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Creators of literary and artistic works routinely incorporate portions of preexisting copyrighted expression into their creations. For instance, the custom of borrowing the literary expression of another with attribution is so central to emphasizing a point that few would pause to consider whether it is lawful. Many people would therefore be surprised to learn that there is no explicit exemption within the United States copyright law that permits the socially accepted activity of quotation. Strictly speaking, under the present copyright statute and jurisprudence, quotation is infringing activity that may be excused by, what the Supreme Court has characterized as, the affirmative defense of fair use.[1]

The First Amendment states that "Congress shall make no law . . . abridging the freedom of speech. . . ." But doesn't a law that may prevent the expressive use of another's speech abridge the freedom of speech? Might not referential use of other's expression be necessary in order for speech to be robust and, in fact, free? Doesn't any law that limits or curtails one's means of expression necessarily result in something short of free speech, something more like cautious speech? Does copyright law create a conflict with the First Amendment?

These questions are not new and consideration of the conflict has a venerable history.[2] The prevailing view is that copyright does not abridge speech because, *inter alia*, internal copyright doctrines fulfill First Amendment concerns. Over time, some courts went so far as to conclude that copyright was categorically immune from First Amendment attack based on the existence of copyright's internal free speech safeguards.[3]

In *Eldred v. Ashcroft*, however, the Supreme Court laid to rest the longstanding assumption that copyright is necessarily free from First Amendment scrutiny. But in denying that copyright is categorically immune from First Amendment challenge, the Court stated that unless Congress alters the "traditional contours of

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1. Harper & Row Publishers, Inc. v. The Nation Enters., 471 U.S. 539, 561 (1985).

2. *See generally*, M. Nimmer, *Copyright and the First Amendment*, 17 UCLA L. REV. 1180, 1193-96 (1970); Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970); and Lionel S. Sobel, *Copyright and the First Amendment: A Gathering Storm?*, 19 COPYRIGHT L. SYMP (ASCAP) 43 (1971).

3. Eldred v. Reno, 239 F.3d 372 (D.C. Cir. 2001).

copyright law," independent First Amendment attacks are unwarranted.[4]

Although the Court did not identify the universe of features that define the traditional contours of copyright law, the Court highlighted two limiting doctrines within copyright law that accommodate First Amendment values: the idea/expression dichotomy and the fair use privilege.[5] Whether these two limitations on the exclusive rights of copyright owners define the traditional contours of copyright or merely contribute to these contours is not yet certain.[6] Yet, despite this uncertainty, the Court's emphasis on the central role of these two particular limiting doctrines is significant, because these doctrines were established by the courts rather than Congress, and because their development remains firmly rooted in common law adjudication.

This article first examines the nature of the "traditional contours" of copyright and how copyright's internal doctrines accommodate free speech concerns in theory and practice. It then illustrates a way in which Congress might have already altered the traditional contours of copyright by enacting the Digital Millennium Copyright Act. Next, assuming that a congressional act has altered the traditional contours, the article evaluates the options that would be available to the courts to preserve the traditional contours of copyright. Finally, the article explores the adequacy of the existing free speech safeguards in accommodating First Amendment interests and offers suggestions for improving the efficacy of these free speech safeguards in order to more fully promote First Amendment interests.

I. THE TRADITIONAL CONTOURS

After *Eldred*, some have alleged that recent congressional changes in copyright establishment, i.e., fixation rather than publication, and the elimination of claim-staking aspects of copyright, such as notice and renewal, have altered the traditional contours of copyright and undermined First Amendment values by preventing works from entering the public domain.[7] This view implies that the First Amendment is principally served by enabling the unfettered use of the expression of others. In this view, only works unrestrained by copyright are fully capable of promoting First Amendment values, and anything that constricts the public domain necessarily impinges on the freedom of speech.

While it is true that copyright places some limits on speech, the view that

4. Eldred v. Ashcroft, 537 U.S. 186, 221 (2003).

5. The Court's reliance on these doctrines as First Amendment safety valves is not new, and genesis of this reasoning may be traced back to a series of seminal articles on the question of conflict between copyright and the First Amendment. *See generally* M. Nimmer, *supra* note 2, at 1193-96; Paul Goldstein, *supra* note 2; and Lionel S. Sobel, *supra* note 2.

6. Arguably, other limitations on an exclusive right, such as the exhaustion of the copyright owner's distribution right in the case of a lawfully sold copy under First Sale Doctrine, could be examples of traditional contours of American copyright law, but this would not implicate free speech values, and Congress has limited the application of that doctrine with regard to particular copyrightable subject matter. 17 U.S.C. §109(b)(1)(A).

7. *See, e.g.*, Kahle v. Ashcroft, 72 U.S.P.Q.2d (BNA) 1888 (N.D. Cal. 2004), *aff'd sub nom* Kahle v Gonzales, 474 F.3d 665 (9th Cir. 2007).

copyright is intrinsically antagonistic to First Amendment values is contradicted by the Court's holding in *Eldred*. As the Court stated, "the Framers intended copyright itself to be the engine of free expression."[8] American copyright's utilitarian formula is intended to promote First Amendment values not to interfere with them. As a former Register of Copyrights, David Ladd, explained:

> The purpose of copyright is to reward authors as a matter of justice, yes; but only as a beginning. Copyright also is intended to support a system, a macrocosm, in which authors and publishers compete for the attentions and favor of the public, independent of the political will of the majority, the powerful, and above all the government, no matter how unorthodox, disturbing, or revolutionary their experience, views, or visions . . . . The marketplace of ideas which the First Amendment nurtures is, then, and must be more widely understood to be, essentially a *copyright* marketplace.[9]

While the Court appeared to agree that the changes in duration were fairly posed in regard to optimal copyright policy, the Court stated that "[t]he wisdom of Congress' action, however, is not within our province to second-guess."[10]

The Court's statements in *Eldred* are not an abdication of judicial oversight of free speech concerns, but rather an acknowledgement of the critical role copyright plays in promoting free speech and an explicit recognition of the judicially-created doctrines that, while perhaps falling short of harmonizing copyright law and the First Amendment in fact, at least internally address free speech considerations within the calculus of the copyright law itself. The idea/expression dichotomy and the fair use privilege enable the courts to accommodate free speech considerations on a case-by-case basis.[11]

The Court's reliance on these judge-made doctrines as "copyright's built-in free speech safeguards" is instructive of the Court's view—the traditional contours of copyright law have been formed by judicial limits on the *scope* of copyright owner's exclusive rights, rather than by congressional determinations on durational limits, subject matter or formalities—and thus these latter theories raised in the *Kahle v. Gonzales* litigation were doomed to failure.[12] The Court's decision

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8. *Eldred*, 537 U.S. at 219, *quoting* Harper & Row Publishers, Inc. v. The Nation Enters., Inc., 471 U.S. 539, 558 (1985).

9. David Ladd, *The Harm of the Concept of Harm in Copyright*, 30 J. COPYRIGHT SOC'Y U.S.A. 421, 427-8 (1983).

10. *Eldred*, 537 U.S. at 222.

11. *See* Baker v. Selden, 101 U.S. 99, 103 (1880) and Folsom v. Marsh, 9 F. Cas. 342 (No. 4,901) (C.C.D. Mass. 1841). While *Folsom* is generally cited as the American foundation of the doctrine of fair use, it is interesting to note that the case can be interpreted as an expansion of the copyright owner's rights rather than a limitation on those exclusive rights. *See* Anthony Reese, *The Story of Folsom v. Marsh: Distinguishing Between Infringing and Legitimate Uses*, *in* INTELLECTUAL PROPERTY STORIES (Jane Ginsburg & Rochelle Dreyfuss eds., 2006). Similarly, while *Selden* specifically dealt with a limitation of the scope of a copyright owner's rights, later seminal cases by Judge Learned Hand, applying the abstractions test of the idea/expression dichotomy, also stood for the proposition that infringement could occur even though literal copying of the text did not. Thus, application of the idea/expression dichotomy also expanded protection to selection and arrangement of ideas that may not in and of themselves be copyrightable. *See* Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49 (2d Cir. 1936).

12. *Kahle*, 72 U.S.P.Q.2d (BNA) 1888, *aff'd sub nom* 474 F.3d 665 (In *Kahle*, the plaintiff

implies that as long as the scope of the exclusive rights of copyright owners does not preclude the use of another's speech, it is unnecessary to preserve efficient mechanisms for injecting works into the public domain.[13] As such, *Eldred* may be interpreted as diminishing the significance of the public domain as a necessary vehicle of First Amendment interests, while simultaneously increasing the significance of internal free speech safeguards throughout the term of copyright protection.

Alternatively, *Eldred* may be viewed as a conceptual revision, and expansion, of the meaning of the term "public domain" to include both the public's right to use unprotected elements (e.g., ideas, facts and expired copyrights) and the right to use relative amounts of the expression of protected works. If this view were correct, there would seem to be some basis for demanding an inverse ratio between the two parts—to the extent that the right to use unprotected elements constricts, the ability to use protected expression should expand.[14]

Based on the *Eldred* decision, First Amendment scrutiny may be avoided only if internal doctrines exist as free speech safeguards. Accordingly, while the Court in *Eldred* expressed the view that these common law doctrines enable the courts to satisfy free speech concerns as long as they remain intact, this assertion begs the question of whether this theoretical *capability* is enough. What if courts are not, in

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claimed that a number of congressional changes to the Copyright Act altered the traditional contours of copyright. In particular, the plaintiff argued that the change from an affirmative act of publication with copyright notice as initiation of federal copyright protection to federal protection upon mere fixation of a work in tangible form caused enormous numbers of works to be protected by federal law that previously would have fallen outside of the federal scheme. Further, the plaintiff argued that by eliminating the requirement for renewal of a copyright beyond its initial term, Congress automatically extended protection to works without an affirmative act by the copyright owner. With these changes, works that might have fallen into the public domain were given federal protection without any indication from the creator that protection was desired.). While this author is sympathetic to these arguments, like those in the *Eldred* case itself, as a matter of policy, the Court's decision in *Eldred* has, at least for now, closed the door on such arguments as constitutional limits on congressional authority. This result, however, imposes enormous importance on copyright's internal safeguards to provide adequate breathing space within copyright.

13. Whether the Court's view is correct or not is debatable. As has been pointed out elsewhere, the broad statements within the Eldred opinion are at least superficial and perhaps even misleading. *See, e.g.*, Neil Weinstock Netanel, *Copyright and the First Amendment; What Eldred Misses—and Portends*, *in* COPYRIGHT AND FREE SPEECH: COMPARATIVE AND INTERNATIONAL (Jonathan Griffiths & Dr. Uma Suthersanen eds., 2005), *available at* SSRN: http://ssrn.com/abstract=614642.
Melville Nimmer long ago questioned whether the absence of durational limits might conflict with the First Amendment and therefore that perpetual protection of common law copyright probably should be temporally limited. Melville R. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press*, 17 UCLA L. REV. 1180, 1193-96 (1970). The 1976 Act mooted the question as to perpetual common law protection, and the Court in *Eldred* answered the question of whether the Copyright Clause provides congressional authority to extend existing copyrights. Nevertheless, while it is questionable whether duration alone would be capable of creating a First Amendment conflict so long as adequate limitations on scope were available, as a question of policy and efficiency, the extension of duration entails significant societal costs without strong arguments of increased creativity by authors or any other fair return to the public.

14. Or, perhaps, if only one dimension of unprotected expression diminishes, e.g., expiration due to lengthened duration, this constriction could be ameliorated by improving the efficacy of corollary doctrines, i.e., improving the functionality of the idea/expression dichotomy.

fact, sufficiently safeguarding free speech concerns in the application of these doctrines? What if courts are so focused on infringement, similarity, statutory factors, levels of abstraction, and potential market harm, that they are forgetting that copyright's limiting doctrines serve an essential constitutional purpose? In order to assess these questions, it is necessary to examine how copyright's internal free speech safeguards function.

II. THE FREE SPEECH SAFEGUARDS

The creation of the idea/expression dichotomy in *Baker v. Selden*, and the continued development of this doctrine by the courts, clarified that the public may freely extract and copy the ideas from the expression of others, so long as the same expression of the idea is not copied.[15] With the idea contained within a work freely available for use, copyright does not impede the original expression by others that incorporates those ideas. By precluding the control of ideas, the idea/expression dichotomy encourages a multiplicity of expressions about an idea in a manner that fosters the advancement of knowledge.[16] To be sure, copyright is capable of protecting more than the literal expression of an author. If this were not the case, "a plagiarist would escape by immaterial variations."[17] While the existence of actionable non-literal copying necessarily complicates determining the line between unprotected ideas and protectible expression, the difficulty of the task does not eliminate the breathing space the idea/expression dichotomy provides. It does, however, present a practical obstacle to the use of this internal free speech safety valve.[18] As Alfred Yen stated:

> The idea/expression dichotomy sounds straightforward, but it is very difficult to apply because there is often no reliable way to distinguish between a work's ideas and the expression of those ideas. . . . The indeterminacy of the idea/expression dichotomy strongly affects the idea/expression dichotomy's ability to limit the scope of

15. The exception to this rule is the merger doctrine which allows the taking of the expression of an idea if there are a limited number of ways to express the idea.

16. There has been criticism of the idea/expression dichotomy's ability to foster non-literary expression. It has been said that the idea/expression dichotomy works fairly well with textual works, but is incompatible with other forms of expression, such as works of the visual arts or musical works. Yet, the problem with this view is underscored by the *Baker v. Selden* decision itself. A visual work of art can include principles, such as perspective, artistic style, scenes a faire, or subject matter; while protected in their particular combination within a work, these principles are not generally protectible themselves. Similarly, in music, rhythms, styles or techniques, e.g., a blues progression or an arpeggio, are not in and of themselves protectible; rather, only the particular expression of these ideas is protected.

17. Nichols v. Universal Pictures Co., 45 F.2d 119, 121 (2d Cir. 1930).

18. It must be noted that not only does non-literal infringement complicate the analysis, but the test for infringement—the total concept and feel—introduced by the Ninth Circuit in Roth Greeting Cards v. United Card Co., 429 F.2d 1106, 1110 (9th Cir. 1970) and Sid & Marty Krofft Television Prod., Inc. v. McDonald's Corp., 562 F.2d 1157, 1167 (9th Cir. 1977) further blurred the line. For a detailed discussion of this development, *see* Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept And Feel,"* 38 EMORY L. J. 393 (1989).

copyright.[19]

As a result of the uncertainty regarding where the line between protectible expression and unprotectible idea lies, the use of anything similar to a copyrighted work, whether literal expression or non-literal "concept and feel," may result in an infringement claim that can be difficult to disprove.

This uncertainty is significant, because while copyright may not categorically prevent free speech, due to the existence of the judicially-created free speech safeguard of the idea/expression dichotomy, speech may be chilled by the inability to establish a reliable safe harbor within the doctrine.[20] Indeed, the potential chilling effect on speech resulting from indecipherable uncertainty is not necessarily limited to risk-averse users of copyrighted works. The idea/expression dichotomy (and Judge Hand's abstractions test) is, after all, one of the vaguest boundaries in copyright law, second only to, perhaps, its sister internal free speech safeguard, the fair use privilege. As Learned Hand explained, "[n]obobdy has ever been able to fix that boundary [between idea and expression], and nobody ever can."[21] Thus, it is important to consider the practical constraints that this free speech safeguard entails.[22]

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19. Alfred C. Yen, *Eldred, the First Amendment, and Aggressive Copyright Claims*, 40 HOUSTON L. REV. 673, 679-80 (2003).

20. *See, e.g.*, Yen, *supra* note 18.

21. Nichols v. Universal Pictures Co., 45 F.2d 119, 121 (2d Cir. 1930).

22. Some have argued that despite the fact that the idea/expression dichotomy is useful in relation to some textual works, it has very little value in the context of other types of works, such as works of visual art or musical works. *See e.g.*, Siva Vaidyanathan, COPYRIGHTS AND COPYWRONGS: THE RISE OF INTELLECTUAL PROPERTY AND HOW IT THREATENS CREATIVITY (2003). At least one court has dismissed the idea/expression dichotomy as an unnecessary complication in copyright infringement claims in the case of a photograph. Mannion v. Coors Brewing Co., 377 F. Supp. 2d 444 (S.D.N.Y. 2005). Judge Kaplan states:

> But there is a difference between the sort of difficulty Judge Hand identified in *Nichols* and the one presented by the Kaplan rationale and the defendant's argument about ideas in this case. . . . The latter difficulty, however, is not simply that it is not always clear where to draw the line; it is that the line itself is meaningless because the conceptual categories it purports to delineate are ill-suited to the subject matter. . . . The idea/expression distinction arose in the context of literary copyright. For the most part, the Supreme Court has not applied it outside that context. . . . In the visual arts, the distinction breaks down. . . . For all of these reasons, I think little is gained by attempting to distinguish an unprotecible "idea" from its protectible "expression" in a photograph or other work of visual art. *Id.*

Judge Kaplan's conclusion is, at a minimum, an overstatement. There are many ways in which the idea/expression dichotomy might allow ideas, styles, or scenes a faire to be used in the visual arts. While Judge Kaplan may be correct that this consideration may be incorporated into the general infringement analysis, given the confusion as to the proper infringement analysis among the circuits that is evidenced in decisions, express recognition of idea/expression dichotomy in infringement actions is not always a worthless exercise. In fact, ignoring the dichotomy may lead to erroneous results.

The *Steinberg* case presents a reasonable example of the idea/expression dichotomy in a work of visual art. Steinberg v. Columbia Pictures Indus., Inc., 663 F. Supp. 706 (S.D.N.Y. 1987). Saul Steinberg's drawing of a parochial New Yorker's view of the world was published on the cover of the *New Yorker* magazine. Steinberg sued Columbia Pictures and others for an advertisement of the movie *Moscow on the Hudson* that depicted the three main characters of the movie superimposed on a similar view of New York City and with Moscow on the horizon. The concept of perspective and the idea of a myopic view of a geographic location are not within the scope of protection of Steinberg's work, yet

In many situations, standing alone, the idea/expression dichotomy is insufficient to accommodate free speech needs. In the case of parody, criticism or other types of referential expression, it is often an absolute necessity to use more than simply the idea of another to adequately accomplish the intended purpose of the speaker. In such cases, fair use allows the taking of other people's expression in a manner and amount that is reasonable under the circumstances.[23] This important safety valve is capable of accommodating First Amendment concerns as long as its application by the courts is sufficiently robust, and as long as the doctrine is not circumscribed by Congress. Judges may allow other people's speech to be used in an amount that is reasonable in relation to the purpose of the use even if, in appropriate cases, the entire work is used.[24]

Yet, like the idea/expression dichotomy, fair use entails practical difficulties in its application. Analyzing the predictability of the four-factor analysis, David Nimmer wrote, "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."[25] The uncertainty of the fair use defense, at a

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copying particular copyrightable features of the work or aspects of original selection and arrangement in the work that go beyond the general style or the standard city features may entail infringement. In musical works, copying standard rhythms or melodic progressions, arpeggios, harmonies, chord progressions or scales should often fall on the idea side of the continuum, just as no one has a claim on an overall style, such as the blues. How to apply the idea/expression dichotomy beyond the traditional literary manifestations may be challenging. While it appears true that courts have been more successful in applying the idea/expression dichotomy to literary works, including plays, novels, and even computer programs, the application of the idea/expression dichotomy to all copyrightable subject matter should be expanded in order to accommodate and promote broader forms of artistic speech. This is particularly true given the free speech implications that may ensue if courts are unwilling to apply it.

23. 17 U.S.C. § 107 (2000) states:

> 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.

24. *See* Bill Graham Archives v. Dorling Kindersley Limited, 448 F.3d 605 (2d Cir. 2006).

25. David Nimmer, *"Fairest of Them All" and Other Fairy Tales of Fair Use*, 66 LAW & CONTEMP. PROBS. 263 (2003). Despite the rhetorical flourish of the opening footnote in that article, this author did agree with much of the article. Our differences related to the manner of resolving the problems identified, and, even in that regard, we privately agreed more than we disagreed—the fair use analysis needs to be better understood and more thoughtfully applied by courts. *See also*, Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005* (working paper, forthcoming 156 PENN. L. REV. (2007)), available at: http://www.bartonbeebe.com/ (analysis of the factors suggesting that leading cases are not necessarily being followed by the lower courts, but are generally leading to an expansion of fair use's scope, albeit in an unpredictable manner).

minimum, forces users toward a minimalist approach even if First Amendment interests support more expansive use. The fact that courts do not routinely acknowledge the important relationship between fair use and free speech values when referential speech is implicated is, in itself, disconcerting. How does a doctrine serve as a free speech safeguard if, in the rote application of the statutory factors, courts appear to ignore the significant role that fair use is supposed to be serving? Since Congress codified the fair use doctrine, courts often look to the statutory factors in a vacuum, without considering the over-arching purpose of the analysis as a free speech safeguard. As a result, fair use tends to promote careful, minimalist speech rather than robust free speech.[26]

While it is true that the First Amendment does not guarantee a person the right to make *another's* speech,[27] there are times when the purpose of the speech requires, or perhaps simply benefits from, the inclusion of another's expression in order to more appropriately make a point or where the purpose is referential to the expression of another. In some cases, the point could unquestionably be made without the use of another's expression, but the purpose of fair use is to allow reasonable use of another's expression within the context of the user's legitimate purpose, if that purpose does not supersede the market for the work used. Just as a picture is worth a thousand words, so too might a sample of a sound recording or a portion of a motion picture be essential to the user's expressive purpose.[28] The purpose of the use must be balanced with the nature of the work used, the amount used in relation to that purpose, and the effect on the market. Yet, in order for fair use to act as a free speech safeguard, it is essential that courts ensure that the privilege serves as a viable free speech safeguard in cases where more than the idea

26. This is not to say that any use of another's expression should be sanctioned under the rubric of fair use. Yet, consider an article such as this one. There are many quotes that may not be "necessary" to the point being made. The incorporation of the expression of others is often a rhetorical vehicle that embellishes one's expression. Custom and practice within scholarly writing support such uses, but in other areas where customs and practices are less settled, we tend to find more granular scrutiny. Courts' longstanding and continued emphasis on the fourth factor of the fair use analysis tends to supersede the importance of the first factor in asserting free speech interests.

27. *See* Eldred v. Ashcroft, 537 U.S. 186 at 221 (2003), ("The First Amendment securely protects the freedom to make—or decline to make—one's own speech; it bears less heavily when speakers assert the right to make other people's speeches.")

28. *See also*, Neil Weinstock Netanel, *Copyright and the First Amendment; What Eldred Misses—And Portends, in* COPYRIGHT AND FREE SPEECH: COMPARATIVE AND INTERNATIONAL ANALYSES (Jonathan Griffiths & Dr. Uma Suthersanen eds., 2005) (arguing that speakers often express themselves more fully and effectively when they impart words others have written than when they use words of their own creation. Netanel forcefully illustrates the point that the context of the use is critical to determining what and how much use should be allowed. For example, he asks, "Is the 'right to make other people's speeches' all that was at stake when a court enjoined as copyright infringement Alan Cranston's unexpurgated translation of *Mein Kampf*, designed to expose the official translation as a whitewash?" And anticipating the whistleblower hypothetical I use *infra*, he asks whether the *City Pages* newspaper that reprinted a racist fable from a police department newsletter to expose racism, or the critics of Scientology who posted Church texts to unveil Church foibles, implicated First Amendment concerns. Obviously, the answer is that these uses of other people's speech are necessary and proper to make the point and profoundly implicate First Amendment interests.).

is used to achieve the expressive purpose.[29]

Thus, the idea/expression dichotomy and the fair use privilege are *capable* of accommodating First Amendment values in relation to copyrighted works if these doctrines remain intact and are properly applied. Yet the recognition of the existence of these safeguards leaves critical questions unanswered: How could the traditional contours of copyright be altered by Congress, and what can be done to maintain the necessary contours of copyright law if the "traditional" contours are so disturbed? Further, and perhaps more importantly, how do we resolve the practical problems with the use and application of these doctrines that may fail to fully accommodate First Amendment values in the present environment?

III. ALTERING THE TRADITIONAL CONTOURS

If, within copyright law itself, the courts have developed the means of accommodating First Amendment ends, how are these traditional contours altered? It would appear that with these judicially-created internal accommodations, the courts have been able to remain deferential to Congress's legislative policy choices regarding copyrightable subject matter, copyright duration, and copyright maintenance. This deference has been largely reciprocal, with Congress allowing the courts to create limiting doctrines that temper the scope of the exclusive rights of copyright owners. If Congress were to limit the judiciary's ability to satisfy First Amendment concerns through internal copyright limiting doctrines, however, it would seem to follow that it would be necessary for courts to apply heightened constitutional scrutiny to copyright legislation.

In essence, the discussion of the First Amendment in *Eldred* can be distilled into two basic propositions: 1) The judge-made First Amendment safeguards applied in case-by-case determinations are capable of preserving free speech values, and 2) Congress could alter these traditional contours in the future in a way that would create a conflict with the First Amendment.

Exploring this second proposition first, what type of legislative action might alter the traditional contours of copyright? Generally, it would be any legislation that limits or eliminates internal free speech safeguards. Thus, a copyright amendment that prevents the application of the idea/expression dichotomy or fair

29. This point is at odds with Melville Nimmer's seminal article on copyright and fair use. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press*, 17 UCLA L. REV. 1180 (1970). Nimmer claims that where the idea conveyed requires the use of particular expression, for example the photographs of the My Lai massacre, the fact that the expression must be copied to convey the idea is a First Amendment privilege, and that this First Amendment principle must be distinguished from the doctrine of fair use. *Id.* at 1203-4. He says, "Fair use, when properly applied, is limited to copying by others which does not materially impair the marketability of the work which is copied. The First Amendment privilege, when appropriate, may be invoked despite the fact that the marketability of the copied work is thereby impaired." *Id.* at 1200-01. This view is inconsistent with the *Eldred* Court's view of fair use as an essential free speech safeguard and is an improper restraint on the doctrine of fair use. If Nimmer's view of the limits of fair use is correct, there would be no need for any factor but the fourth. Properly viewed, the first, second and third factors can, in appropriate cases, outweigh the fourth, and thus fair use can accommodate First Amendment concerns even though there is some impairment of the market for the work used.

use, and which does not create a functionally comparable legislative mechanism to accommodate First Amendment values, would disrupt the traditional contours of copyright law.

What might be an example of legislation that disrupts the traditional contours of copyright law? By way of illustration, consider the Digital Millennium Copyright Act (DMCA) which added a new chapter 12 to title 17. In particular factual situations, § 1201 could have the capacity to disrupt the traditional contours of copyright law.[30] Parts of this law have been interpreted to preclude a fair use defense to the circumvention of or the trafficking in technological measures that protect access to copyrighted works.[31] The overall structure of the section was intended by Congress to accommodate fair and noninfringing uses, but concerns about the adequacy of these accommodations persist.[32] There has been less discussion of §1201's effect on the idea/expression dichotomy,[33] but this too is an area that is ripe for exploration.

So in what factual situation might § 1201 be found to alter the traditional contours of copyright? Given § 1201's design, most First Amendment attacks on the DMCA have been unsuccessful for two reasons. First, there has been little factual basis for a right to *access* to a work where the user has not satisfied the copyright owner's conditions of access. For example, while a book may contain ideas that are unprotectible, there is no duty on the part of the copyright owner to make the work available so that the unprotectible ideas may be learned. To use the somewhat misleading metaphor presented to Congress, users cannot break into the bookstore to gain access to books.[34] As with traditional copyright, users can only

30. 17 U.S.C. §1201 (1998).

31. *See, e.g.*, Universal City Studios, Inc. v. Reimerdes, 111 F. Supp. 2d 294, 319 (S.D.N.Y. 2000), *aff'd sub nom* Universal City Studios v. Corley, 273 F.3d 429 (2d Cir. 2001).

32. *See e.g.*, Report of the House Committee on Commerce on the Digital Millennium Copyright Act of 1998, H.R. REP. NO. 105-551, pt. 2, 36-39 (1998). Generally, by choosing not to prohibit the circumvention of a technological protection measure that protects the rights of a copyright owner, Congress believed that it was enabling the operation of traditional copyright limitations, such as the idea/expression dichotomy and fair use, to users of copyrighted works who had lawful access to those works. In addition to the omission of a prohibition on circumvention of technological measures that protect the rights of a copyright owner, Congress created a number of statutory exemptions to the prohibition on circumvention in § 1201(a)(1) and, in some cases, the trafficking provisions in § 1201(a)(2) and in § 1201(b). While Congress believed this structural design of § 1201 was adequate to preserve traditional noninfringing uses, it also incorporated a regulatory fail-safe mechanism into the statutory framework in § 1201(a)(1)(C) in the form of a triennial anti-circumvention rulemaking proceeding that could result in exceptions to the prohibition of circumvention in § 1201(a)(1) for a three-year period.

33. *But cf.*, Jane Ginsburg, Post Hearing comment No. 4, 2000 Section 1201 Rulemaking, *available at* http://www.copyright.gov/1201/post-hearing/ginsburg.pdf.

34. *See*, Report of the House Committee on the Judiciary on the Digital Millennium Copyright Act of 1998, H.R. REP. NO. 105-6, at 5 (1998); *see also*, WIPO Copyright Treaties Implementation Act and Online Copyright Liability Limitation Act: Hearing on H.R. 2281 and H.R. 2280 before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary 105th Cong. 208 (1997) (prepared statement of Alan Adler). This same speaker went on to say that "the Declaration of Independence is in the public domain, but there is nothing wrong with the National Archives keeping it in a vault and punishing anyone who tries to break through security to get hold of that copy." *Id.* But, as Lord Mansfield once warned, "Nothing in law is so apt to mislead as a metaphor." Knox v. Gye,

gain access to the ideas within the book by obtaining a lawful copy, whether by sale or some progeny of the first sale doctrine. Second, it is difficult to prove that one *needs* to access a protected digital version of a work, particularly if unprotected copies of that work are also available for fair use or other noninfringing purposes, e.g., e-books of works that are also available in traditional book form. Lawful access to a work is generally a condition precedent to lawful *use* of the expression. It is, in fact, relatively difficult to create a hypothetical in which § 1201 alters the traditional contours, and few factual situations have arisen that actually implicate real First Amendment concerns.[35] Nevertheless, it is possible to construct a factual situation in which this law might be used to abridge core free speech interests.

Suppose that we encounter a typical corporate or government whistleblower who desires to provide information to the press about the unethical activities of a corporate or government entity.[36] Yet, in the digital world, further suppose that the whistleblower's smoking gun is not the traditional hard copy memo, but rather takes the form of an encrypted computer CD-ROM disk. The copyrightable information contained on the disk is encrypted. This means that the encryption satisfies the definition of an effective technological protection measure that protects access to a work protected under Title 17.[37] Thus, the reporter receiving this disk would be unable to access, view, or use the documents contained on the disk without circumventing the technological protection measure that protects access to the copyrighted work. There is no statutory exemption in § 1201 that addresses this situation, and if prior precedent is correct, there are no exemptions in the Copyright Act that allow circumvention for what would appear to be a noninfringing use in this situation. Fair use, which is a defense to copyright infringement, does not operate as a defense to the independent violation of circumvention.[38] Further, even if the reporter were willing to test the law, his technological abilities may be such that he could not circumvent without assistance of a device or service. Since the

(1871) 5 L.R.E. & I. App. 656, 676 (H.L.). Paul Ricoeur more recently stated: "Metaphor is the rhetorical process by which discourse unleashes the power that certain fictions have to describe reality." Paul Ricoeur, THE RULE OF METAPHOR 7 (Robert Czerny trans. 1977). Both quotations are from Alan Story, *Burn Berne: Why the Leading International Copyright Convention Must Be Repealed*, 40 HOUSTON L. REV. 763, 786 (2003-04).

35. Some of the noninfringing uses that formed the basis of exemptions over the course of the three triennial rulemakings to date have had First Amendment implications. The exemption allowing circumvention of filtering software or "censorware" was premised on the importance of allowing inspection and public comment on the scope of locations being made inaccessible. In the most recent decision by the Librarian of Congress, the exemption allowing circumvention of encrypted motion pictures on DVDs in order to create clip compilations for pedagogical purposes was, in part, premised on the relationship between this use and promoting classroom speech. Yet, for the purposes of this article, a more direct effect on free speech concerns seems appropriate.

36. My thanks to Professor Peter Jaszi for his assistance in coming up with this hypothetical.

37. 17 U.S.C. § 1201(a)(3)(B) (1998).

38. Universal City Studios v. Corley, 273 F.3d 429, 444 (2d Cir. 2001). Some have argued that § 1201(c) (1) leads to the opposite conclusion. Some commentators have argued that by stating, "Nothing in this section shall affect rights, remedies, limitations, or defenses to copyright infringement, including fair use, under this title," the fair use exception was intended as a defense to the prohibitions in section 1201. *See, e.g.*, Pamela Samuelson, *Intellectual Property and the Digital Economy: Why the Anti-Circumvention Regulations Need to Be Revised*, 14 BERKELEY TECH. L.J. 519 (1999).

trafficking in such a tool may violate § 1201(a)(2)(A), the means to accomplish circumvention under any circumstance may not be lawfully possible.

In such a situation, the reporter would not be able to make a fair use of a work contained on the disk, even if that use fostered free speech and freedom of the press. And not only would the reporter be unable to quote portions of the documents contained on the disk, but without the ability to access the documents contained on the disk, the reporter would not be able to independently verify the claims of the whistleblower and would not even have access to the ideas contained within the documents.[39] Thus, in such a situation, the law may have been designed in such a manner as to preclude the internal free speech safety mechanisms that define the traditional contours of copyright. While Congress attempted to create new safeguards within the statutory exemptions, none of those exemptions address this situation. Further, the fail-safe mechanism of the triennial rulemaking probably would not adequately address a situation in which the timeliness of news was unable to wait for the outcome of this regulatory mechanism. Even if the rulemaking process was underway, the inability of the rulemaking to reach the trafficking provision of § 1201(a)(2) may render it insufficient to accommodate First Amendment concerns in this instance.[40] Without access to the document, the idea of the work and the expression of that idea are both insulated from the public and the reporter cannot take advantage of these free speech safeguards. In such a case, the traditional contours of copyright law have been altered.[41]

What options would be available to a court faced with a First Amendment challenge to the DMCA under this set of facts? Essentially, if judicially-created, internal limiting doctrines are precluded by a statute, there are four principal options[42]:

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39. It has been pointed out that the whistleblower could tell the reporter about the ideas contained within the document, but this seems to be a useful example of the need for access to the expression itself in order to verify the ideas and the expression. It is also an example of a situation in which the idea of the memo is infinitely inferior to the expression—a situation in which the expression must be allowed to speak for itself. In a sense, it represents an example of merger—the idea can not be adequately expressed without resorting to use of the actual expression.

40. *See* 17 U.S.C. § 1201(a)(1)(E) ("Neither the exception under subparagraph (B) from the applicability of the prohibition contained in subparagraph (A), nor any determination made in a rulemaking conducted under subparagraph (C), may be used as a defense in any action to enforce any provision of this title other than this paragraph.")

41. Although the whistleblower situation may appear to have a relatively narrow factual basis on which to base a First Amendment conflict with Title 17, the relevance of whistleblowers has taken on a new significance with the advent of a new website, Wikileaks.org, a web-based way for people with damning, potentially helpful, or just plain embarrassing government documents to make them public without leaving fingerprints. *See* Elizabeth Willamson, *Freedom of Information, the Wiki Way: Site to Allow Anonymous Posts of Government Documents*, THE WASH. POST, Jan. 15, 2007, at A13, *available at* http://www.washingtonpost.com/wp-dyn/content/article/2007/01/14/AR2007011400760.html?sub=AR (last visited Jan. 19, 2007).

42. One option that I omit is deference to Congress eliminating First Amendment safeguards in copyright law, i.e., that copyright law is categorically immune from First Amendment scrutiny. I believe this option is untenable. If a clear conflict was encountered, I believe the First Amendment must trump copyright law, and this belief is the reason for the last option.

1. Courts must examine internal legislative limitations for sufficiency;
2. If insufficient, courts might interpret the statute narrowly in order to avoid a conflict with the First Amendment;
3. Courts may expand existing limiting doctrines or create a new limiting doctrine tailored to address such a problem; or,
4. Courts must apply heightened First Amendment scrutiny to the legislative enactment.

1. COURTS MUST EXAMINE INTERNAL LEGISLATIVE LIMITATIONS FOR SUFFICIENCY

The first option—courts must examine internal legislative limitations for sufficiency—requires the courts to determine whether Congress has adequately accommodated First Amendment considerations within the statute itself. One way Congress could accomplish this is through statutory exemptions that limit the scope of a copyright owners rights. The Court in *Eldred* looked to legislative limitations in the Copyright Term Extension Act itself as evidence that Congress was accommodating First Amendment considerations by supplementing the traditional First Amendment safeguards.[43]

In the context of § 1201, the courts would need to consider the bifurcated structure of § 1201 in relation to measures that protect access and those that protect the § 106 rights of copyright owners, and would also need to consider the statutory exemptions contained in § 1201(c)-(j). If it is determined that this structure together with the statutory exemptions maintain the traditional First Amendment safeguards in a given case or controversy, the court would need to look no further. In the vast majority of cases brought under §1201, this inquiry was sufficient to avoid further judicial intervention based on the specific activities of the defendants in the particular case.[44]

As in the whistleblower hypothetical, let's assume that a particular work that was protected by an access control was the sole source of a particular idea and expression. Since we know that the idea of a work is not protectible by copyright law, what if a copyright owner uses § 1201 to protect the idea itself, in addition to the expression of that idea? If that could be accomplished under § 1201, Congress would appear to have altered the traditional free speech safeguards of copyright. Thus, one can imagine scenarios in which the courts would be required to look beyond the structure of § 1201 and its internal exemptions in order to determine whether it could be reconciled with First Amendment interests.

2. COURTS MAY INTERPRET THE STATUTE NARROWLY IN ORDER TO AVOID A CONFLICT WITH THE FIRST AMENDMENT

The second option—courts might interpret the statute narrowly—may be

43. *Eldred*, 537 U.S. at 220.

44. *See,e.g.*, Universal City Studios, Inc. v. Reimerdes, 111 F. Supp. 2d 294, 319 (S.D.N.Y. 2000), *aff'd sub nom.* Universal City Studios v. Corley, 273 F.3d 429 (2d Cir. 2001).

beneficial in certain situations, but counterproductive in others. For instance, courts might seek to construe the statute in a manner that seeks to avoid the untenable result that the statute appears to facially demand. Thus, a court might be able to find some attenuated or contorted construction of the legislative language by choosing favorable parts of the legislative history that support the desired construction. Such a use of the legislative history as a *post hoc* rationalization for a chosen position rather than as a guide to divining legislative intent is not uncommon.[45]

While it is understandable that a court may use principles of statutory construction in order to avoid an untenable result, this option is not a permissible solution to the broader congressional purpose.[46] There are situations where narrow construction of the statutory language is reasonable in order to avoid copyright owner or user overreaching, but there are other situations in which narrow construction based on selective resort to the legislative history may amount to judicial redrafting of statutory language.[47] In the latter situation, there is a danger that in order to avoid an untenable case-specific result, the narrow construction will systemically frustrate the broader congressional purpose by inhibiting the broader statutory scheme.[48]

In contrast, there are situations in which the statutory language and structure properly validate judicial line-drawing. An example of this in the context of § 1201 can be illustrated in the disparate treatment Congress provided for technological measures under § 1201. For example, Congress prohibited the circumvention of technological protection measures that protect access to copyrighted works, but

45. Examples of such a use of the legislative history to support a questionable conclusion exist already in relation to the DMCA. Two cases from the Federal Circuit have arguably skewed the legislative history of the DMCA in order to avoid a result that the clear legislative language appeared to dictate. *See* Chamberlain Group, Inc. v. Skylink Techs., Inc., 381 F.3d 1178 (Fed. Cir. 2004) and Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc., 421 F.3d 1307 (Fed. Cir. 2005).

46. *See, e.g.*, Universal City Studios, Inc. v. Corley, 273 F.3d 429, 443-444 (2d Cir. 2001) (citing Commodity Futures Comm'n v. Schor, 478 U.S. 833, 841 (1986) (constitutional doubt canon "does not give a court the prerogative to ignore the legislative will")).

47. *See, e.g.*, Universal City Studios v. Corley, 273 F.3d 429, 444 (2d Cir. 2001) (finding it unnecessary and inappropriate to support petitioners' request to read §1201(c)(1) broadly to include a fair use defense to circumvention and thereby interpret the statute's prohibition narrowly in order to avoid a constitutional conflict).

48. *Id.* at 444. The Federal Circuit's requirement that a "copyright owner alleging a violation of section 1201(a) consequently must prove that the circumvention of the technological measure either infringes or facilitates infringing a right protected by the Copyright Act." Chamberlain Group, Inc. v. Skylink Techs., Inc., 381 F.3d 1178, 1203. There is no basis for this requisite nexus within the statutory text and the court selectively chose portions of the legislative history to support its conclusion, while conveniently ignoring other parts which conflict with this view. In addition, if the Federal Circuit's interpretation were correct, there would appear to be little point for the creation of the regulatory fail-safe mechanism of the triennial rulemaking proceeding. Since noninfringing uses do not infringe or facilitate infringement, circumvention for the purpose of engaging in a noninfringing use would routinely be outside the protectible scope of section 1201(a); there would be no reason for the Librarian of Congress to craft an exemption to allow circumvention to enable a user to engage in a noninfringing use. While the Federal Circuit did claim to distinguish its factual situations from the situation posed in the *Reimerdes/Corley* case, its imposition of this obligatory nexus may well frustrate Congress's intent in cases that follow.

Congress also purposely omitted a comparable prohibition on circumvention for technological protection measures that protect the § 106 rights of a copyright owner ("use" controls). The reason for this bifurcated treatment was the congressional view that access was not protected under the law prior to the DMCA, but should be protected in the digital age in order to foster the distribution of copyrighted works in use-facilitating business models such as time-limited access at a lower cost rather than outright sale of a copy, or scope-limited access to a portion of a work at a lower cost rather than access to the work as a whole. In contrast to access, violation of a § 106 right *is* protected by traditional copyright law. By omitting a prohibition on the circumvention of use controls, Congress allowed traditional exclusive rights and limitations to control whether or not the ultimate activity was infringing. Congress further believed that by establishing this bifurcated structure, it was preserving the assertion of the fair use defense in the appropriate context. This asymmetrical structure between sections 1201(a) and 1201(b) is clear from the statutory text and was explicitly and uniformly explained in the legislative history of the DMCA.[49]

But what if a copyright owner merged access and use measures in a manner that avoided the congressional distinction? What if the only way to circumvent a use control—activity that is not prohibited by § 1201—required circumvention of the access control as well, the latter activity being prohibited by § 1201(a)(2) and for which fair use is not a defense? A court facing such a use of § 1201 in a manner that frustrates a congressionally-established distinction might properly choose to interpret the statute in a way that comports with the clear congressional intent to preserve fair use. Thus, a court might find that the statute involves a *quid pro quo*—copyright owners seeking to benefit from § 1201's legal protections can only do so if such use respects the congressionally created statutory distinctions. By bundling or nesting the two different types of measures together so that they are inextricably intertwined, the copyright owner would have to bear the burden of that

49. *See, e.g.*, S. REP. NO. 105-190, at 29 (1998) (Report of the Senate Committee on the Judiciary on the Digital Millennium Copyright Act of 1998):

Unlike subsection (a), which prohibits the circumvention of access control technologies, subsection (b) does not, by itself, prohibit the circumvention of effective technological copyright protection measures. It is anticipated that most acts of circumventing a technological copyright protection measure will occur in the course of conduct which itself implicates the copyright owner's rights under title 17. This subsection is not intended in any way to enlarge or diminish those rights. Thus, for example, where a copy control technology is employed to prevent the unauthorized reproduction of a work, the circumvention of that technology would not itself be actionable under section 1201, but any reproduction of the work that is thereby facilitated would remain subject to the protections embodied in title 17.

See also H.R. REP. NO. 105-551, pt. 1, at 18 (1998) (Report of the House Committee on the Judiciary on the Digital Millennium Copyright Act of 1998):

Paragraph (a)(1) does not apply to the subsequent actions of a person once he or she has obtained authorized access to a copy of a work protected under Title 17, even if such actions involve circumvention of additional forms of technological protection measures. In a fact situation where the access is authorized, the traditional defenses to copyright infringement, including fair use, would be fully applicable. So, an individual would not be able to circumvent in order to gain unauthorized access to a work, but would be able to do so in order to make fair use of a work which he or she has acquired lawfully.

technological choice at the expense of a legal benefit. Such an interpretation of the statutory scheme might allow the court to maintain the traditional contours of copyright, and thus preserve First Amendment values, without undermining the congressional purpose of the statute itself.

3. COURTS MAY EXPAND EXISTING LIMITING DOCTRINES OR CREATE A NEW LIMITING DOCTRINE TAILORED TO ADDRESS FIRST AMENDMENT CONFLICTS; OR

4. COURTS MUST APPLY HEIGHTENED FIRST AMENDMENT SCRUTINY TO THE LEGISLATIVE ENACTMENT

The third option—courts may expand existing limiting doctrines or create a new limiting doctrine tailored to address First Amendment conflicts—is an alternative means of reaching an equitable result that is consistent with the statutory language. The internal free speech safeguards that delineate the traditional contours of copyright are judge-made. Where congressional enactments interfere with the application of these traditional free speech safeguards, is it then necessary for courts to scrutinize the constitutionality of the statute?

Although the case has not yet been brought which demonstrates a direct conflict between § 1201 and First Amendment concerns, as illustrated in the whistleblower hypothetical *supra*, that case could come and could raise questions about the traditional contours under existing law. When a technological protection measure is deployed to protect access to a work that contains the sole source of particular ideas or expression, the idea/expression dichotomy and fair use privilege do not serve as defenses to either a violation of the prohibition of circumvention of access controls or to the provisions that prohibit trafficking in devices or services that circumvent technological measures that protect access, or the § 106 rights of the copyright owner.[50] Such a situation places copyright, or ancillary protections based on copyright, in direct conflict with First Amendment interests. In the whistleblower situation, where the existing free speech safeguards were unavailable, where Congress failed to provide an alternative First Amendment safety valve, and where a statutory interpretation could not reasonably avoid the conflict with legitimate speech, the courts would appear to possess two remaining options.

Applying heightened scrutiny to the statute itself would be one option, but

50. *Cf.* David Nimmer, *InacCSSibility*, *in* BENJAMIN KAPLAN ET AL., AN UNHURRIED VIEW OF COPYRIGHT REPUBLISHED (AND WITH CONTRIBUTIONS FROM FRIENDS) Nimmer 8 (Iris C. Geik et al. eds., 2005) (stating, with this author's agreement, that fair use is not merely a defense to infringement, but a limit on the scope of a copyright owner's § 106 rights). As such, there is room to argue that the additional violations codified in § 1201(b) may not extend to activity proven to be a fair use. Given the uncertainty of the exception to the copyright owner's exclusive rights, the user's interest may currently be viewed as an expectancy interest. It is difficult to rely on fair use to fully promote First Amendment interests when a user does not know the scope of a limitation until a court adjudicates the particular facts.

generally would appear to be an option of last resort.[51] The finding that a statute is unconstitutional, particularly in regard to a statute that was reconcilable with the First Amendment in the vast majority of the factual situations, is a blunt tool for a potentially narrow infirmity. If courts identified a specific instance in which a statute failed to fully accommodate First Amendment values, invalidation of the statute as a whole may be extreme, particularly when a less disruptive option could resolve the deficiency appropriately. One alternative would be for a court to find that the statute was unconstitutional "as applied" in the particular circumstance.[52] Such a finding would have the advantage of targeting the specific problem without compromising a system that generally worked. Yet, courts generally avoid constitutional conflicts when alternative constructions or defenses can eliminate the conflict. In addition, carving out a First Amendment safe harbor by findings of unconstitutionality in application appears to be significantly different from an internal doctrine that serves as a free speech safeguard. So, what other alternatives are available to the courts in such a situation where a statute constricts First Amendment breathing room?

Looking to *Eldred* for guidance, it would appear that the optimal way to preserve the traditional contours of copyright so as to safeguard free speech values would be for a court to apply or expand the existing free speech safeguards, or, alternatively, to create an appropriate common law doctrine to address the conflict.[53] Not only have such doctrines established the First Amendment safeguards during the copyright law's development, but these common law doctrines are capable of accommodating changing circumstances or of being created anew.[54] Obviously, such a judicial application of federal common law creation should not be taken lightly; the expansion or creation of a limiting doctrine unquestionably has enormous potential repercussions.[55] But the judicial tailoring of an equitable doctrine to particular facts has the advantage of limiting its application to similarly-situated problems on a case-by-case basis. It can avoid

51. *See Universal City Studios, Inc.*, 273 F.3d at 445.

52. I thank David Snyder for this point.

53. Although it could be argued that creating such a new limiting doctrine is the application of federal common law that was precluded by Erie R.R. Co. v. Tompkins, 304 U.S. 64 (1938), the fact that such a doctrine of exception has constitutional grounds as a free speech safeguard that prevents constitutional conflict may more appropriately be interpreted as judicial gap-filling that effectuates the purpose of the statute. *See, e.g.*, Itar-Tass Russian News Agency v. Russian Kurier Inc., 153 F.3d 82, 90 (2d Cir. 1998) ("We start our analysis with the Copyrights [sic] Act itself, which contains no provision relevant to the pending case concerning conflicts issues. We therefore fill the interstices of the Act by developing federal common law on the conflicts issue.").

54. *See* H.R. REP. NO. 94-1476, at 66 (1976) (Report of the House Committee on the Judiciary on Copyright Law Revision):

The bill endorses the purpose and general scope of the judicial doctrine of fair use, but there is no disposition to freeze the doctrine in the statute, especially during a period of rapid technological change. Beyond a very broad statutory explanation of what fair use is and some of the criteria applicable to it, *the courts must be free to adapt the doctrine to particular situations on a case-by-case basis.* Section 107 is intended to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way. (Emphasis added).

55. Consider the expansive consequences to the fair use doctrine if the Google Book Search's reproduction of all copyrighted books is found to be a fair use.

reaching untenable results undermining the broader congressional scheme.

So what might such a doctrine look like? It would likely look like the free speech safeguards that define the traditional contours of copyright—the idea/expression dichotomy or the fair use privilege—or it could be more focused to solely address specific First Amendment concerns, i.e., a First Amendment privilege. It would limit the copyright owner's rights in order to accommodate First Amendment concerns while at the same time balancing the benefits of copyright itself as an engine of First Amendment values.

Such a common law doctrine may simply expand the existing contours, such as a fair circumvention privilege, or it may take the form of some other equitable limit on the copyright owner's rights. For instance, it has been suggested that a doctrine of anti-circumvention misuse might properly limit over-reaching by a copyright owner when the deployment of § 1201 attempts to extend benefits beyond the scope or duration of the congressional grant.[56] Such a misuse doctrine would have significant advantages over creative statutory interpretations that seek to avoid undesirable results in a particular case. Such a doctrine might address uses of § 1201 that adversely affect free speech concerns (e.g., where the copyright owner was seeking to prevent unwanted expression rather than preventing infringement).

It is for the courts to determine the most appropriate means of resolving a particular problem raised by a case, so speculation about the optimal manner of preserving First Amendment values cannot be determined until the particular case, and its specific facts, presents itself. Nevertheless, court recognition that judicial doctrines have defined the traditional contours of copyright, and that such doctrines have been the only means by which First Amendment conflicts have been avoided throughout much of copyright's history, is critical to the proper application of these doctrines. Judicial doctrines, like contours, are not static, but must adapt with changes in the law of copyright and changing views of First Amendment jurisprudence. Courts have traditionally been granted deferential authority to reconcile the interests of copyright and the First Amendment on a case-by-case basis, but Congress could alter this model. Reconciliation of copyright with the First Amendment will continue to exist only to the extent that courts assert their essential role, even if the contours change. Systemic changes by Congress are not the only potential problem, however, and it remains to briefly examine the practical obstacles that face users of copyrighted works and the courts in realizing free speech safeguards.

IV. PRACTICAL CHALLENGES

Common law limiting doctrines that are capable of accommodating First Amendment values are essential to reconciling the copyright law and the First Amendment. But, the existence of a doctrine is of little consequence unless it fulfills its purpose. As briefly discussed *supra*, these doctrines present many practical impediments to fulfilling their role as free speech safeguards.

56. *See, e.g.*, Dan Burk, *Anticircumvention Misuse*, 50 UCLA L. REV. 1095 (2003).

First, while free speech values may be reconcilable with copyright's statutory limits on the use of copyrighted works through the courts' application of the idea/expression dichotomy and fair use, there is a significant difference between the unrestrained use that is available for works in the public domain and the uses that are available for protected works by way of these limiting doctrines. Any amount of the expression of a public domain work may be used in the creation of new work. The ability to use the ideas or the expression of a public domain work need not involve lawyers or difficult metaphysical tests to determine how much may be used. On the other hand, there are significant hurdles to overcome when one seeks to use works protected by copyright, even if robust internal free speech safeguards exist. Internal free speech safeguards clearly entail social costs, even if they are functioning properly. Yet, the mere existence of safeguards may not be enough to truly fulfill First Amendment interests, if the application of these safeguards is dysfunctional or inconsistent.

In addition, as long as a work is protected by copyright, suits may be brought for infringement of that work even when the use of the work is reasonable. The fact that free speech safeguards exist does not alter the fact that these safeguards primarily serve only in a defensive posture. Without express permission to use a work, a user will not be able to determine with certainty whether a necessary or reasonable use is immunized until adjudication of the issue takes place. Indeed, the threat of suit is not an abstract concept these days as more and more copyright owners, many with a woefully deficient sense of humor or an overabundant sense of proprietary value, all too easily throw down the gauntlet with the threat of litigation. The plethora of cease and desist letters and Online Service Provider takedown notifications[57] are well documented, and yet a significant number of these threats reveal highly questionable claims.[58] The paucity of § 512(g) counter-notifications may, in part, be the result of the fact that the counter-notification requirements do not expressly address noninfringing use or fair use as a basis for replacing content.[59] The ease with which transformative uses may be threatened,

57. *See*, 17 U.S.C § 512(c)(3) (1998), which creates a mechanism that allows copyright owner's or their agents to send a compliant notification to an online service provider when allegedly infringing material is placed online. After receipt of the takedown notification, if an online service provider seeks the benefits of the limitations on liability created in § 512, the service provider must remove the material identified as infringing within a reasonable period of time.

58. *See* Chilling Effects Clearinghouse, *available at* http://www.chillingeffects.org (last visited Apr. 20, 2007).

59. 17 U.S.C. § 512(g)(3)(C) requires a counter notification to include a statement by the subscriber, under penalty of perjury, that the subscriber has a good faith belief that the material was removed or disabled as a result of *mistake or misidentification* of the material to be removed or disabled. It is not at all clear from this statutory language that a subscriber whose use was noninfringing, either because it was simply an idea rather than expression or because it was not within the copyright owner's exclusive rights because the use was a fair use, can state that the removal or disabling was the result of a "mistake or misidentification." The latter term clearly does not apply. Thus, only "mistake" could possibly encompass the concept of a noninfringing use. Why did Congress choose this term if it sought to include the concept of noninfringing use? Although these terms are mentioned in two cases in relation to counter notification, no court has considered whether the term "mistake" can encompass a noninfringing use. *See* Online Policy Group v. Diebold, Inc., 337 F. Supp. 2d 1195 (N.D. Cal. 2004);

chilled, or effectively censored, through the use of cease and desist letters and take-down notifications, raises serious questions about the effects on speech that are not fully known.[60]

The expense of defending reasonable use of a copyrighted work for reasonable speech-related purposes, and the uncertainty of the outcome, quite easily serve to chill or, at least, curb speech. Are the interests of free speech well-served by safeguards that are used, if at all, only tentatively? Are principles of free speech served by an overabundance of caution on the part of users or gatekeepers? And is the user the only victim of this chilling effect, or is the public deprived of meaningful uses that were curtailed by uncertainty and the fear of litigation?[61]

This reality leads some to believe that fair use and the idea/expression dichotomy have outlived their utility. They say that only lawyers benefit from the uncertainty or "fuzziness" of fair use and the idea/expression doctrines, because it allows them to do what they do best—litigate. They say that fair use is nothing more than the right to hire a lawyer.[62] There is some truth to these views, but

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Perfect 10, Inc. v. Cybernet Ventures, Inc., 213 F. Supp. 2d 1146 (C.D. Cal. 2002). This may appear to be an all too common lack of Congressional clarity, yet the implications are great. If "mistake" does not encompass a noninfringing use, then Congress has precluded free speech safeguards in the context of ISP takedowns. Following the discussion in this paper, this would be another example of Congress altering the traditional contours of copyright. Significantly, without a free speech safeguard within the operation of the limitations of liability for online service providers, takedown notifications may well operate as a means of censoring noninfringing speech.

60. While § 512 undoubtedly provides many benefits to the functioning of the copyright system, a clear and effective mechanism for allowing users to challenge the allegations of copyright owners is essential, particularly at a time when it appears that many takedown notices are automated and insufficiently reviewed by the copyright owners or their agents. The recent controversies surrounding participatory media platforms such as YouTube, highlight this tension. While it is easy to find infringing material on these platforms, that fact may obscure the more subtle issues. These platforms also contain a significant amount of transformative material and the persons posting these transformative works deserve an effective mechanism within §512 to assert their claim that the material is noninfringing. Requiring statements that the material was taken down by "mistake" or "misidentification"—the only available terms in the provision—tends to create even more uncertainty.

61. The problems of the so-called "clearance culture" resulting from lawsuits and the threat of litigation have been well documented. *See, e,.g.*, Patricia Aufterheide and Peter Jaszi, *Untold Stories: Creative Consequences of the Rights Clearance Culture for Documentary Filmmakers*, Center for Social Media (2004), *available at* http://www.centerforsocialmedia.org/files/pdf/UNTOLDSTORIES_Report.pdf; Marjorie Heins and Trisha Beckles, *Will Fair Use Survive? Free Expression in the Age of Copyright Control*, Brennan Center for Justice Free Expression Policy Project (2005), *available at* http://www.brennancenter.org/dynamic/subpages/download_file_9056.pdf.
Anecdotally, in a seminar on fair use that I am currently teaching, I observed a difference between assigning an article for class discussion and using a documentary film. For the class discussion on the sampling of sound recordings, I previewed a documentary film on sampling (*Copyright Criminals* by Ben Franzen and Kembrew McLeod) for the class and was struck by the difference a documentary film using actual clips of songs and segments from music videos had on the discussion. The same issues could have been addressed by assigning an article, but the use of the documentary brought the issues alive and allowed students to make their own assessments of the reasonableness of the use of particular portions of material. While it could be argued that use of the actual expression was not necessary to discuss the ideas, or that less expression could be used, I would argue that discussion would have been narrowed without the benefit of more expansive use in this context. First Amendment values would not have been advanced by such constraints.

62. *See, e.g.*, LAWRENCE LESSIG, FREE CULTURE 292 (2004).

question is: how do we address these concerns?

From a policy perspective, many of the calls to return to the past—to copyright law as it previously existed—are not just simply nostalgic, but quite reasonable. It is unlikely that the extension of term protection provided a meaningful incentive for the creation of additional works other than those that likely would have been created under the terms of the first copyright law. Very likely, term extension served primarily as a windfall for existing works that benefited from the extension. Similarly, publication with notice and renewal provided significant benefits to the public in terms of dissemination of ideas, clarity about authorship or ownership, and certainty about the intention to exploit and enforce a copyright. The decision to alter these significant features of American copyright law based on the goal of international harmonization is, at best, tenuous.

Despite these facts, it remains clear that the Supreme Court does not believe that these features such as duration or renewal affect the traditional contours of copyright that serve to safeguard free speech values.[63] The Court's view together with the unlikelihood that Congress will choose to reverse itself should inspire a more pragmatic approach, at least for the short term.[64] What should we do to improve the law as it now stands?

In addressing this question, we must ask whether the doctrines of fair use and the idea/expression dichotomy have outlived their usefulness. Is the uncertainty they entail such that they are incapable of fulfilling the purpose for which they primarily exist? The answer is not certain, but there is ample basis to suggest that a number of improvements in the application of these free speech safeguards are imperative to effectively promote free speech interests.

In part, the difficulty in the current application of the free speech safeguards may be attributed to the demands being placed on these doctrines. Fair use is being asked to do much more than satisfy First Amendment concerns.[65] Fair use is now expected to serve a role that is well beyond its common law roots and one that surpasses basic principles of common law case-by-case adjudication.[66] Systematic

63. The Ninth Circuit recently agreed with this view. *See* Kahle v. Ashcroft, 72 U.S.P.Q.2d (BNA) 1888 (N.D. Cal. 2004), *aff'd sub nom* Kahle v Gonzales, 474 F.3d 665 (9th Cir. 2007).

64. If Congress ever decided to undertake a fundamental revision of the Copyright Act as a whole, as it did with the 1976 Copyright Act, many of these issues would be appropriate to bring to the table.

65. *See, e.g.*, Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417 (1984); Sega Enters. v Accolade, Inc., 977 F.2d 1510 (9th Cir. 1992); Sony Computer Entm't v. Connectix Corp., 203 F.3d 596 (9th Cir. 2000), *cert. denied*, 531 U.S. 871 (2000); Kelly v. Arriba Soft, 336 F.3d 811 (9th Cir. 2003); Authors' Guild v. Google, Inc., No. 05 CV 8136 (S.D.N.Y. filed Sept. 20, 2005); and McGraw Hill Co. v. Google, Inc, No. 05 CV 8881 (S.D.N.Y. filed Oct 19, 2005). It is interesting to note that all of these expansions of the fair use doctrine are attributable to Ninth Circuit law with the exception of the *Sony Corp.* decision by the Supreme Court reversing the Ninth Circuit's earlier narrower interpretation. For a thorough discussion of how the Justices in *Sony Corp.* came to rest upon the fair use doctrine to systematic use, *see* Peter S. Menell. and David Nimmer, *Unwinding Sony*, UC Berkeley Public Law Research Paper No. 930728 (2006), *available at* http://ssrn.com/abstract=930728.

66. See, e.g., Sanford G. Thatcher, *Fair Use in Theory and Practice: Reflections on its History and the Google Case*, 37 J. SCHOLARLY PUBLISHING 215, 216-17 (Apr. 2006) (arguing that Congress's importation of reproductive use into the conceptual ambit of fair use led to the conceptual confusion that has plagued fair use jurisprudence ever since). While I disagree with the author that wholesale

reproduction on a massive scale that encompasses a multitude of disparate works is largely incompatible with the work-by-work analysis that is necessary for a determination of fair use. Fair use as a means of breathing room for technological innovation is a significantly different analysis from fair use as a First Amendment safeguard.

Perhaps the functional technological uses that have been pushed within the scope of fair use are better addressed in other fora, either through market solutions, legislation exceptions, or statutory licenses.[67] Forcing fair use to handle perceived market failure in relation to new technologies transforms fair use from a free speech safeguard into a monolithic tool of social and economic efficiency.[68] The market failure of systematic uses of broad categories of works is better addressed through legislative action and tailored exemptions than through judicial safety valves designed for work-specific adjudication.

At a minimum, it would be advantageous to distinguish between these two disparate patterns of fair use, as a free speech safeguard on the one hand, and as an exemption for noninfringing technological uses on the other. Unquestionably, there are fundamental differences in these patterns that should be recognized in the approach to the analysis. Once the claim of fair use is established to be in the former category, judicial attention to providing sufficient First Amendment breathing space should be emphasized. Any use that fits within the types of uses specified in the preamble to § 107 would fall comfortably within this category and receive heightened sensitivity as to the purpose and character of the use.

Reforming the fair use analysis to more fully promote First Amendment values must also entail increased understanding of the distinction between transformative

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reproductive use for a productive purpose, e.g. classroom teaching purposes, is outside the scope of traditional fair use principles, I will concede that it created a slippery slope. Further, I agree with the author's views insofar as technological uses must entail a distinctly different fair use analysis from uses that involve free speech considerations, such as those illustrative uses mentioned in the preamble to § 107. In particular, where a use implicates entire "classes" of works, rather than the use of a particular work or works related to their expressive purpose, the doctrine is transformed from a case-by-case free speech safeguard into judicial policy-making.

67. *See* Wendy Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors*, 82 COLUM. L. REV. 1600 (1982). Although Wendy Gordon's seminal article reveals how courts use fair use to address perceived market failures, market failure on a systemic level has traditionally been addressed by Congress through either statutory exemptions or statutory licenses. The interjection of judicial solutions to systemic market failure involving entire classes or categories of works would appear to fall well outside case-by-case adjudication. Systematic use of works is also outside the scope of the fair use analysis since it requires courts to generalize about the "work" at issue. Disparate works generally involve different analyses, even if the general use is the same.

68. As Fred von Lohmann points out, this is not a problem, but rather a purpose for which fair use exists—to set precedent in our common law system. This might be the precise type of precedent that Michael Madison hopes fair use will legitimize through recognition of social patterns. *See*, Michael Madison, *A Pattern-Oriented Approach to Fair Use*, 45 WM. & MARY L. REV. 1525 (2004), *available at* http://www.law.pitt.edu/madison/papers/drafts.htm. While this is part of what fair use has become, it is a contemporary adjunct to its fundamental constitutional role as a free speech safeguard. Whether the doctrine can carry this additional weight without obscuring its basic purpose is an important consideration.

uses and derivative works. Although a thorough and thoughtful exposition of this distinction is beyond the scope of this article,[69] it is worth noting that it is a distinction at the heart of the problem. Even though transformative uses have been emphasized since the Court's Campbell decision, the tendency of the courts to give disproportionate weight to the fourth fair use factor tends to obscure all but the most obvious and limited transformative uses.

This bias, together with the increasingly expansive scope of potential derivative markets considered in the question of *potential* harm to the work used, obfuscates the centrality of fostering new expression. Borrowing ideas and expression in order to build upon what came before, or incorporating common social references that are essential parts of our culture—even though those references are copyrighted—are ways in which legitimate new expression can develop. While it is impermissible to supersede a market for which a work was created or in which such a work would normally be exploited, few truly transformative uses—particularly the type of uses that implicate free speech interests—compromise such markets. This is true unless, of course, the relevant market is found to include the licensing of portions of works for use. Even though the licensing of literary quotations seems unthinkable, equivalent clip markets in numerous other sectors have served to turn the fourth factor into a futile exercise in circular reasoning.[70] If fair use is to serve as a real free speech safeguard, increased sensitivity to the transformativeness of the use must be accompanied by heightened scrutiny of "traditional" and "reasonable" derivative markets.[71]

Another improvement to the application of free speech safeguards would entail a more dynamic recognition of the fact that the constitutional protection of "speech" entails criticism or comment, not only through words, but through the use of pictures, music, sounds, dance and other symbolic forms of expression.[72] The use of a movie clip, a picture, a photograph, or a portion of a sound recording of another may be important to furthering the goal of the user's expressive purpose. Just as a picture is worth a thousand words, a sound recording sample may be a useful social reference and further a new expressive end. An overly restrictive view of sampling from sound recordings or of incidental or transformative uses of visual works,[73] may deprive users of vital social references that enhance free

69. It will be the subject of my forthcoming article.

70. The sampling of sound recording clips provides an example of the disparate treatment between literary quotation and the referential use of small portions of other types of copyrighted works.

71. *See* Am. Geophysical Union v. Texaco Inc., 60 F.3d 913, 930 (2d Cir. 1994) ("However, not every effect on potential licensing revenues enters the analysis under the fourth factor, Specifically, courts have recognized limits on the concept of "potential licensing revenues" by considering only traditional, reasonable, or likely to be developed markets when examining and assessing a secondary use's "effect upon the potential market for or value of the copyrighted work.").

72. Universal City Studios, Inc. v. Corley, 273 F.3d 429, 445-446 (2d Cir. 2001) ("Communication does not lose constitutional protection as 'speech' simply because it is expressed in the language of computer code. Mathematical formulae and musical scores are written in 'code,' i.e., symbolic notations not comprehensible to the uninitiated, and yet both are covered by the First Amendment."). *See also* Marci Hamilton, *Art Speech*, 49 VAND. L. REV. 73 (1996).

73. *See* Blanch v. Koons, 467 F.3d 244 (2d Cir. 2006) for an example of a case recognizing the transformative and expressive use of a portion of a photograph in a new work.

speech values without adversely affecting the salient markets of the copyright owner. The claim of "clip" or "sample" licensing markets should be viewed with greater skepticism where the use of a clip from another work is in the furtherance of a new expressive work that does not supersede the market for the original work from which the clip was taken.[74] While all the factors would have to be considered, where the use involves a transformative purpose that reasonably implicates any form of speech-based expression, courts should be highly sensitive to the fact that fair use is serving a vital role as a First Amendment safety valve.

In a similar vein, courts need to develop further a more robust understanding of the idea/expression dichotomy. Many commentators appear to believe that this doctrine is of little value to the analysis of works other than literary works.[75] This is understandable, since there is a paucity of analysis of the idea/expression dichotomy in infringement suits involving musical works, visual arts, sound recordings and other non-literary works. Nevertheless, that does not mean that the doctrine does not have application in these areas, but rather simply means that further understanding of the scope of the doctrine is necessary. Justice Bradley's comments about "perspective" in *Baker v. Selden* are fully applicable to a painting incorporating perspective as to a book about perspective.[76] Describing or using an idea, system or process in one work should not extend protection of the idea in another. Further levels of abstraction, such as "styles" of perspective, might also be freed for purposes of noninfringing expression.[77] It is also important to remember that the idea/expression dichotomy and the doctrine of fair use may operate in unison, such that an idea together with a reasonable amount of actual expression may be joined together as a noninfringing use.[78]

In his article in this edition, Joseph Liu offers a number of thoughtful suggestions to promote additional breathing space for First Amendment concerns within the fair use analysis. Suggestions such as shifting the burden of proof to the plaintiff in colorable free speech-based fair use claims and potentially limiting

74. In addition to the circularity of licensing markets as a relevant market for fair use purposes (which far too greatly credits the market failure basis for fair use), the use of portions of a work within a new work rarely supersedes the market for the original work as a whole. While the existence of efficient licensing mechanisms for entire works should be a relevant consideration, e.g., the Copyright Clearance Center for article reproduction or coursepack anthologies that merely repackage significant portions of reproduced works, would anyone credit the creation of an efficient licensing mechanism for permitting quotations of a few words in the creation of new articles as a relevant market for the purposes of the fourth factor? If not, why is a three-note "quotation" of a sound recording incorporated into a new work treated differently. *See, e.g.*, Bridgeport Music, Inc. v. Dimension Films, 410 F.3d 792 (6th Cir. 2005).

75. *See supra* note 22.

76. 101 U.S. 99, 103 (1880) ("The copyright of a book on perspective, no matter how many drawings and illustrations it may contain, gives no exclusive right to the modes of drawing described, though they may never have been known or used before.").

77. Such as the style at issue in Steinberg v. Columbia Pictures Indus., Inc., 663 F. Supp. 706 (S.D.N.Y. 1987).

78. The Steinberg case also provides an illustration of this point, where the myopic perspective was coupled with the trivial use of the façade of a particular building, among other minor similarities. While some courts could conclude that the "total concept and feel" of the works are similar, this finding should not change the fact that the use of abstract ideas together with fair uses of expression may provide a similar "concept and feel," yet nevertheless be noninfringing.

damages to reasonable royalties when the claim is based on reasonable free speech reliance are worthy of further consideration.[79] If a colorable fair use claim fails, First Amendment concerns may well be furthered by limiting the dispensation of remedies. As Paul Goldstein long ago pointed out,[80] and Judge Leval more recently restated, [81] courts need not impose injunctive relief in all cases where a use is ultimately determined to be infringing. In certain cases, injunctive relief may be an appropriate remedy, e.g., when the use is unreasonable or the user seeks to push the boundaries of fair use. But in those close cases where the defendant was acting in good faith but nevertheless crossed the line, and where monetary remedies are fully capable of offsetting the harm, injunctive relief may be an improper abridgement of speech.[82] The Supreme Court's recent endorsement of the traditional four-factor test for awarding permanent injunctive relief to a prevailing plaintiff provides strong support for such a view in the fair use context.[83] Given the public interest in free speech values, the judicious application of injunctions, when First Amendment interests are implicated, is even more compelling than it is in the realm of patented inventions.[84]

When courts begin to view speech-based fair use claims through a First Amendment lens, they are less likely to "prejudice [an alleged infringer's] position with assumptions of infringement's intrinsic badness," and more likely to vindicate the public interest involved.[85] Perhaps then we will see the diminution of moral, and even biblical, condemnations of transformative uses of copyrighted works,

79. Joseph P. Liu, *Copyright and Breathing Space*, 30 COLUM. J. L. & ARTS 429 (2007).

80. Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 1032-34 (1970).

81. *See* Pierre N. Leval, Campbell v. Acuff-Rose*: Justice Souter's Rescue of Fair Use*, 13 CARDOZO ARTS & ENT. L.J. 19, 24-25 (1994).

82. A good example of such a case might be Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir. 1997), in which the court determined that the Cat Not in a Hat was not a parody of Dr. Seuss books, but rather was a satire of the events surrounding the O.J. Simpson trial. Upon finding that the use was not a fair use, the court awarded damages and a permanent injunction. As a result, even scholars had difficulty fully assessing the case because the book itself became largely unavailable due to the injunction. As Judge Alex Kozinski stated, unlike other areas of First Amendment law, through the use of injunctions in copyright, Congress gave copyright owners the de facto power to burn books. *See* Alex Kozinski & Christopher Newman, *What's So Fair About Fair Use*, 46 J. COPYRIGHT SOC'Y U.S.A. 513, 516-17 (1999):

> Think about this for a moment. Congress has given courts the power to order books burned. In a legal regime as jealously protective of freedoms of speech and press as ours, this ought to give us some pause. What's that you say? Classified documents about our Vietnam war effort have been stolen from the Pentagon and given to the newspapers? You want an injunction to avoid risking the death of soldiers, the destruction of alliances, the prolongation of war? No way, Jose; this is the land of the brave and the home of the free. But wait a minute - did you say someone drew a picture of O.J. Simpson wearing a goofy stovepipe hat? Light the bonfires, it's Nuremberg time!

83. eBay Inc. v. MercExchange, L.L.C., 126 S. Ct. 1837 (2006)

84. At least one recent appellate court has applied the *eBay* holding in a copyright infringement context. Christopher Phelps & Assocs. v. Galloway, 477 F.3d 128 (4th Cir. 2007). Despite the questionable analysis of other issues in the opinion, it certain that we will see more courts applying the Court's *eBay* holding to the consideration of injunctive relief.

85. Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 1056 (1970).

such as "Thou Shalt Not Steal."[86] We may also foster creative uses of other's expression, such as satire, that do not interfere with the original copyright owner's market, and prevent such expressive uses from being withdrawn from public discourse altogether.[87] Creating a rebuttable evidentiary presumption against injunctive relief in cases involving colorable speech-based claims of fair use, may foster negotiation of reasonable royalties among parties in close cases of commercial use, thereby reducing the uncertainty in the creative process.[88]

Other improvements to the law that serve to decrease the chilling effect on transformative use from weak or merit-less threats may also be possible. The Supreme Court has held that the discretionary award of attorney's fees to prevailing defendants is just as socially important as awards to prevailing plaintiffs seeking to enforce their rights.[89] The availability of attorney's fees to prevailing defendants—a way in which the Copyright Act departs from the traditional American Rule in regard to attorney's fees—is one way in which the copyright law promotes the meritorious assertion of noninfringing uses of the expression of others. This is a significant benefit to users, but is it enough? The potential availability of attorney's fees provides an incentive for lawyers to take on the meritorious defense of infringement cases, knowing that if they prevail, they can recover reasonable expenses for their time. The availability of representation to defend a transformative use against an infringement claim is useful, but do lawyers typically take uncertain cases, e.g., contingent cases, without more than the possibility of being reasonably compensated for their time? Don't most plaintiffs' lawyers generally take contingent fee cases on the basis of a percentage of the client's expected monetary recovery? While the availability of attorney's fees to prevailing defendants is beneficial in promoting meritorious defenses, it is not clear that this mechanism adequately promotes free speech advocacy on behalf of users.[90]

We also need to consider whether the availability of attorney's fees sufficiently promotes users' pursuit of speech-based defenses to infringement. Does the availability of attorney's fees address the significant expenditure of a user's time that is required to litigate a federal lawsuit to advance the interests of First Amendment values? How many legitimate uses will be worth the significant effort

86. Grand Upright Music, Ltd. v. Warner Bros. Records, Inc., 780 F. Supp. 182 (S.D.N.Y. 1991) (involving Biz Markie's sampled use of Gilbert O'Sullivan's song "Alone Again (Naturally)").

87. *See, e.g., Dr. Seuss Enters., L.P.* 109 F.3d 1394, *cert. dismissed*, 118 S. Ct. 27 (1997).

88. Another possible change is providing more discretion to the court in the award of statutory damages. A transformative work that incorporates many other works, such as a documentary film, a sound recording with sampling, or a collage, could result in high statutory damages even at the minimum discretionary levels. Allowing courts to remit damages in cases where a reasonable, good faith belief that the use was fair (similar to what is currently available for nonprofit educational institutions or their agents) is another potential change that could be considered.

89. Fogerty v. Fantasy, Inc., 510 U.S. 517, 527 (1994) ("Thus a successful defense of a copyright infringement action may further the policies of the Copyright Act every bit as much as a successful prosecution of an infringement claim by the holder of a copyright").

90. This may promote public interest group representation of representative cases, but in order to encourage the private copyright bar to represent defendants, it is likely that a monetary return comparable to what a plaintiff's lawyers could recover may be needed if balanced representation is the goal.

expended and costs borne to justify litigation merely on the principle of the matter, without any economic incentive to anyone but the lawyers involved? If "a successful defense of a copyright infringement action may further the policies of the Copyright Act every bit as much as a successful prosecution of an infringement claim by the holder of a copyright," are attorney's fees a sufficient means of economic balance? Copyright owners may receive statutory damages without any proof of harm. If a successful defense equally furthers the policies of the Copyright Act, and fair use furthers the policies of the First Amendment, shouldn't Congress fashion a means for prevailing defendants to receive some form of statutory damages? Wouldn't it also be beneficial to allow users to assert some cause of action based on the First Amendment fair use claims, at least where the user has been instructed by a copyright owner to cease the use of the work?

Declaratory relief actions are available to defendants when they can show "that there is a substantial controversy, between the parties having adverse legal interests, of sufficient immediacy and reality to warrant" relief.[91] But in a number of cases, a cease and desist letter from a copyright has been found to be insufficient to support a justiciable case or controversy.[92] The Supreme Court's recent decision in *MedImmune, Inc., v. Genetech, Inc.* may make it easier for defendants to establish the existence of a sufficient controversy, but that remains to be seen.[93]

In order to more fully promote free speech interests within the Copyright Act, it may be worth considering a new mechanism in which fair use could be asserted, at least when a cease and desist letter or a takedown notification has been sent to a user or his or her online service provider.[94] While such an action may be possible

91. MedImmune, Inc. v. Genetech, Inc., 127 S. Ct. 764, 771 (2007).

92. *See, e.g.*, the controversy between Professor Edward Felten and the RIAA: http://www.eff.org/IP/DMCA/Felten_v_RIAA/ (last visited May 4, 2007); and particularly the district court's final hearing transcript: http://www.eff.org/IP/DMCA/Felten_v_RIAA/20011128_hearing_transcript.html (last visited May 4, 2007):

> The plaintiffs say, well, this is a First Amendment case and, therefore, it is different. Well, as the Third Circuit has noted in the Salvation Army case, again referred to by both sides, 919 F.2d 183, Third Circuit, 1990, where a plaintiff seeks a declaratory judgment with respect to constitutionality of a State Statute, even when the attack is on First Amendment grounds, there must be a real and immediate threat of enforcement against the plaintiff. And this threat must remain throughout the course of the litigation.
>
> Well, the clear and uncontested record here indicates that there is not a real and immediate threat of enforcement against the plaintiffs, much less one that remains throughout the course of the litigation.
>
> The fact that the plaintiffs assert that they feel chilled, their subjective views are insufficient unless we find evidence that there is an actual immediate threat. As to the hypothetical future academic papers, I don't think that those provide a sufficient ground for the immediacy asserted by the plaintiffs. The plaintiffs, of course, bear the burden of establishing the elements of the jurisdiction of this Court. I don't see any injury, in fact, here.
>
> Not only would it be premature adjudication, but it is ephemeral adjudication. It is speculative adjudication. It is by analogy. Sort of adjudication that would let the Court peer into the future to determine whether any loan application by a putative plaintiff could conceivably be a fraud. Courts are ill equipped to engage in that sort of speculation.

93. 127 S. Ct. 764 (2007) (holding that the existence of a license with a patent owner did not prevent the licensee from challenging the validity of the patent in a declaratory judgment action.)

94. There is some basis in intellectual property law for the assertion of antitrust claims based on

as a request for declaratory relief, it may be preferable for Congress to provide for the recovery of a discretionary award of statutory damages to the prevailing party in such a suit when a speech-based use is involved. Not only might such a mechanism decrease frivolous and weak claims of infringement,[95] but such a model would provide an incentive for copyright owners to more carefully consider the merits of threats or take-down notifications prior to dispatching them. And, perhaps more importantly, such a mechanism would encourage conscientious users of copyrighted works to more vigorously defend their speech-based claims.[96] Such a mechanism would more fully promote those socially meritorious uses that the Supreme Court has suggested further the policies of the Copyright Act. Similarly, such a mechanism would more fully promote the idea/expression dichotomy and the fair use privilege as active free speech safeguards. Such a mechanism would also be more likely to encourage the negotiation of reasonable fees for licenses uses, since both parties would face economic risks by going forward with their claims. In short, providing statutory damages to the prevailing party, in addition to attorney's fees, would more fully promote legitimate speech and increase First Amendment breathing space.[97]

As an alternative, or an impetus, to altering judicial tendencies in regard to the fair use analysis, how can the internal free speech safeguards be transformed from mechanisms that are capable of accommodating First Amendment interests into robust tools that effectuate and promote First Amendment interests? Due to the fact that arriving at a consensus between copyright owners and users of copyrighted works over what constitutes reasonable use has historically been a dismal failure,[98] alternative means of reaching the goal of establishing reasonable norms are extremely promising. In particular, the momentum has begun to establish "best practices" of fair use in creative sectors as an alternative to the difficulty, and often

improper threats of suit. In Walker Process Equip. Inc. v. Food Machinery & Chem. Corp., 382 U.S. 172 (1965), the Supreme Court held that enforcement of a patent procured by fraud on the PTO may violate Section 2 of the Sherman Act, provided other Section 2 elements are present. More recently, *Walker Process* claims were allowed by the Federal Circuit when threats of litigation against customers were based on a fraudulently-procured patent, together with a reasonable likelihood that such threats cause the customers to cease dealing with their supplier. Hydril Co. v. Grant Prideco LP, 474 F.3d 1344 (Fed. Cir. 2007).

95. It should be noted that while the possibility for Rule 11 sanctions exists under the FRCP for frivolous claims, this imposition of sanctions is rare, and, given the legal uncertainty that exists with the idea/expression dichotomy and the fair use privilege, the attorney would be able to maintain that the case sought "the extension, modification, or reversal of existing law or the establishment of new law" in the vast majority of cases.

96. While sanctions are possible for frivolous claims under existing law, courts have typically reserved such remedy only for egregious cases. Yet, providing a discretionary monetary remedy for tenuous claims of infringement may better serve to promote First Amendment interests and more sufficiently discourage frivolous threats.

97. The *MedImmune* decision lends further support for views expressed by the Court in *Fogarty* that meritorious defenses are critical to the intellectual property system. Since the MedImmune decision made it easier to challenge the claim of validity, even when a party has licensed use of the alleged intellectual property, the Court is implicitly encouraging defining the contours of intellectual property.

98. *See, e.g.*, The Conference of Fair Use (CONFU) Report, *available at* http://www.utsystem.edu/ogc/INTELLECTUALPROPERTY/confu.htm (last visited Feb. 1, 2007).

futility, of creating negotiated "guidelines."[99]

As in the area of quotations in books and articles, customs and norms within copyright sectors have the capacity to encourage reasonable uses. The development of "best practices" in particular areas of use has the capacity to establish reasonable customs and practices of use that may become accepted as reasonable and reliable safe harbors. As the Supreme Court has noted, "the fair use doctrine was predicated on the author's implied consent to 'reasonable and customary' use when he released his work for public consumption. . . ."[100] Best practices that are developed by users who are also established creators in their own right, and who desire respect for their own works, tend to embody reasonableness in their approach. As such, the development and creation of best practices can lead to the establishment of understandable safe harbors that satisfy the modified Golden Rule of fair use: "Take not from others to such an extent and in such a manner that you would be resentful if they so took from you."[101]

V. CONCLUSION

In *Eldred*, the Supreme Court identified the common law doctrines of the idea/expression dichotomy and fair use as critical internal free speech safeguards that must be preserved if copyright is to be harmonized with the First Amendment. The Court's view emphasizes that the existence of limiting principles on the scope of the exclusive rights of copyright owners can prevent independent First Amendment challenges to copyright, but that this could change.

If Congress alters these traditional limits on the scope of exclusive rights, courts must continue to guarantee that First Amendment interests are preserved. Where narrow interpretation, narrow application or the sufficiency of existing doctrines does not preserve free speech interests, judicial adaptation of the existing free speech safeguards or by the creation of new common law doctrines that are informed by First Amendment jurisprudence may be necessary.

Yet even if Congress does not alter the traditional contours of copyright, the mere existence of doctrines capable of accommodating First Amendment values is not enough to accommodate free speech interests. The application of these existing doctrines by the courts must be attentive to their constitutional purpose. The idea/expression dichotomy and the fair use doctrine must be rigorously applied through the lens of First Amendment jurisprudence. Further thought must also be given to means of more fully fostering the legitimate use of the expression of others. As the Supreme Court recognized, "we cannot indulge in the facile assumption that one can forbid particular words without running a substantial risk

99. *See* Documentary Filmmakers' Statement of Best Practices of Fair Use, *available at* http://www.centerforsocialmedia.org/files/pdf/fair_use_final.pdf (last visited Feb. 1, 2007).

100. Harper & Row, Publishers Inc. v. Nation Enters, 471 U.S. 539, 550 (1985).

101. David Nimmer, *"Fairest of Them All" and Other Fairy Tales of Fair Use*, 66 LAW & CONTEMP. PROBS. 263, 287 (2003) (*quoting* Joseph A. McDonald, *Non-infringing Uses*, 9 BULL. COPYRIGHT SOC. 466, 467 (1962)). *See also*, *Harper & Row*, 471 U.S. at 550 n.3.

of suppressing the ideas in the process."[102] While the words at issue in the *Cohen* case were not copyrightable expression, the Court's point is equally applicable to the fair use of copyrightable expression as it is to inflammatory words.

The use of another's speech must be entitled to sufficient breathing space, even if that speech is copyrighted, as long as the use transforms the context of the expression for speech-related purposes. Courts must recognize the centrality of the idea/expression dichotomy and fair use in fulfilling this constitutional purpose. Where a particular use raises a colorable claim of legitimate expression, courts must be attentive to heightened concern to ensure that the fundamental purpose of these safeguards is carried out.

In light of these free speech interests, courts must also begin to become more sensitive to the subtle distinction between the transformative use of another's expression and the reasonable derivative markets of a copyright owner's work. The fair use analysis is capable of ascertaining this difference between the two, but only if courts are reminded that First Amendment concerns are central to the inquiry, and that reward to the author is not the primary goal of copyright. As the Supreme Court stated, the goal of copyright is generally furthered by the creation of transformative works, which "lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright."[103] All too often courts recite and tally the factors, but forget the fundamental purpose of the question. Fairness, reasonableness, and good faith are values that soundly guide the analysis of the factors, but in many cases, such as those illustrative uses listed in the preamble of § 107,[104] the court must view the factors through the lens of the First Amendment.

Despite the difficulty of the analysis and the wide array of forms in which it may arise, as with fair use, courts must consider the relevance of the idea/expression dichotomy within the claims of infringement. As a constituent free speech safeguard, courts can not indulge in the luxury of avoiding or bypassing its consideration. The investigation of its applicability to the substantial similarity analysis is essential, even when actual expression has been used, because the understanding of the scope of the idea may inform the analysis of the extent to which any expression was used.

The Supreme Court has placed a constitutional burden on these common law

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102. Cohen v. California, 403 U.S. 15, 26 (1971). It is interesting to note that the attorney arguing on behalf of Paul Cohen's right to speak—which in that case involved words on a T-shirt stating "FUCK THE DRAFT. STOP THE WAR"—was none other than Melville Nimmer, the author of the 1970 article on the question of conflict between copyright and the freedom of speech. The fascinating oral argument in that case is available to hear at: http://www.oyez.org/cases/1970-1979/1970/1970_299/ (last visited May 4, 2007).

103. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994).

104. 17 U.S.C. § 107. The preamble states:

> 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 . . . . *Id.*

doctrines, and as a result, courts must pay particular attention to this role. As the Court in *Eldred* stated, "it is appropriate to construe copyright's internal safeguards to accommodate First Amendment concerns."[105] Even though copyright can be an engine of expression, the limited monopoly granted cannot be allowed to abridge or to chill legitimate speech. Unless courts adequately protect speech interests through these internal doctrines, the significant benefits that copyright law bestows upon our society will be placed in jeopardy. The areas of potential change and improvement suggested in this article do not simply benefit First Amendment interests at the expense of copyright. It is in the interest of copyright that we need to strengthen free speech safeguards through interpretive or procedural changes to ensure that they are fulfilling their purpose. These free speech safeguards are essential to copyright's ultimate goal and its continued integrity, because a direct conflict between copyright and the First Amendment is a battle that copyright cannot win.

105. Eldred v. Ashcroft, 537 U.S. 186, 221 n.24 (2003).