Pretrial Remedies in Infringment Actions: The Copyright Holder's Impound of Flesh

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INTRODUCTION

The protection of intellectual property and the various tangible forms it takes is regulated by a copyright law which has rather miraculously withstood nearly 70 years of attack, unforeseen technology, and judicial tinkering.

In 1976 Congress enacted a general revision of the Copyright Act, an effort perhaps inherently doomed to continual criticism since the notion of exclusivity in one's intellectual creations is the product of a marriage of two concepts fundamentally at odds with one another: monopoly and freedom of expression. This conflict manifests itself as a battle between the copyright holder, who is interested in preserving his mo-
nopoly, and the "infringer," who, wishing to use the copyright holder's creation, claims that to deny it to him would be an abrogation of his freedom of expression.

Initially, this comment focuses on the infringement action and the methods of pretrial relief available to the copyright holder to safeguard his copyright from infringement. In particular, the discussion centers on section 503 of the revised Act, under which the copyright holder is entitled to a pretrial, ex parte hearing, followed by an impoundment procedure which requires him to post a bond of at least twice the value of the impounded articles.

Following this examination of the methods of pretrial relief, the comment explores the constitutional deficiencies of the impoundment procedure as tested by the constitutional prohibition against taking property without due process of law and the first amendment. Finally, this comment develops a balancing approach to harmonize the copyright holder's concerns and the infringer's challenge and demonstrates how the application of this balancing approach would resolve the tension between pre-trial and constitutional safeguards.

**PRETRIAL RELIEF**

The argument for preliminary relief takes shape from a clear need for some sort of immediate relief when a copyright infringement is alleged, since failure to act quickly can result in the financial ruin of the innocent party. In many cases, for example, where an allegedly infringing phonograph record is about to be released or a motion picture exhibited, the copyright holder may have only hours in which to act.

Since courts do not, in the normal course of judicial business, act with such speed, extraordinary remedies have been developed which may be implemented quickly and with little preparation or notice. Those seeking such a speedy remedy in an infringement case can resort either to the Copyright Act

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7. Id. § 503(a).
8. See note 51 infra.
9. See notes 97-141 and accompanying text infra.
10. The conflict exists because the Constitution mandates the existence of a copyright law and also sets forth the freedoms of the first and fifth amendments. For a discussion of the notion that the amendments supercede the body of the Constitution, i.e. that they were intended literally to amend it, see Nimmer, supra note 5, at 1182.
itself and the impound provisions of section 101(c), or turn to the more traditional remedies of the temporary restraining order and preliminary injunction.

Both the preliminary injunction and impound attempt to balance the need for immediate action to protect the copyright holder against the inappropriateness of imposing a remedy that drastically affects the alleged infringer before a hearing on the merits. They strike different balances and each generates its own set of practical problems.

Preliminary Injunction—The Traditional Equity Rule in Copyright Practice

The Copyright Act specifically allows for preliminary injunctions and the procedure has evolved into a highly flexible and variable remedy which presents special problems when it is examined for consistency and speed of application. Furthermore, the fact that a preliminary injunction entitles the defendant to retain possession of the allegedly infringing articles raises the question of whether or not the remedy is adequate in the special circumstances of infringement actions.

Commonly used in all types of civil actions, the preliminary injunction procedure provides for an adversary hearing before any court action, and gives protection to defendants from unfair deprivation of their property, since the defendant

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12. FED. R. CIV. P. 65(a), (b).

To comport with the focus of the comment, the temporary restraining order will be considered synonymous with the preliminary injunction. Though the procedures for each differ, when contrasted with impoundment they are both inherently more protective of the alleged infringer. Additionally, in the infringement setting, they are really just two steps in one overall process. See note 18 infra.

13. The 1909 Act provides for injunctive relief at § 112. More protective of defendants than the impound provision, it called for the granting of injunctions "according to the course and principles of courts of equity." This meant that the plaintiff had to make the showing traditionally required for injunctive relief, and it also meant that such showing would be made after notice of the hearing was served upon the defendant.

Section 502 of the revised act also provides for the granting of preliminary injunctions. At the revision sessions the only controversy about proposed changes in the injunction procedure arose over the possibility of writing an allowance for court discretion into the law. Those who opposed the allowance favored the free granting of preliminary injunctions. This controversy had no real foundation however, as the 1961 Register's Report pointed out, since the granting of injunctions has always been discretionary. The new § 502(a) does not mention discretion and retains the language of § 112 that injunctions will be granted "on such terms as [the court] may deem reasonable."

has an opportunity to be heard before action is taken. To obtain a preliminary injunction a showing of infringement must be made, and some difficulties exist with this requirement. The courts have demonstrated a remarkable inconsistency in the showing needed, ranging from mere allegations of infringement to a practical adjudication of the merits of the case at the hearing.\textsuperscript{15}

Originally developed as an equitable remedy, the preliminary injunction was codified in 1948 by rule 65 of the Federal Rules of Civil Procedure. Rule 65 was intended to insure procedural consistency and requires that notice be given to the adverse party before an injunction will issue. Thus, a plaintiff seeking a preliminary injunction has a double burden: he must meet the notice requirements of rule 65\textsuperscript{16} and make the showing traditionally required for equitable relief.\textsuperscript{17} As noted above, the showing required has been highly variable, with the result that the preliminary injunction procedure, as currently applied, may make it unduly difficult for plaintiffs to obtain appropriate pre-trial protection from infringement.\textsuperscript{18} The general uncertainty that results is troublesome, as an examination of preliminary injunction cases in the copyright field illustrates.

Traditional equity concepts indicate two major situations where injunctive relief will be granted: a prima facie showing

\begin{footnotesize}
\begin{itemize}
\item[15.] See text accompanying notes 30-33 infra.
\item[16.] FED. R. CIV. P. 65(a)(1).
\item[17.] The showing required in courts of equity varies according to the factual situations of the case, but generally such factors as danger of irreparable harm, hardship to either party, and plaintiff's likelihood of success on the merits are considered.
\item[18.] The temporary restraining order (TRO), provided in rule 65(b), even though it may be implemented quickly, does not solve the plaintiff's need for adequate pre-trial protection from infringement.
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\end{footnotesize}
of infringement, or a convincing showing of irreparable harm. In *Rushton v. Vitale*, for example, plaintiff discovered copies of its doll selling in stores—copies so blatant that they even had plaintiff's copyright registration and mold number on them. Upon production of the doll in court, a preliminary injunction was granted without a showing of irreparable harm, because the dolls themselves constituted a prima facie case of infringement.

Conversely, in *Inge v. Twentieth Century-Fox Film Corp.*, playwright William Inge had arranged a roadshow of his play "Bus Stop." He had invested considerable sums of money and engaged top talent for the show. Twentieth Century Fox was going to release its film version of "Bus Stop" simultaneously, and Inge needed a preliminary injunction quickly. He based his motion on the fact that incalculable irreparable injury would occur to his roadshow if it had to compete with defendant's motion picture. The preliminary injunction was granted on the basis of Inge's prospective losses, with little inquiry into his ability to make a prima facie showing at the hearing.

For each major theory of preliminary injunction there is a widely-used exception carved out by the courts. Rather than requiring a prima facie showing of infringement, as in *Rushton*, most courts are satisfied with evidence indicating a likelihood of success on the merits even though the defendant presents evidence to rebut the prima facie showing. Similarly, where the plaintiff has shown that irreparable harm will occur, a defendant can offer evidence of harm to himself, causing the court to apply the balance of hardships test.

The likelihood-of-success criterion was used in *Mattel, Inc. v. S. Rosenberg Co.* In that case the defendant sold dolls made in Hong Kong which Mattel contended infringed upon its copyrighted "Kiddle" dolls and accessories. Since both parties

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20. 218 F.2d 434 (2d Cir. 1955).


22. What showing will convince a court that the plaintiff is likely to succeed on the merits is, like all showings used in granting preliminary injunctions, highly variable, but the procedure amounts to an abbreviated version of full scale courtroom proceedings.

claimed irreparable harm and the defendant offered enough evidence to counter Mattel’s showing of copying, the court granted a preliminary injunction based on its examination of the two products, which, it observed, showed “overwhelming evidence of identity resulting from imitation.” Although in many instances this would have been a prima facie showing of infringement, the Mattel court, taking into account defendant’s showing, decided that a preliminary injunction should issue because of plaintiff’s strong likelihood of success.

The balance of hardships test was applied in Columbia Broadcasting System, Inc. v. American Society of Composers, Authors, & Publishers. Here, two licensing societies customarily charged organizations, such as broadcasters, which use a large number of licensed works, a flat annual rate based on spot surveys of use, rather than charging for each actual use. CBS had sued ASCAP and Broadcast Music, Inc. (BMI) to force them to charge only for each actual use. In the meantime, CBS withheld payment of license fees, and BMI sought a preliminary injunction to force CBS to pay for the continued use of BMI’s licensed works.

The federal district court in New York felt that the clearest grounds for granting BMI’s request rested upon the balance of hardships test, since there were serious issues to be litigated which were too complex to give any clues as to the likelihood of success. Furthermore, since CBS ordinarily paid BMI approximately 1.6 million dollars annually, an amount which constituted a substantial portion of BMI’s revenue, and since CBS was “a substantially larger and stronger organization than BMI,” the injunction was granted.

There are also cases in which the court’s reasons for grant-
ing or denying a preliminary injunction fit under neither the likelihood of success nor the balance of hardships rubrics. In those cases some courts have been highly imaginative in creating their own criteria for granting an injunction, or even substituting other remedies for the one sought. Still others, have considered more than one factor in granting injunctive relief, and many have weighed the various determining factors differently. Unless the plaintiff can make a Rushton-type prima facie case, or clearly show irreparable harm, as in Inge, it becomes very difficult to predict the result of a petition for a preliminary injunction. This uncertainty of result, inherent in the preliminary injunction procedure, tends to make it less utilized if other, more certain, mechanisms are available, such as the statutory impound mechanism. Additionally, the balance between the need of the copyright holder for speedy action and the need of the alleged infringer for just adjudication is clearly struck in favor of the alleged infringer due to the existence of a hearing on the merits that is required for a preliminary injunction. Finally, it is clearly advantageous to the copyright holder to be able to deprive the infringer of the allegedly infringing articles. This remedy is not available in the injunction procedure—which makes the statutory impound procedure even more appealing.

Impound—The Codification of an Equitable Remedy

Section 503(a) of the Revised Copyright Act grants courts the power to impound "all copies or phonorecords claimed to


have been made or used in violation of the copyright owner's exclusive rights, and of all plates, molds, matrices, masters, tapes, film negatives, or other articles by means of which such copies or phonorecords may be reproduced.\textsuperscript{34} The impound remedy can be implemented "at any time while an action under this title is pending . . . ."\textsuperscript{35} Thus, immediately upon filing an action, one who feels he is the victim of infringement can ask to have both the allegedly infringing copies and the means of producing them impounded.\textsuperscript{36}

At first glance, there appears to be little significant difference between section 503(a) and the current impound provision. The current provision, section 101(c), states simply that the defendant in an infringement suit may be required "[t]o deliver up on oath, to be impounded during the pendency of the action, upon such terms and conditions as the court may prescribe, all articles alleged to infringe a copyright."\textsuperscript{37} However, there are two major changes. First, unlike section 101(c), section 503(a) of the revised Act makes it clear that both the copies and the means of producing them are subject to pretrial impoundment.\textsuperscript{38} Second, an important part of the former law, the need for a preliminary showing of infringement, has been eliminated.

The first phrase of section 101 reads: "If any person shall infringe the copyright . . . such person shall be liable."\textsuperscript{39} Presumably, this phrase requires a court to determine that infringement had occurred before it could order impound—even though the court was empowered to order the impound before trial. With this requirement then, impound under section 101 prior to a trial on the merits was of questionable validity.

Against this backdrop, section 101 presented a quandary: how far should the court delve into the merits of the plaintiff's claim of infringement? Alternatively, was it fair to go into the merits of the plaintiff's claim at all in an ex parte hearing?

\textsuperscript{34} See Revision of Copyright Law, Pub. L. No. 94-553, § 503(a), 90 Stat. 2541 (1976).
\textsuperscript{35} Id.
\textsuperscript{36} Since the Supreme Court Rules allow approval of the affidavit by a judicial officer, the filing of the action and the issuance of the impound order can be simultaneous. The only remaining hurdle is to have the sheriff execute the order. See note 51 and accompanying text infra.
\textsuperscript{38} See text accompanying note 34 supra.
To alleviate this problem, the drafters of the revised Act,\(^{40}\) rather than providing for an adversary hearing prior to impoundment, similar to a preliminary injunction, simply dropped the "shall infringe" language of section 101.\(^{41}\) Under the new impound procedures a court no longer needs assurance that an infringement has occurred before it grants an impound order.\(^{42}\) Despite the impact of this change, the decision to drop the requirement that infringement had occurred aroused little controversy in any of the revision studies.\(^{43}\)

The preliminary study prior to the drafting of the revised Act did arouse some controversy, however. The 1961 Report of the Register of Copyrights proposed leaving as much discretion\(^{44}\) as possible in the court's decision to grant impound. The Register pointed out that impound was an extraordinary remedy and presented "matters for the court to consider in exercising its discretion."\(^{45}\) As a result, the report recommended that "the present provisions for the impounding and destruction of infringing articles should be retained in substance."\(^{46}\)

After the issuance of the 1961 report, the Register sought comment on it from interested members of the copyright law

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41. Section 503 of the revised Copyright Act now begins by stating that the impound remedy is available at any time during the pendency of the action. See Revision of Copyright Law, Pub. L. No. 94-553, § 503 (a), 90 Stat. 2541 (1976).

42. This is to be inferred from the statutory language, which contains no mention of actual infringement, but only "claimed" infringement. Id.

43. Of those who made their views known to the Register of Copyrights, only the Motion Picture Association (see note 48 infra) had anything negative to say about the proposed revisions to the impound provision. Their comments did not bring up the "shall infringe" language. See Copyright Law Revision, Part Two: Discussion and Comments on the Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law 366 (1963) [hereinafter cited as 1963 Report].

44. The Supreme Court has indicated that the proper exercise of discretion is essential to the operation of any ex parte procedure within constitutional limits:

Yet it has never been held that the hand of government as prosecutor must be stayed until the courts have an opportunity to determine whether the government is justified in instituting suit in the courts. Discretion of any official may be abused. Yet it is not a requirement of due process that there be judicial inquiry before discretion can be exercised.

Ewing v. Mytinger & Casselberry, 339 U.S. 594, 599 (1950). Thus, the Court might view unfavorably a limit upon a court's discretion in the administration of the impound procedure.

45. See 1961 Report, supra note 4, at 108.

46. Id. at 109.
The only party who responded with criticism to the Register's recommendations was the Motion Picture Association of America. The members of the association, legitimate distributors of films, are frequently plaintiffs in infringement suits, and understandably viewed the Register's approval of broad discretion in the impound procedure with some alarm. The association expressed its interest in replacing the discretionary aspects of the procedure with a requirement that impound be granted upon the demand of the copyright holder. It commented: "we regret the suggestion in the Report that the lower courts have a 'discretion' to deny the relief of impoundment altogether, even when a bond and affidavit complying with the rules have been filed."

By dropping the "shall infringe" language, Congress has arguably eased some of the association's concern. The new impound procedure clearly has broadened a court's power in a direction favorable to the needs of plaintiffs. A court is no longer required by statute to ascertain that an infringement has occurred before it grants impound. The wording of the statute gives the court the power to order impound immediately upon the filing of the action.

The Supreme Court Rules—Implementation of the Impound Remedy.

Since 1909, the impound remedy has been implemented through the rules promulgated by the Supreme Court, pursuant to congressional mandate in section 25 of the 1909 Act. Intended to provide for the consistent application of the impound remedy, the Rules' essential provisions are that an affidavit and bond must be delivered to the court before an impound order will be granted, and that the defendant is entitled to an adversary hearing after the seizure.

47. Id. at iii.
49. Id. at 366.
51. Rule 3 requires the affidavit to state the number, location, and value of the items to be seized. Rule 4 sets the amount of the plaintiff's bond at twice the value of the seized items. Rule 9 provides for the post-seizure hearing, although it sets no limits upon the length of the period between seizure and hearing. See infra. A infra.
During the revision hearings, the suggestion was made that the Supreme Court Rules be incorporated into the new Copyright Act. Incorporation would have required courts to follow the Rules and would have eliminated their discretion as to what procedures to follow. The result of this requirement would have been that impound would be automatic after one filed the affidavit and posted bond. The Register, responding to this suggestion in its 1965 report, restated its opinion that application of the impound remedy should be discretionary, and that use of the Rules should not be mandatory. While conceding that "[i]t may well be that the problems of seizure and impounding in copyright cases are so special that separate, detailed rules . . . are justified . . . the present statute contains no specific provision referring to the Supreme Court Rules, and we see no need to include one in this bill." At this point it should be observed that the Supreme Court promulgated its Rules in the context of the 1909 Copyright Act, which contained the "shall infringe" language. It could be argued that the Supreme Court did not intend to allow impound as an absolute right to anyone who complied with the Rules, since the existing "shall infringe" language presented at least a threshold obstacle. That language seems to require that the trial court be satisfied that an infringement has occurred before it grants impound. Thus, more than mere compliance with the Rules would be necessary for impound; the plaintiff would have to make a showing of infringement as well.

No opinion was issued with the Rules; hence it cannot be ascertained what significance the Court gave to the "shall infringe" language. Undoubtedly the Court was aware of its existence. Assuming arguendo that the Court intended its Rules to be applied only after the threshold infringement showing, it is clear that the Rules need review. If the 1909 Court intended to afford the protection of the "shall infringe" language to defendants against whom the impound remedy is asserted, and the Congress has legislatively altered the remedy by removing the "shall infringe" language, the protection the Court thought appropriate has been abrogated.

52. See 1965 Report, supra note 40, at 133.
53. Id. at 133-34.
Although the level of protection for defendants at the filing of the action appears to have been lowered, other protective provisions of the Rules—those designed to assist the defendant in recovering against an unsuccessful plaintiff—are unaffected by the omission of the "shall infringe" language. However, the remedies available—monetary damages and return of items seized—are the same as those available under the Federal Rules of Civil Procedure in all civil actions. Yet there is no provision for pre-trial, ex parte seizure in the Federal Rules. Hence, copyright defendants are at a distinct disadvantage compared with defendants in other types of civil actions in federal courts.

Throughout the history of the 1909 Copyright Act, there have been proposals to revise it. During the 72nd Congress, 1931-32 term, two revision bills were introduced in the Senate which dealt with the remedies available to copyright defendants who had been subjected to seizures under the Act and were subsequently found innocent. The Hebert Bill and the Dill Bill both proposed a mandatory award of damages, rather

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56. This is not to say that a defendant against whom impound has been wrongfully asserted can ever be properly compensated for his loss. Impound results in the work being removed from the public view, yet most copyrightable works have no monetary value except as offerings to the public. The consequences of delaying the debut of a motion picture or the pre-publicized sale of a controversial book, in addition to the financial loss, can include damage to the reputation of the producer or writer, loss of public interest, obsolescence, etc. See, e.g., Estate of Hemingway v. Random House, Inc., 49 Misc. 2d 726, 268 N.Y.S. 531 (N.Y. Sup. Ct. 1966)(attempted delay of publication of Papa Hemingway).

57. Rule 4 empowers the court to exact a penalty from the plaintiff in addition to requiring the return of items seized, should he be unsuccessful. See app. A infra.


59. Fed. R. Civ. P. 64 allows seizure of persons or property according to the procedures of the state in which the action is tried, unless there is a federal statute which governs. All copyright cases are brought under the Copyright Law; thus its provision for seizure is used, state procedures notwithstanding.

60. However, where state attachment laws are applied under Fed. R. Civ. P. 64, the defendant's fortunes vary widely. Many state attachment laws have recently been challenged on constitutional grounds, and some have reached the Supreme Court. See, e.g., North Georgia Finishing Co. v. Di-Chem, Inc., 419 U.S. 601 (1975); Randone v. Appellate Dep't of the Super. Ct., 5 Cal. 3d 536, 488 P.2d 13, 96 Cal. Rptr. 709, cert. denied, 407 U.S. 924 (1971).


61. See note 4 supra.


63. S. 3985, 72d Cong., 1st sess. (1932).
than the discretionary one then and now available under Supreme Court Rule 4.64

Another product of the revision effort was the appraisal of Rules three through thirteen by the Advisory Committee on Rules to the Supreme Court, issued in 1966.65 Their report centers on one main objection: the Rules' lack of protection to defendants. Pointing out that the Rules contravene the general policy of the Federal Rules of Civil Procedure, which is to avoid remedies anticipating decision on the merits,66 the Committee concluded that because the Rules require neither notice nor a showing of irreparable injury they should be revised.67 At the same time the Committee observed that a general revision of the Copyright Law was in progress, and hence refrained from suggesting specific changes in the Rules, on the assumption that the Copyright Act revisers would incorporate additional protections in the new law.68

Despite the Committee's urging that the Rules be altered to afford more protection for defendants, the Rules remain untouched.69 The net result is that the revised Copyright Law saddles us with Supreme Court Rules three through thirteen as written in 1909,70 minus whatever protection the "shall infringe" language once afforded, when interpreted in light of the Rules.

The Supreme Court Rules in Practice—Impound Cases

From the outset, courts had difficulty in dealing with section 101(c), the impound provision of Title 17 of the United States Code, because it allows impound pendente lite of "all articles alleged to infringe the copyright."71 This language has been given two interpretations. The first, and strictest, construction of the language is that only copies are subject to

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64. For the text of Rule 4, see app. A infra. These two bills never became law. Even if they had, they would have been little more than surface remedies. They proposed to cure the impound procedure by providing a damage remedy after the fact, rather than focusing on the real ill—the ease with which an impound order could be obtained.
66. Id.
67. Id.
68. Id.
69. In leaving the Rules untouched the Copyright Act revisers heeded the recommendation of the Register of Copyrights. See 1961 REPORT, supra note 4, at 109.
seizure because only copies can infringe. The second interpretation expands the language to make anything the plaintiff alleges is infringing subject to seizure, including articles used for making the copies. Despite this ambiguity in the statute, the Supreme Court apparently did not recognize the distinction when it wrote the Rules, since Rule 3 clearly allows seizure of both copies and the means for making them.

In spite of the fact that Rule 3 allows for the seizure of the copies and the means for making them, a major question remains unanswered: can a court order the impound of articles which can be used for making infringing copies but which are also capable of other lawful uses? While courts have generally agreed that both copies and means can be impounded, there is confusion and inconsistency in the courts' handling of the problem of neutral items.

The leading case on the lawful scope of a seizure is Duchess Music Corp. v. Stern, which permitted the pretrial seizure of neutral items based on the language of section 101(c). Duchess owned the copyright on the compositions of many well known composers and lyricists and alleged infringement of these compositions by Stern. On the strength of its charge, Duchess obtained a seizure order in a district court in Arizona for all copies and the devices for making them.

The marshal executed the warrant and proceeded to dismantle Stern's cassette tape business, depositing its entire inventory of finished tapes, blank tape, packaging, and tape recorders in a warehouse. In accordance with Rule 9, Stern applied to the district court for return of all articles which were

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72. See, e.g., Elektra Records Co. v. Gem Elec. Distrib., Inc., 360 F. Supp. 821 (E.D.N.Y. 1973). Here the court held that defendant's tape duplicating machines were not subject to impound. At the same time, however, the court granted a preliminary injunction prohibiting infringing use of the machines. Id. at 825.

73. See, e.g., Duchess Music Corp. v. Stern, 458 F.2d 1305 (9th Cir.), cert. denied, 409 U.S. 847 (1972).

74. For the text of Rule 3, see app. A infra.

75. Such articles include tape recorders, presses, cameras, photocopiers, and the like.


77. 458 F.2d 1305 (9th Cir.), cert. denied, 409 U.S. 847 (1972).

78. Included among Duchess' copyrights were works of Elvis Presley, Johnny Cash, Burt Bacharach, Mick Jagger, Joni Mitchell, and Buck Owens. Id. at 1306-07.


80. For the text of Rule 9 see app. A infra.
not copies. Stern's application was granted.\textsuperscript{81} At that time he had been out of business for about two weeks. Duchess appealed to the Ninth Circuit (a procedure not specified in the Rules) and Stern's tapes and equipment remained in the warehouse.\textsuperscript{82}

In reversing the district court, the court of appeals took the view that the language of section 101(c) stating "all articles alleged to infringe" means that anything the plaintiff alleges is infringing is to be seized.\textsuperscript{83} Thus Stern's blank tape and machines, which were certainly capable of noninfringing uses, remained in the warehouse until there was a decision on the merits, effectively preventing Stern from carrying on his tape business which, it should be noted, had not yet been declared unlawful.\textsuperscript{84}

Of particular interest here is the Arizona District Court's lucid analysis of the language of Rule 3 in deciding that impound of neutral items was improper:

Application of the rule of \textit{ejusdem generis} requires that the phrase 'or other means of making such infringing copies' be held to apply only to the same class as are those items specifically enumerated in the phrase immediately preceding, and each of the preceding items—plates, molds, matrices—is of such a particular character as to embody . . . an identifiable impression of the copyrighted work.\textsuperscript{85}

Under this interpretation, such things as presses and tape recorders, which do not contain impressions of a work except when in use, are not subject to seizure.

The court of appeals reversed the district court because the district court was following Supreme Court Rule 3 while the court of appeals was following section 101(c). Arguably, each court correctly interpreted the law it used. The problem which is presented is a direct conflict between two laws on the same subject. However, since the terms and conditions of the impound are subject to the granting court's discretion,\textsuperscript{86} the court of appeals stood on firmer legal ground by upholding the trial

\begin{itemize}
\item \textsuperscript{81} 331 F. Supp. at 128.
\item \textsuperscript{82} \textit{See} 458 F.2d at 1307.
\item \textsuperscript{83} \textit{Id.} at 1309.
\item \textsuperscript{84} Stern was ultimately found guilty of infringement. \textit{Id.} at 1310-11.
\item \textsuperscript{85} 331 F. Supp. at 133.
\item \textsuperscript{86} Under 17 U.S.C. § 101(c) (1970), and under the revised law, impound is ordered "on such terms and conditions as the court may prescribe." \textit{See} Revision of Copyright Law, Pub. L. No. 94-553, § 503, 90 Stat. 2541 (1976).
\end{itemize}
court's impound order.\textsuperscript{87}

Section 503 of the Revision Act\textsuperscript{88} appears to eliminate some of the confusion. The "such terms" language remains, which makes use of the Rules discretionary.\textsuperscript{89} But section 503 now calls for seizure of all articles by means of which the allegedly infringing copies can be made, rather than seizure of all allegedly infringing articles.

Unfortunately, this is only a partial clarification, since the question of whether or not neutral articles can be seized remains unanswered by the new law. What to do with these neutral articles is still subject to the conflicting interpretations outlined by the courts in \textit{Duchess}.\textsuperscript{90} It remains to be seen what judicial resolution will be given to the new provision. Presumably some courts will take a narrow view, limiting seizure orders to only those items embodying an impression of the infringing work; others will take a broad view, permitting the seizure of all items from which potential copies can be made. Whatever the result, plaintiffs and defendants will be as unsure of their pre-trial status as they have been since 1909.

\textbf{Pretrial Relief—Summary}

In summary then, two basic pretrial procedures are available to a copyright holder seeking relief from infringement—preliminary injunction and impound. Both forms of relief, however, present practical difficulties of application.

The preliminary injunction is highly protective of the interests of the defendant in that no action can be taken against him without notice and an adversary hearing.\textsuperscript{91} At this hearing the court applies a balancing process to the facts presented and, absent a prima facie showing of infringement, will consider such equitable factors as the likelihood of success and the

\textsuperscript{87} There are no reported cases in which the procedures outlined in the Supreme Court Rules were disregarded. However, the terms of the impound are discretionary, according to § 101(c). Therefore, the court may specify what is to be seized. If a court wants to support its view that everything should be seized, § 101(c) is applicable. If, on the other hand, the court wants to limit the impound to infringing articles, the language of Rule 3 permitting impound only of the means for making infringing copies supports such a limitation.


\textsuperscript{89} See note 86 and accompanying text supra.


\textsuperscript{91} \textit{FED. R. CIV. P.} 65(a). See notes 12 & 18 supra.
balance of hardships. The more facts a court examines at the
hearing the less likely it is to award or deny relief improperly.

As more facts are examined, however, the time involved in
granting relief increases. Thus, any progress made toward pro-
tecting the needs of the defendant by providing a full hearing
comes at the expense of the plaintiff's need for immediate relief
to safeguard his copyright. Lacking concrete guidelines on
how extensive a pretrial hearing should be before granting
relief, courts have tended to favor one party's interests or the
others, alternatively rubber stamping a plaintiff's contentions
or engaging in a prolonged investigation of the merits.

The impound procedure, too, presents practical difficul-
ties. The wording of section 503 of the Revision Act and the
Supreme Court Rules appears to allow seizure of both copies
and innocent articles. The effect is an overbroad seizure. It is
within the realm of possibility that an entire manufacturing
operation can be dismantled and impounded pending disposi-
tion of the suit. Some courts have later ordered the return of
innocent articles, indicating that their seizure was improper. If
any conclusion can be drawn, it is that the scope of permissible
seizure is uncertain.

An additional practical problem is posed by the elimina-
tion of the "shall infringe" wording in section 503 of the Revi-
sion Act. Those words arguably were intended to make it more
difficult to obtain impound by requiring an infringement show-
ing. As the Revision Act now reads, anyone who complies with
the Supreme Court Rules is entitled to impound; only the
"terms and conditions" of the impound remain subject to court
discretion.

CONSTITUTIONAL PROBLEMS OF IMPOUND

Statutes providing mechanisms for pretrial seizures in the
areas of wage garnishment and obscenity regulation have been
successfully challenged by the assertion of constitutional rights

92. See text accompanying notes 22-29 supra.
93. It is important to note that the TRO procedure provided in Rule 65(b) suffers
from the same vices, from the plaintiff's perspective, as the preliminary injunction
procedure of Rule 65(a). See note 18 supra.
95. See text accompanying note 41 supra.
96. At least one commentator has criticized courts engaging in such a
"ministerial function." See The Supreme Court, 1973 Term, 88 Harv. L. Rev. 43, 79-
80 (1973).
under the first and fifth amendments. The statutes involved in those cases had strikingly similar provisions to those found in the impound portion of the Copyright Act. Therefore, to gain some insight into the constitutionality of section 503's seizure provisions, it becomes useful to examine the Supreme Court holdings on the constitutionality of those statutes.

Free Speech

The first amendment clearly limits congressional ability to regulate speech\(^7\) and since the Copyright Act is a legislative enactment it must meet the amendment’s requirements.\(^8\) The Supreme Court has never ruled on the first amendment sufficiency of the impound provision; it is therefore important to examine it in light of the wording of the first amendment, the holdings of the Supreme Court on seizures pursuant to similar provisions in state obscenity statutes, and the holdings of the lower courts in infringement cases.\(^9\)

Typically, state obscenity laws have enforcement provisions similar to the impound provision in the Copyright Act, so that upon the request of a prosecutor a court order issues allowing the seizure of everything alleged to be obscene.\(^9\) It is not unusual for the affidavits of the state to be vague, or for

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97. U.S. Const. amend. I.
98. It is beyond the scope of this comment to discuss the possibility that the Copyright Law itself is unconstitutional under the first amendment. See generally Nimmer, supra note 5.
99. Full discussion of the doctrines developed by the Supreme Court in dealing with laws restricting speech is beyond the scope of this comment. For the limited purpose of discussion of the impound provision it is adequate to state simply that where the Court perceives a legislative limitation on speech (and the impound provision is such a limitation) it has followed one of two paths.

First, the speech in question could be found to be such that it is not protected by the first amendment. Examples of unprotected speech include obscenity, treason, and arguably infringement of copyrighted material. Where speech is unprotected, laws limiting it are not unconstitutional on first amendment grounds.

The second path the Court has followed leads to a holding that the speech is protected by the first amendment but the law limiting it is permissible because it furthers a legitimate state interest. Such laws are usually aimed at controlling harmful conduct of which speech is a necessary ingredient. An example is a law against inciting to riot. The law is intended to prevent riots but it accomplishes this goal by limiting speech. In these cases the Court will uphold the law if it does not restrict speech more than is necessary to further the legislative interest.

the order to permit seizure of everything on the premises. The result is that innocent articles are often seized along with obscene materials.\textsuperscript{101}

The leading case involving first amendment rights and the seizure of allegedly obscene materials is \textit{Kingsley Books, Inc. v. Brown}.\textsuperscript{102} Here, a seizure order was issued ex parte, and while the Supreme Court upheld the seizure, the dissenting opinion by Justices Black and Douglas presented a convincing first amendment argument which later became the majority view of the Warren Court:\textsuperscript{103}

The provision for an injunction \textit{pendente lite} gives the state the paralyzing power of a censor. A decree can issue \textit{ex parte} without a hearing and without any ruling or finding on the issue of obscenity. This provision is defended on the ground that it is only a little encroachment, that a hearing must be promptly made. But every publisher knows what an awful effect a decree issued in secret can have. We tread here on First Amendment grounds. And nothing is more devastating to the rights that it guarantees than the power to restrain publication before even a hearing is held.\textsuperscript{104}

It is possible to apply the reasoning of the dissent in \textit{Kingsley} to the infringement-impound situation. Under the Supreme Court Rules a prompt post-impoundment hearing is called for; thus there is only "a little encroachment."\textsuperscript{105} Furthermore, a section 503 seizure prevents publication, a restraint found "devastating" to first amendment rights in the \textit{Kingsley} dissent.\textsuperscript{106}

In \textit{A Quantity of Books v. Kansas},\textsuperscript{107} the majority adopted the view of the \textit{Kingsley} dissenters. In attacking an ex parte seizure as an abridgement of freedom of the press, the Court said: "We conclude that the procedures followed in issuing the warrant for the seizure of the books, and authorizing their impounding pending hearing, were constitutionally insufficient because they did not adequately safeguard against the suppres-

\textsuperscript{101} See, \textit{e.g.}, Porno, Inc. v. Municipal Court, 33 Cal. App. 3d 125, 108 Cal. Rptr. 797 (1973)(seizure of films and projectors from a theatre).
\textsuperscript{102} 354 U.S. 436 (1957).
\textsuperscript{103} See note 107 and accompanying text \textit{infra}.
\textsuperscript{104} \textit{Id.} at 446 (Black & Douglas, J.J., dissenting).
\textsuperscript{105} \textit{Id.} at 446 (Black & Douglas, J.J., dissenting).
\textsuperscript{106} For the text of Rule 7, see app. A \textit{infra}.
\textsuperscript{107} 378 U.S. 205 (1964).
Again, it can be argued that an analogous situation occurs in section 503 seizures. Under section 503, articles are capable of being seized before it is known whether or not they are infringing. Similarly, the section provides no adequate safeguard against the seizure of noninfringing articles.

_Jondora Music Publishing Co. v. Melody Recording, Inc._ raised the constitutional problems of impound under the Copyright Act. Melody was in the business of making duplications of phonograph records. Jondora, which owned the copyright on some musical compositions appearing on Melody's taped duplications, obtained a seizure order and impounded Melody's copies and equipment, closing down Melody Recording, Inc. _pendente lite_.

Melody sought reversal of the writ of seizure in the New Jersey Federal District Court and alleged that the impound, which was found to have been in compliance with the Supreme Court Rules, was unconstitutional under the first and fifth amendments.

The court minced no words in disposing of Melody's first amendment claim, dealing with the issue in one sentence: "Since the defendants concede they copy the creative works of others I perceive no first amendment issue." The court reasoned that infringement, like treason, was not protected by the first amendment.

Since Melody conceded after the seizure that it had been infringing the copyright, the court did not deal directly with the propriety of the pretrial seizure itself. Thus, even though in this particular case it turned out that once the facts were revealed the impound was proper, the more general question of the legality of seizures before the facts are determined was left unanswered by _Jondora_.

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108. _Id._ at 208.
110. Such activity may infringe upon two copyrights: that of the owner of the rights in the music itself, and that of the owner of the rights in the particular recording embodying the musical composition. In court, the trier of fact must determine whether the work in question was protected by copyright at the time it was duplicated by the alleged infringer. _See_ Revision of Copyright Law, Pub. L. No. 94-553, §§ 106, 114, 90 Stat. 2541 (1976); 17 U.S.C. § 1(a, f) (Supp. V 1975).
112. _Id._ at 499.
113. _Id._ The court relied on Nimmer, _supra_ note 5, at 1192, 1203-04.
The constitutional propriety of the impound procedure is further confused by the uncertainty of the impact of the copyright clause of the Constitution. It can be argued that the clause adds constitutional weight to the validity of the impound procedure since the regulation of copyrighted material is a specifically enumerated congressional power. This argument must fail, however, for the same reason that regulation of nonobscene material must fail. While both obscene material and infringing material are unprotected by the first amendment, nonobscene and noninfringing material are protected and only a hearing on the merits can determine the status of the particular material in question.

Due Process

The fifth amendment provides a general proscription against seizure of property without due process of law.7 Since impound involves the seizure of property, it is arguable that due process demands must be met before impoundment may take place.8 The Supreme Court has required that special safeguards be present before innocent articles can be seized. Thus, a discussion of seizures of property under the Copyright Act must take into account the Court's position on similar seizures under other statutes.

The leading cases in which the meaning of due process has been discussed in light of statutes allowing ex parte seizures are the repossession and wage garnishment cases,9 beginning in 1969 with Sniadach v. Family Finance Corp.10 Most states at that time had statutes allowing ex parte11 garnishment of wages and repossession of goods sold on credit.

Like section 503, these statutes typically required only that the person seeking the remedy apply to a magistrate and post a bond. Although other grounds for finding these statutes unconstitutional were asserted, the strongest arguments cen-
tered on the theme of a "taking of property."

Sniadach involved the Wisconsin wage garnishment law, which provided that wages could be frozen upon an order by the clerk of the court, mandating that the employer hold them pending resolution of the dispute. The Supreme Court found this procedure suspect since it deprived the laborer of his earnings without any opportunity to be heard and tender a defense on the merits.

The Court viewed the sole question as "whether there has been a taking of property without . . . procedural due process." The Court then pointed out that the basic elements of due process in this setting were notice and a hearing before the taking. The Court found no provision for either in the Wisconsin garnishment procedure and concluded it was constitutionally deficient in these respects.

The leading case on repossession is Fuentes v. Shevin. Like Sniadach, it dealt with a state statute permitting the seizure of property "simply upon the ex parte application of any other person who claims a right to them and posts a security bond." There was no provision for notice or a hearing before seizure.

Using a line of reasoning nearly identical to that in Sniadach, the Court found that minimum due process required notice and an advance hearing, and that neither of these were present in the statutes under consideration. The Fuentes Court went further, however, and pointed out that statutory provisions for a prompt post-taking hearing were insufficient. The Court noted: "The fourteenth amendment draws no bright lines around three-day, 10-day, or 50-day deprivations of property. Any significant taking of property by the state is within the purview of the Due Process Clause."

Two recent Supreme Court decisions have made analysis of fifth amendment problems in pretrial seizures more complicated. In Mitchell v. W.T. Grant Co., the Court upheld a

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119. 395 U.S. at 338 n.1.
120. Id. at 339.
121. Id.
122. Id. at 339-40.
123. Id. at 342.
125. Id. at 69-70.
126. Id. at 70.
127. Id. at 86.
Louisiana statute permitting ex parte seizures of goods sold under installment contracts. The statute under consideration was, like the Supreme Court Rules for impound, more protective of defendants than many similar statutes in that it allowed recovery for damages for wrongful deprivations including "injury to social standing or reputation as well as humiliation and mortification." It also required the seizure order to be issued by a judge, rather than a clerk. But it still clearly provided for ex parte seizure without notice.

The Mitchell Court distinguished Sniadach because it dealt with wages, "a specialized type of property presenting distinct problems in our economic system." It also distinguished Fuentes, even though it dealt with repossession, because the unconstitutional statute in Fuentes was, in several details, less protective than the Louisiana statute.

The Mitchell Court seemed to draw a line between ex parte takings of property which are reasonable, and those which are not. Mitchell clearly indicates that in the Court's opinion it is possible in limited circumstances to seize property without prior notice and a hearing and yet still satisfy the fifth amendment due process requirement.

The Court subsequently indicated its continued willingness to declare ex parte seizures of wages unconstitutional on due process grounds, despite Mitchell. In North Georgia Finishing Co. v. Di-Chem, Inc., a corporate bank account of $51,000 was seized under a Georgia law permitting issuance of a seizure order by a court clerk, based upon the affidavit of the claimant's attorney. The Court distinguished its contrary holding in Mitchell on the ground that the Georgia statute involved in Di-Chem did not have the protective features of the Louisiana statute in Mitchell. The differences were, first, that a judge issued orders in Louisiana whereas a clerk issues them in Georgia and, second, that a defendant was protected by a bond and was entitled to damages for wrongful seizures in

129. The Court set forth the relevant statutes in an appendix to its opinion. See id. at 620-23.
130. Id. at 606 n.8.
132. Id. at 615-18.
133. Id. at 616-17.
134. Id. at 618-19.
136. Id. at 602 n.1.
Louisiana while there were no such provisions in the Georgia law.\textsuperscript{137}

As noted previously, in\textit{ Jondora Music Publishing Co. v. Melody Recording, Inc.},\textsuperscript{138} the defendant charged that the pre-trial seizure in the infringement setting was an unconstitutional taking of property without due process of law.\textsuperscript{139} The district court rejected this claim, asserting that\textit{ Fuentes} and\textit{ Sniadach} did not apply: "It is fundamental that what 'process' is due depends upon the circumstances of each case. Here provisions exist to apply for relief from seizure. These are deemed sufficient to comply with the constitutional mandate."\textsuperscript{140} Thus, the district court apparently concluded, as the Supreme Court had in\textit{ Mitchell}, that some ex parte seizures are reasonable.\textsuperscript{141}

As the leading decisions highlight, the impound procedure presents major constitutional problems which have yet to be resolved. Within the ambit of the first amendment, impound can be viewed as an impermissible encroachment on the freedom of the press by providing for the seizure of articles capable of noninfringing uses.\textsuperscript{142} Within the realm of the fifth amendment, impound can be viewed as violative of the requirement that innocent articles not be seized without notice and a hearing.

**RESOLVING THE CONFLICT**

In ruling on the constitutional sufficiency of the impound procedure the Court will have to weigh the competing interests of the parties involved against the safeguards provided in the Constitution.

\textsuperscript{137} Id. at 610.

The commentators have also supported the continuing validity of\textit{ Sniadach} as requiring greater procedural safeguards in the garnishment setting. See, e.g., 63 GEO. L.J. 1337, 1347 (1975); Note, \textit{Constitutional Law—Prejudgment Garnishment}, 1975 Wis. L. Rev. 860, 867.

This position seems particularly defensible when one considers that one whose wages are garnished suffers a greater hardship than one whose chattels are repossessed.


\textsuperscript{139} See text accompanying note 111 supra.

\textsuperscript{140} 362 F. Supp. at 499-500.

\textsuperscript{141} Despite the constitutional issue raised by the pre-trial seizure without notice and a hearing, the Supreme Court denied certiorari.\textit{ Melody Recording, Inc. v. Jondora Music Publishing Co.}, 421 U.S. 1012 (1975).

\textsuperscript{142} There is also a fundamental conflict between the notions of copyright and freedom of expression. See, e.g., Goldstein, \textit{Copyright and the First Amendment}, 70 COLUM. L. REV. 983 (1970); Nimmer, supra note 5; Sobel, \textit{Copyright and the First Amendment: A Gathering Storm?}, 19 ASCAP COPYRIGHT L. SYMP. 43 (1971).
In a copyright dispute, the interests of each side are grounded in the Constitution. The plaintiff has an interest in immediate pretrial relief from the defendant's infringing activities, an interest which stems from the copyright clause of the Constitution. Conversely, the defendant has an interest in the protection of his freedom of expression as well as his freedom from takings of property without due process of law; also interests which stem from the Constitution.

To resolve the conflict between these competing interests the Court will be called upon to determine whether the needs of either party are strong enough to justify an intrusion upon the constitutional rights of the other. The Court will then determine how much intrusion upon the rights of the other is permissible.

The Competing Interests

Before a balancing test can be applied, an examination and definition of the competing interests is necessary. Careful scrutiny reveals that the interests in copyright infringement cases differ substantially in some respects from the interests in other types of seizures.

**Plaintiff's interests.** On plaintiff's side of the balance is, first, the public interest in preserving the value of copyrights. If the value of copyrights was to be lessened by limiting the courts' ability to enforce them, part of the incentive for producing creative works would be taken away. Clearly there is a public interest in providing an incentive for authors to produce.

Also on the plaintiff’s side of the balance is the copyright clause, which enables Congress to pass legislation giving authors the exclusive rights in their writings. Congress has passed such legislation, embodied in Title 17 of the United States Code, and it includes provisions for the enforcement of the copyright holder's rights against infringers.

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144. U.S. CONST. amends. I & V.
145. See generally notes 151-163 and accompanying text infra.
146. The Supreme Court has held that there is a public interest in copyright in addition to the interests of the copyright holder. See NIMMER ON COPYRIGHT, supra note 76, at § 3.1.
147. U.S. CONST. art. I, § 8. The enabling act in the Constitution says that Congress has the power to "secure" exclusive rights to authors, a clear mandate for putting teeth into a law safeguarding those rights.
Defendant’s interests. There are also two interests on defendant’s side of the balance. First, there is the public interest in the free dissemination of ideas. Any procedure, such as impound, which operates to suppress an idea before it is determined to be unprotected\textsuperscript{149} invades this public interest.

The defendant is also interested in his rights under the first and fifth amendments. Clearly, the rights to free expression and due process of law before the taking of property can affect nearly everything a person does. For purposes of pretrial seizures, however, the defendant’s interest in these rights is his interest in an impound procedure which is not unreasonable.\textsuperscript{150}

In the context of the first amendment, this involves a procedure which is the most likely to result in the seizure of only infringing articles and the least likely to restrict the freedom of expression. In the context of due process, this involves a procedure which is the most likely to guarantee adequate notice and a hearing before seizure and the least likely to omit either of these safeguards.

Developing the Balancing Test

Though the Supreme Court has not applied a balancing test to the impound provision, it has provided useful clues as to what such a test would involve in other cases in which competing interests were balanced to determine the reasonableness of an ex parte procedure. Mitchell v. W.T. Grant Co.\textsuperscript{151} is especially instructive since it involved an ex parte procedure which resembles the impound provision in several important respects.\textsuperscript{152}

Initially it must be recognized that while the Louisiana statute construed in Mitchell was similar to the impound provision, it was weighed against different interests than those

\textsuperscript{149} See note 113 and accompanying text \textit{supra}.

\textsuperscript{150} Obviously, no procedure will be error-free. The Supreme Court has stated that what is sought is the lowest possibility of error consistent with reasonable speed and fairness to plaintiffs—in other words, a procedure which is not likely to result in harm to the defendant:

\begin{quote}
If, on balance, the potential for harm to the defendant under the state-adopted procedure is slight, in light of substantial advancement of a legitimate state interest in providing ex parte preliminary relief, the pre-judgment procedure will be upheld as a constitutional accommodation of the conflicting interests.
\end{quote}


\textsuperscript{151} 416 U.S. 600 (1974).

\textsuperscript{152} See note 129 and accompanying text \textit{supra}.
which exist in an impoundment situation. To begin with, the plaintiff's interest in *Mitchell*—an interest in the restoration of goods sold on credit or payment on his contract, plus the public interest in the continued availability of credit—does not have the constitutional backing that the remedies for infringement have. Further, there were no first amendment claims in *Mitchell*; the question was only one of the reasonableness of the seizure and the procedure leading to the issuance of the warrant. Arguably, therefore, the plaintiff's side of the balance in the copyright-impound area has greater weight than it did in *Mitchell*, because of the constitutional foundation of copyright.

The *Mitchell* Court held that the Louisiana seizure statute gave rise to a reasonable procedure, and that seizures under it were not violative of the defendant's rights. The Court was not unmindful of the fact that in *Sniadach* and *Fuentes* seizure statutes had been overturned. In light of this, the *Mitchell* holding indicates that it is possible to have a "reasonable" pretrial seizure that comports with fifth amendment due process.

Three provisions in the Louisiana statute were critical to its being upheld as constitutional. First, unlike other seizure laws, but similar to section 101(c), the statute required presentation of the request for seizure before a neutral magistrate. Second, the statute required the party seeking seizure to post a substantial bond pending the outcome of the trial. Finally, an immediate post-seizure hearing was available at the defendant's request at which damages could be awarded for wrongful seizure.

The presence of these features led the *Mitchell* Court to conclude that the seizure statute adequately safeguarded the defendant's constitutional rights. Thus, the Court observed that the plaintiff could assert his statutory rights without unreasonably threatening the defendant's interest. 153

Against this backdrop, it appears the Court is focusing on whether or not a statute permitting ex parte seizure accomplishes its intended purpose without unduly encroaching on the rights of either party. The *Mitchell* statute achieved this accommodation by providing a pre-seizure hearing before a neutral judge, requiring the party seeking seizure to post a bond, and making available a prompt post-seizure hearing. In the wake of *Mitchell*, it would seem that an ex parte seizure procedure

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153. The Court said: "In our view, this statutory procedure effects a constitutional accommodation of the conflicting interests of the parties." 416 U.S. at 607.
embodying all three features would have substantial indicia of reasonableness.

Applying the Test

The strengths of the competing interests in the impound setting make the results of applying the balancing test far from certain. There are several avenues open to the Court in resolving either the due process or first amendment claims. The avenues selected by the Court must take into account the special nature of infringements—the fact that damage to the copyrighted work can occur instantaneously, thus calling for an especially speedy remedy.

Resolving the first amendment claim. Initially, the Court might conclude that the impound provision violates the first amendment on the ground that it is overbroad and has the capacity to punish protected speech when other less drastic procedures such as an injunction would not. This conclusion would be bottomed on the belief that the impound procedure, in permitting the seizure of articles without a determination that they are in fact infringing, inhibits the exercise of the constitutionally protected right to freely disseminate ideas.

Additionally, even if the Court does not find the impound procedure overbroad on its face, it could conclude that the procedure violates the first amendment by permitting the seizure of articles capable of noninfringing uses.

On the other hand, the Court might reasonably conclude that infringement is not protected by the first amendment, thus no first amendment claim can be relied on to attack the impound procedure in a copyright case.

Apart from this the Court could note that infringement is a proper subject of government regulation due to the copyright clause. In light of this fact, the Court might conclude that impound is a reasonable method of effectuating the government purpose given the plaintiff's need for speedy relief in an infringement case. Thus, the procedure does not improperly inhibit the exercise of constitutionally protected rights.

Resolving the due process claim. The Court could settle

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155. See notes 97-113 and accompanying text supra.
156. See notes 112-113 and accompanying text supra.
the issue of how much due process is required in an infringement case by reasoning that no due process is required in such a case. The foundation of this conclusion is the copyright clause, which would be held to provide an independent constitutional guarantee which supercedes the need for due process, and mandates the protection of the author's work by whatever procedures are deemed necessary by the legislature.

If the Court holds that due process applies, the issue will be how much process is due. In facing this question, the Court might view the impound procedure as not adequately protective of the defendant and thus depriving him of his property without due process in violation of the fifth amendment. In support of this, the Court could begin by noting that impound contains a high potential of harm to the defendant since it can deprive him of his source of income. Thus, by analogy to the wages protected in other cases, the defendant is being deprived of property deserving of special protection. With these considerations in mind the impound procedure could be adjudged constitutionally deficient since it does not provide for adequate notice and a hearing before seizing the property in question.

However, the Court could just as easily conclude the impound procedure is reasonable and fully protective of the defendant. The Court could begin by noting that the procedure requires the plaintiff to post a substantial bond, payable to the defendant should the court decide the plaintiff seized items in violation of the defendant's rights. This feature can be viewed as protecting the defendant from spurious claims, as it forces the plaintiff to incur a risk when he seeks impound.

Additionally, the Court might be persuaded that this is not a situation where special protection is demanded, since copyright defendants are generally well financed and do not suffer greatly at the hands of this ex parte remedy. Similarly, the Court could point out that the defendant's financial status will permit him to seek legal redress from the filing of suits based on less than solid contentions.

159. See notes 119-127 and accompanying text supra.
160. See app. A infra.
161. Compare this setting with that in the typical wage garnishment case. In the latter situation, the defendant is more likely to be seriously injured by being deprived of his property; he is more likely to be unable to afford counsel to protect his interests.
Finally, the Court could justify the existence of such an extraordinary procedure based on the fact that there is an independent constitutional mandate supporting it, and that proper deference for carrying out the intent of the founding fathers dictates that it deserves equal dignity. Thus, a possible encroachment on the defendant's due process rights is overcome by the need to balance competing constitutional concerns.

As the hypothetical resolutions indicate, the outcome of the balancing approach with respect to the impound procedure is far from certain. However, several factors point in favor of the constitutional adequacy of impound. First, the statute provides for two of the procedures found critical to a finding of reasonableness in *Mitchell*; presentation of the request for seizure before a neutral magistrate and the posting of a substantial bond by the party requesting seizure pending the outcome of the litigation.\(^{162}\) Second, the Constitution itself supports the adequacy of the procedure, by permitting the legislature to pass statutes deemed necessary to protect copyrighted works.\(^{163}\)

**Conclusion**

This comment has outlined the difficulties of application which pervade the pretrial remedies available to plaintiffs in copyright infringement actions. The impound provision has two major practical problems—the uncertainty of the amount of discretion the trial court has in granting impound, and the vagueness of the language which defines the scope of seizure permissible under the statute. The preliminary injunction procedure may be too cumbersome to be an effective tool in halting infringing activities before trial. The nature of the showing required by the court is unclear, and while evidence is being presented to the court the infringement may continue, further damaging the plaintiff. The injunction procedure requires notice to the defendant, which is protective of his interests but may also prevent the court from acting quickly enough to prevent irreparable harm to the plaintiff's copyright.

The constitutional conflicts inherent in the impound procedure have also been explored. Its first amendment problems stem from the more fundamental clash between the notions of copyright and freedom of expression. Its fifth amendment due


\(^{163}\) U.S. Const. art. I, § 8.
process problems raise questions of the propriety of all pretrial seizures.

However, seizures under the impound provision may not be subject to the same considerations as other seizures. This view is bottomed on realization that statutes safeguarding copyrighted works are mandated by the Constitution itself. In view of this constitutional underpinning, it seems reasonable to conclude that even in light of first amendment and due process concerns the impound provision will be upheld.164

Raoul Anthony Renaud

164. This comment was awarded first prize at the University of Santa Clara School of Law in the 1977 Nathan Burkan Memorial Competition sponsored by the American Society of Composers, Authors and Publishers.
Supreme Court Rules*

**Rule 3**

Upon the institution of any action, suit or proceeding, or at any time thereafter, and before the entry of final judgment or decree therein, the plaintiff or complainant, or his authorized agent or attorney, may file with the Clerk of any Court given jurisdiction under section 34 of the Act of March 4, 1909, an affidavit stating upon the best of his knowledge, information and belief, the number and location, as near as may be, of the alleged infringing copies, records, plates, molds, matrices, etc., or other means for making the copies alleged to infringe the copyright, and the value of the same, and with such affidavit shall file with the Clerk a bond executed by at least two sureties and approved by the Court or a Commissioner thereof.

**Rule 4**

Such bond shall bind the sureties in a specified sum, to be fixed by the Court, but not less than twice the reasonable value of such infringing copies, plates, records, molds, matrices, or other means for making such infringing copies, and be conditioned for the prompt prosecution of the action, suit or proceeding; for the return of said articles to the defendant, if they or any of them are adjudged not to be infringements, or if the action abates, or is discontinued before they are returned to the defendant; and for the payment to the defendant of any damages which the Court may award to him against the plaintiff or complainant. Upon the filing of said affidavit and bond, and the approval of said bond, the clerk shall issue a writ directed to the Marshal of the district where the said infringing copies, plates, records, molds, matrices, etc., or other means of making such infringing copies shall be stated in said affidavit to be located, and generally to any Marshal of the United States, directing the said Marshal to forthwith seize and hold the same subject to the order of the Court issuing said writ, or of the Court of the district in which the seizure shall be made.

**Rule 5**

The Marshal shall thereupon seize said articles or any

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smaller or larger part thereof he may then or thereafter find, using such force as may be reasonably necessary in the premises, and serve on the defendant a copy of the affidavit, writ, and bond by delivering the same to him personally, if he can be found within the district, or if he cannot be found, to his agent, if any, or to the person from whose possession the articles are taken, or if the owner, agent, or such person cannot be found within the district, by leaving said copy at the usual place of abode of such owner or agent, with a person of suitable age and discretion, or at the place where said articles are found, and shall make immediate return of such seizure, or attempted seizure, to the Court. He shall also attach to said articles a tag or label stating the fact of such seizure and warning all persons from in any manner interfering therewith.

Rule 7

Within three days after the articles are seized, and a copy of the affidavit, writ and bond are served as hereinbefore provided, the defendant shall serve upon the clerk a notice that he excepts to the amount of the penalty of the bond, or to the sureties of the plaintiff or complainant, or both, otherwise he shall be deemed to have waived all objection to the amount of the penalty of the bond and the sufficiency of the sureties thereon. If the Court sustain the exceptions it may order a new bond to be executed by the plaintiff or complainant, or in default thereof within a time to be named by the Court, the property to be returned to the defendant.

Rule 9

The defendant, if he does not except to the amount of the penalty of the bond or the sufficiency of the sureties of the plaintiff or complainant, may make application to the Court for the return to him of the articles seized, upon filing an affidavit stating all material facts and circumstances tending to show that the articles seized are not infringing copies, records, plates, molds, matrices, or means for making the copies alleged to infringe the copyright.

Rule 10

Thereupon the Court in its discretion, after such hearing as it may direct, may order such return upon the filing by the defendant of a bond executed by at least two sureties, binding them in a specified sum to be fixed in the discretion of the
Court, and conditioned for the delivery of said specified articles to abide the order of the Court. The plaintiff or complainant may require such sureties to justify within ten days of the filing of such bond.