.³⁰⁹ Many authors published their works through the same publisher again and again. In such cases, old deals that turned out, in retrospect, to look as if they had disproportionately rewarded a publisher, could be compensated by generous new deals. One such example concerned Strahan and Creech’s dealing with William Buchan, who having had a huge commercial success with *Domestic Medicine*, proposed to compose a different work: *Preventive Medicine*. The publishers were keen to retain Buchan, and keep him happy, for if he moved to a different publisher he might write a book that would supplant demand for *Domestic Medicine*. Although they never envisaged that Buchan would complete *Preventive Medicine*, nor were the publishers particularly keen to do so, they entered a generous contract with the author.³¹⁰ Another dimension to the continuity of relations between publisher was the seemingly relatively common practice whereby if a book turned out to be particularly successful, the publisher would offer the writer extra payment beyond that to which he or she was entitled under their contract.³¹¹ Given these sorts of relationships, it is hardly surprising that the

308. Letter from Strahan to Creech (Sept. 9, 1774), *quoted in* Richard B. Sher, *William Buchan’s Domestic Medicine: Laying Book History Open*, in *THE HUMAN FACE OF THE BOOK TRADE: PRINT CULTURE AND ITS CREATORS* 45, 54 (Peter Isaac & Barry McKay eds., 1999).

309. KENT, *supra* note 154, at 61, *passim* (describing the relationship between publisher, John Newbery, and writer, Oliver Goldsmith, including Newbery’s payment of the writer’s rent and debts). In *The Vicar of Wakefield*, Goldsmith describes Newbery as “the friend of all mankind.” OLIVER GOLDSMITH, *THE VICAR OF WAKEFIELD: A TALE SUPPOSED TO BE WRITTEN BY HIMSELF* 113 (Houghton, Mifflin & Co. 1895).

310. BL Add. Mss. 48901, *supra* note 87, fol. 22, *cited in* Sher, *supra* note 308, at 64 n.21

311. For example, Andrew Millar paid Henry Fielding an additional £100 for *Tom Jones*, over and above the £600 copy money. *See* Horace Walpole to George Montagu (May 18, 1749), in WALPOLE, *supra* note 128, at 384. Millar also paid the same sum to Mrs. Sheridan, when the demand for her play, *The Dupe*, turned out to be “uncommonly great.” Letter from Andrew Millar to Mrs. Sheridan (undated), in SAMUEL WHYTE & E.A. WHYTE,

authors that explicitly exercised their reversion rights, such as Adam Smith or William Blackstone, did so by conveying the contingent term to the original publisher.

Finally, it is perhaps worth observing that, while the contingent reversion was designed to protect authors, many authors of the time expressed a preference for outright assignments over other forms of exploitation. Advising Sylvester Douglas in 1775, James Beattie wrote: "I would not advise you to make a conditional bargain, stipulating for a price proportioned to the sale of the Book . . . I think it would be better if you could finish the matter at once, and sell your manuscript finally for a sum of money."³¹² Historian Richard Sher proclaims that this view "was widespread among eighteenth-century authors."³¹³ Certainly, a number explained that they sold copyright in order to avoid the difficulty of managing publication. For example, David Hume wrote to William Strahan that "in order to avoid the Trouble and Perplexity" of publishing himself, he wished "at once to part with all the Property" in the *History of England*.³¹⁴ Similarly, the novelist Frances Burney (1752–1850), who had initially been careful not to sell her copyright in *Camilla* (1796), did so soon after publication in order to save herself the job of managing its exploitation.³¹⁵

C. THE DEMISE OF THE REVERSION RIGHT IN 1814

Section 11 of the Statute of Anne was repealed and replaced by the Literary Copyright Act of 1814.³¹⁶ The Act extended the term of copyright from two terms of fourteen years to one term of twenty-eight years, and if the author were still alive when the twenty-eight-year term elapsed, to the life of the author. The relevant part of section four specified, with regard to

MISCELLANEA NOVA 118 (Dublin 1801). Richard Sher gives many examples of authors who had continuing relationships with specific publishers, and circumstances where publishers would "compensate" authors for bad bargains with additional gratuitous payments or increased payments on later works. SHER, *supra* note 2, at 244–45 (detailing extra payments from Strahan & Cadell to John Moore).

312. Letter from James Beattie to Sylvester Douglas (Aug. 14, 1775), in 2 BEATTIE, *supra* note 155, at 308–09, cited in SHER, *supra* note 2, at 214.

313. SHER, *supra* note 2, at 214.

314. Letter from Hume to Strahan (Feb. 15, 1757), in HUME, *supra* note 153, at 14.

315. 3 THE JOURNALS AND LETTERS OF FANNY BURNEY (MADAME D'ARBLAY) 227 (J. Helmlow et al. eds., 1972).

316. An Act to Amend Several Acts for the Encouragement of Learning, 54 Geo 3, c. 156, § 4 (Gr. Brit. and British Empire). The details of the passage of the Act are obscure. Lionel Bently, *R v. The Author: From the Death Penalty to Community Service*, 32 COLUM. J.L. ARTS. 1, 66–71 (2008); Ronan Deazley, *Commentary on the Copyright Act of 1814*, available at PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabeCom/"uk_1814](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabeCom/)" (calling this a "blind-spot in accounts of British copyright law").

works composed or published after the passage of the Act (July 29, 1814), that “[t]he author and his assignee or assigns, shall have the sole liberty of printing and reprinting such Book or Books for the full term of twenty eight years . . . and also, if the author shall be living at the end of the period, for the residue of his natural life.”³¹⁷

The idea of replacing the bifurcated term with a single one had been conceived at least six years previously, rather oddly, perhaps, in the context of concerns over the enforcement of the obligation imposed by the Statute of Anne upon publishers to deposit copies of their works with various libraries, including those of the Universities of Oxford and Cambridge.³¹⁸ In the case of *Beckford v. Hood*,³¹⁹ it was held that an action lay on the basis of the Statute for damages, as opposed to the penalties prescribed by the Act, and that this remedy was available whether or not the work was registered with the Company of Stationers.³²⁰ As a corollary, it appeared that compliance of the deposit requirement likewise was not a condition that had to be met in order to receive protection. When, as a result, booksellers registered and deposited fewer and fewer works, the Cambridge Law Professor Edward Christian began a campaign for “vindication of the rights of universities.”³²¹ In turn, the booksellers sought to highlight the injustice of the deposit requirements. In the face of this resistance, Christian proposed a compromise: in return for the publishers’ compliance with the obligation to provide copies of work for deposit libraries, the publishers would be given a consolidated single term of twenty-eight years.³²² This compromise was

317. An Act to Amend Several Acts for the Encouragement of Learning, 54 Geo 3, c. 156, § 4 (Eng.).

318. The Statute of Anne designated nine libraries (The Royal Library, University of Oxford, University of Cambridge, Sion College, the University Library and the Faculty of Advocates in Edinburgh, the University Libraries at Glasgow, St Andrews, and Aberdeen) and a further two (Trinity College Library and the Kings Inn Library) had been added in 1801 when the application of the Act was extended to Ireland. 41 Geo. 3, c. 2.

319. *Beckford v. Hood*, (1798) 101 Eng. Rep. 1164 (K.B.).

320. *Id.* at 1168 (Lawrence, J.).

321. EDWARD CHRISTIAN, VINDICATION OF THE RIGHT OF THE UNIVERSITIES OF GREAT BRITAIN TO A COPY OF EVERY PUBLICATION (Cambridge Univ. Press 1807).

322. *See* (1818) (402) REPORT FROM THE SELECT COMMITTEE ON THE COPYRIGHT ACTS OF 8 ANNE, c. 19; 15 GEO. III, c. 53; 41 GEO. III, c. 107; AND 54 GEO. III, c. 116, at 83–85 [hereinafter 1818 REPORT] (Edward Christian, stating that it was agreed that “if the Universities could induce the House by the influence of their members and their representatives, to get an increase in copyright; the booksellers undertook never to disturb us again, but that we should have a copy of every book which they published”).

agreed to sometime in 1807,³²³ but an attempt its legislative implementation failed.³²⁴

The matter lay dormant and unresolved for a few years until another court decision, *University of Cambridge v. Bryer*, which affirmed the obligation to deposit copies even where a bookseller did not propose to take advantage of the remedies in the Statute of Anne.³²⁵ The booksellers were angered and petitioned Parliament to remedy the situation. In one of a series of petitions, the booksellers also alluded to the issue of the dual term³²⁶: “[T]he petitioners humbly submit that this distinction is, in many cases, productive of great hardships to the families of authors, and is not founded upon just principles.”³²⁷ Not long after the filing of the petition, an anonymously-authored pamphlet was published that elaborated the argument for a consolidated term of twenty-eight years and the removal of or reduction of the obligation of the deposit.³²⁸ On the first page, the pamphlet explained the injustice that arose under section 11 where an author died before the end of the first term. The author’s

family loses all the profits of his labours at the very time when, from the event of his death, they are in the greatest need of them. It seems the dictate of reason and justice that authors should have at least the full twenty eight years, without any reference to the life of the author.³²⁹

The single fourteen-year term, the pamphlet argued, is “clearly too small.”³³⁰ This was for two reasons: first, there were very many valuable works which

323. 1818 REPORT, *supra* note 322, at 92 (John Charles Villiers, detailing the meeting which he had hosted); (1812–13) (341) SELECT COMMITTEE ON ACTS FOR ENCOURAGEMENT OF LEARNING BY VESTING COPIES OF PRINTED BOOKS IN AUTHORS OR PURCHASERS OF COPIES: MINUTES OF EVIDENCE 17 (July 20, 1813) [hereinafter 1813 SELECT COMMITTEE MINUTES] (Mr. J. Mawman saying he consented to the Villiers Bill but he would be “exceedingly sorry if anything [he] did then, should be considered as denoting [his] opinion at present”). Thomas Norton Longman stated that he was present at the meeting at MP John Charles Villiers’s house in 1807, but that he did not consider the extension of copyright an adequate quid pro quo for the continuation of the deposit obligations even though there were “some persons of that opinion.” *Id.* at 11–12.

324. Leave was given to introduce a bill on June 16, 1808, and Villiers, Sir William Scott, the Earl of Euston, the Attorney General, Solicitor General, and Lord Advocate of Scotland, were charged with its preparation. (1808) H.C. JOUR. 441.

325. *Univ. of Cambridge v. Bryer*, (1812) 104 Eng. Rep. 1109 (K.B.).

326. 24 PARL. DEB., H.C. (1st ser.) (1812) 308, 310 (U.K.).

327. *Id.*

328. S. TURNER, REASONS FOR A MODIFICATION OF THE ACT OF ANNE RESPECTING THE DELIVERY OF BOOKS AND COPYRIGHT (London, Nichols, Son & Bentley 1813).

329. *Id.* at 1.

330. *Id.*

“scarcely get known to the publick during the first fourteen years”;³³¹ secondly, because the cost of publishing books had considerably increased in the century since the Statute of Anne was enacted, a longer period was needed to recoup the additional expense.³³²

Although the pamphlet assumed to represent the interests of authors,³³³ given that many contracts, as we have seen, purported to convey the second term if the author survived, the claim that “the family loses all the profits” was tendentious to say the least. Even those authors (such as Blackstone or Gibbon) who retained the copyright initially, merely permitting the printing of early editions (or entering into profit share arrangements), usually later assigned away their property during the first term of protection. Moreover, had the goal been to protect the families of deceased authors, then a provision such as that which would later be adopted in the United States in 1831 and Lower Canada in 1832,³³⁴ allowing the estate to take advantage of the reversion, would have been better suited than the consolidation of the two terms into a single unit. A more principled justification was offered by Sir Samuel Romilly, debating the petition, who pointed to an anomalous effect of the dual term:

It operated in a way most injurious to the best interests of literature; for as young authors were more likely to reach the second term than old, it gave the immature and jejune compositions of the former double the reward reserved for the productions of ripened genius.³³⁵

Parliament appointed a Select Committee to look into the matter under the chairmanship of Davies Giddy (also known as Davies Gilbert).³³⁶ The Committee heard evidence only from five booksellers, three printers, Reverend Dibdin, and Sharon Turner.³³⁷ Some reference was made to the

331. *Id.* at 31.

332. *Id.* at 35 (stating that “they require a much larger space of time before the author can get reimbursed in his expenses from that sale.”).

333. *Id.* at 59.

334. *See infra* notes 374–76 (describing the Act of 1831 in the United States); *see also* Act for the Protection of Copy Rights, 1832, 2 Will. 4, c. 53 (Can.). Protection lasted for an initial twenty-eight year term (from recording of the work’s title with the Superior Court), but with the possibility of renewal for fourteen years if the author was alive at the end of that period, and resident in the Province, “or being dead, shall have left a widow or child or children, either or all then living.” *Id.* The provision was extended to the whole of Canada when Upper and Lower Canada were united. An Act for the Protection of Copy Rights in this Province, 4&5 Vict c. 61 (Can.).

335. 25 PARL. DEB., H.C. (1st ser.) (1813) 12, 16 (U.K.).

336. 1813 SELECT COMMITTEE MINUTES, *supra* note 323.

337. *Id.*

fact that engravers already received a fixed term of protection for twenty-eight years,³³⁸ thereby pointing to the apparent anomaly in the treatment of books. But it seems, further, that the Committee accepted the contention that the contingent term added unnecessary uncertainty to copyright law without benefiting the author.

In fact, the Committee appears only to have considered as an afterthought the author-protective aims that had informed the inception of section 11 of the Statute of Anne. On June 16, 1813, the Committee called Sharon Turner, who had already given evidence on behalf of the booksellers (as well as playing an active role questioning the witnesses), for re-examination. At that point, Giddy asked Turner to consider the position of authors, and in particular, whether “any advantages would result to authors from a division of the term of copy right into two portions, and from an enactment that no sale of the second portion should take place, till after the expiration of the first?”³³⁹

The question itself was interesting, in that it must have been appreciated after *Carman* that the reversionary term could be assigned before it fell into possession. It seems that another member of the Committee, Charles Watkin Williams Wynn, MP for Montgomeryshire, had raised the possibility of strengthening the author’s position vis-à-vis the publisher.³⁴⁰ Wynn was the life-long friend of the Poet Laureate, Robert Southey. Corresponding with Wynn in April and May 1813, Southey declared:

My opinion is that literary property ought to be inheritable, like every other property, and that a law which should allow the use of trees upon your estates for eight-and-twenty years, and after that term make them over to the Carpenter’s Company, would not be more unjust than that which taken from me and my heirs the property of my literary labour, and gives it to the Company of Booksellers. I am afraid you do not agree with me on this, and certain that even if you do, nothing more can be done towards restitution of the author’s rights than simply to make their complaint when you speak upon the subject. . . . *It is doing something to get the twenty-eight years absolute . . . I should rather the right of sale was limited: it would give the author some share of those prices in the lottery which now fall, almost wholly, to the bookseller. The second term would have enriched*

338. *Id.* at 18 (question put to John Cochrane).

339. *Id.* at 33.

340. For general background on Wynn’s Parliamentary career and relationship with Southey, see Gwyneth Evans, *Charles Watkin Williams Wynn 1775–1850* (1935) (unpublished M.A. dissertation, University of Wales) (on file with University College Library, Bangor).

Cowper. And if you gave us a lease for life I may probably be benefited by it.³⁴¹

Intriguingly, in another letter from Southey to Wynn,³⁴² the poet refers to a mysterious proposed amendment by Wynn: “Your proposed clause will be a real benefit to authors: the copyright of ‘Joan of Arc’ and of my poems would have reverted to me if the bookseller’s custom did not declare otherwise.”³⁴³ Although the precise details of Wynn’s proposal are unknown, the questions posed by Giddy to Turner, as well as the timing (less than two months later), suggest Wynn had passed on Southey’s complaints.

In response to Giddy’s question, Turner explicitly denied that there was any “bookseller’s custom” that disadvantaged authors. Moreover, Turner told the Committee that he thought “no benefit would result to authors” from a reversionary term that was inalienable, adding that he thought it would be desirable merely “that all contracts for copy right should be in writing, and that the term for which the author disposes of it should be there expressed.”³⁴⁴ Turner,³⁴⁵ it might be noted, has been identified as the author of the 1813 pamphlet, mentioned above, which had itself put the case for a single consolidated twenty-eight-year term.³⁴⁶

Ultimately, Turner’s response proved persuasive. The *Report of the Select Committee on Copy Right of Printed Books*³⁴⁷ recommended the consolidation of the two fourteen-year terms in to one of twenty-eight years. Addressing the issue in its final paragraph, the Report stated:

Your Committee have taken into their consideration, the subject of Copy Right; which extends at present to fourteen years certain, and then to a second period of equal duration, provided the author

341. Letter from Southey to Wynn (May 23, 1813), in 2 SELECTIONS FROM THE LETTERS OF ROBERT SOUTHEY 323 (John Wood Warter ed., London, Longman, Brown, Green & Longmans 1856) (emphasis added). The reference to “Cowper” is to the poet William Cowper who died in 1800.

342. Letter from Southey to Wynn (Apr. 24, 1813), *id.* at 320.

343. *Id.* at 321. Southey’s *Joan of Arc* was published in 1796.

344. (1818) (177) COMMITTEE ON ACTS OF 8 ANNE, AND 15 & 41 GEO. III, FOR THE ENCOURAGEMENT OF LEARNING, BY VESTING THE COPIES OF PRINTED BOOKS IN THE AUTHORS OR PURCHASERS OF SUCH COPIES: MINUTES OF EVIDENCE 33 (Apr. 13, 1818).

345. (1768–1847). Turner was a solicitor who represented booksellers in the case against the University of Cambridge, gave evidence to the 1813 Select Committee, and assisted Southey in his legal battle surrounding the publication of *Wat Tyler* in 1817.

346. *Reasons* was attributed to Sharon Turner by Egerton Brydges, a literary figure closely involved in these debates. EGERTON BRYDGES, REASONS FOR A FARTHER AMENDMENT OF THE ACT 54 GEO. III. c. 156, BEING AN ACT TO AMEND THE COPYRIGHT ACT OF QUEEN ANNE (London 1817).

347. 1813 SELECT COMMITTEE MINUTES, *supra* note 323.

happens to survive the first. They are inclined to think, that no adequate reason can be given for this contingent reversion, and that a fixed term should be assigned beyond the existing period of fourteen years.³⁴⁸

The transformation of the reversionary fourteen-year term into a single twenty-eight-year copyright which was effected by the 1814 Act had, thus, been in the pipeline for some time. The reform reflected a perception that the existing system created uncertainty, operated capriciously, did not secure any benefits to authors and potentially deprived booksellers of a suitable period in which to recoup their investments. The apparent absence of protest from authors suggests that there was little affection for the contingent, reversionary term.

The failure to replace the reversion with an author-protective provision may well have reflected the growing dominance of the ideology of freedom of contract.³⁴⁹ Indeed, it is instructive to compare the manner in which the legislature, in the very same year, 1814, treated the issue of the extension of the term of copyright in sculpture, which had been first recognized in 1798. The Models Act of that year introduced protection for sculptors lasting for fourteen years.³⁵⁰ The Act proved inadequate for various reasons, and when reform was proposed, so too was an increase of the term so that sculptors could be placed on a par with engravers (who received a fixed twenty-eight-year term) and writers (who hitherto had received the dual fourteen-year terms). For some reason, the legislators chose the writers' model for sculptors, but balked at the idea of reversion. In place, a new principle was adopted: a sculptor would receive an additional fourteen-year term if he or she was alive when the first term lapsed unless the rights in the work had already been disposed of.³⁵¹ Although the legislative record reveals no details about the reasoning behind the approach, this curious provision seems to reflect a desire to confer greater protection on sculptors who survive, but not to give a windfall to assignees. Both goals are achieved through a targeted, contingent extension, in a manner which avoids interfering with freedom of contract.

As it happens, the Literary Copyright Act in 1814 did not merely consolidate the two fourteen-year terms into a single period of twenty-eight years, but also provided that, if the author were alive at the end of the

348. *Id.*

349. The classic exposition is P.S. ATIYAH, *THE RISE AND FALL OF FREEDOM OF CONTRACT* (1979).

350. Models and Busts Act, 1798, 38 Geo. 3, c. 71 (Gr. Brit.).

351. Sculpture Copyright Act, 1814, 54 Geo. 3, c. 56, § 6 (Gr. Brit.).

twenty-eight-year term, copyright was to continue for the remainder of the author's life.³⁵² In contrast with the decision to consolidate the reversion into a fixed twenty-eight-year term, this extension to the life of the author appears to have arisen spontaneously and without any serious debate.³⁵³ According to Deazley, the amendment was moved during the third reading of the Bill in the Commons, and just before it went up to the Lords.³⁵⁴ The record suggests that the amendment was tabled by the MP, Samuel Egerton Brydges (who had campaigned primarily for a reduction in the deposit obligations).³⁵⁵ Whatever Brydges' reasons for proposing this extension in a Bill that he generally opposed, it is worth noting that the clause was written in a way that, although introducing a "contingency," avoided any impression that the effect would be to reintroduce a reversionary term. The clause stated clearly that the contingent term benefited the author, "his assignee or assigns," and avoided any language (such as that of "returning") that might be interpreted as suggesting reversion. For those authors who assigned the rights "for ever," and took in return a fixed fee, the clause would have operated for the financial benefit of publishers. For most authors, the amendment was of largely symbolic, rather than pecuniary, significance: the Statute recognized that there was some notional relation between their individual survival and the existence of property in the text (even if that property would rarely belong to the author). The amendment reflected the legal embodiment of what Oren Bracha has called "the ideology of authorship,"³⁵⁶ at the same moment that the law abandoned its attempt to intervene in the functioning of the book market to protect the interests of real, flesh-and-blood, writers.

Nevertheless, before the idea of a reversionary right had come to be abandoned in Britain, it was imported, in almost identical terms, by the newly

352. An Act to Amend Several Acts for the Encouragement of Learning, 54 Geo. 3, c. 156, § 4 (Gr. Brit. and British Empire).

353. Whether or not they influenced the British legislation, copyright terms based on the life of the author were in force elsewhere in Europe. *See, e.g.*, French Literary and Artistic Property Act, art. 1, 2 (1793) (Fr.), available at PSOC, *supra* note 2, http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/showmax/%22f_1793_im_001_0001.jpg%22; *see also* BADEN CIVIL CODE art. 577 d f (Luis A. Sundkvist trans., Karlsruhe 1809), available at PSOC, *supra* note 2, http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/showTranslation/%22d_1809_im_001_0003.jpg%22.

354. Deazley, *supra* note 316.

355. 2 EGERTON BRYDGES, *THE AUTOBIOGRAPHY, TIMES, OPINIONS, AND CONTEMPORARIES OF SIR EGERTON BRYDGES* 321 (London, Cochrane & M'Crone 1834) ("Nor was I less earnest and active in the trouble I took about the Copyright Act,—however unsuccessfully."). Brydges's disappointment related, almost certainly, to the failure to reduce the deposit obligations significantly in either 1814 or 1818.

356. Oren Bracha, *The Ideology of Authorship Revisited: Authors, Markets, and Liberal Values in Early American Copyright*, 118 *YALE L.J.* 186 (2008).

independent states of South Carolina and Maryland, and, with slight variations in Connecticut, New Jersey, Pennsylvania, Georgia and New York.³⁵⁷ From there, it made its way into U.S. federal copyright law, transforming itself into the idea of a “renewal term,” and via the United States into Canadian law. In Part III, we explore how well it succeeded in the United States and its ultimate transformation into a “termination right.”

III. UNITED STATES

A. THE CONSTITUTIONAL COPYRIGHT CLAUSE AND THE FIRST COPYRIGHT ACT

The 1787 U.S. Constitution empowers Congress to “secur[e]” “for limited Times to Authors . . . the exclusive Right to their . . . Writings.”³⁵⁸ The plural duration echoes the Statute of Anne’s provision for a second term, contingent on the author’s survival.³⁵⁹ Even before the Constitution, Congress’ 1783 resolution encouraging the states to enact copyright laws and many of the ensuing state copyright statutes imported the contingent two-term structure from the Statute of Anne.³⁶⁰ The United States followed England as the only nation at the time to design exclusive rights around the author, first by instructing Congress that exclusive rights were to go to the creators of “Writings,” and second, by implicitly directing that any additional terms of years also vest in authors. The specification of “limited Times” thus, we suggest, makes authors’ continued ownership interest in their copyrights part of the constitutional scheme.³⁶¹

The first copyright statute, enacted in 1790, accordingly implemented a two-term duration, the second fourteen-year period contingent on the author’s survival. But while the Statute of Anne provided that the rights would “return to the Authors,” the first U.S. copyright act stated: “if, at the

357. Oren Bracha, *The Adventures of the Statute of Anne in the Land of Unlimited Possibilities: The Life of a Legal Transplant*, 25 BERKELEY TECH L.J. 1429 (2010).

358. U.S. CONST. art I, § 8, cl. 8.

359. Statute of Anne, 8 Ann., c. 19, § 11 (1710) (Gr. Brit.).

360. Continental Congress Resolution Recommending the States to Secure Copyright to the Authors and Publishers of New Books, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1783c"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/); Conn. (1783); N.J. (1783); Md. (1783); S.C. (1784); Pa. (1784); Ga. (1786); N.Y. (1786).

361. The plural designation of “Times” might also reflect Art. I, § 8, cl. 8’s combined grant of power to Congress to provide both for copyright and for patents, since the two regimes from the start carried different terms of protection. *See generally* Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 100–03 (2d Cir. 1951) (reviewing differences in first copyright and patent acts), but the prior federal and State copyright provisions suggest an additional reason.

expiration of the said term, the author or authors, or any of them, be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators *or assigns*, for the further term of fourteen years”³⁶² The reference to “assigns” might suggest that the author could assign her rights not only for the first term, but also for the second (subject to her surviving through the first term).³⁶³ On the other hand, “assigns” appears alongside “executors” and “administrators” and the interests of the latter two arise subsequent to the author’s death, yet the renewal term was then contingent on the author’s survival. Thus, it more likely follows that, just as executors and administrators could have succeeded to the author’s second term rights only in the event that the second term came into being, so the “assigns” in question would have been grantees only of rights transferred after the renewal term vested.³⁶⁴ Nonetheless, the contrast between the Statute of Anne’s specification that the right would “*return* to the Author” and the U.S. text’s provision that the “exclusive right shall be *continued* to him”³⁶⁵ perhaps weakens the claim that the first U.S. copyright statute included a reversion right (or that the Constitution required one); however, if Congress did not intend the rights to return to the author, it is not apparent why it would have made the author’s survival a condition of the vesting of a second term.

B. SUBSEQUENT STATUTES AND CASE LAW PRECEDING THE 1909 ACT

In any event, courts construing the renewal term interpreted it to incorporate a reversionary right. Although early U.S. case law on reversion rights is sparse, it recognizes the second term of copyright as a “new interest” that was “made to benefit authors.”³⁶⁶ But neither the Constitution nor the 1790 Act clearly precluded the author’s advance assignment of his renewal term interest, even though such anticipatory alienability arguably defeated the

362. An Act for the Encouragement of Learning, by Securing the Copies of Maps, Charts, and Books, to the Authors and Proprietors of Such Copies, During the Times Therein Mentioned (May 31, 1790), 1 Stat. 124, ch. XV, § 1 [hereinafter 1790 Copyright Act] (emphasis added).

363. Even without statutory provision for “assigns,” the English courts held the author’s contingent interest in the second term to be assignable. *See Carnan v. Bowles*, (1786) 29 Eng. Rep. 45 (Ch.), discussed *supra* Section II.B.2.e. It is possible that this decision influenced the drafting, four years later, of the U.S. provision.

364. This construction of the text does not, however, clearly preclude first term assignments of the renewal term, or at least of a future contingent interest. *See* discussion *infra* Section III.B.

365. 1790 Copyright Act, 1 Stat. 124, § 1.

366. *Pierpont v. Fowle*, 19 F. Cas. 652, 659–60, (C.C.D. Mass. 1846).

purpose of the reversionary right: if the author's prior assignment of the second term bound the surviving author, then he would not have obtained the benefit of the renewal term.³⁶⁷ Some members of Congress appear both to have understood the statute to provide for a reversion, and to have appreciated the anomaly of its assignability, for several bills proposed in the early 1800s would have retained the reference to "assigns," but would also have provided "[t]hat any contract for the sale of the copyright for the second term of fourteen years, or any part of the same made or entered into before the expiration of the first, shall be utterly void."³⁶⁸ By clarifying that relevant "assigns" would have been new grantees for the second term of copyright, the bills would have ensured that the reversion right retained its remedial function of enabling authors to participate in the subsequent success of their works.

In its 1831 amendments to the duration of copyright, however, Congress did not explicitly address the validity of authors' advance alienation of the renewal term. The 1831 amendments extended the first term from fourteen to twenty-eight years and removed the condition that the author survive into the (still fourteen-year) renewal term, thus making compliance with relevant formalities the only remaining prerequisite to the vesting of the second term. Section 16 of the 1831 Act, covering subsisting copyrights, appears to vest the fourteen years added to the first term of copyright in the author rather than the author's grantee. The debates over this provision in the House of Representatives reinforce this conclusion.³⁶⁹ Representative Hoffman objected to the provision not only because he opposed a longer term of copyright generally, but also because section 16 "would be a breach of contract with those booksellers who had purchased copyrights of author

367. If the author received a separate consideration for conveying the future interest, the assignment would have conferred some benefit, although the parties' probable inability to anticipate the work's future value would have deprived the author of the *raison d'être* for vesting the renewal term in him. Moreover, at least as of the advent of the nineteenth-century book publishing form contract, authors' agreements systematically granted both the first and the renewal terms, without providing additional consideration for the latter. *See* discussion of publishing contracts *infra*.

368. H.R. 38, 11th Cong. (as reported to Comm. of the Whole, Jan. 19, 1811); H.R. 75, 10th Cong. (as reported to Comm. of the Whole, March 7, 1808); A Bill for the Encouragement of Learning, and for the Promotion of Useful Arts, 7th Cong. (as reported to Committee of the Whole, Jan. 19, 1803).

369. The one decision that adverts to this extension appears to assume that the author would take the additional term of years appended to the first period of copyright. *See* *Pierpont v. Fowle*, 19 F. Cas. 652, 659 (C.C.D. Mass. 1846) ("[T]he extension allowed under the act of 1831, of a copyright taken out under that act, looks entirely to the author and his family, and not to assignees.").

heretofore, and whose rights would be infringed upon, should the privileges of the authors of works be extended as proposed by the bill.”³⁷⁰ Representative Huntington’s rejoinder rhetorically inquired: “why . . . should the author who had sold his copyright a week ago, be placed in a worse situation than the author who should sell his work the day after the passing of the act?”³⁷¹ The Supreme Court has cited this objection as evidence of a long-standing practice of extending the terms of existing copyrights when Congress institutes a longer term for new works.³⁷² The passage in context seems equally (if not more so) to address the claims of authors to benefit directly from the extended term. Huntington may have assumed that the author who sold a fourteen-year copyright would have received less remuneration than an author who sold a twenty-eight-year copyright, and therefore would have objected that the publisher should not get the windfall of twenty-eight years of exclusive rights for the price of fourteen. Similarly, William Ellsworth, introducing the bill for the House Judiciary Committee asserted: “The question is, whether the author or the bookseller shall reap the reward.”³⁷³ Whether the author in fact took the fourteen years added to the first term free and clear of the grant of the initial fourteen years would have turned on the scope of the granting language.³⁷⁴

In addition, the 1831 amendments clarified who could claim the renewal term: “the same exclusive right shall be continued to such author . . . or, if dead, then to such widow and child, or children, for the further term of fourteen years”³⁷⁵ The provision was apparently designed to protect a

370. 7 CONG. DEB. app. 423 (Jan. 6, 1831).

371. *Id.* at 424.

372. *Eldred v. Ashcroft*, 537 U.S. 186, 204 (2003).

373. 7 CONG. DEB. app. cxx (Dec. 17, 1830).

374. In the early part of the 19th century, it appears that limited-term exclusive grants were more common than transfers for the full term of copyright plus any extensions or renewals. *See, e.g.*, Contract between James K. Paulding and Harper & Bros. (1836) (on file with Harper & Brothers [Publishers] Records 1817–1929, Columbia University Rare Book and Manuscript Library [hereinafter Harper & Bros. (Columbia)]) (for *The Life of Washington*) (granting Harper exclusive publication rights for ten years); Contract between Joel Parker and Harper & Bros. (1843) (on file with Harper & Bros. (Columbia), *supra*) (for *Invitations to True Happiness and Motives for Becoming a Christian*). Later contracts tended to refer to the “term” or “terms” of copyright in grant language. *See, e.g.*, Contract between Samuel J. Prime and Harper & Bros. (1854) (on file with Harper & Bros. (Columbia), *supra*) (for *Travels in Europe and the East*) (granting exclusive right to publish during the “term” of copyright); Contract between E.D.G. Prince and Harper & Bros. (1871) (on file with Harper & Bros. (Columbia), *supra*) (for *Around the World*) (granting exclusive right to publish during the “terms” of copyright).

375. An Act to Amend the Several Acts Respecting Copy Rights (Feb. 3, 1831), 4 Stat. 436, ch. XVI, § 2.

family in need, upon the death of the author.³⁷⁶ A later court perceived the amendment's designation of statutory heirs to convert the second term from a mere continuance of the author's rights—rights which the author could transfer to a publisher or other party—to a true new title:

[The 1831 Act] broke up the continuity of title, and gave the right of renewal to the widow or child or children . . . Here, then, was an entirely new policy, completely dissevering the title, breaking up the continuance in a proper sense of the word, whatever terms might be used, and vesting an absolutely new title *eo nomine* in the persons designated.³⁷⁷

While decisions construing the renewal rights of authors still alive at the vesting of the second term generally assumed that the author could convey her future interest in the renewal term, at least some courts, advertent to the intent underlying the renewal term, declined to rule that the initial assignment necessarily conveyed the renewal right as well as the first term. Thus, the author's assignment of the copyright would not suffice to convey the author's contingent interest in the renewal term. But an explicit assignment would:

It was the genius which conceived and the toil which compiled the book that is to be rewarded by even the first copyright, and no one ever dreamed that an assignee could alone take out the second or extended term, unless he has paid for it, clearly contracted for it³⁷⁸

Lower courts also acknowledged the moral claims of the author against the assignee:

376. See 7 CONG. DEB. app. at cxix (emphasizing that “by the very event of the death of the author, his family stand in more need of the only means of subsistence ordinarily left to them”), cited in Barbara Ringer, *Study No. 31, Renewal of Copyright*, in 1 STUDIES ON COPYRIGHT 503, 507 & n.13 (Arthur Fisher ed., 1963); Stenographic Report of the Proceedings of the Librarian's Conference on Copyright (Mar. 1906), in LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT, pt. C, at 35 (E. Fulton Brylawski & Abe Goldman eds., 1976), available from HeinOnline [hereinafter Stenographic Report 1906] (affirming 1831 Act's concern for author's family because the “proprietor is carefully excluded from the renewal term”). Noah Webster heavily lobbied for these family-protective provisions. See Oren Bracha, *Commentary on the Copyright Act 1831*, at 7, in PSOC, *supra* note 2, http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabeCom/%22us_1831%22.

377. *White-Smith Music Publ'g Co. v. Goff*, 187 F. 247, 250 (1st Cir. 1911).

378. *Pierpont v. Fowle*, 19 F. Cas. 652, 659–60 (C.C.D. Mass. 1846); see also *Cowen v. Banks*, 24 How. Pr. 72 (C.C.D.N.Y. 1862) (intention of parties to assign author's contingent interest in renewal term); GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF COPYRIGHT 234 (1847).

There are at least sentimental reasons for believing that Congress may have intended that the author, who according to tradition receives but little for his work, and afterwards sees large profits made out of it by publishers, should later in life be brought into his kingdom.³⁷⁹

In the course of the nineteenth century, however, publishing practices evolved to defeat authors' accession to their kingdom: the publishing form contracts that appear to have become standard by the 1870s systematically provided for the alienation of the first and the renewal terms, without any separate consideration for the latter. For example, during this period, a typical Harper & Brothers form contract included the following language:

In consideration of the premises, the Author hereby grants and assigns to Harper & Brothers an unpublished work, the subject or title of which is [name of work] and also all rights of translation, abridgement, dramatization, selection, and other rights of, in, or to said work, for the United States of America. Harper & Brothers shall also have the exclusive right in their own name to take out copyright in the United States of America for said work, and to obtain all renewals of copyright, and to hold said copyright and renewals, and to publish said work during the term or terms thereof.³⁸⁰

Leading authors might withhold the renewal term, or even provide for termination of the grant by the author earlier than the expiration of the first term,³⁸¹ but most grants included the renewal term.³⁸²

379. *White-Smith Music*, 187 F. at 251.

380. Contract between Julia Magruder and Harper & Bros. (1899) (on file with Harper & Bros. (Columbia), *supra* note 374) (for *A Manifest Destiny*). Earlier handwritten contracts did not explicitly convey rights to the renewal term, but would grant the right to publish "during the *terms* of copyright." *See, e.g.*, Contract between Mary A. Dodge and Harper & Bros. (1871) (on file with Harper & Bros. (Columbia), *supra* note 374) (for *School-House Stories*) (emphasis added). Other publishers' form contracts contained similar language. *See, e.g.*, Contract between Frances Hodgson Burnett and Charles Scribner & Sons (Dec. 3, 1895) (on file with Atkins Archive, Columbia University Rare Book and Manuscript Library [hereinafter Atkins (Columbia)]) (for *A Lady of Quality*) ("exclusive right to publish said work during the terms of copyright and renewals thereof"); Contract between same parties (June 14, 1897) (on file with Atkins (Columbia), *supra*) (for *Duke of Osmonde*) (containing the same granting language); Contract between Frances Hodgson Burnett and Holiday Publishing Co. (Sept. 7, 1900) (on file with Atkins (Columbia), *supra*) (for *The Land of the Blue Flower*) ("during the full terms of copyright of the same and all renewals thereof").

381. *See, e.g.*, Contract between Samuel Clemens and Harper & Bros. (1902) (on file with Harper & Bros. (Columbia), *supra* note 374) (for *A Double-Barrelled Detective Story*) (Clemens retained right to terminate contract beginning five years after publication); Contract between Clara Kathleen Rogers and Harper & Brothers (1892) (on file with Harper & Bros. (Columbia), *supra* note 374) (for *The Philosophy of Singing*) (exclusive publication rights to

C. 1909 ACT

1. *Legislative History*

In the 1909 Act, Congress gathered the disparate provisions sprinkling the Revised Statutes and in effect created the first federal copyright code. The term of protection and authors' reversion rights figured prominently among the reforms Congress addressed. Proposals included a bill offered in 1906 by Sen. Kittredge and Rep. Currier,³⁸³ which, for most works, would have extended the term of protection to the life of the author, plus fifty years.³⁸⁴ A section concerning "extension of term of existing copyright,"

Harper only for five years); Contract between N. Otis and Harper & Bros. (1862) (on file with Harper & Bros. (Columbia), *supra* note 374) (for *Illustrated History of the Panama Rail*).

382. Even when the statutory heirs renewed the copyright and thus enjoyed a "new estate" superseding prior contracts, grantees appear at least at times to have continued to exploit the work as if no reversion had vested. *See, e.g.*, Letter from Harper & Bros. to John C. Howard (May 26, 1919) (on file with Harper & Bros. (Columbia), *supra* note 374) (explaining that although author died in 1911 during first term of works created between 1985 and 1900, when representative of widow wrote to inquire about copyright renewal and royalties during the renewal term, Harper responded that the copyrights "will be renewed by us in the regular way, in the name of the nearest kin").

The form contracts, and early 1870s handwritten contracts, did contain out-of-print clauses returning the copyright to authors if the books proved unsuccessful. *See, e.g.*, Contract between Sarah Randolph and Harper & Bros. (1871) (on file with Harper & Bros. (Columbia), *supra* note 374) (for *The Domestic Life of Thomas Jefferson*) (giving Harper & Bros. the right to cancel for lack of demand beginning five years after publication). Because the copyrights in out-of-print books were rarely renewed, the statutory reversion right, albeit available to the author, would not have mattered.

Although out-of-print clauses were a form of reversion, contractual rather than statutory in nature, publishers, rather than authors, appear to have had the most to gain from allowing the author to recapture her copyright. Once the rights reverted, the publisher saved the expenses of keeping and mailing detailed royalty records. *See* MICHAEL WINSHIP, *AMERICAN LITERARY PUBLISHING IN THE MID-NINETEENTH CENTURY: THE BUSINESS OF TICKNOR AND FIELDS* 35 (1995); mailing other communications to authors, *id.* at 184 (citing postage as the largest of miscellaneous overhead expenses), business tax on inventory items, *id.*, and costs of warehousing and concomitant efforts for "tighter inventory control." ALEXIS WEEDON, *VICTORIAN PUBLISHING: THE ECONOMICS OF BOOK PRODUCTION FOR A MASS MARKET, 1836–1916*, at 63, 103 (2003). Out-of-print clauses also allowed publishers to destroy plates and extra stock if the author declined to purchase them. The publisher also enjoyed the right to sell copies free of any royalties if author did not purchase the stock.

383. S. 6330, 59th Cong. § 18 (1906). This bill was the product of the Librarian of Congress's Conference on Copyright, at which participants worked from a memorandum draft prepared by Thorvald Solberg, Register of Copyrights. Stenographic Report of the Proceedings of the Librarian's Conference on Copyright (Nov. 1905), *in* LEGISLATIVE HISTORY, *supra* note 376, pt. D, at xv–lxxv [hereinafter Stenographic Report 1905]. The bill is thus generally referred to as the Solberg Bill.

384. S. 6330 § 18(c). Other terms were provided for labels on manufacturing items (twenty-eight years from publication) and composite works (fifty years from publication).

would have extended subsisting copyrights (then protected for a first term of twenty-eight years, renewable for another fourteen) “to endure for the full terms of copyright provided by this Act, for the sole use of the author of said work, if he be living.”³⁸⁵ The proposal further limited the rights of authors’ assignees to:

such term as the said assignee would have been entitled to hold and possess the same under the copyright laws in force on the day of the date of said assignment, and no longer. [The] remainder of said term of copyright shall revert to and vest in the author of the work, if he be living.³⁸⁶

Thus, the extension of the term of works then in their first or second periods would clearly, and consistently with the Constitutional direction, have gone “to Authors.”

Authors’ assignees—publishers—while purporting to endorse the vesting of the extended term in living authors, objected to the next iteration of the proposal, which would also have granted the “remainder of said term” to authors’ “heirs, executors, and administrators.”³⁸⁷ The Publishers Copyright League therefore proposed to substitute a second renewal term, following the then-current fourteen-year term, allowing subsisting copyrights to:

be further renewed and extended by the author, inventor or designer if he be still living, or by his widow or children if he be dead, for a further period equal to that provided under the present act, i.e. for fifty years after the author’s death, provided that the said copyright has not been assigned previous to the passage and approval of this act.³⁸⁸

The publishers claimed that the amendment, by limiting post-mortem beneficiaries to the author’s surviving spouse and children (as had the 1831 Act), would allay the publishers’ fears of having to come to agreements with a plethora of heirs, who, lacking the personal relationship with the publisher that would make the author or her family more likely to “show themselves reasonable in the matter of the protection of this invested property” (by the publisher in creating plates for the printing of the books), would instead

385. Stenographic Report 1905, *supra* note 383, at 219–20 (proposed § 53(a)).

386. *Id.* at 220 (proposed § 53(b), (c)).

387. Stenographic Report 1905, *supra* note 383, at 297 (proposed §§ 67, 298) (George Haven Putnam stating: “The publishers endorse this”).

388. *Id.* at 299.

“insist upon securing a bonus before he would permit the publisher to continue under the extended term the publication of those books.”³⁸⁹

The amendment in fact would have given the publishers something they had not clearly obtained in prior legislation, however: explicit statutory recognition that the author’s assignment of her copyright would also convey any renewals or extensions of the copyright term. While the representative of the American Authors Copyright League did not initially perceive the wolf in the sheep’s clothing of an amendment offered in the publishers’ professed “willing[ness] that they [authors] should have the full benefit of this extension of those copyrights,”³⁹⁰ the reference to assignments did not escape the notice of another participant in the discussions. Arthur Steuart, Chairman of the American Bar Association, aptly characterized the term extension as “for the benefit of the publisher.”³⁹¹

The ensuing discussion regarding rights of publishers versus authors is somewhat confusing. The participants asserted different renewal consequences to publishing agreements in which authors retained their copyrights but granted publishing rights in return for royalties, and outright assignments, with the latter lending themselves to an impasse if the copyright reverted to an author or heir who declined to re-grant the copyright, leaving the publisher with plates it could not use. In the latter instance, publishers would even have preferred to let the work go into the public domain, so that they could continue to exploit their investment in the plates (even if rival publishers could also then go to the expense of setting their own plates).³⁹² The compromise amendment retained much of the renewal language of the 1831 Act, but would have required that any assignee or licensee have joined the renewal application.³⁹³ An extended term contingent on the author’s (or heir’s) and publisher’s “mak[ing] some new arrangement between

389. *Id.* at 298–99 (characterizing the bonus-demanding heir as an “obstructing child”).

390. *Id.* at 299–300 (R.R. Bowker for the authors pronounced the publishers’ proposal “perfectly acceptable”).

391. *Id.* at 300.

392. *Id.* at 300–03.

393. The Solberg Bill read, in relevant part:

[T]he copyright subsisting in any work at the time when this act goes into effect may . . . Be further renewed and extended by the author . . . or if he be dead, leaving a widow, by his widow . . . Or if now widow survive him, by his children . . . provided further, that should such subsisting copyright have been assigned, or a license granted therein for publication upon payment of royalty, the copyright shall be renewed and extended only in case the assignee or licensee shall join in the application for such renewal and extension.

S. 6330, 59th Cong. § 18.

themselves” eased the publishers’ apprehension of being held up by authors.³⁹⁴

Before long, however, critics pointed out the compromise’s susceptibility to the opposite abuse, indeed that the “law [would] simply result in a legalized system of blackmail—nothing more or less”³⁹⁵:

Let us assume that this bill passes, that a copyright expires next year, and that I am the author of a certain book. I go to my publisher and say: “Here under the law I am entitled to a renewal of the copyright for my book for a term of fifty years in all, or during my life, or whatever the term may be.” The publisher replies: “Very well: you want me to join in the securing of that extension, do you?” “Yes.” “Well, I have been paying you 20 per cent royalty: I will pay you 2 per cent hereafter, and if you do not take that I will pay you nothing.”³⁹⁶

The following year, the Monroe-Smith Amendment to the Kittredge-Barchfeld Bill responded, incompletely, to the criticisms the prior bill had attracted. It provided for authors’ reversions, but only if there was no royalty agreement or if the publisher refused to continue to pay the same percentage as set out in the existing royalty agreement.³⁹⁷ The rationale for excluding

394. Stenographic Report 1906, *supra* note 376, at 302 (“if they be reasonable people, they ought to be able to work out some fair settlement”).

395. *To Amend and Consolidate the Acts Respecting Copyright: Hearings on S. 6330 and H.R. 19853 Before the H. and S. Comm. on Patents*, 59th Cong. (Dec. 1906) [hereinafter *Hearings* (Dec. 1906)] (statement of George W. Ogilvie, publisher from Chicago).

396. *To Amend and Consolidate the Acts Respecting Copyright: Hearings on S. 6330 and H.R. 19853 Before the H. and S. Comm. on Patents*, 59th Cong. (June 1906) [hereinafter *Hearings* (June 1906)] (statement of George W. Ogilvie, publisher from Chicago).

397. The Monroe-Smith Amendment read, in relevant part:

[I]f such subsisting copyright shall have been assigned or a license granted therein for publication, and if such assignment or license shall contain provision for payment of royalty. . . . Said original assignee or licensee or his successor shall nevertheless be entitled to continue to publish the work on payment of the royalty stipulated in the original agreement; but if such original assignment or license contain no provision for the payment of royalty, the copyright shall be renewed and extended only in case the original assignee or licensee or his successor shall join in the application for such renewal and extension.

S. 2900, 60th Cong. (1907); H.R. 11794, 60th Cong. (1908).

Another bill, the Smoot-Currier Bill, read, in relevant part:

[T]he copyright subsisting in any work at the time when this act goes into effect may Be further renewed and extended by the author . . . or if he be dead, leaving a widow, by his widow Or if now widow survive him, by his children . . . provided further, that should such subsisting copyright have been assigned, or a license granted therein for publication upon payment of royalty, the copyright shall be renewed and extended

royalty agreements from the application of the author's reversion right is consistent with the purpose of the right, to allow authors to share in the future success of their works. While authors who assigned rights for a lump sum would not participate in future revenues, authors receiving a royalty would; moreover, the bill endeavored to ensure that those authors' royalties would remain constant. On the other hand, while rights could revert to authors who had received lump sums, the reversion was conditioned on filing a renewal application jointly with the original assignee or its successor. Thus, this version of the bill explicitly continued the rights of assignees whose contracts provided for payment of royalties, while leaving in place the means for assignees who had paid a lump sum for the copyrights to "blackmail" authors who sought to renew the copyright for the extended term.

Subsequent hearings on the precursors to the 1909 Act indicate that the drafters understood the importance to authors of renewal term reversions of rights. The Patents Committee Chair, Rep. Currier, repeatedly stressed the example of Mark Twain, who had sold the first term of copyright in *Innocents Abroad* "for a very small sum," but whose "contract did not cover the renewal period, and in the fourteen years of the renewal period he was able to get out of it all of the profits."³⁹⁸ The drafters abandoned the requirement that assignees join the authors on any renewal application in favor of leaving the transfer of renewal or extended term rights to the parties' contractual arrangements.³⁹⁹ It is not clear from the hearings whether those arrangements included contracts that assigned the extended term in advance of its vesting. At least one participant stressed that the Constitution states that Congressional grants of copyright are to go "to Authors,"⁴⁰⁰ and another expressed "doubt about whether it [validating advance assignments] legally could be done"; moreover he urged that the bill "say that it cannot be done,

only in case the assignee of licensee shall join in the application for such renewal and extension.

Smoot-Currier Bill, S. 2499, 60th Cong. (1907); H.R. 243, 60th Cong. (1907).

398. *To Amend and Consolidate the Acts Respecting Copyright: Hearings on S. 6330 and H.R. 19853 Before the H. and S. Comm. on Patents*, 59th Cong. 20(1908) [hereinafter *Hearings* (1908)]; see also *id.* at 62.

399. See *Hearings* (Dec. 1906), *supra* note 395, at 48 (statement of George Ogilvie) (admitting that "the amendment I suggested in June is impractical"); *Hearings* (1908), *supra* note 398, at 72 (statement of George Ogilvie) (noting that, in his decision to turn against the joint-application proposal, "there was a little bit of conscience mixed up in the matter"); *id.* at 128 (statement of William Jenner) (discussing contracts for extended term).

400. *Hearings* (June 1906), *supra* note 396, at 48 (statement of George Ogilvie).

so that the author is certain to have that extension as a provision for his age or a provision for his widow and his children.”⁴⁰¹

The vesting of the extended term, or of an additional renewal term in authors, presented additional problems in the case of multiple-authored works, particularly encyclopedias and other composite works. Publishers testified to the difficulty of locating and obtaining new assignments from the authors of such contributions, and stressed their need to retain copyright in the contributions throughout any extensions or renewals of the copyright term.⁴⁰²

As enacted, the 1909 Act largely retained the approach of the 1831 Act, and, rather than adopting a unitary term of years based on the life of the author, added another fourteen years to the renewal term, for a total of two twenty-eight-year terms or, assuming renewal was effected, fifty-six years from first publication.⁴⁰³ With respect to works already in their renewal term, Congress extended their renewal terms so that the works would enjoy a total of fifty-six years of protection.⁴⁰⁴ Notwithstanding the earlier debates over the beneficiary of term extension (or perhaps because of them), the text did not specify whether the additional years should vest initially in the author or automatically in the rightholder, nor did the statute address the advance assignability of the fourteen-year extension of the second term of copyright for existing works or of the twenty-eight-year renewal term for new works. One passage of the House Report appears to support the inalienability of the renewal term:

Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right.⁴⁰⁵

401. *Hearings* (1908), *supra* note 398, at 128 (statement of William Jenner).

402. *Hearings* (1908), *supra* note 398, at 18–19 (statement of George Haven Putnam, Secretary of American Publishers Copyright League); *id.* at 109 (statement of W.A. Livingstone, Print Publishers’ Association).

403. An Act to Amend and Consolidate the Acts Respecting Copyright (Mar. 4, 1909), 35 Stat. 1075, ch. CCCXX, § 24 [hereinafter Act of March 4, 1909].

404. *Id.* § 23.

405. H.R. REP. NO. 60-2222, at 14 (1909).

But the reference to “the existing law” undermines the argument for inalienability: under the 1831 Act, the practice, and considerable authority both from caselaw and treatises, recognized that the author might bind himself to assign the renewal term, at least if his contract clearly so provided.⁴⁰⁶

Sections 24 and 23 of the Act (addressing new and subsisting works, respectively) both contained the following language:

[T]he author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widowers or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work⁴⁰⁷

Thus, like the 1831 Act, the 1909 Act provided widows and children with renewal rights even after the death of the author. The 1909 Act, however, added rights for executors and next of kin after the death of the widow and children.

Responding to the concerns expressed by publishers of encyclopedias and other composite works, the 1909 Act also listed certain categories of works whose creators would not be vested with the renewal right. Rather, the “proprietors” would take the renewal. For works published as of the Act's effective date, proprietors received renewal rights for posthumous works, periodicals, encyclopedias, and composite works, corporate bodies having copyrighted works, and employers in cases of works-for-hire.⁴⁰⁸ For subsisting works, renewal rights were given only to proprietors of composite

406. See sources cited *supra* note 274; EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES: EMBRACING COPYRIGHT IN WORKS OF LITERATURE AND ART, AND PLAYRIGHT IN DRAMATIC AND MUSICAL COMPOSITION 326–32 (n.p. 1879).

407. Act of March 4, 1909, 35 Stat. 1075, ch. CCCXX, §§ 23, 24.

408. Section 23, on new works, reads:

That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body . . . or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright”

Act of March 4, 1909, 35 Stat. 1075, ch. CCCXX, § 23; see also Catherine L. Fisk, *Authors at Work: The Origins of the Work-for-Hire Doctrine*, 15 YALE J.L. & HUMAN. 1, 62–67 (2003).

works.⁴⁰⁹ This distinction has been attributed either to solicitude for the future interests of the families of authors whose works were published under the prior regime, or simply to careless drafting.⁴¹⁰ Even if the 1909 Act preserved some authors' renewal rights in subsisting works, it appears that, relative to prior enactments, the 1909 Act narrowed the scope of works in which authors could claim renewal term reversions of rights, particularly with respect to contributions to collective works.

2. *The 1909 Act Renewal Term in Court: To Authors or To Their Assigns?*

While the 1909 Act did not expressly resolve the assignability of the renewal term, the Supreme Court, in a controversy involving the song "When Irish Eyes Are Smiling," ultimately ruled that the author's first-term assignment of the second term bound him to convey the renewal term to the original publisher. Justice Frankfurter, finding no explicit statutory limitation on the author's advance assignment of the renewal term, showed no solicitude for the plight of the author, finding no reason, "sentimental"⁴¹¹ or practical, for constraining the author's freedom to contract away his renewal rights:

We are asked to recognize that authors are congenitally irresponsible, that frequently they are so sorely pressed for funds that they are willing to sell their work for a mere pittance, and therefore assignments made by them should not be upheld We cannot draw a principle of law from the familiar stories of garret-poverty of some men of literary genius We do not have such assured knowledge about authorship . . . or the psychology of gifted writers and composers, as to justify us as judges in importing into Congressional legislation a denial to authors of the freedom to dispose of their property possessed by others. While authors may have habits making for intermittent want, they may have no less a spirit of independence which would resent treatment of them as wards under guardianship of the law.⁴¹²

409. Section 24, on subsisting works, reads: "[I]f the work be a composite work upon which copyright was originally secured by the proprietor thereof, then such proprietor shall be entitled to the privilege of renewal and extension granted under this section." Act of March 4, 1909, 35 Stat. 1075, ch. CCCXX, § 24.

410. See Ringer, *supra* note 376, at 123.

411. *White-Smith Music Publ'g Co. v. Goff*, 187 F. 247, 251 (1st Cir. 1911).

412. *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643, 656 (1943). The Supreme Court majority thus made short work of Judge Frank's extensive critique in dissent below of "laissez faire" approaches to contract. See *M. Witmark & Sons v. Fred Fisher Music Co.*, 125 F.2d 949, 954-69 (1942) (Frank, J., dissenting).

Because most book publishing contracts routinely—since at least the 1870s—systematically and explicitly conveyed both the first and the renewal terms,⁴¹³ generally with no separate consideration for the latter, the Court's ruling validated industry practice but also ensured that authors by and large would not be “brought into [their] kingdom,”⁴¹⁴ nor even into a minor freehold.

By contrast, the Supreme Court also ruled that the author's statutory heirs took the renewal term free of the decedent's grant (improvident or otherwise). Unsentimental as ever, the Court did not advert to congressional policy to protect widows and orphans (though this concern almost certainly animated the 1831 law and its successor provisions in the 1909 Act), but rather dryly characterized the author's prior grant as a mere “expectancy,” thus making the original grantee's acquisition of the renewal term contingent on the author's survival.⁴¹⁵ Not surprisingly, it became industry practice in some sectors to condition payment for the author's grant of copyright on the author's obtaining assignments to the publisher of her statutory heirs' contingent interests in the renewal term.⁴¹⁶

If the contract of transfer did not, however, explicitly cover the renewal term, many courts declined to deem it included within the scope of the grant. As the Second Circuit noted, in a case involving a grant of “full ownership . . . in all countries of the world” of the copyright in a musical composition, “[t]he presumption against conveyance of renewal rights serves the congressional purpose of protecting authors' entitlement to receive new rights in the 28th year of the original term.”⁴¹⁷ Thus, an assignment of rights in the copyright term would not suffice to convey the renewal term rights.⁴¹⁸

413. See Harper & Bros, Scribner, and Holiday Publishing Contracts, *supra* note 374.

414. *White-Smith Music*, 187 F. at 251.

415. *Miller Music Corp. v. Charles N. Daniels, Inc.*, 362 U.S. 373, 375 (1960).

416. Interview with Irwin Robinson, former President, EMI Music Publ'g (Jan. 14, 2010); Interview with Jay Morgenstern, Exec. Vice President/Gen. Manager, Warner Chappell Music Inc. (Nov. 25, 2009). The practice of obtaining assignments from contingent heirs did not always ensure the grantee's acquisition of the renewal term, for example, if on the author's death his wife was pregnant and the renewal term had not yet vested. E-mail to Jane Ginsburg from Jay Morgenstern (June 8, 2010) (“[T]he studio demanded all of the signatures and we were able to comply. [Then] the author died while his wife was expecting. Everybody at the studio went into cardiac arrest thinking that the new heir could renege on the license at reversionary time.”); see also *Report of the Register of Copyrights on the General Revision of U.S. Copyright Law*, in *STUDIES ON COPYRIGHT*, *supra* note 376, at 1199, 1253 [hereinafter *Report of the Register*] (“A considerable amount of trafficking in the possible future renewal rights of authors and their prospective heirs has grown up.”).

417. *Corcovado Music Corp. v. Hollis Music, Inc.*, 981 F.2d 679, 684 (2d Cir. 1993).

418. See, e.g., *Edward B. Marks Music Corp. v. Charles K. Harris Music Publ'g Co.*, 255 F.2d 518, 521 (2d Cir. 1958) (“The cases are clear that a copyright renewal creates a separate

Similarly, because the renewal term was considered a “separate interest,” courts protective of authors’ reversion rights might interpret a grant of “all right, title and interest in and to the copyright” to apply only to the first term.⁴¹⁹ On the other hand, contract language, even if lacking the specification “all renewals and extensions thereof,” but which denoted intent to transfer the renewal term, such as “exclusive right to . . . use . . . forever,” could rebut the presumption.⁴²⁰

D. REVERSION RIGHTS UNDER THE 1976 COPYRIGHT ACT

Against this background, when Congress finally revised the copyright law, its provision in the 1976 Act of an inalienable termination right stood out as a signal victory for authors. But, as examination of the text and experience to date will show, the 1976 Act imposes many practical impediments to successful exercise of the termination right. First, we will summarize the genesis of the termination right with respect both to works published before 1978 and to grants of rights (whether in works published before 1978 or created after that date) made as of 1978. Then, in Section E, we will examine how the termination right has been working in practice.

1. *Termination of Contracts Concluded Under the 1976 Copyright Act*

In the 1976 Act, Congress abandoned the two-term copyright scheme, and for new works adopted the by-then international standard of the life of the author plus fifty years. (In 1998, Congress extended the term of copyright to life of the author plus seventy years.) Although the renewal term which had triggered the reversion right would no longer exist, Congress determined to retain a reversion right, and pegged it to the date of conclusion of a grant of rights under copyright, with the right coming into effect from thirty-five to forty years from that date (subject to no fewer than two and no more than ten years’ advance notification).⁴²¹

Some kind of reversion right figured in every copyright bill leading up to the 1976 final version. In the initial *Report of the Register of Copyrights on the*

interest distinct from the original copyright and that a general transfer by an author of the original copyright without mention of renewal rights conveys no interest in the renewal rights without proof of a contrary intention.”); *cf.* sources cited *supra* note 378 (requiring specificity in assignment of renewal term interests under prior Acts).

419. *See, e.g.*, *Rossiter v. Vogel*, 134 F.2d 908, 911 (2d Cir. 1943) (holding “all right, title and interest” transfer at outset of first copyright term insufficient to convey renewal term: “the circumstances justifying the transfer of the right of renewal must be stronger than those justifying the transfer of the copyright, since the right of renewal is separate from the original copyright”).

420. *Siegel v. Nat’l Periodical Publ’ns, Inc.*, 508 F.2d 909, 913–14 (2d Cir. 1974).

421. *See* 17 U.S.C. § 203 (2006).

General Revision of U.S. Copyright Law,⁴²² the Register called for automatic reversion twenty years following the conclusion of a grant, unless the grant provided for continuing royalty payments to the author:

[t]he statute should provide that any assignment by an author or his representative or heirs shall not be effective for more than twenty years from the date of its execution, unless it provides for the continuing payment of royalties based on the uses made of the work or the revenue derived from it.⁴²³

The Register's report both harked back to one of the proposals preceding the 1909 Act, which would have exempted royalty agreements from termination upon the vesting of the renewal term,⁴²⁴ and partly echoed copyright legislation in other countries, notably France, which required authors' contracts to provide for a royalty for every mode of exploitation.⁴²⁵ But author groups persuaded the Register that the royalties safeguard was "illusory, since the royalties could be nominal and the proposal could easily be evaded."⁴²⁶

The Register's Preliminary Draft Bill two years later thus offered two very different alternative approaches. "Alternative A" provided for automatic reversion twenty-five years after transfer "notwithstanding any agreement to the contrary."⁴²⁷ Offsetting the gain to authors of an automatic and inalienable reversion right, the proposal excluded works-for-hire and provided an exception allowing the continued exploitation of derivative works created prior to termination.⁴²⁸ "Alternative B" focused on

422. *Report of the Register*, *supra* note 416, at 1292–94 (calling for "protection of authors against unremunerative transfers"). Section 16 would go on to become § 203 of the 1976 Act. *See* An Act for the General Revision of the Copyright Law, Title 17 of the United States Code, and for Other Purposes, 90 Stat. 2541, 2569 (1976) [hereinafter 1976 Act]. Section 22, which became § 304, is addressed below.

423. *Report of the Register*, *supra* note 416, at 1292–94.

424. *See* discussion *supra* Section III.C.1.

425. *See* Copyright law of 1957, arts. 31, 35 (now Code de la propriété intellectuelle, arts. L. 131-3, 131-4) [hereinafter Copyright law (France)]. The Register's Report took care to add, however, "[w]e would encourage the compensation of authors on a royalty basis but we would not forbid lump-sum transfers." *Report of the Register*, *supra* note 416, at 1293. On the other hand, the French law also acknowledged certain instances of permissible lump sum transfers as well. *See* Copyright law (France), art. 35 (now CPI art. L. 131-4).

426. REGISTER OF COPYRIGHTS, COPYRIGHT LAW REVISION PT. 3, PRELIMINARY DRAFT FOR REVISED U.S. COPYRIGHT LAW AND DISCUSSION AND COMMENTS ON THE DRAFT, 88TH CONG., 2D SESS., at 278 (Comm. Print 1964) [hereinafter COPYRIGHT LAW REVISION PT. 3] (statement of Barbara Ringer).

427. *Id.* at 16.

428. *Id.* at 15–16.

“unremunerative transfers,” allowing the author to terminate twenty years after the transfer. If “the profits received by the transferee or his successors in title are strikingly disproportionate to the compensation, consideration, or share received by the author or his successors, action may be brought in any court mentioned in section 1338 of Title 28 to reform or terminate said transfer.”⁴²⁹

While Alternative B in theory captured the *raison d'être* for the termination right—to redress the imbalance when the author has sold her copyright for a pittance and the publisher reaps all the reward if the work proves successful—the “strikingly disproportionate” standard would have invited expensive and inconclusive litigation.⁴³⁰ The proposal accordingly garnered little support.⁴³¹ With respect to Alternative A, even with its concessions on works-for-hire and derivative works (the former at least in part an accommodation of the transactions costs problem arising with multiple-authored works; the latter a recognition of the reliance interests in the investments made to create derivative works such as motion pictures), the proposal proved too radical for publisher interests who decried “another example of slapping the publishers down, but in this instance the slap would be so violent as to drain the very lifeblood of the industry.”⁴³²

The following year the Revision Bills introduced in Congress⁴³³ retreated from two of the Preliminary Draft’s most author-favorable provisions: they made termination optional rather than automatic, and they delayed vesting of the termination right from twenty to thirty-five years following execution of the contract. On the other hand, the 1964 Bill retained the inalienable character of the termination right, and clarified the scope of its application: “The termination may be effected notwithstanding any agreement to the contrary, including an agreement to make a will or to make any other future transfer.”⁴³⁴ Both authors and publishers found the changes objectionable. The Authors League of America considered thirty-five years too long to wait

429. *Id.* at 16.

430. *Id.*

431. *See, e.g., id.* at 250 (American Book Publishers Council: “The second alternative would, in addition, be extremely impractical in terms of its open invitation to endless and costly litigation in which the publishers might well find themselves at the mercy of the courts, which would have no objective standard to guide them.”).

432. *Id.* at 318 (Music Publishers’ Protective Association).

433. S. 3008, H.R. 11947, 88th Cong., (1964); H.R. 12354, 88th Cong., (1964).

434. REGISTER OF COPYRIGHTS, COPYRIGHT LAW REVISION PT. 5, 1964 REVISION BILL WITH DISCUSSION AND COMMENTS, 89TH CONG., 1ST SESS., at 10 (Comm. Print 1964) [hereinafter COPYRIGHT LAW REVISION PT. 5]; *see also* COPYRIGHT LAW REVISION PT. 3, *supra* note 426, at 402–03 (suggestions of Prof. Melville Nimmer).

for termination rights,⁴³⁵ and feared that the exemption for works-for-hire would encourage publishers to press authors to sign work-for-hire agreements.⁴³⁶ The American Book Publishers Council proved no happier: “There is no adequate reason why the well-entrenched doctrine of non-governmental interference with freedom of contract should not be applied to this situation.”⁴³⁷ The Council dismissed arguments grounded in authors’ inferior bargaining positions; they emphasized authors’ representation by literary agents, and noted: “As a matter of fact, if an author’s first book sells well, usually other publishers bid for him and his original publisher must bargain competitively or lose the author.”⁴³⁸

Despite the publishers’ bid to eliminate reversion rights, subsequent bills continued to include both the right and the “notwithstanding any agreement to the contrary” proviso.⁴³⁹ The termination right was made applicable to “the exclusive or nonexclusive grant of a transfer or license,”⁴⁴⁰ and the timeframe for effecting the termination was limited to five years beginning thirty-five years after transfer.⁴⁴¹ Thus, the exercise of the termination right became progressively less author-favorable. It began as a right that vested automatically twenty, then thirty-five, years from the conclusion of the contract; it next would have vested only if the author exercised his right (continued rights of exploitation thus by default remaining with the assignees); and finally, through the addition of the five-year deadline, it fell subject to a use-it-or-lose-it regime. These compromises, together with the exclusion of works-for-hire and previously created derivative works from the scope of the termination, made the termination right palatable to publishers and motion picture producers.⁴⁴²

435. COPYRIGHT LAW REVISION PT. 5, *supra* note 434, at 239.

436. *Id.* at 156 (statement of Irwin Karp on behalf of Authors League). The concern may have been overstated, in light of the 1976 Act’s restriction of works-for-hire to employee works or only certain specially ordered works, and subject to a signed writing. *Id.* at 145 (testimony of Barbara Ringer concerning author-favorable change in definition of works-for-hire). On the other hand, the concern may have been prescient. *See* *Marvel Characters, Inc. v. Simon*, 310 F.3d 280, 292 (2d Cir. 2002) (retroactively deeming work a “work for hire” constitutes impermissible agreement contrary to termination right).

437. COPYRIGHT LAW REVISION PT. 5, *supra* note 434, at 225.

438. *Id.*

439. H.R. 4347, 89th Cong., § 16(a)(4) (as introduced Feb. 4, 1965).

440. *Id.* § 203(a).

441. *Id.* § 203(a)(2) (with slight variation for grants for right of first publication).

442. *Hearings on Copyright Law Revision Before Subcomm. No. 3 of the H. Comm. on the Judiciary*, 89th Cong. 98 (1965) (Memorandum Statement by the Copyright Comm. of the Motion Picture Association of America, Inc. on H.R. 4347) (“Although we are still strongly opposed in principle to the very concept of statutory recapture in any form, the compromise worked out, after much travail, in H.R. 4347, is a minimal basis on which we can learn to live with

At least one issue remained in dispute—namely, whether unanimity was required among joint authors and/or their heirs to exercise the termination right. Motion picture producers pushed for unanimity,⁴⁴³ while authors' groups contended that such a requirement would likely render the exercise of the right in co-authored works unworkable.⁴⁴⁴ The Authors League thus urged that a majority of those sharing the copyright be sufficient.⁴⁴⁵ The following year's bill awarded the round to the authors, allowing exercise of termination by a "majority of the authors"⁴⁴⁶ and working through the portion of the termination interest the widow(er) and each of the children would hold.⁴⁴⁷ By 1966, Congress had settled most of the details of the 1976 Act termination provisions respecting contracts entered into as of its effective date.

2. *Reversion Rights in Works Whose 1909 Act Copyrights Were Still Subsisting*

For works published before 1978, Congress extended the term of copyright by adding nineteen years to the twenty-eight-year renewal term for a total of seventy-five years of protection from publication.⁴⁴⁸ Congress then confronted the question of the beneficiary of the additional nineteen years, an issue raised as early as the Register's 1961 Report. Without explicitly advertent to the Constitution's authorization to Congress to secure exclusive rights "to Authors," the Register acknowledged that "there would be little justification for lengthening the term unless the author or his heirs were to receive some benefit from it."⁴⁴⁹ The Register initially recommended an automatic reversion at the end of the twenty-eighth year of the renewal term, but only for works for which the author was not receiving royalties.⁴⁵⁰ In the course of the revision bills, however, the same compromises that trimmed the statutory termination right for post-1977 contracts also whittled down the reversion right attached to the "extended renewal term."⁴⁵¹ Thus,

such a provision, and accept the same in the interests of furthering an adequate revision statute.").

443. *Id.* at 996–98.

444. *Id.* at 94 (Prepared Statement of Rex Stout on Behalf of the Authors League of America) ("one of several children of a deceased author" could prevent his mother and siblings, or even the still-living co-authors of a work from exercising termination rights).

445. *Id.*

446. H.R. 4347, 89th Cong., § 203(a)(1) (as reported by Judiciary Comm., Oct. 12, 1966).

447. § 203(a)(2).

448. 17 U.S.C. § 304(a) (2006).

449. *Report of the Register, supra* note 416, at 1258.

450. *Id.*

451. 17 U.S.C. § 304(c).

“proprietors” who under the 1909 Act were entitled to effect the renewals, remained in title throughout the extended renewal period as well, and the scope of the reversion right excluded pre-existing derivative works.⁴⁵² By contrast, under the 1909 Act, the renewal term (if not contracted away) entitled authors to retrieve their copyrights free and clear of all prior grants; thus, the copyright owners of any derivative works created under the authority of the first-term grant would be obliged to negotiate with the owner of the renewal term rights in the underlying work.⁴⁵³ And, as with termination of post-1977 contracts, the extended renewal term reversion right did not attach automatically; the author (or her heirs) was obliged to effect the termination, within a specified time period, otherwise the previously transferred rights would remain with the grantee for the remaining duration of copyright.⁴⁵⁴

When Congress in 1998 added another twenty years to the terms of extant copyrights, it gave the authors (or heirs) of works published before 1978 another opportunity to terminate grants during the last twenty years, but only so long as they had not previously terminated grants at the outset of the prior nineteen-year extension.⁴⁵⁵ As a result, as between the two term extensions, authors may only once recapture rights they assigned or licensed.⁴⁵⁶ The grantee who negotiated rights for the first extended renewal term of nineteen years thus would reap thirty-nine years of exclusive rights for the price of nineteen. In such instances, one may query whether Congress has “secur[ed]” the term extension “to Authors.” If compliance with the constitutional clause was already attenuated under the use-it-or-lose-it recapture provisions accompanying the nineteen-year renewal term extension, the exclusion of many authors from the twenty-year renewal term extension seems even less compatible with the constitutional charge.⁴⁵⁷

452. See §§ 203(b)(1), 304(c)(6)(A) (2006).

453. See, e.g., *Stewart v. Abend*, 495 U.S. 207 (1990) (addressing the renewed copyright in short story on which film *Rear Window* was based). In 1992, Congress amended § 304(a) of the Copyright Act to provide for automatic renewal of copyright registrations. If the author or her heirs effect the registration, all renewal term rights, including in derivative works, will vest; if the renewal is automatic, the first-term grantee of derivative work rights is permitted to continue to exploit the pre-existing derivative work during the renewal term and its extensions. See 17 U.S.C. § 304(a)(4)(A).

454. § 304(c).

455. See § 304(c), (d).

456. § 304(d).

457. See, e.g., *Hearing on S. 483 Before the S. Comm. on the Judiciary*, 104th Cong. 112 (1995) (Register of Copyright Marybeth Peters' response to challenge on “to Authors” issue); *id.* at 117 (Comm'r of Patents and Trademarks Bruce Lehman's response to challenge on “to Authors” issue); *id.* at 165 (statement of Prof. William Patry) (“[M]usic publishers have let it

3. *No Reversion Rights in Unpublished Works*

The 1909 Act reversion right and its extensions in the 1976 Act all are tied to the renewal term following the first twenty-eight-year term. The 1976 Act and 1998 Copyright Term Extension Act amendments' reversions are both a recapture of rights during the extended renewal term. But the renewal term follows an initial twenty-eight-year period that, unless the work was registered as an unpublished work, began upon publication. If the author granted derivative work rights in an unpublished work—for example, a grant of motion picture rights in an unpublished play or story—the underlying work would remain unpublished, and no renewal term would ever attach.⁴⁵⁸ Thus, while the 1909 Act renewal term reversion did not include the derivative works carve-out the motion picture producers demanded for the 1976 Act, to the extent the producers based their films on prior unpublished works that were not works made for hire, they would have limited their exposure to hold-up from the authors of underlying works. By contrast, because the 1976 Act provisions on termination of grants thirty-five years following their conclusion do not distinguish between published and unpublished underlying works, the perceived need for a derivative works carve-out becomes apparent.

be known they would oppose any bill that gives the [extended] copyright to authors. This assertion, if true, demonstrates how far S. 483 as drafted departs from the constitutional goal of protecting authors.”); S. REP. NO. 104-315, at 33–34 (1996) (minority views of Sen. Hank Brown) (arguing that CTEA “does not secure the copyright to authors. Instead it secures the extended monopoly grant to the current owners of the copyright”).

458. See, e.g., *Copyright Office Assignments of Copyright*, 186 PHOTOSTAT COPIES 141 (grant from Vin Moore to Universal Picture Corp, 30 Aug. 1927, of all rights, “forever” in unpublished story “Ocean Bruisers”); *id.* at 47 (grant from Agnes Christine Johnston to Columbia Pictures Corp., September 20, 1927, of motion picture rights in unpublished original dramatic composition “The Kiss”); see also *Paige v. Banks*, 80 U.S. 608, 616 (1871) (finding no reversion right because publisher received unpublished manuscript).

It is possible that 1978 unpublished works became vested with § 203 termination rights on January 1, 1978, when § 303 brought these works under federal copyright, because the “execution” of a grant of *federal* copyright rights would have occurred only with the effective date of the 1976 Act. See Letter from Jane C. Ginsburg, Professor, Columbia Univ., to Maria Pallante, Assoc. Register, Policy & Int’l Affairs, U.S. Copyright Office (Apr. 27, 2010), available at www.copyright.gov/docs/termination/comments/2010/ginsburg-jane.pdf. But the § 203(b)(1) exception for derivative works would in any event shield the motion picture producers from any non-employee for hire’s termination.

E. IMPLEMENTATION OF THE 1976 ACT REVERSION RIGHTS

1. *Summary of Termination Provisions*

Different events trigger the 1976 Act's termination provisions. For works first published when the 1909 Act was still in force, the advent of the author's reversion rights is calculated from the date of first publication.⁴⁵⁹ For grants made as of the 1976 Act's effective date, the date of the execution of the grant (not the date of publication of the work) determines the vesting of the reversion right.⁴⁶⁰

The 1976 Act includes transitional provisions covering the reversion of renewal term rights in works published before 1978, and therefore under the aegis of the 1909 Act. These works fall into two categories, those published before 1964 (whose first twenty-eight-year term expired before 1992), and those published between 1964 and 1977 (whose first twenty-eight-year term expires between 1992 and 2015); the latter group benefits from the automatic renewal amendments made in 1992.⁴⁶¹ For works published before 1964, the renewal term reversion of rights vested automatically (upon proper application and registration). The term generally vested in the author,⁴⁶² but if she survived into the renewal term she was bound by a prior grant of renewal term rights; if the author died before the renewal term vested, the author's surviving spouse or children took the rights notwithstanding any grant of renewal term rights by the author, including with respect to derivative works. No deadline was imposed on the author's or statutory heirs' exercise of the reverted rights.⁴⁶³ For works published between 1964 and 1977, inclusive, if the author did not grant the renewal term, or if the author died before the renewal term vested, then renewal term rights revert if the renewal is effected during the twenty-eighth year of copyright. (If the author, or survivor, does not renew, then the term of copyright will be automatically renewed, *but* the transferee may continue to use pre-existing derivative works.)⁴⁶⁴

With respect to the nineteen additional years the 1976 Act appended to the end of the renewal term for works published under the 1909 Act, the author or her heirs may effect the reversion of these extended renewal term

459. 17 U.S.C. § 304(c)(3).

460. *Id.*

461. *See* § 304(b)(2).

462. The 1909 Act included four categories of works whose "proprietors" took the renewal. *See* 17 U.S.C. § 23 (repealed Oct. 19, 1976).

463. Thus, for example, in *Rohauer v. Killiam Shows, Inc.*, 551 F.2d 484 (2d Cir. 1977), the author's widow effected the renewal in 1952, but did not assign the rights to Rohauer until 1965.

464. 17 U.S.C. § 304(b)(4)(A).

rights within a five-year period beginning at the end of fifty-six years from publication (with a minimum of two years, and a maximum of ten years, advance notice); however, the transferee may continue to use already created derivative works. Similarly, for the twenty years Congress in 1998 added to the extended renewal term of 1909 Act works, the author or her heirs may effect the reversion during a five-year period beginning at the end of seventy-five years from publication (with a minimum of two years, and a maximum of ten years, advance notice), but only if the author or her heirs did not terminate at the end of fifty-six years; the transferee may continue to use already-created derivative works.

For grants of exclusive or non-exclusive rights made after 1977 (regardless of the work's date of publication), the author or her heirs may effect termination within a five-year period beginning thirty-five years from execution of the grant (or, if the grant transferred publication rights, thirty-five years from publication or forty years from execution, whichever is earlier), with a minimum of two years, and a maximum of ten years, advance notice.⁴⁶⁵ As with all other 1976 Act terminations, the transferee may continue to use already-created derivative works.⁴⁶⁶

2. *Case Law*

Grants concluded after 1977 are governed by section 203 of the 1976 Act; they will be terminable beginning in 2013 (with the earliest notice period having begun in 2003). As a result, courts have yet to interpret those provisions. But controversies under section 304(c), governing the termination of the extended renewal term, began to arise with the effective date of the 1976 Act, and are likely to continue for as long as the right to reclaim the section 304(c) or (d) extended renewal term remains enforceable (that is, until 2055).⁴⁶⁷ The cases calling for interpretation of section 304(c) have fallen into three general categories: adequacy of notice given to grantees; scope of the derivative works right exception to termination; and evasion of the inalienability principle embodied in the “notwithstanding any agreement to the contrary” proviso.

465. 17 U.S.C. § 203(a)(3) (2006).

466. § 203(b)(1).

467. The last works under the aegis of the 1909 Act were published in 1977; the second extended renewal term will vest seventy five years later, 2052. The author (or heir) has five years in which to effect termination (2057), but must give at least two years advance notice, hence 2055.

a) Adequacy of Notice to Grantees

The notice provisions of section 304(c) are not author-friendly. As the court in *Siegel v. Warner Bros.* (concerning the recapture of rights in *Superman*) lamented, section 304(c)'s "intricate provisions oftentimes create unexpected pitfalls that thwart or blunt the effort of the terminating party to reclaim the full measure of the copyright in a work of authorship."⁴⁶⁸ The caselaw confirms this sobering assessment. In *Burroughs v. MGM*,⁴⁶⁹ Edgar Rice Burroughs' heirs sought to recapture film rights in the *Tarzan* books. While the derivative works exception insulated the grantees of rights in previously-created motion pictures, the Burroughs heirs aimed to exercise control over future films incorporating the *Tarzan* characters. The Second Circuit held that the termination notice's "undoubtedly inadvertent"⁴⁷⁰ failure to include five of fourteen "Tarzan" titles rendered the termination ineffective even though the five omitted titles did not include the first appearances of the various *Tarzan* characters. In theory, any rights conveyed in the five remaining titles should have been limited to the new matter contributed by those titles, the basic character attributes and adventures having been set out in the earlier works covered by the notice of termination.⁴⁷¹ As a result, the terminated grantee seeking to make a new film should not have been entitled to rely on its remaining rights in the later works because any new film would inevitably incorporate character traits and plot elements contained in the earlier works in which the grantee no longer had rights.

The Second Circuit, however, citing no authority, proclaimed "when an author grants the rights to a work that contains material protected by the author's copyright in an earlier work, the grant implicitly authorizes the use of all material contained in the licensed work, including material that may be covered by the author's other copyrights."⁴⁷² The decision is especially devastating for authors of works in which the same characters appear in multiple sequels. The court's reasoning has the effect of nullifying the

468. *Siegel v. Warner Bros. Ent., Inc.*, 542 F. Supp. 2d 1098, 1117 (C.D. Cal. 2008).

469. *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 683 F.2d 610 (2d Cir. 1982).

470. *Id.* at 622.

471. *Cf.* 17 U.S.C. § 103(b) (2006). Copyright in a derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

Id.

472. *Burroughs*, 683 F.2d at 622.

limitation on the derivative works exception to pre-existing derivative works. Section 304(c)(6)(A) specifies that the “privilege [to continue to exploit previously prepared derivative works] does not extend to the preparation after the termination of other derivative works based upon the copyrighted work covered by the terminated grant.” If derivative works rights granted in later works in the series may continue to be exploited based on an “implicit” grant of rights in earlier works, then the character rights will not be retrieved until fifty-six years following the publication of the last pre-1978 sequel, or thirty-five years following a post-1978 grant of rights in the last sequel.

In *Siegel v. Warner Bros.*, the termination notice served by the heirs of Jerome Siegel, one of the two creators of *Superman*, specified an effective date that failed, by a few days, to encompass the first published appearance of the *Superman* character in promotional announcements for the forthcoming first comic book featuring the character. Though the timing of the notice did encompass the comic book, Warner Bros. claimed that the subsistence of its rights in the earlier advertisements preserved its rights in the essential visual and story elements of the character. The court agreed that as much of the character as was depicted in the announcements remained unaffected by the termination. However,

[t]he Court begins by observing what is *not* depicted in the announcements. Obviously, nothing concerning the Superman storyline (that is, the literary elements contained in *Action Comics*, Vol. 1) is on display in the ads; thus, Superman’s name, his alter ego, his compatriots, his origins, his mission to serve as a champion of the oppressed, or his heroic abilities in general, do not remain within defendants [sic] sole possession to exploit. Instead the only copyrightable elements left arise from the pictorial illustration in the announcements, which is fairly limited.

The person in question has great strength (he is after all holding aloft a car). The person is wearing some type of costume, but significantly the colors, if any, for the same are not represented, as the advertisement appears only in black and white. The argument that the “S” crest is recognizable in the promotional advertisement is not persuasive. What is depicted on the chest of the costume is so small and blurred as to not be readily recognizable, at best all that can be seen is some vague marking or symbol its precise contours hard to decipher. The Court thus concludes that defendants may continue to exploit the image of a person with extraordinary strength who wears a black and white leotard and cape. What remains of the Siegel and Shuster’s *Superman* copyright that is still subject to termination (and, of course, what defendants truly seek) is the entire storyline from *Action Comics*, Vol. 1, Superman’s distinctive blue leotard (complete with its inverted triangular crest across the chest with a red “S” on a yellow

background), a red cape and boots, and his superhuman ability to leap tall buildings, repel bullets, and run faster than a locomotive, none of which is apparent from the announcement.⁴⁷³

The *Siegel* court correctly construed the relationship between the copyright in a work containing a character's first appearance and the copyright in each subsequent work containing additional iterations of the character. *Superman* may be unusual in that the first published works (the promotional announcements) did not convey all the essential elements of the character's appearance and story. The heirs' recapture, while incomplete, was nonetheless sufficiently substantial to oblige Warner Bros. to account to the heirs for profits generated by at least some of the exploitations of the Superman copyright.⁴⁷⁴

b) Scope of the Derivative Works Exception to Termination

The 1976 Act termination right returns fewer rights to the author than did the renewal term reversion because "a derivative work prepared under authority of the grant before its termination may continue to be utilized under the terms of the grant after its termination," while the "new estate" of the renewal term freed the author (if she had not previously assigned her renewal term rights) or her statutory heirs from all prior grants.⁴⁷⁵ Without the continued use exception, derivative works grantees, principally motion picture producers, would have opposed, and likely defeated, an inalienable termination right. While the exception secured the investment made in the creation of derivative works, the Supreme Court interpreted the statute to benefit not only derivative works producers, but also (and at the cost of authors) the intermediaries, generally publishers, who license them. In *Mills Music v. Snyder*, the heirs of the composer of the aptly-named song "Who's Sorry Now?" served a notice of termination on the music publisher.⁴⁷⁶ The music publisher had, pursuant to the now-terminated grant, licensed several record producers to make sound recordings of the song. Under the exception, it was clear that the record producers could continue to sell the recordings they had already made. At issue were the royalty payments: would the record producers now pay 100% of the royalties to the composer's heirs,

473. *Siegel*, 542 F. Supp. 2d at 1126.

474. The court does not appear to have considered whether Warner Bros.' rights in later iterations of *Superman* derived from subsequent, unexpired (or unexpired, if later iterations were work for hire) grants which "implicitly" incorporated grants of rights in the earliest versions of the character.

475. *Stewart v. Abend*, 495 U.S. 207, 226, 230 (1990) (holding that renewal terminates right to exploit derivative works).

476. *Mills Music, Inc. v. Snyder*, 469 U.S. 153 (1985).

or would they continue to pay 50% to the publisher, even though the publisher no longer held any rights in the song? The Supreme Court, in a 5–4 decision, construed “the terms of the grant” to cover both the composer’s grant of rights to the music publisher, and the publisher’s grants of derivative works rights to the record producers. As a result, the publisher would continue to receive its prior share of the royalties. While the derivative works licenses in *Mills Music* split the royalties evenly, so that the author continued to be remunerated, the Court’s reasoning would seem to apply even when the licensing intermediary keeps most or all of the royalties.⁴⁷⁷ The decision has been widely criticized as inconsistent with legislative intent.⁴⁷⁸ Subsequent decisions of lower courts appear to endeavor to limit the potential damage.

In *Woods v. Bourne*, the Second Circuit considered the post-termination distribution of royalties in arrangements of the song “When the Red Red Robin Comes Bob Bob Bobbin’ Along” as sold in sheet music and as publicly performed in sound recordings.⁴⁷⁹ The Court rejected the terminated publisher’s reliance on *Mills Music* for two reasons. First, with respect to royalties earned from the radio broadcasts and other public performances of the recorded songs, the court held that the exception “protects only authorized uses made by derivative work copyright owners, or their licensees.”⁴⁸⁰ Because, at the time of the decision, there was no public performance right in a sound recording, the public performances whose royalties were at issue could not be authorized uses with respect to the sound recordings, rather they implicated rights in the underlying musical composition.

But what was the underlying musical composition? The composer’s heirs contended it was the piano-vocal version, from which subsequent arrangements were adapted. The publisher argued that the initial iteration of

477. *See id.* at 177 (“no support . . . for the proposition that Congress expected the author to be able to collect an increased royalty for the use of a derivative work”).

478. *See, e.g.*, PAUL GOLDSTEIN, COPYRIGHT § 5:132–34; Howard B. Abrams, *Who’s Sorry Now? Termination Rights and the Derivative Works Exception*, 62 U. DETROIT L. REV. 181, 224–32, 238–39 (1985); Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 CORNELL L. REV. 857, 901–02 (1987) (“With this interpretation, the [*Mills Music*] Court did to the right of termination essentially the same thing as it had done to the 1909 Act’s renewal provision 42 years earlier. With termination, as with renewal, the author’s recapture expectancy is essentially alienable. In industries such as music publishing where authors and composers typically assign to the publisher the right to license any further uses, the statutory right to terminate will have little value. As with the renewal term, the author will have assigned most of what is valuable in her work to people from whom she will be unable to recapture it.”).

479. *Woods v. Bourne Co.*, 60 F.3d 978 (2d Cir. 1995).

480. *Id.* at 989.

the song in the “lead sheet” constituted the “work” that was the subject of the “grant.” The lead sheet was “a very simple, hand-written rendering of the lyrics and melody of the composition without harmonies or other embellishments. [The publisher argued that it] modified the lead sheet by adding harmonies and other elements to create a commercially exploitable piano-vocal arrangement that qualifies as a derivative work.”⁴⁸¹ In that event, if all the commercially exploited versions of the song were derivative works, then none would be terminable, and under *Mills Music*, the publisher would keep its share of the royalties from the continued sale of the sheet music. Thus, as its second basis for distinguishing *Mills Music*, the court affirmed the district court’s ruling that the “work” was the piano-vocal version, and, moreover, that most of the arrangements derived from the piano-vocal version lacked sufficient originality to constitute derivative works. If the works for which the royalties were owed were not derivative works, then the derivative works exception would be irrelevant. Applying the Second Circuit’s “distinguishable variation” standard of requisite creativity for derivative works,⁴⁸² the court distinguished originality from the mere skill or “special training” that characterized the “cocktail pianist variations of the piece that are standard fare in the music trade by any competent musician.”⁴⁸³

In its endeavor to prevent the derivative works exception from swallowing the songwriter’s termination right, the court may have applied an unduly high standard of creativity, a suspicion supported by the court’s favorable citation to *Gracen v. Bradford Exchange*.⁴⁸⁴ *Gracen*’s suggestion that a higher standard of originality is required for derivative works than for underlying works has since been discredited in its own circuit.⁴⁸⁵ On the other hand, the *Woods* court’s reference to “standard fare in the music trade”⁴⁸⁶ may be consistent with prior Second Circuit decisions that reject the originality of variations that are necessary to implement the adaptation of a work from one medium to another. For example, in *Batlin v. Snyder*, the Court disregarded the changes the copyright claimant introduced in producing a plastic version of a public domain cast iron “Uncle Sam” bank on the ground that the variations were trivial or necessitated by the medium transformation. In *Woods*, the Second Circuit may have felt confident in affirming the trial court’s assessment that most of the arrangements were trivial because the

481. *Id.*

482. *See* L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 490 (2d Cir. 1976) (internal quotations omitted).

483. *Woods*, 60 F.3d at 991 (internal quotations omitted).

484. *Gracen v. Bradford Exchange*, 698 F.2d 300 (7th Cir. 1983).

485. *See* Schrock v. Learning Curve Int’l, Inc., 586 F.3d 513 (7th Cir. 2009).

486. *Woods*, 60 F.3d at 991.

trial judge was not only a respected jurist but also an opera composer⁴⁸⁷ (although the court of course did not allude to this additional competence). The disqualification of the alleged derivative works meant not only that the terminated intermediary publisher would not receive royalties for the continued exploitation of the arrangements, but that the terminating author (or his subsequent grantee) would determine whether and when the arrangements might henceforth be exploited.⁴⁸⁸

In *Fred Ahlert Music Corp. v. Warner-Chappell Music*, the Second Circuit adapted *Mills Music*'s interpretation of "under the terms of the grant" in the author's favor.⁴⁸⁹ Addressing whether the licensor of pre-termination derivative works could authorize different exploitations of the derivative work post termination, the court ruled that the grantor of a mechanical license to make a sound recording of the song "Bye-Bye Blackbird" was not later entitled to license that derivative work for the soundtrack and soundtrack album of the film "Sleepless in Seattle" once the songwriter reclaimed his rights for the extended renewal term. The Second Circuit emphasized that in *Mills Music*, the Supreme Court interpreted "the grant" as "the entire set of documents that created and defined each licensee's right to prepare and distribute [the] derivative work[]." ⁴⁹⁰ Thus, the court determined that "the grant" at issue combined the songwriter's original grant to the music publisher with the publisher's subsequent grant to the record producer:

Although the original grant would presumably authorize this new use [in connection with the motion picture], plainly Warner's license to A&M does not This grant does not authorize any additional releases of the . . . derivative [recording], much less its inclusion on a movie soundtrack. Just as Warner continues [by virtue of *Mills Music*] to benefit from the terms of the second grant, pursuant to which it receives royalties from sales of the [derivative recording] . . . , it is bound by those terms of the second grant

487. See Christine Perkins, *Courtrooms and Dramas: Richard Owen '50 Has a Noteworthy Career in Both*, HARV. L. BULL., Summer 2006, available at http://www.law.harvard.edu/news/bulletin/2006/summer/cn_01.php.

488. The works the court deemed were not "derivative works" were various sheet music arrangements. The sound recordings, even if based on unoriginal arrangements, would nonetheless be derivative works by virtue of the originality of the recorded performances and of the contributions of the recording engineer.

489. *Fred Ahlert Music Corp. v. Warner/Chappell Music, Inc.*, 155 F.3d 17 (2d Cir. 1998).

490. *Id.* at 23 (emphasis and brackets in Second Circuit's opinion).

which limit its exploitation of the Song to sales of that phonorecord.⁴⁹¹

Because the music publisher had not, pre-termination, authorized additional uses of the licensed derivative work, it was now too late to engage in new exploitations, and the rights to license and receive royalties from those exploitations reverted to the author (or his statutory heirs). Whether *Fred Ablert* effectively cabins *Mills Music* may turn on whether during the minimum two-year period between service of the notice of termination and the effective date of the termination,⁴⁹² the grantee engages in a flurry of downstream licensing to cover the exploitations the grantee did not previously authorize. If “[t]he effect of *Mills Music* . . . is to preserve during the post-termination period the panoply of contractual obligations that governed pre-termination uses of derivative works by derivative work owners or their licensees,”⁴⁹³ then perhaps intermediary grantees may elude the effect of *Fred Ablert* by expanding the “panoply” before the effective date of the termination.⁴⁹⁴

A related issue concerns the interpretation of the phrase “a derivative work *prepared* under authority of the grant before its termination”⁴⁹⁵: must the derivative work have been fully created before termination, or will the derivative work escape termination so long as its creation has been undertaken before the effective date of termination? If “prepared” encompassed derivative works begun but not yet completed, then one might anticipate that grantees would rush to initiate the creation of the maximum number of derivative works during the minimum two-year period between the notification and the effective date of termination. While the notice period may well have been intended to allow grantees the opportunity to wind down their exploitation in anticipation of termination,⁴⁹⁶ the termination right would be considerably compromised if the notice period also enabled

491. *Id.* at 24.

492. *See* 17 U.S.C. § 304(c)(4)(A) (2006).

493. *Woods v. Bourne Co.*, 60 F.3d 978, 987 (2d Cir. 1995).

494. Section 304(c)(6)(B) provides that the “future rights that will revert upon termination of the grant become vested on the date the notice of termination has been served,” but it seems doubtful that the vesting cuts off the grantee’s present rights during the notice period.

495. 17 U.S.C. § 304(c)(6)(A) (emphasis added).

496. *See, e.g.*, SUPPLEMENTARY REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE US COPYRIGHT LAW: 1965 REVISION BILL 75 (May 1965) (“The thought behind the 2-to-10-year limitation on the time for serving a notice was to establish a definite period for filing the notice toward the end of the 35- or 40-year term, thus avoiding earlier, indiscriminate terminations, and to provide a fair period of advance notice to the grantee that his rights are to be terminated.”).

grantees to gear up to engage in further development of derivative works. No decisions yet appear to confront this issue.⁴⁹⁷

c) Inalienability: “Any Agreement to the Contrary”⁴⁹⁸

The termination right remains available to the author or her heirs “notwithstanding any agreement to the contrary, including an agreement to make a will or to make any future grant.”⁴⁹⁹ The Second Circuit has held that a subsequent agreement to recharacterize as a “work for hire” an author’s creation of “Captain America” for a series of comic books was an impermissible “agreement to the contrary” because grants of rights in works made for hire are not terminable.⁵⁰⁰ The determination long after the work’s creation that it was “for hire” thus constituted an impermissible agreement that the creator would have no termination rights.⁵⁰¹ But it appears that not every agreement whose effect is to deprive the author or the statutory heir of the opportunity to terminate a grant is an “agreement to the contrary” within the meaning of section 304(c)(5). The Second and Ninth Circuits have issued conflicting decisions when the parties to an initial pre-1978 grant (or their successors) agreed post-1978 to rescind the grant and enter into a new agreement. Because the initial agreement would have been terminable under section 304(c), but the new agreement would not (nor would it be under section 203), the question arose whether the new agreement was “contrary” to section 304(c).

Milne ex rel. Coyne v. Stephen Slesinger, Inc., concerned transfers of renewal rights in A.A. Milne’s Winnie the Pooh works.⁵⁰² Milne wrote and published several Winnie the Pooh stories between 1924 and 1929. In 1930, he granted Stephen Slesinger an exclusive license of merchandising and other rights to

497. Cf. NIMMER, COPYRIGHT § 11.02[C][1] n.65 (suggesting that as much of derivative work as had been created by date of termination may continue to be exploited, and if remainder of derivative work is not based upon the underlying work—e.g., a soundtrack for a film based on a terminated novel, then the whole derivative work may continue to be exploited. By the same token, one may infer from this suggestion that the termination would preclude further additions to the derivative work-in-progress if those additions derive from the underlying terminated work.).

498. Portions of the following section are adapted from JANE C. GINSBURG & R. ANTHONY REESE, COPYRIGHT: CASES AND MATERIALS 40–44 (Supp. 2009). For a detailed examination of the “any agreement to the contrary” decisions, see Peter S. Mennell & David Nimmer, *Pooh-Poohing Copyright Law’s ‘Inalienable’ Termination Rights* (UC Berkeley Pub. Law Research Paper No. 1525516, 2009), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1525516.

499. 17 U.S.C. §§ 203(a)(5), 304(c)(5) (2006).

500. *Marvel Characters, Inc. v. Simon*, 310 F.3d 280 (2d Cir. 2002).

501. *Id.*

502. *Milne ex rel. Coyne v. Stephen Slesinger, Inc.*, 430 F.3d 1036 (9th Cir. 2005).

the Pooh character in the United States, for the initial and renewal copyright terms in exchange for royalties (Slesinger then transferred his rights to the corporation SSI). The stories' copyrights were later properly renewed. In 1961, SSI—in exchange for royalties—exclusively granted to Walt Disney Productions the rights that SSI had under the 1930 contract, and Disney acquired, *inter alia*, film rights from Milne's widow. In 1983, after Mrs. Milne's death, her only child, Christopher Robin Milne, contracted with SSI and Disney not to exercise his statutory termination rights; SSI and Disney in turn agreed to increase Christopher Robin's royalties from the Pooh properties. The 1983 agreement revoked the 1930 and 1961 agreements and re-granted the rights in the Pooh works to SSI, which then granted rights to Disney. In 2002, Clare Milne, Christopher Robin's sole surviving child, attempted to terminate her grandfather's 1930 grant to Slesinger under section 304(d). She then sought a declaratory judgment that her termination notice was valid and effective. Disney did not object, as Clare simultaneously agreed to grant to Disney the rights that reverted to her; indeed, Disney agreed to fund Clare's litigation.

The Ninth Circuit concluded that the execution of the 1983 agreement revoked the 1930 grant, so that when Clare Milne served her termination notice, there was no longer any pre-1978 agreement to be terminated. The court did not view the 1983 agreement as one inconsistent with the statutory goal of protecting authors or their families against unremunerative transfers, apparently because the 1983 agreement achieved the same objective as termination: obtaining a better deal for the author's heir (in this case the son, rather than the granddaughter). Moreover, the threat of termination proved the incentive both for increasing Christopher Robin's royalties and for paying them earlier than the termination date. That the arrangement cut out the statutory heir of the section 304(d) termination right (the section 304(c) right having gone unexercised) seems not to have troubled the court, which appears to have found Clare's claim almost frivolous.⁵⁰³

The Ninth Circuit reached the opposite result, however, in *Classic Media, Inc. v. Mewborn*,⁵⁰⁴ which involved the story "Lassie Come Home," written and copyrighted by Eric Knight in 1938, as well as Knight's 1940 novel based on the short story. Knight granted the predecessor to Classic Media the right to make a television series based on the works. Knight died in 1943, and his widow and three daughters later renewed the copyrights. Classic's predecessor had an agreement regarding the renewal term television rights

503. *See id.* at 1048.

504. *Classic Media, Inc. v. Mewborn*, 532 F.3d 978 (9th Cir. 2008).

with Knight's widow, but not his daughters. In July 1976, Ms. Mewborn, one of the daughters, assigned her 25% share of the film, TV, and radio rights in the Lassie works to Classic's predecessor for \$11,000. In March 1978, Classic's predecessor contracted with the other two daughters to assign their film, TV and radio rights, as well as ancillary merchandising, dramatic, and recording rights, for \$3,000 to each daughter. In order to conform all of the daughters' grants of rights, Classic's predecessor paid Mewborn \$3,000 to sign a new agreement in March 1978 that was identical to her sisters' agreements, except that it referred to the 1976 agreement, specifying that Mewborn was granting the identified rights "to the extent such rights are owned by me" and that the rights granted "are in addition to" the rights granted in the 1976 agreement.⁵⁰⁵ In April 1996, Mewborn served a notice of termination on Classic's predecessor, seeking to terminate her 1976 grant of film, TV, and radio rights effective May 1, 1998. Classic asserted that the termination was invalid, and eventually both parties sought a declaration of ownership of the disputed rights.

The court ruled that Mewborn's 1976 assignment had transferred all of her film, TV, and radio rights in the Lassie works. As a result, the court decided that when she entered into the 1978 assignment, all Mewborn had to left transfer were the ancillary rights that had not been mentioned in the 1976 agreement, so that the 1978 language purporting to transfer film, TV, and radio rights was "a nullity." The court concluded that the 1978 agreement did not substitute or revoke the 1976 agreement, but instead left it intact and explicitly affirmed it. Thus, Mewborn's pre-1978 agreement remained in force and subject to termination by her 1996 notice. Because the *Classic Media* court found that the 1978 agreement did not prevent Mewborn from terminating the 1976 grant, it did not need to decide whether the later contract was an "agreement to the contrary." (It did indicate, however, that interpreting the 1978 agreement as conveying film, TV, and radio rights to Classic would make that assignment void as an "agreement to the contrary.")

One might distinguish the "Lassie" case from "Pooh" on the ground that the remuneration for the 1978 Mewborn agreement was, compared to Christopher Robin's, relatively paltry, and, more importantly, that where Christopher Robin knew that the agreement bargained away future termination rights for a substantial sum, it does not appear that Mewborn understood that Classic's predecessor had devised the agreement to divest her of a later termination opportunity. The Ninth Circuit appears to distinguish a successful revocation and novation from one that violates the

505. *Id.* at 981.

“any agreement to the contrary” proscription based on its evaluation of the extent to which the author benefits from the new arrangement and is aware that the conclusion of a new agreement will deprive her of a future termination opportunity.

Finally, *Penguin Group (USA) Inc. v. Steinbeck*⁵⁰⁶ concerned a 1938 grant by John Steinbeck to Viking Press of the exclusive right to publish in the United States and Canada some of his best known works, in which he held the copyright, in return for royalty payments. The agreement was to last as long as the publisher kept the works in print. Steinbeck renewed the works' copyrights as they came due. Steinbeck died in 1968; his will left his interest in his copyrights to his widow Elaine. (His two sons from a previous marriage, Thomas and John IV, received \$50,000 each.) Viking later assigned its rights and duties under the agreement to Penguin. The section 304(c) termination window for the earliest work covered by the 1938 agreement opened in 1985; the termination window for the latest work closed in 2000. In 1994 Elaine and Penguin signed a new contract covering all works included in the 1938 agreement (as well as several earlier and posthumous Steinbeck works). Penguin agreed to pay a larger guaranteed annual advance against royalties and to pay royalties on the retail price of the copies sold, rather than the wholesale price. The 1994 agreement expressly provided that it canceled and superseded the 1938 agreement. Elaine died in 2003, leaving her interest in Steinbeck's copyrights to her children and grandchildren from a previous marriage, and excluding Thomas and John IV and their heirs. In 2004, Steinbeck's son Thomas and granddaughter (the only surviving child of the now-deceased John IV) served notice on Penguin seeking to terminate Steinbeck's 1938 grants under section 304(d). Each party sought a declaration as to ownership of the rights in question.

As in *Milne*, the *Steinbeck* court found the subsequent agreement superseded the original agreements, leaving no subsisting agreement to be terminated under section 304(c). Moreover, although the conclusion of the new agreement defeated the statutory heirs' termination rights, it was not held an “agreement to the contrary.”⁵⁰⁷ According to the Second Circuit, the parties' intention to terminate the 1938 contract was clear from the language of the 1994 agreement. The court noted that, under applicable New York law, “parties to an agreement can mutually agree to terminate it by expressly assenting to its rescission while simultaneously entering into a new agreement dealing with the same subject matter.”⁵⁰⁸ The court therefore concluded that

506. *Penguin Group (USA) Inc. v. Steinbeck*, 537 F.3d 193 (2d Cir. 2008).

507. *Id.* at 204.

508. *Id.* at 200 (quoting *Jones v. Trice*, 608 N.Y.S.2d 688 (N.Y. App. Div. 1994)).

the 1938 contract had been extinguished, and thus the 1994 agreement left no pre-1978 grants in effect that could be subject to termination under section 304.

The Second Circuit similarly concluded that the 1994 agreement was not an “agreement to the contrary,” notwithstanding which the termination could be effected. Steinbeck’s son and granddaughter argued that the effect of that agreement, as interpreted by the court, was to eliminate their opportunity to exercise their section 304 termination interest. The court explained that not every agreement which effectively eliminates an author’s or heir’s statutory termination right was “an agreement to the contrary.” It noted, for example, that, in instances in which multiple parties share the right to terminate a particular agreement, the holders of a majority of the interest might agree among themselves not to terminate, which would effectively eliminate the minority parties’ right to terminate the grant, but that the agreement among the majority would not be an invalid “agreement to the contrary.”

The Second Circuit explained that under its interpretation of an “agreement to the contrary,” “authors or their statutory heirs holding termination rights are still left with an opportunity to threaten (or to make good on a threat) to exercise termination rights and extract more favorable terms from early grants of an author’s copyright,” but that the statute does not suggest that they “are entitled to more than one opportunity, between them, to use termination rights to enhance their bargaining power or to exercise them.”⁵⁰⁹ And like the *Milne* court, the Second Circuit viewed Elaine’s actions in 1994 as consistent with the statutory purpose because she obtained an increased return on Steinbeck’s works.⁵¹⁰

The Second and Ninth Circuits thus may understand “agreement to the contrary” not to mean contrary to the *exercise* of the termination right, but contrary to the *policy underlying* the termination right.⁵¹¹ But the statute says:

509. *Id.* at 204.

510. Allowing Elaine to cut out Steinbeck’s children from his first marriage appears not to have been inconsistent with Steinbeck’s own intent, but the Second Circuit had previously held that the author’s intent does not trump the interests of the statutory heirs. *See* *Larry Spier, Inc. v. Bourne Co.*, 953 F.2d 774 (2d Cir. 1992) (indicating that composer provided in his will for his mistress, but she was not entitled to share of copyright interests following termination by statutory heirs).

511. *Penguin Group (USA)*, 537 F.3d at 204. These decisions also suggest a formula for eluding § 203 terminations of rights granted after 1977. Under that provision, grants may be terminated thirty-five years following conclusion of the contract, subject to a minimum two-year and maximum ten-year notice period. If, before the termination right vests with the service of notice, the author and her grantee rescind the prior grant and enter into a new agreement, the thirty five year clock starts over again. If the heirs rescind and regrant, that grant will not be terminable at all. *See* 17 U.S.C. § 203(a) (2006). So long as the new

“termination of the grant *may be effected* notwithstanding any agreement to the contrary”;⁵¹² it does not add “unless the agreement confers the kind of benefits the author or her heirs would have received had they effected the termination.” The rescission-and-rollover technique, if valid, not only postpones exercise of the termination right by another thirty-five years, but may prevent effecting the termination altogether. This is because, as to post-1977 grants, only those made by the author are terminable; heirs who regrant rights in lieu of termination thereby lose their statutory termination rights.⁵¹³ While the thirty-five-year accrual date for the statutory termination right should not be interpreted to prevent the parties from *ending* their relationship before thirty-five years have elapsed,⁵¹⁴ a *new agreement between the same parties* (or their successors in title) that follows the rescission attracts suspicion. The statute casts some doubt on these arrangements, for both sections 203(b)(4) and 304(c)(6)(D) bar agreements to make a further grant of any right covered by a terminated grant unless made after the effective date of termination; while the statute allows the terminating author or heir to make an agreement with the original grantee, she may do so only after the termination notice has been served.⁵¹⁵ At the least, the rescission-and-rollover should invite judicial scrutiny. Judicial review may well be delicate, for arguably the present value of a modest increase in royalties might be worth as much, if not more, to the

agreement offers the author somewhat better terms than the revoked contract, the rescission-and-rollover technique arguably remains consistent with the policy underlying the termination right. Moreover, it may not even be necessary that the new grant offer better terms. *See* H.R. REP. NO. 94-1476, at 127 (1976) (“Section 203 would not prevent the parties to a transfer or license from voluntarily agreeing at any time to terminate an existing grant and negotiating a new one, thereby causing another 35-year period to start running.”).

512. 17 U.S.C. §§ 203(a)(5), 304(c)(5) (emphasis added).

513. 17 U.S.C. § 203(a) (stating that “the exclusive or nonexclusive grant of a transfer or license of copyright or of any right under a copyright, *executed by the author on or after January 1, 1978*, otherwise than by will, is subject to termination” (emphasis added)).

514. *Compare* *Rano v. Sipa Press, Inc.*, 987 F.2d 580 (9th Cir. 1993) (holding thirty-five year termination period preempted earlier terminations), *with* *Walthal v. Rusk*, 172 F.3d 481 (7th Cir. 1999) (rejecting *Rano*), *and* *Korman v. HBC Florida, Inc.*, 182 F.3d 1291 (11th Cir. 1999) (also rejecting *Rano*). *See also* *Latin Am. Music Co. v. Am. Soc’y of Composers Authors & Publishers*, 593 F.3d 95 (1st Cir. 2010) (holding that section 203 requirements do not apply to terminations under state contract law); *Foley v. Luster*, 249 F.3d 1281 (11th Cir. 2001) (referring to caselaw upholding right under state contract law to terminate agreement before 35 years). The Court of Appeals of England and Wales has also upheld contractual clauses providing for automatic reversion of copyright in the event that the grantee materially breaches its obligations under the contract assigning rights under copyright. *See* *Cross Town Music Co. 1 LLC v. Rive Droite Music Ltd.*, [2010] EWCA (Civ) 122 (reversion of UK and foreign copyrights in 119 songs upon material breach—failure to pay royalties to the songwriters).

515. 17 U.S.C. §§ 203(a)(4), 304(c)(4) (2006).

author than the future value of retrieving all her rights (except as to already-created derivative works). But in that event we may sense a depressing déjà vu: a return to the world of *Fred Fisher v. Witmark*, in which Justice Frankfurter contended that authors need not be protected against themselves, and that they could rationally choose to assign the renewal term for a small consideration before its vesting, rather than gamble on a greater return at the end of twenty-eight years.⁵¹⁶

IV. CONCLUSION

If authors' reversion rights laws endeavor to offset the author's weaker bargaining position by assuring her a future opportunity to make a better deal, history and practice suggest at best inconsistent achievement of that aim. Legislators might improve the reversion rights regime, but it is not clear that authors' lots will accordingly ameliorate. As Julie Cohen observed in this Symposium:

[i]f we think that termination of transfers is the best way to put authors in a good bargaining position with respect to what is, in some transcendent sense, rightfully 'theirs,' we may concentrate our energies on reforming termination of transfers, rather than, for example, engaging in substantive regulation of labor contracts in the creative industries.⁵¹⁷

"Transcendent" or not, authors' interests in reaping the fruits of their intellectual labors warrant meaningful and effective protection; substantive regulation of contracts of transfer, rather than rights to terminate those transfers, may indeed offer the preferable path. Reversion rights derive from an era in which delineation of time-limited property rights afforded the most legislatively likely means of attaining the author-protective objective. With time running out in April 1710 in the House of Lords, it is understandable that there is no evidence that any Lord raised or debated intervening in author-publisher contracts; British lawmakers simply adopted a device they knew and understood. The rest is history's inertia. Perhaps American and certainly British authors now would be better off with a more continental European approach, limiting the scope of transfers and assuring them royalty participation for each mode of exploitation of the work.⁵¹⁸ Today we are less reluctant to legislate for the weaker party, as the author's right to terminate

516. *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643, 656 (1943).

517. See Julie E. Cohen, Professor, Georgetown University Law Center, Address at the Berkeley Center for Law and Technology Symposium: Copyright @ 300 (Apr. 9, 2010).

518. See Bernt Hugenholtz, Professor, University of Amsterdam, Address at the Berkeley Center for Law and Technology Symposium: Copyright @ 300 (Apr. 9, 2010).

grants of U.S. rights “notwithstanding any agreement to the contrary” at least in theory attests. We might consider redirecting those limitations on alienability to the substance of the grant, rather than to its duration.

APPENDIX: EVOLUTION OF U.S. AUTHORS' REVERSION RIGHTS

Statute of Anne (Britain 1710)⁵¹⁹

Original term: Fourteen years.

Additional term: Fourteen years (if author living).

Reversion of rights for additional term: Author.

Formalities required: None.

Language: "[A]fter the Expiration of the said Term of Fourteen Years, the sole Right of Printing or Disposing of Copies shall Return to the Authors thereof, if they are then Living for another Term of Fourteen Years."⁵²⁰

1783 Resolution of Continental Congress⁵²¹

Original term: At least fourteen years.

Additional term: At least fourteen years (if author living).

Reversion of rights for additional term: Author; then to: executors, administrators, assigns.

Formalities required: Restrictions as States deem proper.

Language: "[R]ecomended to the several States . . . to secure to said authors, if they shall survive the first term mentioned, and to their executors, administrators, and assigns, the copy right of such books for another term of time not less than fourteen years."

519. Statute of Anne, 8 Ann., c. 19, § 11 (1710) (Gr. Brit.).

520. *Id.* Assignment of renewal right was also possible. *See Carnan v. Bowles*, (1785) 29 Eng. Rep. 45 (Ch.).

521. Continental Congress Resolution Recommending the States to Secure Copyright to the Authors and Publishers of New Books, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1783c"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

Connecticut (1783);⁵²² New Jersey (1783);⁵²³ Pennsylvania (1784);⁵²⁴ Georgia (1786);⁵²⁵ New York (1786)⁵²⁶

Original term: Fourteen years.

Additional term: Fourteen years (if author living).

Reversion of rights for additional term: Author; then to heirs, assigns.

Formalities required: None.

Language: "[A]t the expiration of the said term of fourteen years . . . the sole right of printing and disposing of any such book . . . shall return to the author thereof, if then living, and his heirs and assigns, for the term of fourteen years more."

Massachusetts (1783);⁵²⁷ Rhode Island (1783);⁵²⁸ New Hampshire (1783)⁵²⁹

Original term: Twenty-one years (twenty years in N.H.).

Additional term: Not applicable.

Reversion of rights for additional term: Not applicable.

Formalities required: Not applicable.

522. Connecticut, An Act for the Encouragement of Literature and Genius, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1783a"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

523. New Jersey, An Act for the Promotion and Encouragement of Literature, 1783 N.J. Acts 325, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1783f"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

524. Pennsylvania, An Act for the Encouragement and Promotion of Learning, 1784 Pa. Acts 306, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1784a"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

525. Georgia, An Act for Encouragement of Literature and Genius, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1786"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

526. New York, An Act to Promote Literature, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1786a"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

527. Massachusetts, An Act for the Purpose of Securing to Authors the Exclusive Right and Benefit of Publishing Their Literary Productions for Twenty-One Years, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1783d"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

528. Rhode Island, An Act for the Purpose of Securing to Authors the Exclusive Right and Benefit of Publishing Literary Productions for Twenty-One Years, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1783h"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

529. New Hampshire, An Act for the Encouragement of Literature and Genius, and for Securing to Authors the Exclusive Right and Benefit of Publishing Their Literary Productions for Twenty-One Years, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1783g"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

Language: “[A]ll books . . . shall be the sole property of the said author or authors . . . Their heirs and assigns, for the full and complete term of twenty-one [twenty] years, from the date of their first publication.”

Maryland (1783)⁵³⁰

Original term: Fourteen years.

Additional term: Fourteen years (if author living).

Reversion of rights for additional term: Author.

Formalities required: None.

Language: “[A]t the expiration of the aforesaid term of fourteen years, the sole right of printing or disposing of copies shall return to the authors thereof, if they are then living, for another term of fourteen years.”

South Carolina (1784)⁵³¹

Original term: Fourteen years.

Additional term: Fourteen years (if author living).

Reversion of rights for additional term: Author.

Formalities required: None.

Language: “[A]fter the expiration of the said term of fourteen years, the sole right of printing, or disposing of copies, shall return to the authors thereof, if they are then living, for another term of fourteen years.”

Virginia (1785)⁵³²

Original term: Twenty-one years.

Additional term: Not applicable.

Reversion of rights for additional term: Not applicable.

Formalities required: Not applicable.

530. Maryland, An Act Respecting Literary Property, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1783e"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

531. South Carolina, An Act for the Encouragement of the Arts and Sciences, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1784b"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

532. Virginia, An Act Securing to Authors of Literary Works an Exclusive Property Therein for a Limited Time. *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1785"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

Language: “[T]he author of any book . . . his heirs and assigns shall have the exclusive right of printing and reprinting such book or pamphlet . . . For the term of twenty-one years, to be computed from the first publication thereof.”

North Carolina (1785)⁵³³

Original term: Fourteen years.

Additional term: Not applicable.

Reversion of rights for additional term: Not applicable.

Formalities required: Not applicable.

Language: “[T]he author of any book . . . and his heirs and assigns, shall have the sole liberty of printing, publishing, and vending the same within this State for the term of fourteen years.”

1789 Copyright Bill⁵³⁴

Original term: Fourteen years.

Additional term: Fourteen years (if author living).

Reversion of rights for additional term: Author.

Formalities required: None.

Language: “[A]fter the expiration of the said term of fourteen years, the sole right of printing and of disposing of copies of such books, shall return to the author or authors of such books, if they are living, for another term of fourteen years.”

Act of 1790⁵³⁵

Original term: Fourteen years.

Renewal term: Fourteen years (if author living).

Reversion / Power of Renewal: Authors; then to executors, administrators, assigns.

Formalities required: Re-recording of title in clerk’s office of author’s local Federal district court within six months before expiration of first term, and, within two months following renewal, publication of record in one or more newspapers for four weeks.

533. North Carolina, An Act for Securing Literary Property, *available at* PSOC, *supra* note 2, [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/"us_1785a"](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabe/).

534. Copyright (and Patent) Bill, H.R. 10, 2d Cong., (1789).

535. 1790 Copyright Act, 1 Stat. 124.

Language: “[I]f, at the expiration of the said term, the author or authors, or any of them be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators, or assigns, for the further term of fourteen years”⁵³⁶

Early 1800s Bills⁵³⁷

Original term: Fourteen years.

Renewal term: Fourteen years (if author living).

Reversion / Power of Renewal: Authors; then to heirs, assigns. And, any contract for sale of renewal term would be void.

Formalities required: Re-recording of title in clerk’s office of author’s local Federal district court within six months before expiration of first term, and, within two months following renewal, publication of record in one or more newspapers for four weeks.

Language: “[I]f, at the expiration of the said term of fourteen years, the author or authors, or any of them . . . be living . . . the same exclusive right shall be continued to him or them, his or their heirs and assigns, for the further term of fourteen years And provided, That any contract for the sale of the copyright for the second term of fourteen years, or any part of the same made or entered into before the expiration of the first, shall be utterly void.”

Act of 1831⁵³⁸

Original term: Twenty-eight years.

Renewal term: Fourteen years.

Reversion / Power of Renewal: Authors; if deceased, then surviving spouse and children.

Formalities required: Re-recording of title in clerk’s office of author’s local Federal district court within six months before expiration of first term, and, within two months following renewal, publication of record in one or more newspapers for four weeks.

536. *Id.* § 1; *see also* *Paige v. Banks*, 18 F. Cas. 1001 (C.C.S.D.N.Y. 1870), *aff’d*, 80 U.S. 609 (1872) (publication rights, during both terms, deemed assigned); *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247, 249–50 (1st Cir. 1911) (interpreting second term as continuation of original rights).

537. No number, 7th Cong. (as reported to Committee of the Whole Jan. 19, 1803); H.R. 75, 10th Cong. (as reported to Committee of the Whole Mar. 7, 1808); H.R. 38, 11th Cong. (as reported to Committee of the Whole Jan. 19, 1811).

538. An Act to Amend the Several Acts Respecting Copy Rights (Feb. 3, 1831), 4 Stat. 436.

Language: “[I]f, at the expiration of the aforesaid term of years, such author . . . be still living, and a citizen . . . of the United States . . . or being dead, shall have left a widow, or child, or children, either or all then living, the same exclusive right shall be continued to such author . . . or, if dead, then to such widow and child, or children, for the further term of fourteen years”⁵³⁹

1838 Bill⁵⁴⁰

Original term: Twenty-eight years.

Renewal term: Fourteen years.

Reversion / Power of Renewal: Author; if deceased then heirs.

Formalities required: Within six months before expiration of first term and, within two months following renewal, publication of record in one or more newspapers for four weeks.

Language: “[I]n all cases where any copy-right may have been obtained and term shall have expired, or may hereafter expire, when the author, if living, would have been or would be entitled to a renewal thereof, the same privilege of renewal shall be, and the same is hereby, extended to the heirs of such author.”

1844 Bill⁵⁴¹

Original term: The longer of: life of author plus seven years, or forty-two years from publication.

Renewal term: Not applicable.

Reversion / Power of Renewal: Not applicable.

Formalities required: Not applicable.

Language: “[C]opyright . . . Shall endure for the natural life of such author, and for the further term of seven years, commencing at the time of his death, and shall be the property of such atuhor and his assigns: Provided, always, That if the said term of seven years shall expire before the end of forty-two years from the first publication of such book, the copyright shall, in that case, endure for such period of forty-two years”⁵⁴²

539. *Id.* § 2; *see also* Pierpoint v. Fowle, 19 F. Cas. 652, 660 (C.C.D. Mass. 1846) (“new interest”); White-Smith Music Pub. Co. v. Goff, 187 Fed. 247 (1st Cir. 1911) (confirmed status as reversion and new grant).

540. H.R. 885, 25th Cong. (1838).

541. H.R. 9, 28th Cong. (1844).

542. Modeled after English Statute, 5 & 6 Vict., c. 45 (1842).

Solberg Proposal (in Kittredge-Currier Bill) 1906⁵⁴³

Original term: New works: three-tiered single term based on nature of work. Subsisting works: existing law.

Renewal term: Subsisting works: For period making total copyright period that granted by proposed act.

Reversion / Power of Renewal: Author; if deceased then surviving spouse, children. But, if assigned or licensed, only with assignee or licensee on application for renewal.

Formalities required: Renewal of copyright registration within one year before expiration of first term.

Language: “[I]he copyright subsisting in any work at the time when this act goes into effect may . . . Be further renewed and extended by the author . . . or if he be dead, leaving a widow, by his widow . . . Or if now widow survive him, by his children . . . provided further, that should such subsisting copyright have been assigned, or a license granted therein for publication upon payment of royalty, the copyright shall be renewed and extended only in case the assignee or licensee shall join in the application for such renewal and extension.”

Smoot-Currier Bill 1907⁵⁴⁴

Original term: Life of author plus thirty years.

Renewal term: Not applicable.

Reversion / Power of Renewal: Not applicable.

Formalities required: Full term obtained only if claim recorded within twenty-eight years from publication, and author’s death recorded by executors, administrators, or assigns.

Language: “[W]ithin the next year preceding the expiration of twenty-eight years from the first publication of such work the copyright proprietor shall record in the Copyright Office a notice that he desires the full term . . . And provided further, That where the term is to extend beyond the lifetime of the author it shall be the duty of his executors, administrators, or assigns to further record in the Copyright Office the date of his death.”

Monroe Smith Proposal 1907 (in Kittredge-Barchfield Bill)⁵⁴⁵

Original term: New works: Forty-two years from publication or life of author plus thirty years, whichever longer. Subsisting works: Existing law.

543. S. 6330, 59th Cong. § 18 (1906); *see supra* note 383.

544. S. 2499, 60th Cong. (1907); H.R. 243, 60th Cong. (1907).

545. S. 2900, 60th Cong. (1907); H.R. 11794, 60th Cong. (1908).

Renewal term. New works: not applicable. Subsisting works: For period making total copyright period that granted by proposed act.

Reversion / Power of Renewal. Author; if deceased then: surviving spouse, children; if deceased then: heirs, executors, administrators BUT . . . if no royalty agreement, or author refused to continue royalty agreement: assignee/licensee entitled to be on application.

Formalities required. New works: Full term only obtained if claim recorded within twenty-eight years from publication, and author's death recorded by executors, administrators, or assigns. Subsisting works: Renewal of copyright registration within one year before expiration of first term.

Language. “[I]f such subsisting copyright shall have been assigned or a license granted therein for publication, and if such assignment or license shall contain provision for payment of royalty . . . Said original assignee or licensee or his successor shall nevertheless be entitled to continue to publish the work on payment of the royalty stipulated in the original agreement; but if such original assignment or license contain no provision for the payment of royalty, the copyright shall be renewed and extended only in case the original assignee or licensee or his successor shall join in the application for such renewal and extension.”

Act of 1909: For New Works⁵⁴⁶

Original term. Twenty-eight years.

Renewal term. Twenty-eight years.

Reversion / Power of Renewal. Authors; if deceased then surviving spouse and children; if deceased then: executors, or next of kin except proprietors (for composite works, periodicals, encyclopedias, works copyrighted by corporate body, or works for hire).

Formalities required. Renewal of copyright registration within one year before expiration of first term.

Language. “[T]he author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widowers or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years[,]” except “[t]hat in the case of any posthumous work or of any periodical, cyclopaedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyright by a corporate body . . . or by an employer for whom such work is

546. Act of March 4, 1909, 35 Stat. 1075, ch. CCCXX, § 24.

made for hire, the proprietor of such copyright shall be entitled to a renewal and extension."⁵⁴⁷

Act of 1909: For Subsisting Works⁵⁴⁸

Original term: Existing law.

Renewal term: For period making total copyright period that granted by Act (i.e. fifty-six years).

Reversion / Power of Renewal: Authors, if deceased then surviving spouse, children; if deceased then executors, or next of kin, except proprietors (for composite works).

Formalities required: Renewal of copyright registration within one year before expiration of first term.

Language: "[T]he author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widowers or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further period such that the entire term shall be equal to that secured by this Act, including the renewal period: Provided, however, That if the work be a composite work upon which copyright was originally secured by the proprietor thereof, then such proprietor shall be entitled to the privilege of renewal and extension granted under this section."⁵⁴⁹

Act of 1976: For Contracts executed after 1977 (whether in new or subsisting works).⁵⁵⁰

Original term: Life of author plus fifty years.

Renewal term: Not applicable.

Reversion / Power of Renewal: Termination of grant available for five years beginning thirty-five years after execution; or beginning forty years after execution if grant included right of publication, with minimum two years and maximum ten years

547. *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247 (1st Cir. 1911) (confirming status as reversion and new grant); *Fred Fisher Music Corp. v. Knowles*, 318 U.S. 643 (1943) (confirming ability to assign future interest in renewal copyright); *Miller Music Corp. v. Charles N. Daniels, Inc.*, 362 U.S. 373 (1960) (holding that deceased author's assignment of expectancy in renewed term does not bind statutory heirs); *Stewart v. Abend*, 495 U.S. 207 (1990) (holding that renewal terminates right to exploit derivative works).

548. Act of March 4, 1909, 35 Stat. 1075, ch. CCCXX, § 23.

549. See sources listed *supra* note 547.

550. 1976 Act, 90 Stat. 2541 (1976), § 203.

notices to grantee; grantees of derivative works rights retain throughout renewal term rights in already-created derivative works.⁵⁵¹

Formalities required: Notice to grantees & recordation of notice in Copyright Office.

Language: "Termination of the grant may be effected at any time during a period of five years beginning at the end of thirty-five years from the date of execution of the grant; or, if the grant covers the right of publication of the work, the period begins at the end of thirty-five years from the date of publication of the work under the grant or at the end of forty years from the date of execution of the grant, whichever term ends earlier. . . . Termination of the grant may be effected notwithstanding any agreement to the contrary, including an agreement to make a will or to make any future grant."⁵⁵²

Act of 1976: For Subsisting Works⁵⁵³

Original term: Copyrights in first term on Jan 1, 1978: twenty-eight years from date of copyright.

Renewal term: Copyrights in first term on Jan 1, 1978: 47 years. Copyrights in renewal term on Jan 1, 1978: total of seventy-five years from date of copyright.

Reversion / Power of Renewal: Copyrights at end of first term: Termination of grants as per 1909 Act. Copyrights in second term: Termination of grant available for five years beginning fifty-six years from date of copyright or Jan 1, 1978, whichever is later, with minimum two years and maximum ten years notices to grantee; grantees of derivative works rights retain throughout renewal term rights in already-created derivative works.

Formalities required: Renewal: Renewal of copyright registration within one year before expiration of first term. Termination: Notice to grantees & recordation of notice in Copyright Office.

Language: "Termination of the grant may be effected at any time during a period of five years beginning at the end of fifty-six years from the date copyright was originally secured, or beginning on January 1, 1978, whichever is later . . . Termination of the grant may be effected notwithstanding any agreement to the contrary, including an agreement to make a will or to make any future grant."⁵⁵⁴

551. First terminations to take effect starting 2013 (for grants made starting in 1978).

552. *Id.* § 203(a)(3), (5).

553. *Id.* § 304.

554. *Id.* § 304(c)(3), (5). *Notice of termination:* *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 683 F.2d 610 (2d Cir. 1982) (holding that licensee retained continued rights to exploit works not mentioned in notice of termination); *Siegel v. Warner Bros. Ent., Inc.*, 542 F.Supp.2d 1098 (C.D. Cal. 2008) (holding that notice of termination did not reach first appearance of

1992 Automatic Renewal Amendment⁵⁵⁵

Original term: Not applicable.

Renewal term: Same as extended renewal term for 1976 Act.

Reversion / Power of Renewal: If renewal effected during last year of first term, rights revert to author (or, proprietor in case of posthumous, cyclopedic, composite, or corporate-owned works); if renewal “automatic,” grantees of derivative works rights retain throughout renewal term rights in already-created derivative works.

Formalities required: If renewal by author or statutory heirs, must be applied for within one year before expiration of first term; if no renewal application, renewal automatic.

Language: Sec. 304(a)(2)(B) “At the expiration of the original term of copyright in a work specified in paragraph (1)(C) of this subsection, the copyright shall endure for a renewed and extended further term of 67 years, which—

- (i) if an application to register a claim to such further term has been made to the Copyright Office within 1 year before the expiration of the original term of copyright, and the claim is registered, shall vest, upon the beginning of such further term, in any person who is entitled under paragraph (1)(C) to the renewal and extension of the copyright at the time the application is made; or
- (ii) if no such application is made or the claim pursuant to such application is not registered, shall vest, upon the beginning of such further term, in any person entitled under paragraph (1)(C), as of

Superman character, but did cover later iterations establishing essential story line and some visual aspects).

Scope of derivative works exception: Mills Music v. Snyder, 469 U.S. 153 (1985) (holding that royalties from continued exploitation of derivative work should be paid to terminated publisher rather than to terminating author (heirs)); Woods v. Bourne, 60 F.3d 978 (2d Cir. 1995) (discussing the characterization of derivative works qualifying for exception); Fred Ahlert Music Corp. v. Warner-Chappell Music, 155 F.3d 17 (2d Cir. 1998) (finding that new uses of pre-termination derivative works don’t qualify for exception).

“Any agreement to the contrary”: Marvel Characters v. Simon, 310 F.3d 280 (2d Cir. 2002) (holding that retroactively deeming work a “work for hire” constitutes impermissible agreement contrary to termination right); Milne v. Stephen Slesinger, Inc., 430 F.3d 1036 (9th Cir. 2005) (holding that revocation of grant and negotiation of new grant, in lieu of exercising termination right, not impermissible agreement contrary to termination right); Classic Media, Inc. v. Mewborn, 532 F.3d 978 (9th Cir. 2008) (interpreting agreement not to have revoked earlier grant, thereby preserving termination right over grant); Penguin Group (USA) Inc. v. Steinbeck, 537 F.3d 193 (2d Cir. 2008) (finding that revocation of grant and negotiation of new grant, before termination right could have been exercised, not impermissible agreement contrary to termination right).

555. Copyright Amendments Act of 1992, 106 Stat. 264, as amended by the Sonny Bono Copyright Term Extension Act (October 27, 1998), 112 Stat. 2827, 2828 [hereinafter CTEA].

the last day of the original term of copyright, to the renewal and extension of the copyright.”

Sec. 304(a)(4)(A) “If an application to register a claim to the renewed and extended term of copyright in a work is not made within 1 year before the expiration of the original term of copyright in a work, or if the claim pursuant to such application is not registered, then 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 be used under the terms of the grant during the renewed and extended term of copyright without infringing the copyright, except that such use does not extend to the preparation during such renewed and extended term of other derivative works based upon the copyrighted work covered by such grant.

1998 Copyright Term Extension Act: For Subsisting Works⁵⁵⁶

Original term. No change: Copyrights in first term on Jan 1, 1978: twenty-eight years from date of copyright.

Renewal term. Copyrights in first term on Jan 1, 1978: sixty-seven years. Copyrights in renewal term on Jan 1, 1978: total of ninety-five years from publication.

Reversion / Power of Renewal. If author or statutory heir failed to terminate grants fifty-six years from original copyright date, author or statutory heir may terminate grant during a period of five years beginning seventy-five years from date of copyright, with minimum two years and maximum ten years notices to grantee; grantees of derivative works rights retain throughout extended renewal term rights in already-created derivative works.

Formalities required. Renewal: See 1992 Automatic Renewal Amendment, *supra*. Termination: Notice to grantees & recordation of notice in Copyright Office.

Language. “In the case of any copyright other than a work made for hire, subsisting in its renewal term on the effective date of the Sonny Bono Copyright Term Extension Act for which the termination right provided in subsection (c) has expired by such date, where the author or owner of the termination right has not previously exercised such termination right . . . Termination of the grant may be effected at any time during a period of five years beginning at the end of seventy-five years from the date copyright was originally secured.”⁵⁵⁷

556. CTEA, 112 Stat. 2829.

557. *Id.* § 304(d).

