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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.