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Copyright

Copyright protects creative expression. In some ways it is structurally similar to patent law: both reward someone who creates valuable information with exclusive rights over it. But in many other ways – including subject matter, novelty, registration, term, and similarity – copyright is almost completely the opposite of patent.

The standard justification for copyright law is familiar and utilitarian: to maximize public access to the fruits of human creativity. Thus, copyright law provides an economic ***incentive to create*** new expressive works, and provides protections to encourage the ***distribution*** of those works. Another rationale, with more of a natural-law flavor, is to protect ***authors' non-economic interests*** by giving them creative control over their work. One sometimes also sees arguments that link copyright and ***freedom of speech*** in a shared goal of creating a diverse society with a healthy culture and healthy democracy.

Like patent, copyright law derives from Congress's power under the IP Clause. Congress enacted the first federal copyright act in 1789, which provided for a federal copyright in maps, charts, and books for a term of 14 years, renewable for another 14 years. The subject matter has expanded since then, as has the length of the term. The current statute, the Copyright Act of 1976 (as heavily amended) protects all "original works of authorship" for a term of the author's life plus another 70 years. The previous act, the Copyright Act of 1909 (also heavily amended) casts a long shadow even today and is important for understanding the 1976 act.

For much of U.S. history, federal copyright coexisted alongside state copyright, with publication typically marking the dividing line between the two. The 1976 Copyright Act, as amended, has now almost completely displaced state copyright, but state law's vestigial traces remain, like the appendix of the copyright system, occasionally erputing with painful consequences.

Copyright "subsists" immediately when a work is created and "fixed in any tangible medium of expression," but federal registraion is generally required to bring an infringement suit. The registration process, which is administered by the Copyright Office, a division of the Library of Congress, is quick, cheap, and lightweight compared with

patent examination. The Copyright Office also maintains the records of registrations and other copyright filings, publishes extensive guidance on copyright law, and produces major policy studies on copyright law. Anyone working seriously with copyright should be familiar with the Office's Copyright Off..[1] A Restatement of Copyright project at the American Law Institute is currently underway.[2]

1. Copyright Off., Compendium of U.S. Copyright Office Practices (3d ed as rev. 2021) [hereinafter Compendium].
2. The standard copyright treatises are Melville B. Nimmer & David Nimmer, Nimmer on Copyright (2021); William F. Patry, Patry on Copyright (2021); Howard B. Abrams, The Law of Copyright (2020); Bruce P. Keller & Jeffrey P. Cunard, Copyright Law: A Practitioner's Guide (2020).

A Subject Matter

Copyright protects original works of authorship. It does *not* limit protection to particular kinds of art or creativity, but it *does* exclude "ideas" from being copyrightable.

1 Works of Authorship

Section 102(a) of the Copyright Act states:

> Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.[3]

3. 17 U.S.C. § 102(a).

As *Feist Publications, Inc. v. Rural Telephone Service Co.*, the leading case on copyrightability, explains:

> The *sine qua non* of copyright is originality. To qualify for copyright protection, a work must be original to the author. Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.[4]

4. Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991).

Elsewhere, *Feist* helpfully expresses the elements of originality as "independent creation plus a modicum of creativity."

a Originality

Feist involved competing telephone directories. The Rural Telephone Service Company operates in northwest Kansas. As legally required by state franchise regulations, it published an annual telephone directory that " list[ed] in alphabetical order the names of Rural's subscribers, together with their towns and telephone numbers."[5]

Feist published a telephone directory, covering a much larger geographic area, which contained 46,878 listings. Feist requested a license to Rural's listings; Rural refused. Feist's employees verified the data for 4,935 individuals in Rural's service area. 1,309 of the listings in Feist's telephone directory were identical to listings from Rural's, including "four fictitious listings that Rural had inserted into its directory to detect copying."[6]


ALPHABETICAL TELEPHONE DIRECTORY

Rural's telephone directory

5. *Id.* at 342.

Rural sued for copyright infringement, and won in both the District Court and Court of Appeals on a theory of "sweat of the brow" – that a copyist should not be able to free ride on the hard work of someone who has assembled a compilation of information, even if the individual entries are uncopyrightably unoriginal. As one classic case put it:

> The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which are *publici juris*, or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection. The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author.[7]

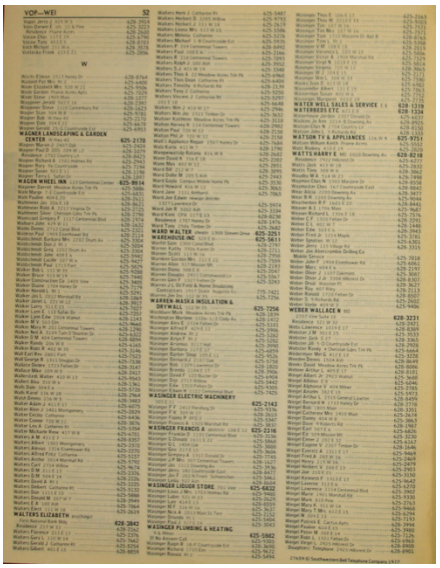
But the Supreme Court unanimously reversed, holding that only originality – not effort – is a proper basis for copyright protection.

> Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying. To illustrate, assume that two poets, each ignorant of the other, compose identical poems. Neither work is novel, yet both are original and, hence, copyrightable.[8]

The theory here is one sometimes known as ***romantic authorship***: creativity is the product of an individual's unique and inimitable artistic inspiration, and this personal essence infused into the work is what copyright protects. It follows immediately that facts are uncopyrightable.

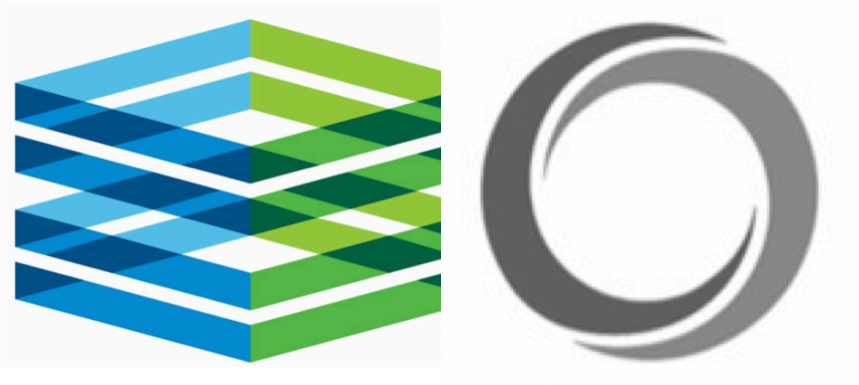
> No one may claim originality as to facts. This is because facts do not owe their origin to an act of authorship. The distinction is one between creation and discovery: The first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence. . . . Census takers, for example, do not "create" the population figures that emerge from their efforts; in a sense, they copy these figures from the world around them. Census data therefore do not trigger copyright because these data are not "original" in the constitutional sense. The same is true of all facts – scientific, historical, biographical, and news of the day. They may not be copyrighted and are part of the public domain available to every person.[9]

Thus, Rural had no copyright in its customers' names, addresses, and telephone numbers. It did not create them; it merely recorded these facts in its directory.



Feist's telephone directory

6. *Id.* at 344.
7. Jeweler's Circular Publ'g Co. v. Keystone Pub. Co., 281 F. 83, 88 (2d Cir. 1922).
8. *Feist*, 499 U.S. at 345.
9. *Id.* at 347–48.



(a) Rack Stack logo (b) Objective Partners logo

Which one is creative enough to be copyrightable?

b A Modicum of Creativity

The rule that facts are uncopyrightable is a qualitative test, but originality also has a quantitative component. There must be at least a "modicum" or "minimal degree" of creativity. How much is a modicum? Not much. *Feist*:

> To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, no matter how crude, humble or obvious it might be.[10]

10. *Id.* at 345.

Starting in 2016, the Copyright Office's Review Board, which hears appeals of registration refusals, has helpfully published its opinions online. They provide a nice window onto the thin line that separates a minimal degree of creativity from a sub-minimal degree. Compare the two logos in Figure 4.3. The Rack Stack logo on the left was copyrightable:

> Though the work employs common geometric shapes, viewed as a whole, the Work combines the constituent elements in a sufficiently creative way to meet the statutory requirements for copyright protection. The Work employs different colors, choosing shades of blue for the left half of the Work and shades of green on the right, with different shades chosen for different sections of the prisms. LPC varied the spacing between the second and third prisms, and also made creative choices in removing six sections of the rectangular prisms to create a unique visual effect. These choices are sufficient to provide the "modicum of creativity" required for copyright protection.

But the Objective Partners logo on the right was uncopyrightable:

> The Board finds that none of the Work's individual components are sufficiently creative to be eligible for copyright protection. The constituent elements – two semi-circular ta-

> pered bands, or crescents – are not individually subject to copyright protection. The Copyright Act does not protect common geometric shapes, such as circles or curved lines.
>
> The combination of these unprotectable elements in the Work as a whole does not elevate its creativity beyond the threshold for copyright protection. While designs that combine uncopyrightable elements can by copyrightable if they are creatively combined, the Work does not have that spark of creativity. Here, the Work consists of a simple combination of only two elements—two tapered crescents arranged as mirror images of each other to form a circle—displayed in two different shades of grey with no other shading or color variation. The Work is thus an example of merely bringing together only a few standard forms or shapes with minor linear or spatial variations that does not qualify for copyright protection.

Observe that the Board treats some creative elements, such as "common geometric shapes," as uncopyrightable as a matter of law. One reason is that they are unoriginal; billions of people have already drawn circles and diamonds. Another is that there are very few creative decisions in a geometric shape by iself; only in combination, with variations such as arrangement and color, can the total degree of creativity add up to more than a modicum.

Other elements are also uncopyrightable as a matter of law on the theory that they are insufficiently creative. The Copyright Office lists a few in its regulations:

> Words and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents;[11]

As an example of the short-phrase rule, the ventriloquist Arthur Takeall's slogan "You Got the Right One, Uh-Huh" was held uncopyrightable in a lawsuit against Pepsi for ads in which Ray Charles sang "You Got the Right One, Baby, Uh–Huh."

The title rule is important in keeping one creators from preempting each other by taking all the good titles. For example, Harry Becker's nonfiction book *We Who Are Young* about the 1936 Presidential campaign could not stop the 1940 movie *We Who Are Young*,[12] or for that matter Preti Taneja's 2018 novel *We That Are Young*.

Another rule of *per se* uncopyrightability in the Copyright Office's regulations is "typeface as typeface."[13] This is sometimes defended on creativity grounds – most typeface designs consist of very subtle variations on well-established letter forms – but the more mundane explanation is that printers successfully lobbied for the exclusion because they were afraid of massive copyright liability for unknowingly printing books using later-held-to-be-infringing fonts.The rule can have some

11. 37 C.F.R. § 202.1(a)

Arthur Takeall and his dummy, Scooter

Ray Charles for Pepsi

12. Becker v. Loew's, Inc., 133 F.2d 889 (7th Cir. 1943).
13. 37 C.F.R. § 202.1(e)

surprising consequences, as in the Board's rejection of the Cyberpunk 2077 logo, which it described as "unprotectable typeface with text effects" that "suggest science fiction or futuristic aesthetics commonly used in typeface design."

Cyberpunk 2077 logo

Arrows Problem

Is this logo (for a professional sports team) sufficiently creative to be copyrightable?

Arrows logo

c Compilations

Copyrightable subject matter includes "compilations," which are "formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship."[14] These preexisting materials are not original, so they are not copyrightable by the compiler. But the compilation as a whole may be copyrightable on the basis of its selection and arrangement.

Feist is also a compilation case, because Rural's strongest argument for copyrightability was how it selected and arranged the listings into its directory. This is a valid form of argument, *if* there is originality in the compiler's choices. The resulting copyright is sometimes said to be ***thin***:

> Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement.[15]

But Rural's directory fell into the ' narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent."[16]

> Rural's selection of listings could not be more obvious: It publishes the most basic information – name, town, and telephone number – about each person who applies to it for telephone service. This is "selection" of a sort, but it lacks the modicum of creativity necessary to transform mere selection into copyrightable expression. Rural expended sufficient effort to make the white pages directory useful, but insufficient creativity to make it original.
>
> We note in passing that the selection featured in Rural's white pages may also fail the originality requirement for another reason. Feist points out that Rural did not truly "select" to publish the names and telephone numbers of its subscribers; rather, it was required to do so by the Kansas Corporation Commission as part of its monopoly franchise. Accordingly, one could plausibly conclude that this selection was dictated by state law, not by Rural.

14. 17 U.S.C. § 101.

15. *Feist*, 499 U.S. at 349.

16. *Id.* at 359.

> Nor can Rural claim originality in its coordination and arrangement of facts. The white pages do nothing more than list Rural's subscribers in alphabetical order. This arrangement may, technically speaking, owe its origin to Rural; no one disputes that Rural undertook the task of alphabetizing the names itself. But there is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course. It is not only unoriginal, it is practically inevitable. This time-honored tradition does not possess the minimal creative spark required by the Copyright Act and the Constitution.[17]

17. *Id.* at 362–63.

d Categories of Copyrightable Works

Section 102(a) also lists eight categories of copyrightable works. The categories are important, since details of copyright turn on them. But they are *nonexclusive*. In theory, a work can be copyrightable without fitting into one of them. I say "in theory" because it is vanishingly uncommon in practice; essentially every work someone cares enough about to claim copyright in can fit within one of the eight categories. It is useful to go over the categories briefly:

1. ***Literary*** works are expressed in words or other symbols. They include books, newspaper articles, and other traditionally written or printed media. They also include ebooks and online articles; the definition is medium-neutral. A little more surprisingly, they also include computer software, which is classified as a literary work because the source code written by programmers is symbolic.
2. ***Musical*** works are songs ("including any accompanying music") and instrumental compositions. Note that this definition protects only the sheet music or other record of the composition istelf, not any particular performance or recording of a performance.
3. ***Dramatic*** works are plays, screenplays, and other scripts. They are defined as "including any accompanying music," so operas, rock operas, and Broadway musicals are included here. Again, this category covers only the script, not any particular performance or recording of a performance.
4. ***Choreographic*** works are instructions for a dance (think Alvin Ailey or the New York City Ballet). Again, what is protected is the instructions, not a performance or recording. ***Pantomimes*** are the obscurest subccategory. Perhaps the mimes are all too busy being stuck in invisible boxes to sue each other.
5. ***Pictorial, graphic, and sculptural*** or PGS works are the visual arts, e.g., photographs, paintings, and statutes.
6. ***Audiovisual*** works consist of "a series of related images which are intrinsically intended to be shown by the use of machines . . . to-

gether with any related sounds."[18]

7. ***Sound recordings*** are the result of fixing sounds so that they can be later replayed. Recorded versions of songs are the obvious example, but audiobooks and secret surveillance tapes are are also sound recordings.
8. ***Architectural works*** are the designs of buildings. They can be embodied in architectural plans (a/k/a blueprints) or in buildings as actually constructed.

2 Aesthetic Nondiscrimination

Does copyright require anything besides originality? Put differently, are there works that possess a modicum of creativity but are nevertheless uncopyrightable because they are the wrong kind of creativity? *Bleistein v. Donaldson Lithographing Co.*, Justice Holmes's copyright masterpiece, answered this question with a definitive "no."[19]

The Courier Lithographing Company produced three large color posters, or "chromolithographs," to be used as advertisements for Benjamin Wallace's traveling circus. Later, the Donaldson Lithographing Company reproduced the posters in smaller black-and-white versions, as advertisements for the same circus.

The copyright statute at the time protected only defined categories of works, one of which was "pictorial illustrations or works connected with the fine arts," so when sued, Donaldson defended by arguing that the the posters were not copyrightable. Thus, in a narrow sense, Justice Holmes opinion was addressed to the no-longer-relevant-today doctrinal point of explaining why circus posters were "pictorial illustrations or works connected with the fine arts." But his language and reasoning made a broader argument that copyright is not just for "fine" art, or even just for good art. Copyright protects *all* creative works, regardless of their artistic merit. This rule, which has become known as the **Bleistein** ***non-discrimination principle***, is now a central precept of U.S. copyright law.

> It is obvious also that the plaintiffs' case is not affected by the fact, if it be one, that the pictures represent actual groups – visible things. They seem from the testimony to have been composed from hints or description, not from sight of a performance. But even if they had been drawn from the life, that fact would not deprive them of protection. The opposite proposition would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. Others are free to copy the original. They are not free to copy the copy. . . .
>
> If there is a restriction it is not to be found in the limited pretensions of these particular works. The least pretentious picture has more originality in it than directories and the like, which may be copyrighted.

18. 17 U.S.C. § 101. The definition in terms of discrete images is unfortunate; it would seem to exclude any audiovisual display produced by continuous motion, rather than in discrete frames like a film or digital video.

19. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903).

Wallace circus poster.

> . . . The word "illustrations" does not mean that they must illustrate the text of a book, and that the etchings of Rembrandt or Steinla's engraving of the Madonna di San Sisto could not be protected to-day if any man were able to produce them. Again, the act however construed, does not mean that ordinary posters are not good enough to be considered within its scope. The antithesis to "illustrations or works connected with the fine arts" is not works of tittle merit or of humble degree, or illustrations addressed to the less educated classes; it is "prints or labels designed to be used for any other articles of manufacture." Certainly works are not the less connected with the fine arts because their pictorial quality attracts the crowd and therefore gives them a real use – if use means to increase trade and to help to make money. A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement. And if pictures may be used to advertise soap, or the theatre, or monthly magazines, as they are, they may be used to advertise a circus. Of course, the ballet is as legitimate a subject for illustration as any other. A rule cannot be laid down that would excommunicate the paintings of Degas.[20]

20. *Id.* at 249–51.

There are at least five different variations on the principle here. Copyright does not discriminate against works on the basis of (1) incorporating reality ("drawn from the life"), (2) subject ("the ballet"), (3) quality ("works of little merit or humble degree"), (4) audience ("addressed to the less educated classes") or (5) use ('used to advertise soap"). Why not? Because of romantic authorship:

> The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.[21]

21. *Id.* at 250.

According to Holmes, it is this individual creativity – which every person possesses, regardless of their profession or station in life – that copyright protects.

As a doctrinal matter, the *Bleistein* non-discrimination principle is a rule only about subject matter. But Holmes went on:

> It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or

> the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value – it would be bold to say that they have not an aesthetic and educational value – and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be our hopes for a change.[22]

22. *Id.* at 251–52.

If this sounds familiar, it should. In his celebrated defense of what would be called the "marketplace of ideas" theory of free speech in his dissent in *Abrams v. United States*, Holmes wrote:

> The ultimate good desired is better reached by free trade in ideas. The best test of truth is the power of the thought to get itself accepted in the competition of the market.[23]

23. Abrams v. United States, 250 U.S. 616, 630 (1919).

Holmes's ringing language about the "dangerous undertaking" seems to suggest that law should not make *any* aesthetic judgments, because judges must be neutral among competing speech. This broader view is tempting but untenable. Brian Soucek explains:

> Aesthetic judgments are far more common, and in more areas of law, than is generally acknowledged. These aesthetic judgments include an endless stream of first-order, "retail" decisions about whether particular objects count as works of art or as aesthetically valuable. These are the kind of decisions made by the IRS every time it assesses the value of a donated or inherited artwork; by courts when they decide whether a work has serious enough artistic value to escape an obscenity charge; by customs officials when they decide whether a certain piece of metal is a sculpture; by the National Endowment for the Arts when it chooses what projects to fund; and by municipal historic preservation committees when they decide whether proposed renovations will disrupt the character of a neighborhood.[24]

24. Brian Soucek, *Aesthetic Judgments in Law*, 69 Ala. L. Rev. 381, 383 (2017).

Copyrightable subject matter is probably the place that the copyright system comes closest to Holmes's vision of aesthetic non-discrimination. One application of the *Bleistein* principle is that courts will not consider whether the ideas expressed in a a work are true or false. In *Belcher v. Tarbox*, for example, the defendant tried to argue that the plaintiff's guides to betting on horse races were uncopyrightable because they "fraudulently represented to the public that users of the system described could beat the horses."[25] No dice, said the court:

> There is nothing in the Copyright Act to suggest that the courts are to pass upon the truth or falsity, the soundness or unsoundness, of the views embodied in a copyrighted work. The gravity and immensity of the problems, theo-

25. Belcher v. Tarbox, 486 F.2d 1087, 1077 (9th Cir. 1973).

> logical, philosophical, economic and scientific, that would confront a court if this view were adopted are staggering to contemplate. It is surely not a task lightly to be assumed, and we decline the invitation to assume it.[26]

26. *Id.* at 1088.

This may be the case at the copyrightable subject-matter stage, but courts are compelled to pass on "truth or falsity . . . of the views embodied in a . . . work" all the time. They do it in fraud cases; they do it in defamation cases. Even within IP, we will see, false-advertising cases pose inescapable questions of what is true and what is not. The Holmesian discomfort with judicial competence to ascertain truth cannot be indulged too far in a judicial system that is committed to resolving disputed questions of fact, as it must every time the plaintiff says "You hit me" and the defendant says, "No, I didn't!"

Another application of aesthetic non-discrimination is that illegal content is still copyrightable. In *Mitchell Bros. Film Group v. Cinema Adult Theater*, for example, the plaintiffs sued movie theaters that showed the film *Behind the Green Door* without permission. The defendants argued without success that the film was uncopyrightable because it was prohibited by laws against obscenity. The Fifth Circuit held that this defense was *not even relevant*, because even if it was illegal to distribute or exhibit (thus making both the plaintiffs and defendants federal felons), it would still be copyrightable. It explained:

> Society's view of what is moral and immoral continually changes. To give one example, in *Martinetti v. Maguire*, the play "The Black Crook," because it featured women clad in flesh-colored tights, was held to be "grossly indecent, and calculated to corrupt the morals of the people" and hence uncopyrightable. By the early part of this century, it had become clear that this judgment reflected the moral standards of a bygone era.
>
> Denying copyright protection to works adjudged obscene by the standards of one era would frequently result in lack of copyright protection (and thus lack of financial incentive to create) for works that later generations might consider to be not only non-obscene but even of great literary merit. Many works that are today held in high regard have been adjudged obscene in previous eras. English courts of the nineteenth century found the works of Byron, Southey and Shelley to be immoral. American courts have found these books, among others, obscene: Edmund Wilson, Memories of Hecate County; Henry Miller, Tropic of Cancer and Tropic of Capricorn; Erskine Caldwell, God's Little Acre; Lillian Smith, Strange Fruit; D. H. Lawrence, Lady Chatterly's Lover; Theodore Dreiser, An American Tragedy.[27]

27. Mitchell Bros. Film Grp. v. Cinema Adult Theater, 604 F.2d 852, 856–58 (5th Cir. 1979). Ann Bartow has a dissenting view: "Copyright law is even more pornography-friendly than the First Amendment. The First Amendment will only protect pornography if it is not obscene or illegal for other reasons; for example, if it contains depictions of children. Copyright law offers protections to pornography no matter what material it contains. The First Amendment merely prevents the government from interfering in the creation, distribution and consumption of pornography that is not obscene or otherwise illegal. With the current practice of indiscriminately according pornographic works copyright protection, the government encourages and incentivizes the production of pornography that is non-progressive and non-useful and therefore beyond the scope of the Intellectual Property Clause of the U.S. Constitution. This must cease." Ann Bartow, *Copyright Law and Pornography*, 91 Or. L. Rev. 1 (2012).

Thus, as in *Juicy Whip, Inc. v. Orange Bang, Inc.* for patents, copyright law

does not consider the morality or immorality, the legality or illegality, of its subject matter.

The *Bleistein* principle has the effect of focusing the copyrightability analysis on formal features of the work itself. It makes irrelevant many factors having to with the author's thoughts, the creative process, and the effects on the audience. Only the work *qua* work matters. The Compendium has a long and illuminating list of applications of this focusing principle:

> As a general rule, the Copyright Office will not consider factors that have no bearing on whether the originality requirement has been met. The fact that a work may be novel, distinctive, innovative, or even unique is irrelevant to this analysis. The Copyright Office does not consider the aesthetic value, artistic merit, or intrinsic quality of a work. For example, the Office will not look for any particular style of creative expression. Likewise, the Office will not consider whether a work is visually appealling or written in elegant prose. For the same reasons, the Office will not consider the truth or falsity of the facts set forth in a work of authorship. Nor will the Office consider the soundness of the views expressed in the work.
>
> The Office will focus only on the actual appearance or sound of the work that has been submitted for registration, but will not consider any meaning or significance that the work may evoke. The Office will not consider the author's inspiration for the work, creative intent, or intended meaning. The U.S. Copyright Office will not consider the author's creative skill and experience, because the author's personal or professional history is irrelevant to the determination of copyrightability.
>
> The Office will not consider the amount of time, effort, or expense required to create the work. As a general rule, the Office will not consider possible design alternatives that the author may have considered when he or she created the work. Likewise, the Office will not consider potential variations in the use of the work, such as the fact that the work could be presented in a different color, in a different size, or with a different orientation. As a general rule, the materials used to create a work have no bearing on the originality analysis. For example, the U.S. Copyright Office will not consider the fact that a jewelry design was constructed with precious metals or gemstones, or the fact that a silk screen was printed on a particular paper stock. The U.S. Copyright Office will not consider the marketability or commercial success of the work, because these issues are irrelevant to the originality analysis.[28]

28. Compendium, *supra* note 1, § 310.

Three T-rex T-shirts

3 Idea and Expression

There is an important limit on copyrightability in section 102(b) of the Copyright Act:

> In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.[29]

29. 17 U.S.C. § 102(b).

The usual hornbook statement of this rule is that "ideas" are not copyrightable, only an author's individual "expression" of those ideas. This exclusion is distinct from originality. A work might have been independently created and display a modicum of creativity, and yet still be an uncopyrightable idea. Or even when a work is original and protected, not *all* of it will be protected. The ideas in the work – as opposed to their particular expression – will remain free for anyone to copy.

But what qualifies as an "idea" rather than "expression" can only be learned by seeing what courts treat as one.[30] Sometimes "idea" refers to the *general creative concept* for a work, as distinguished from its more specific details. Sometimes "idea" is used as a synecdoche for other § 102(b) exclusions – "procedure, process, system, method of operation" – that describe *functional* matter in a work. In addition, two closely related doctrines – merger and *scènes à faire* – help implement these exclusions.

30. "Obviously, no principle can be stated as to when an imitator has gone beyond copying the 'idea,' and has borrowed its 'expression.' Decisions must therefore inevitably be *ad hoc*." Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2nd Cir. 1960) (Learned Hand, J.).

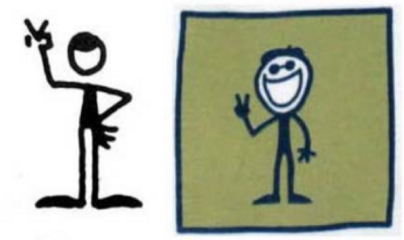
a Ideas

Some of the terms in secton 102(b) – idea, concept, principle, and discovery – describe the contents of a work at a higher level of abstraction than the specific words, musical notes, or dabs of paint. Consider the three designs in Figure 4.9 for a T-shirt featuring comically small *Tyrannosaurus rex* arms. They are all sufficiently creative to be copyrightable. If someone copied one of these designs without permission by making more T-shirts, the copyright owner in the copied design could sue successfully. But none of the three shirts would infringe on any of the others, even though they all depict short T-rex arms. The idea of a T-shirt depicting T-rex arms is just that: an uncopyrightable idea. Only the expression of that idea in a specific T-shirt design is copyrightable.

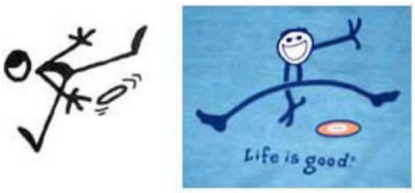
Blehm v. Jacobs offers a more in-depth example of the idea/expression dichotomy in action. Gary Blehm, an artist, started drawing figures he called Penmen in the 1980s. They had round heads, four fingers, large feet, and long, gently curved limbs. He sold posters of the Penmen nationally, and published a syndicated Penmen comic strip. In 2009, he sued Albert and John Jacbos and their company for copyright infringement for their Life Is Good images of Jake, a figure with a round head, four fingers, large feet, and long, gently curved limbs. Jake has appeared on T-shirts, hats, thermos bottles, wall art, cornhole boards, beverage buckets, and much much more.

The similarities between Penmen and Jake were undeniable. For example, image of a Penman flashing a peace sign and catching a frisbee between its legs have quite similar poses to images of Jake doing the same. But there was no infringement, the court held, because all of these similarities consisted of ideas, rather than expression:

> Mr. Blehm has no copyright over the idea of a cartoon figure holding a birthday cake, catching a Frisbee, skateboarding, or engaging in various other everyday activities. Nor can the Jake images infringe on the Penmen because the figures share the idea of using common anatomical features such as arms, legs, faces, and fingers, which are not protectable elements. Mr. Blehm's copyright also does not protect Penmen poses that are attributable to an associated activity, such as reclining while taking a bath or lounging in an inner tube. These everyday activities, common anatomical features, and natural poses are ideas that belong to the public domain; Mr. Blehm does not own these elements.[31]



Peace sign images



Frisbee images

31. Blehm v. Jacobs, 702 F. 3d 1193, 1204 (10th Cir. 2012).

Other aspects of the Penmen were protectable:

> The Penmen at first glance might be considered simple stick figures, but they are more nuanced than a child's rudimentary doodling. For example, the prototypical Penman has a rounded, half-moon smile that takes up a substantial portion of the face. Mr. Blehm has chosen to omit any other facial features on the Penmen. Each figure is filled in black, except for the white half-moon smile, and each Penman's head is detached, hovering above the body. Many of the Penmen stand facing the viewer, flashing the half-moon smile.[32]

32. *Id.*

The key to the case was that the similarities between Jake and the Penmen consisted almost entirely of aspects of the Penmen that the court classified as unprotectable ideas, rather than as protectable expression. Here is a sample of the reasoning:

> Mr. Blehm urges us to find certain similarities between the images. He notes that both have round heads. But Mr. Blehm has no copyright protection in general human features. Further, the figures' heads are not similarly round.

> Jake's head is more oval and somewhat misshapen, whereas the Penman's head is circular and uniform.
>
> Mr. Blehm suggests that the figures have similar proportions, such as the size of the figures' heads, arms, legs, and feet compared with their bodies. A close review of the figures, however, yields the opposite conclusion. Jake's head is very large compared with the body, while the Penman's head is relatively proportional. The Penman's arms and legs are long and disproportionate to its truncated torso. Jake, on the other hand, has more proportional limbs compared with his torso. The figures' feet are distinctly different: the Penman's are thick, long, and roll-shaped, but Jake's are shorter and triangular.
>
> Nevertheless, there are some similarities between the Penman and Jake. Both have black-line bodies, four fingers, and large half-moon smiles, and their feet are pointed outward. But even these similarities have important differences, or are not protectable expression. For example, Jake's fingers appear stubbier. The choice to display the figures' feet outward also naturally flows from the common idea of drawing a two-dimensional stick figure and is thus unprotected.[33]

33. *Id.* at 1206.

Do not mistake this for originality reasoning. Even if Blehm was the first person to draw a stick figure, he could not thereby use copyright to control all stick figures. Idea/expression operates a bit like a tax off the top. In every creative work, the ideas (even if wholly original) are free for all to use; only the particular expression of them in the work is subject to copyright. As Learned Hand explained in a canonical copyright case, *Nichols v. Universal Pictures Corp.*:

> Even . . . granting that the plaintiff's play was wholly original . . . there is no monopoly in such a background. Though the plaintiff discovered the vein, she could not keep it to herself; so defined, the theme was too generalized an abstraction from what she wrote. It was only a part of her "ideas." . . .
>
> If Twelfth Night were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's "ideas" in the play, as little capable of monopoly as Einstein's Doctrine of Relativity, or Darwin's theory of the Origin of Species. It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.[34]

34. Nichols v. Universal Pictures Corp., 45 F.2d 119, 121–22 (2d Cir. 1930).

b Scènes à Faire

A related doctrine is ***scènes à faire***.[35] These are elements of a work that are standard or even inevitable in a particular genre. In a Western, for example, a duel on the streets of a deserted town is a *scène à faire*.[36] They are treated as uncopyrightable. One theory why is that they are fundamentally unoriginal; an author who incorporates one has not come up with anything new. Another theory is that they are part and parcel of the "idea" of a genre. Once *Groundhog Day* established the conventional rules for a time-loop movie, other films were free to reuse the trope of an establishing shot for the start of each repeated day while the same song plays on the soundtrack. And a third is that they are so common within a genre that other works in that genre will share them by pure coincidence, so that the likelihood of their being copied from the plaintiff's work in particular is low. Whatever the reason, they are uncopyrightable.

As an example, in *Walker v. Time Life Films, Inc.*, Tom Walker published a nonfiction book, *Fort Apache*, about his experiences working as a police officer in New York's 41st precinct in the Bronx in the 1970s. He alleged that the 1981 film *Fort Apache* infringed on his book. The court found that all of the similarities between the two consisted of *scènes à faire*:[37]

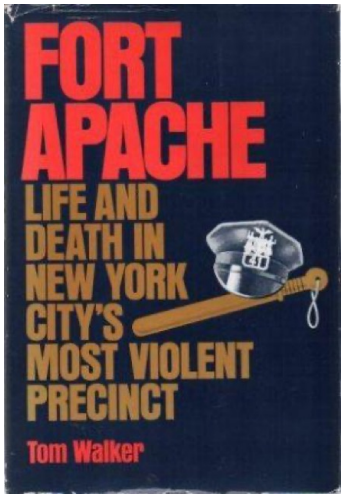
> For example, appellant notes that both the book and the film depict cockfights, drunks, stripped cars, prostitutes and rats; both feature as central characters third- or fourth-generation Irish policemen who live in Queens and frequently drink; both show disgruntled, demoralized police officers and unsuccessful foot chases of fleeing criminals.
>
> These similarities, however, relate to uncopyrightable material. Elements such as drunks, prostitutes, vermin and derelict cars would appear in any realistic work about the work of policemen in the South Bronx. These similarities therefore are unprotectible as "scènes à faire," that is, scenes that necessarily result from the choice of a setting or situation. Neither does copyright protection extend to copyright or "stock" themes commonly linked to a particular genre. Foot chases and the morale problems of policemen, not to mention the familiar figure of the Irish cop, are venerable and often-recurring themes of police fiction. As such, they are not copyrightable except to the extent they are given unique – and therefore protectible – expression in an original creation.

c Processes

A different kind of rationale underlies the exclusion of procedures, processes, systems, and methods of operation. These categories (which I will collectively call "processes" for short) are *functional*. They do some-

35. French for "scenes that must be done."

36. Spend half an hour browsing through TV Tropes. What fraction of entries there are *scène à faire*?



The plaintiff's book, *Fort Apache: Life and Death in New York City's Most Violent Precinct*

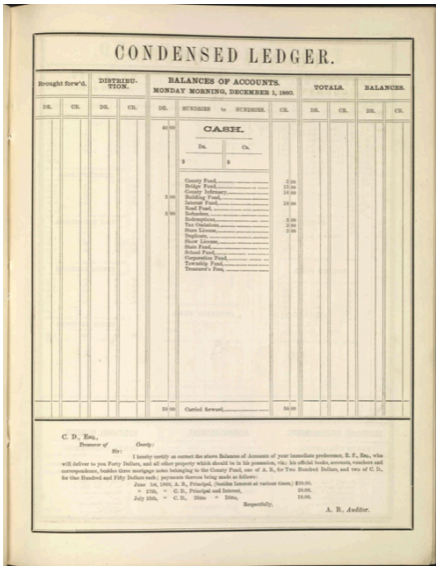
Still from the defendant's film, *Fort Apache, The Bronx*

37. Walker v. Time Life Films, Inc., 784 F.2d 44, 50 (2d Cir. 1986).

thing in the world. Let us try to understand what that "something" is and how it differs from what traditionally *expressive* works do.

The leading case here is *Baker v. Selden*.[38] In 1859, Charles Selden published a book, creatively titled "Selden's Condensed Ledger," describing a method of accounting. In standard double-entry bookkeeping, each transaction is entered in a "journal" as it occurs. To extract information of interest, such as the current cash balance at the end of each day, an accountant must calculate them by working through all of the relevant transactions in the journal, writing down the results in a "ledger." Selden's ledger arranged the columns in a way that made it easier to extract running totals, or totals for a day, month, or other period. His book contained an introductory essay explaining and extolling the system, sample forms showing sample calculations, and blank forms that accountants could use to write down their organization's transactions. His business model was to convince businesses and governments to use his bookkeeping system and sell them the necessary blank forms. Enter Baker, who sold his own books of blank forms for this system of bookkeeping, albeit with a slightly different arrangement of columns. Selden's heir sued.

38. Baker v. Selden, 101 U.S. 99 (1880).


CONDENSED LEDGER.

Selden's Condensed Ledger

Baker held that while the introductory essay *describing* Selden's system of bookkeeping was copyrightable, the system *itself* was an uncopyrightable process.

> A treatise on the composition and use of medicines, be they old or new; on the construction and use of ploughs, or watches, or churns; or on the mixture and application of colors for painting or dyeing; or on the mode of drawing lines to produce the effect of perspective, – would be the subject of copyright; but no one would contend that the copyright of the treatise would give the exclusive right to the art or manufacture described therein.[39]

39. *Id.* at 102.

Why? One reason is that these methods are ***functional***: they have useful results. Protecting that utility is patent's job, and patent has its own standards of novelty, nonobviousness, etc. If patent *refuses* protection, it has good reason to, and copyright should not blindly charge into the gap, because it would undermine important goals of the patent system by doing so.[40] Similarly, patents have much shorter terms; by offering extended protection, copyright could undo the patent bargain of disclosure for limited-time exclusive rights. *Baker* makes this point explicitly:[41]

40. Selden did apply for a patent on his system, and was refused; it was a business method, as in *Bilski v. Kappos*. Does this change how you think about the copyright question?

41. *Baker*, 101 U.S. at 103–04.

> To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters-patent, not of copyright. The claim to an invention or discovery of an art or manufacture must be subjected to the examination of the Patent Office before an exclusive right therein can be

> obtained; and it can only be secured by a patent from the government.

Another reason is more conceptual. Copyright is *not good* at understanding functionality. It is good at aesthetics – or as good as any judicially administered system can be, *Bleistein* notwithstanding. But copyright's doctrines, which are based on holistic lay comparisons, are not well suited to teasing out the technical details on which comparisons of functional works depend. To do that work, copyright would need something more like claims describing how the process works, which would start it down the road to turning into patent. So if we want a copyright system that works the way our current copyright system mostly does, it will need to steer clear of functional subject matter.

Thus, *Baker* distinguishes between functional and expressive works:

> Of course, these observations are not intended to apply to ornamental designs, or pictorial illustrations addressed to the taste. Of these it may be said, that their form is their essence, and their object, the production of pleasure in their contemplation. This is their final end. . . . On the other hand, the teachings of science and the rules and methods of useful art have their final end in application and use; and this application and use are what the public derive from the publication of a book which teaches them.[42]

42. *Id.* at 102–04.

Selden's copyright in the essay extended only to his specific choice of words, not to the idea of an essay describing the system:

> Where the truths of a science or the methods of an art are the common property of the whole world, any author has the right to express the one, or explain and use the other, in his own way. . . .
>
> The copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds, or to the diagrams which he employs to explain them, so as to prevent an engineer from using them whenever occasion requires. The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book. . . .
>
> The use by another of the same methods of statement, whether in words or illustrations, in a book published for teaching the art, would undoubtedly be an infringement of the copyright.[43]

43. *Id.* at 100–01.

Baker remains valid and mostly unquestioned today; its holding is one of the defining principles of modern United States copyright law.

d Merger

The policy reasons underlying the exclusion of ideas are so important that they also prevent a copyright in any expression that is necessary to express the idea. In *Baker*, Baker also copied Selden's blank forms. The Supreme Court held that this too was allowed, because Selden's blank forms were uncopyrightable under the doctrine now known as ***merger***:

> [I]t is contended that the ruled lines and headings, given to illustrate the system, are a part of the book, and, as such, are secured by the copyright; and that no one can make or use similar ruled lines and headings, or ruled lines and headings made and arranged on substantially the same system, without violating the copyright. . . .
>
> And where the art it teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public; not given for the purpose of publication in other works explanatory of the art, but for the purpose of practical application. . . .
>
> And, of course, in using the art, the ruled lines and headings of accounts must necessarily be used as incident to it.[44]

That is, because anyone practicing Selden's bookkeeping system would necessarily have to use blank forms like Selden's, anyone was free to use blank forms like Selden's.

An alternative way of putting the merger doctrine is that when there are only a "limited number" of ways to express an idea, idea and expression are inseparable and both are uncopyrightable. For example, in *Morrissey v. Proctor & Gamble Co.*, there were only a few ways to express the rules for a sweepstakes. As the court put it in *Morrissey*:[45]

> When the uncopyrightable subject matter is very narrow, so that the topic necessarily requires, if not only one form of expression, at best only a limited number, to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance. . . . We cannot recognize copyright as a game of chess in which the public can be checkmated.

And even when idea and expression are separable, merger can still limit the scope of copyright, because " a copyright holder must then prove substantial similarity to those few aspects of the work that are expression not required by the idea."[46] Thus, for example, in *Herbert Rosenthal Jewelry Corp. v. Kalpakian*,[47] there were only a few ways to express the idea of a jeweled bee pin.[48] "There is no greater similarity between the pins of plaintiff and defendants than is inevitable from the use of jewel-encrusted bee forms in both."[49] A more exact replica might still potentially infringe.

44. *Id.* at 101, 103, 104.
45. Morrissey v. Proctor & Gamble Co., 379 F.2d 675, 678–79 (1st Cir. 1967).
46. Concrete Mach. Co. v. Classic Lawn Ornaments, 843 F.2d 600, 607 (1st Cir. 1988).
47. Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738 (9th Cir. 1971).
48. *Id.*

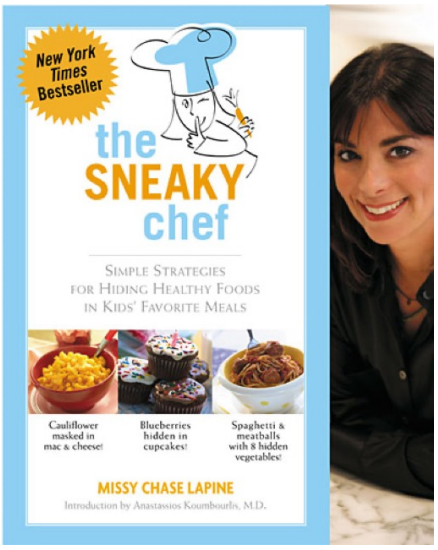
Plaintiff's jeweled bee pins

Defendant's's jeweled bee pins

49. *Id.* at 742.

Cooking for Kids Problem

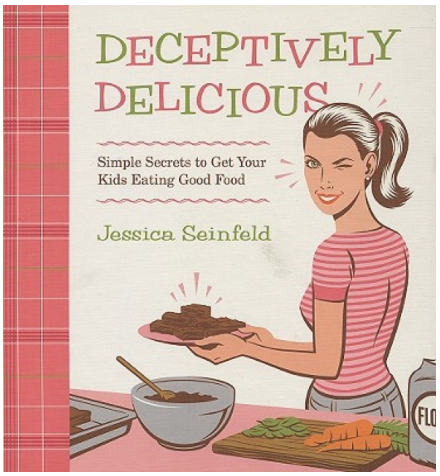
Missy Lapine is the author of *The Sneaky Chef: Simple Strategies for Hiding Healthy Foods in Kids' Favorite Meals* (published 2007), which "presents over 75 recipes that ingeniously disguise the most important superfoods inside kids' favorite meals." Jessica Seinfeld is the author of *Deceptively Delicious: Simple Secrets to Get Your Kids Eating Good Food* (published 2008), which "is filled with traditional recipes that kids love, except they're stealthily packed with veggies hidden in them so kids don't even know!" Seinfeld claims that she was unaware of Lapine's book when she wrote *Deceptively Delicious*. Infringement?



The Sneaky Chef

Hula Problem

Consider this photograph (*Makanani*, photographed by Kim Taylor Reece) and stained glass image sideimage (*Nohe*, by Marylee Colucci) of hula dancers. The dancers' pose (kneeling, with right arm extended, etc.) is traditional. So is their dress (including the lei, etc.). Colucci concedes that she used *Makanani* as a reference when creating *Nohe*. Infringement?



Deceptively Delicious

B Ownership

Patent requires absolute novelty. Copyright does not. An author can obtain a copyright in a work even if someone else got there before them. All that copyright requires is *independent* creation: not copying from someone else. As Learned Hand put it:

> Borrowed the work must indeed not be, for a plagiarist is not himself pro tanto an "author"; but if by some magic a man who had never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an "author," and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's.[50]

Because of this rule permitting multiple independent creation, copyright (like trade secret) does not need complicated priority doctrines, as patent and trademark do.[51]

Two kinds of issues about initial copyright ownership do arise with some regularity. First, there is the problem of whether certain kinds of allegedly "creative" processes should be regarded as resulting in copyrightable authorship at all. Second, there is the problem of dividing up ownership among multiple parties who do contribute authorship. Copyright slices this problem up along two dimensions: contemporaneous collaborations are addressed as joint works or works made for hire, whereas sequential creation is analyzed in terms of derivative works.

1 Authorship

Another famous 19th-century case, *Burrow-Giles Lithographic Co. v. Sarony*, provides the modern rule on who can be considered an author for copyright purposes.[52] The case involved a widely-copied photograph of the Irish author Oscar Wilde by the celebrity photographer Napoleon Sarony. The defendant argued that a photograph was a "reproduction on paper of the exact features of some natural object or of some person" and thus not an original work of authorship.

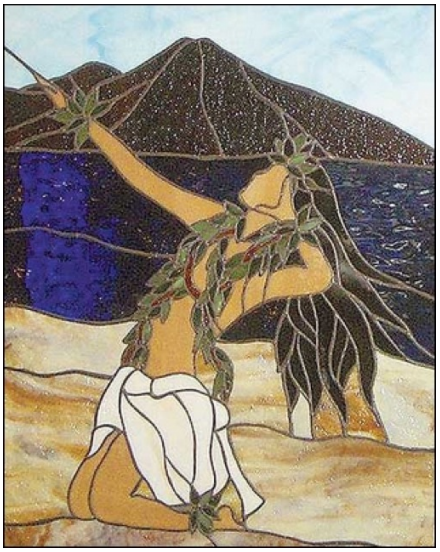
The Supreme Court disagreed. Quoting from a contemporary dictionary, it explained that an author was "he to whom anything owes its origin; originator; maker; one who completes a work of science or literature" and that the copyrightable "writings" of an author could include "all forms of writing, printing, engraving, etching, &c., by which the ideas in the mind of the author are given visible expression."[53] So there was no constitutional obstacle to granting copyrights in works in a medium or genre that did not exist when the IP Clause was adopted as part of the Constitution.

That left a narrower issue – is there any creativity in a photograph? Again, the Court said yes:

> But it is said that an engraving, a painting, a print, does embody the intellectual conception of its author, in which there is novelty, invention, originality . . . while the photograph is the mere mechanical reproduction of the physical features or outlines of some object animate or inanimate, and involves no originality of thought or any novelty in the intellectual operation connected with its visible reproduction in shape of a picture.
>
> [The trial court's findings of fact said that the photograph was a] useful, new, harmonious, characteristic, and graceful picture, and that plaintiff made the same ... entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff, he produced the picture in suit.
>
> These findings, we think, show this photograph to be an original work of art, the product of plaintiff's intellectual invention, of which plaintiff is the author . . . .[54]

Notice the focus on Sarony's *creative choices* that are *reflected in the work*. An author, for copyright purposes, translates a creative idea into physical expression. This is what distinguishes Sarony from Oscar Wilde, the subject of the photograph. Oscar Wilde's facial features are distinc-

Kim Taylor Reece, *Makanani*



Marylee Colucci, *Nohe*

tive, but they are not the product of an act of authorship. Similarly, it distinguishes Sarony from his assistant, Benjamin Richardson, who actually operated the camera. Sarony's "mental conception" was the one reflected in the photograph.

Authorship need not be conscious. *Alfred Bell v. Catalda Fine Arts* held that the distinguishable results of "bad eyesight or defective musculature" are still copyrightable.[55] In a footnote, the court added, "Plutarch tells this story: A painter, enraged because he could not depict the foam that filled a horse's mouth from champing at the bit, threw a sponge at his painting; the sponge splashed against the wall – and achieved the desired result."[56] But the creation process does at least need to be causal. If I find an attractive piece of driftwood on the shore, I can't copyright it.

There is an important exception from authorship on the basis of the identity of the author: ***government works***. On a romantic-author vision, the government has no individual identity that can express itself. On a more utilitarian vision, government does not need copyright's incentives to create. This policy is expressed in two provisions of U.S. copyright law.

The first, in Section 105 of the Copyright Act, says that copyright is not available for "any work of the United States Government."[57] The government can *own* copyrights if it buys them, or it can *license* copyrighted works, but anything created *by* the government is uncopyrightable. In practice, this means anything created by government employees within the scope of their employment. Thus, for example, NASA photographs of deep space are in the public domain from the moment they are taken. Section 105 only applies to the *federal* government. State, local, and foreign governments are free to obtain copyrights in their works. Some states, such as New York and Pennsylvania, do. Others, such as Arizona, do not.

Another rule applies to all levels of government: the law itself (a/k/a ***government edicts***) is not copyrightable. One traditional formulation of the dotrine is that any work with the "force of law" is uncopyrightable. In *Georgia v. Public.Resource.Org, Inc.*, the Supreme Court extended that rule slightly.[58] Georgia attempted to claim copyright in the Official Code of Georgia Annotated. It was assembled by a state agency, including annotations written by Matthew Bender, a private company, under a contract saying that any copyright would vest in the state of Georgia. Public.Resource.Org, a nonprofit dedicated to publishing the law freely online, put the entire OCGA on its website. The Court held that this was permissible because "copyright does not vest in works (1) created by judges and legislators (2) in the course of their judicial and legislative duties."[59]

Similar issues arise when a private organization drafts a model law that is then enacted word-for-word by a government, or a standard (like a building code) that is then incorporated by reference into law. The author-focused test in *Public.Resource.Org* does not resolve them, but under the "force of law" test they become uncopyrightable at the moment

50. Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 54 (2d Cir. 1936) (Hand, J.). Compare: "Pierre Menard did not want to compose *another* Quixote, which surely is easy enough – he wanted to compose *the* Quixote. Nor, surely, need one have to say that his goal was never a mechanical transcription of the original; he had no intention of *copying* it. His admirable ambition was to produce a number of pages which coincided – word for word and line for line – with those of Miguel de Cervantes." Jorge Luis Borges, *Pierre Menard, Author of the* Quixote (1941) (Andrew Hurley trans.).
51. The price paid for simplicity here is that copyright (like trade secret) must include proof of copying *from the plaintiff* as part of its infringement analysis.
52. Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884).

Oscar Wilde No. 18

53. *Id.* at 58.
54. *Id.* at 58, 60.
55. Alfred Bell v. Catalda Fine Arts, 191 F.2d 99, 23 (2d Cir. 1951).
56. *Id.* at 105 n.23. The story is an urban legend of the ancient world; different authors attributed it to different painters and sometimes different animals. The court's version is from Plutarch's "On Chance"; my personal favorite (after far too long researching this) is from Dio Chrysostom's Discourses.
57. 17 U.S.C. § 105.

of adoption.[60]

Monkey Selfie Problem

Nature photographer David Slater was traveling in Indonesia when a monkey picked up his camera and pushed the shutter button, resulting in this photograph. Is it copyrightable? If so, who owns the copyright?

Does it matter whether Slater had chosen his camera's settings (e.g., shutter speed, aperture, autofocus) for taking close-up daytime outdoor wildlife photographs? If he was specifically trying to get monkeys to pick up the camera and take selfies? If he took the photograph himself and then falsely passed it off as a monkey selfie?

2 Collaborations

A work by a single author is owned initially by that author. A work by multiple authors is a ***joint work***, and the authors are coowners.[61] A work made by an employee or certain types specially commisioned work is a ***work made for hire*** and it is owned by the hiring party.[62]

a Joint Works

Property nerds will recognize the rules for the consequences of co-ownership as a tenancy in common. Each co-owner has an "undivided" right to use the work, or to license it to others, as they wish. No co-owner can exclude the others from using the work. However, each co-owner must account to the others for any profits they make from exploiting the work, paying each co-owner their proportionate share. The default is that each co-owner owns an equal share (e.g. four joint authors each take a one-fourth share), but the joint authors can vary that amount with an appropriate written agreement.

A "joint work" is defined as "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole."[63] The first thing to note here is that each co-owner must be an *author*: they must each contribute copyrightable expression to the work. That does not mean they need to have actually taken pen to paper, any more than Napoleon Sarony needed to have been the one to physically operate the camera and develop the print of Oscar Wilde. Instead, as above, they need to have made creative choices that are causally present in the work. For example, in *Gaiman v. McFarlane*, the writer Neil Gaiman wrote a script for Todd McFarlane's *Spawn* comics and created the successful character of Medieval Spawn.[64] That was enough to make him a co-author of *Spawn* No. 9.

The next point here is that the contributions must *merge*. An "inseparable" work is one in which the authors' contributions become indistinguishable, like a Coen Brothers screenplay. An "interdependent" work is one in which the authors' contributions remain recognizable, but have been shaped to fit each other like the the words and music of a song. In both cases, there is a *single* copyright, which is co-owned.

The "Mystic Mountain" within the Carina Nebula, photographed by the Hubble Space Telescope in 2010

58. Georgia v. Pub.Res.Org, Inc., 140 S. Ct. 149 (2020).
59. *Id.* at 1507.
60. *See* Veeck v. S. Bldg. Code Cong. Intern., 293 F. 3d 791 (5th Cir. 2002).

Monkey selfie

61. 17 U.S.C. § 201(a).
62. 17 U.S.C. § 201(b).
63. 17 U.S.C. § 101.

The final and most troublesome requirement is that the joint authors must have the "intention" that their contributions will merge. It seems like this would exclude only a few oddball cases of unintentional collaboration, like two forgetful writers working on the same shared Google Doc who never realize that the other is making changes as well. But the courts have elevated this into something more like a test that each author must intend the legal result that they *be joint authors*, not just the factual result that their contributions merge.

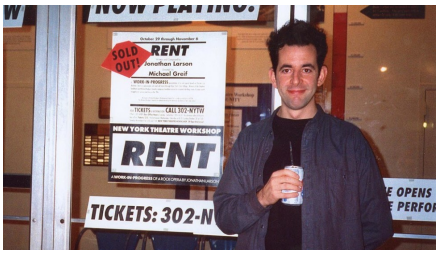
Thomson v. Larson is typical.[65] Jonathan Larson, the composer of *Rent*, famously died of an aortic aneurism hours after its final dress rehearsal in 1996, and never lived to see its spectacular success. He left behind a dispute over the copyright in the musical.[66] *Rent* had been in development and workshops since 1989, and in 1995, with an off-Broadway opening finally in sight, the New York Theatre Workshop hired Lynn Thomson, an NYU professor, to serve as a dramaturg. A dramaturg is the theatrical version of an editor, who contributes whatever a play needs to succeed as a play, including (in Thomson's words)"actual plot elements, dramatic structure, character details, themes, and even specific language."[67] Her contract with NYTW paid her $2,000 and a billing credit as "Dramaturg," and was silent as to copyright. Larson's contract with NYTW listed him as "Author" and gave him approval over all changes to the text. Thomson and Larson worked closely together for months in his apartment, with Larson entering all changes in his computer. The new version – the one that because a smash hit – was described as "a radical transformation of the show."

In holding that Thomson was not a co-author of *Rent*, the Second Circuit cited three factors. First, Larson had sole *decisionmaking authority* over the revisions: he decided which of Thomson's suggestions to incorporate and which to reject. Second, Larson was *credited* as "author" in the scripts and playbill biographies and Thomson was not. And third, their *written agreements with third parties* (here NYTW) treated Larson as author.

This rule embraces a romantic vision of authorship. It recognizes Jonathan Larson as "the" author of *Rent*, downplaying the contributions of Thomson, the producers at NYTW, his former collaborator Billy Aronson, and the many other actors, designers, and theater professionals who helped to shape it. Like the *auteur* theory of filmmaking, which treats a movie as the singular product of a director's creative vision, it excludes others from recognition.

"Medieval Spawn" from *Spawn* No. 9

64. Gaiman v. McFarlane, 360 F.3d 644 (7th Cir. 2004).
65. Thomson v. Larson, 147 F.3d 195 (2d Cir. 1998).



Jonathan Larson (1960 – 1996)

Lynn Thomson

66. *Id.*
67. *Id.* at 197.

Rent Questions

After Jonathan Larson's death but before the Broadway opening of *Rent*, Lynn Thomson sought and received an additional $10,000 from NYTW for her work. In addition, she negotiated with Larson's family over royalties. They offered her a gift of 1% of the author's royalties. She declined. In her suit, she sought a 16% share.

1. Was Thomson's decision to reject the settlement offer and a file suit

a good decision in hindsight?

2. Was it a good decision at the time?
3. If Jonathan Larson had lived, how do you think these negotiations would have gone?
4. Why wasn't copyright ownership addressed in Thomson's contract with NYTW?

b Works Made for Hire

A "work made for hire" is:

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use
- as a contribution to a collective work,
- as a part of a motion picture or other audiovisual work,
- as a translation,
- as a supplementary work,
- as a compilation,
- as an instructional text,
- as a test,
- as answer material for a test, or
- as an atlas,

if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.[68]

68. 17 U.S.C. § 101 (bullet points added).

The "employer or other person for whom the work was prepared" (which we will abbreviate to "hiring party") is considered the author for copyright purposes.[69] This is fictional. GiantHugeCorp did not write the history of the company that appears on its website. It is an artificial entity, with no consciousness or personality of the sort that romantic authorship celebrates. Some employee wrote the blog post, but while that person is an author-in-fact in terms of making creative choices reflected in the work, that person is not the author-in-law recognized by the Copyright Act. GiantHugeCorp is.

69. 17 U.S.C. § 201(b).

It is helpful to think about works made for hire by dividing all copyrightable works into two categories: (1) those made by employees on the job, and (2) those made by everyone else. By default, employee works are owned by the employer; by default works made by anyone else are owned by the creator. Both defaults can be reversed by an appropriate contract. Employers and employees can agree to exclude particular creative tasks from the scope of employment, so that they are not works made for hire and copyright vests initially in the employee. And *for the eight enumerated types of works in the definition*, independently commissioned works can be turned into works made for hire in which copyright vests initially in the hiring party.

Work-made-for-hire status matters for three reasons. First, it affects

initial ownership. This matters primarily as a default, when the parties have not explicitly dealt with copyright ownership.[70] Second, it affects copyright term. Works made for hire have a fixed 95- or 120-year term, rather than one for the life of the author plus 70 years. And third, the authors of works *not* made for hire have a right to terminate their transfers and licenses after thirty-five years, which can be extremely valuable for succssful works.

The leading case on the first (employee) prong of works made for hire is *Community for Creative Non-Violence v. Reid*. The Community for Creative Non-Violence runs a homeless shelter in Washington D.C.[71] In 1985, to dramatize the plight of the homeless, CCNV commissioned Baltimore-based sculptor James Earl Reid to create a Nativity scene in which Jesus, Mary, and Joseph would be homeless figures huddled on a steam grate.

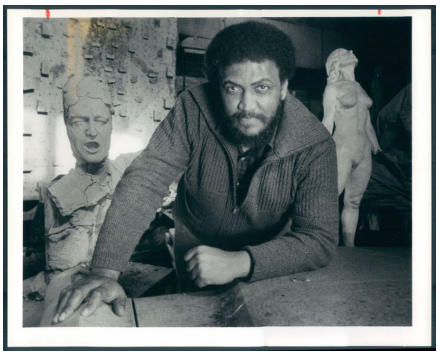
After negotiations, CCNV and Reid agreed that CCNV would pay up to $15,000 for materials and that Reid would donate his services. There was no written agreement and no discussion of copyright. Here is the Supreme Court's description of the creative process:

> After Reid received an advance of $3,000, he made several sketches of figures in various poses. At Snyder's[72] request, Reid sent CCNV a sketch of a proposed sculpture showing the family in a crechelike setting: the mother seated, cradling a baby in her lap; the father standing behind her, bending over her shoulder to touch the baby's foot. Reid testified that Snyder asked for the sketch to use in raising funds for the sculpture. Snyder testified that it was also for his approval. Reid sought a black family to serve as a model for the sculpture. Upon Snyder's suggestion, Reid visited a family living at CCNV's Washington shelter but decided that only their newly born child was a suitable model. While Reid was in Washington, Snyder took him to see homeless people living on the streets. Snyder pointed out that they tended to recline on steam grates, rather than sit or stand, in order to warm their bodies. From that time on, Reid's sketches contained only reclining figures.
>
> Throughout November and the first two weeks of December 1985, Reid worked exclusively on the statue, assisted at various times by a dozen different people who were paid with funds provided in installments by CCNV. On a number of occasions, CCNV members visited Reid to check on his progress and to coordinate CCNV's construction of the base. CCNV rejected Reid's proposal to use suitcases or shopping bags to hold the family's personal belongings, insisting instead on a shopping cart. Reid and CCNV members did not discuss copyright ownership on any of these visits.

Third World America was delivered and displayed during the holidays at the end of 1985, but then the parties had a falling-out. CCNV wanted

70. Copyright ownership *after* creation can always be changed by an assignment in writing, so even a work that is not made for hire can subsequently be transferred to an employer or other party.

71. CCNV acquired its shelter, which is several blocks from the Capitol, by squatting in an abandoned federal building until the federal government agreed to transfer it for use as a permanent shelter.



James Earl Reid (1942 – 2021)

James Earl Reid, *Third World America*

72. Mitch Snyder was an activist and trustee of CCNV.

to take it on tour to raise money for the homeless; Reid objected because he feared it would damage the sculpture. Reid asked CCNV to recast it in bronze (at a cost of $35,000) or to make a master mold ($5,000), but CCNV refused. The parties filed competing copyright registrations, and litigation ensued.

The Supreme Court looked to the "general common law of agency," i.e. employment law. Drawing substantially on the Restatement (Second) of Agency section 220(2), the Court gave a twelve-factor (!) test to determine whether a creator is an "employee" for copyright purposes:

- The skill required.
- The source of the instrumentalities and tools.
- The location of the work.
- The duration of the relationship between the parties.
- Whether the hiring party has the right to assign additional projects to the hired party.
- The extent of the hired party's discretion over when and how long to work.
- The method of payment.
- The hired party's role in hiring and paying assistants.
- Whether the work is part of the regular business of the hiring party.
- Whether the hiring party is in business.
- The provision of employee benefits.
- The tax treatment of the hired party.[73]

73. Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 751–52 (1989) (bullets added).

These factors pointed overwhelmingly to the conclusion that Reid was not an employee:

> True, CCNV members directed enough of Reid's work to ensure that he produced a sculpture that met their specifications. But the extent of control the hiring party exercises over the details of the product is not dispositive. Indeed, all the other circumstances weigh heavily against finding an employment relationship. Reid is a sculptor, a skilled occupation. Reid supplied his own tools. He worked in his own studio in Baltimore, making daily supervision of his activities from Washington practicably impossible. Reid was retained for less than two months, a relatively short period of time. During and after this time, CCNV had no right to assign additional projects to Reid. Apart from the deadline for completing the sculpture, Reid had absolute freedom to decide when and how long to work. CCNV paid Reid $15,000, a sum dependent on completion of a specific job, a method by which independent contractors are often compensated. Reid had total discretion in hiring and paying assistants. Creating sculptures was hardly regular business for CCNV. Indeed,

> CCNV is not a business at all. Finally, CCNV did not pay payroll or Social Security taxes, provide any employee benefits, or contribute to unemployment insurance or workers' compensation funds.[74]

74. *Id.* at 752–53.

Indeed, this is such a clear case it is hard to see how CCNV thought it could have been otherwise. One possibility – which was reflected in the arguments presented to the Court – is the conceptual pull of the *second* work-made-for-hire prong, for specially commissioned works. There is a sense that the entire point of hiring an artist to create a work is to obtain control over the work, i.e. the copyright. Even if CCNV and Reid did not write an agreement to this effect, goes the thought, surely that is what they intended when Reid delivered the sculpture?

If this line of reasoning sounds convincing, you are most likely not a freelance artist. Reid thought he was delivering CCNV *a copy of the work* (a tangible object), not *copyright in the work itself* (an intangible IP right. And the Copyright Act unambiguously agrees with him. Section 202 distinguishes "ownership of a copyright" from "ownership of any material object in which the work is embodied," and then emphasizes the point:

> Transfer of ownership of any material object, including the copy or phonorecord in which the work is first fixed, does not of itself convey any rights in the copyrighted work embodied in the object; nor, in the absence of an agreement, does transfer of ownership of a copyright or of any exclusive rights under a copyright convey property rights in any material object.[75]

75. 17 U.S.C. § 202.

Thus Reid gave up no rights in his copyright by delivering Third World America to CCNV.

Similarly, the Copyright Act could not be clearer that ownership of a non-employee work can neither vest in a hiring party nor be transferred to one without a written agreement. If CCNV wanted to own copyright in Third World America, it needed to *get it in writing*. Reid was perfectly free to assign his copyright to CCNV, but if he did not do so explicitly, copyright ownership remained with him. This aspect of the definition of works made for hire is designed to be author-protective. In short, *Community for Creative Non-Violence* was a case about the employment prong at all only because of the lack of a written agreement on copyright ownership.

In application, the twelve factors are not of equal weight. Generally speaking,a business's willingness to treat workers as employees for tax and benefits purposes is a necessary but not sufficient condition for employee status. Also, do not forget that even if an author is an employee of some business, only works created *within the scope of employment* are works made for hire. As with trade secret and patent, works created on personal time are owned by the author, not the employer.

Turn now to the second prong, for "specially ordered or commis-

sioned" works. The first thing to note here is that only works within the eight listed categories are eligible for work-made-for-hire status. There is no coherent jurisprudential theory for which types of works are eligible; the categories reflect practices in a number of industries and are the result of extensive lobbying. Thus, for example, the inclusion of motion pictures is a recognition of the Hollywood business model, in which ownership of every conceivable right related to a film is concentrated in a single production company and then extensively licensed out. Every person on a production is employed on a work-made-for-hire basis, simplifying copyright ownership and licensing. This and the other categories reflect Congress's unwillingness to disrupt existing practices.

The second thing to note is that the work really must have been created at the behest of the commissioning party. I wrote the solutions manual for a computer-science textbook as a summer job in college. This was a work made for hire because it was a "supplementary work" (to an "instructional text," another work made for hire category). But crucially, I wrote the solutions manual after signing the contract. If I had written up the solutions entirely on my own, and only then approached the publisher, we could not retroactively have classified it as a work made for hire. I could have assigned them the copyright, which would have had very similar practical effect, but it would have remained a sole-authored work even once the publisher owned the copyright.

Third, the written agreement is absolutely essential. A written agreement specifying that Party A will own the copyright may be insufficient, because that agreement might just be an assignment of rights in a work *not* made for hire. For the avoidance of doubt, the agreement should recite (a) that the work falls within the appropriate enumerated category, (b) that the work was in fact specially ordered, and (c) that the work will be treated as a work made for hire. When these are not clear, litigation can ensue. In *Warren v. Fox Family Worldwide, Inc.*, for example, Richard Warren wrote the music for the TV series *Remington Steele*.[76] Each episode was an audiovisual work, and he worked under written contracts with the prodction company, MTM, that provided:

> As [Warren's] employer for hire, [MTM] shall own in perpetuity, throughout the universe, solely and exclusively, all rights of every kind and character, in the musical material and all other results and proceeds of the services rendered by [Warren] hereunder and [MTM] shall be deemed the author thereof for all purposes.

While MTM ultimately won the case, this language created enough doubt that Warren's lawyers thought it was worth litigating the case through appeal. The issue: the contract did not specifically say that the compositions were "specially ordered or commissioned" in so many words. The court had to read other provisions of the contract – such as MTM's final creative control – to confirm that the scores really were written at MTM's behest.

Occasionally, the paperwork process fails. In *Aalmuhammed v. Lee*,

76. Warren v. Fox Family Worldwide, Inc., 328 F.3d 1136 (9th Cir. 2003).

Richard Warren (1952 –)

Remington Steele poster]

for example, Jefri Aalmuhammed was hired as an "Islamic Technical Consultant" for Spike Lee's *Malcolm X* starring Denzel Washington "to ensure the religious and historical accuracy and authenticity of scenes depicting Malcolm X's religious conversion and pilgrimage to Mecca."[77] He wrote several scenes and helped with subtitles, voice-overs, and translations. He was paid $25,000 by Lee and $100,000 by Washington, but never had a written contract. Since this failed to be a work made for hire, Aalmuhammed argued that he was a joint author. The court dismissed the argument using *Thomson*-style reasoning, holding that Spike Lee, not Jefri Aalmuhammed, was the "inventive or master mind" behind *Malcolm X*.

77. Aalmuhammed v. Lee, 202 F.3d 1227, 1230 (9th Cir. 2000).

3 Derivative Works

One work can build on another. Baz Luhrmann's *Romeo + Juliet* is an adaptation of William Shakespeare's play; Lil Nas X's *Old Town Road* is built on a beat from YoungKio, which in turn samples Nine Inch Nails's *34 Ghosts IV*. The copyright-law term for such adaptations is ***derivative works***, which are defined as

> a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. [78]

Section 103 of the Copyright Act gives the author of a derivative work a copyright in "the material contributed by the author of [the derivative] work," but not in the "preexisting material" incorporated in it.[79]. The copyright in the preexisting work is unaffected. The result is that a derivative work, viewed as a whole, can be subject to multiple copyrights. Someone who copies *Old Town Road* without permission infringes on Lil Nas X's copyright in the lyrics and melody, *and* on YounKio's copyright in the beat, *and* on Nine Inch Nails's copyright in the instrumental.

The rule that derivative works are copyrightable has an important proviso: "protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully."[80] This ***infringing-derivatives rule*** prevents a derivative work from being copyrightable if the derivative work itself infringes.

A classic example is *Pickett v. Prince*, which dates from the years that Prince adopted an unpronounceable symbol as his stage name (partly prompted by his struggles with his record label).[81] The symbol, which incorporates elements of the "male" and "female" symbols (derived in turn from the astrological symbols for the planets Mars and Venus), was creative enough to be copyrightable. A fan, Ferdinand Pickett, made a guitar in the shape of the symbol and, he alleged, showed it to Prince. When Prince later appeared in public playing a similar guitar, Pickett sued.

Malcolm X (1992), a Spike Lee joint, not a Spike Lee and Jefri Aalmuhammed joint

78. 17 U.S.C. § 101.
79. 17 U.S.C. § 103(a)
80. 17 U.S.C. § 103(a)
81. Pickett v. Prince, 207 F. 3d 402 (7th Cir. 2000).

Ferdinand Pickett, Symbol-shaped guitar

Pickett lost, becuase he had no copyright in his symbol-shaped guitar. The guitar was an infringing derivative work of the symbol, and therefore it was not copyrightable. In the court's view, the infringing-derivatives rule prevents intractable proof problems: was Prince's symbol-shaped guitar copied from Pickett's symbol-shaped guitar, or from Prince's symbol together with the unprotectable idea of making a guitar in that shape? Another argument sometimes advanced is that it gives the owner of the underlying work more freedom to develop and license it, as others cannot obtain "blocking" copyrights in the same way that they can obtain blocking improvement patents.

Still, the infringing-derivatives rule can be hard on derivative authors. In *Anderson v. Stallone*, Timothy Anderson, the author of a thirty-one page treatment for *Rocky IV* had no copyright at all, because the treatment infringed on the Rocky character from the first three movies.[82] That meant the studio, which took meetings with Anderson and allegedly told him "if they use his stuff it will be big money, big bucks for Tim," was free to use anything it wanted from his treatment without paying.

Even more strikingly, although the infringing-derivatives rule is widely followed, it is not textually required by Section 103, which states that copyright "does not extend *to any part of the work* in which such material has been used unlawfully." The infringing-derivatives rule as applied reads "part" broadly: unless there is an obvious division (e.g., one of three paintings in a tryptich), the entire work is uncopyrightable. Perhaps there was no meaningful "part" of a *Rocky* screenplay without Rocky, but it is also a plausible reading of this provision that Pickett could have maintained a copyright action over any decorative aspects of his guitar other than its shape.

And even more gallingly, courts sometimes apply the infringing-derivatives rule to works in which the preexisting work has been used *lawfully*. In *Gracen v. Bradford Exchange*, the Bradford Exchange held a competition for artists to design a *Wizard of Oz* collector's plate of Dorothy, with the idea that the winner would be offered a contract to create other *Wizard of Oz* plates.[83] Jorie Gracen won the competition, but she and Bradford couldn't agree on contract terms, so it hired another artist and gave him her plate to work from. Gracen was indisputably authorized to create her derivative work (the plate), but the court held that she was not also authorized to obtain a copyright in it, a position with no textual support in section 103. The result is to put future Gracens in the untenable position of a Victor Desny, knowing that if they shows Bradford their plates it will be free to terminate negotiations and use their designs without paying.[84]

On the other hand, a derivative work is copyrightable when it makes a fair use of the underlying work. In *Keeling v. Hars*, Jaime Keeling turned the 1991 surfing-skydiving-heist movie *Point Break* (directed by Kathryn Bigelow and starring Keanu Reeves and Patrick Swayze) into a stage play, *Point Break Live!*:[85]

82. Anderson v. Stallone, No. 87–0592 WDKGX (C.D. Cal. Apr. 25, 1989).

Jorie Gracen's design

The defendant's plate

83. Gracen v. Bradford Exch., 698 F.2d 300 (7th Cir. 1983).

84. More recent caselaw confines some of the damage from *Gracen* by holding that the authorized derivative creator receives a copyright unless their contract with the underlying copyright owner explicitly prohibits one.Schrock v. Learning Curve Intern., Inc., 586 F.3d 513 (7th Cir. 2009).

85. Keeling v. Hars, 809 F.3d 43, 45 (2d Cir. 2015).

> In the film, Reeves plays a rookie FBI agent who goes undercover to infiltrate a gang of bank-robbing surfers led by Swayze's character. The Keeling-authored PBL parody parallels the characters and plot elements from Point Break and relies almost exclusively on selected dialogue from the screenplay. To this raw material, Keeling added jokes, props, exaggerated staging, and humorous theatrical devices to transform the dramatic plot and dialogue of the film into an irreverent, interactive theatrical experience. For example, in Keeling's PBL parody, Point Break 's death-defying scene in which Reeves's character must pick up bricks, blindfolded, in a swimming pool takes place, instead, in a kiddie pool. Massive waves in the film are replaced by squirt guns in the PBL parody. A central conceit of the PBL parody is that the Keanu Reeves character is selected at random from the audience and reads his lines from cue cards, thereby lampooning Reeves's reputedly stilted performance in the movie.

"Skydiving" scene from *Point Break Live*

Keeling worked with Eve Hars to stage a production of *Point Break Live!* in 2007. But after the initial two-month run ended, Hars continued to stage performances of *Point Break Live!* for four years, without paying Keeling and without her permission. Hars's argument was that because *Point Break Live!* was a derivative work made without permission, it was uncopyrightable.

The courts disagreed. Keeling had no copyright in the plot and dialogue elements of *Point Break* that she borrowed for *Point Break Live!*, and she could not have sued Hars for copying those elements. But because *Point Break Live!* was a fair use (in particular, a transformative parody) it used those elements "lawfully," and thus Keeling did have a copyright in all of the creative elements she added, like the kiddie pool and squirt guns. By staging *Point Break Live!*, Hars copied these additional elements, and infringed Keeling's derivative-work copyright.

Photoshoot Problem

You represent Shelbyville Stages, a concert promoter. You have booked the eccentric pop musician Plastica for a twelve-city tour in the Northeast. The marketing staff at Shelbyville have recently discovered an image online that they think would be perfect for using on the concert posters. It features Plastica stepping down the landing ramp of a flying saucer, backlit, carrying a pair of cheerleader's pompoms, with a guitar slung over her back, and wearing her trademark disinterested scowl.

A similar photograph was the cover of this month's Them, a celebrity fashion magazine. An unknown party or party unknown, however, extensively Photoshopped it to make it look like a faded, weather-beaten Old West "WANTED" poster. The marketing staff tell

you that this was a stroke of genius; the combination of the antique look with the kitschy futuristic technology gives the whole thing what they call a "neo-horsepunk flying-car feel" and the outlaw theme plays off Plastica's expression. Their research has determined that the following people were in some way connected with the image:

- Plastica herself, who has spent years crafting her stage persona, which might be described as "heroin-ravaged all-American girl from outer space."
- Plastica's hair-stylist, Alicia Abt, who produced the complicated multi-layer updo in which she appears in the photograph, with a single side ponytail and a Statute-of-Liberty-style ring of spikes.
- Plastica's personal trainer, Ben Boardwell, who has spent years working with her to develop her musculature to combine strength with a suggestion of wasted potential.
- A celebrity photographer, Charles Carmack, who decided on the flying-saucer theme, chose the placement of props, and instructed Plastica on how to pose.
- Carmack's salaried assistant, Denyse Dozier, who operated the camera and pushed the button that took the photographs.
- A Photoshop expert, Ernest Eames, who digitally smoothed out the wrinkles in Plastica's face, extended her neck by two inches, and made a hundred other similar tweaks.
- *Them* magazine, where the modified photograph ran.
- Some unknown person with the username SeePeteyPhotoshop, who added the Old West theme and uploaded the modified photo to the photosharing site AwfulThings.com.

Based on these facts, advise Shelbyville Stages on whether it will be possible to obtain sufficient permissions to use the Old West version of the photo for the concert posters, and, if so how to go about it.

Illustrator Problem

DevaratiDraws is a digital artist with a large following on Instagram and Twitch. She frequently posts doodles and finished drawings, and also regularly livestreams her drawing process. Although she works in a variety of styles, including impressionistic portraits and landscapes, she is best known for her numerous cartoons of characters with pronounced overbites and large heads doing everyday tasks (doing laundry, riding the subway, etc.) in dramatic anime-inspired poses. She makes most of her income from Twitch creator revenue, with a bit from selling prints and merchandise, and occasional sponsored posts on Instagram.

Favorite Things makes and sells a line of home goods like dishware, towels, lamps, etc. Favorite Things has approached DevaratiDraws about the possibility of a partnership. Favorite Things would feature some of DevaratiDraws's illustrations on plates and other items, and Favorite Things would redesign its website for six months to feature

DevaratiDraws's work, with numerous illustrations of characters in her distinctive style. Favorite Things and DevaratiDraws agree that the project will require about 300 hours of her time.

How should Favorite Things and DevaratiDraws structure their agreement? Consider such factors as:

- Whether DevaratiDraws should be hired as an employee or independent contractor.
- Which parts of DevaratiDraws's work Favorite Things will own.
- Whether and when DevaratiDraws will be allowed to make other uses of any of her work for Favorite Things.
- What should happen if DevaratiDraws and Favorite Things have disagreements about the direction of the project or about specific drawings.

Be prepared to negotiate over these details representing *either* DevaratiDraws or Favorite Things.

C Procedures

In this section, we consider two topics: how copyright starts, and how it ends.

1 Formalities

Copyright the statute tells us, "subsists" as soon as a work is "fixed in a tangible medium of expression."[86] The author doesn't need to do anything more to become a copyright owner. Anyone who talks about "copyrighting" a work is confused. At best, they are thinking about "registering" the work with the Copyright Office, which does have several useful advantages, but is not a condition of protection. At worst, they think that unregistered works are not protected by copyright and may freely be copied. *This is wrong, wrong, totally wrong.* Correct them. This is not to say that copyright has no procedural wrinkles – only that these procedures are not preconditions to copyright protection.

86. 17 U.S.C. § 102(a).

It was not always thus. There have been five traditional ***formalities*** in United States copyright law – procedures one must follow to obtain or maintain a copyright: ***publication*** of the work with ***notice*** of the author's copyright, ***registration*** of the work (at first with district courts and now with the Copyright Office) and ***deposit*** of copies for the use of the Library of Congress, and ***renewal*** of the copyright for a second term. Failure to comply with these formalities could terminate a copyright, or even prevent one from existing in the first place.

Today, however, there is only one actual formality required to obtain a copyright, and it is so slight a requirement that it is usually satisfied automatically, without any special effort. That requirement is ***fixation***: that the work be embodied in some tangible object. Vestiges of the other formalities survive, and they can be important to good copyright practice, but fixation is the only thing one must do to have a copyright in the first place.

A word of warning. Not all of the changeover to the modern system of minimal formalities is retroactive. Many older works – especially those published before January 1, 1978, when the Copyright Act of 1976 took effect – remain subject to formalities. A failure to comply with the formalities back in the day can have important consequences in the present day. Due diligence for such works requires a careful investigation of the details.

a Fixation

Section 102(a) of the Copyright Act says that copyright subsists when a work is "fixed in any tangible medium of expression, now known or later developed, from which [it] can be perceived, reproduced, or otherwise communicated, either directly or indirectly with the aid of a machine or device." Section 101 adds that fixation takes place when it is "sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." The objects in which a work is fixed are important enough to have their own names. They are ***copies*** – unless the work is a sound recording that is not part of an audiovisual work, in which case they are ***phonorecords***.[87] The sheet music of a song is a copy; a vinyl record of a band playing the song is a phonorecord; a DVD of a movie with that band's version of the song on the soundtrack is a copy.[88]

This is a very broad definition. It covers everything from cuneiform clay tablets to the computer chips inside a singing stuffed animal. They are both fixed; they are both copyrightable. The definition is also technologically "neutral." It includes works that can be read directly by humans (such as as the pattern of ink in a printed book) and works that cannot (such as the pattern of holes on a DVD). In 1908, the Supreme Court held that piano rolls for player pianos were not "copies" because they were "not made to be addressed to the eye as sheet music,"[89] The 1976 Act's technologically neutral definition of fixation definitively repudiates this rule.

What isn't fixed? On the one hand, some works that are performed only once and not recorded are never embodied in a tangible object at all. The Copyright Compendium lists "an improvisational speech, sketch, dance, or other performance that is not recorded in a tangible medium of expression."[90] On the other, some works may be briefly present in a tangible medium, but not "sufficiently permanent or stable" to enure for more than a "transitory duration." The Compendium gives as examples displays " projected briefly on a screen, shown electronically on a television, or captured momentarily in the memory of a computer."[91] Most works are capable of being fixed, if necessary by pointing a camera or video camera at them. One possible exception may be conceptual art, where the artist has defined the work of art in a way that denies that the work is present in any specific tangible object – perhaps it is a transient performance that occurs once and is over, or perhaps the work is a particular emotion in the mind of a person who is unaware that they are

87. Despite the name, the object "in which the work is first fixed" is also a copy. So according to copyright, the original is a copy. Isn't law fun?

88. What about a DVD that has both the movie and the movie's soundtrack?

89. White-Smith Music Publ'g Co. v. Apollo Co., 209 U.S. 1, 12 (1908).

90. Compendium, *supra* note 1, § 305.

91. *Id.*

part of the art. The Copyright Act may recognize the artist's description of the work or a recording of a performance as fixed and thus copyrightable, but the artist would deny that that these contitute the work itself.

Ephemerality is sometimes raised as a challenge to digital works, but the definition of fixation is broad and pragmatic enough that this is rarely a real problem. Consider *Stern Electronics, Inc. v. Kaufman*, one of a series of similar arcade-game cases from the 1980s. Konami's スクランブル was a side-scrolling arcade game cabinet distributed as Scramble in the United States by Stern. Like all arcade cabinets from the days before flat-panel displays, it was built around a bulky cathode-ray tube monitor. The cabinet also contained circuit boards, speakers, a joystick, buttons, and coin slots. The circuit boards included pre-programmed chips called PROMs, for "programmable read only memory," that controlled the action of the game. It sold 10,000 cabinets at $2,000 each in the first two months.

Scramble

Omni sold knockoff Scramble cabinets with the same name, gameplay, graphics, and sound. When sued, it raised essentially the only plausible argument available to it on those facts: that Scramble wasn't copyrightable in the first place because it wasn't fixed. The easy answer is that Scramble is an audiovisual work fixed in the PROMs. The display on the CRT screen is ephemeral and each dot fades within a small fraction of a second. But the game itself is fixed in the computer chips and the ephemerality of the graphic display is of no more importance than the ephemerality of the sound waves when a record is played.

The deeper problem posed by a video game is that it changes every time the game is played: for example, where the enemies appear on screen depends on how the player maneuvers. This is not quite an argument that the work is not fixed; it clearly is. Rather, it is an argument that the what is fixed does not sufficiently determine what appears on the screen for copyright to protect what appears on the screen.

The exact sequence of sights and sounds will almost never be exactly the same twice. But, as the court observed, many aspects of the game will be similar across many runs:

> These include the appearance (shape, color, and size) of the player's spaceship, the enemy craft, the ground missile bases and fuel depots, and the terrain over which (and beneath which) the player's ship flies, as well as the sequence in which the missile bases, fuel depots, and terrain appears. Also constant are the sounds heard whenever the player successfully destroys an enemy craft or installation or fails to avoid an enemy missile or laser.[92]

This "repetitive sequence of a substantial portion of the sights and sounds of the game" is good enough.[93]

One important proviso in the definition of fixation is that the work must be fixed " by or under the authority of the author."[94] An unauthorized recording of an improvisatoinal jazz concert does not generate

92. Stern Elecs., Inc. v. Kaufman, 669 F.2d 852, 856 (2nd Cir. 1982).

93. What about a modern game like Horizon Zero Dawn? Or how about the procedurally generated No Man's Sky?

94. 17 U.S.C. § 101.

copyright in the recording, either for the jazz combo or for the surreptitious taper. But be careful to pay attention to whether the work is fixed in some other way. A band performing live a new song from their upcoming album does have a copyright in the song if they have recorded a version in the studio.

The other slightly mysterious-at-first clause in the definition of fixation is the sentence, "A work consisting of sounds, images, or both, that are being transmitted, is 'fixed' for purposes of this title if a fixation of the work is being made simultaneously with its transmission."[95] Think of the live broadcast of a basketball game, complete with on-screen graphics and other original elements. The broadcast is not itself fixed, but as long as the network is recording a copy of the broadcast as it goes out, the recording counts as the necessary "simultaneous" fixation.[96]

95. *Id.*

96. Note that this is a copyright in the broadcast of the game, an audiovisual work, not a copyright in the game itself, which is probably not a work of authorship.

Latte Art Problem

Your client is the co-owner and lead barista of Bitter Medicine, an upscale coffee shop. He makes latte art and posts photos on the @BitterMedicine Instagram page. Recently, a rival coffee shop across town has started making replicas of his latte cats and flowers, and repositing his photos (without attribution) on its own Instagram page. When he complained informally, the response was that latte art isn't copyrightable. How will you reply?

Latte art

b Publication

Fixation is a new concept with the 1976 Act. Its predecessor under the 1909 was publication, which marked the dividing line between state-law and federal copyright protection. State copyright protected unpublished works only, and disappeared upon publication. This is why, for example, Warren and Brandeis's famous Samuel Warren and Louis Brandeis includes a discussion of copyright: a right against publication of one's letters can function as an imperfect privacy right. It also secured the author's ability to decide whether and how to first publish a work; without state copyright, anyone who stole a manuscript could also steal the author's thunder.

Federal copyright protection attached upon publication with notice of the author's copyright. Do you see the gap between this rule and the rule that publication destroys state copyright? The problem was that publication with *improper or missing* would simultaneously destroy state copyright (as a publication) while also failing to secure federal copyright (as a publication without notice), leaving the author with no copyright at all.

Faced with these severe consequences for defective notice, the courts responded by manipulating the definition of "publication.":

> In order to soften the hardship of the rule that publication destroys common law rights, courts developed a distinction between a "general publication" and a "limited publi-

> cation." Only a general publication divested a common law copyright. A general publication occurred when a work was made available to members of the public at large without regard to their identity or what they intended to do with the work. Conversely, a non-divesting limited publication was one that communicated the contents of a work to a select group and for a limited purpose, and without the right of diffusion, reproduction, distribution or sale.[97]

The extreme example of this trend is the holding in *Estate of Martin Luther King v. CBS, Inc.* that Rev. Dr. Martin Luther King Jr.'s "I Have a Dream" speech was not "published," when he delivered it from the steps of the Lincoln Memorial on August 28, 1963 to an audience of more than 250,000 attendees of the March on Washington for Jobs and Freedom, and it was broadcast live on television and radio to an even larger audience.[98] As the court explained, "A performance, no matter how broad the audience, is not a publication."[99]

A general publication occurred if copies of the work were distributed to the public, or displayed in a way that would permit the public to make their own copies. But in either case, the author could prevent a general publication from taking place by imposing restrictions on copying. And a publication by someone else, without the author's permission, didn't count. Thus, the "I Have a Dream" speech remained "unpublished" even though copies were available in the press tent at the March, and even though it was printed in the September 1963 newsletter of the Southern Christian Leadership Conference. The trial court accepted the arguments of Dr. King's estate that the press tent copies were limited to the news media for "for the sole purpose of assisting press coverage of the March" and that he had not authorized the SCLC to reprint the speech.[100]

Under the 1976 Act, publication has nothing like the importance it once did. Copyright attaches when the work is fixed regardless of notice, so there is no longer a danger of forfeiture through unintended publication or botched notice. That said, publication is not entirely irrelevant, and it can still be important to know whether a work was published or not, and where.[101] Publication can affect the length of the copyright term for some works, and some of the other formalities, such as deposit and registration (to the extent that they matter) depend on the timing of publication. A number of defenses apply only to, or apply more strongly to, published works. And a work's nationality, which can affect how it is treated under United States and foreign law, can depend on where it was first published. To the extent that it matters, the definition of publication is now codified in Section 101 as distributing copies to the public "by sale or other transfer of ownership, or by rental, lease, or lending."[102]

97. Est. of Martin Luther King v. CBS, Inc., 194 F.3d 1211, 1214–15 (11th Cir. 1999).

Dr. King delivering – but not publishing – his "I Have a Dream" speech

98. *Id.*
99. *Id.* at 1217.

100. Est. of Martin Luther King v. CBS, Inc., 13 F. Supp. 2d 1347 (N.D. Ga. 1998). To be precise, this was for purposes of defeating a summary judgment motion, so the court found that both of these were disputed issues of fact.

101. Compendium, *supra* note 1, § 1903.

102. 17 U.S.C. § 101.

c Notice

Proper notice consists of "Copyright" or "Copr." or ©, followed by the year, followed by the author's name, like so:[103]

© 2015 Jane Q. Driveway

Under the 1909 Act, when publication without notice meant no copyright, courts interpreted the notice requirements with a bleakly hilarious severity. In *Wildman v. New York Times Co.*, for example, F. Collis Wildman wrote a mawkishly sentimental poem in 1911 and had it printed in on cards in 1926.[104] He put the name "F. Collis Wildman" at the end of the poem in the lower right of the cards and the word "Copyright" at the lower left, and sold 3,000 copies to the public. This was defective notice, held the court, because there was no date, and because his name didn't appear next to the word "Copyright." Thus, by selling the cards he "dedicated his verse to the public" and had no copyright to enforce.

Other cases are equally hair-splitting and hair-raising. If the publisher mistakenly printed too early a year in the copyright notice, the term began to run from the date listed, shortening the copyright term. Although the movie *The Last Time I Saw Paris* was released in 1954, MGM mistakenly printed the year as "MCMXLIV", which is 1944 in Roman numerals (the "X" should have been omitted). The term thus began to run from 1944 instead of 1954. MGM, unaware of the error and expecting the 28-year initial term to run until 1982, failed to renew the copyright when the initial 28-year term expired in 1972, causing the movie to enter the public domain. On the other hand, if the publisher printed a year that was too late, the copyright was void, as a kind of penalty for the attempt to improperly extend the copyright term, however inadvertent the mistake. The book *The Sacred Mountains* by Joel T. Headley was put on sale in November 1846, but the copyright notice following the title pages stated 1847 instead. *Held*, the book was not protected by copyright.[105] There are stories of law-firm associates assigned to write extensive memos on the consequences of enclosing the letter "c" in the copyright symbol with a triangle rather than a circle.

The 1976 Act retained the requirement to place visually perceptible notice on published copies of works, but softened its consequences, most notably by switching from publication-with-notice to fixation as the threshold for copyright protection. In 1988, the United States joined the international Berne Convention for the Protection of Literary and Artistic Works, which requires that copyright "shall not be subject to any formality."[106] Thus, since March 1, 1989, when the Berne Convention Implementation Act came into force, notice has no longer been required.

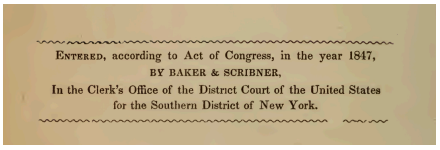
Even though it is now optional, notice remains a best practice.[107] Most obviously, it communicates essential facts about copyright in the work, which can warn off some potential infringers and help people who want to license the work identify the copyright owner. It also has a few minor doctrinal benefits, such as increasing the damages available

103. Compendium, *supra* note 1, § 2204.1.

104. Wildman v. N.Y. Times Co., 42 F. Supp. 412 (S.D.N.Y. 1941).

"Remember This" by F. Collis Wildman (in a later edition)

Title screen from *The Last Time I Saw Paris*



Copyright notice from *The Sacred Mountains* by Joel T. Headley.

105. Baker v. Taylor, 2 Blatchf. 82 (C.C.S.D.N.Y. 1848).

106. Berne Convention art. 5(2).

107. Compendium, *supra* note 1, § 2202.2.

against an "innocent infringer" who had no reason to know that what they were doing was infringing.

d Registration

Under the 1909 Act, following publication a copyright owner was required to register the work with the Copyright Office and deposit two copies "promptly." Failure to do so did not invalidate the copyright the way that publication without notice did, but the copyright owner was not allowed to sue for infringement until registration and deposit were complete. The 1976 Act carries forward the registration requirement as a precondition to sue for infringement, but not to copyright protection.

Compared to the expensive and extensive examination process for patents, copyright registration is cheap and relatively quick. A single online registration for a single work by a single author costs $45. Other types of registrations cost more, but not much more, e.g., registering "a group of works published on an album of music" costs $65. As of 2021, the average processing time for registrations was about 3 months, although timelines for registrations submitted on paper or with mail-in physical deposit averaged closer to a year. For a fee of $800 and for good cause (such as litigation or publication deadlines) and if Copyright Office agrees, an applicant can request "special handling" for which the Copyright Office will attempt to process the claim within five working days.

Registration applications are assigned to a registration specialist, who may correspond with the applicant by email to request more information. Procedures are informal compared with patent applicantions procedures. If the registration is granted, the Copyright Office will provide a certificate of registration. If the specialist rejects the registration, the applicant can file a request for reconsideration to the Copyright Review Board (at a cost of $350), which will issue a short written opinion. If the applicant is still unsatisfied, they can seek judicial review by suing the Register of Copyrights in federal district court.

There are a few exceptions to the usual registration rules. One is "preregistration" for types of works with a history of piracy – such as movies and music – that are being prepared for commercial distribution.[108] The copyright owner must follow up by registering the work within three months of its publication, but can sue infringers in the meantime. Similarly, works that are broadcast and fixed at the same time can be registered within three months but sued on immediately.[109]

As noted, the main reason to register is that you have to before you can sue.[110] Indeed, a copyright infringement suit is not properly pleaded unless the certificate of registration is filed with the complaint. If the registration is rejected, the applicant can still file an infringement suit, but must serve a copy of the complaint on the Register of Copyrights, so that they can appear in the case if they want. For a number of years, some courts allowed copyright owners to file suit as soon as they had *applied* to register their copyright. But the Supreme Court cut off

108. 17 U.S.C. § 408(f).

109. § 411(c).

110. 17 U.S.C. § 411.

that practice in *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*: no filing suit until registration or rejection.[111]

The other doctrinal advantage of registration is remedial: unless the copyright owner registers within three months of publication or before the infringement began, they cannot recover statutory damages or attorney's fees. This is often the difference between making an infringement suit economically viable or not, so given the low cost of registration, it is good practice to register promptly. The evidentiary advantages of registration are real but weak compared with patent; the registration is *prima facie* evidence of the copyright and the facts in the certificate, if it is registered within five years of publication.

111. Fourth Est. Pub. Benefit Corp. v. Wall-St.com, LLC, 139 S. Ct. 881 (2019).

e Deposit

Under the 1976 Act, as under its precedecessor, to register a copyright one must deposit a copy of the work with the Copyright Office.[112] This copy is for the Copyright Office's use in determining whether the work is registrable, and the Copyright Office makes rules and policies about how and whether the copy should be provided. Some classes of works are exempted entirely; the Copyright Office has no interest in receiving a copy of a twelve-ton site-specific metal sculpture. For others it requests electronic or physical copies, and there are special rules for online works. There are provisions to keep certain types of works – such as secure tests like the LSAT – confidential. These deposits are primarily for the Copyright Office's benefit, although they are also sometimes used as evidence in litigation to prove authorship or the contents of the work as of the registration date.

112. Compendium, *supra* note 1, § 1502.

There is *also* a deposit requirement for the benefit of the collection of the Library of Congress. If the work is published, the author must submit two copies of the "best edition" of the work.[113] These copies typically also satisfy the registration-copy deposit requirement, but the exact contents of the two requirements can diverge.

113. 17 U.S.C. § 407. *But see* Valancourt Books, LLC v. Garland, No. 21-5203 (D.C. Cir. Aug. 29, 2023) (holding that the Library of Congress deposit requirement is a taking requiring compensation under the Fifth Amendment).

Failure to comply with the mandatory Library of Congress deposit requirement doesn't affect copyrightability or enforcement. There are fines for owners who fail to comply with a demand for deposit copies, although they max out at $2,500 per work even for repeated and willful refusal.[114]

114. 17 U.S.C. § 407(d).

2 Term

Copyright lasts for a term of the life of the author plus 70 years. After that, the work is no longer subject to copyright, and it enters the "public domain," free for any use by anyone. For a quick sense of what that means in practical terms, consider *Klinger v. Conan Doyle Estate*.[115] Arthur Conan Doyle published 56 Sherlock Holmes stories and 4 novels between 1887 and 1927. Due to details of U.S. copyright terms, this meant that for many years the earlier works (published in 1922 and before) were in the public domain while the last 10 stories (published in 1923 and later) were still under copyright. The Doyle estate, which holds

115. Klinger v. Conan Doyle Est., 755 F.3d 496 (7th Cir. 2014).

those copyrights, is like a number of literary estates[116] notoriously protective and litigious.

In 2011, Leslie Klinger co-edited an anthology of Holmes-inspired stories. The Doyle estate demanded a $5,000 license, which the publisher paid. Klinger sought to publish a sequel, and this time sued for a declaratory judgment to establish that no license was needed. The estate's theory was that as long as any of Doyle's Sherlock Holmes stories was under copyright, the character of Sherlock Holmes was copyrighted and could not be used without permission.

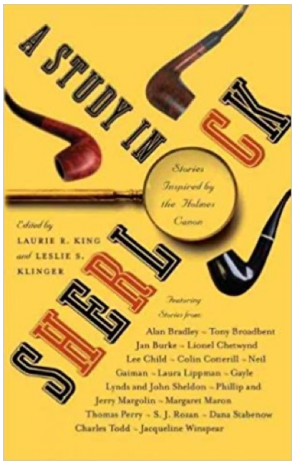
But this isn't right. Copyright protects *works of authorship*, not characters, and when the copyright in a work terminates, everything original in that work is fair game.Klinger and the contributors to the anthology were free to copy any elements they wished from the works – 46 stories and 4 novels – that were no longer under copyright. They could not use any elements from the 10 stories that were published after 1923. Those later stories were derivative works, and the copyright in them extended only to the material Doyle added over and above his previous works depicting Sherlock Holmes, Dr. Watson, etc. So one could not make a movie adaptation of "The Adventure of the Lion's Mane" (1926), but one could adapt "The Red-Headed League" (1891).

The copyright term has grown with time. Under the 1790 Act, it lasted for a 14-year term, which was renewable for a second 14-year term. The 1831 Act extended the initial term to 28 years, but kept the renewal term at 14 years. The 1909 Act extended the renewal term to 28 years as well. The 1976 Act switched to a system – based on the Berne Convention – of the life of the author plus 50 years. And the Sonny Bono Copyright Term Extension Act added another 20 years on top of the Berne minimum, for life of the author plus 70 years.[117]

The CTEA was a watershed moment in copyright politics and activism. It was supported by authors' groups and the "content" industries – film, music, publishing, etc. – for obvious reasons. But critics saw it as a restriction on free expression and the withholding of the raw materials needed for fresh creativity. One charge was that it should be called the Mickey Mouse Copyright Term Extension Act because it was passed shortly before *Steamboat Willie* (1928), the first Mickey Mouse cartoon, would have been due to enter the public domain. Opponents of the CTEA pointed to its *retroactive* extension of copyright for already existing works, arguing that this could serve no possible incentive purpose in encouraging authors. Led by law professor Lawrence Lessig, who argued the case to the Supreme Court, they sued to block the CTEA.

The Supreme Court, however, disagreed. In *Eldred v. Ashcroft*, it held that the CTEA's term extensions were compatible with the Constitution's requirement that exclusive righs be granted for "limited times" and "to promote the progress of science and useful arts."[118] One important point in its reasoning was the long history of term extensions – including retroactive term extensions – which had not previouisly been challenged. A truly perpetual term would be unconstitutional, but life of the author plus 50 years is not perpetual, and neither is a provision

116. *cough cough* James Joyce and William Faulkner



A Study in Sherlock (2011)

117. Sonny Bono – not to be confused with Bono from U2 – was a musician and later a member of Congress (R-CA). He died in 1998. The CTEA was named in his honor and was sponsored by his widow, Mary Bono, who won election to his former seat.

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

increasing 50 to 70.[119] Notably, however, the political heat generated by *Eldred* and its aftermath, seem to have deterred Congress. The 20th anniversary of the CTEA came and went in 2018 with no attempts at an encore performance.

There are a few important exceptions to the life plus 70 rule.[120] A joint work, which has multiple authors, has a term that is measured based on the longest-lived among them.[121] Other works which have no human "author" – works made for hire, and anonymous and pseudonymous works – have a fixed term of 95 years from first publication or 120 years from creation, whichever comes first.[122] All of these terms run until the end of the calendar year, which means that every January 1 is Public Domain Day, when works enter the public domain. 2021, for example, was the year that copyright in F. Scott Fitzgerald's *The Great Gatsby* expired.

All of these rules apply to *new* works: those created and published since 1978.[123] The rules for works already in existence in 1978 are far more complex. For one thing, they depend on whether the work was unpublished (and thus not already under federal copyright), or published and in its initial term, or published and in its renewal term.[124] For another, they inherit all of the complexity of the old formalities – so, for example, some courts but not others distinguished between works pubished in English and those published in other languages.

Another source of complexity even today is renewal. One way of looking at the old dual-term system is that 1909 Act provided for a 56-year term, but required the formality of renewal for the second 28 years. Sometimes, whoever was supposed to file for renewal simply didn't. The 1937 version of *A Star is Born* should have been renewed in 1965 but wasn't.[125] That put it irrevocably in the public domain. The 1976 Act, by switching to a unitary term, eliminated these forfeitures for failure to file for renewal. But it did not restore to copyright works that had not been properly renewed back when that was a thing,[126] so *A Star is Born* is still in the public domain.

Renewal was also a source of trouble because of disputes over *who* was entitled to file for renewal. The 1909 Act allowed the author to file for renewal and secure the renewal term *even if the initial term had been held by someone else*, on the theory that it would give penniless authors and their families a second chance to benefit from the success of a profitable work. An author, however, could assign their rights in the renewal term prosepectively *before it began*, so that a publisher could simply demand up front that the author sign over their rights in both the initial and renewal terms.[127] There was a catch, though: if the author died before the renewal term began, the right to renew would vest in their heirs, *and the author could not prospectively assign their heirs' rights*.[128]

The 1976 Act, you might think, would be free of these problems because it doesn't require renewal. But Congress *put them back in the statute* by giving authors or their heirs the right to ***termination of transfers***: to undo any assignment or license (a "grant") they had entered into and recapture the copyright.[129] These rights apply during a window of 35

119. Mary Bono: "Actually, Sonny wanted the term of copyright protection to last forever. I am informed by staff that such a change would violate the Constitution. . . . As you know, there is also Jack Valenti's proposal for term to last forever less one day."

120. 17 U.S.C. § 302(a).

121. 17 U.S.C. § 302(b)

122. 17 U.S.C. § 302(c).

123. Only in law can four decades feel like recent history.

124. See 17 U.S.C. §§ 303, 304(a),(b).

125. Classic Film Museum, Inc. v. Warner Bros., Inc., 597 F.2d 13 (1st Cir. 1979).

126. Except for foreign works, that is. The BCIA provided for a procedure to "restore" copyright in foreign works that were in the public domain due to failure to comply with a formality. 17 U.S.C. § 104A.

127. Fred Fisher Music Co. v. M. Witmark & Sons, 318 U.S. 643 (1943).

128. Miller Music Corp. v. Charles N. Daniels, Inc., 362 U.S. 373 (1960).

129. 17 U.S.C. § 203(a)(3)

to 40 years following the grant and are subject to intricate rules about who can exercise the right and how. But what puts the icing on the cake is that these termination rights are non-waivable: they can be exercised "notwithstanding any agreement to the contrary."[130] This rule is supposed to help protect authors from predatory publishers who offer them a little money now to give up valuable rights later. But of course, many authors desperately need money now and will sign anything to get it, and many publishers have clever lawyers who will try to craft an agreement that gets around this rule – for example, by terminating the previous grant and entering into a new one, thereby purporting to reset the termination window. The litigation over attempted terminations of some immensely valuable copyrights – including *Of Mice and Men*, *Winnie-the-Pooh*, and *Action Comics #1* – has been incredibly hard-fought.

130. 17 U.S.C. § 203(a)(5).

Finally, the transition rules from the old system to the new one are themselves not so simple. From 1962 onwards, as Congress debated what would become the 1976 Act, it repeatedly passed interim extensions. Every work that would have entered the public domain at the end of its renewal term between September 19, 1962 and December 3, 1976 received extensions until the end of 1976. In addition to the one-time-only extended terms for works still in copyright in 1978, Congress in the 1976 Act also created a second set of one-time-only termination rights for authors so that they could enjoy the benefits of those extended terms. And while in 1992 Congress made renewal automatic for works created between 1964 and 1977, they are still formally protected under a dual-term system.

In short, there is no way around it: copyright terms for older works are a mess and require careful investigation. The details are beyond the scope of this book, but *you have been warned*.

D Infringement: Similarity

Copyright uses a radically different similarity test than patent. Instead of comparing the defendant's product to the plaintiff's *description* of a product as patent does, copyright directly compares the defendant's work to the plaintiff's work.

The test is ***substantial similarity***: the defendant's work infringes if it copies from the plaintiff's work a material amount of protected expression. Substantial similarity is assessed from the viewpoint of the ordinary observer, sometimes described a member of the intended audience for the plaintiff's work. The question is whether "the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same."[131]

131. Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2nd Cir. 1960).

The 1946 case of *Arnstein v. Porter* is canonical for its explanation of the nature of the substantial-similarity inquiry. The plaintiff, Ira B. Arnstein, alleged that the mushc more famous Cole Porter copied numerous songs from him.[132] The court explained why a jury should hear the "improper appropriation" (i.e. substantial similarity) question:

132. Arnstein was a serial and vexatious litigant; among his allegations was that Porter "had stooges right along to follow me, watch me, and live in the same apartment with me." For much, much more, see Gary A. Rosen, Unfair to Genius: The Strange and Litigious Career of Ira B. Arnstein (2012).

> The proper criterion on that issue is not an analytic or other comparison of the respective musical compositions as they appear on paper or in the judgment of trained musicians. The plaintiff's legally protected interest is not, as such, his reputation as a musician but his interest in the potential financial returns from his compositions which derive from the lay public's approbation of his efforts. The question, therefore, is whether defendant took from plaintiff's works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff.
>
> The impression made on the refined ears of musical experts or their views as to the musical excellence of plaintiff's or defendant's works are utterly immaterial on the issue of misappropriation; for the views of such persons are caviar to the general – and plaintiff's and defendant's compositions are not caviar.[133]

133. Compare Arnstein's "A Modern Messiah" to Porter's "Don't Fence Me In" at the Music Copyright Infringement Resource. Subtantially similar?

Note the reasoning here. The finder of fact is not being asked about *their own* evaluations of the works' similarity. They are being asked about the evaluation of "lay listeners, who comprise the audience for which such popular music is composed." The judge or jury is being asked for its *objective* determination of the *subjective* responses of lay listeners.

Some courts, such as the Ninth Circuit, explicitly split the infringement inquiry into two steps: an "extrinsic" test for objective similarities that involves analytic dissection followed by an "intrinsic" test of the holistic subjective reactions of ordinary observes. Only if the works are similar enough at the first, extrinsic step can the case go to the finder of fact for the second, intrinsic step.

1 Measuring Similarity

The most obvious type of substantial similarity is where the defendant's work is a ***complete*** and ***literal*** copy, i.e. an exact duplicate of the plaintiff's work. As long as the work is copyrightable at all, complete literal copying always passes the substantial similarity test. Harder questions arise when the defendant copies only part of the plaintiff's work, when the similarities are nonliteral, or when the copied portion forms only part of the defendant's work. At the end of the day, the substantial-similarity inquiry always turns on the ordinary observer, but it is useful to survey some of the different ways works can be similar.

The only difficult issue posed by literal copying of part of the plaintiff's work is where to draw the line. In *TCA Television Corp. v. McCollum* the defendant's play, *Hand to God*, was a about a shy and repressed man named Jason, who expresses himself through his (possibly demonically possessed) hand puppet Tyrone.[134] At one point Jason and Tyrone perform a one-minute excerpt of the famous Abbott and Constello sketch "Who's on First" (versions of which run either three or nine minutes),

134. TCA Television Corp. v. McCollum, 151 F. Supp. 3d 419 (S.D.N.Y. 2015).

Two greeting cards from *Roth Greeting Cards*

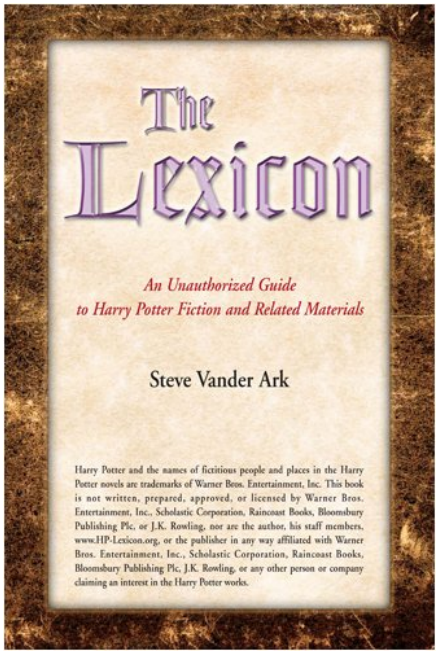
which Jason passes off as his own work. Although the defendants raised (and lost) a fair use defense, substantial similarity was not in question. One minute of out nine can be enough to infringe. Generally speaking, fair use will kick in to excuse a use of only part of the plaintiff's work long before the use fails to be substantially similar.

The cases are clear that extensive literal copying of scattered elements (sometimes called "fragmented literal similarity") can constitute substantial similarity. In *Warner Bros. Entertainment Inc. v. RDR Books*, the *Harry Potter Lexicon* contained hundreds of descriptions of people, places, spellls, creatures, and magical items from the *Harry Potter* universe.[135] It included dozens of direct quotations from the novels (both with and without quotation marks) and dozens of close paraphrases of passages from the books, some of them a paragraph long or more. *Held*, substantially similar.[136]

On the other hand, there are also *nonliteral* similarities. In *Roth Greeting Cards v. United Card Co.*, the plaintiff's and defendant's cards both featured the text "I miss you already" on the outside and "and you haven't even left" on the inside.[137] The art was different, and the text by iself was uncopyrightable under the short phrases doctrine. Still, the "total concept and feel" was the same, so there was infringment.

As Learned Hand explained in *Nichols*:[138]

> It is of course essential to any protection of literary prop-



A later and shorter version of the *Harry Potter Lexicon*

135. Warner Bros. Ent. Inc. v. RDR Books, 575 F. Supp. 2d 513 (S.D.N.Y. 2008).

136. *Id.*

> erty, whether at common-law or under the statute, that the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations. . . . When plays are concerned, the plagiarist may excise a separate scene or he may appropriate part of the dialogue. Then the question is whether the part so taken is "substantial."

Although it is easy to justify a doctrine of infringement based on nonliteral similarity, it is harder to articulate what the test actually is. "Total concept and feel" may work as a jury instruction, but it is a difficult standard for judges to apply without disobeying *Bleistein*'s instruction to avoid aesthetic judgment. One influential analysis comes from *Nichols*, which involved the play *Abie's Irish Rose*, the movie, *The Cohens and the Kellys* . Both were wildly successful, and both were about the tension between an Irish family and a Jewish family when their children fall in love and marry. As Judge Hand explained, the substantial-similarity question was as much about the line between idea and expression as it was about the amount of material copied:

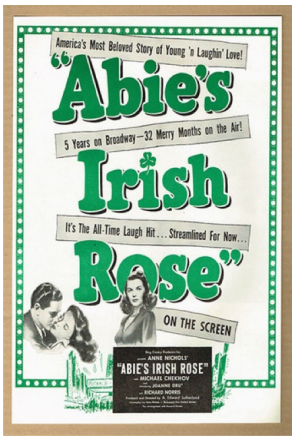
> It is the same question as arises in the case of any other copyrighted work. But when the plagiarist does not take out a block in situ, but an abstract of the whole, decision is more troublesome. Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his "ideas," to which, apart from their expression, his property is never extended.[139]

This is *Blehm* all over again: similarities between two works only constitute infringement if there is similarity of *expression*. Here is Judge Hand's summary of his conclusion that *The Cohens and the Kellys* did not infringe:

> In the two plays at bar we think both as to incident and character, the defendant took no more – assuming that it took anything at all – than the law allowed. The stories are quite different. One is of a religious zealot who insists upon his child's marrying no one outside his faith; opposed by another who is in this respect just like him, and is his foil. Their difference in race is merely an obbligato to the main theme, religion. They sink their differences through grandparental pride and affection. In the other, zealotry is wholly absent; religion does not even appear. It is true that the parents are hostile to each other in part because they differ in race; but the marriage of their son to a Jew does not apparently offend

137. Roth Greeting Cards v. United Card Co., 429 F.2d 1106 (9th Cir. 1970).

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



Abie's Irish Rose

The Cohens and the Kellys

139. *Id.*

> the Irish family at all, and it exacerbates the existing animosity of the Jew, principally because he has become rich, when he learns it. They are reconciled through the honesty of the Jew and the generosity of the Irishman; the grandchild has nothing whatever to do with it. The only matter common to the two is a quarrel between a Jewish and an Irish father, the marriage of their children, the birth of grandchildren and a reconciliation.
>
> If the defendant took so much from the plaintiff, it may well have been because her amazing success seemed to prove that this was a subject of enduring popularity.[140] Even so, granting that the plaintiff's play was wholly original, and assuming that novelty is not essential to a copyright, there is no monopoly in such a background. Though the plaintiff discovered the vein, she could not keep it to herself; so defined, the theme was too generalized an abstraction from what she wrote. It was only a part of her "ideas."
>
> Nor does she fare better as to her characters. It is indeed scarcely credible that she should not have been aware of those stock figures, the low comedy Jew and Irishman. The defendant has not taken from her more than their prototypes have contained for many decades.[141]

140. "[W]hen Robert Benchley was covering Broadway for *Life* magazine back in the '20s, he ran a weekly blurb for the infuriatingly long-running comedy *Abie's Irish Rose* that read, 'People laugh at this every night, which is why democracy can never work.'" Jack Viertel, The Secret Life of the American Musical 68 (2016).

141. *Nichols*, 45 F.2d at 121–22.

2 *De Minimis* Uses

The general rule is that as long as the defendant copies too much expression from the plaintiff, it is irrelevant if the defendant's work also contains other expression. As Learned Hand put it in *Sheldon v. Metro-Goldwyn Pictures Corp.*, "it is enough that substantial parts were lifted; no plagiarist can excuse the wrong by showing how much of his work he did not pirate."

This rule, however, has an exception for uses that are truly *de minimis* in the context of the defendant's work. Think of a copyrighted billboard captured in the background of a television person-in-the-street news interview. This is in one sense a case of total literal copying: the entire billboard is reproduced. But in another sense is it trivial, because no one is watching the news to look at billboards. Thus, while the news program has a compelling fair use case, many courts would also treat this use as not substantially similar as a matter of law because the copying is commercially irrelevant for both plaintiff and defendant.

For example, in *Gottlieb Development LLC v. Paramount Pictures*, a robot-baseball-themed Silver Slugger pinball machine was used as set decoration for an advertising agency in the 2000 Mel Gibson movie *What Women Want*.[142] It appeared in one three-and-a-half-minute scene, only the background, mostly out of focus, and was only on screen for several seconds at time. It played no role in the plot and was never used or mentioned. Although the artwork on the Silver Slugger cabinet and playfield was original and expressive and indisputably copied, there was still no

Still from *What Women Want* (2000)

142. Gottlieb Dev. LLC v. Paramount Pictures, 590 F. Supp. 2d 625 (S.D.N.Y. 2008).

infringement because the copying was *de minimis*.

Compare *Ringgold v. Black Entertainment Television, Inc.*, in which the artist Faith Ringgold made a silk-screened quilt titled *Church Picnic Story Quilt*, a poster of which was used as set decoration for a five-minute scene of the HBO sitcom ROC set in a church hall.[143] The poster was visible in the background for a total of 26.75 seconds, in nine shots ranging from 1.86 seconds to 4.16 seconds. This, the court held, was infringing and was not a *de minimis* use.

Still from *ROC* (1992)

143. Ringgold v. Black Ent. Television, Inc., 126 F.3d 70 (2d Cir. 1997).

The facts of *Gottlieb Development* and *Ringgold* are so similar that they are difficult to reconcile. One possible distinction is that the poster in *Ringgold* was important to the plot; it was chosen specifically to help set the scene of an African-American church. But then again, so was the pinabll machine in *Gottlieb Development*. Another distinction is that the pinball machine was less prominent compared with the other items of set dressing, or that it was blurrier and more often obscured. But these are all splitting the same hair extremely finely.

3 Filtration

There is another way of looking at *Nichols*. The similarities between *Abie's Irish Rose* and *The Cohens and the Kellys* were substantial, but many of those similarities had to be ***filtered*** out of the similarity comparison because the similar elements were uncopyrightable ideas. The same issue arises whenever the plaintiff's work contains elements that are not part of their copyright: public-domain works, uncreative elements like facts and people's appearances, preexisting works used lawfully, systems and methods of operation, etc. All of these must be filtered out of the comparision.

As a result, many courts use a "more discerning ordinary observer" test when filtration is necessary. As once court summarized, "we must attempt to extract the unprotectible elements from our consideration and ask whether the *protectible elements, standing alone*, are substantially similar."[144]

144. Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996, 1002 (2d Cir. 1995).

For an example of the process in action, consider *Boisson v. Banian, Ltd.*, another quilt case. Judi Boisson sued Vijay Rao for copying two alphabet quilt designs, one of which was titled "School Days I." Here is the analysis finding infringement for Rao's "ABC Green" designs:

> "School Days I" consists of six horizontal rows, each row containing five blocks, with a capital letter or an icon in each block. The groupings of blocks in each row are as follows: A-E; F-J; K-O; P-T; U-Y; and Z with four icons following in the last row. The four icons are a cat, a house, a single-starred American flag and a basket. "ABC Green Version I" displays the capital letters of the alphabet in the same formation. The four icons in the last row are a cow jumping over the moon, a sailboat, a bear and a star. "ABC Green Version II" is identical to "ABC Green Version I," except that the picture of the cow jumping over the moon is somewhat altered, the bear is

School Days I

replaced by a teddy bear sitting up and wearing a vest that looks like a single-starred American flag, and the star in the last block is represented in a different color.

All three quilts use a combination of contrasting solid color fabrics or a combination of solid and polka-dotted fabrics to represent the blocks and letters. The following similarities are observed in plaintiffs' and defendants' designs: "A" is dark blue on a light blue background; "B" is red on a white background; "D" is made of polka-dot fabric on a light blue background; "F" on plaintiffs' "School Days I" is white on a pink background, while the "F" on defendants' "ABC Green" versions is pink on a white background; "G" has a green background; "H" and "L" are each a shade of blue on a white background; "M" in each quilt is a shade of yellow on a white background. "N" is green on a white background; "O" is blue on a polka-dot background; "P" is polka-dot fabric on a yellow background; "Q" is brown on a light background; "R" is pink on a gray/purple background. "S" is white on a red background; "T" is blue on a white background; "U" is gray on a white background; "V" is white on a gray background; "W" is pink on a white background; "X" is purple in all quilts, albeit in different shades, on a light background; "Y" is a shade of yellow on the same light background; and "Z" is navy blue or black, in all the quilts.

Boisson also testified that defendants utilized the same unique shapes as she had given to the letters "J," "M," "N," "P," "R" and "W." With respect to the quilting patterns, "School Days I" and the "ABC Green" versions feature diamond-shaped quilting within the blocks and a "wavy" pattern in the plain white border that surrounds the blocks. The quilts are also edged with a 3/8" green binding.

From this enormous amount of sameness, we think defendants' quilts sufficiently similar to plaintiffs' design as to demonstrate illegal copying. In particular, the overwhelming similarities in color choices lean toward a finding of infringement. Although the icons chosen for each quilt are different and defendants added a green rectangular border around their rows of blocks, these differences are not sufficient to cause even the "more discerning" observer to think the quilts are other than substantially similar insofar as the protectible elements of plaintiffs' quilt are concerned. Moreover, the substitution in "ABC Green Version II" of the teddy bear wearing a flag vest as the third icon causes this version of defendants' quilt to look even more like plaintiffs' quilt that uses a single-starred American flag as its third icon. Consequently, both of defendants' "ABC Green" quilts infringed plaintiffs' copyright on its "School Days I" quilt.

ABC Green Version II

Now contrast the analysis finding no infringement for his "ABC Navy" design:

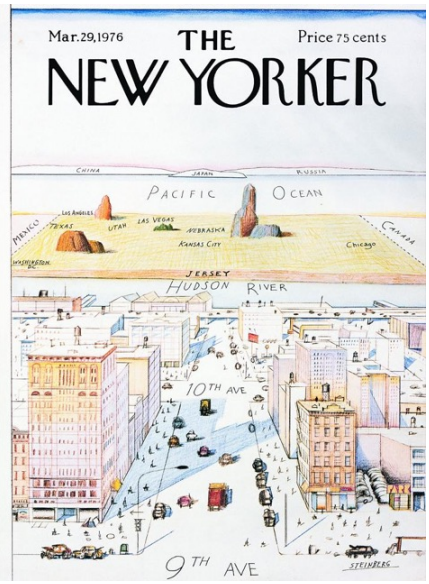
> We agree with the district court, however, that Rao did not infringe on plaintiffs' design in "School Days I" when he created "ABC Navy." While both quilts utilize an arrangement of six horizontal rows of five blocks each, "ABC Navy" does not have its four icons in the last row. Rather, the teddy bear with the flag vest is placed after the "A" in the first row, the cow jumping over the moon is placed after the "L" in the third row, the star is placed after the "S" in the fifth row, and the sailboat is placed after the "Z" in the last row. Further, the colors chosen to represent the letters and the blocks in "ABC Navy" are, for the most part, entirely different from "School Days I." Defendants dropped the use of polka-dot fabric, and plaintiffs did not even offer a color comparison in their proposed findings of fact to the district court, as they had with each of the "ABC Green" versions. The quilting pattern in the plain white border is changed to a "zig-zag" in "ABC Navy," as opposed to plaintiffs' "wavy" design. Finally, although defendants use a binding around the edge of their quilt, in this instance it is blue instead of green.
>
> Looking at these quilts side-by-side, we conclude they are not substantially similar to one another. Just as we rejected defendants' earlier argument and held that what few differences existed between "School Days I" and the "ABC Green" quilts could not preclude a finding of infringement, plaintiffs' emphasis on the similarity in style between some of the letters between "School Days I" and "ABC Navy" cannot support a finding of infringement. Because no observer, let alone a "more discerning" observer, would likely find the two works to be substantially similar, no copyright violation could properly be found.

ABC Navy

Do you find these analyses persuasive? Consistent? This is art. *There are no right answers.*

New Yorker Problem

Below you will find a cover from the *New Yorker* and a poster for the movie *Moscow on the Hudson*. The copyright owners of the former have sued the producers of the latter for copyright infringement. You are the judge assigned to the case, which you have conducted as a bench trial by the consent of the parties. Write the portion of your opinion finding substantial similarity or the lack thereof. Be as specific as you can.



Photograph by Marisol Ortiz Elfeldt

Photograph by Sarah Scurr

E Infringement: Prohibited Conduct

Copyright, like patent, has an interlocking system of exclusive rights. If anything, copyright's are even more intricate. This section and the next two try to bring some order to the system.

1 Proof of Copying

In the margin are two photographs. Does the one on the bottom infringe on the one on top?

If you said "yes," think again. The expression in the photographs is obviously similar. But that by itself is insufficient. To infringe, the similarities in protected expression must arise because the defendant copied *from the plaintiff*. In this case, the similarities are not because one of the photographs was photoshopped from the other. Instead, they were taken nearly simultaneously from nearly the same place. They share a ***common source***, and their similarities are due to similarities in the source, not to the copying of one work from the other. [145] Sometimes two works are similar by pure coincidence: recall the T-rex-arms T-shirts, which may very well all be instances of independent creation. And very occasionally the *plaintiff* copied from the *defendant* – can you see how that might happen, and why?[146]

It is always the plaintiff's burden to prove their theory of the case. In the context of civil copyright infringement, this means showing that it is more likely than not that the defendant copied from the plaintiff. In some cases, the defendant will admit to copying, or there will be direct evidence of the process, like early drafts of the defendant's poster that show them tracing over a print of the plaintiff's photograph. In other cases, plaintiffs can proceed with circumstantial evidence. Two types of such evidence are commonly used: ***access*** and ***probative similarity***.

Access tends to establish that the plaintiff's story of copying is possible by showing that there is a plausible sequence of events by

145. See How an Incredible Coincidence Sparked a Facebook Plagiarism Row, The Telegraph (Feb. 2, 2015). IP professor Roger Ford has made an animated GIF showing that the photographs really were taken from different angles.

146. "[T]he simplistic style in which they are written is partly explained by the fact that the editors, having to meet a publishing deadline, copied the information off the back of a packet of breakfast cereal, hastily embroidering it with a few footnotes in order to avoid prosecution under the incomprehensibly tortuous Galactic Copyright laws.

It is interesting to note that a later and wilier editor sent the book backward in time through a temporal warp, and then successfully sued the breakfast cereal company for infringement of the same laws." — Douglas Adams, The Restaurant at the End of the Universe (1980).

which the defendant could have seen the plaintiff's works. For example, maybe the plaintiff's song was played everywhere on the radio in the summer of 2017, or maybe a friend gave the defendant the plaintiff's book of photographs as a birthday present. There must be a "reasonable possibility" that the defendant had access to the work.

Probative similarities tend to establish that alternative stories are unlikely by showing that there are details in the defendant's work that could only have come from the plaintiff's. The fictitious listings in Rural's telephone directory are a good example: there is no plausible reason that Feist's directory would have included those listings unless they were lifted from Rural's.[147] When probative similarities are so strong that they could not have arisen by chance, courts call them ***striking similarity***.

To build intuition, think about the extreme cases. On the one hand, suppose that the defendant shows that access is all but impossible: perhaps the plaintiff wrote a science-fiction story while serving a six-month deployment on a submarine and the defendant wrote an allegedly infringing story before the submarine returned to port. Then the case should be dismissed, no matter how similar the works are: copying in fact is extremely unlikely. On the other hand, if there are no probative similarities between the works, then copying in fact is irrelevant because the works will not be substantially similar either. Even if access is easy to show (perhaps the plaintiff wrote a best-selling book), it cannot overcome the lack of similarity. In between, access and probative similarity are two kinds of evidence that should be considered with all other relevant evidence on the factual question of whether copying occurred.[148]

Three Boys Music Corp. v. Bolton is an example of proof of copying in action.[149] The Isley Brothers are a long-running rhythm and blues group, with hits like "Shout" and "Fight the Power, Pts. 1 & 2." In 1992, they sued Michael Bolton for infringing their song "Love is a Wonderful Thing" with his own "Love is a Wonderful Thing." The Isley Brothers Love is a Wonderful Thing was only released as a 45-rpm single in 1966, not on an album. It charted at number 110, for one week, before dropping off the charts. It was released on CD in 1991. Michael Bolton [150] and his songwriting parter Andrew Goldmark wrote their Love is a Wonderful Thing in early 1990. It was released in 199 and charted as high as number 49. The songs are similar enough that *if* there was copying-in-fact, the jury was entitled to return, as it did, a verdict of substantial similarity and a $5.4 million damage award. But *was* there copying-in-fact?

The similarities between the songs are real enough to be probative but not striking. So everything comes down to access. Bolton, who was born in 1953, was 13 when the original Isley Brothers single was released. He had been listening to a lot of R&B, performed in a band that played covers of songs by Black R&B singers, and his brother had a good record collection. The song was played a few times a week on radio stations in the mid-Connecticut region where Bolton grew up. Later in life, Bolton was a huge fan of the Isley Brothers and told Ronald Isley

147. Some courts call this kind of similarity "substantial similarity" too, which is a never-ending source of confusion. Some similarities can be probative of copying without constituting infringement (like Rural's fictitious listings), while other similarities are enough to constitute infringement but do not show who copied from whom. *See* Alan Latman, *"Probative Similarity" as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement*, 90 Colum. L. Rev. 1187 (1990).

148. *See generally* Skidmore v. Zeppelin, 952 F.3d 1051 (9th Cir. 2020) (upholding jury verdict that Led Zeppelin's "Stairway to Heaven" did not infringe Spirit's "Taurus" and discussing relationship of access and similarity).

149. Three Boys Music Corp. v. Bolton, 212 F.3d 477 (9th Cir. 2000).

The Isley Brothers

Michael Bolton

150. "There *was* nothing wrong with [the name 'Michael Bolton'] until I was about twelve years old and that no-talent ass clown became famous and started winning Grammys." Office Space (1999)

"I know this guy. I go back with him. I have all his stuff" at a benefit concert. And during the work tape of the recording session, Bolton and Goldmark wondered whether the song was based off of Marvin Gaye's "Some Kind of Wonderful." On the other side, three R&B experts (including Lamont Dozier of Holland-Dozier-Holland) testified that they had never heard of the Isley Brothers' "Love is a Wonderful Thing." Further, there were 129 songs titled "Love is a Wonderful Thing" registered with the Copyright Office.

Putting all of this together, the court held, there was enough evidence of access that the case had properly gone to the jury on copying-in-fact and substantial similarity. Does that sound correct to you? Now listen to the songs. Has your opinion changed?[151]

151. The songs can be heard and compared at the Music Copyright Infringement Resource

Ravens Problem

You represent the Baltimore Ravens, a professional football team. The team recently moved to Baltimore, which led to extensive press coverage over what its new name would be. At a press conference on June 10, the team unveiled the name and new logo, pictured in the margin. Yesterday, you received a phone call from an attorney representing Frederick Bouchat, a local security guard and artist.

According to Bouchat's attorney, during the lead-up to the announcement of the team's name and logo, Bouchat prepared several drawings of possible logos for his favorite possible team name, the "Ravens." One of these drawings came to the attention of the chair of the Maryland Sports Authority, John Moag, who had a brief meeting with Bouchat. Moag liked the drawings and asked Bouchat to fax them to him at his office, which is in the same office suite occupied by the team in Baltimore. Bouchat did so on February 5. Bouchat believes that the new logo is clearly based on one he suggested.

According to your files, the new official Ravens logo was prepared by NFL Properties, the league's licensing and merchandising arm. Bouchat's attorney has demanded a $2 million licensing fee, or he will file suit for copyright infringement and demand $10 million in damages. It is currently late July, and the Ravens' first season in Baltimore officially starts in a little over a month. What should you do?

Ravens logo

Bouchat's sketch for a logo

2 Intent

Direct infringement in copyright, like direct infringement in patent, is generally said to be "strict liability," but it plays out a little differently. In patent, the defendant can infringe while being wholly ignorant of the plaintiff's patent up until the moment they are served with a complaint for patent infringement. But because copyright infringement requires that the defendant have copy from the plaintiff – i.e., because independent creation is a complete defense – the copyright defendant who truly has never encountered the plaintiff's work does not infringe. In other words, one must copy to infringe, but one need not know, or even suspect that one is copying. As Learned Hand, easily the most quotable

copyright judge, put it:

> Everything registers somewhere in our memories, and no one can tell what may evoke it. Once it appears that another has in fact used the copyright as the source of this production, he has invaded the author's rights. It is no excuse that in so doing his memory has played him a trick.[152]

152. Fred Fisher, Inc. v. Dillingham, 298 F. 145, 147 (S.D.N.Y. 1924).

Thus, there are some striking cases of defendants who infringe based on ***subconscious*** copying. We have already seen one example: Michael Bolton's "Love is a Wonderful Thing." The most famous case is that George Harrison's "My Sweet Lord" (1970) has a similar melody and harmony to the Chiffons' "He's So Fine." [153] The songs have very different arrangements and feels, but their musical spine is the same. If the trier of fact is persuaded that the songs are substantially similar, the fact that the copying was unconscious is no defense.

153. ABKCO Music, Inc. v. Harrisongs Music, Ltd., 722 F.2d 988 (2d Cir. 1983). The songs can be heard and compared at the Music Copyright Infringement Resource.

3 Exclusive Rights

Section 106 of the Copyright Act defines infringement. It gives the copyright owner the following exclusive rights:[154]

(1) [the ***reproduction*** right] to reproduce the copyrighted work in copies or phonorecords;

(2) [the ***derivative-work*** or ***adaptation*** right] to prepare derivative works based upon the copyrighted work;

(3) [the ***public-distribution*** right] to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

(4) [the ***public-performance*** right] in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;

(5) [the ***public-display*** right] in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly;

154. A sixth § 106 right, public performance via digital audio transmission, is part of the music-copyright system, and will be discussed in the Music chapter.

Each of the rights has a distinctive and easily grasped essence. Consider a a blockbuster movie. The reproduction right prohibits the making of *new copies* of the same work, e.g., making pirated copies of the movie on DVD. The adaptation right prohibits the making of a *new work* based on the work, e.g., recutting scenes from the movie into a new film. The public-distribution right prohibits a *change in possession of copies*, e.g., selling copies of the movie on DVDs in a store. The public display right prohibits showing the work or a *static image* of or from the work, e.g., putting up a billboard of a still from the movie. The public-performance right prohibits showing a *dynamic* presentation of the sights and/or sounds from the work in real time, e.g., holding a

screening of the movie. As we will see, it is helpful to pay close attention to copies, because each of the rights has a distinctive relationship to copies of the work.

Note that rights (3) through (5) are all qualified by "publicly" or "to the public": distribution *to the public*, to perform the work *publicly*, to display the work *publicly*. For IP survey purposes, Section 101's definition of "publicly" supplies a good definition of "the public" as "a substantial number of persons outside of a normal circle of a family and its social acquaintances."[155] So a public distribution, performance, or display is one that is either does reach or is capable of reaching well beyond a household. For example, in *Fermata International Melodies v. Champions Golf Club, Inc.*, a musical performance in a members-only golf club was a public performance; an audience of twenty-one members plus their guests was a "substantial number of persons outside of a normal circle of a family."[156]

The dining room at the Champions Golf Club. It is not open to the general public, but it is a place where a substantial number of unrelated people gather.

155. 17 U.S.C. § 101.

156. Fermata Int'l Melodies v. Champions Golf Club, Inc., 712 F. Supp. 1257, 1260 (S.D. Tex. 1989).

a The Reproduction Right

The most interesting and difficult doctrinal issue with the reproduction right is *how long* must the work be embodied in a material object for that object to count as an infringing "copy." For a book, or a photographic negative, the answer is clear: long enough. And for transient displays of the sort that would not count as a "printed publication" under patent law, the answer is also clear. An oral presentation is not fixed for copyrightability purposes and it is not a "copy" that can infringe the reproduction right. The same goes for images projected on a screen from slide transparencies. These may be infringements of the public-performance and public-display rights, respectively, but they are not copies.

The real issue arises with computers, which may hold a copyrighted work in memory only briefly. In *MAI Systems Corp. v. Peak Computer, Inc.*, the copyright owner in a computer system combining software and hardware sued a third-party maintenance company for copyright infringement.[157] When Peak performed service on an MAI computer, its technicians would turn the computer on, which would cause the computer to load some of its software from long-term storage (a hard-drive, floppy disk, or read-only memory a/k/a ROM)) into shorter-term working storage (random-access memory a/k/a RAM). Peak argued that this was not an infringing reproduction because these "RAM copies" were transient and ephemeral and would disappear when the computer was turned off. The court disagreed, finding that the RAM copies were sufficiently permanent to infringe: after all, Peak was able to use them to run the software and diagnose the problems with the computers.[158]

On the other hand, in *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, the defendant's "remote DVR" service recorded copies of cable programs at customers' request.[159] Putting aisde the full copies themselves, which are their own kettle of monkeys, the system also used a buffer to store 1.2 seconds of a program at a time. As each new frame came in, it replaced the oldest frame still in the buffer, so that the whole program

157. MAI Sys. Corp. v. Peak Comput., Inc., 991 F.2d 511 (9th Cir. 1993).

An MAI Basic/Four Model 8000 computer, in use 1975–97

158. Congress responded to the result in *MAI* by adding Section 117(c), which explicitly allows the creation of immediately-deleted copies for repair and maintenance, but left the definition of "copies" untouched.

159. Cartoon Network LP, LLLP v. CSC Holdings, Inc., 536 F.3d 121 (2d Cir. 2008).

passed through the buffer, but each individual frame was resident in the buffer for only 1.2 seconds. This, the court held, did not infringe the reproduction right, because a "fleeting 1.2 seconds" was transitory.

b The Adaptation Right

How far does the author's copyright extend beyond the literal contents of the work? We have seen in the Similarity section that infringement is not "limited literally to the text, else a plagiarist would escape by immaterial variations." But historically, courts often read the copyright statutes narrowly, so that changes in form and medium were regarded as falling outside the copyright. For example, in *Stowe v. Thomas* in 1853, a German translation of Harriet Beecher Stowe's anti-slavery novel *Uncle Tom's Cabin* was held not to infringe. One report of the case quotes the judge as saying that anyone "may clothe [her characters] in English doggerel, in German or Chinese prose."[160] And in 1911, it was a serious question whether an unauthorized film version of *Ben Hur* infringed the copyright in the book.[161]

I think the best way to understand the adaptation right is that it definitively settles such questions. Translations and film adaptations are infringements of the adaptation right, regardless of the changes in language and medium. So are inflatable costumes, Batmobile kits, children's birthday cakes, and symbol-shaped guitars. The concept of substantial similarity, therefore, must incorporate these changes. Atom Egoyan's *The Sweet Hereafter* has a dramatically different effect on its audience than the Russell Banks novel of the same name on which it is based, but it is still an adaptation of the book, and it is still similar enough that it would infringe if it were not authorized.

160. Stowe v. Thomas, 23 F. Cas. 201 (C.C.E.D. Pa. 1853).

161. Kalem Co. v. Harper Bros., 222 U.S. 55 (1911).

c The Public-Distribution Right

Distribution, the statute tells us, can take place by "by sale or other transfer of ownership, or by rental, lease, or lending." The key is the transfer of ownership or possession of a copy of the work, regardless of whether money changes hands.

The most vexing issues around public distribution have to do with the Internet. In the offline world, there is a clear division between the reproduction of new copies and the distribution of existing ones. But on the Internet, copies are not conserved. When you download a file from a server, one copy (on the server) becomes two copies (one each on your computer and the server).

Is this a distribution? The problem is that the copy on the server didn't go anywhere. It is still owned and controlled by the same person it was before. One way to overcome this challenge would be to hold that the mere *making available* of copies to the public infringes the distribution right, [162] as in *Hotaling v. Church of Latter-Day Saints*, where a library had an infringing microfiche and the court held that the plaintiff could show an infringement of the distribution right without having to prove that any patrons had borrowed it. But the more common and

162. Article 8 of the WIPO Copyright Treaty, to which the United States is a party, requires a making-available right, but this would not be the first case where United States copyright law fell short of its treaty obligations.

more widely accepted approach is simply to count the downloading as an act of distribution as well as a reproduction. Thus, a distribution might be defined as an act by which a distributor who possesses a copy of the work provides a copy to another person that that person did not previously possess, whether or not they are the *same* copy.

d The Public-Performance Right

'The public-performance right applies only to 'literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works." What's missing? First, there are pictorial, graphic, and sculptural works, and architectural works. It is hard to see how any of these could be "performed" in a commercially significant way. Second, there are sound recordings, which are important enough to have their own separate treatment, discussed in the Music chapter.

Performance vs. Reproduction and Distribution

The crucial distinction that makes a performance a "performance" is that it takes place in real time. "To 'perform' a work means to recite, render, play, dance, or act it . . . or, in the case of a motion picture or other audiovisual work, to show its images in any sequence or to make the sounds accompanying it audible."[163] A reproduction, distribution, or display can take place almost instantaneously. But a performance makes the work visible and/or audible over a period of time during which the audience experiences it as a dynamic event unfolding across time.

This distinction has important implications for when a performance takes place, and who makes the performance. In *Columbia Pictures Industries, Inc. v. Professional Real Estate Investors, Inc.* ("*PREI*"), a hotel rented videocassetes to its guests, who watched the movies in their hotel rooms. The court held that the *customers* "performed" the movies by viewing them, but the *hotel* did not perform the movies by renting them.[164] Thus there was no infringement. The customers made private performances, and the hotel's distribution was protected by first sale.

Compare *Columbia Pictures Industries v. Redd Horne*, where the same movie studio sued a video store that also rented out viewing rooms to its customers. The viewing rooms had TVs that were connected to a bank of VCRs at the front of the store. When a customer selected a movie and went into the viewing room, an employee wout put the cassette into the appropriate VCR and hit play. This, the court held, was a performance *by the video store*.[165]

Streaming media also blur the line between reproduction and performance. In *United States v. American Society of Composers, Authors, & Publishers*, Yahoo! and RealNetworks allowed users to download music for later listening. Following the reasoning of *PREI*, the court held that these were reproductions, not performances.[166] It explained:

> The downloads at issue in this appeal are not musical performances that are contemporaneously perceived by the listener. They are simply transfers of electronic files containing

163. 17 U.S.C. § 101.

164. Columbia Pictures Indus., Inc. v. Pro. Real Est. Invs., Inc. ("*PREI*"), 866 F.2d 278 (9th Cir. 1989).

The New York Times/Steve Williams

Todd Moore, top, renting a video cassette from Andy Miller, assistant manager of Nickelodean Video Showcase in State College, Pa., and viewing it with friends in a private viewing room in the store.

A video store and viewing room: the combination is a public performance

165. Columbia Pictures Indus. v. Redd Horne, 749 F.2d 154 (3rd Cir. 1984). In *Columbia Pictures Industries, Inc. v. Aveco, Inc.*, the VCRs were located in the viewing rooms and the customers inserted the cassettes themselves. The video store still lost, because the court held that the customers' performances were in a "place open to the public."800 F.2d 59, 63 (3rd Cir. 1986).

166. United States v. Am. Soc'y of Composers, Authors, & Publishers, 627 F.3d 64 (2d Cir. 2010).

> digital copies from an on-line server to a local hard drive. The downloaded songs are not performed in any perceptible manner during the transfers; the user must take some further action to play the songs after they are downloaded. Because the electronic download itself involves no recitation, rendering, or playing of the musical work encoded in the digital transmission, we hold that such a download is not a performance of that work, as defined by § 101.
>
> The Internet Companies' stream[ing] transmissions, which all parties agree constitute public performances, illustrate why a download is not a public performance.[167] A stream is an electronic transmission that renders the musical work audible as it is received by the client-computer's temporary memory. This transmission, like a television or radio broadcast, is a performance because there is a playing of the song that is perceived simultaneously with the transmission. In contrast, downloads do not immediately produce sound; only after a file has been downloaded on a user's hard drive can he perceive a performance by playing the downloaded song. Unlike musical works played during radio broadcasts and stream transmissions, downloaded musical works are transmitted at one point in time and performed at another. Transmittal without a performance does not constitute a public performance.

167. Some podcasting apps let you start listening to an episode before it is completely downloaded. Reproduction, performance, or both?

As before, the users would perform the works in short order by listening to the music, but these would typically be non-infringing *private* performances. Make sure you see why true streaming transmissions, like those carried out by Netflix or Spotify, are *public* performances.

Who Performs?

The 1976 Act created an explicit two-prong statutory definition of "perform." One prong applies to transmissions to the public "by means of any device or process." It was added specifically to reverse two Supreme Court cases on cable television.[168] If this "Transmit Clause" means *anything*, it means that cable retransmission of over-the-air broadcast television constitutes a public performance. Cable networks are now subject to special statutory licensing regimes.[169]

The other prong is for in-person performances. Under the 1909 Act, public performances of dramatic works infringed, and so did public performances of musical works for profit. The 1976 Act unifies these into a general performance right, regardless of commerciality, to perform the work "at a place open to the public" or where substantially-more-than-a-household, as discussed above, are gathered.[170] This covers live theater, street-corner busking, and showing movies in theaters.

168. *See* Fort. Corp. v. United Artists Television, Inc., 392 U.S. 390 (1968); Teleprompter Corp. v. Columbia Broad. Sys., Inc., 415 U.S. 394 (1974).

169. Congress often creates statutory licenses when it modifies the sweep of copyright to cover an industry that previously skated around copyright.

170. 17 U.S.C. § 101 (definition of "perform").

Commerciality

Congress recognized that this vastly expanded definition of "perform" would sweep in all kinds of performances that were previously outside the copyright system. Sing a song aloud on the sidewalk? That's a public performance.

Thus, there is an important defense to the public performance right, one so important that it really forms part of the contour of the right itself. Where the 1909 Act applied only to performances "for profit," the 1976 Act contains an exclusion for *in-person* performances with no "purpose of direct or indirect commercial advantage".[171] A rap fan on the sidewalk loudly rapping along to the track in their headphones is engaged in a public performance, but not an infringing one. The in-person limitation is an important one: a public-librarian's online streaming storytime is not protected.

171. 17 U.S.C. § 110(4).

Importantly, a performance can still have a commercial purpose even if the performers are not paid. Consider a karaoke bar: the patrons are not being paid to sing, but their performances are public and commercial *from the bar owner's perspective* because the singing brings in patrons who order drinks. As Justice Holmes (the second-most quotable copyright judge) put it in *Herbert v. Shanley Co.*:

> If the rights under the copyright are infringed only by a performance where money is taken at the door they are very imperfectly protected. . . . The defendants' performances are not eleemosynary. They are part of a total for which the public pays, and the fact that the price of the whole is attributed to a particular item which those present are expected to order, is not important. It is true that the music is not the sole object, but neither is the food, which probably could be got cheaper elsewhere. The object is a repast in surroundings that to people having limited powers of conversation or disliking the rival noise give a luxurious pleasure not to be had from eating a silent meal. If music did not pay it would be given up. If it pays it pays out of the public's pocket. Whether it pays or not the purpose of employing it is profit and that is enough.[172]

172. Herbert v. Shanley Co., 242 U.S. 591, 594–95 (1917).

In addition, Congress added another exemption due to lobbying from small business associations. Think of an auto body shop where the mechanics listen to music on the radio while they work, or a restaurant where the manager leaves a television set on tuned to the baseball game. These too are performances that would have been exempt under the 1909 Act; no one brought their car to Vince's Collision Repair because of the music. Thus, under the "homestyle exception," it is not an infringement to engage in "communication of a transmission embodying a performance or display of a work by the public reception of the transmission on a single receiving apparatus of a kind commonly used in private homes" as long as there is no "direct charge" to see or hear

it.[173] In addition, there is a more complicated system that allows "establishments" (i.e. businesses open to the public) of less than 2,000ft^2 (3,750ft^2 for restaurants and bars) to play the musical works in radio and TV broadcasts using any equipment. Larger establishments can use up to 6 loudspeakers or 4 screens of no more than 55".[174]

173. 17 U.S.C. § 110(5)(A).

174. 17 U.S.C. § 110(5)(B)

e The Public-Display Right

The public-display right is rarely litigated and rarely matters on its own. Very few cases arise in which the defendant violates the public-display right without also violating one of the other rights. In cases where the public-display right might be implicated without triggering the reproduction right because the defendant made no additional copies, first sale will usually apply. One fact pattern on which the public-display right can matter is when the defendant has *unlawful* possession of a copy – perhaps because it was stolen – and displays that copy without making more.

Beyond that, the public-display cases tend to involve unusual procedural postures. One exception is *Streeter v. Rolfe*, where Wesley Streeter and Charles Rolfe had a falling-out over a design for a lightweight wild turkey decoy.[175] Because Streeter delayed in obtaining a registration, the only alleged act of infringement for which he could recover statutory damages was that Rolfe took one of the decoys on a hunting trip. The court held that this wasn't a public display. Another is *Thomas v. Pansy Ellen Products, Inc.*, where the *defendant* argued that a public display of nursery-room storage jars had taken place at a trade show in order to gain the benefit of the statute of limitations.[176] There was no dispute that showing samples to potential buyers at a trade show was a "display," and the court agreed that even though only members of the Juvenile Products Manufacturers Association were in attendance, the event was "public."

175. Streeter v. Rolfe, 491 F. Supp. 416 (W.D. La. 1980).

176. Thomas v. Pansy Ellen Prods., Inc., 672 F.Supp. 237 (W.D.N.C 1987).

Exclusive Rights Problem

You work for a copyright owner who is determined to bring suit against the following. In each case, identify every theory of copyright liability available. Be sure to consider both the different § 106 rights and the various flavors of secondary liability. Be creative.

- A woman calling herself Makeover Morticia gives tutorials on how to put on makeup effectively, which she livesstreams on a Google Hangout. She is paid by makeup companies to use their products and promote them on her streams. She regularly streams music from Spotify over her computer speakers as she works; this background music is audible to her viewers. Sometimes she turns up the music and tells the audience, "You should totally download this."

- *Terminations* is a best-selling dystopian young-adult novel. Fannie Frederickson, a young adult, writes a sequel in the form of a play, which she titles *Reversions*. Her high school's drama club performs *Reversions* as its annual fall drama. It gives three performances, for which it charges $5 admission; the proceeds are used to pay for a cast party at a local diner.[177]
- The Renton Theater obtains a digital copy of the movie *Rager* under a license permitting it exhibition at a single theater. But in addition to showing the movie in its own theater, Renton repeatedly duplicates *Rager* and rents out the copies to ten other movie theaters.
- Diversion Devices sells high-capacity digital video recorders with DVD-R drives. Some buyers of Diversion's DVRs use them to record television programs onto DVRs, which they give as presents to friends, family, and co-workers.

177. Hint: read 17 U.S.C. § 110(4) closely.

F Secondary Liability

Copyright has three non-statutory doctrines of secondary liability. They are arguably authorized by the language "or authorize" in section 106, but Congress has provided essentially no guidance on the scope of secondary liability, so the courts have drawn on general tort principles and on patent law in particular.

As in patent law, all three secondary liability doctrines require that there be a direct infringer. As as in patent law, it is not necessary to join the direct infringer as a defendant. And as in patent law, whether a defendant should be analyzed as a direct or secondary infringer is itself an important threshold issue.

1 Attribution

The following two attribution doctrines single out one party as the (possible) direct infringer, so that the other parties' liability can be assessed using principles of secondary infringement. As you read them, consider whether they are consistent with each other, and with the broader copyright landscape.

a Volitional Conduct

The ***volitional-conduct doctrine*** applies when a provider sets up a general-purpose computing system that others can use to store, transmit, and/or process content. If one of these other parties uses the system in an allegedly infringing way, the volitional-conduct doctrine says that the provider is not a direct infringer because they do not have a "nexus sufficiently close and causal to the illegal copying."[178] As this phrase suggests, calling it the"volitional" conduct doctrine is a bit of a misnomer; it has more to do with a lack of proximate causation than with a lack of volition.[179]

178. CoStar Grp., Inc. v. LoopNet, Inc., 373 F.3d 544, pincite (4th Cir. 2004).

179. Perfect 10, Inc. v. Giganews, Inc., XXX court, at pincite (Mar. 8, 2013).

The leading volitional-conduct case is *CoStar Group, Inc. v. LoopNet, Inc.*, where an ISP provided a website on which a real-estate broker posted infringing photographs.[180] The court reasoned that the ISP's sytem functioned automatically, like a copy machine:

180. *CoStar Grp.*, 373 F.3d 544.

> Indeed, counsel for both parties agreed at oral argument that a copy machine owner who makes the machine available to the public to use for copying is not, without more, strictly liable under § 106 for illegal copying by a customer. The ISP in this case is an analogue to the owner of a traditional copying machine whose customers pay a fixed amount per copy and operate the machine themselves to make copies. When a customer duplicates an infringing work, the owner of the copy machine is not considered a direct infringer. Similarly, an ISP who owns an electronic facility that responds automatically to users' input is not a direct infringer. If the Copyright Act does not hold the owner of the copying machine liable as a direct infringer when its customer copies infringing material without knowledge of the owner, the ISP should not be found liable as a direct infringer when its facility is used by a subscriber to violate a copyright without intervening conduct of the ISP.

The exact status of the voltional-conduct doctrine is a little hard to pin down. The doctrine can be traced to one of the Scientology cases, 1995's *Religious Technology Center v. Netcom On-line Communication Services, Inc.*[181] It has been widely followed in district courts and courts of appeals since in cases involving the reproduction and display rights. While there are cases that reject a defendant's arguments that they lacked the necessary volition, there are no cases rejecting the doctrine iself. Justice Scalia's dissent in *American Broadcasting v. Aereo, Inc.* would have used the volitional-conduct doctrine to hold that Aereo might be a secondary infringer but it was not a direct infringer. Justice Breyer's majority opinion does not discuss violtional-conduct doctrine; it decides the case based on an interpretation of the Transmit Clause.

181. Religious Tech. Ctr. v. Netcom On-line Commc'n Servs., Inc., 907 F. Supp. 1361 (N.D. Cal. 1995).

One possibility, then, is that the volitional-conduct doctrine applies to the other exclusive rights but not to the public-performance and public-display rights. Another is that it applies generally, except when the defendant's system too closely resembles a cable system. A third is that the doctrine has been rendered redundant by the more specific safe harbors of Section 512 of the DMCA.

b The Server Rule

The server rule applies in slightly different circumstances: when party A provides technical instructions for a user's computer to obtain content from party B's server. The most common fact pattern involves what used to be called "framing": party A creates a webpage that contains an image tag pointing to a location on party B's website. When the user directs their browser to party A's page, the browser automatically also

loads the image from party B's server, and displays it in the context of other content from party A's page. On these facts, *Kelly v. Arriba Soft Corp.*[182] and *Perfect 10, Inc. v. Amazon*[183] held that the defendant's search engines did not infringe when they framed images from third-parties servers. As the court in *Perfect 10* explained:

> Instead of communicating a copy of the image, Google provides HTML instructions that direct a user's browser to a website publisher's computer that stores the full-size photographic image. Providing these HTML instructions is not equivalent to showing a copy. First, the HTML instructions are lines of text, not a photographic image. Second, HTML instructions do not themselves cause infringing images to appear on the user's computer screen. The HTML merely gives the address of the image to the user's browser. The browser then interacts with the computer that stores the infringing image. It is this interaction that causes an infringing image to appear on the user's computer screen

182. Kelly v. Arriba Soft Corp., 336 F.3d 811 (9th Cir. 2003).

183. Perfect 10, Inc. v. Amazon, Inc. 508 F.3d 1146 (9th Cir. 2007).

Perfect 10 helpfully then analyzed whether Google was liable as a vicarious, contributory, or inducing infringer (no), showing clearly that the server rule is about attributing direct liability, not about exonerating a defendant entirely. No one disputed that third-party websites with unauthorized copies of the photographs were direct infringers.

The server rule is a bright-line test. It assigns direct liability based on the "external" technical facts of how the system works, not based on the "internal" experience of how the system appears to the user.[184] This has made it popular with technology companies that want as much certainty as they can get about the legality of their operations. This has also made it unpopular with copyright owners who believe that it provides a roadmap to infringement.

184. Orin S. Kerr, *The Problem of Perspective in Internet Law*, 91 Geo. L.J. 357 (2003).

A few district court cases have notably disagreed with the Ninth Circuit's server-rule opinions. For example, in *Nicklen v. Sinclair Broadcast Group, Inc.*, photographer Paul Nicklen uploaded a video of a starving polar bear to Instagram.[185] Sinclair, a network of local television stations, published a web article about the video, and embedded it using Instagram's API, that is, "by including in its website an HTML code provided by Instagram or Facebook that directed web browsers to retrieve the Video from the Instagram or Facebook server."[186] Instagram, by virtue of its terms of service, had a license from Nicklen to display the video.[187] The court held that this was also a display *by Sinclair*, even though the actual video was served to users by Instagram. It rejected the server rule as inconsistent with the text, legislative history, and policies of the Copyright Act. Stay tuned.

185. Nicklen v. Sinclair Broadcast Grp., Inc., 551 F. Supp. 3d 188 (S.D.N.Y. 2021).

A still from Nicklen's video

186. *Id.* at 192.

187. Why "display" and not "perform?"

2 Vicarious Infringement

A ***vicarious infringer*** has (1) the *right and ability* to control the infringement, and (2) a *direct financial interest* in the infringement. The purpose of vicarious infringement is to impose liability on parties who could stop

someone else from infringing but have obviously bad incentives not to. It is an outgrowth of an employer's *respondeat superior* liability for the torts of employees acting within the scope of their employment, but it reaches beyond traditional employment settings.

One classic line of cases, the "dance hall" cases, involved entertainment venues that hired bands to perform. The venues didn't tell the bands to play infringing songs, but they didn't tell the bands not to, either. By holding the venues liable for the bands' infringements, the courts in effect told the venues that they had a duty to supervise their independent contractors more carefully. By way of contrast, landlords were not typically liable for infringements committed by their tenants. This is a pragmatic distinction; it rests on a judgment about who is best positioned to play copyright cop.

A canonical modern case is *Fonovisa, Inc. v. Cherry Auction, Inc.*, where the defendant operated the twice-weekly Cherry Auction swap meet in Fresno, California.[188] Specialty vendors paid a daily rental to Cherry Auction for booth space at the meet. Cherry Auction provided parking, advertising, and security, and retained the right to exclude any vendor at any time for any reason. It also collected entrace fees from customers.

188. Fonovisa, Inc. v. Cherry Auction, Inc., 76 F.3d 259 (9th Cir. 1996).

The Cherry Auction swap meet

Some of the vendors sold infringing cassette tapes of Latin music to which Fonovisa held the copyrights. After several warnings and raids by the county sheriff, Fonovisa sued Cherry Auction. The court held that Cherry Auction could be vicariously liable. On the one hand, it had the absolute legal right to terminate any vendor, and the right to exclude customers, so it had the "right and ability" to prevent the infringement from occurring. Note that it was not actively involved in the infringing sales, but it had the ability to find them and take action, and that was enough. On the other hand, Cherry Auction had a financial interest because the pirate vendors' rental fees were driven by their infringing sales and because the bootleg cassettes acted as a "draw" for customers (with their admission fees) to the swap meet.

3 Contributory Infringement

A ***contributory infringer*** is one who (1) has *knowledge* of the infringement and (2) makes a *material contribution* to it. Unlike in vicarious infringement, *control* over the infringement is not required, just some degree of *contribution*.For example, a concert promoter who is hired to advertise massive unlicensed dance parties cannot prevent the infringing performances from taking place; all they can do is decline to provide their assistance. Their liability will turn on how extensive their contribution is, and their degree of knowledge.

A particularly blatant example of contributory infringement is *A & M Records, Inc. v. Abdallah*, where the defendant, Mohammed Abdallah, sold cassette tapes and audio duplicating equipment. He had regular arrangements with some of his major customers in which he would supply them with large numbers of blank cassette tapes of exactly the same

length as a commercially released cassette tape (e.g. Hammer's "Let's Get It Started"). The customers would copy the legitimate tape onto the blank ones, package them, and sell them onwards.[189]

Abdallah was not a direct infringer; he did not duplicate tens of thousands of cassettes himself. But he was a contributory infringer. The blank tapes were his "material contribution"; they were an essential component of a mass commercial infringement. His customers could almost certainly have sourced their blanks from elsewhere (perhaps at greater expense, effort or risk), but that is no defense. And the evidence that he knew exactly what his customers were doing was everywhere. He told his employees the methods involved, and even worried about letting one customer buy blanks on credit after the customer had been raided by the police for counterfeiting.

Fonovisa is also a contributory-infringement case. Cherry Auction knew of its vendors' infringements after the county sheriff raided the meet and seized 38,000 counterfeit tapes. And as for material contribution:

> Indeed, it would be difficult for the infringing activity to take place in the massive quantities alleged without the support services provided by the swap meet. These services include, inter alia, the provision of space, utilities, parking, advertising, plumbing, and customers.

Contributory infringement – but *not* vicarious or inducing infringement – is subject to the *Sony* defense: it is not contributory infringement to supply a device that is used for infringement as long as the device is "capable of substantial noninfringing uses."[190] The defense takes its name from *Sony Corp. of America v. Universal City Studios, Inc.* Sony sold home VCRs,[191] which some consumers allegedly used in infringing ways – e.g., to record movies broadcast on TV and publicly distribute the tapes.

Sony was not a direct infringer; consumers made the copies, not Sony.[192] Sony was not a vicarious infringer, either. Once it had sold a VCR to a consumer, it was not as though Sony could show up at their house and pull the plug if it were used to infringe. So it was contributory infringement or bust, but the movie studios had a plausible argument here. The material contribution was inarguable: no VCR, no copy. Sony did not have *specific* knowledge of how and when which customers would infringe which copyrighted works, but it did have *general* (sometimes "constructive") knowledge that some customers would use their VCRs to infringe some programs sometime and somehow.

Drawing on "the historic kinship between patent law and copyright law," Justice Stevens grafted the *statutory* contributory infringement test from patent law , which does not impose liability for the sale of a "staple article of commerce," into the *judicial* contributory infringement test of copyright law. Thus:

> Accordingly, the sale of copying equipment, like the sale of

189. Perhaps even to the vendors at Cherry Auction?

190. Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417 (1984) [hereinafter *Sony*].

191. In a minor historical irony, Sony's standard – the Betamax – lost out to the competing VHS standard backed by JVC, Hitashi, Mitsubishi, and Sharp.

The Sony Betamax

192. Notice the implicit use of the volitional-conduct doctrine in this conclusion.

> other articles of commerce, does not constitute contributory infringement if the product is widely used for legitimate, unobjectionable purposes. Indeed, it need merely be capable of substantial noninfringing uses.

In particular, the Court held that the Betamax was capable of two substantial nonnfringing uses. The first was recording programs for later viewing ("time-shifting") with the permission of the copyright owner. Religious and educational broadcasters (including Fred Rogers of *Mister Rogers' Neighborhood*) testified that they did not object to time-shifting. The second noninfringing use was time-shifting even without broadcaster permission, which was protected as fair use.

One way to understand the *Sony* rule treats it as a gloss on the knowledge element of contributory infringement: it works by protecting a defendant who has only general knowledge of their product's infringing uses. A defendant who has specific knowledge of the direct infringement at the time they supply it can be held liable. On this interpretation, Abdallah would not have been protected because he knew that specific customers would use the blank tapes to infringe by duplicating specific albums.

Another way to understand *Sony* treats it as a gloss on the material-contribution element. This approach looks to the patent-law doctrine *Sony* draws on, where the key distinction is between products that have non-infringing uses and those that do not. On this interpretation, Abdallah could not have been sued for selling standard-length blank cassettes in bulk; where he went wrong was in selling cassettes "especially made or especially adapted for use in an infringement," in the words of the Patent Act.

4 Inducing Infringement

The upshot of the inducement test is that when it is satisfied, the *Sony* defense will not protect the defendant. According to the Supreme Court in *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, an ***inducing infringer*** "(1) distributes a device (2) with the object of promoting its use to infringe copyright, (3) as shown by clear expression or other affirmative steps taken to foster infringement."[193] Much ink has been spilled on exactly what this language means, but for most purposes, it suffices to regard it as a variation on the contributory infringement test, with two-and-a-half differences.[194] First, just as it is unclear whether the *Sony* defense only applies to devices, it is unclear whether *Grokster* reaches beyond the distribution of a device as a basis of liability. Second, the required mental state toward the underlying infringement is heightened from knowledge to intent. And third, there is a heightened evidentiary requirement: the intent must be "shown by clear expression or other affirmative steps."

193. Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd., 545 U.S. 913, 936—37 (2005) (numbering added).

194. Indeed, some courts treat inducement as a subspecies of contributory infringement.

Cherry Auction Problem

Should Cherry Auction have rewritten its contracts with vendors *not* to give itself control over their activities and to take away its ability to evict them?

G Defenses

Copyright has a well-articulated and mostly statutory system of defenses. Some, like fair use, are broad and general. Others, like the jukebox license, are narrow and specific. They are codified in sections 107 to 122 of the Copyright Act.

1 First Sale

First sale is the copyright analogue to the exhaustion defense in patent law. Following the first lawful sale of a copy of the work, the copyright owner has no further right to prevent fresh distributions of that copy. The copyright owner still has the exclusive right to prevent the making of new copies (the reproduction right), but it most important exclusive right over that particular copy (the distribution right) has ceased.

The canonical first-sale case is from 1908. In *Bobbs-Merrill Co. v. Straus*, the Bobbs-Merrill publishing company[195] put the following notice on the copyright page of *The Castaway*:

> The price of this book at retail is one dollar net. No dealer is licensed to sell it at a less price, and a sale at a less price will be treated as an infringement of the copyright.[196]

The Macy's department store sold it at eighty-nine cents, and Bobbs-Merrill sued. The Supreme Court held that while Bobbs-Merrill had exclusive control over making copies, and could sell them to whomever it chose at whatever price it chose, it could not control further sales after that. "The purchaser of a book, once sold by authority of the owner of the copyright, may sell it again, although he could not publish a new edition of it."[197] provision Section 109 now codifies the first-sale doctrine.[198] The most important limitation is in section (a):

> Notwithstanding the provisions of section 106(3), the owner of a particular copy or phonorecord lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord.

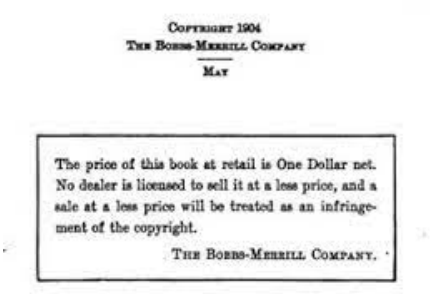
Section (c) contains a similar rule for *in-person* public displays.[199]

There is one striking exception to first sale: per section 109(b) neither sound recordngs nor computer programs can be distributed "purposes of direct or indirect commercial advantage . . . by rental, lease, or lending." That is, they can be sold for profit (think a used record store) and they can be loaned for free (think a library that loans out CDs), they

195. Bobbs-Merrill is now owned by Macmillan, one of the "Big Five" English-langauge publishers, and the name is no longer used as a separate imprint.

196. Bobbs-Merrill Co. v. Straus, 210 U.S. 339 (1908).

The Castaway


Copyright 1904
The Bobbs-Merrill Company
May

The price of this book at retail is One Dollar net. No dealer is licensed to sell it at a less price, and a sale at a less price will be treated as an infringement of the copyright.
The Bobbs-Merrill Company.

Price-restriction notice

197. *Id.*

198. 17 U.S.C. § 109.

199. Why not remote displays?

cannot be rented. But movies can be rented (I still know people who get physical DVDs from Netflix). This odd state of affairs is the result of the Record Rental Amendment of 1984, in which the music industry briefly freaked out that unless musical-work rentals were prohibited, consumers would rent CDs cheaply and rip them to cassette. Interestingly, this is exactly what happened in Japan, which did not enact a similar limitation. It simply became an established part of the Japanese market that people would rent CDs, buy blank cassettes (often from the same store, on a rack immediately next to the CDs), and rip them at home.

The most important word in section 109 is "owner," because only an "owner" of a copy has first sale rights in that copy. In *UMG Recordings, Inc. v. Augusto*, the music company UMG mailed unsolicited promotional CDs to music critics and radio stations, in the hope of getting reviews and airplay.[200] Some of the CDs were labeled "Promotional Use Only—Not for Sale," while others had a more detailed statement:

> This CD is the property of the record company and is licensed to the intended recipient for personal use only. Acceptance of this CD shall constitute an agreement to comply with the terms of the license. Resale or transfer of possession is not allowed and may be punishable under federal and state laws.

Of course, numerous recipients ignored the labels and sold or gave away the CDs. Troy Augusto resold some of them on eBay as "rare industry editions."

Notice that this is a question about ownership of the physical CDs themselves, not a question about a license to the copyrighted music on the CDs. Suppose that Augusto had visited UMG's headquarters in Santa Monica, been shown to a conference room with a dozen upcoming CDs and a professional-grade speaker system, invited to listen to whichever of them he wanted for the next two hours, and forbidden to take them out of the room. First sale would not apply to the CDs. They would be no more his property than the speaker system or the conference room. In personal-propery terms, this is a license, not a sale.

But by mailing the CDs out unsolicited, UMG irrevocably transferred ownership in them, triggering first sale. Under the federal Unordered Merchandise Statute,[201] the recipient of unordered goods is entitled to treat them as a gift and keep them. So the shipment itself was a "first sale."

More generally, UMG made no effort to keep track of the CDs, to demand their return, or to force recipients to agree that they remained UMG's property.[202] Even in cases where the Unordered Merchandise Statute doesn't apply, copyright owners can't pretend that they still own copies they clearly don't. A publisher who gives out promotional copies from its booth at a book fair can't stop visitors who take one from leaking it to industry blogs, or selling it to a used book store.

Another issue in first sale is what counts as a "copy" of the work

200. UMG Recordings, Inc. v. Augusto, 628 F. 3d 1175 (9th Cir. 2011).

201. 39 U.S.C. § 3009. The statute was enacted to counter scams in which unscrupulous companies shipped out merchandise and told consumers they would be billed unless they returned the goods promptly.

202. Epic Records gave reviewers copies of Tori Amos's *Scarlet's Walk* inside of sealed CD players that were glued shut, with headphones glued into the players. First sale?

protected by first sale. An old line of cases such as *Doan v. American Book Co.* allowed owners to repair and modify the physical armature supporting a copy's expressive content. There, textbooks books "had been in use by school children" to predictable effect: "Some were written upon and defaced; some were soiled and torn; the covers of some were wholly or partially destroyed,"[203] *Held*, the defendant was allowed "to clean them, to trim the edges of the leaves, and to rebind them." The same principle applies to taking multiple works – e.g., the issues of a magazine – and binding them together.[204]

A more technologically modern twist on what counts as the relevant copy is *Capitol Records, LLC v. ReDigi Inc.*[205] ReDigi pitched itself as a digital used music store. The ReDigi Media Manager would allow a user to upload music files from their computer to ReDigi's servers.[206] Immediately after transmitting the bits for each sector of data from a file, Media Manager would delete that sector from the user's computer. After completing the transfer, Media Manager would monitor the user's computer to make sure that the file did not reappear. Once uploaded, the user could (1) stream the file to themselves, (2) download the file to a computer (with the same sector-by-sector deletion process taking place in reverse), or (3) sell the file to another ReDigi user (with ReDigi taking a commission), in which case the seller would lose and the buyer would gain the ability to do (1) through (3).

In short, ReDigi was a virtual first sale play. It argued that it had digitally replicated the structure of first sale: any file that entered its system existed in only one place at a time, and only one user at a time had access.

The courts, however, disagreed. The initial upload was a reproduction – a new copy on ReDigi's servers, never mind what happened to the old copy on the user's computer. Thus, the upload was infringing because first sale does not apply to the reproduction right, and the transfer to another user was also infringing because first sale does not apply to distribution of an unlawfully made copy.

203. Doan v. Am. Book Co., 105 F. 772 (7th Cir. 1901).

204. In law school, I would take my heavy casebooks to a copy shop, have the hardback cover chopped off, and have them divided into multiple smaller paperback units. On several occasions, I had to explain to the employees helping me why this was legal; I was not asking them to *reproduce* anything.

205. Capitol Recs., LLC v. ReDigi Inc., 934 F. Supp. 2d 640 (S.D.N.Y. 2013).

206. ReDigi only allowed users to upload music in the AAC format purchased from the iTunes Music Store. Does this make a difference?

2 Fair Use

Fair use is partially codified in Section 107 of the Copyright Act, which is important enough to be worth quoting in full:[207]

207. 17 U.S.C. § 107.

> 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.

The four fair use factors are a checklist of questions to ask about the facts in a given case, not a majority vote. They interrelate, and they are not all of equal importance.[208] I find it helpful to break the factors down into a slightly more detailed checklist:

208. The factors are misordered in the statute. Logically, the nature of the work comes first, followed by the factors that discuss the use and its relationship to the work.

- Factor one ("purpose and character of the [defendant's] use"):
  - Is the use for *criticism*, *comment*, or another use specifically mentioned in the flush text at the start of section 107? These uses all involve the circulation of useful knowledge in society. These uses have substantial spillover civic benefits, so fair use particularly encourages them.
  - Is the use *commercial* or *noncommercial*? Noncommercial uses can still infringe, and commercial uses can be fair use, but as a general matter, commercial uses face a higher burden to show fair use than noncommercial ones.
  - Is the use *transformative*? Transformative uses, in which the work is used in "the creation of new information, new aesthetics, new insights and understandings,"[209] are substantially favored in fair use, to the point that a highly transformative use is almost always a fair use.
- Factor two ("nature of the [plaintiff's] copyrighted work"):
  - Is the work primarily *expressive* or primarily *informational*? Expressive works receive the default level of protection, but informational works, in which the copyright is thinner to start with, are less protected by fair use.
  - Is the work *published* or *unpublished*? Published works receive the default level of protection, but unpublished works receive heightened protection here because the defendant has disrupted the author's traditional privilege to control whether, when, and how their work is first shared with the public.
- Factor three ("amount and substantiality of the portion used"):
  - How much did the defendant copy *quantitatively* from the plaintiff's work? The greater the borrowing, the weaker the case for fair use. In the extreme limit of no copying, there is not even substantial similarity, so fair use is unnecessary. Complete verbatim copying can still be a fair use, but it typi-

209. Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105 (1990).

cally requires a good justification for copying all of the work, rather than just a portion.

  - How *qualitatively* important were the copied portions to the plaintiff's work? Some elements of a work may constitute its "heart," with the most expressive value and greated commercial appeal. Copying these elements requires a stronger fair-use justification than copying more peripheral elements.
  - How extensive was the defendant's copying in light of any proffered *justifications*? When a use is transformative, or necessary for news reporting, etc., these rationales typically justify copying some portions of the work. Copying more, beyond the needs of this justification, weakens the fair-use argument. A book review can appropriately quote complete paragraphs, but not complete chapters.

- Factor four ("effect of the use upon the potential market"):
  - What is the *relevant market*, and is it one the plaintiff can legitimately claim a right to? This is a necessary scope-defining question. The market in which the copyright owner sells the work (e.g. fine art prints or streaming video) is relevant. So too are " traditional, reasonable, or likely to be developed"[210] licensing markets.
  - Did the plaintiff suffer losses because the defendant's work *substituted* for her own, or for some other reason? A negative book review may reduce demand for the plaintiff's novel, but not because the review satisfies the interest that readers have for the author's expression in the novel. Only losses due to substitution, which the defendant uses the plaintiff's own work to satisfy the audience's demand for the work, count.

- Miscellaneous:
  - Did the defendant give appropriate *attribution* to the plaintiff's work as a source? In a borderline case, the defendant's honesty about the copying, or dishonesty in trying to hide it, can nudge the analysis.
  - Did either party engage in any *dishonest or illegal* conduct that bears directly on the copying? There are faint traces of trade secret's concern for ethical business practices in the fair use inquiry; defendants who work with stolen copies of the work may be slightly dinged for it.
  - Is there *anything else* significant in the facts not already accounted for? This is extremely rare, but fair use is a broad inquiry, so you never know. Ask this question to prompt your thinking, but most of the time anything you come up with will fit comfortably in one of the four factors.

210. Am. Geophysical Union v. Texaco Inc., 60 F.3d 913, 930 (2d Cir. 1994).

It is sometimes said that fair-use cases are inherently uncertain, fact-bound, open-ended, and impossible to predict. It is true that fair use is

a standard rather than a rule, but this critique is overstated. The vast majority of fair-use cases fit comfortably within a handful of patterns, and once a case is grouped with others from the same pattern, the inquiry is typically significantly more determinate.[211] You should be able to do a full four-factor analysis, but also able to recognize that you are looking at a parody case or a home consumer use case and narrow your analysis accordingly. This is not a copyright course, so we will not cover all of the patterns in detail.

211. Pamela Samuelson, *Unbundingl Fair Uses*, 77 Fordham L. Rev. 2537 (2009); Michael J. Madison, *A Pattern-Oriented Approach to Fair Use*, 45 William & Mary L. Rev. 1525 (2004).

News Reporting

We start with *news reporting*, one of the statutorily favored purposes. This includes traditional mass media like newspapers, magazines, and network-television evening news. But what matters is the act of reporting the news, not the status of being a professional reporter. Consider, for example, *City of Inglewood v. Teixeira, No. 15-cv–01815*, where Joseph Texeira edited clips from the video recordings of the Inglewood City Council, where he lived.[212] He recut these recordings into length videos, with titles like "James T. Butts Jr. Misleads the Public About His Voter Registration," added captions and his own criticism of the councilmembers, and posted them to YouTube from an account named Dehol Truth. Inglewood sued him for copyright infringement, and he raised a fair-use defense.

212. City of Inglewood v. Teixeira, No. 15-cv–01815, 2015 WL 5025839 (C.D. Cal. Aug. 20, 2015).

A still from one of Teixeira's videos

Start with factor *two*, the nature of the work. It strongly favored Texeira because the videos were more informational than expressive; they described the works of government. There is a strong public interest in having access to this information and governments do not need copyright's incentives to have council meetings or to film them. Indeed, they are required by law to meet publicly and to make their records public.[213]

213. While local governments *can* have a copyriught in the works they create, the court held in the alternative that California law did not actually authorize local governments to do so.

On factor one, the purpose and character of the use, Texeira was engaged in reporting on local politics by publicizing and helping viewers understand the issues at stake in the council meetings. It was probably noncommercial (the city's allegations to the contrary notwithstanding), because he as making the videos available for free and they had miniscule viewership (typically around 200–300 views each). Most importantly, his use was transformative. He transformed the *content* of the videos by recutting them and overlaying his own narration. The resulting videos create substantially different impressions and have substantially different effects on viewers. He also transformed the *purpose* of the videos, changing them from straight records of meetings into a critical commentary on the meetings. He ridiculed councilmembers' physical tics and nervousness, and pointed out sections in which he claimed they were lying.

Criticism is important enough to warrant a short digression. Critical uses are both important and in particular need of fair use protections, because copyright owners may be especially and unreasonably inclined to suppress them. Few people enjoy being criticized or mocked, and criticism can destroy public interest in a work. So even if one is inclined

to think that copyright owners will generally license genuinely valuable uses, criticism may be an exception where licensing markets will break down.

On factor three, the amount used, Texeira used clips of a few seconds or minutes from council meetings that ran for hours. His own videos consisted mostly of copied clips, but overlaid with new captions, music, and commentary. So this copying was quantitatively substantial in relation to his edited videos but less so in relation to the source videos. It was, however, qualitiatively minor; he had not lifted out the sections that had particular expressive or commercial value, because there were no such sections. And, most importantly, given Texeira's transformative purpose, his copying was necessary to that purpose. He needed to show the councilmembers acting nervously to make his point that they were nervous; he needed to show their words to make his point that they were lying. Neither of these responses would have been as effective if he had described the meeting without showing it.

On factor four, the effect on the market, there was no effect because there was no market. The City did not make money from the videos, and could not have. State law prohibited public agencies from charging more than the "direct costs of duplication."[214] And even if it could have, Texeira's criticism was not a market substitute; someone wanting to know what happened in the council meeting could not have found out from Texeira's videos, which presented only a small fraction of the council's business.

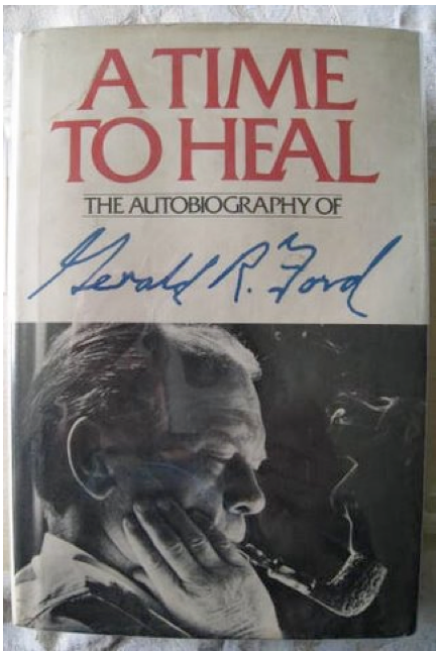
Not all reporting cases result in a fair-use finding. In *Los Angeles Times v. Free Republic*, the defendant's online board contained complete copy-pasted copies of newspaper articles.[215] While the articles were informational (factor two), the purpose of enabling discussion of those articles (factor one) on the board did not justify pasting the complete articles (factor three). And once they were pasted, they allowed board members to avoid buying copies of the newspapers or paying for online subscriptions (factor four).

And in *Harper & Row, Publishers, Inc. v. Nation Enterprises*, the Supreme Court rejected a fair-use argument by *The Nation* magazine when it got its hands on a prepublication copy of ex-President Gerald Ford's memoirs and ran an article about its contents, including some substantial quotes.[216] Here, the memoir was a mix of informational and expressive but unpublished (factor one) and the use was commercial, for news reporting, and mildly transformative (factor two). Although the quotations were quantitatively minimal (about 300 words from a 200,000 book), they were more substantial in relation to the article (about 2,250 words) and they included some of the details of greatest public interest, such as Ford's thoughts about pardoning his predecessor, Richard Nixon (factor three). It was the effect on the market (factor four) that probably decided the case. Harper & Row was in the book business, not the magazine business, so this was not a direct case of competition. But *Time* magazine agreed to pay $25,000 for the right to excerpt 7,500 words from the book shortly before it appeared in stores. When *The Na-*

214. Cal. Gov. Code § 6253(b)

215. L.A. Times v. Free Republic, No. 98-cv07840, 2000 WL 565200 (C.D. Cal. Apr. 4, 2000).

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



A Time to Heal

tion ran its article, *Time* cancelled the contrast. This was direct, proven, market harm, fairly attributable to competition from the infringing article.

Expressive Transformations

Another important pattern of fair uses are parodies, remixes, and other highly expressive transformations. Unlike reporting (and teaching and scholarship), which make use of the work for largely informational purposes, these uses rely on the work's expressive content for expressive effect. There is a greater concern, then, that these uses may compete in the same markets for the same audiences as the original work. But at the same time, some of them can make compelling expressive cases to be allowed to.

Take, for example, *Campbell v. Acuff-Rose Music, Inc.*, another Supreme Court fair-use case. The popular and profane rap group 2 Live Crew recorded a song called "Pretty Woman," which starts with the famous guitar riff from Roy Orbinson and William Dees's "Oh, Pretty Woman," and borrows elements of the melody, harmony, and arrangement, but with different (and much dirtier) lyrics. Unlike in the news-reporting cases above, here the plaintiff's work was published and expressive, and here the defendants were selling in the same formats and distribution channels as the plaintiff: records, cassettes, CDs, live performances, and radio airplay. In addition, the copying here was arguably more extensive; there is a case that the hook was the "heart" of "Oh, Pretty Woman," and the musical borrowings ran all through "Pretty Woman."

Still, the Supreme Court held that fair use could apply, because parodies are typically transformative, "altering the first with new expression, meaning, or message."[217] A parody comments on the original work to make it seem ridiculous, and for this, it needs to make use of the original: "Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim's (or collective victims') imagination."[218] The Court then appealed to *Bleistein*'s "dangerous undertaking" language to tell courts not to ask whether the parody is smart or dumb, funny or plodding. As long as the parody "reasonably could be perceived as commenting on the original or criticizing it, to some degree," it is transformative for first-factor purposes. Here is how Justice Souter, a quiet and reserved New Englander, described the song:

> While we might not assign a high rank to the parodic element here, we think it fair to say that 2 Live Crew's song 2 Live Crew juxtaposes the romantic musings of a man whose fantasy comes true, with degrading taunts, a bawdy demand for sex, and a sigh of relief from paternal responsibility. The later words can be taken as a comment on the naivete of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies. It is this joinder of reference and ridicule that

Roy Orbison

Pretty Woman

217. The Court pointed to earlier cases like *Fisher v. Dees*, where a song titled "When Sonny Sniffs Glue," a parody of "When Sunny Gets Blue," was fair use, and *Elsmere Music, Inc. v. National Broadcasting Co.*, where a *Saturday Night Live* parody of "I Love New York" called "I Love Sodom" was fair use.
218. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994).

> marks off the author's choice of parody from the other types of comment and criticism that traditionally have had a claim to fair use protection as transformative works.

The fourth factor is also worth dwelling on. Note that as a factual matter, listeners are unlikely to regard the Roy Orbison original and the 2 Live Crew paraody as substitutes; the itch to listen to one of them cannot generally be scratched by the other. But there is also potentially a licensing market for a rap cover version of "Oh, Pretty Woman," and that *authorized* rap version and the *unauthorized* parody could well be substitutes. This is where the parody justification becomes important; an uncritical and unironic rap cover might not be transformative to the same degree. Sometimes parody arguments succeed; sometimes they fail. For example, in *Dr. Seuss Enterprises, LP v. ComicMix LLC*, a *Star Trek*-themed parody of Dr. Suess's *Oh, the Places You'll Go!* titled *Oh, the Places You'll Boldly Go!* was[219] *Oh, the Places You'll Boldly Go!* not fair use.[220]

And finally, in a footnote, the Court made an important point about good and bad faith. 2 Live Crew had asked for permission from Acuff-Rose Music, which held the copyright to "Oh, Pretty Woman." The correspondence went as one might expect. Acuff-Rose's final rejection,"I am aware of the success enjoyed by 'The 2 Live Crews', but I must inform you that we cannot permit the use of a parody of 'Oh, Pretty Woman,'" raises questions already answered by its final rejection. The Court held that this failed negotiation should not be treated as a concession that a license was required. Good faith is not required for fair use, and

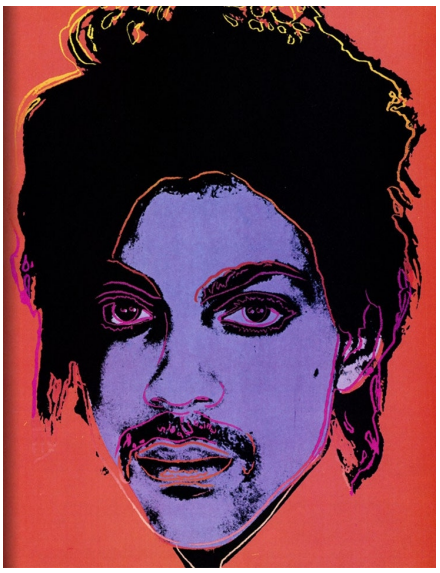
> 2 Live Crew's actions do not necessarily suggest that they believed their version was not fair use; the offer may simply have been made in a good-faith effort to avoid this litigation. If the use is otherwise fair, then no permission need be sought or granted. Thus, being denied permission to use a work does not weigh against a finding of fair use.

For a contrasting case finding no transformative fair use, consider *Andy Warhol Foundation for the Visual Arts v. Goldsmith*.[221] In 1981, Lynn Goldsmith, a professional photographer, took a series of black-and-white photographs of the musician Prince in her studio. In 1984, Goldsmith licensed one particular photograph from the series to the magazine *Vanity Fair* as an "artist reference" for $400. The license stated, "It can appear one time full page and one time under one quarter page. No other usage right granted."[222] *Vanity Fair*, in turn, commissioned the pop artist Andy Warhol to create a portrait of Prince based on the photograph. Warhol prepared 14 silkscreen prints (in different colors) and two pencil sketches, collectively called the "Prince Series." One of the prints (titled "Purple Fame") illustrated an article on Prince in the November 1984 issue of *Vanity Fair*. Over the next several decades, she regularly licensed her photographs of Prince to other magazines.

Prince died in 2016. Condé Nast (*Vanity Fair*'s publisher) ap-

219. images/boldlygo.jpg
220. Dr. Seuss Enters., LP v. ComicMix LLC, 983 F.3d 443 (9th Cir. 2020).
221. Andy Warhol Found. for the Visual Arts v. Goldsmith, 143 S.Ct. 1258 (2023).

Goldsmith's photograph of Prince



Purple Fame, as used in the November 1984 issue of *Vanity Fair*

proached the Andy Warhol Foundation for the Visual Arts (or "AWF")[223] about relicensing Purple Fame for a special commemorative magazine, titled "The Genius of Prince." The AWF informed Condé Nast about the entire series of images, and Condé Nast ended up licensing a different print, "Orange Prince" for use on the cover of the magazine. The licensing fee was $10,000. Goldsmith saw Orange Prince on "The Genius of Prince," and recognized that it was based on one of her photographs. Litigation ensued, and focused on the first factor.

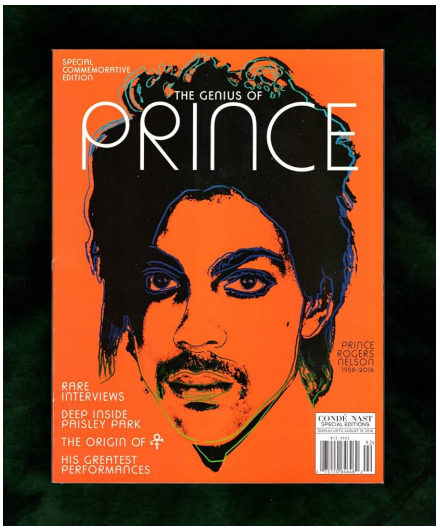
The Supreme Court held that "Even though Orange Prince adds new expression to Goldsmith's photograph, . . . in the context of the challenged use, the first fair use factor still favors Goldsmith." It emphasized that transformativeness is a "a matter of degree, and the degree of difference must be weighed against other considerations, like commercialism.[224] In its view, the relevant context was licensing images for use in stories about celebrities, and "[i]n that context, the purpose of the image is substantially the same as that of Goldsmith's photograph. Both are portraits of Prince used in magazines to illustrate stories about Prince."[225] Moreover, this was a commercial context, one where artists are normally paid for a license to use their works.

The Court also emphasized that other transformative uses add more of a different purpose. In addition to "Pretty Woman" from *Campbell*, it pointed to Warhol's famous silkscreen prints of Campbell's Soup cans:

> His Soup Cans series targets the logo. That is, the original copyrighted work is, at least in part, the object of Warhol's commentary. It is the very nature of Campbell's copyrighted logo – well known to the public, designed to be reproduced, and a symbol of an everyday item for mass consumption – that enables the commentary.[226]

The AWF argued that there was a difference in meaning and aesthetics because the Prince Series portrayed him as "an iconic, larger-than-life figure," and commented on "the dehumanizing nature of celebrity."[227] But the court thought that Orange Prince didn't make enough of a commentary on Goldsmith's photograph to outweigh the commerciality of the directly competing uses.[228]

The Court specifically avoided weighing in on whether Warhol's creation of the unlicensed fifteen images in the Prince Series other than Purple Fame were fair use. So one possibility is that only Purple Fame was legally made, the other fifteen have always been infringing derivative works, and fair use protects none of them under any circumstances – so that it is infringement for collectors to sell them (public distribution) or for the Andy Warhol Museum in Pittsburgh to display the four it owns (public display). Another possibility is that they were legally made (perhaps under fair use, or perhaps as part of the license allowing Warhol to experiment with different colors), and so first sale allows them to be sold and exhibited in person, but that they cannot be licensed commercially without Goldsmith's permission.[229]



Orange Prince, as used on the cover of "The Genius of Prince"

222. *Id.* at 1267.
223. Warhol died in 1987, and left his estate to the AWF.
224. *Andy Warhol Found. for the Visual Arts*, 143 S.Ct. at 1273.
225. *Id.* at 1278.
226. *Id.* at 1281.
227. *Id.* at 1282.
228. *Id.* at 1284–85.
229. Either way, is this factor one or factor four at work?

Consumer Uses

A third pattern of fair-use cases involves consumer home copying. The crucial case here is *Sony*. In addition to holding that Sony could not be contributorily liable if the Betamax had substantial non-infringing uses, the Court also held that the Betamax did indeed have substantial non-infringing uses. These included authorized recordings of shows with permission of the copyright owners. But they also included at least some *unauthorized* recordings protected as fair use.

The Court focused on "time-shifting": recording a program to watch later. Notice how unappealing time-shifting is on a transformative-use view of the four factors. The works are expressive and published (factor two), and the defendant makes a wholly non-transformative use (factor one) by copying the entire work (factor three). True, home taping is non-commercial, but these are uses that are all about experiencing the copyrighted work as it was intended to be experienced, rather than about creating new works.

But even if consumers do not have a strong fair-use argument for time-shifting home taping *as authors*, they have a strong fair-use argument *as audiences*. There is a privacy argument here; these are copies being made and enjoyed within a household. There is an economic argument, too: time-shifting *expands* the audience for broadcast programs, rather than *narrowing* it, and broadcasters were paid (by advertisers) based on total viewership. And there is a kind of argument from fairness and reciprocity: broadcasters have already invited viewers to watch their programming, and that invitation should come with a freedom to make incidental copies in the course of doing what they have been invited to do.

Sony did not rule on whether consumers had a fair-use right to build up large libraries of tapes, or to make tapes and sell them to strangers. But the Napster cases held that garden-variety file-sharing was infringing, and the copyright industries sued a large number of individual uploaders and downloaders of copyrighted movies, TV shows, and music. So one important limit on the *Sony* fair-use principle is almost certainly its limitation to private use by an individual, or within a household.

In the 2000s, a generation of digital video recorders disrupted the equilibrium between viewers and copyright owners. VCRs were finicky beasts that made sometimes-grainy copies and that required careful programming to make work correctly.[230] Tapes cost money, and many people's tape collections were bulky and poorly labeled. But a DVR with a large hard drive could store many hours of recordings, tape shows automatically at specified times, keep perfect track of one's collection, play back in perfect high-resolution fidelity, and fast-forward through commercials – or even skip them entirely.

The litigation in *Fox Broadcasting Co., Inc. v. Dish Network LLC* over Dish's Hopper set-top DVR is a good example.[231] The Hopper, available to anyone who subscribed to Dish's satellite TV service, had a feature called PrimeTime Anytime: programming on the four major broadcast

230. There is a reason that jokes about VCR clocks blinking "12:00" were a staple of 1980s–90s comedy. Everyone who ever successfully programmed a VCR to tape a program at a specific time should get a medal.

231. Fox Broad. Co., Inc. v. Dish Network LLC, 723 F.3d 1067 (9th Cir. 2013).

The Dish Hopper

networks (including Fox) every night of the week: by pushing two buttons, the user could automatically record every prime-time program on the four major networks (ABC, CBS, Fox, and NBC) for a week. Another feature, called AutoHop, would skip over all commercials with the push of another button.

This is, like *Sony*, a secondary-liability case.[232] But do Dish's users infringe at all? The VCR could in theory be used to make bootleg taps for sale; the Hopper could not. So if there is infringement here, it would have to be because either (1) bulk recording of dozens of shows is different than recording a single show, or (2) systematic commercial-skipping is different than watching them, or fast-forwarding through them manually. But in *Fox Broadcasting*, the Ninth Circuit held that PrimeTime Anytime was still fair use. As in *Sony*, it was home non-commercial taping (factor one) of expressive works (factor two) in their entirety (factor three). And there was still no proof of market harm. Even though Fox licensed its shows to Hulu for streaming on demand and Apple for downloads, the *market harm*, if any, was due entirely to commercial-skipping with Autohop. But:

> Fox owns the copyrights to the television programs, not to the ads aired in the commercial breaks. If recording an entire copyrighted program is a fair use, the fact that viewers do not watch the ads not copyrighted by Fox cannot transform the recording into a copyright violation. Indeed, a recording made with PrimeTime Anytime still includes commercials; AutoHop simply skips those recorded commercials unless a viewer manually rewinds or fast-forwards into a commercial break. Thus, any analysis of the market harm should exclude consideration of AutoHop because ad-skipping does not implicate Fox's copyright interests.

Persuasive?

Miscellaneous

Some other common patterns of fair use include:

- Incidental background uses, of the sort that could also be dismissed as *de minimis*.
- Uses as evidence in litigation or other legal processes, e.g., to prove that the copyright owner published a defamatory book, or that the copyright owner's research was prior art for a patent application.
- Uses in comparative advertising, product reviews, etc. to establish characteristics of the copyriught owner's products.
- Various common search-engine practices designed to make the Internet more navigable, such as shownng small "thumbnail" previews of image results.

Finally, fair use is sometimes asserted to try and patch up a near-miss argument under one of copyright's other defenses. For example, even

232. Could you make an argument that Dish is the *direct* infringer? *Hint*: focus on the volitional-conduct doctrine.

though ReDigi lost on first sale, it also raised a fair-use defense – in essence, trying to use fair use to honor the spirit, if not the letter, of first sale. The court there, noting the commercial reproduction and exchange of complete expressive works in competition with the copyright owner, denied fair use.

Documentary Clearance Problem

Your client, Chicory Pictures, is producing a documentary about the New Orleans second line music scene. The producers have preliminarily flagged the following potential copyright issues for review:

- At several points in the documentary, billboards, murals, and storefronts are visible in the background.
- Various musicians and crowd members are interviewed on camera.
- The closing of the documentary is an unbroken eight-minute shot of one the bands playing an extended version of "When the Saints Go Marching In." (The song is in the public domain.)
- A two-minute montage of musicians getting dressed is currently set to Professor Longhair's "Mardi Gras in New Orleans."
- At one point during an interview, a car rolls by with the windows open blasting Outkast's "Hey Ya!" The interviewee breaks up laughing and gives the driver a wave, before returning to the question.
- At least half a dozen songs are heard in segments ranging from ten to thirty seconds during other shots of the bands performing.

The producers set aside $10,000 for licensing, out of a total budget of $120,000. What is your advice?

Chicago HOPE Problem

You represent Shepard Fairey, creator of the famous Obama "HOPE" poster . Fairey created the poster to support Obama, then licensed it for free to the Obama campaign, and the campaign has given out tens of thousands of prints to supporters and it has been distributed widely for free online. Fairey, who started as a street artist, became significantly more famous as a result of the poster and the publicity it received.

With your help, Fairey has sued the Associated Press, which holds the copyright to a photograph of Barack Obama taken by Mannie Garcia, for a declaratory judgment that the poster does not infringe the AP's copyright in the photograph. The original AP photograph was used to illustrate a news story about a campaign event and then offered for licensing through a stock photography bureau. The Associated Press claims that that Fairey copied the design for the HOPE poster from the Garcia photograph.

Obama "HOPE" poster by Shepard Fairey

Obama photograph by Mannie Garcia

Fairey's suit against the AP denied that he had copied from the Garcia photograph (so that any similarities were purely coincidental,) and also argued in the alternative that even if he had worked from the Garcia photograph, it qualified as a fair use.

It has now emerged in discovery that Fairey did in fact work from the Garcia photograph, that he destroyed evidence showing his creative process, and that he lied under oath in trying to conceal the fact that he had used the photograph as a source.

What should you do?

3 Miscellaneous

Section 512 of the Copyright Act, added as part of the Digital Milennium Copyright Act of 1998, provides a "safe harbor" for various online intermediaries for users' infringing acts.[233] It has generated an immense amount of caselaw, the details of which are best left for a course in Internet law.

The Copyright Act includes several statutory licensing schemes for cable television[234], for webcasting[235], for cover versions of songs,[236], for jukeboxes,[237] for works used in non-commercial broadcasting,[238] and for satellite broadcasting.[239] The broadcasting licenses are best thought of as portions of the Telecommunications Act that have been codified in the Copyright Act by mistake. The musical licenses are discussed in more detail in the Music chapter.

Other provisions of the Copyright Act provide specific defenses for uses that are considered socially valuable. Section 108 gives libraries and archives a variety of privileges to reproduce and distribute copies of items in their collections.[240] The section reflects a heavily negotiated balance between libraries' missions of preservation and public access on the one hand, and copyright owners' concerns about unrestricted copying on the other. It institutionalizes and protects standard library practices, but is ringed with limitations that prevent them from being extended to new circumstances and that limit the total volume of public demand that libraries can satisfy. Section 108(c), for example, allows for the duplication of up to three copies of a published work "that is damaged, deteriorating, lost, or stolen, or if the existing format in which the work is stored has become obsolete" if an "unused replacement cannot be obtained at a fair price."[241]

Section 121, which allows for reproductions and distributions "in specialized formats exclusively for use by blind or other persons with disabilities," is to similar effect.[242] A prototypical example is an audio edition of a printed book, recorded without the permission of the copyright owner, by a nonprofit that specializes in creating such editions (e.g. Learning Ally), distributed on a CD in the Digital Accessible Information System (DAISY) file format, for use on a DAISY player with large buttons marked in Braille. The existence of Section 121 is an admission that access for the disabled is often not a priority for copyright owners. Some are concerned about piracy from accessible digital editions, some

233. 17 U.S.C. § 512

234. 17 U.S.C. § 111.
235. 17 U.S.C. § 114.
236. 17 U.S.C. § 115
237. 17 U.S.C. § 116
238. 17 U.S.C. § 118.
239. 17 U.S.C. §§ 119, 121.

240. 17 U.S.C. § 108

241. 17 U.S.C. § 108(c)

242. 17 U.S.C. § 121.

don't see enough potential for profit to make accessible editions, and many simply have not thought about it at all.

At the same time, Section 121 is locked into an ableist model that treats accessible editions as a specicial concession to the disabled, rather than conceptualizing meaningful accessibility for all as the goal. For one thing, building accessibility into the publication workflow makes every work accessible as a matter of course, rather than relying on nonprofits to create after-the-fact accessible editions at much greater expense. For another, accessibility features are often valuable for readers and viewers who do not consider themselves disabled. Hearing people who like watching movies with closed captions enabled have disability activists to thank, just like every skateboarder and parent with a stroller who has been grateful for curb cuts.

Thus, it is notable that probably the single greatest expansion of library use and disaibility access in a generation came about *not* through Section 108 or Section 121, but through fair-use litigation. When authors and publishers sued Google and its library partners for scanning millions of books, the National Federation of the Blind intervened as a defendant, arguing that the scanning had the potential to make books accessible on a much wider scale. Several of the libraries began providing access to their digital copies of the books to print-disabled students. This, the courts held, was a fair use.[243] It was nontransformative copying of complete expressive works, but the effect on the market was miniscule, *precisely because publishers had not traditionally cared about creating disabled editions*. The publishers argued that Section 108 should be read as setting the outer limits of library copying, and one can imagine a similar argument about Section 121 setting the outer limits of copying for accessibility. But the courts held instead that Section 121, like the Americans with Disabilities Act, expressed a policy of favoring such uses, and one can imagine a similar argument about Section 108.

243. Authors Guild, Inc. v. HathiTrust, 755 F.3d 87 (2nd Cir. 2014).

H Paracopyright

The Digital Milennium Copyright Act of 1998 added a new Chapter 12 to the Copyright Act, prohibiting several new types of conduct. As interpreted by the courts, Congress did *not* declare these to be new species of infringement. Instead, they are a kind of paracopyright: they protect similar interests using similar techniques, but with a fraught and ambiguous relationship to many copyright doctrines, especially subject matter and defenses.

1 Anticircumvention

A ***digital rights management*** (***DRM***) (also called a ***technological protection measure*** or TPM) system allows users to interact in some ways with media while preventing them from freely copying it. Section 1201 of the Copyright Act prohibits users from disabling the DRM on copyrighted works. More specifically, section 1201(a)(1)(A) provides:

> No person shall circumvent a technological measure that effectively controls access to a work protected under this title.

Multiple terms here need to be unpacked, and section 1201(a)(3) provides definitions:

(A) to "circumvent a technological measure" means to descramble a scrambled work, to decrypt an encrypted work, or otherwise to avoid, bypass, remove, deactivate, or impair a technological measure, without the authority of the copyright owner; and

(B) a technological measure "effectively controls access to a work" if the measure, in the ordinary course of its operation, requires the application of information, or a process or a treatment, with the authority of the copyright owner, to gain access to the work.

The most common form of DRM, which is squarely covered by these definitions, is a program that encrypts media (such as a song or video) and decrypts it only during playback, and only when the user is properly authenticated and authorized.

A classic early section 1201(a) case was *Universal City Studios, Inc. v. Corley*. DVDs were protected by a system called the Content Scramble System (CSS)[244] that decrypted the contents of a DVD only when it was inserted in a properly licensed DVD player. A Norweigan teenager extracted the secret key from a DVD-playing program and used it to write a program called DeCSS that could rip an unencrypted copy of the contents of a DVD. The courts easily held that DeCSS violated section 1201(a). DeCSS effectively protected copyrighted works (movies) because it required the application of information (the secret key) and a process (decryption) to gain access to the work. DeCSS circumvented it because it decrypted encrypted works (the movies) without permission from the copyright owners. (Note that authorized players did exactly the same thing, but with permission.)

244. Not to be confused with Cascading Style Sheets.

Section 1201(a) has its own, custom-drafted secondary liability rules. Section 1201(a)(2) makes it a violation to "manufacture, import, offer to the public, provide, or otherwise traffic in" a circumvention technology, defined as one that:

(A) is primarily designed or produced for the purpose of circumventing a [TPM];

(B) has only limited commercially significant purpose or use other than to circumvent a [TPM]; or

(C) is marketed by that person or another acting in concert with that person with that person's knowledge for use in circumventing a [TPM].

These three tests codify mutant versions of the contributory and inducement infringement tests.[245] (A) is an inducement-ish test about the defendant's "primary purpose." (B) is a contributory-ish test about the balance of prohibited and innocent uses that replaces *Sony*'s "capable of substantial noninfringing use" with "only limited commercially significant purpose or use." And (C) is another inducement-ish test that

245. Section 1201 predates *Grokster*, so the divergence is not entirely shocking.

focuses on how the technology is "marketed." Most strikingly, there is no requirement of underlying infringement. These rules prohibit trafficking in circumvention technologies, whether or not anyone uses them to infringe.

Note also what is missing from both the "direct" circumvention rule of 1201(a)(1) and the "secondary" trafficking rules of 1201(a)(2): most of copyright law. The whole apparatus kicks in if the TPM is being used to protect copyrighted works, and the copyright owner's permission is a complete defense. But other than that, the usual copyright defenses – fair use, first sale, etc. – are nowhere to be seen. Indeed, because circumvention and trafficking are not defined as copyright infringement, the courts have held that the usual defenses are not available. Thus, even if a DVD-ripping tool is only used for blatantly fair uses (e.g., by film-studies teachers to grab short 15-second excerpts of classic movies for critical classroom discussions of their cinematography and screenplays), *fair use is not a defense to 1201*, as the courts held in the DeCSS cases.[246]

Section 1201's power and loose connection to the rest of copyright law have made it an attractive cause of action well beyond protecting core DRM business model like movie rentals and device-locked music downloads. And this expansion has drawn pushback from courts that have looked for ways to tie it more closely to protecting copyrighted works.

In *Chamberlain Group, Inc. v. Skylink Techs., Inc.*, Chamberlain made garage doors that used a "rolling code" system to change the specific signal that would cause them to open. Skylink universal garage-door openers that sent a sequence of signals that would cause a Chamberlain rolling-code system to reset and open the door. Chamberlain objected to the competition and sued under section 1201(a)(2), arguing that the software in its garage doors was a copyrighted work, and that the rolling-code system was a TPM, and that Skylink's universal openers circumvented the system. The court held that section 1201 "prohibits only forms of access that bear a reasonable relationship to the protections that the Copyright Act otherwise affords copyright owners"[247] – in other words, even if there is not a strict requirement that there be an underlying act of infringement, there must be at least a "reasonable relationship" to infringement.

In a similar case, *Lexmark International v. Static Control Components*, Static Control Components made replacement toner cartridges for Lexmark printers. Lexmark put a small microchip in each of its cartridges to engage in a short "handshake" exchange of signals with the printer authenticating itself as an official Lexmark cartridge. SCC put a chip in its own cartridges to mimic those signals, and Lexmark claimed this was an act of circumvention because it bypassed a TPM protecting the software in the printer. The court held that it wasn't because the handshake did not actually "control access" to the software; anyone who bought a Lexmark printer already had access to the work:[248]

246. Universal City Studios, Inc. v. Reimerdes, 111 F. Supp. 2d 346 (S.D.N.Y. 2000).

247. Chamberlain Grp., Inc. v. Skylink Techs., Inc., 381 F.3d 1178, 1202 (Fed. Cir. 2004).

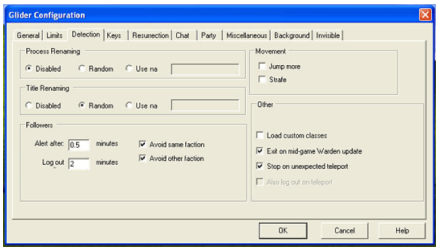
248. Lexmark Int'l v. Static Control Components, 387 F.3d 522 (6th Cir. 2004).

> Just as one would not say that a lock on the back door of a house "controls access" to a house whose front door does not contain a lock and just as one would not say that a lock on any door of a house "controls access" to the house after its purchaser receives the key to the lock, it does not make sense to say that this provision of the DMCA applies to otherwise-readily-accessible copyrighted works.

Both of these cases involved the attempted use of the DMCA to protect a fundamentally non-copyright-based business model. *MDY Industries, LLC. v. Blizzard Entertainment, Inc.* was a harder case.[249] The case involved Blizzard's World of Warcraft online game. Michael Donnelly created and sold a bot program called Glider that would play the game for users, allowing them to level up their characters more quickly and accumulate gold. Blizzard considers the use of bots cheating and added a feature to WoW called "Warden" that would eject a player from the online servers when it detected that a bot program is running. Donnelly reprogrammed Glider so that it could evade detection by Warden, and Blizzard alleged that this constituted a section 1201 violation.

249. MDY Indus., LLC. v. Blizzard Ent., Inc., 629 F.3d 928 (9th Cir. 2010).

World of Warcraft



Glider's configuration screen

The Ninth Circuit reasoned that Warden did not "effectively control access" to WoW's code or to the game's *static* art assets and sounds. All of these were available to users who had installed the game on their computers; they could view or listen to these assets without having to connect to the server. But Warden *did* effectively control access to the game's *dynamic* experience. Just as in Scramble, this dynamic "real-time experience of traveling through different worlds, hearing their sounds, viewing their structures, encountering their inhabitants and monsters, and encountering other players" was protected by copyright as an audiovisual work, even if some elements were player-generated. Since players could not "access" this audiovisual work without passing Warden's checks, that made Warden an effective TPM as to these dynamic elements. Thus, Donelly violated section 1201(a)(2)(C) by marketing Glider as a circumvention technology.

2 Copyright Management Information

Another component of DRM is keeping track of information about the works being protected. Sometimes, this takes the form of metadata describing the work, so that the DRM system can tell, for example, when to disable access because a user's rental has expired. Other times, it takes the form of "watermarks" embedded in the work, so that it can be detected (and possibly traced back) if a user removes it from the DRM system.

The drafters of the DMCA believed that the integrity of this ***copyright management information*** (or CMI) also played an important role in protecting DRM systems. Thus, they included in section 1202 a prohibition on falsifying, removing, or altering CMI. Falsification is prohbited if done "knowingly and with the intent to induce, enable, facilitate, or conceal infringement."[250] Alteration and removal are prohibited if done

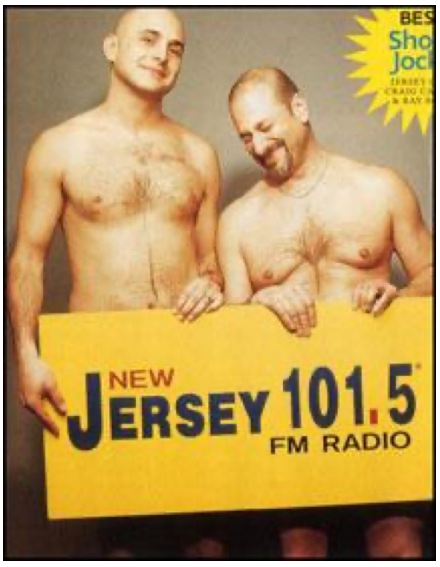
250. 17 U.S.C. § 1202(a).

"knowing or . . . having reasonable grounds to know that it will induce, enable, facilitate, or conceal an infringement."[251] Both provisions include a ban on distributing false/altered/removed CMI, with the same mental states.

Although the CMI provisions seem naturally adapted to DRM, they have been used far more broadly, in part because the definitions of CMI do not say anything about requiring it to be adapted for automated processing by a DRM system. They do say that CMI is "conveyed in connection with a work" and includes the the work's title, author's name, the copyright owner's name, licensing terms, and so on. That's broad enough to encompass photo credits and copyright pages, so a number of plaintiffs have successfully used section 1202 as a kind of quasi-attribution right.

In *Murphy v. Millennium Radio Group LLC*, for example, Peter Murphy took photographs of two radio hosts, Craig Carton and Ray Rossi, for an article in *New Jersey Monthly*. An employee at their radio station, WKXW, scanned the image and posted it to WKXW's website and MySpace page as part of a contest inviting users to Photoshop the image to humorous effect. The posted version lacked the printed credit to Peter Murphy that ran next to the photo in the magazine. The Third Circuit held that this was a section 1202 violation. Murphy's name was CMI, and the station posted the photo knowing that the CMI had been removed.[252]

251. 17 U.S.C. § 1202(b).



Murphy's photo

252. Carton was convicted of securities fraud in 2018 and served a year in prison. Among other episodes from their shock-jock careers, Carton and Rossi were heavily criticized in 2005 for anti-Asian comments.

Problems

Bizarro World Problem, Redux Redux

Recall the Bizarro World Problem from the Undeveloped Ideas chapter. How does your advice change in a world that has copyright law?

Digital Transition Problem

The Copyright Act of 1976 was written for an age of mass media: television and radio, newspapers and magazines, printed books, records and cassette tapes. Today, of course, we have computers and the Internet. Here are a few notable changes:

- It is much easier for individuals to create high-quality creative works.
- It is much easier to distribute creative works to a wide audience.
- As a corollary, audiences have access to creative works from a much wider variety of creators.
- It is much easier to make cheap, perfect copies of creative works.
- Many creative works are now made available via streaming media, rather than by distributing physical objects.

You are writing a study for the Copyright Office. How should the next Copyright Act adapt to these changes?