COPYRIGHT, SUPPRESSION AND THE PROBLEM OF THE UNPUBLISHED WORK: LESSONS FROM THE PATENT LAW

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I. INTRODUCTION

> No man but a blockhead ever wrote, except for money.
> --Samuel Johnson[1]

If monetary reward is the sole incentive for the creation of written works, then the federal copyright law would seem an ideal scheme for encouraging prospective authors. By giving an author control over the production of copies of his or her works,[2] copyright ideally allows recoupment of the total cost of intellectual effort behind the work,[3] and prevents others from "free riding" on these efforts.[4] Therefore, under normal circumstances, the benefits of the exclusive rights provided by copyright inure to both the author and the public at large. For the author, the benefit is full monetary reward for his or her efforts;[5] for the public, it is the production and distribution of works which might not otherwise be produced if the author's monetary reward were not protected.[6] Thus copyright, as classically conceived, ensures the promotion of intellectual progress, by encouraging the production and disclosure of literary, historical, biographical and scientific works,[7] so that later generations may be exposed to, and build upon, these works.[8]

In recent years, however, a disturbing trend has emerged in the enforcement of the copyright privilege. Notable authors and public figures have successfully used copyright as a weapon for suppressing or delaying unauthorized biographies or the excerption of unpublished letters.[9] The

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1. 3 J. Boswell, The Life of Samuel Johnson 19 (G. Hill rev. ed. 1934) (3d ed. 1799).
2. See 17 U.S.C. §106 (1988).
3. Although, in reality, copyright may under- or over-compensate the author. See Breyer, *The Uneasy Case for Copyright: A Study of Copying in Books, Photocopies and Computer Programs*, 84 Harv. L. Rev. 281, 286-87 (1970).
4. For a general discussion of the classical economic conception of the rationale for copyright (often called "reward theory"), see Landes & Posner, *An Economic Analysis of Copyright Law*, 18 J. Legal Studs. 325, 326-29 (1989). See also Litman, *The Public Domain*, 39 Emory L. J. 965, 970 (1990).
5. See Landes & Posner, *supra* note 4, at 328.
6. *Id.* at 329.
7. Copyright, however, is not limited to these examples, but protects any "original work of authorship fixed in any tangible medium of expression...." 17 U.S.C. §102(d). See also Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 252 (1902) (any work which others may wish to copy is subject to the protections of copyright).
8. See Litman, *supra* note 4, at 966 (every new work is in some sense based on the works that preceded it); Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1109 (1990) (explaining the derivative nature of intellectual creativity); Umbreit, *A Consideration of Copyright*, 87 U. Pa. L. Rev. 932, 942 (1939) (every copyrighted work is derived from a work of copyrightable nature).
9. See *The Wages of Rage*, Wash. Post, Oct. 21, 1990, Book World, at 15, col. 1 (Kurt Vonnegut uses threat of copyright suit to prevent distribution of a catalog offering an unpublished letter for sale); *Stop the Presses: Bellow's Clout Delays Biography*, Chi. Tribune, Apr. 18, 1990, §5 (Tempo), at pp. 1-2 (Saul Bellow threatens copyright suit to restrain publication of an unflattering and highly

technique of using copyright as a tool for suppression has not been limited to men and women of letters; corporations have begun to use copyright as a means of hampering plaintiff discovery in consumer litigation.[10] Although the copyright law, by definition, is designed to advance the "promotion of progress"[11] by facilitating the disclosure of works of authorship, courts have recently been very receptive to the use of copyright as a means for suppression.[12]

Copyright is now used as a weapon for suppression in part because of an increasing view by scholars that copyright contains an underlying moral or absolute property right.[13] Under this view, the creator's wishes regarding the work are supreme and the copyright law is viewed as a vehicle through which these wishes are to be enforced against other authors and the public at large.[14] This view is most strenuously argued in the case of the unpublished text.[15] Because the copyright law gives the author the subsidiary right to control first publication,[16] the author is increasingly viewed as entitled to prevent any publication at all, and any attempts by others to excerpt from unpublished works are considered so damaging to this right that they are virtually forbidden.[17]

The use of copyright law to suppress writings seems completely at odds with copyright's constitutional purpose, the "promotion of progress."[18] The promotion of progress would seem to be best served by disclosure of works to the public so that others may learn from, and build

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revealing biography); Yardley, *Fair Use and a Chill Wind*, Wash. Post, Feb. 12, 1990, at B2, col. 1 (widow of Richard Wright uses copyright of six unpublished letters to sue author of a biography of Wright); *infra* notes 55-93 and accompanying text (attempts to restrain publication of biographies of J.D. Salinger and L. Ron Hubbard). The Richard Wright biography was eventually found not to infringe Wright's copyrights. See Wright v. Warner Books, Inc., 748 F. Supp. 105 (S.D.N.Y. 1990), *aff'd*, 1991 U.S. App. LEXIS 28198 (2d Cir. 1991).

10. See generally Jacobsen, *Protecting Discovery by Copyright*, 71 J. Pat & Trademark Off. Soc'y 483 (1989) (discussing the use of copyright to prevent "discovery sharing" among plaintiffs); Note, *The Value of Copyright Law as a Deterrent to Discovery Abuse*, 138 U. Pa. L. Rev. 549 (1989) (same); *Copyright Used to Shield Discovery*, Nat'l L. J., Mar. 28, 1988 at 3, 48 (describing one company's use of copyright to "threaten lawyers sharing information" in product liability suits).
11. See U.S. Const. art. I, §8, cl. 8.
12. See *infra* notes 64-93 and accompanying text.
13. See Weinreb, *Fair's Fair: A Comment on the Fair Use Doctrine*, 103 Harv. L. Rev. 1137, 1138-39 (1990); Fisher, *Reconstructing the Fair Use Doctrine*, 101 Harv. L. Rev. 1659, 1690 (1988); Kauffman, *Exposing the Suspicious Foundation of Society's Primacy in Copyright Law: Five Accidents*, 10 Colum. J. L. & Arts 381, 384 (1986); *infra* notes 64-83 and accompanying text.
14. *C.f.* Fisher, *supra* note 13, at 1690 (discussing "personal rights" in copyright).
15. See Newman, *Copyright Law and the Protection of Privacy*, 12 Colum. J. L. & Arts 459, 477 (1988).
16. See Harper & Row v. Nation Enters., 471 U.S. 539, 549 (1984) (hereinafter *The Nation*).
17. See Salinger v. Random House, Inc., 811 F.2d 90, 97 (2d Cir.), *cert. denied*, 484 U.S. 890 (1987).
18. U.S. Const. art. I, §8, cl. 8.

upon, their teachings.[19] When a work is suppressed, not only does it fail to promote progress, but progress may in fact be hindered.[20] If this is true, then certainly the use of copyright as a tool for suppression causes it to stray from its constitutional objective.

The promotion of progress is also the underlying rationale behind the federal patent law.[21] Yet under the patent law the inventor is not capable of suppressing an innovation. In fact, an inventor who "abandons", "conceals," or "suppresses" an invention may lose all patent rights, and in some instances those rights may be granted to another.[22] This doctrine conforms with the notion that the public good is not served when new creations are withheld from the public, and therefore the creator should not expect the public to reward any attempts at suppression.

Given that the patent and copyright laws are derived from the same constitutional clause, and are presumably intended to serve the same values, it seems curious that suppressive actions under the two schemes are treated so differently.[23] Certainly it would appear that analyzing the manner in which the patent law treats suppression of innovations might call into question the validity of allowing copyright holders in some cases virtually complete suppressive power. It is also quite possible that such an analysis can shed light on flaws in the current approach to the exclusive rights of copyright holders, and perhaps suggest ways to rectify these flaws.

II. SUPPRESSION AND THE PROBLEM OF THE UNPUBLISHED WORK: FROM *THE NATION* TO *NEW ERA*

Before 1976, unpublished writings were ineligible for federal copyright protection.[24] However, unpublished works did receive protection under state "common law" copyright[25] prior to 1976,[26] protection which was in many ways broader than that under the federal scheme.[27] The state

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19. See Chafee, Jr., *Reflection on the Law of Copyright I*, 45 Colum. L. Rev. 503, 511 (1945) (some use of the contents of a book must be allowed to prevent stifling of the creative efforts of other authors).
20. *Id.*
21. See U.S. Const. art. I, §8, cl. 8 (giving rights to inventors as well as authors).
22. See 35 U.S.C. §§102(c), (g) (1988); *infra* notes 137-172 and accompanying text.
23. For a discussion of the manner in which copyright and patent were originally designed to serve the same values, and an explanation of how they now often do not, see Wiley, Jr., *Copyright at the School of Patent*, 58 U. Chi. L. Rev. 119, 138-42, 180-83 (1991).
24. See 1 M. Nimmer & D. Nimmer, Nimmer on Copyright §2.02 at 2-16.1 (1990) (hereinafter Nimmer).
25. Although state protection of unpublished works was almost universally referred to as "common law" copyright, in some states it was actually derived from statute. *Id.*
26. *Id.*
27. 2 Nimmer, *supra* note 24, §8.23 at 8-315 to -316 (common law copyright prevented *any*

common law scheme flourished, despite constitutional problems,[28] for almost 200 years, but the 1976 Copyright Act removed publication as a necessity for federal copyright protection.[29] Under the 1976 Act, any "work of authorship reduced to any tangible medium of expression"[30] received the protections,[31] and was subject to the limitations,[32] of the federal copyright scheme. Although the extension of federal protection to unpublished works seemed a logical outgrowth of the principles underlying the copyright law, there were also tensions inherent in extending copyright to unpublished works.[33] These tensions were first exposed in the Supreme Court's decision in *Harper & Row, Publishers, Inc. v. Nation Enterprises.*[34]

A. The Nation

The Nation involved the manuscript of memoirs written by former President Ford.[35] While the manuscript was being prepared for publication in book form and excerption in Time magazine, the publisher of The Nation magazine surreptitiously received a copy of the manuscript.[36] The Nation quickly compiled an article derived from quotations and distillations of the Ford manuscript, and published it in time to "scoop" the anticipated Time magazine article.[37] As a result, Time canceled its agreement with Ford to publish the excerpts, and refused to pay the amount specified in the agreement.[38] Ford, through his publisher Harper & Row, sued The Nation for infringing his copyright in the unpublished manuscript.[39]

The Nation did not involve suppression of a manuscript from public

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unauthorized copying, and allowed no fair use defense).

28. Common law copyright extended into perpetuity, and allowed no fair use. See Newman, *supra* note 15, at 463. Accordingly, serious conflicts with the congressional power to grant rights "for a limited time" under Art. I §8, cl. 8, and the freedom of speech and press under the First and Fourteenth Amendments were implicated.
29. See 1 Nimmer, *supra* note 24, at §4.01.
30. 17 U.S.C. §102.
31. See *id.* at §106.
32. *Id.* at §107.
33. For example, that an author might not wish to use the copyright law as a means of recovering economic rewards, but instead as a means of ensuring that certain works were never revealed to the public. See *infra* notes 55-99 and accompanying text.
34. 471 U.S. 539 (1984) *(The Nation).*
35. See *id.* at 542.
36. *Id.* at 543.
37. *Id.*
38. *Id.*
39. *Id.* at 543-44.

disclosure.[40] However, its discussion of the manner in which copyright protects unpublished works, and the way the fair use defense[41] applies to these works, would have an effect on subsequent cases involving attempts to suppress through copyright.[42] The Court began the decision by noting that "copyright is intended to increase and not impede the harvest of knowledge."[43] Furthermore, "[t]he rights conferred by copyright are designed to assure *contributors to the store of knowledge* a fair return for their labors."[44] Finally, the Court stated that copyright was designed to achieve an important public purpose: "to motivate the creative activity of authors...*and to allow public access* to the products of their genius...."[45] Each of these passages evidence the Court's sensitivity to the fact that copyright is not an absolute property right, but a grant limited according to the underlying purpose of allowing the public access to written works.[46]

In its analysis of the fair use defense as it is applied to unpublished works, the Court also demonstrated its realization of the need to balance an author's need for control over copying of his or her work versus the underlying role of copyright in furthering progress in literature, biography, and the arts. The Court noted:

> "[T]he author's consent to a reasonable use of his copyrighted works [is]...a necessary incident of the constitutional policy of promoting... progress... since a prohibition... would inhibit subsequent writers from attempting to improve upon prior works and thus...frustrate the very ends sought to be attained."[47]

However, in the case of an unpublished work, the ability to control release of the work to the public can provide substantial economic return.[48] Because this right can be easily arrogated by another under the guise of fair use, the Court concluded that "the unpublished nature of a work is '[a] key, though not necessarily determinative factor' tending to negate a defense of

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40. In fact, the memoirs involved in *The Nation* were being prepared for both full publication as well as pre-publication excerption. *Id.* at 542-43.

41. "Fair use" is a long-standing doctrine in copyright law in which an otherwise infringing use of a copyrighted work is excused in certain circumstances. See 17 U.S.C. §107. It has been said that fair use "permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity the law was intended to foster." 3 Nimmer, *supra* note 24, §13.05 at 13-62.43.

42. See *infra* notes 55-98 and accompanying text.

43. See *The Nation*, 471 U.S. at 545.

44. *Id.* at 546 (emphasis added).

45. *Id.* (emphasis added).

46. See *infra* notes 106-121 and accompanying text.

47. *The Nation*, 471 U.S. at 549 (quoting H. Ball, Law of Copyright and Literary Property 260 (1944)).

48. See *The Nation*, 471 U.S. at 549.

fair use."[49] In so holding, the Court took special note of the fact that this defendant's use of the unpublished materials "had not merely the incidental effect but the *intended purpose* of supplanting the copyright holder's commercially valuable right of first publication,"[50]and noted that fair use "presupposes 'good faith' and 'fair dealing'" on the part of the defendant.[51]

The holding in *The Nation* that the unpublished nature of a work is a key factor in negating a fair use defense seems intended to address the paradigmatic situation in which an author fully intends to reveal his or her as-yet unpublished work to the public and reap the resultant economic rewards. The Court's emphasis on the loss of valuable economic rights when an unpublished manuscript is co-opted by another shows that in this situation a fair use defense could undermine the underlying economic incentives in copyright law.[52] The Court in no way endorsed a view that an author has a wholesale right to keep his work from the public altogether with the imprimatur of the copyright statute. In fact, the Court noted that although there is a constitutional right "not to speak," this right could not "sanction abuse of the [copyright privilege] as an instrument to suppress facts."[53] Accordingly, although *The Nation* endorsed a more stringent realm of protection from copying for unpublished works, this derived from the underlying economic reward rationale for copyright, and in no way intimated that this protection was overarching.[54]

B. Salinger

With *The Nation* providing background for the treatment of unpublished works under the copyright law, the Second Circuit was recently faced with two cases in which the plaintiff appeared more interested in keeping works from public revelation altogether than in wielding economic power through copyright.[55] The first case, *Salinger v. Random House, Inc.*,[56] involved

49. *Id.* at 554 (quoting S. Rep. No. 473, 94th Cong., 1st Sess. 64 (1975)).

50. *Id.* at 562.

51. *Id.*

52. See *supra* note 4 and accompanying text.

53. See *The Nation*, 471 U.S. at 559. Although the Court spoke in terms of the suppression of facts, the constitutional right not to speak is not so limited, and presumably covers the right not to "express" as well. *C.f.* Wooley v. Maynard, 430 U.S. 705, 713 (1976) (individual's right not to speak extends to dissemination of ideological message).

54. See Newman, *supra* note 15, at 468.

55. See New Era Publications, Int'l v. Henry Holt & Co., 695 F. Supp. 1493 (S.D.N.Y. 1988), *aff'd*, 873 F.2d 576 (2d Cir.), *petition for reh'g denied*, 884 F.2d 659 (2d Cir. 1989), *cert. denied*, 110 S. Ct. 1168 (1990); Salinger v. Random House, Inc., 650 F. Supp. 413 (S.D.N.Y. 1986), *rev'd*, 811 F.2d 90 (2d Cir.), *cert. denied*, 484 U.S. 890 (1987).

56. 650 F. Supp. 413 (S.D.N.Y. 1986), *rev'd*, 811 F.2d 90 (2d Cir.), *cert. denied*, 484 U.S. 890 (1987).

a request for an injunction halting publication of an unauthorized biography of noted author J. D. Salinger.[57] The author of the biography originally sought Salinger's cooperation, which Salinger refused, stating that he preferred not to have his biography written during his lifetime and that he considered such a biography an invasion of his privacy.[58] Upon realizing that the biography contained quotations from several unpublished letters written by Salinger (many of which Salinger did not realize existed),[59] the letters were registered for copyright protection[60] and a suit was commenced to restrain publication of the book as an infringement of Salinger's copyrights in the letters.[61] Just as in *The Nation*, the defendant's primary defense was that the copying was fair use.[62]

The district court refused to issue an injunction,[63] but the Second Circuit reversed and remanded with directions to issue the injunction.[64] Although the circuit court noted that the 1976 Act made the right of first publication subject to the fair use defense, it nonetheless stated that the discussion in *The Nation* "convey[ed] the idea that [unpublished] works normally enjoy complete protection against copying."[65] Despite the fact that *The Nation* decision rejected the fair use defense in a large part because of the economic rewards destroyed by the defendant's copying, the court in *Salinger* seemed more concerned with establishing an author's absolute property right in his or her unpublished works.

The circuit court began its decision by incorrectly citing *The Nation* for the proposition that "unpublished letters normally enjoy insulation from fair use copying."[66] Although Salinger disavowed any intention of publishing the quoted letters during his lifetime, the court stated that he was still entitled to "protect his *opportunity* to sell [the copyright to these letters]."[67] Furthermore, it stated that Salinger had a right to protect "his unpublished writings for the term of his copyright, and that right prevails over a claim of fair use under 'ordinary circumstances'."[68] The public, according to the court, was to become aware of the contents of the letters

57. See *id.* at 92.

58. See *Salinger*, 811 F.2d at 92; *Salinger*, 650 F. Supp. at 416.

59. See Margolick, *Whose Words Are They Anyway?*, N.Y. Times, Nov. 1, 1987, §7 (Book Review) at 45, col. 2.

60. The letters were registered because no suit for copyright infringement may proceed unless the underlying work is registered. See 17 U.S.C. §411(a).

61. See *Salinger*, 650 F. Supp. at 413.

62. See *Salinger*, 811 F.2d at 95.

63. *Salinger*, 650 F. Supp. at 428.

64. *Salinger*, 811 F.2d at 100.

65. *Id.* at 95, 97.

66. *Id.* at 95.

67. *Id.* at 99.

68. *Id.* at 100 (quoting *The Nation*, 471 U.S. at 555).

only upon Salinger's decision to publish, or the expiration of the copyright in the letters.[69]

Although the *Salinger* decision was ostensibly derived from the holding in *The Nation*, its language shows a disregard for the underlying concerns informing that decision.[70] *The Nation*'s heightened restrictions on the fair use of unpublished works was intended to apply to the "ordinary" situation in which an author is in the process of preparing the work for publication.[71] Its consideration of the protection afforded unpublished works was based on the underlying economic rewards which could be lost through copying.[72] *Salinger*, however, dealt with an author who not only had no intention of publishing his works, but also was unaware that they existed until revealed by the copier.[73] An author who uses the unpublished nature of a work as a tool for keeping the work from *any* public disclosure is not using copyright for its intended purpose, as an economic reward system. This is not the "ordinary" situation which was addressed in *The Nation*, and approaches a view of copyright as a form of absolute property right inuring to the author only. Giving the author the right to keep a work unpublished (and therefore suppressed from the public) goes beyond the true copyright scheme, providing the author a powerful property right without any concomitant reward to the public.[74] If there was any question that this was the type of protection the Second Circuit intended to endorse, all doubts were dispelled in its next major copyright decision, *New Era Publications, International v. Henry Holt & Co.*[75]

C. New Era

New Era dealt with an unauthorized, and highly critical,[76] biography of pulp author and religious figure L. Ron Hubbard.[77] As in *Salinger*, the plaintiff (representatives of the Hubbard estate) attempted to enjoin

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69. *Id.*

70. See *supra* notes 40-54 and accompanying text.

71. See *supra* notes 51-53 and accompanying text.

72. See *supra* note 50 and accompanying text.

73. See *supra* note 59. Because the *Salinger* defendant revealed the existence of work which the author was unaware still existed, it seems curious that the defendant was denied any reward, and was in fact punished, for revealing writings which might have otherwise have been lost to the public.

74. Although the copyrighted material will eventually lapse into the public domain, given that the copyright term extends for the author's life plus fifty years, see 17 U.S.C. §302, the public is, in all practicality, denied any return for its grant of rights.

75. 873 F.2d 576 (2d Cir. 1989), *cert. denied*, 110 S. Ct. 1168 (1990).

76. For a flavor of the Hubbard estate's decidedly negative attitude to the critical aspects of the work, see *New Era*, 695 F. Supp. at 1499 n.2 (statements of Norman Starkey, executor of the Hubbard estate).

77. See *New Era*, 695 F. Supp. at 1497.

publication of the work as an infringement of the estate's copyright in several unpublished diaries and letters quoted in the book.[78] The defendant, just as in *Salinger*, argued that the use of the unpublished works constituted fair use.[79] The record indicated that the true purpose of the infringement suit was not to prevent loss of the economic value of the letters, but merely to stifle any criticism of Hubbard and the church which he founded.[80]

The district court, constrained by *Salinger*, found that the use of the unpublished works forced a rejection of the fair use defense, but nonetheless denied the injunction, stating that the potential injury to the public interest in freedom of speech outweighed the plaintiff's need to restrain the work.[81] The Second Circuit affirmed the denial of the injunction, but on the grounds of laches.[82] However, the Second Circuit, in a majority opinion by Judge Miner, also went out of its way to reaffirm *Salinger*'s virtual prohibition of the fair use of unpublished works in the face of questions raised in the district court opinion.[83]

The district court had intimated that when unpublished copyrighted expression was copied to demonstrate significant facts about the subject of a biography (for example, untruthfulness or bigotry), fair use might be found.[84] The Second Circuit rejected this rationale and reiterated its conclusion in *Salinger* that unpublished works normally enjoy complete protection from fair use.[85] However, Chief Judge Oakes' concurring opinion questioned some of the conclusions flowing from *Salinger* and the majority opinion. Specifically, he questioned the majority's extensive discussion of the fair use defense in light of the affirmance on laches stating that doing so "even by way of dictum, tends to cast in concrete [*Salinger*]," and noted a previous concern that *Salinger*, "might by being taken literally in another factual context come back to haunt us. This case realizes that concern."[86]

Chief Judge Oakes argued that, in the case of quotation of unpublished works, copying might be justified when the copier is intending to prove character traits at odds with the public image of a subject.[87] In so arguing, he was forced to reject the proposition that "[*The Nation*], as glossed by

78. See *New Era*, 873 F.2d at 577.
79. *Id.*
80. See *New Era*, 695 F. Supp. at 1527 n.14.
81. *Id.* at 1524, 1527.
82. See *New Era*, 873 F.2d at 584-85.
83. *Id.* at 583-85.
84. See *New Era*, 695 F. Supp. at 1509-20.
85. See *New Era*, 873 F.2d at 583.
86. *Id.* at 585.
87. *Id.* at 592.

[*Salinger*], leads to the inevitable conclusion that all copying from unpublished works is per se infringement."[88] Furthermore, he proposed that fair use might also be found when the materials quoted stood little chance of being published by the copyright owner.[89] In this instance, the concurring opinion revealed that troubling questions were raised by the power to suppress works which seemed to flow from the *Salinger* and *New Era* decisions. This opinion hinted that the court should not be so cavalier in laying down a rule appearing to be all-encompassing, especially in a situation in which the author intended to use copyright to suppress his unreleased works and any work derived from them.

On petition for rehearing,[90] the Second Circuit split 4-4.[91] The judges voting to deny rehearing failed to address the questions raised by Chief Judge Oakes' *New Era* concurrence regarding the suppression of unpublished works. The judges voting to grant rehearing emphasized the fact that the *New Era* language regarding unpublished works was dicta, and in no way committed the court to a position in which portions of unpublished works could never be copied.[92] Although both sides seemed to want to retreat from much of the language in the *New Era* majority opinion,[93] neither side addressed the troubling questions raised by the decision as to an author's ability to use copyright to prevent any public disclosure of a work.

D. *The Reaction to* Salinger *and* New Era

The writing and journalistic communities immediately realized the inherent problems flowing from the language in the *Salinger* and *New Era* decisions.[94] A noted historian wrote of the decision "there is a...danger...[t]hat important figures in our national experience, or their descendants, will stifle critical history or biography."[95] Editorialists argued that copyright law could now be used as a tool for censorship and suppression.[96] Other writers, however, applauded the decisions, arguing in

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88. *Id.* at 593.
89. *Id.* at 594.
90. *New Era Publication, Int'l v. Henry Holt & Co.*, 884 F.2d 659 (2d Cir. 1989).
91. *Id.* at 660.
92. See *id.* at 662-63.
93. *Id.* at 661.
94. See Lukas, *A Ruling That Hobbles Historians*, N.Y. Times, July 27, 1990, §A at 27; *Copyright Wrongs*, The Nation, Mar. 19, 1990 at 368, col. 2; *Copyright and Suppression*, Wash. Post, Feb. 22, 1990, at A22, col. 1; Yardley, *supra* note 9, at B2, col. 1.
95. Lukas, *supra* note 94, at col. 4.
96. See *Copyright Wrongs*, *supra* note 94, at 385; *Copyright and Suppression*, *supra* note 94, at A22, col. 2.

essence an author's absolute property right to his or her words.[97] Although the Second Circuit attempted to paint *Salinger* and *New Era* as simple fair use cases, the writing community recognized that these cases instead sanctioned the use of copyright as a means of suppressing the works of unauthorized critics and preventing all public revelation of the writer's own work. An immediate response was a number of cases in which writers strong-armed the suppression or revision of unauthorized biographies.[98] Instead of using copyright to yield economic reward, authors have now discovered its effectiveness as a means of stifling criticism.[99]

Congress reacted to the concerns expressed about the *Salinger* and *New Era* decisions, by proposing an amendment to the fair use provision of the Copyright Act.[100] The proposed legislation was only directed at eliminating the distinction between published and unpublished works in a fair use analysis;[101] it did not address the problem of suppression flowing from the *Salinger* and *New Era* decisions. Thus, an author who wished to prevent the disclosure of anything more than nominal quotations from his or her unpublished works, even those never intended for eventual publication, would have still been able to do so under the proposed amendment. That result stemmed from a notion that the author has some sort of property right in his or her writings, and therefore full power under the copyright law to withhold a work from public disclosure.[102]

Although there was substantial support for the proposed legislation from biographers, historians, and members of the publishing industry,[103] organized opposition from the computer software industry led to the demise of the legislation.[104] Despite attempts to amend the legislation to avoid computer industry concerns, the bill died in committee.[105] The *Salinger* and *New Era* decisions, therefore, remain completely intact; under these decisions authors very much retain a right to suppress their unpublished works from public revelation using the copyright law as a vehicle. Given

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97. See Wash. Post, Feb. 21, 1990, at A4, col. 4 (statement of Edmund Morris); *The Right Not to Be Published*, Chicago Tribune, Feb. 6, 1987, §1 at 22, col. 1.

98. See *supra* note 9.

99. *Id.*

100. See *Fair Use of Unpublished Works is Considered by Senate-House Panel*, 40 BNA's Pat., Trademark & Copyright J. 245 (July 19, 1990) (hereinafter *Fair Use Considered*). The legislation proposed an amendment to 17 U.S.C. §107 such that it would read "... the fair use of a copyrighted work, *whether published or unpublished*,...is not an infringement of copyright." (amendment italicized). *Id.*

101. *Id.*

102. *Id.* at 258 (statement of Judge Roger J. Miner).

103. *Id.* at 246-47.

104. See *Software Issue Kills Liberal Amendment to Copyright Law*, N.Y. Times, Oct. 13, 1990, §1 at 1, col. 1.

105. *Id.* at 11, cols. 1-2.

that the copyright law's express purpose is the "promotion of progress," the retention of this right brings into question the values that copyright is intended to serve.

III. THE VALUE AND PURPOSES OF COPYRIGHT

The conflicting monopolistic and public interest aspects of copyright law have made efforts to formulate a consistent concept of copyright largely unsuccessful.[106] One commentator has noted that "[n]o workable, unifying concept of copyright has yet been formulated."[107] Part of the difficulty in formulating a unifying theory of copyright is the limited number of historical sources regarding enactment of the constitutional clause on which copyright is based, and the reasons behind the clause.[108] Madison, however, did note that "[t]he public good fully coincides [in patent and copyright law] with the claims of [inventors and authors]."[109] This recognition of a public good element in copyright, coupled with the promotion of progress rationale in the constitutional text itself,[110] would certainly seem to indicate that copyright protection should not extend to the point where it encroaches on these interests.

The copyright law is, fundamentally, an economic incentive and reward system.[111] As classically conceived, and as it works in almost all practical circumstances, copyright is intended to allow the producers of written works to reap a financial return from the efforts expended in producing the works.[112] Underlying the scheme is the assumption that if the possibility exists that others can "free ride" on the author's efforts, the author could not recover the costs of his or her efforts, and therefore might be deterred from producing works.[113] The ultimate rationale justifying copyright is an attempt to avoid the danger that persons will be deterred from producing works that they might otherwise be capable of if it were not for the potential inability to fully recover the costs of production.[114]

Accordingly, copyright simultaneously serves two functions. The first, often called "reward", is the vesting of control of production of copies in

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106. See L. Patterson, Copyright in Historical Perspective 8 (1968).

107. *Id.* (quoting Ebenstein, *Introduction* to S. Rothenberg, Copyright Law xix-xx (1956)).

108. See Burchfiel, *Revising the "Original" Patent Clause: Pseudohistory in Constitutional Construction*, 2 Harv. J. Law & Tech. 155, 165 (1989); B. Bugbee, Genesis of American Patent and Copyright Law 129 (1967).

109. The Federalist No. 43, at 57 (J. Madison) (Legal Classics Library ed. 1983).

110. See U.S. Const. art. I, §8, cl. 8.

111. See generally Landes & Posner, *supra* note 4, at 326-29; Wiley, Jr., *supra* note 23, at 138-39.

112. See *id.* at 328.

113. *Id.*

114. *Id.*

the author, who may then determine the optimal quantity produced (and thus price obtained) to recover his or her costs of production.[115] The second, called "incentive" for the purposes of this discussion, is to provide a motivation for those capable of producing works to expend effort to produce the works, and perhaps to avoid less socially valuable pursuits. The benefits of reward vest solely within the author; because it grants a quasi-monopoly[116] in the hands of the author, little public benefit is derived from allowing the author to extract supranormal profits from consumers. If reward were the sole element of copyright, it would certainly be an objectionable scheme; it was the monopolistic aspects of reward with which early critics of copyright evidenced concern.[117]

Incentive, however, makes the copyright system on the whole desirable. Clearly, incentive carries with it a large element of public benefit; in the words of Madison, reward is the claim of the author, incentive is the public good with which it coincides.[118] Obviously, the public is willing to subject itself to the likelihood of having to pay supranormal prices for written works because the benefit it receives in kind is the production of as many works as are desired.[119] When, however, works are kept from the public, the incentive element of copyright is frustrated. If the author uses copyright as a means of suppression, and not as a means of reaping reward, the author gains valuable legal rights.[120] The public, however, receives no benefit from the use of copyright in this manner; in essence it gives the author a right without any quid pro quo in the form of exposure to the work. When copyright is not used for reward, but for suppression, the author-public bargain which supports copyright is destroyed.[121]

The public interest element which underlies copyright does, however, point out the inherent tensions between the interests of authors and the public in the copyright scheme. Clearly, a powerful and highly monopolistic copyright scheme would serve to provide the author with substantial economic and non-economic rewards. If the author can control any and all use of the work, he or she can recapture every portion of the economic

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115. *Id.* at 336.

116. The privileges granted an author under copyright are essentially quasi-monopolistic because the author does not have total control over the use of the work. See, *e.g.*, 17 U.S.C. §107.

117. See Jefferson, *Letter to James Madison (July 31, 1788)*, in 13 The Papers of Thomas Jefferson 443 (1956).

118. See The Federalist, *supra* note 109, at 57.

119. Copyright may, in fact, encourage the production of more works than the public may wish to consume. However, absent copyright, works that the public might otherwise desire may not be produced because of the lack of an adequate monetary reward due to free riding. See *supra* notes 3-8 and accompanying text.

120. I.e., the rights enumerated in §106.

121. For an explanation of the author-public bargain, see Patterson, *Free Speech, Copyright and Fair Use*, 40 Vand. L. Rev. 1, 7 (1987).

value of the work, as well as the personal or psychic value of suppressing works not desired for public distribution. For every measure that erodes this power, as in the example of the fair use defense, the author loses some control, and therefore presumably some of the incentive to produce the work in the first place. Therefore, if the incentive element is viewed as designed not to encourage public revelation of works, but instead simply the production of works, then unauthorized uses of the work should be severely curtailed. This would be especially true in the case of the work never intended for public distribution; such a work provides only personal or psychic value which presumably any unauthorized use would destroy. Accordingly, any legally sanctioned unauthorized use would quite possibly destroy the incentive to create the work in the first place.

Some commentators have argued that copyright is intended to encourage the mere production of works, as opposed to the production and public revelation of works.[122] From this position, it is argued that what flows is a privacy or absolute property right through copyright.[123] If copyright is indeed intended to encourage merely the production of works, then the right to use copyright to suppress works certainly follows. It is also possible to argue that this position does encompass an element of public interest.[124] Although the public at large under this rationale would be deprived of the benefits of works of an author,[125] each member of the public may individually benefit by knowing that they, too, will be able to capture the personal or psychic rewards of preventing public disclosure of their writings.[126] In no area is this more persuasively argued than in the case of private correspondence.[127] There seems to a strong visceral appeal to the argument that one should be able to prevent others from unauthorized public distribution and publication of one's private letters.[128] A reaction to this type of activity was one of the driving forces in the conception of a fundamental right to privacy which continues to stir much discussion in the field of constitutional law.[129] Because copyright protection inures to

122. See, *e.g.*, Kauffman, *supra* note 13, at 383. One author refers to this philosophy of copyright as "producer-oriented." See Wiley, Jr., *supra* note 23, at 139.

123. See, *e.g.*, Weinreb, *supra* note 13, at 1138-39; Kauffman, *supra* note 13, at 384, 387.

124. See Newman, *supra* note 15, at 477.

125. The work would eventually lapse into the public domain, but only after a period of 50 years after the death of the author. See *supra* note 74.

126. Copyright, if capable of use for suppressive purposes, presents an interesting conundrum. Each individual will wish highly restrictive powers for his or her own writings, while at the same time desiring less stringent protection for the works of others. See Landes & Posner, *supra* note 3, at 333.

127. See Newman, *supra* note 15, at 477.

128. See, *e.g.*, *id.* at 477 (arguing for protection of "private writings").

129. See Warren & Brandeis, *The Right to Privacy*, 4 Harv. L. Rev. 193, 199 (1890) (discussing privacy aspects of common law copyright).

the author of a private correspondence,[130] many have argued that it is therefore designed to protect privacy interests.[131] The personal and psychic rewards stemming from the use of copyright to serve privacy interests, according to this rationale, are important externalities flowing from the copyright scheme.

Fundamentally, the use of copyright as a tool for the suppression of works demonstrates two competing externalities which can flow from copyright protection: the increase in public knowledge and encouragement of further works stemming from full distribution of works[132] versus the personal and psychic benefits to individuals gained by allowing them to keep their own works from public disclosure. Each of these externalities can be compellingly argued as important to the copyright scheme. However, copyright's constitutional purpose is the promotion of progress. Advancing private interests through copyright does not serve this value. Given that private personal or psychic interests are protectable through other legal regimes,[133] urging the use of copyright to protect these values seems less compelling. Copyright, in the end, should be a scheme which encourages the author to promptly reveal his or her works to the public. This is precisely the manner in which the patent scheme operates.[134] Because of the close links between the purposes of the patent and copyright law,[135] it seems rational that copyright law should treat suppression in manner similar to the patent law.[136]

IV. SUPPRESSION AND THE PATENT LAW: TOWARDS THE "PROMOTION OF PROGRESS"

The fact that copyright and patent law are derived from the same constitutional clause is certainly not an accident of history.[137] Both realms

130. The author of a letter loses property rights to the letter upon mailing, but retains the copyright in the letter. See Hauhart, *Copyrighting Personal Letters, Diaries and Memorabilia: A Review and a Suggestion*, 13 U. Balt. L. Rev. 244, 247 (1984).

131. *Id.* at 273.

132. One author has referred to this philosophy of copyright as "consumer-oriented." See Wiley, Jr. *supra* note 23, at 139.

133. For example, state privacy or contract law. See Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1129 n.108 (1990) (discussing state privacy law protections).

134. See *infra* notes 137-79 and accompanying text.

135. See U.S. Const. art. I, §8, cl. 8; Gordon, *Fair Use as Market Failure: A Structural Analysis of the Betamax Case and its Predecessors*, 82 Colum. L. Rev. 1600, 1611 (1982).

136. At least one author has argued that the "school of patent law" provides an ideal vehicle for analyzing copyright, because patent law acts as a clear and logical means for encouraging innovation, whereas copyright often does not. See Wiley, Jr., *supra* note 23, at 140.

137. But see Kauffman, *supra* note 13, at 387 (calling the inclusion of patent and copyright in the same constitutional clause an "historical accident").

of protection are driven by virtually identical economic considerations.[138] Both the reward and incentive elements of copyright law are present in the underlying rationale behind the patent law.[139] Yet under the patent law, attempts by an inventor to suppress undisclosed creations are not treated as if excused because of other rights stemming from the scheme itself. In fact, the patent law generally prevents an inventor from obtaining patent rights when it can be shown that the inventor attempted to keep the work from prompt public disclosure.[140]

There are three doctrines in the patent law, "abandonment," "suppression," and "concealment," which may effect the rights of an inventor to a patent when the invention is withheld from prompt public disclosure.[141] Although each of these doctrines have now been codified under section 102 of the Patent Act, they have a long history preceding the act.[142]

A. *Patent Abandonment*

Under section 102(c) of the Patent Act, a person is entitled to a patent unless he or she "has abandoned the invention...."[143] Historically, this section has been used to prevent patenting of an invention when an inventor fails to further prosecute an already-filed patent application,[144] but it may also be applied against the inventor who fails to file within a reasonable time after completion of the invention.[145] The Supreme Court, in the early case of *Kendall v. Windsor*[146] discussed the underlying reasons behind what now constitutes section 102(c). Faced with a patentee who spent eight years after completion of his invention using it in secret before applying for a patent, the Court stated:

> [T]he limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public...was another and doubtless the primary object in granting that monopoly. This was at once the equivalent given by the public for the benefits...[of] the skill of [inventors], and the incentive to

138. See Gordon, *An Inquiry into the Merits of Copyright: The Challenges of Consistency, Consent and Encouragement Theory*, 41 Stan. L. Rev. 1343, 1348 (1989).

139. See Eisenberg, *Patents and the Progress of Science: Exclusive Rights and Experimental Use*, 56 U. Chi. L. Rev. 1017, 1024 (1989).

140. See *infra* notes 145-72 and accompanying text.

141. See 35 U.S.C. §§102(c), (g) (1988).

142. See generally 2 D. Chisum, Patents §6.03 (1990).

143. 35 U.S.C. §102(c).

144. See 2 D. Chisum, *supra* note 142, §6.03[2] at 6-138 to -139.

145. *Id.*, §6.03[1][c][ii] at 6-136 to -137.

146. 62 U.S. (21 How.) 322 (1858).

> further efforts....[I]t follows...that the inventor who designedly...withholds his invention from the public...comes not within the policy or objects of the Constitution or acts of Congress.[147]

Thus, in an instance in which an inventor suppressed his invention from public disclosure until such time as another wished to bring it into the market, and then attempted to obtain and enforce a patent grant, the Court remarked: "[a person] may forfeit his right as an inventor by wilful or negligent postponement of his claims, or by an attempt to withhold the benefit of his improvement from the public...."[148]

An inventor, therefore, is under a degree of compulsion to disclose his invention in the form of an application for patent or possibly lose all patent rights.[149] The inventor is given a degree of latitude in applying for patent, and may keep it secret for a small period of time, but "that privilege has its limits, for [the inventor] may conceal [the invention] so long that he will lose his right to a patent even though [it is never publicly revealed][150] at all."[151] This rule is part of the patent scheme because "the consideration for a patent [is] that the public shall as soon as possible begin to enjoy the disclosure [of the invention]."[152]

B. *Patent Suppression or Concealment*

The importance of prompt public disclosure as a crucial element in the granting of patent rights is perhaps more clearly illustrated under the doctrines of "concealment" or "suppression" as they relate to priority contests. A priority contest (often called "interference") is the procedure whereby the right to a patent is determined between two competing inventors claiming the right to substantially similar inventions.[153] In the typical interference situation, two inventors with very similar or identical inventions will have filed applications within a short period of time from

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147. *Id.* at 327-28.

148. *Id.* at 329.

149. Although some cases intimate that mere delay in filing may not constitute an abandonment, see 2 D. Chisum, *supra* note 142, §6.03[1][c][ii] at 6-137 n.25, intentional failure to file would appear to most certainly lead to abandonment. *Id.* at n.26. But see Paulik v. Rizkalla, 760 F.2d 1270, 1282 (Fed. Cir. 1985) ("[a]n inventor may delay as long as he likes, in the absence of commercialization.") (Rich, J. concurring).

150. Public use or sale of an invention before an application for patent is filed may also result in a bar to patentability. See 35 U.S.C. §102(b).

151. Metallizing Eng'g Co. v. Kenyon Bearing & Auto Parts Co. 153 F.2d 516, 520 (2d Cir.), *cert. denied* 328 U.S. 840 (1946).

152. *Id.*

153. See R. Hildreth, Patent Law: A Practitioner's Guide 107-108 (1988).

each other.[154] Because the United States (as opposed to almost every other country in the world) does not give patent rights based solely on the first inventor to file an application,[155] intricate procedures have been developed to determine the "first to invent".[156] The person determined to be the first to invent gets the exclusive rights under the patent law.[157] However, under section 102(g) of the Patent Act, an inventor who is not the first to invent may still be entitled to patent rights if it can be shown that the actual first inventor concealed or suppressed the invention.[158]

The effects of suppression or concealment on patent rights in an interference contest is illustrated in the leading case of *Mason v. Hepburn*.[159] Mason had conceived and constructed an improved gun clip in 1887, but did not immediately file for a patent, and eventually forgot about his invention.[160] In 1894, after discovering that Hepburn had filed an application for an identical clip, Mason filed for a patent, and claimed priority as the first to invent.[161] The court, however, awarded priority to Hepburn as the "first to invent."[162] In doing so the court cited the discussion of the public interest aspects of patent law as espoused in *Kendall*, and stated that:

> Considering...[the] paramount interest of the public...it imperatively demands that a subsequent inventor...who has diligently pursued...a patent...shall, as against that other, who has deliberately concealed the knowledge of his invention from the public, be regarded as the real inventor and as such entitled to his reward.[163]
>
> The...doctrine...lies in the policy and spirit of the patent laws and in the nature of the equity that arises in favor of him who gives the public the benefit of the knowledge of his invention...that which...all others have been led to believe has never been discovered, by reason

154. *Id.*

155. See 3 D. Chisum, *supra* note 142, §10.01.

156. See generally 3 D. Chisum, *supra* note 142, §10.09. One commentator has called patent interference practice "the blackest of the black arts." Wobensmith, II, *Proof of Who is the First Inventor: Some Special Problems in Patent Interference*, in Dynamics of the Patent System 155 (1960).

157. *Id.* at §10.01.

158. See 35 U.S.C. §102(g).

159. 13 App. D.C. 86 (1898).

160. See *id.* at 87-88, 91.

161. *Id.* at 88-91.

162. *Id.* at 94. Although, in a practical sense Mason was still the first to invent, Hepburn was granted the legal status of "first to invent" because of the activities of Mason.

163. *Id.* at 95.

of the indifference, supineness, or wilful act of one who...discovered it long ago.[164]

This discussion most certainly indicates a paramount concern not with rewarding the one who first conceived a new invention, but instead the person who first took steps to bring this invention to public awareness. It is therefore quite evident, as in the case of abandonment under section 102(c), that prompt public disclosure of an inventor's creations is of paramount importance to the patent scheme. The primary importance of prompt public disclosure in patent law is even more evident from the holding and language of a recent Federal Circuit[165] interference dispute decision, *Paulik v. Rizkalla*.[166]

Paulik concerned a first inventor who waited four years between completion of his invention and filing for a patent.[167] The second inventor filed after the first began preparing his application, but argued that the four year delay constituted a prima facie suppression or concealment, thus negating the first inventor's claim.[168] The court rejected this argument, although it restated the view that an inventor's priority could be extinguished in the case of "intentional concealment or an unduly long delay...."[169] However, in this case, where neither factor existed, it was important that the first inventor's filing was not spurred by the second inventor's activities, and in fact preceded them.[170] In essence, although there was a delay before filing, the first inventor was still the "first to be on the way to giving the public the benefit of the invention."[171]

Both *Mason* and *Paulik* demonstrate how crucial promptness of public disclosure is in the overall scheme of rewarding inventors through the granting of patent rights. In both of these cases, the party ultimately rewarded was the one who was the first to take steps to reveal a discovery to the public. The proscriptions of section 102(c) further demonstrate that the primary concern of the patent law is to require those who wish powerful economic rights to fulfill their bargain with the public. The consideration in that bargain is prompt public disclosure.[172]

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164. *Id.* at 96.

165. Because the Court of Appeals for the Federal Circuit hears all appeals of cases arising under the federal patent law, see 28 U.S.C. §1295(a)(1) (1988), Federal Circuit decisions have a substantial impact on the shape of the patent law. See R. Harmon, Patents and the Federal Circuit vii (1988).

166. 760 F.2d 1270 (Fed. Cir. 1985).

167. See *id.* at 1271.

168. *Id.* at 1272.

169. *Id.* at 1274.

170. *Id.* at 1280 (Rich, J. concurring).

171. *Id.* at 1281 (Rich, J. concurring).

172. See United States v. Dubilier Condenser Corp., 289 U.S. 178, 186 (1932).

C. *Patent Disclosure Requirements*

The type of disclosure which results in the granting of exclusive rights under the patent law is an important aspect of the overall patent scheme. Under section 112, the patent document must describe the invention itself, the manner and process of making and using the invention, and the best mode of carrying out the invention.[173] A disclosure found to be inadequate can lead to a loss of patent rights.[174] This requirement serves many purposes, but an important purpose is that it immediately increases the storehouse of public information available for further research and innovation.[175] The requirements under section 112 can provide more detailed factual information about emerging technologies than may be available through other channels.[176] Because patent disclosures are also classified according to subject matter and technology, information about a particular area of technology can be gathered using patent disclosures with less effort than through other means.[177] Accordingly, public disclosure through patenting can have a significant effect in spurring and promoting the efforts of others in the field, thus enhancing technological progress even before the patent itself expires.[178] A delay in disclosure, or an insufficient disclosure, inhibits this process, and may prevent the building of new technologies on the teachings of current technology.[179] Therefore, the requirement of a prompt and adequate public disclosure directly serves the constitutional purpose of the patent law, the promotion of progress.

An inventor who desires to keep an innovation from the public is, of course, free to do so if he or she so chooses. Many states offer protection of innovations by means of trade secret law.[180] However, maintaining an innovation as a trade secret, rather than filing for patent protection, will generally bar an inventor from subsequently filing for patent protection under section 102(b) of the patent act.[181] Once the invention becomes "in public use or sale," [182]the inventor must file for patent protection within

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173. See 35 U.S.C. §112; 3 D. Chisum, *supra* note 142, §7.01.

174. See, *e.g.*, Grant v. Raymond, 31 U.S. (6 Pet.) 218, 247 (1832).

175. See 3 D. Chisum, *supra* note 142, §7.01.

176. See J. Klooster, The Granting of Inventive Rights 41-42 (1965).

177. *Id.*

178. Because the patent document is published immediately upon issuance, the public has the benefit of its technological disclosures long before the invention itself lapses into the public domain. See Chisum, *Comment: Anticipation, Enablement and Obviousness: An Eternal Golden Braid*, 15 AIPLA Q. J. 57, 59 n.5 (1987).

179. See Eisenberg, *supra* note 139, at 1055.

180. See 2 M. Jager, Trade Secrets Law pt. B (1990).

181. See 35 U.S.C. §102(b); 1 M. Jager, *supra* note 180, §10.01[4] at 10-9.

182. 35 U.S.C. §102(b).

a year, or lose all rights to patent protection.[183] Therefore, once the trade secret is used to produce a commercially exploited product, the inventor must promptly file for patent protection or risk a permanent bar from receiving a patent, even if the commercialization does not reveal the secret.[184] The interface between trade secret protection and the above bars to patentability further demonstrate the importance of prompt public disclosure as key to the inventor-public bargain. An inventor is free to choose not to give the public the benefit of his or her innovation, and may even profit from this choice, but may not in return expect the public to later provide valuable exclusionary rights under the patent law.[185]

In summary, the various provisions of the patent law dealing with the abandonment, suppression and concealment of inventions, coupled with patent disclosure requirements, demonstrate that the patent scheme is designed primarily for encouragement of the prompt disclosure of new innovations so that the works of others may build from this disclosure. Although the patent scheme clearly also serves the functions of rewarding innovators economically and providing incentive for further innovation, these functions are not of superior importance. The patent scheme is, at its core, a bargain between the public and the inventor; the inventor gets valuable and powerful exclusionary rights, but in return must give the public full and prompt disclosure of his or her innovations. This allows the promotion of technological progress by increasing the public storehouse of knowledge and spurring others to build from this storehouse. An inventor who attempts to suppress discoveries has not fulfilled his or her part of the bargain, and therefore is not entitled to the protections afforded a patent holder.

V. COPYRIGHT AND SUPPRESSION: LESSONS FROM THE PATENT LAW

A patent holder clearly has no means of suppressing the teachings of his or her innovations from the public; the issuance of a patent requires the public circulation of the substance of the discovery or creation.[186] Furthermore, an innovator who intentionally withholds a discovery from the

183. See *id.*

184. See W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1550 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

185. The inventor is still eligible for the protective rights flowing from trade secret law, but the protection is limited to the prevention of disclosure of the secret through commercially unethical means. See 1 M. Jager, *supra* note 180, §1.03 at 1-8. Therefore, trade secret is a weakened form of protection relative to patent, because it does not protect the innovation itself, only the means by which the defendant acquired access to it.

186. See 37 C.F.R. §1.11(a) (1990).

public to prevent its revelation will thereafter be ineligible for patent protection.[187] This, however, is not the case when dealing with the activities of a copyright holder. Under the rationale of *New Era* and *Salinger*, a copyright holder has the right to expect that if he or she simply does not want the public to ever be exposed to certain writings, the copyright law can be used as a powerful tool for this purpose.[188] Even if Congress amends the fair use provisions of the Copyright Act to eliminate the distinction between published and unpublished works, this power will still be very much intact.[189] If the patent law can be thought of an analogue to copyright law, this result is incongruous. What follows, therefore, is a discussion of the manner in which suppression through copyright might be treated if viewed through the lens of the patent law.

A. *Copyright and suppression through the lens of the patent law*

The factual differences between *The Nation* and *Salinger/New Era* perhaps most clearly illustrate how the patent analogue would work in the copyright suppression context. In *The Nation*, the author was in the process of preparing and refining his work for public revelation and widespread distribution.[190] This situation is quite similar to the typical patent situation in which an inventor goes from conception to reduction to practice of an invention, followed by prompt drafting and filing of a patent application.[191] In such a situation, the inventor is subject to none of the bars to patentability under the Patent Act, and may afterwards be granted and be able to enforce patent rights against an infringer. Therefore, in a situation like *The Nation*, in which the author fully intends to comply with the public-author bargain by prompt disclosure, a suit for copyright infringement should lie, with a very limited scope to the fair use defense.[192]

However, in a *New Era/Salinger* situation, when it is clear that the author intends to withhold the work completely from public disclosure, copyright protection should be denied. Just as the patent law refuses protection to the inventor who attempts to wilfully abandon, suppress, or

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187. See *supra* notes 143-152 and accompanying text.

188. See *supra* note 63-85 and accompanying text.

189. Because the bill recently considered by Congress only dealt with the fair use provision as it relates to unpublished works, see *Fair Use Considered*, *supra* note 100, at 245, the author would have still been able to prevent disclosure of a work in its entirety, and would only have been restrained from suppressing fairly limited quotations from the body of the work.

190. See *The Nation*, 471 U.S. at 543.

191. See R. Hildreth, *supra* note 153, at 4.

192. Because a fair use can substantially harm the author's valuable rights of first publication. See *The Nation*, 471 U.S. at 549.

conceal an invention from the public, so should the copyright law refuse to grant exclusionary rights to one who refuses to fulfill his or her end of the public-author bargain. The author should be free to protect the work from public revelation by other legal schemes, including state privacy and contract law, but would be constrained to the limited scope and powers inherent to these schemes.

B. *The problem of mandatory publication*

Under the patent law, once an inventor discloses an invention and is granted patent protection, he or she is free to distribute the invention described in the patent as he or she sees fit. The invention may be completely suppressed from distribution if the inventor so desires.[193] This power demonstrates that patent law is primarily geared toward the distribution of knowledge and not goods. Because the knowledge flowing from the innovation (contained in the patent document disclosure) is severable from the innovation, the advancement of public knowledge may be served without ever distributing the invention. Others are able to learn from, and expand upon, the innovation without having access to the innovation itself, because the knowledge contained in the innovation is revealed in the patent document.[194] Under the copyright law, however, the distribution of the knowledge that comes with copyright protection cannot be severed from the good itself; one cannot reveal the contents of a book to the public at large without distributing the book. Therefore, uncoupling mandatory public disclosure from forced publication presents certain conceptual difficulties.

Certainly, forced publication of all works copyrighted would serve the public interest in exposure to new writings. Such a scheme would, however, undermine the reward element of copyright law. When an author is forced to publish, his or her ability to control output and price are undermined. Accordingly, forced publication, even if de minimis, would not be a solution to the problem of allowing public access to works. However, under the current copyright scheme, an author is required to deposit a copy of the work with the Copyright Office before a suit for infringement can proceed.[195] A modification of this requirement may be ideal in encouraging public access to work without forcing publication on authors.

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193. See Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 429-30 (1907).

194. See *supra* notes 173-179 and accompanying text.

195. See 17 U.S.C. §§411(a), 410(a). However, under the latest amendments to the copyright law, this requirement applies only to U.S. authors and authors from countries not adhering to the Berne Convention. See W. Strong, The Copyright Book: A Practical Guide 85 (1990).

C. *Copyright and Suppression: A Proposed Solution*

Just as in the patent law, copyright should encourage prompt disclosure of innovations in a place of public access. Therefore, an author should be required to deposit a copy of the work not when the protections of copyright are desired, but instead within a reasonable period of time after completion of the work. Just as in the patent context, this would allow members of the public interested in the latest works of a certain author or in a certain area immediate access, without placing economic burdens on the author. To ensure public access to the work, the current requirement that all published works also be deposited in the Library of Congress[196] should be expanded to require unpublished works to likewise be deposited. The three month limit between publication and depositing in section 407[197] would be expanded to require depositing of an unpublished work within eighteen months[198] of its completion. This period would allow the author an ample period with which to prepare the work for eventual publication before requiring mandatory public access to the work. A work so deposited would be subject to the same protections, and limitations to these protections, as any copyrighted published work.[199] Any unauthorized copying of the work within the eighteen month period would be completely curtailed, to prevent the co-opting of first publication rights.

An author who does not deposit a work would, eighteen months after the work is completed, be considered to have abandoned or concealed the work, and therefore not entitled to copyright protection. Such an author would be limited to pursue unauthorized copiers through state privacy or contract remedies. However, just as when a trade secret is uncovered, once an abandoned or concealed written work is revealed, it would be treated as if having lapsed into public domain, and free for all to use.[200] Because of the danger of this happening, and the less stringent protections of privacy and contract law, such a rule would encourage prompt filing of works with the Copyright Office.[201] The desirable result of increasing public access

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196. See 17 U.S.C. §407(b); 37 C.F.R. §202.19(a).

197. See 17 U.S.C. §407(b).

198. An eighteen month period has been chosen to reflect the period of time required to transform a completed work to published form, plus a period for preparing the work for copyright filing (reflected now in the three month period of §407). This period could be changed according the actual average time such a process takes in the publishing world.

199. See 17 U.S.C. §§106, 107.

200. See 1 M. Jager, *supra* note 180, §6.03[1] at 6-5 (discussing the loss of trade secret protection upon public disclosure). Unauthorized copiers would not be entitled to copyright the copied work, even though they were the first to bring the work to public attention. Just as in the patent law, see 35 U.S.C. 102(f), one who did not create a work could not be entitled to exclude others from using the work. The work therefore would lapse into the public domain.

201. Incentives for the prompt registration of works in the Copyright Office are already a part of the current copyright scheme. See generally Strauss, *Beat the Clock: The Effect of Section 412 of the*

to works would be furthered, without forced publication.

A work deposited under the above scheme would be accorded all the protections which published works now get under the copyright law. The author of the work would be allowed to control when, where, and to what extent the work is eventually published. The fair use provisions of 17 U.S.C. §107 would still apply, so that limited quotation from the work for scholarly, critical, or biographical uses would still be possible. The public would have access to the deposited work as it would with any other deposited copyrighted work.

D. *Operation of the Proposed Solution*

The factual circumstances surrounding *The Nation*, *Salinger*, and *New Era* can serve to illustrate the manner in which the above system would operate. In *The Nation*, the copyrighted material involved was still in the process of editorial revision; under the above scheme this work would be considered a "work in progress" which would allow complete suppression of any unauthorized copying. Once the work was reduced to completed form, for example in the form of galley proofs, the author would have a period of eighteen months in which to deposit the completed work with the Library of Congress. During the eighteen month period, the author would continue to have the right to complete suppression of any unauthorized copying or publication, since such copying would be considered a de facto co-opting of the right of first publication. After the expiration of the eighteen month period, the deposited work would be considered de facto "published," and other authors and publishers would be able to quote from the work without permission only to the extent allowed under the fair use provisions of 17 U.S.C. §107. This would occur whether the work was actually published or not.

If a work was not deposited within eighteen months after completion, the copyright protection of the work would lapse; to guard against unauthorized publication or quotation, the author would have to resort to the protections of breach of contract or privacy remedies under state law. Thus in *Salinger* and *New Era*, in which the letters involved had been completed[202] many years before the unauthorized quotation, there would be only a cause of action for breach of privacy, unless the letters (or copies of them) had been deposited with the Copyright Office within eighteen months of completion. Accordingly, under this scheme it would be to a letter writer's advantage to either deposit any letters later contemplated for publication, or ensure by contractual or privacy law means that the letters

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Copyright Act on Post-Infringement Registration, 72 J. Pat. & Trademark Off. Soc'y 1006 (1990).

202. In the case of unpublished correspondences, "completion" would be established when the letter is mailed.

were not revealed to others.

VI. CONCLUSION

The above outlined scheme would still allow full control of the production of copies of an author's work by the author. It would also require little change in the copyright scheme as it now stands, simply requiring the author to deposit works at a publicly accessible place earlier than is now required. Because this scheme conforms substantially with the procedures now required of inventors requesting patent protection, it hardly seems objectionable as requiring too much from the creator of a written work.[203]

Copyright is not an absolute right of the author only. It is not intended to serve as the guardian of the author's reputation or privacy; other legal regimes are designed for that. Copyright's principle rationale is the expansion of public knowledge and intellectual progress. An author should recognize that there is a dose of duty required from him or her in return for the powerful protections of copyright. A prompt deposit and disclosure requirement is a small price to pay for these protections.

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203. One author who has studied copyright law through the lens of the patent law has suggested that copyright protection should not be allowed for unpublished private correspondences. See Wiley, Jr., *supra* note 23, at 152-53. This suggestion is based on the notion that economic incentive is not required for most letter-writing activities; an exception, however, would be made for letters written by "unusual authors" who may have kept (and presumably written) letters for later publication. *Id.* at 153. This "exception," however, seems fraught with the potential for unpredictable value judgments being later made by judges or juries based on the notoriety or success of an author. The potential uncertainty of an outcome under this exception might cause a stifling of incentive for lesser-known authors producing correspondences that the public would desire in published form. By adopting a deposit requirement for all unpublished works, there would be no need for the formulation of an exception.