Copyright law does not explicitly impose content-restrictions on the copyrightability of works. As long as a work that is original and fixed in a tangible medium of expression, it is entitled to copyright protection and eligible for registration. Although until 1979, most courts considered immoral and illegal works non copyrightable, the contemporary status of immoral and illegal, works, when examined by courts, is unclear. Thus, an author of an immoral or an illegal work can possibly redeem losses caused by infringement even though society does not necessarily benefit, and might even be harmed, by these works. This scheme does no benefit society and should be resolved. This Article examines the current and desired copyright protection of immoral and illegal works. I review elements of copyrightability while addressing content-restrictions in copyright, comparing them to other IP laws. After evaluating whether copyright law should impose content-restrictions on immoral and illegal works, and whether such impositions would be constitutional, I conclude that while immorality should not bar copyright protection, certain works that are linked to criminal activities and cause harm should not grant the felon profits. I, thus, propose a new doctrine of illegal copyright that de-incentives the creation of undesired works by eliminating profitability from copyrighted materials related to the crime and by reducing increased profitability from the associated esteem, while compensating the victim.
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 numerous times over a short period.\(^1\) Now further imagine that both murderers are caught and sentenced to life imprisonment, while the filmmaker receives a shorter imprisonment term. Not long after, one of the two convicted murderers publishes a book that describes the actual murder, and the other convicted murderer publishes an autobiography relying on his infamous reputation to increase the books’ profits. The filmmaker files multiple lawsuits against anyone who allegedly infringed his rights to the video, in addition to selling tangible items related to him, and highly profiting from both. Although...
this scenario regarding the enrichment of the convicted felons is fictional, the remainder of the elements are non-fictional.²

Should copyright, or any other law for that matter, offer legal remedies and protection for works, which not only do not necessarily benefit society, but are also capable of causing additional harm? As a broader normative matter, should the law disregard or even advocate profitability from crimes? Under current United States copyright law, immoral and/or illegal works³ are usually treated the same as other works—i.e., a work that is original and fixed in a tangible medium of expression is entitled to copyright protection and eligible for registration.⁴ However, this narrow interpretation of copyright law is relatively new. Until 1979, many, if not most, courts interpreted copyright law to provide an explicit bar for registration to immoral, illegal, fraudulent, or blasphemous works.⁵ Prior to 1979, most immoral and illegal works were


³ Many works can fall into the category of “immoral works.” To name a few, works devoted to physical harm, e.g., a racist book explaining reasons and methods to eliminate a certain ethnical group or TV series and movies such as “Jackass” that display physical injuries (JACKASSMOVIE, http://www.jackassmovie.com/#/dvd (last visited Nov. 8, 2012)); pornographic works, whether hard-core—which are legally speaking, obscene—or those deemed indecent (see, e.g., Reno v. ACLU, 521 U.S. 844 (1997); United States v. Am. Library Ass'n, 539 U.S. 194 (2003) (referencing more on differences between obscene and indecent works)); and works which in some communities will be unacceptable, e.g., song lyrics that consist solely of expletives. Works of authorship are considered illegal if their content is criminal, e.g., snuff, or that are either directly linked to harmful crimes, e.g., works that promote criminal activity or are made by a felon, e.g., a book written by the felon that gains profitability due to her infamous reputation. Although the last example is not illegal per se, I categorize it as such as it promotes an undesirable outcome of criminal profitability.

⁴ 17 U.S.C § 102(a) (“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 ...”); and 17 U.S.C § 101 (“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.”).

⁵ See infra note 51.
denied judicial remedies, while granting a valid defense to their infringers, and while holding that they are not copyrightable in the United States. Since 1979, however, the question whether copyright subsides in immoral and illegal works has become vaguer than ever before. While the Fifth and Ninth Circuits has held that all original works of authorship fixed in a tangible medium are copyrightable, whether illegal or immoral, the Second Circuit has disagreed, while the other circuits have not directly addressed this matter. Thus, the current position of copyright law toward immoral and illegal works copyrightability is uncertain. This uncertainty should be explicitly addressed by Congress or, if a case finds its way to the bench, by the Supreme Court to clarify whether immoral and illegal works are eligible for the law’s protection. To answer the substantive question at stake, I first query whether a content-neutrality approach toward immoral and illegal works is desirable and examine possible ramifications of such approach.

Whether certain types of immoral and illegal works are undesired for society and should their authors profit from their dissemination and infringement is disputable. However, even if some works are undesirable, it is unclear whether copyright law should act as a public censor for these works and whether this censorship is constitutional. For example, the Constitution empowers Congress to promote the progress of science and useful arts, namely, to enact copyright laws. On the one hand, the question can be raised does immoral and illegal works promote these constitutional goals? On the other hand, censorship-by-copyright could endanger other constitutional rights, first and foremost First Amendment rights of free speech and possibly due process rights, and, therefore, must be carefully crafted. Moreover, even if copyright law should not act as a public censor for these works, is there a more appropriate method to de-incentivize the making of such works? Finally, how will such doctrine distinguish between desirable and undesirable works?

In this Article, I analyze copyright law’s approach toward immoral and illegal content-restrictions. I review the elements of copyrightability while addressing historical content-based restrictions in copyright, comparing them to other intellectual property (“IP”) laws. After evaluating whether copyright law should impose content-restrictions on immoral and illegal works, and whether such imposition is constitutional, I conclude that immorality should not pose a bar to copyright protection. However, based on the normative

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6 Id.
7 See infra Section II.B.2.
8 Id.
9 U.S. CONST. art. I, § 8, cl. 8. This is discussed infra Section III.A.
10 See infra Section III.
justification that criminals should not profit from their crimes, I opine that certain types of illegality that harm individuals should not grant profits to the felon.11 After reviewing equitable doctrines and propositions in current literature, I propose a new doctrine of illegal copyright, which is designed to de-incentivize criminal behavior and the making of undesired works by eliminating profitability from copyrighted materials related to the crime and by reducing profitability increased by the felon’s infamous reputation. Importantly, this doctrine also takes into account victims and proposes a victim compensation element.

My proposed doctrine is threefold: First, in an illegal infringement lawsuit, courts will be limited to grant remedies to a person physically or mentally harmed as a result of the crime that is associated with the work. Second, the victim, either in person or by proxy, can sue the felon for any profits from a work that its content is directly and substantially connected to the crime against her. In addition, victims will receive any additional profits from the sale of the felon’s intangible property the value of which was increased by the crime’s notoriety. Third and finally, the victim, either in person or by proxy, can sue for the sale of tangible property the value of which was increased by the crime’s notoriety, e.g., for the sale of tangible objects related to the criminal in any way. This doctrine should be codified in penal code, as copyright law should strive to remain content-neutral.

The article proceeds as follows: Section II examines the elements of copyrightability in general and provides a brief historical overview of general content-restrictions and specific content-restrictions vis-à-vis immoral and illegal works. Section III examines whether immoral and illegal content-restrictions are constitutional. Section IV compares the censorship-by-copyright approach to other IP laws. Section V outlines the main benefits and drawbacks of content-neutrality approach toward immoral and illegal works, and evaluates whether such approach is desirable. Section VI differentiates between immoral and illegal works to argue that while immoral works should be treated as any other work, 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 doctrine 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.

II. COPYRIGHTABILITY

A. Elements of Copyright

Copyright law grants copyright protection to original works of authorship fixed in any tangible medium of expression.\(^\text{12}\) Registration, as required by the Berne Convention,\(^\text{13}\) is not a condition for copyright protection in the United States.\(^\text{14}\) Copyright inheres in authorship and exists whether or not it is registered.\(^\text{15}\)

\(^{12}\) See supra note 4. Works of authorship include literary, musical, dramatic, pantomimes, choreographic, pictorial, graphic, sculptural, motion pictures, audiovisual, and architectural works, as well as sound recordings (17 U.S.C § 102(a)). Ideas, procedures, processes, systems, method of operations, concepts, principles and discoveries are not protected (17 U.S.C § 102(b)).

\(^{13}\) 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) (“[T]he 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.”).

\(^{14}\) 17 U.S.C § 408(a). Registration in the United States is codified in 17 U.S.C. §§ 408-412. After reviewing the application to register a copyright, if eligible for copyright protection, the Copyright Office grants registration which could be used as a presumptive evidence that the copyright is valid (17 U.S.C. § 410(c)) and recover statutory damages and attorney’s fees in such an action. However, registration is not required for civil or criminal cases involving foreign works, as 17 U.S.C § 411 only applies to a “United States work.” See DEP’T OF JUSTICE, PROSECUTING INTELLECTUAL PROPERTY CRIMES 22 (2006), available at http://www.justice.gov/criminal/cybercrime/docs/ipma2006.pdf. The exception 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). Preregistration in the United States is codified in 17 U.S.C. § 408(f). United States copyright office defines preregistration as “[A] service intended for works that have had a history of prerelease infringement. It focuses on the infringement of movies, recorded music, and other copyrighted materials before copyright owners have had the opportunity to market fully their products.” To apply for preregistration, the work must be either a motion picture, a sound recording, a musical composition, a literary works being prepared for publication in book form, a computer program (including videogames), or an advertising/marketing photograph. In addition, the work must be unpublished and in the process of being prepared for commercial distribution (in either physical or digital format, e.g., film copies, CDs, or computer programs to be sold online). See PREREＧESTER YOUR WORK, UNITED STATES COPYRIGHT OFFICE, http://www.copyright.gov/prereg (last visited Nov. 8, 2012). Preregistration was created in response to the increase in pre-release infringement, in order to provide right holders a basis for a civil infringement action. Albeit, it does not enjoy all of the same legal protections as registered works. 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).

However, copyright registration is necessary in order to accrue certain rights and benefits.\textsuperscript{16}

After filing an application for copyright registration,\textsuperscript{17} the Register of Copyrights reviews it and determines whether the material deposited constitutes copyrightable subject matter.\textsuperscript{18} When eligible for copyright protection, the Register grants registration and issues a certificate of registration to the applicant that can be used as presumptive evidence of a valid copyright.\textsuperscript{19} However, the Register can refuse registration if the material deposited does not constitute copyrightable subject matter or that the claim is “invalid for any other reason.”\textsuperscript{20} Under current instructions of the Copyright Office, the refusal of registration, when the claim is invalid for “any other reason,” does not grant authority to refuse registration based on a works’ content.\textsuperscript{21} This determination may be based on “any other information regarded by the Register of Copyrights as bearing upon the preparation or identification of the work or the existence, ownership, or duration of the copyright.”\textsuperscript{22} The Copyright Office examines whether the material falls within the subject matter of copyright and whether it represents an original work of authorship, i.e., that there is an appreciable amount of creative authorship in order to justify registration.\textsuperscript{23}

\textsuperscript{16} For example, in a civil action, registration or preregistration of a domestic work is a necessary requirement in order to sue for copyright infringement of a domestic work and to claim attorney’s fees and statutory damages. See Erin Hogan, \textit{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.”).

\textsuperscript{17} 17 U.S.C. § 109.

\textsuperscript{18} 17 U.S.C. § 410(a).

\textsuperscript{19} 17 U.S.C. § 410.

\textsuperscript{20} 17 U.S.C. § 410(b).

\textsuperscript{21} 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 (Matthew Bender rev. 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.”).

\textsuperscript{22} 17 U.S.C. § 409(10); Nimmer, supra note 21, § 7.21.

\textsuperscript{23} The copyright examiner is mainly guided by the Code of Federal Regulations (37 C.F.R. § 202), a manual of examining practices entitled the \textit{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
Thus, with the exception that works of authorship must be original, a narrow interpretation of copyright law suggests that copyrightability is content-neutral. As long as the work is original and fixed in a tangible medium of expression, it is copyrightable, and if registered—enforceable—even if the work is deemed immoral or illegal.\textsuperscript{24} In addition, the nature of a work does not affect the rights or defenses that the Copyright Act provides. For example, an immoral or illegal parody could be considered fair use,\textsuperscript{25} as long as it complies with Copyright’s Act requirements.\textsuperscript{26} As immoral and illegal works are copyrightable, copyright law does not explicitly grant infringers of such works a defense on these grounds.\textsuperscript{27} However, a broader interpretation of the law, applied by various courts in the past, suggests that it was not always content-neutral.\textsuperscript{28} Thus, content-neutrality in copyright is still questionable and should be further analyzed. Before I turn to evaluate whether a content-neutrality approach to copyright is justified and desirable, I examine copyright law’s historical and current doctrines regarding content-restrictions, so as to acquire a better understanding of the current practice in copyright law.

\textsuperscript{24} See Belcher v. Tarbox, 486 F.2d 1087 (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, Case No. 11-3190, 2012 WL 3124826 (7th Cir. 2012) (stating that “the prevailing view is that even illegality is not a bar to copyrightability.”).

\textsuperscript{25} 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.

\textsuperscript{26} See, e.g., Pillsbury Company v. Milky Way Products, Incorporated, 215 U.S.P.Q (BNA) 124 (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.”).

\textsuperscript{27} 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).

\textsuperscript{28} This interpretation of copyright law is discussed \textit{infra} Part II.B.2.
B. A Brief History of Content-Restrictions in Copyright Law

1. General Content-Restrictions

Yet, even considering my comments above, copyright law is hardly content-neutral.\(^{29}\) A closer examination of the scope of creativity and originality requirement reveals that in order to register a work it must meet a certain level of originality, which necessitates independent creation plus a modicum of creativity.\(^{30}\) Thus, the requirement of originality (with its element of creativity) places a content-restriction on copyrightability. Another example of content-restriction is that a creative work containing infringing materials is also not copyrightable.\(^{31}\) Thus, in order for a work to be copyrightable, its content must be examined, to some extent, in order to be eligible for protection.

Moving beyond the requirement of originality, since the enactment of the first copyright statute in 1790 Congress has imposed only two implied statutory content-based restrictions on copyrightability:\(^{32}\) First, in 1870, when Congress placed statutory content-based restriction on the copyrightability of engravings, cuts and prints and applying them only to pictorial illustrations or works connected with the fine arts.\(^{33}\) However, the famous Supreme Court decision Bleistein v. Donaldson Lithograph Co. narrowed its scope,\(^{34}\) and this provision was repealed and resulted in Congress omitting the entire section from the Copyright Act of 1909.\(^{35}\) Second, as interpreted by courts, Congress

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\(^{31}\) Bartow, supra note 29, at 22 (citing, as an 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 (17 U.S.C. § 107).

\(^{32}\) Act of May 31, 1790, 1st Cong., 2d Sess., 1 stat. 124.

\(^{33}\) Act of June 18, 1874, ch. 301, § 3, 18 Stat. 78, 79; Mitchell Bros. Film Grp. v. Cinema Adult Theater, 604 F.2d 852, at n.4 (5th Cir. 1979) (summarizing the history of content-restrictions in United States copyright legislation).

\(^{34}\) See Bleistein v. Donaldson Lithograph Co., 188 U.S. 239, 23 S.Ct. 298, 47 L.Ed. 460 (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.").

placed a moral limitation on the public performance right for dramatic compositions only for performances “designed or suited” for public representation.\(^{36}\) However, this content-based restriction was later removed from legislation.\(^{37}\) By deliberately omitting content-based restrictions in the past, it seems that Congress attempt to design a content-neutral copyright law is an intentional policy.\(^{38}\) Nevertheless, as history reveals, many courts have not reached this interpretation of Congress’ intent; rather, they interpreted the Copyright Act to provide immoral and illegal content-restrictions.

2. **Immoral and Illegal Content-Restrictions**

As a matter of official copyright registration policy, both immoral and illegal materials were not copyrightable and, hence, not registrable for a long period.\(^{39}\) The Copyright Office can refuse registration if it was brought to the examiner’s attention that the material tends to disturb the public peace, corrupt morals, or libel individuals; and that it is a publication of a seditious, blasphemous, immoral or libelous production is a violation of law. 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 the question as to whether or not the material is copyrightable and hence registrable… Registration of such material [which disturb the public peace, corrupt morals, or libel individuals; and that the publication of a seditious, blasphemous, immoral or libelous production is a violation of law], when its nature is brought to the attention of the examiner in the Copyright Office, is refused.\(^{40}\)

Not only were immoral and illegal materials not copyrightable under the pre-1976 legislation, the Copyright Office further suggested that Congress

\(^{37}\) Patent Act of 1870, Ch. 230, 16 Stat. 198-217 (July 8, 1870). I discuss this further in the next section.
\(^{38}\) See *Mitchell Bros. Film Grp.*, 604 F.2d at 854 (“[T]he 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.”).
\(^{39}\) Examining the reasons behind the rapid change in registration policy is beyond the scope of this research and should be further examined.
criminalize any attempt to register obscene, seditious, or blasphemous material as a misdemeanor, carrying a fine, imprisonment, or both.\textsuperscript{41}

However, even if the Register was permitted to refuse registration on moral grounds—it was never obliged to. This was made clear in the Attorney General’s 1959 decision following a requested opinion by the Librarian of Congress.\textsuperscript{42} In response, the Attorney General stated that the Register is free to deny registration of obscene works, not without stating that defining obscene would involve “substantial problems.”\textsuperscript{43} Narrowly interpreting the Attorney General’s instructions, the Register continued the practice of limiting the examination to statutory formalities without moral considerations.\textsuperscript{44}

Official policy, rather than just practice, changed when the Register of Copyrights reversed the 1941 Copyright Office official policy and instructed that copyrightability examination be limited to statutory formalities without examining literary or artistic merits from the viewpoint of obscenity or immorality of the material itself.\textsuperscript{45}

Court’s perspective on immoral and illegal materials did not always align with the official Copyright Office policy, and the history of court’s decisions on these matters reveals that until 1979, immoral and illegal works were considered non-copyrightable. In the 19th century, immorality and illegality were an explicit cause to bar registration. In 1856, when Congress introduced a public performance right for a dramatic composition to copyright law, the new right was limited to public performances that were “designed or

\textsuperscript{41} Id. at 30 (“[I]t 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.”).


\textsuperscript{43} 41 Ops. Att'y Gen. No. 73 (May 8, 1959) (“[T]he 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 42 at 654 (describing the 1959 Attorney General’s opinion on the issue of obscenity in copyright registration).

\textsuperscript{44} Derenberg, supra note 42, at 654 (describing the Register continuance 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).

\textsuperscript{45} 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 (1975) (describing the registration policy history of the Copyright Office and referring to “Letter from the U.S. Copyright Office to author, January 25, 1974”).
suitable” for public representation.\textsuperscript{46} Interpreting the meaning of “suitable,” the California’s Federal Circuit Court held that to be suitable to public representation a work must be morally fit to be represented,\textsuperscript{47} i.e., interpreting the law to place a moral restriction on copyrightability.\textsuperscript{48} However, the term “suitable” was later omitted from the 1870 legislation leaving the public performance right for dramatic compositions without any content-based restrictions.\textsuperscript{49} Nevertheless, even after the 1870s amendment, and despite the lack of a statutory restriction, copyrightability was still uncertain for immoral, illegal, fraudulent, or blasphemous works.\textsuperscript{50} More accurately, beginning with the 19th century and ending in 1979, most immoral and illegal works were denied judicial remedies holding that the works were not copyrightable in the United States,\textsuperscript{51} with infringers benefitting from a valid defense.\textsuperscript{52}

\textsuperscript{46} Act of August 18, 1856, 34th Cong., 1st Sess., 11 Stat. 138. At the time, the public performance right was limited to “dramatic works,” and was expended to musical compositions in 1897 (Act of January 6, 1897, 44th Cong., 2d Sess., 29 Stat. 481). For a general review of the public performance right, see, e.g., Matthew S. DelNero, \textit{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).

\textsuperscript{47} See Martinetti v. Maguire, 16 Fed.Cas. 920, 922 (No. 9173) (C.C. Cal. 1867).

\textsuperscript{48} 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 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).

\textsuperscript{49} Act of July 8, 1870, Ch. 230, § 101, 16 Stat. 198, 214 (July 8, 1870).


\textsuperscript{51} \textit{Martinetti}, 16 Fed.Cas. (holding that a dramatic composition, which is grossly indecent and calculated to corrupt the morals of people, is not copyrightable); \textit{Shook v. Daly}, 49 How. Pr. 366 (N.Y. Sup. Ct. 1875) (refusing to grant injunctive relief for an immoral play’s “piracy”); \textit{Richardson v. Miller}, 20 F. Cas. 722 (No. 11791) (C.C. Mass. 1877) (stating that immoral works are not copyrightable); \textit{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 a copyright by virtue of an indecise and vulgar word in the lyrics); \textit{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, does not promote the progress of science and useful arts); \textit{Hoffman v. le Traunih}, 209 F. 375 (1913) (stating that “to be entitled to be copyrighted, the composition must be original, meritorious, and free from illegality or immorality.”); \textit{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); \textit{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); \textit{Eaton S. Drone, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS} 185 (1879) (“[T]he protection of the law will not be extended to a publication which is obscene, or has a positive immoral tendency.”).

\textsuperscript{52} More specifically, the defense of obscenity in a copyright infringement suit originated
In 1979, the Court of Appeals for the Fifth Circuit took a different approach. In *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, the court of appeals reversed the district court ruling and held that registered copyright on a motion picture titled “Behind the Green Door,” whether obscene or not, is copyrightable, and its infringement is enforceable. This decision, governed by the 1909 Copyright Act, marked a possible turn in copyright's perception regarding the copyrightability of immoral and illegal works. Under *Mitchell Bros.*, copyright was no longer concerned with the nature of a work, unless explicitly addressed by Congress in the Act, which was left intact in the 1976 reform. Moreover, during the Congressional discussions of what later became the 1976 Act, the House Judiciary Committee stated that it has no intention to enlarge the standard of copyright protection to require any requirements of novelty, ingenuity, or aesthetic merit, meaning that the Copyright Act deliberately avoided content-restrictions on copyrightability.

The *Mitchell Bros.* approach was followed by *Jartech, Inc. v. Clancy*. In a 1982 opinion under the 1976 Act, the Ninth Circuit held that obscenity, a matter usually considered both immoral and illegal, is not a defense to

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53 *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979) (the Mitchell Brothers Film Group was granted by Jartech, Inc., 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 the Cinema Adult Theater that screened an unlawful copy of the film in his theater without permission while seeking both injunctive relief and damages).


55 *Mitchell Bros. Film Grp.*, 604 F.2d.


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

58 See H.R. Rep No. 1476, 94th Cong., 2d Sess. 51 (1976); *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.”).

59 Obscene matters can many times be deemed both immoral and illegal. See, e.g., 18 U.S.C § 1460 (prohibits possession with intent to sell, and sale, of obscene matter on Federal property); 18 U.S.C § 1461 (prohibits mailing obscene or crime-inciting matter); 18 U.S.C § 1462 (prohibits importation or transportation of obscene matters); 18 U.S.C § 1463 (prohibits
copyright infringement. Since then, the Fifth and Ninth Circuits maintain their view on this matter—which seems to prevail in other circuits as well. However, in 1998, the New York Southern District Court rejected and criticized the Fifth and Ninth Circuits’ approach. In Devil Films, Inc. v. Nectar Video, the court stated that:

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.

As this ruling only addressed an application for preliminary relief, the court did not decide whether obscenity was a valid defense. 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.” In another case, the district court repeated this view.

To conclude, immorality and illegality are no longer a bar to registration in the United States. Although courts considered copyright in the

mailing indecent matter on wrappers or envelopes); 18 U.S.C § 1464, Broadcasting obscene language (prohibits the uttering of any obscene, indecent, or profane language by means of radio communication); 18 U.S.C § 1465 (prohibits the production and transportation of obscene matters for sale or distribution); 18 U.S.C § 1466 (prohibits engaging in the business of selling or transferring obscene matter); 18 U.S.C § 1466A (prohibits obscene visual representations of the sexual abuse of children); 18 U.S.C § 1467 (proscribes criminal forfeiture of obscene material); 18 U.S.C § 1468 (prohibits distributing obscene material by cable or subscription television).

See Jartech, Inc. v. Clancy, 666 F.2d 403 (9th Cir. 1982) (discussing the obscene nature of adult movies in a copyright infringement case).

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, Case No. 11-3190, 2012 WL 3124826 (7th Cir. Aug. 2, 2012).


Id. at 176.

Id. at 176-77.

Next Phase Distrib., Inc. v. Does 1-27, 2012 U.S. Dist. LEXIS 107648 (S.D.N.Y. July 31, 2012) (“the Court recognizes that, if the Motion Picture is considered obscene, it may not be eligible for copyright protection.”); But see Nova Prods. v. Kisma Video, Inc., 2004 U.S. Dist. LEXIS 24171 (S.D.N.Y. Nov. 30, 2004) (“even 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.”).

See Belcher v. Tarbox, 486 F.2d 1087, 1088 (CA9, 1973) (stating that “[T]here is nothing
past to be secondary to the public’s right to moral protection,\(^67\) it does not seem to be the current Copyright Office view. However, it is still unclear whether courts find immoral and illegal works copyrightable. If at first, immoral and illegal works were considered by many courts as non-copyrightable, under the current Copyright Act it is unclear how courts will rule on this matter. Various circuits have reached different results or have never directly addressed this matter,\(^68\) lacking a much-needed Supreme Court or Congressional clarification in this matter. Although currently, federal appellate courts view copyright as content-neutral, district courts views are uncertain and can vary in different circuits.\(^69\) In order to evaluate whether copyright law should protect immoral and illegal works, I discuss normative justifications for content-restrictions and its constitutionality.

III. CONTENT-RESTRICTIONS CONSTITUTIONALITY

A. Copyright Constitutional Purposes

The Copyright and Patent Clause in the Constitution empowers Congress “To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”\(^70\) Presumably, the constitutional purpose is to allow all creative
works to be accorded copyright protection regardless of their content, trusting
the public’s taste to reward creators for useful works and to deny creators of
useless works, any reward.\footnote{Mitchell Bros. Film Grp. v. Cinema Adult Theater, 604 F.2d 852, 855 (5th Cir. 1979).}

Therefore, Congress is empowered by the Constitution to enact
copyright law only as a means to promote the progress of science and useful
arts.\footnote{See Martinetti v. Maguire, 16 Fed. Cas. 920, 922 (No. 9173) (C.C. Cal. 1867) (“it expressly appears that congress is not empowered by the constitution 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.”).} Thus, the question is whether immoral or illegal works promote the
progress of science and useful arts.\footnote{However, justifying the exclusion of immoral or obscene works from copyright protection
on an interpretation of the Copyright and Patent Clause of the Constitution, providing that they are not promoting progress, was criticized by Jennifer Rothman. Rothman argues that the language of the 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 50, at 155.} However, this 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, then can the
progress of knowledge really be promoted?\footnote{See, e.g., Bartow, supra note 29, 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).} On the other hand, 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. Moreover, every work can possibly promote some knowledge, e.g., to
specialists in the field.\footnote{See, e.g., Sean J. Kelly, 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.”).} Thus, under this argument, all works are 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.\footnote{Mitchell Bros. Film Grp., 604 F.2d.} Thus, under the Fifth Circuit ruling, constitutionally, immoral and illegal works should be
equally copyrightable as compared to other works. However, only few circuits have embraced this view; other circuits have either not decided on this matter or have disagreed with Mitchell Bros. Until Congress or the Supreme Court clarify the exact meaning of the constitutional clause regarding content restrictions, this subject matter will remain in controversy.

B. Freedom of Speech

The First Amendment states that “Congress shall make no law … abridging the freedom of speech.” Thus, imposing content-restrictions on copyrightability could endanger freedom of speech, and hence, be unconstitutional. With that, there are exceptions to the First Amendment’s protection. For example, defamation, incitement, obscenity, and child pornography are not protected speech. Any other content speech-restriction will be examined by court to

77 Ronald L. Green, The Obscenity Defense to Copyright Revisited, 69 KY. L.J. 161, 174-75 (1980) (“in a modern context, the Constitution poses no bar to the granting of copyright protection to the obscene or immoral work.”).

78 Christopher Thomas McDavid argues that Congress should revise section 102(a) of the Copyright Act, to state that “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, 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.” See McDavid, supra note 69, at 582.

80 In order to evaluate whether the conduct falls within the core notion of commercial speech, it must withhold a combination of four characteristics: The speech does no more than propose a commercial transaction; it may be characterized as advertisements; it references a specific product; and its disseminator is economically motivated to distribute the speech. See Bolger v. Youngs Drug Products, 463 U.S. 60 (1983). Although some works will fall into the categorization of commercial speech, e.g., advertisements, numbering systems, contracts and commercial labels, most works will not. 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).

determine whether it is a content-neutral or a content-based regulation. Regulation of neutral content-restriction only needs to meet an intermediate standard of scrutiny. However, content-based restrictions on copyrightability that endanger freedom of speech are subject to the courts strict scrutiny. Thus, if Congress were to impose copyright restrictions based on the content of the works, these restrictions must be narrowly tailored to serve a compelling state interest and be the least restrictive means available to further the articulated interest.

Examining the constitutionality of moral-based restrictions to content in copyright under the First Amendment could lead to a problematic outcome. If the restriction on copyrightability is content-based, the regulation is presumptively invalid since it will unlikely pass strict scrutiny. In addition, (1982) (recognizing that “laws directed at the dissemination of child pornography” are not protected by the First Amendment, regardless of whether they are obscene or not); Bartow, supra note 29, at 20 (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.”).

82 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).


84 See, e.g., Sable Commc’ns v. FCC, 492 U.S. 115, 126 (1989) (holding that content-restrictions must promote a compelling government interest and that it must be 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) (arguing that First Amendment doctrine requires that any content-based speech regulation is subject to strict scrutiny by the courts). 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).

85 See, e.g., Sable Commc’ns, 492 U.S. 115, 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.”); Reno v. ACLU, 521 U.S. 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); Ashcroft v. ACLU, 542 U.S. 656 (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.”).
although the case was based upon different circumstances, the Supreme Court in *Lawrence v. Texas*\(^{87}\) held that moral disapproval could not be the sole asserted state interest for the law.\(^{88}\) On the one hand, under moral considerations, there must be an additional state interest in order to suppress free speech. On the other hand, constitutionality of illegal-based restrictions to content in copyright law under the First Amendment is irrelevant in some cases that are not protected by free speech. Therefore, when the work in itself is not considered protected speech under the First Amendment—e.g., obscene material—its restriction is allowed under free speech jurisprudence.

Imposing a general content-based restriction on copyrighted works on grounds of immorality or illegality will be an almost impossible task, constitutionally speaking. However, a limited permitted restriction upon the content of speech could be possible, as I further discuss.\(^{89}\)

**C. Due Process**

The Fifth Amendment of the Constitution states that “nor shall any person ... be deprived of life, liberty, or property, without due process of law.”\(^{90}\) For this matter, if a law consists of content-restrictions of immoral and illegal works, it should be sufficiently precise for the law to not be considered vague,\(^{91}\) while this precision will likely require a higher level when it comes to works that endanger free speech.\(^{92}\) Thus, regarding immoral works, the law should define

\(^{87}\) *Lawrence v. Texas*, 539 U.S. 558 (2003) (holding that Texas sodomy law banning “deviate sexual intercourse” between consenting adults of the same sex, but not between consenting adults of different sexes, is unconstitutional).

\(^{88}\) *Id.* at 585 (“[A] law branding one class of persons as criminal based solely on the State’s moral disapproval of that class and the conduct associated with that class runs contrary to the values of the Constitution and the Equal Protection Clause, under any standard of review.”); Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(A) Trademark Law after Lawrence v. Texas*, 2 MARQ. INT’L. PROP. LAW REV. 187, 248 (2005) (arguing that “abstract morality standing alone does not serve as a constitutionally adequate rational basis to enact legislation.”).

\(^{89}\) See [*infra* Section VI.B.2.]

\(^{90}\) U.S. CONST. amend. V. Due process also appears in the Fourteenth Amendment to the Constitution.

\(^{91}\) See, e.g., *Grayned v. City of Rockford*, 408 U.S. 104, 108 (1972) (“[I]t 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, 77 S.Ct. 1304, 1312, 1 L.Ed.2d 1498 (1957) (“[T]he 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 ...”).

\(^{92}\) *Smith v. Goguen*, 415 U.S. 566, 573 (1974) (holding that when a statute's literal scope is
moral standards, a nearly impossible task for an ever-changing standard such as morality.\(^93\) Illegal works, however, are easier to define, e.g., as every act prohibited by the Penal law, and will unlikely be void for vagueness.

Accordingly, from a constitutional aspect, imposing general content-based restrictions in copyright is problematic and will not be achieved easily. However, content-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, although highly unlikely, pass the constitutional challenge.\(^94\)

IV. **Content-Restrictions in Intellectual Property**

In order to evaluate justifications for maintaining copyright law as content-neutral as possible, a further examination of other fields of IP namely, trademark and patent law, is required. This analysis indicates that trademark law differs from patent and copyright laws' general approach to immorality and illegality: Both patent and copyright materials can receive protection upon meeting general standards, while trademark law prohibits registration of immoral, disparaging, or scandalous marks. However, the differences between patent and copyright law versus trademark law could justify the different approach toward moral and illegal content-based restrictions.

A. **Trademark Law**

Trademark law is currently not content-neutral.\(^95\) In 1905, Congress enacted a content-based restriction to trademark registration for “immoral or scandalous” marks.\(^96\) A similar and slightly broader provision\(^97\) reappeared in 1946, when capable of reaching expression sheltered by void for vagueness, free speech “demands a greater degree of specificity than in other contexts.”); Gibbons, *supra* note 88, at 236 (applying “void for vagueness” on trademarks as interpreted in *Smith v. Goguen*).

\(^93\) See infra V.A discussing the difficulties of morality standards.

\(^94\) See infra VI.B.2 elaborating on possible content-restrictions.

\(^95\) For a thorough analysis of trademark law and content-neutrality, see Sonya Katyal, *Trademark Intersectioality*, 57 UCLA L. REV. 1601 (2010).

\(^96\) Trademark Act of 1905, Pub. L. No. 489, 33 Stat. 724 (1905) (“no 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.” id. §5(a)). For a definition of what constitutes as a trademark, see 15 U.S.C. § 1127.

\(^97\) 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
Congress codified Federal trademark law with the passage of the Lanham Act. 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 …”

Thus, trademark law, both at the federal level as well as in most states, prohibits registration of immoral, disparaging, or scandalous marks. The composition of immoral, disparaging, or scandalous marks differs from case to case. However, past decisions on this matter suggests that non-registrable marks usually contained a reference to drugs, sex, religion, race, or scatological imagery. When determining whether a mark constitutes a “immoral, deceptive, or scandalous” mark, it is considered within the context of the marketplace, as applied to registry. With that, earlier decisions regarding registration of similar marks are insufficient to warrant the same finding in other cases. In the past, courts have applied the Registry's...
imposition of content-based restrictions on trademarks for immoral, deceptive, or scandalous marks.\textsuperscript{104}

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.\textsuperscript{105} However, in comparison to copyright, trademarks are a form of commercial speech,\textsuperscript{106} which has different characteristics from non-commercial speech. In order to assess whether commercial speech is an unwarranted violation of the First Amendment, the Supreme Court instituted a four-step analysis:\textsuperscript{107} First, the activity must be lawful and not be misleading; second, the asserted government interest must be substantial; third, the regulation must directly advance the governmental interest asserted; fourth, regulation cannot be more extensive than is necessary

\textsuperscript{104} See, e.g., \textit{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); \textit{In re Rundsfeld}, 171 U.S.P.Q. 443 (T.T.A.B. 1971) (holding that “BUBBY TRAP” brassieres are scandalous); \textit{In re McGinley}, 660 F.2d 481 (refusing to register a “[N]ewsletter Devoted to Social 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 (P.T.O 1999) (ordering the cancellation of seven registered trademarks of the National Football League’s Redskins, holding it to be pejorative and offensive). However, the District Court for the District of Columbia later reversed this decision under the doctrine of \textit{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)); \textit{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 or comprise scandalous matter).

\textsuperscript{105} See \textit{In re} McGinley, 660 F.2d 481, 484-85 (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, \textit{Renaming the Redskins (and the “Florida State Seminoles?”): The Trademark Registration Decision and Alternative Remedies}, 27 FLA. ST. U.L. REV. 287, 287 (1999).

\textsuperscript{106} See Friedman v. Rogers, 440 U.S. 1, 11 (1979) (holding that trade names are commercial speech). However, First Amendment protections did not apply to commercial speech until a Supreme Court decision in 1976 (see Virginia State Bd. of Pharmacy v. Virginia Citizens Consumers Council, Inc. 425 U.S. 748 (1976)). Thus, as content-restrictions to 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, \textit{supra} note 97, at 36.

to serve that interest.\textsuperscript{108} The term “scandalous,” was held as sufficiently precise to satisfy due process requirements under the Fifth Amendment.\textsuperscript{109} Even without registration, an immoral, deceptive, or scandalous mark can be used by any company, but nevertheless, will be denied federal protection upon its unauthorized use.\textsuperscript{110}

Hence, it is important to identify the factors that differentiate between trademarks and copyright, in order to evaluate the reason copyright does not explicitly include moral and illegal content-restrictions. Although copyright and trademark are both types of IP, they possess fundamental differences.\textsuperscript{111} 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.\textsuperscript{112} Trademarks have characteristics of private goods, whereas copyright has characteristics of public goods;\textsuperscript{113} unlike copyright, trademark law is not concerned with the dissemination of knowledge and does not enrich the public domain;\textsuperscript{114} and trademarks are concerned with the marketplace of goods while copyright mainly concerns with the marketplace of ideas.\textsuperscript{115}

\begin{footnotesize}

\textsuperscript{108} Id.
\textsuperscript{109} See In re McGinley, 660 F.2d 481, 484-85; TMEP § 1203.01(8th ed. 2010).
\textsuperscript{110} See Bartow, supra note 29, at 59 (“marks 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.”).
\textsuperscript{111} See, e.g., David W. Barnes, A New Economics of Trademarks, 5 NW. J. TECH. & INTELL. 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 95, at 1613 (arguing that trademarks are part of a separate framework than copyrighted and patent goods and concentrates on commerce rather than communication).
\textsuperscript{112} 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.”).
\textsuperscript{113} 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, 6 (2007) (describing trademarks as mixed public goods); Glynn S. Lunney, Jr., Trademark Monopolies, 48 EMORY L.J. 367, 463 (1999) (arguing that unlike a private good, using a trademark does not physically precludes another); Katyal, supra note 95, at 1618 (arguing that currently trademarks take on characteristics that resemble both public and private goods.).
\textsuperscript{114} Katyal, supra note 95, at 1615 (analyzing the distinctions between trademarks and copyrights).
\textsuperscript{115} But see id. at 1617 (arguing that trademark law has been broadened to encompass other expressive uses within the marketplace of ideas).
\end{footnotesize}
In addition, in order to impose content-restrictions, both in trademark and copyright laws, the law must be held to not constitutionally abridge freedom of speech, whether it is commercial or not. Analogous to trademark courts rulings on refusal to register, the refusal to register a mark was held constitutional as long as it did not affect the right to use it as no conduct is proscribed and no tangible form of expression is suppressed. Applying this test to a works’ copyrightability leads to the conclusion that denying registration of copyright works, on any grounds, is constitutional because denial of registration 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.

Variances between copyright and trademark law could possibly justify their different approaches toward immoral and illegal content-restrictions. However, it is not an easy task to evaluate justifications to content-restrictions in trademark law as there is little evidence of Congress intent in their enactment. According to one approach, the main reason for the trademark law approach was to avoid governmental approval of such immoral mark. Another possible reason is that of public policy, to discourage the usage of mark which falls within the categories of the statute, e.g., on immoral

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116 See In re McGinley, 660 F.2d 481 (C.C.P.A. 1981) (“[W]ith 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.”).


118 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).

119 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.”). See In re Old Glory Condom Corp., 26 U.S.P.Q.2d (BNA) 1216, 1220 n.3 (Trademark Trial and Appeal Board 1993). Yet, as the Trademark Trial and Appeal Board did not provide any other justification, and moreover, the fact that denial of registration does not prevent the usage of a mark are strengthening the assumption that the government wishes to avoid a “stamp of approval” of such 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)).
grounds. If these are truly the justifications for trademark law content-
restrictions, they could also be applied in copyright law as well because the
fundamental differences do not affect them. However, the fact that Congress
explicitly imposed a moral-based restriction in trademark law and abstained to
act in a similar way in copyright law, further strengthens the conclusion that
copyright law is presumably content-neutral due to an intentional
congressional decision.

Even if trademark law currently possesses content-restrictions on moral
grounds, it does not justify implementing such a doctrine. Furthermore, as it
is not necessarily needed, the current existence of content-restrictions does not
imply that trademark law will remain as such. Economic considerations by
itself could control the use of offensive marks and the user would most likely
suffer from revenue-losses as many people would rather avoid purchasing
the product or services it marks. Hence, the fact that trademark law imposes
content-restrictions on registration does not necessarily imply that copyright
law should act accordingly.

B. Patent Law

Patent law is governed by Article I, Section 8 of the United States Constitution,
empowering Congress to legislate a patent act ”[t]o promote the Progress
of Science and useful Arts.” Patent law requires, inter alia, a utility
standard, meaning that inventions must prove to be “useful” before the Patent

120 See Pace, supra note 97, 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)).
121 Green, supra note 77, 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).
122 For criticism on trademarks 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
123 Pace, supra note 97, at 9 (arguing that it would be economically unwise for a company to
use an offensive trademark).
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).
125 U.S. CONST. art. I, § 8, cl. 8.
and Trademark Office issue a patent.\textsuperscript{127} The insertion of this requirement is clearly a content-restriction,\textsuperscript{128} but the nature of “useful” is subject to court’s interpretation and could change over time. In 1817, Justice Joseph Story defined “useful” as a negative averment, holding that for an invention to be “useful” in sense of patent law;\textsuperscript{129} it cannot be “frivolous or injurious to the well-being, good policy, or sound morals of society.”\textsuperscript{130} Thus, the court linked the test of usefulness to mischievous or immoral inventions. To exemplify this issue the court noted that inventions designed to poison people, promote debauchery, or facilitate private assassination are not patentable inventions.\textsuperscript{131}

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\textsuperscript{132} and was invoked in many cases for over 150 years.\textsuperscript{133} In recent


\textsuperscript{128} See Mitchell Bros. Film Grp. v. Cinema Adult Theater, 604 F.2d 852, 855 (5th Cir. 1979) (noting that a content-related restriction in patents is that inventions must be shown to be “useful” before a patent is issued).

\textsuperscript{129} Subjected, at that time, to the Patent Act of 1973, ch. 11, 1 Stat. 318 (February 21, 1973), which uses the phrase “useful invention” as an action on the case for the infringement of a patent-right.

\textsuperscript{130} See Lowell v. Lewis, 15 F. Cas. 1018, 1019 (C.C.D. Mass. 1817) (No. 8,568) (the court noted 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.”). \textit{See also} Bedford v. Hunt, 3 F. Cas. 37, 137 (C.C. Mass. 1817) (No. 1217) (limiting the definition of “useful” to an invention that is capable of use not prohibited by sound morals or policy); Eric P. Mirabel, \textit{Practical Utility is a Useless Concept}, 36 AM. U. L. REV. 811, 812-13 (1987) (noting that the two early decisions on what constitutes as “useful” defined it as a negative rather than as a positive averment).

\textsuperscript{131} 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 (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).

\textsuperscript{132} See Bagley, \textit{supra} note 127, at 488-93 (describing the “moral utility” doctrine history).

\textsuperscript{133} For example, the utility requirement was employed by courts to invalidate inventions used to defraud buyers and gambling devices patents that were held immoral. \textit{See, e.g., In re Corbin}, 6 F. Cas. 538, 542 (C.C.D.C. 1857) (No. 3,224) (upholding grant of patent on artificial honey); Klein v. Russell, 86 U.S. (19 Wall.) 433, 468 (1873) (affirming trial court instruction that if the process patented cannot be made useful for any honest purpose than the invention is
years, however, courts have abandoned this doctrine, 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. Hence, immorality is no longer considered a restriction in United States patent law. 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-restriction is set at a very low bar, as an “illegal” patent, which could also be used legally, is registrable. Thus, patent and copyright law seem to be aligned with the general conception of immorality and illegality, both been eligible for protection upon meeting basic general standards. Whether the copyright and patent law approaches toward content-neutrality are desirable requires further evaluation.

V. Evaluating Content-Neutrality in Copyright Law

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 due to moral standards; however, this clause is not mandatory. See Agreement on Trade-Related Aspects of Intellectual Property Rights (1994), § 5, Article 27 ("[M]embers 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.").

Juicy Whip, Inc. v. Orange Bang, Inc., 185 F.3d 1364 (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.”).

See John R. Thomas, An Examination of the Issues Surrounding Biotechnology Patenting and Its Effect Upon Entrepreneurial Companies, CRS REPORT FOR CONGRESS 19 (Congressional Research Service, Aug. 31, 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 could make usage of moral standards. See Thomas F. Cotter, Misuse, 44 Hous. L. REV. 901, 933 (2007) (arguing that the “moral utility” doctrine could retain some vitality regarding small class of inventions which would violate fundamental public policy).

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).
Whether copyright law should examine the content of a work is questionable, especially concerning immoral and illegal works.\textsuperscript{137} Works can be original enough to meet the threshold of copyright law, but at the same time, not benefit society or perhaps be even harmful. The important question of moral considerations in copyright law has received only a little attention in academic literature. Scholars who did address it, usually dealt solely with questions of pornography, sex industry, and other obscene materials.\textsuperscript{138} Hence, the copyrightability of immoral and illegal works should be further examined to determine whether copyright law should be content-neutral. In order to evaluate whether copyright protection should exist without content considerations, I outline the main benefits and drawbacks of a content-neutrality approach to copyright, and evaluate whether they apply differently to immoral and illegal works.

\textsuperscript{137} 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).

\textsuperscript{138} 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 mainly to pornographic materials, while she does not refer to the general question of immorality and illegality outside of the sex industry realm. See Bartow, supra note 29, at 37-38. For more academic literature, see, e.g., Robert C. Summers, \textit{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, \textit{Immorality, Obscenity and the Law of Copyright}, 6 S.D.L. REV. 109 (1961) (examining immorality and obscenity in copyright law); Jeremy Phillips, \textit{Copyright in Obscene Works: Some British and American Problems}, 6 ANGLO-AM. L. REV. 138 (1977) (examining the legal reasoning given by the courts when refusing to protect obscene works); Green, supra note 77 (reviewing and criticizing the obscene defense to copyright infringement in the United States); Norman A. Palumbo Jr., \textit{Obscenity and 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, \textit{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, \textit{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 69 (examining immorality and obscenity in copyright and trademarks); Rothman, supra note 50 (reviewing trademark and copyright law’s treating of sexual content); Nicole Chaney, \textit{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).
A. Content-Neutrality Benefits

Designing content-neutral copyright law could provide the following benefits. First, imposing content-based restrictions could impede the creation of certain types of authorship—i.e., due to an uncertainty whether a work will be considered copyrightable it might not made in the first place. Thus, placing content-based restrictions on copyright law might become a real burden on authors since they will have to estimate whether their work will be considered copyrightable or not and on society which will not be able to differentiate between protected and unprotected work. Hence, content-based restrictions could have a chilling effect on creations and free speech, which could result in creative losses for future generations. Moreover, as a normative matter, copyright law is not designed to bar creative—rather to incentive them. Creating content-based restrictions could stifle creation and dissemination of expression. In addition, how will the public be notified when a work is not copyrightable due to a moral examination?

Second, delineating between moral and immoral works is subjective; thus, a difficult—if not impossible—task. Immorality is an ever-changing

139 See, e.g., Schneider, supra note 45, at 719 (arguing that registration denial could discourage the development of the Arts); Mitchell Bros. Film Grp. v. Cinema Adult Theater, 604 F.2d 852, 856 (5th Cir. 1979) (arguing that “[D]enial of (copyright) Registration could work to discourage the development of the Arts.”).

140 Mitchell Bros. Film Grp., 604 F.2d 2d at 856 (arguing that a content-based restriction on the ground of obscenity could potentially discourage authors, publishers and promoters of works).

141 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.”).

142 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 not only non-obscene but even of great literary merit.”); Green, supra note 77, at 182 (arguing that in a lack of a clear line to determine what is obscene, the potential creator will “logically stay well clear of the line.”).

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

144 This of course can be solved, for example, by demanding that every creative work include a disclaimer that notes whether the work is protected by copyright.

145 See, e.g., Mitchell Bros. Film Grp., 604 F.2d at 856 (stating that “[P]otentially discouraging effect a stated policy of denial on the ground of obscenity would have on authors, publishers and promoters of works inhabiting the hazy border between obscenity and protected
standard that varies according to time, communities, and even inside communities.\textsuperscript{146} Depriving copyright protection on moral grounds could be problematic and unjust. Consider obscenity as an example. Obscenity is usually considered both immoral and illegal and is not entitled to the First Amendment protection.\textsuperscript{147} In 1973, the Supreme Court set a tripartite test for judging whether material is obscene: First, “whether the average person, applying contemporary community standards would find that the work, taken as a whole, appeals to the prurient interest”; second, “whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable ... law”; and third, “whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.”\textsuperscript{148} Hence, if an immoral work is obscene under this test it should be examined by community standards, changing the nature of United States copyright law from its national scope,\textsuperscript{149} and could result in a preemption of the state law,\textsuperscript{150} and in an abridgment of the

\footnotesize{\textsuperscript{146} See Jartech, Inc. v. Clancy, 666 F.2d 403, 406 (9th Cir. 1982) (stating that “obscenity is a community standard which may vary to the extent that controls thereof may be dropped by a state altogether.”); Mitchell Bros. Film Grp., 604 F.2d at 856-58 (stating that “[S]ociety's view of what is moral and immoral continually changes,” and that “what is obscene in one local community may be non-obscene protected speech in another.”); Rothman, supra note 50, at 122 (arguing that “immoral” is difficult to assess); Malibu Media, LLC, v. Jeff Fantalis, Bruce Dunn, and Stephen Deus (Case No. 1:12-cv-00886) in the United States District Court, District of Colorado (“[T]his [content-based] restriction would, if accepted, not only create a Constitutional problem, but a practical one – fragmenting copyright law on the basis of local community standards.”).

\footnotescript{147} Roth v. United States, 354 U.S. 476 (1957) (holding that obscenity is not within the area of constitutionally protected speech or press).

\footnotescript{148} Miller v. Cal., 413 U.S. 15, 24 (1973). In 1987, the Supreme Court held that only the first and second prongs should be decided with reference to “contemporary community standards,” while the third prong be evaluated using an objective “reasonable person” standard. See Pope v. Illinois, 481 U.S. 497, 500-01, 107 S.Ct. 1918, 95 L.Ed.2d 439 (1987).

\footnotescript{149} See Schmalz, supra note 138, at 403 (arguing that the Supreme Court decision in Miller v. Cal. complicated the analysis of the copyright-obscenity issue as copyright law was meant to be uniform and national in scope); Wilkinson, supra note 52, at 1038 (arguing that while the Miller community standard is local, copyright is national in scope, thus resulting in inconsistencies while judging what constitutes as “obscene.”); Mitchell Bros. Film Grp., 604 F.2d at 858 (arguing that enacting an obscenity exception to copyright law would “fragment the uniform national standards of the copyright system and venturing into the uncharted waters of a national obscenity standard.”).

\footnotescript{150} See, e.g., Altria Group v. Good, 555 U.S. 70, 76 (2008) (“we have long recognized that state laws that conflict with federal law are “without effect.” Maryland v. Louisiana, 451 U. S. 725, 746 (1981)).
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Supremacy Clause of the Constitution. For this matter, determination whether a work is immoral will differ between different circuits and even in different rulings in the same circuit. This contrasts with the goals of national uniformity in copyright law. As copyright is national in its scope, one community standard throughout the country should suffice to invalidate registration for a work deemed “immoral.” Stated differently—will an immoral work be considered not copyrightable only in the jurisdiction that categorized it as such? However, as mentioned earlier, in other forms of IP law such as trademark law, the fact that social norms are ever-changing does not diminish the justification to refuse registration of a mark. Thus, a scandalous mark today will not necessarily be considered a scandalous mark in the future.

Assuming that a nation-wide immoral standard can be drafted, if that standard changes to become morally justified in the future, will works that were deemed non-copyrightable in the past because of immorality suddenly receive copyright protection? For example, in 1898, the Northern District of California discussed the copyrightability of the song “Dora Dean,” which used

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151 Applying immoral community standards onto copyright, which is a federal concern, is likely to be considered unconstitutional as violating the Supremacy Clause of the Constitution. See U.S. Const. art. VI, cl. 2 (“[T]his Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.”); McDavid, supra note 69, at 573 (arguing that “given that copyright is completely within the purview of the federal government, any attempt to utilize local standards to dictate its enforcement clearly violates the Supremacy Clause of the Constitution by subjecting federal law to municipal demands.”).

152 Rothman, supra note 50, at 152-53 (arguing that determining copyrightability on local “community standards” will lead to contradictory decisions depending on the jurisdiction and that it will defeat the goals of national uniformity of copyright law).

153 In patent law, when a single court invalidates a patent, it is void throughout the country. See Wilkinson, supra note 52 (making an analogy between copyright and patent law scope of invalidity); Blonder-Tongue Labs., Inc. v. University of Ill. Found., 402 U.S. 313 (1971).

154 See Wilkinson, supra note 52 (articulating the problem of the effect of a declaration of invalidity on the status of the copyright in different jurisdictions).

155 See, e.g., Saunders & Rymsza, supra note 124, at 17 (arguing that “the borderline between registrable and unregistrable marks has shifted as social mores and conditions have changed over the years.”).

156 Id. (“what might currently be considered crude or offensive may someday be regarded as amusing or socially acceptable.”); in re Mavety Media Group Ltd., 33 F.3d 1367 (Fed. Cir. 1994) (regarding trademarks, the court noted that “Today's scandal can be tomorrow's vogue.”).
the word “hottest.” The court held that “hottest” has an indelicate and vulgar meaning and for that reason the song cannot receive copyright protection or more accurately, that a musical composition of immoral character is not protected by copyright until the word usage of immoral significance is omitted. It would seem ridiculous to deny the copyright of such a work in this era.

Third, content-based restrictions on registration could actually increase circulation of these materials to the public since more will be able to use the work without permission. Under this assumption, morally undesired works and illegal works will be more harmful to society when not granted copyright protection.

Fourth, content-based restrictions grant an undesired power to copyright registers who will be required to decide whether a work is eligible for copyright protection, which is beyond the scope of creativity and originality. As the registrar is a governmental agent, the power to refuse registration on these grounds could be viewed as a form of government censorship. In addition, it is unlikely that every registrar will be equipped to decide the standard of morality necessary to pass the copyrightability bar, while judges are better equipped to determine the nature of a work. However, relying on courts to set a copyrightability bar, will not necessarily be an easy task as well, and requires judges to make aesthetic evaluations, a matter that is not necessarily desired by copyright law.

158 Id.
159 See Mitchell Bros. Film Grp. v. Cinema Adult Theater, 604 F.2d 852, 856 (5th Cir. 1979) (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 50, at 156 (“denying copyright protection and trademark protection to works and marks deemed pornographic or immoral may actually increase their dissemination.”).
160 Schneider, supra note 45, at 720 (arguing that registration denial “would make the Copyright Office a federal censor.”).
161 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, 1504-5 (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. 390, 390 (1920) (“[O]f course a work utterly useless and worthless would not promote the progress of science and
Finally, as copyright is no longer domestic in nature, imposing content-restrictions on copyrightability will differentiate between the given protection in the United States and worldwide. That is, works that are considered immoral or illegal will not be profitable under U.S. law, but will be profitable in any country that does not impose content-restrictions or set content-restrictions at a lower level. Will works that are considered immoral in the United States and moral in other countries be only granted protection in the countries that are considering the work morally justified? Will artists of these works reallocate to publish only aboard? Although this can be partially resolved by international conventions and agreements that harmonize IP, but as the perception of morality changes between different countries and as the criminal laws of each country differ, harmonizing content-restrictions will be highly difficult, if possible at all.

B. Content-Neutrality Drawbacks

There are several reasons why copyright law should not be content-neutral. First, denial of copyright protection could de-incentivize the creation of undesired works, which can harm society, by removing economic incentives. Copyright law can aid society in reducing future crimes by decreasing economic incentives from immoral works. Moreover, some immoral and illegal works might have an additional negative impact on society. These works might offend unwilling onlookers, induce criminal conduct, erode moral standards, and harm the social fabric.

useful arts, but outside of obvious limits it is dangerous for persons trained only in the law to pronounce upon such matters.”).

162 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 50, at 158 (“[C]opyright law has long discouraged judges from making aesthetic evaluations.”).

163 See, e.g., TRIPs, supra note 133.

164 On the economic motive of advertising and selling child pornography, see, e.g., New York v. Ferber, 458 U.S. 747, 102 S. Ct. 3348, 73 L. Ed. 2d 1113 (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.”).

165 On the other hand, see Green, supra note 77, at 183 (arguing that the “existence of copyright would not hinder criminal prosecutions.”).

166 For example, exposure to an obscene work can be shocking to people’s sensibilities. For justifications for obscenity regulations, see SULLIVAN & GUNTER, supra note 82, at 121.

167 For example, obscenity could induce “criminal sexual conduct.” See id. at 121.

168 See id. at 121-22.
Second, content-restrictions on illegal works can aid in compensating the victims of a crime. Under this scenario, reallocation of the right to file suit against an infringement—from the offender to the victim or proxy of her choice, allows the victim an additional means of compensation from the crime or by the additional harm caused by the work. I elaborate on this matter later.169

Third and finally, granting federal protection to immoral and illegal materials could be viewed as government endorsement of these actions, i.e., that the government approves such activities.170 Under this argument, copyright protection should not be advocated by the government for works that can harm public policy, and, therefore, governments should place restrictions on the registration of undesirable works.

To conclude, there are both benefits and drawbacks to content neutrality in copyright law. However, as previously discussed, in an overall evaluation, it seems that as a quantitative matter, the benefits outweigh the drawbacks and copyright law should remain content-free, at least to some extent. Nevertheless, qualitatively, the content-neutrality approach does not apply similarly to immoral and illegal works, as they possess different characteristics and therefore should not be treated in the same manner. Thus, in the following section, I reevaluate content-neutrality while differentiating between immoral and illegal works and propose a modest solution to correct an injustice empowered by the law which incentivizes criminal activity.

VI. DIFFERENTIATING BETWEEN IMMORAL AND ILLEGAL CONTENT-RESTRICTIONS

The concept of “immorality” should not be a consideration for copyright protection. Depriving copyright protection from immoral works can lead to undesired outcomes, e.g., a possible chilling effect to incentivize some forms of authorship; changing the nature of United States copyright law from its wide-national scope; granting an undesired power to copyright registers; and it will differentiate between the given protection in the United States and worldwide. Moreover, depriving copyright protection from immoral works will most likely be held unconstitutional, abridging the freedom of speech and due process. As oppose to immoral works, the copyrightability of illegal works might, in some cases, be proven an undesired usage of copyright protection.171

169 See infra VI.B.2.
170 McDavid, supra note 69, 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.”).
171 Yet, the fact that a convicted felon profits because copyright law allows her to does not
that is embedded in a wider perception of the penal system that criminals should not profit from their misconduct.

A. The Problem of Illegal Works

Consider the following two examples of illegal works: spray painting graffiti on a wall of a public building and filming child pornography. Graffiti could be considered an undesirable activity and is illegal in most states—particularly if vandalism is attached to it.\(^\text{172}\) However, this illegal act is undesirable due to its destructive nature—not because of the scope of its creativity. In other words, graffiti exemplifies a type of work that its content, if disconnected from criminal activity, is a legal form of free speech and should be protected.

Now consider child pornography—which is likely a hypothetical example of copyright registration and infringement claims—\(^\text{173}\) it still demonstrates an important issue. The photographer of the child takes an original photo and registers it; i.e., she is the rightful owner of the rights to the photograph and, therefore, eligible to legal remedies. After registration, the photo finds its way to the Internet and is downloaded numerous times by various end-users. Assume that all entities are convicted and incarcerated.\(^\text{174}\)

\(^\text{172}\) See, e.g., CAL. PENAL CODE § 594(a)(1) (Deering 1998); 9 GA. CODE ANN. § 34.70 (LexisNexis 2006). See also Schwender, supra note 68 (describing illegal graffiti in the United States).

\(^\text{173}\) The author of a work that constitutes child pornography is unlikely to register a copyright or bring an infringement action because she will probably fear criminal charges. See Bartow, supra note 29, at 20 (“no holder of copyright in a work that unambiguously constitutes child pornography has to date legally asserted copyrights or brought 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 69, 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).

\(^\text{174}\) The right holder for a violation of 18 U.S.C § 1466A(b), which states that under certain circumstances defined in 18 U.S.C § 1466A(d), “knowingly produces, distributes, receives, or possesses with 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 or attempts or conspires to do so, shall be subject to the penalties provided in section 2252A (b)(1), including the penalties provided for cases involving a prior conviction”; and the end-users for a violation of 18 U.S.C § 1466A(b) which states that under certain circumstances defined in 18 U.S.C § 1466A(d), “knowingly...
While serving time, the right holder, knowing that her exclusive rights were infringed, files multiple lawsuits for copyright infringement. Even if the photo is no longer actionable through the Internet, the photographer is entitled to sue for copyright infringement and receive damages. In this case, the convict can profit from her unlawful activity, while the victim does not receive compensation. Society does not benefit from this activity. In this case, and others like it, the content is criminal and should not be protected by law. Moreover, the crime’s profitability should be minimized.

These examples are only the tip of the iceberg; there is a vast variety of illegal works, some of which are undesirable for society. Whether copyright protection for undesired works actually incentives their creation, and whether copyright law should be involved in this scheme, is disputable. However, the added expressive value to the argument that copyright law should not protect undesired works is that the law should not aid in creating social injustice and incentivize criminal behavior. Thus, from a social aspect, Congress should not grant copyright protection to undesirable types of works and should suppress their creation and dissemination by blocking legal incentives. To put the argument differently, Congress should strive to make undesired works and undesired conduct non-profitable.

**B. Solutions for Illegal Works**

As I discuss earlier, copyright law does not examine the nature of a work. When immoral or illegal works are original works of authorship and fixed in a tangible medium of expression, they automatically receive copyright protection and are eligible for registration. However, the question whether these works benefit from legal remedies is still questionable. Although since 1979, some courts granted remedies for copyright infringement of “obscene” works, it is only limited to the Fifth and Ninth Circuits, while the Second Circuit has

possesses 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 or attempts or conspires to do so, shall be subject to the penalties provided in section2252A (b)(2), including the penalties provided for cases involving a prior conviction.”

175 17 U.S.C § 106.
176 See supra Section II.A.
177 Mitchell Bros. Film Grp. v. Cinema Adult Theater, 604 F.2d 852 (5th Cir. 1979); Jartech, Inc. v. Clancy, 666 F.2d 403 (9th Cir. 1982).
reached a different result.\textsuperscript{178} As I previously note, this uncertainty should be explicitly addressed either by Congress or by the Supreme Court to clarify whether or not immoral and illegal works are eligible for legal remedies. Until such clarification is provided, courts should abstain from imposing content-restrictions to copyrighted works as the law currently does not explicitly grant such restrictions. Thus, under current law, any original work of authorship fixed in a tangible medium of expression, should be granted copyright protection and is eligible for registration.

As a matter of policy, I opine that copyright law should remain content-neutral, especially when it comes to immoral works. As mentioned, the thin border existing between moral and immoral works is difficult to delineate since there is an ever-changing standard that varies according to time and place.\textsuperscript{179} This uncertainty might lead to an undesired chilling effect to creation of works, and by that demotes the progress of knowledge and dissemination of ideas.\textsuperscript{180}

Certain types of illegal works are different though. Committing a criminal offense, which harms an individual, is harmful to society and any knowledge gained from the work connected to the crime is not necessarily desirable. Thus, when criminal offenders profit from their actions, some are even incentivized to act so, it leads to injustice that should not be advocated by the law. Accordingly, as I opine that copyright law should strive to remain as content-neutral as possible as a matter of general policy, but the profitability of undesired works and criminal conduct should nevertheless be de-incentivized by the law, I propose a new doctrine, mostly external to copyright law, which best addresses this problem. Before turning to my proposition, I review possible existing and suggested methods of preventing crimes profitability, in order to emphasis the need of such proposal.

\textbf{1. Equitable Doctrines}

American law comprises many types of equitable doctrines that in some cases can be invoked in a copyright lawsuit as an equitable remedy or as a valid defense. Other forms of IP also acknowledge certain remedies and defenses to infringement lawsuits. In trademarks, for example, the owner of a misleading mark is not eligible for an injunction against the infringement of the mark.\textsuperscript{181}

\begin{footnotesize}
\begin{enumerate}
\item See supra Section V.A.
\item Id.
\item 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” 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
\end{enumerate}
\end{footnotesize}
Similarly, 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 it would support the violation that antitrust laws have regulated against.\textsuperscript{182} However, as I briefly analyze, the current equitable doctrines are not applicable in 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 unjust enrichment under the general rational that “[a] person who is unjustly enriched at the expense of another is subject to liability in restitution.”\textsuperscript{183} Plaintiffs seeking recovery for unjust enrichment usually must prove that the defendants have benefited at their expense and that equity and good conscience require restitution.\textsuperscript{184}

If such legal solution is available, is there a need to create a new doctrine? The answer is simple. Even if crime profitability can be resolved by unjust enrichment, it is uncertain that every court will accept this claim, especially regarding copyright infringement. For example, when a snuff film is unlawfully downloaded by an end-user, but its right holder does not sue for copyright infringement, there is no enrichment of the end-user. Thus, it is unlikely that the victim of the snuff film (or her proxy) will be able to sue the end-user for copyright infringement under unjust enrichment claims since there was no benefit at their expense. Moreover, it is uncertain that every case of illegal copyright will result in a causative relation between the wrongful act and the enrichment, such as in the case of a murderer that sells a painting, which is unrelated to the crime. In addition, a well crafted doctrine should also contain legal remedies for crime victims, who are unaware, unable, or unwilling to sue the felon.\textsuperscript{185} In this case, unjust enrichment is fairly limited, and will not advance this important interest of compensating all crime victims. Put differently, a new doctrine is required to prevent legal uncertainty

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\textsuperscript{182} 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).
\textsuperscript{183} See \textit{Restatement} (Third) of Restitution and Unjust Enrichment § 1 (2011).
\textsuperscript{184} See, e.g., \textit{In re} Mid-Island Hosp., Inc., 276 F.3d 123, 129 (2d Cir.2002).
\textsuperscript{185} See, e.g., Kelly, \textit{supra} note 75, 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.”).
\end{flushleft}
concerning what constitutes of a particular enrichment unjust\textsuperscript{186} and to ensure that the law is clear in its requirements to fulfill state’s interest of crime profitability and victims’ compensation.

In addition to equitable remedies, there are three types of equitable defenses that can be invoked in copyright lawsuits: The first equitable defense is \textit{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.”\textsuperscript{187} This doctrine was affirmed in copyright law\textsuperscript{188} but was rarely invoked. When it was invoked it was only upon meeting very specific conditions,\textsuperscript{189} e.g., “when the plaintiff’s transgression is of serious proportions and relates directly to the subject matter of the infringement action.”\textsuperscript{190} Moreover, this doctrine only applies when the wrongful acts “in some measure affect the equitable relations between the

\textsuperscript{186} See, e.g., Ernest J. Weinrib, \textit{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.”).

\textsuperscript{187} Keystone Driller Co. v. General Excavator Co., 290 U.S. 240, 245, 54 S.Ct. 146, 148, 78 L.Ed. 293, 297 (1933); \textit{Mitchell Bros. Film Grp.}, 604 F.2d. Another doctrine entitled \textit{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 \textit{in pari delicto} doctrine. See generally, Norman C. Sabbey, \textit{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, \textit{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 \textit{in pari delicto}).

\textsuperscript{188} 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 withhold 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 Brett Frischmann & Dan Moylan, \textit{The Evolving Common Law Doctrine of Copyright Misuse: A Unified Theory and its Application to Software}, 15 BERK. TECH. L.J. 865, 881 (2000) (discussing these two unclean hands doctrines applied in United States copyright law).

\textsuperscript{189} See \textit{Nimmer}, supra note 21, § 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).

\textsuperscript{190} \textit{Id.}
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For this matter, the defendant must be personally injured by the plaintiff’s “wrongful” conduct.\textsuperscript{191}

Additionally, from 1979 when the Court of Appeals for the Fifth Circuit rejected the doctrine, it is unclear whether the equitable doctrine of unclean hands is still relevant in copyright law. The court reasoned that this doctrine adds a defense not authorized by Congress.\textsuperscript{193} In addition, the Court held that any similar defense in an infringement action is inappropriate.\textsuperscript{194} Even if accepted by other circuits, this defense will not serve as a valid defense for most cases due to its very specific conditions: The plaintiff’s alleged wrongful conduct must change the equitable relationship between the plaintiff and the defendant as well as harm the defendant.\textsuperscript{195} Thus, equitable defense of unclean hands does not provide the necessary mechanisms to adjudicate illegal works.\textsuperscript{196}

The second equitable defense is of fraud or misconduct as a basis for denying relief. This defense is applied in: fraud perpetrated against the Copyright Office; obtaining information regarding the nature of defendant’s work through unfair means; failure to disclose material information; and deceivingly submitting false material information.\textsuperscript{197} However, as these

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  \item \textsuperscript{191} Keystone Driller Co. v. General Excavator Co., 290 U.S. 240, 245, 54 S.Ct. 146, 148, 78 L.Ed. 293, 297 (1933); Mitchell Bros. Film Grp., 604 F.2d.
  \item \textsuperscript{192} See Lawler v. Gillam, 569 F.2d 1283, 1294 (CA4, 1978); Mitchell Bros. Film Grp., 604 F.2d.
  \item \textsuperscript{193} Mitchell Bros. Film Grp., 604 F.2d. 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 a 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 69, at 569 (arguing that the applicability of the unclean hands doctrine in copyright protection is still unknown, even after the Mitchell Bros. ruling).
  \item \textsuperscript{194} Mitchell Bros. Film Grp., 604 F.2d (“obscenity is not an appropriate defense in an infringement action, whether piggybacked on the unclean hands rubric or introduced in some other manner.”).
  \item \textsuperscript{195} See, e.g., McDavid, supra note 69, 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.”).
  \item \textsuperscript{196} 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 50, 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.”).
  \item \textsuperscript{197} See Nimmer, supra note 21, § 13.09; Note, supra note 161, at 1507 (describing the “inequitable conduct” defense).
\end{enumerate}
categories do not address most illegal conduct, much like the equitable defense of unclean hands this defense will not serve as a valid defense for most cases, and therefore it is also not a proper mechanism to adjudicate illegal works.

The third equitable defense is copyright misuse—an attempt by the right holder to extend the scope of her limited monopoly, i.e., her statutory right, and could result in a violation of antitrust laws.\(^{198}\) When raised successfully, the copyright misuse defense can bar a culpable plaintiff from prevailing on an action for infringement upon the misused copyright.\(^{199}\) However, as this doctrine is mostly connected to anti-competitive rationales and does not address the subject of most illegal works \textit{per se}, it is, therefore, also irrelevant to solve the problem presented.

To conclude, current equitable doctrines are incapable of untangling all matters relating to illegal conduct. Thus, further examination is required. I now present two proposed doctrines. The first, as previously suggested in the literature, applies “compliance conditions” to copyright registration. The second, an original doctrine that I suggest for the first time, is crafting an \textit{illegal copyright} doctrine to be implemented in the Federal Penal Code. This doctrine will reduce monetary incentives to commit crimes by ensuring that felons will not profit from their crimes. Furthermore, it will de-incentivize the creation of undesired works, and ensure victim compensation. As I elaborate on further, \textit{illegal copyright} doctrine best protects the public’s interests.

2. Proposed Doctrines

The general outline of the two doctrines 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.\(^{200}\) As suggested, Congress should invalidate copyright registration when the author or her agent has “violated specific criminal laws in the immediate production of the material for which the protection is sought.”\(^{201}\) 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 a conviction for the violation of the underlying law, the

\(^{198}\) See, generally, \textsc{Nimmer, supra} note 21, § 13.09; \textsc{John Baker McClanahan, Copyright Misuse as a Defense in an Infringement Action: Lasercomb America Inc. v. Reynolds, 49 Wash. \\& Lee L. Rev. 213 (1992)}.
\(^{199}\) \textsc{See Lasercomb Am., Inc. v. Reynolds, 911 F.2d 970 (4th Cir. 1990).}
\(^{200}\) \textsc{See Note, supra note 161.}
\(^{201}\) \textit{Id.} at 1503.
government could invalidate the copyright, registration, and even seize and destroy physical attributes of the copyrighted work.

This proposition 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 creation of socially undesirable works. Moreover, compliance conditions address the problem of uncertainty whether works are copyrightable or not, by drawing a relatively clear line of copyrightability: The work of an author who has violated specific criminal laws in the immediate production of the work, for which the protection is sought, 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 in a non-obscene language the unlawful acts. 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, and 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. Although her actions are prohibited by criminal law, copyright law should not deprive her from her creativity. If someone saw this graffiti and copied it, the artists should not enjoy the benefits of copyright law, but rather incur “criminal” damages with the infringement of her right. Moreover, forfeit of the copyright under these conditions, which will bar any attempt to sue for copyright infringement of the work and thereby correct the injustice of the felon enrichment, will also deny relief to the victim.

Thus, a proper solution should encompass the use of copyright infringement damages to aid in victim compensation. That is, the victim should not only be recompensed from the criminal proceedings, but also compensated in cases where the distributed work offended her in any matter. In addition, the fact that a criminal work is invalidated and even seized and destroyed by the government, does not erase early distribution of the work. Hence, this “undesired” criminal work could be further distributed even though it has been invalidated. Finally, as suggested by one scholar, because it is hypothetical that

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202 Some graffiti will not be protected by copyright because it does not comply with copyright law requirements. Protected graffiti also poses different problems for copyright protection, For instance, the artist may be anonymous, and graffiti gets painted over often.
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.”203 I, however, disagree with this criticism. Even illegal works have a market, and although it is unlikely that felons register an illegal work and risk conviction, it is still plausible.204 Hence, the law should not advocate such behavior.205

As the “compliance conditions” proposal is insufficient, I propose another solution to resolve copyright law perceived injustices, i.e., de-incentivizing illegal creations and criminal conduct by reducing their profitability from the crime. Much like the “compliance conditions” proposal, this proposal opines that copyright felons should not be awarded damages for their work’s infringement.206 However, there two key-differences:

First, infringement of these works should remain actionable by the felon, the victim, a governmental agent, or any interested party207 in order to de-incentivize the dissemination of the work and recompense the victim. A felon suing for copyright infringement will be barred from receiving damages, but the infringers would still be responsible to compensate the victim. As felons, knowing that they are unable to be compensated from copyright infringements will lack any economic incentive to sue, it is important to grant the victim, a governmental agent, or any interested party (as proxy) the ability to sue for copyright infringement of the related work.

Second, the law should eliminate any chance of profitability from copyrighted materials that are connected to the crime, even when the crime

203 For this argument, see McDavid, supra note 69, at 574.
204 For example, Albert DeSalvo, better known as the “Boston Strangler,” family members claim that he only confessed 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). Furthermore, the infrequency of an undesired act should not provide a valid argument preventing regulation against it. See, e.g., Kelly, supra note 75, 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.”). 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 is less important than the possibility to incarcerate them.
206 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 violative of national policy).
207 An “interested party” could include any person physically or mentally harmed as a result of the offense for which the defendant has been convicted. In the event that the victim is not able to file a lawsuit for any reason, a proxy, e.g., a relative of the victim, could also file the lawsuit on her behalf.
was not committed in the immediate making of the work. For example, a convicted pedophile, who molested several children, and published a book describing her acts (even if in a non-obscene fashion), should not posses the ability to gain from such a “creation” due to its connection to the crime—even if it is copyrightable, i.e., original and fixed in a tangible medium. Any such profits should be reallocated to victim compensation.

The normative justification of my proposal extends its limits beyond the possible enrichment from illegal copyright infringement lawsuits. The perception that criminals should not profit from crime already exists in other forms of legislation, which are partially related to copyright. In an emerging need to correct injustice, some states have passed notoriety-for-profit laws, usually referred to as “Son of Sam” laws. The first “Son of Sam” law was passed in New York in 1977, 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 reenact, or describe the person’s thoughts, feelings, opinions or emotions regarding such crime, must pay to respondent Crime Victims Board any moneys owed to that person under the contract. 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. But the Supreme Court struck down this law in 1991, holding that the law is in violation of the First Amendment due to its significant overinclusiveness, thus failing to pass the strict scrutiny test. In 1992, a revised version of the law passed in New York, correcting the

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208 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 (1992) at 31 (describing the need for the first “Son of Sam” law).

209 N.Y. EXEC. LAW § 632-a (McKinney 1982).


212 Simon & Schuster, 502 U.S. 105 (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).
overinclusiveness of the first law, and like many similar “Son of Sam” laws throughout most part of the country, still exists.\footnote{N.Y. Exec. Law § 632-a (McKinney Supp. 1994). For a full list of existing “Son of Sam” laws, see http://www.freedomforum.org/packages/first/SonOfSam/index.htm.}

A federal version of a “Son of Sam” law also exists.\footnote{18 U.S.C. § 3681.} 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.\footnote{See generally Cohen, supra note 211 (describing federal and state “Son of Sam” legislation).} 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 emotions regarding such crime, for victim compensation while remaining amounts may be paid into the Crime Victims Fund in the Treasury.\footnote{18 U.S.C. § 3681; Cohen, supra note 211, at 4.}

I propose to introduce an illegal copyright doctrine to the Penal Code—similar in essence to “Son of Sam” laws, but different in scope. As noted throughout this article, normatively, copyright law should remain content-neutral, while only addressing the originality and fixation requirements. In this way, freedom of speech is not endangered and the purposes of copyright law are fulfilled. In addition, registration should also remain content-neutral, as every copyright, even if connected with a crime, should be actionable. As noted, copyright registers are unequipped to evaluate the nature of every work, and lack the resources and ability to examine whether each work is a connected with a crime. However, the general rule that should be applied is that some 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, when suing for illegal copyright infringement, courts will be limited to granting remedies to a person physically or emotionally harmed as a result of the crime associated with the work.\footnote{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 her emotional impact from the distribution of the work should also be considered as entitled for compensation.} In case that the victim is not alive, either a governmental agent or any relative can sue on her behalf to recompense the victim’s family.

Second, the victim, either in person or by proxy, will be granted the ability to sue the felon for any profits from a work that its content is directly
and substantially connected to the crime, similarly to the concept of “Son of Sam” laws. My proposal differs from current federal “Son of Sam” statute by adding a provision granting victims the ability to sue the felon for profits from works that their content is not directly and substantially connected to the crime. Under this provision, the victim will receive any additional profits from the sale of intangible property made by the felon, and which the work’s value was increased by the notoriety gained from the commission of the crime, e.g., writing a book that does not address the actual crime but still gains in profits due to the criminal’s increased reputation. In order to estimate the “additional profits,” the court will determine the fair market value of a similar intangible property that has not been increased in value by notoriety gained from the commission of the crime, and deduct it from the profits.

Third and finally, the victim will possess the ability to sue the felon for any increased profits from the sale of tangible property that the felon gained due to the notoriety of the criminal. Much like the second provision, in order to estimate the “additional profits,” the court will need to determine the fair market value of a similar tangible property that has not been increased in value by notoriety gained from the crime, and deduct it from the profits. In case that the victim is not alive, any governmental agent or relative can sue on her behalf to recompense the victim’s family.

A further clarification of my proposal is required. This doctrine applies solely to those criminals who were convicted, pleaded guilty, or voluntarily admitted to the commission of crimes and not to those accused of a felony, as the presumption of innocence is important to protect. According to the doctrine, the felon will be required to notify a “victims’ compensation board” on any income derived from the sale of tangible and intangible property. Any obtained income, including profits gained prior to conviction or admission of guilt, will be deposited in an escrow account managed by the board. The

218 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, than the court will have to consider her former reputation in estimating the increased value of the similar intangible or tangible property as it was sold prior to the commission of the crime.

219 For example, some people collect identifying collectibles associated with murders and crime. This phenomenon, often referred to as “Murderabilia,” can make some crimes very profitable. For a general description of this phenomenon and analysis of its legal remedies, see Cobb, supra note 204.

220 See supra note 218.

221 See, e.g., Coffin v. United States, 156 U.S. 432 (1895).

222 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.
board will use the escrow for the benefit of and payable to the victim or her living relatives on her behalf. Moreover, the board will publish legal notices to potential victims of the crime of any income deposited in the escrow account.

In order for this proposal to be held constitutional under the First Amendment, it is important to identify the nature of the imposed restriction. First, as discussed in Section III.B, some forms of speech are not protected by the First Amendment. Although the scope of unprotected speech is limited, a broad interpretation of Supreme Court decisions indicates that permitted restrictions upon the content of speech should also be applied on speech which is “of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and morality.” As my proposal is aimed at the profitability of specified felons, this interest clearly outweighs any slight social value as a step to truth from the restriction. Therefore, it should not be protected by free speech. Second, this proposal does not restrict speech, but rather reduces the profitability of certain types of conduct. It disincentives crime profitability, not protected speech. Therefore, it should not be held abridging the First Amendment as it does not directly restrict the content of the speech. Much like current restrictions on trademark registration, the usage of the works is permissible, only less profitable. Third and finally, even if my proposal is deemed to place a restriction on speech, it should be considered content-neutral, with only an incidental effect on speech due to a possible chilling effect to create. Therefore, it will only need to meet intermediate standard of scrutiny.

However, even if my proposal is considered to place a content-based restriction on free speech, than it must pass the almost impossible strict scrutiny examination—it must serve a compelling state interest and be narrowly drawn to achieve that end. Although content-based restriction of speech are presumptively invalid, and are unlikely to pass strict scrutiny in light of past Court’s decisions, I opine that my proposal could survive strict scrutiny as it serves a compelling state interest and it is narrowly drawn to achieve that end.


224 For a similar argument on possible free-speech argument against imposing “compliance conditions,” see Note, supra note 161, at 1509. But see Simon & Schuster, Inc. v. State Crime Victims Bd., 502 U.S. 105, 115 (1991) (“A statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech.”).

225 For more on trademarks content-restrictions justifications, see Section IV.A.

226 See supra note 83.

227 See Section III.B.
There are two compelling interests to my proposal: first, to disincentivize criminal behavior by ensuring that felons do not profit from their crimes or their reputation; second, to ensure victim, or their family, compensation. Thus, as the proposal serves a compelling state interest, it must not be underinclusive, nor overinclusive, to survive strict scrutiny.

For the doctrine to avoid underinclusiveness, it must not be applied only upon the speech of the crime. For that, including a provision that deprives the criminal from any income resulting from copyright infringement cases is not enough, as it only applies upon the speech of the crime. Hence, the provision should also include any increased profits gained from selling tangible objects related to the crime or the felon that result in increased value due to the felon’s increased reputation. This provision should be sufficient to avoid underinclusiveness as they could only have an incidental effect, if any, on speech that uses a less stringent standard.

For the doctrine to avoid overinclusiveness, its coverage should not apply to works that do not advance legitimate governmental objectives. The law should not apply to every expression of the creator, but rather be limited to any expression that could further harm the victim or her living relatives, or to works or tangible objects that only increased their profitability due to her infamous reputation. If a convicted serial killer chooses to sell a couch based upon fair market value, without any additional profit due to reputation, she should be entitled to do so. However, if that same couch is sold at a price higher than market-value due to the killer’s reputation she should not profit from its increased value. Moreover, if the same serial killer publishes a book that describes the actual murder of every victim, she should not enjoy profits from her work, nor from a copyright infringement of her work, as the victim’s living relatives are likely to be further harmed. Moreover, it is important to disincentivize the creation of such undesired works by reducing the profitability of crimes.

In addition, the law should apply to the commission of crimes defined in the penal law (including federal crimes), or any other chapter of the consolidated laws of the state, which results in a physical or mental harm to an individual. The mandatory harm requirement holds much importance to fulfill

228 A similar provision exists in some states, e.g., in the 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 in California, Cal. Civ. Code. § 2225 (2005)); Cobb, supra note 204, at 1506-07 (analyzing Texas “Son of Sam” statute).

229 See Cohen, supra note 211, at 6 (describing the underinclusiveness requirement and the possible incidental effect on speech); United States v. O’Brien, 391 U.S. 367, 383 (1968).
the state interest of recompense the victims of the crime, and an important matter to insure that the law is not overinclusive and to promote copyright law’s goals. For example, original graffiti should remain protected if it does not harm an individual, as it promotes the progress of knowledge. This division might be perceived as problematic, as many works of convicted felons that were considered by courts to result in physical harm to an individual, will not be protected despite their undoubted promotion of knowledge.

Take for example the founder of al-Qaeda, the late, infamous Osama bin Laden, and imagine that he was convicted. Although most people will highly disapprove of his unlawful actions, some would nevertheless be intrigued to learn more about 9/11 attacks. This information could also be very beneficial to governmental agencies in their fight against terror. Thus, a book published by him could be beneficial to society, although it could potentially harm the victims and their relatives. Other examples of works that could be beneficial to society are works of “convicted felons” such as Mohandas Karamchand Gandhi (“Mahatma”), Nelson Mandela, etc. Should the penal code de-incentivize the creation of such works?

However, my proposal will not limit the creation and dissemination of such works, but rather prevent or reduce their profitability. If an individual would desire to publish such works as in my examples, I opine that their non-copyrightability will not pose a real bar to their production. Rather, the financial incentive will probably not be their sole incentive to create. Moreover, this can be partially solved by including a limited profitability incentive in the doctrine. This can be achieved either by setting a time limit on the usage of the doctrine, i.e., felons will be able to profit from their crime after

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230 See, e.g., Kelly, supra note 75, 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 doctrine 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.

231 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 findingDulcinea Staff, 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.


233 There could be many different incentives to create, e.g., recompense or fame. See Kelly, supra note 75, at 27-28 (providing such examples of incentives to create).
a period set by the law or by extending the scope of granting “additional profits” from the crime to apply on the entire doctrine, i.e., also on copyright infringement lawsuits and on works which are connected to the crime.\textsuperscript{234}

It is noted that although my proposition will not deprive publication of such works but merely any increased profits from it, it will not necessarily pass strict scrutiny, as can be defined unequally by different courts. However, as it is carefully crafted as nor underinclusive or overinclusive to achieve its two compelling interests, Congress should consider its implementation to solve an important injustice, which has been advocated by copyright law, through federal criminal legislation. A caveat: the proposed doctrine will not eliminate the profitability of all crimes nor will it cease the dissemination of all undesired works. Nevertheless, it will improve the current legal status that leads to the undesired outcome of profitable crimes.

\section*{VII. Conclusion}

As a matter of general policy, copyright should strive to remain content-neutral. Original works of authorship fixed in a tangible medium should receive both copyright protection and be eligible for registration—regardless of their content. In order to avoid further circuit court interpretation on this matter, Congress or the Supreme Court should explicitly embrace a content-neutrality approach.

However, certain types of works, which are undoubtedly undesired by society, should not benefit their creator and be economically de-incentivized. These “illegal works,” comprise works with criminal content or works that are directly linked to harmful crimes, e.g., works that promote criminal activity or works and tangible objects that increase their profitability due to the convicted felon reputation, e.g., a book published by her, or a photograph signed by her. A general normative approach should clarify this categorization: An offender should not profit from crimes that harm an individual—even when a “creative” work is involved. Thus, original graffiti should grant its artist copyright protection and legal remedies for her work, but a “snuff” filmmaker should not enjoy legal remedies upon infringement of her work or any profits from her reputation. In that way, the promotion of knowledge is ensured, while the injustice of profitable crimes is corrected.

\textsuperscript{234} 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 of time. For a list of such state statutes, see Kelly, \textit{supra} note 75, at 27-28 n.164. I thank Ariel Porat for suggesting this important note.
The proper solution involves codifying an illegal copyright doctrine in the Penal Code and is threefold: First, when suing for illegal copyright infringement, court will be limited to grant remedies in an infringement lawsuit, only to a person physically or mentally harmed as a result of the offense, which is associated with the work. Second, the victim, either in person or by proxy, will be granted the ability to sue the felon for all profits from a work that content is directly and substantially connected to the crime against her. Victims will receive any additional profits from the sale of intangible property by the felon, which value was increased by the notoriety gained from the offender’s crime. Third and finally, the victim will be granted the ability to sue the felon for any increased profits from the sale of tangible property that the felon gained due to the notoriety of the criminal, e.g., selling tangible objects related to her in any way.

The illegal copyright doctrine is greatly needed to correct an existing injustice in the United States legal system. Criminals should not be incentivized by the legal system to create works that are undesired and harmful to society or in any way gain profit from their misconduct. Even if this spectrum of activities is relatively narrow, or even hypothetical, it does not diminish the normative importance that law should not advocate undesirable behavior. Crime pays. It should not.