



1984

Copyrighting Personal Letters, Diaries, and Memorabilia: A Review and a Suggestion

Robert C. Hauhart
University of Baltimore School of Law

Follow this and additional works at: <http://scholarworks.law.ubalt.edu/ublr>



Part of the [Law Commons](#)

Recommended Citation

Hauhart, Robert C. (1984) "Copyrighting Personal Letters, Diaries, and Memorabilia: A Review and a Suggestion," *University of Baltimore Law Review*: Vol. 13: Iss. 2, Article 3.
Available at: <http://scholarworks.law.ubalt.edu/ublr/vol13/iss2/3>

This Article is brought to you for free and open access by ScholarWorks@University of Baltimore School of Law. It has been accepted for inclusion in University of Baltimore Law Review by an authorized administrator of ScholarWorks@University of Baltimore School of Law. For more information, please contact snolan@ubalt.edu.

COPYRIGHTING PERSONAL LETTERS, DIARIES, AND MEMORABILIA: A REVIEW AND A SUGGESTION

Robert C. Hauhart†

Controlling the unauthorized use of private writings has for centuries challenged the ingenuity of courts and legislatures. Beginning in England in the seventeenth century and continuing through the recent revision of the federal copyright laws, several different approaches have been taken to protect the letters and diaries of private persons. The author traces the historical development of these various strategies to demonstrate that none evidence a realistic appreciation of the unique issues associated with private writings. Following this analysis, the author concludes with a proposed amendment to the federal copyright statute that would better protect authors of private writings.

I. INTRODUCTION

Until recently, common law copyright provided state law protection against the unauthorized use of unpublished works. In the area of unpublished private writings, a body of decisional law developed to define the respective rights of senders and recipients of letters, diaries, and other personal writings. Although many of these rights had their genesis in concepts associated with property law, more contemporary authorities have argued that emerging notions of personal privacy offer a better rationale for according these protections.

During the twentieth century, the federal government has assumed an increasingly important role in shaping the scope of state laws that restrict the unauthorized use of unpublished works. First, the 1909 Copyright Act,¹ by preempting contrary state law, established the federal government as the exclusive regulator of published writings. The task of protecting unpublished writings, though, was relegated to the states. As a result of this legislatively created dichotomy, authors had to look initially to state law for protection, and once a work was published, to federal law. This dual system continued until its abolition by the Copyright Act of 1976.² The 1976 Act abrogated the publication distinction by making the act of committing a thought to writing the point at which preemptive federal protections would attach.³

This article examines these areas of federal and state sovereignty to demonstrate that neither the federal nor the state protective schemes

† B.S., Southern Illinois University, 1972; A.M., Washington University, 1973; Ph.D., University of Virginia, 1982; J.D., University of Baltimore School of Law, 1981. Member, Maryland Bar.

1. Copyright Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075 (repealed 1976); *see infra* notes 123-35 and accompanying text.

2. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified at 17 U.S.C. §§ 101-810); *see infra* notes 170-71 and accompanying text.

3. *See infra* note 170.

adequately protect private writings. The common law of copyright offers little more than a complicated body of law riddled with exceptions. The federal approach, at best, merely incorporates these problems and, at worst, substitutes a remedial scheme that fails to appreciate the special problems presented by private writings. The article concludes with a proposal as to how Congress should amend the federal copyright act so as to achieve a better resolution of the unique problems associated with unpublished letters and diaries.

II. BACKGROUND

A. *Private Writings: Special Protection for Special Problems*

Controlling public access to private writings raises a number of special copyright issues. First, by definition, correspondence and diaries frequently contain the carefully guarded personal thoughts of those who write them. Accordingly, not only do the authors have an obvious interest in preserving their confidences, but society has an obligation to create a protective climate that will encourage its public figures and private citizens alike to record their personal thoughts and motivations.⁴ Second, unpublished works often represent an individual's intellectual work product⁵ and, as such, general principles of fairness dictate that he should be entitled to any pecuniary benefits derived from their publication.⁶ Finally, since letters and diaries contain an intimate history of the times in which they were written, the general public has a strong interest in gaining access to the type of historical perspective found only in private letters and diaries.

Over time, these competing considerations have generated much litigation. Most of these private writings cases have centered on the unauthorized publication of the letters and diaries of prominent persons. For example, lawsuits have been filed to determine the rights to the correspondence of George Washington,⁷ James Abbott McNeill Whistler,⁸ Lord Chesterfield,⁹ Julius and Ethel Rosenberg,¹⁰ Alexander

4. One of the general reasons for recognizing copyright protection is to encourage authors to advance the public welfare by rewarding them for exercising their talents. *Mazer v. Stern*, 347 U.S. 201, 219 (1954). See generally *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480 (1974) (intellectual property created to promote the progress of science and the useful arts); 1 N. NIMMER, NIMMER ON COPYRIGHT § 1.03[A] (1983) (copyright law secures benefits of authorship to the public).

5. See *infra* note 19 and accompanying text.

6. See *id.*

7. *Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841) (No. 4,901); *Mayor of New York v. Lent*, 51 Barb. 19 (N.Y. App. Div. 1868); *Eyre v. Higbee*, 35 Barb. 502 (N.Y. App. Div. 1861).

8. *Philip v. Pennell*, [1907] 2 Ch. 577.

9. *Thompson v. Stanhope*, 27 Eng. Rep. 476 (Ch. 1774).

10. *Meeropol v. Nizer*, 560 F.2d 1061 (2d Cir. 1977), *cert. denied*, 434 U.S. 1013 (1978).

Pope,¹¹ Jonathan Swift,¹² and Mary Baker Eddy.¹³

State copyright protections accorded private writings reflected an effort to balance the individual's right to his letters against society's interest in the availability of the information contained in them. The historical development of this body of law can be divided into three periods. The earliest period is primarily nonstatutory, with the common law defining the protections accorded private writings. The second period is a hybrid, with Congress recognizing the common law approach without truly incorporating it under the terms of the federal statute. The third period is represented by the extensive changes instituted by the 1976 revision of the federal copyright law.

B. Protection of Private Writings at Common Law

Copyright law is a mixture of rights and protections borrowed from different bodies of law as it has developed in the face of recurring problems associated with periodic shifts in legal thought.¹⁴ These problems, and the various solutions applied to them, led to the creation of common law protection for private writings. This protection initially derived from property law concepts and, later, from notions of personal privacy. The result of this historical progression, however, is a collection of concepts that are nearly impossible to apply in a uniform manner and that fail to offer the protections intended.

1. The Property Law Concept

Common law copyright had its genesis in principles that were first articulated in early English property law decisions.¹⁵ Before the invention of the printing press, common law courts refused to recognize that a writer possessed a cognizable interest in his intellectual work product.¹⁶ Rather, the right to reproduce a work of authorship was either nonexistent or held by a publishing guild.¹⁷ At best, writers were

11. *Pope v. Curl*, 26 Eng. Rep. 608 (Ch. 1741).

12. *Id.*

13. *Baker v. Libbie*, 210 Mass. 599, 97 N.E. 109 (1912).

14. See generally Abrams, *The Historical Foundation of American Copyright Law: Exploding the Myth of Common Law Copyright*, 29 WAYNE L. REV. 1119 (1983) (tracing origin of common law copyright from early England through the United States legal system); Hauhart, *Origin and Development of the British and American Copyright and Patent Laws*, 5 WHITTIER L. REV. 539 (1983) (discussing historical development of common law copyright).

15. *E.g.*, *Donaldsons v. Becket*, 98 Eng. Rep. 257 (H.L. 1774); *Millar v. Taylor*, 98 Eng. Rep. 201 (K.B. 1769); *Pope v. Curl*, 26 Eng. Rep. 608 (Ch. 1741); *Thompson v. Stanhope*, 27 Eng. Rep. 476 (Ch. 1774). After reviewing these cases, the United States Supreme Court concluded that it "cannot be doubted" that a writer has a property interest in his work. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 657 (1834).

16. See P. WITTENBERG, *THE PROTECTION OF LITERARY PROPERTY* 3-10 (2d ed. 1968).

17. Known as the Stationers' Guild, this guild was established by royal decree to prevent the spread of the Protestant Reformation. A. LATMAN, *THE COPYRIGHT LAW: HOWELL'S COPYRIGHT LAW REVISED AND THE 1976 ACT* 2-14 (5th ed.

deemed to have only a property right in the paper on which they recorded their expressions.¹⁸

The invention of the printing press, coupled with increased literacy, created an inequitable situation where the creator of a work received nothing for his efforts while the publisher and bookseller, whose only contributions were to reproduce the author's work and to offer it for sale, realized all the profits.¹⁹ In response to this inequity, the concept of intellectual property was developed.²⁰ Not only was this intangible property interest in the writer's creative work product deemed to be a legally cognizable right, more importantly the intellectual property right was separate from the right to the paper on which the thoughts were recorded.²¹

This separation of intellectual property from the tangible medium on which it was recorded is the focal point of the laws governing private writings. Unlike manuscripts that remain within the writer's control, private letters are intended for someone other than the person whose intellectual property is contained in the letter. An author's intangible right to the contents of a letter will thus, by necessity, be permanently separated from the addressee's tangible property interest in the letter itself.²²

1979). Established in 1556, the original charter declared that only members of the Stationers' Company could practice the art of printing. Further, no book could be printed without an express approval of a guild licensor appointed by the King. See Hauhart, *supra* note 14, 546.

18. P. WITTENBERG, *supra* note 16, at 13; Hauhart, *supra* note 14, at 558.

19. A. LATMAN, *supra* note 17, at 2 (copyright evolved from principles of "natural justice") (citing 2 W. BLACKSTONE'S COMMENTARIES *405-06). One English court remarked:

The produce of mental labour, thoughts and sentiments . . . became, as knowledge went onward and spread, and the culture of man's understanding advanced, a kind of property impossible to disregard . . . [I]t was found that the common law, in providing for protection of property, provided for their security, at least before general publication by the writer's consent.

Prince Albert v. Strange, 64 Eng. Rep. 293, 311-12 (V.C. 1894); see also Wheaton v. Peters, 33 U.S. (8 Pet.) 591, 657-58 (1834) (copyright evolved from a realization that the "true value" of a book is the thoughts it contains).

20. See Sony Corp. of Am. v. Universal City Studios, Inc., 104 S. Ct. 774, 783 n.12 (1984) (citing invention of the printing press as an example of how copyright law has adapted to technological changes).

21. Pushman v. New York Graphic Soc'y, Inc., 287 N.Y. 302, 307, 39 N.E.2d 249, 250 (1942); N. BOORSTYN, COPYRIGHT LAW § 3.9 (1981); Straus, *Study No. 29: Protection of Unpublished Works*, in 1 STUDIES ON COPYRIGHT 189, 193 (Fisher Mem. ed. 1963); see also Register of Copyright, *Report of the Register of Copyright on the General Revision of the U.S. Copyright Law*, in 1 STUDIES ON COPYRIGHT 1203, 1203 (Fisher Mem. ed. 1963) (uniqueness of intellectual property is that it is separated from the tangible article on which it is recorded) [hereinafter cited as STUDIES ON COPYRIGHT].

22. H. BALL, THE LAW OF COPYRIGHT AND LITERARY PROPERTY 496 (1944); 1 N. NIMMER, *supra* note 4, § 4.03; Comment, *The 1976 Copyright Act and Preemption of Private Letters*, 13 JOHN MAR. L. REV. 205, 209 (1979).

Courts initially sought to characterize the resulting relationship between the sender and the recipient in terms of traditional personal property concepts. One court viewed the relationship as a bailment since the sender retained rights in the letters.²³ The bailment theory, however, erroneously assumed that the writer, or his personal representative, could secure the return of letters that he had unconditionally transferred to the addressee.²⁴ Other courts regarded the relationship as "a special property interest," which was defined as "joint property with the writer."²⁵ This label was equally troubling. The phrase "special property" interest was contradicted by labeling the interest as joint property. In addition, joint property is represented by a joint undivided interest in the property,²⁶ but the rights accorded senders and recipients of letters are mutually exclusive.²⁷ Therefore, no truly "joint" rights existed. Once it became apparent that traditional labels could not properly explain the conflicting rights of senders and recipients, courts methodically fashioned a complicated set of rules to define the rights of the respective parties.

a. Rights of the Recipient and Exceptions to Those Rights

The addressee of a letter becomes the undisputed owner of the paper on which it is written.²⁸ Accordingly, the addressee generally had the exclusive right to possess and read the letter.²⁹ The recipient

23. *Folsom v. Marsh*, 9 F. Cas. 342, 346 (C.C.D. Mass. 1841) (No. 4,901) (recipient is a "trustee or bailee").

24. *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 489 (1867); Cohn, *Rights in Private Letters*, 8 BULL. COPYRIGHT SOC'Y 291, 291 (1961); Comment, *Personal Letters: A Dilemma for Copyright and Privacy Law*, 33 RUTGERS L. REV. 134, 136-37 (1980) [hereinafter cited as Comment, *Personal Letters*]. Indeed, the recipient could most likely compel the return of letters that had fallen into the sender's hands. A. WEIL, AMERICAN COPYRIGHT LAW 132-33 (1917). Moreover, some authorities contend that the sender should not even have the right to regain possession of the letters for the purpose of copying. Comment, *Personal Letters*, *supra*, at 137 n.27 (citing *Baker v. Libbie*, 210 Mass. 599, 607, 97 N.E. 109, 112 (1912)). The denial of access is premised upon the notion that the writer could have made copies before placing the letter in the mail. See *Ipswich Mills v. Dillon*, 260 Mass. 453, 157 N.E. 604 (1927); Comment, *Property Rights in Letters*, 46 YALE L.J. 493, 496 (1937) [hereinafter cited as Comment, *Property Rights*].

25. *Denis v. LeClerc*, 1 Mart. 297, 300-01 (Orleans 1811); *Woolsey v. Judd*, 11 How. Pr. 49, 63-64 (N.Y. App. Div. 1855); *Gee v. Pritchard*, 36 Eng. Rep. 670, 678 (Ch. 1818); *Pope v. Curl*, 26 Eng. Rep. 608, 608 (H.L. 1741).

26. 4A R. POWELL, THE LAW OF REAL PROPERTY ¶ 615 (Rohan 3d ed. 1982); H. TIFFANY, THE LAW OF REAL PROPERTY AND OTHER INTERESTS IN THE LAND § 187 (Berman 3d ed. abr. 1970).

27. A joint property interest would inaccurately imply that each party has the authority to publish the letter. Comment, *Personal Letters: In Need of a Law of Their Own*, 44 IOWA L. REV. 705, 708 (1959). For a discussion of the conflicting rights of senders and recipients, see *infra* notes 28-81 and accompanying text.

28. *Rice v. Williams* 32 F. 437, 440 (C.C.D. Wis. 1887); *Denis v. LeClerc*, 1 Mart. 297 (Orleans 1811); *Baker v. Libbie*, 210 Mass. 599, 606, 97 N.E. 109, 112 (1912); *Philip v. Pennell*, [1907] 2 Ch. 577, 590.

29. H. BALL, *supra* note 22, at 496.

was also permitted to destroy the letter with impunity because courts assumed that it would be unreasonable to expect an individual to retain letters indefinitely.³⁰

Other proprietary rights that would normally apply to tangible personal property, however, were severely limited in the context of private letters. Primarily, the recipient could not publish the correspondence to a public audience without the author's consent.³¹ Although a limited circulation to a small group was permitted,³² widespread distribution was actionable by the author.³³ A conveyance of letters that did not amount to a publication was also within the addressee's right, but the purchaser/donee acquired only the rights possessed by the original recipient.³⁴ Private writings were also not subject to seizure by the recipient's creditors in an insolvency or bankruptcy proceeding, and they were not taxable as personal property.³⁵ Mere payment of a debt was not regarded as a sufficient justification for revealing the writer's confidences.³⁶ Finally, at death, letters passed to the recipient's personal representative, but they neither became part of the decedent's estate nor were they salable to pay his debts.³⁷ The recipient's heirs possessed only the limited ownership rights in the letters that the decedent would have had.³⁸

b. Rights of the Writer and Exceptions to Those Rights

The major property interest possessed by the writer of private papers is the right to prevent nonconsensual publication.³⁹ This impor-

30. *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 489 (1867); *Baker v. Libbie*, 210 Mass. 599, 606, 97 N.E. 109, 112 (1912); H. BALL, *supra* note 22, at 225.

31. For a definition of the publication concept, see *infra* notes 40-59 and accompanying text.

32. *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 488 (1867); *Baker v. Libbie*, 210 Mass. 599, 606, 97 N.E. 109, 112 (1912); *Labouchere v. Hess*, [1897] 77 T.L.R. 559, 563.

33. See *infra* note 51.

34. L. ADMUR, COPYRIGHT LAW AND PRACTICE 48 (1936); Comment, *Property Rights*, *supra* note 24, at 503-05; Annot., 51 L.R.A. 360 (1901). A sale of the letters would raise the question of who should receive the benefit. If the value of the letter was represented by the ideas it conveyed, the writer would receive the profit; if the value was attributable to the paper on which the letter was written and later becomes a collector's item, the recipient would be entitled to the profits. *McCormick Estates*, 80 Pa. D. & C. 413, 417 (1952).

35. *Bartlett v. Crittenden*, 2 F. Cas. 967, 968-69 (C.C.D. Ohio 1849) (No. 1,076); H. BALL, *supra* note 22, at 497.

36. *Eyre v. Higbee*, 35 Barb. 502, 506-07 (N.Y. App. Div. 1861).

37. H. BALL, *supra* note 22, at 497; Comment, *Personal Letters*, *supra* note 24, at 139.

38. *Bartlett v. Crittenden*, 2 F. Cas. 967, 970 (C.C.D. Ohio 1849) (No. 1,076); *Baker v. Libbie*, 210 Mass. 599, 97 N.E. 109 (1912); *Philip v. Pennell*, [1907] 2 Ch. 577; *Thompson v. Stanhope*, 27 Eng. Rep. 476 (Ch. 1774).

39. *Millard v. Taylor*, 98 Eng. Rep. 201, 242 (Ch. 1769) ("[i]t is certain every man has a right to keep his own sentiments, if he pleases: he has certainly a right to judge whether he will make them public, or commit them only to the sight of his friends"); *Woolsey v. Judd*, 11 How. Pr. 49, 55 (N.Y. App. Div. 1855). The concept of publication, while central to a historical discussion of the problems, no

tant right protects the personal thoughts that have been committed to writing. Unfortunately, common law courts carved out a long list of exceptions since they were forced to fashion common law solutions for novel problems. These exceptions were based primarily on the nature of the correspondence or the circumstances under which it was transmitted. The frequency of the exceptions to these rules, however, often rendered the rules meaningless.

The major exception to the author's right to prevent nonconsensual distributions of his work arose when the writer either impliedly or expressly consented to its publication. At common law, authors had exclusive rights to the intellectual property contained in unpublished writings.⁴⁰ The justification given for conditioning protection upon nonpublication is that, once the author elected to avail himself of the pecuniary benefits that derive from publicly distributing his work, he surrenders his claim to prevent its production by others.⁴¹ Common law copyright therefore only recognized an intellectual property interest in being the first to publish one's written work.⁴² Protection of published works has always been a "creature of statutes."⁴³

The concept of publication is elementary in its abstract form. General publication requires an unequivocal act indicating an intent to dedicate the contents of a letter to the public.⁴⁴ This standard, however, has proven difficult to apply, and has often led to harsh results.

The primary area of difficulty is the distinction drawn between general publication and limited publication. Limited publication is the functional equivalent of no publication⁴⁵ because it involves the circulation of unpublished materials without the intent to dedicate these

longer exists under the Copyright Act of 1976. *See infra* notes 170-71 and accompanying text.

40. *Bartlett v. Crittenden*, 2 F. Cas. 967 (C.C.D. Ohio 1849) (No. 1,076); *Jefferys v. Boosey*, 10 Eng. Rep. 681, 702 (H.L.C. 1854); *Gee v. Prichard*, 36 Eng. Rep. 670, 678-79 (Ch. 1818); *Duke of Queensberry v. Shebbeare*, 28 Eng. Rep. 924, 925 (Ch. 1758).

41. 1 N. NIMMER, *supra* note 4, § 4.03; P. WITTENBERG, *THE LAW OF LITERARY PROPERTY* 62-65 (1957).

42. *Roy Export Co. v. Columbia Broadcasting Sys.*, 672 F.2d 1095, 1101 (2d Cir. 1982); *MacMillan Co. v. I.V.O.W. Corp.*, 495 F. Supp. 1134, 1144 (D. Vt. 1980).

43. The common law was supplanted, in part, by the Statute of Anne, 8 Anne Ch. 19 (1710), which established protection for published writings while leaving unpublished writings to their common law protection. P. WITTENBERG, *supra* note 16, at 28-32; *Abrams*, *supra* note 14, at 1185. The Copyright Act of 1909 perpetuated this legislative/common law dichotomy. *See infra* note 128.

44. *Ferris v. Frohman*, 223 U.S. 424, 432-34 (1912); 1 N. NIMMER, *supra* note 4, § 4.04. Publication was regarded as a question of intent. The essential inquiry was whether the author intended to "dedicate his work to the public." *Id.* § 4.13[D]; *see Data Cash Sys., Inc. v. J.S. & A. Group, Inc.*, 628 F.2d 1038, 1043 (7th Cir. 1980).

45. *Birnbaum v. United States*, 588 F.2d 319, 326-27 (2d Cir. 1978); *Clark Equip. Co. v. Harlan*, 539 F. Supp. 561, 568 (D. Kan. 1982); P. WITTENBERG, *supra* note 16, at 40-42.

writings to the public.⁴⁶ For example, an architect who shows building specifications to contractors has only made a limited publication of the plans.⁴⁷ The determinative factor between the two types of publication is whether the author's outward conduct manifests an intention that only a small number of persons view the writing for a limited purpose.⁴⁸ As with all efforts to apply "imprecise concept[s] to diverse factual patterns,"⁴⁹ the limited publication concept has spawned a body of decisional law that is difficult to reconcile.

Sharing a letter received from a friend does not amount to publication,⁵⁰ but circulating it among a sufficiently large group does.⁵¹ Selling a single copy of a manuscript constitutes publication of the work,⁵² yet allowing a circle of close friends to read a letter rises only to the level of a limited publication.⁵³

Another area of uncertainty arose when the author did not explicitly state an intent to disclose. The style or content of the letter could imply that the writer consented to a more public airing of his thoughts.⁵⁴ Indeed, a letter's salutation may imply that public use was intended⁵⁵ or that a general audience was sought.⁵⁶ For example, in the absence of a contrary expression, the author of a letter to the editor consents to its publication.⁵⁷ In *Mayor of New York v. Lent*,⁵⁸ for example, the court held that a letter sent by George Washington expressing his gratitude to the New York City Council was the absolute

46. *Masterson v. McCroskie*, 38 Colo. App. 239, 241, 556 P.2d 1231, 1233 (1976), *rev'd on other grounds*, 194 Colo. 460, 573 P.2d 547 (1978); *Seay v. Vialpando*, 567 P.2d 285, 288 (Wyo. 1977).

47. *E.g.*, *MacMillan Co. v. I.V.O.W. Corp.*, 495 F. Supp. 1134, 1145 (D. Vt. 1980); *Seay v. Vialpando*, 567 P.2d 285, 288 (Wyo. 1977); *see also* *Dowdey v. Phoenix Films, Inc.*, 199 U.S.P.Q. 579 (S.D.N.Y. 1978) (a sample, absent an offer of sale, is not publication).

48. *See supra* note 46.

49. *Roy Export Co. v. Columbia Broadcasting Sys.*, 672 F.2d 1095, 1101 (2d Cir. 1982).

50. *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 489 (1867).

51. *Widdemer v. Hubbard*, 19 Phila. 263, 264-65 (C.P. Pa. 1887); *British Oxygen Co. v. Liquefied Air Ltd.*, [1925] 1 Ch. 383.

52. *Bobbs-Merrill Co. v. Straus*, 147 F. 15, 19 (2d Cir. 1906), *aff'd*, 210 U.S. 339 (1908).

53. *Baker v. Libbie*, 210 Mass. 599, 606, 97 N.E. 109, 111-12 (1912); *Palmer v. DeWitt*, 47 N.Y. 532, 543 (1872).

54. *See* H. BALL, *supra* note 22, at 499.

55. For example, a correspondent relinquishes his exclusive right to publication when he makes an "unequivocal dedication" of his letters to a public entity. *Folsom v. Marsh*, 9 F. Cas. 342, 345-46 (C.C.D. Mass. 1841) (No. 4,901) (dictum). *But see* *McCormick Estates*, 80 Pa. D. & C. 413, 415 (1952) (soldier's letter addressed to his children was not dedicated to a public entity).

56. *Laidlaw v. Lear*, 30 Ont. 26, 28 (1898).

57. *Diamond v. Am-Law Publishing Corp.*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,627 (S.D.N.Y. 1984) (author has no right to impose conditions on what parts of a letter addressed to a newspaper could be published); H. BALL, *supra* note 22, at 499.

58. 51 Barb. 19 (N.Y. App. Div. 1868).

property of the addressee because it was sent to the "[Honorable], The Mayor, Recorder, Aldermen and Commonalty of the city of New York."⁵⁹

Courts also made stylistic distinctions between letters that were literary in substance and those that were merely ordinary personal letters.⁶⁰ The rights to literary epistles were protected while ordinary personal letters were not.⁶¹ This approach has been abandoned, primarily because it forced judges to engage in literary evaluation,⁶² a task that few members of the judiciary wished to perform.⁶³

The content of the writing, in terms of whether it presents novel ideas or ordinary thoughts, has also been used to determine the writer's implied consent to disclosure. First, since ideas have never been protected under copyright law,⁶⁴ addressees and others were entitled to use any ideas suggested by an ordinary letter.⁶⁵ Second, it was necessary that the ideas be original to warrant protection.⁶⁶ Thus, letters that did not embody original ideas were unprotected.⁶⁷ That a letter recounted historical facts or news events did not mean that establishing originality

59. *Id.* at 25-27.

60. Indeed, some distinctions have even been drawn based upon whether telegrams, postcards, carbon copies of letters, and imaginary correspondence (i.e., a letter found in a novel) were actually letters. Comment, *Common Law Protection of Letters*, 7 VILL. L. REV. 105, 115 (1961).

61. See, e.g., *Hoyt v. Mackenzie*, 3 Barb. Ch. 320 (N.Y. Ch. 1848); *Wetmore v. Scovell*, 3 Edw. Ch. 515 (N.Y. Ch. 1842); *Howard v. Gunn*, 55 Eng. Rep. 181 (R.C. 1863); *Perceval v. Phipps*, 35 Eng. Rep. 225 (Ch. 1813).

62. Cohn, *supra* note 24, at 294 (observing that since 1848, there have been no cases in support of the position that artistic content should govern copyright protections).

63. *Baker v. Libbie*, 210 Mass. 599, 604, 97 N.E. 109, 111 (1912) ("Such a distinction could not be drawn with any certainty. While extremes might be discovered, compositions near the dividing line would be subject to no fixed criterion at any given moment, and scarcely anything is more fluctuating than the literary taste of the general public."); see also 2 J. STORY, COMMENTARIES ON EQUITY JURISPRUDENCE § 947, at 135-36 (12th ed. 1877) (explaining protection accorded to nonliterary letters as a function of the implied duty to keep correspondence private).

64. *Mazer v. Stein*, 347 U.S. 201, 217 (1954). See generally Goldman, *Observations on Copyright and Ideas*, 44 N.Y.U. L. REV. 574 (1969) (discussing copyrightability of ideas). The Copyright Act of 1976 expressly excludes ideas from statutory protection. 17 U.S.C. § 102(b) (1982). But see Hopkins, *Ideas, Their Time Has Come: An Argument and a Proposal for Copyrighting Ideas*, 46 ALB. L. REV. 443 (1982) (arguing that ideas should be protected).

65. Comment, *Property Rights*, *supra* note 24, at 497; see *Haskins v. Ryan*, 75 N.J. Eq. 330, 78 A. 566 (1908); *Stein v. Morris*, 120 Va. 390, 91 S.E. 177 (1917).

66. Originality requires that the works of authorship be created by the author, not copied or borrowed from another source. N. BOORSTYN, *supra* note 21, § 2.2 (copyright merely requires independent creation without copying). Originality, however, should not be confused with novelty. *Baker v. Selden*, 101 U.S. 99, 102 (1879) (novelty irrelevant concerning validity of copyright).

67. *Lueddecke v. Chevrolet Motor Co.*, 70 F.2d 345 (8th Cir. 1934); *Moore v. Ford Motor Co.*, 43 F.2d 685 (2d Cir. 1930); *Soule v. Bon Ami Co.*, 201 A.D. 794, 195 N.Y.S. 574 (1922); *Burwell v. Baltimore & O.R.R.*, 31 Ohio App. 22, 164 N.E. 434 (1928).

would be impossible.⁶⁸ Rather, the essential inquiry was whether the author contributed any of his intellectual work product to the account.⁶⁹ In addition, letters that include more than abstract ideas—such as an advertising scheme,⁷⁰ an architect's plans,⁷¹ or a moving picture scenario⁷²—have been accorded protection, even though the information was disclosed voluntarily.

In addition to the rules based upon the content of the correspondence, several procedural limitations circumscribe the author's right to prevent unauthorized dissemination of his work. Most notably, private letters may be subpoenaed in a judicial proceeding,⁷³ and the recipient may be compelled to produce them over the author's objection. Courts may halt production when the contents of the private papers would tend to incriminate the one surrendering them,⁷⁴ or would contravene a recognized privilege.⁷⁵ Moreover, the recipient can ignore the writer's objections when he has been slandered, misrepresented, or publicly charged with misconduct by the writer.⁷⁶ Because this exception was created to enable the recipient to defend his reputation,⁷⁷ the right to exercise it is personal to him, and cannot be transferred to a third party.⁷⁸

Although the voluntary disclosure of ideas and the concept of publication have been the most troublesome exceptions to the writer's authority to restrict dissemination, four other exceptions have been noted: (1) the publication would aid the progress of science;⁷⁹ (2) the letter is

68. *See Harper & Row Publishers, Inc. v. Nation Enters.*, 501 F. Supp. 848, 851 (S.D.N.Y. 1980), *aff'd in part, rev'd in part*, 723 F.2d 195 (2d Cir. 1983).

69. *United States v. Hamilton*, 583 F.2d 448, 450 (9th Cir. 1978); *Dollcraft Indus. v. Well-Made Toy Mfg. Co.*, 479 F. Supp. 1105, 1108 (E.D.N.Y. 1978); *R. Dakin & Co. v. A & L Novelty Co.*, 444 F. Supp. 1080, 1083 (E.D.N.Y. 1978).

70. *E.g.*, *Liggett & Meyer Tobacco Co. v. Meyer*, 101 Ind. App. 420, 194 N.E. 206 (1935); *Howard J. Ryan & Assoc. v. Century Brewing Ass'n*, 185 Wash. 600, 55 P.2d 1053 (1936). *Contra Lueddecke v. Chevrolet Motor Co.*, 70 F.2d 345 (8th Cir. 1934).

71. *E.g.*, *Wright v. Eisle*, 86 A.D. 356, 83 N.Y.S. 887 (1903); *Larkin v. Pennsylvania R.R.*, 125 Misc. 238, 210 N.Y.S. 374 (1925).

72. *Thompson v. Famous Players-Lasky Corp.*, 3 F.2d 707 (N.D. Ga. 1925); *Barrett v. Fish*, 72 Vt. 18, 47 A. 174 (1899).

73. *Barrett v. Fish*, 72 Vt. 18, 47 A. 174 (1899); *King v. King*, 25 Wyo. 275, 168 P. 730 (1917); *Gee v. Pritchard*, 36 Eng. Rep. 670 (Ch. 1818). This exception would also apply when the recipient has voluntarily offered the letters into evidence. *Cohn, supra* note 24, at 297.

74. *Barrett v. Fish*, 72 Vt. 18, 19-20, 47 A. 174, 175 (1899).

75. *Cohn, supra* note 24, at 297.

76. *Folsom v. Marsh*, 9 F. Cas. 342, 346 (C.C.D. Mass. 1841) (No. 4,901); *Phillip v. Pennell*, [1907] 2 Ch. 577, 588; *Perceval v. Phipps*, 35 Eng. Rep. 225 (Ch. 1813).

77. At least one authority has taken the position that, if the equities are strong enough, the addressee could conceivably vindicate his character by publishing a letter written by someone other than the slanderer. *See A. DRONE, THE LAW OF PROPERTY IN INTELLECTUAL COPYRIGHT* 138 (1879).

78. *Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841) (No. 4,901); *Barrett v. Fish*, 72 Vt. 18, 47 A. 174 (1899); *King v. King*, 25 Wyo. 275, 168 P. 730 (1917).

79. Comment, *supra* note 60, at 115. The commentator notes that this rule prevails in

written by a government official in the course of his duties;⁸⁰ (3) the correspondence is addressed to the government;⁸¹ and (4) the nature of the document deals with an overriding public interest.⁸²

The numerous exceptions to the basic common law property principles have diluted the protection available to writers. The exceptions have engulfed the rule, making it difficult for writers to predict the outcome of litigation or to enforce their rights.

2. The Development of a New Foundation for Protection: The Privacy Theory

Toward the close of the nineteenth century, some observers noted that traditional property law concepts failed to offer an adequate explanation for the protections accorded unpublished private letters. Specifically, in 1890, Samuel D. Warren and Louis D. Brandeis became the first commentators to offer a substitute explanation based on the notion that the unauthorized disclosure of private papers constituted a violation of the writer's personal privacy, the "right to be let alone."⁸³ Reviewing many of the private letter decisions from a revisionist's viewpoint, these commentators concluded that the limitations imposed on the unauthorized dissemination of these writings were grounded not in a proprietary theory,⁸⁴ but in the sender's right to control the use of his "thoughts, sentiments and emotions."⁸⁵ Thus, the property explanations were merely a rationalization of what amounted to a right of privacy.⁸⁶

Although dicta in many of the literary property cases support the Warren and Brandeis conclusion,⁸⁷ courts have yet to render a decision

some foreign countries (Mexico and Thailand) and appears to be consistent with one of the primary purposes of common law copyright protection—the advancement of science and the arts. *Id.*

80. Cohn, *supra* note 24, at 297 (letter regarded as a public document); *see also* 17 U.S.C. § 105 (1982) (statutory copyright in government documents).

81. *Folsom v. Marsh*, 9 F. Cas. 342, 347 (C.C.D. Mass. 1841) (No. 4,901); Cohn, *supra* note 24, at 297.

82. *Tefft v. Marsh*, 1 W. Va. 38 (1864); Comment, *Property Rights*, *supra* note 24, at 502.

83. Warren & Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 213 (1890) (citing J. COOLEY, COOLEY ON TORTS § 23, at 29 (2d ed. 1888)).

84. Warren & Brandeis, *supra* note 83, at 213.

85. *Id.* at 198.

86. *Id.*

87. [T]he unauthorized publication of such letters . . . is, perhaps, one of the most odious breaches of private confidence, of social duty, and of honorable feelings which can well be imagined. It strikes at the root of that free interchange of advice, opinions and sentiments which seems essential to the well-being of society, and may involve whole families in great distress from the public display of facts and circumstances which were reposed in the bosom of others, in the fullest and most affecting confidence that they should remain forever inviolable secrets.

Woolsey v. Judd, 11 How. Pr. 49, 53-54 (N.Y. App. Div. 1855) (quoting J. STORY, *supra* note 63, at 946-47); *see Roberts v. McKee*, 29 Ga. 161, 163 (1859); *Denis v.*

based solely upon the writer's privacy interest.⁸⁸ The judiciary has, however, recognized a common law tort action for the tortious invasion of an individual's privacy.⁸⁹ Despite this recognition, questions concerning the breadth and constitutionality of civil privacy actions must be answered before authors of private letters and diaries can make effective use of privacy claims.

First, the scope of the civil privacy remedy is currently in dispute. Some authorities have advocated an expansive interpretation of the cause of action. For example, Dean Prosser contended that the right to privacy is actually four separate rights: (1) unreasonable intrusion upon the seclusion or solitude of another; (2) public disclosure of private facts about the plaintiff; (3) publicity that places the plaintiff in a false light in the public eye; and (4) appropriation of the name or likeness of another.⁹⁰ Another commentator has taken a narrower view of the right by limiting it to the confines of the Warren-Brandeis notion of human dignity.⁹¹

The usefulness of the civil privacy remedy to private writers differs markedly, depending on which of these interpretations is applied. Under the expansive approach, writers and recipients of private writings would be accorded meaningful protection. By contrast, the narrow Warren-Brandeis interpretation would require that plaintiffs establish separate claims for defamation, emotional distress, or misappropriation. With respect to the narrower view, causes of action for defamation and emotional distress involve elements that are often difficult to prove,⁹² and these claims are subject to many defenses.⁹³ Moreover, in

LeClerc, 1 Mart. 297, 314 (Orleans 1811); *see also* Baker v. Libbie, 210 Mass. 599, 97 N.E. 109, 112 (1912) ("[l]etters of extreme affection and other fiduciary communications" may come within the class of protected writings).

88. Dictum in several cases, though, indicates a judicial willingness to recognize this right. *E.g.*, Liberty Lobby v. Pearson, 390 F.2d 489, 491 (D.C. Cir. 1968) (invasion of privacy "conceivably" shown by a deprivation of rights in a private manuscript); Estate of Hemingway v. Random House, 23 N.Y.2d 341, 347, 244 N.E.2d 250, 255, 296 N.Y.S.2d 771, 778 (1968) (right of press to report public events does not imply a "freedom to publish what people may have put down in *private writings*") (emphasis in original).

89. Georgia was the first jurisdiction to recognize a cause of action for invasion of privacy. *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 50 S.E. 68 (1905). Since then, most jurisdictions have followed suit. *See* W. PROSSER, HANDBOOK OF THE LAW OF TORTS § 117, at 804 n.16 (4th ed. 1971) (listing jurisdictions); RESTATEMENT (SECOND) OF TORTS § 652A (1977). Some jurisdictions have rejected a common law-based privacy claim. *Wilson v. Colonial Penn Life Ins. Co.*, 454 F. Supp. 1208, 1213 (D. Minn. 1978); *Evans v. Sturgill*, 430 F. Supp. 1209, 1213 (W.D. Va. 1977); *Corcoran v. Southwestern Bell Tel. Co.*, 572 S.W.2d 212, 215 (Mo. Ct. App. 1978); *Wojtowicz v. Delacorte Press*, 43 N.Y.2d 858, 860, 374 N.E.2d 129, 130, 403 N.Y.S.2d 218, 219 (1978); *Kalian v. People Acting Through Community Effort, Inc.*, 408 A.2d 608, 609 (R.I. 1979).

90. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960); *see also* RESTATEMENT (SECOND) OF TORTS § 652A (1977) (using same four part classification).

91. Bloustein, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. REV. 962, 973-74 (1964).

92. *Id.* at 1000-07.

93. For a discussion of the constitutional problems, *see infra* notes 95-113. Causes of

light of the preemptive Copyright Act of 1976 it is unclear whether state misappropriation laws are still enforceable.⁹⁴

Second, even if the more expansive Prosser approach is taken, privacy claims may be easily defeated by several defenses. Most importantly, it is currently unresolved whether the constitutional limitations on defamation actions apply in suits based on invasion of privacy. In 1975, the Supreme Court held that as a matter of constitutional law truth is an absolute defense in a defamation case.⁹⁵ In addition, when the plaintiff is a public official or public figure, he must show that actual malice motivated the defendant's wrongful acts before he can sue for defamation.⁹⁶ If these limitations are imported into the law of private writings, persons whose letters have been unlawfully revealed to the public will find their privacy remedy severely limited. A verbatim republishing of the letters could easily establish their truth as an absolute defense.⁹⁷ Also, since it is likely that newsworthiness of the letters is attributable to the celebrity status of the author, the public figure doctrine would severely limit the scope of the privacy remedy.⁹⁸

The resolution of this issue depends upon which of the four interests embodied in the Prosser formulation has been violated: the first, intrusion upon solitude,⁹⁹ or the second, public disclosure of private facts.¹⁰⁰ Application of the intrusion test ensures that the plaintiff will escape the operation of the defamation limitations.¹⁰¹ A claim pressed

action for emotional distress are subject to a variety of defenses. See Bloustein, *supra* note 91, at 1000-07; Prosser, *supra* note 90, at 422.

94. See Fetter, *Copyright Revisions and the Preemption of State "Misappropriation" Law: A Study in Judicial and Congressional Interaction*, 27 COPYRIGHT L. SYMP. (ASCAP) 1 (1982); Mitchell, *Misappropriation and the New Copyright Act: An Overview*, 10 GOLDEN GATE L. REV. 587 (1980).

95. Cox Broadcasting Corp. v. Cohn, 420 U.S. 469, 496-98 (1975) ("the First and Fourteenth Amendments will not allow liability for truthfully publishing information").

96. Monitor Patriot Co. v. Roy, 401 U.S. 265, 270 (1971); Curtis Publishing Co. v. Butts, 388 U.S. 130, 153 (1967); Rosenblatt v. Baer, 383 U.S. 75, 84 (1966); New York Times Co. v. Sullivan, 376 U.S. 254 (1964).

97. Comment, *Personal Letters*, *supra* note 24, at 160 (the truth defense would eviscerate the privacy protections for private letters); see Woito & McNulty, *The Privacy Disclosure Tort and the First Amendment: Should the Community Decide Newsworthiness?*, 64 IOWA L. REV. 185 (1979) (since disclosure is the gravamen of the tort, the truth of the disclosure is seldom in dispute).

98. Comment, *Personal Letters*, *supra* note 24, at 151.

99. The *Restatement (Second) of Torts* defines the intrusion upon solitude as an intentional intrusion "upon the solitude or seclusion of another or his private affairs or concerns . . . if the intrusion would be highly offensive to a reasonable person." RESTATEMENT (SECOND) OF TORTS § 652B (1977).

100. The *Restatement (Second) of Torts* defines publicity given to a private life as the giving of publicity "to a matter concerning the private life of another . . . if the matter publicized is of a kind that (a) would be highly offensive to a reasonable person, and (b) is not of legitimate concern to the public." *Id.* § 652D.

101. Time, Inc. v. Hill, 385 U.S. 374, 385 n.9 (1967); Virgil v. Time, Inc., 527 F.2d 1122, 1127-28 (9th Cir. 1975), *cert. denied*, 425 U.S. 998 (1976); Meeropol v. Nizer, 381

under an intrusion theory is not based upon the confidential nature of the information obtained, but on the "highly intrusive" effect that the conduct would have upon a reasonable person.¹⁰² Although this standard has yet to be applied in a copyright context, monitoring telephone conversations¹⁰³ or opening private mail¹⁰⁴ qualify as highly intrusive conduct. Accordingly, the act of publishing private correspondence, a more intrusive act than merely opening letters, would certainly constitute an intrusion into an individual's private affairs.

Should courts elect to apply the public exposure of private information standard,¹⁰⁵ it will be more difficult, but not impossible, to avoid the defamation constraints.¹⁰⁶ Under this concept of privacy, the plaintiff must show that information of a private nature was disclosed to the public.¹⁰⁷ It is the author's interest in maintaining his private life, not the manner or place from which the information was obtained, that is subject to protection.¹⁰⁸ The type of information disclosed is thus more important than how it was obtained.

Unlike the intrusion decisions, the Supreme Court applied these defamation standards in *Cox Broadcasting Corp. v. Cohn*,¹⁰⁹ a case involving the disclosure of private information to the public. The primary reasons given for relying upon the defamation limitations are that, by pursuing celebrity status, public figures voluntarily expose their private lives to the prying eyes of the public.¹¹⁰ With respect to cases involving "involuntary public figures," the public assertedly has a constitutional right to the availability of truthful information about persons who have captured the public's attention.¹¹¹

F. Supp. 29, 37 (S.D.N.Y. 1974), *cert. denied*, 434 U.S. 1013 (1978); *Baker v. Burlington N., Inc.*, 99 Idaho 688, 587 P.2d 829 (1978).

102. RESTATEMENT (SECOND) OF TORTS § 562B (1977).

103. *Nader v. General Motors Corp.*, 25 N.Y.2d 560, 255 N.E.2d 765, 307 N.Y.S.2d 647 (1970). *See generally* Annot., 11 A.L.R.3d 1296 (1967) (collecting cases dealing with wiretapping as an invasion of privacy). *But see* *Simmons v. Southwestern Bell Tel. Co.*, 452 F. Supp. 392 (W.D. Okla. 1978) (no cause of action for invasion of privacy if the telephone line is not used for private calls).

104. *Birnbaum v. United States*, 588 F.2d 319 (2d Cir. 1978); *Vernors v. Young*, 539 F.2d 966 (3d Cir. 1976); RESTATEMENT (SECOND) OF TORTS § 652B comment b (1977).

105. *See supra* note 100 (defining publicity given to a private life).

106. *Marek v. Zanol Products Co.*, 298 Mass. 1, 9 N.E.2d 393 (1937); 3 J. DOOLEY, MODERN TORT LAW: LIABILITY & LITIGATION § 36.01.10 (1977).

107. *See supra* note 100.

108. It is this interest that motivated Warren and Brandeis to request judicial recognition of a right to privacy. Prosser, *supra* note 90, at 392-93. These commentators were apparently annoyed with the abusive press coverage accorded Boston society functions. *Id.* at 383.

109. 420 U.S. 469 (1975).

110. *See* *Curtis Publishing Co. v. Butts*, 388 U.S. 130 (1967); RESTATEMENT (SECOND) OF TORTS § 652D comment e (1977).

111. *Cox Broadcasting*, 420 U.S. at 496 (rejecting claim based upon "the tort of public disclosure" because it would promote "timidity and self-censorship"); *Time, Inc. v. Hill*, 385 U.S. 374, 388 (1967) (the public has an interest in access to all information "to enable the members of society to cope with the exigencies of their

Neither of these contentions, however, represents a realistic appraisal of the highly personal nature of the information frequently found in letters and diaries. While officials and celebrities may assume the risk that the public will intrude upon their solitude, they do not reasonably expect that their intimate private papers will be paraded before the public eye.¹¹² A contrary finding would blur the important distinction between defamation and privacy. Defamation exists to protect an individual's interest in his reputation. Privacy, however, exists to protect an individual's interest in being free from the emotional distress caused by a public airing of his confidences.¹¹³

The third major problem with privacy claims is that they may be susceptible to many of the shortcomings associated with the property law approach. For example, a prerequisite in all privacy actions is a private correspondence.¹¹⁴ Much like the originality requirement in copyright law,¹¹⁵ debates over whether a given thought or correspondence is private could result in a hypertechnical dispute over a procedural matter. Also, once a plaintiff failed to establish an actual invasion of his privacy, he would lose the right to control the dissemination of his works absent property law protection. Privacy law only protects against intrusions into the plaintiff's confidences or into his private life: it does not concern itself with the pecuniary advantage, if any, gained by the defendant.¹¹⁶ Thus, many of the privacy cases articulate a concept that is nearly identical to the ambiguous publication standard. With respect to claims involving the public dissemination of private information, the plaintiff must show that the defendant circulated the materials in question to the public.¹¹⁷ This circulation must

period"); RESTATEMENT (SECOND) OF TORTS § 652D comment f (1977) (involuntary public figures, although they do not submit to publicity, are nevertheless persons of public interest because the public has an interest in being informed).

112. The Supreme Court has yet to recognize expressly this distinction. The *Cox Broadcasting* Court, however, intimated:

[W]e should recognize that we do not have at issue here an action for the invasion of privacy involving the appropriation of one's name or photograph, a *physical or other tangible intrusion into a private area*, or a publication of otherwise private information that is also false although perhaps not defamatory.

Cox Broadcasting, 420 U.S. at 489 (emphasis supplied).

113. 3 J. DOOLEY, *supra* note 106, §§ 35.02, 36.15.
114. Prosser, *supra* note 90, at 391 (the thing into which the intrusion has been made must be, and be entitled to be, private); RESTATEMENT (SECOND) OF TORTS § 652D comment b (1977) (it is not actionable to merely give publicity to information about the plaintiff that is already public).
115. See *supra* note 66.
116. See *Birnbaum v. United States*, 436 F. Supp. 967 (E.D.N.Y. 1977) (while common law copyright cause of action failed because plaintiff failed to establish a loss of potential gain, court upheld an invasion of privacy claim), *aff'd*, 588 F.2d 319 (2d Cir. 1978).
117. Prosser, *supra* note 90, at 393 (public disclosure, not a private one, is required); RESTATEMENT (SECOND) OF TORTS § 652D comment a (1977) (matter must be made public by communicating it to the public at large).

amount to a publication of the information; merely showing it to a small group of friends is not actionable.¹¹⁸ Finally, privacy claims are personal to the individual whose privacy has been intruded upon. Family and friends of a decedent may not vicariously assert the decedent's right to privacy; rather, they must show that they have suffered a separate intrusion upon their rights.¹¹⁹ Thus, all rights to control the unauthorized reproduction and distribution of private writings die with the author.

While privacy law does not always provide comprehensive protection or a vehicle to escape the shortcomings associated with the property law approach to common law copyright, it may play an important role in future copyright cases. Although many common law property-based claims were preempted by the Copyright Act of 1976,¹²⁰ causes of action for invasion of privacy were left untouched.¹²¹ As a result, state law privacy claims remain a viable option for those who do not, or cannot, come within the purview of the federal copyright statute. The potential use of a privacy law claim, however, must be examined in terms of the federal government's efforts to achieve a uniform statutory protective scheme.

III. STATUTORY LAW: THE EXPANDING USE OF FEDERAL PREEMPTION

Although some form of a federal copyright statute has existed since 1790,¹²² it was not until the 1900's that Congress actively preempted state copyright laws. Beginning in 1909, the federal government, rather than the states, has been the guiding force behind efforts to redefine copyright protection. In 1976, these efforts culminated with the passage of a substantially revised copyright act that preemptively brought unpublished private writings under the umbrella of federal protection. Although this unification of copyright law under the federal scheme represents an appropriate step, the new act failed to offer meaningful protections that reflect an appreciation of the unique problems associated with private writings.

118. Prosser, *supra* note 90, at 393-94 (no breach of privacy to communicate private matters to an employer, any other individual, or a small group of people); RESTATEMENT (SECOND) OF TORTS § 652D comment a (1977). *But see* Kerby v. Hal Roach Studios, 53 Cal. App. 2d 207, 210-12, 127 P.2d 577, 580 (1942) (letter distributed to 1,000 persons was deemed to have been made public).

119. RESTATEMENT (SECOND) OF TORTS § 652I (1977).

120. 17 U.S.C. § 301 (1982).

121. Allied Artist Pictures Corp. v. Rhodes, 496 F. Supp. 408 (S.D. Ohio), *aff'd*, 679 F.2d 656 (6th Cir. 1982).

122. For a discussion of the various federal acts, see A. LATMAN, *supra* note 17, at 7-9. For a discussion of early state copyright laws, see P. WITTENBERG, *supra* note 16, at 52.

A. *The 1909 Act—Publication Becomes a Dividing Line*

Acting under express constitutional authority,¹²³ Congress enacted the Copyright Act of 1909 with the intention of creating a protective scheme for all published works of authorship, defined as "all the writings of an author."¹²⁴ Because unpublished writings were viewed as matters of private or local concern until disclosed to the public,¹²⁵ the common law protection accorded these writings were expressly not preempted.¹²⁶ As a result, publication became the dividing line between state and federal law.¹²⁷ For those who desired federal protection prior to publication, the 1909 Act further provided that private writers could elect to copyright their work by appending a notice of copyright and filing a copy with the copyright office.¹²⁸ In short, authors of private letters could either claim their common law rights or elect to register their works under the federal act.

The 1909 Act's creation of a dual state/federal protective scheme created several problems for private writers. First, since the Act left the common law unchanged, ambiguities associated with the property and privacy concepts were incorporated into federal law by reference.¹²⁹ Second, states frequently offered more attractive protection to private writers than the federal government.¹³⁰ For example, at common law,

123. "The Congress shall have the power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

124. 17 U.S.C. § 4 (1976) (repealed 1978).

125. *Goldstein v. California*, 412 U.S. 546, 559 n.16 (1973) (Congress has made a conscious decision that no national interest exists in regulating the copyrightability of unpublished writings, or in providing for free competition in the area).

126. 17 U.S.C. § 2 (1976) (repealed 1978) provides: "Nothing in this title shall be construed to annul or limit the right of the author . . . of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefore."

127. *Sears, Roebuck & Co. v. Stiffel*, 376 U.S. 225, 231 n.7 (1964); *Mazer v. Stein*, 347 U.S. 201, 214 (1954).

128. Section 12 of the 1909 Act provided in pertinent part:

Copyright may also be had of the works of an author, of which copies are not reproduced for sale, by the deposit, with claim of copyright, of one complete copy of such work if it be a lecture or similar production or a dramatic, musical, or dramatico-musical composition; of a title and description, with one print taken from each scene or art if the work be a motion-picture photoplay; of a photographic print if the work be a photograph; of a title and description, with not less than two prints taken from different sections of a complete motion picture, if the work be a motion picture other than a photoplay, or of a photograph or other identifying reproduction thereof, if it be a work of art or a plastic work or drawing. But the privilege of registration of copyright secured hereunder shall not exempt the copyright proprietor from the deposit of copies . . . where the work is later reproduced in copies for sale.

17 U.S.C. § 12 (1976) (repealed 1978).

129. See *supra* notes 15-81 and accompanying text.

130. See *Straus, supra* note 21, at 189. These benefits included broader coverage, an absence of formalities (such as licensure), little or no restrictions on use, indefinite

unpublished writings were protected in perpetuity or until they were published.¹³¹ Federal law, by contrast, only offered protection for fifty-six years.¹³² By electing to register, writers were exchanging permanent protection for a protective scheme of limited duration.¹³³ Authors of manuscripts might not find this limitation objectionable because, upon publication, their rights would be governed by the federal act. Writers of private letters and diaries, however, never intended that their works be disseminated to the public. These writers consequently were effectively deterred from pursuing a registration option that offered protection for only a limited duration.¹³⁴ As a result, authors of private letters of historical significance had an incentive to secret these letters from the public forever. Furthermore, since all private papers filed with the copyright office were open to the public, filing was not an attractive alternative for authors of confidential material.¹³⁵ In these respects, the 1909 revision set the stage for a dichotomous and troublesome state/federal protective scheme that lasted for over fifty years.

B. *The Call for Statutory Reform: Three Proposals*

Congress quickly recognized the drawbacks to the common law and the early statutory protections for private writings. Indeed, a version of the bill that later became the general revision of the copyright law was first introduced in Congress in 1924.¹³⁶ Since that time, in a series of studies, the Copyright Office¹³⁷ has examined three ap-

duration, and no statutory limits or damages. *Id.* at 194-95. Although punitive damages were available at common law, *Roy Export Co. v. Columbia Broadcasting Sys.*, 672 F.2d 1095, 1106 (2d Cir. 1982), they are not awardable in statutory copyright infringement suits. *Oboler v. Goldin*, 714 F.2d 211, 213 (2d Cir. 1983).

131. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 591 n.1 (1834); *Walker v. Time Life Films, Inc.*, 1983 COPYRIGHT L. REP. (CCH) ¶ 25,554 (N.Y. Sup. Ct. 1983). *See generally* N. BOORSTYN, *supra* note 21, § 1.4 (states are not constrained by the "limited times" clause of the Constitution).
132. Under the 1909 Act, copyrights secured by statute would be limited to a term of 28 years with the possibility in most instances for one 28 year extension. 17 U.S.C. § 24 (1976) (repealed 1978). The Copyright Act of 1976 changed this to "life of the author and fifty years after the author's death." 17 U.S.C. § 302 (1982).
133. By electing to come under the federal scheme, writers forfeited all state law protections. N. BOORSTYN, *supra* note 21, § 1.4 (citing *Photo-Drama Motion Picture Co. v. Social Uplife Film Corp.*, 220 F. 448, 450 (2d Cir. 1915)).
134. *See supra* note 128.
135. Straus, *supra* note 21, at 195; Comment, *The Evolution of the Preemption Doctrine and its Effect on Common Law Remedies*, 19 IDAHO L. REV. 85, 97 (1983).
136. H.R. 9137, 68th Cong., 1st Sess. (1924). This bill represented the first attempt to amend the act at a general session. Its basic principle—of copyright from creation without compliance with formalities—was a departure from the traditional American approach to copyright law. Straus, *supra* note 21, at 210.
137. Straus, *supra* note 21, at 210-15; STUDIES ON COPYRIGHT, *supra* note 21, at 1203. The Legislative Appropriation Act of 1955 started the groundswell that eventually resulted in the 1976 enactment. The 1955 Act granted the Copyright Office funds to study various proposals on how to improve the then-existing copyright law. For a discussion of the various legislative proposals that were drafted under this

proaches to revise the laws pertaining to unpublished works.

The first approach retained the present dual federal/state protection system but stressed the voluntary federal protection for unpublished works that was then available under the 1909 Act.¹³⁸ Thus, the advantages of statutory protection would be available to all works, published or unpublished, and each author could elect the protective scheme that best suited his needs. Although it might have been possible to upgrade the registration system to preserve depositors' confidences, two problems associated with the 1909 act remained. First, the publication standard, with its attendant shortcomings, remained the dividing line between state and federal protective schemes. Courts were still left to wrestle with problems such as limited publication and implied disclosure. Second, since the common law remained unaffected by this dual system, private letter writers were still offered the more attractive perpetual protection at common law. As a result, the private papers of public figures would still remain permanently out of the public's reach.

The second proposal also suggested that the dual system be maintained but urged the redefinition of the dividing line between state and federal protection.¹³⁹ Because of the difficulties in defining "publication," the Copyright Office advocated a new test based upon "public dissemination."¹⁴⁰ The new public dissemination test would consist of determining whether a work "was communicated to the public visually or accoustically by any method and in any form, whether permanently fixed or not."¹⁴¹ It was this alternative test that the Register of Copyrights recommended in his report on the proposed general revision of the copyright law.¹⁴² In light of the problematic publication standard, the dissemination test must have appeared attractive initially. This initial attraction soon faded when it became apparent that as many problems would arise with respect to the public dissemination test as had arisen with publication. For example, private letters would retain their perpetual common law protection under either standard.¹⁴³

The third alternative became the basis for the broad preemption section that appears in the Copyright Act of 1976.¹⁴⁴ Supporters of this

mandate, see CAMBRIDGE RESEARCH INSTITUTE, OMNIBUS COPYRIGHT REVISION: COMPARATIVE ANALYSIS OF THE ISSUES 21-22 (1973).

138. See *supra* note 110.

139. Straus, *supra* note 21, at 218-22.

140. *Id.*

141. *Id.* at 218.

142. STUDIES ON COPYRIGHT, *supra* note 21, at 1199; see also The Sirovich Bill of 1932, H.R. 11948, 72d Cong., 1st Sess. (1932) (suggests test of "public presentation").

143. Straus, *supra* note 21, at 219.

144. 17 U.S.C. § 301 (1976) (repealed 1978). This section was the product of several unsuccessful efforts to unify state and federal copyright laws. See, e.g., H.R. 10364, 11948, 72d Cong., 1st Sess. (1932); S. 176, 72d Cong., 1st Sess. (1931); H.R. 10434, 69th Cong., 1st Sess. (1926); H.R. 9137, 68th Cong., 1st Sess. (1924).

approach argued that all state copyright law should be eliminated in favor of a single, uniform system of federal protection.¹⁴⁵ Theoretically, this revision would eliminate the troublesome concept of publication and provide the uniformity that was lacking under the pre-1976 state/federal system.

C. The Supreme Court and Preemption: A Foreshadowing of Things to Come

In a series of decisions, the Supreme Court analyzed the preemptive effect of federal copyright law over comparable state law. These cases prompted a closer examination of the preemption question and contributed directly to the current form of section 301, the preemptive provision of the 1976 Act.¹⁴⁶

*Sears, Roebuck & Co. v. Stiffel Co.*¹⁴⁷ and *Compco Corp. v. Day-Brite Lighting Inc.*,¹⁴⁸ both decided in 1964, involved federal preemption of state unfair competition laws. The legal arguments raised in each of these cases were influential during the congressional committee debates concerning the copyright revision that eventually became the Copyright Act of 1976.¹⁴⁹ In each case, the defendants copied the plaintiffs' unpatentable products¹⁵⁰ and were selling these look-alike products in direct competition with the plaintiffs' products. The United States District Court for the District of Northern Illinois enjoined the acts of both defendants on the ground that the copying of plaintiffs' products, regardless of whether they were patentable, constituted unfair competition under Illinois law.¹⁵¹ Although each case was affirmed by

145. STUDIES ON COPYRIGHT, *supra* note 21, at 1241 (Register of Copyright noted the advantages associated with a unified federal system, but declined suggestion that this system be adopted because "there are counterbalancing reasons to preserve the common law protections").

146. 17 U.S.C. § 301 (1982).

147. 376 U.S. 225 (1964).

148. 376 U.S. 234 (1964).

149. Goldstein, *Federal System Ordering of the Copyright Interest*, 69 COLUM. L. REV. 49, 91-92 (1969) (strong words of preemption provided the then-working legislative drafters with persuasive authority to support a national copyright law). Indeed, H.R. Rep. No. 94-1476 states that section 301 was drafted to be "consistent with the 1964 Supreme Court decisions in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964)." H.R. REP. NO. 1476, 94th Cong., 2d Sess. 131 (1976); *see also* S. REP. NO. 4739, 94th Cong., 1st Sess. 115 (1975) (citing *Sears* and *Compco*); S. REP. NO. 988, 93d Cong., 2d Sess. 116 (1974) (same).

150. *Compco*, 376 U.S. at 234. The trial court decided the issue of patentability in holding that the patents secured by the plaintiffs were invalid. *Id.* at 235. These included both design and utility patents on a pole lamp in *Sears* and a design patent on a lighting fixture in *Compco*. *Id.* at 235.

151. The court did not require that the defendants be shown to have "palmed off" their imitations as plaintiffs' products but only that a "likelihood of confusion" had arisen from the concurrent sale of the products in the same market. *Stiffel Co. v. Sears, Roebuck & Co.*, 313 F.2d 115, 118 (7th Cir. 1963), *rev'd*, 376 U.S. 225 (1964); *Day-Brite Lighting, Inc. v. Compco Corp.*, 311 F.2d 26, 29-30 (7th Cir.

the United States Court of Appeals for the Seventh Circuit,¹⁵² the Supreme Court reversed, holding that articles that are unprotected by either federal patent or copyright laws are in the public domain and therefore states may not forbid others from copying them.¹⁵³ The basis for these holdings, though, as set forth in the majority and concurring opinions, provided a source of controversy as to how far the preemptive intent of the impending Copyright Act, then in committee, was expected to extend.¹⁵⁴

In both *Sears* and *Compco*, Justice Black wrote for the majority while Justice Harlan filed a concurring opinion. Both justices agreed that, once a work is published, state law should not afford protection of any rights that are equivalent to, and therefore preempted by, federal law.¹⁵⁵

Justice Black argued that states should be prohibited from affording remedies to authors and inventors that were of the same type permitted by the copyright statute, irrespective of the equivalency to a federally protected right.¹⁵⁶ Justice Harlan asserted that a state should be able to vindicate any right that was not equivalent to a federally protected right. States could accomplish this by applying remedies that may be available under either the federal or state scheme.¹⁵⁷ Justice Harlan thus favored permitting states to maintain viable unfair competition laws.

Although *Sears* and *Compco* appeared to signal expansive judicial use of preemption, *Goldstein v. California*¹⁵⁸ ended any hope that the courts would unify state and federal copyright laws without congressional action. *Goldstein* involved a review of a criminal conviction for "piracy," i.e., unauthorized reproduction of sound recordings with the intent to distribute.¹⁵⁹ The petitioner argued that based on *Sears* and *Compco*, published sound recordings could only be protected under federal law.¹⁶⁰ If so, these cases preempted California's effort to protect sound recordings by imposing criminal penalties for their wrongful use.

1962), *rev'd*, 376 U.S. 234 (1964). The unreported district court opinions in *Compco* and *Sears* are summarized in the Supreme Court opinions. *Sears*, 376 U.S. at 226; *Compco*, 376 U.S. at 235-36.

152. *Stiffel Co. v. Sears, Roebuck & Co.*, 313 F.2d 115 (7th Cir. 1963), *rev'd*, 376 U.S. 234 (1964); *Day-Brite Lighting, Inc. v. Compco Corp.*, 311 F.2d 26 (7th Cir. 1962), *rev'd*, 376 U.S. 234 (1964).

153. *Sears*, 376 U.S. at 232-33; *Compco*, 376 U.S. at 237.

154. See Brown, *Unification: A Cheerful Requiem for Common Law Copyright*, 24 UCLA L. REV. 1070 (1977); Goldstein, *Preempted State Doctrines, Involuntary Transfers and Compulsory Licenses: Testing the Limits of Copyright*, 24 UCLA L. REV. 1107 (1977).

155. *Sears*, 376 U.S. at 230-31 n.7; *Compco*, 376 U.S. at 239 (Harlan, J., concurring).

156. *Sears*, 376 U.S. at 239.

157. *Id.* (Harlan, J., concurring); *Compco*, 376 U.S. at 239.

158. 412 U.S. 546 (1973).

159. *Id.* at 548.

160. *Id.*

Chief Justice Burger, writing for a five-member majority,¹⁶¹ first noted that states did not surrender their entire copyrighting authority to the federal government. The *Goldstein* Court noted that only those areas essential to the creation and maintenance of a "national protective" scheme were the exclusive province of federal law.¹⁶² Specifically, the Court recognized that state copyright authority was retained for matters of "local importance" that were "not worthy of national attention or protection."¹⁶³ Turning to the preemption question, the Court examined whether Congress had either specifically legislated in the area in question or, in the absence of congressional action, whether it had been determined that the specific article of commerce should be free from restraint.¹⁶⁴ As an example of a situation where Congress had determined that "neither federal protection nor freedom from restraint was required, the Court cited section 2, the non-preemption clause in the 1909 Act. In addressing the respondent's arguments, the majority held that, because sound recordings did not qualify as writings for purposes of the Copyright Act, there was no equivalent federal law on point.¹⁶⁵ Preemption thus had not occurred, regardless of whether the recordings had been published.¹⁶⁶

Goldstein thus recognized the absence of a per se constitutional or statutory preclusion of state copyright law.¹⁶⁷ Only congressional action could expand the preemptive influence of the federal act to include unpublished private writings.

IV. THE 1976 ACT: UNIFICATION UNDER FEDERAL LAW

The debate over how to reform the problematic 1909 Act culminated in 1976 when Congress enacted a substantial revision of the

161. Two dissenting opinions were filed. Justice Douglas, relying heavily upon *Sears* and *Compco*, argued that the federal interest in uniformity outweighed any countervailing state interest. *Id.* at 572-75 (Douglas J., dissenting). Justice Marshall, also relying upon *Sears* and *Compco*, contended that states may not burden the unauthorized use of sound recordings because, by failing to include these recordings, "Congress had decided that free competition should be the general rule." *Id.* at 578-79 (Marshall, J., dissenting). According to Justice Marshall, states could only act when a congressional failure to act "is hindering 'the Progress of Science and useful Arts.'" *Id.* at 579.

162. *Id.* at 553-58.

163. *Id.* at 558.

164. The *Goldstein* Court noted that this situation could not arise when Congress has determined that a certain article of commerce should be free from restraint. *Id.* at 559. The conflict would not arise, however, "where Congress determines that neither federal protection nor freedom from restraint is required by the national interest." *Id.* An example of a situation where Congress has made this choice is the non-preemption of unpublished writings. *Id.* at 559 n.16.

165. *Id.* at 568-69.

166. *Id.* at 570 n.28.

167. The Court indicated that state law governing unpublished writings was not preempted. *Id.* at 559 n.16 (dictum).

federal copyright laws.¹⁶⁸ Congress intended to unify the dual state/federal scheme of protection under one federal statute by preempting all state law doctrines that were "equivalent" to any of the newly enacted federal provisions.¹⁶⁹ In the area of unpublished writings, the 1976 Act abolished the publication distinction for actions arising after January 1, 1978.¹⁷⁰ Under the new act, federal copyright protection attaches when intellectual property is created, not when it is disseminated.¹⁷¹ Therefore, the act of writing a letter or making an entry in a diary is sufficient to bring the writings under the federal copyright umbrella. Although the abrogation of the publication distinction is indicative of an appreciation of the shortcomings of the common law, the federal scheme does not adequately anticipate many of the problems and interests that are unique to private writings. Nowhere is this more apparent than in the Act's remedial scheme.

A. Remedies Under the Copyright Act of 1976

Chapter five of the 1976 Act sets forth the remedies available in an action against an infringer.¹⁷² The list of remedies includes money damages, injunctive relief, impoundment/destruction, attorneys' fees, and a discretionary authority to award prejudgment interest. Punitive damages, although not discussed in the Act, may also be recoverable.

168. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2574 (1976) (effective Jan. 1, 1978).

169. 17 U.S.C. § 301 (1982). There has been some dispute over exactly what state law actions are preempted. *See, e.g.,* Smith v. Weinstein, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,625 (S.D.N.Y. 1984) (preempting unfair competition law); Klekas v. EMI Films, Inc., 1984 COPYRIGHT L. REP. (CCH) ¶ 25,629 (Cal. Ct. App. 1984) (preempting state plagiarism law); Videotronics v. Bend Electronics, 1983 COPYRIGHT L. REP. (CCH) ¶ 25,579 (D. Nev. 1983) (preempting trade secret/misappropriation law); Warrington Assoc. v. Real-Time Eng'g Sys., 522 F. Supp. 367 (N.D. Ill. 1981) (trade secret laws not preempted because they are based upon breach of trust or confidences, and not just unauthorized reproduction); Commonwealth v. Rizzuto, 1981 COPYRIGHT L. REP. (CCH) ¶ 25,233 (Pa. Super. Ct. 1980) (preempting theft conviction based upon unauthorized reproduction); *see also* Factors Etc., Inc. v. Professional Arts, Inc., 701 F.2d 11 (2d Cir. 1982) (right to publicity not preempted); Strout Realty, Inc. v. County 22 Real Estate Corp., 493 F. Supp. 997 (W.D. Mo. 1980) (preempting actions for breach of contract, misappropriation, and conversion).

170. There are some instances where publication might still be important. One authority notes that:

All works published prior to January 1, 1978, without proper copyright notice are now in the public domain. Any work that entered the public domain before that date cannot be given copyright protection under the Act. Therefore, it remains highly relevant to determine whether prior to 1978 certain acts constituted publication and whether such publication (without proper notice) cause the work to fall into the public domain.

N. BOORSTYN, *supra* note 21, § 1.6. Boorstyn also states that publication continues to be a significant factor in contexts that are unrelated to this article. *Id.*; *see also* 17 U.S.C. § 101 (1982) (current definition of publication).

171. H. HENN, COPYRIGHT PRIMER 28 (1979).

172. 17 U.S.C. § 501(a) (1982) (defining "infringer").

1. Monetary Damages

The 1976 Act provides two alternative types of monetary relief: actual damages and statutory damages.¹⁷³ The first alternative measures the out-of-pocket losses incurred by the plaintiff or any profits earned by the infringing defendant, or both.¹⁷⁴ These actual damages are computed by determining the extent to which the defendant's activities have adversely affected or destroyed the market value of the copyright.¹⁷⁵ Lost sales,¹⁷⁶ lost profits,¹⁷⁷ and consequential damages are the most common example of these damages.¹⁷⁸

Plaintiffs are also entitled to "any profits of the infringement that are attributable to the infringement and are not taken into account in computing actual damages."¹⁷⁹ Aside from the profits earned by the defendant, Congress's use of the phrase "attributable to" has been deemed to include profits that are indirectly related to the unlawful conduct as well.¹⁸⁰ The section places the burden of establishing profit from the infringement on the copyright owner.¹⁸¹ The infringing party, however, is permitted to deduct provable expenses and "elements of profit" attributable to factors other than the copyrighted work.¹⁸²

The interplay between the right to claim actual out-of-pocket damages and the right to recover the defendant's profits has created a debate over the ceiling on infringement damages. Some authorities contend that the actual damages and infringement profits are mutually exclusive; thus, a plaintiff can only recover the greater of each element.¹⁸³ Another authority argues that recovery for both should be

173. 17 U.S.C. § 504(b) (1982).

174. *Id.*

175. 3 N. NIMMER, *supra* note 4, § 14.02.

176. *Stevens Linen Assocs., Inc. v. Mastercraft Corp.*, 656 F.2d 11 (2d Cir. 1981); *Big Seven Music Corp. v. Lennon*, 554 F.2d 504 (2d Cir. 1977); *Lauratex Textile Corp. v. Allton Knitting Mills, Inc.*, 517 F. Supp. 900 (S.D.N.Y. 1981).

177. *Stevens Linen Assocs., Inc. v. Mastercraft Corp.*, 656 F.2d 11 (2d Cir. 1981).

178. 4 N. NIMMER, *supra* note 4, § 14.02.

179. 17 U.S.C. § 504(b) (1982).

180. These damages may include the amount of profits attributable to the following: (1) infringing portion of the defendant's work; or (2) factors unrelated to the work itself, such as the increase in popularity of an infringing singer. R. FRACKMAN, *LITIGATING COPYRIGHT CASES*, reprinted in R. SUGARMAN, *LITIGATING COPYRIGHT, TRADEMARK AND UNFAIR COMPETITION CASES* 33-34 (PLI Course Handbook Series No. 224 (1983)). These damages may also include the importance and popularity of the infringing material and the increase in value that the infringing material has brought about in the defendant's original works. *Id.* at 34 (citing *ABKCO Music, Inc. v. Harrison's Music, Ltd.*, 508 F. Supp. 798 (S.D.N.Y. 1981), *aff'd*, 722 F.2d 988 (2d Cir. 1983); *Lottie Joplin Thomas Trust v. Crown Publishers, Inc.*, 456 F. Supp. 531 (S.D.N.Y. 1977), *aff'd*, 592 F.2d 651 (2d Cir. 1978)).

181. 17 U.S.C. § 504(b) (1982).

182. *See Sid & Marty Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157, 1173-74 (9th Cir. 1977).

183. *Sid & Marty Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977); *Fedtro, Inc. v. Kravex Corp.*, 313 F. Supp. 990 (E.D.N.Y. 1970).

permitted because each exists to accomplish a different purpose.¹⁸⁴ Actual damages are designed to compensate the plaintiff for his losses while a recovery of infringement profits is aimed at preventing the defendant from profiting from his unlawful conduct.¹⁸⁵

2. Statutory Damages

A plaintiff who elects to forego compensatory damages can recover statutory damages fixed by the 1976 Act.¹⁸⁶ These damages range from \$250 to \$10,000,¹⁸⁷ depending upon what the trial judge "considers just."¹⁸⁸ The 1976 Act also imposes harsher penalties on those who willfully violate its provisions, and it accords leniency in appropriate cases. In cases involving willful infringement, the awardable statutory damages ceiling is raised to \$50,000.¹⁸⁹ In contrast, when the infringing party is able to show that he was not aware of and had no reason to believe that he was infringing on the rights of another, statutory dam-

184. See *Miller v. Universal Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981) (holding that 17 U.S.C. § 101(b) (1976) (repealed 1978) allows cumulative recovery; court cites decisional law for and against this proposition).

185. *Miller v. Universal Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981); see 3 N. NIMMER, *supra* note 4, § 14.01.

186. The election can be made "at any time before final judgement is rendered. . . ." 17 U.S.C. § 504(c)(1) (1982). If the writer can prove injury but is unable to establish the infringer's profits or actual damages, he is entitled to mandatory statutory damages. *Russell v. Price*, 612 F.2d 1123, 1129-36 (9th Cir. 1979), *cert. denied*, 446 U.S. 952 (1980); *Dealer Advertising Dev., Inc. v. Barbara Allan Fin. Advertising, Inc.*, 644 F.2d 960, 966-70 (6th Cir. 1979) (since plaintiff offered no proof of damages or profits, the court exercised its discretion to award "in lieu of" damages under the copyright act).

187. 17 U.S.C. § 504(c)(1) (1982).

188. Statutory damages are in the nature of an equitable remedy and therefore there is no right to a jury trial. *Rodgers v. Breckenridge Hotel Corp.*, 512 F. Supp. 1326 (E.D. Mo. 1981); *Glazier v. First Media Corp.*, 532 F. Supp. 63 (D. Del. 1982). *But see* *Gnosso Music v. Mitken, Inc.*, 653 F.2d 117 (4th Cir. 1981) (when a suit is based upon tortious interference with a property right, the defendants are entitled to a jury trial). See *generally* Annot., 64 A.L.R. Fed. 310 (1983) (discussing how courts have drawn the law and equity distinctions).

189. 17 U.S.C. § 504(c)(2) (1982). The section also creates a complete defense for persons engaged in the following acts:

The Court shall remit statutory damages in any case where an infringer believed and had reasonable grounds for believing that his or her use of the copyrighted work was a fair use [citation omitted] if the infringer was: (i) an employee or agent of a nonprofit educational institution, library, or archives acting within the scope of his or her employment who, or such institution, library, or archives itself, which infringed by reproducing the work in copies or phonorecords; or (ii) a public broadcasting entity which infringed by reproducing the work in copies or phonorecords; or (iii) a public broadcasting entity which or a person who, as a regular part of the nonprofit activities of a public broadcasting entity [citation omitted] infringed by performing a published nondramatic literary work or by reproducing a transmission program embodying a performance of such a work.

Id.

ages may be reduced to \$100.¹⁹⁰

3. Injunctive Relief

Under the heading of injunctive relief, the 1976 Act provides that "any court having jurisdiction of a civil action" arising under the federal copyright act may "grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright."¹⁹¹ All injunctions entered may be served in any federal district, and are enforceable throughout the United States.¹⁹² Since the issuance of a preliminary injunction is regarded as an equitable remedy, federal courts have required that copyright owners establish the same elements required in other injunctive actions. Specifically, some courts require that the plaintiff show the following: (1) substantial likelihood of success on the merits;¹⁹³ (2) irreparable harm will follow if the injunction is not issued;¹⁹⁴ (3) anticipated harm outweighs the inconvenience that the injunction might cause the defendant;¹⁹⁵ and (4) issuing the injunction will not offend the public interest.¹⁹⁶ Other courts, though, only require that a plaintiff establish a *prima facie* case of infringement because irreparable injury "can be presumed when a copyright is infringed."¹⁹⁷ At the successful completion of his case, the

190. *Id.* Generally, a willful violation involves the unauthorized use of copyrighted material with the knowledge, or after having received a warning, that this use is unlawful. *Lauratex Textile Corp. v. Allton Knitting Mills, Inc.*, 517 F. Supp. 900 (S.D.N.Y. 1981) (pattern of repeated infringement); *Hospital for Sick Children v. Melody Fare Dinner Theatre*, 516 F. Supp. 67 (E.D. Va. 1980) (willful, knowledgeable infringement); *Iowa State Univ. Research Found., Inc. v. American Broadcasting Co.*, 475 F. Supp. 78 (S.D.N.Y. 1979), *aff'd*, 621 F.2d 57 (2d Cir. 1980); *see also Johnson v. Saloman*, 197 U.S.P.Q. (BNA) 801 (D. Minn. 1977) (concealment of violation contributed to finding willfulness).

191. 17 U.S.C. § 502(a) (1982).

192. *Id.* § 502(b).

193. *Dollcraft Indus. v. Well-Made Toy Mfg. Co.*, 479 F. Supp. 1105, 1113 (E.D.N.Y. 1978); *Encyclopedia Britannica Educ. Corp. v. Crooks*, 447 F. Supp. 243, 247 (W.D.N.Y. 1978). *Contra Building Officials & Code Admin. v. Code Technology, Inc.*, 628 F.2d 730, 732 (1st Cir. 1980) ("[w]e do not agree with the district court's conclusion that [plaintiff's] probability of success on the merits justifies preliminary relief").

194. "Irreparable injury may normally be presumed from a showing of copyright infringement." *Wainwright Sec., Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91, 94 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978). It may also be shown by proving that the plaintiff's product will be reduced in value as a result of the wrongdoer's unauthorized use. *Atari, Inc. v. North Am. Phillips Consumer Elecs. Corp.*, 672 F.2d 607, 619 (7th Cir.), *cert. denied*, 103 S. Ct. 176 (1982).

195. *Warner Bros. v. American Broadcasting Co.*, 523 F. Supp. 611, 619 (S.D.N.Y.), *aff'd*, 654 F.2d 204 (2d Cir. 1981); *Tex Printing Indus. v. Zayre Corp.*, 197 U.S.P.Q. (BNA) 538, 542-43 (D. Mass. 1977).

196. *Metro-Goldwyn-Meyer, Inc. v. Showcase Atlanta Coop. Prods., Inc.*, 479 F. Supp. 351, 355 (N.D. Ga. 1979) (citing *Dallas Cowboy Cheerleaders v. Scoreboard Posters*, 600 F.2d 1184 (5th Cir. 1979)).

197. *Wainwright Sec., Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91, 94 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978); *see also Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1094 (2d Cir. 1977) (quoting *American Metropolis*

copyright owner will be entitled to a permanent injunction if it is likely that there will be future violations of the copyright laws.¹⁹⁸ Courts will not, however, enter an injunction that is unworkable or unenforceable.¹⁹⁹

4. Impoundment and Destruction of Infringing Articles

At any time while a copyright action is pending, "the court may order the impounding . . . of all copies . . . claimed to have been made or used in violation of the copyright owner's exclusive rights. . . ." ²⁰⁰ As part of its final decree, the court may order either destruction of the offending property or any other disposition that it deems reasonable.²⁰¹ Upon proper showing and the posting of a bond, a federal marshal will seize and hold the disputed items until the judge rules on their disposition.²⁰² Since applications for seizure ordinarily accompany requests for injunctive relief,²⁰³ a showing of irreparable harm is apparently required before the court will issue a seizure order. Destruction of the property, a harsh remedy, will only be ordered by a court when it is likely that the defendant will continue his infringement in contempt of the injunction.²⁰⁴

5. Attorneys' Fees, Costs, and Interest

Although not mandatory, a court in the exercise of its discretion may assess costs and attorneys' fees against any party other than the United States or its representative.²⁰⁵ Generally, in awarding fees and costs courts have looked to the willfulness of the defendant's infringe-

Enters. of New York, Inc. v. Warner Bros. Records, Inc., 289 F.2d 903, 905 (2d Cir. 1968)); *Jovan, Inc. v. A.R. Winarick, Inc.*, 196 U.S.P.Q. (BNA) 507 (N.D. Ill. 1977).

198. *Orth-O-Vision, Inc. v. Home Box Office, Inc.*, 474 F. Supp. 672, 685-86 (S.D.N.Y. 1979); *Encyclopedia Britannica Educ. Corp. v. Crooks*, 542 F. Supp. 1156, 1187 (W.D.N.Y. 1982).

199. *Universal City Studios, Inc. v. Sony Corp. of Am.*, 480 F. Supp. 429, 468-69 (C.D. Cal. 1979), *modified*, 659 F.2d 963 (9th Cir. 1981), *aff'd*, 104 S. Ct. 774 (1984).

200. 17 U.S.C. § 503(a) (1982).

201. *Id.* § 503(b).

202. Copyright Rule 3-5 (adopted by the United States Supreme Court), *reprinted in* Annot., 22 A.L.R. Fed. 487, 491-93 (1975 & Supp. 1983).

203. *National Research Bureau, Inc. v. Kucker*, 481 F. Supp. 612, 614-16 (S.D.N.Y. 1979) (granting impoundment order after plaintiff requested that the defendant be found in contempt of a previously issued injunction); *Dollcraft Indus. v. Well-Made Toy Mfg. Co.*, 479 F. Supp. 1105 (E.D.N.Y. 1978) (impounding order issued pursuant to the granting of an injunction).

204. *National Research Bureau, Inc. v. Kucker*, 481 F. Supp. 612 (S.D.N.Y. 1979).

205. 17 U.S.C. § 505 (1982). The cost award provision of the 1909 Act made awarding costs mandatory. *Boz Scaggs Music v. KND Corp.*, 491 F. Supp. 908, 915 (D. Conn. 1980); *see also Marks v. Leo Feist*, 8 F.2d 460, 461 (2d Cir. 1925) (costs are mandatory).

ment²⁰⁶ and the frivolous nature of litigation.²⁰⁷ With respect to attorneys' fees, however, the item must have been registered with the copyright office prior to the infringement.²⁰⁸ In addition to these discretionary damages, the prevailing copyright owner may also recover prejudgment interest, even though this remedy is not specified in the Act.²⁰⁹

6. Punitive Damages

The availability of punitive damages in copyright actions is defined by the preemptive reach of the 1976 Act. The emerging consensus is that, while punitive damages are not available for statutory copyright actions,²¹⁰ they are available for pendent state law claims to the extent that these claims are not preempted.²¹¹ For example, in *Oboler v. Goldin*,²¹² the plaintiff joined an unfair competition claim with a copyright infringement suit. The United States Court of Appeals for the Second Circuit affirmed the district court's decision denying punitive damages. The *Oboler* court reasoned that since causes of action for unfair competition were preempted by federal law, no punitive damages could be awarded for a suit based solely upon a violation of the copyright statute.²¹³ Although the precise reach of federal preemption is currently in dispute,²¹⁴ a plaintiff may have greater success in bringing pendent claims for invasion of privacy,²¹⁵ wrongful appropriation of trade secrets,²¹⁶ or any other non-preempted state law

206. *Lauratex Textile Corp. v. Allton Knitting Mills, Inc.*, 517 F. Supp. 900, 904 (S.D.N.Y. 1981) (court found award of attorneys' fees particularly appropriate "in light of willful violations over a five year period"); *Boz Scaggs Music v. KIND Corp.*, 491 F. Supp. 908, 915 (D. Conn. 1980) (considerations that will impact upon court's allocation of fees include novel questions of law presented by the case, the defendant's willful violation of the copyright act, bad faith prosecution of a claim by the plaintiff, and any good faith attempts by the defendant to avoid litigation); *Samet & Wells, Inc. v. Shalom Toy Co.*, 429 F. Supp. 895, 904 (S.D.N.Y. 1977), *aff'd mem.*, 578 F.2d 1369 (2d Cir. 1978).

207. *Quinto v. Legal Times of Washington, Inc.*, 511 F. Supp. 579 (D.D.C. 1981); *Synercom Technology, Inc. v. University Computing Co.*, 462 F. Supp. 1003 (N.D. Tex. 1978).

208. The prevailing party must have registered his copyright prior to the commencement of the infringement. 17 U.S.C. § 412 (1982). See generally 3 N. NIMMER, *supra* note 4, §§ 7.16[C], 14.10[A] (discussing the registration requirement).

209. *ABK Co. Music v. Harrisongs Music, Ltd.*, 508 F. Supp. 798 (S.D.N.Y. 1981); *Fedtro, Inc. v. Kravex Mfg. Corp.*, 313 F. Supp. 990 (E.D.N.Y. 1970).

210. See, e.g., *Oboler v. Goldin*, 714 F.2d 211, 213 (2d Cir. 1983); *Kamakazi Music Corp. v. Robbins Music Corp.*, 534 F. Supp. 69 (S.D.N.Y. 1982); 3 N. NIMMER, *supra* note 4, § 14.02, at 14-12.

211. *Roy Export Co. v. Columbia Broadcasting Sys.*, 672 F.2d 1095 (2d Cir. 1982); *United Feature Syndicate v. Sunnse*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,623 (S.D. Fla. 1983).

212. 714 F.2d 211 (2d Cir. 1983).

213. *Id.* at 213.

214. See *supra* note 169.

215. See *supra* note 121.

216. *Technican Medical Information Sys. Corp. v. Green Bay Packaging, Inc.*, 687 F.2d 1032 (7th Cir. 1982), *cert. denied*, 103 S. Ct. 732 (1983); *Videotronics v. Bend*

claim.²¹⁷

B. The Remedies Applied to Private Writings

As the foregoing discussion indicates, the Copyright Act of 1976 offers private writers a cause of action that might eventually lead to only monetary or injunctive relief. While monetary relief will be attractive to authors whose manuscripts are scheduled for publication, private writers will not be adequately compensated by the financial awards available under the 1976 Act for two reasons. First, private letters have little pecuniary worth because there will be no lost sales or lost profits. At best, the plaintiff can only hope to divest the defendant of any gain attributable to the unauthorized use of the letters. No damages are available to recompense a person's interest in being free from public exposure of his guarded secrets and confidences. Second, the 1976 Act offers no archival protection. The sole option available to private writers is to hope that would-be infringers will be deterred by the threat of future liability.

V. A PROPOSAL TO AMEND THE COPYRIGHT ACT

The best way to protect private writings is to amend the current federal statute. A return to the common law will not solve the problems with the 1976 Act since reshaping these antiquated common law doctrines beyond their intended boundaries will only serve to aggravate, rather than resolve, the vagaries in the common law. Privacy actions, believed by some to pose a proper solution,²¹⁸ not only place arduous burdens on those who seek to invoke them, but their protective scheme lacks coverage in several areas that are crucial to private writers.²¹⁹ In addition, because some states do not recognize a cause of action for invasion of privacy, lack of uniformity would result and, once again, geography rather than logic or fairness would define an author's rights. Thus, because copyright law has virtually become the domain of federal protection, the federal statute is the logical choice for designing an effective collection of rights for private writers. Since privacy law has developed largely through state law, it is not a satisfactory area for federal intervention.

The centerpiece of a federal statutory amendment should be a substitution of a writer's dissemination standard for the pre-1976 publica-

Elecs., 1983 COPYRIGHT L. REP. (CCH) ¶ 25,579 (D. Nev. 1983); *Warrington Assocs., Inc. v. Real-Time Eng'g Sys.*, 522 F. Supp. 367 (N.D. Ill. 1981). For an extensive discussion of the extent to which state trade secret law has been preempted, see H. EPSTEIN, *MODERN INTELLECTUAL PROPERTY* 113-14 (1984).

217. *United Feature Syndicate v. Sunrise*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,623 (S.D. Fla. 1983) (violation of Florida Deceptive Trade Practices statute and common law of unfair competition); *Roy Export Co. v. Columbia Broadcasting Sys.*, 503 F. Supp. 1137 (S.D.N.Y. 1980), *aff'd*, 672 F.2d 1095 (2d Cir. 1982) (New York's unfair competition law not preempted).

218. See, e.g., *Warren & Brandeis*, *supra* note 83; Comment, *supra* note 27; Comment, *supra* note 22.

219. See *supra* note 89.

tion rules. Under this proposed standard, the essential inquiry would focus upon whether the writer had authorized the distribution of the material in question. Since the mere act of writing imparts copyright protection, any dissemination, other than the one instigated to the intended receiver or expressly consented to by the author, would be unauthorized. To avoid possible abuses of this provision, remedies would be available only for unauthorized dissemination of information that would be deemed objectionable or injurious to the reasonable person under an objective standard. The privacy law requirement that intrusive conduct be objectionable to persons of ordinary sensitivity would provide such a standard.²²⁰

Second, the remedies available for breach of the standard should demonstrate an appreciation of the unique types of harm inflicted by the unauthorized reproduction of private letters and diaries. Certainly, return of the original material and any unauthorized copies would be mandatory. Additional damages, perhaps even discretionary punitive or mandatory treble damages, could be awarded where a sensitive item was widely distributed or where the defendant has acted maliciously or willfully. At the very least, compensation should be available for all demonstrable injuries. In calculating damages for these injuries, the trier of fact should be permitted to consider any invasion of privacy or provable emotional distress, in addition to lost profits or sales.

Third, the amendment would charge the copyright office with the responsibility for storing confidential records, either permanently or for the duration of an adjudication of a copyright. This depository would provide authors of private writings with a meaningful registration option that would guarantee the confidentiality of the items filed. Moreover, a registration provision that offers assurances of meaningful protection would encourage filings, and thereby create a new archives of otherwise unavailable writings and records. As a result, the amendment would create a new centralized source of valuable historical data.

Fourth, an amendment to the 1976 Act could clarify the rules regarding the release of private writings when these writings are deemed to have historical value. An historical exception would provide a meaningful balance between the competing interests of personal privacy and of public access to historically valuable materials. As in copyright law generally, the exception might not take effect until a reasonable time after the writer's death. For example, the present standard, the life of the author plus fifty years, would adequately fulfill this purpose.²²¹

VI. CONCLUSION

The copyright clause of the Constitution authorizes the federal

220. See *supra* note 102.

221. See *supra* note 132.

government to provide protection for "writings and discoveries" as part of its general mandate.²²² In the area of private writings, Congress has historically failed to meet this challenge. By incorporating the common law by reference, a problematic and exception-riddled protective scheme was accorded federal recognition. While the 1976 Act eliminates many of the problems associated with the common law approach, it fails to offer the private writer protection that recognizes his unique circumstances. Under the revised act, the author of a private letter or a diary acquires only the right to sue those who violate his secrecy. If he is successful in court, the 1976 Act offers only compensation for pecuniary losses, not for the violated confidences. A revised remedial scheme that is aimed at protecting these intangible interests, coupled with a repository where private writers can deposit their letters and diaries with the assurance that these works will be kept confidential, will offer private writers a meaningful incentive to record their thoughts.

Although there are perhaps other solutions that would also serve to protect private writings, no steps have been taken in this area to amend the 1976 Act. Until these steps are taken, however, the public as well as historians risk losing access to the type of unique historical perspective that is found only in the private letters and diaries of contemporary figures.

222. U.S. CONST. art. I, § 8, cl. 8.