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CHASING ECHOES OF OBSCENITY EXCEPTIONALISM IN
COPYRIGHT: RECENT SWARM CASES

JAMES R. ALEXANDER*

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Over the past six years, Malibu Media, LLC, (Malibu) producer and distributor of hardcore pornographic films through its website Xart.com, has filed thousands of copyright infringement suits against ‘swarms’ of John Does for using a BitTorrent file-sharing protocol to allegedly and without license download and view their products.¹ Malibu’s strategy has been to use court subpoena authority to identify large numbers of heretofore anonymous internet subscribers and then threaten them individually with copyright infringement claims that would prospectively result in fines and public embarrassment unless they agreed to an offered private settlement.² While most illegal downloading by file sharing has involved noncontroversial fare, such as mainstream movies, vintage

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1. As reported by Matthew Sag, Malibu filed over 1,700 copyright suits against over 6,000 John Doe defendants related to pornography between 2012 and the first quarter of 2014. The second most prolific plaintiff was Patrick Collins, Inc., with over 200 suits filed between 2001 and 2014 against over 11,000 John Does. See Matthew Sag, *Copyright Trolling, An Empirical Study*, 100 IOWA L. REV. 1005, 1131–1132 tbls.1 & 2 (2015). In the three years since January 1, 2014, Malibu filed suits against 5,975 individual John Does, predominantly in the second (1,126), seventh (995), fourth (991), and sixth (883) circuits. See generally Justia Dockets & Filings, <https://dockets.justia.com> (last visited January 16, 2017).

2. See Luke Curran, *Copyright Trolls, Defining the Line Between Legal Ransom Letters and Defending Digital Rights: Turning Piracy into a Business Model or Protecting Creative from Internet Lawlessness?*, 13 J. MARSHALL REV. INTELL. PROP. L. 170, 194 (2013).

television series, anime, and sports,³ the extortive element of the Malibu strategy has proven most effective against downloaders of pornographic material.

Largely unnoticed in the proliferation of these types of copyright infringement suits have been some faint echoes of the vintage content exceptionalism argument from common law holding that irrespective of legislative actions or intent, courts should not on public policy grounds provide equitable relief to owners of illicit and immoral materials which assumedly might incentivize their proliferation and harmful effects.⁴ Historically the doctrine of concept exceptionalism developed in response to the absence of restrictive language on content in copyright statutes in both England and America, leaving equitable jurisdiction in limbo and leaving it to juries to sort out and punish the publication and distribution of criminally-harmful materials on a case-by-case basis.⁵

Traditionally, content exceptions in copyright have in common law been reserved for illegal materials, following the maxim that equitable protection should not be granted to plaintiffs who have in regard to the particulars of the claim behaved in an inequitable manner toward the defendants or the public at large, the latter most specifically with respect to criminal behavior.⁶ If copyright statutes did not delineate content-based exceptions to be parsed by a designated registrar or the courts, the provision of copyright protections fell to juries to determine the legality of the production or distribution (publication) of the works at issue, subject to other constitutional protections. While the proliferation of works of ‘illicit content’ in the marketplace has always spawned demands for statutory exceptions, the prevailing view has been and remains that any such

3. See David Price, *Sizing the Piracy Universe*, NETNAMES (September 2013), <https://www.netnames.com/assets/shared/whitepaper/pdf/netnames-sizing-piracy-universe-FULLreport-sept2013.pdf> (last visited October 22, 2016) (estimating that pornographic material comprises less than a third of all torrent downloading traffic, with 76% of the pornographic traffic non-copyright infringing).

4. Often referred to as consequentialism, this argument is a reflection of the common law ‘natural tendency’ test, whereby juries would consider a publication’s ‘reasonable consequence’ to do public harm, independent of actual evidence of ill-consequence or of the publisher’s benevolent intent. See James R. Alexander, *Roth at Fifty: Reconsidering the Common Law Antecedents of American Obscenity Doctrine*, 41 J. MARSHALL L. REV. 393, 419–423 (2008); Ann Bartow, *Copyright Law and Pornography*, 91 OR. L. REV. 1, 38 (2012) (arguing the social harm caused by distribution and consumption of pornography provides a constitutional rationale for denying them copyright protection as they cannot be construed to promote progress or the useful arts); Ned Snow, *Content-Based Copyright Denial*, 90 IND. L. J. 1473, 1514 (2015) (arguing that the Copyright clause mandate of promoting the progress of science excludes obscene materials which have little to no social value and provides a legitimate basis for denial of copyright protection in the courts).

5. See generally James R. Alexander, *Evil Angel Eulogy: Reflections on the Passing of the Obscenity Defense in Copyright*, 20 J. INTEL. PROP. L. 209 (2013).

6. *Id.* at 219–242 (tracing the maxim regarding inequitable behavior in English common law).

restrictions on expressive content would invite strict scrutiny of legislative purpose under the First Amendment.⁷ This position has been recently reinforced in *Matal v. Tam*, that as a content-based statutory exception, the disparagement portion of Section 2(a) of the U.S. Trademark Act was subject to strict scrutiny and held to be unconstitutional.⁸

Since the eighteenth century, both law and equity courts accepted what became known as the obscenity defense in cases of copyright infringement, an affirmative defense in which plaintiffs claiming copyright infringement on their works were argued to be ineligible for protection if their works were of such a nature as to harm the public. If so, the plaintiff was considered to be approaching the court with “unclean hands,” in effect asking the court to support their illicit behavior.⁹ This defense, grounded in the common law acceptance of content exceptionalism, can be traced back to a series of early nineteenth century English rulings at equity by Lord Chancellor Eldon that were considered governing in American law through the late 1970s, when definitively challenged by *Mitchell Bros. Film Grp. v. Cinema Adult Theater*.¹⁰ The ruling in *Mitchell Bros.* established the now

7. See, e.g., Eldar Haber, *Copyrighted Crimes: The Copyrightability of Illegal Works*, 16 YALE J. L. & TEC. 454, 480–484 (2014) (arguing that the Copyright clause itself mandates or at least opines for content discrimination but to build that into statutory language must navigate the shoals of strict scrutiny under the First Amendment).

8. See *Matal v. Tam*, 137 S. Ct. 1744, 1747 (2017), *affirming In re Tam*, 808 F.3d 1321, 1346–1348 (Fed. Cir. 2015) (en banc). The Federal Circuit, in discussing parallels between trademark and copyright protections, adding “denying benefits of copyright registration to disfavored speech . . . is anathema to the First Amendment” and cautioned that considering trademark registration as government speech, thereby eliminating all First Amendment protections, could have as easily be used to deny such protections under copyright registration. The Federal Circuit’s ruling, however, presumed a distinction could be drawn between expressive and commercial elements of trademark protection, with the former subject to First Amendment protections, a distinction that had been challenged by Ned Snow, *Free Speech & Disparaging Trademarks*, 57 B. C. L. REV. 1639, 1668 n.173 (2016) (arguing that the Commerce and Copyright clauses provide entirely different bases for considering content discrimination); Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381, 422 (2016) (agreeing that copyright and trademark laws provide different types of protections, but specifying that copyright protects the expression in a work and “to mandate that the work be nondisparaging or nonobscene to get protection is to mandate a change in the work itself as a condition of the benefits of protection.”). In *Matal*, the Court argued that Tam’s trademark contained expressive content and, even if viewed only as commercial speech, the disparagement clause still could not withstand the relaxed scrutiny standard established under *Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm’n of N.Y.*, 447 U.S. 557 (1980) since the substantial government interest involved was in preventing speech that expressed ideas that offend. See *Matal*, 137 S. Ct. 1744, 1763 (2017).

9. Alexander, *supra* note 5, at 242–58.

10. See, e.g., 604 F.2d 852 (5th Cir. 1979), *cert. denied*, 445 U.S. 917 (1980) (enforcing the copyright on a pornographic film conceded to be obscene) [hereinafter *Mitchell Bros.*]; see also *Jartech, Inc. v. Clancy*, 666 F.2d 403 (9th Cir. 1982), *cert. denied*, 459 U.S. 826 (1982) (arguing that the uniform application of copyright protection would be fragmented by differential applications based on community standards) [hereinafter *Jartech*]; *Nova Prods. v. Kisma Video, Inc.*, 03-Civ.4259, 2004 U.S. Dist. LEXIS 24171 (S.D.N.Y. Dec. 1, 2004) [hereinafter *Nova Prods.*]; *Dream Games of Ariz., Inc. v.*

commonly-accepted principle of content neutrality in copyright protection that, unless constitutionally acceptable content exceptions were specified, all expressive content was eligible for copyright protection if all other statutory requirements, such as authorship, originality, and registration were fulfilled.¹¹

The purpose of this paper is to lend a more careful ear to those echoes to see if the recent swarm of cases offer new insights regarding the common law argument for content exceptionalism, or are simply restating the basic concerns expressed when the common law acceptance of content exceptionalism was first challenged, not in *Mitchell Bros.* in 1979 but rather in those earlier rulings of Lord Eldon, beginning in 1802 with *Walcot v. Walker* with which the establishment of the principle has long been associated.¹² While such an investigation may seem antiquated and arcane, what we discover is that those rulings wrestled with all of the same issues we consider germane today and perhaps with more circumspection than we might have believed. Their reexamination may in fact inform our interpretation of these most recent echoes.

I. ECHOES IN RECENT SWARM CASES: *NEXT PHASE* AND ITS PROGENY

Malibu and other producers of pornographic movies filed ‘swarm’ suits against multiple and unnamed John Doe defendants identified only by their subscriber account numbers with their respective internet service providers (ISPs), joining them—often numbering in the hundreds or thousands—in a single suit for court expediency.¹³ In each, plaintiffs

PC Onsite, 561 F.3d 983 (9th Cir. Ariz. 2009) [hereinafter *Dream Games*]; *Flava Works, Inc. v. Gunter*, 689 F.3d 754 (7th Cir. 2012) [hereinafter *Flava Works*].

11. See U.S. COPYRIGHT OFFICE, COMPENDIUM OF THE U.S. COPYRIGHT OFFICE PRACTICES, § 315, at 39 (Third Ed., Dec. 22, 2014), excepting possible content review when a work contains material that appears to fall within the scope of the Child Protection Act. See Alexander, *supra* note 5, 304–314 (describing the impact of *Mitchell Bros.* on subsequent court rulings). That the principle of content neutrality is largely accepted rather than wholly accepted is the subject of this paper.

12. See generally *Walcot v. Walker* (1802) 32 Eng. Rep. 1 (Ch) (holding that establishment of rightful property at law must precede an equitable claim of copyright protection of materials of questionable content) [hereinafter *Walcot*]. Eldon’s ruling in *Walcot* followed dictum by Eyre, C.J., in *Dr. Priestley’s Case* (1791) (CPD, *nisi prius*), that there can be no property in a work that in its nature is calculated to do injury to the public. Priestley was first reported *arguendo* in *Southey v. Sherwood* (1817) 35 Eng. Rep. 1006, 1008 (Ch) [hereinafter *Southey*] and in detail by Abbott, C.J., in *Stockdale v. Onwhyn* (1826) 172 Eng. Rep. 75, 76, n.(b) (KB, *nisi prius*). The plaintiff in the 1802 case was John Wolcot (1736–1819), whose name was misspelled in the original published nominate report of Eldon’s ruling and continuously thereafter.

13. See Stefan Mentzer & Michael La Marca, *Joinder and Early Discovery in BitTorrent Copyright Infringement Suits*, 33 CARDOZO ARTS & ENT. L.J. 89, 91–93 (2015) (describing the legal standard for joinder under Federal Rule of Civil Procedure 20); Sag, *Copyright Trolling*, *supra* note 1,

petitioned for subpoena authority under expedited discovery to require the non-party ISPs to divulge the identities of those subscribers allegedly using BitTorrent software programs to illegally download copyrighted movies.¹⁴ The plaintiff then had to not only prove ownership of a valid copyright for films that had been downloaded without license but also document actual copying of elements of an original work in order to establish a *prima facie* claim sufficient to warrant expedited discovery.¹⁵

Rulings in these cases followed a fairly consistent pattern. In virtually all cases, the plaintiff's claim to a valid copyright, based on a film's registration, was accepted as sufficient to consider expedited discovery.¹⁶ Plaintiff's counsel then petitioned to join large numbers of claims against anonymous John Doe infringers to facilitate subpoenaing third-party ISPs to gain the identities of their account users who could be tagged with the downloading. The Court then had to consider whether it was appropriate for large numbers of unnamed defendants to be joined in a single claim, and in particular whether all of the John Does identified in the allegedly infringing swarm had actually colluded to download recognizable elements of the copyrighted materials in a single action. This proved to be a rocky road as even with advanced tracking software, as it was difficult for plaintiffs to demonstrate that defendants had actually acted in concert in a single transaction.¹⁷

Moreover, the participation of any one John Doe in a swarm over any time period did not indicate he was an active participant at all times, or even during the times that the elements of the film were downloaded. Instead, it was more likely that the John Does participated at different times on different days. And given the pervasiveness of wireless routers, a single IP address might support multiple computer devices, allowing others not listed on the ISP address to access the swarm and illegally download the

1131–1132 (identifying the pattern of multi-defendant John Doe litigation as a business model and documenting its principal practitioners in the pornographic film industry).

14. See Charles F. Prutzman, Jr., *Joinder and the Internet: Understanding the Intricacies of BitTorrent and the Fair Resolution of Copyright Infringement Cases*, 32 TEMP. J. SCI., TECH. & ENVTL. L. 185, 190–201 (2013) (outlining the use of the BitTorrent interface and the complications it raises for justifying joinder).

15. See *Feist Publ'n, Inc. v. Rural Tel. Serv. Co. Inc.*, 499 U.S. 340, 361 (1991) (identifying the doctrinal requisites for a *prima facie* claim of copyright infringement).

16. Since the Court first recognized copyright ownership in pornographic films in *Mitchell Bros.*, 604 F.2d at 854, producers have routinely copyrighted each film, only later discovering the difficulty and high cost of enforcing them. See Kate Darling, *IP Without IP? A Study of the Online Adult Entertainment Industry*, 17 STAN. TECH. L. REV. 709, 709 (2014) (finding the industry has greater economic incentive to diversify its services toward consumption convenience and interactive products than to protect its copyrighted monopoly of traditional content).

17. See generally Mentzer & La Marca, *supra* note 13, at 94–107 (reviewing how district courts have arrived at conflicting rulings on the appropriateness of joinder in swarm cases).

movies in question. Furthermore, joinder of multiple John Doe defendants might compromise the ability of the Court to weigh their individual and perhaps unique defense arguments fairly.

Finally, many courts recoiled at what has been portrayed as the film production companies' new 'business model,' under which they sought subpoena power to gain the identities for large numbers of ISP subscribers with no intention of proceeding to litigation.¹⁸ Instead, a company contacted subscribers directly, threatening them with individual (and public) infringement suits that would prove expensive to defend and even more expensive if lost, not to mention the public embarrassment of exposure as having downloaded pornographic films.¹⁹ Subscribers were then offered settlement for nominal amounts through an internet portal, a scheme often portrayed as court-assisted extortion, and if accepted, the plaintiff would voluntarily drop the threatened suit.²⁰

The most cited among recent swarm cases has been *Next Phase Dist. Co., Inc., v. John Does 1–27*²¹ which granted discovery against John Doe 1

18. See, e.g., *AF Holdings, LLC v. John Does 1–1058*, 752 F.3d 990, 995 (D.C. Cir. 2014) (holding as bad faith the abuses of discretion practiced by Prenda Law, a notorious copyright troll, regarding its petitions for both jurisdiction and joinder). Many courts have described this business model with disdain without concluding that the plaintiff was engaging in inequitable conduct under the "clean hands" doctrine. See, e.g., *Malibu Media, LLC v. John Doe*, No. 16-CV-01068-AWI-SKO, 2016 U.S. Dist. LEXIS 147883, at *11 (E.D. Calif. Oct. 25, 2016) ("Despite these concerns, most district courts have permitted Plaintiff to serve ISPs with third-party subpoenas to discover the identity of the customer associated with the relevant IP Address."). On occasion, a defendant has unsuccessfully alleged an abuse of process in that the plaintiff's offer to settle was demonstrative of having no intention to litigate the claim but instead wanting only to use the Court's subpoena authority just to leverage the ISP for the John Does' names and addresses in order to send them extortion letters, which the Court ruled was not conduct under an unclean hands defense. See, e.g., *Purzel Video GmbH v. Smoak*, No. 13-CV-001167-WYD-MEH, 2013 U.S. Dist. LEXIS 182586, at *9 (D. Colo. Dec. 9, 2013) (accepting that "[o]ther courts addressing similar abuse of process claims have found that attempting settlement does not support a claim for abuse of process regardless of the parties' motivations."). However, the affirmative defense of "unclean hands" has been seriously considered when the Plaintiff is alleged to have colluded with the ISP to encourage infringement. See, e.g., *Grady v. Iacullo*, No. 13-CV-00624-RM-KMT, 2016 U.S. Dist. LEXIS 50846, at *10 (D. Colo. Feb. 29, 2016) (instead of working with the third-party website to block infringing activity, the Plaintiff instead continues to bring suits against rampant infringement activities by individual users).

19. One of the most active production companies using this model has been Malibu Media, whose tactics are described in most court rulings. See, e.g., *Malibu Media LLC v. John Doe*, No. 15 CIV. 4369, 2015 U.S. Dist. LEXIS 87751, at *4 (S.D.N.Y. July 6, 2015); see also, *Sag*, *supra* note 1, at 1129–1133 (identifying Malibu's instigation of 1,709 suits filed against John Does from 2001 to 2014, over seven times as many as the next most active plaintiff Patrick Collins, Inc.).

20. See, e.g., *Malibu Media, LLC v. John Doe*, No. 15-CV-13124, 2016 U.S. Dist. LEXIS 69290, at *2, n.1 (E.D. Mich. S.D. May 27, 2016) (citing 289 of 290 cases filed in that district against one of more John Does between June 2012 and September 2015, of which 287 were closed, mostly voluntary dismissed by Malibu having successfully gained subpoena authority to acquire subscriber identifications).

21. *Next Phase Distrib., Inc. v. John Does 1–27*, 284 F.R.D. 165 (S.D.N.Y. 2012) [hereinafter *Next Phase*]. In the five-year period since *Next Phase* (through Oct. 25, 2016), it has been cited in over

but severed John Does 2-27 because of the weakness of the collusion claim. And yet, while the court accepted the plaintiff's copyright registration as sufficient to satisfy the requirement for a prima facie case of infringement for expedited discovery,²² it added what has become a bellwether, if only as an infrequent echo, of traditional content exceptionalism:

[I]f the Motion Picture is considered obscene, it may not be eligible for copyright protection[.] [T]he case law is unsettled regarding whether pornography may legitimately be copyrighted, . . . [and that] since the *Mitchell Bros.* decision, judges across the country and within this district have reached different conclusions on this issue.²³

This same phraseology has appeared in a number of subsequent cases in which valid registration had been accepted, either quoted from *Next Phase* or directly referencing a footnote in *Liberty Media Holdings, LLC v. Swarm Sharing Hash File and John Does 1-38*²⁴ that had stated it was “unsettled in many circuits, whether pornography is in fact entitled to protection against copyright infringements.”²⁵

That footnote in *Liberty Media* recalled all of the issues nominally resolved by *Mitchell Bros.* and became the principal echo of its consequentialist critique. It recognized that copyright protection was “effectively unavailable for pornography” until “the landmark decision” of *Mitchell Bros.*,²⁶ that even if a film were deemed obscene it could nonetheless not be denied protection under a valid copyright, and the question of whether a pornographic film were obscene was to be determined by a jury.²⁷ Moreover, the Court accepted that plaintiff Liberty

ninety district court cases, most confining its reference to issues regarding the properness of joinder of multiple unnamed John Doe defendants.

22. *Id.* at 171 n.5, following *In re: BitTorrent Adult Film Copyright Infringement Cases*, 296 F.R.D. 80, 87 n.8 (E.D.N.Y.) (“For the purposes of this analysis, it is assumed that plaintiff’s works are entitled to copyright protection, though that may be an open question.”) [hereinafter *In re: BitTorrent*].

23. *Id.* at 171. The Court apparently offered this line of argument without provocation, since no defense counsel was listed to argue it substantively, and its generalization about the views of other judges on the issue of content exceptionalism was offered without documentation.

24. 821 F. Supp. 2d 444 (D. Mass. 2011) [hereinafter *Liberty Media*].

25. *Id.* at 447 n.2.

26. *Id.*; see also *Jartech, Inc. v. Clancy*, 666 F.2d 403, 406 (9th Cir. 1982).

27. *Liberty Media*, 821 F. Supp. 2d at 447 n.2. District courts have indiscriminately referred to films in these cases as erotic, pornographic, or obscene, making their rulings, if based on content, confusing. It is commonly recognized that erotic films are those involving sexual themes and/or images of varying degrees of explicitness from implied to graphic. Pornographic films are intended to elicit a lascivious response from certain categories of viewers based on their sexual preferences, more a consideration of producer intent and how the product is marketed than evidence of audience receptivity.

Mutual was a distributor of hardcore but lawful pornography²⁸ and had a valid copyright to the film allegedly downloaded illegally.²⁹ While the Court averred in a footnote that the issue of copyright protection for pornography had not yet been addressed by that (the First) Circuit and was “unsettled in many circuits,” it stipulated that issue was not before it and expressed no opinion on it.³⁰

Ostensibly to illustrate the unsettled nature of the issue, the *Liberty Media* footnote invited a comparison of two rulings from the Second Circuit. The first was *Devils Films, Inc. v. Nectar Video*,³¹ in which the Court denied an order to show cause, to seize of defendant’s unlicensed copies, and to provide injunctive relief because, having viewed three of the over two hundred films allegedly copied, concluded they were obscene.³² It then declared that “given the clearly criminal nature of the plaintiff’s

So-called hard-core pornographic films are explicitly graphic, but still mostly within “the usual limits of candor” by local standards in some communities and not illegal. That a film is obscene is not merely (and subjectively) content descriptive but rather a legal finding that a jury has held it to be criminal in effecting or imminently threatening social harm, under the three-pronged standard promulgated in *Miller v. California*, 413 U.S. 15, 24–25 (1973). See generally Richard Posner, *SEX AND REASON* (Cambridge: Harvard University Press, 1992) (distinguishing erotic, pornographic and obscene works in historical context).

28. *Liberty Media*, 821 F. Supp. 2d at 447 n.2. Most of the films allegedly downloaded illegally in these swarm cases have been conceded by all parties to be pornographic and none has been found criminally obscene by a jury. To argue that a film is ineligible for copyright protection because it is pornographic is to apply a content-based standard to expressive works not called for by copyright statutes and prohibitive under strict scrutiny. The only exception to this may be works containing child pornography, unlawful under 18 U.S.C. § 2257 (2006) and which, if held to disqualify a registered but not criminal work from copyright protection, might constitute a content limitation on copyright. See generally Carissa B. Hessick, *The Limits of Child Pornography*, 89 IND. L. J. 1437 (2014). To date, however, no court within the scope of this study has directly ruled on that argument, some leaving the issue “for another day.” See, e.g., *Malibu Media, LLC v. John Doe*, No. 13-C-3648, 2014 U.S. Dist. LEXIS 77929, at *13 (N.D. Ill. June 9, 2014), while other courts have followed the “prevailing view” that obscene and immoral content is copyrightable. See, e.g., *Malibu Media, LLC v. Zumbo*, No. 2:13-CV-729-JES-DNF, 2014 U.S. Dist. LEXIS 82272, at *11–12 (M.D. Fla. June 17, 2014) (citing *Dream Games*, 561 F.3d at 991); *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 861 (5th Cir. 1979) (holding “that even obscenity and immoral content is copyrightable.”). While content distinctions raised by child pornography laws continue to be argued, the issue remains largely hypothetical regarding registered works against which criminal action has not been taken as “it seems unlikely that unambiguous works of child pornography in which real children are depicted have even been registered with the copyright office.” Bartow, *supra* note 4, at 40.

29. *Liberty Media*, 821 F. Supp. 2d at 449.

30. *Id.* at 447 n.2 (“This issue . . . is not presently before the Court and the Court expresses no opinion on it here.”).

31. 29 F. Supp. 2d 174 (S.D.N.Y. 1998) [hereinafter *Devils Films*].

32. *Id.* at 175 (stating that “they are hard core pornography bereft of any plot and with very little dialogue.”) This was based on the Supreme Court’s presumptive knowledge of its own community standards in *Miller v. California*, 413 U.S. 15 (1973).

operation, it is self-evident that the Court should not use its equitable power to come to the plaintiff's assistance,"³³ continuing:

Since this is only an application for preliminary relief, the Court need not decide if obscenity is a defense to a claim of copyright violation It is far from clear that the Second Circuit will follow the Fifth [*Mitchell Bros.*] and Ninth [*Jartech*] Circuits in rejecting the argument that obscene material is entitled to copyright protection . . . [an argument outweighed by] the potential ramifications of ordering the U.S. marshal to aid in the violation of federal and state law. It strains credulity that Congress intended to extend the protection of the copyright law to contraband.³⁴

While *Devils Films* has been cited in a few copyright infringement cases as effectively countering *Mitchell Bros.*, its precedent value is far from clear.³⁵ Without stipulating whether or not the plaintiff had valid copyrights to the films, the Court in *Devils Films* denied relief because in its view the films at issue were obscene and implicitly 'clearly criminal.'³⁶ In doing so, it exhibited exactly the kind of anti-democratic and arbitrary paternalism (as moral censor) of which Lord Eldon was accused in the early nineteenth century. The Court then noted that it did not need to address the issue of whether the obscene nature of a film denied it copyright protection (albeit having just done so) and that its own Circuit had not yet considered whether it might accept the same reasoning as

33. *Devils Films*, 29 F. Supp. 2d at 175. The Court further stipulated that plaintiff's videos were produced in California and sold in New York, indicating that "probable cause exists to believe that the plaintiff is violating 18 U.S.C. § 1466," making it illegal to sell or transfer obscene materials interstate.

34. *Id.* at 176. As *Mitchell Bros.* had traced the statutory history of copyright exceptionalism and demonstrated a clear congressional intent to avoid such narrowing stipulations, the Court in *Devils Films* seemed more to lament congressional inaction than to take issue with the *Mitchell Bros.* interpretation of the congressional record. The presumption of content neutrality in copyright protection has caused the Supreme Court to rely on the statutory record to reveal congressional intent. *See Eldred v. Ashcroft*, 537 U.S. 186, 212 (2003) (deferring to Congress as to "how best to pursue the Copyright Clause's objectives"); *see also* Margot Kaminski, *Copyright Crime and Punishment: The First Amendment's Proportionality Problem*, 73 MD. L. REV. 587, 606–08 (2014) (discussing *Eldred*, 537 U.S. 186).

35. It has in fact been cited in only five rulings: *Liberty Media Holdings v. Swarm Sharing Hash File*, 821 F. Supp. 2d 444 (D. Mass. 2011); *Next Phase Distrib., Inc. v. John Does 1–27*, 284 F.R.D. 165 (S.D.N.Y. 2012); *Nova Prods. v. Kisma Video, Inc.*, 03-Civ. 4259, 2004 U.S. Dist. LEXIS 24171 (S.D.N.Y. Nov. 30, 2004); *Malibu Media, LLC v. John Does 1-28*, No. 12-CV-12598, 2012 U.S. Dist. LEXIS 189311 (E.D. Mich. Oct. 31, 2012); *Patrick Collins, Inc. v. John Does 1–33*, No. 4:12-CV-13309, 2013 U.S. Dist. LEXIS 50674 (E.D. Mich. February 27, 2013), none of which accepted the premise of *Devils Films* that obscene materials were beyond copyright eligibility.

36. Here it is ambiguous whether the attribution of criminality is to the films themselves or to the business operation of *Devils Films*, which distributed the films in interstate commerce.

Mitchell Bros. and subsequent cases regarding the content neutrality of copyright protection.³⁷

The other Second Circuit ruling cited by a footnote in *Liberty Media*, and the only one directly addressing the question of content exceptionalism, in fact supported *Mitchell Bros.* In *Nova Prods. Inc. v. Kisma Video, Inc.*,³⁸ the principal defendant relied on the declaration of one of the other named individual defendants that the videos at issue were “all ‘hard-core’ pornographic films” and argued they did not warrant copyright protection, citing *Devils Films*.³⁹ However, the Court found that declaration insufficient to categorize the entire catalog of films as obscene, especially without reference to a relevant and evolving community standard under *Miller*, and denied summary judgment.⁴⁰

The *Nova* Court ruled that while it reached no decision on the question of whether the films were obscene, any such factual determination would not affect their eligibility for copyright protection since obscenity was not an accepted affirmative defense for copyright infringement.⁴¹ And while *Devils Films* had felt comfortable in declaring films obscene, *Nova* was clear that such a determination was a matter for a jury, especially considering that courts in that circuit had previously found other ‘hard-core’ pornographic materials to be insufficiently ‘patently-offensive’ to be considered obscene.⁴²

II. THE ASSERTION OF DIVERGENCE AMONG THE DISTRICT COURTS

So, the assertion in *Next Phase* that “judges all across the country and in this District have reached different conclusions” on the copyrightability of obscene matter clearly warrants closer scrutiny. In the five years since

37. Up to that point, the Second Circuit had not considered the issue at all, and it can be argued it has not since.

38. *Nova Prods.*, 2004 U.S. Dist. LEXIS 24171. This case represents a consolidation of four cases involving *Nova/Devils Films: Devils Films, Inc. v. Kisma Video*, 02 Civ. 6277; *Nova Products v. Kisma Video*, 02 Civ. 3850; *Nova Products v. 610 Video*, 03 Civ. 3379; and *West Coast, Inc. v. 557 Video, Inc.* 03 Civ. 4259.

39. *Nova Prods.*, 2004 U.S. Dist. LEXIS at *7.

40. *Id.* at *8–10. This is an example of indiscriminate classifications of film based on content. That a film is pornographic (even hard-core pornographic) does not render it legally obscene, and to argue that “hard-core pornographic films” are ineligible for copyright protection is to apply a common-law exceptionalism not found in copyright statutes. See discussion, *supra* note 28.

41. *Id.* at *10, *12–13 (citing *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979) and *Jartech, Inc. v. Clancy*, 666 F.2d 403 (9th Cir. 1982) as the only two court of appeals’ decisions to consider the issue).

42. *Id.* at *12 (citing *U.S. v. Various Articles of Obscene Merch.*, 565 F. Supp. 7, 9 (S.D.N.Y. 1982), *aff’d*, 709 F.2d 132 (2d Cir. 1983)).

Liberty Media, the Second Circuit has addressed infringement on copyrighted pornographic films in 17 cases: 6 against multiple John Does during 2012–13,⁴³ and 11 against individual John Does, mostly in the two years (2015–16).⁴⁴ All were ‘swarm’ file-sharing cases, characterized by one judge as “well-worn territory for Malibu [Media] and similar plaintiffs alleging copyright infringement of erotic movies by John Doe defendants.”⁴⁵ In all but four, the plaintiff was ruled to have established a sufficient copyright for a *prima facie* claim for expedited discovery without mentioning whether copyright protection might be compromised by the content of the films. In the other four, the Second Circuit likewise accepted the plaintiffs’ copyright registration but averred in some manner to the prospect that eligibility for copyright protection, based on questionable content, might still be an open question.⁴⁶

In other districts, the rulings in swarm copyright infringement cases followed similar patterns. Among the plaintiffs, Malibu Media has almost single-handedly swamped the district courts with multiple or individual

43. See *Next Phase Distrib., Inc. v. John Does 1–27*, 284 F.R.D. 165 (S.D.N.Y. 2012); *John Wiley & Sons, Inc. v. John Does 1–44*, No. 12 Civ. 1568, 2012 U.S. Dist. LEXIS 118232 (S.D.N.Y. Aug. 21, 2012); *Malibu Media, LLC v. John Does 1–5*, 285 F.R.D. 273 (S.D.N.Y. 2012); *Media Prods. v. John Does 1–26*, 12 Civ. 3719, 2012 U.S. Dist. LEXIS 125366 (S.D.N.Y. Sept. 4, 2012); *John Wiley & Sons, Inc. v. John Does 1–24*, 12 Civ. 4231, 2013 U.S. Dist. LEXIS 36359 (S.D.N.Y. Mar. 15, 2013); *Malibu Media, LLC v. John Does 1–11*, 12 Civ. 3810, 2013 U.S. Dist. LEXIS 99332 (S.D.N.Y. July 16, 2013).

44. See *Pearson Educ. Inc. v. John Doe*, No. 12 Civ. 4786, 2012 U.S. Dist. LEXIS 146721 (S.D.N.Y. Sept. 28, 2012); *Patrick Collins, Inc. v. John Doe*, 288 F.R.D. 233 (E.D.N.Y. 2012); *Patrick Collins, Inc. v. John Doe*, 945 F. Supp. 2d 367 (E.D.N.Y. 2013); *Malibu Media, LLC v. John Doe*, No. 14-CV-8903, 2015 U.S. Dist. LEXIS 177954 (S.D.N.Y. Jan. 28, 2015); *Malibu Media, LLC v. John Doe*, No. 15-CV-1883, 2015 U.S. Dist. LEXIS 51579 (S.D.N.Y. Apr. 10, 2015); *Malibu Media, LLC v. John Doe*, No. 15-CV-1883, 2015 U.S. Dist. LEXIS 76608 (S.D.N.Y. June 5, 2015); *Malibu Media, LLC v. John Doe*, No. 1:16-CV-01068-AWI-SKO, 2016 U.S. Dist. LEXIS 147883 (E.D. Cal. Oct. 25, 2016); *Malibu Media, LLC v. John Doe*, No. 15 Civ. 4743, 2015 U.S. Dist. LEXIS 108932 (S.D.N.Y. Aug. 18, 2015); *Malibu Media, LLC v. John Doe*, No. 15 Civ. 4381, 2015 U.S. Dist. LEXIS 108934 (S.D.N.Y. Aug. 18, 2015); *Malibu Media, LLC v. John Doe*, No. 1:16-CV-02462-AJN, 2016 U.S. Dist. LEXIS 64656 (S.D.N.Y. May 16, 2016); *Malibu Media, LLC v. John Doe*, No. 15-CV-3504, 2016 U.S. Dist. LEXIS 112187 (E.D.N.Y. Aug. 23, 2016).

45. *Malibu Media, LLC*, 2015 U.S. Dist. LEXIS 108934, at *2 (The Court in this instance ignored the issue of content altogether by simply referring to the films as erotic rather than pornographic or obscene).

46. See *In re BitTorrent Adult Film Copyright Infringement Cases*, 296 F.R.D. 80, 87 n.8 (E.D.N.Y. 2012) (citing *Liberty Media Holdings v. Swarm Sharing Hash File and John Does 1–38*, 821 F. Supp. 2d 244 (D. Mass. 2011)); *Next Phase*, 284 F.R.D. at 171 (“the Court recognizes that, if the Motion Picture is considered obscene, it may not be eligible for copyright protection.” (pointing to *Liberty Media Holdings*, 821 F. Supp. 2d 444)); *Malibu Media, LLC v. John Doe*, No. 15 Civ. 4369, 2015 U.S. Dist. LEXIS 87751, at *13 (citing *Next Phase*); *Malibu Media, LLC*, 2016 U.S. Dist. LEXIS 112187, at *23–24 (citing defendant’s argument that *Next Phase* questioned the eligibility of obscene motion pictures, but clarifying that “for the limited purposes of this Motion for Discovery, the fact that [the plaintiff] is a registered copyright owner of the Motion Picture satisfies the requirement of a *prima facie* showing of copyright infringement.” (citing *Next Phase*, at 171) (emphasis original)).

John Doe suits, seeking to subpoena ISPs for subscriber identifications.⁴⁷ Most were voluntarily dismissed by the plaintiff having succeeded in acquiring subscriber identifications by third-party subpoenas.⁴⁸ Through 2014, 54 rulings were made in six districts regarding multiple John Doe defendants, mostly sorting through and ruling on the appropriateness of joinder.⁴⁹ Since then (i.e., 2015–2016), 33 rulings have been made in three districts regarding individual John Does, likely filed in response to severance decisions in most of the multiple John Doe cases.⁵⁰ Of those that even mentioned the plaintiff's copyright registration, most accepted it as sufficient ownership to support a prima facie claim for expedited discovery without consideration of or even mention that copyright protection might be compromised by the downloaded film's content.

A few of those that accepted plaintiff's ownership added in brief manner that it was still an open question as to whether obscene materials were eligible for copyright protection. In the Third Circuit, for example, one of the 15 John Doe cases referencing *Next Phase* as precedent regarding joinder issues footnoted that the doctrine of content neutrality in copyright remained an open question.⁵¹ In the Sixth Circuit, in each of two of the 16 cases filed against multiple John Does in 2012–2013, two individual John Does argued directly that plaintiffs might not be eligible for copyright protection, both referencing the *Liberty Media* footnote in *Next Phase*.⁵² However, in each of those cases, the Court was unable to reconcile

47. See generally Sag, *supra* note 1.

48. *Id.*; see also Roy Strom, *In a Rare Scene, Malibu Media Takes a Loss*, CHI. DAILY LEGAL BULLETIN (Feb. 9, 2016), <http://www.chicagolawbulletin.com/Archives/2016/02/09/copyright-02-09-16> (citing research by the firm Lex Machina indicating 84% of 5,207 Malibu suits in the past four years 'likely settled' with summary judgments issued in only two cases).

49. First District: 16; Second District: 5; Third District: 10; Sixth District: 16; Eighth District: 2; Ninth District: 2; Eleventh District: 3.

50. Second District: 11 (2 in 2016); Third District: 5 (none in 2016); Ninth District: 25 (all in E.D. Calif. in 2016, through Oct. 25). All of the rulings admit that there is an inconsistent record between districts and even within districts on the propriety of joinder, depending on circumstances, as described in *Dragon Quest Prods., LLC v. John Does 1–100*, No. 12-6611, 2013 U.S. Dist. LEXIS 83683, at *9–23 (D.N.J. June 13, 2013) and summarized in *Next Phase*, 284 F.R.D. at 168–69.

51. *Malibu Media, LLC v. John Does 1–16*, 902 F. Supp. 2d 690, 700 n.8 (E.D. Pa. 2012) (“at least one court [*Next Phase*] has relied, albeit in part, on the possibility that a motion picture considered obscene may not be eligible for copyright protection” and remarking that neither the Third Circuit nor the Supreme Court had addressed the issue, but other circuits had determined or endorsed that copyright laws are not content-based).

52. *Malibu Media, LLC v. John Does 1–28*, No. 12-CV-12598, 2012 U.S. Dist. LEXIS 189311, at *25–28 (E.D. Mich. Oct. 31, 2012); *Patrick Collins, Inc. v. John Does 1–33*, No. 4:12-CV-13309, 2013 U.S. Dist. LEXIS 50674, *31–33 (E.D. Mich. February 27, 2013). Both cases quoting extensively from the discussion in *Next Phase*—quoting from *Liberty Media*—as raising the prospect that an obscene film may not be eligible for copyright protection, but also citing the holding of content neutrality in *Mitchell Bros.* and repeating *Next Phase*'s assertion that “judges across the country and within this district have reached different conclusions on this issue.” See *Next Phase*, 284 F.R.D. at 171.

that argument with the plaintiffs' subsequent plea for severance based on the uniqueness of each's circumstance and defense. Were they advocating joinder, as implied by arguing plaintiff ineligibility which would affect all John Does similarly, or against joinder?⁵³ In the Eighth Circuit, two claims against multiple John Does in 2013 argued joinder issues along *Next Phase* lines without mentioning copyright eligibility at all. In the Ninth Circuit, all 17 cases filed in 2016 against individual John Does accepted each plaintiff's copyright registration as valid, citing *Next Phase* but again without mentioning eligibility. In the Eleventh Circuit, the same pattern occurred in three cases filed in 2012–13.

It is, therefore, impossible to substantiate *Next Phase's* proposition that judges in the Second, and other circuits have reached conflicting conclusions on content exceptionalism from the commonly-accepted ruling in *Mitchell Bros.* Of the rulings in the Second Circuit, only *Devils Films* can be said to have taken issue with *Mitchell Bros.* in denying preliminary relief based on its own judgment that some of the films were obscene and their producer's operation was clearly criminal. However, the Circuit then offered a series of confusing caveats, the first being that as a preliminary judgment the Court did not have to consider whether obscene works were ineligible for relief—the issue that *Mitchell Bros.* had arguably settled. But the ruling had clearly done just that, following what has been assumed to be the doctrinal reasoning of the early nineteenth century rulings of Lord Eldon—obscene materials were criminal in nature and ineligible for copyright protection. The Court then asserted its discretion to accept or reject the *Mitchell Bros.* position on the issue in future Second Circuit cases, without saying it was rejecting it in that case (which it arguably had). Finally, continuing to argue the case it maintained was not before it, the Court took direct issue with the *Mitchell Bros.* reasoning that the statutory history of copyright protection supported an explicit congressional unwillingness to establish content exceptionalism, countering that it “strains credulity” that Congress intended copyright protection for obscene materials.⁵⁴

53. *Malibu Media, LLC v. John Does 1–28*, No. 12-CV-12598, 2012 U.S. Dist. LEXIS 189311, at *27–28 (E.D. Mich. Oct. 31, 2012) (“it is not clear which way the Does’ argument cuts: if Doe 18 and 25 intend to assert that the Work is not entitled to copyright protection, that defense would presumably be available to all Defendants, which, in turn, favors joinder.”); *Patrick Collins, Inc. v. John Does 1–33*, No. 4:12-CV-13309, 2013 U.S. Dist. LEXIS 50674, at *33 (E.D. Mich. February 27, 2013) (repeating verbatim *Malibu Media, LLC*, 2012 U.S. Dist. LEXIS 189311, *27–28, for Does 8 and 27).

54. Here the Court missed the point made by *Mitchell Bros.*, i.e., that Congress had explicitly avoided any content exceptionalism rather than it was favoring or disfavoring one type of content by not specifying content limitations.

After *Devils Films*, the echoes of content exceptionalism grow decidedly more confusing. In *Nova*, the Court definitively rejected the defendant's *Devils Films* claim that obscene films did not warrant copyright protection and instead stated that a film's potential criminality was the province of a jury to decide.⁵⁵ In *Liberty Media*, the Court in fact agreed with *Mitchell Bros.* that obscenity was not a litmus test for copyright protection eligibility and content criminality was for a jury to decide, but then averred in its often-cited footnote that the issue apparently resolved by the reasoning in *Mitchell Bros.* remained "unsettled in many circuits."⁵⁶ However, because that issue was not before it, it offered no opinion on it.⁵⁷

After that, in a smattering of district court cases beginning with *Next Phase*, each successive court accompanied its ruling with one or both of two reflections back to the footnote in *Liberty Media* that: (1) if a film at issue were obscene, it may not be eligible for copyright protection, implicitly not accepting *Mitchell Bros.* as doctrinally compelling unless it was embraced in future by a range of appeals decisions or by the U.S. Supreme Court; and (2) the case law on the issue was "unsettled," with judges "all over the country" coming to different conclusions. Neither of these positions was accompanied by a substantive argument. Their positions were in effect briefing points having little to do with the issues being argued in the case, based on the footnote in, or out of context from *Liberty Media* that had referred to *Devils Films*.⁵⁸ Ironically, while some courts have mentioned one or both points, some did so and then rejected one or both of them and others simply referenced them back to *Next Phase*.

55. *Nova Prods. v. Kisma Video, Inc.*, 03-Civ. 4259, 2004 U.S. Dist. LEXIS 24171, at *5 (S.D.N.Y. Dec. 1, 2004).

56. *Liberty Media Holdings, LLC v. Swarm Sharing Hash File and John Does 1–38*, 821 F. Supp. 2d 444, 447 n.2.

57. *Id.*

58. A telling example may be *Malibu Media LLC v. John Does 1–6*, 291 F.R.D. 191, 198 (N.D. Ill. 2013) in which John Doe 2, without counsel, argued in his brief that illegal and immoral works have no right to copyright protection, citing "the Rule in Priestley's case." Doe 2 was in fact simply quoting five paragraphs from the defendant's brief in *Malibu Media, LLC v. Fantalis*, No. 12-CV-00886-MEH, 2012 U.S. Dist. LEXIS 150812 (D. Colo. Oct. 18, 2012), neither even explaining the reference. *Mitchell Bros.* did not actually cite *Priestley*, stating only that "the theory that a person can have no property in obscene works, merely expresses by means of a legal fiction the underlying judicial moral conclusion that the work is not worthy of protection . . . [a] doctrine [that] has not been adopted in this country . . . and should not be." *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 861 (5th Cir. 1979) (emphasis added); EATON S. DRONE, TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES EMBRACING COPYRIGHT IN WORKS OF LITERATURE AND ART, AND PLAYRIGHT IN DRAMATIC AND MUSICAL COMPOSITIONS 183–84 n.1 (1879) (stating that "the authority of a *nisi prius dictum* of Lord Chief Justice Eyre at the trial of Dr. Priestley" had resulted in that theory, but referred to it as an Eldonian doctrine rather than a Priestley rule); see also Alexander, *supra* note 5, at 232–42 (discussing *Priestley*).

So the echoes in *Next Phase* can be traced back through *Liberty Media* to *Devils Films*, at least enough to remind us of the common law doctrine of content exceptionalism if not to actually reassert or re-argue it. Since virtually all of the relevant swarm cases never reach litigation, we have seen no substantive defense arguments beyond a court's simply noting the prospect that a plaintiff may not be eligible for copyright protection despite having a valid copyright registration. Implicitly but never mentioned in rulings simply raising the point without discussion or reference, the court would then have to use its discretion to deny equitable relief on public policy grounds. Certainly no court, including arguably *Devils Films*, has directly ruled in support of content exceptionalism.

Finally, it has been argued that the doctrine of content neutrality advanced by *Mitchell Bros.* may be weakened by the language of the Copyright Clause itself, that protected materials should be limited to those that promote progress in the sciences and useful arts.⁵⁹ However, *Mitchell Bros.* did not argue that the Congress lacked authority under the Copyright Clause to establish content-based standards but rather that it had historically chosen not to and, furthermore, courts were ill-equipped to parse copyright eligibility without clearer guidance from Congress.⁶⁰ Moreover, a national copyright eligibility standard that discriminated based on content might not withstand application of diverse "community standards" under *Miller*.⁶¹ And, any congressional effort to specify content limitations would have to balance implicit social harm against the prospect that all materials have some informational value.⁶² This would have to be done without setting an unconstitutional condition on the receipt of copyright protection.⁶³

59. See generally Haber, *supra* note 7; Ned Snow, *Discrimination in the Copyright Clause*, 67 ALA. L. REV. 583, 603 n.108 (2016). This point was one among a battery of defense claims raised but not argued in *Wong v. Hard Drive Prods.*, No. 12-CV-469-YGR, 2012 U.S. DIST. LEXIS 52551, at *5 (N.D. Cal. April 13, 2012) (alleging plaintiff's "work is not copyrightable under Article I, Section 8 of the United State Constitution because it is pornography, which is not a work that promotes the progress of science and the useful arts"), and was not addressed as the parties quickly settled.

60. *Mitchell Bros.*, 604 F.2d at 861 ("it is evident to us that it is inappropriate for a court, in the absence of some guidance or authorization from the legislature, to interpose its moral views between an author and his willing audience"); see also *Eldred v. Ashcroft*, 537 U.S. 186, 208 (2003) ("[courts] are not at liberty to second-guess congressional determinations and policy judgments of this order, however debatable or arguably unwise they may be.").

61. *Mitchell Bros.*, 604 F.2d at 858, 861 (stating that a congressionally-enacted obscenity exception "would fragment the uniform national standards of the copyright system" and "frustrate the congressional purpose underlying an all-inclusive copyright statute.").

62. See Haber, *supra* note 7, at 468–469.

63. See Tushnet, *supra* note 8, at 422; see generally Kathleen M. Sullivan, *Unconstitutional Conditions*, 102 HARV. L. REV. 1413 (1989); Edward J. Fuhr, *The Doctrine of Unconstitutional Conditions and the First Amendment*, 39 CASE W. RES. L. REV. 97 (1989).

III. THE COURT AS CENSOR MORUM

That courts might use their own discretion to parse among registered copyrighted materials harkens back to the doctrine of content exceptionalism associated with the rulings of Lord Chancellor Eldon, which state that materials of a criminally libel (or illicit) nature were ineligible for equitable relief or even consideration because their intent was to bring harm to the public.⁶⁴ Plaintiffs bringing copyright infringement claims regarding such materials were considered to be approaching the court with “unclean hands,” i.e., having treated the public at large in an inequitable fashion by publishing such offending materials. Subsequent case law and widely-accepted treatises at the time and through the first half of the twentieth century identified the doctrine with Eldon’s ruling in *Southey v. Sherwood*⁶⁵ and a series of other supporting Chancery cases in the early 1820s.⁶⁶

In most legal sources, *Southey* has been cited as precedent together with *Walcot*,⁶⁷ which itself had referenced a ruling at assizes in *Dr. Priestley’s Case* in which Lord Chief Justice Eyre denied property damages for the plaintiff’s manuscripts and journals lost in a fire on the presumption that his prior writings were notoriously republican in nature and likely criminal.⁶⁸ In that volatile period, the question of content exceptionalism in copyright focused almost entirely on the publication of allegedly seditious writings that promoted republicanism against the Monarchy, brought the Crown and its government into disrepute, or advocated a constitutional reform or even revolution.⁶⁹ However, the writings in *Walcot* were satirical odes lampooning the Crown and the government rather than polemic

64. See, e.g., Paul M. Zall, *Lord Eldon’s Censorship*, 68 PMLA 436, 436–38 (1953) (arguing that, contrary to the standard Chancery practice of issuing temporary injunctions against literary piracy, Eldon established himself as *ensor morum* by denying injunctions against piracy of materials considered injurious).

65. *Southey v. Sherwood* (1817) 35 Eng. Rep. 1006, 1008 (Ch) (denying injunctive relief for a literary work based on his prior ruling in *Walcot* and citing Eyre’s principle “that a person cannot recover damages for a work which is, in its nature, calculated to do injury to the public.”).

66. See Alexander, *supra* note 5, at 282–291.

67. *Id.* at 248–253 (subsequent references in established legal treatises throughout this period and accompanying text).

68. *Dr. Priestley’s Case* (1791) (CPD, *nisi prius*). There exists no published report of *Priestley* other than its mention arguendo in *Southey*. See Alexander, *supra* note 5, at 232 n.58.

69. See generally Clive Emsley, *An Aspect of Pitt’s ‘Terror’: Prosecutions for Sedition During the 1790s*, 6 SOC. HIST. 155 (1981) (tracing prosecutions of reformist writers in the 1790s); JOHN BARRELL, *IMAGINING THE KING’S DEATH; FIGURATIVE TREASON, FANTASIES OF REGICIDE 1793–1796* (2000) (documenting how radicalization of the reform literature in the 1790s caused the government to re-conceptualize the laws of sedition and treason).

republican tracts.⁷⁰ They were nevertheless pointed and biting, and commercially successful at the expense of George III and William Pitt's ministry, perhaps disrespectful enough to be seen as advancing the cause of radical reform.⁷¹ In short, Wolcot's satirical verse danced perilously close to the edge of prosecution for seditious libel, and on two occasions the filing of a criminal information against him was seriously discussed in Privy Council.⁷²

In practicality, *Walcot* became the source of the doctrine of content exceptionalism as it was arguably the first direct application of the clean hands doctrine to copyright. In that case, Eldon accepted as an established governing principle Eyre's dictum that there could be no property in illicit writings and, he argued, without property at issue Chancery would have no jurisdiction over any claims regarding their copyright.⁷³ In law and equity, this would have barely raised an eyebrow, except that in *Walcot*, denial of equity jurisdiction portended a proliferation of rather than a limitation on those writings in the marketplace. However Eldon was more cautious than Eyre. Instead of declaring the contested writings to be criminally illicit and therefore not property, he declared their nature an open question to be determined by a jury and, if they were accepted as property at law (thereby implicitly not criminal), the plaintiff could then return to Chancery for equitable relief.

As *Walcot* has been portrayed as establishing the governing principle for content exceptionalism in copyright, a careful inspection of its particulars and context may be useful. On the surface, it seemed to hold that writings of an illicit nature could not be considered property for purposes of equitable relief as a matter of public policy, since to provide relief would entail using judicial authority to support criminal action against the public. This was quite conventional reasoning, as an application of the clean hands doctrine – publishers of illicit writings were harming the

70. See generally GARY DYER, *BRITISH SATIRE AND THE POLITICS OF STYLE, 1789–1832*, at 8–38 (1997).

71. See JOHN BARRELL, *THE SPIRIT OF DESPOTISM: INVASIONS OF PRIVACY IN THE 1790S*, at 103–144 (2006) (describing three Wolcot publications criticizing the Treasonable and Seditious Practices Act (1795) 36 Geo. 3 c.7, that precipitated government threats of his prosecution that were, after third-party mediation, not actively pursued).

72. *Id.* at 138–141. A criminal information was a mechanism for seeking an indictment directly from King's Bench rather than petitioning a grand jury, as a matter of expediency given the presumed immediacy of need for resolution; see WILLIAM BLACKSTONE, *IV COMMENTARIES ON THE LAWS OF ENGLAND* 304 (5 vols. Oxford: Clarendon, 1765–1769); see also *infra* notes 123 and 124.

73. *Walcot v. Walker* (1802) 32 Eng. Rep. 1 (Ch) (“If the doctrine of Lord Chief Justice Eyre (*Dr. Priestley's Case*, see 2 *Mer.* 437) is right, and I think it is, that publications may be of such a nature, that the author can maintain no action at law, it is not the business of this Court . . . to decree either an injunction or an account of the profits of works of such a nature, that the author can maintain no action at law for the invasion of that, which he calls his property.”) (Italics in original).

public and asking the Court's assistance to continue; of course the Court should refuse collusion in the publisher's criminality. Yet, if the denial of jurisdiction to the purveyor of illicit writings exposed those writings to unrestrained copyright infringement, particularly rampant reprinting at cheaper prices, the Court would appear to have been tacitly (even knowingly) complicit in their proliferation.

At the time, Eldon's ruling in *Walcot* passed virtually unnoticed, except perhaps because its unsuccessful plaintiff was the extremely popular and commercially-successful satirical poet John Wolcot, who published under the pseudonym of 'Peter Pindar.' It appeared to reflect a relatively standard exercise of judicial discretion in denying equitable relief for infringements against copyrighted but nonetheless arguably libelous or illegal writings. But after Eldon's more public *Southey* ruling fifteen years later, the legal community began to express misgivings.⁷⁴ While it may have been appropriate to deny copyright protection to illicit writings, it had been effectuated solely by judicial discretion rather than by legislative action or after jury deliberation. Eldon seemed to have positioned himself as the sole arbiter of illicitness in publication, *ex mero moto*, without even a veiled hint of democratic participation in the process.⁷⁵ This is precisely the type of judicial paternalism that the Fox Libel Act⁷⁶ had sought to overcome at law in the late eighteenth century.

While critics of Eldon's authoritarianism focused on its threat to the democratic balance in judicial proceedings by substituting judicial discretion for jury deliberation, they expressed little concern for the consequences of his ruling on the dissemination of such illicit publications. Denying the author of illicit works the monopolistic benefits of copyright

74. The use of *Southey* as ratio for subsequent cases in 1822 spawned a debate between the Tory QUARTERLY REVIEW, which initially praised Eldon for his cautiousness in not superseding the Attorney-General in the prevention of libelous writings and the Whig EDINBURGH REVIEW, which found Eldon's discretionary judgment not only in contradistinction to precedent but also sourced in his pro-government bias as a member of the cabinet. See Art. VI. – *Cases of Walcot v. Walker; Southey v. Sherwood; Murray v. Benbow, and Lawrence v. Smith.*, XXVII Q. REV. 123, 134–135 (1822); Art. I. *Reports of Cases argued and decided in the High Court of Chancery. By F. Vesey, Junior. Vol. VII. – Dr. Wolcot's Case, 1802. – Mr. Southey's Case, 1817. Lord Byron's Cain, Feb. 1822. – Mr. Lawrence's Lectures on Physiology, March 1822.*, XXXVIII EDIN. REV. 281, 313–314 (1823).

75. See Alexander, *supra* note 5, at 278 n.231. Eldon's ruling is actually more fluid than that, in essence stating he would preliminarily review the contested works to see if they might be of illicit nature and, if so, send them to law ("before I uphold any injunction, I will see these publications, and determine the nature of them; . . . [i]f upon inspection the work appears innocent, I will act . . . ; if criminal, I will not act at all; and, if doubtful, I will send that question to law."). *Walcot*, 32 Eng. Rep. at 1.

76. An Act to Remove Doubts Respecting the Functions of Juries In Cases of Libels (1792) 32 Geo. 3 c. 60 (expanding the considerations of juries to all aspects of the case, including intentions of the defendants). See JAMES OLDHAM, ENGLISH COMMON LAW IN THE AGE OF MANSFIELD 218–235 (2004) (on the legal and political dynamics leading to its passage).

protection appeared at first glance an appropriate means of dissuading authors from publishing such works and thereby protecting public morals from assault. But, as Eldon himself recognized in *Southey*, the practical consequence would prove to be quite the opposite:

It is very true that, in some cases, [the denial of an injunction] may operate so as to multiply copies of mischievous publications by the refusal of the Court to interfere by restraining them; but to this my answer is, that, sitting here as a Judge upon a mere question of property, I have nothing to do with the nature of the property, nor with the conduct of the parties except as it relates to their civil interests; and if the publication be mischievous, either on the part of the author or of the bookseller, it is not my business to interfere with it.⁷⁷

For the Court to withhold copyright protection from illicit works might well further expand their distribution as down-market publishers printed and sold unauthorized copies of copyrighted but nonetheless illicit works in smaller format and lower prices, and without threat of legal retribution. However, working in a fickle but commercially lucrative market of high product demand, authors of illicit writings were often undaunted by the prospect of not controlling the market for their works via copyright protection and were actually emboldened and even enriched by the portrayal of their works as illicit or even illegal.⁷⁸

IV. *WALCOT V. WALKER* AS THE WELLSPRING OF CONTENT EXCEPTIONALISM

Walcot v. Walker was not a typical copyright infringement case of surreptitious counterfeiting and sale of a work registered to another. It was instead an author's claim that his own publisher had overstepped the bounds of consignment of his titles. The consignment had been a

77. *Southey v. Sherwood* (1817) 35 Eng. Rep. 1006, 1008. (emphasis added).

78. These same disincentives to aggressive copyright enforcement exist in the current market for pornographic materials. See, e.g., Christopher A. Cotropia & James Gibson, *The Upside of Intellectual Property's Downside*, 57 UCLA L. REV. 921, 965 (2010) ("giving intellectual property rights to an industry that has little need for an incentive can be counterproductive because the negative effects of the entitlement predominate."); Snow, *supra* note 59, at 628 (the denial of copyright protection potentially having disincentive effect only on producers that rely on copyright protection, which excludes most in the current market, and especially amateur producers).

ramshackle mix of verbal discussions extending over eight months and a bundle of unstated or poorly phrased conditions, wrapped in a temporary deed poll with a memorandum written on the back and titles list attached, secured by a bond, without a final engrossed agreement. And Walker and his partners were hardly small-scale bootleggers engaged in clandestine operations, rather they were among the most reputable booksellers in London. While author-publisher disputes were not uncommon in the late eighteenth century London bookselling market, this one festered for over seven years and was resolved by a ruling at Chancery court that ostensibly established the doctrine of content exceptionalism in copyright.

As a satirical poet in late Georgian England, John Wolcot's stock-in-trade was faux epics, epistles, odes, and random quips published under the pseudonym of Peter Pindar offering mocking praise of the King, the government, and notables of station. First published in the London MORNING POST as small pieces, his works quickly captured the attention and amusement of the reading middle class, especially those who thrived on political criticism. They were published in small elegant pamphlets of verse, at one or two shillings at first, but sold in the thousands, many titles between 1785 and 1790 reaching ten or eleven editions.⁷⁹ However, while Wolcot's lampooning of the governing elite captured the public's fancy (as well as their coin), it also drew the ire of those targeted and frequently raised the prospect of his prosecution for libel. Most dangerous among those were threats of criminal informations briefed against him by the government for seditious libel in response to his cryptic and disrespectful satires of the King or the Pitt ministry. On at least two occasions, his prosecution was only avoided by mediated negotiations, resulting in his desisting from further pointed criticism for a period.⁸⁰

Wolcot's relationship with the booksellers who marketed his titles was always contentious. Book publishing in the London market was highly competitive, and groups of booksellers (and other secondary investors) would form publishing groups, called congers, to pool capital to purchase copyrights to literary works, giving them sole and exclusive rights over

79. See James R. Alexander, *Publishing Peter Pindar: Production, Profits and Piracy in Georgian Satire*, 112 PAPERS BIBLIOGRAPHY. SOC'Y AM. (forthcoming 2018) (documenting the publishing career of John Wolcot).

80. See generally BARRELL, *supra* note 71. The government's threats of prosecution and subsequent negotiations for annuities are also described in JOHN TAYLOR, II RECORDS OF MY LIFE 364–365 (1833); WILLIAM JERDAN, II THE AUTOBIOGRAPHY OF WILLIAM JERDAN 265 (4 vols. 1852–1853); CYRUS REDDING, II FIFTY YEARS' RECOLLECTION, LITERARY AND PERSONAL 271–272 (3 vols. 1858).

distribution of those titles for the duration of their statutory protection.⁸¹ In ‘the trade,’ as it was called, the most effective congers stockpiled copyrights to classical and standard works for which market demand was continuous and profits assured, thereby controlling all elements potentially affecting their profit margin on titles, including printing costs, retail and wholesale distribution as well as auctioning leftover stock, advertising, and price. The larger the number of titles commanded, the more of the bookselling market the congers could control through distribution and could leverage retail price conformity of smaller retailers, thereby earning their common vilification as ‘bibliopolists.’⁸²

Congers used the same strategy to manipulate the market for popular titles such as poetry and novels by entering into formal agreements with new or established authors (like Wolcot) to purchase exclusive rights to current or future titles, each for a one-time fee that could range into hundreds and on occasion thousands of pounds for a work of the most famous contemporary authors. While the market for popular titles was characteristically faddish and short-lived – from six months to two years – and made such investments an uncertain business, the ever-expanding middle-class readership consumed popular titles at a rate that made the immediate retail market fairly lucrative for those who carefully controlled production costs and anticipated the market capacity for newer editions of popular titles.⁸³

That Wolcot published pamphlets rather than books of verse allowed him to respond more agilely in a reading market hungry for political commentary. He was one of few authors who did not sell his copyrights outright, at least not at first. Instead, he negotiated his own deals with printers and controlled every facet of how his works appeared, from the look of the title page, to the weight and quality of paper, and even the inclusion of advertisements, messages to the reading audience, and occasionally an engraved frontispiece. He also dictated the size of print runs and whether/when to commission a new edition. He then consigned copies of his titles to booksellers’ networks in London (usually through one primary publisher) and later the English provinces and Edinburgh, and they

81. See ISABELLA ALEXANDER, *COPYRIGHT LAW AND THE PUBLIC INTEREST IN THE NINETEENTH CENTURY 20–22* (2010).

82. See generally WILLIAM ZACHS, *THE FIRST JOHN MURRAY AND THE LATE EIGHTEENTH-CENTURY LONDON BOOK TRADE 66–86* (1998); JAMES RAVEN, *PUBLISHING BUSINESS IN EIGHTEENTH-CENTURY ENGLAND* (2014).

83. See ALEX WEEDON, *VICTORIAN PUBLISHING: THE ECONOMICS OF BOOK PRODUCTION FOR A MASS MARKET, 1836–1916*, at 92–99 (2003).

in turn retailed or redistributed stock and handled advertising and sales for an agreed-to commission plus costs.

It was the dickering with booksellers over the commission, rebates for returned (unsold) copies, rates charged for labor or paper, and handling and advertising costs that Wolcot found most distasteful. He developed a prickly distrust of booksellers, assuming that they always wanted the profits of his own labors for themselves, always padded their costs and calculations of overstock, and constantly undervalued the market to gain a better commission rate. And he was ever on the lookout for bookseller deviousness in accounts and willing (with his sizable market clout) to negotiate distribution through different booksellers when he sensed an advantage for doing so, or if his personal relationship with one bookseller soured.

Wolcot first considered selling his copyrights in 1793 and entered into an oral agreement (or ‘treaty’) with booksellers John Walker, George Goulding, George Robinson, his brother John and his son George Robinson, Jr., in early October for the sale of all individual works he had previously published to date, ultimately totaling thirty-seven titles, for an annuity of £250 secured by a £5,000 bond.⁸⁴ Wolcot was to deliver all copies he had in stock and had the option of providing corrections to any future published editions. While he was free to continue to publish new individual titles, Wolcot had initially promised the conger first refusal on the copyrights of any titles he chose to sell. The conger in turn agreed to actively market the purchased titles, and proper substitution of parties should one or more of the members of the conger die or fail to meet his part of the obligation.⁸⁵

The original agreement had been drawn up by Walker’s counsel, engrossed and dated October 3, 1793, and delivered to Wolcot, who reportedly returned it unsigned and “in a mutilated and unusable state,”

84. By all accounts, the agreement was patched together from a series of informal discussions between Wolcot and Goulding regarding the prospective sale, but once the terms were set in writing, the lead partner in Wolcot’s dealings with the conger became Walker, who had already published a number of Wolcot’s individual titles by himself or with Goulding. Details of the negotiations and various interpretations of the agreement have been gleaned from documents filed in two cases at Chancery involving the principals: *Robinson v. Wolcot*, The National Archives (U.K.), (hereinafter NA), C13/8/34, including bill of complaint (Nov. 15, 1798), answer (July 24, 1800), amended bill (Oct. 22, 1800), and amended answer (Dec. 22, 1801) (plaintiff requesting injunctive relief from Wolcot’s action at law to attach the bond for nonpayment of the annuity and accounting of all profits for titles published by Wolcot but not offered to the conger); and *Walcot v. Walker*, NA, C13/2065/36, including Bill of Complaint (Feb. 2, 1802), and Answer (Feb. 26, 1802) (plaintiff requesting injunctive relief from Walker’s unauthorized publication and sale of his copyrighted titles, and an accounting of copies on hand and profits to date).

85. See *Robinson v. Wolcot*, (1802) C13/8/34; *Walcot v. Walker*, C13/2065/36.

presumably because he felt it unsatisfactorily captured what he believed were the terms of the agreement. He then had his own counsel prepare a different version, together with a list of the titles, to which the conger did not object, but neither had they signed it, now wishing to reduce the annuity.⁸⁶ At each successive drafting, the conger pressed for more specification on the conditions, particularly that new titles, if for sale, be offered to them first at a fair price or that they would be allowed to meet a bona fide market offer from another publisher; that if Wolcot published new titles, the conger would be at liberty to include them in its octavo volumes of *THE WORKS OF PETER PINDAR* but not singly without the author's permission; and that the annuity be apportioned to each of member of the conger, under a future instrument to be signed by the parties. In the interim, the agreement was to be executed under a short deed poll authorizing the transfer of property and attaching a memorandum expressing the conditions, likewise dated June 7, 1794.⁸⁷

By third party accounts, the agreement was drafted so hastily, "with a very illaudable degree of obscurity,"⁸⁸ that through their attorneys both parties immediately began to contest its interpretation and its arrangements for payments, ultimately seeking resolution at common law and then at equity.⁸⁹ Initially members of the conger began to withhold annuity

86. See *Wolcot v. Walker*, C13/2065/36, Answer of John Walker. Walker and his partners suspected they had been manipulated into accepting an annuity strung out over the life of the author rather than a one-time flat rate of about £500 by Wolcot's feigning serious illness during negotiations, which the conger had in turn attempted to capitalize on by quickly agreeing to the annuity. The conger also reportedly chafed that the value of the property in those titles had been diminished by the recently enacted Treasonable and Seditious Practices Act (An Act for the Safety and Preservation of His Majesty's Person and Government against Treasonable and Seditious Practices and Attempts (1795) 36 Geo. III, c.7) that further restrained libelous writings and potentially exposing publishers of criminally libelous titles to prosecution, particularly as Wolcot had conceded that one of the titles sold to the conger contained a libel and he had avoided prosecution by withdrawing it from publication.

87. *Id.* The signed deed poll gave the conger unilateral discretion (without obligation) to publish any/all so designated works as they wished, but still required the annuity be paid regardless, in effect prepaying for the option of publishing the designated titles. There is no evidence that Wolcot or Walker filed a copy of the deed poll with their documents at Chancery and no copy has been found. By the account of both parties, the memorandum was written on the back of the deed poll, with a list of titles attached. Despite their stated intentions, there is no evidence that a final instrument was agreed to or signed by the parties, leaving each to interpret the deed poll to best advantage.

88. *Dr. Wolcot*, IV ANNUAL BIOGRAPHY AND OBITUARY FOR THE YEAR 1820, at 283 (London: Longman, Hurst, Rees, Orme, and Brown, 1820). The various reports of the negotiations, based primarily on recollections reported in *Dr. Wolcot*, at 252–254, and JERDAN, AUTOBIOGRAPHY, *supra* note 80, at 265, reveal that neither party seems to have been above seeking unfair advantage. In the end, Wolcot clearly prevailed by opting for the annuity since he outlived all of the original partners in the conger, leaving their heirs burdened with the annuity until his own death in 1819.

89. That the agreement required clarification after clarification, and still ended up disputed in Chancery is testimony to how anxious each party was to gain advantage by quickly signing the initial deed poll, prompting Wolcot's principal biographer to reflect that "documents signed in haste are often a rich source of income for the lawyers." TOM GIRTIN, DOCTOR WITH TWO AUNTS: A BIOGRAPHY OF PETER PINDAR 155 (London: Hutchinson, 1959).

payments, maintaining that Wolcot failed to comply in good faith with his agreement to offer them new titles and hoping to leverage more favorable treatment.⁹⁰ Wolcot countered by suing the conger at law for nonpayment and sought court permission to attach the bond. In this he failed, apparently having not provided sufficient evidence on breaches and damages to warrant issuing a writ and summoning a jury.⁹¹ Nonetheless, his filing suit jarred the conger, which then immediately sought and gained a temporary injunction staying Wolcot's action at law which, after delays awaiting subsequent amendments to bills and answers, apparently remained in effect without a hearing on the cause.⁹²

Finally, after the conger included new but unpurchased titles in their 1802 octavo vol. V of Pindar's *WORKS*, Wolcot sued for copyright infringement. Documents submitted by both parties referred to the memorandum written on the back of the deed poll and an attached list of thirty-four titles previously published to which the agreement referred.⁹³ And both parties admitted that the list was incomplete, having left off three titles also published by that time.⁹⁴ For further clarification, Walker produced a receipt for £125, presumably the first half-year annuity payment, signed by Wolcot and dated June 17, 1794, with the notation "for all works already printed and published by me,"⁹⁵ which both parties agreed gave the conger liberty to publish a total of thirty-seven titles.

The principal dispute springing from the agreement was over whether the conger had discretion to include new titles in its octavo editions of Pindar's *WORKS* without additional compensation or agreement. This issue had been festering since contested drafts of the original agreement were

90. Under the conger's recollection of their October 1793 verbal agreement, Wolcot was to offer for sale the copyright for £50 for each title of at least 42 pages quarto, but Wolcot maintained that the deed poll and memorandum superseded that and gave him leeway to offer new titles at a fair price. By his own admission, Wolcot only offered the conger titles he thought of marginal market value, and so radically over-priced his better pieces as to preclude the conger from purchasing them, which the conger considered bad faith and contrary to their agreement.

91. See *Walcot v. Goulding* (1799) 101 Eng. Rep. 1303 (KB).

92. See *Robinson v. Wolcot*, (1802) C13/8/34. The conger's petition for injunctive relief against Wolcot's suit failed and they had to pay £20 in court costs and agree to semi-annual payments but some continued to miss payments, especially after the principal had died and his obligation passed to his family. The acrimony over annuity payments continued sporadically right up to Wolcot's death, the Robinson family at least once in arrears on its share in 1817. See KENNETH HOPKINS, *PORTRAITS IN SATIRE* 267 (London: Barrie Books, 1958).

93. See *Walcot v. Walker* (1802) C13/2065/36.

94. These included two titles individually purchased and published by Walker "Pathetic Odes" (publ. Sept. 1793) and "Celebration" (publ. Jan. 1794), and one unregistered title "A Commiserating Epistle to James Lowther, Earl of Lonsdale" (London: James Evans, Nov. 1791) (hereinafter "Epistle to Lonsdale"), which Wolcot stated in the agreement contained a libel that caused him to cease its publication.

95. See *Minute Book of Robert Martin Leake*, NA, C37/2497 (March 11, 1802).

exchanged but apparently never arose in a manner requiring formal resolution until 1796. In early January of that year, Walker published vol. IV of the octavo set of Pindar's WORKS including five new (arguably unauthorized) titles.⁹⁶ This immediately prompted discussions between Wolcot and his attorney Thomas Holloway, who advised Wolcot that the new volume had been printed for Walker "without [Wolcot's] privity and consent" and his perusal of the bond regarding the annuity indicated it covered his "works up to No. 34," and, in any case, not the additional five titles. Holloway therefore pressed Wolcot to see Walker personally before further action was contemplated.⁹⁷

The next week, Wolcot notified Holloway that Walker sought an amicable settlement but nonetheless directed his attorney to procure a copy of vol. IV "in order to ground the action and to have it ready to prove in the trial of the intended act against Mr. Walker if necessary."⁹⁸ In late April, Walker having not conceded on the issue, Holloway prepared the filing of "a bill in Equity for an injunction to restrain the defendant from selling the fourth volume . . . unless [Walker] settled in two or three days."⁹⁹ While there was apparently no further discussion of that particular matter for some time, Holloway also drew Wolcot's attention to "several other printers have been selling other Editions of [his] works" and reviewed the next steps to be taken against their infringement, adding at the end of his ledger notation "and it was concluded not to declare against Walker for the present."¹⁰⁰

96. Both Wolcot's claim and Walker's answer portrayed the infringement in volume IV to be the inclusion of four titles, but later in each document acknowledged a fifth "The Lousiad, Canto V and Last," probably not claimed by Wolcot because it was one of very few titles he neglected to register.

97. This sequence is described in the ledger pages of attorney Thomas Holloway found in the John Wolcot Papers, Sir George Grey Special Collections, Auckland (NZ) Central Library, GMS 5, vol. II, at 33 (Jan. 7–8, 1796) [hereinafter Wolcot Papers]. Walker's octavo vols. I–III contained thirty-six clearly licensed titles but excluded the "Epistle to Lonsdale" which both parties assumed to contain a libel. Walker's octavo vol. IV was comprised of five titles (Nos. 37–41) published after June 1794 which Wolcot insisted were unlicensed. The Wolcot Papers are in six volumes, all containers of loose sheets. Volume 5, which contains letters, ledger sheets and other inventories, is in two volumes. The loose pages are hand-numbered for cataloguing and here that page number is then specified by date of entry.

98. Wolcot Papers, *supra* note 97, at 33 (Jan. 13 & 25, 1796).

99. *Id.* at 33 (Jan. 29, 1796).

100. *Id.* at 34 (April 29, 1796). Holloway provides no further reference to discussion of the Walker action after February 3, 1796, so perhaps Wolcot had wearied of the dispute over those titles which had cost him not only attorney fees but also filing and copy charges each time he dealt with Chancery. At that time, in most cases of small-time booksellers publishing unauthorized copies of individual titles, copyright holders easily secured a settlement for costs and destruction of all infringing copies by having an attorney send a letter threatening prosecution for damages at Common Pleas, as Wolcot had regarding Exeter bookseller Joseph M'Kenzie. *Id.* at 36 (Sept. 9 & 14, 1796).

It was only after the 1801 publication of the conger's octavo vol. V that Wolcot filed a complaint in Chancery asking for injunctive relief and disgorgement of profits. In it, he detailed Walker's unauthorized publication of the five titles in the conger's 1796 octavo vol. IV and the additional nine titles in its new vol. V. Complicating the matter but not mentioned in Wolcot's claim was the conger's publication of a duodecimo edition of Pindar's *WORKS* in 1797, the first two volumes containing purchased titles and the third containing the same contested five pieces as the octavo vol. IV the year before.¹⁰¹ In the fall of 1800, Walker had published a fourth volume in the duodecimo edition, including the same contested nine titles as the octavo vol. V.¹⁰²

What prompted Wolcot's copyright infringement complaint in early 1801 rather than five years earlier is a matter of conjecture, probably related to the market implications of the conger's interpretation of its liberty to publish new titles in their octavo edition.¹⁰³ But our purpose here is to recognize what was being factually contested and how that was reflected in Eldon's ruling. Wolcot's bill requested an injunction to stay the conger's unauthorized publication of his new titles, which Eldon routinely ordered pending Walker's answer.¹⁰⁴ Walker responded within three weeks, arguing the agreement allowed the conger to negotiate for publication rights to any future works as individual pieces but assumed the liberty to include any subsequently-published new titles in its future octavo editions at no additional compensation. He derived this interpretation from the language in the deed poll which seemed to differentiate between the sale of the copyrights to individual titles and the permission to use individual titles in octavo editions. As the purchase of the copyrights gave the conger sole discretion over publication of those titles in any format, Walker reasonably contended the permissive language regarding the octavo edition referred to future titles, for which permission and fair price were required only if the

101. Under the Statute of Anne, infringement claims had to be filed within three months of the alleged infringement; (1709) 8 Anne 19, § 10, a period long past for the 1796 and 1797 volumes, as Holloway had cautioned. *See* Wolcot Papers, at 36 (Sept. 29, 1796). Eldon did reference the time lag regarding the 1796 volume as being germane. *See* *Walcot v. Walker* (1802) 32 Eng. Rep. 1, at 1 ("It is not immaterial also, that they have been permitted to publish in their trade for six years together without an action.").

102. The publication date imprinted on the title page of the duodecimo vol. V is 1801, but Walker's answer of Feb. 26, 1802 noted it was published by September/October 1800. *See* *Walcot v. Walker* C13/2065/36, Answer of John Walker, lines 22–23.

103. *See generally* Alexander, *supra* note 79 (Wolcot realizing he had not anticipated the profit share he might lose if the conger retained an open-ended liberty to reprint his new titles in future octavo editions).

104. *See* Minute Book of Peter Wright, NA, C37/2501 (Feb. 8, 1802); Minute Book of John Coppinger, NA, C37/2489 (Feb. 8, 1802).

conger wished to publish them as individual titles but not for their use in the octavo edition after Wolcot had been published them individually.

This liberal interpretation of the agreement was however confined to octavo volumes, and Walker conceded his infringement in the duodecimo edition “through Inadvertance (sic) and Inattention to the terms of the said memorandum.”¹⁰⁵ As ordered, he provided an accounting for all copies in stock and profits on all editions containing the contested titles and asked the Court to determine fair compensation on the duodecimo infringement. Walker also prayed for dissolution of the injunction nisi causa, which was also routinely granted pending Wolcot’s response and a hearing.¹⁰⁶

Wolcot immediately moved against the dissolution, consideration of which was extended until the next term with the parties “be[ing] at liberty in the meantime to procure the agreement.”¹⁰⁷ In the subsequent hearing on May 6, 1802, Eldon ordered the injunction on the octavo edition dissolved, with the plaintiff at liberty to recover at law and then to return for equity consideration.¹⁰⁸ In regard to Walker’s duodecimo edition, a copy of which had not been provided by Wolcot, Eldon ordered the injunction on that dissolved as well, unless a copy was provided within the week.¹⁰⁹ When the court reconvened in late May, Wolcot pleaded that the injunction be maintained until a hearing on cause, which Eldon rejected, ordering the dissolution on the octavo edition to stand.¹¹⁰ In the same hearing, Walker moved for dissolution of the injunction on the duodecimo edition, a copy of which having still not been produced as directed by the Court, and Eldon ruled that dissolved as well.¹¹¹

105. *Wolcot v. Walker* (1802) C13/2065/36, Answer of John Walker, line 54.

106. *Id.*; see also Minute Book of John Coppinger, NA, C37/2489 (Feb. 27, 1802). Notice to show cause was delivered on Mar. 4, 1802, as noted in the affidavit of William Wood, NA, C31/303, pg. 2 (Mar. 8, 1802), and in Wainwright’s ledger notes. See *Wolcot Papers*, *supra* note 97, at 245 (n.d.) (recording a charge of two shillings “On being served with an order to dissolve the injunction obtained in this cause—making two fair copies thereof to annex to briefs”).

107. Minute Book of Robert Martin Leake, NA, C37/2497 (March 11, 1802).

108. *Wolcot v. Walker* (1802) 32 Eng. Rep. 1 (Ch); Minute Book of John Coppinger, NA, C37/2490 (May 6, 1802); Minute Book of Peter Wright, NA, C37/2502/2 (May 6, 1802); also noted in attorney Wainwright’s ledgers, *Wolcot Papers*, *supra* note 97, at 246 (n.d.) (recording a charge of thirteen shillings four pence for “Attending court when the motion was fully argued & the Chancellor ordered the Injunction to be dissolved”). Wolcot’s attorney at Chancery immediately moved for dissolution of the orders for cause, consideration of which was delayed until the next session two weeks hence, during which the parties were again encouraged to settle. Minute Book of Robert Martin Leake NA, C37/2497 (March 11, 1802) (“Let this motion stand over to the next seal and let the partys (sic) be at liberty in the meantime to procure the agreement”).

109. *Wolcot*, 32 Eng. Rep., at 2.

110. Dissolution of the injunctions had been ordered on May 27, 1802, prompting Wolcot’s attorney to immediately move the order be discharged until a full hearing on the cause. That motion was extended over until May 31, 1802, when Eldon disallowed it, NA, C33/518, f.544v.

111. Minute Book of John Coppinger, NA, C37/2490 (May 31, 1802); Minute Book of Peter Wright, NA, C37/2502/5 (May 31, 1802).

V. RECONSIDERING WOLCOT

In his bill of complaint, Wolcot quoted from the endorsed agreement

[T]hat Doctor Wolcot shall give the within mentioned proprietors the refusal of all his future works at a fair price in case of sale—the proprietors to have the liberty of printing in their Octavo Edition any works that Dr. Wolcot may have published separately upon his own account in Quarto or otherwise but not to print the same singly without permission.¹¹²

He then clarified that it was never his intention that the conger was to have the liberty of publishing future works “without first paying for the copyright thereof,” the words in the memorandum regarding future titles intended as having “a retrospective and not a prospective meaning.”¹¹³ Wolcot further detailed how he had made applications to Walker to desist from selling further copies of the octavo edition and to turn over all unsold copies and account for his profits.¹¹⁴ When Walker did not respond to those entreaties, Wolcot filed his bill of complaint requesting injunctive relief and an accounting since, he maintained, Walker “insists on his right to publish the said Poems . . . and intends to publish and sell the same unless he shall be restrained from so doing so by . . . injunction.”¹¹⁵

Walker responded by providing his own view of the details of the agreement, quoting the same passage from the endorsed memorandum but interpreting it to mean that, separate from the refusal clause, once a new title was published individually, the conger was at liberty to include it in its octavo editions without negotiating further authorization or compensation.¹¹⁶ He admitted to having published the contested titles but maintained that there had been a common understanding going back to October 1793 that the conger was at liberty to do so in its octavo edition of WORKS and not singly. Why else would the octavo vol. IV have remained for sale uncontested for five years, long past the statutory requirement that it be challenged in a timely manner?¹¹⁷ Walker argued that Wolcot was in effect claiming against what he had at least tacitly agreed to in the

112. Wolcot v. Walker (1802) C13/2065/36, Bill of Complaint of John Wolcot, lines 25–27.

113. *Id.* at lines 27–30.

114. *Id.* at lines 10–11.

115. *Id.* at lines 30–31.

116. *Id.*; see also Answer of John Walker, *supra* note 84, at lines 36–38, 70–71.

117. *Id.* at lines 43–46. On the statutory limitation on filings see (1709) 8 Anne 19, § 10.

memorandum and by his inaction, and was therefore not entitled to share any profits from the octavo edition.¹¹⁸

Walker then addressed one of the purchased titles, “The Epistle to Lonsdale,”¹¹⁹ which Wolcot maintained he had stopped publishing to forestall a libel prosecution.¹²⁰ Wolcot had not claimed copyright infringement regarding that particular title as Walker had purchased it, but he was asking the Court to protect his property in the contested titles from Walker’s expansive interpretation of the deed poll. For his part, Wolcot may have initiated specific discussion of the title simply to be inclusive in the listing of titles already published by him by that date but in doing so he introduced several complications: first, Wolcot had not registered that title and could not claim property in it under the Statute of Anne anyway; second, it may not have been recognized as property even under common law if it were found in a legal action to have contained a libel; and, third, selling a legally unpublishable title without notification to the other party might be considered fraud, sufficient to void the agreement and his annuity. So Wolcot’s mention of the libelous nature of the title in both the memorandum and his claim may have been an effort to forestall future third-party actions against himself should an action be filed against the title if published in the future or to simply insulate the agreement from claims of fraud.

Walker assured the court that Wolcot had forewarned him of the libelous nature of the title and he had not printed or sold any copies of it individually or in editions.¹²¹ For purposes of the infringement claim, discussion of that title seemed superfluous but it raised the prospect of Wolcot being ineligible for equitable relief under the clean hands doctrine. Under the affirmative defense of ‘unclean hands,’ inequities claimed to disqualify the plaintiff from copyright protection had to be directly related to the contested issues between the parties, which would have excluded any matters related to the “Epistle to Lonsdale” other than perhaps as a general reflection of the possibly questionable nature of his satirical verse. Obviously the Court would not want to be seen as providing copyright

118. *Id.* at lines 60–62. If Walker had submitted to copyright violations in the octavo volumes, he would have had to not only account for profits from those volumes (which he did under subpoena) but also turn over all unsold copies—the remainder of his inventory that he had estimated at 2,000 copies of vol. IV and 1,750 copies of vol. V—and been unable to sell them within full sets, as they were advertised, at a significant loss.

119. *See supra* note 94.

120. *See* *Walcot v. Walker* (1802) C13/2065/36, Answer of John Walker, line 69.

121. Walker did not include the “Epistle to Lonsdale” in the conger’s five-volume octavo set 1794–1801, or in the two-volume set of individual prints he published in partnership with Goulding in 1793, or in the conger’s three-volume duodecimo set in 1797 or its fourth volume in 1801.

protection for a title that might subsequently be found criminally libelous. On the other hand, suspecting or claiming that a title was criminally libelous was not the same as having a jury finding it so. So, it behooves us to briefly examine the libel reported by Wolcot and whether it might have prompted Eldon's suspicion that any of the contested titles might not be 'clearly innocent.'

The alleged Lonsdale libel was contained in a Pindarian panegyric of a comic episode involving the Earl of Lonsdale, perhaps one of the wealthiest men in England at the time, and covered with unmasked delight by the London press. The "Epistle to Lonsdale" was a witty verse mocking the Earl's ill-treatment of the residents of Whitehaven and the workers in the collieries there under his charge, and publicly scolded the Earl for being far too benevolent toward the villagers, given his family's long and distinguished heritage of oppressive and tyrannical behavior. Lonsdale took great exception to this lampooning and pressed for the briefing of criminal information against Wolcot for libel¹²² which, after several hearings, was exhibited and subject to immediate prosecution.¹²³ But Wolcot was never prosecuted, apparently having settled with the Earl by agreeing to cease publication¹²⁴ and leaving unresolved the question of whether the title was in fact criminally libelous and by extension whether its author could claim property in it at law.¹²⁵

For purposes of Wolcot's infringement claim, resolution of those issues was unnecessary as it was not one of the contested titles, and would have been relevant only if that title in some way was directly related to the challenged publication of the new titles, which it was not. Clean hands, as it were, was off the table. The issue was thus reduced to whether Walker could include any new titles in its octavo edition without further agreement or compensation, a matter of interpreting the language and intent of the

122. *King v. Wolcot*, NA, KB10/48 (Easter term 1792), as reported in *THE (LONDON) TIMES*, no. 2224, p. 3 (Feb. 8, 1792); *THE (LONDON) TIMES*, no. 2227, p. 3 (Feb. 11, 1792).

123. *See King v. Wolcot*, NA, KB27/45, f.586v (April 27, 1792).

124. A short time thereafter, a small notice appeared in the London newspapers indicating that the parties had settled, apparently with Wolcot agreeing to no further publication of the title. *See THE (LONDON) TIMES*, no. 2335, p. 2 (June 16, 1792). While exhibition of the information was ordered, there is no record that the normal processes for prosecution were subsequently followed, i.e., Wolcot was not subpoenaed to appear and plead within four days, notice was not served, the prosecutor did not file the required recognizance, and the information was not settled, engrossed or filed, all indicating a quick private settlement. *See CRIMINAL CASES ON THE CROWN SIDE OF KING'S BENCH: STAFFORDSHIRE, 1740-1800*, at 40-42 (ed. Douglas Hay, Bristol: Staffordshire Record Society, 2010).

125. Had the processes been followed, the prosecutor would have had to proceed to trial within one year (i.e., by June 1793) or forfeit costs to the defendant. *See DOUGLAS HAY, CRIMINAL CASES ON THE CROWN SIDE OF KING'S BENCH: STAFFORDSHIRE* 40. Even if Wolcot had reneged on his settlement with Lonsdale, the Earl had forfeited his right to an action at law by pursuing an information and it was unlikely the Court would grant another information.

original deed poll and memorandum. This type of issue would have routinely been directed to the Master of Rolls for study and ruling, or simply referred back to the parties to work out on their own, which Eldon had directed twice.¹²⁶

Deciphering what each of the parties might have intended or understood in the agreement was often a matter whether their stated intentions were borne out in their subsequent actions. In this, Walker's position appeared to be more compelling, as Wolcot had not contested Walker's use of new titles in the octavo vol. IV for five years. However, Eldon's ruling never addressed the deed poll but instead narrowed the issue procedurally to whether Wolcot had property in the titles. After reviewing the octavo edition and citing Eyre's dictum that authors of publications of illicit or criminal nature cannot maintain an action at law, Eldon ruled he was unable to continue the temporary injunction unless Wolcot could maintain an action at law, even though Walker had admitted to publication of contested titles.¹²⁷ In addition, Eldon denied even having the jurisdiction to rule on whether there could be property in the contested titles until their nature had first been reviewed at law, concluding that, on preliminary consideration, he could not authoritatively confirm that Wolcot's writings were 'clearly innocent' in nature.¹²⁸ So he dissolved the injunction on the

126. See Minute Book of Robert Martin Leake, NA, C37/2497 (March 11, 1802); Minute Book of John Coppinger, NA, C37/2490 (May 6, 1802); Minute Book of Peter Wright, NA, C37/2502/2 (May 6, 1802).

127. See *Walcot v. Walker* (1802) 32 Eng. Rep. 1 (Ch). Eyre's nisi prius dictum, while not likely by itself to be the source of a governing principle, was nonetheless consistent with doctrinal treatment of property extending back at least a half-century; see, e.g., *Roach v. Garvan* (1742) 26 Eng. Rep. 683, 683 (Lord Hardwicke ruling that, as a matter of settled practice, substantive judgment regarding whether legally-recognizable property existed in a work was the province of law not equity). *Priestley* then became a "carrier" of the principle without affording a detailed argument regarding its ratio. See Clyde Croft, *Lord Hardwicke's Use of Precedent in Equity*, in LEGAL RECORD AND HISTORICAL REALITY: PROCEEDINGS OF THE EIGHTH BRITISH LEGAL HISTORY CONFERENCE 121, at 134–135 (ed. Thomas Watkin, Cardiff 1987) (identifying how principles historically emerged from patterns of policy decisions of the Court without specific precedent, but once established were then be carried along by future rulings that discretely (however mistakenly) become tagged as 'authorities'). The weakness of *Priestley* as an independent source of precedent was that it was impossible to determine the nature of the plaintiff's lost writings - they could have been republican and prospectively seditious (on the basis of which he had not been prosecuted) or alternatively scientific and of great value. Eyre in effect declared them to be without demonstrable value as property, implicitly unless or until *Priestley* could demonstrate their value at law.

128. Eldon did not clarify if he deduced that from seeing the submitted copy of vol. IV of Pindar's octavo WORKS, from his general familiarity with Wolcot's poems as a member of the often-targeted government's inner circle, or from his own knowledge of the exhibition of the Lonsdale information, having been Solicitor-General at the time. Eldon's inability (or unwillingness) to declare Wolcot's titles as presumptively innocent (sufficient to maintain the injunction) compares interestingly to his acceptance of the innocence of Lord Byron's "Beppo" solely on the assurance from plaintiff's counsel that it was "perfectly innoxious [and] perfectly inoffensive." *Murray v. Dugdale* (1823) (Ch.), reprinted in THE (LONDON) TIMES, July 23, 1823, no. 11931, p. 3. However, Eldon was clearly aware of criticisms of his earlier rulings based on *Priestley*, and in Murray reminded that "the Court ha[s] no

publication and sale of the octavo edition, giving Wolcot the “liberty to apply for an injunction, in case [he] succeeds in an action,”¹²⁹ concluding: “As to one of these editions, it is not possible to grant the injunction, until the right of the Plaintiff has been tried in an action. The facts may alter the effect of the agreement at law; for, if not, the Court ought not to give an account of the unhallowed profits of libelous publications.”¹³⁰

Eldon also stated he would dissolve the injunction on publication and sale of the duodecimo edition, allowing that he would review the nature of that work if it were presented to the court within a week and “[i]f upon inspection the work appears innocent, I will act upon that [Walker’s] submission; if criminal, I will not act at all, and, if doubtful, I will send that question to law.”¹³¹

The distinction is critical, for while Eldon retained the authority to rule that works brought before him were ‘clearly innocent,’ following precedent he ruled that works of questionable nature would have to first be reviewed at law.¹³² That a work might contain libelous content, at least at the stage where a plaintiff might ask for an injunction against infringement on its copyright, was likely more a matter of contextual consideration than a close reading of text. As a satirist of wide renown, Wolcot had skirted the borderline of seditious libel since 1785, and come perilously close to prosecution on several occasions. On the other hand, his caustic treatment

criminal jurisdiction in cases of this nature, and that if the work were really criminal, the publication of it could not be stopped here, but it must be done in another way,” a principle that “had been settled without question for a considerable time” and which he could not abandon “till the Legislature should think it fit to alter the law itself,” *id.*

129. *Walcot*, 32 Eng. Rep., at 1.

130. *Id.* Here Eldon’s language was quite precise—Wolcot was not yet eligible to apply for an injunction because he had not yet established his property in the contested titles, complicated by the intimation that the titles contained illicit material and were thus ineligible for protection under common law.

131. *Id.* At the time, Eldon was chided for having expressing doubt about and therefore dissolving an injunction *ex mero motu* on a text he admittedly had not seen. *See, e.g.*, JOSEPH STORY, II COMMENTS ON EQUITY JURISPRUDENCE § 936, p. 213, n. 1 (2 vols. 1835-1836) (“there is great difficulty in adopting this doctrine, denying the protection of an injunction in matters of property upon mere doubts”); JOHN CAMPBELL, X LIVES OF THE CHANCELLORS 255–256 (10 vols. London: John Murray, 5th ed. 1868) (“notwithstanding his propensity [as Attorney-General] to prosecute libels, he had been afraid to bring the author before a jury, and that he now thought it a more convenient course to unite in his own person the functions of prosecutor and of judge”). The question at that point would have been whether any party might have been injured by leaving the temporary injunction on duodecimo edition in place until Eldon had the opportunity to review it, but Wolcot had not complied with the Court’s order to produce it and Eldon in effect shifted the burden of property back to him. While we know Wainwright purchased copies of the octavo edition for the purpose of appending it to Wolcot’s claim, there is no record he also purchased copies of the duodecimo edition.

132. On Eldon’s vacillations regarding questionable material. *See* Dennis Klinck, *Lord Eldon’s ‘Equity’*, 20 LEGAL HIST. 51, 52–53 (1999); C.J. Rossiter & Margaret Stone, *The Chancellor’s ‘New Shoe’*, 11 U.N.S.W.L.J. 11, 11–16 (1988).

of the Pitt government or other personages (not to mention the Church of England) had made his verse titillating, slightly dangerous, and of course enormously popular. A quick perusal of the contents of the octavo edition would have confirmed the absence of the purportedly libelous “Epistle to Lonsdale” obviating that concern, but its mere mention in Wolcot’s complaint might have given Eldon sufficient cause to direct the whole matter to law for determination as to whether the author could have property in the contested pieces published in the octavo set.

Eldon’s reasoning on how the innocence or potentially harmfulness of their literary content could be determined remains obscure, particularly since his ruling was quite brief¹³³ and ostensibly procedural.¹³⁴ Even if it were not considered definitive regarding the content of the titles, his ruling was chastised as arbitrary and perhaps even prejudiced, which he publicly lamented, having hoped through procedural consistency to avoid the approbation that such decisions varied depending in the predispositions of the magistrate.¹³⁵ If he were simply following doctrinal procedure that an author or publisher of a literary work of questionable content had to first establish property in that work at law before arguing that he had lost value in it through infringement and could seek relief at equity, the only discretion came in whether there was sufficient doubt about the nature of the work to warrant its direction to law. There a judgment would be rendered appropriately by a jury, one way or the other.

And unless Eldon directed all literary content brought before him in copyright claims to law, he could not avoid differentiating the innocent from the questionable. In *Walcot*, he expressed doubt regarding the octavo edition without specification and directed it to law, but dissolved the injunction in the interim, considering perhaps that the relative cost to the

133. The authoritative (and only) nominate report on *Walcot v. Walker* has been reproduced from FRANCIS VESEY, SAMUEL BARKER, ET AL. REPORTS OF CASES ARGUED AND DETERMINED IN THE HIGH COURT OF CHANCERY FROM THE YEAR 1789 TO 1817, at 1 (London: Brooke, 1827), which footnoted Eldon’s reference to Eyre as referencing *Dr. Priestley’s Case* and *Murray v. Dugdale*. Vesey also referenced *Hogg v. Kirby*, (1803) 32 Eng. Rep. 336 (Ch.), in which Eldon was conflicted on maintaining an injunction on a work containing a false assertion in its title (its author being fictitious) but—unlike in *Walcot*—did so temporarily while directing the plaintiff to law to sort out property rights with due speed, after which he would consider a motion to dissolve the injunction. *Hogg*, 32 Eng. Rep., at 340.

134. That Eldon saw Wolcot’s claim as requiring only a procedural ruling may be evidenced by his not even mentioning the case in his JUDICIAL NOTEBOOKS 1802–1821 (Special Collections, Georgetown Law Library), which consistently included quite detailed factual notations regarding virtually every substantive case Eldon heard at equity between 1802 and 1813. The case he did note the week prior to the hearing on *Walcot* was *O’Connor v. Cook*, (1802) 31 Eng. Rep. 1247, 1252 which he likewise directed to law. See II JUDICIAL NOTEBOOKS, 214b-220 (11 vols.) (“Where there is a reasonable doubt before you → [arrow] to the prejudices of a jury and to a judge of a jury.”).

135. See *Gee v. Pritchard* (1818) 36 Eng. Rep. 674, 679 (Ch) (Eldon acknowledging his desire to avoid Selden’s “reproach that equity . . . varies like the Chancellor’s foot”).

integrity of the Chancery court was higher than incremental lost profits in the delay. Interestingly, he was criticized less severely for that judgment, based on his cursory review of the text, than for his dissolution of the injunction on the duodecimo edition, which he had not seen at all.

To dismiss Eldon's ruling in *Walcot* as quaintly arcane would be a mistake. First of all, it is arguably the doctrinal root source of both common law precedent regarding content exceptionalism in copyright and the echoes we hear in recent swarm cases. While Eldon's subsequent rulings provided amplification and nuance, they were all consistent with *Walcot* in both ratio and resolution. Furthermore, *Walcot* frames our consideration of the fundamental issues raised regarding whether copyrighted works of libelous content—seditious, blasphemous, or obscene—could be eligible for equitable relief, portrayed in recent echoes as still an 'open question.' In this, Eldon could not avoid some level of discretion but largely deferred final judgment to law or the legislature. Finally, *Walcot* reinforces that, in the absence of strict legislative guidance regarding content exceptions and consistent with established constitutionally protected rights of expression, any judgment of a copyrighted work's criminality of content in cases where there might be some doubt remained the province of a jury. As indicated by *Mitchell Bros.*, such a judgment must precede any challenge to a registered work's eligibility for protection from infringement.

There is of course the question of whether the harmful consequences of denying copyright protection to questionable works might be sufficiently grave and immediate to warrant discretionary action by the court in refusing equitable relief. Such a denial would be an open invitation to piracy and further proliferation of the questionable works, as Eldon himself addressed in *Southey*, lamenting the obvious tradeoff but ultimately regarding it the duty of the legislature to make such judgments.¹³⁶ That Congress has not adopted content-excepting language to prevent such harms therefore remains compelling, as acknowledged by *Mitchell Bros.*, even though statutory adoption of content discriminatory language may still be within Congress's authority under the Copyright Clause if standards could be fashioned consistent with First Amendment protections.¹³⁷

VI. FALSE ECHOES

The echoes of content exceptionalism in recent swarm cases reflect all these issues, however faintly and perhaps even unknowingly. However,

136. See *Southey v. Sherwood* (1817) 35 Eng. Rep. 1006, 1008 (Ch).

137. See generally Snow, *supra* note 59.

with the possible exception of *Devils Films*, they all either adhered to the Eldonian conclusion that such judgments are the province of juries rather than court declaration or sought safe ground in noting it to be an ‘open question.’ It is here that Eldon’s ruling in *Walcot* seems to have been misinterpreted. Eldon did not declare Wolcot’s verse libelous and therefore ineligible for injunctive relief. Instead, he ruled that libelous nature of Wolcot’s verse, admitted in his own bill of complaint, was ambiguous—not clearly innocent and yet not clearly criminal—and could only be determined by a jury.

That Wolcot’s works might have fallen into the ‘doubtful’ category was no great surprise, given his admitted libel in the non-contested title and his reputation as an author whose works were consistently under scrutiny for seditious libel. Eldon’s deferral of the contested titles to law would then have been a reasonable contextual judgment rather than the product of his own close reading of the text, and he thereby left the door ajar for equitable relief should Wolcot’s property in them be accepted in an action. That several other plaintiffs directed to law in a similar manner did not return to Chancery left the impression that such a deferral was a death knell, a signal that the works were probably ineligible.¹³⁸ This if nothing else may have caused the misreading of Eldon’s ruling.

The recent faint echoes of content exceptionalism therefore tend to ring false. The sporadic claim that the rulings within or between districts exhibit disagreement over content neutrality under *Mitchell Bros.* is simply without substantiation. In fact, excepting *Devils Films*, all subsequent rulings have been substantively consistent with the argument and ruling in *Mitchell Bros.*, even while some in the same breath repeat the axiom that content neutrality ‘remains open question.’ Moreover, even the common law notion of content exceptionalism, presumably the source of the echoes we hear, lacks clear doctrinal roots. If traced back to its original explication in *Walcot v. Walker*, we discover it is not based on Eldon’s ruling or its underlying ratio but instead is sourced in its perceived consequence of having effectively branded as criminal any questionable (or objectionable) content in contested titles. That Eldon’s rulings in *Walcot* and subsequent cases were based on his discretionary judgment that the titles were intended to harm the public and therefore were ineligible for copyright protection is not borne out in the case history. Similarly, in none of the recent swarm cases, including the often-cited *Devils Films*, was a copyright claim

138. Each case not pursued to law, or successfully pleaded at law but not brought back to equity, had its own unique circumstances that made pursuit contrary to the interests of the plaintiff. See Alexander, *supra* note 5, at 259–275.

declared ineligible for relief based on substantive review of its content by court declaration (as ‘obscene’), by its general categorization (such as pornography, or ‘hard-core), or by a jury.¹³⁹

This review of recent swarm cases reveals faint and intermittent echoes of the common law notion of content exceptionalism, that the acceptance of the principle of content neutrality in copyright is still in fact an open question, and courts may be justified in denying copyright protections to duly registered properties as a matter of public policy discretion. This seems to but does not quite contradict the content neutrality principle in *Mitchell Bros.*, and might be considered even more timid than that, to point of being misleading. None of these rulings makes any attempt to provide a ratio for content exceptionalism but instead they collectively, each by citing the others, appear to embrace a legal argument they assumed had been governing since the notion of content exceptionalism was first enunciated in copyright in *Walcot v. Walker*. However, a closer reading of *Walcot* reveals the ruling was largely procedural rather than substantive and supportive of content discrimination, and it neither initiated nor established the notion of content exceptionalism. At best, an argument for content exceptionalism has always drawn its strength not from court doctrine but rather from the anticipated negative consequences of applying content neutrality in copyright, expressed even more strenuously in the 1820s than today. Whether the court might or should supplant legislative prerogative was never a serious consideration, then or now.

139. See *Flava Works, Inc. v. Gunter*, 689 F.3d 755 (7th Cir. 2012) (“the prevailing view is that even illegality is not a bar to copyrightability.”).