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Brief Amicus Curiae of Eleven Copyright Law Professors in Princeton University Press v. Michigan Document Services, Inc

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AMICUS ADVOCACY

BRIEF *AMICUS CURIAE* OF ELEVEN COPYRIGHT LAW PROFESSORS IN *PRINCETON UNIVERSITY PRESS V. MICHIGAN DOCUMENT SERVICES, INC.*

EDITOR'S FOREWORD

The issue dealt with in this *amici curiae* brief is the judicial ability (or inability) to take away rights granted by Congress in 17 U.S.C. § 107, the fair use doctrine.

On June 9, 1994, the United States District Court for the Eastern District of Michigan, Southern Division, issued an opinion in *Princeton University Press v. Michigan Document Services, Inc.*, granting several publishers a permanent injunction prohibiting a commercial copying service from photocopying excerpts from copyrighted works chosen by professors and compiled as course packets to be used by university students in class. The court held that such photocopying was not a fair use even though the course packets were sold to and used by students. The defendants-appellants have filed an appeal with the United States Court of Appeals for the Sixth Circuit. This brief was filed by eleven copyright professors in support of the defendants-appellants. Counsel for the plaintiffs-appellees filed a motion to exclude this *amici curiae* brief.

This decision continues the trend of limiting the fair use doctrine in the context of learning and research as in *Basic Books, Inc. v. Kinko's Graphics Corp.* 758 F. Supp. 1522 (S.D.N.Y. 1991) and *American Geophysical Union v. Texaco* 37 F.3d 881 (2nd Cir. 1994). The Supreme Court has clearly identified the nature and purpose

of copyright and fair use in *Feist Publications, Inc. v. Rural Telephone Services Co.*, 499 U.S. 340 (1991) and *Campbell v. Acuff-Rose Music, Inc.*, ___ U.S. ___, 114 S. Ct. 1164 (1994). The *amici* brief argues that the district court failed to follow these binding precedents.

This debate is of particular interest to students and professors who until recently have had the freedom to use copyrighted materials in research and in classroom work, consistent with the constitutional mandate that copyright promote learning. On a broader scale, the decision redraws the parameters of the fair use doctrine, with implications for other aspects of copyright law.

It should be noted that the Association of Research Libraries, which includes 108 university based research libraries plus the national Libraries of Canada and the United States, became a signatory of the brief after it was filed. The National Libraries of the United States include the Library of Congress and the National Library of Medicine.

STATEMENT OF ISSUES[1]

1. Whether a copyshop is entitled to rely on a professor's fair use right for teaching by reproduction in copies ("including multiple copies for classroom use") when the copyshop makes copies only at direction of the professor who provides copy of the material to be reproduced.
2. Whether publishers can be lawfully empowered by judicial construction of the Copyright Act to require copyshop to serve as the publishers' licensing agent to collect license fees from students because copyshop makes copies at request of professors.
3. Whether denial of fair use defense to defendant copyshop denied students the fair use privilege of using materials for purposes of study and scholarship because copyshop, not professors, made the copies.

[1] As friends of the court, amici do not advocate the position of either party, but seek only to provide the court with information about the law of copyright acquired through years of study, research, and writing. Therefore, the issues in this brief are limited to those of importance to them as professors in the interest of academic freedom, to the public as underwriters of the educational process, and to students as beneficiaries of the preferred fair use for teaching purposes. To the extent a tone of advocacy is in the brief, it is advocacy in the public interest, not a party.

SUMMARY OF ARGUMENT

This is a case of statutory construction in which an appellate court for the first time is asked to determine whether a professor forfeits the right of fair use to make multiple copies for classroom use if he or she requests a copyshop to make the copies. Involved are issues of academic freedom, educational costs, and the fair use rights of students.

The district court determined that defendant copyshop was not entitled to fair use, and thus that professors forfeited the right of fair use by using the copyshop. The incongruous result is that students do not have to pay license fees if a professor makes the copies, but do if a copyshop makes the copies.

Although the copyshop made copies only at the request of professors and only for classroom use, the court's rationale for denying it the professors' right of fair use was that it charged for providing professors this service. The copyshop, however, did not charge for the use of the materials copied and did not receive any money publishers were entitled to. Publishers brought this action to obtain by judicial construction a "special private benefit," i.e., the right to create monopoly privileges by private contract and to avoid statutory safeguards that prevent copyright from being an unfettered monopoly. If they obtain that benefit, it will enable them to impose license fees on students for the classroom use of excerpts made from books in the library. In granting publishers this private benefit, however, the district court ignored relevant components of the copyright law and acted contrary to policy extending back to the beginning of the nation's history.

Copyright is a limited monopoly vested with a large public interest that the district court treated as personal property. The court thus ignored the nature of copyright as a statutory grant and the purpose of fair use as an anti-monopolistic, anti-censorship component of copyright law.

Contrary to Supreme Court precedent, the district court applied a bright-line rule to determine fair use and violated the two basic principles of fair-use application: 1) a work-by-work analysis; and 2) the exclusion of uncopyrightable material in determining the amount used. Thus the district court considered defendant's copyright of works not in the record and may have exceeded its

subject matter jurisdiction.

The district court by judicial construction gave plaintiff-publishers a double copyright monopoly: a monopoly of the sale of books and a monopoly of the right to reproduce excerpts from the books after they have been sold. To protect the second monopoly, the district court granted plaintiff-publishers a permanent copyright injunction that protects all their works as a class. This means that they do not have to fulfill either the constitutional or statutory conditions for copyright. Such injunctions destroy the public domain for literature and turn the Copyright Act into a licensing act for publishers. But whether that Act is to be a licensing act is for Congress, not copyright owners or courts, to determine.

This court must decide whether under the language of 17 U.S.C. § 107 (1977) professors forfeit their—or their students'—fair use right by using copyshops to make copies for classroom use. The ultimate question in this case, then, is whether the copyright statute is to be interpreted with integrity for the benefit of all, or whether it is to be interpreted without regard to coherence and consistency so as to provide a special private benefit for a few private interests.

ARGUMENT AND CITATION OF AUTHORITIES

I. THE DISTRICT COURT IGNORED RELEVANT COMPONENTS OF COPYRIGHT LAW IN DETERMINING THAT DEFENDANT'S USE WAS NOT A FAIR USE.

The copyright statute provides: ". . . [T]he fair use of a copyrighted work, including such use by reproduction in copies . . . for purposes such as . . . teaching (including multiple copies for classroom use), . . . is not an infringement of copyright." 17 U.S.C. § 107 (1977) (emphasis added). Although it states precisely what defendant in this case did, the district court ignored this statutory language.

To decide whether this was error, it is necessary to determine what the language means. Since this is a case of first impression at the appellate level, this court's decision on that point will not only shape copyright law in the Sixth Circuit, but also influence the development of that law in other circuits. The question is this: Do professors who have a fair use right to make multiple copies for classroom use forfeit that right if they have a copyshop make the copies? A proper interpretation of the copyright statute requires a negative answer.

A. The District Court Ignored Express Statutory Language that Should Control the Disposition of this Case.

Fair use is determined not by who does the act, but the act that is done, and "[i]n construing a federal statute it is appropriate to assume that the ordinary meaning of the language that Congress employed 'accurately expresses the legislative purpose.' " Mills Music, Inc. v. Snyder, 469 U.S. 153, 164 (1985). Therefore, why the district court disregarded the ordinary meaning of the language of section 107 permitting multiple copies for classroom use—without any limitation on who may make the copies—is not clear. Apparently, however, the court viewed the copyshop as making money off the plaintiff's property. "The defendant is taking the property of another without right or permission, using that property for personal gain." Order, p. 5.

The court was wrong. First, the distinction between printer and publisher,[2] means that the copyshop, a printer, did not receive any money to which publishers were entitled. The copying charges were the same for uncopyrighted and copyrighted material. And the copyshop did not use the work, because the users were professors exercising fair use rights. Lewis Galoob Toys, Inc. v. Nintendo of America, Inc., 964 F.2d 965, 970 (9th Cir. 1992) (users were individuals using product, not manufacturer of product).

Second, the essence of individual property is the right to exclude use by others.[3] If it were private property unfettered with a public interest, copyright would give publishers the right to exclude any copying by anyone. This is censorship.[4] The court thus vested the power of censorship in publishers by treating copyright as a private property unfettered with a public interest and thereby making the copyright owner's right to copy absolute. This was error. "The monopoly privileges [of copyright] that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit." Sony Corp. v. Universal City Studios, 464 U.S. 417, 429 (1984) (Sony) (viewers may copy copyrighted motion pictures off-the-air in their entirety). Therefore, to the extent copyright is property, it is property vested with a public interest, since "the limited grant is a means by which an important public purpose may be achieved." Id. Thus, as with public utilities, property rights of copyright owners must be kept within the parameters of the public interest.

The district court's Order would extend the publishers' property interest far beyond those parameters and empower publishers to require a copying license for teachers to use excerpts from books (or

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[2] See, e.g., First Comics, Inc. v. World Color Press, Inc., 884 F.2d 1033 (7th Cir. 1989). The distinction is shown by the printer's right in sixteenth century England "evidence that the essential element of copyright was not the right to print, but the right to protection, once the book was published, in order to secure the profit from the sale." L. R. Patterson, Copyright in Historical Perspective 51 (1968).

[3] "An essential element of individual property is the legal right to exclude others from enjoying it. If the property is private, the right of exclusion may be absolute; if the property is affected with a public interest, the right of exclusion is qualified." International News Service v. Associated Press, 248 U.S. 215, 250 (1918) (Brandeis, J., dissenting).

[4] The New Kids on the Block v. News America Publishing, Inc., 971 F.2d 302, 308 n.6 (9th Cir. 1992) ("A prohibition on all copying whatsoever would stifle the free flow of ideas without serving any legitimate interest of the copyright holder.").

journals) for classroom teaching. However beneficial to publishers, such a right would clearly be detrimental to the public interest. It would mean that in addition to the purchase price for the book, publishers would be entitled to two license fees: 1) from professors for making the copy to be reproduced;[5] and 2) from the copyshop for reproducing copies. But the publishers' goal apparently is only to compel copyshops to become their agents to collect license fees from students.

The irony is that this kind of power for publishers granted by judicial construction is precisely the kind that the framers intended to prevent Congress from granting by legislation. The copyright clause is a limitation on, as well as a grant of, legislative power. Thus, the language of the Copyright Clause—"The Congress shall have Power . . . To Promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings . . ." U.S. Const., art. I, § 8, cl. 8.—explains why the Supreme Court early rejected the claim that copyright statutes protect existing property rights. Wheaton v. Peters, 33 U.S. (8 Pet.) 591, 660 (1834) ("Congress, then, by this [copyright] act, instead of sanctioning an existing right, as contended for, created it.")

This limitation serves a practical purpose: It enables Congress to impose the conditions that are necessary for copyright to accommodate the interests of three groups—authors (who write books), publishers (who, as assignees of authors, print and sell books), and members of the public (who use books)—in order to promote learning. The progress of learning thus requires a balancing of interests, which in turn requires limited property rights vested with a public interest, because property rights in "ideas and information" are inimical to both learning and free speech rights. Harper & Row v. Nation Enterprises, 471 U.S. 539, 589-90 (1985) (Brennan, J., dissenting) ("to ensure the progress of arts and sciences and integrity of First Amendment values, ideas and information must not be freighted with claims of proprietary right").

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[5] Atari Games Corp. v. Nintendo of America, Inc., 975 F.2d 832, 840 (Fed. Cir. 1992) ("A single copy is sufficient to support a claim of copyright infringement."); cf. Universal Pictures Co. v. Harold Lloyd Corp., 162 F.2d 354 (9th Cir. 1947) (defendant a contributory infringer because he selected materials for inclusion in direct infringer's motion picture).

Fair use represents the policy against freighting ideas and information with proprietary claims. Although it has been said to be " 'the most troublesome in the whole law of copyright,' " Sony, 464 U.S. at 475 (1984) (Blackmun, J., dissenting), Congress made special efforts to make sure that the fair use doctrine would not be troublesome in the educational context. Amici believe there was only one logical reason for giving teaching a preferred fair use status: To prevent copyright from being used to inhibit classroom teaching, the quintessential use of copyright to fulfill its constitutional purpose—the promotion of learning. This is why the language of section 107 makes teaching a preferred fair use and says as plainly as statutory language can that multiple copies for classroom use is not an infringement.

The district court's disregard of plain statutory language making teaching a preferred fair use is baffling. Apart from teaching, the fair use doctrine is sound policy,[6] and Congress reflected the drafters' wisdom as well as Wheaton's ruling in giving users a statutory right to make fair use of a copyrighted work. Moreover, Congress emphasized the importance of the fair use right by making it the only limitation on copyright that applies to all rights of the copyright owner and to all copyrighted works. Even § 108, "Limitations on Exclusive Rights: Reproduction by libraries and archives," provides that "Nothing in this section—. . .(4) in any way affects the right of fair use as provided by section 107." 17 U.S.C. § 108(f)(4) (1977) (emphasis added).[7]

B. The District Court Failed to Apply Recent Decisions of the Supreme Court Relevant to the Fair Use of Copyrighted Works.

The district court not only failed to apply the plain wording of the copyright statute, it also failed to apply two recent Supreme Court

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[6] The New Kids on the Block, 971 F.2d at 307 n.6.

[7] One must read § 108 to appreciate the significance of this point. The section not only goes into great detail as to the scope of copying permitted by libraries and archives, it also excludes the right of these entities to reproduce: "a musical work, a pictorial, graphic or sculptural work, or a motion picture or other audiovisual work other than an audiovisual work dealing with news." 17 U.S.C. § 108(h) (1977). Yet, Congress provided that fair use is to override these limitations.

decisions that limit the scope of copyright protection and enlarge the right of fair use. They are: Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991) [hereinafter Feist] (white pages of telephone directories not entitled to copyright protection because they lack originality); and Luther R. Campbell a/k/a Luke Skyywalker, et al. v. Acuff-Rose Music, Inc., ___U.S.___, 114 S. Ct. 1164 (1994) [hereinafter Acuff-Rose] (commercial parody of popular song may be fair use).

The importance of Feist and Acuff-Rose is that they correct errors of lower courts that had distorted the legal landscape of copyright by misinterpreting the copyright statute. Some lower courts had extended copyright protection to unoriginal materials, an error that the Supreme Court in Feist corrected by repeatedly emphasizing originality as a constitutional requirement for copyright.[8] Other lower courts had held that the commercial use of a work creates a presumption that the use is not fair, which the Supreme Court in Acuff-Rose rejected, emphasizing that fair use is to be determined in light of all four statutory factors on a case-by-case basis.[9]

In correcting prior judicial errors that broadened the scope of copyright protection and narrowed the right of fair use, the Supreme Court narrowed the scope of copyright protection unlawfully granted and broadened the right of fair use unlawfully denied. Thus, no court deciding a fair use case can afford to ignore either Feist or Acuff-Rose because: 1) many copyrighted works contain unoriginal materials and fair use can apply only to original material in a copyrighted work; and 2) the determination of fair use cannot be made with a bright-line rule and must be made on a case-by-case, which it so say work-by-work, basis.

But having ignored the Supreme Court decisions, the district court in this case made every error the Supreme Court rulings were

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[8] Specifically, Feist holds that: 1) only the original components of a work can be protected by copyright, 449 U.S. 340, passim; 2) there is a constitutional right to use unoriginal materials in a copyrighted work, id. at 349; and 3) to prove infringement a plaintiff must prove the taking of original material. Id. at 361.

[9] Specifically, Acuff-Rose: 1) rules that fair use "calls for case-by-case analysis," 114 S. Ct. at 1174; 2) in light of the purposes of copyright, id. at 1171; 3) says that courts are not to use a bright line rule in fair use cases, id. at 1170; and 4) rejects the presumption that a commercial use is not a fair use. Id. The court also noted that the reproduction of multiple copies for classroom distribution is a statutory exception to the "transformative use" doctrine. Id. at 1170 n.11.

intended to prevent. Those errors culminated in the grant of a permanent copyright injunction that protects copyrighted works without regard to originality and destroys the right of fair use for the works protected.

C. The District Court Failed to Apply the Law as to the Nature and Purpose of Copyright and of Fair Use.

Had the district court understood the nature and purpose of copyright and fair use, it surely would not have ignored Supreme Court precedent and ruled as it did. For it would have understood that:

> 1) copyright is the grant of a limited statutory monopoly and the duty of copyright owners not to inhibit the fair use of copyrighted works is but a small price for the reward—the exclusive right of publication—because copyright owners have no right to preclude a reasonable use of copyrighted works anyway. Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975) [hereinafter Aiken] ("Private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the other arts,"); and
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> 2) fair use is the anti-monopolistic component of copyright law to keep the statutory monopoly within constitutional limits and who does the copying is not a factor in the fair use analysis.[10]

1. Copyright is a statutory monopoly granted in the public interest consisting of limited rights for a limited period of time.

Copyright is a limited statutory monopoly granted in the public interest that consists of limited property rights, 17 U.S.C. § 106 (1977) (Exclusive rights in copyrighted works), for a limited period of time. 17 U.S.C. § 302 (1977) (Duration of copyright). In the

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[10] The four statutory factors to be used in analyzing fair use are: purpose of use; nature of work; amount taken; and economic impact. 17 U.S.C. § 107 (1977).

words of the Supreme Court: "A copyright, like other intellectual property, comprises 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) (emphasis added).[11]

Although the precisely defined interests are necessary for copyright to accommodate the interest of three groups—authors, publishers, and users—publishers seem to be able to convince courts that their interests as copyright holders must prevail over all others. A frightening example is this case, which held the copyright owner's right to copy to be in effect absolute. This holding, however, is contrary to Supreme Court precedent other than the recent cases discussed. To return to an earlier point:

"The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved." Sony, 464 U.S. 417, 429 (1985); cf. Fox Film Corp. v. Doyal, 286 U.S. 123, 127 (1932) ("sole interest of the United States and the primary object in conferring the monopoly [of copyright] lie in the general benefits derived by the public from the labors of authors"); United States v. Paramount Picture, Inc., 334 U.S. 131, 158 (1948) ("copyright law . . . makes reward to the owner a secondary consideration"); Aiken, 422 U.S. at 156 (noting that copyright is primarily to benefit public, secondarily to benefit author). Congress agrees. "Not primarily for the benefit of the author, but primarily for the benefit of the public, such rights are given." H.R. Rep. No. 2222, 60th Cong. 2d Sess. 7 (1909).

Thus, under the copyright statute, as Dowling says, the property rights of publishers (copyright owners by assignment) are conditional rights subject to statutory limitations, as they must be in light of the nature and purpose of copyright.

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[11] These interests are five in number. They are to reproduce the work in copies, to prepare derivative works, to distribute the work publicly, to perform the work publicly, and to display the work publicly. 17 U.S.C. § 106 (1977).

2. Fair use is the anti-monopolistic, anti-censorship component of copyright law that ensures the right of fair copying of excerpts from copyrighted materials.

As this case demonstrates, copyright as merely another species of property empowers copyright owners to require a license for any copying of excerpts. This is the way copyright becomes a monopolistic device of censorship. For just as the power to tax a bank is the power to destroy the bank, the power to license the use of books is the power to censor those books.[12] An example is the right of a publisher to charge the owner of three subscriptions to a scholarly journal (costing a total of $2484) a license fee for copying one article for research purposes.[13] Herein lies the importance of the right to make multiple copies for classroom use. So long as this right exists, it is a barrier to the fruition of the monopolistic and censorship tendencies of copyright as an unfettered property right that copyright owners seek.

Thus, as Acuff-Rose's rejection of the unlawful narrowing of fair use indicates, fair use is the anti-monopolistic and anti-censorship component of copyright law that protects the user's right of fair access by fair copying, which is necessary if copyright is to promote learning as the Constitution requires. U.S. Const. art. I, § 8, cl. 8. "It is axiomatic that learning relative to a work requires access to the work . . . This represents one of two significant policies embodied in the Copyright Clause." Cable News Network v. Video Monitoring Services of America, 940 F.2d 1471, 1478 n.12 (11th Cir. 1991), reh. en banc granted, 949 F.2d 378, appeal dismissed, 959 F.2d 188 (1992) [hereinafter CNN].[14] Thus, fair use "is in harmony with the First Amendment doctrine that free speech

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[12] If copyright owners can require a license for a person to copy any excerpt from a book or journal, the next step is to require a license for reading a book or journal. The agencies for imposing this license, of course, will be rental libraries, which will replace free public lending libraries and collect the license fees.

[13] See American Geophysical Union v. Texaco, Inc., 802 F. Supp. 1, 7 (S.D.N.Y. 1992).

[14] No case of any other Circuit is binding precedent in the Sixth Circuit and the court relies on such cases only for their perceptive analysis and sound reasoning. On this basis, CNN is enormously helpful. In dismissing the appeal on procedural grounds, the Eleventh Circuit did not question either the analysis or reasoning of Judge Birch's opinion for a unanimous panel. Indeed, although vacated, the opinion was the subject of a prize winning comment in 53 Ohio State L. Jour. 1155 (1992).

encompasses 'public access to discussion, debate and dissemination of information and ideas.' " Id. at 1479 (citations omitted).

Congress intended that copyright ensure fair access. Stewart v. Abend, 495 U.S. 207, 228 (1990) ("[Copyright] Act creates a balance between the artist's right to control the work . . . and the public's need for access"); Brown v. Tabb, 714 F.2d 1088, 1092 (11th Cir. 1983) ("the limited monopoly concept of federal law represents an attempt to strike a balance between the interest of authors in the fruits of their labors and the interest of the public in claiming access to material"); cf. Sega Enterprises v. Accolade, Inc., 977 F.2d 1510, 1518 (9th Cir. 1993) (holding that disassembly of computer object code is fair use if disassembly is only means of access to unprotected elements).[15] Thus if fair access—however that right is defined—requires copying, fair use becomes a synonym for fair copying.

In this case, however, publishers have managed to diminish the fair use doctrine (and avoid the user's right of fair copying) despite the fact that the 1976 Act "sets limits on the scope of copyright protection."[16] Indeed, the success of publishers in minimizing the right of fair use may explain why the Supreme Court decided to make constitutional rights a part of the fair use equation.

3. The Supreme Court has Made Constitutional Rights a Part of the Fair Use Equation.

The Supreme Court in Feist made constitutional rights a part of the fair use equation. Saying that "it may seem unfair that much of the fruit of the compiler's labor may be used by others without compensation," the Court concluded that this "is not 'some unfore-

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[15] It should be noted that under the copyright statute, computer programs are classed as literary works, as are books. 17 U.S.C. § 101 (1977) (definition of literary works); Atari Games Corp. v. Nintendo of America Inc., 975 F.2d 832, 838 (Fed. Cir. 1992).

[16] Atari Games Corp., 975 F.2d at 838. There are two tendencies that help to explain the success of publishers in getting courts to treat a constitutional grant to authors in the public interest as being for the publishers' primary benefit. One is the inflation-of-rights tendency, as a result of the "natural tendency of legal rights to express themselves in absolute terms to the exclusion of all else," which is "particularly pronounced" in copyright owners. Sony Corp., 464 U.S. at 432 n.13 (1984). The other is the proprietary tendency that pervades American law with the notion that property rights are absolute. Both serve to choke off the public's right of fair use.

seen byproduct of a statutory scheme,' . . . it is, rather, 'the essence of copyright,' and a constitutional requirement." Feist, 499 U.S. at 349 (cites omitted; emphasis added). The Court thus recognized that the Copyright Clause itself contains free speech values.

Copyright owners can reasonably argue that the Court's language in Feist refers only to unprotectable, i.e. unoriginal, material in a compilation. But whether or not one agrees that the Supreme Court in Feist constitutionalized fair use, the Court did constitutionalize the right to use, and thus the right to copy, unoriginal material in a copyrighted work. No one, then, can deny that constitutional rights have now become a part of the fair use equation. And presumably the Supreme Court made them so because so many copyrighted works contain so much unoriginal material that cannot constitutionally be protected by copyright.

The position of plaintiff publishers that copyright empowers them to license the copying of excerpts from books they have sold is thus constitutionally infirm, because it is: 1) a corruption of copyright law; and 2) the essence of censorship. Apart from integrity in the administration of copyright law, the only defense against both the monopoly and censorship dangers is the fair use doctrine.

II. THE STATUTORY SCHEME OF COPYRIGHT PROVIDES SAFEGUARDS, INCLUDING THE FAIR USE DOCTRINE, TO PREVENT COPYRIGHT FROM BEING A HARMFUL MONOPOLY.

Congress enacted the copyright statute, but courts interpret it. Unfortunately, the statute is long and complex and one of its purposes—to keep the copyright monopoly within constitutional limits—is sometimes lost. Because courts in copyright decisions usually speak in terms of the rights of authors, the point that is often difficult to grasp is this: It is not the author, but the author's assignee—the publisher—who is the monopolist. Thus, no one author, not even the most prolific, can write enough books to create a significant monopoly. Agatha Christie, for example, wrote dozens of detective books and never monopolized detective fiction. But a single publisher, if it is the assignee of its authors' copyrights and if it is large enough, has a monopoly of profound significance.

Moreover, publishers can and do act in concert, as they did in the creation of the Copyright Clearance Center,[17] and as they do with the Copyright Compliance Office of the Association of American Publishers, Inc.[18] and in filing this lawsuit. A copyright owned by an author and one held by a publisher as assignee, then, have different consequences. Owned by an author, copyright presents no danger of a harmful monopoly; owned by a publisher, it does. This case is a classic example, and a brief explanation of the statutory scheme of copyright—and the place of fair use in that scheme—may assist the court in understanding the statutory safeguards against this danger.

There are four such safeguards. Two, the meaning of copyright and the fair use doctrine, were discussed above. The other two are discussed here. They are: 1) the requirement of originality, 17 U.S.C. § 102(a) (1977); and 2) the types of copyrighted works, 17 U.S.C. §§ 102(a), 103 (1977).

A. Originality is a Condition Precedent for Copyright.

Originality is a condition precedent for copyright. U.S. Const., art. I, § 8, cl. 8; Feist, 499 U.S. 340 (1991). Therefore, Congress in the 1976 Copyright Act provided that: "Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression . . ." 17 U.S.C. § 102(a) (1977) (emphasis added).

The point here is that the requirement of originality is a fundamental limitation to protect the public domain—as important to learning as the creation of new works—by preventing the use of copyright to control unoriginal material. Where the material is not original, anyone may use it as he or she pleases. Roth Greeting Cards v. United Card Co., 429 F.2d 1106, 1109 n.3 (9th Cir. 1970) (non-protected material may be copied with impunity), cited in

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[17] See American Geophysical Union v. Texaco, Inc. 802 F. Supp. 7 n.4 (S.D.N.Y. 1992). The Copyright Clearance Center is an organization of publishers that collects and distributes licensing fees for photocopying materials registered with it. As of 1990, over 8000 publishers had registered over 1.5 million texts with the CCC. See generally, id. at 4-9.

[18] See L. Patterson, Copyright and "The exclusive Right" of Authors, 1 J. Intel. Prop L. 44-48 (1993) (copyright compliance letter of American Association of Publishers sent to alleged offending copyshop) (originally included as appendix I to this brief).

Narell v. Freeman, 872 F.2d 907, 910 (9th Cir. 1989) (in infringement action, copyright owner must prove copying of protected elements of work.).

B. The Types of Copyrightable Works are: Predominantly Original Works Under § 102; and Compilations and Derivative Works Under § 103.

Although originality is a constitutional requirement for copyright, an author may satisfy the originality requirement in three different ways: 1) by creating new works, 17 U.S.C. § 102 (1977); 2) by compiling data or preexisting works in an original manner, 17 U.S.C. § 103 (1977); 17 U.S.C. § 101 (1977) (definition of compilation); or 3) by transforming a preexisting work into another work. 17 U.S.C. § 103 (1977); 17 U.S.C. § 101 (1977) (definition of derivative work).

Thus, an author may satisfy the originality requirement by creating something new (a poem, novel or drama—an original work of authorship under § 102); or by selecting, coordinating or arranging data or preexisting materials, in an original manner (a directory or an anthology of stories or poems—a compilation under § 103); or by recasting, transforming or adapting a work into a different work (a movie based on a novel—a derivative work also under § 103).

1. The scope of copyright protection varies for different type works according to their originality.

There is, however, a caveat. The less the originality, the less the protection because the scope of copyright protection depends upon the amount of originality in a work. Feist, 449 U.S. 340, passim. For example, the originality required for a compilation is the selection, arrangement or coordination of data or preexisting materials, 17 U.S.C. § 101 (1977) (definition of compilation); thus, the copyright in a compilation protects these elements, but not the preexisting data or material that is compiled. 17 U.S.C. § 103(b) (1977) ("The copyright in a compilation or derivative work extends only to the material contributed by the author of such work . . . and does not imply any exclusive right in the preexisting material. The

copyright in such work is independent of . . . any copyright protection in the preexisting material.")

Because a compilation copyright protects the compilation as such—not the preexisting materials compiled—an unauthorized person may not reproduce and sell the compilation, e.g., an anthology of eighteenth and nineteenth century British dramas. Such conduct copies the anthologist's selection, coordination or arrangement; but a person may copy and use individual dramas taken from the public domain, where they remain even though put into a copyrighted work. If the individual dramas are still under copyright (being used by permission), one who wishes to use a drama must obtain permission from the dramatist (or one who holds the copyright), but not from the anthologist.

The same principle applies to works that are predominantly original. A novel is a § 102 predominantly original work entitled to plenary copyright protection. But if the novel's hero recites a Shakespearean sonnet to the heroine, the copyright on the novel does not protect the sonnet.

2. The variable scope of copyright protection requires two basic principles of fair use application: work-by-work analysis and exclusion of unoriginal materials.

There are two basic principles in applying the fair use doctrine. One is that it be applied on a case-by-case basis; the other is that unoriginal material be excluded from the amount used. The district court ignored both.

The Supreme Court in Acuff-Rose reinforced the principle that the fair use doctrine "calls for case-by-case analysis." Acuff-Rose, 114 S. Ct. at 1170, citing "Harper & Row, 471 U.S. at 560; Sony, 464 U.S. at 448, and n.31; House Report, pp. 65-66; Senate Report, p. 62." The term case-by-case analysis, of course, is a synonym for work-by-work analysis, for unless the analysis is applied to each of a group of works in one case, a finding of infringement of the works defeats the right of fair use.[19]

[19] The usual copyright case involves a single work, and a case-by-case analysis is thus a work-by-work analysis. Moreover, the fact that a copyrighted work may contain unprotected material is additional evidence that a work-by-work analysis is required.

The other principle—that unoriginal material must be excluded from the fair use analysis—also requires a work-by-work analysis, for it derives from the fact that unoriginal components of a copyrighted work cannot be protected by copyright. Feist, 499 U.S. 340, passim. This is why to determine fair use a court must exclude unoriginal components of a work from the amount used. See Computer Assoc. Int'l, Inc. v. Altai, Inc., 982 F.2d 693, 721 (9th Cir. 1992) (three-step analysis to filter out unprotected material of computer program to ensure that it remains in the public domain). The issue, in short, is the use of a work, not a course of conduct.

The district court, however, violated both of these principles because it relied on defendant's course of conduct in copying excerpts from works other than those of plaintiffs. Thus the court characterized the copying of works in the record "as but the tip of the iceberg" and emphasized that "the six excerpts alleged in this case are part of a considerably larger group of 10,000 to 15,000 copyrighted excerpts copied each semester." Order, p. 3.

By treating the issue as defendant's course of conduct involving thousands of works—rather than the use of the six works in issue—the district court simplified its task with a bright line rule: providing a copying service for professors precludes the fair use defense. The court thus did precisely what the Supreme Court said it could not: "The task [of determining fair use] is not to be simplified with bright-line rules, for the statute, like the doctrine it recognizes, calls for case-by-case analysis." Acuff-Rose, 114 S. Ct. at 1170.

This case provides an example of why the Supreme Court protects the fair use doctrine by prohibiting the use of a bright-line rule. The excerpts copied came from "books, journal articles, newspaper articles, course notes or syllabi, sample test questions, and reference to further works," Order, p. 2, that were not in the record. The district court thus assumed that just because an excerpt comes from a copyrighted work, the excerpt is protected by copyright. The assumption was wrong, 17 U.S.C. § 103 (1977), but apparently for the court was determinative.

C. The District Court Negated the Fair Use Doctrine as a Safeguard against Copyright as a Harmful Monopoly.

Fair use is not unlimited. A ruling that any and all copying for classroom use is always a fair use would be as illogical as the district court's ruling that no copying by a copyshop for classroom use can be a fair use.[20] But fair use does exist. And it exists as a right of users to prevent copyright from becoming a harmful monopoly.

This conclusion is warranted by the fact that the Supreme Court in Feist narrowed the unlawfully broadened scope of copyright protection and made constitutional rights a part of the fair use equation; and in Acuff-Rose enlarged the unlawfully narrowed right of fair use with four rulings: 1) Fair use requires a case-by-case analysis; 2) courts are not to use bright line rules in deciding fair use issues; 3) the commercial use presumption is not valid; and 4) the four factors of § 107 are to be applied in light of the purpose of copyright. Note 9, supra.

The significance of the district court's disregard of both Feist and Acuff-Rose is now apparent: The district court denied professors and students a constitutional right of access that requires copying and is protected by Feist; and, it negated fair use as a safeguard to ensure this right. Under the permanent injunction it granted, defendants cannot make any copy of any portion of plaintiff-publishers' works for any purpose without permission.

III. THE DISTRICT COURT USED AN IMPROPER RATIONALE FOR ITS DECISION AND MAY HAVE EXCEEDED ITS SUBJECT MATTER JURISDICTION.

The district court's ratio decidendi was that "The defendant is taking the property of another without right or permission, using that property for personal gain. There is simply no excuse for this conduct." Order, p. 5. Apart from the fact that the district court

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[20] It is worth noting that the problem of copying a complete book will usually resolve itself. The cost of such copying would normally equal or exceed the retail cost of the book. Thus, no purpose would be served by expending time and energy, as well as money, to get what could be had cheaper from the bookseller.

ignored the limited nature of a copyright owner's property rights, it based its conclusion not on the basis of the copying from the six works in issue, but on the basis of the defendant's alleged copying from thousands of other works. To add to the evidence mentioned above: "The copying which is the subject of this litigation is but the tip of the iceberg." Order, p. 3. The extent to which the court was influenced by the alleged iceberg is indicated by its recitation of figures: "25,000 coursepacks," "700 different courses," "2,900 copyrighted excerpts," "10,000 to 15,000 copyrighted excerpts." Id.

These figures represent the forbidden bright-line rule discussed earlier, and the results of the court's ruling are obvious: Rejection of the fair use rights of 700 professors (assuming one professor per course) and 25,000 students (assuming one student per coursepack). The question is not whether defendant took the property of another, but whether a court is free to take away rights that Congress has granted.

The emotional impact of these figures on the district judge led her, presumably unwittingly, to override clear provisions of the Copyright Act. This is one reason for excluding the bright line rule. Emotion induced by irrelevant facts is a poor substitute for legal analysis based on the law and relevant evidence. There is an important difference, for example, between "copyrighted excerpts" and excerpts from "copyrighted works." The difference has important consequences. In an infringement action, the copyright owner must prove the taking of original components, Feist, 449 U.S. at 361; or "protected expression." Atari Games Corp., 975 F.2d at 837; Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1472 (9th Cir. 1992).

The important point, however, is that the emotional impact of the gross figures induced the district court to disregard four statutory safeguards, two substantive and two procedural, that Congress enacted to keep the copyright monopoly within the bounds that the Constitution defines. The substantive safeguards are originality (required by the Copyright Clause) and the fair use doctrine (required by the First Amendment as well as the Copyright Clause), discussed above. The procedural safeguards are subject matter jurisdiction and standing to sue.

A. The District Court Gave Substantive Effect to Works Alleged to be Copyrighted But Which Were Not in the Record.

Whether the district court in fact exceeded its subject matter jurisdiction in considering thousands of allegedly copyrighted works not in the record need not be decided. For even if the court did not exceed its jurisdiction, its Order suffers from the defect of a court that does: the substitution of emotional reaction for legal analysis, of personal opinion for the rule of law.

The possibility that the district court did exceed its subject matter jurisdiction, however, is based on the copyright statute, which provides: "[N]o action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title. . . ." 17 U.S.C. § 411(a) (1977).

Registration is a jurisdictional requirement.[21] Unless this provision also means that "No infringement of the copyright in any work shall be determined for purposes of decision" by a court unless it is registered, a jurisdictional requirement has been nullified to a large extent. But Congress attached great significance to registration as the House Report on the Berne Convention Implementation Act of 1988 shows. In support of the decision to retain registration, the Report said:

> The Committee is also concerned that abolition of section 411(a) would result in attempts to use the legal system to exert control over materials that Congress intends to be in the public domain. . . .

H.R. Rep. 100-609, Berne Convention Implementation Act of 1988 21-22 (1988) (emphasis added).

The district court's Order in this case does what Congress decided not to do. It eliminates § 411 for works not in issue and assists publishers in using "the legal system to exert control over materials that Congress intends to be in the public domain."

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[21] MGB Homes, Inc. v. Ameron Homes, Inc., 903 F.2d 1486, 1488 (11th Cir. 1990) (registration jurisdictional prerequisite to an infringement suit.).

B. Plaintiffs Had No Standing to Complain About the Alleged Infringement of Copyrighted Works They Did Not Own.

The Copyright Act also uses the standing-to-sue doctrine as a further limitation of the copyright monopoly. Only the legal or beneficial owner may sue for an infringement of the copyright. 17 U.S.C. § 501(b) (1977); Cortner v. Israel, 732 F.2d 267 (2d Cir. 1984) (applying § 501(b)). The plaintiff-publishers thus had no standing to complain about the defendant's use of copyrighted works other than their own. Yet, they persuaded the district court to consider the alleged infringement of thousands of allegedly copyrighted works owned by others to prove that the use of their six works was unfair use.

The district court, by granting them a permanent injunction protecting all their copyrights—present, as well as future—created for plaintiff publishers common law copyrights, which, by relieving them of the burden of complying with the copyright statute, protects even uncopyrightable components of the works.

The subject-matter jurisdiction and standing-to-sue requirements, however, are part of the statutory plan that Congress enacted with a serious purpose: to keep the copyright monopoly within constitutional bounds. Given the importance of the goal, courts should be very careful about rulings that may serve to defeat the legislative plan to achieve it.

IV. COURTS SHOULD NOT CONSTRUE SECTION 106(1) TO GIVE PUBLISHERS A DOUBLE COPYRIGHT MONOPOLY IN VIEW OF THE LIMITATIONS ON THAT MONOPOLY IN SECTION 106(3).

The first effort of publishers to make copyright a double monopoly was the attempt to get "an additional prerogative enabling the [copyright] holder to restrict future sales." Sebastian International, Inc. v. Consumer Contacts (PTY) Ltd., 847 F.2d 1093, 1095 (3d Cir. 1988). The basis of the claim was that the copyright statute gave the copyright owner the right to sell copies of the work without

limitation.[22] The courts rejected this attempt, holding that the right to vend was exhausted with the first sale, Bobbs-Merrill Co. v. Straus, 210 U.S. 339, 350 (1908) ("one who has sold a copyrighted article, without restrictions, has parted with all right to control the sale of it."), and thereby created the "first sale doctrine," now codified as 17 U.S.C. § 109 (1977). See I P. Goldstein, Copyright § 5.6.1, p. 594 (1989).

The claim of the right to license the copying of copies that have been sold is the first sale problem revisited. Publishers in this case attempt to get an additional prerogative enabling them to restrict all future copying, despite the fair use doctrine. Thus, plaintiff publishers in this case sold the books in issue and now seek to require a license for professors to copy any excerpt from the books for classroom use. In claiming this right, however, the publishers not only ignore the fair use doctrine, they rely wholly on section 106(1) and ignore section 106(3) in the grant of rights section of the statute.

The sections say that a copyright owner has the right "(1) to reproduce the copyrighted work in copies or phonorecords," 17 U.S.C. § 106(1) (1977), and "(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending." 17 U.S.C. § 106(1)(3) (1977) (emphasis added). Under § 106(3), a copyright owner can sell or lease copies of the copyrighted work, but not both at the same time.

If the copyright owner sells the copy, he or she has parted with title to, and control of, that copy. Just as "the patentee's control over the product when it leaves his hands is sharply limited," Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 230 (1964), so is the copyright owner's control over the book he or she has sold. Lewis Galoob Toys v. Nintendo of America, 964 F.2d 965, 971 (9th Cir. 1992) ("a party who distributes a copyrighted work cannot dictate how that work is to be enjoyed").

If the copyright owner leases the copy, presumably he or she or it can require a license fee for copying the copy as part of the license agreement. The question is whether Congress intended that

[22] Thus, the copyright owner had the exclusive right to "print, reprint, publish, copy, and vend the copyrighted work." 17 U.S.C. § 1 (1977) (1909 Act.).

the owner be able to sell the copies and then require purchasers of the copies (or anyone else) to obtain a license to copy any excerpts.

An analysis of the statute indicates that Congress did not intend this result. The starting point for analyzing the problem is the difference between the work and the copy of the work, which Congress relied on in enacting the 1976 Copyright Act. The distinction was necessary because Congress provided copyright protection only for the original work of authorship, 17 U.S.C. § 102(a) (1977), not the copy (which may include unoriginal material). The House Report explained the difference:

> The definitions of these terms [copies and phonorecords] in section 101 together with their usage in section 102 and throughout the bill, reflect a fundamental distinction between the 'original work' which is the product of 'authorship' and the multitude of material objects in which it can be embodied. Thus, in the sense of the bill, a 'book' is not a work of authorship, but is a particular kind of 'copy.' Instead, the author may write a 'literary work,' which in turn can be embodied in a wide range of 'copies' and 'phonorecords,' including books, periodicals, computer punch cards microfilm, tape recordings, and so forth.

House Report No. 94-1476, 94th Cong., 2d Sess. 53 (1976).

The exclusive right to reproduce the work thus is now limited to original material in the work by express statutory provision consistent with constitutional requirements. 17 U.S.C. § 102(a) (1977).

The distinction between the work and the copy, then, is important to this case because copyright can protect only original material and the copy may contain unoriginal material. Thus to determine whether the copyright owner can license the copying of the copy that has been sold it is necessary to construe the relationship of 106(1) and 106(3) in light of § 102(a): Can copyright owners have a monopoly under 106(3) for the sale of copies (books) to the public; and also a monopoly in the form of "an additional prerogative" under 106(1) to license the copying of any excerpts (including unoriginal material) from the copies (books) sold? Note that the

issue is not whether the copyright owner can prevent copying that is infringement, but whether he or she or it can prevent any fair use copying. It is this right to preclude fair use copying that makes the right to control the copying of the copy a second monopoly.[23]

This court need only analyze the potential consequences of "the additional prerogative" to determine that it should reach the same result that courts faced with the publishers' claim to control the resale of books reached. Those courts denied the claim of an additional prerogative and thus denied copyright holders a double copyright monopoly.

The effect of a double copyright monopoly under 106(1) and 106(3) is: 1) to eliminate the distinction between the work and the copy; 2) to make the right to reproduce the work in copies absolute; and 3) to provide copyright protection for unoriginal material and defeat the right of fair use.

A. The Right to License Copying the Copy Eliminates the Distinction Between the Work and the Copy.

The distinction between the work and the copy that Congress relied on in enacting the 1976 Copyright Act, discussed above, serves an important function. It is the basis for the distinction between the use of the work and the use of the copyright, a distinction courts used in creating the "first sale" doctrine: the first sale was the use of the copyright, the resale by the purchaser was a use of the work.[24] Thus the use of the copyright is the exercise of a right reserved to the copyright owner; the use of the work is not.[25] One who translates a work makes a derivative work (17

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[23] It is worthy of note that if the right to license copying is confirmed, it will exist for the life of the author plus fifty years or 75 years. 17 U.S.C. § 302 (1977). Thus publishers will be able to charge licensing fees for the same books for three generations of students.

[24] "In Columbia Picture Indus. v. Redd Horne, Inc., 749 F.2d 154 (3d Cir. 1984) we commented that section 109(a) 'is an extension of the principle that ownership of the material object is distinct from ownership of the copyright in this material. The first sale doctrine prevents the copyright owner from controlling the future transfer of a particular copy once its material ownership has been transferred.' Id. at 159." Sebastian International, Inc. v. Consumer Contacts, 847 F.2d at 1095.

[25] This distinction is based on "the separate ownership of the right of copying from that which inheres in the mere physical control of the thing itself," American Tobacco Co. v. Werckmeister, 207 U.S. 284, 299 (1907), codified in 17 U.S.C. § 202 (1977), "Ownership of

U.S.C. § 106(2) (1977) or copies the work to distribute it publicly (17 U.S.C. § 106(3) (1977)) uses the copyright, which requires the copyright owner's permission. The question is whether one who makes a single copy for study is using the copyright or the work.[26] The Supreme Court has recognized that the making of a single copy for personal use is fair use.[27] And in the past, at least, the owner of a book was free "to copy passages from it at will."[28] It is this right to use the work that is under attack in this case.

B. The Right to License Copying the Copy Makes the Right to Reproduce in Copies Absolute.

The copyright owner can license others to do only what it has a right to do. Thus the right to license the copying of the copies requires that the copyright owner have the right to copy the copies that he or she has sold. Therefore, if publishers have the right to license the copying of copies as they claim, they have made the right to reproduce copies absolute. The copyright owner's right to copy, however, is not, and cannot be, absolute so long as the constitutional right of fair access by fair copying exists. Thus to say that the copyright owner can grant a license to copy the copy is to make the right to copy absolute by default. But this decision is for Congress, not for courts.

Copyright as Distinct From Ownership of Material Object."

[26] Much of the confusion about fair use exists because of the failure to distinguish the use of the copyright and the work. That confusion would dissipate if courts recognized that fair use relates to the use of the copyright, not the work, the use of which is a matter of personal use. See L. Patterson & S. Lindberg, The Nature of Copyright 193-200 (1991).

[27] Sony Corp. v. Universal City Studios, 464 U.S. 417 (1984) allowing in-home videotaping of copyrighted motion pictures off-the-air for later viewing is an example of personal use.

[28] Stover v. Lathrop, 33 F. 348, 349 (C.C.D. Colo. 1888) (purchaser of copyrighted book may use it for reference, study, reading, lending, "copying passages from it at will," but cannot duplicate and put it upon the market for sale; opinion by Brewer, J. of the Eighth Circuit, appointed to U.S. Supreme Court in 1889).

C. The Right to License Copying the Copy Provides Copyright Protection for Unoriginal Material and Eliminates the Right of Fair Use.

The ultimate harm of the right to license the copying of copies results from two facts: 1) A copyright owner may have an infringement action against one who copies a work; and 2) a defendant may have the fair use defense for the same conduct. Whether the copying is infringement or fair use is to be decided on a work-by-work basis.

If publishers are empowered to license the copying of any excerpts from copies of books they have sold, it is obvious that they will use the license to avoid the necessity of bringing infringement actions (and of complying with either conditions, constitutional or statutory, for copyright) and professors will have to forfeit the right of fair use. But "just as videotaping television shows for private home use does not implicate the copyright holder's exclusive right to reproduction," New Kids on the Block, 971 F.2d at 307, neither does making multiple copies of excerpts for classroom use (17 U.S.C. § 107 (1977)).

This court should follow the lead of those courts who denied the creation of a double copyright monopoly by creating the first sale doctrine; it should not repeat the error of those courts that misinterpreted the copyright statute and unlawfully expanded the copyright to protect unoriginal material and narrowed the fair use doctrine. To give publishers the right to impose copying licenses for copying excerpts from copies they have sold will have this effect.

The question is not whether the copyright holder is entitled to all profits possible. As with the first sale doctrine, the ultimate question " 'is whether or not there has been such a disposition of the copyrighted article that it may fairly be said that the copyright proprietor has received his reward for its use.' " Sebastian International, Inc. v. Consumer Contacts, 847 F.2d at 1096-97. In short, copyright is not to be used to create profits for copyright holders, but to protect the profit that the marketplace provides.

V. THE DISTRICT COURT'S ORDER TURNS THE COPYRIGHT STATUTE INTO A LICENSING ACT FOR PUBLISHERS, A TASK FOR CONGRESS, NOT THE COURTS.

This case demonstrates two immutable propositions about publishers: 1) they continually seek to enlarge the copyright monopoly to obtain extra benefits;[29] and 2) if they cannot get what they want from the legislature, they turn to the courts.[30] In deciding this case, then, this court should not repeat the district court's error in failing to understand the effect of affirming that decision: To turn the copyright statute into a licensing act for publishers.

Congress did not give publishers the right to license the use of books for classroom use. Therefore, they seek to persuade courts that the Copyright Act should be construed so as to give them that power. Such a construction, however, is contrary not only to the language of § 107, but also to basic copyright principles. This is demonstrated by events that apparently comprise the three components of the publishers' plan to induce courts by judicial construction to treat the Copyright Act as a licensing statute: 1) the creation of a licensing system of dubious constitutionality; 2) legal actions to get illegal permanent injunctions; and 3) a campaign of disinformation directed to users.

A. A Private Licensing System Created Under Authority of the Copyright Act for the Use of Books is of Dubious Constitutionality.

The publishers have by contract created a private licensing system, the Copyright Clearance Center.[31] The twofold rationale

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[29] Sony, 464 U.S. at 432 n.13. For a concrete example, see the copyright notice on WESTLAW. Federal cases are works of the U.S. Government not subject to copyright protection. 17 U.S.C. § 105 (1977). Although West Publishing says it does not claim any copyright on U.S. Government works (as it must to make its notice effective, 17 U.S.C. § 403 (1977)), the notice goes on to say: "No part of a WESTLAW transmission may be copied . . . except as permitted . . ." West thus disclaims copyright as it claims it.

[30] See L. Patterson, Copyright in Historical Perspective 154-179 (1968).

[31] See American Geophysical Union v. Texaco, Inc. 802 F. Supp. 1, 7 n.4 (S.D.N.Y. 1992), discussed at n.17, supra.

for doing so was that: (1) courts would not recognize their right to license without a mechanism for licensing; and (2) the licensing system would create income and a new market and would permit publishers to claim that any user's failure to purchase a license for copying his or her own personal copy of a book was economically harmful. The court's language shows that the stratagem worked: "Plaintiffs have filed affidavits which show that permission fees are a significant source of revenues," and concluded, "The court finds that if defendants' practice of refusing to seek permission before copying and selling excerpts from copyrighted works became widespread, there would be a significant loss of revenues to plaintiffs." Order, p. 11.

This is circular reasoning. Apart from the erroneous assumption—that all copying is infringement—the existence of a market for a work does not prove that copying the work was infringement. Lewis Galoob Toys, Inc. v. Nintendo of America, Inc., 964 F.2d at 968 ("the existence of a market does not, and cannot, determine conclusively whether a work is an infringing derivative work").

To say the least, such a licensing system is of dubious constitutionality: It curtails the professor's right of decision as to what materials he or she may use in the classroom. However slight the control, this is censorship and it should be noted that the key to censorship is not control of what the author writes, but control of what the press publishes, as English history shows.[32] There are then, two questions: First, has Congress enacted a copyright statute to allow publishers to establish a licensing system to control the use of books after they are sold? Second, if not, can courts construe the copyright statute—as the district court did—to allow publishers to establish a licensing system to control the use of

[32] For a detailed history of the English experience with copyright as an instrument of censorship in the sixteenth and seventeenth centuries, see L. R. Patterson, Copyright in Historical Perspective (1968). The events of this history are the common source of the Copyright Clause and the First Amendment. The main instrument of press control was the Licensing Act of 1662, 13 & 14 Car. II, c. 33, the formal title of which is instructive: "An act for preventing Abuses in Printing Seditious, Treasonable and Unlicensed Books and Pamphlets, and for Regulating of Printing and Printing Presses." The offense was not in the writing, but the printing.

published books?[33] These are questions this court will answer one way or another in this case. And it should be noted that any argument that the licensing system is okay because it is private is wrong. It exists, and can exist, only by virtue of laws that Congress enacts and courts enforce.

B. Copyright Injunctions Can Protect Only Works that Comply with the Copyright Act.

Copyright injunctions that provide copyright protection for works as a class are not legal and no amount of precedent can make them so. The district court granted such an injunction.[34] But such injunctions protect all components—unoriginal as well as original—of all plaintiffs' copyrighted works—future as well as present—independently of the copyright statute. Thus, they "grant monopoly privileges—by judicial construction—to those who fail to comply with statutory safeguards intended to protect the public against abuses of such privileges," Washingtonian Publishing Co. v. Pearson, 306 U.S. 30, 55 (1938) (Black, J., dissenting), and they conflict "with statutory policy extending back to the beginning of the nation's history." Id. Thus it is particularly unfortunate that the district court did not heed this court's position as to the grant of injunctions. " 'There is no power the exercise of which is more delicate, which requires greater caution, deliberation, and sound discretion, or more dangerous in a doubtful case, than the issuing an injunction; . . .' " Detroit Newspaper Publishers Ass'n v. Detroit Typographical Union No. 18, 471 F.2d 872, 876 (6th Cir. 1972) (emphasis added).

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[33] Access is involved because the district court's Order impedes the professors' right to give students access to the excerpts in question. The impediment exists under both the Copyright Clause and the First Amendment, for the essence of both constitutional provisions is the right of access. Judge Birch makes this point abundantly clear in his discussion of the Copyright Clause and the First Amendment in CNN. 940 F.2d 1471 at 1478-79.

[34] The injunction is against "any future reproduction of any of plaintiffs' existing or future copyrighted works," Order, p. 12. This gives the impression of requiring compliance with the copyright statute. But under the 1976 Act, copyright comes into existence when an original work of authorship is fixed in a tangible medium of expression. 17 U.S.C. § 102(a) (1977). Therefore, the plaintiffs can ignore the copyright statute entirely, even the requirement of registration. 17 U.S.C. § 411(a) (1977).

As the Supreme Court noted in Acuff-Rose, the goals of copyright law "are not always best served by automatically granting injunctive relief." Acuff-Rose, 114 S. Ct. at 1171 n.10. Indeed, the Eleventh Circuit held injunctions such as the one the district court granted to be unlawful. CNN, 940 F.2d 1471, 1480-81. Judge Birch's scholarly explanation of why this is so should dispose of the issue, for as he said: "This notion [copyright injunctions to protect future works] is manifestly contrary to the basic concepts of copyright law and represents serious legal mischief." Id. at 1480 (emphasis added).

This mischief occurs because a court's power to grant copyright injunctions is limited to works that comply with the copyright statute and is to be exercised only pursuant to the copyright statute. See Stevens v. Gladding, 21 U.S. (17 How.) 447 (1854) (authority to grant copyright injunctions is only by statute).[35]

To appreciate the depth of the mischief such injunctions inflict, however, one must understand that a permanent injunction to protect all books published by three publishers, as in this case, will be precedent for injunctions that provide perpetual copyright protection for all books published by all publishers. The result will eventually be the destruction of the public domain with a judicially created common law copyright, one that extends perpetual copyright protection. With such injunctions in hand, copyright owners need not comply with any requirements for copyright, either constitutional or statutory.

The injunction in this case thus gives the plaintiff-publishers by judicial construction what the Constitution prevents Congress from giving them by statutory enactment, a special private benefit. Sony Corp. v. Universal City Studios, Inc. 464 U.S. 417, 429 (1984) ("The

[35] To see the legal infirmity of copyright injunctions to protect all books—future as well as present—published by a single publisher as in this case, this court need only look at the statutory and constitutional provisions that the permanent injunction negates and overrides. With an injunction protecting future works (and present works not in the record), the publishers can protect unoriginal works (overriding 17 U.S.C. § 102 (1977)); can protect ideas (overriding 17 U.S.C. § 102(b) (1977); can protect U.S. Government works (overriding 17 U.S.C. § 105 (1977)); can deny the right of fair use (overriding 17 U.S.C. § 107 (1977)); and can avoid registration of its copyrights as a prerequisite to obtaining relief for alleged infringements. 17 U.S.C. § 411(a) (1977).

monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit.").[36]

C. Publishers Have Engaged in a Campaign of Disinformation Directed to Users.

The third component of the publishers' plan is a campaign of disinformation about copyright.[37] That publishers engage in such a campaign is not surprising. To some, indeed, this is only puffery, a part of the free market system. The extent of the disinformation, however, has reached the point that one with a fanciful imagination can create a nightmare scenario the court's Order portends.

Publishers will create a copyright compliance office; will assert the right to collect license fees for the copying of any published work, including those that consist primarily of public domain material (for example, British dramas of the eighteenth and nineteenth centuries); will misstate the law, claiming for example, that a district court decision (which is normally deemed not to have precedential value) such as the one in this case means that no copying for classroom use is permitted without payment of a licensing fee; will demand that delinquent copyshops pay for their sins with a private fine in an extortionate amount for the privilege of avoiding a lawsuit.

Unfortunately, the nightmare is not fanciful. Proof exists in the form of a letter—citing the preliminary injunction granted in this case—sent by the Association of American Publishers' Copyright Compliance Office to an offending copyshop, requiring inter alia, the copyshop owner to pay $2500.00 to avoid a lawsuit. That the

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[36] The traditional argument that copyright owners make in support of such injunctions is that they are necessary to avoid a multiplicity of suits. In view of the potent arsenal of remedies that the copyright statute provides in addition to injunctions—impoundment, statutory damages, attorneys' fees, and criminal sanctions this self-serving argument can most accurately be characterized as nonsense. 17 U.S.C. §§ 503-506 (1977).

[37] Publishers are very adept at disinforming the public, especially with overreaching copyright notices. See supra note 29; Heald, Payment Demands for Spurious Copyrights: Four Causes of Action, 1 J. Intell. Prop. Law 259 (1994) (showing at p. 288 claim of copyright protection for Declaration of Independence) (originally included as Appendix II this brief).

copyshop copied (for use in the classroom) excerpts from a book of eighteenth and nineteenth century British dramas was apparently deemed of no consequence, even though the works have long been in the public domain and cannot lawfully be protected by copyright. The letter also demanded that the copyshop owner forfeit its constitutional right to copy unprotected material by signing an oath not to sin again. See 1 J. Intell. Prop. Law 44-48 (1993).

The thinking of the publishers in this case is that the right to reproduce a work in copies should be absolute so that they may create by private contract licenses for copying excerpts from books for classroom use.

> The defect in this thinking springs from the substituting of inference and argument for the language of the statute and from failure to distinguish between the rights which are given to the [copyright owner by the statute] and which he [or she] may assert against all the world through an infringement proceeding and rights which he [or she] may create for himself [or herself] by private contract . . .

Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U.S. 502, 514 (1917).

Plaintiff-publishers have indeed confused their statutory rights and private contract rights and have sought by private law to extend their monopoly rights far beyond the parameters of public interest by using copyshops to deny professors the fair use right for teaching purposes. The district court gave the publishers its judicial imprimatur and thereby made the copyright statute a licensing act. But if the copyright statute is to be turned into a licensing act for publishers, the task is one for Congress, not the courts.

To paraphrase a recent decision of the Second Circuit:

> While proprietary based arguments in favor of broad copyright protection are perhaps attractive from a pure policy perspective, ultimately they have a corrosive effect on certain fundamental tenets of copyright law. If rejection of the property arguments results in narrowing the scope of

> **protection, that result flows from applying, in accordance with Congressional intent, long-standing principles of copyright law. This court's decision should be informed by the concern that these fundamental principles remain undistorted.**

Computer Assocs. Int'l, Inc. v. Altai, Inc., 982 F.2d 693, 712 (2d Cir. 1992).

CONCLUSION

For all of the foregoing reasons, this Court should reverse the district court's judgment and rule that a professor entitled to fair use for teaching purposes by making multiple copies for classroom use does not lose the right merely because he or she asks a copyshop to make the copies, so long as the copyshop charges only for its services and not for use of the excerpts.

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