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Copyright and the First Amendment: Comrades, Combatants, or Uneasy Allies?

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Abstract

The copyright regime and the First Amendment seek to promote the same goals. Both seek the creation and dissemination of more, better, and more diverse literary, pictorial, musical and other works. But, they use significantly different means to achieve those goals. The copyright laws afford to the creator of a work the exclusive right to reproduce, distribute, transform, and perform that work for an extended period of time. The First Amendment, on the other hand, proclaims that Congress "shall make no law . . . abridging the freedom of speech or of the press," thus at least nominally indicating that limitations on the reproduction and distribution of works—including the works of others—are forbidden.

Courts, including the U.S. Supreme Court in Eldred v. Ashcroft, *have stated that these two regimes can be reconciled in large part by some mechanisms internal to the copyright system, and in particular the fair use doctrine and the denial of copyright protection to facts and ideas. Yet, the rejection of these two defenses in a number of prominent copyright infringement actions, and the resulting unavailability of unconstrained access to important materials, illustrates that, on occasion, broader application of First Amendment protection is necessary.*

This Article first explores the history, goals, and values of these two regimes. It concludes that not only has First Amendment protection been denied in important cases, but this denial has likely had a chilling effect in many other instances, in which socially valuable uses of copyrighted materials have been voluntarily forsaken for fear of litigation. The Article then offers a test for greater unconstrained access to otherwise protected

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works. First Amendment interests should prevail: when there is a strong public interest in allowing the unauthorized use of protectable expression; when the speaker has a compelling need to use the expression itself, i.e., when paraphrasing, describing, or summarizing the work is inadequate to meet the speaker's needs; and when there is no reasonable alternative available to obtain consent to that use.

Table of Contents

I. Introduction

The apparent conflict is obvious. The Copyright Clause in the Constitution provides that "[t]he Congress shall have Power . . . To promote the Progress of Science . . . by securing for limited Times to Authors . . . *the exclusive Right* to their respective Writings."[1] However, the First Amendment famously provides that "Congress shall make *no law* . . . abridging the freedom of speech, or of the press."[2] Because the copyright laws permit the copyright owner to enjoin others from speaking or writing,[3] or copying and distributing, certain words, music, photographs, audio-visual works and so forth, and to obtain monetary relief for such unauthorized acts, has Congress not done precisely what the First Amendment seems to preclude—enacted legislation which limits the speech or writing of persons other than the copyright owner?[4]

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1. U.S. CONST. art. I, § 8, cl. 8 (emphasis added).

2. U.S. CONST. amend. I (emphasis added).

3. Here, I am using the terms "speaking" and "writing" in the broadest sense, to include copying, distributing, performing and displaying a work—the exclusive rights given to the owner of copyright by 17 U.S.C. § 106(1) & (3)–(5), subject, of course, to a variety of limitations. 17 U.S.C. § 106(2) also gives the copyright owner the exclusive right to make, or to authorize others to make, "derivative works" from the underlying work. As discussed below, the scope of this right also raises serious First Amendment issues.

4. It is true that the immediate and direct cause of any abridgement of speech or writing almost always involves conduct taken at the behest of a private actor who seeks injunctive or monetary relief against alleged infringers. However, both the source of those rights and the authority for those lawsuits to enforce those rights is federal legislation. *See* 17 U.S.C. §§ 102–22 & 501–05 (2006) (setting out the contours of federal copyright protections). In turn, the Copyright Office of the Library of Congress affords mechanisms for the registration of copyrights. *Id.* §§ 408–12. Also, the federal courts have power to enter and then enforce judgments finding an infringement. *Id.* § 411. Finally, the *in terrorem* effect of the range of protections afforded to the copyright owner will often cause others to desist from using those works without the need to resort to private litigation.

In recognition of the fact that harm from limitations on speech can be as severe and problematic when the cause for the restraint is a private person or entity, it is clear that the First Amendment not only operates as a limitation on the government's restriction on speech, but also on many attempts by private parties to restrict the speech of other private parties. *See, e.g.*, Phila. Newspapers, Inc. v. Hepps, 475 U.S. 767, 777 (1986) (noting that "the text of the First Amendment . . . by its terms applies only to governmental action," but concluding that similar concerns and standards apply to suit by private party); N.Y. Times Co. v. Sullivan, 376 U.S. 254, 264 (1964) (applying the First Amendment to a private defamation action). *But see* Arista Records, Inc. v. Flea World, Inc., 356 F. Supp. 2d 411, 422 (D.N.J. 2005) (refusing to allow the defendant to argue that a copyright owner's enforcement actions had a "chilling effect" on its First Amendment rights, because "the First Amendment is generally a protection of free speech against intrusion by the government, not as among and between private parties").

Some have suggested that this conflict is more apparent than real. I will argue that at least in certain respects, this conflict is all-too-real,[5] and that the very threat of a possible copyright infringement action may impermissibly deter free speech. The conflict may be resolved in a number of ways. At one end of the spectrum, one could take the view that the copyright laws are unconstitutional. Even most free speech[6] maximalists[7] do not take that position.[8] At the other end, one could say that the copyright

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5. *See* Universal City Studios, Inc. v. Corley, 273 F.3d 429, 458 (2d Cir. 2001) (noting that "the fundamental choice between impairing some communication and tolerating [conduct which affects copyright interests] cannot be entirely avoided").

6. Professor Baker has argued that the freedom of speech and freedom of the press clauses protect different interests, and therefore have different implications for the interface of the copyright laws and the First Amendment. C. Edwin Baker, *First Amendment Limits on Copyright*, 55 VAND. L. REV. 891, 897–99 (2002). In part, his distinction is premised on a traditional version of speech—done by individuals—and of the press—typically undertaken by corporate entities, and usually requiring significant sums of money to publish and distribute works. Even accepting that those differences may at one time have been meaningful—and in fact that was not the nature of the press in 1791—they have considerably less vitality today, where the proliferation of "blogs" and Facebook pages demonstrates that anybody with a computer and access to the Internet can be a "publisher," and where a significant component of "speech" occurs on broadcast media controlled by multi-billion dollar entities.

Therefore, I use "freedom of speech" to include "freedom of the press." References to "free speech" should be understood to encompass the full range of interests in unfettered expression encompassed by the First Amendment—not only a "free press," but also the right "peacefully to assemble and to petition the Government for a redress of grievances." U.S. CONST. amend. I.

7. The paradigm of a free speech maximalist was Justice Hugo Black. For example, he wrote:

> I read "no law . . . abridging" to mean *no law abridging*. The First Amendment, which is the supreme law of the land, has thus fixed its own value on freedom of speech and press by putting these freedoms wholly "beyond the reach" of *federal* power to abridge. No other provision of the Constitution purports to dilute the scope of these unequivocal commands of the First Amendment. Consequently, I do not believe that any federal agencies, including Congress and this Court, have power or authority to subordinate speech and press to what they think are "more important interests."

Smith v. California, 361 U.S. 147, 158–59 (1959) (Black, J., concurring) (footnote omitted).

8. *But see* DAVID L. LANGE & H. JEFFERSON POWELL, NO LAW: INTELLECTUAL PROPERTY IN THE IMAGE OF AN ABSOLUTIST FIRST AMENDMENT 305–06 (2009):

> [T]he [First] [A]mendment would be better understood were it to be interpreted at large as a straightforward constraint against the exercise of Congressional (or state) power abridging speech and press . . . . When exclusivity interests in expression are conferred for no better reason than the exclusivity will encourage the production of such interests, or make them valuable in the hands of a favored few, the First Amendment will then intervene. Congress may not thus forbid our common participation in the universe of discourse.

laws are entitled to special treatment, and that the First Amendment has no role to play in determining the nature and scope of copyright protection.[9] While few would go that far, many veer towards that end of the spectrum, arguing that the First Amendment imposes only minimal restrictions on the rights conferred by the copyright laws.[10]

The claim that the First Amendment should have no, or at best only a small, role to play with respect to copyright is particularly curious when contrasted with the courts' treatment of other branches of intellectual property or other forms of intangible property. For example, in *New York Times Co. v. Sullivan*,[11] the Supreme Court held that in light of the First Amendment, a claim for defamation could be asserted only if the plaintiff proved "'actual malice'—that is, [if the statement was made] with knowledge that it was false or with reckless disregard of whether it was false or not."[12] In a broad range of other cases, courts have unequivocally held that claims under both state and federal law are all subject to First Amendment constraints.[13] It is far from obvious why copyright should be singled out for different analysis and harsher treatment.

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9. *See, e.g.*, Eldred v. Reno, 239 F.3d 372, 375 (D.C. Cir. 2001) ("[C]opyrights are categorically immune from challenges under the First Amendment."), *questioned on this point, aff'd on other grounds*, Eldred v. Ashcroft, 537 U.S. 186, 221 (2003); *see infra* notes 159–74 and accompanying text (discussing *Eldred v. Ashcroft*).

10. The watershed scholarly contribution by advocates of a very limited role for the First Amendment was an article by Professor Melville Nimmer. *See* Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180, 1196–1200 (1970) (acknowledging that there were a handful of situations in which copyright interests would have to yield to free speech considerations and envisioning exceptions where there is wedding of expression and ideas).

11. N.Y. Times Co. v. Sullivan, 376 U.S. 254, 292 (1964) (finding that the freedoms of speech and press guaranteed by the First and Fourteenth Amendments applied in a libel action brought by a public official).

12. *Id.* at 279–80.

13. An important accommodation of First Amendment interests to a federal legal regime is the *Noerr-Pennington* doctrine under the antitrust laws. This judicially recognized exception categorically immunizes a variety of petitioning activities—including attempts to secure favorable legislation and prayers for judicial or administrative agency relief, even if those activities result in injury to competition—from antitrust liability unless the defendant's conduct was a "sham"; unless the defendant acted in bad faith and was not genuinely seeking governmental action, but was using the petitioning process itself to injure competition. *See generally* 10 EARL W. KINTNER & JOSEPH P. BAUER, FEDERAL ANTITRUST LAW ch. 77 (1994).

See, e.g., Bartnicki v. Vopper, 532 U.S. 514, 535 (2001) (finding that a radio broadcast of intercepted telephone conversations about a matter of public concern was protected by the First Amendment, even though a third party source for the radio commentator had violated federal and state wiretap laws); Marsh v. Alabama, 326 U.S. 501, 509 (1946) (finding that a state statute, making it a crime to remain on another's property after being warned to leave,

To provide context for this discussion, let me provide a brief summary of the kinds of situations in which these conflicts have arisen. They fall into two broad categories. In the first, plaintiffs have asserted "facial" challenges to statutes expanding the scope of copyright protection, and they have argued, in part, that the expansion was inconsistent with the First Amendment. Examples of these situations have been challenges to the constitutionality of the additional twenty-year term conferred by the Copyright Term Extension Act of 1998 (CTEA),[14] to the automatic renewal provisions in the Copyright Renewal Act of 1992 (CRA),[15] and to the restoration of copyright protection for certain works which had fallen into the public domain by the Uruguay Round Agreement Act (URAA).[16]

The second category consists of a variety of "as applied" challenges. Here, the defendant may have had a First Amendment defense to claims of copyright infringement. While in many of these cases the court found for the defendant, typically after concluding that the fair use defense shielded the unauthorized use, in other cases the court found copyright infringement and dismissed the defendant's First Amendment defenses.[17] Among the situations falling into this second category were instances in which the plaintiff's work was unique, and where adequate communication of the speaker's views required reproduction or distribution of the copyrighted

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abridged the First Amendment rights of a member of the Jehovah's Witnesses who was attempting to distribute religious literature on a street in a company town); Matthews v. Wozencraft, 15 F.3d 432, 440 (5th Cir. 1994) (concluding that the First Amendment bars misappropriation and invasion of privacy claims that challenged a novel that truthfully depicted the plaintiff, a public figure); *infra* notes 406–11 and accompanying text (discussing *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media*, 505 F.3d 818, 824 (8th Cir. 2007), in which the court found that the First Amendment rights of a company running a fantasy baseball league superseded the players' state right of publicity claims).

14. *See* Copyright Term Extension Act, Pub. L. No. 105-298, § 102(b) & (d), 112 Stat. 2827, 2827–28 (1998) (codified as amended in scattered sections of 17 U.S.C.) (extending the duration of copyright protection); *infra* notes 158–74 and accompanying text (discussing these challenges).

15. *See* Copyright Renewal Act of 1992, Pub. L. No. 102-307, Title I, § 102(a) & (d), 106 Stat. 264, 264–66 (1992) (codified as amended in scattered sections of 17 U.S.C.) (regulating a second term of copyright protection); *infra* notes 180–87 and accompanying text (discussing these challenges).

16. *See* Uruguay Round Agreement Act, 17 U.S.C. § 104A (2006) (restoring copyright protection to certain works which had fallen into the public domain); *infra* notes 188–208 and accompanying text (discussing these challenges).

17. *See infra* notes 311–18 and accompanying text (discussing *Los Angeles News Service v. CBS Broadcasting, Inc.*).

expression;[18] the creation of parodies or satires of famous works;[19] reproduction of certain unpublished works, which the copyright owner sought to shield completely from public examination;[20] and reproduction of out-of-print works which had not yet fallen into the public domain.[21]

The theme of this Article is not only that the First Amendment should play a significant role in demarcating copyright protection, but that the courts and numerous commentators have understated its significance. Now for the hard part: Just what should be the balance? And is there a meaningful test or standard that can be articulated to reconcile the interests embodied by these two regimes that give rise to the occasional real conflicts?

This Article will proceed in four parts. First, I will examine whether the history of these two provisions provides any guidance. Next, I will identify and describe the goals of the copyright regime and of the First Amendment. Third, I will examine the extent to which these goals may be inconsistent, and how they may be harmonized. These attempts at harmonization include various mechanisms internal to the copyright regime, which courts and commentators have suggested will minimize any conflicts. Finally, I will discuss those situations in which the conflicts cannot be harmonized, and I will offer some guidelines and principles for their reconciliation.

II. Historical Approach

One starting point, but one that ultimately turns out to be inconclusive and thus unhelpful, is to look to the history of these two provisions. They became parts of the Constitution relatively simultaneously. The Constitution, including the Copyright Clause, was ratified in 1789. The Bill of Rights, including the First Amendment, was adopted by Congress in 1790 and added to the Constitution in 1791.

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18. *See infra* notes 359–67 and accompanying text (discussing *New Era Publications International v. Henry Holt & Co.*).

19. *See infra* notes 300–09 and accompanying text (discussing *Time, Inc. v. Bernard Geis Associates*).

20. *See infra* notes 325–31 and accompanying text (discussing *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*).

21. *See infra* notes 381–88 and accompanying text (discussing *Worldwide Church of God v. Philadelphia Church of God*).

Because subsequently added constitutional provisions repeal or replace inconsistent previous provisions,[22] one could draw the conclusion that the First Amendment controls, and even if it does not make the copyright laws "unconstitutional," it limits any portion of those laws that significantly abridge free speech or freedom of the press. But it is highly unlikely that in 1790 through 1791 the Founding Fathers intended to repeal or diminish the authority conferred on Congress by the Copyright Clause, which had so recently been placed in the Constitution. Strong support for this conclusion is the fact that early Congresses, whose members included the very people instrumental in drafting both the Constitution and the Bill of Rights, enacted legislation pursuant to the delegation of authority in the Copyright Clause, which conveyed exclusive rights to copyright owners, albeit of a more limited nature and scope than under contemporary law.[23]

The opposite conclusion to draw from history might be that although the First Amendment prohibits Congress from making laws which abridge the freedom of speech, there is a carve-out from this prohibition for legislation enacted pursuant to specific authority in Article I. However, certainly the explicit authority given to Congress to coin money[24] would not justify a statute requiring a portrait of Jesus on all coins, and the authority given to Congress to regulate commerce[25] would not authorize a statute

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22. Repeal may be done explicitly. For example, the Twenty First Amendment of the U.S. Constitution repealed the Eighteenth Amendment, which provided for prohibition of alcohol. Also, the Seventeenth Amendment, providing for the direct election of U.S. Senators, repealed Article I, Section 3, providing for their election by state legislatures. More often, the repeal is implicit. For example, the Thirteenth Amendment, which abolished slavery, and the provision in Section 1 of the Fourteenth Amendment stating that all persons born or naturalized in the United States are U.S. citizens, effectively repealed that portion of Article I, Section 2 which provides that in apportioning Representatives in the House, one should count "the whole Number of free Persons," but only three-fifths of persons "bound to Service for a Term of Years," the Constitution's euphemistic description of slaves.

23. The first American copyright statute—the Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124, 124 (repealed 1802)—extended protection only to maps, charts and books; conferred on the author only the exclusive rights to print, reprint, publish and vend; and conferred protection for a term of fourteen years, renewable for an additional fourteen years if the author survived the first term. The history of the expansion of copyright in the ensuing two-plus centuries is reviewed in *Eldred v. Ashcroft*, 537 U.S. 186, 194–201 (2003). *See generally* PAUL GOLDSTEIN, COPYRIGHT'S HIGHWAY: FROM GUTENBERG TO THE CELESTIAL JUKEBOX (2003).

24. *See* U.S. CONST. art. I, § 8, cl. 5 ("The Congress shall have the Power to . . . coin Money . . . .").

25. *See id.* art. I, § 8, cl. 3 ("The Congress shall have the Power to . . . regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes . . . .").

barring the interstate transportation of newspapers critical of the President's positions on health care reform. Similarly, I think it is equally obvious that the authority the Copyright Clause confers could not be used to justify a statute denying copyright protection to authors who criticize the government's policy in Afghanistan, and granting protection only to those who are in agreement.[26] While that conclusion is intuitively obvious,[27] the extent of the limitations that flow from the effects on speech and from content-based provisions is less clear.

Therefore, history alone does not indicate that either regime is given supremacy.[28] Rather, the relatively contemporaneous adoption of these two provisions seems to suggest that the Founding Fathers were aware of the important goals and values embodied in both of them, and believed that they were not in conflict, but rather that they should be dealt with in tandem.[29] In most cases, the two provisions have coexisted harmoniously.

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26. *See* Ashcroft v. Am. Civil Liberties Union, 542 U.S. 656, 660 (2004) ("Content-based prohibitions . . . have the constant potential to be a repressive force in the lives and thoughts of a free people. To guard against that threat the Constitution demands that content-based restrictions on speech be presumed invalid . . . and that the Government bear the burden of showing their constitutionality." (citations omitted)).

27. Although beyond the scope of this Article, I think it also obvious that other hypothetical provisions in the copyright laws might run afoul of other constitutional protections. For example, the Establishment Clause would bar a statute giving longer copyright duration to essays discussing the Bible than those discussing the Koran, and a number of provisions would invalidate a hypothetical statute denying copyright protection to atheists.

28. There is only scanty legislative history for the Patent and Copyright Clause. James Madison made one brief reference to it in the Federalist Papers:

> The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals. The States cannot separately make effectual provisions for either of the cases, and most of them have anticipated the decision of this point, by laws passed at the instance of Congress.

THE FEDERALIST NO. 43 (James Madison); *see* Dotan Oliar, *Making Sense of the Intellectual Property Clause: Promotion of Progress as a Limitation on Congress's Intellectual Property Power*, 94 GEO. L.J. 1771, 1816 (2006) (examining records from the Constitutional Convention, and concluding that the preambular part of the Copyright Clause "was intended to limit Congress's intellectual property power").

The "legislative history" of the First Amendment is even less helpful. The discussion and debates surrounding its adoption are quite limited on its scope and objectives, and are void of any reference to its relationship with provisions of the original Constitution such as the Copyright Clause.

29. *See* Eldred v. Ashcroft, 537 U.S. 186, 219 (2003) ("The Copyright Clause and First Amendment were adopted close in time. This proximity indicates that, in the Framers'

But, on a number of occasions, conflicts have arisen. It is to the treatment of these clashes in the past, and the treatment that they should have in the future, that I now turn.

III. Addressing the Conflict

The most useful starting point for the analysis is an examination of the nature of the conflict, and the different interests promoted by these two constitutional provisions. The goals of both are well known.

A. Goals of the Systems

1. Copyright

The principal function of the copyright system is captured in the preamble to the Copyright Clause: "[T]o promote the progress of Science . . . ."[30] The goal was the enhancement of the quantity and quality of literary and artistic works. Although the vehicle for achieving this goal was to be the conferral of certain exclusive rights, for a limited duration, on the creators of copyrightable material or their assignees or heirs,[31] the intended beneficiaries of this system were the members of the public.[32] The premise was that unlike earlier times, when an artist or musician might create a work under the sponsorship of a wealthy patron, by the eighteenth century, most creators of those and other kinds of works would be induced to create more and better works if they were assured of some monetary reward for their efforts. As noted, however, this incentive was merely the means to the end of enriching the intellectual, cultural and artistic wealth of society.

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view, copyright's limited monopolies are compatible with free speech principles.").

30. U.S. CONST. art. I, § 8, cl. 8. As used in this provision, "Science" was intended to encompass, *inter alia*, literature and the arts, as opposed to the "useful Arts," which were the subject matter of the patent regime.

31. *See* Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 546 (1985) ("'[The] limited grant [in the Copyright Clause] is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward . . . .'" (quoting Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984))).

32. *See id.* ("'The monopoly created by copyright thus rewards the individual author in order to benefit the public.'" (quoting Sony Corp. of Am., 464 U.S. at 477 (1984) (Blackmun, J. dissenting))).

Secondarily, and more recently, some have erroneously suggested that the copyright regime may serve a second function: the protection of the privacy rights and other interests of creators of unpublished works.[33] With respect to some works—for example, personal letters or entries in a diary—the author does not seek the exclusive right to reproduce and distribute his work.[34] Instead, he does not want it ever to see the light of day. Parties have invoked copyright infringement claims to assist in that endeavor.[35] Alternatively, the author may want to have the work distributed eventually, but in the meantime she will want to control the timing and location of that first distribution. Again, authors have relied upon copyright to assure that right.[36]

Under the regime prevailing under the Copyright Act of 1909[37] and its predecessor statutes, only state-created, common law copyright protected unpublished works; federal protection arose only after publication.[38] However, the preemption provision of the Copyright Act of 1976[39] provided that beginning in 1978, *all* copyright protection to works fixed in a tangible medium of expression would be available solely under federal law.[40]

Unlike the protection of commercial interests advanced by federal protection for published works, common law copyright was indeed designed in large measure to protect privacy interests. However, these

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33. *See* Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537, 2579 (2009) ("This is not to say that all factors relevant to authorial fair use defenses cut only in favor of fair use. Drawing expression from unpublished or unfinished works is likely to cut against fair use.").

34. An analogous category includes previously published works which have become out-of-print, but where copyright protection still subsists. *See infra* notes 381–88 (discussing *Worldwide Church of God v. Philadelphia Church of God*).

35. *See infra* notes 348–56 and accompanying text (discussing *Salinger v. Random House, Inc.*).

36. *See infra* notes 134–46 and accompanying text (discussing *Harper & Row, Publishers v. Nation Enterprises*).

37. Copyright Act of 1909, Pub. L. No. 60-349, § 2, 35 Stat. 1075, 1076 (1909).

38. *See id.* at 1076 ("[N]othing in this Act shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor.").

39. Copyright Act of 1976, 17 U.S.C. §§ 101–22 (2006).

40. *See id.* § 301 (providing that protection for "works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright" are governed exclusively by the Copyright Act). *See generally* Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 VAND. J. ENT. & TECH. L. 1 (2007).

interests are fundamentally inconsistent with the goals of copyright, as stated in the preamble to Article I, § 8: of promoting the creation and *dissemination* of more and better creative works.[41] Therefore, the copyright regime should *not* be available for the advancement of privacy interests. Instead, as noted in the legislative history of the 1976 Act, one properly brings claims for invasion of privacy only under state tort law.[42]

2. *First Amendment*

The various goals of the First Amendment have been the subject of extensive discussion and of at least some controversy.[43] The principal one is the critical importance of full and unconstrained speech for maintenance of the vitality of our democratic polity—critical both for the speaker and the listener.[44] Access to a range of information and viewpoints is essential in a myriad of ways, as citizens seek to play some role in governance at the federal, state and local levels—whether as voters, as correspondents to their

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41. *See* U.S. CONST. art. I, § 8, cl. 8 ("The Congress shall have Power to . . . promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . .").

42. *See* H.R. REP. NO. 94-1476, at 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748 (noting that in the House version of the bill, the identification of the right of a privacy claim as one not preempted by § 301 was illustrative of "rights and remedies that are different in nature from the rights comprised in a copyright and that may continue to be protected under State common law or statute"); *see also infra* notes 359–76 and accompanying text (discussing *New Era Publications International v. Henry Holt & Co.*). One court stated:

> It is universally recognized . . . that the protection of privacy is not the function of our copyright law . . . . [W]e have no need to create a protection of privacy under the label of copyright. For in this country under state laws an explicitly named right of privacy has developed through court decision and statute.

New Era Pubs. Int'l v. Henry Holt & Co., 695 F. Supp. 1493, 1504–05 (S.D.N.Y. 1988).

43. *See generally* ZECHARIAH CHAFEE, FREE SPEECH IN THE UNITED STATES (1941); ALEXANDER MEIKELJOHN, FREE SPEECH AND ITS RELATION TO SELF-GOVERNMENT (1948); CASS R. SUNSTEIN, DEMOCRACY AND THE PROBLEM OF FREE SPEECH (1993); Thomas Emerson, *Toward a General Theory of the First Amendment*, 72 YALE L.J. 877 (1963).

44. *See* Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 582 (1985) (Brennan, J., dissenting) ("A broad dissemination of principles, ideas, and factual information is crucial to the robust public debate and informed citizenry that are 'the essence of self-government.' And every citizen must be permitted freely to marshal ideas and facts in the advocacy of particular political choices." (citations omitted) (quoting Garrison v. Louisiana, 379 U.S. 64, 74–75 (1964))).

elected representatives or newspapers, as creators of a blog or Facebook page, or as callers to the Rush Limbaugh show.[45]

However, the interests advanced by the First Amendment are hardly limited to communications about political, social or economic issues. It also encompasses communications in areas of the arts, entertainment and culture. By extending its protection to all these areas, the First Amendment also serves a value similar to that fostered by the copyright laws—promoting the creation and dissemination of knowledge and cultural artifacts. A regime authorizing the relatively unrestrained dissemination of literary, musical, artistic or other creations, and permitting discussions of or sharing information about those works, makes it more likely that new, different and better works will be created.

The First Amendment serves a number of other functions. Access to information and expression, and the ability to share or convey these to others, are necessary for individuals, both as speakers and as listeners, in advancing their personal self-fulfillment and helping to realize their individual autonomy. It is not only that we feel better about ourselves when we can share our viewpoints with, and attempt to persuade or enlighten, others, but we also become better-informed and more well-rounded members of society through conversations and dialogues and through reading, writing, watching and listening.[46]

The First Amendment may also act as a societal safety valve. If people feel less free to communicate either orally or in written form, they may resort to less desirable forms of communication, including violent methods.[47] The freedoms guaranteed by the First Amendment make it less likely that those alternatives will be necessary.

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45. *See generally* Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354 (1999) (emphasizing free speech values in maintaining the diversity of antagonistic information sources).

46. The First Amendment's extension of protection to the reader and listener as well as to the writer or speaker provides an interesting contrast to the concerns reflected by the copyright regime. Because of the importance of being able to hear or read a broadly unrestricted range of materials, persons denied access to those materials have standing to assert a constitutional challenge. *See, e.g.*, Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc., 425 U.S. 748, 756 (1976) ("[T]he protection afforded is to the communication, to its source and to its recipients both."). By contrast, although the person who makes an unlawful copy of a work or sells that copy may be guilty of copyright infringement, there is no copyright liability for reading or purchasing that copy, even if one knows that it was unlawfully made or distributed.

47. The view that these alternative forms of communication are both undesirable and unnecessary is reflected in decisions extending First Amendment protection to certain forms of "expressive conduct." *See, e.g.*, United States v. Eichman, 496 U.S. 310, 319 (1990)

B. Reactions to Conflicts

As discussed below, potential conflicts between the copyright regime and the First Amendment have arisen, and can arise, in a variety of settings.[48] Commentators and courts have expressed three different responses. First, some argue that because the goals of the two systems are consistent, the actual clashes are minimal or nonexistent.[49] But because the means used to achieve those goals are fundamentally different, that is not my view. Rather, I contend that the limited monopoly conferred by the copyright regime often interferes with the potentially uninhibited right of reproduction and dissemination shielded by the First Amendment.[50]

Second, to the extent that those clashes are more significant, many point to mechanisms internal to the copyright laws, which supposedly suffice to accommodate First Amendment concerns.[51] The two principal vehicles which supposedly serve this role are the idea-expression dichotomy and the fair use doctrine. Other devices for achieving this harmonization include the merger doctrine, the fixed terms of copyright protection, the originality requirement for obtaining copyright, the first sale doctrine, the limitation on the performance right to "public" performances, and the grab-bag of exceptions, exemptions and compulsory licenses scattered throughout the 1976 Copyright Act.[52] I agree that these internal mechanisms can and do ameliorate the conflict between the two regimes, but once again, I do not believe that they adequately and fully address the problem.

(concluding that the Flag Burning Act failed First Amendment scrutiny); Texas v. Johnson, 491 U.S. 397, 420 (1989) (concluding that the burning of a flag was "expressive conduct" protected by the First Amendment); United States v. O'Brien, 391 U.S. 367, 386 (1968) (rejecting a claim that the burning of a draft card was protected "symbolic speech"). *But see* Virginia v. Black, 538 U.S. 343, 367 (2003) (concluding that the First Amendment does not bar a state statute from banning cross burning carried on with the intent to intimidate).

48. *See infra* Part III.C.1 (noting that because this conflict arises in a variety of settings, there is the potential for courts to "get it wrong").

49. *See infra* Part III.A (discussing the similar objectives of copyright and the First Amendment).

50. *See* Triangle Pubs., Inc. v. Knight-Ridder Newspapers, Inc., 445 F. Supp. 875, 882 (S.D. Fla. 1978) ("When the Copyright Act and the First Amendment both seek the same objective, their future coexistence is easily assured. However, when they operate at cross-purposes, the primacy of the First Amendment mandates that the Copyright Act be deprived of effectuation.").

51. *See infra* Part III.B.2 (discussing protection only for expression, the fair use doctrine, limited duration, the merger doctrine and *scenes à faire*, and other internal mechanisms).

52. *See infra* Part III.B.2.e (discussing these internal mechanisms).

Although there are a variety of reasons that these internal mechanisms have sometimes proven inadequate to meet all First Amendment concerns, two deserve highlighting. Preeminent has been the enormous growth, initially under the 1976 Act itself, next from judicial interpretation of the Act, and then through subsequent legislation,[53] of the scope and duration of copyright and the rights and remedies available to the copyright owner.[54] Second, the nature of copyrighted materials, and the expansion and diversity of means of using and distributing those materials, give additional opportunities for the values of the First Amendment to come into conflict with those of the copyright laws.[55] In light of these and other phenomena, one means of redressing concerns for protection of First Amendment values would be more robust application of these internal mechanisms.

However, I conclude that in some situations, a third response is also required. On occasion, there will have to be some mechanisms external to the copyright regime for allowing the variety and scope of communication contemplated by a robust First Amendment, despite the objections of the copyright owner.[56] This Article proposes such an alternative.

1. Minimizing the Conflict by Harmonization

One basis for diminishing the apparent conflict between copyright and the First Amendment is the premise that both regimes share the same goals. As just noted, the objectives of both systems are to maximize the creation and dissemination of information, ideas and expression,[57] with the aim of enhancing society's intellectual and cultural well-being.[58] The related

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53. Three of the principal post-1976 statutes are the Visual Artists Rights Act of 1990 (VARA), affording moral rights to certain works of visual arts; the Copyright Term Extension Act of 1998 (CTEA or the Sonny Bono Act), discussed *infra* notes 158–87 and accompanying text; and the Digital Millennium Copyright Act of 1998 (DMCA), discussed *infra* note 248 and accompanying text.

54. *See infra* notes 245–48 and accompanying text (discussing several significant changes in copyright law over the last three decades).

55. *See infra* notes 249–51 and accompanying text (discussing recent developments in technology and their impact on the distribution of copyrighted material).

56. *See infra* Part III.C (discussing the advantages and the limits of an expanded application of the First Amendment).

57. *See infra* notes 70–78 and accompanying text (showing that even this commonality must be qualified because copyright does not protect information or ideas, but only the expression of those ideas). But, as noted there and elsewhere, of course the ideas or the underlying information are often intimately bound up with the expression thereof.

58. *Cf.* Mitchell Bros. Film Group v. Cinema Adult Theater, 604 F.2d 852, 865 (5th

assertion is that to the extent that copyright reduces the public's right to use and disseminate certain expressive creations, the overall increase in production of new works, resulting from the exclusivity given to the author of the work, more than offsets any encroachment on First Amendment values.

While the goals of these two regimes may be similar,[59] the means to achieve them are quite different. With the exception of limited categories of speech or writing which are outside the pale of protection—for example, obscenity,[60] fighting words,[61] slander and libel,[62] or shouting fire in a crowded theater[63]—the First Amendment generally allows the uninhibited use of *any* words, pictures, music and so forth.[64] These might be ideas and expressions which are totally original to the speaker or writer or, importantly, they may have originated elsewhere.[65] On the other hand, copyright seeks to expand the creation of new expressions by giving the author the exclusive right to reproduce and distribute his or her works, and

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Cir. 1979) (harmonizing the goals of both regimes—to increase the production and dissemination of expressive ideas—by rejecting a challenge to the constitutionality of affording copyright protection to obscene works).

59. In fact, it is probably more likely that they overlap than that they are congruent. At the risk of oversimplifying the distinction, although 17 U.S.C. § 106(3) clearly grants the author of a work the exclusive right to distribute that work, the principal objective of copyright law is to stimulate the *creation* of those works. On the other hand, the First Amendment puts a premium on the fullest dissemination of works, regardless of whether the person undertaking the distribution is the creator.

60. *See, e.g.*, New York v. Ferber, 458 U.S. 747, 774 (1982) (finding no First Amendment protection for child pornography); Miller v. California, 413 U.S. 15, 36 (1973) (finding that obscene material is unprotected by the First Amendment).

61. *See* Chaplinsky v. State of New Hampshire, 315 U.S. 568, 572 (1942) (finding that the First Amendment protection does not extend to "insulting or 'fighting' words—those which by their very utterance inflict injury or tend to incite an immediate breach of the peace").

62. *See* Masson v. New Yorker Magazine, Inc., 501 U.S. 496, 525 (1991) (authorizing a defamation action); Milkovich v. Lorain Journal Co., 497 U.S. 1, 22–23 (1990) (same); Beauharnais v. Illinois, 343 U.S. 250, 266 (1952) (upholding a criminal libel statute).

63. *See* Schenck v. United States, 249 U.S. 47, 52 (1919) ("The most stringent protection of free speech would not protect a man in falsely shouting fire in a theater and causing a panic.").

64. *See* United States v. Stevens, 130 S. Ct. 1577, 1592 (2010) (refusing to expand the limited categories of unprotected speech to the sale or possession of videos depicting animal cruelty, and concluding that the Government's proposed test that would have balanced the value of speech against societal costs was inconsistent with the First Amendment).

65. *But see* Eldred v. Ashcroft, 537 U.S. 186, 221 (2003) (asserting that First Amendment protection is more limited "when speakers assert the right to make other people's speeches").

to exclude others from making unauthorized uses thereof.[66] The promise of a limited monopoly in the expression is the vehicle for maximizing the creation of new works.[67]

Thus, it is not merely that the means employed by these two regimes to achieve their goals differ. They may at times be fundamentally inconsistent.[68] Therefore, the supposed similarity of objectives will often be irrelevant in reconciling a clash between the owner of copyright in a work, and rival claimants to some unauthorized use of that work. Dealing with these potential clashes thus requires attention both to certain mechanisms internal to the copyright regime, and, when these still prove inadequate, to some external doctrines for reconciling those occasional clashes.

2. *Internal Mechanisms*

There are numerous elements of the copyright regime which, while perhaps not directly intended to address First Amendment concerns, do ameliorate many free speech objections to affording broad copyright protection.[69] The two most important are the idea-expression dichotomy and the fair use doctrine.

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66. The optimal level of rights and remedies, which will maximize the creation and dissemination of creative works while minimizing the costs imposed on users, is a subject of much debate. *See, e.g.*, *id.* at 248–63 (Breyer, J., dissenting) (comparing the modest increase in the incentive to expand the output resulting from the extension of a copyright term for an additional twenty years, with a significant loss to society from delayed access to those materials). It would be particularly difficult to determine the extent to which creativity would be diminished by First Amendment-derived expanded access to copyrighted materials.

67. With respect to differences in the goals of the copyright laws and the First Amendment and the means used to achieve those ends, there is an interesting analogy to attempts to reconcile the antitrust and intellectual property regimes. Both regimes are said to share the goal of maximizing consumer welfare—the production of more and better products at lower prices. However, antitrust seeks to achieve this goal by fostering competition and making certain forms of collusion or monopoly unlawful. By contrast, as just noted, the intellectual property regime—and here that includes copyright—seeks to achieve those goals by conferring limited monopolies on authors and inventors. *See generally* Joseph P. Bauer, *Refusals to Deal with Competitors by Owners of Patents and Copyrights: Reflections on the* Image Technical *and* Xerox *Decisions*, 55 DEPAUL L. REV. 1211 (2006).

68. *See Eldred*, 537 U.S. at 244 (Breyer, J., dissenting) ("[A] particular statute that exceeds proper Copyright Clause bounds may set Clause and Amendment at cross purposes, thereby depriving the public of the speech-related benefits that the Founders, through both, have promised.").

69. *See id.* at 219 (majority opinion) ("[The] copyright scheme . . . incorporates its

a. Protection Only for Expression

It has long been a core tenet of the copyright laws that protection extends only to the particular expression used by the author.[70] The underlying idea of the work—of taking a photograph of the Statue of Liberty, or authoring a narrative of the trials and tribulations of star-crossed lovers—is itself not protectable.[71] It is the photographer's choice of film, lighting, exposure, timing, and so forth, or the playwright's choice of medium, words, order of events, setting, character details, and the like, which obtain protection.[72] This doctrine has been formally embodied in the 1976 Act.[73]

Related to this doctrine is the absence of protection for facts, data and other kinds of information. While the selection or assembly of that information may achieve protection,[74] the underlying information itself remains free for all to use, regardless of the effort or cost involved in discovering and disclosing it.[75]

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own speech-protective purposes and safeguards. . . . [C]opyright law contains built-in First Amendment accommodations.").

70. *See id.* ("Due to [the idea-expression] distinction, every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication.").

71. *Id.*

72. *See, e.g.*, Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 61 (1884) (finding that photographs may be original works, satisfying the constitutional requirement for protection); Gross v. Seligman, 212 F. 930, 931–32 (2d Cir. 1914) (concluding that a second photograph of the same subject as the first, with a similar pose and lighting, among other things, infringed the first photograph).

A frequently posed hypothetical, to illustrate the proposition that the protection for a dramatic work extends beyond the bare words and place and character names, asks whether Leonard Bernstein's musical *West Side Story* would have been an infringing work if Shakespeare's *Romeo and Juliet* were not in the public domain.

73. *See* 17 U.S.C. § 102(b) (2006) ("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.").

74. *See id.* § 103(a) ("The subject matter of copyright . . . includes compilations . . . ."); *id.* § 101 (defining "compilation" as "a work formed by the collection and assembling of pre-existing material or data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship").

75. *See* Eldred v. Ashcroft, 537 U.S. 186, 217 (2003) ("[C]opyright gives the holder no monopoly on any knowledge. A reader of an author's writing may make full use of any fact or idea she acquires from her reading."); Feist Pubs., Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 351–60 (1991) (concluding that the 1976 Act rejected the "sweat of the brow doctrine," which gave protection to arduously collected factual information, and instead established "originality" as the touchstone for copyright protection); Iowa State Univ.

Defenders of expansive copyright protection in the face of free speech or press objections assert that First Amendment concerns are not raised because the copyright laws only restrict the use by someone of the author's *expression*.[76] Speakers and writers remain free to convey their own ideas, share their concerns, and seek to inform or persuade others, as long as they do not do so by borrowing someone else's original words or expressions.[77] That assertion, however, is incomplete and inaccurate.[78]

Research Found. v. Am. Broad. Cos., 621 F.2d 57, 61 (2d Cir. 1980) ("The public interest in the free flow of information is assured by the law's refusal to recognize a valid copyright in facts.").

In the wake of *Feist*, there have been numerous proposals to give enhanced statutory protection to databases and other collections of facts, names, addresses and the like. *See, e.g.*, Database and Collections of Information Misappropriation Act, H.R. 3261, 108th Cong. (2004); Consumer and Investor Access to Information Act, H.R. 1858, 106th Cong. (1999); Collections of Information Antipiracy Act, H.R. 354, 106th Cong. (1999); Collections of Information Antipiracy Act, H.R. 2652, 105th Cong. (1998); Database Investment and Intellectual Property Antipiracy Act, H.R. 3531, 104th Cong. (1996).

In addition to the Copyright Clause obstacles to such legislation identified by *Feist*, such a statute obviously would severely constrict one of the internal mechanisms identified as accommodating free speech concerns. By erecting additional barriers to the ability of persons to convey and receive factual information, the vitality of political, economic and social discourse could be seriously inhabited. These proposals would therefore also give rise to significant First Amendments objections.

See Daniel J. Gervais, *The Protection of Databases*, 82 CHI.-KENT L. REV. 1109, 1142–47 (2007) (noting constitutional concerns about database protection); Yijun Tian, *Reform of Existing Database Legislation and Future Database Legislation Strategies: Towards a Better Balance in the Database Law*, 31 RUTGERS COMPUTER & TECH. L.J. 347, 362 (2005) (arguing for *sui generis* legal protection of databases).

76. *See Eldred*, 537 U.S. 186, 219 (2003) ("Due to [the idea-expression] distinction, every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication."); Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 560 (1985) ("In view of the First Amendment protections already embodied in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas, . . . we see no warrant for expanding the doctrine of fair use . . . .").

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

78. *Cf.* Golan v. Gonzales, 501 F.3d 1179, 1194 (10th Cir. 2007) (concluding that the URAA, which restored copyright in certain works that had fallen into the public domain, is subject to First Amendment scrutiny); *see infra* notes 196–209 and accompanying text (discussing the fact that the idea-expression dichotomy is not a sufficient safeguard of First Amendment interests, because absent the URAA, the public would be able to make unrestricted use of the expression embodied in those works as well as of the ideas). *See generally* Alfred Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept and Feel"*, 38 EMORY L.J. 393 (1989).

First, the boundary between idea and expression is anything but a bright line; rather, it is blurry and often a moving target.[79] Often one cannot know if one has made a protected expression until a court has spoken.[80] Thus, the prudent, or risk-averse, speaker or writer may desist from using photographs, words or other copyrighted material even if a court might later find such behavior would have been permissible.[81] This necessary strategy flies in the face of the First Amendment's well-known chilling effect doctrine, in which courts hold uncertain or problematic rules unconstitutional because the rules can lead speakers to avoid what may well turn out to be desirable, protectable speech.[82] Indeed, the negative effect of this uncertainty on speech is a principal concern of the broader protection for copyrightable works.

Second, amid the panoply of decisions on this issue, some courts have taken an increasingly expansive view of what constitutes expression.[83] Despite the repetition of the importance of promoting First Amendment values,[84] such a shift in the boundary between protected expression and

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79. Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1266 (11th Cir. 2001) ("There is no bright line that separates the protectable expression from the non-protectable idea in a work of fiction."); Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960) ("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.").

80. *See* Williams v. Crichton, 84 F.3d 581, 587–88 (2d Cir. 1996) ("The distinction between an idea and its expression is an elusive one."); Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905, 912 (2d Cir. 1980) (characterizing the distinction as "an imprecise tool" and noting that "often the determination is a matter of degree"); Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930) (noting that ideas can be expressed with ever-increasing generality, and that at some ill-defined point, copyright protection will no longer be available, and observing that "the line, wherever it is drawn, will seem arbitrary").

81. The likelihood that even the possibility of a lawsuit can lead to a decision not to engage in borderline behavior will be exacerbated in the majority of potential infringement situations by the disparity in resources between the copyright owner and the typical alleged infringer, and their balancing of the costs and risks of litigation.

82. *See, e.g.*, Reno v. Am. Civil Liberties Union, 521 U.S. 844, 871–72 (1997) ("The vagueness of such a regulation raises special First Amendment concerns because of its obvious chilling effect on free speech."); Hustler Magazine v. Falwell, 485 U.S. 46, 52 (1988) (expressing concern for the "'chilling' effect on speech relating to public figures"); Phila. Newspapers, Inc. v. Hepps, 475 U.S. 767, 777 (1986) ("[S]uch a 'chilling' effect would be antithetical to the First Amendment's protection of true speech on matters of public concern . . . ."). *But see* Arista Records, Inc. v. Flea World, Inc., 356 F. Supp. 2d 411, 422 (D.N.J. 2005) ("Copyright law . . . recognizes no 'chilling effect doctrine.'").

83. *See* Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 19 (2001) (noting that "expression has steadily gobbled up idea").

84. *See* Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 589–90 (1985) (Brennan, J., dissenting) ("To ensure the progress of arts and sciences and the integrity of

unprotected ideas and facts carries the risk of significantly inhibiting protected communications.

Third, the assertion that copyright only protects against copying, and that speakers are free to express ideas as long as it is done in their own words,[85] fails to acknowledge the breadth of copyright protection. Copyright not only protects against a partial and imperfect as well as a complete and exact "reproduction of a work";[86] it also gives the copyright owner the exclusive right to prepare "derivative works" based upon the work.[87] Thus, a second speaker may be found to infringe, even if he or she uses a different vehicle or mode to express the earlier idea.[88] The numerous cases involving parodies and satires, in which courts have rejected First Amendment claims for works which were based on a preexisting work, are illustrations of the inadequacy of this supposed internal mechanism.[89]

Finally, and perhaps most important, there may be a variety of communications which require, or at a minimum will be far more understandable and persuasive based on, the use of the copyrighted expression itself, and where rephrasing or describing it will simply not be effective.[90] Some examples of these are discussed below.[91]

First Amendment values, ideas and information must not be freighted with claims of proprietary right." (footnote omitted)).

85. *See supra* notes 76–78 and accompanying text (explaining that one has a right to make one's own speech but not someone else's speech).

86. 17 U.S.C. § 106(1) (2006).

87. *Id.* § 106(2). A "derivative work" is broadly defined as "any . . . form in which a work can be recast, transformed or adapted." *Id.* § 101.

88. Thus, it has been suggested that although a second user may not freely copy the original work, the ability to paraphrase that work satisfies free speech concerns. The copyright owner's right to make a derivative work can severely limit the rights of others to use the work, even after making significant modifications. *See, e.g.*, Salinger v. Random House, Inc., 811 F.2d 90 (2d Cir. 1987) (finding infringement based on a biographer's paraphrasing of passages in J.D. Salinger's letters), *cert. denied*, 484 U.S. 890 (1987).

89. *See, e.g.*, *infra* notes 325–31 and accompanying text (discussing *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*); *infra* note 331 (discussing *Walt Disney Productions v. Air Pirates*).

90. *Cf.* Maxtone-Graham v. Burtchaell, 631 F. Supp. 1432, 1437 (S.D.N.Y. 1986) (recognizing that the defendant's decision to quote, rather than paraphrase, from plaintiff's work was not intended "to save his own time, or to exploit plaintiff's efforts, but to analyze these personal accounts in the most effective and persuasive manner").

91. *See infra* Part III.C.2.b (explaining that the First Amendment should prevail over copyright when there is a strong public interest in free use of the material, there is a compelling need to use the protected expression, and consent to the use of the material is unavailable).

b. Fair Use Doctrine

The fair use doctrine is the second major mechanism internal to the copyright regime which is proffered as a supposed cushion against abridgment of First Amendment rights.[92] This doctrine permits persons to make certain uses of a work protected by copyright without obtaining permission from the copyright owner. The doctrine was originally the product of common law, but for the past three-plus decades, it has been codified by statute.

The origins of the fair use doctrine in the United States are often traced to an 1841 opinion by Supreme Court Justice Joseph Story, sitting as a trial judge.[93] For the next century-plus, the doctrine was expanded, limited and refined by countless other decisions.[94] Then, in 1976, Congress codified the doctrine in Section 107 of the Copyright Act.[95] Two aspects of the provision are noteworthy.

First, the preambular portion, § 107, sets forth six examples of unauthorized uses of a copyrighted work which are more likely to be deemed fair use: "[C]riticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research."[96] However, it does not follow that all instances of these six forms of conduct will be deemed "fair use."[97] Also, many other forms of conduct, which are

92. *See* Eldred v. Ashcroft, 537 U.S. 186, 221 (2003) (identifying the fair use doctrine as a "built-in First Amendment accommodation[]"); Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc., 166 F.3d 65, 74 (2d Cir. 1999) ("First Amendment concerns are protected by and coextensive with the fair use doctrine."). *But see* Universal City Studios, Inc. v. Corley, 273 F.3d 429, 458 (2d Cir. 2001) ("[T]he Supreme Court has never held that fair use is constitutionally required, although some isolated statements in its opinions might arguably be enlisted for such a requirement.").

93. Folsom v. Marsh, 9 F. Cas. 342, 349 (C.C.D. Mass. 1841) ("[I]t is a clear invasion of the right of property of the plaintiffs, if the copying of parts of a work, not constituting a major part, can ever be a violation thereof.... If it had been the case of a fair and bona fide abridgment of the work of the plaintiffs, it might have admitted of a very different consideration.").

94. While the details are not relevant here, it is hardly surprising that over the years, courts have applied a variety of criteria to determine whether any particular use was fair, and that those decisions have often been inconsistent.

95. 17 U.S.C. § 107 (2006).

96. *Id.*

97. *See, e.g.*, Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 569 (1985) (finding that the copying of a portion of President Ford's memoirs by a news magazine did not qualify as a "fair use").

not within these six enumerated uses, may well qualify as fair use if the factors set forth in the statute are met.[98]

Second, the statute sets forth four factors which are to be considered in "determining whether the use made of a work in a particular case is a fair use."[99] These 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.[100]

Courts have repeatedly asserted that the fair use doctrine provides a significant bulwark to claims that the copyright laws impinge on First Amendment interests.[101] And, in a large number of cases, the right to make fair use of copyrighted materials has in fact served as a satisfactory answer to those concerns.[102] There are a number of reasons that the doctrine has proven to be an incomplete response.

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98. *See, e.g.*, Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 456 (1984) (finding that a private individual's use of video cassette recorders to make copies of audio-visual works which were broadcast to the public constituted fair use).

99. 17 U.S.C. § 107.

100. *Id.*

101. *See, e.g.*, Eldred v. Ashcroft, 537 U.S. 186, 219–20 (2003) (characterizing fair use as one of copyright law's "built-in First Amendment accommodations"); Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 560 (1985) (characterizing fair use as one of the "First Amendment protections already embodied in the Copyright Act[]"); Sarl Louis Ferraud Int'l v. Viewfinder, Inc., 489 F.3d 474, 482 (2d Cir. 2007) ("[A]bsent extraordinary circumstances, 'the fair use doctrine encompasses all claims of first amendment in the copyright field.'" (citations omitted)); A&M Records, Inc. v. Napster, Inc., 239 F.3d 1004, 1028 (9th Cir. 2001) (noting "that First Amendment concerns in copyright are allayed by the presence of the fair use defense," and that "[u]ses of copyrighted material that are not fair uses are rightfully enjoined").

102. *See* Triangle Pubs., Inc. v. Knight-Ridder Newspapers, Inc., 626 F.2d 1171, 1178 (5th Cir. 1980) (finding that the fair use doctrine shielded the defendant-newspaper's use of the cover of the plaintiff magazine in comparative advertising, but that the district court, which had rejected the fair use defense, should not have protected that use on the basis of the First Amendment); Maxtone-Graham v. Burtchaell, 631 F. Supp. 1432, 1435 (S.D.N.Y. 1986) (applying the fair use defense, and recognizing that copyright "policy must yield to the right of persons to engage in full and free public discourse of ideas and issues protected by the First Amendment").

On the one hand, there are instances where the courts arguably had to stretch the fair use doctrine to protect First Amendment values. While not destructive of those values, these decisions nonetheless undermine the predictability and integrity of fair use.

On the other hand, and far more problematic, there are a number of cases where the fair use defense was rejected by the courts,[103] and thus where the interests fostered by the First Amendment were undermined.[104] There are a number of factors contributing to this result.[105] Of primary concern, the fair use defense suffers the same two defects as were identified above with respect to the idea-expression dichotomy[106]—its imprecision and its recent expansion.

First, because it is obvious that different courts often apply the same factors to the same facts and reach different results,[107] a potential user of a

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103. For examples of cases in which the fair use defense was rejected by courts, see *infra* notes 311–18, 325–31, 341–42, & 348–76 and accompanying text. *See also* Estate of Martin Luther King, Jr., Inc. v. CBS, Inc., 194 F.3d 1211, 1220 (11th Cir. 1999) (declining to address fair use and First Amendment issues in an action challenging a television network's use of excerpts from Dr. King's "I Have a Dream" speech in a documentary because the district court did not address these defenses and the facts were not fully developed); Meeropol v. Nizer, 560 F.2d 1061, 1068–71 (2d Cir. 1977) (finding triable issues of fact and denying summary judgment on the fair use defense, but declining to discuss First Amendment issues, in a case involving copying of portions of letters written by Julius and Ethel Rosenberg, who were executed in 1953 for conspiracy to transmit information to the Soviet Union).

104. Needless to say, there are many cases where the court found the fair use doctrine inapplicable and then properly concluded that the First Amendment did not shield the defendant's conduct. *See, e.g.*, Dallas Cowboy Cheerleaders, Inc. v. Scoreboard Posters, Inc., 600 F.2d 1184, 1187–88 (5th Cir. 1979) (concluding that the defendant's imitative poster did not qualify as protected satire or parody under the fair use doctrine and that the First Amendment defense was unavailable); Wainwright Secs. Inc. v. Wall St. Transcript Corp., 558 F.2d 91, 97 (2d Cir. 1977) ("[A]ppellants have failed to demonstrate that their use of the Wainwright reports either was reasonable or pursuant to legitimate news reporting that implicates first amendment interests."), *cert. denied*, 434 U.S. 1014 (1978).

105. The identification of the reasons that the fair use doctrine does not adequately address First Amendment concerns could be part of a broader critique of the fair use doctrine. While I have some reservations both about aspects of the doctrine generally and about the construction given it by some courts, I do not argue here that the long history of fair use jurisprudence is flawed. Instead, I assert that regardless of the correctness of fair use analysis, the First Amendment should be applied more broadly in the face of copyright infringement claims, to give greater protection to free speech interests.

106. *See supra* notes 79–91 and accompanying text (discussing the defects associated with the idea-expression dichotomy).

107. Perhaps the clearest illustration of this imprecision would be a citation to the dozens, or probably hundreds, of cases in which an appellate court reversed the judgment of the lower court that the fair use defense was, or was not, applicable. *See, e.g.*, Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 569 (1985) (reversing the court of

work may have great difficulty predicting whether her unauthorized use will be permitted. The prudent and risk-averse user will desist from that use—resulting in the chilling effect that First Amendment courts often decry.[108]

Second, by identifying the "effect of the [defendant's] use upon the potential market for or value of the copyrighted work"[109] as the factor entitled to the greatest weight in copyright infringement analysis, the Supreme Court has significantly limited the scope of the fair use defense.[110] The Court has further limited the defense by interpreting that factor not only to include the potential impact of the defendant's use on the market for the work in its original form, but also the potential loss of the opportunity to create or authorize others to make derivative uses of that work.[111]

Third, the four factors enumerated in § 107 for determining whether a particular use is fair do not include what is probably the most compelling concern embodied in the First Amendment: the public interest, or even public necessity, in permitting unauthorized use of certain copyrighted material.[112] The closest that the Copyright Act's textual enumeration of

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appeals's holding that the use in question was protected by fair use doctrine); Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1276–77 (11th Cir. 2001) (reversing the district court's holding that the use in question was not protected by fair use doctrine).

108. *See generally* Alan Garfield, *The Case for First Amendment Limits on Copyright Law*, 35 HOFSTRA L. REV. 1169, 1195 (2007) (noting the chilling effect of "the prospect of having to litigate even a successful First Amendment defense"); William McGeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 52 (2008) (noting that the "lethal combination of uncertain standards with lengthy and costly litigation creates a classic chilling effect upon the unlicensed use of trademarks to facilitate speech, even when such uses are perfectly lawful"); *see supra* note 82 and accompanying text (discussing the chilling effect doctrine).

109. 17 U.S.C. § 107(4) (2006).

110. *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 574 (1994) ("[T]he effect on the potential market for the original (and the market for derivative works) is 'undoubtedly the single most important element of fair use . . . .'" (quoting *Harper & Row*, 471 U.S. at 566)); *see also* Mulcahy v. Cheetah Learning LLC, 386 F.3d 849, 854 (8th Cir. 2004) (same); Fitzgerald v. CBS Broad., Inc., 491 F. Supp. 2d 177, 189 (D. Mass. 2007) ("Since this question goes to the heart of whether allowing or prohibiting a use furthers the ends of the Copyright Act, market effect is 'undoubtedly the single most important element of fair use.'" (quoting *Harper & Row*, 471 U.S. at 566)).

111. *See* Mark P. McKenna, *The Rehnquist Court and the Groundwork for Greater First Amendment Scrutiny of Intellectual Property*, 21 WASH. U. J.L. & POL'Y 11, 23 (2006) ("Two related trends in fair use law over the last twenty-some years have worked together to loosen fair use from whatever First Amendment core it once had.").

112. I contend that the public interest in allowing unauthorized copying or other use of a work, even in situations where the fair use doctrine might not apply, is a key factor in determining whether First Amendment considerations should trump copyright claims. *See infra* Part III.C.2.b.(1) (discussing the importance of considering the public interest in

factors comes to considering this public interest is the first, vague factor.[113] Rather than undertaking any consideration of "public interest," however, courts weighing this factor have focused almost exclusively on the two distinctions specified in this subsection—"whether such use is of a commercial nature or is for nonprofit educational purposes."[114]

Fourth, fair use analysis focuses on how much the defendant took from the plaintiff's work, regardless of whether the materials used constituted only a small portion of the defendant's final product.[115] It may not matter that the amount taken is a small fraction of the plaintiff's work.[116] From a First Amendment perspective, it would be important not only to see how much or how little the defendant took, but its context—both the quantity used and its importance to the defendant—in the challenged communication.

Fifth, decisions such as the *Pretty Woman* case[117] highlight a distinction which may be significantly important for fair use analysis, but which can have unintended implications for First Amendment purposes.[118]

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deciding when First Amendment values should prevail over copyright claims).

113. *See* 17 U.S.C. § 107(1) ("In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include . . . the purpose and character of the use . . . .").

114. *Id.* Arguably, the preambular specification of examples of uses which are likely to be deemed fair affords leeway for taking account of a public interest. *See supra* notes 98–100 and accompanying text (discussing the six examples of unauthorized use likely to be deemed fair use in the preamble to § 107). Here, too, there is nearly a complete lack of attention to the public interest benefits of such uses as criticism, comment, or news reporting. *See supra* notes 98–100 and accompanying text (considering the purpose, nature, amount, and effect of the use, but not its public interest benefits).

115. *See* Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 565 (1985) ("[A] taking may not be excused merely because it is insubstantial with respect to the *infringing* work.").

116. *See, e.g., id.* at 569 (finding infringement based on defendant's unauthorized use of approximately 300 protected words from plaintiff's approximately 200,000 word manuscript, in part because of the great importance and value of those words); Roy Export Co. Estab. of Vaduz v. Columbia Broad. Sys., 503 F. Supp. 1137, 1145 (S.D.N.Y. 1980) (finding that unauthorized use of a fifty-five second excerpt from a one hour and twenty-nine minute film constituted a substantial use), *aff'd*, 672 F.2d 1095 (2d Cir.), *cert. denied*, 459 U.S. 826 (1982); *see also* Iowa State Univ. Research Found. v. Am. Broad. Cos., 621 F.2d 57, 61–62 (2d Cir. 1980) (denying the fair use defense to a broadcaster which used approximately 8% of the plaintiff's twenty-eight minute film biography of a champion wrestler in connection with telecasts of sports events).

117. *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 594 (1994) (reversing the judgment of the court of appeals that the commercial nature of 2 Live Crew's parody of "Oh, Pretty Woman" rendered it presumptively unfair); *see also infra* notes 291–92 and accompanying text (discussing *Campbell*).

118. *See Campbell*, 510 U.S. at 591 (drawing the distinction between mere duplication

There, the Supreme Court contrasted "mere duplication" of a work from a "transformative" use.[119] Because duplication is far more likely to act as a substitute for the underlying work, thus diminishing the copyright owner's monetary rewards, the defendant's burden of prevailing on the fourth factor[120] is much higher.[121] In contrast, the Court favored transformative use—the creation of a derivative work based on the underlying work—for two reasons: it was less likely to displace demand for the original work,[122] and it gave rise to a new work which contributed to society's cultural or artistic resources.[123]

From a First Amendment perspective, however, the distinction often will point in the opposite direction. On occasion, a speaker or writer may find it necessary to use precisely the same expression as the copyrighted work; indeed, the value and strength of the communication would be undermined if she were required to make some transformation to invoke the benefits of the fair use doctrine. While the creation of derivative uses should be promoted,[124] the fact that the activity is not transformative should not be a barrier to appropriate invocation of the First Amendment.[125]

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for commercial purposes and transformative use).

119. *Id.*

120. *See* 17 U.S.C. § 107(4) (2006) ("[T]he effect of the use upon the potential market for or value of the copyrighted work.").

121. *See Campbell*, 510 U.S. at 591 ("[W]hen a commercial use amounts to mere duplication of the entirety of an original, it clearly 'supersede[s] the objects,' . . . of the original and serves as a market replacement for it, making it likely that cognizable market harm to the original will occur." (quoting Folsom v. Marsh, 9 F. Cas. 342, 248 (C.C.D. Mass. 1841)).

122. *See id.* ("But when, on the contrary, the second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred.").

123. *Id.* at 579 ("[T]he goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. . . . [T]he more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use." (citations omitted)).

124. Even this objective is subject to the obvious limitation that, absent fair use, the statute gives the copyright owner the exclusive right "to prepare derivative works based upon the copyrighted work." 17 U.S.C. § 106(2).

125. Because my objective is to place the primary focus of the analysis on the values underlying the First Amendment, rather than on advancing the interests of present and future authors in creating new works or protecting existing works, I agree with Professor Tushnet that making the legality of the unauthorized use of another's work turn on whether the speech is transformative is inadequate to achieve a proper balance. *See* Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535, 538 (2004) ("The current version of copyright, in which free speech problems are solved by keeping copyright owners from controlling certain transformative uses but in which more ordinary unauthorized copying is prohibited, is incompatible with the

Sixth, another factor considered in fair use analysis—the "character of the [defendant's] use"[126]—may also point in opposite directions for copyright versus free speech purposes. In a number of cases discussed below,[127] the defendant was unsuccessful in obtaining permission to use the copyrighted work. For fair use purposes, it has been suggested that this is evidence pointing against fair use.[128] However, one factor in the test that I propose, which would counsel in favor of finding that the First Amendment should trump copyright claims, is the set of situations in which the subsequent user does not have alternatives to the unauthorized use of the plaintiff's work.[129]

Seventh, courts have held that fair use is an affirmative defense; therefore, the burden of showing that the factors are met is placed on the defendant.[130] First Amendment concerns would be far more appropriately addressed if the tables were turned—if there were a presumption in favor of the primacy of allowing unconstrained speech, and if, after plausible free speech arguments have been asserted, the burden were placed on the copyright owner to show that the defendant's use was improper.[131]

First Amendment."). It is true that copyright law stresses the importance of the transformative character of an unauthorized use in determining whether it is fair. *See* 17 U.S.C. § 107 (listing four factors to be considered in determining whether an unauthorized use constitutes fair use); *see also* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 591 (1994) (stressing the importance of transformative use in fair use analysis). However, there are occasions on which even a purely duplicative use should receive First Amendment protection.

126. 17 U.S.C. § 107(1).

127. *See, e.g.*, *infra* notes 291–92 and accompanying text (discussing *Campbell v. Acuff-Rose Music, Inc.*); *infra* notes 348–56 and accompanying text (discussing *Salinger v. Random House, Inc.*); *infra* notes 300–10 and accompanying text (discussing *Time, Inc. v. Bernard Geis Associates*).

128. For example, in *L.A. News Services v. KCAL-TV Channel 9*, the court noted:

> While the fact that [the defendant] had requested a license but had been refused one is not dispositive, . . . "the propriety of the defendant's conduct" is relevant to the character of the use at least to the extent that it may knowingly have exploited a purloined work for free that could have been obtained for a fee.

L.A. News Services v. KCAL-TV Channel 9, 108 F.3d 1119, 1122 (9th Cir. 1997).

129. *See infra* Part III.C.2.b.(2) (providing an exception when there is a compelling need to use the protected expression).

130. *See, e.g.*, *Campbell*, 510 U.S. at 590 ("Since fair use is an affirmative defense, its proponent would have difficulty carrying the burden of demonstrating fair use without favorable evidence about relevant markets."); Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1403 (9th Cir.) ("Since fair use is an affirmative defense, [defendants] must bring forward favorable evidence about relevant markets."), *cert. denied*, 521 U.S. 1194 (1997); *infra* note 151 (discussing the burden of proof for a fair use defense).

131. By providing that "the fair use of a copyrighted work . . . is not an infringement of

Eighth, and finally, the key factor in copyright infringement analysis—the "effect of the use upon the potential market for or value of the copyrighted work"[132]—may often be irrelevant for First Amendment analysis. Admittedly, there may be some negative financial impact on the copyright owner from the unauthorized use, but that is an unintended consequence of that use. Rather, typically the speaker in situations in which First Amendment concerns are implicated is not primarily seeking financial rewards from that use, but rather is motivated by a desire to enlighten or persuade others.[133]

The inadequacy of fair use as a mechanism to satisfy First Amendment concerns is demonstrated by consideration of illustrative decisions. One leading case, *Harper & Row, Publishers v. Nation Enterprises*,[134] arose out of the publication by *The Nation* magazine of excerpts of President Gerald Ford's memoirs before their publication in book form.[135] Ford's publisher, Harper & Row, had entered into a contract with *Time* magazine for pre-publication serialization of the memoirs; the contract allowed *Time* to withdraw if the memoirs were summarized elsewhere.[136] After acquiring a

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copyright," the statute could be read as creating a presumption in favor of fair use, which would have to be rebutted by the plaintiff. 17 U.S.C. § 107. Nonetheless, the Supreme Court has held on numerous occasions that the burden of proof rests on the party seeking to suppress a particular communication, to show that it is not shielded by the First Amendment. *See, e.g.*, Illinois *ex rel.* Madigan v. Telemarketing Assocs., Inc., 538 U.S. 600, 620 n.9 (2003) ("The Court has long cautioned that, to avoid chilling protected speech, the government must bear the burden of proving that the speech it seeks to prohibit is unprotected."); Thomas v. Chicago School Dist., 534 U.S. 316, 321 (2002) ("[T]he censor must bear the burden of going to court to suppress the speech and must bear the burden of proof once in court." (quoting FW/PBS, Inc. v. Dallas, 494 U.S. 215, 227 (1990)); Elrod v. Burns, 427 U.S. 347, 368 (1976) ("[I]t is the government's burden to demonstrate an overriding interest in order to validate an encroachment on protected [First Amendment] interests . . . .").

132. 17 U.S.C. § 107(4); *supra* notes 109–11 (discussing the fourth factor in a fair use determination and noting that this determination has been allotted the greatest consideration by the courts).

133. *See, e.g.*, Time, Inc. v. Bernard Geis Assocs., 293 F. Supp. 130, 137–38 (S.D.N.Y. 1968) (noting that prior to the unauthorized use, the defendant had unsuccessfully sought the copyright owner's permission to reproduce plaintiff's work, and had offered to pay a royalty equal to the profits from publication of the book in return for permission); *infra* notes 300–10 (discussing *Time*). *Cf.* Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 562 (1985) ("The crux of the profit/nonprofit distinction [in a § 107(1) analysis] is . . . whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.").

134. *Harper & Row*, 471 U.S. at 569.

135. *Id.* at 541–43.

136. *Id.* at 542–43.

copy of the manuscript,[137] *The Nation* published a short article, totaling 2,250 words, which incorporated approximately 300 words from President Ford's memoirs.[138] *Time* backed out, and Harper & Row sued for damages.[139] Reversing the decision of the Second Circuit holding for the defendant,[140] the Supreme Court rejected *The Nation*'s proffered fair use defense and found copyright infringement.[141]

Although the Court's rejection of the fair defense might be criticized on a number of grounds, two deserve emphasis. Because these criticisms demonstrate that the Court "got it wrong," they also provide firm illustration why reliance on the fair use doctrine has proven insufficient to protect First Amendment interests.

Initially, the Court misread and misapplied one of the four factors in § 107. The Act provides for consideration of "the amount and substantiality of the portion used *in relation to the copyrighted work as a whole.*"[142] Here, the defendant had used 300 words from a book that was 655 pages in typescript form[143] and was approximately 200,000 words in length[144]—a taking of approximately 0.1% of "the copyrighted work as a whole."[145] Instead, the Court erroneously focused on the ratio of 300 words to the *defendant's* 2,250-word article, and thus its math indicated that "the direct takings from the unpublished manuscript constitute at least 13% of the infringing article."[146]

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137. A first-time reader of the decision would have known that things weren't going to turn out well for the defendant when Justice O'Connor, in the first paragraph of the opinion, stated that *The Nation*'s editor was working with "the purloined manuscript." *Id.* at 542.

138. *Id.* at 545–46.

139. *See id.* at 543 ("As a result of *The Nation's* article, *Time* canceled its piece and refused to pay the remaining $12,500. Petitioners brought suit in the District Court for the Southern District of New York, alleging conversion, tortious interference with contract, and violations of the Copyright Act.").

140. *See* Harper & Row, Publishers v. Nation Enters., 723 F.2d 195, 208–09 (2d Cir. 1983) (finding that borrowing an "infinitesimal" amount of protected language does not constitute a violation of copyright).

141. Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 569 (1985).

142. 17 U.S.C. § 107(3) (2006) (emphasis added).

143. *Harper & Row*, 471 U.S. at 570.

144. *See id.* at 579 (Brennan, J., dissenting) ("The Court holds that The Nation's [sic] quotation of 300 words from the unpublished 200,000-word manuscript of President Gerald R. Ford infringed the copyright in that manuscript, even though the quotations related to a historical event of undoubted significance—the resignation and pardon of President Richard M. Nixon.").

145. *See supra* note 142 and accompanying text (discussing the third requirement of §107).

146. *Harper & Row*, 471 U.S. at 565.

Far more problematic for First Amendment purposes was the Court's analysis of the fourth factor—the one characterized as "the single most important element of fair use"[147]—the effect on the market for the plaintiff's work.[148] The Court observed that after the appearance of *The Nation*'s article, *Time* magazine decided to exercise its rights under its contract not to run its own excerpts of President Ford's memoirs, and that this had resulted in financial losses for Harper & Row.[149] Yet as Justice Brennan observed in dissent, it is not at all clear whether *Time*'s decision flowed from the defendant's unauthorized use of the protected expression, or from its publication of unprotected facts regarding the Nixon pardon.[150] It is not unlikely that *Time* would have made the same decision even if *The Nation* had completely paraphrased Ford's memoirs, and had not used a single protected expression. By failing to insure that the adverse effect on the market for the memoirs resulted from unauthorized use of protected expression, rather than *The Nation*'s use of unprotected ideas and information,[151] the Court gave far too little regard to the importance of broad and rapid dissemination of ideas and information—the very values that are advanced by the First Amendment.

My criticism of *Harper & Row* then leads to the question of whether the fair use doctrine as an "internal mechanism" is inadequate because of the doctrine itself, or because of its judicial interpretation. The answer is "both." For the reasons already indicated,[152] the doctrine does not reach far enough to encompass all First Amendment concerns. Its inadequacy is compounded by the often-cramped, and too-often-inconsistent, treatment it receives from the courts—creating the chilling effect on speech which I have identified as a core concern resulting from the First Amendment-copyright clash.[153]

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147. *See supra* note 110 (discussing the importance of the effect on the potential market for the original).

148. 17 U.S.C. § 107(4) (2006).

149. Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 543 (1985).

150. *See id.* at 602 (Brennan, J., dissenting) ("If it was this publication of information, and not the publication of the few quotations, that caused Time [sic] to abrogate its serialization agreement, that effect was the product of wholly legitimate activity.").

151. In part, this was because the Court placed the burden of proof on "the infringer to show that this damage would have occurred had there been no taking of copyrighted expression." *Id.* at 567 (majority opinion). Because fair use is a defense, that allocation of the burden is not inappropriate from the perspective of the copyright regime. Because the First Amendment protects valuable rights, however, a concern for free speech values would indicate that the burden should not be on the person who seeks to exercise those rights, but on those who would deny them.

152. *See supra* notes 92–133 and accompanying text (discussing the shortcomings of the fair use doctrine).

153. My concerns for these chilling effects are accentuated by a variety of expansions

c. Limited Duration

The constitutional requirement that the exclusive rights available to the copyright owner may be granted only for "limited Times"[154] could, in theory,

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of the scope of copyright protection, and in particular the grant of para-copyrights by the Digital Millennium Copyright Act (DMCA), Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified at 17 U.S.C. §§ 1201–05), and by other legislation. *See infra* note 248 and accompanying text (discussing the DMCA).

In Universal City Studios, Inc. v. Reimerdes, 111 F. Supp. 2d 294, 309–11 (S.D.N.Y. 2000), the defendants had created computer software which decrypted, and permitted others to make copies of, digitally encrypted movies on DVDs; the defendants also widely distributed this software over the Internet. The district court held that this conduct violated the DMCA, rejecting, *inter alia*, the defendants' fair use and First Amendment defenses. *Id.* at 323.

On appeal, the Second Circuit affirmed the district court's grant of an injunction which barred the defendant from posting the software on websites, or from knowingly linking a website to any other website which contained the software. Universal City Studios, Inc. v. Corley, 273 F.3d 429, 459–60 (2d Cir. 2001). The court of appeals initially concluded that although the software program itself was speech for First Amendment purposes, the computer code combined both speech and nonspeech elements. *See id.* at 449 ("For all of these reasons, we join the other courts that have concluded that computer code, and computer programs constructed from code can merit First Amendment protection, . . . although the scope of such protection remains to be determined." (citations omitted)). Importantly, it found that the injunction was content-*neutral*, and therefore it needed only to meet an intermediate scrutiny test, rather than the strict scrutiny that would have been required if it were content-*based*. *See id.* at 454 (discussing the standard for content-neutral actions). Applying the more relaxed standard, the court found that both injunctive provisions served substantial government interests, that those interests were unrelated to the suppression of free speech and, critically, that any incidental restrictions on the defendant's speech did not burden substantially more speech than was necessary to further those interests. *Id.* at 451.

For those who would rely on the fair use doctrine as a justification for more limited First Amendment protection, the district court's rejection of that defense is particularly problematic. The court held that while fair use applies to charges of *infringement*, it is simply *inapplicable* to the conduct prohibited by § 1201(a) of the Act, such as offering and providing technology designed to circumvent technological measures that control access to copyrighted works. *Id.* at 458–59. "The fact that Congress elected to leave technologically unsophisticated persons who wish to make fair use of encrypted copyrighted works without the technical means of doing so is a matter for Congress unless Congress' decision contravenes the Constitution . . . ." *Reimerdes*, 111 F. Supp. 2d at 324.

Corley's analysis was followed by *321 Studios v. Metro Goldwyn Mayer Studios, Inc.*, in which the court applied the intermediate scrutiny test and concluded that the provisions of the DMCA, which precluded the plaintiff from trafficking in devices which allowed third parties to infringe copyrights in the defendants' DVDs, was not unconstitutional under the First Amendment, and that the DMCA did not impermissibly burden the fair use rights of users of copyrighted materials. 321 Studios v. Metro Goldwyn Mayer Studios, Inc., 307 F. Supp. 2d 1085, 1107–08 (N.D. Cal. 2004). *Corley*'s analysis then discussed *United States v. Elcom Ltd.*, in which the court did likewise, but in a criminal prosecution. United States v. Elcom Ltd., 203 F. Supp. 2d 1111, 1127–37 (N.D. Cal. 2002).

154. *See supra* note 1 and accompanying text (discussing the Copyright Clause).

serve as a means of accommodating First Amendment interests. To begin with, however, most speakers seeking to invoke their constitutional right to distribute or revise the works of others will want to use comparatively modern works.[155] That reality, combined with the judicial approval of several recent statutes[156] that have provided for ever-increasing length of copyright protection,[157] means that "limited duration," to a far greater degree than the two internal mechanisms already discussed, offers virtually no solace to speakers seeking greater flexibility in using the copyrighted words of others.

In 1998, Congress passed the Copyright Term Extension Act (CTEA), extending copyright for both existing and future works by an additional twenty years.[158] In *Eldred v. Ashcroft*,[159] the Supreme Court addressed the obverse of the theoretical safety valve of the limited duration provision—whether this latest extension of the term of copyright, particularly for already existing works,[160] fell afoul of the First Amendment or the Copyright Clause.[161]

Eldred was a challenge to the constitutionality of the CTEA brought by individuals and businesses who sought to use copyrighted materials to

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155. Thus, the fact that a speaker may freely quote from Thomas Paine's *Common Sense* or Harriet Beecher Stowe's *Uncle Tom's Cabin* is of little benefit when she really wants to use extensive portions of Barack Obama's *The Audacity of Hope*.

156. *See infra* notes 158, 188 and accompanying text (discussing the Copyright Term Extension Act and the Uruguay Round Agreement Act, respectively).

157. The maximum total term of copyright under the Act of 1790 was twenty-eight years—an initial term of fourteen years, renewable for another term of fourteen years if the author survived the first term. *See* Eldred v. Ashcroft, 537 U.S. 186, 194 (2003) (discussing the nature of the 1790 copyright statute). The maximum total term was extended to forty-two years in 1831, and to fifty-six years in 1909. *See id.* ("Congress expanded the federal copyright term to 42 years in 1831. . . ."). The 1976 Act created a term of life for the author plus fifty years for certain works, and seventy-five years from publication for other works. On each occasion, the statute extended the terms of both existing and future copyrights. *See id.* at 194–95 (explaining the new copyright terms of the 1976 Copyright Act).

158. Copyright Term Extension Act, Pub. L. No. 105-298, § 102(b) & (d), 112 Stat. 2827, 2827–28 (1998) (codified as amended in scattered sections of 17 U.S.C.).

159. *See Eldred*, 537 U.S. at 222 (finding it within the province of Congress's discretion to extend the duration of a copyright).

160. The Court granted certiorari to consider "whether the CTEA's extension of *existing* copyrights exceeds Congress' [sic] power under the Copyright Clause; and whether the CTEA's extension of *existing and future* copyrights violates the First Amendment." *Id.* at 189 (emphasis added). The plaintiffs, however, only focused on CTEA's constitutionality with respect to existing copyrights, conceding their earlier challenges to Congress's power with respect to protection of future works. *See id.* at 218 n.23 ("Petitioners originally framed this argument as implicating the CTEA's extension of both existing and future copyrights. Now, however, they train on the CTEA's extension of existing copyrights . . . ." (citations omitted)).

161. *Id.* at 192.

create new works. The longer portion of the Court's opinion—dealing with the Copyright Clause challenge—is not directly relevant to the issues raised by this Article.[162] The briefer portion, rejecting the plaintiffs' First Amendment challenge,[163] is far more instructive.

The Court's conclusion was premised on a combination of rationales. In part, it was based on history, and the asserted compatibility of the purposes underlying copyright's grant of limited monopolies and free speech principles.[164] In part, it was based on the other internal limitations just discussed above.[165] In part, it was based on two very minor internal limitations in the CTEA itself.[166] And, in part, it was based on the purported distinction between situations in which "the government compels or burdens the communication of particular facts or ideas,"[167] and situations in which the government *merely* "protects authors' original expression from unrestricted exploitation"[168] by precluding unauthorized access thereto. At the end of the day, though, these parts still do not add up to a satisfactory resolution of the copyright-First Amendment clash.

Much has already been written—both before and after the Supreme Court's decision—on the inadequacy of the Court's conclusion.[169] In the

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162. *Id.* at 199–218.

163. *Id.* at 218–21.

164. *See* Eldred v. Ashcroft, 537 U.S. 186, 219 (2003) ("The Copyright Clause and First Amendment were adopted close in time. This proximity indicates that, in the Framers' view, copyright's limited monopolies are compatible with free speech principles."); *see also supra* notes 29 & 68–69 (discussing the historical background of the Copyright Clause).

165. *See Eldred*, 537 at 219 ("Due to this distinction, every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication."); *supra* notes 75–76, 92 & 101 (explaining the limitations of copyright protection).

166. *See Eldred*, 537 U.S. at 220 (noting that the CTEA allows libraries to reproduce works and exempts small businesses from paying certain performance royalties); *infra* note 220 (noting these two limitations).

167. *Id.* at 221 (distinguishing Turner Broad. Sys., Inc. v. FCC, 512 U.S. 622 (1994)).

168. *Id.*

169. *See, e.g.*, Michael D. Birnhack, *Copyright Law and Free Speech After* Eldred v. Ashcroft, 76 S. CAL. L. REV. 1275, 1276 (2003) ("In this Article, I wish to challenge the constitutional dimension of the judicial rejection of the conflict argument, which concerns the conflict between copyright law and the First Amendment."); Erwin Chemerinsky, *Balancing Copyright Protections and Freedom of Speech: Why the Copyright Extension Act Is Unconstitutional*, 36 LOY. L.A. L. REV. 83, 85 (2002) ("My thesis is clearly stated: Copyright protections are tolerated under the First Amendment because they encourage speech. Extending copyright protections *after* the speech has occurred does not serve this purpose."); Joseph P. Liu, *Copyright and Breathing Space*, 30 COLUM. J. L. & ARTS 429, 430 (2007) ("In this Article, I argue that a similar approach [substantive and procedural alterations] is warranted in copyright law."); Neil Weinstock Netanel, *Locating Copyright*

interest of preserving just one more tree (or electron), suffice it to say that I generally agree with those observations. However, the Court's casual dismissal of First Amendment values serves as a continuing alarm for those like me who give greater primacy to free speech concerns.

As interpreted by the Court, "limited terms" apparently only is the opposite of "infinite protection." But, it is no bulwark against protection that can extend for well over a century, into the lives of the grandchildren and great-grandchildren of the creators.[170] Today, as a result of the CTEA, exclusive copyright protection exists for any work created since 1923, as long as, with respect to works created between that date and 1992, proper and timely registration and renewal were made.[171] With the narrow exception of certain unpublished works,[172] not a single protected work has entered the public domain since 1998, and not a single protected work will enter the public domain until the end of the year 2018.[173] Since that vast body of protected materials doubtless encompasses the overwhelming majority of the works which would be the subject of unauthorized use[174]

Within the First Amendment Skein, 54 STAN. L. REV. 1, 69 (2001) ("First Amendment challenges to copyright law arise in two basic contexts. The first involve facial challenges to legislative and regulatory extensions of copyright holder rights. The second consist of First Amendment defenses to specific applications of copyright holder rights.").

170. The term of copyright of a work created by most individual authors now consists of "the life of the author and 70 years after the author's death." 17 U.S.C. § 302(a) (2006). With growing life expectancies, a work created by a latter-day young and healthy Mozart could easily have copyright protection for well over 150 years.

Certain other works get protection for nearly a century, and in some cases even longer. *See id.* § 302(c) ("In the case of an anonymous work, a pseudonymous work, or a work made for hire, the copyright endures for a term of 95 years from the year of its first publication, or a term of 120 years from the year of its creation, whichever expires first.").

171. *See infra* note 180 and accompanying text (discussing the 1992 statute making renewal automatic for works created between 1964 and 1977).

172. *See* 17 U.S.C. § 303 (specifying the duration of copyright for works created but not published before the effective date of the Copyright Act).

173. The ninety-five year term of a work created in 1923 will finally expire in 2018 unless Congress once again extends the duration of copyright. *See id.* § 305 (providing that the term of copyright runs through the end of the calendar year in which it would otherwise expire).

174. Because the musical works in the American Society of Composers, Authors & Publishers (ASCAP) and the Broadcast Music, Inc. (BMI) repertoires alone approach 5 million works, the corpus of protected materials doubtless runs into the tens of millions. *See AMERICAN SOCIETY OF COMPOSERS, AUTHORS & PUBLISHERS*, www.ascap.com/about (last visited Sept 24, 2010) (licensing and distributing royalties for performances of certain copyrighted work) (on file with the Washington and Lee Law Review); BROADCAST MUSIC, INC., www.bmi.com/about (last visited Sept 24, 2010) (licensing and distributing royalties from businesses that use music) (on file with the Washington and Lee Law Review).

and for which First Amendment freedom would be sought, the promise of only limited duration as a safety valve is wholly illusory to address this concern.

Since *Eldred* was decided, two other kinds of challenges have been mounted under the First Amendment to statutes which have altered the time frame in which copyrighted works will fall into the public domain.[175] One challenge has been completely unsuccessful.[176] The other was directly rebuffed by one court of appeals;[177] in another circuit, the challenge was initially remanded for further analysis but was ultimately rejected there as well.[178]

The 1976 Copyright Act, as enacted, retained the system under the 1909 Act, which mandated renewal of copyrights; renewal was required for all works that were still in their first term in 1978, which was the effective date of the 1976 Act.[179] However, that requirement was abolished by the Copyright Renewal Act (CRA), which made renewal automatic, for a second term of forty-seven years.[180] That was then extended to a renewal term of sixty-seven years by the CTEA.[181] In the absence of this change, unless the copyright owner had taken the affirmative step of renewal, works created between 1964 and 1977 would have fallen into the public domain.[182] Now, copyright on these works automatically extends from 2059 to 2072.[183] In *Kahle v. Gonzales*,[184] the Ninth Circuit rejected both First Amendment and Copyright Clause challenges to the Copyright

175. *See infra* notes 176–78 and accompanying text (identifying two challenges mounted under the First Amendment to copyright statutes).

176. *See infra* notes 184–87 and accompanying text (addressing the challenge raised in *Kahle v. Gonzales*).

177. *See infra* notes 188–95 and accompanying text (addressing the challenge raised in *Luck's Music Library, Inc. v. Gonzales*).

178. *See infra* notes 196–208 and accompanying text (addressing the challenge raised in *Golan v. Gonzales*).

179. 17 U.S.C. § 304(a) (2006). Because the initial term of copyright under the 1909 Act was twenty-eight years, that provision required renewal, in the twenty-eighth year, of works created between 1950 and 1977.

180. Copyright Renewal Act of 1992, Pub. L. No. 102-307, Title I, § 102(a) & (d), 106 Stat. 264, 264–66 (1992) (codified as amended in scattered sections of 17 U.S.C.).

181. *See supra* note 158 and accompanying text (discussing the CTEA).

182. This process was most likely to occur with respect to the large bulk of works which had little or no commercial value.

183. *See supra* note 180 and accompanying text (explaining the effect of the CRA).

184. *See* Kahle v. Gonzales, 487 F.3d 697, 698 (9th Cir. 2007) (addressing the petitioner's claims that alterations in the copyright system ought to require First Amendment review), *cert. denied*, 552 U.S. 1096 (2008).

Renewal Act.[185] As to the former, the court found that the change from an "opt-in" to an "opt-out" system, resulting in the *de facto* extension of many copyright terms, was "materially indistinguishable" from the CTEA extensions upheld in *Eldred*.[186] In both situations, the Congress decided to treat copyright for existing works and future works similarly, and the First Amendment did not stand as an obstacle to that decision.[187]

The other challenge involved the URAA. By that statute, the Congress went a step even beyond the CTEA's and CRA's extension of existing copyright terms—it *restored* copyright protection to certain works which had already fallen into the public domain.[188] Copyrights on a number of works of foreign holders, although still protected by the law where the work was originally published, had fallen into the public domain in the United States.[189] The URAA established or reestablished copyright protection under American law for those works.[190]

Two courts of appeals have considered, and rejected, challenges to URAA by entities that had previously used those works without restriction.[191] Because of the URAA, those entities, or individuals, have now either been absolutely barred from those uses or been subjected to licensing and the payment of royalties.[192] In one case, the D.C. Circuit limited its consideration to a challenge under the Copyright Clause.[193] The court held that this situation was also controlled by *Eldred*,[194] concluding

185. *See id.* at 701 ("Both of Plaintiffs' main claims attempt to tangentially relitigate *Eldred*. However, they provide no compelling reason why we should depart from a recent Supreme Court decision.").

186. *Id.* at 700.

187. *See id.* ("[E]xtending existing copyrights to achieve parity with future copyrights does not require further First Amendment scrutiny."). The court went on to note that "traditional First Amendment safeguards such as fair use and the idea-expression dichotomy are sufficient to vindicate the speech interests affected by the CRA and the CTEA." *Id.* The court also rejected the plaintiff's Copyright Clause claim, holding that it was disposed of by *Eldred*. *Id.*

188. URAA, 17 U.S.C. § 104A (2006).

189. This might have occurred for a variety of reasons. For example, the United States may have failed to recognize copyrights of a particular country, or the copyright owner may have failed to comply with formalities for American protection.

190. *See supra* note 188 and accompanying text (discussing the impact of the URAA).

191. *See infra* notes 193–208 (detailing two court opinions considering challenges to the URAA).

192. *See supra* note 189 and accompanying text (discussing the effect of the URAA).

193. Luck's Music Library, Inc. v. Gonzales, 407 F.3d 1262, 1262–63 (D.C. Cir. 2005) (affirming the district court's order dismissing plaintiff's claims that the URAA was unconstitutional).

194. The district court had also considered a First Amendment challenge, but then had

that there was no "material distinction . . . in terms of the language of the Copyright and Patent Clause or the proper roles of Congress and the judiciary . . . ."[195]

In the other case, the Tenth Circuit also rejected a Copyright Clause challenge to the URAA, but remanded the plaintiffs' attack based on the First Amendment in its first analysis of the issue.[196] The court's analysis began by asking whether the URAA had "altered the traditional contours of copyright protection."[197] Unlike the extension of copyright terms for existing copyrights, which had occurred on multiple occasions in the past, here the statute took the highly unusual step of removing works from the public domain.[198] And that alteration of the "traditional contours affected the plaintiffs' First Amendment interests," since that provision protects their right to unrestrained use of those works.[199] "By removing works from the public domain, [the URAA] arguably hampers free expression and undermines the values the public domain is designed to protect."[200] Finally,

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dismissed that as well. *See* Luck's Music Library, Inc. v. Ashcroft, 321 F. Supp. 2d 107, 119 (D.D.C. 2004) ("When Congress 'has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary . . . .'" (quoting Eldred v. Ashcroft, 537 U.S. 186, 221 (2003))). Furthermore, the court concluded that the URAA "does not encroach on the traditional copyright protections and includes additional protections . . . ." *Id.*

195. *Luck's*, 407 F.3d at 1265. "Plaintiffs completely fail to adduce any substantive distinction between the imbalance (if it be that) in tacking 20 years onto a copyright term about to expire in (say) a year, and extending protection to material that has fallen into the public domain." *Id.*

196. *See* Golan v. Gonzales, 501 F.3d 1179, 1187 (10th Cir. 2007) ("The clear import of *Eldred* is that Congress has expansive powers when it legislates under the Copyright Clause, and this court may not interfere so long as Congress has rationally exercised is authority."), *modified on other grounds*, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010).

197. *Id.* The significance of this test for possible First Amendment scrutiny of copyright legislation is discussed *infra* notes 253–66 and accompanying text.

198. *See supra* note 188 and accompanying text (discussing the URAA). The court stated that it was a "bedrock principle of copyright law that works in the public domain remain there," and concluded that the URAA "alters the traditional contours of copyright protection by deviating from this principle." *Golan*, 501 F.3d at 1187–88.

The URAA deviated from the standard progression—from creation to copyright to the public domain—because under the Act, "the copyright sequence no longer necessarily ends with the public domain; indeed, it may begin there." *Id.* at 1189. Unlike the prior statutory extensions of pre-existing works referenced in *Eldred*, there was only a very limited history, involving exceptional situations, of extricating works from the public domain. *See id.* at 1190 ("The significance of the copyright sequence, combined with the principle that no individual may copyright a work in the public domain, is that ordinarily works in the public domain stay there.").

199. *Golan*, 501 F.3d at 1192.

200. *Id.* at 1194.

the court concluded that the two traditional internal mechanisms for reconciling copyright and the First Amendment—the idea-expression dichotomy and the fair use doctrine—did not adequately serve to protect speech interests.[201]

The Tenth Circuit, however, did not find the URAA to be unconstitutional, but only concluded that its "interference with plaintiffs' rights [was] subject to First Amendment scrutiny."[202] Therefore, it remanded the plaintiffs' challenge to the district court, to determine, among other questions, whether the URAA was content-based or content-neutral.[203]

On remand, the court initially noted that the parties agreed that the URAA restraints were content-neutral, and it accepted that assessment.[204] The court then found that the restoration of rights to works that previously were in the public domain, which was effected by the URAA, was unconstitutional.[205] The statute significantly burdened the plaintiffs' speech interests, and the statute did not advance significant government interests by abridging those rights.[206]

On its second consideration of this constitutional challenge, the Tenth Circuit reversed, upholding the URAA against all challenges.[207] Applying the two prongs of the intermediate scrutiny test,[208] the court of appeals found that the statute advanced important government interests unrelated to the suppression of free speech, and that it did not burden substantially more speech than was necessary to further those interests.

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201. *Id.* at 1194–95.

202. *Id.* at 1194.

203. *Id.* at 1196–97. The significance of this determination is that content-neutral restraints are subject to intermediate scrutiny. The different tests used to evaluate content-based and content-neutral restraints are discussed *infra* notes 267–72 and accompanying text.

204. *See* Golan v. Holder, 611 F. Supp. 2d 1165, 1170 (D. Colo. 2009) ("[T]he speech restricted is a general category of speech—namely, speech created by foreign authors."), *rev'd*, 609 F.3d 1076 (10th Cir. 2010).

205. *See id.* at 1177 ("Accordingly—to the extent [the URAA] suppresses the right of reliance parties to use works they exploited while the works were in the public domain—[the URAA] is substantially broader than necessary to achieve the Government's interest.").

206. *Id.* at 1172–77. The three interests proffered by the government, but which were found inadequate by the court to justify the abridgement wrought by URAA, were (1) the desire to bring the United States into substantial compliance with its treaty obligations under the Berne Convention, (2) protection of copyright interests of U.S. authors in other countries, and (3) correction of "historical inequities" suffered by foreign authors under American law. *See id.* (outlining and analyzing the government's proffered interests).

207. Golan v. Holder, 609 F.3d 1076, 1095 (10th Cir. 2010).

208. *See supra* note 203 and accompanying text (discussing the intermediate scrutiny test).

Two conclusions can be drawn from the various statutory provisions setting forth the terms of a copyright,[209] and from *Eldred* and these subsequent cases addressing challenges to amendments to those provisions. It is clear that the "limited duration" requirement grounded in Article I does not serve as a significant internal safeguard for First Amendment concerns. To the contrary, the relative indifference of these courts to those concerns, and their willingness to defer to Congressional judgments about the appropriate scope of copyright protection, indicates that other means must be found to deal with the occasional First Amendment clashes.

d. Merger Doctrine and Scenes à Faire

As noted above, one potential reconciliation of the First Amendment and copyright is the principle that the latter only protects expression, and that others remain free to express the underlying idea in other ways.[210] Under the merger doctrine, copyright protection will be withheld even from a work's original expression, if the work's underlying idea can be effectively expressed only one way.[211] The related *scenes à faire* doctrine provides that copyright protection may be withheld from certain elements of a work which are "pre-ordained" by the work's unprotectable ideas; examples of this are certain basic plot or character qualities, which would typically be found in any work of that type.[212] The merger doctrine has most frequently been used to withhold protection for functional and factual works, while the *scenes à faire* doctrine more frequently arises to limit protection for fictional works.[213]

It is initially noteworthy that these doctrines are invoked far less frequently than the first two internal mechanisms already discussed. In any event, the objections to concluding that the idea-expression dichotomy and the fair use doctrine fully address First Amendment concerns[214] also apply to

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209. 17 U.S.C. §§ 302–05 (2006).

210. *See supra* Part III.B.2.a (discussing the general rule that copyright only protects specific expression).

211. *See generally* 1 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 2.3.2 (3d ed. Supp. 2009) (explaining the merger doctrine of copyright law).

212. *See id.* § 2.3.2.2 (explaining the *scenes à faire* doctrine and the idea of "pre-ordained" elements).

213. *Id.*

214. *See supra* notes 79–91 & 107–33 and accompanying text (explaining various reasons why the idea-expression dichotomy and the fair use doctrine are not sufficient safeguards for the First Amendment).

merger and *scenes à faire*.[215] The scope of these doctrines suffers from similar imprecision, once again giving rise to a chilling effect on potentially lawful speech. More importantly, as discussed more fully below, the need to use copyrighted expression is not usually the product of the inability to describe the expression in another way; rather, it is the product of the fact that in certain situations, those alternatives are simply not adequate substitutes, and that the robustness of dialogue contemplated by the First Amendment may indicate the imperative for using that particular form of protected expression.[216]

e. Other Internal Mechanisms

Arguably, some of the other limitations on copyrightability or on the rights and remedies of copyright owners may serve to address First Amendment concerns. These limitations include the requirement of originality as a condition for obtaining copyright protection;[217] the first sale doctrine;[218] the limitation on the performance right to public performances;[219] and a host of other statutory exceptions, exemptions and compulsory licenses.[220] While these limitations may affect the copyright-First

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215. *Cf.* N.Y. Mercantile Exch. v. Intercontinental Exch., Inc., 497 F.3d 109, 116–18 (2d Cir. 2007) (rejecting a challenge by a commodities futures exchange to a competitor's use of settlement prices that were determined on a daily basis by exchange members), *cert. denied*, 552 U.S. 1259 (2008). The court determined that even if prices were sufficiently creative and original to warrant copyright protection—an issue on which the majority expressed doubt—protection for the idea of determining those prices was precluded by the merger doctrine; the court did not discuss First Amendment interests in the free dissemination of that information. *Id.*

216. *See infra* Part III.C.2.b.(2) (discussing situations in which there is a compelling First Amendment reason for using the protected speech, including situations in which paraphrasing the copyrighted work would not serve the same purpose).

217. *Cf.* Feist Publ'ns., Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345–46 (1991) ("The *sine qua non* of copyright is originality . . . . Originality is a constitutional requirement.").

218. *See* 17 U.S.C. § 109(a) (2006) (permitting the owner of a particular copy of a work to sell or otherwise dispose of the possession of that copy).

219. *See id.* § 106(4) (granting the copyright owner an exclusive right to perform the copyrighted work publicly).

220. *See id.* §§ 108–21 (providing various statutory limitations on the exclusive rights granted by § 106). In *Eldred v. Ashcroft*, 537 U.S. 186 (2003), the Court identified two aspects of the CTEA which "supplements . . . traditional First Amendment safeguards." *Id.* at 220. These were the exception in 17 U.S.C. § 108(h) for libraries and archives to reproduce certain works during the last 20 years of the copyright term, and the provision in § 110(5)(B) expanding the exemption for small businesses and restaurants from having to pay royalties for the performance of music from broadcast sources. *Id.* If these really are

Amendment clash at the margins, they also fail to address the bulk of the concerns raised by the sometimes inconsistent interests embodied in the two regimes.

C. *Sometimes First Amendment Interests Trump*

Even though my default position in the event of a clash is to tip the balance towards greater protection of free speech, and thus to an expansion of the unconstrained right to reproduce and distribute copyrighted material, I recognize that the First Amendment does not provide unlimited rights to use those materials.[221] Admittedly, merely waving a constitutional flag should not be enough. Thus, I find intellectual allies with other commentators who would expand the reach of the First Amendment in dealing with copyright claims, but who also recognize the limits on that defense.[222]

Although the potential clash between these two regimes is not merely a "tempest in a teapot," it is true that the worst fears of champions of First Amendment values have not been realized. In the majority of cases asserting free speech defenses, copyright claims have yielded based on one of the "internal mechanisms," and so First Amendment concerns have been satisfied, even if they were not addressed directly.[223] This is a desirable outcome. There is a preference for avoiding constitutional issues, if matters can be resolved on the basis of statutory interpretation.[224]

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supplements, their First Amendment impact is minimal at best.

221. *See* Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc., 600 F.2d 1184, 1188 (5th Cir. 1979) ("The first amendment is not a license to trammel on legally recognized rights in intellectual property."); Intellectual Reserve, Inc. v. Utah Lighthouse Ministry, Inc., 75 F. Supp. 2d 1290, 1295 (D. Utah 1999) ("[T]he First Amendment does not give defendants the right to infringe on legally recognized rights under the copyright law."). *But see* Jed Rubenfeld, *The Freedom of Imagination: Copyright's Constitutionality*, 112 YALE L.J. 1, 24–30 (2002) (rejecting a claim that copyright is immune from a First Amendment challenge because it is a form of property).

222. *See, e.g.*, Alan E. Garfield, *The Case for First Amendment Limits on Copyright Law*, 35 HOFSTRA L. REV. 1169, 1172 (2007) ("Scholars may have undermined their own cause by exaggerating the threat of overbearing copyright owners and by casting their arguments in theoretical terms that have left judges with little practical guidance.").

223. *See, e.g.*, Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 803 (9th Cir. 2003) (affirming the dismissal of a challenge to a parody because it was shielded by the fair use doctrine, while noting that the "[defendant] has created the sort of social criticism and parodic speech protected by the First Amendment and promoted by the Copyright Act"); *infra* notes 279, 330 and accompanying text (discussing *Mattel*).

224. A passage from Justice Brandeis's concurring decision in Ashwander v. TVA, 297 U.S. 288 (1936) (Brandeis, J., concurring), is often cited in connection with the doctrine of "constitutional avoidance": "The Court will not pass upon a constitutional question although

1. There Really Is a Problem

Courts, however, have not always gotten it right. To the contrary, as discussed below, there are a number of cases in which courts improperly rejected arguments that the First Amendment shielded the defendants' conduct from claims of copyright infringement.[225] More significantly, the uncertainty as to whether particular unauthorized uses of copyrighted materials would be shielded by the First Amendment and the costs and risks of litigation doubtless have led, and will continue to lead, many speakers to desist from conduct which might have been determined, by at least some courts, to be perfectly lawful.

Indeed, the cases in which, in my view, the courts have gotten it wrong are likely only the tip of the iceberg. It is the self-censoring effect of under-protection for the First Amendment which is probably the far more significant concern.[226] Here, like the famous canine identified by Sherlock Holmes, our concern is for the "dog that didn't bark."[227] Unfortunately, the result of present-day doctrine is that our political, social and cultural

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properly presented by the record, if there is also some ground upon which the case may be disposed of . . . ." *Id.* at 347. "[I]f a case can be decided on either of two grounds, one involving a constitutional question, the other a question of statutory construction or general law, the Court will decide only the latter." *Id.*; *see also* FCC v. Fox Television Stations, Inc., 129 S. Ct. 1800, 1811 (2009) ("The so-called canon of constitutional avoidance is an interpretive tool, counseling that ambiguous statutory language be construed to avoid serious constitutional debate."); Office of Sen. Mark Dayton v. Hanson, 550 U.S. 511, 514 (2007) (noting the "established practice of interpreting statutes to avoid constitutional difficulties").

225. *See, e.g.*, *infra* note 236 and accompanying text (identifying some cases in which the court rejected a First Amendment defense).

226. In Smith v. California, 361 U.S. 147 (1959), the Court identified concern for self-censorship as a basis for striking down a Los Angeles city ordinance which imposed strict criminal liability—irrespective of scienter—on retailers possessing or selling obscene materials. *Id.* at 219–20. It noted that the booksellers' alternative, which would likely have resulted in the removal of nonobscene as well as obscene materials from their shelves, would have harmed the public as much as the sellers themselves:

> For if the bookseller is criminally liable without knowledge of the contents, and the ordinance fulfills its purpose, he will tend to restrict the books he sells to those he has inspected; and thus the State will have imposed a restriction upon the distribution of constitutionally protected as well as obscene literature. . . . The bookseller's self-censorship, compelled by the State, would be a censorship affecting the whole public . . . .

Id. at 153–54 (footnotes omitted). *See also* McKinney v. Alabama, 424 U.S. 669, 685 (1976) (asserting that "the possible erroneous imposition of civil sanctions under the preponderance-of-the-evidence standard simply creates too great a risk of self-censorship").

227. *See* ARTHUR CONAN DOYLE, *Silver Blaze* (1892), *in* THE COMPLETE SHERLOCK HOLMES 335, 347 (Barnes & Noble, Inc. 1992).

dialogues have become less robust than the First Amendment would sanction.[228] Therefore, continued attention to achieving the proper balance continues to be necessary.

There are several reasons that First Amendment interests are under-protected. To begin with, as discussed above,[229] the various proffered internal mechanisms have not proven adequate for full vindication of First Amendment values.[230] Second, as just noted, because of the uncertainty regarding their reach, parties cannot know ex ante the extent of the accommodation that will be afforded to First Amendment goals, and so they may simply desist from taking the chance of liability for copyright infringement.[231] In those cases in which parties have taken that risk, sometimes First Amendment values have taken a back-seat, because courts have given an unduly restrictive reading to these internal mechanisms.[232] Also, one cannot take complete satisfaction even from some of the decisions where the First Amendment ultimately prevailed, because there the courts may have given what many commentators might view as an inaccurately expansive treatment to those safety valves.

The inability of the internal mechanisms fully to address First Amendment concerns is best demonstrated by an examination of some illustrative cases. Several of these cases have already been discussed;[233] others are discussed in the following portion of this Article.[234] In general, however, they fall into two categories. In one—which includes the cases already discussed—plaintiffs have asserted facial challenges to statutes expanding the scope of copyright protection, and they have argued, in part, that the expansion is inconsistent with the First Amendment.[235] The other

228. *See* James Boyle, *The First Amendment and Cyberspace: The Clinton Years*, 63 LAW & CONTEMP. PROBS. 337, 341 (2000) ("[C]oncern for First Amendment values seems entirely over-shadowed by a commitment to intellectual property maximalism.").

229. *See supra* Part III.B.2 (discussing the various internal mechanisms of the copyright system for dealing with First Amendment concerns).

230. *See, e.g.*, Eldred v. Ashcroft, 537 U.S. 186, 252–53 (2003) (Breyer, J., dissenting) (providing examples of situations where neither idea-expression restriction nor fair use exception would adequately protect First Amendment interests).

231. *See supra* notes 82, 108, 153 and accompanying text (discussing the chilling effect of the threat of litigation).

232. *See, e.g.*, *Eldred*, 537 U.S. at 252–53 (Breyer, J., dissenting) (criticizing the "'First Amendment safeguards' in which the majority places its trust").

233. *See supra* notes 134–46 and accompanying text (discussing *Harper & Row*); notes 159–68 and accompanying text (discussing *Eldred*).

234. *See infra* Part III.C.2 (discussing cases that may be helpful in crafting a solution).

235. *See supra* Part III.B.2.c (discussing challenges to copyright statutes for violating the "limited duration" requirement of the Constitution).

category, which involves "as applied" challenges, presents even more problematic issues. Here, the defendant may have had a First Amendment defense to claims of copyright infringement; in most of these cases, the court found for the plaintiff, usually after concluding that the fair use defense was inapplicable.[236] This second, more traditional, category is likely to be more helpful in identifying the appropriate reconciliation of the copyright regime and the First Amendment, by pointing towards some defining principles.

My claim for an expansion of the rights of speakers to make greater unconstrained use of copyrighted materials flows from the assertion that it is simply not true, as some courts have suggested, that the First Amendment is "inapplicable" to copyright disputes.[237] To the contrary, there are *constitutional* grounds for acknowledging limits on the scope of the copyright laws.[238]

One basis for recognizing First Amendment-derived limitations is the fact that copyright protection is neither absolute nor self-enforcing. Unlike the First Amendment, which, standing by itself, restricts the ability of the government to limit speech, the Copyright Clause does not confer any rights on authors. Instead, it merely creates a reservoir of congressional power, to enact certain legislation.[239] First, the existence and scope of any rights conferred are the product of whatever statutes Congress has passed; those statutes, in turn, contain limitations on those rights (including compulsory

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236. *See, e.g.*, *infra* notes 311–17 and accompanying text (discussing *Los Angeles News Service v. CBS Broadcasting, Inc.*); notes 325–31 and accompanying text (discussing *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*); notes 331, 402 and accompanying text (discussing *Walt Disney Productions v. Air Pirates*); notes 359–67 and accompanying text (discussing *New Era Publications International v. Henry Holt & Co.*).

237. *See, e.g.*, Eldred v. Reno, 239 F.3d 372, 375 (D.C. Cir. 2001) ("[C]opyrights are categorically immune from challenges under the First Amendment."), *questioned on this point, aff'd on other grounds sub nom.*, Eldred v. Ashcroft, 537 U.S. 186, 221 (2003); Chicago Bd. of Educ. v. Substance, Inc., 354 F.3d 624, 631 (7th Cir. 2003) ("The First Amendment adds nothing to the fair use defense. The defense . . . is the point of balance between the right to criticize, . . . one aspect of freedom of expression, and the incentive to create expressive works, . . . another aspect of the same freedom, the aspect that undergirds the Constitution's copyright clause."); Roy Export Co. Establishment of Vaduz v. Columbia Broad. Sys., 672 F.2d 1095, 1099 (2d Cir. 1982) ("No Circuit that has considered the question, however, has ever held that the First Amendment provides a privilege in the copyright field distinct from the accommodation embodied in the 'fair use' doctrine." (footnote omitted)), *cert. denied*, 459 U.S. 826 (1982).

238. *See generally* William W. Van Alstyne, *Reconciling What The First Amendment Forbids with What the Copyright Clause Permits: A Summary Explanation and Review*, 66 L. & CONTEMP. PROBS. 225, 238 (2003) (rejecting the claim that the Copyright Clause "'excepts' a certain area of legislation from the First Amendment").

239. *See, e.g.*, U.S. CONST. art. I, § 8, cl. 8 (granting Congressional power rather than mandating Congressional action).

licenses).[240] Second, the statutory regime also reflects the many rights that Congress could have granted but has in fact withheld.[241] Third, copyright legislation is bounded by the purposes and limitations embodied in the Copyright Clause.[242] Fourth, and perhaps most importantly, an implicit constraint on the power granted by that Clause is the limitations found elsewhere in the Constitution—including, of course, the First Amendment. Also, in deciding what rights and remedies to confer and what to withhold pursuant to its Copyright Clause powers, one would expect that Congress has indeed been mindful, or at least should have been mindful, of these limitations imposed by, and values reflected by, the entire Constitution, and it should be the duty of the courts to police those limitations.

Because of the importance that First Amendment values play in reconciling the competing interests of copyright owners and persons seeking broad rights to use copyrighted works, and because of the primacy that frequently should be given to the latter interest, two steps must be taken. First, courts must give more robust application to the internal mechanisms discussed above. Second, because that step is unlikely to be completely adequate to address those concerns, I argue that some additional external mechanisms are required to ensure that First Amendment values are properly safeguarded.[243]

The need to address these First Amendment concerns has grown over the three-plus decades since the passage of the Copyright Act. First, regardless of what one thinks about "propertization" of copyright,[244] or about

240. *See, e.g.*, 17 U.S.C. §§ 108–21 (2006) (providing various statutory limitations on a copyright owner's rights, including compulsory licensing).

241. *See, e.g., id.* § 106 (providing specific, delimited rights of the copyright owner).

242. *Cf. Eldred*, 537 U.S. at 199–205 (recognizing that Congress's authority to pass Copyright legislation is rooted in the Copyright Clause).

243. *Cf.* Online Policy Group v. Diebold, Inc., 337 F. Supp. 2d 1195, 1200 (N.D. Cal. 2004) ("Copyright protection sometimes appears to conflict with First Amendment protections. This conflict is ameliorated *in part* by various copyright doctrines." (emphasis added)).

244. *See, e.g.*, Shubha Ghosh, *Deprivatizing Copyright*, 54 CASE W. RES. L. REV. 387, 390 (2003) (arguing that "the time has come to recognize both copyright law as a form of privatization and the need to deprivatize copyright in order to realize the public good that Madison envisioned"); Wendy Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1535 (1993) (arguing "that a properly conceived natural-rights theory of intellectual property would provide significant protection for free speech interests"); Randal Picker, *From Edison to the Broadcast Flag: Mechanisms of Consent and Refusal and the Propertization of Copyright*, 70 U. CHI. L. REV. 281 (2003) (arguing that modern technologies for controlling access to copyrighted material have given copyright owners a greater degree of control akin to more traditional property); Stacy McDonald, Comment, *Copyright for Sale: How the*

the best balance of the interests of copyright owners, users of copyrighted materials, and persons seeking to create new works, there is no arguing that there have been significant changes in several aspects of copyright. This includes growth in the kinds of works for which copyright is available;[245] expansion of the rights of copyright owners and the remedies available against infringers;[246] extension of the duration of copyright;[247] and the creation of a variety of para-copyrights, granted most notably, but not exclusively, by the Digital Millennium Copyright Act.[248]

Commodification of Intellectual Property Distorts the Social Bargain Implicit in the Copyright Clause, 50 HOW. L.J. 541, 544 (2007) (arguing "that the commodification of intellectual property distorts the copyright balance by valuing a copyrighted work for its market potential over, above, and to the exclusion of its non-economic values").

245. *See, e.g.*, 17 U.S.C. § 102(a)(4) (affording, for the first time, statutory protection for pantomimes and choreographic works); *id.* § 102(a)(7) (affording protection for sound recordings, first protected by a 1971 amendment to the 1909 Act); *id.* § 102(a)(8) (adding, effective in 1990, protection for architectural works).

246. *See, e.g.*, Digital Theft Deterrence and Copyright Damages Improvement Act of 1999, Pub. L. No. 106-160, § 2, 113 Stat. 1774, 1774 (codified as amended at 17 U.S.C. § 504(c)) (increasing statutory damages by fifty percent); Digital Performance Right in Sound Recordings Act of 1995, Pub. L. No. 104-39, § 2, 109 Stat. 336, 336 (codified at 17 U.S.C. § 106(6)) (adding a section conferring the right to perform sound recordings by means of digital audio transmissions).

247. *See, e.g.*, Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (extending the copyright term of the 1976 Act for an additional 20 years); Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (setting the copyright term at the life of the author plus fifty years, or seventy-five years for anonymous or pseudonymous works, or works made for hire); Copyright Act of 1909, Pub. L. No. 60-349, 35 Stat. 1075 (setting the copyright term at twenty-eight years, with the possibility of an additional renewal term of twenty-eight years); Copyright Act of 1831, 4 Stat. 436 (setting the copyright term at twenty-eight years, with the possibility of an additional renewal term of 14 years); Copyright Act of 1790, 1 Stat. 124 (setting the copyright term at fourteen years, with the possibility of an additional renewal term of fourteen years); *supra* note 157 and accompanying text (discussing the repeated Congressional extension of copyright terms).

248. *See* DMCA, Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified at 17 U.S.C. §§ 1201–05) (prohibiting both actual circumvention of technology controlling access to copyrighted materials, and manufacture and sale of certain devices which permit circumvention of technological controls over access to or use of such materials); Universal City Studios, Inc. v. Reimerdes, 111 F. Supp. 2d 323, 323–25 (S.D.N.Y. 2000) (holding that fair use defense is unavailable for violations of DMCA), *aff'd sub nom.* Universal City Studios, Inc. v. Corley, 273 F.3d 429 (2d Cir. 2001); *supra* note 153 (discussing *Reimerdes*); *see also* Chamberlain Group, Inc. v. Skylink Techs., Inc., 381 F.3d 1178, 1199 n.14 (Fed. Cir. 2004) ("[L]eav[ing] open the question as to when § 107 might serve as an affirmative defense to a prima facie violation of § 1201 [of the DMCA].").

Other statutes which afford para-copyright protection include the Semiconductor Chip Protection Act, Pub. L. No. 98-620, 98 Stat. 3347 (1984) (codified at 17 U.S.C. §§ 901–14) (providing protection against unauthorized copying for semiconductor chips and "mask works"); the Audio Home Recording Act, 102 Pub. L. No. 102-563, 106 Stat. 4237 (1992)

Second, the ease with which copyrighted materials can be reproduced and the range with which they can be distributed has grown significantly since 1976. A few years ago, a new buzzword was "desktop publishing." Now, even that phrase is somewhat passé. Today, with a computer, anyone can make a perfect copy of literary and musical works, whether for personal or commercial purposes. Then, using that same computer and an internet connection, that person can send those copies virtually instantaneously to millions of people around the world, and at minimal expense for reproduction and distribution.[249]

The various expansions of copyright protection just noted are among the methods by which the owners of copyright interests have attempted to respond to these developments.[250] However, the opportunities afforded by these technological developments have also expanded the importance to speakers of being able to reproduce, distribute, alter or comment on the expressive elements of certain copyrighted materials, without first obtaining permission from the copyright owner.[251] The failure to adjust copyright and First Amendment jurisprudence to meet these needs has led to under-protection of free speech interests.

(codified at 17 U.S.C. §§ 1001–10) (authorizing copying controls on, and providing a royalty payment system for, digital audio recording devices); URAA, Pub. L. No. 103-465, §§ 512–13, 108 Stat. 4809, 4974–76 (1994) (codified at 17 U.S.C. § 1101 & 18 U.S.C. § 2319A) (creating an "anti-bootlegging" provision by providing civil relief and criminal penalties for unauthorized fixation, transmission, or distribution of live musical performances).

249. Many twenty-first century uses of digital technology and the Internet raise questions about the rationale underlying copyright protection, such as the continuing necessity for long-term, exclusive protection for works in order to incentivize their creation. Whether it is the proliferation of blogs, Facebook pages, or YouTube postings, millions of individuals seem perfectly happy to disseminate their creations without any regard to whether others will seek permission to reproduce or redistribute those works, much less make payment for those uses.

250. *See* McKenna, *supra* note 111, at 22 (noting that digital technologies not only make dissemination of copyrighted materials easier, but also increase likelihood of challenges because uses are more visible to copyright owners).

251. The correlative to this explosion of sources of creative works and vehicles for their distribution is an erosion of the preeminence of the traditional sources of copyrighted work. As suggested in *supra* note 249, newspapers and magazines have been supplemented by blogs; radio and television have been supplemented by the posting of material to YouTube; and mass-produced sound recordings and videos have been supplemented by people making and distributing individual copies of CDs and DVDs. And, more and more, people are relying on these alternative sources for information and entertainment. If they are to be encouraged and nurtured, individuals will often need more flexibility in being able to use preexisting, and frequently copyrighted, materials. *See* Boyle, *supra* note 228, at 349–50 (arguing for heightened attention to First Amendment values in online settings).

2. Seeking a Solution

So, finally, for the hard part: What is the solution? Are there tests, standards, approaches, or methodologies, that courts could use to reconcile these values?

a. General Principles

While not identifying precisely when copyright might have to yield, the Supreme Court in *Eldred* offered one possibility. The Court stated that the D.C. Circuit had "spoke[n] too broadly when it declared copyrights 'categorically immune from challenges under the First Amendment.'"[252] However, the Court stated that "copyright's built-in free speech safeguards are *generally adequate* to address [First Amendment concerns]."[253] That assertion obviously leaves unstated when those safeguards might prove inadequate.

A hint of the opening contemplated by the Court might have been provided by the concluding sentence in that portion of the opinion: "But when, as in this case, *Congress has not altered the traditional contours of copyright protection*, further First Amendment scrutiny is unnecessary."[254] While the meaning of this statement is unclear, it carries the problematic implication that the courts should defer to congressional judgments with respect to any statutory provisions, or subsequent amendment, that fall within these contours.

As discussed above,[255] several courts have used this highlighted language as a benchmark for determining whether a copyright statute may have run afoul of First Amendment limitations.[256] While this possible exception may be useful in beginning the analysis, I believe that it seriously understates the situations in which the First Amendment should prevail.

One problem with the statement of this "exception" is that the Court provided no guidance on the meaning of "traditional contours." Was this

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252. Eldred v. Ashcroft, 537 U.S. 186, 221 (2003) (quoting Eldred v. Reno, 239 F.3d 372, 375 (D.C. Cir. 2001)).

253. *Id.* (emphasis added).

254. *Id.* (emphasis added).

255. *See supra* notes 194 & 197–99 and accompanying text (discussing cases that have applied the First Amendment language of *Eldred*).

256. *See, e.g.*, Golan v. Gonzales, 501 F.3d 1179, 1187 (10th Cir. 2007) (quoting the highlighted *Eldred* language); Kahle v. Gonzales, 487 F.3d 697, 700 (9th Cir. 2007) (same); Luck's Music Library, Inc. v. Gonzales, 321 F. Supp. 2d 107, 119 (D.D.C. 2004) (same).

formulation simply a way of restating the idea-expression and fair use limitations on copyright protection? If so, it adds very little. Or, was there perhaps a suggestion that it referred to long-standing, but changeable, characteristics of copyright, and that the effects of such changes would be subject to First Amendment scrutiny?

If the answer to this latter question is "yes," considerable difficulty would arise by trying to ascertain what is meant by "traditional." For example, for the first eight decades of copyright legislation, there was no protection for derivative works,[257] the category that creates the greatest problems for potential First Amendment clashes.[258] It was not until 1870 that protection was first extended to the "right to dramatize or translate,"[259] and broader rights to control transformations, although still falling short of the right to prepare a derivative work conferred by the Copyright Act of 1976,[260] were not extended until 1909.[261] Yet, it is doubtful that the Court intended to open up First Amendment scrutiny for all derivative works.

Or, is this "exception" limited to more recent changes—for example, the doctrine that prevailed until 1978, that unpublished works were protected by state common law copyright rather than under federal law,[262] or that until 1989, certain formalities, including placement of notice, were required to claim copyright protection?[263] The recent creation of various para-copyrights[264] might be such an alteration. But, again, the Court's statement raises more questions than it provides answers.

Regardless of its meaning, the Court's reference to "traditional contours" takes too cramped an approach to accommodating First

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257. *See, e.g.*, Stowe v. Thomas, 23 F. Cas. 201 (C.C.E.D. Pa 1853) (denying Harriet Beecher Stowe relief against an unauthorized translation of *Uncle Tom's Cabin*).

258. *See supra* notes 85–89 and accompanying text (discussing the limitations imposed on First Amendment freedom by copyright's protection of derivative works).

259. Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212.

260. 17 U.S.C. § 106(2) (2006).

261. Copyright Act of 1909, Pub. L. No. 60-349, § 1(b), 35 Stat. 1075, 1075–76 (affording to copyright owners, with respect to various types of works, the right to translate, dramatize, convert, arrange, adapt, complete, execute and finish the work).

262. 17 U.S.C. § 301(a) (preempting protection inconsistent with the federal regime, and abolishing common law copyright); *see supra* note 38 and accompanying text (discussing the § 301(a) treatment of state common law copyright).

263. *See* Berne Implementation Amendments, Pub. L. No. 100-568, § 12, 102 Stat. 2853, 2860 (1988) (eliminating, as of Mar. 1, 1989, notice as a condition for obtaining copyright protection).

264. *See supra* note 248 and accompanying text (discussing the DMCA and other acts that create "para-copyrights").

Amendment interests to the copyright laws.[265] It suggests far too great a deference to Congress in weighing important constitutional values, something that the Court has been quite unwilling to do in a host of other settings.[266] Furthermore, clashes of those values can, and do, occur even within those "traditional contours." Thus, to resolve those clashes, I suggest looking not only to the goals of these two regimes, but also to ways in which core principles from First Amendment case law can form the underpinnings of my proposed methodology.

First, a very brief (and admittedly very incomplete) review of First Amendment jurisprudence follows.[267] In defining the extent to which the government is prevented from limiting speech,[268] one step often taken in interpreting that provision is to distinguish between content-based and content-neutral restraints.[269] For the former, courts use a "strict scrutiny" test, striking down the restraint unless the defendant meets the heavy burden of showing that the restriction is narrowly tailored to meet a

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265. *See generally* Alfred C. Yen, Eldred, *The First Amendment, and Aggressive Copyright Claims*, 40 HOUS. L. REV. 673 (2003) (noting the recent reliance by political candidates on copyright law to attack rivals' political speech, and expressing hope that *Eldred*'s signal—that courts should not ignore First Amendment concerns—may become a basis for rebutting these aggressive claims).

266. For the most recent, and controversial, of many possible examples, see *Citizens United v. Fed. Elections Comm'n*, 130 S. Ct. 876, 913 (2010), in which the Court struck down portions of the Bipartisan Campaign Reform Act of 2002 as inconsistent with protections afforded to corporations and labor unions by the First Amendment.

267. The Supreme Court has addressed the First Amendment in hundreds of decisions, addressing a multiplicity of factual situations. These include the kind of speech (political, obscene, defamatory, symbolic, etc.), the place (public streets, private property, schools, in a newspaper, etc.), the type of restriction imposed (prior restraint, post-conduct imprisonment, civil damages, etc.), and many other variations. What follows is obviously just the barest of bones of the tests used.

268. As noted earlier, this may include private parties using the courts in an attempt to limit the speech of others. *See supra* note 4 and accompanying text (acknowledging that the immediate cause of almost all specific restrictions of speech involve a private actor filing a suit).

269. There is extensive commentary in the literature as to the nature of copyright restrictions, and on which side of this divide they fall. That debate is beyond the scope of this Article.

As noted above, in Golan v. Gonzales, 501 F.3d 1179 (10th Cir. 2007), in considering a First Amendment challenge to the URAA, the Tenth Circuit thought it important to decide whether the challenged copyright restorations were content-neutral or content-based. *Id.* at 1196–97; *supra* notes 196–208 and accompanying text. Regardless of the relevance of this distinction to such a facial challenge to a statute, it has less importance in deciding whether an individual defendant can rely on the First Amendment to defend a particular use against claims of copyright infringement.

compelling public interest.[270] For the latter, courts use a more deferential standard, sometimes referred to as "intermediate scrutiny."[271] This kind of restraint will be upheld only if it is narrowly tailored to serve a significant governmental interest unrelated to the suppression of speech, if it is reasonable with respect to time, place and manner, and if ample alternative channels of communication have been left open.[272] I do not find it necessary to resolve any dispute as to the characterization of copyright's regulation of speech, though I recognize that those in the "content-based" camp have even stronger claims for extending First Amendment protection to copyright infringement defendants.[273] Rather, the approach that I suggest for reconciling the First Amendment-copyright clash draws on elements of the tests used for both of these kinds of restraints, and in many ways is the mirror of the limitations imposed on a variety of speech restrictions.

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270. *See, e.g.*, Pleasant Grove City, Utah v. Summum, 129 S. Ct. 1125, 1132 (2009) ("[A]ny restriction based on the content of the speech must satisfy strict scrutiny, that is, the restriction must be narrowly tailored to serve a compelling government interest . . . ."); Ysursa v. Pocatello Educ. Ass'n, 129 S. Ct. 1093, 1098 (2009) ("Restrictions on speech based on its content are 'presumptively invalid' and subject to strict scrutiny."); United States v. Playboy Enter. Group, 529 U.S. 803, 813 (2000) ("Since § 505 is content based, it can stand only if it satisfies strict scrutiny. . . . It must be narrowly tailored to promote a compelling Government interest, and if a less restrictive alternative would serve the Government's purpose, the legislature must use that alternative." (citations omitted)).

271. *See, e.g.*, *Ysursa*, 129 S. Ct. at 1103 (Breyer, J., dissenting) (describing "what the Court sometimes calls an 'intermediate scrutiny'").

272. *See, e.g.*, Clark v. Cmty. for Creative Non-Violence, 468 U.S. 288, 293 (1984) ("Expression . . . is subject to reasonable time, place, or manner restrictions . . . ."). "[R]estrictions of this kind are valid provided that they are justified without reference to the content of the regulated speech, that they are narrowly tailored to serve a significant governmental interest, and that they leave open ample alternative channels for communication of the information."). *Id.*; *see also* Thomas v. Chicago Park Dist., 534 U.S. 316, 322–23 (2002) (considering time, place, and manner restrictions in the context of public demonstrations in municipal parks); Ward v. Rock Against Racism, 491 U.S. 781, 791 (1989) ("[T]he government may impose reasonable restrictions on the time, place, or manner of protected speech, provided the restrictions 'are justified without reference to the content of the regulated speech, that they are narrowly tailored to serve a significant governmental interest, and . . . they leave open ample alternative channels for communication . . . .'" (quoting *Clark*, 468 U.S. at 293)); City of Renton v. Playtime Theatres, Inc., 475 U.S. 41, 47 (1986) ("[S]o-called 'content-neutral' time, place, and manner regulations are acceptable so long as they are designed to serve a substantial governmental interest and do not unreasonably limit alternative avenues of communication.").

273. *Compare* Baker, *supra* note 6, at 922 ("[C]opyright laws involve content-based suppression of speech in the simplest and most direct sense.") *and* Rubenfeld, *supra* note 221, at 5 ("[C]opyright law is clearly content-based in at least some of its applications.") *with* Netanel, *supra* note 83, at 47–54 (concluding that copyright is content-neutral speech regulation, which "should be subject to heightened, but not strict, scrutiny").

In summary, I would propose that in weighing claims to copyright exclusivity, First Amendment interests should prevail when there is a strong public interest in allowing the unauthorized use of the protectable expression; when the speaker has a compelling need to use the expression itself, i.e., when paraphrasing, or describing, or summarizing the work is simply inadequate to meet the speaker's needs; and when there are no reasonable alternatives available to obtain consent to that use. And, because of the importance I give to First Amendment values, I would place the burden of proof on the copyright owner to show that these criteria were *not* satisfied.[274]

I recognize both that the asserted need for greater protection for First Amendment interests is controversial,[275] and that my proffered formulation of occasions on which free speech concerns should displace of copyright protection is imprecise. Admittedly, it suffers from much the same unpredictability and unevenness in application that I decried with respect to the internal safeguards. To that extent, my concern for a chilling effect may be diminished, but it is not eliminated. However, the statement at least has the virtue of reiterating the occasional primacy of the First Amendment and continuing the dialogue—both academic and judicial—of the appropriate balance between the conflicting interests. One might expect that just as case law has given greater content to the imprecision of the fair use doctrine, judicial application of an approach like mine will concretize those standards.

b. Identifying Criteria to Implement These Principles

(1) The Public Interest

The key consideration for identifying situations in which First Amendment values would prevail over copyright claims is the existence of a public interest in allowing unfettered use of the copyrighted work. The nature of that interest is two-fold: the value to the speaker in being able to

274. *See supra* notes 130–31 & 151 and accompanying text (arguing for a rule that the plaintiff should have the burden of proof to show that First Amendment interests are not abridged).

275. *See, e.g.*, Lackland Bloom, *Copyright Under Siege: The First Amendment Front*, 9 COMP. L. REV. & TECH J. 41, 42 (2004) (describing *Eldred*'s "resounding rejection of practically all of the modern first amendment-based copyright challenges" as "correct, sensible and persuasive," and concluding that internal mechanisms adequately address virtually all free speech concerns).

disseminate, and perhaps to comment on or criticize, the protected expression, and the value to society in hearing or seeing that speech.[276] Both of these concerns inform an assessment of the nature and degree of this public interest. In addition, the importance to the speaker of using this particular protected expression is also relevant to my proposed second factor—the asserted need for that use.

The description of copyright as one of the branches of intellectual *property* offers support for certain public interest-based limitations on the rights of the copyright owner. The law regarding tangible property is replete with examples of limitations on the property owner. He may not engage in conduct which constitutes a nuisance. She may be subject to zoning restrictions. He may be required to permit public access or grant easements to the property. She may not place certain encumbrances on subsequent transfer or alienation of the property, and so on. Similarly, ownership of a copyright does not automatically entitle the owner to unlimited and unrestricted rights. In addition to the limitations in the statute itself, the First Amendment may serve as a basis for permitting increased access to certain expression, to the extent that there is a "public interest" in further limitations on the copyright owner's rights.[277]

The existence and nature of a public interest in fostering expanded dissemination of copyrightable expression will depend in part on its subject matter. It is particularly important to permit unauthorized, as well as

276. In our ever-expanding global world, speech uttered in this country is increasingly heard around the world. It is true that persons outside the United States may not have the same First Amendment claims for being deprived of the opportunity to hear speech whose utterance was foreclosed in the United States, as would persons within the United States who lost that opportunity. However, First Amendment interests are still implicated by that loss. In addition to the externality of a benefit flowing to foreign audiences from expanded protection for such speech, there is enhanced value for domestic speakers in having access to an international audience.

277. The question of whether particular speech is of public concern already is a part of First Amendment jurisprudence. For example, in *Philadelphia Newspapers, Inc. v. Hepps*, 475 U.S. 767 (1986), a private figure brought a libel action against a newspaper based on several articles which suggested that he had connections to organized crime. *Id.* at 770–71. At issue was which party had the burden of showing that the statements at issue were false. *Id.* at 776. The Court identified "two forces that may reshape the common-law landscape to conform to the First Amendment." *Id.* at 775. One was whether the plaintiff was a public official or a private figure. *Id.* "The second is whether the speech at issue is of public concern." *Id.*; *see also* Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc., 472 U.S. 749, 758–59 (1985) (noting that speech on "matters of public concern" is "at the heart of the First Amendment's protection" (citations omitted)).

permitted, uses of the original expression with respect to topics of discussion and controversy in the public arena.[278]

However, in determining whether there is a strong public interest in permitting such unauthorized uses, it is important not to over-emphasize the newsworthy quality of the use. It is true that the value to society may arguably be greater when the expression concerns political, social or economic issues, and so perhaps there should be a stronger presumption that unauthorized uses of those kinds of expressions are consistent with the public interest. But, because there often will also be important values in allowing greater access to expression which is more of a cultural, artistic or entertainment nature,[279] the public interest in the expanded and unconstrained dissemination of those kinds of works should not be understated.[280]

(2) Compelling Need to Use the Protected Expression

Although the public interest in allowing unconstrained dissemination would be the principal consideration in striking this balance, the competing interests of the copyright owner in constraining use of his or her work, and of the speaker in having broader access thereto, also deserve attention. Here, I would have courts focus on two issues, which form the second and

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278. Claims for expanding the scope of even unauthorized uses of expression when there is a greater public interest in those uses are supported by the rule giving expanded First Amendment protection in libel actions which are brought by public officials. In cases beginning with *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964), the Supreme Court has held that public officials must prove, by clear and convincing evidence, that the allegedly defamatory statement was false and was made with actual malice. *Id.* at 279–83. The same values which make it more difficult to attempt to suppress comments about those officials support permitting others to make unfettered use of copyrighted expression to discuss topics in the public arena.

279. *See, e.g.*, Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 806 (9th Cir. 2003) (concluding that photographs of a Barbie doll with social and political overtones were shielded by the fair use doctrine, and noting that "the benefits to the public in allowing such use—allowing artistic freedom and expression and criticism of a cultural icon—are great").

280. *See, e.g.*, Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1171 (9th Cir. 1977) (finding that the absence of any special, much less newsworthy, quality in the materials taken justified the rejection of the defendant's constitutional defense). The plaintiffs in *Krofft* had created a children's television show, replete with characters, locations and themes; the defendant used many of these elements in a series of commercials. *Id.* at 1160. After finding infringement, the court concluded: "Plaintiffs' work in this case is neither a graphic expression nor concerning newsworthy events. Therefore, no [F]irst [A]mendment considerations operate." *Id.* at 1171 (footnote omitted).

third parts of my test. Why was it necessary for the speaker to use the protected expression?[281] Were there reasonable and meaningful alternatives for her to convey that expression, and also any ideas embodied therein, without the unauthorized use of the copyrighted work? Could the parties reasonably have made arrangements for the copyright owner to authorize the use of the work?[282]

The existence of alternatives is evocative of the comparable inquiry under the Rule of Reason in antitrust analysis.[283] The defendants have engaged or propose to engage in behavior which arguably adversely affects competition; they note, in response, that the conduct is in fact intended to benefit competition. Assume not only that the proffered pro-competitive effects exist, but that arguably they outweigh the anti-competitive effects, so that the conduct in question would pass muster under the Rule of Reason. Courts still may require that the defendants show that those pro-competitive effects could not have been achieved using a "less restrictive alternative."[284]

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281. One aspect of this inquiry might be into the nature of the unauthorized speech. An element of fair use analysis is "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes . . . ." 17 U.S.C. § 107(1) (2006). Here, too, I would argue that the claims for a First Amendment privilege to make that use is stronger if the defendant does not seek to profit from that use; however, as with fair use analysis, some commercial purpose should not be fatal for a First Amendment defense. *See, e.g.*, Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 583–85 (1994) (finding that the commercial nature of a use does not make that use presumptively unfair, as commercial use is only one factor to be considered in the fair use analysis).

282. This inquiry parallels, but addresses different concerns than, another of the fair use considerations: The "effect of the [unauthorized] use upon the potential market for or value of the copyrighted work . . . ." 17 U.S.C. § 107(4). The copyright side of the analysis indicates that the unauthorized use is more likely to be deemed fair if the copyright owner suffers minimal or no economic harm. *Id.* From a First Amendment perspective, under this proposed approach, the unauthorized use would be least likely to be shielded if the copyright owner would have been willing to license the use on reasonable terms, but the second party declined that opportunity. Conversely, the use is more likely to be shielded if considerations of cost, time or convenience made authorized use difficult, and also where, with respect to unpublished or out-of-print works, the copyright owner was not seeking any economic benefit from the work. *See infra* notes 345–88 and accompanying text (discussing unpublished and out-of-print copyrighted works).

283. *See* Standard Oil Co. of N.J. v. United States, 221 U.S. 1, 62 (1911) ("[T]he criteria to be resorted to in any given case for the purpose of ascertaining whether violations of . . . section [1 of the Sherman Act] have been committed is the rule of reason . . . .").

284. *See, e.g.*, United States v. Brown Univ., 5 F.3d 658, 679 (3d Cir. 1993) ("To determine if a restraint is reasonably necessary, courts must examine first whether the restraint furthers legitimate objectives, and then whether comparable benefits could have been achieved through a substantially less restrictive alternative."). However, a demonstration of the mere existence of some less restrictive alternative to achieve the

In similar fashion, in the copyright context, courts undertaking this analysis should properly consider the importance to the speaker, and to the public, of the use of the plaintiff's protected expression, as opposed to requiring the speaker to use a paraphrasing or mere description of the work.[285] And, since some alternative will always be a possibility, courts would ask whether that reformulation is sufficiently informative or effective or convincing.

In a variety of contexts, we recognize that even if paraphrasing or verbal description may be possible, it often will be far less valuable or credible. Why, for example, do courts or academics quote the exact language of prior decisions or secondary authorities, rather than summarize them?[286] The use of the original language conveys authenticity and assures that the meaning of the words is not distorted. In these situations, as well as in many others, if the defendant cannot reasonably convey the information or his or her ideas without using the expressive aspects of the protected work, courts should conclude that there is a strong, if not compelling, case for allowing a First Amendment defense.[287]

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defendants' goal will not satisfy the plaintiff's burden of proof. Since there usually will be *some* such alternative, the question becomes whether it is a "reasonable" alternative—if it also is significantly less satisfactory in meeting those goals, if the costs of using that alternative are significantly greater, and so forth. *See generally* Christopher Sprigman, *Copyright and the Rule of Reason*, 7 J. TELECOMM. & HIGH TECH. L. 317 (2009) (drawing on antitrust jurisprudence, and suggesting different standards for copyright infringement likely to harm authors' incentives and those with more ambiguous effects).

285. *Cf.* Roy Export Co. Estab. of Vaduz v. Columbia Broad. Sys., 672 F.2d 1095, 1097 (2d Cir. 1982) (considering a challenge, by the owners of the copyrights in several Charlie Chaplin movies and in a compilation of excerpts of those movies, to a television network's use of substantial portions of the compilation in the creation of a retrospective biography which it broadcast shortly after Chaplin's death), *cert. denied*, 459 U.S. 826 (1982). Both the district court and the Second Circuit held out the possibility that in rare cases, the First Amendment might allow such unauthorized uses even if they were not shielded by the fair use doctrine. Roy Export Co. Estab. of Vaduz v. Columbia Broad. Sys., 503 F. Supp. 1137, 1147–48; *Roy Export*, 672 F.2d at 1099–1100. However, in this case, constitutional protection was unavailable because the defendant's use of the copyrighted works was "*not essential* to CBS's news report of Charlie Chaplin's death or to its assessment of his place in history." *Roy Export*, 672 F.2d at 1100 (emphasis added). Here, the defendant CBS in fact had been offered, and rejected, a license offered by the plaintiffs to use a different set of Chaplin film excerpts; alternatively, CBS could have used other Chaplin films which were in the public domain to create its own undoubtedly lawful compilation. *Id.* at 1097–99.

286. It is true that most of these situations will be covered by the fair use or other defenses, and so resort to the First Amendment would not be needed. As discussed above, however, these internal mechanisms often prove inadequate for a variety of reasons, and so First Amendment analysis would support immunity for those uses.

287. *Cf.* L.A. News Serv. v. Tullo, 973 F.2d 791, 795–96 (9th Cir. 1992) (identifying a

(3) Consent to Use Is Unavailable

The possibility that the defendant might in fact have authorized the plaintiff's use would certainly cut against a bald assertion that the First Amendment permits any unconstrained use.[288] However, there will be a myriad of situations in which the copyright owner will simply not allow others to reproduce, revise or create a new work based on that work. These may include situations such as in the *Suntrust* case,[289] where Margaret Mitchell's estate severely restricted the ability of others to create derivative works of *Gone With the Wind*, and doubtless would not have approved of the creation and distribution of *The Wind Done Gone*;[290] or, as in the *Pretty Woman* case,[291] where the plaintiff's agent categorically refused permission

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case in which the court asked the wrong question in rejecting the defendant's First Amendment defense). The plaintiff held copyrights in videotapes of newsworthy events—the sites of an airplane crash and a train wreck. *Id.* at 792. The defendant, which operated a news clipping service, made and then sold unauthorized copies of portions of those videotapes. *Id.* In its consideration of the defense, the court discussed a test proposed by Professor Melville Nimmer: That a "news photograph in which idea and expression are inseparable should be subject to a compulsory licensing scheme unless within a month of its making, the photograph appears in newspapers, magazines or television news programs servicing a given area." *Id.* at 796 (quoting MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHTS § 1.10[c][2] (1992 ed.)). Here, the test was not met because the defendant had not shown that these other depictions were unavailable. *Id.* But, since the First Amendment protects the interests of individual speakers in being able to convey both ideas and information in their own voices, as well as the societal utility in a multitude of such voices, it should not matter that other speakers may have previously spoken.

However, the court may still have reached the correct result. As noted below, the court should instead have asked whether the defendant had alternate means to make lawful use of the plaintiff's videotapes. *See infra* Part III.C.2.b.(3) (considering circumstances where consent for use is unavailable). Since the defendant's use was a commercial one, and it was potentially in competition with the plaintiff, the court should have inquired whether the defendant would have had a relatively easy opportunity to negotiate for the right to make and distribute these copies. *Infra* Part III.C.2.b.(3). The First Amendment is not a blanket license to take, free of charge, the intellectual property of one's competitors.

288. Here, I assume that the defendant is unable to rely on the fair use doctrine for that use. That doctrine is designed, of course, to permit certain limited uses, for certain purposes, without obtaining the permission—and perhaps notwithstanding the objection—of the copyright owner.

289. *See* Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1277 (11th Cir. 2001) (reversing the grant of a preliminary injunction prohibiting publication of a parody of *Gone with the Wind*).

290. *See id.* at 1282 (Marcus, J. concurring) (describing *Suntrust*'s "apparent practice of placing certain editorial restrictions on the authors of its licensed derivatives"); *infra* notes 332–39 and accompanying text (discussing *Suntrust Bank*).

291. *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 594 (1994) (finding that the defendant's commercial parody of the plaintiff's song might be immunized by the fair

for creation of an authorized rap version of the plaintiff's song;[292] or in *Geis*,[293] where the publisher refused all offers for permission to reproduce frames from the Zapruder film.[294] In other cases, while authority might be forthcoming, the process of obtaining that permission might be unreasonably laborious, time-consuming or expensive, or the copyright owner might seek an exorbitant fee for the use of the work. While of course the First Amendment provides no blanket immunity for unauthorized use, the case for permitting that use in these situations is stronger and more compelling.

The policies for permitting these uses, notwithstanding the objections of the copyright owner, are analogous to the compulsory licenses created by the 1976 Act.[295] Persons other than the copyright owners are permitted to use certain works, upon the payment of a statutorily or administratively determined royalty, because there is a strong public interest in expansive and unconstrained dissemination of those kinds of works, and because the transaction costs—in terms of money, time delay, and difficulty of consummating a formal contractual royalty—are significant. Similarly, if actual permission for use of works is reasonably available, First Amendment claims should not trump the copyright owner's interests. However, in those situations where such permission is not reasonably available, and where there are strong free speech interests in expanded distribution, my proposal would effectively result in a judicially created compulsory license, with a royalty of *zero*.[296]

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use defense, and remanding for reconsideration of the four factors in § 107).

292. *See id.* at 592 (noting that the "unlikelihood that creators of imaginative works will license critical reviews or lampoons of their own productions removes such uses from the very notion of a potential licensing market"); *id.* at 572–73 & 585 n.18 (concluding that requesting, and being denied, permission to make authorized use does not weigh against a finding of fair use).

293. *See* Time, Inc. v. Bernard Geis Assocs., 293 F. Supp. 130, 133 (S.D.N.Y. 1968) (granting summary judgment to the defendants in a fair use case surrounding the publication of a book about the assassination of President Kennedy).

294. *See id.* at 137–38 (detailing the plaintiff's refusal to grant permission for the use of the frames); *infra* notes 300–10 and accompanying text (discussing *Time, Inc.*).

295. *See* 17 U.S.C. § 111 (2006) (authorizing creation of statutory licenses for secondary transmissions by cable television systems); *id.* § 115 (providing for compulsory licenses for nondramatic musical works embodied in phonorecords); *id.* § 118 (providing for compulsory license for certain works used by noncommercial broadcasters); *id.* § 116 (providing for negotiated licenses for public performances of nondramatic musical works in coin-operated players, replacing the provision for compulsory licenses in the original 1976 Act).

296. Presumably, the possibility that courts might find for defendants in such situations would put pressure on owners of copyright interests in those works to negotiate actual

(4) Specific Applications of These Principles

There are a variety of situations in which I believe this test would be met, and in which First Amendment considerations would support the unauthorized use of copyrighted materials. The first includes certain works which are so famous or unique that there is no reasonable alternative to their use. A second category would include certain derivative works, and in particular parodies or satires. A third category would include certain unpublished works, and most particularly situations where the copyright owner is not seeking to exploit or distribute the work, but instead is using the copyright regime to keep the work from seeing the light of day. A fourth category—which is a variant on the third—includes certain works which were once published and are now out-of-print, but are still subject to copyright protection.[297] Other instances might also be identified.[298]

Probably the strongest category for invocation of First Amendment primacy would be for materials of a famous or unique nature, where the full meaning or impact of the subject matter cannot be conveyed other than by use of the particular expressive, and therefore copyright-protected, version of that subject matter. The *Geis* case, involving the Zapruder film of President Kennedy's assassination, has often been offered as a leading example for recognizing First Amendment primacy.[299]

Abraham Zapruder, a Dallas dress manufacturer, had stationed himself along the route of President Kennedy's motorcade, with the intention of filming home movies with his video camera.[300] The scene he photographed became "an historic document and undoubtedly the most important photographic evidence concerning the fatal shots."[301] Several years later, Josiah Thompson, a college history professor, wrote a book about the

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agreements, rather than adamantly declining all requests for licensing arrangements.

297. This situation is different from so-called "orphan works," where the identity and/or location of the copyright owner is unknown, or issues involved in the proposed Google Book Project, where the copyright owner would theoretically be willing to allow publication for a fee. Instead, this fourth category includes works where a known copyright owner has affirmatively decided *not* to permit further reproduction of an out-of-print work.

298. *See infra* notes 389–92 and accompanying text (considering materials such as model statutes and databases of information).

299. Even Professor Nimmer, in his famous article, recognized this situation as a possible exception to the primacy of the copyright regime in the face of First Amendment claims. *See* Nimmer, *supra* note 10, at 1197–99 (1970) (conceding that public interest would also dictate similar outcome for unauthorized reproduction and distribution of photographs of My Lai massacre).

300. Time, Inc. v. Bernard Geis Assocs., 293 F. Supp. 130, 133 (S.D.N.Y. 1968).

301. *Id.* at 131.

assassination, challenging the Warren Commission's conclusion of a single shooter.[302] In connection with his book, Thompson sought to use some of the frames from the Zapruder film.[303] Rights in the film had been assigned to Time, Inc.; Thompson and his publisher sought permission to use those images, but that permission was refused.[304] The defendant then used an artist's sketches of several dozen of the frames from the film; the court concluded that these were sufficiently identical to Zapruder's work as to constitute copyright infringement, unless the reproduction was protected by the fair use doctrine.[305]

In this case—which preceded the codification of the fair use doctrine in the Copyright Act of 1976, but which nonetheless looked to several of the factors which are contained in § 107—the court recognized a fair use defense for the defendants' conduct,[306] and therefore found it unnecessary to consider the defendants' alternative First Amendment defense.[307] But, even if the court had reached a contrary result on fair use, I argue that here free speech concerns would compel a recognition of a right to make these kinds of unauthorized uses of Zapruder's film. Although the court did not perform the analysis I have proposed, it made note of all of the factors that I have suggested a court should consider, to find a First Amendment right to make an unauthorized use of a work. There was a strong public interest in permitting this use.[308] There was a strong need to use the plaintiff's work, rather than having the defendant use some (here, nonexistent) alternative, or simply describe the work.[309] Also, negotiations to obtain permission, as an alternative to unauthorized use, had proven unsuccessful.[310]

An example of a situation in which First Amendment interests properly should have trumped any claims for copyright exclusivity is presented by a number of the lawsuits asserting infringement of the

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302. *Id.* at 131–32.

303. *Id.* at 137–38.

304. *Id.*

305. *See id.* at 144 ("There is thus an infringement by defendants unless the use of the copyrighted material in the Book is a 'fair use' outside the limits of copyright protection.").

306. *Id.* at 144–46.

307. *Id.* at 132.

308. *See id.* at 146 ("There is a public interest in having the fullest information available on the murder of President Kennedy.").

309. The court's conclusion on this point was far milder than I would have drawn, but it did note that "[w]hile doubtless the theory could be explained [by some alternatives], the explanation actually made in the Book with copies is easier to understand." *Id.*

310. *See supra* note 294 and accompanying text (explaining that the publisher refused to give permission to reproduce frames from the Zapruder film).

copyrighted videotape of the beating of Reginald Denny during riots in Los Angeles, which were an aftermath of the acquittal of police officers in the prior beating of Rodney King.[311] Los Angeles News Services (LANS)—an independent newsgathering organization that had made and then licensed video recordings of news events—had shot helicopter footage of Denny's beating.[312] In one of those cases, although it had broadcast the videotape on one of its own affiliates and had licensed it to other stations—for unstated reasons—LANS had refused to license it to KCAL, the defendant station.[313] KCAL then obtained the tape from another station and broadcast it a number of times. The district court granted summary judgment for KCAL on fair use grounds; the Ninth Circuit reversed.

The court of appeals's opinion made only a nodding reference to First Amendment considerations;[314] instead it focused solely on fair use, finding triable issues on the availability of that defense. Had the court applied the test I have suggested, its own analysis would have led to the conclusion that free speech interests prevailed over copyright claims. The court recognized that the beating of an innocent motorist during those riots was of overwhelming public interest and concern.[315] It would have ill-served KCAL's viewers to have a reporter merely describe the situation, rather than see it with their own eyes.[316] Because the videotape was the only visual record of the incident, the defendant had a compelling need to use it.

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311. *See, e.g.*, L.A. News Serv. v. CBS Broad., Inc., 305 F.3d 924, 942 (9th Cir. 2002) [hereinafter *LANS*] (providing a case where copyright prevailed over freedom of speech and press); L.A. News Serv. v. Reuters Television Int'l, Ltd., 149 F.3d 987, 997 (9th Cir. 1998) (same), *cert. denied*, 525 U.S. 1141 (1999); L.A. News Serv. v. KCAL-TV Channel 9, 108 F.3d 1119, 1123 (9th Cir. 1997) [hereinafter *KCAL-TV*] (same); L.A. News Serv. v. Conus Commc'ns Co. L.P., 969 F. Supp. 579 (C.D. Cal. 1997) (same).

312. *LANS*, 305 F.3d at 929.

313. *KCAL-TV*, 108 F.3d at 1119.

314. In passing, the court noted the defendant's argument that "First Amendment considerations reinforce the conclusion that KCAL's use was fair," but then it failed to present any discussion or analysis of that argument. *Id.* at 1121.

315. *See id.* at 1123 ("KCAL's use of LANS's copyrighted tape was arguably in the public interest because it was a percipient recording of a newsworthy event.").

316. In a later case, the Ninth Circuit acknowledged the communicative impact of visual representation:

> In this age of television news, it is frequently the image accompanying the story that leaves an event seared into the viewership's collective memory. The riots that shook Los Angeles in April 1992 are bookended by two such images: the footage of police officers beating motorist Rodney King, which led to the trial and verdict that sparked the rioting, and the footage of rioters beating truck driver Reginald Denny . . . .

LANS, 305 F.3d at 929.

And, the plaintiff's refusal of the defendant's request for a license to use the tape[317] meant that, absent not showing it at all, the defendant had no reasonable alternative.[318]

Examples of other situations where the use of photographs or video recordings of events are essential to discussions of those events, and where verbal descriptions or altered versions would not be sufficient to permit comparably robust discussions, might include the photographs of the My Lai Massacre,[319] the torturing of detainees at the Abu Ghraib Prison,[320] the video recordings of the police beating of Rodney King[321] or other newsworthy events.[322] In these cases, one element of the public discussion

317. *KCAL-TV*, 108 F.3d 1119, 1122 (9th Cir. 1997).

318. The fair use defense was considered in two of the other cases brought by LANS against other defendants for other instances of copyright infringement; however, neither opinion even mentioned the First Amendment. *See* L.A. News Serv. v. Reuters Television Int'l, Ltd., 149 F.3d 987, 992–95 (9th Cir. 1998) (finding the fair use defense unavailable in action involving copying of LANS's videotapes and transmissions to foreign news agencies), *cert. denied*, 525 U.S. 1141 (1999); *LANS*, 305 F.3d 924, 938–42 (9th Cir. 2002) (holding that the fair use defense could be successfully invoked by one defendant which had used only a brief snippet of the videotape while operating in a significantly different market than the plaintiff).

319. *See supra* note 299 and accompanying text (noting that even Professor Nimmer recognized this example as one in which First Amendment interests should trump).

320. *Cf.* Four Navy Seals v. Associated Press, 413 F. Supp. 2d 1136, 1148 (S.D. Cal. 2005) (declining to rule on the defendants' fair use defense in an action for copyright infringement pertaining to the unauthorized distribution of photographs of Navy SEALs allegedly torturing Iraqi captives, stating that "that issue is inappropriate for determination in a [Rule] 12(b)(6) motion").

321. *See generally* Elizabeth F. Loftus & Laura A. Rosenwald, *The Rodney King Videotape: Why the Case Was Not Black and White*, 66 S. CAL. L. REV. 1637 (1993) (describing the probative value of videotapes of King's beating).

322. *See* L.A. News Serv. v. Tullo, 973 F.2d 791, 795–99 (9th Cir. 1992) (rejecting the First Amendment and fair use defenses to the unauthorized copying and distribution of videotapes of an airplane crash and train wreck); *supra* note 287 and accompanying text (providing a detailed discussion of the *Tullo* case); *see also* Jackson v. MPI Video, 694 F. Supp. 483, 489–90 (N.D. Ill. 1988) (granting Jackson's motion for a preliminary injunction while rejecting the defendant's fair use and First Amendment arguments); Pacific & S. Co. v. Duncan, 572 F. Supp. 1186, 1192–93 (N.D. Ga. 1983) (rejecting the First Amendment defense for a news "clipping service," which sold copies of plaintiff-station's news broadcasts saying that the material in question, while "informational," was "soft news" lacking significant public interest). In *Jackson*, the defendant distributed a videotape of the publicly televised speech delivered by Jesse Jackson at the 1988 Democratic National Convention (DNC). *Jackson*, 694 F. Supp. at 485. The district court granted Jackson's motion for a preliminary injunction, rejecting the defendant's fair use and First Amendment arguments, based in part on the possibility that Jackson might have wanted to distribute, and make money from, the tapes of his speech. *Id.* at 489–91. That aside, the court's conclusion flies in the face of several of its own findings—that the DNC "considers its conventions to be public events of political and historical significance," that Jackson himself "testified that

may be whether certain incidents occurred and, if so, various specific details of the event. Here, where use of the actual photographs or videotapes may be necessary to substantiate the speaker's claims, the second element of my proposed test—a compelling need to use the protected expression—is likely to be satisfied.[323]

The unauthorized creation and distribution of certain parodies, satires[324] or other transformative works would constitute the second set of situations in which free speech interests on occasion should prevail over potential objections from the copyright owner. The *Dr. Seuss* case[325] exemplifies a situation in which, regardless of the fair use analysis, application of First Amendment values as suggested in this Article would have called for a different result than the court's analysis, which was limited solely to the internal mechanisms of the copyright regime.

The defendants created *The Cat NOT in the Hat!*, which was a rhyming summary of the O.J. Simpson murder trial, as a parody of the famous *The Cat in the Hat* story. The Ninth Circuit rejected the defendants' fair use defense and upheld the district court's grant of an injunction against the defendants' publication and distribution of their work.[326] The court's dismissive rejection of the defendants' "claim that the

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the 'essence' of his speech was 'news' occurring at an 'historical event,'" and that "[h]e desired the speech to receive the widest possible audience." *Id.* at 487.

323. These situations might also be addressed by another of the internal mechanisms to the copyright laws: that the expression and the idea have merged. *See supra* Part III.B.2.b (discussing the role played by the fair use doctrine in the protection of First Amendment rights).

324. The Court in *Campbell* drew a distinction between parodies and satires in determining the availability of the fair use defense, giving considerably less deference to satires. *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 580–81 (1994) ("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, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing."). Regardless of the merits of that distinction for evaluating the scope of copyright, I believe that it should be irrelevant for First Amendment analysis. *See also infra* note 326 and accompanying text (providing further discussion of the distinction between parody and satire).

325. *See* Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1406 (9th Cir. 1997) (affirming the "preliminary injunction prohibiting the publication and distribution of the infringing work").

326. In its discussion of the first fair use factor—"the purpose and character of the [defendants'] use"—the Ninth Circuit acknowledged that "[p]arody is regarded as a form of social and literary criticism, having a socially significant value as free speech under the First Amendment." *Id.* at 1400. However, because it concluded that the defendants' work was a satire rather than a parody, and that "there is no effort to create a transformative work with 'new expression, meaning, or message,'" the court held that this first factor tipped against fair use. *Id.* at 1400–01 (quoting *Campbell*, 510 U.S. at 578).

injunction in this case constitutes a prior restraint in violation of free speech guarantee[s]" was tucked away in a footnote and, more importantly, was limited to a response to the plaintiff's *trademark* and *unfair competition* claims.[327]

First Amendment values, however, required considerably more respect for the public interest which would have been advanced by permitting the distribution of the defendants' work. The O.J. Simpson trial was one of the closest watched in our nation's history, and the verdict of acquittal was highly controversial, raising among other issues, matters of racial and economic equality and justice.[328] While it is true that the defendants' commentary could have drawn on completely original sources,[329] it is likely that their views would be communicated more effectively by use of Dr. Seuss's well-known characters and verse patterns.[330] Denying the defendants the right to create and distribute this satire resulted in the

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327. *Dr. Seuss*, 109 F.3d at 1403 n.11. The district court's discussion of the First Amendment was far more detailed but, as with the court of appeals, its opinion was almost exclusively directed to its use as a defense to the plaintiff's Lanham Act claims. *See* Dr. Seuss Enters., L.P., v. Penguin Books USA, Inc., 924 F. Supp. 1559, 1571–73 (S.D. Cal. 1996) ("Just as in copyright, trademark infringement will be excused only where necessary to the purpose of the use. Where alternative means of achieving the satiric or parodic ends exist that would not entail consumer confusion, the First Amendment will not protect the parodist from being held to infringe." (footnotes omitted)); *see also* Browne v. McCain, 612 F. Supp. 2d 1125, 1130–33 (C.D. Cal. 2009) (refusing to dismiss, on the basis of the fair use defense, a musician-composer's copyright infringement action against a presidential candidate for the unauthorized use of his song in a political commercial, finding that the plaintiff was entitled to further pre-trial discovery). The court considered the First Amendment defense only in connection with the plaintiff's Lanham Act claim. *Id.*

328. *See* POSTMORTEM: THE O.J. SIMPSON CASE 6, 26 (Jeffrey Abramson ed., 1996) (noting that "public opinion about Simpson's guilt almost immediately split along racial lines" and that an "estimated 150 million Americans watched the reading of the jury verdicts, surpassing all previous television records").

329. The district court suggested another alternative—"freely plunder[ing] the myriad familiar works already in the public domain." *Dr. Seuss*, 924 F. Supp. at 1568. *But see supra* note 155 (noting a preference for the right to use more recently created works).

330. *Cf.* Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 796, 806 (9th Cir. 2003). In *Mattel*, the defendant had "produce[d] photographs with social and political overtones . . . , in which he depicted [Mattel's] Barbie in various absurd and often sexualized positions." *Id.* at 796 (footnote omitted). Here, distinguishing *Dr. Seuss*, the Ninth Circuit found that the photographs were protected by the fair use doctrine. *Id.* at 806. It rejected Mattel's argument that the defendant's "work is not parody because he could have made his statements about consumerism, gender roles, and sexuality without using Barbie." *Id.* at 802 n.7. The court emphasized that, "[a]cceptance of this argument would severely and unacceptably limit the definition of parody." *Id.* Although the court's analysis did not require reliance on constitutional protection, it invoked First Amendment interests to support its conclusion. *Id.* at 803; *see also supra* note 223 and accompanying text (discussing the court's consideration of First Amendment interests).

elimination of one component of the public discourse on this important topic.[331]

Suntrust is another illustrative case for the supremacy of First Amendment values.[332] The plaintiff owned the copyright in *Gone with the Wind* (*GWTW*), the well-known novel by Margaret Mitchell.[333] Alice Randall had written a different novel—entitled *The Wind Done Gone* (*TWDG*)—which used many of the characters, scenes and events from *GWTW*. However, instead of the nostalgia for the ante-bellum and post-Civil War South reflected in *GWTW*, Randall's novel was in the form of a diary of a former slave, and was critical of, and cynical about, Mitchell's

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331. Admittedly cutting against invocation of a First Amendment right is that the defendants' use might not have satisfied the third factor in my test. The defendants had not sought permission to use the copyrighted materials from the plaintiff, although it had licensed the Dr. Seuss marks to other persons "for use on clothing, in interactive software, and in a theme park." Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1396 (9th Cir. 1997).

Perhaps an even stronger instance in which the court failed to give appropriate regard to First Amendment considerations arose in another Ninth Circuit decision. *See* Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 758 (9th Cir. 1978) (rejecting defendant's fair use defense concerning the use of Disney characters in comic books "[b]ecause the amount of defendant's copying exceeded permissible levels"), *cert. denied*, 439 U.S. 1132 (1979). In *Air Pirates*, the defendants had created adult "counter-culture" comic books, in which "defendants supposedly sought to convey an allegorical message," and attacked Disney's "'image of innocent delightfulness,'" by placing "several well-known Disney cartoon characters in incongruous settings," including engaging in promiscuity or the use of drugs. *Id.* at 753. In a decision applying the standards of the 1909 Act rather than the four factors in § 107 of the 1976 Act, the court of appeals rejected the defendants' proffered fair use defense. *Id.* at 758. The defendants' reliance on First Amendment protection was dismissed in a single paragraph. The court stated that the "defendants' claim can be dismissed without a lengthy discussion that it otherwise might merit," in light of an earlier decision which had found "that 'the idea-expression line represents an acceptable definitional balance as between copyright and free speech interests,'" and "[b]ecause the defendants here could have expressed their theme without copying Disney's protected expression . . . ." *Id.* at 758–59 (quoting Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1170 (9th Cir. 1977)).

The court was wrong. The defendants' parallel themes—ridiculing the wholesome world of such Disney characters as Snow White and Mickey Mouse, and offering support for a dramatically different cultural view—could not have been conveyed without some actual portrayal of the Disney characters. There was, and still is, significant public value in debating these competing cultural themes. This was undoubtedly a situation in which the plaintiff would not have licensed the defendants to make the contested use of their copyrighted materials.

332. Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1276 (11th Cir. 2001).

333. The court noted that "*GWTW* has become one of the best-selling books in the world, second in sales only to the Bible," *id.* at 1259, and that it "is one of the most famous, popular, and enduring American novels ever written," *id.* at 1271–72.

oeuvre.[334] The Eleventh Circuit reversed the district court's grant of a preliminary injunction against publication of *TWDG*,[335] concluding that the plaintiff had not met its burden of showing that Randall's work would not have been shielded by the fair use doctrine. In the course of its opinion, the court of appeals made several references to the values reflected by the First Amendment,[336] but found it unnecessary to decide its applicability here.[337] I would argue that regardless of the resolution of the statutory defense, this case is another instance in which First Amendment interests should have allowed the creation of a parody, notwithstanding the objections of the owners of copyright in the original work.

Both the topics of slavery and race relations, and the literary and social dimensions of a work like *Gone with the Wind*,[338] are matters of significant public interest. Comment and criticism of that work would be made immeasurably more difficult, and less valuable to the public, if critics were barred from using Mitchell's language and characters.[339] As noted above,[340] there was no possibility for Randall to have obtained permission for her parody from the copyright owners. Thus, to have denied Randall the right to this form of commentary would have been to censor not only a form of expression, but to censor her underlying ideas.

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334. *See id.* at 1270 ("[*TWDG*] is principally and purposefully a critical statement that seeks to rebut and destroy the perspective, judgments, and mythology of *GWTW*.").

335. Suntrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357, 1386 (N.D. Ga. 2001).

336. *See, e.g.*, *Suntrust Bank*, 268 F.3d. at 1263 (asserting that "the First Amendment was enacted to prevent public censorship" (footnote omitted)); *id.* at 1264 (noting "the First Amendment's underlying goal of encouraging open debate and the free exchange of ideas"); *id.* at 1276 (stressing "that the public interest is always served in promoting First Amendment values and in preserving the public domain from encroachment").

337. The district court had explicitly rejected the defendant's First Amendment arguments. *See Suntrust Bank*, 136 F. Supp. 2d at 1384–85 ("With respect to copyright protection, however, the First Amendment does not license an infringing author to trample on legally recognized rights."). The court of appeals asserted that in light of the idea-expression dichotomy and the availability of the fair use defense, there was less need for it to give consideration to the First Amendment arguments. *See Suntrust Bank*, 268 F.3d at 1263.

338. *See supra* note 333 and accompanying text (noting the enormous popularity of *GWTW*).

339. *See* Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1269 (11th Cir. 2001) (noting Randall's contention that "a work of fiction . . . is a more powerful vehicle for her message than a scholarly article"); *id.* at 1271 ("It is hard to imagine how Randall could have specifically criticized *GWTW* without depending heavily upon copyrighted elements of that book.").

340. *See supra* note 290 and accompanying text (discussing the various restrictions placed on the creation of derivative works by Margaret Mitchell's estate).

Although closer questions are presented by a more recent parody-sequel case,[341] there too I would have found that First Amendment interests trumped the author's copyright claims, irrespective of any fair use analysis. The defendant had written a work based on J.D. Salinger's famous novel *Catcher in the Rye*, using the premise of a character, Mr. C, who was sixty years older than Holden Caulfield, and then offering the reflections of the seventy-six year old Mr. C on his life. The district court rejected the defendant's attempted reliance on the fair use doctrine, making only passing reference to the First Amendment.[342]

It is true that the right conferred on an author by the Copyright Act to create a derivative work is an important part of the incentive-reward structure of the statute, and that that right is particularly valuable if the work achieves, as *Catcher in the Rye* has, popularity or notoriety. However, as with *Gone with the Wind*, there was a strong public interest in allowing a sequel to this very famous work. That interest was particularly strong here because of the high probability that Salinger would neither have created nor have authorized such a work. The use of the format of a sequel based on this iconic literary character allowed unique insights, which might not have been achieved as effectively through more traditional forms of commentary or criticism. Also, the opportunity to read this sequel, and to compare it to the original, benefitted the public by adding to literary resources and promoting discourse.

Reemphasis of the economic rationale for copyright—to incentivize the creation of creative works—is in fact further support for the proposition that parodies and satires deserve enhanced First Amendment protection. One factor in the fair use analysis is the effect of the later use on the economic value of the underlying work.[343] Because copyright owners would almost never license others to create a new work which criticizes or

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341. *See* Salinger v. Colting, 641 F. Supp. 2d 250, 268 (S.D.N.Y. 2009) (rejecting the defendant's fair use defense and noting the lack of legitimate parodic content), *vacated on other grounds*, 607 F.3d 68 (2d Cir. 2010).

342. Although the court weighed all four factors of 17 U.S.C. § 107, in particular it found under § 107(1) that the defendant's work was "non-transformative," because it was insufficiently "parodic" either of *Catcher in the Rye* or of Salinger. *See id.* at 261–63 (describing the limited extent of any arguably transformative elements within the defendant's work *60 Days*). Here, contrasting the analysis in *Suntrust*, the court found "no reasonably discernable rejoinder or specific criticism of any character or theme of *Catcher*." *Id.* at 258 (footnote omitted).

343. *See* 17 U.S.C. § 107(4) (2006) (setting forth the fourth factor in the fair use test as "the effect of the use upon the potential market for or value of the copyrighted work"); *see also supra* notes 147–48 and accompanying text (providing further analysis of the fourth consideration in the fair use test).

pokes fun at their works, the only harm to their works is the loss of reputation, and potential sales, because the public's estimation of them has diminished. It is clear that there is no copyright infringement based on criticism which does not use the protected expression. Similarly, I would assert that First Amendment values should trump whatever limited copyright interests exist in being free of that loss of reputation if the effectiveness of that criticism depends on actual use of the expressive components of the works.[344]

The final two instances in which the First Amendment certainly should call for broader access than afforded by the internal mechanisms both involve circumstances when the copyright owner wants no distribution of his or her work. One of these situations is works which the copyright owner simply does not want reproduced or distributed, by himself or anyone else, such as *unpublished* works, but where there is a strong public interest in access to those materials. The other would involve works which at one time were published and distributed, but which are now out-of-print and where the copyright owner has no desire to publish additional copies.

With regards to unpublished works, for the overwhelmingly majority of copyrighted materials, the interest of the public and of the copyright owner will coincide, as she exercises her right to exploit the work and seeks to maximize its commercial return. As a result, the work will be available to the public, albeit under the copyright owner's control and subject to restrictions and payments. When she uses copyright to protect her privacy interests by simply prohibiting access to and use of the work by others,[345] however, the public interest in broad access and dissemination is negated.

The approach I suggest is consistent not only with First Amendment values, but also with those of the copyright regime. It can hardly "promote the Progress of Science" to have creative works kept totally under wraps.[346]

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344. Indeed, critical commentary is still protectable, even if it is harmful to the commercial value of the work or to the author's reputation. *See, e.g.*, Consumers Union of U.S., Inc. v. Gen. Signal Corp., 724 F.2d 1044, 1051 (2d Cir. 1983) ("A court would not find it relevant in deciding the fair use question, however, that evidence might show that the devastating critique had diminished sales by convincing the public that the original work was of poor quality.").

345. As noted above, protection of privacy interests should be the exclusive province of state law, and is not a legitimate goal of the federal copyright regime. *See supra* notes 34–42 and accompanying text (discussing the function of common law copyright with respect to the protection of privacy interests).

346. Indeed, it might be argued—perhaps in another article—that the Copyright Clause cannot authorize protection of works which will be kept secret, and thus which cannot meet that preambular objective. *But see* Chicago Bd. of Ed. v. Substance, Inc., 354 F.3d 624, 627 (7th Cir. 2003) ("It may seem paradoxical to allow copyright to be obtained in secret

I certainly do not assert that the First Amendment permits copying or distribution of every private letter, diary, or the like. However, in the limited category of situations in which the copyright owner forbids the dissemination of materials about which there is a strong public interest, we should applaud, or at least condone, its dissemination by others.[347]

A prime example of a situation in which the First Amendment should have prevailed was J.D. Salinger's successful copyright infringement challenge to an unauthorized biography.[348] Ian Hamilton, described by the court of appeals as "a well-respected writer on literary topics,"[349] initially sought Salinger's cooperation for access to and permission to quote from Salinger's unpublished writings in preparing the biography.[350] After that was denied, Hamilton turned in part to private letters written by Salinger and donated by their recipients to several university libraries. In the biography, Hamilton quoted from some portions of those letters and paraphrased others. The district court had denied Salinger's request for a preliminary injunction against the publication of the biography,[351] but the Second Circuit reversed.[352] In an opinion that made absolutely no mention of First Amendment concerns, the court of appeals concluded that Hamilton

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documents, but it is not. . . . [F]ederal copyright is now available for unpublished works that the author intends never to see the light of day." (citations omitted)).

347. The argument that the First Amendment should on occasion override federally afforded copyright interests with respect to *unpublished* materials has only had vitality since 1978. Under the regime prevailing under the Copyright Act of 1909 and earlier statutes, so-called state "common law copyright" protected unpublished works, and federal protection arose only after publication. *See* Bauer, *supra* note 40, at 6–7 (delineating the various copyright protections under state and federal law prior to the enactment of the Copyright Act of 1976). Thus, pre-1976 analysis would have focused solely on a clash with published works. *See supra* notes 39–40 & 262 and accompanying text (discussing the preemption provision of the Copyright Act of 1976).

348. *See* Salinger v. Random House, Inc., 811 F.2d 90, 100 (2d Cir.) (concluding that Salinger was entitled to a preliminary injunction against the publication of an unauthorized biography), *cert. denied*, 484 U.S. 890 (1987).

349. *Id.* at 92.

350. *Id.* at 92–93. Salinger is best known for the novel *Catcher in the Rye*, published in 1951. *See supra* notes 341–42 and accompanying text (describing the popularity of Salinger's *Catcher in the Rye*). As of the time that Hamilton completed the biography, Salinger had not published any literary work in nearly thirty years, and he lived a life as a recluse in rural New Hampshire. *See Salinger*, 811 F.2d. at 92 ("[Salinger] has not published since 1965 and has chosen to shun all publicity and inquiry concerning his private life.").

351. Salinger v. Random House, Inc., 650 F. Supp. 413, 428 (S.D.N.Y. 1986).

352. *Salinger*, 811 F.2d at 100.

was not entitled to rely on the fair use doctrine for his attempted use of Salinger's letters.[353]

The court's judgment is problematic on two counts. First, its balancing of the four fair use factors[354] put far too much weight on the fact that the letters were *un*published.[355] Second, the court gave far too little weight to the social and literary value in the public's having access to Salinger's words and thoughts, and the imperative facing an author who wanted to convey Salinger's expression, rather than a cold narrative of the facts contained in those letters. These unaddressed concerns are the elements which I have suggested above should be a part of a First Amendment balancing.[356] Because Salinger is someone whose works have reached iconic status in twentieth-century American literature,[357] information about him, as would be uniquely reflected in his other writings,

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353. *See id.* ("[F]air use . . . is not available with respect to the current version of Hamilton's proposed biography.").

354. 17 U.S.C. § 107(1)–(4) (2006).

355. The court initially noted that "[c]entral to this appeal is the application of the defense of 'fair use' to unpublished works." Salinger v. Random House, Inc., 811 F.2d 90, 95 (2d Cir. 1987). Asserting that "we place special emphasis on the unpublished nature of Salinger's letters," *id.* at 96, the court read the Supreme Court's decision in *Harper & Row* for the proposition that unpublished works "normally enjoy complete protection against copying any protected expression." *Id.* at 97; *see also supra* notes 134–53 and accompanying text (providing further discussion and criticism of the Supreme Court's opinion in *Harper & Row*). The Second Circuit concluded that while the §107(1) factor tipped towards the defendants, the other three factors—and particularly § 107(2), because the plaintiff's work was unpublished—all tipped towards the plaintiff. *Id.* at 97–99. *But see infra* note 372 (discussing the legislative overrule of *Salinger*).

356. The district court had recognized the importance of using Salinger's expression. *See Salinger*, 650 F. Supp. at 424 ("To the extent [a biographer] departs from the words of the letters, he distorts, sacrificing both accuracy and vividness of description.").

The court of appeals was unpersuaded. *See Salinger*, 811 F.2d at 96 ("[T]he biographer has no inherent right to copy the 'accuracy' or the 'vividness' of the letter writer's expression. Indeed, 'vividness of description' is precisely an attribute of the author's expression that he is entitled to protect.").

The biographer's difficulty and the public's loss were compounded by the fact that the court also found infringement arising from some of the paraphrased text, concluding that it was sufficiently similar to Salinger's original language. *See id.* at 98 ("[I]n all of the instances where that minimum threshold [of creativity] is met, the Hamilton paraphrasing tracks the original so closely as to constitute infringement."). Thus, even this attempt to avoid use of Salinger's expression proved unavailing. The resulting uncertainty about how far one must go to avoid infringement is yet another example of the chilling effect on would-be later users.

357. *See* New Era Publ'ns. Int'l v. Henry Holt & Co., 873 F.2d 576, 583 (2d Cir. 1989) (describing Salinger as a "literary lion").

is of significant public interest and value.[358] Because Salinger refused to allow public access to those works, there was no reasonable alternative available, other than Hamilton's relatively modest quotations and paraphrasing of the letters, to convey their substance to the public.

Two years later, the Second Circuit again shortchanged the First Amendment interest in permitting unauthorized copying of works of significant public concern, in another case involving a critical biography of another figure of great notoriety and importance, this one examining the life and writings of L. Ron Hubbard, the founder of the Church of Scientology.[359] Russell Miller, the author of the biography, incorporated in his work frequent quotations both from Hubbard's unpublished writings[360] and from his published books, pamphlets and bulletins issued to Church members. The district court[361] concluded that the majority of Miller's quotations were either noninfringing or were covered by the fair use doctrine.[362] Importantly, in reaching the latter conclusion, the court emphasized that Miller needed to use Hubbard's words, because summaries or paraphrasing would be inadequate to convey Hubbard's character and behavior.[363]

However, because a number of Miller's uses of Hubbard's words were infringing,[364] the district court held that Miller and Holt, the publisher of the

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358. The court asserted that denying "a biographer like Hamilton the opportunity to copy the expressive content of unpublished letters is not . . . to interfere in any significant way with the process of enhancing public knowledge of history or contemporary events." *Salinger*, 811 F.2d at 100. The court believed that the public interest was adequately satisfied by Hamilton's ability to report facts, and it seemed undisturbed by the fact that "[p]ublic awareness of the expressive content of the letters will have to await either Salinger's decision to publish them"—which evidence suggested would never occur—or "until the expiration of his copyright," seventy years after his death in 2010. *Id.* I suspect that many of the millions of fans of Salinger's works, whether casual readers or serious scholars, will not be comforted by the thought that they will enter the public domain in 2080.

359. *New Era*, 873 F.2d at 576–77.

360. *See id.* at 578–79 (noting that Miller borrowed mostly excerpts from Hubbard's diaries in addition to quoting from his letters and other unpublished documents).

361. New Era Publ'ns. Int'l v. Henry Holt & Co., 695 F. Supp. 1493, 1528 (S.D.N.Y. 1988) (concluding that the "interests of free speech overwhelmingly exceed the plaintiff's interest in an injunction").

362. *See New Era*, 873 F.2d at 587 n.2 (Oakes, C.J., concurring) (detailing the findings of the district court: Only three of the sixty-nine uses of published materials were infringing and uncovered by the fair use doctrine while forty-one of 132 uses of unpublished materials were unlawful).

363. *See New Era*, 695 F. Supp. at 1524 ("Hubbard's expression is taken primarily to show character flaws in a manner that cannot be accomplished without use of his words.").

364. *See* New Era Publ'ns. Int'l v. Henry Holt & Co., 873 F.2d 576, 587 n.2 (2d Cir.

biography, which was the sole named defendant, had engaged in copyright infringement. After expressly considering First Amendment interests, however, the district court concluded that the strong public interest in access to Hubbard's words, so as to enable readers of the biography to make a more accurate assessment of competing claims about his life and his beliefs,[365] militated against granting an injunction forbidding its publication,[366] and instead the court limited the plaintiff to monetary relief.[367]

1989) (Oakes, C.J., concurring) (noting that the district court found a total of forty-four infringing uses, mostly derived from *un*published materials, with a total of thirty-seven infringing uses from Hubbard's diaries).

365. In approving a more expansive application of the fair use doctrine, the district court properly noted that allowing a public figure like Hubbard to use the copyright laws to prevent dissemination of negative information would cause serious harm to free speech interests. It said:

> [T]o make this right [of first publication] inevitably prevail over all competing considerations would lead to absurd results that are almost incompatible with First Amendment interests. By registering a copyright, public figures who are the expected focus of public interest could use this supposed commercial protection as an aggressive weapon to prevent the publication of embarrassing revelations and to obstruct criticism.

New Era, 655 F. Supp. at 1502.

366. Unlike the typical infringement action, where the defendant's conduct affects the plaintiff's ability to exploit his work and arguably reduces the incentive to create new works, here the plaintiff's principal concern was to deprive the public of access to critical and unflattering information about Hubbard which could be conveyed only by use of Hubbard's expressions. The court stated:

> Hubbard's writing is quoted to substantiate the argument of a laboriously researched, well-constructed biography representing, right or wrong in its views, a valuable commentary on a subject of public importance. . . . Surely the suppression of such a work implicates concerns of the First Amendment. . . . If . . . the copyright owner can be reasonably compensated in damages for injury to this commercial interest, and the injury to the public interest in free speech resulting from injunction would be great, that is a powerful reason for limiting the remedy to damages and withholding the injunctive relief.

Id. at 1525–26.

367. *Id.* at 1527–28. This decision suggests another, albeit partial, means of accommodating First Amendment interests: a strong presumption against issuance of an injunction, and limiting the copyright owner to an action for damages. Although the Copyright Act expressly authorizes the grant of an injunction, 17 U.S.C. § 502 (2006), such relief, particularly when granted even before the allegedly offending work has been distributed, runs afoul of a core First Amendment doctrine: forbidding injunctions which constitute a prior restraint against certain speech. *See* Neb. Press Ass'n v. Stuart, 427 U.S. 539, 559 (1976) ("[P]rior restraints on speech and publication are the most serious and the least tolerable infringement on First Amendment rights.").

This judicial option of only granting monetary relief also addresses some of the concerns raised by my third factor for deciding whether free speech interests should trump

The Second Circuit affirmed on other grounds, finding that the claim was barred by laches.[368] However, it also included extensive and unnecessary dictum,[369] rejecting the district court's fair use and First Amendment analysis.[370] As to the former, the court relied in large part on the close-to-irrebuttable presumption, stated in *Salinger*,[371] of an absence of

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copyright claims—whether the second user has a reasonable alternative to the unauthorized use of the work—and it has some of the earmarks of creating a compulsory license for use of certain works. There is ample authority for withholding injunctive relief in appropriate situations. *See, e.g.*, eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388, 391 (2006) (concluding that the traditional four-factor test for granting injunctive relief applies to patent infringement actions and that the trial court's decision to grant or deny injunctive relief is an act of equitable discretion, reviewable on appeal for abuse of discretion); Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 578 n.10 (1994) (suggesting that "[b]ecause the fair use enquiry [sic] often requires close questions of judgment as to the extent of permissible borrowing," the "goals of copyright law . . . are not always best served by automatically granting injunctive relief" (citations omitted)); Salinger v. Colting, 607 F.3d 68, 82 (2d Cir. 2010) (finding that the *eBay* standard for grant of injunctive relief also applied to copyright claims, and applied equally to preliminary and permanent injunctive relief, and noting that "[e]very injunction issued before a final adjudication on the merits risks enjoining speech protected by the First Amendment"); New Era Publ'ns. Int'l v. Henry Holt & Co., 873 F.2d 576, 595–97 (2d Cir. 1989) (Oakes, C.J., concurring) (citing cases supporting the denial of an injunction when public and First Amendment interests are at stake). *But see* Pac. & S. Co. v. Duncan, 744 F.2d 1490, 1499–1500 (11th Cir. 1984) (concluding that the district court abused its discretion by withholding injunctive relief because of First Amendment considerations, and that a modest furtherance of First Amendment interests from increased public access to a copyrighted work is relevant only to liability issues, not to forms of relief), *cert. denied*, 471 U.S. 1004 (1985). However, given the potential for substantial damages for copyright infringement, this alternative still raises significant chilling effect concerns, and therefore for materials which would meet my proposed test for First Amendment preference, it is only the second best solution.

368. New Era Publ'ns. Int'l v. Henry Holt & Co., 873 F.2d 576, 584 (2d Cir. 1989).

369. It was particularly problematic for the court of appeals to address constitutional issues, when it resolved the case on unrelated equitable considerations. *See supra* note 224 and accompanying text (discussing the practice of avoiding unnecessary constitutional issues); *cf.* Spector Motor Serv., Inc. v. McLaughlin, 323 U.S. 101, 105 (1944) ("If there is one doctrine more deeply rooted than any other in the process of constitutional adjudication, it is that we ought not to pass on questions of constitutionality . . . unless such [questions are] unavoidable."); Ashwander v. Tenn. Valley Auth., 297 U.S. 288, 347 (1936) (Brandeis, J., concurring) (explaining that constitutional questions should not be decided unless "'absolutely necessary to a decision of the case'" (quoting Burton v. United States, 196 U.S. 283, 295 (1905))).

370. In additional dictum, the court of appeals also disagreed with the district court's decision to deny injunctive relief, asserting that "[t]he public would not necessarily be deprived of an 'interesting and valuable historical study,' but only of an infringing one." *New Era*, 873 F.2d at 584 (citations omitted).

371. *See supra* note 355 and accompanying text (discussing the high level of protection for unpublished works).

fair use for unpublished works;[372] the court also disagreed with the district court's weighing of the other three fair use factors. Without belaboring the point, this portion of the court of appeals's opinion again demonstrates the frequent inadequacy of fair use as an internal mechanism to protect First Amendment interests.[373]

The court of appeals's First Amendment analysis, while limited, took two familiar tracts. One was the suggestion that there was no room for First Amendment considerations in the face of claims of copyright infringement[374]—a position rejected by the Supreme Court a few years later

372. *See New Era*, 873 F.2d at 583 ("Where use is made of materials of an 'unpublished nature,' the second fair use factor has yet to be applied in favor of an infringer, and we do not do so here.").

Two years later, the Second Circuit adhered to that position in *Wright v. Warner Books, Inc.*, 953 F.2d 731, 737 (2d Cir. 1991) ("Our precedents, then, leave little room for discussion of this factor [§ 107(2)] once it has been determined that the copyrighted work is unpublished."). Nonetheless, there the court found fair use. *See id.* at 740 ("Three of the four fair use factors clearly favor the defendants. The one that does not—the nature of the copyrighted work—raises an obstacle to this conclusion, but not an insurmountable one.").

The suggestion that unpublished works should almost never receive "fair use" treatment was abrogated legislatively in 1992. *See* Pub. L. No. 102-492, 106 Stat. 3145 (1992) (providing that "[t]he 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.") (codified at 17 U.S.C. § 107). The legislative history expressly criticized the holdings of *Salinger* and *New Era*; while it approved of *Wright*'s nonabsolutist result, it also noted that "concern has been expressed that the *Wright* decision did not disavow certain troublesome language in the *Salinger* opinion." H.R. REP. NO. 102-836, at 5–9 (1992), *reprinted in* 1992 U.S.C.C.A.N. 2553, 2556–61.

373. Interestingly, in a case decided the following year, *New Era Publications International v. Carol Publishing Group*, which involved another unauthorized and unflattering biography of Hubbard, but where this author had only used excerpts from Hubbard's *published* works, the Second Circuit reversed the district court's conclusion that these quotations were outside the scope of the fair use doctrine. *See* New Era Publ'ns Int'l v. Carol Publ'g Group, 904 F.2d 152, 161 (2d Cir.) ("We hold that each of the four factors of § 107 favors appellant, and that the book's use of quotations from Hubbard's published works was protected fair use."), *cert. denied*, 498 U.S. 921 (1990).

374. *See* New Era Publ'ns Int'l v. Henry Holt & Co., 873 F.2d 576, 584 (2nd Cir. 1989) ("We are not persuaded, however, that any first amendment concerns not accommodated by the Copyright Act are implicated in this action.").

in *Eldred*.[375] The other was the suggestion that the fair use and idea-expression doctrines adequately protected First Amendment interests.[376]

In my view, this case and *Salinger* should be seen as easy cases in which First Amendment interests should trump objections to the unauthorized use of the plaintiffs' protected expression.[377] All three of the considerations identified above were present. The subject matter of the speech, and the very expressions used, were matters of significant public interest.[378] The defendants' communications would have been, and in

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375. *See* Eldred v. Ashcroft, 537 U.S. 186, 221 (2003) ("We recognize that the D.C. Circuit spoke too broadly when it declared copyrights 'categorically immune from challenges under the First Amendment.'" (quoting Eldred v. Reno, 239 F.3d 372, 375 (D.C. Cir. 2001))); *see also supra* notes 9 & 237 and accompanying text (discussing other instances where the courts have expressed the view that First Amendment considerations are inapplicable to copyrights).

376. *See New Era*, 873 F.2d at 584 ("Our observation that the fair use doctrine encompasses all claims of First Amendment in the copyright field never has been repudiated . . . . An author's expression of an idea, as distinguished from the idea itself, is not considered subject to the public's 'right to know.'" (citations omitted) (quoting WILLIAM F. PATRY, THE FAIR USE PRIVILEGE IN COPYRIGHT LAW 466 (1985))).

In another Scientology case, *Religious Technology Center v. Netcom On-Line Communication Services*, 923 F. Supp. 1231 (N.D. Cal. 1995), the defendant, Erlich, had posted both published and unpublished Church works on an internet newsgroup which was dedicated to criticisms of the Church. *Id.* at 1239. Erlich had quoted from most of these works—and sometimes in their entirety—without making any edits or changes; rather, they were accompanied by the defendant's minor comments. *Id.* at 1243. The court's detailed examination of the four fair use factors, *id.* at 1242–50, justified its rejection of the fair use defense. However, as is true with most other decisions treating the issue, its rejection of First Amendment concerns was lamentably limited. *See id.* at 1258 ("Because Erlich is able to continue to criticize the Church and use its published and unpublished works to the extent allowed by the doctrine of fair use . . . , Erlich's First Amendment interests have been adequately considered.").

377. See Online Policy v. Diebold, Inc., 337 F. Supp. 2d 1195, 1203 (N.D. Cal. 2004), for another example of an easy case where First Amendment principles should trump. The defendant was the manufacturer of electronic voting machines, which were the subject of substantial critical commentary as to their verification procedures and reliability. *Id.* at 1197. A number of Diebold employees exchanged internal emails, acknowledging problems associated with the machines. *Id.* The plaintiffs obtained access to these machines and posted them on the Internet. *Id.* By invoking provisions of the DMCA and by threatening copyright infringement actions, the defendants were successful in having those emails removed from the Internet. *Id.* at 1198. In an action challenging that behavior, the court found that the plaintiffs' conduct was shielded by the fair use doctrine, noting that the plaintiff's purpose was to "inform[] the public about the problems associated with Diebold's electronic voting machines," and saying "[i]t is hard to imagine a *subject* the discussion of which could be more *in the public interest*." *Id.* at 1203 (emphasis added).

378. *Cf.* Bartnicki v. Vopper, 532 U.S. 514, 533–34 (2001) (noting that "enforcement of [the statutory] provision . . . implicates the core purposes of the First Amendment because it imposes sanctions on the publication of truthful information of public concern. In these

Salinger in fact were, far less effective when the use of the plaintiffs' actual words was foreclosed.[379] The defendants also had no reasonable alternative, such as seeking advance permission, to the unauthorized uses.[380]

Similar First Amendment concerns are implicated in the second situation—previously published works, where the copyright owner no longer wishes public distribution of the work. Interestingly, several of these disputes have arisen over religious publications. For example, in the *Worldwide Church of God* case,[381] the predecessor of the plaintiff, a religious organization, had distributed more than one million copies of a book written by Herbert Armstrong, the church's founder.[382] After Armstrong's death, the plaintiff determined that the book was racist and inconsistent with modern social norms, and it decided that it would no longer distribute any more copies of the book; it also destroyed most of the copies in its inventory.[383] A splinter church organization—which continued to adhere to Armstrong's tenets—made and distributed virtually identical copies of the book.[384]

The Third Circuit upheld the plaintiff's copyright infringement claim, rejecting both the fair use and First Amendment defenses.[385] The latter

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cases, privacy concerns give way when balanced against the interest in publishing matters of public importance").

379. *See, e.g.*, New Era Publ'ns Int'l v. Henry Holt & Co., 695 F. Supp. 1493, 1523–24 (S.D.N.Y. 1988) ("These are uses for which the biographer's point cannot be effectively demonstrated without the subject's words—demonstrations of traits of character.").

380. In an earlier case, *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966), the Second Circuit indicated that these first two considerations, public interest in the matter and the necessity of using the original work, were relevant in determining whether a particular unauthorized use fell within the fair use doctrine. *See id.* at 307 ("Whether the privilege may justifiably be applied to particular materials turns initially on the nature of the materials, e.g., whether their distribution would serve the public interest in the free dissemination of information and whether their preparation requires some use of prior materials dealing with the same subject matter."), *cert. denied*, 385 U.S. 1009 (1967); *see also* New Era Publ'ns Int'l v. Henry Holt & Co., 873 F.2d 576, 589 (2d Cir. 1989) (Oakes, C.J., concurring) (placing similar emphasis on the factors of public interest and the necessity of using the original work, saying, "the second use must serve the public interest and must require use of the original work").

381. *See* Worldwide Church of God v. Phila. Church of God, 227 F.3d 1110, 1120 (9th Cir. 2000) (rejecting defendant's fair use defense for its unauthorized reproduction and distribution of a copyrighted work finding that the religious nature of the work did not render the verbatim copying reasonable).

382. *Id.* at 1113.

383. *Id.*

384. *Id.*

385. *Id.* at 1120.

analysis[386] is noteworthy, both for its brevity and its failure to consider the range of concerns I have already identified. Quoting from *Harper & Row*, the court asserted that "[t]he public interest in the free flow of information is assured by the law's refusal to recognize a valid copyright in facts."[387] But, that bald assertion fails again to capture the importance to the defendant, and its adherents, of distributing Armstrong's very words.[388] A recitation of the facts, or a recasting of Armstrong's ideas, was clearly insufficient to fully and accurately convey his views. Because the plaintiff absolutely refused to allow the distribution of the book, the defendant had no reasonable alternative to taking the steps it did. Thus, the First Amendment should have permitted the defendant to make those copies.

Finally, there may be other situations that do not fall into these four categories but which would also satisfy my proposed test for permitting the unauthorized reproduction or distribution of copyrighted materials. One such situation would be the reproduction of model statutes or ordinances, drafted by a private entity or organization, and subsequently enacted into law by a governmental body.[389] Although surely such model statutes would initially be entitled to copyright protection, I would freely allow third parties not only to copy and distribute the ordinance as enacted, but also to take the short-cut route of reproducing the underlying model law. In the only case to have decided the legality of that behavior, *Veeck v. Southern*

386. Calling this portion of the court's opinion an analysis is generous. Instead, it was a melange of citations and quotations from other opinions. *Id.* at 1115–16.

387. *Id.* at 1115 (quoting Harper & Row, Publishers v. Nation Enters., 471 U.S. 539, 558 (1985)).

388. Without making the case even more complicated, there was arguably a different First Amendment concern involved here—under the Free Exercise Clause. *See id.* at 1120–21 (considering and rejecting defendant's defense under the Religious Freedom Restoration Act). It goes without saying that constraints on adherents of any religious denomination or sect which limit their ability to engage in religious practices—whether they arise under the copyright laws or otherwise—raise additional public concerns and interests. *Cf.* Penguin Books U.S.A., Inc. v. New Christian Church of Full Endeavor, Ltd., No. 96 Civ. 4126, 2000 WL 1028634, at *17–19 (S.D.N.Y. July 25, 2000) (rejecting the defendant's fair use defense in an action challenging the copying of religious texts and concluding that enforcement of copyright would not violate the defendants' right under the First Amendment's Free Exercise Clause); Urantia Found. v. Maaherra, 895 F. Supp. 1329, 1332–34 (D. Ariz. 1995) (rejecting the First Amendment argument, premised on religious nature of infringed works, that the Establishment and Freedom of Speech Clauses foreclose copyright protection); Bridge Publ'ns, Inc. v. Vien, 827 F. Supp. 629, 634–35 (S.D. Cal. 1993) (rejecting the First Amendment argument, premised on the religious nature of the infringing and infringed works, that the Free Exercise and Establishment Clauses foreclose copyright protection).

389. Another situation would include proposals to give protection to databases and other collections of facts. *See supra* note 75 and accompanying text (presenting First Amendment objections to such legislation).

Building Code Congress International,[390] the Fifth Circuit relied on two of the traditional internal mechanisms to support a conclusion of noninfringement, finding that the enacted versions of the model laws became unprotectable facts, and that the expression contained in their words had merged with the idea embodied in the ordinances.[391] Although I agree with that result, alternatively I would have found that the First Amendment interests in being able to reproduce and distribute the ordinance itself would have trumped any claim under the copyright laws.[392] Because unfettered access to the text of the law is often crucial to its understanding and implementation, the alternative of requiring others instead to paraphrase or describe it will not be suitable.

c. Instruction from Other Intellectual Property Regimes

While First Amendment defenses arising in the context of *state law* intellectual property claims—and in particular with the alleged infringement of the right of publicity—are beyond the scope of this Article, some of the learning from those cases is instructive. As with copyright, there is no absolute First Amendment right to use a person's name, image or attributes without his or her permission. In the only Supreme Court case to have considered this issue,[393] *Zacchini v. Scripps-Howard Broadcasting*

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390. Veeck v. S. Bldg. Code Cong. Int'l, 293 F.3d 791, 800 (5th Cir. 2002) (finding that Veeck did not violate copyright law when he copied the law of Anna and Savoy, Texas even though those laws incorporated copyrighted model building codes). In *Veeck*, the defendant maintained a noncommercial website with information about north Texas. *Id.* at 793. Two small towns in north Texas had adopted ordinances, using the text of a Standard Building Code written by the plaintiff. *Id.* The defendant purchased a disk containing a copy of the Code from the plaintiff; although that disk had a copyright notice, indicating that the Code could not be copied and distributed, the defendant posted the text of the Code on his website. *Id.*

391. *Id.* at 801–02. Having disposed of the case on these grounds, the court found it unnecessary to consider the fair use defense. *Id.* at 802 n.17.

392. These First Amendment considerations are particularly important because *Veeck* was an *en banc* decision and was resolved by a vote of 9–6. *Id.* at 793. Although the issue was not addressed by the majority, one of the two dissents asserted, incorrectly in my view, that "SBCCI simply is *not* stifling access to, or speech about, THE law. SBCCI has not violated the First Amendment vis-á-vis Veeck." *Id.* at 821 (Wiener, J., dissenting). Even the majority carved out only limited rights to use those proposed laws, asserting that "the result in this case would have been different if Veeck had published not the building codes of Anna and Savoy, Texas, but the SBCCI model codes, as model codes." *Id.* at 805 (majority opinion).

393. The Court has discussed the clash between other kinds of state law claims and the First Amendment on numerous occasions. *See, e.g.*, Time, Inc. v. Hill, 385 U.S. 374, 388

Co.,[394] the Court concluded that the First Amendment did not foreclose a right of publicity claim for a television station's unauthorized videotaping and broadcasting of the plaintiff's performance as a "human cannonball."[395]

Justice White's opinion for the Court identified the competing interests of the state in allowing the right of publicity claim and the constitutional interest in permitting unrestricted access to the plaintiff's performance. Those state interests are very familiar to students of copyright law[396]—encouraging the investment of time and money by performers to stimulate the development of these acts for the benefit of society and providing rewards to performers for those undertakings. These goals are achieved by allowing performers to control access to their performances.[397] By comparison, the First Amendment is designed to encourage broader dissemination to the public of both newsworthy and entertaining material. Here, the Court concluded that this constitutional prerogative was exceeded by the unauthorized dissemination of plaintiff's "entire act."[398]

(1967) (finding that the First Amendment limits the application of a state statute allowing damage awards for false reports concerning matters of public interest unless it is proved that "the defendant published the report with knowledge of its falsity or in reckless disregard of the truth"); N.Y. Times Co. v. Sullivan, 376 U.S. 254, 279–80, 283 (1964) (concluding that a public official cannot recover damages for defamation or libel absent proof that the statement was made with actual knowledge of its falsity or with reckless disregard of its truth or falsity). Other than their general learning about the scope of the First Amendment, these cases are also beyond the scope of this Article.

394. Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 577 (1977).

395. *See id.* ("The Constitution does not prevent Ohio from making a similar choice here in deciding to protect the entertainer's incentive in order to encourage the production of this type of work."). The defendant videotaped the entirety of defendant's act—which took place at a county fair and which lasted fifteen seconds—without his permission, and then broadcast the act as one part of an evening news report. *Id.* at 563–64.

396. On three separate occasions, the Court's opinion compared the state's interests in protecting the plaintiff's persona and performance to the federal interests in affording copyright protection. *See id.* at 573 ("[T]he State's interest is closely analogous to the goals of patent and copyright law . . . ."); *id.* at 575 ("The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner . . . ." (citations omitted)); *id.* at 576 ("This same consideration [to provide economic incentive to produce a performance] underlies the patent and copyright laws . . . .").

397. *See id.* at 578 ("[N]either the public nor [defendant] will be deprived of the benefit of petitioner's performance as long as his commercial stake in his act is appropriately recognized. Petitioner does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it."). Thus, the majority's focus was on the financial consequences of the unauthorized broadcast.

398. *See id.* at 575 ("[W]e are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent.").

This conclusion is problematic, as demonstrated by Justice Powell's dissenting opinion.[399] In addition to the imprecision of the standard,[400] the Court gave too little attention to the adverse effects of its judgment. The broadcast of the plaintiff's performance during a standard local newscast was typical of the reporting that the First Amendment was designed to protect and encourage.[401] Conversely, the Court's holding that this particular broadcast was unprotected is likely to have a chilling effect on other kinds of reporting, by causing risk-averse media firms to engage in self-censorship—all to the detriment of the viewing and listening public. Thus, as in the copyright cases discussed above, here *Zacchini*'s regrettable diminished concern for First Amendment values reflects the extent to which the attempted balancing of the clash between the two regimes can give inadequate protection for free speech concerns.[402]

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399. *See id.* at 579 (Powell, J., dissenting) (criticizing the majority's emphasis on the respondent's use of the performer's entire act). *Zacchini* was a 5 to 4 decision. Justices Brennan and Marshall joined in Justice Powell's dissent. *Id.* Justice Stevens dissented separately, arguing that it was not clear that the case could not have been decided on independent state law grounds. *Id.* at 582–83 (Stevens, J., dissenting).

400. *See id.* at 579 (Powell, J., dissenting) ("I doubt that this formula [of performer's entire act] provides a standard clear enough even for resolution of this case." (footnote omitted)).

401. *See id.* at 580–81 (asserting that the First Amendment's purpose of encouraging reporting of "newsworthy events" would be undermined by the majority's "entire act" standard). The performance by the "human cannonball" at the Geauga County Fair was likely of significant interest to people in the television station's viewing area. *Id.* at 580. Because a picture is worth a thousand words, a mere verbal description of the performance, absent some footage of the event, would have inadequately informed the viewing public.

402. As noted, *Zacchini* involved a clash between a state-created right of publicity and the First Amendment. However, in a footnote, the Court "note[d] that Federal District Courts have rejected First Amendment challenges to the federal copyright law on the ground that 'no restraint [has been] placed on the use of an idea or concept.'" *Id.* at 577 n.13 (majority opinion) (citations omitted).

This particular observation has been relied on and cited by subsequent courts to support the assertion that the idea-expression dichotomy justifies a more limited scope for a First Amendment defense regarding the copyright regime as well as state law claims. *See, e.g.*, Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 582 (1985) (Brennan, J., dissenting) (noting that the originality requirement for obtaining copyright "also ensures consonance with our most important First Amendment values"); Int'l Olympic Comm. v. San Francisco Arts & Athletics, 781 F.2d 733, 737 (9th Cir. 1986) ("Such property rights [in trademarks] can be protected without violating the First Amendment."); Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 758–59 (9th Cir. 1978) (rejecting a First Amendment challenge, because defendants allegedly could have expressed their theme without copying plaintiff's expression), *cert. denied*, 439 U.S. 1132 (1979); Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 924 F. Supp. 1559, 1575 (S.D. Cal. 1996) ("Copyright law accommodates the concerns of the First Amendment through its exclusion of protection for ideas, and through the fair use doctrine."), *aff'd*, 109 F.3d 1394 (9th Cir.), *cert. denied*, 521 U.S. 1146 (1997).

A number of other courts have reached conclusions similar to *Zacchini*.[403] In particular, when the use of the plaintiff's name, image or persona are undertaken for commercial purposes, courts invoke the well-known principle that First Amendment protection for commercial speech is more limited.[404]

By contrast, however, when the challenged use is for noncommercial, entertainment purposes, and particularly when the use has newsworthy

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In *Jackson v. MPI Home Video*, 694 F. Supp. 483 (N.D. Ill. 1988), the court cited *Zacchini* to support the grant of an injunction against the distribution of a videotape of a speech given at the 1988 Democratic National Convention, because the plaintiff, Reverend Jesse Jackson, "can show he earns part of his living by being paid for his oratory." *Id.* at 489. Even if there might be some justification for restricting First Amendment rights for broadcasts of the entire act of an entertainer such as the "human cannonball," there is far less justification for extending that financial concern to the First Amendment rights of persons reproducing a speech delivered at a political convention.

403. Perhaps the leading example of a failure to recognize, much less accommodate, First Amendment interests is *White v. Samsung Electronics America, Inc.* *See* White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1401 (9th Cir. 1992) (concluding that the defendant's use of Vanna White's persona was not protected speech because it was used for the purpose of making profit). In *White*, the Ninth Circuit upheld a claim based on an advertisement for consumer electronics which included a robot standing next to the Wheel of Fortune set; the court held that this evocation of Vanna White's persona infringed on her right of publicity. *Id.* at 1399. The court's discussion of First Amendment concerns was limited. It stated:

> [E]ven if some forms of expressive activity, such as parody, do rely on identity evocation, the [F]irst [A]mendment hurdle will bar most right of publicity actions against those activities . . . . In the case of commercial advertising, however, the [F]irst [A]mendment hurdle is not so high . . . . Unless the [F]irst [A]mendment bars all right of publicity actions—and it does not, *see Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 97 S.Ct. 2849, 53 L.Ed. 2d 965 (1977)—then it does not bar this case.

Id. at 1401 n.3. Far more persuasive was Judge Kozinski, who, in his dissent from the court's denial of a rehearing en banc, asserted that "not allowing *any* means of reminding people of someone [constituted] a speech restriction unparalleled in First Amendment law." *Id.* at 1519 (Kozinski, J, dissenting) (footnote omitted).

See also Bosley v. WildWetT.com, 310 F. Supp. 2d 914, 926–31 (N.D. Ohio 2004) (rejecting the argument that the defendant's unauthorized sale of a videotape of the plaintiff-news reporter's "wet t-shirt" performance was shielded by First Amendment because the images distributed by the defendant did not contain transformative or creative elements, and its use of those images was solely for commercial exploitation of her fame).

404. *See, e.g.*, Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y., 447 U.S. 557, 562–63 (1980) ("[O]ur decisions have recognized 'the commonsense distinction between speech proposing a commercial transaction, which occurs in an area traditionally subject to government regulation, and other varieties of speech.' The Constitution therefore accords a lesser protection to commercial speech than to other constitutionally guaranteed expression." (footnote and internal quotation marks omitted) (quoting Ohralik v. Ohio State Bar Ass'n, 436 U.S. 447, 455–56 (1978))).

qualities,[405] the importance of protecting First Amendment values becomes more pronounced. Here, just as with the balancing of copyright interests discussed above, and in contrast to the majority view in *Zacchini*, the public interest in allowing such unauthorized use should trump the interests in protecting the plaintiff's state-created, state-protected intellectual property.

A recent case illustrates this preferred balancing. In *C.B.C. Distribution & Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*,[406] C.B.C., the producer of fantasy baseball games, used the names of and information about major league players, without their permission, to create those games.[407] Although the Eighth Circuit concluded that the players properly stated all the elements of a right of publicity claim, it held that C.B.C.'s First Amendment privilege superseded the players' state law rights.[408] The court first identified both the economic and noneconomic interests advanced by a right of publicity.[409] These state interests are evocative of the interests underlying the copyright regime; they included "the right of an individual to reap the rewards of his or her endeavors" and the state's "desire to provide incentives to encourage a person's productive activities."[410] Although the court downplayed the importance of these goals in the case of already highly paid baseball players, its more critical observation was that "state law rights of publicity must be balanced against [F]irst [A]mendment considerations, and here we conclude that the former must give way to the latter."[411] Not only was the information that CBC used already in the public domain; there was a recognized public value in that information, and indeed the public was benefitted by the use that C.B.C. made of it.[412] Thus, the First Amendment properly prevailed, to displace the plaintiff's state law claim.

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405. Although commercial uses properly receive less First Amendment protection, courts should not distinguish among different forms of noncommercial uses. *Supra* notes 403–04 and accompanying text.

406. C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818, 824 (8th Cir. 2007), *cert. denied*, 128 S.Ct. 2872 (2008).

407. *Id.* at 820.

408. *See id.* at 824 ("[W]e hold that CBC's [F]irst [A]mendment rights in offering its fantasy baseball products supersede the players' rights of publicity.").

409. *Id.*

410. *Id.*

411. *Id.* at 823 (citations omitted).

412. ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 938 (6th Cir. 2003) is another decision which properly strikes the balance between the public interests and the private right of publicity. In *ETW Corp.*, the co-defendant Rush, a sports artist, had created a print, including an action portrait, of Tiger Woods's memorable victory at the 1997 Masters

IV. Conclusion

Virtually no one would contend that the First Amendment's command that "Congress shall make *no law* abridging the freedom of speech, or of the press," operates as a total ban on legislation which cabins the rights of speakers or writers.[413] The parallel constitutional provision in Article I, however, authorizing the conferral under the copyright laws of exclusive protection for an author's writings, runs a serious risk of excessive interference with the First Amendment's scope of protection. There are numerous cases in which courts have failed to accord appropriate scope to free speech interests. The more significant problem arises from the chilling effect that those decisions have had on would-be users of copyrighted materials: the speech that has not occurred because of fear of an infringement action.

This Article argues for a new balance, which tips more firmly towards accommodating free speech concerns, while in time also affording somewhat more precision and thereby reducing the uncertainty of whether an unauthorized use of protectable expression will obtain constitutional protection. First Amendment interests should prevail over copyright claims when there is a compelling public interest in allowing that unauthorized use; when the speaker has a compelling need to use the expression itself, such as when paraphrasing, or describing, or summarizing the work is simply inadequate to meet the speaker's needs; and when there are no reasonable alternatives available to obtain actual consent to that use.

Tournament. *Id.* at 918. Multiple copies of these prints were produced and distributed by co-defendant Jireh. *Id.* The court rejected Woods's action for infringement of his right of publicity, concluding that the First Amendment trumped the state law claim:

> Permitting Woods's right of publicity to trump Rush's right of freedom of expression would extinguish Rush's right to profit from his creative enterprise.
>
> After balancing the societal and personal interests embodied in the First Amendment against Woods's property rights, we conclude that the effect of limiting Woods's right of publicity in this case is negligible and significantly outweighed by society's interest in freedom of artistic expression.

Id. at 938; *see also* Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 976 (10th Cir. 1996) (rejecting baseball players' right of publicity claims against the creators of parody trading cards, stating that the "cards . . . are an important form of entertainment and social commentary that deserve First Amendment protection").

413. U.S. CONST. amend. I (emphasis added).