

COPYRIGHT FAIR USE:

A CONSTITUTIONAL IMPERATIVE

The 36th Annual Donald C. Brace Lecture

By Hon. Stanley F. Birch

In 2006, the Copyright Society of the United States invited Judge Birch to present the 36th Annual Donald C. Brace Memorial Lecture on copyright law at New York University Law School. His remarks are reprinted below with permission of the Copyright Society.

I am at once humbled and elated to have been invited to present the Donald C. Brace Memorial Lecture on the law of copyright. My review of the distinguished scholars who have delivered this talk was indeed humbling. Yet the opportunity to share my views on the law of copyright—my own jealous mistress—is truly exciting. My introduction to the mysteries, mythology, history, and hyperbole of copyright occurred in many sessions with my now departed mentor and friend-in-the-law, Professor L. Ray Patterson. The Copyright Society had no finer exemplar of scholarly and gentlemanly aspect—a truly original thinker in a field that extols originality.⁴⁴¹ I trust that my remarks will be pleasing to his ear. Many of the ideas and viewpoints presented here were exchanged, discussed, debated, and examined in the hours that Ray and I spent exploring the ever-expanding reach of copyright.

The thesis of my presentation is that Congress intended the fair use doctrine to be a necessary antidote to the elimination of publication as a precondition to the grant of the copyright privilege⁴⁴² and that, with the passage of the Copyright Act of 1976, the right of fair use cannot be considered an affirmative defense—either logically or doctrinally.⁴⁴³ The elimination of publication as a condition for copyright was one of the two most important changes in the 1976 Copyright Act. The other significant change was a corollary of the first, the codification of the judicial fair use doctrine. If one accepts the stated purpose of copyright—the promotion of learning⁴⁴⁴—and agrees that the elimination of publication as a condition for copyright threatens that purpose,⁴⁴⁵ the constitutional dimensions of statutory fair use become apparent. Fair use protects the public's First Amendment right of access,⁴⁴⁶ a right that was formerly assured by publication as a condition for copyright.



Despite the importance of the fair use doctrine, the Supreme Court has opined that it has become “the most troublesome in the whole law of copyright.”⁴⁴⁷ The thrust of my discussion is to explain why and to demonstrate that this need not be so. Initially, I shall examine the origins of fair use and the reasons for its troublesome nature. Then, I shall suggest a framework for analyzing the fair use doctrine and its codification in § 107 of the 1976 Copyright Act. A historical perspective is vital to understanding the principles of the law of copyright. Few modern statutes are based upon an English statute enacted in 1709—the Statute of Ann. Fewer statutes have a direct lineage back to the Star Chamber Decree of 1586. The Copyright Act of 1976 does have such a predicate.

In codifying the fair use doctrine, Congress returned to the case that created it, *Folsom v. Marsh*,⁸⁴⁴ an 1841 decision by Justice Joseph Story of the Supreme Court on circuit. *Folsom* merits examination because the failure to understand it is a source of the contemporary confusion about copyright.

In *Folsom*, the charge was that Rev. Charles Upham infringed Jared Sparks’ biography and the letters of George Washington. Upham’s two-volume work, entitled *Life of Washington, in the Form of an Autobiography*, was a narrative in which Washington was made to tell the story of his life by means of correspondence inserted into the narrative. The 353 pages of letters inserted were alleged to infringe letters contained in the 12-volume work of Sparks, which contained 7,000 pages.⁹⁴⁴ Upham, however, had not copied anything from the original text in Sparks’ biography of Washington.⁴⁴¹⁰

The controversy in *Folsom* was thus between two authors about the scope of copyright. To appreciate the full import of the case, one must examine the copyright statute in effect when the case was decided. In 1841, the copyright statute in effect was the Copyright Revision Act of 1831,¹¹⁴⁴ under which copyright protection for books was very narrow, for copyright then protected only the published book

and only as it was published. This explains why another author could abridge or translate a copyrighted book without infringing the copyright. While other works could be infringed by copying, books could be infringed only by printing, publishing, or importing copies.¹²⁴⁵

The 1831 act thus reflected the distinction between the copyright and the work. The use of the work by a second author—abridgment or translation—was not a use of the copyright, because the second author created a new work and was entitled to a copyright for publishing it. But however many new works resulted from abridging or translating a work, many persons would deem the copying involved to be unfair. Although they might admit that it would be reasonable for an author to use *part* of another's work in creating his or her own, they would argue that it is not reasonable for the second author to use the entire work for that purpose, because he or she would then be *using the copyright*. This, at least, seems to have been the thinking of Justice Story when he created the fair use doctrine. He held, in effect, that the second author had the right to use part of another's work in creating a new work, but not the whole work (which would be tantamount to using the copyright). Partial use of a work by a rival author could be a fair use of the copyright, but the entire use of the work could not.

We now turn to the opinion itself. Justice Story said that “a fair and bona fide abridgment of an original work, is not a piracy of the copyright” and that the question was “whether the use, in the defendant's work, of the letters of Washington” was a piracy of Sparks' work.¹³⁴⁵ Justice Story discussed the copyrightability of the letters and concluded that they were copyrightable, that the plaintiffs were proper assignees of the copyright, and that the defendant's work was not a fair abridgment.¹⁴⁴⁵

There are three points of special interest about the opinion. The first is that Justice Story used a natural law theory of copyright in creating the fair use doctrine. Referring to the publication of the Duke of Wellington's dispatches, he said:

It would be a strange thing to say, that a compilation involving so much expense, and so much labor to the editor, in collecting and arranging the materials, might be pirated and republished by another bookseller, perhaps to the ruin of the original publisher and editor.⁴⁵¹⁵

Sparks' work, of course, was a compilation of letters collected and arranged, and the editors had expended much labor and expense in arranging them. But they were not original writings of Sparks, whose own writing, the biography of George Washington in the first volume, had not been infringed.

Second, Justice Story enlarged the copyright monopoly by laying the predicate for eliminating *the fair abridgment doctrine* and substituting fair use. He declared—consistent with natural law theory—that one can infringe a copyright by taking merely a portion of a work either by duplication or by imitation. He wrote:

It is certainly not necessary, *to constitute an invasion of copyright*, that the whole of a work should be copied, or even a large portion of it, in form or in substance. ... *The entirety of the copyright* is the property of the author; and it is no defence, that another person has appropriated a part, and not the whole, of any property.⁴⁵¹⁶

Story wrote that the copying could be in form (by duplication) or substance (by imitation). He also recognized, however, that the publication of a work—not its copying—was the operative act of infringement. Without *publication*, it made no difference whether copying was by duplication or imitation.

Third, Justice Story treated what came to be known as fair use as a function of copyright, making fair use relevant only if one is exercising a right of the copyright owner. He said:

I have no doubt whatever, that there is an invasion of the plaintiffs' copyright. ... But if the defendants may take three hundred and nineteen letters, included in the plaintiffs' copyright, and exclusively belonging to them, there is no reason why another bookseller may not take [an]other five hundred letters, and a third, one thousand letters, and so on, and thereby the plaintiffs' copyright be totally destroyed.⁴⁵¹⁷

Thus, fair use was originally intended to protect the *copyright*, leaving protection of the *work* as incidental to this purpose. The wrong, in short, was not the copying of the letters *per se* but the publishing of them, which was an invasion of the copyright that might be “totally destroyed.”

He then provided guidelines for determining how much the second author could take of the first author's work:

In short, we must often, in deciding questions of this sort, look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.⁴⁵¹⁸

His guidelines also reflect copyright as a natural law property right, and the message that they convey is that the property must be protected.

Thus was created the “fair use” doctrine to supplant the fair abridgment doctrine.¹⁹⁴⁵ Although apparently no court used the term “fair use” until some 20-odd years after the *Folsom* case,⁴⁵²⁰ it seems to have been well established by 1879, when Eaton S. Drone defined it in his classic treatise as follows:

It is a recognized principle that every author, compiler, or publisher, may make certain uses of copyrighted work, in the preparation of a rival or other publication. The recognition of this doctrine is essential to the growth of knowledge; as it would obviously be a hindrance to learning if every work were

a sealed book to all subsequent authors. The law, therefore, wisely allows a “fair use” to be made of every copyrighted publication.²¹⁴⁶

This passage makes clear an important point that is consistent with *Folsom*: the fair use doctrine as a function of copyright enabled one author to exercise the right of another author in making use of that author’s work and was thus relevant only for this particular scenario. This limited role of fair use is manifested by the transformative doctrine: the second author is expected to use the material he or she takes from the first author’s work to create a new work. Presumably this is the justification for allowing the copying that otherwise might have no purpose other than piracy.

A corollary of fair use as a function of copyright is that *there is a difference between using the copyright of a work and using the work itself*.⁴⁶²² The former may be an infringement of copyright; the latter cannot be.

Thus, long after the fair use doctrine was created, the rule was that an individual was entitled to copy passages from a book for his or her own *personal use*. In 1888, less than 10 years after Drone’s treatise was published, in *Stover v. Lathorp*, Justice Brewer of the Supreme Court on circuit ruled that

[T]he effect of a copyright is not to prevent any reasonable use of the book which is sold. I go to a bookstore, and I buy a book which has been copyrighted. I may use the book for reference, study, reading, lending, copying passages from it at my will. I may not duplicate that book, and thus put it upon the market, for in so doing I would infringe the copyright. But merely taking extracts from it, merely using it, in no manner infringes upon the copyright.⁴⁶²³

In this passage, Justice Brewer clearly used the distinction between the work and the copyright, for, as he explained, “the title to the books carries with it the right to use them.”⁴⁶²⁴ The significance of this point is that one did not *use the copyright* until he or she published the copied work, because publication, not copying, was the exclusive right of the copyright owner and was thus the operative act of infringement.

The original concept of fair use, then, was simple: one author can use portions of a copyrighted work for creating his or her own work, because, as Drone said, “it would obviously be a hindrance to learning if every work were a sealed book to all subsequent authors.”²⁵⁴⁶ The fair use doctrine, as originally created, did not apply to the exercise of concurrent rights of the *user* but to the exercise of concurrent rights by a *competitor*.

This will be instructive in determining why the Supreme Court calls this simple doctrine “the most troublesome in the whole of copyright.”⁴⁶²⁶ There are two reasons for the confusion about fair use: (1) *Folsom* created fair use as a natural law concept and (2) *Folsom*’s fair use required a distinction between the use of the copyright and the use of the work, a distinction that the 1909 act confused.

One of Justice Story’s most famous comments in *Fol-*

som is that copyrights (and patents) are the metaphysics of the law. The implied frustration is understandable in view of what he did. To achieve the result he desired, he treated the statutory grant copyright as a natural law copyright. He surely knew the difference, because he had been a member of the Supreme Court in *Wheaton v. Peters*,²⁷⁴⁶ which, less than 10 years earlier, had rejected the natural law theory (fully argued by Wheaton’s lawyers, including Daniel Webster) in favor of the statutory grant theory. The gulf between the equity he desired and the law he was duty-bound to administer was so wide that it could not be crossed with reason alone. This explains his comment placing copyright in the realm of metaphysics.²⁸⁴⁶

The gulf existed because statutory copyright is the grant of a limited statutory monopoly; the natural law copyright is an unlimited common law monopoly. The statutory copyright requires an original work; the natural law copyright requires only a work that is the result of effort—for example, compiling and arranging letters. The essential difference between the two copyrights thus is philosophical: the statutory copyright is to benefit the public directly and the author indirectly; the natural law copyright is to benefit the author directly and the public indirectly. If copyright is seen as a monopoly to benefit the public, it is reasonable that the protection be limited to the work as published and that abridgment not be regarded as an infringement of this right; if copyright is intended primarily to benefit the author, such an abridgment is wrong. Story took the latter view, and his natural law reasoning proved to be a basis for confusion as to the modern-day meaning of fair use.

The fair use doctrine as a natural law concept served to enhance the limited copyright monopoly, because it gave support to the concept of copyright as a plenary property right and caused courts to ignore the constitutional fences enclosing the copyright domain. As a natural law concept, copyright applied to both the copyright and the work. Thus, the author was deemed to own the work under natural law and the copyright under the statute. The ownership of the work was justification for subordinating the statutory limitations to the author’s interest, which is what Justice Story did in *Folsom*.

The fair abridgement doctrine did not entail the use of the copyright, because it did not entail a right of the copyright owners; the copyright owner did not have exclusive right to abridge the work any more than he or she had the exclusive right to translate the work. The operative word here is “exclusive,”⁴⁶²⁹ because the author could always abridge or translate his or her own work and be entitled to a *new* copyright for doing so. Prior to the fair use doctrine, when another author used the work for either of these purposes, the issue was piracy or not, as in *Folsom*. Either one used the copyright or one did not; there was no rule against the use of the work because the right to do so fulfilled the major purpose of copyright: the promotion of learning.

The fair use doctrine, of course, involved use of the work as well as the copyright, and it served a twofold purpose: (1) It protected the author as copyright owner by preventing the use of too much of the work (2) It protected

the author as creator by enabling him or her to use the work of another to create a new work. The goal of fair use, in short, was to limit harm to the copyright, not to prevent use of the work; but if fair use became so inclusive that the second author in using the work had to be continually concerned with whether the use was fair, the result would be a fair use inhibiting—not protecting—the creation of new works. This is why it is important to understand that fair use is a function of copyright that requires one to distinguish between the use of the copyright and the use of the work.

The basis for the distinction between the use of the copyright and the use of the work was the limited right of the copyright owner.³⁰⁴⁷ As long as the copyright owner had the right only to publish a book, one who merely copied passages from it used the work, not the copyright. This was the situation prior to the 1909 act. If one published copies of a competitor's book or even a substantial portion of it, he or she was guilty of copyright infringement, because he or she used the copyright. The operative act was not the copying but the *publishing*. One who copied but did not publish—or intend to publish—was using the *work* not the *copyright*. Recall Justice Brewer's comment that one could copy passages from a book at will but could not duplicate the book and put it on the market.

Whether one uses the copyright of the work or merely uses the work itself, however, the use usually involves copying. Thus, if the copyright owner has the exclusive right both to copy *and* to publish the work, the basis for distinguishing the use of the copyright and the use of the work is blurred, if not eliminated. Arguably, the operative acts of infringement become either copying or publishing. This is what happened as a result of the 1909 act, which—for the first time—ostensibly gave the copyright owner of a book the exclusive right to copy as well as to publish it.

The right to copy a work was first used in the 1802 amendment to the 1790 act to provide copyright protection for prints and engravings.⁴⁷³¹ The right to copy thus entered the copyright statute as a term of art indicating a right available only for works of art. The premise for the distinction was that one *publishes* books but *copies* works of art. This explains why, until the 1909 act, all copyright statutes maintained the distinction between the right “to copy” works of art and the right “to print and publish” books.

The current confusion as to the nature of fair use can be traced to the language of § 1(a) of the 1909 Copyright Act, in which the rights of the copyright owner were specified as “[t]o print, reprint, publish, copy, and vend” any copyrighted work. The right to copy a book, of course, is much broader than the right to publish it. For example, one may copy a chapter from a book, but seldom would one publish only that chapter. Thus, if a copyright owner's “exclusive right” can prevent copying a chapter from his or her copyrighted book, the copyright monopoly has been expanded exponentially. This is what arguably occurred when the 1909 act was interpreted to make unpermitted copying an operative act of infringement on a par with unpermitted printing.⁴⁷³²

There is, however, substantial evidence that Congress did not intend so to expand the monopoly by making the right to copy in the 1909 act a generic right. For one thing, the right of a copyright holder to copy the book was redundant, because the exclusive right to publish the book necessarily included the exclusive right to copy it for that purpose. A competitor who copied intending to publish without permission was guilty of piracy. For another, there is evidence in House Report 2222 on the 1909 act that Congress intended to continue the law as it had been established. The report states that

Subsection (a) of section 1 adopts without change the phraseology of section 4952 of the Revised Statutes, and this, with the insertion of the word “copy,” practically adopts the phraseology of the first copyright act Congress ever passed—that of 1790. Many amendments of this were suggested, but the committee felt that it was safer to retain without change the old phraseology which has been so often construed by the courts.⁴⁷³³

This language indicates an intent to continue the extant rule, not to make a fundamental change in the law.

Nevertheless, the word “copy” came to be treated as a generic term and copying an operative act of infringement, and the importance of the distinction between the use of the copyright and the use of the work was blurred. The fact that the copyright owner was assumed to own both seemed to make the distinction irrelevant. Additionally, the fact that defendants in copyright cases were rarely individuals making personal copies contributed to the irrelevance of the distinction. Moreover, the rarity of an action against an individual made any such case especially influential when the court ruled against the defendant.⁴⁷³⁴ Thus, under the 1976 act the right to reproduce the work in copies became the basis for an argument that the copyright owner's right to copy is absolute enough to eliminate the right of personal use—which use had been unquestioned throughout the 19th century, when an individual had the right to copy passages from a book at will, as long as he or she did not put the copy on the market.³⁵⁴⁷

In the House of Representatives' report on the 1976 act, Congress took the position that “Section 107 is intended to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way.”³⁶⁴⁷ The intention, however, was not and could not be realized. It was not realized because the four nonexclusive factors to determine fair use included one that was not a part of judicial fair use—that is, the purpose of the use. It could not be realized because fair use is a function of copyright and the 1976 act expanded the copyright monopoly from protection for published writings to protection for all writings.

Paradoxically, the statement in the report intended to aid courts in the application of fair use misled them, because the inference to be drawn from it was that judicial precedent for judicial fair use was valid for statutory fair use, which it was not. And, if we can assume that Congress codified fair use to keep the enlarged copyright monopoly

within constitutional boundaries, the comment endorsing judicial fair use had the opposite of its intended effect: it did not narrow, but further enlarged the copyright monopoly.

The irony here is that, in this respect, the statement in the House report reflected an unsuspected truth. The creation of the fair use doctrine in 1841 was to give the author greater protection by enlarging the copyright monopoly; the codification of the fair use doctrine in 1976, although intended to give the public greater protection by narrowing the copyright monopoly, was given the same effect by the use of precedent for judicial fair use.

The use of old precedent to interpret a new statute had the effect one would expect. When applying the statute, courts preferred the precedent to the words of the statute. The error is one that has a simple solution: to read and give meaning to the words of the statute when applying it.

The words of the fair use statute, § 107, are simple and clear, but their context is not. Contrary to a common view, the context is not prior fair use decisions, but the copyright statute itself. Thus, to apply the fair use statute in a way that is consistent with its goal of narrowing those provisions of the statute that would otherwise provide an overbroad copyright monopoly, one needs to begin with three basic propositions: (1) there are different kinds of copyrighted works and different kinds of fair use, (2) the application of fair use in any situation depends upon the kind of work being used and the kind of use one is making of the work, and (3) there is a distinction between the work and the copyright and thus between the use of the work and the use of the copyright. The result is that, as the House report on the 1976 act concludes, fair use must be determined on a case-by-case (or work-by-work) basis—a view with which the Supreme Court concurs.⁴⁸³⁷

The copyright statute provides for three types of copyrighted works: (1) the § 102(a) creative work, (2) the § 103 compilation, and (3) the § 103 derivative work. These works contain variable amounts of copyrighted material, and, because fair use applies only to the copyrighted or original material in copyrighted works, it is useful to emphasize that the type of work is an important factor in applying fair use. The fair use of a compilation of uncopyrightable data or government documents will differ from the fair use of a creative novel. To put the point simply, fair use is a limitation on the copyright owner's rights and those rights exist only for original works. Therefore, to the extent that the work is not original, it is in the public domain and free for all to use without limitation.

Creative works are works of imagination—literature, art, and music—rather than mere assimilation, such as anthologies and databases, both printed and electronic. Creative works are the paradigm of copyrighted works and reflect the romantic notion of authorship that copyright owners (typically publishers) have used over the years to argue for the expansion of the copyright monopoly. The success of the argument is suggested by the fact that few people appreciate the reality that, in terms of economic impact, creative works are probably the least important class of copyrighted works.

Compilations are of two types: databases and collective works. The former consist of data, the latter of independently copyrightable works, such as anthologies of poems, short stories, or dramas. The author of a compilation thus contributes very little in the way of either creativity or originality and, indeed, the copyright statute requires originality only in the selection, coordination, or arrangement of the materials.

Derivative works are those that are based on another work. The classic example is the motion picture that is based on a novel. Thus, a derivative work is a transformation of a work from one form to another, and even though the transformation may entail as much originality as the creation of the original, the derivative author is entitled to copyright protection only for his or her contributions.

There are also three kinds of fair use: (1) creative fair use, (2) personal use, and (3) educational fair use.⁴⁸³⁸ The purpose of each of these uses differs. Creative fair use involves the use of another work in creating one's own; personal use involves the use of a copyrighted work for learning or entertainment; and educational fair use involves the use of copyrighted works for teaching, scholarship, or research. As a general proposition, creative fair use involves a competitive use of the *copyright*; personal and educational fair use involves only a use of the *work*.

Creative fair use is use by one author of another author's work in creating his or her own. It is the earliest—and during the 19th century was the only—form of fair use. This is the point that the passage from *Drone on Copyright* makes clear, because “it would obviously be a hindrance to learning if every work were a sealed book to all subsequent authors. The law, therefore, wisely allows a ‘fair use’ to be made of every copyrighted production. . . .”⁴⁸³⁹

The use of another's work to create one's own also means the use of the copyright of that work. This is because it utilizes, and therefore interferes with, a right reserved to the copyright owner—for example, the right to sell copies of the work. If one author abridged another author's work, he or she would interfere with the author's right to sell the unabridged work and this use of the work would be so extensive that it would also be a use of the copyright. This, of course, is the problem that Justice Story sought to resolve in *Folsom*, and it is when the use of a work extends to the use of the copyright that creative fair use comes into play. The essential question is always how much of an intrusion on the copyright of the original work will be fair.

The three factors to aid in this determination were named in *Folsom v. Marsh*: one must “look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.”⁴⁸⁴⁰ Thus, the factors were the nature of the work, the amount used, and the effect on the market. The purpose of the use, the first factor listed in § 107, was not listed in the *Folsom* case, because that factor implies other kinds of fair use, and in promulgating fair use the Supreme Court was concerned only with creative fair use.

The limitation of fair use to competing authors meant

that personal use of copyrighted works was not limited by the fair use doctrine. Indeed, in the 19th century, personal use was beyond the scope of copyright law, as Justice Brewer of the Supreme Court informed us in *Stover v. Lathrop*:

I may use the book for reference, study, reading, lending, copying passages from it at my will. I may not duplicate that book and thus put it on the market, for in doing so I would infringe the copyright. But merely taking extracts from it, merely using it, in no manner infringes the copyright.⁴¹⁴⁹

Personal fair use has now been codified—a step made desirable, if not necessary, by the increased copyright monopoly of the 1976 act. Thus, personal fair use is a use of the work by an individual for his or her learning, for example, scholarship or research, § 107, or entertainment, for example, taping a copyrighted motion picture off the air for later viewing, a personal fair use permitted by *Sony Corp. of America v. Universal City Studios*.⁴⁹⁴²

Except for personal fair use, one could read his or her book, but not copy excerpts from it. Thus, copyright owners would be empowered to ration learning by imposing a levy on individuals for using copyrighted books for their intended purpose—learning or entertainment—for which they were purchased in the first place. Consequently, personal fair use promotes the ultimate goal of copyright law as manifested in the learning policy of the Copyright Clause: a society of informed citizens capable of self-government and, in a free-enterprise economy, consumers capable of making informed choices. The important point, however, is that *once the fair use has been determined to be a personal use*, to subject the use to the four-factor test undermines this goal (that is, the promotion of learning).

Educational fair use is like personal fair use in that it is a new type of use aimed at protecting the educational process against an enlarged and expanded copyright monopoly. The difference is that Congress expressed more concern for educational, than for personal, fair use, as shown by four provisions of the copyright statute designed to protect educational fair use. Most prominent, of course, is the use of works for “teaching (including multiple copies for classroom use)” as an exemplar of fair use in § 107. The other three provisions are the first of the four fair use factors, which distinguishes between commercial and non-profit educational use, § 107(1) (a superfluous distinction unless it implies special protection for educational use); § 108, the limitations on library photocopying, which can be overridden by fair use, § 108(f)(4); and the good-faith defense for employees of nonprofit educational institutions, libraries, and archives, § 504(c)(2), which shows Congress’ special concern that copyright not be used to interfere with the educational process.

Copyright law has a purpose and a function. The purpose, defined by the Copyright Clause, is to promote learning; the function, implemented by the copyright statute, is to protect the economic interest of copyright owners. Accordingly, it is easy to see that copyright law involves a con-

flict between two policies of American society: free speech and free markets, and this conflict means that copyright is a compromise. The ultimate question of that compromise is: Where is the appropriate line of demarcation between the proprietary rights of copyright owners and the public’s right of access? It is the line that distinguishes separating the copyright and the work, because it is the boundary that provides the basis for distinguishing between the use of the copyright (which represents the owner’s economic interest) and the use of the work (which represents the public’s right of access). This is the role of the fair use doctrine.

A use of the copyright, of course, always involves a use of the work; but a use of the work does not necessarily involve the use of the copyright. The line separating the two is economic impact. The use of the copyright will typically have an economic impact, which is why the subject of fair use is the use of the copyright; the personal or educational use of the work will seldom have an economic impact in and of itself. This is why such uses can always be presumed to be fair and this is why the copyright owner’s right to copy cannot under the Constitution be—and why under the copyright statute it is not—absolute. And this is why it is necessary to distinguish between the use of the copyright and the use of the work when applying the fair use doctrine.

To apply the four fair use factors, one must interpret them, which is difficult because they have no substantive content. To say that one should consider the nature of the work, the amount used, and the market effect to determine fair use does not indicate what kind of work, how much can be used, or what market is relevant. This means, of course, that the factors are subject to interpretation consistent with the interests of the interpreter.

One argument is that all four factors must be applied to all uses of all copyrighted works. Such an interpretation, however, means that fair use enhances rather than diminishes the copyright monopoly. The more uses subjected to scrutiny and the more factors that must be met, the more likely the use is to be held to be infringing rather than fair. The factors cease to be measures to guide use and become tests to be passed.

The other argument is that the factors are to be applied according to the purpose of the use—creative, personal, or educational—and the nature of the work—creative, compilation, or derivative. Indeed, this is what the first two factors suggest. Thus, commercial use is equivalent to creative use, which makes the other factors (nature of the work, amount used, and market effect) relevant. But if the use is personal or educational fair use, the other factors are irrelevant. A typical personal or educational use does not interfere with the sale of the work, which is what makes the nature of the work, the amount used, and market effect irrelevant.

Which position is soundest, of course, depends on whether the copyright owner’s right to copy is an absolute or a predicate right, as discussed above. This indicates the importance of the correct interpretation of §§ 106(1) and 106(3), and the reasons supporting the predicate-right interpretation apply here. The most persuasive reason, per-

haps, is that Congress codified the fair use doctrine to limit the copyright monopoly. To interpret the copyright owner's right to copy as being absolute enhances the copyright monopoly. A part of this pattern of enhancement is the insistence that all four statutory factors apply to all types of copyrightable works and all kinds of fair use. An interpretation that gives a statute the opposite effect of that intended is not one that serves the public interest. For this reason alone, it is logical to conclude that, if the nature of the use is commercial, then the other three factors are relevant. If the use is a personal or educational use, then there is no further issue to be decided, which makes the other factors irrelevant.

When new technology provides an opportunity for new ways for businesses to profit, the law usually develops accordingly and rules emerge to protect the new profit.⁴⁵⁰ Consider, for example, the development of the printing press in 16th-century England that gave rise to copyright. As this experience demonstrates, new rules to protect new businesses tend to be strict and unyielding in favor of the entrepreneur because of the uncertainty generated by charting a new course. Once the course is well established, a reassessment often occurs, and the strict rules are modified to accommodate the public interest as well as the entrepreneur's interest. That pattern can be seen in the development of Anglo-American copyright, which began as a plenary proprietary monopoly that after some 150 years was changed into a limited statutory monopoly without any change in the relevant technology.

Copyright law—and, in particular, the fair use doctrine—is being challenged today by new technology that provides opportunity for new and greater profit. The question is whether judges successfully will meet the challenge and keep copyright within its constitutional boundaries. The answer to that question is to be found in the perspective with which courts view the problem. Is this a problem of litigants and fairness in the use by a defendant of the plaintiff's property? Or is it a problem of preventing—in the words of John Milton—knowledge and truth and understanding from becoming mere commodities for the marketplace? The first, of course, is the property perspective; the latter is the learning perspective.

The answer is that it is some of both, but litigation is such that the property perspective almost always displaces the learning perspective, because the issue is viewed as rights as between two parties as a matter of private interests independent of the public interest. The view has considerable merit in that protecting private interests does serve the public interest. The extent to which the view is valid in a particular case, however, depends in large part upon the subject matter of the litigation. When the subject matter is truth, learning, and knowledge, the public interest becomes more important than the private interest. Even so, this is a difficult perspective to maintain in the context of a private dispute between two parties, and one of the purposes of constitutional provisions is to ensure that the public perspective is not lost.

No provisions of the Constitution are more important for this purpose than the First Amendment and the Copyright

Clause. Awareness of this point, however, is obscured, because the former denies Congress the power to make any law regulating the press, and the latter ostensibly empowers Congress to do just that. This latter point has seldom been acknowledged, probably because the idea of a conflict between two constitutional provisions is anathema to the legal mind. But a statute that empowers publishers to exercise plenary proprietary rights in published learning materials is a statute regulating the press. That it is favorable to the press is a matter of indifference from a constitutional standpoint.

The major reason that copyright has not been deemed to be inconsistent with free speech rights is twofold: (1) constitutionally, copyright is limited to one's own writings and (2) the writings traditionally must be published to have copyright protection. Consequently, under the Constitution, Congress has the power to secure to authors the exclusive right to their writings when the author provides public access—that is, publishes them. The right of access to knowledge, truth, and learning, of course, is so important to the welfare of society that it can be classed as a civil right comparable to the right to vote, because the former is a necessary condition for the meaningful exercise of the latter.

That the right of access is the point of intersection between free speech rights and copyright is a truism that is demonstrated by the fact that control of access is the essence of censorship. So long as copyright required publication of a book, there was no issue of free speech rights because there was no issue of access. The 1976 act's elimination of publication as a condition for copyright without more would have generated serious First Amendment problems, which explains why Congress added more: the fair use doctrine.

The fair use section is the one provision of the 1976 act that appears necessary for that statute to be constitutional. For without fair use, Congress, by granting copyright protection from the moment of fixation, can be said to have exceeded the limits of its constitutional power to grant authors the "exclusive right" to their writings, which is only the right to publish them. Also, this is because, without the fair use doctrine, copyright granted upon the fixation of a work (which may include public-domain material) gives the copyright owner the right to control access and the Copyright Act becomes one large statute regulating the press.

The limitations on copyright in the statute that make copyright a regulatory concept serve to prove the point. For Congress to provide by statute the conditions upon which a university library may copy published materials for its patrons is clearly to regulate the press in favor of the press to the detriment of the public. This explains why Congress provided in § 108 that nothing in the section would affect the right of fair use.⁴⁵⁰ Therefore, *it is of enormous significance that the only general limitation on the copyright owner's rights applicable to all copyrighted works is the right of fair use*. If that right is given a narrow, contrived interpretation, the 1976 Copyright Act becomes a statute that is contrary to the First Amendment.

This, of course, is why fair use has constitutional dimensions, and this is why courts should interpret the right of fair use in light of the Copyright Clause and the constitutional policies of copyright: that copyright shall not be used for censorship purposes; that copyright protects the public domain; and that copyright is to benefit the author, not the publisher. The Supreme Court has long recognized that Congress is to benefit the author with the monopoly of copyright only in a manner that is congruent with the public interest.

Against this historical and theoretical backdrop, it should be manifest that to denominate fair use as merely an affirmative defense is a mischaracterization of constitutional dimensions. It is unfortunate that Justice Souter referred to fair use as an “affirmative defense” in *Campbell v. Acuff-Rose Music Inc.*⁴⁵¹ Even though it is evident that that observation is both dicta and a reversal of course by the Supreme Court, it nevertheless is Supreme Court dicta.⁴⁵¹ Accordingly, a critical view of such a mischaracterization should be voiced.⁴⁷⁵¹

Recall the express language used by Congress in § 107: “Fair use of a copyrighted work ... for the purposes such as criticism [or] comment ... is not an infringement of copyright.” Logically then, how can it be said that fair use, which by definition is not an infringement, can be considered properly an affirmative defense in a copyright infringement action? Additionally, recall that the usual copyright infringement defenses are both statutory and judicial. The statutory (negative) defenses include no copying, no adaptation, no public distribution, no public performance, no public display, and no registration; the judicial defenses include lack of originality, merger, copyright misuse, copyright estoppel, and abandonment.⁵¹⁴⁸ These defenses all speak to matters—disqualification for copyright and excuse for infringement—rather than to an exception to infringement and, at least, an exception thereto.

It is also informative to note that Justice Souter, writing for the Court in *KP Permanent Make-Up Inc. v. Lasting Impression I Inc.*,⁵¹⁴⁹ has confirmed placement of the burden of proof regarding likelihood of confusion on the trademark holder rather than on the alleged infringer.

At most, I would opine that a defendant in an infringement action should have the initial burden of stating in defensive pleadings that it was asserting the right of fair use, thereby placing the plaintiff copyright owner on notice. After satisfying that initial burden of coming forward, the burden to establish infringement upon the plaintiff would include the burden to negate fair use, because fair use, by statutory definition, is not an infringement.

Accordingly, when the Supreme Court has an opportunity to revisit and to deal squarely with the issue, I am, if not confident, at least encouraged that the Court will hold that fair use is an *affirmative right* born of the Copyright Clause, the First Amendment, and the 1976 Copyright Act.

TFL

Judge Stanley Francis Birch Jr. graduated from the University of Virginia with a B.A. in 1967 and received both his J.D. and his LL.M. (in taxation) from Emory University School of

Law in 1970 and 1976, respectively. Judge Birch also studied at Trinity College (Oxford) and the Peabody Conservatory. He served in the U.S. Army, Fifth Special Forces from 1970 to 1972 (including a tour of duty in Vietnam). After the military, Judge Birch prepared for his future judicial career as a law clerk for Chief Judge Sidney Smith in the Northern District of Georgia, then moved to private practice in Gainesville, Ga., and in Atlanta in 1985. President Bush appointed Judge Birch to his position on the Eleventh Circuit in 1990. This speech was originally published in the Journal of the Copyright Society of the U.S.A.'s Winter-Spring 2007 issue and is reprinted with permission.

Endnotes

¹Professor L. Ray Patterson's two books on copyright provide a rich reference for all the historical facts concerning the law of copyright that I set out in this presentation. See L. Ray Patterson, *COPYRIGHT IN HISTORICAL PERSPECTIVE* (1968), and L. Ray Patterson and Stanley W. Lindberg, *THE NATURE OF COPYRIGHT: A LAW OF USERS' RIGHTS* (1991).

²Prior to 1976, an important characteristic of copyright statutes was copyright formalities: registration, deposit, and notice. Thus, to secure copyright protection, the copyright claimant had to publish the work with notice, register the work, and deposit copies of the work. Act of Mar. 4, 1909, chap. 320, §§ 10–14 (repealed in 1976). The status of the formalities was at issue in *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), where the plaintiffs claimed that the formalities were discretionary. The Supreme Court disagreed and held that they were mandatory because they were conditions that were precedent and subsequent; thus, if they were not fulfilled according to statutory requirements, there was no copyright protection. The “formalities,” in short, were misnamed; they were duties of substance, not form. This remained the law until the 1976 act, when Congress provided that neither deposit nor registration would be a condition of copyright protection. Additionally, the amendments to the statute by the Berne Convention Implementation Act of 1988 made the notice requirement discretionary, not mandatory. 17 U.S.C. § 401 (2000). (Unless otherwise indicated, all section references will be to the Copyright Act of 1976, found at 17 U.S.C. § 101 *et seq.*)

³*Bateman v. Mnemonics Inc.*, 79 F.3d 1532, 1542 n.22 (11th Cir. 1996) (Birch, J.) (“Although the traditional approach is to view ‘fair use’ as an affirmative defense, this writer, speaking only for himself, is of the opinion that it is better viewed as a right granted by the Copyright Act of 1976.”). I am pleased to find that a number of scholars have found my thoughts to be of interest and have cast my musings in a positive light. See David Nimmer, *Appreciating Legislative History: The Sweet and Sour Spots of the DMCA's Commentary*, 23 CARDOZO L. REV. 909, 967 n.323 (2002); David Nimmer, *A Riff on Fair Use in the Digital Millennium Copyright Act*, 148 U. PA. L. REV. 673, 714 n.227 (2000); David Nimmer, *An Odyssey Through Copyright's Vicarious Defenses*, 73 N.Y.U. L. REV. 162, 191 (1998). See also L. Ray Patterson, *Copyright in the New Millennium: Resolving the Conflict Between Property Rights and Political Rights*, 62 OHIO ST. L.J. 703, 715 (2001) (agreeing with my view that “[t]he language of section 107—the fair use of a

copyrighted work ... is not an infringement of copyright—should mean that fair use is a right”). For other references to my characterization of fair use as a right rather than an affirmative defense, see Zohar Efroni, *A Momentary Lapse of Reason: Digital Copyright, the DMCA and a Dose of Common Sense*, 28 COLUM. J.L. & ARTS 249, 273 n.170 (2005); Merritt A. Gardiner, Casenote, *Bowers v. Baystate Technologies: Using the Shrinkwrap License to Circumvent the Copyright Act and Escape Federal Preemption*, 11 U. MIAMI BUS. L. REV. 105, 122 (2003); David R. Johnstone, *Debunking Fair Use Rights and Copyduty Under U.S. Copyright Law*, 52 J. COPYR. SOC’Y 345, 346 (2005); James White, *Misuse or Fair Use: That Is the Software Copyright Question*, 12 BERKELEY TECH. L.J. 251, 263 n.40 (1997).

⁴See *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1260–1262 (11th Cir. 2001) (Birch, J.) (and cases and articles cited therein) (hereinafter occasionally referred to as the *Gone With the Wind/The Wind Done Gone* case).

⁵See, for example, Ralph D. Clifford, *Simultaneous Copyright and Trade Secret Claims*, 104 DICK. L. REV. 247, 251 (2000) (stating that, with the 1976 act’s abandonment of the publication requirement, “an author can apparently claim his or her copyright while refusing to disclose the contents of the work to the public. Nevertheless, the concept of disclosing the copyrighted work to the public is inherent in the Constitutional basis of copyright.”); Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L. J. 683, 722 (2003) (“[T]he new fixation requirement did represent a significant change from ... the publication, deposit, and registration provisions. Under those provisions, fixation alone was never enough. To qualify for protection through publication, for example, an author had to not only capture his expression in tangible form, but also engage in an appropriate form of public dissemination with notice. ... The 1976 copyright revision eliminated these additional requirements, recognizing copyright on the basis of fixation alone. That greatly expanded the number of works eligible for federal protection, and it was therefore a significant re-envisioning of fixation’s role in the copyright regime.”); see also Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Anatomy of a Congressional Power*, 43 IDEA 1, 81 (2002) (noting “a steady and ever increasing tendency of both Congress and the judiciary to erode through legal fiction and evermore expansive interpretation those limitations on the copyright power found in the [Copyright] Clause” and stating that “[t]he result has been a massive increase in both the scope and term of copyright, with a resultant detriment to the public domain”).

⁶Many articles and cases have highlighted the First Amendment free speech values embedded by the Founders in the Copyright Clause of the Constitution as well as the potential for conflict between the First Amendment and the Copyright Clause, including my own opinion in *Suntrust Bank*. In *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003), the Supreme Court referred to fair use as one of the copyright law’s “built-in free speech safeguards.” Several scholars have viewed this as a recognition by the Court of the “constitutionalization” of fair use. See Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and*

How Copying Serves It, 114 YALE L. J. 535, 548 (2004) (“Indeed, one can read *Eldred* and other cases to hold that fair use is constitutionally required.”); see also Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283 (1979); Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970); Lawrence Lessig, *Copyright’s First Amendment*, 48 UCLA L. REV. 1057 (2001); Stephen M. McJohn, *Eldred’s Aftermath: Tradition, The Copyright Clause, and the Constitutionalization of Fair Use*, 10 MICH. TELECOM. & TECH. L. REV. 95 (2003); Neil W. Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1 (2001); Neil W. Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283 (1996); Melville B. Nimmer and David Nimmer, NIMMER ON COPYRIGHT § 1 (2006); Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180 (1970); Stephen B. Plichta, Note, *Constitutional Limitations Upon the Congressional Power to Enact Copyright Legislation*, 1972 UTAH L. REV. 534; L. Ray Patterson, *Free Speech, Copyright, and Fair Use*, 40 VAND. L. REV. 1 (1987); Harry N. Rosenfield, *The Constitutional Dimension of “Fair Use” in Copyright Law*, 50 NOTRE DAME L. REV. 790 (1975); Lionel S. Sobel, *Copyright and the First Amendment: A Gathering Storm?* ASCAP, COPYRIGHT LAW SYMPOSIUM, no. 19, at 43 (1971).

Justice Souter, writing for the Court in *Campbell v. Acuff-Rose Music Inc.*, explained: “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 ...” U.S. Const. Art. I, § 8, cl. 8.” 510 U.S. 569, 575 (1994). He wrote this, despite the fact that he went on to hold in dicta that fair use was an “affirmative defense.” *Id.* at 590. For other cases mentioning the constitutional dimensions of fair use, see *Bowers v. Baystate Techs. Inc.*, 320 F.3d 1317, 1325 (Fed. Cir. 2003) (citation omitted) (agreeing that the fair use doctrine must be flexible so as to “accommodate new technological innovations” and promote “the free flow of ideas”); *Universal City Studios v. Corley*, 273 F.3d 429, 458–459 (2d Cir. 2001) (“[W]e note that the Supreme Court has never held that fair use is constitutionally required, although some isolated statements in its opinions might arguably be enlisted for such a requirement.”).

Of course, there have been many rights not expressed in the Constitution but nonetheless have been recognized as fundamental by the Court, including the rights of access to information and ideas and to learn and to know. These are all directly rather than comparatively supportive of a right of fair use, through the Copyright Clause’s own internal limitation that any such legislation advance “the Progress of Science and Useful Arts.”

⁷*Sony Corp. of Am. v. Universal City Studios Inc.*, 464 U.S. 417, 475 (1984) (Blackmun, J., dissenting) (quoting *Dellar v. Samuel Goldwyn Inc.*, 104 F.2d 661, 662 (2d Cir. 1939)).

⁸*Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841) (No. 4901).

⁹*Id.* at 345.

¹⁰See *id.* (stating that “there is no complaint that Mr. Up-

ham has taken his narrative part,” only that the defendant inserted copies of Washington’s letters and official documents).

¹¹Act of Feb. 3, 1831, ch. 16, 4 Stat. 436.

¹²*Id.* sec. 1, 4 Stat. at 436, granted copyright to the author of “any book or books, map, chart, or musical composition” and also to any author “who shall invent, design, etch, engrave, work ... any print or engraving.” The rights of copyright consisted of “the sole right and liberty of printing, reprinting, publishing, and vending such book or books, map, chart, musical composition, print, cut, or engraving.” *Id.* Section 7 of the statute made it an infringement for anyone to “engrave, etch, or work, sell, or copy” any print, cut, engraving, map, chart, or musical composition. *Id.* at 438. Section 6 of the statute, however, only made it an infringement to “print, publish or import” a book or books. *Id.* at 437. Thus, copying books was not an infringement under the 1831 act.

¹³*Id.* at 345.

¹⁴The fair abridgment doctrine has its origins in eighteenth century English case law. In the landmark case of *Gyles v. Wilcox*, (1740) 2 Atk. 141, 26 Eng. Rep. 489 (Ch.), the defendant avoided infringement liability by arguing that his work was a “fair abridgment” of the original work, and thus was a separate work. *Id.* In addressing that argument, the Lord Chancellor agreed that the Statute of Anne could not be “carried so far as to restrain persons from making a real and fair abridgement” of a literary work, *id.* at 143, apparently because a fair abridgment was the result of intellectual effort and represented a new work, wholly separate from the original. See William F. Patry, COPYRIGHT LAW AND PRACTICE 535–536 (1994). While a “colorable” alteration of the original work was an infringement, a fair abridgment that resulted in an entirely different work was not. *Id.* at 536. The test, apparently, was whether the defendant exerted his own effort in making the abridgment, as opposed to merely appropriating the plaintiff’s effort.

Following the passage of the rather restrictive Copyright Act of 1790—which granted to authors the right solely to “print, reprint, publish, and vend” their works, 1 Stat. 124 (1790)—the fair abridgment doctrine was taken from English law and was adopted by American courts. It was referenced by Justice Story in *Folsom*. See *Folsom* at 347. “The result [of the doctrine] was a loss of economically important ancillary markets.” Patry, *supra* at 537. The doctrine was left behind in the 1909 act: “when a new right apart from the right of reproduction was granted, one that the 1976 Act call[ed] the right to prepare derivative works.” *Id.* For more background on this rather antiquated doctrine, see generally Eaton S. Drone, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 434–440 (1879) (hereinafter occasionally referred to as Drone on Copyright). Despite the doctrine’s acceptance by American courts, Drone took the position that a fair abridgment of a work was nevertheless piracy. See *id.* at 440–445.

¹⁵*Id.* at 347. This passage should be compared with the language in *Jeweler’s Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83, 88 (2d Cir.), cert. denied, 259

U.S. 581 (1922) and *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484, 486 (9th Cir. 1937).

¹⁶*Folsom* at 348 (emphasis added).

¹⁷*Id.* at 349.

¹⁸*Id.* at 348.

¹⁹The translation doctrine was changed by statute. Section 86 of the 1870 Revision Act provided that “authors may reserve the right to dramatize or to translate their own works.” Act of July 8, 1870, 16 Stat. 212.

²⁰In *Lawrence v. Dana*, 15 F. Cas. 26 (C.C.D. Mass. 1869) (No. 8136), Justice Clifford of the Supreme Court, sitting on circuit, said the following: “Examined as a question of strict law, apart from exceptional cases, the privilege of fair use accorded to a subsequent writer must be such, and such only, as will not cause substantial injury to the proprietor of the first publication.” *Id.* at 61.

²¹Drone on Copyright, *supra* note 14, at 386–387.

²²Indeed, § 202 plainly states: “Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied.” 17 U.S.C. § 202 (2000). This distinction between the work and the copyright is one frequently obscured by the use of the term “intellectual property.” The term “intellectual property” suggests an analogy to real or personal property, by reason of which the use of a copyrighted work is analogous to trespass or conversion that must be excused. There are, however, three weaknesses of such an analogy. First, it is often said that copyright as intellectual property differs from other types of property because use does not consume the product. But, of course, this is true of trespass on land, which is not necessarily consumed, no matter how often trespass occurs. Nor does the conversion of personality necessarily result in destruction of the property. What is affected in both instances is title—trespass may result in an easement to the harm of the title, and conversion may result in a change of possession that threatens the title of the true owner. This explains the second weakness of the analogy. The use of the copyrighted work—unlike trespass and conversion—in no way affects title, because an infringer does not threaten the ownership of the copyright. The third weakness of the analogy is that a copyrighted work is designed for use that is analogous to trespass or conversion. Thus, the subject of copyright—an original work of authorship—is intended to be used by others and, indeed, that is its very purpose, even if that use involves copying.

The real difference between copyright as property and other types of property, then, is that copyright is primarily a right of use shared by the owner with others but for different purposes. The owner’s right of use is to sell copies of the work, the user’s right is to use the copy for learning. By analogizing copyright to other types of property, some copyright holders have endeavored to obscure this point and leave the impression that no one has any rights in regard to a copyrighted work except the copyright holders themselves. Witness the many “warnings” that assert not only copyright ownership but unequivocally state that “any use” is prohibited without the authorization of the copyright owner—a manifest in terrorem misstatement of

the law as to what may constitute copyright misuse. For example, the following notice in the Association of American Publishers' 1994 *Industry Statistics* makes the point:

© 1995 by Association of American Publishers Inc. All Rights Reserved. No part of this report may be used or reproduced in any manner whatsoever without express permission from the Association of American Publishers Inc., 71 Fifth Avenue, New York, NY 10003-3004.

This, however, would mean that their rights are absolute, even as against the nonowner author/creator, which they are not, as demonstrated by both the beneficial owner concept (§ 501(b)) ("The legal or beneficial owner of an exclusive right under a copyright is entitled ... to institute an action for any infringement ...") and the author's inalienable termination right (§ 304(c)). Moreover, any statistical data themselves are not copyrightable and would constitute, in their simplest form, an industrious collection.

The question, then, is the line of demarcation between the owner's rights of use and the user's rights of use. A rational line can be drawn only if courts recognize the two domains involved—the proprietary domain of the copyright owners and the public domain from which the proprietary rights are carved. The fact that the law empowers an author to withdraw material from the public domain and monopolize its use does not mean that the monopoly is without limitation. This follows from the fact that the copyright monopoly must allow for the use of the work by others, a principle shown by the fact that the copyright owner is given only the right to distribute the work to the public and to perform and display the work publicly (§ 106 (3), (4) and (5)).

There is, in short, an important distinction between the work and the copyright. The work is what it is: a novel, a painting, a poem, or a database; the copyright is the rights to which the copyrighted work is subject. And it is the rights, not the work, that the copyright holder owns. The copyright of a database, for example, gives the copyright owner no exclusive right to data or other uncopyrightable material in the database. Perhaps this point becomes clearer in light of the fact that, when the copyright ends, the erstwhile copyright holder no longer owns any exclusive rights, but the work continues to exist without change. Thus, the copyright owner never owned the work, because copyright is only a series of specified rights to which a given work is subject for a limited period of time, after which the work enters the public domain.

The merit in defining the proprietary domain of copyright is to make clear that copyright law is intended to protect the public domain for the user as well as the proprietary domain of the copyright owner. The practical value of this point is that it makes apparent the distinction between the use of the work and the use of the copyright and that one does not infringe the work, one infringes the copyright. As the Copyright Act provides, "Anyone who violates any of the exclusive rights of the copyright owner ... is an infringer of the copyright. ..." (§ 501(a)) This definition of infringement means that the distinction between the use of the work and the use of the copyright is essential

to determine whether there has been an infringement. The basic issue in all copyright defenses is whether the use of the alleged infringer was a use of the work or a use of the copyright.

In sum, copyright, as property, is a series of intangible rights that should not be confused with the physical object that is the subject of those rights. The error is in assuming that the rights are a necessary as well as sufficient condition for the manufacture of the physical object.

²³*Stover v. Lathorp*, 33 F. 348, 349 (C.C.D. Colo. 1888) (emphasis added).

²⁴*Id.*

²⁵See Drone on Copyright, *supra* note 14, at 386.

²⁶*Sony Corp. of Am. v. Universal City Studios* 417, 475 (1984) (Blackmun, J., dissenting) (quoting *Dellar v. Samuel Goldwyn Inc.*, 104 F.2d 661, 662 (2d Cir. 1939)).

²⁷33 U.S. (8 Pet.) 591 (1834).

²⁸*Id.* at 672.

²⁹The number of rights of copyright in the 1976 act has grown to six: (1) to reproduce the work in copies, (2) to prepare derivative works, (3) to distribute copies publicly, (4) to perform the work publicly, (5) to display the work publicly, and (6) in the case of sound recordings, to distribute the work via a digital audio transmission. The six rights are stated in § 106, which provides that the rights are exclusive, subject to the limitations in §§ 107–122. But, if a right is subject to limitations, it is not "exclusive," it is merely a right subject to limitations. Even though the language is often read as limiting the rights of users, it is just as logical to read it as meaning that the stated rights are exclusive of any other rights. Indeed, this reading is consistent with the Supreme Court's definition of copyright as "a series of carefully defined and carefully delimited interests to which the law affords correspondingly exact protections." *Dowling v. United States*, 473 U.S. 207, 216 (1985).

The grant of rights section is the epitome of regulation, because the copyright holder has only the rights granted. Thus, it is the most persuasive evidence of Congress' use of the regulatory model for copyright. The larger question is whether the rights granted are *interdependent* or *independent* in nature. The narrower, but more influential, question is whether the right to reproduce copies in § 106(1) is independent of the right to distribute copies to the public in § 106(3). Whatever answer one gives to the question, understanding copyright requires that one understand what the drafters accomplished. They separated the two steps of publication into two rights: (1) the right to reproduce the work in copies and (2) the right to distribute those copies to the public. The advantage of this change to copyright owners is obvious. If the copyright owner has the right to reproduce the work in copies without regard to distribution, the right to copy the work is independent of any other right. If this is so, any person who makes a copy uses the copyright and the copyright owner is entitled to exact a tribute in the form of a license fee for the purpose.

Arguably this interpretation is as disadvantageous to the individual's right to learn as it is advantageous to the publisher's right to profit. And the resulting imbalance is reason to consider whether or not the claim that the right to copy

is independent is of dubious constitutionality. This is not the place to provide the answer, but analysis serves the useful function of enhancing one's understanding of copyright and thus improving one's ability to assess arguments for and against the constitutionality of dividing the single right of publication into two rights. Whether one interprets the rights as being interdependent or independent will be determined by whether one accepts the proprietary or the regulatory model for copyright. The proprietary model means that question is irrelevant, because one can do what one wishes with his or her property. The statement of rights functions merely to provide a statutory remedy for violation of the defined rights. Under the regulatory model, the right to reproduce in copies and to distribute the copies to the public are interdependent, because the right to distribute copies to the public is a limitation on the right to reproduce in copies. Publishers, of course, interpret the right to reproduce in copies as an independent right so they can license the user's copying from a work for personal purposes. Courts that accept their interpretation, wittingly or not, amend § 106(1) to read: "To reproduce the copyrighted work in copies *in whole or in part or to license others to do the same.*" The flaw with this reading of § 106(1) is that it is inconsistent with § 106(3), which grants the right to sell or license copies of the work, but not both.

The major reason for interpreting the right to copy and to distribute the copies as being interdependent is that, if they are independent, then the result is an enlargement of the copyright monopoly far beyond the constitutional power of Congress. This is because the broad interpretation of the rights as being independent of each other provides six copyrights for every copyrighted work—far beyond the exclusive right that Congress is empowered to grant. The result is to subordinate the constitutional policy of promoting learning to proprietary interests and, as the statute is written; also this interpretation makes rules inconsistent with each other. If the right to reproduce the copies is an independent right, it negates the public limitation on the right to distribute copies, and a user would be precluded from making a copy and distributing it privately, for example, to a class of students. Such a rule would be inconsistent with the language of § 107 that the reproduction of multiple copies for classroom use is a fair use.

Moreover, the exclusive right of the copyright owner to reproduce the work in part adds a right to the six rights that is not in the statute. If Congress had meant to give the copyright owner the exclusive right to reproduce the work in part, it would have been a simple matter to say "to reproduce the work in whole or in part in copies or phonorecords." But Congress did not do this in § 106, and it also declined another opportunity when it defined "copies" as "material objects, other than phonorecords, in which a work is fixed by any method ..." in § 101. Congress could easily have said "in which a work is fixed in whole or in part," but it did not. Thus, in the House report, Congress said: "As under the present law, a copyrighted work would be infringed by reproducing it in whole or in *any substantial part.* ..." H.R. REP. NO. 1476, at 61 (1976) (emphasis added).

³⁰At this juncture, it may be helpful to discuss the frequent argument advanced by those whose self-interest (generally publishers who have purchased an author's exclusive rights) prompt an emotional argument putatively on behalf of authors and artists that is a cunning canard. In the 1640s, for example, as part of their plea to Parliament to enact press control legislation to protect copyrights on which their livelihood depended, English booksellers claimed that, without such a law, "Many books of great worth will be strangled in the womb," an *in terrorem* argument with an emotional base to serve as a substitute for sound reasoning, as is usually true. See *The Company of Stationers' Petition to Parliament*, April 1643, reprinted in I Edward Arber, *A TRANSCRIPT OF THE STATIONERS' REGISTERS 1554–1640 A.D.* 584, 587 (1875).

This strangled-in-the-womb argument merits close examination for the same reason it tends to be effective. In large measure, copyright law determines what we may know, and the implied threat is that without copyright the reservoir of recorded knowledge will diminish, if not evaporate entirely. As sagely observed by Professor Paul Goldstein, "Is copyright protection needed as an incentive to creative production? One reason the copyright optimists resist the pessimists' claim so strongly is that they know that, if put to rigorous empirical proofs, they could rarely answer this vital question affirmatively." Paul Goldstein, *COPYRIGHT'S HIGHWAY: FROM GUTENBERG TO THE CELESTIAL JUKEBOX* 13 (rev. ed. 2003). The modern version of this argument is that copyright must give the copyright owner the right to control access to the work after it is sold as well as before. Thus, without so stating, publishers today claim that modern copyright must provide protection against the customer's use as well as the competitor's pirating. Such a copyright, of course, gives the copyright owner the power to deny the right to read and thus to deny the right to know.

As noted above, the source of the argument for the author is 18th century English publishers, who made it after the limited statutory copyright of the Statute of Anne had replaced their perpetual trade copyright. Their goal was to have courts treat copyright as a subset of property law as a means of enhancing their monopoly. Moreover, the reward-for-the-author theory ignores the fact that, in creating a work, the author harvests his or her materials from the public domain, a point that finds expression in the rule that copyright does not protect ideas. When viewed in this way, it becomes apparent that copyright is less a subset of property law than a subset of public domain law, which becomes clear when one realizes that all writings fall into one of two categories: those that are copyrightable and those that are not. Writings in this latter category are in the public domain. Two of the unrecognized purposes of copyright are to protect and enrich the public domain. For proof of this point, one need only read the Copyright Clause, the limitations of which protect public domain works from being captured by copyright and ensure that all copyrighted works eventually go into the public domain.

When one understands the role of copyright in protecting and enriching the public domain, it becomes apparent

that, even though copyright continues to have a proprietary base, it should not be in the nature of fee simple property. A more appropriate proprietary base is easement, because easement is a proprietary concept of shared rights. Copyright thus makes sense as a temporary marketing easement of material taken from the public domain, which leaves room for an easement of use by those to whom the works are marketed. This concept is explored in depth by the late Professor L. Ray Patterson in his as yet unpublished book (which was edited and includes contributions by the author of this presentation), *A Unified Theory of Copyright*.

³¹Act of Apr. 29, 1802, 2 Stat. 171–172.

³²The cases, however, obscured this development, because the unpermitted copying was almost always accompanied by printing and publication. The exception was *Whitol v. Crow*, 309 F.2d 777, 781 (8th Cir. 1962) (holding that the defendant infringed by making a limited number of copies of a choral arrangement that included copyrighted songs on a school copier for church and school performance). One of the first major efforts to make copying an operative act of infringement—which failed—was *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (Ct. Cl. 1973), *aff'd by a vote of 4 to 4*, 420 U.S. 376 (1975).

³³H.R. REP. NO. 2222, at 4 (1909).

³⁴See *Whitol* at 781.

³⁵*Stover v. Lathorp* 348, 349.

³⁶H.R. REP. NO. 94-1475, at 66 (1976).

³⁷*Campbell v. Acuff-Rose Music Co.* 569, 577 (stating that the fair use doctrine “calls for case-by-case analysis”).

³⁸17 U.S.C. § 107 (2000).

³⁹Drone on Copyright, *supra* note 14, at 386–387.

⁴⁰*Folsom v. Marsh* 342, 348.

⁴¹*Stover v. Lathorp* 349.

⁴²*Sony Corp. of Am. v. Universal City Studios* 417, 454–455.

⁴³Traditionally, there were two ways of commercial exploitation for copyrighted works, by publication and by performance, which gave rise to the publication and the performance copyright. A relatively new method of exploitation is the transmission of works, including public domain materials, that has given rise to the transmission copyright. The printing press that facilitated the reproduction of books for the market, of course, is the source of the traditional publication copyright. However, the performance copyright, the right to perform drama and musical compositions, is almost as old as the publication copyright, at least in inchoate form. In 18th century England, the right to perform a drama was held to be protected by the common law copyright, *Macklin v. Richardson*, (1770) Amb. 644, 27 Eng. Rep. 451 (Ch.), a rule that continued in the United States until the 1976 act. 17 U.S.C. §§ 301, 106(4) (2000). The performance right for dramas, however, was given statutory recognition in this country in the middle of the 19th century with an amendment to the Copyright Act that granted the right to perform dramas publicly. Act of Aug. 18, 1856, ch. 169, 11 Stat. 138–139. The public-performance-for-profit right was granted for musical compositions in the latter part of the 19th century. Act of Jan. 6, 1897, ch. 4, 29 Stat. 481–482. Congress continued both

rights in the 1909 act and gave them full recognition by making the rights available for all appropriate works in the 1976 act.

The 1976 act recognizes a third way to market a work—by transmitting it—and so has given rise to the transmission copyright. Apparently, the impetus for this development was the desire of sports entrepreneurs who broadcast sporting events on live television to use copyright to provide a remedy against one who pirated the broadcast signals. A careful reading of the relevant statutory language shows that the provisions were tailored for that purpose, but courts have not limited their rulings to the language. New meaning for the transmission copyright has resulted from the rise of computers, which can transmit material instantaneously, simultaneously, and widely. The marketing copyright thus creates a problem when the copyrighted work—whether it is published, performed, or transmitted—contains public domain material because it subjects public domain material to copyright protection. The significance of this point becomes clearer in light of copyright history.

The original English copyright, the stationers' copyright, was a pure marketing copyright, because it was not available to the author and it was not conditioned upon the creation of an original work of authorship. Thus, it gave the bookseller as copyright owner the exclusive right to publish (that is, print and sell) copyrighted books. As a marketing copyright, however, the stationers' copyright resulted in an opprobrious monopoly of the book trade. In part, this was because it was limited to members of the company and in part because of the major characteristic of the marketing copyright—it was unrelated to the author of the work. The Statute of Anne made the author a part of the copyright equation and in so doing substituted the subject matter copyright for the marketing copyright. The statutory solution to the marketing copyright monopoly was to allow only the author to be the initial copyright owner and to give the author the copyright only for newly composed books and then only for a limited term. Consequently, the basis of copyright was thus changed from a marketing right created by the Stationers' Company, based on possession of the “copie” (or manuscript) to a right conferred by statute on the author for creating a work. Therefore, copyright changed from a marketing base to a subject matter base, because it was the subject matter—a newly composed book—that determined the right to copyright. The most important result of the subject matter copyright was the protection of the public domain that emerged with the demise of censorship. If the new statutory copyright required the writing of a new work, then all other books that had been printed prior to the statute or for which the copyright had expired could be published by anyone free of charge. Moreover, the copyright on the newly composed books would last at the most for 28 years. It is worth noting that the end of the legal support for the stationers' copyright as a device of censorship (1694) was almost contemporaneous with the Glorious Revolution (1688) that ensured the Protestant succession to the English throne. No longer was it necessary to use copyright as a means of suppressing heretical, schismatical, or seditious books, for which the

marketing copyright was ideal.

The subject matter copyright is relevant to current copyright law, because it is being threatened by the rise of a new marketing copyright—the transmission copyright. The problem is that the marketing copyright provides protection on an “all or nothing” basis. One does not, for example, buy part of a book or usually perform part of a drama; and for transmission, the fee for receiving materials is not discounted because some of the material may be in the public domain. Because history tells us that it was necessary to destroy the original marketing copyright in order to create the public domain, one can infer that the rise of a new marketing copyright constitutes a threat to the public domain. Just as the stationers’ marketing copyright of publication was made possible by new technology—the printing press—the marketing copyright by transmission has also been made desirable by new communications technology (including the Internet, television, and the computer).

To see the threat that the transmission copyright poses, it is necessary to understand that the essential difference between the subject matter copyright and the new transmission copyright is the service each provides. The subject matter copyright provides access to newly created works; the transmission copyright provides access primarily to materials in the public domain. Consider the computer databases that transmit legal opinions or consist of library catalogs. In short, the transmission copyright is a utilitarian copyright that preempts, but adds nothing to, the public domain. It typically involves some adaptation of the industrious collection found uncopyrightable in *Feist Publications Inc. v. Rural Telephone Service Co. Inc.*, 499 U.S. 340, 363–364 (1991).

⁴⁴17 U.S.C. § 108(f)(4) (2000).

⁴⁵*Campbell v. Acuff-Rose Music Co.* 569, 590.

⁴⁶The basis for Justice Souter’s assumption that fair use is an affirmative defense in *Campbell* is Justice O’Connor’s statement in *Harper & Row Publishers Inc. v. Nation Enterprises* that “[t]he drafters [of the 1976 act] resisted pressures from special interest groups to create presumptive categories of fair use, but structured the provision as an affirmative defense requiring case-by-case analysis.” 471 U.S. 539, 561 (1985). The context of this remark, however, places the emphasis on “case-by-case analysis” rather than on “affirmative defense.” Further, as Professor Litman’s account of the Supreme Court justices’ debate over *Sony* demonstrates, Justice O’Connor felt strongly that the burden of proof ought to lie with the copyright holder and not with the alleged infringer. See Jessica Litman, *Copyright and Personal Copying: Sony v. Universal Studios Twenty-One Years Later: The Sony Paradox*, 55 CASE W. RES. L. REV. 917, 949 (2005); Glynn S. Lunney Jr., *Fair Use and Market Failure: Sony Revisited*, 82 B.U. L. REV. 975, 989 n.70 (2002) (stating that Campbell’s counsel conceded that he bore the burden of proof without mentioning, much less arguing or briefing, that *Sony* had held that the burden of proof should be borne by the plaintiff).

⁴⁷In the “*Gone With The Wind*” vs. “*The Wind Done Gone*” case, see *supra* note 4, after citing *Campbell* at 590 and acknowledging that we would apply fair use as an affirmative

defense out of deference to the misguided declaration of Justice Souter, we were quick to emphasize: “Nevertheless, the fact that the fair use right must be procedurally asserted as an affirmative defense does not detract from its constitutional significance as a guarantor to access and use for First Amendment purposes.” 268 F.3d 1257, 1260 n.3 (11th Cir. 2001). Because I was writing for our court, I was constrained to follow Supreme Court dicta, notwithstanding my personal contrary view.

⁴⁸See, for example, *Feist Publications Inc. v. Rural Telephone Service Co.* at 361–362 (lack of originality); *Computer Assocs. Int’l Inc. v. Altai Inc.*, 982 F.2d 693, 715 (2d Cir. 1992) (merger); *Saxon v. Blann*, 968 F.2d 676, 680 (8th Cir. 1992) (misuse/unclean hands); *Chi-boy Music v. Charlie Club Inc.*, 930 F.2d 1224, 1228–1229 (7th Cir. 1991) (estoppel); *Bell v. Combined Registry Co.*, 397 F. Supp. 1241, 1249 (N.D. Ill. 1975), *aff’d*, 536 F.2d 164 (7th Cir. 1976) (abandonment).

⁴⁹543 U.S. 111, 118 (2004).