

## *Divisibility, Ownership, and the Exclusive Copyright License*

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Prior to the 1976 Copyright Act, a longstanding line of cases held as a matter of federal IP policy that patent and copyright licenses “are personal to the licensee and not assignable unless expressly made so in the agreement.”<sup>1</sup> Many contend that because it includes exclusive licenses among “transfers of copyright ownership,” the 1976 Act has to be read as overturning this rule. The Ninth Circuit, on the other hand, held in *Gardner v. Nike* that the 1976 Act did *not* abrogate the preexisting presumption of nonassignability for exclusive copyright licenses, but only meant to confer standing to sue on exclusive licensees by affording them “all of the protection and remedies accorded to the copyright owner.”<sup>2</sup>

*Gardner* has been almost uniformly criticized by treatise writers and other commentators. Much of this criticism rests on an assumption, asserted as though it were axiomatic, that the term “transfer of ownership” as used in section 101 must be read to mean a complete transfer of title identical in all functional respects to an assignment.<sup>3</sup> This article questions that assumption, looking at the understanding of “ownership” and the distinction between assignments and licenses that had developed in both patent and copyright caselaw prior to the 1976 Act, as well as the purpose and implications of the move toward copyright divisibility in the 1976 Act. My goal is to provide a persuasive analysis of the term “ownership” as used in the 1976 Act, which includes identifying which powers of title are and are not essential to permit an interest to be characterized in this way.

I do not yet know precisely what conclusions I will reach in the course of completing the article, but I start with the intuition that it is possible to have various “ownership” interests that differ in significant ways, which means that the simple equation of “exclusive license” to “assignment” to “title” is unconvincing as either a textual or a conceptual matter:

- Under the pre-1976 caselaw it was possible to effect a transfer that was construed as granting “ownership” for the purpose of conferring standing to sue, even though the transferor retained certain aspects of title.
- Section 101 includes a “mortgage” as well as an “exclusive license” among

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<sup>1</sup> *Unarco Industries v. Kelley Co.*, 465 F.2d 1303, 1307 (7th Cir. 1972).

<sup>2</sup> *Gardner v. Nike*, 279 F.3d 774 (9<sup>th</sup> Cir. 2002) (holding that rule applies to copyright licenses despite changes in 1976 Copyright Act).

<sup>3</sup> See, e.g., *Nimmer*, supra note **Error! Bookmark not defined.**, at § 10.02[4][A] (“The [exclusive licensee] having acquired “title” or ownership of the rights conveyed, may reconvey them absent contractual restrictions.”). Note that *Nimmer* places “title” but not “ownership” in quotation marks, even though it is the latter and not the former term that appears in the relevant statutory provision.

“transfers of ownership.” Mortgages are clearly ownership interests, but they are not equivalent to “title,” nor does anyone claim that the statute was intended to obliterate all distinctions between “mortgages” and “assignments.”

- Had the intent really been to permit transfer of standing to sue only in conjunction with transfer of *all* aspects of title concerning the exclusive right in question, this would have been fully achieved by section 201(d)(2) alone. There was no need to take the additional unorthodox step of including an “exclusive license” within the statutory definition of “transfer of copyright ownership.”

The article will also grapple with a broader theoretical issue: To what extent is divisibility of ownership to various uses of the same property (whether in traditional or intellectual property) compatible with the conception of property as an *in rem* right “to a thing” as opposed to that of a “bundle of rights.”