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## RECENT DEVELOPMENT

Copyright—The Obscenity Defense in Actions To Protect Copyright.—In 1972, Jartech, Inc., produced a movie entitled “Behind the Green Door” and showed the film to selected audiences to determine public acceptance. After some changes in the sound track, the movie was registered with the United States Copyright Office as a film “other than photoplay,”<sup>1</sup> and was released on April 18, 1973. Jartech entered into an agreement with Mitchell Brothers Film Group on February 1, 1973, granting Mitchell Brothers the exclusive right to distribute and exhibit “Behind the Green Door.” Mitchell Brothers then licensed the film for exhibition in theaters across the country.

Kenneth Bora, operator of the Cinema Adult Theater in Dallas, acquired several pirated copies of the film and showed them in his theater, despite the fact that Mitchell Brothers advised him that his copies were made in violation of copyright. Plaintiffs then brought suit in federal district court against Bora and the theater, alleging copyright infringement and seeking both injunctive relief and damages.

At trial, defendants contended that the copyright on “Behind the Green Door” was invalid on several grounds. They argued that the film had been fraudulently described in the application for copyright as “other than photoplay”; that it had been exhibited without restriction before a proper copyright was obtained and that it was therefore in the public domain; that it did not contain a proper copyright mark; and, finally, that it was obscene and therefore not a proper subject for copyright.

The court rejected the first,<sup>2</sup> second,<sup>3</sup> and third<sup>4</sup> of defendants’ contentions. Regarding the fourth point, however, the court stated that obscenity was a valid defense in a copyright action. After viewing the film, the court found that it was obscene<sup>5</sup> and therefore not entitled to copyright protection, and judgment was

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1. Copyright Act of July 30, 1947, ch. 391, § 5(m), 61 Stat. 652 (current version at 17 U.S.C.A. §§ 101-810 (1977)). A film other than photoplay was described by the court as a film which “has no plot, such as a newsreel, travelog, promotional film, and nature study film.” Mitchell Bros. Film Group v. Cinema Adult Theater, 192 U.S.P.Q. (BNA) 138, 140 (N.D. Tex. 1976).

2. The court said that “Behind the Green Door” could be described as having no plot and was therefore classified correctly. Further, there was no evidence of fraudulent intent, so that if the classification were incorrect, such mistake would not be grounds for invalidating the copyright. 192 U.S.P.Q. (BNA) at 141; see Copyright Act of July 30, 1947, ch. 391, § 5, 61 Stat. 652 (current version at 17 U.S.C.A. §§ 101-810 (1977)).

3. Since the film was shown to a selected audience for the limited purpose of gauging public response, the court found that there was no dedication to the general public and that the film was therefore not in the public domain. Mitchell Bros. Film Group v. Cinema Adult Theater, 192 U.S.P.Q. (BNA) 138, 141 (N.D. Tex. 1976).

4. The copy of the film viewed by the court was found to bear a proper copyright mark. *Id.*

5. *Id.* at 144. There was some question as to whether the film should have been judged under the standard of Roth v. United States, 354 U.S. 476 (1957), as modified by *Memoirs v. Massachusetts*, 383 U.S. 413 (1966), which was in effect at the time the movie was produced and copyrighted, or under the standard of *Miller v. California*, 413 U.S. 15 (1973), decided shortly

entered for defendants.<sup>6</sup> *Mitchell Brothers Film Group v. Cinema Adult Theater*, 192 U.S.P.Q. (BNA) 138 (N.D. Tex. 1976).

The defense of obscenity in a copyright infringement action arises from an old common law rule that material which is illegal or immoral cannot be the subject of a valid copyright.<sup>7</sup> In *Mitchell Brothers*, the defense was raised for the first time since the Supreme Court established the local community standard for determining obscenity in *Miller v. California*.<sup>8</sup> Since the law concerning copyright is national in scope, while the *Miller* community standard is local, several obvious inconsistencies result. When a film is judged obscene according to the contemporary community standards of one jurisdiction, and the copyright on that film is invalidated, a question arises as to the effect of that declaration of invalidity on the status of the copyright in a jurisdiction where the film has not yet been judged obscene by its own community standard. Is the copyright invalid everywhere, only in the jurisdiction where it was found to be obscene, or only for the purposes of the suit in which it was declared invalid? If the copyright is invalid everywhere, it would seem that *Mitchell Brothers Film Group* would be found to be obscene according to the community standards of Texas, even though no court in New York had yet passed upon the film. No decision has examined the effect of a declaration of the invalidity of a copyright. However, if the situation is analogous to cases involving patents, which are usually considered void everywhere when declared void by one court,<sup>9</sup> a film declared obscene in one locale could be legally pirated anywhere.

There is no statutory basis for a defense of obscenity in a copyright infringement suit. Neither the old copyright law<sup>10</sup> nor the new one<sup>11</sup> mentions that obscene materials cannot be the subject of a valid copyright. Rather, the doctrine is one of common law origin that has survived almost without change from its beginnings in nineteenth century England.

The first appearance of the rule was dictum of Chief Justice Eyre in an early English decision, *Dr. Priestley's Case*.<sup>12</sup> *Dr. Priestley* had brought an action for after the copyright had been registered. The court found that "Behind the Green Door" was obscene under both formulations. *Mitchell Bros. Film Group v. Cinema Adult Theater*, 192 U.S.P.Q. (BNA) 138, 144 (N.D. Tex. 1976). For a discussion of these standards for determining obscenity, see notes 54-61 *infra* and accompanying text.

6. The court reviewed several older cases supporting the rule that obscene material is not a proper subject for copyright. See *Mitchell Bros. Film Group v. Cinema Adult Theater*, 192 U.S.P.Q. (BNA) 138, 142-43 (N.D. Tex. 1976). For a discussion of the development and acceptance of this rule, see notes 12-34 *infra* and accompanying text.

7. M. Nimmer, *Nimmer on Copyright* § 36, at 146.29 (1976).

8. 413 U.S. 15, 31-34 (1973).

9. *Blonder-Tongue Laboratories, Inc. v. University of Ill. Foundation*, 402 U.S. 313 (1971). For a discussion of the effect of judgment of invalidity of patents, see notes 70-79 *infra* and accompanying text.

10. Copyright Act of July 30, 1947, ch. 391, 61 Stat. 652 (current version at 17 U.S.C.A. §§ 101-810 (1977)).

11. 17 U.S.C.A. §§ 101-810 (1977).

12. *Dr. Priestley's Case* was not reported, but descriptions of it can be found in *Southey v. Sherwood*, 35 Eng. Rep. 1006, 1007 (Ch. 1817), and *Stockdale v. Onwhyn*, 108 Eng. Rep. 65, 65 (K.B. 1826).

damages against "the hundred"<sup>13</sup> for property, including unpublished manuscripts, that had been destroyed during a riot. Defendants claimed that Dr. Priestley was in the habit of publishing works injurious to the government, but produced no evidence to support the statement. Chief Justice Eyre said that such evidence would have been admissible if produced. While this statement was erroneous, as such evidence would be inadmissible unless relevant to the specific manuscripts destroyed, not to Dr. Priestley's work in general,<sup>14</sup> it nonetheless formed the foundation of the doctrine.

Equity courts adopted this dictum and applied it in actions seeking to enjoin copyright infringement as well as an accounting of profits.<sup>15</sup> There was some disagreement, however, as to the wisdom of denying relief on the basis of the immorality of the publication. In *Walcot v. Walker*,<sup>16</sup> the Lord Chancellor adopted the rule of *Dr. Priestley's Case*, interpreting it as meaning that an author had no property right at law in illegal or immoral publications, and therefore no right to equitable relief.<sup>17</sup> Fifteen years later, in *Southey v. Sherwood*,<sup>18</sup> the Lord Chancellor not only repeated that an author lacks property rights in a work that "is not an innocent publication,"<sup>19</sup> but he also dealt with the argument that the refusal to grant an injunction only multiplied the number of copies available. While this argument was rejected,<sup>20</sup> it was indicative of the disagreement regarding the wisdom of the doctrine. Two cases decided in 1822 reiterated the rule and denied copyright protection to publications which violated the law by expressing views contrary to Biblical teachings.<sup>21</sup> Several years later, a court of

13. *Stockdale v. Onwhyn*, 108 Eng. Rep. 65, 65 (K.B. 1826); *Southey v. Sherwood*, 35 Eng. Rep. 1006, 1007 (Ch. 1817).

14. See C. McCormick, *Evidence* § 185, at 434 (E. Cleary 2d ed. 1972). Later courts recognized the error in Chief Justice Eyre's reasoning, but the rule had already been accepted and used. See, e.g., *Stockdale v. Onwhyn*, 108 Eng. Rep. 65, 65 (K.B. 1826), where the court acknowledged that "it is plain that the dictum of Eyre C.J. was not well founded in law," but nonetheless went on to apply the doctrine.

15. See cases cited notes 16-21 *infra*.

16. 32 Eng. Rep. 1 (Ch. 1802).

17. *Id.* In *Walcot*, plaintiff sought an injunction to restrain defendants from publishing two editions of plaintiff's works. The Lord Chancellor found the works to be "of such a nature, that the author can maintain no action at law for the invasion of that, which he calls his property, but which the policy of the law will not permit him to consider his property," and therefore declined to grant equitable relief. *Id.* He suggested that plaintiff first establish a property right at law and then apply to equity for an injunction and accounting. *Id.*

18. 35 Eng. Rep. 1006 (Ch. 1817).

19. *Id.* at 1007.

20. *Id.* at 1008. Lord Chancellor Eldon reasoned that equity was concerned only with the civil interests of the parties, not with the resulting proliferation of undesirable publications. *Id.* Today, judicial concern over the practical results of refusal to enjoin obscene publications is still with us. See *Argos Films v. Barry Int'l Properties, Inc.*, No. 77 Civ. 1062, slip op. at 19 (S.D.N.Y. July 7, 1977); *Mitchell Bros. Film Group v. Cinema Adult Theater*, 192 U.S.P.Q. (BNA) 138, 143 (N.D. Tex. 1976).

21. *Lawrence v. Smith*, 37 Eng. Rep. 928 (Ch. 1822) (lectures on physiology and zoology illegal because contrary to the doctrine of the immortality of the soul); *Murray v. Benbow*, cited in *Lawrence v. Smith*, *id.* at 929 n.1 (injunction against publication of pirated copies of Byron's *Cain* refused because poem's story conflicted with Scriptures).

law considered the problem for the first time and adopted the approach of equity.<sup>22</sup>

The rule that illegal or immoral works will not be protected by copyright, which was introduced in incorrectly-reasoned dictum, enforced by equity, and later accepted in law courts, was adopted in the United States as part of the English common law tradition. It was virtually unused, however, until the late 1800's,<sup>23</sup> at which time cases began to appear in which the defendant claimed obscenity as a defense in a copyright action.

American courts accepted the rule without hesitation and were ingenious in devising rationales for its continued use. Some courts based the doctrine on the limitations implicit in the Constitution itself,<sup>24</sup> on the theory that obscenity does not "promote the Progress of Science and useful Arts."<sup>25</sup> Others based their decisions on the idea that the courts are the guardians of the public virtue.<sup>26</sup> Still others relied on the equitable doctrine of clean hands to refuse relief to an author whose work was deemed morally offensive.<sup>27</sup> Some courts used a combination of the above theories,<sup>28</sup> and others merely applied the rule without attempting to explain its validity.<sup>29</sup>

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22. *Stockdale v. Onwhyn*, 108 Eng. Rep. 65 (K.B. 1826). While equity was not precedent for courts of law, the justices accepted equity's interpretation of *Dr. Priestley's Case*. The court did, however, recognize the error in reasoning in that case. It also refined the principle that an author has no property right in an obscene work by stating that, while he has no right as regards copyright, he does have a property right for other purposes, such as larceny. *Id.* at 65.

23. Obscenity was largely ignored by the courts in this country until the latter half of the 19th century. See F. Lewis, *Literature, Obscenity, & Law* 6 (1976). It first became an issue in Massachusetts and New York, and in the federal courts in those jurisdictions. Alpert, *Judicial Censorship of Obscene Literature*, 52 Harv. L. Rev. 40, 53-64 (1938).

24. See, e.g., *Bullard v. Esper*, 72 F. Supp. 548 (N.D. Tex. 1947); *Barnes v. Miner*, 122 F. 480, 489-90 (C.C.S.D.N.Y. 1903); *Martinetti v. Maguire*, 16 F. Cas. 920, 922 (C.C.D. Cal. 1867) (No. 9,173).

25. U.S. Const. art. I, § 8, cl. 8. The laws regarding copyright are enacted under the power conferred by this section. The courts reasoned that since obscenity was not within this constitutional definition, Congress had no power to bring obscene matter under the protection of the copyright laws and could not have intended that obscenity be so protected. See cases cited note 24 *supra*.

26. See, e.g., *Martinetti v. Maguire*, 16 F. Cas. 920, 922 (C.C.D. Cal. 1867) (No. 9,173); *Shook v. Daly*, 49 How. Pr. 366, 368 (N.Y. Sup. Ct. 1875).

27. See, e.g., *Bullard v. Esper*, 72 F. Supp. 548, 549 (N.D. Tex. 1947). For a case voiding a copyright because of fraudulent misrepresentation, in which the doctrine of clean hands was invoked, see *Stone & McCarrick, Inc. v. Dugan Piano Co.*, 220 F. 837, 841-43 (5th Cir. 1915). The defense of fraudulent misrepresentation in a copyright action derives from the same rule as the obscenity defense.

In cases where it was doubtful that the material in question was immoral, several courts have used the opposite of the clean hands approach, stating that when the validity of the defense is unclear, the case should be resolved in favor of the holder of the copyright. See *Khan v. Leo Feist, Inc.*, 70 F. Supp. 450, 458 (S.D.N.Y.), *aff'd*, 165 F.2d 188 (2d Cir. 1947); *Simonton v. Gordon*, 12 F.2d 116, 124 (S.D.N.Y. 1925).

28. See, e.g., *Bullard v. Esper*, 72 F. Supp. 548 (N.D. Tex. 1947); *Martinetti v. Maguire*, 16 F. Cas. 920 (C.C.D. Cal. 1867) (No. 9,173).

29. See, e.g., *Broder v. Zeno Mauvais Music Co.*, 88 F. 74, 78 (C.C.N.D. Cal. 1898) (rule

Until *Mitchell Brothers*, the defense of obscenity in a copyright suit had been virtually unused since the 1940's. It had been reaffirmed, however, by the Attorney General in an opinion issued in 1958.<sup>30</sup> The opinion stated that obscenity was still a valid defense in a copyright action,<sup>31</sup> and that the usual method for denying copyright protection was invalidation of the copyright by the courts.<sup>32</sup> The court in *Mitchell Brothers* revived judicial use of the rule,<sup>33</sup> which has more recently been followed in another copyright suit, *Argos Films v. Barry International Properties, Inc.*<sup>34</sup>

The rule of *Dr. Priestley's Case* has survived unchanged for almost two centuries. The standards for deciding what is illegal or immoral, however, have changed considerably. Just as illegality depends on the state of the law at any given time, the concept of immorality depends upon "the blushing-point of a particular society at a particular point in time . . ."<sup>35</sup> If the legal and ethical standards of the nineteenth century had been an essential part of the doctrine of *Dr. Priestley's Case*, the doctrine would have died shortly after it was born. Instead, the rule has survived and only the obscenity tests used in its application have undergone changes.

The adaptation of the doctrine to changing morals was discussed in *Keene v. Kimball*.<sup>36</sup> In that case, the defendant, charged with pirating a copyrighted play, raised obscenity as a defense on the premise that all dramatic compositions were once considered obscene. The court found the argument "ingenious and interesting," but rejected it, saying that "the particular application once made of this rule of the common law, in conformity with the peculiar opinions, sentiments or prejudices of one generation of men, will not control its application in a state of society where different views prevail."<sup>37</sup>

A further illustration is offered by two cases dealing with the same material, decided thirty-four years apart. In 1867, a play entitled "Black Crook" was denied copyright protection because it was judged immoral.<sup>38</sup> In 1901, an action

accepted on the basis of early English and American decisions); *Cain v. Universal Pictures Co.*, 47 F. Supp. 1013, 1018 (S.D. Cal. 1942) (rule stated and accepted without explanation, but matter in question found not to be obscene); *Simonton v. Gordon*, 12 F.2d 116, 124 (S.D.N.Y. 1925) (same).

30. 41 Op. Att'y Gen. 395 (1958), 121 U.S.P.Q. (BNA) 329 (1959).

31. *Id.* at 399, 121 U.S.P.Q. (BNA) at 332.

32. Underlying the opinion was the practical consideration that, while the Register could validly refuse to issue a copyright when the matter in question was obscene, the burden of doing so would be too great, in terms of both administrative efficiency and the difficulty of correct judgment on an issue of constitutional dimensions. *Id.* at 401-02, 121 U.S.P.Q. (BNA) at 332-33.

33. 192 U.S.P.Q. (BNA) 138, 142 (N.D. Tex. 1976).

34. No. 77 Civ. 1062, slip op. at 19 (S.D.N.Y. July 7, 1977). Following *Mitchell Brothers*, the court accepted the defense, relying on the constitutional rationale discussed *supra* notes 24-25, but the film in question was found not to be obscene. *Id.* at 22.

35. F. Lewis, *Literature, Obscenity, & Law* 4 (1976).

36. 82 Mass. (16 Gray) 545, 77 Am. Dec. 426 (1860), *overruled on other grounds*, *Tompkins v. Halleck*, 133 Mass. 32, 46 (1882).

37. 82 Mass. (16 Gray) at 549, 77 Am. Dec. at 427.

38. *Martinetti v. Maguire*, 16 F. Cas. 920 (C.C.D. Cal. 1867) (No. 9,173).

for copyright infringement was brought against a defendant who had pirated copies of an advertisement for "Black Crook," and the copyright was enforced.<sup>39</sup>

Thus, the application of the rule from *Dr. Priestley's Case* is dependent on the morals of the time, and the judicial test for obscenity in copyright cases is the same test for obscenity used for other purposes. In the late nineteenth and early twentieth centuries, many American courts relied on variations of the test enunciated in an English case, *Queen v. Hicklin*,<sup>40</sup> that material was obscene if *any portion* of it would tend to corrupt the minds of those who were open to immoral influences and who might have access to such materials.<sup>41</sup> Beyond this, no precise guidelines were followed, and the definition of what might tend to corrupt was left to the discretion of the court.<sup>42</sup> In 1933, the *Hicklin* test was rejected by federal courts<sup>43</sup> in *United States v. One Book Called "Ulysses"*,<sup>44</sup> and replaced by a test of whether the publication's *net effect* was to excite "sexually impure and lustful thoughts" in the person of average instincts.<sup>45</sup> This standard, adopted by many courts,<sup>46</sup> was much more liberal,<sup>47</sup> but still left the decision as to what materials excited such thoughts to the bias of the particular court.

The result was a varying definition of obscenity from state to state and even from court to court. This disparity was reflected in the copyright cases involving obscenity, and, as in other contexts, no uniform definition emerged. Publications judged to be obscene and not a proper subject for copyright were variously described as "grossly indecent, and calculated to corrupt the morals of the people,"<sup>48</sup> "subversive of good morals,"<sup>49</sup> "morally objectionable" because of "an indelicate and vulgar meaning,"<sup>50</sup> "calculated to arouse

39. *Hegeman v. Springer*, 110 F. 374 (2d Cir. 1901), *aff'd per curiam*, 189 U.S. 505 (1903).

40. L.R. 3 Q.B. 360 (1868).

41. *Id.* at 371. This case interpreted Lord Campbell's Act, a law to protect children from the abundance of pornography in circulation at the time. Alpert, *Judicial Censorship of Obscene Literature*, 52 Harv. L. Rev. 40, 51 (1938).

42. For example, Massachusetts courts applied a test of intent to corrupt until 1909, when the *Hicklin* rule was adopted, and interpreted both rules so as to repress almost everything. *See, e.g., Commonwealth v. Friede*, 271 Mass. 318, 171 N.E. 472 (1930) (Dreiser's "An American Tragedy" found to be obscene). On the other hand, New York courts had a more liberal approach, tempering the test with a consideration of the work's literary, historical, didactic, or informational value, thus eliminating the classics, medical texts, and so forth, from the category of obscenity. Alpert, *Judicial Censorship of Obscene Literature*, 52 Harv. L. Rev. 40, 56-65 (1938).

43. At that time, under *Swift v. Tyson*, 41 U.S. (16 Pet.) 1 (1842), federal courts applied federal substantive law, rather than the substantive law of the states.

44. 5 F. Supp. 182 (S.D.N.Y. 1933), *aff'd*, 72 F.2d 705 (2d Cir. 1934).

45. *Id.* at 184.

46. However, the *Hicklin* test was not expressly overruled until *Roth v. United States*, 354 U.S. 476, 489 (1957).

47. As compared to the *Hicklin* test, the new test focused on net effect, not isolated passages, and aimed at protecting the average person rather than the most sensitive. *United States v. One Book Called "Ulysses"*, 5 F. Supp. 182, 184-85 (S.D.N.Y. 1933), *aff'd*, 72 F.2d 705 (2d Cir. 1934).

48. *Martinetti v. Maguire*, 16 F. Cas. 920, 922 (C.C.D. Cal. 1867) (No. 9,173).

49. *Shook v. Daly*, 49 How. Pr. 366, 368 (N.Y. Sup. Ct. 1875).

50. *Broder v. Zeno Mauvais Music Co.*, 88 F. 74, 78-79 (C.C.N.D. Cal. 1898).

lust,"<sup>51</sup> and having a "libidinous effect."<sup>52</sup> Later cases involving copyright relied on definitions of obscenity found in federal statutes, with no less diversified results.<sup>53</sup>

This diversity ended in 1957 with the Supreme Court's ruling in *Roth v. United States*.<sup>54</sup> The Court stated that obscenity was not constitutionally protected speech, but because former obscenity decisions had often proscribed speech which was so protected, the Court set forth more specific guidelines as to what it deemed obscene. Only that which, taken as a whole, was without redeeming value and appealed to the prurient interest of an average person applying contemporary community standards could be controlled or prohibited without violating the first amendment.<sup>55</sup> Although the community standard was approved for interpreting the guidelines, it was unclear whether that standard was national or local. In later cases the test was amended somewhat but there was still no decision as to the meaning of "community."<sup>56</sup> The resolution of that issue came in 1973, in *Miller v. California*.<sup>57</sup> There, the Court amended the guidelines,<sup>58</sup> expressly stated that the community standard was a local and not a national one,<sup>59</sup> and required that state laws, either as written or construed, specifically define what type of depictions are obscene.<sup>60</sup> The Court, in effect, set narrow limits within which states were free to proscribe obscenity and approved local variations in interpretation provided they fell within those limits.<sup>61</sup>

The *Miller* standards, which originated in a case involving state law, were applied to federal law in *United States v. 12 200-Ft. Reels of Super 8MM*.

51. *Simonton v. Gordon*, 12 F.2d 116, 124 (S.D.N.Y. 1925).

52. *Khan v. Leo Feist, Inc.*, 70 F. Supp. 450, 458 (S.D.N.Y.), *aff'd*, 165 F.2d 188 (2d Cir. 1947).

53. *Compare Bullard v. Esper*, 72 F. Supp. 548, 548 (N.D. Tex. 1947) (applying the standards of postal and interstate carrier regulations: "The obscenity which the law seeks to suppress is that which brings the blush of shame to the cheek of virtue, not to the cheek of vice, not to the wise . . ."), *with Cain v. Universal Pictures Co.*, 47 F. Supp. 1013, 1018 (S.D. Cal. 1942) (applying the standards of postal statutes: "[T]he work must be considered as a whole and have a direct tendency to corrupt morals. Mere vulgarity or coarseness of language does not condemn it").

54. 354 U.S. 476 (1957).

55. *Id.* at 487-89.

56. *See, e.g., Memoirs v. Massachusetts*, 383 U.S. 413, 418 (1966).

57. 413 U.S. 15 (1973).

58. *Id.* at 24-25.

59. *Id.* at 30-34.

60. *Id.* at 24.

61. *Id.* at 23-25. The Court stated that state law may only prohibit or regulate depictions of sexual conduct and suggested what type of conduct could be defined as obscene. Within these specific categories, it would be a question of fact as to whether the depiction appealed to the prurient interest and was patently offensive to the average person applying contemporary community standards. *Id.* at 24-25. However, outside these limited categories, material is not obscene, and a trier of fact would not be free to find that it is. These narrow limits are illustrated by *Jenkins v. Georgia*, 418 U.S. 153 (1974), where a jury found a film to be patently offensive and to appeal to the prurient interest. Their decision was reversed because the depictions of sexual conduct in the film did not fall into the categories suggested in *Miller*. *Id.* at 161.

*Film*.<sup>62</sup> The Court there considered a case where obscene matter had been seized by customs officials, as authorized by the Tariff Act.<sup>63</sup> Without discussion of the validity of the application of a local standard to a federal law, the case was remanded to the district court for consideration of whether the material was obscene under the *Miller* standard.<sup>64</sup>

The first use of the *Miller* standard in relation to the federal law of copyright was in *Mitchell Brothers Film Group v. Cinema Adult Theater*.<sup>65</sup> The rule of *Dr. Priestley's Case* is, under *Miller*, only applied to that small class of material which is not protected by the first amendment, rather than to anything which a particular court may consider immoral. A defense of obscenity in a copyright suit will be successful only if the material in question falls within the narrow limits enunciated by the Supreme Court. Within those limits, the interpretation of the standards need not be uniform, but can vary with the locale, even when applied to federal law. The problem with applying local standards to federal law is apparent when the effect of a declaration of a copyright's invalidity is examined.

The question remaining is whether a copyright declared invalid on obscenity grounds is invalid only with respect to the parties to the action in which it was so declared, or only in the jurisdiction in which the case was decided, or whether it is invalid everywhere. There has been no decision on the effect of such delaration of invalidity, and the question remains an open one.

The courts which have accepted the obscenity defense have largely ignored the effect of their decision on parties other than those before the court.<sup>66</sup> There is no doubt that the parties to the suit are bound by *res judicata* as to the issues which were raised.<sup>67</sup> The problem would arise if other persons infringed the copyright and its holder tried to relitigate the question of its validity. If the prior decision is conclusive as to the issue of the copyright's validity, relitigation would be impossible,<sup>68</sup> but if it is not conclusive the issue could be retried with each case of piracy.<sup>69</sup>

An analogy can be drawn from cases involving patent infringement. Patent, like copyright, is an in rem right,<sup>70</sup> good against the world,<sup>71</sup> and the question of whether a declaration of invalidity bars later relitigation has been more fully explored in the patent area.

Prior to 1971, a declaration of invalidity of a patent was considered as

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62. 413 U.S. 123, 129-30 (1973).

63. 19 U.S.C. § 1305(a) (1970).

64. 413 U.S. at 129-30.

65. 192 U.S.P.Q. (BNA) 138 (N.D. Tex. 1976).

66. An exception is *Barnes v. Miner*, 122 F. 480 (C.C.S.D.N.Y. 1903), where the court said that "[a]ny person at any place may reproduce [the show] entire if he does not offend the penal statutes of the jurisdiction in which the performance is given." *Id.* at 490.

67. Restatement (Second) of Judgments §§ 68, 73 (Tent. Draft No. 1, 1973).

68. *Id.* § 73(a), Comment a, at 191-93.

69. *Id.*

70. *Mercoid Corp. v. Mid-Continent Inv. Co.*, 320 U.S. 661, 678 (1944) (Jackson, J., dissenting).

71. P. Rosenberg, *Patent Law Fundamentals* 17 (1975).

binding only the parties to the suit. The Supreme Court had established this rule in *Triplett v. Lowell*,<sup>72</sup> ending disagreement on the issue among the circuits. The Court held that in a suit for patent infringement, each court "must determine for itself validity and ownership of the claims asserted, notwithstanding a prior adjudication of invalidity of some of them, unless those issues have become *res adjudicata*, by reason of the fact that both suits are between the same parties or their privies."<sup>73</sup> This rule that a prior judgment of the invalidity of a patent does not bar relitigation of the issue was held to apply even when the prior adjudication and the later one occurred in the same circuit.<sup>74</sup>

In 1971 the Supreme Court overruled the *Triplett* principle in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*.<sup>75</sup> Stressing the cost, length, and complexity of patent cases, the overloaded court dockets, and the possibility that the holder of a patent declared invalid might receive license fees or royalties from parties who would rather pay them than go to court to relitigate validity, the Court held that judicial declaration of invalidity of a patent can operate to estop the patentee from relitigating the issue.<sup>76</sup> This, the Court felt, satisfied due process requirements, since the patentee had already had an opportunity to argue the issue of validity fully.<sup>77</sup> A narrow exception was made for cases where, through no fault of the patentee, the court in the previous case had failed to grasp the technical aspects of the patent involved.<sup>78</sup> The Court, however, established the general rule that a declaration of invalidity bars future relitigation of the issue.<sup>79</sup>

The reasoning used in patent decisions can be applied to copyright cases by analogy. Both patents and copyrights are "intellectual property,"<sup>80</sup> and both are governed solely by federal laws enacted under the same constitutional power.<sup>81</sup> The differences between patent and copyright lie principally in the

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72. 297 U.S. 638, 644 (1936).

73. *Id.* at 645.

74. *Id.* at 648.

75. 402 U.S. 313, 350 (1971).

76. *Id.* at 334-50.

77. *Id.* at 329-30.

78. Where a patent is declared invalid, and its subject matter is "so complex that legal minds, without appropriate grounding in science and technology, may have difficulty in reaching decision," *id.* at 331, the court in a second case involving the patent's validity may find that it is unjust for the prior decision to operate as a bar, *id.* at 333-34. For a case employing this exception, see *Kaiser Indus. Corp. v. Jones & Laughlin Steel Corp.*, 181 U.S.P.Q. (BNA) 193 (W.D. Pa. 1974). This case involved a patent on a complex process for converting molten iron into steel. The court found that, since the district court in the previous case had failed to understand "the gist of the invention" and the error was not corrected on appeal, this was one of the unusual cases in which the prior judgment of invalidity should not be conclusive. *Id.* at 271-72.

79. 402 U.S. 313, 350 (1971). A decision upholding the validity of a patent, however, never bars future challenges involving different parties. P. Rosenberg, *Patent Law Fundamentals* 17 (1975).

80. P. Rosenberg, *Patent Law Fundamentals* 23 (1975).

81. "To promote the Progress of Science and useful Arts, by securing for limited Times to

types of materials they cover, the criteria for obtaining them, and the protection they afford.<sup>82</sup> For purposes of determining whether a judgment of invalidity is conclusive, the similarities may be sufficient to convince a court to apply the reasoning of *Blonder-Tongue Laboratories*<sup>83</sup> to a case involving the invalidity of a copyright. Should such an application be made, the tension between the obscenity defense and the local community standard for determining obscenity would clearly come into focus.

Three elements coalesce in *Mitchell Brothers*: the rule that obscenity will not be protected by copyright, the local community standard for determining obscenity, and the possibility that a prior judgment of invalidity of a copyright on obscenity grounds may block relitigation of the issue. If the result is legalized nationwide piracy of the material, it is incongruous, not only because obscenity would be proliferated rather than suppressed, but also because copyright benefits would be denied to material which may be protected speech, not obscenity, in some jurisdictions. Chief Justice Burger's statement in support of a local community standard, that residents of Maine or Mississippi cannot be required to accept depictions found tolerable in Las Vegas or New York,<sup>84</sup> would be reversed. At least in the context of copyright protection, residents of Las Vegas or New York may be governed by what is tolerated in Maine or Mississippi.

Should the situation arise in which a plaintiff is sued for infringement of a copyright already declared invalid in another jurisdiction, several solutions are possible to avoid the unjust result described above. One possibility would be that a court could follow the principle of *Blonder-Tongue*,<sup>85</sup> that a prior adjudication of invalidity blocks relitigation of the validity of a patent, inapplicable to copyrights. A more theoretically sound solution would be to hold that, even though a prior adjudication of invalidity may generally operate to bar relitigation of the validity of copyrights, an exception should be made for copyrights declared invalid on obscenity grounds. This is a legitimate solution, since the question of obscenity in a second locality would not have been fully argued and resolved, and since copyright suits are not as long, costly, or complex as patent suits. The use of a prior adjudication as a bar to litigation of such an issue would offend due process requirements.<sup>86</sup>

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Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. art. I, § 8, cl. 8.

82. For a more comprehensive comparison of patent and copyright, see 1 W. Robinson, *The Law of Patents* § 26, at 40-43 n.1 (1890), and P. Rosenberg, *Patent Law Fundamentals* 23-33 (1975).

83. 402 U.S. 313 (1971).

84. *Miller v. California*, 413 U.S. 15, 32 (1973).

85. 402 U.S. 313 (1971).

86. The fifth amendment requires that notice and a hearing be accorded a person before he is deprived of property. *Fuentes v. Shevin*, 407 U.S. 67, 79-80 (1972); *Mullane v. Central Hanover Bank & Trust Co.*, 339 U.S. 306, 313 (1950); *Baldwin v. Hale*, 68 U.S. (1 Wall.) 223, 233 (1863). When the question of obscenity in a given jurisdiction has not been determined, it would seem that the requirement of a hearing would not be met if the copyright were automatically deemed invalid.

However, both of these solutions, though they may be workable in the situation at issue, avoid the broader problem resulting from the application of local obscenity standards to federal laws. The inconsistencies which appear when obscenity is an element of a copyright case are not unique. Whenever a local standard is used as a basis for a finding of fact in a case involving federal law, the resulting inconsistency in interpretation of federal law is problematic.

The first amendment, as interpreted by the Supreme Court, permits Congress to prohibit obscenity,<sup>87</sup> but the extent to which federally imposed restrictions on obscenity are implemented should not be subject to varying interpretations from one community to another.<sup>88</sup> Admittedly, the scope of the permissible definition of obscenity under *Miller*,<sup>89</sup> as applied to federal law by *12 Reels of Film*,<sup>90</sup> is very narrow,<sup>91</sup> but the possibility for inconsistent application exists as long as any variation is allowed. To avoid the result that legislation of Congress can be varied according to the standards of a particular locale, a national community standard should be utilized for cases involving federal law.<sup>92</sup> A national community standard is no more difficult to ascertain than a local standard, since individuals within a community are as diverse as are different communities.<sup>93</sup> In a recent case, Justice Blackmun indicated that a national standard might not be precluded by *Miller*, if Congress amended federal legislation to require use of such a standard.<sup>94</sup>

Thus, the inequitable result made possible by *Mitchell Brothers* is indicative of the inconsistency which results whenever local standards are used to interpret federal law. The problem, should it arise, can be solved in the copyright context, but the broader issue remains unresolved as long as local obscenity standards are used to interpret federal law.

Bonnie Wilkinson

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87. See *Miller v. California*, 413 U.S. 15, 23 (1973); *Roth v. United States*, 354 U.S. 476, 485 (1957); Sunderland, Book Review, 22 N.Y.L. Sch. L. Rev. 799, 805-06 (1977).

88. See generally Leventhal, *The 1973 Round of Obscenity-Pornography Decisions*, 59 A.B.A.J. 1261, 1262 (1973); Sunderland, Book Review, 22 N.Y.L. Sch. L. Rev. 799, 806 (1977).

89. 413 U.S. 15 (1973).

90. 413 U.S. 123 (1973).

91. See note 61 *supra* and accompanying text.

92. Leventhal, *The 1973 Round of Obscenity-Pornography Decisions*, 59 A.B.A.J. 1261, 1262 (1973); Sunderland, Book Review, 22 N.Y.L. Sch. L. Rev. 799, 806 (1977).

In the copyright area, such a standard has already been used by one court. In *Argos Films v. Barry Int'l Properties, Inc.*, No. 77 Civ. 1062 (S.D.N.Y. July 7, 1977), the court chose a quasi-national and international standard, rather than a local community standard, to determine if the film in question was obscene. "This choice, while inconsistent with *Miller*, may well be preferable in copyright infringement actions . . ." Nolan-Haley, *Obscenity, Copyright and Community Standards*, 178 N.Y.L.J., Dec. 23, 1977, at 2, col. 3.

93. Leventhal, *The 1973 Round of Obscenity-Pornography Decisions*, 59 A.B.A.J. 1261, 1262 (1973); Sunderland, Book Review, 22 N.Y.L. Sch. L. Rev. 799, 806 (1977).

94. *Smith v. United States*, 431 U.S. 291, 304 n.11 (1977).