Introducing the Association's 82nd President .......................... 3
President's Page .............................................. 5
Washington Letter
Intellectual Property and Trade .................................. 14
Mid-Winter Meeting, January 31-February 3, 1990
Thirteenth Annual Institute—The Art
of Negotiation and Conciliation .................................. 18
Annual Meeting Luncheon Speeches
Commissioner Michael Lane ................................. 33
Honorable Roger J. Miner ........................................ 37
Annual Meeting Plenary Session
Recent Case Law Developments ............................ 44
Annual Meeting Committee Reports ......................... 68
Patent and Trademark Office Affairs ................. 90
Copyright Office Affairs ..................................... 92
AIPLA BULLETIN

OFFICERS 1988-1989

WILLIAM S. THOMPSON .................................................. President
100 N.E. Adams Street, Peoria, IL 61629-6490

JEROME G. LEE .......................................................... President-Elect
345 Park Avenue, New York, NY 10154

I. FRED KOENIGSBERG .................................................. First Vice President
One Lincoln Plaza, New York, NY 10023

WILLIAM L. LA FUZE ................................................. Second Vice President
2912 First City Tower, 1001 Fannin, Houston, TX 77002-6760

MARGARET A. BOULWARE ............................................. Secretary
One Riverway, Suite 1100, Houston, TX 77056

WILLIAM T. MC CLAIN ............................................... Treasurer
1775 K Street, NW, Suite 600, Washington, DC 20006

MICHAEL W. BLOMMER ............................................. Editor
2001 Jefferson Davis Highway, Suite 203, Arlington, VA 22202

BOARD OF DIRECTORS

(Terms Expire October 1990)

JACK C. GOLDSTEIN .................................................. 750 Bering Drive, Suite 400, Houston, TX 77087
ROBERT A. ARMITAGE .................................................. 301 Henrietta Street, Kalamazoo, MI 49001
ROBERT L. BAECHTOLD ............................................... 277 Park Avenue, New York, NY 10172
WILLIAM H. ELLIOTT, JR. ............................................ 2600 One Reading Center, 1101 Market Street, Philadelphia, PA 19107
ALBERT ROBIN .......................................................... 330 Madison Avenue, New York, NY 10017

(Terms Expire October 1991)

GARY A. SAMUELS ...................................................... 551 Paper Mill Road, Newark, DE 19714
ROBERT G. STERNE .................................................... 1225 Connecticut Avenue, NW, Suite 300, Washington, DC, 20036
HOGE T. SUTHERLAND ............................................... 2001 Jefferson Davis Highway, Suite 1001, Arlington, VA 22202
JANICE E. WILLIAMS .................................................. One Franklin Plaza, Philadelphia, PA 19103

(Terms Expire October 1992)

DONALD S. CHISUM .................................................... 1914 N. 34th Street, Suite 400, Seattle, WA 98103
WALTER N. KIRN ...................................................... P.O. Box 33427, St. Paul, MN 55133-3427
DON W. MARTENS .................................................... 620 Newport Center Drive, 16th Floor, Newport Beach, CA 92660
RICHARD C. WITTE ................................................... 5299 Spring Grove Avenue, Cincinnati, OH 45217-1087

Councilman to NCIPLA

LEONARD B. MACKEY .................................................. 320 Park Avenue, New York, NY 10022

Published from the Association Offices, 2001 Jefferson Davis Highway, Suite 203, Arlington, Virginia 22202. Domestic Subscription Rate $40.00 per year. Foreign Subscription Rate $70.00; $6.00 per copy.
# Table of Contents

Introducing the Association’s 82nd President ......................................................... 3  
President’s Page ........................................................................................................ 5  
1990 Robert C. Watson Award Competition .......................................................... 7  
1990 Giles Sutherland Rich Moot Court Competition ............................................. 8  
Bicentennial Celebration ....................................................................................... 9  
Washington Letter
  Intellectual Property and Trade ........................................................................... 14  

Association Activities
  Mid-Winter Meeting Program, January 31-February 3, 1990 ............................... 18  
  Membership Applications ..................................................................................... 21  
  News of Members ............................................................................................... 26  
  Deaths ................................................................................................................ 26  

Annual Meeting, October 18-20, 1989
  Business Meeting .............................................................................................. 27  
  Passing the Gavel ............................................................................................... 28  
  The President Presides ...................................................................................... 30  
  Luncheon Speakers:
    Thursday, October 19 – Commissioner Michael Lane .................................. 33  
    Friday, October 20 – Honorable Roger J. Miner ........................................... 37  

Plenary Session—Friday, October 20, 1989
  Recent Case Law Developments
    Moderator: I. Fred Koenigsberg ....................................................................... 44  
    Copyrights
      Robert J. Bernstein ......................................................................................... 44  
    Patents
      Donald S. Chisum ............................................................................................ 51  
    Trademarks
      Kenneth B. Germain ...................................................................................... 57  
    World Intellectual Property Practice
      John P. Sinnott ............................................................................................... 65  

Committee Reports
  Amicus ................................................................................................................ 68  
  Antitrust Law ...................................................................................................... 68  
  Awards ................................................................................................................ 69  
  Chemical Practice .............................................................................................. 70  
  Committees and Long Term Planning .................................................................. 71  
  Continuing Legal Education ............................................................................ 71  
  Copyright Law ................................................................................................... 72  
  Economics of Law ............................................................................................. 73  
  Federal Litigation .............................................................................................. 73  
  Government Intellectual Property Policy ........................................................... 74  
  Interference ........................................................................................................ 74  
  Information Retrieval ....................................................................................... 74  
  International and Foreign Law ........................................................................... 78  
  International Trade Commission ........................................................................ 82  
  Licensing ........................................................................................................... 83  
  Relations with the PTO .................................................................................... 84  
  Patent Law ......................................................................................................... 86  
  Plant Variety Protection ..................................................................................... 86
MR. GOLDSTEIN: We have a very distinguished group at our head table today. I think this is the first time we've had a trilateral conference at the head table of an AIPLA meeting. On my far left and your right is Bill LeFuze, our second vice president. Next to Bill is Ralph Oman, Register of Copyrights. Next to him is Jerry Lee, our president-elect. Next to Jerry is Paul Braendli, the president of the European Patent Office. Next to him is Mr. Fumitake Yoshida from the Japanese Patent Office—the head of the Japanese Patent Office. And next to him is Bill Thompson, our president in about 30 minutes.

On the far end, Mike Blommer, our Executive Director. Joe DeGrandi, our immediate past president. Donald Quigg, United States Commissioner of Patents and Trademarks. Fred Koenigsberg, our first vice president and the officer in charge of an excellent program and we're just about to have the zenith of it today.

I do want to introduce a few people in the audience. From the Court of Appeals for the Federal Circuit, Judge Giles S. Rich, and Judge Pauline Newman.

From the Patent and Trademark Office, Jeffrey Samuels, Assistant Commissioner for Trademarks.

And once again, Mr. Patent and Trademark Office, Isaac Fleischmann.

This afternoon the commissioners are going to join us and, in addition, from the JPO is Keisuke Shimizu, Director of International Affairs, from JPO.

And Takao Marui—I'm not sure if I'm getting the pronunciations exactly correct—Director of Research from JETRO.

Ulrich Schatz is the Principal Director for International Affairs of the European Patent Office.

And Renata Remandas, Vice President for International and Legal Affairs of the European Patent Office.

Now, as it has been in our custom in the past, we take this opportunity at this particular luncheon to honor some of the examiners who have contributed so much to the success of our intellectual property systems. For the first time this year we have some copyright examiners with us, selected by the Copyright Office, in four different areas. I am going to read one of the certificates and ask when I call the recipient's name just to stand, and I'm going to hold off giving the certificates until afterwards, and will present the certificates when I can hold you for a photograph session.

The certificate reads, "The American Intellectual Property Law Association recognizes the outstanding contributions of (the recipient) to the integrity of intellectual property law while in distinguished service of the Copyright Office." From the Copyright Office—I'd like each of them to stand—John Ashley, from the Visual Arts Section.

Victoria Miklos-Vego, from the Literary Section.

Wilda Heiss, from the Performing Arts Section. She's not here. I'm sorry.

And Helen Walker, from the Renewal Section.

From the PTO, we have similar certificates from the trademark group, from Law Office Number 4, Glen Mayershoff.

From Law Office Number 6, Mary Kay McDonald.

That's an interesting combination, the trademark people sit with the copyright people, and I'll bet you all the patent people are sitting together—From the Patent Examining Corps, from Group 110, Theodore Morris.

From Group 120, Robert Gerstl.

From Group 130, and I'm going to take a stab at this, Peter A. Hruskoci. Sorry about that.

From Group 150, Edward J. Smith. That's a little easier.

Group 180, Howard E. Schairn.

Group 210, George H. Miller, Jr.

Group 230, David H. Malzahn.

And I'm not sure that I understand the notation on this—Groups 220 and 290, apparently—Susan J. Lucas. I can't even find out the answer to that.

Group 240, Philip R. Ceo.

Group 250, John D. Lee.

Group 260, Leo H. Boudreau.

Group 310, Sherman D. Basinger.

Group 320, Joseph H. McGlynn.

Group 330, Richard J. Johnson.

Group 340, Tony M. Argenbright.

There we have a man of all seasons—a patent examiner sitting with the Copyright Office examiners and the trademark examiners.

Group 350, Andrew V. Kundrat.

Our speaker for the day is going to give us an outstanding talk. From the United States Court of Appeals for the Second Circuit, Judge Roger J. Miner is going to speak today on "Exploiting Stolen Property: Fair Use or Foul Play?" I think most of the audience are—if you were there at the CLE this morning—warmed up based on the report of the New Era case. There's a few sparks flying in another court besides the Federal Circuit—excuse me, he's back. Let me in-
troduce one more. Judge Paul Michel, from the Court of Appeals for the Federal Circuit.

There have been some sparks flying on the Second Circuit over the proper application of the doctrine of fair use and, of course, that's a very simple doctrine so we don't understand why everyone doesn't agree about that.

Judge Miner has an outstanding background. He graduated from State University of New York with a Bachelor of Science degree and from New York Law School, where he received his LL.B. cum laude in 1956. He was the managing editor of the Law Review there. Upon graduation he went into the army for three years and served as a first lieutenant in the Judge Advocate General Corps in Japan and Korea.

JUDGE MINER: Thank you, Mr. President, and distinguished guests at the head table, distinguished members of the American Intellectual Property Law Association, guests, ladies and gentlemen.

EXPLOITING STOLEN TEXT: FAIR USE
OR FOUL PLAY?*
Roger J. Miner**

The doctrine of fair use in copyright law presently permits the exploitation of unpublished, copyrighted text stolen from an author or one in lawful possession. This anomaly in the law is a creature of the Copyright Act and should be eliminated by appropriate statutory amendment. The outright theft of intellectual property ought not to be condoned by Congress. In any case where an author has not published or publicly disseminated his or her copyrighted material, there simply is no reason to allow the use of that material without the author's consent.

In his Commentaries on the Laws of England, Sir William Blackstone described the rights of authors in their original compositions as "species of property grounded in labour and invention." The rule in 1766 England, according to Blackstone, was that "[w]hen a man by the exertion of his rational powers has produced an original work, he has clearly a right to dispose of that identical work as he pleases, and any attempt to take it from him, or vary the disposition he has made of it, is an invasion of his right of property." Copyright was recognized in the common law as well as by the Statute of Anne, which, according to Blackstone, provided "additional penalties" to protect the property of authors and their assigns for a term of years. On the equity side, courts of chancery granted injunctions prohibiting the invasion of authors' property rights. It is interesting to note that Blackstone, in examining the law of larceny, found that "when property is established, ... any violation of that property is subject to be punished by the laws of society." The right to make some reasonable use of published, copyrighted material long has been recognized in the English cases. "Fair abridgement," as it then was called, was permitted early on, despite the difficulties experienced by courts in coping with the concept. However, the common law rights of authors to control first publication always were considered separate and distinct from any rules pertaining to statutory copyright, including the doctrine of fair use. In affirming an injunction against the publication of a catalogue of engravings made by Prince Albert and Queen Victoria and obtained without their consent, the Lord Chancellor held that "abridgements, translations, extracts, and criticisms of public works... all depend upon the extent of right[s] under
the acts respecting copyright, and have no analogy to the exclusive rights in the author of unpublished compositions, which depend entirely upon the common law right of property.20

In the United States, Congress first exercised its constitutional authority to "secure[e] for limited Times to Authors . . . the exclusive Right to their respective Writings10 when it enacted the first copyright statute in 1790.11 In Folsom v. Marsh,12 Justice Story formulated the first definitive statement on fair use in American copyright law. The case involved a claim of infringement in the copying of certain letters of George Washington in a two-volume work on Washington written by Rev. Charles Upham. The letters were copied from the twelve-volume work of Jared Sparks, who originally edited, copyrighted and published them. Sparks and Chief Justice Marshall had obtained the letters from Justice Bushrod Washington, nephew of the first president. In his opinion, Justice Story discussed the justifiable uses of copyrighted works and developed some factors to be considered in determining whether there has been an infringement. Those factors—the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects of the original work15—were to be echoed in the Copyright Act of 1976.14

The distinction between common law and statutory copyright protection was carried over to American law from the law of England.16 Common law copyright attached to a work from creation to publication or dissemination, and was enforceable in the state courts.16 As was true under British law, the defense of fair use was not considered applicable to unpublished material.17 The 1976 Copyright Act changed all that. Or so it seemed. Common law copyright, often referred to as the right of first publication, was preempted by the new statute.18 The doctrine of fair use was codified and made applicable for the first time to all copyrighted work, published and unpublished, without distinction. According to the Act, "fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research, is not an infringement of copyright."19 In determining whether the use made of a work in a particular case is fair, courts are constrained to consider four factors: purpose and character of the use; nature of the copyrighted work; amount and substantiality of the portion used; and effect of the use on the potential market for the copyrighted work.20

A persuasive case is made in the leading treatise on fair use for the proposition "that Congress intended to continue the common law prohibition against fair use of unpublished but not voluntarily disseminated works."21 There is, of course, no specific statutory language supporting the proposition, which is founded in a review of the legislative history of the 1976 Act. The legislative history referred to is derived from the reports of several committees of Congress, including one expressing a congressional intent to "restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way."22 The treatise refers to this and other evidence as providing support for the notion that the fair use doctrine is intended to apply only to unpublished works that are publicly disseminated, the same as at common law.23 Apparently, public dissemination is thought to involve a deliberate choice to make a work available to others, short of actual publication. The public performance of unpublished plays and an author's delivery of an unpublished manuscript to a critic are given as examples of voluntary dissemination.24 Publication is defined by statute as "the distribution of copies . . . of a work to the public" as well as "[t]he offering to distribute copies . . . to a group of persons for purposes of further distribution, public performance, or public display . . . . A public performance or display of a work does not of itself constitute publication."25 The distinction between publication and public dissemination is very slight indeed.

In Harper & Row, Publishers, Inc. v. Nation Enterprises,26 the Supreme Court was presented with a clear opportunity to eliminate unpublished works from the reach of fair use. That it did not do so was attributable solely to the language of the Copyright Act. Unquestioned in Harper & Row was the trial court's finding that the defendant "knowingly exploited a purloined manuscript."27 The manuscript in question was, of course, the memoirs of President Ford. Excerpts of the memoirs were scheduled to appear in Time magazine one week before the full length book was to be distributed by the plaintiff publishing house. Before either scheduled event transpired, simple theft allowed the defendant to print and distribute the words of President Ford, describing the pardon of Richard Nixon, in its publication. In reversing the Second Circuit Court of Appeals and holding the plaintiff entitled to damages, the Court concluded "that the unpublished nature of a work is 'a' key, though not necessarily determinative, factor tending to negate a defense of fair use."28 Although the Court analyzed the facts of the case in terms of the four statutory fair use factors, it held that "[u]nder ordinary circumstances, the author's right to control the first public appearance of his undisguised expression will outweigh a claim of fair use."29 I suggest that the vague and undefined phrase, "under ordinary circumstances," leaves open a window that should be closed by Congress. The window is open only because the Copyright Act presently makes no distinction for fair use purposes between
copyrighted material that is published or disseminated and copyrighted material that is unpublished or undissemninated. It is a window through which a thief may enter.

In the wake of Harper & Row, the courts have been faced with some thorny problems in deciding whether various uses of unpublished, copyrighted material were used fairly within the intention of the Copyright Act. For example, in Salinger v. Random House, Inc. a case involving the copying of letters of J.D. Salinger by a biographer who gained access to the letters by promising not to copy them, the appeals court panel puzzled over the "ambiguity arising from the Supreme Court's observation that 'the scope of fair use is narrower with respect to unpublished works.'" The conclusion was that the Court meant it was less likely that fair use would apply to unpublished than published matter, and not merely that a lesser quantity of material may be copied in the case of unpublished matter. It is interesting to note that at least some of the biographer's copying was motivated by a desire to avoid writing what he called "pedestrian sentence[s]." If you can lift the word images and stylistic devices of J.D. Salinger, why bother creating your own?

The extensive use of an unpublished paper "purloined from the Princeton library" presented a District Judge with yet another twist in the defense of fair use. A copy of the paper, dealing with the Pahlavi restoration in Iran, arrived at the library as part of the files of Allen Dulles, to whom it was sent by the author. Researchers at the library were afforded notice of possible liability for copyright infringement and agreed that permission to reproduce was required. The user claimed that he was entitled to copy large parts of the author's paper in order to provide his book with an "air of authenticity" and "full flavor." He contended also that the "ordinary circumstances" rule did not apply because the paper copied was fact rather than fiction, the author of the paper had given copies to certain persons, and the paper and the book were designed to serve different purposes. The district court rejected all these contentions, applied the statutory fair use factors and found the user liable for infringement.

An action to enjoin the publication of the biography of L. Ron Hubbard, deceased founder of the Church of Scientology, presented another occasion for an attempt to define further the imprecise parameters of the doctrine of fair use as it pertains to unpublished material. The material was the product of the pen of Hubbard himself, and the unpublished writings in question, a certain diary in particular, were almost certainly acquired from the Church of Scientology by misappropriation or conversion. Although the district court ultimately decided to award damages for infringement, it accepted the infringer's contention that there is greater justification in using unpublished work to make a point about the character of the work's author (as was the case in the Hubbard biography) than to display the distinctiveness of a writing style (as was the case in the Salinger biography).

In dictum, the panel majority of the appeals court found the distinction between use to enliven text and use to communicate certain traits of character "unnecessary and unwarranted" the biography clearly was a work of criticism, scholarship or research, the purpose of use factor therefore weighed in favor of the copier, and this distinction was considered superfluous. The dissent from denial of in banc consideration in the case found significance in the fact that the Supreme Court never has expressly rejected the "distinction between copying expression to enliven the copier's prose and doing so where necessary to report a fact accurately and fairly." As the author of the panel majority opinion and the opinion concurring in the denial of rehearing in banc, I continue to "question whether judges, rather than literary critics, should decide whether literary material is used to enliven text or demonstrate truth." In my opinion, "[i]t is far too easy for one author to use another author's work on the pretext it is copied for the latter purpose rather than the former." The issue is not yet definitely resolved in the Second Circuit because affirmation of the judgment of the district court in the case, New Era Publications v. Henry Holt & Co., was based on laches, rather than on the type of use to which the converted material was put.

Certain elements of the intellectual property bar hold the firm belief that the window of fair use should be opened even wider than permitted by Harper & Row for access to unpublished and undissemninated material. These elements apparently are not at all offended by the notion of exploiting a manuscript pilfered by a burglar from an author's locked desk drawer, provided the exploitation furthers a just and worthy cause. That federal judges are intended to decide what causes are good and just should be a matter of some concern. Many critics base their positions on First Amendment arguments. One commentator has written that "[t]he nature of the accommodation [sic] between copyright principles and First Amendment principles remains to be drafted." Yet the Supreme Court in Harper & Row noted "that copyright's idea/expression dichotomy 'strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.' The commentator merely chooses to disregard the accommodation already identified by the Supreme Court.

The authors of an article describing the doctrine of fair use as "the biographer's bane" condemn the
severe limitations on copying unpublished works protected by copyright as a "dangerous rule of interpretation." 44 They refer to language in Salinger—"unpublished works . . . normally enjoy complete protection against copying any protected expression"45—as an "overstatement"46 of the Harper & Row standard: "[u]nder ordinary circumstances, the author's right to control the first public appearance of his undissemi nated expression will outweigh a claim of fair use."47 It is difficult to discern how the language in Salinger is anything other than a restate ment of the standard in Harper & Row. The same authors find much to criticize in New Era, finding that it "ignore[s] the explicit congressional mandate that the equities must be flexibly balanced case by case"48 in favor of elevating the single fact of unpublished status "to an almost insurmountable obstacle to a successful fair use defense."49 But there is nothing in New Era to indicate that the congressional mandate to apply the fair use factors in the case of unpublished works is to be ignored. There is merely a reiteration of the principle that the unpublished nature of a work is to weigh heavily in the balance and a faithful adherence to the "under ordinary circumstances" language employed by the Supreme Court.

It is surely an exaggeration to say, as does one commentator, that "biographers are now virtually precluded from publishing convincing, critical portraits backed up by limited use of the subject's unpublished writings to rebut a too polished public persona."50 It simply is an incorrect statement of law to say, as does the same commentator, that we have come to a point "where property rights—albeit intellec tual property rights—embodied in the Copyright Act, which protects the manner of expression of ideas or facts, takes precedence over the First Amendment, which prevents the monopolization or privatization of facts or ideas."51 The Supreme Court has held specifically that the protections of the First Amendment are "already embodied in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas."52 As to the fair use doctrine in particular, the commentator candidly concedes as accurate the statement that the "doctrine encompasses all claims of first amendment in the copyright field,"53 but disagrees with it. Even so, it is difficult to know why he considers that a "chill wind now blows through . . . editorial offices,"54 in view of the unlimited right to use facts and ideas, published and unpublished, copyrighted and uncopyrighted; the limited right to use copyrighted, published material, and the severely limited right to use copyrighted, unpublished material. My thesis is that the delicate balance between the public interest and private rights should be restored by a return to earlier law through the total elimination of the right to

the fair use of material that is unpublished or undissemi nated.

An understanding of this thesis requires an examination of the policy underlying copyright law and the doctrine of fair use. The Supreme Court teaches that the purpose of copyright is to stimulate creativity for the public good through the incentive of a fair return for an author's labor. 55 The concept of advancing the public welfare by encouraging individual effort through personal gain is said to drive the Patents and Copyrights clause of the Constitution.56 The Supreme Court reminds us "that the Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas."57 The fair use doctrine, described as an "equitable rule of reason,"58 was developed by the courts to provide some elasticity in situations where the copyright law might tend to inhibit authors from creating new works by building on older works. Strict application of copyright in such situations would defeat incremental progress, to the detriment of the public good. My colleague, Judge Posner, suggests that Shakespeare, who was known to borrow plot, character and actual language from existing works, might be stilled by our copyright law.59 Positing a return to the theory of creative imitation of Shakespeare's day, Judge Posner notes that the extensive expansion of fair use that would be required not only would be difficult to define but would very adversely affect the author whose work was used.60 Although he finds thriving literature before there was such a thing as copyright, the reasons he gives for the phenomenon—the low cost of writing, nonmonetary rewards, and the high cost of copying—have little relevance to modern times.61

It is difficult to understand how the expansion of fair use of unpublished works that some espouse would serve the purpose of present-day copyright law. Not unexpectedly, an editorial in The Nation recently advocated that "Congress should indicate its displeasure with and disapproval of the recent rulings, beginning with the Nation case, which deviate so far from the way politics and history are and necessarily ought to be written."62 The Nation's specific proposal was to amend the Copyright Act to provide that "unpublished material shall be treated the same way as published works have heretofore been treated" for fair use purposes.63 Apparently, it would make no difference to The Nation whether or not the unpublished material was stolen. The statutory amendment proposed in the editorial, contrary to its purported goal, would not serve the public purpose because it would not encourage the efforts of authors. That an unpublished, undissemi nated, copyrighted work is of historical significance and
"deserving of unfettered public discussion" does not mean that the public may take from that work whatever it will.

As has been demonstrated, the present "open window" for fair use of unpublished material has given rise to much uncertainty. It allows for the exploitation of stolen text. It has spawned proposals for fair use analysis under market theory guidelines, redevelopment of the fair use doctrine predicated in part on a utopian theory, and evaluation of the unpublished nature of the work on a fact/fiction scale. A rule that would disallow the exploitation of purloined work, dispel the uncertainty attributable to the open window, and eliminate the need to revise the doctrine of fair use as applied to unpublished works is a rule that prohibits absolutely any copying of unpublished or undissemi ned works.

It cannot be gainsaid that an author should have the right and the opportunity to hone, polish, refine, revise or discard his or her work prior to publication. The author should also have the right to withhold the work from public dissemination just as long as he or she deems it proper to do so. Implicated in these rights are notions of privacy, freedom to refrain from speaking and an author's control of his or her own material. If information can be considered property under certain circumstances, an unpublished and undissemi ned manuscript, duly copyrighted, should be considered the property of the author and subject to the protection of the law.

To the argument that the copying of unpublished material must be allowed for reasons of public health, safety or welfare, the short response is that copyright protection does not extend to any fact or idea embodied in a copyrighted work. To the assertion that the retention of unpublished, copyrighted papers for 50 to 100 years, immune from fair use, is at "cross-purposes" with the Copyright Clause of the Constitution, the answer is the same. The freedom of access to facts and ideas is the history of democracy. The right of ownership in intellectual property is quite another thing. Interestingly enough, it appears that an author whose work is protected under the recently-ratified Berne Convention is entitled to protection from any use of an unpublished work. The Convention provides that:

[It shall be permissible to make quotations from a work which already has been made available to the public, provided that their making is compatible with fair practice, and their extent does not exceed that justified by the purpose . . .]

Unpublished material would seem to be excluded from "fair practice," and a violation of "moral rights" may be implicated in any use of such material.

My thesis accounts for the concern of scholars that a denial of fair use for unpublished works would be "most inappropriate for the great majority of letters and memorabilia whose authors are no longer alive." It also does so by deeming letters to be voluntarily disseminated to the public when they are received by the addressees. The generally accepted concept that the author of the letter retains the ownership of the intellectual property, while the recipient acquires ownership of the physical property, allows public display of the letter by the recipient.

There is no great leap in logic to consider that, in writing and sending letters, authors have agreed to a dissemination of their correspondence to the public. Voluntary public dissemination was, of course, the same as publication for the purpose of losing the common law copyright protection that applied to unpublished matter under the old dual system of copyright. Historians, as well as authors, scholars, journalists and researchers should have no quarrel with a rule that permits the fair use of copyrighted letters, wherever such letters are found, to the same extent that they are afforded fair use of published or publicly disseminated matter.

The Framers of our Constitution long ago foresaw the need to maintain balances in the republic they created: the balance between individual rights and public needs; the balance of authority between state and national governments; and the balance entailed in the separation of powers in the federal government. In the area of intellectual property, they foresaw a need to maintain a balance between the rights of authors and inventors and the rights of society. They therefore empowered the Congress to establish and maintain that balance by assuring that writers and inventors have exclusive rights, but only for a limited time, in their writings and discoveries. The balance contemplated cannot be established or maintained unless Congress affords to authors the assurance that their copyrighted work cannot be used in any manner whatsoever prior to publication or voluntary and public dissemination.

Endnotes

1. Copyright 1989, Roger J. Miner. All rights reserved.

2. Circuit Judge, United States Court of Appeals, Second Circuit; Adjunct Professor, New York Law School.


4. The Statute of Anne, 8 Anne c. 19, cited in 2 W. Blackstone, Commentaries *407. This was the original copyright statute. W. Patry, The Fair Use Privilege in Copyright Law 4-5 (1985).

5. 2 W. Blackstone, Commentaries *407.
6. Id.
7. 4 W. Blackstone, Commentaries *230.
8. W. Patry, supra note 4, at 6-9.
13. Id. at 348.
15. W. Patry, supra note 4, at 439.
16. Id. at 440.
20. Id. § 107(1)-(4).
21. W. Patry, supra note 4, at 441-47.
23. See supra note 21.
24. W. Patry, supra note 4, at 442; see also 2 Nimmer, supra note 18, § 8.11[Al], at 8-120.2 to 8-1203.
27. Id. at 563.
28. Id. at 554 (quoting S. Rep. No. 473, 94th Cong., 1st Sess. 64 (1975)).
29. Id. at 555.
31. Id. at 97 (quoting Harper & Row, 471 U.S. at 564, and adding emphasis).
32. Id. at 96.
34. Id. at 1133.
35. Id. at 1134.
37. New Era, 873 F.2d at 383.
38. New Era, 884 F.2d at __, No. 88-7095, slip op. 5287, 5295 (2d Cir. Aug. 29, 1989) (denial of rehearing in banc).
39. Id. at __, slip op. at 5290.
40. Id. at __, slip op. at 5290.
41. 873 F.2d at 584-85.
45. Salinger, 811 F.2d at 97.
46. Goldberg & Bernstein, supra note 44, at 3, col. 3.
48. Goldberg & Bernstein, supra note 44, at 7, col. 3.
49. Id. at 7, cols. 2-3.
51. Id. at 2, col. 3.
53. Wishingrad, supra note 50, at 2, col. 4 (quoting New Era, 873 F.2d at 584).
54. Id. at 2, col. 3.
55. Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1978).
60. Id. at 361.
61. Id. at 339.
63. Id.
66. See Fisher, supra note 11, at 1780.
72. See, e.g., MacGregor v. Watts, 254 A.D. 904, 5 N.Y.S.2d 525 (2d Dep't 1938) (manuscripts of plays, at least one of which was copyrighted, held subject to conversion).
73. Goroff, supra note 17, at 348.
83. 1 Nimmer, supra note 18, § 5.04.

MR. GOLDSTEIN: Thank you. Now, that's an unequivocal statement. Thank you very much, Judge Miner, for very provocative ideas. I know several things occurred to me that I had never thought about before in the area of copyright law. We appreciate it very much.

That brings this meeting to a conclusion, with only one thing to tell you, and that is, that now you're to send all of your complaints to Bill Thompson.

Thank you very much.