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A Fair Use Project for Australia: Copyright Law and Creative Freedom

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COPYRIGHT LAW AND CREATIVE FREEDOM
COPYRIGHT REPORTER
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Introduction

In *Folsom v. Marsh*, Justice Joseph Story founded the United States doctrine of fair use. Even at the early stage, the judge was alert to the subtleties and nuances involved in making a fair use determination: ‘Patents and copyrights approach, nearer than any other class of cases belonging to forensic discussions, to what may be called the metaphysics of the law, where the distinctions are, or at least may be, very subtle and refined, and, sometimes, almost evanescent.’¹ The judge elaborated:

What constitutes a fair and bona fide abridgment, in the sense of the law, is one of the most difficult points, under particular circumstances, which can well arise for judicial discussion. It is clear, that a mere selection, or different arrangement of parts of the original work, so as to bring the work into a smaller compass, will not be held to be such a abridgment. There must be real, substantial condensation of the materials, and intellectual labor and judgment bestowed thereon; and not merely the facile use of the scissors; or extracts of the essential parts, constituting the chief value of the original work.²

His Honour emphasized: ‘There must be real, substantial condensation of the materials, and intellectual labor and judgment bestowed thereon; and not merely the facile use of the scissors; or extracts of the essential parts, constituting the chief value of the original work.’³

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¹ *Folsom v. Marsh* 9 F.Cas. 342 at 344 (1841).

² *Folsom v. Marsh* 9 F.Cas. 342 at 345 (1841).

³ *Folsom v. Marsh* 9 F.Cas. 342 at 345 (1841).

The doctrine of fair use became codified in the United States copyright regime. Section 107 of the *Copyright Act* 1976 (Cth) provides:

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.

Moreover the provision 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.’⁴

Since that time, the doctrine of fair use has been applied in a dazzling array of factual situations and technological environments. As Pamela Samuelson has observed:

Fair use has been invoked as a defense to claims of copyright infringement in a wide array of cases over the past thirty years, as when someone has drawn expression from an earlier work in order to parody it, quoted from an earlier work in preparing a new work on the same subject, published a photograph as part of a news story, made a time-shift copy of television programming, photocopied a document for submission as evidence in a litigation, reverse engineered a computer program to get access to interface information, cached websites to facilitate faster access to them, or provided links to images available on the Internet, just to name a few.⁵

Moreover, the defence of fair use has migrated into other adjoining fields of intellectual property. The codification of trade mark dilution law features a defence of fair use.⁶

⁴ Section 107 of the *Copyright Act* 1976 (US)

⁵ Pamela Samuelson, ‘Unbundling Fair Uses’, (2009) 77 *Fordham Law Review* 2537 at 2539.

⁶ See Matthew Rimmer, ‘The Black Label: Trade Mark Dilution, Culture Jamming, and the No Logo Movement’ (2008) 5 (1) *Script-ed (University of Edinburgh)* 70-136.

There are strong parallels between the defence of fair use under copyright law and the defence of experimental use under patent law (not least because Justice Joseph Story invented both doctrines).⁷

In addition to such legal jurisprudence on the topic, there has been a publishing boom in academia on the topic of copyright law and fair use. There have been ferocious debates over the merits and the demerits of the legal doctrine. Academics have suggested a fantastic spectrum of theories and reforms to improve the doctrine of fair use under copyright law. Pamela Samuelson surveys the literature on the topic:

Some commentators have proposed to ‘fix’ fair use by establishing a low-cost administrative tribunal so that putative fair users could explain uses they wished to make of another author’s work and get feedback from the tribunal about whether the use is fair. Another has suggested that the U.S. Copyright Office be given more rule-making authority to develop fair use guidelines or create new exceptions. Still others have recommended quantitative safe harbors for common kinds of appropriations (e.g., so many seconds of a song, so many words from a text). A fourth approach has been to articulate ‘best practices’ guidelines for groups of creators who typically reuse parts of previous works in developing new ones (e.g., documentary filmmakers). Many commentators have also urged that courts take into account some factors not set forth in Sec. 107, the fair use provision of the Copyright Act of 1976 (1976 Act), including the likelihood of market failure, the plaintiff’s rationale for insisting that the use must be licensed, chilling effects on free speech, chilling effects on innovation, the impact of network effects, whether the defendant’s use was reasonable and customary in her field of endeavor, how ‘old’ the work is, distributive values, and even the fairness of the use.⁸

Samuelson has sought to identify policy clusters underlying the cases dealing with the fair use doctrine. She suggests: ‘The policies [which] underlie modern fair use law include promoting freedom of speech and of expression, the ongoing progress of authorship, learning, access to information, truth-telling or truth-seeking, competition, technological innovation, and privacy and autonomy interests of users’.⁹

There has been a great interest in the operation of the defence of fair use in practice in the United States. In a paper entitled ‘The Googlization of Everything and the Future of Copyright’, Siva Vaidhyanathan comments upon the paradox of the defence of fair use:

⁷ See Matthew Rimmer, ‘The Freedom To Tinker: Patent Law and Experimental Use’ (2005) 15 (2) *Expert Opinion on Therapeutic Patents* 167-200.

⁸ Pamela Samuelson, ‘Unbundling Fair Uses’, (2009) 77 *Fordham Law Review* 2537 at 2540-1.

⁹ *Ibid* at 2541-2542.

As Lawrence Lessig has said and written on many occasions, ‘fair use is the right to hire a lawyer.’ This statement is a recognition of the central problem of fair use, its central paradox: while fair use might seem to be growing stronger on paper (and in court), it is increasingly less fair and less useful in real life. Not every publicly beneficial use is a parody or a thumbnail. The confidence that fair use affords creators correlates strongly with one’s position in the socioeconomic scale and one’s expertise in matters of copyright.¹⁰

His insight is that there is a gap between the law in the books, with the protection afforded by the defence of fair use, and the murky reality of access to justice and the law in action.

This essay provides a critical assessment of the Fair Use Project based at the Stanford Center for Internet and Society. In evaluating the efficacy of the Fair Use Project, it is worthwhile considering the litigation that the group has been involved in, and evaluating its performance. Part 1 outlines the history of the Stanford Center for Internet and Society, and the aims and objectives of the Fair Use Project. Part 2 considers the litigation in *Shloss v. Sweeney* over a biography concerning Lucia Joyce, the daughter of the avant-garde literary great, James Joyce.¹¹ Part 3 examines the dispute over the Harry Potter Lexicon.¹² Part 4 looks at the controversy over the Shepard Fairey poster of President Barack Obama, and the resulting debate with Associated Press.¹³ Part 5 of the essay considers the intervention of the Fair Use Project as an *amicus curiae* in the ‘Column case’.¹⁴ Part 6 explores the participation of the Fair Use Project as an *amicus curiae* in the litigation over *60 Years Later*, an unauthorised literary sequel to J.D. Salinger’s *The Catcher in the Rye*.¹⁵ Part 7 of the essay investigates the role of the Fair Use project in disputes over copyright law and musical works.¹⁶ Part 8 investigates

¹⁰ Siva Vaidyanathan, ‘The Googlization of Everything and the Future of Copyright’ (2007) 40 *The University of California Davis Law Review* 1207 at 1226-1227.

¹¹ *Shloss v. Sweeney* 515 F. Supp. 1068 (2007).

¹² *Warner Bros and JK Rowling v RDR Books* 575 F.Supp.2d 513 (2008)

¹³ *Fairey v. Associated Press* 09-01123 (AKH) United States District Court for the Southern District of New York (2009)

http://cyberlaw.stanford.edu/biguploads/Fairey_v_AP_complaint_with_exhibits.pdf

¹⁴ *Gaylord v. The United States* 85 Fed. Cl. 59 (2008) (the ‘Column’ case); and *Gaylord v. United States* 595 F.3d 1364 (2010).

¹⁵ *Salinger v. Colting* 641 F.Supp.2d 250 S.D.N.Y.,2009; and *Salinger v. Colting* 607 F. 3d 68 (CA2, NY, 2010).

¹⁶ *Vargas v. Pfizer Inc.* 352 Fed.Appx. 458 C.A.2 (N.Y.),2009

the role of the Fair Use Project as an advocate in disputes over copyright law, fair use, documentary films, and internet videos.¹⁷

The conclusion has main three arguments. First, it contends that Australia should establish a Fair Use Project to support creative artists in litigation over copyright exceptions. Second, it maintains that Australia should adopt a flexible, open-ended defence of fair use, and draw upon the rich jurisprudence in the United States on the fair use doctrine. Finally, this paper argues that support should be given at an international level to the proposal for a Treaty on Access to Knowledge.

1. The Stanford Center for Internet and Society and the Fair Use Project



The Stanford Center for Internet and Society was established by Lawrence Lessig in 1999.

Famously, Lessig mounted a series of constitutional challenges to the copyright term extensions, which had taken place in the United States. Most famous of all, of course, was the landmark decision of *Eldred v. Ashcroft*.¹⁸ The majority of the Supreme Court of the United States ruled that the *Sonny Bono Copyright Term Extension Act* 1998 (US) was valid in light of the Intellectual Property Power of the United States Constitution and consistent with the protection afforded to free speech by the First Amendment. Amongst other things, Ginsburg J argued that the defence of fair use was an important safeguard for freedom of speech:

¹⁷ *Aguiar v. Webb* 1:2007cv11673 (Mass. District Court); *Lennon v. Premise Media Corporation* LP 556 F. Supp 2d 310 (SDNY 2008); *MoveOn.Org Civic Action and Brave New Films v. Viacom* 21 March 2007; and *Brave New Films v. Weiner aka. Savage* 2009 WL 1622385 (N.D.Cal.)

¹⁸ *Eldred v. Ashcroft* 537 U.S. 186 (2003).

The “fair use” defense allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances. Codified at 17 U.S.C. § 107 the defense provides: “[T]he fair use of a copyrighted work, including such use by reproduction in copies . . . , for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.” The fair use defense affords considerable “latitude for scholarship and comment,” *Harper & Row*, 471 U.S., at 560, and even for parody, see *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (rap group’s musical parody of Roy Orbison’s “Oh, Pretty Woman” may be fair use).¹⁹

In his dissent, Breyer J noted: “The majority also invokes the “fair use” exception, and it notes that copyright law itself is restricted to protection of a work’s expression, not its substantive content.”²⁰ In his opinion the copyright term extension would have a significant impact upon freedom of speech, notwithstanding the presence of the defence of fair use: “Such harm, and more, will occur despite the 1998 Act’s exemptions and despite the other “First Amendment safeguards” in which the majority places its trust.”²¹

Brewster Kahle and the Internet Archive complained, unsuccessfully, about the removal of formalities from copyright law in the United States.²² Lawrence Golan, a conductor, has been involved in longstanding litigation over the revival of copyright in foreign works – with much legal debate back and fro over whether the traditional contours of copyright law had been changed.²³

In the wake of these failed constitutional battles, Lessig wrote popular manifestos calling for copyright law reform, such as *Free Culture* and *Remix*.²⁴ He also helped forge a number of campaigns, and institutions. First, he helped establish the Creative Commons movement – which relied upon the use of private contracts to make

¹⁹ *Eldred v. Ashcroft* 537 U.S. 186 at 219-220 (2003).

²⁰ *Eldred v. Ashcroft* 537 U.S. 186 at 252 (2003).

²¹ *Eldred v. Ashcroft* 537 U.S. 186 at 252 (2003).

²² *Kahle v. Ashcroft* 72 U.S.P.Q.2d 1888 (2004); *Kahle v. Gonzales* 474 F.3d 665 C.A.9 (Cal.), 2007; and *Kahle v Mukasey* 128 S.Ct. 958 (Mem) U.S.,2008

²³ *Golan v. Ashcroft* 310 F.Supp.2d 1215 (2004); *Golan v. Gonzales* 74 U.S.P.Q.2d 1808 (2005); 501 F.3d 1179 (2007); *Golan v. Holder* 611 F.Supp.2d 1165 (2009); 2010 WL 2473217.

²⁴ Lawrence Lessig, *Free Culture: How Big Media Uses Technology And Law To Lockdown Culture And Control Creativity*. New York: Penguin Books, 2004, <http://freeculture.org/>, Creative Commons free download; and Lawrence Lessig, *Remix: Making Art and Commerce Thrive in the Hybrid Economy*. New York: Penguin Books, 2008, <http://remix.lessig.org/remix.php> , Creative Commons free download.

copyright work more accessible.²⁵ Naysayers notwithstanding, one would have to concede that the Creative Commons has a major impact on the cultural landscape. Second, Lessig has lobbied for a legislative response to the problem of orphan works. He promoted the *Public Domain Enhancement Bill* 2005 (US). However, he lobbied against the *Shawn Bentley Orphan Works Bill* 2008 (US) – preferring instead a system of registration for copyright law to help preserve public domain. Third, Lessig was instrumental in establishing a ‘Fair Use Project’. This initiative is perhaps less well known than the famous Creative Commons. But, going against the popular wisdom, I would argue that the Fair Use Project is the most significant and important initiative of the three institutional ventures associated with Lessig.

After participating in constitutional challenges to the copyright term extension, the legal clinic turned its attention to questions of copyright law and fair use – representing J. Emily Somma in her conflict with Great Ormond Street Hospital over her follow-up literary work to Peter Pan.²⁶ In 2006, the Stanford Center for Internet and Society established the ‘Fair Use Project’ to provide legal support to a range of projects designed to clarify, and extend, the boundaries of ‘fair use’ in order to enhance creative freedom.²⁷

The executive director of the Fair Use Project, Anthony Falzone, is described in these terms:

As an intellectual property litigator, he has defended writers, publishers, filmmakers, musicians and video game makers against copyright, trademark, rights of publicity and other intellectual property claims. Tony represented visual artist Shepard Fairey in copyright litigation against The Associated Press over Fairey's ‘Obama Hope’ posters, and represented RDR Books as trial counsel in its copyright and Lanham Act dispute with J.K. Rowling and Warner Brothers over the *Harry Potter Lexicon*. This follows notable victories on behalf of the producers and distributors of the film *Expelled: No Intelligence Allowed* in litigation against Yoko Ono Lennon and EMI Records, on behalf of Professor Carol Shloss in her lawsuit against the Estate of James Joyce, and on behalf of electronic musician BT in a copyright infringement case in the Second Circuit Court of Appeals.²⁸

²⁵ The Creative Commons, <http://creativecommons.org/>; see Matthew Rimmer, ‘Remix Culture: The Creative Commons and its Discontents’, *Digital Copyright and the Consumer Revolution: Hands off my iPod*, Cheltenham (UK) and Northampton (Mass.): Edward Elgar, July 2007.

²⁶ *J. Emily Somma v. Great Ormond Street Hospital* Civil Case No. 02-5889 EMC, United States

²⁷ The Stanford Center for Internet and Society, ‘The Fair Use Project’, <http://cyberlaw.stanford.edu/node/5979>

²⁸ Anthony Falzone, <http://cyberlaw.stanford.edu/profile/anthony-falzone>

The Stanford Center for Internet and Society has three main objectives. First, the Fair Use Project ‘represents filmmakers, musicians, artists, writers, scholars and other content creators in a range of disputes that raise important questions concerning fair use and the limits of intellectual property rights’.²⁹ The venture ‘relies on a network of talented lawyers within the Center for Internet and Society, as well as attorneys in law firms and public interest organizations that are dedicated to advancing the mission of the [Fair Use Project].’³⁰

Second, the Fair Use Project offers counselling to content creators: ‘It has advised prominent creators and distributors of documentary films concerning fair use, defamation, trademark infringement, and other issues relating to the appropriate bounds of free expression’.³¹ The organization notes: ‘While it is impossible to eliminate completely the risk of a dispute, this analysis helps reduce and identify liability and litigation risks before the fact, so that informed decisions can be made.’³²

Third, the Fair Use Project has been ‘developing a pilot project to reduce the costs of the insurance needed to show or distribute documentary films and other creative works’. In terms of its future ambitions, the group has observed: ‘As the Fair Use Project develops, and the network of attorneys expands, the Fair Use Project hopes to bring these effects to bear on an ever-increasing scale’.³³

The Fair Use Project hoped: ‘Ultimately, we seek to not only define and expand the law, but change the way content owners approach fair use issues.’³⁴

After flirting with the possibility of running for the United States Congress, Lessig has departed from Stanford Law School, and become the director of the Edmond J. Safra Foundation Center for Ethics at Harvard University and a Professor of Law at

²⁹ The Stanford Center for Internet and Society, ‘The Fair Use Project’, <http://cyberlaw.stanford.edu/node/5979>

³⁰ The Stanford Center for Internet and Society, ‘The Fair Use Project’, <http://cyberlaw.stanford.edu/node/5979>

³¹ The Stanford Center for Internet and Society, ‘The Fair Use Project’, <http://cyberlaw.stanford.edu/node/5979>

³² The Stanford Center for Internet and Society, ‘The Fair Use Project’, <http://cyberlaw.stanford.edu/node/5979>

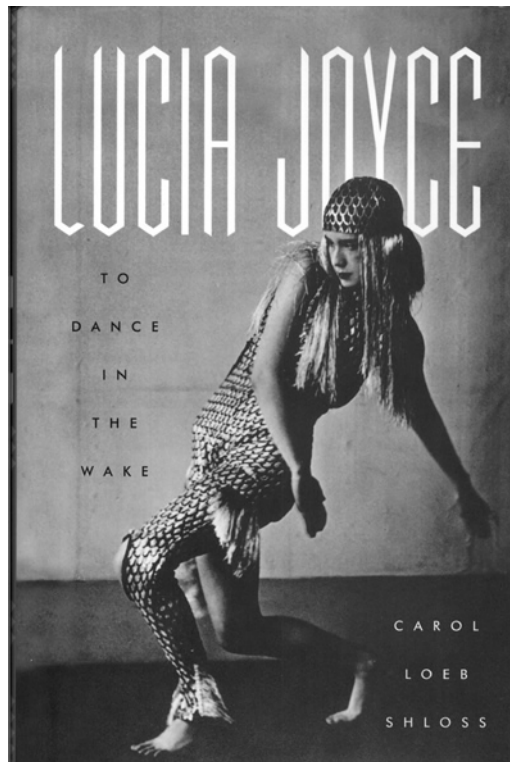
³³ The Stanford Center for Internet and Society, ‘The Fair Use Project’, <http://cyberlaw.stanford.edu/node/5979>

³⁴ The Stanford Center for Internet and Society, ‘The Fair Use Project’, <http://cyberlaw.stanford.edu/node/5979>

Stanford Law School. His new campaign is [fixcongressfirst.org](http://www.fixcongressfirst.org/), an advocacy corporation which is designed to protect the independence and autonomy of Congress from lobbyists, special interest groups, and corporate funding organizations.³⁵ Lessig has been promoting the *Fair Elections Now Bill* 2010 (US) H. 1826 and S. 752 to help fix the system of campaign financing.³⁶ This campaign was, perhaps, in part the product of encountering at first hand the undue influence of copyright industries upon law-making in the United States Congress.

Notwithstanding the departure of Lessig, the Stanford Center for Internet and Society and the Fair Use Project have continued to operate and flourish. The current director of the Stanford Center for Internet and Society is Barbara van Schewick, and Anthony Falzone continues as the director of the Fair Use Project.

2. Lucia Joyce: To Dance in the Wake



In the case of *Shloss v Sweeney*,³⁷ the biographer, Carol Loeb Shloss, enlisted the assistance of the Fair Use Project in her dispute with the Estate of James Joyce over her

³⁵ Fix Congress First, <http://www.fixcongressfirst.org/>

³⁶ *Fair Elections Now Bill* 2010 (US) H. 1826 and S. 752

³⁷ *Shloss v Sweeney* C 06-3718 (US District Court for the Northern District of California, 2006).

biography, *Lucia Joyce: To Dance in the Wake*.³⁸ This case arose out of copyright litigation threats that the Estate of James Joyce made against Shloss through its trustee, Seán Sweeney and other agents of the Estate, such as Stephen James Joyce. There have been other similar incidents – ever since copyright protection in the work of James Joyce was revived by a series of copyright term extensions.³⁹ The biographer, Carol Loeb Shloss, explained:

Even before the book was in print, even before I published it, long before I thought about asking the estate for permission, I received a letter from Stephen Joyce which I'll never forget. And he was trying to second-guess me, he said 'I've heard by rumour that there's going to be a book and I assume it must be your book, and therefore you cannot quote', and then he began to make lists of everything he thought that I might use, since he'd never seen a word. And then he said almost as a post script, 'But you may quote from A Flower given to my Daughter which I'm sure he thought was a beautiful poem, for a fee which I will yet determine'. And so I didn't know what to do with it other than to forward it to my publishers. As publication date became nearer and nearer, and as these letters became more vehement and more frequent, the threats had to be taken more and more seriously. That means that there was a series of deletions.⁴⁰

The Joyce Estate took the contentious view that a figure of 500 words was acceptable as fair use in the book. The biographer was concerned that, as a result of such restrictions, she needed to delete many of her opinions. She observed: 'I had to rewrite this book over and over again'.⁴¹ Shloss observed: 'The process of deleting things that had taken years to find out was just excruciating'.⁴² In her view, there was a larger problem for the community of scholars: 'The ability of people to use quotes from Joyce has ground to a standstill.'⁴³

As a result of the redaction of her biography, Shloss was criticised in some book reviews. The *New Yorker*, for instance, offered this damning assessment:

³⁸ Carol Loeb Shloss, *Lucia Joyce: To Dance in the Wake*, London: Bloomsbury, 2003.

³⁹ Matthew Rimmer, 'Bloomsday: Copyright Estates and Cultural Festivals', (2005) 2 (3)*Scripted (University of Edinburgh)*, 383-428, SSRN: http://papers.ssrn.com/sol3/papers.cfm?abstract_id=759244

⁴⁰ Damien Carrick, 'Copyright Law', The Law Report, 14 September 2004, <http://www.abc.net.au/rn/talks/8.30/lawrpt/stories/s1198816.htm>

⁴¹ Dinita Smith, 'A Portrait of the Artist's Troubled Daughter', *The New York Times*, 22 November 2003.

⁴² Ibid.

⁴³ Ibid.

This elevation of Lucia to the role of collaborator on 'Finnegans Wake' is the book's most spectacular act of inflation, but by no means the only one. The less Shloss knows, the more she tells us... In some sections, however, Shloss forgets that she is writing a symbolist poem or a Laingian treatise and starts writing a biography. That, of course, is when she has some information to go on.'⁴⁴

Smarting from such criticism from book reviewers, Shloss prepared a website that hosted an electronic supplement to her Book in order to present necessary documentary support that serves, in connection with her critical and analytical commentary, to enrich the scholarly nature of her Book.

Carol Loeb Shloss enlisted the assistance of the Fair Use Project. Lawrence Lessig commented upon why it was taking on such a test case:

We want to establish that scholars have the clear right to make even extensive use of copyrighted material for critical scholarly purposes. Shloss's book and website are not copies of, nor substitutes for, Joyce's works. Accordingly, her work is not the kind that copyright law seeks to prohibit. Instead it is the kind of scholarly, critical work that is protected, and that should always be protected, by fair use. We seek a clear statement from the court that such academic use of copyrighted materials is protected under fair use.⁴⁵

The lawyer and literary critic, Robert Spoo, noted: 'There is a climate of concern bordering on fear among Joyce scholars that their work may suddenly come under copyright scrutiny'.⁴⁶

With the help of the Fair Use Project, Shloss launched a civil action seeking declaratory judgment that her use of certain written works on her proposed website did not constitute infringement of any copyrights held by the estate of James Joyce.⁴⁷ The

⁴⁴ Joan Acocella, 'A Fire in the Brain: The Difficulties of Being James Joyce's Daughter', *The New Yorker*, 8 December 2003, http://www.newyorker.com/archive/2003/12/08/031208crbo_books

⁴⁵ 'Shloss v *The Estate of James Joyce*', Stanford Law School, 12 June 2006.

⁴⁶ Dinita Smith, 'A Portrait of the Artist's Troubled Daughter', *The New York Times*, 22 November 2003. Robert Spoo has written extensively on conflicts over copyright law and literary modernists, such as James Joyce and Ezra Pound: see Robert Spoo, 'Copyright Protectionism and Its Discontents: The Case of James Joyce's *Ulysses* in America', (1998) 108 (3) *The Yale Law Journal* 662-663; Robert Spoo, 'Injuries, Remedies, Moral Rights and the Public Domain', (2000) *James Joyce Quarterly* 333; Robert Spoo, 'Copyright Law and Archival Research' (2000-2001) 24 (2) *Journal of Modern Literature* 205; and Robert Spoo, 'Ezra Pound's Copyright Statute: Perpetual Rights and the Problem of Heirs' (2009) 56 *UCLA Law Review* 1775.

⁴⁷ *Shloss v Sweeney* C 06-3718 (US District Court for the Northern District of California, 2006).

Fair Use Project listed four cases of action – a declaratory judgment for non-infringement; fair use; copyright misuse; and unclean hands.⁴⁸

First, the Fair Use Project contended that there was a controversy existing as to whether the material in the Electronic Supplement infringes any copyright of the Estate. It noted: ‘De minimis quotations in the Electronic Supplement are noninfringing’.⁴⁹ Moreover, ‘Quotations of material in the U.S. public domain, including but not limited to the 1922 Paris first edition of *Ulysses*, are noninfringing in the United States.’⁵⁰

Second, the Fair Use Project argued that ‘Shloss’s uses of Defendants’ Material in the planned Electronic Supplement are for the purposes of scholarly, biographical research and literary criticism and commentary.’⁵¹ It observed:

Shloss’s use of Defendants’ Material in the planned Electronic Supplement is not substantially commercial. Defendants’ Material as used in the planned Electronic Supplement comprises both published and unpublished written works. Shloss’s uses of Defendants’ Material in the planned Electronic Supplement are of reasonable length to accomplish her scholarly goals. Shloss’s uses of Defendants’ Material in the planned Electronic Supplement establish historical and/or literary facts that are relevant to Shloss’s scholarly works. Shloss’s uses of Defendants’ Material in the planned Electronic Supplement are transformative because they alter Defendant’s Material with new expression, meaning, or message. Shloss’s uses of Defendants’ Material in the planned Electronic Supplement have little to no effect on the potential market for or value of Defendants’ Material. Due to the purpose and nature of Shloss’s work, her use of Defendants’ Material in the planned Electronic Supplement should be considered presumptive fair use.⁵²

Third, the Fair Use Project alleged that the estate of James Joyce had engaged in copyright misuse: ‘Defendants engaged in the misuse of their copyrights, including in the letters they sent to Shloss and to her Publisher and University employer, by claiming that Shloss’s work constituted copyright infringement when Defendants knew or should have known that it did not.’⁵³ The group observed that this was a case of ‘copyfraud’,⁵⁴

⁴⁸ ‘Amended Complaint for Declaratory Judgment and Injunctive Relief, Demand for Jury Trial’ in *Shloss v Sweeney* C 06-3718 (US District Court for the Northern District of California, 2006).

⁴⁹ *Ibid.*, 19.

⁵⁰ *Ibid.*, 19.

⁵¹ *Ibid.*, 20.

⁵² *Ibid.*, 20.

⁵³ *Ibid.*, 21.

⁵⁴ Jason Mazzone, ‘Copyfraud’ (2006) *New York University Law Review* 1026; and see Jason Mazzone, *Copyfraud and Other Abuses of Intellectual Property*, Palo Alto: Stanford University Press, 2010 (forthcoming).

to use James Mazzone’s evocative phrase: ‘Shloss alleges, upon information and belief, that Defendants’ demand that Shloss not use Lucia Joyce’s works and letters, along with her medical records and uncopyrighted information contained in those works, letters, and records, was an effort to secure an exclusive right or limited monopoly not granted by the copyright laws’.⁵⁵ The Fair Use Project concluded: ‘Shloss alleges, upon information and belief, that the Estate is using threats of copyright infringement to restrain Shloss’s free speech and artistic expression in order to illegally extend the scope of Defendants’ copyright.’⁵⁶

Finally, the Fair Use Project protested that the estate of James Joyce had shown unclean hands: ‘In letters to Shloss, the Publisher, and Shloss’s employer, Stanford University, Defendants have incorrectly claimed that they were legally entitled to prevent Shloss under the circumstances from making use of Lucia Joyce’s letters, writings, and other Lucia-related materials, and even her medical records and files.’⁵⁷ The group observed that ‘this directly impacted Shloss’s scholarly work and compelled the Publisher to suppress portions of Shloss’s Book’.⁵⁸ The Fair Use Project also complained: that the ‘Defendants threatened Shloss’s employer, Stanford University, and otherwise sought to interfere with her work, including her archival research at the University of Buffalo, in order to obstruct her scholarly efforts related to the Book.’⁵⁹

In response, the Estate of James Joyce sought an order dismissing for the complaint for declaratory judgment and injunctive relief for ‘lack of an actual controversy’.⁶⁰ The Estate protested that the ‘Defendants have never threatened to sue Shloss for copyright infringement, and Shloss has never released her Website’.⁶¹ Moreover, the Estate argued that the ‘Defendants now covenant not to sue Shloss for copyright infringement based on the written works appearing on the Electronic

⁵⁵ ‘Amended Complaint for Declaratory Judgment and Injunctive Relief, Demand for Jury Trial’ in *Shloss v Sweeney* C 06-3718 (US District Court for the Northern District of California, 2006), 21.

⁵⁶ *Ibid.*, 21.

⁵⁷ *Ibid.*, 22.

⁵⁸ *Ibid.*, 22.

⁵⁹ *Ibid.*, 23.

⁶⁰ ‘Notice of Motion and Motion of Defendants Sean Sweeney and the Estate of James Joyce to Dismiss, or in the Alternative to Strike, Carol Loeb Shloss’s Amended Complaint: Memorandum of Points and Authorities in Support Thereof’, 22 January 2007, 1.

⁶¹ *Ibid.*, 1.

Supplement that were provided to them in 2005.’⁶² The Estate of James Joyce complained:

This case is an attempt by Shloss and her lawyers, Lawrence Lessig and Robert Spoo, to run roughshod over the rights of a copyright holder in the name of “scholarship” and on behalf of “fair use.” The Estate disagrees that the work in question is a work of “scholarship” and that the use Shloss proposes is “fair.” The Estate vehemently disagrees with – and denies – Shloss’s speculations, stated as facts, in support of her copyright misuse and unclean hands allegations. The Estate, however, does not believe this matter is an appropriate use of this Court’s resources. The Estate already has made itself known. It did not threaten to sue Shloss over the Website, and has covenanted not to sue Shloss over the subject of her original Complaint. The exercise in which Shloss asks this Court to participate, then, is academic.⁶³

Accordingly, the ‘Defendants respectfully request the Court to dismiss Shloss’s Amended Complaint for declaratory judgment and injunctive relief with prejudice and award attorneys’ fees and costs.’⁶⁴

Nonetheless, the United States District Court for the Northern District of California found that Plaintiff demonstrated the existence of an actual ‘case or controversy’ and interpreted Defendants’ unwillingness to extend a covenant not to sue based on the amended electronic supplement as a continuing threat of litigation.⁶⁵ Ware J noted, in his judgment, the correspondence between the parties over the defence of fair use:

On November 6, 2002, Leon Friedman, the Publisher's attorney, wrote to Stephen Joyce, informing him that the Publisher believed Plaintiff's work to be protected by the fair use doctrine of copyright law. On November 21, 2002, Stephen Joyce wrote to Friedman, stating that Friedman “should be aware of the fact that over the past decade the Estate's ‘record’, in legal terms, is crystal clear and we have proven on a number of occasions that we are prepared to put our money where our mouth is.” Stephen Joyce further wrote that the Publisher's fair use claim “sounds like a bad joke or wishful thinking” and told Friedman to “kindly bear in mind that there are more than one way [sic] to skin a cat.”⁶⁶

⁶² Ibid, 1.

⁶³ Ibid., 4.

⁶⁴ Ibid., 24.

⁶⁵ *Shloss v. Sweeney* 515 F. Supp. 1068 (2007).

⁶⁶ *Shloss v. Sweeney* 515 F. Supp. 1068 at 1073 (2007).

The Court denied Defendants' motion to strike three of the claims made by Shloss and the Fair Use Project.

In March 2007, Stephen James Joyce and the Joyce Estate entered into a settlement agreement, enforceable by the court, which allowed Shloss publish this material electronically and also publish a printed supplement to her book *Lucia Joyce: To Dance in the Wake*.⁶⁷ On the question of author remedies, the judge held that the author was eligible for award of reasonable attorney fee and costs, but the copyright owner was not entitled to relief from the settlement agreement or order granting stipulated dismissal with prejudice.⁶⁸ In 2009, the Joyce Estate agreed to pay \$240,000 in attorney's fees to Shloss and her counsel.⁶⁹

Shloss was delighted by this outcome, observing:

The work of literary scholars is inherently transformative. We take the writing of someone whose work we love and share it with others. We keep our human inheritance alive by making it part of a dialog with our peers, our friends, our students and the generations that follow us. When that dialog is interrupted, when we are squeezed between the aggression of literary estates and the apprehensions of publishers, something very important is lost.

I fought not just for Lucia and Joyce, whose words had to be taken out of my book, but for the freedom to consider what happened to them and for the freedom of others to respond to my ideas. 'Fair use' exists to foster this liveliness of mind; its measure is in transformation not in a restrictive counting of words. Everyone who worked on this case understood that something far more important than my particular book was at stake in the fight.⁷⁰

Anthony Falzone, the director of the Fair Use Project, was happy with the outcome: 'Our client got exactly what she asked for in her complaint, and more.'⁷¹

Similarly, Lawrence Lessig observed of the victory:

I am extraordinarily happy that Stanford's Fair Use Project has enabled an academic to do her work. But this is just the first of a series of cases that will be necessary to establish the reality of

⁶⁷ 'Settlement Agreement and Mutual Release between Carol Loeb Shloss, Stephen James Joyce, and Sean Sweeney in his Capacity as the Trustee of the Estate of James Joyce', 25 August 2009.

⁶⁸ *Shloss v. Sweeney* 515 F. Supp. 1083 (2007)

⁶⁹ Anthony Falzone, 'Joyce Estate Pays \$240,000 in Attorneys' Fees to Shloss and her Counsel', Stanford Law School, 28 September 2009, <http://cyberlaw.stanford.edu/node/6265>

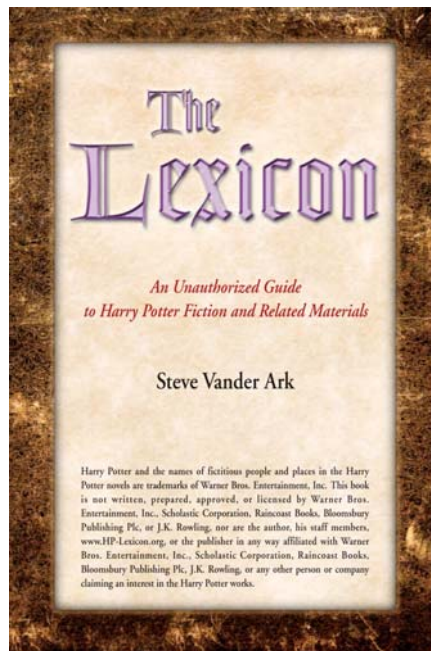
⁷⁰ 'Prof. Carol Shloss settles copyright lawsuit with Joyce Estate', *Stanford Report*, 26 March 2007, <http://news.stanford.edu/news/2007/april4/joyce-040407.html>

⁷¹ 'Stanford Scholar Wins Right to Publish Joyce Material in Copyright Suit', Stanford Law School, 22 March 2007.

creative freedom that the ‘fair use’ doctrine is intended to protect in theory. We will continue to defend academics threatened by overly aggressive copyright holders, as well as other creators for whom the intended protections of ‘fair use’ do not work in practice. I am hopeful that this is the last time this defendant will be involved in an action like this. But it is only the first time that we will be defending academics in these contexts.⁷²

Somewhat more circumspectly, Sean Latham, the editor of the *James Joyce Quarterly*, observed: ‘When launched on the eve of Bloomsday last year, there was considerable hope that it might advance to trial and thus provide scholars with some clearer sense of the precise reach and limits of the ‘fair use’ exception to copyright’.⁷³ He reflected: ‘By essentially conceding the Shloss suit, however, the Estate (perhaps wisely) evaded this larger test.’⁷⁴ In his view, there remained outstanding issues in respect of copyright law and the Estate of James Joyce: ‘When dealing with the Joyce Estate, however, broad fair-use continues to remain all too theoretical.’⁷⁵

3. The Harry Potter Lexicon



http://store.rdrbooks.com/index.php?main_page=popup_image&pID=62

⁷² Ibid.

⁷³ Sean Latham, ‘Raising the Wind’, (2006) 44 (1) *James Joyce Quarterly* 7.

⁷⁴ Ibid.

⁷⁵ Ibid.

The *Harry Potter Lexicon* is a reference guide created by Steven Vander Ark, a former grade school teacher.⁷⁶ He has organised a large volume of material on the Harry Potter books and the Harry Potter films on a website in an alphabetical listing, from 'A-Z'. The founder of RDR Books, Roger Rapoport, approached Ark to publish the *Harry Potter Lexicon* in a book form.⁷⁷ Ark agreed to this request, and provided the publisher with a condensed version of the web-site. This companion text was described by the court in these terms:

The Lexicon is an A-to-Z guide to the creatures, characters, objects, events, and places that exist in the world of *Harry Potter*. As received by the Court in evidence, the Lexicon manuscript is more than 400 type-written pages long and contains 2,437 entries organized alphabetically... The Lexicon entries cull every item and character that appears in the *Harry Potter* works, no matter if it plays a significant or insignificant role in the story. The entries cover every spell (e.g., Expecto Patronum, Expelliarmus, and Incendio), potion (e.g., Love Potion, Felix Felicis, and Draught of Living Death), magical item or device (e.g., Deathly Hallows, Horcrux, Cloak of Invisibility), form of magic (e.g., Legilimency, Occlumency, and the Dark Arts), creature (e.g., Blast-Ended Skrewt, Dementors, and Blood-Sucking Bugbears), character (e.g., Harry Potter, Hagrid, and Lord Voldemort), group or force (e.g., Aurors, Dumbledore's Army, Death Eaters), invented game (e.g., Quidditch), and imaginary place (e.g., Hogwarts School of Witchcraft and Wizardry, Diagon Alley, and the Ministry of Magic) that appear in the *Harry Potter* works.⁷⁸

The resulting work was comparable to other companion books to fantasy series, such as Paul Ford's *Companion to Narnia: A Complete Guide to the Magical World of C.S. Lewis's The Chronicles of Narnia* and George Beahm's *Fact, Fiction, and Folklore in Harry Potter's World: An Unofficial Guide*.⁷⁹

After RDR Books announced its intention to publish the reference book, J.K. Rowling and Warner Brothers brought a legal action in the United States District Court for the Southern District of New York, alleging that the publishers of the *Harry Potter*

⁷⁶ The *Harry Potter Lexicon*, <http://www.hp-lexicon.org/>

⁷⁷ RDR Books, <http://www.rdrbooks.com/>

⁷⁸ *Warner Bros and JK Rowling v RDR Books* 575 F.Supp.2d 513 at 524-5 (2008)

⁷⁹ Paul Ford, *Companion to Narnia: A Complete Guide to the Magical World of C.S. Lewis's The Chronicles of Narnia*. San Francisco: Harper Collins, 2005; and George Beahm, Tim Kirk, and Britton McDaniel. *Fact, Fiction, and Folklore in Harry Potter's World: An Unofficial Guide*. Charlottesville, VA: Hampton Roads Publishing Company, 2005.

Lexicon were in breach of various intellectual property rights.⁸⁰ A spokesperson for Warner Brothers and J.K. Rowling observed:

A fan's affectionate enthusiasm should not obscure acts of plagiarism. The publishers knew what they were doing. The problem remains that the *Lexicon* takes an enormous amount of Ms. Rowling's work and adds virtually no original commentary of its own. As we've said in court, it takes too much and adds too little. Authors have a duty to prevent the exploitation of their works by people who contribute nothing original, creative or interpretive.⁸¹

Initially, the claims of J.K. Rowling and Warner Brothers covered breach of copyright, trade marks, and unfair competition laws.⁸² After pretrial orders, the parties narrowed the claims and defences to be tried: the plaintiffs pursued only their claims for copyright infringement and statutory damages.

The Center for Internet and Society at Stanford Law School has provided legal representation for RDR Books as part of its fair use project.⁸³

The defence lawyer, Anthony Falzone, observed in his opening statement"

Ms. Rowling has indeed created one of the most enchanting and profitable worlds known to the history of literature. The story of how she did it is both remarkable and inspiring. As the creator of the world of Harry Potter, she is used to exercising full power and complete control over what happens in that world. But the power she asserts here today, your Honor, is very different. The question here today before your Honor is whether Ms. Rowling has the power to make the *Lexicon* disappear from our world, never to be seen in libraries or bookstores across the country. So let's start with the *Lexicon* because this case really is about one book. The *Lexicon*. We will show your Honor that the *Lexicon* is nothing like what plaintiffs have described here this morning. The snippets and outtakes that were shown to your Honor simply do not capture the true nature of the *Lexicon*. It is, above all else, a reference guide. And if that term is a label, it is not a self-serving label. It is an accurate label. We'll show your Honor the *Lexicon* was created by Steve Vander Ark with help from many other contributors. Mr. Vander Ark is a librarian by training. He's trained to organize information and help people find it. And that, your Honor, is one thing the *Lexicon* does. It helps organize and discuss what was described to your Honor

⁸⁰ *Warner Bros. Entertainment Inc. and J.K. Rowling v. RDR Books* 07 CIV 9667 (United States District Court for the Southern District of New York, 2007).

⁸¹ Warner Brothers, 'JKR/WB vs RDR Books Trial: Public Statement by Warner Brothers', 16 April 2008.

⁸² *Warner Bros. Entertainment Inc. and J.K. Rowling v. RDR Books* 07 CIV 9667 (United States District Court for the Southern District of New York, 2007).

⁸³ The Center for Internet and Society, Stanford Law School, Fair Use Project, <http://cyberlaw.stanford.edu/taxonomy/term/374>

accurately here as the complicated and elaborate world of Harry Potter. And in that respect, your Honor, it is very much like an encyclopedia. But in addition it provides citations, thousands of citations to the specific places in the voluminous Harry Potter novels and other sources where specific information about specific things and specific characters can be found. In that respect, your Honor, it is a research tool.⁸⁴

Falzone emphasized that ‘A work does not have to be a scholarly work, fit to be published in an academic journal to qualify as transformative’.⁸⁵ He stressed: ‘In fact, that transformative function that is so critical to fair use could be found in a work that simply organizes a lot of information that would otherwise be difficult to find or keep track of like an index does or an Internet search engine does.’⁸⁶

RDR Books maintained that J.K. Rowling and Warner Brothers were over-zealous in their claims of copyright infringement:

J.K. Rowling, author of the Harry Potter books, asserts that this reference guide infringes both her copyright in the seven Potter novels and her right to publish, at some unidentified point in the future, a reference guide of her own. In support of her position she appears to claim a monopoly on the right to publish literary reference guides, and other non-academic research, relating to her own fiction. This is a right no court has ever recognized.⁸⁷

Their lawyers warned that a ruling in favour of J.K. Rowling and Warner Brothers could have a detrimental impact on the publication of a wide range of reference books: ‘If accepted, it would dramatically extend the reach of copyright protection, and eliminate an entire genre of literary supplements: third party reference guides to fiction, which for centuries have helped readers better access, understand and enjoy literary works’.⁸⁸ Moreover, RDR Books add: ‘By extension, it would threaten not just reference

⁸⁴ Trial Transcripts in *Warner Bros. Entertainment Inc. and J.K. Rowling v. RDR Books* 07 CIV 9667 (United States District Court for the Southern District of New York, 14 April 2008), p. 29, <http://cyberlaw.stanford.edu/node/5748>

⁸⁵ Ibid.

⁸⁶ Ibid.

⁸⁷ Opposition of RDR Books in *Warner Bros. Entertainment Inc. and J.K. Rowling v. RDR Books* 07 CIV 9667 (United States District Court for the Southern District of New York, 2007), p. 1, <http://cyberlaw.stanford.edu/system/files/Final+Memo+in+Opposition+to+Rowling%27s+PI+M+oiton.pdf>

⁸⁸ Ibid., p. 1.

guides, but encyclopedias, glossaries, indexes, and other tools that provide useful information about copyrighted works.’⁸⁹

The lawyers argued that RDR Books was protected by the defence of fair use under United States copyright law:

The fair use doctrine protects the right to use copyrighted material for new and transformative purposes. Here, it protects RDR’s right to publish the Lexicon, a valuable reference tool that helps readers to better access, understand and enjoy the Harry Potter works.⁹⁰

RDR Books suggests that the doctrine of fair use is a ‘critical First Amendment safeguard designed to prevent copyright law from unduly burdening free speech.’⁹¹ The attorneys submit that the *Harry Potter Lexicon* has value as an organizational tool: ‘The Lexicon organizes, synthesizes and discusses this mass of information in the form of a reference volume that makes it easier for readers to locate, access, and understand the information that is spread across so many disparate sources.’⁹² Moreover, it was argued that the *Harry Potter Lexicon* offers original commentary and analysis: ‘In addition to this analysis, the Lexicon decodes the meaning of many geographical and historical references, folklore and literary allusions, and provides etymologies of invented terms and names, as well as translates cross-cultural references used in the Harry Potter series.’⁹³ Furthermore, in its view, ‘the Lexicon incorporates additional research and new information about the characters and things that appear in them.’⁹⁴

In the landmark 2008 case of *Warner Bros and J.K. Rowling v. RDR Books*, Patterson J of the United States District Court for the Southern District of New York held that the publishers of the Harry Potter Lexicon infringed the copyright of J.K. Rowling and Warner Brothers in such works as the *Harry Potter* series, *Fantastic Beasts & Where to Find Them*, and *Quidditch Through the Ages*.⁹⁵

In the key ratio in his ruling in *Warner Bros and J.K. Rowling v. RDR Books*, Patterson J held: ‘In striking the balance between the property rights of original authors and the freedom of expression of secondary authors, reference guides to works of

⁸⁹ Ibid., p. 1.

⁹⁰ Ibid., p. 5.

⁹¹ Ibid., p. 6.

⁹² Ibid., p. 8.

⁹³ Ibid., p. 10.

⁹⁴ Ibid., p. 11.

⁹⁵ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 (2008).

literature should generally be encouraged by copyright law as they provide a benefit [to] readers and students; but to borrow from Rowling's overstated views, they should not be permitted to 'plunder' the works of original authors, 'without paying the customary price' lest original authors lose incentive to create new works that will also benefit the public interest.⁹⁶ His Honour ruled:: 'Ultimately, because the Lexicon appropriates too much of Rowling's creative work for its purposes as a reference guide, a permanent injunction must issue to prevent the possible proliferation of works that do the same, and thus deplete the incentive for original authors to create new works'.⁹⁷

Taking into account the various factors and considerations involved a fair use determination, Patterson J held that the defendants, RDR Books, had failed to raise the affirmative defence of fair use.

In the course of his judgment, Patterson J paid close attention to past precedents dealing with guidebooks to *Seinfeld*, *Star Trek*, and *Twin Peaks*.⁹⁸ His Honour held that the case of the Harry Potter Lexicon could be distinguished from these past precedents:

Its function as a reference guide distinguishes the Lexicon from the secondary work at issue in *Castle Rock*, a 132-page book of trivia about the events and characters depicted in *Seinfeld*. Despite its specious claims to critique and expose the *Seinfeld* series, the trivia book served no purpose but 'to satiate *Seinfeld* fans' passion' for the series and simply 'repackage[d] *Seinfeld* to entertain *Seinfeld* viewers.' A statement by the book's creators on the back cover, urging readers to 'open this book to satisfy [their] between-episode [*Seinfeld*] cravings,' belied its transformative purpose. By contrast, the Lexicon seeks not to entertain but to aid the reader or student of *Harry Potter* by providing references about the elements encountered in the series. The Lexicon's purpose as a reference guide also distinguishes it from the books at issue in *Twin Peaks* and *Paramount Pictures*.⁹⁹

The judge also acknowledged a range of other precedents on copyright law and fair use relating to biographies about United States Presidents, and Elvis;¹⁰⁰ derivative works,

⁹⁶ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 551(2008).

⁹⁷ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 553 (2008).

⁹⁸ *Twin Peaks Productions Inc. v. Publications International Limited* 996 F. 2d. 1366 (2d Cir. 1993); *Paramount Pictures Corp. v. Carol Publishing Group* 11 F. Supp. 2d 329 (SDNY 1998) ('*Star Trek*' case), and *Castle Rock Entertainment v. Carol Publishing Group* 955 F. Supp 360 (SDNY 1997) ('*Seinfeld*' case).

⁹⁹ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 542-543 (2008).

¹⁰⁰ *Harper & Row*, 471 U.S. 562 (1985); and *Elvis Presley Enters., Inc. v. Passport Video*, 349 F.3d 622 (9th Cir.2003).

such as the Beanie Babies;¹⁰¹ as well as books illustrating the work of the Grateful Dead,¹⁰² and parodies of *Gone with the Wind*.¹⁰³

Considering the purpose and character of the use, Patterson J recognised that ‘the purpose of the Lexicon's use of the *Harry Potter* series is transformative’.¹⁰⁴ The judge noted: ‘To fulfill this function, the Lexicon identifies more than 2,400 elements from the *Harry Potter* world, extracts and synthesizes fictional facts related to each element from all seven novels, and presents that information in a format that allows readers to access it quickly as they make their way through the series’.¹⁰⁵ Patterson J, though, held that the Harry Potter Lexicon was insufficiently and inconsistently transformative:

The transformative character of the Lexicon is diminished, however, because the Lexicon's use of the original *Harry Potter* works is not consistently transformative. The Lexicon's use lacks transformative character where the Lexicon entries fail to ‘minimize[] the expressive value’ of the original expression. As discussed more fully in analyzing the ‘amount and substantiality’ factor, the Lexicon copies distinctive original language from the *Harry Potter* works in excess of its otherwise legitimate purpose of creating a reference guide. Perhaps because Vander Ark is such a *Harry Potter* enthusiast, the Lexicon often lacks restraint in using Rowling's original expression for its inherent entertainment and aesthetic value. The Lexicon also lacks transformative character where its value as a reference guide lapses.¹⁰⁶

Furthermore, the judge noted that the *Harry Potter Lexicon* had an ultimately commercial purpose: ‘Seeking to capitalize on a market niche does not necessarily make Defendant's use non-transformative, but to the extent that Defendant seeks to ‘profit at least in part from the inherent entertainment value’ of the original works, the commercial nature of the use weighs against a finding of fair use.’¹⁰⁷

The reasoning of the judge lacks clarity on the question of transformative use. It is unclear from the judgment where one would draw the line between ‘strong’ and ‘weak’ transformative uses.

¹⁰¹ *Ty, Inc. v. Publications International Ltd* 292 F.3d 512 (7th Cir.2002).

¹⁰² *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 608 (2d Cir.2006).

¹⁰³ *Suntrust Bank v. Houghton Mifflin Company*, 268 F 3d 1257 (11th Cir, 2001) (‘Gone with the Wind’ case).

¹⁰⁴ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 541 (2008).

¹⁰⁵ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 541 (2008).

¹⁰⁶ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 544 (2008).

¹⁰⁷ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 545 (2008).

Analysing the nature of the copyright work, the judge held: ‘In creating the *Harry Potter* novels and the companion books, Rowling has given life to a wholly original universe of people, creatures, places, and things.’¹⁰⁸ He ruled: ‘Such highly imaginative and creative fictional works are close to the core of copyright protection, particularly where the character of the secondary work is not entirely transformative.’¹⁰⁹

In respect of the amount and substantiality of use, Patterson J admitted: ‘Determining how much copying of fictional facts and plot elements from the *Harry Potter* series is reasonably necessary to create a useful and complete reference guide presents a difficult task.’¹¹⁰ The judge held: ‘While it is difficult to draw the line at each entry that takes more than is reasonably necessary from the *Harry Potter* series to serve its purposes, there are a number of places where the Lexicon engages in the same sort of extensive borrowing that might be expected of a copyright owner, not a third party author.’¹¹¹ He noted in a footnote that ‘the Lexicon borrows from the Harry Potter works with approximately the same liberty that the *Companion to Narnia*, written by third-party author Paul F. Ford and published by copyright holder HarperCollins, borrows from C.S. Lewis’s *The Chronicles of Narnia*.’¹¹² The judge also adds that the ‘Lexicon’s use of copyrighted expression from Rowling’s two companion books presents an easier determination’ because it ‘takes wholesale from these short books’.¹¹³

On the question of market harm, the judge observed that ‘there is no plausible basis to conclude that publication of the Lexicon would impair sales of the *Harry Potter* novels’.¹¹⁴ Patterson J noted: ‘Children may be an elusive market for book publishers, but it is hard to believe that a child, having read the Lexicon, would lose interest in reading (and thus his or her parents’ interest in purchasing) the *Harry Potter* series’.¹¹⁵ The judge suggested: ‘The Lexicon is thus unlikely to serve as a market substitute for the *Harry Potter* series and cause market harm.’¹¹⁶

¹⁰⁸ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 549 (2008).

¹⁰⁹ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 549 (2008).

¹¹⁰ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 548 (2008).

¹¹¹ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 548 (2008).

¹¹² *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 548 (2008).

¹¹³ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 548 (2008).

¹¹⁴ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 550 (2008).

¹¹⁵ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 550 (2008).

¹¹⁶ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 550 (2008).

However, the judge was of the view that the ‘publication of the Lexicon could harm sales of Rowling's two companion books’.¹¹⁷ Patterson J emphasized: ‘Unless they sought to enjoy the companion books for their entertainment value alone, consumers who purchased the Lexicon would have scant incentive to purchase either of Rowling's companion books, as the information contained in these short works has been incorporated into the Lexicon almost wholesale.’¹¹⁸ The judge concluded: ‘Because the Lexicon's use of the companion books is only marginally transformative, the Lexicon is likely to supplant the market for the companion books’.¹¹⁹ Accordingly, Patterson J held: ‘In view of the market harm to Rowling's companion books, the fourth factor tips in favor of Plaintiffs’.¹²⁰

This part of the judgment is brittle. The judge draws a quibbling distinction between the market impact of the *Harry Potter Lexicon* upon the series of seven books, and the companion works. Arguably, this point of the judgment would be vulnerable, if there was an appeal against the decision.

In conclusion, Patterson J held that RDR Books had failed to establish its affirmative defence of fair use:

The fair-use factors, weighed together in light of the purposes of copyright law, fail to support the defense of fair use in this case. The first factor does not completely weigh in favor of Defendant because although the Lexicon has a transformative purpose, its actual use of the copyrighted works is not consistently transformative. Without drawing a line at the amount of copyrighted material that is reasonably necessary to create an A-to-Z reference guide, many portions of the Lexicon take more of the copyrighted works than is reasonably necessary in relation to the Lexicon's purpose. Thus, in balancing the first and third factors, the balance is tipped against a finding of fair use. The creative nature of the copyrighted works and the harm to the market for Rowling's companion books weigh in favor of Plaintiffs.¹²¹

This ‘balancing of factors’ approach is questionable. The great treatise writer, William Patry, has been critical of the ‘aggregate assessment’ approach of courts to the interpretation of the doctrine of fair use.¹²² He suggests: ‘Courts will be more faithful to

¹¹⁷ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 550 (2008).

¹¹⁸ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 550 (2008).

¹¹⁹ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 550 (2008).

¹²⁰ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 551 (2008).

¹²¹ *Warner Bros and JK Rowling v. RDR Books* 575 F.Supp.2d 513 at 551 (2008).

¹²² William Patry, ‘The Fair Use Doctrine: Fair Use as a Common-Law Analysis’, *Patry on Copyright*, Chapter 10:8.50, updated September 2008.

the doctrine's common-law roots and role, as well as to Congress's intent if they act like common-law judges and not as interpreters of a statute that cannot, in fact, be interpreted, nor should there be a fear that such common-law adjudication will lead to unacceptable levels of uncertainty'.¹²³ Patry contends: 'Fair use determinations are inherently and unavoidably judgment calls: predictability can be achieved only by constraining the discretionary nature that lies at the heart of the doctrine.'¹²⁴

Patterson J cautioned, though, that other reference books and literary supplements could be protected by the defence of fair use, if they were sufficiently transformative. The judge noted: 'Notwithstanding Rowling's public statements of her intention to publish her own encyclopedia, the market for reference guides to the *Harry Potter* works is not exclusively hers to exploit or license, no matter the commercial success attributable to the popularity of the original works.'¹²⁵ He emphasized that 'the market for reference guides does not become derivative simply because the copyright holder seeks to produce or license one.'¹²⁶ The judge emphasized: 'While the Lexicon, in its current state, is not a fair use of the *Harry Potter* works, reference works that share the Lexicon's purpose of aiding readers of literature generally should be encouraged rather than stifled.'¹²⁷

The Stanford Law School Fair Use Project represented RDR Books. The lawyer, Anthony Falzone, reflected upon the decision: 'Reference guides and companion books about literary works have been a critically important part of literature since its inception, and the right to publish them stood largely unchallenged'.¹²⁸ The lawyer explained the involvement of the clinic: 'We agreed to help defend the Harry Potter Lexicon because J.K. Rowling's claims threatened that right, and because we believe the fair use doctrine protects the Lexicon, and other publications like it.'¹²⁹ Falzone commented on the ruling:

¹²³ Ibid.

¹²⁴ Ibid.

¹²⁵ Ibid. at 538.

¹²⁶ Ibid. at 550.

¹²⁷ Ibid. at 553.

¹²⁸ Anthony Falzone, 'Ava Kedavra – The Harry Potter Lexicon Disappears', The Stanford Law School Fair Use Project, 8 September 2008, <http://cyberlaw.stanford.edu/case/rowling-v-rdr-books>

¹²⁹ Ibid.

In a thoughtful and meticulous decision spanning 68 pages, the Court recognized that as a general matter authors do not have the right to stop publication of reference guides and companion books about literary works, and issued an important explanation of why reference guides are not derivative works. Needless to say, we're very happy the Court vindicated these important principles. But the Lexicon did not fare so well. The Court held the Lexicon infringed Ms. Rowling's copyright, was not protected by fair use, and permanently enjoined the publication of it.¹³⁰

Falzone noted: 'Careful and thoughtful as the decision is, we think it's wrong'.¹³¹ He acknowledged the efforts of the publisher: 'In the meantime, thank Roger Rapoport, the Publisher of RDR Books for having the courage to stand up for free speech and fair use'.¹³² Falzone also acknowledged the author, Steve Vander Ark, noting: 'It's not easy to stand up to your hero, or bear the unjustified scorn of your fellow fans.'¹³³

For his part, Steve Vander Ark was undaunted, publishing a shortened, edited version of his book with RDR Books, called *The Lexicon: An Unauthorized Guide to Harry Potter Fiction*.¹³⁴ This work has been edited, so that it stays within the confines of the interpretation of the defence of fair use. There is little in the way of direct quotes from the expression of the Harry Potter texts; careful control in the use of paraphrasing; and a much greater amount of commentary, criticism, and review. Particular care has been taken with the secondary works associated with the Harry Potter series. The entry, for instance, for 'Quidditch Through the Ages', refers to the reader to J.K. Rowling's work: 'We do not reproduce that information in here; instead, we encourage you to buy a copy of Quidditch Through The Ages for yourself and find out more.'¹³⁵ The book has an extensive disclaimer on the front cover - denying any authorisation or association with any of the copyright owners and trademark owners associated with the Harry Potter franchise. Steve Vander Ark has also published a travel book entitled *Looking for Harry Potter*, which seeks to detail the urban and rural places in the United Kingdom, which inspired by the Harry Potter series.¹³⁶

¹³⁰ Ibid.

¹³¹ Ibid.

¹³² Ibid.

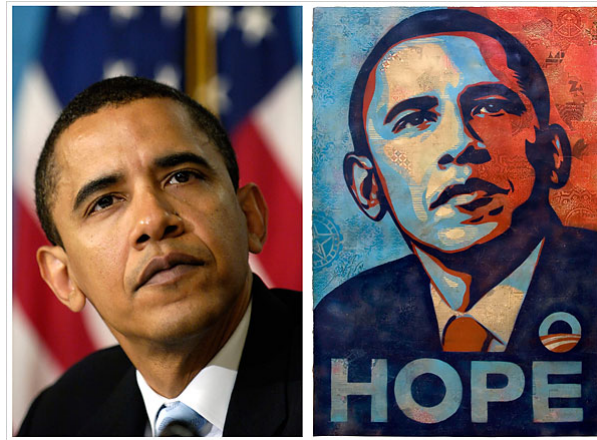
¹³³ Ibid.

¹³⁴ Steve Vander Ark, *The Lexicon: An Unauthorized Guide to Harry Potter Fiction*, RDR Books, January 2009.

¹³⁵ Ibid, 256.

¹³⁶ Steve Vander Ark, *Looking for Harry Potter*, Methuen Publishing Ltd, 2008.

4. The Shepard Fairey Hope Poster



In 1989, Shepard Fairey first came to prominence with a series of stickers, street posters, and stencils that combined the words ‘Andre the Giant Has a Posse’ with the visage of wrestling superstar, Andre the Giant. Shepard Fairey discusses his street art:

I became active as a street artist because I felt public space was the only option for free speech and expression without bureaucracy. The Internet was not developed at the time I started, and though it does level the playing field for some things, it still filters out those who do not have a computer. I also didn’t really consider what I was doing to be art, and considered the art galleries too elitist anyway. I also found the whole idea that you could be arrested for stickering or posterizing as something I wanted to rebel against. In my opinion, the taxpayers are the bosses of the government. I’m a taxpayer – why can’t I use public space for my imagery when corporations can use it for theirs?¹³⁷

In 1993 Titan Sports, Inc. - now World Wrestling Entertainment, Inc. - threatened to sue Fairey for violating their trademarked name, Andre the Giant.¹³⁸ In response, Fairey altered the portrait of the famous wrestler, combining the new image with the word, ‘Obey’. Fairey’s self-titled ‘absurdist propaganda’ campaign.

In *The Obey Manifesto*, Shepard Fairey explained the logic behind the sticker and stencil campaign: ‘The OBEY sticker attempts to stimulate curiosity and bring

¹³⁷ Shepard Fairey and others, *Obey, Supply & Demand: The Art of Shepard Fairey*, Berkeley (CA), Gingko Press and Obey Giant, 2009, p.94.

¹³⁸ Mark Vallen, ‘Obey Plagiarist Shepard Fairey’, Art for Change, December 2007, <http://www.art-for-a-change.com/Obey/index.htm>

people to question both the sticker and their relationship with their surroundings'.¹³⁹ He comments: 'Because people are not used to seeing advertisements or propaganda for which the product or motive is not obvious, frequent and novel encounters with the sticker provoke thought and possible frustration, nevertheless revitalizing the viewer's perception and attention to detail.'¹⁴⁰ In his view, the sticker campaign was a phenomenological experiment: 'Because OBEY has no actual meaning, the various reactions and interpretations of those who view it reflect their personality and the nature of their sensibilities.'¹⁴¹

In a recent exhibition of his portraits, Shepard Fairey explained that 'iconography is everything'.¹⁴² In his opinion, 'In my art and design career, most of the work I've created has revolved around the incorporation of emblematic elements that serve as reference points for certain ideas'.¹⁴³ He observed: 'When I make a portrait, I try to capture the whole person, not just how they look but their iconic essence'.¹⁴⁴ Fairey explained his artistic intentions behind the Obama poster:

As important as I think it is for people to question everything, its equally important for people to stand behind the things they believe in. Because I knew I stood behind Barack Obama one hundred percent, I wanted people who may have never even heard about Obama or his principles to see this portrait of him and immediately see that he was a man of vision, thoughtfulness and idealism. Once enough people had seen it, it became the icon of the campaign. Just as Obama had represented all the qualities I wanted to see in a leader, the portrait came to be a representation of everything that drew people to Obama. In a way, the power of the icon was that it made him iconic.¹⁴⁵

Michael Desmond observes of his portraits: 'Fairey's posters admit a debt to the example of Pop artist, Andy Warhol, to Russian Constructivist posters of the 1920s to South American posters of the 1950s'.¹⁴⁶ He notes: 'His political posters exude a strong

¹³⁹ Shepard Fairey and others, 'The Obey Manifesto', *Obey, Supply & Demand: The Art of Shepard Fairey*, Berkeley (CA), Gingko Press and Obey Giant, 2009, p, 5.

¹⁴⁰ Ibid.

¹⁴¹ Ibid.

¹⁴² Shepard Fairey, 'Obey: Shepard Fairey Posters', National Portrait Gallery, Canberra, 18 September 2009- January 2010.

¹⁴³ Ibid.

¹⁴⁴ Ibid.,.

¹⁴⁵ Ibid.

¹⁴⁶ Ibid.

retro appeal coupled with a particular knowing innocence, steeped as they are in the nostalgic optimism of social change'.¹⁴⁷

In his 20 year retrospective book, Fairey elaborates upon his design of the Obama posters for the Obama campaign:

One of the things that really inspired me to make art for the Obama campaign was that they recognized the importance of art and design, especially in engaging a younger audience. The campaign clearly put thought and effort into it, deviating from conventional boilerplate campaign art, but only to the point that it wasn't off-putting to the mainstream. I strived for that in my Obama images, trying to make something that would resonate with my audience, while engaging people outside the sphere of counterculture. People wanted me to do an Obey-style logo, but that would have just looked like an irreverent counterculture image, and I didn't want to pigeonhole Obama and his supporters as rebels. I wanted this to be a universal image with the power to unite people.

The response to my original (unauthorized) 'Progress' and 'Hope' images was so strong that the Obama campaign reached out to me and asked me to donate an illustration in the same style since they couldn't use what I'd done because they didn't have the rights to the photo and because it was something that had been disseminated illegally at times. I just wanted Obama to get elected, so I was willing to do anything. I did the illustration for the 'Change' image ...[on] January 31st, 2008. The Obama campaign sold 5,000 posters on their website for \$75 each, raising \$375,000 total, and they also did versions on thinner paper for promotional use.¹⁴⁸

In an interview, he noted: 'I don't think the artist has a job to comment on politics, but my favourite art has something provocative about it and communicates a point of view'.¹⁴⁹ Fairey said: 'With street art, there is this 'medium is the message' principal, but it's an act of defiance and rebellious in nature, and that politicizes it'.¹⁵⁰ The poster artist makes the caveat: 'But that doesn't mean a street artist should just assume that whatever they're doing is groundbreaking and political because it's on the street'.¹⁵¹ Fairey observes that his model is the British guerrilla artist, BANKSY: 'I like work that looks nice but has a point of view and a sense of humor.'¹⁵²

¹⁴⁷ Ibid.

¹⁴⁸ Shepard Fairey and others, *Obey, Supply & Demand: The Art of Shepard Fairey*, Berkeley (CA), Gingko Press and Obey Giant, 2009, p. 271.

¹⁴⁹ Ibid., p. 273.

¹⁵⁰ Ibid., p. 273.

¹⁵¹ Ibid., p. 273.

¹⁵² Ibid., p. 273.

One of the most thoughtful commentaries on the Obama poster is the series of annotations by Ben McCorkle.¹⁵³ The critic observes: ‘During the presidential campaign melee of 2008, culture jammer, guerrilla sticker graffittist, Andre the Giant acolyte, and anti-authoritarian skateboard artist Shepard Fairey created what is widely considered one of the most recognizable pieces of political visual rhetoric to emerge in American culture in quite some time: the Barack Obama ‘HOPE’ poster’.¹⁵⁴ McCorkle notes the impact of the poster: ‘Although not originally part of the official campaign branding, the design proved so popular that the poster became something of a viral phenomenon, seamlessly playing into the Obama campaign's overall ambience’.¹⁵⁵

McCorkle identifies five distinctive features of Fairey’s design, which captivated viewers. First, he suggests that the poster works in a tradition of agitprop and inspirational portraits: ‘Fairey's design, which depicts Obama in a contemplative, almost heroic pose, bears more than a passing resemblance to the ‘High Red’ propaganda poster aesthetic that has immortalized the likes of Che, Lenin, and Chairman Mao (Fairey himself admits being influenced by Jim Fitzpatrick's iconic Guevara poster)’.¹⁵⁶ Second, McCorkle highlights the distinctive use of colour in the picture, and wonders whether Fairey is playing with the concept of racial transcendence: ‘Obama's skin is superimposed with a red, white, and blue overlay, re-marking him as a new symbol of (patriotic) color’.¹⁵⁷ He also suggests that the palette is muted: ‘To my eye, this decision lends the image a nostalgic quality, and it occurs to me that the palette might function subtly to combat nagging perceptions of Obama's inexperience (green-ness)’.¹⁵⁸ Third, McCorkle observes ‘Fairey's design utilizes familiar urban tools like stencils, Sharpies, and spray paint, but it also incorporates the more provincial element of hatching, a technique commonly used in etchings, engravings, or woodcuts’.¹⁵⁹ Fourth, McCorkle highlights the use of words in the posters – ‘HOPE’, ‘CHANGE’ and ‘PROGRESS’.¹⁶⁰ He comments: ‘The all-caps, sans serif font, in keeping with the official campaign

¹⁵³ Ben McCorkle, ‘The Annotated Obama Poster’, Harlot: A Revealing Look at the Arts of Persuasion, 2009, No 2, <http://www.harlotofthearts.org/index.php/harlot/article/viewArticle/29/18>

¹⁵⁴ Ibid.

¹⁵⁵ Ibid.

¹⁵⁶ Ibid.

¹⁵⁷ Ibid.

¹⁵⁸ Ibid.

¹⁵⁹ Ibid.

¹⁶⁰ Ibid.

branding, adds to the effect, vacillating between static and iconic (the nominal representation of ‘thingness’) and loud and vocal.’¹⁶¹ Fifth, McCorkle considers the question of copyright law and artistic appropriation. He wonders: ‘If an artist reappropriates an image into one of the most iconic political posters of all time and no one notices it for several months, does it make a sound argument for Fair Use?’¹⁶² McCorkle comments: ‘Multimodal compositionists are sure to be watching, collective breath bated, how this tale unfolds, as it is the first major copyright case of the digital age’.¹⁶³ In his view, ‘The outcome will likely establish a precedent that will have a far-reaching impact on those who create (or have their students create) mashups, parodies, collages, montages, and similar digital texts that often incorporate other content’.¹⁶⁴ Finally, McCorkle notes that the poster is spoof-worthy, encouraging replication and transformative use: ‘Like Apple’s iPod ads and the ‘got milk?’ campaign, the simple graphic design makes Fairey’s poster ripe for spoofing in a variety of cultural contexts: political, popular, religious, etc’.¹⁶⁵ Indeed, there have been endless parodies and spoofs of the Shepard Fairey posters – featuring everyone from Vice Presidential candidate, Sarah Palin, to the Swedish Chef from *The Muppets*.

The poster campaign was a remarkable success, with Fairy distributing 300,000 stickers and 500,000 posters during the election campaign. He used poster and fine art sales to support such electioneering. As thanks for his efforts, Fairey received a formal letter of gratitude from Barack Obama for his contribution to his 2008 presidential campaign. The letter stated:

I would like to thank you for using your talent in support of my campaign. The political messages involved in your work have encouraged Americans to believe they can change the status-quo. Your images have a profound effect on people, whether seen in a gallery or on a stop sign. I am privileged to be a part of your artwork and proud to have your support. I wish you continued success and creativity.¹⁶⁶

¹⁶¹ Ibid.

¹⁶² Ibid.

¹⁶³ Ibid.

¹⁶⁴ Ibid.

¹⁶⁵ Ibid.

¹⁶⁶ Shepard Fairey and others, *Obey, Supply & Demand: The Art of Shepard Fairey*, Berkeley (CA), Gingko Press and Obey Giant, 2009, p. 273.

At the same time, Associated Press threatened an action for copyright infringement, alleging that the Poster used a substantial part of one of its photographs, apparently taken by photographer Mannie Garcia, which depicts Obama at a panel discussion at the National Press Club in April 2006 with actor George Clooney.

In February 2009, the Fair Use Project filed a law suit on behalf of Shepard Fairey ‘to vindicate the rights of visual artist Shepard Fairey and Obey Giant in connection with the series of iconic works Fairey created to support the candidacy of President Barack Obama.’¹⁶⁷ It noted: ‘Fairey’s work became a ubiquitous symbol of Obama’s historic presidential campaign and stood as powerful symbols of Obama’s grassroots support.’¹⁶⁸ The Fair Use Project observed: ‘Fairey and Obey Giant bring this action to clarify the rights of the parties, and to refute the AP’s baseless assertions of copyright infringement finally and definitively’.¹⁶⁹ Moreover, ‘Fairey and Obey Giant seek a declaratory judgment holding Fairey’s works do not infringe any copyrights held by Defendant AP and are protected by the Fair Use Doctrine. Fairey and Obey Giant also seek an injunction enjoining Defendant AP and its agents from asserting its copyrights against Fairey, Obey Giant, or any other party in possession of the works at issue.’¹⁷⁰

The Fair Use Project raised four grounds in its law suit. First, the Fair Use Project questioned whether the Shephard Fairey had infringed any copyright works: ‘An actual controversy exists as to whether the Obama Works infringe any copyright owned by the AP’.¹⁷¹ The Fair Use Project argued: ‘Even insofar as the AP owns the copyrights to the Garcia Photograph, the Obama Works do not infringe any of the exclusive rights secured by the Copyright Act. Fairey and Obey Giant are therefore entitled to a declaration that the Obama Works do not infringe any copyrights owned by the AP.’¹⁷²

¹⁶⁷ *Fairey v. Associated Press* 09-01123 (AKH) United States District Court for the Southern District of New York (2009) http://cyberlaw.stanford.edu/biguploads/Fairey_v_AP_complaint_with_exhibits.pdf

¹⁶⁸ Ibid. 1.

¹⁶⁹ Ibid. 1.

¹⁷⁰ Ibid., 1.

¹⁷¹ Ibid., 10.

¹⁷² Ibid., 10.

Second, the Fair Use Project argued that there was an ‘actual controversy exists as to whether Fairey’s use of any materials to which the AP holds copyrights is protected by the Fair Use Doctrine.’¹⁷³ The Fair Use Project elaborated upon its claims:

Fairey used the Garcia Photograph as a visual reference for a highly transformative purpose; Fairey altered the original with new meaning, new expression, and new messages; and Fairey did not create any of the Obama Works for the sake of commercial gain.

The Garcia Photograph had been published well before Fairey used it as a visual reference, and is a factual, not fictional or highly creative, work.

Fairey used only a portion of the Garcia Photograph, and the portion he used was reasonable in light of Fairey’s expressive purpose.

Fairey’s use of the Garcia Photograph imposed no significant or cognizable harm to the value of the Garcia Photograph or any market for it or any derivatives; on the contrary, Fairey has enhanced the value of the Garcia photograph beyond measure.¹⁷⁴

Accordingly, the Fair Use Project argued that ‘Fairey and Obey Giant are therefore entitled to a declaratory judgment that the use of the Garcia Photograph as a visual reference in creating the Obama Works is protected by the Fair Use Doctrine’.¹⁷⁵

Third, the Fair Use Project raised constitutional arguments, maintaining that the ‘Defendant’s counterclaims are barred in whole or in part by the First Amendment of the United States Constitution’.¹⁷⁶

Fourth, the Fair Use Project complained that Associated Press had ‘unclean hands’:

Defendant’s counterclaims are barred in whole or in part by the equitable doctrine of unclean hands. Specifically, The AP claims copyright ownership in, and makes commercial use of, many photographs that consist almost entirely of copyrighted artwork of Fairey and other artists without permission. Copies of these photographs are offered for sale and licensed for use by The AP through its image licensing database available at <http://www.apimages.com>.¹⁷⁷

¹⁷³ Ibid., 11.

¹⁷⁴ Ibid. 11.

¹⁷⁵ Ibid. 11.

¹⁷⁶ ‘Answer and Affirmative Defenses of Plaintiffs and Counterclaims in *Fairey v. Associated Press* 09-01123 (AKH) United States District Court for the Southern District of New York (2009)’, 21.

¹⁷⁷ Ibid, 22.

In particular, the Fair Use Project pointed out that Associated Press's image database contained reproductions of Fairey's Obama Hope Mural, Fairey's Posters, Fairey's Portraits, post-modernist artist Jeff Koons' *Ushering in Banalities*, Banksy's *Sketch of Essex Road*, and Harings' *Hope*. Anthony Falzone alleged: 'The AP applies an obvious double-standard. It is happy to sell, through its image licensing database, photographs that are really just bare copies of artists' work, yet it condemns Fairey for using an AP photograph in a far more creative, transformative, expressive and defensible way.'¹⁷⁸ He maintained: 'If The AP's bare copies of other artists' work are protected by fair use, then Fairey's significantly more transformative and expressive work has to be, too.'¹⁷⁹

In response, the Associated Press vigorously replied that Fairey had infringed its copyright.¹⁸⁰ The newspaper complained:

The AP's claims arise out of Plaintiffs' willful and blatant violation of The AP's copyright in a photograph of President Obama, taken by The AP staff photographer Mannie Garcia in April 2006. Plaintiffs have used the Obama Photo without The AP's consent in violation of the Copyright Act of 1976, as amended. Namely, Counterclaim Defendants Shepard Fairey, Obey Giant Art, Inc., Obey Giant LLC and Studio Number One, Inc. fully aware that the Obama Photo was a copyrighted image, misappropriated The AP's rights in that image by developing a series of posters and other merchandise based on the Obama Photo and selling such merchandise through various distribution channels. The Infringing Works copy all the distinctive and unequivocally recognizable elements of the Obama Photo in their entire detail, retaining the heart and essence of The AP's photo, including but not limited to its patriotic theme.¹⁸¹

The Associated Press protested: 'Nowhere in Plaintiffs' Complaint for a declaratory judgment and other relief do they mention that they have made, and continue to make, substantial revenue from the Infringing Works'.¹⁸² The newspaper group insisted that 'the fair use doctrine cannot be contorted to permit Fairey to wholly replicate a photographer's prescient photograph and exploit it for his own commercial benefit in utter disregard of The AP's long-established licensing program, which provides needed

¹⁷⁸ Anthony Falzone, 'AP Issues Statement About Fairey's Answer, Misses Point Entirely' 16 April 2009, <http://cyberlaw.stanford.edu/node/6160>

¹⁷⁹ Ibid.

¹⁸⁰ 'Answer, Affirmative Defenses and Counterclaims of Defendant, The Associated Press in *Fairey v. Associated Press* 09-01123 (AKH) United States District Court for the Southern District of New York (2009)', http://www.ap.org/iprights/Answer_and_Counterclaims_of_Associated_Press.pdf

¹⁸¹ Ibid., 10.

revenue to support The AP's not-for-profit mission of reporting the news as well as funding The AP's charitable efforts'.¹⁸³

In its counterclaim, the Associated Press claimed that there was, first, copyright infringement: 'Faurey has infringed and will continue to infringe The AP's copyright in the Obama Photo by using this original copyrighted photograph as a basis for the Infringing Works without permission.'¹⁸⁴ Second, the group alleged that Faurey had committed contributory copyright infringement – 'Faurey actively promotes the infringements through the purchase of products and merchandise bearing the Infringing Works, provide tools that are indispensable to these infringements, and continuously facilitate the infringements.'¹⁸⁵ Third, the Associated Press sought a declaratory judgment that Faurey had engaged in fraud: 'Faurey improperly obtained copyright registrations in three of the Infringing Works, which are unauthorized derivative works, Registration Nos. VA0001651320, VA0001651318, and VA0001651319'.¹⁸⁶ Fourth, the Associated Press alleged that Faurey had breached the protection under the *Digital Millennium Copyright Act* 1998 (US) in respect of electronic rights management information: 'Upon information and belief, Faurey, without authority of The AP or the law, has intentionally removed and/or altered and has caused and induced others to remove and/or alter copyright management information from The AP's Obama Photo, including for use in the Infringing Works, and have thereafter distributed said works, having reasonable grounds to know that such acts will induce, enable, facilitate or conceal an infringement of copyright under Title 17, United States Code, in violation of 17 U.S.C. § 1202(b)(1) and (3).'¹⁸⁷ There are existing precedents dealing with artistic works and electronic rights management information.¹⁸⁸

To complicate matters further, Mannie Garcia, the photographer who took the picture Obama, entered into the case, claiming that he was never an Associated Press employee, but was the creative author and is the rightful owner of the photograph

¹⁸² Ibid., 12.

¹⁸³ Ibid., 13-14.

¹⁸⁴ Ibid., 48.

¹⁸⁵ Ibid., 50.

¹⁸⁶ Ibid., 50.

¹⁸⁷ Ibid., 152.

¹⁸⁸ *IQ Group, Limited. v. Wiesner Publishing, LLC*, 409 F.Supp.2d 587, 596 (D.N.J.2006); *Textile Secrets Intern., Inc. v. Ya-Ya Brand Inc.* 524 F.Supp.2d 1184 C.D.Cal.,2007; and *Gregerson v. Vilana Fin. Inc.* Slip Copy, 2008 WL 451060 D.Minn.,2008 (removal of digitally embedded watermark)

referenced multiple times in the Complaint as the ‘Garcia Photograph’. The Associated Press denied that Garcia was an independent contractor:

AP clearly owns the copyright in the photograph as a work for hire. Mannie Garcia was a salaried employee from whom taxes were withheld and to whom overtime was paid, among many other documented indicators providing proof that he was a staff employee at the time the photo was taken in 2006. At the same time, the AP notes that Mr. Garcia shares AP's position that the photo used by Mr. Fairey is protected by copyright. Like AP, Mr. Garcia also disputes Shepard Fairey's assertion of the Fair Use Doctrine and claims infringement of copyright.¹⁸⁹

Expert opinion was starkly divided about the case. The treatise writer, William Patry, has argued that the poster should be protected under the defence of fair use, both because of its transformative and its political nature:

Mr. Fairey significantly transformed the original, and it is his changes, not the original, that give the poster its power. Without demeaning the original photograph, there is nothing special about it; unlike most forms of appropriation art where the original is not altered and the ‘art’ is in the lack of transformation, the essence of Mr. Fairey’s poster is its transformation *from* the original. We care about the transformed image only because of the insights provided by Mr. Fairey. Mr. Fairey’s use should be regarded as fair use despite his reliance on Mr. Garcia’s photo... That Mr. Fairey’s poster enriches society has been undeniably proven by its widespread approval by the public, by President Obama, and by its becoming part of the permanent collection of the US National Portrait Gallery.¹⁹⁰

By contrast, Professor Jane Ginsburg has maintained that such artistic mash-ups should not be protected under the defence of fair use: ‘What makes me uneasy is that it kind of suggests that anybody's photograph is fair game, even if it uses the entire image, and it remains recognizable, and it's not just used in a collage.’¹⁹¹

In November 2009, the Fair Use Project withdrew from the case, after revelations that Shepard Fairey had fabricated and destroyed relevant evidence and other newly discovered information in the lawsuit. Somewhat embarrassedly, Anthony Falzone commented:

¹⁸⁹ Paul Colford, ‘Statement from the Associated Press on Mannie Garcia’s Employment’, 16 May 2009, http://www.ap.org/pages/about/pressreleases/pr_071609a.html

¹⁹⁰ William Patry, *Patry on Copyright*, updated March 2010.

¹⁹¹ Hillel Italie, ‘AP alleges copyright infringement of Obama image’, Associated Press, 4 February 2009.

As reported, we are no longer representing Shepard Fairey in his dispute with The Associated Press. The events that led to this have been well-publicized; they involve Shepard's deletion of electronic files relating to the question of which photograph he used to create the Obama Hope poster, and his creation of new documents designed to make it look as though he used a different photograph. There are lots of reasons lawyers may not be able to continue representing a client. But it's important to make one thing clear: Our decision in that regard had nothing to do with the underlying merits of Shepard's case. We believe as strongly as ever in the fair use and free expression issues this case presents, and we believe Shepard will prevail on them. The question of which photo he used as a reference simply should not make a difference, much less overshadow the merits of this important case. Shepard has a fantastic set of lawyers representing him now, so he is in good hands, as are the important rights at stake in this case. That fact makes us profoundly happy. We'll be watching and rooting for Shepard, albeit now from the sidelines.¹⁹²

By any measure, though, the participation of the Fair Use Project in the Shepard Fairey litigation would have to be assessed as a disappointment, given these circumstances.

Capitalizing upon the revelations, the Associated Press amended its filings against Shepard Fairey. General Counsel for Associated Press Sri Kasi triumphantly observed:

Striking at the heart of his fair use case against the AP, Shepard Fairey has now been forced to admit that he sued the AP under false pretenses by lying about which AP photograph he used to make the *Hope* and *Progress* posters. Mr. Fairey has also now admitted to the AP that he fabricated and attempted to destroy other evidence in an effort to bolster his fair use case and cover up his previous lies and omissions.... Fairey's lies about which photo was the source image were discovered after The AP had spent months asking Fairey's counsel for documents regarding the creation of the posters, including copies of any source images that Fairey used. Fairey's counsel has now admitted that Fairey tried to destroy documents that would have revealed which image he actually used. Fairey's counsel has also admitted that he created fake documents as part of his effort to conceal which photo was the source image, including hard copy printouts of an altered version of the Clooney Photo and fake stencil patterns of the *Hope* and *Progress* posters.¹⁹³

The General Counsel concluded: 'The AP intends to vigorously pursue its countersuit alleging that Fairey willfully infringed The AP's copyright in the close-up photo of then-

¹⁹² Anthony Falzone, 'FUP Withdraws from Fairey Case; Hope Remains', Stanford Law School, 13 November 2009, <http://cyberlaw.stanford.edu/node/6353>

Senator Obama by using it without permission to create the *Hope* and *Progress* posters and related products, including t-shirts and sweatshirts that have led to substantial revenue.¹⁹⁴

As a result of his actions in respect of evidence, Fairey is under criminal investigation. One would have to presume that it will be difficult for Fairey to win the case, in light of his conduct during the trial.

5. 'The Column' Case



Another piece of litigation involving the Fair Use Project was the Column Case. The Column case concerned the decision of the United States Postal Service to issue a 37-cent postage stamp commemorating the 50th anniversary of the armistice of the Korean War.¹⁹⁵ This stamp featured a photograph taken by John Alli of many of the 19 stainless steel soldier sculptures that are part of the Korean War Veterans Memorial located on the national mall in Washington, D.C. The sculptor, Frank C. Gaylord, an artist and World War II, filed an action against the Postal Service, alleging that the stamp image

¹⁹³ Sri Kasi, 'Fairey Admits He Sued AP Under False Pretenses', Associated Press, 16 October 2009, http://www.ap.org/pages/about/pressreleases/pr_101609a.html

¹⁹⁴ Ibid.

¹⁹⁵ *Gaylord v. The United States* 85 Fed. Cl. 59 (2008) (the 'Column' case)

of ‘The Column,’ infringed his exclusive copyright in the sculpture. The sculptor sought a royalty of ten percent on the Postal Service’s net sales of the commemorative stamp and related merchandise.

At first instance, Wheeler J considered whether the stamp was protected under the doctrine of fair use. The judge ruled that the photograph was transformative in its nature: ‘Mr. Alli’s efforts resulted in a work that has a new and different character than ‘The Column’ and is thus a transformative work’.¹⁹⁶ Moreover, the postage stamp was also transformative: ‘The Postal Service further altered the expression of Mr. Gaylord’s statues by making the color in the ‘Real Life’ photo even grayer, creating a nearly monochromatic image. This adjustment enhanced the surrealistic expression ultimately seen in the Stamp by making it colder’.¹⁹⁷

In the case of *Gaylord v. United States*, the United States Court of Appeals for the Federal Circuit considered an appeal against the verdict of the District Court.

The Fair Use Project wrote an amicus curiae brief on behalf of The Andy Warhol Foundation for the Visual Arts, Inc., The Andy Warhol Museum, Thomas Lawson, Barbara Kruger, Jonathan Monk, and Allen Ruppersberg. The group emphasized:

The decision of the Court of Federal Claims holding the United States Postal Service made fair use of Appellant Frank Gaylord’s sculpture *The Column* vindicated important rights of free expression and creative freedom. For centuries, art and culture has built on itself. Artists have always manipulated the world around them, including images, objects and scenes – some familiar, some not – to create new works that express new aesthetics and convey new meaning. Much of this imagery and other material is under copyright protection, for copyright now covers nearly every creative work fixed in a tangible medium and often lasts well over a century. The right to use existing imagery under the fair use doctrine is therefore critical to free speech and free expression.¹⁹⁸

¹⁹⁶ *Gaylord v. The United States* 85 Fed. Cl. 59 (2008) (the ‘Column’ case)

¹⁹⁷ *Gaylord v. The United States* 85 Fed. Cl. 59 (2008) (the ‘Column’ case)

¹⁹⁸ Amicus Brief of Amici Curiae, including The Andy Warhol Foundation for the Visual Arts Inc., The Andy Warhol Museum, Thomas Lawson, Barbara Kruger, Jonathan Monk, Allen Ruppersberg and Eleven Professors of Law in Support of the Defendant in *Gaylord v. United States* 595 F.3d 1364, <http://cyberlaw.stanford.edu/system/files/Gaylord%20v%20US%20Amici%20brief%20%28filed%29.pdf>

The Fair Use Project emphasized: ‘In holding the postage stamp at issue is protected by fair use, the Trial Court vindicated important rights of creativity and free expression that lie at the heart of the Copyright Act and the fair use doctrine.’¹⁹⁹

A copyright maximalist made light of the ruling: ‘It appears that Gaylord’s effort to enforce his copyright was undone by the court’s responsiveness to an inspired photographer on a snowy day and to the artistic sensibilities of the Postal Service.’²⁰⁰

However, the majority of the Court of Appeals for the Federal Circuit overturned the judgment of the District Court.²⁰¹ Writing the lead judgment, Moore J held that the Government’s stamp was not a fair use, finding that it was risible to think that the work was transformative:

We conclude that the stamp does not transform the character of The Column. Although the stamp altered the appearance of The Column by adding snow and muting the color, these alterations do not impart a different character to the work. To the extent that the stamp has a surreal character, The Column and its soldiers themselves contribute to that character. Indeed, the Penn State Team suggested that the Memorial have a ‘dream-like presence of ghostly figures.’ Capturing The Column on a cold morning after a snowstorm-rather than on a warm sunny day-does not transform its character, meaning, or message. Nature’s decision to snow cannot deprive Mr. Gaylord of an otherwise valid right to exclude.²⁰²

The judge concluded: ‘Even though the stamp did not harm the market for derivative works, allowing the government to commercially exploit a creative and expressive work will not advance the purposes of copyright in this case’.²⁰³

In dissent, Newman J protested that ‘Clear error has not been shown in the Court of Federal Claims’ factual findings supporting the statutory factors of fair use’.²⁰⁴ She was of the view that ‘This finding of fair use of itself establishes the right of the United States to use a picture of the Memorial on a United States postage stamp, without

¹⁹⁹ Ibid.

²⁰⁰ Nicole Rizzo Smith, ‘Postal Service Prevails in Copyright Battle over Korean War Commemorative Stamp’, Intellectual Property Update, February 2009, http://www.sunsteinlaw.com/publications-news/news-letters/2009/02/200902_Rizzo%20Smith.html

²⁰¹ *Gaylord v. United States* 595 F.3d 1364 (2010)

²⁰² *Gaylord v. United States* 595 F.3d 1364 at 1373-4 (2010)

²⁰³ *Gaylord v. United States* 595 F.3d 1364 at 1376 (2010)

²⁰⁴ *Gaylord v. United States* 595 F.3d 1364 at 1385 (2010)

liability for copyright infringement.’²⁰⁵ Moreover, in her view, ‘The use for governmental purposes of a photograph of the Korean War Veterans Memorial, a public monument that was designed and built with public money, is unambiguously covered by the contract and statutes under which this Memorial was built.’²⁰⁶

6. *60 Years Later: Copyright Law and Literary Sequels*



In the case of *Salinger v. Colting*, J.D. Salinger brought an action for copyright infringement and common law unfair competition in respect of the creation of an unauthorised sequel to the famous novel, *The Catcher in the Rye*.²⁰⁷ The complaint protested that the Sequel infringed Salinger's copyright rights in both his novel and the character Holden Caulfield, who is the narrator and essence of that novel. ‘Seeking to capitalize on this success, defendants have published and are poised to distribute in this country, a book with a cover describing it as a ‘sequel to one of our most beloved classics’.²⁰⁸ The author moved for a preliminary injunction against publishing, advertising, or otherwise distributing the allegedly infringing work during pendency of the action.

In response, the defendants contended that *60 Years Later* was a serious critical commentary and transformative piece on both *The Catcher in the Rye* and Holden Caulfield:

²⁰⁵ *Gaylord v. United States* 595 F.3d 1364 at 1385 (2010)

²⁰⁶ *Gaylord v. United States* 595 F.3d 1364 at 1386 (2010)

²⁰⁷ *Salinger v. Colting* 641 F.Supp.2d 250 S.D.N.Y., 2009.

²⁰⁸ Complaint in *Salinger v. Colting* 641 F.Supp.2d 250 S.D.N.Y., 2009. 1 June 2009.

The Court should not ban this book. *60 Years Later: Coming Through the Rye* is a complex and undeniably transformative exposition about one of our nation's most famous authors, J.D. Salinger, and his best known creation, Holden Caulfield from *The Catcher in the Rye* ('Catcher').²⁰⁹

The defendants suggested that the sequel was a self-reflexive piece of work: '*60 Years Later* shows the battle between Salinger (who himself is a character in *60 Years Later*) and the 76-year-old 'Mr. C' as Salinger struggles to kill off his famous character and then has to reconcile himself to Mr. C's continued existence'.²¹⁰

In *Salinger v. Colting*, the District Court judge, Deborah A. Batts, J., considered whether the sequel was entitled to protection as a transformative work under the fair use doctrine. The judge discussed the nature of the doctrine of fair use in the United States:

From the infancy of copyright protection, some opportunity for fair use of copyrighted materials has been thought necessary to fulfill copyright's very purpose, '[t]o promote the Progress of Science and useful Arts' At the Constitutional level, while the 'Copyright Clause and the First Amendment [are] intuitively in conflict, [they] were drafted to work together to prevent censorship' such that 'the balance between the First Amendment and copyright is preserved, in part, by the idea/expression dichotomy and the doctrine of fair use.' 'Copyright law thus must address the inevitable tension between the property rights it establishes in creative works, which must be protected up to a point, and the ability of authors, artists, and the rest of us to express them-or ourselves by reference to the works of others, which must be protected up to a point. The fair-use doctrine mediates between the two sets of interests, determining where each set of interests ceases to control.'²¹¹

Curiously, the judge draws upon a mosaic of quotations from past litigation and jurisprudence – including from the cases dealing with Jeff Koons' post-modern appropriation of fashion photographs in *Blanch v. Koons*;²¹² and the litigation over the Harry Potter Lexicon in *Warner Bros. Entertainment Inc. v. RDR Books*,²¹³ and the jurisprudence of Pierre N. Leval.²¹⁴

First, considering the purpose and character of the use, the judge questioned whether the book, *60 Years Later*, was a parody of *The Catcher in the Rye*, its main

²⁰⁹ Complaint in *Salinger v. Colting* 641 F.Supp.2d 250 S.D.N.Y., 2009. 1 June 2009.

²¹⁰ Complaint in *Salinger v. Colting* 641 F.Supp.2d 250 S.D.N.Y., 2009. 1 June 2009.

²¹¹ *Salinger v. Colting* 641 F.Supp.2d 250 at 254-5 S.D.N.Y., 2009.

²¹² *Blanch v. Koons*, 467 F.3d 244, 250 (2d Cir.2006).

²¹³ *Warner Bros. Entertainment Inc. v. RDR Books*, 575 F.Supp.2d 513 (S.D.N.Y.2008)

²¹⁴ Pierre N. Leval, 'Toward a Fair Use Standard' (1990) 103 *Harvard Law Review* 1105.

character, or its author. The judge distinguished the facts of this case from the earlier precedent, involving *The Wind Done Gone*: ‘The factual finding of parody is what truly sets *TWDG* apart from *60 Years Later* because the Court here cannot make that same factual finding.’²¹⁵ Her Honour noted the ruling: ‘*The Wind Done Gone* is not a general commentary upon the Civil-War-era American South, but a specific criticism of and rejoinder to the depiction of slavery and the relationships between blacks and whites in *Gone With The Wind*.’²¹⁶ She observed: ‘*60 Years Later*, however, contains no reasonably discernable rejoinder or specific criticism of any character or theme of *Catcher*.’²¹⁷

The judge was of the firm opinion: ‘To the extent Defendants contend that *60 Years Later* and the character of Mr. C direct parodic comment or criticism at *Catcher* or Holden Caulfield, as opposed to Salinger himself, the Court finds such contentions to be post-hoc rationalizations employed through vague generalizations about the alleged naivete of the original, rather than reasonably perceivable parody.’²¹⁸ The court concluded: ‘Accordingly, the Court finds that to the extent Colting and Defense experts contend that *60 Years Later* is attempting to accentuate how Holden's emotional growth would ultimately be stunted by his unwillingness to compromise his principles or engage with ‘the phonies,’ they were again simply rehashing one of the critical extant themes of *Catcher*.’²¹⁹

In a damning footnote, the judge observes that in a number of public statements the author of *60 Years Later* had denied that there was any critical intent in the work: ‘Furthermore, in a number of public statements that were made prior to the filing of the present lawsuit, Colting himself made it clear that *60 Years Later* was not a parody or critique of *Catcher*, but rather a **tribute and sequel**’ (my emphasis).²²⁰

The judge also considered whether the book *60 Years Later* was a parody of J.D. Salinger. Her Honour noted:

While the addition of Salinger as a character in *60 Years Later* is indeed novel, the Court is unconvinced by Defendants' attempts to shoehorn Defendants' commentary and criticism of Salinger into the parodic framework of *Campbell*, which requires critique or commentary of the

²¹⁵ *Salinger v. Colting* 641 F.Supp.2d 250 at 257 S.D.N.Y.,2009.

²¹⁶ *Salinger v. Colting* 641 F.Supp.2d 250 at 258 S.D.N.Y.,2009.

²¹⁷ *Salinger v. Colting* 641 F.Supp.2d 250 at 258 S.D.N.Y.,2009.

²¹⁸ *Salinger v. Colting* 641 F.Supp.2d 250 at 258 S.D.N.Y.,2009.

²¹⁹ *Salinger v. Colting* 641 F.Supp.2d 250 at 258 S.D.N.Y.,2009.

²²⁰ *Salinger v. Colting* 641 F.Supp.2d 250 S.D.N.Y.,2009.

work. Defendants' use of Salinger as a character, in order to criticize his reclusive nature and alleged desire to exercise 'iron-clad control over his intellectual property, refusing to allow others to adapt any of his characters or stories in other media,' is at most, a tool with which to criticize and comment upon the author, J.D. Salinger, and his supposed idiosyncracies. It does not, however, direct that criticism toward *Catcher* and Caulfield themselves, and thus is not an example of parody.²²¹

The judge observed that 'just because an author and his work are intimately associated does not mean that a critique of one will *necessarily* equate to a critique of both'.²²²

Second, the judge found that the nature of the copyright work weighed against a finding of fair use: 'Here there is no question that in this case, the novel *The Catcher in the Rye* is a "creative expression for public dissemination [that] falls within the core of the copyright's protective purposes"'.²²³

Third, the judge considered the amount and substantiality of the portion used in relation to the copyrighted work as a whole. Her Honour commented that this factor weighed against a finding of fair use: 'Here, on the record currently before the Court, Defendants have taken well more from *Catcher*, in both substance and style, than is necessary for the alleged transformative purpose of criticizing Salinger and his attitudes and behavior'.²²⁴ The judge noted: 'In addition to the use of Caulfield as protagonist, *60 Years Later* depends upon similar and sometimes nearly identical supporting characters, settings, tone, and plot devices to create a narrative that largely mirrors that of *Catcher*.'²²⁵

Fourth, the judge considered the factor of market harm in the fair use determination. The judge ruled: 'while it appears unlikely that *60 Years Later* would undermine the market for *The Catcher in the Rye* itself, it is quite likely that the publishing of *60 Years Later* and similar widespread works could substantially harm the market for a *The Catcher in the Rye* sequel or other derivative works, whether through confusion as to which is the true sequel or companion to *The Catcher in the Rye*, or simply because of reduced novelty or press coverage'.²²⁶ Her Honour insisted: 'This

²²¹ *Salinger v. Colting* 641 F.Supp.2d 250 at 261 S.D.N.Y.,2009.

²²² *Salinger v. Colting* 641 F.Supp.2d 250 at 261 S.D.N.Y.,2009.

²²³ *Salinger v. Colting* 641 F.Supp.2d 250 at 263 S.D.N.Y.,2009.

²²⁴ *Salinger v. Colting* 641 F.Supp.2d 250 at 263-4 S.D.N.Y.,2009.

²²⁵ *Salinger v. Colting* 641 F.Supp.2d 250 at 264 S.D.N.Y.,2009.

²²⁶ *Salinger v. Colting* 641 F.Supp.2d 250 at 267-87 S.D.N.Y.,2009.

remains true even if, as would undoubtedly be the case, significant residual interest in a Salinger-authored sequel would still remain'.²²⁷

In his aggregate assessment, the judge held that 'while the Court does find some limited transformative character in *60 Years Later*, ... it finds that the alleged parodic content is not reasonably perceivable, and that the limited non-parodic transformative content is unlikely to overcome the obvious commercial nature of the work, the likely injury to the potential market for derivative works of *The Catcher in the Rye*, and especially the substantial and pervasive extent to which *60 Years Later* borrows from *The Catcher in the Rye* and the character of Holden Caulfield.'²²⁸

The Fair Use Project has entered the fray, writing an amicus brief on behalf of a number of libraries and the Organization of Transformative Works. Anthony Falzone reflected that the injunction banning the publication of *60 Years Later* raised fundamental issues about freedom of speech:

In *60 Years Later*, it's Holden Caulfield who's in jeopardy. An aged Caulfield has escaped from a retirement home instead of a prep school, and faces an unlikely threat: Salinger himself. The conceit of *60 Years Later* is clever. It's written as if Salinger himself has ended his decades of seclusion to 'finish what [he] started.' Salinger is trying to kill Caulfield - his 'monster' - 'bringing him back just so [he] can kill him.' But the plan goes awry, and Caulfield won't die. As Salinger and Caulfield play out their game of cat and mouse through a second adventure in New York, they urge us to ponder the relationship between an author and his work.²²⁹

He acknowledged: 'This case does raise some difficult copyright issues'.²³⁰ Nonetheless, Falzone was of the view: 'Whether the book is likely to be held an infringement at the conclusion of the case or not, courts have to consider and balance all of the important interests at stake before banning publication of a book - or any expressive work'.²³¹

The Fair Use Project raised questions about the granting of the injunction; the interpretation of the defence of fair use; and the relevance of moral rights considerations. First, the Fair Use Project argued that the judge had erred in the granting of a preliminary injunction: 'At the very least, courts should exercise great caution in granting preliminary injunctions that ban creative and expressive works. The District

²²⁷ *Salinger v. Colting* 641 F.Supp.2d 250 S.D.N.Y.,2009.

²²⁸ *Salinger v. Colting* 641 F.Supp.2d 250 S.D.N.Y.,2009.

²²⁹ Anthony Falzone, 'Confusion Over Copyright Injunctions And Other Restraints Of Speech', the Fair Use Project, 3 August 2009.

²³⁰ Ibid.

Court failed to heed that caution here.’²³² Second, the Fair Use Project contended that the District Court had made an error by applying an unduly restrictive fair use standard:

In order to give this creativity-protective doctrine sufficient breathing space, courts must be able to recognize multiple forms of transformativeness. Contrary to *Campbell* and *Blanch*, the District Court required the defendant’s use to fit within a narrow definition of parody and criticism, and then used that narrow construction to influence the outcomes on the remaining factors.²³³

Third, the Fair Use Project suggested that the ‘The District Court, without citation to any precedent, introduced an entirely new rationale in finding market harm: the speculation that authors might create out of a desire to *not* license derivative works.’²³⁴ Finally, the Fair Use Project urged the court to provide further guidance to lower courts over copyright law, fair use, and the First Amendment: ‘The Court should likewise remind courts and litigants alike of the important difference between injunctions against verbatim copying versus those that would enjoin expressive works incorporating significant new creativity’.²³⁵

The Fair Use Project’s submission was also reinforced by similar submissions by the non-profit advocacy organization, *The New York Times* and other press

²³¹ Ibid.

²³² Brief of Amici Curiae, including the American Library Association, Association of College and Research Libraries, Association of College and Research Libraries, The Organization for Transformative Works, and The Right to Write Fund in Support of Defendants in *Salinger v. Colting* 607 F. 3d 68 (CA2, NY, 2010).

²³³ Brief of Amici Curiae, including the American Library Association, Association of College and Research Libraries, Association of College and Research Libraries, The Organization for Transformative Works, and The Right to Write Fund in Support of Defendants in *Salinger v. Colting* 607 F. 3d 68 (CA2, NY, 2010).

²³⁴ Brief of Amici Curiae, including the American Library Association, Association of College and Research Libraries, Association of College and Research Libraries, The Organization for Transformative Works, and The Right to Write Fund in Support of Defendants in *Salinger v. Colting* 607 F. 3d 68 (CA2, NY, 2010).

²³⁵ Brief of Amici Curiae, including the American Library Association, Association of College and Research Libraries, Association of College and Research Libraries, The Organization for Transformative Works, and The Right to Write Fund in Support of Defendants in *Salinger v. Colting* 607 F. 3d 68 (CA2, NY, 2010).

organizations, such as The Associated Press, the Gannett Company and the Tribune Company.²³⁶ The newspaper organisations noted:

Amici publish copyrighted material every day, and depend on the copyright law to protect their writings. Indeed, their need for copyright protection is today more intense than ever as digital technologies make it ever easier for third parties to seize and repurpose the fruits of their costly newsgathering efforts. Nonetheless, Amici fiercely believe that the availability of a preliminary injunction under the copyright law cannot trump the prerogatives of the First Amendment, and that a book banning of at least arguably transformative work cannot be countenanced.²³⁷

On behalf of Public Citizen, Dan Hunter from the New York Law School wrote an amicus brief, complaining: ‘While the fair use defense provides important First Amendment protections, the vagueness and uncertain application of the defense can itself chill speech by discouraging authors from creating new works in borderline cases.’²³⁸

After hearing the matter, the Court of Appeals for the Second Circuit concluded that the District Court properly determined that Salinger had a likelihood of success of the merits of the case. The judges notes: ‘It may be that a court can find that the fair use factor favors a defendant even when the defendant and his work lack a transformative purpose’.²³⁹ However, the Court of Appeals for the Second Circuit stressed: ‘We need not decide that issue here, however, for when we consider the District Court’s credibility finding together with all the other facts in this case, we conclude, with the District Court, that Defendants are not likely to prevail in their fair use defense.’²⁴⁰

However, in its view, the Court of Appeals for the Second Circuit found that the District Court had failed to properly apply the Supreme Court of the United States’ decision in *eBay Inc. v MercExchange LLC* on the factors underlying the grant of an injunction.²⁴¹ The Court of Appeals for the Second Circuit commented:

The object of copyright law is to promote the store of knowledge available to the public. But to the extent it accomplishes this end by providing individuals a financial incentive to contribute to

²³⁶ Brief for Amicus Curiae the New York Times Company, The Associated Press, Gannett Co Inc. and Tribune Company in *Salinger v. Colting* 607 F. 3d 68 (CA2, NY, 2010).

²³⁷ Ibid, 2.

²³⁸ Brief of Amicus Curiae Public Citizen Inc. in *Salinger v. Colting* 607 F. 3d 68 (CA2, NY, 2010).

²³⁹ *Salinger v. Colting* 607 F. 3d 68 (CA2, NY, 2010).

²⁴⁰ *Salinger v. Colting* 607 F. 3d 68 (CA2, NY, 2010).

²⁴¹ *eBay Inc. v MercExchange LLC* 547 U.S. 388 (2006).

the store of knowledge, the public's interest may well be already accounted for by the plaintiff's interest. The public's interest in free expression, however, is significant and is distinct from the parties' speech interests.²⁴²

Accordingly, the Court of Appeals for the Second Circuit vacated the District Court's order and remanded the case to the District Court to apply the proper standard.

Kenneth Slawenski suggests, though, that the legal action by Salinger and his estate was ultimately futile, noting: 'The sequel's publication in Europe placed it beyond the reach of United States copyright law and therefore available for sale worldwide through the internet'.²⁴³ He comments that the copyright law could not provide exclusive control, ultimately, over characters:

In truth then, Salinger had lost control of Holden - not through trials or theft or carelessness, but through technology. While in a deeper sense, more vital than court room proceedings or sterile laws, Salinger never truly possessed Holden Caulfield at all. His character was not a commodity to be bartered. Holden had long ago meshed with the lives of readers. He belonged to the rebel who admired him, the outcast who drew strength from him, the young girl enamoured of him.²⁴⁴

Slawenski concludes that the interpretative community of readers ultimately claimed ownership of Holden Caulfield: 'And it was their affection for his character that provoked resentment against *any* author who refused to understand that Holden was *their* property, uniquely re-created each time a reader opened a copy of *The Catcher in the Rye*'.²⁴⁵

7. The Amen Break: Copyright Law and Musical Works



The Amen Break, UCLA Law and Columbia Law Copyright Infringement Project²⁴⁶

²⁴² *Salinger v. Colting* 607 F. 3d 68 (CA2, NY, 2010).

²⁴³ Kenneth Slawenski, *J.D. Salinger: A Life Raised High*, Brisbane: University of Queensland Press, 2010, 391-392.

²⁴⁴ *Ibid.* 392.

²⁴⁵ *Ibid.* 392.

²⁴⁶ The Amen Break, UCLA Law and Columbia Law Copyright Infringement Project http://cip.law.ucla.edu/cases/case_vargaspfizer.html

Historically, there has been much interest in copyright law, the defence of fair use, and musical works. Indeed, the landmark Supreme Court of the United States decision in *Campbell v. Acuff-Rose Music, Inc.*, on the defence of fair use, transformative use, and parody concerned a parody by 2 Live Crew of a famous Roy Orbison song.²⁴⁷ There has been a great deal of interest about the application of the doctrine of fair use to a range of new forms of cultural production – such as digital sampling, remixes, and mash-ups.²⁴⁸

Somewhat surprisingly, the Fair Use Project has had little involvement to date in litigation in respect of copyright law, musical works – with one exception. In the matter of *Vargas v. Pfizer Inc.*, Ralph Vargas, a drummer in New York City, and his producer, Bland Ricky Roberts, claimed that Brian Transeau’s drumbeat ‘Aparthenonia,’ which appeared in the jingle of a Celebrex commercial, infringed a drum loop, which they had recorded.²⁴⁹ The plaintiffs sued Brian Transeau, his distribution company, East West Communications, Inc., and those responsible for making the commercial - Fluid Music, Publicis, Inc. and Pfizer Inc. (the manufacturer of Celebrex) - claiming more than \$10 million in damages for the alleged copyright infringement.

Reflecting upon the dispute, the UCLA Law and Columbia Law Copyright Infringement Project had some interesting reflections upon the musical material at dispute:

Apart from the plaintiff’s purportedly original sound recording, in the present case the musical material in question comprises one-measure of a well-known rhythmic pattern that has been referred to recently as the ‘Amen break’. (The notation below was derived from a transcription of the ‘Amen break’ - which consists of this measure repeated three times followed by a different final measure - on the website of percussionist Joe Jahnigan who associates this rhythmic riff with ‘Amen Brother,’ a song recorded in the 1960’s by a soul band called The Winstons.) Were The Winstons really the first to fix this rhythmic sequence, whether in a sound recording or through music notation? Even if they were, a determination that one measure alone, of a rhythmic riff, contains sufficient original material to be eligible for copyright protection as a musical work has the potential of fostering grotesque and overreaching claims that attempt to

²⁴⁷ *Campbell v. Acuff-Rose Music, Inc.*, 510 US 569 (1994)

²⁴⁸ Victoria Elman and Alex Middleton, ‘Girl Talk On Trial: Could Fair Use Prevail?’ (2009) *Cardozo Law Review*, 149; Mary Wong, “‘Transformative’ User-Generated Content in Copyright Law: Infringing Derivative Works or Fair Use?” (2009) 11 (4) *Vanderbilt Journal of Entertainment and Technology Law* 1075; Brett Gaylor, *RiP!: A Remix Manifesto*, Eyesteel Film and the National Film Board of Canada, 2009, http://nfb.ca/hd/rip_a_remix_manifesto/; and Benjamin Franzen and Kembrew McLeod, *Copyright Criminals*, Indie Pix Films, 2010.

²⁴⁹ *Vargas v. Pfizer Inc.* 352 Fed.Appx. 458 C.A.2 (N.Y.), 2009

monopolize basic elements of music composition. This is why courts have, over the past century, focused almost exclusively on melodic similarity in music copyright infringement cases, and given little weight in determining similarities that support a claim of infringement, to harmonic or rhythmic resemblances between the works in dispute.²⁵⁰

Representing Brian Transeau, the Fair Use Project maintained that his work was an independent creation:

Vargas' 'Bust Dat Groove' is a one-bar, looped drum pattern. Similarly, BT's 'Aparthenonia' is a two and one-quarter bar drum pattern that shares with 'Bust Dat Groove' many basic drumbeat elements, such as of an eighth-note hi-hat, snare drum, and bass drum. Vargas alleges that BT sampled and digitally rearranged the drumbeats in 'Bust Dat Groove' in order to create 'Aparthenonia.' However, BT has proffered evidence that 'Aparthenonia' was created independently, using drum machines and Propellerhead Reason software (and not by a human drummer, as with 'Bust Dat Groove'). Yet Vargas maintains that 'Aparthenonia' is so strikingly similar to 'Bust Dat Groove' as to preclude any possibility of independent creation and to preclude the need to show that BT had access to Vargas' work.²⁵¹

The group maintained that there was insufficient evidence to establish copyright infringement.

In the United States District Court for the Southern District of New York, Pauley, J., granted the defendants summary judgment,²⁵² and awarded the defendants \$175,000 in attorney fees.²⁵³

In the case of *Vargas v. Pfizer Inc.*, the Court of Appeals for the Second Circuit upheld this ruling.²⁵⁴ The Circuit Judges observed that there were deficiencies in the evidence presented by the plaintiffs:

Here, Plaintiffs relied on the reports and testimony of three experts to establish that *Aparthenonia* and *Bust Dat Groove* were strikingly similar. The district court determined, however, that this evidence was insufficient to create a genuine issue of fact, explaining, *inter alia*, that the expert reports and testimony were both internally and externally inconsistent. Plaintiffs contend that the district court's treatment of their expert evidence was improper at the summary judgment stage. We disagree. Although Plaintiffs are correct that the district court must

²⁵⁰ http://cip.law.ucla.edu/cases/case_vargaspfizer.html

²⁵¹ Eric Chan, 'BT: Case Summary', 4 December 2006, <http://cyberlaw.stanford.edu/node/5037>

²⁵² *Vargas v. Transeau* 514 F.Supp.2d 439 (2007)

²⁵³ *Vargas v. Transeau* 2008 WL 3164586 (2008).

²⁵⁴ *Vargas v. Pfizer Inc.* 352 Fed.Appx. 458 C.A.2 (N.Y.),2009

view the facts and evidence in the light most favorable to them at summary judgment and ‘must be wary of granting summary judgment when conflicting expert reports are presented,’ Plaintiffs cannot avoid summary judgment simply by submitting any expert evidence, particularly where that evidence is both internally and externally inconsistent.²⁵⁵

Accordingly, the Circuit judge found that the action was without merit.

There has also been much concern about the emergence of ‘sample trolls’ in the field of music. Reflecting upon litigation by a mysterious company called Bridgeport Music Inc. against Jay Z., Timothy Wu reflects upon the phenomenon of ‘sample trolls’:

Similar to its cousins the patent trolls, Bridgeport and companies like it hold portfolios of old rights (sometimes accumulated in dubious fashion) and use lawsuits to extort money from successful music artists for routine sampling, no matter how minimal or unnoticeable. The sample trolls have already leveraged their position into millions in settlements and court damages, but that's not the real problem. The trolls are turning copyright into the foe rather than the friend of musical innovation. They are bad for everyone in the industry—including the major labels. The sample trolls need to be stopped, either by Congress or by court rulings that establish sampling as a boon, not a burden, to creativity.²⁵⁶

Reflecting upon the problem, Wu suggests that ‘Congress could also easily act against the sample trolls’.²⁵⁷ In his view, ‘All that is needed is a "sampling code": a single section of the law that declares the usage of some fixed amount of a sound recording, say, seven notes or less, to be no infringement of the copyright law.’²⁵⁸ Such a compromise ‘would give artists a simple rule to live by, while still requiring licenses for big samples that would compete with the original.’²⁵⁹

²⁵⁵ *Vargas v. Pfizer Inc.* 352 Fed.Appx. 458 C.A.2 (N.Y.),2009

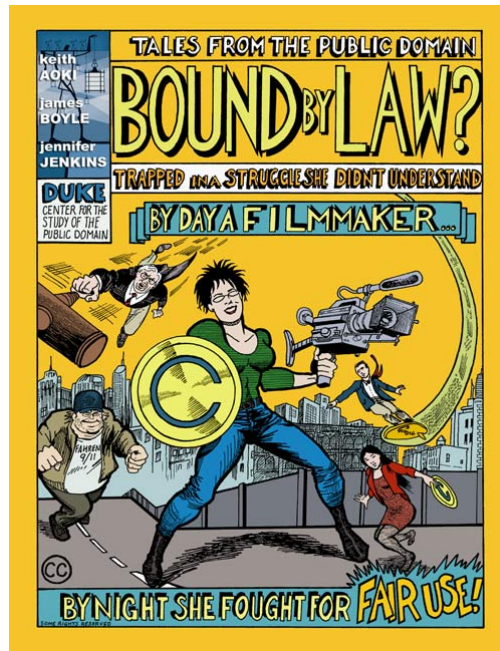
²⁵⁶ Timothy Wu, ‘Jay Z Versus the Sample Troll’, *Slate*, 16 November 2006, <http://www.slate.com/id/2153961>

²⁵⁷ *Ibid.*

²⁵⁸ *Ibid.*

²⁵⁹ *Ibid.*

8. Expelled: Copyright Law, Documentary Films, and Internet Videos



The Fair Use Project has also taken a strong interest in copyright law, documentary films, and internet videos.

In November 2004, the Center for Social Media from the American University in Washington DC released a disturbing report entitled *Untold Stories: Creative Consequences of the Rights Clearance Culture for Documentary Filmmakers*.²⁶⁰ The study considered the problems that independent documentary filmmakers faced in obtaining and controlling rights under copyright law for their creative work - and the consequences for cultural creativity. One of the central findings of the report was that rights clearance costs are high, and have escalated dramatically in the last two decades. Gordon Quinn is the founder of Kartemquin Films, which has produced such

²⁶⁰ Patricia Aufderheide, and Peter Jaszi, *Untold Stories: Creative Consequences of the Rights Clearance Culture for Documentary Filmmakers*, Washington DC: Center for Social Media, 2004, <http://www.acsil.org/resources/rights-clearances-1/nps240.tmp.pdf>

documentaries as *Hoop Dreams*, *Chicago Maternity Center Story*, *Golub*, *5 Girls*, and *The New Americans*. He commented:

I notice in our budgets we're building in more and more money for rights. We're pretty experienced and senior filmmakers, but we were \$100,000 off on our rights for *The New Americans*. We just didn't have enough money budgeted for it and it's becoming a huge strain on the project. That \$100,000 is after we made all kinds of compromises. You really have to budget for it and think it through and think about what markets it's ultimately going to go into.²⁶¹

The report made a number of recommendations to lower costs associated with copyright law and documentary films. First, it recommended that documentary film-makers make the most of the defence of fair use, develop and disseminate models of 'best practices', and establish one or more 'legal resource centers' to support filmmakers. The report observed: 'We also believe that a general guideline such as the fair use doctrine, interpreted on a case-by-base basis, offers creators more opportunity than any more narrowly drafted new legislative exception.'²⁶² Second, the report recommended reforms to facilitate the clearance process – including establishing a non-profit rights clearinghouse; and lobbying for legislation on orphan works. Third, the report recommended building a greater awareness of filmmakers' use rights. It suggested that there was a need to facilitate filmmaker access to sound pre-production legal advice; develop learning materials to provide a balanced general account of intellectual property, for filmmakers and film students; and educate gatekeepers about creators' use rights.

However, the report recommended against taking test cases: 'It is important to emphasize that we are not suggesting that documentary filmmakers, supported by pro bono counsel, should seek out opportunities for 'test case' litigation, at least at this time.'²⁶³ Citing case law such as *Elvis Presley Enters. v. Passport Video*,²⁶⁴ the report observed that litigation was a high risk-proposition: 'In our view, if filmmakers ever should choose to do such litigation, they should first lay down a stronger foundation of

²⁶¹ Ibid., 8.

²⁶² Ibid., 30.

²⁶³ Ibid., 32.

²⁶⁴ *Elvis Presley Enters. v. Passport Video*, 349 F.3d 622 (9th Cir 2003).

agreed-upon principles and actual good practices before judicial clarification is sought.’²⁶⁵

Since its establishment, the Fair Use Project has championed the interests of documentary film-makers in litigation.

In the case of *Aguiar v. Webb*, William V. Aguilar III, sued documentary filmmaker Floyd Webb, alleging that Webb's promotional website and film trailer for his upcoming film infringe on copyrights and trademarks that Aguilar claimed to own.²⁶⁶ The film project is a documentary film entitled, *The Search for Count Dante*. The film concerns the life of John Keehan, a martial arts expert who changed his name in the 1960s to Count Juan Raphael Dante.

The Fair Use Project argued that ‘Aguilar, however, has not begun to satisfy the heavy burden a party must show to obtain a preliminary injunction especially one that hinders free speech.’²⁶⁷ The Project stressed that Aguilar had not provided evidence that he owned valid copyright or trademark rights: ‘Indeed, several of the copyrights he asserts are not registered to him and the trademark registrations he points to are invalid.’²⁶⁸ The Fair Use Project argued: ‘Even if Aguilar could show ownership of valid rights, Webb’s work is protected by the Fair Use doctrine of copyright law.’²⁶⁹ The Fair Use Project elaborated:

Webb’s work is highly transformative. In his Trailers, he uses artifacts from Count Dante’s life to piece together a snapshot of the man, his nature, the things he did, and the life he lived. Its additional purpose is to introduce the audience to the forthcoming feature documentary about Count Dante, which will delve deeper into Count Dante’s life, and tell his story through the people who knew him. Similarly, the website is designed to convey information about the film biography underway. Webb’s biographical purpose is sharply different from the original purpose of the allegedly copyrighted material. The World’s Deadliest Fighting Secrets booklet was presumably designed to teach martial arts skills; advertisements for it from comic books were

²⁶⁵ Patricia Aufderheide, and Peter Jaszi, *Untold Stories: Creative Consequences of the Rights Clearance Culture for Documentary Filmmakers*, Washington DC: Center for Social Media, 2004, <http://www.acsil.org/resources/rights-clearances-1/nps240.tmp.pdf>, 32.

²⁶⁶ *Aguiar v. Webb* 1:2007cv11673 (Mass. District Court).

²⁶⁷ Defendant Floyd Webb’s Memorandum of Points and Authorities in Opposition to Plaintiff’s Motion for Preliminary Injunction in *Aguiar v. Webb* 1:2007cv11673 (Mass. District Court). <http://cyberlaw.stanford.edu/system/files/10.12.2007%20%5BAguiar%20v.%20Webb%5D%20Opposition%20to%20Motion%20for%20Preliminary%20Injunction.pdf>, 1.

²⁶⁸ Ibid, 1.

²⁶⁹ Ibid, 1.

presumably intended to sell more booklets. Webb, by contrast, has recast that material and used it in a new and creative story that pieces together the biographical elements of Count Dante's life.²⁷⁰

The Fair Use Project also maintained that 'any use of trademarks in Webb's video trailers, or on his website to chronicle the making of his film, are used in a plainly non-commercial context and do not implicate the source-identification function of trademark law.'²⁷¹

In February 2008, Floyd Webb successfully defeated William Aguiar's motion for a preliminary injunction. Reading his opinion from the bench, Wolf J held that Aguiar had not shown that he was likely to succeed on his copyright infringement claim, even assuming he could prove ownership of the allegedly infringed works, because Webb had demonstrated a likelihood of success on his fair use defense.

In the 2008 case of *Lennon v. Premise Media Corporation LP*, Yoko Ono Lennon, the children of John Lennon, and EMI Blackwood Music Inc. brought an action against the producers of a documentary about the alleged censorship of proponents of intelligent design called, *Expelled: No Intelligence Allowed*, which reproduced fifteen seconds of the song, 'Imagine', without the permission of the plaintiffs.²⁷²

Stein J denied the motion for a preliminary injunction because 'on the basis of the current record, defendants are likely to prevail on their affirmative defense of fair use'.²⁷³ Undertaking the usual multi-factorial test, the judge commented the movie was highly transformative:

Defendants' use is transformative because the movie incorporates an excerpt of "Imagine" for purposes of criticism and commentary. The filmmakers selected two lines of the song that they believe envision a world without religion: "Nothing to kill or die for/ And no religion too." As one of the producers of "Expelled" explains, the filmmakers paired these lyrics and the accompanying music to a sequence of images that "provide a layered criticism and commentary of the song." The Cold War-era images of marching soldiers, followed by the image of Stalin, express the filmmakers' view that the song's secular utopian vision "cannot be maintained without realization in a politicized form" and that the form it will ultimately take is dictatorship. The movie thus uses the excerpt of "Imagine" to criticize what the filmmakers see as the naïveté

²⁷⁰ Ibid, 1.

²⁷¹ Ibid, 1.

²⁷² *Lennon v. Premise Media Corporation LP* 556 F. Supp 2d 310 (SDNY 2008).

²⁷³ *Lennon v. Premise Media Corporation LP* 556 F. Supp 2d 310 at 316 (SDNY 2008).

of John Lennon's views. The excerpt's location within the movie supports defendants' assertions. It appears immediately after several scenes of speakers criticizing the role of religion in public life. In his voiceover, Ben Stein then connects these sentiments to the song by stating that they are merely "a page out of John Lennon's songbook."²⁷⁴

Summing up, the judge held that the 'Defendants' use of "Imagine" is transformative because their purpose is to criticize the song's message'.²⁷⁵ Stein J held: 'Moreover, the amount and substantiality of the portion used is reasonable in light of defendants' purpose.'²⁷⁶ Furthermore, the judge ruled: 'Although "Imagine," as a creative work, is at the core of copyright protection, and defendants' use of the song is at least partially commercial in nature, the weight of these factors against a finding of fair use is limited given that defendants' use is transformative'.²⁷⁷ Finally, the judge held that the 'plaintiffs have not shown that defendants' use will usurp the market for licensing the song for non-transformative purposes.'²⁷⁸

The Fair Use Project has also taken an interest in the take-down of Internet videos. In the case of *MoveOn.Org Civic Action and Brave New Films v. Viacom*, the Fair Use Project and the Electronic Frontier Foundation filed a suit against Viacom for taking down a parody by Robert Greenwald of the Colbert Report, complaining: 'Plaintiffs contend that, consistent with the Copyright Act of the United States of America, including those laws prohibiting direct, contributory or vicarious infringement, laws protecting fair use and the First Amendment to the United States Constitution, and judicial decisions construing such laws, doctrines, and provisions, the creation and posting of "Stop the Falsiness" by the Plaintiffs was and is non-infringing.'²⁷⁹ In response, Viacom conceded that it should not have taken such an action, and agreed to withdraw its objections to the parody.

In the matter of *Brave New Films v. Savage*, Michael Savage, the host of a nationally syndicated radio show, demanded the removal of a video from YouTube called 'Michael Savage hates Muslims' created and posted by Brave New Films.²⁸⁰ The work used one minute of excerpts from Savage's two-hour radio show to highlight Savage's vocal hatred towards Muslims on his radio show. The Fair Use Project

²⁷⁴ *Lennon v. Premise Media Corporation* LP 556 F. Supp 2d 310 at 322-3 (SDNY 2008).

²⁷⁵ *Lennon v. Premise Media Corporation* LP 556 F. Supp 2d 310 at 327 (SDNY 2008).

²⁷⁶ *Lennon v. Premise Media Corporation* LP 556 F. Supp 2d 310 at 327 (SDNY 2008).

²⁷⁷ *Lennon v. Premise Media Corporation* LP 556 F. Supp 2d 310 at 327 (SDNY 2008).

²⁷⁸ *Lennon v. Premise Media Corporation* LP 556 F. Supp 2d 310 at 327(SDNY 2008).

²⁷⁹ *MoveOn.Org Civic Action and Brave New Films v. Viacom* 21 March 2007.

brought an action, insisting that ‘the use of short fragments of a two-hour radio broadcast to demonstrate and criticize the views of its host is a self-evident fair use, and obviously protected by the First Amendment’s free speech guarantees.’²⁸¹ In the end, there was a settlement reached between the parties. Michael Savage provided the apology:

OTRN acknowledges that it made a mistake by asking YouTube to remove Brave New Films' video "Michael Savage Hates Muslims" from the YouTube site. Upon further examination, it is clear that video should not have been included in OTRN's September 29, 2009 takedown notice. OTRN apologizes for this error.²⁸²

Brave New Films producer, Robert Greenwald, commented: ‘We were not going to allow extreme members of the right to intimidate progressive organizations into inaction.’²⁸³

Such skirmishes over copyright law and internet videos have taken place against the background of mega-litigation by Viacom and other copyright owners against YouTube for inducing copyright infringement.²⁸⁴ Thus far, YouTube has been able to successfully be shielded under the safe harbours protection afforded by the *Digital Millennium Copyright Act* 1998 (US).

Conclusion

Surveying the litigation involving the Fair Use Project, this paper has three main conclusions.

First, there is a need to establish a Fair Use Project in Australia, given the lack of any equivalent entity in the legal landscape. The relevant government departments – such as the Attorney General’s Department, the Department of Broadband, Communications, and the Digital Economy, and the Department of Foreign Affairs and Trade – are focused on questions of legislation and policy; and have no capacity or

²⁸⁰ *Brave New Films v. Weiner aka. Savage* 2009 WL 1622385 (N.D.Cal.)

²⁸¹ Submission of the Fair Use Project in *Brave New Films v. Weiner aka. Savage* 2009 WL 1393540 (N.D.Cal.) <http://cyberlaw.stanford.edu/system/files/BNF+v.+Savage+Complaint.pdf>

²⁸² Tana Ganeva, ‘Michael Savage Has to Apologize to Brave New Films’ AlterNet 10 September 2009.

²⁸³ Ibid.

²⁸⁴ *Viacom International Inc. v. YouTube* 2010 WL2532404 SDNY.

interest in running test cases in respect of copyright exceptions. The Copyright Tribunal has had a rather narrow role of arbitration. The copyright collecting societies are obviously hostile to copyright exceptions, generally, and have opposed broad readings of copyright exceptions in both the context of policy disputes, and litigation. The Australian Copyright Council and the Arts Law Centre of Australia are very much focused upon the defending the economic and moral rights of artistic creators and copyright owners. The community legal centres in Australia do not possess any particular track record or expertise in respect of copyright litigation, generally, and disputes about copyright exceptions, more particularly, the defence of fair dealing. The Australian Digital Alliance is focused upon the interests of libraries, educational institutions, and technology developers. The Creative Commons Australia is primarily focused on the development and up-take of Creative Commons licences, rather than larger questions of copyright litigation and law reform. The Electronic Frontiers Australia has a broader remit than merely copyright law, looking at larger issues of freedom of speech and censorship on the Internet. Well-established university centres, such as the Intellectual Property Research Institute of Australia, the Australian Centre for Intellectual Property in Agriculture, and the Cyberspace Centre for Law and Policy, have a broader remit than copyright law, and lack any accompanying legal clinic. Moreover, it would be accurate to say that the cause of copyright exceptions has not had the charismatic leadership in Australia – compared to say Professor Lawrence Lessig in the United States, or Professor Michael Geist in Canada.

In the absence of any Fair Use Project, the defence of fair dealing is currently championed by ill-suited defendants in Australia. Large media broadcasters – such as Network Ten Pty Ltd - have been the main ones to raise the defence of fair dealing in litigation.²⁸⁵ Such entities are clearly poor champions of the defence of fair dealing, because they equally have an interest in protecting the large portfolio of copyright works. The Fair Use Project in the United States has played an important role in providing a strong voice for copyright exceptions – even though the outcomes of the cases that it has been involved in have been variegated.

²⁸⁵ Infamously, Network Ten Pty Ltd refused argue the point for fair dealing before the High Court of Australia, despite the frustration of the judges on the bench. In *Network Ten Pty Ltd v TCN Channel Nine Pty Ltd* (2004) 59 IPR 1, the High Court of Australia made it clear that it was up to Parliament to reform the current defence of fair dealing. Justice Kirby observed: ‘To the extent that it is suggested that the fair dealing defence under the Act is unduly narrow, that submission

Second, there is a need for the Australian Government to introduce a defence of fair use, like its United States counterparts. William Patry has observed that copyright owners have run a ‘swiftboating’ campaign against the introduction of the defence of fair use in jurisdictions outside the United States:

There is a counter-reformation movement afoot in the world of copyright. The purpose of the movement is to chill the willingness of countries to enact fair use or liberal fair dealing provisions designed to genuinely further innovation and creativity, rather than, as is currently the case, merely to give lip service to those concepts as the scope of copyright is expanded to were-rabbit size. The counter-reformation movement is presently at the stage of a whispering campaign, in which ministries in countries are told that fair use (and by extension possible liberal fair dealing provisions) violate the "three-step" test. And who wants to violate the three-step after all? The appeal by counter-reformation forces to external and abstract concepts like the three-step test is a time-worn tactic: when you can't win on the merits, shift the debate elsewhere to grounds on which you think you can win. Given that few ministry officials are experts in copyright law, much less arcana like the three-step test, these appeals - made by those who claim to be such experts - can be effective. They shouldn't be. National governments should make policy decisions based on the merits of the proposals, free from such scare tactics. The three-step test is not a bar to a single proposal of which I am aware.²⁸⁶

There has certainly been evidence of such a campaign in Australia. There have been numerous calls for a defence of fair use from the Copyright Law Reform Committee, parliamentary committees, and scholars – but such efforts have been somewhat nobbled and frustrated. At most, the Federal Government was willing to add a new defence for fair dealing in respect of parody and satire in 2006; some format-shifting exceptions; and a flexible dealing defence under s 200AB of the *Copyright Act 1968* (Cth).²⁸⁷ Arguably, Australia should go further and introduce an open-ended, multi-factorial

should be addressed to the Parliament.’ His Honour observed: ‘The correction of any remaining defects is a matter for the Parliament. It is not for this Court.’

²⁸⁶ William Patry, ‘Fair Use, The Three-Step Test, and the Counter-Reformation’, The Patry Copyright Blog, 2 April 2008, <http://williampatry.blogspot.com/2008/04/fair-use-three-step-test-and-european.html>

²⁸⁷ Fair Dealing for Parody or Satire, ss 41A, 103AA of the *Copyright Act 1968* (Cth); Time-shifting television broadcasts – s 111 of the *Copyright Act 1968* (Cth); Space-shifting sound recordings – s 109A of the *Copyright Act 1968* (Cth); Format-shifting cinematographic films – s 111AA of the *Copyright Act 1968* (Cth); Format-shifting books, newspapers and periodical publications – s 43C of the *Copyright Act 1968* (Cth); Format-shifting photographs – s 47J of the *Copyright Act 1968* (Cth); Cultural preservation – ss 51A and 110BA of the *Copyright Act 1968* (Cth); and Flexible dealing provision – s 200AB of the *Copyright Act 1968* (Cth).

defence of fair use. Indeed, it has had a remarkably similar defence of reasonableness for a decade under the moral rights regime – there has been nary a complaint or a controversy over it.

Third, there is a need to take a progressive approach to the interpretation of exceptions under international copyright law. There has been much debate within the World Trade Organization panels about the meaning of the three-step test.²⁸⁸ Some commentators have been willing to contemplate the possibility that the defence of fair use somehow violates the three-step test under the *Berne Convention for the Protection of Literary and Artistic Works* and the *TRIPS Agreement* 1994.²⁸⁹ In her piece, ‘International Copyright Law: (W[h]ither) User Rights?’, Myra Tawfik provides an important corrective to such procrustean interpretations of the three-step test:

Article 13 of *WTO/TRIPS* has been interpreted as the overarching normative standard from which to evaluate all limitations and exceptions that curtail rights conferred under the *Berne Convention* and *WTO/TRIPS*. Its scope has been the subject of much discussion and commentary, including having been at issue in a recent WTO Dispute Panel decision. Although the test is emerging as the pre-eminent measure for assessing limitations and exceptions and has found its way from *Berne* to *WTO/TRIPS* as well as to the *WIPO Treaties*, its interpretation is still evolving.

While there remains uncertainty about the contours of this test, at least one aspect seems clear: the three-step test does not undermine the discretion enjoyed by national legislatures to enact limitations and exceptions so long as they remain consistent with the *Berne Convention* and conform to the objectives the test was formulated to achieve. More specifically, the test does

²⁸⁸ United States—Section 110(5) of the U.S. Copyright Act, Report of the Panel, WT/DS160/R (June 15, 2000); and Canada -- Patent Protection of Pharmaceutical Products, Report of the Panel, WTO Doc. WT/DS114/R (April 2, 2000).

²⁸⁹ See, for instance, David Brennan 'The Three-Step Frenzy: Why the TRIPS Panel Decision Might be Considered Per Incuriam' (2002) 2002 *Intellectual Property Quarterly* 212-225; and Samuel Ricketson, *WIPO Study on Limitations and Exceptions of Copyright and Related Rights in the Digital Environment*, 5 April 2003, SCCR/9/7, http://www.wipo.int/edocs/mdocs/copyright/en/sccr_9/sccr_9_7.pdf at page 69: ‘It is quite possible that any specific judicial application of Section 107 will comply with the three-step test as a matter of fact; the real problem, however, is with a provision that is framed in such a general and open-ended way. At the very least, it is suggested that the statutory formulation here raises issues with respect to unspecified purposes (the first step) and with respect to the legitimate interests of the author (third step).’

not prevent countries from introducing “free use” limitations and exceptions, nor does it require further restrictions on existing permitted use formulations.²⁹⁰

Far from being radical or controversial, the defence of fair use in the United States has a hallowed history dating back to Justice Joseph Story. Accordingly, it would be worthwhile for the Australian Government to promote a Treaty on Access to Knowledge, with scope for flexible copyright exceptions, such as the defence of fair use.²⁹¹ Members of the World Intellectual Property Organization and World Trade Organization – and parties to TRIPS-Plus trade agreements with the United States – deserve to enjoy the equivalent protection afforded by the United States defence of fair use, in a process of harmonization.

²⁹⁰ Myra Tawfik, ‘International Copyright Law: (W[h]ither User Rights?)’ in Michael Geist (ed.), Michael Geist, (editor). *In The Public Interest: The Future of Canadian Copyright Law*. Toronto: Irwin Law, 2005, 77. See also Myra Tawfik, ‘International Copyright Law and Fair Dealing as a ‘User Right’’, *UNESCO e-Copyright Bulletin*, http://portal.unesco.org/culture/en/files/27422/11514150881Myra_e.pdf/Myra_e.pdf

²⁹¹ Amy Kapczynski, ‘The Access to Knowledge Mobilization and the New Politics of Intellectual Property’ (2008) 117 *Yale Law Journal* 804.