

**COPYRIGHTED CRIMES:  
THE COPYRIGHTABILITY OF ILLEGAL WORKS**

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**ABSTRACT**

*Copyright law does not explicitly impose content-based restrictions on the copyrightability of works. As long as a work is original and fixed in a tangible medium of expression, it is entitled to copyright protection and eligible for registration, regardless of its content. Thus, child pornography, snuff films or any other original works of authorship that involve criminal activities are copyrightable. Such work can be highly profitable for its makers even though society does not necessarily benefit from, and might even be harmed by, the work. Along with revenue from sales, the author of an illegal work may also be able to collect damages for infringement. This scheme does not benefit society and should be revised.*

*After examining how the current copyright regime deals with works involving illegal activity, this article suggests a new framework. First, I review the elements of copyright and consider existing content-based restrictions in copyright, trademark, and patent law. After evaluating whether copyright law should impose content-based restrictions on illegal works, and whether such impositions would be constitutional, I conclude that creators should not benefit from works that are linked to harmful criminal activities. I propose a new framework for the copyright of such works that de-incentives their creation by eliminating profits from the works themselves and reducing profits from the felon's other works due to his or her notoriety, while also compensating victims.*

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## I. INTRODUCTION

Imagine that two men brutally murder an innocent, defenseless victim, using a hammer and a screwdriver, while another person films the entire act. Shortly after the gruesome murder, this snuff video finds its way to the Internet and is downloaded many times over a short period.<sup>1</sup> Now imagine that both murderers are sentenced to life in prison, while the filmmaker receives a shorter prison term. Not long after, one of the convicted murderers publishes a book that describes the murder, and the other convicted murderer publishes an autobiography relying on his infamous reputation to increase the book's profits. The filmmaker files

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<sup>1</sup> Snuff films depict the actual murder of a person for the enjoyment of the audience, often for the express purpose of increasing distribution and entertainment or financial exploitation. See, e.g., Arnold H. Loewy, *Obscenity, Pornography, and First Amendment Theory*, 2 WM. & MARY BILL RTS. J. 471, 476 (1993) (defining "snuff films").

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multiple lawsuits against anyone who allegedly infringed his rights to the video, highly profiting from them.<sup>2</sup>

In this article, I consider whether copyright should offer legal remedies and protection for such works, which not only do not necessarily benefit society, but are also capable of causing harm. As a normative matter, should the law disregard or even enable profits from crimes?

Under current copyright law, illegal works<sup>3</sup> are usually treated just like other works: a work that is original and fixed in a tangible medium of expression is entitled to copyright protection and eligible for registration.<sup>4</sup> However, this interpretation of copyright law is relatively new. Until 1979, many, if not most, courts interpreted copyright law to explicitly bar the registration of illegal, immoral, fraudulent, or blasphemous works.<sup>5</sup> Prior to 1979, most U.S. courts held that illegal works were not copyrightable and, when the copyright holders attempted to assert their rights against infringers, most courts found that the works' connection to illegal activity granted any alleged infringers a valid defense.<sup>6</sup> Since 1979, however, the question of whether copyright subsides in illegal works has become less clear.<sup>7</sup> While the Fifth and Ninth Circuits have held that *all* original works

<sup>2</sup> A similar incident occurred in 2008 in Ukraine, though the convicted felons were not enriched as a result. The infamous “Dnepropetrovsk Maniacs,” a pack of Ukrainian thrill killers, filmed “3 Guys 1 Hammer,” a snuff film that was released online and downloaded many times. See *Dnepropetrovsk Maniacs Murder Guy with Hammer and Screwdriver (Real Snuff Video)*, BESTGORE.COM (Dec. 9, 2008), <http://www.bestgore.com/murder/dnepropetrovsk-maniacs-murder-guy-hammer-screwdriver-real-snuff-video>; *The Dnepropetrovsk Maniacs*, CRIMINALMINDS, [http://criminalminds.wikia.com/wiki/The\\_Dnepropetrovsk\\_Maniacs](http://criminalminds.wikia.com/wiki/The_Dnepropetrovsk_Maniacs) (last visited Jan. 1, 2014).

<sup>3</sup> I consider works of authorship “illegal” if: i) their content is criminal, such as snuff; ii) they are directly linked to harmful crimes, including works that promote criminal activity; or iii) they are otherwise legal works made by a felon that profit from the felon’s infamous reputation. Although the last example is not illegal *per se*, I categorize it as such, as it promotes the undesirable outcome of profit from criminal activity.

<sup>4</sup> 17 U.S.C. § 102(a) (2012) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device . . . .”); 17 U.S.C. § 101 (2012) (“A work is ‘fixed’ in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is ‘fixed’ for purposes of this title if a fixation of the work is being made simultaneously with its transmission.”).

<sup>5</sup> See *infra* note 54.

<sup>6</sup> *Id.*

<sup>7</sup> See *infra* Section II.B.2.

of authorship fixed in a tangible medium are copyrightable, whether connected to illegal activity or not, district courts in the Second Circuit have disagreed. Other circuits have not directly addressed this matter.<sup>8</sup> Thus, the law's current position on copyright for illegal works is uncertain. This uncertainty should be explicitly addressed by Congress or, if a case finds its way to the bench, by the Supreme Court.

Whether certain types of illegal works are undesirable for society and whether their authors should profit from them is disputable. Furthermore, even if the works are undesirable, it is unclear that copyright law is the proper tool for censoring them, or that such censorship would be constitutional. For example, the Constitution empowers Congress to enact copyright laws in order to promote the progress of science and useful arts.<sup>9</sup> Do illegal works promote these constitutional goals? On the other hand, censorship-by-copyright could endanger other constitutional rights, first and foremost First Amendment rights and possibly due process rights.<sup>10</sup> At the same time, can the law provide a more appropriate method for discouraging such works? Finally, how will any such framework distinguish between desirable and undesirable works?

In this article, I analyze copyright law's approach to content-based restrictions on illegal works. I review the elements of copyright, address historical content-based restrictions in copyright, and compare them to the treatment of illegal works by other intellectual property ("IP") laws. After evaluating whether the law should limit copyright only to legal works, and whether such a limitation would be constitutional, I argue that certain types of illegality that harm individuals should not grant profits to the felon. I base this position on the normative justification that criminals should not profit from their crimes.<sup>11</sup> After reviewing equitable doctrines and propositions in current literature, I propose a new framework of *illegal copyright*, which is designed to discourage criminal behavior and the making of undesired works by eliminating profits from copyrighted materials related to crime and reducing profits from a felon's infamous reputation. Importantly, this framework also takes into account victims and proposes a victim compensation element.

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<sup>8</sup> *Id.*

<sup>9</sup> U.S. CONST. art. I, § 8, cl. 8. This is discussed *infra* Section III.A.

<sup>10</sup> *See infra* Section III.

<sup>11</sup> *See, e.g.,* *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 119 (1991) ("The State likewise has an undisputed compelling interest in ensuring that criminals do not profit from their crimes.").

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My proposed framework is threefold: *First*, the copyright of a work that is directly and substantially connected to a crime<sup>12</sup> will be expropriated from the person who was convicted of, pled guilty to, or voluntarily admitted to the crime (hereinafter the *copyright felon*) and will be reallocated to a “Crime Victims Board” (CVB). If such material exists but was never registered, the CVB will be able to register as its copyright owner. *Second*, the CVB will be able to sue the copyright felon for any existing profits from any work directly and substantially connected to the crime. *Third*, the CVB will be able to sue the copyright felon for any other profits he or she reaped from the notoriety he or she gained from the crime. The CVB will deposit any profits obtained from the three provisions in an escrow account, which the board will manage and use for the benefit of the victim, her living relatives, and/or any victims of similar offences throughout the country. To distribute the money, the CVB will publish legal notices to potential victims of the crime.

The article proceeds as follows: Section II examines the elements of copyrightability and provides a brief historical overview of content-based restrictions in copyright law. Section III examines whether restrictions on illegal content are constitutional. Section IV compares the censorship-by-copyright approach to other IP laws. Section V outlines the main benefits and drawbacks of a content-neutral approach toward illegal works, and evaluates whether such an approach is desirable. Section VI argues that illegal works should not grant profits to their maker. For this matter, I evaluate the current remedies available for a defense in an infringement lawsuit and propose a new legal framework of *illegal copyright*. Finally, Section VII summarizes the discussion and concludes that some criminals should not profit from their misconduct, while their victims should nevertheless be compensated from profits connected with the crime or the criminal.

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<sup>12</sup> The set of relevant crimes can be defined by statute. It should include those crimes that result in physical or emotional harm to an individual. In order to reduce differences in state criminal prohibitions, the type of crimes should be set at a high level, i.e., conduct which is considered a criminal offence in each state resulting in physical or emotional harm to an individual.

## II. COPYRIGHTABILITY

### A. *Elements of Copyright*

Copyright law grants protection to original works of authorship fixed in any tangible medium of expression.<sup>13</sup> As required by the Berne Convention,<sup>14</sup> registration is not a condition for copyright protection in the United States.<sup>15</sup> Copyright inheres in authorship and exists without registration.<sup>16</sup> However, copyright registration is necessary in order for the author to accrue certain rights and benefits.<sup>17</sup>

After an applicant files for copyright registration,<sup>18</sup> the Register of Copyrights reviews the application and determines whether the material deposited constitutes copyrightable subject matter.<sup>19</sup> If the content is eligible for copyright protection, the Register grants registration and issues a certificate of registration to the applicant, which can be used as presumptive evidence of a valid copyright.<sup>20</sup> However, the Register can refuse to register material that does not constitute copyrightable subject

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<sup>13</sup> See *supra* note 4. Works of authorship include literary, musical, dramatic, pantomime, choreographic, pictorial, graphic, sculptural, audiovisual, and architectural works, as well as sound recordings and motion pictures. 17 U.S.C. § 102(a) (2012). Ideas, procedures, processes, systems, method of operations, concepts, principles and discoveries are not protected. 17 U.S.C. § 102(b) (2012).

<sup>14</sup> Berne Convention for the Protection of Literary and Artistic Works, art. 5 (2), July 24, 1971, 1161 U.N.T.S. 3 (as revised in 1971) (“The enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work.”).

<sup>15</sup> 17 U.S.C. § 408–12 (2012). See generally, Aaron B. Rabinowitz, *Criminal Prosecution for Copyright Infringement of Unregistered Works: A Bite at an Unripe Apple?*, 49 SANTA CLARA L. REV. 793, 794, 798 (2009).

<sup>16</sup> See *supra* note 14.

<sup>17</sup> For example, in a civil action, registration or preregistration of a domestic work is a necessary requirement in order to sue for copyright infringement and to claim attorney’s fees and statutory damages. See Erin Hogan, *Survey, Approval Versus Application: How to Interpret the Registration Requirement Under the Copyright Act of 1976*, 83 DENV. U. L. REV. 843, 843 (2006) (noting that “certain rights and benefits accrue only upon copyright registration.”). However, registration is not required for cases involving foreign works, as 17 U.S.C. § 411 (2012) only applies to a “United States work.” See DEP’T OF JUSTICE, PROSECUTING INTELLECTUAL PROPERTY CRIMES 21 (2013), available at [http://www.justice.gov/criminal/cybercrime/docs/prosecuting\\_ip\\_crimes\\_manual\\_2013.pdf](http://www.justice.gov/criminal/cybercrime/docs/prosecuting_ip_crimes_manual_2013.pdf). The exception to § 411 is an action brought in the event of a violation of the rights of attribution and integrity of a visual art author, set out in 17 U.S.C. § 106A (a).

<sup>18</sup> 17 U.S.C. § 109 (2012).

<sup>19</sup> *Id.* § 410(a).

<sup>20</sup> *Id.* § 410.

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matter or if the claim is “invalid for any other reason.”<sup>21</sup> Currently, the Copyright Office will not base refusal for “any other reason” on a work’s content.<sup>22</sup> Instead, such refusal may only be based on information “bearing upon the preparation or identification of the work or the existence, ownership, or duration of the copyright.”<sup>23</sup> Therefore, the Copyright Office considers only whether the material falls within the subject matter<sup>24</sup> of copyright and whether it represents a sufficient amount of original, creative authorship to justify registration.<sup>25</sup>

Thus, with the exception that works of authorship must be original, a narrow interpretation of copyright law suggests that the determination of whether or not a work is copyrightable is *content-neutral*. As long as the work is original and fixed in a tangible medium of expression, it is copyrightable and, after registration, that copyright can be enforced even if the work is deemed illegal.<sup>26</sup> In addition, the nature of a work does not affect the rights or defenses that the Copyright Act provides. For example,

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<sup>21</sup> *Id.* § 410(b).

<sup>22</sup> *In re* Opinion of Attorney General of the United States, 183 U.S.P.Q. (BNA) 624 (1974); 2-7 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.21 (16 ed. 2012) [hereinafter NIMMER] (arguing that “[a]lthough it has been said that this discretion includes the power to refuse registration of seditious, libelous and obscene matter, the Copyright Office has declared that it will not refuse registration on these grounds.”).

<sup>23</sup> 17 U.S.C. § 409(10) (2012); NIMMER, *supra* note 22, at § 7.21.

<sup>24</sup> Copyright protection subsists in original works of authorship fixed in any tangible medium of expression, and include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works. 17 U.S.C. § 102 (2012).

<sup>25</sup> The copyright examiner is mainly guided by the Code of Federal Regulations (37 C.F.R. § 202 (2012)) and a manual of examining practices entitled the COMPENDIUM OF COPYRIGHT OFFICE PRACTICES (LIBRARY OF CONGRESS COPYRIGHT OFFICE, II COMPENDIUM OF COPYRIGHT OFFICE PRACTICES (1984)). In addition, each section of the Examining Division has detailed practices relating to its subject matter. For a general description of the available guidelines of the examiners, see Marybeth Peters, *The Copyright Office and the Formal Requirements of Registration of Claims to Copyright*, 17 U. DAYTON L. REV. 737, 739-40 (1992). For more on copyright registration in the United States, see Matthew J. Astle, *Help! I've Been Infringed and I Can't Sue!: New Approaches to Copyright Registration*, 41 U. MEM. L. REV. 449 (2011); Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485 (2004).

<sup>26</sup> See *Belcher v. Tarbox*, 486 F.2d 1087, 1091 (9th Cir. 1973) (holding that “[t]here is nothing in the Copyright Act to suggest that the courts are to pass upon the truth or falsity, the soundness or unsoundness, of the views embodied in a copyrighted work.”); *FlavaWorks, Inc. v. Gunter*, 689 F.3d 754, 755 (7th Cir. 2012) (stating that “the prevailing view is that even illegality is not a bar to copyrightability.”).

an illegal parody could be considered fair use<sup>27</sup> as long as it complies with the Copyright Act.<sup>28</sup> Because illegal works are copyrightable, copyright law does not explicitly grant infringers of such works a defense on illegality grounds.<sup>29</sup>

However, a broader interpretation of the law, applied by various courts in the past, suggests that copyright was not always content-neutral.<sup>30</sup> Thus, copyright does not necessarily have to be content-neutral and the possibility of content-based protection should be further analyzed. Before evaluating a *content-neutrality* approach to copyright, I first examine copyright law's historical and current doctrines regarding content-based restrictions.

## ***B. A Brief History of Content-Based Restrictions in Copyright Law***

### *1. General Content-Based Restrictions*

Copyright law is hardly content-neutral.<sup>31</sup> A closer examination of the creativity and originality requirement reveals that a work must exhibit a certain level of originality to warrant registration. Specifically, a work must exhibit independent creation plus a modicum of creativity.<sup>32</sup> Thus, the requirement of originality (with its element of creativity) places a content-based restriction on copyrightability. Another example of a content-based restriction is that a creative work containing infringing material is not

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<sup>27</sup> The Copyright Act provides a “fair use” exemption to copyright infringement for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, and research. *See* 17 U.S.C. § 107 (2012).

<sup>28</sup> Regarding immoral works, see, e.g., *Pillsbury Co. v. Milky Way Products, Inc.*, 215 U.S.P.Q (BNA) 124, \*9 (N.D. Ga. 1981) (“[t]he Copyright Act, however, does not expressly exclude pornographic materials from the parameters of the fair use defense, and the plaintiff offers no authority for this protection. The character of the unauthorized use is relevant, but, in the court's judgment, the fact that this use is pornographic in nature does not militate against a finding of fair use.”).

<sup>29</sup> *See, e.g., Jartech, Inc. v. Clancy*, 666 F.2d 403, 406 (9th Cir. 1982) (holding that obscenity is not a defense to a copyright infringement claim).

<sup>30</sup> This interpretation of copyright law is discussed *infra* Part II.B.2.

<sup>31</sup> Ann Bartow, *Copyright Law and the Commoditization of Sex* 22 (May 11, 2011) (unpublished manuscript), [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1825946](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1825946) (“nothing about copyrights is content neutral.”).

<sup>32</sup> *See, e.g., Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340, 345 (1991) (noting that the requisite level of creativity in copyright law is extremely low); *John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986) (confirming a refusal to register a logo which lacked the minimal creativity necessary to support a copyright).



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copyrightable.<sup>33</sup> Thus, for a work to be copyrightable, its content must be examined, to some extent.

In addition to these implicit content-based restrictions, Congress has imposed two explicit content-based restrictions since it enacted the first copyright statute in 1790:<sup>34</sup> First, in 1874, Congress passed a statute limiting the copyrightability of engravings, cuts and prints only to those works connected with the fine arts.<sup>35</sup> However, the Supreme Court narrowed that statute's scope in *Bleistein v. Donaldson Lithograph Co.*,<sup>36</sup> and Congress eventually repealed the statute and omitted the entire section from the Copyright Act of 1909.<sup>37</sup> Second, as interpreted by courts, Congress limited the public performance right for dramatic compositions only to performances "designed or suited" for public representation, thereby imposing a moral restriction.<sup>38</sup> However, Congress later removed this content-based restriction.<sup>39</sup>

Because Congress has deliberately omitted or removed content-based restrictions in the past, Congress seems to intend that copyright law be content-neutral.<sup>40</sup> Nevertheless, as history reveals, many courts have reached the opposite conclusion, interpreting the Copyright Act to impose content-based restrictions that limit copyright protection to legal works.

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<sup>33</sup> Bartow, *supra* note 31, at 19 (citing, as example of non-copyrightable works due to infringing materials, *Anderson v. Stallone*, 11 U.S.P.Q.2d 1161 (1989) and *Gracen v. Bradford Exchange*, 698 F.2d 300 (1983)). In addition, the fair use exemption also looks to the nature of a work in determining whether the use is permitted. *See* 17 U.S.C. § 107 (2012).

<sup>34</sup> Act of May 31, 1790, 1st Cong., 2d Sess., 1 stat. 124 (1790).

<sup>35</sup> Act of June 18, 1874, ch. 301, § 3, 18 Stat. 78, 79 (1874); *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, at 855 n.4 (5th Cir. 1979) (summarizing the history of content-restrictions in United States copyright legislation).

<sup>36</sup> *See* *Bleistein v. Donaldson Lithograph Co.*, 188 U.S. 239, 251 (1903) (stating that "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.").

<sup>37</sup> Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075-82 (1909).

<sup>38</sup> Act of Aug. 18, 1856, 34th Cong., 1st Sess., 11 Stat. 138 (1856).

<sup>39</sup> Act of July 8, 1870, ch. 230, 16 Stat. 198-217 (1870). I discuss this further in the next section.

<sup>40</sup> *See* *Mitchell Bros.*, 604 F.2d at 854 ("The history of content-based restrictions on copyrights, trademarks, and patents suggests that the absence of such limitations in the Copyright Act of 1909 is the result of an intentional policy choice and not simply an omission.").

## 2. *Content-Based Restrictions on Illegality*

As a matter of official copyright registration policy, for a long time, illegal materials were not copyrightable if their nature was brought to the attention of the examiner.<sup>41</sup> The Copyright Office could refuse registration if the examiner learned that the material tended to disturb the public peace, corrupt morals, or libel individuals. As noted by the Copyright Register of 1941:

The Copyright Office is not an office of censorship of public morals. In passing upon applications for registration of such material, the only official interest to be exercised is in deciding . . . whether or not the material is copyrightable and hence registrable . . . Registration of such material [which tends to disturb the public peace, corrupt morals, or libel individuals, or is a seditious, blasphemous, immoral or libelous production], when its nature is brought to the attention of the examiner in the Copyright Office, is refused.<sup>42</sup>

Not only could the Copyright Office refuse registration to illegal materials before the 1976 legislation,<sup>43</sup> but the Office also suggested that Congress criminalize any attempt to register obscene, seditious, or blasphemous material as a misdemeanor, carrying a fine, imprisonment, or both.<sup>44</sup>

However, even if the Office was permitted to refuse registration on moral grounds, it was never obliged to do so. The Attorney General made this clear in a 1959 decision,<sup>45</sup> which stated that, while the Register could deny registration to obscene works, defining “obscene” would involve

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<sup>41</sup> Examining the reasons behind the rapid change in registration policy is beyond the scope of this article and should be further examined.

<sup>42</sup> See *44th Annual Report of the Register of Copyrights*, COPYRIGHT OFFICE 29 (1941), <http://www.copyright.gov/reports/annual/archive/ar-1941.pdf>.

<sup>43</sup> It should be noted that the official copyright registration policy regarding illegal works was only applied after registration, when their nature was brought to the attention of the examiner. Hence, illegal works were copyrightable to some extent at that time.

<sup>44</sup> *44th Annual Report of the Register of Copyrights*, *supra* note 42, at 30 (“It would seem that, in the interests of public morals and public policy generally, the copyright law should be amended so as to create an equally effective sanction against attempts to obtain registration of obscene, seditious or blasphemous material in the Copyright Office—in other words, that such an attempt knowingly set on foot should constitute a misdemeanor, carrying a fine, imprisonment or both.”).

<sup>45</sup> Walter J. Derenberg, *Copyright Law*, 35 N.Y.U. L. REV. 650, 654 (1960) (describing the Librarian of Congress request from the Attorney General).

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“substantial problems.”<sup>46</sup> Narrowly interpreting the Attorney General’s instructions, the Office continued to limit its examination to statutory formalities.<sup>47</sup>

Official policy, rather than just practice, changed in 1974, when the Copyright Office reversed the 1941 policy and instructed examiners to limit their determination to statutory formalities, without weighing the literary or artistic merits of a work against the obscenity or immorality of the material.<sup>48</sup>

The courts did not always agree with the Copyright Office on illegal materials. Until 1979, courts considered illegal works to be non-copyrightable. In the 19th century, immorality, and possibly illegality, was an explicit cause for barring registration. As noted above, when Congress introduced a public performance right for a dramatic composition to copyright law in 1856, it limited the new right to performances that were “designed or suited” for public representation.<sup>49</sup> California’s Federal Circuit Court interpreted the “suited for” public representation requirement to mean that a work must be morally fit in order to obtain the right.<sup>50</sup> This moral restriction could also be applied to deem illegal works non-copyrightable.<sup>51</sup> Though Congress later omitted the term “suited” from the legislation,<sup>52</sup> the

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<sup>46</sup> 41 Ops. Att’y Gen. No. 73 (May 8, 1959) (“The statute nowhere requires the Register to refuse to accept such works for registration . . . I am of the opinion that the discretion conferred upon the Register by the Copyright Law leaves him free to decide not to attempt to refuse or deny registration of claims to copyright in works of the nature here discussed.”); Derenberg, *supra* note 45, at 654 (describing the 1959 Attorney General’s opinion on the issue of obscenity in copyright registration).

<sup>47</sup> Derenberg, *supra* note 45, at 654 (describing the Office’s practice of limiting the examination to the statutory formalities without examining the literary or artistic merits from the viewpoint of obscenity or immorality of the material itself).

<sup>48</sup> See Dan W. Schneider, *Authority of the Register of Copyrights to Deny Registration of a Claim to Copyright on the Ground of Obscenity*, 51 CHI.-KENT L. REV. 691, 704 n.79 (1975) (describing the registration policy history of the Copyright Office and referring to “[l]etter from the U.S. Copyright Office to author, January 25, 1974.”).

<sup>49</sup> Act of August 18, 1856, *supra* note 36. At the time, the public performance right was limited to “dramatic works,” and was expanded to musical compositions in 1897 (Act of January 6, 1897, 44th Cong., 2d Sess., 29 Stat. 481 (1897)). For a general review of the public performance right, see, e.g., Matthew S. DelNero, *Long Overdue? An Exploration of the Status and Merit of a General Public Performance Right in Sound Recordings*, 51 J. COPYRIGHT SOC’Y U.S.A. 473 (2004).

<sup>50</sup> See *Martinetti v. Maguire*, 16 Fed.Cas. 920, 922 (No. 9173) (C.C. Cal. 1867).

<sup>51</sup> See *id.* at 922 (the court noted that the exhibition of women in the “Black Crook” play is “grossly indecent” and “neither promotes the progress of science [n]or useful arts,” and that it is the duty of the court to “uphold public virtue, and discourage and repel whatever tends to impair it”).

<sup>52</sup> Act of July 8, 1870, ch. 230, § 101, 16 Stat. 198, 214 (1870).

courts' position on the copyrightability of illegal works remained uncertain.<sup>53</sup> In fact, until 1979, courts denied most illegal (and immoral) works judicial remedies, instead holding that the works were not copyrightable in the United States.<sup>54</sup> This gave infringers a valid defense.<sup>55</sup>

In 1979, the Fifth Circuit took a different approach. In *Mitchell Bros. Film Grp. v. Cinema Adult Theater*,<sup>56</sup> the Fifth Circuit reversed the district court ruling<sup>57</sup> and held that a motion picture titled "Behind the Green Door" was copyrightable, and its infringement enforceable, whether or not it was obscene.<sup>58</sup> This decision, governed by the 1909 Copyright

<sup>53</sup> See Jennifer E. Rothman, *Sex Exceptionalism in Intellectual Property*, 23 STAN. L. POL'Y REV. 119, 140 (2012) ("copyright law denied copyright protection to works deemed, *inter alia*, immoral, illegal, fraudulent, or blasphemous.").

<sup>54</sup> *Barnes v. Miner*, 122 F. 480 (C.C.S.D.N.Y. 1903) (holding that a play entitled "X-Rays of Society," was not copyrightable, because it was immoral and lacked dramatic value and, thereby, did not promote the progress of science and useful arts); *Broder v. Zeno Mauvais Music Co.*, 88 F. 74 (C.C.N.D. Cal. 1898) (holding that a song titled "Dora Dean," is not entitled to copyright by virtue of an indelicate and vulgar word in the lyrics); *Richardson v. Miller*, 20 F. Cas. 722 (No. 11791) (C.C.D. Mass. 1877) (stating that immoral works are not copyrighted); *Bullard v. Esper*, 72 F. Supp. 548 (N.D. Tex. 1947) (denying copyright protection on grounds that copyright does not intend to protect illegality or immorality); *Hoffman v. le Traunik*, 209 F. 375, 379 (N.D.N.Y. 1913) (stating that "to be entitled to be copyrighted, the composition must be 'original, meritorious, and free from illegality or immorality'"); *Martinetti*, 16 Fed.Cas. (holding that a dramatic composition, which is grossly indecent and calculated to corrupt the morals of people, is not copyrightable); *Dane v. M. & H. Co.*, 136 U.S.P.Q. 426 (N.Y. Sup. Ct. 1963) (holding that a choreographic musical composition of striptease does not fall within the purview of the statute as a production tending to promote the progress of science and useful arts); *Shook v. Daly*, 49 How. Pr. 366 (N.Y. Sup. Ct. 1875) (refusing to grant injunctive relief for an immoral play); EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS 185 (1879) ("The protection of the law will not be extended to a publication which is obscene, or has a positive immoral tendency.").

<sup>55</sup> More specifically, using obscenity as a defense in a copyright infringement suit originated in England and was implemented in the United States as part of the English common law tradition. It first appeared in a Chief Justice Eyre decision in *Southey v. Sherwood*, 35 ENG. REP. 1006, 1007 (Ch. 1817). See Bonnie Wilkinson, *Recent Development*, 46 FORDHAM L. REV. 1037, 1038-40 (1978) (describing the origins of the obscene defense in English copyright).

<sup>56</sup> *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979).

<sup>57</sup> *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, No. 3-74-645, 1976 U.S. Dist. LEXIS 13396, at \*2-4 (N.D. Tex. 1976) (Jartech Inc. granted the Mitchell Brothers Film Group the exclusive right to distribute and exhibit a pornographic movie titled "Behind the Green Door." The Mitchell Brothers Film Group sued Kenneth Bora, the operator of a cinema adult theater that screened an unlawful copy of the film in his theater without permission while seeking both injunctive relief and damages).

<sup>58</sup> *Mitchell Bros. Film Grp.*, 604 F.2d at 854.

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Act,<sup>59</sup> marked a possible turn in the courts' perception regarding the copyrightability of illegal works. *Mitchell Bros.* interpreted copyright law to no longer consider the nature of a work, unless Congress explicitly addressed content restrictions in the Act, which it did not do in the 1976 reform.<sup>60</sup> Moreover, during the Congressional discussions of the 1976 Act, the House Judiciary Committee stated that it had no intention of including any requirements of novelty, ingenuity, or aesthetic merit in the standard for copyright protection, meaning that the Copyright Act deliberately avoided content-based restrictions on illegality.<sup>61</sup>

In *Jartech, Inc. v. Clancy*, the Ninth Circuit followed the Fifth's Circuit's *Mitchell Bros.* approach. In a 1982 opinion under the 1976 Act, the Ninth Circuit held that the fact that content is obscene, which is usually considered illegal,<sup>62</sup> is not a defense to copyright infringement.<sup>63</sup> Since then, the Fifth and Ninth Circuits have maintained their view on this matter, which seems to prevail in other circuits as well.<sup>64</sup>

However, in 1998, the Southern District of New York rejected and criticized the Fifth and Ninth Circuits' approach. In *Devil Films, Inc. v. Nectar Video*,<sup>65</sup> the court stated:

<sup>59</sup> Act of Mar. 4, 1909, Pub. L. 60-849, 35 Stat. 1075 (1909) (codified as amended at 17 U.S.C. §§ 1-216 (1970)) (repealed 1976).

<sup>60</sup> See 17 U.S.C. § 102 (1976); *Mitchell Bros. Film Grp.*, 604 F.2d at 863 (“Congress has not chosen to refuse copyrights on obscene materials, and we should be cautious in overriding the legislative judgment on this issue.”).

<sup>61</sup> See *Mitchell Bros. Film Grp.*, 604 F.2d at 855 (stating that “[t]he legislative history of the 1976 Act reveals that Congress intends to continue the policy of the 1909 Act of avoiding content restrictions on copyrightability”); H.R. REP. NO. 1476, 94th Cong., 2d Sess. 51 (1976).

<sup>62</sup> See, e.g., 18 U.S.C. § 1460 (2012) (prohibits possession with intent to sell, and sale, of obscene matter on Federal property); 18 U.S.C. § 1461(2012) (prohibits mailing obscene or crime-inciting matter); 18 U.S.C. § 1462 (2012) (prohibits importation or transportation of obscene matters); 18 U.S.C. § 1463 (2012) (prohibits mailing indecent matter on wrappers or envelopes); 18 U.S.C. § 1464 (2012) (prohibits the uttering of any obscene, indecent, or profane language by means of radio communication); 18 U.S.C. § 1465 (2012) (prohibits the production and transportation of obscene matter for sale or distribution); 18 U.S.C. § 1466 (2012) (prohibits engaging in the business of selling or transferring obscene matter); 18 U.S.C. § 1466A (2012) (prohibits obscene visual representations of the sexual abuse of children); 18 U.S.C. § 1467 (2012) (proscribes criminal forfeiture of obscene material); 18 U.S.C. § 1468 (2012) (prohibits distributing obscene material by cable or subscription television).

<sup>63</sup> *Jartech, Inc. v. Clancy*, 666 F.2d 403, 408 (9th Cir. 1982) (discussing the obscene nature of adult movies in a copyright infringement case).

<sup>64</sup> For example, the Seventh Circuit, without deciding on the matter, noted that “the prevailing view is that even illegality is not a bar to copyrightability.” See *FlavaWorks, Inc. v. Gunter*, 689 F.3d 754, 755 (7th Cir. 2012).

<sup>65</sup> *Devil Films, Inc. v. Nectar Video*, 29 F. Supp. 2d 174 (S.D.N.Y. 1998).

It is far from clear that the Second Circuit will follow the Fifth and Ninth Circuits in rejecting the argument that obscene material is entitled to copyright protection ... Once a court has determined that copyrighted material is obscene, there seems no reason to require it to expend its resources on behalf of a plaintiff who it could as readily be trying for a violation of the federal criminal law.<sup>66</sup>

As this ruling only addressed an application for preliminary relief, the court did not decide whether the obscenity of content could constitute a valid defense against allegedly infringing the content. However, as the court noted, “the strong public policy against the distribution of obscene material compels the conclusion that the court should not exercise its equitable powers to benefit plaintiff.”<sup>67</sup> In another case, the district court repeated this view.<sup>68</sup>

Thus, illegality is no longer a bar to copyright registration in the United States.<sup>69</sup> Although courts previously considered copyright to be secondary to the public’s right to moral protection,<sup>70</sup> the Copyright Office no longer seems to hold that view. However, it is still unclear whether courts consider illegal works copyrightable under the current Copyright Act. Although, circuit courts currently view copyright as neutral regarding illegality, district courts views vary in different circuits.<sup>71</sup> In addition, certain circuits never directly addressed this matter;<sup>72</sup> therefore, a Supreme Court or Congressional clarification is much needed.

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<sup>66</sup> *Id.* at 176.

<sup>67</sup> *Id.* at 176-77.

<sup>68</sup> *Next Phase Distrib., Inc. v. Does 1-27*, 284 F.R.D. 165, 171 (S.D.N.Y. 2012) (“[T]he Court recognizes that, if the Motion Picture is considered obscene, it may not be eligible for copyright protection.”). *But see Nova Prods., Inc. v. Kisma Video, Inc.*, No. 02 Civ. 3850(HB), 2004 WL 2754685, at \*3 (S.D.N.Y. 2004) (“[E]ven if the videos were ultimately proven to be obscene, following the Fifth and Ninth Circuits holdings, this would not be a defense to copyright infringement.”).

<sup>69</sup> *See Belcher v. Tarbox*, 486 F.2d 1087, 1088 (9th Cir. 1973) (stating that “[t]here is nothing in the Copyright Act to suggest that the courts are to pass upon the truth or falsity, the soundness or unsoundness, of the views embodied in a copyrighted work”).

<sup>70</sup> *Shook v. Daly*, 49 How. Pr. 366, 368 (N.Y. Sup. Ct. 1895) (“The rights of the author are secondary to the right of the public, to be protected from what is subversive of good morals.”).

<sup>71</sup> Christopher Thomas McDavid, *I Know It When I See It: Obscenity, Copyright, and the Cautionary Tale of the Lanham Act*, 47 U. LOUISVILLE L. REV. 561, 567 (2009) (“Since 1982, this issue has remained dormant in the federal appellate courts, but it has not been entirely undisturbed at the district level.”).

<sup>72</sup> *See, e.g., Liberty Media Holdings, LLC v. Swarm Sharing Hash File*, 821 F. Supp. 2d 444, 447 n.2 (D. Mass. 2011) (noting that whether pornography is in fact entitled to

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Having discussed the current state of whether copyright law does protect illegal works, I now turn to whether copyright law *should*. I consider the normative justifications for content-based restrictions, as well as their constitutionality.

### III. THE CONSTITUTIONALITY OF CONTENT-BASED RESTRICTIONS

#### A. Copyright's Constitutional Purposes

The Copyright and Patent Clause in the Constitution empowers Congress “[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”<sup>73</sup> Presumably, the constitutional purpose of copyright protection is therefore to protect all creative works, regardless of their content, trusting the public’s taste to reward creators for useful works and to deny creators of useless works any reward.<sup>74</sup>

Therefore, the Constitution empowers Congress to enact copyright law only as a means to promote the progress of science and useful arts.<sup>75</sup> But do illegal works promote the progress of science and useful arts?<sup>76</sup> This

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protection against copyright infringement is a matter of first impression in the First Circuit and is unsettled in many circuits); *Villa v. Pearson Educ., Inc.*, No. 03 C 3717, 2003 U.S. Dist. LEXIS 24686, at \*7 (N.D. Ill. 2003) (while the court denied a motion to dismiss on procedural grounds, it noted that whether the defendant would be liable for copyright infringement on the basis that the mural is not protected by copyright law as it is illegal, depends on the factual question of illegality. Thus, by this statement, the court recognized that illegality could serve as a bar to copyrightability). For more on possible ramifications of *Villa v. Pearson Educ., Inc.*, see generally, Danwill Schwender, *Promotion of The Arts: An Argument For Limited Copyright Protection of Illegal Graffiti*, 55 J. COPYRIGHT SOC’Y U.S.A. 257 (2008).

<sup>73</sup> U.S. CONST. art. I, § 8, cl. 8. Here, science means “knowledge” and “learning,” as these terms were synonymous in the eighteenth century. For more information on this matter, see Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution*, 2 J. INTEL. PROP. L. 1, 51 (1994); Giles S. Rich, *The Principles of Patentability*, 42 J. PAT. OFF. SOC’Y 75, 78-80 (1960); Karl B. Lutz, *Patents and Science: A Clarification of the Patent Clause of the U.S. Constitution*, 32 J. PAT. OFF. SOC’Y 83, 84 (1950).

<sup>74</sup> *Mitchell Bros. Film Grp.*, 604 F.2d at 855.

<sup>75</sup> See *Martinetti v. Maguire*, 16 Fed. Cas. 920, 922 (No. 9173) (Cal. Dist. Ct. App. 1867) (“[I]t expressly appears that [C]ongress is not empowered by the [C]onstitution to pass laws for the protection or benefit of authors and inventors, except as a means of promoting the progress of ‘science and useful arts.’”).

<sup>76</sup> However, Jennifer Rothman criticizes attempts to justify the exclusion of obscene works from copyright protection by arguing that they are not promoting progress and therefore do not fall within the Copyright and Patent Clause. Rothman argues that the language of the

question is not easy to answer. On the one hand, when people are harmed during the making of a work or as a consequence of its distribution and consumption, can the progress of knowledge really be promoted?<sup>77</sup> On the other hand, every work can promote some knowledge; for example, to specialists in the field.<sup>78</sup> Thus, promotion of knowledge can be achieved even when harm is associated with a work, as they are not necessarily linked and could be viewed as independent factors. Under these arguments, all works are arguably beneficial for society and should be granted copyright protection.

As mentioned, the Fifth Circuit held in *Mitchell Bros.* that the protection of all writings, without regard to their content, is a constitutionally permissible means of promoting science and the useful arts.<sup>79</sup> Hence, under the Fifth Circuit ruling, constitutionally, illegal works should be just as copyrightable as other works.<sup>80</sup> However, only a few circuits have embraced this view; courts in other circuits have either not decided on this matter or have disagreed with *Mitchell Bros.* Until Congress or the Supreme Court clarifies the exact meaning of the constitutional clause regarding content-based restrictions,<sup>81</sup> this controversy will persist.

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clause is an explanation of purpose and not a mandate, and that the underlying goal of copyright applies to the body of law, not to individual works. See Rothman, *supra* note 53, at 155.

<sup>77</sup> See, e.g., Bartow, *supra* note 31, at 2 (arguing that some pornographic works cannot reasonably be construed as promoting progress or useful arts because people are harmed during their production, or as a consequence of their distribution and consumption).

<sup>78</sup> See, e.g., Sean J. Kealy, *A Proposal for a New Massachusetts Notoriety-For-Profit Law: the Grandson of Sam*, 22 W. NEW ENG. L. REV. 1, 27 (2000) (“When a criminal details his experiences, society is benefitted because various specialists can gain a greater knowledge of the criminal mind and its methods.”).

<sup>79</sup> *Mitchell Bros. Film Grp.*, 604 F.2d at 860.

<sup>80</sup> Ronald L. Green, *The Obscenity Defense to Copyright Revisited*, 69 KY. L.J. 161, 174-75 (1980) (“[I]n a modern context, the Constitution poses no bar to the granting of copyright protection to the obscene or immoral work.”).

<sup>81</sup> Such clarification was offered by Christopher Thomas McDavid, arguing that Congress should revise section 102(a) of the Copyright Act to state that “[c]opyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device, without regard to the moral value of the work,” and to clarify that under section 502 of the Copyright Act, which grants courts the discretionary right to grant temporary and final injunctions of alleged violators of copyright, “the content of the copyrighted material is not to be taken into consideration under the court’s discretionary powers.” McDavid, *supra* note 71, at 582.



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**B. Freedom of Speech**

The First Amendment states that “Congress shall make no law . . . abridging the freedom of speech.”<sup>82</sup> Imposing content-based restrictions on copyrightability could endanger freedom of speech and, hence, be unconstitutional.<sup>83</sup> That said, the First Amendment does not protect all speech. For example, defamation, incitement, obscenity, and child pornography are generally not protected speech.<sup>84</sup> Courts will examine other content-based restrictions on speech to determine whether they arise from a content-neutral or content-based regulation.<sup>85</sup> Content-neutral restrictions only need to meet an intermediate standard of scrutiny.<sup>86</sup> However, content-based restrictions on copyrightability that endanger freedom of speech are subject to strict scrutiny.<sup>87</sup> Thus, if Congress were to

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<sup>82</sup> U.S. CONST. amend. I.

<sup>83</sup> Although some works will fall into the commercial speech category, such as advertisements, numbering systems, contracts and commercial labels, most works will not. In order for speech to be commercial, it must combine four characteristics: it must do no more than propose a commercial transaction; it may be characterized as an advertisement; it must reference a specific product; and its disseminator must be economically motivated to distribute the speech. *See Bolger v. Youngs Drug Products*, 463 U.S. 60, 66-67 (1983). Therefore, I will generally refer to copyright as noncommercial speech. For more information on copyright and commercial speech, see Alfred C. Yen, *Commercial Speech Jurisprudence and Copyright in Commercial Information Works*, 58 S.C. L. REV. 665 (2007). For a general review of copyright and free speech, see COPYRIGHT AND FREE SPEECH: COMPARATIVE AND INTERNATIONAL ANALYSES (Jonathan Griffiths & Uma Suthersanen eds., 2005).

<sup>84</sup> *See, e.g., Ashcroft v. Am. Civil Liberties Union*, 535 U.S. 564, 574 (2002) (noting that obscene speech “has long been held to fall outside the purview of the First Amendment”); *Ashcroft v. Free Speech Coalition*, 535 U.S. 234, 245-46 (2002) (“The freedom of speech has its limits; it does not embrace certain categories of speech, including defamation, incitement, obscenity, and pornography produced with real children”); *New York v. Ferber*, 458 U.S. 747, 756 (1982) (recognizing that “laws directed at the dissemination of child pornography” do not violate the First Amendment); *Miller v. Cal.*, 413 U.S. 15, 23-24 (1973); *Bartow, supra* note 31, at 18 (arguing that “[t]he First Amendment will only protect pornography if it is not obscene or illegal for other reasons, *i.e.*, if it contains depictions of children.”).

<sup>85</sup> For more on the distinction between content-based and content-neutral regulations, see KATHLEEN M. SULLIVAN & GERALD GUNTHER, *FIRST AMENDMENT LAW* 211-43 (2d ed. 2003).

<sup>86</sup> *Turner Broadcasting System, Inc. v. F.C.C.*, 512 U.S. 622, 642 (1994). Whether copyright constitutes content-neutral or content-based speech regulation is disputable. For more on this matter, see Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1 (2001) (arguing that copyright falls within a sub-category of content-neutral regulation requiring rigorous scrutiny).

<sup>87</sup> *See, e.g., Sable Commc'ns of California Inc. v. FCC*, 492 U.S. 115, 126 (1989) (holding that content-based restrictions must promote a compelling government interest and must be

impose copyright restrictions based on the content of the work, the restrictions would have to be narrowly tailored to serve a compelling state interest and be the least restrictive means available to further the articulated interest.<sup>88</sup>

Examining the constitutionality of content-based restrictions in copyright law under the First Amendment could lead to a problematic outcome. A content-based restriction is unlikely to survive strict scrutiny.<sup>89</sup> The state will likely be unable to assert an interest that requires the suppression of free speech. On the other hand, the constitutionality of a restriction against granting copyright to illegal works need not always involve the First Amendment. In the case of obscene material, for example, First Amendment protection should not apply. Thus, refusing copyright to obscene works, and other creations that do not receive First Amendment protection, should withstand constitutional challenges. Moreover, as I further suggest, reducing the profitability of certain types of conduct (illegal works), does not place restriction on speech, and therefore should be held not to violate the First Amendment.

Imposing a general restriction against granting copyright to illegal works will be an almost impossible task, constitutionally speaking. However, a more limited restriction could be possible, as I discuss below.<sup>90</sup>

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the least restrictive means of achieving that interest); Patrick M. Garry, *A New First Amendment Model for Evaluating Content-Based Regulation of Internet Pornography: Revising the Strict Scrutiny Model to Better Reflect the Realities of the Modern Media Age*, 2007 BYU L. REV. 1595, 1596 (2007) (stating that First Amendment doctrine requires that courts subject any content-based speech regulation to strict scrutiny). For more on strict scrutiny in the United States, see Adam Winkler, *Fatal in Theory and Strict in Fact: An Empirical Analysis of Strict Scrutiny in the Federal Courts*, 59 VAND. L. REV. 793 (2006).<sup>88</sup> See, e.g., *Ashcroft v. Am. Civil Liberties Union*, 542 U.S. 656, 665-666 (2004) (finding that the Child Online Protection Act (COPA), designed to regulate minor's access to harmful material on the Internet, is unconstitutional because it "was likely to burden some speech that is protected for adults" while there were "plausible, less restrictive alternatives."); *Reno v. Am. Civil Liberties Union*, 521 U.S. 844, 844 (1997) (finding that two provisions of the Communications Decency Act of 1996, indecent transmission and patently offensive display, abridge freedom of speech and, therefore, unconstitutional); *Sable Commc'ns*, 492 U.S., at 126 (holding that the government may "regulate the content of constitutionally protected speech in order to promote a compelling interest if it chooses the least restrictive means to further the articulated interest").

<sup>89</sup> See *R.A.V. v. St. Paul*, 505 U.S. 377, 382 (1991); *Simon & Schuster, Inc. v. Members of N. Y. State Crime Victims Bd.*, 502 U.S. 105, 115 (1991); *Police Dep't of Chicago v. Mosley*, 408 U.S. 92, 95 (1972).

<sup>90</sup> See *infra* Section VI.A.2.

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**C. Due Process**

The Fifth Amendment states that no person shall “be deprived of life, liberty, or property, without due process of law.”<sup>91</sup> Restrictions against granting copyright protection to illegal works should be able to satisfy this due process requirement if they are sufficiently precise to not be considered vague.<sup>92</sup> The precision will likely have to be higher where free speech is implicated.<sup>93</sup> The concept of “illegal works” should be able to survive a vagueness challenge; For example, it can be defined as specific acts prohibited by the penal law.

To conclude, from a constitutional perspective, general content-based restrictions in copyright will not be achieved easily. However, restrictions on some forms of illegal activities—which are narrowly tailored to serve a compelling state interest and are the least restrictive means available to further the articulated interest—could pass the constitutional challenge. I elaborate on possible content-based restrictions in Section VI.A.2 below.

**IV. CONTENT-BASED RESTRICTIONS IN INTELLECTUAL PROPERTY**

In order to evaluate justifications for keeping copyright law as content-neutral as possible, an examination of other fields of IP—namely, trademark and patent law—is required. Such an analysis indicates that trademark law’s approach to content-neutrality differs from that of both patent and copyright law: materials can receive both patent and copyright protection simply upon meeting general standards, while trademark law prohibits the registration of immoral, disparaging, or scandalous marks.

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<sup>91</sup> U.S. CONST. amend. V. Due process also appears in the Fourteenth Amendment to the Constitution. U.S. CONST. amend. XIV.

<sup>92</sup> See, e.g., *Grayned v. City of Rockford*, 408 U.S. 104, 108 (1972) (“It is a basic principle of due process that an enactment is void for vagueness if its prohibitions are not clearly defined.”). However, the lack of precision is not itself offensive to the requirements of due process. See *Roth v. United States*, 354 U.S. 476, 491 (1957) (“The Constitution does not require impossible standards; all that is required is that the language “conveys sufficiently definite warning as to the proscribed conduct when measured by common understanding and practices . . . .””) (quoting *United States v. Petrillo*, 332 U.S. 1, 7-8 (1947)).

<sup>93</sup> *Smith v. Goguen*, 415 U.S. 566, 573 (1974) (holding that when a statute’s literal scope is capable of reaching expression sheltered by the First Amendment, the “void for vagueness” doctrine “demands a greater degree of specificity than in other contexts.”); Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(A) Trademark Law after Lawrence v. Texas*, 9 MARQ. INTELL. PROP. LAW REV. 187, 236 (2005) (applying “void for vagueness” as interpreted in *Smith v. Goguen* to trademarks).

However, the differences between trademark and patent and copyright law—including their connection to commercial speech and their constitutional origins—could justify these different approaches.

### A. Trademark Law

Trademark law is not content-neutral.<sup>94</sup> In 1905, Congress created a content-based restriction in trademark, prohibiting the registration of “immoral or scandalous” marks.<sup>95</sup> A similar and slightly broader provision<sup>96</sup> appeared in 1946, when Congress codified federal trademark law with the passage of the Lanham Act.<sup>97</sup> The Act prohibits registration of any trademark that “consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt . . . .”<sup>98</sup>

Thus, trademark law, both at the federal level and in most states,<sup>99</sup> prohibits the registration of immoral, disparaging, or scandalous marks. Courts have denied trademarks for such marks,<sup>100</sup> though their composition

<sup>94</sup> For a thorough analysis of trademark law and content-neutrality, see Sonya Katyal, *Trademark Intersectionality*, 57 UCLA L. REV. 1601 (2010).

<sup>95</sup> Trademark Act of 1905, Pub. L. No. 58-489, §5, 33 Stat. 724 (1905) (“[N]o mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trademark on account of the nature of such mark unless such mark (a) Consists of or comprises immoral or scandalous matter . . . .”). For a definition of what constitutes as a trademark, see 15 U.S.C. § 1127 (2012).

<sup>96</sup> The 1905 Trademark Act did not include a prohibition on mark that disparage any person or bring them into contempt or disrepute. See Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must A Trademark Be?*, 22 PEPP. L. REV. 7, 23 n.99 (1994) (comparing the 1905 and 1946 trademark Acts in connection to the prohibition against registration for immoral, scandalous, and disparaging marks in the United States).

<sup>97</sup> Trademark Act of 1946, Pub. L. No. 79-489, 60 Stat. 427 (1946) (named after Representative Fritz G. Lanham of Texas).

<sup>98</sup> *Id.* § 2(a). For more information on section 2(a) of the Lanham Act, see Gibbons, *supra* note 93.

<sup>99</sup> In addition to federal protection, state registration provides trademark owners in the United States with protection for their marks. See Pace, *supra* note 96, at 7, 23 n.100 (listing examples of state trademark legislation that prohibit registration for scandalous, immoral or disparaging marks).

<sup>100</sup> See, e.g., *In re The Boulevard Entertainment, Inc.*, 334 F.3d 1336 (Fed. Cir. 2003) (refusing to register “1-800-JACK-OFF” and “JACK-OFF” as federal trademarks on the ground that the marks consist of or comprise scandalous matter); *In re Riverbank Canning*, 95 F.2d 327 (affirming the refusal to register the mark “Madonna” as a trademark for wines, on the ground that for such purpose the use of the word is scandalous); *In re McGinley*, 660 F.2d, at 481 (affirming a refusal to register a “Newsletter Devoted to Social

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differs case by case. However, precedent suggests that non-registrable marks usually contain a reference to drugs, sex, religion, race, or scatological imagery.<sup>101</sup> When determining whether a mark constitutes an “immoral, deceptive, or scandalous” mark, the context of the marketplace matters.<sup>102</sup> Prior decisions regarding similar marks are insufficient to warrant the same finding in other cases.<sup>103</sup>

Constitutionally speaking, refusal to register an immoral or scandalous mark was held not to abridge the First Amendment as “no conduct is proscribed, and no tangible form of expression is suppressed,” and as the refusal does not affect the right to use the mark.<sup>104</sup> However,

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and Interpersonal Relationship Topics” and “Social Club Services” marks comprising a “photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia” was considered scandalous); *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999) (ordering the cancellation of seven registered trademarks of the National Football League’s Redskins, holding it to be pejorative and offensive); *In re Runsdorf*, 171 U.S.P.Q. 443 (T.T.A.B. 1971) (affirming a decision that “BUBBY TRAP” brassieres are scandalous). However, the District Court for the District of Columbia later reversed this decision under the doctrine of *laches* (*Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 132 (D.D.C. 2003)), a decision that was reaffirmed by the Court of Appeals for the District of Columbia (*Pro-Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009)).

<sup>101</sup> See Bartow, *supra* note 31, at 50-52 (listing examples of denied trademarks under 15 U.S.C. §1052(a), such as “Cocaine” for a soft drink and “Pussy” for an energy drink). Courts usually refer to the dictionary definition of “scandalous” as “[c]ausing or tending to cause scandal; shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; Giving offense to the conscience or moral feelings; exciting reprobation; calling out condemnation.” See *In re Riverbank Canning*, 95 F.2d 327, 328 (C.C.P.A. 1938).

<sup>102</sup> *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981) (“In determining whether appellant's mark may be refused registration as scandalous, the mark must be considered in the context of the marketplace as applied to only the goods or services described in the application for registration. Whether or not the mark, including innuendo, is scandalous is to be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public.”). According to the United States Patent and Trademark Office, “to support a refusal on the ground that a proposed mark is immoral or scandalous, the examining attorney must provide evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace.” TMEP § 1203.01 (8th ed. 2010).

<sup>103</sup> *Id.* (citing *In re Red Bull GmbH*, 78 U.S.P.Q.2d 1375 (T.T.A.B. 2006)).

<sup>104</sup> See *In re McGinley*, 660 F.2d, at 484 (C.C.P.A. 1981); TMEP § 1203.01 (8th ed. 2010). Nevertheless, refusal to register a trademark could potentially jeopardize merchandising revenues since the owner is not able to prevent the usage of the name and logo. See, e.g., Jack Achiezer Guggenheim, *Renaming the Redskins (and the "Florida State Seminoles?"): The Trademark Registration Decision and Alternative Remedies*, 27 FLA. ST. U. L. REV. 287, 287 (1999).

unlike copyright,<sup>105</sup> trademarks are a form of commercial speech.<sup>106</sup> In order to assess whether regulation of commercial speech violates the First Amendment, the Supreme Court instituted a four-step analysis:<sup>107</sup> First, the speech must be lawful and not misleading; second, the asserted government interest must be substantial; third, the regulation must directly advance that interest; fourth, the regulation cannot be more extensive than is necessary to serve that interest.<sup>108</sup> The Supreme Court held the term “scandalous” to be sufficiently precise to satisfy due process requirements under the Fifth Amendment.<sup>109</sup> Even without registration, an immoral, deceptive, or scandalous mark can be used by any company, but it will be denied federal protection from unauthorized use.<sup>110</sup>

Hence, it is important to identify what differentiates trademarks from copyright in order to evaluate why copyright does not explicitly refuse to protect illegal (or immoral) content. Although copyright and trademark are both types of IP, they possess fundamental differences:<sup>111</sup> To name a few, trademarks are part of a separate framework, originating from the Commerce Clause, and are not governed by the Copyright (and Patent) Clause;<sup>112</sup> trademarks have characteristics of private goods, whereas

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<sup>105</sup> See *supra* note 83.

<sup>106</sup> See *Friedman v. Rogers*, 440 U.S. 1, 11 (1979) (holding that trade names are commercial speech). First Amendment protections did not apply to commercial speech until a Supreme Court decision in 1976. *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumers Council, Inc.* 425 U.S. 748 (1976). Thus, as content-based restrictions in trademark law were enacted prior to the extension of the First Amendment protections to commercial speech, this legislation was not examined through the lens of constitutional free speech. See, e.g., *Valentine v. Chrestensen*, 316 U.S. 52, 54 (1942) (“We are equally clear that the Constitution imposes no such restraint on government as respects purely commercial advertising”); *Pace*, *supra* note 96, at 36.

<sup>107</sup> *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557 (1980).

<sup>108</sup> *Id.* at 564.

<sup>109</sup> See *In re McGinley*, 660 F.2d 481, 484-85; TMEP § 1203.01 (8th ed. 2010).

<sup>110</sup> See *Bartow*, *supra* note 31, at 55 (“[M]arks that cannot be federally registered can still be used in commerce, and that appears to keep this content based trademark registration restriction within the bounds of constitutionality.”).

<sup>111</sup> See, e.g., David W. Barnes, *A New Economics of Trademarks*, 5 NW. J. TECH. & INTEL. PROP. 22, 22 (2006) (arguing that “according to conventional wisdom, trademark law has no theoretical or practical connection to copyright and patent law”); *Katyal*, *supra* note 94, at 1613 (arguing that trademarks are part of a separate framework than copyrighted and patented goods and concentrates on commerce rather than communication).

<sup>112</sup> *In re Trade-Mark Cases*, 100 U.S. 82, 93-94 (1879) (“[A]ny attempt, however, to identify the essential characteristics of a trademark with inventions and discoveries in the arts and sciences, or with the writings of authors, will show that the effort is surrounded with insurmountable difficulties.”).

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copyrights have characteristics of public goods;<sup>113</sup> unlike copyright law, trademark law is not concerned with the dissemination of knowledge and does not enrich the public domain;<sup>114</sup> and trademarks are concerned with the marketplace of goods while copyright mainly concerns the marketplace of ideas.<sup>115</sup>

At the same time, regardless of whether it appears in the trademark or the copyright context, a content-based restriction cannot abridge freedom of speech, whether it is commercial or not. Refusal to register a mark can be constitutional as long as the refusal does not affect the right to use the mark, as the refusal does not proscribe any conduct or suppress any tangible form of expression—it simply limits potential profits.<sup>116</sup> Applying this test to a work's copyrightability, denying registration on any grounds appears to be constitutional because such denial does not affect the right to use the work. Yet, as mentioned, commercial speech does not enjoy the same constitutional protection as non-commercial speech and copyright may therefore require a more speech-protective standard.<sup>117</sup>

As noted above, differences between copyright and trademark law could justify their different approaches to restrictions on illegal (and immoral) content. However, it is not easy to evaluate justifications for content-based restrictions in trademark law, as there is little evidence of

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<sup>113</sup> William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 276 (1988) (“[A] proper trademark is not a public good; it has social value only when used to designate a single brand.”); Mark A. Lemley, *Ex Ante Versus Ex Post Justifications for Intellectual Property*, 71 U. CHI. L. REV. 129, 143 (2004) (arguing that in trademarks, “there is no public goods problem for intellectual property to solve.”). *But see* David W. Barnes, *Trademark Externalities*, 10 YALE J.L. & TECH. 1, 5 (2007) (describing trademarks as mixed public goods); Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 462 (1999) (arguing that unlike a private good, using a trademark, a public good, does not physically preclude the use of another good); Katyal, *supra* note 94, at 1618 (arguing that currently trademarks take on characteristics that resemble both public and private goods.).

<sup>114</sup> Katyal, *supra* note 94, at 1615 (analyzing the distinctions between trademarks and copyrights).

<sup>115</sup> *But see id.* at 1617 (arguing that trademark law has been broadened to encompass other expressive uses within the marketplace of ideas).

<sup>116</sup> *See In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (“With respect to appellant's First Amendment rights, it is clear that the PTO's refusal to register appellant's mark does not affect his right to use it. *Holiday Inn v. Holiday Inn, Inc.*, 534 F.2d 312, 319 n.6, 189 USPQ 630, 635 n.6 (Cust. & Pat. App. 1976). No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark.”).

<sup>117</sup> *See Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447 (1978).

Congressional intent in their enactment.<sup>118</sup> According to one theory, the main motivation for the trademark law approach was to avoid government approval of immoral marks.<sup>119</sup> Another possible reason is public policy—to discourage the use of immoral marks.<sup>120</sup> These justifications for content-based restrictions could equally apply to copyright law because the fundamental differences between the two intellectual property rights do not affect these justifications. However, the fact that Congress explicitly imposed a morality-based restriction in trademark law and abstained from such a restriction in copyright law supports the opposite conclusion: that, unlike its approach to trademark law, Congress intended for copyright law to be presumably content-neutral.<sup>121</sup>

The existence of content-based restrictions in trademark law does not justify implementing the same doctrine in copyright.<sup>122</sup> Furthermore, the fact that there are content-based restrictions in trademark law now does not mean that there always will be. Economic considerations by themselves—

<sup>118</sup> *In re Riverbank Canning*, 95 F.2d 327, 328 (C.C.P.A. 1938) (stating that the legislative history of the prohibition to register a scandalous matter does not aid the court in arriving at Congress' intent of its enactment).

<sup>119</sup> See Timothy R. Holbrook, *The Expressive Impact of Patents*, 84 WASH. U. L. REV. 573, 579 (2006) (“[T]he primary reason for denying the trademark registration in this context, therefore, is the potential that the government would be viewed as approving of such a scandalous mark.”). The Trademark Trial and Appeal Board rejected this argument, stating that “[i]n this case, as in others where the issue has been whether a mark is scandalous, we have detected an undercurrent of concern that the issuance of a trademark registration for applicant's mark amounts to the awarding of the U.S. Government's ‘imprimatur’ to the mark. Such a notion is, of course, erroneous.” *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1220 n.3 (Trademark Trial and Appeal Board 1993). Yet, the Trademark Trial and Appeal Board's lack of another justification and the fact that denial of registration does not prevent the usage of a mark strengthen the assumption that the government wishes to avoid a “stamp of approval” of such a mark. See Holbrook, *supra* note 119, at 579 (making a similar argument, while citing GRAEME B. DINWOODIE & MARK D. JANIS, *TRADEMARKS & UNFAIR COMPETITION: LAW & POLICY* 330-31 (2004)).

<sup>120</sup> See Pace, *supra* note 96, at 22 (arguing that Congress reasoned the prohibition of registering a mark due to public policy reasons in order to discourage their use, while referring to *Hearings on H.R. 4744 before the Subcomm. on Trademarks of the House Comm. on Patents*, 76th Cong., 1st Sess. 18 (1939) (statement of Rep. Thomas E. Robertson)).

<sup>121</sup> Green, *supra* note 80, at 171 (arguing that the specific exception of obscene trademarks suggests that the same would have been done with copyright law had Congress felt it desirable).

<sup>122</sup> For criticism on trademark's content-based restrictions, see, e.g., Jasmine Abdel-Khalik, *To Live in In-"Fame"-Y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 CARDOZO ARTS & ENT. L.J. 173 (2007); Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act*, 106 COLUM. L. REV. 388 (2006).



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without the law’s intervention—could discourage use of offensive marks,<sup>123</sup> as many customers would avoid purchasing an offensively-marked product or service.<sup>124</sup> Hence, the fact that trademark law imposes content-based restrictions does not necessarily imply that copyright law should develop accordingly.

**B. Patent Law**

Patent law is governed by Article I, Section 8 of the United States Constitution, which empowers Congress to legislate a patent act “[t]o promote the Progress of Science and useful Arts.”<sup>125</sup> Patent law requires, *inter alia*,<sup>126</sup> that an invention prove to be “useful” before the Patent and Trademark Office issues a patent for it.<sup>127</sup> This is clearly a content-based restriction,<sup>128</sup> but the nature of “useful” is subject to a court’s interpretation and can change over time. In 1817, Justice Joseph Story held that, for an invention to be “useful” in patent law terms,<sup>129</sup> it cannot be “frivolous or injurious to the well-being, good policy, or sound morals of society.”<sup>130</sup>

<sup>123</sup> Pace, *supra* note 96, at 9 (arguing that it would be economically unwise for a company to use an offensive trademark).

<sup>124</sup> Kurt M. Saunders & Leonard J. Rymsza, *The Scarlet Letter of Trademark Law: The Bar to Registration of Immoral and Scandalous Trademarks*, 14 S.L.J. 17, 27-28 (2004) (arguing that allowing consumers to avoid purchasing of a product or services because it is vulgar or unappealing could be an alternative to trademarks content-based restrictions).

<sup>125</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>126</sup> See, e.g., 35 U.S.C. §§ 102-103 (2012) (lists the conditions for U.S. patentability).

<sup>127</sup> 35 U.S.C. § 101 (2012) (“[W]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”). In addition, the patent statute provides for the issuance of design patents on ornamental designs for articles of manufacture and plant patents on asexually reproduced plants. See 35 U.S.C. §§ 161, 171 (2012); Margo A. Bagley, *Patent First, Ask Questions Later: Morality and Biotechnology in Patent Law*, 45 WM. & MARY L. REV. 469, 482-84 (2003) (describing patent eligibility).

<sup>128</sup> See *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 855 (5th Cir. 1979) (noting patent law’s requirement that inventions be shown to be “useful” before a patent is issued is a content-related restriction).

<sup>129</sup> Subjected, at that time, to the Patent Act of 1793, ch. 11, 1 Stat. 318 (1793), which uses the phrase “useful invention” as an action on the case for the infringement of a patent-right.

<sup>130</sup> See *Lowell v. Lewis*, 15 F. Cas. 1018, 1019 (C.C.D. Mass. 1817) (No. 8,568) (noting that “all that the law requires is, that the invention should not be frivolous or injurious to the well-being, good policy, or sound morals of society. The word ‘useful,’ therefore, is incorporated into the act in contradistinction to mischievous or immoral.”). See also *Bedford v. Hunt*, 3 F. Cas. 37, 37 (C.C. Mass. 1817) (No. 1217) (limiting the definition of “useful” to an invention that is be capable of use not prohibited by sound morals or policy); Eric P. Mirabel, *Practical Utility is a Useless Concept*, 36 AM. U. L. REV. 811, 812-13

Thus, the court linked usefulness to morality. To exemplify this, the court noted that inventions designed to poison people, promote debauchery, or facilitate private assassination are not patentable.<sup>131</sup>

The idea that an invention, within the meaning of the patent statute, must meet standards of morality was referred to as the “moral utility” doctrine<sup>132</sup> and was invoked in many cases for over 150 years.<sup>133</sup> In recent years, however, courts have abandoned this doctrine,<sup>134</sup> and the current interpretation of patent law suggests that it requires only that an invention be put to a single lawful use, lacking moral examination.<sup>135</sup> Hence,

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(1987) (noting that the two early decisions on what constitutes “useful” defined the term as a negative rather than a positive averment).

<sup>131</sup> *Lowell*, 15 F. Cas. at 1019 (“[A] new invention to poison people, or to promote debauchery, or to facilitate private assassination, is not a patentable invention.”); *Martinetti v. Maguire*, 16 Fed. Cas. 920, 922 (No. 9173) (C.C. Cal. 1867) (holding that an invention expressly designed to facilitate the commission of crime, however novel or ingenious, could not be patented).

<sup>132</sup> See Bagley, *supra* note 127, at 488-93 (describing the “moral utility” doctrine history).

<sup>133</sup> For example, the utility requirement was employed by courts to invalidate inventions used to defraud buyers and gambling device patents that were held to be immoral. *See, e.g., In re Corbin*, 6 F. Cas. 538, 540, 542 (C.C.D.C. 1857) (No. 3224) (upholding grant of patent on artificial honey); *Klein v. Russell*, 86 U.S. 433, 445, 468 (1873) (affirming trial court instruction that if the process patented cannot be made useful for any honest purpose then the invention is not patentable); *National Automatic Device Co. v. Lloyd*, 40 F. 89 (N.D. Ill. 1889) (invalidating a patented toy automatic race course); *Schultze v. Holtz*, 82 F. 448 (N.D. Cal. 1897) (invalidating a patented slot machine); *Rickard v. Du Bon*, 103 F. 868, 873 (2d Cir. 1900) (denying a patent on an alleged fraudulent intent to make domestic tobacco look like imported tobacco); *Brewer v. Lichtenstein*, 278 F. 512 (7th Cir. 1922) (invalidating a patented lottery device); *Meyer v. Buckley Mfg. Co.*, 15 F. Supp. 640, 641 (N.D. Ill. 1936) (denying a patent on a “game of chance” vending machine). In the global realm, signed members of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) are entitled to exclude from patentability inventions that pose a risk to the public order or do not meet moral standards; however, this clause is not mandatory. *See* Agreement on Trade-Related Aspects of Intellectual Property Rights, art. 27, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) § 5 (“Members may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect *ordre public* or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law.”).

<sup>134</sup> *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1366-1367 (Fed. Cir. 1999) (noting that “the principle that inventions are invalid if they are principally designed to serve immoral or illegal purposes has not been applied broadly in recent years.”).

<sup>135</sup> *See* John R. Thomas, *An Examination of the Issues Surrounding Biotechnology Patenting and Its Effect Upon Entrepreneurial Companies*, CRS REPORT FOR CONGRESS 19 (2000) (noting that “[t]he modern view is that so long as the invention may be put to a single lawful use, it possesses utility within the patent statute.”). However, in rare cases, courts can make use of moral standards. *See* Thomas F. Cotter, *Misuse*, 44 HOUS. L. REV.

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immorality is no longer considered a restriction in United States patent law.<sup>136</sup> Nevertheless, the fact that an invention must be put to a single lawful use before being eligible for registration could possibly bar patent registration for illegal inventions. However, this content-based restriction is set at a very low bar, as an invention that could be used for illegal purposes is registrable as long as it can also be put to legal use. Thus, patent and copyright laws seem to be aligned in the general conception that illegal works are eligible for protection upon meeting basic general standards. Whether this content-neutral approach is desirable requires further evaluation.

## V. EVALUATING CONTENT-NEUTRALITY IN COPYRIGHT LAW

Whether copyright law should examine the content of a work is questionable, especially with regard to illegal works.<sup>137</sup> Works can be original enough to meet the threshold of copyright law, but at the same time, not benefit society or perhaps even harm it. The important question of moral considerations in copyright law has received little attention in academic literature. Scholars who address it usually deal solely with questions of immorality—e.g., pornography and the sex industry, and/or the possible illegality of obscene materials—but do not provide a broader examination of illegality.<sup>138</sup> Hence, the copyrightability of illegal works

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901, 933 n.155 (2007) (arguing that the “moral utility” doctrine could retain some vitality regarding small class of inventions that would violate fundamental public policy).

<sup>136</sup> See Holbrook, *supra* note 119, at 594 (arguing that the current United States patent system is viewed as morally agnostic, i.e., it makes no judgments about the value of individual patents).

<sup>137</sup> See, e.g., Bullard v. Esper, 72 F. Supp. 548 (N.D. Tex. 1947) (holding that copyright provisions were never intended to protect illegality or immorality).

<sup>138</sup> There are a few suggestions regarding certain types of pornography that should be non-copyrightable. For example, Ann Bartow argues that copyright law should not grant copyright protection in a situation of little originality and/or a high-risk level of harms resulting from the distribution and consumption of a work. However, Bartow's suggestion refers only to pornographic materials, and she does not consider the question of illegality outside of the sex industry realm. See Bartow, *supra* note 31, at 37-38. For more academic literature, see, e.g., Robert C. Summers, *Constitutional Protection of Obscene Material Against Censorship as Correlated with Copyright Protection of Obscene Material Against Infringement*, 31 S. CAL. L. REV. 301 (1958) (discussing copyright protection of obscene material); Franklin Wallahan, *Immorality, Obscenity and the Law of Copyright*, 6 S.D.L. REV. 109 (1961) (examining immorality and obscenity in copyright law); Jeremy Phillips, *Copyright in Obscene Works: Some British and American Problems*, 6 ANGLO-AM. L. REV. 138 (1977) (examining the legal reasoning courts give when refusing to protect obscene works); Green, *supra* note 80 (reviewing and criticizing the obscene defense to copyright infringement in the United States); Norman A. Palumbo Jr., *Obscenity and*

should be further examined to determine whether copyright law should be content-neutral on this issue. In order to evaluate whether copyright protection should exist without content considerations, I outline and evaluate the main benefits and drawbacks of content-based restrictions in copyright.

### *A. Drawbacks of Content-Based Restrictions*

Imposing content-based restrictions in copyright could have several negative effects, which maintaining content-neutrality could avoid. First, content-based restrictions could impede the creation of certain types of work;<sup>139</sup> due to the uncertainty of whether a work will be considered copyrightable, it might not be made in the first place.<sup>140</sup> This might burden authors—who will have to guess whether or not their work will be copyrightable—and society (which consume works)—which will not be able to differentiate between protected and unprotected work and fear the possibility of infringement. Hence, content-based restrictions could have a chilling effect on creations and free speech,<sup>141</sup> which could result in creative losses for future generations.<sup>142</sup> Moreover, as a normative matter, copyright

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*Copyright: An Illustrious Past and Future?*, 22 S. TEX. L.J. 87 (1981) (describing the obscenity defense in both English and American copyright law); Kurt L. Schmalz, *Problems in Giving Obscenity Copyright Protection: Did Jartech and Mitchell Brothers Go Too Far?*, 36 VAND. L. REV. 403 (1983) (discussing copyright and obscenity in light of recent court's rulings on this matter); Ann Bartow, *Pornography, Coercion, and Copyright Law 2.0*, 10 VAND. J. ENT. & TECH. L. 799 (2008) (discussing copyright law's effect on the creation and consumption of pornography); McDavid, *supra* note 71 (examining immorality and obscenity in copyright and trademarks); Rothman, *supra* note 53 (reviewing trademark and copyright law's treating of sexual content); Nicole Chaney, *Cybersex: Protecting Sexual Content in the Digital Age*, 11 J. MARSHALL REV. INTELL. PROP. L. 815 (2012) (evaluating copyright protection in light of the Internet and the growing demand for digital sexual content).

<sup>139</sup> See, e.g., Schneider, *supra* note 48, at 719 (arguing that “[d]enial of Registration could work to discourage the development of the Arts.”); Mitchell Bros. Film Grp., 604 F.2d at 856 (5th Cir. 1979) (citing Schneider).

<sup>140</sup> *Mitchell Bros. Film Grp.*, 604 F.2d at 856 (citing Schneider, *supra* note 48, at 719 and arguing that a content-based restriction on the ground of obscenity could potentially discourage authors, publishers and promoters of works).

<sup>141</sup> See, e.g., *id.* (stating that “the absence of content restrictions on copyrightability indicates that Congress has decided that the constitutional goal of encouraging creativity would not be best served if an author had to concern himself not only with the marketability of his work but also with the judgment of government officials regarding the worth of the work.”).

<sup>142</sup> See *id.* at 857 (arguing that “denying copyright protection to works adjudged obscene by the standards of one era would frequently result in lack of copyright protection (and thus lack of financial incentive to create) for works that later generations might consider to be

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law is not designed to bar creativity—rather, it aims to incentivize it—but content-based restrictions could stifle the creation and dissemination of expression.<sup>143</sup>

Second, content-based restrictions on registration could actually increase the circulation of troubling materials to the public since more people will be able to use the work without permission or paying fees.<sup>144</sup> Under this assumption, illegal works, which are usually morally undesirable, will be more harmful to society when not granted copyright protection.

Third, content-based restrictions grant an undesired power to copyright registrars: such restrictions would require that the registrars decide whether a work is moral or legal enough for copyright protection, which is beyond their current scope of creativity and originality. Because the registrar is a government agent, the power to refuse registration on these grounds could be viewed as a form of government censorship.<sup>145</sup> In addition, it is unlikely that every registrar will be able to apply the standard of morality (related to, for example, obscenity); judges are better equipped to determine the nature of a work. However, relying on courts to set a bar will not necessarily solve the problem,<sup>146</sup> as it would require judges to make aesthetic evaluations, a role copyright law did not necessarily intend.<sup>147</sup>

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not only non-obscene but even of great literary merit”); Green, *supra* note 80, at 182 (arguing that without a clear line to determine what is obscene, the potential creator will “logically stay well clear of the line.”).

<sup>143</sup> Jim Gibson, *Copyright as Censorship*, THE MEDIA INSTITUTE (Dec. 22, 2009), [http://www.mediainstitute.org/IPI/2009/122209\\_CopyrightasCensorship.php](http://www.mediainstitute.org/IPI/2009/122209_CopyrightasCensorship.php) (arguing that copyright law is not designed to stifle the creation and dissemination of expression, but rather to encourage it).

<sup>144</sup> See Schneider, *supra* note 48, at 719 (noting that “at least one commentator argued that denial of registration will increase the circulation of material to the public, by removing the right to sue for unauthorized publication and dissemination of copied material”); Jeffrey M. Ferguson, *The Obscenity Defense Denied: The Rise of a Rational View of Copyright*, 9 W. ST. U. L. REV. 85, 95 (1981) (arguing that denying copyright protection “encourages wrongdoers to copy and disseminate obscene matter at will.”); Rothman, *supra* note 53, at 156 (“denying copyright protection and trademark protection to works and marks deemed pornographic or immoral may actually increase their dissemination.”).

<sup>145</sup> Schneider, *supra* note 48, at 720 (arguing that registration denial “would make the Copyright Office a federal censor.”).

<sup>146</sup> *Id.* at 719 (arguing that there are difficulties involved in making a constitutionally adequate determination of obscenity which suggest that courts, rather than the Copyright Office, are the appropriate forum for this determination); Note, *Can Intellectual Property Law Regulate Behavior - A Modest Proposal for Weakening Unclean Hands*, 113 HARV. L. REV. 1503, 1504-05 (2000) (arguing that changing the rule of content neutrality in copyright law will place a difficult burden on either the examiners of the Copyright Office or on the judicial branch); Edward S. Rogers, *Copyright and Morals*, 18 MICH. L. REV.

Finally, as copyright is no longer domestic in nature, imposing content-based restrictions on copyrightability could differentiate U.S. protection from the protections provided elsewhere. That is, works that are considered illegal will not be profitable under U.S. law but will be profitable in any country that does not impose content-based restrictions or that sets content-based restrictions at a lower level. Will works that are considered illegal in the United States and legal in other countries be granted protection only in the other countries? Will artists of such works reallocate to publish only abroad?<sup>148</sup> Although international conventions and agreements that harmonize IP can partially resolve this issue,<sup>149</sup> the criminal laws of each country differ, making such harmonization highly difficult, if possible at all.

### ***B. Benefits of Content-Based Restrictions***

On the other hand, there are several reasons why content-based restrictions in copyright would improve the legal system. First, denial of copyright protection to undesired works could de-incentivize their creation, which can harm society, by removing economic incentives.<sup>150</sup> Copyright law can reduce crime by decreasing economic incentives for illegal works.<sup>151</sup> Moreover, some illegal works might have an additional negative impact on society, for example by offending unwilling onlookers,<sup>152</sup>

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390, 390 (1920) (“[O]f course a work utterly useless and worthless would not promote the progress of science and useful arts, but outside of obvious limits it is dangerous for persons trained only in the law to pronounce upon such matters.”).

<sup>147</sup> See, e.g., *Belcher v. Tarbox*, 486 F.2d 1087, 1088 (9th Cir. 1973) (“[T]here is nothing in the Copyright Act to suggest that the courts are to pass upon the truth or falsity, the soundness or unsoundness, of the views embodied in a copyrighted work. The gravity and immensity of the problems, theological, philosophical, economic and scientific, that would confront a court if this view were adopted are staggering to contemplate”); Rothman, *supra* note 53, at 158 (“[C]opyright law has long discouraged judges from making aesthetic evaluations.”).

<sup>148</sup> This scheme could also be beneficial at some level, as it disincentives the creation of undesired works, at least in the U.S.

<sup>149</sup> See, e.g., TRIPs, *supra* note 133.

<sup>150</sup> On the economic motive of advertising and selling child pornography, see, e.g., *New York v. Ferber*, 458 U.S. 747, 747 (1982) (“[T]he advertising and selling of child pornography provides an economic motive for and is thus an integral part of the production of such materials, an activity illegal throughout the nation.”).

<sup>151</sup> On the other hand, see Green, *supra* note 80, at 183 (arguing that the “existence of copyright would not hinder criminal prosecutions.”).

<sup>152</sup> For example, exposure to an obscene work can be shocking to people’s sensibilities. For justifications of obscenity regulations, see SULLIVAN & GUNTHER, *supra* note 85, at 121.

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inducing criminal conduct,<sup>153</sup> eroding moral standards, and harming the social fabric.<sup>154</sup>

Second, content-based restrictions on illegal works could aid in compensating the victims of a crime. Reallocating the right to sue for infringement from the offender to the victim or proxy of her choice gives the victim an additional means of compensation from the crime or from the additional harm caused by the work. I elaborate on this matter later.<sup>155</sup>

Third and finally, without content-based restrictions, granting federal protection to illegal materials could be viewed as government endorsement of such illegal works, suggesting that the government approves such activity.<sup>156</sup> Under this argument, because the government should not advocate copyright protection for works that can harm public policy, governments should instead restrict the registration of undesirable works.

To conclude, there are both benefits and drawbacks to content-based restrictions in copyright law. As a quantitative matter, the benefits outweigh the drawbacks and copyright law should remain content-free, at least to some extent. Nevertheless, qualitatively, the drawbacks of granting copyright protection to illegal works outweigh the benefits of a content-neutrality approach, to some extent. Thus, in the following section, I propose a modest solution to correct an injustice empowered by the current alleged content-neutrality approach of copyright law.

## VI. THE PROBLEM OF ILLEGAL WORKS

Consider the following two examples of illegal works: spray painting graffiti on a public building and filming child pornography. Graffiti could be considered undesirable and is illegal in most states—particularly when it is connected to vandalism.<sup>157</sup> However, this illegal act is undesirable due to its destructive nature and not because of the scope of its creativity. In other words, graffiti exemplifies a type of work the content of which, if disconnected from criminal activity, is a legal form of free speech and should be protected. The illegality arises not from the content of the creation, but from the act of it.

<sup>153</sup> For example, obscenity could induce “criminal sexual conduct.” *See id.* at 121.

<sup>154</sup> *See id.* at 121-22.

<sup>155</sup> *See infra* VI.A.2.

<sup>156</sup> McDavid, *supra* note 71, at 562 (describing an argument that granting copyright protection to obscene materials “is de facto government endorsement of pornography to feminist concerns for the welfare of exploited women.”).

<sup>157</sup> *See, e.g.*, CAL. PENAL CODE § 594(a)(1) (2012); GA. CODE ANN. § 34.70 (2012). *See also* Schwender, *supra* note 72 (describing illegal graffiti in the United States).

Now consider child pornography. Imagine that a photographer takes an original pornographic photo of a child and registers it. After registration, the photo finds its way to the Internet and is downloaded by various users. Assume that all individuals who broke the law are convicted and incarcerated.<sup>158</sup> While serving time, the photographer files multiple lawsuits for copyright infringement. Even if the photo is no longer available online, the photographer can sue for copyright infringement and receive damages. In this case, the convict can profit from her unlawful activity, while the victim receives no compensation. Society does not benefit. The content is criminal and should not be protected by law; instead, profits from the crime should be minimized.

Though the child pornography example may be little more than a hypothetical for a number of reasons—for example, the author is unlikely to register the work or sue infringers because she will likely fear criminal charges<sup>159</sup>—this hypothetical nevertheless raises important issues. Most importantly, copyright law serves an expressive value for society. Regardless of whether or not copyright protection incentivizes the creation of such works or is ever even invoked in such situations, the law should not condone such works as a normative matter. Copyright law should not protect undesired works because the law should not aid in creating social injustice; it should not be written in such a way that it could incentivize criminal behavior.<sup>160</sup> Thus, from a social perspective, Congress should not grant copyright protection to undesirable works and should instead suppress

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<sup>158</sup> Under 18 U.S.C. § 1466A(a) (2012) and 18 U.S.C. § 1466A(b) (2012), these individuals include anyone who knowingly [attempts to, conspires to, or does] produce, distribute, receive, or possess with [or without] intent to distribute a visual depiction of any kind, including a drawing, cartoon, sculpture, or painting, that depicts a minor engaging in sexually explicit conduct and is obscene or depicts an image that is, or appears to be, of a minor engaging in graphic bestiality, sadistic or masochistic abuse, or sexual intercourse, including genital-genital, oral-genital, anal-genital, or oral-anal, whether between persons of the same or opposite sex and lacks serious literary, artistic, political, or scientific value. Thus, assume that both the rights holders and the end-users are convicted and incarcerated.

<sup>159</sup> See Bartow, *supra* note 31 (“[N]o holder of copyright in a work that unambiguously constitutes child pornography has to date legally asserted copyrights or brought an infringement action. Given the shadowy nature of the industry due to fear of arrest, it seems unlikely that unambiguous works of child pornography in which real children are depicted have even been registered with the Copyright Office”); McDavid, *supra* note 71, at 570 (arguing that a child pornographer will not likely register her work since registration sends evidence of the felonious act to the federal government).

<sup>160</sup> Yet, the fact that a convicted felon profits because copyright law allows her to, does not contradict copyright’s constitutional purposes. See McDavid, *supra* note 71, at 571 (“Whether anyone reaps a reward from copyright is of no constitutional concern.”).



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their creation and dissemination by blocking legal incentives. Congress should strive to block profits from undesired works and undesired conduct.

### *A. Solutions for Illegal Works*

As I discuss earlier, copyright law does not examine the nature of a work before granting it protection. When illegal works are original and fixed in a tangible medium of expression, they can automatically be registered for copyright.<sup>161</sup> However, whether the authors of these works can benefit from legal remedies once infringement occurs remains an open question. Since 1979, courts in the Fifth and Ninth Circuits have granted remedies for infringement of obscene works,<sup>162</sup> but courts in the Second Circuit have not.<sup>163</sup> Congress or the Supreme Court should clarify whether illegal works are eligible for legal remedies. Until such clarification is provided, courts should abstain from imposing content-based restrictions on copyrighted works (based on illegality or immorality), as current law does not explicitly grant such restrictions.

At the same time, current copyright law is not entirely content-neutral. As a result, adding further restrictions into copyright law should not jeopardize the goals of copyright law. Accordingly, copyright law should not incentivize illegal works. Criminal offenses that harm an individual are undesirable for society and any knowledge gained from creative work connected to the crime does not necessarily enrich the public domain. Thus, when criminal offenders profit from their actions, it leads to injustice that should not be permitted by the law. Accordingly, I propose a new framework to address this problem. Before turning to my proposition, I review existing and suggested methods of preventing crime profitability in order to emphasize the need for such a proposal.

#### *1. Equitable Doctrines*

American law contains many types of equitable doctrines that can be invoked in some copyright lawsuits as a remedy or defense. Other forms of IP also acknowledge certain remedies and defenses to infringement lawsuits. In trademark, for example, the owner of a misleading mark is not eligible for an injunction against the infringement of the mark.<sup>164</sup> Similarly,

<sup>161</sup> See *supra* Section II.A.

<sup>162</sup> Mitchell Bros. Film Grp., 604 F.2d 852 (5th Cir. 1979); *Jartech, Inc. v. Clancy*, 666 F.2d 403 (9th Cir. 1982).

<sup>163</sup> *Devil Films, Inc. v. Nectar Video*, 29 F. Supp. 2d 174 (S.D.N.Y. 1998).

<sup>164</sup> See *Worden & Co. v. California Fig Syrup Co.*, 187 U.S. 516, 23 S.Ct. 161, 188, 47 L.Ed. 282 (1903) (the California Fig Syrup Company used the trademark “Syrup of Figs”

a plaintiff who acquired a patent in violation of antitrust limitations on patent pooling is not entitled to bring suit to enjoin another from using the patent because such an injunction would support the antitrust violation.<sup>165</sup> However, as I briefly analyze, the current equitable doctrines in copyright are not applicable to most cases of illegal works infringement and, therefore, cannot aid in solving the presented injustice.

I begin with the equitable remedy of unjust enrichment. The undesired outcome of crime profitability could be resolved, at least partially, by invoking the unjust enrichment rationale that “[a] person who is unjustly enriched at the expense of another is subject to liability in restitution.”<sup>166</sup> Plaintiffs seeking recovery for unjust enrichment usually must prove that the defendant benefited at their expense and that equity and good conscience require restitution.<sup>167</sup>

If such a legal solution is available, is a new doctrine necessary? The answer is simple. Even if unjust enrichment *can* resolve the problem of crime profitability, it is uncertain that every court will accept such a claim, especially regarding copyright infringement. For example, when an end-user unlawfully downloads a snuff film, but its right holder does not sue for copyright infringement, the end-user is not enriched, at least not in the monetary sense.<sup>168</sup> Thus, it is unlikely that the victim of the snuff film (or her proxy) will be able to sue the end-user for unjust enrichment from copyright infringement since the end-user received no benefit at the victim’s expense. Moreover, it is uncertain that every case of illegal copyright will arise from a causal relationship between the wrongful act and the enrichment, such as in the case of a murderer that sells a painting unrelated to the crime. In addition, a well-crafted framework should also contain legal remedies for crime victims who are unaware, unable, or

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for a laxative that was not in fact a syrup of figs. The court held that “when the owner of a trademark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trademark or in his advertisements and business, be himself guilty of any false or misleading representation, ; that if the plaintiff makes any material false statement in connection with the property which he seeks to protect, he loses his right to claim the assistance of a court of equity”). *Id.* at 528; *see also* Shondel v. McDermott, 775 F.2d 859, 868 (7th Cir. 1985).

<sup>165</sup> *See* Frank Adam Elec. Co. v. Westinghouse Elec. & Mfg. Co., 146 F.2d 165 (8th Cir. 1945); Shondel v. McDermott, 775 F.2d 859 (7th Cir. 1985).

<sup>166</sup> *See* RESTATEMENT (THIRD) OF RESTITUTION AND UNJUST ENRICHMENT § 1 (2011).

<sup>167</sup> *See, e.g., In re Mid-Island Hosp., Inc.*, 276 F.3d 123, 129 (2d Cir. 2002).

<sup>168</sup> A possible counter argument could be that the end-user is enriched by receiving content which she did not pay for.

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unwilling to sue the felon.<sup>169</sup> In such cases, unjust enrichment is fairly limited, and will not advance the important interest of compensating all crime victims. Put differently, a new framework must prevent legal uncertainty concerning what makes a particular enrichment unjust<sup>170</sup> and must ensure that the law addresses crime profitability and victims' compensation.

In addition to equitable remedies, three types of equitable defenses can be invoked in copyright lawsuits: The first is *unclean hands* and applies to a case in which a plaintiff's misconduct "affect[s] the equitable relations between the parties in respect of something brought before the court for adjudication."<sup>171</sup> This doctrine has been affirmed in copyright law<sup>172</sup> but is rarely invoked. When it has been invoked, it has met very specific

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<sup>169</sup> See, e.g., Kealy, *supra* note 78, at 23 (arguing that a law such as the Son of Sam Law, as opposed to existing civil actions, "is necessary to ensure that victims will be compensated regardless of whether or not it occurs to them to bring a civil action against their offenders.").

<sup>170</sup> See, e.g., Ernest J. Weinrib, *Structure of Unjustness*, 92 B.U. L. REV. 1067, 1067 (2012) ("Even today, as we celebrate a new Restatement (Third) of Restitution and Unjust Enrichment, uncertainty concerning what makes a particular enrichment unjust continues to spawn both doctrinal and theoretical controversy.").

<sup>171</sup> *Keystone Driller Co. v. General Excavator Co.*, 290 U.S. 240, 245, 54 S.Ct. 146, 148, 78 L.Ed. 293, 297 (1933); see also *Mitchell Bros. Film Grp.*, 604 F.2d at 863. Another doctrine entitled *in pari delicto* (equally at fault), is a subdivision of the "unclean hands" defense—when opposing sides are equally wrong, court will not adjudicate their dispute as awarding relief to the plaintiff would reward wrongdoing. Hence, applying the doctrine on copyright infringement lawsuit could result in barring monetary fines and damages in the event the plaintiff's work is equally at fault with the defendant. However, it is irrelevant in this situation as long as a copyright does not intervene with the nature of a work, even if it is considered morally wrong, the plaintiff is not at fault at all, thus, disabling the *in pari delicto* doctrine. See generally, Norman C. Sabbey, *Private Antitrust Suits: The In Pari Delicto Defense*, 10 B.C. L. REV. 172 (1968); *Everet v. Williams, Ex. (1725)* (known as "*The Highwayman's Case*," as described in Note, *The Highwayman's Case*, 9 L.Q. REV. 197 (1893)); *Schlueter v. Latek*, 683 F.3d 350, 355-56 (7th Cir. 2012) (describing the doctrine of *in pari delicto*).

<sup>172</sup> For example, in 1903, the Second Circuit refused to punish a defendant who plagiarized parts of two copyrighted encyclopedias into a separate work because the plaintiff had also plagiarized another's work. The court relied on the plaintiff's unclean hands (*Edward Thompson Co. v. Am. Law Book Co.*, 122 F. 922 (2d. Cir. 1903)). In 1915, the Circuit Court of Appeals for the Fifth Circuit withheld protection for an instruction manual, stating that "he who seeks equity must present himself in court with clean hands." (*Stone & McCarrick, Inc. v. Dugan Piano Co.*, 220 F. 837 (5th Cir. 1915)). See also Brett Frischmann & Dan Moylan, *The Evolving Common Law Doctrine of Copyright Misuse: A Unified Theory and its Application to Software*, 15 BERKELEY TECH. L.J. 865, 881 (2000) (discussing these two unclean hands doctrines applied in United States copyright law).

conditions<sup>173</sup>—specifically, “the plaintiff’s transgression [must be] of serious proportions and relate[s] directly to the subject matter of the infringement action.”<sup>174</sup> Moreover, given that this doctrine only applies when the wrongful acts “in some measure affect the equitable relations between the parties in respect of something brought before the court for adjudication,”<sup>175</sup> the defendant must be personally injured by the plaintiff’s “wrongful” conduct.<sup>176</sup> Because the defendant in an illegal copyright case would likely be the individual who infringed the work and the plaintiff would be the maker, this doctrine seems unlikely to serve as a valid defense in such cases.<sup>177</sup> Furthermore, since the Fifth Circuit rejected the doctrine in 1979—reasoning that this doctrine adds a defense not authorized by Congress<sup>178</sup> and holding that any similar defense in an infringement action is inappropriate<sup>179</sup>—it is unclear whether the doctrine is still relevant in copyright law. Thus, the equitable defense of unclean hands does not provide the necessary mechanisms to adjudicate illegal works.<sup>180</sup>

The second equitable defense is of *fraud or misconduct* as a basis for denying relief. This defense applies to: fraud perpetrated against the Copyright Office; obtaining information regarding the nature of the defendant’s work through unfair means; failure to disclose material

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<sup>173</sup> See NIMMER, *supra* note 22, § 13.09 (arguing that the equitable defense of unclean hands was recognized rarely, when the plaintiff’s transgression was of serious proportions and relates directly to the subject matter of the infringement action).

<sup>174</sup> *Id.*

<sup>175</sup> *Keystone Driller Co.*, 297 U.S. at 245; *Mitchell Bros. Film Grp.*, 604 F.2d.

<sup>176</sup> See *Lawler v. Gillam*, 569 F.2d 1283, 1294 (4th Cir. 1978); *Mitchell Bros. Film Grp.*, 604 F.2d. at 863.

<sup>177</sup> See, e.g., *McDavid*, *supra* note 71, at 569 (“[t]he case of infringement of a copyright for obscene materials where the defendant infringer is personally injured is difficult, if not impossible, to imagine.”).

<sup>178</sup> *Mitchell Bros. Film Grp.*, 604 F.2d. at 861. In addition, the court held that a prior decision in related matters, i.e., *Stone & McCarrick, Inc. v. Dugan Piano Co.*, 220 F. 837 (5th Cir. 1915), is inconsistent with later Supreme Court and Fifth Circuit rulings holding that an equitable doctrine should not be applied in a way that will frustrate the purpose of a federal statute). *But see* *McDavid*, *supra* note 71, at 569 (arguing that the applicability of the unclean hands doctrine in copyright protection is still unknown, even after the *Mitchell Bros.* ruling).

<sup>179</sup> *Mitchell Bros. Film Grp.*, 604 F.2d at 863 (“obscenity is not an appropriate defense in an infringement action, whether piggybacked on the unclean hands rubric or introduced in some other manner.”).

<sup>180</sup> *Dream Games of Ariz., Inc. v. PC Onsite*, 561 F.3d 983 (9th Cir. 2009) (holding that illegal operation of an otherwise copyrightable work does not deprive the work of copyright protection, nor is it a defense to infringement, at least where the illegality did not injure the infringer); *Rothman*, *supra* note 53, at 142 (arguing that today’s dominant view of copyright law is that “equitable theories such as unclean hands do not prevent the enforcement of copyright in such instances.”).

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information; and deceptively submitting false material information to the Copyright Office.<sup>181</sup> However, as these categories do not address most illegal conduct, much like unclean hands, this defense will not serve as a valid defense in most cases, and therefore it is also not a proper mechanism for adjudicating illegal works.

The third equitable defense is *copyright misuse*—an attempt by the right holder to extend the scope of her statutorily-granted but limited monopoly, which could result in a violation of antitrust laws.<sup>182</sup> When raised successfully, the copyright misuse defense can bar a plaintiff from prevailing in an action for infringement upon the misused copyright.<sup>183</sup> However, as this doctrine is mostly based in anti-competitive rationales and does not address the subject of most illegal works *per se*, it is, therefore, also irrelevant to the problem presented.

To conclude, current equitable doctrines are incapable of untangling all matters relating to illegal conduct. Thus, a new solution is required. I now propose two frameworks. The first has previously been suggested in the literature and applies “compliance conditions” to copyright registration. The second, an original provision that I suggest for the first time, is to design an *illegal copyright* framework. This framework would reduce monetary incentives to commit crimes by ensuring that felons would not profit from their crimes. Furthermore, it would de-incentivize the creation of undesired works, and ensure victim compensation. As I discuss below, the *illegal copyright framework* best protects the public’s interests.

## 2. Proposed Frameworks

The general outline of the two frameworks is similar: Every illegal work of authorship, fixed in a tangible form, is eligible for copyright protection, but is generally not eligible for any legal remedy, at least not for the felon. The first solution, as proposed by one scholar, applies “compliance conditions” to copyright registration.<sup>184</sup> As suggested, Congress should invalidate copyright registration when the author or her agent has “violated specific criminal laws in the immediate production of

<sup>181</sup> See NIMMER, *supra* note 22, at § 13.09; Note, *supra* note 146, at 1507 (describing the “inequitable conduct” defense).

<sup>182</sup> See generally, NIMMER, *supra* note 22, at § 13.09; John Baker McClanahan, *Copyright Misuse as a Defense in an Infringement Action*: Lasercomb America Inc. v. Reynolds, 49 WASH. & LEE L. REV. 213 (1992).

<sup>183</sup> See Lasercomb Am., Inc. v. Reynolds, 911 F.2d 970, 972 (4th Cir. 1990) (“A successful defense of misuse of copyright bars a culpable plaintiff from prevailing on an action for infringement of the misused copyright.”).

<sup>184</sup> See Note, *supra* note 146.

the material for which the protection is sought.”<sup>185</sup> Under this proposal, copyright registration will be accompanied by a notice that if the creator or their agents should be discovered to have violated criminal laws (or a statutorily defined subset) they will be forced to forfeit their copyright. Upon convicting the owner for violating the underlying law, the government could invalidate the copyright and registration, and could even seize and destroy physical attributes of the copyrighted work.

This proposal deals with the problem internally to copyright, and to some extent, resolves the problem of illegal copyright in a proper manner. Implementing “compliance conditions” will de-incentivize the creation of socially undesirable works. Moreover, compliance conditions draw a relatively clear line that addresses the problem of uncertainty as to whether works are copyrightable or not: The work of an author who has violated specific criminal laws in the immediate production of the work is not copyrightable.

However, this proposal is insufficient: Compliance conditions only apply to violations of criminal law in the immediate production of the material; thus, criminal acts that ensued after the immediate production of the material will not invalidate registration. Consider the following scenario: a convicted and imprisoned child molester decides to publish a song for every child molested, describing the unlawful acts in non-obscene language. Applying compliance conditions will not void registration of the work, as no criminal act occurred in the immediate production of the material.

In addition, these conditions apply to every criminal act, but should be limited to criminal acts that directly harm another person, either physically or mentally. Take graffiti for example. If someone sprays original graffiti on the wall of a public building and is incarcerated, compliance conditions will deprive her of copyright protection.<sup>186</sup> Although criminal law prohibits her actions, copyright law should not deprive her of her creativity. If someone saw this graffiti and copied it, this artist should enjoy the benefits of copyright law, and receive damages for the infringement of her right. Moreover, forfeit of the copyright under these conditions, which would bar any attempt to sue for copyright infringement of the work, would also deny relief to the victim.

Thus, a proper solution should use copyright infringement damages to aid in victim compensation. That is, the victim should not only be

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<sup>185</sup> *Id.* at 1503.

<sup>186</sup> Some graffiti will not be protected by copyright because it does not comply with copyright law requirements. Protected graffiti also poses various problems for copyright protection. For instance, the artist may be anonymous, and graffiti gets painted over often.

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compensated for the criminal proceedings, but also for any harm that resulted from the distributed work. In addition, the fact that a criminal work is invalidated and even seized and destroyed by the government does not erase the early distribution of the work. As a result, the “undesired” criminal work could be further distributed even though it has been invalidated.

Finally, as suggested by one scholar, because it is hypothetical that felons will attempt to register a copyright of their work and risk conviction, this proposition “seems little more than a hollow victory,” as the work “would have no value as it would be unmarketable.”<sup>187</sup> I, however, disagree with this criticism. Even illegal works have a market, and although felons are not likely to register an illegal work and risk conviction, such registration is still plausible.<sup>188</sup> Hence, the law should not advocate such behavior.<sup>189</sup>

As the “compliance conditions” proposal is insufficient, I propose another solution to resolve copyright law’s perceived injustices—specifically, this solution would de-incentivize illegal creations and criminal conduct by reducing profitability from the crime. Much like the “compliance conditions” proposal, this proposal assumes that copyright felons should not be awarded damages when their work is infringed.<sup>190</sup>

The normative justification of my proposal extends beyond possible enrichment that criminals could get from infringement lawsuits for illegal copyright. In fact, the perception that criminals should not profit from crime already exists in other legislation that is partially related to copyright. In an emerging need to correct injustice, some states have passed notoriety-for-

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<sup>187</sup> For this argument, see McDavid, *supra* note 71, at 574.

<sup>188</sup> For example, family members of Albert DeSalvo, better known as the “Boston Strangler,” claim that he only confessed to the murders to profit from book and movie deals. See Tracey B. Cobb, *Making a Killing: Evaluating the Constitutionality of the Texas Son of Sam Law*, 39 HOUS. L. REV. 1483, 1485 (2002) (citing Philip Hilts, *Boston Strangler: New Clues, New Mysteries: Forensic Team Finds Evidence that Could Prove Albert DeSalvo Wasn't the Spree Killer*, TORONTO STAR (Dec. 30, 2001)). Furthermore, the infrequency of an undesired act should not provide a valid argument preventing regulation against it. See, e.g., Kealy, *supra* note 78, at 21 (arguing that “the mere infrequency of the statute’s use in the past does not provide a valid argument for keeping the statute off the books.”).

<sup>189</sup> Yet, it could be more beneficial for society to grant copyright protection to such felons since the incentive to register could aid in catching criminals. Thus, although those criminals can receive damages, it could be less important than the possibility of incarcerating them.

<sup>190</sup> For a similar general argument, see Schmalz, *supra* note 138, at 430 (arguing that a sound policy should deny financial rewards to obscene works that by definition are illegal and violate national policy).

profit laws, usually referred to as “Son of Sam” laws.<sup>191</sup> New York passed the first Son of Sam law in 1977,<sup>192</sup> providing, *inter alia*, that an “entity” contracting with a person “accused or convicted of a crime” for the production of a movie, book, magazine article, tape recording, or the like, which reenacts, or describes the person’s thoughts, feelings, opinions or emotions regarding such crime, must pay any money owed to that person under the contract to a Crime Victims Board instead.<sup>193</sup> The money was then deposited in an escrow account, and paid to victims who filed a claim within five years of the date the escrow account was established.<sup>194</sup> But the Supreme Court struck down this law in 1991, holding that it violates the First Amendment due to its significant overinclusiveness.<sup>195</sup> In 1992, a revised version of the law passed in New York, correcting the overinclusiveness of the first law, and like similar Son of Sam laws throughout most of the country, still exists.<sup>196</sup>

A federal Son of Sam law also exists.<sup>197</sup> The federal statute applies to convictions of gathering or delivering defense information to aid a foreign government, and to convictions for federal crimes resulting in physical harm to an individual.<sup>198</sup> The Crime Victims Fund in the Treasury uses the profits from the depiction of the crime in a movie, book, newspaper, magazine, radio or television production, or live entertainment of any kind, or an expression of that defendant’s thoughts, opinions, or

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<sup>191</sup> Named after the serial killer David Berkowitz, nicknamed “Son of Sam,” who was offered a relatively large sum of money for the rights to his story. See David L. Hudson Jr., *‘Son of Sam’ laws*, FIRST AMENDMENT CENTER (June 4, 2004), <http://www.firstamendmentcenter.org/son-of-sam-laws>. For more information regarding “Son of Sam” laws, see Mark A. Conrad, *New York’s New “Son of Sam” Law-Does It Effectively Protect the Rights of Crime Victims to Seek Redress from Their Perpetrators?*, 3 FORDHAM ENT., MEDIA & INTELL. PROP. L.F. 27, 31 (1992) (describing the need for the first “Son of Sam” law).

<sup>192</sup> N.Y. EXEC. LAW § 632-a (McKinney 1982).

<sup>193</sup> *Simon & Schuster, Inc. v. State Crime Victims Bd.*, 502 U.S. 105 (1991) (describing the “Son of Sam” law in New York).

<sup>194</sup> See generally, Henry Cohen, *The “Son of Sam” Case: Legislative Implications*, CRS REPORT FOR CONGRESS 1 (1998) (describing the New York “Son of Sam” Statute).

<sup>195</sup> *Simon & Schuster*, 502 U.S. (striking down a law regulating the earnings of convicted criminals who write tell-all books about their crimes, as it was inconsistent with the First Amendment’s guarantee of freedom of speech and press).

<sup>196</sup> N.Y. EXEC. LAW § 632-a (McKinney Supp. 1994). For a full list of existing “Son of Sam” laws, see FREEDOM FORUM, <http://www.freedomforum.org/packages/first/SonOfSam/index.htm> (last visited Oct. 1, 2013).

<sup>197</sup> 18 U.S.C. § 3681 (2012).

<sup>198</sup> See generally Cohen, *supra* note 194 (describing federal and state “Son of Sam” legislation).



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emotions regarding such crime, for victim compensation while remaining amounts may be paid into the Fund.<sup>199</sup> However, the federal Son of Sam law is insufficient to deal with the perceived problem of copyright-related crimes, as it only applies to federal crimes. Similarly, state Son of Sam laws are insufficient, as they differ between states and do not exist in all states.

I propose introducing an *illegal copyright* framework to copyright law—similar in essence to Son of Sam laws, but different in scope. Generally, Son of Sam laws are an improper and insufficient mechanism to cover all types of copyright-related crimes. They are improper, as they depend on state legislators, when this problem should be dealt with on a nation-wide scale. Thus, I propose an amendment to the Copyright Act, based on the concept that criminals who have committed certain types of criminal offenses should not be able to profit from their *illegal copyright* or their reputation. This provision is threefold:

First, copyright registration will be accompanied by a notice that if the creator or his/her agent was convicted of, pled guilty to, or voluntarily admitted to a serious crime (or some statutorily defined subset)<sup>200</sup> that resulted in physical or emotional harm to an individual,<sup>201</sup> and to which the registered material is directly and substantially connected, they will forfeit all of their rights to the material. These rights will be expropriated and reallocated to a “Crime Victims Board” (CVB), which will become the material’s registered copyright owner.<sup>202</sup> In cases of unregistered materials, the CVB will be granted the ability to register the material and become its copyright owner. In both cases, the copyright felon will be permitted to make non-commercial, personal use of his previously-owned work.<sup>203</sup>

The CVB will publish legal notices to potential victims of the crime, or their living relatives, and on request, will sue infringers on their behalf. Any profits from the work, including from copyright infringement suits,

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<sup>199</sup> 18 U.S.C. § 3681 (2012); Cohen, *supra* note 194, at 4.

<sup>200</sup> This framework does not apply to those simply accused of a felony, as the presumption of innocence is important to protect. *See, e.g., Coffin v. United States*, 156 U.S. 432 (1895).

<sup>201</sup> Including criminal offenses that cause emotional harm is also important. To illustrate, consider a convicted felon who took naked pictures of a minor. In that case, the minor was not necessarily physically harmed, but the emotional impact on her from the distribution of the work should also be considered as entitled to compensation.

<sup>202</sup> The duration of the copyright will remain the life of the original author plus 70 years (17 U.S.C. § 302 (2012)).

<sup>203</sup> It should be further clarified that any contractual obligations made by the felon prior to conviction, pleading guilty to, or voluntarily admission to the serious crime, are void. The CVB will carefully consider whether to sign new contracts, taking into account the victims or her living relatives opinions.

will be deposited in an escrow account managed by the board. The board will use the escrow for the benefit of and payable to the victim or her living relatives. In addition, in cases where the victim or her living relatives do not request the board to sue for copyright infringement, the board will be able to file suit on their own discretion. Any profits from such suits will be deposited in an escrow account managed by the board, which will use the escrow for the benefit of and payable to the victims or her living relatives, and for the compensation of any victims of similar offences throughout the country. Whenever money is deposited in the escrow account, the board will publish legal notices to potential victims of the crime.

Second, copyright law should contain an *illegal copyright misuse* provision, which will give the CVB the ability to sue the copyright felon for any previous profits from a work that is directly and substantially connected to the crime.<sup>204</sup> Any profits from the work, including from copyright infringement suits, will be deposited in an escrow account managed by the board. As in the first provision, the board will use the escrow for the benefit of and payable to the victim or her living relatives, and for the compensation of any victims of similar offences throughout the country. Whenever money is deposited in the escrow account, the board will publish legal notices to potential victims of the crime.

Third, under a second provision of the *illegal copyright misuse* doctrine, the CVB be able to sue a copyright felon for (increased) profits from works made by the felon, which, though not linked to the crime, did garner more profits by virtue of the notoriety the felon gained from the crime, such as income from a book that does not address the actual crime but becomes more popular due to the criminal's notoriety. In order to estimate such additional profits, the court will determine the fair market value of a similar work that has not gained value through crime-related notoriety and deduct that from the profits.<sup>205</sup> Any excess profit from the work will be deposited in an escrow account managed by the board. As in the first and second provisions, the board will use the escrow for the benefit of and payable to the victim or her living relatives, and for the compensation of any victims of similar offences throughout the country. Whenever money is deposited in the escrow account, the board will publish

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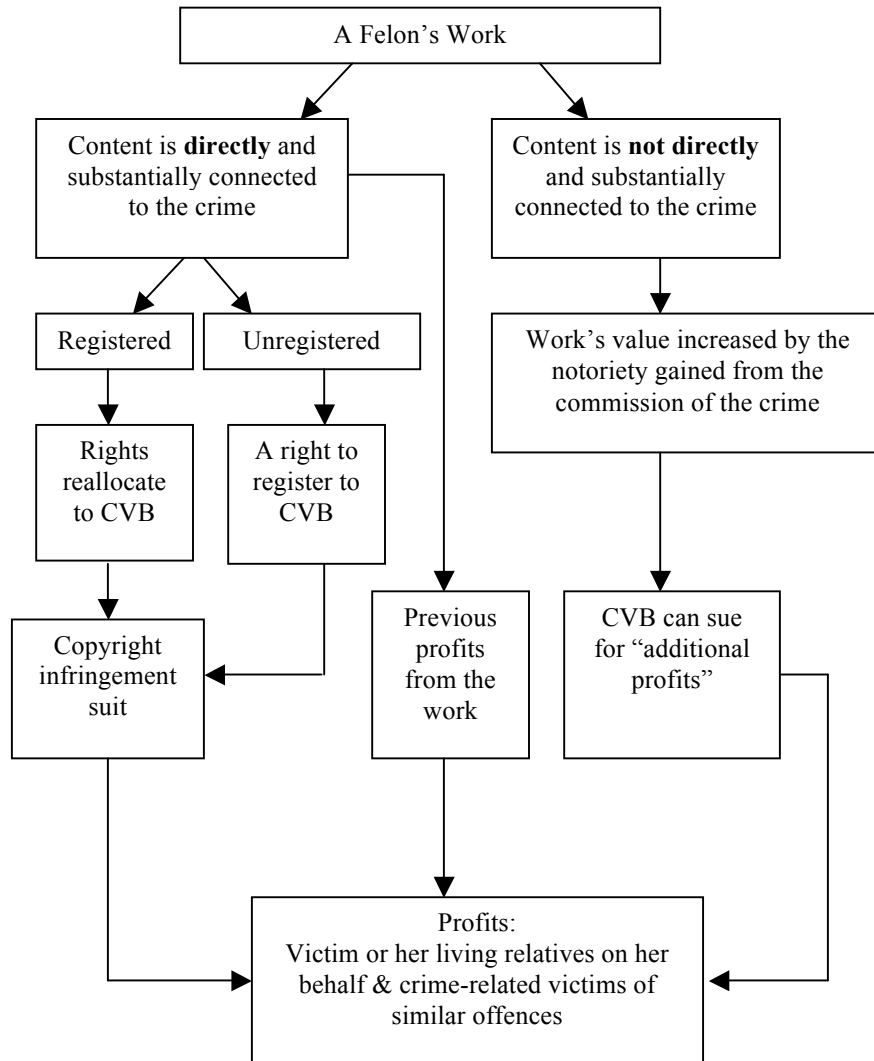
<sup>204</sup> Although the accused could spend all profits before conviction, leaving nothing for the escrow account, this could be solved by seizing all profits at the time of the indictment. The profits could be returned if the accused is not found guilty.

<sup>205</sup> It is noted that in some cases, determining the fair market value of a similar intangible or tangible property could be highly problematic. For example, if the felon was already famous prior to her misconduct, then the court must consider her former reputation in estimating the increased value of the similar intangible or tangible property as if sold prior to the commission of the crime.

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legal notices to potential victims of the crime. Figure 1 best illustrates the illegal copyright framework:

Figure 1: The Illegal Copyright Framework



If designed correctly, this proposal can be held constitutional under the First Amendment. First, as discussed in Section III.B, the First Amendment does not protect some forms of speech. Although the scope of unprotected speech is limited, a broad interpretation of Supreme Court decisions indicates that permitted restrictions on the content of speech can apply to speech that is “of such slight social value as a step to truth that any benefit that may be derived from [it] is clearly outweighed by the social

interest in order and morality.”<sup>206</sup> As my proposal targets the profits of specified felons, the social interest in order and morality clearly outweighs any slight social value that would be lost from the restriction. Therefore, the First Amendment should not apply to the works at issue here.

Second, this proposal does not restrict speech, but rather reduces the profitability of certain types of conduct. It disincentivizes crime, not protected speech. Much like current restrictions on trademark registration, this proposal would still allow the works to exist, just in a less profitable form.<sup>207</sup> Therefore, this proposal should be held not to violate the First Amendment as it does not restrict speech.<sup>208</sup>

Third and finally, even if my proposal is deemed to place a restriction on speech, it should be considered content-neutral as it regulates speech without regard to the viewpoint conveyed, with only an incidental effect on speech due to a possible chilling effect to create. Therefore, it will only need to survive intermediate scrutiny.<sup>209</sup>

Even if my proposal is considered to place a content-based restriction on speech, it may be able to pass the almost impossible strict scrutiny examination. Although content-based restrictions on speech are presumptively invalid, and are unlikely to survive in light of past Court decisions,<sup>210</sup> my proposal could survive as it serves a compelling state interest and it is narrowly drawn to achieve that end.

My proposal serves two compelling interests: first, to disincentivize criminal behavior by ensuring that felons do not profit from their crimes or their reputation, and second, to ensure that victims, or their family, receive compensation. Thus, as the proposal serves compelling state interests, it can survive strict scrutiny as long as it is neither under- nor overinclusive.

For the framework to avoid underinclusiveness, it must not apply only to the speech of the crime. As a result, a provision that deprives the criminal of any income from copyright infringement cases is not enough, as it would only apply to the speech of the crime. Hence, the provision should also include any increased profits from any other work related to the felon’s

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<sup>206</sup> See *R.A.V. v. St. Paul*, 505 U.S. 377, 382-83 (1991) (citing *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942)).

<sup>207</sup> For more on trademarks content-restrictions justifications, see *supra* Section IV.A.

<sup>208</sup> For a similar argument on possible free-speech argument against imposing “compliance conditions,” see Note, *supra* note 146, at 1509. *But see* *Simon & Schuster, Inc.*, 502 U.S., at 115 (“[a] statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech.”).

<sup>209</sup> See *supra* note 86.

<sup>210</sup> See *supra* Section III.B.

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increased notoriety (and not to the crime).<sup>211</sup> This provision should be sufficient to avoid underinclusiveness while only having an incidental effect on speech for which restrictions must meet a less stringent standard.<sup>212</sup>

For the framework to avoid overinclusiveness, it should not apply where it does not advance legitimate government objectives. The law should not apply to every expression of a criminal, but rather only to any expression that could further harm the victim or her living relatives and to works that became more profitable due to the criminal's notoriety. If a convicted serial killer receives fair market value royalties for her pre-crime work, without any profit boost due to reputation, she should be entitled to all of that income. However, if the royalties increase due to her reputation, she should not profit from that increased value. Moreover, if the same serial killer publishes a book that describes the murder of every victim, she should not enjoy profits from her work, nor from a lawsuit challenging copyright infringement of her work, as the victim's living relatives are likely to be further harmed. It is important to de-incentivize the creation of such undesired works by reducing their profitability.

In addition, the law should apply to works related to acts defined as crimes in the penal law (including federal crimes), or any other acts mentioned in the consolidated laws of the state that result in physical or mental harm to an individual. The mandatory harm requirement is essential to fulfilling the state interest of compensating the victims,<sup>213</sup> and is also important to ensure that the law is not overinclusive and still promotes copyright law's goals. For example, original graffiti should not fall within the framework if it does not harm an individual, as it promotes the progress of knowledge.

One significant challenge to my framework is that, once a court finds that a work harms another individual, that work will not be protected even if it undoubtedly promotes knowledge. Imagine, for example, that the

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<sup>211</sup> A similar provision exists in some states in relation to tangible property. *See, e.g.*, Texas "Son of Sam" statute (TEX. CRIM. PROC. CODE ANN. § 59.06(k)(2) (Vernon Supp. 2002)), which covers the value of tangible goods owned by a criminal that is increased due to the notoriety of the criminal; *see also* California, Cal. Civ. Code. § 2225 (2005); Cobb, *supra* note 188, at 1506-07 (analyzing Texas "Son of Sam" statute).

<sup>212</sup> *See* Cohen, *supra* note 194, at 6 (describing the underinclusiveness requirement and the possible incidental effect on speech); *United States v. O'Brien*, 391 U.S. 367, 383 (1968).

<sup>213</sup> *See, e.g.*, Kealy, *supra* note 78, at 16 (arguing that a narrowly tailored notoriety-for-profit statute should define the "defendant" to focus only on those offenders who have an obligation to compensate victims). Although broadly defining the framework to refer to any crime, regardless of the harm to an individual, could also be desired in order to prevent profitability of other undesired works that do not harm individuals, it will nevertheless be overbroad and encompass works, which are desired for society.

founder of al-Qaeda, the late, infamous Osama bin Laden, was convicted and wrote a book about the 9/11 attacks. Although most people will highly disapprove of his unlawful actions, some would nevertheless be intrigued to learn more about the attacks. This information could also be very beneficial to government agencies in their fight against terror. Thus, his book could benefit society, although it could also harm the 9/11 victims and their relatives. Alternatively, works of “convicted felons” such as Mohandas Karamchand Gandhi (“Mahatma”)<sup>214</sup> and Nelson Mandela could also benefit society.<sup>215</sup> Should copyright law de-incentivize the creation of such works?

My proposal does not suggest that such works should not exist: it would not make the creation and dissemination of such works illegal; rather, it would prevent or reduce their profitability.<sup>216</sup> The reduced profitability is not likely to pose a real bar to their production as, in such cases, the financial incentive will probably not be the sole incentive to create.<sup>217</sup>

A few more challenges arise from my proposition. For example, expropriating an illegal work could seemingly lead to the undesired outcome of increased distribution as the work will be free of charge. However, as the CVB will become the material’s registered copyright owner, deterrence from infringement lawsuits will remain. Another concern is that of the differences between state’s penal codes. Since criminal offenses differ between states, the framework will have difficulty to determine a clear set of offences. This would be resolved by forming a list of nation-wide offences that result in physical or emotional harm to an individual, without considering differences between the volumes of sanctions. Murder, rape and assault, for example, are criminal offenses in all states, while only differences in the level of sanctions exist. Therefore, types of offences should be determined and set nation-wide.

<sup>214</sup> On March 18, 1922, a British colonial court convicted Gandhi of sedition after a protest march led to violence and sentenced him to six years imprisonment. *See On This Day: Gandhi Imprisoned for Civil Disobedience*, FINDINGDULCINEA (Mar. 18, 2011, 06:00 AM), <http://www.findingdulcinea.com/news/on-this-day/March-April-08/On-this-Day--Gandhi-Imprisoned-for-Civil-Disobedience-.html>.

<sup>215</sup> In 1964, Nelson Mandela was sentenced to life in prison for sabotage. *See 1964: Nelson Mandela Jailed for Life*, BBC, [http://news.bbc.co.uk/onthisday/hi/dates/stories/june/12/newsid\\_3006000/3006437.stm](http://news.bbc.co.uk/onthisday/hi/dates/stories/june/12/newsid_3006000/3006437.stm) (last visited Jan. 15, 2014).

<sup>216</sup> It is noted that the CVB’s discretion on the distribution of illegal works is problematic, and could endanger free speech. Therefore, the CVB decisions should be public and subject to judicial review.

<sup>217</sup> There could be many different incentives to create, e.g., recompense or fame. *See Kealy, supra* note 78, at 27-28 (providing such examples of incentives to create).

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Another possible challenge is that creating works could aid in the rehabilitation of a felon, and the framework could erode that right by reducing the incentive to create. By the same token, the framework might harm falsely accused criminals by preventing them to “tell their story.” To address such concerns, the framework could be revised to include a limited profitability incentive. For example, the framework could apply only for a limited time, enabling felons to profit from their crime after a period set by the law.<sup>218</sup> In that way, after a considerable amount of time, felons could create their work, “tell their story,” and even profit from their work, while lowering profitability levels of the work.

Naturally, the proposed framework will not eliminate the profitability of all crimes nor cease the dissemination of all undesired works. But it is nonetheless an important step toward making crimes less profitable and Congress should consider enacting it.

## VII. CONCLUSION

Though copyright law should generally adopt a content-neutral approach, it should also adopt an *illegal copyright* framework to de-incentivize the creation of illegal works. An offender should not profit from harming an individual—even when “creative” work is involved.

A proper framework would strike a balance between ensuring the continued promotion of knowledge through creative works like original graffiti and correcting the injustice of profits from illegal works, like “snuff” films. Incorporating a three-fold illegal copyright framework into the Copyright Act would strike such a balance: First, the copyright of a work that is directly and substantially connected to a crime would be reallocated—or originally registered—to a CVB. Second, the CVB would be able to sue the copyright felon for any previous profits from any work that is directly and substantially connected to the crime. Third, the CVB would be able to sue the copyright felon for any profits that he or she gained through the notoriety achieved from the crime. The CVB would deposit any profits obtained from the three provisions in an escrow account, which the board would use to compensate the victim, her living relatives, and/or any victims of similar offences.

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<sup>218</sup> It could be important to keep some financial incentive to create as these works can also benefit society, and as the publication of these works is necessary to compensate victims. For example, some Son of Sam statutes permit the recovery of a percentage of the profits from the crime, after a specified period. For a list of such state statutes, see Kealy, *id.* at 27-28, n.164. I thank Ariel Porat for suggesting this important note.

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This illegal copyright framework is greatly needed to correct an injustice in the legal system. The system should not encourage criminals to create societally undesirable or harmful works, or enable them to in any way profit from their misconduct. Even if such profits are relatively rare—or even hypothetical—normatively, the law has a responsibility not to advocate such undesirable behavior. Currently, crime pays. Congress should change that as soon as possible.