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Pace Intellectual Property, Sports & Entertainment Law Forum, Volume 5, Issue 1, Spring 2015

Abstract

The staff of PIPSELF has worked diligently this year in selecting and preparing original and appealing articles concerning emerging issues in the fields of intellectual property, sports, and entertainment law for this issue. We welcome our readers to send comments and feedback: e-mail us at pipself@law.pace.edu, visit our Twitter [@PIPSELF](#), or 'like' us on Facebook at "Pace Intellectual Property, Sports & Entertainment Law Forum."

Keywords

intellectual property, sports, entertainment, copyright

Pace Intellectual Property, Sports & Entertainment Law Forum

Volume 5

Spring 2015

Issue 1

VIRTUAL WORLDS GOING MAINSTREAM: COMICS, GAME OF THRONES, SOCIAL MEDIA, GOOGLE BOOKS AND THE LAWS OF INTELLECTUAL PROPERTY

ARTICLES

The Night is Dark and Full of... Family Law?:

California Law and Marital Presumption in Games of Thrones

Rebecca Rosen

Transforming “Transformative Use”:

The Growing Misinterpretation of the Fair Use Doctrine

Caile Morris

Wide Right:

How ISP Immunity and Current Laws Are Off The Mark

In Protecting The Modern Athlete on Social Media

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Gotham Skylines:

The Intersection of Scènes à Faire and Fictional Facts

In Comic Books, Graphic Novels, and Their Derivative Works

Gavin M. Strube

Pace
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PACE LAW SCHOOL
P A C E U N I V E R S I T Y

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The Forum, known colloquially to the Pace community as PIPSELF, celebrates its fifth anniversary. Since its inception, PIPSELF has grown in both size and stature, thanks to the dedication and determination of past and present Editorial Boards. The premier volume featured compositions compiled by and prepared for publication solely by the four founding members. Today, the journal comprises a fully staffed Editorial Board and a roster of Associate Editors.

The Volume 5 Editorial Board would like to give special thanks to our new Faculty Advisor, Professor Leslie Garfield, for all of her supervision and guidance as a managerial advisor this year. In addition, the present Editorial Board is extremely grateful to the Pace University School of Law Library Staff for their continued assistance and encouragement. A special thank you to Professor Lucie Olejnikova for her availability and support throughout the school year.

The staff of PIPSELF has worked diligently this year in selecting and preparing original and appealing articles concerning emerging issues in the fields of intellectual property, sports, and entertainment law for this issue. We welcome our readers to send comments and feedback: e-mail us at pipself@law.pace.edu, visit our Twitter [@PIPSELF](https://twitter.com/PIPSELF), or 'like' us on Facebook at "Pace Intellectual Property, Sports & Entertainment Law Forum."

— *Alexia Mickles*
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Volume 5

PACE UNIVERSITY
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PACE INTELLECTUAL PROPERTY, SPORTS &
ENTERTAINMENT
LAW FORUM

Volume 5

Spring 2015

Issue 1

Essay

**The Night is Dark and Full of...Family Law?:
California Law and Marital Presumption in Game of
Thrones**

*Rebecca Rosen**

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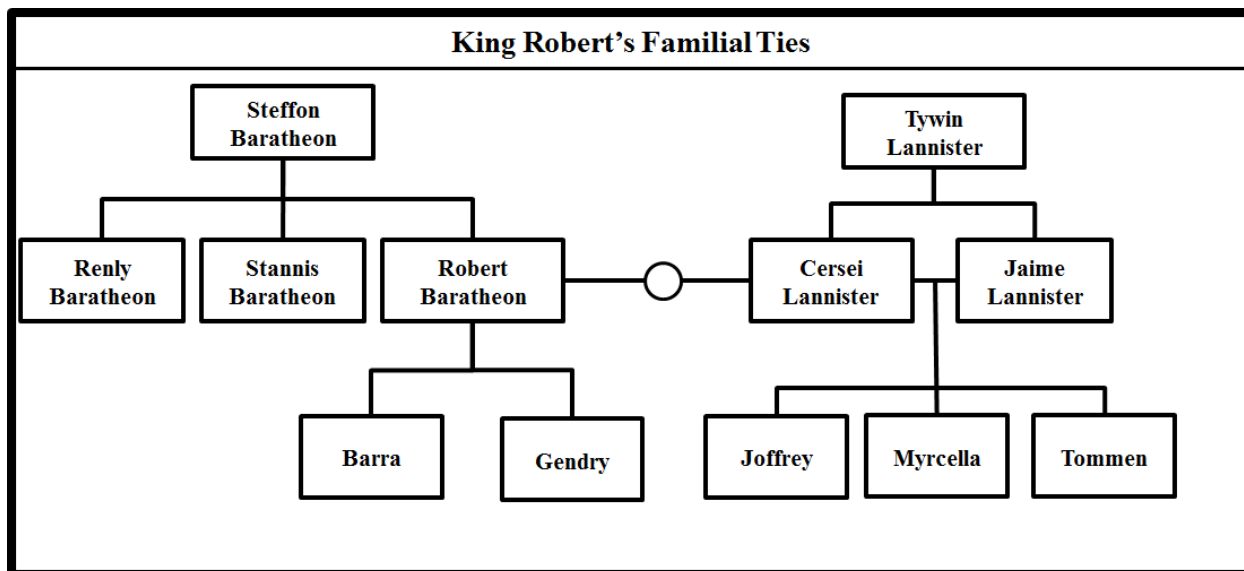
“All men must die.”
–Valyrian Proverb

I. INTRODUCTION

The television show *Game of Thrones* has developed a tremendous following in recent years. The show takes place primarily in the fictional state of Westeros, a feudal society that mirrors many of the legal structures of medieval England. As such, many of the laws and customs of Westeros seem antithetical to the beliefs and values of modern viewers. In an attempt to posit a more just outcome following the death of Westeros’ king (the action which springboards the primary power struggle), this Article applies California law to the disposition of King Robert’s property. Shockingly, this Article finds that California’s marital presumption laws are as unsettling as some of the laws found in Westeros itself.

This Article argues that the current marital presumption laws are outdated and badly in need of reform. Using the disposition of King Robert’s property as an example, this Article critiques the modern California Family Code’s approach to paternity disestablishment. Part I provides a description of the marital presumption rule. Part II applies it to situations such as King Robert’s where the father incorrectly believed that a child was his own. Part III concludes by suggesting how the law should be altered to create a more just outcome to situations of mistaken paternity.

While more information can be gleaned from *A Song of Fire and Ice* book series, this Article relies on the information obtained through the HBO series unless otherwise indicated. Additionally, this Article only addresses the disposition of property as it would occur under California law.



II. HEIR, HERE?

The following section explains the marital presumption rule, its justification, and how one would rebut the presumption.

A. *What is the Marital Presumption?*

The marital presumption law states that if a man's wife has a child during the course of the marriage the man is the presumed biological father of the child.¹ This presumption arose to prevent children from being labeled as illegitimate (due to associated social and legal stigmas), to address a lack of available scientific tools, to encourage personal responsibility for children, and to protect the integrity of the family unit.²

¹ CAL. FAM. CODE § 7540 (West 2014).

² See Paula Roberts, *Truth and Consequences: Part II. Questioning the Paternity of Marital Children*, 37 FAM. L.Q. 55, 56 (2003) (genetic testing was not available until the 20th century, whereas the rule originated in the 18th century); Niccol D. Kording, *Little White Lies That Destroy Children's Lives – Recreating Paternity Fraud Laws to Protect Children's Interests*, 6 J. L. FAM. STUD 237, 242 (2004); *In re Paterson's Estate*, 93 P.2d 825, 831 (Cal. Ct. App. 1939).

B. Fading Justification for the Marital Presumption Rule

These justifications, however, are no longer as salient as they once were. Today, children do not face substantial social and legal stigmas based on the marital status of their parents. As the number of children born out of wedlock has increased, the social stigma associated with children born out of wedlock has decreased.³ Additionally, legislatures have passed numerous statutes forbidding discrimination based on the marital status of a child's parents.⁴ Furthermore, today's courts are not limited by a lack of scientific tools. Modern genetic testing can determine whether a man is the biological father of a child with almost complete certainty.⁵ Therefore, social stigmas, legal stigmas, and a lack of scientific tools no longer form a legitimate justification for the marital presumption rule.

The remaining justifications for the rule are alleged support for personal responsibility of children and protection of the family unit. Application of this rule, however, does not encourage personal responsibility; it merely shifts who is presumed responsible for taking care of the child. The marital presumption rule allows a man to father children with a married woman and permits him to escape all legal and financial responsibility.⁶ In fact, that is *exactly* what happened in this case study. Furthermore, forcing a legal fiction of parenthood does not ensure the stability or longevity of the family unit. Prohibiting divorce does not ensure that all marriages are happy and, in the same way, prohibiting paternity disputes does not ensure that all families will be cohesive.

The sad truth is that the courts no longer enforce the marital presumption rule because of rational justifications; the courts enforce the marital presumption law because it is administratively convenient and straightforward. As scholars have pointed out, however, "convenience should not require that a husband remain financially responsible for the actions of other men."⁷

C. Rebutting the Presumption

While still rebuttable, the marital presumption is "one of the strongest and most persuasive presumptions known to the law."⁸ Rebutting the marital

³ See Brady E. Hamilton, et al., *Births: Preliminary Data for 2012*, 62 NAT'L VITAL STATISTICS REP. 2 (Sept. 6, 2013), http://www.cdc.gov/nchs/data/nvsr/nvsr62/nvsr62_03.pdf (concluding that 4.53% of children were born out of wedlock in 2012).

⁴Browne Lewis, *Children of Men: Balancing the Inheritance Rights of Marital and Non-Marital Children*, 39 U. TOL. L. REV. 1 (2007).

⁵ *Frequently Asked Questions Regarding Paternity: Parentage Testing* GENETIC PROFILES CORP., http://www.geneticprofiles.com/main_files/faq.htm (last visited Mar. 11, 2015) ("DNA Profiling can establish that the alleged father is the child's biological father with a probability of paternity of 99% or higher.")

I. ⁶ SEE VERONICA SUE GUNDERSON, *PERSONAL RESPONSIBILITY IN PARENTAGE: AN ARGUMENT AGAINST THE MARITAL PRESUMPTION*, 11 U.C. Davis J. Juv. L. & Pol'y 335, 349 (2007).

⁷ Gunderson, *supra* note 6, at 349.

⁸ CAL. FAM. CODE § 7540; *Richard B. v. Sandra B.B.*, 625 N.Y.S.2d 127, 129 (App. Div. 1995).

presumption adheres to a strict statute of limitations: a parent wishing to disestablish the presumption of paternity must raise a claim within two years of the child's birth.⁹ The claim can be brought by the husband, presumed father, or the child.¹⁰ Genetic testing can be used, but the statute provides little guidance for how to apply these scientific tests and their implications.¹¹

III. DISTRIBUTION OF PROPERTY AND THE APPLICATION OF THE MARITAL PRESUMPTION

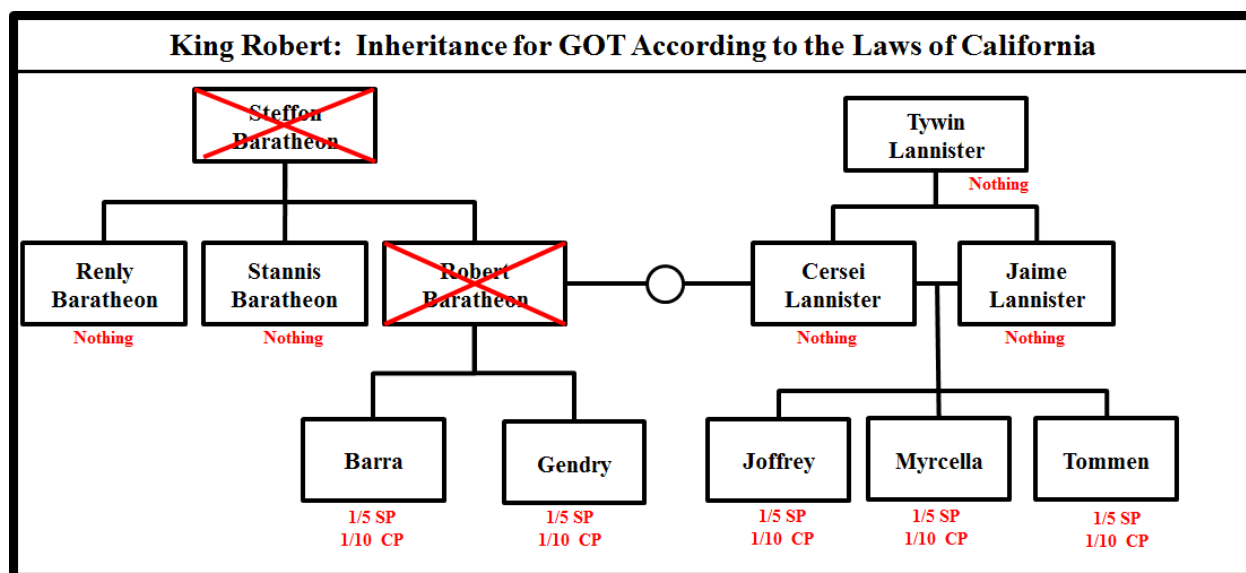
The distribution of King's Robert's property would be different under California law in three ways: (1) the application of California's slayer statute, (2) the application of California law concerning illegitimate children, and (3) the application of the marital presumption rule.

Before diving into the ways in which California law is distinct from Westeros law, an overview of California's property rules is in order. In California, property consists of both community property and separate property. Property produced during the marriage and by the labor of either spouse is termed community property. When one of the marriage participants dies, the decedent is allowed to distribute half of the community property via will or that half will be distributed via intestate succession. Things that are not considered community property include (1) property acquired before the marriage, (2) property acquired after a divorce, or (3) property acquired without labor (i.e. inheritance). Separate property, on the other hand, is held by individuals and held separately from the spouse. When one of the marriage participants dies, the decedent is allowed to distribute all of the separate property via a will or that separate property will be distributed via intestate succession. The following section discusses the distribution of King Robert's half community property and the entirety of his separate property.

⁹ CAL. FAM. CODE § 7541.

¹⁰ *Id.*

¹¹ *Id.*



A. Barred Inheritance for Slayers

First, California probate law prevents a slayer from inheriting property from his spouse, while Westeros law does not. A slayer is an individual who intentionally and feloniously kills his spouse.¹² Normally, under intestate succession, the surviving spouse of the decedent is entitled to half community property and one-third separate property of the decedent's property slated for disposition.¹³ Here, however, Cersei's orchestration of King Robert's death pegs her as a slayer and bars her from inheriting any property from him. Cersei instructed Robert's squire to intoxicate him during the boar hunt to increase the chances of Robert dying in a hunting accident. This demonstrates the necessary intent to qualify as a slayer, and the murder itself qualifies as felonious. Therefore, Cersei will not be able to inherit any property from her late husband.

B. Inheritance Rights of Children Born Out of Wedlock

Second, California probate law allows children born out of wedlock to inherit property, while Westeros law does not. Robert's illegitimate children would benefit substantially under California's property laws because California grants the same inheritance rights to children born out of wedlock as it affords to children born to married parents.¹⁴ California intestacy statutes indicate that if the decedent's wife is either deceased or barred from inheritance, all of the property will be inherited by

¹² CAL. FAM. CODE § 7541.

¹³ CAL. PROB. CODE § 6401 (West 2014).

¹⁴ See Lewis, *supra* note 4.

the issue of the decedent.¹⁵ Robert's illegitimate children, Gendry and Barra, qualify as issue and therefore stand to inherit part—and potentially all—of King Robert's estate.

C. The Iron Grip of Marital Presumption

Third, California family law adheres to the marital presumption law, while Westeros law does not. Cersei admits that her children were not fathered by Robert¹⁶ and Ned's analysis of genetic lineage confirms her statement.¹⁷ Despite this conclusive information disproving Robert's paternity, neither a confession nor genetic testing can overcome the presumption. Additionally, Ned lacks standing to bring this claim.¹⁸ California's family laws dictate that, despite clear evidence to the contrary, Joffrey, Myrcella, and Tommen are legally King Robert's issue, and as such, they each would inherit one-fifth of the King's separate property and one-tenth of the King's community property. Robert's actual issue would be forced to share his property with Cersei's children, despite clear parental fraud.

IV. PROPOSED SOLUTION

A. Proceedings with Caution

The initial response to a case study like the one above is to abolish the marital presumption rule. Before rash action is taken, however, there are two major problems with eliminating this rule. First, it would punish the child as well as the mother. Second, it would model the law based on an anomaly. When deceit occurs the wrongdoing falls on the shoulders of the mother, not the child; however, marital presumption laws protect both parties. As a result, alterations to marital presumption laws also have the potential to hurt both parties. Caution should be taken to avoid harming a child who played no role in deceiving a parent. Furthermore, abolishing the marital presumption law suggests that the norm involves married women giving birth to illegitimate children left and right. The problem of parental fraud exists, but it is not so rampant as to form the basis of our legal structure. These problems suggest that minor changes, rather than a complete overhaul, is the proper way to proceed.

An alternative to abolishment of the presumption is strengthening the tools to rebut the presumption. This Article's suggested changes will not fix all of the problems that arose in this case study. Under both the current family code and this Article's proposed changes, Joffrey, Myrcella, and Tommen will still inherit. Their mother lied to her husband, her children, and the kingdom; yet she will not be

¹⁵ CAL. PROB. CODE § 6402.

¹⁶ *Game of Thrones: You Win or You Die* (HBO television broadcast May 29, 2011).

¹⁷ *Game of Thrones: A Golden Crown* (HBO television broadcast May 22, 2011).

¹⁸ CAL. FAM. CODE § 7540.

punished for her deceit. While proposals exist to eliminate parental fraud,¹⁹ they are drastic and reduce the family unit to expectation of a series of lawsuits based on genetic links. California cannot write its laws with Cersei as the prototypical mother and Joffrey as the prototypical son. Laws cannot be based off of outliers, lest society allows the innocent to be punished along with the guilty. Instead, this Article applies a few changes to our existing system to feasibly achieve a more just system.

B. A Partial Solution

There are a few simple tweaks that would go a long way in preventing parental fraud problems in the future. First, the California Family Code should adjust the statute of limitations to run from knowledge of the paternity issue rather than from birth. Second, the law should allow genetic testing to help disprove paternity, but limits should be placed on the genetic tests to prevent abuse. Considering each of these suggestions would go a long way towards remedying an outdated common law doctrine.

i. Changing the Time Frame of the Statute of Limitations

Currently, the statute of limitations is set at two years after the child's birth.²⁰ If the father has no reason to suspect that his wife has been unfaithful during this time period, he will unknowingly run out the clock. Two reasons to justify the "from birth" statute of limitations include: (1) ease of the court system to avoid later litigation, and (2) emotional and financial stability for the child.

While predictability is important and forms the basis of different legal concepts, the concept can only go so far. Setting a statute of limitations without regard to knowledge prevents men from seeking justice for parental fraud.

While the goal of achieving a stable emotional environment is admirable, it is a fiction to believe that a short statute of limitations achieves this goal. A father who finds out that a child is not his own is unlikely to preserve and provide the emotional stability hoped for by the courts, regardless of a lack of legal remedies.

Rather than starting the clock from the moment the child was born, the clock should start running from when the father gained real or constructive knowledge that the child was not his own. Tolling the statute of limitations to begin after notice is common in other areas of law.²¹ This alteration would prevent adulterers like Cersei from bragging about her deception with impunity. By altering the

¹⁹ Kording, *supra* note 2, at 265-68 (suggesting mandatory genetic testing at birth to prevent parental fraud).

²⁰ CAL. FAM. CODE § 7540.

²¹ *E.g.*, CAL. PEN. CODE § 803 (West 2015) (asserting a discovery rule within criminal law); CAL. CODE CIV. PROC. § 340 (West 2014) (asserting a discovery rule within tort law); CAL. CODE CIV. PROC. § 338 (West 2014) (asserting a discovery rule within property law).

starting point of the statute of limitations, the law will permit a more realistic opportunity for men to rebut the marital presumption.

ii. Clarifying Limitations to Genetic Testing

It is laudable that the California Family Code allows genetic testing to prove or disprove parentage, however, the parameters of this rule should be clarified. Courts should place limitations on DNA testing, and Uniform Parentage Act (2002) provides helpful guidelines for when and how to incorporate genetic testing. In order to be entered into evidence, genetic tests must be either (1) court-ordered, or (2) with the full consent of all parties.²² Secretly conducting a genetic test of the family members in question would undermine the family structure and serve as a major violation of privacy. While Ned's actions were guided by moral principles, his analysis of Joffrey's, Myrcella's, and Tommen's genetic heritage should not be admissible in court.

V. CONCLUSION

The marital presumption rule persists because of its entanglements with other laws and social policies. The common law rule and newer family codes seek to protect the family unit while providing a remedy for parental fraud and creating a framework for dealing with scientific advancements. Keeping all of these considerations in balance is a difficult task and perhaps a perfect solution does not exist.

This Article suggests that small steps, rather than massive reform, are the preferred route to improving this doctrine. Readjusting the start date of the statute of limitations and creating more specific guidelines for DNA testing are some of these small developments that will improve the system without destroying the family unit. More steps will need to be taken as science continues to advance and as families create more interesting case studies with which to grapple.

²² Uniform Parentage Act § 621(e) (2002),
http://www.uniformlaws.org/shared/docs/parentage/upa_final_2002.pdf.

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Essay

**Transforming “Transformative Use”:
The Growing Misinterpretation of the Fair Use Doctrine**

*Caile Morris**

* Caile will earn her J.D. on May 17, 2015 from American University Washington College of Law. During her tenure at Washington College of Law, she specialized in intellectual property law (working on the American University Business Law Review as an Articles Editor, blogging for the American University Intellectual Property Brief, and working as a student attorney with the Glushko Samuelson Intellectual Property Law Clinic). Caile received her Bachelor of the Arts in History and American Studies from the State University of New York (SUNY) at Geneseo in May 2012. She would like to dedicate this article to Michelle Winters and the Note and Comment Staff of the American University Business Law Review who helped her to research and write this article, Professor Peter Jaszi of American University Washington College of Law for inspiring her to write on this topic, and to her family and friends for supporting her throughout the writing process.

Abstract

Starting in late 2012, and continuing into late 2013, the United States District Court for the Southern District of New York wreaked havoc on the traditional interpretation of the copyright infringement defense known as “fair use.” Two cases stemming from the advent of the Google Books Project are *Author’s Guild, Inc. v. HathiTrust* and *Author’s Guild, Inc. v. Google, Inc.* These cases adopted a controversial interpretation of the fair use defense, codified in 17 U.S.C. § 107, when each case determined that the mass digitization of thousands of books constituted fair use merely because the digitization was what is known as “transformative use.”

This Comment will explore the background of the fair use defense, from its common law origins, to its codification in the 1976 Copyright Act, to its application in modern law. Keeping this background in mind will explain why the current legal state of the fair use defense, as propagated by the District Court for the Southern District of New York and the United States Courts Appeals for the Ninth Circuit, is inconsistent with traditional statutory construction principles.

Proposed recommendations to solve legal inconsistencies in Section 107 can come from clarification either from Congress by way of an amendment to this Section, or by a decision from the United States Supreme Court.

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I. INTRODUCTION

On October 10, 2012, Judge Baer handed down a decision that fueled dramatic change to the fair use doctrine of U.S. copyright law. In *Author's Guild v. HathiTrust*, Judge Baer upheld the actions of a group of academic libraries to digitize their collections by partnering with Google in the Google Books project.¹ The court held that these actions did not fall under the Copyright Act's library exception, codified at 17 U.S.C. § 108, but instead would be afforded a fair use defense, found at 17 U.S.C. § 107.²

On November 13, 2013, Judge Chin of the same court continued this dramatic change by ruling for a commercial entity with a fair use defense. In *Author's Guild, Inc. v. Google, Inc.*, Judge Chin upheld Google's fair use defense for the complete copying and digital reproduction of millions of copyrighted materials.³

These holdings are a radical change from precedent leading up to the codification of the fair use defense.⁴ Only the Ninth Circuit applies the fair use defense as the New York courts did, using a contested interpretation of transformative use, which was a major basis for both *Author's Guild* decisions.⁵ Each Southern District of New York judge focused on the way that defendants, *Google* and *HathiTrust*, transformed the copyrighted works in new and socially valuable ways that varied greatly from the uses of the original books and articles.⁶ Traditionally, the fair use judicial interpretation balanced rewarding authors and creators with intellectually enriching the public; the dramatic shift in the Southern

¹ *Authors Guild, Inc. v. HathiTrust*, 902 F. Supp. 2d 445 (S.D.N.Y. 2012) (holding that the fair use defense was available to the universities and that the systematic digitization of copyrighted books contained within the universities libraries' was protected by the fair use doctrine).

² *Id.* at 456-58.

³ *Author's Guild, Inc. v. Google, Inc.*, 954 F. Supp. 2d 282 (S.D.N.Y. 2013) (holding that the fair use defense was available to Google, a commercial Internet search engine, for the systematic digitization of copyrighted books from partner libraries).

⁴ 17 U.S.C. § 107 (2010); *see generally* *Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841) (enumerating the fair use defense as it was usually applied at common law as well as the four factors generally associated with those codified in the current Copyright Act).

⁵ *See Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003) (holding that displaying a 'thumbnail' version of a copyrighted picture on an Internet search engine was a transformative use, and therefore protectable under the fair use doctrine); *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007) (holding that Google's use of 'thumbnail' images of copyrighted images was a transformative use and protectable under the fair use doctrine). *But see, e.g.* Sandford Gray Thatcher, *One Publisher's Take on the Google Decision*, LIKELIHOOD OF CONFUSION (Nov. 14, 2013), <http://www.likelihoodofconfusion.com/one-publishers-take-on-the-google-books-decision>.

⁶ *See generally Google*, 954 F. Supp. 2d 282 (explaining that Google's scanning of the copyrighted books into a keyword searchable online database was transformative from the original use of the books); *see generally HathiTrust*, 902 F. Supp. 2d 445 (finding that the works in the HathiTrust Digital Library transformative because they serve a different purpose, i.e. search capability, than the original copyrighted works).

Transforming Transformative Use:
The Growing Misinterpretation of the Fair Use Doctrine

District of New York and Ninth Circuit courts now allows mass digitization of copyrighted works to continue without the permission of copyright holders.⁷

This Comment will argue that the growing theory of transformative use as propagated by the Ninth Circuit, and adopted by New York's Southern District, is a judicial interpretation that is not consistent with statutory construction principles. The decisions in *HathiTrust* and *Google*, extending the Ninth Circuit broad view of transformative use, stray too far from the traditional analysis of the fair use doctrine. Congressional intent is at odds with this broad interpretation, and the principles of the Copyright Act would be better served by returning to a more traditional interpretation. In lieu of returning to a more traditional judicial interpretation of the fair use doctrine, there are a few legislative-based alternatives that would allow for this kind of digitization to continue without straying from the traditional statutory construction of 17 U.S.C. § 107.

Part Two of this Comment explores the background of the fair use doctrine from its common law origins and codification through to its application in modern law. This exploration will focus on relevant case law that developed the fair use doctrine until its codification in 17 U.S.C. § 107 and the general application following codification. Part Two also describes the broad Ninth Circuit interpretation of the fair use doctrine, particularly the theory of transformative use. Additionally, this part details the *Author's Guild, Inc. v. HathiTrust* and *Author's Guild, Inc. v. Google, Inc.* decisions. Finally, this subsection explains the basics of a statutory construction analysis.

Part Three analyzes why the transformative use interpretation is inconsistent with traditional statutory construction principles by looking to 17 U.S.C. § 107 and its legislative history in order to conduct a statutory construction analysis of the statutes. Part Three also explains why the decisions in *Google* and in *HathiTrust*, specifically, veer too far from the principles of statutory construction.

Part Four provides legislative and judicial solutions to the issue of interpreting the fair use doctrine, and more specifically, how the transformative use theory factors in to the overall analysis.

Finally, Part Five concludes by reiterating that the current fair use defense, as it exists in modern copyright law, is inconsistent with statutory construction principles.

II. FROM COMMON LAW TO CODIFIED LAW TO TRANSFORMATIVE LAW: TRACING THE HISTORY OF THE FAIR USE DOCTRINE

In what is known as the Copyright Clause, the United States Constitution gives Congress the power “[t]o promote the Progress of Science and useful Arts, by

⁷ See generally *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (adopting Judge Leval's view of transformative use to help analyze the first factor of the four factor fair use doctrine test) (citing Leval, *infra* note 24).

securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁸ This clause embodies the delicate balance struck between rewarding an author for time and effort put into creating a work and limiting the monopoly protection to a certain amount of time, providing the public with access to the work.⁹ The fair use defense plays a significant role in this balance because it attempts to limit the protection given to the authors by giving members of the public who meet certain criteria an affirmative defense to their infringement of an author’s copyrighted material.¹⁰

This section discusses the origins of the fair use defense and its original application, the codification of fair use in the Copyright Act, and finally, how it is applied in modern law.

A. Humble Beginnings: History of Fair Use and Creation of 17 U.S.C. § 107

Justice Story once opined that “copyrights approach, nearer than any other class of cases belonging to forensic discussions, to what may be called the metaphysics of the law, where the distinctions are, or at least may be, very subtle [sic] and refined, and, sometimes, almost evanescent.”¹¹ Justice Story means it is often difficult in copyright cases to come to fitting conclusions or create principles that can be generally applied to all copyright cases.¹² Copyright infringement cases, by nature, need to be examined and analyzed case-by-case, as copying one line of a novel may be considered infringement, whereas copying large chunks may not be found to infringe depending on other facts and circumstances.¹³

The fair use defense is no different in that judges need to examine and analyze the argument on a case-by-case basis. Justice Story recognized this in the first case found to enumerate the factors we now know as part of the fair use defense.¹⁴ In *Folsom v. Marsh*, the plaintiff had created a work on the life of President George Washington, which included personal letters written by

⁸ U.S. CONST. art. I, § 8, cl. 8.

⁹ See U.S. CONST. art. I, § 8, cl. 8.

¹⁰ 17 U.S.C. § 107 (allowing those defendants who meet the criteria an affirmative defense for infringement when it is used for purposes such as teaching, reporting, or researching following an analysis of four factors).

¹¹ *Folsom*, 9 F. Cas. at 344.

¹² *Id.*

¹³ *Id.* at 344-45. See also *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 560 (1985) (stating that there is no generally applicable fair use definition that can be applied, so each case must be decided on its own facts); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 448 (1984) (allowing a Court to use section 107 to apply an equitable rule of reason analysis to claims based on their particular facts); H.R. REP. NO. 94-1476, at 65-66 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5679 (“Indeed, since the [fair use] doctrine is an equitable rule of reason, no generally applicable definition is possible, and each case raising the question must be decided on its own facts.”); S. REP. NO. 94-473, at 62 (1975) (“Beyond a very broad statutory explanation of what fair use is and some of the criteria applicable to it, the courts must be free to adapt the doctrine to particular situations on a case-by-case basis.”).

¹⁴ *Folsom*, 9 F. Cas. 342.

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Washington along with his biography.¹⁵ The plaintiff edited a twelve-volume work on the life of President George Washington, the first volume containing a biography and the following eleven volumes containing verbatim copies of President Washington's personal and private letters, messages and other public acts, with some explanatory notes from the editor.¹⁶ Justice Story found that the defendant used some of the letters from the plaintiff's work in creating his own, shorter biography of Washington in two volumes, copying 353 pages identically, with 319 of these pages containing the contested verbatim copies of the Washington's letters.¹⁷

In 1841, the Circuit Court of Massachusetts was confronted with the questions of whether such copying was considered piracy, and if there were any affirmative defenses to such copying.¹⁸ Justice Story laid out some factors that could be used to determine if a person had pirated another's copyrighted work, but would not be held liable for his or her piracy in coming to this decision.¹⁹ This case is the common law foundation of the analysis of the current fair use defense in U.S. Copyright law.²⁰

Most courts have adopted these factors to help determine if a fair use defense was applicable in any given case.²¹ They were so prevalent in fact, that they were codified as the factors for judicial consideration in the 1976 Copyright Act.²² These factors include "the purpose and character of the use," which includes consideration of whether the use is commercial or not "the nature 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 use upon the potential market for or value of the copyrighted work."²³ The fair use section says that fair use of a copyrighted work for the purposes of criticism, comment, news reporting, teaching, scholarship, or research is not considered an infringement of copyright.²⁴ The section then lists factors, reminiscent of those from Justice Story, which judges may take into consideration to determine if the facts of a case warrant a fair use defense.²⁵

¹⁵ *Folsom*, 9 F. Cas. at 345.

¹⁶ *Id.*

¹⁷ *Id.* at 345-46.

¹⁸ *Id.* at 345-49 (finding a 'piracy,' which is equated with modern day copyright infringement, and that the affirmative defense brought by the defendant fell short in this case, a defense later known as the fair use defense).

¹⁹ *Id.* at 348 ("Look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.").

²⁰ *Folsom*, 9 F. Cas. at 348; see 17 U.S.C. § 107 (West 1992).

²¹ See *Campbell*, 510 U.S. at 576-80; Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1106-07, 1110-12 (1990) (explaining how judges have applied fair use despite the lack of guidance given by the codification in section 107, and how he believes Judge Story's four factors from *Folsom* should be applied).

²² See 17 U.S.C. § 107.

²³ *Id.*

²⁴ *Id.*

²⁵ *Id.*

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The Congressional notes accompanying the statute show that it is difficult to distinguish between fair use and copyright infringement.²⁶ Although the courts have analyzed and ruled on the fair use defense numerous times, its codification is the first unified attempt at defining it.²⁷ Even with the codification, there is no general definition to apply since fair use must be decided on a case-by-case basis.²⁸ The legislative notes show that the purpose of the statute is to merely codify judicial interpretation of the defense up until that point, not modify or enlarge the concept in any way.²⁹ It is meant to be open to further judicial interpretation and be a starting point for a judge's analysis.³⁰

In the years following its codification, Section 107's open-ended application provided too little guidance for judges on how to recognize fair use and what extent of copying is acceptable.³¹ In 1990, Judge Pierre Leval of the Second Circuit published a law review article advocating for a fair use defense concept that is consistent with the principles of copyright.³² These principles include the utilitarian goal of stimulating progress of the arts for the intellectual improvement of the public rather than giving the absolute ownership of a work to an author.³³ A judge may do this by looking at the four statutory factors given and using them to analyze the facts of each case while considering whether a finding of fair use would affect the objectives of copyright.³⁴

The most important point from Judge Leval's article is his explanation of how a judge may analyze the first statutory factor, which considers the purpose and character of the secondary and allegedly infringing use.³⁵ In order to determine this first factor, the secondary use must be analyzed to see if it is justified, and this justification hinges on whether the challenged secondary use is transformative or not.³⁶ According to Judge Leval the first factor is the heart of the fair use defense, while the other factors focus on the entitlements of the copyright owner to be weighed against the first factor.³⁷ Consideration of the purpose and character of use raises the question of whether the use is justified under the objectives of

²⁶ H.R. REP. NO. 94-1476, at 65-66 (1976); S. REP. NO. 94-473, at 62 (1975).

²⁷ H.R. REP. NO. 94-1476, at 65-66 (1976); S. REP. NO. 94-473, at 62 (1975) (suggesting that judges have attempted to apply this defense with the factors for consideration that have emerged within each respective jurisdiction, with no previous statutory basis).

²⁸ *Id.*

²⁹ H.R. REP. NO. 94-1476, at 65-66; S. REP. NO. 94-473, at 62.

³⁰ *Id.*

³¹ Leval, *supra* note. 21 at 1105-07.

³² *Id.* at 1107 (advocating that fair use should become a "rational, integral part of copyright, whose observance is necessary to achieve the objectives of that law").

³³ *Id.*

³⁴ *Id.* at 1110-11.

³⁵ *Id.* at 1111-12.

³⁶ *Id.* (defining a transformative use as one that is "productive and ... employ[s] the quoted matter in a different manner or for a different purpose from the original").

³⁷ Leval, *supra* note. 21 at 1116.

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copyright law.³⁸ If justifiable, it must be powerful enough to outweigh the rights of the copyright owner by transforming the original work.³⁹ This transformative use must add value to the original work, rather than repackaging or republishing quotations from the original material.⁴⁰ Since this factor is indispensable to a fair use defense, if a justification through transformative use is not found, then fair use should be rejected without further analysis of the other factors.⁴¹

Judge Leval advocated successfully for this utilitarian transformative use approach, as it was adopted by the Supreme Court of the United States in *Campbell v. Acuff-Rose Music, Inc.*⁴² Here, the defendants wrote a commercial parody of plaintiff's song and the Supreme Court was asked to rule on the alleged infringement.⁴³ In its consideration and analysis of the issue, the Court heavily relied on Judge Leval's idea of transformative use and how it lies at the heart of the fair use doctrine.⁴⁴ The Court held that this specific parody did not copy excessively from the original, and its criticism of an earlier era was transformative.⁴⁵ In adopting Judge Leval's take on the application of the four factors listed in Section 107, the Court expanded the transformative use concept to a new class of copyrighted works to include pictures, sculptures and music.⁴⁶

This Supreme Court decision acknowledges the importance of the first statutory factor in Section 107 to the fair use defense.⁴⁷ Following this decision, other courts began to expand this application without considering, as Judge Leval cautioned, the core objectives of copyright law.⁴⁸ This expansion began in the Ninth Circuit.⁴⁹

³⁸ Leval, *supra* note. 21 at 1116.

³⁹ *Id.* at 1111-12.

⁴⁰ *Id.* (noting that transformative uses when proven do not necessarily guarantee a successful fair use defense, especially if extensive taking from an original work imposes on the incentives for authors to create).

⁴¹ *Id.* at 1116.

⁴² *Campbell*, 510 U.S. at 578.

⁴³ *Id.* at 571-73 (defendant 2 Live Crew wrote a commercial parody of Roy Orbison's song "Oh, Pretty Woman" owned by plaintiff Acuff-Rose Music Inc. and the Court was to decide if it was either infringement or fair use under 17 U.S.C. § 107).

⁴⁴ *Id.* at 578-79 ("The more transformative the new work, the less will be the significance of other factors ... that may weigh against a finding of fair use.")

⁴⁵ *Id.* at 578-85.

⁴⁶ *Campbell*, 510 U.S. at 578-85.

⁴⁷ *Id.* at 578.

⁴⁸ *Kelly*, 336 F.3d at 811 (applying the fair use defense to an Internet search engine considering the transformative use and public good, unbalancing the rights of the authors and creators at the core of copyright objectives); *Perfect 10*, 508 F.3d at 1146 (applying the fair use defense to Google and Amazon again putting the transformative use that serves the public good over the rights of the copyright owners).

⁴⁹ *Kelly*, 336 F.3d at 818-19; *Perfect 10*, 508 F.3d at 1163-68.

B. Transformations Rewarding the Public Over Authors

The Ninth Circuit is well known for tackling issues of advancing technology in copyright contexts.⁵⁰ The results of considering these sorts of issues do not always retain the core concepts of copyright law, which is to advance public intellect for the exchange of return on investment by creative authors willing to share their works.⁵¹ This is illustrated through the Circuit's decisions in the *Kelly v. Arriba Soft Corp.* and *Perfect 10, Inc. v. Amazon.com Inc.* cases.⁵²

Arriba Soft is a search engine that displays results as small pictures, or 'thumbnails,' instead of displaying text; Kelly, a photographer, realized that his images displaying scenes of the American West were part of Arriba Soft's database, and sued for infringement.⁵³ In 2006, the court in *Kelly v. Arriba Soft Corp.* found that while the defendant's use of the plaintiff's photographs was commercial in nature, it was more incidental than exploitative.⁵⁴ The court also found that changing the full-size photographs into smaller, lower-resolution images constituted a transformative use from the originals by providing access to images on the Internet and their websites, as opposed to the aesthetic function of the original photographs. The court saw this transformation as a change in function from the original work to the infringing use, rather than the "retransmission of ... images in a different medium," simply because this change served the purpose of improving access to information on the Internet rather than artistic expression.⁵⁵ After considering the other three factors of Section 107, the court concluded that since a majority of the factors favored Arriba Soft, the use of the thumbnails should be considered a fair use.⁵⁶

In 2007, the Ninth Circuit again considered a fair use claim with very similar facts to *Kelly*.⁵⁷ *Perfect 10, Inc. v. Amazon.com Inc.*, in which Google was a co-defendant, had facts and a fair use defense analysis that was very similar to *Kelly*.⁵⁸ The court found that Google's use of the thumbnails was highly transformative because they serve a different function than the original work's aesthetic or entertainment purpose.⁵⁹ Google was found to have improved access to information

⁵⁰ See generally *Kelly*, 336 F.3d 811; *Perfect 10*, 508 F.3d 1146 (applying the fair use defense to copyrighted photographs on the internet that were allegedly infringed upon by an online search engine).

⁵¹ See Leval, *supra* note 21, at 1107.

⁵² See *Kelly*, 336 F.3d 811; *Perfect 10*, 508 F.3d 1146.

⁵³ *Kelly*, 336 F.3d at 816-19.

⁵⁴ *Kelly*, 336 F.3d at 816-19.

⁵⁵ *Id.*

⁵⁶ *Id.* at 822.

⁵⁷ See generally *Perfect 10*, 508 F.3d 1146.

⁵⁸ *Id.* at 1155-57, 1163-68 (stating that Google was using thumbnail versions of full pictures from the Perfect 10 website, a site offering nude photos to those willing to pay to be part of the "member's area").

⁵⁹ *Id.* at 1163-68; See also *Kelly*, 336 F.3d at 819.

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on the Internet, a use that the court found to be new, different, and transformative from Perfect 10's original use for the photographs.⁶⁰

Changing the theory of transformative use to give so much deference to public enrichment over rewarding the authors goes beyond the guidance provided by the statute in Section 107.⁶¹ The Supreme Court advocated for this change, so long as it was done within the purposes of copyright, and also stated that lower courts may lessen the weight of consideration of the last three factors so long as the first factor is found through a transformative use.⁶² The Ninth Circuit takes this one step further by looking to the great public service provided by these two similar cases in terms of search engine functionality and accessibility, and how transformative the use is without seeming to consider the other Section 107 factors Judge Leval advised would protect the interests of the copyright owner.⁶³ This shift puts more emphasis on the needs of the public over the need to incentivize new authors and creators to continue creating, unbalancing one of the core purposes of copyright.⁶⁴

C. Transforming Fair Use to Serve the Public: Google and HathiTrust

The Ninth Circuit is no longer one of the only Circuits to apply the transformative use concept to the fair use defense by favoring vast public enrichment over rights of authors. Two recent cases out of the Southern District of New York in the Second Circuit have fully embraced this concept relating to the Google Books Project.⁶⁵

The Author's Guild, a professional organization and advocate for writers, brought suit against Google in late 2005 for its creation of the Google Books Project and litigation continued through November of 2013.⁶⁶ Google partnered with academic libraries to create a large electronic database in which both copyrighted books and books in the public domain are keyword-searchable and available in a digital format.⁶⁷ In *Author's Guild, Inc. v. Google, Inc.*, Judge Chin found that Google could exercise a fair use defense, relying heavily on Judge Leval's article, the ruling from the Supreme Court in *Campbell*, and the more recent Ninth Circuit

⁶⁰ See *Perfect 10*, 508 F.3d at 1165 (going so far as to say that the search engine may have more transformative use than the parody considered by the Supreme Court in *Campbell*).

⁶¹ See 17 U.S.C. § 107; see generally *Kelly*, 336 F.3d 811; *Perfect 10*, 508 F.3d 1146.

⁶² See *Campbell*, 510 U.S. 569.

⁶³ See *Kelly*, 336 F.3d 811; *Perfect 10*, 508 F.3d 1146; see also Leval, *supra* note 24, at 1110-11, 1116-25.

⁶⁴ Leval, *supra* note 21, at 1106-07.

⁶⁵ See generally *HathiTrust*, 902 F. Supp. 2d 445; *Google*, 954 F. Supp. 2d 282.

⁶⁶ See generally *Google*, 954 F. Supp. 2d 282 (The history of this case between 2005 and 2011 concerned the two parties negotiating a settlement, which was denied by the Southern District of New York. Following the denial, a new class-action suit was filed and recently decided in November 2013.).

⁶⁷ *Google*, 954 F. Supp. 2d at 282.

precedent regarding fair use.⁶⁸ While there was an abundance of evidence pointing to a prima facie case of copyright infringement by Google, it did not matter because Google's use of the copyrighted works was highly transformative. The court held that Google changed "expressive text into a comprehensive word index that helps readers, scholars, researchers, and others find books" and did not supersede the text of the books.⁶⁹

When taking into account the other factors, Judge Chin found that there were not many convincing arguments made in favor of Author's Guild, save for the factor that considers the amount of the original work that is copied.⁷⁰ When considered overall, Judge Chin concluded that Google Books benefits both the public and the authors and publishers. He therefore found a fair use defense in this case would be in line with the principles of copyright.⁷¹

In a separate case with similar facts, Author's Guild brought suit against HathiTrust in 2011, a partnership of major academic research libraries founded in 2008, an offshoot of the Google Books Project.⁷² The main difference between this case and the Google Books case is that HathiTrust is a group of libraries, and their use of the material is presumed to be for nonprofit purposes rather than commercial use.⁷³

Author's Guild, Inc. v. HathiTrust was decided in October 2012, a little earlier than the main Google Books case.⁷⁴ Relying on *Campbell* and the work of Judge Leval, Judge Baer found that the first factor of Section 107 was satisfied in its purpose for scholars and academic research, by protecting those works that still have valid copyrights from being read in full without purchase, and under transformative use, because the new purpose of the copied works was enhanced by search capabilities of the text.⁷⁵ After evaluating the other three factors and concluding that transformative use undermined any favorable factors to the Author's Guild without a transformative use, Judge Baer ruled that HathiTrust served the purposes of copyright to allow the fair use defense to apply in this case.⁷⁶

These two cases show the rapid adoption of the first factor of Section 107, and that if a transformative use is found, that use will determine whether or not a fair

⁶⁸ *Google*, 954 F. Supp. 2d at 291.

⁶⁹ *Id.*

⁷⁰ *Id.* at 291-92 (stating that all books were scanned and reproduced in their entirety, which would normally be concerning, but since Google needed full verbatim scans of the books in order to offer a full-text search of the books, Judge Chin found this to balance the harm of the taking).

⁷¹ *Id.* at 294.

⁷² *HathiTrust*, 902 F. Supp. 2d at 446.

⁷³ See generally *HathiTrust*, 902 F. Supp. 2d at 459; see 17 U.S.C. §107(1) ("factors to be considered shall include - within the purpose and character of the use, whether or not a use is commercial in nature or is for nonprofit educational purposes").

⁷⁴ *HathiTrust*, 902 F. Supp. 2d at 445.

⁷⁵ *Id.* at 459-61.

⁷⁶ *Id.* at 461-64.

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use defense applies in a given case.⁷⁷ Starting with Judge Leval and the adoption of his theory by the Supreme Court, then expanding from the Ninth Circuit into the Second Circuit, this theory is likely to change how fair use is applied from pre-codification precedent and from how the statute suggests it should be applied.

D. Statutory Construction of Section 107: The Basics

The processes of legislative drafting and analysis of statutory language overlap when deciding how to draft new legislation or how to properly interpret codified language.⁷⁸ Central to these processes are the canons of statutory principles applied by judges when reading and interpreting a statute and considered by legislators when drafting new legislation.⁷⁹

These canons are extremely important to keep in mind when interpreting the meaning of any statute, especially in the case of the fair use defense.⁸⁰ The codification in the 1976 Copyright Act of the defense was meant to condense decades of judicial consideration and countless different interpretations into one concept for judicial application across jurisdictions.⁸¹

III. STATUTORY MISCONSTRUCTION: THE PROPAGATION OF TRANSFORMATIVE USE

The current track of the fair use defense, especially following the decisions in *Author's Guild, Inc. v. HathiTrust* and *Author's Guild, Inc. v. Google, Inc.*, is straying too far from the common statutory interpretation canons or principles.⁸² This section will analyze the traditional statutory construction of 17 U.S.C. § 107 and how Congress intended this defense to be applied based on the language itself and the legislative history of the section's drafting. This section will then apply this statutory construction to the *Author's Guild* cases and show how each decision's extension of the Ninth Circuit's interpretation of fair use deviates from the traditional statutory construction of the fair use defense.

⁷⁷ See *Google*, 954 F. Supp. 2d 282; *HathiTrust*, 902 F. Supp. 2d at 459-61; see also *Campbell*, 510 U.S. at 578 (adopting Judge Leval's view of emphasizing the first factor of section 107 more than the other three, if a 'transformative use' justification can be found).

⁷⁸ See generally Yule Kim, *Statutory Interpretation: General Principles and Recent Trends*, CRS REPORT FOR CONGRESS, <http://fas.org/sgp/crs/misc/97-589.pdf> (last updated Aug. 31, 2008); Karl N. Llewellyn, *Remarks on the Theory of Appellate Decision & the Rules or Canons About How Statutes Are to be Constructed*, 3 VAND. L. REV. 395 (1949).

⁷⁹ See Kim, *supra* note 78, at 1-2; Llewellyn, *supra* note 78, at 401-06.

⁸⁰ See Kim, *supra* note 78, at 1-2; Llewellyn, *supra* note 78, at 401-06.

⁸¹ See S. REP. NO. 94-473, at 62 (1975); H.R. REP. NO. 94-1476, at 65-66 (1976).

⁸² See *Google*, 954 F. Supp. 2d 282; *HathiTrust*, 902 F. Supp. 2d at 459-61.

A. *The Codification of Fair Use: Restating Common Law*

Section 107 was created intending to restate the judicial doctrine of the fair use defense at the time that the statute was adopted.⁸³ This codification includes a preamble generally explaining the defense, four factors that judges are urged to consider among others when analyzing a case for fair use, and a caveat regarding the place of unpublished works within the defense.⁸⁴ A traditional statutory construction analysis considers many of the canons and any judge interpreting the meaning of this statute, and how fair use applies to an individual case, should consider these canons as well.⁸⁵

Statutory construction based on the traditional canons emphasizes starting and ending any analysis with the plain language of the statute, especially if that language is unambiguous.⁸⁶ This means that if the language provided can plainly be discerned, then there is no need to turn to the legislative history or Congressional intent for further guidance.⁸⁷ However, if a statute is ambiguously written, or a literal reading would create absurd results, it is common for courts to then look to the legislative history of a document to garner further information on how Congress intended the statute to be interpreted.⁸⁸

For Section 107, the language is unambiguous, even if the application is more difficult to understand.⁸⁹ It states that notwithstanding the provisions of sections of the Act that note the exclusive rights granted to copyright owners, fair use of a specific copyrighted work for the purposes enumerated is not considered to be an infringement of that copyright. These purposes include “criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research.”⁹⁰ The statute then lists four guiding factors that shall be included in any analysis determining if an infringing use may be afforded a fair use defense, which include: the purpose and character of the use, the nature of the copyrighted work, the amount of the portion used in relation to the whole, and the effect of the use upon the potential market or value of the copyrighted work.⁹¹ Finally, the statute ends with a caveat that just because a work is unpublished, that alone will not bar a finding of fair use if a finding can be made based on the four listed factors.⁹² To

⁸³ See S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66.

⁸⁴ 17 U.S.C. § 107.

⁸⁵ See Kim, *supra* note 78, at 1-2; Llewellyn, *supra* note 78, at 401-06.

⁸⁶ See Kim, *supra* note 78, at 2-3; Llewellyn, *supra* note 78, at 403.

⁸⁷ See Kim, *supra* note 78, at 2.

⁸⁸ See Kim *supra* note 78, at 2-4; See also Llewellyn, *supra* note 78, at 403 (giving the counter point to the plain and unambiguous canon that it should not be read as being plain and unambiguous “when literal interpretation would lead to absurd or mischievous consequences or thwart manifest purpose”).

⁸⁹ See Leval, *supra* note 21, at 1105-06.

⁹⁰ 17 U.S.C. § 107.

⁹¹ *Id.* at § 107(1)-(4).

⁹² 17 U.S.C. § 107.

summarize, a plain reading of the statute would say that fair use of a copyrighted work for specific purposes will not be infringement and that the four factors should be used in making that determination.⁹³

The language itself gives no indication as to which of the factors, if any, should weigh more in the analysis. This means all factors should be considered without deference to a specific one.⁹⁴ A plain reading would also support that due to the subjective nature of the factors, every case attempting to bring a fair use defense needs to be decided on its own particular fact pattern because there is no bright-line standard for deciding if something is considered a fair use.⁹⁵ There are some things that may be inferred based on specific words used within the statute.⁹⁶ One example is that because the words “shall include” are used prior to describing the factors for consideration, all four factors should be considered by judges in their analyses, but these are not the only factors that may be considered.⁹⁷ Another example is that because the words “such as” are used before the list of acceptable purposes that may bring a successful fair use defense, it may be inferred that there are other possible acceptable purposes and that the list provided is non-exhaustive.⁹⁸

Considering that the language as interpreted above is unambiguous, and would not lead to absurd results due to its success in American common law for decades prior to codification, this would be a good reading of the language of the statute.⁹⁹ However, because the guidance given in Section 107 is so difficult to apply, despite being plainly stated, a judge would want to look to legislative history for further guidance.¹⁰⁰ While this is always a valid option, the legislative history merely spells out what is obvious from a plain reading of this statute itself.¹⁰¹ The history shows that courts are free to

⁹³ 17 U.S.C. § 107.

⁹⁴ *Id.*

⁹⁵ *Id.*; Accord S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66.

⁹⁶ See Kim, *supra* note 78, at 6-7 (explaining that words that are not defined within the statute or are not terms of art are given their ordinary, dictionary definitions); Llewellyn, *supra* note 78, at 302 (enumerating the canon of statutory construction that claims that words are to be taken in their ordinary meaning unless they are technical or terms of art).

⁹⁷ See 17 U.S.C. § 107; see generally Kim, *supra* note 78; Llewellyn, *supra* note 78.

⁹⁸ See 17 U.S.C. § 107.

⁹⁹ See Kim, *supra* note 78, at 6-7; Llewellyn, *supra* note 78, at 403 (noting that the counterpoints to the traditional statutory construction canons of plain language and ordinary meaning do not really apply in a situation where those interpretation do not cause absurd results that fall outside the purposes of the statute).

¹⁰⁰ See Leval, *supra* note 78, at 1105-06; Llewellyn, *supra* note 78, at 403 (noting the counter point to having plainly stated text is to look to the legislative history for overall meaning of the statute). *Contra* Kim, *supra* note 78, at 2-3 (explaining that the current trend of the Supreme Court is to begin and end analysis of statutes with their plain meaning if discernible, rather than resorting to legislative history).

¹⁰¹ See 17 U.S.C. § 107; S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66.

adapt the doctrine on a case-by-case basis, and that Section 107 was intended to restate the judicial doctrine of fair use as it was developed prior to codification, rather than change, narrow, or enlarge the doctrine in any way.¹⁰² This is all consistent with a traditional statutory construction analysis.¹⁰³

Another traditional statutory construction principle is that a statute should be read as a whole, where each section within is interpreted in a broader statutory context to further the overall purposes of the statute.¹⁰⁴ In the context of the Copyright Act, the statute itself fulfills the part of the United States Constitution that designates the right to Congress to create copyright laws.¹⁰⁵ The Constitution states that Congress has the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”¹⁰⁶ This means that all copyright laws should be written and interpreted with the broad purpose in mind that authors are rewarded for sharing their creativity with the public by having a limited monopoly over exclusive rights that go with the work, such as reproducing and distributing the work.¹⁰⁷ It is a balance between benefitting the public intellectually and rewarding the work and creativity of the authors.¹⁰⁸ Section 107 should be read with this general purpose in mind, which is often acknowledged in opinions where judges are considering the fair use defense.¹⁰⁹ It is important to analyze the defense and the four factors listed in Section 107 in a context that satisfies the core principles of copyright, namely the balance mentioned above.¹¹⁰ Two important canons of statutory construction that play off each other are the idea that every word and clause of a statute must be given effect and that the courts should not add language that Congress has not included.¹¹¹ Statutes should not be construed to

¹⁰² S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66.

¹⁰³ See generally Kim, *supra* note 78; Llewellyn, *supra* note 78, at 401-06.

¹⁰⁴ See Kim, *supra* note 78, at 2-3 (“A statute should be read as a harmonious whole, with its various parts being interpreted within their broader statutory context in a manner that furthers statutory purposes.”); Llewellyn, *supra* note 78, at 302 (including the canon that statutes in *pari materia*, or on the same subject or matter, must be construed together).

¹⁰⁵ U.S. CONST. art. I, § 8, cl. 8.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.*; see Leval, *supra* note 21, at 1107-08; see also 17 U.S.C. § 106 (listing examples of exclusive rights granted to a copyright owner upon the granting of a copyright for a work, including right to make and distribute copies, right to public display, right to sound recordings, etc.).

¹⁰⁸ Leval, *supra* note 21, at 1107-08.

¹⁰⁹ See *Campbell*, 510 U.S. at 575-78.

¹¹⁰ See *Campbell*, 510 U.S. at 575-78 (“Nor may the four statutory factors be treated in isolation, one from another. All are to be explored, and the results weighed together, in light of the purposes of copyright.”); Leval, *supra* note 21, at 1110-11.

¹¹¹ See Kim, *supra* note 78, at 12-13; Llewellyn, *supra* note 78, at 404.

render superfluous any of the language included.¹¹² Similarly, Congress put time and effort into creating a statute and going further to amend it, so the courts should be wary of including and making crucial any new language to the statute.¹¹³ This prevents judges from undermining the authority of Congress and interpreting the laws as they were written, allowing for respect of the drafting process of Congress itself for choosing certain language. A counterargument to this may be that the general rule is contrary to a very prominent and evident meaning that judges feel should be applied, and that judges should be given the leeway to interpret as they see fit to the particular situation in a case.¹¹⁴

Section 107 should include all four factors, even if they are not to be weighed equally by a judge during his or her consideration of a case's individual fair use defense.¹¹⁵ Also, a judge should not add language to what is already given, and, in the case of Section 107, that would mean an additional factor that must always be considered or an additional consideration within a specific factor.¹¹⁶ To commit either one of these actions not only goes against traditional statutory construction principles, but also against the common law foundations of the fair use defense.¹¹⁷

Similarly, another traditional canon is that words and phrases that have received judicial construction before enactment should be understood according to that construction.¹¹⁸ The fair use defense is based off of judicial constructs beginning with those factors and concepts enumerated in *Folsom v. Marsh*.¹¹⁹ The statute and legislative history state that all factors should be considered on a case-by-case basis and provide a list of factors that would be most useful to the majority of analyses.¹²⁰ These basic concepts were used in the common law for decades before being codified. Therefore, in the case of Section 107, the codified construction is what judges should use in their analyses.¹²¹

There are many other canons of statutory construction that may be

¹¹² See Kim, *supra* note 78, at 12-13 (citing *Monclair v. Ramsdell*, 107 U.S. 147, 152 (1883)) ("A basic principle of statutory interpretation is that courts should 'give effect, if possible, to every clause and word of a statute, avoiding, if it may be, any construction which implies that the legislature was ignorant of the meaning of the language it employed.');" Llewellyn, *supra* note 80, at 404.

¹¹³ See Kim, *supra* note 78, at 13.

¹¹⁴ See Llewellyn, *supra* note 78, at 404.

¹¹⁵ See 17 U.S.C. § 107; Kim, *supra* note 78, at 12-13; Llewellyn, *supra* note 78, at 404.

¹¹⁶ 17 U.S.C. § 107; see Kim, *supra* note 78, at 12-13.

¹¹⁷ 17 U.S.C. § 107; see Kim, *supra* note 78, at 12-13; Llewellyn, *supra* note 78, at 404; S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66.

¹¹⁸ See generally Kim, *supra* note 78, at 18 (explaining that if Congress wanted to depart from an established interpretation at common law, it would make it clear not only in the statute but also in its legislative history); see also Llewellyn, *supra* note 78, at 401.

¹¹⁹ 17 U.S.C. § 107. *Folsom*, 9 F. Cas. at 348.

¹²⁰ 17 U.S.C. § 107; S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66.

¹²¹ 17 U.S.C. § 107; S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66.

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observed and applied to Section 107, but do not add substantially more to what has already been discussed.¹²² While this statutory construction is based on a hypothetical reading of the fair use defense, it, like the defense itself, comes to life when applied to a case's fact pattern.

IV. GOOGLE AND HATHITRUST IGNORE STATUTORY CONSTRUCTION

Traditional statutory construction of 17 U.S.C. § 107 lends most credence to a plain reading of the statute supplemented by the legislative intent.¹²³ What is clear from the precedent set in the Ninth Circuit with *Kelly v. Arriba Soft Corp.* and *Perfect 10, Inc. v. Amazon.com, Inc.*, and the expansion of that precedent in New York's Southern District through *Author's Guild, Inc. v. HathiTrust* and *Author's Guild, Inc. v. Google Inc.*, is that the courts are beginning to move away from the traditional statutory construction of Section 107 by focusing heavily on transformative use.¹²⁴ By moving away from this construction, in essence, the Second and Ninth Circuits are moving away from decades of judicial construction of the fair use defense that Section 107 was meant to codify.¹²⁵ The Author's Guild cases use the crutches of increased technology and large public benefits to avoid applying the traditional statutory construction to achieve a particular result.¹²⁶ This comes at the cost of the individual authors and publishing companies retaining profits for their creativity and creates a lack of incentive, all while under the guise of being "in light of the purposes of copyright."¹²⁷ The following contains specific examples of how this focuses on the first factor listed in Section 107, and is based solely on whether an infringing use is transformative or not, that strays away from the traditional statutory construction of the section.

The most obvious canons that are violated here, and that can be considered an overarching theme for other statutory construction principles that are ignored, are that a statute must be analyzed by its plain language and that a statute must be read as a whole with each section striving to achieve an overall purpose.¹²⁸

¹²² See Llewellyn, *supra* note 78, at 401-06.

¹²³ Llewellyn, *supra* note 78, at 403.

¹²⁴ See *Google*, 954 F. Supp. 2d at 290-92; Kim, *supra* note 78, at 2-3; *HathiTrust*, 902 F.Supp.2d at 459-60; *Kelly*, 336 F.3d at 818; *Perfect 10*, 508 F.3d at 1163.

¹²⁵ 17 U.S.C. § 107; see S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66; Leval, *supra* note. 24, at 1106-07, 1111-12; *Campbell*, 510 U.S. at 579.

¹²⁶ See *Google*, 954 F. Supp. 2d at 291-92; *HathiTrust*, 902 F.Supp.2d at 458-64 (finding in both cases that the benefit to the public in general, and the print-disabled public in particular, makes the complete copying of the books and articles a transformative use to a keyword-searchable book database).

¹²⁷ See *Campbell*, 510 U.S. at 578.

¹²⁸ See Kim, *supra* note 78, at 2-3; Llewellyn, *supra* note 78, at 402-03.

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Both *HathiTrust* and *Google* ignore the plain language reading of Section 107 by giving almost all consideration to the first factor and relating back the other three to the fact that the first factor has been found.¹²⁹ In both *HathiTrust* and *Google*, Judges Baer and Chin, after finding that the infringing use was transformative and therefore satisfied the first factor of Section 107, referred back to the first factor and the transformative use when setting out their brief analyses of the other three factors in each case.¹³⁰ The plain reading of the statute infers that each factor should be considered fully and then considered overall to determine if a fair use defense exists.¹³¹ While the judge determines the weight each factor should be given in the analysis, including those factors the judge wishes to consider not enumerated in the statute, it is logical to believe that each factor deserves its own careful contemplation.¹³²

Both cases also ignore the overall purpose of the Copyright Act.¹³³ While Judge Chin specifically mentions that he believes all parties benefit in some way from the Google Books database, he glosses over the harms suffered by the individual authors and publishing companies.¹³⁴ Google took thousands of books, digitized them, kept copies for itself, distributed them in snippets to the public, in full text back to the libraries, all without payment of any kind to the copyright holders.¹³⁵ While this enriches the intellect of the public, it woefully ignores the rights of the authors and publishers who suffered unauthorized copying and distributions of their copyrighted works.¹³⁶

Another canon of statutory construction that both cases disregard is that every word and clause of a statute must be given effect.¹³⁷ As discussed above, *Google* and *HathiTrust* put the most emphasis on finding the first factor, with a determination that a transformative use exists without the other three factors of Section 107.¹³⁸ This makes the other three factors, forged in the common law and then codified to reflect that judicial construction, mere surplusage.¹³⁹ It implies that Congress did not need to bother including the other three factors if courts today only feel the need to briefly run through them once determining there was a transformative use.¹⁴⁰

More specifically to *HathiTrust*, there is another section of the Copyright Act, 17 U.S.C. § 108, that deals with the exceptions to copyright infringement pertaining

¹²⁹ *Google*, 954 F. Supp. 2d at 6-11; *HathiTrust*, 902 F. Supp. 2d at 458-64.

¹³⁰ *Google*, 954 F. Supp. 2d at 6-11; *HathiTrust*, 902 F. Supp. 2d at 458-64.

¹³¹ 17 U.S.C. § 107; Kim, *supra* note 80 at 2-3; Llewellyn, *supra* note 80 at 403.

¹³² 17 U.S.C. § 107. See S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66.

¹³³ Kim, *supra* note 78, at 2-3; Llewellyn, *supra* note 78, at 402-03.

¹³⁴ *Google*, 954 F. Supp. 2d 293-94.

¹³⁵ *Google*, 954 F. Supp. 2d 293-94.

¹³⁶ See U.S. CONST., art. I, § 8, cl. 8.

¹³⁷ Kim, *supra* note 78, at 12-13; Llewellyn, *supra* note 78, at 404.

¹³⁸ 17 U.S.C. § 107; see *Google*, 954 F. Supp. 2d at 290-92; *HathiTrust*, 902 F. Supp. 2d at 458-64.

¹³⁹ Kim, *supra* note 78, at 12-13; Llewellyn, *supra* note 78, at 404.

¹⁴⁰ 17 U.S.C. § 107; Kim, *supra* note 78, at 12-13; Llewellyn, *supra* note 78, at 404.

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to libraries.¹⁴¹ As written, Section 108 gives leeway to fair use defenses if Section 107 is not found to apply, but the fact that Judge Baer completely waived off the argument that Section 108 applied without considering it further almost renders Section 108 as surplusage.¹⁴² If Section 108 never applies because Section 107 supersedes it, even when the allegedly infringing party is a library, no library will ever feel the need to use the protections afforded under Section 108 if they may obtain a defense more easily from Section 107.¹⁴³

More specifically to *Google*, Judge Chin disregards the commercial nature of Google, thus disregarding that an activity having a commercial character, while not dispositive, needs to be weighed with the other factors in the overall consideration.¹⁴⁴ Judge Chin dismisses the commercial purpose of the activity by saying that Google only indirectly profited from the Google Books project and does not weigh that consideration with the others.¹⁴⁵ While it is a hard line to draw, Congress would not have specifically included a provision that a judge should consider the commercial, not-for-profit, or educational character of the use, if it was not meant to factor into the overall analysis. Otherwise, those words would be surplusage.¹⁴⁶

The canon that is often considered with surplusage, that the courts should not add something where Congress has not, also applies to the analysis employed in both *Author's Guild* cases.¹⁴⁷ Both cases added the concept of the transformative use to the first factor in Section 107.¹⁴⁸ Congress amended the language from “the purpose and character of the use” to the language as it currently stands, explicitly adding, “whether such use is of a commercial nature or is for non-profit educational purposes.”¹⁴⁹ There have also been amendments to Section 107 in 1990 and 1992, and further amendments to the Copyright Act in 1998.¹⁵⁰ There was ample time for Congress to consider the ruling of the Supreme Court in *Campbell* and its adoption of Judge Leval’s transformative use in light of the rise of new technology; however, Congress chose to keep the language as it was.¹⁵¹ If Congress wanted transformative use to be the cornerstone of the fair use defense, Congress could

¹⁴¹ See 17 U.S.C. § 108(f)(4) (stating the affirmative defense that libraries may use when a suit for infringement of the exclusive rights of making and distributing copies within the libraries of copyrighted works, and in what situations that defense applies).

¹⁴² *HathiTrust*, 902 F. Supp. 2d at 456-58; see also 17 U.S.C. § 108(f)(4); Kim, *supra* note 78, at 12-13; Llewellyn, *supra* note 78, at 404.

¹⁴³ Kim, *supra* note 78, at 12-13; Llewellyn, *supra* note 78, at 404.

¹⁴⁴ *Google*, 954 F. Supp. 2d. at 291-92; see S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66 (explaining in both legislative histories that all factors need to be weighed somehow in a fair use analysis).

¹⁴⁵ *Google*, 954 F. Supp. 2d at 291-92.

¹⁴⁶ Kim, *supra* note 78, at 12-13; Llewellyn, *supra* note 78, at 404.

¹⁴⁷ Kim, *supra* note 78, at 12-13; Llewellyn, *supra* note 78, at 401.

¹⁴⁸ *HathiTrust*, 902 F. Supp. 2d at 459-61; *Google*, 954 F. Supp. 2d at 291-92.

¹⁴⁹ H.R. REP. NO. 94-1476, at 65-66.

¹⁵⁰ *Id.*

¹⁵¹ H.R. REP. NO. 94-1476, at 65-66.

have made it so, and for the courts to continue to disregard this and add to Section 107 goes against traditional statutory construction principles.¹⁵²

Finally, the fair use defense received considerable judicial construction before the codification of Section 107.¹⁵³ Understanding a statute in light of that common law construction is another canon of traditional statutory construction.¹⁵⁴ Beginning with *Folsom v. Marsh* and continuing through the years, Section 107 is meant to be simply a restatement of all case law that led up to the 1976 Copyright Act regarding the fair use defense.¹⁵⁵ Each application is to be considered on a case-by-case basis and to be analyzed with at least the four factors enumerated within Section 107, because that was the judicial construction of the fair use defense prior to codification.¹⁵⁶ It was only in the last twenty or so years with Judge Leval and the Supreme Court's opinion in *Campbell*, as well as the rapid expansion of the concept by the Ninth Circuit, that transformative use has started to gain judicial popularity.¹⁵⁷ Both *Google* and *HathiTrust* rely heavily on the post-codification construction of the fair use defense that involves transformative use, which is a far cry from the way judges traditionally interpreted the statute.¹⁵⁸

Though these are not the only examples of traditional statutory construction principles that could be applied to these cases, it is clear from this analysis that the adoption of transformative use truly transforms how the fair use defense is applied.¹⁵⁹ It is hard to tell if there will be future expansion of this post-codification construction of Section 107, but what is certain is that it is now too far from the way it should be read by judges and others.¹⁶⁰

V. LEGISLATIVE AND JUDICIAL EXPANSION: SOLUTIONS TO A FAIR USE FAUX PAS

The Southern District of New York's application of the fair use principle, especially its application of the transformative use doctrine, is not something that is accepted across the board and may generate litigation in other jurisdictions over the same issues with varied results. It is clear from this that a clarification of the parts of the Copyright Act that deal directly with the fair use defense would provide the necessary guidance for correct application of the defense. This clarification may come from one of two sources: either the Supreme Court or Congress.

¹⁵² See Llewellyn, *supra* note 78, at 401, 404.

¹⁵³ See generally *Folsom*, 9 F. Cas. at 342.

¹⁵⁴ Llewellyn, *supra* note 78, at 401.

¹⁵⁵ S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66.

¹⁵⁶ 17 U.S.C. § 107; S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66.

¹⁵⁷ Leval, *supra* note 21, at 1111-12; *Campbell*, 510 U.S. at 579; *Kelly*, 336 F.3d at 818; *Perfect 10*, 508 F.3d at 1163.

¹⁵⁸ Leval, *supra* note 21, at 1111-12; *Campbell*, 510 U.S. at 579; *Kelly*, 336 F.3d at 818; *Perfect 10*, 508 F.3d at 1163.

¹⁵⁹ See generally Llewellyn, *supra* note 78.

¹⁶⁰ *Id.* at 401-06.

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The first option would require a case attempting to interpret how the fair use defense applies and the role of the doctrine of transformative use, to be accepted on appeal to the Supreme Court. Both the *HathiTrust* and *Google* decisions are appealable and could possibly escalate to the Second Circuit, and further petitioned to the Supreme Court. It is possible that there is ample case law in other Circuits that could be appealed as well. A recommendation would be for the Supreme Court to conduct a statutory construction analysis to determine how far the fair use defense, and other judicial constructs like transformative use, may go in terms of favoring the public over the authors. A true reading of the statute based on the canons of statutory construction would give credence to an interpretation that current case law is going too far from the purpose of the fair use defense and the overall purpose of the Copyright Act.¹⁶¹ The Ninth Circuit and Southern District of New York's decisions upset the balance that is inherent in the Copyright Clause of the Constitution and the Copyright Act, and that is struck between the needs of the public and the need to provide incentive to authors and creators by favoring the public benefit.¹⁶² A Supreme Court decision would provide a clear and uniform interpretation of the fair use defense to apply across the Circuits, limiting extensive future litigation costs and further confusion regarding Section 107.

The Supreme Court may also be able to combine sections in the Copyright Act. If the Court were to analyze and interpret the relationship between Section 107 and Section 108, then library exception cases such as the *Author's Guild* cases would be easier to decide.¹⁶³ As it is currently written, Section 108 provides an affirmative defense to copyright infringement on the exclusive right of reproduction so long as the infringer is a library or archive, and only a certain number of copies are reproduced for specific purposes.¹⁶⁴ This section was updated to include a defense for digitization of works, but only for purposes of preservation of, or ease of access to, the work.¹⁶⁵ However, the section carves out the fair use defense by stating "nothing in this section in any way affects the right of fair use as provided by Section 107."¹⁶⁶ In light of new technological advances showcased in the *Author's Guild* cases, in particular the *HathiTrust* decision, the most recent amendment to Section 108 is outdated technologically, shifts a court's analysis to section 107, and fails to utilize Section 108.¹⁶⁷ A Supreme Court decision consistent with technological advances that helps to clarify how the two defenses work together would be a good solution to the current problem.

¹⁶¹ U.S. CONST., art. I, § 8, cl. 8; 17 U.S.C. § 107; Llewellyn, *supra* note 80, at 401-06.

¹⁶² *Google*, 954 F. Supp. 2d 293-94; *HathiTrust*, 902 F. Supp. 2d at 459-60; *Kelly*, 336 F.3d at 818; *Perfect 10*, 508 F.3d at 1163.

¹⁶³ *HathiTrust*, 902 F. Supp. 2d at 458-61; *see generally* 17 U.S.C. §§ 107, 108 (stating that section 108 is not meant to interfere with any rights or defenses provided in section 107 as currently written).

¹⁶⁴ 17 U.S.C. § 108.

¹⁶⁵ *Id.* § 108(b)(2), (c)(2).

¹⁶⁶ *Id.* § 108(f)(4).

¹⁶⁷ 17 U.S.C. §§ 107, 108; *HathiTrust*, 902 F. Supp. 2d at 458-61.

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Another option would be one of several legislative solutions, which include amending the current Copyright Act and clarifying Section 107, Section 108, or both, to allow for a clearer application of the fair use defense to internet-based works. This option, regardless of what sections are amended, is more likely than consideration by the Supreme Court.

An amendment to Section 107 should consider the current language before and after the four factors enumerated for judicial consideration.¹⁶⁸ Language that would be most effective in clarifying the present problems with the interpretation of the fair use defense would have to explain how much weight should be given to any one factor listed in the statute for consideration, and may even include an acceptable interpretation of transformative use.¹⁶⁹ An amendment to Section 108 would need to be directed at the amount of copies and the purposes for which a library may digitize copyrighted works within its collection.¹⁷⁰ This would address cases like *HathiTrust* more directly, and if amended in a way that considers the advancement of technology where digitization is concerned, Section 108 could be properly used in conjunction with the fair use defense.¹⁷¹ An amendment to both sections would allow for cases like the *Author's Guild* decisions to be analyzed and ruled on with no doubt as to the Congressional intent behind the statute and how it should be applied in situations with commercial entities in opposition to nonprofit libraries.

VI. CONCLUSION

It is unclear from the most recent opinions in *Author's Guild, Inc. v. HathiTrust* and *Author's Guild, Inc. v. Google, Inc.*, whether any issues will be appealed and whether the courts will consider this issue of transformative use within the scope of the fair use defense. The question remains whether these recent changes signify a permanent shift in the state of this area of copyright law or if they are merely a fluke that will be corrected by any or all of the recommendations listed above. This interpretation does not comply with traditional statutory construction principles. It is discomfoting that both the established case law and more recent developing precedent only 25 years after codification, can rapidly change without Congressional input as to the original intent of the Act. One can only hope that some sort of solution in the form of Congressional or Supreme Court intervention will arrive to clear up and refocus the appropriate construction for Section 10.

¹⁶⁸ 17 U.S.C. § 107.

¹⁶⁹ S. REP. NO. 94-473, at 62; H.R. REP. NO. 94-1476, at 65-66.

¹⁷⁰ 17 U.S.C. § 108(b)(2), (c)(2).

¹⁷¹ *HathiTrust*, 902 F. Supp. 2d at 456-58.

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Essay

**Wide Right:
How ISP Immunity and Current Laws Are Off the Mark
in
Protecting the Modern Athlete on Social Media**

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Abstract

“[Y]our tranny looking dad is a disgrace to American football,” “I would rape the shit out of her,” and “[The] [B]ears are easier than you on prom night,”¹ are just a sampling of some of the alarmingly harassing tweets received by Chloe Trestman between the night of November 9, 2014 and November 10, 2014. Who is Chloe Trestman, and what could she have possibly done to warrant such abuse? Chloe’s father is Marc Trestman, the head coach of the Chicago Bears. And the twitter vitriol, or “twitriol,” directed toward Chloe was in response to the Bears’ blowout loss to their longtime rivals, the Green Bay Packers, 55-14 on Sunday Night Football. So the question remains, what did Chloe do to garner such an abusive reaction from the disgruntled Chicago fan-base?

The answer, of course, is she did nothing to deserve this hate-inspired tweeter tirade, other than being the daughter of an NFL head coach and having a twitter account. In this generation of Facebook, Twitter and other social media outlets, it is commonplace for athletes, and unfortunately sometimes their family members, to become targets of harassing online misconduct and abuse. Arguably more alarming than the harassing component of social media websites, is the fact that the current laws governing Internet Service Providers lack the necessary teeth to provide any recourse to athletes victimized by online misconduct, which only perpetuates this type of behavior and leaves no recourse for the injured party. So Coach Trestman, Chloe Trestman and mostly any other internet targeted athlete are left with no legal remedy until the vast safeguards protecting ISPs are curtailed.

¹ Samer Kalaf, *Twitter Users Harass Marc Trestman's Daughters After Bears Loss*, Deadspin (Nov. 10, 2014), <http://deadspin.com/twitter-users-harass-marc-trestmans-daughters-after-bea-1657009542>.

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“The fact that broadcasters, media people and athletes are allowed to tweet, which should be against the law, is a big change, okay. It should be against the law, all right, because nobody needs to hear from any one of them.”²

– Mike Francesa

² Tom Weir, *WFAN's Mike Francesa Wants to Make Twitter Illegal*, USA TODAY (May 15, 2012), <http://content.usatoday.com/communities/gameon/post/2012/05/wfans-mike-francesa-wants-to-make-twitter-illegal/1#.UXhmTrVJOVV>.

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Legendary New York sports radio talk show host Mike Francesa is right in that athletic tweets can be problematic. Due to their celebrity status, athletes are easy targets for social media “trolls,” or people who regularly and anonymously post offensive insults on social media sites.³ While some of the negative content constitutes free speech, there are many instances when the third party’s conduct exceeds the First Amendment’s scope of protection, and quite often constitutes cyber harassment.⁴

Few, if any, laws provide athletes with meaningful recourse. Under the current law, individual social media sites and other Internet Service Providers (ISPs) are immune from liability for their users’ behavior by the legislative safeguards granted to ISPs through the Communications Decency Act (CDA) and the Digital Millennium Copyright Act (DMCA).⁵ As recent incidents illustrate, the consequences of athletic cyber harassment yield great damages.⁶

The consequence of damages is complicated by the anonymous nature of social media and the strong business presence of the sports industry in the United States and throughout the world. This makes athletes some of the most popular and influential people in the country, which renders them vulnerable targets for Internet misconduct by way of social media sites. Society’s iconography of athletes increases the potential for damages resulting from public humiliation via social media. According to a recent article by Lee Gordon, the Barna Group reports that, “Americans believe that professional athletes have a bigger influence on their lives than pastors by more than a three-to-one margin.”⁷ Just consider the 20.5 million Twitter followers of LeBron James to the 5.9 million followers of Pope Francis.⁸

The combination of America’s infatuation with athletes and ease of fan-athlete communication on social media can be volatile. Despite every effort that is made to limit athletes’ use of social media to avoid precarious situations that will reflect poorly on the athlete and the team, league or university, athletes still find themselves frequently in trouble due to their availability to the public on such sites

³ Erik Brady & Jorge L. Ortiz, *For Athletes, Social Media Not All Fun and Games*, USA TODAY (July 31, 2013), <http://www.usatoday.com/story/sports/2013/07/31/for-athletes-social-media-not-all-fun-and-games/2606829/>.

⁴ *Id.* (example of how tennis professional and “U.S. Fed Cup team member Varvara Lepchenko found a message on her Facebook page at Wimbledon telling her that if she didn’t lose her first-round match in London she wouldn’t live”).

⁵ Communications Decency Act 47 U.S.C. § 230 (2012); Digital Millennium Copyright Act 17 U.S.C. § 512 (2012).

⁶ See *infra* Part I (the Manti Te’o and Randall Goforth situations discussed within this article).

⁷ Lee Gordon, *Think Before You Tweet: Social Media Lessons for Athletes*, STACK (Feb. 22, 2013), <http://www.stack.com/2013/02/22/twitter-for-athletes>.

⁸ @KingJames, TWITTER, <https://twitter.com/KingJames> (last visited April 19, 2015); @Pontifex, TWITTER, <https://twitter.com/Pontifex/followers> (last visited April 19, 2015).

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as Facebook and Twitter. Under the current set of laws, there is no remedy for athletes victimized through social media misconduct.

This article will highlight the vulnerability of national athletes through their use of social media and will discuss the lack of remedies available due to the legislative and judicial confines of Free Speech and the current applicable laws. The article proceeds in four parts. Part I provides a narrative of two recent social media debacles: the Manti Te'o catfishing controversy and the Randall Goforth fake Twitter account prank. This section uses the Te'o and Goforth situations to illustrate how high profile athletes can become victims of Internet misconduct through the use of social media.

Part II outlines the current safeguards that prevent Te'o, Goforth and other similarly situated athletes from recovering damages suffered through social media sites or other ISPs. Specifically, this section will address the immunities granted to ISPs through the CDA, the DMCA, and explain how the Supreme Court and other federal courts have expanded Congressional immunity granted to ISPs.

Part III analyzes the cyber harassment aspect of these two incidents, while Part IV describes the collective limitations of the CDA, the DMCA, and the current harassment laws as means to provide relief for online harassment. This last section illustrates the reason Te'o and Goforth are likely to fail should they proceed with their actions against Facebook and Twitter, respectively. This article concludes by arguing that the current laws do not offer adequate relief for Te'o, Goforth and other similarly situated athletes. In fact, these laws actually contribute to social media misconduct by immunizing social media sites from repercussions from this type of conduct.

I. OPENING DRIVE: SOCIAL MEDIA'S NEGATIVE IMPACT ON ATHLETES

Both the Manti Te'o fake girlfriend hoax, which broke in early January 2013, and the Randall Goforth fake Twitter account incident, which occurred at the end of the 2012 NCAA football season, illustrate how social media sites can make athletes, through little or no fault of their own, easy targets for harmful online activity. Although the specific details differ, both cases share the important similarities of garnering an incredible amount of media coverage and displaying the dangerous side of social media for athletes. Both instances serve as examples that support the need for accountability of ISPs when social media leads to emotional injury, loss of anticipated business, and other possible damages.

A. (Cat)fishing for Manti

Manti Te'o at 6'5" and 250lbs, was Notre Dame's All-American inside linebacker who played in all 38 games during his four-year career and started in 36

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of them, including 35 consecutive contests for the Fighting Irish.⁹ Te'o was one of the most highly regarded and most decorated defensive players, not only to come out of Notre Dame in recent years, but in college football history.¹⁰ Prior to January 2013, his name was synonymous with winning, strong character, leadership, and potential.

Te'o's journey was one of the feel-good college stories emerging out of the 2012 season. His exceptional play anchored the revitalized Notre Dame defense that paced the Fighting Irish to a 12-0 record, which earned the storied university a spot in the 2013 Bowl Championship Series title game to compete for its first National Championship since 1988.¹¹ He was heralded for how well he was able to perform on the field after losing both his grandmother and his girlfriend, Lennay Kekua, who lost a battle to leukemia, within hours of each other during the season in September 2012.¹² Te'o's stellar play, coupled with his tragic personal loss, propelled him into the running for the Heisman Trophy, which is awarded by a vote to the most outstanding college player of the season. Although Te'o would finish second in the Heisman Trophy balloting, his professional career appeared to be bright as he was considered a highly touted prospect coming out of college and believed to be a high first round draft selection in the upcoming 2013 NFL Draft.¹³ Te'o's personal and professional life were both compromised, however, when the website Deadspin published an article stating that his late girlfriend never existed.¹⁴

Notre Dame claimed in a statement that Te'o was a victim of an elaborate "hoax," known as catfishing,¹⁵ in which someone used the fictitious name Lennay Kekua in order to establish a relationship with him and later conspired with others to convince Te'o that she had tragically died of leukemia.¹⁶ Te'o released a

⁹ *Manti Te'o*, THE OFFICIAL SITE OF NOTRE DAME'S ATHLETICS: FOOTBALL, http://www.und.com/sports/m-footbl/mtt/teo_manti00.html (last visited May 2, 2013).

¹⁰ *Id.*

¹¹ *Manti Te'o-Biography*, THE BIOGRAPHY.COM, <http://www.biography.com/people/manti-teo-21105315?page=1> (last visited May 2, 2012) (hereinafter "Manti Te'o-Biography").

¹² Steve Eder, *Hoax Is Revealed as Irish Star Says He Was Duped*, N.Y. TIMES (Jan. 16, 2013), http://www.nytimes.com/2013/01/17/sports/ncaaf-football/story-of-manti-teos-girlfriend-is-said-to-be-a-hoax.html?_r=0&adxnnl=1&adxnnlx=1367524036-s7Qzmqj65fhVnlshsZd8BNA.

¹³ Manti Te'o-Biography, *supra* note 11; see Matt Hayes, *BCS National Championship Game: Alabama vs. Notre Dame Analysis*, SPORTING NEWS (Dec. 14, 2012), <http://www.sportingnews.com/ncaa-football/story/2012-12-14/bcs-national-championship-game-2013-alabama-vs-notre-dame-nick-saban>.

¹⁴ Eder, *Hoax*, *supra* note 12.

¹⁵ See generally Mary Pilon, *In Te'o Story, Deception Ripped from the Screen*, N.Y. TIMES (Jan. 17, 2013), http://www.nytimes.com/2013/01/18/sports/ncaaf-football/deception-ripped-from-the-screen-in-hoax-story-of-manti-teo.html?_r=0 (explaining the origins of the "catfishing" phenomenon).

¹⁶ Eder, *Hoax*, *supra* note 12.

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statement of his own, admitting that he was the target of “what was apparently someone’s sick joke and constant lies.”¹⁷ But as more facts became public, the more twisted the story became, lending credence to what many media outlets’ labeled as, “one of the most bizarre stories to surface in the sports world in a long time.”¹⁸

Despite the claims from Te’o and Notre Dame that depicted him as nothing more than a sympathetic victim in this peculiar story, some of the facts have left many questioning if he was a willing participant in this fraud, hoping that the tragic story would garner sympathy from the public and voters alike, in an effort to bolster his resume for the Heisman Trophy.¹⁹ On December 8, 2012 (two days after receiving the chilling call from Kekua’s phone, which left him questioning her death and identity), at the Heisman Trophy ceremony, Te’o stated that the most unforgettable moment of the 2012 season was the moment he found out his girlfriend had died.²⁰ Although he has maintained his innocence in the hoax, Te’o did admit during his interview with ESPN that he tailored the story to lead people to believe that he had actually met Kekua in person before her death, out of embarrassment of people knowing it was strictly an online relationship.²¹

From the time the rumblings surrounding the hoax began to surface at the end of December 2012, a downward spiral was set in motion for Te’o’s professional career.²² He had a poor performance in the BCS National Championship Game in early January 2013²³ and was later underwhelming at the 2013 NFL combine in Indianapolis.²⁴ His misfortune continued in April 2013 when he was selected with

¹⁷ Eder, *Hoax*, *supra* note 12.

¹⁸ Manti Te’o-Biography, *supra* note 11.

¹⁹ Steve Eder, *Image Becomes a Puzzle as Theories on Te’o Swirl*, N.Y. TIMES (Jan. 17, 2013), <http://www.nytimes.com/2013/01/18/sports/ncaafotball/image-of-manti-teo-becomes-puzzle-as-theories-swirl.html?pagewanted=all&module=Search&mabReward=relbias%3As>.

²⁰ Eder, *Te’o Answers Questions but Doesn’t Settle Riddle*, N.Y. TIMES (Jan. 20, 2013), http://www.nytimes.com/2013/01/21/sports/ncaafotball/teos-espn-interview-has-answers-but-doesnt-settle-riddle.html?module=Search&mabReward=relbias%3As&_r=0.

²¹ *Id.*

²² Eder, *Te’o Answers*, *supra* note 20.

²³ Tim Rohan, *Te’o’s Draft Stock Tumbled When Irish Did*, N.Y. TIMES (Jan. 9, 2013), <http://www.nytimes.com/2013/01/09/sports/ncaafotball/manti-teos-draft-stock-tumbled-when-irish-did.html>.

²⁴ Mike Florio, *Te’o Blames Slow 40 Time on Combine Stress*, PRO FOOTBALL TALK (Feb. 25, 2013, 9:21 PM), <http://profootballtalk.nbcsports.com/2013/02/25/teo-blames-slow-40-time-on-combine-stress> (Te’o ran a 4.82-second 40-yard dash at the NFL scouting, which is considered slow for an NFL linebacker).

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the thirty-eighth pick, the sixth pick of the second round and the third linebacker taken overall, in the 2013 NFL Draft.²⁵

Te'o, who entered the 2013 championship game as a highly regarded first round draft pick talent, dropped to the second round after his poor performance in the championship game and his sub-par forty time. Two team officials from different NFL clubs expressed to ESPN after the draft that their respective teams passed up on Te'o due to his "off the field issues" as well.²⁶ It appears as though the fake girlfriend hoax not only embarrassed Te'o on a national level and tarnished his reputation, but it may have cost him the prestige and money that accompany a first round draft pick. Even Te'o was quoted as saying that he expected himself to be a first round draft pick, but he realized that "things happened" and vowed that his misfortunes would only give him more motivation going forward.²⁷ The damage to Te'o's reputation and professional career has already been done.

B. Will @TheRealRandallGoforth Please Tweet Back?

Although far less convoluted than the Manti Te'o saga, Randall Goforth's situation was no less serious. Sometime in late October 2012, it appeared as though, innocently enough, Randall Goforth, University of California, Los Angeles' (UCLA) then Freshmen punt returner and defensive back, set up a Twitter account under the handle @RandallG3000.²⁸ The problem was that it was not Goforth at all, but an unknown perpetrator.²⁹ And it did not take long for this undercover prankster to heat up the already deep seeded football rivalry between UCLA and University of Southern California (USC) sending both fan bases and players alike into a twitter frenzy.

While the Twitter war raged on between the two college football powerhouses, the actual Randall Goforth was left completely in the dark because, according to Coach Jim Mora, Goforth was in a tutoring session when the "idiot" was out there tweeting.³⁰ At the time of the incident, Goforth himself did not even have a Twitter account and he later informed the Los Angeles Times that he would

²⁵ *Chargers Draft LB Manti Te'o*, ESPN.COM NEWS (April 27, 2013), http://espn.go.com/nfl/draft2013/story/_/id/9215985/2013-nfl-draft-san-diego-chargers-select-manti-teo-sixth-pick-second-round.

²⁶ *Id.*

²⁷ *Chargers Draft*, *supra* note 25.

²⁸ Paul Myerberg, *Fake Twitter Account has UCLA's Jim Mora Steaming Mad*, USA TODAY (Nov. 6, 2012), <http://www.usatoday.com/story/gameon/2012/11/06/jim-mora-ucla-fake-twitter/1687763/>.

²⁹ *Id.*

³⁰ *Id.*

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not dare talk like that as a freshmen.³¹ Whatever Goforth would not say, however, @RandallG3000 had no problem tweeting. On November 5, 2012, the imposter infuriated the Trojan fan base, including some members of the USC football squad, when he boisterously tweeted, “[W]e will beat you guys on Nov. 17. Believe the hype.”³² After a series of exchanges between USC fans and @RandallG3000, the fake Goforth further enraged the USC faithful by claiming, “USC SUCKS!! WE WILL GET IT IN NOVEMBER 17. ALL ABOUT ACTION NO NEED TO BRAG JUST BE TUNED IN ON THE 17TH!!!!”³³

Quickly, the real Goforth’s UCLA teammates came to his defense alerting the Twitter community that this was someone impersonating Goforth and nothing more.³⁴ The backlash even prompted Mora to contact then USC head coach Lane Kiffin to explain that this was just a hoax.³⁵ Mora was visibly livid when he spoke to the media about the whole situation, noting that the “[p]ower of social media is amazing and when it's used in a negative way like that, it's sickening.”³⁶ He labeled the imposter a “coward” and challenged whomever it was to reveal his true identity, but Mora noted this would never happen because “[t]hat’s what cowards do. Cowards hide behind print...”³⁷

Mora, however, continued in his criticism of the Goforth impersonator claiming that this individual was “the lowest form of life form if you would portray yourself as an 18-year-old young man who's out here trying to do his best...I think he ought to go to jail. That's how I feel. I think you're a scumbag.”³⁸ Although Mora’s comments were rife with emotion, he does unearth a serious problem associated with the type of social media behavior experienced by Goforth, which is the near impossible task of discovering who should be held accountable for Goforth’s harm when the actual attacker remains anonymous. Unfortunately for Goforth, due to the current structure of our laws, Twitter would remain free from liability despite the fact that it was the vehicle chosen to perpetrate the unauthorized online impersonation - essentially offering no remedy to Goforth.

The circumstances surrounding Te’o and Goforth are uniquely different, but the natures of the indiscretions are the same. Both men were targeted because of their high profile statuses as NCAA college football players for major programs at

³¹ Ron Dicker, *Randall Goforth Impersonator Starts Twitter War Between USC, UCLA*, THE HUFFINGTON POST (Nov. 7, 2012), http://www.huffingtonpost.com/2012/11/07/randall-goforth-impersonator-twitter-usc-ucla-mora_n_2088357.html.

³² Myerberg, *supra* note 28.

³³ *Id.*

³⁴ *Id.*

³⁵ Dicker, *supra* note 31.

³⁶ Myerberg, *supra* note 28.

³⁷ *Id.*

³⁸ Myerberg, *supra* note 28.

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Notre Dame and UCLA, and social media provided the platform allowing these athletes to be easily perpetrated. Only compounding the problem for Te'o and Goforth (and other similarly situated athletes) is the fact that any attempt at legal recourse against the ISPs in question, will likely be a futile exercise under today's Internet regulations and laws to online activity. This is alarming because not only are ISPs protected from liability for their users' tortious conduct, but also there is no deterrent for similar misconduct in the future under the current governing laws.

II. PROTECTING THE QUARTERBACK: ISP SAFEGUARDS AND THEIR IMMUNITY FROM TORTIOUS INTERNET ACTIVITY

Congress has protected ISPs by providing immunity from defamatory or tortious material published by their users through the CDA and the DMCA. Congress determined that holding ISPs liable for legal issues created by their subscribers was not in the public's best interest³⁹ and passed the CDA and the DMCA in an effort to protect the ISPs from liability.⁴⁰ These acts render ISPs immune from tort-based claims stemming from a third party's activity.⁴¹ ISP immunity from tortious conduct has only been expanded through the case law governing the CDA and DMCA.

A. *The Two Blocks of Granite: Legislative Safeguards*

This section will discuss both the CDA and the DMCA in depth. It will then explain how the higher courts, through precedent, have expanded the already broad ISP safeguards. The combined ramifications of the Acts, along with the case law, renders ISPs nearly invincible to litigation arising from the conduct of their users.

i. *The Communications Decency Act*

Congress enacted the CDA in 1996, which paved the way for the preferential treatment afforded to ISPs in regards to user liability.⁴² At the heart of the Act is Section 230, which offers ISPs immunity from third party liability.⁴³ Section 230(c)(1) of the CDA establishes a general standard in regard to all ISPs providing that "no provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider."⁴⁴ The Act defines an "information content provider" as a "person or entity that is responsible, in whole or in part, for the creation or development of information provided through the Internet or any other interactive computer

³⁹ Cyrus Sarosh Jan Manekshaw, *Liability of Isps: Immunity from Liability Under the Digital Millennium Copyright Act and the Communications Decency Act*, 10 COMPUTER L. REV. & TECH. J. 101, 102 (2005).

⁴⁰ *Id.* at 102.

⁴¹ *Id.* at 109.

⁴² *Id.* at 106.

⁴³ 47 U.S.C. § 230.

⁴⁴ *Id.*

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service.”⁴⁵ Whereas Section 230(f)(2) defines an “interactive computer service” as any interactive service system or provider that “enables computer access by multiple users to a computer server, including specifically a service or system that provides access to the Internet and such systems operated or services offered by libraries or educational institutions.”⁴⁶

The distinction between an “interactive computer service” and an “information content provider” is a crucial one under Section 230(c)(1), as any ISP labeled an “interactive computer service” is free from liability for another’s content.⁴⁷ Courts have referred to Section 230(c)(2), specifically, as the “Good Samaritan” provision of the CDA, despite the whole (c) subsection being entitled “Protection for ‘Good Samaritan’ blocking and screening of offensive material.”⁴⁸ The “Good Samaritan” provision, Section 230(c)(2)(A), specifically limits civil liability for any provider or user of interactive computer service on account of “[a]ny action voluntarily taken in good faith to restrict access to or availability of material that the provider or user considers to be obscene, lewd, lascivious, filthy, excessively violent, harassing, or otherwise objectionable, whether or not such material is constitutionally protected.”⁴⁹

Congress made sure to address the issue of preemption in Section 230(e)(3) of the CDA in an effort to curtail the challenge-ability of the Act. This Section declares that “[n]o cause of action may be brought and no liability may be imposed under any State or local law that is inconsistent with this section.”⁵⁰ Despite the wide-ranging immunity bestowed upon ISPs through Section 230, it is important to note that the CDA is not absolute.⁵¹

Section 230(e), which discusses the effect the Act has on other laws, highlights the act’s weakness.⁵² According to Section 230(e)(1): “Nothing in this section shall be construed to impair the enforcement of” specific laws pertaining to obscenity or relating to the sexual exploitation of children or “any other Federal criminal statute.”⁵³ Through its language this Section also appears to exempt intellectual

⁴⁵ 47 U.S.C. § 230.

⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ See Claudia G. Catalano, Annotation, *Validity, Construction, and Application of Immunity Provisions of Communications Decency Act*, 52 A.L.R. Fed. 2d 37 (2011).

⁴⁹ 47 U.S.C. § 230

⁵⁰ 47 U.S.C. § 230

⁵¹ Manekshaw, *supra* note 39, at 108.

⁵² 47 U.S.C. § 230.

⁵³ *Id.*

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property from the CDA since “[n]othing in this section shall be construed to limit or expand any law pertaining to intellectual property.”⁵⁴

The courts seem to struggle with interpreting the application of the limitation involving intellectual property law.⁵⁵ Depending on the circumstances of the case, courts have been split when deciding if the limitation did or did not apply to claims arising under state and federal law.⁵⁶ Despite the intellectual property limitation to the Act, it is evident that Congress’ intent, which has been expounded by the case law, was to restrict government interference and to extend immunity from liability to ISPs for third party activity.⁵⁷

Another peculiarity of the CDA is located in Section 230(b), which discusses the policy concerns of the Act. Section 230(b)(5) proclaims that it is the United States’ policy to “ensure vigorous enforcement of Federal criminal laws to deter and punish trafficking in obscenity, stalking, and harassment by means of computer.”⁵⁸ If this was truly a priority for Congress, then it seems almost counterproductive to grant such indiscriminate and extensive immunity to all ISPs who can meet the requirements to be labeled as an interactive computer service. However, instead of limiting Section 230’s safeguard protections, Congress only further broadened the immunity enjoyed by ISPs by virtue of the DMCA.

ii. *The Digital Millennium Copyright Act*

The DMCA improved the shortcomings of the CDA while making the immunity power enjoyed by ISPs even more expansive. Congress passed the Digital Millennium Copyright Act in 1998, amid much controversy, with the purpose of adapting copyright law to the digital age.⁵⁹ The Act consists of two crucial, and sometimes conflicting, goals: “promoting the continued growth and development of electronic commerce and protecting intellectual property rights.”⁶⁰

Section 512 of the DMCA offers ISPs a “safe harbor” or immunity from liability stemming from claims of copyright infringement,⁶¹ an area that was left vulnerable under Section 230 of the CDA.⁶² Section 512(b)(1) limits service providers’ liability for copyright infringement “by reason of the intermediate and temporary storage of

⁵⁴ 47 U.S.C. § 230.

⁵⁵ Catalano, *supra* note 48.

⁵⁶ *Id.*

⁵⁷ Manekshaw, *supra* note 39, at 114.

⁵⁸ 47 U.S.C. § 230.

⁵⁹ Amy P. Bunk, Annotation, *Validity, Construction, and Application of Digital Millennium Copyright Act*, 179 A.L.R. Fed. 319 (2002).

⁶⁰ H.R. REP. NO. 105-551, pt. 2, at 23 (1998).

⁶¹ Digital Millennium Copyright Act (DMCA) of 1998, 17 U.S.C. § 512 (2012).

⁶² Jillian Bluestone, *La Russa's Loophole: Trademark Infringement Lawsuits and Social Networks*, 17 VILL. SPORTS & ENT. L.J. 573, 581 (2010).

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material on a system or network controlled or operated by or for the service provider.”⁶³ The infringing material must: 1) be made available online by someone other than the service provider; 2) be transmitted by that person to a third person via the service provider’s network; and 3) be stored and transmitted through “an automatic technical process for the purpose of making the material available to users of the system or network” who can request to access the material from the person who made it available online.⁶⁴

The DMCA does not provide blanket immunity to all ISPs for infringing material posted on their networks, but rather qualifies only certain providers when specific conditions are met.⁶⁵ In order for a provider to qualify for a Section 512 safe harbor, the provider must:

(a)[Adopt] and reasonably [implement], and [inform] subscribers and account holders of the service provider's system or network of, a policy that provides for termination in appropriate circumstances of subscribers and account holders of the service provider's system or network who are repeat infringers; and (b)[accommodate] and does not interfere with standard technical measures.⁶⁶

Even though the DMCA allows for the service providers to follow these guidelines reasonably, as opposed to strictly, there are limitations for the safe harbor provision of the Act.⁶⁷ An ISP can lose its safe harbor protection when it has actual knowledge or should have had constructive knowledge of the infringement.⁶⁸ The safe harbor can also be limited when a service provider, upon obtaining an infringing activity, does not “[act] expeditiously to remove, or disable access to, the material.”⁶⁹ Therefore, in order for an ISP to enjoy the safe harbor provided by the DMCA, the service provider must advertise a policy against copyright infringements and make a realistic threat of shutting down account access to those who go against the policy.⁷⁰

B. The Expansion of the CDA and the DMCA Through the Courts

Through their interpretations of the CDA and the DMCA, the federal courts have broadened the Act’s already far-reaching authority to the point where it appears as though there is no remedy available for a victim of social media

⁶³ 17 U.S.C. § 512.

⁶⁴ *Id.*

⁶⁵ 17 U.S.C. § 512.

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ 17 U.S.C. § 512.

⁷⁰ Bluestone, *supra* note 62, at 582.

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misconduct. It is evident that at the time, the federal courts chose to protect ISPs from user misconduct as opposed to holding them accountable for such actions on their Internet platforms. The cases that followed resulted in the pivotal precedent that has shaped the landscape of ISP immunity as it is today.

The landmark case of *Zeran v. America Online* tested the immunity power of Section 230 of the CDA.⁷¹ In *Zeran*, the Fourth Circuit held that the CDA barred the plaintiff's liability claims against AOL alleging that the company "unreasonably delayed in removing defamatory messages posted by an unidentified third party, refused to post retractions of those messages, and failed to screen for similar postings thereafter."⁷² The court emphasized that Congress' intent for Section 230 was to restrict governmental interference and allow the Internet to police itself.⁷³

The Fourth Circuit continued to interpret Congressional intent in *Zeran* by finding that the purpose behind statutory immunity was "not difficult to discern," and that Congress made a "policy choice" not to "deter harmful online speech through the separate route of imposing tort liability on companies that serve as intermediaries for other parties' potentially injurious messages."⁷⁴ This case was decided in 1997 and the court then acknowledged that an ISP such as AOL was dealing with users in the millions and the amount of information communicated via interactive computer services was staggering.⁷⁵ According to the Fourth Circuit, Congress believed that if ISPs were faced with liability claims for each message republished by their services, the service providers would be forced to restrict the number of users and messages posted, which would have a "chilling effect" on the freedom of internet speech.⁷⁶ As a result, Congress chose to immunize ISPs to avoid such a restrictive result.⁷⁷

In the 1998 case of *Blumenthal v. Drudge*, the D.C. Circuit expanded on the immunities provided to ISPs via the CDA and the *Zeran* decision.⁷⁸ The Blumenthals, a husband and wife, were White House Employees who brought a defamation action against defendant, Matt Drudge, an online columnist, and AOL for disseminating the defamatory content.⁷⁹ AOL had entered into a one year licensing agreement with Drudge making the Drudge Report available to all AOL members in exchange for a \$3,000 monthly "royalty payment" to Drudge.⁸⁰ Under

⁷¹ Bluestone, *supra* note 62, at 582.

⁷² *Zeran v. Am. Online, Inc.* 129 F.3d 327, 327 (4th Cir. 1997).

⁷³ *Id.* at 327, 330.

⁷⁴ *Id.* at 330-31.

⁷⁵ *Id.* at 331.

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ Bluestone, *supra* note 62, at 582.

⁷⁹ *Blumenthal v. Drudge*, 992 F. Supp. 44, 47 (D.D.C. 1998).

⁸⁰ *Id.* at 47.

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the agreement, Drudge was able to “create, edit, update and ‘otherwise manage’ the content of the Drudge Report” while AOL maintained the right to remove content that it “reasonably determined” was in violation of AOL's then standard terms of service.⁸¹

In formulating its decision, the D.C. Circuit used the principals outlined in *Zeran* to begrudgingly conclude that AOL was immune from suit in this case despite the fact that Drudge was an AOL employee and was operating in his employment capacity.⁸² This ruling was a display of great deference to the *Zeran* decision since the D.C. Circuit ruled in this manner even though the court believed that AOL had taken “advantage of all the benefits conferred by Congress in the Communications Decency Act, and then some, without accepting any of the burdens that Congress intended.”⁸³ *Blumenthal* would be only one of several cases to cite *Zeran* as authority, which reaffirmed the findings of the *Zeran* court.⁸⁴

In 2001, the Southern District of New York decided *Gucci Am., Inc. v. Hall & Assoc.*, in which Gucci brought a trademark infringement claim against a website operator and the ISP which was hosting the operator's website.⁸⁵ Here, the court affirmed that the CDA does not provide immunity for trademark infringement claims against ISPs.⁸⁶ The impact of this decision gave rise to several claims that triggered DMCA safe harbor protection.⁸⁷

The first notable case in this category was *Hendrickson v. eBay*, which was decided in 2001.⁸⁸ The plaintiff was the owner of a copyright in a motion picture and brought this infringement action against eBay, the online auction service, which had listed offers to sell the alleged infringing copies of the film.⁸⁹ The court applied a narrow interpretation of the DMCA in determining whether an ISP qualified for safe harbor protection and found that a service provider cannot lose its immunity when it engages in conduct specifically required by the DMCA.⁹⁰

The conduct specifically required by the DMCA at issue in *Hendrickson* is the requirement for an ISP to remove or block access to materials posted on its system once it has been notified of a claimed infringement.⁹¹ Upon receiving notice of the

⁸¹ *Blumenthal*, 992 F. Supp. at 47.

⁸² *Id.* at 51-52.

⁸³ *Id.* at 52-53.

⁸⁴ *Bluestone*, *supra* note 62, at 582-83.

⁸⁵ *Gucci Am., Inc. v. Hall & Assoc.*, 135 F. Supp. 2d 409 (S.D.N.Y. 2001).

⁸⁶ *Id.* at 417.

⁸⁷ *Bluestone*, *supra* note 62, at 583.

⁸⁸ *Hendrickson v. eBay*, 165 F. Supp. 2d 1082 (C.D. Cal. 2001).

⁸⁹ *Id.* at 1084-85.

⁹⁰ *Id.* at 1093.

⁹¹ *Id.*

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infringement claim by the plaintiff, eBay removed the infringing listings of the movie pursuant to the DMCA.⁹² Thus, it was meritless to argue that by removing the infringed material that eBay had established the right and ability to control the infringing activity on its website.⁹³ Furthermore, the court found that a notice of infringement to a service provider such as eBay must “comply substantially” with the elements of notification of the DMCA in order to remove safe harbor protection, which was not achieved in *Hendrickson*.⁹⁴

In *Costar Group v. Loopnet*, the court further expanded the DMCA interpretations of safe harbor immunity for service providers claiming that the DMCA created a floor, but not a ceiling, for ISP protection.⁹⁵ The District Court of Maryland held that an ISP’s “policy must warn users who repeatedly infringe copyrights that there is a ‘realistic threat’ of losing account access.”⁹⁶ Then in 2008, the Fifth Circuit continued the trend of extending CDA and DMCA immunities to include social networking sites such as Facebook and Twitter in *Doe v. MySpace*.⁹⁷

Based on the immunity from liability provided to ISPs through the CDA and the DMCA and the broadening effect of these Acts via court interpretation, it seems unlikely that any service provider could be found liable for a tort committed by one of their users’ acts.⁹⁸ However, many times the damaging online behavior necessitates some type of remedy. In these situations, it is common for these victims to turn to harassment statutes to find justice for their Internet grievances.

III. INCOMPLETE PASS: HARASSMENT LAWS ILLUSTRATE HOW TRADITIONAL LAWS DO NOT ADEQUATELY ADDRESS ISP MISCONDUCT

Harassment laws have progressed through the years in effort to adapt to our ever-evolving society, except when it comes to cyber harassment. Harassment, in its traditional offline form, is defined as “words, conduct, or action ... that ... annoys, alarms, or causes substantial emotional stress in [the] person and serves no legitimate purpose.”⁹⁹ The Internet has muddled the traditional notions of harassment by providing increased opportunities for harassers who can anonymously perpetrate their victims with ease through email, blogs, or social media sites while at home or at work.¹⁰⁰ As a result, there is no universal definition

⁹² *Hendrickson*, 165 F. Supp. 2d at 1093.

⁹³ *Id.*

⁹⁴ *Hendrickson*, 165 F. Supp. 2d at 1089.

⁹⁵ *Costar Group v. Loopnet*, 373 F.3d 544, 555 (4th Cir. 2004).

⁹⁶ *Bluestone*, *supra* note 62, at 584.

⁹⁷ *Id.*; *see, e.g., Doe v. MySpace*, 528 F.3d 413 (5th Cir. 2008).

⁹⁸ *See Zeran*, 129 F.3d at 328; *Hendrickson*, 165 F. Supp. 2d at 1082; *Blumenthal*, 992 F. Supp. at 47; *Gucci Am., Inc.*, 135 F. Supp. 2d at 409.

⁹⁹ Sarah Jameson, *Cyberharassment: Striking a Balance Between Free Speech and Privacy*, 17 *COMMLAW CONSPECTUS*, 231, 235 (2008).

¹⁰⁰ *Jameson*, *supra* note 99, at 235.

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for cyber harassment, but it typically occurs “when an individual or group with no legitimate purpose uses a form of electronic communication as a means to cause great emotional distress to a person.”¹⁰¹ A cyberharasser’s motive is to frighten or embarrass the victim.¹⁰²

Unfortunately, Congress has not made protecting victims of cyberharassment a priority.¹⁰³ As a result, there is currently no federal statute that directly addresses the various forms of cyberharassment, which means victims must rely on the traditional federal harassment laws and possibly state laws.¹⁰⁴ Harassment is usually classified as a misdemeanor in most states, but these statutes have no applicable law or punishment for violators on the Internet.¹⁰⁵

Initially, Section 223 of the CDA made it a federal crime to use a telecommunications device to make harassing or obscene calls, but the Internet was intentionally excluded from the statute for years.¹⁰⁶ Then, in 2006, Section 223(a)(1)(C) was amended to incorporate into its definition of “telecommunications device,” “any device or software that can be used to originate telecommunications or other types of communications that are transmitted, in whole or in part, by the Internet.”¹⁰⁷ After the 2006 amendment, Section 223(a)(1)(C) made it a federal crime for anyone using the Internet “without disclosing his identity and with intent to annoy, abuse, threaten, or harass any person...who receives the communications.”¹⁰⁸ Thus, Internet harassment was finally criminalized pursuant to the 2006 amendment.

Based on their most recent amendments, the traditional federal statutes addressing harassment are trying to incorporate the online nature of the crime as

¹⁰¹ Jameson, *supra* note 99, at 237 (“Until Congress adopts a federal statute, the need for clearly stated definitions remains.”).

¹⁰² Jameson, *supra* note 99, at 236.

¹⁰³ Jameson, *supra* note 99, at 245-46 (“Traditional, federal harassment statutes focus on physical contact between the harasser and the victim and therefore inappropriately address the virtual nature of cyberharassment. Although Congress has enacted legislation to protect children on the Internet, mainly from harmful content, enacting legislation to protect victims from harassers on the Internet has not been a congressional priority. Victims of cyberharassment are limited to civil litigation as a remedy: victims can sue for defamation, invasion of privacy, or intentional infliction of emotional distress. Victims might also find recourse by reporting a cyberharasser to an ISP and then attempting to sue the ISP itself under section 509 of the CDA. However, when utilized in suits for unlawful conduct over the Internet, these options are increasingly restricted and leave victims of cyberharassment ineffectively protected. Fortunately, Congress has started to recognize the increasing problems caused by cyberharassment.”).

¹⁰⁴ 2 RONALD N. WEIKERS ET AL., , DATA SECURITY AND PRIVACY LAW § 15:18 (2d ed. 2014).

¹⁰⁵ Jameson, *supra* note 99, at 246.

¹⁰⁶ WEIKERS, *supra* note 104.

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

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evidenced by Section 223(a)(1)(C). However, issues with applying them to cyberharassment still remain. The fundamental problem in applying such laws to cyberharassment is due to the traditional statute's strong focus on the physical and direct contact between the harasser and the victim, which makes the statute ineffective when dealing with the cyber aspect of harassment.¹⁰⁹ For instance, applying Section 223(a)(1)(C) to a catfishing hoax or to a false Twitter account prank would be difficult because the specific nature of those activities do not fit into the statutory definition of harassment. It is important to note that the statute itself inherently carries with it issues of vagueness, as well as First Amendment free speech challenges.¹¹⁰

Since there is no federal statute regulating cyberharassment and there is no current federal harassment law that adequately addresses the cyber aspect of harassment, victims of the crime are forced to find a remedy through civil litigation.¹¹¹ The Megan Meier's "MySpace Suicide Hoax" illustrates the consequences of not having a specific statute penalizing cyberharassment.¹¹² Megan was a thirteen-year-old girl who hanged herself due to a MySpace prank that was played on her by her forty-seven year old neighbor, Lori Drew.¹¹³ Drew created a MySpace account under the fictitious name Josh Evans with the intent to discover whether or not Megan spread rumors about Drew's daughter.¹¹⁴

During a two-hour time frame on the night she committed suicide, Megan became a target of intense cyberharassment, analogous to a "teenage mob on the Web."¹¹⁵ The "mob" tormented Megan by calling her fat and a slut, as well as spreading other rumors about her, and said that no one should befriend her.¹¹⁶ Tragically, Megan ended her life that night, and without a federal statute specifically criminalizing the cyberharassment she suffered. Thus, holding Drew criminally responsible for her role in the suicide will likely be unsuccessful, leaving civil litigation as Megan's family's sole remedy.¹¹⁷

Victims of cyberharassment can attempt to sue for defamation, invasion of privacy, and/or intentional infliction of emotional distress, along with other torts.¹¹⁸ The voluntary nature of the Internet combined with the high burden the plaintiff carries in presenting clear evidence proving the defendant's state of mind to

¹⁰⁹ Jameson, *supra* note 99, at 246.

¹¹⁰ WEIKERS, *supra* note 104.

¹¹¹ Jameson, *supra* note 99, at 246.

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ *Id.*

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ Jameson, *supra* note 99, at 232.

¹¹⁸ *Id.* at 246.

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intentionally cause harm, makes it very difficult for a plaintiff to win on these claims.¹¹⁹

Another major problem associated with cyberharassment is the anonymous nature of the Internet, because too often the victim does not know the harasser's identity or is mistaken as to the true identity of the harasser.¹²⁰ These victims may try to find recourse through suing the ISP after reporting the cyberharassment to the ISP under the CDA.¹²¹ ISP immunity, however, as previously discussed, is incredibly broad and the standard of proof required to find one liable for a user's message is very high. This limits the options for cyberharassment victims and leaves them ineffectively protected by the law.¹²² Failure to allow relief from ISPs renders these plaintiffs without a remedy.

IV. THE 4TH QUARTER

The CDA, the DMCA, and the corresponding case law, appear to leave Te'o and Gorforth without a remedy against the social media conglomerates, Facebook and Twitter. It seems evident that Congress chose to legislate away any claim to damages that would have been available to the two athletes. The harms that Te'o and Gorforth suffered are so pervasive and rapidly becoming commonplace in our cyber-world that Congress must do something to address this inequity. This is the type of conduct the CDA promised to protect against in its policy section, but instead, Congress has only allowed this kind of cyber misconduct to flourish without recourse.

Te'o and Gorforth will have an incredibly difficult time establishing a successful tort claim against Facebook and Twitter, respectively. Section 230 of the CDA specifically states that ISPs will not be treated as the "publisher or speaker" for the content of a third party.¹²³ The act also prohibits civil liability in instances where the service provider acted in good faith to remove or restrict access to materials considered by the provider to be "obscene, lewd, lascivious, filthy, excessively violent, harassing, or otherwise objectionable."¹²⁴ The immunity afforded to Facebook and Twitter by Section 230 of the CDA would appear to thwart a tort claim brought forth by Te'o or Gorforth on its face.

¹¹⁹ Jameson, *supra* note 99, at 248.

¹²⁰ *Id.*

¹²¹ *Id.* at 246.

¹²² *Id.*

¹²³ 47 U.S.C. § 230.

¹²⁴ 47 U.S.C. § 230.

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Then, the *Zeran* decision expanded Section 230 ISP immunity so far as to make recovery virtually impossible for Te'o and Goforth.¹²⁵ The court held that instead of having ISPs actively limit and restrict online speech in fear of being liable for its content, "Congress considered the weight of the speech interests implicated and chose to immunize service providers to avoid any such restrictive effect."¹²⁶ In other words, an ISP is not required to screen each of its millions of postings for possible problems and is free from liability from such postings pursuant to the CDA.¹²⁷ Even if Te'o or Goforth could establish that there was "obscene, lewd, lascivious, filthy, excessively violent, harassing, or otherwise objectionable" material that caused them injury on either site, Facebook and Twitter are not obligated to screen for that content and, therefore, cannot be held liable for its appearance on their networks. .

The DMCA, by way of Section 512, strengthens the weakness of Section 230 of the CDA by offering ISPs "safe harbor" protection from monetary damages for claims of copyright infringement.¹²⁸ Finally, the court in *Doe v. MySpace*, extended CDA and DCMA immunities to include social media sites, thus rendering Facebook and Twitter seemingly impervious to tort liability for their users' conduct.¹²⁹

Although it is likely that Te'o and Goforth would be precluded from successfully suing the appropriate social media sites for tort liability, they could attempt to bring a possible cyberharassment claim due to the nature and extent of their victimization. While filing a cyberharassment claim is an option, it is likely that both players would fail on that ground as well.

Te'o appears to have a stronger cyberharassment claim than does Goforth, because Te'o can readily identify his alleged "harasser" as Ronaiah Tuiasosopo who has accepted responsibility for the catfishing hoax.¹³⁰ Pursuant to Section 223(a)(1)(C) of the federal cybercrime statute, it is a federal crime for anyone to use the Internet "without disclosing his identity and with intent to annoy, abuse, threaten, or harass any person...who receives the communications."¹³¹ Applying this statute to Tuiasosopo's online activity, however, will be difficult to accomplish for a few reasons. First, Tuiasosopo clearly did not reveal his true identity to Te'o, but he did go to great lengths to assume a fictitious identity instead of remaining anonymous. This is an important difference, because it lends insight into

¹²⁵ Bluestone, *supra* note 62, at 580.

¹²⁶ *Zeran*, 129 F.3d at 331.

¹²⁷ Bluestone, *supra* note 62, at 582.

¹²⁸ *Id.* at 580.

¹²⁹ *Id.*

¹³⁰ Eder, *Te'o Answers*, *supra* note 20 (since Ronaiah Tuiasosopo came forward and accepted responsibility for the hoax).

¹³¹ WEIKERS, *supra* note 104.

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Tuiasosopo's mindset during the catfishing hoax, which is pivotal when trying to interrupt his intent.

Second, it is unclear and nearly impossible to prove that Tuiasosopo's intent was to "annoy, abuse, threaten, or harass" Te'o given the bizarre nature of this case.¹³² People have speculated a variety of possible motives for Tuiasosopo, ranging from him seeking the thrill of a successful publicized catfishing hoax, to a potential financial payout from Te'o down the line.¹³³ By all accounts, however, it is still unclear as to what motivated Tuiasosopo's behavior, assuming he was definitely the architect behind the hoax.¹³⁴ Tuiasosopo, in his interview with Dr. Phil, claimed that pretending to be Lennay Kekua gave him an "escape" from his life and that he developed "feelings" and "emotions" for Te'o that eventually Tuiasosopo "couldn't control anymore."¹³⁵

Based on Tuiasosopo's account, which is difficult to rely on since he is an admitted liar and hoaxer,¹³⁶ his actions do not appear to meet the intent requirement of Section 223(a)(1)(C) and proving otherwise will be challenging. Te'o's voluntary participation in the matter will not aid in establishing the intent requirement of Section 223(a)(1)(C) either. Tuiasosopo clearly duped Te'o into believing Kekua was an actual person, but the fact remains, Te'o was a willing party in the relationship, which leads to the question, "how harassing was Tuiasosopo's behavior?"

Despite Te'o's participation in the catfishing hoax, he was still injured by the actions of Tuiasosopo. It seems likely, however, that Tuiasosopo's actions will fall outside the scope of Section 223(a)(1)(C) because the intent requirement cannot be established. Thus, the current harassment laws do not seem equipped to incriminate complex catfishing hoaxes.

The circumstances surrounding Goforth's online impersonation seemingly disqualify any potential cyberharassment claim he may have under Section 223(a)(1)(C). Even if Goforth could establish the intent burden of Section 223(a)(1)(C), he was not the person who "receive[d] the communications," and was therefore not the subject of any harassment himself, as the statute requires.¹³⁷

¹³² Eder, *Te'o Answers*, *supra* note 20.

¹³³ *Id.*

¹³⁴ Eder, *Te'o Answers*, *supra* note 20.

¹³⁵ Timothy Burke & Jack Dickey, *Here's Everything Ronaiah Tuiasosopo Told Dr. Phil in Day One Of His Exclusive Interview*, DEADSPIN (Jan. 31, 2013, 2:07 PM), <http://deadspin.com/5980594/heres-everything-ronaiah-tuiasosopo-told-dr-phil-in-day-one-of-his-exclusive-interview>.

¹³⁶ Eder, *Te'o Answers*, *supra* note 20.

¹³⁷ WEIKERS, *supra* note 104.

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Furthermore, an anonymous individual committed the online impersonation. As a result, Goforth's cyberharassment claim would have to be brought against Twitter, which is clearly immune from third party actions, under the immunities provided to ISPs through the CDA and the DMCA. The extensive safeguarding power afforded to the ISPs, coupled with the nonexistent federal statute that directly addresses the specific nature of all the various new forms of cyberharassment, leaves no available recourse for either Te'o or Goforth.

V. THE "HAIL MARY"

The evolving nature of the Internet creates new challenges in its regulation almost on a daily basis. As a result of these challenges, the Legislature needs to create new laws or amend the current ones so that ISPs can no longer hide behind blanket immunity for all of their users' behavior. However, given the legislative safeguard protections enjoyed by the CDA and the DMCA, coupled with the courts' apparent stance that this type of Internet misconduct is not something that needs to be protected, it is likely that nothing will change unless the CDA and the DMCA are amended. Amending the CDA and the DMCA, however, is almost as unlikely as completing a successful "Hail Mary" as time expires to win the Super Bowl; meaning Te'o and Goforth will be left on the sidelines without a remedy.

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Essay

**Gotham Skylines:
The Intersection of Scènes à Faire and Fictional Facts
In Comic Books, Graphic Novels, and their Derivative
Works**

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I. INTRODUCTION

The lights of one thousand skyscrapers pierce the pitch-black night sky. A city rises from the sea, crowding an island that is 13.4 miles long and at most 2.3 miles wide. The city stretches out, familiar to most in the entire western world. Locals gaze upon the unmistakable shape of One World Trade Center and feel a sense of completeness, a monument to American spirit and the inability of foes abroad to crush that spirit. It is, to many, the center of the universe, the place where dreams come true, the city that never sleeps. But as soon as the viewer knows this is New York City, they are proven wrong. This is not the New York City known by all and beloved by some. This is a dark reflection of The City as a human cultural touchstone. This City is consumed by some shadow that can never be seen head on. Lives are shorter here, more brutal. Criminals rule the streets while the police are unwilling or unable to serve and protect. This is a city protected not by the watchful members of the New York Police Department, but by the Dark Knight. This is Gotham.

There is a scene in Chris Nolan's film, *The Dark Knight Rises*, where an aerial shot of Gotham shows the island city before the film's antagonist destroys the bridges leading into the city. The aerial shot clearly shows Manhattan; the bridges that are destroyed include the George Washington bridge, among other well-known

thoroughfares. The symbolism can be jarring for some, particularly given New York's relationship with the concept of terrorism. It is a film (and a series) uniquely suited to post-9/11 America, and yet it bears the mantle of the modern myth, the Superhero.

While these heroes protect the innocent, who protects them? Perhaps more importantly (for the owners and studios), who protects the vast profit they are capable of generating? In just a decade and a half since the modern superhero film exploded onto the scene,¹ the comic books and graphic novels that have long been the very definition of a fringe or niche interest, have morphed into a multi-billion dollar film, television and video game empire. The two main players in this industry, Marvel² and DC,³ are owned by juggernauts in the entertainment industry. More importantly, some of these characters have been around for over three-quarters of a century.⁴ Readers keyed into intellectual property law, particularly copyright, should begin to see the issue. The copyright protection on these characters will expire in the coming years, and could potentially open up a wide range of other works based on these venerable and valuable properties. While trademark law may provide some limited protections, there may in fact be another way for these characters to be protected.

There are several exceptions to copyright, but the one most applicable to our case is the prohibition against recognizing copyright protection for "Scènes à Faire." Succinctly put, the doctrine prohibits copyrighting a scene that is indispensable to conveying basic information about the overall copyrighted work. In other words, using a skyline shot of New York City to convey that a film is set in New York City is not copyrightable on its own, even though the rest of the film is certainly eligible for protection. In a similar manner, facts may not be copyrighted. However, fictional facts may be. For example, the fact that Superman was born on the planet Krypton and sent to Earth as a baby to be raised in Smallville by the Kent family are 'facts' of a sort, but as fictional facts they are subject to copyright protection.

The world of comic books is full of hypothetical questions regarding competing forces. Can Thor's hammer (the irresistible force) destroy Captain America's shield (the immovable object)?⁵ Who is faster, Superman or The Flash?⁶

¹ X-MEN (20th Century Fox 2000).

² Marvel is owned by Disney. Ben Fritz, *Disney Tells Details of Marvel Entertainment Acquisition in a Regulatory Filing*, L.A. TIMES (Sept. 23, 2009), <http://articles.latimes.com/2009/sep/23/business/fict-marvel23>.

³ DC is owned by Warner Brothers. *DC Entertainment*, WARNER BROTHERS, <http://www.warnerbros.com/studio/divisions/dc-entertainment> (last accessed May 19, 2015).

⁴ ACTION COMICS 1 (Detective Comics June 1938) (the first appearance of Superman).

⁵ MARVEL'S THE AVENGERS (Marvel Studios 2012) (no, it cannot).

⁶ In this author's mind, the Flash is faster. However, other comic book enthusiasts may think otherwise.

In this mix we bring a legal conundrum to join the debates that swarm around conventions and online message boards. What happens when fictional facts interact with scènes à faire in the manner that occurs in films based on comic books? Which wins, the protectable nature of fictional facts or the generic scenes that are bereft of protection? In this note I will argue that when fictional facts interact with scènes à faire in comic book movies, the previously unprotected scenes gain copyright protectable status. While this may seem a moot point, it is not. The extensive protections offered by copyright will enable those copyright holders to continue exploiting the vast commercial value of those rights for decades to come.

I. DESCRIPTION OF THE ISSUE

A. *Narrowing the Field*

To begin with, we must focus our attention on a single company, DC Comics, Inc. This is important for a number of reasons. To begin with, DC and Marvel Comics are the largest producers of comic books and graphic novels in the world. These two companies together command a significant majority in market share,⁷ and they hold the most valuable 'books of business' in the industry. While the two companies trade places from time to time on the top of the sales charts, they are the undisputed kings of the industry.

The main purpose in focusing on DC over Marvel is twofold. First, Marvel sets their comics (and the films based on them) in primarily real world environments. New York is New York, Chicago is Chicago, and so on. The unique and fictional settings in Marvel comics are indisputably original and have yet to be featured prominently in film. Conversely, DC comics feature entirely fictional cities, from Gotham to Metropolis to Central City, Coast City and Star City.⁸ These cities, when they are depicted in audiovisual works, need either massive (and massively expensive) backlots and soundstages, or stand-ins. Stunt cities, so to speak. Chicago has played the part of both Gotham and Metropolis (as has New York), Los Angeles has even played double to Gotham, and Pittsburgh has newly been crowned Central City.⁹

The final reason we are focusing on DC properties is one of time. DC, descended from Detective Comics, is a truly venerable company in the industry. Two of their most popular and enduring characters first debuted in the late thirties,

⁷ Mat Elfring, *Top Selling Comics & Publisher Market Share: August 2014*, COMIC VINE (Sept. 5, 2014), <http://www.comicvine.com/articles/top-selling-comics-publisher-market-share-august-2/1100-149758/> (as of August, 2014, Marvel and DC together commanded 62.98% of the dollar share and 68.41% of the unit share).

⁸ MICHAEL TEITELBAUM ET. AL. THE DC COMICS ENCYCLOPEDIA, UPDATED AND EXPANDED EDITION (2008).

⁹ *The Flash* (CW television broadcast, 2014-2015).

and while Marvel is descended from a contemporary company, the modern incarnation of Marvel began publishing in 1961 with *The Fantastic Four*. Additionally, many of DC's properties are owned wholly by DC, rather than human authors retaining copyrights. The ownership of copyright in Marvel characters, however, is not clear.¹⁰ For that reason, many Marvel copyrights may not expire for decades after Mr. Lee is deceased, while the clock is most definitely ticking on Superman and Batman.¹¹

B. Why It Matters

At first this issue may appear purely academic. However, that is not the case. While it is true that this will not be a testable issue for nearly twenty years, Warner Brothers has already laid out plans for production and development on movies based on DC properties through 2020. The superhero genre is incredibly lucrative, with comic books and graphic novels alone amassing roughly \$870 million in sales in 2013. That figure pales even more when one views the world-wide box office revenue for *Man of Steel*, the most recent Warner Brothers film based on Superman: over \$660 million. That is only one film; in 2013, theatrically released superhero films grossed over three billion dollars¹². Superhero films have become a genre in and of themselves, and some movies are even referred to as “following the Marvel formula.”¹³ That amount of money can make or break companies, and when they acquired Marvel, Disney discovered the goose that laid a golden egg¹⁴. While Warner Brothers and DC have not emulated the runaway success of Marvel, they have nonetheless seen impressive returns. When that much money is at stake, the property must be protected.

Hypothetically, by 2033, after Warner Brothers has poured millions of dollars into development and production of an extensive franchise of superhero characters

¹⁰ *Stan Lee Media Fights Disney for the Iron Man, Spider-Man and X-Men Copyright in Lawsuit*, INQUISITR (Oct. 29, 2014), <http://www.inquisitr.com/1572737/stan-lee-media-fights-disney-for-the-iron-man-spider-man-and-x-men-copyright-in-lawsuit/>.

¹¹ 17 U.S.C. § 302(c) (2012) (copyright expires 95 years after publication, which is 2033 for *Superman*, and 2034 for *Batman*).

¹² BOX OFFICE MOJO, <http://www.boxofficemojo.com/> (last visited Mar. 20, 2015) (showing earnings for *Iron Man 3*: \$1,215,439,994, *Man of Steel*: \$668,045,518, *The Wolverine*: \$414,828,246, *Kick-Ass 2*: \$59,556,104, *Thor: The Dark World*: \$644,783,140, with a total box office gross revenue of \$3,002,653,002).

¹³ Keith Staskiewicz, *Review of Big Hero 6*, ENTERTAINMENT WEEKLY (Jan. 17, 2015, 5:04 PM), <http://www.ew.com/article/2014/11/14/big-hero-6> (perhaps unsurprising for a Disney film based off of a Marvel property).

¹⁴ BOX OFFICE MOJO, <http://www.boxofficemojo.com/> (last visited Mar. 20, 2015) (even 2014's *Guardians of the Galaxy*, based on an obscure group of misfits and anti-heroes, became a surprise hit with a worldwide gross revenue of over \$770 million).

and team ups, another company could make a Superman film, capitalizing on the investments made by Warner Brothers and diluting the market for future films. While recent individual stories will still be protected by copyright, the only law shielding Superman from exploitation by other companies is the rather flimsy shield of trademark protection.¹⁵ In the event this protection of Superman should elapse, Warner Brothers will surely hire a veritable army of intellectual property attorneys, and I am deeply sorry for my fellow classmates and peers who may be among those attorneys, as it may not be necessary. Warner Brothers can essentially block out competing companies from ever being able to make practical use of their characters in a blockbuster film environment in a very simple way. They can use the fictional facts imposed upon scènes à faire to copyright those scenes. In other words, New York City as Gotham is a copyright owned by Warner Brothers, and that copyright will last until at least the year 2108.¹⁶

It is important to note that when (and if) these copyrights expire, the only copyrights that will expire will be in the initial appearances of the characters. Many portions of the character and storylines of the characters have been introduced over decades, and those adaptations will still be under copyright protection.¹⁷ However, with every year that passes, more and more of that original idea will pass into the public domain.

II. ALTERNATIVE MEANS OF EXPANDING PROTECTION

Before launching into a discussion and analysis of combining scènes à faire with fictional facts to create a copyrightable piece of expression, it behooves us to ensure that this is necessary even in the hypothetical and prospective framework being considered. It is true that there are at least two methods of expanding or maintaining the protections held by owners of comic book characters and settings, but neither provides a perfect solution. Whether the focus is on extending the term of copyright or trademark protections, both possibilities come with their own difficulties and drawbacks.

A. *Extended Copyright Terms*

As long as Mickey Mouse has value, copyrights will never expire. That was a quip by my Copyright Law professor, and all joking aside, it holds a grain of truth.

¹⁵ See *infra* part III(B).

¹⁶ The aforementioned scene of New York appeared in the 2013 film, *The Dark Knight Rises*, the copyright of which will expire in 2108, 95 years later. 17 U.S.C. § 302(c) (2012).

¹⁷ I.e., When Superman first appeared, he was a wildly different character than the “last son of Krypton,” now known to comic book fans. While competitors may be wary of exploiting a character many people may not recognize, it is still essential to protect these original properties regardless of the likelihood of needing such protection.

Disney was certainly one of the forces behind the passage of the Sonny Bono Copyright Term Extension Act (CTEA)¹⁸ and its defense in the courts.¹⁹ While Disney's power and influence are not to be denied,²⁰ AOL Time Warner (owner of DC) specifically filed an amicus brief on behalf of the respondent. The main thrust of the CTEA was to extend copyright protections to a term of life plus seventy years for authors or a flat ninety-five years for works created anonymously, under a pseudonym or as works for hire.²¹ This act also added a flat twenty years to already existing copyrights provided they had been properly extended under the earlier copyright regime.

When the CTEA faced a constitutional attack, a great deal of attention was placed on what exactly was meant or intended by the I.P. clause of the U.S. Constitution.²² Justice Ginsburg, writing for the court, determined that the question was a rather simple one. In other words, although the act did extend the term of copyright, that term would still terminate and it was still a "limited time."²³ It seems likely that as the term of certain valuable copyrights approaches their expiration, there will be another push towards extending the copyright term.²⁴

It is worth noting, however, that this method of continuing copyright protection is a stopgap measure at best. The primary hurdle to pass in order to extend the copyright protection term is the sentiment embodied in Justice Stevens' dissent in *Eldred*.²⁵ Stevens asserts that despite the definition of "limited time," extensions of copyright such as the CTEA will eventually extend copyright protection infinitely, creating a congressional overreach that will surpass the original constitutional provision.²⁶ Similarly, Justice Breyer attacked the congressional motivations behind extending copyright, seeing comments by members of Congress as proof of an intent to eventually bypass the constitutional mandate of limited time altogether.²⁷

¹⁸ Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998).

¹⁹ See generally *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

²⁰ Particularly since Disney now owns Marvel and thus has a vested interest in the continuing expansion of copyright protections as they relate to comic book properties.

²¹ Under the previous version of the Copyright Act, these terms were universally twenty years less. Copyright Act of 1976, 94 Pub. L. 553, 90 Stat. 2541 (1976), amended by Copyright Term Extension Act, 112 Stat. 2827.

²² U.S. CONST. art. 1, § 8, cl. 8 ("[t]o promote the Progress of...useful Arts, by securing for *limited Times* to Authors...the exclusive Right to their respective...." (emphasis added)).

²³ *Eldred*, 537 U.S. at 189.

²⁴ Mickey Mouse's copyright protection is to expire in the near future, creating a copyright issue to be addressed.

²⁵ *Eldred*, 537 U.S. at 222 (Stevens, J., dissenting).

²⁶ *Id.* at 223.

²⁷ *Id.* at 256 (Congress did not intend to act unconstitutionally. But, it may have sought to test the Constitution's limits. After all, the statute was named after a Member of Congress, who, as the

While the dissenting opinions were clearly insufficient to sway the majority of the Court, these bits of dicta are nonetheless important as future copyright extensions are contemplated. Should Congress (as a result of the lobbying of influential copyright owners) extend the term of copyright again, eventually the Court will step in to curtail such extensions. It is unclear if this would happen the next time an extension occurs or multiple extensions in the future, but it is nearly inevitable that the Court will in fact begin enforcing the “limited time” constitutional requirement. Because of the level of Supreme Court prognostication required to guess when this will occur, it would be far more secure for copyright owners to seek alternative means of strengthening their copyrights.

B. Trademark Protection

“All characters, their distinctive likenesses and related elements featured in this publication are trademarks of DC Comics.”²⁸ That should end our inquiry right then and there. If these characters have trademark protection, then the creators and owners of the characters can just rely on that, can’t they? Unfortunately, this is not the case. While trademark protections do have at least one benefit over copyright,²⁹ there are numerous other issues that make trademark law ill-suited to the task at hand. Chief among those issues are that some superhero characters may actually not be eligible for trademark. Trademark protections are generally less robust than those afforded to copyright, and the Supreme Court has ruled that subject matter that should fall under copyright law should not receive the benefits of trademark protection because the laws serve entirely different purposes.

Certain superheroes may lack the hallmark of distinctiveness necessary to fend off serious challenges to trademark validity. Since *Abercrombie & Fitch Co. v. Hunting World*,³⁰ four broad categories of textual marks³¹ have been recognized in trademark law.³² While fanciful or arbitrary marks are afforded a wide presumption of validity, generic and descriptive marks are not. Descriptive marks must demonstrate secondary meaning in order to be valid, and generic marks are presumptively invalid and cannot achieve secondary meaning. The majority of superhero names are arguably quite clearly descriptive marks. A man who dresses

legislative history records show, “wanted the term of copyright protection to last forever.” (citation omitted)).

²⁸ GEOFF JOHNS ET AL., JUSTICE LEAGUE VOLUME 1: ORIGIN 4 (Eddie Berganza et al. eds., 2012).

²⁹ 15 U.S.C.A. § 1059 (2012) (trademarks may be perpetually renewed if statutory requirements are met).

³⁰ *Abercrombie & Fitch Co. v. Hunting World*, 537 F.2d 4 (2d Cir. 1976).

³¹ *Id.* (textual marks are words or phrases that an individual or a company seeks to register as a trademark).

³² *Id.* (the four categories include: fanciful marks (often a word with no independent meaning), arbitrary marks (a word with no inherent connection to the product it will mark), descriptive marks (a word describing a product or a service) and generic marks (a generic word or phrase).

up as a bat is Batman. A man with power of water is Aquaman. A woman with incredible super powers is Wonder Woman.

Luckily for the owners of the marks, it is clear that *substantial* secondary meaning has been achieved. In other words, in the United States, people hear the name Batman and assume that the comic book character is being referenced. Meanwhile, some superheroes begin to toe the line between descriptive and generic marks. Green Lantern, for example, quite literally gains his superpowers from a ring powered by a green lantern. Then you have characters whose names are distressingly close to generic marks. A man who can seemingly do anything and exists as an ideal for the world to aspire to is Superman.³³ A villainous take on a clown who exists as a foil for a dour hero is Joker. If these marks are deemed generic, no amount of secondary meaning can save them. They will be invalidated.³⁴

The ease with which an invalid trademark can be stripped of protection is just a single example of the limitations of trademark protection compared to that of copyright. Copyright offers a full suite of rights and protections, including the ability create additional works drawing upon the same creative work. Trademarks, conversely, exist exclusively in the realm of commerce. Having a trademark in Superman allows Warner Brothers to use the popular “S” shield emblazoned on goods and to prevent other business from doing the same. At best, a trademark infringement suit against another writer or film producer could require the infringer to drop the name or symbol.³⁵

The final problem with relying on trademark protection is that the Supreme Court has decided that trademark protection should not overlap with copyright protection.³⁶

[T]he Lanham Act prohibits actions like trademark infringement that deceive consumers and impair a producer's goodwill...The words of the Lanham Act should not be stretched to cover matters that are typically

³³ There is an interesting argument to be made that Superman is a derivative of Nietzsche's *Übermensch*. See generally FRIEDRICH NIETZSCHE, *THUS SPOKE ZARATHUSTRA* (1896).

³⁴ Gotham, originally coined as a term for New York City by Washington Irving in the nineteenth century, is another example of a generic mark.

³⁵ In the 2014 film, *Man of Steel*, the “S” shield was completely redesigned and the word “Superman” was used only once. A competing film could arguably do the same and avoid trademark liability. Without delving too deeply into comic book minutiae, another important departure from the original material occurred. Superman's emblem is generally portrayed as the symbol of his “house” or family. In *Man of Steel* it is described as an alien symbol for hope. This disassociation from previous copyrighted expression could be done in other films as well, preventing a suit alleging copying of the character as it was developed after the initial copyright.

³⁶ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

of no consequence to purchasers. It could be argued, perhaps, that the reality of purchaser concern is different for what might be called a communicative product—one that is valued not primarily for its physical qualities, such as a hammer, but for the intellectual content that it conveys, such as a book or, as here, a video. The purchaser of a novel is interested not merely, if at all, in the identity of the producer of the physical tome (the publisher), but also, and indeed primarily, in the identity of the creator of the story it conveys (the author). And the author, of course, has at least as much interest in avoiding passing off (or reverse passing off) of his creation as does the publisher. For such a communicative product (the argument goes) “origin of goods” in § 43(a) must be deemed to include not merely the producer of the physical item...*The problem with this argument according special treatment to communicative products is that it causes the Lanham Act to conflict with the law of copyright, which addresses that subject specifically.* The right to copy, and to copy without attribution, once a copyright has expired, like “the right to make [an article whose patent has expired]—including the right to make it in precisely the shape it carried when patented—passes to the public.”³⁷

Justice Scalia, in clear and unambiguous terms, rejected the argument that trademark would be used to create a sort of perpetual protection for intellectual property, something clearly prohibited by the United States Constitution.³⁸

In this case, the subject matter in question was nothing less than a full audiovisual program. It is possible to say that, on more narrow scales, the Supreme Court may allow trademark to succeed as an avenue of protection, but several very important distinctions need to be made. The sheer scale of the financial power behind the superhero genre means that ruling in favor of trademark is, in fact, far more broad than this holding, and will likely be discarded by the court.

III. SCÈNES À FAIRE AND FICTIONAL FACTS AS A METHOD OF EXTENDING COPYRIGHT

Having examined alternative avenues to extending or further strengthening the protection currently afforded the owners of the intellectual property in question, our investigation turns to a more novel approach and the crux of this analysis: utilizing the legal principle that fictional facts can be copyrighted (as opposed to the

³⁷ *Dastar Corp.*, 539 U.S. at 32-33 (emphasis added).

³⁸ *Id.* at 37; U.S. CONST. art. I, § 8, cl. 8 (guaranteeing exclusive rights for limited times).

normal rule that facts are unprotectable) to make scènes à faire copyrightable. To begin, a brief overview of the scènes à faire doctrine (in addition to an overview of fictional facts) is necessary, followed by case law that has come close to integrating the concepts.

While this area of legal theory is currently untested, there are legal principles and case law that can be used to formulate future predictions about the success of this integration. An examination of that law will follow, and this note will attempt to lay out a roadmap that will predict on what side the courts will fall should this integration be utilized in an attempt to extend the existing protections afforded by copyright law.

Finally, even if this integration of scènes à faire and fictional facts is successful, there are pitfalls and workarounds that the owners of the intellectual property must be aware of. The only truly ironclad protection for these valuable properties is an extension of the copyright term. Relying on this integration is theoretically possible, but should not be considered a first line of defense. Some of the more glaring pitfalls will be addressed at the end of this section.

A. A Brief Introduction to Scènes à Faire and Fictional Facts

On the surface, the legal principle of scènes à faire is a simple one.³⁹ Certain scenes or situations are inherently necessary to a form of expression, and thus cannot be copyrighted independently of the work as whole. An example would be the use of skyline shots to show that an audiovisual work is set in a given city.⁴⁰ Other examples of scènes à faire include the “indispensable elements” of a genre or category of creative expression.⁴¹ A still image from *The Dark Knight Rises*, alluded to in the introduction, clearly shows the skyline of lower Manhattan.⁴² Bereft of any other significance, this shot falls squarely within the scènes à faire doctrine when used to denote that some activity is occurring in a large city (such as New York City). The creative aspects of the scene are copyrightable, but the use of such a wide shot to inform the viewers of the location of the action is not.

Scènes à faire have their roots in the traditional copyright principle known as the idea/expression dichotomy. Put succinctly, bare ideas cannot be the subject of copyright, but the expression of those ideas can be.⁴³ These indispensable scenes

³⁹ See generally Leslie A. Kurtz, *Copyright: The Scenes a Faire Doctrine*, 41 FLA. L. REV. 79 (1989) (for a more in-depth overview of the scènes à faire doctrine).

⁴⁰ See, e.g., *Castle* (ABC television broadcast 2009-2015) (an example of a modern television show that uses skyline shots of a given city while being filmed in a city with significantly lower operating costs. *Castle* was filmed in Vancouver while portraying New York City.).

⁴¹ Kurtz, *supra* note 39 at 92-94.

⁴² See *infra* Appendix.

⁴³ See, e.g., *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930).

have become ideas in their own right by virtue of their indispensable nature. The common building blocks of a police procedural or a hospital drama, for example, cannot be copyrighted beyond the particular expression of those building blocks utilized in a given creative work. This principle has found its expression in case law as well. When attempting to assert his copyright over certain historical aspects of a book he had published, A.A. Hoehling was stymied by the Second Circuit's determination that such historical information was not copyrightable, as well as the fact that scenes of Germans singing in a beer hall and theories of sabotage were indispensable from a film about the tragic final flight of the Hindenburg.⁴⁴

As *Hoehling* and other case law demonstrates, the scènes à faire doctrine is tied very closely with the bedrock concept that facts cannot be copyrighted.⁴⁵ A fact such as "the earth orbits the sun, which is a star located in the Milky Way galaxy" cannot be the subject of copyright, because these facts are fully and squarely within the public domain.⁴⁶ In a manner of speaking, scènes à faire and facts are both concepts and ideas that must be expressed in a creative way to create a copyrightable work, and they remain on their own unprotected. The author of a book detailing a new method of accounting, for example, can certainly own the copyright in his expression of this new method. However, the forms and paperwork used to carry out this method of accounting contains nothing but facts and is indispensable to the art expressed in the book.⁴⁷

These clear-cut legal principles tend to gain a murky quality when the subject of fictional facts arise. Ask any avid trivia-night bar goer and "Han Solo's ship is called the *Millenium Falcon*" is most assuredly a true fact. The entire nature of the subject matter is fictional, however, which changes the legal landscape, particularly as it relates to copyright. Copyright in *Star Wars* lies squarely with its creator and assigns.⁴⁸ Therefore, this "fact" is part and parcel of that copyright and defeats the standard legal principle.

Fictional facts are clearly copyrightable, and an unauthorized use of those facts can be the basis of an infringement lawsuit.⁴⁹ When a fan of J.K. Rowling's *Harry Potter* series of books wished to publish an encyclopedia of information from that series, the facts therein were held to be the creative property of the author and whosoever held the copyright. "Although hundreds of pages or thousands of fictional facts may amount to only a fraction of the seven-book series, this quantum

⁴⁴ *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980).

⁴⁵ *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 347 (1991).

⁴⁶ *See Int'l News Serv. v. Associated Press*, 248 U.S. 215, 248-67 (1918) (Brandeis, J., dissenting).

⁴⁷ *Baker v. Selden*, 101 U.S. 99 (1879).

⁴⁸ Parsing out whether Disney or George Lucas owns these copyrights is not the subject of this note, and would require investigating the contracts signed by the parties.

⁴⁹ *Warner Bros. Entm't Inc. v. RDR Books*, 575 F. Supp. 2d 513 (S.D.N.Y. 2008).

of copying is sufficient to support a finding of substantial similarity where the copied expression is entirely the product of the original author's imagination and creation.”⁵⁰

RDR Books relies on a two-part analysis developed from cases such as *Ringgold v. Black Entm't Television, Inc.*,⁵¹ essentially looking at two levels of copying in order to determine copyright infringement. The first level is quantitative copying, which refers to how much of the material was copied. In *Ringgold*, for example, the copyrighted expression in question was a “story quilt,” and the quilt was copied in its entirety.⁵² Similarly, the court determined in *RDR Books* that a significant portion of the Harry Potter Lexicon involved direct quotations and significant paraphrases of Rowling’s novels.⁵³ The second level of analysis is qualitative copying. Qualitative copying is reminiscent of other “overall look and feel” tests in copyright law, and the inquiry is focused on the alleged infringer’s adoption of the copyright holders general creative effort. As an example, the author of the Harry Potter Lexicon relied exclusively on the creative work and fictional facts created by Rowling.⁵⁴

In one easily imagined situation, a film starring the character of Batman could be found to lack the necessary quantitative copying to find infringement. However, any such film would have to rely on fictional facts and thus could be found to have qualitatively copied the creative efforts that came after the initial character creation.

This example clearly demonstrates that ‘facts’ such as: “Batman lives and fights crime in Gotham City” is a copyrightable portion of the creative work owned by Warner Brothers. Just as clearly, Christopher Nolan’s skyline shot of Manhattan is an unprotectable scène à faire. What then, about the integration of these two ideas? Does Manhattan AS Gotham rise to the level of copyrightable expression?

B. Integration of the Two Concepts: Past Court Decisions and Future Predictions

Perhaps due to the prospective nature of this issue, there is little guidance given through case law that is on all fours with the idea of integrating fictional facts with scènes à faire. Instead, a roadmap of what direction courts will likely take must be constructed from the cases that do exist. These cases include an instance of independently protected sculptural works losing that protection in the context of

⁵⁰ *Warner Bros.*, 575 F. Supp. 2d at 535.

⁵¹ *Ringgold v. Black Entm't TV*, 126 F.3d 70 (2d Cir. 1997).

⁵² *Id.* at 72.

⁵³ *RDR Books*, 575 F. Supp. 2d at 535.

⁵⁴ *Id.* at 536.

fictional facts and independent creative portrayals,⁵⁵ cases that narrow the copyright protection extended to poorly developed characters,⁵⁶ and cases that detail what must be added to scènes à faire to make them no longer incapable of obtaining copyright protection.⁵⁷

In *Leicester v. Warner Bros.*,⁵⁸ the individual who designed towers that were eventually depicted in the film, *Batman Forever*, sued, claiming that his copyright in his sculptural work has violated. The Court of Appeals affirmed a lower court determination that the work was instead an architectural work and afforded more limited protection.⁵⁹ While the ruling was based on the limitations of the protections afforded to architectural works rather than the creation of a new legal concept, some dicta in the opinion provides compelling guidance. “The 801 Tower and the two lantern towers and two smoke towers in the streetwall appear briefly as background in a few scenes in the movie. The building is the Gotham City bank where nefarious deeds occur before Batman comes to the rescue.”⁶⁰ While focusing on the particular usage of a single verb is by no means conclusive, the language is still important. The use of the architecture in an independently copyrightable setting alters the very identity of the original architecture. The fictional facts surrounding the attack on the Gotham City bank altered the original real life setting. Now that building is copyrighted AS the Gotham City bank. This was accepted without discussion or comment by the court⁶¹ and lays the groundwork for copyrighting far more than one building.

An illustrative example of this can be seen, once again, in *The Dark Knight Rises*. The JP Morgan building, well known to many a visitor to New York City’s Financial District, is portrayed as the Gotham Stock Exchange in an early act of the film.⁶² While a photograph of the building would not (in and of itself) be protectable by copyright, the film impresses an artificial identity on the building, and with that new identity comes copyright protection.

Next we move to some limitations on copyright, exemplified in *Idema v. Dreamworks*.⁶³ Copyright can only be extended to those portions of an expression that are original, and while there is only a de minimis showing required, that showing is still needed. “Plaintiffs claim that the...character in the film is the

⁵⁵ *Leicester v. Warner Bros.*, 232 F.3d 1212 (9th Cir. 2000).

⁵⁶ *Idema v. Dreamworks*, 162 F. Supp. 2d 1129 (C.D. Cal. 2001), *aff'd in part, dismissed in part*, 90 F. App'x 496 (9th Cir. 2003), *as amended on denial of reh'g* (Mar. 9, 2004).

⁵⁷ *Lexmark Int'l v. Static Control Components* 387 F.3d 522 (6th Cir. 2004).

⁵⁸ *Leicester*, 232 F.3d 1212.

⁵⁹ *Id.* at 1214.

⁶⁰ *Id.* at 1215 (emphasis added).

⁶¹ *Leicester*, 232 F.3d at 1215.

⁶² *See infra* Appendix.

⁶³ *Idema*, 162 F. Supp. 2d 1129.

substantial equivalent of the...character described only in a one-paragraph character summary at the conclusion [of the book]...However, a couple of sentences of vague description are clearly not enough to create a protectable character under copyright.”⁶⁴ This core concept underlying copyright law would extend to any attempt to copyright generic scenes modified by fictional facts. While this potentially gives rise to some pitfalls or weaknesses in attempting this sort of protection,⁶⁵ the “character” of the cities represented in DC/Warner Brothers properties has been established and developed over decades.⁶⁶

Scènes à faire are not permanently consigned to the land of non-copyrightable material. It is possible to add additional creative elements to something previously deemed to be a generic scènes à faire and create a new, copyrightable whole. While *Lexmark International* does not focus on fictional facts, the case nonetheless describes the level of effort required to elevate previously non-copyrightable material to the sphere of copyrightable expression. The protected work at issue here was a computer program, which is subject to the “abstraction-filtration-comparison test”⁶⁷ and requires a level of dissection in order to determine the actual copyright-eligible aspects of a work. “In trying to discern whether these doctrines apply, courts tend to ‘focus on whether the idea is capable of various modes of expression.’...The question, however, is not whether any alternatives theoretically exist; it is whether other options practically exist under the circumstances.”⁶⁸

Whether it is a choice made in computer code or the development of a story, choice itself is often enough to meet the de minimis standard explained in *Feist*.⁶⁹ Once that standard is met, the subject in question is no longer subject to the scènes à faire doctrine or the merger doctrine, emerging as its own copyrightable expression. It does seem obvious that courts will require a little more of a showing to lock down a portrayal of an iconic city rather than the code used to control toner cartridges. Furthermore, *Lexmark* deals exclusively with the non-utilitarian programming choices that should be exhibited when seeking copyright protection over a computer program and does not speak directly to using fictional facts to do the same thing. However, fictional facts combined with the non-utilitarian choice of a real life city can potentially be used as a functional equivalent.

⁶⁴ *Idema*, 162 F. Supp. 2d at 1186.

⁶⁵ See *infra* part III(C).

⁶⁶ While examples abound in each fictional city used, the most telling is the dichotomy between Gotham and Metropolis. These settings are both intended to represent “the city” as an ideal and as a character. Gotham represents the dark aspects of the city while Metropolis takes on the glorified positive aspects. This “black and white” portrayal, common in comic books, serves to characterize the cities in a far more developed manner than the character at issue in *Idema*.

⁶⁷ See *Computer Associates Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992).

⁶⁸ *Lexmark*, 387 F.3d at 536 (citations omitted).

⁶⁹ *Id.*

When analyzing the various rules outlined above, a new rule can be synthesized. If there is an artistic or creative choice at play in the selection of the scene to be used, and if that choice incorporates creative aspects that are in themselves copyrightable and surpass the bar set by *Idema*, then the supposed scène à faire is no longer a scène à faire. Applying that rule to the facts of comic book films, we would first look to the choices of the film-makers. In his Dark Knight Trilogy, Christopher Nolan clearly made choices that were purely creative. He did not need to use New York as his backdrop. In fact, in earlier films Chicago was the ‘body double’ for Gotham City. He did not need to use one city or the other (or in fact any real city at all, a computer generated or artistic rendering of Gotham worked sufficiently for Burton and Schumaker). The second step of the analysis is to examine the ‘character’ at issue; Gotham City. Throughout decades of interpretation and development, the character of Gotham City has clearly developed beyond “a couple of sentences” as in *Idema*.⁷⁰

The result is an independently copyrightable scene. The true power of this rule, however, is seen when another film-maker attempts to create a Batman film. Chicago has been used as Gotham, as has New York City.⁷¹ Any attempt to portray Gotham using those cities would infringe on the independently copyrightable expression articulated by Christopher Nolan and owned by Warner Brothers. The use of just a few more suitable cities in this manner would result in forcing competing film-makers into a choice between limited and unenviable alternatives; use a less iconic city and thus lose the force of that association, adopt a perhaps far more costly plan of utilizing digital effects to create a city from scratch, or abandon the project altogether.

C. Pitfalls and Workarounds

It is critically important to note that this solution is far from perfect. Setting aside the possibility that a court may be unwilling to adopt this interpretation of integrating scènes à faire with fictional facts, flaws and workarounds (by which a clever film-maker could defeat this concept) still exist.

First and perhaps most importantly, even if courts allow scènes à faire to be modified into copyrightable expression in this way, there are still avenues open to exploit these characters by inventive competitors. Novels, animated films, even potentially video games are potential areas of exploitation. While they have not proven to be nearly as lucrative as the live action films have been, they will remain completely untouched by this method of extending copyright protections.

⁷⁰ *Idema*, 162 F. Supp. 2d at 1186.

⁷¹ BATMAN BEGINS (Warner Brothers Entertainment 2005) (Chicago as Gotham); THE DARK KNIGHT RISES (Warner Brothers Entertainment 2012) (New York as Gotham).

Perhaps more worrisome is the fact that films based on comic books are becoming as much a genre as westerns or noir films.⁷² Scènes à faire are linked to specific types of expression or genres as a matter of definition, and portions of creative works deemed indispensable to one genre will not be scènes à faire in others. As the “superhero” genre becomes more established and recognized as its own category of expression, it will develop its own specific scènes à faire, which may very well include the type of city “stand-ins” described in this note.

Adding to this concern is the likelihood that aggressive use of this method will push these copyrighted scenes right back into the territory of unprotected scènes à faire. Even if the integration concept is legally accepted, implementing it too often and cornering the market on any conceivable city used in this manner will result in the same effect that occurred in *Lexmark*: the application of the scènes à faire and merger doctrines will strip these scenes of their copyright and open up these properties to the very exploitation that the owners sought to prevent.

IV. CONCLUSION

Utilizing fictional facts to transform unprotected scènes à faire into expression protected by copyright has the very real potential to extend copyright protection over comic book characters as it relates to film depictions of them. Because this would be a novel extension of copyright concepts and doctrines, the success of this theory is far from certain. While past cases give insight into the arguments that may succeed, it is not a method that should be relied on exclusively.

Should it be adopted – or even attempted – the most important thing to remember is that this does not constitute bulletproof protection of valuable intellectual properties. When combined with trademark arguments and the potential for extending copyright terms again, it provides an additional avenue to seek further protection, but it will not likely stand on its own.

Perhaps most importantly, this author takes no stance on the wisdom of attempting or relying on this approach. The purpose of this note is to explore the possibilities in seeking further protection on an industry that has evolved from selling five cent comic books to bringing in billions of dollars in revenue on an annual basis. Comic books have evolved from being a niche interest to a true commercial juggernaut, and those who own these properties will need every tool at their disposal to attempt to protect them.

⁷² Mark Hughes, *Why Marvel is Defining the Modern Superhero Film Genre*, FORBES (Oct. 29, 2013, 8:00 AM), <http://www.forbes.com/sites/markhughes/2013/10/29/why-marvel-is-defining-the-modern-superhero-film-genre/>.

Appendix



Preceding still image is referred to *supra* part IV(A).



Preceding still image is referred to *supra* part IV(B).

PACE INTELL. PROP. SPORTS & ENT. L.F. VOL. 5, ISS. 1 (2015)
Gotham Skylines:
The Intersection of Scènes à Faire and Fictional Facts
In Comic Books, Graphic Novels, and their Derivative Works

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