

CARDOZO ARTS & ENTERTAINMENT LAW JOURNAL



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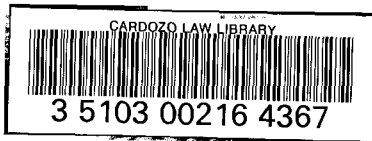
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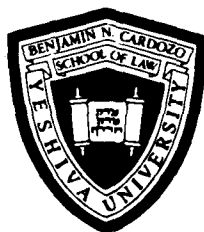
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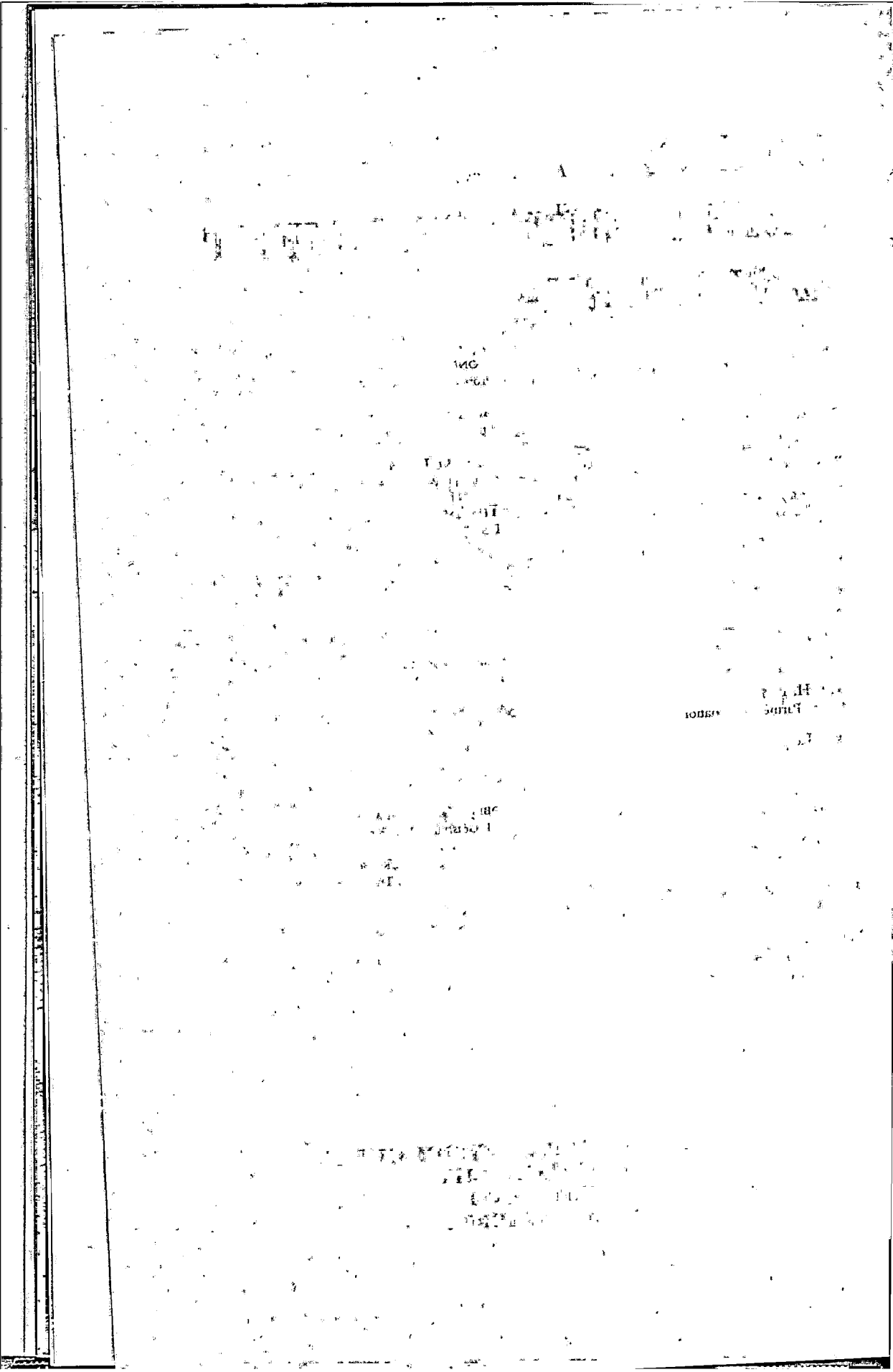
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THE CONFLICT BETWEEN THE FIRST AMENDMENT AND COPYRIGHT LAW AND ITS IMPACT ON THE INTERNET

STEPHEN FRASER*

I. INTRODUCTION

Since the U.S. Supreme Court's decision in *Harper & Row, Publishers, Inc. v. Nation Enterprises*,¹ few courts have upheld the argument that copyright law might be limited by the First Amendment to the U.S. Constitution.² That Amendment states, "Congress shall make no law . . . abridging the freedom of speech, or of the press . . ." ³ Taken on their face, the copyright laws of the United States⁴ place limits on the freedom to use certain speech by granting authors a list of exclusive rights in their copyrighted materials.⁵ However, according to the Supreme Court in *Harper & Row*, "the Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to use one's expression, copyright supplies the economic incentive to create and dis-

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¹ 471 U.S. 539 (1985). In *Harper & Row*, the defendants had attempted to argue what, to the Court, amounted to a public figure exception, *id.* at 557, to excuse their copying portions of President Ford's biography in their magazine, prior to the biography's publication. *Id.* at 542-44, 556. In fact, Paul Goldstein, a renowned copyright scholar and author of one of the first and most influential articles on the issue of copyright and the First Amendment, Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970) (federal copyright law, by and large, accommodates the First Amendment), states in his treatise that in light of *Harper & Row*, "[i]n retrospect it is clear that the perceived conflict between copyright and the first amendment was a tempest in a very small teapot." PAUL GOLDSTEIN, *COPYRIGHT: PRINCIPLE, LAW, AND PRACTICE* § 10.3 (2d ed. 1991). Professor Goldstein probably gave up on the point too soon. Not all conflicts between the First Amendment and copyright could have been resolved or foreseen in *Harper & Row*.

² See *infra* notes 223-26, 244-48 and accompanying text.

³ U.S. CONST. amend. I. The full text of the First Amendment, which includes the Religion Clauses and the right of assembly, is as follows: "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances." *Id.*

⁴ Copyright Act of March 4, 1909, 35 Stat. 1075 (codified as amended at 17 U.S.C. §§ 1-216 (1976)); Copyright Act of 1976, *codified as amended at* 17 U.S.C. §§ 101-1010 (1996). The 1909 Act applies to works created before January 1, 1978, the effective date of the Copyright Act of 1976. See 17 U.S.C. §§ 301-305. Most references in this article will be to the 1976 Act.

⁵ 17 U.S.C. §§ 106, 106A.

seminate ideas."⁶ In holding copyright law consistent with the First Amendment, the Court rejected the attempt by the defendant to raise a First Amendment defense to strict copyright liability for using, in a magazine article, materials taken from former President Ford's then unpublished biography.⁷

A little more than ten years later, a federal district court in California refused to hold a Bulletin Board Service ("BBS") operator or its Internet Service Provider ("ISP") directly liable for the unpublished copyrighted materials posted on their services, and therefore made available on the Internet, by a disgruntled former member of the Church of Scientology.⁸ Like many courts before it, the district court was faced with a situation where First Amendment freedom of speech interests appeared in direct conflict with those granted to copyright owners by copyright law. Instead of accepting the defendants' First Amendment defense, District Judge Whyte opted to limit the application of the Copyright Act to BBSs and ISPs in a manner that was, while protective of speech, inconsistent with the Copyright Act.⁹ The case has since been partially settled,¹⁰ but the implications for free speech and copyright law on the Internet endure. This paper therefore seeks to re-examine the copyright law/First Amendment¹¹ crossroads, reveal its historical sources, and then emphasize the problems that arise with the Internet as exemplified by the *Netcom* case.¹²

⁶ *Harper & Row*, 471 U.S. at 558.

⁷ *Infra* notes 111-12 and accompanying text.

⁸ *Religious Tech. Ctr. v. Netcom On-Line Communications Serv., Inc.*, 907 F. Supp. 1361 (N.D. Cal. 1995); see *infra* Part IV.

⁹ See *infra* Part IV.

¹⁰ See *infra* note 338.

¹¹ There exist dozens of law review articles on the copyright/First Amendment issues that will be raised herein. See Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 *YALE L.J.* 1533 (1993); Diane L. Zimmerman, *Information as Speech, Information as Goods: Some Thoughts on the Marketplaces and the Bill of Rights*, 33 *WM. & MARY L. REV.* 665 (1992); Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept and Feel"*, 38 *EMORY L.J.* 393 (1989); L. Ray Patterson, *Free Speech, Copyright, and Fair Use*, 40 *VAND. L. REV.* 1 (1987); Henry S. Hoberman, *Copyright and the First Amendment: Freedom or Monopoly of Expression?*, 14 *PEPP. L. REV.* 571 (1987); Harry N. Rosenfield, *The American Constitution, Free Inquiry, and the Law, in FAIR USE AND FREE INQUIRY; COPYRIGHT LAW AND THE NEW MEDIA* 288 (John S. Lawrence & Bernard Timberg eds., 1980); Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 *CAL. L. REV.* 283 (1979); Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guaranties of Free Speech and Press?*, 17 *UCLA L. REV.* 1180 (1970). See also *supra* note 1.

¹² Commentary on the impact of the Internet on copyright and/or First Amendment law has been growing. See Jerry Berman & Daniel J. Weitzner, *Abundance and User Control: Renewing the Democratic Heart of the First Amendment in the Age of Interactive Media*, 104 *YALE L.J.* 1619 (1995); Niva Elkin-Koren, *Copyright Law and Social Dialogue on the Information Superhighway: The Case Against Copyright Liability of Bulletin Board Operators*, 13 *CARDOZO ARTS & ENT. L.J.* 345 (1995); Jane C. Ginsburg, *Putting Cars on the "Information Superhighway": Authors, Exploiters, and Copyright in Cyberspace*, 95 *COLUM. L. REV.* 1466 (1995); I. Trotter Hardy,

Cases decided in federal courts have not always portrayed federal copyright law as being flexible to the demands of the First Amendment. Part of the problem has been that authors, their attorneys, and sympathetic courts have sometimes chosen to construe the exclusive rights granted under the Copyright Act as broad property rights akin to real and personal property, in marked contrast to the intended constitutional and congressional grants.¹³ Use of the terms "intellectual property" to describe works that are protected by copyright further the confusion. The U.S. Constitution¹⁴ grants exclusive rights to authors pursuant to Copyright Act legislation¹⁵ passed by Congress. The fact remains that terminology such as "intellectual property" is common, and copyright, though a statutorily created grant, shares some similarities to "property."¹⁶ Instead, federal copyright law is best seen as a form of trade regulation whose rules,¹⁷ like the protections of the First

The Proper Legal Regime for "Cyberspace," 55 U. PITT. L. REV. 993 (1994); Raymond T. Nimmer & Patricia Ann Krauthaus, *Copyright on the Information Superhighway: Requiem for a Middleweight*, 6 STAN. L. & POL'Y REV. 25 (1994); Christopher Wolf & Stephen B. Fabrizio, *Online Providers Can Be Liable for Users' Actions*, NAT'L L.J., Oct. 31, 1994, at C9; David J. Loundy, *E-Law: Legal Issues Affecting Computer Information Systems and Systems Operator Liability*, 3 ALB. L.J. SCI. & TECH. 79 (1993); Henry H. Perritt, Jr., *Tort Liability, the First Amendment, and Equal Access to Electronic Networks*, 5 HARV. J. L. & TECH. 65 (1992).

¹³ See *supra* note 16.

¹⁴ U.S. CONST. art. I, § 8, cl. 8.

¹⁵ 17 U.S.C. §§ 101-1010 (1988 & Supp. IV 1993).

¹⁶ Professor (later Judge) Kaplan had this to say on the subject:

To say that copyright is "property," although a fundamentally unhistorical statement, would not be boldly misdescriptive if one were prepared to acknowledge that there is property and property, with few if any legal consequences extending uniformly to all species and that in practice the lively questions are likely to be whether certain consequences ought to attach to a given piece of so-called property in given circumstances.

BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 72 (1967). See also *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984). "[T]he protection given to copyrights is wholly statutory." *Id.* at 431. "[C]opyright is not based upon any natural right that the author has." *Id.* at 429 n.10. Cf. 17 U.S.C. § 202. Even Congress has fallen into the habit of using the terminology. Telecommunications Act of 1996, Pub. L. No. 104-104, § 509(d)(2), 110 Stat. 56; *infra* note 289.

¹⁷ See, e.g., Patterson, *supra* note 11. Recent examples of the trade regulatory aspects of copyright have been seen in the negotiations of the North American Free Trade Agreement ("NAFTA") and the Trade Related Aspects of Intellectual Property ("TRIPS") in the Uruguay Round of the General Agreement on Tariffs and Trade ("GATT"). As part of NAFTA, the Copyright Act was amended to restore copyright protection in motion pictures that had fallen into the public domain between January 1, 1978 (effective date of the Copyright Act of 1976) and March 1, 1989 (date the Berne Convention became effective in the United States) generally for lack of proper copyright notice. Pub. L. No. 103-182, Title III, § 334(a), 107 Stat. 2115 (codified at 17 U.S.C. § 104A (Supp. 1994)). Those previously believing themselves free to use these public domain works will now be obligated to negotiate licenses for their uses, if not give them up, or risk facing suit for copyright infringement of these "restored" works. 17 U.S.C. § 104A.

In light of the above, and without pushing the analogy too far, the fact that copyright is more akin to trade regulation than property, and as such, not a natural right, the risk of offending the Fifth or Fourteenth Amendments by raising a First Amendment defense to

Amendment, inure to the benefit of the public.

Whatever one's views on copyright, there exists ample case law interpreting the Copyright Act's purposes and the means chosen for achieving those purposes. This Article aims to determine whether copyright's purposes can be reconciled with the First Amendment's prohibition against governmental restrictions on speech, and to examine whether the Internet changes this balance.

By re-examining the relationship of copyright, which places limits on the accessibility of certain speech, and the First Amendment, which was meant to make speech as open and accessible as possible,¹⁸ a properly-balanced reconciliation between the two can be discovered. The concern is not simply that of over- or under-protection of copyrights, but also of over- or under-emphasizing the goals inherent in the First Amendment. By emphasizing free speech concerns, the use of copyright protection can be better utilized to attain not only its goals, but also those of the "marketplace of ideas."

Part I of this Article will review the purposes of and protections provided by the First Amendment to the U.S. Constitution. Part II will review the history and underlying principles of copyright law and analyze the Supreme Court's decision in *Harper & Row* in light of copyright law and First Amendment objectives. Part III will deal with the fair use defense for copyright infringement as well as the few cases that have allowed a First Amendment defense to such infringement. Finally, Part IV will examine the *Netcom* decision, *Reno v. ACLU*,¹⁹ a recent Supreme Court decision, and how the Internet, as one of the most powerful mediums for free speech, is changing the way copyright law and the First Amendment intersect.

II. THE FIRST AMENDMENT

By its very terms the First Amendment protects the freedom of the press,²⁰ freedom of speech,²¹ and, by implication, freedom of

copyright infringement should be minimal. *But cf.* *Roth v. Pritikin*, 710 F.2d 934, 939 (2d Cir. 1983) (patent). For a lament on the uprooting of copyright law by inclusion in international trade agreements, see David Nimmer, *The End of Copyright*, 48 VAND. L. REV. 1385 (1995).

¹⁸ As the *Netcom* court put it, the Internet "may turn out to be the best public forum for free speech yet devised." *Religious Tech. Ctr. v. Netcom On-Line Communications Serv., Inc.*, 907 F. Supp. 1361, 1377-78 (N.D. Cal. 1995); see *infra* Part IV.

¹⁹ 117 S. Ct. 2329 (1997)

²⁰ *Miami Herald Publ'g Co. v. Tornillo*, 418 U.S. 241 (1974); *New York Times Co. v. United States*, 403 U.S. 713 (1971); *Near v. Minnesota*, 283 U.S. 697 (1931).

²¹ *Bose Corp. v. Consumers Union of United States, Inc.*, 466 U.S. 485, 503-04 (1984) ("[T]he freedom to speak one's mind is not only an aspect of individual liberty—and thus

expression.²² The Supreme Court has held that First Amendment freedoms also include the right to remain silent, or not to speak,²³ as well as the right to receive or have access to information.²⁴ It is these last two rights that are most directly affected by copyright law. "[B]y securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries,"²⁵ the U.S. Constitution has granted Congress the power to restrict public access to certain expression Congress has chosen to protect through the Copyright Act and the ideas that protected expression may contain. Writers have tended to focus on the right of access to information when examining copyright law²⁶ and/or the First Amendment.²⁷ However, federal copyright law's purposes can be

good unto itself—but also is essential to the common quest for truth and the vitality of society as a whole.").

²² *Ward v. Rock Against Racism*, 491 U.S. 781 (1989) (music); *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988) (cartoons); *Board of Educ. v. Pico*, 457 U.S. 853 (1982) (literature); *Schad v. Mount Ephraim*, 452 U.S. 61 (1981) (nude dancing); *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578 (1977) ("There is no doubt that entertainment, as well as news, enjoys First Amendment protection."); *Schacht v. United States*, 398 U.S. 58 (1970) (drama); *Freedman v. Maryland*, 380 U.S. 51 (1965) (film); *see generally* *Whitney v. California*, 274 U.S. 357, 375-76 (1927) (Brandeis, J., concurring).

²³ *Wooley v. Maynard*, 430 U.S. 705, 714 (1977) ("[T]he right of freedom of thought protected by the First Amendment against state action includes both the right to speak freely and the right to refrain from speaking at all."); *Board of Educ. v. Barnette*, 319 U.S. 624 (1943). *Id.* at 633-34. ("It is now a commonplace that censorship or suppression of expression of opinion is tolerated by our Constitution only when the expression presents a clear and present danger of action of a kind the State is empowered to prevent and punish. It would seem that involuntary affirmation could be commanded only on even more immediate and urgent grounds than silence.") (Jackson, J.); ("The right of freedom of thought and of religion as guaranteed by the Constitution against State action included both the right to speak freely and the right to refrain from speaking at all."). *Id.* at 645 (Murphy, J., concurring).

²⁴ *Young v. American Mini Theatre*, 427 U.S. 50, 77 (1976) ("[T]he central First Amendment concern remains the need to maintain free access of the public to the expression."); *Procunier v. Martinez*, 416 U.S. 396 (1974) (access for prisoners); *Kleindienst v. Mandel*, 408 U.S. 753, 760, 762-65 (1972) (right to "receive information and ideas"); *Red Lion Broad. Co. v. FCC*, 395 U.S. 367, 390 (1969) ("right of the public to receive suitable access to social, political, esthetic, moral, and other ideas and experiences"); *Stanley v. Georgia*, 394 U.S. 557, 564 (1969) ("It is now well established that the Constitution protects the right to receive information and ideas."); *Griswold v. Connecticut*, 381 U.S. 479, 482 (1965) ("The right of freedom of speech and press includes not only the right to utter or to print, but the right to distribute, the right to receive, the right to read and freedom of inquiry, freedom of thought, and freedom to teach.") (citations omitted); *Lamont v. Postmaster Gen.*, 381 U.S. 301 (1965); *Associated Press v. United States*, 326 U.S. 1, 20 (1945) ("The First Amendment . . . rests on the assumption that the widest possible dissemination of information from diverse and antagonistic sources is essential to the welfare of the public."); *Martin v. City of Struthers*, 319 U.S. 141, 143 (1943).

²⁵ U.S. CONST. art I, § 8, cl. 8.

²⁶ *See* *Nimmer*, *supra* note 11 (emphasis mostly on copyright); *Patterson*, *supra* note 11 (emphasis on copyright and Copyright Clause of the U.S. Constitution); *Gordon*, *supra* note 11 (emphasis on Locke's natural law theory of property to debunk the argument that natural law gives an unlimited right to one's self-expression and arguing accommodation of First Amendment concerns).

²⁷ Carl H. Settlemeyer III, Note, *Between Thought and Possession: Artists' "Moral Rights"*

as significant in overcoming the author's right not to speak.²⁸

Once the view of a sizable minority of the Supreme Court, particularly during the Warren era,²⁹ the "absolutist" theory of the First Amendment,³⁰ suggesting that the phrase "Congress shall make no law" means *no law*, has been rejected.³¹ The Court has preferred to take several approaches to the First Amendment by mixing theories based on the category of speech involved³² (showing preferences or dislike for certain speech),³³ on the type of me-

and Public Access to Creative Works, 81 GEO. L.J. 2291 (1993); Hoberman, *supra* note 11, at 573; Rosenfield, *supra* note 11, at 296; Denicola, *supra* note 11, at 285.

²⁸ Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 558-59 (1985); *infra* notes 121-22 and accompanying text.

²⁹ Earl Warren served as Chief Justice of the U.S. Supreme Court from 1953 to 1969.

³⁰ See, e.g., *Konigsberg v. State Bar*, 366 U.S. 36, 56, 60-61 (1961) (Black, J., dissenting, joined by Douglas, J., and Warren, C.J.).

I do not subscribe to that doctrine [that permits constitutionally protected rights to be "balanced" away whenever a majority of this Court thinks that a State might have interest sufficient to justify abridgement of those freedoms] for I believe that the First Amendment's unequivocal command that there shall be no abridgement of the rights of free speech and assembly shows that the men who drafted our Bill of Rights did all the "balancing" that was to be done in this field.

Id. at 60-61.

³¹ *Id.* at 49-51 (Harlan, J.) ("[W]e reject the view that freedom of speech and association, as protected by the First and Fourteenth Amendments, are 'absolutes.'" (citations omitted).

³² In what has become infamous dicta, the Supreme Court in *Chaplinsky v. New Hampshire*, 315 U.S. 568 (1942), stated:

Allowing the broadest scope to the language and purpose of the Fourteenth Amendment, it is well understood that the right of free speech is not absolute at all times and under all circumstances. There are certain well-defined and narrowly limited classes of speech, the prevention and punishment of which have never been thought to raise any Constitutional problem. These include the lewd and obscene, the profane, the libelous, and the insulting or "fighting" words—those which by their very utterance inflict injury or tend to incite an immediate breach of the peace. It has been well observed that such utterances are no essential part of any exposition of ideas, and are of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and morality.

Id. at 571-72 (footnotes omitted). The Court has reviewed, narrowed and/or overruled this "dicta" many times. *R.A.V. v. City of St. Paul*, 112 S. Ct. 2538, 2543 (1992) acknowledges as much when it states that "[o]ur decisions since the 1960's have narrowed the scope of the traditional categorical exceptions for defamation, and for obscenity, but a limited categorical approach has remained an important part of our First Amendment jurisprudence." *Id.* at 2543 (citations omitted). Compare *Beauharnais v. Illinois*, 343 U.S. 250 (1952) (defamation) and *Roth v. United States*, 354 U.S. 476 (1957) (obscenity) with *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964) (defamation) and *Miller v. California*, 413 U.S. 15 (1973) (obscenity). See also *Denver Area Educ. Telecomm. Consortium, Inc. v. FCC*, 116 S. Ct. 2374, 2402-03 (1996) (Souter, J., concurring) (remarking on the amount of time the Court has taken before reaching "a final method of review" for various First Amendment areas).

³³ *New York Times Co. v. United States*, 403 U.S. 713 (1971) (political speech and the "heavy burden" of overcoming prior restraints); *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557 (1980) (commercial speech); *New York Times Co.*, 376 U.S. at 254 (libel of public figure); *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974) (libel of private individual over a matter of public concern); *Dun & Bradstreet, Inc. v. Greenmoss*

dia through which the speech is communicated,³⁴ and balancing interests where speech and non-speech concerns are involved.³⁵ Although the Court has repeatedly stated that the First Amendment is not an absolute,³⁶ the specter of the absolutist position has never entirely left its decisions.³⁷

Applying Justice Black's absolutist approach to situations where copyright protection and the First Amendment conflict, the outcome would appear simple: the First Amendment states, "Congress shall make no law . . . abridging the freedom of speech,"³⁸ and consequently, the Copyright Act, being an act of Congress, would yield to the First Amendment.³⁹ In fact, on its face, the First Amendment seems to swallow the rule since the Copyright Act, by definition, abridges certain aspects of speech.⁴⁰ As the late copyright scholar Melville B. Nimmer argued, this could not have been the intent of the Framers of the U.S. Constitution, nor, he posited, was it likely Black's position either.⁴¹ But, as Professor Goldstein

Builders, Co., 472 U.S. 749 (1985) (libel and speech of no public concern); *Miller*, 413 U.S. at 15 (obscenity).

³⁴ *Reno v. ACLU*, 117 S. Ct. 2329 (1997) (Internet); *Turner Broad. Sys., Inc. v. FCC*, 114 S. Ct. 2445 (1994) (cable television); *Miami Herald Pub. Co. v. Tornillo*, 418 U.S. 241 (1974) (newspapers); *Red Lion Broad. Co. v. FCC*, 395 U.S. 367 (1969) (broadcasting). *Denver Area Education Telecommunication Consortium*, 116 S. Ct. at 2374, appeared to mark a change in the Supreme Court's First Amendment jurisprudence in the "media of communication" area. Justice Souter's concurrence, in particular, remarked on the impending convergence of various forms of media on the Internet to help explain why the plurality did not set a standard of review for the cable television rules at issue. *Denver Area*, 116 S. Ct. at 2401-03. *Reno*, however, appears to be a slight swing to a media specific approach.

³⁵ See, e.g., *United States v. O'Brien*, 391 U.S. 367 (1968) (where speech and nonspeech elements combined, reasonable time, place, and manner restrictions allowed); *Texas v. Johnson*, 491 U.S. 397 (1989) (flag burning).

³⁶ "This Court has frequently denied that First Amendment rights are absolute and has consistently rejected the proposition that a prior restraint can never be employed." *Nebraska Press Assoc. v. Stuart*, 427 U.S. 539, 570 (1976) (Burger, C.J.); cf. "the exceptions to the rule [against prior restraints] have been confined to 'exceptional cases.'" *Id.* at 590 (Brennan, J., concurring, joined by Stewart, J., and Marshall, J.).

³⁷ "Content based regulations are presumptively invalid." *R.A.V.*, 112 S. Ct. at 2542 (Scalia, J.). "This Court's First Amendment jurisprudence has acknowledged limitations on the otherwise absolute interest of the speaker in reaching an unlimited audience where the speech is sexually explicit and the audience may include children." *Bethel Sch. Dist. No. 403 v. Fraser*, 478 U.S. 675, 683 (1986) (Burger, C.J.).

³⁸ U.S. CONST. amend. I.

³⁹ See *Konigsberg v. State Bar*, 366 U.S. 36, 56 (1961) (Black, J., dissenting).

⁴⁰ See 17 U.S.C. §§ 106 & 106A (exclusive rights in copyrighted works), 501 (infringement of copyright), 502 (injunctions), 503 (impounding and destruction of infringing articles) (1988 & Supp. IV 1993).

⁴¹ See Nimmer, *supra* note 11, at 1181-82. What Professor Nimmer neglected to mention are the reasons why Justice Black's absolutist views were not reconcilable with federal copyright law. Although close scrutiny of the absolutist theory of the First Amendment is beyond the scope of this article, see Alexander Meiklejohn, *The First Amendment Is an Absolute*, 1961 SUP. CT. REV. 245, if accepted, the Supreme Court's decision in *Harper & Row*, and its muddled approach to the copyright/First Amendment balance argues that the First Amendment absolutist theory is not as engulfing of copyright protection as Professor Nimmer believed.

has pointed out, "[c]opyright is the uniquely legitimate offspring of censorship,"⁴² and if the First Amendment was intended for anything, it was to prohibit governmental censorship.⁴³

The First Amendment and copyright share similar historical developments in the English licensing system. As stated in *Lovell v. Griffen*, "[t]he struggle for the freedom of the press was primarily directed against the power of the licensor."⁴⁴ In England, this power had primarily been given to the Stationers' Company.⁴⁵ "The primary interest of the state in granting this monopoly was not, however, the securing of stationers' property rights but the establishment of a more effective system for governmental surveillance of the press."⁴⁶ Copyright law first came into being shortly after the English government stopped licensing presses because of licensing's unpopularity.⁴⁷ As Mark Rose has demonstrated, the first copyright statute, the Statute of Anne of 1709 - 1710,⁴⁸ arose in England when the Stationers' Company campaigned for the protection of the literary property of authors in the hopes of reasserting its monopoly on published materials.⁴⁹ Although the Stationers' Company may have failed in its attempt to regain monopoly control, the centralizing power inherent in copyright law was given as one of the reasons to include the First Amendment in the Bill of Rights.⁵⁰

Most, if not all, of the bases argued to underlie the First Amendment were explained by Justice Brandeis in his concurrence in *Whitney v. California*.⁵¹

Those who won our independence believed that the final end of the State was to make men free to develop their faculties; and that in its government the deliberative forces should prevail over the arbitrary. They valued liberty both as an end and as a means. They believed liberty to be the secret of happiness and courage to be the secret of liberty. They believed that freedom to think as you will and to speak as you think are means indispensable to the discovery and spread of political truth; that without free speech and assembly discussion would be futile; that with them, discussion affords ordinarily adequate protection

⁴² Goldstein, *supra* note 1, at 983.

⁴³ *Near v. Minnesota*, 283 U.S. 697, 713-14 (1931).

⁴⁴ *Lovell v. Griffen*, 303 U.S. 444, 451 (1938).

⁴⁵ MARK ROSE, *AUTHORS AND OWNERS; THE INVENTION OF COPYRIGHT* 12 (1993).

⁴⁶ *Id.*

⁴⁷ *Id.* at 31-32, 36.

⁴⁸ An Act for the Encouragement of Learning, 1710, 8 Anne, ch. 19 (Eng.).

⁴⁹ See Rose, *supra* note 45, at 31-48.

⁵⁰ See *infra* notes 125-26 and accompanying text.

⁵¹ 274 U.S. 357, 375-76 (1927) (Brandeis, J., concurring).

against the dissemination of noxious doctrine; that the greatest menace to freedom is an inert people; that public discussion is a political duty; and that this should be a fundamental principle of American government. They recognized the risks to which all human institutions are subject. But they knew that order cannot be secured merely through fear of punishment for its infraction; that it is hazardous to discourage thought, hope, and imagination; that fear breeds repression; that repression breeds hate; that hate menaces stable government; that the path of safety lies in the opportunity to discuss freely supposed grievances and proposed remedies; and that the fitting remedy for evil counsels is good ones. Believing in the power of reason as applied through public discussion, they eschewed silence coerced by law—the argument of force in its worst form. Recognizing the occasional tyrannies of governing majorities, they amended the Constitution so that free speech and assembly should be guaranteed.⁵²

However, not all of the above reasons for First Amendment protection have been accepted or consistently applied over the years by the Supreme Court in all circumstances. Justice Brandeis' view that the protection of free speech can be an end in itself or for self-fulfillment, is not cited by courts very often.⁵³ The Supreme Court's battles over how to deal with defamation,⁵⁴ hate speech,⁵⁵ obscenity,⁵⁶ child pornography⁵⁷ and other so-called less favored or unprotected categories of speech⁵⁸ have made clear that certain speech is preferred, namely political speech and speech of "social importance."⁵⁹ In retrospect, it should be pointed out that Justice Brandeis' concurrence in *Whitney* was a vote to uphold a state law criminalizing certain union activity.⁶⁰ Despite the apparent disagreements and changing basis for First Amendment protection in the Supreme Court's jurisprudence, the favored treatment of "free trade in ideas," as first elucidated by Justice Oliver Wendell

⁵² *Id.*

⁵³ *Id.* This is not to say that its influence is unfelt. See JOHN E. NOWAK & RONALD D. ROTUNDA, CONSTITUTIONAL LAW 940-41 (4th ed. 1991); Marci A. Hamilton, *Art Speech*, 49 VAND. L. REV. 73 (1996); Stephen Fraser, *Berne, CFTA, NAFTA & GATT: The Implications of Copyright Droit Moral and Cultural Exemptions in International Trade Law*, 18 HASTINGS COMM. & ENT. L.J. 287, 301 (1996).

⁵⁴ See *supra* notes 32 & 33.

⁵⁵ *R.A.V. v. City of St. Paul*, 112 S. Ct. 2538 (1992).

⁵⁶ *Pope v. Illinois*, 481 U.S. 497 (1987); *Miller v. California*, 413 U.S. 15 (1973).

⁵⁷ *Osborne v. Ohio*, 110 S. Ct. 1691 (1990); *New York v. Ferber*, 458 U.S. 747 (1982).

⁵⁸ See *supra* note 32.

⁵⁹ See, e.g., *New York Times Co. v. United States*, 403 U.S. 713 (1971); *Roth v. United States*, 354 U.S. 476 (1957) (Brennan, J.).

⁶⁰ *Whitney v. California*, 274 U.S. 357 (1927) (Sanford, J.).

Holmes,⁶¹ remains constant through out the Court's holdings. By allowing the removal of certain speech from the marketplace of ideas, however, copyright appears to fly in the face of the goals of the First Amendment.

In light of the above, scrutiny of copyright law under First Amendment doctrine is not simple. Copyrighted material has never been considered one of the traditional categories less worthy of First Amendment protection. Because all types of speech are copyrightable,⁶² and as such, copyright is content and viewpoint neutral, the Supreme Court has rarely scrutinized copyrighted subject matter on the basis of the type of speech involved; be it political,⁶³ commercial, or obscene. One major reason why courts have managed to avoid these issues is that copyright is not supposed to protect ideas but only the expression of them, leaving ideas to the public domain where they can be traded freely.⁶⁴

III. COPYRIGHT

Federal copyright law, enacted under the authority granted to Congress by the U.S. Constitution,⁶⁵ protects "original works of authorship fixed in any tangible medium of expression."⁶⁶ In 1991, the Supreme Court addressed the issue of what copyrightable subject matter is in *Feist Publications, Inc. v. Rural Telephone Service Co.*⁶⁷ Speaking for a unanimous Court, Justice O'Connor stated:

The *sine qua non* of copyright is originality. To qualify for protection, a work must be original to the author. Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority

⁶¹ *Abrams v. United States*, 250 U.S. 616, 630 (1919) (Holmes, J., dissenting). The fact that Holmes' theory was first raised in a dissent has been a constant source of succor to many First Amendment theorists, including First Amendment absolutists.

⁶² *Mitchell Bros. Film Group v. Cinema Adult Theatre*, 604 F.2d 852 (5th Cir. 1979) (obscenity); *Belcher v. Tarbox*, 486 F.2d 1087 (9th Cir. 1973) (fraudulent subject matter).

⁶³ *But see Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 554, 557-60 (1985) (public interest in the content of copyrighted subject matter does not necessarily override the author's right to first publication or other exclusive rights granted to copyright owners by the Copyright Act).

⁶⁴ *Id.* at 547; *New York Times Co.*, 403 U.S. at 727 (Brennan, J., concurring); 17 U.S.C. § 102(b) (1988 & Supp. IV 1993).

⁶⁵ The text of Article I, Section 8, Clause 8 of the U.S. Constitution reads as follows: "The Congress shall have the 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." U.S. CONST. art. I, § 8, cl. 8.

⁶⁶ 17 U.S.C. § 102(a).

⁶⁷ 111 S. Ct. 1282 (1991).

of works make the grade quite easily, as they possess some creative spark, "no matter how crude, humble or obvious" it might be.⁶⁸

The Court was quite clear that originality was a constitutional requirement for copyright protection.⁶⁹ The maxim has arisen that as soon as a work is written down or recorded, it is copyrighted.⁷⁰

Copyright grants its owner certain exclusive rights that are listed in § 106 of the Copyright Act.⁷¹ As the Supreme Court in *Sony Corp. of America v. Universal City Studios, Inc.*⁷² noted: "[t]he monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit."⁷³ In other words, copyright is not property in the sense that real and personal property are commonly viewed.⁷⁴ In the House Report to the 1909 Copyright Act, the predecessor of the current

⁶⁸ *Id.* at 1287 (quoting I MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §§ 2.01[A]- [B] (1990); citing Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 547-49 (1985) (citations omitted)).

⁶⁹ *Feist*, 111 S. Ct. at 1288, 1289, 1294, 1296, 1297.

⁷⁰ 17 U.S.C. § 201(a) (1988 & Supp. IV 1993). A "work" is said to be fixed "in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." 17 U.S.C. § 101 (1996).

Registration is not a prerequisite for protection under current Federal Copyright Law. 17 U.S.C. § 408(a) (1996). Under the Copyright Act of 1909 and up to January 1, 1978, the effective date of the Copyright Act of 1976, a work generally had to have been "published" to fall under federal copyright protection, otherwise, state common law copyright protection applied. *See, e.g., American Visuals Corp. v. Holland*, 239 F.2d 740 (2d Cir. 1956); *White v. Kimmell*, 193 F.2d 744 (9th Cir. 1952). On January 1, 1978, such state common law protection was preempted by the Copyright Act of 1976, and the line of demarcation set by publication for most purposes disappeared. 17 U.S.C. § 301 (1996). *But see* 17 U.S.C. §§ 106(3), 107, 301(c) (1996).

⁷¹ Subject to §§ 107 through 120, the owner of copyright under this title has the exclusive right to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

17 U.S.C. § 106. *See also id.* at § 106A (certain moral rights provisions for "works of visual art").

⁷² 464 U.S. 417 (1984).

⁷³ *Id.* at 429.

⁷⁴ *See Kaplan, supra* note 16, at 72.

Act, which *Sony* quotes,⁷⁵ the Judiciary Committee of the House of Representatives stated:

The enactment of copyright legislation by Congress under the terms of the Constitution is not based upon any *natural right* that the author has in his writings, . . . but upon the ground that the welfare of the public will be served and progress of science and useful arts will be promoted by securing to authors for limited periods the exclusive rights to their writings.⁷⁶

*Feist*⁷⁷ is the Supreme Court's latest analysis of what the Copyright Act protects, holding that protection extends only to "original" expression and not to facts or ideas.⁷⁸ In stating this, the Court re-examined and restated what purpose copyright protection serves.

The primary objective of copyright is not to reward the labor of authors, but "[t]o promote the Progress of Science and useful Arts." Art. I, § 8, cl. 8. Accord *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. *Harper & Row, supra*, 471 U.S. at 556-557. This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship. As applied to a factual compilation, assuming the absence of original written expression, only the compiler's selection and arrangement may be protected; the raw facts may be copied at will. *This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.*⁷⁹

Feist dealt with the issue of whether the white pages of a phone book were copyrightable subject matter.⁸⁰ There had been some question before *Feist* whether there might be a "sweat of the brow" or "research" exception to the idea/expression distinction.⁸¹ Consistent with the encouragement theory stated above, the Court specifically held that "sweat of the brow" was not protected by the Copyright Act.⁸² "Sweat of the brow" could not be allowed under the constitutional grant to Congress to provide for copyright protection because facts "are not original," and as such, could not be

⁷⁵ *Sony Corp. of Am.*, 464 U.S. at 429-30 n.10.

⁷⁶ H.R. REP. NO. 2222, at 7 (1909) (emphasis added).

⁷⁷ 111 S. Ct. 1282 (1991).

⁷⁸ *Id.* at 1290.

⁷⁹ *Id.* at 1290 (emphasis added).

⁸⁰ *Id.* at 1287.

⁸¹ See, e.g., *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981).

⁸² *Feist*, 111 S. Ct. at 1295.

copyrighted.⁸³ Possibly the Court could have avoided this constitutional question since the Copyright Act itself states that its protections do not extend to ideas.⁸⁴ However, the relevant section does not specify that facts are unprotected.⁸⁵ The question was important because the Copyright Act also explicitly extends its copyright protection to compilations and derivative works,⁸⁶ which, it was argued, implied copyright protection to some of the facts therein.⁸⁷ By upholding the inclusion of facts in the public domain, the Court, *sub silentio*, was simultaneously reaffirming and enhancing First Amendment considerations in the area of copyright law. Even though the Copyright Act gives copyright holders certain exclusive rights, *Feist* makes clear that they are not all encompassing. As such, any public dissemination of a copyrighted work entails a partial dedication to the public domain of the facts and ideas contained therein for the public's benefit, even before the copyright term in the work has expired.⁸⁸

Even though *Feist* reaffirmed the idea/expression dichotomy as the essence of copyright law, the distinction, though clear in theory, has proven to be a difficult concept to apply in practice. The best known discussion on the topic is from Judge Learned

⁸³ *Id.* at 1290.

⁸⁴ "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." 17 U.S.C. § 102(b) (1996).

⁸⁵ Section 102 refers, for example, to ideas and discoveries. *Id.*

⁸⁶ In response, the Court stated, "copyright in a factual compilation is thin." *Feist*, 111 S. Ct. at 1289. Copyright protection may extend to compilations or derivative works but only to the extent of the new material contributed by the author of the new work. 17 U.S.C. § 103(b) (1996). "A 'compilation' is a work formed by the collection and assembling of preexisting materials 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." *See id.* at § 101 (1996).

A "derivative work" is a work *based upon* one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."

Id. (emphasis added).

The copyright protection of works that have fallen into the public domain (i.e. their copyright protection has ended) cannot be extended by use in a new work. 17 U.S.C. § 103(b). It is only that which is original and contributed by the author of the new work that is protected. *Id.*

⁸⁷ *Feist*, 111 S. Ct. at 1291-92.

⁸⁸ 17 U.S.C. §§ 302-305 (1996) (provisions on duration of copyright). Works created on or after January 1, 1978 have a copyright term which extends to 50 years after the death of the author, *id.* § 302(a), or up to 100 years from the date of the work's creation in the cases of anonymous, pseudonymous, and works made for hire. *Id.* §§ 101, 302(c).

Hand. His "abstractions test," used to determine when copying constitutes copyright infringement, is consistently cited:

Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times consist of only its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his "ideas," to which apart from their expression, his property is never extended.⁸⁹

The line between idea and expression, Hand said, would always appear arbitrary to some.⁹⁰ Thirty years later, however, Hand would declare that the decision of where to draw the line between protectable expression and unprotected ideas was inevitably an *ad hoc* one.⁹¹

Hand's "abstraction test," or variations thereon,⁹² remains the standard used by courts to draw the elusive line between copyrightable expression and ideas in the public domain. Despite the difficulties involved in this determination, the copyright laws have never been held to be overbroad. Courts and many commentators have maintained that the distinction between ideas and expression is sufficient protection against most of the impositions copyright law might have in the area of free speech.⁹³

As the Supreme Court stated in *Feist*, "facts do not owe their origin to an act of authorship."⁹⁴ At least in that respect, the distinction with expression is clearer. But when the term idea is used to distinguish it from expression, a lot becomes relative. For example, what is the idea in music? In the same vein, there is a danger in allowing personal taste to decide what should and should not maintain copyright protection. Justice Holmes was cogent and prescient when he stated:

It would be a dangerous undertaking for persons trained only to

⁸⁹ *Nichols v. Universal Pictures Co.*, 45 F.2d 119, 121 (2d Cir. 1930).

⁹⁰ *Id.* at 122.

⁹¹ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

⁹² *See, e.g., Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992).

⁹³ *See generally* Jane C. Ginsburg, *Copyright and other Protection of Works of Information after Feist v. Rural Telephone*, 92 COLUM. L. REV. 338 (1992); Comment, *A Regulatory Theory of Copyright: Avoiding a First Amendment Conflict*, 35 EMORY L. J. 163 (1986); Nimmer, *supra* note 11; Goldstein, *supra* note 1. Furthermore, it is argued, when expression must be copied, the equitable doctrine of fair use is sometimes available. 17 U.S.C. § 107 (1988 & Supp. IV 1993); *supra* Part III.

⁹⁴ *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1288 (1991).

the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke.⁹⁵

It is encouraging to see this language quoted by a unanimous Supreme Court in *Campbell v. Acuff-Rose Music, Inc.*⁹⁶ where the issue was a bawdy parody by the controversial rap group *2 Live Crew* of the song *Oh, Pretty Woman*, originally made popular by the late Roy Orbison.⁹⁷ In contrast, a majority of the Sixth Circuit panel, which the Supreme Court reversed, could not see how *2 Live Crew's* version could be a parody, although it assumed it was for summary judgment purposes.⁹⁸ One commentator went so far as to repeat the allegation that the panel's decision might have been racist in its inability to understand rap music's position in counterculture.⁹⁹

Another difficult issue involves Andy Warhol and Roy Lichtenstein and the possibility that they could have been sued for copyright infringement when they copied existing works such as pictures of Marilyn Monroe and comic strips. Picasso, not averse to copying himself, is quoted to have said: "[g]ood artists copy; great artists steal."¹⁰⁰ Regardless of Justice Holmes' warning, what Picasso, Warhol, and Lichtenstein did, and Jeff Koons is still doing, constitutes copyright infringement under current copyright law unless what they have copied can be described as unprotected facts and ideas or amounts to excusable "fair use"¹⁰¹ of the work which "inspired" them.¹⁰² It is precisely because the line is unclear,

⁹⁵ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

⁹⁶ 114 S. Ct. at 1173. In fact, Justice Souter's opinion uses language familiar to First Amendment experts, such as "breathing space," terms first used in *Sullivan*. See Henry R. Kaufman & Michael K. Cantwell, *From a First Amendment Standpoint*, NAT'L L.J. May 16, 1994, at C1.

⁹⁷ *Acuff-Rose*, 114 S. Ct. at 1167-68.

⁹⁸ *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429, 1435 n.8 (6th Cir. 1992), *rev'd*, 510 U.S. 569 (1994).

⁹⁹ Thomas F. Smegal, Jr., *Acuff-Rose Fair-Use Case Spurs Debate*, NAT'L L. J., Dec. 20, 1993, at 20.

¹⁰⁰ Molly McGraw, Comment, *Sound Sampling and Infringement in Today's Music Industry*, 4 HIGH. TECH. L.J. 147, 169 (1989).

¹⁰¹ For a discussion of the fair use defense, see *infra* Part III.

¹⁰² *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992) shows another example of a court's inability or unwillingness to find parody in the copied work. Koons, a well known "appropriation artist," following in the tradition of Marcel Duchamp and Andy Warhol, has frequently found himself embroiled in litigation over works he has sought to criticize. *Campbell v. Koons*, No. 91-6055, 1993 WL 97381 (S.D.N.Y. Apr. 11, 1993) (Koons created a sculpture based partly on Barbara Campbell's photograph *Boys with Pig*); *United Features Syndicate, Inc. v. Koons*, 817 F. Supp. 370 (S.D.N.Y. 1993) (Koons created a sculpture that included the character "Odie" from the Garfield comic strip). Koons lost his cases when

whether it be idea/expression, infringement/noninfringement, or fair use, that conflicts arise and exist between copyright and the First Amendment. Little is gained by courts reciting the idea/expression mantra if they do not recognize the constitutional implications involved.

In the only Supreme Court case to ever directly face the issue,¹⁰³ *Harper & Row, Publishers, Inc. v. Nation Enterprises*,¹⁰⁴ the majority stated "that copyright's idea/expression dichotomy 'strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communications of facts while still protecting an author's expression.'"¹⁰⁵ The Court found that the "definitional balance" of the idea/expression dichotomy covered a lot of ground in leaving to the public domain important tools for free speech. Facts are free.¹⁰⁶ For example, imagine a newspaper "scooping"¹⁰⁷ or having an "exclusive"¹⁰⁸ on a breaking news story. Under the Act, other newspapers could recite the same facts in the first news article or articles that later appeared, so long as they did

the courts refused to find fair use. Apparently, no First Amendment defenses were asserted. This may have been due to the Second Circuit's earlier assertion, influenced as it was by *Harper & Row*, that "the fair use doctrine encompasses all claims of First Amendment in the copyright field." *New Era Publications Int'l, ApS v. Henry Holt & Co.*, 873 F.2d 576, 584 (2d Cir. 1989). For somewhat of a step back from that statement, see *Twin Peaks Productions, Inc. v. Publications International, Ltd.*, 996 F.2d 1366, 1378 (2d Cir. 1993) (First Amendment defense in "extraordinary" cases).

¹⁰³ As opposed to dicta, which was the case in *New York Times Co. v. United States*, 403 U.S. 713 (1971). In what has come to be known as the *Pentagon Papers Case*, *New York Times* dealt with the federal government's application for an injunction to prevent publication of information contained in *History of U.S. Decision-Making Process on Viet Nam Policy*, a classified study the petitioner had managed to obtain. *Id.* at 714. In a footnote apparently in response to Chief Justice Burger's dissent, Justice Brennan stated: "copyright cases have no pertinence here: the Government is not asserting an interest in the particular form of words chosen in the documents, but is seeking to suppress the ideas expressed therein. And the copyright laws, of course, protect only the form of expression and not the ideas expressed." *Id.* at 726 (Brennan, J., concurring). The Copyright Act generally precludes copyright protection for works of the United States Government. 17 U.S.C. § 105 (1996).

¹⁰⁴ 471 U.S. 539 (1985).

¹⁰⁵ *Id.* at 556 (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 203 (2d Cir. 1983) (it later was reversed on the fair use determination). The majority also cited *New York Times Co. v. United States*, 403 U.S. 713, 726 (1971) (Brennan, J., concurring) and MELVILLE B. NIMMER, 1 COPYRIGHT § 1.10[B][2] (3d ed. 1984) as support for their position. The value of these authorities should give one pause considering that Justice Brennan wrote the dissent in *Harper & Row*, 471 U.S. at 579-605 (Brennan, J., dissenting, joined by White, J., and Marshall, J.) and that Melville B. Nimmer filed an *amici curiae* brief urging affirmation of the Second Circuit's fair use decision which the Supreme Court reversed. *Harper & Row*, 471 U.S. at 541.

¹⁰⁶ *Harper & Row*, 471 U.S. at 556; 17 U.S.C. § 102(b) (1996).

¹⁰⁷ Being the first to discover a newsworthy event, or the first to release the story for public dissemination by being faster than the competing news services. WEBSTER'S 20TH CENTURY DICTIONARY 1264 (1992).

¹⁰⁸ *Id.* at 638. Being the only news service with access to the newsworthy information.

not copy the expression therein.¹⁰⁹ The "scooping" newspaper could not demand permission for use of the facts and copyright royalties from the "scooped" newspapers who wished to run their stories. The *Pentagon Papers Case* was fought to assert the press's right to discover and publish such news without government interference.¹¹⁰

A somewhat analogous situation occurred in *Harper & Row*, where a newspaper tried to "scoop" some of the material contained in former President Ford's autobiography before the book was released to the public.¹¹¹ One distinction the Supreme Court emphasized was that the former President's book had not yet been published.¹¹² This, the Court held, "tended to negate the defense of fair use,"¹¹³ an equitable defense that could have prevented a holding of infringement.¹¹⁴ This distinction between published and unpublished works eventually led to some fair use decisions having far reaching copyright and First Amendment implications by which not even Congress could abide.¹¹⁵ Consequently, in 1992, Congress amended the fair use provision of the Copyright Act to limit the impact of *Harper & Row* and its progeny. The Act now states: "The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors."¹¹⁶

The crux of the majority's argument in *Harper & Row* against a First Amendment defense to copyright infringement was that "[i]f every volume that was in the public interest could be pirated away by a competing publisher, . . . the public [soon] would have nothing worth reading."¹¹⁷ According to the Court, "the Framers in-

¹⁰⁹ Or not too much, as allowed under the "fair use" doctrine. 17 U.S.C. § 107 (1996); *infra* Part III.

¹¹⁰ *New York Times Co.*, 403 U.S. at 713; *supra* note 103.

¹¹¹ *Harper & Row*, 471 U.S. at 542-43.

¹¹² *Id.* at 542, 551. Since the *Pentagon Papers* were alleged to be classified state secrets, *New York Times Co.*, 403 U.S. at 713, and as such, unpublished, query what the result in that case would have been if the government had been able to assert a copyright infringement claim.

¹¹³ *Id.* at 551, 554.

¹¹⁴ 17 U.S.C. § 107. See *infra* Part III.

¹¹⁵ See, e.g., *New Era Publications Int'l ApS. v. Henry Holt & Co.*, 873 F.2d 576 (2d Cir. 1989); *Salinger v. Random House Inc.*, 811 F.2d 90 (2d Cir. 1987).

¹¹⁶ Pub. L. No. 102-492, 106 Stat. 3145 (codified at 17 U.S.C. § 107 (1992)). Congress apparently did not believe it was overruling *Harper & Row* when it passed the amendment, but rather addressing the problems raised by the restrictive holdings against fair use of unpublished works in *Salinger* and *New Era*, which were argued to be "misreadings" of *Harper & Row*. S. REP. NO. 102-141 (1991); H. R. REP. NO. 102-836 (1992); 138 CONG. REC. S17358 (daily ed. Oct. 7, 1992). See Roger L. Zissu, *Market Impact Key to Fair-Use Analysis*, NAT'L L. J., Mar. 1, 1993, at 23.

¹¹⁷ *Harper & Row*, 471 U.S. at 559 (quoting Sobel, *Copyright and the First Amendment: A Gathering Storm?*, 19 COPYRIGHT L. SYMP. (ASCAP) 43, 78 (1971)).

tended copyright itself to be the engine of free expression. By establishing a marketable right to use one's expression, copyright supplies the economic incentive to create and disseminate ideas."¹¹⁸ Thus, the majority's slippery slope argument against a First Amendment defense for copying speech of "public interest" exhibited a concern that under-protecting this speech could lead to less speech of public interest. The Court seemed influenced by the fact that the defendant's "copying" was "composed of quotes, paraphrases, and facts drawn exclusively from [former President Ford's] manuscript [and] . . . attempted no independent commentary, research or criticism,"¹¹⁹ the type of "transformative" use the Supreme Court has since shown itself to prefer in fair use cases.¹²⁰

One element of the *Harper & Row* decision that is especially troubling, is that the majority does not give any direct authority, historical or otherwise, for the argument of the Framers' intent to make copyright "the engine of free expression." The only First Amendment argument made by the Court that comes close to this concern was "*freedom of thought and expression 'includes both the right to speak freely and the right to refrain from speaking at all.'*"¹²¹ As this au-

¹¹⁸ *Harper & Row*, 471 U.S. at 558.

¹¹⁹ *Id.* at 543. For an in depth discussion of fair use, see *infra* Part III.

¹²⁰ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

¹²¹ *Harper & Row*, 471 U.S. at 559 (quoting *Wooley v. Maynard*, 430 U.S. 705, 714 (1977) (Burger, C.J.) (emphasis added)); see also *supra* notes 23-24 and accompanying text. The Court in *Harper & Row* emphasized that the First Amendment right depends on whether the speech or silence was voluntary by quoting *Estate of Hemingway v. Random House, Inc.*, 244 N.E.2d 250, 255 (N.Y. 1969) (Fuld, C.J.):

The essential thrust of the First Amendment is to prohibit improper restraints on the *voluntary* public expression of ideas; it shields the man who wants to speak or publish when others wish him to be quiet. There is necessarily, and within suitably defined areas, a concomitant freedom *not* to speak publicly, one which serves the same ultimate end as freedom of speech in its affirmative aspect.

Harper & Row, 471 U.S. at 559. The Court does not help in defining the precise contours of this right. Certainly, it has not been as clearly drawn as rights to speak or to have access to information. See *supra* notes 23-28 and accompanying text. *Maynard* itself, from which the Court gleans the right, was citing to *West Virginia Board of Education v. Barnette*, 319 U.S. 624 (1943), which dealt with a Jehovah's Witness' refusal to salute the flag. *Id.* at 626, 629 n.2. The Court saw the salute as a form of utterance which the state could not compel. *Id.* at 633-34. Coincidentally, *Maynard* also concerned a Jehovah's Witness' refusal to be forced to show fealty to his government. *Maynard*, 430 U.S. at 713. *Maynard* had been jailed for covering up and removing the words "Live Free or Die" on his New Hampshire license plate. *Id.* at 707-08. The Court held that the state could not force *Maynard* to place such mottos on his automobile. *Id.* at 713. The lack of guidance on what constitutes compelled speech was thrown into disarray last term in *Glickman v. Wileman Bros. & Elliott, Inc.*, 117 S. Ct. 2130 (1997). In *Glickman*, the law in question required financial support of generic advertising from members of a government "collectivised" industry. The five member majority found no First Amendment issue was involved. The dissent by Justice Souter would have applied the now-traditional *Central Hudson* test for commercial speech, while Justice Thomas' dissent would have applied the highest level of scrutiny to the law. Thomas' last line read as follows: "surely we have lost our way." 117 S. Ct. at 2156.

thor has stated in the past, one view of the Court's argument could be the following:

[I]f one is going to speak, but is only willing to do so for a price, copyright will aid in the dissemination of that speech and prevent unauthorized copying (infringement) by others. If, under exercise of the First Amendment right to remain silent, speech cannot be voluntarily obtained without remuneration, copyright provides the economic incentive to release the expression to the public. The Speech Clause of the First Amendment does not prohibit the government from encouraging speech; it only prohibits the government from discouraging it. The public benefits because the marketplace of ideas is a First Amendment end in itself. Authors are benefited by a system of trade regulation for the dissemination of their work for profit. Arguably, only in this way can copyright be seen as "the engine of free expression" under the First Amendment and still be consistent with First Amendment principles.¹²²

To ease some of the concern that the copyright "monopoly"¹²³ could be abused, the Supreme Court stated: "[w]e do not suggest this right not to speak would sanction abuse of the copyright owner's monopoly as an instrument to suppress facts."¹²⁴

The problem with the Court's reasoning that the Framers of the Constitution intended copyright to be the engine of free expression, of course, is that it is historically false. Although there is little historical content on the drafting of the Constitution's Copy-

¹²² Fraser, *supra* note 53, at 302-03 (footnotes omitted). The author is no longer convinced that First Amendment and copyright concerns are adequately addressed by this balance. To point out the obvious, despite Justice Souter's quotation of Samuel Johnson in *Acuff-Rose*, that "[n]o man but a blockhead ever wrote, except for money," 510 U.S. 569, 582 (1994) (quoting from 3 BOSWELL'S LIFE OF JOHNSON 19 (G. Hill ed., 1934)), not all copyrighted materials are created for money or profit. Class notes, shopping lists, personal cards and letters, and various Internet uses amply exemplify this fact. *Feist's* assertion that the originality necessary for copyright protection is extremely low would give protection to expressive works that were never intended to be created for profit, unless the word profit is stretched beyond its remunerative meaning. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1287; *supra* note 68 and accompanying text. Secondly, the argument puts too much weight on the commercial market of the First Amendment marketplace of ideas. Third, the First Amendment, being an end in and of itself, is a doubtful argument given current Supreme Court First Amendment jurisprudence. See *supra* notes 53-60 and accompanying text. But see *Bose Corp. v. Consumers Union of United States, Inc.*, 466 U.S. 485, 503-04 (1984); *supra* note 21. Finally, the historical evidence reveals that copyright was not exactly viewed as the engine of free expression the Supreme Court attributes to the Constitution's Framers. *Harper & Row*, 471 U.S. at 558; *supra* note 118. In fact, it was quite the opposite. See *infra* notes 125-27 and accompanying text.

¹²³ It is somewhat of a misnomer to refer to copyright as a "monopoly." "This [copyright] protection has never accorded the copyright owner complete control over all possible uses of his work." *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 432 (1984). "[P]rotection given to copyrights is wholly statutory." *Id.* at 431.

¹²⁴ *Harper & Row*, 471 U.S. at 559.

right Clause,¹²⁵ the Clause was one of the reasons given by supporters of the *Bill of Rights* for including the First Amendment in the Constitution.

Tho[ugh] it is not declared that Congress have a power to destroy the liberty of the press; yet in effect, they will have it They have a power to secure to authors the right of their writings. Under this, they may license the press, *no doubt*, and under licensing the press, they may suppress it.¹²⁶

The fear of a licensed press and the historical roots of copyright in that censorship system was not lost on the Framers.¹²⁷ Unfortunately, in protecting a former President against the copying of his unpublished memoirs, and by muddling their way through accepted economic and First Amendment arguments to buttress their decision, the majority was able to circumvent the First Amendment defense they were facing with a myth. This may be unduly harsh given that what the defense was asking the Court to do was rule a federal statute overbroad with no clear guidance on how to limit a First Amendment defense or privilege other than on the basis that the author in question was a public figure.¹²⁸ Nevertheless, resorting to logical fallacies and baseless historical arguments, thereby allowing copyright owners to restrict more speech than necessary and forcing Congress to intervene anyway¹²⁹ is the harsh result of the *Harper & Row* decision. More consideration for the free expression issue¹³⁰ could have prevented the current quan-

¹²⁵ THE FEDERALIST NO. 43 (James Madison).

¹²⁶ *Ratification of the Constitution by the States, Pennsylvania*, 2 THE DOCUMENTARY HISTORY OF THE RATIFICATION OF THE CONSTITUTION 454 (1976). The quote is attributed to Pennsylvania Constitutional Convention Delegate Robert Whitehill and was made on December 1, 1787 in the debates over the ratification of the U.S. Constitution. The Pennsylvania Convention voted to adopt the Constitution, without the amendments Mr. Whitehill had proposed, by a vote of 46 to 23 on December 12, 1787. *Id.* at 323-24. For other historical evidence arguing for and against amendment of the Constitution during ratification, based on freedom of speech and press concerns related to the Copyright Clause, see *A Republican I: To James Wilson, Esquire*, N.Y.L.J. Oct. 25, 1787 reprinted in 13 THE DOCUMENTARY HISTORY OF THE RATIFICATION OF THE CONSTITUTION 477, 479 (1981); Hugh Williamson, Ratification of the Constitution by the States, North Carolina, Address at Edenton, North Carolina (Nov. 8, 1787), in N.Y. DAILY ADVERTISER, Feb. 25, 1788, reprinted in 16 THE DOCUMENTARY HISTORY OF THE RATIFICATION OF THE CONSTITUTION 201, 202 (1986).

¹²⁷ See *supra* notes 42-49 and accompanying text.

¹²⁸ *Harper & Row*, 471 U.S. at 557. The fact that such a factor had been part of defamation law since *New York Times v. Sullivan*, 376 U.S. 254 (1964), should not necessarily have convinced the court that it was the best line to draw. However, the public interest had been part of the Court's First Amendment and copyright and fair use jurisprudence until, and even after, *Harper & Row*. Thus, *Harper & Row's* rejection of the public interest in its fair use analysis rings hollow. See *infra* note 200 and accompanying text.

¹²⁹ See *supra* notes 115-16 and accompanying text.

¹³⁰ In a stinging dissent that would prove prophetic, Justice Brennan, joined by Justices White and Marshall, stated:

Although the Court pursues the laudable goal of protecting "the economic in-

dary courts face when dealing with conflicts between protected speech and copyrighted works within the constrained framework of copyright fair use.¹³¹

Despite the above discussion of the holding in *Harper & Row*, the fact remains that by granting authors the exclusive right to reproduce and distribute their original expression,¹³² the Copyright Act allows some authors and copyright holders to use copyright as a means to suppress facts as well as expression.¹³³ Most of the cases addressing this problem have arisen under the fair use doctrine. Thus, any balance between the First Amendment and copyright must consider the implications of the fair use defense to copyright infringement.

IV. FAIR USE

The case most responsible for firing the debate over the First Amendment implications of federal copyright law was *Time Inc. v. Bernard Geis Associates*.¹³⁴ *Time Inc.* involved the now famous eight millimeter film taken by Abraham Zapruder of the assassination of President John F. Kennedy in Dallas on November 22, 1963.¹³⁵ A

centive to create and disseminate ideas," *ante*, at 558, this zealous defense of the copyright owner's prerogative will, I fear, stifle the broad dissemination of ideas and information copyright is intended to nurture. Protection of the copyright owner's economic interest is achieved in this case through an exceedingly narrow definition of the scope of fair use. The progress of arts and sciences and the robust public debate essential to an enlightened citizenry are ill served by this constricted reading of the fair use doctrine.

Harper & Row, 471 U.S. at 579 (Brennan, J., dissenting).

¹³¹ See, e.g., *Twin Peaks Prods., Inc. v. Publications Int'l, Ltd.*, 996 F.2d 1366 (2d Cir. 1993); *Maxtone-Graham v. Burtchaell*, 803 F.2d 1253 (2d Cir. 1986); *ApS v. Henry Holt & Co.*, 873 F.2d 576 (2d Cir. 1989); cases cited *infra* note 133.

¹³² 17 U.S.C. §§ 106; 102(a) (1988).

¹³³ *Religious Tech. Ctr. v. F.A.C.T.NET Inc.*, 907 F. Supp. 1468 (D. Colo. 1995) (seized Church of Scientology materials returned to defendants); *Religious Tech. Ctr. v. Lerma*, 908 F. Supp. 1362 (E.D. Va. 1995) (Church of Scientology's motivation in bringing copyright infringement suit found to be "reprehensible" attempt to stifle criticism); *Church of Scientology Int'l v. Fishman*, 35 F.3d 570 (9th Cir. 1994); *Bridge Publications, Inc. v. Vien*, 827 F. Supp. 629 (S.D. Cal. 1993); *New Era Publications Int'l, ApS v. Carol Publ'g Group*, 904 F.2d 152 (2d Cir. 1990); *New Era Publications*, 695 F. Supp. 1493 (S.D.N.Y. 1988), *aff'd on other grounds*, 873 F.2d 576 (2d Cir. 1989), *cert. denied*, 110 S. Ct. 1168 (1990) (Church of Scientology licensee sued under copyright to enjoin publications critical of L. Ron Hubbard, church founder, based on copying from Hubbard's published and unpublished works); *Maxtone-Graham v. Burtchaell*, 803 F.2d 1253 (2d Cir. 1986) (pro-choice author sued anti-abortion author for infringement over quotation of copyrighted work); *Salinger v. Random House Inc.*, 811 F.2d 90 (2d Cir. 1987) (1987) (author J.D. Salinger sued under copyright law to enjoin use of his letters in a biography). These examples are among the more extreme and coincidentally involve many cases brought by the Church of Scientology. See also Part IV; David Leavitt, *Did I Plagiarize His Life?*, N.Y. TIMES MAGAZINE, Apr. 3, 1994, at 36 (Young writer's new book, *While England Sleeps*, inspired by British poet Stephen Spender, withdrawn by his publisher when Spender threatened copyright suit).

¹³⁴ 293 F. Supp. 130 (S.D.N.Y. 1968); *Nimmer*, *supra* note 11, at 1197-1204.

¹³⁵ *Time Inc.*, 293 F. Supp. at 131, 133.

few days after the assassination, *Life* magazine, owned by Time Inc.,¹³⁶ bought Zapruder's film and "all rights therein" for \$150,000.¹³⁷ In what it termed a "remarkable and exclusive series," *Life* published most of the individual frames of the Kennedy shooting a few days later.¹³⁸ Later issues of *Life* commemorating the event¹³⁹ or discussing the Warren Commission's Report¹⁴⁰ on the assassination also included frames from the Zapruder film.¹⁴¹

In November 1967, Bernard Geis Associates published a book written by Josiah Thompson titled *Six Seconds in Dallas*¹⁴² that included, without Time Inc.'s permission, "[s]ignificant parts of 22 copyrighted frames," in the form of charcoal "sketches," from the Zapruder film.¹⁴³ The court described Thompson's book as "a serious, thoughtful and impressive analysis of the evidence" on the Kennedy assassination.¹⁴⁴ Nevertheless, Time Inc. sued the publisher, its distributor, Random House, and Thompson¹⁴⁵ for copyright infringement.¹⁴⁶ The defendants argued as affirmative defenses, *inter alia*, "that the Book [was] protected by the First Amendment and on that account an injunction [could not be] issued" and alternatively, that their copying was a fair use under copyright law.¹⁴⁷

The defendants had made numerous unsuccessful attempts to obtain permission from Time Inc. to use the Zapruder film frames in their book.¹⁴⁸ Even an offer "to pay *Life* a royalty equal to the profits [of] the book" was refused.¹⁴⁹ The defendants' attorney had been told that "it was corporation policy 'not to allow anyone the use of any part of this film in the United States,' that the film was considered 'an invaluable asset of the corporation,' and that

¹³⁶ *Id.* at 131.

¹³⁷ *Id.* at 134.

¹³⁸ *Id.*

¹³⁹ *Id.*

¹⁴⁰ Chief Justice Earl Warren was appointed by President Lyndon Johnson to chair the Commission responsible for investigating President Kennedy's assassination. *Id.*

¹⁴¹ *Id.* at 134, 136-37.

¹⁴² JOSIAH THOMPSON, *SIX SECONDS IN DALLAS; A MICRO-STUDY OF THE KENNEDY ASSASSINATION* (1967).

¹⁴³ *Time Inc.*, 293 F. Supp. at 139; see also THOMPSON, *supra* note 142, at 68-73.

¹⁴⁴ *Id.* at 131-32.

¹⁴⁵ Since Thompson, presumably in Pennsylvania where he was an assistant professor of philosophy at Haverford College, was never served with process and never appeared, the court did not have jurisdiction over him. *Id.* at 132.

¹⁴⁶ *Id.*

¹⁴⁷ *Id.* The use of injunctions in copyright cases has come under increased scrutiny since *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 581 n.10 (1994). See Practice Management Info. Corp. v. AMA, 121 F.3d 516 (9th Cir. 1997); American Geophysical Union v. Teraco, Inc., 60 F.3d 913, 932 n.19 (2d Cir. 1994).

¹⁴⁸ *Time Inc.*, 293 F. Supp. at 138.

¹⁴⁹ *Id.*

'its use will be limited to our publications and enterprises.'¹⁵⁰ Time Inc. argued that it intended to use the Zapruder film in "a motion picture project" and would "undoubtedly" use the film in its publications and broadcast outlets in the future.¹⁵¹

The court in *Time Inc.* sidestepped the First Amendment question by finding that defendants' copying of the frames in their book was a fair use.¹⁵² Applying (what at the time was still just a legislative proposal for codification) the judicially created fair use exception to copyright law,¹⁵³ the court found the balance weighed for the defendants and dismissed Time Inc.'s suit.¹⁵⁴ The reasoning applied by Judge Wyatt of the Federal Southern District Court of New York has been sharply criticized by many of the leading commentators as inconsistent with the fair use provision.¹⁵⁵ The court is said to have put too little emphasis on the fourth factor: "the effect of the use upon the potential market for or value of the copyrighted work."¹⁵⁶ Melville Nimmer was particularly incensed by Judge Wyatt's statement of: "[i]t seems reasonable to speculate that the Book would, if anything, enhance the value of the copyrighted work; it is difficult to see any decrease in its value."¹⁵⁷ Nimmer's response was:

¹⁵⁰ *Id.*

¹⁵¹ *Id.* at 136-37.

¹⁵² *Id.* at 146.

¹⁵³ *Id.* at 145. The legislative proposal eventually became § 107 of the Copyright Act of 1976, thus codifying the fair use exception. H.R. REP. NO. 94-1476, at 65-66 (1976). Other than the addition of a clause at the end of the first factor to be considered in a fair use determination, and the recent amendment as to unpublished works (the last sentence of the section), *supra* note 115, § 107 is practically the same as the provision the court was considering in 1968. It reads:

§ 107. Limitation on exclusive rights: Fair use

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

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

The fact that a work is unpublished shall not itself bar a finding of fair use if such a finding is made upon consideration of all the above factors.

17 U.S.C. § 107 (1994).

¹⁵⁴ *Time Inc.*, 293 F. Supp. at 146.

¹⁵⁵ See Nimmer, *supra* note 11, at 1200-01; Denicola, *supra* note 11, at 302-03.

¹⁵⁶ 17 U.S.C. § 107(4).

¹⁵⁷ *Time Inc.*, 293 F. Supp. at 146; Nimmer, *supra* note 11, at 1201.

This is like arguing that if a motion picture company takes my novel and uses it as the basis of a film, I am not injured because the film is likely to enhance the sale of my novel. Indeed, my book sale may not be harmed, but my ability to mount my own motion picture production based upon my novel will.¹⁵⁸

Although Nimmer's reply was polemical in nature, the applicability and correctness of his analogy is somewhat relative.

Nimmer's attack was, in a very important sense, comparing very different fair use situations. His point is best illustrated by an application of the fair use factors to the facts at hand. The first factor requires a consideration of the "purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes."¹⁵⁹ Judge Pierre Leval, in his seminal article on fair use, termed this factor "the soul of fair use. A finding of justification under this factor seems indispensable to a fair use defense."¹⁶⁰

One reason why Judge Wyatt's analysis is criticized is that he focused almost exclusively on the fourth factor and ignored the first three by stating in a conclusory fashion that "the balance seems to be in favor of the defendants."¹⁶¹ However, when applying the first factor to the defendant's copying of the Zapruder film, the result does appear to favor the defendants. The fact that the court stated that the "artist" had "simply copied the original in charcoal with no creativity or originality whatever"¹⁶² is not determinative.¹⁶³ Under the "transformative test" propounded by Judge Leval,¹⁶⁴ a productive use was made of the copied matter; the frames were used to criticize the conclusions of the Warren Com-

¹⁵⁸ Nimmer, *supra* note 11, at 1201.

¹⁵⁹ 17 U.S.C. § 107(1).

¹⁶⁰ Pierre N. Leval, *Toward A Fair Use Standard*, 103 HARV. L. REV. 1105, 1116 (1990). The reason Judge Leval considers the first factor so important is that it is the only one of the four listed that emphasizes the copying work itself, or the copier, instead of the work copied. *Id.* at 1111. Without the first factor, the whole analysis would otherwise, almost by definition, be weighed against fair use.

The influence of Judge Leval's law review article can be seen throughout the Supreme Court's last foray into the fair use area in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). The Court specifically cites Leval for the proposition that the four fair use factors listed in § 107 of the Copyright Act cannot "be treated in isolation, one from the other. All are to be explored, and the results weighed together, in light of the purposes of copyright." *Acuff-Rose*, 510 U.S. at 576-78 (citing Leval, *supra* note 160, at 1110-11). It adopted his "transformative" test as applied to the first fair use factor, and reiterated its holding in *Sony* that a transformative use would not always be a necessary requisite for a fair use finding. *Acuff-Rose*, 510 U.S. at 577.

¹⁶¹ *Time Inc.*, 293 F. Supp. at 146.

¹⁶² *Id.* at 139.

¹⁶³ If it were, many of the quotes in this paper, and most scholarly articles, would constitute copyright infringement.

¹⁶⁴ Leval, *supra* note 160, at 1111.

mission.¹⁶⁵ Judge Wyatt says as much when he states: "[t]he Book is not bought because it contained the Zapruder pictures; the Book is bought because of the theory of Thompson and its explanation, supported by Zapruder pictures."¹⁶⁶ The fact that defendant's book was sold for profit is not of itself determinative because if all uses for profit were to fail under this factor, practically no fair uses could be made at all.¹⁶⁷

Applying the same test to Professor Nimmer's hypothetical is difficult because of a lack of facts.¹⁶⁸ The less the transformation of his novel in its adaptation to a motion picture, the less likely it is to warrant justification.¹⁶⁹ Underlying both scenarios is also the fact that the Copyright Act vests the exclusive right "to prepare derivative works based on the copyrighted work" in the author.¹⁷⁰ Though fair use applies notwithstanding this exclusive right in copyright holders, it must be kept in mind when determining the scope of what copyright protection covers.¹⁷¹

The second factor, "the nature of the copyrighted work,"¹⁷² would tend to weigh for Professor Nimmer's hypothetical novel, and against Time Inc. Artistic works tend to receive more favorable treatment under this factor than works that are factual in

¹⁶⁵ *Time Inc.*, 293 F. Supp. at 135. According to Judge Leval, "[t]ransformative uses may include criticizing the quoted work, . . . proving a fact, or summarizing an idea argued in the original in order to defend or rebut it. They also may include parody, symbolism, aesthetic declarations, and innumerable other uses." Leval, *supra* note 160, at 1111.

¹⁶⁶ *Time Inc.*, 293 F. Supp. at 146.

¹⁶⁷ See Leval, *supra* note 160, at 1116 n.53; Harper & Row, Publications, Inc. v. Nation Enters., 471 U.S. 539, 592 (1985) (Brennan, J., dissenting); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 570, 582 (1994). Judge Wyatt also stated that "fair use presupposes 'good faith and fair dealing.'" *Time Inc.*, 293 F. Supp. at 146. Yet Thompson, who for a while had been a consultant for *Life* magazine on the Kennedy assassination, managed to obtain access to the Zapruder frames during his work and to make copies of them. *Id.* at 135-36. In fact, he was caught in the act of doing so. *Id.* at 136. The court found *Life's* reaction to this event as peculiar: Thompson was not rebuked or told he had done something that was prohibited, but was allowed to keep the copies. *Id.* Though the court did not consider this an excuse for Thompson's actions, *id.*, it is clear from its decision that despite this purported lack of "good faith," it was not enough to arrive at a different decision. This may have been partly because Thompson could have gotten access to the frames elsewhere, and because of Time Inc.'s rejection of an offer of full royalties from defendant's book. *Id.* at 146.

¹⁶⁸ *Acuff-Rose*, 510 U.S. at 579 (fair use to be judged "case by case, in light of the ends of the copyright law").

¹⁶⁹ See Leval, *supra* note 160, at 1111 ("merely repackaging" vs. "secondary use [which] adds value to the original"); *Campbell*, 510 U.S. at 578.

¹⁷⁰ 17 U.S.C. §§ 106(2), 201(a) (1988).

¹⁷¹ In another famous quote from Judge Learned Hand, the rule was stated that copyright law "cannot be limited literally to the text, else a plagiarist would escape by immaterial variations." *Nichols v. Universal Pictures Co.*, 45 F.2d 119, 121 (2d Cir. 1930). For a critical history of the gradual enlargement of the scope of copyright protection since its inception in the first Copyright Act passed by Congress, the Copyright Act of May 31, 1790, see Patterson, *supra* note 11.

¹⁷² 17 U.S.C. § 107(2) (1988).

nature because they exhibit the creativity copyright is meant to encourage.¹⁷³ Professor Nimmer's work, a fiction novel, is more likely to exhibit this type of creativity than the filming of a news event where the facts may not be copyrighted,¹⁷⁴ as was the case with the Zapruder film.¹⁷⁵

The third factor, "the amount and substantiality of the portion used in relation to the copyrighted work,"¹⁷⁶ is a very difficult one to weigh. Usually, the greater the taking, the less likely a fair use will be found.¹⁷⁷ The question is made difficult by its relation to the first and fourth factors.¹⁷⁸ With enough transformation, even a substantial taking might be excused.¹⁷⁹ Conversely, the greater the taking, the more likely the work will tend to have an adverse effect on the "potential market"¹⁸⁰ of the copied work. Furthermore, the factor is not limited to a quantitative measure of the copying, but will frequently examine the qualitative worth of what was appropriated.¹⁸¹ In *Time Inc.*, there was copying of much of twenty-two frames of the Zapruder film¹⁸² out of a possible 480.¹⁸³ However, of those 480 frames, only 140 showed the events of the Kennedy assassination, and out of those, only 40 showed the shots fired at President Kennedy and Texas' Governor John Connally.¹⁸⁴ Thus, depending on the number of frames chosen to determine the sample to compare from, quantitatively speaking, the copying can be characterized from minute to substantial. Qualitatively, the point tends to favor *Time Inc.* because the frames copied were most likely the important part of the film. Judge Wyatt may be faulted for ignoring this factor in his opinion. As for Professor Nimmer's hypothetical, again, facts are sorely lacking. But if a faithful adaptation were to be done of his novel, obviously a substantial amount would have to be copied.

While Professor Nimmer probably would have won on all three factors, *Time Inc.* has arguably won only on one. Nimmer's

¹⁷³ *Stewart v. Abend*, 495 U.S. 207, 237-38 (1990); *cf. Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 455 n.40 (1984).

¹⁷⁴ *See Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1290 (1991).

¹⁷⁵ *Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 143 (S.D.N.Y. 1968).

¹⁷⁶ 17 U.S.C. § 107(3).

¹⁷⁷ *Cf. Sony*, 464 U.S. at 449-50; Leval, *supra* note 160, at 1123.

¹⁷⁸ *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 582 (1994).

¹⁷⁹ *Harper & Row v. Nation Enters.*, 471 U.S. 539, 564-65 (1985). In *Sony*, the home taping of entire television programs was found not to weigh against a finding of fair use. *Sony*, 464 U.S. at 449-50.

¹⁸⁰ 17 U.S.C. § 107(4); Leval, *supra* note 160, at 1123.

¹⁸¹ *Acuff-Rose*, 510 U.S. at 582; Leval, *supra* note 160, at 1123.

¹⁸² *Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 139 (S.D.N.Y. 1968).

¹⁸³ *Id.* at 133.

¹⁸⁴ *Id.*

analogy thus shows how fact sensitive the fair use test is when applied, and that little is served other than rhetoric by equating what amounts to apples and oranges. Nimmer's rebuttal applies most forcefully to the fourth fair use factor: "the effect of the use upon the potential market for or value of the copyrighted work."¹⁸⁵ This factor has been termed "undoubtedly the single most important element of fair use."¹⁸⁶ Its characterization as such has caused the lower courts,¹⁸⁷ and ultimately the Supreme Court, problems in application for which Professor Nimmer can be held partly to blame. The Supreme Court was citing to his treatise to support the statement.¹⁸⁸

The crux of Professor Nimmer's argument is that it is the effect on the *potential market* for the copied copyrighted work that is crucial; that the potential market includes derivative works that could be made, such as motion pictures, from his novel.¹⁸⁹ By ignoring Time Inc.'s interest in developing a motion picture based on the Zapruder film or any other potential uses for the film, Nimmer's argument maintains that Judge Wyatt gave short shrift to the fourth factor.¹⁹⁰

A question arises whenever the factors are found to be balanced. In *Time Inc.*, factors one and two appear to weigh for the defendants while factors three and four could weigh for the plaintiff. As Judge Leval puts it:

The factors do not represent a score card that promises victory to the winner of the majority. Rather, they direct courts to examine the issue from every pertinent corner and to ask in each case whether, and how powerfully, a finding of fair use would serve or disserve the objectives of copyright.¹⁹¹

Those objectives, as described earlier in *Feist*, are to "promote the Progress of Science and useful Arts," as the Constitution commands, by providing an incentive to authors to create new works.¹⁹²

¹⁸⁵ 17 U.S.C. § 107(4).

¹⁸⁶ *Harper & Row v. Nation Enters.*, 471 U.S. 539, 566 (1985).

¹⁸⁷ See Leval, *supra* note 160, at 1124-25.

¹⁸⁸ *Harper & Row*, 471 U.S. at 566 (citing 3 NIMMER, COPYRIGHT §13.05[A], at 13-76 (1984)). The Supreme Court's silence on this issue in *Campbell* has puzzled some courts. See *American Geophysical Union v. Texaco, Inc.*, 60 F.3d at 913, 926 (2d Cir. 1994).

¹⁸⁹ See Nimmer, *supra* note 11, at 1201; 17 U.S.C. § 106(2) (1988) (exclusive right to prepare derivative works); *supra* note 71.

¹⁹⁰ See Nimmer, *supra* note 11, at 1201.

¹⁹¹ Leval, *supra* note 160, at 1110-11; *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 576-78 (1994).

¹⁹² *Feist Publ'g, Inc. v. Rural Serv. Co., Inc.*, 499 U.S. 570 (1991) (quoting U.S. CONST. art. I, § 8, cl. 8); *supra* note 78; see also *Acuff-Rose*, 510 U.S. at 576-78; Leval, *supra* note 160, at 1100.

By keeping this in mind in the fair use balance, courts may find themselves with fact patterns like that of Nimmer's novel and *Time Inc.*'s Zapruder film that require very different results.

The court in *Time Inc.* looked to the legislative history of the fair use codification for guidance in its weighing of the factors. This is what it found:

Although the courts have considered and ruled upon the fair use doctrine over and over again, no real definition of the concept has ever emerged. Indeed, since *the doctrine is an equitable rule of reason*, no generally applicable definition is possible, and each case raising the question must be decided on its own facts. On the other hand, the courts have evolved a set of criteria which though in no sense definitive or determinative, provide some gauge for balancing the equities.¹⁹³

Those criteria became the four non-exclusive factors of § 107.¹⁹⁴ Judge Wyatt has been criticized for holding:¹⁹⁵ "[t]here is a public interest in having the fullest information available on the murder of President Kennedy. Thompson did serious work on the subject and has a theory entitled to public consideration."¹⁹⁶ Whether Judge Wyatt was adding an additional factor to the fair use balance, one of public interest, is unclear at best, but its use was not new.¹⁹⁷

The Supreme Court rejected a defense of public interest in *Harper & Row* as being so broad as to swallow the Copyright Act.¹⁹⁸ As discussed earlier, that argument borders on the specious.¹⁹⁹ It was also disingenuous as the Court and lower courts have applied

¹⁹³ *Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 145 (S.D.N.Y. 1968) (quoting H.R. REP. NO. 83, at 29-30 (1967)). Being part of the legislative history of the current Copyright Act, the Copyright Act of 1976, 17 U.S.C. §§ 101-810, has language which can be found at H.R. REP. NO. 94-1476, at 65.

¹⁹⁴ Judge Leval believes the four factors of § 107 are the only applicable ones and that any others are merely "false factors," tending to confuse the issue rather than being of any aid. See Leval, *supra* note 160, at 1125-30. However, what this suggests is that by codifying fair use into § 107, Congress froze the doctrine. It is doubtful Judge Leval intended to do the same with his article. Furthermore, it is apparent from the words of the statute itself, and from the legislative history, that the fair use doctrine was not meant to be frozen by codification.

[T]here is no disposition to freeze the doctrine in the statute, especially during a period of rapid technological change. Beyond a very broad statutory explanation of what fair use is and some of the criteria applicable to it, the courts must be free to adapt the doctrine to particular situations on a case-by-case basis.

H.R. REP. NO. 94-1476, at 65-66.

¹⁹⁵ See Nimmer, *supra* note 11, at 1201; Charles J. Sanders, *Twenty-Five Years of Photography: Fair Use and the 1st Amendment*, N.Y.L.J., Jan. 7, 1994, at 5.

¹⁹⁶ *Time Inc.*, 293 F. Supp. at 146.

¹⁹⁷ *Rosemont Enters., Inc. v. Random House*, 366 F.2d 303, 307 (2d Cir. 1966); see also *infra* note 199 and accompanying text and note 206.

¹⁹⁸ *Harper & Row v. Nation Enters.*, 471 U.S. 539, 559 (1985); *supra* note 117 and accompanying text.

¹⁹⁹ See *supra* notes 128-29 and accompanying text.

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an underlying public interest factor in their fair use analysis both before and since *Harper & Row*.²⁰⁰ The Court's reasoning displayed a fear that fair use would be used to deprive copyright holders of their exclusive rights "precisely when they encounter those users who could afford to pay."²⁰¹ The facts in *Time Inc.* show that the defendants were willing to pay more than the going price to use the Zapruder frames in their book that criticized the Warren Commission's conclusions.²⁰² In fact, the Supreme Court was fully cognizant that the First Amendment right to refrain from speaking underlying the Copyright Act might lead to abuses of the rights granted by Federal Copyright Law.²⁰³ The majority said: "[w]e do not suggest this right not to speak would sanction abuse of the copyright owner's monopoly as an instrument to suppress facts."²⁰⁴ As the *Time Inc.* case shows, the risk of enterprises accumulating copyrights, and then refusing access to them cannot be ignored.²⁰⁵ Professor Goldstein has noted: "[t]he statutory copyright monopoly tends generally to serve First Amendment values. The aggregation of statutory copyrights by a single holder threatens those values."²⁰⁶

²⁰⁰ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580-81 (1994) (fair use to be judged "case by case, in light of the ends of the copyright law"); *Fogerty v. Fantasy, Inc.*, 499 U.S. 517, 525-27 (1994) (copyright "must ultimately serve the public good") (emphasis added) (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984)); see also *Sony*, 464 U.S. at 454 ("[W]e acknowledged the public interest in making television broadcasting more available. Concededly, that interest is not unlimited. But it supports an interpretation of the concept of 'fair use' that requires the copyright holder to demonstrate some likelihood of harm before he may condemn a private act of time-shifting as a violation of federal law.") (emphasis added).

²⁰¹ *Harper & Row*, 471 U.S. at 559 (quoting Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the "Betamax" Case and its Predecessors*, 82 COLUM. L. REV. 1600, 1615 (1982)).

²⁰² *Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 138, 146 (S.D.N.Y. 1968).

²⁰³ See *Harper & Row*, 471 U.S. at 559; *supra* notes 123-24 and accompanying text.

²⁰⁴ *Harper & Row*, 471 U.S. at 559; *Practice Management Info. Corp. v. AMA*, 121 F.3d 516 (9th Cir. 1997); *Settlemyer*, *supra* note 26, at 2296, 2328 (ample evidence that large corporations often never release substantial amounts of copyrighted material after obtaining the rights to the works and arguing for a compulsory license for the authors affected); Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of "Authorship"*, 1991 DUKE L.J. 455, 497 (1991) (overprotection of copyright could lead to "a charter for private censorship").

²⁰⁵ See, e.g., *Settlemyer*, *supra* note 27; BEN H. BAGDIKIAN, *THE MEDIA MONOPOLY* (2d ed. 1987).

²⁰⁶ Goldstein, *supra* note 1, at 1035. Professor Goldstein referred to the phenomena as "enterprise monopoly," and believed that copyright law inadequately protected First Amendment interests where such accumulation of copyrights occurred. *Id.* at 1039. However, Goldstein believed that antitrust and communications law often offered sufficient protection against the risks of private censorship. *Id.* Nevertheless, he argued for a copyright misuse defense, more expansive than the one applied to patents, *id.* at 1045-47, and for increased regulation of copyright enterprise monopolies. *Id.* at 1050. Increased governmental regulation seems unlikely to occur anytime soon. Only recently have arguments for a copyright misuse defense been found acceptable by the lower federal courts. *Practice Management Info.*, 121 F.3d at 516 (copyright misuse). See, e.g., Thomas F. Smegal, Jr., *Mis-*

Thus, there is no reason why public interest cannot or currently is not a factor in a fair use defense or First Amendment privilege, particularly since the public interest lies at the heart of the First Amendment and copyright law.²⁰⁷ The Supreme Court's fears in *Harper & Row* were nothing but a restatement of the slippery slope, or floodgates, argument. What is the purpose of copyright, if not for the public benefit, as the Supreme Court has repeatedly stated and re-stated since *Harper & Row*.²⁰⁸

We have recognized the monopoly privileges that Congress has authorized, while "intended to motivate the creative activity of authors and inventors by the provision of a special reward," are limited in nature and *must ultimately serve the public good*.²⁰⁹

The reason why the "public interest" holding in *Time Inc.* has been so closely examined is that for some commentators, *Time Inc.* signaled the beginning of a First Amendment privilege in the area of copyright law,²¹⁰ an exception to the rule even Professor Nimmer believed should exist.²¹¹ Despite Judge Wyatt's avoidance of

use Defense Gains in Federal Courts, NAT'L L. J., Feb. 15, 1993, at 18; Note, *Clarifying the Copyright Misuse Defense: The Role of Antitrust Standards and First Amendment Values*, 104 HARV. L. REV. 1289 (1991).

One of the most egregious examples of "enterprise monopoly" abuse was found in *Rosemont Enterprise, Inc. v. Random House*, 366 F.2d 303 (2d Cir. 1966). In *Rosemont*, billionaire entrepreneur Howard Hughes, through Rosemont, a corporation he "dominated," *id.* at 312, systematically acquired the copyrights in various magazine articles written about him so as to sue to enjoin publication of an unauthorized biography which had partly relied on the articles. *Id.* at 312-13. Hughes lost when the court held the uses fair, *id.* at 307, but not before getting a preliminary injunction on the biography from the district court that was vacated by the Second Circuit's decision. *Id.* at 303. The court of appeals stated that "public interest in free dissemination of information [outweighs] . . . a copyright holder's interest in a maximum financial return." *Id.* at 307.

²⁰⁷ See *New York Times v. Sullivan Co.*, 376 U.S. 254, 270 (1964); *supra* note 33.

²⁰⁸ See *supra* note 79 and accompanying text.

²⁰⁹ *Fogerty v. Fantasy, Inc.*, 499 U.S. 517, 525-27 (1994) (emphasis added) (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984)).

²¹⁰ Denicola, *supra* note 11, at 299-300; cf. Nimmer, *supra* note 11, at 1200-04.

²¹¹ Professor Nimmer suggested that there might be cases in which idea and expression could not be separated, requiring appropriation of the expression as well. Nimmer, *supra* note 11, at 1202-03. Nimmer used the example of the My Lai photographs. *Id.* at 1203. He believed the "idea" of the massacre would require the copying of its expression in the photographs "because the idea cannot be conveyed unless the expression as well is copied." *Id.* He agreed that such copying was also required in *Time Inc.* *Id.* However, Nimmer would have required payment of a price for the copying, in the form of a compulsory license, limited to the area of news photographs, for the use made. *Id.* at 1199.

What is interesting about Professor Nimmer's proposal is its scope: he would not have limited it to situations where the photograph had already been published, but would have included unpublished newsworthy pictures. This goes much further in compelling speech than the case in *Time Inc.* where the frames had already been published in *Life* magazine. *Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 134 (S.D.N.Y. 1968). In fact, unless Congress overruled *Harper & Row's* holding on this issue in 1992, *supra* note 116 and accompanying text, *Harper & Row's* prohibition against appropriation of an unpublished work argues against the suggestion. *Harper & Row v. Nation Enters.*, 471 U.S. 539, 551

the First Amendment defense raised in *Time Inc.*, commentators chose to see the case as one that either could not survive a fair use analysis and thus argued for a First Amendment privilege,²¹² or as a case that created the privilege within the confines of the fair use doctrine.²¹³ During the 1970s, First Amendment defenses were increasingly raised by those challenged with suits for copyright infringement.²¹⁴ Many courts stated that such a defense might exist, but only one reported case from the era actually took the step to decide the controversy before it on such a theory. That case was *Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc.*²¹⁵

Triangle Publications arose out of a motion for a preliminary injunction²¹⁶ to stop the defendant from running a television advertisement that included a copy of the plaintiff's publication, the *TV Guide*, being compared with defendant's new *TV Book*, an insert included with its *Miami Herald* Sunday newspaper.²¹⁷ Almost rush-

(1985). Also of interest is the fact that a compulsory license would be inconsistent with Nimmer's own warnings:

I would suggest that a grave danger to copyright may lie in the failure to distinguish between the statutory privilege known as fair use and an emerging constitutional limitation on copyright contained in the first amendment. The scope and extent of fair use falls within the discretion of Congress. The limitations of the first amendment are imposed upon Congress itself. Fair use, when properly applied, is limited to copying by others which does not materially impair the marketability of the work which is copied. The first amendment privilege, when appropriate, may be invoked despite the fact that the marketability of the copied work is thereby impaired.

Nimmer, *supra* note 11, at 1200-01. A compulsory license within a First Amendment privilege would imply a tax on a constitutional right. That cannot have been Professor Nimmer's intent.

²¹² Nimmer, *supra* note 11, at 1200, 1202-03. See also Harry N. Rosenfield, *The Constitutional Dimensions of "Fair Use" in Copyright Law*, 50 NOTRE DAME L. REV. 790 (1975) (fair use doctrine is one of constitutionality under the First and Ninth Amendments); Rosenfield, *supra* note 11, at 295.

²¹³ Denicola, *supra* note 11, at 300.

²¹⁴ See, e.g., *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184 (5th Cir. 1979); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978); *Sid & Marty Kroff Television Prod., Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977); *Wainwright Sec., Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91 (2d Cir. 1977); *Meeropol v. Nizer*, 361 F. Supp. 1063 (S.D.N.Y. 1973), *aff'd*, 505 F.2d 232 (2d Cir. 1974); *Meeropol v. Nizer*, 417 F. Supp. 1201 (S.D.N.Y. 1976), *rev'd*, 560 F.2d 1061 (2d Cir. 1977). Most of these cases recognized that a First Amendment defense to copyright might exist, but not to the merits of the case at hand.

²¹⁵ 445 F. Supp. 875 (S.D. Fla. 1978), *aff'd on other grounds*, 626 F.2d 1171 (5th Cir. 1980).

²¹⁶ *Triangle Publications*, 445 F. Supp. at 876. The court, with the consent of the parties at the hearing, went on to decide the merits of a permanent injunction. *Id.*

²¹⁷ *Id.* at 877. The defendants had run other ads comparing the competing television listings books in its newspapers, on its vending machines, and in a second television advertisement. *Id.* at 876-77. Only one of the television commercials was before the court on the issue of the preliminary injunction. *Id.* at 877. Though somewhat unclear in its decision, the other ads appeared to be at issue in the request for a permanent injunction. *Id.* at 878. See also *Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 1171, 1172-73 (5th Cir. 1980).

ing to reach the First Amendment issue, and relying on Professor Nimmer's treatise for help to do so,²¹⁸ the court held that the commercial critiques made by the defendant of plaintiff's *TV Guide* were not the type of criticism the fair use doctrine was meant to protect.²¹⁹ Judge James Lawrence King of the Southern Florida Federal District Court took great pains to emphasize that the first factor of the fair use test demanded consideration of whether the alleged infringing use had a commercial purpose.²²⁰ Finding that the advertising in question had a definite commercial purpose,²²¹ the court ignored the other factors and proceeded to the First Amendment defense.²²²

Judge King seemed to find himself compelled to reach a First Amendment exception to the Copyright Act because of what, at the time, was new Supreme Court authority granting First Amendment protection to commercial speech.²²³ The court said, "[s]uch comparative advertising, when undertaken in the serious manner that defendant did herein, represents an important source of information for the education of consumers in a free enterprise system."²²⁴ The court felt that both the Copyright Act and the First Amendment "are oriented toward an atmosphere conducive to the interchange of ideas."²²⁵ Consequently, Judge King believed that

²¹⁸ *Triangle Publications*, 445 F. Supp. at 880. The court relied on this quotation from Nimmer's treatise:

The defense of fair use is most universally recognized in connection with the function of literary criticism. Here substantial passages may be quoted since clearly the review merely supplements but does not replace the function of the work being reviewed. Closely related is the recognition of the defense of fair use where defendant's work is used for scientific or historical or educational purposes. Nimmer, 2 Nimmer on Copyright § 145 (cit. omit.).

Id. at 880. By ignoring the transformative use of the plaintiff's *TV Guide* cover in the context of comparative advertising, the court managed to avoid any further fair use balancing. Such a rigid application of fair use was not called for. In *Harper & Row v. Nation Enters.*, 471 U.S. 539 (1985), the Supreme Court held that "[f]air use is a mixed question of law and fact." *Id.* at 560. If enough facts are established at the district court level to weigh the fair use factors, an appellate court can decide the fair use question as a matter of law. *Id.*

²¹⁹ *Triangle Publications*, 445 F. Supp. at 880.

²²⁰ *Id.* Even Judge Leval has implied that the first factor may have a range in its coverage going from the educational use to use in advertising. "Perhaps at the extreme of commercialism, such as advertising, the statute provides little tolerance for claims of fair use." Leval, *supra* note 160, at 1116 n.53.

²²¹ *Triangle Publications*, 445 F. Supp. at 880.

²²² *Id.* at 881.

²²³ *Id.* at 883 (citing *Bates v. Arizona*, 433 U.S. 350 (1977)).

²²⁴ *Id.*

²²⁵ *Id.* at 882. In fact, the court's description of the Copyright Act strengthens the argument that part of its function is regulatory of trade.

In essence, the Copyright Act, like the First Amendment itself, aims to insure that our society will continue to receive vital contributions from individuals who otherwise might be discouraged from doing so if the potential for reward was in jeopardy of usurpation by those more adept at packaging than creation . . . The Copyright Act seeks to diminish the threat posed by the person

allowing the First Amendment defense, instead of striking down the Copyright Act or the fair use section as unconstitutional, would be more in line with the purposes underlying federal copyright law and the First Amendment.²²⁶

It was exactly because the district court had placed so much emphasis on the commercial nature of the defendant's use as applied to the first fair use factor that the Fifth Circuit Court of Appeals found Judge King's fair use analysis erroneous.²²⁷ Citing to Nimmer,²²⁸ the panel found that the district court "established what amounts to virtually a per se rule that commercial motive destroys the defense of fair use. Clearly, § 107 makes commercial motive relevant to fair use analysis. But it is certainly not decisive."²²⁹ Instead, applying the four factors of section 107, a majority of the panel found defendant's copying to be a fair use, and affirmed without reaching the First Amendment question.²³⁰

To overcome the first factor's bias against commercial purpose, the panel found that "the advertisement was a comparative advertisement done in a manner which is generally accepted in the advertising industry."²³¹ In a footnote emphasizing the flexibility of the fair use doctrine, the court noted that "the *public interest* in comparative advertising is well-recognized," and went on to quote a Federal Trade Commission regulation for support.²³² As seen earlier, public interest in *Time Inc.* also seemed to sway the court there to find fair use.²³³ In an additional similarity to *Time Inc.*,²³⁴ the Fifth Circuit found that any commercial effect on the potential value of plaintiff's copyright would, at most, be de minimis, under the fourth fair use factor.²³⁵ Unlike *Time Inc.*, however, the court of appeals had the commentators on its side, citing three law re-

who can commercially release a copy of a creation more quickly than the creator.

Id.

²²⁶ *Id.* at 882-83, 884.

²²⁷ *Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 1171, 1175 n.11 (5th Cir. 1980). The situation of a court overemphasizing the commercial nature of the work into a presumption against fair use, was strikingly similar to that faced by the Supreme Court over a decade later in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

²²⁸ Professor Nimmer had joined the plaintiff as counsel on the appeal. *Campbell*, 510 U.S. at 575.

²²⁹ *Triangle Publications*, 626 F.2d at 1175.

²³⁰ *Id.* at 1178.

²³¹ *Id.* at 1176.

²³² *Id.* at 1176 n.13 (emphasis added).

²³³ *Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 146 (S.D.N.Y. 1968); *supra* note 195-97 and accompanying text.

²³⁴ 293 F. Supp. at 146.

²³⁵ *Triangle Publications*, 626 F.2d at 1177.

view articles criticizing the district court's fair use holding.²³⁶

In an odd twist that the Fifth Circuit panel attempted to de-emphasize, the writer of the panel's decision also entered a dissent.²³⁷ Judge John R. Brown felt the court should have taken the extra step of holding the district court's First Amendment defense as erroneous on the merits.²³⁸ It was Judge Brown's view "that the First Amendment will rarely prevail over a copyright interest."²³⁹ Judge Tate, in a concurrence, stated:

[T]o illustrate my difference with the dissent on this issue, if fair use did *not* protect the defendant's use of the copyrighted cover, then I would agree completely with the district court, for the reasons expressed in his opinion, that the First Amendment prevented the plaintiff from enjoining reproduction of the cover.²⁴⁰

The concurrence went on to say that it did not believe the First Amendment and copyright conflict was before it and chose to leave that determination to another day.²⁴¹

The solicitude voiced by Judge Brown and Judge Tate implicitly shows two sides of the balance struck by federal copyright law. The first is the risk of providing too little copyright protection. Judge Brown recited the following from *Dallas Cowboys Cheerleaders v. Scoreboard Posters*,²⁴² to make his point: "[t]he first amendment is not a license to trammel on legally recognized rights in intellectual property."²⁴³ The second is the risk in having too much protection of expression in the Copyright Act. Judge Tate showed that concern when he said: "[i]n my view, under limited circumstances, a First Amendment privilege *should* exist where utilization of the copyrighted expression is necessary for the purpose of conveying thoughts or expression."²⁴⁴

What is sometimes forgotten in this debate is that the district court's First Amendment holding was never overruled. Whatever value it may hold as precedent may be questioned, divorced as it is

²³⁶ *Id.* at 1177-78 (quoting Denicola, *supra* note 11, at 305-06; Note, *Copyright Infringement and the First Amendment*, 79 COLUM. L. REV. 320, 327-28 (1979); Case Note, *Copyright and the First Amendment—Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc.*, 1979 Wis. L. REV. 242, 262 (1979)).

²³⁷ *Triangle Publications*, 626 F.2d at 1178 n.17.

²³⁸ *Id.* at 1182.

²³⁹ *Id.*

²⁴⁰ *Id.* at 1184.

²⁴¹ *Id.*

²⁴² 600 F.2d 1184 (5th Cir. 1979).

²⁴³ *Triangle Publications*, 626 F.2d at 1180 (quoting *Dallas Cowboys Cheerleaders*, 600 F.2d at 1188).

²⁴⁴ *Triangle Publications*, 626 F.2d at 1184.

from the fair use determination which made it superfluous to the Fifth Circuit panel on appeal. The importance of the holding is the concept of the First Amendment defense/privilege to federal copyright law that the Fifth Circuit sustained by not overruling the district court's holding. As if history were destined to repeat and correct itself, on June 11, 1993, a federal district court in California, in the unreported *Holliday v. Cable News Network*,²⁴⁵ was the first known court since *Triangle Publications* to hold the First Amendment as a defense to a claim of copyright infringement.²⁴⁶ The case, reminiscent of *Time Inc.*, in that it dealt with what can be considered this generation's version of the Zapruder film, involved the videotape showing the beating of Rodney King by Los Angeles Police Department officers. George Holliday had taped the beating and granted an unlimited license for its use, ("and to let other broadcasters use" the videotape), to television station K.T.L.A. in Los Angeles.²⁴⁷ In a suit to recover for copyright infringement from CNN, ABC, CBS, and NBC for their broadcasts of the tape, Judge Irving Hill of the Central District Federal Court of California granted summary judgment to the defendants finding their broadcasts to be fair uses as well as protected by the First Amendment.²⁴⁸ Judge Hill even invited the Ninth Circuit Court of Appeals to review the case.²⁴⁹ Referring to Nimmer's My Lai hypothetical proposing a possible First Amendment exception,²⁵⁰ Judge Hill described the videotape before him as one which, "in terms of national interest and democratic dialogue, may be as important or even more important than My Lai."²⁵¹ But Judge Hill limited his exception, somewhat in agreement with Nimmer, to only "exceptional" situations "where words cannot serve the democratic [process]."²⁵²

Holliday may be the beginning of the end of *Harper & Row's* misguided influence on a First Amendment defense to copyright infringement. Although limited to "exceptional" cases, the rise of the Internet may show that such cases could become far more com-

²⁴⁵ N.Y.L.J., Jan. 21, 1994, at 5, (C.D. Cal. June 11, 1993).

²⁴⁶ *Id.*

²⁴⁷ *Holliday*, N.Y.L.J., Jan. 21, 1994, at 5.

²⁴⁸ *Id.*

²⁴⁹ *Id.* Holliday did file an appeal, but the case was settled and the appeal dismissed on June 9, 1994. Leslie Ann Reis, Note, *The Rodney King Beating—Beyond Fair Use: A Broadcaster's Right to Air Copyrighted Videotape as Part of a Newscast*, 13 J. MARSHALL J. COMPUTER & INFO. L. 269, 311 n.23 (1995). *But see* Los Angeles News Serv. v. Reuters Television Int'l Ltd., No. CV-95 1073-KMW 1996 U.S. LEXIS 13582 (C.D. Cal., July 23, 1996).

²⁵⁰ See Nimmer, *supra* note 11, at 1203; *supra* note 211.

²⁵¹ *Holliday*, N.Y.L.J., Jan 21, 1994, at 5.

²⁵² *Id.*

mon as the ability to share information easily proliferates in cyberspace.

IV. NETCOM AND COPYRIGHT ON THE INTERNET

One judge has said of the Internet:

It is no exaggeration to conclude that the Internet has achieved, and continues to achieve, the most participatory marketplace of mass speech that this country—and indeed the world—has yet seen. The plaintiffs in these actions correctly describe the “democratizing” effects of Internet communication: individual citizens of limited means can speak to a worldwide audience on issues of concern to them. . . . [As such it] deserves the broadest possible protection²⁵³

A later court remarking on the Internet stated:

The range of tools and forums available for users of interactive computer services is astounding: with access to the web of computer networks known as the Internet, a scholar can contact a distant computer and make use of its capabilities; a researcher can peruse the card catalogues of libraries across the globe; users around the world can debate politics, sports, music, and literature. However trivial some of their uses might seem, emerging media technologies quite simply offer an unprecedented number of individual citizens an opportunity to speak and to be heard—at very little cost—by audiences around the world. In that sense, *we are encountering a communications medium unlike any we have ever known.*²⁵⁴

Thus, to some, the potential of the Internet for democratic discourse is lauded in nearly utopian terms.²⁵⁵ To others, including certain other branches of the U.S. government,²⁵⁶ the risks inherent in the Internet for infringement of copyright would require that responsibility be placed on providers of Internet services to

²⁵³ *ACLU v. Reno*, 929 F. Supp. 824, 881 (E.D. Pa. 1996) (Dalzell, Dist. J.). See also, *Reno v. ACLU*, 117 S. Ct. 2329, 2344 (1997) (“[O]ur cases provide no basis for qualifying the level of First Amendment scrutiny that should be applied to this medium.”).

²⁵⁴ *Shea v. Reno*, 930 F. Supp. 916, 922 (S.D.N.Y. 1996) (emphasis added) *aff’d without opinion*, 117 S. Ct. 2501 (1997).

²⁵⁵ See Niva Elkin-Koren, *Cyberlaw and Social Changes: A Democratic Approach to Copyright Law in Cyberspace*, 14 *CARDOZO ARTS & ENT. L.J.* 215 (1996); NICHOLAS NEGROPONTE, *BEING DIGITAL* (1995). See also Chris Hedges, *Serb’s Answer to Oppression: Their Web Site*, *N.Y. TIMES*, Dec. 8, 1996, at A1 (on use of the Internet to overcome Serbian government’s attempts to stifle Serbian press).

²⁵⁶ INFORMATION INFRASTRUCTURE TASK FORCE, *INTELLECTUAL PROPERTY AND THE NATIONAL INFORMATION INFRASTRUCTURE: THE REPORT OF THE WORKING GROUP ON INTELLECTUAL PROPERTY RIGHTS* 117 (1995) [hereinafter *WHITE PAPER*].

police and possibly be strictly liable²⁵⁷ for the infringements of their users.²⁵⁸ In other words, because Internet service providers ("ISPs") have the technological "ability" to monitor how their users make use of the Internet, and since their services "aid" users to make and disseminate unauthorized copies of copyrighted materials on the Internet, ISPs should be legally responsible for such conduct. This approach therefore differs somewhat from the situations presented in Parts II and III because a strict liability rule focuses less on knowing copiers than on treating ISPs as if they were copiers and publishers of infringing materials.

On the other hand, the issues remain remarkably similar. Institutionally and historically, copyright law has tended to concentrate the distribution of copyrighted materials into the hands of a few, be it the press, publishers,²⁵⁹ entertainment conglomerates²⁶⁰ or the media of broadcasting, cable and, increasingly, satellite.²⁶¹ These copyright industries are very powerful and are increasing their influence on government policy.²⁶² A copyright rule for an Internet service provider who has or takes editorial control over the material it redistributes has tremendous implications for privacy rights and the First Amendment.²⁶³ The attempt to reshape an essentially decentralizing,²⁶⁴ and never before encountered²⁶⁵ medium into traditional centralized modes of distribution is not

²⁵⁷ Strict liability is liability without fault, i.e. without intent to do harm and/or where there is no duty to act or refrain from acting. See W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 75, at 534-38 (5th ed. 1984). The Copyright Act is a strict liability statute because it does not require a showing that the defendant(s) intended to infringe another's copyright. 17 U.S.C. § 501 (1988).

²⁵⁸ WHITE PAPER, *supra* note 256, at 117.

²⁵⁹ Professor Negroponte, among others, has advanced that "copyright law is totally out of date. It is a Gutenberg artifact. Since it is a reactive process, it will probably have to break down completely before it is corrected." NEGROPONTE, *supra* note 254, at 58. See also Elkin-Koren, *supra* note 12, at 401-02; Sarah Lyall, *Publishing: To Avoid Future Shocks, Publishers and Authors are Fighting for the Electronic Rights to Books*, N.Y. TIMES, Mar. 24, 1994, at D6.

²⁶⁰ See, e.g., Bagdikian, *supra* note 204.

²⁶¹ See Philip Shenon, *Ideas & Trends; A Repressed World Says, 'Beam Me Up'*, N.Y. TIMES, Sept. 11, 1994, at E4.

²⁶² See Denise Caruso, *Global Debate Over Treaties on Copyright*, N.Y. TIMES, Dec. 16, 1996, at D1, D6. Professor Pamela Samuelson has termed the approach taken by the *White Paper* as a "Copyright Grab" by these industries. Pamela Samuelson, *The Copyright Grab*, WIRED, Jan. 1996, at 191. See also James Boyle, *Sold Out*, N.Y. TIMES, Mar. 31, 1996, at E15.

²⁶³ See Elkin-Koren, *supra* note 12, at 384, 398-99. On the privacy issues involved in information gathering on the Internet, see A. Michael Froomkin, *Flood Control on the Information Ocean: Living with Anonymity, Digital Cash, and Distributed Databases*, 15 J.L. & COM. 395, 479-91 (1996).

²⁶⁴ *Reno v. ACLU*, 117 S. Ct. 2329, 2336 (1997); A. Michael Froomkin, *The Internet as a Source of Regulatory Arbitrage, I. B. Decentralized Standard Setting, in BORDERS IN CYBERSPACE* (Brian Kahin & Charles Nesson eds., forthcoming 1996; David G. Post, *Anarchy, State, and the Internet: An Essay on Law-Making in Cyberspace*, 1995 J. ONLINE L. art. 3, paras. 33, 36, 38; Elkin-Koren, *supra* note 255, at 217; NEGROPONTE, *supra* note 255, at 229.

²⁶⁵ *Shea v. Reno*, 930 F. Supp. 916, 922 (S.D.N.Y. 1996).

new to copyright law.²⁶⁶ If the potential of the Internet to turn everyone into a "publisher" is stifled by governmental pressures to assert control over cyberspace²⁶⁷ by using such an outdated model, its impact on freedom of speech must be understood.

One federal district court decided that a rule of strict liability was unworkable for Internet service providers, who are the closest figures the Internet has to the publishers and distributors that copyright law has more traditionally encountered. Contradicting two other federal district courts faced with similar questions,²⁶⁸ in *Netcom*,²⁶⁹ Judge Ronald A. Whyte decided that: "[a]lthough copyright is a strict liability statute, there should still be some element of volition or causation which is lacking where a defendant's system is merely used to create a copy by a third party."²⁷⁰ Because the ISP and BBS defendants had not undertaken any "affirmative action that directly resulted in copying,"²⁷¹ they could not be held strictly liable for a third defendant's copyright infringement.²⁷²

²⁶⁶ See *supra* notes 42-50 and accompanying text.

²⁶⁷ For a particularly egregious example of governmental overreaction to asserted illegal activity conducted through a bulletin board service ("BBS") devoted to computer games, see *Steve Jackson Games, Inc. v. United States Secret Service*, 816 F. Supp. 432 (W.D. Tex. 1993), *aff'd*, 36 F.3d 457 (5th Cir. 1994).

²⁶⁸ *Sega Enters. Ltd. v. MAPHIA*, 857 F. Supp. 679 (N.D. Cal. 1994); *Playboy Enters. v. Frena*, 839 F. Supp. 1552 (M.D. Fla. 1993); see *infra* note 304.

²⁶⁹ 907 F. Supp. 1361 (N.D. Cal. 1995).

²⁷⁰ *Netcom*, 907 F. Supp. at 1370.

²⁷¹ *Id.* at 1368.

²⁷² *Id.* at 1372-73.

Generally speaking, an ISP is a computer service that provides its customers with the means of connecting to the Internet. A BBS is also a computer service, but information access is usually limited to what is available on the BBS's computer(s). Examples of (searchable) BBSs well known to lawyers are Lexis/Nexis and Westlaw. Some BBSs have begun offering their users access to the Internet thereby making the lines between different types of providers fluid. The *Netcom* Court sometimes seems lost in its inability to explain some of these important technical aspects of the case. For example, the court quotes numerous definitions of the Internet. One of these defines the Internet as "a collection of thousands of local, regional, and global Internet Protocol networks." *Id.* at 1365 n.2 (quoting David Bruning, *Along the InfoBahn*, 23 *ASTRONOMY*, June 1996, no. 6, at 76). However, the court then neglects to explain what Internet Protocol networks are, or mention that the definition ignores Transmission Control Protocol.

A network is two or more computers that are linked together and able to communicate with each other. The Internet, as the court's definition explains, is made up of numerous networks. The Internet itself is nothing more than a giant network using certain protocols. Internet Protocol ("IP") is needed for transferring information between computers without first having to connect to the other computer; while Transmission Control Protocol ("TCP") is needed when connection is required. These TCP/IP protocols are "the language that Internet-connected computers must speak" in order to transfer information between each other. Richard Wiggins, *How the Internet Works*, *INTERNET WORLD*, Oct. 1996, at 60. This is as centralized as the Internet gets. How the information actually travels on the Internet is part of what makes the Internet a unique decentralized medium.

Information is transported between the networked computers on the Internet through a system called "packet switching." All information or messages sent on the Internet is broken into small packets. These packets are labeled with information specifying where they are to be sent and in which order they are to be assembled. Routers along the

The plaintiffs in *Netcom*, Religious Technology Center and Bridge Publications, Inc., were the holders of certain copyrights in works by L. Ron Hubbard, the founder of the Church of Scientology (together "the Church").²⁷³ The defendants were the ISP, Netcom On-Line Communications, Inc. ("Netcom"); the BBS, run by Thomas Klemesrud; and Dennis Erlich.²⁷⁴ Erlich had once been a Church minister but had since, as the court put it, "turned vocal critic of the Church."²⁷⁵ When Erlich posted some of the Church's materials on Klemesrud's BBS, which Netcom made available on the Internet to the Usenet newsgroup "alt.religion.scientology,"²⁷⁶ the Church sued all three for copyright infringement.²⁷⁷ The court had already granted the Church's

wire and wireless paths of the Internet have the task of routing these packets to their assigned destination. Obviously, the most efficient way to route a message will often be the shortest link between the computers involved. However, if the traffic is heavy along one or more routes, the router can send the packets through many different routes to their destination. The whole process can take less than a second, even for messages coming from other countries. *Id.* at 55-56.

Thus, the *Netcom* Court's sometime "black box" mentality of explaining the Internet and its workings can lead to a lack of understanding of the decentralized and often automatic methods by which information travels through the Internet. It is usually at this point that one makes obligatory mention of the fact that the Internet was created during the Cold War to survive a nuclear war and was designed to circumvent blockage. If certain paths through which messages were routed fell, the system would know to follow a different route, to get the messages to their destination. See Charles McGrath, *The Internet's Arrested Development*, N.Y. TIMES MAGAZINE, Dec 8, 1996, at 85. For an excellent, although more legalistic description of the Internet's workings, see *Shea v. Reno*, 930 F. Supp. 916, 925-30 (S.D.N.Y. 1996).

²⁷³ *Netcom*, 907 F. Supp. at 1365.

²⁷⁴ *Id.* at 1365-66.

²⁷⁵ *Id.* at 1365.

²⁷⁶ *Id.* The court's description of Usenet is confusing at best. The panel in *Shea* gives a better indication of Usenet's workings:

Internet users may also transmit or receive "articles" posted daily to thousands of discussion groups, arranged by subject matter and known as "newsgroups," available through an electronic bulletin-board system known as "Usenet." When a user with access to a Usenet server—that is, a computer participating in the Usenet system—posts an article to a particular newsgroup, the server automatically forwards the article to adjacent Usenet servers, which in turn forward it to other servers, until the article is available on all Usenet sites that furnish access to the newsgroup in question. Once a message reaches a particular Usenet site, it is temporarily stored there so that individual users—running client software, known as a "newsreader," capable of sorting articles according to header information identifying the newsgroup to which the article was posted—can review and respond to the message.

Reno, 930 F. Supp. at 927-28 (citations omitted).

²⁷⁷ *Netcom*, 907 F. Supp. at 1362, 1368. The Church also brought a claim of misappropriation of trade secrets against Erlich. *Id.* at 1366 n.5. In a decision filed one week later on a different suit by the Church, Judge Brinkema of the Eastern District Federal District Court of Virginia stated:

[T]he Court finds that the motivation of plaintiff [the Church] in filing this lawsuit against The [Washington] Post is reprehensible. Although the RTC brought the complaint under traditional secular concepts of copyright and trade secret law, it has become clear that a much broader motivation prevailed-

request for a preliminary injunction against Erlich on the copyright claims in a prior order,²⁷⁸ and was proceeding to decide certain motions for summary judgment brought by Netcom, for a judgment on the pleadings brought by Klemesrud, and a request by the Church for a preliminary injunction against Netcom and Klemesrud.²⁷⁹

Judge Whyte organized his decision on the basis of the asserted types of copyright claims brought by the Church against Netcom and the BBS (direct copying, contributory infringement, and vicarious liability), and the defenses raised thereto of fair use and the First Amendment. A close examination of the decision can help uncover and pinpoint some of the important First Amendment and copyright concerns raised by the Internet which seemed to exert considerable influence on the court.

1. Direct Infringement

The court first explained how "copies" of the Church's works were made by the BBS and ISP and thereby made available on the Internet at the "alt.religion.scientology" Usenet area by Erlich. Erlich would connect to Klemesrud's BBS using his computer, a modem and telephone line. Klemesrud's BBS would briefly store a copy of Erlich's messages on the BBS's computer while the BBS would connect to the Internet and forward the message to the chosen Usenet area via Netcom. Netcom's computers would automatically copy Erlich's messages from the BBS's computer and make them publicly available from the Usenet area for almost anyone having a connection to the Internet.²⁸⁰ Understanding the technical requirements involved in posting Erlich's messages is important, because Erlich's copies of the Church's works were copied onto Klemesrud's and Netcom's computers before actually being available for viewing (and further copying) by others having access to Usenet on the Internet. Thus, on the question of direct infringement, the Church argued that the copies made by Netcom's

—the stifling of criticism and dissent of the religious practices of Scientology and the destruction of its opponents.

Religious Tech. Ctr. v. Lerma, 908 F. Supp. 1362 (E.D. Va. 1995). For reviews of the Church of Scientology's use of copyright infringement suits to prevent criticism of its religious movement, see Mark Fearer, *Scientology's Secrets*, INTERNET WORLD, Dec. 1995, at 76; Mike Allen, *Dissidents Use Computer Network to Rile Scientology*, N.Y. TIMES, Aug. 14, 1995, at A12. For a listing of some prior reported decisions of Church of Scientology cases, see *supra* note 133.

²⁷⁸ 907 F. Supp. at 1365 n.3.

²⁷⁹ *Id.* at 1366.

²⁸⁰ *Id.* at 1367.

and Klemesrud's computers infringed its copyrights.²⁸¹ As noted above, the court rejected this argument.²⁸²

Judge Whyte reasoned that if the Church's theory for liability were accepted, it "would create many separate acts of infringement and, carried to its natural extreme, would lead to unreasonable liability."²⁸³ This unreasonable liability would extend to not just the defendant BBS and ISP involved in the litigation, but also to "every single Usenet server in the worldwide link of computers transmitting Erlich's message to every other computer."²⁸⁴ This is because all these servers would need to make and maintain a copy of Erlich's postings on their computers as well. Although not cited, the court's reasoning resembles that in the famous case of *Palsgraf v. Long Island Railroad Co.*, where liability for a tort was limited to harm proximately caused by a defendant to foreseeable plaintiffs.²⁸⁵ With copyright liability sometimes being viewed as a form of tort liability,²⁸⁶ introduction of such a stringent proximate causation requirement in copyright law where the Internet is concerned might seem appropriate. However, the court goes beyond this reasoning to require instead "some element of volition or causation" by BBSs and ISPs, without explaining what level of volition or causation is needed for copyright liability to attach.²⁸⁷

In effect, Judge Whyte may have done exactly what he was attempting not to do: rewritten the Copyright Act. In a footnote, he addressed the argument put forward by Netcom that it should be treated as a common carrier because it is "a passive conduit for information," much like a telephone company.²⁸⁸ However, because common carriers are statutorily exempt from liability and since the Copyright Act has no such exemption for BBSs and ISPs,²⁸⁹ Judge Whyte believed any new exemption was for Congress

²⁸¹ *Id.* at 1369.

²⁸² See *supra* notes 271-72 and accompanying text.

²⁸³ *Netcom*, 907 F. Supp. at 1369.

²⁸⁴ *Id.* See *supra* note 276.

²⁸⁵ *Palsgraf v. Long Island R.R. Co.*, 162 N.E. 99 (N.Y. 1928) (Cardozo, J.).

²⁸⁶ See *KEETON ET AL.*, *supra* note 257, § 130, at 1020.

²⁸⁷ *Netcom*, 907 F. Supp. at 1370.

²⁸⁸ *Id.* at 1369 n.12.

²⁸⁹ In fact, the Communications Decency Act of 1996, part of the Telecommunications Act of 1996, makes clear that in spite of its "Good Samaritan Blocking and Screening of Offensive Material" provision in Section 509(c): "Nothing in this section shall be construed to limit or expand any law pertaining to intellectual property." Telecommunications Act of 1996, Pub. L. No. 104-104, § 509(d)(2), 110 Stat. 137. However, by encouraging "interactive computer services" to screen messages from their users for "obscene, lewd, lascivious, filthy, excessively violent, harassing, or otherwise objectionable, whether or not such materials is constitutionally protected," *id.* § 509(c)(2)(A), the government's supposed intent to overrule *Stratton Oakmont, Inc. v. Prodigy Services Co.*, 1995 WL 323710 (N.Y. Sup. Ct. May 24, 1995) (unreported decision), an unpublished lower court decision, comes across more as a

to provide and not the courts.²⁹⁰ Given the government's interest in the question of liability for ISPs in its *White Paper on "Intellectual Property and the National Information Infrastructure,"*²⁹¹ it is not surprising that the court preferred not to explicitly create such an exemption, especially where it is foreseeable that Congress might act on the issue.²⁹² Perhaps the addition of volition into the Copyright Act for direct infringement is a desirable result given that most copying implies some type of action. What makes the Internet different is that now, because of the way the technology works, it is possible for unintentional copying to occur.²⁹³

The Clinton Administration's *White Paper* is a presence felt throughout *Netcom*. The court is often at pains to distinguish its reasoning from that presented in the *White Paper*. One example is the question of "browsing." Generally, browsing is the act of viewing materials from other computers being accessed on the Internet. Because browsing involves the making of a temporary copy of the accessed materials in the memory of the user's computer, a few courts have held that such temporary copies may infringe copyright.²⁹⁴ The *White Paper* puts forward the position that in light of these cases, browsing may constitute copyright infringement by Internet users.²⁹⁵ One of those cases, *MAI Systems Corp. v. Peak Computer, Inc.*,²⁹⁶ was a Ninth Circuit Court of Appeals decision that Judge Whyte found "controlling."²⁹⁷ The court felt forced to distinguish *MAI Systems* in order to decide that *Netcom* and *Klemes-*

disingenuous attempt to hide the true reach of the provision: allowing a centralized form of third party censorship with the government's approval. If such censorship cannot be done directly, there is no reason why this overbroad and vague rule should not be held unconstitutional. See *Shea v. Reno*, 930 F. Supp. 916 (S.D.N.Y. 1996); *ACLU v. Reno*, 929 F. Supp. 824 (E.D. Pa. 1996).

²⁹⁰ *Netcom*, 907 F. Supp. at 1370 n.12.

²⁹¹ WHITE PAPER, *supra* note 256.

²⁹² *Id.* app., at 1. On-Line Copyright Liability Limitation Act, H.R. 2180, 105th Cong. (1997) (proposed legislation that would limit the liability of ISPs); *infra* note 342.

²⁹³ *Netcom*, 907 F. Supp. at 1367 (Netcom's computers would automatically store messages forwarded from Klemesrud's BBS). See *supra* notes 272, 276. An every day example for many Internet users is electronic mail (e-mail). When e-mail messages are accessed through the Internet, a copy is automatically made in the recipient's computer. These messages, like letters received in the mail, are protected by copyright law. The copyright belongs to the author of the letter. 17 U.S.C. §§ 102(a), 106 (1988). See *Salinger v. Random House Inc.*, 811 F.2d 90 (2d Cir. 1987); *supra* note 133. Additionally, unauthorized redistribution of e-mail, a frequent occurrence, could constitute copyright infringement.

²⁹⁴ See WHITE PAPER, *supra* note 256, at 64-65. These courts seem to have ignored the legislative history to the Copyright Act of 1976 which states: "fixation" would exclude from the concept purely evanescent or transient reproductions such as those projected briefly on a screen, shown electronically on a television or other cathode ray tube, or captured momentarily in the 'memory' of a computer." H.R. REP. NO. 94-1476, at 54 (1976).

²⁹⁵ WHITE PAPER, *supra* note 256, at 65 n.203.

²⁹⁶ 991 F.2d 511 (9th Cir. 1993).

²⁹⁷ *Netcom*, 907 F. Supp. at 1367.

rud were not liable for direct infringement of the Church's copyrights.²⁹⁸ It is this attempt to distinguish the harsh rule of *MAI Systems* that led the court to circumvent the Copyright Act's strict liability by imposing an "element of volition or causation" by Netcom and the BBS before infringement would occur.²⁹⁹ The *MAI Systems* case and its progeny have been severely criticized and may not be the law outside the Ninth Circuit.³⁰⁰ The government's reliance on the case in its *White Paper*, which even criticizes *MAI Systems* for its fair use holding,³⁰¹ has not escaped notice and has been viewed as an attempt, if not to rewrite, then at least to influence, the development of copyright law.³⁰²

Netcom's rejection of the *White Paper's* point of view and *MAI Systems* would give Internet users a reason to breathe a sigh of relief were it not for the fact that it flies in the face of copyright liability rules. If *MAI Systems* is read as an incorrect application of copyright law in contradiction of congressional intent,³⁰³ there is no reason to believe that the "transitory copying" by Netcom and Klemesrud of eleven and three days respectively, require the same result of no infringement. The *Netcom* court had to contend with two other federal district court cases finding infringement, one of them in its own district, before it could find Netcom and Klemesrud not directly liable for copyright infringement.³⁰⁴ Although *Netcom's* holding is indirectly protective of the First Amendment rights of ISPs,

²⁹⁸ *Id.* at 1368.

²⁹⁹ The court states:

Netcom correctly distinguishes MAI on the ground that Netcom did not take any affirmative action that directly resulted in copying plaintiffs' works other than by installing and maintaining a system whereby software automatically forwards messages received from subscribers onto the Usenet, and temporarily stores copies on its system.

Id. at 1368. The temporary storage of messages noted by the court lasted for 11 days for messages posted to Usenet for Netcom and three days for Klemesrud's BBS. *Id.* at 1367.

³⁰⁰ Samuelson, *supra* note 262, at 137; WHITE PAPER, *supra* note 256, at 64-65.

³⁰¹ WHITE PAPER, *supra* note 256, at 65 n.204.

³⁰² Samuelson, *supra* note 262, at 137; Pamela Samuelson, *Intellectual Property Rights and the Global Information Economy*, 39 COMM. A.C.M., Jan. 1996, no. 1, at 23.

³⁰³ See *supra* note 294.

³⁰⁴ *Sega Enters. Ltd. v. MAPHIA*, 857 F. Supp. 679 (N.D. Cal. 1994); *Playboy Enters. v. Frena*, 839 F. Supp. 1552 (M.D. Fla. 1993). On motion, the court granted a preliminary injunction to Sega against a BBS for offering and encouraging the uploading and downloading of Sega's copyrighted and trademarked video games on the BBS's system. The court held that the defendants would likely be found to have directly and contributorily infringed Sega's copyrights and relied on *MAI Systems* and *Frena* for its holding. *MAPHIA*, 857 F. Supp. at 686-87. In *Frena*, on a motion for summary judgment, a BBS was held directly liable for the unauthorized public distribution and display of Playboy's copyrighted pictures on its system. *Frena*, 839 F. Supp. at 1556-57. Defendants in both cases made fair use arguments that were rejected. *MAPHIA*, 857 F. Supp. at 687-88; *Frena*, 839 F. Supp. at 1557-58. See Elkin-Koren, *supra* note 12, for review and criticism of these two cases.

BBSs, and Internet users, and instead of introducing questionable doctrine into copyright law which Congress can always change,³⁰⁵ the court would have better served freedom of speech by taking the opportunity presented to use the First Amendment as a bar to strict liability for ISPs and BBSs.

2. First Amendment and Fair Use.

Unfortunately, Judge Whyte was not willing to go quite that far. Netcom argued that if the Church's theory of liability were accepted, "it would chill the use of the Internet because every access provider or user would be subject to liability when a user posts an infringing work to a Usenet newsgroup."³⁰⁶ In response, the court recited traditional concepts of the idea/expression dichotomy and the fair use defense as balancing the First Amendment and copyright interests.³⁰⁷ Furthermore, since the court was unwilling to hold the defendants directly liable for their copying, and since any form of secondary liability would require the defendants to have "knowledge and participation or control and direct profit" before infringement from their copying could be found,³⁰⁸ any risks of a chill on the First Amendment were not present in the case.³⁰⁹ In fact, in its holding the court implied that a First Amendment problem might exist if it were otherwise. "[I]f usenet servers were responsible for screening all messages coming through their systems, this could have a chilling effect on what some say may turn out to be the best public forum for free speech yet devised."³¹⁰

In a convoluted footnote amounting to dicta, the court gave further reasons why First Amendment interests would not likely be implicated where copyrighted works are disseminated by ISPs and BBSs. Addressing the question of browsing, however, the court appeared to contradict itself:

The temporary copying involved in browsing is only necessary because humans cannot otherwise perceive digital information. *It is the functional equivalent of reading, which does not implicate the copyright laws* and may be done by anyone in a library without the permission of the copyright owner. However, it can be argued that the effects of digital browsing are different because millions can browse a single copy of a work in cyberspace, while only one

³⁰⁵ See *infra* note 342; *supra* note 293.

³⁰⁶ Religious Tech. Ctr. v. Netcom On-Line Comm. Servs., Inc., 907 F. Supp. 1361, 1377 (N.D. Cal. 1995).

³⁰⁷ *Id.* See *supra* Parts II, III.

³⁰⁸ *Netcom*, 907 F. Supp. at 1377; see *infra* Part IV.

³⁰⁹ *Netcom*, 907 F. Supp. at 1377.

³¹⁰ *Id.* at 1377-78.

can read a library's copy at a time. Absent a commercial or profit-depriving use, digital browsing is probably fair use; Until reading a work online becomes as easy and convenient as reading a paperback, copyright owners do not have much to fear from digital browsing and there will not likely be much market effect.³¹¹

The quotation is partly a misreading of the "first sale doctrine" and should be assumed to apply a fair use defense only if that doctrine is not applicable. Generally, the first sale doctrine of the Copyright Act exempts from infringement any further distribution of a copy of a work once that lawfully authorized copy has been sold.³¹² This is why libraries can lend books to the public. They purchase a lawful copy and can distribute it as they please. Thus, the court's assertion that copyright is not implicated in browsing is misleading and correct only to the extent that the copies browsed are lawfully obtained. Erlich's posting of the Church's materials on Usenet, the court had preliminarily held, was probably not lawful under the first sale doctrine.³¹³ At that point, a fair use argument would arise for the browsing by other users of the works Erlich had made available on the Internet.

The court makes two other points in a footnote that merit discussion. The broad statement that browsers would have an innocent infringer defense mostly affects works created before March 1, 1989, as the Church's works presumably were,³¹⁴ and ignores the fact that the defense is severely limited.³¹⁵ Second, the court notes that as a "practical matter," copyright owners may not be able to prove, or choose to sue, for infringement for the browsing of their works.³¹⁶ The fact that this does not prevent such suits, as the *Netcom* case itself should indicate, or bar copyright owners from threatening suit and using its *in terrorem* effect in a way that also chills free speech, evidences some shortsightedness. One should not underestimate the impact on speech from cease and desist letters sent by lawyers, and other controversies that are never litigated and/or reported.

In the end, for undisclosed reasons, *Netcom* admitted that the "First Amendment argument is merely a consideration in the fair use argument . . ." ³¹⁷ which left the court partly off the hook on the

³¹¹ *Id.* at 1378 n.25 (emphasis added).

³¹² 17 U.S.C. § 109 (1988).

³¹³ *Netcom*, 907 F. Supp. at 1365 n.3.

³¹⁴ *Id.* at 1378 n.25.

³¹⁵ 17 U.S.C. §§ 405(b), 504(c)(2) (1988).

³¹⁶ *Netcom*, 907 F. Supp. at 1378 n.25.

³¹⁷ *Id.* at 1378.

First Amendment question. Addressing the fair use defense, the court made clear that it was Netcom's and, though not discussed, probably also Klemesrud's actions that were the focus of the analysis, and not those of Erlich.³¹⁸ Erlich's use had already been found to be most likely unfair.³¹⁹ However, because the Church had placed Netcom on notice regarding Erlich's postings and could have prevented the further dissemination of the Church's works on the Internet, the court found "a genuine issue as to the possibility that Erlich's postings, made available over the Internet by Netcom, could hurt the market for plaintiff's works."³²⁰ Therefore, despite the court's leniency on the other fair use factors, Judge Whyte ruled against Netcom on its motion for summary judgment on its fair use defense.³²¹ Nevertheless, the court recited "First Amendment concerns" in denying injunctive relief for the Church, holding that it was not likely to succeed on its copyright claims against Netcom or Klemesrud.³²² "Netcom and Klemesrud play a vital role in the speech of their users. Requiring them to pre-screen postings for possible infringement would chill their users' speech."³²³ Judge Whyte thus made explicit what his earlier discussion of Netcom's First Amendment defense had left implicit:³²⁴ that the First Amendment can act as a bar to copyright infringement claims.³²⁵

4. Contributory Infringement and Vicarious Liability

The district court was faced with two other arguments in support of copyright infringement: contributory infringement and vicarious liability. The fact that the court allowed the Church to proceed on the contributory infringement claim again shows the influence of First Amendment concerns in Judge Whyte's opinion. The court first reveals this concern in a footnote which compared strict copyright liability with the liability of a BBS for defamation.³²⁶ Citing two New York cases, *Cubby, Inc. v. CompuServe, Inc.*³²⁷ and *Stratton Oakmont, Inc. v. Prodigy Services Co.*,³²⁸ the court stated:

³¹⁸ *Id.*

³¹⁹ *Id.*

³²⁰ *Id.* at 1380.

³²¹ *Id.* at 1381.

³²² *Id.* at 1383.

³²³ *Id.*

³²⁴ See *supra* notes 309-10 and accompanying text.

³²⁵ *Netcom*, 907 F. Supp. at 1383. The First Amendment concerns raised by the court were in the context of the Church's request for a broad preliminary injunction which the court feared would result in a "prior restraint" on the ISP's and BBS's speech. *Id.*; see *supra* note 33.

³²⁶ *Netcom*, 907 F. Supp. at 1367 n.10.

³²⁷ 776 F. Supp. 135 (S.D.N.Y. 1991).

³²⁸ 1995 WL 323710 (N.Y. Sup. Ct. May 24, 1995). See also *infra* note 342.

Recent decisions have held that where a BBS exercised little control over the content of the material on its service, it was more like a "distributor" than a "republisher" and was thus only liable for defamation on its system where it knew or should have known of the defamatory statements.³²⁹

The court then went on to hold, as noted above,³³⁰ that the ISP and BBS could not be directly liable for their copying.

However, by holding that the ISP and BBS could be contributorily liable, Judge Whyte was following the *Cubby* approach. *Cubby* teaches that "[t]he requirement that a distributor must have knowledge of the contents of a publication before liability can be imposed for distributing that publication is deeply rooted in the First Amendment."³³¹ Quoting from the U.S. Supreme Court's opinion in *Smith v. California*,³³² District Judge Leisure of the Southern District of New York held:

"[T]he constitutional guarantees of the freedom of speech and of the press stand in the way of imposing" strict liability on distributors for the contents of the reading materials they carry. . . .

"[T]he bookseller's burden [to make himself aware of the contents of every book in his shop] would become the public's burden, for by restricting him the public's access to reading matter would be restricted. If the contents of bookshops and periodical stands were restricted to material of which their proprietors had made an inspection, they might be depleted indeed."³³³

Cubby applied the same defamation rule to a BBS. *Netcom*, by eliminating the strict liability of copyright law for BBSs and ISPs, appears to have transposed the rule and its First Amendment concerns to the Internet.

Netcom thus requires that before an ISP or BBS can be held liable for the copyright infringement of its users, it must know of and substantially participate in the copyright infringement.³³⁴ This is the doctrine of contributory liability. Alternatively, a BBS or ISP can be vicariously liable for its users' infringement if "it has the right and ability to supervise the conduct of its subscribers" and

³²⁹ *Netcom*, 907 F. Supp. at 1367 n.10.

³³⁰ See *supra* Part IV.

³³¹ *Cubby*, 776 F. Supp. at 139.

³³² 361 U.S. 147 (1959).

³³³ *Cubby*, 776 F. Supp. at 139-40 (quoting *Smith*, 361 U.S. at 152-53).

³³⁴ *Netcom*, 907 F. Supp. at 1373 (citing *Gershwin Publ'g Corp. v. Columbia Artists Management*, 443 F.2d 1159, 1162 (2d Cir. 1971)). For one argument in support of such a rule for the Internet, see Giorgio Bovenzi, *The Liabilities of System Operators on the Internet*, 11 BERKELEY TECH. L.J. 93, 139-40 (1996).

obtains "direct financial benefit" from the infringement.³³⁵ Since the Church was unable to show that Netcom or Klemesrud directly benefitted financially from Erlich's postings of alleged infringing materials,³³⁶ in spite of evidence of some control,³³⁷ the court granted their motions for summary judgment and judgment on the pleadings respectively.³³⁸

Obviously, if construed too loosely, contributory copyright infringement can be as much of a snare and concern for BBSs, ISPs, and other Internet servers and users, as strict copyright liability can be to the First Amendment. *Netcom* appears to leave ISPs and BBSs some room to maneuver, but it may not be enough. Although rejecting Netcom's argument that infringement by its users must be unequivocally shown before ISPs are required to act on notice received from a copyright owner of infringement of its work(s), the court showed itself amenable to the difficulties that ISPs and BBSs could face if required to police and determine what uses are infringements:

The court is more persuaded by the argument that it is beyond the ability of a BBS operator to quickly and fairly determine when a use is not infringement where there is at least a colorable claim of fair use. Where a BBS operator cannot reasonably verify a claim of infringement, either because of a possible fair use defense, the lack of copyright notices on the copies, or the copyright holder's failure to provide the necessary documentation to show that there is a likely infringement, the operator's lack of knowledge will be found reasonable and there will be no liability for contributory infringement for allowing the continued distribution of the works on its system.³³⁹

It is too soon to tell whether this is sufficient protection given to the Internet, the First Amendment, and copyright, or whether other courts will follow *Netcom* given its strained reading of the Copyright Act's strict liability. Elimination of strict liability for ISPs, as *Netcom* shows, would be a first step toward addressing First Amendment concerns. However, if Congress fails to act in this area by amending the Copyright Act to take the First Amendment

³³⁵ *Netcom*, 907 F. Supp. at 1375-76, 1382.

³³⁶ *Id.* at 1377, 1382.

³³⁷ *Id.* at 1375-76, 1382.

³³⁸ *Id.* at 1377, 1382. The court allowed the Church 30 days to amend its complaint on the vicarious liability claim against Klemesrud if it could do so in good faith. *Id.* at 1382. The BBS and ISP eventually settled their claims against the Church, leaving Erlich as the sole remaining defendant. See *Klemesrud Press Release* (visited Aug 22, 1996) <http://www.eff.org/pub/Legal/Cases/Scientology_cases/960822_klemesrud_settle.announce>.

³³⁹ *Netcom*, 907 F. Supp. at 1374.

into consideration on the Internet, possibly by codifying the *Netcom* decision,³⁴⁰ courts will continue to face what are admittedly unprecedented difficulties raised by the public forum called the Internet.

One positive development has been the Supreme Court's decision in *Reno v. ACLU*.³⁴¹ The nearly unanimous Court held that the Internet, as a medium, was entitled to the highest level of protection, such as that enjoyed by newspapers.³⁴² The case involved the constitutionality of certain provisions inserted in the Telecommunications Act of 1996. Those provisions, part of what was called the Communications Decency Act of 1996 ("CDA"), would have made it unlawful to transmit content that is "indecent" or "depict[ed] or describe[d], in terms patently offensive as measured by contemporary community standards, sexual or excretory activities or organs" to minors under the age of eighteen (together, the "indecency sections").³⁴³ Justice John Paul Stevens' opinion stated that the effect of the indecency sections was to "suppress . . . a large amount of speech that adults have a constitutional right to receive and to address to one another."³⁴⁴ As the concurrence and partial dissent by Justice O'Donnell states, "the only way for a speaker to avoid liability under the CDA is to refrain completely from using indecent speech," which "reduc[e]s the adult population [on the Internet] to reading only what is fit for children."³⁴⁵

Strict copyright liability imposes a similar type of constraint on every ISP in this country for the copyright infringement of its users as the indecency sections of the CDA did in *Reno*. The scenarios may be factually distinct, but the results are the same. Police your users or risk unlimited liability (i.e. get out of business). And the issue does not stop with strict liability. If ISPs do not discontinue subscribers discovered to be distributing infringing materials over the Internet, they might be liable for their subscribers' activities. If they ignore what their subscribers send over the Internet and re-

³⁴⁰ The WHITE PAPER, *supra* note 256, defeated copyright legislation, *infra* note 342, and events at the International level, Caruso, *supra* note 262, appear to show a current unwillingness in the Clinton administration and Congress to follow such a route. *But see supra* note 291. In fact, the Clinton administration is accused of attempting to circumvent significant Congressional scrutiny by obtaining increased copyright protection through new international copyright treaties. Caruso, *supra* note 262, at D6. *See also*, Stephen Fraser, *The Copyright Battle: Emerging International Rules and Roadblocks on the Global Information Infrastructure*, 15 J. MARSHALL J. OF COMPUTER & INFO. L. 759 (1997).

³⁴¹ *Reno v. ACLU*, 117 S. Ct. 2329 (1997).

³⁴² *Id.* at 2343-44.

³⁴³ Telecommunications Act of 1996, Pub. L. No. 104-104, Title V, § 502, 110 Stat. 133 (current version at 47 U.S.C.A. §§ 223(a) & 223(d) (Supp. 1997)).

³⁴⁴ *Reno*, 117 S. Ct. at 2346.

³⁴⁵ *Id.* at 2354.

spect the privacy of those subscribers, they may still be in violation of the law for willfully ignoring such transmissions which, under the law, may be equated with knowledge. Finally, if ISPs screen user transmissions, users lose their right to privacy and may refrain from using the Internet altogether. None of these alternatives are acceptable—resulting in conflicts between copyright law and the First Amendment.

IV. CONCLUSION

The problem of copyright law on the Internet thus appears to have reached a crossroad. If strict copyright liability is imposed on Internet servers as the government's *White Paper* proposes and the Copyright Act appears to impose, the chill on the speech made possible by the Internet is palpable.³⁴⁶ If Congress insists on asserting control in a centralizing manner that is inconsistent with the structure of the Internet,³⁴⁷ the First Amendment concerns are subtler because copyright law is a creature suited to a system where works must pass through some editorial intermediary before being disseminated to the public. The Internet allows circumvention of this historical/institutional construct and makes those with access to its networks contributors to a new public forum.

But the problems do not start with the Internet. The conflict between copyright and the First Amendment has been brewing since their beginnings and was aggravated by the Supreme Court's decision in *Harper & Row*.³⁴⁸ The main problem has been trying to find a proper balance for copyright protection without putting sufficient weight on the concerns evinced by the First Amendment. The *White Paper* states that the Copyright Act is merely in need of a

³⁴⁶ See *Religious Tech. Ctr. v. Netcom On-Line Communications. Servs., Inc.*, 907 F. Supp. 1361, 1377-78, 1382 (N.D. Cal. 1995).

³⁴⁷ See Elkin-Koren, *supra* note 255. Based in part on proposals included in the *White Paper*, *supra* note 256 app., at 1, bills were introduced in Congress to amend the Copyright Act. H.R. 2441/S. 1284, 104th Cong., 1st Sess. (1995). During the process of "marking up" (making changes) to the bills in committee, several proposals for giving Internet service providers an exemption or limitation from strict liability were proposed. The legislation had not been enacted and was left in committee when the 104th Congress adjourned for the 1996 elections. One major reason cited for the failure of the legislation is the opposition raised by ISPs and telephone companies wishing to offer Internet services, to some of the bills' provisions. See Carey R. Ramos & Carl W. Hampe, "Mere Conduit" Exemption Stirs Debate, N.Y.L.J., Sept. 30, 1996, at S1.

Although beyond the scope of this article, for other evidence of the Clinton Administration's centralizing policies for the Internet, see, in regards to "encryption" (encryption makes viewing materials extremely difficult without the "key" to breaking the encrypted message's code), John Markoff, *A Compromise on Encryption Exports Seems to Unravel*, N.Y. TIMES, Dec. 6, 1996, at D1; Communications Decency Act of 1996, Pub. L. No. 104-104, §§ 509(c)-(d), 110 Stat. 137 (prescreening of messages).

³⁴⁸ *Supra* Parts II, III.

fine tuning.³⁴⁹ The proposals put forth by the *White Paper* would be better viewed as an overhaul; one intended to keep a strong engine for traditional centralized copyright industries instead of the real purveyors of information the First Amendment is meant to encourage and which the Internet now makes possible on a global scale: all of us.

Of course "all of us" does not include those who do not have access to the Internet.³⁵⁰ Maybe that divide will be conquered swiftly as technology spreads, or slowly, as governments begin to realize what impact the Internet will have on copyright laws and freedom of speech and other issues of sovereignty.

Either way, the time has come for courts to begin allowing First Amendment defenses against copyright infringement suits in situations other than the exceptional ones of the Kennedy assassination, the Rodney King beating, and, *sub silentio*, the ISP and BBS in *Netcom*. Taken together, since *Time Inc.*,³⁵¹ the lower federal courts have begun to establish standards for such a defense/privilege: a requirement of some public interest in the copyrighted work; a necessity for access to the work, especially where the copyright holder attempts to withdraw the work from the public or exact absurd demands for its dissemination; or a risk of unreasonable liability for unknowing and automatic distributors of infringing works. Certainly, other factors exist, likely depending on the context in which a controversy may arise.

The argument for bringing a First Amendment privilege outside of the confines of the fair use doctrine is that the purposes of the Copyright Act, although alleged to act as the engine of the First Amendment,³⁵² do not always coincide with the basis underlying the First Amendment.³⁵³ Furthermore, maintaining the First Amendment privilege within the fair use doctrine leaves the impression that the interests found in the *Bill of Rights* can be balanced away every time the price to copyright holders is too high. For those situations that are bound to arise as we approach the technological reality of what Marshall McLuhan called the Global Village, the free marketplace of ideas on the Internet and other-

³⁴⁹ WHITE PAPER, *supra* note 256, at 17.

³⁵⁰ Steve Lohr, *A Nation Ponders its Growing Digital Divide*, N.Y. TIMES, Oct. 21, 1996, at D5.

³⁵¹ *Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130 (S.D.N.Y. 1968); *supra* Part III.

³⁵² *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985); *supra* notes 118, 126-27 and accompanying text.

³⁵³ And as many commentators have noted, none better than Professor Nimmer, copyright is a creature of Congress; the First Amendment was created to limit Congress. See Nimmer, *supra* note 11, at 1200-01; *supra* note 210.

wise becomes even more important. Protection of the freedom of speech from overzealous courts, Congress, and copyright holders must be assured. An independent First Amendment privilege outside the copyright fair use doctrine is a necessary step in that direction.