Touching and concerning Copyright: Real Property Reasoning in MDY Industries, Inc. v. Blizzard Entertainment, inc

Molly Shaffer Van Houweling

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TOUCHING AND CONCERNING COPYRIGHT: 
REAL PROPERTY REASONING IN MDY 
INDUSTRIES, INC. V. BLIZZARD 
ENTERTAINMENT, INC.

Molly Shaffer Van Houweling*

I. INTRODUCTION

Copyright and patent law establish exclusive rights that attach to intangible works of authorship and invention. These rights are often entangled with separate property rights attached to tangible copies of those intangible works. For example, an author may own the copyright to a novel she has written while a reader owns a particular book embodying that novel.1 Because of the author's copyright, there are

* Professor of Law, University of California, Berkeley. Thanks to Eric Goldman, Jason Schultz, Brian Carver, and the other participants in the Santa Clara High Tech Law Institute's conference on "Exhaustion and First Sale in Intellectual Property," for which this article was prepared. Thanks also to Jennifer Rothman and other participants in the Loyola Law School, Los Angeles, IP Theory Colloquium; to Jeanne Fromer, Sonia Katyal, and other participants in the Fordham Law School IP & Innovation Colloquium; and to Cynthia Ho, Edward Lee, and other participants in the Chicago Intellectual Property Colloquium co-sponsored by Chicago-Kent College of Law and Loyola University Chicago School of Law.

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1. Section 202 of the Copyright Act makes this distinction clear: Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied. Transfer of ownership of any material object, including the copy or phonorecord in which the work is first fixed, does not of itself convey any rights in the copyrighted work embodied in the object; nor, in the absence of an agreement, does transfer of ownership

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certain things the reader may not do with the book, notwithstanding her ownership of it. For example, she may not—subject to certain exceptions—read aloud from it on a public stage to a paying audience. This and other limitations on the reader’s use of her own personal property are not the result of any special relationship she has with the author. Instead, these limitations adhere in the nature of the author’s intellectual property right, which runs with the intangible work of authorship (and, as a practical matter, with its tangible embodiment) to bind anyone who encounters it—including our initial reader and any subsequent possessors of her book.

These complicated intersections between intangible and tangible property rights are mediated by intellectual property “exhaustion.” This concept provides (through various specific doctrinal mechanisms in copyright, patent, and trademark law) that at least some of an intellectual property owner’s rights no longer apply—they are “exhausted”—upon the lawful transfer of an authorized embodiment of the protected intangible subject matter. Although the exhaustion concept is fuzzy around the edges and frustratingly under-theorized, one function it clearly serves is to limit the extent to which the intangible rights held by intellectual property owners can interfere with the freedom of owners of tangible objects to exercise rights normally incident to personal property ownership—to use those objects “in the ordinary pursuits of life,” as the Supreme Court has put it. In this way,

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2. This would amount to performing the work publicly, see 17 U.S.C. § 101 (defining “to perform . . . a work ‘publicly’” as, inter alia, “to perform . . . it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of family and its social acquaintances is gathered”). Public performance is an exclusive right of a copyright owner granted by 17 U.S.C. § 106(4). The paying audience would take this performance out of one exception for noncommercial performances, 17 U.S.C. § 110(4)(A), but it might qualify for other exceptions, see e.g., 17 U.S.C. § 110(4)(B), including fair use, 17 U.S.C. § 107.

3. My focus here will be on patent and, especially, copyright law. My analysis of exhaustion in these two contexts is shaped by the constitutional text that authorizes these bodies of law. Because trademark law does not share the same constitutional origin, my analysis does necessarily apply there.

exhaustion operates much like doctrines that have long limited the ways in which non-possessory interests in real property (so-called "servitudes") can interfere with the rights of landowners to use their land. Like those limiting doctrines, exhaustion's limits have been subject to pressure applied by property owners eager to have the force of law behind the novel restrictions they would impose on others.

In previous work I have described some of the limiting doctrines from the law of real servitudes, and have examined whether their rationales might also be relevant to contemporary questions about intellectual property. In this article I begin to examine, in more detail, one particular doctrinal restriction from the land servitude context—the "touch and concern" requirement. Touch and concern has long been maligned as anachronistic, indeterminate, and unnecessary. Some courts, and the recent Restatement (Third) of Servitudes, have abandoned the requirement altogether in the land servitude context. Ironically, the spirit—if not the exact terminology—of touch and concern may be reemerging as courts grapple with a new generation of servitude-like restrictions imposed by intellectual property owners.

The glimmer of this reasoning appears in MDY Industries, Inc. v. Blizzard Entertainment, Inc., where the Court of Appeals for the Ninth Circuit struggled to apply a specific statutory manifestation of exhaustion in the copyright context. MDY suggests that the reasoning underlying the touch and concern doctrine may be more useful in this new context than in the land context where it first arose.

U.S. 539).

6. See infra notes 61–64 and accompanying text.
7. See infra notes 53–54 and accompanying text.
8. MDY Indus. v. Blizzard Entm't, 629 F.3d 928 (9th Cir. 2010), as amended on denial of rehearing, 2011 WL 538748 (2011). I am not the only observer to see this glimmer. See, e.g., E-mail from Professor Greg Lastowka to CyberProf Listserv, Ninth Circuit Opinion in MDY v. Blizzard (Dec. 17, 2010) (on file with author).
II. LAND SERVITUDES, CHATTEL SERVITUDES, AND THE NEW SERVITUDES

A land servitude is a non-possessory property interest that gives its holder the right to use land in specified ways, to object to particular uses of it, or to insist on certain behavior connected to it. Servitudes are voluntarily created by property owners, typically in writing (but sometimes by estoppel, implication, or prescription) and with some manifestation of intent to create an encumbrance that “run[s] with” the land, “pass[ing] automatically to successive owners or occupiers.” Unlike a mere contractual agreement to, say, refrain from blocking your neighbor’s satellite dish, a servitude is enforceable against successors in interest. Therefore, if you grant your neighbor an effective servitude, she will be able to enforce the restriction against you and any subsequent owners of your land. The benefit of a servitude typically runs to successors as well—from your neighbor to the next owner of her house.

The land-use planning needs of the Industrial Revolution triggered the development of modern Anglo-American land servitude law. Increased urban density and the potential

9. This section relies heavily on my previous work on servitudes. See Van Houweling, supra note 5.

10. See generally RESTATEMENT (THIRD) OF PROP.: SERVITUDES § 1.1 (2000); Susan F. French, Design Proposal for the New Restatement of Property Servitudes, 21 U.C. DAVIS L. REV. 1213, 1214–15 (1988) (hereinafter French, Design Proposal) (explaining how various types of servitudes—including “easements, profits, covenants, and equitable servitudes”—“create interests running with the land. They create nonpossessory rights in the land of another, which pass with ownership or occupancy of the benefited land or estate, and corresponding duties, which pass with ownership or occupancy of the burdened land or estate.”); see also Susan F. French, Toward a Modern Law of Servitudes: Reweaving the Ancient Strands, 55 S. CAL. L. REV. 1261 (1982) (hereinafter French, Strands); Van Houweling, supra note 5, at 891–905.

11. RESTATEMENT (THIRD) OF PROP.: SERVITUDES § 1.1.

12. See, e.g., French, Strands, supra note 10, at 1264. On the complicated and evolving issue of when possessors who are not owners succeed to the benefits and burdens of servitudes, see RESTATEMENT (THIRD) OF PROP.: SERVITUDES, ch. 5, introductory note; GERALD KORNGOLD, PRIVATE LAND USE ARRANGEMENTS: EASEMENTS, REAL COVENANTS AND EQUITABLE SERVITUDES §§ 5.03, 9.14(b)-(c) (2d ed. 2004).

13. Easements existed in Roman law and running covenants were recognized as early as Spencer’s Case, (1583) 77 Eng. Rep. 72 (K.B.), in 1583. But “until the Industrial Revolution greatly increased the use of servitudes, the common law did not develop a general theory of easements or servitudes.” French, Design Proposal, supra note 10, at 1214; see also Uriel Reichman,
for conflicts between neighboring property owners prompted a variety of attempts to coordinate land uses through durable private arrangements.¹⁴ Nineteenth-century English courts reacted to this development with ambivalence. They recognized affirmative easements—rights of way and other non-possessory rights to use burdened land.¹⁵ And under very limited circumstances they enforced running duties to use land in specified ways as negative easements or as “real covenants.”¹⁶ But the courts resisted most attempts to enforce running use restrictions against successors until the landmark 1848 case of Tulk v. Moxhay.¹⁷ In Tulk, the Court of Chancery established the notion of an “equitable servitude”—a land-use restriction that binds successors to the burdened land who take the land with notice of the restriction.¹⁸

Although Tulk liberalized the English law of servitudes somewhat, even courts of equity following Tulk imposed a thicket of doctrinal limitations on attempts to impose running use restrictions.¹⁹ Many of these doctrinal restrictions imposed by English courts were imported into early U.S. decisions.

Over time, however, the law in the United States has become more accommodating toward real servitudes. Courts (in addition to commentators and some state legislatures) seem convinced by the argument that land servitudes can promote efficient land use and can be fair to successors in interest, so long as everyone burdened has the opportunity for clear notice—an opportunity that modern recording systems generally provide.²⁰


¹⁵. See generally Winokur, supra note 14, at 12.

¹⁶. See generally id. at 12 & n.43.

¹⁷. (1848) 41 Eng. Rep. 1143 (Ch.).

¹⁸. As Lord Cottenham explained in Tulk, “the question is . . . whether a party shall be permitted to use the land in a manner inconsistent with the contract entered into by his vendor, and with notice of which he purchased.” Id. at 1144.

¹⁹. See generally Simpson, supra note 14, at 256–60 (describing development of English case law before and after Tulk).

²⁰. See generally French, Design Proposal, supra note 10, at 1223
While courts have increasingly accommodated land servitudes, the conventional wisdom under Anglo-American law has long been that the types of servitudes that can be attached to land cannot be attached to chattels.\textsuperscript{21} Several rationales have been offered for this prohibition, including the difficulty of ensuring adequate notice of chattel servitudes in the absence of the recording systems that provide notice in the land context.\textsuperscript{22} In the late nineteenth and early twentieth centuries, U.S. courts grappled with the tension between this general rule of the common law and the non-possessory statutory rights that copyright and patent law create.\textsuperscript{23} The issue is a complicated one. In the limited way noted above,\textsuperscript{24} every copyright and patent creates the type of non-possessory right to control the use of chattels that common law has traditionally refused to recognize.\textsuperscript{25} Technically, the

(“Servitudes law may be simplified substantially because particular rules designed to give notice are no longer needed. The modern technology of record systems and title search procedures, together with the protection recording acts afford, have made these rules superfluous.”).


\textsuperscript{22} See, e.g., Hansmann & Kraakman, supra note 21, at 407, arguing that: Part of the reason [that it is so “much simpler to establish partial rights in real property than in personal property”] is that the registries developed for verifying ownership of land are available to record these other [partial] interests as well, hence avoiding many of the additional system and nonuser costs that effective verification of these rights would otherwise require.

\textsuperscript{23} See generally Van Houweling, supra note 5, at 906–25.

\textsuperscript{24} See generally Van Houweling, supra note 5, at 910–24 (discussing cases).

\textsuperscript{25} See supra Part I.
subject matter of these intellectual property regimes extends only to intangible works of authorship and invention, not to the tangible objects embodying those works. But because of that embodiment, the regimes necessarily impose some constraints on use of the physical objects as well. The concept of intellectual property "exhaustion" can be understood as an attempt to minimize the extent to which those constraints cover "ordinary" uses of copies of copyrighted works and of physical objects that embody patented inventions.26

When the lawful owner of a patented phonograph machine uses it to play records, for example, he does not thereby infringe the patent—notwithstanding the Patent Act’s prohibition on unauthorized "use" of patented inventions.27 Courts have explained that the initial authorized sale of a patent-embodying item "terminates" or "exhausts" the patent holder's rights. This doctrine has come to be known as patent exhaustion.28 In copyright, many ordinary uses of copies of copyrighted works simply do not implicate an exclusive right of the copyright holder at all, as there is no exclusive right to "use" in the Copyright Act.29 Using a physical book by reading it, for example, does not require authorization. Showing or selling (or giving, or lending, etc.) the book to someone else is also not generally covered by copyright—notwithstanding the copyright owner's exclusive rights to display and distribute copies to the public30—because of limiting doctrines in copyright that are analogous to patent exhaustion.

Similar to patent exhaustion, these copyright doctrines were initially articulated by courts.31 But they were also

26. E.g., Bloomer v. McQuewan, 55 U.S. 539, 549 (1852) ("The purchaser of the implement or machine for the purpose of using it in the ordinary pursuits of life, stands on different ground . . . .[W]hen the machine passes to the hands of the purchaser, it is no longer within the limits of the monopoly.").
28. E.g., Quanta Computer, Inc. v. LG Elecs., Inc., 553 U.S. 617, 625 (2008) ("The longstanding doctrine of patent exhaustion provides that the initial authorized sale of a patented item terminates all patent rights to that item.").
30. 17 U.S.C. §§ 106(3) & 106(5) (establishing the copyright owner's exclusive right "to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending" and "to display the copyrighted work publicly").
31. See generally Aaron K. Perzanowski & Jason Schultz, Digital Exhaustion, 58 UCLA L. REV. (forthcoming Apr. 2011) (draft manuscript}
codified, at least in part, in the Copyright Act of 1909,32 which introduced a statutory provision commonly referred to as the "first sale doctrine." The codified first sale doctrine currently resides in § 109 of the Copyright Act, where it limits copyright holders’ rights to control the display and distribution of lawfully made copies of their works by owners of those copies.33 More recently, Congress added a separate provision in § 117 that limits copyright holders’ reproduction rights in a way that privileges ordinary uses of copies of computer software.34 This limit, known as the "essential step" exception, allows an owner of a copy of a computer program to reproduce that copy to the extent necessary to use the program on her computer.35

Despite these legislative recognitions of the exhaustion concept in the copyright context, and the Supreme Court’s recent reiteration of the importance of patent exhaustion in *Quanta Computer, Inc. v. LG Electronics,*36 these doctrines

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32. Copyright Act of 1909, ch. 320, § 41, Pub. L. No. 60-349, 35 Stat. 1075 (1909). The provision is now 17 U.S.C. § 109, which specifies in relevant part that:

the owner of a particular copy or phonorecord lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord ... [and that] ... the owner of a particular copy lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to display that copy publicly, either directly or by the projection of no more than one image at a time, to viewers present at the place where the copy is located.

*Id.*

As Perzanowski and Schultz explain, the codified first sale doctrine of current § 109 only incompletely captures the principle of copyright exhaustion developed in the courts. See Perzanowski & Schultz, *supra* note 31, at 29-45.


35. The relevant language of that provision states that:

it is not an infringement for the owner of a copy of a computer program to make or authorize the making of another copy or adaptation of that computer program provided ... that such a new copy or adaptation is created as an essential step in the utilization of the computer program in conjunction with a machine and that it is used in no other manner.


36. 553 U.S. 617 (2008). The Court also had a recent opportunity to address first sale under the Copyright Act, but an equally divided Court affirmed the decision of the lower court without issuing an opinion. Costco Wholesale Corp. *v.* Omega, S.A., 131 S. Ct. 565 (2010).
have over the past several decades begun more and more to resemble the law of land servitudes. Non-possessory restrictions that once met judicial hostility have been accommodated, at least in cases where the burdened party acquired the intellectual property-embending chattel with notice of the restrictions. There are reasons to doubt whether enforcement of these “new servitudes” is generally desirable. But for now I want to focus on another question: assuming it is possible for intellectual property owners to impose—with notice—use restrictions on copies of their works, what substantive limitations should there be on the terms of those restrictions? In the land context, this question has traditionally been addressed with the “touch and concern” requirement.

III. THE TOUCH AND CONCERN REQUIREMENT IN THE LAW OF LAND SERVITUDES

Among the servitude-limiting doctrines imposed by English courts and initially adopted by U.S. courts was the requirement that running duties or restrictions (whether recognized as real covenants or equitable servitudes) “touch and concern” both the burdened and benefitted land. What

37. See, e.g., Vernor v. Autodesk, Inc., 621 F.3d 1102 (9th Cir. 2010); Mallinckrodt, Inc. v. Medipart, Inc., 976 F.2d 700 (Fed. Cir. 1992); United States v. Wise, 550 F.2d 1180 (9th Cir. 1977).
39. See infra notes 41–43 and accompanying text.
40. This section relies heavily on my previous work on servitudes. See Van Houweling, supra note 5.
41. See generally KORNGOLD, supra note 12, at 348 (“Under the prevailing rule, the courts hold that a covenant must touch and concern the land in order for it to run. This is a requirement in actions both at law and in equity.”); French, Strands, supra note 10, at 1277.
42. As Restatement Reporter Susan French helpfully summarizes, “[t]raditional servitudes doctrine requires that covenant burdens and benefits touch and concern the land if they are to pass automatically to successors of the original covenanting parties. The doctrine . . . applies regardless of the parties’ intent, limiting the kinds of covenants that can be made into servitudes.” Susan F. French, The Touch and Concern Doctrine and the Restatement (Third) of Servitudes: A Tribute to Lawrence E. Berger, 77 NEB. L. REV. 653, 653 (1998) (citing Spencer’s Case, (1583) 77 Eng. Rep. 72 (K.B.)); see generally KORNGOLD, supra note 12, at 349 (“The authorities mostly agree that touch and concern
the burdened party is required to do (or to refrain from doing) must be connected to her land and also to the land of the party enforcing the servitude. Imagine that a landowner sells half of her land subject to a purported real covenant binding the buyer and her successors in interest to sing "Happy Birthday" annually for the benefit of the owner of the retained parcel. The touch and concern doctrine could be applied to render such a non-land-use-related servitude unenforceable against successors.

The touch and concern requirement has been defended on several grounds. One justification for the doctrine is that it promotes notice, because restrictions and duties tied to land use are relatively easy to discover upon physical inspection. Another justification is that non-land-use-related restrictions and duties are likely to satisfy merely the idiosyncratic whims of the original parties—and therefore to become obsolete with the passage of time. As Uriel Reichman argues, "obligations not related to actual property use are highly individualized. They tend, therefore, to become inefficient in the short run following a transfer." Relatedly, Reichman objects to limiting the autonomy of future generations without the type of land-use justification that the doctrine requires. As he argues,

means that in order for a covenant to run, there must be some fundamental link between the promise and the burdened and benefited land. The question of touch and concern must be analyzed on both sides of the covenant.

43. One widely-cited articulation of the test is whether the servitude "operate[s] to make more valuable some of the rights, privileges, or powers possessed by the covenantee or to relieve him in whole or in part of some of his duties." Harry A. Bigelow, The Content of Covenants in Leases, 12 Mich. L. Rev. 639 (1914). A variation provides that

[i]f the promisor's legal relations in respect to the land in question are lessened—his legal interest as an owner rendered less valuable by the promise—the burden of the covenant touches or concerns that land; if the promisee's legal relations in respect to that land are increased—his legal interest as owner rendered more valuable by the promise—the benefit of the covenant touches and concerns the land.

Charles E. Clark, Real Covenants and Other Interests Which "Run with Land" 97 (2d ed. 1947).

44. See generally Korngold, supra note 12, at 352–53 (summarizing commentary critiquing and defending the doctrine).

45. See Hansmann & Kraakman, supra note 21, at 402 (noting that servitudes touching and concerning the land "are much easier to verify upon physical inspection of property").

46. Reichman, supra note 13, at 1233.
Private property is sanctioned by society not only to promote efficiency, but also to safeguard individual freedom. Servitudes are a kind of private legislation affecting a line of future owners. Limiting such "legislative powers" to an objective purpose of land planning eliminates the possibility of creating modern variations of feudal serfdom.  

Although Reichman is not its only defender, the touch and concern doctrine has more often been scorned by commentators and evaded by courts. One objection is that its purported purposes are better served by other mechanisms. Notice can be provided through land recording systems, for example. And substantively obsolete or unreasonable servitudes can be judicially modified or terminated ex post as needed.  

As for Reichman’s argument that limiting the autonomy of future generations is not justifiable without an “objective purpose of land planning,” this rationale for the touch and concern doctrine is vulnerable in the absence of some agreed-upon set of land planning purposes. If a landowner gets special enjoyment (and attaches additional value to her land) because she is secure in the knowledge that her neighbors and their successors will forever be required to sing “Happy Birthday” to her and to her successors, then imposing that requirement arguably is a “land planning” purpose—unless we have some theory of “land planning” that rejects such whims. In his critique of touch and concern, Richard Epstein argues that the purposes of land ownership cannot be cabined in that way:

47. Id.


49. See generally French, supra note 42, at 654.

50. See, e.g., KORNGOLD, supra note 12, at 353, arguing that: [t]he current touch and concern test ... may not be the best way to control inefficient and eccentric covenants in all cases ... [and that] ... courts should straightforwardly face the issues inherent in difficult covenants ... and resolve them in terms of articulated policies as well as the values of freedom of contract, and the policy against land restrictions.

Id.; French, Strands, supra note 10, at 1308; French, supra note 42, at 654.
Insistence that the attachment of merely personal obligations to land is likely to frustrate, rather than enhance, the objectives which a private land holding system seeks to realize presupposes that we have some collective vision of what that system is supposed to do. Yet one traditional argument for both freedom of contract and private property is that they define domains in which individuals may establish both the means and the ends for themselves, to pursue as they see fit (so long as they do not infringe upon the rights of third parties). Private property is an institution that fosters individualized, if not eccentric, preferences; it does not stamp them out. We may not understand why property owners want certain obligations to run with the land, but as it is their land, not ours, some very strong reason should be advanced before our intentions are allowed to control.

Epstein's rejection of any "collection vision" for property may represent an extreme view. But he is not alone in criticizing the touch and concern doctrine for failing to provide a satisfactory theory of the purposes that servitude restrictions may validly serve. In sum, the touch and concern doctrine has been justified in terms of limiting notice and information costs, preempting servitude obsolescence, and keeping enforcement of non-possessory property rights consistent with the purposes of private land ownership. But it has been criticized on the grounds that insufficient notice and obsolescence are addressed by superior alternative mechanisms, and that using the purposes of land ownership as a touchstone will either be hopelessly indeterminate or else will impose limitations that reflect an unjustifiably cramped notion of the ends of property ownership. In light of these and other criticisms, some U.S. courts have relaxed the touch and concern requirement. The recent Restatement (Third) of Property: Servitudes abandons touch and concern.

52. Even Jeffrey Stake, a defender of touch and concern, acknowledges that the foremost articulation of the touch and concern doctrine "runs in a circle." Stake, supra note 48, at 929.
53. See Richard R. Powell, Powell on Real Property § 60.04 (2005); Sterk, supra note 48 at 649 n.141 (noting the paucity of case law invalidating servitudes for failure to satisfy the touch and concern requirement).
altogether.  

IV. REVIVING TOUCH AND CONCERN TO CONTROL THE NEW SERVITUDES

Contemporary attempts to impose novel running restrictions on the use of intangible works of authorship and invention—and thus on the tangible objects embodying those works—can be analyzed as servitudes. Some observers use the servitude characterization to call these restrictions into question. To others, judicial enforcement of servitude-like restrictions on users of intellectual creations and their embodiments is consistent with the liberalizing attitude toward land servitudes and rightly represents the preeminence of freedom of contract over hostility towards restraints on resource use and transfer.

The judicial reception has been mixed, but at least some courts have allowed both patent and copyright owners to impose (and to enforce through infringement lawsuits) running restrictions on users of copies of their intellectual works. The primary mechanism by which this move has been accomplished, notwithstanding the exhaustion doctrines described above, is the characterization of a user’s relationship to the embodiment of a work as a mere “license” to use it. The scope of this “license” is then determined by

54. RESTATEMENT (THIRD) OF PROP.: SERVITUDES §§ 2.4, 2.6, 3.2, and introductory notes to chs. 2 & 3 (2000).
56. E.g., Elkin-Koren, supra note 55; Radin, supra note 55.
57. Robinson, supra note 21.
58. E.g., Vernor v. Autodesk, Inc., 621 F.3d 1102 (9th Cir. 2010); Mallinckrodt, Inc. v. Medipart, Inc., 976 F.2d 700 (Fed. Cir. 1992); United States v. Wise, 550 F.2d 1180 (9th Cir. 1977).
59. See generally Carver, supra note 38; Rothchild, supra note 38.
consulting an “End User License Agreement” (EULA) or “Terms of Use” (ToU) provided by the copyright or patent owner.\textsuperscript{60}

As a practical matter, this accomplishes the same result as those cases that liberalized the law of land servitudes: allowing original parties to transfer possession of an object and to characterize that transaction in a way that imposes property-based restrictions running to subsequent possessors of the object, whether or not there is any contractual relationship between the ultimately benefited and burdened parties. But recognizing the possibility of running use restrictions—the intellectual property equivalent of \textit{Tulk v. Moxhay}—does not resolve the question of what (if any) substantive limitations there should be upon those restrictions. Should there be, in other words, a touch and concern doctrine for intellectual property servitudes?

On first utterance, the notion seems laughable. Why address digital-age intellectual property puzzles by reviving a land law doctrine that has, even in its native doctrinal context, been characterized as “anachronistic,”\textsuperscript{61} “superseded,” “a confusing artifact of history,”\textsuperscript{62} a “hoary requirement . . . relegated to the dustbin,”\textsuperscript{63} and “a feudal relic best abandoned”?\textsuperscript{64} Indeed, to my knowledge, no court has in fact expressly invoked the much-maligned “touch and concern” doctrine in this intellectual property context. But, as at least one other observer has noted,\textsuperscript{65} the Ninth Circuit’s recent decision in \textit{MDY Industries, Inc. v. Blizzard Entertainment, Inc.}\textsuperscript{66} employs an analysis of a running

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\item[\textsuperscript{60}]
See generally Rothchild, supra note 38.
\item[\textsuperscript{61}]
Winokur, supra note 14, at 143.
\item[\textsuperscript{62}]
Robinson, supra note 21, observing that:
\texttt{[t]he latest Restatement of Property, reflecting a growing body of scholarly opinion that believes the touch and concern doctrine is just a confusing artifact of history, concludes that it is “superseded,” leaving only specific limitations on certain restraints, such as those that impose unreasonable restraints on alienation or violate some other public policy.}
\textit{Id.} at 1461 n.36.
\item[\textsuperscript{63}]
\item[\textsuperscript{64}]
Tarlock, supra note 48, at 809 (defending the doctrine to some extent, but observing that “[t]o many, the touch and concern doctrine is a feudal relic best abandoned”).
\item[\textsuperscript{65}]
See Lastowka, supra note 8.
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629 F.3d 928 (9th Cir. 2010), \textit{as amended on denial of rehearing}, 2011
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restriction on a copy of a copyrighted work that echoes—and perhaps improves upon—touch and concern.

V. *MDY v. Blizzard's "Nexus" with Touch and Concern*

In *MDY*, the Ninth Circuit addressed a dispute between Blizzard Entertainment and Michael Donnelly regarding Blizzard's popular online game "World of Warcraft."\(^67\) Donnelly initiated the lawsuit, asking the district court to declare that he did not infringe copyright—or any other right Blizzard possessed in the game—when he sold his own software, a program called "Glider," to World of Warcraft players.\(^68\) Glider is a "bot" program that automatically plays the World of Warcraft game for a user, so that she can proceed to advanced levels of the game, even while away from her computer.\(^69\) As Donnelly's website explained, "[y]ou can do something else, like eat dinner or go to a movie, and when you return, you'll have a lot more experience and loot."\(^70\)

Blizzard countersued on various theories and the district court held Donnelly liable for secondary copyright infringement, for a violation of the Digital Millennium Copyright Act (DMCA), and for tortious interference with contract.\(^71\) My focus here is on the secondary copyright infringement claim, on which the Ninth Circuit held for Donnelly.\(^72\) I leave for another day the intriguing contrast with the court's DMCA analysis in favor of Blizzard.

The court's copyright analysis turned in part on the "essential step" provision in § 117(a)(1) of the Copyright Act. The provision, described briefly above, declares that

it is not an infringement for the owner of a copy of a computer program to make or authorize the making of another copy or adaptation of that computer program provided . . . that such a new copy or adaptation is created as an essential step in the utilization of the computer

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\(^{67}\) Id. at 934-35.  
\(^{68}\) Id. at 935.  
\(^{69}\) Id.  
\(^{70}\) Id.  
\(^{71}\) Id. at 936-37 (providing procedural history).  
\(^{72}\) MDY Indus. v. Blizzard Entm't, 629 F.3d 928, 941-42 (9th Cir. 2010), as amended on denial of rehearing, 2011 WL 538748 (2011).
program in conjunction with a machine and that it is used in no other manner.\textsuperscript{73}

As with other manifestations of the exhaustion concept, this provision limits the extent that copyright holders may deploy their non-possessory rights to limit ordinary uses of their works by owners of lawfully made copies.\textsuperscript{74} And also as with other types of exhaustion, some courts have allowed copyright owners to forbid even "essential step" copies by characterizing transactions by which users acquire their initial copies as "licenses," as opposed to "sales."\textsuperscript{75}

The applicability of the essential step provision was important in \textit{MDY} because the kernel of Blizzard's copyright infringement argument was that the users were directly infringing its copyrights (and that Donnelly was secondarily liable for helping those users) when they played World of Warcraft using Glider.\textsuperscript{76} The only aspect of the players' use that implicated Blizzard's exclusive rights under copyright was the copying of World of Warcraft into the temporary memory of their computers for purposes of playing the game—just the type of behavior that the essential step provision seems to privilege.

Indeed, Donnelly argued that the players' use of the World of Warcraft software fell within the essential step exception and was therefore not infringing.\textsuperscript{77} But users would not be shielded by the essential step exception if they were not "owner[s]" of copies as the term is used in § 117.\textsuperscript{78} On this question, the Ninth Circuit sided with Blizzard. Copies of the game software were distributed with an End User License Agreement that the court interpreted, together with the Terms of Use for the World of Warcraft online service, as imposing so many restrictions on transfer and use that the users should be considered as mere "licensees" rather than owners.\textsuperscript{79} To reach this conclusion, the Ninth Circuit

\textsuperscript{75}. See, e.g., Wall Data Inc. v. L.A. Cnty. Sherriff's Dept', 447 F.3d 769, 784–85 (9th Cir. 2006).
\textsuperscript{76}. \textit{See MDY}, 629 F.3d at 937–38.
\textsuperscript{77}. \textit{Id.} at 938.
\textsuperscript{78}. 17 U.S.C. § 117(a).
\textsuperscript{79}. \textit{MDY Indus. v. Blizzard Entm't}, 629 F.3d 928, 938–39 (9th Cir. 2010), as
followed its own controversial logic from Vernor v. Autodesk,\(^8\) in effect allowing the copyright holder to impose, via EULAs and ToUs, servitudes that restrain the otherwise permissible, “ordinary” behavior of users in lawful possession of copies of copyrighted works.

I leave to another day the important question of whether Vernor was correctly decided and applied in MDY (while noting that this question is made even more interesting by the same court’s recent application of Vernor to reach the opposite result in UMG Recordings, Inc. v. Augusto\(^81\)). What is key, for purposes of this article, is that the Ninth Circuit simultaneously recognized the possibility of this type of servitude and imposed substantive limits on its terms. In the land context, this type of substantive scrutiny of the terms of servitudes has typically been conducted through the doctrinal lens of the maligned “touch and concern” requirement. The Ninth Circuit breathes new life into that moribund concept with its analysis in MDY.

In the land servitude context, courts that apply the touch and concern doctrine are fundamentally determining whether a restriction should be treated as a property right or (because it fails to “touch and concern” and is therefore not a valid servitude) as a mere contract (with the limitations on privity and remedies that come with that label). In MDY, the Ninth Circuit drew an analogous distinction between property (copyright) and contract, using a touch-and-concern-like approach to determine whether the restrictions at issue could be enforced as property rights.

Specifically, once the court had determined that the users did not qualify for the essential step exception, it was left with Blizzard’s argument that the temporary copies that users made while playing the game were infringing on Blizzard’s copyright. Although its EULA and ToU gave paying users permission to play the game (and thus to make temporary copies of it), Blizzard argued that the permission was conditioned on compliance with the terms set forth in the EULA and ToU, including a prohibition on use of “third-party software designed to modify the World of Warcraft


80. 621 F.3d 1102 (9th Cir. 2010).

81. 628 F.3d 1175 (9th Cir. 2011).
experience." Under that argument, no compliance means no license to use the software—no license (plus no essential step exception) means that playing the game (which necessarily involves copying) amounts to infringement by the users and secondary liability for Donnelly. In other words, Blizzard demanded a property remedy for violation of the restrictions it had inserted into its EULA and ToU.

To the Ninth Circuit, there was an alternative possibility: although the court said the that this type of restriction could be enforceable as a property right—even against lawful possessors of copies of the software—it imposed a substantive screen to determine whether these particular restrictions should be considered "conditions" that qualify for servitude-like treatment, or as mere contractual "covenants." The distinction is legally significant because a plaintiff asserting a breach of covenant is left solely with contractual remedies against defendants in contractual privity. As the court explained, "[w]e refer to contractual terms that limit a license's scope as 'conditions,' the breach of which constitute copyright infringement. We refer to all other license terms as 'covenants,' the breach of which is actionable only under contract law.

This aspect of the case, thus, came down to the same fundamental question that courts face when they apply the touch and concern doctrine to land servitudes: does the substance of this restriction make it eligible for enforcement as an in rem property right—binding possessors of the land beyond the bounds of contractual privity—or must the parties rely instead on whatever promises they have made between each other (and on the limited remedial options in breach of contract actions)?

As with servitutes, the intent of the initial parties to any restriction is one aspect of determining whether that restriction should be considered a property interest, as opposed to a mere contract. And so the Ninth Circuit looked in part to the way the World of Warcraft EULA and ToU

82. MDY, 629 F.3d at 938.
83. Id. at 939–41.
84. See id. at 941 n.3 (explaining why "a copyright holder may wish to enforce violations of license agreements as copyright infringements" as opposed to mere breaches of contract).
85. Id. at 939.
described the key restrictions at issue. But if this were the only relevant consideration, a well-drafted license could characterize any manner of restrictions as conditions of the license. If a user were to play the game without complying with those restrictions, the act of playing the game (insofar as it involved making a copy that is outside of § 117) would establish a prima facie case of copyright infringement. A license could say, for example: “permission to reproduce this software for purposes of playing the game is granted only on the condition that the player submits three positive reviews to the GameRate videogame review website.” If conditions were not subject to any substantive scrutiny, then failure to submit the positive reviews would take the player’s copying outside the scope of the license and therefore into the realm of copyright infringement. The Ninth Circuit describes this possibility:

Blizzard—or any software copyright holder—could designate any disfavored conduct during software use as copyright infringement, by purporting to condition the license on the player's abstention from the disfavored conduct. The rationale would be that because the conduct occurs while the player's computer is copying the software code into RAM in order for it to run, the violation is copyright infringement.

If we were to borrow Epstein's logic from the land servitude context, there is nothing wrong with this scenario: if a copyright owner who can forbid copying altogether decides instead to condition the permission to copy on compliance with some idiosyncratic whim, so be it. To see why the touch and concern requirement may be more useful in this context than in its native domain, recall that Epstein's biting critique of limitations on land servitudes turned on the absence of "some collective vision of what [a private land holding system] is supposed to do." Whatever the validity of Epstein's claim in the land context, it does not apply to

86. A similar logic would allow a copyright owner to impose running restraints on the distribution or display of copies, if the copies had managed to evade the first sale doctrine of 17 U.S.C. § 109 following the logic of, e.g., Vernor v. Autodesk, Inc., 621 F.3d 1102 (9th Cir. 2010).
87. MDY Indus. v. Blizzard Entm't, 629 F.3d 928, 941 (9th Cir. 2010), as amended on denial of rehearing, 2011 WL 538748 (2011).
88. Epstein, supra note 51, at 1359 and accompanying text.
89. I certainly do not mean to endorse Epstein's view in the land context.
intellectual property—where the purpose of the exclusive rights is constitutionally defined as to “promote of Progress of Science and useful Arts.”\(^9\) If the essence of the touch and concern inquiry is to probe whether a given restriction affects the value of burdened and benefitted resources, however “value” is defined in the given property scheme, then the inquiry simply makes more sense where value can be defined with reference to the property scheme’s clearly-specified purpose.

An example from another type of copyright dispute helps demonstrate the point. In *Campbell v. Acuff-Rose Music, Inc.*,\(^9\) the Supreme Court’s fair use analysis turned in part on the statutory factor of “the effect of the use upon the potential market for or value of the copyrighted work.”\(^9\) In his analysis of that factor, Justice Souter posed the interesting question whether it should count against a claim of fair use that the defendant has employed the copyright holder’s expression to ridicule the copyright holder, and therefore to hurt the marketplace value of his work.\(^9\) Justice Souter concluded that it should not, explaining that “[w]e do not, of course, suggest that a parody may not harm the market at all, but when a lethal parody, like a scathing theater review, kills demand for the original, it does not produce a harm cognizable under the Copyright Act.”\(^9\) Why not? Surely a “lethal parody” has an effect on the “value of the copyrighted work” in the sense that a copyright owner measures “value.” And yet Souter insists that this diminution in value is simply not cognizable under the Copyright Act. This conclusion makes perfect sense only if one recognizes that the Copyright Act protects the value of copyrighted works not to satisfy the whims of copyright owners, but rather for a specific purpose: to promote intellectual progress. Souter’s logic here reflects the notion that progress would be undermined, not promoted, by deploying copyright to protect copyright owners from critique.

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\(^9\) U.S. CONST. art. I, § 8, cl. 8.
\(^9\) Id. at 590.
\(^9\) See id. at 591–92.
\(^9\) Id.
Importing this logic into a touch-and-concern-style analysis might yield a rule such as this: a copyright license condition that purports to impose a running restriction on use of a copy of a copyrighted work is enforceable only where its enforcement would promote the purposes of the copyright holder's exclusive rights. This proposed rule is not so different from what the Ninth Circuit appears to have adopted in *MDY*.

The Ninth's Circuit's substantive screen for sorting enforceable conditions from mere covenants is this: "We conclude that for a licensee's violation of a contract to constitute copyright infringement, there must be a nexus between the condition and the licensor's exclusive rights of copyright." With its focus on the substantive connection between the restriction and the property right, this appears similar to the touch and concern requirement. Alas, as with touch and concern, the nature of the relationship required to satisfy the test is a bit unclear.

One way to understand the Ninth Circuit's nexus requirement is that enforceable license conditions are only those that forbid behavior that would—when viewed in isolation—violate an exclusive right of the copyright holder if undertaken without a license. For example, a license might say, "the licensor may copy the work for non-commercial but not for commercial purposes." The condition—no non-commercial copying—restricts behavior that, but for the license, would be a copyright infringement. By contrast, understanding the nexus requirement in this way would likely exclude my hypothetical license that requires submission of favorable game reviews as a condition of playing the game. It is possible to identify the regulated behavior (submission of favorable game reviews) separately from the licensed behavior (copying the game for purposes of playing it). But if this is how to understand "nexus," then it is unclear why there was not a nexus in *MDY*, where the forbidden conduct itself—playing World of Warcraft with Glider—involved making a copy of Blizzard's copyrighted game on the user's computer.

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95. MDY Indus. v. Blizzard Entm't., 629 F.3d 928, 941 (9th Cir. 2010), as amended on denial of rehearing, 2011 WL 538748 (2011).
97. The court does not clarify its nexus requirement when it addresses the
The analysis and its rationale might be clearer if framed somewhat differently: whether there is a nexus between the condition and the purposes served by the exclusive rights of the copyright holder. Because copyright—unlike real property—has a constitutionally identified purpose, this approach should have more teeth than a purpose-based version of touch and concern. Subjected to this test, violation of my hypothetical license that conditions permission to copy on submission of favorable game reviews could not be enforced as a copyright infringement because the condition lacks a nexus with the purposes of copyright and is instead in tension with those purposes. Any claim by the copyright owner that the value of its work is harmed by violations of this condition is no more persuasive than the argument in Campbell concerning harm caused to an original song by a biting parody. The copyright owner may, in fact, be harmed by such behavior. But copyright law should not care—and should not make its power and remedies available to prevent such harm. As for the limitations on bot-enabled play at issue in MDY itself, the question is a closer one. My preliminary assessment, based on the facts conveyed in the MDY opinion, is that use of Glider may degrade the game experience for other users in a way that has a nexus with the progress-promoting purposes of the exclusive right to prepare derivative works. I hope to return to a more detailed assessment of that question—and, more generally, to the operationalization of my version of the nexus requirement, in future work. For now, suffice it to say that the Ninth Circuit's specific articulation of the nexus test does not provide a satisfactory answer in this and in other difficult

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enforceability of licenses conditioned on the payment of royalties:

A licensee arguably may commit copyright infringement by continuing to use the licensed work while failing to make required royalty payments, even though a failure to make payments otherwise lacks a nexus to the licensor's exclusive statutory rights. We view payment as sui generis, however, because of the distinct nexus between payment and all commercial copyright licenses, not just those concerning software.

MDY, 629 F.3d at 941 n.4. Here, the court is unclear about whether a payment requirement has the requisite nexus to an exclusive right, or whether it is enforceable despite the lack of a nexus. Either could conceivably be true depending on what the court means by "use" for which a royalty must be paid.

cases. But, by pointing us toward the reasoning of touch and concern, it suggests a surprisingly promising approach.

VI. CONCLUSION

Ironically, the touch and concern doctrine may prove to be more useful as an approach to assessing “the new servitudes” than it has been in the land context where it initially arose. The Ninth Circuit’s opinion in MDY offers an example of a court attempting, in the copyright servitude context, to identify a limiting doctrine that both recognizes the possibility of running restrictions on “ordinary” uses of copies of protected works, and also limits those restrictions based on the purposes the underlying property regime is designed to serve.

Having a limiting doctrine is valuable, in part, because the established systems for providing notice of real servitudes are not replicated in the realm of copyright. So one rationale for jettisoning “touch and concern” (that land recording systems provide a superior mechanism for making servitudes noticeable) is absent here. But beyond concern with notice—and thus even in cases with actual notice by the party who would bear the burden—intellectual property law’s animating principles provide courts with a touchstone for deciding what restrictions deserve to be enforceable via copyright (or patent) law.

Identifying the underlying purposes of real property (and thus the contours of touch and concern) is a difficult and contentious endeavor. The purposes of intellectual property, by contrast, are constitutionally defined. That is not to say that the constitutional design “[t]o promote the Progress of Science and useful Arts” has a clearly agreed upon meaning, or that it will be easy to apply. But it does provide a starting point for thinking about the new servitudes—informed, but not constrained, by the logic and lessons of the old.
