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THE DEFENSE OF "FAIR USE": A PRIMER

*Alan J. Hartnick**

The law in our society should act as a barrier or marker to direct appropriate discourse and behavior. Yet, when the law is so unclear or interpreted so diversely, the existence of such a law may be weakened in its effect. Such is the case with the current state of the decisional law as related to the defense of fair use and its application in the area of copyright infringement.¹

When one holds a copyright, it is some degree of assurance that the copyrighted work will not be utilized without one's express permission.² However, the fair use doctrine allows for a certain degree of unauthorized use without the consent of the copyright holder and thus limits the exclusivity granted by the copyright.³

What defines "fair use" is unclear at best and appears to be defined by the particular judge in a particular case. Such *ad hoc* application has seemingly frustrated the true intent of the doctrine and has resulted in much uncertainty in this area of the law.⁴ The federal copyright statute has been seen as an attempt to provide courts with useful standards by which to decide these cases by setting forth exemplary purposes where fair use may be applied, and by describing certain factors for assessing whether a use is indeed "fair."⁵

Judicial interpretation of these purposes and factors has been unpredictable. Because the statutory language is illustrative and not exclusive, the application of "fair use" has made for tumultuous terrain.⁶

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¹ See generally *Fisher v. Dees*, 794 F.2d 432, 436 (9th Cir. 1986); but see *American Geophysical Union v. Texaco, Inc.*, 60 F.3d 913 (2d Cir. 1995).

² See *infra* note 9 and accompanying text.

³ 2 P. GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE 187 (1989).

⁴ H.R. REP. NO. 94-1476, at 65 (1976), reprinted in 1976 U.S.C.C.A.N. [hereinafter H.R. REP.].

⁵ See *infra* note 9 and accompanying text.

⁶ See *infra* note 9 and accompanying text.

This article is presented as a primer on the defense of “fair use” in copyright infringement cases. It discusses in great detail the statutory background of the defense, setting forth the dual guidelines for application of the fair use doctrine. Finally, this article will also discuss the new law with respect to Internet treaties signed in Geneva in December of 1996. Congress has decided that the rights of the copyright owner in cyberspace are limited by this defense.⁷

Before one can opine as to the possibility that “fair use” does or does not apply, one needs some grounding in the law as it has developed.

STATUTORY BACKGROUND

Under the current copyright statute, Title 17 of the United States Code, copyright, which is an intangible property interest, exists as a matter of law from the moment that a work is “fixed in any tangible medium of expression.”⁸ This property right is held by the author or creator of a work or, in the case of works made for hire, by the employer who contracts for creation of the work.⁹ The

⁷ See *infra* notes 135-145 and accompanying text.

⁸ 17 U.S.C. § 102 (1995). Section 102 provides in pertinent part: “Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” *Id.*

⁹ 17 U.S.C. § 107 (1995). Section 107 provides in pertinent part:

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 of the use in relation to the

holder of the copyright interest in a work is entitled to exclusive use, including the right of reproduction of the work for the duration of the copyright and may license its use and reproduction by others.¹⁰

Intellectual property issues arise whenever materials are reproduced without the consent of the copyright holder.¹¹

copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors."

Id.

¹⁰ 17 U.S.C. § 106 (1995). Section 106 provides in pertinent part:

[T]he owner of copyright under this title had the exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies and 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.

Id.

¹¹ 17 U.S.C. § 501 (1995). Section 501 provides in pertinent part:

Infringement of copyright (a) Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 118 or of the author as provided by section 106(a), or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright or right of the author, as the case may be . . .

Id.

FAIR USE

Under certain circumstances, works under copyright, or portions thereof, may be used without the permission of the copyright holder.¹² Such use is termed “fair use” and is addressed by the current copyright statute at Section 107 of the Copyright Act of 1976.¹³ It is a judge made rule whose theoretical basis is the implied consent of the copyright owner so as to permit a critic to quote literally.

Fair use is “a privilege in others than the owner of a copyright to use the copyrighted material in a reasonable manner without [the owner’s] consent, notwithstanding the monopoly granted to the owner by the copyright.”¹⁴ Fair use operates to limit the exclusive rights of copyright holders, which are granted by the statute.¹⁵

“Fair use,” however, is a term without a clear definition. The House of Representatives Report, which accompanied the Copyright Act of 1976, observed that the fair use doctrine is “an equitable rule of reason,” or a judge-made category, and, as such, is not susceptible of any “generally applicable definition.”¹⁶ The result is that all determinations are *ad hoc*.¹⁷ There really are no rules of thumb. All evaluations are fact specific.

The fair use doctrine became an explicit part of the United States copyright statute upon adoption of the 1976 Copyright Act.¹⁸ The House Report observes that the “claim that a defendant’s acts constituted a fair use rather than an infringement has been raised as a defense in innumerable (sic) copyright actions over the years, and

¹² 17 U.S.C. §§ 107-112 (1995).

¹³ See *supra* note 9 and accompanying text.

¹⁴ 2 P. GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE 187 (1989) (citing H. BALL, THE LAW OF COPYRIGHT AND LITERARY PROPERTY 260 (1944)); see also *Harper and Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 549 (1985).

¹⁵ See *supra* note 9 and accompanying text.

¹⁶ See H.R. REP., *supra* note 4, at 65.

¹⁷ *Id.* at 66 (reasoning that 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).

¹⁸ See *supra* note 9 and accompanying text.

there is ample case law recognizing the existence of the doctrine and applying it.”¹⁹

Hitchcock’s *Rear Window* was deemed to have infringed on a copyrighted story.²⁰ The Supreme Court found the infringement to be a “classic example of an unfair use: a commercial use of a fictional story that adversely affects the story owner’s adaptation rights.”²¹ Of course, motion pictures and literature are not the only areas²² where a fair use defense is asserted. The Supreme Court found in favor of the fair use defense in the parodic version of Roy Orbison’s *Pretty Woman*.²³ The Court analyzed all four factors set forth in section 107²⁴ of the Copyright Act and found that all supported the fair use defense.²⁵ Two appellate courts conducted the same analysis, both finding against the fair use defense.²⁶ Other examples: the Second Circuit found the publication of excerpts from the *Seinfeld* television show to be an infringement of the copyright owned by Castle Rock Entertainment.²⁷ The Ninth Circuit found the copying and selling of the copyrighted broadcast of the Reginald Denny beating to be an infringement.²⁸ It is not

¹⁹ H.R. REP., at 65.

²⁰ See *Stewart v. Abend*, 495 U.S. 207 (1990).

²¹ *Id.* at 238.

²² 17 U.S.C. § 102(a). Section 102(a) provides in pertinent part: “Works of authorship include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.” *Id.*

²³ See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). See also, *Fisher v. Dees*, 794 F.2d 432 (9th Cir. 1986) (finding the parody of the song *When Sonny Gets Blue* to be fair use).

²⁴ See *supra* note 9 and accompanying text.

²⁵ *Campbell*, 510 U.S. at 594.

²⁶ *Castle Rock Entertainment, Inc. v. Carol Publishing Group, Inc.*, 150 F.3d 132 (2d Cir. 1998) (denying fair use defense for a published trivia book with quotes and references to the television show *Seinfeld*); *Los Angeles News Service v. Reuters Television International, Ltd.*, 149 F.3d 987 (9th Cir. 1998) (finding infringement of a newsbroadcast of the beating of Reginald Denny during the riots in Los Angeles which was copied and later re-broadcast).

²⁷ *Castle Rock*, 150 F.3d at 146.

²⁸ *Los Angeles News Service*, 149 F.3d 987, 992 (9th Cir. 1998).

necessary that all four factors weigh in favor of one party for victory. The court conducts the analysis and makes a conclusion based on an aggregate assessment of the factors.²⁹

Fair use is a mixed question of law and fact and, therefore, the application of the doctrine and of Section 107 must be made on a case-by-case basis.³⁰ This case-by-case review tends to result in an unpredictable application depending on the facts of each case. The flexibility of the fair use defense means that there are no bright lines.

SOME EXAMPLES

To continue with examples, before we begin our primer:

In *Fisher v. Dees*,³¹ the Ninth Circuit held that a parody of Marvin Fisher's "When Sonny Gets Blue" was considered fair use.³² Similarly, the Seventh Circuit allowed a fair use defense in *Eisenschiml v. Fawcett Publications*³³ where an author used practically exact quotations from Otto Eisenschiml's works.³⁴

Parody is a type of permitted use considered fair.³⁵ Rick Dees, a disc jockey, created a parody of Marvin Fisher's *When Sonny Gets Blue*.³⁶ Dees' work was entitled *When Sonny Sniffs Glue* and was included with a host of other parodied works in an album entitled *Put It Where the Moon Don't Shine*.³⁷ Dees requested permission from Fisher prior to publishing the parody, but was denied.³⁸ The Ninth Circuit noted that a denied request does not necessarily result

²⁹ *Castle Rock*, 150 F.3d at 146.

³⁰ See *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 560 (1985). See also *Fisher v. Dees*, 794 F.2d 432, 436 (9th Cir. 1986); *Eisenschiml v. Fawcett Publications, Inc.*, 246 F.2d 598 (7th Cir. 1957).

³¹ 794 F.2d 432 (9th Cir. 1986).

³² *Id.* at 440.

³³ 246 F.2d 598 (7th Cir. 1957).

³⁴ *Id.* at 601.

³⁵ See *Fisher*, 794 F.2d at 435.

³⁶ *Id.* at 434.

³⁷ *Id.*

³⁸ *Id.*

in a copyright infringement when the author publishes anyway.³⁹ Additionally, the court recognized that requests to parody one's work would likely be denied.⁴⁰ As such, considering Dees' publication a copyright infringement merely because his request was rebuffed would undermine the parody example of "fair use."⁴¹

In this case, Dees copied approximately sixteen percent of Fisher's music,⁴² specifically to conjure up the original for the purpose of the parody.⁴³ The specific work at issue is approximately 1/80th of the total on the album.⁴⁴ Because the Code specifies the "amount and substantiality of the portion used in relation to the copyrighted work as a whole"⁴⁵ as one of the factors in determining fair use, it is necessary for the court to analyze both the purpose and amount of the use.⁴⁶ Previous cases identified a "conjure up" test⁴⁷ whereby any amount greater than what is necessary to "conjure up" the original is considered an infringement.⁴⁸ The *Fisher* court specifically rejected this view as too rigid, noting: "The concept of 'conjuring up' an original came into the copyright law not as a limitation on how much of an original may be used, but as a recognition that a parody frequently needs to be more than a fleeting evocation of an original in order to make its humorous point."⁴⁹

Recognizing this baseline, the court continued to identify three considerations in determining whether the use of copyrighted

³⁹ *Id.* at 437. The court specifically found that penalizing Dees for publishing despite failure to obtain permission from Fisher would "penalize him for a modest show of consideration . . . [and the court] refuse[d] to discourage [such requests]." *Id.*

⁴⁰ *Id.*

⁴¹ *Id.*

⁴² *Id.* at 434.

⁴³ *Id.* at 438.

⁴⁴ *Id.* at 434.

⁴⁵ See 17 U.S.C. § 107 (1995).

⁴⁶ *Fisher*, 794 F.2d at 439.

⁴⁷ *Walt Disney Productions v. Air Pirates*, 581 F.2d 751, 757 (9th Cir. 1978).

⁴⁸ *Fisher*, 794 F.2d at 438.

⁴⁹ *Id.* at 438-39. (quoting *Elsmere Music, Inc., v. National Broadcasting Co.*, 623 F.2d 252 (2d Cir. 1980)).

material is to be considered excessive:⁵⁰ “(1) the degree of public recognition of the original work, (2) the ease of conjuring up the original work in the chosen medium, and (3) the focus of the parody.”⁵¹ In utilizing these factors, the court concluded that Dees’ use of Fisher’s work is entitled to a “fair use” defense.⁵²

Similarly, but in a different context, the *Eisenschiml* court concluded that Joseph John Millard’s use of excerpts from Otto Eisenschiml’s work was a fair use.⁵³ Otto Eisenschiml was a noted authority on Civil War history who specifically focused on the Lincoln assassination.⁵⁴ Because of the limited nature of his specialty, a researcher doing a piece on this subject would likely come across his work.⁵⁵

In analyzing whether the challenged work was an infringement, the court compared sections of the challenged work with sections of the Eisenschiml work.⁵⁶ Millard’s own testimony revealed that there was a similarity to their work.⁵⁷ The court noted that Millard used material from Eisenschiml’s research; however, the test is not whether the research was independent, but “whether the one charged with the infringement has made an independent production, or made a substantial and unfair use of the complainant’s work.”⁵⁸ Using this test, the court found that the use of Eisenschiml’s work was fair.⁵⁹

⁵⁰ *Id.* at 439.

⁵¹ See also *Air Pirates*, 581 F.2d at 757-58.

⁵² *Fisher*, 794 F.2d at 440. The Court stated “[w]e conclude that *When Sonny Sniffs Glue* is a parody deserving of fair-use protection as a matter of law.” *Id.*

⁵³ *Eisenschiml v. Fawcett Publications*, 246 F.2d 598, 603 (7th Cir. 1957).

⁵⁴ *Id.* at 600.

⁵⁵ *Id.* at 604.

⁵⁶ *Id.* at 601.

⁵⁷ *Id.* at 602.

⁵⁸ *Id.* at 603. (quoting *Nutt v. National Institute, Inc.*, 31 F.2d 236, 237 (2d Cir. 1929)).

⁵⁹ *Id.* at 604.

THE PRIMER

In 1985, Justice O'Connor, considering "fair use" in the circumstances of the nonpermissive publication by *The Nation* of excerpts from former President Ford's memoirs, wrote that "copyright is intended to increase and not to impede the harvest of knowledge," but that the "rights conferred by copyright are designed to assure contributors to the store of knowledge a fair return for their labors."⁶⁰

Justice O'Connor's statement reflects the bedrock of the fair use doctrine which is that the fair use exception to the copyright monopoly is designed for the greater good and not for individual profit.⁶¹ For this reason, fair use protection is not liberally accorded unlicensed use of copyrighted materials by profit-making ventures.⁶²

TWO GUIDES

Section 107 bears out the above-stated principle that there is no strict definition of "fair use." The statute steers clear of providing any definition whatsoever. Instead, Section 107 offers two rough guides for application of the fair use doctrine, and the guides are interrelated.⁶³ The first guide is a list of six exemplary purposes for which copyrighted material may be used without benefit of a license.⁶⁴ The second is a set of four non-exclusive factors to be

⁶⁰ *Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539, 545-46 (1985).

⁶¹ *Id.* See also *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

⁶² Compare *Castle Rock v. Carol Publishing*, 150 F.3d 132 (2d Cir. 1998) (holding that the commercial use of *Seinfeld* television program material not entitled to fair use defense), and *Los Angeles News Service v. Reuters*, 149 F.3d 987 (9th Cir. 1998) (holding rebroadcast of Reginald Denny beating not entitled to fair use defense), and *Stewart v. Abend*, 495 U.S. 207 (1990) (holding movie production of Hitchcock's *Rear Window* not entitled to fair use defense), with *Campbell v. Acuff-Rose*, 510 U.S. 569 (1994) (holding that parodic version of song was entitled to fair use defense).

⁶³ See *supra* note 9 and accompanying text.

⁶⁴ See *supra* note 9 and accompanying text.

considered in each case of unlicensed use, but without limitation, and including the six exemplary purposes.⁶⁵

(A) Exemplary Purposes

The first sentence of Section 107 identifies six specific purposes, which may bring unlicensed use, including reproduction, of copyrighted material under the rubric of "fair use."⁶⁶ Those six purposes are "criticism, comment, news reporting, teaching . . . scholarship, or research."⁶⁷ This list is suggestive and not exclusive.

The list of exemplary permissible purposes is amplified somewhat by the House Report, which gives clearance to:

quotation of excerpts in a review or criticism for purposes of illustration or comment, quotation of short passages in scholarly or technical work, for illustration or clarification of the author's observations; use in a parody of some of the content of the work parodied; summary of an address or article, with brief quotations, in a news report; reproduction by a library of a portion of a work to replace part of a damaged copy; reproduction by a teacher or student of a small part of a work to illustrate a lesson; reproduction of a work in legislative or judicial proceedings or reports; incidental and fortuitous reproduction, in a newsreel or broadcast, of a work located in the scene of an event being reported.⁶⁸

Most of the uses described in the House Report relate to noncommercial activity, and particularly to education, scholarship and the maintenance of archives.⁶⁹ The examples relating to newspapers and broadcasting are certainly related to commercial

⁶⁵ See *supra* note 9 and accompanying text.

⁶⁶ See *supra* note 9 and accompanying text.

⁶⁷ See *supra* note 9 and accompanying text.

⁶⁸ H.R.REP., at 65.

⁶⁹ *Id.*

activity, especially the commercial activity of large corporations; but the commercial activity of journalism has, for the most part, been distinguished (though sometimes with difficulty) from the entertainment industry and has been rationalized, whether or not with justification, as a peculiarly high-minded enterprise. Essentially, there is a difference between editorial and advertising use. Editorial use has more fair use leeway.

(B) The Four Factors

The second sentence of Section 107 provides four factors to be weighed by courts in determining whether particular uses are “fair.”⁷⁰ These four factors, like the categories in the first sentence of the section, are non-exclusive and courts are free to take other factors into consideration.

The four “factors to be considered” are:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit 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 work⁷¹

(1) Purpose of the Use

The first factor (i.e., purpose) sets up the explicit contrast between “commercial purpose” and nonprofit educational purpose.⁷²

Much has been made of the commercial-noncommercial distinction. Clearly educational purposes are favored; and, it used to be thought that commercial purposes are presumptively not

⁷⁰ See *supra* note 9 and accompanying text.

⁷¹ See *supra* note 9 and accompanying text.

⁷² See *supra* note 9 and accompanying text.

permissible in a fair use analysis.⁷³ It is nevertheless axiomatic that the existence of a commercial purpose does not absolutely prevent an unlicensed use being "fair."⁷⁴ In a famous pronouncement, the Ninth Circuit has said that, even "assuming that the use had a purely commercial purpose, the presumption of unfairness can be rebutted by the characteristics of its use."⁷⁵ In *Campbell v. Acuff-Rose Music, Inc.*,⁷⁶ discussed below, the Court held that there was no such presumption.⁷⁷

In fact, public policy may well suggest that the determining factor in the "fairness" of a use is not the question of a profit motive but the actual or likely benefit that the use may provide to society.⁷⁸

In the context of biographical writing, the Second Circuit has recognized that a profit-making enterprise may be entitled to broad, unlicensed use of copyrighted material. In *Rosemont Enterprises, Inc. v. Random House, Inc.*,⁷⁹ the Court wrote:

Whether an author or publisher reaps economic benefits from the sale of a biographical work, or whether its publication is motivated in part by a desire for commercial gain, or whether it is designed for the popular market, i.e., the average citizen, rather than the college professor, has no bearing on whether a public benefit may be derived from such a work Thus,

⁷³ *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

⁷⁴ *Campbell v. Acuff Rose*, 510 U.S. 569 (1994). The Court in *Campbell* held that "[t]he language of the statute [17 U.S.C. § 107] makes clear that the commercial . . . purpose of a work is only one element of the first factor. *Id.* at 584.

⁷⁵ *Hustler Magazine, Inc. v. Moral Majority, Inc.*, 796 F.2d 1148, 1152-53 (9th Cir. 1986). See also *Triangle Publications, Inc. v. Knight Ridder Newspapers, Inc.*, 626 F.2d 1171, 1177 (5th Cir. 1980).

⁷⁶ 510 U.S. 569 (1994).

⁷⁷ *Id.* at 584.

⁷⁸ See generally 2 P. GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW & PRACTICE 187 (1989).

⁷⁹ 366 F.2d 303, 307 (2d Cir. 1966), cert. denied, 385 U.S. 1009 (1967). In *Rosemont*, the owner of copyrights on magazine articles concerning a celebrity brought a copyright infringement action against a publisher which had issued a biography of the celebrity. *Id.* at 303.

we conclude that whether an author or publisher has a commercial motive or writes in a popular style is irrelevant to a determination of whether a particular use of copyrighted material in a work, which offers some benefit to the public, constitutes fair use.⁸⁰

Therefore, it is clear that courts do find unlicensed, commercial use of copyrighted material to be “fair.”⁸¹

Justice Souter, in *Campbell v. Acuff-Rose Music, Inc.*,⁸² stated that lower courts *should not* consider that every commercial use of copyrighted material is presumptively unfair, based upon an erroneous reading of *Sony Corp. of America v. Universal City Studios, Inc.*⁸³ Justice Souter said:

The language of the statute makes clear that the commercial or nonprofit educational purpose of a work is only one element of the first factor enquiry into its purpose and character Accordingly, the mere fact that a use is educational and not for profit does not insulate it from a finding of infringement, any more than the commercial character of a use bars a finding of fairness. If, indeed, commerciality carried presumptive force against a finding of fairness, the presumption would swallow nearly all of the illustrative uses listed in the preamble paragraph of section 107, including news reporting, comment, criticism, teaching, scholarship, and research, since these activities “are generally conducted for profit in this country.” Congress could not have intended such a rule, which certainly is not inferable from the common-law cases, arising as they did from the world of letters in which Samuel Johnson could pronounce

⁸⁰ *Id.* at 306.

⁸¹ *Id.* at 308. For example, the Second Circuit has held “[t]he fair use privilege has been applied without question to other publications which have obviously been motivated in part by a desire for economic gain.” *Id.*

⁸² 510 U.S. 569 (1994).

⁸³ 464 U.S. 417 (1984).

that “[n]o man but a blockhead ever wrote, except for money.”⁸⁴

Furthermore, Justice Souter noted that:

Sony itself called for no hard evidentiary presumption Rather, as we explained in *Harper & Row*, *Sony* stands for the proposition that the “fact that a publication was commercial as opposed to nonprofit is a separate factor that tends to weigh against a finding of fair use.” But that is all, and the fact that even the force of that tendency will vary with the context is a further reason against elevating commerciality to hard presumptive significance.⁸⁵

Nonetheless, the presence of commercial arrangements and a likelihood of profits raise an inference that a user should clear the rights to any copyrighted materials prior to use. The case law, as well as the statutes, suggests that unlicensed use in a commercial context will only be deemed “fair use” if it is *de minimus* or a true parody.⁸⁶

One must be aware that demonstrating that an infringement is *de minimus* may not be an easy task. “Whether an infringement is *de minimus* is determined by the amount taken without authorization from infringed work, and not by the characteristics of infringing work.”⁸⁷ In *Woods*, Universal used a copyrighted drawing created by Woods in their movie, “12 Monkeys,” without obtaining Woods’ permission.⁸⁸ “Universal argue[d] that the infringement [was] *de minimus* because the infringing footage in ‘12 Monkeys’ amount[ed] to less than five minutes in a movie 130 minutes

⁸⁴ *Campbell*, 510 U.S. at 584 (quoting 3 BOSWELL’S LIFE OF JOHNSON 19 (G. Hill ed. 1934)).

⁸⁵ *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 562 (1985). “The fact that a publication was commercial as opposed to nonprofit is a separate factor that tends to weigh against a finding of fair use.” *Id.*

⁸⁶ *Sony*, 464 U.S. at 481-82 (Blackmun, J., dissenting).

⁸⁷ *Woods v. Universal City Studios, Inc.*, 920 F. Supp. 62, 65 (S.D.N.Y. 1996).

⁸⁸ *Id.* at 63.

long.”⁸⁹ Judge Cedarbaum found that “‘12 Monkeys’ copie[d] substantial portions of Woods’ drawing”⁹⁰ and granted Woods’ motion for a preliminary injunction.⁹¹

Courts also consider whether the use is *transformative*, that is, whether the use is not a substitute for the copyrighted work, but creates something new, with a further purpose or different character.⁹² The more transformative the new work, the less important are other factors, like commercialism, that will weigh against a finding of fair use.⁹³ As an example, parody, Justice Souter notes in *Acuff Rose*, is transformative.⁹⁴ On the other hand, transformative uses are not required for a finding of fair use.

(2) Nature of the Copyrighted Material

The distinctions, which courts have found to be germane in judicial inquiry as to the nature of copyrighted material under Section 107, have been “factual” works as opposed to “inventive” works.⁹⁵ Works of a factual nature are accorded a lower degree of protection than imaginative works on the ground that the law favors the free flow of information and provides maximal safeguards for products of the imagination.⁹⁶

⁸⁹ *Id.* at 65.

⁹⁰ *Id.* In her analysis Judge Cedarbaum pointed out that “[a] comparison of ‘(Upper) Chamber’ and footage from 12 MONKEYS demonstrates that the movie has copied Woods’ drawing in striking detail.” *Id.* at 64.

⁹¹ *Id.* (noting that Universal had failed to demonstrate that this was a case of “special circumstances” justifying only an award of damages and not an injunction).

⁹² *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994). See also Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990).

⁹³ *Campbell*, 510 U.S. at 579.

⁹⁴ *Id.* Justice Souter reasoned that “[l]ike less ostensibly humorous forms of criticism, it can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one.” *Id.*

⁹⁵ *Consumers Union of the United States, Inc. v. General Signal Corp.*, 724 F.2d 1044, 1049 (2d Cir. 1983), *cert. denied*, 469 U.S. 823 (1984); *New York Times Co. v. Roxbury Data Interface, Inc.*, 434 F. Supp. 217, 221 (D.N.J. 1977).

⁹⁶ *Consumers Union*, 724 F.2d at 1049. Judge Timbers reasoned that “[s]ince

Courts had regarded published works as in need of a lower degree of protection than unpublished works.⁹⁷ The Copyright Law was amended in 1992 to provide that 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 fair use factors.⁹⁸ And so, there is no *per se* rule barring claims of fair use of unpublished works.⁹⁹ Unpublished works no longer have a special status under *Harper v. Row Publishers v. Nation Enterprises*.¹⁰⁰

There is greater license for use of works that are unavailable -- works that are out of print or otherwise unobtainable by ordinary means.¹⁰¹

There also appears to be a stronger argument for expropriation under the fair use doctrine of portions of "a work more of diligence than of originality or inventiveness."¹⁰² In the Southern District of New York, Judge Carter has stated that "copyright protection for compilations of factual materials cannot be reconciled with the general principles of the copyright law" and that "such works should be most conducive to fair use."¹⁰³

But, sometimes factual materials cannot be copied. The Second Circuit has recognized that "the advent of modern photocopying technology creates a pressing need for the law 'to strike an

the risk of restraining the free flow of information is more significant with informational work, the scope of permissible fair use is greater." *Id.*

⁹⁷ *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 553 (1985). Justice O'Connor reasoned that "[t]he applicability of the fair use doctrine to unpublished works is narrowly limited since, although the work is unavailable, this is the result of a deliberate choice on the part of the copyright owner." *Id.*

⁹⁸ *Id.* at 554 (stating that the unpublished nature of a work is a key, though not necessarily determinative, factor tending to negate a defense of fair use).

⁹⁹ *Id.* at 569 (finding that there is no warrant for judicially imposing, a 'compulsory license' permitting unfettered access to the unpublished copyrighted expression of public figures).

¹⁰⁰ 471 U.S. 539 (1985).

¹⁰¹ 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 13.05[A][2][a] (1997).

¹⁰² *New York Times Co. v. Roxbury Data Interface, Inc.*, 434 F. Supp. 217, 221 (D.N.J. 1977).

¹⁰³ *Dow Jones & Co. v. Board of Trade*, 546 F. Supp. 113, 120 (S.D.N.Y. 1982).

appropriate balance between the authors' interest in preserving the integrity of copyright, and the public's right to enjoy the benefits that photocopying technology offers."¹⁰⁴

In *Texaco*, Texaco employed 400 to 500 researchers who conducted scientific research to develop new products and technology primarily to improve commercial performance in the petroleum industry.¹⁰⁵ In support of research activities, Texaco "subscribe[d] to many scientific and technical journals and maintain[ed] a sizable library with these materials."¹⁰⁶ Texaco had its library circulate current issues of relevant journals to their researchers in order to keep them abreast of developments in their fields.¹⁰⁷ Researchers would review and photocopy relevant articles in their entirety and place the copies in files for later reference.¹⁰⁸ Based on these facts the Court held that "Texaco's photocopying of [these] articles . . . was not fair use."¹⁰⁹

(3) Substantiality of Use

The third factor, amount and substantiality, measures the length of the quotation from a copyrighted work against the copyrighted work as a whole.¹¹⁰ The Second Circuit has stated that "[t]here are no absolute rules as to how much of a copyrighted work may be copied and still be considered fair use."¹¹¹ In fact, it is clear that, "whatever the use, generally it may not constitute a fair use if the

¹⁰⁴ *American Geophysical Union v. Texaco, Inc.*, 60 F.3d 913, 917 (2d Cir. 1995) (citing 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §13.05 [E][1] (1997)).

¹⁰⁵ *Id.* at 915.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ *Id.* at 931. The Second Circuit confined their ruling "to the institutional, systematic, archival multiplication of copies . . . for which licenses are in fact available." *Id.*

¹¹⁰ *Maxtone-Graham v. Burtchaeil*, 803 F.2d 1253, 1263 (2d Cir. 1986), *cert. denied*, 481 U.S. 1059 (1987).

¹¹¹ *Id.*

entire work is reproduced.”¹¹² But, even that is not absolute because time-shifting of *entire* audiovisual work was permitted by the Supreme Court in *Sony*.¹¹³

Recent case law suggests that the substantiality issue is a question of “qualitative substantiality” as well as of quantity. In *Salinger v. Random House, Inc.*,¹¹⁴ where expropriated material formed a sizable percentage of the body of work from which it was taken, i.e., one-third of 17 letters and ten percent of 42 letters, the Second Circuit seems to have been concerned largely with the question of bulk in its determination that Ian Hamilton’s use of material by J.D. Salinger was infringement rather than fair use.¹¹⁵ But in *Harper & Row v. Nation Enterprises*,¹¹⁶ a mere 300 words, however minor in comparison to the size of the entire work from which removed, were deemed to constitute the “heart” of a book-length work.¹¹⁷ Consequently, the magazine’s fair use defense was rejected.¹¹⁸

(4) Effect of Use on the Market

The Supreme Court has said that the issue of adverse “effect of the use upon the potential market for or value of the copyrighted work” is the “single most important element of fair use.”¹¹⁹ In making this market analysis, courts have been concerned not only with the effect on the original copyrighted work but also with the likelihood that there will be interference with the market for

¹¹² 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05[A][3] (1997).

¹¹³ *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

¹¹⁴ 811 F.2d 90 (2d Cir. 1987).

¹¹⁵ *Id.* at 98.

¹¹⁶ 471 U.S. 539, 565 (1985).

¹¹⁷ *Id.*

¹¹⁸ *Id.* at 569.

¹¹⁹ *Harper & Row v. Nation Enterprises*, 471 U.S. 539, 566 (1985); “Fair use, when properly applied, is limited to copying by others which does not materially impair the marketability of the work which is copied.” *Id.* at 566-67.

derivative works.¹²⁰ This could be a circular argument because a market is irrelevant if there be “fair use.”

The Register of Copyrights, Marybeth Peters, has stated:

The choice of the term ‘potential’ seems appropriate . . . a concept that has proved useful in the context of the copyright fair use doctrine, which requires courts to weigh as the most important factor in the fair use analysis ‘the effect of the use upon the potential market for or value of a copyrighted work.’ . . . In determining which markets are closely enough related to be considered ‘potential,’ courts could examine the producer’s business plans as well as customary business practices The mere possibility that a use could be licensed should not be sufficient, or the term would become circular.¹²¹

FIRST AMENDMENT

Many commentators and courts have recognized the potential conflict between the first amendment right to freedom of speech, and the right to copyright the expression of a work.¹²² Most courts have indicated that the fair use doctrine inherently accommodates First Amendment concerns.¹²³ Since the fair use doctrine serves to abolish copyright claims, courts have held that it eliminates the concerns that are raised by free speech.¹²⁴ In some cases it has been stated that the fair use doctrine acts to preserve those interests of the

¹²⁰ *Harper & Row v. Nation Enterprises*, 471 U.S. 539, 568 (1985); *New Era Publications v. Carol Pub. Group*, 904 F.2d 152, 159 (2d Cir. 1990).

¹²¹ *Peters: Hearings on H.R. 2652 Before the House Subcomm. in Courts and Intellectual Property*, 105th Cong. 6 (1997); see generally 4 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 13.05[A][4] (1997).

¹²² *Triangle Publications, Inc. v. Knight Ridder Newspapers, Inc.*, 626 F.2d 1171 (5th Cir. 1980).

¹²³ *Id.*

¹²⁴ Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283 (1979).

First Amendment by allowing the access to expressions which are otherwise protected by copyright law.¹²⁵

Copyright law operates to preserve the property interests of a copyright holder in order to preserve the economic incentive to produce.¹²⁶ The First Amendment reserves no such property interest nor does it yield to economic encouragement.¹²⁷ If free speech demands access to the expression of another's copyrighted work, perhaps the First Amendment should not yield to copyright law.¹²⁸

GOOD OR BAD FAITH

Because the fair use doctrine remains "an equitable rule of reason," and presumes "good faith and fair dealing," the good or bad faith of the parties may play a substantial role in a court's determination of whether defendant's copying was fair and reasonable.¹²⁹

On the other hand, Justice Souter in *Campbell* considered failure to obtain a license irrelevant to a fair use analysis.¹³⁰ The company, Acuff-Rose, held the copyright to a song entitled *Oh Pretty Woman*, on which the band, "2 Live Crew" based their song, *Pretty Woman*.¹³¹ The band sent a letter and a copy of both the song and the written lyrics to Acuff-Rose, asking for a license so that they could produce their version of the song.¹³² Although "2 Live Crew" offered money to Acuff-Rose, they were denied permission for usage. "2 Live Crew" produced their song *Pretty Woman* despite the denial by Acuff-Rose to grant a license of the song *Oh Pretty Woman*.¹³³ In litigation, Acuff-Rose asserted "2 Live

¹²⁵ *Id.*

¹²⁶ *Id.*

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Iowa State University v. ABC*, 621 F.2d 57 (2d Cir. 1980) (stating that ABC's conduct was not irrelevant to the fairness of the use).

¹³⁰ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

¹³¹ *Id.*

¹³² *Id.*

¹³³ *Id.*

Crew's" intention to buy the copyright as evidence of the infringer's state of mind. Justice Souter addressed this assertion by writing:

Finally, regardless of the weight one might place on the alleged infringer's state of mind, we reject Acuff-Rose's argument that "2 Live Crew's" request for permission to use the original should be weighed against a finding of fair use. Even if good faith were central to fair use, "2 Live Crew's" actions do not necessarily suggest that they believed their version was not fair use; the offer may simply have been made in a good faith effort to avoid this litigation. If the use is otherwise fair, then no permission need be sought or granted. Thus, being denied permission to use a work does not weigh against the finding of fair use.¹³⁴

And so, even as to bad or good faith, there is no unanimity.

THE DIGITAL MILLENNIUM COPYRIGHT ACT OF 1998

The question of copyright infringement in cyberspace and the applicability of fair use doctrine on the Internet has recently been a topic of much debate and concern in the world of copyright law.¹³⁵ Indeed, "[a]s a two-way communication medium over which more than one hundred million people send and receive communications, the Internet differs fundamentally from traditional communication media to which copyright law has applied."¹³⁶ However, with the

¹³⁴ Fisher v. Dees, 794 F.2d 432, 437 (9th Cir. 1986).

¹³⁵ See generally Monica P. McCabe et al., *Internet Copyright Infringement: Congress, Courts Address Liability of Third Parties*, 220 N.Y.L.J. S1 (1998); See also Fred Koenigsberg, *Guarding Intangible Property in a New, Intangible Realm*, 20 NAT'L L.J. C8 (1998); "The creation of a new 'place' in which intellectual property is used – alternatively referred to as cyberspace, the digital electronic environment, the global information infrastructure and the Internet – presents a novel challenge to the continued protection of intellectual property rights. The law must now deal creatively with that challenge." *Id.*

¹³⁶ McCabe, *supra* note 135, at S1. See also Wendy Leibowitz, *The Sound of One Computer Copy*, 21 NAT'L L.J. A16 (1998). "As computers, the world's

passage and adoption of the Digital Millennium Copyright Act of 1998, "the landscape of Internet copyright is likely to change significantly this year" ¹³⁷

The Digital Millennium Copyright Act of 1998, ¹³⁸ a bill recently signed by President Clinton, ¹³⁹ was "designed to facilitate the robust development and world-wide expansion of electronic commerce, communications, research, development, and education in the digital age." ¹⁴⁰ As evidenced by the Act's unanimous and speedy passage, Congress has shown much concern for the impact that copyright law and these amendments will have on electronic commerce and technological development. ¹⁴¹

greatest copying machines, proliferate, the operation of copyright law hits home – or the office – as never before." *Id.* (emphasis added).

¹³⁷ McCabe, *supra* note 135, at S1. See also Wendy Leibowitz, *The Sound of One Computer Copy*, 21 NAT'L L.J. A16 (1998) (noting a paradigm shift in copyright law in light of global technological changes).

¹³⁸ The Digital Millennium Copyright Act of 1998, Pub. L. No. 105-304, § 202(a), 112 Stat. 2860, 2877-83 (1998). The Senate Bill was unanimously passed in May of 1998 and the House similarly passed its version on August 4, 1998; finally, President Clinton signed it on October 28, 1998. 1997 U.S.H.B. 2281.

¹³⁹ S. REP. NO. 105-190, at 1 (1998).

¹⁴⁰ See *id.* The Committee Report describes the purpose and coverage of the Act as follows:

Title I will implement the new World Intellectual Property Organization (WIPO) Copyright Treaty and the WIPO Performances and Phonograms Treaty, thereby bringing U.S. copyright law squarely into the digital age and setting a marker for other nations who must also implement these treaties. Title II will provide certainty for copyright owners and Internet service providers with respect to copyright infringement liability online. Title III will provide a clarifying exemption in the Copyright Act to ensure that the lawful owner or lessee of a computer machine may authorize an independent service technician to activate the computer in order to service its hardware components. Finally, Title IV will begin to update our nation's copyright laws with respect to library, archive, and educational uses of copyrighted works in the digital age.

Id.

¹⁴¹ See *id.* § 205.

The Digital Millennium Copyright Act actually evolved from a meeting in Geneva of the world's governments in December of 1996 to "hash out international treaties on copyright protection in the age of the Internet."¹⁴² It signifies a first step in implementing the World Intellectual Property Organization [hereinafter "WIPO"] treaties (Title I of the new Act).¹⁴³ In anticipation of signing the bill into law, President Clinton stated: "This bill will extend intellectual protection into the digital era while preserving fair use and limiting infringement liability for providers of basic communication services I urge the Senate to ratify these treaties so that America can continue to lead the world in the Information Age."¹⁴⁴

This legislation was enacted specifically to bring into play the strong copyright protections contemplated in Geneva at the WIPO meeting. It makes the "minor modifications to U.S. copyright law that are necessary to achieve compliance with the WIPO treaties."¹⁴⁵

Section 1201(a)(2) of Title I, Circumvention of Copyright Protection Systems, prohibits, *inter alia*, manufacturing, importing, offering for sale, providing or trafficking in products primarily designed for the purpose of circumventing technological measures designed to control access to copyrighted works. Section 1201(a)(1), which prohibits the circumvention of copyrighted works, begins only two years after the effective dates of the legislation, that is, in late October of the year 2000 (Section 1201(a)(1)(A)). It shall not apply to any class of works identified by the Register of Copyrights in consultation with the Assistant Secretary of Commerce for Communications and Information as having had its users "adversely affected by virtue of such prohibition." Congress has ordered the Copyright Office to undertake a rule-making in which it shall examine five separate criteria to determine, essentially, whether the fair use of any particular class (undefined) of copyrighted works has been unduly limited by section 1201. The balance of section 1201 contains

¹⁴² Matthew McAllester, *Putting the Brakes on Highway Robbery*, *NEWSDAY*, October 28, 1998, at C3.

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ Fred Koenigsberg, *Guarding Intangible Property in a New, Intangible Realm*, 20 NAT'L L.J. C8 (1998).

numerous exceptions to the rules previously specified, including exemptions for non-profit libraries, archives, and educational institutions gaining access to the copyrighted work in order to make a "good faith determination whether to acquire a copy of that work for the sole purpose of engaging in the conduct permitted under this title," that is, fair use.

As noted, Congress in the Digital Millennium Act itself did not ignore "fair use." Further, in section 1201(c)(1), Congress stated "Nothing in this section shall affect rights, remedies, limitations, a defense to copyright infringement, including *fair use*, under this title" (emphasis supplied). And so, fair use is alive and well in the Internet era!

CONCLUSION

It is difficult to make fair use decisions. Sadly, one must guess at fair use probabilities. A lot depends on who your adversary is: will he, she or it sue or not. Finally, even judges disagree as to when fair use should apply, which explains why many fair use cases are reversed on appeal. The author suggests a conservative view when advising clients in this fast-changing area of the law.

In conclusion, the issue of whether fair use applies has been dealt with in even the most controversial cases. No fair use was found for the TV news broadcast of 30 seconds from a copyrighted videotape of the Reginald Denny beating.¹⁴⁶ Despite the news consideration in the use, and the fact that there could be no substitute for use of the tape itself, the Ninth Circuit concluded that the unlicensed use was commercial, allowed "use[of] the heart of the tape," and impaired the copyright owner's original and primary market.¹⁴⁷ This is but one illustration of how the application of the fair use doctrine continues to develop, and an indication of the challenges facing intellectual property law as we enter the new millennium.

¹⁴⁶ Los Angeles News Service v. KCAL-TV Channel 9, 108 F.3d 1119 (9th Cir. 1997).

¹⁴⁷ *Id.* at 1123.