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## **A Copyright Conundrum: Protecting Email Privacy**

Ned Snow

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## A Copyright Conundrum: Protecting Email Privacy

*Ned Snow*\*

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## I. INTRODUCTION

*It is certain every man has a right to keep his own sentiments, if he pleases; he has certainly a right to judge whether he will make them public, or commit them only to the sight of his friends.*<sup>1</sup>

For centuries courts have recognized property rights in personal correspondence.<sup>2</sup> As far back as 1741, courts have held that authors of letters retain rights to their expressions even after recipients take possession of the letters.<sup>3</sup> Private expression has received the protection of property.<sup>4</sup> Today the new medium of personal correspondence, email, demands that same protection.<sup>5</sup> At the click of a mouse, email recipients parade others' expression literally around the world, often creating a most embarrassing outcome for the original sender.<sup>6</sup> Electronic

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1. *Millar v. Taylor*, (1769) 98 Eng. Rep. 201, 242 (K.B.).

2. See, e.g., *Lish v. Harper's Magazine Found.*, 807 F. Supp. 1090, 1110 (S.D.N.Y. 1992) (discussing damages for publication of copyrighted letter); *Folsom v. Marsh*, 9 F. Cas. 342, 349 (C.C.D. Mass. 1841) (No. 4901) (Story, J.) (discussing copyright invasion of plaintiff's letters); *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 484–85 (1867) (discussing property rights of letters and their contents); *Baker v. Libbie*, 97 N.E. 109, 111 (Mass. 1912) (discussing writer's property rights in letters); *Millar*, 98 Eng. Rep. at 242 (discussing property rights of manuscript); *Pope v. Curl*, (1741) 26 Eng. Rep. 608, 608 (Ch.) (discussing property rights of writers and receivers of letters).

3. See *Pope*, 26 Eng. Rep. at 608 (granting injunction to stop publication of a book of letters written by Alexander Pope).

4. See, e.g., *Baker*, 97 N.E. at 111 (“The right of the author to publish or suppress publication of his correspondence is absolute in the absence of special considerations . . . .”); *Woolsey v. Judd*, 11 How. Pr. 49, 55 (N.Y. Sup. Ct. 1855) (“We must be satisfied, that the publication of private letters, without the consent of the writer, is an invasion of an exclusive right of property which remains in the writer, even when the letters have been sent to, and are still in the possession of his correspondent.”); *Gee v. Pritchard*, (1818) 36 Eng. Rep. 670, 675–76 (Ch.) (“It has been decided, fortunately for the welfare of society, that the writer of letters, though written without any purpose of profit, or any idea of literary property possesses such a right of property in them, that they cannot be published without his consent, unless the purposes of justice, civil or criminal, require the publication.”); accord James Madison, *Property*, NATIONAL GAZETTE, Mar. 27, 1792, in 14 THE PAPERS OF JAMES MADISON 266 (Robert A. Rutland et al. eds., 1983) (“[A] man has a property in his opinions and the free communication of them.”).

5. See Robert A. Cinque, *Making Cyberspace Safe for Copyright: The Protection of Electronic Works in a Protocol to the Berne Convention*, 18 FORDHAM INT'L L.J. 1258, 1258–59 (1995) (“With the click of a mouse or the tap of a key, virtually anyone with a computer and a telephone can obtain vast quantities of information from almost anywhere on the globe. These conditions pose a formidable challenge to the international protection of intellectual property. Copyrighted works, which include . . . forms of expression, are especially vulnerable to piracy.” (footnotes omitted)); Posting of James Grimmelmann to Yale LawMeme, *Accidental Privacy Spills: Musings on Privacy, Democracy, and the Internet*, <http://research.yale.edu/lawmeme/modules.php?name=News&file=article&sid=938> (Feb. 19, 2003, 22:02 EST) (observing the harmful impact of not protecting email expression through copyright law, i.e., inhibition of creative and frank thought).

6. See Grimmelmann, *supra* note 5 (reciting the intense scrutiny that the Pulitzer Prize winning, *Newsday* reporter Laurie Garrett experienced after her personal email, which provided a

forwarding is killing private expression.<sup>7</sup> Stripped of expressive privacy, email senders are beginning to restrain expression: where an email sender would rather a sentiment not be forwarded to a third party, the sentiment is simply left out of the email.<sup>8</sup> Creative, frank, and clear expression is suppressed to avoid the costly tariff of exposure on the information superhighway.<sup>9</sup> Email demands the privacy protection that for centuries the law has afforded personal correspondence.<sup>10</sup>

Past protection of expressive privacy has existed under common-law copyright.<sup>11</sup> For over two-hundred years, common-law copyright offered near-absolute protection to authors of letters.<sup>12</sup> This protection came through a specific right called the right of first publication.<sup>13</sup> The right of

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candid description of the World Economic Forum, ended up all over the Internet); Charles Mandel, *E-Mail Stink Proves Web's Power*, WIRED NEWS, Mar. 10, 2003, <http://www.wired.com/news/privacy/0,1848,57960,00.html> (reporting that a personal email that recommended its recipients boycott fish-farming products had, after the email had been forwarded without its sender's consent, caused widespread alarm among fish farmers that resulted in a public apology from the sender); Ben McGrath, *Oops*, THE NEW YORKER, June 30, 2003, at 34–35, available at [http://www.newyorker.com/talk/content/?030630ta\\_talk\\_mcgrath](http://www.newyorker.com/talk/content/?030630ta_talk_mcgrath) (collecting stories about unintended consequences of email recipients forwarding sender's expressions without permission).

In addition to the restraint of expression that individuals experience, businesses may incur financial or reputational costs as a direct result of unauthorized email forwarding. See Mandel, *supra* (discussing negative repercussions to employer that a personal email of its employee caused); White Paper of Proofpoint, Inc. & Forrester Consulting, *Outbound Email and Content Security in Today's Enterprise*, 2–7, 11–15 (May 2006) (on file with author) (describing policies that US and UK employers implement to reduce costs resulting from unauthorized viewing of employees' email).

7. Cf. Mandel, *supra* note 6 (quoting professor of journalism at Columbia University for proposition that email senders must restrict their expression to that which the senders would be comfortable viewing on the front page of a newspaper).

8. See *id.* (advising restraint in email expression); cf. Grimmelmann, *supra* note 5 (opining that unprotected email may lead to a dulling of expression).

9. See sources cited *supra* note 6; cf. *Woolsey*, 11 How. Pr. at 62–63 (“[L]etters never intended to be published, and written on familiar subjects, are usually more *interesting and valuable* than those elaborately written and originally intended for the press.”).

10. See *Woolsey*, 11 How. Pr. at 63 (opining that “private letters, although not intended to be published, and however familiar and trivial the subjects to which they relate” were the proper subject of copyright law, and that “the writer of such letters has an absolute right to forbid their publication by another”).

11. See cases cited *supra* note 2; 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 5.04 (2006) (describing the protection that copyright law affords letters).

Under specific circumstances, email could be protected under trade-secret law. See, e.g., APG, Inc. v. MCI Telecomms. Corp., 436 F.3d 294, 307 (1st Cir. 2006) (contemplating whether disclosure of email constituted violation of corporate trade secret, but ultimately determining that no violation occurred because the information was not of a confidential nature). To receive that protection, an email must (1) mention a trade secret, and (2) disclose the trade-secret information under an established confidential relationship. ROGER M. MILGRIM, MILGRIM ON TRADE SECRETS § 3.03 (2005). The application of trade-secret law to email, however, is outside the scope of this Article. The Article considers the protection that the law confers on senders of email, regardless of the email expression's content.

12. See cases cited *supra* note 2.

13. Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 551 (1985).

first publication allowed an author exclusive control over whether and when a letter would be published to a third party who was not originally intended as the recipient.<sup>14</sup> The right ensured that letter recipients could not copy the expression in a letter and give that copy to a third party.<sup>15</sup> In other words, the right provided a letter author the exclusive power to decide whether and when the expression in a letter—even if already sent to its intended recipient—would be published. Publication to a third party was controlled by the author. For example, an unfaithful husband who sent amorous letters to his lover could control whether and when his lover could copy and distribute those letters to any other person.<sup>16</sup> Notably, common-law copyright afforded this right to authors without requiring that an author follow any formal procedure, registration or otherwise.<sup>17</sup> The cheating husband would hold a common-law copyright in the letters as soon as he penned the ink. Any expression qualified for common-law protection.<sup>18</sup>

Then in 1976 that all changed when Congress passed the Copyright Act.<sup>19</sup> The Act preempts any common-law rights that are equivalent to rights set forth under the Act.<sup>20</sup> One of the rights in the Act purports to provide authors a right of first publication.<sup>21</sup> It seems, then, that letter authors and email senders must now rely on the Act's purported right of

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14. See *id.* (describing the common-law right of first publication as “the author’s right to decide when and whether [the work] will be made public”); *Woolsey*, 11 How. Pr. at 67 (“[T]he writer of letters has an exclusive right not only to publish them himself, but to forbid their publication by others . . .”).

15. See *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 488 (1867) (suggesting that publication would occur if a recipient were to make a copy of the original letter and distribute that to a third party rather than simply reading the original letter to the third party or depositing the original with the third party for safe-keeping); *Baker v. Libbie*, 97 N.E. 109, 111 (Mass. 1912) (opining that although an author’s right of first publication exists independent of the manuscript, “this right involves a right to copy or secure copies”); see also *Denis v. LeClerc*, 1 Mart. (o.s.) 297, 308 (Orleans 1811) (“[T]he property of the writer of a letter may be violated, by multiplying the copies of it . . .”); *Millar v. Taylor*, (1769) 98 Eng. Rep. 201, 242 (K.B.) (“It is certain every man has a right to keep his own sentiments, if he pleases: he has certainly a right to judge whether he will make them public, or commit them only to the sight of his friends.”).

16. See *Barrett v. Fish*, 47 A. 174, 175–76 (Vt. 1899) (considering the admissibility of letters exchanged between allegedly adulterous couple).

17. See *Woolsey*, 11 How. Pr. at 62–63 (reviewing precedent establishing that private letters are copyrightable and describing the right to publish them as “inherent in [the author] . . . until it is chosen to be asserted”).

18. See *id.* at 63 (noting obligation of courts of equity to protect the writers of private letters “without any other inquiry than into the fact of his authorship”).

19. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101–1332 (2000)).

20. 17 U.S.C. § 301(a).

21. See *id.* § 106(3) (granting the owner of copyright exclusive rights “to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending”).

first publication to protect their expressive privacy. They appear to be subject to the rules governing federal copyright law.

The Copyright Act is unlikely to protect privacy for email senders like the common law did for letter authors.<sup>22</sup> The Act excuses a user's ostensible infringing use of a work if the use in question is deemed to be "fair."<sup>23</sup> A defense of fair use is usually recognized where the use does not harm the economic value of the work.<sup>24</sup> This is relevant to email forwarding because the forwarding does not usually harm the sender's ability to market the expression, especially given that there is often no market for casual email correspondence.<sup>25</sup> The absence of any effect on the market for email expression would trigger the fair-use defense.<sup>26</sup> At first glance, it would seem that the Act's fair-use provision strips email senders of the privacy protection that the common law so readily afforded authors of letters.<sup>27</sup> Email forwarding appears permissible under the Act.<sup>28</sup>

Despite the Act's fair-use provision, private email expression may nevertheless receive legal protection.<sup>29</sup> A strong argument exists that the Act does not preempt the common-law right of first publication.<sup>30</sup> This argument stems from the premise that the Copyright and Patent Clause of the Constitution restricts the property rights that Congress may legislate.<sup>31</sup> Under the Clause, if Congress legislates property rights, those rights must further public utility.<sup>32</sup> Public utility is not furthered by

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22. See *infra* Part III.A–B.

23. 17 U.S.C. § 107.

24. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985) (describing the economic impact of the defendant's use of a copyrighted work as "the single most important element of fair use").

25. See *infra* Part III.A.2, III.B.3 (providing the Copyright Act's list of nonexhaustive criteria in determining whether the fair-use exception applies and analyzing them in the email context).

26. See *infra* Part III.A.2.

27. See *infra* Part III.C (discussing the impact of the Copyright Act on the privacy of email communication).

28. See *infra* Part III.A.2, III.B.3 (discussing the application of the fair-use doctrine on casual email correspondence and the impact of the 1992 amendment to the Copyright Act, which appears to remove federal copyright protection from most email).

29. See *infra* Parts III.C–D, IV (arguing that the apparent conflict in the Copyright Act can be resolved to still provide legal protection to private email correspondence).

30. See *infra* Parts III.D, IV (providing a constitutional argument that limits the scope of the Copyright Act).

31. See *infra* Part III.D.1 (discussing the Copyright and Patent Clause of the Constitution, which gives Congress the power to legislate property rights that promote the progress of science and useful arts).

32. See *infra* Part III.D.1 (discussing the utilitarian nature of the Copyright and Patent Clause of the Constitution).

a right that allows an author to withhold a work from the public.<sup>33</sup> Accordingly, the Constitution prohibits Congress from legislating property rights that function to protect an author's privacy.<sup>34</sup> This means that the Copyright Act's purported right of first publication should not be construed as a right that protects an author's privacy.<sup>35</sup> In other words, the Act's right of first publication should not be construed as a right that protects an author's decision whether to publish—a decision that concerns privacy.<sup>36</sup> The Act does not preempt common-law copyright to the extent that the common law protects an author's privacy interest.<sup>37</sup> Absent preemption, the common-law right of first publication is alive and well.<sup>38</sup>

Construing the Copyright Act as not preempting the common-law right of first publication raises interesting implications in the email context.<sup>39</sup> Under the common law, unauthorized distribution of only a few copies constitutes publication.<sup>40</sup> The issue arises, then, as to whether an email recipient violates the sender's right of first publication by either displaying to third parties a printed copy of the email or forwarding the email to third parties.<sup>41</sup> The common law suggests that displaying the printed copy is permissible insofar as the email recipient does not transfer that copy.<sup>42</sup> Email forwarding, on the other hand, violates the sender's right of first publication.<sup>43</sup> Email forwarding completely

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33. See *infra* Part III.D.1 (arguing that where an author attempts to keep a work private, the right does not serve a utilitarian end).

34. See *infra* Part III.D.1 (discussing how the Constitution may prevent Congress from creating rights that do not serve the utilitarian end of the Copyright and Patent Clause).

35. See *infra* Part III.D.1 (discussing how the right of first publication is only valid to the extent that it serves a utilitarian end).

36. See *infra* Part III.D.2 (discussing how the Copyright Act *only* preempts common law rights equivalent to those protected in the Act).

37. See *infra* Part III.D.2 (discussing the difference in the scope of protection afforded from the common law and the Copyright Act).

38. See *infra* Part III.D.2 (discussing the nonequivalence of the two rights protected by the common law and by the Copyright Act: protecting the author from being "found out" and from being "scooped," respectively).

39. See *infra* Part II (discussing the common law's protection of email correspondence).

40. See *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 488 (1867) ("Publication by the author is circulation before the public eye by printing or multiplied copies in writing."); *Baker v. Libbie*, 97 N.E. 109, 111 (Mass. 1912) (opining that although an author's right of first publication exists independent of the manuscript, "this right involves a right to copy or secure copies"); see also *Denis v. LeClerc*, 1 Mart. (o.s.) 297, 308 (Orleans 1811) ("[T]he property of the writer of a letter may be violated, by multiplying the copies of it . . .").

41. See *infra* Part II.B.1–2 (discussing the impact of forwarding or physically displaying email communication on the sender's right to first publication).

42. See *infra* Part II.B.2 (discussing how at common law the recipient of a letter could show it to others as long as he did not make copies of it).

43. See *infra* Part II.A.2.a (discussing how forwarding an email deprives the original sender of



duplicates the original expression and transfers a copy of that duplication to a third party,<sup>44</sup> and the common law directly prohibits this practice.<sup>45</sup> Finally, it should be noted that a corollary to this common-law rule is that an author may relinquish the right of first publication by transferring a copy to a third party.<sup>46</sup> This means that carbon copying a third party on an email may create a presumption that the sender meant to relinquish his common-law protection of expressive privacy.<sup>47</sup>

The common law's governance of property rights in letters also raises implications regarding the rights that email *recipients* hold in email. Under the common law, a letter recipient holds property rights in the physical materials composing a letter while the letter author retains rights to the expression within the letter.<sup>48</sup> This principle suggests that email recipients own the computer files that constitute the received emails.<sup>49</sup> The email recipient may therefore exercise physical dominion over the file: he may preserve, destroy, or transfer the file insofar as a copy does not result.<sup>50</sup> Similarly, the recipient may physically move the email file to any location, and further, may display the email to a third party without violating the sender's property rights.<sup>51</sup> Finally, the common law suggests that email recipients to whom the sender mistakenly sends an email, i.e., unintended recipients, hold no property rights in the email file as against the sender.<sup>52</sup> This is because the law of gifts and the law of finders control an unintended recipient's property

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his privacy).

44. See *infra* Part II.A.2.a (describing how email forwarding works).

45. See *infra* Part II.A.2.a (discussing how principles at common law that prevent the copying of letters apply to email communication to not allow email forwarding).

46. See *Kortlander v. Bradford*, 190 N.Y.S. 311, 313 (N.Y. Sup. Ct. 1921) ("This exclusive right is confined to the first publication. When once published it is dedicated to the public, and the author has not at common law any exclusive right to multiply copies of it or to control the subsequent issues of copies by others." (citing *Palmer v. De Witt*, 47 N.Y. 532 (1872))); *Widdemer v. Hubbard*, 19 Pa. C. 263, 264–65 (C.P. 1887) (discussing how a husband destroyed his privacy expectation when he allowed a bishop to read the letter to his wife and therefore the wife was allowed to spread the publication of the letter if she wished).

47. See *infra* Part II.A.2.c (discussing how carbon copying a third party on an email causes the sender to relinquish the right of first publication).

48. *Baker v. Libbie*, 97 N.E. 109, 111–12 (Mass. 1912) ("The [letter] author parts with the physical and material elements which are conveyed by and in the envelope. These are given to the receiver.").

49. See *infra* Part II.B (discussing the rights of letter recipients at common law and the applicability of those rights to email recipients).

50. See *infra* Part II.B.1 (discussing how an email recipient's property rights are in the computer file and not the expression contained within the email).

51. See *infra* Part II.B.1 (describing permissible transfers of email communication).

52. See *infra* Part II.B.3 (explaining the rights of unintended recipients of email communication using the principles of gift-and-finders law).

rights in the email file.<sup>53</sup> A donee of a gift must be the *intended* donee to acquire property rights as against the donor.<sup>54</sup> Unintended email recipients, then, hold no property rights to the email as against the sender: they are finders of lost property, and accordingly, must destroy it upon the sender's request.<sup>55</sup>

This Article examines the extent to which an email sender may enforce property rights to email expression to ensure privacy. Part II applies the common-law right of first publication to the email context. It discusses how common-law principles that govern the rights of letter authors and recipients affect the rights of email senders and recipients.<sup>56</sup> Part III examines whether the Copyright Act adopts the common-law right of first publication. It concludes that the Act does not incorporate the same privacy protection as the common-law right of first publication because the Act allows for liberal application of the fair-use defense.<sup>57</sup> Part III next examines whether the Act preempts the common-law right of first publication.<sup>58</sup> Based on the view that the Copyright and Patent Clause restricts Congress to legislate property rights that further a utilitarian purpose, Part III posits that the Act cannot constitutionally protect an author's interest in keeping a work from the public.<sup>59</sup> For this reason, Part III posits that the Act does not preempt the common-law right of first publication.<sup>60</sup> Part IV evaluates whether a dual copyright system—the common-law system to protect privacy interests and the federal-law system to protect commercial interests—is advisable. It examines issues relating to whether a dual system is practicable<sup>61</sup> and whether privacy in expression is good policy.<sup>62</sup> The Article concludes that the common-law right of first publication should be invoked to protect an email sender's privacy interests.

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53. See *Baker*, 97 N.E. at 111–12 (“The author parts with the physical and material elements which are conveyed by and in the envelope. These are given to the receiver.”); *Eyre v. Higbee*, 22 How. Pr. 198, 204 (N.Y. Sup. Ct. 1861) (“We must . . . presume a grant of the letters from him to her.”).

54. See RESTATEMENT (SECOND) OF PROP.: DONATIVE TRANSFERS § 31.1 (1992) (“The owner of personal property may make a gift thereof to another person (the donee) by delivering it to the donee . . . with the manifested intention that the donee be the owner of the personal property.”).

55. See *infra* Part II.B.3 (describing how unintended recipients of emails are finders of lost property and as such have inferior property rights to the email as the sender).

56. See *infra* Part II.A–B.

57. See *infra* Part III.A–C.

58. See *infra* Part III.D.

59. See *infra* Part III.D.1.

60. See *infra* Part III.D.2.

61. See *infra* Part IV.A.

62. See *infra* Part IV.B.

## II. THE COMMON LAW'S PROTECTION OF EMAIL EXPRESSION

Property rights in email expression derive from the common law's recognition of property rights in personal correspondence. At common law, a letter author held property rights in the expression of the letter, and a letter recipient held property rights only to the physical components of a letter.<sup>63</sup> Application of this simple principle in the email context suggests that dual categories of property rights exist in any email. The sender retains rights to the electronic expression; the recipient receives rights to the physical email file. The following subparts analyze these respective rights.

### A. *The Rights of Email Senders*

Common-law copyright's protection of an author's private expression traces back to the eighteenth century.<sup>64</sup> Well established is the common-law principle that an author retains a right to control the first instance that the author's expression may be made public.<sup>65</sup> Under this right, a letter author controls whether the letter will be published to the public, and if so, when it will first be published.<sup>66</sup> "Public" in this

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63. See *Baker v. Libbie*, 97 N.E. 109, 111–12 (Mass. 1912) ("The author parts with the physical and material elements which are conveyed by and in the envelope. These are given to the receiver.").

64. See *Millar v. Taylor*, (1769) 98 Eng. Rep. 201, 242 (K.B.) ("[T]he manuscript is, in every sense, his peculiar property; and no man can take it from him, or make any use of it which he has not authorized, without being guilty of a violation of his property."); *Pope v. Curl*, (1741) 26 Eng. Rep. 608, 608 (Ch.) ("[W]here a man writes a letter, it is in the nature of a gift to the receiver. . . . [T]his does not give a license to any person whatsoever to publish them to the world, for at most the receiver has only a joint property with the writer.").

65. See *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 488 (1867) ("[W]e incline to the conclusion that the weight of authority, fortified by analogy, preponderates in favor of the author's special property in the publication, and in his consequential right to publish . . ."); *Woolsey v. Judd*, 11 How. Pr. 49, 70 (N.Y. Sup. Ct. 1855) (interpreting English common law to have rejected the argument that "there can be no property" in "familial letters, not intended by the writers to be published"); *Barrett v. Fish*, 47 A. 174, 175 (Vt. 1899) (dictum) ("[T]he view most consonant with reason, justice, and sound public policy is that which holds that a court of equity will protect the right of property in such letters by enjoining their unauthorized publication by any person who may attempt or intend such publication. Such protection is based solely on the property of the writer or possessor of such letters therein."). Perhaps the strongest endorsement of the property nature in the rights that an author holds over personal correspondence is found in *Baker v. Libbie*: "The existence of a right in the author over his letters, even though private and without worth as literature, is established on principle and authority. The right is property in its essential features. It is, therefore, entitled to all the protection which the Constitution and laws give to property." 97 N.E. at 111.

66. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 551 (1985) (describing the common-law right of first publication as "the author's right to decide when and whether [the work] will be made public"); *Baker*, 97 N.E. at 111 ("The right of the author to publish or suppress publication of his correspondence is absolute in the absence of special considerations, and is

sense has a broad meaning: it means any third party who is not the original intended recipient.<sup>67</sup> Sending a letter to its intended recipient, then, does not amount to making expression “public,” whereas sending a copy of the letter to any other person does. The right effectively allows an author to keep expression private regardless of whether the expression has any literary value.<sup>68</sup> This right is referred to as the right of first publication.<sup>69</sup>

Applying this right of first publication to email requires understanding the principle of privacy underlying this right and the common-law rules growing out of this right. This principle of privacy, the attendant rules of the common law, and their application to email are set forth below in the ensuing subparts.

### 1. The Common Law’s Protection of Privacy

Common-law copyright exists to protect privacy in written expression.<sup>70</sup> That purpose was articulated by Samuel Warren and Louis

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independent of any desire or intent at the time of writing.”).

67. See *Grigsby*, 65 Ky. (2 Bush) at 484–85, 488–89 (defining publication as circulation before the “public eye” and suggesting that publication would occur if a recipient were to make a copy of the original letter and distribute that to a third party rather than simply reading the original letter to the third party or depositing the original with the third party for safe-keeping); accord *Baker*, 97 N.E. at 111 (opining that although an author’s right of first publication exists independent of the manuscript, “this right involves a right to copy or secure copies”); *Denis v. LeClerc*, 1 Mart. (o.s.) 297, 308 (Orleans 1811) (“[T]he property of the writer of a letter may be violated, by multiplying the copies of it.”); *Millar*, 98 Eng. Rep. at 242 (“It is certain every man has a right to keep his own sentiments, if he pleases: he has certainly a right to judge whether he will make them public, or commit them only to the sight of his friends.”).

68. See *Folsom v. Marsh*, 9 F. Cas. 342, 346 (C.C.D. Mass. 1841) (No. 4901) (Story, J.) (“I hold, that the author of any letter or letters . . . whether they are literary compositions, or familiar letters, or letters of business, possess the sole and exclusive copyright therein; and that no persons, neither those to whom they are addressed, nor other persons, have any right or authority to publish the same upon their own account, or for their own benefit.”); *Baker*, 97 N.E. at 111 (“The existence of a right in the author over his letters . . . is established [even without worth as literature] . . .”); *Woolsey*, 11 How. Pr. at 63, 68 (commenting that “[e]very writing, in which words are so arranged as to convey the thoughts of the writer to the mind of a reader, is a literary composition” to support its holding that copyright applies to “private letters, although not intended to be published, and however familiar and trivial the subject to which they relate” to the extent that an author holds “an absolute right to forbid their publication by another”); *Gee v. Pritchard*, (1818) 36 Eng. Rep. 670, 675–76 (Ch.) (“It has been decided, fortunately for the welfare of society, that the writer of letters, though written without any purpose of profit, or any idea of literary property possesses such a right of property in them, that they cannot be published without his consent, unless the purposes of justice, civil or criminal, require the publication.”); accord *Denis*, 1 Mart. (o.s.) at 302 (holding that “the right of publishing a letter remains exclusively in the writer” notwithstanding that the letter was “not written with a view to profit”).

69. *Harper & Row*, 471 U.S. at 552; see also *Birnbaum v. United States*, 588 F.2d 319, 326 (2d Cir. 1976) (“[T]he common law copyright is, in essence, a right of first publication, which of necessity includes the right to suppress any publication by injunction.” (internal citations omitted)).

70. See *Harper & Row*, 471 U.S. at 554 (“It is true that common-law copyright was often

Brandeis in their seminal 1890 *Harvard Law Review* article, *The Right to Privacy*.<sup>71</sup> Warren and Brandeis opined that the right of first publication under common-law copyright is a manifestation of a more general right—the right to be let alone.<sup>72</sup> Underlying the right to be let alone, Warren and Brandeis declared, is the ideal of an inviolate personality.<sup>73</sup> And, they continued, part of one’s personality is one’s expression: making public an expression that was intended to be private constitutes an attack on personality.<sup>74</sup> Warren and Brandeis thus concluded that an interest inherent in one’s person, which falls within the ambit of the general right to be let alone, is the interest one holds in privacy of expression.<sup>75</sup> Personal correspondence represents one’s very personality, and so, Warren and Brandeis argued, such correspondence merits as much protection as any other personality interest.<sup>76</sup> It merits protection of its inherently private nature.<sup>77</sup>

This interest in keeping correspondence private is apparent in the email context. Senders of email are interested in ensuring that no one other than the intended recipient views the electronic recording of the sender’s expression.<sup>78</sup> That is, the sender desires that a copy of the email will not end up in the hands of a third party.<sup>79</sup> This of course does not

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enlisted in the service of personal privacy.”); Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 1004 (1970) (“[C]ommon law copyright, in its coverage of letters, . . . protects personal rather than economic values and clothes privacy with the attributes of property.”); Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 198 (1890) (“The common law secures to each individual the right of determining, ordinarily, to what extent his thoughts, sentiments, and emotions shall be communicated to others.”).

71. Warren & Brandeis, *supra* note 70, at 198–99, 204–05.

72. *Id.* at 205. The right to be let alone is, according to Warren and Brandeis, a right inherent in one’s person; specific examples of this general right include the right not to be assaulted or beaten, the right not to be imprisoned, and the right not to be defamed. *Id.*

73. *See id.* (“The principle which protects personal writings and all other personal productions . . . is . . . that of an inviolate personality.”).

74. *Id.*

75. *See id.* (“[T]he conclusion [is] that the protection afforded to thoughts . . . is merely an instance of the enforcement of the more general right of the individual to be left alone.”).

76. *Id.* at 205–07.

77. *Id.* at 205.

78. *See* Grimmelmann, *supra* note 5 (opining that unprotected email may lead to a dulling of expression); Mandel, *supra* note 6 (relying on professor of journalism at Columbia University for proposition that email senders must restrict their expression to that which the senders would be comfortable viewing on a public website).

79. Two examples illustrate this interest of a sender. The first occurred when a *Newsday* reporter and former Pulitzer Prize winner, Laurie Garrett, wrote a candid email summarizing her experience at the World Economic Forum in Switzerland. Grimmelmann, *supra* note 5. Without a doubt, the email was written very casually: she called Vicente Fox “sexy”; she described the wireless infrastructure as “very cool”; she misstated the phrase “various and sundry” as “various insundry.” *Id.* Garrett then sent the email to a “handful” of friends. *Id.* About a week after sending it, the email had been forwarded several times, and to Garrett’s dismay, appeared on a publicly accessible website. *Id.* After that, it became public news. *See, e.g.,* Mandel, *supra* note 6 (reporting Garrett’s

apply to all email senders: there can be no doubt that some senders of email do not expect, and perhaps discourage, their email to be kept private.<sup>80</sup> Just as some authors of letters do not mind if their sentiments are passed along to third parties, so also do some email senders not expect any privacy restriction.<sup>81</sup> But the relevant point is that the interest to hold expression private is present in the email context, regardless of whether all email senders hold that interest.

The question of whether the law should secure an email sender's interest in privacy raises the issue of whether the type of personal correspondence to which Warren and Brandeis referred, and that the common law contemplates, is sufficiently analogous to email correspondence. Simply put: Do the principles and rules governing expression in physical letters extend to expression in email? The opinion expressed by Warren and Brandeis suggests so. They opined that the right to privacy underlying letter correspondence exists "wholly independent of the material on which, or the means by which, the thought, sentiment, or emotion is expressed."<sup>82</sup> This conclusion appears to be correct. The privacy interest that copyright protects is with respect to the expression—not the physical material on which the expression is recorded.<sup>83</sup> Expression in electronic form is just as much a part of one's personality as expression on physical paper. Principles, rules, and rationales governing expression in letters should apply to expression in email. The privacy interest that underlies common-law copyright has a place in email expression.

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email experience).

The second example occurred when a high-level employee of an environmental nonprofit foundation sent a private email to a limited number of recipients. *Id.* The employee was an aquaculture specialist for the foundation. *Id.* In the email she advised the recipients to fax fish farmers that they were boycotting fish products over an issue relating to sea lice. *Id.* The email included the following line: "Tormenting fish farmers is fun – it really, really is." *Id.* Not long after sending it, the email found its way onto the public stage of the Internet. *Id.* The fish-farm industry was very displeased with her sentiments, and imputed the employee's email to the environmental foundation. *Id.* Predictably, the employee issued an apology. *Id.*

80. For instance, senders of "spam" email would not seek to maintain privacy of expression. *See Am. Online, Inc. v. Nat'l Health Care Disc., Inc.*, 174 F. Supp. 2d 890, 894–97 (N.D. Iowa 2001) (suggesting that senders of spam email commercially benefit from massive distribution of their expression).

81. *See, e.g., id.* at 894 (explaining a case in which the National Health Care Discounts' vice-president contacted an emailer to send commercial email for a fee).

82. Warren & Brandeis, *supra* note 70, at 199.

83. *See Baker v. Libbie*, 97 N.E. 109, 112 (Mass. 1912) (teaching that a letter recipient has rights to the physical components of a letter "as absolute owner subject only to the proprietary right retained by the author for himself and his representatives to the publication or nonpublication of ideas in its particular verbal expression"); Warren & Brandeis, *supra* note 70, at 206–07 (suggesting that privacy protection extends to various media of expression).

## 2. The Right of First Publication

The common law secures privacy of expression through the right of first publication.<sup>84</sup> That right can be thought of as comprising two steps. The first step represents the author's choice to decide *whether* to publish the expression in the letter.<sup>85</sup> An author may decide never to publish the expression such that the author's privacy receives protection indefinitely.<sup>86</sup> In that circumstance, the second step is never reached. If, on the other hand, the author does decide to publish it, the second step occurs: the right of first publication allows the author to decide *when* the first publication will occur.<sup>87</sup> This second step protects the author's interest in keeping the expression private from the point of publication decision to the actual time of publication.<sup>88</sup> The second step protects the expression's yet-to-be-realized commercial value, which the author has already decided to realize.<sup>89</sup> Realization of an expression's commercial value depends on the author being able to publish the expression before anyone else.<sup>90</sup> In this way, the second step—the right to decide *when* to publish—protects the author's interest in realizing the commercial value of the expression. Thus, the right of first publication protects two seemingly contrary interests: the author's interest in keeping the expression private, and the author's interest in realizing commercial gain. The right protects the former interest by allowing the author exclusive control over *whether* to publish; the right protects the latter interest

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84. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 553 (1985) (describing privacy as purpose of right of first publication).

85. *Id.* at 551; see also *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 484 (1867) (“[T]he author should have the right to decide for himself whether the publication would be useful to the public and profitable to himself . . . .”); *Baker*, 97 N.E. at 112 (“[An author]’s proprietary power is to make or restrain a publication . . . .”); *Woolsey v. Judd*, 11 How. Pr. 49, 67 (N.Y. Sup. Ct. 1855) (“[T]he writer of letters has an exclusive right not only to publish them himself, but to forbid their publication by others . . . .”).

86. See *Harper & Row*, 471 U.S. at 551 (“Under common-law copyright, the property of the author . . . in his intellectual creation [was] absolute until he voluntarily part[ed] with the same.” (internal quotations omitted)); *Denis v. LeClerc*, 1 Mart. (o.s.) 297, 302 (Orleans 1811) (“[T]he right of publishing a letter remains exclusively in the writer, till he abandons it, and if not abandoned, passes at his death to his representatives.”).

87. See *Harper & Row*, 471 U.S. at 551 (stating that “publication . . . [before the author] has authorized its dissemination seriously infringes on the author’s right to decide when and whether” to publish).

88. See Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1120–21 (1990) (observing a distinction between protection of unpublished works that were created for publication or on their way to publication and unpublished works never intended for publication).

89. See *id.* at 1122 (summarizing the concerns relevant in protecting the expectations of creators that copyright law was created to protect).

90. See *Harper & Row*, 471 U.S. at 554–55 (stating that the “author’s control of first public distribution implicates . . . his property interest . . . which [is] valuable in [it]self”).

(where the author does decide to publish it) by allowing the author exclusive control over *when* to publish.<sup>91</sup>

The common law's protection of expressive privacy through the right of first publication is nearly absolute.<sup>92</sup> Exceptions are rare.<sup>93</sup> The fact that an unauthorized copy may appear "reasonable and customary" does not affect the strength of the author's common-law right.<sup>94</sup> Further privacy protection is manifest by the common law's definition of publication: "publication" constitutes any circulation of a multiplication of the original expression.<sup>95</sup> This definition prohibits circulating even

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91. See *id.* ("In its commercial guise, . . . an author's right to choose when he will publish is no less deserving of protection.")

92. See *Baker v. Libbie*, 97 N.E. 109, 111 (Mass. 1912) ("The property right of the author . . . to publish or suppress publication of his correspondence is absolute in the absence of special considerations."); *Woolsey v. Judd*, 11 How. Pr. 49, 62–63 (N.Y. Sup. Ct. 1855) ("[T]he writer of such letters has an absolute right to forbid their publication by another . . .").

93. Circumstances where a court has ruled that publication is proper even though the author does not consent include the following: (1) the letter is necessary for a recipient to establish rights in a lawsuit, *Folsom v. Marsh*, 9 F. Cas. 342, 346–47 (C.C.D. Mass. 1841) (No. 4901) (Story, J.); (2) parts of a letter are necessary to furnish information that will vindicate the recipient's character and reputation, or free the author from unjust humiliation and reproach, *id.*; (3) the author intends to dedicate his or her rights to the expression to the public or to the recipient, *id.*; (4) the letter is from a public officer to a government body, *id.*; (5) the letter constitutes an instrument or means for the accomplishment of an unlawful purpose, *Knights of the Ku Klux Klan v. Int'l Magazine Co.*, 294 F. 661, 663 (2d Cir. 1923); and (6) the author relinquishes the right by publishing the letter, *Widdemer v. Hubbard*, 19 Pa. C. 263, 264–65 (C.P. 1887).

94. *Harper & Row*, 471 U.S. at 550–51.

95. See *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 488–89 (1867) ("Publication by the author is circulation before the public eye by printing or multiplied copies in writing. . . . [A letter recipient] may do every thing but multiply copies, and perhaps he may do this, if he do [sic] not print them." (internal quotations omitted)); *Baker*, 97 N.E. at 112 ("In this opinion, publication has been used in the sense of making public through printing or multiplication of copies."); *Widdemer*, 19 Pa. C. at 264–65 (holding that letter author had made publication by sending the letter to two third-party recipients in addition to its intended recipient).

Tellingly, the *Grigsby* court commented that a recipient may be able to "multiply" copies of an author's expression so long as the recipient does not "print" those copies. 65 Ky. (2 Bush) at 489. It is possible that at the time of the opinion in 1867, "multiplying" copies by hand did not suggest that the recipient was distributing the copies to third parties, whereas "printing" copies by machine did suggest third-party distribution.

One court has held that a publication did not occur where there occurred a limited distribution of copies of a letter. *Birnbaum v. United States*, 588 F.2d 319, 327 (2d Cir. 1978). That court's holding, however, seems misstated. The reason for the copying and distribution was to maintain national security. *Id.* at 321. Public policy dictates that this reason for copying and distribution appears to be a justifiable exception to the right of first publication. Hence, the *Birnbaum* court's holding appears correct insofar as it permits publication on the basis of a compelling government interest. It appears incorrect insofar as it labels the copying and distribution as anything other than a publication. See *id.* (finding that "reading of the plaintiff's letters by several persons, none of whom circulated them to the world, is not a publication that destroys the value of the work").

A less common but broader definition of publication is any multiplication of the original expression, irrespective of whether the multiplication is circulated. See *Denis v. LeClerc*, 1 Mart. (o.s.) 297, 308 (Orleans 1811) ("[T]he property of the writer of a letter may be violated, by multiplying the copies of it . . ."). The rationale for this broad definition appears to be that an extra



one copy of a letter. For instance, it precludes distributing a copy of amorous communications by a husband's lover.<sup>96</sup> Distribution of even one copy of such a letter would be sufficient to destroy the lover's privacy, especially when that copy finds its way into the hands of the husband's former wife.<sup>97</sup> The common-law protection of privacy prohibits letter recipients from distributing any copy of the expression.<sup>98</sup>

a. Common-Law Prohibition of Email Forwarding<sup>101</sup>

Under the recognized common-law definition of publication, an email sender may preclude the recipient from distributing copies of the email to third parties. A frequent occurrence of such distribution arises in the practice of email forwarding. Email forwarding is common because it is so effortless: a click of the mouse allows complete duplication and distribution of the sender's expression.<sup>99</sup> Nevertheless, the fact that forwarding may be performed with ease does not alter the fact that the forwarding deprives the sender of privacy.<sup>100</sup> The common law would forbid that act, for the expression in an email is as private as the expression in a letter. The ease of copying the expression should not affect the analysis to determine whether the act in question—forwarding an email—invades the sender's privacy interest. Common-law copyright principles condemn email forwarding as a violation of the sender's property rights in the electronic expression.<sup>101</sup>

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copy of a letter could possibly come into possession of a third party, so that copy could possibly destroy the author's privacy in the expression.

96. See *King v. King*, 168 P. 730, 733 (Wyo. 1917) (prohibiting former wife from gaining possession of copy of letter from husband's second wife, where letter was allegedly relevant to divorce proceeding).

97. *Id.*

98. See, e.g., *Grigsby*, 65 Ky. (2 Bush) at 488–89 (recognizing the duty of privacy and secrecy of personal letters); *Baker*, 97 N.E. at 111 (noting that the exceptions to the “absolute right of the author to prevent publication by the receiver” are “narrow and rare”); *Denis*, 1 Mart. (o.s.) at 308 (“[T]he property of the writer of a letter may be violated, by multiplying the copies of it . . . .”); *Widdemer*, 19 Pa. C. at 264–65 (discussing the right to privacy and possible waivers); *King*, 168 P. at 731 (protecting privacy right in a letter relevant to a divorce proceeding).

99. See *Grimmelmann*, *supra* note 5 (describing why copying and redistributing another's expression is so effortless through the email-forwarding function).

100. See generally, e.g., *id.* (describing the intense scrutiny that Pulitzer Prize *Newsday* reporter, Laurie Garrett, experienced after her personal email, which provided a candid description of the World Economic Forum, ended up all over the Internet).

101. *Accord* *Warren & Brandeis*, *supra* note 70, at 199 (opining that the right of first publication “is wholly independent of the material on which, or the means by which, the thought, sentiment, or emotion is expressed”); see also *Estate of Hemingway v. Random House, Inc.*, 279 N.Y.S.2d 51, 57 (N.Y. Sup. Ct. 1967) (dictum) (recognizing author's right of first publication with regard to a telegram, which, like email, constitutes expression by means of electrical impulse), *aff'd*, 285 N.Y.S.2d 568 (N.Y. 1967).

An argument may be made that email forwarding is permissible because the practice is so common.<sup>102</sup> All email programs have forwarding capability, so any email sender with reasonable knowledge of how email works will know that the email recipient has the ability to forward along the email to any third party. Any sender who is at all familiar with email practice should know that email recipients often utilize this forwarding capability. It is arguable, then, that by sending an email, the sender implicitly consents, or at least assumes the risk, that the expression in the email may be forwarded to a third party. Common practice, and thereby common sense, suggests that the sender implicitly consents to email forwarding based on the sender's very use of email.

It is also arguable that email forwarding is permissible because recipients do so not for the purpose of duplicating the expression therein, but rather to communicate to a third party the senders' ideas. Authority exists for the proposition that the right of first publication does not secure an author property rights in the idea that the author has expressed, but rather only in the expression of that idea.<sup>103</sup> A recipient arguably forwards email to communicate a sender's idea within the expression rather than to communicate the sender's actual expression. Stated differently, a recipient would paraphrase the sender's expression except that the single-click method of forwarding is easier than expending effort to paraphrase. This reason for recipient forwarding suggests that the recipient does not intend to pirate the recipient's expression, but rather intends only to communicate the recipient's ideas.<sup>104</sup> On this basis it is arguable that forwarding is permissible.

These two arguments in favor of email forwarding are not persuasive.<sup>105</sup> The first argument stems from the notion that the number

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102. *Cf. Shelter Mut. Ins. Co. v. See*, 46 S.W.3d 65, 67 (Mo. Ct. App. 2001) (dictum) ("Implied permission is determined from the facts and circumstances of the case and usually arises from a course of conduct of the parties over a period of time."); *Penza v. Century Indem. Co.*, 197 A. 29, 30 (N.J. 1938) (dictum) ("Permission to take and use a car upon a particular occasion . . . may in a proper case be implied by usage and common practice of the parties.").

103. *See Baker*, 97 N.E. at 112 (opining that letter author holds proprietary right to "verbal expression"); *accord Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 356 (1991) (recognizing that copyright applies to expression, rather than idea within the expression, under federal Copyright Act).

104. *See sources cited infra* note 105.

105. The common practice of email forwarding merits a brief discussion on how the descriptive term of "forward" may be affecting social acceptance of copyright-infringing behavior. Unsurprisingly, programmers of email software chose the word "forward" to denote the process of copying an email and distributing to a third party. The term "forwarding" does not suggest impermissibility. Under the common law, a person who merely forwards along a misrepresentation is arguably not liable for that misrepresentation. *See, e.g., Dickerson v. Trinity-W. Title Co.*, 985 S.W.2d 687, 690-91 (Tex. Ct. App. 1999) (determining that title company was not liable for seller's misrepresentation on the basis that the title company "merely passed along the information [it] had

of people engaging in email forwarding should make the practice reasonable and customary. But common-law copyright permits “reasonable and customary” uses only if the author impliedly consents to such uses by releasing a work for public consumption.<sup>106</sup> In other words, under the common law there must be publication before what is reasonable and customary becomes relevant as to whether a use of a work is permissible.<sup>107</sup> Assuming the email sender does not publish the email, there would be no implied consent.<sup>108</sup>

The second argument bases liability on intent: the recipient apparently does not intend to pirate expression, but rather simply forwards the email because clicking the forward button is less burdensome than paraphrasing the sender’s expression. Justice Story rejected such a contention in a landmark common-law copyright case, *Folsom v. Marsh*.<sup>109</sup> “The intention to pirate is not necessary in an action of this sort; it is enough, that the publication complained of is in substance a copy, whereby a work vested in another is prejudiced.”<sup>110</sup> Intent is, according to Justice Story, irrelevant in determining whether expressive piracy has occurred.<sup>111</sup> Regardless of whether the intent to pirate is present, a recipient who forwards email violates the email sender’s right of expression.<sup>112</sup>

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received”). Forwarding suggests the act of passing along so that the email recipient acts as a mere pass-along, or in other words a connection, between the original sender and the ultimate third-party recipient. See WEBSTER’S ENCYCLOPEDIA UNABRIDGED DICTIONARY OF THE ENGLISH LANGUAGE (1989) (defining “forward” as meaning “to send forward; transmit, esp. to a new location”). This meaning of forwarding would be legally accurate if in fact the sender requested, or consented to, the third-party’s receipt of the email. In that instance, the original email recipient would act as a mere pass-along because the recipient would be a chain in the distribution that the sender had intended. But copying and distributing an email without permission does not reflect the common-usage dictionary-definition of “forward.” In that circumstance, the meaning would more likely be captured by the terminology, “copy and redistribute.” Yet a “copy and redistribute” button is not as spatially efficient on a computer screen. It is possible, then, that users of email forward private correspondence based on, at least in part, the subtle mis-identification applied to the feature that enables the recipient to copy the email and distribute it to others without permission. A user is less likely to recognize the impermissibility of copying and distributing based on the seemingly innocuous label of “forward.”

106. Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 550–51 (1985).

107. See *id.* (stating that “fair use traditionally was not recognized as a defense to charges of copying from an author’s as yet unpublished works” (citations omitted)).

108. See Paul M. Schwartz, *Privacy and Democracy in Cyberspace*, 52 VAND. L. REV. 1609, 1662–63 (1999) (arguing against “consent traps” on websites).

109. 9 F. Cas. 342, 349 (C.C.D. Mass. 1841) (No. 4901).

110. *Id.* at 348.

111. *Id.*

112. See *id.* (stating that the inclusion of excerpts of copyrighted material would be “an invasion of that right”).

The common law's rejection of common practice and intent to uphold expressive privacy is based on the fact that ensuring expressive privacy ultimately ensures better quality expression.<sup>113</sup> If email senders lack an expectation of privacy, creative and frank expression become guarded.<sup>114</sup> Email senders speak more freely than they otherwise would when they have an assurance that the expression in the email will not be forwarded without permission.<sup>115</sup> The possibility of forwarding email deters senders' expression.<sup>116</sup> And if the current state of email is such that senders do in fact expect an email to be forwarded, then communications are not as creative and frank as they otherwise could be.<sup>117</sup> The presence of an expectation that recipients will forward email does not represent a legal norm, but rather a deficiency in the enforcement of senders' rights of expression. Consistent with the common-law right of first publication, the law should be strengthened so that "forwarding" is recognized as impermissible copying and distribution.

b. Limits to the Right in the Email Context

Applying the common-law right of first publication to the email context raises issues regarding whether an email recipient violates that right by the mere fact that the email server that the recipient utilizes makes copies of the email expression during the email delivery process.<sup>118</sup> Stated another way, the technical process of receiving email

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113. See *Woolsey v. Judd*, 11 How. Pr. 49, 62–63 (N.Y. Sup. Ct. 1855) (“[L]etters never intended to be published, and written on familiar subjects, are usually more *interesting and valuable* than those elaborately written and originally intended for the press.”).

114. See Mandel, *supra* note 6 (quoting a professor of journalism at Columbia University for the proposition that email senders must restrict their expression to that which the senders would be comfortable viewing on the front page of the newspaper); see also Grimmelmann, *supra* note 5 (positing that email senders will not include private sentiments if expression is not protected); cf. Julie E. Cohen, *Examined Lives: Informational Privacy and the Subject as Object*, 52 STAN. L. REV. 1373, 1425–26 (2000) (arguing that invasion of informational privacy will lead people to be more cautious).

115. See sources cited *supra* notes 113–14.

116. See sources cited *supra* notes 113–14.

117. See Mandel, *supra* note 6 (stating that email senders should not send an email unless they are comfortable with it being published on the front page of the newspaper); Grimmelmann, *supra* note 5 (stating that people “will stop using email for certain matters, if this is what happens when they use it”); cf. Cohen, *supra* note 114, at 1426 (“The condition of no-privacy threatens not only to chill the expression of eccentric individuality, but also, gradually, to dampen the force of our aspirations to it.”).

118. See Marshall Brain, *How E-mail Works*, <http://www.howstuffworks.com/email.htm/printable> (last visited Jan. 13, 2007) (stating that a server may save several pieces of information from an email).

requires copies of the email to be made for the ultimate benefit of the email recipient,<sup>119</sup> and those copies raise the issue of whether the sender's right of first publication is violated. As further discussed below, that technical process suggests that there should be limitations on an email sender's right of first publication.

The process for sending and receiving email is rather simple. An email recipient must employ an email client, which is a program that allows recipients to read email, e.g., Outlook Express or Eudora.<sup>120</sup> Outlook Express (and all other email clients) receives email through an email server. Email servers are machines that transmit email files between each other through the Internet.<sup>121</sup> So, each email recipient employs an email client, e.g., Outlook Express, which receives data from a specific email server, and that email server receives data from other email servers which respectively correspond with the email clients of the email senders.<sup>122</sup> This process is relevant to the right of first publication because when a recipient's email server "sends" an email file to the recipient's email client, the server actually makes a copy of the file and sends the copy to the client.<sup>123</sup> Outlook Express receives only *copies* of email files from an email server; the original email files lie with the email server.<sup>124</sup> After sending a copy to Outlook Express, the server either retains the original email file or deletes it.<sup>125</sup>

This process raises the issue of whether copies of email that Outlook Express receives from its email server violate the sender's right of first publication. The issue is magnified where a recipient may designate through the email client that the recipient be able to view the email both through the email client, e.g., Outlook Express, and through the email server on the Internet, e.g., the Yahoo! server.<sup>126</sup> If the email server sends a copy to the email client and also retains the email file, an email recipient may view the email through both the email server and the email client. The user may access two copies of the expression—one on the user's hard drive through Outlook Express and another on the email

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119. *Id.*

120. *Id.* Like Outlook and Eudora, some email clients stand alone, meaning that they exist independently of the Internet on the user's computer machine; by contrast, some email clients exist on the Internet, such as Yahoo! and Hotmail.

121. *Id.*

122. *Id.*

123. *See id.* (discussing how email clients save coded versions of email attachments that are then decoded for the user automatically).

124. *Id.*

125. *Id.*

126. *Id.* The recipient would actually view the copy on the email server through an email client program that interfaces through the server through the Internet. *Id.*

server of Yahoo!. The copy that an email server sends to Outlook Express seems to violate the sender's right of first publication.<sup>127</sup> It is a copy that the sender never expressly authorizes.

This seeming violation should not be viewed as an actual violation of the sender's right of first publication. By engaging in email, a sender implicitly consents to the electronic processes involved in delivering email to the intended recipient. Part of that delivery process consists of an email server copying the email file and sending the copy to Outlook Express, or any other email client. The copying is a necessary step in email delivery, for a recipient must employ an email client to view email. Furthermore, the fact that a recipient might view the email through two different sources—Outlook Express on the recipient's hard drive and the Yahoo! email server on the Internet—does not lessen the sender's privacy. That the recipient may access two copies of the same expression does not imply that an unintended third party will view the sender's expression. There is no circulation of a copy to a third party. The existence of two copies does not imply that the sender has lost any privacy. In the absence of privacy deprivation, there should be no violation of the right of first publication.<sup>128</sup>

Given that an email server may make and distribute a copy of the email to Outlook Express without violating the sender's right of first publication, an issue arises as to whether the email server may permissibly make and distribute multiple copies of the email to multiple email clients. Simply put, an issue arises as to whether multiple persons may receive the same email that a sender transmits to one email address. This issue exists because several persons may each have their own Outlook Express program that receives email through the same email address as the other persons. That is, multiple email clients may be tied to a single email address on an email server, so that multiple persons may receive the same email sent to a single email address. For example, multiple editors of a law review might each have Outlook Express on their own computers, and through those Outlook Express programs, the editors might each receive a copy of any email sent to editors@lawreview.edu. An issue thus arises as to whether the multiple copies that the email server sends each email client would constitute a violation of the sender's right of first publication.

It appears that in certain circumstances the right of first publication is

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127. See *supra* Part II.A.2 (discussing the right of first publication).

128. The issue of whether an email recipient might provide a third party access to the email stored through the recipient's email client or email server raises an entirely different issue. This Article addresses that issue in Part II.B.2.a.

violated where one email address corresponds to multiple email clients. Those circumstances arise where the email address signifies that only one person will receive the email: in that situation, the sender reasonably expects that only one recipient will receive the expression. Tying multiple email clients to a single-name email address would contravene that expectation. For example, if a student sent an email to a particular professor's email address, such as nsnow@uark.edu, the student would expect that only the professor would receive that email. The expectation would of course be violated if it turned out that other professors also received the student's email through that address. Because the email address suggests that only one recipient will receive the email, the presence of multiple recipients would effectively result in the expression being published to unintended third parties. Therefore, where an email address indicates that only one person will receive the email, the presence of multiple recipients on that email address (through multiple email clients) likely would violate the sender's right of first publication.

In the situation where an email address fails to indicate that only one person will receive the email file, it appears that the right of first publication would not be violated. The email sender would have no expectation that the email would be received by only one person. By sending an email to editors@lawreview.edu, an email sender would not reasonably expect that only one editor will receive the email. It is as though the email sender sent each editor an individual email. That being the case, it is noteworthy that the email sender still has an expectation of privacy in the email sent to each recipient. The email sender has an expectation that each recipient receiving email through the single email address will not disclose the expression to third parties.<sup>129</sup>

In summary, copies of email sent from an email server to an email client, such as Outlook Express, do not violate the right of first publication where there is only one email client corresponding to the email address. If there are multiple email clients corresponding to an email address, and if the email address suggests that only one recipient will receive the email through that address, then the copies that the email server sends to the multiple clients violate the sender's right of first publication. By contrast, if an email address does not suggest that only one recipient will receive the email through that address, then the right of first publication is not violated, and the sender retains a right of first

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129. An ostensible presence of multiple email clients on a single email address is analogous to an email sender designating multiple recipients in the "to" field of the email. The sender would have an expectation of expressive privacy as to each recipient, and accordingly, would hold a right of first publication as to each identical expression received by each recipient. See *infra* Part II.A.2.c.

publication over each copy distributed to each recipient of the email address.

c. Relinquishment of the Right by Carbon Copying

Under common-law copyright, once an author publishes a letter to a third party who is not the intended recipient, the author has relinquished the right of first publication.<sup>130</sup> For instance, if an author were to send a letter to its intended recipient, and then send a copy of that same letter to a third party, the author would have published the letter to the third party, and accordingly would have relinquished his or her right not to publish the letter.<sup>131</sup> The author's publication to a third party thereby excuses a recipient's subsequent publication.<sup>132</sup> By publishing a letter to a third party, the author foregoes the common law's protection of privacy.<sup>133</sup> The rationale underlying this rule of relinquishment is simple: If the author were interested in keeping a letter private, the author would not provide a copy of the letter to the third party.

The principle that an author relinquishes the right of first publication upon publishing the private expression to a third party raises complexities in the email context. An email sender often sends a single email to multiple recipients using a variety of different methods. It is arguable that each of these methods result in relinquishment of the sender's common-law right of first publication. The simplest method occurs when an email sender specifies more than one email address in the "to" field. Each "to" field recipient receives an identical expression from the sender. Arguably, then, the sender has relinquished the right of first publication by publishing the expression to more than one person.

With regard to multiple "to" field recipients, this relinquishment argument would not likely succeed. Designating multiple "to" field recipients is analogous to sending an identical letter to multiple recipients. If a letter author intends for the expression in the letter to

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130. See *Kortlander v. Bradford*, 190 N.Y.S. 311, 313 (N.Y. Sup. Ct. 1921) (stating that "once published it is dedicated to the public, and the author has not at common law any exclusive right . . . to control the subsequent issue of copies by others"); *Widdemer v. Hubbard*, 19 Pa. C. 263, 264–65 (C.P. 1887) (holding that the "making known to others the contents of [a] letter" constitutes a publication).

131. See *Widdemer*, 19 Pa. C. at 264–65 (holding that letter was published where the author sent the letter to two third-party recipients in addition to its intended recipient).

132. *Id.* Although the recipient would still be subject to statutory copyright prohibition against copying the letter, for reasons discussed below, that general prohibition would not likely apply in the context of a casual email correspondence. See *infra* Part III.A–C.

133. *Widdemer*, 19 Pa. C. at 264–65.



address each individual recipient, the author retains a right of first publication as to each letter recipient, regardless of whether the other recipients receive the identical expression. For example, consider an author who sends an identical letter, which perhaps complains generally about working conditions at large corporations, to three different corporate executives, each addressed to “Dear Corporate Executive.” The author retains an interest in maintaining privacy of expression that the author has made to each executive, even where the author specifies in the letter that the author is sending an identical letter to all three executives. The executives receive a letter that is intended to address them—not merely reiterate an expression made to a different person. Thus, the fact that the author sends identical expressions to multiple recipients should not detract from the privacy interest that the author holds as to the same individual expression sent to each recipient. In the email context, the same reasoning applies. Even though a sender may transmit an identical expression to each “to” field recipient, for purposes of the email sender’s interest in maintaining privacy, the email sender has effectively written individual identical emails to each recipient. The author retains a right of first publication with respect to the multiple emails received by the respective multiple email recipients. Multiple “to” field recipients merit multiple instances of privacy protection.

Although the presence of multiple “to” field recipients does not suggest that the sender relinquishes the right of first publication, a contrary conclusion arises where a sender designates a recipient in the “carbon copy” field. Carbon copying (or blind carbon copying) constitutes copying the expression sent to the intended recipient listed in the “to” field and sending that copy to a third party to observe. An email sender who carbon copies someone is analogous to an author of a letter who copies the letter, stamps the letter with the word “copy,” and then sends the original to a recipient and the stamped copy to a different recipient for review. The express label of “copy” stamped on a letter sent to a party other than the letter’s intended recipient would evidence a finding that the author intended to copy and distribute the expression meant for the intended recipient, or in other words, that the author published it. The author would not have intended for the expression in the copy to be addressed to, or apply to, the third-party recipient.

In the email context, the carbon-copy feature electronically stamps the carbon-copy recipient’s email with a mark indicating that the sender intended to make a copy of the original email and distribute it to a party other than the intended recipient. It evidences an intent to create a copy for the purpose of third-party review or observation. That is, the electronic carbon-copy stamp suggests that the sender does not intend for

the email expression to apply to the carbon-copy recipient, but rather intends for the carbon-copy recipient to receive a record of the expression sent to the “to” field recipient. Common-law copyright rules therefore suggest that an email sender relinquishes the right of first publication when the sender includes a carbon-copy or blind-carbon-copy recipient in the email.

The distinction that common-law copyright draws between multiple “to” field recipients and a “carbon copy” recipient warrants criticism. An email sender may intend for the email expression to apply to a carbon-copy recipient as much as the sender intends for the email to apply to multiple “to” field recipients. Perhaps the sender desires to separate two recipients by placing them in the separate “to” and “carbon copy” fields because the visual appearance of two names separated vertically is easier to identify than is the appearance of two names separated by a semicolon in a horizontal string. Perhaps a sender desires to send the same email to multiple recipients without revealing any recipient’s identity to any other recipient. In that circumstance, the sender might designate himself as the “to” field recipient, and then designate all other intended recipients in the blind-carbon-copy field. The email text would not indicate that the message was directed to a specific recipient. Hence, in view of the purposes for which senders employ the carbon-copy (and blind-carbon-copy) field, the mere use of that field should not necessarily suggest relinquishment of the right of first publication. Use of the carbon-copy field does not necessarily suggest that the sender intends for the email expression to apply only to the recipients listed in the “to” field and not to those listed in the carbon-copy field.

This criticism has merit. Where the content of the email indicates that the sender intends for the content of the email to apply to the carbon-copy field recipient as much as the “to” field recipient, the fact that the sender employs the carbon-copy field should not imply that the sender has relinquished the right of first publication. Ultimately the issue of whether publication to a third party has occurred—or in other words the issue of relinquishment—raises a question of fact contingent upon a sender’s intent. Nevertheless, where the content does not expressly indicate that the expression applies to the carbon-copy recipient, the fact that the sender has employed the carbon-copy feature should create at least a presumption of relinquishment. Standing alone, carbon copy indicates an intent to publish: it functions as a discrete indicator of an intent to copy and distribute the email to a third party for the purpose of making the expression which was sent to the “to” field recipient known to that third party. Use of this feature presumptively establishes an intent

by the sender to relinquish the right of first publication.<sup>134</sup> Only if circumstances demonstrate otherwise should the carbon-copy feature not be viewed as evidence of relinquishment by the sender.

*B. Rights of Email Recipients*

The common law endows letter recipients with property rights,<sup>135</sup> which implies that email recipients also hold property rights. Once delivery occurs, the letter recipient receives by gift property rights to possess the physical components of the letter: the physical paper, the envelope, the ink, and the postage stamp.<sup>136</sup> So while copyright secures an author property rights in the letter's expression, property law secures the recipient property rights to the physical components of the letter.<sup>137</sup>

Other than publishing the letter, a recipient may exercise all rights over a physical letter inherent in personal property.<sup>138</sup> The recipient may preserve the letter against the wishes of its author.<sup>139</sup> Further, the recipient may dispose of the letter by destroying, selling, or otherwise

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134. By contrast, a recipient's use of the "forward" feature does not suggest that the sender has relinquished the right of first publication. Assuming that the sender does not forward the email, the forwarding label evidences the recipient's intent to copy and distribute the email expression. Relinquishment of the right of first publication hinges upon the intent of the sender—not the intent of the recipient. Accordingly, if a recipient forwards an email, the sender retains his right of first publication.

135. See *Baker v. Libbie*, 97 N.E. 109, 111–12 (Mass. 1912) ("The author parts with the physical and material elements which are conveyed by and in the envelope. These are given to the receiver."); *Woolsey v. Judd*, 11 How. Pr. 49, 64 (N.Y. Sup. Ct. 1855) (recognizing the English common-law principle that "the receiver of letters has only a special or qualified property, confined to the material on which they are written, and not extended to the letters as expressive of the mind of the writer").

136. See *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 486 (1867) ("[T]he unqualified delivery of the letter [is] adjudged a gift of all the author's right to it, except his right to publish if existing, and to prevent the publication of it without his consent."); *Baker*, 97 N.E. at 111–12 (declaring that the material elements "conveyed by and in the envelope . . . are given to the receiver" such that "the right in the receiver of an ordinary letter is one of unqualified title in the material on which it is written"); *Eyre v. Higbee*, 22 How. Pr. 198, 204 (N.Y. Sup. Ct. 1861) ("We must . . . presume a grant of the letters from him to her."); see also *Woolsey*, 11 How. Pr. at 63 (relating, without objecting to, the assumption of a litigant's argument that "sending of letter is in the nature of a gift to the receiver").

137. See *Baker*, 97 N.E. at 112 (teaching that a letter recipient has rights to the physical components of a letter "as absolute owner subject only to the proprietary right retained by the author for himself and his representatives to the publication or nonpublication of ideas in its particular verbal expression").

138. See *Grigsby*, 65 Ky. (2 Bush) at 488 ("[T]he recipient may rightfully make *any use* of the letter which will not, in the same sense, amount to publication . . ." (emphasis added)).

139. See *id.* at 484 ("By sending [the letters], the authors parted with their right to the possession, control, or reclamation of them without [the recipient's] consent, and gave her the exclusive right to read and keep them for their enduring memories and sentiments.").

transferring it.<sup>140</sup> It is noteworthy that transferring the letter does impinge on the author's interest in maintaining privacy: through transfer, an unintended third party gains permanent access to the author's expression. The reason that transfer is permissible despite its encroachment on the author's privacy interest appears to be that the recipient's property rights over the physical letter are absolute.<sup>141</sup> When the author gives the letter to the recipient, the author parts with rights to the letter's physical components, and the recipient becomes the rightful owner.<sup>142</sup> As rightful owner of the letter, the recipient is not subject to restraints on alienation.<sup>143</sup> In short, a person's right of alienation in personal property appears to be a stronger legal interest than is the interest of protecting another person's right to maintain expressive privacy.<sup>144</sup> Alienability appears to be a stronger interest than privacy.<sup>145</sup> At the cost of invading a degree of the author's privacy, then, the recipient may transfer the letter.

These common-law principles governing property rights to a physical letter imply that an intended email recipient holds property rights in the electronic computer file that constitutes the email. The sender transmits the computer file to the recipient, and that file gives rise to the evanescent display on the computer screen.<sup>146</sup> As owner of the computer file, the recipient may preserve the file on a storage device, or alternatively, dispose of the file.<sup>147</sup> Disposal by destruction is apparent:

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140. See *id.* at 486 (“[T]his general property implies the right in the recipient to keep the letter or to destroy it, or to dispose of it in any other way than by publication . . . .”); *Baker*, 97 N.E. at 112 (“[An author]’s proprietary power is to make or to restrain a publication, but not to prevent a transfer.”).

141. *Grigsby*, 65 Ky. (2 Bush) at 486; *Baker*, 97 N.E. at 112.

142. See *supra* notes 135–36 and accompanying text (describing a recipient’s rights to the letter).

143. See *Dyer v. Dyer*, 566 S.E.2d 665, 668 (Ga. 2002) (“It is the policy of the law to encourage free alienability of property, and attempts to remove either land or chattels from circulation in trade are discouraged . . . by the rule against unreasonable restraints on alienation.” (quoting *Leathers v. McClain*, 338 S.E.2d 666, 667 (Ga. 1986))).

144. See RESTATEMENT OF PROPERTY § 489 cmt. a (1944) (“The policy of the law has been, in general, in favor of a high degree of alienability of property interests. This policy arises from a belief that the social interest is promoted by the greater utilization of the subject matter of property resulting from the freedom of alienation of interests in it.”); cf. Jessica Litman, *Information Privacy/Information Property*, 52 STAN. L. REV. 1283, 1296–1301 (2000) (arguing that a property-based theory to further privacy must fail because property necessarily requires rights of alienability, which fosters exchange, and exchange contravenes privacy).

145. See *supra* note 144 and accompanying text (discussing alienability and privacy in terms of property interests).

146. See *Brain*, *supra* note 118 (describing the email process).

147. See *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 486 (1867) (discussing right of recipient of a letter “to keep the letter or to destroy it, or to dispose of it”); *Baker v. Libbie*, 97 N.E. 109, 112 (Mass. 1912) (discussing letter recipient’s right to deal with the letter as “absolute owner”).

the recipient simply deletes the file. Disposal by sale or other transfer merits further discussion.<sup>148</sup>

### 1. The Right to Transfer Email

Permissible email transfer by a recipient requires a physical transfer of the email computer file. Because the recipient holds property rights in the computer file, rather than the expression within the email, the recipient may not simply forward the email to effect a transfer.<sup>149</sup> By forwarding an email, the original email recipient makes a reproduction of the expression in the email, and the right to reproduce the expression is not within the bundle of rights that the recipient holds in the physical components of the letter.<sup>150</sup> A recipient may therefore exercise the right to transfer the email file only if the transfer results in physical movement of the file to the transferee.<sup>151</sup> A permissible transfer must be a physical transfer.

Physical transfer of email raises several complexities. Email files exist within physical storage devices.<sup>152</sup> Specifically, an email could exist on a recipient's hard drive where the email client, e.g., Outlook Express, has saved the file sent from the email server, or alternatively, an email could exist on the email server accessible through the Internet.<sup>153</sup> Physical transfer in the former situation—the email file existing on the recipient's hard drive—requires that the recipient physically transfer the hard drive on which Outlook Express originally saved the email file. If the email file exists only on the hard drive, the recipient physically controls the email only to the extent that the recipient is able to control the hard drive on which the file exists. A physical transfer would therefore require a transfer of the hard drive.

The second situation—the email file existing on the email server—raises a complexity under the physical transfer requirement. The email file on the email server would belong to the recipient, but the storage

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148. See *infra* Part II.B.1 (discussing rights of email recipients to transfer emails).

149. See *supra* Part II.A.2.a (discussing email forwarding).

150. See *supra* Part II.A.2.a (discussing email forwarding). The fact that an email recipient might forward the original email expression as an attachment rather than as inline text does not affect the argument that the email recipient does not hold a right to reproduce that original expression. Regardless of its digital form, the original expression belongs to the original email sender.

151. See *Grigsby*, 65 Ky. (2 Bush) at 488 (discussing letter recipient's right to deposit letters at a place of recipient's choosing); *Woolsey v. Judd*, 11 How. Pr. 49, 57–58 (N.Y. Sup. Ct. 1855) (discussing letter recipient's rights to control only the material on which expression is written).

152. See *Brain*, *supra* note 118 (explaining how email works on the Internet).

153. See *id.* (explaining the mechanics of how email clients and servers work).

device on which that file is saved would belong to the owner of the email server, an internet service provider. In that situation, the recipient's circumstance would be analogous to that of a building owner whose building lies on land of a separate landowner.<sup>154</sup> Just as the building owner uses and leases the land on which the building lies from a landowner, an email recipient stores email files on and rents server space from an internet service provider.<sup>155</sup> And just as the building owner cannot transfer title to the land underlying the building, the email recipient cannot transfer title to the server on which the recipient's email is saved.<sup>156</sup> Instead, the building owner and email recipient may transfer rights of dominion and control over their respective properties.<sup>157</sup> To be effective, the transfers must be subject to the property rights of the respective landowner and an internet service provider.<sup>158</sup>

Like a transfer of email stored on a hard drive, a transfer of email stored on a server belonging to an internet service provider must be absolute.<sup>159</sup> The email recipient who accesses email through an email server on the Internet, e.g., Yahoo!, must transfer his or her lease to the server space corresponding to the email that the recipient seeks to transfer. In the analogous situation of the building owner, the building owner must transfer rights to lease the underlying land if the building owner is to effect a complete transfer of all rights to the building.<sup>160</sup> The circumstances of the email context, however, preclude the email recipient from transferring only the leased server space that corresponds to a single email.<sup>161</sup> Internet service providers do not fragment email accounts.<sup>162</sup> If an email recipient desires to transfer server space

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154. *See, e.g., Adams v. Shirk*, 104 F. 54, 59–60 (7th Cir. 1900) (recognizing the conceptual distinction between property held by owner of a building and property held by owner of land on which the building sits).

155. *See id.* at 60 (discussing lease situation).

156. *See id.* (discussing lessee's inability to transfer land underlying leased building).

157. *See id.* (discussing right to transfer).

158. *See id.* (stating that transfer of lease is subject to property rights of respective landowner).

159. *See Grimsley v. Grimsley*, 632 S.W.2d 174, 179 (Tex. Ct. App. 1982) (rejecting attempted transfer of property in the absence of relinquishment of total dominion and control by transferor).

160. *See Adams*, 104 F. at 60 (stating it was not in lessee's power "to compel the desired forfeiture or his own discharge through the enforced acceptance of a substitute").

161. The mechanics of email preclude email-account fracturing. The email-website operator, which acts as the internet server through which the email is received, creates one single computer file on which multiple email messages may exist. *See Brain, supra* note 118 ("As other people sent mail to [the recipient], the server would simply append those messages to the bottom of the file in the order that they arrived. The [email] text file would accumulate a series of five or 10 messages . . .").

162. *E.g., 2006 Yahoo! Terms of Service*, <http://docs.yahoo.com/info/terms> (last visited Aug. 1, 2006) (on file with author) [hereinafter Yahoo! Terms of Service].

corresponding to a particular email, the recipient must transfer all the server space constituting the email account.<sup>163</sup> A recipient must sign over the rights to the email-website account containing the email. For example, a Yahoo! subscriber could transfer an email sent to the subscriber's Yahoo! email address only if the subscriber transferred all rights to the entire Yahoo! account.<sup>164</sup> The transferee could then bar the original recipient from accessing the account, so the transfer would be absolute.

It should be noted that technology provides a means for realizing the same outcome of transferring email which is much less cumbersome than the two means of transfer discussed above. Forwarding and deleting an email is easier than detaching and delivering a hard drive or signing over an email account. An argument exists that email forwarding and deletion should replace these more difficult means of email transfer. The argument is one of efficiency. The transaction cost is high where the recipient must physically transfer the email file; indeed, the costs of delivering a hard drive or signing over an email account can altogether prevent the transfer. By contrast, the same result of the email being transferred to a third party and the original recipient not holding a copy of the email can be realized by a much simpler and less costly means: forwarding and deleting the email. If a recipient simply forwards and deletes the email, the effect is the same as though the recipient were to provide the third party the actual physical copy of the email file on the recipient's hard drive or the contract rights to the recipient's email account. Forwarding and deleting has the same effect as physical transfer. The original email recipient is left with no physical record of the email expression, so from a pragmatic perspective, the third party's copy appears to be a transfer. An argument thus exists that the technological means of email forwarding and deletion should replace the archaic requirement of physically delivering to the third party the original email that the recipient received from the sender.

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163. See *supra* note 161.

164. An issue arises as to whether an email recipient may permissibly transfer rights of use to an email-website account. Some email-website operators contractually prohibit such transfer. See, e.g., Yahoo! Terms of Service, *supra* note 162 (noting that the Yahoo! Account is nontransferable). Whether those terms are enforceable is an issue outside the scope of this Article. It nevertheless should be noted that such a contractual prohibition would represent a restraint on alienation with respect to the email recipient's property rights to the email file contained on the Yahoo! server. The common law disfavors such restraints on alienation. See *Cont'l T.V., Inc. v. GTE Sylvania Inc.*, 433 U.S. 36, 53 n.21 (1977) ("[T]o impose vertical restrictions in sale transactions would 'violate the ancient rule against restraints on alienation.'" (quoting *United States v. Arnold, Schwinn & Co.*, 388 U.S. 365, 380 (1966), *overruled on other grounds by Cont'l T.V.*, 433 U.S. at 58)).

This argument for transfer by email forwarding and deletion would not likely succeed. The recipient may permissibly transfer the email without invading the sender's privacy only because the recipient holds absolute property rights to the physical components of the email.<sup>165</sup> Any copies of the email expression, even if the original email is deleted, fall within the scope of the sender's rights to control the expression. Accordingly, although forwarding and deleting email may effect the same result as transferring rights to the physical email file that the recipient originally received, forwarding is not within the scope of property rights that an email recipient holds in the physical file. Transfer can occur only by exercising rights to the physical components of the email, for that is the only subject matter over which the recipient holds property rights. This means that the transfer must occur in either one of two ways: (1) a physical transfer of the storage device on which the recipient's computer originally saved the file;<sup>166</sup> or (2) a transfer of the contractual right to the email account containing the physical email file. The fact that technology provides means for realizing the same outcome is of no consequence. Transferring the expression by reproducing it would constitute an unwarranted infringement of the sender's right to control the expression.

## 2. The Right to Display Email

Another common-law rule governing letters is that a letter recipient may show the letter to others.<sup>167</sup> Authority exists for the proposition that the recipient may display the letter to as many persons as the recipient desires, insofar as the recipient does not make copies of the letter.<sup>168</sup> This right to display arises out of the recipient's property rights in the physical components of the letter, which allow the recipient to control

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165. See *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 486 (1867) (opining that a letter recipient holds property rights over the physical components of the letter); *Baker v. Libbie*, 97 N.E. 109, 112 (Mass. 1912) (same).

166. Transfer of the storage device on which the file exists does not permit the email recipient to save the file onto a different storage device for the purpose of effecting a permissible transfer. That is, an email recipient may not copy the email file from the storage device on which the email was originally saved (e.g., the recipient's hard drive) onto a different storage device (e.g., a floppy disk) for the purpose of effecting a physical transfer of the email file.

167. See *Baker*, 97 N.E. at 112 (dictum) (noting that with regard to a recipient's rights over letters, "there must be inferred a right of reading or showing to a more or less limited circle of friends and relatives").

168. See *Salinger v. Random House, Inc.*, 811 F.2d 90, 97 (2d Cir. 1987) ("[Plaintiff]'s letters are unpublished, and they have not lost that attribute by their placement in libraries . . .").



the physical possession, and thereby location, of the letter.<sup>169</sup> If a recipient were not allowed to show the letter to others, the recipient's right to control the physical location of the letter would be severely restricted. To uphold the recipient's property rights to the physical components of the letter, common-law copyright recognizes that a recipient may place the letter in a physical location for other persons to view.<sup>170</sup>

This common-law principle implies that an email recipient may display the email to others. The issue arises, then, as to whether there are limitations on the method for displaying the email. Most akin to displaying a physical letter would be displaying an email to a third party while the email is visible on a computer screen. A screen display does not affect the email file on the recipient's hard drive or internet email account. That method of display instead requires any third party to be present at the computer on which the recipient may access the email.<sup>171</sup> This method appears most similar to the circumstances surrounding a letter recipient showing the letter to a third party because it requires that the letter be physically located in proximity to the third party. Screen display of a recipient's email appears permissible under the common law.

Other methods of display are possible. A recipient might post the email on a website, might provide a third party access to the recipient's email account, might print the email and show the third party that copy, or might print the email and give the third party that copy. The issue of whether these methods are permissible under the common law is discussed in the following two subparts.

#### a. Email Display on a Website

Consistent with common-law recognition that a letter recipient may place the letter at any physical location for others to view, it has been held that a recipient may publicly display the letter by placing it in a

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169. See *id.* at 94–95 (“Having ownership of the physical document, the recipient . . . is entitled to deposit it with a library . . . .”); *Grigsby*, 65 Ky. (2 Bush) at 488 (discussing recipient's right to deposit letters at a place of recipient's choosing).

170. See *Grigsby*, 65 Ky. (2 Bush) at 488 (“[T]he recipient may read the letters to a friend or deposit them for safe-keeping without violating the author's right of publication.”).

171. It is possible for an email recipient whose email is stored on an email server to view the email through the Internet while using a third party's computer in order to show the email to the third party. That situation would be analogous to providing a third party access to the email account on which the email is stored, which is addressed in Part II.B.2.a.

library.<sup>172</sup> In view of this holding, the question arises as to whether an email recipient may publicly display the email by either posting it to a website or by making available the password to access a website email account that contains the email. At first glance, the library and the two website situations seem analogous. All persons interested in viewing an email may view the email on a website much like they could view it at a library. Displaying the email through a website seems to be like making it available at a public forum, much like a library.

This argument for website display should not succeed. The library analogy fails due to a substantive distinction arising between the fora of cyberspace and physical space. With respect to either a publicly available website or a website email account like Yahoo!, the computers of all persons who view the email on the website must produce a copy of that email display in their computers' memory.<sup>173</sup> Courts have held that computer memory is a medium on which infringing copies may be made.<sup>174</sup> Accordingly, a copy of an email that is made by a computer that is not under the control of the intended recipient—whether that copy be made by accessing the recipient's email account or by accessing a website—results in an unauthorized publication of the email. By providing others access to an email account, or by simply posting the email on a publicly available website, the recipient facilitates for others a means to reproduce copies of the expression.<sup>175</sup> Displaying email on a website or providing others access to an email account appears to violate the right of first publication.<sup>176</sup>

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172. See *Salinger*, 811 F.2d at 97 (“[Plaintiff]’s letters are unpublished, and they have not lost that attribute by their placement in libraries . . .”).

173. See Fred H. Cate, *The Technological Transformation of Copyright Law*, 81 IOWA L. REV. 1395, 1397 (1996) (“[D]igital expression cannot be accessed without being copied into computer memory . . . .”); see also Marshall Brain, *How Web Pages Work*, <http://computer.howstuffworks.com/web-page5.htm> (last visited Jan. 10, 2007) (explaining process for posting graphics files on a website).

174. See *Stenograph L.L.C. v. Bossard Assocs., Inc.*, 144 F.3d 96, 101–02 (D.C. Cir. 1998) (finding that the defendant had illegally reproduced elements of the copyrighted work “insofar [as the] elements were reproduced into RAM”); *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 519 (9th Cir. 1993) (holding that a computer’s RAM constituted a fixed form of a work); *Advanced Computer Servs. of Mich., Inc. v. MAI Sys. Corp.*, 845 F. Supp. 356, 363 (E.D. Va. 1994) (holding that RAM is “sufficiently ‘fixed’ to constitute a ‘copy’ under the Act”). These cases have arisen under the Copyright Act, but seem just as applicable under a common-law standard. There is no reason or authority supporting the argument that common-law copyright and federal copyright have different rules regarding the material on which a copy may be made to constitute a “copy.”

175. Making a letter available to the public in a library would be analogous to the website circumstances described above if in the library context the letter recipient made available the letter for library patrons for the sole purpose of patrons themselves making a copy of the letter at the library.

176. With respect to posting an email on a publicly available website, the argument that the website functions as a public forum for display fails for another reason. The procedure for posting

Admittedly this response to the argument for website display relies on a very technical computer process. It seems to employ a technicality to escape the inevitable consequence of allowing public display in the digital age.

b. Email Display on Physical Paper

The question of whether an email recipient may display an email that the recipient prints on paper raises a preliminary issue of whether the recipient may even print the email. The common law suggests that printing is permissible.<sup>177</sup> As stated above, the common law definition of publication is the circulation of any number of copies.<sup>178</sup> The act of printing email does not necessarily result in circulation; it does not necessarily result in privacy invasion.<sup>179</sup> If a recipient holds both the original electronic version of the expression and additional paper copies, but never exposes the copies to any third party, the email sender's privacy remains unaffected.<sup>180</sup> Because email printing itself does not result in a deprivation of privacy, it appears permissible for a recipient to make a physical copy of the sender's electronic expression.

The question next arises as to whether the recipient may show the printed email to a third party. Privacy interests of the sender favor the view that the only means for an email recipient to permissibly show the

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an email on such a website requires that a copy of the email be made for display on the website. *See* sources cited *supra* note 173. That is, the email recipient does not display the actual original email that he or she received from the email sender when the recipient posts it to a website. The recipient must make and distribute a copy of the sender's expression in order to post the email on a website.

177. In *Grigsby v. Breckinridge*, the court stated: "[A letter recipient] may do every thing but multiply copies, and perhaps he may do this, if he do [sic] not print them." 65 Ky. (2 Bush) 480, 489 (1867) (internal quotations omitted). This statement would not make sense unless there were a distinction between multiplying copies and printing copies. It is therefore likely that "multiplying" copies denotes copying by hand but not distributing those copies to third parties, whereas "printing" copies denotes copying by machine for the purpose of third-party distribution.

178. *See id.* at 488 ("Publication by the author is *circulation* before the public eye by printing or multiplied copies in writing." (emphasis added)); *accord* *Ipswich Mills v. Dillon*, 157 N.E. 604, 605-06 (Mass. 1927) (holding that copies of letter made by author, which author did not distribute, did not impair the property rights of the author); *see also* *Widdemer v. Hubbard*, 19 Pa. C. 263, 264-65 (C.P. 1887) (holding that letter author had made publication by sending the letter to two third-party recipients in addition to its intended recipient).

179. *Grigsby*, 65 Ky. (2 Bush) at 488.

180. *See id.* (stating that the recipient may make any use of the letter which does not amount to publication). It is entirely plausible that a recipient would print a paper copy of the email without distributing it to a third party: recipients often prefer to read text on paper rather than on a computer screen, and evidence exists that reading words on paper is more efficient than on screens. *See generally* Andrew Dillon, *Reading from Paper Versus Screens: A Critical Review of the Empirical Literature*, 35 *ERGONOMICS* 1297 (1992) (discussing numerous issues relating to reading computer screens versus reading on paper).

email is to show it on a computer screen. By restricting the means for viewing the expression, a recipient might decrease the number of people to whom the recipient would likely show the expression. On the other hand, property interests of the paper owner suggest that the owner may exercise full control over the paper on which the copy is printed. The property rights attaching to the paper would appear to be the same before printing the email as after printing the email; so if the email recipient prints the email on paper belonging to either the recipient or a third party, it seems that the recipient or that third party then may exercise full control over that printed email. The paper owner arguably may show it to anyone.

A clear resolution of these competing interests of privacy and property is not readily apparent.<sup>181</sup> The argument that the recipient should not be able to show the printed copy is simply that the recipient's right to print email should not be extended in a manner that decreases the sender's privacy. The basis for the recipient's right to print the email is that the act of printing does not result in a deprivation of privacy. This basis would be ineffective if the recipient could display the printed copy to others. It is possible, then, that the email recipient receives a right to print the email subject to a restriction that the printed copy may not be displayed to a third party. Duplication of the expression would be permitted only to the extent that it does not decrease the sender's privacy. By printing the email, the recipient arguably exchanges the right to display and the right to transfer the paper on which the email is printed for the right to make a physical copy of the email expression.

A counterargument exists to this argument against displaying and transferring printed copies. It is that the recipient never bargains with the sender to print the email, so the recipient holds absolute property rights over the printed copy.<sup>182</sup> This counterargument posits that the recipient's right to print the email stems from the fact that printing email is a common practice. Because the practice is so universally accepted, it is arguable that the sender implicitly consents to the practice by the very fact that the sender transmits email. The consent would mean that the sender cannot control the physical paper on which the expression is printed. It would mean that the paper copy of the email may be

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181. The common law has not addressed an analogous situation in the letter context, likely because in the context of letters during the nineteenth century it would have been easier to display the expression by simply showing the actual letter rather than by copying the letter and then showing that copy.

182. See *Grigsby*, 65 Ky. (2 Bush) at 488 (“[T]he recipient may rightfully make *any use* of the letter which will not, in the same sense, amount to publication . . . .” (emphasis added)).

displayed, and for that matter transferred, without regard to the sender's privacy interest. The copy of the email on physical paper arguably belongs as much to the email recipient as the email computer file belongs to the recipient.

This counterargument is persuasive. Although an email sender's interest in privacy suggests that it would be advisable to limit the uses of the printed copy, it is unlikely that the sender could impose such a restriction. The common practice of email appears to compel an email sender to allow the recipient to print the email. In a sense, the email sender qualifies his or her right of expression by the mere fact that the sender uses email: to the extent the recipient does not publish the expression, the recipient may print the email on paper over which the recipient may exercise dominion and control. That dominion and control includes showing and transferring the paper.

A pragmatic problem with this reasoning is that if an email recipient may transfer the printed copy of the email, then the recipient may publish the expression therein. Likewise, if the recipient prints the email on paper belonging to someone else, publication results. The recipient's seeming right to print a hard copy of the email, in conjunction with the absolute property rights that the paper owner holds over the paper on which the recipient prints the email, leads to the outcome that the recipient is able to publish the expression. The recipient can simply transfer title of the printed copy to a third party, retain the electronic file, and thereby undermine the sender's right of first publication.<sup>183</sup> Alternatively, the recipient can simply print the email on paper belonging to a third party.

This pragmatic problem is resolvable. The common-law principle that a letter recipient "has only a special or qualified property" right suggests that the recipient's physical property rights in the email exist only to the extent that those rights preserve an email sender's rights to control duplication and distribution of the sender's expression.<sup>184</sup> Consistent with this principle, the property rights in the physical printed copy of the email should be tied to those in the email computer file.<sup>185</sup> If both a paper form and an electronic form of the expression exist, they

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183. A similar argument could be made in situations where the email recipient retains a copy of the email on the recipient's hard drive and on an email server. See *supra* Part II.A.2.b. (discussing limits on common-law right of first publication in the email context). The recipient could simply transfer title to the hard drive and retain the copy on the email server.

184. See *Woolsey v. Judd*, 11 How. Pr. 49, 64 (N.Y. Sup. Ct. 1855).

185. This resolution would apply to the analogous argument raised, *supra*, in note 183: an email recipient could transfer title to the hard drive only if the recipient transferred title to the email account on the email server along with it.

must exist together. This would mean that a recipient may print an email on paper belonging to another, but only if the paper owner transfers title to the email recipient upon printing. Similarly, the printed copy may be transferred to a third party, but only if the physical email file is transferred along with it. Bundling together the property rights to the physical email file and the printed copy preserves a recipient's right to control the physical nature of the email and the printed copy, yet it also subjects those rights to the sender's rights of expression. Bundling would maintain the sender's privacy. Accordingly, transfer of the email computer file should require the transfer of the paper copy, and likewise, a transfer of the paper copy should require the transfer of the email computer file. Because the recipient does not retain property rights to an electronic or paper form of the expression when the recipient transfers both forms, no two persons could hold property rights to a physical manifestation of the expression. There would be no publication. Thus, the physical property rights of a printed email copy should be tied to those of the physical property rights of the email computer file.

### 3. Rights of Unintended Email Recipients

Up to this point the discussion regarding the rights of email recipients has relied on the assumption that the recipients of email were in fact the intended recipients of the email. But that is not always true. Email senders often mistakenly input an incorrect email address in the "to" field such that the email address entered does not identify the person whom the sender intends to receive the email. Occasionally, such a mistaken email address corresponds to an email address of an actual person.<sup>186</sup> Email is sent to unintended recipients. The question arises, then, whether unintended recipients of email hold property rights in the email.

This question is easily answered under simple principles of gift law and finders law. As stated above, a letter recipient receives property rights to the letter by gift from the letter author.<sup>187</sup> To gift personal property to a person, a donor must deliver the property to the intended donee.<sup>188</sup> Delivery occurs where the gift donor has done "all that

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186. See, e.g., Posting of Jeff Carlson to Jeff Carlson (. Thought), [http://jeffcarlson.typepad.com/thought/2005/06/misdirected\\_ema.html](http://jeffcarlson.typepad.com/thought/2005/06/misdirected_ema.html) (June 13, 2005, 10:36) ("I frequently receive misdirected email intended for New England Coffee Company because they're necoffeeco.com, while I'm necoffee.com.").

187. See *supra* note 136 (noting that delivery of a letter is a gift of all of the author's rights, excluding publication).

188. See RESTATEMENT (SECOND) OF PROP.: DONATIVE TRANSFERS § 31.1 (1992) (stating that

normally could be done” under the circumstances to put the intended donee in control of the personal property.<sup>189</sup> This means that for a sender to transfer property rights in the email to the intended recipient, the sender must do all that normally could be done to put the intended recipient in possession of the email.<sup>190</sup> All that normally could be done includes typing the correct email address of the intended recipient in the “to” field. Delivery never occurs, then, where the sender inputs an incorrect email address. The actual recipient must therefore be the intended recipient for the actual recipient to hold property rights in the email under gift law.

Although an unintended recipient holds no property rights in the email under gift law, an issue arises as to whether the unintended recipient may assert property rights over the email by virtue of the fact that the unintended recipient is in possession of the email. In establishing property rights, “[p]ossession is very strong; rather more than nine points of the law.”<sup>191</sup> An unintended recipient could therefore argue that mere possession of the email bestows property rights. Although it was not a gift, in the recipient’s inbox the email exists, and that—according to an unintended recipient—should be sufficient.

This argument would not likely prevail. The email sent to an unintended recipient is essentially an item that the sender mistakenly causes to exist in a different location than intended. Stated another way, the email is a lost item. The unintended recipient is therefore a finder of lost property.<sup>192</sup> And although it is lost, the physical email file has not been abandoned.<sup>193</sup> Finders of lost, but not abandoned, property hold property as against all others but the true owner.<sup>194</sup> Therefore, the sender retains property rights to the email computer file even after the sender mistakenly addresses and sends the email to the unintended recipient.<sup>195</sup>

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for a gift to be valid, the donor must deliver the personal property “to the donee with the manifested intention that the donee be the owner of the personal property”).

189. *Id.* § 31.1 cmt. b.

190. *See id.* (discussing what constitutes delivery).

191. *Corp. of Kingston-up-Hull v. Horner*, (1774) 98 Eng. Rep. 807, 815 (K.B.).

192. *See id.* (contemplating the possibility that a finding may occur with respect to property that is intended to be gifted).

193. *See Haslem v. Lockwood*, 37 Conn. 500, 506–07 (1871) (holding that plaintiff did not abandon property rights to manure that plaintiff left in the street, which defendant attempted to take possession of).

194. *Armory v. Delamirie*, (1722) 93 Eng. Rep. 664, 664 (K.B.).

195. It should be noted that the recipient acts as a finder of lost property, and as a finder, the recipient does hold property rights against all persons who are neither the intended recipient nor the original sender. *See id.* (“[T]he finder of a jewel, though he does not by such finding acquire an absolute property or ownership, yet he has such a property as will enable him to keep it against all but the rightful owner . . .”).

The fact that the sender retains title to the physical email file sent to an unintended recipient suggests that if the email sender requests the unintended recipient to destroy the email, the unintended recipient is obligated to comply with that demand. Contrary to popular belief that email disclaimers are of no legal effect,<sup>196</sup> an email disclaimer that requests an unintended recipient to destroy an email does appear to merit legal recognition: gift law and finders law imply that the email sender retains a property interest in the email.<sup>197</sup> The following simple email notice appears to have legal effect: “If you are not the intended recipient of this email, the email sender requests that you destroy this email.”<sup>198</sup> Because the unintended recipient never receives a property right superior to the email sender, the unintended recipient must comply by deleting the email.<sup>199</sup>

### III. FEDERAL COPYRIGHT’S FAILURE TO PROTECT EMAIL EXPRESSION

In 1976, Congress passed the Copyright Act.<sup>200</sup> The Act purports to provide a right of first publication to authors,<sup>201</sup> and further states that it preempts all other law that provides “equivalent” rights.<sup>202</sup> At first glance, the Act’s codification of a right of first publication appears to mirror the common-law principle of protecting privacy interests in

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196. See Grimmelmann, *supra* note 5 (“People who send email from disclaimer-laden corporate accounts are roundly mocked; unless the email is obviously and intrinsically not meant for certain eyes, disclaimers are next to useless.”).

197. *Armory*, 93 Eng. Rep. at 664; see also RESTATEMENT (SECOND) OF PROP.: DONATIVE TRANSFERS § 31.1 (1992) (“The owner of personal property may make a gift thereof to another person (the donee) by delivering it to the donee, or to a third person for the donee, with the manifested intention that the donee be the owner of the personal property.”).

198. Martin H. Myers, *Cyber-Ethics 2002: Professional Responsibility and Evolving Technology*, 701 PRACTISING L. INST. 977, 994 (2002) (providing similar email disclaimer).

199. The fact that rules of personal property law, such as gift law, govern property rights to physical email files suggests that it is possible for an unintended email recipient to gain property rights to the email. Personal property may be acquired through adverse possession. See *Lightfoot v. Davis*, 91 N.E. 582, 583 (N.Y. 1910) (“[I]t seems to be the generally accepted doctrine that by adverse possession title to chattels may be acquired which will be paramount to that of the true owner.”); cf. *Sporn v. MCA Records, Inc.*, 451 N.Y.S.2d 750, 751 (N.Y. App. Div. 1982) (contemplating possibility that intangible property may be acquired through adverse possession). Title by adverse possession arises where possession is open and notorious. *Lightfoot*, 91 N.E. at 584–85. Accordingly, if an unintended email recipient notifies the sender of the recipient’s receipt of the email, and if the sender fails to request that the unintended recipient return or destroy the email, then after the time period applicable for adverse possession, the unintended recipient would arguably gain title to the physical email file.

200. The Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101–1332 (2000)).

201. 17 U.S.C. § 106(3).

202. *Id.* § 301(a).



unpublished works.<sup>203</sup> On further examination, however, the Act appears markedly different from the common-law doctrines that protect privacy. Unlike the common law, the Act provides a fair-use defense that may apply regardless of whether the author has decided to publish the work.<sup>204</sup> A weighty criterion of the fair-use defense is whether the use harmfully affects the potential market for the work.<sup>205</sup> Because casual email expression usually has no market potential, such expression would likely fall outside the scope of federal copyright protection.<sup>206</sup>

This Part analyzes whether the Copyright Act applies to private email expression. Part III.A analyzes the relevant provisions of the Act in the email context and concludes that the Act would likely not protect email expression. Part III.B examines the caselaw and legislative history that deal with application of the Act to unpublished works and determines that these sources support the conclusion that the Act fails to protect email. Part III.C discusses the theoretical tension that arises by interpreting the Act, including its fair-use defense as it applies to works that are never intended to be published, such as email. Part III.D argues that the Copyright and Patent Clause of the Constitution restricts the Act to govern only rights that further a utilitarian purpose; that the common-law right of first publication furthers only an author's privacy interest; that this common-law right which protects private email expression falls outside the preemptive scope of the Act; and that the centuries-old common-law doctrines that have protected private letters today protect private emails.

#### *A. A Statutory Analysis of Exclusive Rights and Fair Use*

The Copyright Act provides an author exclusive rights that are subject to a defense of fair use.<sup>207</sup> This subpart analyzes the rights

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203. *Id.* § 106(3) (Historical and Statutory Notes).

204. *Id.* § 107.

205. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985) (describing the effect-on-the-market criterion as "the single most important element of fair use").

206. Because the Act concerns only rights that an author holds in an expression, the Act does not change the dual nature of the property rights to a letter, and therefore email. *See* discussion *supra* Part II.B. Regardless of whether the Act applies to email, an intended recipient does hold property rights in the physical email file, and an unintended recipient does not. *See* discussion *supra* Part II.B.

207. Emails appear to fall within the defined subject matter of the Copyright Act. The Act applies to "original works of authorship," and an "original work of authorship" includes "literary works." 17 U.S.C. § 102(a). "Literary works" is defined to mean works that are "expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied." *Id.* § 101.

relevant to the email context and then discusses whether the fair-use doctrine protects otherwise infringing uses. It concludes that fair use protects a recipient's use of casual email correspondence.

### 1. Exclusive Rights Under the Copyright Act

The exclusive rights relevant to the email context include: (1) the right to reproduce a work; (2) the right to distribute copies of a work "to the public by sale or other transfer of ownership, or by rental, lease, or lending"; and (3) the right to display a work publicly.<sup>208</sup> The first enumerated right constitutes a straightforward prohibition against reproduction.<sup>209</sup> Reproducing a work even without distributing that reproduction to a third party violates this right.<sup>210</sup> Therefore, printing an email, without transferring it, violates this right. Indeed, both printing and forwarding email constitute illegal reproductions of the email expression.<sup>211</sup>

The second enumerated right—the right to distribute copies of a work to the public—is referred to in the Statutory Notes of the Act as the "Public Distribution" right.<sup>212</sup> Those Notes state that the Public Distribution right "establishes the exclusive right of publication."<sup>213</sup> The Notes state:

Under this provision [concerning the federal right of publication] the copyright owner would have the right to control the first public distribution of an authorized copy . . . of his work, whether by sale, gift, loan, or some rental or lease arrangement. Likewise, any unauthorized

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One requirement to receive copyright protection under the Act is that works must be "fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." *Id.* § 102(a). A computer file constitutes a sufficiently tangible medium of expression to fulfill the requirement for protection. *See ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447, 1453 (7th Cir. 1996) (concluding computer files are fixed in a tangible medium of expression).

208. 17 U.S.C. § 106. The other exclusive rights comprise: the right "to prepare derivative works based upon the copyrighted work"; the right "to perform the copyrighted work publicly"; and in the case of sound recordings, the right "to perform the copyrighted work publicly by means of a digital audio transmission." *Id.*

209. *See id.* § 106(1) (providing the owner of a copyright with exclusive rights to the reproduction of the copyrighted work).

210. *See Alcatel USA, Inc. v. DGI Techs., Inc.*, 166 F.3d 772, 787 n.54 (5th Cir. 1999) (citing 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.02[C], at 8-32 (1998)) (noting that copying a protected work results in a violation of the exclusive right of reproduction "even if it is used solely for the private purposes of the reproducer").

211. *See* 17 U.S.C. § 106(1) (stating the owner of the copyright has the exclusive right to reproduction of the work).

212. *Id.* § 106 (Historical and Statutory Notes).

213. *Id.*

public distribution of copies . . . that were unlawfully made would be an infringement.<sup>214</sup>

This right thus appears to be the federal analogue to the common-law right of first publication.<sup>215</sup> It allows an author to control the first publication, prohibiting unauthorized public distribution of copies.<sup>216</sup> Consistent with the common-law right of first publication, the Act further provides that the federal right of first publication ceases once the author has parted with ownership of the copy.<sup>217</sup>

Despite the seeming similarity between this federal right of first publication and the common-law right of first publication, the two rights are substantively distinct. Distributing a single copy of a work does not appear to constitute a publication under the federal right of first publication, whereas it would under the common-law right of first publication.<sup>218</sup> Distribution of a single copy, or even a few copies, would not likely be sufficient to constitute a protected “public distribution” under the federal right of first publication.<sup>219</sup> Statutory support for this interpretation of “public distribution” arises in the Act’s definition of “public display.” With respect to “public display,” the Act provides: “To perform or display a work ‘publicly’ means to perform or display it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social

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214. *Id.*

215. *Compare id.* (using the language “first public distribution”), with *Baker v. Libbie*, 91 N.E. 109, 112 (Mass. 1912) (holding that a letter author has a proprietary right to publication and commenting that publication means “making public through printing or multiplication of copies”).

216. 17 U.S.C. § 106 (Historical and Statutory Notes).

217. *See id.* § 109(a) (“Notwithstanding the provisions of section 106(3), the owner of a particular copy or phonorecord lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord.”); *id.* § 106 (Historical and Statutory Notes) (“[T]he copyright owner’s rights under section 106(3) . . . cease with respect to a particular copy or phonorecord once he has parted with ownership of it.”).

It is notable that the Act provides that publication does not occur when a person makes a public display of the work. *See id.* § 106(5) (giving the owner the right to publicly display the work in addition to the publication rights in § 106(3)). This is consistent with the common-law copyright rule that a letter recipient does not violate the right of first publication by showing the letter to friends or even by displaying it at a public place such as a library.

218. *Compare* 17 U.S.C. §§ 101, 106(3) (defining “publication” and the process of displaying a work “publicly”), with *Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 488 (1867) (“Publication by the author is circulation before the public eye by printing or multiplied copies in writing.”), *King v. King*, 168 P. 730, 731, 733 (Wyo. 1917) (stating an author of a work is entitled to withhold the work from the knowledge of the public), and *supra* Part II.A.2 (discussing the rights of first publication).

219. *See* 17 U.S.C. § 106(3) (stating the owner has exclusive rights “to distribute copies . . . to the public by sale or other transfer of ownership, or by rental, lease, or lending”).

acquaintances is gathered . . . .”<sup>220</sup> This definition suggests that the word “public” denotes “a substantial number of persons outside of a normal circle of a family and its social acquaintances.”<sup>221</sup> Accordingly, an email recipient who forwards the email to a few acquaintances does not appear to make a public distribution.<sup>222</sup> Likewise, an email sender who carbon copies a few acquaintances on an email does not appear to make a public distribution.<sup>223</sup> Thus, whereas the common-law right of first publication protects an email sender’s expression from distribution to even one third party, the federal right of first publication appears to apply only with respect to a distribution made *en masse*.<sup>224</sup>

The third enumerated right—the right to display a work publicly—extends protection beyond that provided by the common law.<sup>225</sup> This right provides an author the exclusive right to make a public display of the work,<sup>226</sup> where public display is defined to include a display “at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered.”<sup>227</sup> Whereas common-law copyright allows email or letter recipients to display the email or letter in a public forum such as a library,<sup>228</sup> federal copyright law precludes such a display.<sup>229</sup>

## 2. Fair Use Under the Copyright Act

Perhaps the greatest difference between common-law copyright and the Copyright Act is the fair-use doctrine.<sup>230</sup> Although fair use originates in the common law, the common law did not apply that defense where a work was unpublished.<sup>231</sup> The privacy protection that the common law secured an author under the right of first publication was not subject to

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220. *Id.* § 101.

221. *See id.* (containing both in § 101).

222. *See id.* (requiring a “substantial number”).

223. *See id.* (appearing to require more of a distribution by the use of the word “substantial”).

224. *See* sources cited *supra* note 218 (defining publication in both the federal right of first publication and the common-law right of first publication).

225. 17 U.S.C. § 106(5).

226. *Id.*

227. *Id.* § 101.

228. *See supra* Part II.B.2.a (noting that at least one federal circuit has held that recipients may “publicly” display a letter).

229. *See* 17 U.S.C. §§ 101, 106(5) (granting the owner the exclusive right to public display).

230. *See id.* § 107 (making certain types of use noninfringing).

231. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 549–52 (1985) (“[F]air use in the Copyright Act reflects the intent of Congress to codify the common-law doctrine. . . . [F]air use [under the common law] traditionally was not recognized as a defense to charges of copying from an author’s as yet unpublished works.”).

fair use.<sup>232</sup> Rather, common-law copyright established a nearly absolute bar against publication.<sup>233</sup> By contrast, the fair-use provision of the Copyright Act allows courts to determine that otherwise infringing uses of an author's unpublished work are permissible.<sup>234</sup> The Act provides a list of nonexhaustive criteria to assist courts in determining whether a use is permissibly fair:

(1) the purpose and character of the use, including whether such use is of a commercial nature . . . ; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.<sup>235</sup>

These criteria suggest that the fair-use defense would apply to casual email correspondence. With respect to the first factor, an email recipient often does not have a commercial purpose for forwarding casual email correspondence to a third party.<sup>236</sup> Often the purpose is noncommercial in that the recipient forwards the information to inform the third party about the sender's idea or expression, without profiting from distributing the material.<sup>237</sup> The recipient may also forward the email with a comment or criticism about the original sender's expression. The statute expressly cites comment and criticism as examples of purposes that would be presumptively fair.<sup>238</sup> Furthermore, the character of the use appears innocuous because email forwarding has become commonplace.<sup>239</sup> The common practice of email forwarding suggests

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232. *Id.*

233. *See supra* Part II.A.2 (noting that common-law copyright protects the author's interests of whether and when to publish the work).

234. 17 U.S.C. § 107.

235. *Id.*

236. *See id.* § 107(1). The Supreme Court has explained that the test for whether the use is of a commercial nature turns on "whether the user stands to profit from exploitation of the copyrighted material without paying the customary price." *Harper & Row*, 471 U.S. at 562.

237. An all too common email-forwarding phenomenon occurs where summer associates at legal and business firms express honest and harmful sentiments about their temporary employer. *See McGrath, supra* note 6, at 34. Recipients forward the sentiments to several persons, ostensibly not for a commercial purpose, and the email eventually becomes public knowledge. *See id.* For instance, one Harvard Law student inadvertently sent an email to law-firm employees which conveyed an attitude of indolence towards the work. *Id.* The email quickly became common knowledge, eventually appearing in *The New Yorker* magazine. *Id.* Other expressions forwarded without a commercial purpose, which eventually became public knowledge, include a summer associate's email about cocaine use occurring at a law firm and a new business associate's email about his sexual exploits on a business trip. *Id.*

238. 17 U.S.C. § 107.

239. *See* Grimmelmann, *supra* note 5 (describing the reasons that email forwarding has become a common occurrence).

that an email sender should expect that this outcome may result.<sup>240</sup> The first criterion favors fair use.

The second and third fair-use criteria disfavor the fair-use defense.<sup>241</sup> Regardless of the content or economic value of the work, the second criterion—the nature of the copyrighted work—always weighs against permitting the use where the work is unpublished.<sup>242</sup> With regard to the third fair-use criterion—the amount and substantiality of the portion used—the typical email that is forwarded includes the entire email that the sender expressed to the original recipient.

The fourth criterion—the effect of the use upon the potential market for or value of the copyrighted work<sup>243</sup>—is, according to the Supreme Court, the most important of the four listed fair-use criteria.<sup>244</sup> Applying this criterion to the email context reveals that it favors the fair-use defense. Although the email may be personally valuable to the sender, this fourth criterion examines economic value as determined in the public marketplace for expression.<sup>245</sup> Where email expresses casual correspondence, there is usually no market for the expression.<sup>246</sup> Market

240. See Mandel, *supra* note 6 (advising that email senders should expect this outcome).

241. See 17 U.S.C. § 107(2)–(3) (considering the nature of the copyrighted work and the amount copied).

242. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 564 (1985) (discussing second fair-use criterion and commenting that “the scope of fair use is narrower with respect to unpublished works”); *Norse v. Henry Holt & Co.*, 847 F. Supp. 142, 147 (N.D. Cal. 1994) (holding that fair use applied but noting that “[o]nly the second factor, the unpublished nature of plaintiff’s letters, favors plaintiff”).

243. 17 U.S.C. § 107(4).

244. See *Stewart v. Abend*, 495 U.S. 207, 238 (1990) (“The fourth factor is the ‘most important, and indeed, central fair use factor.’” (quoting 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 9.02 (1989))); *Harper & Row*, 471 U.S. at 566 (describing the fourth criterion as “the single most important element of fair use”); *accord Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 450 (1984) (analyzing fourth criterion and observing that the very “purpose of copyright is to create incentives for creative effort”).

245. See *Harper & Row*, 471 U.S. at 598 (contrasting the informational value of a work’s use under the second criterion with the economic harm of the use under the fourth criterion).

246. See *Hoyt v. Mackenzie*, 3 Barb. Ch. 320, 324 (N.Y. Ch. 1848) (“It is evident . . . the complainant never could have considered [the letters] as of any value whatever as literary productions. For a letter cannot be considered of value to the author, for the purpose of publication, which he never would consent to have published . . . .”); *accord Wetmore v. Scovell*, 3 Edw. Ch. 515, 528 (N.Y. Ch. 1842) (“[T]he court of chancery has [not] exercised the power of preventing a publication of private letters of business on the ground of copy-right or literary property, when they possess none of the attributes of literary compositions . . . .”). *But see Grigsby v. Breckinridge*, 65 Ky. (2 Bush) 480, 506–07 (1867) (Williams, J., dissenting) (recognizing that *Hoyt* and *Wetmore* are no longer controlling authority); *Woolsey v. Judd*, 11 How. Pr. 49, 73 (N.Y. Sup. Ct. 1855) (rejecting court decisions holding that private letters should not receive proprietary protection).

The view that there is no market for casual email correspondence does not hold true where the email sender is a public figure. See *Salinger v. Random House, Inc.*, 811 F.2d 90, 99 (2d Cir. 1987) (valuing author’s private letters at \$500,000).

value of personal correspondence is usually nonextant.<sup>247</sup> The lack of a potential market for personal email suggests an absence of economic harm, thereby implying that a recipient's forwarding use would be a fair use.<sup>248</sup>

Thus, where email is a casual correspondence with no economic value, a strong argument favors the defense of fair use. The following facts support its application: (1) the purpose of email forwarding is not commercial in nature; (2) the character of email forwarding appears innocuous given its common practice; and (3) there is no harmful economic impact resulting from email forwarding. Two of the four fair-use criteria, one of which is the most weighty of the four, suggest its application. Fair use likely excuses a recipient's forwarding of an email containing casual correspondence.<sup>249</sup> It thus appears that the Copyright Act falls short of protecting an email sender's interest in keeping email expression private, which the common law did so well for letter authors.

### B. *Caselaw and Legislative History of the Copyright Act*

The above statutory analysis suggests that the Copyright Act's fair-use provision likely strips an email recipient of any privacy protection.<sup>250</sup> Caselaw and legislative history dealing with unpublished works suggest that this conclusion is correct.<sup>251</sup> Initially, however, courts considering the Act's fair-use defense were reluctant to weaken the privacy protection that the common law had in the past afforded authors of unpublished works.<sup>252</sup> As this judicial reluctance became evident, Congress amended the Copyright Act so that it explicitly subjected

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247. See generally sources cited *supra* note 246 (noting distinctions between private letters and literary compositions).

248. See *Norse v. Henry Holt & Co.*, 847 F. Supp. 142, 147 (N.D. Cal. 1994) (determining that fourth fair-use criterion justified defendant's use of plaintiff's private letters on basis that "plaintiff ha[d] provided no evidence of a valuable market").

249. In the situation where an email contains expression that is economically valuable, fair use would not likely apply. For example, an unpublished manuscript of a soon-to-be best-selling novel that is printed in, or attached to, an email would merit as much copyright protection under the Act as if the unpublished manuscript had not been in an email form. See, e.g., *Harper & Row*, 471 U.S. at 561, 566-69 (refusing to apply fair use to soon-to-be-published manuscript). The first and fourth factors, which had favored fair-use application in casual correspondence, would in this situation disfavor fair use. *Id.* The economic value of such an email would be sufficient to preclude a fair-use defense.

250. See *supra* Part III.A.2.

251. See *infra* Part III.B.3 (discussing judicial response to the 1992 amendment of the Copyright Act that explicitly applied fair use to unpublished materials).

252. See *infra* Part III.B.1-2.

unpublished works to the fair-use defense.<sup>253</sup> Courts responded to that amendment by giving less weight to the fact that a work was unpublished when analyzing whether a use was fair.<sup>254</sup> Accordingly, courts now apply the Act so that an author's interest in keeping a work private does not provide a compelling reason to keep another party from publishing the work.<sup>255</sup> In general, publication must cause economic harm to the author before the Act protects the expression.<sup>256</sup> The Act trades common-law privacy for public utility. The subparts below describe this caselaw and legislative history.

### 1. Supreme Court Commentary in *Harper & Row*

Following the enactment of the Copyright Act, the Supreme Court considered whether the fair-use defense applied where a defendant, without authorization, published memoirs that the plaintiffs were preparing for publication.<sup>257</sup> In *Harper & Row, Publishers, Inc. v. Nation Enterprises*, the defendant, a magazine entitled *The Nation*, received a copy of former President Ford's soon-to-be-published memoirs, which contained significant details about his pardon of former President Nixon.<sup>258</sup> *The Nation* received that copy in secret, without obtaining authorization to possess, much less publish, its contents.<sup>259</sup> Mr. Ford had agreed to publish his memoirs with the plaintiffs, who had licensed *Time* magazine to publish excerpts prior to the plaintiffs' full publication of the memoirs.<sup>260</sup> A few weeks before *Time* published the excerpts, *The Nation* published selections of the memoirs.<sup>261</sup>

In considering the plaintiffs' claim of copyright infringement, the Supreme Court addressed the relationship between the Copyright Act and common-law copyright.<sup>262</sup> The Court recognized the absolute nature of an author's right of first publication under the common law.<sup>263</sup> The Court opined that "fair use traditionally was not recognized as a defense

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253. See *infra* Part III.B.3.

254. See *infra* Part III.B.3.

255. See *infra* Part III.B.3 (discussing judicial rules regarding fair use that disregarded the question of the author's privacy interest altogether).

256. See *infra* Part III.B.3 (discussing the emergence of "market effect" as the most important criterion in applying fair use).

257. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 542–43 (1985).

258. *Id.*

259. *Id.* at 543.

260. *Id.* at 542–43.

261. *Id.* at 543.

262. *Id.* at 549–52.

263. *Id.* at 550–51.



to charges of copying from an author's as yet unpublished works."<sup>264</sup> Fair use was not applied to unpublished works because, according to the Court, that defense "was predicated on the author's implied consent to 'reasonable and customary' use when he released his work for public consumption."<sup>265</sup> In the Court's words: "Under common-law copyright, 'the property of the author . . . in his intellectual creation [was] *absolute* until he voluntarily part[ed] with the same."<sup>266</sup> The Court further observed that an author voluntarily parts with the common-law property right of expression only when the author publishes the work, either through formal publication or "de facto" publication.<sup>267</sup>

After acknowledging the common-law privacy protection of unpublished works, the Court explained that the Copyright Act adopts that protection.<sup>268</sup> That adoption, the Court declared, is apparent from the fact that the Act recognizes a right of first publication.<sup>269</sup> The Court further recognized that the Act's fair-use provision does not "change, narrow, or enlarge" the scope of that defense as it had been applied (or rather *not* applied) to unpublished works under the common law.<sup>270</sup> The Court summed up its analysis with the following rule: "Under ordinary circumstances, the author's right to control the first public appearance of his undissemated expression will outweigh a claim of fair use."<sup>271</sup>

Despite this seeming brightline rule that the Court set forth with regards to unpublished works, the Court could not entirely ignore the Act's fair-use provision in view of the fact that the statute appeared to allow application of fair use as to all copyright rights, including the right of first publication.<sup>272</sup> The Court therefore proceeded to address the four

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264. *Id.*

265. *Id.*

266. *Id.* at 551 (quoting *Am. Tobacco Co. v. Werckmeister*, 207 U.S. 284, 299 (1907), *superseded by statute*, Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (current version at 17 U.S.C. §§ 101-1332 (2000))) (alterations in original) (emphasis added).

267. *Id.*

268. *Id.* at 552.

269. *Id.*

270. *Id.* at 554 (referencing H.R. REP. NO. 94-1476, at 66 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5680).

271. *Id.* at 555. The cited statement contrasts with a statement that the Court later made in the same *Harper & Row* opinion: the Court later stated that the fourth fair-use criterion—the market effect—was the "single most important element" in the fair-use analysis. *Id.* at 566. The seeming tension between these statements is enigmatic. It is possible that the Court viewed the fourth criterion as the single most important element where an author had already published, or was planning to publish, the work.

272. See 17 U.S.C. § 107 (2000) ("fair use of a copyrighted work"); *Harper & Row*, 471 U.S. at 560-69 (analyzing *The Nation's* fair-use argument).

specific fair-use criteria, noting “that the *scope* of fair use is narrower with respect to unpublished works.”<sup>273</sup>

All four fair-use criteria disfavored fair use.<sup>274</sup> Because *The Nation* had profited from publishing Mr. Ford’s memoirs, and because the rightful copyright holder intended to publish those memoirs, the Court held that *The Nation* had distributed the memoirs for a commercial purpose and had caused economic harm to the copyright holder.<sup>275</sup> Likewise, the unpublished nature of the work and the amount and substantiality of the memoirs that *The Nation* used also suggested that the use was not fair.<sup>276</sup> In determining that all four criteria disfavored fair use, the Court appeared to attach greatest weight to the second criterion—the nature of the work—as that criterion addressed the fact that the memoirs were unpublished.<sup>277</sup>

The language of *Harper & Row* thus indicates that the Court was attempting to uphold the privacy protection that the common law had afforded unpublished works.<sup>278</sup> While expressly acknowledging that common-law copyright exists to protect privacy, the *Harper & Row* Court treated the Act as a codification of the existing right of first publication under the common law.<sup>279</sup> Although the Court recognized that the Act allows for a fair-use defense, the Court was careful to point out that the Act does not “change, narrow, or enlarge” the fair-use doctrine with respect to unpublished works.<sup>280</sup> *Harper & Row* appears to be an attempt to uphold common-law privacy protection under the Copyright Act.<sup>281</sup>

## 2. Judicial Response to *Harper & Row*

After *Harper & Row*, federal courts of appeals began following the Supreme Court’s direction by refusing to apply the fair-use defense to

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273. *Harper & Row*, 471 U.S. at 564 (emphasis added).

274. *Id.* at 560–69.

275. *Id.* at 561–63, 566–69.

276. *Id.* at 564–66.

277. *Id.* at 564.

278. *See id.* at 550–51, 554 (“[F]air use traditionally was not recognized as a defense to charges of copying from an author’s as yet unpublished works. . . . It is true that common-law copyright was often enlisted in the service of personal privacy. . . . [The effect of the Copyright Act is to] preserve existing law concerning fair use of unpublished works . . . and not to ‘change, narrow, or enlarge it.’”).

279. *Id.* at 554 (referencing H.R. REP. NO. 94-1476, at 66 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5680).

280. *Id.*

281. *See supra* note 278 and accompanying text.

unpublished works.<sup>282</sup> In *Salinger v. Random House, Inc.*, the Second Circuit held that author J.D. Salinger could prohibit defendant Random House, Inc. from publishing a biography about Salinger which contained excerpts of Salinger's personal letters to various friends.<sup>283</sup> After viewing a draft of the biography, Salinger sought protection under the Copyright Act for the purpose of keeping the letters private.<sup>284</sup> The Second Circuit acknowledged that unlike the common law, the Act subjects an author's right of first publication to fair use.<sup>285</sup> Yet, according to the court, the scope of the fair-use defense as applied to unpublished works was rather limited in view of *Harper & Row*.<sup>286</sup> The court read *Harper & Row* to mean that "unpublished letters normally enjoy insulation from fair use copying."<sup>287</sup>

After opining on the strong protection afforded unpublished works, the *Salinger* court appeared to treat the fair-use test as a mere afterthought. Although the purpose of the defendants' use of the letters—criticism, scholarship, and research—suggested that the use was fair, this fact was not sufficient to overcome the unpublished nature of the letters.<sup>288</sup> As for the fourth fair-use criterion—the effect of the use on the potential market—the *Salinger* court faced the situation where the author disavowed any intent to publish his private letters.<sup>289</sup> Undeterred by Salinger's intent not to publish, the court proceeded to rely on the value of the letters that Salinger's agent had estimated, which undoubtedly was based on the fact that the letters were unpublished.<sup>290</sup> The fact that Salinger was a famous person, coupled with the fact that there existed a single copy of each letter, boosted the letters' value to

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282. *But see* *Wright v. Warner Books, Inc.*, 953 F.2d 731, 736, 740 (2d Cir. 1991) (applying fair use to publication of biography containing excerpts of decedent's private letters). The *Wright* court applied fair use arguably because courts appear less likely to protect an author's privacy interest where the author is deceased. *See* Kate O'Neill, *Against Dicta: A Legal Method for Rescuing Fair Use from the Right of First Publication*, 89 CAL. L. REV. 369, 392 (2001) (opining that the issue of whether an author is alive at the time of the use is a criterion for applying fair use).

283. 811 F.2d 90, 92–93, 99–100 (2d Cir. 1987).

284. *Id.* at 93–94.

285. *Id.* at 95.

286. *Id.* at 95, 97.

287. *Id.* at 95.

288. *Id.* at 96–97.

289. *Id.* at 99.

290. *Id.*; *see also* Kenneth D. Crews, *Fair Use of Unpublished Works: Burdens of Proof and the Integrity of Copyright*, 31 ARIZ. ST. L.J. 1, 20 (1999) (analyzing the alleged \$500,000 value on which the *Salinger* court relied). The strong protection that *Harper & Row* and *Salinger* offered authors of unpublished works led to widespread revision and in some instances cancellation of numerous works that utilized unpublished resources. *Id.* at 21.

\$500,000.<sup>291</sup> Because the value was so great, the fact that even a few potential consumers might be deterred from purchasing the expression was sufficient to find a harmful effect on the market, thereby favoring protection of Salinger's copyright.<sup>292</sup> The court construed the fourth fair-use criterion as favoring the copyright holder directly due to the fact that the work under consideration was unpublished.<sup>293</sup>

Two years after *Salinger*, the Second Circuit again heard a case involving a biographer's use of private letters in a biography.<sup>294</sup> In *New Era Publications International, ApS v. Henry Holt & Co.*, the Second Circuit cursorily reiterated its position that the unpublished nature of a work weighs heavily in favor of upholding a copyright.<sup>295</sup> *New Era* confirmed that absent extraordinary circumstances, an infringing use simply could not be fair if the work were unpublished.<sup>296</sup>

### 3. The 1992 Amendment to the Copyright Act

In response to the judicial trend of providing unpublished works near-absolute protection under the Copyright Act, Congress, in 1992, passed an amendment to the Copyright Act ("1992 Amendment").<sup>297</sup> The fair-use provision of the Act was amended to include the following sentence: "The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the [enumerated fair-use] factors."<sup>298</sup> The 1992 Amendment appears to constitute a congressional rejection of the idea that if a work were unpublished, an author would receive automatic protection absent extraordinarily compelling circumstances.<sup>299</sup> Expressly rejecting the strong protection *Salinger* provided unpublished works, the House Report to the 1992 Amendment notes the legislature's concern over the

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291. Crews, *supra* note 290, at 20.

292. *Salinger*, 811 F.2d at 99.

293. *Id.*; Crews, *supra* note 290, at 20.

294. *New Era Publ'ns Int'l ApS v. Henry Holt & Co.*, 873 F.2d 576 (2d Cir. 1989).

295. *Id.* at 583.

296. *Id.* Owing to a laches defense, the court did not grant the plaintiff relief. *Id.* at 584-85.

Another court following *Harper & Row* opined that the unpublished nature of letters merits full copyright protection, and that fair use "generally applies to materials already released by an author for public consumption." *Sinkler v. Goldsmith*, 623 F. Supp. 727, 732 (D. Ariz. 1985).

297. Fair Use of Unpublished Works, Pub. L. No. 102-492, 106 Stat. 3145 (codified as amended at 17 U.S.C. § 107 (2000)).

298. *Id.*

299. The legislative history indicates that Congress disapproved of the Second Circuit's interpretation of *Harper & Row* as establishing a per se rule protecting unpublished works from fair use. H.R. REP. NO. 102-836, at 4-9 (1992), *reprinted in* 1992 U.S.C.C.A.N. 2553, 2555-61.

Second Circuit's statement that unpublished works "normally enjoy complete protection against copying any protected expression."<sup>300</sup>

This reaction from the legislature was predictable. Popular culture values expression regardless of, and perhaps because of, its private nature.<sup>301</sup> Public access to private works benefits the masses at the cost of one individual's privacy. Representing the populace, Congress had an opportunity to maximize public benefit at a minimal cost. That a multitude gained utility where only one individual lost privacy was sufficient reason for Congress to undermine the centuries-old doctrine of the common-law right of first publication.

Subsequent to the 1992 Amendment, courts began rejecting the principle that unpublished works deserved near-absolute copyright protection.<sup>302</sup> In *Sundeman v. Seajay Society, Inc.*,<sup>303</sup> the Fourth Circuit considered whether fair use protected a defendant's dissemination of an author's unpublished manuscript.<sup>304</sup> After quoting the Supreme Court's language in *Harper & Row*, which stated that undissemintated expression outweighs a claim of fair use, the court opined that this Supreme Court mandate was overturned when Congress passed the 1992 Amendment.<sup>305</sup> Controlling the court's fair-use analysis was the fact that the copies were disseminated to only a few parties.<sup>306</sup> The dissemination did not detract from the commercial viability of the unpublished manuscript, but rather may have promoted commercial interest in the manuscript.<sup>307</sup> Commercial value dictated application of fair use.<sup>308</sup> Privacy was never mentioned, much less considered.<sup>309</sup>

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300. *Id.* at 8 (quoting *Salinger v. Random House, Inc.*, 811 F.2d 90, 97 (2d Cir. 1987)).

301. *See, e.g.*, Grimmelmann, *supra* note 5 (explaining public popularity of email correspondence intended to be private).

302. Also telling about the effect of the 1992 Amendment are those cases decided just after the Amendment's enactment, yet based on facts that occurred prior to its enactment. As the Amendment was not retroactive, those courts held that fair use did not apply to the unpublished works at issue. *See* *CSM Investors, Inc. v. Everest Dev., Ltd.*, 840 F. Supp. 1304, 1313 (D. Minn. 1994) (relying on *Harper & Row*'s statement that "the scope of fair use is narrower with respect to unpublished works" to find that fair use did not apply to unpublished architectural designs); *Lish v. Harper's Magazine Found.*, 807 F. Supp. 1090, 1101 n.10, 1104-05 (S.D.N.Y. 1992) (denying fair use for publication of private letters despite fact that the effect on the market favored fair use, but purporting that the Amendment's application would have made no difference in its decision).

303. 142 F.3d 194 (4th Cir. 1998).

304. *Id.* at 201.

305. *Id.* at 204-05.

306. *Id.* at 206-07.

307. *Id.* at 207.

308. *Id.* at 207-08.

309. *See id.* at 202 (failing to set forth privacy as a factor used to guide a court when deciding whether the fair-use doctrine applies).

In *Norse v. Henry Holt & Co.*,<sup>310</sup> another federal court relied on the Amendment to apply fair use to unpublished works.<sup>311</sup> On remand from the Ninth Circuit, a California district court considered whether to apply fair use where an author's embarrassing statements in his private letters appeared in a published book.<sup>312</sup> Twice referring to the 1992 Amendment, the court determined that the fair-use criteria overall favored labeling the defendant's publication as fair.<sup>313</sup> As for the purpose of the use, the book containing the private letters was a scholarly biography—albeit with commercial potential—and scholarship suggested a permissible use.<sup>314</sup> As for market effect, the court treated this factor as “the single most important element of fair use.”<sup>315</sup> The publisher's use of the letters, the court declared, would not have adversely affected the publication value to the author.<sup>316</sup> Moreover, in conjunction with this “most important” fair-use criterion, the court noted the absence of any market for the letters.<sup>317</sup> Fair use thereby deprived the author of his privacy.

Consistent with the above caselaw, the 1992 Amendment appears to preclude federal copyright protection for most email expression. The Amendment subjects unpublished works to the full force of fair use, and accordingly has led courts to ignore an author's privacy interest under prior copyright jurisprudence.<sup>318</sup> Where an email expression has no commercial value, the 1992 Amendment expressly places the expression outside the protection of federal copyright law. Simply put, the Copyright Act fails to protect email privacy.

### C. *Two Competing Interests Under One Copyright Theory*

The above discussion regarding caselaw interpretation of the 1992 Amendment portrays a conundrum that email presents under the Copyright Act. On the one hand, the Act purports to protect privacy

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310. 847 F. Supp. 142 (N.D. Cal. 1994).

311. *Id.* at 146–47.

312. *Id.* at 144.

313. *Id.* at 146–47.

314. *Id.* at 145.

315. *Id.* at 147 (internal quotations omitted).

316. *Id.*

317. *Id.*

318. See *Sundeman v. Seajay Soc'y, Inc.*, 142 F.3d 194, 208 (4th Cir. 1998) (holding that defendant's use of an unpublished manuscript was permissible under the fair-use exception); *Norse*, 847 F. Supp. at 142 (holding that defendant biographer was protected by fair-use defense after publishing author's private letters).

interests by providing a right of first publication.<sup>319</sup> Historically that right has existed for the purpose of allowing authors the opportunity to keep their works private.<sup>320</sup> Email falls within this category of copyright.<sup>321</sup> On the other hand, the Act represents an attempt to provide an optimal level of creative works for public consumption.<sup>322</sup> The Act engenders creative works by providing commercial incentive to produce them in the form of a production monopoly.<sup>323</sup> The Act further allows for unrestricted public access to creative works where the monopolistic commercial incentive is unnecessary.<sup>324</sup> Fair use provides this access,<sup>325</sup> and it is squarely at odds with an author's privacy interest.<sup>326</sup> A contradiction thus arises between the purposes of the Act.<sup>327</sup> Privacy protection under the right of first publication competes with public access under the fair-use doctrine.<sup>328</sup>

The tension between privacy protection and public access stems from a fundamental difference in philosophies of property. At the root of an author's right of first publication is the Lockean principle that labor results in absolute property.<sup>329</sup> According to John Locke, a laborer holds

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319. 17 U.S.C. § 106 (2000) (Historical and Statutory Notes).

320. Goldstein, *supra* note 70, at 1004; Warren & Brandeis, *supra* note 70, at 198–200, 204–05.

321. See *supra* Part II.A (discussing common-law privacy rights of email senders).

322. See Leval, *supra* note 88, at 1118–19 (characterizing the goal of the Copyright Act as the stimulation of authorship for public edification).

323. See *Eldred v. Ashcroft*, 537 U.S. 186, 227 n.4 (2003) (Stevens, J., dissenting) (“The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors. It is said that reward to the author or artist serves to induce release to the public of the products of his creative genius.” (internal quotations omitted)).

324. See Leval, *supra* note 88, at 1118–20 (opining that fair use should apply to works that copyright was not designed to stimulate).

325. 17 U.S.C. § 107 (2000).

326. See Crews, *supra* note 290, at 35–36 (“Legitimate privacy concerns should be analyzed directly and not be entangled with copyright law. Privacy is a serious right to be respected, but privacy law and copyright have conflicting objectives.” (footnote omitted)).

327. See *id.* at 36 (“Privacy secures confidential actions, thoughts, and writings; copyright, by contrast, seeks to promote the growth of knowledge through public dissemination of information.” (citing Diane L. Zimmerman, *Requiem for a Heavyweight: A Farewell to Warren and Brandeis’s Privacy Tort*, 68 CORNELL L. REV. 291, 292–93 (1983))).

328. See Note, *Personal Letters: In Need of a Law of Their Own*, 44 IOWA L. REV. 705, 715 (1959) [hereinafter *Personal Letters*] (arguing that copyright law does not adequately provide the proprietary protection necessary to secure privacy of personal correspondence on the basis that “the injury sustained by the unauthorized publication or dissemination of private letters is usually quite different from that arising from the piracy of an author’s literary work”).

329. See *Baker v. Libbie*, 97 N.E. 109, 111 (Mass. 1912) (“It is generally recognized that one has a right to the fruits of his labor . . . . The labor of composing letters for private and familiar correspondence may be trifling, or it may be severe, but it is none the less the result of an expenditure of thought and time.”); JOHN LOCKE, TWO TREATISES OF GOVERNMENT 306 (Peter Laslett ed., Cambridge Univ. Press 2d ed. 1967) (1690) (opining that property rights vest when a person exerts labor over a thing in a way that excludes the common right that others hold in the

absolute property rights in the product of his or her labor.<sup>330</sup> The absolute rights of property allow the laborer to control the uses of the product of his labor against all others.<sup>331</sup> In the email context, because the email expression results from the labor of the sender, according to Locke that expression would be a product over which the sender holds absolute property rights.<sup>332</sup> Locke's view suggests that an email sender has a right to control the product that results from the sender's effort to communicate an idea.<sup>333</sup> Maintaining privacy in an email expression is, under Lockean philosophy, a manifestation of the property-based control an email sender may exercise.

In contrast to the Lockean philosophy that is manifest in an author's right of first publication, the fair-use doctrine represents a completely different property philosophy. Fair use is a manifestation of a utilitarian view of property.<sup>334</sup> Under the utilitarian philosophy, property rights exist to increase society's net welfare.<sup>335</sup> Awarding an author a property right to mass produce an expression encourages authors to create works for public consumption, ultimately increasing social welfare.<sup>336</sup> Conversely, where works exist without a need for production incentives, the utilitarian theory posits that copyright law should not reward authors with property rights.<sup>337</sup> For such works, social welfare is greater without property rights bestowed on the authors. Fair use, then, is the means

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thing).

330. LOCKE, *supra* note 329, at 306.

331. *Id.*

332. *See id.* ("For this Labour being the unquestionable Property of the Labourer, no Man but he can have a right to [it] . . ."); *see also* Grigsby v. Breckinridge, 65 Ky. (2 Bush) 480, 485 (1867) (basing its holding that letters merit proprietary protection on the rationale that "[a] production of the mind is property in every essential sense in which a production of the hands is the producer's property"); *Baker*, 97 N.E. at 111 ("The basic principle on which the right of the author is sustained . . . is not their literary quality, but the fact that they are the product of labor.").

333. *See* sources cited *supra* note 332 (explaining that one who creates something has the right to control it).

334. *See* Leval, *supra* note 88, at 1107–10 (arguing that the goal of copyright is utilitarian in nature by furthering creation of works and providing exceptions, such as fair use, to promote this goal).

335. *See* Eldred v. Ashcroft, 537 U.S. 186, 212 n.18 (2003) (commenting on the Copyright Act, and noting that "the incentive to profit from the exploitation of copyrights will redound to the public benefit by resulting in the proliferation of knowledge." (quoting *Am. Geophysical Union v. Texaco Inc.*, 802 F. Supp. 1, 27 (S.D.N.Y. 1992), *aff'd* 60 F.3d 913 (2d Cir. 1994))); Leval, *supra* note 88, at 1109 ("The copyright law embodies a recognition that creative intellectual activity is vital to the well-being of society. It is a pragmatic measure by which society confers monopoly-exploitation benefits for a limited duration on authors and artists . . . in order to obtain for itself the intellectual and practical enrichment that results from creative endeavors.").

336. Leval, *supra* note 88, at 1109.

337. *See id.* at 1109–10 (discussing rationale for allowing fair use in light of the incentive that copyright provides for fostering creativity).



whereby courts may determine whether protecting an author's monopoly will benefit social welfare.<sup>338</sup> Privacy is unimportant in that determination.<sup>339</sup> Most important is the economic effect of the use, for that affects the author's incentive to produce the work.<sup>340</sup> Tellingly, many common-law courts noted a conclusion contrary to this economic-value criterion of fair use: those courts concluded that the absence of literary value should not affect legal protection of an author's right of first publication.<sup>341</sup>

Any privacy protection the Copyright Act purportedly offers appears to be incidental to the Act's utilitarian end. Application of the fair-use defense to unpublished private works, especially since the 1992 Amendment, has become the norm. Furthermore, it is apparent that the Act focuses on utilitarian principles at the expense of an author's privacy based on the Act's registration requirement. In order to obtain relief under the Act, an author must make the expression available for public inspection by registering it with the Copyright Office.<sup>342</sup> This registration requirement means that even if fair use did not apply to a casual email, the email sender's attempt to enforce privacy would in fact decrease that privacy.<sup>343</sup> As soon as the sender would register the email

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338. See *id.* at 1107–10 (commenting that fair use is consistent with the utilitarian focus of copyright law).

339. See discussion *supra* Part III.B.3 (“That a multitude gained utility where only one individual lost privacy was sufficient reason for Congress to undermine the centuries-old doctrine of the common-law right of first publication.”).

340. See discussion *supra* Part III.B.3 (“Commercial value dictated application of fair use.”).

341. *Folsom v. Marsh*, 9 F. Cas. 342, 346 (C.C.D. Mass. 1841) (No. 4901) (Story, J.) (“I hold, that the author of any letter or letters . . . whether they are literary compositions, or familiar letters, or letters of business, possess the sole and exclusive copyright therein . . . .”); *Baker v. Libbie*, 97 N.E. 109, 111 (Mass. 1912) (“The existence of a right in the author over his letters, even though private and without worth as literature, is established on principle and authority.”); *Woolsey v. Judd*, 11 How. Pr. 49, 63, 68 (N.Y. Sup. Ct. 1855) (commenting that “[e]very writing, in which words are so arranged as to convey the thoughts of the writer to the mind of a reader, is a literary composition” to support its holding that copyright applies to “private letters, although not intended to be published, and however familiar and trivial the subjects to which they relate”); *Gee v. Pritchard*, (1818) 36 Eng. Rep. 670, 675–76 (Ch.) (“It has been decided, fortunately for the welfare of society, that the writer of letters, though written without any purpose of profit, or any idea of literary property, possesses such a right of property in them, that they cannot be published without his consent, unless the purposes of justice, civil or criminal, require the publication.”); *accord* *Denis v. LeClerc*, 1 Mart. (o.s.) 297, 302 (Orleans 1811) (noting that “the right of publishing a letter remains exclusively in the writer” notwithstanding that the letter was “not written with a view to profit”).

342. See 17 U.S.C. § 411(a) (2000) (“[N]o action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made . . . .”); 17 U.S.C. § 705(a)–(b) (2000) (“The Register of Copyrights shall ensure that records of . . . registrations . . . shall be open to public inspection.”); *Tedder Boat Ramp Sys. v. Hillsborough County*, 54 F. Supp. 2d 1300, 1303 (M.D. Fla. 1999) (“[C]opyrights are available to the public for examination and viewing purposes.”).

343. See *Crews*, *supra* note 290, at 17 n.74 (commenting on the irony that arises when a

expression to bring suit, the expression would be available for public viewing.<sup>344</sup> The reason for this registration requirement appears to be that it facilitates public utility as an exchange for the author's copyright monopoly.<sup>345</sup> Simply stated, it furthers public benefit. Wholly utilitarian in nature, the registration requirement is completely at odds with protecting privacy interests.<sup>346</sup>

The Copyright Act thus appears to acknowledge the dual purposes of copyright protection without providing separate legal theories for each purpose. The two purposes compete: one purports to keep expression private; the other seeks to engender public consumption of expression.<sup>347</sup> The Act creates an appearance of serving the former purpose through its right of first publication,<sup>348</sup> but in reality the Act serves only the latter, as evidenced by its fair-use provision.<sup>349</sup> The coexistence of these two competing interests under the same legal theory is dubious.<sup>350</sup> Although this tension has arisen prior to the advent of email, its presence is more frequent and pronounced in the email context than in the occasional circumstance involving letters cited in a biography. As email forwarding abounds, the Act sacrifices email privacy for public access to expression.

#### *D. Resolution of the Privacy Conundrum*

The apparent conflict in the Copyright Act which seems to leave email expression without privacy protection may be resolvable. A strong argument supports the view that the Act does not preempt the common-law right of first publication.<sup>351</sup> The starting point for this argument begins with the starting point for the Copyright Act: the Constitution.<sup>352</sup>

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copyright holder interested in protecting privacy seeks to enforce protection by registering the private work); Leval, *supra* note 88, at 1130 (same).

344. See sources cited *supra* note 343.

345. An author need not register the work prior to the infringing act to invoke federal copyright protection. 17 U.S.C. § 411 (Historical and Statutory Notes). Registration must merely occur prior to bringing suit. *Id.*

346. See sources cited *supra* note 343.

347. See Crews, *supra* note 290, at 36 (stating privacy and "growth of knowledge through public dissemination" are conflicting objectives).

348. See 17 U.S.C. § 106(3) (2000) (giving copyright owners exclusive right to distribute copyrighted works).

349. See *id.* § 107 (allowing noncopyright owners to copy and distribute copyrighted works in certain circumstances).

350. See Crews, *supra* note 290, at 35–36 (arguing that privacy interests should not be protected under copyright law).

351. See *infra* Part III.D.1–2 (discussing congressional power to enact copyright laws under the Constitution and the common law).

352. See *infra* Part III.D.1 (discussing the powers and limitations of congressional copyright authority under the Constitution).

## 1. A Constitutional Challenge to the Scope of the Copyright Act

Congressional power to enact the Copyright Act stems from the Copyright and Patent Clause in the Constitution.<sup>353</sup> The Clause states that Congress has power to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>354</sup> The Clause is unmistakably utilitarian in nature.<sup>355</sup> It grants Congress power to legislate property rights that promote the *progress* of science and *useful* arts.<sup>356</sup> The words “progress” and “useful” suggest that the property rights granted by Congress must provide society some sort of utility.<sup>357</sup> Federal property rights encompass rights that progress societal understanding of science or that provide societal utility through arts.<sup>358</sup> A work falls within the scope of the Copyright and Patent Clause inasmuch as it progresses science or promotes usefulness, regardless of how minute the progress or use may be, how subjectively the progress or use may be measured, or how few members of society benefit from the progress or use.<sup>359</sup>

This apparent utilitarian purpose underlying the Copyright and Patent Clause implies that a right which fails to progress science or promote usefulness does not fall within the scope of that Clause.<sup>360</sup> Congress may legislate only those rights that promote the progress of science or the useful arts.<sup>361</sup> Any right that does otherwise is a right that

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353. See *Eldred v. Ashcroft*, 537 U.S. 186, 212 (2003) (describing the congressional authority to enact the Copyright Act under the Copyright and Patent Clause, and commenting that the Clause acts as “both a grant of power and a limitation”).

354. U.S. CONST. art. I, § 8, cl. 8.

355. See *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’”); Leval, *supra* note 88, at 1119 (describing the purpose of the Copyright and Patent Clause as furthering public illumination).

356. U.S. CONST. art. I, § 8, cl. 8.

357. See WEBSTER’S ENCYCLOPEDIA UNABRIDGED DICTIONARY OF THE ENGLISH LANGUAGE (1989) (defining “progress” to mean “gradual betterment; especially: the progressive development of humankind,” and “useful” to mean “capable of being put to use; especially: serviceable for an end or purpose”).

358. U.S. CONST. art. I, § 8, cl. 8.

359. See *Eldred v. Ashcroft*, 537 U.S. 186, 212 (2003) (“[I]t is generally for Congress, not the courts, to decide how best to pursue the Copyright Clause’s objectives.”).

360. See Leval, *supra* note 88, at 1119 (“Placing all unpublished private papers under lock and key, immune from any fair use, for periods of fifty to one hundred years, conflicts with the purposes of the copyright clause. Such a rule would use copyright to further secrecy and concealment instead of public illumination.”).

361. During a congressional hearing on whether fair use could apply to unpublished works,

Congress may not legislate under the Clause. The Constitution therefore appears to prevent Congress from creating rights that do not serve the utilitarian end of the Copyright and Patent Clause.<sup>362</sup>

This interpretation of the Copyright and Patent Clause is consistent with Supreme Court jurisprudence. Several Supreme Court Cases clearly portray the utilitarian focus of the Clause.<sup>363</sup> On two occasions the Court has described the “philosophy behind” the Clause as “the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors.”<sup>364</sup> Similarly, the Court has recognized that “the incentive to profit from the exploitation of copyrights will redound to the public benefit by resulting in the proliferation of knowledge.”<sup>365</sup> In no uncertain terms, the Court has recognized the end of the Copyright and Patent Clause as providing social benefit.<sup>366</sup> Indeed, serving the public good and advancing public

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Judge Pierre Leval of the federal district court for the Southern District of New York testified as follows: “Protecting the right of privacy [through copyright] does not promote the progress of science and the useful arts. To the contrary, it serves secrecy. The Constitution does not grant to Congress a power to pass tort laws for the protection of privacy.” *Fair Use and Unpublished Works: Joint Hearing on S. 2370 and H.R. 4263 Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary and the Subcomm. on Courts, Intellectual Prop., and the Admin. of Justice of the House Comm. on the Judiciary*, 101st Cong. 107 (1990); see also Crews, *supra* note 290, at 36 (agreeing with the previously cited statement of Judge Leval).

362. See *Eldred*, 537 U.S. at 212 (interpreting the Copyright and Patent Clause as “both a grant of power and a limitation”). Congress’s powers are limited to those enumerated in the Constitution. See *United States v. Morrison*, 529 U.S. 598, 607 (2000) (“Every law enacted by Congress must be based on one or more of its powers enumerated in the Constitution.”).

363. See, e.g., *Eldred*, 537 U.S. at 212 n.18 (“[E]ncouragement of individual effort by personal gain is the best way to advance public welfare.”); *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991) (stating the goal of copyright law is to “promote the Progress of Science and useful Arts.”); *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 8–9 (1966) (stating that Thomas Jefferson recognized the “social and economic rationale of the patent system”); *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (same as *Eldred*).

364. *Eldred*, 537 U.S. at 212 n.18 (emphasis added); *Mazer*, 374 U.S. at 219 (emphasis added).

365. *Eldred*, 537 U.S. at 212 n.18 (emphasis added) (internal quotations omitted).

366. See *Eldred*, 537 U.S. at 212 n.18 (“[A]s James Madison observed, in copyright the public good fully coincides with the claims of individuals. . . . [C]opyright law serves public ends by providing individuals with an incentive to pursue private ones.” (internal quotations omitted)); *Feist*, 499 U.S. at 349 (“The primary objective of copyright is not to reward the labor of authors, but ‘to promote the Progress of Science and useful Arts.’”). The Court has cited the writing of Thomas Jefferson for insight into the Copyright and Patent Clause as it applies to patents:

[Jefferson] rejected a natural-rights theory in intellectual property rights and clearly recognized the social and economic rationale of the patent system. The patent monopoly [and thereby the copyright monopoly] was not designed to secure to the inventor [and author] his natural right in his discoveries. Rather, it was a reward, an inducement, to bring forth new knowledge.

*Graham*, 383 U.S. at 8–9.

welfare is a utilitarian philosophy.<sup>367</sup> Supreme Court jurisprudence indicates that the Copyright and Patent Clause serves a utilitarian end.<sup>368</sup>

The Supreme Court has also recognized that the Clause's utilitarian end limits Congress's power.<sup>369</sup> In *Graham v. John Deere Co. of Kansas City*, the Court commented that the purpose of the Clause places a restriction on congressional power to create property rights.<sup>370</sup> The Court stated: "The Congress in the exercise of the patent power [and thereby the copyright power] may not overreach the restraints imposed by the stated constitutional purpose."<sup>371</sup> Although the Court considered the Clause's application to the patent system, Congress's patent power arises from the same Clause: the Court's comments regarding that Clause should apply in the copyright context as well. The purpose of the Copyright and Patent Clause—utilitarian public benefit—limits the rights that Congress can legislate.

This constitutional limitation severely restricts the federal right of first publication under the Copyright Act. Specifically, the right of first publication under the Act is valid only to the extent that it serves a utilitarian end. A utilitarian end exists only if there is a possibility that the author will publicly disseminate the work.<sup>372</sup> Absent the possibility of publication, there is no utilitarian end for the Act's right of first publication to further.<sup>373</sup> So from the time that the author contemplates publication through the time of actual publication, the Act's right of first publication protects the author's interest in realizing commercial gain from the work.<sup>374</sup> But prior to an author ever contemplating the possibility of publication, the Act's right of first publication furthers no utilitarian end.<sup>375</sup> In that situation, the federal right remains dormant. That is, where an author seeks to hold the work private, the right does not

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367. See discussion *supra* Part III.C (analyzing the tension between authors' rights to protection and the public benefit gained through access to information).

368. See cases cited *supra* note 363.

369. *Graham*, 383 U.S. at 5–6.

370. *Id.*; accord *Eldred*, 537 U.S. at 212 (quoting *Graham* as describing the Copyright and Patent Clause as "both a grant of power and a limitation").

371. *Graham*, 383 U.S. at 5–6.

372. See Leval, *supra* note 88, at 1119 (contrasting copyright coverage for works intended and not intended for publication in light of the scope of the Copyright and Patent Clause).

373. See *id.* at 1109–10 (explaining how an author's exploitation of a monopoly benefits the public good).

374. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 554–55 (1985) (discussing dichotomy between right of first publication's commercial-interest protection and right of first publication's privacy-interest protection); Leval, *supra* note 88, at 1120–21 (analyzing the state at which authors should receive copyright protection for yet-to-be-published works).

375. See *Harper & Row*, 471 U.S. at 554 (stating that the rationale for protecting works that the author had no intention to publish has focused on personal privacy).

serve a utilitarian end.<sup>376</sup> The author's interest in holding the work private implies the absence of a commercial interest, and therefore, the absence of a utilitarian purpose.<sup>377</sup> Thus, the purpose of the Copyright and Patent Clause—to further public utility—restricts the scope of the federal right of first publication. An author may invoke that right only when the author contemplates publishing a work.<sup>378</sup>

## 2. The Survival of Common-Law Copyright

The constitutional restriction on the federal right of first publication implies that the Copyright Act should not preempt the common-law copyright protection of an author's privacy interest. The Act provides that it preempts common-law rights "that are *equivalent* to any of the exclusive rights within the general scope of copyright as specified by section 106."<sup>379</sup> The right of first publication specified in § 106 of the Act is not "equivalent" to the common-law right of first publication.<sup>380</sup> The former serves utilitarian interests; the latter serves privacy interests. As stated above, the Constitution limits the property rights that Congress may create to those which serve a utilitarian purpose. Accordingly, the Act's right of first publication should not be construed as preempting a right that serves a contrary interest.

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376. See Leval, *supra* note 88, at 1118–19 ("The second [fair-use] factor should not turn solely, nor even primarily, on the published/unpublished dichotomy. At issue is the advancement of the utilitarian goal of copyright—to stimulate authorship for the public edification.").

377. See *id.* at 1116–19 (discussing historical treatment of writings not intended for publication).

378. The fact that the federal right of first publication under the Copyright Act is not violated by distributing a work to a few acquaintances is consistent with the utilitarian theory underlying federal copyright law. See discussion *supra* Part III.A.1 (discussing exclusive rights in the context of email). Consider the following example: A book editor makes a copy of a yet-to-be-published novel with the permission of the author, but then gives that copy to a friend without the author's permission. Infringement would lie under the common-law right of first publication, see discussion *supra* Part III.A.2 (noting that common-law copyright provides a nearly absolute bar against publication). It would not lie, however, under federal law. See discussion *supra* Part III.A.1 (noting that distribution of a single copy of the work does not appear to constitute a publication under federal copyright law). The number of persons to whom the editor distributed the copies was too minimal to constitute a public distribution sufficient to invoke the federal right. This is so because copies distributed to a *de minimis* number of third parties would not negatively affect the aggregate market for an author's work. See *On Davis v. Gap, Inc.*, 246 F.3d 152, 172 (2d Cir. 2001) ("The *de minimis* doctrine essentially provides that where unauthorized copying is sufficiently trivial, 'the law will not impose legal consequences.'"). The author's incentive to distribute the work to the public is preserved, so the utilitarian purpose of copyright does not warrant an infringement.

379. 17 U.S.C. § 301(a) (2000) (emphasis added).

380. See *supra* Part III.D.1 (discussing utilitarian policy of the Copyright Clause and its application to the Copyright Act).

If an author intends to withhold a work from ever being published, the Act's right of first publication would not apply in that situation.<sup>381</sup> The right effectively remains dormant.<sup>382</sup> The author has no commercial interest, so there is no possibility of public access, further implying that there is no invocation of the federal right of first publication.<sup>383</sup> Under the common law, however, the right of first publication would apply.<sup>384</sup> Where the author does not even contemplate publishing a work, the common law offers a right that protects expressive privacy.<sup>385</sup> Whereas the federal right of first publication lies dormant in the absence of an intent to publicly disseminate, the common-law right of first publication is at that point in full force.<sup>386</sup> The federal right protects an author from being scooped; the common-law right protects an author from being found out. The rights should not be construed as being "equivalent." There should be no preemption.<sup>387</sup>

Another reason that the Act should not be viewed as preempting the common law right of first publication is that it leads to an absurd outcome. Preemption of a right facilitating the privacy of a work effectively represents a means to strip away that right through the fair-use defense.<sup>388</sup> Because casual correspondence held private is by definition a work that has no potential economic value or market, it will never receive federal copyright protection.<sup>389</sup> The federal right of first publication, then, does not represent a "right" as to private works. It represents a deprivation of a right. If preempted, a common-law right that secures private expression would always be subject to the federal fair-use defense.<sup>390</sup> For authors of private works, the federal "right" would effectively represent the federal defense.<sup>391</sup> Preemption would not effect a right replacement, but rather a right deprivation.

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381. See *supra* Part III.D.1 (arguing that the apparent utilitarian purpose of the Copyright and Patent Clause implies that a right that does not progress science or the useful arts does not fall within the scope of the Clause).

382. See *supra* Part III.D.1.

383. See *supra* Part III.D.1 (arguing that the Constitution may prevent Congress from creating rights that do not serve the Copyright and Patent Clause's utilitarian ends).

384. See *supra* Parts II.A.1, III.D.1 (discussing common law protection of privacy).

385. See *supra* Parts II.A.1, III.D.1.

386. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 554–55 (1985) (comparing commercial-interest protection of the Copyright Act with privacy-interest protection of common-law copyright); *supra* Parts II.A.1, III.D.1.

387. See 17 U.S.C. § 301(a) (2000) (providing that "equivalent" rights are preempted).

388. See *supra* Part II.A.2 (discussing the common-law right of first publication).

389. See *supra* Part II.A.2.

390. See *supra* Part II.A.2.

391. See *supra* Part II.A.2.

The view that the Copyright Act should not preempt the common-law right of first publication is supported by portions of the Act's legislative history. The legislative history states: "[C]ommon law rights of 'privacy' . . . would remain unaffected [by the Copyright Act] as long as the causes of action contain elements, such as an invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement."<sup>392</sup> This statement is relevant in light of the privacy argument set forth by Warren and Brandeis in their article, *The Right to Privacy*, discussed above.<sup>393</sup> They argued that the common-law right of first publication represents a common-law right of privacy.<sup>394</sup> That this right has a copyright label does not detract from its function of protecting an author's interest in keeping expression private, they contended.<sup>395</sup> The right of first publication is, according to Warren and Brandeis, a right of privacy.<sup>396</sup> The congressional history of the Act, which recognizes that the Act does not extend to "rights of 'privacy,'"<sup>397</sup> contravenes preemption of the common-law right of first publication.

Interpreting the federal right of first publication under the Copyright Act as applying only to works *intended* to be published is consistent with the 1992 Amendment.<sup>398</sup> The fact that the Amendment subjects unpublished works to the fair-use defense is consistent with the view that the federal right of first publication protects an author's commercial interest only in an unpublished work that is yet to be published. To the extent that a work will be published, a fair-use analysis is appropriate to evaluate the utilitarian value of protecting the yet-to-be-published work.<sup>399</sup> That the work is not yet published may be a fact to consider in the fair-use analysis, but it should not be controlling.<sup>400</sup> Given that the work will eventually be published, the second criterion—the nature of the work—appears secondary to the fourth criterion—the effect of the

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392. H.R. REP. NO. 94-1476, at 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748. *But see* Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 554 (1985) (concluding that the effect of the Act is "to preserve existing law concerning fair use of unpublished works").

393. Warren & Brandeis, *supra* note 70, at 198–205.

394. *Id.* at 198–99, 204–05.

395. *Id.* at 204–05.

396. *Id.* at 205.

397. H.R. REP. NO. 94-1476, at 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5748.

398. Fair Use of Unpublished Works, Pub. L. No. 102-492, 106 Stat. 3145 (codified at 17 U.S.C. § 107 (2000)).

399. *See, e.g.,* Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 554–55 (1985) (analyzing fair-use defense as applied to a soon-to-be-published unpublished work).

400. *See* Leval, *supra* note 88, at 1118–19 (arguing that the fact that a work is unpublished should not affect the second fair-use criterion—the nature of the copyrighted work—as the Copyright Act concerns works intended for publication).



use on the potential market.<sup>401</sup> By lessening the weight that courts should attach to the unpublished nature of a work, the 1992 Amendment is consistent with interpreting the Act so that it does not preempt common-law protection of privacy.

It should be noted that the Copyright Act does preempt a portion of the common-law right of first publication. Recall that the common-law right of first publication comprises a two-step right: an author first has a right to decide *whether* to publish; if the author does decide to publish, the author next has a right to decide *when* to publish.<sup>402</sup> In this manner, the common-law right of first publication has protected a work up to the time of publication.<sup>403</sup> The first stage may be described as the right to refrain from publishing, and it is this stage in which the author seeks to maintain privacy.<sup>404</sup> The second stage represents the time between the decision to publish and the actual publication.<sup>405</sup> As discussed above, the author holds an interest in making the work commercial during this second stage.<sup>406</sup> This second stage in the right of first publication is therefore preempted.<sup>407</sup> Federal law governs from the point that an author decides to publish, regardless of when the publication actually occurs.

The argument that the Copyright Act does not preempt the entire common-law right of first publication is seemingly inconsistent with the Supreme Court decision in *Harper & Row*.<sup>408</sup> There the Court suggested that the Copyright Act preempts the common-law right of first publication, even the portion of that right that had been applied to protect privacy interests.<sup>409</sup> Yet the actual holding of *Harper & Row* does not require that that suggestion be valid. The issue in *Harper & Row* was whether *The Nation* had infringed the copyright holder's right of first publication by publishing memoirs that were scheduled to be published

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401. See *Harper & Row*, 471 U.S. at 566 (describing the fourth criterion as "the single most important element of fair use").

402. See *supra* Part II.A.2 (discussing the common-law right of first publication).

403. See *supra* Part II.A.2.

404. See *supra* Part II.A.2.

405. See *supra* Part II.A.2.

406. See *supra* Part II.A.2.

407. See 17 U.S.C. § 301(a) (2000) (preemption applies whether published or not).

408. See *supra* Part III.B.1 (discussing *Harper & Row*).

409. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 552–55 (1985) (commenting that the Copyright Act "eliminated publication as a 'dividing line between common law and statutory protection,' extending statutory protection to all works from the time of their creation," and discussing common-law copyright protection of privacy while discussing the scope of the Act (quoting H.R. REP. NO. 94-1476, at 52 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5665)).

at a later date.<sup>410</sup> Key is the fact that the copyright holder had already decided to publish the memoirs.<sup>411</sup> As discussed in the paragraph above, the Act does preempt the common-law right of first publication with regard to works that are set to be published, although they in fact are not published. This means that the Act preempted the common-law right protecting the memoirs at issue in *Harper & Row*, for the author had already decided to publish them.<sup>412</sup> The *Harper & Row* Court's language suggesting that the Act preempts common-law protection of privacy<sup>413</sup> was therefore not relevant to the issue under consideration. The facts suggested that preemption applied with regard to an author's commercial interest in a yet-to-be-published work,<sup>414</sup> so the troublesome language was dicta.

Also relevant in analyzing *Harper & Row*'s language regarding preemption is the fact that the 1992 Amendment appears to undermine that language.<sup>415</sup> To the extent the *Harper & Row* Court attempted to hold that the Copyright Act adopted the privacy protection of common-law copyright, Congress appears to have abolished that holding through the 1992 Amendment.<sup>416</sup> The Amendment weakens *Harper & Row*'s representation that the Act protects privacy, and consequently, the Amendment also weakens *Harper & Row*'s representation that the Act preempts common-law privacy protection. In conjunction with the 1992 Amendment, the law set forth in *Harper & Row* is consistent with the argument that the Copyright Act does not preempt the common-law right of first publication.

This argument against federal preemption of common-law copyright raises interesting implications in the email context. As described in Part II, common-law principles imply the following: (1) a private email may not be forwarded by its recipient, regardless of how casual or trite the correspondence;<sup>417</sup> (2) protection for private expression is nearly absolute;<sup>418</sup> and (3) fair use is not in play.<sup>419</sup> The common-law rule of

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410. *Id.* at 541–42, 552–55.

411. *See id.* at 542–43 (discussing plans for publication).

412. *Id.*

413. *See supra* note 409 for a description of the Court's comments that suggest the Copyright Act preempts the common-law protection of privacy.

414. *Harper & Row*, 471 U.S. at 554.

415. *See supra* Part III.B.3 (discussing the 1992 Amendment).

416. *See supra* note 318 and accompanying text.

417. *See supra* Part II.A.2.a.

418. *See supra* Part II.A.2 (discussing the common-law right of first publication).

419. *See Harper & Row*, 471 U.S. at 549–51 (“[F]air use [under the common law] traditionally was not recognized as a defense to charges of copying from an author's as yet unpublished works.”); *see also supra* Part II.A.2 (“The fact that an unauthorized copy may appear ‘reasonable and

relinquishment further implies that if an email sender relinquishes his or her common-law right of first publication by publishing the email, federal law applies.<sup>420</sup> This means that if the sender were to carbon copy a third party, the sender would not be able to invoke the common law to protect an otherwise private email.<sup>421</sup> By carbon copying a third party, the sender would publish the email, and thereby waive the common-law right of first publication.<sup>422</sup> The sender would forego common-law protection of privacy. Any property interest in the expression would exist only under the federal Copyright Act. As discussed above, federal protection would be nonextant if the email correspondence were not economically valuable: the sender would be stripped of privacy protection by the fair-use defense.<sup>423</sup> Thus, the common-law right of first publication governs only to the extent that an email sender has not carbon copied a third party on the email.

#### IV. A NORMATIVE ANALYSIS OF A DUAL COPYRIGHT SYSTEM

The above discussion has presented a theory for protecting privacy interests in expression.<sup>424</sup> That theory is to bifurcate an author's right of first publication between the common law and federal law according to whether an author has affirmatively decided to publish the work.<sup>425</sup> Works that are held private fall under common-law copyright; works that will be published fall under federal copyright law.<sup>426</sup> This is possible because of a constitutional basis for concluding that the Copyright Act does not preempt common-law protection of privacy in expression.<sup>427</sup>

Although this theory of a dual copyright system may be theoretically plausible, the question of whether this theory can and should be put into practice is another matter. A normative analysis of the theory is

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customary' does not affect the strength of the author's common-law right [of first publication].").

420. See *supra* Part II.A.2.c (discussing the common-law rule of relinquishment).

421. See *supra* Part II.A.2.c ("Common-law copyright rules . . . suggest that an email sender relinquishes the right of first publication when the sender includes a carbon-copy or blind-carbon-copy recipient in the email.").

422. See *supra* Part II.A.2.c.

423. See *supra* Part III.A–B (concluding that "where an email expression has no commercial value, the 1992 Amendment expressly places the expression outside the protection of federal copyright law").

424. See *supra* Part III.D.

425. See *supra* Part III.D.

426. See *supra* Part III.D.

427. See *supra* Part III.D (arguing that the wording of the Constitution's Copyright and Patent Clause makes it "unmistakably utilitarian in nature," limiting Congress's power to legislate such property rights to the extent an author has an interest in realizing commercial gain).

necessary to evaluate whether both a common-law and federal system of copyright should govern property rights in expression.<sup>428</sup>

*A. Determination of the Applicable Copyright System*

The first issue that arises in evaluating the dual copyright system is the pragmatic problem of how to determine whether an author has decided to publish a work.<sup>429</sup> If the author has decided to publish a yet unpublished work, it may be difficult, if not impossible, to verify that alleged decision. Believing that the common law provides a stronger basis for prevailing against an infringer than does the Copyright Act, the author might recant his or her past decision to publish. For a defendant, establishing an author's state of mind regarding the finality of a publication decision raises a thorny issue of fact. Excessive resources would be necessary to prove that the decision to publish has been made. The practical barrier in reaching a determination of whether an author has decided to publish arguably poses a pragmatic threat to the proffered interpretation of the Copyright Act.

This practical barrier is resolvable by applying a simple rule: the author should be able to choose which law applies. It is true that by allowing a copyright holder to choose between the federal and common-law copyright systems, the copyright holder will always have the option of choosing a system with near-absolute protection over a system that allows for a liberal fair-use defense.<sup>430</sup> Yet the disparity of remedies under the two systems balances their disparity of expressive protection available to the author. The remedies available under common-law copyright would be an injunction against publication and compensatory damages.<sup>431</sup> Compensatory damages would lie only if the author could establish emotional harm for invading expressive privacy.<sup>432</sup> They would not lie for any decrease in the expression's market value. As a result, the

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428. See *infra* Part IV.A–C.

429. See Leval, *supra* note 88, at 1120–21 (discussing factual intricacies that might arise in attempting to distinguish between works created for publication and works held private).

430. An author could nearly always prevail on a copyright claim under common-law copyright given its near-absolute protection of privacy interests. See *supra* Part II.A.2 (discussing the common-law right of first publication). By contrast, an author would be subject to a liberal application of the fair-use defense. See *supra* Part III.A.2–B (describing the fair-use doctrine, and discussing applicable caselaw and legislative history).

431. See *Baker v. Libbie*, 97 N.E. 109, 112 (Mass. 1912) (issuing injunction against publication of letters); *Personal Letters*, *supra* note 328, at 708 n.31 (considering possible relief that common-law copyright affords author).

432. See *Personal Letters*, *supra* note 328, at 708 n.31 (“[I]t would seem that if damages have been sustained a remedy at law exists.”).

near-absolute protection available under the common law would only be valuable to an author who is concerned with the privacy of the work. Federal copyright law, on the other hand, provides remedies that are not available under the common law: compensatory damages may be awarded for the commercial value of the copyrighted expression, along with statutory damages.<sup>433</sup> The Copyright Act would therefore be valuable to an author who is concerned with realizing the commercial potential of the work. The remedies available under common-law or federal copyright reflect the respective interests of either privacy or commercial gain that an author may hold in the work.

If an author of an unpublished work chooses which law should control the suit, the author will select the law corresponding to the remedy that best serves the author's interest. The author will accordingly demonstrate the interest—privacy or commercial gain—that the author values. Where an author is concerned with keeping a work private, the author will bring suit under the common law. Where an author is concerned with realizing the commercial value of the work, the author will bring suit under federal law. There would be no thorny issue of fact.

A few examples illustrate the mechanics of a dual system of copyright. An email that is a casual correspondence—for instance, a simple invitation to lunch—may be the subject matter of an injunction against the email recipient. The email sender may enjoin the recipient from forwarding the simple expression in the email.<sup>434</sup> If the recipient has already forwarded the email, the sender may sue for damages. Assuming the lunch-invitation expression is not of an embarrassing nature, the sender would not be able to establish emotional harm caused by the recipient's forwarding of the email.<sup>435</sup> If, however, the email were of an embarrassing nature, compensatory damages would be available. For instance, perhaps an employee sends an email to another employee complaining of horrific work conditions. If the recipient forwards the email to the sender's employer, emotional harm would likely ensue. The embarrassment of the exposure would invade the sender's privacy, and potentially result in the termination of the sender's employment.

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433. 17 U.S.C. § 504(a)–(c) (2000). If infringement is willful, \$150,000 may be awarded as statutory damages; otherwise the maximum statutory damages amount is \$30,000. *Id.*

434. It seems unlikely that any sender would expend resources necessary to enjoin a recipient from forwarding such a seemingly innocuous email as an invitation to lunch. But perhaps the sender was an employee who sent the email to a competitor of the employer; or perhaps the sender was a spouse sending the email to a lover. Circumstances surrounding the expression may provide an impetus to seek protection against email forwarding.

435. Only nominal damages would lie.

Compensatory damages would lie for the emotional harm caused by the copyright violation.

Examples of copyright protection for email under the federal system are less apparent. Email is rarely sent with an intent to publish commercially. But it is possible that circumstances could change so that the sender would later decide to realize commercial gain by publishing the email. A good example is Monica Lewinsky's email regarding her relationship with former President Clinton.<sup>436</sup> At the time she sent it, the email was most assuredly held private.<sup>437</sup> But as events unfolded,<sup>438</sup> she could have sought to capitalize on the expression in the email. Her publication decision could have arisen subsequent to sending the email. This decision would have implied that the market value of the email outweighed the value of the emotional harm that Ms. Lewinsky would have incurred from its public exposure.<sup>439</sup> When *Newsweek* magazine published that email, Ms. Lewinsky could have brought suit under the Copyright Act for violating her federal right of first publication.<sup>440</sup> It is arguable that Ms. Lewinsky would prevail on liability.<sup>441</sup> Assuming she did, damages would be available to compensate Ms. Lewinsky for the market value of the email publication. There would be no damages for any emotional harm that *Newsweek's* publication caused her.

Thus, the seeming pragmatic difficulty of determining whether an author has decided to publish may not present any difficulty at all. If an author of an unpublished work has an option to decide whether to bring

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436. See Crews, *supra* note 290, at 32 n.162 (postulating that Ms. Lewinsky's email messages could merit copyright protection).

437. See *id.* (citing *He Could Have Called Me*, NEWSWEEK, Feb. 23, 1998, at 26–27 (printing excerpts from Ms. Lewinsky's emails)).

438. Mark Ribbing, *Events Leading to Clinton's Grand Jury Appearance*, THE BALTIMORE SUN, Aug. 16, 1998, at A4.

439. Assuming that the publication decision arose after the Ken Starr report, the emotional harm resulting from publication of the specific email expressions would have been negligible because the public already knew the details of her affair. See *In Graphic Detail, Report Says Clinton Lied About Affair*, THE ST. LOUIS POST-DISPATCH, Sept. 12, 1998, at A15 (describing the Starr report as giving "dense, at times unsettling, detail about a long-running series of sexual encounters between Clinton and Lewinsky"); *Referral to the United States House of Representatives pursuant to Title 28, United States Code, § 595(c) Submitted by The Office of the Independent Counsel, September 9, 1998*, <http://www.washingtonpost.com/wp-srv/politics/special/clinton/icreport/srprintable.htm> (last visited Jan. 10, 2007) (Kenneth Starr's final report on President Clinton to the U.S. House of Representatives narrating the nature and circumstances of Clinton's relationship with Monica Lewinsky).

440. See Crews, *supra* note 290, at 32 n.162 (discussing possible copyright infringement by *Newsweek* magazine).

441. The argument that Ms. Lewinsky would prevail is based on the fact that courts are reluctant to find fair use based solely on a freedom-of-the-press argument. See, e.g., *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 545–46, 560 (1985) (rejecting appellate court's reasoning that freedom of the press justified finding of fair use).

suit under the common law or under federal law, the author will select the system that best protects the interest which the author values in the work—privacy or commercial gain. The mutually-exclusive nature of those interests precludes overlap.<sup>442</sup> Available remedies under the two different systems will result in the author self-selecting the actual interest that the author values most.

*B. The Merits of a Distinct Copyright System for Privacy*

The reason for having both federal and common-law systems of copyright is to provide a balance between the two competing interests of societal utility and individual privacy.<sup>443</sup> Yet the fact that a balance is possible does not mean that it is desirable.<sup>444</sup> A more fundamental issue than whether the law *does* allow for the coexistence of both privacy and utilitarian interests in expression is whether the law *should* allow for that coexistence.<sup>445</sup> There are obvious drawbacks to a distinct copyright system, the purpose of which is to ensure privacy. To begin with, effectuating common-law copyright will likely breed more litigation than common-law copyright has in the past entertained. In the past, situations for protecting privacy interests in unpublished works arose relatively infrequently, usually over private letters that biographers or divorced spouses sought to publish.<sup>446</sup> Copying and distributing a private letter was not common.<sup>447</sup> Today the situation is markedly different.<sup>448</sup> Email forwarding has become routine.<sup>449</sup> If a sender lacks discretion in drafting

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442. See *supra* Part III.C (discussing the competing interests under the Copyright Act).

443. See *supra* Part III.C–D (offering resolution to the competing-interest dilemma).

444. See, e.g., Edward C. Baig et al., *Privacy: The Internet Wants Your Personal Info. What's in It for You?*, BUS. WK., Apr. 5, 1999, at 84 (commenting on internet privacy and observing that users “already have zero privacy” and so they should simply “[g]et over it”).

445. See AMITAI ETZIONI, *THE LIMITS OF PRIVACY* 214 (1999) (arguing against legalizing privacy rights on the basis that “publicness reduces the need for public control, while excessive privacy often necessitates state-imposed limits on private choices” (internal endnote omitted)); Richard A. Posner, *The Right of Privacy*, 12 GA. L. REV. 393, 395–97 (1978) (arguing against the concept of privacy offered by Warren and Brandeis—an interest in being let alone—on the grounds that privacy serves merely to protect from, or capitalize on, imperfect market information).

446. See, e.g., *Salinger v. Random House, Inc.*, 811 F.2d 90, 92–94 (2d Cir. 1987) (contemplating circumstance of biographer seeking to avoid letter publication); *King v. King*, 168 P. 730, 731–33 (Wyo. 1917) (contemplating circumstance of former spouse publishing letter).

447. See Grimmelmann, *supra* note 5 (“[G]oing from paper to bits lowers the cost of copying and forwarding. It takes a pretty important letter to be worth the bother of Xeroxing, stamping, and mailing, but even an infinitesimally small benefit is worth the minimal cost of clicking on the forward button and typing in a few addresses.”).

448. See *id.* (recounting an illustration of today’s situation).

449. See *id.* (“People who wouldn’t have forwarded a letter will forward an email—and they’ll forward it to more people. . . . Quasi-private emails leak out *all the time* now, not because we want

an email, the sender's words will likely be seen by many more than the original recipient.<sup>450</sup> Allowing a cause of action for email forwarding is a recipe for liability based on happenstance. A litigious society will exploit the opportunity to hold liable unsuspecting email recipients who happen to forward expression.

It also seems foolish to create a cause of action where the emotional harm to the email sender is caused, in large part, by the sender's own indiscretion. If a sender desires to keep a sentiment private, the sender should have omitted it while drafting the email. Just as a cheating husband one-hundred years ago should have thought twice before putting incriminating evidence in a letter to his lover,<sup>451</sup> so also should today's email senders think through indiscrete expressions before knowingly creating an electronic record that can so easily be distributed to the world.<sup>452</sup> The very fact that the sender chooses to use email suggests that the sender assumes a risk that the expression might be forwarded to others.<sup>453</sup> A legal remedy caused by a complainant's own indiscrete behavior seems unnecessary, if not wasteful.<sup>454</sup>

These two criticisms admittedly have strength. But they do not overturn the argument for applying common-law copyright to email expression. The benefit of protecting private expression outweighs its cost of creating a cause of action that will give rise to seemingly needless litigation that results in part from a plaintiff's own seemingly irresponsible actions. Protecting private expression from unauthorized distribution facilitates creativity, frankness, and efficiency.<sup>455</sup> Absent protection, an author must guard against an unknown recipient eventually obtaining a copy of the expression: such guarding imposes a cost on

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what is private to become public, but because it has become so hard to tell private from public in the context of email.”).

450. *Id.*

451. *See* Barrett v. Fish, 47 A. 174, 175–76 (Vt. 1899) (providing account of a party seeking to use such letters in criminal adultery proceedings).

452. *See* Mandel, *supra* note 6 (advising that email senders should restrict their expression to that which the senders would be comfortable viewing on “the front page of [their] newspaper”).

453. *See* Grimmelmann, *supra* note 5 (“The median email is less private and more public in its content than the median letter, not because our words care whether they travel by ink or by bits, but because we have evolved a set of expectations about email that are less private and more public than our expectations about traditional letters.”).

454. *Cf.* Neighbarger v. Irwin Indus., Inc., 882 P.2d 347, 351 (Cal. 1994) (“[T]he doctrine of assumption of risk properly bars a plaintiff's claim only when it can be established that, because of the nature of the activity involved and the parties' relationship to the activity, the defendant owed the plaintiff no duty of care.” (citing Knight v. Jewett, 834 P.2d 696, 707–08 (Cal. 1992))).

455. *See* Woolsey v. Judd, 11 How. Pr. 49, 63 (N.Y. Sup. Ct. 1855) (“[L]etters never intended to be published, and written on familiar subjects, are usually more *interesting and valuable* than those elaborately written and originally intended for the press.”); Mandel, *supra* note 6 (advising restraint in email expression).



expressive clarity and substance.<sup>456</sup> Privacy protection ensures effective communication of thought.<sup>457</sup>

Even assuming that the policy argument supporting privacy were no stronger than the policy argument for decreasing excessive, wasteful litigation, the alleged costs of securing privacy are doubtful. Excessive, needless litigation would not likely result. As discussed above, the primary remedies available under common-law copyright would be either an injunction preventing the recipient from forwarding the email or compensation for emotional harm.<sup>458</sup> These remedies suggest that the likelihood is fairly low that email senders would flood courts with frivolous email-forwarding disputes: attorneys' fees for enjoining a recipient from forwarding an innocuous lunch-invitation email would practically bar suit, and proving emotional harm over such an email would be more than difficult, if not impossible. Yet even if courts were flooded, the flooding would be both warranted and temporary. Privacy of expression—no matter how trite the expression—merits protection.<sup>459</sup> And as courts recognize this protection, public behavior regarding email will change. The now-common practice of forwarding emails would adjust so that email recipients would only forward them with permission. This adjustment would thereby strengthen an email sender's ability to engage in frank and creative expression. Litigation would not be excessive or wasteful.

## V. CONCLUSION

Alive and well is the centuries-old argument for protecting privacy of expression.<sup>460</sup> Today that argument is especially important given the

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456. See Grimmelmann, *supra* note 5 (commenting that email forwarding dulls the content and context of email expression).

457. This protection is not absolute. As discussed in Part II.B.2, *supra*, the property rights of an email sender are subject to the property rights that an email recipient holds in the physical email file, and those rights of the recipient allow the recipient to show the sender's expression to third parties. Similarly, as discussed in Part II.A, *supra*, the sender's rights are qualified under extraordinary circumstances which would permit a third party to publish the sender's expression.

458. See *supra* Part IV.A (comparing remedies available under common-law and federal copyright systems).

459. See *Woolsey*, 11 How. Pr. at 63 (opining that property rights exist in private letters "however familiar and trivial" the expression may be).

460. See, e.g., Teresa De Turris, *Copyright Protection of Privacy Interests in Unpublished Works*, 1994 ANN. SURV. AM. L. 277, 307 (1994) ("Protection of privacy interests in unpublished works is reasonably within the domain of federal copyright law."); Stephen B. Thau, *Copyright, Privacy, and Fair Use*, 24 HOFSTRA L. REV. 179, 202 (1995) (arguing that courts "protect an author's privacy by giving him the ability to control the reproduction and dissemination of works that can be viewed as extensions of his personality"); Benjamin Ely Marks, Note, *Copyright*

common practice of email recipients exploiting email senders' privacy.<sup>461</sup> The argument stems from the common-law right of first publication.<sup>462</sup> That right allows an email sender to decide whether to publish the expression in an email to someone other than the intended recipient.<sup>463</sup> Only the sender may decide whether to copy and distribute the email expression.<sup>464</sup> If the sender does so, often by carbon copying a third party, the sender relinquishes the right of first publication.<sup>465</sup> If the sender does not, the email recipient may not forward the email.<sup>466</sup> This protection of a sender's private expression admits few exceptions.<sup>467</sup>

In contrast to the common-law right of first publication that an email sender holds in email expression, email recipients hold property rights to the physical email file.<sup>468</sup> These property rights derive from the common law's recognition that a letter recipient holds property rights in the physical components of the letter.<sup>469</sup> By holding property rights to the physical email file, the recipient may transfer the file to a third party, which involves either transferring the storage device on which the file exists or transferring access rights to view the file through an email-website service.<sup>470</sup> The email recipient may also print and display the email at any location.<sup>471</sup> Finally, it is noteworthy that unintended recipients who receive email do not hold property rights to the email against the sender.<sup>472</sup>

Federal law should not be construed to strip an email sender of this common-law privacy protection.<sup>473</sup> Although the Copyright Act purports to provide authors a right of first publication, that right provides limited

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*Protection, Privacy Rights, and the Fair Use Doctrine: The Post-Salinger Decade Reconsidered*, 72 N.Y.U. L. REV. 1376, 1379 (1997) (proposing "an explicit, privacy-based exception to the fair use doctrine"). See generally Robert C. Hauhart, *Copyrighting Personal Letters, Diaries, and Memorabilia: A Review and a Suggestion*, 13 U. BALT. L. REV. 244, 244-45 (1984) (arguing for stronger protection of private expression).

461. See Grimmelmann, *supra* note 5 (observing that email forwarding has become commonplace).

462. See *supra* Part II.A.2.

463. See *supra* Part II.A.2.

464. See *supra* Part II.A.2 (stating that authors can decide *whether* and *when* to publish their work).

465. See *supra* Part II.A.2.c.

466. See *supra* Part II.A.2.c.

467. See *supra* Part II.A.2.

468. See *supra* Part II.B.

469. See *supra* Part II.B.

470. See *supra* Part II.B.1.

471. See *supra* Part II.B.2.

472. See *supra* Part II.B.3.

473. See *supra* Part III.

to no privacy protection in view of the liberal fair-use defense.<sup>474</sup> The Supreme Court initially attempted to extend federal copyright law to protect privacy interests in unpublished works, but Congress amended the Act to cripple the Court's attempt.<sup>475</sup> The Act protects authors' commercial interest to further its utilitarian purpose.<sup>476</sup> It does not protect privacy.<sup>477</sup> The absence of federal privacy protection, however, is not fatal to an author's privacy interest.<sup>478</sup> The Copyright and Patent Clause in the Constitution requires the Act to have a utilitarian purpose, which is mutually exclusive of a purpose that protects individual privacy.<sup>479</sup> Therefore, the federal right of first publication cannot be interpreted as preempting the common-law copyright's protection of privacy.<sup>480</sup> The common-law right of first publication that protects an author's decision whether to publish is a right that survives the Copyright Act.<sup>481</sup> Preemption does not apply.<sup>482</sup>

The normative argument in support of having both federal and common-law copyright systems is simple.<sup>483</sup> Two copyright systems are necessary because the purpose of federal copyright law—utilitarian public benefit—forecloses the opportunity to realize any privacy protection.<sup>484</sup> Privacy is a worthy end because it fosters creativity, frankness, and efficiency in communication.<sup>485</sup> Furthermore, enforcing two systems to further their two distinct ends is pragmatically possible: email senders will self-select which system serves the interest they most value, commercial gain or privacy, based on the available remedies each system offers; and any seemingly excessive litigation over email will in the end be productive, ensuring senders' privacy.<sup>486</sup> For email to be as thoughtful, clear, and creative as possible, privacy of expression must be recognized. Copyright should protect email privacy.

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474. *See supra* Part III.A, III.B.3.

475. *See supra* Part III.B.1–3.

476. *See supra* Part III.C.

477. *See supra* Part III.C.

478. *See supra* Part III.D.

479. *See supra* Part III.D.1.

480. *See supra* Part III.D.

481. *See supra* Part III.D.2.

482. *See supra* Part IV.

483. *See supra* Part III.C (discussing competing interest of copyright theory).

484. *See supra* Part IV.B.

485. *See supra* Part IV.B.

486. *See supra* Part IV.A–B.