

UTAH LAW REVIEW

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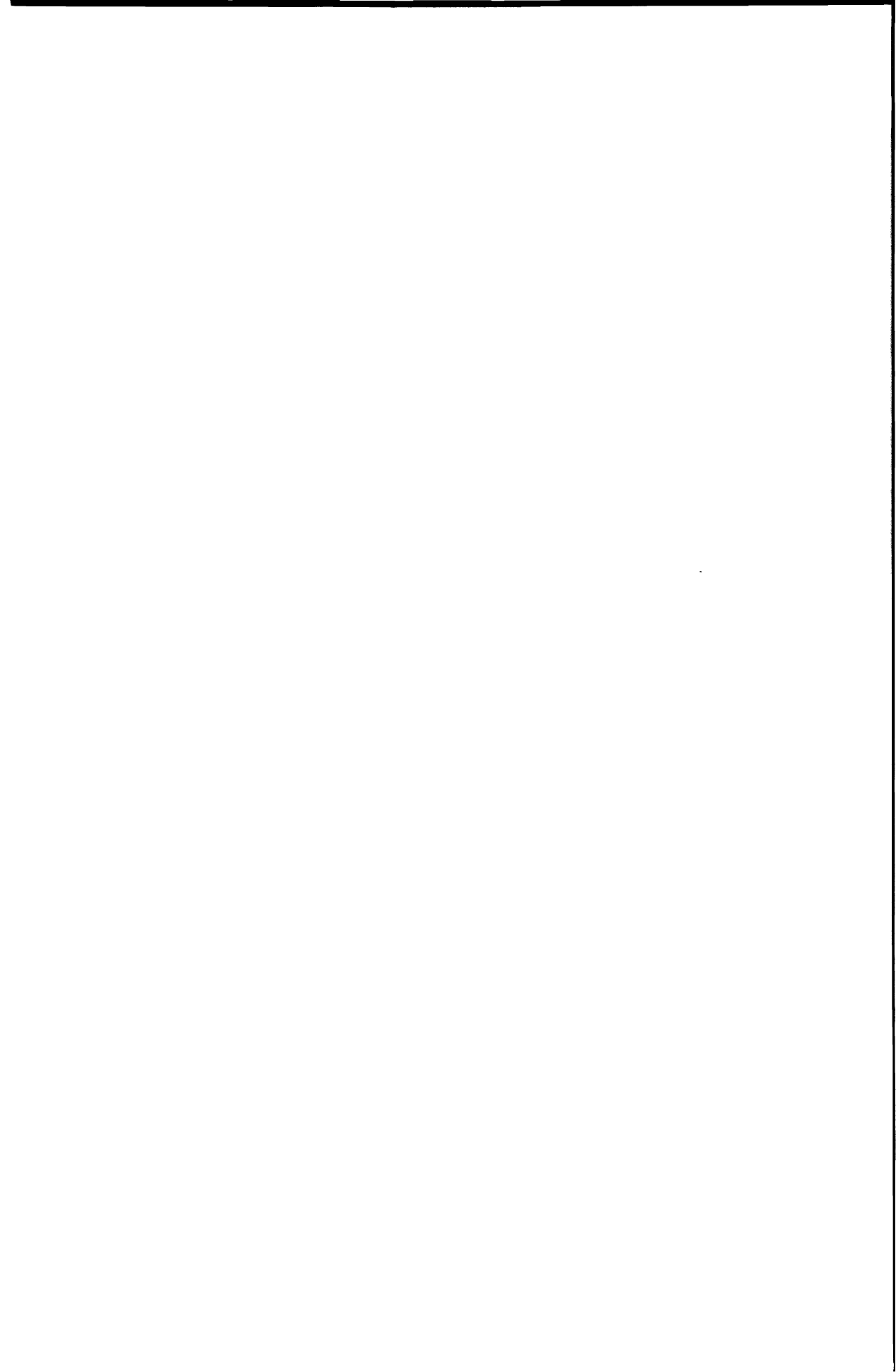
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INFRINGEMENT NATION: COPYRIGHT REFORM AND THE LAW/NORM GAP

John Tehranian*

I. INTRODUCTION

*As a veteran listener at many lectures by copyright specialists over the past decade, I know it is almost obligatory for a speaker to begin by invoking the communications revolution of our time, [and] then to pronounce upon the inadequacies of the present copyright act.*¹

Benjamin Kaplan's wry admonition, made over four decades ago in his seminal tome *An Unhurried View of Copyright*, rings just as true today. As the rapid pace of technological change continues to force a reconsideration of the vitality of our intellectual property regime, it is tempting indeed to cite the "communications revolution" of *our* time—the Internet—as disrupting to the delicate balance struck by pre-digital copyright laws between the rights of owners and users of creative works. After all, it was no less than the Supreme Court that succumbed to this inexorable urge in its first encounter with cyberspace by famously proclaiming the Internet "a unique and wholly new medium of worldwide human communication."² But the rush to tout the revolutionary potential of the Internet has subsided; the Panglossian cybernauts have faded like other fin-de-siècle perpetrators of the "this time, it's different"³ myth—the dot-com boomers who embraced wild predictions of Dow 100,000⁴ and the speculators

* Professor of Law, University of Utah, S.J. Quinney College of Law. I would like to thank all of the participants in this symposium for their outstanding contributions, Dean Hiram Chodosh, Associate Dean Bob Adler, and my colleague Amy Wildermuth, the faculty advisor to the *Utah Law Review*, for their generous support, and Dan Rosenthal and Maral Vahdani for their invaluable comments and assistance. I would also like to express my gratitude to the members of the *Utah Law Review*, especially Allison Behjani, Kim Hansen, Joe Loosle, Clemens Muller-Landau, and Austin Riter, for their hard work and tireless efforts in making this symposium possible.

¹ BENJAMIN KAPLAN, *AN UNHURRIED VIEW OF COPYRIGHT* 1 (1967).

² *Reno v. ACLU*, 521 U.S. 844, 850 (1997) (quoting *ACLU v. Reno*, 929 F. Supp. 824, 844 (E.D. Pa. 1996)).

³ See, e.g., ROBERT ZUCCARO, "DOW, 30,000 BY 2008!" *WHY IT'S DIFFERENT THIS TIME* (2001).

⁴ See, e.g., DAVID ELIAS, *DOW 40,000: STRATEGIES FOR PROFITING FROM THE GREATEST BULL MARKET IN HISTORY* (1999); JAMES K. GLASSMAN & KEVIN A. HASSETT, *DOW 36,000: THE NEW STRATEGY FOR PROFITING FROM THE COMING RISE IN THE STOCK MARKET* (1999); CHARLES W. KADLEC, *DOW 100,000: FACT OR FICTION* (1999).

who rode the recent real estate wave. A tide of skepticism⁵ has followed the euphoria epitomized by John Perry Barlow's influential *Declaration of the Independence of Cyberspace*.⁶ The Internet, it turns out, can be regulated, even in the face of the fractured and anarchic international legal regime. Ironically, no less than the Supreme Court has so held, finding that the Internet is not sufficiently different to warrant wholesale reform of numerous long-standing legal doctrines.⁷

All the while, as Congress and the courts chart the course of regulation, a turf battle over intellectual property rights in cyberspace continues to rage. Copyright maximalists, such as the Motion Picture Association of America (MPAA) and Recording Industry Association of America (RIAA), have bemoaned the Internet's potential to transform any teenager with a computer into a grand larcenist. They argue that the ease of digital reproduction has enabled piracy on a scale never before witnessed in human history, and they have lobbied vigorously for statutory weapons with which to fight this scourge.⁸ Meanwhile, copyright skeptics such as Larry Lessig and Pamela Samuelson have asserted that the digital revolution has radically enhanced the rights of owners rather than users.⁹ They argue that development of digital rights management technology has enabled copyright owners to exercise unparalleled dominion over their property, thereby constraining

⁵ See Jack L. Goldsmith, *Against Cyberanarchy*, 65 U. CHI. L. REV. 1199, 1200–01 (1998). As Goldsmith argues, regulation skeptics

make three basic errors. First, they overstate the differences between cyberspace transactions and other transnational transactions. . . . Second, the skeptics do not attend to the distinction between default laws and mandatory laws. . . . Third, the skeptics underestimate the potential of traditional legal tools and technology to resolve the multijurisdictional regulatory problems implicated by cyberspace. Cyberspace transactions do not inherently warrant any more deference by national regulators, and are not significantly less resistant to the tools of conflict of laws, than other transnational transactions.

Id.

⁶ John Perry Barlow, *A Declaration of the Independence of Cyberspace* (Feb. 8, 1996), <http://homes.eff.org/~barlow/Declaration-Final.html>. The manifesto opens: "Governments of the Industrial World, you weary giants of flesh and steel, I come from Cyberspace, the new home of Mind. On behalf of the future, I ask you of the past to leave us alone. You are not welcome among us. You have no sovereignty where we gather." *Id.*

⁷ See, e.g., *Ashcroft v. ACLU*, 535 U.S. 564, 584–85 (2002) (upholding the Child Online Protection Act's use of local contemporary community standards, despite objections from the plaintiffs that, inter alia, the standard was quixotic in light of the inherently national, if not transnational, nature of Internet publication and distribution).

⁸ See, e.g., Digital Millennium Copyright Act, 17 U.S.C. §§ 1201–1205 (2006) (providing criminal penalties against, inter alia, anyone who traffics in devices that circumvent digital rights management measures taken by copyright holders).

⁹ See LAWRENCE LESSIG, *CODE AND OTHER LAWS OF CYBERSPACE* 175 (2006); Pamela Samuelson, *The Copyright Grab*, WIRED, Jan. 1996, at 135.

fair use rights.¹⁰ Digital fences have begun to dot the online landscape, bringing a new enclosure movement to our cyber commons every bit as significant as the eighteenth-century edition.¹¹

So what are we to make of this paradoxical gestalt where the Supreme Court has simultaneously embraced and rebuffed the Internet's status as a unique medium and where educated observers recognize that digital technology has simultaneously spurred unparalleled rates of piracy and granted heretofore unknown levels of control to copyright owners? And, with Benjamin Kaplan's caveat in mind, what are we to make of a symposium entitled *Fixing Copyright*, a designation that presupposes a broken system in need of reform?

Clearly, we are only beginning to grasp the massive changes afoot with the advent of digital technology. Yet amidst the flux, one constant emerges: the 1976 Copyright Act lies always at the heart of these debates, inextricably mediating our relationship with cyberspace and new media. Three decades have passed since the current Copyright Act went into effect. Without dispute, tremendous economic, technological, and social changes have occurred in that time. And although these changes do necessarily warrant concomitant reform, this symposium follows on the premise that we have reached an appropriate point to evaluate the efficacy of the extant Act and think holistically about the issue of reform.

At this juncture, three key trends bear close observation. First, copyright law is increasingly relevant to the daily life of the average American. Second, this growing pertinence has precipitated a heightened public consciousness over copyright issues. Finally, these two facts have magnified the vast disparity between copyright law and copyright norms and, as a result, have highlighted the need for reform.

II. COPYRIGHT RELEVANCE

In decades past, developments in copyright law only received the attention of special interest groups representing the movie, music, and publishing industries as well as the small number of intellectual property academics and attorneys then in existence. Once relegated to the legal hinterlands, copyright has taken center stage in recent years. Now, copyright law is of direct importance to the hundreds of millions of individuals who download music and movies for their iPods, engage in time- and place-shifting with their TiVos or Slingboxes, own CD or DVD burners, operate their own websites, write blogs, or have personal pages on MySpace, Facebook, or Friendster. Copyright law has a profound impact on two leading sectors of our economy—technology and media/entertainment. It is also affecting both new industries and ancient professions alike. The birth of the software industry brought copyright law to an entirely new sector. Meanwhile, the architectural profession is undergoing a fundamental transformation with the

¹⁰ See LESSIG, *supra* note 9, at 175; Samuelson, *supra* note 9, at 191.

¹¹ See James Boyle, *The Second Enclosure Movement and the Construction of the Public Domain*, 66 LAW & CONTEMP. PROBS. 33, 34–37, 40–41 (2003).

expansion of copyright protection to architectural works.¹² Recent litigation in the industry has challenged the traditional norms of borrowing so essential to the development of post-modern architecture.¹³

Copyright law is playing a profound role in shaping our very identities. Copyright's regulation, propertization, and monopolization of cultural content determine who can draw upon such content in the discursive process of identity formation. Thus, the contours of our intellectual property regime privilege certain individuals and groups over others and intricately affect notions of belonging, political and social organization, expressive rights, and semiotic structures. In short, copyright laws lie at the heart of "struggles over discursive power—the right to create, and control, cultural meanings."¹⁴ As Madhavi Sunder has powerfully argued, we are in the midst of a "'Participation Age' of remix culture, blogs, podcasts, wikis, and peer-to-peer file-sharing. This new generation views intellectual properties as the raw materials for its own creative acts, blurring the lines that have long separated producers from consumers."¹⁵ In the digital age, we are all regular consumers and producers of copyrighted content.

III. COPYRIGHT CONSCIOUSNESS

With the tools for the creation, manipulation, and widespread dissemination of copyrighted works in the hands of an ever-increasing number of individuals, a remarkable thing has happened: copyright has infiltrated the public consciousness like never before. Take, for example, the growing awareness of copyright issues since the turn of the century. In 1998, Congress passed the Sonny Bono Copyright Term Extension Act (CTEA), which lengthened the copyright term of all subsisting and future creative works by an additional twenty years.¹⁶ By altering the terms of the state-granted copyright monopoly for millions of creative works, the Act represented a multibillion dollar allocation decision made by Congress and ensured that virtually no creative works would enter the public domain over the following two decades. Yet the Act somehow slipped through the House and the Senate with little debate. Indeed, it passed through both houses of Congress via voice vote, thereby making it impossible to ascertain who had voted yea or nay.¹⁷

¹² See Architectural Works Copyright Protection Act of 1990, Pub. L. No. 101-650, 104 Stat. 5133 (1991) (codified as amended in scattered sections of 17 U.S.C.).

¹³ See, e.g., *William Hablinski Architecture v. Amir Constr. Inc.*, No. CV-03-6365 CAS(RNBX), 2005 WL 4658149, at *1 (C.D. Cal. Feb 27, 2005) (alleging unlawful use of copyrighted drawings for a custom-designed home).

¹⁴ Madhavi Sunder, *Intellectual Property and Identity Politics: Playing with Fire*, 4 J. GENDER RACE & JUST. 69, 70 (2000).

¹⁵ Madhavi Sunder, *IP*³, 59 STAN. L. REV. 257, 263 (2006).

¹⁶ Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, § 102(g), 112 Stat. 2827, 2827–28 (1998) (codified at 17 U.S.C. §§ 301–304 (2006)).

¹⁷ Lawrence Lessig, *The Balance of Robert Kastenmeier*, 2004 WIS. L. REV. 1015, 1018.

Just a year later, however, the copyright maximalists were not so fortunate. In late 1999, at the behest of the RIAA, Congress amended the definition of “works made for hire” to explicitly include sound recordings.¹⁸ In many industries, including the music business, the ambiguity over what types of works may qualify as works for hire has profound implications.¹⁹ First, the designation affects copyright duration.²⁰ Second, and most importantly, the designation affects the exercise of § 203 rights. A remarkably powerful provision buried in the 1976 Copyright Act, § 203 grants authors and their heirs the inalienable right to terminate, after thirty-five years, any copyright assignment or license made after January 1, 1978.²¹ However, works made for hire are exempt from termination.²² Since most musicians assign their copyrights in their sound recordings to their record labels,²³ musicians can begin to terminate such assignments starting in 2013²⁴—unless, of course, their sound recordings are deemed works made for hire.²⁵ Thus, the ambiguity surrounding works for hire has become a billion-dollar question for the music industry.

¹⁸ Mary LaFrance, *Authorship and Termination Rights in Sound Recordings*, 75 S. CAL. L. REV. 375, 375 (2002).

¹⁹ Under the Copyright Act, a work made for hire is either “a work prepared by an employee within the scope of his or her employment,” or “a work specially ordered or commissioned” through a written agreement for use in one of nine statutory categories: “as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas.” 17 U.S.C. § 101. Thus, it is unclear whether sound recordings made by nonemployees can ever constitute works made for hire.

²⁰ Works made for hire enjoy copyright protection for 120 years from creation or 95 years from publication, whichever comes first. *Id.* § 302(c). All other works receive protection that lasts until 70 years after the death of the last surviving author. *Id.* § 302(a)–(b).

²¹ *See id.* § 203(a).

²² *Id.* As Mary LaFrance notes, individual recording artists who create their works as employees of their own loan-out corporations also risk having their termination rights waived as the sound recordings are likely considered works made for hire. LaFrance, *supra* note 18, at 403–04.

²³ Of course, such an assignment is only meaningful to the extent that musicians are considered the authors of a sound recording in the first place. One could argue that, by literally fixing the music in a tangible medium, the record labels are actually the authors of sound recordings since they literally press the ‘record’ button. *See, e.g.,* Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 737 (1989) (deeming that the author is “the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection”); *Taggart v. WMAQ Channel 5*, 57 U.S.P.Q.2d 1083, 1086 (S.D. Ill. 2000) (finding plaintiff interviewee had no copyright interest in interview by defendant, a broadcasting station, and noting that “[t]herefore, if anyone was the ‘author,’ it may very well have been the cameraman who fixed the ideas into a tangible expression, the videotape”).

²⁴ Notification of the termination must be given at least two years, and no more than ten years, prior to the termination date. 17 U.S.C. § 203(a)(4)(A).

²⁵ The termination right itself is subject to an exemption for derivative works contained in 17 U.S.C. § 304(c).

Once again, like the CTEA, this amendment to the Copyright Act sailed through Congress unblemished and President Clinton quickly signed it into law. But, this time, a grassroots effort immediately struck back. The CTEA's constriction of the public domain had rallied individuals and groups concerned about users' rights and the perceived excesses of industry lobbyists. The result was nothing short of extraordinary. As Mary LaFrance recounts, "When outraged musicians and scholars discovered that, virtually overnight, the substantive law of copyright had undergone this dramatic change, the reaction was swift, loud, and overwhelmingly disapproving. Reeling from the bad press, Congress held a brief hearing and retroactively repealed the amendment."²⁶ The issue of ownership and termination now remains unresolved and is likely to be litigated in the next few years as musicians begin to exercise their § 203 termination rights.

The repeal of the works-made-for-hire amendment epitomized the exceptional awakening of public consciousness over copyright issues. In recent years, mainstream publications have regularly featured large spreads on copyright issues that would have previously appeared arcane and esoteric.²⁷ Groups such as the Electronic Frontier Foundation the Creative Commons, and the Future of Music Coalition have emerged as powerful forces to offset the lobbying interests of the entertainment and publishing industries, and programs such as Stanford Center for Internet and Society's Fair Use Project have begun public interest litigation to vindicate fair use rights against overly aggressive copyright holders. Indeed, copyright activism has become commonplace. Witness the recent furor over the Copyright Royalty Board's proposed increase in webcasting fees,²⁸ or the successful efforts to increase the number of exemptions to the Digital Millennium Copyright Act (DMCA) granted by the Library of Congress.²⁹

²⁶ LaFrance, *supra* note 18, at 375–76.

²⁷ See, e.g., Jonathan Lethem, *The Ecstasy of Influence: A Plagiarism*, HARPER'S MAG., Feb. 2007, at 57 (brilliantly critiquing our existing copyright regime's suppression of transformative use and appropriationist art); D. T. Max, *The Injustice Collector*, THE NEW YORKER, June 19, 2006, at 34 (documenting the overzealous copyright enforcement of the James Joyce Estate); Richard A. Posner, *On Plagiarism*, ATLANTIC MONTHLY, Apr. 2002, at 23 (discussing notions of plagiarism and arguing that we could use, in some instances, "more plagiarism!"); James Surowiecki, *Righting Copywrongs*, THE NEW YORKER, Jan. 21, 2002, at 27 (critiquing copyright term extensions).

²⁸ See, e.g., *Assessing the Impact of the Copyright Royalty Board Decision to Increase Royalty Rates on Recording Artists and Webcasters: Hearing Before the H. Comm. on Small Business*, 110th Cong. (2007) (statement of Richard Eiswerth, President, Cincinnati Public Radio), available at <http://www.house.gov/smbiz/hearings/hearing-06-28-07-internet-radio/testimony-06-28-07-eiswerth.pdf> (addressing a March 2, 2007 decision by the Copyright Royalty Board that increased royalty expenses for commercial and noncommercial webcasters).

²⁹ Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies, 71 Fed. Reg. 68,472 (Nov. 27, 2006) (to be codified at 37 C.F.R. pt. 201) (enacting, pursuant to 17 U.S.C. § 1201(a)(1), the recommendation of the Register of Copyrights to add a record six new DMCA exemptions).

A more balanced struggle between copyright maximalists and skeptics has resulted, leading to a policy stalemate. During this impasse, the fundamental disconnect between our copyright laws and our copyright norms has grown increasingly apparent and has highlighted the need for reform.

IV. COPYRIGHT'S LAW/NORM GAP

The dichotomy between copyright law and norms is profound yet underappreciated. On any given day, for example, even the most law-abiding American engages in thousands of actions that likely constitute copyright infringement. The widespread use of peer-to-peer (P2P) file-sharing technology, which has enabled ordinary Americans to become mass copyright infringers with spectacular ease, has brought the law/norm gap to light. However, the problem extends far beyond P2P activities. We are, technically speaking, a nation of constant infringers.

A. *Infringement Nation*

To illustrate the unwitting infringement that has become quotidian for the average American, take an ordinary day in the life of a hypothetical law professor named John. For the purposes of this *Gedankenexperiment*, we assume the worst-case scenario of full enforcement of rights by copyright holders and an uncharitable, though perfectly plausible, reading of existing case law and the fair use doctrine. Fair use is, after all, notoriously fickle and the defense offers little ex ante refuge to users of copyrighted works.³⁰

In the morning, John checks his email, and, in so doing, begins to tally up the liability. Following common practice, he has set his mail browser to automatically reproduce the text to which he is responding in any email he drafts. Each unauthorized reproduction of someone else's copyrighted text—their email—represents a separate act of brazen infringement, as does each instance of email forwarding.³¹ Within an hour, the twenty reply and forward emails sent by John have exposed him to \$3 million in statutory damages.³²

³⁰ See John Tehranian, *Whither Copyright? Transformative Use, Free Speech, and an Intermediate Liability Proposal*, 2005 BYU L. REV. 1201, 1215–1216.

³¹ 17 U.S.C §§ 102(a)(1), 106(1), 501(a). Although one could attempt to distinguish the existing case law on the matter, courts have deemed fair use rights to a previously unpublished work, such as a piece of correspondence, to be exceedingly limited. *See, e.g.*, *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 555 (1985) (noting the strong presumption against fair use of unpublished works); *New Era Publ'ns Int'l. v. Henry Holt & Co.*, 873 F.2d 576, 583–84 (2d Cir. 1989) (noting that “a small, but more than negligible, body of unpublished material cannot pass the fair use test” and that under ordinary circumstances “the copying of ‘more than minimal amounts’ of unpublished expressive material calls for an injunction barring the unauthorized use” (quoting *Salinger v. Random House, Inc.*, 811 F.2d 90 (2d Cir. 1987))).

After spending some time catching up on the latest news, John attends his Constitutional Law class, where he distributes copies of three just-published Internet articles presenting analyses of a Supreme Court decision handed down only hours ago. Unfortunately, despite his concern for his students' edification, John has just engaged in the unauthorized reproduction of three literary works in violation of the Copyright Act.³³

One could also argue that John had an implied license. However, such a defense is problematic. As the Copyright Act notes, “[o]wnership of a copyright . . . is distinct from ownership of any material object in which the work is embodied. Transfer of ownership of any material object . . . does not of itself convey any rights in the copyrighted work embodied in the object.” 17 U.S.C. § 202. For example, in an infringement case involving letters penned by J.D. Salinger, the Second Circuit deemed Salinger the owner of the copyrights thereto, even though he no longer owned the letters themselves (he had mailed them). The court then rejected a fair use defense and enjoined the publication of the letters. *Salinger*, 811 F.2d at 94–95. § 202 and its application, as illustrated in *Salinger*, call into question the viability of an implied consent defense in the email example.

Under existing secondary liability principles, the maker of this email software also faces potential liability for contributory and vicarious infringement. *See, e.g., Gershwin Publ'g Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971) (imposing contributory liability when defendant has knowledge of an infringement and materially contributes to it and vicarious liability when a defendant has the right and ability to control the activities of an infringer and gains a direct financial benefit from these activities). Courts have read these doctrines with increasing liberality in recent years. *See Mark Bartholomew & John Tehranian, The Secret Life of Legal Doctrine: The Divergent Evolution of Secondary Liability in Trademark and Copyright Law*, 21 BERKELEY TECH. L. J. 1363, 1369–70 (2006).

³² This figure assumes the availability and the assessment of maximum statutory damages in the amount of \$150,000 for each of the twenty distinct acts of infringement. 17 U.S.C. § 504(c)(2) (2006).

³³ 17 U.S.C §§ 102(a)(1), 106(1), 501(a). Despite the explicit text of the 1976 Copyright Act, which states that “the fair use of a copyrighted work, . . . for purposes such as . . . teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright,” 17 U.S.C. § 107, the courts have still managed to find a plethora of instances where use of a copyrighted work for teaching, research, or scholarship constitutes infringement. *See, e.g., Princeton Univ. Press v. Michigan Document Servs., Inc.*, 99 F.3d 1381 (6th Cir. 1996); *Am. Geophysical Union v. Texaco*, 37 F.3d 881 (2d Cir. 1994), *superseded by* 60 F.3d 913 (2d Cir. 1994); *Duffy v. Penguin Books*, 4 F. Supp. 2d 268 (S.D.N.Y. 1998); *Television Digest, Inc. v. U.S. Tel. Ass'n*, 841 F. Supp. 5 (D.D.C. 1993); *Basic Books, Inc. v. Kinko's Graphics Corp.*, 758 F. Supp. 1522 (S.D.N.Y. 1991). The reason these cases have usually dealt with course material providers is simple: Professors lack the deep pockets that universities and photocopiers often possess.

Additionally, while one might blithely dismiss the infringement here by positing an absence of market harm, the courts have frequently found liability under the most attenuated claims of economic damage. To assess market harm in a fair use defense, courts often extend the analysis “to the *potential market* for as yet *nonexistent* derivative works.” *Castle Rock Entm't, Inc. v. Carol Publ'g Group, Inc.*, 955 F. Supp. 260, 271 (S.D.N.Y. 1997) (emphasis added). On numerous occasions, therefore, courts have rejected a fair use defense by speculating about harm to a hypothetical market for derivative works. *See, e.g.,*

Professor John then attends a faculty meeting that fails to capture his full attention. Doodling on his notepad provides an ideal escape. A fan of post-modern architecture, he finds himself thinking of Frank Gehry's early sketches for the Bilbao Guggenheim as he draws a series of swirling lines that roughly approximate the design of the building. He has created an unauthorized derivative of a copyrighted architectural rendering.³⁴

Later that afternoon, John attends his Law and Literature class, where the focus of the day is on morality and duty. He has assigned e.e. cummings's 1931 poem *i sing of Olaf glad and big* to the students. As a prelude to class discussion, he reads the poem in its entirety, thereby engaging in an unauthorized public performance of the copyrighted literary work.³⁵

Before leaving work, he remembers to email his family five photographs of the Utes football game he attended the previous Saturday. His friend had taken the photographs. And while she had given him the prints, ownership of the physical work and its underlying intellectual property are not tied together.³⁶ Quite simply, the copyright to the photograph subsists in and remains with its author, John's friend. As such, by copying, distributing, and publicly displaying the copyrighted photographs, John is once again piling up the infringements.³⁷

In the late afternoon, John takes his daily swim at the university pool. Before he jumps into the water, he discards his T-shirt, revealing a Captain Caveman tattoo on his right shoulder. Not only did he violate Hanna-Barbera's copyright when he got the tattoo—after all, it is an unauthorized reproduction of a

Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir. 1997) (finding that a satire of the O.J. Simpson trial based on *The Cat in the Hat* infringed Dr. Seuss's copyright); Rogers v. Koons, 960 F.2d 301 (2d Cir. 1992) (finding that modern artist Jeffrey Koons's kitschy appropriation of a photograph to satire suburban American aesthetic sensibilities infringed the copyright of the original photographer); *Castle Rock*, 955 F. Supp. at 260 (finding that a humorous guidebook to the *Seinfeld* series violated Castle Rock's copyright in the television show). The holdings of *Dr. Seuss*, *Koons*, and *Castle Rock*, combined with John's failure to obtain reproduction licenses (which arguably undermined the not-even-hypothetical photocopying market), could certainly lead a court to reject a fair use defense in this example.

³⁴ 17 U.S.C. §§ 102(a)(5), 102(a)(8), 106(2), 501(a). If John circulated his doodles too widely and Gehry were feeling extraordinarily litigious, John could find himself in court. There is no reason why this example should not constitute fair use. However, given the market harm analysis above, *see supra* note 33, a fair use outcome is by no means assured.

³⁵ *Id.* § 102(a)(1), 106(4), 501(a). *See, e.g.,* BMG Music v. Gonzalez, 430 F.3d 888, 890 (7th Cir. 2005) (noting that, for poetry, "copying of more than a couplet or two is deemed excessive" and not fair use). While John might rely § 110(1)'s liability exemption for certain public performances at nonprofit educational institutions, 17 U.S.C. § 110(1), the exemption does not apply to for-profit schools, of which there are many. One could even argue that the conspicuous absence of for-profit schools from the exemption implies that a public performance at such an institution is necessarily infringing and not fair use.

³⁶ 17 U.S.C. § 202.

³⁷ *Id.* §§ 102(a)(5), 106(1), 106(3), 106(5), 501(a). *See supra* note 31 (regarding unpublished works and implied licenses).

copyrighted work³⁸—he has now engaged in a unauthorized public display of the animated character.³⁹ More ominously, the Copyright Act allows for the “impounding”⁴⁰ and “destruction or other reasonable disposition”⁴¹ of any infringing work. Sporting the tattoo, John has become the infringing work.⁴² At best, therefore, he will have to undergo court-mandated laser tattoo removal. At worst, he faces imminent “destruction.”⁴³

That evening, John attends a restaurant dinner celebrating a friend’s birthday. At the end of the evening, he joins the other guests in singing “Happy Birthday.”⁴⁴ The moment is captured on his cellphone camera. He has consequently infringed on the copyrighted musical composition by publicly performing the song and reproducing the song in the video recording without authorization.⁴⁵ Additionally, his video footage captures not only his friend but clearly documents the art work

³⁸ *Id.* §§ 102(a)(5), 106(1), 501(a). *See, e.g.*, Christopher A. Harkins, *Tattoos and Copyright Infringement: Celebrities, Marketers, and Businesses Beware of the Ink*, 10 LEWIS & CLARK L. REV. 313 (2006) (using the recent infringement suit involving NBA star Rasheed Wallace’s tattoo as the starting point for analyzing the minefield of ink-related copyright issues). *See supra* note 33 (regarding market harm). Based on existing jurisprudence, a court may well find that donning a Captain Caveman tattoo is a commercial use that deprives Hanna-Barbera of the licensing revenue it might gain for selling animated character tattoos, should it chose to enter that market.

³⁹ 17 U.S.C. §§ 102(a)(5), 106(5), 501(a).

⁴⁰ *Id.* § 503(a).

⁴¹ *Id.* § 503(b).

⁴² Paraphrasing J. Robert Oppenheimer’s haunting words upon the first successful test of the atomic bomb, my friend Daniel Rosenthal quipped: “John is become tattoo, infringer of works.”

⁴³ 17 U.S.C. § 503(b). For the sake of posterity, I have no such tattoo in real life.

⁴⁴ Time Warner claims copyright ownership over the lyrics to “Happy Birthday” and vigorously enforces its purported exclusive rights based thereon. *See, e.g.*, KEMBLEW C. MCLEOD, *FREEDOM OF EXPRESSION: RESISTANCE AND EXPRESSION IN THE AGE OF INTELLECTUAL PROPERTY* 15–18 (2007). For example, the makers of the documentary *The Corporation* have a minute of silence in their movie during a birthday party scene since they elected not to license the rights to the song—a use that allegedly would have cost them several thousand dollars. *THE CORPORATION* (Big Picture Media Corp. 2003).

⁴⁵ 17 U.S.C. §§ 102(2), 106(1), 106(4), 501(a). Described as “[o]ne of the greatest sources of revenue in the music industry,” a copyright holder’s exclusive control of public performances of a musical composition extends to such public venues as restaurants. *Woods v. Bourne Co.*, 60 F.3d 978, 983–84 (2d Cir. 1995) (citation omitted). Although one might posit a de minimus use defense here, it is often ignored by the courts. In the related area of sound recordings, for example, the slightest unauthorized sample can result in a multimillion-dollar judgment, even if a significant and expressive new musical work is created through use of the sample. *See Bridgeport Music, Inc. v. Dimension Films*, 383 F.3d 390, 398 (6th Cir. 2004) (holding that any unauthorized sample of a sound recording, no matter how small, constitutes copyright infringement); *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 183 (S.D.N.Y. 1991) (quoting Exodus, equating the Seventh Commandment with the law of copyright, admonishing “Thou shall not steal” and rejecting a fair use defense in a music sampling case).

hanging on the wall behind his friend—*Wives with Knives*—a print by renowned retro-themed painter Shag. John's incidental and even accidental use of *Wives with Knives* in the video nevertheless constitutes an unauthorized reproduction of Shag's work.⁴⁶

At the end of the day, John checks his mailbox, where he finds the latest issue of an artsy hipster rag to which he subscribes. The 'zine, named *Found*, is a nationally distributed quarterly that collects and catalogues curious notes, drawings, and other items of interest that readers find lying in city streets, public transportation, and other random places. In short, John has purchased a magazine containing the unauthorized reproduction, distribution, and public display of fifty copyrighted notes and drawings.⁴⁷ His knowing, material contribution to *Found*'s fifty acts of infringement subjects John to potential secondary liability⁴⁸ in the amount of \$7.5 million.⁴⁹

By the end of the day, John has infringed the copyrights of twenty emails, three legal articles, an architectural rendering, a poem, five photographs, an animated character, a musical composition, a painting, and fifty notes and drawings. All told, he has committed at least eighty-three acts of infringement and faces liability in the amount of \$12.45 million (to say nothing of potential criminal charges).⁵⁰ There is nothing particularly extraordinary about John's activities. Yet

⁴⁶ 17 U.S.C. §§ 102(5), 106(1), 501(a). *See, e.g.,* Ringgold v. Black Entertainment Television, Inc., 126 F.3d 70, 77–78 (2d Cir. 1997) (reversing summary judgment for defendants on fair use defense and allowing case to proceed to trial on claim of infringement for the unauthorized use of a poster as part of the set decoration in the background of a five minute scene in a single episode of a television sitcom). One could try to distinguish *Ringgold* by arguing that there is no commercial use here. However, courts have frequently adopted broad readings of commercial use. For example, in *A&M Records, Inc. v. Napster, Inc.*, the Ninth Circuit held that P2P trading, a sharing activity with no quid pro quo attached, constituted commercial use because users were not paying the “customary price” for the copyrighted works they received. 239 F.3d 1004, 1015 (9th Cir. 2001). Similarly, in *Worldwide Church of God v. Philadelphia Church of God, Inc.*, the Ninth Circuit held that *giving away* 30,000 free copies of a religious work constituted a commercial activity because the defendant “profited” from the use of the work by attracting new members who ultimately tithed. 227 F.3d 1110, 1117–18 (9th Cir. 2000). Based on these cases, one could argue that virtually all use is commercial since, at some level, any unpaid use of a work causes someone to lose potential revenue.

⁴⁷ 17 U.S.C. §§ 102(1), 102(5), 106(1), 106(3), 106(5), 501(a). As previously unpublished works, the materials featured in *Found* are subject to only severely limited fair use rights. *See supra* note 31.

⁴⁸ *See* MGM Studios, Inc. v. Grokster, Ltd., 545 U.S. 913, 930 (2005) (“One infringes contributorily by intentionally inducing or encouraging direct infringement . . .”). By subscribing to *Found*, John is quite arguably encouraging and materially contributing to *Found*'s acts of infringements by making them profitable.

⁴⁹ 17 U.S.C. § 504(c)(2).

⁵⁰ *Id.* §§ 504(c)(2), 506; 18 U.S.C. § 2319 (providing for criminal penalties against certain copyright infringers). The \$12.45 million figure assumes that, for the purposes of tallying statutory damages, one uses the number of works infringed (83) and multiplies it

if copyright holders were inclined to enforce their rights to the maximum extent allowed by law, barring last minute salvation from the notoriously ambiguous fair use defense, he would be liable for a mind-boggling \$4.544 billion in potential damages each year. And, surprisingly, he has not even committed a single act of infringement through P2P file-sharing. Such an outcome flies in the face of our basic sense of justice. Indeed, one must either irrationally conclude that John is a criminal infringer—a veritable grand larcenist—or blithely surmise that copyright law must not mean what it appears to say. Something is clearly amiss. Moreover, the troublesome gap between copyright law and norms has grown only wider in recent years.

B. *The Default Rule of Use as Infringement*

As noted earlier, digital technology has enabled unparalleled manipulation and use of creative works by ordinary individuals. But before the passage of the 1976 Copyright Act, most creative works did not enjoy copyright protection. Quite simply, authors could only enforce exclusive rights to works whose copyrights had been properly registered (and, subsequently, renewed).⁵¹ As a result, the vast majority of our society's creative output automatically belonged in the public domain and use of this output did not raise any legal flags.⁵² With the passage of the 1976 Copyright Act, however, we radically altered our default regime from one of nonprotection to one of protection. Under the current Act, copyright subsists in authors the moment they fix a creative, original work in a tangible medium, regardless of the observance of any formalities such as registration.⁵³ Thus, virtually the entire universe of creative works created after 1978 is now subject to copyright protection. Any use of a creative work is now, as a default matter, viewed as an infringement.⁵⁴ By making even more obscure works profitable, the "long tail"⁵⁵ has also exacerbated matters by extending what might be dubbed the "long copyright chastity belt." Enforcement has become increasingly worthwhile for a growing number of copyright holders, making copyright law relevant to any growing number of creators and, concomitantly, users.

by the maximum award for willful infringement (\$150,000 per infringed work). I also assume that neither an acquiescence nor fair use defense excuses the conduct.

⁵¹ Copyright Act of 1909 § 10 (codified as amended at 17 U.S.C. 11, 61 Stat. 652 (1947)) (repealed by Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541).

⁵² Save the Music & Creative Commons: Proceedings Before the U.S. Copyright Office at 13 (Mar. 25, 2005), <http://www.copyright.gov/orphan/comments/OW0643-STM-CreativeCommons.pdf> (Comments of Creative Commons and Save the Music).

⁵³ 17 U.S.C. § 102 (2006).

⁵⁴ This fact is exacerbated by the status of fair use as an affirmative defense which places the burden of proof on a user. See John Tehranian, *Et Tu, Fair Use? The Triumph of Natural-Law Copyright*, 38 U.C. DAVIS L. REV. 465, 495 (2005).

⁵⁵ CHRIS ANDERSON, *THE LONG TAIL: WHY THE FUTURE OF BUSINESS IS SELLING LESS OF MORE 10* (2006).

C. Technological Change and the Law/Norm Gap

Finally, by facilitating superior tracking of the use of copyrighted works, technology is now forcing us to address the uncomfortable and ultimately untenable law/norm disparity. While there may be a vast disparity between what activities the Copyright Act proscribes and what the average American might consider fair or just, a lack of aggressive enforcement has long prevented this fundamental tension from coming to a head. As technology improves, however, and as privacy rights continue to erode, enforcement is becoming increasingly practicable.

Take the example of piracy. In the past, most piracy took place in the private realm, well beyond the Panopticonian gaze of copyright holders. For example, individuals would record songs from the radio, duplicate their friends' albums on cassettes, or swap mix tapes. But there were few practical means for the record labels to monitor such activity and haul infringers into court. With the advent of P2P technology, individuals could share music not only with their best buddies, but with millions of their closest "friends" around the world. As we all know, P2P networks have vastly expanded the scope of piracy to previously unknown levels. But P2P technology also did something else—it brought individual piracy into the light of day and made enforcement a viable option for copyright holders. Specifically, Internet Protocol addresses and log databases retained by Internet Service Providers made previously undetectable "sharing" both visible and traceable.

The expanded enforcement of copyright laws precipitated by the P2P revolution has forced us to reexamine the rationality of our reigning intellectual property regime. For example, the statutory damages provisions of the Copyright Act have enabled the RIAA to file multimillion dollar infringement suits against thousands of individuals, including many children and grandparents,⁵⁶ on the basis of P2P activity. The cases rarely advance to an adjudication on the merits, as all but the bravest (or, perhaps, most foolhardy) defendants quickly settle instead of fighting the well-financed behemoth and the powerful threat of statutory damages—up to \$150,000 per infringing act.⁵⁷ In one pro bono case that I handled, the RIAA sued my client, a middle-aged, terminally ill Mexican immigrant on welfare who could not speak English, for the alleged file-sharing activities of his son.⁵⁸ He ultimately diverted funds from his welfare checks to finance the settlement.

The P2P example is just one way in which technology has enabled expanded enforcement of copyright laws—a trend that is accelerating as technology improves. Imagine a world where every act currently deemed infringing under the

⁵⁶ See Matthew Sag, *Piracy: Twelve Year-Olds, Grandmothers, and Other Good Targets for the Recording Industry's File Sharing Litigation*, 4 NW. J. TECH. & INTELL. PROP. 133, 146 (2006).

⁵⁷ 17 U.S.C. § 504(c)(2).

⁵⁸ See *Arista Records LLC v. Haro*, No. CV-05-5350 (C.D. Cal. Oct. 17, 2006).

law were actually prosecuted. Take, for instance, something we all do: sing along with our car stereo. Currently, such an activity (especially if the windows are rolled down) is possibly infringing,⁵⁹ but completely unenforceable. The very technologies that enhance our media experiences are rapidly bringing us closer to the Panopticon state in which a near-total enforcement of intellectual property rights becomes viable. With the requisite advances in voice recognition software, every car stereo could be equipped with ears that monitor the noise in a car. Like a radio-frequency identification toll card, the mechanism could determine each song being hummed inside the car during the course of a month and then automatically bill the car's owner for the licensing rights to perform those copyrighted musical compositions or create such derivatives of the sound recordings. One can readily imagine a future dystopian world where the record labels, long since irrelevant to the development and distribution of new music, become nothing more than copyright trolls, drawing their revenue entirely from collections (or litigation) of this kind.

As surveillance technology grows more sophisticated, thereby allowing acts of infringement increasingly to come under the detection and enforcement power of copyright holders, we will be forced to confront the law/norm disparity. In response, we have already begun to reexamine our norms.⁶⁰ It is also incumbent upon us to reexamine the vitality of our copyright regime.

V. CONCLUSION

In recent years, legislators, judges, and practicing attorneys have critiqued law reviews for their excessively theoretical bent, arguing that their contents have become increasingly devoid of any real-world value. At the risk of alienating my academic colleagues and shocking the members of the copyright bar, I would like to think that this symposium is different. By bringing together a group of leading copyright scholars, including Tom Bell, Dan Burk, Wendy Gordon, Justin Hughes, Peter Jaszi, Bobbi Kwall, David Nimmer, Pam Samuelson, and Rebecca Tushnet, to contemplate the issue of legal reform in practical terms, this symposium strives to foster a dialogue that could impact future revisions at a concrete level. It is a first step in what will hopefully become a broader debate over copyright reform.

⁵⁹ This scenario is not nearly as far-fetched as it may initially appear. Recently, a U.K. performing rights society sued Kwik-Fit, a car repair chain, for £200,000, claiming Kwik-Fit's mechanics were engaging in unauthorized public performances simply by playing their radios too loudly. The suit has survived an initial dismissal motion and underscores the very real threat of liability should the sing-along hypothetical be pursued in court. See *Kwik-Fit Sued Over Staff Radios*, BBC NEWS, Oct. 5, 2007, http://news.bbc.co.uk/1/hi/scotland/edinburgh_and_east/7029892.stm (last visited Dec. 6, 2007).

⁶⁰ All sides of the copyright debate have engaged in efforts to alter norms, from the RIAA's anti-piracy advertising and the MPAA's "Respect Copyright" Boy Scout Merit Badge to the efforts that Peter Jaszi documents in his symposium article to foster norms supporting fair use in the documentary filmmaker community. Peter Jaszi, *Copyright, Fair Use and Motion Pictures*, 2007 UTAH L. REV. 715.

PRELIMINARY THOUGHTS ON COPYRIGHT REFORM

Pamela Samuelson*

Myriad reasons can be proffered for undertaking a copyright reform project. For one thing, the current U.S. copyright law is much too long, now weighing in at approximately two hundred pages.¹ The statute is also far too complex, incomprehensible to a significant degree, and imbalanced in important ways.² Moreover, it lacks normative heft—that is, the normative rationales for granting authors some protections for their works and for limiting the scope of those protections is difficult to extract from the turgid prose of its many exceptionally detailed provisions.³

I. THE COPYRIGHT ACT OF 1976: AN OBSOLETE AMALGAM?

The drafters of the Copyright Act of 1976 (1976 Act) intended it to be flexible and adaptable as new technologies enabled the creation of new kinds of works.⁴ Thirty years of experience with the 1976 Act has shown that this was an overly optimistic hope. The only new subject matters added to the copyright realm since 1976 have arrived through statutory amendments, not through common law

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¹ See, e.g., SELECTED INTELLECTUAL PROPERTY AND UNFAIR COMPETITION STATUTES, REGULATIONS, AND TREATIES (Roger E. Schechter ed., 2006) [hereinafter SELECTED STATUTES]. The Copyright Act of 1976 runs from pages 259 to 433, criminal copyright provisions from pages 434 to 442, and the anti-circumvention provisions from pages 466 to 481. Three other copyright-like acts have been incorporated in Title 17 of the United States Code, including the Semiconductor Chip Protection Act, 17 U.S.C. §§ 901–914; the Audio Home Recording Act, 17 U.S.C. §§ 1001–1010; and the Vessel Hull Protection Act, 17 U.S.C. §§ 1301–1332. The Copyright Act of 1909, by contrast, is approximately twenty-five pages in length. See SELECTED STATUTES, *supra*, at 235–58.

² See, e.g., JESSICA LITMAN, DIGITAL COPYRIGHT 29–32 (2000).

³ Among the most turgid provisions of the 1976 Act are 17 U.S.C. § 111 (limiting exclusive rights for secondary transmissions of performances by cable systems); § 119 (limiting exclusive rights for secondary transmissions of superstations and network stations for private home viewing); § 304(c)–(d) (allowing individual authors or their heirs to terminate transfers of rights).

⁴ Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (adopting expansive subject matter and exclusive rights provisions); H.R. REP. NO. 94-1476, at 51 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664 (acknowledging the impossibility of foreseeing all new forms of creative expression and thus the bill's intent to create neither a strictly limited nor unlimited range of copyrightable subject matter).

interpretation of the 1976 Act's broad subject matter provision.⁵ Virtually every week a new technology issue emerges, presenting questions that existing copyright rules cannot easily answer.

Google, Inc., for example, has been at the center of several challenging cases. Some writers and publishers have sued Google because it is scanning the texts of thousands of books, including books still in copyright, obtained from university libraries in order to prepare indices of their contents so that snippets can be made available to researchers making pertinent queries.⁶ On the one hand, the scanning of books seems like a *prima facie* violation of the exclusive right to reproduce works in copies. On the other hand, this scanning was necessary to prepare the indices, Google only makes snippets from the books available in response to queries, and authors benefit when more readers know about their works.⁷

Google has also been sued for copyright infringement because, unbeknownst to it, some infringing copies of photographs on other firms' servers have been made accessible to users of its search engine.⁸ Because Google does not maintain copies of full-size images on its servers⁹ and because it has not acted in league with infringers, Google argues that it should not be treated as a direct or contributory infringer.¹⁰ However, Google does provide reduced-size images of the photographs when they are responsive to search requests. Further, it is hard to say that the infringing images are not publicly displayed on the users' computer screens when they are selected from responses to a Google search request.¹¹

Google and its popular subsidiary, YouTube, have also been sued for copyright infringement because users sometimes upload copies of other peoples'

⁵ Architectural Works Copyright Protection Act, Pub. L. No. 101-650, 104 Stat. 5089, 5128 (adding architectural works to the subject matter of copyright); H.R. REP. NO. 96-1307, at 23 (1980), *reprinted in* 1980 U.S.C.C.A.N. 6460, 6482 (noting that the 1980 amendments implemented recommendations of the National Commission on New Technological Uses of Copyrighted Works as to copyright protection for computer programs); *see also infra* note 24.

⁶ McGraw-Hill Co. v. Google, Inc., No. 05-CV 8881 (S.D.N.Y. filed Oct. 19, 2005); Authors' Guild v. Google, Inc., No. 05 CV-8136 (S.D.N.Y. filed Sept. 20, 2005). For a Congressional Research Service report on this litigation, see ROBIN JEWELER, CRS REPORT FOR CONGRESS, THE GOOGLE BOOK SEARCH PROJECT: IS ONLINE INDEXING A FAIR USE UNDER COPYRIGHT LAW? (2005), http://openers.com/rpts/RS22356_20051228.pdf.

⁷ *See, e.g.*, Jonathan Band, *The Google Print Library Project: A Copyright Analysis*, August 2005, <http://www.policybandwidth.com/doc/googleprint.pdf>.

⁸ *See Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828 (C.D. Cal. 2006), *aff'd in part, rev'd in part*, Nos. 06-55405, 06-55406, 06-55425, 06-55759, 06-55854, 06-55877, 2007 WL 1428632, at *1, *2-3 (9th Cir. May 16, 2007) (dismissing some claims, but upholding one claim of infringement).

⁹ *Perfect 10*, 2007 WL 1428632, at *1, *7.

¹⁰ *Perfect 10*, 416 F. Supp. 2d at 837-38.

¹¹ *Perfect 10*, 2007 WL 1428632, at *6 (finding infringement of public display right). Google had sought shelter under a Ninth Circuit ruling, *Kelly v. Arriba Soft Corp.*, which held in favor of a search engine that made reduced size images of photographs available to users. 336 F.3d 811, 815 (9th Cir. 2003).

copyrighted works, including television programs and remixes of motion pictures to YouTube, which then makes them available to millions of other users.¹² Viacom argues that infringements of its copyrights are so rampant on YouTube that Google has a duty to be more proactive in deploying filtering technologies to detect infringing copies.¹³ Google argues that it qualifies for a statutory safe harbor from liability as long as it takes down infringing materials after receiving notice from the relevant copyright owners.¹⁴

Apart from cumbersome and very expensive litigation, which may lead to common law evolution of copyright concepts, or legislative amendments, which only Hollywood seems to have the clout to bring about, there is no straightforward way to address challenging questions such as those the Google lawsuits raise. Litigation and legislation are not only expensive, but uncertain mechanisms for resolving ambiguities in the statute.

The 1976 Act has been amended more than twenty times since 1976.¹⁵ As a result, it has become an amalgam of inter- and intra-industry negotiated compromises¹⁶ and a hodgepodge of law. Although Congress has occasionally given the U.S. Copyright Office (Copyright Office) rule-making authority,¹⁷ most of the controversial issues have been left for the Congress or the courts to resolve. This has given rise to serious public choice problems with the copyright law and policymaking process.¹⁸ The copyright industries have become accustomed to drafting legislation that suits their perceived needs and to having that legislation adopted without careful scrutiny.¹⁹

The 1976 Act is, moreover, the intellectual work product of a copyright reform process that was initiated in the mid-1950s.²⁰ This legislation was written

¹² See Complaint for Declaratory and Injunctive Relief and Damages, *Viacom Int'l Inc. v. YouTube, Inc.*, No. 1:07-CV-02103 (S.D.N.Y. Mar. 13, 2007), available at <http://news.justia.com/cases/viacom-youtube/337988/1/0.pdf>.

¹³ *Id.* at ¶¶ 6, 10, 39, 45.

¹⁴ See Defendants' Answer and Demand for Jury Trial, *Viacom Int'l Inc. v. YouTube, Inc.*, No. 1:07-CV-02103 (S.D.N.Y. Apr. 30, 2007), available at <http://news.justia.com/cases/viacome-youtube/337988/21/0.pdf>.

¹⁵ See, e.g., JULIE E. COHEN ET AL., *COPYRIGHT IN A GLOBAL INFORMATION ECONOMY* 28–29 (2d ed. 2006).

¹⁶ See, e.g., LITMAN, *supra* note 2, at 35–69 (discussing the history of copyright negotiated compromises).

¹⁷ See, e.g., 17 U.S.C. § 1201(a)(1)(B)–(D) (2006).

¹⁸ See, e.g., William Patry, *The Failure of the American Copyright System: Protecting the Idle Rich*, 72 NOTRE DAME L. REV. 907 (1997).

¹⁹ See, LITMAN, *supra* note 2, at 22–32.

²⁰ The first six years of the copyright statutory revision process that led to enactment of the 1976 Act, from 1955 to 1961, were largely spent commissioning studies on various revision-related issues. See, e.g., *COPYRIGHT LAW REVISION: STUDIES PREPARED FOR THE SUBCOMM. ON PATENTS, TRADEMARKS, AND COPYRIGHTS OF THE S. COMM. ON THE JUDICIARY, 86TH CONG. STUDIES 1–4 (1960)* [hereinafter *COPYRIGHT LAW REVISION STUDIES NOS. 1–4*]. The studies can be found in *OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY: COPYRIGHT LAW REVISION STUDIES 1–19 (1960)* (George S.

without giving serious thought to how it would apply to computers, computer programs, or computer networks. When questions began to arise in the early to mid-1960s about the implications of computers for copyright, the Register of Copyrights deliberately decided against addressing them.²¹ During a 1965 hearing, for example, he stated that “it would be a mistake . . . in trying to deal with such a new and evolving field as that of computer technology, to include an explicit provision [on computer-related uses] that could later turn out to be too broad or too narrow.”²² Technology developers, educational institutions, and libraries were understandably displeased at the prospect of having to resolve foreseeable disputes over computer use questions through litigation based on a statute that was intentionally not clarified to deal with them.²³ Because of the intense controversy over the new technology questions, the copyright revision process was stalled for most of the next decade while various stakeholders debated how the revised law should handle these new technology issues.²⁴

To break this logjam and move copyright revision forward, Congress ultimately decided in 1974 to spin off the challenging new technology copyright issues to a newly created commission, asking it to report back whether the law should be amended to address the controversial new technology questions.²⁵ Professor Benjamin Kaplan presciently warned that a commission would not be

Grossman ed., William S. Hein & Co., Inc. 1976) [hereinafter OMNIBUS LEGISLATIVE HISTORY]. Professor Walter Derenberg of New York University Law School submitted one such study to the Office in 1956. See STAFF MEMBERS OF THE NEW YORK UNIVERSITY LAW REVIEW UNDER THE GUIDANCE OF WALTER J. DERENBERG, STUDY NO. 3: THE MEANING OF “WRITINGS” IN THE COPYRIGHT CLAUSE OF THE CONSTITUTION (1956), reprinted in COPYRIGHT LAW REVISION STUDIES NOS. 1–4, *supra*, at 61, and in 1 OMNIBUS LEGISLATIVE HISTORY, *supra*, at 61. This study was originally published as Stephen Lichtenstein et al., Note, *Copyright—Study of the Term “Writings” in the Copyright Clause of the Constitution*, 31 N.Y.U. L. REV. 1263 (1956).

²¹ In the mid-1960s, the Copyright Office decided to allow computer programs to be registered as original works of authorship, but only under its so-called “rule of doubt.” That is, program authors could obtain registration certificates but would have to persuade courts that their works were actually copyrightable subject matter, thereby overriding the Office’s doubts. See COPYRIGHT OFFICE CIRCULAR 31D (Jan. 1965), reprinted in Duncan M. Davidson, *Protecting Computer Software: A Comprehensive Analysis*, 1983 ARIZ. ST. L.J. 611, 652 n.72.

²² See H. COMM. ON THE JUDICIARY, 89TH CONG., COPYRIGHT LAW REVISION, PART 6: SUPPLEMENTARY REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW: 1965 REVISION BILL, at 18 (Comm. Print 1965), reprinted in 4 OMNIBUS LEGISLATIVE HISTORY, *supra* note 20, at 18.

²³ I tell part of this story in Pamela Samuelson, *Why Copyright Excludes Systems and Processes from the Scope of Its Protection*, 85 TEX. L. REV. 1921, 1944–45 (2007).

²⁴ See NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS, FINAL REPORT (1979), available at <http://digital-law-online.info/CONTU/PDF/index.html> [hereinafter TECHNOLOGICAL USES OF COPYRIGHTED WORKS, FINAL REPORT] (last visited Nov. 28, 2007) (relating this history).

²⁵ *Id.*

able to resolve new technologies questions within the framework of the copyright act then under consideration by merely adding a few amendments; Kaplan suggested that the revised bill should be rethought from scratch.²⁶ Congress and other actors involved in the copyright revision process were by then already weary of a revision process that seemed to be endless and in no mood to rethink how the contours of the law should be changed in light of these new technologies. So the 1976 Act was passed with a 1950s/60s mentality built into it, just at a time when computer and communication technology advances were about to raise the most challenging and vexing copyright questions ever encountered.

It was, in truth, too early in the evolution of these technologies for the Congressional Commission, anyone in Congress, or the copyright policymaking community to figure out how to adapt copyright law to meet and withstand these challenges. Might it have been preferable to stick with the 1909 Act instead of enacting a law in 1976 that was already unsuited to the new technology challenges of the day? There is reason to think that the public as a whole would have been better off under the rubric of the 1909 Act, not the least because so many more works would be in the public domain and available for free reuse and creative remixes. I suspect, moreover, that U.S. copyright industries would have fared just fine had the legislative stasis over new technology issues continued for another few decades.

The 1976 Act was also drafted in an era when it mainly regulated the copyright industries and left alone the acts of ordinary people and non-copyright industries that use copyrighted works. It didn't matter that much if the law was incomprehensible as long as the copyright industries that negotiated the fine details of the statute knew what the provisions meant, even if no one else did.²⁷ But today, copyright law applies to all of us and to many common uses of copyrighted works. Advances in digital technologies have, moreover, democratized the creation and dissemination of new works of authorship and brought ordinary persons into the copyright realm, not only as creators, but also as users of others' works.²⁸ One reason why a simpler copyright law is needed is to provide a comprehensible normative framework for all of us who create, use, and disseminate works of authorship.

Thirty years after enactment of the 1976 Act, with the benefit of considerable experience with computer and other advanced technologies and the rise of amateur creators, it may finally be possible to formulate a more comprehensive approach to adapting copyright to digital networked environments and maintaining copyright's integrity as to existing industry products and services that do not exist outside of the digital realm. If one considers, as I do, that the 1976 Act was the product of

²⁶ *Copyright Law Revision: Hearings on S. 597 Before the Subcomm. on Patents, Trademarks, and Copyrights of the S. Comm. on the Judiciary*, 90th Cong. 571–73 (1967) [hereinafter *1967 Senate Hearings*] (statement of Benjamin Kaplan, Professor of Law), reprinted in 9 OMNIBUS LEGISLATIVE HISTORY, *supra* note 20, at 571–73.

²⁷ LITMAN, *supra* note 2, at 36–37.

²⁸ See, e.g., LAWRENCE LESSIG, *FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY* 9 (2004).

1950s/60s thinking, then a copyright reform process should be well underway because copyright revision projects have occurred roughly every forty years in the United States.²⁹ It is particularly important to get started because a copyright reform project will take years of careful thought, analysis, and drafting before facing the daunting challenge of persuading legislators to enact it.

As enthusiastic as I am about copyright reform, I am not so naïve as to think that there is any realistic chance that a copyright reform effort will be undertaken in the next decade by the Copyright Office, the U.S. Congress, or any other organized group. There are many reasons why a copyright reform project is infeasible at the present time.

Perhaps the most important reason copyright reform is infeasible is that the U.S. Congress has a lot of other vexing challenges to deal with in the next decade, including the Iraq war, global warming, immigration reform, and tax policy reform, just to name a few. In the grand scheme of things, copyright law just isn't very important. U.S. copyright industries have, moreover, largely prospered under the rubric of the 1976 Act.³⁰ It may be a flawed statute, but it is not so flawed that it is completely dysfunctional for the industries that it principally regulates. Copyright industry players and the copyright bar, furthermore, may well prefer the devil they know to the devil that might emerge from a copyright reform project. Hundreds of thousands, if not millions, of licenses have been negotiated in light of the contours of the 1976 Act. Those with the most clout in the copyright legislative process are unlikely to perceive the present copyright law as disadvantageous and would almost certainly resist attempts to recalibrate the copyright balance in a way that might jeopardize the advantages that the present statute provides them.

Further, a copyright reform project focused on revision of the 1976 Act would require a considerable investment of effort from many people, would cost a good deal of money, and would bring to the surface many highly contentious issues, such as those that manifested themselves in the legislative struggles that led to the Digital Millennium Copyright Act of 1998.³¹ Even modest reform efforts, such as one recently undertaken to update library copying privileges now codified in 17 U.S.C. § 108, have encountered difficulties in reaching consensus.

II. MOVING TOWARD A NEW MODEL COPYRIGHT LAW

The prospects of copyright reform are perhaps so dim that a reasonable person might well think it a fool's errand to contemplate a reform project of any sort. It is, however, worth considering the feasibility of a model copyright law, along the lines of model law projects that the American Law Institute has frequently

²⁹ See COPYRIGHT OFFICE CIRCULAR: UNITED STATES COPYRIGHT OFFICE: A BRIEF INTRODUCTION AND HISTORY 1a (2005), <http://www.copyright.gov/circs/circ1a.html> (stating that the first copyright statute was enacted in 1790, first revision in 1831, second revision in 1870, and the third revision was effective in 1909).

³⁰ STEPHEN E. SIWEK, COPYRIGHT INDUSTRIES IN THE U.S. ECONOMY: THE 2006 REPORT, http://www.iipa.com/pdf/2006_siwek_full.pdf.

³¹ See, e.g., LITMAN, *supra* note 2, at 122–50.

promulgated. Such a model copyright law could provide interpretive comments and citations to relevant case law, or at least a set of copyright principles that would provide a shorter, simpler, more comprehensible, and more normatively appealing framework for copyright law.³²

There are several reasons why such a copyright reform project would be worthwhile. First, many copyright professionals agree that the current statutory framework is akin to an obese Frankensteinian monster, even if they do not agree on every detail about the problems with the 1976 Act. At least some copyright professionals would welcome a model law or principles project as a way to restore a positive and more normatively appealing vision of copyright as a “good” law. Implicit in the criticism that many of us level at the 1976 Act, proposals to amend it, or otherwise add other provisions on an ad hoc basis, is that we have an inchoate vision of a “good” copyright law that a model law or principles project could potentially bring to light.

Second, a model law or principles document could provide a platform from which to launch specific copyright reforms, for example, amendments to the 1976 Act to address the orphan works problem, or to object to proposed amendments to the 1976 Act that would either further imbalance or clutter that statute. In order to say “no” in a more principled way to certain entertainment industry proposals to amend copyright law, it would be helpful to articulate a positive conception of copyright in a model law or principles document.

Third, a model law or principles document might, over time, prove useful as a resource to courts and commentators as they try to interpret ambiguous provisions of the existing statute, apply the statute to circumstances that Congress did not and could not have contemplated in 1976, or extract some principled norm from provisions that as codified are incomprehensible or nearly so.

Fourth, a model law or principles document could stimulate valuable discourse about what a “good” (or at least a better) copyright law might look like, which could serve as a potential resource to whoever might undertake a more officially sanctioned copyright law reform project in the future. A model law or principles document could provide an alternative conception of a legal framework that would serve as a contrast to the turgidity of the 1976 Act.

Fifth, it seems to me the right thing to do. Copyright law used to be much simpler than it is today; it can be made simple again; maybe not as simple as the Statute of Anne,³³ but definitely simpler. If it needs to be done, then someone needs to get started with it.

³² See, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION (1995) §§ 9–17, 39–45 (articulating principles of trademark and trade secret law with interpretive comments and citations to case law).

³³ Statute of Anne, 1710, 8 Ann., c. 19 (Eng.), available at <http://www.copyrighthistory.com/anne.html>.

A. *Framing a Model Copyright Law*

Here are some preliminary thoughts about what a model copyright law might include and how one might go about getting rid of some of the clutter in the existing statute. The latter goal can probably best be achieved by developing a rule-making procedure so that many of the industry- and situation-specific provisions can be spun out of the statute and so that future advanced technology questions can be addressed through an administrative process.

Let's start with the core components of copyright law. In the course of teaching intellectual property law for more than twenty-five years, I have developed a framework for introducing students to the core components of an intellectual property regime, which I then use as a framework for introducing copyright law.

The core elements of an IP regime, as I have articulated them, include:

1. A statement of the subject matter(s) that a particular IP regime may be used to protect (i.e., what kinds of intellectual creations are eligible for protection).
2. Eligibility criteria for specific people and works:
 - a. Who is eligible for any IP right that might exist?
 - b. What qualitative or other standards does a particular instance need to satisfy to qualify for those IP rights?
 - c. What if any procedures need to be followed to obtain the rights (or effectively maintain them)?
3. A set of exclusive rights (this is what the IP owner owns).
4. A duration for the exclusive rights.
5. A set of limitations and/or exceptions to those exclusive rights.
6. An infringement standard.
7. A set of remedies against infringers.

A model copyright law ought to include, at a minimum, these core elements. While it is too early to say what substantive changes a model copyright law should make as compared with current law, it is helpful to illustrate how one might trim down the obesity of today's copyright law by breaking it down into similar core components.

1. Subject matter: works of authorship.³⁴
2. Eligibility criteria for specific people and works:
 - a. Who is eligible: the author (but special rule for works made for hire);
 - b. Qualitative or other standards: original; fixed in a tangible medium; not a useful article;

³⁴ 17 U.S.C. § 102(a) (2006). The constitutional subject matter of copyright is the "writings" of "authors." U.S. CONST. art. I, § 8, cl. 8.

- c. Procedures: rights attach automatically as a matter of law from first fixation in a tangible medium;³⁵ deposit is required but not as condition of protection;³⁶ notice and registration are advisable for effective protection;³⁷ registration is necessary for U.S. authors to bring infringement suits; prompt registration is necessary for recovery of attorney fees and statutory damages.³⁸
3. Exclusive rights: reproduce the work in copies; make derivative works; distribute copies to the public; publicly perform the work; publicly display the work;³⁹ importation;⁴⁰ attribution and integrity rights for works of visual art.⁴¹
4. Duration: life of the author plus 70 years; 95 years from first publication for corporate authored works.⁴²
5. Limitations and/or exceptions to those exclusive rights: includes fair use,⁴³ first sale,⁴⁴ certain educational uses,⁴⁵ and backup copying of computer programs,⁴⁶ among others.
6. Infringement standard: infringement occurs when someone violates one of the exclusive rights,⁴⁷ and the activities do not fall within one of the exceptions or limitations to copyright;⁴⁸ usual test applied for non-literal infringements is whether there is substantial similarity in protected expression that the alleged infringer appropriated from the copyright owner.⁴⁹
7. Remedies: preliminary and permanent injunctive relief; money damages; destruction of infringing copies; attorney fees; costs; criminal sanctions.⁵⁰

In addition to addressing these core components, a model copyright law should also be written in plain English so ordinary people—and not just the high

³⁵ 17 U.S.C. § 102(a).

³⁶ *Id.* § 407.

³⁷ Prompt registration enables copyright owners to qualify for awards of statutory damages and attorney fees. *Id.* § 412. Failure to provide adequate notice of infringement affects remedies. *Id.* § 405(b).

³⁸ *Id.* § 411.

³⁹ *Id.* § 106.

⁴⁰ *Id.* § 601.

⁴¹ *Id.* § 106A.

⁴² *Id.* §§ 302(a) (individual authors), 302(c) (works for hire).

⁴³ *Id.* § 107.

⁴⁴ *Id.* § 109(a).

⁴⁵ *Id.* § 110(1)–(2).

⁴⁶ *Id.* § 117.

⁴⁷ *Id.* § 501(a).

⁴⁸ *Id.* §§ 107–122.

⁴⁹ 1 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT §§ 7.1, 7.3 (2002).

⁵⁰ 17 U.S.C. §§ 502–506, 509; *see also* 18 U.S.C. § 2319.

priests of copyright—can understand what the law means.⁵¹ Further, a model copyright law should also articulate the purposes that it seeks to achieve and offer some guidance about how competing interests should be balanced, perhaps through a series of comments on the model law or principles.⁵²

B. Some Substantive Suggestions

1. Clarify the Scope of Subject Matter Protection

If one reflects on experiences with the 1976 Act, it is clear that some parts of the Act have been more successful than others in attaining their stated objectives. Section 102(a), which provides that “[c]opyright subsists . . . in original works of authorship fixed in any tangible medium of expression,”⁵³ was thought preferable as compared with its predecessor provisions because it was simpler and believed flexible enough so that the statute would not need to be amended every time a new category of work came into being.⁵⁴ The simplicity argument for 102(a) is somewhat belied by the fact that it goes on to recite eight specific categories of works that copyright protects.⁵⁵ The flexibility argument for 102(a) has not been borne out by thirty years of experience with the Act. The only subject matters to be added to the copyright regime in the last thirty years—architectural works and computer programs—were accomplished by statutory amendments.⁵⁶ Perhaps there should be an administrative process for determining whether any future classes of innovations should be eligible for copyright protection rather than expecting an open-ended subject matter provision will perform this function well.

⁵¹ See, e.g., LITMAN, *supra* note 2, at 22–34.

⁵² See, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 9–17, 39–45 (1995) (articulating principles of trademark and trade secret law with interpretive comments and citations to case law).

⁵³ 17 U.S.C. § 102(a).

⁵⁴ See H.R. REP. NO. 94-1476, at 51 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664.

⁵⁵ The 1976 Act initially listed the following as qualifying works of authorship: literary works, musical works, dramatic works, pantomimes and choreographic works, pictorial, sculptural or graphic works, motion pictures and other audiovisual works, and sound recordings. 17 U.S.C. § 102(a) (1976 & Supp. 1979).

⁵⁶ Architectural works became statutory subject matter of copyright protection in 1991. See Architectural Works of Copyright Protection Act, Pub. L. No. 101-650, § 706, 104 Stat. 5133, 5134 (1990). While there is some evidence that Congress intended computer programs to be copyrightable subject matter under the 1976 Act, the evidence on this point is somewhat equivocal. See Pamela Samuelson, *CONTU Revisited: The Case Against Copyright Protection for Computer Programs in Machine-Readable Form*, 1984 DUKE L.J. 663, 727–53 (1984). Only after Congress passed legislation recommended by the National Commission on New Technological Uses of Copyrighted Works (CONTU) was there firm evidence of congressional intent to protect machine-executable forms of programs by means of copyright law. See TECHNOLOGICAL USES OF COPYRIGHTED WORKS, FINAL REPORT, *supra* note 24.

2. Clarify the Eligibility Criteria

The congressional intent underlying a key limitation on the scope of copyright protection now set forth in section 102(b)⁵⁷ was to codify the holdings of *Baker v. Selden*⁵⁸ and its progeny.⁵⁹ Congress intended section 102(b) to clarify that methods and systems embodied in copyrighted works cannot be protected by copyright.⁶⁰ Congress also intended the section to ensure that the scope of copyright protection in computer programs would consequently be “thin,” such that only exact or near-exact copying would infringe.⁶¹ This intent has been undermined by the undue deference that some courts have given to an influential treatise which criticized *Baker*, and misconstrued its holding and the policies embodied in the decision.⁶² This treatise contends that *Baker* merely holds (which it does not) that abstract ideas are excluded from the scope of copyright and reads the other seven words of exclusion out of the statute.⁶³

Something akin to 102(b) should be in a model copyright law. Yet, a better provision would make three things clearer: (1) that ideas, concepts, and principles are in the public domain and can never be protected by copyright or any other intellectual property law once they have been revealed to the public; (2) that facts, data, information, and knowledge are similarly excluded from the scope of copyright protection, and as with ideas, they are in the public domain and incapable of becoming intellectual property once publicly disclosed; and (3) that processes, procedures, systems, methods of operation, functions, and useful discoveries are excluded from the scope of copyright protection in any work describing or explaining them, although some of these innovations may be eligible for patent or other forms of intellectual property protection.⁶⁴

A model copyright law should also retain key provisions of the 1976 Act. This includes the originality requirement of the 1976 Act,⁶⁵ particularly since the Supreme Court endorsed the “modicum of creativity” standard for originality.⁶⁶

⁵⁷ 17 U.S.C. § 102(b) (2006); see H.R. REP. NO. 94-1476, at 57 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5670.

⁵⁸ 101 U.S. 99, 104 (1879).

⁵⁹ See Samuelson, *supra* note 56.

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.18 (2006). The Nimmer treatise’s interpretation of *Baker* is criticized at length in Samuelson, *supra* note 56, at Part III.

⁶³ NIMMER & NIMMER, *supra* note 62, § 2.03[D]–[E], § 2.18 (dissecting the exclusions from the scope of copyright law in § 102(b) and the policy rationales for these exclusions).

⁶⁴ Samuelson, *supra* note 36, Part I.

⁶⁵ 17 U.S.C. § 102(a) (2006) (“original works of authorship” qualify for copyright protection).

⁶⁶ *Feist Pub., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 341 (1991) (concluding that white pages listings of telephone directory lacked modicum of creativity necessary to satisfy copyright standards).

Additionally the fixation requirement, which requires a work to be “fixed into a tangible medium of expression” for copyright protection to begin,⁶⁷ has a number of benefits, including the proof it provides that a tangible instance of the work exists and is available for examination and comparison with other works.⁶⁸ Fixation also means that there will be artifacts in existence so that when the copyright term expires, the work of authorship embodied in the artifact will be available for others to reuse and draw upon.

I also think that authors should continue to be the initial owners of any copyrights that might exist in their works. Yet, to avoid transactions costs and avert the risks of fragmentation of rights, it makes sense for employers to own copyrights in works made for hire by employees, although perhaps more might be done to articulate circumstances in which that rule ought not to apply (for example, as to the writings of professors).⁶⁹ Similar policy considerations may support vesting initial ownership of copyright in certain specially commissioned works, but this should be done by articulating criteria for determining which works qualify rather than naming specific categories of works eligible for treatment as the 1976 Act does.⁷⁰

3. Refine Copyright “Formalities”

Additionally, the model copyright law should give more thought than the 1976 Act does to “formalities,” such as copyright notice, registration, and deposit.⁷¹ For almost two hundred years, the United States limited the availability of copyright protection to works whose authors or publishers had sufficient interest in copyright that they took the trouble to comply with some simple rules that gave notice to the world about what works were protected and for how long.⁷² Courts presumed that if a work didn’t have a copyright notice, it was in the public domain and available for free copying and derivative uses.⁷³ The 1976 Act continued this

⁶⁷ 17 U.S.C. § 102(a).

⁶⁸ See, e.g., Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683, 730–34 (2003) (discussing fixation as an evidentiary matter).

⁶⁹ See, e.g., Rochelle Cooper Dreyfuss, *The Creative Employee and the Copyright Act of 1976*, 54 U. CHI. L. REV. 590, 590–600 (1987) (discussing rationales for recognition of a teacher exception to the work for hire rule).

⁷⁰ See 17 U.S.C. § 101(2) (defining “work made for hire” and identifying specific categories of specially commissioned works that may qualify as works made for hire).

⁷¹ The notice provisions of U.S. copyright law can be found at 17 U.S.C. §§ 401–406, the deposit provision at § 407, and registration provision at § 408.

⁷² See Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485, 487–88 (2004).

⁷³ See, e.g., *Advertisers Exch., Inc. v. Anderson*, 144 F.2d 907, 908–09 (8th Cir. 1944) (holding that plaintiff could not recover for copyright infringement of manuals because copyright notice was insufficient where it was labeled with “©” instead of the required “Copyright” or “Copr.” and was thus in the public domain); Lichtman, *supra* note 68, at 719–20 (discussing this presumption under the 1909 Act).

tradition, although it allowed authors to cure defective notice to some extent.⁷⁴ Not until 1988, when Congress passed legislation to conform its law to the requirements of the Berne Convention,⁷⁵ did U.S. copyright law flip this presumption. Currently, a work may not be used unless a person has certain knowledge that it is in the public domain, even if the person seeking to use the work cannot locate the author in order to take a license. This has created a rights-clearance nightmare for any conscientious person who wants to build upon pre-existing works or make them available to others.⁷⁶

The Copyright Office has proposed legislation to limit remedies for reuse of works whose copyright owner cannot be located after a reasonably diligent effort.⁷⁷ This “orphan works” legislation is a step in the right direction, but the problems of too many copyrights and not enough notice of copyright claims and ownership interests run far deeper than that. With the rise of amateur creators and the availability of digital networked environments as media for dissemination,⁷⁸ the volume of works to which copyright law applies and the universe of authors of whom users must keep track have exploded. Creative Commons has done a useful service in providing a lightweight mechanism for allowing sharing and reuses of amateur creations,⁷⁹ but copyright formalities may have a useful role in reshaping copyright norms and practices in the more complex world that has evolved in recent years. More needs to be done to develop centralized repositories for locating copyright owners so that rights clearances can be done without undue transaction costs.

4. Carefully Tailor Exclusive Rights

The exclusive rights of the 1976 Act may also need some renewed attention. The reproduction right, in particular, has proven particularly vexing. At least one appellate court, interpreting the 1976 Act, has opined that every temporary copy

⁷⁴ See H.R. REP. NO. 94-1476, at 143–48 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5759–64 (discussing notice requirements and ability to cure under 1976 Act).

⁷⁵ Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853.

⁷⁶ Christopher Sprigman, *Ninth Circuit Rejects Constitutional Challenge to Copyright Laws in Kahle v. Gonzales*, Public Knowledge, Jan. 23, 2007, <http://www.publicknowledge.org/node/799> (discussing implications of repeal of copyright formalities).

⁷⁷ U.S. COPYRIGHT OFFICE, REPORT ON ORPHAN WORKS 127 (2006).

⁷⁸ See, e.g., Molly Shaffer Van Houweling, *Distributive Values in Copyright Law*, 83 TEX. L. REV. 1535, 1562–64 (2005) (discussing amateur creations disseminated via the internet).

⁷⁹ See Creative Commons, <http://creativecommons.org/> (last visited Nov. 28, 2007). Creative Commons offers a variety of licenses to enable sharing and reuses of copyrighted content. See Creative Commons, License Your Work, <http://creativecommons.org/license/> (last visited Nov. 28, 2007).

made in the random access memory of a computer triggers the reproduction right.⁸⁰ In that case, a computer repair firm was held liable for infringement of computer program copyrights because of RAM copies made when the firm turned on the computer in question to repair it.⁸¹ Congress reacted to this specific ruling by amending the statute to clarify that making copies of digital information contained on computers does not violate copyright law when the copies are made in conjunction with the repair or maintenance of a computer.⁸² However, Congress did not at the same time expressly repudiate the dicta that RAM copies infringe unless they have been authorized.⁸³ It is, of course, impossible to access, use, read, view, or listen to copyrighted works in digital form without making numerous RAM copies of the work.⁸⁴ The 1995 Clinton Administration White Paper on Intellectual Property and the National Information Infrastructure took the position that this was and should be the law and sought to inject this rule in the WIPO Copyright Treaty of 1996.⁸⁵ This stratagem did not succeed.⁸⁶ But the fact remains that the reproduction right needs to be reconsidered in light of post-1976 Act developments and either clarified or more carefully tailored.⁸⁷ The derivative work and public display rights may also need to be reconsidered.⁸⁸

⁸⁰ *MAI Systems Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 518 (9th Cir. 1993), *cert. denied*, 510 U.S. 1033 (1994).

⁸¹ *Id.* at 519–20.

⁸² Digital Millennium Copyright Act, 17 U.S.C. § 117(d) (2006).

⁸³ *MAI Systems Corp.*, 991 F.2d at 519.

⁸⁴ For a thorough discussion of this issue, see Jessica Litman, *The Exclusive Right to Read*, 13 CARDOZO ARTS & ENT. L.J. 29 (1994).

⁸⁵ BRUCE A. LEHMAN, WORKING GROUP ON INTELLECTUAL PROPERTY RIGHTS, INFORMATION INFRASTRUCTURE TASK FORCE, INTELLECTUAL PROPERTY AND THE NATIONAL INFORMATION INFRASTRUCTURE: THE REPORT OF THE WORKING GROUP ON INTELLECTUAL PROPERTY RIGHTS 64–66 (1995), available at <http://www.uspto.gov/web/offices/com/doc/ipnil/ipnil.pdf>. The unsuccessful effort to include a temporary copy norm in the WIPO Copyright Treaty is related in Pamela Samuelson, *The U.S. Digital Agenda at WIPO*, 37 VA. J. INT'L L. 369, 380–92 (1997).

⁸⁶ Samuelson, *supra* note 85, at 390.

⁸⁷ NATIONAL RESEARCH COUNCIL, *THE DIGITAL DILEMMA: INTELLECTUAL PROPERTY RIGHTS IN THE INFORMATION AGE* 140–45 (2001) (questioning whether the reproduction right is a sound benchmark given the nature of digital information).

⁸⁸ The derivative work right should be clarified to resolve certain conflicts in the case law about its scope and questions about its applicability in digital networked environments. Compare *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341, 1343–44 (9th Cir. 1988) (framing art print held to infringe derivative work right), and *Lee v. A.R.T. Co.*, 125 F.3d 580, 581–82 (7th Cir. 1997) (framing picture held non-infringing), and *Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.*, 964 F.2d 965, 968 (9th Cir. 1992) (taking a narrow view of the derivative work right as applied to add-on software), with *MicroStar v. FormGen, Inc.*, 154 F.3d 1107, 1111–12 (9th Cir. 1998) (taking a broad view of the derivative work right as applied to add-ons). There was no counterpart to the public display right in the 1909 Act, and there has been very little case law on what the 1976 Act means by conferring this right on authors. As a consequence, the scope of the public display right is unclear. For a valiant effort to breathe some normative life into the public display right,

Under previous copyright statutes, an author's exclusive rights were, for the most part, narrowly tailored and narrowly construed; moreover, acts that did not fall within the contemplated scope of those exclusive rights were considered to be unregulated and consequently free from copyright constraints.⁸⁹ Common law interpretation of copyright also led to the creation of some limitations and exceptions, such as the fair use and the first sale exceptions, as necessary to achieving a balance between rights holders and public interests in copyright law. The 1976 Act, in the guise of simplifying the exclusive rights provision, arguably broadened the rights substantially.⁹⁰ It further set forth a considerable number of exceptions and limitations,⁹¹ few of which seem based on normative principles. They seem more to reflect who showed up—and who didn't—at the legislative hearings at which carve-outs were up for grabs.⁹²

This manner of articulating exclusive rights implies that if the 1976 Act does not specifically provide an exception for a particular activity that falls within one or more of the broadened exclusive rights, then the activity, no matter how economically trivial, will be deemed illegal unless it can somehow be shoe-horned into the fair use rubric or some other specific exception.⁹³ The broadening of exclusive rights and the articulation of very detailed and often narrowly tailored exceptions and limitations seemingly mean that the unregulated spaces of

see R. Anthony Reese, *The Public Display Right: The Copyright Act's Neglected Solution to the Controversy Over RAM "Copies,"* 2001 U. ILL. L. REV. 83, 83. *But see* Perfect 10 v. Google, Inc., 416 F. Supp. 2d 828, 843–44 (C.D. Cal. 2006) (holding search engine violated public display right in Google's use of thumbnails because infringing information was on Google's servers), *aff'd in part, rev'd in part*, Nos. 06-55405, 06-55406, 06-55425, 06-55759, 06-55854, 06-55877, 2007 WL 1428632 (9th Cir. May 16, 2007).

See 17 U.S.C. § 1 (1947) (exclusive rights under 1909 Act) (revised 1976 in 17 U.S.C. § 106). Public performances of musical works under the 1909 Act, for example, were unregulated unless they were "for profit." *Id.* § 1(e).

⁹⁰ *See* 17 U.S.C. § 106 (1976 & Supp. 1979). Under the 1909 Act, only specific derivatives were within the reach of the statute. *See* 17 U.S.C. § 1(b) (1947) ("To translate the copyrighted work into other languages or dialects, or make any other version of, if it be a literary work; to dramatize it if it be a nondramatic work; to convert it to a novel or other nondramatic work if it be a drama; to arrange or adapt it if it be a musical work; to complete, execute, and finish it if it be a model or design for a work of art."). The public performance right was similarly narrower under the 1909 Act than under the 1976 Act. *Compare* 17 U.S.C. § 1(d)–(e) (1947), *with* 17 U.S.C. § 106(4) (1976 & Supp. 1979).

⁹¹ 17 U.S.C. §§ 107–122. The fair use provision is one of the few exceptions and limitations that gives the reader some sense of the normative purpose for its existence. *Id.* § 107 (fair use "for purposes as criticism, comment, news reporting, teaching . . . , scholarship, or research" is noninfringing).

⁹² How else can one account for the fact that agricultural and horticultural fairs got exceptions to enable them to publicly perform certain classes of copyrighted works, whereas other seemingly equally socially valuable gatherings (for example, girl scout rallies) did not?

⁹³ *See, e.g.,* Jessica Litman, *Lawful Personal Use*, 85 TEX. L. REV. 1871 (2007) (discussing this phenomenon).

copyright have shrunk considerably. This flipped another presumption of previous laws. Under predecessor laws, that which was not forbidden was permitted. Under the 1976 Act, arguably only those uses expressly permitted were lawful.⁹⁴ As Jessica Litman has recently shown, there are many personal uses of copyrighted works that may trip one of the exclusive rights and fail to qualify for one of the statutory exceptions, even though reasonable people would agree they should be considered lawful personal uses. For example, an individual who makes a backup copy of her digital music files may be infringing the reproduction right under a very strict interpretation of the 1976 Act.⁹⁵ Additional work on user rights should be part of a model copyright law project.⁹⁶

5. Reduce the Duration of Copyright

In addition, drafters of a model copyright law should consider modifying the duration of copyright. This topic has been the subject of contentious debate in recent years, indeed of constitutional challenges and popular protests.⁹⁷ It would be in the public interest for more copyrighted works to get in the public domain sooner than currently required by copyright law.⁹⁸ Shortening the duration of the copyright term would be one way to achieve this objective. Another would be to require periodic renewals of copyright claims for a small registration fee. International treaty obligations will surely be asserted as a reason not to make structural changes to the life + X years approach to copyright duration,⁹⁹ but it is worth thinking more carefully about durational limits. A model copyright law should make it easier for works to be dedicated to the public domain.¹⁰⁰ Drafters

⁹⁴ This was certainly the premise of Justice Blackmun's dissent in *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 457–500 (1984) (Blackmun, J. dissenting). The Blackmun dissent and its implications are discussed in Pamela Samuelson, *The Generativity of Sony v. Universal: The Intellectual Property Legacy of Justice Stevens*, 74 *FORDHAM L. REV.* 1831, 1846–50, 1875 (2006).

⁹⁵ LITMAN, *supra* note 2.

⁹⁶ See, e.g., Rochelle Cooper Dreyfuss, *TRIPS—Round II: Should Users Strike Back?*, 71 *U. CHI. L. REV.* 21, 22–23 (2004).

⁹⁷ See, e.g., *Eldred v. Ashcroft*, 537 U.S. 186, 208, 217 (2003) (rejecting constitutional challenge to Copyright Term Extension Act). Lawrence Lessig, who was counsel for Eldred in this case, inspired protests against the CTEA. See, e.g., OpenLaw: *Eldred v. Ashcroft*, <http://cyber.law.harvard.edu/eldredvreno/> (last visited Nov. 28, 2007).

⁹⁸ See, e.g., Brief of George A. Akerlof, et al. as Amici Curiae in Support of Petitioners at 5–7, *Eldred v. Ashcroft*, 537 U.S. 186 (2003) (No. 01-618), available at <http://cyber.law.harvard.edu/openlaw/eldredvashcroft/supct/amici/economists.pdf>.

⁹⁹ Berne Convention for the Protection of Literary and Artistic Works, art. 7(1), Sept. 9, 1886, revised at Paris on July 24, 1971 and amended in 1979, S. TREATY DOC. NO. 99-27 (1986) [hereinafter Paris Act], reprinted in *SELECTED STATUTES*, *supra* note 1, at 553–73. Art. 7(1) requires member states of the Berne Union to protect works for life of the author plus fifty years after the author's death.

¹⁰⁰ See, e.g., Robert P. Merges, *A New Dynamism in the Public Domain*, 71 *U. CHI. L. REV.* 183, 201–02 (2004).

might also want to consider whether a feature such as the 1976 Act termination of transfer provisions is the best way to give authors a second chance to share in the value of works they created which were assigned or licensed to others.¹⁰¹

6. Clarify Infringement Standards

Drafters of a model law should also consider clarifying the standard for judging infringement. Under the 1976 Act, infringement occurs when someone trespasses on an exclusive right, and this trespass is not excused by an exception or limitation.¹⁰² The statute is silent, however, about how judges or juries should determine whether an infringement has occurred. The courts have, of course, developed tests for judging when infringement has occurred and for determining on which issues experts can testify.¹⁰³ Infringement standards based on case law are neither satisfactory nor consistent with one another.¹⁰⁴ Courts are especially confused over the extent to which a dissection analysis of the component parts of the work or a gestalt-like impression test should be used, and whether the tests should be applied separately or together.¹⁰⁵ It would be worth considering whether a model copyright law could give greater guidance on this score than prior statutes have done.

Drafters of a model copyright law should also consider whether infringements should only be found where the defendant had some wrongful knowledge or intent, or whether certain remedies should only be available based on wrongful knowledge or intent. Codification of secondary liability rules and standards for judging indirect infringements should also be part of a model copyright law. The 1976 Act is deficient in this respect,¹⁰⁶ although courts have evolved some standards for secondary liability over the years.¹⁰⁷

¹⁰¹ See, e.g., 17 U.S.C. § 304(c) (2006); see Peter S. Menell & David Nimmer, *Defusing the Termination of Transfers Time Bomb*, (2005) <http://www.idc.ac.il/ipatwork/PUBLICATION/Defusing.pdf>.

¹⁰² See 17 U.S.C. § 501(a).

¹⁰³ See, e.g., *Arnstein v. Porter*, 154 F.2d 464, 469, 473 (2d Cir. 1946) (discussing infringement standards and roles of experts); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121–23 (2d Cir. 1930) (discussing infringement standards and roles of experts).

¹⁰⁴ Compare infringement standards set forth in *Arnstein*, 154 F.2d at 469 (substantial similarity to be judged based on dissection and lay observer impression), with those set forth in *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164–66 (9th Cir. 1977) (extrinsic/intrinsic test), and *Computer Assoc. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706–711 (2d Cir. 1992) (abstraction/filtration/comparison test).

¹⁰⁵ The *Altai* test, 982 F.2d at 706–11, for example, is highly dissection and seems to leave no room for lay observer impressions, while *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 482, 489 (2d Cir. 1960) relies heavily on lay observer impression and almost not at all on dissection.

¹⁰⁶ See 17 U.S.C. § 106 (setting forth exclusive rights conferred on copyright owners). This provision allows authors to exercise or “to authorize” these exclusive rights. The “to authorize” language is said to provide a statutory basis for secondary liability, but how far this authorizes secondary liability is questionable. See Brief of Amici Curiae of Sixty

7. *Rethink Certain Remedies*

Finally, a model copyright act should address remedies for copyright infringement. I have no quarrel with preserving injunctive relief and actual damage recoveries when copyrights have been infringed.¹⁰⁸ But, more thought should perhaps be given to articulating under what circumstances defendants' profits should be awarded.¹⁰⁹ Drafters should also consider whether preliminary injunctions should be as easy to obtain in copyright cases as they have been in recent years.¹¹⁰ Also worth considering is whether in close cases, greater use should be made, as the Supreme Court has more than once endorsed, of damage awards in lieu of injunctive relief.¹¹¹

The remedy issue most in need of serious rethinking is statutory damages. Under the 1976 Act, copyright owners can ask for an award of statutory damages in amounts ranging from \$200 to \$150,000 per infringed work, even if the copyright owner has actually suffered no damages.¹¹² The willfulness or innocence of an infringement has some bearing on the range for such damages,¹¹³ but due process considerations argue strongly for development of more refined criteria. One factor that seemingly tipped a majority of the Supreme Court to the fair use ruling in the *Sony*¹¹⁴ case was the prospect that ordinary people who had used their VCRs to make copies of television programs could be liable for statutory damages amounting to multiple thousands of dollars just for taping a show to watch it at a later time than it was broadcast.¹¹⁵ Thought should also be given to circumstances under which those charged with secondary liability for user infringements should

Intellectual Property and Technology Law Professors and the United States-Ass'n for Computing Machinery Public Policy Committee in Support of Respondents, *Metro-Goldwyn-Mayer Studios, Inc., v. Grokster*, 545 U.S. 913 (2005) (No. 04-480) *reprinted in* 20 *BERKELEY TECH. L.J.* 535 (2005).

¹⁰⁷ *See, e.g.*, *Metro-Goldwyn-Mayer Studios*, 545 U.S. at 936–37 (borrowing inducement liability rule from patent law); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 434–42 (1984) (borrowing contributory infringement liability from patent law).

¹⁰⁸ 17 U.S.C. §§ 502 (injunctive relief), 504(b) (actual damages).

¹⁰⁹ *Id.* § 504(b). Unjust enrichment may justify an award of profits in some cases, as where the defendant has willfully infringed, but query whether such an award is always justified, given that copyright infringement under U.S. law is today a strict liability offense.

¹¹⁰ Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 *DUKE L.J.* 147, 197–208 (1998).

¹¹¹ *See, e.g.*, *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 n.10 (1994).

¹¹² 17 U.S.C. § 504(c).

¹¹³ Statutory damages can be as low as \$200 for an innocent infringer and as high as \$150,000 for willful infringement. The range is \$750 to \$30,000 for other infringements. *Id.* § 504(b).

¹¹⁴ *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 417 (1984).

¹¹⁵ *See* Jessica Litman, *The Sony Paradox*, 55 *CASE W. RES. L. REV.* 917, 928–33 (2005).

have to pay statutory damages, and if so, how much. Criminal copyright rules should also be revisited and clarified.¹¹⁶

By focusing on these core elements of copyright, I do not mean to suggest that nothing but these elements should be in a model copyright law or principles document. Yet perhaps anything else nominated for inclusion in the model law or principles should be accompanied by a justification as to why it needs to be there, and why it should not be achieved through common law evolution of copyright law by judges or delegated to an administrative rulemaking process.¹¹⁷

III. OTHER CHALLENGING ASPECTS OF COPYRIGHT REFORM

Equally challenging to drafting a substantive model of copyright law is conceiving a way to restructure institutions and policymaking processes so that the dysfunctions that currently beset copyright lawmaking can be averted or at least mitigated to some degree. It makes little sense to develop a model copyright law that is simple, comprehensible, and coherent if there is no mechanism to prevent it from getting cluttered by the same kinds of industry-specific “fixes” and compromises that have made the 1976 Act so bloated and ugly.

The simplest way to achieve this objective would be a legislative delegation of rulemaking authority to the government office responsible for carrying out copyright-related responsibilities.¹¹⁸ Many of the industry-specific exceptions now in the 1976 Act,¹¹⁹ for example, would probably be better implemented as the by-product of agency rulemaking rather than by legislative amendment. An advantage of ongoing rulemaking authority would be that it would be possible to update complex provisions of this sort, as technology and the industry adapted to new developments. Perhaps a restructured, more administratively rigorous government copyright office could take on some adjudicative and policymaking functions as well.¹²⁰

¹¹⁶ See, e.g., Lydia Loren, *Digitization, Commodification, Criminalization: The Evolution of Criminal Copyright Infringement and the Importance of the Willfulness Requirement*, 77 WASH. U. L.Q. 835, 835 (1999).

¹¹⁷ Misuse of copyright is an example of a copyright doctrine not already in the copyright statute that might be worth codifying in a copyright law. See, e.g., Tom W. Bell, *Codifying Copyright's Misuse Doctrine*, 2007 UTAH L. REV. 573.

¹¹⁸ Congress gave the Library of Congress (in which the Copyright Office is located) rule-making authority as part of the Digital Millennium Copyright Act of 1998. Pub. L. No. 105-304, 112 Stat. 2860 (codified at 17 U.S.C. § 1201(a)(1)(B)–(D)).

¹¹⁹ See, e.g., 17 U.S.C. § 111 (2006) (exception for secondary transmissions of television programming by cable systems).

¹²⁰ This has been suggested by several commentators. See, e.g., Michael Carroll, *Fixing Fair Use*, 85 N.C. L. REV. 1087 (proposing establishment of fair use board as part of the Copyright Office); Jacqueline D. Lipton, *Solving the Digital Piracy Puzzle: Disaggregating Fair Use from the DMCA's Anti-Device Provisions*, 19 HARV. J. L. & TECH. 111, 120–24, 146–59 (2005) (suggesting that the Copyright Office develop an administrative procedure for dealing with fair use defenses as to technically protected content); see also Mark A. Lemley & R. Anthony Reese, *Reducing Digital Copyright*

A model copyright law or principles project will be faced with other challenges besides what substantive rules to propose and what kinds of institutional and process reforms might help maintain the integrity of the law or principles. One such challenge is to what extent the drafters should feel constrained in their thinking by international treaty obligations.¹²¹ International obligations should be considered as a constraint, it seems to me, but not so much of a constraint that the drafters cannot deliberate about what the right rule might be and then consider whether it can be reconciled with international obligations. There may be more flexibility in international norms than some may perceive. Drafters of a model copyright law or principles document might also find it useful to articulate what they believe to be the “best” rule on a particular subject, even if it may seem to conflict with an international norm, but then consider whether a second-best rule might accommodate the desired policies reasonably well.

A second challenge is whether to draft U.S.-centric or more internationally acceptable rules. There are several reasons why this is an especially challenging task. First, any drafting group is likely to be largely, if not entirely, American in training and expertise, and it will be difficult for them to set aside the American mindset on copyright law. Second, there are significant substantive and philosophical differences between the two principal traditions for intellectual property rights for literary and artistic works, namely, the economically oriented, utilitarian approach of the United States and the European authors’ rights approach.¹²² While some commonalities can be identified among the rules embodied in these legal traditions, differences may be more profound than their commonalities.

One possible way to manage these differences would be for drafters of a model copyright law to articulate rules both traditions have in common and then to offer policy options where they differ. For example, the rules as to whom should be considered “the author,” and therefore, the owner of rights conferred under the law, might be structured with a set of policy options. Jurisdictions with a more economic or utilitarian tradition might choose to adopt work-for-hire rules such as those embodied in U.S. copyright law,¹²³ whereas jurisdictions inclined to protect authors’ rights might choose a policy option that always confers rights on authors.

A third challenge is to what extent the drafting should be constrained by existing interests of rights holders, licensing practices, and institutional structures

Infringement without Restricting Innovation, 56 STAN. L. REV. 1345, 1351–53 (2004) (proposing lightweight administrative process for resolving disputes about peer-to-peer file-sharing).

¹²¹ See Paris Act, *supra* note 99, reprinted in SELECTED STATUTES, *supra* note 1, at 553–80; Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). *Id.* at 1023–61. Article 9 of TRIPs requires member nations of the World Trade Organization to abide by Articles 1 through 21 of the Berne Convention.

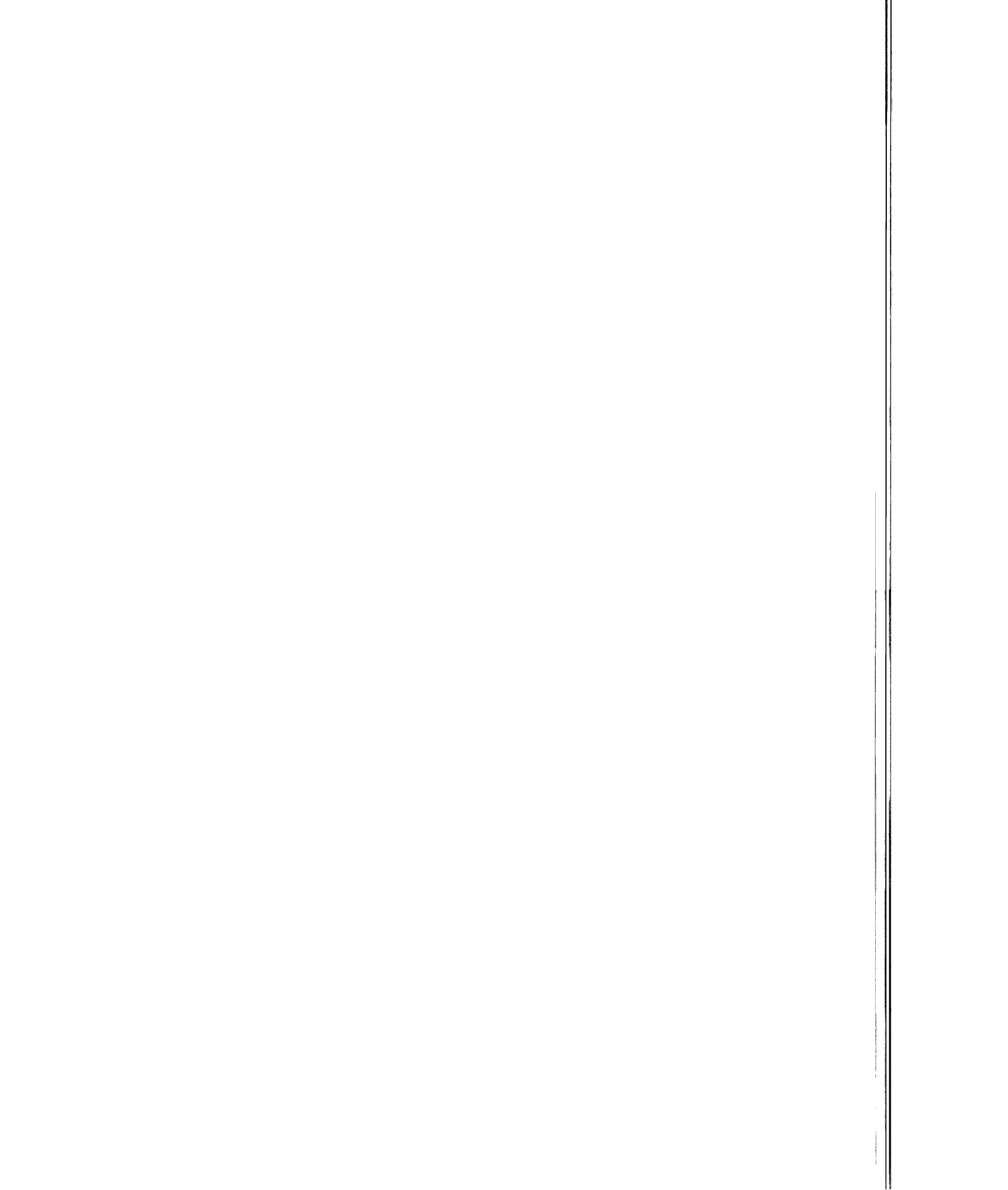
¹²² See, e.g., Pamela Samuelson, *Economic and Constitutional Influences on Copyright Law in the United States*, 23 EUR. INTELL. PROP. REV. 409, 409 (2001) (contrasting U.S. and E.U. approaches to copyright law).

¹²³ 17 U.S.C. § 201(b).

such as collecting societies.¹²⁴ At a minimum, serious consideration should be given to how to achieve a kind of policy interoperability for transitioning from existing statutory frameworks to the model law framework.

Finally, there is the challenge of even contemplating how such a project might be transitioned to an implemented legal framework. As noted earlier, the prospects for meaningful copyright reform in the near future are at the moment very dim. Since many copyright industry representatives know how to navigate the current copyright regime and at least at times enjoy some benefits from its dysfunctionalities, there are formidable hurdles to implementing a reformed copyright law. The obstacles are perhaps so formidable that many would think it not worth the investment of intellectual effort to draft a model law. Still, few would contest the idea that a simpler, more comprehensible, and more balanced copyright law would be a good idea. Perhaps the preliminary thoughts offered in this essay and in other articles in this symposium issue will spark a new round of copyright reform discourse.

¹²⁴ See, e.g., Glynn S. Lunney, Jr., *Copyright Collectives and Collecting Societies: The United States Experience*, in COLLECTIVE MANAGEMENT OF COPYRIGHT AND RELATED RIGHTS 311–13 (describing the practices of collecting societies and copyright collectives in the United States) (Daniel Gervais ed., 2006); see also Daniel Gervais, *The Evolving Role(s) of Copyright Collectives*, in DIGITAL RIGHTS MANAGEMENT: THE END OF COLLECTING SOCIETIES? 27, 56 (Christoph Beat Graber et al. eds., 2005) (discussing the implications of technology changes on collecting societies).



CODIFYING COPYRIGHT'S MISUSE DEFENSE

Tom W. Bell*

Although courts have recognized misuse as a defense to copyright infringement, lawmakers have not yet codified it. To clarify the doctrine, and to bring the Copyright Act up to date with the law, this Article proposes adding to the Copyright Act a new § 107(b):

It constitutes copyright misuse to contractually limit any use of a copyrighted work if that use would qualify as noninfringing under § 107(a). No party misusing a work has rights to it under § 106 or § 106A during that misuse. A court may, however, remedy breach of any contract the limitations of which constitute copyright misuse under this section.

This Article documents § 107(b)'s codification of the judicial precedents, offers legislative history explaining the proposed statute, and discusses how the new law would work in the real world. Although the proposed codification of copyright misuse would in large part simply rationalize what courts have already said, it would also promote the salutary policy goal of encouraging the owners of expressive works to forego copyright rights in lieu of common law ones.

I. INTRODUCTION

The misuse defense to copyright infringement exists, at present, only in scattered judicial pronouncements¹ and in a somewhat uncertain form.² The U.S.

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¹ See, e.g., *Video Pipeline, Inc. v. Buena Vista Home Entm't, Inc.*, 342 F.3d 191, 206 (3d Cir. 2003) (expressly “extend[ing] the patent misuse doctrine to copyright,” but ultimately holding it inapplicable to the case at hand); *Bond v. Blum*, 317 F.3d 385, 397–98 (4th Cir. 2003) (affirming trial court finding of misuse); *DSC Commc'ns Corp. v. Pulse Commc'ns, Inc.*, 170 F.3d 1354, 1368 (Fed. Cir. 1999) (recognizing “[c]opyright misuse is a defense to a claim of copyright infringement”); *Alcatel USA, Inc. v. DGI Techs., Inc.*, 166 F.3d 772, 792 (5th Cir. 1999) (holding same); *Practice Mgmt. Info. Corp. v. Am. Med. Ass'n*, 121 F.3d 516, 520 (9th Cir. 1997) (holding same); *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 976 (4th Cir. 1990) (holding same); see also, *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303, 311 (2d Cir. 1966) (Lumbard, C.J., concurring) (recognizing that the doctrine of unclean hands should bar enforcement of a copyright used to “restrict the dissemination of information about persons in the public eye even though those concerned may not welcome the resulting publicity”).

Supreme Court has only hinted at the doctrine,³ and federal lawmakers have yet to codify it.⁴ Nonetheless, lower courts appear increasingly willing⁵ to recognize misuse as a defense to copyright infringement.⁶ Misuse has now reached a stage of development similar to the stage that the fair use defense reached before its statutory enactment.⁷ Furthermore, just as precedents from patent law inspired

² See PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 11.6, 11:42 (3d ed. 2005 & Supp. 2006) (“Because copyright misuse doctrine is still relatively unformed, categorization of its central concerns is at best approximate.”).

³ See *United States v. Loew’s, Inc.*, 371 U.S. 38, 50 (1962) (stating that “[t]he principles underlying our *Paramount Pictures* decision have general application to tying arrangements involving copyrighted products”); *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948) (approving an injunction on certain copyright licensing practices on grounds that the practices “add to the monopoly of the copyright in violation of the principle of the patent cases involving tying clauses”); *Lasercomb*, 911 F.2d at 976 (“[N]o United States Supreme Court decision has firmly established a copyright misuse defense in a manner analogous to the establishment of the patent misuse defense.”).

⁴ See Copyright Act of 1976, 17 U.S.C. §§ 101–1332 (2006).

⁵ See GOLDSTEIN, *supra* note 2, at 11.6, 11:40 (“The copyright misuse defense is widely accepted today, both in dicta and in holdings.” (footnote omitted)); MARK A. GLICK, LARA A. REYMAN, & RICHARD HOFFMAN, INTELLECTUAL PROPERTY DAMAGES: GUIDELINES AND ANALYSIS 297 (2003) (“[C]opyright misuse appears to be gaining credibility as a defense”); Ralph Jonas, et al., *Copyright and Trademark Misuse, in ABA SECTION OF ANTITRUST LAW, INTELLECTUAL PROPERTY MISUSE: LICENSING AND LITIGATION* 165, 165 (2000) (predicting “copyright misuse doctrine eclipsing patent misuse doctrine in importance”).

⁶ See *supra* note 1 (listing federal circuits that have recognized the defense); *Int’l Motor Contest Ass’n v. Staley*, 434 F. Supp. 2d 650, 664 (N.D. Iowa 2006) (noting the absence of “a single Circuit Court of Appeals decision expressly rejecting such a defense as a matter of law”).

Several circuits have yet, however, to expressly recognize the validity of the copyright misuse defense. See *Garcia-Goyco v. Law Envtl. Consultants, Inc.*, 428 F.3d 14, 21 n.7 (1st Cir. 2005) (observing that the First Circuit “has not yet recognized misuse of a copyright as a defense to infringement” but concluding that the court was not required to reach the issue); *Telecom Technical Servs. v. Rolm Co.*, 388 F.3d 820, 831 (11th Cir. 2004) (“This circuit has not recognized, but has not rejected, misuse as a defense for infringement suits.”); *Data Gen. Corp. v. Grumman Sys. Support Corp.*, 36 F.3d 1147, 1170 (1st Cir. 1994) (finding that the present case “does not require us to decide whether the federal copyright law permits a misuse defense” because there was insufficient evidence of the alleged misuse); *BellSouth Adver. & Publ’g Corp. v. Donnelley Info. Publ’g*, 999 F.2d 1436, 1439 n.5, 1446 (11th Cir. 1993) (en banc) (vacating and reversing a panel decision recognizing the defense, because there was no copyright infringement, and hence, no need to reach the question of whether to recognize a “misuse of copyright” defense); *United Tel. Co. v. Johnson Publ’g Co., Inc.*, 855 F.2d 604, 612 (8th Cir. 1988) (“On the assumption that judicial authority teaches that the patent misuse doctrine may be applied or asserted as a defense to copyright infringement, the stipulated facts in this case do not support Johnson’s contention that United Telephone ‘misused’ its copyright.”).

⁷ See *Ty, Inc. v. Publ’ns Int’l Ltd.*, 292 F.3d 512, 517 (7th Cir. 2002) (“The defense of fair use, originally judge-made, now codified, plays an essential role in copyright law.”).

courts to recognize the defense of copyright misuse,⁸ the Patent Act's codification of misuse⁹ should serve as a model for lawmakers, inspiring them to write copyright misuse into the Copyright Act.

To rationalize the doctrine, and bring the Copyright Act up to date with the law, this Article proposes a codification of copyright's misuse defense. Specifically, it suggests putting all that now appears in § 107 of the Copyright Act into a section designated § 107(a) and adding to the Copyright Act this section, § 107(b):

It constitutes copyright misuse to contractually limit any use of a copyrighted work if that use would qualify as noninfringing under § 107(a). No party misusing a work has rights to it under § 106 or § 106A during that misuse. A court may, however, remedy breach of any contract the limitations of which constitute copyright misuse under this section.

Several scholars have proposed clarifying or modifying copyright's misuse doctrine.¹⁰ Some have even called for its codification.¹¹ None, however, appears to have tackled the project. Perhaps the prospect seemed too constraining. Any attempt to codify a judicial doctrine must, after all, pay due heed to the case law. The codification offered here aims to do so, at any rate.

Codifying copyright's misuse doctrine calls for more than mere legal stenography, however. The relevant case law splits on important issues and offers little by way of theory to patch things up. Insofar as predominant judicial views

⁸ See GOLDSTEIN, *supra* note 2, at § 11.6, 11:38 (“[C]ourts have drawn on [patent misuse] in giving shape to the misuse doctrine in copyright.”).

⁹ See 35 U.S.C. § 271(d) (2006) (codifying patent's misuse defense).

¹⁰ See, e.g., Thomas F. Cotter, *The Procompetitive Interest in Intellectual Property*, 48 WM. & MARY L. REV. 483, 552 (2006) (suggesting that in cases where restrictions on reverse engineering give rise to misuse or fair use concerns, “courts probably should require some proof of anticompetitive effects before excusing the IP defendant from liability”); Kathryn Judge, Note, *Rethinking Copyright Misuse*, 57 STAN. L. REV. 901 (2004) (arguing that any attempt to use copyright to gain control over an idea or to deter fair use should constitute misuse and that courts should discourage copyright misuse by denying equitable relief); Jennifer R. Knight, Comment, *Copyright Misuse v. Freedom of Contract: And the Winner Is*, 73 TENN. L. REV. 237, 262–65 (2006) (proposing that courts follow a multi-factor balancing test to invalidate copyright licenses that facilitate misuse); Lydia Pallas Loren, *Slaying the Leather-Winged Demons in the Night: Reforming Copyright Owner Contracting with Clickwrap Misuse*, 30 OHIO N.U. L. REV. 495, 523 (2004) (proposing that “if a shrinkwrap or clickwrap clause purports to limit activity that a majority of courts have found to be fair use, that clause should also trigger a presumption of misuse”).

¹¹ See Judge, *supra* note 10, at 937 (stating that “I would strongly encourage Congress to codify misuse in the form advocated by this Note” but not offering specific statutory language); Knight, *supra* note 10, at 265 (proposing that lawmakers enact a Copyright Misuse Act but not describing such an Act's content).

have surfaced, proposed § 107(b) hews to them.¹² As for the rest, § 107(b) advances a policy implicit in the case law: when copyright and contract rights combine to give a copyright owner too much legal power, courts should decline to enforce only the owner's copyright rights.¹³ By so doing, courts would keep private and public interests in rough balance.

Part II of this Article sums up the case law on copyright misuse, documenting how well § 107(b) captures the extant law. Part III offers legislative history for the proposed amendment, explaining why it would help the Copyright Act to "promote the Progress of Science and useful Arts . . ."¹⁴ Part IV forecasts how § 107(b) would fare in the legislative process and, supposing it survives, what impact it would have in the real world.

II. COPYRIGHT MISUSE IN THE COURTS

Copyright misuse currently exists solely as a judge-made doctrine. Understanding how lawmakers should codify copyright misuse calls for first understanding how courts have shaped the doctrine. Other commentators have tackled that worthy project many times over and in great detail.¹⁵ This part thus offers only a summary account of the extant case law on copyright misuse.

Copyright misuse grew out of patent misuse, where the doctrine originated to bar patent owners from wielding their statutory rights to effectuate illegal restraints on trade.¹⁶ Although some authorities have affirmed that using a copyright in violation of antitrust law likewise constitutes misuse,¹⁷ most courts that have applied the doctrine have done so in response to other, less plainly actionable

¹² The second sentence of § 107(b), for instance, largely sums up the case law defining the effect that misuse has on copyright infringement claims. *See infra* Part III.

¹³ *See, e.g.*, the last sentence of § 107(b), discussed in detail at *infra* Part III.

¹⁴ U.S. CONST., art. I, § 8, cl. 8.

¹⁵ *See, e.g.*, Melville B. Nimmer & David Nimmer, 4 NIMMER ON COPYRIGHT § 13.09, 13-291 to 13-295 (2006) [hereinafter NIMMER ON COPYRIGHT]; GLICK, ET AL., *supra* note 5, at 297-304; GOLDSTEIN, *supra* note 2, at § 11.6, 11:36 to 11:43; Brett Frischmann & Dan Moylan, *The Evolving Common Law Doctrine of Copyright Misuse: A Unified Theory and Its Application to Software*, 15 BERKELEY TECH. L.J. 865, 871-900 (2000) (describing policy and case law supporting misuse); Judge, *supra* note 10, at 915-23.

¹⁶ *See* NIMMER ON COPYRIGHT, *supra* note 15, § 13.09[A][2][a] at 13-296 (explaining that courts "have long held that a patentee who uses his patent privilege contrary to the public interest by violating the antitrust laws will be denied the relief of a court of equity in a patent infringement action" (footnotes omitted)).

¹⁷ *See* Nat'l Cable Television Ass'n v. Broad. Music, Inc., 772 F. Supp. 614, 652 (D.D.C. 1991) (explaining that "failure to show violation of the antitrust laws makes it more difficult to conclude that [copyright owners] have misused their copyrights. While such a violation is not a prerequisite to showing misuse, . . . its absence" requires a showing that the copyright owner "somehow illegally extended its monopoly or otherwise violated the public policy underlying copyright law").

wrongs.¹⁸ As the Fourth Circuit Court of Appeals put it, in pioneering the doctrine of copyright misuse, “[t]he question is not whether the copyright is being used in a manner violative of antitrust law . . . but whether the copyright is being used in a manner violative of the public policy embodied in the grant of a copyright.”¹⁹

As that broad reference to public policy suggests, the exact scope of misuse remains a bit uncertain. The doctrine evidently applies when a copyright owner attempts to restrict by license competitive behavior otherwise permissible under copyright law.²⁰ Courts have also found misuse where copyright owners have attempted to use their statutory rights to inhibit what the fair use defense plainly allows²¹ or what the Copyright Act otherwise leaves unprotected.²² Based on the

¹⁸ For one of the few opinions to address the viability of a copyright misuse defense associated with a violation of the antitrust laws, see *Elec. Data Sys. Corp. v. Computer Assocs. Int’l, Inc.*, 802 F. Supp. 1463 (N.D. Tex. 1992) (denying motions to dismiss copyright misuse and antitrust claims). *See also*, NIMMER ON COPYRIGHT, *supra* note 15, § 13.09[A][2][a] at 12-295 (“[S]ome courts have indicated that a copyright owner would be denied relief in an infringement action, if he is in violation of the antitrust laws.” (footnotes omitted)).

¹⁹ *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 978 (4th Cir. 1990).

²⁰ *See Alcatel USA, Inc. v. DGI Techs., Inc.*, 166 F.3d 772, 793–94 (5th Cir. 1999) (holding that plaintiff engaged in copyright misuse by licensing its software on condition that it be used only with plaintiff’s hardware); *Practice Mgmt. Info. Corp. v. Am. Med. Ass’n*, 121 F.3d 516, 520–21 (9th Cir. 1997) (finding that a license preventing use of other forms gave plaintiff AMA a substantial and unfair advantage over its competitors, thereby constituting misuse); *Lasercomb*, 911 F.2d at 977–79 (finding that misuse caused by a license suppressing independent development of competing, non-infringing software). *But see Costar Group, Inc. v. Loopnet, Inc.*, 164 F. Supp. 2d 688, 708 (D. Md. 2001) (rejecting misuse defense where the plaintiff attempted by license to “restrict licensees from distributing photographs and data over which, by its own admission, it has no claim of ownership”).

²¹ *Bond v. Blum*, 317 F.3d 385, 397–98 (7th Cir. 2003) (affirming the trial court’s finding of misuse where plaintiff brought an infringement suit “to suppress the underlying facts of his copyrighted work rather than to safeguard its creative expression”); *Video Pipeline, Inc. v. Buena Vista Home Entm’t, Inc.*, 342 F.3d 191 (3d Cir. 2003) (recognizing that a copyright owner might commit misuse in trying to enforce a license that prohibits criticism of copyright-protected works, though affirming that the licenses in question had not gone that far).

²² *Assessment Techs. of WI, LLC v. WIREdata, Inc.*, 350 F.3d 640, 647 (7th Cir. 2003) (explaining that it constitutes misuse “to use an infringement suit to obtain property protection, here in data, that copyright law clearly does not confer”); *see also A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1026 (9th Cir. 2001) (“The misuse defense prevents copyright holders from leveraging their limited monopoly to allow them control of areas outside the monopoly.”); *Lasercomb*, 911 F.2d at 979 (“The misuse arises from Lasercomb’s attempt to use its copyright . . . to control competition in an area outside the copyright . . .”).

logic of such cases, and suggestive *dicta* from other cases, commentators surmise that the defense extends to attempts to contractually restrict users' fair use rights.²³

During the misuse of a copyrighted work, the work affords its owner no copyright rights. A copyright owner can regain those rights, but only by ending the practices that constitute misuse.²⁴ Even then, judging from patent law precedent,²⁵ courts will not remedy alleged infringements that occurred during the period of misuse.²⁶ Because no copyright rights existed during that period, no copyright wrongs—i.e., infringements—could have occurred. The sole exception to that view appears in a trial court's dictum summarily claiming that copyright misuse tolls not rights but only remedies. Under that idiosyncratic view, copyright owners might, after ending their misuses, recover even for infringements that allegedly occurred during the period of misuse.²⁷

Under the majority view, copyright misuse functions only as a defense.²⁸ It does not create standing to sue and win judicial relief.²⁹ Even in what evidently marks the sole case where a court has recognized copyright misuse as an affirmative claim for relief, rather than merely as a defense to copyright

²³ See NIMMER ON COPYRIGHT, *supra* note 15, § 13.09[A][2][b], at 13-299 ("Included [in the scope of the copyright misuse defense] could be contracts that eliminate the fair use or first sale defenses." (footnotes omitted)); Loren, *supra* note 10, at 516-19 (discussing recent trend toward expanding the misuse doctrine to protect public policy concerns).

²⁴ See *Lasercomb*, 911 F.2d at 979 n.22 ("Lasercomb is free to bring a suit for infringement once it has purged itself of the misuse.").

²⁵ See DONALD S. CHISUM, 6 CHISUM ON PATENTS § 19.04[4], 19-537-38 (2000 & Supp. 2005) (reading Supreme Court case law "to assume that a patent owner could not, even after complete [sic] abandonment and dissipation, recover monetary relief for infringing acts occurring prior to such dissipation"); James B. Kobak, Jr., *The Misuse Defense and Intellectual Property Litigation*, 1 B.U. J. SCI. & TECH. L. 25, ¶ 21 (1995) ("When misuse is purged, damages or royalties can be recovered only for the period post-purge.").

²⁶ See Jonas, et al., *supra* note 5, at 189 (observing that patent law disallows recovery for infringements that occur during misuse and that "[p]resumably, the courts will apply a similar analysis to the copyright misuse doctrine").

²⁷ See *In re Napster, Inc. Copyright Litig.*, 191 F. Supp. 2d 1087, 1108 (N.D. Cal. 2002) ("The doctrine does not prevent plaintiffs from ultimately recovering for acts of infringement that occur during the period of misuse."). The court evidently read too much into the precedents it quoted, which, while stating that no remedies should be afforded during misuse, did not say that rights should be retroactively enforced.

²⁸ GLICK, ET AL., *supra* note 5, at 303 ("[M]isuse is generally limited to use as a defense, not an affirmative claim of relief").

²⁹ See *Altera Corp. v. Clear Logic, Inc.*, 424 F.3d 1079, 1090 (9th Cir. 2005) (observing that "it makes little sense to allow Clear Logic to proceed on an independent claim for copyright misuse when there has been no allegation of copyright infringement"); *Ass'n of Am. Med. Colls. v. Princeton Review, Inc.*, 332 F. Supp. 2d 11, 17-20 (D.D.C. 2004) (dismissing affirmative claim of copyright misuse); *Novell, Inc. v. CPU Distrib., Inc.*, No. H-97-2326, 2000 U.S. Dist. LEXIS 9952, at *15-16 (S.D. Tex. May 15, 2000) (granting summary judgment against misuse claim on grounds that "[t]he Fifth Circuit has not . . . recognized copyright misuse as an independent claim for affirmative relief.).

infringement, the plaintiff sought only declaratory judgment and complained of practices that also violated antitrust law.³⁰

A party need not suffer directly from misuse to wield it as a defense to copyright infringement. Instead, it suffices to prove that a copyright owner engages in misuse somewhere and that the misuse affects someone.³¹ Thus, for instance, a defendant might enjoy the defense because the plaintiff's licensing agreements with third parties unduly restrict the third parties' rights.³²

Courts have not decisively resolved whether a party with unclean hands can benefit from copyright misuse.³³ The *Lasercomb* court, which largely pioneered the modern approach to copyright misuse, allowed the defendants the benefit of the doctrine, even as it affirmed that they had committed fraud.³⁴ The court in *Atari Games Corp. v. Nintendo of America Inc.*, in contrast, found that the defendants' unclean hands barred them from invoking misuse.³⁵ Arguing that the *Atari* court had misread the relevant precedents, the court in *Alcatel USA, Inc. v. DGI Technologies, Inc.*, held that the trial court had wrongly denied the defendant the misuse defense, even though the defendant had "very dirty mitts."³⁶ In sum, although it seems safest to say that copyright misuse can shield even a party with unclean hands, the issue remains unsettled and, in most jurisdictions, unaddressed.

Copyright misuse provides a defense against only copyright infringement claims; it offers no defense to a contract or other common law cause of action.³⁷ Courts have thus let misuse bar enforcement of copyright rights while leaving contract and other rights unaffected.³⁸ Still other courts have suspended plaintiffs'

³⁰ *Elec. Data Sys. Corp. v. Computer Assocs. Int'l, Inc.*, 802 F. Supp. 1463, 1466 (N.D. Tex. 1992).

³¹ *See Video Pipeline, Inc. v. Buena Vista Home Entm't, Inc.*, 342 F.3d 191, 204 (3d Cir. 2003) ("To defend on misuse grounds, the alleged infringer need not be subject to the purported misuse.").

³² *See Lasercomb Am. Inc. v. Reynolds*, 911 F.2d 970, 979 (4th Cir. 1990) ("[T]he fact that appellants here were not parties to one of Lasercomb's standard license agreements is inapposite to their copyright misuse defense. The question is whether Lasercomb is using its copyright in a manner contrary to public policy . . .").

³³ *See GLICK, ET AL.*, *supra* note 5 at 302-03.

³⁴ *Lasercomb*, 911 F.2d at 980.

³⁵ 975 F.2d 832, 846 (Fed. Cir. 1992).

³⁶ 166 F.3d 772, 794 (5th Cir. 1999).

³⁷ *See Altera Corp. v. Clear Logic, Inc.*, 424 F.3d 1079, 1090 (9th Cir. 2005) ("Copyright misuse is not a defense to the state law claims [i.e., intentionally inducing Altera's customers to breach their software license agreements with Altera and intentionally interfering with those contractual relations] asserted by Altera."); *Davidson & Assocs. v. Internet Gateway*, 334 F. Supp. 2d 1164, 1182-83 (E.D. Mo. 2004) (declining to afford copyright misuse defense in part because "the Court is reluctant to apply the copyright misuse defense as a defense to a contract claim because the defense is normally used in copyright infringement actions and the copyright claim has been dismissed in this case.").

³⁸ *See, e.g., PRC Realty Sys., Inc. v. Nat'l Ass'n of Realtors*, Nos. 91-1125, 91-1143, 1992 U.S. App. LEXIS 18017, at *38 (4th Cir. Aug. 4, 1992) (affirming damages for

copyright rights in light of misuse without speaking to—and thus evidently without disallowing—plaintiffs’ common law rights.³⁹ Although commentators⁴⁰ have generally overlooked this interesting, but admittedly obscure, feature of copyright misuse,⁴¹ it plays a significant role in the policy goals pursued by proposed § 107(b).⁴²

III. A LEGISLATIVE HISTORY OF § 107(b)

Section 107(b) codifies copyright’s misuse doctrine. Hitherto, courts have justified the copyright misuse doctrine by drawing comparisons to patent law, which has long had a codified misuse defense⁴³ and by invoking general principles of equity.⁴⁴ Section 107(b) brings the Copyright Act up to speed with the Patent Act, codifying the copyright misuse defense, clarifying its scope, and defining its effect.

Section 107(b) operates stepwise, through three sentences. The first sentence specifies when copyright misuse might occur. The second sentence describes the legal effect of the defense. The third sentence limits the scope of the doctrine. Taken as a whole, §107(b) aims to ensure that, instead of combining copyright and contract law to limit fair use, copyright owners choose either the rights afforded under the Copyright Act or those afforded by contract law.

breach of contract while reversing, on grounds of misuse, remedies for copyright infringement); *Tamburo v. Calvin*, No. 94-C-5206, 1995 U.S. Dist. LEXIS 3399, at *15–19 (N.D. Ill. Mar. 17, 1995) (granting motion to dismiss copyright infringement claim on grounds of misuse, but granting leave to amend contract and other claims).

³⁹ See, e.g., *Alcatel*, 166 F.3d at 792–94 (neglecting to rule on enforceability of contract); *Practice Mgmt. Info. Corp. v. Am. Med. Ass’n*, 121 F.3d 516, 520–21 (9th Cir. 1997) (allowing misuse defense without addressing viability of copyright holder’s other potential common law claims); *Lasercomb*, 911 F.2d at 979 (holding same).

⁴⁰ See, e.g., Judge, *supra* note 10, at 947 (claiming that under the approach adopted by all courts except *Napster* “during the period of misuse, the property right is replaced with a zero-liability right . . . [and] infringement is costless to the infringer”).

⁴¹ But see Bell, *infra* note 64, at 800 (observing that “courts finding copyright misuse . . . suspend enforcement of the copyright in question unless and until the misuse ends, while leaving coincident common law rights standing.” (footnotes omitted)); Knight, *supra* note 10, at 250 (observing that “under breach of contract . . . the copyright misuse defense is mute”).

⁴² See *infra* notes 61–64 and accompanying text (describing § 107(b)’s goal of denying copyright rights to overreaching copyright owners while leaving common law rights in force).

⁴³ See 35 U.S.C. § 271(d) (2006).

⁴⁴ See *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303, 311 (2d Cir. 1966) (Lumbard, C.J., concurring).

A. *Sentence One*: “It constitutes copyright misuse to contractually limit any use of a copyrighted work if that use would qualify as noninfringing under § 107(a).”

This sentence aims to ensure that copyright and contract law do not combine to vest copyright owners with too much legal clout. Effectively, it forces a copyright owner to choose between enforcing copyright rights no further than the bounds of fair use, as defined in § 107(a), and enforcing non-copyright claims as far as non-copyright law allows. By specifying that contractual limits on fair use qualify as copyright misuse, § 107(b) rationalizes the case law, capturing not the holding of just one particular court, but rather the logic and spirit of manifold judicial and academic opinions.⁴⁵

Notably, the first sentence of § 107(b) specifies only one particular way in which copyright misuse might arise. It does not foreclose a court from justifying the defense on other grounds.⁴⁶ A defendant facing a copyright infringement suit might, for instance, fruitfully allege that the plaintiff’s antitrust violations support a finding of copyright misuse. Just as it has since the origins of copyright misuse, patent misuse might thereby continue to serve as persuasive authority.⁴⁷

The first sentence of § 107(b) thus aims only to clarify a particular, and particularly uncertain, form of copyright misuse. It does not foreclose the invocation of other, more clearly established grounds for finding copyright misuse. Nor does it foreclose courts from exercising their equitable discretion to remedy egregious, but novel, forms of copyright misuse. In that, § 107(b) adopts an open texture akin to that of § 107(a).⁴⁸

B. *Sentence Two*: “No copyright owner misusing a work has rights to it under § 106 or § 106A during that misuse.”

This sentence codifies the practice, evidently followed in copyright misuse cases, of suspending copyright rights in a work during the work’s misuse.⁴⁹ As a matter of simple logic, remedies cannot be justified if rights are not violated. Even copyright owners who end their misuses should therefore not retroactively win copyright remedies for any alleged infringements that occurred during the period of misuse. In that regard, as in so many others, copyright misuse follows the path laid by patent misuse.⁵⁰

⁴⁵ See *supra* notes 20–23 and accompanying text (discussing scope of copyright misuse).

⁴⁶ See *supra* notes 17–22 and accompanying text (describing other grounds on which courts have found copyright misuse).

⁴⁷ See GOLDSTEIN, *supra* note 2, § 11.6, 11:38.

⁴⁸ See 17 U.S.C. § 107(a) (specifying that fair use includes certain enumerated uses and that determinations of fair use shall include certain enumerated factors, without precluding courts from protecting other uses or considering other factors).

⁴⁹ See *supra* notes 28–32 and accompanying text (describing legal effect of misuse defense).

⁵⁰ See GOLDSTEIN, *supra* note 2, § 11.6, 11:38.

Only a dictum of the *In re Napster*⁵¹ court offers a judicial exception to that view. The court opined that when and if the plaintiffs had cured their misuse, they might win copyright remedies retroactively—even for infringements that occurred during the period of misuse.⁵² Since it did not rule out awarding interest on any monetary relief thereby delayed, the *In re Napster* court’s approach to copyright misuse threatens to gut the doctrine. Such a lenient an approach to misuse would give copyright owners little reason to fear the misuse defense.⁵³ The second sentence of § 107(b), because it suspends copyright *rights* rather than only *remedies*, rejects that suspect dictum from *In re Napster*.

Sentence Two also impliedly follows the majority view that misuse merely tolls copyright rights; it does not permanently destroy them. Courts and commentators have opined that a copyright owner facing a valid misuse defense may, by no longer misusing the subject work, regain copyright rights in it.⁵⁴ This approach conforms to the theory, implicit in the case law, that the doctrine of misuse aims not to punish overreaching copyright owners but rather merely to deny them overweening legal powers.

Section 107(b) seeks to guard constitutionally protected freedoms of expression from the state power afforded to copyright owners.⁵⁵ The fair use defense has traditionally helped to ensure that the Copyright Act does not contradict the First Amendment.⁵⁶ A license that prohibits commentary about copyright-protected work would, however, threaten to overwhelm that bulwark of liberty. Section 107(b) fortifies fair use, safeguarding the defense—and thus our freedoms of expression—from an unseemly combination of copyright and contract rights.⁵⁷

Sentence Two goes beyond, but not against, the case law in clarifying that the copyright misuse defense bars not only the rights set forth in § 106 of the

⁵¹ *In re Napster, Inc. Copyright Litig.*, 191 F. Supp. 2d 1087 (N.D. Cal. 2002).

⁵² *Id.* at 1108.

⁵³ *But see* Judge, *supra* note 10, at 948–49 (arguing that even under the *In re Napster* court’s approach, “[a] variety of factors . . . reduce the estimated cost to a consumer of using the misused copyright” and that it “represents a significant shift away from patent misuse and toward a remedy better suited to effectuate the purpose of copyright misuse”).

⁵⁴ *See supra* note 24–27 and accompanying text (describing purge of misuse defense).

⁵⁵ U.S. CONST. amend. I (“Congress shall make no law . . . abridging the freedom of speech, or of the press . . .”).

⁵⁶ *See Eldred v. Ashcroft*, 537 U. S. 186, 219 (2003) (including fair use among copyright law’s “built-in First Amendment accommodations”).

⁵⁷ Courts should thus not read § 107(b) to excuse copyright licensees who, citing the fair use defense, complain about making standard and reasonable payments for licensed uses of a copyright protected work. The ease of paying for permission in such cases typically goes to show that no fair use defense applies. *See, e.g., Am. Geophysical Union v. Texaco, Inc.*, 60 F.3d 913, 930–31 (2d Cir. 1994) (“[T]he right to seek payment for a particular use tends to become legally cognizable under the fourth fair use factor when the means for paying for such a use is made easier.”).

Copyright Act but also those set forth in § 106A.⁵⁸ Why that extension? Not because anyone who enjoys the relatively limited rights afforded by § 106A poses a particularly great risk of misusing them but only because no compelling reason suggests that such parties, when and if they misuse their copyright rights,⁵⁹ should escape the scope of the defense.⁶⁰

C. Sentence Three: "A court may, however, remedy breach of any contract the limitations of which constitute copyright misuse under this section."

Copyright owners risk combining their statutory and common law rights to seize an unwarranted amount of legal power. In such instances, misuse doctrine operates to reestablish a rough balance between private and public interests. It empowers courts to deny copyright rights to overreaching copyright owners, while leaving common law rights in force. Misuse doctrine thus helps ensure that copyright law conforms to its constitutional mandate: "To promote the Progress of Science and useful Arts."⁶¹

The third sentence of § 107(b) codifies what courts have already held: Copyright misuse serves as a defense against only copyright claims—not claims arising under common law in general or contract law in particular.⁶² That is not to say that a copyright owner facing a valid misuse defense will prevail on those alternative causes of action, of course; they may fall to defenses other than copyright misuse.⁶³ It is only to say that a contract that facilitates copyright misuse may not, for that reason alone, suffer invalidation.

That careful respect for common law rights reflects a fundamental aspect of copyright policy. The prevailing view of copyright casts it as a necessary evil,

⁵⁸ Section 106A(a) gives "the owner of a work of visual art" the right to "claim authorship of that work," § 106A(a)(1)(A), disavow misattributions of authorship, § 106A(a)(1)(B), disavow authorship to his or her works that have suffered modifications that "would be prejudicial to his or her honor or reputation," § 106A(a)(2), and to protect his or her works from specified sorts of harm, § 106A(a)(3).

⁵⁹ Notably, a party can enjoy § 106A rights.

⁶⁰ Similar reasons suggest that lawmakers might find it worthwhile to consider also expanding the defense to bar misuses of the rights that the Digital Millennium Copyright Act created to protect copyright protection systems, 17 U.S.C. § 1201, and copyright management information, 17 U.S.C. § 1202. For an argument on behalf of that sort of extension, see Dan L. Burk, *Anticircumvention Abuse*, 50 UCLA L. REV. 1095 (2004). For a case suggesting that judges, at least, have hesitated to take up that call, see *321 Studios v. Metro Goldwyn Mayer Studios, Inc.*, 307 F. Supp. 2d 1085, 1101–03 (N.D. Cal. 2004) (holding that misuse defense does not apply to anticircumvention provisions of Digital Millennium Copyright Act, 17 U.S.C. § 1201).

⁶¹ U.S. CONST. art. I, § 8, cl. 8.

⁶² See *supra* notes 37–38 and accompanying text (documenting that copyright misuse provides a defense against only copyright infringement).

⁶³ Sentence Three thus says only that a court *may* remedy breach of contract.

justified as a response to the market's underproduction of expressive works.⁶⁴ In a better world, we would not need copyright law. To the extent that copyright policy can help bring about that sort of world, therefore, it achieves a salient good.

By forcing copyright owners who misuse their works to choose between their statutory rights and their common law ones, § 107(b) would encourage the development of new ways of protecting expressive works. To the extent that such alternatives would cure the market failure that justifies copyright, they would render copyright superfluous. Thus, might copyright *misuse* promote the worthy policy of eventually ending copyright *use*.

IV. SECTION 107(b) IN PRACTICE

Could the codification of copyright misuse proposed here survive the legislative process and pass into law? Possibly. As noted earlier,⁶⁵ the doctrine of copyright misuse stands at a point in its development akin to that achieved by the fair use doctrine just before its codification.⁶⁶ That merely suggests copyright misuse may have grown ripe for codification, however; it hardly compels that result. To assess the prospects for § 107(b), we need to take account of the various factions that might lobby for or against it.

Though hardly a politically powerful faction, the various parties who generally favor opening wider access to copyrighted works—consumers, educators, librarians, students, and others—would almost certainly find much to like in § 107(b). The proposed statute would, after all, clarify and universalize what courts have already said: Copyright owners must not leverage their rights under the Act to commit wrongs against the public. In particular, § 107(b) would, by classifying contractual limitations on fair use rights as copyright misuse, clearly safeguard a vital mechanism for ensuring that copyright law does not infringe on our freedoms of expression.

A much more powerful lobby, including representatives of the entertainment and software industries, generally disfavors weakening copyright protection. Even those parties, however, might find much to like in § 107(b). First, the proposed codification misuse would clarify a troublingly vague area of law, making the rights protected by the Copyright Act more certain and, thus, more valuable. Second, copyright owners wary of § 107(b) could easily safeguard their statutory rights by adding to their licenses appropriate saving clauses, avoiding the misuse defense by clarifying that the licenses do not limit any rights protected by

⁶⁴ See, e.g., Tom W. Bell, *Escape from Copyright: Market Success vs. Statutory Failure in the Protection of Expressive Works*, 69 U. CIN. L. REV. 741, 758 (2001) (“Courts and commentators agree that copyright law represents a statutory response to market failure.”).

⁶⁵ See *supra* 5–9 and accompanying text (discussing timeliness of codification of misuse).

⁶⁶ See 17 U.S.C. § 107 (2006) (codifying the fair use defense).

§ 107(a).⁶⁷ Third, § 107(b) would reassure copyright owners that, even if they offended its definition of misuse, they might still enforce their rights under contract law.

How would § 107(b) work in practice? Suppose that ThinSkin offers downloads of its copyrighted software, Bugfest, subject to payment of \$20 and agreement to a click-through license. Among other terms, that license bars public criticism of Bugfest. Snarky buys a copy of the Bugfest, clicks “OK” to the license, and thereafter blogs about the software’s many flaws. Snarky’s critique includes screenshots of Bugfest in action (as the case may be). ThinSkin sues Snarky citing unauthorized reproduction of expressions protected by Bugfest’s copyright⁶⁸ and violation of the software’s license.

Though § 107(b) would plainly give Snarky a misuse defense to ThinSkin’s copyright infringement claim,⁶⁹ ThinSkin would retain the right to sue Snarky for breach of contract. Snarky might attempt to void the contract for want of consideration arguing that ThinSkin’s misuse meant that it had no copyright rights to license.⁷⁰ ThinSkin would doubtless overcome that defense, however, by observing that it forbore from refusing to allow Snarky to download a copy of Bugfest.⁷¹ While denied the generous monetary and near-automatic injunctive relief afforded by the Copyright Act,⁷² ThinSkin would enjoy a good chance of winning contract damages⁷³—perhaps even liquidated damages, if the contract specifies them⁷⁴—and a fair argument for an injunction against breach.⁷⁵

In the long run, § 107(b) would encourage copyright owners like ThinSkin to develop new ways of protecting expressive works. In some cases, after all, § 107(b) would flatly rule out reliance on copyright rights. It would, however, reassure copyright owners that they might still invoke contract law to good effect. Like a mother bird nudging her fledglings to the nest’s edge, § 107(b) would

⁶⁷ Assuming it finds such a clause enforceable, a court should take that clause to provide an effective counterargument to any defense asserted under § 107(b).

⁶⁸ See 17 U.S.C. § 106(1) (giving the owner of a copyright the exclusive right to reproduce it).

⁶⁹ Indeed, it would give *anyone* a defense to *any* copyright claim to BugFest brought by its copyright owner ThinSkin.

⁷⁰ See RESTATEMENT (SECOND) OF CONTRACTS § 17(1) (1979) (requiring consideration for formation of a contract).

⁷¹ See *id.* § 71(3) (explaining that consideration may consist of a forbearance).

⁷² See 17 U.S.C. §§ 502–505; see also *id.* § 506 (providing for criminal penalties against copyright infringement); *id.* § 509 (providing for seizure and forfeiture of illegal copies and copying equipment).

⁷³ See RESTATEMENT (SECOND) OF CONTRACTS §§ 344–56 (1979) (specifying a variety of rules for awarding monetary relief for breach of contract).

⁷⁴ See *id.* § 356 (specifying when party breaching a contract may owe liquidated damages).

⁷⁵ See *id.* § 359 (defining when courts should award injunctive relief for breach of contract).

embolden copyright owners to escape the confines of the Copyright Act, promoting the public good even as they promote their own interests.⁷⁶

V. CONCLUSION

This Article has described and defended a codification of copyright's misuse doctrine. The § 107(b) proposed here largely follows the case law in defining the scope and effect of the defense. In specifying that certain contractual restrictions constitute misuse, § 107(b) also pursues a policy of ensuring that fair use continues to protect our freedoms of expression. If thus codified, the misuse defense would promote the public good by making copyright rights less vague, less threatening, and ultimately less important.

⁷⁶ See Bell, *supra* note 64, at 804–05 (explaining the public policy benefits of developing extra-copyright protections of expressive works).

METHOD AND MADNESS IN COPYRIGHT LAW

Dan L. Burk*

I. INTRODUCTION

Copyright law is a source of nearly endless scholarly fascination because of the paradoxes, the absurdities, the contradictions in its doctrines. Lewis Carroll's *White Queen* had nothing on copyright law.¹ Copyright asks us to accept far more than six impossible, almost nonsensical assertions as part of its standard doctrine. Copyright asks us to believe, for example, that creative works have an existence independent of their embodiment;² that corporations, rather than people, can author documents;³ that computer code is a literary work, like poetry or novels;⁴ that artists have a special propensity to bungle their business affairs.⁵ The list seems nearly endless.

Perhaps we do not have to believe all of copyright's impossibilities before breakfast. But those of us who deal with copyright have to believe them, or at least pretend to accept them, all day long, day in and day out. As the Queen pointed out to Alice, believing impossible things takes practice.⁶ With enough practice, the impossible becomes commonplace. When that happens, when we stop seeing the impossibility in the impossible, we seldom stop to question, or at least marvel, over the exceptional ideas that we have come to accept. And when this happens in copyright, we overlook or ignore some truly startling assumptions that are foundational to the copyright system.

In this essay, I want to exercise the scholarly prerogative to examine one of those unexamined assumptions that lies at the center of a cluster of fundamental copyright doctrines. My subject is implicit in the way that copyright treats methods or processes, and we shall see that copyright has very special rules regarding methods or processes. Every student of copyright knows about these special rules, but the logic behind the rules, and the implications of that logic, have gone largely unexamined. I will look, hopefully with a fresh eye, at the assumptions about causality in copyright's treatment of methods, systems, and processes. I shall do so through the lens of a relatively recent series of cases dealing with copyright in

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¹ See LEWIS CARROLL, *Through the Looking-Glass and What Alice Found There*, in THE ANNOTATED ALICE 167, 251 (Martin Gardner ed., 1960).

² 17 U.S.C. §§ 101, 202 (2006).

³ 17 U.S.C. § 201(b).

⁴ H.R. REP. NO. 94-1476, at 54 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5667.

⁵ See *Stewart v. Abend*, 495 U.S. 207, 207 (1990).

⁶ See CARROLL, *supra* note 1, at 251.

valuation estimates, which ultimately implicate the methods for generating those valuations. I shall show that the copyright system incorporates a rather surprising set of notions regarding determinism and causality, and those concepts then play out in rather unexpected ways in a variety of related doctrines.

Now, we have not even gotten started and I have already invoked some rather formidable language, words like determinism and causality, which carry with them many centuries of philosophical baggage. We want to see what they are doing in the law of copyright, but in a relatively short essay we have neither the time nor the patience to unpack all of their baggage. Such a project could quickly spiral off into a discussion over the existence of free will and the implications of Laplace's demon.⁷ I hope to skirt that metaphysical abyss and concentrate instead on how they inform the structure of the copyright statute. We will be considering copyright's treatment of method, and you may initially get the sense that there is some madness to my method. But I believe you will see by the end that this is primarily due to a good deal of madness *about* methods in the law of copyright. And perhaps you will catch a glimpse of the impossible assumptions lurking beneath the surface of some copyright doctrines that we usually take for granted.

II. SOME FOUNDATIONAL DOCTRINES

We begin, as we so often do in copyright, with the Supreme Court decision in *Baker v. Selden*, one of the two or three pivotal decisions in American copyright law.⁸ *Baker*, you recall, involved the copying of printed forms that were intended to facilitate a method of accounting; the developer of the methods and of the forms, unsuccessfully asserted copyright in the forms.⁹ *Baker* is an iconic case for American copyright because it is situated at the intersection, at the crossroads if you will, of at least three, and perhaps four, key doctrines that are foundational to copyright, and which interact in a complex fashion that we will need to disentangle here. This doctrinal intersection is no accident, because these doctrines are closely intertwined and the facts of *Baker* present the limiting case.

The first of these doctrines is perhaps the most famous, although it is by no means certain that it should be, as it is not clear that it is in fact central to the holding of *Baker*.¹⁰ This is the idea/expression distinction, which perhaps surprisingly will concern us very little here. The idea/expression distinction is the first of several copyright doctrines that ensure copyright covers only expression, and we shall be chiefly concerned with some of the others rather than with this one. But this particular doctrine mandates that in copyright law, generalized ideas

⁷ "Laplace's demon" is a hypothetical entity capable of knowing the state of the universe at a given moment, and so of predicting the state of the universe in the next. See ROGER HAHN, PIERRE SIMON LAPLACE 1749–1827: A DETERMINED SCIENTIST 168 (2005).

⁸ 101 U.S. 99 (1879).

⁹ *Id.* at 99.

¹⁰ See Pamela Samuelson, *Why Copyright Law Excludes Systems and Processes From the Scope of Its Protection*, 85 TEX. L. REV. 1921, 1924–28 (2007) (critiquing this reading of the *Baker* opinion).

may be taken freely, and only particularized expression is protected by exclusive rights.¹¹ You may write a story and call it *Romeo and Juliet*, and someone else may tell the same story and call it *West Side Story*. The general idea of these stories may be the same, but so long as the particular expression of the idea originates independently, the works are entitled to separate copyright protection, and no infringement has occurred.

Of more interest to us is the corollary of the idea/expression distinction, the concept of merger. In circumstances where there is only one way, or a very small number of ways, to express an idea, we say that idea and expression have merged—that the expression is coterminous with the idea. In such cases, copyright will not cover the expression, because to do so would be tantamount to copyrighting the idea. Multiple, alternative expressions of the idea would not be available to other creators, so that imposing copyright on the merged expression would monopolize the idea. One way to read *Baker v. Selden* is as an instance of merger: that the accounting forms were the only way to express the idea of the accounting method, such that the idea and expression merged, rendering the forms unprotectable in copyright. We shall see that this is perhaps not the best reading of the case, but it remains a very prevalent reading nonetheless.¹²

The second, most banal, and perhaps least defensible of the *Baker* doctrines also need not long concern us here. This is the line of authority holding that business forms are, if not *per se* unoriginal, at least universally suspect for copyright protection.¹³ A rule that forms are *per se* unprotectable is something of an oversimplification, and indeed a distortion, of the holding in *Baker*. The case does not stand for the proposition that forms are *per se* unoriginal, and certainly one can imagine original, expressive forms that could qualify for copyright. The conclusion that forms are *per se* unprotected may be the result of bad induction, as it confuses the particular with the general. The forms at issue in *Baker v. Selden* in fact *were* unoriginal and unexpressive, and the outcome in that case was surely correct from the application of the opinion's general principles to that specific instance. That need not mean that the outcome will be the same in every case involving forms.

Of course any copyright in original, expressive forms would be very “thin,” that is to say, very limited. Copyright protection for forms is thin, and often non-existent, not because forms as a genre are necessarily devoid of originality or of expression, but because any originality or expression is layered over a structure that is at its foundation functional. Forms are intended to collect and organize information, not to entertain or to edify in an aesthetic sense. Only the expressive portion of the form, if any, would be covered by copyright. The functional

¹¹ *Harper & Row Publishers, Inc. v. Nation Enters.* 471 U.S. 539, 556 (1985).

¹² See Pamela Samuelson, *The Story of Baker v. Selden: Sharpening the Distinction Between Authorship and Invention*, in *INTELLECTUAL PROPERTY STORIES* 159, 177 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss, eds., 2006).

¹³ See, e.g., *Bibbero Sys. Inc. v. Colwell Sys. Inc.*, 893 F.2d 1104, 1106–07 (9th Cir. 1990); see also 37 C.F.R. § 202.1(c) (2007) (Copyright Office rule precluding copyright registration of blank forms).

structure of the form lies outside of copyright, available for appropriation, and in most cases, it would be a trivial exercise to strip off the veneer of protected expression so as only to take the unprotected framework of the form.

So the bias against copyright protection for forms in fact derives from a third line of authority that springs from *Baker*, and this doctrine demands rather more of our attention. This line of cases deals with the principle of functionality. Copyright covers expressive works, and not functional or utilitarian works. We must be somewhat cautious with this terminology, because all copyrightable subject matter has a use, a utility, or in a very broad sense performs a function.¹⁴ Novels and paintings and poetry are useful to entertain and enlighten their audience, they perform a communicative function of telling the audience something about the author, and the world, and if the art or literature is good art or literature, it ought to tell the audience something about themselves. But utility in copyright is not concerned with such informational or aesthetic “uses;” rather it is practical or operational “uses” that are excluded from the copyright protection.

A particularized version of this principle appears in the copyright statute, as the “useful article” doctrine under section 101 of the statute.¹⁵ That definition of useful article addresses the subject matter category of pictorial, graphic, and sculptural works; the statute states that when such a work entails both aesthetic and functional features, then only the expressive features that are physically or conceptually separable from the functional features will be protected under copyright.¹⁶ If the functional features are not separable from the expressive features, then the whole work is deemed functional, and so unprotectable in copyright. The statute further defines a useful article as one having a utilitarian purpose other than to convey information or to portray itself.¹⁷ That language is intended to deal with the definitional problem that we have already identified: paintings and sculptures have a use, but the function is to convey information or to portray themselves. They are not useful in the functional sense that we have been considering.

The “useful article” section of the statute contemplates a particular instance of functionality, involving the category of pictorial, graphic, and sculptural works. But the *Baker* opinion articulates a more general version of that principle, beyond the category of pictorial, graphic, and sculptural works. It says that items that perform functions or have uses other than expression belong in the patent system, not the copyright system.¹⁸ And that of course is where the Supreme Court in *Baker* told Selden he ought to go with his accounting method, to the Patent Office, although ironically the Patent Office at that time was unlikely to grant a patent on a

¹⁴ See Dennis S. Karjala, *A Coherent Theory for the Copyright Protection of Computer Software and Recent Judicial Interpretations*, 66 U. CIN. L. REV. 53, 57–58 (1997) (distinguishing “useful” works from “functional” works).

¹⁵ 17 U.S.C. § 101 (2006).

¹⁶ *Id.*

¹⁷ *Id.*

¹⁸ *Baker v. Seldon*, 101 U.S. 99, 102 (1879).

business method because of the view that such methods failed some of the other criteria for patentability.¹⁹

It is important to note that the useful article portions of the statute also signal a type of merger rule for functionality. The rule that functional and expressive features must be physically or conceptually separable in order for the latter to receive any copyright protection parallels the merger rule in the idea/expression doctrine. If function and expression are merged, if they are not physically or conceptually separable, then the entire work is excluded from copyright. This points to another and important way to read *Baker*: that whatever expression there may have been in the accounting forms, it was merged with their function, and so off-limits to copyright. This may indeed be the best way to read *Baker v. Selden*. It might be said that because the accounting forms were the only way to express the accounting system, that idea and expression had merged. But it might better be said that because the accounting forms were the only method of performing the accounting method, expression and function had merged.

Indeed, one implication of *Baker* is that we can often recognize functionality by the criterion of merger; by constraint upon methodology. We assume that there are multiple, perhaps nearly infinite ways of expressing the ideas in art, music, or poetry. But when there is only one way, or a limited number of ways, to achieve a certain result, then it is likely we are no longer talking about something that is expressive, but are talking about something that is utilitarian or functional. Trademark law, which also excludes utilitarian features of a mark from protection, has a similar rule for recognizing utility for functionality.²⁰ The constraint on alternatives signals the presence of functionality.

In a case such as *Baker*, where the forms were the only way to practice the accounting method, the constraint on alternatives is a point of convergence with the idea/expression doctrines, but may not always be so. For example, in the *Lotus v. Borland* case, where Lotus had copied computer menu commands from Borland's user interface, the court concluded that there had not been idea/expression merger, but there had been functionality merger.²¹ The court noted that there were many possible substitutes or alternatives for the "copy" command in the command menu: Lotus could have changed the command to "replicate" or "duplicate" or something of the sort.²² So there were other possible modes of expression. But as a practical matter, there was only one viable, functional way of indicating this command, which was to use the standard command that users would recognize. Having learned one command structure, users would become confused or would incur the personal expense of relearning new commands each time they tried to change products. The benefits of standardization created a functional merger, if not an expressive merger.

¹⁹ See Dan L. Burk, *Patenting Speech*, 79 TEX. L. REV. 99, 142 (2000).

²⁰ See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1337 (C.C.P.A. 1982).

²¹ 49 F.3d 807, 815 (1st Cir. 1995), *aff'd by an equally divided Court*, 516 U.S. 233 (1996).

²² *Id.* at 811.

Even though this functionality analysis is integral to the *Borland* decision, and even though the *Borland* decision relied very explicitly on the *Baker* decision, it does not rely on *Baker* for quite this proposition in quite this way. *Lotus v. Borland* brings us to the fourth, and final stream of copyright doctrine that flows from *Baker v. Selden*, which is also found in the title of this article. And that is the doctrine regarding processes and methods of operation. The *Borland* court held that the user interface commands, whether expressive or not, were the embodiment of a method or process for operating the computer.²³ The court compared the interface commands, quite rightly, to the accounting forms in *Baker*, which were the embodiment of an accounting process.²⁴ The forms were themselves the method. And the copyright statute explicitly excludes processes and methods of operation from the protection of copyright.

Now you may notice two corollaries of this holding, neither of which should be surprising given what we have said so far. The first is that we are again talking about a sort of merger doctrine.²⁵ The menu commands in *Borland* may have been expressive, or at least they were the result of choosing or selecting among different possibilities for the user interface. We shall say more about that in a moment. The accounting forms in *Baker* were really not expressive, as they were rather bare bones, but they could have been. Yet in neither case were the commands or the forms protectable, because protecting them would have been tantamount to protecting the method or process that they embodied. This is the rationale of merger. If the expressive part of a work can be separated from the method, or from the function, or from the idea, then copyright can cover the expression separately. But if the expression cannot be separated or disentangled from the method, or from the function, or from the idea, then the expression has no place in copyright.

The second corollary you may notice is that the prohibition on copyright for methods and processes is intimately bound up with the prohibition on copyright for functional or useful articles. Processes are by definition functional, they *are* functions. Creative works may be the products of processes, they may be the output. Or they may be the input into processes. Such inputs and outputs may be expressive or they may be utilitarian, and the relationship between functional processes and their non-functional products is troublesome. If you recall the definition of a useful article, you will recall that it excludes works that convey information or portray themselves.²⁶ And as you can see those are characteristics defined by processes—conveying, portraying—so there is the question of what to do with processes that communicate information or portray expression. This is a bit of a problem, and we shall say more about that in just a moment as well.

But for the moment it may be best to recognize the relationship between process and functionality in the terms set out by the *Baker* decision. Recall that

²³ *Id.* at 815.

²⁴ *Id.* at 816–17.

²⁵ See Alan L. Durham, *Speaking of the World: Fact, Opinion, and the Originality Standard in Copyright*, 33 ARIZ. ST. L.J. 791, 807–08 (2001).

²⁶ 17 U.S.C. § 101 (2006).

Baker stands for the proposition that functional subject matter belongs in the patent system, and not in the copyright system. It also stands for the proposition that processes and methods belong in the patent system and not in the copyright system. Just as the copyright statute explicitly excludes processes and methods from its subject matter, so the patent statute explicitly *includes* processes and methods within its subject matter. Processes have their home in the patent statute, with other utilitarian creations. The *Baker* opinion draws a clean line between patent and copyright, but we shall see that the line is perhaps less clean than it once was.

III. FACTS AND FICTIONS

We have now seen how the *Baker* decision and its progeny set the fundamental copyright doctrine on methods and processes, and that in turn sets the stage for us to think about the meaning of those doctrines in the copyright system. I said at the beginning that the objective of this essay is to look at certain assumptions embedded in the law of copyright, and that our entry point to that discussion is a set of very troubling opinions beginning with the Second Circuit decision in *CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.*²⁷ We want to examine how the *Baker* doctrines play out in some of these cases; we frankly want to see where these opinions have gone wrong. These opinions are like our treasure map; they mark the spot where the interesting concepts are buried. It is the anomalies in these opinions, the inconsistencies, that show us where to start digging.

In *CCC*, the allegedly infringed work was a compilation of used car valuations, the “Red Book,” which was useful for selling or purchasing used automobiles, and particularly useful for payment estimates by automobile insurance adjusters.²⁸ The accused infringer had extracted the valuations from the print version of the Red Book and provided them on-line as electronic reports.²⁹ When sued for infringement, the electronic service argued that the valuations were facts, statements about the prices that would be paid for various automobiles, calculated by taking into account relevant factors such as price variations by region, by condition of the automobile, by make and by model, and so on.³⁰ Since it is black letter law that only original expression, and not facts, is protected under copyright, that would mean that copying the valuations was not a taking of protected expression, so that copying the valuations was not infringement.

While this argument was accepted by the trial court, on appeal the Second Circuit held that the valuations constituted original expression.³¹ The appellate court reached this conclusion on the basis of the choices that had been made in

²⁷ 44 F.3d 61 (2d Cir. 1994).

²⁸ *Id.* at 63.

²⁹ *Id.* at 64.

³⁰ *Id.*

³¹ *Id.* at 67.

developing the valuation formula; for example, the choice to divide the nation into a certain number of geographic regions for valuation, or the choice to compare vehicles based on 5,000 mileage increments.³² According to the court, such selection among different possibilities meant that the values in the Red Book were not factual statements about the value of automobiles, or arithmetic derivations from available data, but were only a “loose judgment” about automobile values and were “approximate and original,” rather than “mechanical” or “historical.”³³ The values were the result of choices, and so were expressive, and so constituted the proper subject matter of copyright.

This holding is troubling, the more so because it is not an isolated instance; there have been several cases with a similar profile. For example, in *CDN, Inc. v. Kapes*, the defendant published on his Internet site values for rare coins, which were drawn in part from numismatic values published by the plaintiff.³⁴ As in the case of the CCC automobile valuations, the CDN coin valuations were arrived at by a process of combining and evaluating relevant pricing factors, such as the type, condition, and age of coins, the results of recent auctions and sales, and other movements in the market.³⁵ As in *CCC*, the defendant in *CDN* argued that no protected expression had been taken because the published values were *facts*.³⁶ The trial and appellate courts disagreed, relying upon *CCC* to conclude that the values were *judgments*, that they were the creative products of choices made by, the compilers of the valuations.³⁷ As with the automobile valuations, the coin values were found to constitute original expression, and so copying them constituted infringement.

But a bit of reflection reveals that these are quite disturbing results. First, it seems that the supposedly “original” aspects of the values for used cars or for coins were the kind of “choices” dictated by the desire for accuracy, for correspondence with fact. This seems clear from the nature of the product being sold: the compilation of values. If the values given in the compilation were truly original, truly idiosyncratic, then what use could they be to those who want to know the value of the used cars or rare coins they are buying and selling? Would the compilers of the valuation books really sell very many books if they represented that their valuations were based on creative guesswork, that they chose the geographic regions for their aesthetics, or that the values of the items listed were based on an artistic whim? Would the purchasers of such books care to rely on valuations that bear no relation to the prices and valuations that are actually the basis for exchange in the marketplace?

On the contrary, it seems obvious that the valuations are themselves valued for their accuracy, for their predictability, for their determinacy. The factors that

³² *Id.*

³³ *Id.*

³⁴ 197 F.3d 1256, 1257 (9th Cir. 1999).

³⁵ *Id.* at 1260.

³⁶ *Id.* at 1259.

³⁷ *Id.* at 1260–61.

went into the valuations were certainly chosen to yield the best possible prediction of market value. The entire point of the “Red Book” or of a numismatic catalog is that the valuations should reflect as closely as possible the actual state of the market for used cars or rare coins, so that the “choice” of valuation factors is dictated by circumstances beyond or outside the original expression of the compilers. This is always the case for factual works. The cartographer has the “choice” of depicting measuring distances in ells or furlongs, but such a map is unlikely to be useful or appealing to modern users—the cartographer will almost certainly use miles or kilometers. For that matter, the cartographer has the “choice” of depicting the world as flat, rather than spheroid but such a map depicts what we would understand to constitute fantasy rather than reality.³⁸ Such “choices” are illusory for the creators of works that are not flights of fancy, but intended to correspond with reality. Or in other words, the valuations of cars and coins, like the measurements and features on a map, were meant to be what we would understand to be *facts*.

Even if the valuations were estimates, or had some range of deviation or coefficient of error, this would not differentiate them from any other scientific measurement that yields a best approximation. The careful scientist recognizes the imperfections of measurement, and puts error bars on her graphs. Even through the background noise of unrelated but inseparable phenomena, or against the impediments of human and instrumental error, such measurements are intended to reflect something about the state of the world. And so, too, are the numbers valuing coins and used cars. The judgment that a spectrophotometer will yield better results than a scintillation counter, or that a 1969 Dodge Dart will likely sell for \$100 more south of the Mason-Dixon line than it will to the north, is not at all the same thing as the judgment that a fictional character like Sherlock Holmes will be depicted to play the violin rather than the bassoon.

It is worth noting at this point that copyright law treats expression that is represented as factual as being factual—the so-called copyright estoppel doctrine.³⁹ If you claim that your theory of history or cosmology is a fact, then you are stuck with that assertion,⁴⁰—which is to say, that you cannot protect that datum in copyright, because copyright covers original expression, not facts, and we take you at your word that your datum is factual. If it is a fact, it is not protected by copyright; if it is protected by copyright, then it can’t be a fact. You can’t have it both ways, and courts will hold you to your original representation.

Unless, perhaps, you are in the Second Circuit, where they have decided that some facts aren’t factual. In a feat of legal gymnastics intended to save

³⁸ See, e.g., TERRY PRATCHETT, *THE COLOUR OF MAGIC* (1983) (depicting “Discworld,” a fictional flat world).

³⁹ See Thomas F. Cotter, *Gutenberg’s Legacy: Copyright, Censorship, and Religious Pluralism*, 91 CAL. L. REV. 323, 345 (2003) (discussing copyright estoppel).

⁴⁰ See, e.g., *Urantia Found. v. Maaherra*, 114 F.3d 955, 958–59 (9th Cir. 1997) (text purportedly received from extraterrestrial beings unprotected by United States copyright); *Nash v. CBS, Inc.*, 899 F.2d 1537, 1541 (7th Cir. 1990) (historical theory unprotected by copyright).

compilations like the Red Book from an unavoidable idea/expression paradox,⁴¹ the Second Circuit held that what it calls “hard” or objective ideas may be subject to the idea/expression doctrine, but that “soft” or subjective ideas, infused with opinion, are not.⁴² And of course they found the Red Book automobile valuations to be “soft” opinionated ideas.⁴³ What the Second Circuit calls “hard” or objective ideas, we generally call facts. We should note first that this runs all the copyright exclusions from *Baker* together into one muddle: the process or method of producing the valuations is an “idea,” the functional valuations themselves are an “idea”—indeed everything this side of Plato’s cave⁴⁴ is an “idea.” And second, this maintains copyright in the CCC valuations by distinguishing them into a class of statements about the world that require judgment and creative selection—sort of subjective facts, if you will.

But this distinction proves far too much. The Second Circuit spoke more truly than it knew. Postmodernists would tell us, quite properly, that *all* facts involve judgment and creative selection. As the late Jacob Bronowski was so fond of pointing out, there really are no measurements, only judgments.⁴⁵ When you round the value of π off to 3.141592654, you have made a judgment that it is the first nine decimal places that matter, and that the rest don’t. When you look at stars through an optical telescope, you have made a judgment that it is the wavelengths of light between 400 and 700 nanometers that matter, and that the rest of the electromagnetic spectrum doesn’t—if you were to use a radio telescope to look at other wavelengths, you would get quite a different picture of the phenomenon you are observing. That is why science, fact-finding, is a creative endeavor, a human endeavor: because it requires judgments about what matters, which in turn require a model or viewpoint about the universe to inform those judgments, and the construction of such a model or viewpoint is quintessentially an act of creation.⁴⁶

This is a theme that I will return to a bit later. For now it is important to see that if we follow the logic of judgment too far, then there are no facts that lie outside the copyright system. Everything becomes expression, and every measurement is covered by copyright. That cannot be right. The corollary of course is that the copyright system has a very pronounced view about what constitutes a fact. The statute says that there is something called a fact, and that facts are not covered by copyright. Facts exist independently in the universe, waiting to be found or discovered. Copyright covers original expression, and

⁴¹ See Dan L. Burk, *Expression, Selection, Abstraction: Copyright’s Golden Braid*, 55 SYRACUSE L. REV. 593,594-95 (2005).

⁴² CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61, 71–73 (2d Cir. 1994).

⁴³ *Id.* at 73.

⁴⁴ See PLATO, THE REPUBLIC 220–25 (G.R.F. Ferrari ed., Tom Griffith trans., Cambridge University Press 2000).

⁴⁵ See JACOB BRONOWSKI, *The Abacus and the Rose: A New Dialogue on Two World Systems*, in SCIENCE AND HUMAN VALUES 77, 88–91 (Harper & Row rev. ed. 1965).

⁴⁶ JACOB BRONOWSKI, *The Creative Process*, in A SENSE OF THE FUTURE 6, 11 (1977).

whatever facts are, they are not original expression.⁴⁷ And the cases like *CCC* and *CDN* tell us that this is because facts do not involve judgments or choices, they do not originate in the decisions of an author. We know that on any sensible understanding of science this assertion is manifestly untrue, but we shall have to accept it for the moment.

However, you should see that the definition of fact as divorced from choice or judgment is not only manifestly untrue, it should also be decidedly familiar. It is the same criteria we have seen before in deciding what is to be excluded from copyright, in deciding what is original and expressive and what not. Recall what we have already said about the intersecting doctrines in *Baker v. Selden*. We know that idea and expression have merged, and have become unprotectable, when there is only one or a limited number of ways to express the idea. We know that function and expression have merged, and have become unprotectable, when there are utilitarian constraints on the available options to achieve the instantiation of the work. We know that expression and process have merged, and so become unprotectable, when the expression is dictated by function, as it was for Selden's accounting forms. So it should not surprise us if courts are defining another category of excluded subject matter—facts—in terms of the availability of alternative expression.

IV. THE PROBLEM OF PROCESS IN COPYRIGHT

To this point we have seen that cases such as *CCC* and *CDN* adopt the rather dubious view that the valuations found in automobile and numismatic catalogs are not facts, but are a form of creative expression. This conclusion in turn rests upon a particular view of facts embedded in the copyright system. When dealing with matters extrinsic to the author, with facts, copyright assumes that their expression is dictated by the state of the universe, and that there is not a large or infinite number of ways to express those concepts—or at least, not a large number of ways to express them accurately. This is why the copyright in factual compilations, such as maps, is “thin.”⁴⁸ There may be a considerable number of creative ways to depict a river or mountain on a map, changing the colors or choosing the symbols to mark the particular geographic feature. But when the mapmaker becomes sufficiently creative with the location of the features, with their relationships to one another, the map ceases to reflect the state of reality—we then have a map of some other reality, of Elfland, or of Middle-earth, which is highly creative and garners a high degree of copyright protection, but which is not useful in navigating Poughkeepsie.⁴⁹

⁴⁷ See Durham, *supra* note 25, at 802.

⁴⁸ See Dennis S. Karjala, *Copyright in Electronic Maps*, 35 JURIMETRICS J. 395, 413 n.65 (1995).

⁴⁹ Cf. URSULA K. LEGUIN, *From Elfland to Poughkeepsie*, in *THE LANGUAGE OF THE NIGHT: ESSAYS ON FANTASY AND SCIENCE FICTION* 73, 74 (Susan Wood ed., G.P. Putnam's Sons 1979) (“[T]he point about Elfland is that you are not at home there. It's not Poughkeepsie.”).

We have also seen that this assumption that original expression can take multiple forms, that it is not constrained to a single embodiment, is a standard doctrinal assumption in copyright, underpinning for example the idea/expression distinction and the concept of merger. In copyright we normally assume that there exist a large, possibly infinite number of ways to express a particular idea. But where the number of possible ways to express an idea is highly constrained, to the point that only one or a very small number of expressive modes are available, then the danger exists that protecting that expression would be tantamount to protecting the idea, and we refuse to protect the expression. The same is true where the constraints are functional. Where there is a large, possibly infinite, number of ways to reach a particular outcome, the courts take that as an indicator of originality, of expression. Where the options are constrained to one or a few possibilities, this is taken as an indicator of functionality and copyright is precluded.

Now I wish to concentrate for a moment on this reasoning as it applies to processes or methods, as you would expect from the title of this article. For all the talk of idea/expression merger in these opinions, they encompass at their core a process issue as well. This should be clear from the courts' criteria for declaring the valuations to be expressive. The courts focus on the valuation factors selected, the decisions about input that result in the final numerical result. This is to say that the courts focus upon the method, on the algorithm used for determining the value of a car or of a coin, for determining whether the result qualifies for copyright. This approach ties the output of the process, the valuation of the car or coin, to the method by which it was produced, as a matter of definition. And that should give us pause. *Baker* tells us that methods are not protected under copyright, and that there are instances where a method is instantiated as expression, which precludes the copyright of this expression. Only where a method and its expression are clearly separable can copyright protect the latter.

So the result in these cases is troubling for a second reason, which is the very real presence of a process or method that may be swept up into copyright protection. The *CCC* opinion rejects the idea that it might be doing what *Baker v. Selden* forbids: protecting a process incident to protecting expression that is bound up with that process. The court claims that the Red Book valuations "explain nothing, and describe no method, process, or procedure."⁵⁰ The court assumes that the valuations and the process that produced the valuations are conceptually separable, that the latter can be covered by copyright without covering the former.⁵¹

But the valuation number is the end product of a method, the tip of a methodological iceberg. Protecting the end product as a matter of copyright effectively protects the method by which that end-product was generated, especially if the method involves the creativity that the court attributes to it. There may be several ways to measure the current temperature, but we expect them to

⁵⁰ *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 73 (2d Cir. 1994).

⁵¹ *Id.* at 72-73.

converge on a particular result, or range of results, conforming to the state of the universe. But if the valuation of an automobile or coin is indeed an idiosyncratic, creative product, then we would not expect multiple methods to yield the same result except perhaps by sheerest happenstance—there is no objective result that they need conform to. A creative, idiosyncratic result arises from a creative, idiosyncratic, and likely singular, process. If the protected expression stems from creative choices then it follows that it is ultimately those choices that are being protected by copyright.

Of course this argument also proves too much—or does it? Remember the question, which we reserved before, as to what we should do with processes that portray a work or convey information. Here it is again, or at least its first cousin. A particular painting represents the endpoint or culmination of the process that produced it, the application of daubs of pigment to a canvas or other surface. A particular sculpture represents the endpoint or culmination of the process that produced it; chiseling away fragments of stone; accreting successive bits of clay or wax; smelting, pouring, and cooling alloys in a mold. Protecting the result of such processes in some sense protects the process that culminated in exactly that product. If we say that this Picasso painting or this Moby soundtrack is protected by copyright, then we are in effect saying that the process which results in that painting or soundtrack is also swept up into that copyright. Indeed, we may be protecting a suite of processes, as any process that reproduces that particular painting or soundtrack is precluded by copyright, whether the process is painstakingly reproducing the Picasso image by hand or whether the process is simply scanning and printing the image. The copyright statute does not say that it covers the process by which a work is produced, but if the process necessarily produces the work, and producing the work is infringement, the process is precluded along with the infringing product.

The caveat of course is that the process is precluded from copyright *unless* it independently recreates the protected work, that is, unless no copying is involved. For infringement to occur, there must be a causal connection between an authorized copy of the work and the production of an unauthorized copy of the work. Sometimes we infer such a connection as an evidentiary matter.⁵² But whether the connection is explicit or inferred, the precluded process must be one that takes someone else's original expression as an input and maintains some substantial portion of that expression as an output.⁵³ Copyright prohibits unauthorized copying, or reproduction of the work; if there is no copying, there cannot be a violation of the right of reproduction. So independent re-creation is a defense to a claim of copyright infringement. But we assume both as a matter of

⁵² See *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

⁵³ We might note in passing that processes which, without authorization, take original expression as an input and produce some other original expression as an output have been held to constitute fair use of the input expression. See *Sony Computer Entm't, Inc. v. Connectix Corp.*, 203 F.3d 596 (9th Cir. 2000); *Sega Enters. v. Accolade, Inc.* 977 F.2d 1510 (9th Cir. 1992); *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255 (5th Cir. 1988).

evidence and as a matter of causality that the chances of independently re-creating a Picasso painting or a Moby soundtrack, or Keats' *Ode on a Grecian Urn*,⁵⁴ are vanishingly small.

And it is exactly that assumption about the probability of independent re-creation, the assumption that original expression is rare, unique, and particular to an author, and the corollaries to that assumption, that are key to the treatment of process in copyright. I have said that the court in *CCC* essentially classified works according to the nature of the process that produced them. I have also just said that we do something of this sort as a general matter in deciding the causality of infringement; we say some processes imbue their products with originality, and others do not. A process which only copies another work has a determined outcome; it will result in the same expression that it emulates. A process that produces something undetermined, either independent of a given model or idiosyncratically while trying to reproduce a model, in whole or in part, is not merely reproduction. We rely upon the distinction between determined and undetermined outcomes to decide what is original expression and what is not.

So we can see, for example, a reliance upon the idiosyncratic variations of the mezzotint process in the famous *Alfred Bell & Co. v. Catalda Fine Arts, Inc.* opinion.⁵⁵ In that case, the plaintiff had produced mezzotint engravings, reproductions of Old Master paintings, such as by Rembrandt. The accused infringer had produced unauthorized second generation engravings, copying from the first generation engravings. Any expression copied from the Old Masters lay in the public domain, and could be taken, second-hand so to speak, from the mezzotint just as they could have been taken directly from the public domain Rembrandt. So the only question was whether anything original had been added to the mezzotint that might have been taken by the subsequent copyist. The court held that something original *had* been added to the first generation engravings, that the engraving process reflected idiosyncrasies unique to the engraver, such as stray lines and other variations.⁵⁶ Copying those variations from the first generation engravings was an infringing appropriation of original expression.

One has to wonder a bit about that holding; if the purpose of the engraving was to produce as faithful a reproduction of the public domain work as possible, then the engraver's choices were directed toward producing a reproduction with nothing original, and nothing for copyright to protect. Some more recent cases involving more sophisticated reproduction technologies have held just that; that a high fidelity reproduction of a public domain work leaves nothing to be added to the reproduction that can be called original.⁵⁷ Mistaken or inadvertent deviations from faithful reproduction hardly seem original choices of the sort that copyright

⁵⁴ *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936).

⁵⁵ 191 F.2d 99 (2d Cir. 1951).

⁵⁶ *Id.* at 102-03.

⁵⁷ *See, e.g., Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 200 (S.D.N.Y. 1999).

should protect.⁵⁸ It may be that the court was really trying to protect the labor that went into creating the mezzotints, and that this would be prohibited under more recent Supreme Court decisions.⁵⁹ But if we take the opinion at face value, the court in *Alfred Bell* found that something was added, that the reproduction was not made with perfect fidelity. Or in other words, that the outcome of the process was not pre-determined; the process could result in multiple possible end products.

By the same token, a process that is seen to constrain the copyist to an unoriginal outcome entails no original expression, so that a second generation copy would not be infringement. This was the situation, you may recall, in *L. Batlin & Son, Inc. v. Snyder*.⁶⁰ The work at issue in *Batlin* was a mass-produced replica of a much older cast metal bank in the form of an "Uncle Sam" figure. The cast metal bank, if it ever had copyright protection, had fallen into the public domain and became the model for an inexpensive plastic replica. The mass-produced version differed in certain minor respects from the cast metal original, in part due to differences in the method of manufacture—certain details of the figure could not be replicated, or could only be replicated with less definition, when produced by the injection of polymer plastics into a mold.

When the plastic replica of the bank was itself copied by another manufacturer, the first manufacturer sued unsuccessfully for copyright infringement.⁶¹ As in *Alfred Bell*, the question was whether anything protectable existed in, and had been taken from, a reproduction of a work that lay in the public domain. Yet in *Batlin*, unlike *Alfred Bell*, the court held that while the second manufacturer had certainly copied, the copying had not taken any original, protectable expression.⁶² Any expression copied from the cast metal original to the plastic replica was of course unprotectable as having fallen into the public domain, and could be taken freely by the second manufacturer, whether directly from the cast metal bank or indirectly as passed along in the plastic replica. Consequently, the first manufacturer had to point to the differences from the cast metal original as the only candidates for original expression that might have been copied.⁶³ But those differences were held to be either so trivial as to lack originality, or to have been dictated by the nature of the manufacturing process—in other words, to have been the result of a functional process.⁶⁴

Now were there no choices made, no selections, in producing the *Batlin* novelty bank? Apparently none that the court believed were unique or idiosyncratic or original to the creator. The variations from the public domain bank were held to result from the characteristics of the materials used in molding the polymer—not from a creative choice of the designer. To be sure, the designer

⁵⁸ See Alan Durham, *The Random Muse: Authorship and Indeterminacy*, 44 WM. & MARY L. REV. 569 (2002) (arguing that inadvertent creations are not works of authorship).

⁵⁹ See, e.g., *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

⁶⁰ 536 F.2d 486 (2d Cir. 1976).

⁶¹ *Id.* at 487–88.

⁶² *Id.* at 492.

⁶³ *Id.* at 489.

⁶⁴ *Id.*

made choices: the choice to imitate the cast iron public domain bank, and to do so using polymer plastics. I suppose the court in *CCC* might consider those choices creative choices, although the choice of materials was likely dictated by the cost of manufacturing and clearing price for such replicas in the market, so it seems unlikely that the bank manufacturer really had a very free hand in those decisions. And once the decision was made to use an injected polymer manufacturing process, then certain features of the bank resulting from the process were determined.

That kind of determination will be the case whatever production process is employed. Just as certain results are determined once you have decided to replicate a bank in polymer plastic, so certain results will be determined once you have decided to estimate the market value of used cars. For that matter, it seems likely that certain results are determined once you decide to replicate Rembrandt drawings as mezzotint. A certain mode of production might be chosen to replicate novelty banks or mezzotints due to its economic features, or due to its esthetic features, but in either event it will give rise to certain product characteristics that are determined by the use of those particular input materials in that particular process.

V. DEGREES OF FREEDOM

By now, I hope it has become plain that there is a commonality among the categories of subject matter that we have considered as being excluded from copyright. They are identified and defined by criteria that are shared by the doctrines we have reviewed. The common thread here is that of determinism; courts declare that the law of copyright does not protect expression that can only be instantiated in a single, determined way. Neither does it protect processes or methods, which yield predictable, determined outcomes. And it treats the universe as a sort of machine, as a collection of processes that generate deterministic results, which it designates facts, and which it refuses to accept as the subject of copyright because they are determined, and not originated from an author.

The language of determinism, or of determination, carries with it some connotative danger. Perhaps we should use the term "monovalent" to describe this kind of process, in order to avoid the philosophical morass of causality and predestination and such. We need not make a philosophical declaration about the causal order of the universe in order to consider actions that converge upon a determined result. Our concern is with outcomes localized in space and in time; we need not trace matters back to the Big Bang, or to Genesis, or to the hatching of the Cosmic Egg. We are considering conditions tied to a particular result, processes that, if I may borrow a term from statistics, are constrained or are singular in their degrees of freedom.

Neither should we become distracted by the problem of inevitability. The linkage of an outcome to a previous set of conditions need not necessarily be predictable to be determinate. We may have incomplete information about the initial conditions that produced a certain result, but that is a failure of human

capacity, not of determinacy. And of course even predictable processes can go wrong; Murphy's Law may divert processes into unexpected outcomes. But in such a case we are of course considering an outcome causally related to a different process than the one we had considered initially, the unexpected process rather than the expected process.

We need only recognize that copyright doctrine contemplates an obligatory sort of causality for non-expressive subject matter. Copyright separates out subject matter that is monovalent, or determined, or singularly constrained, in its outcome. Setting aside the very interesting but rather sticky philosophical ramifications, this doctrine implicitly adopts a determined causality, assumes that a particular result is causally related to a particular action, that the state of the universe at one moment is determined by the state of the universe in the previous moment, and will in turn determine the state of the universe in the moment to come. I have said that this is effectively a process-based definition of expression. The presence of a process implies the presence of an apparatus for executing that process. In copyright, the universe is that machine.

This is of course the logic of science. We design experiments to force the universe to a resolution between alternatives, and we assume that the state of the universe at the end of the experiment is deterministically correlated to the state of the universe that we contrived at the beginning. We treat nature as essentially a Turing machine,⁶⁵ that is, as a mechanism with a defined output for every input. We give the universe a certain input, and we expect a defined output. And we assume that we can deduce the machine's axioms of operation from the responses we get to particular inputs. Of course we know that whatever kind of machine the universe is, it cannot be a machine of this type. But this logic allows us to systematically construct a workable, if incomplete, model of how the world functions.⁶⁶

Some of you who know something of such matters may protest that quantum mechanics does not function in this way; at the atomic scale, material behaves in seemingly unpredictable ways so that we cannot definitely determine both its position and velocity, and sometimes things pop up in places without troubling to inhabit, even temporarily, the spaces between where they were and where they are. But this only means that we are talking about a probabilistic machine, and not that we are no longer talking about a machine. There is still an input, a process, and an output, even though we may state the inputs and outputs as statistical ranges. Others may protest with a bit more sophistication that Gödel and Turing have shown that the universe cannot be quite this kind of a machine; that such a system would be incomplete or inconsistent.⁶⁷ But here we are talking simply about the

⁶⁵ MARVIN MINSKY, *COMPUTATION: FINITE AND INFINITE MACHINES* 117 (1967) ("A Turing machine is a finite-state machine associated with an external storage or memory medium.").

⁶⁶ See JACOB BRONOWSKI, *The Laws of Nature and the Nature of Laws*, in *THE ORIGINS OF KNOWLEDGE AND IMAGINATION* 65, 80 (1978).

⁶⁷ See JACOB BRONOWSKI, *The Logic of the Mind*, in *THE IDENTITY OF MAN* 117, 124 (Natural History Press rev. ed. 1971) (1965).

limits of our ability to describe the universe as a formal system; at some point it is undoubtedly true that at some point the axiomatic system of science, and the language of science, mathematics, will break down. This has not stopped science from making falsifiable predictions about the behavior of the universe, and while we may at any moment find the limits of the system, on the whole it continues to work pretty well.

The logic of copyright, the logic of *expression*, however, is indeed quite different. It effectively assumes that originality, the touchstone for copyrightable subject matter, stands outside the causal order of the universe. It is part of the romantic view. A considerable body of scholarship has now explored the myth of the "romantic author," a sort of fictional, solitary genius from whose fevered brow original expression springs full-blown, like Athena from the head of Zeus. This authorial caricature, drawn from a nineteenth century vision of creation, continues to animate copyright law with the assumption that creative expression originates from an isolated creator.⁶⁸ Much of postmodern copyright criticism has been concerned with pointing out that there can be no creation of expression *ex nihilo*, that writers and artists are situated in the communities in which they create, and draw upon the influences with which they are surrounded. Yet the cult of the romantic author persists, perpetuating legal rules that inflate the exclusive rights of the author at the expense of the public, and which alienate the creative process from the sources that creation necessarily draws upon.⁶⁹

Now this body of scholarship might initially appear at odds with the observations I have been making here; to say that copyright valorizes the independence of the romantic genius when I have been saying that copyright incorporates assumptions of determinism. But the two are in fact complementary. Copyright adopts, as counterpoint to the romantic author, an almost classical positivism, which owes less to Mach⁷⁰ and Carnap⁷¹ than it does to Laplace⁷² and Comte.⁷³ I have remarked elsewhere on the strain of Cartesian dualism that permeates the law of copyright, separating mind from matter, conceptual from material.⁷⁴ And now here it is again. Romanticism draws the boundary of copyright to include that which is original to the author and exclude that which derives from

⁶⁸ See, e.g., Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of "Authorship,"* 1991 DUKE L.J. 455, 455–56; Martha Woodmansee, *On the Author Effect: Recovering Collectivity*, 10 CARDOZO ARTS & ENT. L.J. 279, 279 (1992).

⁶⁹ See David Lange, *At Play in the Fields of the Word: Copyright and the Construction of Authorship in the Post-Literate Millennium*, 55 LAW & CONTEMP. PROBS. 139, 141–42 (1992).

⁷⁰ See JOHN T. BLACKMORE, *ERNST MACH: HIS WORK, LIFE, AND INFLUENCE* (1972).

⁷¹ See ALAN W. RICHARDSON, *CARNAP'S CONSTRUCTION OF THE WORLD: THE AUFBAU AND THE EMERGENCE OF LOGICAL EMPIRICISM* (1998).

⁷² See HAHN, *supra* note 7.

⁷³ See MARY PICKERING, *AUGUSTE COMTE: AN INTELLECTUAL BIOGRAPHY* (1993).

⁷⁴ See Dan L. Burk, *Feminism and Dualism in Intellectual Property*, 15 AM. U. J. GENDER SOC. POL'Y & L. 183, 185 (2006).

material causality. Original expression arises out of the author; fact and measurement exist outside of the author. Copyrightable expression derives from unfettered will; uncopyrightable fact and measurement are bound to the condition of the world.

For all the talk of the romantic author, and how that concept defines the subject matter of copyright, there has been little recognition that it also necessarily defines that which is *excluded* from copyright. That which is original, which springs from genius, defines that which is unoriginal, which exists already in the state of the world. If the original expression in copyright constitutes that which is animated by romantic genius, then the methods, processes, and facts which are excluded from copyright must constitute inert mechanics, devoid of such genius. The two go hand in hand; if the zeitgeist of the eighteenth and nineteenth century defines that which is protected by copyright, then the definition of that which is excluded from copyright arises out of the same milieu. And if the cult of the author has been left untouched by postmodern recognition that no one creates expression in cultural isolation, so too copyright's conception of fact has been left untouched by postmodern recognition that no material process is realized in cultural isolation.

This view of the universe is implicit in cases, such as *CCC*, that incorporate a deterministic logic into their reasoning over copyrightable subject matter. The decisions in these cases rest upon the assumption that there are multiple ways to construct a valuation of a coin or a used car. The cases rely upon the available degrees of freedom as a proxy for originality, and for the subject matter of copyright. If, for purposes of automobile valuation, the country could be divided into six regions rather than five, or antique coins could be grouped in twelve-year increments rather than ten-year increments, then such "choices" indicate multiple approaches to an outcome, and selection among such choices must be original. Multivalent outcomes are characteristic of originality, and multivalent, non-deterministic outcomes are characterized by authorial choice, so the courts conclude that originality is signaled by the presence of authorial choice.

That syllogism is of course an error in logic, but more importantly, it is an error in perception. The question is not the presence of choice, but the kind of choice. As we have seen, in a case like *CCC* the distinction over choice is to some extent illusory—it is not at all clear that there are multiple ways of constructing a particular valuation of a used car, at least not if you wish that valuation to correspond to the actual state of affairs in the used car market. By the same token, it is as a practical matter unlikely that there really are multiple ways of constructing a particular symphony by Copeland⁷⁵ or picture by Vasarely. You either have the unique synaptic architecture of Aaron Copeland, or you don't. But this distinction between monovalent and multivalent outcomes, which the courts inelegantly have equated with selection or choice, attempts to capture a profound difference between the informational character of a Copeland symphony and the informational character of a used car valuation. There are two very different kinds

⁷⁵ See generally HOWARD POLLACK, AARON COPELAND: THE LIFE AND WORK OF AN UNCOMMON MAN (1999) (discussing the works of Aaron Copeland).

of information at issue here, one of which is the proper concern of copyright and one of which is not.

As Bronowski observed many years ago, every child taking geometry rediscovers the Pythagorean theorem, but they all do so in exactly the same form; there is as a practical matter only one way in which it will work.⁷⁶ This is not so for a work of art or of drama, like the *Mona Lisa* or like *Oedipus Rex*. As I said in my description of the idea/expression distinction, many original portraits may be painted, many plays can be written on the same themes as contained in those works, yet no artist or playwright will express those themes quite like Leonardo or like Sophocles. Indeed, no two members of an audience viewing the *Mona Lisa* or *Oedipus Rex* will receive or understand the artist's expression in quite the same way. This is one reason that we are willing to grant exclusive rights to original expression, but not to facts and natural principles;⁷⁷ we must all share the same meaning for the Pythagorean theorem, but we may each find our own meaning in *Oedipus Rex*.

To be sure, a Riemann⁷⁸ or a Gauss⁷⁹ or a Lobachevsky⁸⁰ may take his own idiosyncratic view of the Pythagorean theorem, and when one of them refuses to accept that the internal angles of a triangle must add up to 90 degrees, then the assumptions of planar geometry give way and a new geometry is born: hyperbolic, parabolic, spheroid.⁸¹ That is creativity of the same order as that of a Leonardo or a Sophocles, and may well be the common characteristic that constitutes genius. But the avenues for such geometric genius are constrained in ways that the avenues for interpretation of expression are not. In all but a very few cases, the idiosyncratic treatment of basic geometry is not genius, it is simply wrong, and the geometry teacher marks the paper down on criteria that are constrained in ways that the evaluation of the teacher of painting or literature are not.

This constraint comes about because the Pythagorean theorem conveys a descriptive statement about the external state of the world, whereas *Oedipus Rex*

⁷⁶ JACOB BRONOWSKI, *On Art and Science, in A SENSE OF THE FUTURE* 16, 18 (1977).

⁷⁷ There is a real question as to whether a mathematical statement such as the Pythagorean theorem constitutes a fact or a natural principle. See PHILLIP J. DAVIS & REUBEN HERSH, *THE MATHEMATICAL EXPERIENCE* 321 (1980). At a minimum it constitutes a statement that is constrained in equivalent formulations. See Robert G. Balding, *A Socratic Approach to Understanding the Limits (if Any) of Software Copyright Protection*, 28 *JURIMETRICS J.* 153 (1988).

⁷⁸ See generally JOHN DERBYSHIRE, *PRIME OBSESSION: BERNHARD RIEMANN AND THE GREATEST UNSOLVED PROBLEM IN MATHEMATICS* (2006).

⁷⁹ See generally M.B.W. TENT, *THE PRINCE OF MATHEMATICS: CARL FRIEDRICH GAUSS* (2006).

⁸⁰ See generally Alexander Vucinich, *Nicolai Ivanovich Lobachevskii: The Man Behind the First Non-Euclidean Geometry*, 53 *ISIS* 465 (1962).

⁸¹ For a lay introduction to non-Euclidean or differential geometries, see MICHAEL GUILLEN, *BRIDGES TO INFINITY: THE HUMAN SIDE OF MATHEMATICS* 84–86, 108–111 (1983).

conveys, at base, a statement about the internal state of the self.⁸² I might add that hyperbolic or spheroid geometry is also a description of the external world, it is simply a different external world than that of Euclid, although if we believe Einstein perhaps not different than the world in which we live. We use such descriptions prescriptively in the logic of science, to make predictions about how the universe will react when we bring it to an experimental crossroads. We rely upon them as functional descriptions to construct the useful articles and processes that are excluded from copyright but included within the patent system. They are, as Karl Popper would have said,⁸³ testable and falsifiable; they either work or they do not.

This is not at all the case for those works that copyright would call original expression. The information conveyed by such works is information of a very different kind than conveyed in a scientific work. I said before that we might write many works on the theme of *Romeo and Juliet*. But the point of *Romeo and Juliet* is not to make a recommendation as to whether you should fall in love with your hereditary enemies, nor as to whether thwarted lovers should commit suicide, anymore than the point of DaVinci's "Last Supper" is to convey a historical depiction of a meal taken in an upper room of first-century Jerusalem.⁸⁴ Such works do not carry, except incidentally, an objective message about the physical world or its deterministic functions. They carry instead a subjective message about the experience of being human; at a minimum something of the author's experience, but just as important, something we recognize of ourselves.⁸⁵ Indeed, although this article is not intended as an exposition on aesthetics,⁸⁶ C.S. Lewis once asserted that the dividing line between good literature and bad literature, between art and kitsch, is that capacity to expand the reader's experience.⁸⁷ Good literature, he said, conveys something to the audience outside of their previous experience, whereas bad literature is merely a vehicle used by the audience to re-enforce their own preconceptions and prejudices.⁸⁸ It is the transformative potential of the work that makes all the difference.

Having drawn that distinction, perhaps it becomes clear how profound an error the court made in *CCC*. Estimates of used car value are manifestly information of the descriptive, prescriptive type, and not reflections on the implications of the evaluator's experience, or an elegy on the state of humankind. The Red Book tables provide testable and falsifiable predictions about the value of used automobiles and a recommendation as to how one ought to act—what one

⁸² JACOB BRONOWSKI, *The Logic of the Mind*, in *THE IDENTITY OF MAN* 51, 64–65 (Natural History Press rev. ed. 1971) (1965).

⁸³ See generally KARL R. POPPER, *THE LOGIC OF SCIENTIFIC DISCOVERY* (1959).

⁸⁴ Cf. *id.*

⁸⁵ *Id.*

⁸⁶ But see Alfred C. Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247, 247–51 (1998) (arguing that sound copyright reasoning should incorporate aesthetic reasoning).

⁸⁷ C.S. LEWIS, *AN EXPERIMENT IN CRITICISM* 14–21, 88–94 (1961).

⁸⁸ *Id.*

ought to pay—in the market for used automobiles. While the value estimate may have been the result of choices, those choices were profoundly constrained by the logic of science, by the need to conform to the state of the external world. If we can imagine another Red Book, or a Green Book or a Pink Book, based on a different set of choices with a different set of estimates, it is either because, like the departure of Reimann or Lobachevsky from Euclidian geometry, they provide a closer fit to external criteria; or it is because, like the paper of the erring geometry student, those alternate estimates are simply wrong. Market estimates and valuations may be demonstrably wrong; Shakespeare and Sophocles never are. The messages of Shakespeare or Sophocles may be impenetrable, or unappreciated, or even immoral, but they are never *wrong* in any scientific sense of the word.

VI. PATENT LAW INTERMEZZO

Now we leave copyright, just for a moment, just for the sake of perspective. It is worth pausing to consider that a parallel problem arises in patent law, which is in many senses the complement to copyright. A comparison between the two may seem rather odd given what I have been saying about copyright: that the subject matter defined by the patent statute explicitly includes processes,⁸⁹ whereas I have made a great deal of the fact that the subject matter defined by the copyright statute explicitly excludes processes. One of the messages of *Baker v. Selden* was that methods and processes belong in patent law, if they belong anywhere. So it seems odd that patent law would have difficulty accommodating process claims when by definition it is intended to include them, or that patent protection of processes would have anything to teach copyright when by definition it is not.

But the inclusion of processes within the stated subject matter of the patent statute does not mean that patent law can distinguish process inventions from non-process inventions, or that it knows what to do with processes when it finds them. Following the statute, patentable inventions are traditionally lumped into the categories of process inventions and product inventions, the latter covering the statutory subject matter of manufactures, machines, and compositions, and the former being the immaterial odd category out. Processes themselves are typically divided into methods of making and methods of use: the kinds of processes one can engage in with some material object. But since the exclusive rights conferred under product patents include the rights to make and use the claimed invention, those processes are always entailed within the grant of a patent on a material object anyway.

These categories and distinctions made some sense and worked relatively well until recently. I have detailed elsewhere the difficulties that courts and the Patent Office have had in distinguishing product from process, particularly in the biotechnology area, and to some extent in computer software as well.⁹⁰ Since the

⁸⁹ 35 U.S.C. § 101 (2006).

⁹⁰ Dan L. Burk, *The Problem of Process in Biotechnology*, 43 HOUS. L. REV. 561, 562–66 (2006).

Supreme Court initiated the age of biotechnology patenting with its decision in *Diamond v. Chakrabarty*⁹¹ a good quarter-century ago, the patent system has repeatedly run up against difficulties in separating product from process. This problem has occurred across a variety of patent doctrines, such as determining the patentability of a novel product produced by means of a previously known process, or determining whether the offshore use of a patented product in a non-infringing process could constitute infringement, or determining the utility of a process that yields a product of indeterminate use.⁹²

I have argued that the difficulty in separating process from product in these cases stems first from the nature of processes and second from the nature of technologies that have recently become patentable.⁹³ Processes involve the transfer of information, as that term is defined in physics and related disciplines—a measure of the state of uncertainty or disorder in a particular system.⁹⁴ This definition is held to be true for all types of physical processes. It is the basis for a number of scientific laws that we have formulated to describe the behavior of the universe, as well as being increasingly the basis for our understanding of the nature of the fabric of the universe itself. We conceive the universe as comprised of material, which take the form of either matter or energy, and of information, which orders the arrangement of that material.⁹⁵ The information may be in a state of dynamic transfer or the information may be in a state of static embodiment.

This understanding of process and product explains why in previous technologies we could draw a clear distinction between the two categories; we could focus on the material, and ignore the informational nature of the invention. But this is not the case for the problematic new subject matter categories of biotechnology and computer software. In these technologies information is only lightly embodied, lies very near the surface of the material instantiation, and is quite impossible to ignore. In these technologies process shades into product because the transfer of information cannot be easily distinguished from the information itself. And when products become largely indistinguishable from processes, the distinctions among product patents and process patents become increasingly untenable.

So there has been in patent law what we might call a kind of merger, if we are willing to borrow some copyright terminology. The information conveyed in a process can no longer be distinguished from the process itself. The courts have responded to this development by declaring utility to be the key criterion for patentable subject matter, by saying that any process which produces a useful

⁹¹ 447 U.S. 303 (1980).

⁹² See Burk, *supra* note 90.

⁹³ *Id.* at 588-90.

⁹⁴ See JOHN R. PIERCE, AN INTRODUCTION TO INFORMATION THEORY: SYMBOLS, SIGNALS, & NOISE 24 (2d rev. ed. 1980).

⁹⁵ See LEE SMOLIN, THREE ROADS TO QUANTUM GRAVITY 55-56 (2001); see also Jacob D. Bekenstein, *Information in the Holographic Universe*, SCI. AM., Aug. 2003, at 58, 58.

outcome is potentially a patentable process.⁹⁶ This response effectively does away with what we might call the fixation requirement for patents, with any requirement that a process be instantiated in a physical apparatus. And so purely informational processes become patentable, which is why we hear so much commotion about the patenting of business methods and other nontechnical methods.⁹⁷ If purely informational processes are patentable, then perhaps it does not matter so much what is a product and what is a process, but the doctrinal categories built up around these distinctions are bound to become troublesome.⁹⁸

In light of this breakdown in patent law categories, reconsider the problem that processes pose for copyright. In the case of copyright, we deal with creative works that are *purely* informational; by statutory definition, copyright is directed to the expressive work embodied in a particular tangible object, but not to the object itself.⁹⁹ And yet the information comprising the intangible work must be of an idiosyncratic nature: communication of facts or other unadorned representations of the universe lie outside the realm of copyright. So the statute simultaneously requires us to separate the material from the intangible and the utilitarian from the aesthetic, for example defining the uncopyrightable useful article¹⁰⁰ as an item that *does not* merely convey information or portray its own appearance. Recall that *Baker* tells us useful articles and other functional items belong to patent law.

The copyright act excludes processes; *Baker* declares them to be the subject matter of patent law. The implication is that processes are by definition utilitarian, because of course utilitarian subject matter is the domain of patents. Causation

⁹⁶ *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998).

⁹⁷ See Rochelle Cooper Dreyfuss, *Are Business Method Patents Bad for Business?*, 16 SANTA CLARA COMPUTER & HIGH TECH. L.J. 263, 265 (2000); Leo J. Raskind, *The State Street Bank Decision: The Bad Business of Unlimited Patent Protection for Methods of Doing Business*, 10 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 61, 62 (1999); John R. Thomas, *The Patenting of the Liberal Professions*, 40 B.C. L. REV. 1139, 1141–42 (1999).

⁹⁸ Some panels of the Court of Appeals for the Federal Circuit appear to have begun acknowledging this tangibility problem, and are now desperately trying to distance themselves from the consequences of the *State Street* decision, perhaps fearing unwanted attention from the Supreme Court. *Compare In re Comiskey*, No. 2006-1286, 2007 WL 2728361, at *6-7 (Fed. Cir. Sept. 20, 2007) (holding a method of arbitration unpatentable), and *In re Nuijten*, No. 2006-1371, 2007 WL 2728397, at *5 (Fed. Cir. Sept. 20, 2007) (holding an encoded electromagnetic signal without apparatus unpatentable), with *Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.*, 126 S. Ct. 2921, 2928 (2006) (Breyer, J., dissenting from the dismissal of the writ of certiorari as improvidently granted) (questioning whether the *State Street* decision comports with Supreme Court precedent regarding intangible processes). But it is unclear how one can draw a subject matter line that avoids the doctrinal endpoint reached in *State Street*. See Dan L. Burk & Brett H. McDonnell, *Patents, Tax Shelters, and the Firm*, 26 VA. TAX REV. 981, 984 (2007) (noting that software patenting leads inevitably to patents for intangible processes).

⁹⁹ 17 U.S.C. § 202 (2006).

¹⁰⁰ *Id.* § 101 (defining “useful article”).

involves the transfer of information.¹⁰¹ Sometimes that information will be communicative and sometimes it will be static. When it is communicative, it may sometimes be factual, reflecting the external state of the world, or sometimes that information will be expressive, reflecting the internal state of humankind. But in any event, copyright has always assumed that you can separate the process of transfer from the information transferred, and that the process of transfer is always utilitarian or functional.

This exclusion, which is really the best way to think about the result in *Baker*, makes a good deal of sense when your processes are embedded in physical apparatus, when the process is tangibly fixed. We know that such an apparatus, of cogs and gears and wires does not belong to the copyright system. But the distinction is much less viable when we are dealing with purely informational processes that are only lightly fixed, if at all, so that the information is very nearly free of material embodiment. As in patent law, software presents this kind of profile to copyright law. The valuation methods in *CCC* and *CDN* are processes of the same type; even if the courts are correct that they are too subtle to be captured as computer code, they are informational processes running in a carbon-based processor rather than in a silicon-based processor.

VII. DETERMINED TEXTS

Let me review the argument up to this point. We began with several propositions of black-letter copyright law, harking back to *Baker v. Selden*, that copyright does not protect ideas, utilitarian items, processes or methods. We then reviewed several recent cases that seem to do the last, to protect a process or a method by protecting as a matter of copyright law the output of that process or method—to protect the methodology of valuation by protecting a statement about the value of a coin, or of a used car. The justification or rationale given in these cases is that the method or process was creative, where creativity is defined as selecting steps in the process from among other alternatives.

These cases and their justification are troubling, but we know that neither the objection to them nor the defense of their outcome can be quite right. The objection cannot be quite right because every copyrightable work is the result of some process, so that for copyright to effectively protect an underlying process by protecting its result may actually be quite common. The rationale justifying the outcome cannot be quite right because the results of these particular processes were clearly intended to accurately represent or reflect the state of the world. In short, the output of the processes was certainly intended as fact.

This in turn leads us back again to a black-letter proposition of copyright law: that copyright does not protect facts. But these cases we are considering throw into doubt the characterization of facts; they appear to assert that whatever facts may be, they are not derived from creative choices among alternatives. In other words,

¹⁰¹ Cf. John Collier, *Causation Is the Transfer of Information*, in *CAUSATION AND LAWS OF NATURE* 221–23 (Howard Sankey ed., 1999).

facts are the result of certain methodologies. The corollary to this supposition seems to be that facts are entities that somehow exist independent of human creativity and judgment. Both versions of the supposition are of course absurd; any description of the world is in fact a judgment, and the result of creative choices. So if the application of human choice or judgment is our criterion, then facts cannot be excluded from copyrightable subject matter; copyright would cover them all.

The black-letter copyright rule for excluding facts holds that they are not original, that is, that they do not originate with the author. This distinction arises from a romantic view of authorship which has been elucidated and critiqued in detail by a host of scholars, who have pointed out how this view aggrandizes the capture of cultural properties and ignores the communal milieu of creation. The view that creativity springs from the mind and will of the solitary genius sits well with neither postmodern theory of the arts nor with what we know empirically and anecdotally about the creative act.¹⁰² The artist is not separate from either the natural or the cultural environment; there must be creative inputs before there can be creative outputs.

But the same is true of science, of the methodology by which we generate and certify facts, both in the creation of theories and in the measurements that we call experiment, which allow us to distinguish between more or less preferable theories. The scientific method requires creative choices, requires creative inputs, to formulate empirical theories and subject them to experiment. This is not to say that we must embrace the romantic view of authorship in order to exclude facts from the subject matter of copyright; it is rather to reject the criterion of selection as the determinant for copyright. The question is rather whether a particular work must conform to a determined outcome. Copyrightable expression is not constrained in this fashion; it communicates something about the state of the *self*, rather than something about the state of the *world*.¹⁰³ The purpose of *Hamlet* is not to advise us on whether or not to avenge our father's death, any more than Frost's poem *Mending Wall* is intended to advise us on whether to be friendly with our neighbors.¹⁰⁴ On the other hand, the purpose of the used car Red Book is decidedly to advise us on whether or not we are paying too much for a particular used car, and guides to antique coins or options contracts have a similar function.

Let me be clear in my assertion. I am not asserting that we need accept the fiction of the romantic author, nor yet that we must treat science as the product of such romance. I am rather asserting that the exercise of judgment cannot be the point upon which we distinguish what we call fact from what we call original expression. This recognition leads us to the proper criterion for exclusion: that the proper subject matter of copyright is multivalent, rather than monovalent. That distinction is drawn ultimately from the core insight of *Baker v. Selden* and its

¹⁰² See Julie E. Cohen, *Creativity and Culture in Copyright Theory*, 40 U.C. DAVIS L. REV. 1151, 1151–54 (2007).

¹⁰³ Cf. BRONOWSKI, *Knowledge of Self*, in THE IDENTITY OF MAN, *supra* note 82, at 64–69.

¹⁰⁴ *Id.* at 72.

progeny: where there is only a single or limited mode of expression, we will not grant an exclusive right in that mode. If you wish we can view it as an originality criterion: there is nothing original in expressing a work in the only way it *can* be expressed, where the choice is imposed on the author by necessity, not by any act of creativity.

In the case of valuation procedures for cars or coins, the courts implicitly adopt the position that if the choice of value is imposed upon the creator by necessity, it is not a creative choice, and was chosen for the sake of conforming to the state of the world. They then assume that because the creator is free to indulge in fantastic or inaccurate valuations, he is under no constraint. As a criterion for creativity this is quite mistaken; but stripped of this error, the underlying logic of monovalence may be helpful. It is the characteristic of determinism, of a single constrained outcome, that is the common thread among the black letter exclusions from copyrightable subject matter. Merged expression cannot be included within copyright because it is limited to a single instantiation; facts cannot be protected because they are constrained to a single result. Processes, methods, and systems—which is to say, in effect, machines—cannot be included because they are quite literally geared to a particularized output.

A moment ago I mentioned software in the context of patent law, and alluded to the problems it poses for copyright. It should now be clear why that is so. The use of selection as a proxy for determination, the failure to recognize multivalence rather than choice as the criterion for copyright, can only work mischief with the copyright system. That problem is certainly manifest in *CCC*, but reaches its zenith in the computer cases from the 1980s and 1990s. The courts in those cases were attempting to accommodate software within the copyright act, as Congress has instructed them to do. Following those legislative instructions was really a logical impossibility, as the statute specifically forbids copyright protection for methods and processes, and yet software comprises a method or process. In the key decisions, such as *Apple v. Franklin*,¹⁰⁵ the courts attempted to separate the symbolic representation of a process from its physical execution, holding that the former was protected by the copyright statute, whereas the latter was not. This bifurcation had long been the staple logic for dealing with cooking recipes and such; the words describing the culinary process might fall under copyright, but the execution of the process described by the words was not.¹⁰⁶ In other words, the copyright statute defines computer programs as “instructions” to a machine,¹⁰⁷ and courts attempted to treat instructions to a machine as you would treat instructions to a human.¹⁰⁸

¹⁰⁵ 714 F.2d 1240, 1253–54 (3d Cir. 1983).

¹⁰⁶ *See, e.g., Publ'ns Int'l, Ltd. v. Meredith Corp.*, 88 F.3d 473, 480–81 (7th Cir. 1996).

¹⁰⁷ 17 U.S.C. § 101 (2006).

¹⁰⁸ Dennis S. Karjala, *Copyright, Computer Software, and the New Protectionism*, 28 JURIMETRICS J. 33, 41–42 (1987).

But this of course would not work, because the computer code specifies a process that is entirely deterministic in the sense that we have been talking about. We euphemistically call the program a set of instructions, but they are not instructions of the sort that a cook reads in a recipe, calling for a teaspoon of sugar, but for which the cook may choose to substitute half a teaspoon of sugar, or a teaspoon of honey, or no sugar at all.¹⁰⁹ When executing computer code, the machine exercises no judgment, has no choice in whether a certain set of bits will be moved to a particular register; or viewed at a different level, has no choice whether a certain voltage will be raised or lowered across a certain circuit. The courts hoped to treat the code as a sort of notation for a blueprint of certain circuit configurations. But where software is concerned, the separation between specification and machine is not so neat: when placed in the context of hardware, the software notation does not merely describe the circuit, it in fact configures the machine so as to *become* the circuit.

Commentators have tried to capture this principle by describing software either as “text that behaves” or as “a machine built of text.”¹¹⁰ Usually we think of machines as built out of metal, plastic, or other physical substances, and a hardwired data processor is in fact constructed wholly of such materials. But we have decided to construct the majority of our data processing devices as universal machines that can be reconfigured for different purposes by a text that the programmer composes. Indeed, Phil Agre has pointed out that therein lies the enormous power of the modern computer: because such machines are quite literally inscribed with text, anything that can be described can be modeled virtually as a computing process.¹¹¹ For our purposes here this is significant because construction of a device by writing text is equivalent to constructing the device by soldering metal or molding polymers: both will execute processes to produce a determined, monovalent outcome. The execution of the physical process becomes coterminous with the symbolic specification of the process.

Either definition of software contemplates a mechanism whose operation yields a certain result rather than that of an expressive text with variant possible articulation and interpretation. We can perhaps try to push the question of choice back a level, and say that the programmer made a judgment, or had choices in selecting the functions that would be specified by the computer code she wrote. This, by the way, is most likely how the copyright law tries to deal with works of computer-generated art: by assuming that the author, the entity who made choices about the output, is not the machine, but is rather the programmer who created the

¹⁰⁹ *See id.*

¹¹⁰ Pamela Samuelson et al., *A Manifesto Concerning the Legal Protection of Computer Programs*, 94 COLUM. L. REV. 2308, 2320 (1994).

¹¹¹ *See* Philip E. Agre, *Internet Research: For and Against*, in INTERNET RESEARCH ANNUAL: SELECTED PAPERS FROM THE ASSOCIATION OF INTERNET RESEARCHERS CONFERENCES 2000–2002, at 25, 27 (Mia Consalvo et al., eds., 2004).

software driving the machine.¹¹² But in the case of most commercial software, if perhaps not in the case of computer generated art, the programmers choices are constrained in the same ways that the valuations in *CCC* or *CDN* were constrained: by the functional goal of the specified process. Choices in programming are constrained by the limits of the hardware; speed, efficiency, capacity of the processor and memory. This is the same situation as that in *Batlin*; the constraints of the material dictate the design of the work, and the result is the same as well: the outcome is not original as copyright defines that term. In computer code, process, machine, and information come together in expression that is entirely determined by the need for congruity with the state of the world.

VIII. CONCLUSION

I said at the outset of this essay that copyright asks us to believe the outrageous, the impossible. Some of those impossibilities are readily apparent, but others come to light only with a little digging. It was perhaps not immediately obvious at the beginning of this essay that we would find embedded in the copyright statute a powerful and somewhat loaded philosophical assumption regarding the nature of reality. Copyright assumes that certain types of outcomes, certain types of results, are determined or constrained or monovalent, and that those types of mechanistic outcomes lie outside the subject matter of copyright. The universe is a machine, and human artifacts which rely on that mechanism, which are in effect piggy-backed on the functioning of the cosmic machine, belong to the realm of patent law.

This bifurcation of patent and copyright, as held in *Baker v. Selden*, is structured around the separation of function and expression into separate compartments. It turns upon a mechanistic view of process or method. But as I have argued in the previous work I mentioned, we have begun to discover in patent law that this neat separation cannot be sustained, as informational technologies such as software and recombinant DNA strain the definitions of process and product, of machine and expression. If this has become apparent in patent law, the same must be true for the paired body of law intended to accommodate expression. As the other bookend to patent law, copyright shares the categorical breakdown between process and information. You can no longer rely on the separation of process and information to keep functional subject matter out of copyright. So you have to pay rather careful attention to the type of information at issue, as it may be expressive information that belongs to copyright after all.

But perhaps the most startling realization about copyright's concept of determined outcomes is that it exists in the statute alongside the romantic view of original authorship. Copyright does not merely adopt the positivist view, I might say the somewhat tautological positivist view, that the universe is the sum total of

¹¹² FINAL REPORT OF THE NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS 44 (1978), available at <http://digital-law-online.info/CONTU/PDF/index.html>.

the observations about the universe and nothing else.¹¹³ Copyright adds to this the rather mystical proposition that there is something outside the mechanism of nature, something that is not a fact or observation, something that arises out of human creativity, and which is the proper subject matter of copyright. I said at the beginning that in this discussion we would skirt the quagmire of free will and determinism, but it is there nonetheless; and if original expression stands somehow outside the causal order of the universe, there remains for some future investigation the problem of the nature of the subject matter the copyright statute is constructed to protect.

Now there may be some tendency to ask why we need to unpack everything from these cases in this way, to ask what all the fuss is about. There may be some tendency to say, well, the courts in these cases are simply trying to protect people's investment in valuable creations, and well they should. You might say to yourself that a case like *CCC* is really just about courts trying to reach an optimal business result, and even if the reasoning is a little muddy, the outcome is all that matters. We don't need to understand determinism and multivalence and such to go on protecting investments in car valuations or coin valuations. That is the only guiding rule we need, to protect and encourage economic incentives, and that should be explanation enough for anyone.

Economic justifications for intellectual property statutes are very popular today, and they are fine so far as they go. I have certainly done some of that kind of analysis myself.¹¹⁴ But if that is all that we are trying to accomplish, then there really is no need for anything as complex as the copyright statute, with all of its apparatus about expression and originality and so on; we could instead use a much simpler general misappropriation statute to protect people's investment in creativity (and indeed, Professor Litman has suggested that perhaps we ought to do exactly that).¹¹⁵ So that cannot be the whole story. While encouraging investment may be an objective of the statute, what we have seen here is that it is by no means the only objective of the statute. Given the assumptions that we have seen embedded in the statute, it may not be very well suited to that objective. Indeed, given what we have seen demonstrated in this essay, we can say at most that if the statute is intended to promote investment, it is directed to promoting investment in only a very particular type of subject matter. You cannot use copyright as a general misappropriation statute without doing enormous violence to the structure of the copyright system, and ignoring all of the limiting parameters that the statute lays out. Which is of course unfortunately exactly what the opinion in *CCC* does.

That observation leads us immediately to the "So what?" question. There is always someone in the back row—and occasionally, in the front row—of the

¹¹³ See A.J. Ayer, *Editor's Introduction*, in *LOGICAL POSITIVISM* 3, 11–12 (A.J. Ayer, ed., 1959); see also MICHAEL FRIEDMAN, *RECONSIDERING LOGICAL POSITIVISM* (1999).

¹¹⁴ See, e.g., Dan L. Burk & Brett H. McDonnell, *The Goldilocks Hypothesis: Balancing Intellectual Property Rights at the Boundary of the Firm*, 2006 U. ILL. L. REV. 275.

¹¹⁵ See Jessica Litman, *Revising Copyright for the Information Age*, 75 OR. L. REV. 19, 47–48 (1996).

lecture hall who asks the “So what?” question when the lights come up at the end of a presentation. What difference does all of this make, he asks? If this is your analysis, then what are your recommendations? How should this change our current practice? What ought we to be doing differently?

There is of course the answer that we ought to value new knowledge for its own sake; that, in this particular instance, we are better off understanding the nature of the assumptions in the copyright statute than we are not understanding them. In most disciplines, that answer is enough. If the fund of human knowledge has been enriched, then everyone is satisfied. If pure research becomes applied, so much the better, but that is not the point of it. I think that answer a perfectly adequate answer, but perhaps it will not do in this case. In law we always want to do something with our conclusions. It is something drummed into us very early in legal education. That is after all the method of prototypical student law review note: identify a problem, explicate it, and propose legislation to solve it. Tie the package up neatly.

With apologies to the law review students, I am not about to propose legislation. Most of the problems that we have already in copyright law are the result of someone proposing legislation.¹¹⁶ Each time legislation is proposed, we get a few more problems, and only rarely solve the problem that we meant to solve with the proposal.¹¹⁷ The anomalies I have pointed out here will not be resolved by legislation in any event. They are inextricably intertwined with every aspect of copyright as we know it. If we are unhappy with the underlying philosophy of the current statute, we will probably have to do away with the statute altogether. And perhaps Professor Litman is correct that we should do exactly that. But even then we will simply be substituting one set of philosophical assumptions for another. Every statute has embedded assumptions, and since we now know something more about the assumptions in our present statute, perhaps we should stick with the ones we know.

So as long as we have the current statute, it is not clear that we should *do* anything about its underlying assumptions, or at least, that we should do anything other than recognize and accept their presence. It is claimed, probably apocryphally, that Einstein defined madness as repeating the same action but expecting different results—or in other words, as ignoring determined causality. But it is equally mad to engage in differing actions and expect a consistent result. This is what the courts have been doing. Courts must be aware of the logic of copyright in order to reach results that are consistent with that logic, which I think I have demonstrated that the valuation cases decidedly are not. The value of unearthing the doctrinal structure, the reason for all the fuss, is that we must know

¹¹⁶ Jessica Litman, *Copyright Legislation and Technological Change*, 78 OR. L. REV. 275, 277 (1989); Jessica D. Litman, *Copyright, Compromise and Legislative History*, 72 CORNELL L. REV. 857, 857 (1987).

¹¹⁷ See Dan L. Burk, *Reflections in a Darkling Glass: A Comparative Contemplation of the Harvard College Decision*, 40 CANADIAN BUS. L.J. 219 (2003) (discussing the downside of legislating specialized solutions in intellectual property).

what we are about, know the underlying assumptions of copyright, if we are ever to take some of the madness out of method in copyright law.

THE PUBLIC'S RIGHT TO FAIR USE: AMENDING SECTION 107 TO AVOID THE "FARED USE" FALLACY

Wendy J. Gordon and Daniel Bahls*

I. INTRODUCTION

A. *A Wrong Direction in Fair Use Scholarship and Jurisprudence*

Under provocative titles like "Fared Use"¹ and "The End of Friction,"² commentators argue about whether or not the copyright doctrine of fair use³ should exist in a world of instantaneous transactions. As collecting societies such as the Copyright Clearance Center have become more powerful, and technologies like cellular phones and the internet have made it possible to purchase digital copies by dialing a number or clicking a mouse, the suggestion is sometimes made that fair

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¹ Tom W. Bell, *Fair Use vs. Fared Use: The Impact of Automated Rights Management on Copyright's Fair Use Doctrine*, 76 N.C. L. REV. 557 (1998).

² Robert P. Merges, *The End of Friction? Property Rights and Contract in the "Newtonian" World of On-line Commerce*, 12 BERKELEY TECH. L.J. 115, 130 (1997); see also Glynn S. Lunney, Jr., *Fair Use and Market Failure: Sony Revisited*, 82 B.U. L. REV. 975 (2002). For a powerful presentation of the view that 'market failure' as a basis for fair use should not be limited to barriers between seller and buyer, see Lydia Pallas Loren, *Redefining the Market Failure Approach to Fair Use in an Era of Copyright Permission Systems*, 5 J. INTELL. PROP. L. 1 (1997). For an interesting treatment that has some parallels to the discussion in the instant article, see Matthew Africa, *The Misuse of Licensing Evidence in Fair Use Analysis: New Technologies, New Markets, and the Courts*, 88 CAL. L.REV. 1145, 1171 (2000). Other articles on the topic are cited as we raise various issues below.

³ 17 U.S.C. §107 (2006) (fair use allows the unconsented use of a copyrighted work). Developed as a judicial doctrine, fair use was eventually codified, although Congress gave ample warnings in the legislative history that judges should continue to develop the precedent and that the statute was not meant to "freeze the doctrine." H.R. REP. NO. 94-1476, at 66 (1976).

use could or should disappear. The Second and Sixth Circuits have flirted with foreclosing fair use if a licensing market is present or possible.⁴ The presence of “traditional, reasonable, or likely to be developed markets,” they say, counts heavily against fair use.⁵ The only exception, a later decision suggests, might lie in the ill-defined category of transformative uses.⁶ For exact copies, it seems, the presence of a licensing mechanism might be fatal to fair use.⁷ This is a dangerous direction for copyright law.⁸

⁴ See *Princeton Univ. Press v. Mich. Document Servs., Inc.*, 99 F.3d 1381, 1388 (6th Cir. 1996) (where, although noting that “the existence of an established license fee system” is “not conclusive,” the court gave heavy weight to available licensing mechanisms); *Am. Geophysical Union v. Texaco, Inc.*, 60 F.3d 913, 930–31 (2d Cir. 1994) (“[I]t is not unsound to conclude that the right to seek payment for a particular use tends to become legally cognizable under the fourth fair use factor when the means for paying for such a use is made easier. . . . [A]n unauthorized use should be considered ‘less fair’ when there is a ready market or means to pay for the use.”).

On the dangers posed by this approach, see for example, James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 931–35 (2007); Loren, *supra* note 2, at 6–7 (discussing the ability of copyright owners to manipulate licensing markets). See also Wendy J. Gordon, *The ‘Why’ of Markets: Fair Use and Circularity*, 116 YALE L.J. POCKET PART 371 (2007), <http://yalelawjournal.org/2007/4/25/gordon.html> (commenting on Gibson).

⁵ *Texaco*, 60 F.3d at 936. How heavily such markets should count is unclear. Some observers see “the absence of market failure” as “the conclusive rationale for rulings against fair use” in both *Texaco* and *Michigan Documents*. Ben Depoorter & Francesco Parisi, *Fair Use and Copyright Protection: A Price Theory Explanation*, 21 INT’L REV. L. & ECON. 453, 456 (2000).

⁶ *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 614–15 (2d Cir. 2006) (resisting the notion that willingness to license will always count heavily against fair use, but seeming to limit its new insight to cases of “transformative” uses). Admittedly the *Bill Graham Archives* court gives an immensely broad reading to “transformative”—it counts as “transformative” the exact but tiny replication of copyrighted concert posters in a book about the Grateful Dead. Nevertheless, the *Bill Graham Archives* court does not go far enough.

⁷ But see Jessica Litman, *Lawful Personal Use*, 85 TEX. L. REV. 1871, 1879–1903 (2007); Pamela Samuelson, *The Generativity of Sony v. Universal: The Intellectual Property Legacy of Justice Stevens*, 74 FORDHAM L. REV. 1831, 1862–71 & 1873–75 (2006) (discussing various kinds of exact copies that should qualify as fair uses).

⁸ Copyright law needs to make clear that any reproduction—whether or not it can be seen as “transformative”—can potentially need and deserve fair use, despite the presence of an owner willing to license.

On the importance that nontransformative speech can have, see for example, Rebecca Tushnet, *Copy this Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535, 546 (2004) (discussing the importance of exact replication). See also Wendy J. Gordon, *Do We Have a Right to Speak with Another’s Language? Eldred and the Duration of Copyright*, in COPYRIGHT AND HUMAN RIGHTS 109, 127 (Paul L.C. Torremans, ed., 2004) (considering a music historian’s need to collect exact copies of a song); Wendy J. Gordon, *A Property Right in Self-Expression: Equality and*

B. One Cause of the Wrong Direction

Contributing to this dangerous direction is a set of beliefs we dub the “fared use fallacy.”⁹ “Fared use” is use for which a license is purchased, and the fallacy can be defined by the following assumptions and conclusion:

Assumption one: Fair use exists to assist copyrighted works to be employed in socially desirable ways that would not occur if the copyright owner’s consent had to be sought.

Assumption two: Any utilization of a copyrighted work that would generate social or personal value will occur in an optimal way if the copyright owner and the putative user are physically able to negotiate with each other in a setting where transaction-cost barriers between them are low. That is, if a market is physically available, imposing infringement liability on all copiers will not discourage desirable use of copyrighted works.

Purported conclusion: Therefore, so long as a market can physically occur between copyright claimant and those who wish to utilize the work, there is no need for fair use. In other words, the argument runs: as technology makes more licensing markets possible, fared use displaces fair use.

The easiest way¹⁰ to see the flaws in the fallacy is by examining its second

Individualism in the Natural Law of Intellectual Property, 102 YALE L.J. 1533, 1591 (1993) [hereinafter Gordon, *Self-Expression*] (“Sometimes particular words are essential.”).

⁹ We call the argument a “fallacy” only informally: The problem with the argument is not its logical form (which would make it a formal fallacy) but with the truth of its premises.

¹⁰ One can also dispute other aspects of the argument, including the first assumption. Matthew Africa characterizes the first assumption somewhat differently than we do. He attributes it to “the market failure theory of fair use” which he says “posits that the fair use defense should protect only those uses for which a socially beneficial transfer of rights would not occur absent a finding of fair use.” Africa, *supra* note 2, at 1148.

A note from Professor Gordon: Although I might quarrel with aspects of Matthew Africa’s analysis of my work, I think his statement implicitly captures a difficulty in my early thinking. I may have had the illusion that “a socially beneficial transfer of rights,” *id.*, existed as a static thing: that the valuable downstream use was a kind of Platonic entity whose form and content would remain untouched by the process of obtaining permissions.

One change in my perspective is an increasing realization that process matters. That is, I’ve come to appreciate more fully that the process of purchase can change the nature of what the downstream artist produces. This theme is one I have explored in several articles, see, for example, *infra* notes 22, 41 and 98), and that Daniel Bahls and I further explore here, particularly in our discussion of privacy, see *infra* Part V.A.

There is often no fixed “use”—no final draft or disk securely hidden in a drawer—for which permission is to be sought. (Copyright law can treat harshly those who make their derivative works prior to obtaining permission.) A use—a parody, a quotation, an adaptation—may have no existence except as a set of possibilities in a downstream artist’s future. To imagine that the artist’s plans for using another’s work will always remain untouched by the process of purchasing permission is a flat absurdity when one considers the complex nature of the creative process.

step, namely, the claim that so long as a market exists, optimal use of copyrighted works will occur. This claim may look plausible because it bears a superficial resemblance to the Coase theorem. However, the Coase theorem functions only if *all* transaction costs are absent, including the costs of monitoring all bargains¹¹ (a matter which we address under privacy, below) and the costs that stand between the market participants and third parties affected by the transaction.¹² An absence of market barriers between copyright seller and licensee hardly assures the absence of other transaction costs and other forms of market failure. And if such costs are present, the law can and does make a difference in resource use.¹³

Moreover, the Coase theorem never purports to claim that all socially desirable uses will occur if transaction costs are absent; the theorem merely addresses efficiency.¹⁴ Even if the absence of transaction costs could automatically ensure efficiency, justice and distributional equity will not automatically follow. For these reasons, too, it will matter what the law does. Judges need to make normative choices even where licensing is available.

The fared use fallacy accepts the notion that fair use is a legitimate response to markets beset by imperfection, but assumes that the only way a market “fails” is if the copyright claimant and the potential utilizer are blocked by transaction-cost barriers from being able to identify, contact, and negotiate with each other. In other words, under this misunderstanding, so long as *some* market exists—some forum in which buying and selling can occur—the market is not “failing” and judges can rely on private parties to spontaneously serve social ends.

The interpretation is sometimes erroneously attributed to an article that one of us wrote in 1982. That article, *Fair Use as Market Failure*,¹⁵ urged the courts to confirm that fair use was an appropriate response to situations where, if copyright were enforced over the contested usage, no licensing would occur and socially valuable use would decrease.¹⁶ In other words, the article argued that the fair use doctrine embraced, inter alia, a user liberty to make exact copies when transaction-cost barriers between user and copyright owner were so high that no licenses would be likely to result even if the copyright were enforced.¹⁷

¹¹ Ronald H. Coase, *The Problem of Social Cost*, 3 J.L. & ECON. 1, 15 (1960) (stating that the costs of contracting include the costs of “undertak[ing] the inspection necessary to be sure that the terms of the contract are being lived up to”).

¹² When a wide range of people are beneficially affected by a user’s deployment of a work, transaction costs may make those benefits “external” to the user’s licensing decision. For a discussion of the role that external benefits should play in fair use cases, see Loren, *supra* note 2, at 53–56, and Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors*, 82 COLUM. L. REV. 1600, 1630–31 (1982) [hereinafter Gordon, *Fair Use as Market Failure*].

¹³ See Coase, *supra* note 11, at 19.

¹⁴ *Id.* (placing “questions of equity apart”).

¹⁵ Gordon, *Fair Use as Market Failure*, *supra* note 12.

¹⁶ See *id.* at 1620–21.

¹⁷ *Id.* at 1618.

Such a “market barrier” rationale for fair use had been implicit in some earlier cases, notably the 1973 case of *Williams & Wilkins Co. v. United States*.¹⁸ In 1982, however, this implicit rationale had not yet been fully understood. For example, in 1981, a liberty to make exact home copies was repudiated by the Ninth Circuit Court of Appeals, despite the apparent lack of any plausible route through which such home copies could have been licensed.¹⁹ Therefore, it was important at the time to articulate that free use might appropriately be premised upon a consumer’s inability to purchase copies through any plausibly convenient mechanism. But that 1982 article never purported to displace the other justifications for fair use. (In fact, the article canvassed a number of fair use types to show how they corresponded to inadequacies of the market *other than* the inadequacy of “transaction cost barriers that prevent licenses.”)²⁰ In short, the 1982 article sought to secure a place for an additional fair use category, and show how economics could illuminate a range of fair use types, not to truncate any of the many bases for fair use.

Nevertheless, a more overweening market approach has proved attractive to several commentators, who present transaction-cost barriers between copyright claimant and potential utilizer²¹ as if they were the sole basis for fair use.²² Thus, as the internet and other licensing mechanisms now proliferate, some argue that fair use should correspondingly diminish.²³ We disagree. One category of fair use does indeed become less necessary as transaction cost barriers diminish, but the

¹⁸ *Williams & Wilkins Co. v. United States*, 487 F.2d 1345, 1353 (Ct. Cl. 1973), *aff’d per curiam by an equally divided court*, 420 U.S. 376 (1975).

¹⁹ *Universal City Studios, Inc. v. Sony Corp. of Am.*, 659 F.2d 963, 971–72 (9th Cir. 1981), *rev’d*, 464 U.S. 417 (1984).

²⁰ Gordon, *Fair Use as Market Failure*, *supra* note 12, at 1629–33 (discussing, *inter alia*, externalities, nonmonetizable interests, and anti-dissemination motives).

²¹ Obviously, transaction costs play roles beyond setting up barriers between copyright claimant and potential utilizer. Transaction costs are responsible for “externalities,” including the positive externalities generated by some users (like teachers, students, and artists) who cannot capture in their pockets all the value they generate. When such a user is the defendant, the positive externalities she generates provide another possible basis for fair use. See Gordon, *Fair Use as Market Failure*, *supra* note 12, at 1630–32; Loren, *supra* note 2, at 49–50. Our thanks go to Gideon Parchomovsky for reminding us to make this explicit.

²² Exceptions exist, of course, including Lydia Loren’s excellent article. See *supra* note 2. For Gordon’s own responses, see for example, Gordon, *supra* note 4; Wendy J. Gordon, *Excuse and Justification in the Law of Fair Use: Transaction Costs Have Always Been Only Part of the Story*, 50 J. COPYRIGHT SOC’Y U.S.A. 149–97 (2003) [hereinafter Gordon, *Excuse and Justification*]; Wendy J. Gordon, *Market Failure and Intellectual Property: A Response to Professor Lunney*, 82 B.U. L. REV. 1031 (2002). Also, for independent justifications for fair use, see for example, Wendy J. Gordon, *Reality as Artifact: From Feist to Fair Use*, 55 LAW & CONTEMP. PROBS. 93, 100–104 (1992) [hereinafter Gordon, *From Feist to Fair Use*]; Gordon, *Self-Expression*, *supra* note 8, at 1555–60.

²³ See, e.g., Bell, *supra* note 1, at 560–61.

need for fair use to address a number of other public needs remains as strong as ever.

C. *Our Goals*

In this Article, we suggest that the fair use provision, section 107, be amended to read as follows (with our new language in italics):

§ 107. The *right of fair use*

Notwithstanding *other provisions of this title*, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means [*words omitted here*], for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is *a right and* not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

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

The fact that a work is unpublished *or that a license is available for the contested use* shall not itself bar a finding of fair use if such finding is made upon consideration of *all relevant* factors.

Our primary suggestion appears in the last sentence of the proposed section 107. We suggest that Congress make emphatically clear that the availability of licensing does not foreclose the possibility of fair use. In the process of arguing that point, we will discuss some of the bases for triggering a fair use analysis that exist *independently* of the presence of high transaction cost barriers between the copyright claimant and the potential utilizer.²⁴

Secondarily, this Article suggests that the statute be amended to make clear that fair use is an affirmative right.²⁵ This may seem unnecessary because the

²⁴ A preliminary catalog appeared in Gordon, *Fair Use as Market Failure*, *supra* note 12, at 1627–36 (presenting the following categories: market barriers, externalities, nonmonetizable interests, noncommercial activities, and anti-dissemination motives).

²⁵ Prior commentators have also urged the recognition of “user’s rights” in various contexts. See, notably, Julie E. Cohen, *A Right to Read Anonymously: A Closer Look at “Copyright Management” in Cyberspace*, 28 CONN. L. REV. 981 (1996) (analyzing First Amendment basis for “right to read anonymously” and advocating congressional action to mandate an anonymity option within digital copyright management systems); Jessica

statute already specifies that fair uses are not an infringement of copyright, which is equivalent to saying that fair uses are an area of liberty. In post-Hohfeldian terms, where there is no infringement, the copyright owner has “no claim rights,” and the public has correlative “liberties.”²⁶ So the public already has liberty rights

Litman, *The Exclusive Right to Read*, 13 CARDOZO ARTS & ENT. L.J. 29, 52–53 (1994) (urging the reader to draft a model statute to safeguard, inter alia, user opportunities). Richard Stallman, in a piece of dystopic science fiction, even imagined a revolution premised in part on the desire to recapture for the people “the right to read.” Richard Stallman, *The Right to Read*, 40 COMM. ACM 85, 87, reprinted in FREE SOFTWARE, FREE SOCIETY: SELECTED ESSAYS OF RICHARD M. STALLMAN 75, 77 (Joshua Gay ed., 2d ed. 2004), available at <http://www.gnu.org/philosophy/right-to-read.html>; see also Julie E. Cohen, *The Place of the User in Copyright Law*, 74 FORDHAM L. REV. 347, 349 (2005) [hereinafter Cohen, *The Place of the User*].

Recently, the Supreme Court of Canada explicitly articulated fair use as a user’s right. CCH Canadian Ltd. v. The Law Soc’y of Upper Can., [2004] 1 S.C.R. 339, 2004 SCC 13 (Can.). This case is discussed further *infra* note 148.

²⁶ See WESLEY N. HOHFELD, FUNDAMENTAL LEGAL CONCEPTIONS AS APPLIED IN JUDICIAL REASONING AND OTHER LEGAL ESSAYS (Walter Wheeler Cook ed., Yale University Press 1923) [hereinafter HOHFELD, ESSAYS]; Wesley N. Hohfeld, *Fundamental Legal Conceptions as Applied in Judicial Reasoning*, 26 YALE L.J. 710, 746–47 (1917) [hereinafter Hohfeld, *Judicial Reasoning*]. Conversely, the copyright owner has “claim rights” in his areas of exclusivity, and in those domains the public has correlative “duties.” See HOHFELD, ESSAYS, *supra*; Hohfeld, *Judicial Reasoning, supra*, at 746–47.

Our use of terms is *post*-Hohfeldian in two respects. First, instead of “right” as a label for denominating the ability to call on the government for assistance, we prefer “claim right.” Second, instead of “privilege” as a label for denominating the freedom from governmental control, we prefer “liberty.”

To explain the first terminological change, from “right” to “claim right”: the ability to enlist governmental assistance is known in Hohfeld’s system as a “right.” Recent commentators tend to use the phrase “claim right” instead, and we follow that newer usage, thus allowing us to preserve the simple term “right,” with its rich connotative range, for more general applicability.

As Hohfeld of course recognized, the term “right” standing alone has many meanings in the law. For example, Hohfeld distinguishes “rights” from “powers” and “privileges,” yet the Hohfeldian “power” to contract is often known as the “right” to contract, and the Hohfeldian “privilege” of self-defense is often known as the “right” of self-defense. Hohfeld, *Judicial Reasoning, supra*, at 746–47. Therefore, we too will use the phrase “claim right” (instead of the simple term “right”) to denote the ability to enlist governmental power.

Regarding the second terminological change, from “privilege” to “liberty,” Hohfeld used the term “privilege” to denote an area where persons are free of governmental restraint. *Id.* He had in mind privileges like self-defense, which immunized an actor from ordinary tort liability. *Id.* More public-oriented privileges (like the freedom from governmental restraint embodied in the First Amendment) were largely outside Hohfeld’s areas of doctrinal concern. Most of us would feel awkward calling something like free speech a “privilege” since the word “privilege” connotes something that is extra or undeserved. We doubt Hohfeld intended his use of “privilege” to have such pejorative connotations—we see “privilege” as simply the word that came to mind given his doctrinal

of fair use. But that a liberty right exists at one point in time is no guarantee of its continuance, or that courts will give significant weight to the liberty right when its exercise is imperiled by newly asserted legal claims.²⁷ This Article seeks to remind the legal community that fair use is a “right” in all these senses: it is an existing liberty, to which the public has an enduring entitlement, and which deserves significant weight. These are all aspects of what the public usually means when using the term “right.”²⁸ Therefore, having the statute explicitly label fair use a “right” has advantages: the nomenclature would emphasize that the liberty of fair use is an important entitlement under both our statutory scheme and our traditions.

Courts in the preemption area sometimes have trouble seeing that fair use is a crucial part of the congressional balance.²⁹ But fair use, of course, should play a role in preemption cases—when analyzing whether federal copyright preempts a contractual or other state law claim, the courts need to inquire into whether the state law interferes with congressional policy.³⁰ Yet courts sometimes construe areas of noninfringement narrowly as if areas of nonprotection were mere

contexts. The word “liberty” is just as accurate as “privilege,” and free of the negative connotation.

“Privilege” also has another difficulty in the copyright context: historically, the term “privilege” in England referred to governmental grants—such as a royal monopoly to sell salt—that were awarded for reasons unrelated to creativity or invention. *See, e.g.*, BLACK’S LAW DICTIONARY 1217 (7th ed. 1999).

²⁷ In addition, some commentators might object to terming fair use as a “right” on varying other grounds. *See, e.g.*, the sources mentioned in Africa, *supra* note 2, at 24.

²⁸ In this assessment of how “right” is understood colloquially, we are not following the Dworkinian approach. RONALD DWORKIN, TAKING RIGHTS SERIOUSLY 26, 193 (1977) (presenting rights as “trumps” and “principles” as having “weight”).

²⁹ Elizabeth M.N. Morris, *Will Shrinkwrap Suffocate Fair Use?*, 23 SANTA CLARA COMPUTER & HIGH TECH. L.J. 237, 268 (2007) (“[C]ourts should be able to use a preemption analysis to subjugate unfair license terms by determining that the fair use test of copyright law trumps the license terms of an adhesion contract. However, recently there has been a trend to uphold these adhesion contract terms.”).

³⁰ This is a debatable proposition, because some courts seem to see a mechanical application of copyright’s statutory preemption section, 17 U.S.C. § 301 (2006), as exhausting their preemption responsibilities. But other courts apply § 301 with an eye toward congressional policy, and also recognize that congressional policy must be taken into account even if § 301 itself does not preempt. The latter inquiry is known as “conflict” preemption. Thus Maureen O’Rourke writes:

Even if a particular [state] cause of action survives a § 301 preemption analysis, it still must be evaluated for consistency with constitutional concerns because it still may be preempted if it “stands as an obstacle to the accomplishment of the full purposes and objectives of Congress.”

Maureen A. O’Rourke, *Drawing the Boundary Between Copyright and Contract: Copyright Preemption of Software License Terms*, 45 Duke L.J. 479, 534 (1995) (quoting *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)).

exceptions and without significant importance to the congressional scheme.³¹ The “rights” nomenclature may be of assistance here.

In addition, courts typically put the burden of proving fair use on the defendant³² because under the current language, fair use can too easily be classified as an “affirmative defense.” Changes in the statutory language, such as we suggest, will allow courts to make more sensitive, policy-based decisions not only on preemption, but also on burden of proof.³³

We also suggest eliminating the first few words of the fair use provision, which currently reference “the provisions of sections 106 and 106A.”³⁴ These words, enacted prior to the Digital Millennium Copyright Act (DMCA), can be interpreted to exclude DMCA defendants from calling on fair use.³⁵ The statute should not encourage a narrow reading of the fair doctrine’s applicability to the DMCA anticircumvention rules.

Our Article relegates our discussion of the DMCA issue to the footnotes. The proposition that fair use should apply (or does apply) to the DMCA has been well examined by others,³⁶ and raises some complexities beyond our current scope.³⁷

³¹ For an example, consider *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988). Bette Midler filed a state cause of action when the makers of a television commercial had a ‘sound-alike’ singer imitate Midler’s rendition of a particular song. The federal copyright statute denies the owners of sound-recording copyrights the ability to sue imitators, 17 U.S.C. § 114(b), so one would have thought that copyright would have preempted Midler’s state cause of action. Nevertheless, although the Ninth Circuit recognized the existence of the federal statute, the court gave the provision little attention and held the singer’s state cause of action not preempted. *Midler*, 849 F.2d at 462.

³² See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994); *Kelly v. Arriba Soft Corp.*, 77 F. Supp. 2d 1116, 1118 (C.D. Cal. 1999); *Sandoval v. New Line Cinema Corp.*, 973 F. Supp. 409, 412 (S.D.N.Y. 1997).

³³ See, e.g., *Africa*, *supra* note 2, at 1171 (suggesting “shifting the burden of proof to the plaintiff on the market effect factor” but also that “it would probably require a legislative amendment to the statute to effect this change”); Gordon, *Fair Use as Market Failure*, *supra* note 12, at 1624–26 (suggesting that once defendant proves market failure, “[t]he burden of going forward with proof of injury should then shift to plaintiff”).

³⁴ 17 U.S.C. § 107 (2006).

³⁵ Although some judicial language can be interpreted to suggest that fair use would not apply in any DMCA action, at least one court has expressly left that question open. See *Chamberlain Group, Inc. v. Skylink Tech., Inc.*, 381 F.3d 1178, 1199 & n. 14 (Fed. Cir. 2004) (discussing and distinguishing prior caselaw). See also *id.* at 1212 (“The statutory structure and the legislative history both make it clear that the DMCA granted copyright holders additional legal protections, but neither rescinded the basic bargain granting the public noninfringing and fair uses of copyrighted materials, § 1201(c), nor prohibited various beneficial uses of circumvention technology, such as those exempted under §§ 1201(d),(f),(g),(j).”).

Changing the language in section 107 could encourage experimentation to square fair use policies with anticircumvention policies. See e.g., *infra* note 37.

³⁶ Major sources are collected in Jerome H. Reichman, Graeme B. Dinwoodie & Pamela Samuelson, *A Reverse Notice and Takedown Regime To Enable Public Interest Uses of Technically Protected Copyrighted Works*, 22 BERKELEY TECH. L.J. (forthcoming

Our focus is on two propositions: that “fared use” cannot displace all of fair use, and that fair use is a “right.” These propositions are already true, already implicit in the statute, but need to be made explicit.

D. Roadmap

Our Article will begin by stipulating a definition for “market failure” as a triggering event for a judge to stop giving automatic deference to a copyright claimant. The Article then reaches into the core of Law and Economics and utilizes Ronald Coase’s classic notion of “reciprocal cause” to illuminate a crucial reason why all benefits should not be internalized to copyright owners. The Article then posits two potential fair users, one fully imaginary and one drawn from Bob Dylan’s autobiography. We examine how these two people might fare under bases for fair use other than transaction-cost barriers between them and the copyright claimants. We first canvass categories of fair use already found in the case law or literature, and then offer two additional ways in which requiring purchase of a license—even if some licensing could occur *sans* transaction-cost barriers between the participants—might fail to serve social interests. The Article then addresses the terminological problem—fair use as a “right.” Our Article concludes by returning to the amendments that we suggest Congress add to the Copyright Act to help courts safeguard the fair use doctrine.

Remember, a finding of market failure does not mean that the defendant should win. It only means that we cannot *automatically* trust the copyright claimant’s judgment and that the judge’s usual rigid deference to the copyright owner should give way to a more flexible inquiry into the merits—particularly when it is not certain that the owner’s claim rightfully extends to the disputed use.³⁸

2007) (manuscript at 3 n.15), available at <http://people.ischool.berkeley.edu/~pam/papers.html> (follow the title hyperlink).

³⁷ See, e.g., Dan L. Burk & Julie E. Cohen, *Fair Use Infrastructure for Rights Management Systems*, 15 HARV. J.L. & TECH. 41, 54–70 (2001); Jane C. Ginsburg, *The Pros and Cons of Strengthening Intellectual Property Protection: Technological Protection Measures and Section 1201 of the US Copyright Act*, 10, 12–17 (Columbia Law Sch. Pub. Law & Legal Theory Working Paper Group, Paper No. 07137, 2007), available at <http://lsr.nellco.org/index.html> (follow “Columbia Public Law & Legal Theory Working Papers,” then the title); Reichman et al., *supra* note 36, at 41–46.

³⁸ We are indebted here to Abraham Drassinower’s notion of copyright’s intrinsic limits. See Abraham Drassinower, *Authorship as Public Address: On the Specificity of Copyright vis-à-vis Patent and Trade-Mark*, 2008 MICH. ST. L. REV. (forthcoming Feb. 2008).

II. WHY MARKETS CAN BE USEFUL—AND WHEN THEY ARE NOT

A. *What We Mean by “Market Failure”*

For our purposes, a market fails whenever we cannot trust it as an allocator of social resources. The failure could be a technical failure, such as one arising out of the presence of transaction costs, strategic behavior,³⁹ or income and endowment effects.⁴⁰ Or the failure can be a larger matter, such as the inappropriateness of using market transactions in a given context. A comparative institutional analysis can show that, at least in some contexts, markets are a less appropriate way of encouraging creativity and dissemination than are alternative modes, such as informal norms of reciprocity or gift.⁴¹ In short, although economists use “market failure” in a narrower sense than that adopted here, we will employ the term to identify any characteristics that would erode the conditions under which the market’s “invisible hand” will automatically direct resources as society would prefer.

B. *When Markets Are Useful*

Note that we emphasize the market’s failure to “automatically” function in a desirable way. This issue is one of appropriate delegation. As Morris Cohen pointed out, property is an area where the government delegates some of its decision-making power—cedes some of its sovereignty—to the owner, a private party.⁴²

“Delegation of sovereignty” means that owners’ decisions are automatically enforced, without judicial second-guessing. Such delegation of sovereignty—deference to property owners—can serve efficiency because often private parties can employ local information to make decisions about resource use that serve not only their private interests but also the public interest in having resources valuably employed. In essence, when the market is working properly, private actors do a better, less-costly job of distributing resources than a typical government regulator can. The government can step back and allow property owners to do their private balancing of costs and benefits through decisions to buy, sell, and license, so long

³⁹ Some commentators would consider strategic behavior a kind of transaction cost. See Robert Merges, *Intellectual Property Rights and Bargaining Breakdown: The Case of Blocking Patents*, 62 TENN. L. REV. 75, 82 (1994) (“[T]he Coase Theorem overlooks strategic behavior itself as an important transaction cost.”).

⁴⁰ See *infra* notes 99–100.

⁴¹ See generally YOCHAI BENKLER, *THE WEALTH OF NETWORKS, HOW SOCIAL PRODUCTION TRANSFORMS MARKETS AND FREEDOMS* (2006); LEWIS HYDE, *THE GIFT: IMAGINATION AND THE EROTIC LIFE OF PROPERTY* (1983); Wendy J. Gordon, *Render Copyright unto Caesar: On Taking Incentives Seriously*, 71 U. CHI. L. REV. 75 (2004) [hereinafter Gordon, *Caesar*].

⁴² See generally Morris R. Cohen, *Property and Sovereignty*, 13 CORNELL L.Q. 8 (1927).

as the market structure is serving the public interest. When market structures cannot be relied upon to promote social goals, however, this justification for the delegation of sovereignty also fails. The government then typically steps in to reassert its sovereignty, and has one of its agents (for example, a judge) weigh the costs, benefits, and justice of the disputed action.

C. When We Cannot Trust the Invisible Hand, We Look More Closely

Thus, as we catalog some of the many places where markets are inadequate, we are also cataloging reasons why automatic deference to owners' wishes—that is, delegating sovereignty to owners—is inappropriate. As was emphasized earlier, lack of deference to a rights holder's private decision-making is not the same thing as saying the defendant should always win. Rather, it means that a decision-maker other than the property owner should judge whether the public interest is best served by enforcing, or not enforcing, the copyright. The presence of market failure, therefore, does not trigger the grant of fair use to a defendant. It triggers a judicial examination of the merits.⁴³

In the language of the common law, the presence of market failure essentially transforms a "trespass" inquiry into a "reasonableness" inquiry. Thus, for example, when two drivers accidentally collide in the tangible world, their lack of intention triggers a judicial inquiry into the reasonableness of their behavior.⁴⁴ Reasonableness requires a decision by judge or jury as to the normative merits of the parties' behavior.

In copyright, a quasi-reasonableness inquiry can be triggered by factors that are far subtler than a lack of intentionality. This should not surprise us. The copyright market is itself a compromise institutional solution. Plagued by deadweight loss, copyright markets are incapable of "perfection." Moreover, if a copyright owner makes the wrong decision, the stakes are particularly high given

⁴³ The merits include both the value of the contested use, and the appropriateness of defendant's decision to bypass the market. See Gordon, *Excuse and Justification*, *supra* note 22.

Note that fair use may involve judges in making some decisions that go beyond the standard *Bleistein* vision of judicial neutrality on aesthetic matters. Compare *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.") with Robert P. Merges, *Are You Making Fun of Me? Notes on Market Failure and the Parody Defense in Copyright*, 21 AIPLA Q. J. 305, 312 (1993) ("[D]octrines of copyrightability—notably the requirements for registration and 'originality'—have developed with an eye towards value neutrality. It seems impossible to remain neutral in the same sense when assessing whether a work is 'really' a parody . . ."); see also Alfred Chuh-Yih Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247 (1998). Addressing this issue would take us beyond the scope of the current Article.

⁴⁴ Guido Calabresi & A. Douglas Melamed, *Property Rules, Liability Rules, and Inalienability: One View of the Cathedral*, 85 HARV. L. REV. 1089, 1127 (1972).

that free speech and democratic participation can be at risk.⁴⁵ Additionally, unlike a stranger's unconsented consumption of an owner's scarce tangible property, a stranger's unconsented use of a copyrighted work might not cause harm to the owner.

Moreover, the delegation (deference to owners) that one sees in the tangible realm should not be overstated. Nuisance law, for example, is often governed by reasonableness inquiries, even when the actors behave intentionally.⁴⁶ In the realm of tangibles, when problems that afflict copyright arise—such as holdouts and other strategic behavior—the law typically responds with a lack of deference, and judges reassert the sovereignty of the government as the decision-maker.⁴⁷

Peñalver and Katyal even argue that while a “delegation” architecture is characteristic of tangible property, an “anti-delegation” architecture is characteristic of copyright.⁴⁸ So it is no wonder that, as compared with the yes/no questions presented by trespass claims over realty (“Did the defendant cross the boundary or did he not?”), fair use and cognate doctrines require copyright judges to engage in nuanced decisions that assess, on a virtually all-things-considered basis, whether the defendant has appropriately bypassed the market.

D. Recap

An owner's unwillingness or inability to license can trigger fair use,⁴⁹ but the converse does not follow. The copyright owner's willingness to license a particular use does not necessarily mean that the copyright owner has a right to control that use. Even if an owner is *willing* to license, the law may give him no claim right to demand a license. On the contrary, the putative user of the copyright work may have a fair use entitlement.

There are many places where, despite the potential for licensing, our society cannot afford to rely on an owner's self-interest to further the public interest. The copyright statute should make this even clearer than it already does.⁵⁰

⁴⁵ See, e.g., C. Edwin Baker, *First Amendment Limits on Copyright*, 55 VAND. L. REV. 891, 948–49 (2002); Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283, 285, 352 (1996); and the additional sources cited *infra* note 63.

⁴⁶ See, e.g., RESTATEMENT (SECOND) OF TORTS § 821B (1979).

⁴⁷ Holding out and other strategic behaviors motivate takings law—that is, the government's freedom to take property with compensation, but against the owner's will.

⁴⁸ Fair use is only one of the “anti-delegation” characteristics they see in copyright law. See SONIA KATYAL & EDUARDO M. PEÑALVER, *PROPERTY OUTLAWS II: FREE(DOM) RIDING IN THE AGE OF INTELLECTUAL PROPERTY* 9 (forthcoming 2008) (“delegation” architecture can be defined as a system of law which “delegates a variety of key gatekeeping function to the owner”).

⁴⁹ See Gordon, *Fair Use as Market Failure*, *supra* note 12, at 1628–30, 1632–35 (discussing anti-dissemination motives and transaction-cost barriers).

⁵⁰ We believe our suggested change in language is not *necessary* to give proper scope to the fair use doctrine. The language would largely serve as a reminder, making it easier

In this Article, we shall briefly recapitulate some of the well known (and not so well known) categories upon which commentators or courts have suggested fair use can be premised. Then we explore two considerations in depth. One, privacy, has been mentioned in the literature before, but needs further development; the second, ‘packaging,’ seems not to have been previously examined in the fair use context. All of the fair use categories are consistent with three recognitions:

1. That copyright law employs the devices of property rights and markets to accomplish certain goals.
2. That certain identifiable characteristics can, when they appear in specific cases, make markets less likely to accomplish these goals.
3. That the presence of high transaction costs impeding bargains between copyright claimant and potential utilizer is only one of many such characteristics.

III. “DOWNSTREAM” AUTHORS AS EFFICIENT DECISION-MAKERS

The fundamental reason why broad fair use is crucial to both economic health and cultural flourishing can be seen in one of the articles that gave birth to the Law and Economics movement: *The Problem of Social Cost* by Ronald Coase.⁵¹ In that article, Coase criticized the Pigovian notion that all costs of a polluting activity should automatically be borne by the factory.⁵² Sometimes a factory can make a cost-effective reduction in pollution, either by adopting filters or by reducing overall production, but sometimes it cannot; sometimes the downstream neighbors could avoid the pollution more easily and cheaply, perhaps, for example, by hooking up to the city water system instead of washing their clothes in the river.

To restate the Coasian lesson, taking it from the context of land-based nuisances like pollution, and adapting it to the new context of copyright law: Do not assume that the most obvious active party (the copyright owner) is the one to whom all the effects should be internalized.⁵³ Sometimes the downstream author or user is in a position to take value-enhancing steps, and she needs incentives to do

for future judges to avoid the occasional errors of some past decisions that improperly limited fair use. *But see supra* note 33 (regarding burdens of proof).

⁵¹ Coase, *supra* note 11.

⁵² *Id.* at 12–17. Coase’s “theory of the firm” also has profound implications for copyright. RONALD H. COASE, *THE FIRM, THE MARKET, AND THE LAW* 40–47 (1988). Using Coase’s theory of the firm, Yochai Benkler argues for decentralized modes of social production. *See* Yochai Benkler, *Coase’s Penguin, or, Linux and The Nature of the Firm*, 112 *YALE L.J.* 369, 375–76 (2002). The classic statement of the opposing stance—arguing that many intellectual products require centralization rather than decentralization—is Edmund Kitch, *The Nature and Function of the Patent System*, 20 *J.L. & ECON.* 265, 285–86 (1977).

⁵³ *See* Wendy J. Gordon, *Ronald Coase*, in *THE NEW OXFORD COMPANION TO LAW* (P. Cane & J.A.F. Conaghan, eds., forthcoming 2008).

so.⁵⁴ Therefore, some privileges should be left to that downstream person; the law should allow the downstream person to keep some of the benefits, so that she will have incentive to take productive steps herself.

Comparing the incentives for upstream and downstream actors yields one of the reasons copyrights expire. Consider the impact if Shakespeare's multitudinous descendants owned copyright in the plays. How would it have complicated efforts to mount *West Side Story* if Shakespeare's heirs had been able to capture much of the profit because of the play's obvious use of plot sequences from *Romeo and Juliet*? And what of Jane Smiley's best-selling novel, *A Thousand Acres*? In that book, for which she received a Pulitzer Prize, Smiley interprets *King Lear* in a way sympathetic to the ungrateful daughters: the father has indulged in sexual abuse. Conceivably, Shakespeare's heirs might have tried to suppress Smiley's novel.⁵⁵ And for what purpose would society give heirs such power? It is hard to imagine that the prospect of his family having infinite control over his works would have provided Shakespeare appreciable incentives.⁵⁶

The need to allow productivity to flower in non-centralized hands is not only served by the durational limit; it is also one of the prime reasons for the fair use doctrine. It would be a serious error to allow all benefits to be internalized by the copyright owner.⁵⁷

Copyright law imposes a loss of liberty with consequences that monetary payments may not satisfy. Creative production may need a kind of freedom inconsistent with the bureaucratic record keeping that licensing requires.⁵⁸ The possibility of merely a monetary surplus may not be sufficient to encourage the kind of spontaneous play⁵⁹ among second-generation creators that we need.⁶⁰

⁵⁴ See Wendy J. Gordon, *Copyright As Tort Law's Mirror Image: "Harms," "Benefits," and the Uses and Limits of Analogy*, 34 MCGEORGE L. REV. 533, 535, 537 (2003).

⁵⁵ See, e.g., Thomas Babington Macaulay, A Speech Delivered in the House of Commons (Feb. 5, 1841), available at <http://www.baen.com/library/palaver4.htm> (discussing the possibility that James Boswell's descendants might have refused to allow republication of the *Life of Johnson*).

⁵⁶ In fact, the issue of duration did not arise at all; Shakespeare's life predated the first English copyright statute.

⁵⁷ For some of the additional reasons why it is unwise to internalize all benefits to one party, see for example, William W. Fisher, *Theories of Intellectual Property*, in NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROPERTY 168 (2000) (discussing Glynn Lunney, Jr., *Reexamining Copyright's Incentives-Access Paradigm*, 49 VAND. L. REV. 483 (1996)), available at <http://cyber.law.harvard.edu/people/ffisher/iptheory.pdf>. Also, as Landes and Posner point out, every increase in this generation's copyright increases the cost of creating for the next generation, who must use what came before. William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 334 (1989).

⁵⁸ The need to obtain advance permission may "distort the borrower's creative impulse." Gordon, *Caesar*, *supra* note 41, at 82; see also Cohen, *supra* note 25, at 372-73.

⁵⁹ On the importance of play, see, for example, David Lange, *Reimagining the Public Domain*, 66 LAW & CONTEMP. PROBS. 463, 481 n.63 (2003); David Lange, *At Play in the*

Also note that many forms of incentives and remuneration are possible.⁶¹ In emphasizing the need for downstream liberty—and the need for downstreamers to keep some of the benefits they generate—we hardly gainsay that authors need money to live. The question is not “money or freedom,” but rather, what institutional schemes give us the best possible mixture of monetary incentives to create, and the liberty needed to create.⁶² Fair use, a tool for allowing flexibility within the dominant market model, is an essential part of the institutional arsenal.

IV. A PAIR OF HYPOTHETICALS AND A CATALOG OF FAIR USE TYPES

We proffer two potential fair users—a songwriter named Dylan and a scholar named Janine—and will refer back to their situations as we review various fair use rationales. As for the set of categories against which we will measure the potential fair users, it is best to begin with the Supreme Court’s reminder that fair use has a constitutional dimension that sounds in free speech.⁶³ Fair use constitutes one of the Copyright Act’s “traditional First Amendment safeguards.”⁶⁴

Fields of the Word: Copyright and the Construction of Authorship in the Post-Literate Millennium, 55 LAW & CONTEMP. PROBS. 139, 146–50 (1992); David Lange, *Recognizing the Public Domain*, 44 LAW & CONTEMP. PROBS. 147, 175–76 (1981). (Although this is a painfully unplayful footnote.)

⁶⁰ For discussion of how bureaucratic and monetary constraints can inhibit the muse, see, for example, HYDE, *supra* note 41, at 5.

⁶¹ See Benkler, *supra* note 41, at 376, 433–35; Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281, 324–26 (1970).

⁶² Even the monetary issue leads to limiting copyright. See Landes & Posner, *supra* note 57, at 331–33. Securing monetary returns via copyright ownership increases incentives to one generation, but increasing those returns raises the costs of the next generation of creative persons too much. *Id.* In Strahlivetz’s witty words, this “introduce[s] a useful sort of Laffer curve to the analysis of innovation policy.” Lior Jacob Strahilevitz, *Wealth Without Markets*, 117 YALE L.J. 1472, 1481 (2007) (reviewing Benkler, who made a point similar to Landes & Posner’s). A better (if less witty) analogy than the “Laffer curve” might be Guido Calabresi’s search for a *system* that minimizes the costs of accidents: as Calabresi emphasized, reducing one kind of cost (e.g., discouraging fast driving) often increases other kinds of costs (such as enforcement costs and pedestrian carelessness), so the search is for a method of calibrating the interrelated cost-benefit functions to generate the highest net result. GUIDO CALABRESI, *THE COST OF ACCIDENTS: A LEGAL AND ECONOMIC ANALYSIS passim* (1970).

⁶³ The literature exploring the relation between the First Amendment and fair use is rich. See, e.g., Baker, *supra* note 45; David Lange, *Reimagining the Public Domain*, 66 LAW & CONTEMP. PROBS. 463 (2003); Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. (2001); Jed Rubinfeld, *The Freedom of Imagination: Copyright’s Constitutionality*, 112 YALE L.J. 1 (2002).

⁶⁴ *Eldred v. Ashcroft*, 537 U.S. 186, 219–20 (2003) (upholding the Copyright Term Extension Act against constitutional challenge).

Thus, the Court views fair use as a “First Amendment accommodation[.]” that is “built-in”⁶⁵ to the Copyright Act and helps preserve copyright’s constitutionality.⁶⁶ Although it is conceivable that in some cases the availability of licenses can satisfy First Amendment concerns,⁶⁷ this might not often be the case. When monetary markets cannot accommodate free speech interests, fair use must be available despite the presence of licensing markets.

Fair use does not only render service where copyright claims threaten First Amendment goals. Other situations may be mishandled unless fair use is available. Of those already in the literature, we will discuss: patterns of creative production that are not consistent with bureaucratic behaviors; anticommons, hold-out and bilateral monopoly problems; distributional inequities; positive externalities; use of another’s work not as expression but as a fact; use of another’s expression as a means to access the public domain; and critical, nonmonetizable and/or “priceless” uses of copyrighted works. We also present two additional purposes that fair use may serve despite the availability of licensing: preserving an expectation of privacy and encouraging the development of efficient rights packaging.

This list is not exhaustive. Some additional forms of fair use (such as using another’s copyrighted work in self-defense)⁶⁸ do not adapt well to our hypotheticals. But the many examples we do canvass should more than demonstrate that the mere possibility of licensing does not satisfy all the constitutional, social, and moral needs to which fair use responds.⁶⁹

⁶⁵ *Id.*

⁶⁶ The copyright provisions challenged in *Eldred* were upheld in part because the Court felt confident that fair use could serve First Amendment goals: “[W]hen, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.” *Id.* at 221

⁶⁷ In *Zacchini v. Scripps-Howard Broadcasting Co.*, the availability of licensing constituted part (but not all) of the basis on which the Supreme Court upheld a state right of publicity claim against constitutional challenge. 433 U.S. 562, 573–74 (1977). The Court stated:

[I]n ‘right of publicity’ cases the only question is who gets to do the publishing. An entertainer such as petitioner usually has no objection to the widespread publication of his act as long as he gets the commercial benefit of such publication. Indeed, in the present case petitioner did not seek to enjoin the broadcast of his act; he simply sought compensation for the broadcast in the form of damages.

Id.

⁶⁸ See sources discussed *infra* note 141.

⁶⁹ Our strategy is not unique. For example, Mathew Africa and Lydia Loren give examples of situations where fair use is needed despite a possibility of licensing. Africa, *supra* note 2 at 1167 (discussing markets for criticism); Loren, *supra* note 2, at 47–57 (identifying “societal benefits [that] are impossible to internalize in any bargained-for exchange between the copyright owner and the user”).

Now let us turn to the two potential fair users and their situations. The first situation is based on an event in the life of Bob Dylan.

A. *Bob Dylan Studies a Song*

Bob Dylan recounts how he took some of his early steps toward becoming a songwriter. Fascinated by the Brecht/Weill composition “Pirate Jenny,”⁷⁰

I found myself taking the song apart, trying to find out what made it tick. . . . I took the song apart and unzipped it—it was the form, the free verse association, the structure and disregard for the known certainty of melodic patterns to make it seriously matter, give it its cutting edge. It also had the ideal chorus for the lyrics. I wanted to figure out how to manipulate and control this particular structure and form which I knew was the key that gave “Pirate Jenny” its resilience and outrageous power.⁷¹

Let us assume that Dylan wrote down the complete lyrics and musical score. Few of us would think Dylan would have violated copyright in making these copies by hand.⁷²

Would our answer change if there were a website where potential songwriters who wanted to hand-copy lyrics or music could purchase a license to do so?

⁷⁰ “Pirate Jenny” is a famously bitter song by Brecht and Weill. Written in the 1920s, and encountered by Dylan decades later, the song for Dylan was a new kind of experience that opened up a range of creative possibilities previously unglimped. See BOB DYLAN, CHRONICLES: VOLUME ONE 273–76 (1971).

What we assume Dylan did—writing down someone else’s text word for word—is neither unusual nor trivial. At least one English department regards as a “secret bible” the 1920 book by Robert Gay, *Writing Through Reading*. Gay urges the rewriting of others’ prose as one of the best methods for students to learn to write and read well. ROBERT M. GAY, WRITING THROUGH READING xvii (1920) (“Reproducing thought which you read has several definite advantages over original composition.”). For some uses of Gay’s work in the classroom, see, for example, <http://www.yale.edu/ynhti/curriculum/units/1979/4/79.04.01.x.html>.

⁷¹ DYLAN, *supra* note 70, at 275–76.

⁷² *But see* 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05[E][4][d] (2007) [hereinafter NIMMER ON COPYRIGHT] (explaining that there are no reported cases determining “whether a single handwritten copy of all or substantially all of a book or other protected work made for the copier’s own private use is an infringement or fair use” and arguing that although “force of custom might impel a court to rule for the defendant on the ground of fair use,” that result “could not be reconciled with the rationale for fair use”).

B. Janine Studies Aristotle

Our second, more ornate example comes from our imaginations, though we think it plausible. We posit a young scholar named Janine. Janine is preparing an essay on Aristotle's *Poetics*.⁷³ Although she can not read Greek—she only understands French and English—Janine does not want to be overly influenced by any one translator's interpretation of Aristotle. To the contrary, she wants to be in a position where she can comment intelligently on the various translations that are currently influential in her field.

As an initial stage in her research, she plans to make a chart showing alternative translations for every Greek paragraph. Accordingly, she pays for and downloads the major translations of the *Poetics* that exist in English and French, in electronic versions.⁷⁴ One translation, we shall assume, is in the public domain because its copyright has expired. The copyrights in the other translations, we shall assume, have not expired.

After Janine downloads the electronic books she reads each of them, at least in part, many times. She then uses the copy function to paste the full text of each into her word processor. In the process she loses the formatting and page numbers that had been in the uneditable version, but she does not mind. She can now move the English and French texts around, highlight what she needs to highlight, and insert comments as she thinks of things to include in her essay.

She then copies the relevant portions of the many translations into a master chart, making sure to match up the varying translations in French or English with the corresponding Greek paragraph to the extent possible. Finally, she begins to

⁷³ We chose *Poetics* with malice aforethought. Our topic is the utility of copying, and Aristotle emphasized that copying and imitation ("mimesis") was foundational to all art. ARISTOTLE, *POETICS*, ch. 4, reprinted in 2 THE COMPLETE WORKS OF ARISTOTLE 2316, 2318 (Jonathan Barnes ed., Ingram Bywater trans., Princeton Univ. Press 1984) ("Imitation is natural to man from childhood, one of his advantages over the lower animals being this, that he is the most imitative creature in the world, and learns at first by imitation.").

⁷⁴ When we mention the purchase of intellectual products sold for computers, we stumble into the area of things putatively controlled by various licensing agreements. Leaving the technicalities of contract formation aside, such as whether a click-wrap, browse-wrap, or a vaguely-co-exist-wrap license is properly accepted, we meet questions of how broadly copyright preemption should be applied. See 17 U.S.C. § 301 (2006). We later touch on the possibility that Janine has contracted away some of her fair use rights, but do so only briefly, *infra* note 122 and accompanying text. While we believe that fair use can play a role if copyright owners tried to limit Janine's rights by contract, fully exploring this role would take us outside the scope of this Article.

For the moment, let us set aside the issue of whether contract or copyright should control in Janine's case. Instead, we can focus on the following questions. Assuming that no contract controls a particular use (whether from failure to form a contract, failure to plead a contract-based cause of action, silence of an otherwise controlling contract on a particular issue, copyright preemption, or any other reason) what are the respective rights and privileges of the parties?

write her essay, including in it many (duly-cited) lengthy quotations from the translations.

None of Janine's actions, at first glance, seem at all unethical or unfair. As for lawfulness, clearly she is behaving lawfully when she copies into her word processor the translation whose copyright has expired, and quotes from it. However, the copyright law gives the copyright owners of the other translations an exclusive right of reproduction⁷⁵ and of making derivative works.⁷⁶ Copyright law might or might not prohibit her from moving the text into a word processor, from creating her chart of differences, from quoting from the translations she discusses,⁷⁷ and possibly even from rereading the books too many times.⁷⁸ She is making unlicensed⁷⁹ reproductions of, and unlicensed derivative works from, copyrighted works.⁸⁰

⁷⁵ 17 U.S.C. § 106(1) gives copyright owners an exclusive right to copy. Moving a text to a word processor literally, if not in spirit, implicates this right, even if Janine destroys the original digital version and simply substitutes the new platform for it. First a copy is made in RAM, which many courts consider making a copy (despite legislative history to the contrary), and then she makes a copy to her hard disk. On the "right to read," we are indebted to the work of Jessica Litman and Richard Stallman. *See supra* note 25; *infra* text accompanying note 146.

⁷⁶ 17 U.S.C. § 106(2).

⁷⁷ Scholarly quotation is well recognized as a fair use. Our angle of inquiry asks whether this well-recognized liberty should vanish if copyright owners stood ready to license it.

⁷⁸ Some commentators see an "exclusive right over reading" arising out of the conjunction of the reproduction right, 17 U.S.C. § 106(1), with a few court cases such as *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 518–19 (9th Cir. 1993), which have viewed making a copy into RAM (which a computer must do every time it reads a file) to be sufficiently nontransitory to constitute "copying" under § 106. Thus, even if Janine owns a digital copy of a book, it might constitute civil copyright infringement for her to reread it. *See generally* Litman, *supra* note 25 (discussing copyright issues raised during use of the Internet). Additionally, the "one read" license might not be terribly far away. Microsoft's Zune music player allows users to send songs from one Zune to another, which can then be sampled "up to three times in three days." Zune to Zune Sharing, <http://www.zune.net/en-us/meetzune/zunetozunesharing.htm> (last visited Nov. 28, 2007). We can assume that each digital copy Janine downloads comes bundled with an implicit or explicit license to read it at least once—and probably more than once—otherwise nobody would buy it. *See* Yannis Bakos, Eric Brynjolfsson & Douglas Lichtman, *Shared Information Goods*, 42 J.L. & ECON. 117, 142–44 (1999). However, if one book is licensed to be read five times (and to minimize the contract preemption issue mentioned in note 74, contains no provision expressly limiting Janine to reading it only five times) would a sixth reading violate the copyright law?

⁷⁹ Note that the word "unlicensed" in this context does not mean illegal or unpermitted. It merely means that the copies would not be made with the permission of the copyright holder. This Article investigates whether Janine needs the permission of the copyright holder.

⁸⁰ If not for the fair use doctrine, copying and pasting would be a violation of the copyright owner's reproduction right. 17 USC §§ 106(1), 107. In addition, Janine will soon

Is Janine's behavior an infringement of copyright or is it instead lawful as a "fair use"?⁸¹ Should the answer change if the electronic book publisher is willing to sell Janine a license⁸² to make additional copies and derivative works?⁸³ Must Janine pay these license fees, or is the publisher simply trying to sell her rights she already has?

C. How Our Hypotheticals Fare

In our hypotheticals, transaction cost barriers between the copyright claimant and potential utilizer are low.⁸⁴ Nevertheless, both utilizers—Bob Dylan and

be making a derivative work from each of those translations as she makes her comparative charts and inserts her various comments and changes. *Id.* § 106(2). Making derivative works is another behavior that the law appears to place within the copyright owner's exclusive ken. *Id.* If not for the fair use doctrine, this would be a violation of the copyright owner's right to make derivative works. *Id.*

⁸¹ At least one court has indicated, in dicta, that some of these behaviors are fair uses. In a DMCA case, the court observed: "The conversion accomplished by the [contested] program enables a purchaser of an ebook to engage in 'fair use' of an ebook without infringing the copyright laws, for example, by allowing the lawful owner of an ebook to read it on another computer, to make a back-up copy, or to print the ebook in paper form." *United States v. Elcom Ltd.*, 203 F. Supp.2d 1111, 1118–19 (N.D.Cal. 2002). The *Elcom* court then went on to note that "[t]he same technology, however, also allows a user to engage in copyright infringement," *id.* at 1119, and upheld an indictment under the DMCA that alleged "trafficking in and marketing of" the program, *id.*, against motions to dismiss that had raised constitutional challenges to the DMCA.

⁸² Suppose, for example, Janine copied the text of the first three books without any difficulties, but a window popped up when she attempted to copy the text of the final book. The window read: "Do you want to do more than read the PDF version you have purchased? If so, additional charges apply. The publisher has reserved its exclusive rights, including the right to make copies and derivative works. If your copy is exclusively for personal use, the publisher is willing to sell you a license to make additional copies for \$1.50 per page. You may enter a credit card number below."

The blurb in the window continued: "For derivative works recasting or transforming our copyrighted work, the price for each page used by you is \$2.50, plus ten per cent of your gross revenues. For the preparation of derivative works, in addition to entering your credit card, enter the name of your project and the person in your enterprise capable of receiving service of process. We will contact that person once every three months to obtain progress reports and a statement of your gross revenues, if any."

⁸³ We might also ask about access restraints: if Janine's software prevents her from accessing this copy, is it unfair or illegal for her to find some kind of technological work-around in order to get a text she can edit? If she modifies the access-control file, she may violate the DMCA's anticircumvention rule. *See id.* § 1201(a)(1)(A) ("No person shall circumvent a technological measure that effectively controls access to a work protected under this title."). *But see supra* notes 35–37.

⁸⁴ Admittedly, in our later discussion, the possibility arises that Janine may find all of her digital books accompanied by confusing licensing terms. This raises the possibility of a new kind of transaction cost barrier: the time and frustration for Janine having to decipher

Janine—have good claims to fair use.⁸⁵ First we will mention some bases for their fair use claims already found in the literature, and then advance two additional bases for fair use: encouraging the development of efficient rights packaging and preserving an expectation of privacy. Note that all these bases for fair use can be characterized as forms of market failure *other than* the presence of transaction-cost barriers between copyright claimant and utilizer.

Let us start by canvassing bases already recognized in the literature. First, regarding Dylan, the bureaucratic process of obtaining permission is likely to chill creative experimentation.⁸⁶ That means that the market may not be a good institution to employ here, and that instead the courts should allow a formal liberty, one regulated only by informal norms such as cooperative reciprocity or generative gratitude among artists.

Second, if Janine wants to do a truly scholarly job, she needs to make reference to all the respected translators. This gives any one of them a potential hold-out power. Analogous to an anticommons problem, holdout and bilateral monopoly problems are potentially powerful bases for fair use.⁸⁷

Third, both Janine and the young Dylan are unlikely to have in their pockets money reflecting the ability of their use to serve social welfare. Both on distributional grounds,⁸⁸ and on the ground that they are generators of positive externalities,⁸⁹ they may have claims to fair use.

Fourth, the translations are “facts of life” in Janine’s field, and her essay would not be complete without extensive quotation and analysis of the leading authorities. She should be shielded in her efforts to use facts, even when the facts are manmade.⁹⁰

such licenses—or the cost of uncertainty if she clicks assent without reading. Reading notices is something for which very few consumers have time. It strains cognitive and attentional abilities. *Cf.* Howard Latin, “Good” Warnings, *Bad Products, and Cognitive Limitations*, 41 UCLA L. REV. 1193, 1206–57 (1994) (discussing warnings and notices in the product liability arena).

⁸⁵ In addition to the factors mentioned in the text, Dylan and Janine’s activities are not likely to harm the expected, normal markets of the songwriters and translators, or their assignees. But since we are trying to break the circularity of the “licensing analysis,” we will leave that out of the equation for now. *See* Gordon, *supra* note 4, at 371–76.

⁸⁶ Gordon, *Caesar*, *supra* note 41, at 89; *see also* Cohen, *The Place of the User*, *supra* note 25, at 371 (making the same point).

⁸⁷ On strategic behavior as a source for fair use, *see* Merges, *supra* note 2, at 133 (noting that strategic behavior includes bilateral monopoly); Ben Depoorter & Francesco Parisi, *Fair Use and Copyright Protection: A Price Theory Explanation*, 21 INT’L REV. L. & ECON. 453, 458–59 (2002) (discussing holdout and anticommons problems).

⁸⁸ Molly Shaffer Van Houweling, *Distributive Values in Copyright*, 83 TEX. L. REV. 1535, 1539–40 (2005).

⁸⁹ *See* Loren, *supra* note 2, at 49–50; Gordon, *Fair Use as Market Failure*, *supra* note 12, at 1630.

⁹⁰ *See* Gordon, *From Feist to Fair Use*, *supra* note 22, at 93–94.

As a matter of subject-matter classification, facts are not ownable under copyright, while expressive texts can be owned.⁹¹ But the same text can have different ontologies. What is communication of truth in one context, can in another context be a mere fact about what was stated. This is something that evidence law recognizes: it outlaws as hearsay only those third-party statements that are presented to prove “the truth of the matter asserted.” When third-party statements are presented for the purpose of proving other facts, evidence law treats them as nonhearsay.

The fair use doctrine thus serves to honor the public interest in access to texts when they are acting not as communicators but as facts. When someone replicates a text that is *ordinarily* expressive not (or not solely) for its original communicative message, but rather to show that the text exists and to examine its impact, the fair use doctrine should be available to handle the crucial shift in the text’s ontological nature.⁹²

And fair use does often serve this function. A newspaper was sheltered by fair use when it printed a copyrighted photo that lay at the center of a controversy,⁹³ and a litigant is generally sheltered by fair use when she makes copies of copyrighted documents whose content is factually at issue in the litigation.⁹⁴

Fifth, Janine is essentially seeking to understand an artifact of Western culture, the public domain text by Aristotle. She is like a programmer seeking to understand the public domain ideas within a copyrighted program: if the only practical way to gain access to the public domain is to copy, *Baker v. Selden*⁹⁵ and the reverse engineering cases teach us that the person seeking a public-domain use

⁹¹ 17 U.S.C. § 102.

⁹² This summarizes the argument made in Gordon, *From Feist to Fair Use*, *supra* note 22.

⁹³ *See* Núñez v. Caribbean Int’l News Corp., 235 F.3d 18, 22–23 (1st Cir. 2000).

⁹⁴ *See, e.g.*, 4 NIMMER ON COPYRIGHT, *supra* note 72, at § 13.05[D][2]. This can extend to computer code. *Tavory v. NPT, Inc.*, 495 F. Supp. 2d 531, 538–39 (E.D. Va. 2007) (“[T]he character of the use was not commercial, nor was the potential market for or value of the software source code impaired. To the extent that the code was reproduced in anticipation of or preparation for litigation, that use was a fair use and there can be no liability for infringement.”). The court continued in a footnote:

The Plaintiff has cited authority for the proposition that the use of copyrighted material in the course of litigation may fall outside the ambit of fair use, and thus expose the party who uses the copyrighted material to liability for infringement. . . . The Court does not presume to announce a rule that categorically shields litigants from copyright liability through fair use. But where, as here, the works produced before the Court are material to the litigation, and where the party offering production of the work has done so without notice or knowledge of another’s claim to copyright, the equities are in favor of fair use.

Id. at 539 n.10 (citation omitted).

⁹⁵ 101 U.S. 99, 107 (1879).

might be able to employ others' copyrighted expression.⁹⁶ A liberty like the one allowed for purposes of reverse engineering in search of uncopyrightable ideas should be given, in at least some contexts, to a search for the meaning of public domain texts.⁹⁷

Sixth, Janine will be discussing some of the copyrighted translations critically. This obviously implicates nonmonetizable interests such as free speech. Further, the sale of "rights to criticize" could degrade the quality of criticism.⁹⁸ Moreover, permission to be criticized is a "product" that bears a high emotional charge, and we suspect that such goods are particularly sensitive to income and endowment effects.⁹⁹ This is most visible at the extreme: someone who possesses the right not to be criticized might not sell it at any price . . . but if he had to *purchase* the critic's silence, the price he could pay would be limited by his financial resources.¹⁰⁰ In such a situation, there is no neutral market that can reveal which use—the critical use or the silence—is more valuable.¹⁰¹

⁹⁶ See, e.g., *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1520 (9th Cir. 1993) (holding fair use for reverse engineering); *Sony Computer Entm't, Inc. v. Connectix Corp.*, 203 F.3d 603, 609 (9th Cir. 2000) (holding that intermediate copying that was necessary to access unprotected functional elements constituted fair use). The law of real property similarly creates rights to enter private land in order to reach public areas. See Wendy J. Gordon, Keynote, *Fair Use: Threat or Threatened*, 55 CASE WESTERN U. L. REV. 903, 907 (2005).

⁹⁷ Of course, there are additional complications to be investigated. Among other things, Janine has at least one public domain translation she can use, and she cannot call on the patent policies that probably assisted the defendant's reverse-engineering cases.

⁹⁸ See Wendy J. Gordon, *Excuse and Justification in the Law of Fair Use: Commodification and Market Perspectives*, reprinted in *THE COMMODIFICATION OF INFORMATION* 149, 194 (Niva Elkin-Koren & Neil Weinstock Netanel, eds., 2002) (making analogy to Titmuss's argument regarding the way that *selling* blood decreased the quality of the blood supply); Richard A. Posner, *When Is Parody Fair Use?*, 21 J. LEGAL STUD. 67, 74 (1992) ("The social product is diminished if persons are able to exact compensation from truthful critics of their failings, for such a right reduces the incentive to produce truth.").

⁹⁹ On the income or "welfare" effects, see E.J. Mishan, *The Postwar Literature on Externalities: An Interpretive Essay*, 9 J. ECON. LITERATURE 1, 18–19 (1971) ("The maximum sum [a person] will pay for something valuable is obviously related to, indeed limited by, a person's total resources, while the minimum sum he will accept for parting with it is subject to no such constrain."). Thus, "owning" a right increase one's valuation of it because the ownership itself is a source of value. See WARD FARNSWORTH, *THE LEGAL ANALYST: A TOOLKIT FOR THINKING ABOUT THE LAW* 209–12 (2007) (using the term "wealth effects"). In addition, as a psychological matter, people tend to put a higher value on a thing they own than they would spend to purchase the same item. This is the related but distinct notion of "endowment effect." See *id.* at 212.

¹⁰⁰ On income effect and antidissemation motives, see Gordon, *Excuse and Justification*, *supra* note 22, at 179–83, 189–91 (discussing pricelessness and systemic effects); Wendy J. Gordon, *Toward a Jurisprudence of Benefits: The Norms of Copyright and the Problem of Private Censorship*, 57 U. CHI. L. REV. 1009, 1042–46 (examining the "economics of suppression" under the rubric of "'income' or 'wealth' effects"). See also

Ordinarily, economic analysts determine which use of a resource is most socially valuable by asking “what would be the outcome of a market transaction between different potential users.” The person willing to pay the most is assumed to value the resource most highly. For goods affected by the income effect and similar phenomena, however, the market would reveal different results depending on the identity of the party to which the law awarded initial ownership of the good. As a result, a market transaction could not reveal with any stability which use of the good (the critic’s use to criticize, or the criticized person’s use to protect himself) would generate more value.

Thus economic analysis joins free speech concerns in showing why a right to copy fairly lengthy excerpts for purposes of criticism is well established. As the Second Circuit has recognized,¹⁰² and common sense suggests, even if a copyright claimant was willing to license critical uses at *some* price, that would not wipe out fair use for criticism.

We could go on surveying the existing literature and case law. Instead, let us turn to two factors that have been implicitly taken into account by some courts and commentators, but need explicit recognition. The first category is the need to maintain privacy, which cannot be easily accommodated in individual deals between copyright claimant and utilizer. The second category is the need to keep rights packaged in a way that keeps information costs within tolerable levels.¹⁰³ Each category involves harms both to the potential utilizer, and to persons *outside* the immediate parties to the potential transaction.

Gordon, *Fair Use as Market Failure*, *supra* note 12, at 1632–35 (discussing antidissemation motives); Landes & Posner, *supra* note 57, at 359; Robert P. Merges, *Are You Making Fun of Me? Notes on Market Failure and the Parody Defense in Copyright*, 21 *AIPLA Q.J.* 305, 309–10 (1993); Alfred C. Yen, *When Authors Won't Sell: Parody, Fair Use, and Efficiency in Copyright Law*, 62 *U. COLO. L. REV.* 79, 81–84 (1991).

¹⁰¹ One might call the latter a “pricelessness effect.” See Gordon, *Excuse and Justification*, *supra* note 22, at 182. Admittedly, some might characterize the last-mentioned argument as a kind of market barrier between copyright claimant and utilizer because if one party views control over the use as “priceless,” there will be no exchange. But we use pricelessness as an example simply because it is so dramatic. Income and endowment effects have a wide range of impacts on the licenses that are (and are not) reached. Thus, income and endowment effects can apply even when an author is willing to sell the right to quote him critically at *some* price; what is crucial to these effects (and to the way they skew resource use) is simply that for some things, the price one is willing to pay is different from the price the same person would be willing to accept if he were the owner.

¹⁰² *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 614–15 (2d Cir. 2006) (“[A] copyright holder cannot prevent others from entering fair use markets merely ‘by developing or licensing a market for parody, news reporting, educational or other transformative uses of its own creative work.’” quoting *Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.*, 150 F.3d 132, 146 n.11 (2d Cir. 1998)).

¹⁰³ We are indebted here to Thomas W. Merrill & Henry E. Smith, *Optimal Standardization in the Law of Property: The Numerus Clausus Principle*, 110 *YALE L.J.* 1, 26 (2000).

V. TWO MORE BASES FOR FAIR USE

A. *Preserving Expectations of Privacy*¹⁰⁴

The ability to meter uses of copyrighted works finely comes at a cost to the privacy of the utilizer.¹⁰⁵ When a window opens on Janine's computer offering her a license to download, her initial thought process would probably be something like this: Who is asking for my credit card number? Is this message from who it claims to be from, or is somebody trying to steal my identity? If she is satisfied that the message is genuine and its sender is trustworthy, she still might not want to share information about how she is planning to use the copyrighted material. The purchase of such a license will leave a personally identifiable record of her

¹⁰⁴ We are not the first to notice that privacy has potential relevance for fair use. For example, a brief but stimulating discussion appears in Africa, *supra* note 2, at 1171, 1176. See also, e.g., Cohen, *The Place of the User*, *supra* note 25. Privacy issues have been prominent in discussions of management technologies, see, for example, Cohen, *supra* note 25, at 1012; Electronic Privacy Information Center, Digital Rights Management and Privacy, <http://www.epic.org/privacy/drm/> (last visited Nov. 28, 2007) (expressing concerns about various DRM technologies, including some that "phone home" to a central server), and in discussions of peer-to-peer networks. The Supreme Court may have had privacy concerns in mind when it gave fair use treatment to consumers who made copies for purposes of time-shifting their viewing of television shows at home. Sony Corp. of Am. v. Universal City Studios, 464 U.S. 417 (1984); Lloyd L. Weinreb, *Fair's Fair: A Comment on the Fair Use Doctrine*, 103 HARV. L. REV. 1137, 1155 (1990). Our aims are to emphasize this strand of analysis in a way that will (a) show how transactions between willing parties can impose privacy costs on third parties, and (b) put user privacy more explicitly on the fair use agenda.

Just as Brandeis and Warren suggested that privacy concerns play a legitimate role in common law copyright's grant of exclusion rights, we suggest that privacy can play a legitimate role in copyright's grant of public rights. See Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 Harv. L. Rev. 193, 205 (1890). For the point about Warren and Brandeis, we are indebted to Pamela Samuelson.

¹⁰⁵ See Cohen, *supra* note 25, at 1012 ("The freedom to read anonymously is just as much a part of our tradition, and the choice of reading materials just as expressive of identity, as the decision to use or withhold one's name. Indeed, based purely on tradition, the freedom to read anonymously may be even more fundamental than the freedom to engage in anonymous political speech."). On the value of privacy especially in the Internet context, see generally Julie E. Cohen, *Copyright's Public Private Distinction*, 55 CASE W. RES. L. REV. 963, 963 (2005); Julie E. Cohen, *Overcoming Property: Does Copyright Trump Privacy?*, 2002 U. ILL. J.L. TECH. & POL'Y 375, 376 (2003); Sonia K. Katyal, *Privacy vs. Piracy*, 7 YALE J.L. & TECH. 222, 223 (2004-2005); Jacqueline Lipton, *Information Property: Rights and Responsibilities*, 56 FLA. L. REV. 135, 137-38 (2004); Jessica Litman, *Information Privacy/Information Property*, 52 STAN. L. REV. 1283, 1287 (2000); Pamela Samuelson, *The Copyright Grab*, WIRED Jan. 1996, at 135.

desired use. Beyond the usual concerns about embarrassment, persecution,¹⁰⁶ or undesired, targeted advertising, Janine might worry that such a license compromises any desire she has for secrecy in her work. She may not want other researchers to know what she is working on until she is able to publish it lest they preempt her work. If Janine decides to buy the derivative work license, she has functionally allowed the translations' copyright owners the ability to look quite closely at her current work. This secrecy concern might be heightened if she were a researcher racing for a patent, or a corporate CEO who did not want somebody to know that he had been reading a book with a title like *Defending Against Hostile Takeovers for Dummies* (or worse, that he had read the book three times and printed "Chapter 7: They'll Never Guess You're Bluffing!").¹⁰⁷

Consider the way that libraries refuse to give out their readers' lists of borrowing, lest borrowing be chilled.¹⁰⁸ Similarly, sometimes an uncompensated

¹⁰⁶ Fortunately for Janine, researching Aristotle is not likely to get her on a no-fly list of any sort. However, her colleague doing research on the tactics of the Weather Underground or the IRA might not be so fortunate.

¹⁰⁷ We should consider, briefly, whether Janine, the patent researcher, or the CEO might be able to take steps to increase anonymity. It is possible to imagine an intermediary protecting privacy just as Paypal might protect credit card numbers. To a certain extent this might work, provided people had the technical savvy to use it and were readily able to find a trusted intermediary. Still, the intermediary might be vulnerable to subpoenas, and we doubt that the necessary technology exists to guarantee full anonymity against sophisticated hacking. Moreover, Paypal and anonymity would hardly work where permission is sought to make derivative works. In such cases, copyright owners typically want to know the user's plans for the work.

Mathew Africa makes a similar point in assessing the danger that "records of which articles a company was photocopying might be used by the company's competitors . . . to deduce valuable trade secrets." Africa, *supra* note 2, at 1171. He suggests that even though the Copyright Clearance Center had made efforts to "mask" the names of copied articles, "a competitor might still be able to infer this information through careful study of [CCC] records." *Id.* at 1171 n.115.

¹⁰⁸ Forty-eight states currently have confidentiality laws relating to library records. American Library Association, *State Privacy Laws Regarding Library Records* (2007), <http://www.ala.org/template.cfm?section=stateifcinaction7template=/contentmanagement/contentdisplay.cfm&contentID=14773> (last visited Nov. 28, 2007). According to such laws, library records are to remain confidential and not to be disclosed except in very specific situations, including pursuant to an order or subpoena, see, for example, CAL. GOV'T CODE § 6267 (West 1995); N.Y. C.P.L.R. 4509 (McKinney 2007), or when required to protect public safety, see, for example, TEX. GOV'T CODE ANN. § 552.124 (Vernon 1995). See also American Library Association, Code of Ethics, art. III (1995), <http://www.ala.org/ala/oif/statementspols/codeofethics/codeofethics.pdf> (stating the American Library Association's policy to protect each library user's right to privacy and confidentiality with respect to circulation records, as a matter of professional ethics); American Library Association, Policy on Confidentiality of Library Records (1986), <http://www.ala.org/ala/oif/statementspols/otherpolicies/confidentialitylibraryrecords.pdf> (stating that such records are not to be made available except pursuant to an order or subpoena). We are indebted to the B.U. Law Library staff for this footnote.

use of copyrighted works should be deemed fair to safeguard the privacy interests of someone who does not want to leave the kind of identifying tracks that a license requires. It is true that Janine probably left a record with her purchase of the digital books. However, the supplemental license would require her to leave a record of the manner in which she is using them as well as possibly the nature of her underlying work. If she has a fair use liberty, she is freed of the need to disclose details she would prefer to keep private.

Many market transactions come with privacy concerns. One might therefore object that privacy concerns cannot motivate fair use since privacy issues arise in all market transactions. Why would society worry about the market for intellectual transactions when society accepts the need to reveal private facts when people purchase things like contraceptives, pharmaceuticals, and life insurance? Point of purchase embarrassment may be a sort of transaction cost—but it is rarely a deal breaker.

This objection has many replies. Most obviously, the tangible world also has legal protections for privacy. For example, insurance and prescription pharmaceuticals are subject to privacy policies and regulations.¹⁰⁹ But in addition, the literature on free speech is full of reasons why markets in communication may stand in special need of the law's solicitude. Most notably, communication gives benefits to many people beyond the immediate speaker and recipient, yet the desire to communicate is more easily chilled than are other, more robust, material wants.¹¹⁰ In addition, intellectual products are nonrivalrous, so when extra, uncompensated copies are made there may be no harm to revenue; moreover, markets for intangibles may impose more dead weight loss than necessary to generate incentives.¹¹¹

The narrowly tailored license could allow undesirable insight into the personal as well as the professional life of the potential purchaser. Traditionally, a book could be bought as a gift, as a coffee table decoration, to complete a collection, because the purchaser is friends with the author, or even because the purchaser liked the cover art. However, a license to read, reread, or copy could imply a stronger interest in the underlying subject matter. It might also reveal the time and location the material is being read.

If that subject matter is “how to leave my job” or “how to get over my neurosis,” those whom it would most benefit might be unwilling to leave a record of their need. To put it mildly, such reading is not something society wants to chill.

¹⁰⁹ And offline anonymity can often be preserved through using cash.

¹¹⁰ We might imagine certain documents such as the Pentagon Papers that are protected by the First Amendment but where potential readers are worried that if they are traced as receiving and circulating the documents to others, they will end up on a government watch list.

¹¹¹ See, e.g., Ian Ayres & Paul Klemperer, *Limiting Patentees' Market Power Without Reducing Innovation Incentives: The Perverse Benefits of Uncertainty and Non-Injunctive Remedies*, 97 MICH. L. REV. 985, 1032 (1999) (“[T]he profits coming from the last increment of monopoly pricing impose disproportionate costs on society.”).

We should also highlight that our immediate concern is the expectation of privacy as well as privacy in a particular instance. A reader might have a purely academic interest in the "how to get over my neurosis" book and, having nothing to hide, view the privacy cost only as a minor addition to a standard transaction cost. However, if this reader purchases a license it will shift the cost of maintaining privacy to the next reader, who in this case, may have the more socially valuable use. If privacy becomes something only maintained by those with something to hide, then an assertion of privacy becomes an admission of guilt.

We worry about identity theft. We worry about embarrassment. But we worry most about the commodification of the most intimate, the most personal parts of our lives. Requiring a license for particularly private or personal intellectual exchanges raises larger privacy concerns.¹¹² We use intellectual products both to understand ourselves and to understand our relationships with each other. Should the lover acquire a license before copying down a few particularly resonant lines of poetry in a letter? Must the children playing Superman acquire a license for a public performance of a derivative work? May the text of a wedding announcement or an obituary be copied into an email or scanned into the family computer? Because our lives are so seeped in intellectual products and ideas, requiring a license for all uses would raise privacy concerns unprecedented in other market situations.

Privacy is a particularly pressing concern in artistic matters. Just as privacy may involve shielding one's actions from the eyes of others, it can also involve creating a personal space free from external influences. In the hypothetical involving Bob Dylan's creative process, and the early stages of his burgeoning creativity as a songwriter, a demand for a licensing fee could be particularly intrusive. For young Bob Dylan, paying a licensing fee to copy down a song would invite a licensing agency into his intensely personal struggle to define and understand himself as an artist. Nothing kills a dream like boilerplate.¹¹³

Finally, our privacy concern also extends beyond worries about specific transactions. By its nature, privacy must be protected at a societal rather than individual level. While Janine may not be at all concerned about her privacy, if she sacrifices it, she increases the cost to the next researcher who desires to preserve privacy. If privacy is readily commoditized, those who value their own privacy will be assumed to be hiding something. We suggest that privacy concerns might help to justify a finding of fair use, both to prevent the chilling of the use by privacy-valuing individuals and to protect an individual's right to seek privacy without stigma.

¹¹² Indeed, as we suggested above, one of the reasons society is willing to tolerate a loss of privacy in some market transactions is that many tangible goods have multiple possible uses. Nobody needs to know whether a purchaser of roses intends them as a centerpiece or as a gift to an illicit lover. With increased use of DRM technology and increasingly specific licenses, this anonymity is shrinking for intellectual products.

¹¹³ Of his first contract, Dylan says he signed it without reading it. DYLAN, *supra* note 70, at 280.

A liberty that needs to be bargained for may end up being used far differently than a liberty that is freely granted. A liberty that is freely granted as a favor may end up being used far differently than a liberty that is freely granted as an entitlement. And a liberty whose use is monitored may be a liberty that goes unused.

B. Packaging: Preventing Slivers of Rights from Pricking

Just as courts should take into account the privacy costs of denying fair use to a defendant, they should take into account the benefits of granting fair use to “trim away” undesirable restraints from awkwardly shaped packaging. One such set of benefits relates to standardization.¹¹⁴

We address this in two contexts. First, we raise the possibility that courts should be more willing than they now are to use preemption to strike down those purported contractual restraints that violate congressional intent as found in the fair use provision.¹¹⁵ We raise that possibility only in a preliminary way, given the importance of the countervailing issues,¹¹⁶ but the preemption possibility needs at least to be mentioned in any discussion of standardization and fair use. We discuss preemption in regard to Janine, who may have (for example) assented to a contract that forbade multiple rereadings.

Second, and with more certainty, we address the standardization issue in the context of unusual or unexpected assertions of copyright. Fair use can be used to help honor consumer expectations¹¹⁷ and prevent one unusual copyright owner from spoiling the profits of the group. We discuss this in the context of Bob Dylan’s hand-copying the lyrics and music from “Pirate Jenny.”

The growth of digital commerce has allowed intellectual products to be sold in previously unknown packaging. A copyright owner could, without too much trouble, sell a song that would only play on the sound system of a Cadillac driving

¹¹⁴ As mentioned above, this section is indebted to the work of Merrill & Smith, *supra* note 103.

¹¹⁵ See *supra* note 30.

¹¹⁶ Merrill and Smith note that the costs of standardization in property-rights forms might be kept low by preserving the possibility of some workarounds. See Merrill & Smith, *supra* note 103, at 35 (noting, for example, that *numerus clausus* problems can sometimes be avoided by carefully rewriting leases). Our suggestion could limit the ability to do contractual workarounds. Nevertheless, the benefits of standardization need to be acknowledged, even if in the contract context the countervailing costs are also high.

¹¹⁷ Customary uses have long been favored by fair use. For example, Africa suggests that one consideration the courts should take into account is, “Will [requiring a market] defeat the expectations of the public?” Africa, *supra* note 2, at 1176. But it is important to identify the dangers in relying on custom, see Gordon, *supra* note 4, and to be clear about what its potential benefits might be. What the instant Article adds to the discussion is a focus on the Merrill and Smith factors, in particular, the way that noncustomary packages, though perhaps agreed upon by the immediate parties to a transaction, can impose increased search and measurement costs on third parties.

between 75 and 85 mph on a Monday. With a bit more effort, the owner might find somebody who would actually buy this bundle.¹¹⁸ However, whatever benefit arises from such a transaction would be dwarfed by the headache to everyone else who now has to be careful not to accidentally purchase the Monday-Speeding-Cadillac bundle. While many bundles are possible, not all bundles are equally valuable, and the more bundles there are, the greater the search cost to people who want to buy a specific bundle.¹¹⁹ Through fair use, a court can shape these bundles into more standard, readily recognizable forms. A court might determine that a sliver of a right, such as a right to reread or time-shift, should be sold with a copy of the work. This could curb the proliferation of nonstandard packages that, in addition to leading to unpleasant consumer surprise, can actually decrease the value of all intellectual products.¹²⁰ Again, note that our primary concern is with

¹¹⁸ Further, with some clever programming, he could ensure that the purchaser only listens to the song in the prescribed manner. While such strange arrangements were possible before the digital age, DRM has made such strangely tailored packages self-enforcing.

“DRM” originated as an acronym for “Digital Rights Management,” although as Richard Stallman has pointed out, “Digital Restrictions Management” might be a more apt referent. RICHARD STALLMAN, *Can You Trust Your Computer?*, in *FREE SOFTWARE, FREE SOCIETY: SELECTED ESSAYS OF RICHARD M. STALLMAN* 117, 117 (Joshua Gay ed., 2nd ed. 2004), available at <http://www.gnu.org/philosophy/fsfs/rms-essays.pdf>.

DRM refers to technological restrictions placed on computer media, typically to prevent unlicensed use of music. The goal is to manage consumers’ use of digital media by restricting their actions to a subset of behaviors. Typically, computer code tells users’ computers what the user is allowed to do. This usually means that behaviors the programmer expects and approves of will work fairly well, but that behaviors the programmer wishes to discourage, or which are simply less conventional and thus overlooked by the DRM architects, will be inhibited. Among other things, DRM may make it difficult for users to switch from one type of media player to another, or to change computers without losing the functionality of their files.

The DMCA provides legal back-up to DRM. *See supra* note 35 (discussing the DMCA).

¹¹⁹ *See Merrill & Smith, supra* note 103, at 24–40.

¹²⁰ Slicing rights thinly can be lucrative, but also destructive—not only to the copyright claimant and the potential utilizer but also to other copyright owners and potential users. Let us illustrate with an example from the physical world. A simple form of this example is suggested by Merrill & Smith’s discussion on currency, weights, and measures. Merrill & Smith, *supra* note 103, at 48.

When coins were made of uniform weights of gold, profit could be made by shaving a few grams of gold from one’s coins, and selling the harvested gold separately. This practice was highly discouraged, both by custom and law. Yet if I own a piece of gold jewelry, property law suggests that I can melt it down and divide it into two pieces of jewelry if I wish. Why shouldn’t I also be able to shave off a bit of my gold coin and put the coin back into circulation? After all, it is my gold.

The answer is easy to see. We all know the problems that would arrive when I dump my diminished coin into the market. Let’s say a coin that formerly weighed thirty grams now weighs twenty-four. If I shave this much off a coin, an astute purchaser will likely

harm to other market participants *outside* the transaction who will be inflicted with increased uncertainty costs.¹²¹

Let us return to Janine and Bob Dylan. If Janine, in acquiring her digital books, entered into a contract that prohibits rereading one of her books, she and anybody she tells about her license now have doubts about whether other electronic books are rereadable. She will have to check more carefully in the future to ensure that she is purchasing what she thinks she is purchasing. Additionally, if she ever hopes to resell any of her digital books in some form, any prospective purchaser will need to find a way to ensure that she actually possesses the rights she thinks she does.¹²² To avoid these problems, a court should consider using preemption to enforce fair use against those portions of Janine's contract that create the troublesome slivers of rights.

Bob Dylan's example presents an analogous problem. Many commentators have noted that consumers being able to engage in multiple uses or in sharing can increase the value (and price) of copyright licenses.¹²³ If Bob Dylan and other fans think they must ensure that they have explicit permissions before they can hand-copy a song's lyrics, the value they will see in buying songs will decrease—as will the price they will be willing to pay. Thus, if most holders of music copyrights would freely allow lyric transcribing, a few spoilers could create uncertainty that decreases the value of everybody's copyright.

notice something isn't right. Let's assume I even tell my purchaser—perhaps in very fine print—that I have shaved off part of the coin. The savvy purchaser should notice this and appropriately discount the value of my coin. The transaction is arguably fair, depending on our mutual expectations and the size of the fine print. But let's assume it's fair at least between myself and my savvy purchaser.

I nevertheless have created some harm to others by shaving off my coin. I have devalued the worth of currency as an institution. Now every future merchant will need to weigh carefully every coin. Imagine the downstream chaos we would create if we gave change for a \$20 bill by cutting off a proportion equivalent to \$3.17!

Even if I never receive any improper benefit from my coin modification, I have imposed costs on everyone. Now everyone has to buy a scale that's sensitive to minute variations in weight. If they don't buy scales, they will instead discount the value of all coins to reflect the possibility they've been shaved. The value of a coin in the marketplace is thereby diminished.

¹²¹ In addition, of course, there can be harm to the participants themselves, but conceivably they can take care of the difficulties by explicit license terms. Third parties are not so easily protected. This is, of course, one of our usual themes: the possibility of *some* market between *some* of the affected parties does not safeguard all the people affected.

¹²² See generally Henry Hansmann & Reinier Kraakman, *Property, Contract, and Verification: The Numerus Clausus Problem and the Divisibility of Rights*, 31 J. LEGAL STUD. 373 (2002) (recognizing *numerus clausus* in property law, but suggesting its root cause is allowing potential purchasers to verify what rights the seller possesses).

¹²³ See, e.g., Litman, *supra* note 25, at 46–48; Michael J. Meurer, *Price Discrimination, Personal Use and Privacy: Copyright Protection of Digital Works*, 45 BUFF. L. REV. 845, 858 (1997).

Fair use can also create consistency between old and new media. What rights come with a digital book? A court might approach this question by analogy. What is a digital book? It is like a book, but electronic. If a court sought to honor consumer expectations by giving a digital book a similar set of rights to those of a physical book—modified primarily by the necessities of electronic form—fair use would be one of the applicable tools for the court to apply.¹²⁴

In some cases, such as transferability, the peculiarities of the electronic form may suggest a slightly different default package.¹²⁵ But we suspect that the burden for shifting from a recognized form to a new form should fall on the party claiming that a use is unfair.

VI. TOWARD A THEORY OF PUBLIC RIGHTS

A. *The Need for a Theory of Public Rights*

The Supreme Court has proclaimed that the public has “a federal right to ‘copy and to use’”¹²⁶ what the patent and copyright laws do not make exclusive.¹²⁷ That is, the Court has treated areas where the legislature has refused to grant exclusivity as constituting an *affirmative* grant to the public of the corresponding liberty right, and has given that right to “copy and use” a weight sufficiently heavy that it invalidates or narrows state¹²⁸ and federal¹²⁹ claims that might interfere with it. Thus, for example, the Supreme Court restricted the potential scope of the Lanham Act (the federal trademark statute) to keep it from eroding the public’s right to copy and use works of expression whose copyright had expired.¹³⁰

¹²⁴ As Jessica Litman has emphasized, consumers don’t read and understand copyright statutes. Litman, *supra* note 25, at 51–52.

¹²⁵ There may be digital packages (for example, allowing primitive copying *sans* page numbers and formatting, but disallowing exact PDF printing) that maximize value for both producers and consumer. See Gal Oestreicher-Singer & Arun Sundararajan, *Are Digital Rights Valuable? Theory and Evidence from eBook Pricing*, 2004 TWENTY-FIFTH INT’L CONF. ON INFO. SYSTEMS 533.

¹²⁶ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 165 (1989).

¹²⁷ When the concept was born, the Court extended the treatment to copyright as well as patent. Thus, the Court wrote: “To forbid copying would interfere with the federal policy, found in Art. I, s. 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.” *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964) (dicta). To similar effect is *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231–33 (1964) (asserting that states may not per se prohibit the copying of articles unprotected by copyright or patent) (dicta). It was not until 2003 that the Court put teeth in the copyright half. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 36 (2003).

¹²⁸ *Bonito Boats*, 489 U.S. at 165 (preempting a state law that prohibited a form of copying boat hull designs).

¹²⁹ *Dastar Corp.*, 539 U.S. at 33–37

¹³⁰ *Id.*

These rights to copy are nowhere articulated as such in the patent or copyright law. Rather, they arise naturally where the domains of patent and copyright exclusivity end,¹³¹ and are given strength by policy.¹³² We suggest that fair use, which is articulated explicitly by statute, which has a long judicial tradition, and which has constitutional stature, be given similar recognition.¹³³ Further, as one of us has argued, the very “natural law” rights that are usually cited as providing the moral premise for an author’s claim to reward also provide the premise for a strong set of expressive rights in the public.¹³⁴

We need a comprehensive definition of the public’s rights in the realm of expression.¹³⁵ Ray Patterson,¹³⁶ Julie Cohen, and others have seen this as a need to

¹³¹ All duties have correlative claim rights; all areas of no-duty are realms of liberties. See the discussion of Hohfeld, *supra* note 26.

¹³² Whether a federal liberty is strong enough to withstand a newly made state statute or a newly asserted cause of action is a matter not of Hohfeldian definition but of policy. That a strong entitlement to copy does not arise from the mere fact of federal nonprotection is demonstrated by *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 478 (1974). In that case the Court allowed states to prohibit some copying of secret but unpatented inventions. *Id.* at 491–93. If an invincible “right to copy” had followed from the mere fact that the inventions were unprotected by federal patent law, *Kewanee* would have gone the other way and preempted state trade secrecy law. The Court allowed trade secrecy law to stand because of a policy judgment: the states allowed copying by reverse engineering and the Court viewed this factor, among others, as sufficing to keep trade secrecy laws from significantly interfering with patent policy. *Id.* By contrast, a law that prohibited copying of publicly known inventions *would* interfere with patent policy, as *Bonito Boats* made clear. 489 U.S. at 162.

Our argument is, of course, that fair use is not merely an existing liberty, but is also a liberty that serves a strong policy: fair use is essential to preserving the balance that makes assertion of private ownership over speech acceptable. Without fair use, copyright would not only be constitutionally questionable, see *Eldred v. Ashcroft*, 537 U.S. 186, 219–20 (2003), and violate notions of justice, see Gordon, *Self-Expression*, *supra* note 8, but also could impair the public’s economic welfare, *see, e.g.*, COMPUTER & COMM’NS INDUS. ASSOC., FAIR USE IN THE NEW ECONOMY: ECONOMIC CONTRIBUTIONS OF INDUSTRIES RELYING ON FAIR USE 6 (2007), available at <http://www.cciinet.org/artmanager/uploads/1/FairUseStudy-Sep12.pdf> (providing “an initial assessment of the economic contribution generated by companies benefiting from fair use”).

¹³³ The U.S. courts are beginning to recognize this. *See, e.g.*, *Chamberlain Group, Inc. v. Skylink Tech., Inc.*, 381 F.3d 1178, 1197 (Fed. Cir. 2004) (referring to “the rights that the Copyright Act grants to the public”).

¹³⁴ Gordon, *Self-Expression*, *supra* note 8, at 1536–37, 1555–72 (regarding the public’s entitlement), 1577–78, 1592–96, 1601–09 (applying Lockean theory to provide a basis for fair use); *see also* Drassinower, *supra* note 38; Abraham Drassinower, *A Rights-Based View of the Idea/Expression Dichotomy in Copyright Law*, 16 CAN. J. L. & JURIS. 3 (2003).

¹³⁵ *See* Cohen, *The Place of the User*, *supra* note 25, at 372.

¹³⁶ *See* L. RAY PATTERSON & STANLEY W. LINDBERG, *THE NATURE OF COPYRIGHT: A LAW OF USERS’ RIGHTS* 191 (1991).

focus on the “users” of copyrighted works.¹³⁷ That is a salutary starting place, particularly if one recognizes that authors too are users,¹³⁸ but the notion of “user” has implications that are too narrow. The public has rights in many capacities, not just as utilizers. For example, they may have rights as cocreators of the copyrighted work,¹³⁹ as harmed parties seeking redress through self help,¹⁴⁰ as holders of First Amendment free speech rights,¹⁴¹ and as human beings.¹⁴²

¹³⁷ See Cohen, *The Place of the User*, *supra* note 25, at 348; Rochelle Cooper Dreyfuss, *TRIPS-Round II: Should Users Strike Back?*, 71 U. CHI. L. REV. 21, 22 (2004).

¹³⁸ Cf. Jessica Litman, *The Public Domain*, 39 EMORY L. J. 965, 966 (1990) (asserting that no authorship exists without debt to predecessors).

¹³⁹ See generally LIOR ZEMER, *THE IDEA OF AUTHORSHIP IN COPYRIGHT* (2007) (arguing that the public is also an author); Daniel Bahls, *The Fluid Text and Its Authors* (May 20, 2007) (unpublished paper, on file with authors) (arguing that the public’s authorial role continues through criticism, translation, and interpretation even after a work is first published).

¹⁴⁰ The best example is that of Jerry Falwell who, as part of a fundraising effort, sent his supporters copies of a copyrighted “fake ad” published by *Hustler* magazine that had depicted Falwell in a degrading light. The Ninth Circuit wrote:

[A]n individual in rebutting a copyrighted work containing derogatory information about himself may copy such parts of the work as are necessary to permit understandable comment. Falwell did not use more than was reasonably necessary to make an understandable comment when he copied the entire parody from the magazine. . . . [T]he public interest in allowing an individual to defend himself against such derogatory personal attacks serves to rebut the presumption of unfairness.

Hustler Magazine, Inc. v. Moral Majority, Inc., 796 F.2d 1148, 1153 (9th Cir. 1986). From a Lockean perspective, the right to replicate another’s expression in self-defense can be linked to the public’s rights in the common. See Gordon, *Self-Expression*, *supra* note 8, at 1565–72, 1601–05.

The First Amendment sharply limits the *rights* the government can give to private parties to obtain monetary redress for the harms done them by speech. Thus, in a companion case, Falwell was denied the right to sue *Hustler* for intentional infliction of emotional distress. *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 56–57 (1988). But fair use and cognate doctrines—such as estoppel—only give *liberties* as redress: the ability to use speech as a form of self-help to fight back against the injurer. See Gordon, *Caesar*, *supra* note 41, at 83 n.30 and accompanying text.

¹⁴¹ See, e.g., Baker, *supra* note 45, at 897–898; Netanel, *supra* note 45, at 348 (“[D]issemination of fixed original expression . . . is a fundamental building block of democratic association.”); Rubinfeld, *supra* note 63, at 3–12.

¹⁴² See, e.g., Universal Declaration of Human Rights, G.A. Res 217A (III), at art. 27(1), U.N. GAOR, 3d Sess., 1st plen. mtg., U.N. Doc A/810 (Dec. 10, 1948), available at <http://www.un.org/Overview/rights.html> (“Everyone has the right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits.”). International Covenant on Economic, Social and Cultural Rights art. 15.1(a)–(b), opened for signature Dec. 16, 1966, 993 U.N.T.S. 3, available at <http://www.ohchr.org/english/law/cescr.htm> (“The States Parties to the present Covenant

The current statute could be organized around the public's many liberty rights, but instead is organized in the opposite way: around a copyright owner's exclusion rights. That is, the statute could state all the things the public *can* do as the first order of business, and only as a second order of business identify exclusive right holders who have the power to unlock the gates to the things the public cannot do.

The two forms of organization are analytically identical. In the graphic arts, foreground and background are drawn by the same stroke of the pencil. One can map an archipelago by focusing on the ocean and drawing where it ends, or by focusing on the islands and showing where they end. But unlike graphic art, words cannot simultaneously draw background and foreground. Something must take precedence in order for anything to be stated.

The specification of a copyright owner's claim rights was placed at the center of the statute. This may have made sense as a matter of initial drafting strategy: Because the liberty to copy is assumed to be the background condition,¹⁴³ it is simplest to assume the sea of liberty, and spend one's words on specifying the few islands. That is the way most of us perceive law: as the exception, the places where we have duties instead of liberty.¹⁴⁴ But now that the copyright statute is immensely complex, the public, as the party least able to afford lawyers, should have a simple statement of what members of the public are entitled to.¹⁴⁵

recognize the right of everyone: (a) To take part in cultural life; (b) To enjoy the benefits of scientific progress and its applications").

Some philosophers distinguish between rights we hold because of what we do (special rights), and rights we hold because of our status as humans (general rights). JEREMY WALDRON, *THE RIGHT TO PRIVATE PROPERTY* 106–24 (1988). Some fair use is premised on special rights, and some on general.

¹⁴³ Copyright and patent are seen as islands of protection in a sea of liberty. Whether the background really is a sea of liberty, however, is open to debate. *See, e.g.,* J.H. Reichman, *Charting the Collapse of the Patent-Copyright Dichotomy: Premises for a Restructured International Intellectual Property System*, 13 *CARDOZO ARTS & ENT. L.J.* 475, 516–17 (1995) ("If, as the old cliché declares, the classical patent and copyright systems were once islands of protection in a sea of competition, the legal hybrids—taken together—conjure up the vision of a sea of protection in which intrepid entrepreneurs encounter remote islands of free competition.").

¹⁴⁴ This understanding is culturally based. An old joke goes this way: In the US, everything is allowed except if forbidden. In Germany, everything is forbidden except if allowed. In the USSR, everything is compulsory except if forbidden.

¹⁴⁵ *See* Litman, *supra* note 138, at 970–77 (discussing the complexity of the copyright statute). Jeremy Bentham apparently had a similar notion for legislation. In inquiring "whether the law should be expounded at length in a list of rights or a list of obligations," Hart notes, "The test which [Bentham] proposed was 'Present the entire law to that one of the parties that has most need to be instructed.'" H.L.A. Hart, *Bentham on Legal Rights*, in *OXFORD ESSAYS IN JURISPRUDENCE (SECOND SERIES)* 171, 190 (A.W.B. Simpson ed., 1973) (citation omitted).

B. Some Possible Rights of the Public

What would be one such first order right? As Litman and Stallman have suggested, one such right should be “the right to read.”¹⁴⁶ Our gorge rises at the thought that we would have to account to someone else for our reading, or allow someone else to track what we read by forcing us to sign up for it. Because of technological changes, and some doubtful judicial precedent, browsing online is probably considered making a reproduction.¹⁴⁷ As noted above, this act of private copying may trigger a prima facie duty to get permission first.

If the statute were written with ordinary expectations about public rights made explicit, it would say something like: “no permissions needed for private reading.” But such a sentence was omitted because no one would have imagined that such a statement would be necessary. However, technology changed, and the act of reading became something that might involve reproduction. So to guard against technology making further inadvertent incursions on public rights, the public’s rights need to be made explicit. Fair use is a good place to start.

For now, therefore, we make a modest suggestion: The statute should make it explicit that fair use is a “right.” The Supreme Court of Canada has done no less, in *CCH Canadian Ltd. v. Law Society of Upper Canada*.¹⁴⁸ As that Court writes:

[T]he fair dealing exception is perhaps more properly understood as an integral part of the *Copyright Act* than simply a defence. Any act falling within the fair dealing exception will not be an infringement of copyright. The fair dealing exception, like other exceptions in the *Copyright Act*, is a user’s right. In order to maintain the proper balance between the rights of a copyright owner and user’s interest, it must not be interpreted restrictively. As Professor Vaver . . . has explained . . . : “User rights are not just loopholes. Both owner rights and user rights should therefore be given the fair and balanced reading that befits remedial legislation.”¹⁴⁹

It is overdue for our courts to do the same.¹⁵⁰

¹⁴⁶ See Litman, *supra* note 25, at 31–34; Stallman, *supra* note 25, at 75–78.

¹⁴⁷ This is the unfortunate legacy of a case with a different focus. *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 518–19 (9th Cir. 1993). See *supra* note 78.

¹⁴⁸ *CCH Canadian Ltd. v. Law Soc’y of Upper Can.*, [2004] 1 S.C.R. 339, 2004 SCC 13 (Can.), at ¶ 48, available at <http://scc.lexum.umontreal.ca/en/2004/2004scc13/2004scc13.html> (emphasis deleted). For a stimulating discussion of this issue, see Abraham Drassinower, *supra* note 38 and Abraham Drassinower, *Taking User Rights Seriously*, in *THE PUBLIC INTEREST: THE FUTURE OF CANADIAN COPYRIGHT LAW* 462 (Michael Geist ed., 2005).

¹⁴⁹ *CCH Canadian*, [2004] 1 S.C.R. 339, at ¶ 48. (quoting DAVID VAVER, *COPYRIGHT LAW* 171 (2000)); see also Dreyfuss, *supra* note 137, at 26 (asserting that focus on intellectual property rights favors proprietary concerns).

¹⁵⁰ They can and should do so without a statute, but a legislative nudge rarely hurts.

That fair use deserves to be seen a “right”—in the sense of an entitlement with a guarantee of continuity and significant importance—should be even clearer in the United States context. Not only has our Supreme Court declared that fair use has Constitutional backing,¹⁵¹ but in addition fair use has played a key role in the development of United States copyright doctrine.

VII. CONCLUSION

We would revise the current § 107¹⁵² to read as follows, with italics indicating areas of change:

§ 107. The *right of fair use*

Notwithstanding *other provisions of this title*, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means [*words omitted here*], for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is *a right and* not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;

¹⁵¹ Eldred v. Ashcroft, 537 U.S. 186, 219–20 (2003) (fair use is one of the Copyright Act’s “traditional First Amendment safeguards.”).

¹⁵² 17 U.S.C. § 107 (2006) now reads:

§ 107. Limitations on exclusive rights: Fair use

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

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

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

The fact that a work is unpublished *or that a license is available for the contested use* shall not itself bar a finding of fair use if such finding is made upon consideration of *all relevant* factors.

Our proposed modifications to copyright law would clarify that uses such as Janine's and Bob Dylan's would remain fair use even if a publisher offers to explicitly license them.

As for the location of the change, it is logical to place it where Congress corrected the courts the last time they tried to artificially constrain fair use, namely, in the final sentence of § 107. In that sentence, Congress made clear that no one factor—there, the unpublished status of plaintiff's work—should be determinative.¹⁵³ We suggest a similar addition for the availability of licensing.¹⁵⁴

As mentioned, we adopt this agenda in part because some courts and commentators apparently believe that a § 107 fair use claim should be denied if a licensing market for that use exists. This ambiguity, combined with a largely one-sided interaction between savvy right owners and risk-averse, downstream producers,¹⁵⁵ has threatened to shrink fair use. The fair use provision of the copyright statute, however, is critical to copyright's ability to serve the social interest.

We also suggest that § 107 drop its potentially restraining first clause,¹⁵⁶ and that it identify fair use as a right. These changes would further underline the importance of fair use, by making clear that it can play a role in cases involving the DMCA, that fair use is a crucial part of any conflicts analysis under preemption, and that the burden of proving all elements of fair use need not rest on the defendant. As the Supreme Court has said of the public's ability to copy unpatented inventions, the public's ability to "copy and to use" is a "right"¹⁵⁷ that

¹⁵³ *Id.* ("The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.")

¹⁵⁴ We also changed the last two words of the existing sentence, to make clear that the four factors listed in the statute are not the only ones that matter. Decades of jurisprudence and legislative history have consistently indicated, that the four factors listed in § 107 are merely illustrative. *See* 17 U.S.C. § 107 (listing factors to "include" in consideration of fair use); *see also id.* § 101 (indicating that, "[t]he terms 'including' and 'such as' are illustrative and not limitative."). *See* H.R. REP. NO. 102-836, at 3 (1992), *reprinted in* 1992 U.S.C.C.A.N. 2553, 2555 (acknowledging that list in §107 is illustrative).

¹⁵⁵ *See generally* Africa, *supra* note 2, at 1172 (arguing that fear of liability warps fair use); Gibson, *supra* note 4, at 887 (stating four core uncontroversial premises).

¹⁵⁶ Deleting the first clause, "Notwithstanding the provisions of sections 106 and 106A," is directed at DMCA concerns. *See supra* notes 35, 83.

¹⁵⁷ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 164–65 (1989); *see also Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33–37 (2003) (giving

cannot be lightly abandoned. Our Congress should explicitly declare that fair use deserves similar respect.

federal trademark law a restrictive interpretation in order to avoid trademark claims being used in a way that would erode the public's right to copy works whose copyright has expired). *See supra* notes 126–130 and accompanying text.

AMERICAN MORAL RIGHTS AND FIXING THE *DASTAR* “GAP”

Justin Hughes*

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I. INTRODUCTION

Until 1988, people who worked in copyright law lived with the fact that the biggest national producer of copyrighted works, the United States, lived outside the dominant multilateral system of copyright norms. Although an American delegation had participated in the drafting of the Berne Convention in 1886, the United States remained stubbornly distant from the “Berne Union.”¹ Arguably this

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¹ See, e.g., Melville B. Nimmer, *Implications of the Prospective Revisions of the Berne Convention and the United States Copyright Law*, 19 STAN. L. REV. 499, 500 (1967).

distance grew when moral rights were added to the Berne Convention as Article 6bis in 1928.²

Moral rights, or *droit moral*, are a constellation of rights that ensure an ongoing relationship between the author and the creative work outside economic issues. Two of these rights—the right of attribution and the right of integrity—are the core moral rights recognized in Berne Article 6bis.³ The right of attribution guarantees that the author's selected form of identification with the work remains—whether the author used her own name, used a pseudonym, or wanted to remain anonymous. The right of attribution is also generally understood to include a right against misattribution. The right of integrity allows the artist to object to distortions, alterations, or changes in the work; in Article 6bis this right is limited to changes that might damage the artist's reputation. Although there are other rights in the constellation of *droit moral*,⁴ Berne is only concerned with these two.

When the United States finally acceded to the Berne Convention in 1988, it did not have any federal statutory provision providing the two 6bis moral rights. Yet the U.S. government concluded—and the other Berne signatories seemingly accepted—that the United States provided substantively equivalent protection via a “composite” or “compendium” or “patchwork” of laws.⁵ Of course, the idea that countries can meet their international intellectual property obligations through different types of laws is quite common. For example, the Agreement on Trade-Related Aspects of Intellectual Property Law (TRIPS) expressly accepts substantively equivalent, but formally varied, protection for plant varieties.⁶

² See H.R. REP. NO. 101-514, at 7 (1990), reprinted in 1990 U.S.C.C.A.N. 6915, 6917; see also Orrin G. Hatch, *Better Late than Never: Implementation of the 1886 Berne Convention*, 22 CORNELL INT'L L.J. 171, 184 (1989) (“At the outset of the 100th Congress, the ‘moral rights’ obstacle remained in the path of legislation to implement the [Berne] Convention.”).

³ Berne Convention for the Protection of Literary and Artistic Works, art. 6bis, Sept. 9, 1886, as revised at Paris on July 24, 1971 and amended in 1979, S. TREATY DOC. No. 99-27 (1986), 1161 U.N.T.S. 30 [hereinafter Berne Convention].

⁴ Other moral rights include a right of “first publication” and a right of “withdrawal.” See, e.g., PAUL GOLDSTEIN, INTERNATIONAL COPYRIGHT 289–90 (2001) (discussing rights of withdrawal and “divulgation”) [hereinafter GOLDSTEIN, INTERNATIONAL COPYRIGHT]; A. LUCAS & H.-J. LUCAS, PROPRIETE LITTERAIRE ET ARTISTIQUE 299 (1994); MAREE SAINSBURY, MORAL RIGHTS AND THEIR APPLICATION IN AUSTRALIA 6–12 (2003) (describing same four moral rights).

⁵ All these terms come from the legislative history. See, e.g., H.R. REP. No. 100-609, at 37 (1988); FINAL REPORT OF THE AD HOC WORKING GROUP ON U.S. ADHERENCE TO THE BERNE CONVENTION 39, reprinted in 10 COLUM.-VLA J.L. & ARTS 513 (1986) [hereinafter WORKING GROUP FINAL REPORT]. I first used the “patchwork” notion in Justin Hughes, *The Line Between Work and Framework, Text and Context*, 19 CARDOZO ARTS & ENT. L.J. 19, 21 (2001). One could also call it a “mélange of legal theories.” Ilhyung Lee, *Toward an American Moral Rights in Copyright*, 58 WASH. & LEE L. REV. 795, 800 (2001).

⁶ TRIPS Article 27(3)(b) provides that “Members shall provide for the protection of plant varieties either by patents or by an effective *sui generis* system or any combination thereof.” Agreement on Trade-Related Aspects of Intellectual Property Rights art. 27(3)(b),

Agreement on the TRIPS provisions covering geographical indications was only possible with the understanding that some countries would fulfill the obligations with their *appellations d'origine* systems and others through trademark law.⁷ Yet even in such a liberal framework for implementing treaty obligations, to many, the American claim of Article 6bis compliance was, at best, a stretch.⁸

Within this patchwork of protection, Lanham Act claims were arguably the keystone of the United States' claim to provide protection substantively equivalent to Article 6bis' right of attribution. In 2003, the Supreme Court appeared to shred that portion of the patchwork with its ruling in *Dastar Corp. v. Twentieth Century Fox Film Corp.*⁹ In *Dastar*, the Court unanimously held that, vis-à-vis works in the public domain, there is no Lanham Act obligation to credit the original creator or copyright owner as the origin of the work.¹⁰ The *Dastar* ruling was unquestionably important for a robust public domain,¹¹ but the reasoning the Court employed makes American compliance with Article 6bis considerably more problematic.

Section II provides a brief context for the discussion that follows, while Section III explores the American patchwork approach to compliance with Berne Article 6bis. Section IV aims to convince the reader that (a) the reasoning in *Dastar* is fundamentally unstable as an interpretation of § 43(a) of the Lanham Act, (b) that lower courts have further expanded the *Dastar* holding with neither need nor justification, and (c) that a narrower, more stable approach could have reached the same result for the public domain with no negative impact on our Berne Article 6bis compliance. Section V provides a simple, politically tenable statutory fix for *Dastar*. Section VI of this Article returns to the general issue of

Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round, vol. 31, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994).

⁷ See Justin Hughes, *Champagne, Feta, and Bourbon: The Spirited Debate about Geographical Indications*, 58 HASTINGS L.J. 299, 311–20 (2006).

⁸ As anthropologist Michael Brown wrote in 2003, "the moral rights dimension of copyright law is underdeveloped in the United States, a situation that seems unlikely to change." MICHAEL F. BROWN, WHO OWNS NATIVE CULTURE? 74 (2003). Brown goes on to note, "[t]he doctrine of moral (or authors') rights represents a feeble nod in the direction of non-economic concerns, but it is limited in scope, problematic from a free-speech perspective, and almost completely absent from the legal system of the United States, the single largest actor on the world's commercial stage." *Id.* at 235. David Nimmer also believes that "it is a stretch to maintain that the law in the United States as of the enactment of the Berne Convention Implementation Act of 1988 was congruent with Article 6bis of the Berne Convention." David Nimmer, *The Moral Imperative Against Academic Plagiarism (Without a Moral Right Against Reverse Passing Off)*, 54 DEPAUL L. REV. 1, 22 (2004).

⁹ 539 U.S. 23 (2003).

¹⁰ *Id.* at 38.

¹¹ See, e.g., Lynn McLain, *Thoughts on Dastar from a Copyright Perspective: A Welcome Step Toward Respite for the Public Domain*, 11 U. BALT. INTELL. PROP. L.J. 71, 72 (2002); Ruth L. Okediji, *Through the Years: The Supreme Court and the Copyright Clause*, 30 WM. MITCHELL L. REV. 1633, 1636 (2004).

patchwork protection, concluding that American scholars who have been critical of the argument have been generally unfamiliar with Berne Convention implementation in other countries and have not judged the United States' Berne compliance by public international-law standards.

II. MORAL RIGHTS IN DIFFERENT, BUT NOT SO DIFFERENT, SYSTEMS

Commentators often observe that Anglo-American copyright law is driven principally by consequentialist, economic, and incentive-based justifications,¹² while continental European copyright law is informed to a greater degree by natural rights and concern to protect the personality interests of the author.¹³ But neither this difference nor the role moral rights play in it should be sketched in caricature.

The two *6bis* moral rights were introduced into the Berne Convention during the 1928 Rome revision of the treaty,¹⁴ with some modification of the treaty language in the Stockholm revision in 1967.¹⁵ First, Article *6bis*(1) obliges member states to provide the author with "the right to claim authorship of the work."¹⁶ Narrowly understood, this could be construed as only an author's right to have the work attributed to her by her legal or commonly-known name: in other words, a right to prevent nonattribution. But the *6bis* wording has also generally been understood to give the author (a) a right to enjoy nonattribution—to publish anonymously or pseudo-anonymously—and a two-pronged right to prevent

¹² See H.R. REP. NO. 100-609, at 17 (1988) ("Under the U.S. Constitution, the primary objective of copyright law is not to reward the author, but rather to secure for the public the benefits derived from the authors' labors."). See generally Peter S. Menell, *Intellectual Property: General Theories*, reprinted in 2 ENCYCLOPEDIA OF LAW AND ECONOMICS: CIVIL LAW AND ECONOMICS 129, 129 (Boudewijn Bouckaer & Gerrit De Geest, eds., 2000) (discussing utilitarian intellectual property rights), available at <http://encyclo.findlaw.com/1600book.pdf> (last visited Nov. 28, 2007).

¹³ See PAUL GOLDSTEIN, COPYRIGHT'S HIGHWAY 137-38 (rev. ed. 2003) (explaining European copyright focus on author); GOLDSTEIN, INTERNATIONAL COPYRIGHT, *supra* note 4, at 283-84 ("Civil law systems, with their ostensible deference to authors' natural rights, are commonly thought to provide more rigorous moral rights protection than common law systems, with their reputed utilitarian bent."); SAINSBURY, *supra* note 4, at 19 ("Moral rights originated in civil law jurisdictions, which traditionally place more emphasis on the natural rights of the author than his or her economics rights as the basis for intellectual property protection. In common law jurisdictions, intellectual property protection is more to do with economic protection for the author than natural rights." (footnote omitted)).

¹⁴ See INTERNATIONAL UNION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS, PROCEEDINGS OF THE CONFERENCE HELD AT ROME FROM MAY 7 TO JUNE 2 1928, vol. 1 at 106-07, vol. 2. at 173-82, 200-04 (Pierre Tuisseyre trans., 1929).

¹⁵ See WIPO, GUIDE TO THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS (PARIS ACT, 1971) 43 (1978) [hereinafter WIPO, GUIDE TO THE BERNE CONVENTION].

¹⁶ Berne Convention, *supra* note 3, at art. *6bis*(1).

misattribution; (b) to prevent her name from being attached to works that are not hers, and (c) to prevent others' names from being attached to her works.¹⁷

Under Article 6bis(1), the right of integrity is the author's right "to object to any distortion, mutilation or other modification of, or another derogatory action in relation to, the said work, which would be prejudicial to [the author or artist's] honor or reputation."¹⁸ Again, this right could be understood broadly or narrowly. Under some interpretations, 6bis does not create an obligation to allow artists to stop the complete destruction of their work, because disappearance from the cultural landscape would not necessarily be prejudicial to the author's honor or reputation.

These moral rights are often portrayed as quite alien and distinct from the economic or patrimonial rights associated with copyrighted works, even to the point of touching off an almost metaphysical discussion in Europe over whether authors' rights are dualistic or unitary in nature.¹⁹ Adding to their otherness, these legal notions appeared late, congealing in France as *droit moral* only at the end of the nineteenth century²⁰—well after economic rights had been defined and established in copyright laws in France (1791 and 1793), England (1710), and the United States (1780s). In 1976, Professor John Henry Merryman noted that the "moral right of the artist [is] still comparatively young even in the nation of its origin" and that it probably "has not reached anything like its full development."²¹

Yet there is no question that moral rights reflect some basic equitable ideas of human relations—and have parallels in both general legal norms and nonjuridical norms. The right of attribution, and against misattribution, is clearly akin to our social norm against plagiarism. In fact, the earliest French cases that are now identified as moral rights cases—in the 1820s and 1830s—condemned false

¹⁷ See WIPO, GUIDE TO THE BERNE CONVENTION, *supra* note 15, at 41; WORKING GROUP FINAL REPORT, *supra* note 5, at 547–52. Stephen Ladas divided the right of attribution into three subrights, not including the right of anonymity. STEPHEN P. LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 585 (1938). Australia's 2000 codification specifically separates the right of attribution (section 193) from the right to prevent false attribution (section 195AC). Copyright Act, 1968, §§ 193, 195AC, available at http://www.austlii.edu.au/au/legis/cth/consol_act/ca1968133/.

¹⁸ Berne Convention, *supra* note 3, at 235.

¹⁹ See BERNARD EDELMAN, LA PROPRIETE LITTERAIRE ET ARTISTIQUE 44 (1989) (noting a "dialectic" between economic and moral rights); LUCAS & LUCAS, *supra* note 4, at 300 (noting dualist or unitary debate); ALAIN STROWEL & JEAN-PAUL TRIAILLE, LE DROIT D'AUTEUR, DU LOGICIEL AU MULTIMEDIA para. 62, at 46–47 (contrasting "une vision dualiste" with German law's "doctrine moniste" in which "le droit d'auteur n'est pas la somme des éléments patrimoniaux et personnels, mais un droit unique").

²⁰ See LUCAS & LUCAS, *supra* note 4, at 15–18, 299 ("[O]n est presque surpris de constater qu[e le droit moral] n'est apparu qu'assez tardivement."); ALAIN STROWEL, DROIT D'AUTEUR ET COPYRIGHT: DIVERGENCES ET CONVERGENCES para. 371, at 481 (1993).

²¹ John Henry Merryman, *The Refrigerator of Bernard Buffet*, 27 HASTINGS L.J. 1023, 1026 (1976).

attribution of authorship under general principles of law.²² There is also no question that American copyright law has always had strong secondary strains of natural justice²³ and concern for the author's personality interests.²⁴ Whether common law or civil law, the economic side of copyright often includes nonmarket or antimarket mechanisms to protect authors—reversionary rights in the United States and best-seller rights in Germany. Meanwhile, the moral rights of attribution and integrity are often “monetized” by authors—as when a court awards money damages for lack of attribution, when a famous architect sells the rights to put his name on a building separate from his creative services, and when an artist negotiates a monetary payment to support further works as recompense for the integrity of some existing work being compromised.

²² Cour de Paris [Court of Appeals], March 20, 1826, *Periodique Sirey* 1827.2.155 (false attribution case); Civ. Trib. Seine, December 17, 1838, *Gazette des Tribunaux*, December 18, 1838; Civ. Trib. Seine, March 12, 1836, *reprinted in* EUGENE POUILLET, *TRAITE THEORIQUE ET PRATIQUE DE LA PROPRIETE LITTERAIRE ET ARTISTIQUE ET DU DROIT DE REPRESENTATION* (Georges Maillard & Charles Claro eds., 3d ed. 1908). Then, from the 1880s onwards, French courts built up a large body of cases elaborating the rights of attribution and integrity. *See* William Strauss, *The Moral Right of the Author* (July 1959), *reprinted in* 2 *STUDIES ON COPYRIGHT* 963, 965–76 (Arthur Fisher ed. 1963) [hereinafter Strauss, *The Moral Right of the Author*].

²³ *See, e.g.*, Massachusetts Copyright Act of March 17, 1783, *reprinted in* THORVALD SOLBERG, *COPYRIGHT ENACTMENTS OF THE UNITED STATES, 1783–1906*, at 14 (2d ed. 1906) (saying that security in the “fruits of [authors’] study and industry is one of the natural rights of all men, there being no property more peculiarly a man’s own than that which is produced by the labour of his mind”); New York Act of April 26, 1786, *reprinted in* SOLBERG, *supra*, at 29 (“[I]t is agreeable to the principles of natural equity and justice that every author should be secured . . .”). *See also* Thomas B. Nachbar, *Constructing Copyright’s Mythology*, 6 *GREEN BAG* 20, 37, 44 (2002) (noting that in state copyright acts preceding the 1790 federal law “authors’ natural rights are mentioned as frequently as society’s benefit as the justification for protection”). Even in *Mazer v. Stein*, 347 U.S. 201 (1954), a case widely cited for the Supreme Court espousing the economic incentive theory of copyright, the Court’s economic incentive statement—“[t]he economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors . . .”—is promptly followed by a natural rights-sounding comment: “Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.” *Id.* at 219.

²⁴ “The personality theory of intellectual property had been present in the Anglo-American tradition since the eighteenth century . . .” Carla Hesse, *The Rise of Intellectual Property, 700 B.C.–A.D. 2000: An Idea in the Balance*, *DAEDALUS*, Spring 2002, at 26, 42.

III. THE AMERICAN PATCHWORK FOR BERNE ARTICLE 6BIS

When the United States finally joined the Berne Convention in 1988,²⁵ Congress made clear that the treaty was not self-executing, i.e., that authors would not enjoy causes of action directly arising from the treaty:

The provisions of the Berne Convention, the adherence of the United States thereto, and satisfaction of United States obligations thereunder, do not expand or reduce any right of an author of a work, whether claimed under Federal, State, or common law—(1) to claim authorship of the work; or (2) to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the work, that would prejudice the author's honor or reputation.²⁶

As a result, the few courts that have considered the issue have found that authors have no claims arising from the Berne Convention independent of domestic law.²⁷

While it was absolutely clear in 1988 that moral rights of the Article 6bis sort did not exist in the U.S. copyright statute,²⁸ there was an understandable impulse to minimize any needed changes in statutory copyright law.²⁹ To that end, the House

²⁵ On October 31, 1988, President Ronald Reagan signed the Berne Convention Implementation Act (BCIA), Pub. L. No. 100-568, 102 Stat. 2853 (1988) (codified at 17 U.S.C. §§ 101, 104, 116, 116A, 205, 301, 401-08, 411, 501, 504, 801, 803 (2006)).

²⁶ 17 U.S.C. § 3(b), 102 Stat. 2853, 2854; *see also id.* §§ 3(a), 4(c), 120 Stat. 2853, 2855. Section 4(c) is now codified at 17 U.S.C. § 104(c).

²⁷ *See* *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 195 (S.D.N.Y. 1999) ("Although the Supreme Court has not yet decided the point, it seems quite clear at this point that the Berne Convention is not self-executing."); *Choe v. Fordham Univ. Sch. of Law*, 920 F. Supp. 44, 49 (S.D.N.Y. 1995) (holding that the "Convention itself, as adopted, does not create federal common law action for violation of author's moral rights"); *Rodriguez v. Casa Salsa Rest.*, 260 F. Supp. 2d 413, 422 (D.P.R. 2003); *see also* 3 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 8D.02[D] (2006) [hereinafter *NIMMER ON COPYRIGHT*]. Australian courts have also ruled that Berne is not self-executing. *See* *Minister of State for Immigration and Ethnic Affairs v. Toeh* (1995) 183 C.L.R. 273; *Dietrich v. The Queen* (1992) 177 C.L.R. 292; *New S. Wales v. Commonwealth* (1975) 135 C.L.R. 337.

²⁸ *See, e.g.,* *Vargas v. Esquire, Inc.*, 164 F.2d 522, 526 (7th Cir. 1947) (concluding that there are no moral rights under American copyright law); *Crimi v. Rutgers Presbyterian Church*, 89 N.Y.S.2d 813, 819 (N.Y. Sup. Ct. 1949) (holding that an artist had no customary rights to stop destruction of church mural); *LADAS, supra* note 17, at 802 ("The conception of 'moral right' of authors . . . has not yet received acceptance in the law of the United States. No such right is referred to by legislation, court decisions or writers."); *see also* *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 82 (2d Cir. 1995) (stating that the limited rights recognized under the Visual Artists Rights Act (VARA) "are of recent vintage in American jurisprudence" and that courts have rejected "attempts to inject" such rights into U.S. law more generally).

²⁹ *See, e.g.,* 134 CONG. REC. S14, 552 (daily ed. Oct. 5, 1988) (statement of Sen. Leahy) ("I encouraged my colleagues to make only those changes necessary to our laws

Report on Berne implementation concluded that no amendment of U.S. law was needed because “there is a composite of laws in this country that provides the kind of protection envisioned by Article 6bis.”³⁰ According to the legislative history,³¹ those existing causes of action include:

- 17 U.S.C. § 106 right to prepare derivative works
- 17 U.S.C. § 115 prohibition on distortion of musical compositions³²
- 17 U.S.C. § 203 restriction on termination of licenses and transfers
- Section 43(a) of the Lanham Act
- State right of publicity laws
- State unfair competition laws
- State contract laws
- State fraud and misrepresentation laws
- State defamation laws
- State moral rights legislation³³

This patchwork protection was not an ingenious, last minute creation of Capitol Hill staff in 1988; it had a long conceptual and practical history. The earliest appearance of the patchwork argument in American legal literature may have been in a 1940 article by Martin Roeder.³⁴ William Strauss subsequently wrote a detailed study on the issue in 1959 as part of the long review of American copyright law that contributed to the 1976 Act.³⁵

which are necessary to comply with Berne.”). Reluctance to modify the copyright law may have stemmed from simple conservatism against fiddling with an established law or fresh memories on Capitol Hill from the painfully protracted effort to revise U.S. copyright law in the 1960s and 1970s.

³⁰ H.R. REP. NO. 100-609 at 34 (1988).

³¹ *Id.*

³² *Id.* Section 115(a)(2) of the Copyright Act forbids the party republishing a musical composition in a new sound recording under a compulsory license from changing the basic melody or fundamental character of the work. 17 U.S.C. § 115(a)(2) (2006).

³³ The House report recognized that “eight states have recently enacted specific statutes protecting the rights of integrity and paternity in certain works of art.” H.R. REP. NO. 100-609 at 34.

³⁴ Martin A. Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 554 (1940). Roeder recognized that common law provided some moral rights-like protections. He noted that “[t]he right to prevent deformation has been recognized by English and American courts and theorists. . . . The theories advanced have been manifold.” *Id.* at 565–66 (footnote omitted). Nonetheless, Roeder generally considered these inadequate substitutes for true moral rights provisions. *See id.* at 574.

³⁵ Strauss, *The Moral Right of the Author*, *supra* note 22. Strauss had earlier explored the same issues in William Strauss, *The Moral Right of the Author*, 4 AM. J. COMP. L. 506 (1955).

William Strauss's 1959 monograph concluded that "protection of the moral right varies considerably from one [Berne] member country to another,"³⁶ but, nonetheless, that "[w]ithout using the label 'moral right,' . . . the courts in the United States arrive at much the same results as do European courts."³⁷ Strauss discussed the examples of Britain and Switzerland to describe how countries could provide *6bis* protection without establishing specific *droit moral* causes of action.³⁸ In the case of Great Britain, a 1952 report—preceding the U.K.'s revision of copyright law in 1953—noted that *droit moral* was "a term unknown in our jurisprudence" and opined that many of the concerns addressed by moral rights reasoning "do not lend themselves to cure by legislative action, but are of a type that can best be regulated by contract between the parties concerned."³⁹ Concerning Switzerland, Strauss concluded that *droit moral* was secured only by a general provision of the Civil Code giving injunctive relief to "[a]nyone whose personal rights are violated by an unlawful act" and that "authors as a class enjoy no preferential treatment as regards their personal rights."⁴⁰ He judged such claims to be similar to privacy causes of action under the common law.⁴¹

In a 1967 article, Professor Melville Nimmer had similarly concluded that the moral rights barrier to U.S. accession to Berne was "in part based on a misconception."⁴² Professor Nimmer found that "the substantive content of Article *6bis* is left largely to the determination of domestic legislation"; that "a number of the so-called moral rights receive protection in United States courts"; and, therefore, that "[i]t could be said that the United States does comply with a narrow construction of the requirements of Article *6bis*."⁴³ The credibility of the patchwork argument has been strengthened recently by Cyrill Rigamonti's careful study concluding that "the European concept of moral rights itself is just a

³⁶ Strauss, *The Moral Right of the Author*, *supra* note 22, at 966.

³⁷ *Id.* at 991.

³⁸ *Id.* at 976–78.

³⁹ *Id.* at 976–77 (quoting The Report of the Copyright Committee of 1952, presented by the President of the Board of Trade to Parliament by Command of Her Majesty, October 1952). Immediately following this cryptic comment, the 1952 report recommended that a provision of the Fine Arts Copyright Act giving "artists a measure of protection against unauthorized alteration of their drawings or the fraudulent affixing of signatures to them" be extended to "literary and musical works." *Id.* at 977.

⁴⁰ *See, e.g., id.* at 977 n.71 (describing a Swiss case upholding the right of privacy for an artist's widow and another case recognizing protection for an "artist's personal honor" but not "artistic reputation"). Swiss law of this period was not unique for its use of general civil law provisions this way. In China, the right of attribution can currently be exercised under specific provisions of the copyright law *or* the general civil law principle that everyone has the right to protect his or her name. In a celebrated case in the 1990s, the writer Jia Pingao used the general civil law provisions to successfully sue a publisher who had misattributed a novel to Jia. Xue Hong & Guo Shoukang, *China*, in 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, at CHI-57 to CHI-58 (Paul Edward Geller ed., 2006).

⁴¹ Strauss, *The Moral Right of the Author*, *supra* note 22, at 977–78.

⁴² Nimmer, *supra* note 1, at 518.

⁴³ *Id.* at 522.

patchwork of rules, albeit a highly theorized one”⁴⁴ and that statutory moral rights regimes in the United States and United Kingdom “have likely reduced rather than increased the aggregate level of authorial protection”⁴⁵ compared to the patchworks that preceded conscious efforts to address the moral rights problem.

A. *How the Gilliam Decision Made this Credible*

All this commentary before U.S. accession to Berne was not purely speculative. Clever lawyering had produced moral rights—like protection from existing causes of action in a handful of cases in the 1940s, 50s, and 60s.⁴⁶ Indeed, by 1985, Professor Roberta Rosenthal Kwall could credibly note that “[t]he increasingly liberal applications of unfair competition law generally and § 43(a) of the Lanham Act in particular” had made these causes of action popular “vehicles for redressing alleged violations of interests protected elsewhere by the right of integrity and paternity.”⁴⁷

⁴⁴ Cyrill P. Rigamonti, *Deconstructing Moral Rights*, 47 HARV. INT’L. L.J. 353, 412 (2006).

⁴⁵ *Id.* at 355.

⁴⁶ See *Autry v. Republic Prods.*, 213 F.2d 667, 669 (9th Cir. 1954) (holding that sufficiently severe editing of film could undermine artist’s work); *Granz v. Harris*, 198 F.2d 585, 588–89 (2d Cir. 1952) (finding that sale of abbreviated jazz recordings without producer’s permission constituted breach of contract or the tort of unfair competition); *Carroll v. Paramount Pictures*, 3 F.R.D. 95, 96 (S.D.N.Y. 1942) (holding that false imputation of an inferior work to a producer is libelous per se); *Stevens v. NBC*, 148 U.S.P.Q. 755, 758 (Cal. Super. Ct. 1966) (enjoining the broadcast of an edited version of *A Place in the Sun*); see also *Smith v. Montoro*, 648 F.2d 602, 603, 608 (9th Cir. 1981) (finding violation of § 43(a) of Lanham Act for “reverse passing off” where actor who appeared in the film *Convoy Buddies* had his name replaced).

One could complain that even when artists prevail in these actions, the court’s reasoning shows that moral rights are not being provided. For example, in *Smith v. Montoro*, the Ninth Circuit held that the substitution of one actor’s name for that of another in a film’s credits was improper because “being accurately credited for films in which they have played would seem to be of critical importance in enabling actors to sell their ‘services,’ i.e., their performances.” 648 F.2d at 607. But an actual right of attribution would apply regardless of any economic effect. (We will leave to one side the problem that an actor is not considered a true artist in the continental European legal systems with the strongest moral rights.)

⁴⁷ Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1, 18 (1985) (describing possible causes of action, although finding some deficient); see also Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 354–65 (1988) (discussing how moral rights-like protection might be provided under a compendium of common law causes of action); Comment, *Toward Artistic Integrity: Implementing Moral Rights Through Extension of Existing American Legal Doctrines*, 60 GEO. L.J. 1539, 1545–61 (1972) (presenting alternative common law and contract law theories to protect the same rights that paternity and integrity protect). But see, e.g., Merryman, *supra* note 21 (critiquing “moral rights equivalents” arguments).

This observation about “increasingly liberal application” of the Lanham Act to protect moral rights was anchored in the Second Circuit’s 1976 decision in *Gilliam v. ABC, Inc.*⁴⁸ Indeed, no case gave more credence to the patchwork idea than *Gilliam*, a case in which members of Britain’s Monty Python comedy troupe sought to stop ABC from broadcasting bowdlerized versions of *Monty Python’s Flying Circus*.⁴⁹ The shows were written and taped by Monty Python.⁵⁰ By contract, the BBC was allowed to make only “minor alterations” and such changes “as in its opinion are necessary in order to avoid involving the BBC in legal action or bringing the BBC into disrepute.”⁵¹ The same agreement further—and critically—provided that “subject to the terms therein, the group retains all rights in the script.”⁵²

The BBC subsequently licensed U.S. broadcasting rights for the recorded Monty Python shows to Time-Life, who in turn licensed them to ABC.⁵³ ABC cut 24 minutes from 90 minutes of the original comedy skits in order to make room for commercials and remove material that ABC deemed objectionable.⁵⁴ When the Monty Python writers saw the 27% leaner ABC version, they were “appalled.”⁵⁵

Monty Python’s claims against ABC were a cocktail of copyright infringements, breach of contract, and a “false light” unfair competition claim—two of these being central to the “patchwork” argument.⁵⁶ The Second Circuit reversed the district court’s denial of Monty Python’s motion to enjoin ABC from broadcasting the edited programs. First, the court ruled that Monty Python was likely to succeed on a derivative-work claim against ABC.⁵⁷ Because the troupe had reserved all rights to the Monty Python scripts except those expressly granted to the BBC, each BBC show was a derivative work on a script that still belonged to Monty Python; the substantial editing for ABC’s special made the ABC show a derivative work of the BBC shows and, therefore, also a second-generation derivative-work of the Monty Python scripts. The court concluded that vis-à-vis

⁴⁸ 538 F.2d 14 (2d Cir. 1976).

⁴⁹ *Id.* at 17.

⁵⁰ *Id.* at 17 n.2, 22.

⁵¹ *Id.* at 17 n.2.

⁵² *Id.* at 17.

⁵³ *Id.* at 17–18. The BBC/Time-Life agreement allowed the latter to “edit the programs only ‘for insertion of commercials, applicable censorship or governmental . . . rules and regulations’” and for National Association of Broadcasters requirements. *Id.* at 18. Of course, the BBC probably did not even have the authority to grant this limited editing right to Time-Life since insertion of commercials and addressing U.S. censorship would not be needed to keep the BBC out of legal action absent some preexisting duty to Time-Life. And it would make no sense to interpret the contractual provision so as to allow the BBC to use the subsequent contractual obligations to argue that they were permitted to do such editing under the BBC/Monty Python contract.

⁵⁴ *Id.* at 18.

⁵⁵ *Id.*

⁵⁶ *Id.* at 24.

⁵⁷ *Id.* at 19, 23.

the BBC shows, the ABC shows were authorized derivative works, but vis-à-vis the Monty Python scripts, the ABC shows were wholly unauthorized.⁵⁸

The court then went on to consider whether Monty Python had stated a cause of action under the Lanham Act.⁵⁹ While acknowledging in 1976 that “American copyright law, as presently written, does not recognize moral rights,”⁶⁰ Judge Lumbard concluded that it was possible that ABC’s editing “mutilated the original work and that consequently the broadcast of those programs *as the creation of* Monty Python violated the Lanham Act.”⁶¹ According to Lumbard’s reasoning, ABC’s attributing the ninety minute shows to Monty Python was “a representation [that] . . . although technically true, creates a false impression of the product’s origin.”⁶² In other words, Monty Python could prevail on a Lanham § 43(a) cause of action based on a misattribution claim.

Gilliam’s direct progeny was limited in the courts, but its reasoning was respected, if not controlling, in a number of cases. For example, finding against a copyright licensee for having exceeded permissible derivations from the original work, a 1980 Texas district court cited *Gilliam* for the proposition that “an author should have control over the context and manner in which his or her work is presented.”⁶³ *Gilliam* was similarly cited by the D.C. Circuit in its 1988 *Community for Creative Non-Violence v. Reid* decision for the proposition that the artist in that case “may have rights against [plaintiff] should it publish an excessively mutilated or altered version” of the artist’s work.⁶⁴ And, of course, in the Second Circuit, courts accepted the *Gilliam* approach even when they found that an editor, publisher, or broadcaster’s actions did not rise to the level of actionable *Gilliam* distortion or misrepresentation. In *King v. Innovation Books*, the Second Circuit confirmed that “a false reference to the origin of a work, or a reference which, while not literally false, is misleading or likely to confuse”⁶⁵ was grounds for a Lanham Act § 43(a) claim, but the court concluded that a credit that the derivative work was “based upon” Stephen King’s short story was not

⁵⁸ *Id.* at 19 (“Appellants first contend that the question of ownership is irrelevant because the recorded program was merely a derivative work taken from the script in which they hold the uncontested copyright. Thus, even if BBC owned the copyright in the recorded program, its use of that work would be limited by the license granted to BBC by Monty Python for use of the underlying script. We agree.”). Later the court noted that “[s]ince the copyright in the underlying script survives intact despite the incorporation of that work into a derivative work, one who uses the script, even with the permission of the proprietor of the derivative work, may infringe the underlying copyright.” *Id.* at 20.

⁵⁹ *Id.* at 24.

⁶⁰ *Id.*

⁶¹ *Id.* (emphasis added).

⁶² *Id.*

⁶³ *Nat’l Bank of Commerce v. Shakelee Corp.*, 503 F. Supp. 533, 544 (W.D. Tex. 1980).

⁶⁴ 846 F.2d 1485, 1498–99 (D.C. Cir. 1988), *aff’d*, 490 U.S. 730 (1989).

⁶⁵ 976 F.2d 824, 828 (2d Cir. 1992).

misleading in the way a possessory credit—for instance, “Stephen King’s Lawnmower Man”—would have been.⁶⁶

With its double-barrel derivative work and Lanham Act rationales, it is easy to see how *Gilliam* became a darling of the moral rights contingent. Inspired by *Gilliam*, many commentators have opined on how and when § 43(a) of the Lanham Act could be used by authors and artists to safeguard their right of attribution.⁶⁷ And all this seemed consistent with the intent of the 1976 Copyright Act. The copyright statute expressly provides that it does not limit any other federal cause of action,⁶⁸ while the legislative history of the 1976 Act expressly states that it would not preempt a state law cause of action for misattribution of an audiovisual work.⁶⁹ In a post-*Gilliam* world—including the moment when the Berne Convention was ratified—the patchwork did not look so bad.

B. *The Patchwork Thickens*

In the years following 1988, the patchwork of protection grew thicker. In 1990, Congress passed the Visual Artists Rights Act (VARA),⁷⁰ establishing § 106A of the Copyright Act, a straightforward moral rights provision for works of fine art. Section 106A creates rights of attribution and integrity that (a) belong to the author of the work “whether or not the author is the copyright owner”⁷¹ and (b) “endure for the term consisting of the life of the author.”⁷² The moral rights created by VARA are not quite coextensive with those established by Berne Article 6bis.

The first and most obvious problem is an odd relationship between the term of moral rights required in Article 6bis and the term of moral rights created by

⁶⁶ *Id.* at 831; see also *Choe v. Fordham Univ. Sch. of Law*, 920 F. Supp. 44, 48 (S.D.N.Y. 1995) (noting that Choe’s allegation of mutilation “pales” in comparison to the actionable editing in *Gilliam* and other cases); *Considine v. Penguin, U.S.A.*, No. 91 Civ. 4405, 1992 WL 183762, at *4 (S.D.N.Y. July 20, 1992) (stating that the *Gilliam* reasoning was more appropriate where “the mangling of the artist’s work was more flagrant than in the case before us, or the misrepresentation of the artist’s role in producing the material was more outrageous”).

⁶⁷ See, e.g., Marie V. Driscoll, *The “New” 43(a)*, 79 TRADEMARK REP. 238, 243–44 (1989); Diana Elzey Pinover, *The Rights of Authors, Artists, and Performers Under Section 43(a) of the Lanham Act*, 83 TRADEMARK REP. 38, 48 (1993); Randolph Stuart Sergent, *Building Reputational Capital: The Right of Attribution Under Section 43 of the Lanham Act*, 19 COLUM.-VLA J.L. & ARTS 45, 57 (1995).

⁶⁸ 17 U.S.C. § 301(d) (2006).

⁶⁹ H.R. REP. NO. 94-1733, at 78 (1976) (Conf. Rep.), reprinted in 1976 U.S.S.C.A.N. 5810, 5819.

⁷⁰ Visual Artists Rights Act of 1990, Pub. L. No. 101-650, 104 Stat. 5128 (1990) (codified as 17 U.S.C. § 106A (2006)).

⁷¹ 17 U.S.C. § 106A(b). The separateness of the rights is further elaborated in § 106A(e)(2).

⁷² 17 U.S.C. § 106A(d)(1). Section 106A(d)(2) actually provides for *longer* moral rights for a work that was created before VARA where the artist still holds the copyright to that work. For those works, the moral rights are coterminous with the § 106 rights.

VARA. Berne Article *6bis* requires that moral rights “shall, after [the author’s] death, be maintained at least until the expiry of the economic rights.”⁷³ But it then creates an exception for countries whose “legislation, at the moment of their ratification or accession to this Act, does not provide for the protection after the death of the author of all the rights set out in the preceding paragraph.”⁷⁴ Such countries “may provide that *some* of these rights may, after [the author’s] death, cease to be maintained.”⁷⁵ A reasonable reading of this odd provision is that when a country codifies moral rights—as France and the United Kingdom did *after* Berne accession—the country can allow one, but not both, of the Article *6bis* rights to expire on the author’s death. For works created after VARA’s effective date, June 1, 1991, § 106A rights of both attribution and integrity expire on the author’s death.⁷⁶ This means that VARA, by itself, is not a Berne-compliant moral rights regime for works of fine art.

There are other, subtler ways VARA is probably not coextensive with what Article *6bis* requires. For example, § 106A(a)(3)(A) seems to establish an irrebuttable presumption that “*any* intentional distortion, mutilation, or . . . modification of [a] work” is “prejudicial [to the artist’s] honor or reputation.”⁷⁷ Because not every distortion is prejudicial to an artist’s honor or reputation, this VARA provisions arguably goes beyond what Berne Article *6bis* requires. On the other hand, if a distortion or mutilation is not intentional, VARA offers no protection, while Berne Article *6bis* is not limited to intentional acts.⁷⁸

But the real problem with VARA is not the strength of its provisions, but their limited scope. Section 106A creates moral rights only for “works of visual art,” defined as a painting, photograph, sculpture, drawing, or print that exists in a single copy or a “limited edition of 200 copies or fewer” that are individually signed by the artist.⁷⁹ The legislation, according to one of its co-sponsors, “covers only a very select group of artists.”⁸⁰ Moreover, it covers only the original.⁸¹

⁷³ Berne Convention, *supra* note 3, at art. *6bis*(2).

⁷⁴ *Id.*

⁷⁵ *Id.* (emphasis added).

⁷⁶ See GOLDSTEIN, INTERNATIONAL COPYRIGHT, *supra* note 4, at 284 n.789.

⁷⁷ 17 U.S.C. § 106A(a)(3)(A) (emphasis added).

⁷⁸ Another small example: § 106A(a)(3)(B) gives the artist the right to “prevent any destruction of a work of recognized stature,” including “grossly negligent destruction,” but Article *6bis* is only concerned with destruction that is prejudicial to the artist’s honor or reputation. One could argue that VARA is only superficially different from *6bis* on this count since destruction of “a work of recognized stature” will almost certainly be detrimental to the artist’s reputation.

⁷⁹ 17 U.S.C. § 101 (2006) (definition of a “work of visual art”). The definition has slightly different descriptions for different types of art. A limited edition print, drawing, or photograph must be “signed and consecutively numbered by the author,” while a sculpture cast in two hundred copies or less must “bear the signature or other identifying mark of the author.” *Id.*

⁸⁰ H.R. REP. NO. 101-514, at 11 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6915, 6921 (quoting Rep. Edward Markey); *see also id.* at 6919 (stating that the Congressional debate “revealed a consensus that the bill’s scope should be limited to certain carefully defined

Imagine that an artist sells a VARA-covered sculpture to be installed in a building foyer and the building developer commissions a photographer to produce a quality postcard of the sculpture. If the postcard fails to credit the sculptor, there is no VARA cause of action. If the postcard distorts the sculpture, there is also no VARA cause of action. As Professor Jane Ginsburg puts it colorfully, VARA “reach[es] only the slasher”—someone who distorts the *original* of the work of fine art.⁸²

Thus, VARA put a steel plate into the patchwork—establishing explicit, roughly Berne-compliant moral rights for the original copy in the classical fine arts⁸³—while inevitably accentuating the lack of such rights for other expressive works. On this count, one could criticize VARA as a kind of half-way, checkerboard approach lacking the integrity that gives legitimacy to legislation.⁸⁴ And yet first addressing moral rights for works of fine art made some sense and, as in many policy areas such as health care, environmental protection, and voting rights, surely incremental improvement is better than none at all.

The 1998 Digital Millennium Copyright Act (DMCA) also made an incremental, if unintentional, addition to the patchwork.⁸⁵ Article 12 of the 1996 World Intellectual Property Organization (WIPO) Copyright Treaty (WCT) requires treaty countries to prohibit the removal or alteration of “electronic rights management information” when the actor knows or reasonably should know that the removal or alteration “will induce, enable, facilitate, or conceal an infringement of any right covered by this Treaty or the Berne Convention.”⁸⁶ Section 1202 of the U.S. Copyright Act implements this obligation, broadening the WCT’s “electronic rights management information” into “copyright management information” (CMI) and applying the prohibition on removal or alteration of the information to all physical media or digital copies.⁸⁷

types of works and artists, and that if claims arising in other contexts are to be considered, they must be considered separately”).

⁸¹ 17 U.S.C. § 102(a).

⁸² Jane C. Ginsburg, *Have Moral Rights Come of (Digital) Age in the United States?*, 19 CARDOZO ARTS & ENT. L. J. 9, 11 (2001) [hereinafter Ginsburg, *Have Moral Rights Come of Age*].

⁸³ Or the first two hundred copies in the case of prints. 17 U.S.C. § 106A.

⁸⁴ RONALD DWORKIN, *LAW’S EMPIRE* 176–224 (1986).

⁸⁵ Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended in scattered sections of 17 U.S.C.).

⁸⁶ WIPO Copyright Treaty (WCT) art. 12, Dec. 20, 1996, S. TREATY DOC. NO. 105-17 (1997), 36 I.L.M. 65, available at http://www.wipo.int/treaties/en/ip/wct/pdf/trtdocs_wo033.pdf. There is a parallel provision in the WIPO Performances and Phonograms Treaty (WPPT), Dec. 20, 1996, S. TREATY DOC. NO. 105-17 (1997), 36 I.L.M. 76, available at http://www.wipo.int/treaties/en/ip/wppt/pdf/trtdocs_wo034.pdf.

The Diplomatic Conference on Certain Copyright and Neighboring Rights Questions in Geneva adopted both treaties on Dec. 20, 1996, available at <http://www.copyright.gov/wipo/100dc.html> (last visited Nov. 28, 2007).

⁸⁷ 17 U.S.C. § 1202(c) (including “copies or phonorecords . . . including in digital form” within the definition of CMI).

CMI can include “[t]he name of, and other identifying information about, the author of the work.”⁸⁸ When it does, this often provides a kind of right of attribution,⁸⁹ particularly because “[a]ny person injured by a violation of [§ 1202] may bring a civil action in an appropriate United States district court,”⁹⁰ i.e., the cause of action is not limited to the copyright holder. Nonetheless, there are a couple wrinkles in § 1202 providing a right of attribution.

First, what counts as CMI depends on what “information [is] conveyed in connection with copies or phonorecords of a work or performances or displays of a work,” presumably meaning the initial authorized publication, distribution, or performances.⁹¹ In the initial release, the copyright holder does not have to include any CMI or might decide not to include the name of the author. More generally, because the CMI content would be decided by the copyright holder, § 1202 does nothing for the author vis-à-vis the copyright holder, a common fact pattern in attribution disputes. Second, even if the CMI includes the name of the author, the erasure or alteration of the author’s name is only actionable if the eraser reasonably should have known that the result “will induce, enable, facilitate, or conceal an infringement.”⁹² So far, we have no case law interpreting § 1202, so the facilitate/conceal standard could be very low or very high. Practically speaking, since most publishers do indicate the names of authors,⁹³ § 1202 will generally establish liability against third-party copiers for authorial nonattribution or misattribution as long as the facilitate/conceal standard is not too strict.⁹⁴

⁸⁸ 17 U.S.C. § 1202(c)(2).

⁸⁹ Hughes, *supra* note 5, at 21.

⁹⁰ 17 U.S.C. § 1203(a).

⁹¹ 17 U.S.C. § 1202(c).

⁹² Ginsburg, *Have Moral Rights Come of Age*, *supra* note 82, at 12 (quoting WCT, *supra* note 86). Professor Ginsburg has pointed out that this statutory language technically falls short of the WIPO Treaty obligation—precisely because of our “patchwork” argument. *Id.* at 10. She argues that WCT article 12(1) requires us to prohibit any removal of CMI that would enable or facilitate “an infringement of any right covered by this Treaty or the Berne Convention.” *Id.* at 12. Since Berne includes Article 6*bis*, that means we must prohibit any removal of CMI that would facilitate an infringement of moral rights. But our supposed patchwork puts moral rights protection outside copyright law, so § 1202 does not prohibit removal of CMI that would only enable or facilitate violation of 6*bis* moral rights. Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademark Laws*, 41 HOUS. L. REV. 263, 284–85 (2004) [hereinafter Ginsburg, *Right to Claim Authorship*].

⁹³ The statutory list of CMI includes “[s]uch other information as the Register of Copyrights may prescribe by regulation.” 17 U.S.C. § 1202(c)(8). Professor Ginsburg has suggested that, in the case of works made for hire, the Register could require the names of the contributors to be included. *See* Ginsburg, *Have Moral Rights Come of Age*, *supra* note 82, at 15. This is an intriguing suggestion, but it also opens a larger can of worms. With works for hire, the employer is the author under American law, and the contributors are not authors at all.

⁹⁴ Section 1202(c) does create some exemptions from a right of attribution. 17 U.S.C. § 1202(c) (2006). Under § 1202(c)(4), radio and television broadcasters do not have to provide information about performers of musical compositions when the recorded music is

Beyond these two statutory additions to the patchwork, in the post-1988 period there was what Judge Posner characterized as "glimmers" and "creepings" of moral rights making their way into American law.⁹⁵ On the other hand, Judge Leval—and later Judge Easterbrook—have found themselves holding the fort against the advance of judge-created moral rights.⁹⁶ Easterbrook's role came in the A.R.T. cases, an inconclusive set of skirmishes fought in the late 1980s and early 1990s over whether a purchaser of copies of an artwork could affix those copies to ceramic tiles and resell the tiles.⁹⁷

In the 1988 *Mirage Editions v. Albuquerque A.R.T. Co.* case, the defendant had taken artwork from pages of a commemorative book of Patrick Nagel's art and mounted each image on a ceramic tile with a protective film over the image and exposed tile surface.⁹⁸ In *Munoz v. Albuquerque A.R.T.*, the same defendant engaged in the same mounting activities vis-à-vis notecards carrying the Alaska-themed art of artist Rie Munoz.⁹⁹ In both cases, the Ninth Circuit found that

broadcast; under §1202(c)(5), only the "writer, performer, or director who is credited in [an] audiovisual work" forms part of the CMI when a television station broadcasts a film or television show. The Nimmer treatise discusses "influence during the lobbying process," and points out that cable and Internet stations do not enjoy the 1202(c) limitations. NIMMER ON COPYRIGHT, *supra* note 27, at § 12A.09[A][1]. Although these exceptions may need to be written more widely than they are now drafted, they make sense. A television station cannot be expected to run the three minutes of credits that commonly follow a feature film; a radio station cannot announce all the detailed information found in a CD jewel box. If anything, the § 1202(c)(4) and (5) exceptions point out the work that needs to be done in figuring out what should count as basic CMI that must be carried through different media and delivery channels.

⁹⁵ See *Seshardi v. Kasraian*, 130 F.3d 798, 803–04 (7th Cir. 1997) ("[T]here are glimmers of the moral-rights doctrine in contemporary American copyright law."); *Ty, Inc. v. GMA Accessories*, 132 F.3d 1167, 1173 (7th Cir. 1997) (stating that preliminary injunction "draws additional sustenance from the doctrine of 'moral rights' . . . a doctrine that is creeping into American copyright law"). Posner's remarks, like the mention of moral rights in *Gilliam* itself, seem the sort of jurisprudential musings intended to "stimulate informed commentary" and "provoke future consideration of emerging issues." *United States v. Oshatz*, 912 F.2d 534, 540 (2d Cir. 1990). This understanding of moral rights language in federal case law was suggested by Judge Michael Mukasey in *Choe v. Fordham University School of Law*, 920 F. Supp. 44, 49 (S.D.N.Y. 1995) ("There is no federal claim for violation of Plaintiff's alleged 'moral rights' . . . such emergence should occur in the first instance, if at all, at the circuit level, and not in this court.").

⁹⁶ Pierre N. Leval, *Commentaries: Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1128–29 (1990) (arguing against development of moral rights in copyright law and that "[i]f we wish to create such rights for the protection of artists, we should draft them carefully as a separate body of law, and appropriately define what is an artist and what is a work of art").

⁹⁷ See *Lee*, 125 F.3d at 582–83.

⁹⁸ See *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341, 1342 (9th Cir. 1988). The artworks were single pages taken from *NAGEL: THE ART OF PATRICK NAGEL* (Jeffery Book ed., 1985).

⁹⁹ See *Munoz v. Albuquerque A.R.T.*, 829 F. Supp. 309, 310–311 (D. Alaska 1993).

mounting an artwork to a ceramic tile produced a new derivative work in which the original artwork had been “recast, transformed, or adapted.”¹⁰⁰ In the 1993 *Munoz* case, the district court expressly recognized that while variations in traditional means of framing art do not create derivative works, the ceramic tiles were derivative works because they permanently bound the art to a new medium.¹⁰¹

A few years later, Judge Easterbrook faced the same basic fact pattern and reached the opposite result in *Lee v. A.R.T. Co.*, concluding that the ceramic tiles with epoxy affixed prints lacked “editorial revision, annotations, elaborations, or other modifications”; thus, the tiles were not “original work[s] of authorship”; and, thus, the tiles were not derivative works.¹⁰² Whatever the pro-artist inclinations of his Ninth Circuit brethren, Judge Easterbrook was very clear that he was unwilling to see the derivative-work right as a “back door [for] an extraordinarily broad version of authors’ moral rights.”¹⁰³

The tension in the A.R.T. cases is nothing new. It is found in the contrast between two classic cases commonly taught copyright students. In *Fawcett Publications v. Elliot Publishing*, the defendant bound together multiple second-hand comic books (with different storylines and different copyright owners), and resold them as “Double Comics.”¹⁰⁴ The court concluded that this was permissible because “[t]he exclusive right to vend is limited. It is confined to the first sale of any one copy and exerts no restriction on the future sale of that copy.”¹⁰⁵ Contrast this thinking with the earlier case of *National Geographic Society v. Classified Geographic* in which National Geographic succeeded in stopping the defendant from purchasing copies of the magazine, tearing up the magazines, bringing together articles of the same subjects (horses, birds, fish), and reselling these newly rebound thematic compilations.¹⁰⁶ Conceding that the defendant owned the physical copies of the articles, the court still found that these activities violated the derivative-work right to control compilations, adaptations, and new arrangements of the copyrighted material.¹⁰⁷

In contrast to *Fawcett Publications*, *National Geographic* and the A.R.T. cases, in *Gilliam* the distorted/mutilated work at issue was a different copy than what Monty Python transferred to the BBC. So in *Gilliam* the derivative-work right was not impeded by a first sale in its control of downstream integrity. All this suggests that in present American law, the existence of a right of integrity within copyright law can be understood this way:

¹⁰⁰ *Id.* at 314. See *Mirage Editions*, 856 F.2d at 1343–44.

¹⁰¹ *Munoz*, 829 F. Supp. at 314.

¹⁰² 125 F.3d at 581–83.

¹⁰³ *Id.* at 582. Perhaps to assuage this concern, Ms. Lee had “disclaimed any contention that the sale of her works on tile ha[d] damaged her honor or reputation.” *Id.* at 583.

¹⁰⁴ 46 F. Supp. 717, 718 (S.D.N.Y. 1942).

¹⁰⁵ *Id.* at 718.

¹⁰⁶ 27 F. Supp. 655, 657–62 (D. Mass. 1939).

¹⁰⁷ *Id.* at 659.

Table 1: The Right of Integrity

	Original Copy of Work	Additional Copies of Work
Work of Fine Art	VARA	No VARA Derivative Work Right [if author has ©]
All Other Works	Derivative Work Right [if author has ©] <i>has to battle</i> First Sale Doctrine	Derivative Work Right [if author has ©]

Table 1 substantiates Andre Lucas’s comment from a French perspective that “by exploiting all the resources of economic rights, in particular the right of adaptation, American law can partly compensate for the absence of specific moral rights.”¹⁰⁸ And this substantial interplay between the derivative work right and the moral right of integrity is hardly unique to American copyright law. For example, in *Konami K.K. v. Ichiro Komami*, the Tokyo District Court found the right of integrity in an audiovisual work had been violated by the defendant’s derivative audiovisual work.¹⁰⁹ Plaintiff Konami was the creator of a videogame “simulat[ing] life at ‘Kirameki High’ for a Japanese boy” and featuring, as its principal character, an attractive female student named Shiori Fujisaki.¹¹⁰ The defendant created and distributed a work that lifted the Shiori Fujisaki character—in visual appearance, not name—and “portray[ed] her engaged in sexual conduct as a form of adult entertainment.”¹¹¹ The court concluded that “the defendant ha[d] violated the plaintiff’s right to preserve the integrity of the work by portraying the plaintiff’s character in a context where she is performing sex acts.”¹¹² In short, the case uses the right of integrity to control a derivative work—the converse of the result in *National Geographic*, *Gilliam*, and the A.R.T. cases.

¹⁰⁸ LUCAS & LUCAS, *supra* note 4, at 303 (“C’est d’ailleurs en exploitant toutes les ressources des droits patrimoniaux, notamment du droit d’adaptation, que le droit américain peut compenser en partie l’absence de droit moral spécifique.”) (internal citations omitted).

¹⁰⁹ See Konami, 1696 HANREI JIHŌCHI, 145 (Tokyo Dist. Ct., Aug. 30, 1999), translated in Kenneth L. Port, *Japanese Intellectual Property Law in Translation: Representative Cases and Commentary*, 34 VAND. J. TRANSNAT’L L. 847, 852–53 (2001).

¹¹⁰ Port, *supra* note 109, at 849.

¹¹¹ *Id.* at 850.

¹¹² *Id.* at 853. Kenneth Port has pointed out some of the peculiar aspects of this case, including that it seems to center around damages over “the reputation of a cartoon character.” *Id.* at 855.

IV. THE BROAD *DASTAR* DECISION AND ARTICLE 6BIS

The Supreme Court's *Dastar* opinion unquestionably changed our understanding of the Lanham Act's coverage and, accordingly, the moral rights topography of American law. I hope to convince the reader that the *Dastar* analysis reached the right result, but that the Court's opinion both rests on completely unproven assumptions about consumer expectations and produces an unstable result. This section will also discuss how the Court missed an opportunity to draw a simple, bright line that would have protected copyright's policy of a robust public domain while allowing the Lanham Act to do the same Article 6bis right of attribution work that it had previously done. In this sense, as Graeme Austin has observed, the Court failed to adhere to the basic principle of judicial interpretation that "acts of Congress should never be construed to violate international laws if another interpretation is available."¹¹³ Nonetheless, we will also see that the damage done to the "patchwork" may or may not be as great as some think.

The *Dastar* case is familiar to many readers of this article. In the late 1940s, Time, Inc. produced a television series based on Dwight Eisenhower's book *Crusade in Europe*.¹¹⁴ The television series used narration based on the book and footage from several Allied sources.¹¹⁵ The copyright assignee, Twentieth Century Fox (Fox), failed to renew copyright and the series lapsed into the public domain in 1977.¹¹⁶ Presumably conscious of their lost copyright in the television series, Fox relicensed the television rights to the Eisenhower book in 1988.¹¹⁷ That effectively protected them from any nontransformative reproduction, distribution, or public performance of the television series.¹¹⁸ On the fiftieth anniversary of the end of World War II, *Dastar* released a low-priced video set called *World War II Campaigns in Europe (Campaigns)*, made by shortening and remixing the now public-domain television series:¹¹⁹

Dastar substituted a new opening sequence, credit page, and final closing for those of the *Crusade* television series; inserted new chapter-title

¹¹³ Graeme W. Austin, *The Berne Convention as a Canon of Construction: Moral Rights after Dastar*, 61 N.Y.U. ANN. SURV. AM. L. 111, 111–12 (2005).

¹¹⁴ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 25–26 (2003).

¹¹⁵ *Id.* at 26.

¹¹⁶ *Id.*

¹¹⁷ *Id.*; see also Brief for the United States as Amicus Curiae Supporting Petitioners at 2, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (No. 02-428), 2003 WL544536 [hereinafter United States Amicus Brief] (discussing respondents "exclusive right to distribute the *Crusade* television series on video, and to sublicense others to do so").

¹¹⁸ See *Dastar*, 539 U.S. at 26. In other words, as long as the *Crusade* television series was a derivative work on the book and Fox had the exclusive license to broadcast or distribute any television derivative works on the book, Fox could stop someone from distributing or broadcasting the *Crusade* show proper.

¹¹⁹ *Id.* at 26–27.

sequences and narrated chapter introductions; moved the "recap" in the Crusade television series to the beginning and retitled it as a "preview"; and removed references to and images of the book. Dastar created new packaging for its Campaigns series and (as already noted) a new title.¹²⁰

Dastar then marketed the video set as its own product, making reference to neither the Fox series nor the Eisenhower book.¹²¹

Fox brought suit against Dastar alleging copyright infringement of its rights to the Eisenhower book and reverse passing off of the origin of the television series in violation of § 43(a) of the Lanham Act.¹²² The trial court granted summary judgment for Fox on both claims.¹²³ The Ninth Circuit reversed on the copyright issues, but affirmed judgment for Fox on the reverse-passing-off claim.¹²⁴ The Ninth Circuit concluded that Dastar's "label[ing] the resulting product with a different name and . . . without attribution to Fox" constituted a "bodily appropriation" of the Fox series "sufficient to establish reverse passing off."¹²⁵ The Supreme Court granted certiorari to resolve the scope of § 43(a) of the Lanham Act in regards to a previously copyrighted work that has fallen into the public domain.¹²⁶

Section 43(a) is a complex provision, offering two possible prongs of liability. The first, § 43(a)(1)(A), creates liability where:

A false designation of origin, false or misleading description of fact, or false or misleading representation of fact . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person¹²⁷

¹²⁰ *Id.*

¹²¹ *Id.* at 27.

¹²² *Id.* at 27, 29. The suit was brought under 15 U.S.C. § 1125(a)(1)(A) (2006). *See Dastar*, 539 U.S. at 27, 36. Fox also sued Dastar for reverse passing off under state unfair competition law, but the trial court folded resolution of the state law claims into the Lanham Act analysis, and the Ninth Circuit was silent on the issue. *Id.* at 27–28.

¹²³ *Id.*

¹²⁴ *Id.* at 28.

¹²⁵ *Id.* (quoting *Twentieth Century Fox Film Corp. v. Entm't Distrib.*, 34 Fed. App'x 312, 316 (9th Cir. 2002)).

¹²⁶ *See Dastar*, 539 U.S. at 31 ("At bottom, we must decide what § 43(a)(1)(A) of the Lanham Act means by the 'origin' of 'goods.'").

The United States' amicus brief described the question before the Court more broadly as "[w]hether and to what extent the Lanham Act, 15 U.S.C. 1125(a), prevents the uncredited copying of a work." United States Amicus Brief, *supra* note 117, at *1.

¹²⁷ Trademark (Lanham) Act of 1946 § 43(a)(1), Pub. L. 79-489, 60 Stat. 441 (current version at 15 U.S.C. § 1125(a)(1) (2006)). In full, §43(a) of the Lanham Act, as amended, now provides:

We will turn shortly to the complexity which results from embedding so many terms into this provision. The second prong, § 43(a)(1)(B) does not require a likelihood of confusion, but is limited to advertising or promotion that has a false claim of “origin” or “fact” that “misrepresents the nature, characteristics, qualities, or geographic origin” of the goods.¹²⁸ Without relying on 43(a)(1)(B), Fox’s argument was limited to the claim that Dastar’s labelling of the video set as its own “without acknowledging its nearly wholesale reliance on” the Fox series created a “false designation of origin . . . likely to cause confusion . . . as to the origin” of the goods under § 43(a)(1)(A).¹²⁹

The unanimous *Dastar* opinion begins by framing the question very simply: does “origin” in § 43(a) mean “the manufacturer or producer of the physical ‘goods,’” and/or does it include “the creator of the underlying work”?¹³⁰ If the former, there is no problem in Dastar’s taking all the credit for the video set, because it was the manufacturer. If the latter, then whereas copyright policy seeks the unimpeded use of works in the public domain, the Lanham Act could chill such uses by requiring proper attribution of the origin of public domain materials. There is no statutory definition of “origin” in the Lanham Act and, to complicate matters, the posture of the case depended on a long-standing judicial gloss that § 43(a) also applies to omissions of designation of origin.¹³¹ The Copyright Act itself expressly

-
- (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
- (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . ,
 - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1) (2006).

¹²⁸ *Id.* at § 1125(a)(1)(B).

¹²⁹ *Dastar*, 539 U.S. at 31 (quoting Lanham Act § 43(a)(1)(A)).

¹³⁰ *Id.* Scalia originally suggests that a very restrictive understanding of “origin”—limited to “geographic origin”—was the proper interpretation of the original § 43(a), but recognizes that all circuit courts interpreted the phrase to include “origin of source or manufacture” and Congress confirmed that reading of the statute in 1998. *Id.* at 29–30.

¹³¹ This is typically half of the reverse-passing-off claim: the defendant used their own name and omitted the plaintiff’s name. *See* *Smith v. Montoro*, 648 F.2d 602, 605 (9th Cir. 1981). As David Nimmer notes:

Although it certainly had the opportunity to track *Montoro*’s language in the Trademark Law Revision Act of 1988, Congress declined to do so. Indeed,

provides that it does not limit any other federal cause of action;¹³² the Lanham Act is silent on its relationship to copyright law. Thus, the whole case was framed as being about reconciling trademark law with fundamental copyright policy.¹³³

One available means to reconcile the statutes—a path not taken by the Court—was to allow the § 43(a) cause of action for nonattribution to creative origin to stand, but to correct the Ninth Circuit's wandering away from a genuine likelihood-of-confusion standard. In a series of cases beginning in 1981, both the Ninth Circuit¹³⁴ and the Second Circuit¹³⁵ permitted likelihood of confusion in the case of expressive works to be shown by similarity of the plaintiff's and defendant's products, without the traditional multi-factor test applied in all other Section 43(a) cases. As the amicus brief of the International Trademark Association (INTA) noted, "the Ninth Circuit has never explained why it believes the mere replication of a product, literary or industrial, will likely produce consumer confusion irrespective of the commercial context."¹³⁶ The Court could have rejected this Ninth Circuit "bodily appropriation" standard, remanded for application of a *Sleekcraft* analysis, and expressed doubt that confusion as to origin is ever likely from a failure to name a prior copyright holder who was never an author of the work.¹³⁷

Congress considered and rejected a proposal to expand section 43(a) to prohibit any "omission of material information." It rejected that suggestion because it "raised difficult questions [of] freedom of speech."

Nimmer, *supra* note 8, at 33–34 (citations omitted). Omission of this 'omissions of material fact' proposal was also explained in the Senate Report as being because the proposal "could be misread to require that all facts material to a consumer's decision to purchase a product or service be contained in each advertisement." S. REP. NO. 100-515, at 41 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5603.

¹³² 17 U.S.C. § 301(d) (2006) ("Nothing in this title annuls or limits any rights or remedies under any other Federal statute.").

¹³³ Richard Posner has put it bluntly: "[t]he Court based this holding on its belief that the copyright statute itself creates a right to such copying [without attribution]." Richard A. Posner, *Misappropriation: A Dirge*, 40 HOUS. L. REV. 621, 639 (2003).

¹³⁴ *Cleary v. News Corp.*, 30 F.3d 1255, 1261 (9th Cir. 1994) (stating bodily appropriation "might cause customer confusion"); *Shaw v. Lindheim*, 919 F.2d 1353, 1364 (9th Cir. 1990) (first case to use "bodily appropriation" as a phrase; nonattribution in the form of failure to give writing credit); *Smith v. Montoro*, 648 F.2d 602, 606–07 (9th Cir. 1981) (holding nonattribution and misattribution where the plaintiff actor's name was removed from film credits and another actor's name substituted).

¹³⁵ *Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775, 784 (2d Cir. 1994).

¹³⁶ Brief of Amicus Curiae The International Trademark Association in Support of Neither Party at *15–16, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (No. 02-428), 2003 WL 367725; *see also* United States Amicus Brief, *supra* note 117, at *26–28.

¹³⁷ On this count, the *Dastar* fact pattern gave the Court an easy out. Fox had taken the copyright by assignment; it was not a Fox work for hire. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 25–26 (2003).

But this approach would not have dissipated the cloud of possible Lanham Act claims over public-domain works. Perhaps intentionally ignoring the fact that Fox was only a copyright assignee, the Court believed that Fox's claim interpreted § 43(a) of the Lanham Act as creating a cause of action for, in effect, plagiarism.¹³⁸ On the other hand, if Dastar had credited Fox on the Dastar video set, the kind of credit that would obviate plagiarism/reverse passing off, Fox would still have had a § 43(a) cause of action:

On the one hand, [Dastar] would face Lanham Act liability for *failing* to credit the creator of a work on which their lawful copies are based; and on the other hand they could face Lanham Act liability for *crediting* the creator if that should be regarded as implying the creator's "sponsorship or approval" of the copy.¹³⁹

Fox's ability to jump either way on § 43(a)—suing for nonattribution of origin or suing for misattribution of sponsorship or approval—would chill uses of a work otherwise in the public domain. The Court rejected this interpretation of § 43(a) because it would create a cause of action against "the use of otherwise unprotected words and inventions without attribution."¹⁴⁰

Since the Scylla and Charybdis facing Dastar were two distinct notions within § 43(a)—"origin" and "sponsorship" (or "approval"), one might have thought that the *Dastar* opinion would say more about how the complex wording of section 43(a) is to be construed. The truth is that we have had surprisingly little jurisprudence—from either courts or commentators—trying to unpack all the notions crammed together in § 43(a).¹⁴¹ For example, there are at least sixteen "or"s in § 43(a)(1)(A), producing a liability provision completely unencumbered by clarity.

¹³⁸ *Id.* at 36.

¹³⁹ *Id.*

¹⁴⁰ *Id.* The Court said that this would be "akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do." *Id.* at 37.

¹⁴¹ For example, the McCarthy treatise makes almost no attempt. 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:13, at 27-26 to 27-27 (4th ed. 2007) [hereinafter MCCARTHY ON TRADEMARKS] (showing very limited parsing of a § 43(a)(1)(A) claim without any explanation of various terms). *But see* Ginsburg, *Right to Claim Authorship*, *supra* note 92, at 274-75.

Table 2: The Mess of Section 43(a)

Instrumentality	Caused State of Mind	Nature or Object of the State of Mind
<p><i>Any:</i></p> <ul style="list-style-type: none"> • word, • term, • name, • symbol, • device, • [or any combination thereof], or • false designation of origin, • false or misleading description of fact, • false or misleading representation of fact, • [or omission thereof]; 	<p><i>Which is likely:</i></p> <ul style="list-style-type: none"> • to cause confusion, • to cause mistake, or • to deceive; 	<p><i>As to the:</i></p> <ul style="list-style-type: none"> • affiliation [of such person with another person], • connection [of such person with another person], or • association for such person with another, or • origin, sponsorship, or approval [by another] of the goods, services, or commercial activities.

Table 2 shows an initial untangling of the grammatical thicket of §43(a)(1)(A). Column one of Table 2 shows the instrumentality of a § 43(a) claim, basically divided into two groups: (a) signifiers in the simplest sense—any word or any symbol—and (b) three specific types of false/misleading assertions: false designations of origin, false or misleading descriptions of fact, and false or misleading representations of fact. In addition to the statutory language found in § 43(a), courts have added an additional “or” by including omission on the list of instrumentalities. An instrumentality in the first column causes an error—likelihood of confusion, mistake, or deceit (in the second column) as to some state of affairs (shown in the third column). The state of affairs includes the origin of the goods, but it also includes confusion as to affiliation, connection, or association—of one person with another, or sponsorship or approval—of goods, services, or commercial activities.

Fox’s claim was for “false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion . . . as to the origin . . . of his or her goods.”¹⁴² Notice this claim

¹⁴² *Dastar*, 539 U.S. at 31 (quoting Brief for Respondents at *8, 11, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (No. 02–428), 2003 WL 1101321) (emphasis added).

uses origin on both sides, but exclusively so on the state of affairs side. That is the core nature of a passing-off or reverse-passing-off claim: the state of affairs for which confusion has been made probable is the origin of the goods or services.

Untangling § 43(a) helps clarify the damned-if-you-do, damned-if-you-don't argument that seems to put such a chill over public-domain materials. To the degree that *Campaigns'* packaging or screen credits said "DASTAR Corp. presents," or "Produced and Distributed by Entertainment Distributing," there was no § 43(a) offending effect, because these descriptions or representations of fact were true.¹⁴³ Similarly, Fox would not have had a § 43(a) misattribution claim against Dastar if Dastar has labeled their videotape boxes "prepared from materials previously copyrighted by Twentieth Century Fox, who did not approve this video set and is not affiliated with Dastar," that description of fact would have been true also. In other words, the "damned-if-you-do" side is not as potent as the Court makes out.

The real problem is the "damned-if-you-don't" side. The problem arises from our addition of omissions to the § 43(a) instrumentalities list. Including omissions creates labelling duties of unknown scope; this is the Court's how-far-up-the-Nile problem.¹⁴⁴ To avoid a nonattribution claim, would the origin portion of the label have to include Time, Inc.?¹⁴⁵ And all the Allied government agencies whose newsreels had been included?¹⁴⁶ And the unidentified "Newsreel Pool Cameramen"?¹⁴⁷

In its amicus brief on behalf of the United States, the Department of Justice (DOJ) recognized the perpetual protection problem that figured so strongly in the Court's opinion,¹⁴⁸ but properly focused on the liability being generated by nonattribution. The DOJ reasoned that the Ninth Circuit's decision was based on the videotapes being marketed "without attribution to Fox" and therefore the case was only about nonattribution, not misattribution.¹⁴⁹ The DOJ argued that the

¹⁴³ *Id.* at 27 (noting that Entertainment Distributing was an entity owned by Dastar). This made the *Dastar* fact pattern quite distinct from a fact pattern in which there is an active misrepresentation (like a snuff movie marketed as "directed by George Lucas"). See *supra* Part III.A.

¹⁴⁴ *Dastar*, 539 U.S. at 36.

¹⁴⁵ *Id.* at 25–26.

¹⁴⁶ *Id.* (noting that the *Crusade* television series contained "footage from the United States Army, Navy, and Coast Guard, the British Ministry of Information and War Office, [and] the National Film Board of Canada").

¹⁴⁷ *Id.*

¹⁴⁸ See United States Amicus Brief, *supra* note 117, at *6 (arguing that if § 43(a) were construed to "establish a generalized duty on the part of producers to credit the original creators of works" such a construction would "overextend the Lanham Act by giving the original creators of works a perpetual *trademark* right to prevent the uncredited copying of a work."); *id.* at *21 (noting that "the Court should avoid construing the Lanham Act in a manner that would enable creators to extend in perpetuity the protections available to creators for only a limited time under the patent and copyright laws").

¹⁴⁹ *Id.* at *7. So, by the DOJ's lights, Fox's only complaint, in the posture of the case, was for the omission of their name, not the inclusion of Dastar's name, meaning Fox could

Lanham Act protects against (a) claiming credit for someone when no credit is due that person, but not (b) failing to give credit to someone when credit is due that person.¹⁵⁰ When only (b) occurs, the DOJ argued that there is no Lanham cause of action.¹⁵¹

But neither INTA's nor the DOJ's arguments would have served the political purpose of the *Dastar* opinion, as the Court's 2003 Term counterweight to *Eldred v. Ashcroft*.¹⁵² Where *Eldred* accepted Congress's twenty-year extension of copyright—thereby sharply curtailing what will go into the public domain for decades¹⁵³—*Dastar* shows the Court to be highly protective of the public domain. A decision based on failure to prove likelihood of confusion or narrowly focused on nonattribution would not have given the Court a platform to speak boldly about the public domain. To get that platform for copyright policy, the Court offered us a new, borderline-surreal interpretation of "origin" in § 43(a).

The Court concluded that "the most natural understanding of the 'origin' of 'goods' . . . is the producer of the tangible product sold in the marketplace" and that "as used in the Lanham Act, the phrase "origin of goods" is in our view incapable of connoting the person or entity that originated the ideas or communications that goods embody or contain."¹⁵⁴ Thus, *Dastar* holds that § 43(a) "origin" means the manufacture of the physical product and never means "the person or entity that originated the ideas or communications"¹⁵⁵ embodied or contained in the physical product. *Dastar* "manufactured and sold the set of *Campaigns* videotapes as its own good."¹⁵⁶ Fox was not involved in any way in the manufacture of the videotapes. This seemed like a remarkably clean way to close the matter, particularly against the view that Fox's "argument accord[ed] special treatment to communicative products," although the very examples the Court used

not object when *Dastar* used its own name because that was accurate as to the physical origin of the tapes.

¹⁵⁰ *Id.* at *18, ("[T]he case law does suggest that the Lanham Act does not create a duty of express attribution, but does protect against misattribution." (quoting *Cleary v. News Corp.*, 30 F.3d 1255, 1260 (9th Cir. 1994))).

¹⁵¹ The DOJ distinguished *Smith v. Montoro* on this ground because it involved the removal of actor Paul Smith's name from a film's credits and the substitution of another actor's name, Bob Spencer, although Spencer did not appear in the film. See United States Amicus Brief, *supra* note 117, at *6 (citing *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981)). The McCarthy treatise similarly notes that *Montoro* "holds only that mis-attribution violations § 43(a), not that the mere removal of a credit created falsity and not that every actor and everyone that worked on a film is entitled under § 43(a) to receive screen credit." 5 MCCARTHY ON TRADEMARKS, *supra* note 141, § 27:85, at 27-202 to 27-203 (4th ed. 2007). This is also the position taken by the Restatement of Unfair Competition. RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 2-4 (1995).

¹⁵² 537 U.S. 186 (2003).

¹⁵³ *Id.* at 205-06.

¹⁵⁴ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 24 (2003).

¹⁵⁵ *Id.*

¹⁵⁶ United States Amicus Brief, *supra* note 117, at *3.

show that the court was aware its holding applies far beyond the copyright realm.¹⁵⁷

But the line(s) drawn by *Dastar* may not be easy to defend. For example, the Court used VARA to support its limitation on § 43(a) origin.¹⁵⁸ The Court reasoned that interpreting § 43(a) to protect against artistic misattribution and nonattribution would render both the substance and the time limitations of the VARA right of attribution “superfluous.”¹⁵⁹ This would be a fine argument, except that VARA does not involve any likelihood-of-confusion requirement.¹⁶⁰ The VARA 17 U.S.C. § 106A(a)(1)(A) cause of action is a genuine, straightforward nonattribution claim. Indeed, remanding on the grounds that the Ninth Circuit had failed to apply a real likelihood-of-confusion test would have contrasted Lanham § 43(a) with § 106A.

More importantly, the Court tells a strange, strange tale about the psychology of consumers:

[T]he brand-loyal consumer who prefers the drink that the Coca-Cola Company or PepsiCo sells, while he believes that that company produced (or at least stands behind the production of) that product, surely does not necessarily believe that that company was the “origin” of the drink in the sense that it was the very first to devise the formula. The consumer who buys a branded product does not automatically assume that the brand-name company is the same entity that came up with the idea for the product, or designed the product—and typically does not care whether it is.¹⁶¹

Perhaps consumers do not always “automatically” assume that the brand-name company “came up with the idea for the product,” but it is hard to think of worse examples for Scalia’s argument.

There is a robust folklore about the Coca-Cola formula: it was invented by Dr. John Pemberton, who, along with his accountant, also created the Coca-Cola name and classic logo.¹⁶² There is an unbroken line between the persons who devised the formula, name, and logo—all the key ideas—and the modern Coca-Cola corporation. The same with Pepsi, a formula originally concocted by pharmacist Caleb Bradham, who christened it “Pepsi-Cola” and formed the Pepsi Cola

¹⁵⁷ *Dastar*, 539 U.S. at 33; see, e.g., Tom W. Bell, *Misunderestimating Dastar: How the Supreme Court Unwittingly Revolutionized Copyright Preemption*, 65 MD. L. REV. 206, 208 (2006) (observing how the *Dastar* ruling applies to trade secrecy-protected works, patented works, and services).

¹⁵⁸ *Dastar*, 539 U.S. at 34–35.

¹⁵⁹ *Id.* (quoting 17 U.S.C. § 106A(d)(1) (2006)).

¹⁶⁰ See also Ginsburg, *Right to Claim Authorship*, *supra* note 92, at 283 (discussing why “section 43(a) does not make VARA superfluous”).

¹⁶¹ *Dastar*, 539 U.S. at 32.

¹⁶² See generally MARK PENDERGRAST, *FOR GOD, COUNTRY, AND COCA-COLA* (1993).

Company. The Pepsi formula was changed in the 1930s, but, again, by a person who owned the Pepsi Cola Company. And neither company actually produces most of the cola products marketed under their names—almost all the cans and bottle say so. With these products, it is not clear whether “origin” to a consumer would mean manufacturing entity or entity that “came up with the idea.”

Trademarks no longer identify the manufacturing or productive origin of many consumer products today in the sense that products are often physically fabricated in facilities that belong to someone besides the trademark holder. Consider the view in a leading businessperson’s book on intellectual property: “[f]irms such as Coca-Cola and Sara Lee extract the bulk of their IP value (and even their corporate value) from their trademarks. Neither of them is a classic ‘manufacturer.’ Instead, they licence their brand to selected companies who make the actual Coca-Cola or Sara Lee products.”¹⁶³

Ford may still make its own Mustangs and Proctor & Gamble may still make its own Ivory soap, but Apple does not make its own computers;¹⁶⁴ none of the consumer electronics marked “RCA” are made by Radio Corporation of America (which no longer exists); Gap clothes are made in east Asian factories; and most fast food is prepared, on location, by independent franchisees using products from independent fast food chain contractors.¹⁶⁵ What makes a Big Mac a Big Mac is that it is made to McDonald’s Big Mac specifications, McDonald’s being “the very first to devise the [Big Mac] formula.”¹⁶⁶

And it is reasonable—as or more reasonable than Justice Scalia’s assumptions—to believe that a very large percentage of consumers know much of this. Indeed, many large companies that purvey ideas-based products are quite public about others doing the manufacturing. For example, in the Washington, D.C. area, both McDonald’s and Pepsi advertise their local African-American franchisees.¹⁶⁷ When a consumer purchases a Dior dress or a Perry Ellis shirt or a

¹⁶³ JULIE L. DAVIS & SUZANNE S. HARRISON, *EDISON IN THE BOARDROOM* 74 (2001).

¹⁶⁴ Technology companies like Apple, Sun, Cisco, IBM, Dell, and Hewlett-Packard do less and less actual manufacturing these days. Instead, they rely on electronic manufacturing services (EMS) companies like Solectron, Flextronics, Sanmina-SCI, Celestica, and Jabil Circuit (the top five EMS companies). See Bernard Levine, *EMS Elite in Billionaire Club: Solectron Leads Pack with \$16b in 2001 Revenue-Packaging*, *ELECTRONIC NEWS*, May 13, 2002, at 1–2, http://www.findarticles.com/p/articles/mi_m0EKF/is_20_48/ai_86039426 (last visited Nov. 28, 2007). Meanwhile, laptop PCs for Dell, IBM, Apple, Compaq, Gateway, and, probably, Toshiba and Sony, have been made by Quanta—a company most American consumers have never heard of. See Robert Blincoe, *Quanta Laptop Dances in Pole Position*, *THE REGISTER*, November 19, 2001, at 2, http://www.theregister.co.uk/2001/11/19/quanta_laptop_dances_in_pole/ (last visited Nov. 28, 2007).

¹⁶⁵ For a disturbing fictionalized account of a fast food chain’s hamburger patties coming from a contractor, see the film *FAST FOOD NATION* (BBC Films 2006).

¹⁶⁶ See *Dastar*, 539 U.S. at 32.

¹⁶⁷ There are 327 franchisees in the National Black McDonald’s Operators Association with 800 restaurants and \$1 billion in annual sales, facts that McDonald’s

Chanel handbag, is Scalia correct that the consumer does not “assume that the brand-name company is the same entity that came up with the idea for the product, or designed the product”? Is Scalia correct that this consumer “typically does not care whether it is”? Many of us have a different understanding of what consumers expect from branded products: consumers expect that Apple designed its products, expect that Microsoft designed its products, and expect that Perry Ellis, Chanel, and Yves St. Laurent designed their products.¹⁶⁸

Of course, the Justices have some sense of modern brand and trademark licensing. Hence the Court’s locution that the modern consumer “believes that that company produced (or at least stands behind the production of) that product.”¹⁶⁹ The Court repeats this point, acknowledging that the origin of the goods “might be stretched . . . to include not only the actual producer, but also the trademark owner who commissioned or assumed responsibility for (‘stood behind’) production of the physical product.”¹⁷⁰ By the time Scalia has stretched “origin” this far, the term begins to look like “sponsorship” or “approval,” other bases for likelihood of confusion under § 43(a)(1)(A).

In other words, the strict holding of *Dastar* is founded on an unproven empirical claim that we have no good reason to believe. Indeed, survey data shows that most Americans do not believe that McDonald’s restaurants are owned and operated by McDonald’s—meaning they expect that the burger they pick up is not “produced” (in the sense of cooked and prepared) by the trademark holder.¹⁷¹ There is extensive case law that assumes consumers know that providers of some services—franchise businesses—are not the actual trademark holders.¹⁷² To make

publicly trumpets. See <http://www.mcdonalds.com/corp/about/factsheets.html> (follow “Commitment to African-American Community” hyperlink) (last visited Nov. 28, 2007).

¹⁶⁸ I chose those examples intentionally because, of course, Coco Chanel and Perry Ellis are dead. Yves St. Laurent retired from designing. But it is unclear whether expectations are related to the individual person or the “design house,” making Chanel more like Apple. In recent decades, fashion design houses have had no problem trumpeting their new designers, as with Karl Lagerfeld restoring the glamour to Chanel in the 1980s and Tom Ford doing the same for Gucci in the 1990s.

¹⁶⁹ *Dastar*, 539 U.S. at 32.

¹⁷⁰ *Id.* at 31–32.

¹⁷¹ In an early 1990s survey of 307 people, 54.6% believed that most McDonald’s restaurants are “locally and nationally owned and operated.” Robert W. Emerson, *Franchisors’ Liability When Franchisees Are Apparent Agents: An Empirical and Policy Analysis of “Common Knowledge” About Franchising*, 20 HOFTSRA L. REV. 609, 680 (1992). In another survey of 328 college students, when asked “[i]f a fast-food restaurant is a ‘McDonald’s,’ in your opinion does that mean it is owned by the McDonald’s Corporation?” 49.1% of college students said “Probably No” or “Definitely No,” while 5.8% said they “Did Not Know.” *Id.* at 672–73.

¹⁷² As the Florida Supreme Court wrote in 1995, “[i]n today’s world, it is well understood that the mere use of franchise logos . . . does not necessarily indicate that the franchisor has actual or apparent control over any substantial aspect of the franchisee’s business.” *Mobil Oil Corp. v. Bransford*, 648 So. 2d 119, 120 (Fla. 1995). This line of cases extends back to at least 1939; while concentrated on gasoline stations, the reasoning

even this noncorroborated empirical claim sound credible, the court stretches the manufacturing notion of "origin" so that it blends into distinct notions found in § 43(a): sponsorship or approval.

A. *Dastar Hurts the Patchwork Where It Was Already Weak*

What is the effect of this ruling on the Lanham Act element of our *6bis* composite? To recap, the *6bis* right of attribution has been interpreted as establishing a small constellation of rights:

- (a) the right for the author to be attributed on the author's own work—that is, a right against nonattribution;
- (b) the right to remain anonymous or use a pseudonym, in relation to (a);
- (c) the right against misattribution, that is, to stop attachment of the author's name to a work that is not the author's; and
- (d) the right against misattribution, considered as attachment of another's name to a work that is the author's.

One could organize these rights in different ways, but the Berne treaty language foremost secures (a): the right to be attributed and to prevent nonattribution.¹⁷³

But the American patchwork is arranged in the opposite way, offering the surest protection against (c) and (d), which focus on misattribution, while offering

has included car dealerships and hotels. *See, e.g., Apple v. Standard Oil, Div. of Am. Oil Co.*, 307 F. Supp. 107, 114 (N.D. Cal. 1969) (finding it a "matter of common knowledge" that trademarks are displayed by independent dealers (quoting *Reynolds v. Skelly Oil Co.*, 287 N.W. 823, 827 (Iowa 1939))); *Wood v. Shell Oil Co.*, 495 So. 2d 1034, 1039 (Ala. 1986) (noting that the "vast majority" of courts have assumed common knowledge among consumers about independent dealers); *Trust Co. of Chi. v. Sutherland Hotel Co.*, 58 N.E.2d 860, 863 (Ill. 1945) (concerning a Howard Johnson motel, "[i]t is common knowledge that the names by which hotels are known to the public are often those of an individual who has no interest in the management of the business or the ownership of the building"); *Reynolds v. Skelly Oil Co.*, 287 N.W. 823, 827 (Iowa 1939) (rejecting the argument that "because the word 'Chevrolet' or 'Buick' is displayed in front of a place of business, General Motors would be estopped to claim that it was not the owner of the business. It is a matter of common knowledge that these trademark signs are displayed throughout the country by independent dealers."); *Chevron, U.S.A., Inc. v. Lesch*, 570 A.2d 840, 846 (Md. 1990) (noting that a majority of courts have assumed common knowledge among consumers about independent dealers). For thoughtful criticism of these cases, see Emerson, *supra* note 171, at 638–45; Lynn M. LoPucki, *Toward a Trademark-Based Liability System*, 49 UCLA L. REV. 1099 (2002).

¹⁷³ According to the Lucas treatise, "it is universally recognized that the author can demand that the work be distributed under his name." The Lucas treatise goes on to note that the suing for the right of attribution is possible in the case of "omission;" that the right applies to derivative works; and that it applies to collective works. LUCAS & LUCAS, *supra* note 4, at 326.

the weakest protection against (a). The dominant default value in U.S. copyright law is that the author does not have a right to prevent nonattribution, although they can demand such a right contractually when they license or transfer copyright.¹⁷⁴ The only way that William Strauss could claim in 1959 that “both here and abroad . . . [a]n author has the right to be given credit in the publication, performance, adaptation, or other use of his work,”¹⁷⁵ was by seeing this right of attribution as latent in the control of an unfettered copyright. But as Melville Nimmer noted, contract law provides “no right at all, since a right dependent upon the voluntary agreement of individual contracting parties . . . hardly satisfies the [Berne] Convention requirement of obligatory recognition.”¹⁷⁶

In contrast, the misattribution claims, (c) and (d), can trigger strong background concerns in U.S. law against deception of consumers, unfair competition, defamation, and invasion of privacy.¹⁷⁷ Thus the most successful cases have been claims against putting someone else’s name on a work, like in *Smith v. Montoro*,¹⁷⁸ or against putting an author’s name on a work that is not hers,

¹⁷⁴ See *Harris v. Twentieth Century Fox Films*, 35 F. Supp. 153, 155 (S.D.N.Y. 1940) (holding that absence of contractual provision for author’s credit eliminated “all rights generally known as the moral rights of authors, which rights include the right to credit as author of a work”); *Morton v. Raphael*, 79 N.E.2d 522, 524 (Ill. App. Ct. 1948) (“As the author has no inherent common law right to have his name used in connection with his work, his name may be wholly omitted from the work, if the proprietor of it sees fit so to do.”) (quoting 18 C.J.S. *Copyright & Literary Property* § 12, at 147 (1939)); *De Bekker v. Stokes Co.*, 153 N.Y.S. 1066, 1068 (N.Y. App. Div. 1915) (finding contract that chose title for work, but did not stipulate that author must be named, implied waiver of right to be named); Laurie Stearns, *Copy Wrong: Plagiarism, Process, Property, and the Law*, 80 CAL. L. REV. 513, 529 (1992) (“Where copying is authorized, the author has no common law right to attribution; such a right is nonexistent unless created by contract.”). But see *Clemens v. Press Publ’g Co.*, 122 N.Y.S. 206, 208 (N.Y. App. Div. 1910) (Seabury, J., concurring) (“The purchaser cannot garble it, or put it out under another name than the author’s; nor can he omit altogether the name of the author, unless his contract with the latter permits him so to do.”).

¹⁷⁵ Strauss, *The Moral Right of the Author*, *supra* note 22, at 992 (adding “but he may waive this right. For some types of publications, such as an author’s contribution to a collective work, this right is presumed to be waived unless specifically reserved.”).

¹⁷⁶ Nimmer, *supra* note 1, at 520.

¹⁷⁷ See *id.* at 520–21. This seems right, although it merits pointing out that Cyril Rigamonti has made a persuasive case that continental European systems may not achieve much more. Thus, while Ilhyung Lee is concerned that “the moral rights rule would effectively cancel a negotiable term from the parties’ deliberations,” Lee, *supra* note 5, at 813, Cyril Rigamonti concludes that “[i]n the context of copyright contracts, the Continental emphasis on moral rights tends to favor a moderate regulatory system over pure freedom of contract,” Rigamonti, *supra* note 44, at 376, and that the inalienability of moral rights “although absolutely central to Continental moral rights consciousness, boils down to little more than a handful of rather narrow limitations on the content of copyright contracts.” *Id.* at 380.

¹⁷⁸ 648 F.2d 602 (9th Cir. 1981).

either because it never was hers,¹⁷⁹ or because it has been so distorted it can no longer properly be called hers.¹⁸⁰

This means that the *Dastar* result hurts us where the American patchwork was already weak: a reverse-passing-off claim available under Lanham Act § 43(a) can no longer be grounded on nonattribution of the creative source of the good. In explaining the U.S. approximation of moral rights, Paul Goldstein wrote in 2001 that "[c]ourts have . . . held that distributing a work without attributing authorship violates the [Lanham] Act because it implies that the publisher rather than the actual author created the work."¹⁸¹ Clearly that is no longer true. Fearful of the Article 6bis implications, Marybeth Peters, the Register of Copyright, has called the decision "ill-considered."¹⁸² Perhaps the one person who gets the last laugh is Judge Murray Gurfein. Judge Gurfein filed a concurrence in *Gilliam* in which he noted that the Lanham Act is "not a substitute for *droit moral* which authors in Europe enjoy"¹⁸³ because the "Lanham Act does not deal with artistic integrity. It only goes to misdescription of origin and the like."¹⁸⁴

¹⁷⁹ See, e.g., *D'Altamonte v. New York Herald*, 102 N.E. 1101 (N.Y. 1913); *Ellis v. Hurst*, 66 Misc. 235 (N.Y. Sup. Ct. 1910).

¹⁸⁰ In addition to *Gilliam*, see, for example, *Granz v. Harris*, 198 F.2d 585, 589 (2d Cir. 1952) (Frank, J., concurring) ("Whether the work is copyrighted or not, the established rule is that, even if the contract with the artist expressly authorizes reasonable modifications (e.g., where a novel or stage play is sold for adaptation as a movie), it is an actionable wrong to hold out the artist as author of a version which substantially departs from the original."); *Neyland v. Home Pattern Co.*, 65 F.2d 363 (2d Cir. 1933).

¹⁸¹ GOLDSTEIN, *INTERNATIONAL COPYRIGHT*, *supra* note 4, at 286–87.

¹⁸² *The Family Movie Act: Hearing on H.R. 4586 Before the S. Comm. on Courts, the Internet and Intellectual Property of the H. Comm. on the Judiciary*, 108th Cong. 2d Sess. 5 (2004) (Statement of Marybeth Peters, Register of Copyrights), available at <http://www.copyright.gov/docs/regstat061704.html> (last visited Nov. 28, 2007). After calling *Dastar* an "ill-considered decision by our Supreme Court," Peters notes:

While the *Dastar* decision is not the subject of this hearing, I believe that the subcommittee should examine whether section 43(a) of the Lanham Act should be amended to reflect what was the longstanding understanding prior to *Dastar*—that section 43(a) is an important means for protecting the moral rights of attribution and integrity. Although I will comment no further on *Dastar* at this hearing, and although I will not comment on the portion of the proposed legislation that would provide an exemption from liability under the Lanham Act, it is worth noting that in the wake of *Dastar* (and, for that matter, even under pre-*Dastar* law), there may be little reason to be concerned that the conduct proposed to be covered by the proposed Family Movie Act would violate the Lanham Act in any event.

Id. at n.2. See also Austin, *supra* note 113, at 119 ("[T]he Court's holding, interpreted broadly, swept away most of the protections against misattribution of the creative content of works of authorship that the Lanham Act was once assumed to provide.").

¹⁸³ *Gilliam v. ABC, Inc.*, 538 F.2d 14, 27 (2d Cir. 1976) (Gurfein, J., concurring).

¹⁸⁴ *Id.*

B. It Gets Worse When It Need Not Have

Driven by an admirable, albeit very broad, policy goal for copyright, the Court crafted a narrow, albeit very strange, statutory interpretation of trademark law. If subsequent lower courts had stuck to one or the other issues—the policy goal or statutory interpretation—the resulting gap in our right of attribution might not be so bad. But blinded by the policy goal, lower courts have vastly expanded statutory interpretation in two ways. First, instead of understanding *Dastar* to be strictly about origin in § 43(a), they have interpreted it to be about § 43(a) in its entirety—a result that we will see does not make sense. It is also a result that ignores a cardinal rule of statutory interpretation that each word of a statute is assumed to have separate meaning.¹⁸⁵ Second, courts have interpreted *Dastar* to apply to state unfair competition laws. These were state laws that it was widely agreed were not preempted by federal copyright law before *Dastar*. The result of this second expansion of *Dastar* is that these state laws—also cited by Congress in 1988 as part of the United States’ compliance with Berne—are now more limited in their capacity to contribute to the American patchwork of Article 6bis protection.

1. The Broadening of Dastar to Wipe Out § 43(a)

A broad reading of *Dastar* is that § 43(a) *in toto* is unconcerned with “the author of any idea, concept, or communication embodied in . . . goods” because of the Lanham Act’s “common law . . . foundations (which were not designed to protect originality or creativity).”¹⁸⁶ The adherent to a broad reading of *Dastar* is not troubled by the different concepts packed into both ends of the § 43(a) equation (not to mention three states of mind in the middle—confusion, mistake, and deception).¹⁸⁷ Unfortunately, this is how many lower courts have now interpreted *Dastar*. One announced that “the Supreme Court left the protection to the creative talent behind communicative products to the copyright laws.”¹⁸⁸ Another stated

¹⁸⁵ See *Discover Bank v. Vaden*, 396 F.3d 366, 369 (4th Cir. 2005) (“[C]ourts must ‘give effect to every provision and word in a statute and avoid any interpretation that may render statutory terms meaningless or superfluous.’” (quoting *United States v. Ryan-Webster*, 353 F.3d 353, 366 (4th Cir. 2003))).

¹⁸⁶ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003).

¹⁸⁷ See David A. Gerber, *Copyright Reigns—Supreme: Notes on Dastar Corp. v. Twentieth Century Fox Film Corp.*, 93 TRADEMARK REP. 1029, 1029–34 (2003). See also Nimmer, *supra* note 8, at 43 (characterizing the “broad reading” as being “that the opinion negates any regulation by the Lanham Act that is geared at works of authorship, rather than being limited to the domain under review of reverse passing off”). But Nimmer disagrees with this because “nothing in the opinion overtly inclines towards that earthquake.” *Id.*, at 43.

¹⁸⁸ *Carroll v. Kahn*, No. 03-CV-0656, 2003 WL 22327299, at *6–7 (N.D.N.Y. Oct. 9, 2003). Other post-*Dastar* decisions often do not provide enough information in the opinions to determine whether the plaintiff is complaining of a false description or representation of fact. In one case, the alleged offending attribution does not sound like a

that "[t]he Court concluded that claims of false authorship and reverse passing off, when raised to protect an author's interest in the intellectual content of communicative products, were not actionable under § 43(a)."¹⁸⁹ It appears that most, if not all, federal courts interpret *Dastar* as applying to all of § 43(a).¹⁹⁰

Interpreted this way, *Dastar* likely means that *Gilliam v. ABC* is no longer good law.¹⁹¹ But, the *Dastar* opinion need not disturb *Gilliam* because *Dastar* is about nonattribution, while *Gilliam* was based on misattribution. At this point, it is important to keep in mind all of the different concepts packed into § 43(a). Whatever the merits of the Justice Scalia's exegesis on the meaning of "origin," that analysis does not expressly apply to § 43(a)'s positive, intentional "false or misleading description of fact, or false or misleading representation of fact,"¹⁹² which is likely to produce confusion in the mind of the consumer as to approval, sponsorship, affiliation, or the like.¹⁹³ It would not make any sense to apply Scalia's tight, physical manufacturing definition of "origin" to these much broader § 43(a) terms that sit on both sides of the § 43(a) equation. To apply *Dastar* properly, then, it is imperative to pay attention to some distinctions that have been blurred in the past: assertion versus omission, passing off versus reverse passing

false description of fact. See *Zyla v. Wadsworth*, 360 F.3d 243, 246–51 (1st Cir. 2004) (involving a plaintiff who had removed herself as a coauthor, but objected to the acknowledgements as inadequate). In another case, *Bretford Manufacturing, Inc. v. Smith System Manufacturing Co.*, 286 F. Supp. 2d 969, 971–73 (N.D. Ill. 2003), the court inappropriately applied *Dastar* to the defendant's use of a physical component from the plaintiff. While there are legitimate questions about origin attributions for physical subcomponents, they definitely are not addressed by *Dastar*.

¹⁸⁹ *General Universal Sys., Inc. v. Lee*, 379 F.3d 131, 149 (5th Cir. 2004).

¹⁹⁰ See *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1116–17 (W.D. Wash. 2004) (interpreting *Dastar* to preempt reverse passing off claim for copyrighted images); *Aagard v. Palomar Builders, Inc.*, 344 F. Supp. 2d 1211, 1218 (E.D. Cal. 2004) (interpreting *Dastar* to preempt reverse palming off claim for copyrighted architectural plans); *Smith v. New Line Cinema*, No. 03 Civ. 5274 (DC), 2004 WL 2049232, at *3–4 (S.D.N.Y. Sept. 13, 2004) (interpreting *Dastar* to preempt reverse passing off claim for copyrighted screenplay); *Bob Creeden & Assocs. v. Infosoft, Inc.*, 326 F. Supp. 2d 876, 878–80 (N.D. Ill. 2004) (interpreting *Dastar* to preempt reverse passing off claim for copyrighted software). In addition to these, there are cases applying *Dastar* beyond the realm of copyright. See, e.g., *Keane v. Fox Televisions Stations, Inc.*, 297 F. Supp. 2d 921, 934–37 (S.D. Tex. 2004) (interpreting *Dastar* to bar § 43(a) claim for reverse passing off of uncopyrightable idea); *Tao of Sys. Integration, Inc. v. Analytical Servs. & Materials, Inc.*, 299 F. Supp. 2d 565, 571–72 (E.D. Va. 2004) (interpreting *Dastar* to preempt reverse passing off claim for trade secrets). These two cases are discussed extensively by Tom Bell. See Bell, *supra* note 157, at 217–19; see also Roberta Rosenthal Kwall, *Inspiration and Innovation: The Intrinsic Dimension of the Artistic Soul*, 81 NOTRE DAME L. REV. 1945, 1994–95 (2006) ("These courts have applied *Dastar* absent explicit analysis of the implications of the Court's opinion for non-public domain works.").

¹⁹¹ See Greg Lastowka, *Digital Attribution: Copyright and the Right to Credit*, 87 B.U. L. REV. 41, 74 n.182 (2007).

¹⁹² 15 U.S.C. § 1125(a)(1) (2006).

¹⁹³ *Id.*

off, and origin versus affiliation, connection, association, approval, or sponsorship.¹⁹⁴

The 1980 case of *Follett v. New American Library, Inc.*¹⁹⁵ is exemplary. In *Follett*, the defendant intended to publish a nonfiction book that had a complicated authorship history. The original book had been written pseudonymously by three French journalists.¹⁹⁶ Follett was brought on board to edit and, then, substantially revise this original work; his role morphed from editor to someone who “in fact rewrote the work.”¹⁹⁷ Indeed, when the book was first published in England, Follett “sought and obtained some authorship credit” with the byline “Rene Louis Maurice with Ken Follett.”¹⁹⁸ Years later, after Follett had become a famous fiction author, the book’s copyright holder announced plans to publish it in America, dramatically emphasizing Follett and deemphasizing the original, primary authors.¹⁹⁹ Since there was no question that Follett was part of the origin of the book in the pre-*Dastar* sense, the court properly understood the § 43(a) issue as whether the book jacket had a description or representation that was false.²⁰⁰ The court concluded that “the representation that Follett [was] the principal author of the book is literally false.”²⁰¹ It did not expressly decide what kind of confusion had been engendered other than origin, but arguably using Follett’s name so prominently would confuse his readership base and others as to affiliation, connection, association, sponsorship, or approval.

Follett and Monty Python made parallel claims: Follett did not want to be named as the principal creator of a work that was not his principal creation. The Monty Python troupe did not want to be named as the principal creator of a work that was no longer their creation. In each case, the labelling was a false representation of facts leading to likely confusion as to affiliation, connection, association, sponsorship, or approval. Such claims should survive *Dastar* as long as the misattribution can reasonably be characterized as a description or representation of fact. In other words, if I publish a defense of big government and lavish welfare programs and label it “written by Sean Hannity,” are we prepared to say that this is not an actionable “misrepresentation of fact” likely to confuse consumers as to affiliation, connection, sponsorship, or approval? How about a pornographic film that credits Steven Spielberg as the director? These are passing

¹⁹⁴ And, of course, § 43(a)(1)(A) and § 43(a)(1)(B) codified at 15 U.S.C. § 1125(a)(1)(A) and § 1125(a)(1)(B). See Nimmer, *supra* note 8 at 41–42.

¹⁹⁵ 497 F. Supp 304 (S.D.N.Y. 1980).

¹⁹⁶ *Id.* at 306.

¹⁹⁷ *Id.* at 309.

¹⁹⁸ *Id.* Rene Louis Maurice was a combined pseudonym for the three French journalists. *Id.* at 305.

¹⁹⁹ The new edition would have had a jacket that said “by the author of TRIPLE and EYE OF THE NEEDLE: KEN FOLLETT with Rene Louis Maurice,” *id.* at 308, with the French name “printed in much smaller type . . . only 6 mm. in height,” *id.* at 312, and not appearing on the spine of the book at all, *id.* at 308.

²⁰⁰ *Id.* at 312.

²⁰¹ *Id.*

off cases, plain and simple. If we take *Dastar* broadly and assume § 43(a) does not concern the origin of ideas, can I market my new high-energy drink as "formulated by the people at Coca-Cola" or my new line of clothing as "designed by Karl Lagerfeld" without § 43(a) ramifications? Such a broad reading of *Dastar* means that there is no Lanham Act cause of action against wildly false, indeed fraudulent, assertions of facts whenever they bear on "the author of any idea, concept, or communication embodied in . . . goods."²⁰² It seems unlikely this is what the Court intended.²⁰³

2. *The Broadening of Dastar to Wipe Out State Laws*

Prior to *Dastar* there had been general agreement that copyright law, through 17 U.S.C. § 301 (2006), did not preempt state unfair competition claims that sounded in failure of attribution.²⁰⁴ Now, as Professors Michael Landau and Tom Bell have separately explored,²⁰⁵ all this is in doubt. As Tom Bell has observed, after *Dastar*, for a state law to be vulnerable to preemption "[i]t suffices . . . that a state law risks limiting public use of fixed works of authorship for a period exceeding the limits imposed by federal copyright law."²⁰⁶

In *Dastar* itself, the district court on remand concluded with absolutely no analysis that the Supreme Court's holding applied to claims brought under California's unfair competition law.²⁰⁷ At least two other district courts have also concluded that the *Dastar* reasoning controls claims under state unfair competition laws, either on the grounds (a) that the state unfair competition claims have always been interpreted as "congruent" with Lanham Act claims,²⁰⁸ or (b) that the

²⁰² *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003).

²⁰³ Other commentators seem to believe that this sort of false representation of material fact claim has survived *Dastar*. See, e.g., 5 MCCARTHY ON TRADEMARKS, *supra* note 141, § 27:77.1, at 27-175 to 27-185 (4th ed. 2007); Ginsburg, *Right to Claim Authorship*, *supra* note 92, at 275-77 (proposing that misrepresentations material to the consumer would survive *Dastar*).

²⁰⁴ See, e.g., *Summit Mach. Tool Mfg. Corp. v. Victor CNC Sys., Inc.*, 7 F.3d 1434, 1441 (9th Cir. 1993) ("State unfair competition laws which seek to prevent reverse palming off are not preempted by federal law."); GOLDSTEIN, *supra* note 5, §§ 15.2.1.2, 15:15; NIMMER ON COPYRIGHT, *supra* note 27, § 1.01[B][1], at 1-13 n.62. For a discussion of some contrary cases, see Bell, *supra* note 157, at 240-43.

²⁰⁵ See Bell, *supra* note 157; Michael Landau, *Dastar v. Twentieth Century Fox: The Need for Stronger Protection of Attribution Rights in the United States*, 61 N.Y.U. ANN. SURV. AM. L. 273, 304-06 (2005).

²⁰⁶ Bell, *supra* note 157, at 232.

²⁰⁷ The sum total of the analysis was "[t]he Supreme Court's finding that Defendants' actions were not misleading under the Lanham Act controls the resolution of their California unfair competition claim." *Twentieth Century Fox Film Corp. v. Dastar Corp.*, No. CV98-07189FMC(EX), 2003 WL 22669587, at *5 (C.D. Cal. Oct. 14, 2003).

²⁰⁸ *Bob Creeden & Assocs. v. Infosoft, Inc.*, 326 F. Supp. 2d 876, 878-80 (N.D. Ill. 2004) (citing congruence between Illinois unfair competition law and Lanham Act to conclude that Lanham Act reverse passing off claim that fails because of *Dastar* also states

copyright policy considerations that limited the definition of “origin” in the Lanham Act must similarly curb state unfair competitions laws.²⁰⁹

Both paths of reasoning are flawed. Lanham Act and state law congruence has certainly been good for an efficient legal system, but when the Supreme Court changes the understood meaning of a term in a federal statute, we should not assume that parallel state laws remain congruent in their coverage. The parallel state laws were drafted by different people at different times, and perhaps with a *Gilliam*-esque understanding of the Lanham Act’s coverage. In that kind of situation, there is not much to the congruence argument except as a stand-in for the copyright policy/preemption argument. And the copyright policy considerations affect only works that have fallen out of copyright (and materials that are uncopyrightable), not works still protected by copyright. So a healthy and desirable embrace of the *Dastar* policy concerns does not mean embracing the odd *Dastar* analysis of origin and certainly does not require applying it in blanket fashion to different statutory language in state laws.

C. *There Was a Simpler Way to Protect the Public Domain*

The Court had a number of options available in *Dastar* that could have avoided the uncertainties embedded in the opinion. For example, the Court could have narrowly ruled that, whatever the meaning of § 43(a) origin, it could not mean Fox. It appears that Time, Inc. was the first author of *Crusade in Europe* under the work-for-hire doctrine. Fox was just a subsequent assignee. The last owner of an unowned thing is not its origin. We don’t look at an abandoned farmhouse and say that the last family to own it was the “origin” of the house unless they built it.²¹⁰ But overturning the Ninth Circuit’s holding on these grounds would have left intact the spectre of § 43(a) nonattribution claims by true originators/creators when the work is in the public domain. Was there any way to remove the spectre of nonattribution Lanham Act claims on public-domain works while leaving untouched such claims on works still under copyright?

The answer is yes. In this sense, the Court is to be faulted for having failed to interpret an act of Congress consistent with the United States’ international

“no claim under Illinois’ statutory unfair competition laws”); *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1186 (C.D. Cal. 2003) (plaintiff’s state unfair competition claims fail because “[t]he Ninth Circuit has consistently held that state law unfair competition claims are ‘congruent’ with Lanham Act claims”).

²⁰⁹ *Aagard v. Palomar Builders, Inc.*, 344 F. Supp. 2d 1211, 1218 (E.D. Cal. 2004). Although this court also mentions the Lanham Act and state unfair competition law being “substantially congruent,” it seems more explicitly to rely on preemption by copyright policy considerations.

²¹⁰ For more on the use of “originating” and “creating,” see Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 *CARDOZO ARTS & ENT. L.J.* 81, 99–104 (1998).

obligations.²¹¹ The Court could have established a simple interpretation of the otherwise undefined statutory term "origin": when the materials come from the public domain there is no legally-cognizable obligation to attribute origin to any person, natural or juridical. This was the obvious way to go—as noted by many commentators.²¹² What has been less noted is the overarching principle that justifies this bifurcation: there should be no obligation to attribute origin when the material comes from the public domain or any other recognized zones of nonproperty. This principal should apply well beyond intellectual property. If the Pepsi Cola Bottling Company wants to start bottling air, there is no need to attribute the origin of the air to anyone. Similarly, if they decided to build an art collage out of materials abandoned as trash on the sidewalks of New York, there would also be no need to attribute the origins of the materials to anyone.²¹³

The virtue of this approach is that it provides a fairly bright line concerning nonattribution. The bright line may be most visible with materials that have fallen into the public domain, but the rule can apply across the board to clearly unowned tangible and intangible materials. Leonard Bernstein does not need to credit Shakespeare with the idea for *West Side Story* because the idea is, and always was, clearly unowned. The Weather Channel does not have to credit the National Oceanic and Atmospheric Administration (NOAA) as the origin of its weather data because the data is clearly unowned, both under *Feist*²¹⁴ and 17 U.S.C. § 105. A manufacturer of bottled hydrogen, nitrogen, or oxygen does not have to credit the gases with any particular origin because the atmosphere is unowned. The *Dastar* opinion can be discussed without mentioning Justice Scalia because judicial opinions are unowned by operation of 17 U.S.C. § 105 and *Wheaton v. Peters*.²¹⁵ None of the desalination plants in the United States extracting fresh water from seawater²¹⁶ need to attribute any origin to their final product because seawater is

²¹¹ *Murray v. Schooner Charming Betsy*, 6 U.S. (2 Cranch) 64, 118 (1804); *see also* Austin, *supra* note 113, at 113.

²¹² *See e.g.*, Austin, *supra* note 113, at 148 ("It would be more consistent with the international obligations of the United States to view the *Dastar* holding as applying only to misattribution claims for works whose copyrights have expired.").

²¹³ This is true assuming that the abandoned materials are not covered by intangible property rights, such as a copyright on an abandoned painting leading to a derivative-work claim when the painting is integrated into the collage.

²¹⁴ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361–62 (1991).

²¹⁵ 33 U.S. (8 Pet.) 591, 668 (1834).

²¹⁶ There are approximately 1200 desalination plants in the United States, *see* Eliza Barclay, *Thirsty States Turning to Desalination*, UPI Wire Service, April 23, 2004, available at http://www.upi.com/NewsTrack/Science/2004/04/23/thirsty_states_turning_to_desalination/4161/ (last visited Nov. 28, 2007), but almost all of them convert brackish groundwater to drinkable freshwater. However, seawater conversion is on the way: "[a] major reverse-osmosis desalting plant is already in operation in Tampa, Fla., along with smaller ones in California" and state funding approved in Texas for pilot projects in Brownsville, Corpus Christi, and Freeport. *See* Phil Magers, *Analysis: States Seek New Water Sources*, UPI Wire Service, Aug. 5, 2004, available at <http://www.upi.com/>

unowned under international law. If you shoot a wild boar as it is crossing the street from my property into a park and you serve the medallions of wild pig in your restaurant, you don't have to attribute the origin of the meat to me or anyone else.²¹⁷ The same is true for wild ducks and fish caught at sea.²¹⁸ In short, if it comes from the commons—if it is *ferae naturae* or *terra nullius*—you should have no obligation of attribution.

Of course, there are at least two differences between a creative work now in the public domain and ocean water, air, and wild boar meat. First, the audiovisual work previously had an owner, while the materials did not. Second, the creation or origination of the audiovisual work can be pinned to particular, identifiable human(s), while the materials cannot. But neither of these differences is a powerful argument against the principle that if it comes from the commons, there is no obligation of attribution. We have already explored how ownership is not origin; as for the second difference, we have to make a policy decision about how far reputational interests should extend.

There is no question that Pepsi can take unowned materials, process and package them, and label them Pepsi Air, Pepsi Seawater, Pepsi Literature, and Pepsi Art. Similarly, Dastar could have labeled the television series “Dastar Corp. presents” even if they had not manufactured the tapes, because the “Dastar” label would be accurate as to sponsorship or approval. But what if Pepsi releases a new edition of *Taming of the Shrew* labeled “by Uncle Pepsi” or, more playfully, “by Neville Isdell,” the Chairman of the Board of the Coca-Cola Company?²¹⁹

Here, we can see how narrow this commons principle is. The elimination of attribution duties for materials in the commons does not create misattribution rights for the same materials. To return to Table 2, we have eliminated any line going from the omission of designation of origin to likely confusion over origin of goods, but we have not changed the obligations to avoid false/misleading descriptions/representations of fact which lead to likely confusion over origin of goods or sponsorship of the goods or approval of the goods or affiliation, connection, or association of a named person with the good or its producer. If *Deep Throat*²²⁰ falls into the public domain, you still cannot package it with a label that says “Walt Disney presents” because that is a false description of fact likely to

International_Intelligence/Analysis/2004/08/05/analysis_states_seek_new_water_sources/8689/ (last visited Nov. 28, 2007).

²¹⁷ As all lawyers remember, the boar, like the fox in *Pierson v. Post*, is an animal *ferae naturae*. 3 Cai. 175, 177–78 (N.Y. Sup. Ct. 1805).

²¹⁸ 3 BENEDICT ON ADMIRALTY § 158, at 11–15 (1992) (stating that “[t]he recovery of marine life such as ambergris, whales, or other large fish entitles the finder to keep the property or the proceeds from the sales of that property”).

²¹⁹ See <http://www.thecoca-colacompany.com/ourcompany/executive.html> (last visited Nov. 28, 2007).

²²⁰ DEEP THROAT (P.D. Inc. & Vanguard Films Production 1972).

subvert a whole range of § 43(a) concerns besides the physical origin of the goods.²²¹

V. FIXING THE *DASTAR* GAP

That path—a clean cleaving of origin obligations once things become unowned—is the path that was not chosen. *Dastar* does knock out § 43(a) as a device to prevent nonattribution of owned works, either through a broad reading that § 43(a) *in toto* is “not designed to protect originality or creativity”²²² or a narrow reading that § 43(a) origin is never concerned with the source of creativity and originality embodied in a product or service. Yet if we work through all the possibilities, the practical hole created by *Dastar* may be operatively modest. *Dastar* creates a gap in protection for those works and circumstances where there is a failure of appropriate attribution and no cause of action under VARA, under state moral rights laws,²²³ under 17 U.S.C. § 1202 for failure to include copyright management information, or under state unfair competition laws in states where the courts hold that *Dastar* should not control,²²⁴ and where contract law does not

²²¹ Similarly, the 1948 *Shostakovich v. Twentieth-Century Fox* case concerned works in the public domain, but the issue was *attribution* to the composer, not nonattribution. 80 N.Y.S.2d 575 (N.Y. App. Div. 1948). Again, the elimination of attribution duties for materials in the commons does not create misattribution rights for the materials in the commons. (Although in the *Shostakovich* case, the musical compositions had been written by the composer and the misattribution argument was more attenuated. *Id.*)

²²² *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 36 (2003).

²²³ These state laws vary enough from 17 U.S.C. § 106A that a few additional works will gain a right of attribution under them. VARA only preempts state law “with respect to works of visual art to which the rights conferred by section 106A apply.” 17 U.S.C. § 301(f) (2006). If state moral rights laws apply to any works not covered by VARA, those state laws appear to survive preemption. At least eight states now have such moral rights provisions on their statute books. *See, e.g.*, CAL. CIV. CODE § 987 (West 2007); LA. REV. STAT. ANN. §§ 51:2151–56 (West Supp. 2007); ME. REV. STAT. ANN. tit. 27, § 303 (2007); MASS. GEN. LAWS ANN. ch. 231, § 85S (LexisNexis Supp. 2007); N.J. STAT. ANN. § 2A:24A-1 to -8 (West 2000); N.Y. ARTS & CULT. AFF. LAW § 14.03 (McKinney Supp. 2007); 73 PA. CONS. STAT. ANN. §§ 2101–10 (Purdon Supp. 2007); R.I. GEN. LAWS § 5-62-2 to -6 (LexisNexis 2005). But 17 U.S.C. § 301(f) may not resolve the question of federal copyright law preempting such state law. For example, copyright’s first sale doctrine could arguably be frustrated by a state law against mutilation of a work, triggering nonstatutory preemption. For a description of this pre-VARA issue see Sophia Davis, *State Moral Rights Law and Federal Copyright System*, 4 CARDOZO ARTS & ENT. L.J. 233, 251–252 (1985).

²²⁴ After writing this passage, I noted that David Nimmer has reached the same conclusion that we should have a better grasp of how much of a real problem we have: “But before mounting a corrective campaign in Congress, what is required is an empirical investigation into whether society currently confronts scores of compositions being vended by their copyright owners in derogation of the true author’s name.” Nimmer, *supra* note 8, at 50. And this goes not just to the scope of the problem, but whether contract law, in the

establish a framework to protect attribution. Whether or not we include contract law in this list may vary from industry to industry.²²⁵

But to eliminate the *Dastar* gap, the Court's reasoning itself must be overturned. Having already opined on the meaning of a very dense statute, it seems unlikely that the Court will revisit the issue. As Justice Ginsburg would say, the ball is now in Congress's court.²²⁶ A simple way to seal the *Dastar* gap would be amendment of the Lanham Act. One might first think to amend the language of § 43(a), but once we reopen a statutory provision as messy as § 43(a), we will likely be besieged by all kinds of questions, phantoms, and rent-seekers. Alternatively, we could take a more surgical approach and add the following partial definition to § 45, the Lanham Act provision which provides the Act's definitions:

The word "origin" as used in 15 U.S.C. § 1125(a) shall, as applied to and only to such works as are protected by copyright, be interpreted to include the person(s) defined as the author(s) of the copyrighted work under Title 17.

This language does not return us to the pre-*Dastar* world because it limits the reexpansion of "origin" to works protected by copyright.

More elegantly we could add the same substantive provision to the Copyright Act, either as an addition to § 106A or a new § 106B. This would further gather our moral-rights provisions in one place. Adding some appropriate bangs and whistles, the whole provision might be:

present author/capital environment, is adequate to protect an author's right of attribution where it is important to the author.

²²⁵ Where the industry has a collective bargaining agreement that secures attribution rights, as in the audiovisual industry, contract law should be considered. For example, both the Screen Actors Guild and the Writers Guild of America require companies doing business with their respective members to provide agreed-upon screen credits. *See, e.g.*, 2004 WRITERS GUILD OF AMERICA-ALLIANCE OF MOTION PICTURE AND TELEVISION PRODUCERS THEATRICAL AND TELEVISION BASIC AGREEMENT art. 8 (Nov. 1, 2004) (entitled "Screen Credits"), available at <http://web1.wgaeast.org/index.php/articles/article/wgreview/xaraya/var/uploads/File/contracts/MBA%202004.pdf>; ALLIANCE OF MOTION PICTURE AND TELEVISION PRODUCERS, PRODUCER-SCREEN ACTORS GUILD CODIFIED BASIC AGREEMENT OF 1995 § 25 (1995) (same). *See also* Writers Guild of America, East, *Minimum Basic Agreement (MBA)* (Jan. 1, 2007) ("The responsibility for determining writing credits was won many years ago [from film producers] by the Guild."), available at <http://www.wgaeast.org/index.php/articles/article/336?startnum=&sort=&letter=&wgc=89#wga336> (last visited Nov. 28, 2007) (an article describing the MBA).

²²⁶ *An Open Discussion with Justice Ruth Bader Ginsburg*, 36 CONN. L. REV. 1033, 1043 (2004) ("[W]hen . . . the Court has made its best guess at what some dense statute means, we are likely to adhere to that reading. . . . We've said what we thought the statute meant. After that, the ball is in Congress' court; Congress can change the law . . .").

§106B Rights of Other Authors to Attribution

- (a) Definition of "Origin" for Works Protected by Copyright. As applied to and only to such works protected by copyright, "origin" as used in 15 U.S.C. § 1125(a) shall be interpreted to include the person(s) defined as the author(s) under this Title.
- (b) Scope and Exercise of Rights. The rights conferred by subsection (a) shall not apply in relation to:
 - (1) acts or omissions against which there is a cause of action under § 106A(a)(1) of this Title;
 - (2) acts or omissions in relation to a work whose author(s) cannot be determined by a person after having performed and documented a reasonably diligent search in good faith to locate the author(s);
 - (3) acts or omissions in relation to transmissions by a broadcast station, or a cable system, or someone who provides programming to such station or system, where providing information as to origin as specified in subsection (a) is not technically feasible or would create an undue financial hardship and the act or omission was not done with intent to conceal the origin of the copyrighted work;
 - (4) acts or omissions where providing attribution to the author of the copyrighted work would be unreasonable under the circumstances.

I am not sure that these are all the needed bangs and whistles—or even the most needed ones. Clause (b)(2) addresses the orphan-works issues, using a standard drawn from H.R. 5439, as introduced in May 2006 in the 109th Congress.²²⁷ Obviously, the standard should be the same as that in any orphan-works law that the United States might adopt. Clause (b)(3) addresses broadcast-media practices and tracks the language used for this purpose in relation to copyright-management information under § 1202(e).

Clause (b)(4) may appear to eviscerate the entire provision, but it is common for national laws to so limit rights of attribution—a point that may not be recognized by commentators who disfavor attribution rights.²²⁸ For example, Canada's statute expressly provides that an author has "the right, where reasonable in the circumstances, to be associated with the work as its author."²²⁹ The right of

²²⁷ The Orphan Works Act of 2006, H.R. 5439, 109th Cong. § 514(b)(1)(A) (2006).

²²⁸ See, e.g., Jonathan Band & Matt Schruers, *Dastar, Attribution, and Plagiarism*, 33 AIPLA Q.J. 1, 2 (2005) (arguing that when it comes to the contexts in which attribution is called for "[t]he law is poorly suited to make the nuanced distinctions").

²²⁹ Copyright Amendment Act, *infra* note 253, at §14.1(1). But the right to remain anonymous does not appear to be subject to measures of reasonableness. See Ginsburg, *Right to Claim Authorship*, *supra* note 92, at 293.

attribution in Israel is statutorily limited to “the accepted manner and extent”,²³⁰ in Senegal, to “the extent and manner that conforms with good practices.”²³¹ Japanese law provides that an author’s name may be omitted when “there is no risk of damage to the author in his claim to authorship” and when the omission follows “fair practice”;²³² Korea has similar provisions.²³³ Danish law gives the author only the right to have her name “stated to the extent and in the manner required by proper usage.”²³⁴ In Brazil, a judge can dismiss *de minimis* attribution claims.²³⁵ Indeed, a reasonable circumstances test for attribution is built into the 1996 WPPT.²³⁶

As written, the proposal would restore the connection between violation of the right of attribution and Lanham Act remedies, the same remedies allowed prior to *Dastar*. From a pure moral-rights approach, injunctive relief is the right remedy, but persuasive arguments can be made that many minor failures of attribution do

²³⁰ Neil J. Wilkof, *Israel*, in 2 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, at ISR-28 (Paul Edward Geller ed., 2006).

²³¹ Article 3(A) (“Le nom de l’auteur doit être indiqué dans la mesure et de la manière conforme aux bons usages sur tout exemplaires . . .”) Law No. 73-52, Protection of Author’s Rights (Loi No. 73-52 Relative a la Protection du Droit d’Auteur) (Sen., 1973), in TEXTES RELATIFS AU DROIT D’AUTEUR ET AU BUREAU SENEGALAIS DU DROIT D’AUTEUR [Texts Concerning Copyright and the Senegal Copyright Bureau] 9 (date unknown).

²³² Copyright Law, Law No. 48 of 1970, art. 19(3), translated in Copyright Research and Information Center, Copyright Law of Japan, available at http://www.cric.or.jp/cric_e/clj/clj.html (“It shall be permissible to omit the name of the author where it is found that there is no risk of damage to the interests of the author in his claim to authorship in the light of the purpose and the manner of exploiting his work and in so far as such omission is compatible with fair practice.”) (last visited Nov. 28, 2007).

²³³ The right of attribution applies unless omission is “deemed unavoidable in light of the nature of the work as well as the purpose and manner of its exploitation.” Copyright Act, 1989, No. 3916, § 3, amended by 1995, No. 5015 (S. Korea), available at http://www.wipo.int/clea/docs_new/pdf/en/kr/kr001en.pdf.

²³⁴ Copyright Act, 2001, No. 618, § 3, amended by 2003, No. 164 (Den.), available at http://www.wipo.int/clea/docs_new/en/dk/dk001en.html (last visited Nov. 28, 2007); see also THOMAS RIIS, INTELLECTUAL PROPERTY LAW IN DENMARK, at 38 (2000) (“The duty to state the name of the author is dependent on what is considered as proper use. If it is impossible, unreasonably burdensome or unreasonably disturbing given the context in which the work is used to state the name of the author, it is in compliance with proper use not to do so.”).

²³⁵ See T.J.S.P.-3, Ap. No. 6.956-1, Relator: Des. Evaristo dos Santos, 9.12.1980, 555 R.T. 1981, 103 (Brazil) (failure to give an architect of public monuments attribution on postcards of the public monuments was held nonactionable under Brazil’s moral rights statute); see also Manoel J. Periera dos Santos & Otto B. Licks, *Brazil*, in 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, at BRA-49 (Paul Edward Geller ed., 2006).

²³⁶ Article 5(1) of the WPPT recognizes that musical performers have a “right to claim to be identified as the performer of his performances, except where omission is dictated by the manner of the use of the performance.” WPPT, *supra* note 86, art. 5, 36 I.L.M. at 82.

not warrant full-tilt injunctive relief. As much as moral rights are conceptually distinct from economic rights, these moral rights are quite often monetized: wronged parties seem to be willing to be made whole with financial payments. In an ideal implementation of the right of attribution, we should somehow take this into account. This proposal also does not address the question of whether, when, and how an author should be able to waive this sort of claim. The Lanham § 43(a) claim exists regardless of whether the defendant successfully raised a fair use defense in relationship to the related authorized reproduction, distribution, or public performance. Jane Ginsburg believes this is an appropriate balance,²³⁷ although I can imagine situations in which the fair use defense should preclude any claim against nonattribution, for instance when small amounts of quotation in a scholarly work or a parody by its very nature already point the viewer to the original. At a minimum, I think the legislative history for this amendment should indicate that where the defendant has a successful fair use defense to the underlying § 106 violation, it is likely to be unreasonable to expect authorial origin to be stated.

Finally, this proposal is more politically tenable for the same reason that moral-rights purists will dislike it.²³⁸ By redefining "origin" to include "the person(s) defined as the author(s) of the copyrighted work under Title 17," we have integrated the work-for-hire doctrine into the definition. If Disney holds the copyright in an animation as a work for hire, then Disney, not the individual Disney animators, has the right of attribution. There may be circumstances where this deprives someone with genuine authorial interests of their attribution right, but as I have argued elsewhere, in many work-for-hire situations the personality interests involved in a creative work may genuinely be split between the employed and the employer—or even concentrated with the employer.²³⁹

VI. POSTSCRIPT—PATCHWORK APPROXIMATION OR TREATY COMPLIANCE?

In the best of times, the patchwork had at least as many doubters as believers among American legal commentators.²⁴⁰ How, they asked, can this patchwork be

²³⁷ See Ginsburg, *Right to Claim Authorship*, *supra* note 92, at 303.

²³⁸ See, e.g., *id.* at 280.

²³⁹ See Hughes, *supra* note 210, at 154–58.

²⁴⁰ The skeptics have ranged from those sure that the United States does not provide genuine Article 6*bis* moral rights to those who are very doubtful. See, e.g., Phyllis Amarnick, *American Recognition of the Moral Right: Issues and Options*, 29 COPYRIGHT L. SYMP. (ASCAP) 31, 60–81 (1983) (discussing the right of integrity); Sidney A. Diamond, *Legal Protection For The "Moral Rights" of Authors and Other Creators*, 68 TRADEMARK REP. 244, 280–81 (1978); A. Dietz, *The United States and Moral Rights: Idiosyncrasy or Approximation?*, 142 REVUE INTERNATIONALE DU DROIT D'AUTEUR 222 (1989); Robert E. Hathaway II, *American Law Analogues to the Paternity Element of the Doctrine of Moral Right: Is the Creative Artist in America Really Protected?*, 30 COPYRIGHT L. SYMP. (ASCAP) 121, 152–53 (1983); Flore Kringsman, *Section 43(a) of the*

pacta sunt servanda fulfillment of Article 6*bis* treaty obligations?²⁴¹ The skepticism has been honest, but also arguably myopic, tending to come from intellectual-property experts, not international-law experts. The intellectual-property scholars tend to read the Article 6*bis* obligations and then immediately compare our domestic law to the treaty language. What is missing is an interpretative step in which the words might turn out to mean something nonobvious. This is strange coming from copyright scholars—people who live in a world in which “writings” has accreted interpretation over time to now include photos, sculpture, films, sound recordings, and broadcasts of sports games.²⁴²

The content of an international legal norm—in this case, a particular treaty obligation—depends largely on its interpretation and implementation by nation-states. Memorializing a familiar principle of customary international law,²⁴³ Article 31 of Vienna Convention on the Law of Treaties provides that in interpreting a treaty, account shall be taken of “any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation.”²⁴⁴ As Michael Akehurst notes, “[t]he way in which states perform their obligations under a treaty can be evidence of what they originally intended when they drafted the treaty.”²⁴⁵ Or in the words of the Harvard Research Draft Convention of 1935:

Lanham Act as a Defender of Artists’ “Moral Rights,” 73 TRADEMARK REP. 251, 270–72 (1983); Tyler T. Ochoa, *Introduction: Rights of Attribution, Section 43(A) of the Lanham Act, and the Copyright Public Domain*, 24 WHITTIER L. REV. 911, 925–28 (2003); Deborah Ross, Comment, *The United States Joins the Berne Convention: New Obligations for Authors’ Moral Rights?*, 68 N.C. L. REV. 363–64 (1990). Although Martin Roeder put forward the “composite” theory, his overall conclusion was that American law was inadequate. Roeder, *supra* note 34, at 575–78.

²⁴¹ See Vienna Convention on the Law of Treaties art. 26, *opened for signature* May 23, 1969, 1155 U.N.T.S. 331; *see also* ARNOLD MCNAIR, THE LAW OF TREATIES 493–505 (1961).

²⁴² It is interesting how infrequently this problem is discussed among copyright scholars prepared to devote thousands of words to the meaning of “progress” or other words in the Copyright and Patent Clause. In his dissent in *Mazer v. Stein*, Justice Douglas raised just this issue, writing “Is a sculptor an ‘author’ and is his statue a ‘writing’ within the meaning of the Constitution? We have never decided the question.” 347 U.S. 201, 220 (1954) (Douglas, J., dissenting).

²⁴³ Although the United States has not ratified the Vienna Convention, for the U.S. Executive’s general recognition of the Convention as an authoritative guide to customary international law regarding treaties, *see* 1 RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 145 (1986). The Vienna Convention is widely viewed as restating customary principles for treaty interpretation. *See* IAN SINCLAIR, THE VIENNA CONVENTION ON THE LAW OF TREATIES 153 (2d ed. 1984).

²⁴⁴ Vienna Convention on the Law of Treaties, *supra* note 241, at art. 31(3)(b).

²⁴⁵ MICHAEL AKEHURST, A MODERN INTRODUCTION TO INTERNATIONAL LAW 166 (1984). Lord McNair similarly noted that “when there is doubt as to the meaning of a provision or expression contained in a treaty, the relevant conduct of the contracting parties after the conclusion of the treaty . . . has a high probative value as to the intention of the parties at the time of its conclusion.” MCNAIR, *supra* note 241, at 423.

In interpreting a treaty, the conduct or action of the parties thereto cannot be ignored. If all the parties to a treaty execute it, or permit its execution, in a particular manner, that fact may reasonably be taken into account as indicative of the real intention of the parties or the purpose which the instrument was designed to serve.²⁴⁶

Similarly, the International Court of Justice (ICJ) and its predecessor have repeatedly referred to contracting-state practice in understanding treaty obligations,²⁴⁷ and it does not matter whether we treat this as a principle of interpretation or a rule of evidence as to the parties' intent.²⁴⁸ The evidence here is that in the post-1928 period several Berne members executed their *6bis* obligations in a way similar to what the United States has done since 1988. All the evidence indicates that other Berne members permitted this approach.

Indeed, international tribunals have extended this principle of state practice further such that state practice may inform the content of a treaty obligation, even when the state practice seems at odds with the plain meaning of the treaty provision. In a 1965 decision, *Air Services Agreement of 27 March 1946*, between the United States and France, an arbitration panel concluded that "the practice of the Parties in the application of the Agreement" is "susceptible of either confirming or contradicting, and even possibly of correcting, the conclusions furnished by the interpretation based on an examination of the [treaty] text and the preparatory work."²⁴⁹ The ICJ has confirmed the principle that state practice can both interpret and literally modify a treaty obligation. In the 1962 *Temple of Preah Vihear (Merits)*, the Court wrote:

²⁴⁶ Harvard Research Draft Convention, *Research in Int'l Law Part III: Draft Convention on the Law of Treaties, with Comment*, 29 AM. J. INT'L. 966 (Supp. 1935).

²⁴⁷ Int'l Status of South-West Afr., Advisory Opinion, 1950 I.C.J. 128, 135-36 (July 11) ("Interpretations placed upon legal instruments by the parties to them . . . have considerable probative value . . ."); *Corfu Channel (U.K. v. Alb.)*, 1949 I.C.J. 4, 25 (Apr. 9) ("The subsequent attitude of the Parties shows that it was not their intention, by entering into the Special Agreement, to preclude the Court from fixing the amount of compensation."); *Jurisdiction of the Courts of Danzig*, Advisory Opinion, 1928 P.C.I.J. (ser. B) No. 15, at 18 (Mar. 3) ("The intention of the Parties, which is to be ascertained from the contents of the Agreement, *taking into consideration the manner in which the Agreement has been applied*, is decisive.") (emphasis added).

²⁴⁸ See Gerald Fitzmaurice, *The Law and Procedure of the International Court of Justice, 1951-54: General Principles and Sources of Law*, 30 BRIT. Y.B. OF INT'L L. 1, 54-58 (1953); Gerald Fitzmaurice, *The Law and Procedure of the International Court of Justice, 1951-54: Treaty Interpretation and Other Treaty Points*, 33 BRIT. Y.B. OF INT'L L. 203, 223-25 (1957).

²⁴⁹ *Air Transp. Servs. Agreement Arbitration (U.S. v. Fr.)*, 38 I.L.R. 182, 245-46 (Arb. Tr 1963); see also MICHAEL BYERS, *CUSTOM, POWER, AND THE POWER OF RULES* 171-74 (1999) (discussing this case and offering an alternative interpretation of it as a rule of customary international law modifying treaty obligations).

The Court considers that the acceptance of the Annex I map by the Parties caused the map to enter the treaty settlement and to become an integral part of it. . . . In other words, the Parties at that time adopted an interpretation of the treaty settlement which caused the map line . . . to prevail over the relevant clause of the treaty."²⁵⁰

This is the long-standing framework²⁵¹ that should be considered in judging American compliance with Article 6*bis*. But this also leads to an interesting question: do we judge American compliance against the weakest compliance with Article 6*bis* historically or against the weakest compliance currently? Our practice appears to be reasonably mainstream compared to historic treatment of the Article 6*bis* obligations, but less so in relation to current practices of Berne member states.

A. Comparative Historical Compliance

Respectable adherence to Berne historically did not require express statutory provisions establishing the two moral rights. While moral rights are commonly identified with French *droit d'auteur*, codification of moral rights did not occur in France until 1957—almost 30 years after 6*bis* was written.²⁵² Although Canada codified moral rights very early,²⁵³ most major common law countries—and several significant civil law countries—were members of the Berne Convention for decades before they passed moral rights statutes for the two Article 6*bis* rights.

²⁵⁰ Temple of Preah Vihear (Thail. v. Cambodia), 1962 I.C.J. 6, 33–34 (June 15).

²⁵¹ In the seventeenth century, the “usage of nations” was recognized as “the best interpreter of the sentiments of the contracting parties.” MCNAIR, *supra* note 241, at 252 (describing *Les Quatre Frères* (1778), Judge of the Admiralty Court, sitting in prize, interpreting a Treaty of 1670 between England and Denmark; and *The Vryheid (No. 1)* (1778), Judge of the Admiralty Court, sitting in prize, interpreting a Treaty of 1674 between England and Holland).

²⁵² Presently, the French statute has several *droit moral* provisions, but only one, Article L. 121-1 of the Intellectual Property Code, secures by itself both of the Article 6*bis* rights, guaranteeing the author a “right to respect for his name, his authorship, and his work.” Code Propriété Intellectuelle [C. PROP. INTELL.] art. L. 121-1 (Fr.). This ambiguous provision is uniformly recognized as embracing both a broad right of attribution and a strong right of integrity. See J.A.L. STERLING, *WORLD COPYRIGHT LAW* § 8.08, at 284 (1999).

²⁵³ See Copyright Amendment Act, 1931 S.C., ch. 8, § 12(7) (Can.); Copyright Act, R.S.C., ch. C-42, §§ 14.1, 28.1 (1985) (Can.); see also GOLDSTEIN *INTERNATIONAL COPYRIGHT*, *supra* note 4, at 284. The Canadian Supreme Court had already, without any statute, recognized moral rights surviving transfer of economic interests as early as 1911. See *Morang & Co. v. Le Seuer*, [1911] 45 S.C.R. 95, 97–98 (Can.) (“Nor could the author be denied by the publisher the right to make corrections, in dates or otherwise, if such corrections were found to be necessary for historical accuracy; nor could the manuscript be published in the name of another. After the author has parted with his pecuniary interest in the manuscript, he retains a species of personal or moral right in the product of his brain.”).

In the case of the United Kingdom, we have already discussed the 1952 parliamentary report that concluded that moral rights as such were unknown in English jurisprudence and a matter best left to "contract between the parties concerned."²⁵⁴ During their 1956 copyright law revision, the United Kingdom codified a small piece of a modern statutory moral-rights system.²⁵⁵ Section 43 of the 1956 Copyright Act addressed false attribution of authorship. Its provisions were narrowly tailored to circumstances where an author's name was "insert[ed] or affix[ed] . . . in or on a work of which that person is not the author."²⁵⁶ False-attribution liability expressly extended to distribution of falsely labeled copies,²⁵⁷ public exhibition of a falsely labeled work,²⁵⁸ false attribution in a public performance or broadcast,²⁵⁹ and false attribution of adaptations.²⁶⁰ The 1956 U.K. law provided the author with neither any positive right of attribution (i.e., it did not provide a cause of action against nonattribution) nor any right against false attribution of the author's work to third persons. An express right of integrity was similarly absent from English law²⁶¹ until an elaborate statute covering both Article 6bis rights was passed by Parliament in 1988.²⁶² During this sixty-year period of U.K. adherence to Berne Article 6bis, British law "left authors to secure protection for moral interests" through a composite of contract law and common law causes of action—defamation, injurious falsehood, passing-off, and privacy violations.²⁶³ It is also worth recognizing that the common law portion of the British composite

²⁵⁴ See discussion *supra* part III.

²⁵⁵ Copyright Act, 1956, 4 & 5 Eliz. 2, c.74, § 43 (U.K.). The U.K. Fine Arts Copyright Act 1862 had a provision prohibiting the selling of copies of an altered work as or in replacement of the original, unaltered work. 25 & 26 Vict., c. 68, § 7 (1862) (U.K.) This arguably provided some right of integrity protection in the period from 1862 until 1956.

²⁵⁶ Copyright Act, 1956, 4 & 5 Eliz. 2, c.74, § 43(2)(a) (U.K.).

²⁵⁷ *Id.* § 43(2)(a), (c).

²⁵⁸ *Id.* § 43(2)(b).

²⁵⁹ *Id.* § 43(2)(d).

²⁶⁰ *Id.* § 43(3).

²⁶¹ One practitioner guide states that "[p]rior to the [1988 amendments], English law did not recognize moral rights as such. The Copyright Act 1956 simply prohibited the false attribution of authorship in a protected work." BAKER & MACKENZIE'S GUIDE TO INTELLECTUAL PROPERTY IN THE I.T. INDUSTRY 28 (Robert Hart ed. 1998).

²⁶² Copyright, Designs, and Patents Act (CDPA), 1988, c.48 (U.K.). See also *supra* note 39 and accompanying text.

²⁶³ Lionel Bently, *United Kingdom*, in 2 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, at UK-89 (Paul Edward Geller ed., 2006). See *Prince Albert v. Strange*, (1849) 64 Eng. Rep. 293 (disclosure of confidential materials); *Ridge v. English Illus. Mag.*, [1911-16] Mag Cas. 91 (K.B. 1913); *Humphries v. Thompson*, [1905-10] Mag Cas. 148 (K.B. 1908); *Archibold v. Sweet*, [1832] 172 Eng. Rep. 947 (defamatory or injurious falsehood); *Clark v. Assoc. Newspapers*, [1998] 1 All E.R. 959 (Comm.); *Samuelson v. Producer's Dist.*, (1932) 1 Ch. 201 (passing off). But see *Sweeny v. MacMillan Publishers*, [2002] R.P.C. 651, ¶¶ 78-83 (rejecting passing off claim).

was arguably weaker than its American counterpart because of our more robust right of privacy.²⁶⁴

Since its inception, the Berne Convention has applied to Australia, first as a British colony and then, since 1928, as an independent signatory.²⁶⁵ Until 1956, British imperial copyright applied directly to Australia, so questions of Australia's Berne compliance until that date are generally subsumed under the analysis applied to the United Kingdom. In 1958, the Australian Attorney-General appointed a committee to study copyright issues (the "Spicer Committee") and, not surprisingly, the committee concluded that Australian copyright law complied with Article 6*bis* through the same composite of causes of action that British jurists had embraced.²⁶⁶ And again, this conclusion was reached while the common law portion of the Australian composite was arguably weaker than its American counterpart because "Anglo-Australian [common] law does not recognize privacy interests."²⁶⁷ The Australians did not codify moral rights provisions until their *Copyright Amendment (Moral Rights) Act 2000*.²⁶⁸ New Zealand fell literally midway between its two larger Commonwealth colleagues, more or less adopting the U.K moral rights statute in 1994.²⁶⁹

As mentioned earlier, Switzerland, also an 1887 Berne signatory,²⁷⁰ spent decades fulfilling its Article 6*bis* obligations with only the general provision in its Civil Code protecting an individual's right of personality, including honor,

²⁶⁴ Nimmer, *supra* note 1, at 523 n.132 (noting that "unlike the United States, the United Kingdom does not recognize the right of privacy in the full sense of the United States cause of action").

²⁶⁵ SAM RICKETSON, *INTELLECTUAL PROPERTY: CASES, MATERIALS AND COMMENTARY* 349 (1994).

²⁶⁶ "The Spicer Committee concluded that common law remedies existing at the time, such as contract law and the laws preventing defamation, were adequate to enable Australia to meet the requirements of the Berne Convention by indirectly protecting the author's moral rights." SAINSBURY, *supra* note 4, at 32.

²⁶⁷ 10th *Cantanae Pty Ltd. v. Shoshana Pty Ltd.* (1987) 79 A.L.R. 299. *See also* *Austrl. Broad. Comm'n v. Lenah Game Meats Pty Ltd.* (2001) 208 C.L.R. 199, 213 (confirming the lack of a right of privacy under Australian common law).

²⁶⁸ Copyright Amendment (Moral Rights) Act, 2000, No. 159 (Austl.), *available at* [http://www.comlaw.gov.au/ComLaw/Legislation/Act1.nsf/0/EB1A1A9EEC038ABFCA256F72000B5F61/\\$file/159of2000.pdf](http://www.comlaw.gov.au/ComLaw/Legislation/Act1.nsf/0/EB1A1A9EEC038ABFCA256F72000B5F61/$file/159of2000.pdf).

²⁶⁹ *See* Copyright Act 1994, 1994 S.N.Z. No. 143, 4, §§ 94-97; *see also* SUZY FRANKEL & GEOFF MCLAY, *INTELLECTUAL PROPERTY IN NEW ZEALAND* 241-47 (2002) (explaining the development and application of moral rights in New Zealand).

²⁷⁰ For a list of Berne member states, the date they initially became members of the Convention, and the latest version of the Convention to which each member is an adherent, *see* Berne Convention for the Protection of Literary and Artistic Works, Status on April 13, 2007, *available at* <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/berne.pdf> [hereinafter *Berne Status 2007*]. Switzerland is listed as a party to the Paris (1971) revision of the Convention. *Id.* at 11.

reputation, and privacy.²⁷¹ Specific provisions recognizing Article 6*bis* rights were not codified into Swiss law until 1992,²⁷² four years after the United States joined Berne.²⁷³ Belgium also lacked a codified right of attribution until 1994.²⁷⁴

In short, when the then Director-General of WIPO endorsed the view in 1987 that a patchwork of common law causes of action could fulfill Article 6*bis*,²⁷⁵ he had a good foundation in the historic and then current practices of several Berne members. That treaty provisions may be given very broad, almost counterintuitive interpretations is compatible with the principle of *pacta sunt servanda* if that principle is understood "as part of the more general principle of legitimate expectation."²⁷⁶ By 1988, the members of the Berne Convention should have legitimately expected that an adhering party would comply without express statutory provisions in its copyright law (Switzerland) and with only court-established doctrines, whether civil law (France, Belgium) or common law (Britain, Australia). And the United States could legitimately expect that that is what the other Berne member states would expect. Moreover, since 1988, formal diplomatic objections to the United States' compliance with Article 6*bis* have been rare and oblique.²⁷⁷

²⁷¹ Schweizerisches Zivilgesetzbuch [ZGB] [Civil Code] Dec. 10, 1907, SR 210, art. 28 (Switz.). For a brief discussion of Swiss moral rights, see Francois Dessemontet, *Switzerland*, in 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, at SWI-56 to SWI-61 (Paul Edward Geller ed., 2006).

²⁷² Dessemontet, *supra* note 271 (discussing art. 9 of the Swiss Copyright Act). See also Rigamonti, *supra* note 44, at 392.

²⁷³ Berne Status 2007, *supra* note 270.

²⁷⁴ The right of paternity is now codified in Article 1(2) of the 1994 Copyright Act, but prior to that "this right did not figure in the [statutory] law." STROWEL, *supra* note 20, para. 393(2), at 504. Nonetheless, the Berne Convention applied directly to individuals in Belgium, so a right of attribution unquestionably existed. Email from Alain Strowel, Professor of Law, Facultés universitaires Saint-Louis, Belgium to author (Sept. 27, 2004, 06:48 EST) (on file with author).

²⁷⁵ In 1987, WIPO Director-General Dr. Arpad Bogsch sent a letter to Irwin Karp, which became part of the Congressional Record on Berne accession and implementation. Bogsch wrote:

In my view, it is not necessary for the United States of America to enact statutory provisions on moral rights . . . to comply with Article 6*bis* of the Berne Convention. The requirements under this Article can be fulfilled not only by statutory provisions in a copyright statute but also by common law and other statutes.

H.R. REP. NO. 100-609, at 37 (1988).

²⁷⁶ BYERS, *supra* note 249, at 175.

²⁷⁷ In recent years the European Commission has suggested that "problematic" moral rights protection in the United States constitutes a trade barrier, a curious conclusion considering that moral rights are considered paradigmatically non-economic, so much so that the Commission does not even have *competence* in the field of moral rights. See European Commission, *United States Barriers to Trade and Investment: Report for 2006*,

B. Comparative Current Compliance

Yet as Maree Sainsbury notes “[i]n the context of moral rights, there is an overwhelming international trend towards providing direct moral rights protection in legislation specifically designed for the purpose, rather than relying on indirect protection to protect the rights of integrity and attribution.”²⁷⁸ For example, in addition to the countries discussed above, China’s 1990 copyright statute included for the first time rights of integrity, alteration, attribution, and first publication identified as personality rights, separate from property rights.²⁷⁹ Malaysia also promulgated an intricate moral rights provision in 1990 when it acceded to the Berne Convention.²⁸⁰ The current WIPO model law for copyright apparently includes express rights of integrity and attribution, with the latter broken into express language on attribution, anonymity, and pseudonyms.²⁸¹

The question is whether this change in national practices could alter the proper interpretation of Article 6bis against a party who joined the treaty before the establishment of the new standard for national implementation of the Article 6bis obligation.²⁸²

14 (2007); European Commission, *United States Barriers to Trade and Investment: Report for 2005*, 5, 68–69 (2006); European Commission, *Report on United States Barriers to Trade and Investment 2004*, 8, 65–66 (2004). The 2005 and 2004 reports all but accuse the United States of being out of compliance with Berne Article 6bis, while the 2006 report does not explore the issue in depth.

²⁷⁸ SAINSBURY, *supra* note 4, at 16.

²⁷⁹ Zhu zuo quan fa [Copyright Law] (promulgated by the Standing Comm. Nat’l People’s Cong., Sept. 7, 1990, effective June 1, 1991), art. 10 (P.R.C.). The separate rights of “integrity” and to control “alterations” seem duplicative or overlapping.

²⁸⁰ Copyright Act 1987, § 25 (1987) (Malay.). Email from Ida Madieha Abdul Ghani Azmi, Professor, International Islamic University of Malaysia, to author (Sept. 28, 2004, 20:56 EST) (on file with author).

²⁸¹ When consulting with developing countries that are modernizing their copyright laws, WIPO generally claims that they do not use a model law. Understandably, an official model law could become a political football match between the United States and the European Union over provisions like moral rights. But in 2003, Laos, in consultation with WIPO, prepared a draft copyright law which appears to reflect the WIPO model. *See* Draft Law on Copyright and Related Rights for the Lao People’s Democratic Republic (on file with the author).

²⁸² *See, e.g.,* Harold J. Berman & Colin Kaufman, *The Law of International Commercial Transactions (Lex Mercatoria)*, 19 HARV. INT’L L. J. 221, 254 (1978) (noting in the context of international *lex mercatoria* that “[i]t is not always easy . . . to determine . . . common understandings, especially as they shift with changing commercial practices” but that American courts have “been more willing than courts of many other countries” to accept shifts in practices as evidence of shifts in common understandings of law and legal obligations). The use of modern practices—as expressly contrasted with different, historic practices—to understand the content of the treaty obligation is different than the suggestion of some scholars that more recent intellectual property treaty provisions are proper evidence for the interpretation of ancestor treaty obligations. *See, e.g.,* Neil W. Netanel, *The Next Round: The Impact of the WIPO Copyright Treaty on TRIPS Dispute*

First, it seems unlikely that the recent change in national practices in recognizing authorial rights of attribution and integrity could tighten the proper interpretation of Article 6*bis*. Whatever the trend of the past twenty-five years, there were decades of state practice following the initial establishment of Article 6*bis*; that early practice is privileged in informing the interpretation of Article 6*bis*; and new practice should only modify such an interpretation after a much longer period of widespread and consistent state action. Related to this point, the amount of leeway contracting states are given in implementing treaty obligations can vary from treaty to treaty. In the case of the Berne Convention, there has been a significant amount of deference to states in permitting them to make their own interpretation of the Convention's obligations.²⁸³ Deference to national interpretation of treaty provisions is embodied in the interpretative canon *in dubio mitius*, if a provision is ambiguous, "the preferred meaning is the one that is the least onerous to the party assuming an obligation . . . or that involves the fewest general restrictions on the parties."²⁸⁴ Deferential interpretation is inextricably linked to, if not founded on, the positivist idea in international law that a state can only be bound to those obligations to which it has consented, consent being strictly construed.²⁸⁵

Settlement, 37 VA. J. INT'L L. 441, 447 (1997) (reasoning that, to some extent, "the WIPO Copyright Treaty and Agreed Statements in fact constitute subsequent agreement and state practice under Berne and TRIPS"); Pamela Samuelson, *The U.S. Digital Agenda at WIPO*, 37 VA. J. INT'L L. 369, 406–07 (1997) (suggesting that the negotiating history of the 1996 WIPO Copyright Treaty could be used in WTO dispute resolution to interpret the proper scope of Article 13 of the TRIPS Agreement).

²⁸³ Graeme B. Dinwoodie, *The Development and Incorporation of International Norms in the Formation of Copyright Law*, 62 OHIO ST. L.J. 733, 740 (2001) (discussing "deference shown member states' own interpretation of what was required to comply with the Convention").

²⁸⁴ Richard H. Steinberg, *Judicial Lawmaking at the WTO: Discursive, Constitutional, and Political Constraints*, 98 AM. J. INT'L L. 247, 258 (2004). See generally 2 OPPENHEIM'S INTERNATIONAL LAW 1278 (Robert Jennings & Arthur Watts eds., 9th ed. 1992); James Cameron & Kevin R. Gray, *Principles of International Law in the WTO Dispute Settlement Body*, 50 INT'L & COMP. L.Q. 248, 254 (2001). WTO panels have recognized this principle in interpreting GATT and WTO obligations. See Appellate Body Report, *European Communities—Measures Concerning Meat and Meat Products (Hormones)*, ¶ 165 n.154, WT/DS26/AB/R, WT/DS48/AB/R (Jan. 16, 1998).

²⁸⁵ The principle of deference to national interpretation seems to have spawned an offshoot in European human rights jurisprudence—the margin of appreciation. See HOWARD C. YOUROW, *THE MARGIN OF APPRECIATION DOCTRINE IN THE DYNAMICS OF EUROPEAN HUMAN RIGHTS JURISPRUDENCE* 9, 15–16 (1996); Laurence R. Helfer, *Finding a Consensus on Equality: The Homosexual Age of Consent and the European Convention on Human Rights*, 65 N.Y.U. L. REV. 1044, 1052–59 (1990). The principle appears to have developed to provide deference to state action in time of national emergency (such as during IRA terrorism). Such deference in application of Berne provisions is arguably visible in the WTO panel's May 2000 decision concerning the United States' Fairness in Music Licensing Act. Panel Report, *United States—Section 110(5) of the U.S. Copyright Act*, WT/DS160/R (June 15, 2000), available at http://www.wto.org/english/tratop_el

In the case of Berne Article 6bis, deference to national interpretation is appropriate not only because of varied state practice historically, but because of varied state practice currently: France's limitation of moral rights in software,²⁸⁶ the exception-riddled moral rights statute in the United Kingdom,²⁸⁷ special regimes for particular kinds of works in Germany and the United States,²⁸⁸ etc. While national moral rights laws probably do not range as widely as national limitations and exceptions to copyright, they arguably range more widely than national implementation of the right of reproduction or even national implementation of the new international legal norm protecting digital locks from circumvention.²⁸⁹

Finally, even if national practices could trigger a new, stricter interpretation of Article 6bis, it is not at all clear that that interpretation could be applied against members who joined the Convention before the new consensus on national practices. Cogent estoppel and acquiescence arguments can be made under public international law²⁹⁰ by which the United States should be permitted to continue with "weak implementation" of Article 6bis. Estoppel has been an accepted principle of public international law since at least the Permanent Court of International Justice's (PCIJ) 1928 decision in *Concerning the Factory at Chorzow*.²⁹¹ While often applied to territorial claims,²⁹² estoppel has grounded the

dispu_e/cases_e/ds160_e.htm. Although the Panel found that the Act was a violation of TRIPS, as Graeme Dinwoodie has noted, "The report contains several passages apparently exhibiting substantial deference to national autonomy. Indeed, in many respects, the panel's level of deference contains an echo of pre-TRIPS attitudes to compliance." Dinwoodie, *supra* note 283, at 765. This pervasive national autonomy is not rooted in seven years of state practices vis-à-vis TRIPS Article 13; it is rooted in decades of varied state practices vis-à-vis Berne Article 9(2).

²⁸⁶ Code Propriété Intellectuelle [C. PROP. INTELL.] art. L. 121-7 (Fr.).

²⁸⁷ See generally Rigamonti, *supra* note 44, at 400-04.

²⁸⁸ The American VARA provisions were discussed extensively. See *supra* note 70-84 and accompanying text. For Germany's special regime for right of integrity with motion pictures, see Section 93(1), Urheberrechtsgesetz [UrhG] [Copyright Law], Sept. 9, 1965, BGB1. I at 1273, last amended by Gesetz, Sept. 10, 2004, BGB1. I at 1774.

²⁸⁹ Established by Article 11 of the WCT, *supra* note 86. See generally Justin Hughes, *The Internet and the Persistence of Law*, 44 B.C. L. REV. 359, 375-376 (2003) (discussing consistent U.S. and E.U. implementation of Article 11).

²⁹⁰ Keith Highet & George Kahale III, *International Decisions*, 89 AM. INT. L. J. 376, 382-383 (1995) ("The doctrine of estoppel, as it operates in public international law and EC law, serves to protect the settled expectations of states that relied in good faith on clear and unambiguous representations by another state by precluding the latter from subsequently adopting different statements.").

²⁹¹ (Ger. v. Pol.) 1928 P.C.I.J. (ser. A) No. 17, at 33-34 (Sept. 13) (recognizing estoppel as a "general principle of International Law by civilized nations"). See, e.g., *Concerning the Temple of Preah Vihear* (Cambodia v. Thail.), 1962 I.C.J. 6, 40 (separate opinion of Judge Alfaro); Georg Schwarzenberger, *Fundamental Principles of International Law*, 87 RECUEIL DES COURS 195, 301 (1955).

²⁹² See, e.g., *Fisheries* (U.K. v. Nor.), 1951 I.C.J. 116 (Dec. 18). In the 1951 *Fisheries* case, the United Kingdom objected to Norway's system of calculating the Norwegian

ICJ's procedural conclusions at least once²⁹³ and it is reasonable to argue that in putting forward its "patchwork" protection, the United States relied on the conduct exhibited by many prominent Berne members (and tolerated by all others) up until 1988.²⁹⁴

VII. CONCLUSION

Reviewing America's 1988 commitment to Berne moral rights with fifteen years of hindsight, William Patry concluded that "it was crystal clear that U.S. law provided no such rights" and that "the Reagan Administration and Congress engaged in the charade of claiming that the United States already had adequate moral rights to permit adherence."²⁹⁵ But by 1988 multiple commissions and scholars in multiple common law jurisdictions had reached a very different conclusion: that a patchwork of causes of action provided roughly similar rights. Australia, New Zealand, and the United Kingdom were Berne signatory for decades without statutory moral rights; France itself had run solely on judge-created rights for three decades of Berne obligations; Switzerland had fulfilled its obligations with a scanty code provision robustly construed. Either the charade was enormously widespread, or widespread diversity of national practices had established broad leeway in national implementation of Article 6bis.

Because § 43(a) of the Lanham Act figured prominently in all narratives about patchwork protection, there is no question that the *Dastar* decision punched a hole in the patchwork. The motivating force behind the *Dastar* decision—to keep public domain materials wholly unencumbered—was correct. But that critical goal could have been achieved in a way that would have been more sensible for both the Lanham Act and our Berne Article 6bis obligations. Instead, *Dastar*'s policy-driven reading of "origin" in § 43(a) has been extended somewhat mindlessly by courts to other elements of § 43(a) and to reinterpretation/preemption of state

coastline because it pushed Norwegian waters into territory that Britain considered open seas. The ICJ, however, noted that "[t]he system [of delimitation] was consistently applied by Norwegian authorities," *id.* at 136–37, and that "[f]or a period of more than sixty years the United Kingdom Government itself in no way contested it," *id.* at 138. On this basis, the ICJ ruled in favor of Norway. *Id.* at 139–143.

²⁹³ *Concerning Military and Paramilitary Activities in and Against Nicaragua* (Nicar. v. U.S.), 1984 I.C.J. 392 (Nov. 26) (United States estopped from disputing jurisdiction under Article 36(2) of the Statute of the Court). See also Megan L. Wagner, Comment, *Jurisdiction by Estoppel in the International Court of Justice*, 74 CAL. L. REV. 1777 (1986).

²⁹⁴ Jurists of international law vary on whether estoppel in international law requires reliance and detriment, but the United States would be able to argue such reliance and detriment. For a view that reliance is required, see Judge Fitzmaurice in the *Preah Vihear Temple* case, 1962 I.C.J. 6, 63–64. For the view that reliance is not required, see *Legal Status of Eastern Greenland* (Den. v. Nor.), 1933 P.C.I.J., (ser. A/B), No. 53, at 68 (Apr. 5).

²⁹⁵ William Patry, *The United States and International Copyright Law: From Berne to Eldred*, 40 HOUS. L. REV. 749, 751 (2003).

unfair competition laws. All this has made the “*Dastar* gap” larger than it need have been. At the same time, the discussion above has shown that the new gap in Article 6bis protection created by *Dastar* may be, practically speaking, quite small. In particular, the complexity of § 43(a)’s wording may mean that a *Gilliam*-style misattribution will still be actionable under § 43(a) as a misrepresentation of fact. Section 1202 of the Copyright Act, VARA, state law moral rights statutes, state law reverse-passing-off claims, and contract law have all been discussed as factors narrowing the real *Dastar* gap.

To some Europeans, the gap—no matter how small—will comport with their vision of America as a place that cares more about commerce than culture. This is an enduring, probably permanent, theme in transatlantic relations. In *Democracy in America*, Alexis de Toqueville observed that in America “there is no class . . . in which the taste for intellectual pleasures is transmitted with hereditary fortune and leisure and by which the labors of intellect are held in honor.”²⁹⁶ An American looking at continental European moral rights in 1940 lamented that “[b]usy with the economic exploitation of her vast natural wealth, America has, perhaps, neglected the arts,”²⁹⁷—a strange thing to write while Europeans were busy waging World War II on one another.

If you adhere to a pure economic incentive view of American copyright law, then it may be a waste of judicial resources to “require[e] that courts adjudicate disputes relating to attribution in cases where attribution offers no market benefits”²⁹⁸—that is, it may be a waste of time to fix a relatively small problem with no economic import. On the other hand, if you believe that attribution and recognition are quite important to authors regardless of the economic benefits, then—while still respecting the public domain spirit of the Court’s decision—the *Dastar* gap would be an easy thing to fix.

²⁹⁶ ALEX DE TOQUEVILLE, 1 DEMOCRACY IN AMERICA 52 (Phillips Bradley, trans., Vintage Books 1st ed. 1990).

²⁹⁷ Roeder, *supra* note 34, at 557.

²⁹⁸ Band & Schruers, *supra* note 228, at 11.

COPYRIGHT, FAIR USE AND MOTION PICTURES*

Peter Jaszi**

I. MOTION PICTURES AND COPYRIGHT DISCIPLINE

Consider the following passage, drawn from what appears to have been the first published report of a copyright infringement involving the new art of motion pictures in the United States:

The complainant's operator, by means of a pivoted camera of special construction, designed and owned by complainant, took in rapid succession, on a single highly sensitized celluloid film 300 feet long, 4,500 pictures, each of which was a shade different from its predecessor and successor, and all of which collectively represented at different points Kaiser Wilhelm's yacht Meteor while being christened and launched. From this film or negative a positive reproduction was made on a celluloid sheet by light exposure. The value of such celluloid reproduction is that by means of an appliance similar to a magic lantern these views may be thrown on a screen in rapid succession so as to give the effect of actual motion, and pictorially reproduce launching precisely as it took place. This positive celluloid sheet was sent by the complainant to the Department of the Interior, and by it copyrighted to him as proprietor under "the title of a photograph, the title to which is in the following words, to wit, 'Christening and Launching Kaiser Wilhelm's Yacht Meteor.'" The complainant thereafter placed on the copies thereof issued by him a notice of copyright inscribed on a celluloid plate fastened on the front and at one end of the sheet. From the other end of one of such marked articles about one-third thereof was detached by some unknown person, and came into the hands of respondent, without knowledge on his part of its having been copyrighted. The 1,500 pictures on this part, which represented a part of the launch, Lubin photographed on a sensitized celluloid film. From this negative he reproduced a positive on a celluloid sheet, which was, of course, an exact reproduction of the copyrighted one of the complainant. These were sold to exhibitors, and enabled them to reproduce the part of the launch therein represented.¹

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¹ Edison v. Lubin, 122 F. 240, 240-41 (3d Cir. 1903).

The decision helped to establish, among other things, that motion pictures were entitled to the protection of the law even though they had not been in contemplation when the Copyright Act of 1870 was enacted.² The court reasoned that

[f]rom the standpoint of preparatory work in securing the negative, the latter consists of a number of different views, but when the negative was secured the article reproduced therefrom was a single photograph of the whole. And that it is, in substance, a single photograph, is shown by the fact that its value consists in its protection as a whole or unit, and the injury to copyright protection consists not in pirating one picture, but in appropriating it in its entirety.³

The *Edison* court also demonstrated another kind of truth about motion pictures: that from its inception the new medium was a radically appropriative one.⁴ Whether or not one believes the self-serving and ultimately unavailing representation of the defendant, Sigmund "Pop" Lubin, that he was unaware of the Edison copyright is not the point:⁵ then, as now, the movies thrived on their ability to capture and repurpose existing material, much of it subject to prior claims of copyright protection.

Other early encounters between film and copyright dealt with less straightforward appropriations from one production to another, like the motion picture involved in *American Mutoscope & Biograph Co. v. Edison Manufacturing Co.*

An examination of the complainant's positive film . . . shows that it contains several hundred pictures, and that the camera in which were produced the negatives from which the positive film was printed occupied no less than seven or eight different positions, the first two or three of which, it is clear from the statements of the bill of complaint, were at or near to Gen. Grant's Tomb in New York City, the others being evidently in some country district. The defendant's photograph is also a positive film, evidently printed from negatives taken by a camera located

² *Id.* at 242 (stating that the motion picture at issue met the statutory requirement even though "the continuous method by which [the] negative was secured was unknown when the act was passed").

³ *Id.*

⁴ *Id.* at 241.

⁵ *Id.* For a first-hand account of Lubin's questionable duping practices, see FRED J. BALSCHOFER & ARTHUR C. MILLER, *ONE REEL A WEEK* 7-8 (1967). Balshofer also notes that "[b]esides duping and occasionally making a picture, [the Philadelphia studio] faked championship bouts by using matched doubles for the boxers and staging the round-by-round action from the newspaper accounts," and describes the production of an ersatz newsreel of the San Francisco earthquake using cardboard cutouts of buildings. *Id.* at 9.

at seven or eight different places, the first two or three of which were taken near to Gen. Grant's Tomb, or to a structure strongly resembling it; the remaining places being also in some country district. That the complainant's photograph is a reproduction upon a positive film of pictures on negatives taken by a camera located at different points is confirmed by the language of the ninth paragraph of the bill, which states that "the scene prominently depicted in said photograph occurred largely at Grant's Tomb, on Riverside Drive, in New York City," and in the subsequent statement in the same paragraph that "in successive scenes the chase is depicted across the country in various situations." The title of the complainant's copyrighted photograph consists simply of the word "Personal." There is nothing in the proceedings for securing the copyright, as they are set forth in the bill, indicating that the scene depicted in the photograph "represents a French gentleman," or any other person who had "inserted an advertisement stating his desire to meet a handsome girl at Grant's Tomb." Consequently, there is nothing in the complainant's photograph, or in the title to its copyright, or in the proceedings for securing its copyright, in any wise suggestive of the title of the defendant's photograph, which is "How a French Nobleman Got a Wife Through the New York Herald Personal Columns."⁶

Although the court was not convinced that the latter film was an unlawful derivative of the former, its opinion established the principle that infringement by wrongful adaptation, rather than from direct reproduction, is possible under the copyright law as applied to motion pictures.⁷ The United States Supreme Court underlined and extended this principle six years later, when, in the "Ben-Hur" decision, it concluded that the unauthorized production of a motion picture version could infringe the copyright of the underlying literary work.⁸

Indeed, down to the present day much of the copyright litigation surrounding motion pictures has grown out of controversies about the wrongful appropriation of content or imagery from one motion picture to another, or from a creative work in another medium into the motion pictures.⁹ This essay, however, is concerned with the legal implications of another set of practices characteristic of motion picture production, to which one might apply the term coined by Bernard Edelman in a somewhat different context: the "over-appropriation of the real."¹⁰ While much of the focus in what follows is on documentary filmmaking, I hope to indicate how the problems of copyright arise, and how the doctrine of fair use can help to resolve them, across a spectrum of media.

⁶ 137 F. 262, 264-65 (C.C.D.N.J. 1905).

⁷ *Id.* at 267-68.

⁸ *Kalem Co. v. Harper Bros.*, 222 U.S. 55, 62 (1911).

⁹ See Peter Jaszi, *When Works Collide: Derivative Motion Pictures, Underlying Rights, and the Public Interest*, 28 UCLA L. REV. 715 (1981).

¹⁰ BERNARD EDELMAN, *OWNERSHIP OF THE IMAGE: ELEMENTS FOR A MARXIST THEORY OF LAW* 38-43 (Elizabeth Kingdom trans., Routledge & Kegan Paul 1979) (1973).

Motion pictures' dependence on the raw material of reality is, of course, most obvious in connection with the documentary film tradition,¹¹ which has its origins in early newsreels and "local views."¹² But well before 1917, it also had become an important part of the classical mode of American fiction film production, with its emphasis on placing the spectator within an illusionistic three-dimensional space. Not only did actual locations come to be substituted more commonly for studio backgrounds, but as the authors of *The Classical Hollywood Cinema* note, "whenever possible sets were built on location, so that real landscapes rather than painted flats frequently appeared outside windows in the early teens."¹³ Inevitably, however, the increasing reliance of motion picture production on the appropriation of reality has given rise to tensions that have been expressed in terms of conflicts over copyright. These tensions have become more acute over time, as the "real" environment has become more and more saturated with media artifacts, and as copyright law itself has extended its domain over more and more of those media objects.¹⁴

Within copyright law, the tension between contemporary creators' needs for access to preexisting material, on the one hand, and the imperatives of copyright ownership, on the other, are mediated primarily by the so-called "fair use" doctrine. The application of this venerable legal concept, which exempts some substantial takings of protected content from infringement liability, is the subject of this essay.

II. WHAT IS FAIR USE?

"Fair use" has its origins in a line of judicial decisions dating back to 1841, when a federal court considered whether a biographer of George Washington should be excused for having borrowed material from an earlier published biography.¹⁵ The fair use doctrine functions as a kind of "safety valve" in the copyright system. As the reach of copyright law increased in the mid-twentieth century, it came to be more frequently relied upon by defendants and interpreted by the judges. There have been various efforts to explain the theoretical bases of fair use, but perhaps none better than Alan Latman's 1958 summary, which was based on a comprehensive review of cases and other authorities:

¹¹ PATRICIA AUFDERHEIDE, DOCUMENTARY FILM—A VERY SHORT INTRODUCTION (forthcoming Oct. 2007).

¹² CHARLES MUSSER, THE EMERGENCE OF CINEMA: THE AMERICAN SCREEN TO 1907, at 266 (1990).

¹³ DAVID BORDWELL, JANET STAIGER, & KRISTIN THOMPSON, THE CLASSICAL HOLLYWOOD CINEMA: FILM STYLE & MODE OF PRODUCTION TO 1960, at 217 (1985).

¹⁴ In documentary practice, the tension has been further exacerbated by the rise of the *cinema verité* style, reliance on which increases the likelihood that copyrighted works will be captured incidentally in the course of filming, and by the increasing inclination of some filmmakers to tape the media environment itself as a subject.

¹⁵ *Folsom v. Marsh*, 9 F. Cas. 342, 344 (C.C.D.Mass 1841) (No. 4901).

[A]s a condition of obtaining the statutory grant, the author is deemed to consent to certain reasonable uses of his copyright work to promote the ends of public welfare for which he was granted copyright . . .

The theory of “enforced consent” suggests another rationale which relies more directly upon the constitutional purpose of copyright. It has often been stated that a certain degree of latitude for the users of copyrighted works is indispensable for the “Progress of Science and useful Arts” [because] progress depends on a certain amount of borrowing, quotation and comment.

Justification for a reasonable use of a copyrighted work is also said to be based on custom. This would appear to be closely related to the theory of implied consent. It also reflects the relevance of custom to what is reasonable. In any event, it has been stated that fair use is such as is “reasonable and customary.”¹⁶

More recently, the United States Supreme Court has made it clear that fair use is one of the mechanisms by which copyright recognizes the principle of freedom of expression that is enshrined in the First Amendment to the U.S. Constitution: without fair use, copyright law could be found unconstitutional as applied to expressive activities such as documentary filmmaking.¹⁷

The judge-made fair use doctrine was codified in 1976, as part of the general revision of the Copyright Act of 1909, which took effect on January 1, 1978.¹⁸ Both before that time and afterwards, the doctrine has been extensively interpreted by the U.S. federal courts, including the U.S. Supreme Court and the various circuit courts of appeals. Among other things, these courts have made it clear that, broadly speaking, fair use comes in two varieties—one relating to personal or private end uses of copyrighted material and the other to reuses that are arguably “productive” in nature.¹⁹ Obviously, the dichotomy is a somewhat artificial one, since all creative practice ultimately is rooted in imitation. But the distinction is serviceable nevertheless, if only because it allows us to note that some aspects of the fair use doctrine are fairing better in contemporary courts than others. Recent commentaries on case law suggest that the concept of “passive” fair use is at risk

¹⁶ ALAN LATMAN, STUDY NO. 14, FAIR USE OF COPYRIGHTED WORKS (1958), reprinted in 2 STUDIES ON COPYRIGHT 781, 785 (Arthur Fisher Memorial ed. 1963).

¹⁷ Eldred v. Ashcroft, 537 U.S. 186, 219–20 (2003).

¹⁸ 17 U.S.C. § 107 (1976).

¹⁹ See, e.g., Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 578–79 (1994) (highlighting the importance of permitting reuses that are transformative); Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 455 n.40 (1984) (addressing the degree to which the fair use doctrine should protect “productive” uses). For a discussion of the difficulty of articulating a workable definition of transformative use, see, for example, Mitch Tuchman, *Judge Leval’s Transformation Standard: Can it Really Distinguish Foul from Fair?*, 51 J. COPYRIGHT SOC’Y. 101 (2003).

today, as new technologies continue to blur the public/private line.²⁰ By contrast, the “active” branch of the doctrine is thriving, in its application to fields of cultural practice as diverse as scholarship, musical parody, computer programming, and film production.²¹

III. FAIR USE IN ACTION

Section 107 directs courts considering whether a particular challenged use is fair to evaluate, among other things, four factors derived from pre-1976 judicial opinions:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.²²

In recent decisions, moreover, the courts have indicated that a critical consideration in evaluating most, if not all, of these factors, is whether the use can be considered “transformative”—whether it “adds something new, with a further purpose or different character.”²³ If that is the case, the first factor can weigh in favor of fair use even if the use is “commercial” in character.²⁴ Self-evidently, the second factor tends to favor transformative uses as well, precisely because they add value to the preexisting material rather than merely repeating it for its original purpose. Moreover, if the use is transformative, courts will approve the use of a greater proportion of the protected material in connection with the third factor. Finally, and crucially, if a use is a transformative one, it is likely to satisfy the fourth factor as well, because, as the Second Circuit Court of Appeals recently recognized, copyright owners are not entitled to control the “transformative markets” for their works.²⁵

The Second Circuit Court of Appeals explained how fair use works today in *Bill Graham Archives v. Dorling Kindersley Ltd.*²⁶ In that case, the defendant

²⁰ Rebecca Tushnet, *Copy This Essay: How the Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535, 537 (2004).

²¹ Paul Goldstein, *Fair Use in a Changing World*, 50 J. COPYRIGHT SOC'Y U.S.A. 133, 137–38 (2003).

²² 17 U.S.C. § 107.

²³ *Acuff-Rose Music*, 510 U.S. at 579.

²⁴ *Id.* (“[T]he more transformative the new work, the less will be the significance of other factors, like commercialism . . .”).

²⁵ *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 614–15 (2d Cir. 2006).

²⁶ *Id.*

published what the court described as a “480-page coffee table book [that] tells the story of the Grateful Dead along a timeline running continuously through the book, chronologically combining over 2000 images representing dates in the Grateful Dead’s history with explanatory text. A typical page of the book features a collage of images, text, and graphic art designed to simultaneously capture the eye and inform the reader.”²⁷ The plaintiff owned the copyrights to posters and other graphic materials associated with the musical group’s historic appearances at the Fillmore Auditorium and other Bay Area venues.²⁸ After license negotiations for the use of these materials in the book broke down, the publisher proceeded to use seven of them without authorization, and the lawsuit followed.²⁹

The court’s analysis began with the first statutory factor: the purpose and character of use.” Because the publisher deployed the images in a “transformative” way, the judges agreed with the trial court that the

use of images placed in chronological order on a timeline is transformatively different from the mere expressive use of images on concert posters or tickets. Because the works are displayed to commemorate historic events, arranged in a creative fashion, and displayed in significantly reduced form, . . . the first fair use factor weighs heavily in favor of DK.³⁰

In other words, the recontextualization of the quoted material made all the difference to the determination of its transformative character. Moreover, if the user’s purpose was transformative, the mere fact that it was also commercial does not bar application of the doctrine.³¹ In fact, the court notes, most fair uses are conducted for profit.³²

The second factor, the nature of the copyright work, which often favors copyright plaintiffs, was judged here to be inconclusive, on reasoning that echoes the language already quoted:

We recognize . . . that the second factor may be of limited usefulness where the creative work of art is being used for a transformative purpose . . . of enhancing the biographical information provided in Illustrated Trip. Accordingly, we hold that even though BGA’s images are creative works, which are a core concern of copyright protection, the second factor has limited weight in our analysis because the purpose of DK’s use was to emphasize the images’ historical rather than creative value.³³

²⁷ *Id.* at 607.

²⁸ *Id.* at 607 n.1.

²⁹ *Id.*

³⁰ *Id.* at 609.

³¹ *Id.* at 611–12.

³² *Id.* at 612 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 584 (1994)).

³³ *Id.* at 611.

Thus, while the posters were creative works, this use focused on their value as historical artifacts.

The court deemed the third factor—the amount and substantiality of the portion used—to be a toss-up, since to accomplish its transformative purpose, “DK displayed reduced versions of the original images and intermingled these visuals with text and original graphic art. As a consequence, even though the copyrighted images are copied in their entirety, the visual impact of their artistic expression is significantly limited because of their reduced size.”³⁴

Finally, the important fourth factor, the effect of the use upon the market for the value of the original, tilted conclusively for the defendant:

DK’s use of BGA’s images is transformatively different from their original expressive purpose. In a case such as this, a copyright holder cannot prevent others from entering fair use markets merely “by developing or licensing a market for parody, news reporting, educational or other transformative uses of its own creative work . . . [C]opyright owners may not preempt exploitation of transformative markets”³⁵

The court continued by noting that “a publisher’s willingness to pay license fees for reproduction of images does not establish that the publisher may not, in the alternative, make fair use of those images.”³⁶

One of the most notable features of this enlightening opinion is the court’s heavy reliance for precedent on some of the last decade’s crop of fair use cases involving claims against documentary filmmakers—many of which were resolved in favor of the defendants.³⁷ A description of some of those decisions follows.

IV. MOTION PICTURES AND FAIR USE BY THE NUMBERS

This important development in fair use began in 1996, with *Monster Communications v. Turner Broadcasting System*,³⁸ which involved no more than two minutes of clips from *When We Were Kings*, an acclaimed non-fiction feature on the Muhammad Ali–George Forman “rumble in the jungle,” that had been incorporated into a TNT made-for-television documentary called “Ali—The Whole Story.”³⁹ The court marches through the four statutory factors, finding that its status as a biography of a public figure favors fair use: that “the character [of the quoted material] as historical film footage may strengthen somewhat the hand of a fair use defendant as compared with an alleged infringer of a fanciful work or

³⁴ *Id.* at 613.

³⁵ *Id.* at 614–15 (quoting *Castle Rock Entm’t, Inc. v. Carol Publ’g Group*, 150 F.3d 132, 146 n.11 (2d Cir. 1998)).

³⁶ *Id.* at 615 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 585 n.18 (1994)).

³⁷ *Id.* at 608–15.

³⁸ 935 F. Supp. 490 (S.D.N.Y. 1996).

³⁹ *Id.* at 491.

a work presented in a medium that offers a greater variety of forms of expression;⁴⁰ that the amount taken is small, both quantitatively and, in light of the different topical emphases of the two films qualitatively;⁴¹ and that neither the commercial reception of *When We Were Kings* itself, nor the prospects for spin-offs, such as music videos, from the film, were likely to be affected by the existence of the television program.⁴² Notably, the court did not address the powerful but circular argument that copyright owners sometimes make in connection with the fourth factor: that the very loss of licensing revenue from the defendant's use represents market harm. It was this argument—apparently not presented by the plaintiff here—that the court in *Bill Graham Archives* subsequently answered by its reference to “transformative markets.”⁴³ Finally, in addition to being first in the line of documentary fair use cases, *Monster* also has the distinction of being one of the last fair use decisions—relating to this or any other domain of practice—to not mention “transformativeness.”

For better or worse, transformativeness rapidly became a meta-factor, dominating juridical discourse. And although most documentary filmmakers who have been defending infringement claims on the basis of fair use have been as successful as TNT was in *Monster*, there have been exceptions to this trend—and they are instructive in their own right. To illustrate, consider two decisions dealing with biographical documentaries: *Elvis Presley Enterprises, Inc. v. Passport Video*,⁴⁴ and *Hofheinz v. A & E Television Networks, Inc.*⁴⁵ In the first of these cases, defendants, Passport Video, produced a sixteen-hour video documentary about the life and times of Elvis, which the court described as follows:

The biography itself is indeed exhaustive. The producers interviewed over 200 people regarding virtually all aspects of Elvis' life. The documentary is divided into 16 one-hour episodes, each with its own theme. For example, one episode is entitled “The Army Years,” whereas another—“The Spiritual Soul of Elvis”—chronicles . . . religious themes . . .

The Definitive Elvis uses Plaintiffs' copyrighted materials in a variety of ways. With the video footage, the documentary often uses shots of Elvis appearing on television while a narrator or interviewee talks over the film. These clips range from only a few seconds in length to portions running as long as 30 seconds. In some instances, the clips are the subject of audio commentary, while in other instances they would more properly be characterized as video “filler” because the commentator is discussing a subject different from or more general than

⁴⁰ *Id.* at 494.

⁴¹ *Id.* at 494–95.

⁴² *Id.* at 495.

⁴³ *Id.* at 495–96.

⁴⁴ 349 F.3d 622 (9th Cir. 2003).

⁴⁵ 146 F. Supp. 2d 442 (S.D.N.Y. 2001).

Elvis' performance on a particular television show. But also significant is the frequency with which the copyrighted video footage is used. *The Definitive Elvis* employs these clips, in many instances, repeatedly. In total, at least 5% to 10% of *The Definitive Elvis* uses Plaintiffs' copyrighted materials.

Use of the video footage, however, is not limited to brief clips. In several instances, the audio commentary discusses Elvis' appearance on a show and then, without additional voice-over, a clip is played from the show featuring Elvis. For example, one excerpt from *The Steve Allen* show plays continuously for over one minute without interruption. This excerpt includes the heart of Elvis' famous "Hound Dog" appearance on *The Steve Allen* show.

In the aggregate, the excerpts comprise a substantial portion of Elvis' total appearances on many of these shows. For example, almost all of Elvis' appearance on *The Steve Allen Show* is contained in *The Definitive Elvis*. Thirty-five percent of his appearances on *The Ed Sullivan Show* is replayed, as well as three minutes from *The 1968 Comeback Special*.

The use of Plaintiffs' copyrighted still photographs and music is more subtle and difficult to spot. The photographs are used in a way similar to some of the video footage: the photograph is displayed as video filler while a commentator discusses a topic. The photographs are not highlighted or discussed as objects of the commentary like many of the video pieces are. Finally, the songs are played both as background music and in excerpts from Elvis' concerts, television appearances, and movies.⁴⁶

As may be imagined, the court was not impressed with the defendant's fair use arguments under the various Section 107 factors. At the outset, in connection with the first statutory factor, the filmmakers' uses were deemed preponderantly non-transformative.⁴⁷ The court pointed to some instances of transformative use where "the clips play for only a few seconds and are used for reference purposes while a narrator talks over them or interviewees explain their context in Elvis' career;" but other "clips are played without much interruption, if any," and indicated that "[t]he purpose of showing these clips likely goes beyond merely making a reference for a biography, but instead serves the same intrinsic entertainment value that is protected by Plaintiffs' copyrights."⁴⁸

With this out of the way, the statutory fair use factors began to pile up against the defendants: many of the works quoted were creative in nature rather than merely factual, and too many of the defendant's uses involved unnecessarily long quotations, repetitions of shorter ones, or quotations that represented the "heart" of

⁴⁶ *Elvis Presley Enters.*, 349 F.3d at 625.

⁴⁷ *Id.* at 628-29.

⁴⁸ *Id.*

the copyrighted work—"Elvis' appearance on the shows, in many cases singing the most familiar passages of his most popular songs."⁴⁹ Finally, and fatally, the appeals court saw no reason to upset the trial judge's decision that, where the fourth factor was concerned:

Passport's use is commercial in nature, and thus we can assume market harm. Second, Passport has expressly advertised that *The Definitive Elvis* contains the television appearances for which Plaintiffs normally charge a licensing fee. If this type of use became wide-spread, it would likely undermine the market for selling Plaintiffs' copyrighted material. This conclusion, however, does not apply to the music and still photographs. It seems unlikely that someone in the market for these materials would purchase *The Definitive Elvis* instead of a properly licensed product. Third, Passport's use of the television appearances was, in some instances, not transformative, and therefore these uses are likely to affect the market because they serve the same purpose as Plaintiffs' original works.⁵⁰

Although the details of this market analysis are subject to some doubt, the more general message of the court of appeals' opinion is clear: once the defendant had lost the battle over "transformativeness," the factorial analysis lines up neatly in the plaintiffs' favor.⁵¹

Hofheinz presents a very different picture. In a suit brought by the widow of one of the principals of American International Pictures, the court ruled that unauthorized inclusion of copyrighted film clips from *It Conquered the World* in an A&E biography about the career of actor Peter Graves was protected fair use because they were "not shown to recreate the creative expression reposing in plaintiff's [copyrighted] film, [but] for the transformative purpose of enabling the viewer to understand the actor's modest beginnings in the film business."⁵² Once this was established, the other factors weighed, overall, in the defendants' favor.⁵³

⁴⁹ *Id.* at 630.

⁵⁰ *Id.* at 631.

⁵¹ Another recent example of a nonfiction filmmaker who went "over the top" and forfeited the ability to rely on fair use can be found in *Video-Cinema Films, Inc. v. Lloyd E. Rigler-Lawrence E. Deutsch Found.*, No. 04 Civ. 5332(NRB), 2005 WL 2875327, at *1 (S.D.N.Y. Nov. 2, 2005). In the case, the defendant's *Classic Arts Showcase* program for public television consisted of a miscellaneous collection of clips showing famous performances by musicians, dancers and so forth, intended to whet viewers' interest in the fine arts. *Id.* Included among the quoted materials were excerpts from a movie, *Carnegie Hall*, that the plaintiff company licenses for TV and home video distribution. *Id.* Finding that the inclusion of the clip was "non-transformative," the court then made relatively short work of the remaining statutory factors. *Id.* at *7-8.

⁵² *Hofheinz v. A&E Television Networks*, 146 F. Supp. 2d 442, 446-47 (S.D.N.Y. 2001).

⁵³ *Id.* at 447-49.

Where the fourth factor was concerned, the court held that “[t]he proper question is whether the Graves biography was, in effect, a substitute for Hofheinz’s film clips”—not whether she stood to lose licensing revenue if the fair use defense was upheld.⁵⁴ The fact that the filmmakers might have licensed the clip rather than appropriating it was not, in itself, enough: “Plaintiff may not bootstrap the specter of a fair use holding against her here, on the facts of this case, as reason why the use is not a fair use to begin with.”⁵⁵

The analysis applied in *Hofheinz v. A&E Television Networks* was based, in large part, on the opinion in another of the *Hofheinz* trilogy, *Hofheinz v. AMC Productions, Inc.*⁵⁶ The discussion of the film clips from *It Conquered the World* found in *Hofheinz v. A&E Television Networks*, in turn, prefigured the outcome in the last of these cases, *Hofheinz v. Discovery Communications, Inc.*,⁵⁷ decided late in 2001, in which a fair use defense was validated in connection with the use of a clip from *Invasion of the Saucer Men* in a Learning Channel program entitled *Aliens Invade Hollywood*.⁵⁸

The copyright lawyer who experienced a dearth of success in the *Hofheinz* cases returned to the fray on behalf of a different client several years later, still on the trail of unauthorized clips of Hollywood aliens. This time, *Good Morning America* used clips from *Robot Monster*, *The Brain from Planet Arous*, and *Plan 9 from Outer Space* in segments about the American fascination with extraterrestrials. The clips illustrated presenter Joel Siegel’s theme that “big or small, cute or icky, alien life as portrayed in pop culture inevitably shares some humanlike traits.”⁵⁹ It is hardly a surprise, at this point, that the fact of this recontextualization was enough to demonstrate the transformativeness of the use. Further, the court specifically rejected the argument that uses cannot be both transformative and entertaining.⁶⁰ It quoted the judge in the final *Hofheinz* case⁶¹ and went on to cite various heavy-duty authorities for declining to parse this illusive distinction.⁶²

Three lawsuits surrounding the famous footage of the beating of truck driver Reginald Denny near the intersection of Florence and Normandie during the 1992 Los Angeles riots further illustrate the use of transformativeness in judicial decisions, although they do not involve documentary film production as such. The Los Angeles News Service, an independent provider of news footage to TV

⁵⁴ *Id.* at 449.

⁵⁵ *Id.*

⁵⁶ 147 F. Supp. 2d 127 (E.D.N.Y. 2001).

⁵⁷ No. 00 Civ. 3802(HB), 2001 WL 1111970, at *1 (S.D.N.Y. Sept. 20, 2001).

⁵⁸ *Id.*

⁵⁹ *Id.* at *1–2.

⁶⁰ *Id.* at *9.

⁶¹ “Section 107 does not explicitly distinguish between entertaining and serious, plausible and implausible, or weighty or frivolous commentaries, and I do not propose to engage in such subjective line-drawing.” *Id.* (quoting *Hofheinz v. Discovery Commc’ns Inc.*, No. 00 Civ. 3802(HB), 2001 WL 1111970, at *4 (S.D.N.Y. Sept. 20, 2001)).

⁶² *Id.*

stations and other outlets, brought suit against television stations for the unauthorized use of their footage. Two of these cases, *Los Angeles News Service v. KCAL-TV*,⁶³ and *Los Angeles News Service v. Reuters Television International, Ltd.*,⁶⁴ involved unlicensed broadcast of the footage while it still had considerable “hot news” value.⁶⁵ At base, the court’s skepticism about these defendants’ fair use defenses reflected the fact that the footage in question was being reused to fulfill the very purpose for which it originally had been captured—to serve news reporting—rather than in some more “transformative” way.⁶⁶

By contrast, when Los Angeles News Service sued Court TV, some months later, for using

a few seconds of footage from “Beating of Reginald Denny,” primarily the frames depicting Damien Williams throwing a brick at Denny’s head, in on-air “teaser” spots promoting its coverage of the trial [of the assailants and] incorporat[ing] the brick-throwing footage into the introductory montage for its show “Prime Time Justice,” which used a stylized orange clock design superimposed over a grainy, tinted, monochromatic video background [that] changed as the “hands” of the clock revolved, [with] LANS’s copyrighted video was in the background for a couple of seconds, one 360 degree sweep of the clock.⁶⁷

Working its way through the fair use factors, the federal appeals court concluded that while the quotations in “teasers” were not transformative, the more “commercially exploitive” incorporation of the footage into the *Prime Time Justice* introduction did include “the element of creativity beyond mere publication, and it serves some purpose beyond newsworthiness.”⁶⁸ The court went on to note that the highly factual nature of the footage pointed “clearly” toward fair use, and that the amount of material used was small, expressing skepticism that brief excerpts could be considered “the heart of the work.”⁶⁹ Finally, the court found that there was little chance that Court TV’s uses (or others like them) would harm the licensing market for longer clips—which was, after all, the Los Angeles News Service’s core business.⁷⁰ Despite the court’s equivocation on the issue of “transformativeness,” what seems to have carried the day was its conviction that Court TV’s uses were somehow out of the ordinary.⁷¹

The *Wade Williams* and *CBS Broadcasting* decisions serve as perhaps the best evidence of how far the federal courts have gone to create a generally hospitable

⁶³ 108 F.3d 1119 (9th Cir. 1997).

⁶⁴ 149 F.3d 987 (9th Cir. 1998).

⁶⁵ *KCAL-TV*, 108 F.3d at 1120; *Reuters Television*, 149 F.3d at 990.

⁶⁶ *KCAL-TV*, 108 F.3d at 1121–22; *Reuters Television*, 149 F.3d at 993–94.

⁶⁷ *L.A. News Serv. v. CBS Broad., Inc.*, 305 F.3d 924, 929–30 (9th Cir. 2002).

⁶⁸ *Id.* at 939.

⁶⁹ *Id.* at 942.

⁷⁰ *Id.* at 940–41.

⁷¹ *Id.* at 942.

space for nonfiction filmmaking and related media activities through their application of the fair use doctrine. Even where the quotation of existing copyright content is done as much to amuse as to enlighten, or for a promotional purpose, the fact that it has been “transformed” through repurposing weighs heavily in favor of a fair use finding—at least where the quotation is not overly extensive.

In principle, at least, similar results might be expected where quotations are used in fiction films. In practice, it is difficult to be so confident. The fair use cases involving appropriation of preexisting copyrighted elements in narrative films are fewer—too few, in fact, to form anything resembling a pattern. One decision sometimes mentioned in this connection, *Sandoval v. New Line Cinema Corp.*, actually avoids the issue of fair use in assessing a copyright challenge to the motion picture *Seven*.⁷² Instead, the court finds that fleeting glimpses of the plaintiff photographer’s images in the background of a scene in which detectives search a suspect’s apartment are too trivial to constitute even potential infringements.⁷³ The previous year in *Ringgold v. Black Entertainment Television, Inc.*, another appeals court criticized a trial court’s prior finding that an artist’s poster used as set decoration in a television situation comedy constituted fair use.⁷⁴ The main ground for skepticism was the lack of transformativeness: “Ringgold’s work was used by defendants for precisely the decorative purpose that was a principal reason why she created it.”⁷⁵ In contrast, in *Jackson v. Warner Bros., Inc.* several of the plaintiff’s appropriately themed paintings decorated a set representing the apartment of a principal character in the film *Made In America*, and the court found fair use.⁷⁶

These cases are too scattered and too disparate in both outcome and analytic approach to offer any real guidance, going forward, to narrative filmmakers. And while the cases involving documentary filmmaking are sufficiently numerous and consistent to suggest a pattern, a problem remains: although the documentary cases cover a fairly wide range of different specific filmmaking practices, they by no means exhaust the list of situations in which a documentary producer might wish to rely on fair use. They illustrate a mode of analysis, and suggest a considerable judicial bias in favor of enabling documentarians access to preexisting copyrighted material. But they leave many questions unanswered—as does any set of legal precedents applying a principle of general applicability—like negligence in tort or self-defense in criminal law, to specific circumstances.

⁷² 147 F.3d 215, 218 (9th Cir. 1998).

⁷³ *Id.*

⁷⁴ 126 F.3d 70, 78 (2d Cir. 1997).

⁷⁵ *Id.* at 78 n.8.

⁷⁶ 993 F. Supp. 585, 592 (E.D. Mich. 1997). The outcome appears to have been influenced, in some degree, by the fact that the plaintiff’s objections to the use were primarily ideological rather than economic. *Id.* at 591. Fair use also provides a secondary rationale for the court’s finding of noninfringement in *Amsinck v. Columbia Pictures Indus.*, 862 F. Supp. 1044, 1046, 1048 (S.D.N.Y. 1994), where plaintiff’s “Baby Bears” hanging mobile was used as set décor in the film *Immediate Family*.

V. THE CRITIQUE OF FAIR USE

The notoriously fact-specific nature of fair use analysis recently led some of the foremost advocates of greater openness in the copyright system to raise questions about the doctrine's utility. Thus, for example, Professor Lawrence Lessig has argued that fair use doesn't strike an adequate balance in copyright law. The statutory formulation, he asserts, is too vague and open-ended to be relied upon effectively; its real utility is severely limited because fair use claims can be tested only after the fact of use and then only when a creator relying on the doctrine is able to retain legal counsel and willing to expose himself or herself to considerable economic risk in the event that the defense fails.⁷⁷ Professor David Lange, in turn, has speculated about the possibility of new legislation that would supplant fair use and lighten the burden of copyright clearance on documentary filmmakers by providing them with a special compulsory license.⁷⁸

But however reasonable and unthreatening proposals like Professor Lange's may be, in fact, there is little likelihood that the motion picture and music industries, which exercise considerable sway in these matters, would tolerate their enactment. Fair use, as the law summarized above now stands, actually offers filmmakers and other creators of media considerable latitude for creative practice. But the critique of fair use as being too vague and unreliable to be of much practical use has achieved considerable currency, and it operates to discourage media practitioners, their lawyers, and their so-called "gatekeepers," including distributors, broadcasters, insurers, and others from relying on the doctrine. What can be done to address it, and to encourage filmmakers to take advantage of their fair use rights?

VI. THE STRUCTURAL MEANING OF THE FAIR USE CASES

Fair use challenges filmmakers, as well as other practice communities, to find ways of making this powerful but elusive doctrine more transparent and predictable. The key to meeting this challenge can be found in the passage of Professor Latman's historical study, quoted earlier in this essay: "Justification for a reasonable use of a copyrighted work is also said to be based on custom."⁷⁹ In

⁷⁷ See generally LAWRENCE LESSIG, *FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY* 116-68 (2004) (describing how copyright law has changed from traditional regulation of commercial copying to regulation of private copying, creativity, and transformation). These themes are developed at greater length in Professor Lessig's testimony to the House of Representatives. *Testimony on The Digital Media Consumers' Rights Act of 2003: Hearing on H.R. 107 Before the Subcomm. on Commerce, Trade, and Consumer Protection*, 108th Cong. 15-22 (2004) (statement of Lawrence Lessig, Professor, Stanford Law School).

⁷⁸ See the webcast of the April 2, 2004 legal panel from the "Full Frame" conference, available at <http://www.law.duke.edu/framed/> (follow link titled "Culture on the Legal Cutting Room Floor").

⁷⁹ See LATMAN, *supra* note 16, at 785.

other words, courts engaged in fair use decision-making should care about evidence of what is considered “reasonable” and “customary” within the relevant practice communities. Before the enactment of Section 107, case law offered various examples of this approach.⁸⁰ These cases included several instances in which customary practice was explicitly considered.⁸¹

Fair use discourse shifted after the enactment of Section 107, and for a time the customary roots of the doctrine were obscured. Scholars sought coherence elsewhere, particularly in utilitarian economic analysis.⁸² Other commentators expressed pessimism whether fair use analysis, which depends on a “calculus of incommensurables,” could ever be rationalized or made more predictable.⁸³ Although the Supreme Court, in 1985, acknowledged the connection between custom and fair use,⁸⁴ many lower courts temporarily lost sight of this dimension of the doctrine, turning their attention instead to the factoral analysis apparently privileged by the statute.⁸⁵ And, as we have seen, their opinions came to focus increasingly on the issue of “transformativeness.”

As Michael Madison has convincingly demonstrated, however, the link between fair use and custom never really was severed—only temporarily overlooked:

I suggest . . . that the contemporary focus on “case-by-case adjudication of fair use disputes misunderstands the properly contextual orientation of fair use decision making as it developed historically, as Congress understood it when it enacted the fair use statute, and as the statute actually has been applied over the last twenty-five years.”⁸⁶

⁸⁰ See generally Harry Rosenfeld, *Customary Use as “Fair Use” in Copyright Law*, 25 BUFF. L. REV. 119 (1975) (stating that where applicable, custom is per se “Fair Use”).

⁸¹ See, e.g., *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303, 307 (2d Cir. 1966) (unauthorized biography of Howard Hughes). In 1973, the United States Court of Claims held that handwritten copies of text materials by scholars represented fair use since they were “customary facts of copyright-life.” *Williams & Wilkins Co. v. United States*, 487 F.2d 1345, 1350 (Ct. Cl. 1973). This mode of analysis is also employed after 1978, as demonstrated by *Maxtone-Graham v. Burtchaell*, 803 F.2d 1253, 1263 (2d Cir. 1986) (reaffirming that it is “both reasonable and customary for biographers to refer to and utilize earlier works” (quoting *Rosemont Enters.*, 366 F.2d at 307)).

⁸² Wendy Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors*, 82 COLUM. L. REV. 1600, 1631 (1982); William W. Fisher III, *Reconstructing the Fair Use Doctrine*, 101 HARV. L. REV. 1659, 1698–1700 (1988).

⁸³ Lloyd L. Weinreb, *Fair Use*, 67 FORDHAM L. REV. 1291, 1306 (1999).

⁸⁴ *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 550–51 & n.4 (1985).

⁸⁵ That this trend may have run its course is suggested by the discussion of custom in a 2006 Ninth Circuit Court of Appeals decision, *Wall Data, Inc. v. L.A. County Sheriff’s Department*, 447 F.3d 769, 778 (9th Cir. 2006).

⁸⁶ Michael J. Madison, *A Pattern-Oriented Approach to Fair Use*, 45 WM. & MARY L. REV. 1525, 1587 (2004).

Professor Madison argues that as courts explore the four factors and ponder degrees and kinds of “transformativeness,” they are in fact seeking to ascertain whether the challenged work fits within a privileged use category, or on the other hand, whether an invocation of fair use is merely an infringer’s attempt to dress its unjustifiable appropriations in borrowed plumage.⁸⁷ Thus, Madison points out, the very first fair use decision, *Folsom v. Marsh* of 1841, involved a judicial effort to distinguish between true biographical scholarship and simple free-riding.⁸⁸ Likewise, the focus of the Supreme Court’s celebrated 1994 “2 Live Crew” decision was whether the allegedly infringed song was a genuine parody or a mere effort to capitalize on the fame of the plaintiff’s song.⁸⁹ By the same token, in many of the cases involving nonfiction filmmakers reviewed above, the underlying issue was whether the challenged production was actually a documentary, or merely an entertainment film in disguise. And in the handful of cases involving narrative filmmaking, a recurrent question is whether the reproductions of defendants’ artistic creations were actually part of the film’s decorative background—or something more. Such inquiries, although currently conducted using the vocabulary of Section 107, always involve—at bottom—a comparison between the practices of a defendant and the norm or pattern of use with which he seeks to affiliate. And the best way to determine whether, in Madison’s terms, a genuine “patterned” use is involved is to look, in one way or another, to common or customary practice in whatever the field of practice may be.⁹⁰

In a recent article, James Gibson has extended this analysis, warning of a possible vicious circle in fair use jurisprudence.⁹¹ Documenting the extent to which custom and practice are, and long have been, touchstones for fair use analysis, he goes on to make a further point: when users are excessively conservative in their practices, choosing to license rights even when they do not have a legal obligation to do so, the result of this timidity may eventually be a recalibration of the law itself towards a less permissive setting.⁹² He points out that such failures to assert fair use are often the result of constraints imposed on users by various “gatekeepers”—including broadcasters, distributors and especially insurers.⁹³ In effect, Gibson reminds us that the watchword for fair use is “use it or lose it,” as he

⁸⁷ *Id.* at 1586–88.

⁸⁸ *Id.* at 1557.

⁸⁹ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 574 (1994).

⁹⁰ *See* Madison, *supra* note 86, at 1631.

⁹¹ James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 *YALE L.J.* 882, 896 (2007).

⁹² *Id.* at 896–906. Gibson assembles powerful support for the proposition that customary usage matters in fair use determinations, although his claim that customs with respect to licensing practice have long been singled out for special attention is less well documented. *See, e.g.*, RICHARD C. DEWOLF, *AN OUTLINE OF COPYRIGHT LAW* 143 (1925) (discussing possible market substitution effects without mention of licensing as such); *Shapiro, Bernstein & Co. v. P.F. Collier & Son Co.*, 26 U.S.P.Q. (BNA) 40, 42 (S.D.N.Y. 1934) (discussing same, with additional analysis of custom in general).

⁹³ Gibson, *supra* note 91, at 896–906.

points to a problem of negative reinforcement that has been aggravated greatly, and deliberately, by the practices of large copyright holders.⁹⁴

What then, can we make of these central perceptions into the real inner workings of fair use jurisprudence? The answer, I would suggest, is that collective action offers members of various practice communities a chance to affect the way in which the law, as applied to them, is understood.⁹⁵ The effectiveness of the approach was tested more than a decade ago by the Society for Cinema and Media Studies (SCMS). In 1993, with the help of several experts including myself, the SCMS developed a best-practices code for its members concerning use of stills and frame grabs from films in academic literature.⁹⁶ Ever since, this code has effectively reduced costs and facilitated publication for many film scholars. Recently, the model has been extended to the field of documentary filmmaking practice.

VII. STATEMENTS OF BEST PRACTICES—PROCESSES AND PRODUCTS

*The Documentary Filmmakers' Statement of Best Practices in Fair Use*⁹⁷ (“*Statement*”) is a testament to the power of collective self-help and accessible scholarship. Documentary filmmakers, acting through their organizations and with coordination and support from academics at American University, have asserted common principles for the application of fair use under copyright. In so doing, they have made fair use—the right to quote copyrighted material without permission or payment, under certain circumstances—far more widely available. This has made films that formerly would have been treated as too risky for broadcast—such as controversial works of social or media criticism or certain historical documentaries—available to viewers today. The filmmakers’ example is one that many other creators’ organizations can profit from and emulate.

Documentary filmmakers had found themselves increasingly hemmed in by ever more owner-friendly copyright law, especially as the term of copyrights was repeatedly extended. At this point, the bulk of surviving films and other works made after 1923 are copyrighted, along with practically all expression created since 1978, including poems and grocery lists; therefore copyright protection is the default setting. A 2004 study of current documentary filmmaking practice in

⁹⁴ *Id.* at 895.

⁹⁵ Gibson suggests that self-help may be futile because doctrinal feedback “takes place regardless of . . . whether copyright users want to do something about it” *Id.* at 906. But if “doing something” includes changing the conduct that gives rise to feedback, it is not clear why this need be so. The actual experience of documentary filmmakers, as described below, appears to indicate otherwise.

⁹⁶ See Kristin Thompson, *Report of the Ad Hoc Committee of the Society For Cinema Studies, 'Fair Usage Publication of Film Stills,'* 32 CINEMA J. 3 (1993).

⁹⁷ ASSOCIATION OF INDEPENDENT VIDEO AND FILMMAKERS ET AL., DOCUMENTARY FILMMAKERS’ STATEMENT OF BEST PRACTICES IN FAIR USE (2005), available at http://www.centerforsocialmedia.org/resources/publications/statement_of_best_practices_in_fair_use/. Excerpts from the *Statement* appear as an Appendix to this Article.

copyright clearance, *Untold Stories*, conducted by Professor Patricia Aufderheide of the School of Communication at American University, along with the present author, documented the creative costs of the “clearance culture.”⁹⁸ For instance, documentary filmmakers changed the reality they filmed during shooting by instructing subjects to turn off the television so as to avoid incidental capture of copyrighted media. They also changed their films in post-production by editing sounds and images to avoid perceived copyright clearance problems. Further, they suffered both financial uncertainty and high prices. Worst of all, they avoided topics that might involve overly complex clearance problems, including social criticism, musical documentaries, and a wide range subjects involving historical footage. “I tell people not to make historical films,” said Robert Stone.⁹⁹

Of the many possible solutions to the crisis in copyright clearance, filmmakers themselves could address fair use. As noted above, courts respect the views of practice communities about what constitutes reasonable and appropriate use of copyrighted materials.¹⁰⁰ But filmmakers interviewed for *Untold Stories* found themselves unable to say what was appropriate because they did not know what the consensus of their peers was on how to fairly and reasonably interpret the law.¹⁰¹ To help filmmakers to establish such a consensus, Aufderheide and I worked with five filmmaker organizations: Association of Independent Video and Filmmakers, Independent Feature Project, International Documentary Association, National Alliance for Media Arts and Culture, and Women in Film and Video, Washington, D.C. Chapter.¹⁰² In thirteen meetings, including ten small group meetings hosted by the various professional organizations, the scholars worked with veteran professional filmmakers to articulate principles, and limitations on those principles, for the application of fair use.¹⁰³ In these conversations, documentarians wrestled to define both what their own needs were to quote others’ material without permission or payment, and what they thought would be acceptable, were someone to quote their own material without authorization.¹⁰⁴

The *Statement*¹⁰⁵ deals with four recurrent situations in documentary filmmaking practice: quotation of copyrighted material for purposes of critique; quotations of popular culture to illustrate an argument; incidental capture of media

⁹⁸ PATRICIA AUFDERHEIDE & PETER JASZI, *UNTOLD STORIES: CREATIVE CONSEQUENCES OF THE RIGHTS CLEARANCE CULTURE FOR DOCUMENTARY FILMMAKERS* (2004), available at http://www.centerforsocialmedia.org/files/pdf/UNTOLDSTORIES_Report.pdf.

⁹⁹ *Id.* Robert Stone is a documentary filmmaker whose titles include the film *American Babylon*, as well as *American Experience* episodes “Radio Bikini,” “Satellite Sky,” and “Guerrilla: The Taking of Patty Hearst.”

¹⁰⁰ See Rosenfeld, *supra* note 80, at 133–37.

¹⁰¹ AUFDERHEIDE & JASZI, *supra* note 98, at 22–25.

¹⁰² ASSOCIATION OF INDEPENDENT VIDEO AND FILMMAKERS, *supra* note 97, at 1.

¹⁰³ *Id.* at 3–6.

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* 3–4.

content in documenting the lives of a film's subjects;¹⁰⁶ and the use of copyrighted material in historical narrative.¹⁰⁷ The treatment of the latter topic emerged out of a rich and difficult discussion among the documentarians; not only did the filmmakers respect the importance of archival activities—and understand the importance of compensating them—but they were quick to see that today's documentaries are tomorrow's archival footage.¹⁰⁸ At the same time, they were outraged by, for example, CSPAN's refusal to release some presidential and Congressional material, and the arbitrary licensing practices of some private archives.¹⁰⁹ The *Statement* carefully balances these various concerns. It declares that filmmakers in general should clear historical archive material, unless it is impossible or the terms are extortionate.¹¹⁰ If it is still imperative to use the material—which is not the primary subject of the documentary—then the filmmaker must use only as much as is needed to make the point, and should credit the source.¹¹¹

The balanced nature of the *Statement*, as the product of a community with stakes both in maintaining copyright and allowing for reasonable levels of access to protected material, has made the document powerfully persuasive. Following its release on November 18, 2005, the *Statement* had an immediate effect. It was used by three filmmakers to justify inclusion of their films at the Sundance Film Festival only eight weeks later, including Kirby Dick (*This Film Is Not Yet Rated*), Ricki Stern and Annie Sundberg (*The Trials of Darryl Hunt*), and Byron Hurt (*Hip-Hop: Beyond Beats & Rhymes*).¹¹² In *The Trials of Darryl Hunt*, for example, the filmmakers had followed, and helped to organize, protests in a racially-charged death penalty case, and then chronicled the eventual proof that the accused was

¹⁰⁶ *Id.* at 3–5. This is an issue that was of great concern to documentary filmmakers working in the *cinema verité* mode. The conclusion arrived at by the filmmakers in the *Statement* appears to be entirely consistent with the first principles of fair use articulated by the courts and Congress. Although Professor Gibson suggests that the case law on the question is divided, see Gibson, *supra* note 91, at 890 n.16, 906 n.89, the reality is that it has simply gone unaddressed, with the singular exception of *Shapiro, Bernstein & Co. v. P.F. Collier & Son Co.*, 26 U.S.P.Q. 40, 43 (S.D.N.Y. 1934) (dictum on incidental capture by *still* photographer as fair use). The other cases cited by Gibson involve the purposeful, chosen use of copyrighted material in the backgrounds of fiction film sequences, not the incidental capture of existing media content by documentarians.

¹⁰⁷ Of course, as the *Statement* itself makes clear, the articulation of these consensus principles is not intended to foreclose the assertion of fair use by filmmakers in other situations. ASSOCIATION OF INDEPENDENT VIDEO AND FILMMAKERS, *supra* note 97, at 3–4.

¹⁰⁸ *Id.* at 3–4.

¹⁰⁹ *Id.*

¹¹⁰ *Id.*

¹¹¹ *Id.*

¹¹² CENTER FOR SOCIAL MEDIA, SUCCESS OF THE STATEMENT OF BEST PRACTICES 1 (2005), http://www.centerforsocialmedia.org/files/pdf/success_of_the_statement.pdf.

innocent.¹¹³ Archival footage had been used with the permission of the local broadcast station, but when news station leadership saw the potential of making their own documentary, this permission suddenly was withdrawn.¹¹⁴ The filmmakers stood on the ground of fair use to use archival broadcast news footage in their film.¹¹⁵

Within four weeks of the *Statement's* release, Aufderheide and I hosted a meeting with broadcast and cable executives. This meeting precipitated a decision by the Independent Feature Channel (IFC) to create an internal fair use policy allowing it to clear the cablecast of *This Film Is Not Yet Rated*, which includes more than one hundred uncleared quotes from popular recent films as part of a critique of the MPAA rating system. IFC also saved hundreds of thousands of dollars by relying on fair use to reduce clearance claims for a documentary about road movies, *Wanderlust*.¹¹⁶ By April 2006, the Public Broadcasting Service (PBS) accepted the applicability of fair use to *Hip-Hop: Beyond Beats & Rhymes*, which quotes substantial amounts of music and video in its argument that hip-hop had become a celebration of misogyny and violence.¹¹⁷ Moreover, PBS shared the *Statement* with all general managers and general counsels in its network.¹¹⁸

Perhaps the most powerful evidence of the transformation that the *Statement* has helped to work is that four of the seven insurers who offer errors and omissions insurance to filmmakers are now offering to cover fair use claims, and others may soon follow.¹¹⁹ It took insurers, cautious by nature, some eighteen months to reconsider their practice in the light of a consensus document that dramatically lowered risk.¹²⁰ At least where documentary filmmaking is concerned, the vicious circle of which Professor Gibson warns¹²¹ may have been replaced by a “virtuous circle.”

Film professors also have become activists for the expanded freedom of expression that the *Statement* permitted. The University Film and Video Association sponsored an award for the best use of fair use in a student and/or

¹¹³ Patricia Aufderheide, *How Documentary Filmmakers Overcame Their Fear of Quoting and Learned to Employ Fair Use: a Tale of Scholarship in Action*, 1 INT'L J. OF COMM. 26, 33–34 (2007), available at <http://ijoc.org/ojs/index.php/ijoc/article/view/10/26>.

¹¹⁴ *Id.*

¹¹⁵ *See id.*

¹¹⁶ *See* Elaine Dutka, *Legendary Film Clips: No Free Samples?*, N.Y. TIMES, May 28, 2006, § 2, at 16.

¹¹⁷ *See* CENTER FOR SOCIAL MEDIA, *supra* note 112, at 1; *HIP-HOP: Beyond Beats & Rhymes* (PBS Independent Lens premier Feb. 20, 2007).

¹¹⁸ CENTER FOR SOCIAL MEDIA, *supra* note 112, at 1.

¹¹⁹ *Id.* *See also* the postings for February 13, 2007 (“Insurer accepts fair use claims!”) and February 24, 2007 (“MediaPro also uses Fair Use Best Practices Statement for insurance policies”), on the “Beyond Broadcast Blog,” http://www.centerforsocialmedia.org/blogs/future_of_public_media/.

¹²⁰ CENTER FOR SOCIAL MEDIA, *supra* note 112, at 1.

¹²¹ *See* Gibson, *supra* note 91, at 896.

professor's work.¹²² In addition, teachers began using the Center for Social Media's Fair Use Teaching Tools, including a DVD that provides core teaching materials on fair use.¹²³

Other creator groups also began to organize to emulate the best-practices model. Music educators, media literacy practitioners, and art historians began the process of assessing problems in their communities and establishing peer groups among professionals to deliberate common values.¹²⁴ In her 2006 book, *Permissions, A Survival Guide: Blunt Talk About Art as Intellectual Property*, veteran publisher Susan Bielstein warmly endorses the potential of the best practices approach.¹²⁵

The Documentary Filmmakers' Statement of Best Practices in Fair Use has begun to change practices and expand possibilities in many areas of media-making and scholarship.¹²⁶ It is part of a contemporary movement to reclaim the copyright system for the public—its original intended beneficiary. Responsibility for realizing the potential of the approach exemplified by the *Statement* now lies with teachers, students and practitioners themselves.

¹²² See Center for Social Media Newsletter, News from the Fair Use Project (Feb. 2, 2006), http://www.centerforsocialmedia.org/newsletter/entry/february_events_and_new/#.

¹²³ See http://centerforsocialmedia.org/resources/fair_use_teaching_tools/.

¹²⁴ See, e.g., RENEE HOBBS, PETER JASZI & PAT AUFDERHEIDE, CENTER FOR SOCIAL MEDIA, THE COSTS OF COPYRIGHT CONFUSION FOR MEDIA LITERACY 21–22 (2007), available at http://www.centerforsocialmedia.org/files/pdf/Final_CSM_copyright_report.pdf.

¹²⁵ See SUSAN M. BIELSTEIN, PERMISSIONS, A SURVIVAL GUIDE: BLUNT TALK ABOUT ART AS INTELLECTUAL PROPERTY 4–5 (2006).

¹²⁶ For a further discussion of the *Statement* and its background, see Paige Gold, *Fair Use and the First Amendment: Corporate Control of Copyright is Stifling Documentary Making and Thwarting the Aims of the First Amendment* (bepress Legal Series, Working Paper No. 950, 2006), available at <http://law.bepress.com/cgi/viewcontent.cgi?article=4599&context=expresso>.

APPENDIX

[An excerpt from the *Documentary Filmmakers' Statement of Best Practices on Fair Use*]¹²⁷

This statement recognizes that documentary filmmakers must choose whether or not to rely on fair use when their projects involve the use of copyrighted material. It is organized around four classes of situations that they confront regularly in practice. (These four classes do *not* exhaust all the likely situations where fair use might apply; they reflect the most common kinds of situations that documentarians identified at this point.) In each case, a general principle about the applicability of fair use is asserted, followed by qualifications that may affect individual cases.

**ONE: EMPLOYING COPYRIGHTED MATERIAL AS THE OBJECT OF SOCIAL,
POLITICAL OR CULTURAL CRITIQUE**

Description: This class of uses involves situations in which documentarians engage in media critique, whether of text, image or sound works. In these cases, documentarians hold the specific copyrighted work up for critical analysis.

Principle: Such uses are generally permissible as an exercise of documentarians' fair use rights. This is analogous to the way that (for example) a newspaper might review a new book and quote from it by way of illustration. Indeed, this activity is at the very core of the fair use doctrine as a safeguard for freedom of expression. So long as the filmmaker analyzes or comments on the work itself, the means may vary. Both direct commentary and parody, for example, function as forms of critique. Where copyrighted material is used for a critical purpose, the fact that the critique itself may do economic damage to the market for the quoted work (as a negative book review could) is irrelevant. In order to qualify as fair use, the use may be as extensive as is necessary to make the point, permitting the viewer to fully grasp the criticism or analysis.

Limitations: There is one general qualification to the principle just stated. The use should not be so extensive or pervasive that it ceases to function as critique and become, instead, a way of satisfying the audience's taste for the thing (or the kind of thing) critiqued. In other words, the critical use should not become a market substitute for the work (or other works like it).

¹²⁷ ASSOCIATION OF INDEPENDENT VIDEO AND FILMMAKERS, *supra* note 97, at 3–6.

TWO: QUOTING COPYRIGHTED WORKS OF POPULAR CULTURE TO ILLUSTRATE AN ARGUMENT OR POINT

Description: Here the concern with material (again of whatever kind) that is quoted not because it is, in itself, the object of critique, but because it aptly illustrates some argument or point that a filmmaker is developing—as clips from fiction films might be used (for example) to demonstrate changing American attitudes toward race.

Principle: Once again, this sort of quotation should generally be considered as fair use. The possibility that the quotes might entertain and engage an audience as well as to illustrate a filmmaker's argument takes nothing away from the fair use claim. Works of popular culture typically have illustrative power, and in analogous situations, writers in print media do not hesitate to use illustrative quotations (both words and images). In documentary filmmaking, such a privileged use will be both subordinate to the larger intellectual or artistic purpose of the documentary and important to its realization. The filmmaker is not presenting the quoted material for its original purpose but harnessing it for a new one. This is an attempt to add significant new value, not a form of "free riding"—the mere exploitation of existing value.

Limitations: Documentarians will be best positioned to assert fair use claims if they assure that:

- the material is properly attributed, either through an accompanying on-screen identification or a mention in the film's final credits;
- to the extent possible and appropriate, quotations are drawn from a range of different sources;
- each quotation (however many may be employed to create an overall pattern of illustrations) is no longer than is necessary to achieve the intended effect;
- the quoted material is not employed merely in order to avoid or inconvenience of shooting equivalent footage.

THREE: CAPTURING COPYRIGHTED MEDIA CONTENT IN THE PROCESS OF FILMING SOMETHING ELSE

Description: Documentarians often record copyrighted sounds and images when they are filming sequences in real-life settings. Common examples are the text of a poster on a wall, music playing on a radio, and television programming heard (perhaps seen) in the background. In the context of the documentary, the incidentally captured material is an integral part of the ordinary reality being documented. Only by altering and thus falsifying the reality they film—such as telling subjects to turn off the radio, take down a poster, or turn off the TV—could documentarians avoid this.

Principle: Fair use should protect documentary filmmakers from being forced to falsify reality. Where a sound or image has been captured incidentally and without prevision, as part of an unstaged scene, it should be permissible to use it, to a reasonable extent, as part of the final version of the film. Any other rule would be inconsistent with the documentary practice itself and with the values of the disciplines (such as criticism, historical analysis, and journalism) than inform reality-based filmmaking.

Limitations: Consistent with the rationale for treating such captured media uses as fair ones, documentarians should take care that:

- particular media content played or displayed in a scene being filmed was not requested or directed;
- incidentally captured media content included in the final version of the film is integral to the scene/action;
- the content is properly attributed;
- the scene has not been included primarily to exploit the incidentally captured content in its own right, and the captured content does not constitute the scene's primary focus of interest;
- in the case of music, the content does not function as a substitute for a synch track (as it might, for example, if the sequence containing the captured music were cut on its beat, or if the music were used after the filmmaker has cut away to another sequence).

FOUR: USING COPYRIGHTED MATERIAL IN A HISTORICAL SEQUENCE

Description: In many cases the best (or even the only) effective way to tell a particular historical story or make a historical point is to make selective use of words that were spoken during the events in question, music that was associated with the events, or photographs and films that were taken at that time. In many cases, such material is available, on reasonable terms, under license. On occasion, however, the licensing system breaks down.

Principle: Given the social and educational importance of the documentary medium, fair use should apply in some instances of this kind. To conclude otherwise would be to deny the potential of filmmaking to represent history to new generations of citizens. Properly conditioned, this variety of fair use is critical to fulfilling cultural mission of copyright. But unless limited, the principle also can defeat the legitimate interests of copyright owners—including documentary filmmakers themselves.

Limitations: To support a claim that a use of this kind is fair, the documentarian should be able to show that:

- the film project was not specifically designed around the material in question;
- the material serves a critical illustrative function, and no suitable substitute exists (that is, a substitute with the same general characteristics);
- the material cannot be licensed, or the material can be licensed only on terms that are excessive relative to a reasonable budget for the film in question;
- the use is no more extensive than is necessary to make the point for which the material has been selected;
- the film project does not rely predominantly or disproportionately on any single source for illustrative clips;
- the copyright owner of the material used is properly identified.

FAIR USE IN OTHER SITUATIONS FACED BY DOCUMENTARIANS

The four principles just stated do not exhaust the scope of fair use for documentary filmmakers. Inevitably, actual filmmaking practice will give rise to situations that are hybrids of those described above or that simply have not been anticipated. In considering such situations, however, filmmakers should be guided by the same basic values of fairness, proportionality, and reasonableness that inform this statement. Where they are confident that a contemplated quotation of copyrighted material falls within fair use, they should claim fair use.

AUTHORS IN DISGUISE: WHY THE VISUAL ARTISTS RIGHTS ACT GOT IT WRONG

Roberta Rosenthal Kwall*

I. INTRODUCTION

In the civil law tradition, moral rights protection is justified on the ground that a work of creative authorship reveals the author's individual process of creativity and artistic autonomy. Thus, given the infusion of "self" that occurs by virtue of the authorship process, an author should be entitled to claim certain personal guarantees such as the right of attribution and the right of integrity, which allow an author to prevent modifications to her work that are inconsistent with her artistic vision. Some critics are troubled, however, by the very concept of moral rights. Beginning in the late 1970s, literary critics such as Roland Barthes and Michel Foucault raised academic awareness of the purported fallacy that authorship entails an exclusive focus on the individual Romantic author.¹ This postmodern view of authorship essentially sees works of authorship as the product of individual or collective borrowing from the social fabric rather than the essence of any single person's creativity. Arguably this view is inconsistent with the theoretical predicate of moral rights.

Undoubtedly, authors freely borrow from the landscape of existing cultural production in creating their works.² This reality is as true today as it was historically.³ Despite the fact that all authors owe a debt to the past, the authorship

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¹ ROLAND BARTHES, *The Death of the Author*, in IMAGE, MUSIC, TEXT 142 (Stephen Heath trans., 1977); MICHEL FOUCAULT, *What Is an Author?*, in TEXTUAL STRATEGIES: PERSPECTIVES IN POST-STRUCTURALIST CRITICISM 141 (Josué V. Harari ed., 1979). For further discussion of this trend in literary criticism and its impact on copyright law, see Peter Jaszi, *On the Author Effect: Contemporary Copyright and Collective Creativity*, in THE CONSTRUCTION OF AUTHORSHIP: TEXTUAL APPROPRIATION IN LAW AND LITERATURE 29–35 (Martha Woodmansee & Peter Jaszi eds., 1994).

² For this reason, Lior Zemer has suggested that "the public" should be regarded as a joint author of all copyrightable works. See LIOR ZEMER, *THE IDEA OF AUTHORSHIP IN COPYRIGHT 2* (2007).

³ See generally Martha Woodmansee, *The Genius and the Copyright: Economic and Legal Conditions of the Emergence of the 'Author'*, 17 EIGHTEENTH-CENTURY STUD. 425, 441–45 (1984) (engaging in a historical discussion of authorship).

construct as we know it today embodies the idea of “crafting” a work so that it embodies the author’s personal stamp of autonomy. Notwithstanding the borrowing inherent in the authorship process, it is still the “author” who, on an individual or joint basis, “composes” the creative package. Postmodern scholars advocate a reconfiguration of the authorship construct in order to achieve a more balanced copyright law. Alternatively, I suggest that such a reconfiguration is unnecessary as long as we carefully formulate law that weighs the boundaries of this construct.⁴

Thus, an author may borrow liberally in crafting her work, but the final product nonetheless can reflect a “meaning” and “message” personal to the author and reflective of the author’s autonomy. Moral rights protection exists to recognize authorship autonomy by safeguarding the author’s meaning and message. The concepts of a work’s “meaning” and “message” as used in this Article are related in that they are dependent upon the author’s subjective vision rather than the vision of the author’s audience. These terms nonetheless embrace somewhat distinct ideas. The author’s “meaning” personifies what the work stands for on a level personal to the author; whereas the author’s “message” represents what the author is intending to communicate externally on a more universal level. A work’s “meaning” therefore exemplifies the idea of “why I as the author got involved in doing this work and what I see in it.” In contrast, a work’s “message” embodies the notion of “what I as author expect others to see in it, and what I hope they’ll take from it.”⁵

Let’s unbundle these concepts with an example. In my office hangs an exquisite colorful print called *Bereshit Micrography* by Leon Azoulay. The print contains the complete book of Genesis executed in Hebrew microcalligraphy and depicts the creation, Noah’s ark and a rainbow, and other images from the book of Genesis. Although I cannot say with certainty what the meaning of this work is for the author, one could posit that he created this edition of 350 prints as a testament to the mysteries of divine creation. Azoulay grew up in the ancient town of Tsfat, Israel, the birthplace of Jewish mysticism known as Kabbalah.⁶ His biography indicates that this environment inspired him to search for a means of expressing his passion for both painting and the Bible.⁷ Azoulay’s personal meaning essentially

⁴ Cf. Margaret Ann Wilkinson, *The Public Interest in Moral Rights Protection*, 2006 MICH. ST. L. REV. 193, 206 (noting that regardless of the divergent views surrounding the appeal of copyright as a romantic notion or as a utilitarian concept, “the founding of copyright upon identification of the work with the author has functioned as a necessary concept”).

⁵ I am indebted to Wendy Gordon for her insights with respect to framing this distinction. Charles Beitz recognized a similar distinction between a creator’s interest in preserving a work’s communicative content (an idea comparable to the term “message”) and the creator’s “desire to transfigure a world experienced as lacking in meaning or value” (illustrating the notion of “meaning” as used in this text). Charles R. Beitz, *The Moral Rights of Creators of Artistic and Literary Works*, 13 J. POL. PHIL. 330, 340-342 (2005).

⁶ See <http://www.leon-gallery.co.il/about.phtml> (last visited Nov. 28, 2007).

⁷ *Id.*

can be viewed as including whatever qualities he believes the work intrinsically embodies. The message of the print, on the other hand, is the narrative the author seeks to communicate to his audience. The author's message likely will include his own personal meaning, but it might also extend beyond it. For example, hypothetically speaking, Azoulay's microcalligraphy of Genesis may have intended to communicate that unless man controls his evil tendencies, suffering will occur as it did in the Garden of Eden. Thus, as used in this Article, the "message" of a work is whatever the author is seeking to communicate to her audience.

When a work of authorship manifests a meaning and message specific to the author, moral rights safeguard the author's original conceptions. Charles Beitz, a professor of politics at Princeton, has observed that even if a creator's work lacks a clear "propositional content" because she is simply attempting to "produce an interesting object for interpretation," the argument for moral rights protection remains strong because "the creator might reasonably believe that preservation of the work in its original form is necessary for the success of the aim."⁸ Attribution is a vital, and perhaps the most widely endorsed, component of moral rights. An author's choice of attribution is very much part of a work's meaning and message; as such, it plays a central role in communicating the essence of an author's work to her audience. As will be discussed more fully below, even anonymous or pseudonymous works can be seen as reflecting a branding choice that is a fundamental part of the author's meaning and message. When the author's attribution of choice is omitted without permission of the author, the original work is somehow incomplete. Attribution thus functions as a significant and widely acknowledged means of safeguarding the overall integrity of an author's text. In discussing the right of attribution, Susan Liemer observed that the "goal is to protect the personal association between the artist and her art" because even if two works look similar, they arise out of distinct minds, bodies, creative efforts, and processes.⁹

The moral right of integrity also represents a foundational authorship value. Objectionable distortions, modifications, or presentations of an author's work damage authorship dignity because the author's external embodiment of her meaning and message no longer represents her intrinsic creative process. The resulting damage is particularly acute when the modified work is linked to the author through specific attribution or widespread public recognition.¹⁰

Most copyrighted works are produced outside the framework of an individual author whose identity is known to the public. Works created outside the traditional authorship trope include those produced by authors who write anonymously or under a pseudonym, works for hire, and even collective works. The relationship

⁸ Beitz, *supra* note 5, at 341.

⁹ Susan P. Liemer, *Understanding Artists' Moral Rights: A Primer*, 7 B.U. PUB. INT. L.J. 41, 49 (1998).

¹⁰ See Roberta Rosenthal Kwall, *Inspiration and Innovation: The Intrinsic Dimension of the Artistic Soul*, 81 NOTRE DAME L. REV. 1945, 1974-75 (2006).

between moral rights and works created by these “authors in disguise” is problematic because if the primary objective of moral rights is to safeguard the meaning and message of an author’s work, it would seem as though the true author’s identity should be publicly known. Yet, for the types of works discussed in this Article, this knowledge may not be readily available. This Article explores these difficulties as a general matter, with particular focus on the failure of the Visual Artists Rights Act of 1990 (VARA) to incorporate explicit protection for anonymous and pseudonymous works and its exclusion of works made for hire from the scope of its coverage.¹¹ VARA is the primary federal codification of moral rights in the United States, and thus its provisions represent the most significant embodiment of the doctrine in this country. I argue that in light of the theoretical predicate for moral rights, VARA’s exclusions are misguided.

II. ANONYMITY AND PSEUDONYMITY

Recent legal scholarship has evaluated the practices of anonymity and pseudonymity from the perspective of consumer deception. Most of the scholarship on this topic treats this issue with a focus on literary genres in the context of attribution. Laura Heymann has proposed “a doctrine of moral rights for readers,”¹² and invokes the concept of an “authornym” as a branding choice offered by the author to the consuming public in the form of the author’s trademark.¹³ She does not see appropriate “authornymic attribution” as grounded in authorial “justice,” but rather as a method of preserving organizational integrity so that reader responses will be informed and consumer confusion minimized with respect to creative works.¹⁴

Writing primarily in the context of employment law, Catherine Fisk also has documented the branding function of attribution as a trademark. For example, she observed that “readers of Nancy Drew novels expect them to be authored by ‘Carolyn Keene’ even though she does not exist and the books were written by a number of different people according to specifications established by the publisher.”¹⁵ Greg Lastowka also calls for recognition of the trademark function of authorship and has recommended that attribution interests be regulated to prohibit “deceptive misattributions of authorship that result in consumer harms.”¹⁶ Henry Hansmann and Marina Santilli offer another perspective. They posit that pseudonymous works present “at most a modest fraud on the public” because the

¹¹ See 17 U.S.C. § 101 (2006) (defining “work of visual art”). The moral rights issues raised by collective works are outside the scope of this Article.

¹² Laura A. Heymann, *The Birth of the Authornym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377, 1446 (2005).

¹³ *Id.* at 1381.

¹⁴ *Id.* at 1446.

¹⁵ Catherine L. Fisk, *Credit Where It’s Due: The Law and Norms of Attribution*, 95 GEO. L.J. 49, 63 (2006).

¹⁶ Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U. L. REV. 1171, 1241 (2005).

use of this practice does not deceive the public as much as it does deny them the information of the real author's identity that they might otherwise like.¹⁷ In their view, this argument applies with even greater force to anonymous works because here there is "no offsetting concern that the public will be deceived into believing that there is some person other than the true author who has written the work in question."¹⁸

Despite the appeal of treating attribution and even integrity interests within the framework of trademark law, I suggest that trademark law is not analytically consistent with the theoretical basis for moral rights protection. Trademark law is concerned with preventing consumer confusion, a concept totally unrelated to the authorship interests encompassed by moral rights. Whether consumers are confused by a particular party's actions with respect to a work of authorship is a completely separate inquiry from whether a party has, through misattribution or other modifications, distorted the meaning and message of an author's work. Thus, in contemplating the difficulties presented by anonymous and pseudonymous works, the starting point is not determining whether the public is deceived by the attributions but rather ascertaining exactly whose meaning and message the work at issue reflects.¹⁹

Although VARA does not include specifically the negative rights of anonymity or pseudonymity,²⁰ these rights do comport with the Berne

¹⁷ Henry Hansmann & Marina Santilli, *Authors' and Artists' Moral Rights: A Comparative Legal and Economic Analysis*, 26 J. LEGAL STUD. 95, 131 (1997).

¹⁸ *Id.* at 132.

¹⁹ In this regard, ghostwriting presents some strong parallels to works written anonymously or under a pseudonym. The scenarios in which ghostwriting occurs are quite varied and can range from situations in which the ghostwriter is doing virtually all of the creative work to those in which the final product is far more representative of the message of the named author than that of the ghost writer. A more extensive analysis of ghostwriting is beyond the scope of this Article, however, because VARA does not address ghostwriters.

²⁰ The House Report states that the right of attribution contained in 17 U.S.C. § 106A(a)(1) extends "to the right to publish anonymously or under a pseudonym." H.R. REP. NO. 101-514 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6915, 6924. The authority cited for this proposition is the FINAL REPORT OF THE AD HOC WORKING GROUP ON U.S. ADHERENCE TO THE BERNE CONVENTION, *reprinted in* 10 COLUM.-VLA J.L. & ARTS 513, 550 (1986). This report does not, however, establish that VARA covers anonymous and pseudonymous works. It simply mentions that Article 6*bis* of the Berne Convention encompasses this right, citing as support the WORLD INTELLECTUAL PROPERTY ORGANIZATION [WIPO], GUIDE TO THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS 41 (1978). *See infra* note 21 and accompanying text. In fact, VARA explicitly requires that works be signed in certain instances. *See* 17 U.S.C. § 101 (2006) (defining "work of visual art"). The legislative history on the signature requirement is muddled, but it has been suggested that the real reason for the signature requirement was to meet "unreasonable demands by the book publishing industry, which was determined to eliminate even the most implausible hypothetical scenario for liability."

Convention.²¹ David Nimmer has observed that although the language of Berne on this point is “sparse,” the semi-official guide published by the World Intellectual Property Organization (WIPO) recognizes this aspect of the right of attribution as being within the scope of the Convention.²² There is good reason for this view in that an author’s decision to create anonymously or under a pseudonym can be viewed as a branding choice that is a fundamental part of the author’s meaning and message. Hansmann and Santilli have observed that an “artist may have good reasons to exist in the public’s mind as two different artists” and this analysis, in their view, applies “even more strongly to works published anonymously.”²³ I suggest that more often than not, the reasons underlying an anonymous or pseudonymous attribution choice relate to how the author understands both the personal meaning of her work and her intended, externalized message.²⁴

A compelling example of this phenomenon is Laura Heymann’s observation that in certain instances, an author may choose to subordinate her own identity to the “broader purpose of the text.” For example, a Holocaust survivor may favor anonymity because she wishes her poem or painting to represent the voice of all of the victims.²⁵ Heymann catalogues other motivations for authors and artists to select various expressive identities, which include gender morphing, and the masking of particular cultural, racial, or ethnic identification.²⁶ Such authors are experimenting with different modes of authorship to, in effect, reflect a personal meaning and facilitate the communication of a particular message to their readers.

WILLIAM PATRY, *The Visual Artists Rights Act of 1990*, in PATRY ON COPYRIGHT § 16:14 (2006).

²¹ Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, revised at Paris on July 24, 1971 and amended on Sept. 28, 1979, S. TREATY DOC. NO. 99-27 (1986).

²² David Nimmer, *The Moral Imperative Against Academic Plagiarism (Without a Moral Right Against Reverse Passing Off)*, 54 DEPAUL L. REV. 1, 15 (2004). Countries vary in their approach to whether moral rights extend to anonymous or pseudonymous works. For example, the United Kingdom grants the moral right of pseudonymity but not anonymity. ELIZABETH ADENEY, *The United Kingdom: The Rights and Their Application*, in THE MORAL RIGHTS OF AUTHORS AND PERFORMERS: AN INTERNATIONAL AND COMPARATIVE ANALYSIS § 14.32, at 397 (2006) [hereinafter THE MORAL RIGHTS]. In contrast, Germany’s statute has been interpreted to allow protection for both. See ADENEY, *Moral Rights in Germany*, in THE MORAL RIGHTS, *supra*, § 9.72, at 238.

²³ Hansmann & Santilli, *supra* note 17, at 131–32.

²⁴ *But see* Wilkinson, *supra* note 4, at 229–30 (arguing that the right of attribution should incorporate the right to maintain a pseudonym because this approach vindicates the public’s interest in “the authority of the information,” but the opposite is true regarding the right of anonymity).

²⁵ See Heymann, *supra* note 12, at 1406.

²⁶ *Id.* at 1398–1401.

In this regard, consider the facts in *McIntyre v. Ohio Elections Commission*.²⁷ The defendant in this case distributed leaflets opposing a proposed school tax levy with the attribution "Concerned Parents and Tax Payers."²⁸ Heymann observes that what motivated McIntyre, the defendant, to use this designation was "not the fear of retribution but a deliberate construction of identity, a desire to have the viewpoints in her handbill attributable to an identity other than her 'true' identity."²⁹ In fact, she posits that in *McIntyre*, the defendant may have been motivated to take advantage of a perceived audience tendency to give more weight to joint authorship than to an individual writer.³⁰ Catherine Fisk provides another telling example when she discusses the practice of newspaper writers electing a byline strike as a means of publicly protesting "objectionable workplace policies."³¹ Fisk maintains that in such instances, the reporters are hoping that the absence of their bylines will alert readers to their complaints.³² As these examples pointedly show, an author's choice to write either anonymously or under a pseudonym can be understood as a component of the work's essential meaning for the author and its intended message to the public.

VARA, of course, covers only visual art.³³ Paintings, drawings, sculptures and other works within the scope of VARA are at first blush typically not regarded as the sort of works created anonymously or under a pseudonym. Although a couple of state moral rights statutes explicitly cover an author's right to receive credit under a pseudonym, no case law exists on this point.³⁴ Still, the above analysis applies to visual art in much the same way as to literary and other works. For example, a visual artist might choose to create under a pseudonym to mask her true identity in order to convey a particular message through her work.³⁵ With respect to anonymity, recall the Holocaust survivor example discussed earlier who paints anonymously to give a voice to all of the victims.³⁶ Also, visual artists may fail to sign their works intentionally so as not to deface the visual integrity of their works. These decisions should be construed as deliberate branding choices and covered within the framework of VARA. In sum, the practices of anonymity and pseudonymity can be reconciled with moral rights protection for the author on the

²⁷ 514 U.S. 334, 357 (1995) (holding unconstitutional a state law prohibiting any individual from distributing material designed to promote or defeat a political issue unless the author's name and address were listed).

²⁸ *Id.* at 337.

²⁹ Heymann, *supra* note 12, at 1430.

³⁰ *Id.*

³¹ Fisk, *supra* note 15, at 92–93; *see also* David Nimmer, *supra* note 22, at 73 (noting that with respect to scholars, it is "[f]ar more threatening . . . to vest exclusive attribution in the employers" than to divest economic rights under the work-for-hire doctrine).

³² Fisk, *supra* note 15, at 93.

³³ *See* 17 U.S.C. § 106A(a) (2006).

³⁴ *See* MASS. GEN. LAWS ch. 231, § 85S (2006); N.M. STAT. ANN. § 13-4B-3 (West 2006). Prior to VARA's enactment, eleven states had moral rights legislation.

³⁵ *See* Heymann discussion, *supra* note 12 and accompanying text.

³⁶ *See supra* note 25 and accompanying text.

ground that these attribution designations function as part of the author's personal meaning and intended message. Therefore, VARA should be amended in this respect to include explicit protection for works that are anonymous and pseudonymous.

III. WORKS FOR HIRE

The practice of hiring someone to create a work of authorship for which no attribution credit will be given has had a long and distinguished history in the United States in the form of the work-for-hire doctrine. This doctrine operates to vest authorship status in the employer of the author or, in certain instances, in the party who commissions the work. Work for hire is the only aspect of our copyright law that conflicts with an explicit right of attribution for all authors. Although variations of this doctrine appear in other countries such as the Netherlands and Russia, the United States, for the most part, is unique in its explicit embrace of this position.³⁷ According to Adolf Dietz, the work-for-hire doctrine as applied "takes

³⁷ For a discussion of the doctrine's theoretical application in the Netherlands, see Jane C. Ginsburg, *The Concept of Authorship in Comparative Copyright Law*, 52 DEPAUL L. REV. 1063, 1088–90 (2003) [hereinafter Ginsburg, *The Concept of Authorship*]. Interestingly, Russian copyright law also has a work-for-hire doctrine. See *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 92 (2d Cir. 1998); see also Australian Copyright Act, 1968, § 35(6), available at http://www.austlii.edu.au/au/legis/cth/consol_act/ca1968133/ (last visited Nov. 28, 2007) (providing that the employer of an author will own the copyright in certain instances).

In contrast, French law does not recognize the work-for-hire doctrine except with regard to computer programs, a position that also is shared by some other countries. See, e.g., Jane C. Ginsburg, *Reforms and Innovations Regarding Authors' and Performers' Rights in France: Commentary on the Law of July 3, 1985*, 10 COLUM.-VLA J.L. & ARTS 83, 88–89 (1985); Council Directive 91/250, art. 2.1, Legal Protection of Computer Programs, 1991 O.J. (L 122) 42. In addition, French law has special provisions for collective works that resemble the operation of works made for hire. See 1-FRA INTERNATIONAL COPYRIGHT LAW & PRACTICE § 4[1](b)(ii)(C) (Paul Edward Geller & Melville B. Nimmer eds., 18th ed. 2006). Interestingly, Jane Ginsburg cites French sources from the early to middle nineteenth century supporting a broader view of "author" as including "not only those who themselves created a literary work, but also those who have had the work composed by others, and who undertake to pay for its composition." See Ginsburg, *The Concept of Authorship*, *supra*, at 1088–90.

The civil law tradition typified by the French perspective regarding works for hire does, however, look to other means to achieve a comparable result in certain situations. Such means "include rules of presumed transfers of exploitation rights, statutory limitations on moral rights, and judicially tailored rules for commissioned works or works created in an employment relationship." Marina Santilli, *United States' Moral Rights Developments in European Perspective*, 1 MARQ. INTELL. PROP. L. REV. 89, 96–99 (1997) (providing a comprehensive discussion of these issues). By way of comparison, the British Copyright Act provides that "[w]here a . . . work is made by an employee . . . his employer is the first owner of any copyright in the work subject to any agreement to the contrary." Copyright, Designs and Patents Act, 1988, c. 48, § 11(2) (Eng.). According to this provision, only

away with one stroke of the pen the constitutional guarantee for the initial and true author.”³⁸ The work-for-hire doctrine perhaps can be justified when it operates to divest an author of copyright ownership given the economic quid pro quo she receives. On the other hand, by allowing an author to relinquish her authorship status and all that such status entails, the work-for-hire doctrine arguably undermines authorship dignity in a fundamental way.³⁹

A. History and Statutory Operation of the Work-for-Hire Doctrine

From the outset, the approach underlying the work-for-hire doctrine in the United States was very focused on economic realities. Significantly, the work-for-hire doctrine originally was codified as a default rule invoked to determine copyright ownership in the absence of a contractual stipulation on this point.⁴⁰ With respect to works for hire, the employer is regarded as the author in a legal sense, as compared to the creator of a work, whom Judge Learned Hand once termed “the ‘author’ in the colloquial sense.”⁴¹ Thus, the work-for-hire doctrine fails to distinguish between colloquial authorship of a work and legal ownership of the copyright in which the creative work is embodied. This is a significant distinction because the autonomy concepts of “meaning” and “message” that provide the theoretical grounding for moral rights apply to “authors” as that term is understood colloquially rather than legally.⁴² Regardless of whether an author transfers any or all of her copyrights, the creative work continually manifests the colloquial author’s subjective meaning and intended message. As discussed above, the author’s artistic autonomy is tied to the accurate presentation and attribution of this object, despite the transfer of the object itself or the copyrights to the work. In her study of the norms of attribution, Catherine Fisk stated that “[t]o most employees most of the time, what matters is not that you own your . . . copyright, but that you can truthfully claim to be the . . . author of it.”⁴³ By simply positing

ownership rather than authorship is attributed to the employer. *Id.* Nevertheless, sections 79(3) and 82(1) of the British Act essentially negate this distinction by diminishing the attribution and integrity rights of employed authors. *Id.* §§ 79(3), 82(1)(a). Germany lacks a direct work-for-hire doctrine, but article 43 of the Copyright Law presumes a transfer of rights from employed authors to their employers. Urheberrechtsgesetz [UrhG] [Copyright Law], Sept. 9, 1965, BGBl. I. at 1273, art. 43, (F.R.G.).

³⁸ Email from Adolf Dietz, Honorary Professor of Copyright Law, University of Passau, Germany to author (July 18, 2005) (on file with author).

³⁹ See Catherine L. Fisk, *Authors at Work: The Origins of the Work-for-Hire Doctrine*, 15 YALE J.L. & HUMAN. 1, 68 (2003) (“If American law had recognized moral rights as French law does, it might have been more difficult to imagine how the corporation could acquire all the rights to the employee’s works.”).

⁴⁰ See *Martha Graham Sch. & Dance Found., Inc. v. Martha Graham Ctr. of Contemporary Dance, Inc.*, 380 F.3d 624, 634 (2d Cir. 2004) (discussing both the 1909 and 1976 Copyright Acts).

⁴¹ *Shapiro, Bernstein & Co. v. Bryan*, 123 F.2d 697, 699 (2d Cir. 1941).

⁴² See *supra* notes 5–10 and accompanying text.

⁴³ Fisk, *supra* note 15, at 54.

that the employer becomes the author, the work-for-hire doctrine gives no consideration to the consequences of deeming the employer to be the physical source of the creation.

The work-for-hire doctrine has been in place in the United States, at least in theory, for over a century.⁴⁴ The 1909 Copyright Act failed to include a definition of “work made for hire” but stipulated that “the word ‘author’ shall include an employer in the case of works made for hire.”⁴⁵ The 1976 Act attempted to create more certainty in work-for-hire determinations to preclude employees from claiming an after-the-fact copyright interest in such works.⁴⁶ Section 201(b) of the 1976 Act specifically embraces the work-for-hire doctrine by providing that:

In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.⁴⁷

Further, the 1976 Act invokes a two-pronged definition of a “work made for hire” as “a work prepared by an employee within the scope of his or her employment; or a work specially ordered or commissioned” for specified types of uses.⁴⁸ To satisfy the specially commissioned prong of the definition, the parties also must

⁴⁴ For a comprehensive analysis of the history of the work-for-hire doctrine in the 19th and early 20th centuries, see Fisk, *supra* note 39, at 6.

⁴⁵ 17 U.S.C. § 26 (repealed 1976). Under judicial interpretations of the 1909 Act, the work-for-hire doctrine vested copyright ownership in the person at whose “instance and expense” the work was created, regardless of whether the work was created by an employee or an independent contractor. See *Brattleboro Publ’g Co. v. Winmill Publ’g Corp.*, 369 F.2d 565, 567–68 (2d Cir. 1966) (employee); *Lin-Brook Builders Hardware v. Gertler*, 352 F.2d 298, 300 (9th Cir. 1965) (independent contractor). Although the 1909 Act’s work-for-hire doctrine initially was confined to works made by traditional “employees” in the scope of their employment, the doctrine later was expanded to include independent contractors. See, e.g., *Forward v. Thorogood*, 985 F.2d 604, 606 (1st Cir. 1993) (citing *Murray v. Gelderman*, 566 F.2d 1307, 1310 (5th Cir. 1978); *Brattleboro*, 369 F.2d at 567–68).

⁴⁶ Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 CORNELL L. REV. 857, 889–95 (1987) (stating that “[t]he keynote of the [1976 Copyright] statute’s ownership provisions is a commitment to facilitation of transfer and exploitation of copyrights by removing uncertainties over copyright ownership”); see also *Cmty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 749 (1989) (noting that “Congress’ paramount goal in revising the 1976 Act” was to enhance “predictability and certainty of copyright ownership”).

⁴⁷ 17 U.S.C. § 201(b) (2006).

⁴⁸ *Id.* § 101.

“expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.”⁴⁹

The legislative history accompanying the codification of the work-for-hire doctrine under both the 1909 and 1976 Acts does not reveal an explicit appreciation for the personal rights of authors as distinct from their ownership interests. Additionally, the history does not specifically address the implications of vesting authorship, as opposed to ownership, rights in an employer.⁵⁰ In fact, the language of section 201(b) suggests that a signed written agreement can transfer copyright ownership, but not authorship status, to the hired party—the colloquial author—with respect to works made for hire.⁵¹

It would have been reasonable to expect the text and history of VARA to recognize the distinction between ownership and authorship. Yet, VARA excludes works made for hire from the scope of the statute’s coverage.⁵² Specifically, in the context of visual art, this exclusion can have a tremendous impact in practice because works made for hire “may account for a number of major art works, including major commissions, installed works, and works incorporated into buildings.”⁵³

B. Work-for-Hire Cases Implicating Moral Rights Issues

For the most part, the work-for-hire case law similarly fails to consider the distinction between authorship and ownership because ownership of the

⁴⁹ *Id.* See *Compaq Computer Corp. v. Ergonome Inc.*, 210 F. Supp. 2d 839, 842–43 (S.D. Tex. 2001) (summarizing the split among the circuits on the question of the appropriate timing of the execution of the written agreement in 17 U.S.C. § 101(2)).

⁵⁰ *But see* Fisk, *supra* note 39, at 64 (noting, in the context of the legislative history of the 1909 Act, some sensitivity to the distinction between authorship and copyright ownership on the part of Robert Underwood Johnson, Secretary of the American Authors’ Copyright League); *id.* at 68 (observing that one of the drafters of the 1909 Act “worried that employer ownership might allow a firm to alter and degrade a work after its creation and injure the reputation of the individual employee who was known to have been its creator”).

⁵¹ See Rochelle Cooper Dreyfuss, *The Creative Employee and the Copyright Act of 1976*, 54 U. CHI. L. REV. 590, 600 (1987) (“A signed writing can, at most, have the effect of rebutting the presumption that the employer is the copyright owner.”).

⁵² For a discussion of the legislative history of VARA, see Roberta Rosenthal Kwall, *How Fine Art Fares Post VARA*, 1 MARQ. INTELL. PROP. L. REV. 1, 4 (1997).

⁵³ See REGISTER OF COPYRIGHTS, WAIVER OF MORAL RIGHTS IN VISUAL ART WORKS xv (1996). In addition, the following six state moral right statutes exclude works made for hire from their statutory protections: California, Connecticut, Massachusetts, Nevada, New Mexico, and New York. See CAL. CIV. CODE §§ 987, 989 (West 2006); CONN. GEN. STAT. § 42-116t (2005); MASS. GEN. LAWS ch. 231, § 85S (2006); NEV. REV. STAT. § 597.720 to .760 (2006); N.M. STAT. § 13-4B-3 (West 2006); N.Y. ARTS & CULT. AFF. LAW § 11(C) (McKinney 2002). See *supra* note 34.

copyrighted property typically is what is at issue in work-for-hire disputes.⁵⁴ Between 1978, the effective year of the 1976 Act, and today, the specially commissioned prong of the work-for-hire doctrine⁵⁵ has been the subject of roughly thirty-five cases. The employee prong⁵⁶ has given rise to nearly double this number since 1989, when the Supreme Court provided guidelines for determining whether an individual should be considered an employee or an independent contractor.⁵⁷ Taken together, these decisions total roughly one hundred cases, but only a handful involve facts that could even potentially give rise to attribution or other textual integrity violations. Moreover, only a small number of these decisions involve works potentially within the scope of VARA.⁵⁸ Despite the lack of precedent on this point, it is instructive to examine a couple of key decisions because they demonstrate how the operation of the work-for-hire doctrine has the potential to conflict with the authorship autonomy interests that form the basis of moral rights protection.

In *Community for Creative Non-Violence v. Reid*, a nonprofit organization, the Community for Creative Non-Violence (CCNV), sued James Earl Reid, an artist whom it had commissioned to sculpt a homeless family for a Christmastime

⁵⁴ It is important to note, however, that under the current copyright statute, the determination that a work is one for hire affects issues other than just copyright ownership. For example, when a work for hire has been licensed, the license is not subject to termination under sections 203 and 304 of the Act. 17 U.S.C. §§ 203(a) & 304(c) (2006). The original rationale underlying the termination provisions was to provide additional benefits to authors. In *Marvel Characters, Inc. v. Simon*, the court noted that because the statutory author of a work-for-hire historically was an employer-publisher, this rationale is not as directly applicable since “an employer-publisher does not face the same potential unequal bargaining position as an individual author.” 310 F.3d 280, 291 (2d Cir. 2002). Also, the employer of a work-for-hire can exercise the renewal right under § 304(a), while the colloquial author or her statutory successors cannot. 17 U.S.C. §304(a) (2006). The number of years copyright protection subsists also varies between ordinary works and works-for-hire pursuant to sections 302(a) and (c). According to section 302(a), copyright protection in general lasts for the life of the author plus seventy years. *Id.* § 302(a). Section 302(c) provides that in the case of works made for hire (as well as anonymous and pseudonymous works), protection lasts “for a term of 95 years from the year of its first publication, or a term of 120 years from the year of [the work’s] creation, whichever expires first.” *Id.* § 302(c). To the extent all of these provisions are concerned with the economic value of the author’s copyright rather than the dignity interests of authors, their continued application with respect to works for hire is not problematic from the standpoint of moral rights.

⁵⁵ 17 U.S.C. § 101. *See also infra* note 76.

⁵⁶ *Id.* § 101. *See also infra* note 91.

⁵⁷ *Cmty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 751–52 (1989). *See also* Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 *CARDOZO ARTS & ENT. L.J.* 81, 151 (1998) (noting that the “employee” prong “has remained the battleground for work-for-hire disputes—so much so that 1909 law and 1976 law cases look much the same”).

⁵⁸ *See infra* note 91.

pageant.⁵⁹ Reid wanted to cast the piece in bronze so that it would be more durable, but CCNV rejected this idea due to time and financial constraints.⁶⁰ Ultimately, Reid suggested that he cast the sculpture in a synthetic substance that would be more economical but still durable, a compromise accepted by CCNV.⁶¹ No written agreement was signed and no mention was made of the copyright.⁶² During the creation process, members of CCNV visited Reid to discuss the project.⁶³ After the completion of the statue, it was displayed for about a month and then returned to Reid's studio for minor repairs.⁶⁴ Upon hearing of CCNV's plans to take the sculpture on a major tour, Reid refused to return the sculpture because he believed the sculpture could not withstand such an ambitious tour. Reid urged CCNV to cast the statute in bronze or create a master mold, but CCNV declined to spend additional sums of money on the sculpture.⁶⁵ Reid then refused to return the sculpture and filed a certificate of copyright registration in his own name.⁶⁶ He proposed to take the sculpture on a more modest tour than the one contemplated by CCNV.⁶⁷ Then, CCNV filed a competing certificate of copyright registration and instituted a lawsuit, seeking the sculpture's return and a declaration of copyright ownership.⁶⁸ The Supreme Court held that Reid was an independent contractor rather than an employee of CCNV, and therefore, ownership of the copyright did not belong to CCNV pursuant to the work-for-hire doctrine.⁶⁹

The *Reid* Court concluded that the general common law of agency should govern whether an individual is an employee under the work-for-hire definition, with the focus on whether a hiring party has the "right to control the manner and means by which the product is accomplished."⁷⁰ To decide whether an agency relationship exists, courts should balance a variety of factors derived from the

⁵⁹ 490 U.S. 730, 733–36 (1989).

⁶⁰ *Id.* at 733.

⁶¹ *Id.* at 733–34.

⁶² *Id.* at 734.

⁶³ *Id.*

⁶⁴ *Id.* at 735.

⁶⁵ *Id.*

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ According to the Court's analysis, the level of CCNV's participation in the project was not sufficiently high to merit its being designated as the legal author for purposes of the work-for-hire doctrine. The overall consideration, according to the Court, is whether the hiring party has the "right to control the manner and means by which the product is accomplished." *Id.* at 750–51. In applying the *Reid* factors, the Court concluded that Reid was an independent contractor given his level of skill; the use of his own tools and studio; his discretion in hiring assistants; the relatively short period of time in which he was retained by CCNV; the payment to Reid upon the completion of the job; CCNV's lack of being in the sculpting business; and CCNV's failure to pay taxes or provide any other employee benefits to Reid. *Id.* at 752–53.

⁷⁰ *Id.* at 750–51.

common law as outlined by the Restatement of Agency.⁷¹ A review of these factors reveals that the Restatement's emphasis is on "the relationship between the person performing the work and the person paying him to perform the work."⁷² The courts should consider

the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; whether the hiring party has the right to assign additional projects to the hired party; . . . the method of payment; the hired party's role in hiring and paying assistants; . . . whether the hiring party is in business; the provision of employee benefits; and the tax treatment of the hired party.⁷³

These factors are largely irrelevant when evaluating a situation involving a potential work made for hire in the context of a violation of authorship autonomy. In these instances, the focus should be on whether the work itself conveys the colloquial author's meaning and intended message, and if so, whether misattributions or presentations of the work by the hiring party or anyone else distort these communicative qualities.⁷⁴

⁷¹ See RESTATEMENT (SECOND) OF AGENCY §220 (2) (1958).

⁷² *MacLean Assocs. v. Wm. M. Mercer-Meidinger-Hansen, Inc.*, 952 F.2d 769, 777–78 (3d Cir. 1991).

⁷³ *Reid*, 490 U.S. at 751–52.

⁷⁴ Of course "the right to control the manner and means by which the product is accomplished" does bear on whose meaning and message the work conveys. *Id.* at 751. Still, of all the more specific *Reid* factors enumerated by the Supreme Court, only the skill required of the hired party and perhaps "the extent of the hired party's discretion over when and how long to work" may have a bearing on whether the work reflects the meaning and message of the hired party. *Id.*

As a general matter, a major problem with the application of the *Reid* factors is that that a court may readily manipulate them if inclined toward a particular result. See *Kwall*, *supra* note 52, at 9–10 (noting that the court in *Carter v. Helmsley-Spear* "may have reached the result it did because it was troubled by the prospect of allowing the work to remain in a lobby for a long period of time when the original agreement was entered into by a net lessee of the building, rather than by the building's owner"). In *Martha Graham School & Dance Foundation, Inc. v. Martha Graham Center of Contemporary Dance, Inc.*, 380 F.3d 624 (2d Cir. 2004), the court manipulated the *Reid* factors, particularly the exercise of creative control, to arrive at a desired result. See *infra* note 87 and accompanying text. In that case, had the dances not been classified as works for hire, the copyrights to them would have passed under Graham's will to her long-time companion rather than to the Martha Graham Center of Contemporary Dance. *Martha Graham*, 380 F.3d at 631.

Although the *Reid* factors are designed to determine whether an individual is an employee as opposed to an independent contractor, the employee prong of the work-for-hire definition also requires that the work in question be created by an employee "within the scope of his or her employment." 17 U.S.C. § 101 (2006) (emphasis added). In applying this prong of the work-for-hire definition, courts typically invoke a three-part test derived from the common law of agency. These factors require a court to determine whether the

Reid did not involve an application of the specially commissioned prong, for which the relevant categories of covered works are limited to those specified in the statute. Although in theory, some of the designated categories in this prong of the work-for-hire definition could include works covered under VARA, the Report of the Register of Copyrights clearly indicates that the works of artists were not among those contemplated by the statutory definition.⁷⁵ Moreover, in practice, the specially commissioned work-for-hire cases yield little relevant information on how to approach a work-for-hire and moral rights conflict because many of these

work in question: (1) is “of the kind” the author is “employed to perform;” (2) “occurs substantially within authorized work hours;” and (3) is “actuated, *at least in part*, by a purpose to serve the employer.” *See, e.g.,* *Shaul v. Cherry Valley-Springfield Cent. Sch. Dist.*, 363 F.3d 177, 186 (2d Cir. 2004) (emphasis added). Here again, these factors are analyzed from the standpoint of determining the nature of the relationship between the hiring and hired parties. With respect to moral rights, however, the question should revolve around the nature of the relationship between the author and her work. Moreover, even the scope of the employment test as articulated bears some recognition that an employee performing a task within the scope of her employment nonetheless can be producing a highly creative work that reflects the colloquial author’s meaning and intended message. The third part of the test asks whether the creation of the work was “actuated, *at least in part*, by a purpose to serve the employer.” *Id.* (emphasis added). It would be rare for a truly creative work to be created for the sole benefit of the employer, as the creation process itself inevitably affords the author with a degree of internal satisfaction. *Cf. Favela v. Fritz Cos.*, No. CV 92-2450 DT, 1993 WL 651875, at *6 (C.D. Cal. Sept. 20, 1993) (holding that computer programs were created within the scope of employment because they were created “for the sole benefit” of employer); *Sterpetti v. E-Brands Acquisition, LLC*, No. 6:04-CV-1843-ORL-3DA, 2006 WL 1046949, at *8 (M.D. Fla. Apr. 20, 2006) (holding that employee’s work was “appreciably motivated” to serve employer’s business, and therefore was completed within the scope of employment).

⁷⁵ *See infra* note 118 and accompanying text. Even apart from the interface between the work-for-hire doctrine and VARA, a meaning and message analysis also may be relevant for some of the commissioned categories that are not within the scope of VARA, such as parts of motion pictures or other audiovisual works. *Cf. Michael P. Matesky II, Note, Whose Song Is It Anyway? When are Sound Recordings Used in Audiovisual Works Subject to Termination Rights and When are They Works Made for Hire?*, 5 VA. SPORTS & ENT. L.J. 63, 88-96 (2005) (advocating that when sound recordings are commissioned for “the primary purpose” of being used in audiovisual works, they should qualify as works made for hire). Justin Hughes has discussed the “intentionality” of the commissioning party as “a measure of whether the patron’s intentions imbue and control the artistic endeavor” with respect to commissioned works. *See Hughes, supra* note 57, at 153. His discussion of relevant “personhood” interests reinforces the view that in certain instances, it is appropriate to evaluate a specially commissioned work from the standpoint of whose meaning and message the work reflects—that of the author or that of the hiring party. Nonetheless, several of the categories in the specially commissioned prong such as instructional texts, supplementary works, tests, or answer materials for tests encompass works for which it would be difficult, if not impossible, to approach the conflict from the perspective of determining the source of a work’s meaning and message. *See* 17 U.S.C. § 101 (2006).

decisions focus on compliance with the provision's additional requirement of a written instrument signed by both parties stipulating that the work is one for hire.⁷⁶

Although the facts of *Reid* did not involve an express moral rights violation, they certainly raise the potential for such a claim. Specifically, CCNV, as the commissioning party, owned the sculpture at issue but did not own the copyright. As a legal matter, *copyright* ownership and authorship remained in Reid because the work did not satisfy the requirements of the Court's work-for-hire test.⁷⁷ Therefore, the case resulted in ownership of the artwork in one party and the copyright to the artwork in another.⁷⁸ Under such a scenario, moral rights issues can arise when the owner of the artwork fails to attribute authorship or desires to take some action that will modify, or perhaps even destroy, the work's meaning and message as conceived by the original author. Thus, CCNV's desire to take the sculpture on a tour that would have been too ambitious for the work could have been the basis for a right of integrity claim by Reid had the law in the United States allowed for this cause of action.⁷⁹ With respect to the governing law, however, CCNV presumably had the right to take the sculpture on a tour, even if that tour would damage or destroy the work.⁸⁰ Further, the law at that time would

⁷⁶ Hughes, *supra* note 57, at 150. I tracked thirty-three federal cases that applied the "specially commissioned" prong of the Copyright Act of 1976. Nineteen of these cases were decided solely on the presence or absence of a clearly written work-for-hire agreement. None of the courts sought to determine whose meaning and message the work reflected. *See also supra* note 55 and accompanying text.

⁷⁷ *Reid*, 490 U.S. at 751-53.

⁷⁸ Towards the end of its opinion, the Court indicated that perhaps CCNV might be considered a joint author of the sculpture if the district court subsequently found on remand that the parties prepared the work so as to comply with the statutory requirements for joint authorship. *Id.* at 753; *see* 17 U.S.C. § 101 (2006) (defining a "joint work"). On remand following the Supreme Court's opinion, the district court determined that Reid should be recognized as the sole author of the sculpture and that he has sole ownership rights under section 106 regarding all three-dimensional reproductions of the sculpture. *Cnty. for Creative Non-Violence v. Reid*, No. 86-1507(TPJ), 1991 WL 415523, at *1 (D.D.C. Jan. 7, 1991). The court also ruled that CCNV is the sole owner of the original copy of the sculpture, and that both parties are co-owners of all section 106 rights respecting two-dimensional reproductions of the sculpture. *Id.*

⁷⁹ The sculpture at issue in *Reid* was created prior to the effective date of VARA, and therefore not subject to the statute. *See* 17 U.S.C. § 106A(d)(2) (2006). Further, note that VARA only prevents destruction of works that are "of recognized stature." *Id.* § 106A(a)(3)(B). The "recognized stature" caveat regarding destruction is not present in the prohibition involving mutilation. *Id.* § 106A(a)(3)(A). One problem with this aspect of VARA is that neither the statute nor the legislative history provides any guidance for determining when a work qualifies as being "of recognized stature." *Carter v. Helmsley-Spear, Inc.*, 861 F. Supp. 303, 324-25 (S.D.N.Y. 1994), *aff'd in part*, 71 F.3d 77 (2d Cir. 1995).

⁸⁰ According to the appellate court, "Co-ownership (or even sole ownership) of the copyright does not appear to carry with it a right to stop or limit CCNV's tour or to gain possession of the unique work of art." *Cnty. for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1498 (D.C. Cir. 1988).

not have required CCNV to attribute authorship of the work to Reid, although on remand, the district court ordered that any two-dimensional reproductions of the sculpture must credit Reid as the author.⁸¹

These issues would not have been resolved any more satisfactorily had the Court concluded that the sculpture was a work for hire. If the Court had held that CCNV owned the copyright, CCNV also could have taken actions with respect to the sculpture that would have obliterated the meaning and message of Reid's work. For example, as the copyright owner, CCNV would have been able to reproduce the work but would not be required to attribute authorship. CCNV also would be able to modify or even destroy the work, actions that surely would affect the work's meaning and message as determined by Reid.

The only case to examine directly VARA's exclusion of works made for hire from the definition of "visual art" is *Carter v. Helmsley-Spear, Inc.*⁸² In *Carter*, the Second Circuit concluded that the plaintiffs' "walk-through sculpture,"⁸³ which occupied the majority of the lobby of the defendants' building, was a work made for hire.⁸⁴ This determination precluded the application of VARA to the plaintiffs' lawsuit seeking to enjoin the defendants from removing, modifying, or destroying the art work.⁸⁵ *Carter* would have been an ideal fact situation to determine the relationship between copyright ownership and authorship as defined by the work-for-hire doctrine because it involved a situation in which the artists enjoyed substantial creative control over the work.⁸⁶ Thus, the real issue presented in

⁸¹ *Reid*, 1991 WL 415523, at *1.

⁸² 71 F.3d 77 (2d Cir. 1995), *cert. denied*, 517 U.S. 1208 (1996).

⁸³ *Id.* at 80.

⁸⁴ *Id.* at 87-88.

⁸⁵ In applying the *Reid* factors, the district court concluded that the plaintiffs were independent contractors. *Carter v. Helmsley-Spear, Inc.*, 861 F. Supp. 303, 317-21 (S.D.N.Y. 1994), *aff'd in part*, 71 F.3d 77 (2d Cir. 1995); *see supra* notes 69-74 and accompanying text. One factor of particular interest was the plaintiffs' ownership of the copyright to the work, which the district court concluded was a "plus factor" indicating their independent contractor status. *Carter*, 861 F. Supp. at 321-22. In contrast, the Second Circuit rejected the district court's view and "put off for another day deciding whether copyright ownership is probative of independent contractor status." *Carter*, 71 F.3d at 87.

⁸⁶ The Second Circuit apparently felt the need to defend its work-for-hire conclusion against the strong showing of artistic freedom enjoyed by the plaintiffs:

Again, we emphasize that despite the conclusion reached we do not intend to marginalize factors such as artistic freedom and skill, making them peripheral to the status inquiry. The fact that artists will always be retained for creative purposes cannot serve to minimize this factor of the *Reid* test, even though it will usually favor VARA protection.

Id. The Second Circuit essentially predicated its holding that the sculpture was a work-for-hire on the combination of the existence of payroll formalities, the possibility of additional projects assigned to the plaintiffs, the defendants' furnishing the plaintiffs with needed

Carter was if and how an author's moral rights should be applied in a situation in which the author is technically employed by another entity but nonetheless engaged in a highly creative enterprise over which she has maintained substantial creative control.⁸⁷

IV. REVISITING VARA

The foregoing discussion demonstrates that the work-for-hire doctrine is concerned with authorship in the legal sense, which essentially implicates the question of copyright ownership. The incompatibility between the work-for-hire doctrine and the concept of authorship autonomy supporting moral rights fails to capture the attention of the courts, and VARA has perpetuated this problem. Some commentators explain this result by positing that perhaps no conflict exists because when works made for hire are at issue, the work's tangible expression essentially is controlled by the employer or commissioning party.⁸⁸ As such, no autonomy violation realistically occurs because the work in question does not reflect the physical author's meaning and intended message but rather is more reflective of the hiring party's intentions and control over the artistic endeavor.⁸⁹ Henry Hansmann and Marina Santilli even suggest that the work-for-hire doctrine "constitutes a waiver of moral rights, in recognition by the artist and the commissioning party that the latter's need for flexibility in the use of the work exceeds the artist's subjective and reputational interests."⁹⁰

supplies, and the need for the plaintiffs to obtain the defendants' consent to hire assistants. *Id.* at 88.

⁸⁷ More recently, the court in *Martha Graham School and Dance Foundation, Inc. v. Martha Graham Center of Contemporary Dance*, 380 F.3d 624 (2d Cir. 2004), relied on the analysis in *Carter* in concluding that some of Martha Graham's dances were works for hire despite the high degree of artistic freedom and creative control enjoyed by the famous choreographer. *Id.* at 642. According to the court, "[t]he fact that Graham was extremely talented understandably explains the Center's disinclination to exercise control over the details of her work, but does not preclude the sort of employee relationship that results in a work for hire." *Id.* See *supra* note 74. Although choreographed works such as dances are not within the scope of VARA, they still can manifest equal degrees of creativity as the visual art covered by the statute.

⁸⁸ See Hughes, *supra* note 57, at 156 ("As much as the patron intervenes—or can intervene—in the process of intellectual production, the artist may feel that *less* of their personalities are involved in the creation.") (emphasis added); Hansmann & Santilli, *supra* note 17, at 134 ("Work for hire, in general, is work that is subject to substantial control by the person who commissions the work [and] as such, it has less connection with the personality of its creator.").

⁸⁹ See Hughes, *supra* note 57, at 154–57 (discussing cases in which the patron is a sufficient cause for the creation and exhibits control over the artistic direction); Hansmann & Santilli, *supra* note 17, at 134 ("[T]he interests of the artist that are protected by moral rights doctrine are less in evidence in work for hire than they are in other forms of creative work.").

⁹⁰ Hansmann & Santilli, *supra* note 17, at 134.

These assumptions do not necessarily reflect the realities of the process of human creation in employment situations. Therefore, they do not furnish a basis upon which to justify the work-for-hire doctrine's trumping an author's attribution and integrity interests without concern for violating the colloquial author's autonomy and dignity interests. Receipt of a monetary benefit, even pursuant to an employment relationship, does not necessarily destroy the author's desire for attribution and for the preservation of the meaning and intended message of her work. The norms of authorship which underscore moral rights operate at a level distinct from the economically focused inquiry mandated by the work-for-hire analysis. No inconsistency exists between the hiring party retaining the economic rights and the hired party retaining moral rights in cases where the hired party is responsible for the meaning and intended message of a work.

Thus, in order to determine if and how moral rights and the work-for-hire doctrine should co-exist, it is important to examine the extent to which a particular author "for hire" imbues the work with her own subjective meaning and intended message reflective of her dignity as an author, as opposed to merely executing orders dictated from the hiring party. The majority of work-for-hire cases decided under the employee prong of the statutory definition involve quasi-functional copyrightable material, such as computer programs, that cannot convey an author's meaning and message as these terms are used in this Article.⁹¹ Nevertheless, the facts giving rise to *Carter v. Helmsley-Spear, Inc.*⁹² and *Community for Creative Non-Violence v. Reid*⁹³ illustrate how theoretically, one can be an employee for purposes of a work-for-hire analysis but still produce a work that manifests the colloquial author's meaning and intended message rather than that of the hiring

⁹¹ Of the nearly seventy cases applying the "employee" prong of the work-for-hire doctrine post *Reid*, only a couple of them arguably involve VARA subject matter. *See, e.g., Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77 (2d Cir. 1995), *cert. denied*, 517 U.S. 1208 (1996), *see supra* notes 82–86 and accompanying text; *Marco v. Accent Publ'g Co.*, 969 F.2d 1547 (3d Cir. 1992); *Marshburn v. United States*, 20 Cl. Ct. 706 (1990) (involving a painted mural in the employee cafeteria). For example, in *Marco v. Accent Publishing Company*, the parties disputed ownership of highly creative photographs taken for a trade journal. 969 F.2d at 1548–49. Although the court did not discuss whether the photographs were within the scope of VARA, they would seem to be barred from coverage on the ground they were not taken "for exhibition purposes only." *See* 17 U.S.C. § 101 (definition of a "work of visual art"). *See also* Hansmann & Santilli, *supra* note 17, at 108–09 (positing that the right of integrity should be extended to work for which the "the artist's name is considered informative or useful in assessing the work," and where "the reputation of the artist is . . . based on the entire body of work [the artist] has created"); Greg R. Vetter, *The Collaborative Integrity of Open-Source Software*, 2004 UTAH L. REV. 563, 662–669 (questioning the application of conventional moral rights with respect to software).

⁹² 71 F.3d 77 (1995). *See supra* notes 82–86 and accompanying text.

⁹³ 490 U.S. 730 (1989). *See supra* notes 58–69 and accompanying text. Of course, the Court held that Reid was an independent contractor rather than an employee, but the overall facts illustrate the point made in the text. *Id.* at 752–53.

party.⁹⁴ Both of these cases involved subject matter potentially within the scope of VARA, even though the statute was not applicable in either case for different reasons.⁹⁵

To embrace both the theoretical basis for moral rights and the certainty Congress sought by crafting the work-for-hire provision,⁹⁶ any works eligible for moral rights protection should not be made to automatically forfeit this protection just because they are created for hire. In this regard, VARA's exclusion of works made for hire is problematic. A much better approach would be to provide that authors of works otherwise subject to moral rights protection retain their rights as colloquial authors, even if their works were created for hire, absent compelling reasons for divesting them of their rights.⁹⁷ One situation supporting no moral rights in a particular work-for-hire scenario is where the work in question was created under the hiring party's direction or control to such a degree that it does not represent the colloquial author's meaning and intended message. In determining whose meaning and intended message the work at issue reflects, courts should focus on the narratives of the hiring party and the colloquial author,⁹⁸ as well as the evidence pertaining to the work's creation and the exercise of artistic discretion and control. In applying this analysis to the facts of *Carter v. Helmsley-Spear, Inc.*, for example, the Second Circuit's discussion clearly reveals that the plaintiff artists "had complete artistic freedom with respect to every aspect of the sculpture's creation" and enjoyed the "right to control the manner and means" of executing the sculpture.⁹⁹

Industry norms steeped in public policy also may effectively preclude applying attribution and other integrity interests in limited situations. VARA already attempts to incorporate industry norms into its scheme, particularly with respect to the installation of art as part of buildings. For example, section 113(d)(1) states that a building owner is not liable under VARA for the destruction of artwork within the scope of VARA that has been incorporated into a building if the removal of the artwork will cause its destruction or modification, and the author consented to the work's installation prior to the effective date of VARA.¹⁰⁰ Alternatively, if the work was installed after VARA, no liability on the part of the building owner will result if the author and the building owner signed a written instrument specifying "that [the] installation of the work may subject the work to

⁹⁴ See *supra* notes 69–74 and accompanying text.

⁹⁵ See *supra* notes 79, 82–87 and accompanying text.

⁹⁶ See *supra* note 46 and accompanying text.

⁹⁷ Cf. Nancy Kim, *Martha Graham, Professor Miller and the "Work for Hire" Doctrine: Undoing the Judicial Bind Created by the Legislature*, 13 J. INTEL. PROP. L. 337, 364 (2006) (recommending reversing the statutory presumption so that a written instrument signed by both parties is required for works to be deemed created for hire).

⁹⁸ In *Phillips v. Pembroke Real Estate Inc.*, the court took note of the artist's narrative emphasizing that his "inherent reverence for natural beauty in this ecologically ravaged world" influences all of his artistic decisions. 459 F.3d 128, 130 (1st Cir. 2006).

⁹⁹ 71 F.3d 77, 86 (2d Cir. 1995).

¹⁰⁰ 17 U.S.C. § 113(d)(1) (2006).

destruction, distortion, mutilation, or other modification, by reason of its removal.”¹⁰¹ Further, for works which can be removed from a building without causing their destruction or modification, VARA applies unless the building owner has made a “diligent, good faith attempt” to notify the author of the intended removal but was unsuccessful in notifying the author, or has provided written notice to the author and the author failed to remove the work within ninety days of receiving notice.¹⁰²

Although VARA expressly incorporates viable industry standards with respect to art that has been installed in buildings, both the text of VARA and the legislative history are silent with respect to site-specific art.¹⁰³ This genre of art is “conceived and created in relation to the particular conditions of a specific site” and therefore meaningful only when it is displayed in the particular location for which it was created.¹⁰⁴ Yet, even absent specific directives, courts have been sensitive to industry norms in applying the statute in this context. A recent federal appellate court held that VARA does not apply to site-specific art.¹⁰⁵ This opinion thus displayed sensitivity to the norms of realty, particularly the real property policy disfavoring restrictions on land, especially those that are unrecorded.¹⁰⁶ More generally, the Register of Copyrights has manifested sensitivity to industry norms in its recommendations with respect to VARA’s operation, particularly regarding the statute’s provision that its protections can be waived.¹⁰⁷ As part of a

¹⁰¹ *Id.* § 113 (d)(1)(B).

¹⁰² *Id.* § 113(d)(2).

¹⁰³ *Phillips*, 459 F.3d at 143.

¹⁰⁴ *Serra v. U.S. Gen. Servs. Admin.*, 847 F.2d 1045, 1047 (2d Cir. 1988) (quoting sculptor Richard Serra). In *Serra*, a pre-VARA case, the court held that the sculptor of the site-specific work had relinquished his free speech rights in his work when he sold it to the government. *Id.* at 1049. Therefore, the government’s removal of the sculpture from Manhattan’s Federal Plaza and its subsequent relocation did not violate Serra’s First Amendment rights. *Id.* See also Justin Hughes, *The Line Between Work and Framework, Text and Context*, 19 *CARDOZO ARTS & ENT. L.J.* 19, 23 (2001) (“[R]ecognizing the artist’s claim to control the framework of her art *after* she has introduced that art into the world would burden too many other social interests.”).

¹⁰⁵ *Phillips*, 459 F.3d at 143. In so holding, the court rejected the district court’s conclusion that VARA applies to site-specific art, but its removal is permitted by VARA’s public presentation exception. *Id.* at 131. This exception provides that modifications of works that are the result of conservation or public presentation, including lighting and placement, are not actionable unless they are the result of gross negligence. See 17 U.S.C. § 106A(c)(2) (2006).

¹⁰⁶ *Phillips*, 459 F.3d at 142.

¹⁰⁷ Section 106A(e)(1) provides that although an author’s VARA rights cannot be transferred, they can be waived “if the author expressly agrees to such waiver in a written instrument signed by the author.” 17 U.S.C. § 106A(e)(1). For a detailed discussion of the study and findings of the Copyright Office, see Kwall, *supra* note 52, at 52. See also RayMing Chang, *Revisiting the Visual Artists Rights Act of 1990: A Follow-up Survey about Awareness and Waiver*, 13 *TEX. INTELL. PROP. L.J.* 129, 144 (2005) (discussing

comprehensive series of recommendations, the Register advocated that the current waiver provision be retained for all installed works regardless of whether they are incorporated into buildings.¹⁰⁸

The approach advocated in this Article suggests looking to whether, in any given instance, the colloquial author of a particular work for hire should retain the rights of authorship for purposes of VARA's protections. The colloquial author should be denied authorship rights under VARA only when "compelling circumstances" exist.¹⁰⁹ Although in such instances there may be an implied waiver of moral rights, it is important to keep in mind that an author's moral rights may be subject to limitations even in jurisdictions with the strongest moral rights protections.¹¹⁰

V. REVISITING THE WORK-FOR-HIRE DOCTRINE

The themes explored in this Article suggest the desirability of making the work-for-hire doctrine more compatible with authorship autonomy interests apart from its interface with VARA. One possible reform is to revisit section 201(b)'s provision that the employer of a work made for hire "is considered the author for purposes of this title."¹¹¹ Recall that given the work-for-hire's history as a doctrine primarily concerned with copyright ownership rather than colloquial authorship, the legislative history reveals virtually no attention to the relationship between authorship autonomy and transferring authorship status.¹¹² If this provision is examined from a fresh perspective, one that is grounded in a complete view of human creativity rather than focused only on economic rationales for protecting works of authorship, it becomes clear that little justification exists for converting the employer or commissioning party into the "author" without a more complete understanding of what rights authorship entails.

One way to make the copyright statute more sensitive to attribution and integrity interests would be to vest the employer of a work for hire with "copyright ownership" rather than "authorship status," and to retain the caveat that this result

results of a 2003 survey of 379 respondents, 308 of whom identified themselves as visual artists).

¹⁰⁸ See Kwall, *supra* note 52, at 50–51.

¹⁰⁹ Cf. Justin Hughes, *American Moral Rights and Fixing the Dastar "Gap,"* 2007 UTAH L. REV. 659, 700 n.225; Rebecca Tushnet, *Naming Rights: Attribution and Law,* 2007 UTAH L. REV. 787, 807.

¹¹⁰ In France, for example, an author is precluded from "preventing any 'adaptation of a computer program' that complies with 'the rights he has transferred' and from 'exercising his right to retract or correct.'" See 1 INTERNATIONAL COPYRIGHT LAW & PRACTICE, FRA § 7[2](a) (Paul Edward Geller & Melville B. Nimmer eds., 18th ed. 2006) (quoting Intellectual Property Code art. L. 121-7 (Fr.)). In addition, French courts have given priority to urban planning demands over authors' moral rights claims respecting architectural works. *Id.* § 7[2](b).

¹¹¹ 17 U.S.C. § 201(b) (2006).

¹¹² See *supra* note 50 and accompanying text.

can be countered with a signed written instrument stating that the employee owns the copyright in the work.¹¹³ This approach would allow any colloquial author to retain her authorship status while providing for a means of transferring ownership of the copyright in appropriate instances. It would also provide needed clarification in the application of the work-for-hire doctrine.

Of course, to the extent copyright law does not otherwise incorporate adequate protections for authors' moral rights, this approach may not ultimately prove adequate to safeguard the interests of authors who infuse their highly creative works of authorship with their personal meaning and intended message. In other words, if the law fails to recognize separately the personal rights attaching to authorship, as opposed to copyright ownership, simply allowing an author to retain her authorship status may still do little to ameliorate the fundamental lack of recognition for authorship autonomy.¹¹⁴

Another possible reform in connection with the work-for-hire doctrine is to limit its application so that works that strongly manifest the colloquial author's personal meaning and intended message are outside of its scope, thus preventing such authors from being vulnerable to losing their authorship status. Some support already exists for the idea that the work-for-hire doctrine should be applied cautiously to certain works of authorship. For example, in *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, the court declined to apply the work-for-hire doctrine to books, articles, and recordings that were created by the founder of a church.¹¹⁵ Instead, it observed that works motivated by the founder's "own desire for self-expression or religious instruction of the public [were] not 'works for hire.'"¹¹⁶ There is also recognition for this viewpoint in the Report of the Register of Copyrights on the 1976 Act's revision of the work-for-hire doctrine.¹¹⁷ In discussing the categories of "commissioned works" stipulated in the specially commissioned prong of the work-for-hire definition, the Report stated:

The addition of portraits to the list of commissioned works that can be made into 'works made for hire' by agreement of the parties is difficult to justify. Artists and photographers are among the most vulnerable and poorly protected of all the beneficiaries of the copyright law, and it seems clear that, like serious composers and choreographers,

¹¹³ See *supra* note 51 and accompanying text.

¹¹⁴ See *supra* note 37 (discussing the British distinction between authorship and copyright ownership with respect to works created by employees).

¹¹⁵ 206 F.3d 1322, 1324 (9th Cir. 2000).

¹¹⁶ *Id.* at 1326.

¹¹⁷ See REGISTER OF COPYRIGHTS, SECOND SUPPLEMENTARY REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW: 1975 REVISION BILL, ch. XI, at 12-13 (1975) [hereinafter REGISTER OF COPYRIGHTS REPORT].

they were not intended to be treated as ‘employees’ under the carefully negotiated definition in section 101.¹¹⁸

This passage displays sensitivity to the perspective that works of a certain nature should not be within the scope of this part of the definition of works made for hire.

The most developed support for this approach exists in the form of the “teacher” exception. In *Weinstein v. University of Illinois*, the Seventh Circuit emphasized the tradition under which professors retain the copyrights in their scholarly articles and other intellectual property, despite copyright law’s potential “to make every academic article a ‘work for hire’ and therefore vest exclusive control in universities rather than scholars.”¹¹⁹ Prior to the 1976 Act, the existence of a “teacher” exception to the work-for-hire doctrine had been suggested by at least one court,¹²⁰ but its continued existence following the enactment of the 1976 Copyright Act is disputed among scholars¹²¹ and unclear according to judicial precedent.¹²² Within the past several years, the Second Circuit has affirmed the existence of the teacher exception but refused to apply it because the case involved work product such as tests, quizzes, and homework problems.¹²³ In so holding, the

¹¹⁸ *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 747 n.13 (1989) (quoting REGISTER OF COPYRIGHTS REPORT, *supra* note 117, at 12–13).

¹¹⁹ 811 F.2d 1091, 1094 (7th Cir. 1987).

¹²⁰ *See Williams v. Weisser*, 78 Cal. Rptr. 542, 545 (Cal. Ct. App. 1969) (holding that common law copyright in professor’s lectures belongs to the faculty member rather than the university, absent evidence of an assignment).

¹²¹ Some commentators believe that even if cases such as *Williams v. Weisser* supported the existence of a “teacher” exception under the 1909 Act, the 1976 Act abolished such an exception. Other scholars dispute this conclusion. For a comprehensive list of commentaries on each side, see Roberta Rosenthal Kwall, *Copyright Issues in Online Courses: Ownership, Authorship and Conflict*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1, 12 (2001). *See also* Rochelle Cooper Dreyfuss, *Collaborative Research: Conflicts on Authorship, Ownership, and Accountability*, 53 VAND. L. REV. 1161 (2000) (providing an in-depth discussion of the controversy surrounding the application of the work-for-hire doctrine to academic work product).

¹²² *See Hays v. Sony Corp. of Am.*, 847 F.2d 412, 416–17 (7th Cir. 1988) (indicating, without explicitly deciding, that the teacher exception should be retained based on policy considerations and the absence of an express Congressional intent to alter the law).

¹²³ In *Shaul v. Cherry Valley-Springfield Central School District*, a high school math teacher brought a civil rights suit based on an unauthorized search of his classroom and removal of work product such as tests, quizzes, and homework problems. 363 F.3d 177, 179–81 (2d Cir. 2004). The court concluded that the plaintiff did not have a possessory interest in these teaching materials given that they constituted works made for hire. *Id.* at 185–86. *Shaul’s* analysis is unique, however, in that it addressed the “teacher” exception as a matter distinct from the application of the employee prong of the work-for-hire definition. By separately validating the “‘academic tradition’ [that grants] authors ownership of their own scholarly work,” *Shaul* provides direct support for the application of the “teacher” exception in appropriate situations. *Id.* at 186.

The cases also recognize the relevance of school or district policies regarding ownership of copyrightable material in resolving work-for-hire disputes. *See infra* note

court distinguished the subject matter involved in that case from published articles authored by university professors.¹²⁴ More recently, however, a district court in Illinois, in a case involving course materials prepared by a medical school professor, reaffirmed the teacher exception and indicated it may not be limited to faculty publications.¹²⁵

Strong policy reasons support a liberal application of the “teacher” exception, especially in the context of scholarly works of authorship produced in the university setting.¹²⁶ Even if academic authors desire widespread dissemination of their work to enhance their professional reputations, this motive does not displace the large internal investment that often motivates scholarly writing and other comparable endeavors.¹²⁷ Nor does this motive detract from the reality that such scholarly works can evidence a meaning and intended message of fundamental importance to the author. Thus, a liberal application of the “teacher” exception in this respect facilitates the author’s ability to safeguard the meaning and intended

125; see also Elizabeth Townsend, *Legal and Policy Responses to the Disappearing “Teacher Exception,” or Copyright Ownership in the 21st Century University*, 4 MINN. INTELL. PROP. REV. 209, 210 (2003) (providing a comprehensive examination of the teacher exception and noting that the current trend is to resort to individual university copyright policies). Recall that section 201(b) provides that the work-for-hire doctrine vests the hiring party with authorship status and ownership of the copyright “unless the parties have expressly agreed otherwise in a written instrument signed by them.” 17 U.S.C. § 201(b) (2006). See *supra* note 41 and accompanying text; see also Dreyfuss, *supra* note 51, at 599–600 (noting that policies announced in faculty handbooks favoring copyright retention in faculty “are unlikely to be considered signed writings within the meaning” of section 201(b)). Although these policies are relevant to work-for-hire discussions, they do not necessarily address moral rights concerns given the absence of moral rights protections available in this country to works other than certain forms of visual art.

¹²⁴ The court stated that the “‘academic tradition’ granting authors ownership of their own scholarly work is not pertinent to teaching materials that were never explicitly prepared for publication.” *Shaul*, 363 F.3d at 186. I would augment the court’s reliance on publication status as a relevant factor in applying the “teacher” exception by additionally considering whether an author in an academic setting invests his work with a fundamental, personal meaning and intended externalized message.

¹²⁵ *Bosch v. Ball-Kell*, No. 03-1408, 2006 WL 2548053, at *7 (C.D. Ill. Aug 31, 2006). The plaintiff in this case brought a copyright infringement suit against the defendant professor and a former university administrator based on their unauthorized copying and distribution of her pathology course materials. *Id.* at *1–3. The court denied the defendants’ summary judgment motion on the ground that the court could not find that the plaintiff lacked ownership of the teaching materials in light of both its reading of the teacher exception to the work-for-hire doctrine and the history of the University’s copyright policy. *Id.* at *4–8.

¹²⁶ See Roberta Rosenthal Kwall, *Moral Rights for University Employees and Students: Can Educational Institutions Do Better Than the U.S. Copyright Law?*, 27 J.C. & U.L. 53, 79 (2000).

¹²⁷ See Nimmer, *supra* note 22, at 75 (noting that the “entire incentive” for the creation of scholarly articles is “to advance the frontiers of human knowledge and . . . to win their authors recognition”).

message of her work by allowing her to maintain authorship status and to retain ownership of the copyrights to her work.¹²⁸

Just as some academic work product should not be treated as works made for hire because they embody a particular type of investment by the author, the same is true for certain other works of authorship.¹²⁹ For example, the reasons supporting the “teacher” exception for scholarly works also support a work-for-hire exception with respect to highly original works manifesting substantial creativity on the part of the colloquial author, even if the work is determined to be created by an employee rather than an independent contractor. Both an academic’s scholarly work and other highly original works manifesting a substantial amount of creativity can embody an author’s own particular meaning and intended message.¹³⁰ In determining whether the work-for-hire doctrine should apply to such highly creative work, courts should consider explicitly the degree to which the work personifies an author’s particular meaning and intended message. The colloquial author’s narrative can provide important evidence on this score just as it can operate in the context of the work-for-hire and VARA determinations discussed earlier.¹³¹

VI. CONCLUSION

The moral rights of attribution and integrity are designed to allow an author to safeguard the personal meaning and intended externalized message of her creative work. For works produced by “authors in disguise,” such as those that are anonymous, pseudonymous, or works made for hire, it is essential to consider whether and how moral rights protection can be applied. VARA failed to embrace this challenge by simply excluding such works from the scope of its protection.

The realities of works made for hire demand a nuanced analytical approach that is more in keeping with the theoretical predicate of moral rights. An author’s decision to create anonymously or under a pseudonym should be understood as a deliberate branding choice integral to the work’s personal meaning to the author and its intended externalized message. With respect to how moral rights should apply to works made for hire, the relevant issue is whether the work in question conveys the meaning and message of the colloquial author or the hiring party. In resolving particular situations, I suggest an approach that takes into account the narratives of both the hiring party and the colloquial author, as well as relevant

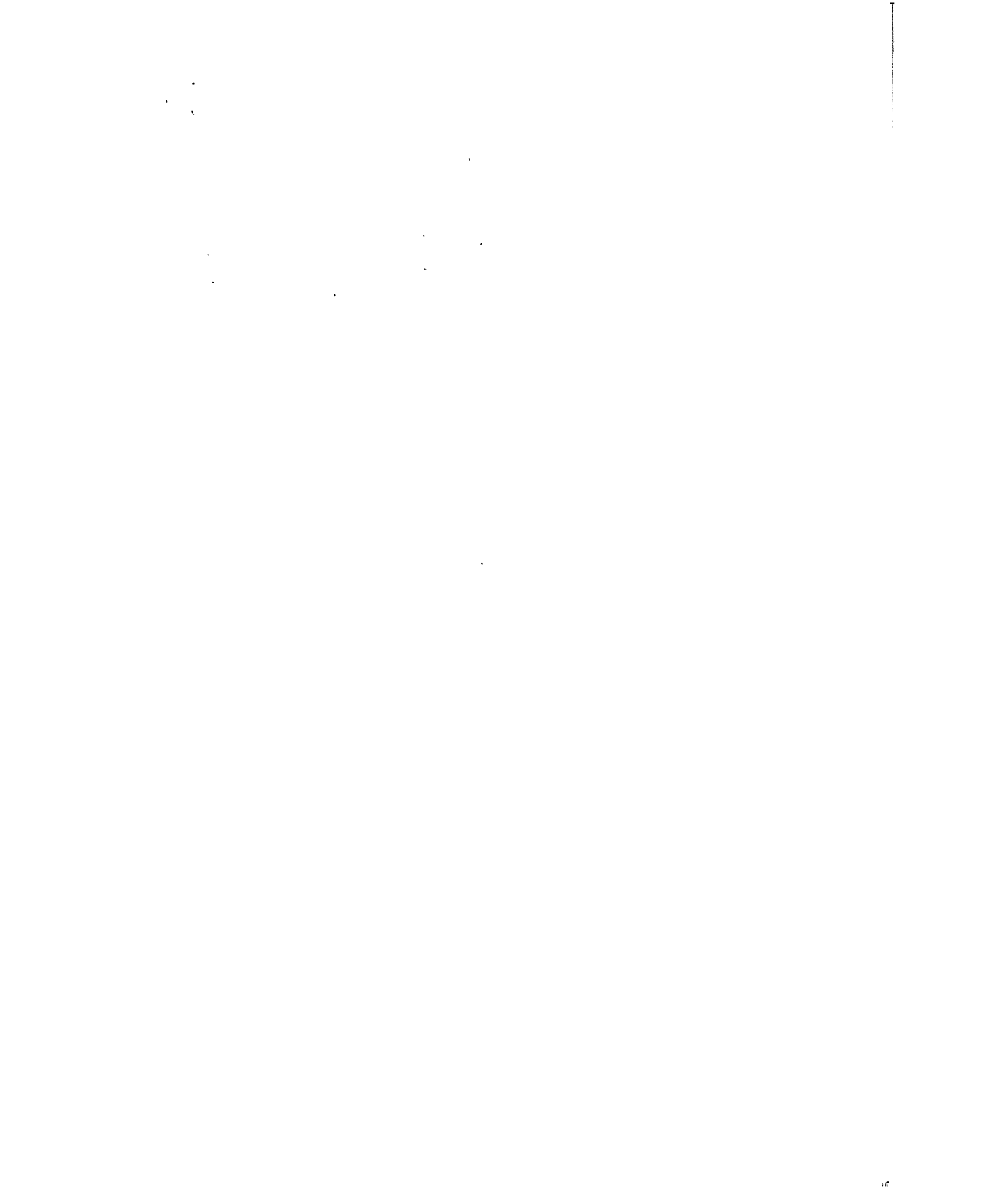
¹²⁸ For these reasons, I have argued elsewhere that universities have special responsibilities to safeguard the moral rights of authors operating within their creative environments. See Kwall, *supra* note 126, at 79.

¹²⁹ Cf. Kim, *supra* note 97, at 341 (advocating a “particularized” work-for-hire analysis that focuses on the parties’ intent in determining copyright ownership).

¹³⁰ The question of how to determine what constitutes a “highly original work” manifesting “substantial creativity” is beyond the scope of this Article. For an exploration of this issue, see Roberta Rosenthal Kwall, *Originality in Context*, 44 HOUS. L. REV. 871 (2007).

¹³¹ See *supra* notes 98–99 and accompanying text.

evidence regarding the exercise of artistic discretion and control. Industry norms reflecting compelling public policies should also be factored into the analysis where relevant. This approach is indeed very modest and can be adopted without changing VARA's substance and structure significantly. A more global question, raised but left to another time for deeper exploration, is whether the work-for-hire doctrine itself should be reformulated to exclude highly original works manifesting substantial creativity.



ACCESS DENIED

David Nimmer*

The Internet works multiple revolutions to the copyright world. One occurs in the widescale publication of material that was formerly held closely to the author's vest. That change, in turn, threatens upheaval to the copyright doctrine of "access," whereby a plaintiff has to prove a chain of custody placing her work in the defendant's purview, for all unpublished works. What should be done about opening the floodwaters to make access essentially universal? Conversely stated, is redress required for the phenomenon that defendants will be denied the safeguard of arguing that the plaintiff has failed to prove access? This piece grapples with those questions.

I. TWO ELEMENTS

A. *Of the Prima Facie Case*

The plaintiff in a copyright infringement case need prove only two elements: the plaintiff's ownership of a subsisting copyright and the defendant's copying of protectible elements from that work. The first element is trivially easy. Any hack who writes a screenplay, any software engineer who composes a subroutine, and any five-year-old who finger-paints on the kitchen table acquires a federal statutory copyright in her handiwork, subsisting for at least seventy years and perhaps well over a century. Therefore, to the extent that any dikes hold back the floodwaters of copyright litigation, they must arise out of the second element.

Copyright law, since its inception, has always striven for a balance. As Lord Mansfield cogently observed in 1785,

we must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded.¹

* © 2007 by David Nimmer, UCLA School of Law; Irell & Manella LLP. Rob Kasunic, Mark Lemley, Lou Petrich, Lon Sobel, and Jeremy Williams offered valuable feedback on the points raised herein. My thanks as well to John Tehranian for the kind invitation to participate in this symposium, for his comments, and for affording me the luxury of several research assistants, whom I also thank: André Litster, Richard Sorenson, and Jeremy Wooden.

¹ Sayre v. Moore (K.B. 1785) (Lord Mansfield, C.J.), *quoted in* Cary v. Longman, 102 Eng. Rep. 138, 139 n.(b) (K.B. 1801).

To the extent there is substance to that balance, it must come either in the panoply of defenses to the charge of copyright infringement or via barriers to establishing element number two of a plaintiff's prima facie case, given how toothless element number one actually is.

B. Of Copying

Copying, the second element of the prima facie case, in turn subdivides into two components: copying as a factual matter and copying as a legal matter. The latter is also known as *substantial similarity*. Voluminous literature explicates its contours.² That matter is not the present concern.³

² Such discussions are perennial. For a recent crop, see Lucille M. Ponte, *The Emperor Has No Clothes: How Digital Sampling Infringement Cases Are Exposing Weaknesses in Traditional Copyright Law and the Need for Statutory Reform*, 43 AM. BUS. L.J. 515 (2006); Daniel Fox, Comment, *Harsh Realities: Substantial Similarity in the Reality Television Context*, 13 UCLA ENT. L. REV. 223 (2006); Jennifer Understahl, Note, *Copyright Infringement and Poetry: When is a Red Wheelbarrow The Red Wheelbarrow?*, 58 VAND. L. REV. 915 (2005). When I served as a judge on behalf of ASCAP for its annual Nathan Burkan competition, we awarded second prize to Mark Avsec, "*Nonconventional Musical Analysis and 'Disguised' Infringement: Clever Musical Tricks to Divide the Wealth of Tin Pan Alley*," 52 CLEV. ST. L. REV. 339, 344–51 (2004).

³ Much rarer than discussions of copying as a legal matter, see *supra* note 2, are articles confronting copying as a factual matter. The fountainhead is Alan Latman, "*Probative Similarity as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement*," 90 COLUM. L. REV. 1187 (1990). Later discussions, up to the present, have tended to be very brief, often only in a footnote. See, e.g., John A. Odozynski, *Infringement of Compilation Copyright After Feist*, 17 U. DAYTON L. REV. 457, 493 n.154 (1992); Jeanne English Sullivan, *Copyright for Visual Art in the Digital Age: A Modern Adventure in Wonderland*, 14 CARDOZO ARTS & ENT. L.J. 563, 601–04 (1996); Loren J. Weber, *Something in the Way She Moves: The Case for Applying Copyright Protection to Sports Moves*, 23 COLUM.-VLA J.L. & ARTS 317, 330 n.57 (2000); Melanie Costantino, Note, *Fairly Used: Why Google's Book Project Should Prevail under the Fair Use Defense*, 17 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 235, 247–50 (2006); B. MacPaul Stanfield, Note, *Finding the Fact of Familiarity: Assessing Judicial Similarity Tests in Copyright Infringement Actions*, 49 DRAKE L. REV. 489, 495–512 (2001); cf. Michelle Brownlee, Note, *Safeguarding Style: What Protection is Afforded to Visual Artists by the Copyright and Trademark Laws?*, 93 COLUM. L. REV. 1157, 1164 n.28, 1163–65, 1181 (1993) ("Nimmer adopted the term 'probative similarity' from Professor Alan Latman who suggests its use in order to avoid confusion with 'substantial similarity.'" (citing 3 NIMMER ON COPYRIGHT, *infra* note 6, at § 13.01[B])). For some lengthier discussions, see Aaron M. Broaddus, *Eliminating the Confusion: A Restatement of the Test for Copyright Infringement*, 5 DEPAUL-LCA J. ART & ENT. L. & POL'Y 43, 49–55, 68–80 (1995); Douglas Y'Barbo, *The Origin of the Legal Standard for Copyright Infringement*, 6 J. INTELL. PROP. L. 285, 286–96, 311–15 (1999).

C. Of Copying as a Factual Matter

Copying as a factual matter is again subdivided into two ingredients: access and *probative similarity*.⁴ The latter refers to similarities that, in the normal course of events, one would expect to arise only by virtue of copying, not by coincidence. Any time a plaintiff charges a defendant with copying, there are two possibilities, as a factual matter: either the defendant copied from plaintiff's work or the defendant did not copy from plaintiff's work.

Given the current⁵ impossibility of looking inside the defendant's head and tracking all movements throughout her lifetime, the law has developed a substitute for direct evidence of actual copying. Implicated here are two ingredients: the defendant's access to plaintiff's work plus probative similarities between the defendant's and plaintiff's work, which together tend to evidence that the one was copied from the other.⁶

D. Of Access

"Access" is defined as sufficient dissemination of the work to create a reasonable possibility that the defendant experienced it—read it in the case of a literary work, heard it in the case of a musical work, saw it in the case of an audiovisual work or a sculpture, etc. In turn, there are two major types of access:⁷

⁴ Confusingly, many cases also refer to this doctrine as "substantial similarity." See *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975) (stating that "substantial similarity is not always substantial similarity"). Latman's pathbreaking article, cited above, counseled the terminology "probative similarity" for current purposes. See Latman, *supra* note 3, at 1204. Since its publication, many courts have followed suit and adopted that term. See, e.g., *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70, 74–75 (2d Cir. 1997) (stating that "probative similarity" is the better term for the threshold for copying as a factual matter).

⁵ For an alternative future, see *infra* Part III.A.

⁶ The source of much difficulty with respect to access is the inverse ratio rule: To the extent that great evidence exists of probative similarity, correspondingly less proof of access is required. For instance, consider a screenplay that juxtaposes Florence Nightingale, Utnapishtim, Giuditta Pasta, and Evelyn Waugh. If someone else were to come up with a rival screenplay featuring precisely those same four characters, the probative similarities between the two works would be extremely high. In that instance, less evidence of access would be required than, say, an instance of one screenplay featuring four current members of the Los Angeles Lakers, suing a rival screenplay likewise featuring the same four Lakers. See 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[D] (2007) [hereinafter NIMMER ON COPYRIGHT]. Given that the conceptual confusion occasioned by the inverse ratio rule stands apart from the issues that form the core of the current investigation, that issue does not play into the discussion set forth in this article.

⁷ See *Repp v. Lloyd Webber*, 947 F. Supp. 105, 114 (S.D.N.Y. 1996) (holding that access can be demonstrated by either establishing that the work has been widely

*general publication*⁸ or, in the case of an unpublished work, bringing an exemplar within the defendant's *chain of control*.⁹

The chain of control can proceed down many links. For example, Erin could prove that she gave ten copies of her screenplay to her brother-in-law Noah, a self-proclaimed publicist; of those ten copies, Noah placed one with Adam, his CPA; and Adam took a meeting with Zach, the assistant producer of the movie that the defendant ultimately produced and claims to have pitched the idea to Zach at that juncture.

In the case of a generally published work, by contrast, there is no need to prove the existence of those individual tradents. Instead, after umpteen copies of a work have been disseminated, it becomes reasonably possible that the defendant got hold of one such published copy. Note that "access" is defined as the reasonable *opportunity* to see a work; it is not properly defined as proof that the defendant *actually* saw the work. To require such actual proof would return us to the situation in which lifetime tracking of the defendant's movements would be required,¹⁰ an impossibility under current constraints.¹¹ Instead, when a book has been published and myriad copies distributed to stores and libraries all over the country, a reasonable possibility arises that the defendant might have come across one.¹²

* * *

Wending our way backwards, the taxonomy of copyright reveals a series of dichotomies. To begin, a copyright case has two elements; the plaintiff's ownership of a work and the defendant's copying of the work. The second element, copying, has a legal and a factual component; the latter divides into

disseminated, or "a particular chain of events exists by which the alleged infringer might have gained access to copyrighted work").

⁸ See *Odegard, Inc. v. Costikyan Classic Carpets, Inc.*, 963 F. Supp. 1328, 1336 (S.D.N.Y. 1997) (stating that access may be inferred "when a plaintiffs' [sic] works have been widely disseminated").

⁹ See *Sanford v. CBS, Inc.*, 594 F. Supp. 711, 712-13 (N.D. Ill. 1984) (denying summary judgment to defendant on question of access, given alleged submission of tape of plaintiff's song to defendant CBS's office in Illinois, which allegedly sent the tape to CBS's office in Los Angeles, where it was allegedly made "available" to CBS artists, at a time when CBS allegedly knew that defendant Michael Jackson was looking for a song to perform with Paul McCartney, and that Jackson allegedly was "in frequent contact" with CBS).

¹⁰ Jeremy Williams points out that a middle ground also exists, in the form of other evidence. A witness could testify, "I remember having a discussion with defendant about plaintiff's novel, which we were both reading." Or a book store receipt could equally prove that defendant bought a copy of plaintiff's novel. But such examples are the rare exception in copyright litigation.

¹¹ See *infra* Part III.C.

¹² But note the divergent ruling regarding a publication of 17,000 items. See *infra* Part II.D.

probative similarity and access. In turn, access can be proven through a direct chain or generally via publication. That last angle furnishes the operative questions here: How does publication establish access as one of the subcomponents of a copyright case, and how can the doctrine of access be modified to respond to increased incidence of Internet publication?

II. WHAT IS ACCESS?

Access requires more than “mere speculation or conjecture.”¹³ Instead, there must be a reasonable possibility of viewing the plaintiff’s work—not a bare possibility.¹⁴ *Palmieri v. Estefan* provides a good illustration.¹⁵ In that case, the plaintiff presented testimony that Gloria Estefan was present in a room with 15,000 records, including one containing the plaintiff’s song. Absent more—testimony that she started listening to some of them would have been a good start—there was no more than a bare possibility that she was exposed to one of plaintiff’s songs, which was insufficient to demonstrate access.¹⁶

Thus, performance of a song at a dormitory in Haifa does not establish access, absent further proof that defendants or someone associated with them happened to be present at that performance.¹⁷ However, performance in a place where it is reasonably likely that defendant was located produces a different dynamic.¹⁸ For instance, proof of performance of a song at a dormitory in Haifa in spring 2004 would suffice against me as a defendant, inasmuch as the Faculty of Law housed me there when I taught a class on international copyright at the University of Haifa.

¹³ See *Murray Hill Publ’ns, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 316 (6th Cir. 2004) (citations omitted).

¹⁴ See *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 482 (9th Cir. 2000).

¹⁵ 35 U.S.P.Q.2d (BNA) 1382, 1383 (S.D.N.Y. 1995).

¹⁶ See *id.*

¹⁷ See *Spiegelman v. Reprise Records*, 35 U.S.P.Q.2d (BNA) 1732, 1733 (S.D.N.Y. 1995), *aff’d mem., remanded in part*, 101 F.3d 685 (2d Cir. 1996). In this case involving the alleged performance of a song at a dormitory in Haifa, plaintiff alleged an additional performance in Greenwich Village—but that locale was equally unconnected to defendants.

¹⁸ Consider that in *Wilkie v. Santly Bros.*, 13 F.Supp. 136 (S.D.N.Y. 1935), the plaintiff never published the song “Confessing,” but did privately perform it for a small number of people at different times before 1929, thus creating the possibility that defendant heard it before composing his own song “Starlight” in 1931. *Id.* at 136 (“[I] cannot say that it is entirely improbable that at some time prior to 1931, [the defendant] may have had access to the melody ‘Confessing.’”).

A. Publication

For current purposes, general publication must be distinguished from the copyright doctrine of publication.¹⁹ The definition of general publication appears on the face of the statute as “the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication.”²⁰

Throughout copyright law, tremendous significance attends the distinction between generally published works and all others.²¹ To cite some examples, under the 1909 Act, generally published works required a copyright notice, whereas all others did not. Under the current Act, generally published works are protected only when connecting factors with the United States are present, whereas all unpublished works are protected categorically (i.e., even in the absence of such connecting factors).²² To illustrate, a work authored by an Afghani and first published in Iran reposes in the public domain for purposes of U.S. copyright law.²³ If unpublished, however, it is fully protected under the statute.²⁴ If intelligent life exists on the sixth planet circling Antares, its unpublished literature currently finds protection under U.S. copyright law (though collection of royalties may pose headaches).

Consider the implications of general publication for a copyrighted work of art. If Artist paints ten canvasses and offers them for \$20,000 a pop at an opening held in 1995 at Gallery, then each has been published.²⁵ It may eventuate that nobody

¹⁹ The term “publication” is susceptible to a wide array of meanings. Judge Frank has warned against the “one word one meaning fallacy,” given that it is “perfectly clear that the word ‘publication’ does not have the same legal meaning in all contexts. Its copyright definition, for example, differs from its meaning where applied in respect of torts or in respect of privacy.” *Am. Visuals Corp. v. Holland*, 239 F.2d 740, 743 (2d Cir. 1956) (citations omitted).

²⁰ 17 U.S.C. § 101 (2000).

²¹ In some instances, dubbed “limited publication,” publication does not trigger the normal consequences that accompany that term. *See* 1 NIMMER ON COPYRIGHT, *supra* note 6, at § 4.13[A]. In turn, those considerations generate distinctions between “investive” and “divestive” publication. *Id.* § 4.13[C]. Happily, those additional matters lie beyond current concerns.

²² For a catalog of fifteen bases of significance under the current Copyright Act, as well as a host of additional reasons under the predecessor 1909 Act, see 1 NIMMER ON COPYRIGHT, *supra* note 6, at § 4.01.

²³ An exception would apply, however, to the extent that, within one month of its Iranian publication, the work were republished in a Berne Convention nation or other locality with which the United States has copyright treaty relations. *See* 17 U.S.C. § 104(b).

²⁴ *See* 17 U.S.C. § 104(a).

²⁵ The reason is that the opening constitutes an “offering to distribute copies . . . to a group of persons for purposes of further distribution” and also “for purposes of . . . public display.” 17 U.S.C. § 101.

buys, except that, out of pity, Mother buys the painting entitled *Oedipus Wrecks* for \$300. The others—*Colonnus*, *Thebes*, *Chula Vista*, etc.—remain unsold through Artist's life, and are relegated to a niece's attic after Artist's death. Nonetheless, as of 1995, each of the ten works has been generally published.

There is actually one more sentence in the statutory definition of general publication: "A public performance or display of a work does not of itself constitute publication."²⁶ Again, consider the implications. Let us imagine that Sculptor refuses to sell any of her works but consents to the installation of *Electra Magnetism*, a 50-foot high bronze, in the rotunda of Grand Central Station, where upwards of fifty thousand people pass by it every day. Despite how familiar the work might become, it nonetheless remains "unpublished" in the eyes of the Copyright Act.

B. Exceptional Circumstances

The consequences are ironic. Millions may have seen *Electra Magnetism* and know it intimately, yet, it could remain "unpublished." Conversely, only a handful of people has ever seen *Chula Vista* as it remains under lock and key, but the work is technically "published." Still, for purposes of the many implications of copyright law, it is the technical definition that applies, notwithstanding these ironic results.

Nonetheless, a few copyright domains contain wiggle room. One example is *Harper & Row, Publishers, Inc. v. Nation Enterprises*,²⁷ in which the Supreme Court granted special deference under the second fair use factor to "unpublished" works.²⁸ The term "unpublished" occurs a score of times in the majority opinion before it concludes that "the unpublished nature of a work is a key, though not necessarily determinative, factor tending to negate a defense of fair use."²⁹

Still, if Sculptor filed for infringement of *Electra Magnetism*, she might encounter a robust fair use defense. Another term that the majority opinion intones multiple times is "confidentiality."³⁰ The bottom line in *Harper & Row* is that the "scope of the fair use doctrine is considerably narrower with respect to unpublished works *which are held confidential by their copyright owners*."³¹ Having sacrificed confidentiality in this most public of displays, Sculptor would be

²⁶ *Id.*

²⁷ 471 U.S. 539 (1985).

²⁸ *Id.* at 554. See 17 U.S.C. § 107(2). Later Second Circuit rulings distorted the holding of *Harper & Row v. Nation*, forcing Congress to amend the statute. See H.R. REP. NO. 102-836, at 8 (1992). See generally 4 NIMMER ON COPYRIGHT, *supra* note 6, at § 13.05[A][2][b] (remarking that, even though the Second Circuit "apparently imported a bright line rule against fair use of unpublished excerpts," Congress's later amendment reaffirmed the holding of *Harper & Row*).

²⁹ *Harper & Row*, 471 U.S. at 554 (internal quotation marks omitted).

³⁰ *Id.* at 564 ("A use that so clearly infringes the copyright holder's interests in confidentiality and creative control is difficult to characterize as 'fair.'").

³¹ *Id.* at 597 (Brennan, J., dissenting) (quoting 3 NIMMER ON COPYRIGHT, *supra* note 6, at § 13.05[A]) (emphasis added by Justice Brennan).

hard-pressed to make significant headway on the second fair use factor. This example demonstrates that the line separating published from unpublished works is not the touchstone for all copyright purposes.³²

C. Implications for Access

Likewise, in the case of access, there is wiggle room from strictly adhering to the technical definition of general publication. Classically, access inheres in a reasonable opportunity to view. That test largely subsumes works that have been generally published. After all, if a novel has sold 20,000 copies or if a film has been in general circulation, then no defendant should be heard to deny having had a reasonable opportunity to view it.

Nonetheless, there are exceptions. Consider, first, that a million copies of the Dear Leader's memoirs might have been sold throughout North Korea; does that fact alone make the work accessible to U.S. defendants? Even if perennially atop the bestseller list of the Hermit Kingdom, that evidence of access would still seem to fail as to a U.S. defendant. In other words, the mere fact that myriad copies might exist in proximity to Juche Tower does not create a reasonable possibility that Jane Thomas of Greensboro, hauled before the Middle District of North Carolina, had access to them. In this instance, therefore, general publication fails to create access.

Correlatively, even wide-scale dissemination within the United States might be inadequate to establish a reasonable possibility of access to given individuals. Let us imagine a community of Amish wagon-makers in Alaska. One of their number, Plain Percy, becomes an established novelist. A screenwriter sues Percy, alleging the plot of his latest novel was purloined from her hit television show. Normally, a successful TV show would be widely disseminated, sufficiently to dispel any doubt that the element of access has been established. Nonetheless, if the evidence were to show that the particular hit television show was shown on saturation coverage throughout the Southwest but not in any other part of the country,³³ and that Percy himself³⁴ had never left Alaska, where the show had

³² Many more nuances are lurking here. For instance, a work may have been disseminated so widely as to become a popular icon. But if that activity took place without the proprietor's permission, then it remains "unpublished" in the eyes of the Copyright Act. *See Zito v. Steeplechase Films, Inc.*, 267 F. Supp. 2d 1022, 1026 (N.D. Cal. 2003) (noting that defendant's unauthorized dissemination of plaintiff's unpublished Ansel Adams photograph failed to constitute "publication").

³³ For current purposes, we discount the possibility that the Internet has broken down geographic barriers and raised the possibility that all television shows can now be seen everywhere. If the evidence were to show that that possibility had been realized as to the timeframe governing the litigation as to the parties in court, access would be established.

³⁴ Percy may well be the exception contemplated in the observation, "Virtually every adult in this country has had 'access' to the copyrighted photographs published in Playboy® Magazines." *Playboy Enters. v. Starware Publ'g Corp.*, 900 F. Supp. 433, 437 (S.D. Fla. 1995) (emphasis added).

never been screened, then evidence of access could be deemed lacking in that instance.³⁵

In a nutshell, then, the second way of establishing access is through general publication, but with a twist. The key ingredient is that the subject work be sufficiently disseminated so that the defendant had a reasonable opportunity to view it.

D. Outfoxed

But a variant ruling immediately interposes itself.³⁶ In *Rice v. Fox Broadcasting Co.*, a plaintiff alleged that Fox Broadcasting Company infringed his videotape, *The Mystery Magician*, which featured a hooded star revealing secrets behind famous illusions.³⁷ The district court granted the defendant's summary judgment motion based on an absence of substantial similarity after concluding that the distribution of 17,000 copies of a videotape defeated Fox Broadcasting's defense of no access.³⁸ Despite the trial court's comprehensive opinion on the subject, the Ninth Circuit reached a very different result: It affirmed summary judgment, not on the basis relied on below, but instead on the alternative basis (rejected below) that access was lacking as a matter of law.³⁹ Without citing any precedent or other authority, it concluded that a work sold on 17,000 videotapes "cannot be considered widely disseminated."⁴⁰ Though certainly, given a blockbuster motion picture, the sale of only 17,000 videotapes or DVDs would be considered a crushing disappointment, it scarcely follows that 17,000 extant copies renders the subject work effectively inaccessible.

As a synthesis of prior holdings, it is submitted that the Ninth Circuit's holding is in error.⁴¹ "Access" connotes that the defendant had a reasonable opportunity to view plaintiff's work. Given that plaintiff sold 17,000 copies of *The Mystery Magician*, it is hardly unreasonable to imagine that the defendant, Fox Broadcasting Company (or one of its many agents), had an opportunity to view the videotape before producing and airing a special featuring a disguised magician explaining how famous tricks are performed. To the extent that the district court properly ruled for defendants, it is because it meticulously analyzed how the expression of the two shows differed and how actionable similarity was lacking as

³⁵ See *McRae v. Smith*, 968 F. Supp. 559, 562, 565 (D. Colo. 1997) (holding that the regional dissemination of 500 copies and performance in places where the defendants were not located was inadequate to establish access).

³⁶ This discussion is drawn from 4 NIMMER ON COPYRIGHT, *supra* note 6, at § 13.02[A].

³⁷ 148 F. Supp. 2d 1029, 1035–36 (C.D. Cal. 2001).

³⁸ *Id.* at 1049, 1054.

³⁹ *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1180–81 (9th Cir. 2003) (reversing the disposition of Rice's false advertising claim).

⁴⁰ *Id.* at 1178.

⁴¹ Ironically, however, it might light the way towards a new future. See discussion *infra* Parts II.E., III.A.

a matter of law, not because no reasonable fact finder could have found access under the facts presented.

Rice has attracted essentially no support in subsequent cases.⁴² Its logic⁴³ appears to conflate the widescale availability required for access with massive popularity.⁴⁴ Prior cases establish a very different proposition: “Ordinarily, of

⁴² Although dozens of cases have cited to the Ninth Circuit opinion in *Rice v. Fox Broadcasting Co.*, only one follows its access holding. In particular, *Mestre v. Vivendi Universal Co.*, No. CV-04-442 MO, 2005 U.S. Dist. LEXIS 41024 (D. Or. Aug. 15, 2005), found the sale of 211 copies not to be a “wide dissemination,” *id.* at *11. Still, even that ruling is much more defensible than the Ninth Circuit’s holding, given the wide gap separating 211 from 17,000. *Rice*, 330 F.3d at 1178–79.

⁴³ At one point, the court states that plaintiff’s theory of access rests in addition on “a very complex and intricate web of inferences.” *Rice*, 330 F.3d at 1178.

⁴⁴ Dicta in a recent district court case inclines towards the same fallacy. The court justified its holding that a cartoon character was not widely disseminated with the following statement of the rule and parenthetical summary of relevant caselaw:

Silberstein has contended that her *Sqrat* was widely disseminated in the media, and argues that this widespread dissemination should allow an inference of access. This court has consistently recognized widespread dissemination giving rise to an inference of access exclusively in cases where the allegedly infringed work has had considerable commercial success or is readily available on the market. *See ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988 (2d Cir. 1983) (access inferred where song was number one on the popular music charts for weeks in the United States and England); *Arnstein v. Porter*, 154 F.2d 464, 469 (2d Cir. 1946) (finding access inferable where “more than a million copies of one of [plaintiff’s] compositions were sold; copies of others were sold in smaller quantities or distributed to radio stations or band leaders or publishers, or the pieces were publicly performed”); *Well-Made Toy Mfg. Corp. v. Goffa Int’l Corp.*, 210 F. Supp. 2d 147, 165–66 (E.D.N.Y. 2002) (defendant’s principal decided to design and market product only after learning that plaintiff’s similar product was “selling well in the United States”); *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 988 F. Supp. 289, 293 (S.D.N.Y. 1997) (drawing inference of access based on widespread dissemination, where allegedly infringed song was a top-five country hit at time of alleged infringement); *Repp v. Lloyd Webber*, 947 F. Supp. 105, 115 (S.D.N.Y. 1996) (no finding of widespread dissemination when “greatest commercial success” of musical containing allegedly infringed song occurred two years after creation of allegedly infringing work); *Iris Arc v. S.S. Sarna, Inc.*, 621 F. Supp. 916, 918 (S.D.N.Y. 1985) (widespread dissemination found where plaintiff marketed its products nationwide, advertised them in an annual catalogue and in trade magazines, exhibited them at frequent trade shows, and had them on permanent display in showrooms in sixteen cities). Plaintiff provides no such evidence of commercial success here; no inference of access may therefore be drawn from media coverage absent any signs that *Sqrat* was, even for a moment, popular or widely available for public consumption.

course, after a literary work is published, it is accessible to every one."⁴⁵ Access becomes an issue only in instances when "the publication in which the synopsis appeared is not one in general circulation, accessible to any one who pays the price. It was evidently not for sale to the general public and was sent to a selected list only."⁴⁶

E. Nooks and Niches

The above considerations raise to the fore the question of niche publication. It would seem legitimate to hold that such limited publications do not prove access generally but only to those in the same niche. But when a work has been made generally available throughout a locality, then access exists as to everyone residing therein. For instance, *Repp v. Lloyd Webber*⁴⁷ upheld a finding that the allegedly infringed work was not widely disseminated because it appealed to a "specialized religious market."⁴⁸ Nonetheless, it would seem that defendant Andrew Lloyd Webber actually did inhabit the same niche, inasmuch as he "composes liturgical works" and is "fond of church music."⁴⁹ Perhaps a better explanation for this ruling, therefore, is that the plaintiff composer was unable to provide "documentary proof of the number of copies of [the song] actually distributed to the public in album, tape or cassette form."⁵⁰ A better illustration, therefore, is *Iris Arc v. S.S. Sarna, Inc.*,⁵¹ in which crystal sculptures were deemed "widely disseminated" because they were marketed nationwide, advertised in an annual catalogue, exhibited at trade shows, and on permanent display in the showrooms of sixteen different cities,⁵² given the further evidence that "[p]laintiff and defendants both participate[d] in the same trade shows, and . . . maintained offices in the same building in New York City."⁵³

Of course, the issue remains of insular communities, such as the Amish invoked above.⁵⁴ Let us imagine the case of *Herman's Hermits v. Howard Hermit*. It seems logical that, if the defendant claimed to be a hermit totally outside popular culture, nonetheless, he had a reasonable opportunity to hear the plaintiff's song, to

Silberstein v. Fox Entm't Group, Inc., 424 F. Supp. 2d 616, 627 (S.D.N.Y. 2004). Ultimately, that holding appears to have more to do with a theory of access via widespread publicity than via general publication. Accordingly, even it does not support the gloss of *Rice v. Fox Broadcasting Co.*

⁴⁵ Echevarria v. Warner Bros. Pictures, 12 F. Supp. 632, 638 (S.D. Cal. 1935).

⁴⁶ *Id.*

⁴⁷ 132 F.3d 882 (2d. Cir. 1997).

⁴⁸ *Id.* at 890 (citation omitted).

⁴⁹ *Id.* at 890 (quoting *Repp v. Lloyd Webber*, 858 F. Supp. 1292, 1302 (S.D.N.Y. 1994)).

⁵⁰ *Id.* at 887.

⁵¹ 621 F. Supp. 916 (E.D.N.Y. 1985).

⁵² *Id.* at 918.

⁵³ *Id.* at 921.

⁵⁴ See *supra* Part II.C.

the extent it was continuously broadcast over the airwaves where he lived. Under this formulation, the element of access would be established. Nonetheless, the fact finder would be free to rule in favor of Howard, by crediting his testimony that he did not own a radio and had never heard one.

III. THE CHALLENGES OF TECHNOLOGY

Technology threatens to disrupt many aspects of copyright doctrine, including the issue of access here under review.

A. *The Future*

Let us imagine the realization of Jeremy Bentham's *Panopticon*, whereby everybody could see anything. In the future, perhaps our whole lives will be viewable on YouTube. At that omega point, once there is a record of everyone doing everything, then the surrogate equation of

access + probative similarity = copying as a factual matter

would no longer pertain.⁵⁵ For, in that world, if a plaintiff alleged that defendant copied her work, it would suffice to rewind the tape of the defendant's life, tracking his movements at every moment. To the extent that we saw him avidly reading plaintiff's work and taking notes thereon, copying as a factual matter would be established. On the other hand, to the extent that we observed that he was never exposed to the plaintiff's work throughout his lifetime, copying as a factual matter would be negated.

B. *The Past*

Things have not gone that far. On the other hand, they have produced an entirely different world from the one in which the above equation arose. Historically, the millions of poems, letters, stories, photographs, drawings, etc., created by members of the public were not subject to federal statutory protection.⁵⁶ Rather, only a minuscule fraction of all such works achieved that distinction.⁵⁷

The primary method of securing federal copyright under the 1909 Act was via *publication*. Among the myriad manuscripts submitted to publishing houses, only a small fraction was deemed worthy of their efforts. Those small few became

⁵⁵ See *supra* Part I.C.

⁵⁶ See 1 NIMMER ON COPYRIGHT, *supra* note 6, at § 2.02 (recounting history of how common law copyright protection radically contracted with passage of the Copyright Act of 1976).

⁵⁷ See 2 NIMMER ON COPYRIGHT, *supra* note 6, at § 7.16[A][2][c][i] (recounting how a tiny fraction of unpublished works could achieve statutory protection under Copyright Act of 1909 via registration).

published works.⁵⁸ The act of publication not only conferred a merit badge upon the author,⁵⁹ but also established the ingredient of access. As to unpublished works, their authors could not file suit for copyright infringement, no matter how great the similarities, unless they could show a chain of control.⁶⁰ In other words, if Joan Nobody wrote a screenplay that bore an uncanny resemblance to the latest release from Twentieth Century Fox, Joan would be without remedy under copyright law unless she could show that her screenplay actually made it across Fox's transom.⁶¹

C. *The Present*

An entirely different dynamic now arises in the Internet era. The domain of general publication is no longer limited to those who convince a publishing house of the marketability of their words. Instead, self-publishing has emerged with a vengeance.⁶² No longer need Joan remain nobody. If Random House and Simon & Schuster refuse to acknowledge the lucidity of her prose, an alternative vehicle is at hand to ensure that millions of people can read her deathless descriptions: the Internet.

Imagine that some demon established a site called "wycca.com," an acronym for "Win Your Copyright Case—Access!" The organizers of the site, for \$100, are willing to post the screenplay that any warlock in Hollywood has ever written. Once posted, those screenplays become accessible to every writer, producer, director, and agent in Hollywood. Now, to prove the factual copying prong of copyright infringement, it is only necessary to show probative similarities between the latest motion picture and the posted screenplay.⁶³ Access becomes automatically established by virtue of the posting of the screenplay on wycca.com.⁶⁴ For, in that venue, it is reasonably possible that the producers of the motion picture reviewed it.

⁵⁸ For a series of graphics charting the explosion in works subject to statutory copyright from the 1909 Act to the present, see David Nimmer, *Copyright in the Dead Sea Scrolls*, 38 HOUS. L. REV. 1, 180–90 (2001).

⁵⁹ See RICHARD A. LANHAM, *THE ECONOMICS OF ATTENTION* 1 (2006).

⁶⁰ See *supra* Part I.D.

⁶¹ Recall the links from brother-in-law to hair stylist to production assistant imagined above. *Id.*

⁶² See *The Joy of Self-Publishing*, <http://podwriting.wordpress.com> (last visited Nov. 28, 2007).

⁶³ See *supra* Part I.C.

⁶⁴ I take this result to follow from the structure of the Web. When works are posted there with authorization, everyone in the world is invited to visit the site and download onto their own computer the material that has been uploaded there. The copies that will be resident on each of those home computers is owned by their respective owners, not by the copyright proprietor. Hence, the subject work has presumably been published; but even if that result does not technically follow, it has certainly become accessible, in the manner of *Electra Magnetism*, the 50-foot statue in Grand Central Station, hypothesized above. See *supra* Part II.A.

Plainly, something is broken if the safeguard of access is effectively eliminated from the case law. No longer will many cases of aspiring screenwriters be eliminated through their failure to be able to prove the ingredient of access. Instead, wycca.com will make such proof automatic in all cases. A witch's brew threatens to swallow traditional copyright safeguards.

IV. SEARCHING FOR SOLUTIONS

We have now reached the domain of "access denied." Where access formerly stood as a safeguard for defendants, a hurdle that plaintiffs had to vault to state a prima facie case of copyright infringement, devices such as wycca.com could effectively flatten that barrier. Thus, defendants would be denied access as a viable shield from liability.⁶⁵ So what is the solution? A variety of techniques could be used to restore the necessary balance to copyright law. Consider the four following options.

The first possible option is to keep the plaintiff's prima facie case as difficult to prove as it has traditionally been. Given that access has become so much easier to prove, the solution would be to vastly strengthen the coordinate element of copying as a legal matter. In other words, the requirements for proving substantial similarity between the plaintiff's and the defendant's works could be tightened up considerably.

Another possibility is to balance the increasing ease of proving the plaintiff's prima facie case by making it increasingly easy for the defendant to prove any of the pertinent copyright defenses. For instance, fair use could be strengthened, to cite but one example.

From the opposite perspective, we could decide to do nothing. Though technology has brought new dynamics to this aspect of copyright law, a thousand other aspects of the field have likewise been rent asunder, but Congress has not intervened in each instance.

The final possibility is to redefine "access." We could no longer look in general to a reasonable possibility of copying, but could narrow the circumstances that qualify. Let us expand on each of those possibilities.

A. Tighten-up Substantial Similarity

The standards for proving substantial similarity in a copyright case emanate from judge-made law rather than from any act of Congress.⁶⁶ Thus, courts could come up with new formulations without the need for any legislative amendment. That is the easy part.

⁶⁵ The matter could be phrased alternatively from the plaintiffs' perspective, as *Access (Always) Granted*. However denominated, the tilt to traditional copyright doctrine is the same.

⁶⁶ See 4 NIMMER ON COPYRIGHT, *supra* note 6, at § 13.03.

When it comes time to define what the substance of a reformulated substantial similarity defense should be, the problems begin. Traditionally, most circuits have followed the audience test by looking to the “spontaneous and immediate” reaction of the public to the two works.⁶⁷ That test stands accused of betraying the purposes of copyright law by allowing sophisticated and disguised copying to escape liability.⁶⁸ However, new circumstances could call forth the need for new exigencies. Thus, one solution would be to move copyright law toward a trademark standard of likelihood of confusion in the marketplace.⁶⁹ Such a radical upheaval, lying well beyond the scope of this article, would need to be extensively vetted on its own merits, its congruence tested against the problem that it purports to redress.

B. Strengthen Copyright Defenses

The current statute contains special relief for matters as diverse as distribution of Braille works⁷⁰ and performances by nonprofit horticultural organizations.⁷¹ Congress could add any number of new exemptions to the Copyright Act. Alternatively, it could bolster the catch-all defense under copyright law, fair use.⁷²

Such proposals may or may not represent good policy. But, for current purposes, they seem too blunt to remedy the access problem. Let us start with a general defense. Given that exemptions are geared at specific situations, whereas the access problem threatens to become pandemic,⁷³ there is an unbridgeable disconnect between a new defense and the issue that calls forth its existence.

At first blush, fair use seems more promising. For the defense, in its second factor, already places great significance on the unpublished nature of the plaintiff's work.⁷⁴ Thus, both Congress and the courts have tried to calibrate how much the unpublished nature of a work militates against its usage being fair.⁷⁵ But on deeper examination, that experience is a dead-end. Past experience deals by definition with unpublished works. The looming problem of the future is that all works may be deemed published, with only trivial effort.⁷⁶ Thus, the trick is to come up with

⁶⁷ *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1, 18 (9th Cir. 1933). See 4 NIMMER ON COPYRIGHT, *supra* note 6, at § 13.03[E][1][a].

⁶⁸ 4 NIMMER ON COPYRIGHT, *supra* note 6, at § 13.03[E][2].

⁶⁹ 15 U.S.C. § 1125(a)(1)(A) (2000).

⁷⁰ 17 U.S.C. § 121(d)(4)(A) (Supp. IV 2004); see 2 NIMMER ON COPYRIGHT, *supra* note 6, at § 8.07[B].

⁷¹ 17 U.S.C. § 110(6) (2000); see 3 NIMMER ON COPYRIGHT, *supra* note 6, at § 12.04[B][2].

⁷² 17 U.S.C. § 107.

⁷³ See *supra* Part I.D.

⁷⁴ 17 U.S.C. § 107(2); see *supra* Part II.C.

⁷⁵ See, e.g., *Salinger v. Random House, Inc.*, 811 F.2d 90, 95-97 (2d Cir. 1987), modified by statute, Fair Use of Unpublished Works Provision, Pub. L. No. 102-492, 106 Stat. 3145 (1992). For commentary on that amendment, see David Nimmer, *Codifying Copyright Comprehensibly*, 51 UCLA L. REV. 1233, 1346 (2004).

⁷⁶ See *supra* Part I.D.

new standards for *published* works, not to embroider on past standards applicable to *unpublished* works.

In theory, of course, there could be a new amendment to the Copyright Act regulating fair use of published works.⁷⁷ But if the desire is to alter the consequences of universal access to works of authorship, then there is no need to gerrymander the fair use doctrine for that purpose. Instead, the direct approach is to alter the access doctrine itself. Accordingly, it is best to defer further examination of this aspect to the discussion below.⁷⁸

C. *Leave Well Enough Alone*

An argument in favor of doing nothing is that the act of Internet publication promotes the progress of science and the useful arts—the constitutional purpose of the copyright regime—by facilitating the dissemination of works that previously would have remained unpublished.⁷⁹ So, if those who take advantage of services like wycca.com find themselves significantly benefited,⁸⁰ that is the price society pays for the benefits of Internet publication.

Yet the benefits to society from such sites as wycca.com strike this observer as small compared to the substantial detriment of gutting the defense of access. Others are free to weigh the competing values differently, of course.

Nonetheless, another perspective could produce a different conclusion.⁸¹ The equation set forth above, access + probative similarity = copying as a factual matter,⁸² applies to more than determining if the defendant copied from the plaintiff. Instead, that same equation can be used by defendants against plaintiffs:

[If] defendant offers proof of lack of originality by plaintiff through evidence that plaintiff copied from prior works (or even from defendant itself), the burden then shifts to plaintiff to overcome that evidence.

What if the defendant lacks direct proof that the plaintiff copied, and invokes instead the presumptions that copyright law has developed to prove copying? If plaintiff's expression is itself [probatively] similar to previous creations to which plaintiff had access, does the imputation arise that it is plaintiff (rather than defendant) who in fact is the copier, meaning that the work in suit lacks the necessary ingredient of originality? Proof that the plaintiff copied from prior works should involve the same elements as are required to establish copying by the

⁷⁷ Just as Congress previously passed the Fair Use of Unpublished Works Provision, *see supra* note 75, so it could pass a new hypothetical Fair Use of Published Works Provision. *See* 4 NIMMER ON COPYRIGHT, *supra* note 6, at § 13.05[A][2][b].

⁷⁸ *See infra* Part IV.D.

⁷⁹ *See* U.S. CONST. art. I, § 8, cl. 8.

⁸⁰ *See supra* Part III.C.

⁸¹ Lou Petrich deserves credit for this point.

⁸² *See supra* Part III.A.

defendant from the plaintiff, *i.e.*, access and probative similarity. Hence, those doctrines would seem to apply defensively as well as offensively.⁸³

These considerations raise the possibility of applying the access rule with a vengeance. Let us play out the scenario of wycca.com,⁸⁴ reverting to the screenplay imagined above that juxtaposes Florence Nightingale, Utnapishtim, Giuditta Pasta, and Evelyn Waugh.⁸⁵ If that submission constitutes script #30,017 on the service, the plaintiff who registered it will be quick to allege that Fox's latest motion picture infringes it. Yet, at the same time, a like presumption arises that the plaintiff herself had access to the 30,016 scripts on that service that preceded her own. Culling out the elements of the plaintiff's script that share no affinity with all those previous submissions may leave nothing residual over which plaintiff can even claim protection.⁸⁶ The upshot is that this situation radically favors the defendants, just as the plaintiff hoped it would benefit her class.

This cure seems as bad as the disease. An aggressive implementation converts the standard for copyright protection from its current requirement of *originality* into the patent standard of *novelty*;⁸⁷ that is, only matters never before embodied by anyone would succeed to copyright protection.⁸⁸ Although there may be poetic justice in hoisting overly assertive plaintiffs on their own petard, the goal herein is to preserve what Lord Mansfield long ago celebrated as copyright's balance.⁸⁹ Thus we must still pursue a different solution.

D. Redefine "Access"

Redefining "access" is the most direct means for redressing the increasing ease of access. A reasonable opportunity to review a work cements the element of "access." In the past, when the universe of published works was limited, it was not

⁸³ 3 NIMMER ON COPYRIGHT, *supra* note 6, at § 12.11[B][1].

⁸⁴ See *supra* Part III.C.

⁸⁵ See *supra* note 6.

⁸⁶ Obviously, the thought process here cannot be mechanical. The mere fact that script #507 included Florence Nightingale, script #7501 featured Utnapishtim, and script #9997 juxtaposed Giuditta Pasta and Evelyn Waugh does not divest script #30,017 of protection. To the extent that its screenwriter originated the combination of all four, it can be protected as compilation on that basis. See 17 U.S.C. § 103(a) (2000). On the other hand, to the extent that the only similarity between plaintiff's work and Fox's motion picture consisted of Utnapishtim (as well as extraneous elements), the plaintiff's case would seem to collapse on its own merits.

⁸⁷ 35 U.S.C. § 102.

⁸⁸ The current copyright standard is far different. "[I]f by some magic a man who had never known it were to compose anew Keats's *Ode on a Grecian Urn*, he would be an 'author,' and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's." *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936), *aff'd*, 309 U.S. 390 (1940) (internal citations omitted). See *Nimmer*, *supra* note 58, at 38-40.

⁸⁹ See *supra* Part I.A.

that much of a stretch to reason that a defendant creating a work on a given topic might have seen the plaintiff's published work on that same topic. In other words, during that era, access + probative similarity showed that there was a decent probability that the defendant actually copied plaintiff's work.⁹⁰

However, the Internet has brought us into an inflationary universe.⁹¹ In fact, the Internet represents such a glut of availability that it no longer makes sense to conclude that probative similarity to a work "published" on the Internet creates a decent probability that the defendant copied plaintiff's work. Instead, it just shows that if the defendant had spent her time searching a haystack, she might conceivably have come upon plaintiff's needle.

Accordingly, something beyond simple availability on the Internet must be required. What is that extra element? At this point, *mirabile dictu*, perhaps the decision in *Rice v. Fox Broadcasting Co.*⁹² could be rehabilitated. To review, the Ninth Circuit concluded there that a work sold on 17,000 videos "cannot be considered widely disseminated."⁹³ For the reasons set forth above, that ruling gives short shrift to the traditional notion of an opportunity to view, with no stated basis for departing so sharply from precedent.⁹⁴

Yet, let us imagine a variant ruling, in which a court concludes that a work "disseminated solely on websites such as wycca.com cannot be considered widely disseminated." Obviously, the phrase "websites such as wycca.com" needs work. One alternative is to omit altogether the words "such as wycca.com," making Net distribution wholly inapplicable to proving access. That idea, however, seems to go much too far. At present, certain websites are well known and often accessed. There is no reason to exclude them from the definition of the copyright term *access*. Indeed, in a world in which traditional publications are continually migrating toward the Net, that expedient seems to rush headlong in the wrong direction.

⁹⁰ See the equation set forth in Part III.A *supra*.

⁹¹ In physics, a phase transition is thought to have occurred a while back—to be exact, 10^{-35} seconds after the universe was created. It took a bit longer for the Internet to get up a good head of steam. For background on this phenomenon, see *The Inflationary Universe*, <http://csep10.phys.utk.edu/astr162/lect/cosmology/inflation.html> (last visited Nov. 28, 2007). The *Inflationary Universe* website states that:

During this period the Universe expanded at an astonishing rate, increasing its size scale by about a factor of 10^{50} . Then, when the phase transition was complete the universe settled down into the big bang evolution that we have discussed prior to this point. This, for example, means that the entire volume of the Universe that we have been able to see so far (out to a distance of about 18 billion light years) expanded from a volume that was only a few centimeters across when inflation began!

Id.

⁹² 330 F.3d 1170 (9th Cir. 2003).

⁹³ *Id.* at 1178.

⁹⁴ See *supra* Part II.D.

Therefore, a better idea would seem to exclude only specialty sites on the Internet from "access". The trick is to find language that would exclude the likes of wycca.com from eligibility to prove access, without affecting such popular sites as cnn.com. Before going further, a sobering realization intrudes:⁹⁵ It may be categorically impossible to formulate such language, given the ubiquity of sophisticated search engines. In other words, although the particular domain on wycca.com housing script #30,017 may be completely *recherché*, it nonetheless would have been trivially easy for Fox to have accessed it by typing in a request for all sites combining Utnapishtim and Waugh. Thus, the very enterprise of separating accessible from inaccessible sites might turn out to be a fool's errand in the Internet age. Further, screenwriters might even be able to assemble evidence that studio readers routinely would turn to wycca.com as a valuable resource for locating scripts that they had read in the past. So it might be that wycca.com would be able to work its black magic, even if a standard were developed of generally excluding specialty sites.

Maybe what is needed instead is tightening "access" from its current standard of being equated to a reasonable opportunity to review a work. One can play around with various refinements of "reasonable opportunity plus" to titrate the optimal level. Should it be "a reasonable likelihood" instead? Or "a reasonable opportunity combined with a minimal indication that it was actually availed?" How about simply placing the burden on the plaintiff of showing that defendant had "more than a reasonable opportunity to review the plaintiff's work?"

Actually, maybe at present we can reach into the future, to anticipate a piece of Bentham's *Panopticon* in order to redress the problem.⁹⁶ Current technology may suffice, at least on the Net, to determine who has visited where. It might be straightforward for the webmaster of wycca.com to maintain a log of everyone who accessed each of its scripts. In future litigation against Twentieth Century Fox arising out of script #963 hosted on that site, for example, it might then be fair to place the burden on the plaintiff of proving not merely a reasonable opportunity to view the subject work but to go further and show actual access to the material. Under this scenario, the plaintiff would be required to demonstrate through the visitor logs that a Fox employee visited it on March 17, for example, and spent thirty-six minutes on script #963. To maintain rigorous copyright protection for its uploaders, the webmaster would be sacrificing the privacy interests of the site's users.⁹⁷ (Of course, the webmaster could still choose to safeguard anonymous browsing, but at the cost of sacrificing her customers' potential copyright claims.)⁹⁸ Thus, strange tradeoffs pose themselves as technology progresses.

⁹⁵ Rob Kasunic deserves credit for this point.

⁹⁶ See *supra* Part III.A. Mark Lemley deserves credit for this point.

⁹⁷ See Julie E. Cohen, *A Right to Read Anonymously: A Closer Look at "Copyright Management" in Cyberspace*, 28 CONN. L. REV. 981, 981 (1996).

⁹⁸ Of course, the very *raison d'être* for wycca.com is to benefit its scriptwriter customers. So its webmaster could easily be expected to sacrifice user privacy. In other instances, however, the balance is nicer.

protections for “copyright management information” (CMI), but the legal rules governing CMI are explicitly geared at deterring infringement of the copyright owner’s economic rights, not the creator’s moral rights.⁴ Current case law “suggest[s] that the CMI provisions have not been particularly efficacious or well-drafted.”⁵

Generally, authors who want attribution must depend on whatever economic leverage they have or on norms of citation. Where there is no contractual relationship between an author and a user—for example, in cases of fair use, statutory licenses, or statutory exceptions to copyright rights—there is no way for an author to demand a separate attribution right. When the author lacks economic leverage, as individual creators often do when negotiating with large corporations, she is unlikely to be able to retain attribution rights. In many cases, the individual creator’s work may be a work for hire, leaving her with no rights that copyright will recognize.

Though it presents an unusual set of facts, the metamorphosis of O.J. Simpson’s recent autobiography illustrates the significance of the authorship/ownership divide. Simpson, with assistance from another writer, penned *If I Did It* (referring to the double murder of which he was acquitted at a criminal trial, but for which he was held liable at a subsequent civil trial). Because of the outstanding civil judgment against him, he lost control of the rights to the Goldman family, which had the cover redesigned to obscure the *If*; added a subtitle, *Confessions of the Killer*; removed Simpson’s name from the cover; and added disparaging commentary.⁶ In a moral rights jurisdiction, this would violate several of Simpson’s inalienable rights, but in the U.S., it was just another example of an owner’s ability to control a work.

The overall American legal landscape, then, is unfavorable to attribution rights in copyright. Attribution is incidental and largely customary. Instead, control over the copyrighted material has primacy of place. Occasionally control is replaced by compensation, a right to be paid for certain uses even when the copyright owner cannot prohibit them, such as the compulsory license for reproductions of musical works or compulsory cable retransmission licenses. Various proposals have been offered for increasing the role of compulsory

⁴ See 17 U.S.C. § 1202. Removal of CMI is only actionable if it facilitates copyright infringement. See *id.* § 1202(b). Altering the name of the author (who need not even be named in the CMI, since the author’s name is only one potential type of CMI) without making infringement more likely does not violate the law. See *id.* § 1202(b)–(c).

⁵ Greg Lastowka, *Digital Attribution: Copyright and the Right to Credit*, 87 B.U. L. REV. 41, 70 (2007).

⁶ See Timothy Noah, *O.J. Is Still Beating His Wife*, SLATE, Aug. 30, 2007, <http://www.slate.com/id/2173030>. In fact, on Amazon.com, the Goldman Family is listed as the author. See Amazon.com, *If I Did It: Confessions of the Killer*, <http://www.amazon.com> (search “books” for “If I Did It”; then follow “If I Did It” hyperlink) (last visited Nov. 28, 2007).

licenses, shifting the balance from control to compensation.⁷ But credit, a term I will use interchangeably with attribution, is still a distant third in law.

B. Attribution's Proponents

In recent years, attribution has received sustained attention from copyright scholars and activists, in part because of the Supreme Court's 2003 decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.*,⁸ which sharply limited the ability of authors to use trademark law to control attribution of copyrighted works. *Dastar* held that the Lanham Act's prohibition of false designations of "origin" refers only to the physical origin of a product, not to the origin of the expression or ideas contained therein. Thus, "[t]he right to copy, and to copy without attribution, once a copyright has expired . . . 'passes to the public.'"⁹ Before *Dastar*, an author could often assert a right over the use or omission of his name on a copyrighted work, even if he had transferred the copyright, on the ground that the use or omission deceptively allocated credit for the work. After *Dastar*, this control is only possible, if at all, in circumstances where there is a deceptive misrepresentation in advertising or promotion that is material to consumers.¹⁰

Despite *Dastar* and the absence of robust attribution rights in copyright law, powerful pro-attribution norms exist throughout modern American society. Both authors and audiences generally accept that attribution is important to authors, and that false attribution, especially plagiarism, is a moral wrong.¹¹ As Jane Ginsburg

⁷ See, e.g., WILLIAM W. FISHER III, PROMISES TO KEEP: TECHNOLOGY, LAW AND THE FUTURE OF ENTERTAINMENT 199–258 (2004) (discussing possibilities for expanded compulsory licensing in the digital age); Olufunmilayo B. Arewa, *Copyright on Catfish Row: Musical Borrowing, Porgy and Bess, and Unfair Use*, 37 RUTGERS L.J. 277, 339, 347 (2006) (suggesting that copyright should shift its focus from control to compensation); Mark Lemley & Philip J. Weiser, *Should Property or Liability Rules Govern Information?*, 85 TEX. L. REV. 783, 786 (2007) (arguing that liability or compensation rules should sometimes apply to unauthorized uses of copyrighted works); Neil Weinstock Netanel, *Impose a Noncommercial Use Levy to Allow Free Peer-to-Peer File Sharing*, 17 HARV. J.L. & TECH. 1, 31 (2003) (offering a compulsory licensing proposal somewhat different from Fisher's).

⁸ 539 U.S. 23 (2003).

⁹ *Id.* at 33 (quoting *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964)).

¹⁰ See *id.* at 38 (stating that false advertising claims for misattribution under § 43(a)(1)(B) remain available). *But see* *Antidote Int'l Films, Inc. v. Bloomsbury Publ'g, PLC*, 467 F. Supp. 2d 394, 398 (S.D.N.Y. 2006) (holding that *Dastar* bars false advertising claims concerning authorship).

¹¹ See, e.g., Stuart P. Green, *Plagiarism, Norms, and the Limits of Theft Law: Some Observations on the Use of Criminal Sanctions in Enforcing Intellectual Property Rights*, 54 HASTINGS L.J. 167, 175 (2002) (discussing attribution norms as moral obligations); Rebecca Tushnet, *Payment in Credit: Copyright Law and Subcultural Creativity*, 70 LAW & CONTEMP. PROBS. 135, 155 (Spring 2007).

willing to sign on to consumer interests as an extra justification for attribution rights, because proper attribution allows readers to identify the types of works in which they would prefer to invest their time, attention, and money.²³ The consumer-protection justification for attribution may be attractive to high-protectionists insofar as it casts readers and viewers as generalized “users” and “consumers,” groups whose moral claims to appropriate and interpret creative works may seem far inferior to those of authors.²⁴ Trademark-style consumer protectionism differs from low-protectionism in copyright both in the definition of the protected class (consumers making rational choices in a marketplace versus audiences desiring access to works that are important parts of culture) and in the interests to be protected (quality of information about particular works versus quantity, although low-protectionists believe that quantity offers each person an opportunity to satisfy her unique tastes and thus provides quality as well).

The emerging consensus is that attribution serves both authors and audiences, rather than forcing a tradeoff between their interests.²⁵ In this view, credit, unlike control and compensation, poses no difficulty of balancing incentives for creation versus access to already-created work.

II. CREDIT IN CONTEXT

Attribution’s proponents make many good points about the important work done by proper credit in rewarding authors and informing consumers. As Catherine Fisk has documented, attribution norms are widespread across many endeavors, from academia to moviemaking to advertising firms, indicating a robust consensus that attribution is an important moral and economic value.²⁶ Yet, the particulars of how credit is earned vary substantially. The difficult problems arise in integrating a legal attribution right into the existing copyright scheme.²⁷ Because there are

²³ See Jane C. Ginsburg, *The Author’s Name as a Trademark: A Perverse Perspective on the Moral Right of “Paternity”?*, 23 *CARDOZO ARTS & ENT. L.J.* 379, 381–82 (2005); Ginsburg, *supra* note 12, at 269–70. Ginsburg is clear, however, that moral rights trump trademark principles, which might otherwise focus on owners rather than authors. See *id.* at 388–89 (arguing that trademark concepts have to be modified in the authorship context to honor individual creators’ attribution rights, which belong to them as a matter of moral desert); cf. Kwall, *supra* note 20, at 745 (arguing that trademark analogies do not recognize the proper author-centered rationales for attribution rights).

²⁴ See Jane C. Ginsburg, *Authors and Users in Copyright*, 45 *J. COPYRIGHT SOC. U.S.A.* 1 (1997). Ginsburg, in the course of arguing for the primacy of authors over users, puts the phrase “user rights” in quotes, “because ‘rights,’ of course, is a loaded term,” *id.* at 2, but she is less concerned with the connotations of “users.”

²⁵ See Ginsburg, *supra* note 12, at 306–07; Lastowka, *supra* note 5, at 1174.

²⁶ See Fisk, *supra* note 22, at 76–101.

²⁷ As explained *supra* note 22, Laura Heymann would convert attribution rights into trademark rights. Many of my objections would apply as readily to credit-as-trademark as to credit-for-copyright. For example, parceling out credit can be extremely contentious with respect to multiply-authored or derivative works. See discussion *infra* Part II.C. Heymann argues that her proposal avoids this problem because trademark is not about

licenses, shifting the balance from control to compensation.⁷ But credit, a term I will use interchangeably with attribution, is still a distant third in law.

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In recent years, attribution has received sustained attention from copyright scholars and activists, in part because of the Supreme Court's 2003 decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.*,⁸ which sharply limited the ability of authors to use trademark law to control attribution of copyrighted works. *Dastar* held that the Lanham Act's prohibition of false designations of "origin" refers only to the physical origin of a product, not to the origin of the expression or ideas contained therein. Thus, "[t]he right to copy, and to copy without attribution, once a copyright has expired . . . 'passes to the public.'"⁹ Before *Dastar*, an author could often assert a right over the use or omission of his name on a copyrighted work, even if he had transferred the copyright, on the ground that the use or omission deceptively allocated credit for the work. After *Dastar*, this control is only possible, if at all, in circumstances where there is a deceptive misrepresentation in advertising or promotion that is material to consumers.¹⁰

Despite *Dastar* and the absence of robust attribution rights in copyright law, powerful pro-attribution norms exist throughout modern American society. Both authors and audiences generally accept that attribution is important to authors, and that false attribution, especially plagiarism, is a moral wrong.¹¹ As Jane Ginsburg

⁷ See, e.g., WILLIAM W. FISHER III, PROMISES TO KEEP: TECHNOLOGY, LAW AND THE FUTURE OF ENTERTAINMENT 199–258 (2004) (discussing possibilities for expanded compulsory licensing in the digital age); Olufunmilayo B. Arewa, *Copyright on Catfish Row: Musical Borrowing, Porgy and Bess, and Unfair Use*, 37 RUTGERS L.J. 277, 339, 347 (2006) (suggesting that copyright should shift its focus from control to compensation); Mark Lemley & Philip J. Weiser, *Should Property or Liability Rules Govern Information?*, 85 TEX. L. REV. 783, 786 (2007) (arguing that liability or compensation rules should sometimes apply to unauthorized uses of copyrighted works); Neil Weinstock Netanel, *Impose a Noncommercial Use Levy to Allow Free Peer-to-Peer File Sharing*, 17 HARV. J.L. & TECH. 1, 31 (2003) (offering a compulsory licensing proposal somewhat different from Fisher's).

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⁹ *Id.* at 33 (quoting *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964)).

¹⁰ See *id.* at 38 (stating that false advertising claims for misattribution under § 43(a)(1)(B) remain available). But see *Antidote Int'l Films, Inc. v. Bloomsbury Publ'g, PLC*, 467 F. Supp. 2d 394, 398 (S.D.N.Y. 2006) (holding that *Dastar* bars false advertising claims concerning authorship).

¹¹ See, e.g., Stuart P. Green, *Plagiarism, Norms, and the Limits of Theft Law: Some Observations on the Use of Criminal Sanctions in Enforcing Intellectual Property Rights*, 54 HASTINGS L.J. 167, 175 (2002) (discussing attribution norms as moral obligations); Rebecca Tushnet, *Payment in Credit: Copyright Law and Subcultural Creativity*, 70 LAW & CONTEMP. PROBS. 135, 155 (Spring 2007).

writes, “few interests seem as fundamentally intuitive as that authorship credit should be given where credit is due.”¹²

To address this mismatch between morality and law, scholars have set forth various proposals for recognizing attribution rights. Roberta Rosenthal Kwall, for example, proposes an attribution right covering (1) actual use or substantial reproduction of an author’s original work without attribution or with false attribution, (2) “modification of an author’s work resulting in a substantially similar version to the original without attribution or with false attribution,” and (3) “false attribution of authorship of a work to an author.”¹³ She would also add a limited integrity right in cases of (1) “objectionable modifications” to the work or (2) public use of the original work, or a close copy, “in a context deemed objectionable by the author” when “the work is either expressly attributed to the original author, or absent attribution, still likely to be recognized as the original author’s work.”¹⁴ In such cases, the user would be required to add a disclaimer “adequate to inform the public of the author’s objection to the modification or contextual usage.”¹⁵ Kwall’s recommendation regarding integrity is more of a disclaimer remedy or reverse attribution right rather than a traditional integrity right, as the latter would allow the author to suppress an objectionable use entirely.¹⁶

Proposals for attribution rights receive support from two often-clashing groups of copyright theorists. First, copyright low-protectionists (like me) think that copyright’s control rights have metastasized, harming creativity and access to creative works. Low-protectionists favor attribution as a substitute for expansive economic rights in copyrighted works.¹⁷ For example, most Creative Commons licenses grant to the world many rights of reuse, but include as the key default term an attribution requirement. The basic presumption is that uncompensated and uncontrolled uses are legitimate as long as credit remains attached. In other countries, fair dealing exceptions to copyright allow certain news and educational

¹² Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 HOUS. L. REV. 263, 264 (2004).

¹³ Kwall, *supra* note 3, at 2004.

¹⁴ *Id.* at 2006.

¹⁵ *Id.*

¹⁶ I thank Professor Kwall for her discussions with me on this point.

¹⁷ See, e.g., Derek E. Bambauer, *Faulty Math: The Economics of Legalizing the “Grey Album,”* 59 ALA. L. REV. (forthcoming 2007) (manuscript at 53–54) (suggesting attribution rights and disclaimers as replacements for the derivative works right in most cases); Lastowka, *supra* note 5, at 62 (praising the incentive function of attribution); Jessica Litman, *Revising Copyright for the Information Age*, 75 OR. L. REV. 19, 47 (1996) (“[A]ny adaptation, licensed or not, should be accompanied by a truthful disclaimer and a citation or hypertext link to an unaltered copy of the original. That suffices to safeguard the work’s integrity, and protects our cultural heritage, but it gives copyright owners no leverage to restrict access to public domain materials by adding value and claiming copyright protection for the mixture.”); Tushnet, *supra* note 11.

use, conditioned on appropriate attribution.¹⁸ An attribution rule has also been proposed as a quid pro quo for allowing people to copy orphan works. Most proponents of a special rule facilitating use of orphan works accept unhesitatingly that attribution is the least (and often the most) we owe known-but-unreachable authors.¹⁹

Second, authorial high-protectionists, who believe that authors should in general be able to control most uses of their works, also favor attribution rights, often as part of a greater package of moral rights.²⁰ These high-protectionists object to the complete commodification of copyrighted works, but not on the same grounds as low-protectionists. Rather, full commodification (including the ultimate in alienability, the work for hire) interferes with the dignity and integrity of the unique relationship between the author and her creations. Attribution rights, in this view, would protect creators from exploitation and bad bargains; they would not necessarily require or facilitate any retrenchment in copyright's control or compensation rights.

The strange bedfellows of this consensus find themselves borrowing from each other's copyright theories. Low-protectionists, who often put the public interest over authors' interests, nevertheless offer attribution rights as a matter of fairness to authors.²¹ Meanwhile, a growing literature focuses on a third, consumer-oriented rationale for attribution rights, treating authorship as a type of trademark and thus a consumer-protection device.²² High-protectionists are often

¹⁸ The Berne Convention provides for exceptions to copyright for such uses, but requires attribution. See Berne Convention, *supra* note 1, arts. 10(2)–(3), 10bis(1).

¹⁹ See UNITED STATES COPYRIGHT OFFICE, REPORT ON ORPHAN WORKS: A REPORT OF THE REGISTER OF COPYRIGHTS 110–11 (2006) [hereinafter REPORT ON ORPHAN WORKS], available at <http://www.copyright.gov/orphan/orphan-report.pdf>.

²⁰ See, e.g., Roberta Rosenthal Kwall, *Authors in Disguise: Why the Visual Artists Rights Act Got It Wrong*, 2007 UTAH L. REV. 741, 743–44; Kwall, *supra* note 3, at 1972–75.

²¹ Jennifer Rothman, for example, though highly critical of the role that custom plays in many areas of intellectual property law, singles out attribution-related customs as legitimate for courts to consider. Attribution customs, she argues, are aspirational and normative claims about justice toward authors, rather than simply adopted to avoid litigation, and thus can properly be accorded legal weight. Jennifer Rothman, *The Questionable Use of Custom in Intellectual Property*, 93 VA. L. REV. (forthcoming Dec. 2007) (manuscript at 47–48, 50).

²² See, e.g., Laura A. Heymann, *The Birth of the Authonym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377 (2005) [hereinafter Heymann, *Birth of the Authonym*]; Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U. L. REV. 1171 (2005); cf. Catherine L. Fisk, *Credit Where It's Due: The Law and Norms of Attribution*, 95 GEO. L.J. 49, 63 (2006) (analyzing attribution as valuable information in employment relationships). Laura Heymann advocates taking attribution rights out of copyright entirely and treating them as trademark claims, with disclaimers being an appropriate remedy, in order to limit copyright to protecting authors' economic interests. Laura A. Heymann, *The Trademark/Copyright Divide*, 60 SMU L. REV. 55, 61–62 (2007) [hereinafter Heymann, *Trademark/Copyright*].

willing to sign on to consumer interests as an extra justification for attribution rights, because proper attribution allows readers to identify the types of works in which they would prefer to invest their time, attention, and money.²³ The consumer-protection justification for attribution may be attractive to high-protectionists insofar as it casts readers and viewers as generalized “users” and “consumers,” groups whose moral claims to appropriate and interpret creative works may seem far inferior to those of authors.²⁴ Trademark-style consumer protectionism differs from low-protectionism in copyright both in the definition of the protected class (consumers making rational choices in a marketplace versus audiences desiring access to works that are important parts of culture) and in the interests to be protected (quality of information about particular works versus quantity, although low-protectionists believe that quantity offers each person an opportunity to satisfy her unique tastes and thus provides quality as well).

The emerging consensus is that attribution serves both authors and audiences, rather than forcing a tradeoff between their interests.²⁵ In this view, credit, unlike control and compensation, poses no difficulty of balancing incentives for creation versus access to already-created work.

II. CREDIT IN CONTEXT

Attribution’s proponents make many good points about the important work done by proper credit in rewarding authors and informing consumers. As Catherine Fisk has documented, attribution norms are widespread across many endeavors, from academia to moviemaking to advertising firms, indicating a robust consensus that attribution is an important moral and economic value.²⁶ Yet, the particulars of how credit is earned vary substantially. The difficult problems arise in integrating a legal attribution right into the existing copyright scheme.²⁷ Because there are

²³ See Jane C. Ginsburg, *The Author’s Name as a Trademark: A Perverse Perspective on the Moral Right of “Paternity”?*, 23 CARDOZO ARTS & ENT. L.J. 379, 381–82 (2005); Ginsburg, *supra* note 12, at 269–70. Ginsburg is clear, however, that moral rights trump trademark principles, which might otherwise focus on owners rather than authors. See *id.* at 388–89 (arguing that trademark concepts have to be modified in the authorship context to honor individual creators’ attribution rights, which belong to them as a matter of moral desert); cf. Kwall, *supra* note 20, at 745 (arguing that trademark analogies do not recognize the proper author-centered rationales for attribution rights).

²⁴ See Jane C. Ginsburg, *Authors and Users in Copyright*, 45 J. COPYRIGHT SOC. U.S.A. 1 (1997). Ginsburg, in the course of arguing for the primacy of authors over users, puts the phrase “user rights” in quotes, “because ‘rights,’ of course, is a loaded term,” *id.* at 2, but she is less concerned with the connotations of “users.”

²⁵ See Ginsburg, *supra* note 12, at 306–07; Lastowka, *supra* note 5, at 1174.

²⁶ See Fisk, *supra* note 22, at 76–101.

²⁷ As explained *supra* note 22, Laura Heymann would convert attribution rights into trademark rights. Many of my objections would apply as readily to credit-as-trademark as to credit-for-copyright. For example, parceling out credit can be extremely contentious with respect to multiply-authored or derivative works. See discussion *infra* Part II.C. Heymann argues that her proposal avoids this problem because trademark is not about

powerful attribution *norms* throughout modern society, rather than a single norm that covers most situations, any attribution law is likely to be extremely vague, which punts the problem of identifying when and what attribution is required to individual cases. This generates legal uncertainty in an area that hardly needs more uncertainty. The following sections explore these problems with moving from norms to legal regulation.

A. Classification Difficulties

The threshold problem is determining which copyrightable works should be granted attribution rights. Even highly moralistic copyright regimes limit the types of works deemed worthy of moral rights. Computer programs, for example, have so many utilitarian functions that moral rights would be incompatible with general social welfare. As a result, moral-rights theorists are less interested in bringing computer programs within the subject matter of moral rights.²⁸ Part of the project of defining an attribution right is to identify appropriate subsets of copyrightable works for which attribution rights should be available.²⁹ Again, there are possible

identifying the source of individual components of a product. Instead, trademark is a system for attributing responsibility to a particular source, and she would not recognize any attribution right unless there was consumer confusion about who authorized a particular work. See Heymann, *Birth of the Authornym*, *supra* note 22, at 1442–43. But multiple entities can authorize a single product, just as multiple entities can endorse a single political candidate. In my view, credit-as-trademark would increase the pressure on courts to find “trademark uses” and consumer confusion about authorization everywhere, including in cases where an artistic work is in the background of a picture or movie. I will focus here, however, on copyright-oriented attribution proposals. For a discussion of an early version of Heymann’s proposal, see 43(B)log, Works in progress: Laura Heymann, <http://tushnet.blogspot.com/2006/10/works-in-progress-laura-heyman.html> (Oct. 8, 2006, 10:36 EST).

²⁸ See, e.g., Ian Eagles & Louise Longdin, *Technological Creativity and Moral Rights: A Comparative Perspective*, 12 INT’L J.L. & INFO. TECH. 209 (2004) (discussing and criticizing the exclusion of computer programs and similar works from existing moral rights schemes). The objections to moral rights center on interference with economic exploitation of works that are highly functional or generally require substantial corporate and collective investment. Attribution rights seem easier to extend to such works than rights against distortion, rights of withdrawal, or others that plainly threaten to take a work or a derivative work entirely off the market. See Ginsburg, *supra* note 12, at 301 (an attribution right in the United States should cover all copyrightable works). Notably, open-source licenses generally involve attribution to contributors, suggesting that credit serves important functions for computer programmers, as it does for other types of authors. See Josh Lerner & Jean Tirole, *Some Simple Economics of Open Source*, 52 J. INDUS. ECON. 197, 212–17 (2002) (discussing the economic and reputational benefits for programmers of being identified as participating in open-source projects).

²⁹ See, e.g., Roberta Rosenthal Kwall, *Originality in Context*, 44 HOUS. L. REV. (forthcoming Dec. 2007) (arguing that only works meeting a heightened standard of originality should be given moral rights; this would involve excluding certain categories of works entirely as well as evaluating specific works within protectable categories).

producer- and consumer-oriented classifications. Taking the author's perspective, we could grant attribution rights where we conclude that attribution is generally an important part of the connection between author and creation.³⁰ Or, taking the audience's perspective, we could grant attribution rights where attribution is likely to be significant to the audience's perception or valuation of the resulting work. Either way, we would be endorsing particular cultural conceptions about when attribution matters.³¹

This classification project seems to me highly dubious. I can imagine many situations in which attribution is much more important to a computer programmer's life goals and plans than a painter's,³² and many situations in which audiences care more about the identity of the programmer than the painter. Here, however, I take for granted that an attribution right might be limited to certain categories within copyrightable subject matter, excluding most utilitarian or corporately created works, whether for principled or practical reasons. Even after making this cut, I will argue, attribution rights would have immense difficulty recognizing and conforming to vital contextual differences.

Traditional literary and visual works, for example, would be at the core of any attribution right, yet a legal code of attribution would fit poorly with the practices of reference and quotation that pervade these forms.

A recent work offers an object lesson: Jonathan Lethem's essay *The Ecstasy of Influence: A Plagiarism*.³³ At the end of the piece, he reveals that his words are in fact copied from a variety of other sources, quotations mixed and mashed. He provides sources at the end, but not in a conventional format; it is difficult to tell which words came from where. In the context of a passionate argument against control over creative works, the absence of attribution serves as part of Lethem's

³⁰ See Ginsburg, *supra* note 12, at 301–02 (arguing that all human authors and performers should have attribution rights, regardless of work-for-hire status).

³¹ The idea of limiting attribution rights to particular authors adopts a culturally specific notion about authorship, and may enhance the problem of disregarding cultural traditions from which individual authors have drawn. See, e.g., Fisk, *supra* note 22, at 55–56 (“Attribution appears to operate quite differently within traditional or indigenous cultures than it does in modern American or European culture. Notions of individual authorship, the status that comes from being perceived as a creator, and the norms that govern attribution vary among cultures It is interesting to note that as indigenous or non-western cultural practices, information, and artifacts are appropriated by American or European culture, vague attribution is sometimes made (to highlight the exoticness or authenticity of the borrowed bit of culture), but often it is not. The power disparities in such cultural appropriation are enormous”) (footnote omitted). Gender also plays an important role in determining who is deemed entitled to credit. See *id.* at 58 (“Women have long provided uncredited research, editorial, and technical assistance on creative projects undertaken by the men in their lives. Who can and should be credited with invention is thus culturally specific and wrapped up as much in norms about honor and credit as in the supposedly simple fact of who conceived a new idea.”).

³² Catherine Fisk points out that open-source programmers have created elaborate schemes for ensuring proper attribution. See Fisk, *supra* note 22, at 88.

³³ HARPER'S MAGAZINE, Feb. 2007, at 61.

claims: We read the essay because of Lethem's reputation as a writer, *Harper's* reputation as a magazine, and Lethem's skill in deploying (others') words. Attribution would destroy the flow of the piece and would also disconnect the words from Lethem's endorsement of them, just as a President's acknowledgment that a speechwriter wrote his addresses would distract audiences from the critical fact that he was speaking in all relevant respects for himself. (One might respond that Lethem's quotations are classic fair use, but attribution rights proposals generally include fair uses.³⁴)

Larry Lessig, copyright law's most prominent low-protectionist, was one of the people whose words were appropriated. In a letter to *Harper's*, he praised Lethem's sentiment, but objected to Lethem's unattributed copying of "the only sentence I have ever written that I truly like."³⁵ Lessig wanted attribution where he would never dream of seeking control—a perfectly consistent position for a Creative Commons supporter. Lethem's response, however, pointed out that nonfiction has citation standards distinct from those of other creative forms:

Artists are, among other things, mischievous, and we should try to remember that we wish them to be. In songs, films, paintings, and much poetry, allusions and even direct quotations . . . are subsumed within the voice of the artist who claims them. Citations come afterward, if at all. There are no quotation marks around the elements in a Robert Rauschenberg collage or around Quentin Tarantino's swipes from lesser-known movies. And T.S. Eliot's "The Waste Land" has only end-notes—which, I suspect, are much less often read than the poem itself.³⁶

Or, as a recent Organisation for Economic Co-operation and Development (OECD) report states more dryly, "In a multi-media environment with mixes of text, video, and graphic works, concepts such as 'citation' may be blurry."³⁷ What works for quotations in standard educational and news reporting uses may not work in other forms of reuse, even within the same medium. The fact that practices surrounding attribution are widely varied even within particular cultures makes an

³⁴ See Ginsburg, *supra* note 12, at 303 (stating that "fair use and other statutory exceptions should not supply a defense" to a violation of the attribution right); Lastowka, *supra* note 5 (proposing to make attribution part of the fair use test).

³⁵ Lawrence Lessig, Letter to the Editor, *Credit Where Credit's Due*, HARPER'S MAGAZINE, Apr. 2007, at 4. Lessig declines to identify the sentence.

³⁶ Jonathan Lethem, Letter, HARPER'S MAGAZINE, Apr. 2007, at 5. For a recently litigated example of art without quotation marks, see *Blanch v. Koons*, 396 F. Supp. 2d 476 (S.D.N.Y. 2005), *aff'd*, 467 F.3d 244 (2d Cir. 2006). Koons incorporated a portion of Blanch's fashion photograph into a painting, and as part of his successful fair use defense argued that it was important to his artistic message to appropriate the "anonymous" legs in Blanch's photo. *Id.* at 481.

³⁷ Directorate for Sci., Tech. and Indus., Comm. for Info., Computer and Commc'n Policy, Working Party on the Info. Econ., DSTI/ICCP/IE(2006)7/FINAL 46 (Apr. 12, 2007), available at <http://www.oecd.org/dataoecd/57/14/38393115.pdf>.

attribution right difficult to define in advance, and thus onerous for compliance purposes.³⁸

Consider also relatively recent information about Nabokov's *Lolita*. What good would it do us for Nabokov to interrupt the narrative in order to tell us that he'd been inspired by a short story published in Germany, whose plot and characters have notable similarities to those of his masterpiece?³⁹ This information is plainly of interest to scholars tracing the anxiety of influence, or perhaps the anxiety of forgetting. That does not mean that the ordinary reader would find her understanding of Nabokov's work enhanced. Nabokov has suffered no diminution in reputation since this revelation, even though he could be judged to have violated both the original author's attribution and integrity rights. Many people think that Nabokov created a work of genius, and this excuses much. When it comes to plagiarism, as opposed to copyright infringement, many readers follow an older rule: improvement on the original is not wrong.⁴⁰ Attribution might even muddy the waters, making it more difficult to credit Nabokov for the brilliance he added to an otherwise unremarkable concept.

The broader issue raised by Nabokov's example is the idea/expression distinction. Plagiarism is often charged when a writer, especially a student, fails to attribute the source of her ideas. But copyright does not protect ideas, only original

³⁸ Another example: Catherine Fisk describes the rise of attribution norms at newspapers that require not just credit for the main writer of a story, but also for "stringers" who contributed research or parts of the story. This contrasts with the norms of broadcast journalism, where writers, researchers, and others off screen are rarely credited, perhaps because voluminous credits would cut into valuable advertising time. Fisk suggests that the main reason for fewer credits is that viewers' expectations about authorship and credit differ between broadcast and print journalism, expectations that themselves are likely related to the economic structures of the different media. See Fisk, *supra* note 22, at 92-93.

³⁹ See *Lolita: A tale by Heinz von Lichberg*, http://www.arlindo-correia.com/lolita_de.html (July 24, 2004) ("[A]dmirers of Vladimir Nabokov and scholars of modern literature were startled by the revelation that the *Lolita* of Nabokov's great novel was not the first fictional nymphet of that name to have enchanted an older lover: her namesake had appeared in an eighteen-page tale, also called "*Lolita*," by the obscure German author Heinz von Lichberg, published in 1916.").

⁴⁰ See generally MARILYN RANDALL, PRAGMATIC PLAGIARISM: AUTHORSHIP, PROFIT, AND POWER 154 (2001) ("All agree, it would seem, that imitation is acceptable if changes, usually deemed 'improvements,' are effected on the original text or idea.").

expression.⁴¹ Proponents of a right to attribution for expression only have already uncoupled law from the norms that supposedly justify a legal remedy.⁴²

An obvious defense of attribution rights against this critique is that line-drawing is part of the judicial enterprise, and is certainly familiar in copyright cases. If copyright recognizes “thin” and “thick” variants, and inquires on a case-by-case basis into whether useful articles’ creative features are conceptually separable from their utilitarian functions, it can certainly evaluate particular works for whether attribution is required either to respect an original artist or to accurately inform a potential audience.⁴³ A court could evaluate the sufficiency of T.S. Eliot’s endnotes, looking for evidence of how readers used them to allocate credit. Another court could mandate that Tarantino add citations to the end credits of his films, preserving their flow but identifying the obscure sources of his inspiration.

This would be a very bad idea. The fact that rights thickets already exist is no reason to make them thicker and pricklier.⁴⁴ Moreover, experience with attribution rights in other jurisdictions does not show that they would work well here. This is because the American copyright system is in many ways an outlier and because Americans are often willing to sue when, in other systems, the conflict would be resolved outside the judicial system.⁴⁵ I am not aware of a non-U.S. case similar to

⁴¹ It is also relevant that people often overestimate the originality of their ideas, and believe they deserve credit when they do not, or do not deserve very much—as the source of Nabokov’s inspiration deserves little credit for *Lolita*. Two authors of cookbooks aimed at picky children, for example, are presently involved in a dispute over whether one “stole” the idea from the other—but the idea itself was already known. See Steven A. Shaw, *Not That There’s Anything Wrong With That: Jessica Seinfeld’s Cookbook Is Unoriginal, But It’s Not Plagiarism*, SLATE, Oct. 24, 2007, <http://www.slate.com/id/2176563/>.

⁴² See Lastowka, *supra* note 5, at 1233–34 (distinguishing anti-plagiarism norms, which cover ideas and small snippets of verbatim copying, from his proposed attribution right, which would not cover those things).

⁴³ See Ginsburg, *supra* note 12, at 299, 304 (arguing that an attribution right should follow the example of Australia’s multifactor tests, including reference to industry norms as one among many considerations in evaluating whether omission of attribution was reasonable); Heymann, *Trademark/Copyright*, *supra* note 22, at 60–61 (arguing that the practical difficulties of attribution are similar to other problems in intellectual property law); Kwall, *supra* note 29, manuscript at 21 (accepting the necessity of line-drawing in attribution rights).

⁴⁴ No matter how mechanical an attribution regime would be in theory, as long as it did not replace any existing rights, it would necessarily add complexity to the current system. Moreover, even a mechanical, CMI-type attribution right of the kind Ginsburg discusses, *see* Ginsburg, *supra* note 12, at 304, would be difficult if not impossible for amateur creators to implement. Especially given the vast amount of existing material that is not digitally tagged with appropriate author information, the creator of a mash-up or parody would have a devilish time complying with new attribution rules.

⁴⁵ One reason for this, as my colleague Julie Cohen pointed out, is that many other jurisdictions require the losing party to pay the victor’s attorney fees, which makes litigation a riskier prospect than the standard American rule in which each side bears its

Choe v. Fordham University School of Law,⁴⁶ in which a disgruntled student sued a law journal under the Lanham Act for marring his note with capitalization and typographical errors, erroneous footnote cross-references, and extra words.⁴⁷

Attribution rights may seem easier to manage than other moral rights because all they require is proper disclosure. Thus, rather than suppressing works entirely, attribution rights simply enforce labeling rules. This proposition assumes that authors will never over assert their rights in order to suppress unwanted uses completely, and that users will understand and assert their rights to proceed once they have conformed their attributions to the law. Those assumptions are unwarranted. The most detailed proposals for new attribution rights provide for damages, either generally⁴⁸ or at least under some circumstances such as willful misattribution, actual economic harm, or violations that are fully completed so that injunctive relief would be useless.⁴⁹ Given the standard practice of sending cease and desist letters phrased in aggressive terms, we can expect that some authors will always claim that those circumstances apply when they allege violation of an attribution right. As a result, users will routinely be threatened with substantial monetary penalties, and legitimate behavior will be chilled.⁵⁰

Yet even setting aside chilling effects, disclosure is an insufficient remedy for misattribution. The next section discusses why the apparently happy compromise of disclosure without suppression will not work.

B. *The Fine Print*

Many proponents of an attribution right accept that, in general, it should be limited in the remedies it affords. In particular, attribution rights compatible with both high- and low-protectionist tendencies should not allow an author to suppress another's speech for failure to attribute sources. Instead, the cure should be a reasonable amount of required disclosure, and, when the original author does not

own costs. American copyright and trademark laws allow fee awards in certain circumstances, but they are far from routine.

⁴⁶ 920 F. Supp. 44 (S.D.N.Y. 1995), *aff'd*, 81 F.3d 319 (2d Cir. 1996).

⁴⁷ Specifically, Choe sued because of the following problems: "'treaty' was changed improperly to 'FCN Treaty' in 12 places; 'treaty' should have been 'Treaty' in two instances; 'parent's' should have been deleted in three references to the FCN Treaty; five footnote cross-references were misnumbered; two sentences needed rewriting; and numerous typographical errors marred the text." *Id.* at 46.

⁴⁸ See Ginsburg, *supra* note 12, at 306 (actual and statutory damages should be available, even in the absence of a timely registration).

⁴⁹ See Kwall, *supra* note 3, at 2006.

⁵⁰ For purposes of comparison, consider that takedown notices under § 512 of the Copyright Act, which are not threats to sue but simply notifications of claimed infringement, often result in the cessation of the challenged conduct, even when there are legitimate issues of noninfringement or fair use. See Jennifer M. Urban & Laura Quilter, *Efficient Process or "Chilling Effects"? Takedown Notices Under Section 512 of the Digital Millennium Copyright Act*, 22 SANTA CLARA COMPUTER & HIGH TECH. L.J. 621 (2006).

agree with the use to which her work has been put, a disclaimer indicating her distaste for the use.⁵¹ Digital culture arguably makes this much easier. As Jane Ginsburg explains,

a requirement to identify all authors and performers may unreasonably encumber the radio broadcast of a song, but distributed recordings of the song might more conveniently include the listing. This may be particularly true of digital media, where a mouse click can provide information even more extensive than that available on a printed page.⁵²

The obvious solution of requiring lots of fine-print credits certainly invites litigation over when such credits are necessary, but it is extremely unlikely to protect either authors or consumers. This is because, English students and law professors aside, people rarely read footnotes, read through the credits of a film, or pay attention to disclosures in general.⁵³ In other words, most people will not click on a link to read about all the authors and performers of a song. The Federal Trade Commission (FTC) disapproves of internet “click to read” disclosures and disclaimers. In its judgment consumers are unlikely to make the required effort, especially when the “click to read” link does not indicate that it contains information that consumers will find significant.⁵⁴ Attribution proponents want audiences to care as much about authorship as the proponents already do. But legal rights provide audiences with no reason to pay attention. Without norm entrepreneurship, the only way to get audiences to pay the “proper” amount of

⁵¹ See, e.g., Heymann, *Birth of the Authornym*, *supra* note 22; Kwall, *supra* note 3, at 1990–91, 2005–07.

⁵² Ginsburg, *supra* note 12, at 304.

⁵³ The research to date focuses on disclosures in consumer product advertising and labeling, but the findings support the idea that audiences are unlikely to process “fine print” wherever it is encountered, including at the end of films, unless they have special reasons to do so. See, e.g., Alan R. Andreasen, *Consumer Behavior Research and Social Policy*, in HANDBOOK OF CONSUMER BEHAVIOR 459 (Thomas S. Robertson & Harold H. Kassarian eds., 1991) (consumers don’t often use disclaimers in making decisions); Gita Venkataramani Johar & Carolyn J. Simmons, *The Use of Concurrent Disclosures to Correct Invalid Inferences*, 26 J. CONSUMER RES. 307, 320 (2000) (noting that because of cognitive processing limitations, “obviously effective disclosures (e.g., those that are encoded, those that are explicit, etc.) are often ineffective”). Laura Heymann acknowledges that her disclaimer-based attribution right is subject to these criticisms, but contends that disclaimers are better than the alternative of total suppression of unattributed or unwelcome uses. See Heymann, *Trademark/Copyright*, *supra* note 22, at 98 n.205. Her response does not, however, establish that disclaimers are better than the alternative of no attribution right at all.

⁵⁴ See FEDERAL TRADE COMMISSION, DOT COM DISCLOSURES: INFORMATION ABOUT ONLINE ADVERTISING 9–12, 17 (2000), available at <http://www.ftc.gov/bcp/conline/pubs/buspubs/dotcom/index.pdf>.

attention is to jump up and down, blocking their view of something they want to see—and that has obvious costs to the audiences.⁵⁵

Similar issues have arisen with respect to product placement in entertainment. Commercial Alert, a consumer group, petitioned the FCC and the FTC to require pop-up disclaimers during the actual product placement.⁵⁶ The petition made the point that disclosure at the beginning or end of the work was likely to be ineffective.⁵⁷ The FTC rejected the argument that additional further disclosures were required,⁵⁸ no doubt in large part because of the intrusiveness of an effective disclaimer.⁵⁹ Pop-ups are amusing in music videos, but they are hardly conducive to maintaining the suspension of disbelief required in a James Bond movie.⁶⁰ Effectiveness and artistry are in competition, and the same would be true of attribution disclosures and disclaimers, especially when the artist's interest is in identifying her contribution to a greater whole or her disagreement with a

⁵⁵ Jessica Silbey suggested to me that audiences may not care about credit as much as they are interested in contextualizing a work, which may involve information about individual creators or about a creative community. For example, Annalee Newitz has written about how American audiences react to Japanese anime, perceiving it as reflecting an entire cultural context, which often overwhelms or at least complements the significance of individual authors. See Annalee Newitz, *Anime Otaku: Japanese Animation Fans Outside Japan*, BAD SUBJECTS, Apr. 2004, available at <http://bad.eserver.org/issues/1994/13/newitz.html>.

⁵⁶ Letter from Gary Ruskin, Executive Dir., Commercial Alert, to Donald Clark, Sec'y, FTC, at 2 (Sept. 30, 2003), <http://www.commercialalert.org/ftc.pdf>.

⁵⁷ See *id.* at 3 (“The impact of the product placement, like that of ordinary ads, occurs at the moment of exposure. For this reason disclosure must occur at that same moment, as it does in print ads. To inform viewers of product placements only at the start or end of a show or segment is not adequate, because they might not be viewing then. Honesty and fair dealing require that the label be attached directly to the thing to which it pertains—in this case, the product placement.”).

⁵⁸ See Letter from Mary K. Engle, Assoc. Dir. for Adver. Practices, FTC, to Gary Ruskin, Executive Dir., Commercial Alert (Feb. 10, 2005), <http://www.commercialalert.org/FTCletter2.10.05.pdf>.

⁵⁹ See Commercial Alert, News Release, Advertisers Attack Honest Disclosure of Stealth Ads on TV, <http://www.commercialalert.org/issues/culture/product-placement/advertisers-attack-honest-disclosure-of-stealth-ads-on-tv> (Nov. 15, 2003) (discussing the Freedom to Advertise Coalition's argument that Commercial Alert's proposed requirement of on-screen disclaimers during product placements would be “‘impractical,’ ‘dangerous,’ ‘extreme,’ ‘radical,’ and that it ‘borders on the ludicrous,’ and that it would make programming ‘virtually unwatchable’”).

⁶⁰ See Cindy Tsai, *Starring Brand X: When the Product Becomes More Important Than the Plot*, 19 LOY. CONSUMER L. REV. 289, 305 (2007) (“The true benefit of product placement[] for the consumer is that it enhances the entertainment experience. It allows consumers to suspend their disbelief and be involved in the film. On-screen notices during the actual placement will ruin the entertainment experience for the consumer. Just like internet pop-up ads, on-screen notices during the actual placement will be distracting and annoying for the viewer. With pop-up notices, consumers will not be able to watch a film without constant distractions.”).

particular alteration. (Recall that many attribution proposals are designed to allow an original author to register disagreement with a permitted subsequent use.)

Just as the FTC has to date accepted small end-credit disclosures with product placement, courts would probably accept footnote, click-to-read, or end-credit solutions. Fact finders are likely to treat such disclosures as “reasonable” forms of attribution in order to preserve the integrity of legitimate works like T.S. Eliot’s *The Waste Land* and Quentin Tarantino’s *Jackie Brown*. But they would be doing so only to support a legal fiction, not a requirement that audiences actually understand who should, in the law’s judgment, get credit for works.⁶¹

Copyright low-protectionists, who do not highly value authorship, might not care about an ineffective attribution right as long as it reduces control and compensation claims from copyright owners. Still, the ineffectiveness of disclosures should matter both to those who see attribution in consumer protection terms and to authorial high-protectionists. The difficulties failed attributions pose to consumer-oriented theorists are obvious. For high-protectionists, an attribution that goes unnoticed fails to protect the unique relation between author and work because the third party in that relationship is, necessarily, the audience.

Even if we treat the audience as passive and dependent on authors to make meaning, it cannot be ignored in the moral-rights analysis. From an author-centered perspective, attribution is an important component of the artist’s message. If the audience misattributes a work, distortion of the message has occurred regardless of whether formal attribution requirements have been satisfied. To sharpen the point, imagine that a user properly attributed a work, and the author knew that the attribution was present on the work, but the attribution was printed in binary code, or invisible ink. Hardly anyone would say that attribution had really been made, because readers would not know about it. Once we recognize that readers’ understanding is a crucial component of attribution, however, we have to consider whether even explicit attributions in fact become part of their understanding of the work.

Moral-rights proponents rarely discuss the complexities of communication, the irreducible gap between sender and receiver. This may be related to their general expectation that each work contains a proper, intended message or set of messages and their related belief that unintended interpretations are misreadings to be minimized. Because there is a true meaning, it must follow that unintended

⁶¹ Other countries’ attribution rights require “reasonable” attribution. See Ginsburg, *supra* note 12, at 288–89, 292–93, 294–95 (discussing attribution rights in Commonwealth countries). The Commonwealth countries generally use the clarity and prominence of the attribution as a proxy for effectiveness. However, in the United Kingdom an author is entitled to an attribution that is “likely to bring [the author’s] identity to the attention of a person seeing or hearing the performance, exhibition, showing, broadcast or cable programme in question.” Copyright, Designs and Patents Act, 1988, c. 48, § 77(7)(c) (U.K.) (emphasis added), *quoted in* Ginsburg, *supra* note 12, at 289. As far as I am aware, the meaning of this provision has not been extensively explored, possibly in part because of the significant restrictions the United Kingdom imposes on the assertion of an attribution right. See Ginsburg, *supra* note 12, at 290–92.

interpretations can be minimized. Given that I see meaning as emerging from the interactions between author, text, and audience, I don't accept the initial premises—but even those who do should recognize that there is no syllogism here. Even if there is a true meaning and misreadings ought to be seen as harms, that does not mean they can in practice be stopped or even substantially decreased—especially with the tools available to lawyers, as opposed to literature teachers.⁶²

The assumption behind high-protectionists' endorsement of a disclosure remedy is that the audience will in fact perceive an overt attribution, but that is not necessarily true. Audiences, unfortunately, are very bad at interpreting information, even in situations when speakers have every incentive to communicate clearly and effectively.⁶³ If courts took a reality-based approach, an attribution right would be much closer to an integrity right than many of its supporters want. As the Second Circuit pointed out in the important *Gilliam v. ABC* case involving unauthorized editing of *Monty Python* episodes for American television:

We are doubtful that a few words could erase the indelible impression that is made by a television broadcast, especially since the viewer has no means of comparing the truncated version with the complete work in order to determine for himself the talents of plaintiffs. Furthermore, a disclaimer . . . would go unnoticed by viewers who tuned into the broadcast a few minutes after it began.⁶⁴

Thus, allowing a mutilated version of an original, even a fair use, inherently risks a misallocation of credit and blame between the original artist and a subsequent creator.

⁶² I do believe in misreadings, at the extreme. It would be a misreading of the Constitution to see it "as the story of a small boy growing up in Kansas." Don Herzog, *As Many As Six Impossible Things Before Breakfast*, 75 CAL. L. REV. 609, 629 (1987). But, as the very outrageousness of that example suggests, implausible misreadings rarely cause trouble. Plausible ones, though, often tell us something important even if they are, in the end, wrong.

⁶³ See *supra* notes 20–25 and accompanying text; see also JACOB JACOBY & WAYNE D. HOYER, *THE COMPREHENSION AND MISCOMPREHENSION OF PRINT COMMUNICATIONS* 110–13 (1987) (finding that an average of 19% of messages in magazine advertisements were affirmatively misunderstood by consumers, while 16% of the messages were not received; no message was correctly conveyed to all readers, and all but 3 of 1,347 respondents misunderstood something about the four advertisements they read); JACOB JACOBY ET AL., *MISCOMPREHENSION OF TELEVISED COMMUNICATIONS* 64–73 (1980) (finding that consumers misunderstood an average of 28.3% of messages in television commercial ads; 81.3% of consumers misunderstood at least some portion); Jacob Jacoby & George J. Szybillo, *Why Disclaimers Fail*, 84 TRADEMARK REP. 224, 226 (1994) (listing reasons why consumers may not receive messages that are directed to them, such as inattention and information overload).

⁶⁴ 538 F.2d 14, 25 n.13 (2d Cir. 1976).

In the *Gilliam* situation, perhaps a constant disclaimer on the screen stating “edited by ABC; not approved by Monty Python” would inform most consumers, at the cost of destroying a substantial amount of the show’s visual appeal.⁶⁵ However, even if a court were willing to require such drastic measures, how would that solution work with music? What should 2 Live Crew do to indicate that certain portions of their song “Pretty Woman” were taken from Roy Orbison’s “Oh, Pretty Woman,” while others were not?⁶⁶

Again, an attribution right could limit this problem by only requiring attribution where feasible. My argument, however, is that *effective* attribution is rarely feasible. Given audiences’ often low levels of attention, the vast number of works to which we are exposed in the modern environment, and basic cognitive limitations on processing information, even a clearly stated attribution has only a limited chance of informing audiences, and we can expect routine failures. In this, attribution is not much different from other types of information. Often, regulators face a practical choice between (1) allowing a simple statement that will inevitably be misunderstood by some significant percentage of the target audience or (2) suppressing the statement entirely. The middle ground of requiring more nuanced disclosures is comforting, but simply does not work.⁶⁷

Ineffective attribution may often be possible, but the social costs of a legally enforceable right to ineffective attribution seem unjustified. Moreover, a feasibility analysis makes starkly clear how discriminatory an attribution right is across types of artistry, as the next section explores.

C. Attribution and Multiple-Author Works

Depending on the way in which audiences receive and perceive works, attribution may be relatively simple or prohibitively difficult. The implicit model of the author entitled to an attribution right is a single artist whose name deserves

⁶⁵ This result might satisfy authorial high-protectionists, who would not want ABC to broadcast the mutilated version in any event, and some consumer advocates. Yet, consumers have competing interests, including interests in being entertained. To the extent that disclosures and disclaimers impair the audience’s experience, consumer protection goals may not be furthered, especially if the material affected involves commentary, parody, or other socially beneficial uses. Preventing deception is not the only way to protect consumers, and may even harm them on balance, if it suppresses competition. See Rebecca Tushnet, *Why the Customer Isn’t Always Right: Producer-Based Limits on Rights Accretion in Trademark*, 116 YALE L.J. (POCKET PART) 352, 357 (2007), <http://yalelawjournal.org/2007/04/25/tushnet.html> (arguing that trademark law should rely upon established concepts of free competition and free speech, not “evanescent and irrelevant” consumer confusion).

⁶⁶ Cf. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 594 (1994) (finding that 2 Live Crew may have made fair use of Orbison’s song).

⁶⁷ See Rebecca Tushnet, *It Depends on What the Meaning of “False” Is: Falsity and Misleadingness in Commercial Speech Doctrine*, 41 LOY. L.A. L. REV. (forthcoming 2007).

to be the only name attached to a single book, sculpture, painting, or similar visual work. In many cases, this model already depends on the erasure of key figures—editors, research assistants, agents, dealers, and others who shaped the works. But since an attribution right would only cement, not cause, their separation from credit, I will not discuss them further. When we move away from that core model—whether by adding authors whose contribution levels may vary or changing the medium from the purely visual—the proper scope of an attribution right becomes unclear at best.⁶⁸

1. Joint Authors

Group authorship creates serious attribution problems, especially when none of the people involved in a creation own the copyright because it is owned by corporate entity instead. Catherine Fisk, writing about multi-participant projects in business contexts, makes observations that apply to many creative endeavors, from software to movies:

Participants in some group projects often do not know exactly what their contributions are. Ex ante, they do not know what the project will entail, how long it will take, who will contribute how much in terms of time, useful ideas or skills along the way, or even whether the project will succeed enough to make it worth thinking about who did what. Ex post, people have a hard time reconstructing what their contribution was, and psychological literature shows a tendency of people to exaggerate (in their own mind) their successful interventions and to forget their failures. Some of the literature even suggests that it is entirely rational for participants to exhibit this form of over-confidence in their abilities and skill.⁶⁹

Disputes over joint authorship illustrate this problem when people who admittedly contributed substantial value to a work claim—usually unsuccessfully—that their contributions rise to the level of “authorship” for copyright purposes.

Courts are generally unwilling to recognize multiple authors even when it is uncontested that multiple people are responsible for a work’s final form.⁷⁰ Currently, “authorship” also carries with it initial ownership of the copyright. Thus, litigation that adds a new joint author to a work, such as a film, substantially

⁶⁸ See, e.g., Lastowka, *supra* note 5, at 1232–33 (recognizing this issue and arguing that consumer-protection attribution rights should only apply to works like novels, which have at most a few authors deserving attribution).

⁶⁹ Fisk, *supra* note 22, at 105. See generally CORYNNE MCSHERRY, WHO OWNS ACADEMIC WORK? BATTLING FOR CONTROL OF INTELLECTUAL PROPERTY (2001) (discussing variations in credit norms and behaviors across academic disciplines, and persistent tendencies of everyone involved to feel slighted).

⁷⁰ See, e.g., Aalmuhammed v. Lee, 202 F.3d 1227, 1231–35 (9th Cir. 2000); Thomson v. Larson, 147 F.3d 195, 204–05 (2d Cir. 1998).

disrupts the economic expectations of the film's producers, and creates potential licensing problems, since all authors must agree in order to grant exclusive licenses. This is likely an important reason that courts have adopted restrictive definitions of joint authorship, essentially requiring that the "main" author have consciously intended to share the specific legal status of authorship. Many scholars have persuasively criticized the current case law,⁷¹ but as long as it exists, attribution rights will be insufficient for many people who, in lay terms, deserve credit for creative works. If we are interested in properly allocating credit among creative participants, we will have to reconstruct the definition of joint authorship.⁷²

If we did create a special type of "attribution authorship" that carried with it no economic rights, legal recognition of multiple contributions might improve. This change would increase the number of line-drawing problems substantially, of course, but authorial high-protectionists might judge it worth the costs, if only to push copyright law to recognize the importance of multiply-authored works.⁷³ Consumer advocates, likewise, might endorse attribution rights for natural persons, because consumers may be far more interested in the identity of a film's director and cinematographer than in the identity of the studio that owns the copyright. Copyright low-protectionists, by contrast, are unlikely to see much gain from such a rule, because it would add rights without any tradeoff in increased access or freedom of re-use. Attribution would not substitute for compensation and control rights in such cases, because those rights would remain in other hands.

2. *Derivative Works*

Multiple authorship exists not just in isolated works, but in the even trickier category of derivative works. The Supreme Court invoked this problem in *Dastar* as one reason for limiting the application of the Lanham Act:

⁷¹ See, e.g., Roberta Rosenthal Kwall, "Author-Stories: Narrative's Implications for Moral Rights and Copyright's Joint Authorship Doctrine," 75 S. CAL. L. REV. 1, 57-58 (2001) (arguing that joint authorship need not imply equal rights, any more than tenancy in common does).

⁷² Kwall clearly recognizes this interrelationship between authorship definitions and attribution rights. See Roberta Rosenthal Kwall, *The Attribution Right in the United States: Caught in the Crossfire Between Copyright and Section 43(A)*, 77 WASH. L. REV. 985, 990, 1001-02 (2002).

⁷³ Fisk points out a related problem: new legal attribution rights could increase perceived unfairness among those who don't qualify for the newly expanded categories. See Fisk, *supra* note 22, at 112 ("Any effort to identify contributors will create a subterranean group whose work goes unrecognized, and those who feel themselves to be closest to the line entitling them to recognition may feel wronged in a way that they would not feel if they were farther from the line and there were a larger group of anonymous contributors. The problem is inescapable in collaborative work because the law asks us to see distinct categories in a world in which people might otherwise see gradations.").

Without a copyrighted work as the basepoint, the word “origin” has no discernable limits. A video of the MGM film *Carmen Jones*, after its copyright has expired, would presumably require attribution not just to MGM, but to Oscar Hammerstein II (who wrote the musical on which the film was based), to Georges Bizet (who wrote the opera on which the musical was based), and to Prosper Mérimée (who wrote the novel on which the opera was based). In many cases, figuring out who is in the line of “origin” would be no simple task.⁷⁴

It is possible that audiences might not care about the antecedents of a derivative work, but they might. Even without consumer confusion, authors are likely to want to control the use or omission of their names on derivative works, especially when those works reach new audiences.⁷⁵

However, initial authors and derivative work audiences are unlikely to agree on what descriptions are truthful and significant. Movies made from comic books provide an easy example where credit will necessarily depend on audience assumptions about the relative contributions of the actors, directors, screenwriters, comic writers, and so on. The audiences for such movies are larger by orders of magnitude than the audiences for the original works. Precise division of credit would require each moviegoer to sit down and compare the comic (or the novel, or play, etc.) to the adaptation. This is not going to happen, because moviegoers want to see a movie, not to read a comic book. They could be informed that the work was changed from the original—but do they need an attribution right to figure that out? And all this merely addresses the relationship between the original author and the audience—the creators whose expression went into the derivative work will have strong opinions of their own about credit and blame, which will likely conflict with the original author’s.

One senses that the practice of licensing someone else to develop a derivative work is itself something that high-protectionist moral-rights proponents find odd and a little distasteful. The widespread practice of surrendering artistic control to another’s judgments—even if the original author exercises supervisory powers, which she often does not—is in tension with the basic moral-rights claim that authors have unique and inviolable connections to their own works. It is therefore no surprise that attribution problems are particularly tricky in such situations.

A related problem raised by derivative works is the problem of blame, which is the flip side of attribution.⁷⁶ If an attribution right is applied beyond the copyright owner’s right to control use, the practice of giving credit might lead audiences to assume that the copyright owner endorsed the work at issue. In the orphan-works context, one commentator discussed the example of a song whose

⁷⁴ *Dastar v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 35 (2003).

⁷⁵ *See King v. Innovation Books*, 976 F.2d 824 (2d Cir. 1992) (concerning credit for a movie based, at least in theory, on a short story by Stephen King).

⁷⁶ Fisk refers to this as the “discipline function” of attribution. *See Fisk, supra* note 22, at 61–62.

creator is known but unfindable. Under an orphan-works regime, the producers of a pornographic film could use the song as long as they gave proper credit—but the songwriter might not appreciate that credit very much.⁷⁷ Attribution would disclose one truth, the source of a work, while potentially distorting another—the author's relationship to the use at issue.⁷⁸

Neither authorial high-protectionists nor consumer advocates would see an unqualified good in such cases of undesired attribution. Again, low-protectionists might accept these consequences in order to get more freedom to use orphan works; but that is merely to say that attribution is doing other work for them than vindicating authors' interests in controlling credit.

Most economically significant copyrighted works—the kinds most likely to generate litigation—are the products of multiple creators' efforts, whether jointly (movies), sequentially (derivative works), or both (*Batman Begins*). The more cooks adding ingredients to the recipe, the more difficult it is to identify responsibility for the final result, and the more room there is for disagreement, reasonable and otherwise. Attribution for screenwriters of Hollywood films, for example, is subject to elaborate standards developed by industry experts over decades, yet it still routinely produces disputes requiring arbitration.⁷⁹ Screenwriting credits can be significantly removed from responsibility for what actually gets filmed, and industry participants know this. However, credit is still a matter of pride, and screenwriting credit also determines entitlement to residual royalties.⁸⁰ Given the high stakes in money and ego, the industry has significant

⁷⁷ See 43(B)log, Orphan Works, Panel 2, part 2, <http://tushnet.blogspot.com/2006/03/orphan-works-panel-2-part-2.html> (Mar. 7, 2006, 14:30 EST) (reporting comments of Jay Rosenthal of the Recording Artists Coalition at *Orphan Works: New Prospects for a Solution*, American University, Washington College of Law, Feb. 24, 2006); see also 43(B)log, Orphan Works Find Home at AU, <http://tushnet.blogspot.com/2006/03/orphan-works-find-home-at-au.html> (Mar. 6, 2006, 22:29 EST) (reporting comments of Mitch Glazer of the Recording Industry Association of America (RIAA) at the same conference; Glazer pointed out that a user of an orphan work might be only fifty percent sure about who the creator was; an unalloyed attribution requirement therefore risks false credit and false blame).

⁷⁸ See discussion *infra* Part III.B for one possible response to the problem of undeserved blame.

⁷⁹ For a description of the system, see Fisk, *supra* note 22, at 77–80. Fisk notes that in 2002, “67 of 210 feature film writing credits were arbitrated.” *Id.* at 79.

⁸⁰ See Kung Fu Monkey, Writing: Arbitration Letters, <http://kfmonkey.blogspot.com/2007/03/writing-arbitration-letters.html> (Mar. 15, 2007 10:14 MST) (“The main reason people want credit on a movie is not for bragging rights or employment; everybody in Hollywood knows what kind of writer you are based on your scripts circulating through the studio system. . . . To be blunt, after reading the shooting script of CATWOMAN, I was pretty dubious about having my name on it But then . . . I thought about the two odd years of shitty, shitty development, weekly meetings with ungodly notes until finally they asked me to leave because I’d gotten too truculent with my insistence that if we made the movie the way they wanted, *it would suck* . . . and I considered any possible residuals the bonus pay for that experience.”).

incentives to develop a workable credit scheme, but its rules still consistently engender disputes and resentment.⁸¹ As one screenwriter points out, the routine use of arbitration encourages screenwriters to vent, and perhaps fixate on “the various frustrations they’ve felt at the film development process,”⁸² which are many. While he finds the results of arbitration generally reasonable, he observes that “every now and then some infamously bizarre decision will come down the pipe that’s so disturbingly arbitrary, it reinforces the sense of panic and helplessness most writers feel . . . well, every day-ish.”⁸³ It is unlikely that copyright law could succeed where industry experts have repeatedly just muddled through.

Given the difficulty that a highly concentrated industry has with managing attribution, developing new legally enforceable attribution norms in less-well-organized mediums would be a daunting prospect. Right now, these disputes are left to the private realm, resolved (often unsatisfactorily) by moral suasion or contract. Law could not do better.

D. Author's Rights and the Problem of Pseudonymity

Many of the problems discussed so far can be, if not avoided, rendered less weighty. If one only considers the author’s own interests in attribution, the fact that a literally correct attribution might not succeed in getting audiences to assign proper credit is not the death knell for an attribution right.

Roberta Rosenthal Kwall defends the attribution right as a way to defend the integrity of an author’s work, though not as a traditional “integrity right.”⁸⁴ She argues that misattribution distorts the meaning and message of an author’s work. Because preserving the author’s message to his audience is part of her concern, it may be the case that an explicit but ineffective disclaimer would not vindicate the author’s right as she defines it.⁸⁵ Yet even if we treated the author’s right as an

⁸¹ *See id.* (“Now the insane ugly truth here is that trying to turn the difference between “Story by” and “Screenplay by” and “Written by” into solid, actionable guidelines for the arbitrating readers is, well . . . insane. Despite the best efforts of the Guild folk . . . the guidelines somehow manage to be both authoritative and vague. . . . Each screenwriter . . . gets to write a letter . . . in which *we* argue out how *we* interpret these objectively/subjective guidelines applying to the scripts in question, supporting the credits we think are fair. . . . The real thriller is that you have no idea what other writers are claiming. Some guys come on hard on arbitration because *they* got fucked on *their* last project, and now it’s time for the hate to run downhill.”) (first ellipsis in original).

⁸² *Id.*

⁸³ *Id.*

⁸⁴ *See* Kwall, *supra* note 20, at 743; Kwall, *supra* note 3, at 1972–73.

⁸⁵ *See* Kwall, *supra* note 3, at 2008–09 (“The proposed standard . . . is designed to facilitate public knowledge of the original author’s message regarding works possessing these qualities . . . [A]s an authorship norm dignity demands an external embodiment allowing the inner personality to commodify and explain itself to the outside world. This conception of dignity requires a public linkage between the author’s inner labor and its external embodiment.”) (footnotes omitted); *see also supra* text accompanying notes 62–67

entirely formal one, designed to give him the satisfaction of knowing his message was out there, the author-centered view must be balanced against audience interests. On its own, it fails to justify an attribution right.

The limitations of the author-centered view can be seen in its unqualified endorsement of rights to publish anonymously or to use a pseudonym, including a pseudonym that adopts a particular identity. In some situations, identifying a work with a particular person has profound effects.⁸⁶ A Holocaust survivor, for example, may wish to create works using that epithet rather than a personal name in order to universalize her experience; identifying the work with a particular human being could change the artist's relationship to the work as well as the audience's reaction.⁸⁷ Or a pamphleteer could use a pseudonym suggesting group authorship in order to give her political opinions the credibility attached to an organized group; forcing her to use her own name would blunt the message.⁸⁸ Kwall does not explicitly address unauthorized derivative works or uses of excerpts such as those made by Lethem in this context, but Lessig's experience suggests that an unattributed quotation can interfere at least with the author's relationship to his work—his pride in creating a uniquely felicitous expression.⁸⁹

The problem with attribution rights as integrity rights is the problem with traditional integrity rights. That is, there are good reasons to deny authors control over *interpretations* of their works, including interpretations driven by authorial identity. More specifically, the Holocaust survivor, the woman who has had an abortion, and the soldier who has served in Iraq, among others, may understandably want their experiences to be taken to represent the standard, normal, or consensus experience of people in their positions. I have no quarrel with the idea that the First Amendment generally bars government from requiring them to disclose their identities. But if someone else knows and identifies the author of an anonymous or pseudonymous work, that information can also clarify matters for the audience, even if it distorts the author's intended message.⁹⁰

(arguing that author-focused justifications for attribution rights nonetheless must consider audience perceptions).

⁸⁶ For discussion of the ways in which anonymity can change both speakers' expression—their willingness to say particular things—and audiences' reactions, see Lyrissa Barnett Lidsky & Thomas F. Cotter, *Authorship, Audiences, and Anonymous Speech*, 82 NOTRE DAME L. REV. 1537, 1550, 1568–69 (2007).

⁸⁷ See Kwall, *supra* note 20, at 744 (discussing Heymann, *Birth of the Authornym*, *supra* note 22, at 1406).

⁸⁸ See Kwall, *supra* note 20, at 746–47 (discussing Heymann, *Birth of the Authornym*, *supra* note 22, at 1430, and the facts of *McIntyre v. Ohio Elections Commission*, 514 U.S. 334 (1995)).

⁸⁹ Jessica Silbey suggested to me that Lessig's protest was tongue in cheek. Lethem and I took him seriously; if we were wrong, though, that just adds another strike against the concept of transparent authorial meaning.

⁹⁰ Cf. *McConnell v. FEC*, 540 U.S. 93, 128 & n.23, 197 (2003) (decrying misleading use of names in campaign-related advertising); Seth F. Kreimer, *Sunlight, Secrets, and Scarlet Letters: The Tension Between Privacy and Disclosure in Constitutional Law*, 140 U. PA. L. REV. 1, 85 (1991) (arguing that a speaker's true identity is important information

Joe Klein published *Primary Colors*, the Bill Clinton campaign *roman à clef*, as a novel by "Anonymous," but his position in the campaign was quite relevant to many readers' understanding of the novel.

Likewise, the anonymous pamphleteer wants to seem to represent a mass movement by calling the pamphlet the work of "concerned citizens." Yet, if she actually represents a movement of one, that is important information for her audience to know, especially insofar as she is relying on apparent popularity as rhetorical technique.⁹¹ Indeed, in commercial contexts, this type of misrepresentation is actionable false advertising.⁹² "The public is entitled to get what it chooses, though the choice may be dictated by caprice or by fashion or perhaps by ignorance."⁹³

for audiences evaluating the persuasiveness of that speaker's claims); Lidsky & Cotter, *supra* note 86, at 1545, 1559–61 (claiming authorial identity can be a vital component of a message, and anonymity can deprive audiences of key information), 1576 (discussing authors who favorably review their own work anonymously or pseudonymously, attempting to deceive readers).

⁹¹ See Lidsky & Cotter, *supra* note 86, at 1544 (suggesting that the Supreme Court in *McIntyre* "gloss[ed] over the implication that others supported the arguments made in the handbill" (citing *McIntyre*, 514 U.S. at 337)).

⁹² See, e.g., *Vidal Sassoon, Inc. v. Bristol-Myers Co.*, 661 F.2d 272 (2d Cir. 1981) (finding that an ad misrepresenting consumer preference survey results was false advertising). Heymann acknowledges that accurate biographical information can be important, but points out that her argument for recognizing rights in invented "authornyms" does not prevent anyone from investigating and publicizing truthful information. See Heymann, *Birth of the Authornym*, *supra* note 22, at 1426. (By contrast, Kwall's author-centered view of attribution sees unmasking a pseudonym as a moral wrong.) I am unconvinced that Heymann sufficiently addresses the problem of deceptive authornyms. While more speech is sometimes the only available corrective for false speech, in trademark and false advertising law, to which she analogizes authornyms, producers have no right to make false claims about provenance just because someone else could advertise the truth. Indeed, the point of trademark and false advertising law is to provide a legal remedy to stop false claims and obviate the need for counterspeech.

⁹³ *FTC v. Colgate-Palmolive Co.*, 380 U.S. 374, 387 (1965) (citation omitted). *Colgate-Palmolive* upheld the FTC's finding that it was deceptive to show a simulated product test in a television advertisement as if it were a recording of a real test, even though real tests produced the same results, but did not look good on television. *Id.* at 377. The Court analogized to trademark law, which bars passing off even when the defendant's goods are of equal quality:

[T]he seller has used a misrepresentation to break down what he regards to be an annoying or irrational habit of the buying public—the preference for particular manufacturers or known brands regardless of a product's actual qualities, the prejudice against reprocessed goods, and the desire for verification of a product claim. In each case the seller reasons that when the habit is broken the buyer will be satisfied with the performance of the product he receives. Yet, a misrepresentation has been used to break the habit and . . . a misrepresentation for such an end is not permitted.

The problem of misrepresentation via pseudonym has arisen most often with authors who write as if they belonged to historically disadvantaged minority groups, but in fact were members of the majority. In such cases, the construction of an authorial identity is linked very closely to the message of the works, but that is precisely what audiences (and minority authors forced to compete with faux-minority authors) find objectionable when the deception is exposed.⁹⁴ And deception is the right word, even if the author feels justified in adopting a different identity in order to get her work taken seriously. It may not much matter whether John Grisham is really a lawyer.⁹⁵ But it matters a fair amount whether “Justin Anthony Wyrick Jr.,” a top-rated provider of legal advice on the advice website AskMe.com, was “a law expert with two years of formal training in the law” who had been “involved in trials, legal studies and certain forms of jurisprudence” (as he claimed) or whether he was a fifteen-year-old relying on *Law and Order* episodes for his expertise (as he in fact was).⁹⁶

“Wyrick” was never a moral-rights claimant, and his advice, while copyrighted because it was delivered in written form, probably would not qualify for protection in a moral-rights regime that required a heightened originality standard. I use him as an example to show that the source’s identity routinely matters, and that the ways in which it matters will be difficult to define in advance because of the myriad modes of and reasons for human communication.⁹⁷

To take a more literary example, James Frey’s *A Million Little Pieces* became a bestseller largely on the strength of its claims to autobiographical detail. When it

Id. at 389. Similarly, authors may attempt to attract readers by adopting a persona with specific identifying features; if the readers enjoy the story, the impulse is to say that no harm has been done. But the authors of the works the readers would have purchased instead, had they known the truth, would probably disagree. And sometimes, the readers may feel harmed if they attributed special value to works by an author who pretended to come from a particular group.

⁹⁴ See Heymann, *Birth of the Authonym*, *supra* note 22, at 1400–01 (noting that audiences often react with anger and accusations of betrayal when the author’s ethnic identity is revealed). For general discussion of creating in another’s voice, see BORROWED POWER: ESSAYS ON CULTURAL APPROPRIATION 71–136 (Bruce Ziff & Pratima V. Rao eds., 1997); RANDALL, *supra* note 40, at 56; SUSAN SCAFIDI, WHO OWNS CULTURE?: APPROPRIATION AND AUTHENTICITY IN AMERICAN LAW 90–102 (2005).

⁹⁵ See Heymann, *Birth of the Authonym*, *supra* note 22, at 1422–23 (“So long as the fan of Grisham’s novels can identify those novels branded with Grisham’s authonym and distinguish them from others, he need not know any details of Grisham’s ‘true’ identity—indeed, ‘John Grisham’ can be female or a nonlawyer or a collective authorial endeavor.”).

⁹⁶ See Michael Lewis, *Faking It*, N.Y. TIMES, July 15, 2001, § 6 (Magazine), at 32.

⁹⁷ Modern audiences may dislike pseudonyms precisely because the cult of the author has had such success. See STEPHEN KING, THE BACHMAN BOOKS: FOUR EARLY NOVELS BY STEPHEN KING ix (1985) (“There is a stigma attached to the idea of the pen name. . . . As respect for the art of the novel rose, things changed. Both critics and general readers became suspicious of work done by men and women who elected to hide their identities. *If it was good*, the unspoken opinion seems to run, *the guy would have put his real name on it.*”).

turned out that his biography differed substantially from the life described in his book, public outrage followed, along with fraud lawsuits and, ultimately, a settlement from the publisher.⁹⁸ If Frey had not been found out, however, he and his publisher would have continued to profit. As Lastowka puts it, “[m]isattribution of authorial identity is valuable to those who engage in it precisely *because* it deceives the public.”⁹⁹

Laura Albert’s novel *Sarah* also involved a misrepresentation of identity that resulted in a lawsuit. *Sarah* is about a 12-year-old male prostitute in competition with his mother for tricks, which Albert wrote under the penname J.T. LeRoy.¹⁰⁰ *Sarah* was promoted as a novel with substantial autobiographical elements, but it was not.¹⁰¹ Because of the apparent realism, LeRoy received a movie deal, but the filmmaker’s financing collapsed when Albert was exposed as an older, female author instead of the young man she had constructed.¹⁰² The film company sued. Its federal false advertising and passing off claims were dismissed based on *Dastar*, but its state-law fraud claim survived,¹⁰³ and a jury found in its favor.¹⁰⁴ This incident illustrates the substantial harm that can be done by misrepresentations of identity, mainly because some audiences members resent

⁹⁸ See Samantha J. Katze, *A Million Little Maybes: The James Frey Scandal and Statements on a Book Cover or Jacket as Commercial Speech*, 17 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 207, 208, 210–11 (2006); Alex Beam, *A Million Little Lawsuits*, BOSTON GLOBE, May 28, 2007, at 6D; cf. Jessica Silbey, *Criminal Performances: Film, Autobiography, and Confession*, 37 N. MEX. L. REV. 189, 189–93 (2007) (situating the Frey controversy in debates over authenticity and the reconstruction of past events).

⁹⁹ Lastowka, *supra* note 5, at 1227; cf. Ellen P. Goodman, *Stealth Marketing and Editorial Integrity*, 85 TEX. L. REV. 83, 131 (2006) (arguing for mandatory disclosure of commercial intent when advertisers sponsor speech, whether as product placement in media or “astroturf” word-of-mouth endeavors, in order to properly inform audiences who are deceived into thinking that such speech results from the speakers’ independent judgment).

¹⁰⁰ See generally J.T. LEROY, SARAH (2000) (presenting herself as J.T. LeRoy, Laura Albert created an author with a history of prostitution, drug addiction, and vagrancy).

¹⁰¹ See Alan Feuer, *Going to Court over Fiction by a Fictitious Writer*, N.Y. TIMES, June 15, 2007, at B1 (“Mr. LeRoy seemed at first to be a hot commodity in today’s biography-obsessed literary world, a gifted writer with a grotesquely compelling story that only enhanced the value of the work.”).

¹⁰² See *id.* (stating that the director wanted to “blend elements of J.T. LeRoy’s biography into the narrative of ‘Sarah’ in . . . a film about ‘how art could emerge from a ruined childhood,’” but “[t]he trouble was there was no ruined childhood from which art could actually emerge,” and the commercial prospects of the film were threatened because “[t]he whole autobiographical back story aura that made this so attractive was a sham” (quoting the director’s lawyer)).

¹⁰³ See *Antidote Int’l Films, Inc. v. Bloomsbury Publ’g, PLC*, 467 F. Supp. 2d 394, 396–97 (S.D.N.Y. 2006).

¹⁰⁴ See Alan Feuer, *Jury Finds ‘JT LeRoy’ Was Fraud*, N.Y. TIMES, June 23, 2007, at B1.

being asked to give greater credibility to a story based on the storyteller's identity when the storyteller's identity is itself a fiction.¹⁰⁵

Nonetheless, not all voluntary misattributions should be considered false advertising or trademark misuse. Lastowka considers instances of writing under a real author's "brand name" to be deeply troubling, as when Tom Clancy licensed his name for a line of adventure novels or when V.C. Andrews' estate authorized further "V.C. Andrews" novels featuring Andrews' well-known (one might say "trademark") trope of "troubled young girls surviving perverse torments inflicted by demented adults."¹⁰⁶ He recounts instances in which readers expressed dismay at learning that the named author did not write the books, and others in which readers were apparently confused as to authorship.¹⁰⁷ He asserts that there is little reason to think that ghostwriting of this sort produces any public benefits.¹⁰⁸

Yet Lastowka's analysis suffers from the general flaw of discussions of attribution: the failure to recognize that information that is confusing and even deceptive to some people is helpful to others. People who want to read stories about troubled young girls surviving perverse torments inflicted by demented adults, for example, can use the V.C. Andrews name/brand as a useful shortcut.¹⁰⁹

¹⁰⁵ There are degrees of belief, of course. We do not believe that reality TV or Michael Moore's films are completely unstaged. The question of when law should attempt to create a space in which we can believe certain claims, in the service of preserving mutual trust and respect, is an extremely complicated one. Without denying that audiences can be sophisticated in evaluating the constructedness of a narrative, I would argue that too great a divergence from the conventions of a form such as autobiography or documentary can deceive and harm audiences. Consider, for example, the difference if Michael Moore had hired actors to portray healthcare-seekers in his film *Sicko* and did not disclose that fact, as opposed to shooting hundreds of hours of footage and choosing only that which supported his case. I thank Jessica Silbey for pressing me on this point.

¹⁰⁶ Lastowka, *supra* note 5, at 1225.

¹⁰⁷ *See id.* at 1224 & nn.258–59.

¹⁰⁸ *See id.* at 1227.

¹⁰⁹ Lastowka suggests that the ghostwritten V.C. Andrews novels harm other authors writing under their own names, because readers' money and attention are zero-sum. *See id.* at 1240. However, he does not take into account the efficiency of trademarks as brands. Other authors might be able to cut deals with the V.C. Andrews estate if they could show an ability to satisfy readers' demands for stories about troubled young girls surviving perverse torments inflicted by demented adults. Even if they could not write for the V.C. Andrews brand, it is not clear why those other authors are entitled to get readers instead of the estate-authorized ghostwriter just because they are using their own, non-established names. They might be writing better books (by whatever standard one wants to apply), but readers still face costs in sorting through all the possibilities and finding ones that satisfy their preferences, and the V.C. Andrews estate has centralized and applied its publishing expertise to the problem, which may be the most efficient result. By contrast, when an author pretends to be a member of a minority or historically disadvantaged group, the history of domination, exploitation, and silencing may create a cognizable harm to authors who are truly from that group. *See supra* note 90 and accompanying text. Special concerns arise when a nonmember speaks for, and in the place of, a minority group given that

It is an empirical matter whether the use of a name this way hurts more consumers than it helps.¹¹⁰ Given the massive sales of multiple ghostwritten V.C. Andrews novels over decades, one could easily argue that the brand is performing its intended function. Those readers who have never learned that Andrew Neiderman is the current ghostwriter behind the novels would be harmed if he was forced to publish only under his name because they would have difficulty finding the new source of the works they desire. Moreover, even the discomfort felt by some readers who discover that Andrew Neiderman is the author of recent V.C. Andrews books has a potential upside: it may demonstrate to them that the author is not always unique or irreplaceable, encouraging them to play with favorite characters and situations themselves.¹¹¹

Thus, I am not advocating a ban on ghostwriting or on adopting another identity, which can have valuable and liberating effects for the author.¹¹² But considering only the author's interest in controlling attribution discounts the audience's powerful interests in deciding for itself whether the author has the authority to be speaking as she does.

III. LESSONS FOR LEGISLATION

Adding a new, generalized attribution right to American copyright law would be a mistake at this time, despite the strong moral claims to attribution that authors have in many circumstances. The additional complexity and uncertainty that would be generated would outweigh the benefits to authors. But there are other ways to encourage attribution, for instance through norms and "best practices" such as those set out by documentary filmmakers. The filmmakers have attempted to define when it is fair use to incorporate others' copyrighted works in their films without seeking expensive, and often unavailable consent, and have made attribution a cornerstone of their best practices.¹¹³ There are also smaller reforms

audiences are likely to confer special authority and credibility on authors who present themselves as minority-group members.

¹¹⁰ For example, in the Frey and Albert cases discussed above, some readers might have treated the authors' supposed autobiographical information as irrelevant or merely entertaining, regardless of its truth value. *See supra* notes 94–101 and accompanying text. The key issue is whether the harms to those who are deceived outweighs the benefits to those who are not.

¹¹¹ *See* Weather Pattern, *The Bourne Redundancy*, <http://www.weatherpattern.com/2007/08/the-bourne-redundancy/> (Aug. 20, 2007, 8:26 PM) ("If [authorized books] are of equal or perhaps even better quality of the original author, readers start asking what makes the original author so special? If the new books are bad, readers start questioning why one author gets the privilege of penning new works and they may be more apt to enter the world of fan fiction. . . . The application and defense of an author's rights extending beyond his death may actually encourage the weakening of those rights.").

¹¹² *See* Heymann, *Birth of the Authornym*, *supra* note 22, at 1398–99.

¹¹³ *See* ASS'N OF INDEP. VIDEO & FILMMAKERS ET AL., *DOCUMENTARY FILMMAKERS' STATEMENT OF BEST PRACTICES IN FAIR USE 3–7* (2005), *available at* <http://www.centerfor>

that, like the addition of VARA and the DMCA's provisions on CMI, could introduce attribution rights in dribs and drabs. This section considers two such proposals.

A. Attribution and Fair Use

Greg Lastowka, like the filmmakers, considers attribution an important element in establishing fair use. He has proposed amending the Copyright Act to make attribution to the author an explicit fifth factor for courts to consider in assessing fair use defenses.¹¹⁴ He argues that this would correct the doctrine's current focus on commercial exploitation and compensation, to the exclusion of other incentives for creation.¹¹⁵ Credit, he argues, is a powerful and increasing motive for creativity, and should be recognized as such in our fair use doctrine.¹¹⁶

I have argued in the past that the presence of disclaimers should influence fair use determinations, at least in the context of fan fiction and other unauthorized creative works based on popular media texts.¹¹⁷ Although I still believe this, I disagree that attribution should be inserted into § 107 for consideration in every case. Whether the statutory factors determine results in litigated cases, or whether courts manipulate them to reach what they deem to be the overall proper result, is a matter of much debate.¹¹⁸ Assuming that a new factor would influence outcomes, however, Lastowka's proposal raises some of the problems discussed above, albeit in the limited context of fair use.

Will attribution be owed to individual "authors" in the lay sense, or to the entities that are authors for purposes of copyright because they are the proprietors of works for hire? If the former, this will be a significant inroad into the work-for-hire principle, and one that may pose substantial difficulties for would-be fair users who are not in the ideal position to identify the individual author of a work for hire. If the latter, attribution to a corporate owner has less of a moral and practical pull; in Lastowka's terms, corporate owners of works for hire are less likely to be

socialmedia.org/files/pdf/fair_use_final.pdf (recommending attribution as part of the best case for fair use in documentaries).

¹¹⁴ See Lastowka, *supra* note 5, at 48–53. Specifically, this fifth factor should be “the provision of attribution, in a manner reasonable under the circumstances, to the author of the work.” *Id.* at 49.

¹¹⁵ See *id.* at 49.

¹¹⁶ See *id.* at 48, 53–54.

¹¹⁷ See Rebecca Tushnet, *Legal Fictions: Copyright, Fan Fiction, and a New Common Law*, 17 LOY. L.A. ENT. L.J. 651, 680 (1997).

¹¹⁸ See, e.g., David Nimmer, “*Fairest of Them All*” and Other Fairy Tales of Fair Use, 66 LAW & CONTEMP. PROBS. 263, 280 (“Basically, had Congress legislated a dartboard rather than the particular four fair use factors embodied in the Copyright Act, it appears that the upshot would be the same.”); cf. Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 PA. L. REV. (forthcoming 2007) (identifying particular factors and subfactors that appear to be important in driving outcomes, and others that are unimportant).

incentivized by credit than individual authors.¹¹⁹ Separately, an attribution rule keyed to current ownership would conflict with the norms of attribution, in that users sometimes identify an *auteur* figure such as a director or producer as the person to whom credit is due even when a corporation is the copyright owner and legal author.

Even if we choose individual authors over owners for fair use purposes, lay practices do not generally allocate credit for multiply-authored works. The *auteur* idea is common and convenient even when other creators such as screenwriters are directly responsible for much of the final product. Thus, for example, fan fiction and other unauthorized fan-created works based on the television show *Buffy the Vampire Slayer* often praise creator Joss Whedon, but rarely if ever list all the writers and other creative contributors.¹²⁰ Likewise, people citing song lyrics routinely identify the singer or group most strongly associated with the song, rather than the composer. Noncommercial, transformative uses, including quotations, would therefore often lack proper attribution from a strict legal standpoint, even though such uses should be and currently are specially favored in fair use analysis.¹²¹

Assuming this problem can be solved, or accounted for in the overall fair use analysis, an explicit attribution requirement fails to take into account ways in which the relevant audience's knowledge may itself substitute for attribution.¹²² If a work is famous enough, attribution may be distracting or even a bit insulting to the audience's intelligence. Lastowka quotes the important Second Circuit case of *Rogers v. Koons* to show that fair use determinations already take attribution into account. He does not consider, however, the implications of the court's references to the audience's awareness:

[The public must be aware of the original work] to insure that credit is given where credit is due. By requiring that the copied work be an object

¹¹⁹ The argument for attribution rights with which Lastowka begins his article, Ralph R. Shaw's *Copyright and the Right to Credit*, even distinguishes an author's interest in credit, which might be maximized by distributing a work for free, from his publisher's interest in compensation, which is necessary for the publisher to survive. See Ralph R. Shaw, *Copyright and the Right to Credit*, 113 SCIENCE 571, 752 (1951), quoted in Lastowka, *supra* note 5, at 1.

¹²⁰ See Tushnet, *supra* note 11, at 154; Tushnet, *supra* note 117, at 669 n.84, 679 n.135 (examples of attribution to *auteur*).

¹²¹ The argument for attribution rights with which Lastowka begins his article, Ralph R. Shaw's *Copyright and the Right to Credit*, even distinguishes an author's interest in credit, which might be maximized by distributing a work for free, from his publisher's interest in compensation, which is necessary for the publisher to survive. See Ralph R. Shaw, *Copyright and the Right to Credit*, 113 SCIENCE 571, 752 (1951), quoted in Lastowka, *supra* note 5, at 1.

¹²² See Tushnet, *supra* note 11, at 160. Trademark doctrine also holds that context can make proper source attribution clear; explicit disclaimers are not required in order for parodies to be nonconfusing and noninfringing. See, e.g., *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g. Group, Inc.*, 886 F.2d 490, 496 (2d Cir. 1989).

of the parody, *we merely insist that the audience be aware that underlying the parody there is an original and separate expression, attributable to a different artist. This awareness may come from the fact that the copied work is publicly known* or because its existence is in some manner acknowledged by the parodist in connection with the parody.¹²³

As I have written elsewhere, if I say that life is “a tale/Told by an idiot, full of sound and fury,/Signifying nothing,” I hardly expect readers to think the words are mine,¹²⁴ and only a law review would require a citation. So, when the author of a popular series of humorous movie summaries decried plagiarism, she concluded her denunciation with “Do not post it in a box, do not post it on a fox. I do not like creative theft and ham, I do not like it, Jerk I Am.”¹²⁵ Then she added a footnote instructing critics not to accuse her of plagiarism because “you know damn well what this is from.”¹²⁶

Perhaps Lastowka’s requirement of reasonable attribution would include attribution that is obvious because of the popularity of the infringed work, but it is hard to imagine copyright plaintiffs conceding that. A fifth fair use factor could easily give them new ammunition to argue that a defendant’s attribution was too limited and the use therefore unfair. Fourteen years after Koons lost *Rogers v. Koons*, he won a similar fair use case involving uncredited appropriation of a not particularly recognizable fashion photograph, which he combined with other images to comment on the pleasures and dangers of our consumption-oriented society.¹²⁷ The Second Circuit’s analysis this time did not mention credit, focusing instead on the transformative nature of the use. Under Lastowka’s proposal, Koons’s use would have had an additional strike against it, despite the relative unimportance of the sources of his borrowed images to his message.

Fair use is already uncertain enough for defendants, and a new variable is likely to worsen matters. Instead, fair use should treat attribution flexibly, taking it into account where appropriate. The current test allows for that already and is not in need of revision. There may, however, be cases in which new user rights can be coupled with attribution requirements in a productive manner.

¹²³ *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992) (emphasis added), quoted in Lastowka, *supra* note 5, at 52.

¹²⁴ See Tushnet, *supra* note 11, at 155; see also RANDALL, *supra* note 40, at 5; Posting of Geoffrey K. Pullum, Language Log: Plagiarism and Allusion, (June 12, 2007, 20:16), <http://itre.cis.upenn.edu/~myl/language-log/archives/004598.html> (“It’s plagiarism if you copy someone’s writing and you don’t want it to be noticed that you were copying; it’s allusion if you do exactly the same but you do want it to be noticed. . . . [In making an uncredited allusion,] I intended there to be not just recognition of the quote but also mutual recognition of our mutual knowledge state.”).

¹²⁵ Movies in Fifteen Minutes, <http://community.livejournal.com/m15m/4155.html> (July 1, 2004, 13:17:00 EST).

¹²⁶ *Id.*

¹²⁷ See *Blanch v. Koons*, 396 F. Supp. 2d 476 (S.D.N.Y. 2005), *aff’d*, 467 F.3d 244 (2d Cir. 2006).

B. The Paternity of Orphan Works

Orphan works offer another area of possible legislative reform. In this case, there is substantial momentum for change, and attribution will likely be part of a solution. The Copyright Office's proposal mentioned above has set the terms for further debate. It provides that if a user made a reasonable search for the copyright owner but failed to locate her, and if the user provided attribution to the author and the copyright owner "if such attribution is possible and as is reasonably appropriate under the circumstances," then significant limitations on remedies would apply in the unlikely event that the copyright owner later resurfaced.¹²⁸ The Copyright Office concluded that attribution would facilitate notice to the copyright owner that her work was being used and deter abuse of the orphan works protection, and that attribution is independently valuable to authors even when their works are used without consent.¹²⁹

I am in favor of orphan works legislation, but the Copyright Office's proposal with respect to attribution should be modified. Attribution alone is too subtle a signal if the desire is to encourage copyright owners to come forward. Moreover, as noted above and as Kwall argues, attribution in the context of derivative works may give the appearance of consent, which may be mistaken and even deeply offensive to an author. If it is possible and appropriate to give attribution, it is also possible and appropriate to state that the work is being used as an orphan work.¹³⁰ This is not to say that such a designation will always be helpful—it may rarely be

¹²⁸ REPORT ON ORPHAN WORKS, *supra* note 19, at 110. The Office's proposed statutory language incorporates this language, which is designed to be flexible. *See id.* at 127. The Orphan Works Act of 2006, legislation introduced by Representative Lamar Smith, used similar language requiring attribution, "in a manner reasonable under the circumstances, to the author and owner of the copyright, if known with a reasonable degree of certainty based on information obtained in performing the [required] reasonably diligent search." H.R. 5439, 109th Cong. § 514(a)(1)(B) (2006), *available at* <http://thomas.loc.gov/cgi-bin/query/z?c109:H.R.5439:>.

¹²⁹ REPORT ON ORPHAN WORKS, *supra* note 19, at 111–12.

¹³⁰ The reply comments of the Association of American Publishers (AAP) provide an objection to my proposal: The AAP points out that copyright law generally does not require attribution, nor does it require users to identify the particular exceptions they are relying on when they proceed without the copyright owner's consent. Joint Reply Comments Concerning "Orphan Works" from the AAP to Jule L. Sigall, Assoc. Register for Pol'y & Internal Affairs, U.S. Copyright Office 6 (May 6, 2005), <http://www.copyright.gov/orphan/comments/reply/OWR0085-AAP-AAUP-SIIA.pdf>. That is not a huge problem, but the AAP points out that an orphan-works designation might itself be misleading. *See id.*; *cf. id.* at 4 (expressing a concern that "orphan work" not become a status that applies to a work for all time, but rather a designation that applies to a particular use of a work because that specific user's search was reasonable, but failed). The question is, as always, the balance of harms; if, as almost everyone agrees, "parents" essentially never show up to reclaim their orphans, any cost of an explicit designation would be minimal—though perhaps the benefit, too, would be limited, as unknown and unfindable authors/owners would almost never be harmed by false assumptions that they had authorized a particular use.

noticed, much less understood by nonexpert audiences. Yet an explicit designation of orphan work status would be a relatively low-cost way of signaling lack of consent, in the context of a special protection that already requires users to jump through various hoops and include attribution information.¹³¹

The orphan works proceedings also offer insight into the ways in which attribution rights are deeply linked to author-centered concepts of copyright and to integrity rights. The Copyright Office's report repeatedly emphasizes that the copyright in orphan works is often held by entities other than the individual creators, which is part of what makes the problem so difficult for would-be users.¹³² In response to this observation, the Directors Guild of America suggested that film directors, who generally are not authors but rather participants in the creation of works for hire, be given backup rights to authorize uses of orphan works when the copyright owner cannot be found.¹³³ The Copyright Office rejected this proposal,¹³⁴ but its own proposal to require attribution to both author and copyright owner, despite the fact that only the copyright owner has an economic interest in being notified of the use,¹³⁵ indicates the kinship between attribution rights and other author-centered rights.

IV. CONCLUSION: AUTHORS' RIGHTS IN AN OWNERSHIP SOCIETY

There are powerful arguments that American copyright law should be rebalanced to give more weight to the interests of authors of creative works, rather than the owners of the economic rights in those works. Attribution rights could be a part of a package of authorial rights. On their own, however, they are too alien to our copyright law to work well with the rest of the system, especially given the complexities of credit in context.

I have identified three types of proponents of attribution rights. Authorial high-protectionists seek recognition for the natural rights of creators and their

¹³¹ Labeling can have epistemic value as a practice even if labels' specific contents are widely ignored. Knowing that labels exist, in other words, has value in assuring audiences that they can trust what they see independent of knowing what the labels say. *Cf.* Goodman, *supra* note 99 (arguing for the merits of a system in which audiences can generally trust speakers). Attribution may also have specific value to certain practice communities that regularly reuse existing work, such as fan fiction writers and fan video creators or documentary filmmakers, as part of their self-definitions. *See* Tushnet, *supra* note 11, at 154–60. But these epistemic values do not justify a legal attribution right, which exists largely to correct mistakes or malfeasance in labels that are, in fact, generally present and thus already conferring their epistemic benefits as signifiers that a citation of a prior work has occurred or that a particular person claims authorship.

¹³² *See* REPORT ON ORPHAN WORKS, *supra* note 19, *passim*.

¹³³ *See id.* at 107 n.365 (proposal of Directors Guild of America).

¹³⁴ *See id.* (“[The proposal] go[es] well beyond the scope of this study, and touch[es] upon fundamental issues about how rights and interests in the exploitation of motion pictures are apportioned.”).

¹³⁵ *See id.* at 111 (“Attribution will help facilitate the marketplace transactions that are the primary goal of the recommended solution to the orphan works problem.”).

special connections to their works. Copyright law-protectionists favor credit instead of control of downstream uses of copyrighted works. Trademark-style consumer protectionists consider authorship relevant information for audiences to consider. Each set of justifications is directed at different goals and each has somewhat different responses to the problems I have identified. Often, these justifications may even be in tension with one another, compounding the uncertainties involved in framing a legally enforceable attribution right. In the actual legislative process, powerful corporate interests, who have reason to be hostile to the claims of individual authors, would also influence the drafting of an attribution right, and it is unlikely that many of those who support attribution rights in the abstract would be happy with the result.

Attribution remains a powerful incentive for creative production. Moreover, norms of credit, including the ones that produced all the footnotes in this piece, are extremely valuable for particular professions and individuals laboring within those professions. Sometimes, however, law and morality should be left to diverge, when law's tools are too crude to make the fine distinctions that prevail in ethics. Attribution rights provide an example of this situation. "Who steals my purse steals trash,"¹³⁶ but should still go to jail; but he that filches from me credit for my creative works deserves condemnation, not injunction.

¹³⁶ WILLIAM SHAKESPEARE, *OTHELLO*, act 3, sc. 3.

DELEGATION OF JUDICIAL AUTHORITY TO EXPERTS:
PROFESSIONAL AND CONSTITUTIONAL IMPLICATIONS OF SPECIAL
MASTERS IN CHILD-CUSTODY PROCEEDINGS

Allison Glade Behjani*

I. INTRODUCTION

Child-custody proceedings are an intricate, dramatic, and multi-faceted area of the family law system.¹ To determine custody, courts invade the privacy of the family to make decisions that will affect the rest of a child's life. There are many players in the system, all of whom strive for the best outcome in such highly emotional decisions.

Since the 1970s, family courts have granted custody based on their determination of the best interests of the child.² This subjective test has resulted in family courts referring psychological issues to mental-health professionals, who are assumed to be better qualified to make such delicate decisions.³ Specifically, judges increasingly appoint mental-health professionals as special masters and delegate to them fact-finding authority in order to inform their determination of the child's best interests.⁴

Use of special masters, however, may be problematic. Special masters in custody cases contribute to efficiency and provide family courts with psychological insights. Yet, the lack of professional and educational guidelines coupled with the power such an expert can wield over the court might ultimately harm the fragile nature of child-custody proceedings. To avoid this negative outcome, courts need clearer professional and judicial guidelines to ensure that special masters can continue to provide valuable assistance to family courts.

This note explores the issues presented in the effort to define professional criteria for special masters in family courts and the constitutional implications of

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¹ See ELEANOR E. MACCOBY ET AL., *DIVIDING THE CHILD: SOCIAL AND LEGAL DILEMMAS OF CUSTODY* 266 (1992) (utilizing four central questions of "(1) gender differentiation in parental roles, (2) legal conflict, (3) children's contact with both parents over time, and (4) the nature of the co-parenting relationship" to study how divorced parents face the dilemmas of child custody); Victoria Mikesell Mather, *Evolution and Revolution in Family Law*, 25 ST. MARY'S L.J. 405, 413 (1993) (tracking major changes in family law over the last twenty-five years).

² Janet M. Bowermaster, *Legal Presumptions and the Role of Mental Health Professionals in Child Custody Proceedings*, 40 DUQ. L. REV. 265, 265 (2002).

³ *Id.* at 269.

⁴ *Id.* at 272. For a simple example of what an appointment of a special master entails, see SUPER. CT. OF CAL., MONTEREY COUNTY, LOCAL RS. 11.01-11.08, available at <http://www.monterey.courts.ca.gov/local.html> (follow "Local Rules" hyperlink) (last visited on Nov. 28, 2007) [hereinafter MONTEREY COUNTY RS.].

appointing mental-health professionals to quasi-judicial roles. First, Section II discusses the changes in how family courts view custody decisions and the resulting proliferation of special masters in family courts. Next, Section III examines the hurdles for defining the requirements that mental-health professionals must possess to act as qualified special masters. Section IV explores the constitutional issues involved in using special masters, primarily the potential of an unconstitutional delegation of judicial authority and related due process concerns. Finally, Section V shows how allowing parties to stipulate to a special master's findings on small factual issues may solve some of the professional and constitutional obstacles to the use of special masters in family court.

II. BACKGROUND

In recent years, family law courts have delegated decision-making authority to experts, particularly in the area of child custody.⁵ Commonly, courts employ psychiatrists, social workers, therapists, psychologists, and family law attorneys.⁶ The recent delegation of power is a response to the law's shift in the 1970s from the determinative, gender-based custody rules outlined below, to subjective determinations of the best interests of the child.⁷

A. Replacement of Determinative Rules with the Best-Interests-of-the-Child Standard

Beginning in the nineteenth century, the tender years doctrine became an exception to courts' preference for paternal custody.⁸ The courts presumed that awarding custody to the mother during a child's early years favored a child's interest because courts and society assumed a mother could provide a more nurturing environment.⁹ In the 1970s, legislatures and courts recognized the importance of gender-neutrality in family law and largely did away with the determinative rules that governed custody awards.¹⁰ Very few bright-line rules filled the void left by the revolution against determinative rules.¹¹ Rather, the new standard requires courts to subjectively determine the best interests of the child. In making this determination, judges must predict how parents will raise a child and

⁵ Bowermaster, *supra* note 2, at 268–69.

⁶ *Id.* at 269–70 (providing brief descriptions of the role each mental-health professional may play in family court).

⁷ *Id.* at 265 (explaining the general trends and uses of expert testimony).

⁸ *Id.* at 267.

⁹ Helms v. Franciscus, 2 Bland 544, 563 (Md. Ch. 1830) (“Yet even a court of common law will not go so far as to hold nature in contempt, and snatch helpless, pulling infancy from the bosom of an affectionate mother, and place it in the coarse hands of the father. The mother is the softest and safest nurse of infancy . . .”).

¹⁰ Bowermaster, *supra* note 2, at 268.

¹¹ *Id.* at 269.

meet the child's needs.¹² In choosing between parents, judges refer to many factors, some of which require value-based determinations to decide the fittest parent for the particular child.¹³

While most jurisdictions have enumerated lists of relevant factors similar to those in the Uniform Marriage and Divorce Act,¹⁴ the factors inherently implicate value judgments and personal biases. Consequently many judges, feeling unequipped to make such emotional and psychological decisions, have delegated the task of determining the best interests of the child to mental-health professionals.¹⁵ For example, mental-health professionals may perform child-custody evaluations by visiting the home and assessing the child's needs and may also submit psychological assessments to the court. After assessing the child's needs, experts also inform judges of the general effects of divorce on children and child development.¹⁶ Recently, family courts have employed special masters, more commonly used in commercial litigation, for decision-making roles in child-custody cases.¹⁷

¹²T.J. Hester, Note, *The Role of Mental Health Professionals in Child Custody Determination Incident to Divorce*, 14 WOMEN'S RTS. L. REP. 109, 109-10 (1992).

¹³ See Robert H. Mnookin, *Child-Custody Adjudication: Judicial Functions in the Face of Indeterminacy*, 39 LAW & CONTEMP. PROBS. 226, 260 (1975).

¹⁴ See, for example, UNIF. MARRIAGE AND DIVORCE ACT § 402, 9A U.L.A. 282 (1998), which states:

The court shall determine custody in accordance with the best interest of the child. The court shall consider all relevant factors including:

- (1) the wishes of the child's parent or parents as to his custody;
- (2) the wishes of the child as to his custodian;
- (3) the interaction and interrelationship of the child with his parent or parents, his siblings, and any other person who may significantly affect the child's best interest;
- (4) the child's adjustment to his home, school, and community; and
- (5) the mental and physical health of all individuals involved.

The court shall not consider conduct of a proposed custodian that does not affect his relationship to the child.

Id.

¹⁵ Bowermaster, *supra* note 2, at 269-70.

¹⁶ For example, experts often testify about the effects of "parental alienation syndrome" where one parent attempts to turn the child's affections away from the other parent. See, e.g., Carol S. Bruch, *Parental Alienation Syndrome and Parental Alienation: Getting It Wrong in Child Custody Cases*, 35 FAM. L.Q. 527, 531 (2001).

¹⁷ Bowermaster, *supra* note 2, at 272.

B. Emergence of Special Masters

1. Historical Use of Special Masters

A state courts' authority to appoint or delegate decision-making power to special masters stems from the state's adoption of Federal Rule of Civil Procedure 53.¹⁸ Generally, Rule 53 allows for reference to a special master to:

- (A) perform duties consented to by the parties;
- (B) hold trial proceedings and make or recommend findings of fact on issues to be decided by the court without a jury if appointment is warranted by
 - (i) some exceptional condition, or
 - (ii) the need to perform an accounting or resolve a difficult computation of damages; or
- (C) address pretrial and posttrial matters that cannot be addressed effectively and timely by an available district judge or magistrate judge of the district.¹⁹

Courts use special masters for fact-finding and decision-making most often in complex litigation.²⁰ Under Rule 53, the court drafts a reference order that specifically describes the parameters of the master's authority.²¹ Generally, masters appointed by the judge or stipulated to by the parties aid in discovery motions, calculation of fees and damages, and management of mass tort litigation.²² Retired judges, attorneys, or academics with expertise and perspective most often act as special masters.²³ Parties usually pay the special master's fees based upon their relative responsibility for the need to have a special master, their relative financial means, and the amount in controversy.²⁴

The ubiquitous use of special masters today has led scholars to argue that the role of a special master has changed from the historical role of prelitigation

¹⁸ Lynn Jokela & David F. Herr, *Special Masters in State Court Litigation: An Available and Underused Case Management Tool*, 31 WM. MITCHELL L. REV. 1299, 1325 (2005) (chart summarizing each state's form of Rule 53). Courts also have inherent equitable powers to appoint special masters. See *In re Peterson*, 253 U.S. 300, 312 (1920) (holding that courts have inherent power to appoint persons to aid in performance of judicial duties). For simplicity, this Note will use language from the Federal version of Rule 53 as a proxy for various state adoptions of the Rule.

¹⁹ FED. R. CIV. P. 53(a)(1)(A)–(C).

²⁰ Linda J. Silberman, *Judicial Adjuncts Revisited: The Proliferation of Ad Hoc Procedure*, 137 U. PA. L. REV. 2131, 2142–45 (1989).

²¹ FED. R. CIV. P. 53(b)(2)–(4).

²² Jokela & Herr, *supra* note 18, at 1303–07 (listing documented uses of special masters in federal and state court).

²³ Silberman, *supra* note 20, at 2134.

²⁴ FED. R. CIV. 53(h)(1)–(3).

discovery management to one that permeates all facets of litigation, including settlement.²⁵ Some have argued that judges, in appointing special masters, “have developed an almost Pavlovian response” to difficult and complex cases.²⁶ Moreover, few procedural guidelines exist to govern both the appointment and substantive practices of special masters, resulting in a system that fosters ad hoc reference to special masters.²⁷

2. *Emerging Use of Special Masters in Child-Custody Proceedings*

Similar to judges’ increased reliance on special masters in commercial litigation, family courts have more frequently appointed mental-health professionals as special masters.²⁸ Advocates for special master appointments in custody cases emphasize the benefits that special masters can provide in high-profile divorces, where the parties face long, drawn-out battles in the courtroom with little hope of consensus.²⁹ Additionally, proponents argue that the use of special masters in child custody proceedings and high-profile divorces protects vulnerable children from consuming litigation and familial uncertainty.³⁰

²⁵ Silberman, *supra* note 20, at 2135–36.

²⁶ *Id.* at 2158. *But see* Richard A. Posner, *Coping with the Caseload: A Comment on Magistrates and Masters*, 137 U. PA. L. REV. 2215, 2217–18 (1989) (arguing that although there are few rules that govern special masters, and judges perhaps over-delegate matters to special masters, special masters nevertheless are respectable people and “a few bad apples need not spoil the entire barrel”).

²⁷ See James S. DeGraw, Note, *Rule 53, Inherent Powers, and Institutional Reform: The Lack of Limits on Special Masters*, 66 N.Y.U. L. REV. 800, 803 (1991) (focusing primarily on the deviation from traditional uses of special masters in institutional reform litigation).

²⁸ Bowermaster, *supra* note 2, at 272–73. The term “special master” has taken on many different names in family court. Common synonyms include: master, referee, or judicial adjunct. Jokella & Herr, *supra* note 18, at 1325. Certain psychology periodicals refer to parent coordinators as special masters, but parent coordinators are used more often as post-trial therapists to families. See, e.g., OKLA. STAT. ANN. tit. 43, § 120.2 (West Supp. 2007). Parent coordinators offer workable custody arrangements and then stay in contact with the family to make sure the parents implement the arrangement. Special masters, on the other hand, participate in pre-trial motions and trial adjudications. For a description of parental coordinator duties, see Matthew J. Sullivan, *Ethical, Legal, and Professional Practice Issues Involved in Acting as a Psychologist Parent Coordinator in Child Custody Cases*, 42 FAM. CT. REV. 576, 576 (2004), and Christine A. Coates, et al., *Special Issue, Parenting Coordination for High-Conflict Families*, 42 FAM. CT. REV. 246, 247–48 (2004).

²⁹ Janet Griffiths Peterson, *The Appointment of Special Masters in High Conflict Divorces*, UTAH B.J. Aug./Sept. 2002 at 16, 17 (arguing that appointing special masters in commercial litigation to ensure compliance with court orders is analogous to the use of special masters in family court where parents can become fiercely litigious).

³⁰ *Id.* at 18; see Linda D. Elrod, *Reforming the System to Protect Children in High Conflict Custody Cases*, 28 WM. MITCHELL. L. REV. 495, 529–34 (2001) (explaining ways in which a special master can mediate between two hostile parents by setting parent plans).

To facilitate the use of special masters in family law issues, courts have adopted Rule 53 or equivalent rules in varying ways.³¹ Some special masters are only permitted to determine the best interests of the child with respect to a narrowly defined range of issues: education, extracurricular activities, healthcare, and issues surrounding substance-abusing parents.³² Other courts, however, have extended the power of a special master well beyond these unique circumstances and have either appointed a special master or allowed the parties to stipulate to the use of a special master to decide the final custody arrangement.³³ In each situation, a mental-health professional must assume a legal role that blends her professional knowledge and experience with her knowledge and experience—however limited—of legal procedure and dispute resolution.

Overall, the indeterminate nature of the best-interests-of-the-child standard, combined with the fast-growing use of special masters to make factual decisions, presents issues of professionalism and constitutionality. As courts deciding custody arrangements assign more responsibility to special masters, the need for clearer professional and judicial guidelines increases.

III. PROFESSIONAL IMPLICATIONS OF SPECIAL MASTERS

A. *Professional guidelines*

Critics are concerned that courts may give too much deference to a mental-health professional's findings, regardless of the professional's credentials.³⁴ In complex commercial litigation, retired judges and seasoned attorneys usually serve as special masters.³⁵ In child-custody proceedings, however, mental-health professionals may have little experience with judicial procedure and must quickly adapt to the legal arena.³⁶ Generally, mental-health professionals acting as experts must abide by professional rules of conduct, such as the American Psychological Association's Ethical Principles of Psychologists.³⁷ Beyond that, Rule 53 gives

³¹ ANDREW I. SCHEPARD, CHILDREN, COURTS, AND CUSTODY: INTERDISCIPLINARY MODELS FOR DIVORCING FAMILIES 108–12 (2004).

³² *Id.* at 110–11.

³³ For examples of states allowing stipulation or arbitration for child custody, see MICH. COMP. LAWS § 600.5071(b) (2004) and *In re E.H.*, 2006 UT 36, ¶¶ 20–28, 137 P.3d 809, 814–17.

³⁴ See Bowermaster, *supra* note 2, at 265.

³⁵ Silberman, *supra* note 20, at 2134.

³⁶ Bowermaster, *supra* note 2, at 276–90 (explaining that mental-health professionals may refuse to take on a judicial role, may be ignorant of new presumptions developed in the law, have inadequate legal knowledge, or disagree with the policy behind the law). *But see* N.H. SUP. CT. R. 38, APPLICATION OF THE CODE OF JUDICIAL CONDUCT, available at <http://www.courts.state.nh.us/rules/scr/scr-38.htm> (last visited Nov. 28, 2007) (including a marital master and a special master as judges subject to the judicial conduct code).

³⁷ APA, Ethical Principles of Psychologists and Code of Conduct (2003), available at <http://www.apa.org/ethics/code2002.pdf>; see also Marion Gindes, *Guidelines for Child*

little guidance for the qualifications that a master must have to make an informed decision. For example, under Rule 53(b)(1), “[t]he court must give the parties notice and an opportunity to be heard before appointing a master.”³⁸ The rule also provides that “[a] party may suggest candidates for appointment.”³⁹ Although the rule’s language may prevent arbitrary appointments by allowing the parties a chance to be heard, the rule does not adequately define the professional eligibility for the proposed masters. This lack of guidance gives the court and parties broad discretion in determining the eligibility and skill of the proposed special master.

Some jurisdictions have opted, through local court rules, to set further guidelines on what types of experts may serve as special masters in custody proceedings.⁴⁰ For example, California’s Monterey County Local Court Rules set special guidelines for special masters deciding child custody and visitation.⁴¹ Under the Monterey County Local Court Rules, psychologists, psychiatrists, marriage and family counselors, clinical social workers, and attorneys may serve as special masters.⁴² A psychologist or psychiatrist must belong to a national or state professional association, have three years post-license experience in child and family therapy, and have three years experience in diagnostic evaluations for family courts and/or mediation with a minimum of ten evaluations.⁴³

The Monterey County Local Court Rules also recommend that psychologists and psychiatrists serving as special masters be familiar with the ethical issues surrounding child-custody disputes and that they previously work at least six cases with attorneys.⁴⁴ Counselors and social workers must meet the same guidelines as

Custody Evaluations for Psychologists: An Overview and Commentary, 29 FAM. L.Q. 39, 41–49 (1995); Task Force for Model Standards of Practice for Child Custody Evaluation, *Model Standards of Practice for Child Custody Evaluation*, 45 FAM. CT. REV. 70, 72–75 (2007). Special masters are also bound by the Code of Judicial Conduct. MODEL CODE OF JUDICIAL CONDUCT, Application of Code of Judicial Conduct, § A (2004).

³⁸ FED. R. CIV. P. 53(b)(1).

³⁹ *Id.*

⁴⁰ *See, e.g.*, N.H. SUPER. CT. ADMIN. RS. 12-1 to 12-18, *available at* <http://www.nh.gov/judiciary/rules/admn/index.htm> (last visited Nov. 28, 2007) (requiring that a “marital master” be appointed by a Master Committee, not practice law, and have three-year initial terms with renewable five-year tenures); SUPER. CT. CAL., SACRAMENTO COUNTY, LOCAL R. 14.09(A)–(B), *available at* http://www.saccourt.com/geninfo/local_rules/PDFChapters/2007/Chapter%2014%20010107.pdf [hereinafter SACRAMENTO COUNTY RS.] (stating that the court will publish a list of masters that meet set requirements, from which the parties may to choose to stipulate).

⁴¹ MONTEREY COUNTY RS., *supra* note 4, at Rs. 11.02–.08. *But see* FLA. FAM. LAW R. P. 12.492(a), *available at* http://www.flcourts.org/gen_public/family/forms_rules/rules_and_opinions.shtml (follow “Acrobat (PDF)” hyperlink next to “Family Law Rules”) (stating that a court may only appoint a special magistrate from the Florida Bar).

⁴² MONTEREY COUNTY RS., *supra* note 4, at R. 11.02(b).

⁴³ *Id.*

⁴⁴ *Id.*

psychologists and psychiatrists, but must have five years of experience in areas where psychologists and psychiatrists only need three.⁴⁵

If all jurisdictions created bright-line requirements similar to those described above, child-custody decisions made by special masters would have more continuity and predictability.⁴⁶ Clear guidelines would allow family courts to benefit from the psychological expertise a special master has in dealing with high-conflict divorces and custody battles while maintaining credibility.

B. Special Masters Playing Dual Roles

On the other hand, while professional eligibility requirements may provide a court more guidance in appointing a special master, the same requirements may not reveal a master's personal biases. Rule 53 requires that: "[a] master must not have a relationship to the parties, counsel, action, or court that would require disqualification of a judge under 28 U.S.C. § 455 unless the parties consent with the court's approval to appointment of a particular person after disclosure of any potential grounds for disqualification."⁴⁷ Special masters in child-custody proceedings may have unusually high levels of involvement with the parents and children involved in the litigation.⁴⁸ A special master may observe a family closely for up to a year⁴⁹ and will undoubtedly form subconscious bonds with the family.

Compared to custody proceedings, a special master in commercial litigation may be more professionally removed from the parties and therefore may more easily remain unbiased. In child-custody proceedings, however, the parties may wish to choose a special master with whom they have had contact.⁵⁰ Moreover, to make an informed decision regarding the best interests of the child, the special master may also need to spend time with one or both parents observing everyday life. This method of observation creates a situation where the special master may not differentiate his or her professional opinion from personal or emotional feelings toward one or both parents.⁵¹ As one commentator observed:

⁴⁵ *Id.*

⁴⁶ Peterson, *supra* note 29, at 20.

⁴⁷ FED. R. CIV. P. 53(a)(2). Notably, 28 U.S.C. § 455(a) disqualifies judges and magistrates whose judicial partiality might be reasonably questioned.

⁴⁸ See Daniel B. Pickar, *On Being A Child Custody Evaluator: Professional and Personal Challenges, Risks, and Rewards*, 45 FAM. CT. REV. 103, 104–07 (2007) (explaining the difficulties a mental-health professional encounters when overcoming bias and maintaining a forensic rather than sympathetic role).

⁴⁹ *In re E.H.*, 2006 UT 36, ¶ 11, 137 P.3d 809, 813.

⁵⁰ Pickar, *supra* note 48, at 105.

⁵¹ Kirk Heilbrun, *Child Custody Evaluation: Critically Assessing Mental Health Experts and Psychological Tests*, 29 FAM. L.Q. 63, 70–71 (1995) (addressing the difficulties treating clinicians face when testifying as experts in litigation involving their current patients).

It would be very difficult, if not impossible, in most cases for a clinician to “set aside” the attitudes and feelings that constitute the “therapeutic orientation” that has been developed with a given individual or family in exchange for the more detached, skeptical, and objective stance that is necessary for the forensic evaluator.⁵²

Understandably, marital special masters may also be tempted to assume additional roles as counselors and/or mediators for the family. However, Rule 53 requires that the order referencing the master specifically define situations in which a master may appropriately speak *ex parte* with the parties.⁵³ Although mental-health professionals and attorneys are asked to rely on their professional acumen when making decisions, “judgments and decisions made by the Special Master are often simply based on reasonableness and not on any scientific or professional knowledge . . . and his or her own beliefs about what is best for children.”⁵⁴ One scholar stated, “[t]he danger of a new cottage industry, enhanced by large fees for special masters and endangered by potential cronyism and conflicts of interest, cannot be ignored when assessing the system of special masters presently in vogue.”⁵⁵

Overall, special masters fill the gaps left open by the non-determinative best-interests-of-the-child standard. Given the fact-based nature of child-custody proceedings, courts need professional guidance to inform judicial decision making. However, courts should establish stricter professional guidelines to lend more credibility and predictability to the current system. Additionally, as shown below, courts should be mindful of their constitutional judicial role when delegating authority to special masters.

IV. CONSTITUTIONAL IMPLICATIONS OF SPECIAL MASTERS

A. *Delegation of Core Judicial Powers*

Although special masters can provide insight into family relationships that judges may not have, delegating fact-finding authority to special masters diminishes the judiciary’s core constitutional responsibility. When making a reference to a special master, “the authority of the trial court . . . is constrained by the basic constitutional principle that judicial power may not be delegated.”⁵⁶ In general, “the court is duty bound to examine and consider the evidence for itself . . . in entering the judgment recommended by the master.”⁵⁷

⁵² *Id.* at 70.

⁵³ FED. R. CIV. P. 53(b)(2)(B).

⁵⁴ Sullivan, *supra* note 28, at 580.

⁵⁵ Silberman, *supra* note 20, at 2137.

⁵⁶ *Ruisi v. Thieriot*, 62 Cal. Rptr. 2d 766, 772 (Cal. Ct. App. 1997).

⁵⁷ *Bell v. Bell*, 307 So. 2d 911, 914 (Fla. Dist. Ct. App. 1975); *In re United States*, 816 F.2d 1083, 1087 (6th Cir. 1987) (holding that a special master could not decide the dispositive summary judgment motion because even though the antitrust case was complex,

Rule 53 requires that a court appoint a special master only if warranted by "some exceptional condition."⁵⁸ The United States Supreme Court in *La Buy v. Howes Leather Co.* stated that court congestion is not an "exceptional circumstance" that warrants appointment of a master.⁵⁹ As noted above, however, advocates of special masters in child-custody proceedings often cite congested courts and emotional damage to children as reasons for appointing special masters.⁶⁰

Courts that have reviewed the use of special masters in custody proceedings have rejected the argument that court congestion constitutes an "exceptional condition." For example, in *In re the Marriage of S.K.B. v. J.C.B.*, the Missouri trial court appointed a special master to conduct a five-day hearing to determine the custody of a thirteen-year-old girl.⁶¹ The master preserved a record for only two days of the proceeding, leaving out the mother's testimony entirely.⁶² Moreover, the master unilaterally denied the parents' repeated requests for guardian ad litem representation.⁶³

Despite the trial court's reasoning, the appellate court rejected the appointment of a special master.⁶⁴ The appellate court determined that calendar congestion and the attorneys' "procedural 'games'" did not constitute exceptional conditions warranting the appointment of a master for a custody issue.⁶⁵ Instead, the court concluded that "[m]asters are appointed to aid judges in the performance of specific judicial duties, as they may arise in the progress of a cause, and not to place the judge into a position of a reviewing court."⁶⁶ Additionally, the court reasoned that the "exceptional conditions" standard should especially apply to custody cases where it is the "better practice to have a sitting judge hear and decide the matter."⁶⁷

Other courts have agreed that delegating the finding of the best interests of the child to a special master strips the court of its core judicial powers.⁶⁸ In a prominent California case regarding a mother's right to move with her daughter to Rhode Island, *Ruisi v. Thieriot*, the trial court appointed a special master after the

appointment of a special master to decide matters other than discovery "run[s] counter to the spirit and purpose of judicial administration").

⁵⁸ FED R. CIV. P. 53(a)(1)(B)(i).

⁵⁹ 352 U.S. 249, 259 (1957) (holding that in an antitrust suit, neither court congestion nor complexity of facts and law was an exceptional circumstance).

⁶⁰ See *supra* notes 29–30 and accompanying text.

⁶¹ 867 S.W.2d 651, 655 (Mo. Ct. App. 1993).

⁶² *Id.*

⁶³ *Id.*

⁶⁴ *Id.* at 658–59.

⁶⁵ *Id.* at 658.

⁶⁶ *Id.* (internal quotations and citations omitted); see also *M.F.M. v. J.O.M.*, 889 S.W.2d 944, 950 (Mo. Ct. App. 1995) ("Where a master is used, the trial court sees not the child, but only a cold record of the interview.").

⁶⁷ *In re Marriage of S.K.B.*, 867 S.W.2d at 659.

⁶⁸ *Ruisi v. Thieriot*, 62 Cal. Rptr. 2d 766, 773–75 (Cal. Ct. App. 1997).

court evaluator recommended that a special master decide “any and all issues regarding custody.”⁶⁹ The appellate court determined that only a limited number of issues could be delegated to a special master. Such issues included accounting, discovery questions, special proceedings, and questions of fact in *existing* controversies, but not custody disputes that may arise later.⁷⁰

Additionally, the Monterey County Local Court Rules, discussed above, state that recommendations “which alter a child’s primary residence, alter an award of physical custody, alter an award of legal custody, prohibit a party’s contact with his/her children, or require or prohibit adherence to a religion,” are prohibited.⁷¹ These rules further state that such issues “are reserved to the . . . court for adjudication, and may be presented to the court by either party or upon the recommendation of the Special Master without a recommendation as to outcome.”⁷² As evidenced by the cases and court rules discussed, a delegation to a master for custody awards likely does not constitute an exceptional circumstance and also jeopardizes preservation of courts’ constitutional powers.

B. Due Process Concerns

Beyond the potential unconstitutional delegation of judicial authority, appointing special masters in custody proceedings may deprive family members of due process. Rule 53 gives the parties some rights to object to the special master and to the court’s powers to overturn the master’s findings. In general, Rule 53 allows parties to make objections to a master’s order within twenty days of service.⁷³ If either party files an objection, Rule 53 only allows an appellate court to overturn the master’s factual finding if clearly erroneous.⁷⁴ In custody proceedings such a high standard of appellate deference may not adequately address and remedy biases that occur when special masters determine the best interests of the child.⁷⁵ Courts have recognized that the special master system “undoubtedly has salutary effects resulting in the more expeditious dispatch of the

⁶⁹ *Id.* at 771–72.

⁷⁰ *Id.* at 774. The court conceded, however, that the California statute allows the parties to agree or stipulate for the court to refer to a special master to try “any or all of the issues in an action or proceeding, whether of fact or law.” *Id.* at 773 n.13 (quoting CAL. CODE CIV. P. § 638(a)). Thus, while California has restricted the range of issues that a special master may determine, these restrictions are subject to the parties’ contractual agreements.

⁷¹ MONTEREY COUNTY RS., *supra* note 4, at R. 11.03(c).

⁷² *Id.*

⁷³ FED. R. CIV. P. 53(g)(2).

⁷⁴ FED. R. CIV. P. 53(g)(3)(A). If the parties have stipulated to a master, then the master’s findings are final as to facts but not law. *Id.* at 53(g)(3)(B).

⁷⁵ See *Hadick v. Hadick*, 603 A.2d 915, 917–18 (Md. Ct. Spec. App. 1992) (holding that family court chancellor could not accept special masters findings simply because they were not clearly erroneous, but had to exercise independent judgment of the best interests of the child based on the facts).

judicial process” but that “[I]tigators in . . . child custody proceeding[s] . . . are entitled to have their cause determined ultimately by a duly qualified judge.”⁷⁶ This language suggests that if a special master’s determination is immune from review on appeal, each parent is entitled as a matter of due process to have the court thoroughly consider and question the masters’ analysis and recommendation.⁷⁷

Additionally, reference to special masters may involve inappropriate *ex parte* discussions between the special master and the parties outside the formal hearing process. Such discussions may deprive the parties of an opportunity to respond to the statements of the special master and the other party.⁷⁸ Rule 53 requires the order appointing the master to define circumstances in which the master may proceed *ex parte*.⁷⁹ In many instances, however, masters have failed to either include all testimony on the official record or have conducted private conferences.⁸⁰ If a special master is allowed to spend too much time with a parent or child and does not include interviews on the record, the master’s biases will be hidden from the court. Some courts have attempted to remedy this situation by making it explicit in the appointment that the court will not give communications

⁷⁶ *Ellis v. Ellis*, 311 A.2d 428, 430–31 (Md. Ct. Spec. App. 1973) (determining that the mother had a right to an independent review of the evidence and testimony despite the master’s report, especially since the chancellor accepted the report without any independent information of the living conditions of the parties). *But see Ex parte Atkinson*, 121 S.E.2d 4, 8 (S.C. 1961) (“When considering the question of the custody of a child between estranged parents, the recommendation of the Master is entitled to considerable weight because of his opportunity to observe the witnesses . . .”); *Moser v. Moser*, 836 P.2d 63, 66–67 (Nev. 1992) (holding that even if a party objects to factual findings of a special master, the reviewing district court cannot strike all of the master’s findings without an evidentiary hearing).

⁷⁷ For an example of one local rule that attempted to remedy the deprivation of due process by creating more transparency, see MARIN COUNTY SUPERIOR COURT UNIFORM LOCAL R. 6.33, available at <http://www.co.marin.ca.us/depts/MC/main/PDFs-LocalRules/ULRules.pdf>, which states that the court “permits parties, by stipulation only, to agree to the appointment of a Special Master.” Additionally, the rule also limits a special master’s authority by explicitly stating that “[n]o Special Master will have authority to make orders on subjects which are, by law, reserved to the Court for adjudication, such as substantial changes in time sharing arrangements, an award of physical custody, an award of legal custody, or orders which substantially interfere with a party’s contact with his/her children.” *Id.*

⁷⁸ See Degraw, *supra* note 27, at 804, 816–17 (arguing that the prohibition against *ex parte* discussions is constantly violated by special masters).

⁷⁹ See *supra* Section II; FED. R. CIV. P. 53(b)(2)(B).

⁸⁰ See, e.g., *In re Marriage of S.K.B. v. J.C.B.*, 867 S.W.2d 651, 655 (Mo. Ct. App. 1993) (noting that the master excluded the mother’s testimony); *Moser*, 836 P.2d at 65 (requiring new psychologist reports after the father claimed the court erroneously considered only one of two available reports, rejecting the one report on which the father alleged the child had “bonded” with the psychologist); *Walker v. Walker*, 317 N.E.2d 415, 417 (Ohio Ct. App. 1974) (holding that if the referee wishes to interview children in private, a record of the interview must be made upon the request of either party).

received *ex parte* a presumption of correctness.⁸¹ However, this standard may be unworkable in a child-custody proceeding where the judge relies more heavily on the expert's expertise in interviewing the child and applying psychological analysis. Ultimately, depriving a parent of access to his or her child implicates a violation of fundamental constitutional rights to family associations. Parents ought to have a meaningful chance to be heard through independent court review.⁸² While these procedural inconsistencies may not deprive a party of a fair trial, they raise due process questions about the prudence of delegating such important court procedures to a quasi-judicial professional.

V. POSSIBLE SOLUTION: STIPULATIONS TO MASTERS FOR MINOR FACTUAL DISPUTES

Concerns regarding the professional eligibility of special masters and the constitutional problems associated with their involvement in family courts may be resolved by making reference to special masters only when stipulated to by the parents.⁸³ In principle, a stipulation that appoints a special master to determine small factual issues would insure the parents' consent and allow the trial judge to make an informed final decree about the best interests of the child without risking an improper delegation of judicial authority. The parties may also have more control over the education and experience of the chosen special master. Because custody proceedings vary widely in facts and circumstances, the parties can choose a special master who will fit their unique needs.

Some jurisdictions already require both parents' consent when a family court appoints a special master.⁸⁴ For example, in Florida, if a special master is to make a "conclusive determination" about the case, the parties' consent is required.⁸⁵ In

⁸¹ See *Ruiz v. Estelle*, 679 F.2d 1115, 1163 (5th Cir. 1982) (stating that *ex parte* discussions will not be presumed correct and will not be subject to clearly erroneous standard of review), *amended* in part, *vacated* in part, 688 F.2d 266 (5th Cir. 1982) (cited in *Degraw*, *supra* note 27, at 820 n.121); *cf.* *Krinsley v. United Artists Corp.*, 225 F.2d 579, 582 (7th Cir. 1955) (holding that the "clearly erroneous" standard of review applies to "findings of fact made after hearings, by masters" (citing FED. R. CIV. P. R. 53(c)(2))).

⁸² *B.A.C. v. B.L.M.*, 30 P.3d 573, 578 (Wyo. 2001) (noting that a family court commissioner could not deny evidence and district court could not defer to commissioner's findings without independent finding, especially when involving child custody).

⁸³ A stipulation to a special master implies that the parties have consented to a special master and the court need not appoint one. In general, family courts are more hesitant to appoint special masters without the parties' consent. See, e.g., *SACRAMENTO COUNTY RS.*, *supra* note 40, at R.14.09(B) ("The court will not order parties to use a Special Master . . .").

⁸⁴ See *Swezy v. Bart-Swezy*, 866 So.2d 1248, 124 (Fla. Dist. Ct. App. 2004). Florida Rule 12.490(b)(1) requires "[n]o matter shall be heard by a general magistrate without an appropriate order of reference and the consent to the referral of all parties." FLA. FAMILY LAW R. P. 12.490(b)(1).

⁸⁵ *In re Marriage of Esparza*, No. DO44853, 2006 WL 165014, at *4 (Cal. Ct. App. Jan. 4, 2006).

other words, the party can stipulate to a special master to avoid the potential for an unconstitutional delegation of judicial power. Therefore, requiring the parties to make a detailed stipulation to a special master may alleviate some of the constitutional concerns involved in judicial appointment of special masters.⁸⁶

However, stipulating to the appointment of a special master in a custody dispute should be limited to small factual disputes to avoid giving ultimate decision-making power to a special master who may not have the same legal experience as a judge.⁸⁷ Currently, most courts would likely hesitate in entering a master's order regarding final custody of a child.⁸⁸ For example, the Monterey County Local Court Rules only consider the parties' stipulation in limited, discreet matters.⁸⁹

⁸⁶ Bowermaster, *supra* note 2, at 273 (stating "[t]he range of referable issues is much broader when the parties affirmatively consent to appointment of a special master.").

⁸⁷ See Peterson, *supra* note 29, at 18 (arguing that because special masters are most analogous to court commissioners, a special master cannot have judicial authority but could be assigned to find smaller issues such as vacation time, education, etc.).

⁸⁸ See Bowermaster, *supra*, note 2, at 295–96; American Psychological Association, *Guidelines for Child Custody Evaluations in Divorce Proceedings*, 29 FAM. L.Q. 51, 58 (1995). Specifically, the American Psychological Association's guidelines state:

While the profession has not reached consensus about whether psychologists ought to make recommendations about the final custody determination to the courts

If the psychologist does choose to make custody recommendations, they should be derived from sound psychological data, and must be based upon the best interests of the child Recommendations are based on articulated assumptions, data, interpretations, and inferences based upon established professional and scientific standards. Psychologists guard against relying upon their own biases or unsupported beliefs in rendering opinions in particular cases.

Id. See also *Glauber v. Glauber*, 600 N.Y.S.2d 740, 741–43 (N.Y. App. Div. 1993) (holding that the court would not recognize an arbitration agreement for child custody determination).

⁸⁹ MONTEREY COUNTY RS., *supra* note 4, at R. 11.03(a). The local rules state the following as the limited matters for stipulation:

1. Dates and times of pick-up and delivery
2. Sharing of parent vacations and holidays
3. Method of pick-up and delivery
4. Transportation to and from visitation
5. Selection of child care/daycare and baby sitting
6. Bedtime
7. Diet
8. Clothing
9. Recreation
10. After school and enrichment activities
11. Discipline

Recently, however, the Utah Supreme Court allowed a biological mother and the adoptive parents involved in a heated custody dispute to stipulate to the use of a special master to ultimately determine the best interests of the child.⁹⁰ An analysis of this case shows the danger in allowing a stipulation for a custody award, but also suggests that stipulations to smaller matters may improve court efficiency and reduce hostile litigation.

In *In re E.H.*, a mother allowed a family to adopt her child after the prospective adoptive parents assured her that all of their children were well adjusted and on the honor roll at school.⁹¹ After the biological mother lived with the adoptive parents, she felt the adoptive parents had not represented their family truthfully, and appealed to the court to regain custody of her child.⁹² Before trial the parties decided that to facilitate a resolution, they would stipulate to a special master to find the best interests of the child. The parties also agreed that the trial court would enter the final decree.⁹³ Following the policy arguments that “the law favors the settlement of disputes” and that arbitration agreements often stop the court from intervening, the Utah Supreme Court reasoned that the parties could determine by contract how they wished to settle the final custody arrangement.⁹⁴ The court compared the stipulation to a stipulation of facts that “determine[s] the contours of the factual landscape” and as “an exercise entirely consistent with efficient and just judicial administration.”⁹⁵ The court further reasoned that because the court retained the power to review the psychologist’s determination and

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12. Health care management
 13. Alterations in schedule which do not substantially alter the basic time share agreement
 14. Participation in visitation (significant others, relatives, etc.)

Id.

⁹⁰ *In re E.H.*, 2006 UT 36, ¶ 21, 137 P.3d 809, 814–15.

⁹¹ *Id.* ¶ 7, 137 P.3d at 812.

⁹² *Id.*

⁹³ *Id.* ¶ 9, 137 P.3d at 812. The stipulation at issue stated:

[T.H.] having waived any right to proceed on her claim to set aside the relinquishment for fraud, constructive fraud, violation of procedures, breach of contract, or for any other good cause in light of the parties’ Stipulation, it is hereby ordered that she shall not challenge the Judgment in this case or in the adoption case on the basis of such claims. [The adoptive parents] and Families for Children having waived any right to object to or challenge the propriety or enforceability of a Judgment for post-adoption contact in this case in light of the parties’ Stipulation, it is hereby ordered that they shall not challenge such an order or Judgment for post-adoption contact should such an order or Judgment be recommended.

Id. ¶ 10, 137 P.3d at 813.

⁹⁴ *Id.* ¶¶ 20–21, 137 P.3d at 814–15.

⁹⁵ *Id.* ¶ 22, 137 P.3d at 815.

overturn the recommendation if “clearly erroneous,” the core functions of the court were not compromised by the stipulation.⁹⁶ Because the trial court had ultimate authority to enter the final order, the Utah Supreme Court found that the stipulation did not jeopardize any core judicial powers.⁹⁷

Similar stipulations may solve some of the constitutional obstacles a family court encounters when appointing a special master because stipulations allow the court to respect the parties’ wishes without relinquishing court authority. However, stipulations should be limited to smaller factual disputes. Although a court may see virtue in permitting parties to contract for a resolution of their dispute, allowing parties to stipulate to a final determination of the best interests of the child may trump the purpose of the judiciary. If such stipulations are upheld, the court becomes merely a “reviewing court” with little power to balance the special master’s findings with its own view of the facts.⁹⁸ Although *In re E.H.* stands for the proposition that parties may stipulate to an ultimate custody decision made by a special master, the reasoning of the court fails to address the commonly accepted concept that judicial efficiency is not an exceptional condition under the rule.⁹⁹ Furthermore, although the court speaks extensively about its ability to overturn a special master’s findings if “clearly erroneous,” it points to nothing in Utah’s version of Rule 53 that would give the court safeguards to verify the veracity of the special master’s order.¹⁰⁰

Overall, a stipulation for a special master’s findings on parenting time, school choice, location, and other day-to-day activities would help the court avoid the difficult task of inquiring into the parties’ private lives, but would preserve the courts’ ultimate discretion over the final custody award. A stipulation to a special master will protect the parties’ constitutional rights and will protect fragile family bonds from high-conflict litigation. This proposed solution will also conform to the general direction of private ordering in family law and at the same time keep ultimate discretion and authority with the court.

VI. CONCLUSION

The requirement of a family court to find the best interests of the child in a custody proceeding has made custody awards more gender-neutral but has also made custody determinations more value-based and less predictable. Consequently, the reliance on expert testimony in determining the best interests of

⁹⁶ *Id.* ¶ 23, 137 P.3d at 815.

⁹⁷ *Id.* ¶ 28, 137 P.3d at 815–16.

⁹⁸ *In re Marriage of S.K.B.*, 867 S.W.2d 651, 658 (Mo. Ct. App. 1993).

⁹⁹ See UTAH R. CIV. P. 53 (stating that “[a] reference to a master shall be the exception and not the rule . . . [i]n actions to be tried without a jury, save in matters of account, a reference shall, in the absence of the written consent of the parties, be made only upon a showing that some exceptional condition requires it.”).

¹⁰⁰ FED. R. CIV. P. 53(g)(3)(B) states that factual findings by a special master stipulated to by the parties will be final. Therefore, a stipulation to a special master may alleviate the due process concerns involved in appointments of special masters.

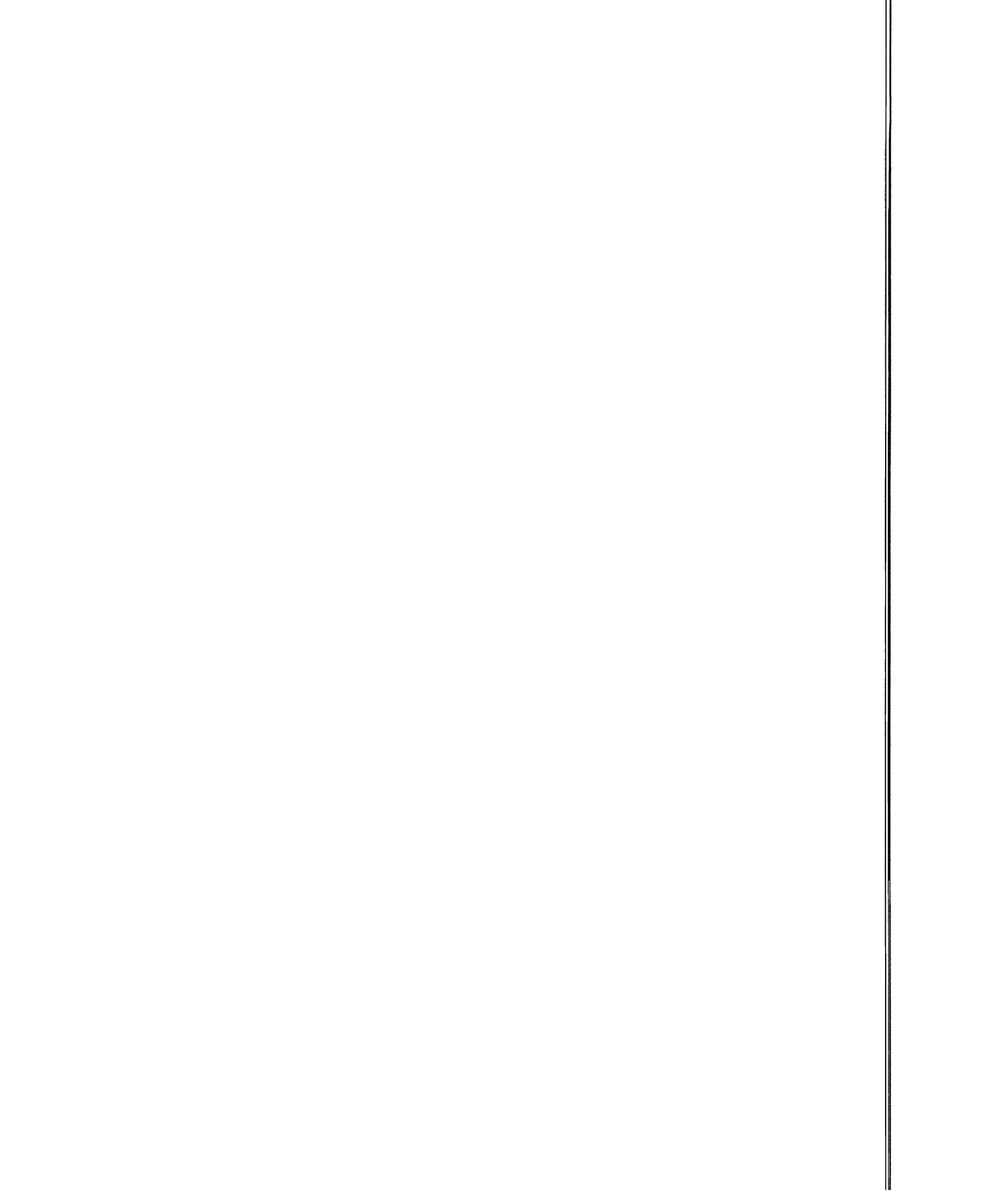
the child has grown more popular among courts. While experts often testify as to their opinion, some act as special masters with bigger roles in the final custody decision under a process equivalent to Federal Rule of Civil Procedure 53. While delegating judicial proceedings to special masters may unclog courts and shorten lengthy proceedings in hostile divorce litigation, clearer rules should be set in place to guarantee that courts will retain their ultimate adjudicative power.

First, the unique nature of the child-custody proceeding may require stricter guidelines than those that govern traditional special masters under Rule 53. Special masters in complex commercial litigation, often retired judges and attorneys, have knowledge of court procedure and the importance of pre-trial decisions. Mental-health professionals acting as special masters in family court may not reconcile their professional standards with court procedure. Furthermore, a special master in family court may not separate her own beliefs and biases from the necessary legal conclusions of the child's best interest. While some jurisdictions have set specific educational and experience requirements for mental-health professionals serving as special masters, such objective requirements may not guarantee that the special master will serve the court adequately.

Second, the use of special masters in child-custody proceedings may strip the court of its core fact-finding function. If the special master is allowed to enter a report of facts or ultimate findings and the court is bound by that report unless clearly erroneous, the court may in essence become a reviewing court rather than a finder of fact and law. A parent appearing in front of a court for an ultimate determination of their child's custody deserves to have a judge make the final conclusions. Although the court may be able to overturn a special master's findings if clearly erroneous, the high deference makes it less likely that parties will appeal decisions, effectively giving special masters more decision-making authority. Additionally, the process of monitoring a family to determine the best interests of the child may result in inappropriate ex parte discussions between parties and the special master.

One solution to these problems is to allow the parties to stipulate to the use of a special master only for small factual issues. Requiring parties to consent to the use of a special master may solve some of the problems inherent in setting uniform professional standards for special masters. Furthermore, party stipulations to the use of a special master may protect the court by preventing it from unconstitutionally delegating its fact-finding authority.

In short, special masters play an important role in the court system. To preserve this important role, courts and legislatures should develop clearer rules to ensure reliability. While the best-interests-of-the-child standard will always remain subjective and value driven, guidelines for decision makers will help preserve judicial authority and maintain access to professionals that provide such valuable assistance.



DISHONEST DEBTORS AND DISCHARGEABLE DEBTS IN
BANKRUPTCY: AN ANALYSIS OF THE CIRCUIT SPLIT REGARDING
THE INTERPRETATION OF 11 U.S.C § 523(A)(2)'S *RESPECTING THE
DEBTOR'S . . . FINANCIAL CONDITION*

Joanna L. Radmall*

I. INTRODUCTION

In some circuits, fraudulent debtors in bankruptcy may have their debts discharged—even debts obtained by actual fraud, false misrepresentations, or false pretenses. In other circuits, courts are less forgiving of such debtors and instead protect the creditors that the debtor defrauded or misled. The source of this circuit conflict is a debt dischargeability exception that applies to individuals in bankruptcy.

Section 523(a)(2) provides an exception to dischargeability for debtors who obtained credit, property, or services by actual fraud, misrepresentations, or false pretenses.¹ Generally, such debts become nondischargeable in bankruptcy cases. However, if the debtor made statements “respecting the debtor’s or insider’s financial condition,”² unless the statement was in writing,³ the debt remains dischargeable.

While this seems relatively straightforward, courts are split as to what constitutes a *statement respecting the debtor’s financial condition*. Some circuits have broadly held that a debtor’s reference to owning property, outright or

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¹ 11 U.S.C. § 523(a)(2) (2006). 11 U.S.C. § 523(a)(2)(A)–(B) states:

A discharge under § 727 . . . does not discharge an individual debtor from any debt—

- (2) for money, property, services, or an extension, renewal, or refinancing of credit, to the extent obtained, by—
 - (A) false pretenses, a false representation, or actual fraud, other than a statement respecting the debtor’s or an insider’s financial condition;
 - (B) use of a statement in writing—
 - (i) that is materially false;
 - (ii) respecting the debtor’s or an insider’s financial condition;
 - (iii) on which the creditor to whom the debtor is liable for such money, property, services, or credit reasonably relied; and
 - (iv) that the debtor caused to be made or published with intent to deceive.

² 11 U.S.C. § 523(a)(2)(A).

³ *Id.* § 523(a)(2)(B).

otherwise, qualifies as a statement of financial condition.⁴ Other circuits have interpreted financial condition more narrowly to require a complete asset and liability run-down from the debtor.⁵ Within circuits that have not adopted one of the above views, some bankruptcy courts have formulated and adopted a modified-expansive view. This view requires the court to look at the nature of the debtor's statement and the debtor's purpose in making the statement to determine whether the debtor intended it to be a statement of financial condition or a material part of the lending decision.⁶

Bankruptcy courts usually liberally construe dischargeability questions in favor of the debtor.⁷ The Tenth Circuit, however, gave a boon to all creditors who extended credit based on a debtor's oral misrepresentation by holding that as long as the debtor's oral statement is not a financial statement providing a complete look at the debtor's financial condition, it may be a basis for denial of discharge.⁸

Part II of this note discusses the dischargeability statute, its legislative history, and current case law interpreting nondischargeability where debtors have used oral statements, false pretenses and false representations to obtain credit. Part III addresses the reasoning behind both the broad and narrow interpretations of "financial condition" and why some courts felt compelled to derive a third interpretation, the modified-expansive view. Finally, Part IV discusses the need for either universal adoption of the modified-expansive view or new legislation to guide creditors, debtors, and courts to treat creditors and debtors equitably.⁹

⁴ See *Engler v. Van Steinburg (In re Van Steinburg)*, 744 F.2d 1060, 1061 (4th Cir. 1984) (noting that even a statement regarding whether the debtor owns "property free and clear" qualifies as a statement of financial condition).

⁵ See *Cadwell v. Joelson (In re Joelson)*, 427 F.3d 700, 714 (10th Cir. 2005) (determining that a statement of financial condition was one that "present[ed] a picture of the debtor's overall financial health"); *Rose v. Lauer (In re Lauer)*, 371 F.3d 406, 413-14 (8th Cir. 2004) (supporting the interpretation that statements of financial condition are "financial statements").

⁶ See *Armbrustmacher v. Redburn (In re Redburn)*, 202 B.R. 917, 928-29 (Bankr. W.D. Mich. 1996) (focusing on the intended purpose of the statement); *Norcross v. Ransford (In re Ransford)*, 202 B.R. 1, 5-6 (Bankr. D. Mass. 1996) (examining the statement's purpose and the debtor's intention behind the statement made to the creditor).

⁷ See *Equitable Bank v. Miller (In re Miller)*, 39 F.3d 301, 304 (11th Cir. 1994) (noting that discharge questions are liberally construed in favor of the debtor); *Boyle v. Abilene Lumber, Inc. (In re Boyle)* 819 F.2d 583, 587 (5th Cir. 1987) (stating that general bankruptcy policy favors discharge for the debtor); *Boroff v. Tully (In re Tully)*, 818 F.2d 106, 110 (1st Cir. 1987) (noting that questions of discharge ordinarily favor the debtor).

⁸ *In re Joelson*, 427 F.3d at 714.

⁹ This Note does not delve into the differences in dischargeability under subsection (A) and (B) of 11 U.S.C. § 523(a)(2). For instance, § 523(a)(2)(B) allows the debt to become nondischargeable if the debtor obtained the debt by false pretenses, actual fraud, or a false representation using a written statement of financial condition with the intent to deceive and upon which the creditor reasonably relied. This Note does not address what constitutes a writing for the purpose of subsection (B). Rather, its goal is to determine

II. BACKGROUND

Section 523 of the Bankruptcy Code sets out the exceptions to an individual debtor in bankruptcy's right to discharge her debts. Despite the many changes in the Bankruptcy Code from last year's Bankruptcy Abuse Prevention and Consumer Protection Act of 2005 (BAPCPA),¹⁰ Section 523(A)(2) of the Code remained untouched.

A. *The Statute*

Section 523 of the Bankruptcy Code divides debts obtained by false pretenses, false representations, and fraud into two categories with differing criteria for whether the court will discharge the debt. First, § 523(a)(2)(A) states that debts obtained by fraudulent pretenses, representations, or actual fraud are not dischargeable by the debtor in bankruptcy.¹¹ However, statements respecting the debtor's financial condition cannot constitute the false pretense, representation, or actual fraud.¹² Importantly, this section does not specify that the statement respecting the debtor's financial condition must be in writing. Second, § 523(a)(2)(B) states that a debtor receives no discharge in bankruptcy if the debtor used a materially false, written statement respecting the debtor's financial condition with the intent to deceive on which the creditor relied.¹³ Contrasting this section with the first, subsection (B) protected the creditor because the debt is nondischargeable as long as the statement respecting the debtor's financial condition was in writing.

The Fourth Circuit summarized best the interplay of these two sections stating that "[t]he Bankruptcy Act provides that a debtor may not discharge debts for money obtained by false pretenses, false representations, or fraud, except that false statements 'respecting the debtor's . . . financial condition' must be in writing in order for the debt to be nondischargeable."¹⁴ Regardless of whether the fraudulent statements or representations are written or oral, the courts must determine whether the statements or representations respected the debtor's financial condition because the Bankruptcy Code does not define "financial condition."¹⁵

whether it is possible to uniformly interpret the phrase "statement of financial condition" such that creditors and debtors are treated equitably across the circuits.

¹⁰ Bankruptcy Abuse Prevention and Consumer Protection Act of 2005 (BAPCPA), Pub. L. No. 109-8, 119 Stat. 23 (codified as amended in scattered sections of 11 U.S.C.).

¹¹ 11 U.S.C. § 523(a)(2)(A) (2006).

¹² *Id.*

¹³ *Id.* § 523(a)(2)(B).

¹⁴ Engler v. Van Steinburg (*In re Van Steinburg*), 744 F.2d 1060, 1060 (4th Cir. 1984) (citing 11 U.S.C. § 523(a)(2)(A)–(B)). Under § 523(a)(2)(B), the creditor must also prove that it reasonably relied upon the debtor's fraudulent written statement and that the debtor intended to deceive the creditor with that fraudulent written statement.

¹⁵ Interestingly, while financial condition is not defined in the Bankruptcy Code, it is referred to in the definition of "insolvent." See 11 U.S.C. § 101(32)(A) (defining

B. Legislative History

The Supreme Court laid out the history of the exceptions to nondischargeability for debts obtained by fraud in *Field v. Mans*.¹⁶ In the original Bankruptcy Act of 1898,¹⁷ debts were not dischargeable where property was “obtain[ed] . . . by false pretenses or false representations.”¹⁸ In 1903, Congress amended the Bankruptcy Code to allow bankruptcy judges to choose not to discharge debts where the debtor “obtained property on credit from any person upon a materially false statement in writing made to such person for the purpose of obtaining such property on credit.”¹⁹

For nearly sixty years, debtors in bankruptcy did not receive discharges for debts obtained by false pretenses or representations or if debtors used writings containing materially false statements intended to induce the creditor to lend to them. On July 12, 1960, Congress amended the Bankruptcy Code to appear more like the Code today, requiring that debts be nondischargeable for:

[L]iabilities for obtaining money or property by false pretenses or false representations, or for obtaining money or property on credit or obtaining an extension or renewal of credit in reliance upon a materially false statement in writing *respecting his financial condition* made or published or caused to be made or published in any manner whatsoever with intent to deceive²⁰

“insolvent” as “with reference to an entity other than a partnership and a municipality, *financial condition* such that the sum of such entity’s debts is greater than all of such entity’s property”) (emphasis added). Notably, in *Weiss v. Alicea (In re Alicea)*, the court used this definition as part of its reasoning for declaring a debt dischargeable because the debtor had stated that the debtors had no financial means to pay on their own. 230 B.R. 492, 504 (Bankr. S.D.N.Y. 1999). That court interpreted a lack of ability to pay as being insolvent. *Id.*

¹⁶ *Field v. Mans*, 516 U.S. 59, 64–66 (1995).

¹⁷ Bankruptcy Act of 1898, ch. 541, 30 Stat. 544 (codified as amended in scattered sections of 11 U.S.C.) (repealed 1978). In 1978, Congress adopted the new Bankruptcy Code, which was codified in 11 U.S.C. §§ 101–1532.

¹⁸ Bankruptcy Act of 1898, ch. 541, 30 Stat. 550 (repealed 1978) (superseded by 11 U.S.C. § 523(a)(2) (2006)).

¹⁹ Bankruptcy Act, ch. 487, § 4(b), 32 Stat. 797–98 (1903).

²⁰ Amendment to Bankruptcy Act, Pub L. No. 86-621, 74 Stat. 408–09 (1960) (emphasis added). Notably, the purpose for this change in the Code was “[t]o amend the Bankruptcy Act to limit the use of false financial statements as a bar to discharge.” *Id.* at 408. The 1960 amendment also changed 11 U.S.C. § 32(c)(3) addressing a “sole proprietor, partnership, or . . . an executive of a corporation” to prohibit discharge where the credit was extended because the debtor gave a materially false written statement “respecting his financial condition or the financial condition of such partnership or corporation.” *Id.*

Significantly, part of the debate over the meaning of “financial condition” today stems from the Supreme Court’s review of the history of this part of the Code in *Field v. Mans*. 516 U.S. at 64–66. When discussing the 1960 Bankruptcy Act, the Court substituted

In sum, the legislative history shows that Congress acknowledged that not all debt obtained by fraud, false pretenses, or false representations should be nondischargeable. Thus in 1960, Congress pushed part of the responsibility back onto the creditor to practice due diligence when lending to debtors.

C. *The Circuit Split*

While this issue has not come before circuit courts with great regularity, there is nonetheless a split between the circuits and general disarray among the lower courts as to the proper interpretation of a statement of financial condition.

There are three approaches to interpreting statement of financial condition.²¹ First, the *broad interpretation*, or *expansive view*, allows “a communication addressing the status of a single asset or liability [to] satisf[y] this element.”²² Second, the *narrow interpretation*, or *limited view*, “is satisfied by communications that give a sense of the debtor’s overall financial condition.”²³ Third, the *modified-expansive view* “examines the weight that a lender may put in such a document in determining whether to lend and the intention of such a document.”²⁴

1. *Broad Interpretation or Expansive View*

In *Engler v. Van Steinburg*, the Fourth Circuit held that “[a] debtor’s assertion that he owns certain property free and clear of other liens is a statement respecting his financial condition.”²⁵ In *In re Van Steinburg*, the creditor loaned the debtor \$5500 and received a security interest in livestock and farm tools. The debtor told the creditor that the creditor would have a “first priority security interest in the property, even though Van Steinburg [debtor] knew that other creditors had superior liens.”²⁶ However, all of the statements in the security interests themselves were true.²⁷ The bankruptcy court held that the debtor’s statements about

“financial statement” for the actual words from the 1960 amendment, “financial condition.” *Id.* at 65. See *Cadwell v. Joelson (In re Joelson)*, 427 F.3d 700, 709–10 (10th Cir. 2005) (noting that several courts point to the Supreme Court’s substitution of financial statement as justification for interpreting “financial condition” to be narrowly limited to “financial statement”).

²¹ See *Am. Gen. Fin. Servs. v. Costanzo (In re Costanzo)*, Bankruptcy Case No. 05-42920, Adv. No. 05-6094, 2006 WL 2460639, at *3 n.2 (Bankr. D. N.J. Aug. 23, 2006) (referring to the Tenth Circuit’s analysis in *In re Joelson*, 427 F.3d at 704).

²² *Id.* at *3 n.2.

²³ *Id.*

²⁴ *Id.* (citing *Telmark v. Booher (In re Booher)*, 284 B.R. 191, 212 (Bankr. W.D. Pa. 2002)).

²⁵ *Engler v. Van Steinburg (In re Van Steinburg)*, 744 F.2d 1060, 1061 (4th Cir. 1984).

²⁶ *Id.* at 1060.

²⁷ *Id.*

“own[ing] the property free and unencumbered related to his financial condition.”²⁸ The court compared the case with a court using the narrow interpretation of financial condition and found that interpretation wanting:

Concededly, a statement that one’s assets are not encumbered is not a formal financial statement in the ordinary usage of that phrase. But Congress did not speak in terms of financial statements. Instead it referred to a much broader class of statements — those “respecting the debtor’s . . . financial condition.” A debtor’s assertion that he owns certain property free and clear of other liens is a statement respecting his financial condition. *Indeed whether his assets are encumbered may be the most significant information about his financial condition.*²⁹

Many courts that espouse this view hold that a statement of the financial condition of even one asset qualifies under the statute and therefore the statement may not be used in a 523(a)(2)(A) claim as evidence of false pretense, false representation or actual fraud.³⁰

2. *Narrow Interpretation or Limited View*

In 2004, the Tenth Circuit Bankruptcy Appellate Panel held that only a statement of the “debtor’s net worth, overall financial health, or ability to generate income” meets the definition of financial condition.³¹ In *Cadwell v. Joelson*,

²⁸ *Id.*

²⁹ *Id.* at 1060–61 (emphasis added).

³⁰ See *Beneficial Nat’l Bank v. Priestley (In re Priestley)*, 201 B.R. 875, 882 (Bankr. D. Del. 1996) (noting that financial condition includes “statements concerning the condition or quality of a single asset or liability impacting on the debtor’s financial picture.”); see also *In re Van Steinburg*, 744 F.2d at 1060–61 (holding that a statement of owning property free and clear was a statement of financial condition under the statute); cf. *Benjelloun v. Robbins (In re Robbins)*, 178 B.R. 299, 304 (Bankr. D. Mass. 1995) (declaring that a document called “Summary of Proposed Investment” containing only financial information on “a particular property” was not sufficient); *Resolution Trust Corp. v. Oliver (In re Oliver)*, 145 B.R. 303, 305 (Bankr. E.D. Mo. 1992) (stating that “debtor’s statement about a single asset is not *per se* a statement respecting the debtor’s financial condition”).

³¹ *Cadwell v. Joelson (In re Joelson)*, 307 B.R. 689, 696 (B.A.P. 10th Cir. 2004). See also *Old Kent Bank-Chicago v. Price (In re Price)*, 123 B.R. 42, 45 (Bankr. N.D. Ill. 1991) (holding that statements of financial condition are ones that describe the debtor’s net worth or total financial position); *D. Nagin Mfg. Co. v. Pollina (In re Pollina)*, 31 B.R. 975, 978 (Bankr. D.N.J. 1983) (explaining that financial statement applies to any statement or representation of the debtor’s net worth, including balance sheets, profit/loss statements, weekly wages and individual existing debts); *Jokay Co. v. Mercado (In re Mercado)*, 144 B.R. 879, 885 (Bankr. C.D. Cal. 1992) (noting that in ordinary usage financial condition is a representation of the debtor’s net worth or ability to create income).

Cadwell, a retiree, befriended Jeanne Joelson, a local waitress, and lent her more than \$50,000 to stop foreclosure on property she told Cadwell she owned.³² They drove from Wyoming to Arizona so that Joelson could show Cadwell the property that she represented she owned.³³ While they were there, a person living at the house gave Joelson money that Joelson represented to Cadwell was for the rent.³⁴

Additionally, Joelson represented that she “owned other residences, a motel, and several antique cars. She showed [Cadwell] these other properties, including a storage facility that housed the cars.”³⁵ Joelson also told Cadwell that her brother was going to lend her the money to pay off the foreclosure loan and that she would repay Cadwell with her brother’s money when he gave it to her.³⁶ Cadwell drove Joelson to Arizona again and met the foreclosing lender. During this meeting, Cadwell learned that the property was titled to “Jolene Joelson” and not “Jeanne Joelson.”³⁷ To induce Cadwell to agree to the loan, Joelson promised to sign a promissory note and give Cadwell collateral against the loan; however, while Joelson did give Cadwell a promissory note, she never gave him collateral to secure the loan.³⁸ Shortly after that, Joelson filed for bankruptcy and Cadwell sought to prevent his debt from being discharged due to Joelson’s fraudulent representations.

Joelson contended that she had made oral statements respecting her financial condition by alleging ownership of properties and antique cars and showing Cadwell the properties. Under § 523(a)(2)(A), those statements of financial condition are not actionable.³⁹ The bankruptcy court held that the claim was

Interestingly, a New York bankruptcy court held that a debtor telling the creditor that “he . . . lacked the present ability to pay” was a statement of financial condition under the statute because it was “essentially a statement of [his] insolvency.” *Weiss v. Alicea* (*In re Alicea*), 230 B.R. 492, 504 (Bankr. S.D.N.Y. 1999). Furthermore, the court noted that insolvency is defined in the Bankruptcy Code “as a type of ‘financial condition.’” *Id.* (quoting 11 U.S.C. § 101(32)(A) (2006)).

³² *In re Joelson*, 307 B.R. at 691.

³³ *Id.*

³⁴ *Id.*

³⁵ *Id.* at 691–92.

³⁶ *Id.* at 691. It is interesting to note that the Tenth Circuit refused to accept this statement as going to Joelson’s ability to generate future income since the statement implies that the loan would be of short duration because Joelson’s brother intended to lend her money. *Caldwell v. Joelson* (*In re Joelson*), 427 F.3d 700, 715 (10th Cir. 2005). While strictly speaking receiving an anticipated loan is not future income, it was likely a determinative factor in whether Cadwell would lend Joelson the money, and therefore, the statement was material to Cadwell’s decision. *See id.*

³⁷ *Id.* at 692. Jeanne Joelson apparently convinced Cadwell that Jeanne and Jolene Joelson were the same person. *Id.*

³⁸ *Id.*

³⁹ 11 U.S.C. § 523(a)(2)(A) (2006). Joelson argued that this interpretation of financial condition is in harmony with the holding of *Engler v. Van Steinburg* (*In re Van Steinburg*), 744 F.2d 1060, 1060 (4th Cir. 1984). Petition for Writ of Certiorari at 5, *Joelson v. Cadwell*, 126 S.Ct. 2321 (2006) (No. 05-1121), 2006 WL 598166. Joelson emphasized that

nondischargeable under 11 U.S.C. § 523(a)(2)(A).⁴⁰ The Bankruptcy Appellate Panel also affirmed the nondischargeability of the debt.⁴¹ Finally, the Tenth Circuit upheld the lower courts and declared that the debt was nondischargeable because neither Joelson's representations about owning the properties and cars nor her representation that she would repay Cadwell when her brother lent her the money "constitute[d] statements 'respecting [Joelson's] financial condition'"⁴² The court found that her representation of her brother's forthcoming loan did not "reflect[] Joelson's overall financial health, and therefore does not 'respect[] the debtor's . . . financial condition'"⁴³ The court further explained that although the statement did address part of her flow of income, the debt was nondischargeable because the statement did "not reflect Joelson's overall financial health."⁴⁴

3. *Modified-Expansive View*

The modified-expansive view scrutinizes the "nature of the statement and the purpose for which it is sought and made."⁴⁵ Courts espousing this view consider whether the single asset or liability about which the debtor made the misrepresentation "materially affect[s] the debtor's . . . overall financial condition" and is "made for the purpose of demonstrating financial wherewithal to pay a debt or perform a contract."⁴⁶

Cadwell "should have had the debtor complete a signed written financial statement before advancing such a significant amount of money." *Id.*

⁴⁰ *In re Joelson*, 307 B.R. at 691.

⁴¹ *Id.* at 696–97.

⁴² *Cadwell v. Joelson (In re Joelson)*, 427 F.3d 700, 715 (10th Cir. 2005). The court did not address whether Joelson's misrepresentation of her identity (being Jeanne or Joelene) rendered the debt dischargeable because the bankruptcy court was unable to determine whether the names did in fact represent two different people. *Id.* at 715 n.5. Moreover, the court noted that it could not determine whether a misrepresentation about identity would render the debt nondischargeable. *Id.*

⁴³ *Id.* at 715.

⁴⁴ *Id.*

⁴⁵ *Weiss v. Alicea (In re Alicea)*, 230 B.R. 492, 503 n.8 (Bankr. S.D.N.Y. 1999). See *Norcross v. Ransford (In re Ransford)*, 202 B.R. 1, 4–5 (Bankr. D. Mass. 1996) (adopting the modified-expansive view).

⁴⁶ *In re Alicea*, 230 B.R. at 503 n.8 (citation omitted). See *In re Ransford*, 202 B.R. at 4 (agreeing with the method used in the *Mercado* case); *Jokay Co. v. Mercado (In re Mercado)*, 144 B.R. 879, 884 (Bankr. C.D. Cal. 1992) (looking at the materiality of the asset in question); cf. *First Fed. Bank v. Mulder (In re Mulder)*, 306 B.R. 265, 271 (Bankr. N.D. Iowa 2004) (recognizing that "[t]he purpose of the statement must be to indicate the debtor's overall financial condition" but not specifically calling the court's method the modified-expansive view) (emphasis added).

However, the court in *Alicea* criticizes this approach stating that it merely restates the broad view of § 523(a)(2)(B) because those courts consider whether the statement about

In *Norcross v. Ransford*, the creditors and the parents of the debtor were close friends.⁴⁷ In 1985, the debtor's father conveyed a valuable property to the debtor for no consideration.⁴⁸ The debtor executed the deed and immediately conveyed the property back to his father.⁴⁹ However, this last conveyance was not recorded until August 6, 1992, and the debtor's parents represented to the creditors that the debtor still owned the property—never mentioning that the debtor reconveyed the property back to the debtor's father.⁵⁰

In 1991, the creditors sold their business to the debtor after having several conversations with the debtor where he represented to the creditors that he owned the property.⁵¹ The debtor executed a promissory note for \$140,000 to be paid to the creditors over sixteen years. The creditors secured the interest with the company's equipment and inventory.⁵² The attorney who completed the deal purported to jointly represent the parties.⁵³ This attorney reassured the creditors during the closing that although they wanted a mortgage on the property owned by the debtor, the property was valuable enough that the debtor would be solvent should he default on the note.⁵⁴

The debtor paid the creditors sporadically until July 1992 and then recorded the reconveyance of the property back to the debtor's father one month later.⁵⁵ Two years later, the creditors foreclosed on the business's collateral, but there was still a deficiency, so they began foreclosure proceedings against the property.⁵⁶ One month later, the debtor filed for bankruptcy and the creditors sought to have their debt barred from discharge.⁵⁷

The debtor contended that the debt was dischargeable under § 523(a)(2)(A) because he had made misrepresentations respecting his financial condition.⁵⁸ The Massachusetts bankruptcy court recognized the circuit split regarding whether to interpret financial condition broadly or narrowly, but noted that it agreed with the outcomes of the cases it cited, regardless of how broadly or narrowly the phrase

the asset is materially related to the debtor's financial condition and "[m]ateriality is already an element of the fraud claim." 230 B.R. at 503 n.8.

⁴⁷ 202 B.R. at 2.

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.* The creditors even visited the Registry of Deeds and verified the debtor's continued interest in the property before agreeing to sell the debtor their business. *Id.*

⁵² *Id.*

⁵³ *Id.* The creditors did not know that this attorney was associated with the attorney who had helped the debtor reconvey the property to the debtor's father. *Id.* Moreover, during the closing of the sale of the business, the attorney never disclosed to the creditors that the property in question actually belonged to the debtor's father. *Id.*

⁵⁴ *Id.*

⁵⁵ *Id.* at 3.

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ *Id.*

was interpreted.⁵⁹ The *Ransford* court ultimately relied on a California bankruptcy court case⁶⁰ which looked at the purpose of the statement made by the debtor.⁶¹ It found that the reasoning in *Jokay Co. v. Mercado*⁶² “provided a framework for better distinguishing between a statement which implicates a debtor’s financial condition from one that does so only incidentally.”⁶³ Additionally, the *Ransford* court noted that the cases it reviewed from within its district all followed this method of “searching out the purpose of the statement complained of.”⁶⁴

Importantly, the *Ransford* court acknowledged that this method of analysis works under both § 523(a)(2)(A) and § 523(a)(2)(B).⁶⁵ Thus, the court allowed the debt to be discharged because the debtor made an oral statement respecting the debtor’s financial condition⁶⁶ and because the creditors did not obtain that statement in writing.⁶⁷ Moreover, the court found that the debtor’s purpose in making his statements was to convince the creditor that even if the debtor’s business failed, the debtor had other property upon which the creditors could rely for repayment of the debt.⁶⁸

⁵⁹ *Id.* at 4.

⁶⁰ *Jokay Co. v. Mercado (In re Mercado)*, 144 Bankr. 879, 883–85 (Bankr. C.D. Cal. 1992). In *Mercado*, the court determined that the statement of when a building project would be complete and free of all liens was not a statement of financial condition. *Id.* at 882. That court recognized that in the cases where financial condition was interpreted broadly:

[E]ach debtor was attempting to obtain loans and the overall financial condition of each was extremely relevant to the lender in granting the loan. In that circumstance, a misrepresentation regarding a material asset that would effect the evaluation of the overall financial condition of the debtor certainly fits within the parameters of § 523(a)(2)(B). However, that is not the situation here. Plaintiff was interested in the financial condition of the Property. Plaintiff was not relying upon the overall financial condition of Debtor. . . . The overall financial condition of Debtor was irrelevant to the transaction. Yes, the status of the Property did affect the overall financial condition of Debtor, *but this was neither the focus nor the purpose of the inquiry*. Plaintiff was not relying on Debtor’s financial capacity for completion of the Project Therefore, I decline to follow the rationale of . . . *Van Steinburg*.

In re Ransford, 202 B.R. at 5 (quoting *Mercado*, 144 B.R. at 884 (footnote omitted)).

⁶¹ *In re Ransford*, 202 B.R. at 4.

⁶² *In re Mercado*, 144 B.R. at 844.

⁶³ *In re Ransford*, 202 B.R. at 5.

⁶⁴ *Id.*

⁶⁵ *Id.* at 5.

⁶⁶ The court stated that the statements of ownership of the property were not meant to “incidentally describe the ownership of the Hopper farm [property], but to demonstrate the Debtors’ financial condition.” *Id.*

⁶⁷ *Id.* at 6.

⁶⁸ *Id.* at 5.

Likewise, in *Armbrustmacher v. Redburn*, the court noted that courts using the modified-expansive view consider whether the statement in issue constitutes “information [that] a potential lender or investor would generally consider before investing” in addition to the purpose of the debtor’s statement.⁶⁹

III. DISCUSSION

As the law currently stands, creditors are more protected from fraudulent debtors in bankruptcy in the Tenth Circuit under § 523(a)(2)(A) than in the Fourth Circuit; whereas debtors in bankruptcy are much better off filing in the Fourth Circuit. Several courts, including the *Joelson* and *Ransford* courts, have discussed the policy reasons behind adopting a particular view.

The purpose of discharge under the Bankruptcy Code is to give the honest debtor a new start because emerging from bankruptcy as productive members of society when burdened by unpaid debts is nearly impossible.⁷⁰ However, that new start is a privilege and not a right.⁷¹ While discharge is not guaranteed for all debts, “[i]t is well established that exceptions to discharge are to be construed narrowly against creditors, and must not be allowed to swallow the general rule favoring discharge.”⁷²

⁶⁹ *Armbrustmacher v. Redburn* (*In re Redburn*), 202 B.R. 917, 928 (Bankr. W.D. Mich. 1996).

⁷⁰ *E.g.*, *Grogan v. Garner*, 498 U.S. 279, 286–87 (1991); *see Williams v. U.S. Fid. & Guar. Co.*, 236 U.S. 549, 554–55 (1915) (“It is the purpose of the bankrupt[cy] act to convert the assets of the [debtor] into cash for distribution among creditors, and then to relieve the honest debtor from the weight of oppressive indebtedness, and permit him to start afresh free from the obligations and responsibilities consequent upon business misfortunes.”) (emphasis added); *Univ. of Ala. Hosps. v. Warren* (*In re Warren*), 7 B.R. 201, 202 (Bankr. N.D. Ala. 1980) (noting that bankruptcy allows the debtor “a new opportunity in life and a clear field for future effort, unhampered by the pressure and discouragement of pre-existing debt” (quoting *Local Loan Co. v. Hunt*, 292 U.S. 234, 244 (1934))).

⁷¹ Courts agree that the legislative intent to provide a fresh start extends only to the honest debtor. *Perez v. Campbell*, 402 U.S. 637, 660 (U.S. 1971); *see United States v. Sanabria*, 424 F.2d 1121, 1123 (7th Cir. 1970) (emphasizing that it is good for both the public and the debtor to give a fresh start to the honest debtor); *Hickman v. Texas* (*In re Hickman*), 260 F.3d 400, 404 (5th Cir. 2001) (emphasizing that the “Code’s basic purpose” is “reliev[ing] the honest debtor from the weight of oppressive indebtedness and permitting him to start afresh” (alteration in original) (quoting *Williams v. U.S. Fid. & Guar. Co.*, 236 U.S. 549, 554–55 (1915))); *Handeen v. LeMaire* (*In re LeMaire*), 898 F.2d 1346, 1352 (8th Cir. 1990) (explaining that the Bankruptcy Code’s second purpose is to relieve the debtor of his debts through discharge); *cf. In re May*, 12 B.R. 618, 621 (Bankr. N.D. Fla. 1980) (noting that dischargeability of debt “is not intended to be available to a dishonest debtor”).

⁷² *Am. Express Travel Related Servs. Co. v. McKinnon* (*In re McKinnon*), 192 B.R. 768, 771 (Bankr. N.D. Ala. 1996).

A. *Policy Arguments for the Narrow/Limited View*

Dishonest debtors take advantage of creditors by obtaining credit through false statements, false pretense, or actual fraud. The position of the courts espousing the limited/narrow view of “financial condition” is that courts should not discharge these fraudulently acquired debts in bankruptcy.

The courts espousing this view usually follow one or more rationales. First, in ordinary financial parlance, a financial statement “denotes a balance sheet of some kind, an accounting of assets and liabilities.”⁷³ Most people with financial backgrounds would not consider a statement merely indicating whether people owned their home a statement of their financial condition. People regularly say they “own” their home, even though they have little to no equity in it. They consider themselves homeowners simply by virtue of the fact that they no longer pay rent.

Second, limited-view courts want to prevent a reward to those debtors guilty of “egregious frauds” perpetrated by “oral misrepresentations of a debtor’s financial condition.”⁷⁴ These courts are concerned that those “frauds will go unaddressed under a more expansive reading.”⁷⁵ A Massachusetts bankruptcy court noted that those egregious frauds would likely “be perpetrated upon naïve lenders. These would most likely be amateur lenders — friends, family, and the like — rather than banks and other institutional lenders, which generally require financial information upon which they intend to rely to be in writing.”⁷⁶ The result would leave “many plaintiffs . . . without a cause of action if they did not have the foresight to require a written statement in situations that normally do not require one.”⁷⁷

The limited-view courts criticize the broad interpretation of “statement of financial condition” because it would result in all fraudulent debt being dischargeable because “[v]irtually any statement concerning an asset or liability arguably relates to financial condition.”⁷⁸ Too broad an interpretation would enable many debtors guilty of oral misrepresentations to “escape the anti-discharge provisions completely.”⁷⁹ The *Alicea* court noted that the dischargeability exceptions in § 523(a)(2) would “swallow[] up the general rule in subdivision (A),” and “would permit many dishonest debtors to avoid the consequences of oral

⁷³ *In re Redburn*, 202 B.R. at 925; see *Jokay Co. v. Mercado (In re Mercado)*, 144 B.R. 879, 885 (Bankr. C.D. Cal. 1992) (“The ordinary usage of ‘statement’ in connection with ‘financial condition’ denotes either a representation of a person’s overall ‘net worth’ or a person’s overall ability to generate income.”).

⁷⁴ *In re Redburn*, 202 B.R. at 925.

⁷⁵ *Id.*

⁷⁶ *Zimmerman v. Soderlund (In re Soderlund)*, 197 B.R. 742, 746 (Bankr. D. Mass. 1996).

⁷⁷ *Gehlausen v. Olinger (In re Olinger)*, 160 B.R. 1004, 1011 (Bankr. S.D. Ind. 1993).

⁷⁸ *Weiss v. Alicea (In re Alicea)*, 230 B.R. 492, 502 (Bankr. S.D.N.Y. 1999).

⁷⁹ *Id.* at 502.

fraud.”⁸⁰ For these reasons, the limited-view courts seek more to protect the creditor than the dishonest debtor, despite the historical fresh start policy.

B. Policy Arguments for the Broad/Expansive View

Broad-view courts, on the other hand, think it reasonable to require creditors to perform due diligence to ensure that the debtor’s statements that induce the creditor to lend the debtor money, property, or services are true. Broad-view courts criticize the policies of limited view courts because without requiring creditors to test the truthfulness of the debtor’s statements and representations, creditors have their cake and eat it too. In other words, they give credit and are certain to have good long-term odds of cashing in later when the fraudulent debtor files for bankruptcy.

Broad-view courts justify their stance based on the fresh start policy and the policy that courts should liberally construe discharge exceptions in favor of the debtor.⁸¹ Accordingly, broad-view courts note that virtually any statement about a debtor’s finances can be construed as part of their financial condition to render a debt undischARGEABLE.⁸²

Courts espousing the broad view generally interpret “statement” to be “an utterance of some kind, denotation not limited to the word’s financial context.”⁸³ Many courts that follow this view rely on the *Van Steinburg* court’s statement of Congress’s intent, noting that if Congress wanted to have courts consider financial statements (i.e., asset and liability sheets, etc.), then Congress would have used that language instead of the broader term “financial condition.”⁸⁴

⁸⁰ *Id.* at 504.

⁸¹ See *In re Ransford*, 202 B.R. at 5–6.

⁸² The *Skull Valley* court noted that in *Engler v. Van Steinberg* the court’s decision “turned on whether a statement that an asset was not encumbered was or was not a statement regarding financial condition.” *Skull Valley Band of Goshute Indians v. Chivers (In re Chivers)*, 275 B.R. 606, 614 n.3 (Bankr. D. Utah 2002). See *Engler v. Van Steinberg (In re Van Steinberg)*, 744 F.2d 1060 (4th Cir. 1984). While the *Skull Valley* court ultimately chose the limited-view interpretation, it is interesting to note that both it and the Tenth Circuit favored *Van Steinburg*’s position that “[a] debtor’s assertion that he owns certain property free and clear of other liens is a statement respecting his financial condition. Indeed, whether his assets are encumbered may be the most significant information about his financial condition.” *Bellco First Fed. Credit Union v. Kaspar (In re Kaspar)*, 125 F. 3d 1358, 1361 (10th Cir. 1997) (quoting *In re Van Steinburg*, 744 F.2d at 1060–61).

⁸³ *Armbrustmacher v. Redburn (In re Redburn)*, 202 B.R. 917, 925 (Bankr. W.D. Mass. 1996).

⁸⁴ *In re Van Steinburg*, 744 F.2d at 1060–61. For that court’s complete statement, see *supra* note 25 and accompanying text. The *Ransford* court commented that the “plain language of § 523(a)(2) does not require that the ‘statement’ be a traditional financial statement. And the statute provides no further guidance.” *Norcross v. Ransford (In re Ransford)*, 202 B.R. 1, 4 (Bankr. D. Mass. 1996).

Additionally, courts use this view to protect honest debtors from unscrupulous lenders. One of Congress's concerns was that institutional lenders deliberately took advantage of less-sophisticated debtors.⁸⁵ One court described how lenders would "coax[] potential borrowers into submitting incomplete financial information" by providing too little space on the form to list the borrower's assets and liabilities and then have the customer certify that their financial statement was complete.⁸⁶ When the debtor later filed bankruptcy, those unscrupulous lenders would challenge the discharge of that debt claiming the debtor was fraudulent.⁸⁷ Broad-view courts want to protect honest debtors from being tricked into "presenting a false picture of [their] overall financial condition."⁸⁸

Critics of broad-view courts, however, rely heavily on the *Field* court's repeated statements that § 523(a)(2)(B) refers to "false financial statements,"⁸⁹ instead of the language "false statements of financial condition" in the statute.⁹⁰ Additionally, critics of the broad view have noted that restricting financial condition to mean overall financial health and ability to generate future income "narrows the scope of the provision to only the most deliberate false statements."⁹¹

⁸⁵ See Barry L. Zaretsky, *The Fraud Exception to Discharge Under the New Bankruptcy Code*, 53 AM. BANKR. L.J. 253, 259–61 (1979) (describing the evolution of the nondischargeability statute in the Bankruptcy Code and noting that prior to the 1960 amendments, all of the debtor's debts were nondischargeable if any creditor could prove that the debtor obtained any of his credit fraudulently).

⁸⁶ *Weiss v. Alicea (In re Alicea)*, 230 B.R. 492, 503 (Bankr. S.D.N.Y. 1999) (citing *Field v. Mans*, 516 U.S. 59, 76–77 n.13 (1995) and H.R. Rep. No. 95–595, at 130–31 (1977), *reprinted in* 1978 U.S.C.C.A.N. 5963, 6091). The *Field* court noted that it seemed that:

Congress wanted to moderate the burden on individuals who submitted false financial statements, not because lies about financial condition are less blameworthy than others, but because the relative equities might be affected by practices of consumer finance companies, which sometimes have encouraged such falsity by their borrowers for the very purpose of insulating their own claims from discharge.

Field, 516 U.S. at 76–77.

⁸⁷ *In re Alicea*, 230 B.R. at 503.

⁸⁸ *Id.*

⁸⁹ *Field*, 516 U.S. at 65–66.

⁹⁰ *Skull Valley Band of Goshute Indians v. Chivers (In re Chivers)*, 275 B.R. 606, 614–15 (Bankr. D. Utah 2002). The *Chivers* court noted that the *Field* court refers to "false financial statements" at 516 U.S. at 64–65, 65 n.6, and 76. *Id.* However, the *Field* court was grappling with what level of reliance is required under the fraud statute and was not determining the meaning of financial condition. *Field*, 516 U.S. at 65.

⁹¹ *Zimmerman v. Soderlund (In re Soderlund)*, 197 B.R. 742, 746 (Bankr. D. Mass. 1996).

The broad view of statements of financial condition has been the historically prevailing view until the last decade or so.⁹² This view reiterates a commitment to protecting debtors from their creditors in bankruptcy. It also places the responsibility for lending credit to bad debtors on the creditor.

C. Policy Arguments for the Modified-Expansive View

A Massachusetts and a Michigan bankruptcy court broke away from both the broad and limited views and created the modified-expansive view. Both courts agreed with the holdings of cases that relied on the limited view, as well as holdings that relied on the broad view.⁹³

The *Redburn* court commented that the plain meaning of a statute controls except in the case where it “will produce a result demonstrably at odds with the intentions of its drafters.”⁹⁴ Nevertheless, the court noted that both interpretations claimed to be within the plain meaning of the statute and “plausibly so.”⁹⁵ After determining that “neither reading will produce results ‘demonstrably at odds’ with Congressional intent,”⁹⁶ the *Redburn* court adopted the “expansive view, with modification.”⁹⁷ The court explained:

Congress could have elected to use the more precise term “financial statement” but did not. Instead it used the word “statement” and, later in the same sentence, limited its meaning by adding, “respecting the debtor’s or an insider’s financial condition.” Thus, the only “statements” which fall within subsection (A)’s exception—and are therefore actionable only under subsection (B), and only then if they are in writing—are those “respecting the debtor’s or an insider’s financial condition.” Of course, oral statements regarding matters other than the debtor’s or an insider’s financial condition and which constitute false pretenses, false representation, or actual fraud remain actionable under section 523(a)(2)(A).⁹⁸

Interestingly, when the *Soderlund* court broke down the advantages and disadvantages of the limited and broad views, the court commented that “[e]ither interpretation could bring forth a parade of imaginary horrors.”⁹⁹ The *Ransford*

⁹² *In re Chivers*, 275 B.R. at 614.

⁹³ *Norcross v. Ransford (In re Ransford)*, 202 B.R. 1, 4 (Bankr. D.Mass. 1996).

⁹⁴ *Armbrustmacher v. Redburn (In re Redburn)*, 202 B.R. 917, 926 (Bankr. W.D. Mich. 1996) (quoting *United States v. Ron Pair Enters.*, 489 U.S. 235, 242 (1989)).

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ *Id.* at 927.

⁹⁸ *Id.*

⁹⁹ *Zimmerman v. Soderlund (In re Soderlund)*, 197 B.R. 742, 746 (Bankr. D. Mass. 1996). That court went on to embrace the limited view believing that “less harm is done” with that view. *Id.*

court addressed this comment acknowledging that if in fact the Norcrosses' "allegations are true, it could be argued that the result here would fit within the 'parade of imaginary horrors' However, it must be remembered that the Plaintiffs could have avoided this result by taking a mortgage on the Hopper Farm."¹⁰⁰ The *Ransford* court referred to a First Circuit case that held that § 523(a)(2) was not intended to "deter all bad faith conduct by the debtor irrespective of its effect upon the particular creditor."¹⁰¹

Critics of the modified-expansive view feel that it is merely a restatement of the broad view that "considers the materiality of the statement regarding a single asset or liability in determining whether it concerns the debtor's financial condition. Materiality is already an element of the fraud claim."¹⁰²

This criticism oversimplifies the modified-expansive courts' thoughtful analysis. The modified-expansive view allows a court to consider the statement's nature and purpose, without specific regard to materiality or to how much the creditor might or might not have relied on the statement. Hence, the court can achieve results that are perhaps more equitable than nearly always deciding in favor of the debtors (broad view) or in favor of the creditors (narrow view). The modified-expansive view permits the court to consider the sophistication of the parties and their intentions.

IV. WHERE TO GO FROM HERE: ADOPTING THE MODIFIED-EXPANSIVE VIEW OR MODIFYING THE STATUTE

The courts are at an impasse, and none of the views seem to treat the parties involved equitably. The question becomes whether to modify the statute to clarify the legislative intent behind "statement of financial condition" or whether to endorse one of the current interpretations.

Adopting the modified-expansive view permits courts to look at the totality of the circumstances to reach more equitable results. The limited and broad views allow individual bankruptcy courts much less discretion. If a circuit wants to protect creditors from dishonest debtors by adopting the limited view, any misbehavior or lack of due diligence on the creditor's part will be forgiven, and the creditor will win. If the circuit wants to make sure that courts help a debtors in bankruptcy to a fresh start by adopting the broad view, even the most calculated frauds will be forgiven. Instead, courts should welcome the opportunity to treat fraud cases individually and take a more fact-specific look at them, rather than merely favoring creditors or debtors at the expense of equity.

As the *Soderlund* court points out, the broad view does not protect amateur lenders—friends, family, people with good intentions and money to lend. More

¹⁰⁰ *Norcross v. Ransford* (*In re Ransford*), 202 B.R. 1, 6 n.4 (Bankr. D. Mass. 1996).

¹⁰¹ *Id.* at 6 (quoting *Century 21 Balfour Real Estate v. Menna* (*In re Menna*), 16 F.3d 7, 10 (1st Cir. 1994)).

¹⁰² *Weiss v. Alicea* (*In re Alicea*), 230 B.R. 492, 503 n.8 (Bankr. S.D.N.Y. 1999).

likely than not, these lenders are not well-versed in the practices of sophisticated lenders.¹⁰³

Sophisticated creditors protect themselves by requiring debtors to execute a written document containing their agreements and representations. This is a typical practice in a Chase Manhattan office, but not a retiree's living room. Those parties who regularly deal in credit or who participate in significant transactions are more likely to protect themselves with a written document. The Tenth Circuit commented that "[a] creditor who forsakes [the protection of a writing], abandoning caution and sound business practices in the name of convenience, may find itself without protection."¹⁰⁴ Yet the reality is that less sophisticated lenders like Mr. Cadwell often do not omit a written statement for the sake of convenience. Rather, they likely omit such formalities due to their lack of familiarity with the responsibilities of being a creditor.

Ultimately, to resolve the inequity between how creditors and debtors are treated from circuit to circuit, the statute should be modified to clarify the definition of "statement of financial condition." To protect less sophisticated creditors, Congress could add a test to the statute to determine the sophistication of the creditor and then apply the rule of law in favor or against the creditor according to his capability, knowledge, and sophistication. This would not be a strictly subjective standard. The statute could define less sophisticated creditors by creating a bright-line rule based upon the number of loans a creditor makes per year or the amount of the loan.

Regardless of whether the Supreme Court ultimately sides with the Tenth Circuit to give creditors a broad opportunity to make debts nondischargeable or whether the Court sides with the Fourth Circuit to make it nearly impossible for debts obtained by fraud to become nondischargeable, Congress should act to provide more equitable relief for the casual, infrequent creditor.

Many of the courts attempted to rule based on equity and rather than what could be easily predicted from the language of the statute. At first glance, for the good of the economy, for the sake of predictability within the law, and to discourage forum shopping by fraudulent debtors, courts should adopt the limited view. The broad view seems to inappropriately remove the risk of loss from creditors who did not work to protect themselves by doing something as simple as creating a writing.

However, that solution does not satisfy a court concerned for creditors like Mr. Cadwell. Adoption of the limited view leaves amateur creditors without protection, perhaps in a position similar to the Norcrosses under the *Ransford* court. The only discernable factual differences between the Norcrosses and Mr. Cadwell are that the Norcrosses consulted an attorney and visited the recorder's office for the deed to ensure that the property was in fact in Ransford Jr.'s name.

¹⁰³ *In re Soderlund*, 197 B.R. at 746.

¹⁰⁴ *Bellco First Fed. Credit Union v. Kaspar (In re Kaspar)*, 125 F.3d 1358, 1361 (10th Cir. 1997).

Mr. Cadwell made two trips to Arizona to see the properties and witnessed rent being given to Joelson. What more can amateur, unsophisticated creditors do?

The answer is simple: create a written document reflecting the statements on which they as creditors intend to rely in anticipation of their repayment. None of the three interpretations of financial condition can protect the creditor from this type of situation as effectively as a written statement. The limited view purports to, but comes at great expense to the dischargeability on which debtors in bankruptcy rely and to the purpose of having § 523(a)(2) in the Bankruptcy Code at all. In the Tenth Circuit, for a statement to convey a creditor's financial condition it must "present a picture of a debtor's overall financial health includ[ing] those analogous to balance sheets, income statements, statements of changes in overall financial position, or income and debt statements that present the debtor or insider's net worth, overall financial health, or equation of assets and liabilities."¹⁰⁵ It is difficult to imagine most debtors providing that level of detail in conversation. Thus, the message is clear: be a creditor in a limited-view court such as the Tenth Circuit.

If Congress intended to protect the unsophisticated creditor from all fraudulent debtors, it would have required a "financial statement" instead of a statement of "financial condition." Conversely, bankruptcy law would be more predictable if Congress held large consumer creditors to a higher standard than their less sophisticated creditor counterparts by requiring a written statement of financial condition only for large consumer creditors. Furthermore, amending the current law to define and differentiate large commercial creditors as those who lend a minimum dollar amount or extend a minimum number of loans per year will help distinguish those creditors who are more sophisticated (or should be more informed) and therefore in less need of protection from creditors that are less sophisticated and likely to lack the resources or know-how to follow-up on a debtor's statement of financial condition.

V. CONCLUSION

Protecting creditors from fraudulent debtors is a laudable goal, but only to a certain point. If the debtor has discussed his financial condition with the creditor, then it is good policy to force the creditor to lose the outstanding loan on bankruptcy if the creditor did not perform due diligence. However, there are many amateur creditors in the United States who bear more resemblance to Mr. Cadwell than Chase Manhattan Bank. These are people who are retired, fortunate, or save well; and, they are ultimately people who make risky loans to people they trust or love. They do not have the resources a sophisticated professional lender has to perform adequate due diligence, nor do they have the inclination to disbelieve loved ones or friends hard on their luck.

Courts that favor punishing the fraudulent debtor use a limited view of financial condition and thereby make it too easy for incompetent or lazy creditors of all levels of sophistication to win every dischargeability case. Likewise, courts

¹⁰⁵ Cadwell v. Joelson (*In re Joelson*), 427 F.3d 700, 714 (10th Cir. 2005).

who favor making creditors more accountable for their lending decisions and risk-taking make it too easy for debtors to make relatively casual statements about some property that they might or might not own in order to avoid nondischargeability later.

Using the modified-expansive view allows courts to equitably pick apart the facts and take notice of the nature and purpose of the statements made by the debtor, even in the absence of a written statement. However, requiring the statement to be material to the transaction only assists those cases where the debtor's statement is in writing.

Ultimately, the only permanent solution is for Congress to modify the statute to clearly explain whom they intend to protect and to what extent Congress wants to absolve the creditor or debtor of responsibility for their actions and inactions.

