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## COPYRIGHT: INFRINGEMENT, LITIGATION, AND FAIR USE

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**T**he purposes of copyright—to promote the advancement of culture by providing an economic incentive to create art and literature—require that copyright owners be able to enforce their exclusive rights. With some important exceptions, anyone who exploits an owner’s rights without permission commits copyright infringement, and the Copyright Act directs the courts to punish it harshly. The penalties can include a court order restraining further uses of the work, impoundment and/or destruction of unauthorized works, and money damages calculated in various ways, even when the infringer did not intend to infringe. Including infringed material in a book or article may also constitute a material breach of the infringer’s publishing contract and may make her liable for her publishers’ losses and attorneys’ fees as well as for her own.

This chapter describes the procedure followed in an infringement lawsuit, the elements of an infringement claim, and other key legal concepts. It explains how authors can use self-help to stop infringements of their own works on the Internet. It then covers the all-important fair use exception to infringement, how fair use works in practice for writers, and how to obtain permission to use copyrighted works in ways that exceed fair use.

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## LEGAL PROCEDURE IN INFRINGEMENT SUITS

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Similar to every civil litigation, proving infringement and defenses such as fair use requires evidence that the parties gather through pretrial discovery, which can include document exchanges, sworn testimony in deposition questioning conducted by the lawyers, written responses to each others' interrogatories, trial testimony, and the courts' comparisons of the original and alleged infringing works. The plaintiff has the burden of proving the elements of infringement by a preponderance (that is, more than 50 percent) of the evidence; the defendant must prove its defenses, including fair use. If the plaintiff fails to prove its case, the defendant does not need to proffer a defense. The elements of and defenses to infringement present both legal and factual questions. The judge decides legal issues. Fact issues are usually decided by juries, but parties frequently ask judges to step in before the jury's fact finding role and issue a summary judgment before trial, based on the evidence presented, that no genuine issue of material fact exists and a ruling is appropriate as a matter of law. In some cases, a judge might rule at the outset that the plaintiff has failed to state a legally cognizable claim and dismiss the case based solely on deficiencies in the claims raised by the defendant on a motion to dismiss the complaint.

All copyright suits in the United States must be brought in federal district court. The twelve federal appellate courts of the nation, called Courts of Appeals, strongly influence the practice of copyright law because they devise the tests and standards interpreting the statute. The district courts must follow the precedents of the Court of Appeals covering their geographic jurisdictions (called Circuits), and of course all courts must follow the rulings of the ultimate appeals court, the Supreme Court. The appellate courts of the Second and Ninth Circuits, covering New York and the West Coast respectively, deal frequently with copyright cases, and therefore their rulings are influential throughout the country.

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## THE ELEMENTS OF INFRINGEMENT

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In order for a court to find an infringement, it must determine that: (1) the plaintiff owns the copyright or at least one of the exclusive rights in the work; and (2) the alleged infringer actually copied the protected work or exercised an exclusive right held by the plaintiff. To show that the allegedly

infringing work was copied, the plaintiff must show that it is “substantially similar” to the original work. Proving the defendant copied some or even most of a work is only part of the battle. The plaintiff still must prove that the alleged infringing work copied enough of the expressive elements of the original work to warrant liability. In other words, the appearance of similar plot elements, stock characters, descriptions of facts, and *scènes à faire*<sup>18</sup> in two works is not, in itself, proof of infringement. Remember, copyright does not protect ideas, facts, discoveries, concepts, processes and procedures, and works in the public domain; it protects only the original expression in which these are embodied. Many writers have sued for infringement only to learn the hard way that the copied elements of their works were unprotected ideas or facts, not protected expression.

#### OWNERSHIP

The plaintiff must show it owns the copyright or at least one of the exclusive rights of copyright. A licensee of a specific exclusive right under copyright, such as a publisher, has the right to sue for infringement of that particular right, but it may not sue for an unauthorized use that it has not licensed. If the owner registered the copyright within five years of first publication, the certificate of registration serves as presumptive proof of the validity of the owner’s copyright and of the facts stated on the certificate. The defendant may rebut that presumption with evidence to the contrary, but the burden of doing so rests on the defendant.

#### COPYING

Copyright protects against the actual copying of a protected work, but not against the independent creation of a similar or even an identical work. Therefore, infringement cannot have happened unless the defendant actually copied the protected work, whether deliberately or unconsciously. Given the difficulty plaintiffs often face in producing direct proof of actual copying, some courts will accept evidence that the defendant had access to the work and that the alleged infringing work bears enough similarity to the original (known in legal parlance as “probative similarity”) that a jury may conclude actual copying must have occurred.

<sup>18</sup> A leading court has defined *scènes à faire* as “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.”

### ACCESS TO THE ORIGINAL WORK

In some cases, access is not so difficult to prove. If the original work was nationally distributed, broadcast repeatedly, or freely available online, a court might readily accept that a person with a television or Internet connection at the time in question had access to the work. Without direct proof of access, courts can consider circumstantial evidence, such as correspondence to or from a publisher or producer (e.g., submission or rejection letters) to conclude that a defendant had access to the work. In some circuits, courts may infer that a defendant must have copied the original based solely on such a “striking similarity” between the works as to preclude the possibility of independent creation. When a mistake or a deliberately placed non sequitur appears in both the original and the second work, a court is more likely to draw that inference.

### SUBSTANTIAL SIMILARITY

Direct proof or striking similarity shows that actual copying took place. But, substantial similarity, needed to show infringement, requires a deeper analysis. It means the appropriation was wrongful, that is, that a substantial amount of original, copyrighted expression was copied. Copyright would be toothless as an incentive to create if it protected only against complete verbatim copying. On the other hand, no copyright owner has a monopoly on the ideas or facts expressed in her work. The amount of copying, both qualitative and quantitative, required to rise to the level of infringement depends in part on the amount of creativity or originality in the protected work. The more creative the original work, the less copying is necessary to make the second work substantially similar. The less creative the original, the more copying is necessary to prove substantial similarity.

In the classic description of the substantial similarity test written in 1930, Judge Learned Hand explained that every work can be abstracted on several levels, from the most general statement of what the work is about to complete verbatim reproduction. Between these abstractions lies the boundary between uncopyrightable ideas and their copyrightable expression and in turn, between an original new work and a substantially similar infringing work:

Upon any work . . . a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may

perhaps be no more than the most general statement of what the [work] is about, and at times might consist of only its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the [author] could prevent the use of his "ideas," to which, apart from their expression, his property is never extended.

Although no bright line test separates unprotected ideas and protected expression, it is clear that altering some text or visual or aural parts of a work—10, 25, even 75 percent—will not avoid infringement if the jury or judge decides that more than a *de minimus* amount of the protected elements of the work has been copied. Different courts use several different tests, and sometimes employ expert testimony, to determine substantial similarity. Depending on the nature of the work and of the alleged infringement, courts often use an "ordinary observer" test, that is, whether an average lay observer, comparing the two works, would recognize the alleged copy as having been taken from the original. If the nature of the works is more complex, courts might allow expert testimony on the theory that a specialized group, not the general public, was the intended audience. For narrative works, courts look for similarities in the text, format, plot, structure, sequence, and other protected elements, such as well-developed characters. For works including literary, visual, audio or multimedia, the test might be whether the "total concept and feel" of a work has been copied. The total concept and feel test can be further divided into "extrinsic" and "intrinsic" tests: the "extrinsic" test analytically dissects the expressive elements of each of the two works and often requires expert testimony. The intrinsic test depends again on the reaction of the "ordinary observer."

The choice of test employed by a court, and the makeup of a jury comparing two works, can easily determine the outcome, and any of the tests can err in the result, either by finding infringement because a significant amount of unprotected ideas or facts were copied, or by allowing superficial changes in a second work to mask the misappropriation of expressive elements of the first. Two examples illustrate how courts approach this fundamental issue.

In 2001, author Alice Randall and her publisher were about to release *The Wind Done Gone* ("TWDG"), the story of *Gone With the Wind* ("GWTW") narrated from the point of view of a slave. *TWDG* is a harsh critique of Margaret Mitchell's depiction of slavery and the antebellum

South. Mitchell's estate sued for an order prohibiting the publication of *TWDG*. Although the defendants ultimately proved their work was fair use, their argument that the works were not "substantially similar" failed. The appellate court found that Randall's depiction of fifteen of *GWTW*'s main characters and their relationships, the plot, and several famous scenes, though acidly reimagined, renamed, and retold from the narrator's view, contained enough of Mitchell's protected expression to make the books substantially similar. "While we agree . . . that the characters, setting and plot taken from *GWTW* are vested with a new significance when viewed through the character of [*TWDG*'s narrator], it does not change the fact that they are the very same copyrighted characters, setting and plot."

In another example, the Second Circuit held that *The Seinfeld Aptitude Test*, a novelty book containing more than 600 trivia questions about the characters, scenes, and plots from eighty-four episodes of the long-running TV show *Seinfeld*, substantially copied protected elements of the fictional show. The court chose to view the TV series as a whole, rather than comparing the small quantity of copied elements from each of eighty-four episodes separately. Every reference to any episode of *Seinfeld* was found to have copied from the series. Through this lens, the book was held to be substantially similar to the expressive elements in the series.

## DAMAGES FOR INFRINGEMENT

The Copyright Act dictates the required penalties and monetary awards for infringement, and they can be quite significant.<sup>19</sup> A successful plaintiff can recover her own actual market loss caused by the infringement, *plus* any additional profits earned by the infringing work. If the owner registered the work within three months of publication (or for unpublished works, at any time before the infringement), then in lieu of having to prove actual damages she may opt for "statutory damages," which the court has discretion to decide within the range of \$750 to \$30,000 for each infringed work.<sup>20</sup> Courts may decrease statutory damages to as little

<sup>19</sup> Critics of the scope and duration of copyright point to the heavy liabilities required by the Copyright Act to illustrate the chilling effect of copyright on users who might otherwise legitimately employ fair use or other exceptions.

<sup>20</sup> A defendant has the right to ask a jury, not a judge, to determine statutory damages.

as \$200 per infringed work if the original work did not have a copyright notice and the infringer shows it did not intend to or know it was infringing, and may increase them to as much as \$150,000 for each infringed work if the infringement is found to have been willful. “Willful” is not defined in the statute, but courts have defined it as knowing or reckless. Juries have found that attempting to hide or deny an infringement can amount to willfulness. For example, a jury leveled a verdict of almost \$2 million—\$80,000 per infringed work—against a woman it found to have willfully infringed twenty-four sound recordings through file-sharing software. The jury decided that she had lied and tried to cover her tracks online when first approached by the plaintiffs.<sup>21</sup>

In addition to money damages, the Act allows for court orders prohibiting additional infringement, impoundment and disposal or destruction of infringing works, court costs, and, for timely registered works, attorneys’ fees.<sup>22</sup> Attorneys’ fees can amount to hundreds of thousands of dollars or more for cases that go to trial, so registering copyright within three months of publication not only makes it easier for plaintiffs to sue, but also creates a strong deterrent against infringement. The Supreme Court has read the Act also to allow attorneys’ fees awards to defendants who prevail in infringement suits.

## STATUTE OF LIMITATIONS

The statute of limitations for a copyright infringement claim is three years from the time the claim “accrued.” That means that, in most cases, a claim that arose more than three years ago is time-barred and cannot be asserted against the infringer, though a court might “toll” (i.e., extend) the statute if a defendant fraudulently concealed the infringement. Fixing the accrual date of a claim is not only significant for determining whether a claim can be made at all but can make a world of difference in damage calculations when an infringement continued, but was not discovered, for more than three years. Most courts have adopted the “discovery rule,” meaning that

<sup>21</sup> The judge in the case reduced the award significantly, calling it “monstrous and shocking.” The verdict was handed down during a second trial of the case. After a third trial, the Court of Appeals reinstated a \$222,000 verdict from an earlier trial. *Capitol v. Thomas-Rasset*, 692 F.3d 899 (8th Cir. 2012). The United States Supreme Court declined to reconsider that decision; certiorari was denied on February 11, 2013.

<sup>22</sup> Moreover, the Act provides criminal penalties for cases of willful infringement prosecuted by the government.

the clock does not start until the plaintiff discovered, or with reasonable diligence should have discovered, the infringement, even when it began more than three years before suit. Other courts allow claims to be made and damages awarded only for acts that occurred within the three-year window immediately prior to the date of filing.

The best practice for copyright owners is to exercise diligence to detect unauthorized uses; at the very least, set up a Google Alert or other search engine equivalents for your name and for key words or phrases from your work, so you can discover when they appear online.

#### WHO IS LIABLE FOR INFRINGEMENT? SECONDARY LIABILITY?

Lawyers call copyright infringement a “strict liability” tort, meaning that infringers are liable whether or not they intentionally copied or knew they were infringing.<sup>23</sup> Strict liability means the publisher of an infringing work is liable even when its author guaranteed its authenticity. By the same token, any party who knowingly assists or induces another party to infringe copyright can be held equally liable as a contributor to the infringement. Even a party who does not knowingly help another infringe copyright, but who is in a position to stop the infringement and receives a financial benefit from it, can be held “vicariously liable.” For example, a swap meet operator was held to be contributorily liable for the sale of pirated works at the swap meet. The operators of file-sharing systems that enabled the exchange of copyrighted music, both on a peer-to-peer and a centralized basis, were held fully responsible for their users’ infringement.<sup>24</sup> But courts do not extend secondary liability to every actor in the chain of infringement. For example, the Ninth Circuit recently affirmed the dismissal of claims by a purveyor of copyrighted photos against the banks that processed payments for websites selling infringing access to the photos.

Liability for infringement damages among co-infringers can be assessed jointly and severally, meaning that each defendant is potentially liable for

<sup>23</sup> Intent does affect the calculation of money damages, however.

<sup>24</sup> The Digital Millennium Copyright Act (DMCA) of 1998 exempts Internet service providers and websites from contributory and vicarious liability if they provide a means for copyright owners to notify them of users’ infringements through their services and expeditiously remove alleged infringing works. See below for more on the DMCA.



up to the full award. The judgment creditor may choose to collect up to the entire damage award from either the direct infringer or the secondarily liable party, regardless of that party's relative responsibility.<sup>25</sup> For example, a publisher and a printer might each be jointly and severally liable for all damages if the publisher wrongfully authorizes the reprint of a book in which it no longer has rights.

The limited liability normally gained by forming a corporation is not necessarily a shield against individual liability in a copyright infringement lawsuit. When a corporate officer participates in the infringement, uses the corporation to carry out an infringement, or is the dominant influence over the corporation, courts are likely to "pierce the corporate veil" and impose personal liability. Likewise, an employee who commits or causes its employer to commit infringement might be held personally liable, and the employer can still be responsible as a contributory or vicarious infringer.

#### STATES AND STATE ENTITIES IMMUNE

A series of decisions by the US Supreme Court in the late 1990s significantly increased states' rights by making them immune from lawsuits by private parties to enforce federal rights, including copyright. In 1999, a divided Court ruled that unless states explicitly agree to be sued by private citizens to enforce federal claims—including intellectual property rights—the states' Eleventh Amendment sovereign immunity shields them from such lawsuits. Following the holding, the Fifth Circuit Court of Appeals dismissed an infringement lawsuit against the University of Houston press brought by author Denise Chavez, because the university, as an instrumentality of the state, was immune from liability under Supreme Court precedent. These rulings mean that states, state-owned entities (such as state university presses and educational institutions), and their employees cannot be sued for damages if they infringe copyright. Injured plaintiffs may ask only for injunctive relief against states. Subsequent attempts by Congress to remedy these holdings have been rejected by the Supreme Court as unconstitutional.

<sup>25</sup> Contributory or vicarious infringers are generally not responsible for the other defendants' profits, however.

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SELF-HELP FOR ONLINE INFRINGEMENT

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Have you discovered your work copied in full on an ad-heavy website, read or performed on YouTube, or emailed to untold numbers, without your knowledge, permission, attribution, or compensation? Many writers are happy to have their work widely distributed, but it is reasonable to want to do so on your own terms. It is easy enough to find your work on the web, but ascertaining whether its appearance represents an infringement, and if so, stopping it, requires some work.

After years of lobbying by online service providers concerned that their customers' unfettered infringements could expose them to massive vicarious and contributory liability, Congress amended the Copyright Act in 1998 by passing the Digital Millennium Copyright Act. The DMCA provides safe harbor to online service providers (including Internet service providers, website hosts, social media sites, search engines, and portals) when they passively and unknowingly facilitate their users' infringement. Copyright owners may not sue service providers for money damages or an injunction as long as the service provides a straightforward method to address and stop infringement through their services. They must also publish and enforce a policy of removing repeat infringers from their services.

If your work appears on a website or a social networking site links to your work on an authorized site, neither case is necessarily an infringement. Your publisher might have the right to grant sublicenses to post your work online and might have done so. Refer to your contract or ask your publisher. If the work is an excerpt from a book that is still in print and the contract was signed later than the mid-1990s, your publisher probably has some electronic rights and may have sublicensed them. A contract for a freelance article published after 1995 also probably grants digital rights to the publisher. But if your contract does not explicitly set forth a grant of digital rights or there is no written contract, then you probably own them.

If you find your work posted online and you granted the right to publish online to your publisher, notify the publisher and inquire whether permission was granted. If the publisher has the rights but did not grant permission, ask them to have the work removed by taking the steps described below. If the publisher has properly granted permission, your contract might entitle you to a share of any license fees. If you kept the electronic or digital rights, you have the right to notify the online service provider or

website that you own the work and to demand that it remove your work from the site. Under the DMCA, the service provider must “expeditiously” remove the work on receipt of your notice and take down demand.

Tracking down the service provider can sometime be fairly easy; other times they are underground, hidden behind many layers of false and anonymous registrations. If the infringement appears on a website, including a social media site, review the site’s terms and conditions or copyright policy to find the contact for copyright notices. If the site does not post this information, go to [www.internic.net/whois.html](http://www.internic.net/whois.html), the site of the organization that registers virtually every site on the Internet. Enter the infringing site’s URL to find its contact information and, more important, the name of the host service provider that has the ability and the obligation to take down the infringing work.

To qualify for immunity, a service provider also must drop repeat infringers from its service, publish its policy of terminating repeat infringers, and accommodate “standard technical measures” used to protect copyrighted works. You can easily check on whether it has published its anti-infringement policy. Service providers also must assign a designated agent to receive notice of infringement claims on their behalf. The identity and address of the agent should appear on the service provider’s site and/or with the Copyright Office.

Once you have the correct agent’s address or other method of contact specified by the service provider, you or your representative must send written notification of the infringement and demand that it be removed. Frequently, you may do this by email, but be sure to keep copies of your correspondence. Many providers post their copyright policy prominently via their home pages specifying the information they need from you. At a minimum, your notice should identify the copyrighted work being infringed, identify the material that contains the infringement, provide sufficient information to allow the service provider to locate the material (for example, the specific URL of the page where the infringement occurs), and provide your contact information. You also must certify that you are the copyright owner, or authorized to act on the owner’s behalf, and believe that the appearance of your work on the site is unauthorized and is not a fair use.

When its agent receives this notice, the service provider must “expeditiously” remove the infringed work or interrupt access to it. If you want to go further and sue the infringer, the law makes it fairly easy to subpoena the

provider for the infringer's identity. After the service provider has removed or disabled the offending material, it must promptly inform the alleged infringer of the change. If the alleged infringer claims in writing that a mistake has been made, the service provider, after informing you, must replace or permit access to the material within ten days, unless you bring a lawsuit to prevent restoration of the material. A true infringer is unlikely to respond in this way because the counter-notice must include its full contact information and agreement to submit to the jurisdiction of a court if sued.

If an online service provider has met all these legal requirements, you cannot recover damages from it regardless of how much damage the infringement caused. You may only sue for contributory liability if you can show that a service provider actually knew a subscriber was infringing your copyright, or that it supervised the content and received a specific benefit from its subscriber's infringement. (One exception to this exception: nonprofit institutions of higher education as long as they stop the piracy after learning of it.)

If a site actively encourages subscribers to upload others' published work, you should document that fact. Note any way in which the service provider might financially benefit from copying your work—charging a per-download fee, or using it to help sell merchandise or advertising. If it has done so, or has failed to comply with any of the DMCA safe harbor requirements described here, it could lose its immunity, leaving you able to seek recourse directly against this potentially deep pocket.

## FAIR USE, THE PUBLIC DOMAIN, AND SECURING PERMISSION

Virtually every cultural creation borrows from and is built on works that came before it. If copyright's grant of a long-term monopoly over the use of original works were absolute, it would cripple, not promote, the development of culture, and it would violate the right of free expression. In fact, the copyright owner's rights are not absolute. Sections 107 through 120 of the Copyright Act exempt several specific activities from the prohibition on copying.<sup>26</sup> The most important exception to the owner's exclusive rights is the right of others to make fair use of a work, a centuries-old principle of

<sup>26</sup> Some of the exempted activities are library and archival copying to preserve works in danger of deterioration; use of sound recordings and instructional materials in long-distance teaching; and the "first sale doctrine" described in Chapter 2.

common law that courts devised based on the values underlying the First Amendment.

Congress wrote the fair use doctrine into the 1976 Copyright Act. Section 107 states: “the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship or research, is not an infringement of copyright.” Technically, fair use is an affirmative defense to an infringement claim, meaning that an owner must prove infringement before the defendant must prove its use was fair. Note that the list of permissible fair use purposes in the Act is illustrative, not exclusive. Other purposes for which a user might copy an original work can and frequently are ruled fair uses. In theory at least, fair use is supposed to offer significant breathing space for all kinds of uses of copyrighted works.

Every fair use claim is decided on its particular facts in a four-part test set forth in the Act that is simple to state but challenging to apply and therefore requires some work to predict with confidence. One court complained that fair use is “so flexible as virtually to defy definition.” But one thing is certain: simply quantifying the amount of an original work copied does not end the inquiry. The Supreme Court famously rejected a fair use claim when approximately 300 words were copied from a 200,000 word manuscript. By contrast, fair use has been repeatedly credited as a defense even when works were copied in their entirety, for purposes such as parody, criticism, archival preservation, online search facilitation, and illustration of a historical analysis.

The Copyright Act instructs courts to weigh each of the following four factors to determine whether an unauthorized appropriation of a copyrighted work is fair use and therefore noninfringing:

The purpose and character of the use, including whether the use is of a commercial nature or for nonprofit educational purposes;

The nature and character of the copyrighted work;

The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

The effect of the unauthorized use on the market for or value of the copyrighted work.

Courts may also consider other factors they deem relevant, but they must analyze all four statutory factors in any given case and weigh the results together, in light of the purposes of copyright.

Under common law and through the mid-1990s, courts followed the lead of the Supreme Court and tended to give the most weight to the fourth factor, “the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.” In the same vein, the Supreme Court once opined that any commercial use was “presumptively unfair.” Today, although the analysis in any given case can be complex, the inquiry into the economic effect on existing or realistically potential markets for the original work if the use were to become widespread remains an important factor. But beginning in 1990, with the publication of a seminal law review article by now-Second Circuit Appellate Judge Pierre Leval, the “transformative” nature of the use (i.e., whether it “transforms” the original by building upon it rather than simply taking its place) began to weigh more heavily relative to the effect on the original work’s market. The Supreme Court soon adopted Judge Leval’s argument that allowing the creation of transformative works, even when the use is commercial, advances the goal of copyright. In 1994, the Court defined “transformative” fair use to mean “add[ing] something new, with a further purpose or different character, altering the first with new expression, meaning or message” as opposed to “merely supersed[ing] the objects of the original creation.” The weight given to any particular factor in the endless variety of factual situations presented is in the courts’ discretion, but they must follow Supreme Court precedent. Thus, although the four factors interrelate in most cases and no one factor automatically trumps the others, recent fair use decisions tend to focus on whether a use was transformative. Even then, in every fair use analysis, courts will necessarily consider whether the user copied more of a work than necessary to realize the claimed objective.

Fair use questions arise for writers in a number of situations: use of historical works as background and reference for one’s own work; quotations of passages from a work to illustrate its style, comment on its content, or compare it to another; parody; enhancement of a novel or essay with song lyrics or other quotations; inclusion of photos, drawings, maps and other images to illustrate text; downloading or copying articles and other materials to keep for easy reference, and others. Significantly, there are no hard and fast rules (i.e., not exceeding a specified word count) that can reliably apply to determine whether a given use is a fair use. Whether or not any particular copying is fair use must be determined through common sense application of the four factors, keeping in mind the nonexclusive list of statutory purposes.

The following descriptions of leading judicial decisions are intended to illustrate the permissible parameters around specific kinds of uses.

### QUOTING OTHER WORKS

For a review or scholarly article analyzing a particular work or body of work, one generally has leeway to reproduce much of the subject work verbatim without infringing it. On the other hand, copying the “heart” of a work, even when it amounts to a small part of the whole, could fail the fair use test if it appropriates the original’s intended audience or market. A landmark case involved the memoirs of Gerald Ford published by Harper & Row. The publisher had licensed the exclusive right to publish a 7500-word excerpt before book publication to *Time* magazine. Prior to *Time*’s intended publication date, the *Nation* magazine got an embargoed copy and published an article paraphrasing a key passage and also containing about three hundred words copied verbatim from the memoirs—about .015 percent of the whole. The effect of this scoop was to preempt the *Time* excerpt, leading *Time* to cancel its deal with Harper & Row. The Supreme Court rejected the *Nation*’s fair use defense. As required under the Act, the Court analyzed the four fair use factors:

1. *Purpose and Character of the Use*: Although its work arguably was for purposes of news reporting, scholarship or research, the *Nation* profited from exploiting the copyright without paying the customary license fee for serial rights.
2. *Nature of the Copyrighted Work*: Courts logically give greater protection to more creative works than to factual compilations or historical nonfiction. But even if not highly creative, if the copied work is unpublished, this factor will weigh against the user.
3. *Amount and Substantiality of Use*: Remarkably, the Court found 300 words from a 200,000 word manuscript to be the “heart of the book,” i.e., Ford’s internal deliberations about pardoning Richard Nixon. The Court also took the unusual step of comparing the 300 copied words in relation to the whole of the defendant’s article of 2200 words.
4. *Effect on Potential Market or Value*: This factor weighed most heavily against the *Nation*. The negative effect on the market

for the work was manifest when *Time* withdrew from its licensing deal.

The moral for authors who want to quote from another work is that one simply cannot rely solely on the relative amount of the material to be copied. To be sure, if you are quoting a work, even extensively, to advance your analysis, illustrate a point, or comment on the quoted work or its ideas, you are more likely to be making fair use, particularly if you attribute the quote to its author. Purposes such as scholarship, criticism, and comment are at the core of what fair use supports, and they require incorporation of original source material for proper treatment of the subject. Quoting copyrighted material in historical works such as biographies is also likely to be fair use. On the other hand, if you use more than you need for such purposes, or cross the line into copying another author's expression to enliven your own writing (rather than to discuss something about the original) or avoid generating your own work, or if your copying is not otherwise serving one of the fair use purposes, you should seriously rethink your course of action. Either create your own expression of the ideas or facts found in the other work, seek permission from the owner, or consult a knowledgeable lawyer for an opinion on whether the copying is unfairly encroaching on the first work's value or audience.

#### USING IMAGES IN YOUR WORK

Where an established market exists for licensing photographs, drawings, maps or other images, incorporating them in a book, article, or website without permission is less likely to be fair use. But more important are the purposes for and the ways in which the images are used. To illustrate, an important 2006 decision by Second Circuit held that a publisher's reproduction of seven highly original concert posters, reduced to thumbnail size and placed on a timeline with other images and text to illustrate the history of The Grateful Dead, was fair use. The court reasoned that the publisher's purpose in using the images was "plainly different" from the posters' original purposes, which were "artistic expression" and concert promotion. The inclusion of the images had the beneficial purposes of enhancing the reader's understanding of the text and of serving as historical artifacts, both of which fulfilled a transformative purpose. Therefore, even though the copyright owner had a business in licensing images of the posters, the



publisher's use did not impact the owner's potential to develop "traditional, reasonable or likely to be developed markets." The fact that the images were so reduced in size that the publisher did not usurp an existing market for reproduced posters was a key factor in the analysis.

A later case deemed the use of twenty-four magazine covers in a biography of the artist who created the cover art to be fair use. The images were used for a completely different purpose than the original purpose and only the covers, not the entirety of the magazines, had been copied. In the same vein, commenting on or reporting about images requires the reproduction of those images, and this practice is generally considered fair use. Note that the images themselves should be the topic on which the report comments, not the subject of the images. In other words, if the fact that the image exists is somehow newsworthy, using it is more likely to be fair than if the image simply illustrates the subject of the report. The latter use would generally require permission.

To illustrate this fine distinction, a few years before *The Grateful Dead* book case, the Ninth Circuit affirmed a ruling that the producers of a 16-hour film biography of Elvis Presley had used too much unauthorized copyrighted material for fair use. The film repeated numerous video and audio clips of Elvis's performances and appearances. The court held the purpose of the defendants' use was not only to illustrate historical references, which would have been fair use, but instead to "serve the same intrinsic entertainment value that is protected by plaintiffs' copyright." In particular, by showing 30–60 second clips of performances with minimal voiceover commentary, the filmmakers were found to have used more than they needed to make permissible transformative use.

### PARODY

Whether a parody, which copies parts of a work in order to make fun of it, is fair use depends on whether it derives its value from what it copied of the original or from the new material added that makes it a parody. If the value comes mostly from the original work, applying the four factors is likely to result in infringement liability. The claimed parody must actually comment to a significant degree on the original, not use the original to comment on a different topic.<sup>27</sup> Below are the leading cases that illustrate this point.

<sup>27</sup> A leading copyright litigator offers this practical advice: a parody has a better chance in court if it makes the judge laugh.

In 1994, in *Campbell v. Acuff-Rose Music, Inc.*, the Supreme Court examined the rap group 2 Live Crew's takeoff on Roy Orbison's "Oh, Pretty Woman." 2 Live Crew called its song "Big Hairy Woman" and based it substantially on Orbison's work. In contrast to the original, "Big Hairy Woman" was blatantly comic and misogynistic. The album containing the song sold 250,000 copies. Refining its view of the "market effect" factor from the *Nation* case, the Court held that a parody of a copyrighted work can constitute fair use, even if purely commercial. In doing so, the Court redefined and increased the impact of the first fair use factor (the purpose and character of the defendant's use) to include the transformative nature of the use. The decision formally adopted Judge Leval's academic analysis and decreed that "the more transformative the new work, the less will be the significance of the other factors, like commercialism, that weigh against fair use." The Court defined parody as "the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's work." Crucially, the Court distinguished a permissible parody from a work that has "no critical bearing on the substance or style of the original composition, [but is merely used] to get attention or avoid the drudgery in working up something fresh." It explained that in a true parody, the copyrighted work is the *object* of the parody, and not merely a vehicle with which to poke fun at a different target.

Following *Campbell*, the Second Circuit found fair use in the advertisement for the comedy film *Naked Gun 3*, which largely copied Annie Leibovitz's famous photo portrait of a pregnant and nude Demi Moore and superimposed actor Leslie Nielsen's head on a pregnant model's body. The court observed with approval that at least one major purpose of the ad was to comment on the arguable "pretentiousness" of the original photo. By contrast, the Ninth Circuit held that a novelty book commenting on the 1995 O. J. Simpson murder trial using the style, characters, and rhyme scheme of Theodore Geisel's *The Cat in the Hat* was not a comment on the first work, but rather on a current event—a notorious murder trial. Therefore, it was not a parody of the first book and not fair use.

Later cases repeat the importance of this distinction in the analysis of a claimed transformative use. In *The Wind Done Gone* case, the appeals court found the retelling of *Gone With The Wind* by a slave character to be a pure transformative use, a parody that fulfilled a primary purpose of fair use: criticism and commentary on the original. In contrast, the *Seinfeld Aptitude*

*Test* book did not comment on or critique the original series, but instead tried to free ride on its success by creating a derivative work that would appeal to the show's fans.<sup>28</sup>

### ARCHIVAL COPYING

Archival copying might be fair use if the copying is neither systematic nor institutional.<sup>29</sup> The Supreme Court established long ago that the individual recording of copyrighted broadcasts for the purpose of “time shifting,” i.e., private viewing after broadcast, is fair use. More recently, the Second Circuit found no infringement by a Cablevision service that copies every program it provides on its own remote servers and allows its customers to access them any time for private viewing.

In a 1995 case, eighty-three publishers of scientific and technical journals sued Texaco for unauthorized archival copying of their journals by the company's large research staff. The court focused its fair use analysis on one typical employee who had photocopied eight articles for easy reference. The Second Circuit affirmed a district court decision rejecting fair use but limited the application of the lower court's analysis.

1. *Purpose and Character of the Use*: The employee had copied the work for the same reason for which Texaco would otherwise typically purchase a copy or license the work through a commercial database—to have it conveniently available for reference.
2. *Nature of the Copyrighted Work*: The law gives less protection to factual works, even highly advanced scientific research results that are expensive to publish, because of the great public interest in their dissemination.
3. *Amount and Substantiality of the Portion Used*: The defendant copied the articles in their entirety, so this factor weighed against fair use.
4. *Effect on the Potential Market or Value of the Copyrighted Work*: The publishers demonstrated harm to the value of their journals

<sup>28</sup> The facts of *The Wind Done Gone* and *Seinfeld Aptitude Test* cases are described above.

<sup>29</sup> In the UK and Canada, “fair use” *per se* does not exist but their copyright laws allow “fair dealing,” a list of permitted uses of protected works that includes making copies for personal use.

from the loss of subscription and photocopy licensing revenue in long-established markets.

Balancing the factors, and noting that Texaco could readily have used available blanket licensing schemes, the Second Circuit rejected the fair use defense. In an amendment to its opinion, the court clarified that it limited the holding to the specific facts of the case, emphasizing that the systematic, institutional nature of the copying factored largely in its holding. Many observers take the amended opinion and additional factors as signals from the court that occasional archival copying by individuals, or for noncommercial purposes, is likely to be fair use.

As of this writing, a court in New York is considering an important fair use question in the Google Books suit led by the Authors Guild, which is described in chapter 14. The fair use question presented: does scanning entire copyrighted books and storing the texts in a digital database constitute fair use if only “snippets” (i.e., a few words) of the books are presented, along with ads, to Google users in response to their searches? An important element of the suit is the fact that Google gave copies of these scans in their entirety to the providing libraries without prior permission from the copyright owners.

#### EDUCATIONAL FAIR USE

One of the favored fair use purposes in the statute includes making “multiple copies for classroom use.” After the 1976 Act passed, the Copyright Office convened the Conference on New Technological Uses of copyrighted works, a group representing the interests of authors, publishers, educators, and librarians, to help devise guidance on what this means. CONTU was concerned with the effect and the potential of photocopy technology on copyright owners’ and users’ interests. The Conference devised guidelines for classroom and library photocopying by nonprofit educational institutions. These guidelines, known as the CONTU Guidelines ([www.cni.org/docs/infopols/CONTU.html](http://www.cni.org/docs/infopols/CONTU.html)), set forth the safe harbor conditions—that is, the minimum amount of educational copying permitted under fair use—but do not purport to define the maximum amount and frequency of copying allowed.

Under the CONTU guidelines, an individual teacher may copy portions of copyrighted works for a class if the copyright notice in the owner’s name appears on the class materials and the use is not systematic (for example, done throughout a school system or for an entire semester). Systemic copying, including unauthorized copying of excerpts from books to cre-

ate coursepacks, is not fair use. For educators who do not know whether a planned use of a work falls within fair use, the University of Texas has created an excellent, clear, and comprehensive explanation and “Rules of Thumb” for all kinds of educational uses: library uses, performance and display in face-to-face and long distance instruction, coursepacks, digitization, and multimedia uses. It is available at <http://copyright.lib.utexas.edu/copypol2.html>.

### *BEST PRACTICES IN FAIR USE GUIDES*

Acknowledging that a lack of clear guidance and the harsh penalties for infringement together have a detrimental chilling effect on fair users, at least eight interested groups have taken action. Supported by the Center for Social Media, these groups have painstakingly devised codes of best practices in fair use for their specific vocations. They include poets, cinema and media studies writers, documentary filmmakers, media literacy educators, online video makers, open courseware creators, research and academic libraries, and makers of dance-related materials. The Center for Social Media has aggregated these codes and is actively working to facilitate more such codes for professions that need to make fair use in order to function. [www.centerforsocialmedia.org/fair-use](http://www.centerforsocialmedia.org/fair-use).

### *HOW TO GET PERMISSION TO COPY*

Almost every publishing contract requires the author to warrant and represent that she has all rights necessary to include third party content in the work. This guarantee means that if you want to include a third party’s materials, such as photos, illustrations, or maps, in your book or article, you must do one of three things: make fair use (or rely on another exception to copyright), use public domain work, or obtain permission to include the work from the holder of the copyright. This section briefly examines public domain status and then describes how to get permission to use materials if you need to do so.

### *WHAT IS IN THE PUBLIC DOMAIN?*

If a work is in the public domain, anyone can use it however they wish without permission. In the United States, works published before January 1, 1923, works published without notice before 1978 (or 1989 in some cases), and works published before 1964 for which registration was

not renewed are all in the public domain.<sup>30</sup> But it is not easy to know with certainty whether a work published after 1922 remains in copyright.<sup>31</sup> The peculiar way US copyright law has evolved makes determining the public domain status of a work complicated. For example, legislation passed in 1994 restored copyright protection in the United States to virtually every foreign work younger than 75 years old that entered the public domain because the owner did not observe American formalities of notice, registration, or renewal. Works published between January 1, 1978, and February 28, 1989, without notice might have forfeited copyright, but some of them may have been spared (see chapter 3). Unfortunately, the registration status of material published or registered before 1978 is not searchable in the Copyright Office's database or any other authoritative site. If you want to search those older copyright records, you must contact the Copyright Office and pay for the search or do it yourself in person.

Unless a work is clearly in the public domain or your proposed use is fair use or otherwise exempted under the Act, you will need to obtain legal permission to copy protected elements of it. To obtain permission, follow these steps: determine who owns the rights, contact the owner, negotiate permission to use the work for the duration, territories, and formats you need, possibly pay a fee, and document the permission in writing. It can take several weeks to several months to secure permission in the best case, so plan ahead and start as early as you can. The last thing you want is to have included third party material and be on the verge of delivering your work, or of publishing it, before you begin negotiations.

### FINDING THE OWNER

If the work you want to include is obscure or unpublished it could be difficult, if not impossible, to find the owner.<sup>32</sup> Copyright registrations and all recorded assignments and licenses from January 1, 1978, to the present are

<sup>30</sup> Contrary to myth, the fact that a work is available via the Internet does not mean it is in the public domain.

<sup>31</sup> Appendix C is a chart that outlines the public domain or copyright status of a literary work depending on its age, publication date (if any) and registration status (if any).

<sup>32</sup> For several years, Congress has introduced, and failed to pass, so called "orphan works" legislation that would make it easier for users who make a diligent but fruitless search for an owner to use the work without facing harsh infringement liability.

searchable at the Copyright Office website, [www.loc.gov/copyright/](http://www.loc.gov/copyright/). (Of course, many copyrighted works are not registered and therefore will not appear in the Copyright Office's database.)

If the work in question is part of a published book that is in print, the publisher probably owns the exclusive right to grant permission; if the book is out of print, the publisher might direct you to the owner or her agent. Be aware that many publishers are notoriously slow to respond to permission requests. If you have trouble getting a response, your own publisher might be able to help you. The Authors Registry, a clearinghouse for payments to authors, has a database containing the contact information of more than thirty thousand authors and dozens of literary agencies. ((212) 563-6920 or [staff@authorsregistry.org](mailto:staff@authorsregistry.org)).

For song lyrics, you are less likely to prevail on a fair use claim even if you use only a couplet (although song titles are not protected by copyright). The music publisher probably owns the rights to a song's lyrics. If the Copyright Office's database does not reveal the claimant, try searching the databases offered by the major music performance rights associations: ASCAP, the American Society of Composers, Authors and Publishers, at [www.ascap.com/ace/index.aspx](http://www.ascap.com/ace/index.aspx); BMI, Broadcast Music, Inc., at [www.bmi.com/search/](http://www.bmi.com/search/); or SESAC, at [www.sesac.com/Repertory/Terms.aspx](http://www.sesac.com/Repertory/Terms.aspx). These groups do not grant permission to quote lyrics, but the databases provide contact information for the publisher or other claimants for the millions of songs in their repertoires.

Once you have found the owner, you can secure permission with a letter or email describing the project (including your publisher and the estimated print run), the material you want to use, the extent of the rights you need (that is, territory, formats, duration—which must at least mirror the rights you have granted to your publisher), whether exclusive or, more commonly, nonexclusive, the proposed credit line, and the permission fees, if any. Permission fees are negotiable and will vary depending on the amount and nature of the material you intend to use. Some publishers provide permissions kits to their authors, which include its preferred permission form and instructions. Once the owner indicates that it will grant permission, you should secure the license in writing.

The sample form below can be adapted to meet your particular situation by describing your proposed use clearly.

## SAMPLE PERMISSION FORM

[Your name] (the "Licensee") is composing [your work, e.g., a book, play, article, etc.] tentatively entitled [Title] (the "Work") to be published [or produced] by [Publisher or producer]

For valuable consideration of [describe fee or other valuable exchange, if necessary], the receipt and adequacy of which is acknowledged, [Owner's name] (the "Licensor") hereby grants to the Licensee the [non-]exclusive right to reproduce [or translate or adapt] the following material (the "Material") in the Work in [specify media or formats, language(s), territory, time period, if any]:

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