

## COPYRIGHT, OBSCENITY, AND UNCLEAN HANDS

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*A mouse click away, virtual pornography promises immediate satisfaction of the prurient interest. Yet the allurements of ephemeral pleasure often presents a trap for the unwary. Some copyright owners use their pornographic works solely to extract tidy sums from the ignorant and base of society. Known as “copyright trolls,” these copyright owners have made a business out of litigating infringement claims, and virtual pornography yields fertile ground for their money-making scheme. It starts with sex on the screen, is followed by a lawyer’s letter, and ends with money paid. Tempting, efficient, and lucrative, copyright trolling has become a booming business.*

*Judges detest this practice. They are offended that the judicial system is being used as a cog in the troll’s machine of litigation. What can be done? The answer lies in the equitable doctrine of unclean hands. Centuries old, the doctrine of unclean hands allows courts to bar claimants from enforcing their rights if the claimants have engaged in wrongful conduct that is relevant to the subject matter of a lawsuit. This scenario frequently arises when copyright trolls pursue infringement claims for unauthorized downloading of their pornographic works: the trolls have often employed those works to violate state and federal obscenity laws. The works over which they seek copyright protection are the instrumentalities for their unlawful conduct, so unclean hands would seem to apply. Courts should not enforce their copyrights.*

*This simple solution to the problem of copyright trolls turns out not to be so simple. In Mitchell Bros. Film Group v. Cinema Adult Theater, the Court of Appeals for the Fifth Circuit held that unclean hands does not apply where a litigant is seeking to enforce a copyright to an obscene work. Although the case is more than four decades old, it has proven highly influential among jurists. The Ninth and Seventh Circuits have followed Mitchell, along with several district courts. Other courts, however, have questioned its holding, suggesting that the law on this issue is unsettled. Surprisingly, though, no one has critically analyzed the Mitchell decision; courts and commentators have*

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only noted its holding or cursorily described its reasoning. Mitchell is overdue for an examination.

*This Article is the first critical analysis of Mitchell. The Article concludes that Mitchell was wrongly decided because of serious flaws in the court's reasoning. The Article then argues that, pursuant to the unclean hands doctrine, the public interest warrants against enforcing a copyright when a copyright owner has committed an unlawful act either in the process of creating her work or in the process of exercising her rights. As a practical matter, this would mean that copyright would be unenforceable for much of pornography. Copyright trolling would cease.*

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## I. INTRODUCTION

The pornography industry has always been lucrative.<sup>1</sup> Even as the internet threatened to strip pornographers of a paying market, pornographers have found other ways to cash in on the prurient interest.<sup>2</sup> Indeed, today’s market for pornography includes an unlimited and free virtual supply, so if pornographers want to make money from their wares, they cannot rely on the traditional economic principle that price should be set where supply meets demand. They must find another way to cash in on their offering of ephemeral pleasure.<sup>3</sup> One way that is becoming common is through litigating copyright claims.<sup>4</sup>

The litigation business model is simple and effective. Copyright owners of pornographic content scour the internet for users who have clicked on the captivating content without permission, and then they sue them. Even if

<sup>1</sup> See *\$15 Billion*, QUARTZ INDEX (June 21, 2018), <https://index.qz.com/1310708/porn-could-be-worth-more-to-the-us-economy-than-netflix-the-nba-or-the-nfl/> (estimating annual revenue of pornography industry to be somewhere between \$6 billion to \$15 billion).

<sup>2</sup> See Jennifer Booton, *Porn Industry’s Billion-Dollar New Frontier*, MARKETWATCH (July 26, 2015, 10:26 AM), <https://www.marketwatch.com/story/how-the-future-of-virtual-reality-depends-on-porn-2015-07-15> (noting that revenue growth of the pornography industry increased at a lower-than-average annual rate owing to piracy and free pornography sites).

<sup>3</sup> See generally Kal Raustiala & Christopher Jon Sprigman, *The Second Digital Disruption: Streaming and the Dawn of Data-Driven Creativity*, 94 N.Y.U. L. REV. 1555, 1561–65 (2019) (summarizing the changing market conditions in the adult entertainment industry and arguing that the industry has been forced to revise its business model to rely on “the massive popularity of free pornography”).

<sup>4</sup> See Matthew Sag, *Copyright Trolling, An Empirical Study*, 100 IOWA L. REV. 1105, 1108–10 (2015) (defining copyright trolls and their tendency to litigate over pornographic works).

internet users are in fact innocent of the accused download (for instance, a roommate had clicked on the infringing content), they face high legal costs and embarrassing publicity that compels them to pay the demand of these copyright owners. Known as “copyright trolls,” these copyright owners extract high sums.<sup>5</sup> The internet, it turns out, has not made *all* information free. Often in the thousands of dollars, the ticket price of in-home private viewings has become litigiously expensive—as well as the price of a curious roommate who uses your internet account.<sup>6</sup> Either way, the troll must be paid.

Courts loathe the tactics of copyright trolls. Several have refused to serve as “cogs” in the “copyright-enforcement business model.”<sup>7</sup> Similarly, others have recognized that copyright trolls “have used the offices of the Court as an inexpensive means to gain the Doe defendants’ personal information and coerce payment from them.”<sup>8</sup> The threat of copyright trolls, two courts have observed, “could turn copyright protection on its head.”<sup>9</sup>

As a result of their aversion to copyright trolling, several courts have attempted to stop the practice by barring discovery of information that would reveal the identities of John Doe defendants.<sup>10</sup> Yet for many courts, the rules of discovery are not the proper means to deal with the problem.<sup>11</sup> After all,

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<sup>5</sup> See *id.* at 1109–10 (describing the calculus of defendants in deciding whether to settle with a copyright troll).

<sup>6</sup> See *id.* at 1110.

<sup>7</sup> See *Media Prods., Inc. v. John Does 1-26*, No. 12 Civ. 2962(HB), 2012 WL 3866492, at \*2 (S.D.N.Y. Sept. 4, 2012) (“[T]he federal courts are not flexible enough to be shaped into ‘cogs in a plaintiff’s copyright-enforcement business model. The Court will not idly watch what is essentially an extortion scheme . . . .” (quoting *Malibu Media, LLC v. John Does 1-10*, No. 2:12-cv-3623-ODW(PJWx), 2012 U.S. Dist. LEXIS 89286, at \*9 (C.D. Cal. June 27, 2012)).

<sup>8</sup> See *Digital Sin, Inc. v. Does 1-176*, 279 F.R.D. 239, 242 (S.D.N.Y. 2012) (quoting *K-Beech, Inc. v. John Does 1-85*, No. 3:11cv469-JAG, 2011 WL 10646535, at \*3 (E.D. Va. Oct. 13, 2011)).

<sup>9</sup> *Malibu Media, LLC v. Doe*, No. 15 Civ. 4369(AKH), 2015 WL 4092417, at \*3 (S.D.N.Y. July 6, 2015) (quoting *Media Prods.*, 2012 WL 3866492, at \*2).

<sup>10</sup> See, e.g., *id.*; *Strike 3 Holdings, LLC v. Doe*, 351 F. Supp. 3d 160, 163 (D.D.C. 2018), *rev’d*, 964 F.3d 1203 (D.C. Cir. 2020); *Malibu Media, LLC v. Doe*, No. 15-CV-1883, 2015 WL 3651566, at \*2–4 (S.D.N.Y. June 5, 2015).

<sup>11</sup> See, e.g., *Strike 3 Holdings*, 964 F.3d at 1214 (reversing district court’s denial of discovery motion by copyright troll); *Malibu Media, LLC v. Doe*, 319 F.R.D. 299, 303–04 (E.D. Cal. 2016) (“The danger of copyright trolls is particularly acute in the context of pornography . . . . Despite these concerns, most district courts have permitted Plaintiff to serve ISPs with third-party subpoenas to discover the identity of the customer associated with the relevant IP Address.”); *Malibu Media, LLC v. Doe*, No. 15 Civ. 4381(JFK), 2015 WL 4923114, at \*1 (S.D.N.Y. Aug. 18, 2015); *Malibu Media, LLC v. John Does 1 Through 16*, No. 12-cv-1847-AJB (DHB), 2012 WL 3809128, at \*2

infringement did occur, and the defendants are the potential infringers: as in other areas of law that contemplate such circumstances, discovery should proceed.<sup>12</sup> Indeed, a federal appellate court recently overturned a district court's decision to deny discovery for a copyright troll, holding that the district court had incorrectly relied on the fact that the work was pornographic to reach its discovery ruling.<sup>13</sup> Content cannot be the basis for denying discovery.<sup>14</sup>

The question thus arises: Is there no way to stop the copyright troll? There is. The equitable defense of unclean hands allows courts to summarily dispose of most copyright suits that concern pornographic content. A few courts have recognized this doctrine in suits over pornography.<sup>15</sup> The doctrine enables courts to bar claimants from enforcing their rights if they have engaged in wrongful conduct that is relevant to the subject matter of the lawsuit.<sup>16</sup> Copyright owners often violate state and federal obscenity laws when exercising rights to pornographic works. In particular, state laws criminalize the performance and display of obscene material and child pornography, and federal law criminalizes the distribution of such material across state lines.<sup>17</sup> Moreover, even if some pornographic works do not fall within the legal definition of obscenity, the creation of those works often involves copyright owners violating state and federal law. Specifically, many pornographic works reflect the producer's direction that actors commit

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(S.D. Cal. Sept. 4, 2012); *Malibu Media, LLC v. Does 1-5*, No. 12 Civ. 2950(JPO), 2012 WL 2001968, at \*1 (S.D.N.Y. June 1, 2012).

<sup>12</sup>See generally FED. R. CIV. P. 26(d)(1) (allowing for discovery of information prior to conferring with parties when authorized by a court); *Gillespie v. Civiletti*, 629 F.2d 637, 642 (9th Cir. 1980) (allowing discovery of information to identify defendant's identity).

<sup>13</sup>*Strike 3 Holdings*, 964 F.3d at 1210 (“Having accepted [the copyright owner's] allegations of copyright ownership, the district court could not weaken the property rights attached to that ownership by imposing a content-based restriction on [the copyright owner's] access to discovery.”).

<sup>14</sup>See *id.*

<sup>15</sup>See, e.g., *Devil Films, Inc. v. Nectar Video*, 29 F. Supp. 2d 174, 175 (S.D.N.Y. 1998) (applying unclean hands doctrine to deny copyright owner's application for seizure of obscene materials); *Malibu Media, LLC v. Doe*, No. 13 C 3648, 2014 WL 2581168, at \*4 (N.D. Ill. June 9, 2014) (denying copyright owner's motion to strike defendant's affirmative defense of unclean hands).

<sup>16</sup>See generally *McKennon v. Nashville Banner Publ'g Co.*, 513 U.S. 352, 360 (1995) (“[A] suitor who engaged in his own reprehensible conduct in the course of the transaction at issue must be denied equitable relief because of unclean hands.”).

<sup>17</sup>See 18 U.S.C. §§ 1464 (criminalizing broadcasting of obscene material), 1465 (criminalizing the sale or transfer of obscene material), 2252(a) (criminalizing distribution of child pornography).

violent acts against victims (and any seeming consent may not extend to those acts).<sup>18</sup> Many pornographic works portray underage actors, which violates federal child pornography laws.<sup>19</sup> Hence, copyright owners of pornographic works often come to court with unclean hands. Equity demands that courts refuse to enforce their rights.

Although the unclean hands defense seems to apply here, precedent resists its application. Several courts have refused to apply the defense based on a case that the Fifth Circuit Court of Appeals decided over forty years ago—*Mitchell Bros. Film Group v. Cinema Adult Theater*.<sup>20</sup> The *Mitchell* case holds that unclean hands cannot apply in the context of a copyright suit over obscenity.<sup>21</sup> The Ninth Circuit adopted that holding a few years later.<sup>22</sup> Then a few decades later, the Seventh Circuit referred to it as “the prevailing view” on the issue.<sup>23</sup> District courts now overseeing suits by copyright trolls have relied on *Mitchell* to reject the unclean hands defense.<sup>24</sup> In short, *Mitchell* single-handedly changed the equitable doctrine of unclean hands in copyright law.<sup>25</sup> It is a formidable barrier—indeed, it is *the* barrier—to denying enforcement of a copyright to obscenity.

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<sup>18</sup> See *People v. Samuels*, 58 Cal. Rptr. 439, 447 (Ct. App. 1967) (ruling that consent was not a defense to a charge of aggravated assault against defendant who filmed an allegedly consensual beating); Ann Bartow, *Pornography, Coercion, and Copyright Law 2.0*, 10 VAND. J. ENT. & TECH. L. 799, 819 (2008) (“Even those with decidedly pro-pornography sensibilities are sometimes aghast at the violence that is ‘consensually’ inflicted upon pornography performers.”).

<sup>19</sup> See 18 U.S.C. § 2252(a) (2016).

<sup>20</sup> 604 F.2d 852 (5th Cir. 1979).

<sup>21</sup> *Id.* at 863–65.

<sup>22</sup> *Jartech v. Clancy*, 666 F.2d 403, 406 (9th Cir. 1982). See also *Dream Games, Inc. v. PC Onsite*, 561 F. 3d 983, 990–91 (9th Cir. 2009) (“The *Mitchell/Belcher* principle leads to the conclusion that illegal operation of a copyrightable work neither deprives the work of copyright protection nor precludes generally available remedies.”).

<sup>23</sup> *Flava Works, Inc. v. Gunter*, 689 F.3d 754, 755 (7th Cir. 2012) (citing to *Mitchell* for the proposition that “the prevailing view is that even illegality is not a bar to copyrightability”).

<sup>24</sup> See, e.g., *Malibu Media, LLC v. Zumbo*, No. 2:13-cv-729-JES-DNF, 2014 WL 2742830, at \*4 (M.D. Fla. June 17, 2014) (citing to *Mitchell* for the proposition that “even obscenity and immoral content are copyrightable”); *Nova Prods., Inc. v. Kisma Video, Inc.*, No. 02 Civ. 3850(HB), 2004 WL 2754685, at \*3 (S.D.N.Y. Dec. 1, 2004) (citing to *Mitchell* for the proposition that “obscenity is not a defense to a copyright infringement claim”).

<sup>25</sup> See *Liberty Media Holdings, LLC v. Swarm Sharing Hash File*, 821 F. Supp. 2d 444, 447 n.2 (D. Mass. 2011) (“Copyright protection in the United States was effectively unavailable for pornography until the landmark decision by the Fifth Circuit in *Mitchell Brothers Film Group v. Cinema Adult Theater*, 604 F.2d 852, 854–55, 858 (5th Cir.1979).”).

Some courts, though, have cast doubt on *Mitchell*'s holding. They have questioned whether their own circuits would follow its lead.<sup>26</sup> The issue, then, is by no means settled. Indeed, judicial discord over *Mitchell* has been mounting for more than two decades.<sup>27</sup> Yet the cases that cast doubt on *Mitchell* have failed to challenge its reasoning, merely posing the possibility of disagreement in footnotes or with guarded tone.<sup>28</sup> This is puzzling. For the court opinion that altered the landscape of a centuries-old doctrine, one would expect courts and commentators to critically evaluate its reasoning. That evaluation has been noticeably absent. Only cursory summaries have appeared in the literature.<sup>29</sup> Some have expressed opinions about its holding, but none have examined its reasoning.<sup>30</sup> The examination is long overdue.

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<sup>26</sup> See, e.g., *Strike 3 Holdings, LLC v. Doe*, 351 F. Supp. 3d 160, 165 n.5 (D.D.C. 2018) (“The Court notes it is unsettled in many circuits—including this one—whether pornography is in fact entitled to protection against copyright infringement.”), *rev’d* 964 F.3d 1203 (D.C. Cir. 2020); *Malibu Media, LLC v. Doe*, No. 13 C 3648, 2014 WL 2581168, at \*4 (N.D. Ill. June 9, 2014) (recognizing *Mitchell* and stating that “the Court is not prepared to say that federal copyright law would permit one who has produced child pornography . . . to enforce a copyright relating to such material”); *Next Phase Distrib., Inc. v. Does 1-27*, 284 F.R.D. 165, 171 (S.D.N.Y. 2012) (“[I]f the Motion Picture is considered obscene, it may not be eligible for copyright protection. . . . [S]ince the *Mitchell Bros.* decision, judges across the country and within this district have reached different conclusions on this issue.”); *Liberty Media*, 821 F. Supp. 2d at 447 n.2 (“Notably, it is a matter of first impression in the First Circuit, and indeed is unsettled in many circuits, whether pornography is in fact entitled to protection against copyright infringement.”).

<sup>27</sup> See cases cited *supra* note 26.

<sup>28</sup> See, e.g., *Devil Films, Inc. v. Nectar Video*, 29 F. Supp. 2d 174, 175–76 (S.D.N.Y. 1998) (“Since this is only an application for preliminary relief, the Court need not decide if obscenity is a defense to a claim of copyright violation.”); see also cases cited *supra* note 26.

<sup>29</sup> See, e.g., MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.17 (2019) (“In the most thoughtful and comprehensive analysis of the issue, *Mitchell Brothers Film Group v. Cinema Adult Theater* concluded that no works are excluded from copyright by reason of their content.”).

<sup>30</sup> See James R. Alexander, *Evil Angel Eulogy: Reflections on the Passing of the Obscenity Defense in Copyright*, 20 J. INTEL. PROP. L. 209, 227 (2013) (“The authority of the venerable Clean Hands Doctrine in copyright law appeared to be summarily eviscerated by *Mitchell Brothers*, a ruling that interestingly evoked relatively little comment or criticism.”) (tracing the history of courts applying equitable defenses in copyright law and considering whether *Mitchell*'s holding is consistent with general trends in equity law).

Professor Ann Bartow has criticized the *Mitchell* court for showing “little apparent concern for any negative consequences” to “increasing incentives for the production and distribution of pornography.” See Ann Bartow, *supra* note 18, at 831–32.

Professor Eldar Haber has proposed that illegal works should not receive copyright protection despite the holding in *Mitchell*. See Eldar Haber, *Copyrighted Crimes: The Copyrightability of Illegal Works*, 16 YALE J. L. & TECH. 454, 465, 490–500 (2014).

This Article performs a critical analysis of *Mitchell*'s holding that unclean hands cannot apply in the context of enforcing a copyright to obscenity. In this Introduction, I briefly summarize the reasoning of *Mitchell* and its problems. The *Mitchell* court relied on three premises to support its holding. First, the court argued that the unclean hands defense applies only if a copyright owner personally injures the defendant.<sup>31</sup> That premise is false. It contravenes Supreme Court precedent as well as the public policy that underlies copyright law.<sup>32</sup> Second, the *Mitchell* court argued that unclean hands should not apply because the then-governing 1909 Copyright Act encompassed expression that could be deemed obscene.<sup>33</sup> Yet unclean hands does not depend on the scope of content covered by the Act; rather, unclean hands examines whether wrongful acts of the plaintiff relate to the issue before the court.<sup>34</sup> Third, the *Mitchell* court cited policy arguments in support of its holding.<sup>35</sup> Its arguments, however, are seriously flawed. The court contended that refusing to enforce copyright rights in obscenity would lead to absurd and unacceptable results, would fragment rights of copyright owners, and would be subject to outdated moral standards.<sup>36</sup> As I discuss in Part III, these contentions have both logical and practical flaws.<sup>37</sup> *Mitchell*'s parade of horrors simply would not occur.

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Professors Christopher Crotopia and James Gibson have raised an economic argument which would effectively "entrench the holding[] of *Mitchell*." See Christopher A. Cotropia & James Gibson, *The Upside of Intellectual Property's Downside*, 57 UCLA L. REV. 921, 981 n.274 (2010). I reply to their argument in another work. See Ned Snow, *Moral Bars to Intellectual Property: Theory & Apologetics*, 28 UCLA ENT. L. REV. (forthcoming 2021).

A student note summarizes the *Mitchell* court's analysis, criticizes it for being inconsistent with the scope of the First Amendment, and argues that public policy calls for courts to rule differently. Note, Karl Schmalz, *Problems in Giving Obscenity Copyright Protection: Did Jartech and Mitchell Brothers Go Too Far?*, 36 VAND. L. REV. 403, 414–15, 417–21 (1983); see also Note, *Can Intellectual Property Law Regulate Behavior? A "Modest Proposal" for Weakening Unclean Hands*, 113 HARV. L. REV. 1503, 1503–08 (2000) (citing to *Mitchell* as a case in opposition to a proposal that would bar authors from registering their works if they had committed criminal acts related to their works).

<sup>31</sup> *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 863 (5th Cir. 1979).

<sup>32</sup> See discussion *infra* Part III.A.

<sup>33</sup> See *Mitchell*, 604 F.2d at 854, 862–63.

<sup>34</sup> See discussion *infra* Part III.B.

<sup>35</sup> See *Mitchell*, 604 F.2d at 857–58, 864.

<sup>36</sup> See *id.*

<sup>37</sup> See discussion *infra* Part III.C.



After refuting *Mitchell*, this Article considers circumstances in which the public interest in a copyright lawsuit suggests against enforcement under the unclean hands doctrine.<sup>38</sup> The Article argues that courts should recognize two categories of such circumstances: first, where the author of a work commits an unlawful act as part of the creative process; and second, where the copyright owner commits an unlawful act corresponding to his exclusive rights.<sup>39</sup> Both situations offend the public interest that underlies copyright. Of course, this interpretation casts doubt on the enforceability of works other than obscenity, such as graffiti, fake news, and mass-shooting videos.<sup>40</sup> In any of these situations, the unlawfulness of the act will depend on a particular jurisdiction's definition. Moreover, other circumstances may be relevant to a court's decision about whether to ultimately deny enforcement of the copyright. These and other issues are considered in Part IV.

Thus, this Article argues that courts may apply the unclean hands defense where copyright owners have acted unlawfully with respect to the works over which they are seeking protection. Part II provides background on the doctrine of unclean hands as it relates to copyright law. It outlines the current state of the law. Part III analyzes the *Mitchell* decision, observing flaws in the Fifth Circuit's reasoning, which ultimately led the court to reach an incorrect conclusion. Part IV sets forth the two circumstances that should justify application of unclean hands in the copyright context. Part IV also addresses issues relating to jurisdictional differences in defining lawfulness, rights of licensees, and other factors that should inform the enforcement decision.

## II. UNCLEAN HANDS AND COPYRIGHT

For more than two centuries, courts have applied the equitable doctrine of unclean hands to deny remedies for litigants who do not deserve to enforce their rights.<sup>41</sup> The maxim that underlies its application is simple: "he who seeks equity, must do equity."<sup>42</sup> The modern Supreme Court has explained

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<sup>38</sup> See discussion *infra* Part IV.

<sup>39</sup> See discussion *infra* Part IV.A–B.

<sup>40</sup> See discussion *infra* Part IV.A.

<sup>41</sup> See, e.g., *Talbot v. Jansen*, 3 U.S. 133, 158 (1795) ("[I]t is right to conduct all cases of this kind, in such a manner, as that the persons guilty of fraud, should not gain by it. Hence the efficacy of the legal principle, that no man shall set up his own fraud or iniquity, as a ground of action or defense.").

<sup>42</sup> 1 JOHN NORTON POMEROY, A TREATISE ON EQUITY JURISPRUDENCE AS ADMINISTERED IN THE UNITED STATES OF AMERICA § 385, at 419 (Spencer W. Symons ed., 5th ed. 1941).

the doctrine as follows: “a suitor who engaged in his own reprehensible conduct in the course of the transaction at issue must be denied equitable relief because of unclean hands.”<sup>43</sup> The doctrine would enable a court to deny relief if, for instance, a party to a contract for murder, having fulfilled his contractual obligation to commit a homicide, sought relief against a defendant for failure to pay the agreed-upon price.<sup>44</sup> In short, the doctrine allows courts to prevent wrongdoers from employing the legal system to support their wrongful acts.

Because the doctrine is an equitable one, it has traditionally affected only the enforcement of equitable remedies.<sup>45</sup> However, many courts over the past several decades have applied unclean hands to hold legal rights unenforceable.<sup>46</sup> In the copyright context specifically, courts have employed the doctrine to refuse legal remedies.<sup>47</sup> They have treated unclean hands as governing both equitable injunctions and monetary damages.<sup>48</sup>

This Article argues that courts may apply unclean hands to deny remedies to a copyright owner who is seeking to enforce rights in a pornographic work.

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<sup>43</sup> *McKennon v. Nashville Banner Publ’g Co.*, 513 U.S. 352, 360 (1995).

<sup>44</sup> *See, e.g., Kaiser Steel Corp. v. Mullins*, 455 U.S. 72, 77 (1982) (“There is no statutory code of federal contract law, but our cases leave no doubt that illegal promises will not be enforced in cases controlled by the federal law.”). Contracts for a party to perform an illegal act usually require the performance of an illegal act against an unknowing third party or the public at large. *See generally* 17A AM. JUR. 2D *Contracts* § 217 (2020).

<sup>45</sup> 27A AM. JUR. 2D *Equity* § 19 (2020).

<sup>46</sup> *See* T. LEIGH ANENSON, *JUDGING EQUITY: THE FUSION OF UNCLEAR HANDS IN U.S. LAW* 79–88 (2019) (reciting federal cases in which courts have applied unclean hands to legal actions).

<sup>47</sup> *See e.g., Supermarket of Homes, Inc. v. San Fernando Valley Bd. of Realtors*, 786 F.2d 1400, 1408 (9th Cir. 1986) (“The defense of unclean hands by virtue of copyright misuse prevents the copyright owner from asserting infringement and asking for damages when the infringement occurred by his dereliction of duty.”); *Cellular Accessories for Less, Inc. v. Trinitas LLC*, 65 F. Supp. 3d 909, 917 (C.D. Cal. 2014); *Microsoft Corp. v. Worth*, No. 3:06-CV-2213-G, 2007 WL 1975574, at \*2 (N.D. Tex. July 5, 2007) (“As an affirmative defense, unclean hands can absolve the defendant of liability from both the legal claims of copyright and trademark infringement and the equitable claims for injunctive relief.”); *Societe Civile Succession Richard Guino v. Beseder Inc.*, No. CV 03-1310-PHX-MHM, 2006 WL 2917349, at \*5 (D. Ariz. Oct. 6, 2006) (“The defense of unclean hands applies in copyright infringement cases to prevent a plaintiff from obtaining relief both in law and in equity.”); *McCormick v. Cohn*, No. CV 90–0323 H, 1992 WL 687291, at \*3 (S.D. Cal. July 31, 1992) (quoting *Buchanan Home & Auto Supply v. Firestone Tire*, 544 F. Supp. 242, 245 (D.S.C. 1981)).

<sup>48</sup> *See* 5 WILLIAM F. PATRY, *PATRY ON COPYRIGHT* § 17:127 (2020) (“Where unclean hands is established, it is a complete defense to the infringement action and any future actions until the unclean hands conduct is cured.”).

Such a copyright owner often acts unlawfully either in creating the work (perhaps by instructing an actor to batter an actress) or in exercising a right to the work (perhaps by performing or distributing the work in a jurisdiction that defines the content as obscene). Simply put, if the copyright owner acts unlawfully in creating the work or in exercising rights to the work, courts may deny enforcement of the copyright.

As simple as this argument may sound, it raises a complex issue. Specifically, are such unlawful acts sufficiently connected to the lawsuit over the pornographic work? If the unlawful acts are not sufficiently connected to the lawsuit, unclean hands cannot apply.<sup>49</sup> The view that the unlawful acts are not sufficiently connected to the litigation arises from the fact that the copyright owner's unlawful acts do not involve harm to the infringing defendant.<sup>50</sup> A defendant is not usually harmed by a copyright owner who commits unlawful acts in the process of creating a pornographic work or in the process of exercising rights to the work. Indeed, the copyright owner's unlawful acts while creating, performing, or distributing a work would not seem to harm an infringer who has himself reproduced, performed, or distributed the work (without permission).<sup>51</sup> If anything, the copyright owner's unlawful actions make possible the defendant's infringement. Given this fact, the issue arises as to whether the copyright owner's unlawful actions are sufficiently connected to an enforcement action against an infringing defendant.

The Sections below consider case law that addresses this issue. Section A examines Supreme Court precedent in the patent context. Section B examines lower court rulings in the copyright context.

### A. *Supreme Court Patent Jurisprudence*

Although the Supreme Court has not yet addressed this issue in the copyright context, the Court has spoken on it in the patent context. The Court's comments are instructive here because of relevant similarities between patent and copyright law. Both patent and copyright arise under the same constitutional provision and share the same theoretical underpinnings.<sup>52</sup>

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<sup>49</sup>See *McKennon v. Nashville Banner Publ'g Co.*, 513 U.S. 352, 360 (1995) (reciting the equitable maxim that "a suitor who engaged in his own reprehensible conduct *in the course of the transaction at issue* must be denied equitable relief because of unclean hands") (emphasis added).

<sup>50</sup>See *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 863 (5th Cir. 1979).

<sup>51</sup>See *id.*

<sup>52</sup>See U.S. CONST. art. I, § 8, cl. 8.

For this reason, the Court has frequently looked to patent law in crafting copyright doctrine.<sup>53</sup> Hence, this Section examines statements by the Court about whether unclean hands may apply where a patentee has engaged in unlawful acts that do not affect the defendant.

### 1. Earlier Patent Cases

The Court's application of unclean hands in the patent context occurred decades ago (in the 1930s and 1940s) in four cases.<sup>54</sup> The teachings of those older cases still guide courts today in both patent and copyright law.<sup>55</sup> Tellingly, none of the older cases involved the patentee personally injuring the defendant.

Three of the four cases involved misconduct by the patentee before the United States Patent and Trademark Office (PTO).<sup>56</sup> Based on these three cases, appellate courts have applied unclean hands to deny protection where either a patentee or a copyright owner has acted wrongfully before the PTO or before the Copyright Office.<sup>57</sup> In the fourth case, *Morton Salt Co. v. G.S. Suppiger Co.*, the Supreme Court invoked unclean hands to deny patent protection where a patentee had engaged in misconduct toward third parties

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<sup>53</sup> See, e.g., *MGM Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 932–37 (2005); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 439 (1984) (“The closest analogy is provided by the patent law cases to which it is appropriate to refer because of the historic kinship between patent law and copyright law.”). See also *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 976–77 (4th Cir. 1990) (“The origins of patent and copyright law in England, the treatment of these two aspects of intellectual property by the framers of our Constitution, and the later statutory and judicial development of patent and copyright law in this country persuade us that parallel public policies underlie the protection of both types of intellectual property rights. We think these parallel policies call for application of the misuse defense to copyright as well as patent law.”).

<sup>54</sup> See *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 819–20 (1945) (denying relief for knowingly submitting application containing perjured statements); *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U.S. 238, 245 (1944) (denying relief for carrying out a scheme to defraud the PTO), *overruled on other grounds by* *Standard Oil Co. v. United States*, 429 U.S. 17 (1976); *Morton Salt Co. v. G.S. Suppiger Co.*, 314 U.S. 488, 491–92 (1942) (denying relief for tying arrangement); *Keystone Driller v. Gen. Excavator Co.*, 290 U.S. 240, 243 (denying relief for manufacturing false evidence).

<sup>55</sup> See, e.g., *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1285 (Fed. Cir. 2011) (relying on Supreme Court case law on unclean hands in applying patent law); *Lasercomb*, 911 F.2d at 976–77 (relying on Supreme Court case law on unclean hands in applying copyright law).

<sup>56</sup> See *Precision Instrument*, 324 U.S. at 816; *Hazel-Atlas*, 322 U.S. at 240–41, 245; *Keystone Driller*, 290 U.S. at 243–44.

<sup>57</sup> See *Therasense*, 649 F.3d at 1287; *Atari Games Corp. v. Nintendo of Am. Inc.*, 975 F.2d 832, 846 (Fed. Cir. 1992).

(who were neither the PTO nor the defendant), which involved an unlawful tying arrangement.<sup>58</sup> Appellate courts have interpreted *Morton Salt* to create an equitable “misuse doctrine” in both the patent and copyright contexts.<sup>59</sup> The misuse doctrine denies relief where a rights-holder extends the monopoly of patent or copyright beyond the scope granted by the respective statute.<sup>60</sup> Hence, courts have relied on these earlier patent cases to create specific equitable doctrines in both patent and copyright law. None of the specific doctrines require direct injury to a defendant.

In creating these specific doctrines, appellate courts have not limited the general doctrine of unclean hands. Indeed, the Federal Circuit recently applied unclean hands based on misconduct of an inventor’s attorney toward a third party.<sup>61</sup> That case did not involve misconduct against either the PTO or the defendant, nor did it involve patent misuse.<sup>62</sup> In the copyright context as well, courts recognize that a general doctrine of unclean hands exists that would apply outside the contexts of fraud on the Copyright Office or copyright misuse.<sup>63</sup>

## 2. *eBay Inc. v. MercExchange, LLC*

The modern Supreme Court case of *eBay Inc. v. MercExchange, LLC* sheds further light on the issue of whether unclean hands requires a rights-holder to have personally injured a defendant.<sup>64</sup> There, the Court considered whether injunctive relief should be granted to a patentee whose patent had been infringed.<sup>65</sup> The Court explained that in seeking injunctive relief, the patentee must satisfy a four-element test, which is required by “well-

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<sup>58</sup> 314 U.S. at 491, 494.

<sup>59</sup> See *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1372 (Fed. Cir. 1998) (citing *Morton Salt* for guidance in patent misuse doctrine); *Lasercomb*, 911 F.2d at 976–77 (relying on *Morton Salt* to apply copyright misuse doctrine).

<sup>60</sup> See *C.R. Bard*, 157 F.3d at 1372; *Lasercomb*, 911 F.2d at 976–77.

<sup>61</sup> *Gilead Scis., Inc. v. Merck & Co.*, 888 F.3d 1231, 1241–43 (Fed. Cir. 2018).

<sup>62</sup> See *id.*

<sup>63</sup> See, e.g., *Microsoft Corp. v. Worth*, No. 3:06-CV-2213-G, 2007 WL 1975574, at \*2 (N.D. Tex. July 5, 2007) (treating unclean hands separate from copyright misuse); *Huthwaite, Inc. v. Randstad Gen. Partner (US)*, No. 06-C-1548, 2006 WL 3065470, at \*9 (N.D. Ill., Oct. 24, 2006) (recognizing that pleading that copyright owner exercised bad faith in obtaining confidential information is sufficient to support unclean hands defense); see also PATRY, *supra* note 48, § 17:127.

<sup>64</sup> *Cf.* 547 U.S. 388, 391 (2006).

<sup>65</sup> *Id.* at 390–91.

established principles of equity.”<sup>66</sup> One of the elements is that “the public interest would not be disserved by a permanent injunction.”<sup>67</sup> The presence of this public-interest element in the Court’s test suggests against a rigid rule requiring that a defendant be personally injured to invoke the unclean hands doctrine. Although the *eBay* Court did not couch its test in terms of that doctrine per se, the test would seem relevant to that doctrine because unclean hands is so central to all principles of equity. Indeed, a foremost authority on equity has explained that the maxim of unclean hands “may be regarded as the foundation of *all* equity, as the source of every doctrine and rule of equity jurisprudence.”<sup>68</sup> So, if the *eBay* Court is correct that well-established principles of equity call for courts to consider the public interest in granting or denying relief in patent cases, this suggests that courts should consider the public interest in applying the unclean hands defense in copyright cases. And consideration of the public interest suggests against requiring direct harm to the defendant.

The *eBay* opinion further indicates that this public-interest consideration applies with as much force in copyright as it does in patent.<sup>69</sup> Three aspects of the opinion suggest this conclusion. First, the *eBay* Court introduced its test in the abstract.<sup>70</sup> That is, the Court described the public-interest principle as a “well-established principle[] of equity” and then applied it to patent law.<sup>71</sup> Hence, the principle is not specific to patent law. Second, as support for its four-factor test in patent law, the Court observed that its approach is consistent with its treatment of injunctions under the Copyright Act.<sup>72</sup> It drew strong parallels between the two regimes.<sup>73</sup> The Court explained:

This approach [to granting injunctions in patent law] is consistent with our treatment of injunctions under the Copyright Act. Like a patent owner, a copyright holder possesses “the right to exclude others from using his property.” *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932); see also *id.*, at 127–128 (“A copyright, like a patent,

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<sup>66</sup> *Id.*

<sup>67</sup> *Id.*

<sup>68</sup> POMEROY, *supra* note 42, § 385, at 713–14.

<sup>69</sup> 547 U.S. at 391.

<sup>70</sup> *Id.*

<sup>71</sup> See *id.* at 391–92.

<sup>72</sup> *Id.* at 392.

<sup>73</sup> See *id.*

is at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals and the incentive to further efforts for the same important objects”). Like the Patent Act, the Copyright Act provides that courts “may” grant injunctive relief “on such terms as it may deem reasonable to prevent or restrain infringement of a copyright.” 17 U.S.C. § 502(a).<sup>74</sup>

Third, the Court noted that both copyright and patent represent rights that are “given by the public,” which makes the public interest relevant in both regimes.<sup>75</sup> Because the public must honor the intellectual property rights for them to be effective, the public’s interest is especially relevant in both intellectual property regimes. Neither regime could exist without the public. Thus, the public-interest criterion articulated in *eBay* appears to apply in copyright law.

This public-interest consideration indicates that in applying unclean hands, courts should not impose a strict requirement that a copyright owner injure the defendant. Indeed, the Supreme Court has noted that where “the public interest is involved,” the equitable powers of a court “assume an even broader and more flexible character.”<sup>76</sup> The public interest in a lawsuit exists independent of the defendant’s interest. As discussed below, however, several courts in the copyright context have refused to invoke unclean hands on the basis that a copyright owner’s unlawful actions have not personally injured the defendant.

### B. Copyright History

Court decisions are mixed on the issue of whether unclean hands applies where a copyright owner has committed an unlawful act in connection with his work yet that act has not caused injury to the defendant.<sup>77</sup> Obscenity is the exemplary case.<sup>78</sup> The act of distributing obscenity represents one of the copyright rights, and that same act is also unlawful in many jurisdictions,

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<sup>74</sup> *Id.* at 392–93 (citations omitted).

<sup>75</sup> *Id.* at 392 (quoting *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932)).

<sup>76</sup> *Porter v. Warner*, 328 U.S. 395, 398 (1946).

<sup>77</sup> See discussion *infra* Part II.B.1–2.

<sup>78</sup> See discussion *infra* Part II.B.1–2. For an insightful argument against copyrighting pornography owing to harmful effects in the production process, see Ann Bartow, *Copyright Law and Pornography*, 91 OR. L. REV. 1 (2012). As Professor Bartow aptly notes: “Sex-for-hire is usually illegal, unless it is being filmed.”

including under federal statute.<sup>79</sup> Therefore, a copyright owner who exercises his right of distribution by selling obscene material acts unlawfully, but his unlawful act does not directly injure a defendant who infringes on his copyright in that material. Does his unlawful act of distributing the obscene material bar the copyright owner from enforcing his rights against the defendant? The subsections below describe judicial answers to this question.

### 1. Courts Applying Unclean Hands

Some courts have answered the question in the affirmative. A good example is a 1998 case in the Southern District of New York, *Devil Films, Inc. v. Nectar Video*.<sup>80</sup> The work there consisted of “hard core pornography bereft of any plot and with very little dialogue.”<sup>81</sup> The copyright owner sought a seizure of unauthorized copies of its work.<sup>82</sup> At the same time, the copyright owner appeared to be in violation of the federal law that prohibits the sale or transfer of obscene material in interstate commerce.<sup>83</sup> Under those facts, the court reasoned:

Once a court has determined that copyrighted material is obscene, there seems no reason to require it to expend its resources on behalf of a plaintiff who it could as readily be trying for a violation of the federal criminal law. . . . Here the strong public policy against the distribution of obscene material compels the conclusion that the Court should not exercise its equitable powers to benefit plaintiff.<sup>84</sup>

The unlawful nature of the copyright owner’s distribution of his copyrighted work—legally obscene material—was sufficient for the court to apply the unclean hands doctrine.<sup>85</sup> It denied equitable relief.<sup>86</sup>

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<sup>79</sup> Compare 17 U.S.C. § 106 (2016) (stating that copyright includes a right to publicly distribute a work), with 18 U.S.C. § 1466 (2016) (punishing the sale and transfer of obscene matter).

<sup>80</sup> 29 F. Supp. 2d 174, 175 (S.D.N.Y. 1998).

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*

<sup>84</sup> *Id.* at 176–177.

<sup>85</sup> *See id.*

<sup>86</sup> *Id.* at 177.



A more recent case occurred in *Malibu Media, LLC v. Doe*, where the plaintiff, known to be a copyright troll in the industry,<sup>87</sup> sought statutory damages against a defendant for downloading the plaintiff's pornographic films through BitTorrent, a peer-to-peer file-sharing venue.<sup>88</sup> The defendant argued the affirmative defense of unclean hands, and the plaintiff moved to strike that defense.<sup>89</sup> Denying the plaintiff's motion to strike the unclean hands defense, the district court held that the plaintiff could have violated a federal obscenity statute.<sup>90</sup> In particular, the statute requires a producer of a sexually explicit film to maintain records of each performer in the film (in an effort to identify under-age performers).<sup>91</sup> The possibility of that violation indicated that the plaintiff could have violated federal child-pornography laws.<sup>92</sup> In view of these possible unlawful actions, the court refused to strike the unclean hands defense.<sup>93</sup>

## 2. Courts Refusing to Apply Unclean Hands

Other courts have altogether rejected unclean hands as a defense to infringement of legal obscenity. The first court to do so was the Fifth Circuit in 1979, in a case called *Mitchell Bros. Film Group v. Cinema Adult Theater*.<sup>94</sup> As discussed in Part III below, a critical part of the *Mitchell* court's rejection of unclean hands was its conclusion that unclean hands requires that a defendant be personally injured by the wrongful conduct at issue.<sup>95</sup>

Three years later the Ninth Circuit embraced *Mitchell*'s teachings when it decided *Jartech, Inc. v. Clancy*.<sup>96</sup> Labeling *Mitchell* as "the prevailing view," the *Jartech* court extended copyright protection to obscene material based on a few of the reasons recited in *Mitchell*.<sup>97</sup> Notably, the *Jartech* court never addressed whether the actions of the plaintiffs amounted to unclean

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<sup>87</sup> See *Malibu Media: EFF Calls for Court Sanctions for Copyright Troll's Public Humiliation Tactic*, ELECTRONIC FRONTIER FOUND., <https://www.eff.org/cases/malibu-media> (last visited at Mar. 16, 2021).

<sup>88</sup> No. 13 C 3648, 2014 WL 2581168, at \*1 (N.D. Ill. June 9, 2014).

<sup>89</sup> See *id.* at \*1, \*3.

<sup>90</sup> *Id.* at \*4.

<sup>91</sup> *Id.* at \*3 (examining 18 U.S.C. § 2257).

<sup>92</sup> *Id.* at \*4.

<sup>93</sup> *Id.*

<sup>94</sup> 604 F.2d 852 (5th Cir. 1979).

<sup>95</sup> See discussion *infra* Part III.B.

<sup>96</sup> 666 F.2d 403 (9th Cir. 1982).

<sup>97</sup> *Id.* at 406.

hands. Indeed, absent from the court's opinion was any discussion about the unclean hands defense. Rather, the court considered whether obscene content per se should be a defense to copyright infringement.<sup>98</sup>

In 2012, the Seventh Circuit in *Flava Works, Inc. v. Gunter* recognized copyright protection for obscene content.<sup>99</sup> The issue of unclean hands was not before the court. Nevertheless, the court relied on *Mitchell* and *Jartech* to note in passing that “the prevailing view is that even illegality is not a bar to copyrightability.”<sup>100</sup>

Several modern district court decisions have also recognized the *Mitchell* case as controlling on this issue. Like the court in *Jartech*, however, most of them do not specifically address the unclean hands doctrine, instead relying on the general principle that a work's content per se should not disqualify it from receiving copyright protection.<sup>101</sup> One district court, though, did comment on unclean hands specifically, observing that a copyright owner's unlawful conduct in violation of a federal child-pornography statute does not bar enforcement of the copyright—in direct conflict with the reasoning of the case noted above, *Malibu Media, LLC v. Doe*.<sup>102</sup>

Other courts have recognized the issue as being unsettled. In a copyright case involving pornography, a district court did not rule on whether obscenity affects copyright protection except to say that the issue is “unsettled in many circuits.”<sup>103</sup> Another district court, in deciding whether to join defendants to

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<sup>98</sup> See *id.* at 408.

<sup>99</sup> 689 F.3d 754, 755 (7th Cir. 2012).

<sup>100</sup> *Id.*

<sup>101</sup> See, e.g., *Malibu Media LLC, v. Does 1-6*, No. 12-3142, 2012 U.S. Dist. LEXIS 204410, at \*2 (E.D. Pa. Oct. 17, 2012) (relying on *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979) for the proposition that “copyright laws are not content-based, and thus pornography is indeed eligible for copyright protection”); *Malibu Media, LLC v. Does 1-16*, No. 12-2078, 2012 WL 4717893 at \*8 n.8 (E.D. Pa. Oct. 3, 2012) (same); *Nova Prods., Inc. v. Kisma Video, Inc.*, Nos. 02 Civ. 3850(HB), 02 Civ. 6277(HB), 03 Civ 3379(HB), 2004 WL 2754685, at \*3 (S.D.N.Y. Dec. 1, 2004) (extending copyright protection to obscene material and noting that *Mitchell* was a “well-reasoned and scholarly opinion”).

<sup>102</sup> See *Malibu Media, LLC v. Zumbo*, No. 2:13-CV-729-JES-DNF, 2014 WL 2742830, at \*4 (M.D. Fla. June 17, 2014) (citing to *Mitchell* for the proposition that “even obscenity and immoral content are copyrightable”).

<sup>103</sup> *Liberty Media Holdings v. Swarm Sharing Hash File*, 821 F. Supp. 2d 444, 447 n.2 (D. Mass. 2011) (“Notably, it is a matter of first impression in the First Circuit, and indeed is unsettled in many circuits, whether pornography is in fact entitled to protection against copyright infringement. Copyright protection in the United States was effectively unavailable for pornography until the landmark decision by the Fifth Circuit in *Mitchell*, 604 F.2d 852 (5th Cir.1979). Congress

a copyright action, opined that if a work “is considered obscene, it may not be eligible for copyright protection,” observing that “since the *Mitchell Bros.* decision, judges across the country and within this district have reached different conclusions on this issue.”<sup>104</sup> Hence, although several courts have followed the lead of *Mitchell*, other courts have questioned whether the law is settled on this point.

### 3. The First Case to Reject Unclean Hands

Although *Mitchell* was the first case in which a court refused to apply unclean hands in the context of enforcing a copyright to obscenity, *Mitchell* was not the first case to do so in the broader context of unlawful works. The first case arose in the Ninth Circuit in 1973, *Belcher v. Tarbox*.<sup>105</sup> *Mitchell* and subsequent courts have relied on *Belcher* for the proposition that copyright owners who commit unlawful acts while exercising their rights can still receive copyright protection.<sup>106</sup> Hence, the case is important to analyze.

In *Belcher*, the plaintiff published a system for betting on horses.<sup>107</sup> The district court held that the publication contained fraudulent representations, and on that basis, denied it protection.<sup>108</sup> On appeal, the Ninth Circuit reversed, with a dissent.<sup>109</sup> The majority reasoned:

There is nothing in the Copyright Act to suggest that the courts are to pass upon the truth or falsity, the soundness or unsoundness, of the views embodied in a copyrighted work. The gravity and immensity of the problems, theological, philosophical, economic and scientific, that would confront a court if this view were adopted are staggering to

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has never addressed the issue by amendment to the Copyright Act. This issue, however, is not presently before the Court and the Court expresses no opinion on it here.”)

<sup>104</sup>*Next Phase Distrib., Inc. v. Does 1–27*, 284 F.R.D. 165, 171 (S.D.N.Y. 2012); *see also* *Patrick Collins, Inc. v. Does 1–33*, No. 4:12-CV-13309, 2013 WL 12182153 (E.D. Mich. Feb. 27, 2013).

<sup>105</sup>486 F.2d 1087 (9th Cir. 1973).

<sup>106</sup>*Mitchell*, 604 F.2d at 863; *see* *Dream Games, Inc. v. PC Onsite*, 561 F.3d 983, 990 (9th Cir. 2009) (relying on *Belcher* to conclude that copyright owner’s unlawful use of video gambling game does not preclude copyright protection under unclean hands).

<sup>107</sup>486 F.2d at 1087–88.

<sup>108</sup>*Id.* at 1089.

<sup>109</sup>*Id.*

contemplate. It is surely not a task lightly to be assumed, and we decline the invitation to assume it.<sup>110</sup>

The majority thus cited two reasons for granting copyright to fraudulent works: first, the Copyright Act never states that courts are to judge whether views in a work are true; and second, fraud raises the issue of whether a statement reflects truth, and deciding truth from various perspectives is too “staggering” an exercise for courts to perform.<sup>111</sup>

These two reasons are not persuasive. Let us consider the second reason first—that deciding whether fraud is present would require courts to determine truth. The dissenting judge pointed out that courts regularly pass judgment on whether statements are fraudulent.<sup>112</sup> Courts must if they are to hear cases involving the tort of fraud. Indeed, courts do not suddenly become incompetent at judging that a statement is false when they hear copyright cases. Furthermore, ruling on fraud does not require courts to determine the truth of statements that are not demonstrably false—like theological, philosophical, economic, and scientific theories.<sup>113</sup> The “staggering” exercise to which the majority alluded is therefore not relevant to the judicial exercise of finding fraud. The majority’s second reason is faulty on its face.

As for the first reason—the Copyright Act’s silence on fraud—the dissent further pointed out that the then-governing 1909 Copyright Act requires courts to grant injunctive relief “according to the course and principles of courts of equity.”<sup>114</sup> Those principles of equity call for withholding relief where a plaintiff exercises her right contrary to the public interest: exercising a copyright to monopolize fraudulent material is contrary to the public interest because it makes the government endorse and support deceitful conduct.<sup>115</sup> The dissent explained:

As a general principle, courts of equity may appropriately withhold their aid where the plaintiff is using the right asserted contrary to the public interest. . . . By allowing copyright protection to such material, the law is not only condoning fraud but is placing its power, endorsement and support behind fraudulent works. Persons who heretofore

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<sup>110</sup>*Id.* at 1088.

<sup>111</sup>*See id.*

<sup>112</sup>*See id.* at 1091 (Wallace, J., dissenting).

<sup>113</sup>*See id.*

<sup>114</sup>*See id.* at 1089 n.1 (Wallace, J., dissenting).

<sup>115</sup>*See id.* at 1090 (Wallace, J., dissenting).

have never composed fraudulent literature can do so and seek solace in the law as the protector of their copyrighted fraud. I submit that this is detrimental to our legal system and not in the public interest.<sup>116</sup>

The 1909 Act requires courts to grant relief according to principles of equity; principles of equity require denying relief where a copyright owner uses her right contrary to the public interest; and exercising a copyright to further fraudulent conduct is against the public interest. Accordingly, by directing courts to apply principles of equity in deciding whether to grant injunctive relief, the 1909 Copyright Act implicitly endorses withholding injunctive relief on the grounds of fraud.<sup>117</sup>

Thus, the reasoning of the *Belcher* majority is lacking. The purported impossibility of courts deciding whether a statement is fraudulent does not reflect the practical reality that courts routinely decide tort actions for fraud. And the majority's purported rationale for the Copyright Act's silence on the copyrightability of fraudulent statements does not reflect the Act's explicit requirement that courts apply equitable principles in determining relief. *Belcher* is poorly reasoned.

### III. ANALYSIS OF *MITCHELL*

Six years after *Belcher*, the Fifth Circuit decided *Mitchell Bros. Film Group v. Cinema Adult Theater*.<sup>118</sup> The facts of *Mitchell* are simple: the plaintiffs had created a pornographic film that was legally obscene, and they licensed it for exhibition to the public at theaters across the country.<sup>119</sup> The defendants had exhibited the film in their own theaters without permission from the plaintiffs.<sup>120</sup>

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<sup>116</sup>See *id.*

<sup>117</sup>See Act of Mar. 4, 1909, Pub. L. No. 60-349, § 36, 35 Stat. 1075, 1084.

<sup>118</sup>604 F.2d 852 (5th Cir. 1979).

<sup>119</sup>See No. 3-74-645, 1976 U.S. Dist. LEXIS 13396, at \*2-4 (N.D. Tex. Sept. 2, 1976), *rev'd*, 604 F.2d 852 (5th Cir. 1979).

The history of the Mitchell brothers is rather bizarre. After becoming very successful in the pornography industry, Jim and Artie Mitchell had a falling out. In 1992, Jim visited Artie at home in an apparent attempt to help Artie with a substance-abuse problem (according to Jim's account). Jim brought two guns with him and proceeded to shoot Artie three times (in the abdomen, shoulder, and right eye). Artie died; Jim went to prison. See Richard C. Paddock, *S.F. Porn King Jim Mitchell Guilty in Slaying of Brother*, L.A. TIMES (Feb. 20, 1992), <https://www.latimes.com/archives/la-xpm-1992-02-20-mn-3543-story.html>.

<sup>120</sup>See *Mitchell*, 1976 U.S. Dist. LEXIS 13396, at \*4.

Plaintiffs sued for infringement, but in its bench-trial opinion, the district court denied plaintiffs relief on the basis of unclean hands.<sup>121</sup> The reasoning of the district court was straightforward. The court recognized that most state laws criminalize the acts of displaying or exhibiting obscene works, and that federal law criminalizes the acts of transporting, mailing, and importing obscene works.<sup>122</sup> So, when the plaintiffs had exercised their copyright rights to publicly perform and distribute their work, they violated obscenity laws.<sup>123</sup> With unclean hands, they could not be granted relief.<sup>124</sup>

A three-judge panel of the Fifth Circuit reversed the district court's application of the unclean hands defense.<sup>125</sup> The appellate panel relied on three grounds for its reversal. First, the court held that the defense requires that a plaintiff personally injure the defendant. Second, the court interpreted the Copyright Act as precluding the defense. Third, the court cited various policy reasons. The Sections below examine these three grounds for the appellate court's refusal to apply unclean hands.

#### A. Personal Injury to Defendant

The linchpin of the Fifth Circuit's rejection of the unclean hands defense was its premise that the defense could not apply unless the copyright owners' wrongful conduct had personally injured the defendants.<sup>126</sup> In the following passage the court explained its reasoning on this point:

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<sup>121</sup> *Id.* at \*1, \*13–14, \*19. The district court opinion was written by Judge Robert Madden Hill. Four years after the Fifth Circuit's decision reversing Judge Hill, he was appointed to that appellate court. See *Hill, Robert Madden*, FED. JUD. CTR., <https://www.fjc.gov/history/judges/hill-robert-madden> (last visited July 22, 2020). He died three years later—without having had a chance while on the appellate court to revisit *Mitchell*. See *Robert Madden Hill Is Dead*, *Federal Appeals Court Judge*, THE NEW YORK TIMES (Oct. 22, 1987).

<sup>122</sup> See *Mitchell*, 1976 U.S. Dist. LEXIS 13396, at \*13.

<sup>123</sup> See *id.* at \*19.

<sup>124</sup> *Id.*

<sup>125</sup> See *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 854 (5th Cir. 1979). Given the abuse-of-discretion standard of review for reversing application of equitable doctrines, the appellate court apparently believed that the district court abused its discretion by invoking the unclean hands doctrine; *Midwestern Cattle Mktg., L.L.C. v. Legend Bank, N. A.*, 800 Fed. Appx. 239, 245 & n.15 (5th Cir. 2020) (“We review application of the unclean hands doctrine for abuse of discretion. . . . [B]ecause unclean hands ‘is an equitable doctrine, and the decision whether to invoke it [is] within the court’s discretion, we review for abuse of discretion.’”) (citing *In re Coastal Plains, Inc.*, 179 F.3d 197, 205 (5th Cir. 1999)). Indeed, the appellate opinion indicates that, as a matter of law, unclean hands could not apply. See *Mitchell*, 604 F.2d at 865.

<sup>126</sup> See *Mitchell*, 604 F.2d at 863.

The maxim of unclean hands is not applied where plaintiff's misconduct is not directly related to the merits of the controversy between the parties, but only where the wrongful acts "in some measure affect the equitable relations between the parties in respect of something brought before the court for adjudication." *Keystone Driller Co. v. General Excavator Co.*, 290 U.S. 240, 245 (1933). The alleged wrongdoing of the plaintiff does not bar relief unless the defendant can show that he has personally been injured by the plaintiff's conduct. *Lawler v. Gilliam*, 569 F.2d 1283, 1294 (CA4, 1978). The doctrine of unclean hands "does not purport to search out or deal with the general moral attributes or standing of a litigant." *NLRB v. Fickett-Brown Mfg. Co.*, 140 F.2d 883, 884 (CA5, 1944). Here it is clear that plaintiffs' alleged wrongful conduct has not changed the equitable relationship between plaintiffs and defendants and has not injured the defendants in any way.<sup>127</sup>

In this passage, the *Mitchell* court interpreted the unclean hands doctrine as applying only when a defendant had been personally injured by the plaintiff's wrongful conduct.<sup>128</sup> Obviously, the plaintiffs' unlawful distribution of the obscene film did not harm the defendants in *Mitchell*, who themselves had made a public performance of the film.<sup>129</sup> This fact, then, was the purported reason that the *Mitchell* court refrained from applying unclean hands.<sup>130</sup>

*Mitchell*'s requirement that the defendant be personally injured was not a proper application of law. Four reasons support this conclusion. First, the Supreme Court case on which the *Mitchell* court relied in the above quotation, *Keystone Driller*,<sup>131</sup> suggests the very opposite conclusion.<sup>132</sup> Second, the Fourth Circuit case that the *Mitchell* court cited in the above quotation, *Lawler v. Gilliam*,<sup>133</sup> is inapposite to *Mitchell*.<sup>134</sup> Third, *Mitchell*'s

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<sup>127</sup> *Id.*

<sup>128</sup> *Id.*

<sup>129</sup> *Id.* at 854.

<sup>130</sup> *Id.* at 865.

<sup>131</sup> 290 U.S. 240, 245 (1933).

<sup>132</sup> See discussion *infra* Part III.B.1.

<sup>133</sup> 569 F.2d 1283, 1294 (4th Cir. 1978).

<sup>134</sup> See discussion *infra* Part III.B.2.

requirement for a personal injury to the defendant contravenes the Supreme Court case of *Morton Salt Co. v. G.S. Suppiger Co.*,<sup>135</sup> which was decided prior to *Mitchell*.<sup>136</sup> Fourth, at the time of *Mitchell*, Fifth Circuit precedent recognized that unclean hands applies in the copyright context even where the copyright owner has not personally injured the defendant.<sup>137</sup> The subsections below discuss these four reasons.

1. *Keystone Driller Co. v. General Excavator Co.*

In the block quotation above, the *Mitchell* court relied on the Supreme Court case of *Keystone Driller* to support its proposition that a plaintiff must personally injure the defendant for unclean hands to apply.<sup>138</sup> In *Keystone Driller*, the Court applied the unclean hands doctrine where a patentee had made a fraudulent representation to the PTO while attempting to obtain a patent.<sup>139</sup> The patentee had not personally injured the defendant.<sup>140</sup> Owing to this fact, the patentee had argued that his wrongful conduct could not have been “directly connected and material to the matter in litigation.”<sup>141</sup> The Court, however, rejected this argument.<sup>142</sup> Hence, the fact that the patentee had not personally injured the defendant did not bar the unclean hands defense.<sup>143</sup>

The *Keystone Driller* Court did recognize, though, that unclean hands would not apply where a rights-holder’s misconduct “has no relation to anything involved in the suit.”<sup>144</sup> It explained further that courts of equity “apply the maxim, not by way of punishment for *extraneous transgressions*, but upon considerations that make for the advancement of right and justice.”<sup>145</sup> Clearly, the patentee’s conduct in obtaining his patent rights was not an “extraneous transgression”; it related to “something brought before the

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<sup>135</sup> 314 U.S. 488, 494 (1942).

<sup>136</sup> See discussion *infra* Part II.B.3.

<sup>137</sup> See *Stone & McCarrick, Inc. v. Dugan Piano Co.*, 220 F. 837, 841 (5th Cir. 1915); discussion *infra* Part III.B.4.

<sup>138</sup> 604 F.2d 852, 863 (5th Cir. 1979).

<sup>139</sup> 290 U.S. 240, 247 (1933).

<sup>140</sup> See *id.* at 243.

<sup>141</sup> *Id.* at 244.

<sup>142</sup> *Id.* at 245.

<sup>143</sup> See *id.* at 247.

<sup>144</sup> *Id.* at 245.

<sup>145</sup> *Id.* (emphasis added).



court for adjudication,” i.e., misconduct relating to the patent rights being enforced.<sup>146</sup>

The same sort of circumstance was present in *Mitchell*.<sup>147</sup> In *Mitchell*, the plaintiffs’ wrongful conduct concerned something brought before the court for adjudication—the unlawful exercise of the very rights that the plaintiffs were trying to enforce against the defendants.<sup>148</sup> Hence, *Keystone Driller* does not support *Mitchell*’s statement that a defendant must be personally injured by a plaintiff’s misconduct. *Keystone Driller* stands for just the opposite.

## 2. *Lawler v. Gilliam*

In the block quotation above, the *Mitchell* court relied on a Fourth Circuit case, *Lawler v. Gilliam*,<sup>149</sup> as direct support for the *Mitchell* court’s statement that “the defendant [must] show that he has personally been injured by the plaintiff’s conduct.”<sup>150</sup> Yet a close reading of *Lawler* shows that that case is inapposite.

*Lawler* is a securities regulation case in which sellers of securities (the defendants) violated federal law by selling unregistered securities to the plaintiff, who then sold the same securities to his own clients.<sup>151</sup> In three brief sentences, the Fourth Circuit rejected the defendants’ unclean hands defense: “This defense, as Pomeroy explains, requires the defendant to show that he himself has been injured by the plaintiff’s conduct. [Defendants] did not prove that [the plaintiff] harmed them. The only wrong he committed was against third parties.”<sup>152</sup> *Lawler*’s short analysis thus relied exclusively on the *Pomeroy* treatise.<sup>153</sup> That treatise does state: “The wrong must have been done to the defendant himself and not to some third party.”<sup>154</sup> Yet that statement appears to apply only where the plaintiff’s conduct harms only a specific third party (as in *Lawler*, the clients of the plaintiff).<sup>155</sup> That

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<sup>146</sup> *See id.* at 246.

<sup>147</sup> *See* 604 F.2d 852, 854 (5th Cir. 1979).

<sup>148</sup> *See id.*

<sup>149</sup> 569 F.2d 1283 (4th Cir. 1978).

<sup>150</sup> 604 F.2d at 863.

<sup>151</sup> 569 F.2d at 1286–87.

<sup>152</sup> *Id.* at 1294.

<sup>153</sup> *See id.*

<sup>154</sup> 2 POMEROY, *supra* note 42, § 399, at 99 (emphasis added).

<sup>155</sup> *See id.*

statement does not speak to the situation where the plaintiff's conduct harms the public interest in a lawsuit.<sup>156</sup> Tellingly, the same section of the Pomeroy treatise addresses the application of unclean hands in copyright cases.<sup>157</sup> It endorses the application of unclean hands where the copyright owner has committed wrongful acts with regard to “the subject-matter of the suit”—i.e., the disputed work.<sup>158</sup> The treatise states:

The [unclean hands doctrine] is applicable to a complainant who seeks protection from a court of equity against the violation or infringement of rights in patents, literary property, and copyrights. If he does not come into the court with clean hands *with regard to the subject-matter* of the suit, he will be denied relief.<sup>159</sup>

Thus, the rule that *Lawler* recited from Pomeroy—that the defendant must be personally injured—does not, according to Pomeroy, apply to copyright.

The reason that the defendant-injury requirement in *Lawler* does not apply to copyright is because the effects of enforcing the securities statute in *Lawler* are very different from the effects of enforcing the copyright statute. Enforcing the securities statute in *Lawler* would only punish the defendants' fraudulent acts (i.e., selling unregistered securities to the plaintiff).<sup>160</sup> The enforcement would not reward the plaintiff for any fraudulent acts that he may have committed.<sup>161</sup> Indeed, the plaintiff in *Lawler* is no more likely to sell unregistered securities as a result of the *Lawler* court punishing the defendants. By contrast, enforcing the copyright statute against the defendants in *Mitchell* would have the effect of incentivizing and rewarding the plaintiffs' unlawful acts. The *Mitchell* plaintiffs are more likely to continue violating obscenity laws if the court enforces their copyright. In short, the reasoning that underlies *Lawler* is inapposite to the facts of *Mitchell*.

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<sup>156</sup> *See id.*

<sup>157</sup> *See id.* § 402a, at 122–24.

<sup>158</sup> *Id.* at 122–23.

<sup>159</sup> *Id.* (emphasis added).

<sup>160</sup> *See* 569 F.2d at 1291.

<sup>161</sup> *See id.*

### 3. *Morton Salt Co. v. G.S. Suppiger Co.*

*Mitchell*'s requirement for a personal injury to the defendant contravenes a prior Supreme Court case in which the Court applied unclean hands in the patent context: *Morton Salt Co. v. G.S. Suppiger Co.*<sup>162</sup> In *Morton Salt*, a patentee tied the licensing of his patented machine to the sale of another product, apparently creating an unlawful monopoly.<sup>163</sup> The Court explained that unclean hands applied in that situation "regardless of whether the particular defendant has suffered from the misuse of the patent."<sup>164</sup> Because *Morton Salt* is a patent case, and the public interest is the same in patent as in copyright (i.e., incentivizing underproduced intellectual creations), this point of law in *Morton Salt* would appear to apply directly to the copyright context.<sup>165</sup> Hence, *Morton Salt* (like *Keystone Driller*) appears to contradict *Mitchell*'s requirement for a personal injury to the defendant.

Given *Morton Salt*'s explicit rejection of a defendant-injury requirement, the *Mitchell* court attempted to distinguish that case.<sup>166</sup> The *Mitchell* court contended that unclean hands was appropriate in *Morton Salt* only because the public injury was limited to "misuses that frustrate the particular purposes of the . . . patent[] statute."<sup>167</sup> Yet the language of *Morton Salt* contravenes this narrow reading of the case. Although the *Morton Salt* Court recognized that in that instance, the patentee's conduct would undermine the public policy of the patent grant, the Court's language never restricted the public-interest consideration only to such situations.<sup>168</sup> From *Morton Salt*, consider the following instruction on when the public interest is relevant to the application of unclean hands:

It is a principle of general application that courts, and especially courts of equity, may appropriately withhold their aid where the plaintiff is using the right asserted contrary to *the public interest*.<sup>169</sup>

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<sup>162</sup>314 U.S. 488 (1942).

<sup>163</sup>*Id.* at 490–91.

<sup>164</sup>*Id.* at 494.

<sup>165</sup>*Cf.* *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 976–77 (4th Cir. 1990) (relying on *Morton Salt* to apply copyright misuse doctrine).

<sup>166</sup>*See* 604 F.2d 852, 864 n.25 (5th Cir. 1979).

<sup>167</sup>*Id.* at 864.

<sup>168</sup>*See Morton Salt*, 314 U.S. at 493.

<sup>169</sup>*Id.* at 492 (emphasis added).

Undoubtedly “equity does not demand that its suitors shall have led blameless lives,” but additional considerations must be taken into account where maintenance of the suit concerns *the public interest* as well as the private interests of suitors.<sup>170</sup>

It is the adverse effect upon *the public interest* of a successful infringement suit, in conjunction with the patentee’s course of conduct, which disqualifies him to maintain the suit, regardless of whether the particular defendant has suffered from the misuse of the patent.<sup>171</sup>

In these passages, the *Morton Salt* Court suggests applying the unclean hands defense where enforcing a right would be “contrary to the public interest,” where the lawsuit “concerns the public interest” (in addition to private interests), and where enforcing the right would have an “adverse effect upon the public interest.”<sup>172</sup> None of the Court’s language suggests that “the public interest” is relevant to unclean hands only if the wrongful conduct concerns the particular purpose of the patent statute.

Even if the *Mitchell* court were correct that the public interest must concern the purpose of the patent or copyright statute, the public interest in not incentivizing unlawful distribution of obscenity satisfies such a requirement. The purpose underlying both the copyright and patent statutes is to incentivize a more optimal amount of intellectual creations—expressions and inventions—that would otherwise be underproduced.<sup>173</sup> Using expressions or inventions to engage in unlawful activity, however, results in costly negative externalities to the public.<sup>174</sup> Unlawfully distributing legal obscenity (in *Mitchell*) results in harms to society which the market does not internalize—as does unlawfully tying a patented product to the purchase of another product (in *Morton Salt*).<sup>175</sup> In the situations posed under both *Mitchell* and *Morton Salt*, the purpose of the monopoly—to achieve a more optimal output of the intellectual creation—becomes

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<sup>170</sup>*Id.* at 493 (citations omitted) (emphasis added).

<sup>171</sup>*Id.* at 494 (emphasis added).

<sup>172</sup>*See id.*

<sup>173</sup>*See* WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 13–14, 19 (2003).

<sup>174</sup>*See* SNOW, *supra* note 30; Ned Snow, *Content-Based Copyright Denial*, 90 *INDIANA L.J.* 1473, 1512–14 (2015).

<sup>175</sup>*See generally* SNOW, *supra* note 174.

frustrated because the market does not account for externalities of the unlawful activity.<sup>176</sup> Hence, the public interest at issue in *Mitchell* does in fact concern the purpose of the copyright statute.<sup>177</sup>

#### 4. *Stone & McCarrick v. Dugan Piano Co.*

Prior to *Mitchell*, the Fifth Circuit applied unclean hands in the copyright context where the plaintiff had not personally injured the defendant.<sup>178</sup> The case was *Stone & McCarrick v. Dugan Piano Co.*,<sup>179</sup> which incidentally remains good law in the Fifth Circuit, for only a Supreme Court decision or an en banc circuit decision can overrule circuit precedent.<sup>180</sup> In *Stone & McCarrick*, the plaintiff created advertisements for piano businesses to use in selling their pianos to the public.<sup>181</sup> The defendant was a piano seller who had used the plaintiff's advertisements without permission.<sup>182</sup> The advertisements, however, were misleading and deceptive because they made claims about pianos that would not necessarily be true for every piano dealer selling pianos.<sup>183</sup> Notably, though, the plaintiff's misconduct did not harm the defendant; indeed, the misleading and deceptive advertisements benefited the defendant.<sup>184</sup> Nevertheless, the Fifth Circuit recognized the unclean hands defense.<sup>185</sup> The plaintiff's act of creating advertisements that had a tendency "to mislead and deceive the public" was sufficient to deny copyright protection.<sup>186</sup> The fact that the plaintiff's conduct offended the public interest

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<sup>176</sup>See *id.*; *Morton Salt*, 314 U.S. at 493; *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 863–64 (5th Cir. 1979).

<sup>177</sup>*Cf.* *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388, 392–93 (2006) (recognizing that copyright is given by the public and courts should consider that fact in awarding injunctive relief).

<sup>178</sup>See *Stone & McCarrick v. Dugan Piano Co.*, 220 F. 837 (5th Cir. 1915).

<sup>179</sup>*Id.*

<sup>180</sup>See *United States v. Traxler*, 764 F.3d 486, 489 (5th Cir. 2014) ("It is a well-settled Fifth Circuit rule of orderliness that one panel of our court may not overturn another panel's decision, absent an intervening change in the law, such as by a statutory amendment, or the Supreme Court, or our en banc court."). *But see* 5 PATRY, *supra* note 48, § 17:127 (citing to *Mitchell* for the proposition that "*Stone & McCarrick* was, however, subsequently overruled by the Fifth Circuit").

<sup>181</sup>220 F. at 838.

<sup>182</sup>*Id.* at 837.

<sup>183</sup>See *id.* at 842.

<sup>184</sup>See *id.* at 842–43.

<sup>185</sup>See *id.*

<sup>186</sup>*Id.*

mattered more than whether the defendant was personally injured.<sup>187</sup> Thus, the reasoning of *Stone & McCarrick* dictates a different outcome in *Mitchell*.

Recognizing that *Stone & McCarrick* was an obstacle to its holding, the *Mitchell* court made a point to undermine the legitimacy of that case.<sup>188</sup> The *Mitchell* court argued that *Stone & McCarrick* “is plainly unacceptable under modern precedents.”<sup>189</sup> Specifically, the *Mitchell* court interpreted the Supreme Court case of *Morton Salt* as foreclosing *Stone & McCarrick*’s broad public-interest rationale for denying copyright.<sup>190</sup> In fact, the exact opposite is true. The *Morton Salt* Court explicitly approved of *Stone & McCarrick* in its opinion, relying on *Stone & McCarrick* as support for its own holding.<sup>191</sup> The *Morton Salt* Court stated:

for application of the like doctrine in the case of copyright, *Edward Thompson Co. v. American Law Book Co.*, 122 F. 922, 926; *Stone & McCarrick v. Dugan Piano Co.*, 220 F. 837, 841–843. The patentee, like these other holders of an exclusive privilege granted in the furtherance of a public policy, may not claim protection of his grant by the courts where it is being used to subvert that policy.<sup>192</sup>

The *Morton Salt* Court could not be clearer here. The Court explicitly recognized that the copyright owner in *Stone & McCarrick* could “not claim protection of his grant” because his intellectual creation was “being used to subvert [a public] policy,” namely, the policy supporting the copyright grant.<sup>193</sup> Hence, while *Mitchell* decried *Stone & McCarrick* for being

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<sup>187</sup> *See id.*

<sup>188</sup> *See* 604 F.2d 852, 863–64 (5th Cir. 1979).

<sup>189</sup> *Id.* at 864. The *Mitchell* court also claimed that *Stone & McCarrick* “erroneously read” a Supreme Court case, *Manhattan Med. Co. v. Wood*, 108 U.S. 218 (1883). *See Mitchell*, 604 F.2d at 864 n.25. In *Manhattan Medicine*, the Supreme Court denied trademark protection because a mark made a false statement about who manufactured the good. *See* 108 U.S. at 219–21. The *Manhattan Medicine* Court explained that if it did not deny protection “a deception would be practiced upon the public and the very fraud accomplished.” *Id.* at 223. That was the same possibility that the *Stone & McCarrick* court faced—deception and fraud—and like *Manhattan Medicine*, *Stone & McCarrick* also concerned false advertising. It is therefore puzzling that *Mitchell* characterized *Stone & McCarrick*’s reliance on *Manhattan Medicine* as “erroneous.”

<sup>190</sup> 604 F.2d at 864 n.25.

<sup>191</sup> 314 U.S. 488, 494 (1942).

<sup>192</sup> *Id.*

<sup>193</sup> *Id.*

“unacceptable” under *Morton Salt*,<sup>194</sup> *Morton Salt* sanctioned *Stone & McCarrick* as an “application of the like doctrine in the case of copyright.”<sup>195</sup> *Mitchell*’s claim is demonstrably false.

### B. Copyright Act

In addition to incorrectly interpreting the unclean hands doctrine as requiring that a plaintiff personally injure a defendant, the *Mitchell* court incorrectly interpreted the 1909 Copyright Act as barring application of the unclean hands doctrine to obscene works.<sup>196</sup> Under *Mitchell*’s reasoning, even if a copyright owner had personally injured a defendant with the obscene work, the Act would still preclude application of unclean hands.<sup>197</sup> That is not correct.

The *Mitchell* court’s interpretation of the Act is flawed for three reasons. First, the court reached its conclusion by incorrectly framing the issue to be about the Act’s scope of coverage rather than the conduct of copyright owners.<sup>198</sup> Second, even assuming the scope of coverage were somehow relevant to the application of unclean hands, the *Mitchell* court’s construction of the 1909 Copyright Act (as extending protection to obscenity) stands in conflict with evidence of the 1909 Congress’s intent.<sup>199</sup> Third, the Act expressly calls for courts to apply equitable doctrines in the enforcement of copyright.<sup>200</sup> These three reasons are discussed in the subsections below.

#### 1. Incorrect Framing

The *Mitchell* court justified its refusal to apply unclean hands on the ground that the 1909 Copyright Act extends copyright protection to “all the writings of an author.”<sup>201</sup> Reasoning that this all-inclusive language necessarily applies to obscenity, the court concluded that the district court was “not authorized by Congress” to apply unclean hands because its

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<sup>194</sup>*Mitchell*, 604 F.2d at 864.

<sup>195</sup>*Morton Salt*, 314 U.S. at 494.

<sup>196</sup>*See* 604 F.2d at 854–58.

<sup>197</sup>*See id.*

<sup>198</sup>*See* discussion *infra* Part III.C.2.

<sup>199</sup>*See* discussion *infra* Part III.C.3.

<sup>200</sup>*See* discussion *infra* Part III.C.1.

<sup>201</sup>*Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 854 (5th Cir. 1979) (quoting 17 U.S.C. § 4 (1970) (repealed)).

application would “frustrate” the statute.<sup>202</sup> In the court’s words: “Creating a defense of obscenity—in the name of *unclean hands* or through any other vehicle—adds a defense not authorized by Congress that may, as discussed above, actually frustrate the congressional purpose underlying an all-inclusive copyright statute.”<sup>203</sup> Stated differently, the court reasoned that the all-inclusive language of the Act created a presumption against doctrines that would deny enforcement for certain works, so unless Congress specifically authorized such doctrines, they would frustrate the purpose of the statute.<sup>204</sup>

This reasoning reflects an incorrect framing of the issue about whether unclean hands may apply. Recall that the unclean hands doctrine enables a court to deny relief based on unlawful conduct of a plaintiff.<sup>205</sup> The doctrine does not alter the rights of the plaintiff (or in the copyright context, the scope of the content protected); it changes only the remedy to which a plaintiff may be entitled.<sup>206</sup> So, regardless of the content under consideration, if the plaintiff engages in wrongful conduct, a court may invoke unclean hands to deny relief.<sup>207</sup> Unclean hands, then, condemns the unlawful act of distributing obscene content; it does not bar protection because of the content per se. Accordingly, a copyright owner may receive copyright protection for obscene material just so long as he does not use it to commit an unlawful act. He can, for instance, exercise his right to stop an infringer from reproducing his obscene work (assuming that he himself has not unlawfully distributed the work).<sup>208</sup> In short, the issue of whether to apply unclean hands concerns whether the copyright owner has engaged in unlawful conduct—not whether

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<sup>202</sup> *Id.* at 861.

<sup>203</sup> *Id.* (emphasis added).

<sup>204</sup> *See id.*

<sup>205</sup> *See generally* McKennon v. Nashville Banner Publ’g Co., 513 U.S. 352, 360 (1995) (“[A] suitor who engaged in his own reprehensible conduct in the course of the transaction at issue must be denied equitable relief because of unclean hands.”).

<sup>206</sup> *See id.*; 5 PATRY, *supra* note 48, § 17:127 (reciting doctrine of unclean hands in copyright context).

<sup>207</sup> The validity of this proposition is evident by the fact that in none of the Supreme Court cases that applied unclean hands in the patent context did the Court examine the content of the patent application. *See* Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co., 324 U.S. 806 (1945); Hazel-Atlas Glass Co. v. Hartford-Empire Co., 322 U.S. 238 (1944), *overruled on other grounds by* Standard Oil Co. v. United States, 429 U.S. 17 (1976); Morton Salt Co. v. G.S. Suppiger Co., 314 U.S. 488 (1942); Keystone Driller Co. v. Gen. Excavator Co., 290 U.S. 240 (1933) (denying relief for manufacturing false evidence).

<sup>208</sup> *See generally* 17 U.S.C. § 106 (2016) (providing a copyright owner with the right to preclude others from making unauthorized reproductions).



Congress intended to protect specific content. The unclean hands defense is not inconsistent with the Act's statement that "all the writings of an author" are eligible for copyright protection.

A simple example illustrates the distinction between a copyright owner's conduct and the scope of copyright protection as they relate to the application of unclean hands. Consider a photographer who takes a picture of an unsuspecting neighbor in a private setting (say, the neighbor is using the toilet) and then publishes that picture in a newspaper. The picture would definitely receive copyright protection: it is original and fixed in a tangible medium of expression.<sup>209</sup> Yet regardless of that fact, the photographer committed the tort of invasion of privacy by publicly displaying private facts within the picture.<sup>210</sup> He would have exercised his copyright right of public display in a way that is unlawful, so if he sought to enforce his copyright against an infringer, unclean hands would warrant denying him enforcement of his rights. The fact that his picture receives copyright protection would not be relevant to the application of unclean hands. Put simply, unclean hands focuses on whether conduct is lawful—not on whether content is copyrightable.

In contrast to this focus of unclean hands, the *Mitchell* court focused on reasons that obscene content should receive copyright protection.<sup>211</sup> The court recited a principle articulated by the Supreme Court in *Bleistein v. Donaldson Lithographing Co.* that judges should not assess the value of content in order to determine copyright eligibility.<sup>212</sup> Relying on this principle of nondiscrimination from *Bleistein*, the *Mitchell* court reasoned that by protecting obscenity, Congress would ensure that judges would not subjectively assess a work's value.<sup>213</sup> Yet even if that is true, it has nothing to do with whether the *Mitchell* defendants used their copyright rights in an unlawful manner. The application of unclean hands depends on actions of the copyright owner—not the content per se. Specifically, publicly performing

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<sup>209</sup> See *id.* § 102 ("Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression.").

<sup>210</sup> See RESTATEMENT (SECOND) OF TORTS § 652D (AM. LAW INST. 1977) ("One who gives publicity to a matter concerning the private life of another is subject to liability to the other for invasion of his privacy, if the matter publicized is of a kind that (a) would be highly offensive to a reasonable person, and (b) is not of legitimate concern to the public.").

<sup>211</sup> See 604 F.2d 852, 855–58 (5th Cir. 1979).

<sup>212</sup> See *id.* at 856 (relying on *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903)).

<sup>213</sup> See *id.*

or distributing obscene content triggers unclean hands. Although judges may need to examine content in order to identify whether an unlawful act has occurred (such as identifying whether content is fraudulent, defamatory, or obscene), the examination is not for the purpose of determining whether the content deserves copyright protection as much as it is to identify unlawful conduct. Indeed, judges must examine such content to determine unlawful conduct in those other causes of actions (i.e., fraud, defamation, and obscenity). Hence, *Mitchell's* recitation of *Bleistein's* nondiscrimination principle is misplaced.<sup>214</sup>

The upshot here is that the *Mitchell* court incorrectly framed the issue as concerning whether the Copyright Act includes obscene content. Whether the Act encompasses that content is irrelevant to whether a court should apply the unclean hands defense. A proper framing of the issue examines whether the plaintiff engaged in wrongful conduct.

## 2. Congressional Intent

Putting aside the fact that unclean hands does not concern the scope of the Act's coverage, there are problems with the *Mitchell* court's interpretation of the 1909 Act as extending to obscenity. The central support for the *Mitchell* court's conclusion that the Act encompasses obscene works is the Act's language that copyright extends to "all the writings of an author."<sup>215</sup> Yet that statement in the Act cannot be literally true: in 1909 and at the time of *Mitchell*, courts did not recognize protection for various categories of "writings," including obscenity, even though the 1909 Act did not expressly exclude those categories.<sup>216</sup> Courts did not extend protection to

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<sup>214</sup> Another example illustrates the *Mitchell* court's incorrect framing of the issue as whether the 1909 Congress intended to include obscenity as copyrightable content. The court argued that the rules for determining obscenity do not correspond well with determining whether works should receive copyright protection. *Id.* at 856. The court stated: "Obscenity law is a concept not adapted for use as a means for ascertaining whether creative works may be copyrighted." *Id.* Yet law that defines whether a copyright owner's conduct is unlawful has nothing to do with identifying whether a work is copyrightable. Invasion of privacy, defamation, and fraud are not adapted to ascertain whether content should be copyrighted. And they are all laws that would trigger unclean hands in the copyright context. Hence, it never makes sense to define copyrightable content according to laws that define unlawful conduct. How does that fact suggest that unclean hands should not apply?

<sup>215</sup> *See id.* at 854.

<sup>216</sup> *See, e.g.*, 2 JOSEPH STORY, COMMENTARIES ON EQUITY JURISPRUDENCE 603–04 (1884) ("In the first place, no copyright can exist, consistently with principles of public policy, in any work of a clearly irreligious, immoral, libelous, or obscene description.").

writings that were not original,<sup>217</sup> to writings whose idea merged with its expression,<sup>218</sup> and at the time of *Mitchell*, to writings that could not be identified separately from a utilitarian article.<sup>219</sup> So unless well-established bodies of law are ignored, the Act's purported protection for "all the writings of an author" simply could not mean *all* writings.<sup>220</sup> By construing "all the writings" literally, the *Mitchell* court ignored the law, along with the likely intent of the 1909 Congress.

In further support of its interpretation of the 1909 Act, the *Mitchell* court offered criticisms of obscenity law as a reason that the 1909 Congress would have intended to extend copyright protection to obscene works.<sup>221</sup> The court explained one criticism of obscenity law as follows: "It is an awkward, barely acceptable concept that continues to dog our judicial system and society at large."<sup>222</sup> But there is no support for the conclusion that the 1909 Congress held this view. Congress had enacted federal obscenity law in 1873, and it had never indicated any intent to change that law up through 1909 (and beyond).<sup>223</sup> Similarly, another criticism that the *Mitchell* court raised was that the definition of obscenity depended on local community standards.<sup>224</sup> Yet this local-community-standards definition did not enter the law until well after 1909, so the criticism could not reflect the view of the 1909 Congress.<sup>225</sup> Thus, these criticisms are not grounded in evidence suggesting a view of the 1909 Congress. They must indicate the court's own view.

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<sup>217</sup> See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58–59 (1884) (explaining requirement for originality in copyright law).

<sup>218</sup> See *Baker v. Selden*, 101 U.S. 99, 103 (1880) (articulating merger doctrine in copyright law).

<sup>219</sup> See 37 C.F.R. § 202.10(c) (1959); 37 C.F.R. § 202.8(a) (1949).

<sup>220</sup> In addition to failing to note these exceptions to protection for "all the writings of an author," the 1909 Act did not codify the fair use doctrine. See *Cambridge Univ. Press v. Patton*, 769 F.3d 1232, 1258 n.19 (11th Cir. 2014) ("Fair use was originally a common law doctrine that Congress codified in the Copyright Act of 1976."). Like the exceptions to protection, the common law defense of fair use existed despite the Act's silence.

<sup>221</sup> See 604 F.2d 852, 856 (5th Cir. 1979).

<sup>222</sup> *Id.*

<sup>223</sup> Act of March 3, 1873, ch. 258, 17 Stat. 598. See also 18 U.S.C. § 1464 (2016) (criminalizing the broadcast of obscene material).

<sup>224</sup> See 604 F.2d at 858 (relying on *Miller v. California*, 413 U.S. 15 (1973), to criticize obscenity defense in copyright owing to local-community standards that define meaning of obscenity).

<sup>225</sup> See *Roth v. United States*, 354 U.S. 476, 490–91 (1957) (adopting community-standard rationale to define obscenity).

The *Mitchell* court also argued that the 1909 Congress would have viewed denial of protection for obscenity as “antithetical to promotion of creativity,” and that “[t]he purpose underlying the constitutional grant of power to Congress” represents “an invitation to creativity.”<sup>226</sup> Although it is true that pornography is creative (as is fraud, for that matter), there is no support for the view that the 1909 Congress viewed creativity as the ultimate purpose of copyright. Indeed, courts and commentators uniformly agreed around the time of the 1909 Act that promoting the progress of science was the ultimate aim of copyright law, and moreover, that obscenity failed to promote that progress.<sup>227</sup> Because this view was so well accepted at that time, it would seem unreasonable for the 1909 Congress not to have held this view as well. The *Mitchell* court offered no evidence that the 1909 Congress would have deemed creativity for the sake of creativity as the purpose of copyright, or for that matter, that obscenity would promote the progress of science.

### 3. Statutory Recognition of Unclean Hands

The *Mitchell* court interpreted the 1909 Copyright Act as not authorizing the application of the unclean hands defense and that applying it would “frustrate the congressional purpose” of the Act.<sup>228</sup> This is incorrect. The Act specifically stated that courts “shall have power” to grant injunctions “according to the course and principles of courts of equity, on such terms as

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<sup>226</sup> See 604 F.2d at 856 (“[I]f Congress were receptive to subject matter restrictions on copyright, there are many reasons why it would be unlikely to choose obscenity as one of those restrictions. . . . Such restraints [such as an obscenity restriction], if imposed, would be antithetical to promotion of creativity.”).

<sup>227</sup> See, e.g., *Barnes v. Miner*, 122 F. 480, 489–90 (C.C.S.D.N.Y. 1903) (denying protection for obscene work because it was not “of a nature to ‘promote the progress of science’”); *Clayton v. Stone*, 5 F. Cas. 999, 1003 (C.C.S.D.N.Y. 1829) (No. 2872) (“The term science cannot, with any propriety, be applied to a work of so fluctuating and fugitive a form as that of a newspaper or pricecurrent [sic], the subject-matter of which is daily changing, and is of mere temporary use.”); EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES, EMBRACING COPYRIGHT IN WORKS OF LITERATURE AND ART, AND PLAYRIGHT IN DRAMATIC AND MUSICAL COMPOSITIONS 198–99, 209 (1879) (opining that Congress enacted copyright laws pursuant to its power “to promote the progress of science” and recognizing that the purpose of copyright is “to promote learning and useful knowledge”).

<sup>228</sup> See 604 F.2d at 861 (“Creating a defense of obscenity in the name of unclean hands or through any other vehicle adds a defense *not authorized by Congress* that may, as discussed above, actually frustrate the congressional purpose underlying an all-inclusive copyright statute.”) (emphasis added).

said court or judge may deem reasonable.”<sup>229</sup> That is, the 1909 Congress explicitly authorized courts to apply equitable doctrines in deciding whether to grant injunctive relief.<sup>230</sup> According to the leading treatise on equity at the time of the 1909 Act (Pomeroy), the doctrine of unclean hands represents a “universal rule affecting the entire administration of equity jurisprudence.”<sup>231</sup> Hence, when the Act refers to “principles of courts of equity,” that must include the doctrine of unclean hands.<sup>232</sup>

The *Mitchell* court was therefore incorrect in claiming that the application of unclean hands would “frustrate the congressional purpose” of the Act.<sup>233</sup> The court was ignoring the Act’s express endorsement of courts applying principles of equity. In short, applying unclean hands would effectuate—not frustrate—the Act.

### C. Policy Arguments

The *Mitchell* court set forth three policy reasons against applying unclean hands.<sup>234</sup> It articulated one reason while arguing that unclean hands requires that a defendant be personally injured, and two other reasons while arguing that the 1909 Congress intended to extend copyright protection to obscene content.<sup>235</sup> Its three policy reasons are the following: first, the application of the unclean hands defense would lead to absurd and unacceptable results; second, it would fragment the rights of copyright owners; and third, it could produce outdated rulings given that moral norms change.<sup>236</sup> As discussed in the three subsections below, these policy reasons lack substance.

Before addressing these three policy reasons, I note that the *Mitchell* court failed to address the most obvious policy reason *for* applying unclean hands. Enforcing a copyright where the copyright owner has exercised her rights in

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<sup>229</sup> Act of March 4, 1909, Pub. L. No. 60-349, § 36, 35 Stat. 1075, 1084.

<sup>230</sup> *See id.*

<sup>231</sup> 1 POMEROY, *supra* note 42, § 398, at 434.

<sup>232</sup> The current Copyright Act of 1976 retains such discretionary language. 17 U.S.C. § 502 (2016). (“Any court having jurisdiction of a civil action arising under this title *may* . . . grant temporary and final injunctions on such terms *as it may deem reasonable* to prevent or restrain infringement of a copyright.”) (emphasis added). In *eBay Inc. v. MercExchange, LLC*, the Supreme Court indicated that this language in the 1976 Act allows courts to apply principles of equity. *See* 547 U.S. 388, 392–93 (2006).

<sup>233</sup> 604 F.2d at 861.

<sup>234</sup> *See id.* at 857–58, 864.

<sup>235</sup> *See id.*

<sup>236</sup> *See id.*

an unlawful way serves to condone and incentivize unlawfulness.<sup>237</sup> Resources of the government should not be employed to encourage conduct that the government has condemned.<sup>238</sup> Simply put, such an unproductive use of public resources is not in the public interest. Despite this obvious policy reason for applying unclean hands, the *Mitchell* court did not even acknowledge it.

### 1. Absurd and Unacceptable Results

The *Mitchell* court argued against the unclean hands defense on the basis that its application would lead to absurd and unacceptable results.<sup>239</sup> In the court's words: "It is immediately apparent that limiting copyright protection on a broad public injury rationale would lead to absurd and unacceptable results."<sup>240</sup> The court contended that application of unclean hands to the unlawful performance of obscenity (which did not injure the defendants) would mean that unclean hands would apply in any situation where a copyright owner committed an unlawful act that somehow involved his work.<sup>241</sup> According to the court, if the court were to apply the defense here, it would mean that the defense would apply where a copyright owner "failed to pay income taxes on revenue derived from the copyright," or where a copyright owner transported his work in a "truck that does not meet federal safety and pollution requirements."<sup>242</sup> "The possibilities are well nigh limitless," argued the court, so application of unclean hands would reflect bad policy.<sup>243</sup>

The problem with the court's analysis is that its hypothetical actions do not relate to the lawsuit in the same way that the actions of the *Mitchell* plaintiffs do. The plaintiffs distributed and performed the obscene work in an unlawful manner, and those actions correspond with the very rights that the plaintiffs were seeking to enforce. In other words, the plaintiffs had abused the rights that they were invoking in the lawsuit. For this reason, their unlawful actions related to the subject matter of the suit: they were attempting to enforce their rights that they had previously abused. By contrast, a

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<sup>237</sup> See *Devil Films, Inc. v. Nectar Video*, 29 F. Supp. 2d 174, 175 (S.D.N.Y. 1998).

<sup>238</sup> See *id.*

<sup>239</sup> See 604 F.2d at 864.

<sup>240</sup> *Id.*

<sup>241</sup> *Id.*

<sup>242</sup> *Id.*

<sup>243</sup> *Id.*

copyright owner has not abused his rights if he were to fail to pay taxes on copyright revenue from his work or if he were to transport his work in a truck that fails to comply with safety regulations. These hypothetical unlawful actions, which the court cited, do not comprise a reproduction, a distribution, or a display of the work, or a preparation of a derivative work. The hypothetical actions are therefore completely unrelated to a copyright owner's rights and to the process of creating the work. They represent "extraneous transgressions," unconnected to the subject matter of a copyright infringement lawsuit.<sup>244</sup> Thus, applying the unclean hands defense in *Mitchell* would not have implied the "absurd and unacceptable results" suggested by the court.

## 2. Fragmentation

Perhaps the most cited policy reason that unclean hands should not apply to acts involving obscenity is *Mitchell*'s fragmentation argument.<sup>245</sup> Simply put, the argument is that applying unclean hands would fragment the rights of copyright owners based on different jurisdictional definitions of obscenity.<sup>246</sup> The *Mitchell* court explained:

Since what is obscene in one local community may be non-obscene protected speech in another, and the copyright statute does not in other respects vary in its applicability from locality to locality, Congress in enacting an obscenity exception [for copyright] would create the dilemma of choosing between using community standards that would (arguably unconstitutionally) fragment the uniform national standards of the copyright system and venturing into the uncharted waters of a national obscenity standard.<sup>247</sup>

Three years after *Mitchell*, the Ninth Circuit expressed a similar sentiment in *Jartech, Inc. v. Clancy*: "Acceptance of an obscenity defense would fragment copyright enforcement, protecting registered materials in a certain

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<sup>244</sup> *Cf.* *Keystone Driller Co. v. Gen. Excavator Co.*, 290 U.S. 240, 245 (1933) (observing that unclean hands should not be applied for "extraneous transgressions").

<sup>245</sup> *See* 604 F.2d at 858 (articulating fragmentation argument). Several courts have relied on this argument. *See, e.g.*, *Flava Works, Inc. v. Gunter*, 689 F.3d 754, 756 (7th Cir. 2012); *Jartech, Inc. v. Clancy*, 666 F.2d 403, 406 (9th Cir. 1982); *Pillsbury Co. v. Milky Way Prods., Inc.*, No. C78-679A, 1981 WL 1402, at \*9 n.10 (N.D. Ga. Dec. 24, 1981).

<sup>246</sup> *See Mitchell*, 604 F.2d at 858.

<sup>247</sup> *Id.*

community, while, in effect, authorizing pirating in another locale.”<sup>248</sup> Then three decades after *Jartech*, the Seventh Circuit resurrected this passage from *Jartech* while considering whether a pornographic work was copyrightable.<sup>249</sup> Three appellate courts have thus viewed the fragmentation of copyright rights as reason to refrain from applying unclean hands in the obscenity context.

This reliance on the fragmentation argument by three federal circuit courts does not change the conclusion that the argument is specious. The argument relies on the premise that copyright enforcement would vary according to whether certain actions are defined as unlawful in different jurisdictions.<sup>250</sup> That premise is simply not true. Enforcement is possible regardless of whether a jurisdiction deems actions that correspond with copyright rights to be unlawful. This is because, as a general matter, intellectual property rights are “negative” in nature, meaning that a rights-holder may only exclude others from engaging in certain actions.<sup>251</sup> A rights-holder does not hold a right to affirmatively perform those actions herself.<sup>252</sup> Accordingly, a rights-holder may enforce her rights even in a jurisdiction that deems an action corresponding to her right as being unlawful: she enforces her right by excluding others from committing the unlawful act.<sup>253</sup> She can therefore enforce her rights of exclusion in any jurisdiction, regardless of whether any jurisdiction defines an act to be unlawful. Jurisdictional differences do not fragment her rights to exclude others.

This principle of negative rights is well established in patent law.<sup>254</sup> Admittedly, however, in copyright law, the Copyright Act could be

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<sup>248</sup> 666 F.2d at 406.

<sup>249</sup> See *Flava Works*, 689 F.3d at 756.

<sup>250</sup> See *Mitchell*, 604 F.2d at 858.

<sup>251</sup> See 35 U.S.C. § 154 (2015) (articulating patent right as a right to “exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States”); *Clouding IP, LLC v. Google Inc.*, 61 F. Supp. 3d 421, 429 n.6 (D. Del. 2014) (“The core exclusionary right of a patent is the negative right of a ‘patentee.’”); *Toracco v. Port Auth. of N.Y. & N.J.*, 615 F.3d 129, 146 n.6 (2d Cir. 2010) (Wesley, J., concurring) (“Copyright is, in fact, only a negative right to prevent the appropriation of the labours of an author by another.” (quoting *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 n.16 (2d Cir. 1951))).

<sup>252</sup> See *Patterson v. Kentucky*, 97 U.S. 501, 503 (1878) (recognizing power of State to punish conduct corresponding to right of intellectual property rights-holder).

<sup>253</sup> See 17 U.S.C. § 106 (2016) (articulating exclusive rights of copyright owner).

<sup>254</sup> See *Patterson*, 97 U.S. at 503 (1878); DANIEL BREAN & NED SNOW, *PATENT LAW: FUNDAMENTALS OF DOCTRINE AND POLICY* 25 (2020) (explaining patent as a “negative right to exclude”).



interpreted to suggest that a copyright comprises positive rights.<sup>255</sup> Specifically, the Act states that “the owner of copyright . . . has the exclusive rights *to do* and to authorize any of the following [actions].”<sup>256</sup> A right “to do” the actions suggests that the copyright owner has an affirmative right to perform those actions.<sup>257</sup> However, this reading of the statute cannot be correct. Besides the fact that courts and scholars agree that copyright is a negative right,<sup>258</sup> if copyright were a positive right, that would undermine well-established bodies of common law. The common law makes certain types of expression unlawful—such as defamatory and libelous expression—and thereby enjoins that expression from occurring.<sup>259</sup> Yet if copyright were a positive right, it would give a speaker of defamatory expression an affirmative right to speak that expression publicly.<sup>260</sup> State defamation law would be in direct conflict with federal copyright law. And if there is ever a conflict between state common law and federal statutory law, federal statutory law prevails.<sup>261</sup> In short, if copyright were a positive right, it would undermine centuries of common law; copyright must be a negative right.

In summary, the fact that copyright is a negative right implies that a requirement that copyright owners obey the individual laws of all jurisdictions does not affect their ability to enforce their rights in all those jurisdictions. If they refrain from using their copyrighted works to commit an unlawful act in any particular jurisdiction, they can enforce their rights in every jurisdiction. Specifically, they can legally compel others to cease committing actions that correspond with the actions covered by their rights.

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<sup>255</sup> See 17 U.S.C. § 106 (2016).

<sup>256</sup> *Id.* (emphasis added).

<sup>257</sup> See *id.*

<sup>258</sup> See *Toracco v. Port Auth. of N. Y. & N. J.*, 615 F.3d 129, 146 n.6 (2d Cir. 2010) (Wesley, J., concurring); *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 n.16 (2d Cir. 1951); Dennis S. Karjala & Robert K. Paterson, *The Case Against Property Rights in Old Intangible Indigenous Cultural Property*, 15 NW. J. TECH. & INTELL. PROP. 1, 15 (2017) (“[I]t is standard intellectual property dogma that the exclusive rights are *negative*, that is, they give the legal power to prevent others from using the work but do not give an affirmative right to use it in any and all circumstances.”); Alexander B. Pope, *A Second Look at First Sale: An International Look at U.S. Copyright Exhaustion*, 19 J. INTELL. PROP. L. 201, 205 (2011) (“Intellectual property rights, particularly copyrights, provide their holders with a number of negative rights, which allow one to prevent others from taking specific actions.”).

<sup>259</sup> See *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 269 (1964).

<sup>260</sup> See 17 U.S.C. § 106 (2016) (providing rights to publicly perform and distribute expression).

<sup>261</sup> See *generally Int’l Paper Co. v. Ouellette*, 479 U.S. 481, 491–94 (1987) (discussing the development of preemption doctrine).

On the other hand, if copyright owners use their copyrighted works to commit an unlawful act in any jurisdiction, their rights become unenforceable in every jurisdiction. In that situation, they cannot legally compel anyone to cease infringing actions. Hence, applying unclean hands based on differing state laws would not affect the enforceability of rights in different jurisdictions. There is no possibility that a copyright owner's rights could ever be enforceable in one jurisdiction but not in another.

As a counterargument to this conclusion, one might argue that the fact that a copyright is a negative right implies that unlawful acts committed by a copyright owner are extraneous to any claims that the copyright owner brings against an infringer. In other words, because copyright owners do not hold rights to affirmatively perform any actions, one might argue that their affirmative unlawful actions do not actually concern their intellectual property rights. Because a copyright owner cannot exercise his rights by affirmatively performing an unlawful act, a copyright owner's affirmative unlawful actions may seem unrelated to a lawsuit in which the copyright owner seeks to enforce negative rights.

The response to this counterargument is that a copyright owner's affirmative unlawful actions are indeed relevant to a lawsuit in which he seeks to enforce his negative right. The lawsuit to enforce his negative right represents his attempt to employ that right to profit from his unlawful activity. He employs his negative right to exclude others in order to further the fruits of his own affirmative unlawful act. Technically, then, rather than saying "a copyright owner unlawfully exercises his right to perform a work," we should say "a copyright owner exercises his right to exclude others from performing a work in order to profit from his own affirmative performance of that work, which performance is an unlawful act." For the sake of brevity, though, we simply say the former statement rather than the latter. Yet regardless of these semantics, the relevant point is that even though a negative right does not provide the copyright owner a right to affirmatively perform an unlawful act, his negative right makes his performance of that unlawful act much more profitable for him. Simply put, employment of the negative right to further an unlawful purpose amounts to an abuse of the right. The copyright owner's unlawful act is not a mere extraneous transgression.

Lastly, even if copyright consisted of positive rights to affirmatively perform actions, the application of unclean hands based on a particular jurisdiction's law would do no more to fragment rights of a copyright owner

than First Amendment law already does.<sup>262</sup> A copyright owner's First Amendment right to speak obscene expression is already fragmented across jurisdictions.<sup>263</sup> Tellingly, courts apply obscenity restrictions even though the restrictions fragment speech rights.<sup>264</sup> This means that denying copyright enforcement based on the jurisdictional definition of obscenity ensures that the application of copyright and First Amendment law are consistent across jurisdictions. Stated differently, denial of enforcement according to jurisdictional definitions of obscenity ensures that copyright law does not incentivize behavior that is inconsistent with obscenity restrictions on speech. Jurisdictional incongruity, then, does not arise from applying unclean hands according to individual jurisdictional definitions of obscenity. Indeed, incongruity between copyright and speech laws arises from failing to apply unclean hands according to those individual jurisdictional definitions.<sup>265</sup>

Thus, the fragmentation argument is specious. Recall the Fifth Circuit's articulation of that argument in *Mitchell*: an obscenity defense would "fragment the uniform national standards of the copyright system" such that the copyright statute would "vary in its applicability from locality to locality."<sup>266</sup> Recall a similar argument articulated by the Ninth Circuit and reiterated by the Seventh Circuit: "an obscenity defense would fragment copyright enforcement, protecting registered materials in a certain community, while, in effect, authorizing pirating in another locale."<sup>267</sup> These statements are not correct. A copyright owner who does not engage in unlawful conduct may enforce his rights against any infringer in every locality whether or not his work is deemed to be legally obscene.<sup>268</sup> Unclean hands does not "fragment the uniform national standards of the copyright system"; rather, it allows for uniform application of the right to exclude.<sup>269</sup>

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<sup>262</sup> See *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, No. 3-74-645, 1976 U.S. Dist. LEXIS 13396, at \*11-16 (N.D. Tex. Sept. 2, 1976), *rev'd*, 604 F.2d 852 (5th Cir. 1979).

<sup>263</sup> See *id.*

<sup>264</sup> See generally *Roth v. United States*, 354 U.S. 476, 491-92 (1957) (discussing the various jurisdictional definitions for obscenity and holding that they did not "offend constitutional safeguards" for protected speech nor did they fail to provide "adequate notice of what is prohibited").

<sup>265</sup> *Contra Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 858 (5th Cir. 1979).

<sup>266</sup> See *id.* at 858.

<sup>267</sup> *Flava Works, Inc. v. Gunter*, 689 F.3d 754, 756 (7th Cir. 2012); *Jartech, Inc. v. Clancy*, 666 F.2d 403, 406 (9th Cir. 1982).

<sup>268</sup> See discussion *supra* Part III.D.2.

<sup>269</sup> *Mitchell*, 604 F.2d at 858.

Unclean hands does not “vary in its applicability from locality to locality”;<sup>270</sup> rather, it applies the same in every locality: it consistently requires the copyright owner to obey every locality’s law. Unclean hands does not “protect[] registered materials in a certain community, while, in effect, authorizing pirating in another locale”; rather, it is consistent with copyright’s protection of all registered materials in every community.<sup>271</sup> Whether a copyright owner obeys or violates local laws, unclean hands treats the rights the same in every jurisdiction: either they are enforceable everywhere or nowhere. There is no fragmentation of rights.

### 3. Changing Morals

The *Mitchell* court argued that Congress intended to extend copyright protection to obscenity because moral standards change over time.<sup>272</sup> The court explained:

[I]f Congress were receptive to subject matter restrictions on copyright, there are many reasons why it would be unlikely to choose obscenity as one of those restrictions. . . . Society’s view of what is moral and immoral continually changes. . . . It is obvious that many works shocking to the sensibilities of the public in 1920 would be entirely inoffensive today [in 1979]. Denying copyright protection to works adjudged obscene by the standards of one era would frequently result in lack of copyright protection (and thus lack of financial incentive to create) for works that later generations might consider to be not only non-obscene but even of great literary merit. Many works that are today held in high regard have been adjudged obscene in previous eras.<sup>273</sup>

In short, the court cited changing-moral standards as evidence that Congress would have intended to protect obscenity.<sup>274</sup>

As a practical matter, a premise of the court’s argument is difficult to swallow. Are we to believe that hard-core pornography—the sort of material

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<sup>270</sup> *Id.*

<sup>271</sup> *Jartech*, 666 F.2d at 406.

<sup>272</sup> 604 F.2d at 856–57.

<sup>273</sup> *Id.*

<sup>274</sup> *See id.*

that exists for the sole purpose of sexually stimulating its audience with explicit and graphic content—might someday be held in high regard for its artistic merit? The court is essentially teaching that this logical possibility suggests that Congress is wise to extend copyright protection to such material. The possibility begs practical reason. As already discussed, this could not have been the thinking of the 1909 Congress.

But that is beside the point. Here, I address the logic of the court's argument, ignoring its impracticality. The logic is flawed because application of unclean hands does not forever deny protection for once-unlawful conduct involving a work. Rather, the defense ceases to apply when the conduct is no longer unlawful.<sup>275</sup> As moral norms change, laws change, and unclean hands no longer applies to actions involving certain works. Hence, a change in the law that makes actions lawful means that past actions of copyright owners that resulted in the suspension of their rights will no longer have that effect. So even assuming that today's obscene material could become valuable art in the future (which is a rather dubitable assumption), this would mean that its performance would not be unlawful in the future; unclean hands would not apply at that time. Hence, *Mitchell's* changing-moral rationale is no reason to withhold application of unclean hands. The application is fluid based on changes in norms and laws.

In sum, *Mitchell's* reasoning is seriously flawed. To review, the *Mitchell* court incorrectly interpreted the unclean-hands doctrine as requiring personal injury to the defendant so as to disregard injuries to the public.<sup>276</sup> The interpretation conflicts with Supreme Court decisions in the patent law context, and it is inconsistent with Fifth Circuit precedent in *Stone & McCarrick*—a case that the Supreme Court expressly endorsed as a correct application of unclean hands.<sup>277</sup> The *Mitchell* court misread the 1909 Copyright Act as precluding application of unclean hands in the case before it: the court incorrectly focused on the Act's extensive protection of content rather than analyzing the defendants' unlawful conduct;<sup>278</sup> the court interpreted the Act as literally prohibiting any exception to its coverage of "all" writings—a blatant contradiction of established copyright doctrines;<sup>279</sup>

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<sup>275</sup> See 5 PATRY, *supra* note 48, § 17:127 ("Where unclean hands is established, it is a complete defense to the infringement action and any future actions *until the unclean hands conduct is cured.*" (emphasis added)).

<sup>276</sup> See discussion *supra* Part III.B.

<sup>277</sup> See discussion *supra* Part III.B.

<sup>278</sup> See discussion *supra* Part III.C.2.

<sup>279</sup> See discussion *supra* Part III.C.3.

the court suggested that the 1909 Congress would have thought that obscenity laws “dog our judicial system and society at large” despite evidence suggesting a contrary view by the 1909 Congress;<sup>280</sup> and the court misinterpreted the Act as restricting a court’s equitable powers, even though the Act expressly authorized all those powers.<sup>281</sup> Lastly, the court cited policy arguments about absurd and unacceptable results, fragmentation of enforcement, and changing moral standards, yet each of these arguments is demonstrably flawed.<sup>282</sup>

Taken together, the errors in the *Mitchell* court’s reasoning suggest not merely a problem of judicial competency. They suggest a problem of credibility. The court seemed determined to protect obscenity— notwithstanding the law.

#### IV. UNCLEAN HANDS GOING FORWARD

Courts should no longer follow the teachings of *Mitchell*. Instead, courts should recognize that they may apply the unclean hands defense where a copyright owner has engaged in an unlawful act that relates to the subject matter of the litigation. To be clear, unlike the *Mitchell* court’s approach, this proposed rule does not require that the copyright owner’s unlawful conduct have injured the defendant.<sup>283</sup> As discussed in Part III.B, injury to the defendant is not necessary because the copyright monopoly is “given by the public.”<sup>284</sup> By seeking to enforce that publicly given monopoly, the copyright owner has made relevant to the lawsuit those unlawful acts that directly relate to the rights he is seeking to enforce. The public’s interest in granting the copyright is offended by the copyright owner’s unlawful acts that directly relate to the enforcement of that copyright.

This conclusion raises an obvious question. What sorts of actions by a copyright owner directly relate to the enforcement of her rights? The Court in *Keystone Driller* set forth a general standard:

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<sup>280</sup> See discussion *supra* Part III.C.3.

<sup>281</sup> See discussion *supra* Part III.C.1.

<sup>282</sup> See discussion *supra* Part III.D.

<sup>283</sup> Cf. *Gilead Scis., Inc. v. Merck & Co.*, 888 F.3d 1231, 1240–43 (Fed. Cir. 2018) (applying unclean hands based on misconduct toward a third party by a patent attorney, who was responsible for drafting claims in the inventor’s patent application).

<sup>284</sup> See *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388, 392 (2006); discussion *supra* Part II.A.2.

[Courts] apply the maxim requiring clean hands only where some unconscionable act of one coming for relief has *immediate and necessary relation to the equity that he seeks* in respect of the matter in litigation. They do not close their doors because of plaintiff's misconduct, whatever its character, that has no relation to anything involved in the suit, but only for such violations of conscience as *in some measure affect the equitable relations between the parties* in respect of something brought before the court for adjudication. They apply the maxim, not by way of punishment for extraneous transgressions, but upon considerations that make for the advancement of right and justice. They are not bound by formula or restrained by any limitation that tends to trammel the free and just exercise of discretion.<sup>285</sup>

Here, the Court explained that there must be an “immediate and necessary relation” between the claimant’s misconduct and the relief that he is seeking, and that the misconduct must “in some measure affect the equitable relations between the parties.” Unfortunately, the Court did not provide any further guidance on the sorts of situations that would constitute an “immediate and necessary relation” or that would “affect the equitable relations between the parties.” Rather, the Court merely stated that courts may apply this doctrine through “the free and just exercise of discretion.” Subsequently in *Morton Salt*, the Court faced the same question, and it observed that “additional considerations must be taken into account” where the suit concerns the “public interest.”<sup>286</sup> Yet the Court never explicated those “additional considerations.” In short, the Court has not delineated a meaningful answer to the question posed above.

Although this lack of guidance does ensure flexibility and discretion for courts to apply equitable defenses, some guidance appears necessary to ensure that courts properly account for the public interest. The question must

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<sup>285</sup> See generally *Keystone Driller Co. v. Gen. Excavator Co.*, 290 U.S. 240, 245 (1933) (opining that unclean hands cannot apply unless a plaintiff’s actions have an “immediate and necessary” connection to the lawsuit).

<sup>286</sup> *Morton Salt*, 314 U.S. at 493 (“Undoubtedly equity does not demand that its suitors shall have led blameless lives, but additional considerations must be taken into account where maintenance of the suit concerns the public interest as well as the private interests of suitors.”).

therefore be further considered: What circumstances suggest that an unlawful act triggers the public's interest in a copyright lawsuit?

My answer to this question is that a copyright owner's unlawful actions are sufficiently related to the public's interest in the enforcement of a copyright if they occur in the process of creating a work or in the exercise of rights to a work. This conclusion follows from the fact that the public extends the copyright monopoly to incentivize actions that effectuate the creation and dissemination of works.<sup>287</sup> With respect to dissemination, most rights in a copyright involve acts of dissemination (i.e., reproduction, distribution, performance).<sup>288</sup> Accordingly, when an author performs unlawful actions as part of his process of creation, or when he performs unlawful actions in exercising his rights in a work, the copyright monopoly would effectively be incentivizing those unlawful actions. The author would either be committing unlawful actions to gain the publicly given monopoly, or he would be using the publicly given monopoly to commit unlawful actions. Either situation is contrary to the public's interest in extending copyright protection. Simply put, incentivizing unlawful actions is contrary to the public interest.<sup>289</sup>

Thus, the public's interest in a copyright suit suggests two categories of actions that should trigger unclean hands: unlawful actions committed during the process of creating a work and unlawful actions committed in the exercise of rights.<sup>290</sup> The Sections below discuss these categories.

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<sup>287</sup> See *Golan v. Holder*, 565 U.S. 302, 325–26 (2012) (recognizing creation and dissemination of works as fulfilling constitutional purpose of copyright law).

<sup>288</sup> See 17 U.S.C. § 106 (2016) (listing rights of copyright owners, including reproduction, distribution, performance, display, and derivative works). It is debatable whether the right to prepare derivative works concerns dissemination. See *id.*

<sup>289</sup> Consistent with this conclusion, case law recognizes that the unclean hands defense applies where a copyright owner commits fraud before the Copyright Office or commits copyright misuse by extending the monopoly beyond the scope of the statutory grant. See *Atari Games Corp. v. Nintendo of Am. Inc.*, 975 F.2d 832, 846 (Fed. Cir. 1992); *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 976–77 (4th Cir. 1990); discussion *supra* Part II.A.1 (observing that these specific circumstances that trigger the unclean hands defense do not affect a more general application of the defense). These circumstances support the principle that wrongful conduct in the procurement of rights (fraud before the Copyright Office) or in the exercise of rights (copyright misuse) should trigger unclean hands. The discussion in this Part, though, focuses on the circumstance of any unlawful action that a copyright owner commits either during the creative process or in the exercise of rights.

<sup>290</sup> Owing to the influence of *Mitchell's* reasoning, some courts have ruled in ways that are inconsistent with this interpretation of the unclean hands doctrine. See, e.g., *Malibu Media v. Doe*, No. 13–11432, 2014 WL 2616902, at \*3 (E.D. Mich. June 12, 2014) (refusing to recognize unclean hands where the producer of a pornographic film did not comply with record-keeping requirements



### A. *Unlawful Actions in the Process of Creation*

The public's interest in a copyright lawsuit suggests against enforcing the rights where the author has committed unlawful actions as part of the creative process. This category of disqualifying actions thus consists of unlawful creative efforts. For example, consider a creator of a pornographic film who directs a male actor to batter a female actress while the creator records the action. The unlawful battery occurs in the process of creating the pornographic film, so the public interest warrants against enforcement of the copyright.<sup>291</sup>

This category of unlawful actions raises three issues. First, how should a court determine whether a creator's unlawful act is part of the creative process? Suppose that an artist steals paints in order to create a masterpiece painting. Would her act of theft be considered part of the creative process that led to the completed painting?

Second, which jurisdiction defines lawfulness? Suppose that a person records a private conversation without the other person being aware of the recording. In some but not all jurisdictions, the recording would be unlawful.<sup>292</sup> Which jurisdiction's law should govern in deciding whether an action is unlawful so as to deny copyright enforcement?

Third, what other factors should courts consider where a creator has engaged in an unlawful act as part of the creative process? Suppose that J.K. Rowling had written part of the Harry Potter series on paper napkins that she inadvertently stole from a restaurant.<sup>293</sup> Do other factors suggest that a court should still enforce her copyright despite her unlawful act?

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for performers under 18 U.S.C. § 2257); *Survivor Prods. LLC v. Fox Broad. Co.*, No. CV01-3234 LGB (SHX), 2001 WL 35829270, at \*3-5 (C.D. Cal. June 12, 2001) (refusing to apply unclean hands where film creators allegedly manipulated results in outcome of television show, in violation of 47 U.S.C. § 509); *Broderbund Software, Inc. v. Unison World, Inc.*, 648 F. Supp. 1127, 1138 (N.D. Cal. 1986) (refusing to apply unclean hands where copyright owner allegedly infringed another's copyright in creating its own work).

<sup>291</sup>For purposes of this example, we must assume that any consent by the female model is not effective, which assumption the law supports. *See infra* note 292.

<sup>292</sup>*Compare* CAL. PENAL CODE § 632(a) (2020) (requiring consent of all parties to a conversation for lawful recording), *with* N.Y. PENAL LAW §§ 250.00, 250.05 (2019) (authorizing recording of conversation if one party to the conversation consents).

<sup>293</sup>*See* Emma-Victoria Farr, *JK Rowling: 10 Facts About the Writer*, TELEGRAPH (Sep. 27, 2012 12:00 AM), at <https://www.telegraph.co.uk/culture/books/booknews/9564894/JK-Rowling-10-facts-about-the-writer.html> ("On a delayed train from Manchester to London in 1990, Rowling wrote her initial Potter ideas on a napkin.").

The subsections below consider these three issues.

### 1. Scope of Actions Covered

Which actions of an author are part of the creative process? In copyright, the process of creating a copyrightable work consists of a person fixing an original subject of thought into a tangible medium.<sup>294</sup> Therefore, an unlawful act would appear to be part of the creative process if the author commits the act (or is responsible for committing the act) during the process of fixing the subject of thought. Consider the example mentioned above: a creator of a pornographic film directs a male actor to batter a female model while filming. The battery represents an unlawful act that the creator instigates for the purpose of creating the subject matter of the recording, and the act occurs during the process of fixing that pornographic subject matter into the tangible medium of the film.<sup>295</sup> Hence, the director's instigation of the unlawful act would be part of the creative process.

The same conclusion would apply where a person rents out his home and secretly films the occupants.<sup>296</sup> The act of surveilling the unsuspecting persons would constitute a violation of their privacy, an intrusion upon seclusion.<sup>297</sup> That unlawful act would occur during the recording of the

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<sup>294</sup> 17 U.S.C. § 102 (2016); *see also* *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1008 (2017) (“And a work of authorship is ‘fixed’ in a tangible medium of expression when it is embodied in a material object from which the work can be perceived, reproduced, or otherwise communicated.”) (internal quotations omitted).

<sup>295</sup> This assumes that any consent to the battery would not be a defense. *See* *People v. Samuels*, 58 Cal. Rptr. 439, 447 (Ct. App. 1967) (ruling that consent was not a defense to aggravated assault, where defendant filmed an allegedly consensual beating); *id.* (“[C]onsent of the victim is not generally a defense to assault or battery, except in a situation involving ordinary physical contact or blow incident to sports . . .”). For a detailed discussion of the approaches taken by various jurisdictions, *see* W.E. Shipley, Annotation, *Consent as Defense to Charge of Criminal Assault and Battery*, 58 A.L.R.3d 662 (1974).

<sup>296</sup> *E.g.*, Ben Popken, *At an Airbnb? You Might Be on Camera, Whether You Like It or Not*, NBC NEWS (Mar. 7, 2019, 4:20 PM), <https://www.nbcnews.com/tech/security/airbnb-you-might-be-camera-whether-you-it-or-not-n974776>.

<sup>297</sup> *See, e.g.*, *Miller v. Nat'l Broad. Co.*, 232 Cal. Rptr. 668, 678–80 (Ct. App. 1986) (discussing development of invasion of privacy law in light of new technology); *see also* Amended Complaint & Demand for Jury Trial at 6–7, *Schumacher v. Airbnb, Inc.*, No. 4:15-cv-05734-CW, 2016 WL 11499624 (N.D. Cal. July 21, 2016) (alleging Airbnb guests were secretly filmed in the living areas, resulting in the recording of plaintiff while undressed and of private discussions including “many highly personal matters, which included financial matters, the nature of their relationship, and essentially, private and intimate details that a couple discusses in private”).

subject matter, so it would be part of the creative process. Finally, consider a creator who records himself murdering someone.<sup>298</sup> The unlawful act occurs while the murderer is fixing the subject matter (the murder) into a tangible medium. As part of the creative process, the murder would trigger the public interest in not enforcing the copyright.

What about an author's unlawful actions that serve to develop his subject of thought prior to his fixing that subject of thought into a tangible medium? For instance, suppose that a man cruelly beats a female model so that he can subsequently photograph her bruised body. Should his unlawful act prior to the act of taking the picture be considered part of the creative process, sufficient to deny enforcement? Although it might seem so, unlawful actions that occur prior to the act of fixation do not appear sufficiently connected to the creative process. Such unlawful actions may arise entirely independent of the decision to fix that subject into a tangible medium, and furthermore, those actions may occur long before the fixation decision. For instance, consider a person who commits a robbery, exercising original thought in deciding how to execute his plan; then ten years later, the person decides to write a book about how to prevent people from committing robberies. His prior act of robbery would inform his thoughts about the content of his book on robbery prevention, so in that sense, his unlawful act is not unrelated to his creation. Yet he committed his unlawful act independent of his decision to write the book. For that reason, his unlawful act seems too remote from the process of creation. Indeed, to a certain extent, any prior experience might inform future thoughts, some of which may become the subject of fixation. Judging which past acts affect future thoughts invites subjectivity and indeterminacy. Hence, unlawful acts committed prior to the act of fixation should not be considered part of the process that leads to the copyrighted expression.<sup>299</sup> Those unlawful acts should not be the basis for denying enforcement.

This principle raises interesting issues where an author commits an unlawful act to procure material for fixing the subject of his thought. Consider a graffiti artist who paints a building without permission from the

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<sup>298</sup> E.g., Olivia Solon, *Six Months After Christchurch Shootings, Videos of Attack Are Still on Facebook*, NBC NEWS (Sept. 20, 2019, 9:58 AM), <https://www.nbcnews.com/tech/tech-news/six-months-after-christchurch-shootings-videos-attack-are-still-facebook-n1056691>.

<sup>299</sup> Nor would unlawful acts committed *after* the act of fixation be part of the creative process. Hence, a person who writes an email about a criminal act that she intends to commit in the future would not have unclean hands with respect to her copyright in the email. Similarly, if the author creates expression for use in a future crime (say, a kidnapper writes a ransom note prior to the kidnapping), the author has not committed an unlawful act as part of the fixation process.

building owner. The fixation of the subject matter (the graffiti design) into a tangible medium (the building) involves the graffiti artist committing a trespass on the building. The unlawful act occurs simultaneous with the act of fixation, so his trespass should be considered part of the creative process.<sup>300</sup> Yet would this conclusion also be true where an artist steals paints and canvas in order to create a painting? On the one hand, the unlawful act of stealing the paint and canvas occurs prior to the act of fixing the paint on the canvas. From that perspective, the unlawful act of theft would not seem part of the creative process. On the other hand, trespass to chattel is a continuing tort: while in possession of the stolen property, the artist is committing the tort of trespass.<sup>301</sup> So in using the stolen paints or canvas during the act of fixation, the artist is committing an unlawful act of trespass. Like an artist who trespasses in order to fix his graffiti design, an artist who employs stolen paints or canvas commits an unlawful act during the creative process. Unclean hands could apply in either situation.

Now suppose an artist creates digital artwork using software that he copied in violation of a copyright owner's rights. Although the situation may seem analogous to a person who uses stolen paints and canvas, it is not. Infringement of a copyright is not a continuing tort like trespass to a physical chattel: copyright infringement occurs only at the point in time when a person copies, distributes, or publicly displays or performs a work.<sup>302</sup> Copying the software, then, would certainly be an unlawful act, but that act would not occur at the time that the artist is using the software to create the digital painting. The unlawful copying would not be part of the fixation process. Hence, only if the artist engages in an act of copying while painting on the digital canvas would he infringe the copyright. In the hypothetical stated

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<sup>300</sup>This is not to say that graffiti should not receive copyright protection. See Celia Lerman, *Protecting Artistic Vandalism: Graffiti and Copyright Law*, 2 N.Y.U. J. INTELL. PROP. & ENT. L. 295 (2013); Danwill Schwender, *Promotion of the Arts: An Argument for Limited Copyright Protection of Illegal Graffiti*, 55 J. COPYRIGHT SOC'Y U.S.A. 257 (2008). My argument is that unclean hands should apply where the artist commits the unlawful act of trespass to create the graffiti, but that is not always the case. See, e.g., *Castillo v. G&M Realty L.P.*, 950 F.3d 155, 167–68 (2020) (recognizing copyright protection in graffiti that was created with the permission of building owner).

<sup>301</sup>See generally RESTATEMENT (SECOND) OF TORTS § 162 cmt. c-e (1965) (discussing when a trespass to land is considered a continuing tort); *id.* § 218–20 (discussing liability in trespass to chattel as continuing in certain circumstances).

<sup>302</sup>See 17 U.S.C. §§ 106, 501(a) (2016).

above, that does not appear to be occurring.<sup>303</sup> As a result, the artist should not be denied enforcement of her rights to her digital artwork, which was created with software that she unlawfully copied.

If an unlawful act is merely incidental to fixing a subject matter into a tangible medium, then enforcing the copyright would do nothing to incentivize or reward that act. Enforcement, then, should not be denied. For example, suppose that a person makes an oral recording of himself telling a story and he does so while trespassing on someone else's land. Because the recording is only oral, it is unlikely that his trespass would affect the subject matter of what is being fixed in the oral recording. If that is the case, the unlawful act would not be part of the process of fixing the subject matter (the words that he speaks) into the tangible medium (the oral recording); the act would not be part of the creative process. By contrast, if the recording includes a visual component, such that it includes a view from the land on which the author is trespassing, then the trespass would be necessary to portray that view. The unlawful act would directly affect the subject matter of the creation, so the act would be part of the creative process.

What if the unlawful act results from a mistake of fact? For instance, suppose that an artist mistakenly (but reasonably) believes that an owner of a canvas has consented to the artist using the canvas to create a painting. Under tort law, the artist's mistake of fact would not be a defense to his tortious trespass to chattel.<sup>304</sup> Tort law imposes strict liability to shift the loss from the injured party to the injuring party.<sup>305</sup> In the context of tort law, this shift of loss makes sense: as between two innocent parties, the burden of loss should lie with the party committing the harmful act—even if the fault was based on a mistaken belief. But here, in the context of enforcing intellectual property rights, that rationale does not hold true. Denying enforcement of the copyright does not alleviate the victim's loss. Nor does enforcing the copyright deprive the victim of compensation for her loss. Moreover, enforcing intellectual property rights would neither incentivize the artist to

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<sup>303</sup>One court has held that a person creates an infringing copy when he loads computer software into the memory of a computer (loading the program copies the code into the computer's RAM memory). *See MAI Sys. Corp. v. Peak Comput., Inc.*, 991 F.2d 511, 518–19 (9th Cir. 1993). Not all courts agree with this holding. *See London-Sire Recs., Inc. v. Doe 1*, 542 F. Supp. 2d 153, 175 n.29 (D. Mass. 2008). Yet even assuming that loading the program into RAM memory constitutes an act of infringement, the separate act of creating the painting occurs after loading the program into the memory—albeit close in time.

<sup>304</sup>*See* RESTATEMENT (SECOND) OF TORTS § 217 cmt. c (1965).

<sup>305</sup>*See generally* Richard Epstein, *A Theory of Strict Liability*, 2 J. LEGAL STUDIES 151 (1973).

engage in conduct that is unlawful nor reward him for having engaged in that conduct: in the mistake-of-fact situation, the artist's mistaken fact implies that he did not deliberately choose to engage in unlawful conduct. Simply put, a creator cannot be incentivized to engage in conduct that he is unaware of; he cannot be rewarded for a choice that he never made. Thus, a reasonable mistaken fact that incorrectly suggests the lawfulness of conduct should excuse the creator's unlawful act, such that he should be able to enforce his copyright.

Enforcement also should not be denied if the author of the work is not responsible for unlawful acts that comprise the subject matter of her work. If the author is not responsible for the acts, enforcing the author's copyright would not incentivize or reward those acts. Consider a passerby who records a criminal beating. Although the criminal beating comprises an unlawful act, the passerby who fixes that subject matter is not responsible for that act. Denying the passerby enforcement of her copyright would not serve to incentivize or reward the criminal beating. Hence, unlawful acts of other persons, which a creator independently records, would not be disqualifying events.<sup>306</sup>

## 2. Jurisdiction

A criticism of denying protection for unlawful works is that there could be a multiplicity of definitions for unlawfulness given the disparities between individual state laws as well as federal law. Who is to say what is unlawful? The answer to this question is that the definition of an unlawful act depends on which jurisdiction the action occurs in. If the creative process involves actions that are legal in the state in which they occur (as well as legal under

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<sup>306</sup> Although independent unlawful acts that an author captures in a fixed medium should not be considered part of the creative process, unlawful actions of an actor in creating a film should be attributable to the film's director or producer even where the director or producer did not specifically direct that the unlawful action occur—in certain circumstances. Specifically, I propose that the unlawful actions should be attributable if the director or producer profits from the actor's actions and the director or producer has a right and ability to control those actions. This proposed test for imputing the actor's actions to the author aligns with the test for vicarious infringement. Vicarious infringement arises when "the right and ability to supervise coalesce with an obvious and direct financial interest in the exploitation of copyrighted materials—even in the absence of actual knowledge that the copyright monopoly is being impaired." *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307 (2d Cir. 1963).

federal law), the actions are not unlawful for purposes of denying enforcement.<sup>307</sup>

An example illustrates this simple principle. Suppose a car driver seeks to create a video of himself driving 80 mph. He creates the video in a jurisdiction, say Massachusetts, where the highest speed limit for a public road is 65 mph.<sup>308</sup> He thus acts unlawfully in the process of creating the video. But in other jurisdictions, such as Utah, cars may legally drive up to 80 mph on certain roads.<sup>309</sup> Nevertheless, because the car driver in this example commits the unlawful act in Massachusetts, he may be denied copyright enforcement under unclean hands. He would not face this possibility had he created the same video in Utah on a road permitting him to drive 80 mph.

The principle underlying this geographical distinction in denying enforcement is that creators should respect the rule of law that applies in whichever jurisdiction they create their work. There is good reason to apply unclean hands merely based on the geographical setting of the creation: wherever disobedience to the law occurs, the law should not encourage or reward the disobedience.

### 3. Other Factors

As mentioned above, unclean hands is a flexible doctrine, affording considerable discretion to courts in deciding whether to apply it.<sup>310</sup> Recognizing that the flexible nature of an equitable defense precludes rigid rules, I propose three factors that courts should consider in addition to the public interest in incentivizing and rewarding only lawful conduct. These factors are consistent with general principles that guide the application of unclean hands.<sup>311</sup>

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<sup>307</sup> See, e.g., *Malibu Media, LLC v. Doe*, No. 13 C 3648, 2014 WL 2581168, \*3–4 (N.D. Ill. June 9, 2014) (recognizing that unclean hands may apply where conduct at issue is violation of federal law).

<sup>308</sup> See MASS. GEN. LAWS ch. 90, § 17A (2019).

<sup>309</sup> See *Utah Driving Laws*, VISITUTAH.COM, <https://www.visitutah.com/plan-your-trip/getting-around-utah/utah-driving-laws/> (last visited July 27, 2020).

<sup>310</sup> See generally *Keystone Driller Co. v. Gen. Excavator Co.*, 290 U.S. 240, 245 (1933) (explaining that in applying unclean hands, “[courts] are not bound by formula or restrained by any limitation that tends to trammel the free and just exercise of discretion”); discussion *supra* Part IV.

<sup>311</sup> See ANENSON, *supra* note 46, at 49–50, 55–57.

One factor is the nature and severity of the wrongdoing of the claimant.<sup>312</sup> Courts should recognize that every unlawful act does not equally offend the public interest. Unintentional trespassing and slightly speeding should not be treated the same as murder and torture. Accordingly, in evaluating whether an unlawful act should result in a denial of enforcement, courts should weigh the severity of the unlawful act. Acts that constitute violent crimes, that are felonies, or that violate human rights should weigh heavily against enforcing the copyright. The acts are so reprehensible that the law should never incentivize or reward them. By contrast, actions that impose minimal harmful consequences to others, such as misdemeanors and some tortious acts, may be excused if other factors suggest enforcing the rights.

Another factor is the claimant's actions to remedy the act of unlawfulness.<sup>313</sup> To the extent that an author has rectified the consequences of her unlawful acts, courts should consider this fact in deciding whether to enforce her rights. In assessing the act of restitution, courts might consider whether the author voluntarily paid compensation, or alternatively, whether a legal action compelled her to pay. As an example, consider the artist who trespasses on a building when he creates graffiti design. If the artist subsequently pays the building owner for a license to paint his art on the building, his remedial action would favor recognizing enforcement of his rights.

A third factor is the low value of the work to the public.<sup>314</sup> Courts should consider this factor only in extreme situations, for judicial evaluation of the worth of a work invites subjective viewpoints on expressive thought. Only if facts indicate a clear public harm caused by a work should courts consider this factor. More particularly, this factor should be considered only if the expression under consideration lacks First Amendment protection. A bedrock tenet of copyright law is that, outside of the "narrowest and most obvious" situations, judges should not decide whether to extend copyright protection

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<sup>312</sup>*See generally id.* at 50 ("A trial court typically has discretion to consider the seriousness of the conduct and its relation to the case in tandem rather than determine each element in isolation.").

<sup>313</sup>*See generally id.* at 56 ("[P]art of a trial court's discretion is to account for all the circumstances, including any mitigating factors, before deciding that unclean hands defeats a plaintiff's remedy.").

<sup>314</sup>*See generally id.* at 55 ("Judges may expand or contract the unclean hands defense in the public interest.").



to content based on their opinion of the content's value.<sup>315</sup> Expression that lacks First Amendment protection, such as legal obscenity or defamation, would fall within the exception for the narrowest and most obvious situations. Accordingly, if this factor is considered in the obscenity context, it would only give further reason not to enforce the copyright.

Thus, in addition to considering the public interest in incentivizing and rewarding only lawful conduct, courts should also consider three other factors that affect the public's interest in enforcing copyright. Courts should consider whether the unlawful activity is severe, whether the creator has remedied the consequences of his unlawful act, and whether the work is of such low value to the public that it does not receive First Amendment protection. Taken together, these other factors may outweigh or further support the public interest in not incentivizing and rewarding unlawful activity.

### *B. Unlawful Actions Corresponding to Rights*

The public interest suggests against a court enforcing a copyright if the author, after having created her work, commits an unlawful action that corresponds with one of the rights to the work.<sup>316</sup> This situation contemplates the actions of the author (or licensee) after the author has fixed the original thought in a tangible medium. If the author engages in an unlawful action after having completed the work, and that unlawful action corresponds to one of the actions covered by her exclusive rights, the public interest warrants against the author being able to enforce her rights.

In this situation, the denial of enforcement would only suspend the copyright owner's rights.<sup>317</sup> The rights would initially exist, but during the

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<sup>315</sup>See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”).

<sup>316</sup>This application of unclean hands is broader than the doctrine of copyright misuse. Under that specific application of unclean hands, courts cancel the intellectual property rights where the intellectual property owner uses the rights to prevent competition. See, e.g., *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 979 (4th Cir. 1990); *Microsoft Corp. v. Comput. Support Servs. of Carolina, Inc.*, 123 F. Supp. 2d 945, 955 (W.D.N.C. 2000).

<sup>317</sup>See Robert A. Matthews, Jr., 4 ANNOTATED PATENT DIGEST § 27:131.50 (2020) (“While a finding of unclean hands may prevent a patentee from enforcing a patent against a particular defendant in a particular case, it generally does not destroy the patent such that the patent becomes unenforceable against the world if the unclean hands does not relate to acts in obtaining the patent (unless, of course, other accused infringers can themselves prove unclean hands).”); 5 PATRY, *supra*

time that the copyright owner is exercising her rights in a way that violates a law (in the jurisdiction where the act occurs), her rights would be suspended (in all jurisdictions). During that time, if someone commits an act of infringement, the copyright owner would not be able to obtain relief. Yet as soon as the copyright owner ceases the unlawful activity, she could enforce her rights with respect to any future acts of infringement. Hence, the denial of enforcement would not necessarily be permanent.

### 1. Scope of Actions Covered

A copyright comprises rights covering the reproduction of the work, preparation of a derivative of the work, distribution of copies of the work to the public, and public performance or display of the work.<sup>318</sup> So if a copyright owner commits an unlawful act corresponding to the activities covered by these rights, that act would be a disqualifying event. For instance, suppose a copyright owner steals copying equipment to reproduce copies of a book that he has created. During the time that he unlawfully uses the copying equipment to reproduce the work (which corresponds to his right of reproduction), the copyright owner could not enforce his rights. Another example would be a copyright owner of a film creating a sequel to the film (which corresponds to his right to prepare derivative works) and in doing so, he incorporates another's copyrighted work into the sequel without permission (which is an unlawful act of infringement). While exercising his right to prepare the derivative work, he is engaging in an unlawful act. Unclean hands would apply.

These examples do not imply that copyrighted expression that facilitates unlawful actions necessarily results in a suspension of rights. Consider, for instance, a copyright owner's distribution of a copyrighted book that advocates for unlawful violence, and suppose that a book purchaser engages in those acts because he agrees with the book's message. The purchaser's unlawful acts would not result in the suspension of the copyright owner's rights because the unlawful acts in question were not committed by the

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note 48, § 17:127 ("Where unclean hands is established, it is a complete defense to the infringement action and any future actions until the unclean hands conduct is cured.").

<sup>318</sup>See 17 U.S.C. § 106. In the case of sound recordings, the right of public performance only extends to digital audio transmissions. *See id.*

copyright owner.<sup>319</sup> Likewise, even if the copyright owner himself were to engage in the violence for which he advocated in his book, his acts of violence would not be reason to suspend his rights: the violence would not correspond with any actions covered by the rights that he holds in his copyright. In short, for the rights to be suspended, the copyright owner must have committed an unlawful act that corresponds with an action covered by his rights.

The analysis of unlawful acts that correspond with the rights of public distribution, public performance, and public display has an additional nuance. Actions corresponding with those rights may raise speech issues, for when a copyright owner is distributing, performing, or displaying a copyrighted work, she may be speaking a message within the content of the work. Simply put, the distribution, performance, and display of an expressive work comprise acts of speech.<sup>320</sup> This fact implies that if the unlawfulness of the distribution, performance, or display of the work is because of the work's content, a free-speech issue arises. More precisely, if a court refuses to enforce a copyright because the distribution, performance, or display of content is illegal, then that content necessarily must not be protected by the First Amendment.

Defamation and obscenity are common examples.<sup>321</sup> If a copyright owner places a defamatory work into public circulation, the copyright owner has committed an unlawful act which corresponds with his right of distribution.<sup>322</sup> The First Amendment does not protect the defamatory content, so a court's refusal to enforce his copyright rights in the content would be constitutionally permissible.<sup>323</sup> Similarly, a legally obscene film that is available for public viewing implies that its copyright owner has committed an unlawful act which corresponds with his right of public

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<sup>319</sup> See *Hess v. Indiana*, 414 U.S. 105, 108 (1973) (finding that the First Amendment extended protection to speech that may have advocated for lawless action, and noting that "at worst, it amounted to nothing more than advocacy of illegal action at some indefinite future time").

<sup>320</sup> See generally *Texas v. Johnson*, 491 U.S. 397, 404 (1989) ("In deciding whether particular conduct possesses sufficient communicative elements to bring the First Amendment into play, we have asked whether '[a]n intent to convey a particularized message was present, and [whether] the likelihood was great that the message would be understood by those who viewed it.'") (citing *Spence v. Washington*, 418 U.S. 405, 410–411 (1974)).

<sup>321</sup> See *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 283–84 (1964) (recognizing unprotected nature of defamatory expression that is made with actual malice); *Miller v. California*, 413 U.S. 15, 23–26 (1973) (recognizing unprotected nature of obscenity).

<sup>322</sup> See 17 U.S.C. § 106(3).

<sup>323</sup> See *N.Y. Times*, 376 U.S. at 283–84.

performance.<sup>324</sup> To publicly perform legally obscene material is an unlawful act which does not receive First Amendment protection.<sup>325</sup> A court's refusal to enforce the copyright would therefore be constitutional as a matter of free speech law. Thus, where a copyright owner's unlawful act corresponds to the rights of distribution, performance, and display, and where the unlawfulness of that act is based on the content of the work, that content must not be protected by the First Amendment for the copyright to be unenforceable.

## 2. Licensees

A licensee has authority granted from the copyright owner to exercise the rights of the copyright.<sup>326</sup> If the licensee holds an exclusive license, she has standing to sue for infringement.<sup>327</sup> Would unclean hands apply if that licensee has committed an unlawful act corresponding to one of the copyright rights? The answer is that unclean hands may apply (at the discretion of the court). In that situation, the exclusive licensee stands in the shoes of the original copyright owner, so unlawful acts by the licensee are just as damning for the licensee under the unclean hands doctrine. For instance, consider an author who grants an exclusive license to a publishing company to publish her book. Suppose that the book contains defamatory content and that the company knows this fact, but the company decides to publish the book anyway. The company has committed the tort of defamation,<sup>328</sup> and as a result, the public interest disfavors the company being able to enforce the copyright to the book against someone who copies it without permission.

Whereas an exclusive licensee has standing to enforce her rights, a non-exclusive licensee does not.<sup>329</sup> Because the non-exclusive licensee cannot enforce any rights, unclean hands would not apply to her. Nevertheless, the non-exclusive licensee's unlawful acts that correspond with rights in the copyright should affect the copyright owner's ability to enforce his rights. This is because the copyright owner can control the licensee's unlawful uses under the licensing agreement.<sup>330</sup> For instance, if a copyright owner of an

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<sup>324</sup> See 17 U.S.C. § 106(4).

<sup>325</sup> See *Miller*, 413 U.S. at 24–25.

<sup>326</sup> A licensee has been transferred a legal right from the copyright owner to exercise rights of the copyright. 2 PATRY, *supra* note 48, § 5:121.

<sup>327</sup> See *id.*

<sup>328</sup> See RESTATEMENT (SECOND) OF TORTS § 558 (1977).

<sup>329</sup> See 2 PATRY, *supra* note 48, § 5:127.

<sup>330</sup> See *id.*

obscene film grants to a theater a non-exclusive license to publicly perform that film, and the theater does so in violation of obscenity law, then the copyright owner should not be able to enforce his rights to the film. The copyright owner had the ability to require the theater not to commit any unlawful act in exercising the licensed rights. As a result of his failure to control the actions of the theater, the copyright owner should not be able to enforce his rights.<sup>331</sup>

### 3. Jurisdiction

Courts should determine whether a copyright owner's actions are unlawful based on the law of the jurisdiction where the copyright owner's act occurred. That is, unclean hands should apply if a copyright owner (or her licensee) has performed an unlawful act, which corresponds with one of her rights, according to the law of the jurisdiction in which she committed the act (under either state or federal jurisdiction). In that situation, the copyright owner should not be able to enforce any of her rights in any jurisdiction for the duration that the unlawful conduct continues in the relevant jurisdiction.

This jurisdictional point applies to only a relatively few works. The lawfulness of reproducing, publicly displaying or performing, and publicly distributing works are usually governed by the same legal definitions across all jurisdictions.<sup>332</sup> As mentioned above, only unprotected categories of speech, such as defamation or obscenity, are subject to differing definitions of unlawfulness.<sup>333</sup> And the laws of the states, for the most part, define these categories of speech the same.<sup>334</sup> Most states adopt the same common law meaning of libel or fraud, for instance.<sup>335</sup> Perhaps, though, communities have

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<sup>331</sup> *See id.*

<sup>332</sup> *See supra* Part III.D.2.

<sup>333</sup> *See cases cited supra* note 321.

<sup>334</sup> *See cases cited supra* note 321.

<sup>335</sup> Compare *Bellavia Blatt & Crossett, P.C. v. Kel & Partners LLC*, 151 F. Supp. 3d 287, 292 (E.D.N.Y. 2015) ("The elements of libel under New York law are: (1) a false and defamatory statement of fact concerning the plaintiff; (2) that was published by the defendant to a third party; (3) due to the defendant's negligence (or actual malice, depending on the status of the person libeled); and (4) special damages or 'per se' actionability."), with *Locricchio v. Evening News Ass'n*, 476 N.W.2d 112, 126 (Mich. 1991) ("A cause of action for libel encompasses four components: (1) a false and defamatory statement concerning the plaintiff, (2) an unprivileged communication to a third party, (3) fault amounting to at least negligence on the part of the publisher, and (4) either actionability of the statement irrespective of special harm or the existence of special harm caused by publication.").

varying standards that define obscenity.<sup>336</sup> But even then, media programming has become so accessible from a national scale, views of obscenity across communities seems to be much more uniform than when the Supreme Court introduced the community-standards test in 1973.<sup>337</sup> This is all to say that, as a practical matter, differing jurisdictional definitions of lawfulness are unlikely to arise in the context of defining unlawful acts that correspond with actions covered by the copyright rights.

Even if jurisdictional differences do arise, this fact would not fragment rights of copyright owners.<sup>338</sup> Copyright owners who obey the law of the jurisdiction in which they enforce their rights may always enforce those rights in all jurisdictions, regardless of whether the jurisdiction has defined actions as unlawful which correspond to their rights.<sup>339</sup> This is because the enforcement of rights consists only of excluding others from engaging in certain actions; as discussed above, intellectual property laws do not provide their holders rights to affirmatively perform actions with their works.<sup>340</sup> For instance, a copyright in an obscene work enables its owner to exclude others from performing that work in public, but the copyright does not provide him a right to perform the work publicly himself.<sup>341</sup> Suppose, then, that the copyright owner of that work never performs it in any jurisdiction that defines its performance to be unlawful (although perhaps he does perform it in other jurisdictions). In those jurisdictions that define its performance to be unlawful, the copyright owner can still enforce his rights in the work by excluding others from performing or copying it. Hence, a copyright owner's rights to exclude are enforceable regardless of whether a jurisdiction defines conduct to be unlawful.

Correlatively, if a copyright owner uses her expression to disobey even one state's law, then she cannot enforce any of her rights in any jurisdiction until she ceases her unlawful conduct.<sup>342</sup> In that situation, her rights are still not fragmented across jurisdictions. She simply cannot enforce her rights in

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<sup>336</sup> See *Miller v. California*, 413 U.S. 15, 30 (1973).

<sup>337</sup> See, e.g., *United States v. Kilbride*, 584 F.2d 1240, 1254 (9th Cir. 2009) (applying national contemporary standard to define obscenity with respect to material sent via the internet).

<sup>338</sup> This fragmentation argument was raised by the Fifth Circuit in *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 858 (5th Cir. 1979). In criticizing that court opinion, I address the argument in Part III.D.2.

<sup>339</sup> See discussion *supra* Part III.D.2.

<sup>340</sup> See discussion *supra* Part III.D.2.

<sup>341</sup> See generally 17 U.S.C. § 106(4).

<sup>342</sup> See discussion *supra* Part III.D.2.

any jurisdiction. In short, there is no situation where a copyright owner could enforce her rights to exclude others' conduct in only some jurisdictions.<sup>343</sup> Thus, this jurisdictional rule does not fragment a copyright owner's rights.

### C. *Practical Effect*

What would be the practical effect of applying unclean hands in the two categories of circumstances described above in Section A (unlawful acts that occur in the process of creation) and Section B (unlawful acts that correspond with a copyright right)? Although the examples discussed in those Sections contemplate a variety of situations in which unclean hands could apply, in practice, only a limited category of works would likely be affected. The two circumstances described above—unlawful actions that occur during the creative process and unlawful actions that correspond with a copyright right—contemplate many situations that, as a practical matter, simply would not arise in a copyright lawsuit. Indeed, as discussed below, the only sort of works that would likely be affected by these two circumstances (with any regularity) would be those which are obscene.

#### 1. Unlawful Acts in the Creative Process

With respect to unlawful actions committed during the creative process, two reasons suggest that many situations that would otherwise trigger unclean hands would not actually arise in a copyright lawsuit. The first reason is that unlawful activities in the creative process often result in works that portray those activities, so the works would serve as damning evidence against the author.<sup>344</sup> An author who recorded himself committing a felony will not likely show up to court trying to enforce a copyright to the damning evidence.<sup>345</sup> A murderer, for instance, will not likely seek to enforce a copyright to the video of his criminal act (assuming that he has not been caught, and if he has been caught, it seems doubtful that he will bother enforcing his copyright from jail). Alternatively, if the criminal does post it to social media, which some do, he will do so to experience notoriety, and

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<sup>343</sup> See discussion *supra* Part III.D.2.

<sup>344</sup> See discussion *supra* Part IV.A.1 (positing that the unlawful act must involve the process of fixing the subject matter into a tangible medium).

<sup>345</sup> Cf. Ryan Prior, *Prosecutors Say a Man Stole \$88,000 From a Bank Vault. The FBI Caught Him After He Flashed Stacks of Bills on Social Media*, CNN.COM (Dec. 14, 2019, 1:30pm ET), <https://www.cnn.com/2019/12/14/us/man-accused-of-stealing-from-bank-vault-facebook-post-trnd/index.html>.

consequently, not seek to enforce his copyright rights.<sup>346</sup> Hence, because works that portray severely unlawful acts create a record of the act, their creators are not likely to enforce the copyright to those works.

The second reason is that minimal infractions of the law can be difficult to ascertain and to prove.<sup>347</sup> Consider the example above involving an artist creating a painting with stolen paints.<sup>348</sup> How would an infringer of the painting know, much less prove, that the artist used stolen paints in the process of creating it? Or consider the examples of a person recording himself unlawfully driving 80 mph or trespassing on another's property.<sup>349</sup> An infringer of these works likely would not know that these acts involved unlawful activity, and even if she did know that fact, it could be difficult to prove. Minor infractions of law present ascertainment and proof issues that would inhibit the application of unclean hands.

Despite these reasons, one category of content would largely still be affected by the application of unclean hands. Hard-core pornographic works often involve acts of violence against female models during their creation.<sup>350</sup> Consent by the models is a dubitable defense.<sup>351</sup> Yet for whatever reason, the models do not raise allegations against their employers.<sup>352</sup> This means that pornographic works would not likely serve as damning evidence against its creator. No civil or criminal suits depend on the evidence.<sup>353</sup> Furthermore,

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<sup>346</sup> See Rick Noack, *Terrorists Crave Publicity. In the Age of Social Media, Can Notoriety Truly Be Denied?*, WASHINGTONPOST.COM (Mar. 19, 2019, 7:34am EDT), <https://www.washingtonpost.com/world/2019/03/19/terrorists-crave-publicity-age-social-media-can-notoriety-truly-be-denied/>.

<sup>347</sup> See discussion *supra* Part IV.A.1.

<sup>348</sup> See discussion *supra* Part IV.A.1.

<sup>349</sup> See discussion *supra* Part IV.A.1–2.

<sup>350</sup> Ana J. Bridges et al., *Aggression and Sexual Behavior in Best-Selling Pornography Videos: A Content Analysis Update*, 16(10) VIOLENCE AGAINST WOMEN 1065, 1075–77 (2010) (finding that 88.2% of all pornographic scenes sampled contained instances of physical aggression); see also discussion *supra* Part IV.A.1.

<sup>351</sup> See sources cited *supra* note 295.

<sup>352</sup> See Clay Calvert & Robert D. Richards, *Porn in Their Words: Female Leaders in the Adult Entertainment Industry Address Free Speech, Censorship, Feminism, Culture and the Mainstreaming of Adult Content*, 9 VAND. J. ENT. & TECH. L. 255, 281–87 (2006) (explaining reasons that female models continue to perform in pornography industry).

<sup>353</sup> Cf. Katie Van Syckle, *22 Women Say They Were Exploited by Porn Producers*, N.Y. TIMES (Aug. 29, 2019), <https://www.nytimes.com/2019/08/29/style/girls-do-porn-lawsuit-testimony.html> (indicating that, while significant on-set abuse occurs, the industry remains “opaque”).



the violent acts would not be difficult to ascertain or prove.<sup>354</sup> The discovery process would likely demonstrate that the creator of the work is responsible for the unlawful actions that occurred. In short, unclean hands would likely apply with regularity to hard-core pornographic works.

## 2. Unlawful Acts Corresponding to Rights

We now consider the sort of situations that would likely arise when a copyright owner commits unlawful acts that correspond with rights in the copyright. As discussed above, the copyright rights consist of the following: reproduction; preparation of derivative works; public distribution; and public performance and display.<sup>355</sup> Here, we consider whether unlawful acts that correspond with these rights are likely to occur with regularity or frequency, and if so, whether the acts are likely to serve as a basis for unclean hands in a copyright lawsuit.

With respect to unlawful acts corresponding with the right of reproduction, they seem rare. Those acts would most likely involve the unlawful use of an instrumentality necessary for reproducing the work—for instance, using a stolen computer to scan and reproduce one's own work.<sup>356</sup> The situation is not implausible, but seems rather unusual, and might be difficult to ascertain or prove. Hence, it seems unlikely that unlawful acts corresponding with this right would frequently arise in copyright disputes.

With respect to unlawful acts corresponding to the right of preparation of derivative works, they would most likely involve an unauthorized use of another's work while preparing a derivative work of one's own original work.<sup>357</sup> This situation does arise from time to time.<sup>358</sup> Yet copyright law already denies protection to that derivative work under a different doctrine.<sup>359</sup> So the application of unclean hands in that situation would have no practical effect.

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<sup>354</sup> See generally Bartow, *supra* note 18, at 819–20.

<sup>355</sup> See 17 U.S.C. § 106 (2016).

<sup>356</sup> See discussion *supra* Part IV.B.1.

<sup>357</sup> See discussion *supra* Part IV.B.1. It is also possible that one might unlawfully use another's instrumentalities to prepare that derivative work. As discussed in Part IV.C.1, these sorts of unlawful acts are difficult to ascertain and prove.

<sup>358</sup> See, e.g., *Pickett v. Prince*, 207 F.3d 402, 405–06 (7th Cir. 2000); *Anderson v. Stallone*, No. 87–0592 WDKGX, 1989 WL 206431, at \*8–9 (C.D. Cal. Apr. 25, 1989).

<sup>359</sup> Incorporating another's work into one's own is an infringement of the other's right of derivative works, and as a result, courts have denied copyright protection for the newly created work. See *Pickett*, 207 F.3d at 405–06; *Anderson*, 1989 WL 206431, at \*8–9.

With respect to unlawful acts corresponding to the rights of public distribution, public display, and public performance, if the act does not involve the content of the work, the act would likely be an unusual occurrence.<sup>360</sup> For instance, such situations would include trespassing onto another person's property to publicly display a work, or broadcasting a work on public radio waves without a license from the FCC.<sup>361</sup> The situations are possible, but not likely to arise with any degree of frequency.

The situation is markedly different for acts of distribution, performance, or display which are unlawful because of the content of the work. As discussed above, those situations would necessarily involve content that is not protected by the First Amendment.<sup>362</sup> Obscenity, defamation, and fraud are the most common examples. These sorts of unprotected speech do arise from time to time, as evidenced by lawsuits over them.<sup>363</sup> Yet other than obscenity, these works are not likely to arise in a copyright lawsuit. If the work is known to constitute unprotected speech (for instance, expression is known to be defamatory), the laws making that speech illegal will likely foreclose their continued distribution, performance, or display.<sup>364</sup> Stated differently, those laws will likely prevent potential infringers from distributing, performing, or displaying the fraudulent or defamatory content.<sup>365</sup> Moreover, speakers of such content (e.g., defamation and fraud) often desire for the content to be disseminated by anyone in order to spread misinformation, which suggests that they would ignore their copyright rights.<sup>366</sup> Hence, copyright lawsuits over unauthorized uses of content that is unprotected by the First Amendment do not seem likely to arise with any degree of regularity.

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<sup>360</sup> See discussion *supra* Part IV.B.1.

<sup>361</sup> See *Unauthorized Radio Operation*, FCC, <https://www.fcc.gov/consumers/guides/unauthorized-radio-operation> (last updated Jan. 14, 2021).

<sup>362</sup> See discussion *supra* Part IV.B.1.

<sup>363</sup> See, e.g., *Wagner Equip. Co. v. Wood*, 893 F. Supp. 2d 1157, 1164 (D. N.M. 2012).

<sup>364</sup> See, e.g., *id.* (“Because an injunction prohibiting a defendant from repeating a statement determined by a judge or jury to be defamatory would not constitute a prohibited prior restraint of speech under either the First Amendment to the United States Constitution or the New Mexico Constitution, Plaintiff’s claim seeking permanent injunctive relief is not prohibited as a matter of law.”).

<sup>365</sup> See, e.g., *id.*

<sup>366</sup> See Geoffrey A. Fowler, *You Are Probably Spreading Misinformation. Here’s How to Stop.*, WASHINGTONPOST.COM (June 5, 2020 7:00am EDT), <https://www.washingtonpost.com/technology/2020/06/05/stop-spreading-misinformation/>.

Obscenity is the exception. In practice, obscenity laws are infrequently enforced with respect to adult content (but not child pornography).<sup>367</sup> Perhaps because of widespread use, state and federal officials have chosen not to enforce obscenity laws like they have in the past.<sup>368</sup> As a result, unlike copyright owners of defamatory or fraudulent expressions, copyright owners of obscene expressions regularly enforce their rights against infringers.<sup>369</sup> So for unlawful acts involving obscenity, unclean hands would make a practical difference.

To sum up, the only unlawful actions, which correspond to a right in the copyright and which would be likely to serve as evidence of unclean hands in a lawsuit, are those that involve distribution, performance, and display of a work. And only if those acts are unlawful because of the content that they communicate would they seem to occur with any frequency (as a practical matter), which means that the First Amendment would not protect that content. Of the limited groups of unprotected speech, only obscene expression seems likely to arise in a copyright lawsuit.

The upshot is that this category of situations that calls for application of unclean hands (i.e., unlawful acts corresponding to rights in the copyright) would likely apply only in situations that involve obscene works. Therefore, although Sections A and B of this Part contemplate unclean hands in a variety of situations and for a variety of works, in practice, its application would seem relatively infrequent for most works. Unclean hands would apply with regularity only to obscene works.

## V. CONCLUSION

In situations where copyright would serve to incentivize unlawful actions, courts should refuse to enforce the copyright. Copyright exists to incentivize works that will benefit the public interest.<sup>370</sup> Yet to wield copyright in a way that incentivizes unlawful actions would offend that interest.<sup>371</sup> Hence, courts

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<sup>367</sup> See Orrin G. Hatch, *Fighting the Pornification of America by Enforcing Obscenity Laws*, 23 STAN. L. & POL'Y REV. 1, 2–3 (observing the decline of obscenity enforcement).

<sup>368</sup> See *id.*

<sup>369</sup> See, e.g., cases cited *supra* notes 7, 8, 9, 10, 11, 15, 23, 24, 25.

<sup>370</sup> See generally U.S. CONST. art. I, § 8, cl. 8; Ned Snow, *Discrimination in the Copyright Clause*, 67 ALA. L. REV. 583, 617 (2016) (“The purpose of copyright is to benefit the collective society—not individuals.”).

<sup>371</sup> See discussion *supra* Parts II.A.2, IV.

should apply unclean hands to protect the public interest that is inherent in copyright law.<sup>372</sup>

This principle means that courts should recognize the unclean hands defense where a copyright owner has committed an unlawful act that occurs during the process of creating the work or that corresponds with one of her copyright rights in the work.<sup>373</sup> Those two circumstances represent creative and disseminative efforts, which efforts reflect the purpose of copyright.<sup>374</sup> In those two circumstances, the unlawful acts of the copyright owner, which offend the public interest, are sufficiently connected to the copyright lawsuit because they comprise the actions that the copyright is incentivizing.<sup>375</sup>

As a practical matter, the unclean hands defense would apply mostly to copyright owners of pornographic works.<sup>376</sup> Unlike other works that involve unlawful actions, pornographic works are often the subject of copyright lawsuits.<sup>377</sup> They are the fuel for the copyright troll's business.<sup>378</sup> And copyright trolls usually approach litigation with unclean hands. They often derive their rights from a creator who instigated unlawful violence in the creation of pornography, or they exercise their rights in a manner that violates state and federal obscenity laws.<sup>379</sup> Courts should therefore refuse to enforce their rights.

To this end, courts should no longer follow the Fifth Circuit decision in *Mitchell Bros. Film Group v. Cinema Adult Theater*.<sup>380</sup> The *Mitchell* court incorrectly refused to apply unclean hands to the unlawful use of obscene material.<sup>381</sup> Its purported reason—that the defendants had not been personally injured—lacks support in law and policy.<sup>382</sup> Its interpretation that the Copyright Act precludes the application of unclean hands is demonstrably false.<sup>383</sup> Its policy arguments are without merit: applying unclean hands in the two circumstances mentioned above would not lead to absurd and

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<sup>372</sup> See discussion *supra* Part IV.

<sup>373</sup> See discussion *supra* Part IV.

<sup>374</sup> See discussion *supra* Part IV.

<sup>375</sup> See discussion *supra* Part IV.

<sup>376</sup> See discussion *supra* Part IV.C.

<sup>377</sup> See discussion *supra* Part IV.C.

<sup>378</sup> See discussion *supra* Part I.

<sup>379</sup> See discussion *supra* Part IV.A–B.

<sup>380</sup> 604 F.2d 852 (5th Cir. 1979).

<sup>381</sup> See discussion *supra* Part III.

<sup>382</sup> See discussion *supra* Part III.B.

<sup>383</sup> See discussion *supra* Part III.C.

unacceptable results; it would not fragment rights of copyright owners; and it would not be inconsistent with changing moral standards.<sup>384</sup> *Mitchell* is not simply a case that represents another way of looking at an issue. It is wrong as a matter of law.

Thus, *Mitchell* should no longer stand in the way of courts denying enforcement of copyrights to pornographic works. Without *Mitchell*, copyright trolls are in trouble. Their business of litigating claims to pornography must end.

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<sup>384</sup> See discussion *supra* Part III.D.