

1-2022

Comments on Council Draft 6 [black letter and comments]

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Recommended Citation

Jane C. Ginsburg & June M. Besek, *Comments on Council Draft 6 [black letter and comments]*, (2022).

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To: Professor David Levi, President, and Council Members,
American Law Institute
From: Jane Ginsburg and June Besek¹
Subject: Comments on CD6 [black letter and comments]
Date: January 18, 2022

Note: References in this memo are to the internal page numbers in Council Draft No. 6 (CD6) (November 2021).

We appreciate the Reporters' incorporation of some of our comments on recent drafts. There remain, however, certain flaws in CD6 that should be addressed. We explain the issues, below.

Section 8, Fixation

Comments d and f: We and other commenters have criticized successive drafts' depiction of "enjoyment and exploitation" as a standard to determine whether the instantiation of a work exists for a duration of time sufficient to consider it a "copy" under the law. This formulation is Reporters' creation and is not used in the statute or caselaw. CD6 apparently attempts to mitigate this problem by characterizing this phrase as "one possible way to understand" the statute's duration requirement. Page 5, lines 9-10.

The unassuming characterization of this made-up standard is belied by later more definitive expressions of the concept as a standard, not as a mere possible way of understanding the fixation requirement. See, e. g., page 5, lines 22-24; page 5, lines 28-30; page 9, lines 7-11; page 9, lines 24-26; page 10, lines 2-4. Using "enjoyment or exploitation" as a means of differentiating fixed from unfixed works is using it as a standard. It tells the courts that this is what "fixation" means. A copyright-unfamiliar judge could well conclude that the "one possible way to understand" it is in fact the test for duration. As we have consistently since the first appearance of "enjoyment or exploitation," we urge that this unsupported fabrication be removed from the Comments.

Section 10, Subject Matter and Standards

Page 17

Black Letter ("BL") 10(b), line 7: We reiterate the query we made with respect to PD7: Is it ALI's position that judges make law?

¹ Jane Ginsburg is an Adviser to the Restatement Project. June Besek is a liaison from the ABA Section of Intellectual Property Law, but these comments are done in her individual capacity and not on behalf of the ABA.

Id., line 8: As we noted in our comments on PD7, the caselaw and much of the discussion concern explanatory materials that weren't *created* by the legislature but were *adopted* by it.

Page 23

Comment c, lines 8-9. Our comments on PD7 (page 7, line 7) questioned use of "the better view" in this context for lack of support. CD6 removes these words ("the better view that. . ." formerly after "binding interpretation") to make a more affirmative statement, citing *Georgia v. Public.Resource.org*, 140 Sup.Ct. 1498 (2020) and *Veeck v. Southern Building Code Cong. Int'l*, 293 F.3d 791 (5th Cir. 2002) in support. As discussed below, neither of these cases support this statement in CD6.

Section 10 (c) of CD6 states that when a government adopts privately-authored commentary as binding in a judicial decision, statute or regulation etc., that adopted commentary is part of the "edict of law," excluded from copyright protection. CD6 concedes that courts have not addressed this issue with respect to privately-authored commentary (p. 23, lines 6-7). The authorities CD6 cites, however (lines 10-14), don't support the proposition that private commentary on private codes becomes an "edict of law." In *Public.Resource.org* the annotations accompanied state actor-generated legislation. In *Veeck*, the court addressed the code, not the commentary. This section goes beyond restating the law. Through bootstrapping the decisions it cites, CD6 provides an overbroad statement in lines 8-9 that effectively strips the commentary of its copyright.

Page 25

Comment d, lines 4-7: Does it matter if the edict refers to the privately-authored work as THE way to satisfy a legal requirement? Why does it matter how many ways exist?

Page 31

Reporter' Note c, lines 12-27: CD6 sidesteps the question whether a government's adoption of private code and/or commentary is a taking that should be compensated under the Takings Clause of the Constitution. It observed that *CCC Info. Servs. v. MacLean Hunter Mkt. Reports*, 44 F.3d 61 (2d Cir. 1995), raised the issue but the court did not decide it. CD6 states that there was no unfairness to the owner of the code or commentary because the purpose behind the private drafting "almost always is to convince a government to adopt the authored text." (p. 31, lines 14-15) But CD6 provides no evidence to support this assertion. According to CD6, even if there were no such intention "due process and prudential concerns remain." (Line 17.)

CD6's dismissal of a possible Takings claim is unjustified. Many takings are prompted by worthy goals, but compensation is nevertheless required. CD6 needs a more careful consideration of the Takings issue.

Section 15, Scope of Protection

Page 38

Comment e, lines 13-16 (citing Judge Boudin’s concurrence in *Lotus v. Borland*, 49 F.3d 807, 819 (1st Cir. 1995)): This suggests that a "creative work" may retroactively become a "method" if lots of people use it.

Lines 27-31: (citing Judge Boudin’s concurrence in *Lotus*, 49 F.3d at 821): This is why retroactively ruling a work's organization a "method" is problematic.

According to CD6

This Restatement takes the position that elements of programs that permit inter-operability, such as lock-out codes and user interface elements like menu-command hierarchies, are not protected because they are critical to the competitive production of compatible software and hardware.

(p. 38, lines 19-22) This statement is overbroad and unjustified by the case law, including the recent Supreme Court decision in *Google LLC v. Oracle Am*, 141 Sup. Ct. 1183 (2021). That decision does not address the copyrightability of Oracle’s computer program, but instead, whether Google’s use of Oracle’s program was a fair use on the particular facts of the case. CD6 declares that *Google v. Oracle* “cast doubt” on the Federal Circuit’s holding that Oracle’s APIs were copyrightable. (p. 40, lines 2-3). This hardly justifies CD6’s conclusion.

Section 25, Individual Ownership, etc.

Page 60

Comment h, lines 23-25: Discuss what "that particular collective work, any revision of that collective work, and any later collective work in the same series" means.

Section 40, Copyright Formalities

Page 71

BL §40(b), lines 5, 16: We reiterate the comment we made concerning PD7: “Eligible works” gives the impression that copyright covers a restricted class of works. It implies a high threshold (and harks back to prior drafts that also presented copyright as a series of hurdles to overcome, rather than arising from creation). We suggest deleting “eligible.” You can use the Comments to point out that not all works enjoy copyright protection.

Lines 13-14 “. . . the provision of notice, or lack thereof, on copies or phonorecords has other consequences.” Should be “may have other consequences”: the innocent infringement defense may not be credited, in which case, there are no consequences to lack of notice.

Page 72

BL §40(c), line 5: This is confusing. Does this reference publication between 1978 and March 1989 for works created before 1978? Does it mean that a work published with proper notice could lose protection if a subsequent printing didn't bear the notice? Support for that proposition?

Comment a, line 18: Here, "subsisted" is not the right term, since these are 1909 Act works, in which, if published, federal copyright had to be secured by affixing notice.

Page 73, lines 3-6: "Since the Comment acknowledges that 'the relevance of formalities is discussed in connection with works that are otherwise 'eligible' for copyright protection . . ." There is no need to keep reiterating "eligible" in the black letter. As stated above, the constant reiteration of "eligible" gives the false impression of a high threshold to copyright protection.

Section 41

Page 80

BL §41(a), lines 2-4: Same observation as we made in our comment immediately above.

Page 81

Comment a, line 3: Change "obtained immediately" to "attaches."

Page 83

Comment b, lines 24-25: The draft should make clearer that selling a single original can be publication because "copies" includes a single copy.

Lines 25-26: See query from PD7 [reproduced below in our comment to page 85, line 9].

Page 84

Comment c, lines 20-23: But actual distribution would be a publication.

Practical consequences: will publication turn on determination of the moment at which Musician has distributed to a sufficient number of persons to make up the "public"? Will it suffice that Musician distributes to just one member of the "public"?

Page 85

Comment e, line 9: Comment from PD7: What is meant by "authorized to retain"? For how long? "Retain" sounds permanent, but even if the purchasers received only a temporary (but not transient) download, such as a rental copy, it still would be a distribution, and therefore a "publication" (if the posting were the first public offering of access to copies).

Line 14: The Copyright Office is conducting a study on publication. See <https://copyright.gov/rulemaking/online-publication/>

Page 86

Comment e, lines 8-10: Make clear that the "to the public" criterion can be met even if there was only one actual distribution.

Comment f, line 21: Problems with the citation to *Zito v Steeplechase Films*, 267 F.2d 1022 (N.D. Cal. 2003): (1) the Comment makes it seem as if *Zito* concerned pre '76 works, which it did not. (2) The parenthetical describing the case does not say that the photo's incorporation was unauthorized (it was).

Page 89

Comment h, line 6: "distribution of phonographs." You mean "distribution of phonorecords"?

Page 90

Line 24: Cite to Peter Menell's work? Peter Menell, [In Search of Copyright's Lost Ark: Interpreting the Right to Distribute in the Internet Age](#), 59 J. Copyright Soc'y U.S.A. 201, 267 (2012) ("[T]o prove violation of copyright's distribution right, a copyright owner need merely show that a copyrighted work has been placed in a share folder that is accessible to the public.")

Page 91

Comment i, line 19: "is" should be "are"

Section 45

Page 99

BL §45(b), line 4: This is confusing; delete "a subsisting copyright or of" so it would read "the owner of any exclusive right. . ." The statute states that ownership of any exclusive right makes one an owner of copyright.

BL §45 (c), lines 9-12: Note that this may not be Berne-compatible.

Page 103

Comment d, lines 21-23: The description of works that don't qualify as United States works is not entirely consistent with the definition of "United States work" in 17 USC §101. "Or based there" is not a statutory term. Use "domiciliaries or habitual residents."

Page 108

Comment g, lines 5-6: Berne problem. This is not a valid condition for works of foreign authorship.

Page 109

Comment h, lines 4-10: These cases do not support "simply offer some evidence." (Line 1) They appear to require more and therefore should be the lead cases. Otherwise, it's misleading.

Page 110

Comment i, lines 20-22: Also, actions under §§1201, 1202.

Page 113

Comment k, lines 1-3 What about disparities between work described in the registration and work sued on?

Section 46

Page 122

BL 46(a), line 3: Why "could"? If work was "eligible" then nothing more is needed.

Page 129

Comment h, lines 9-12: But what about *Rosette v. Rainbo Mfg.Co.*, 546 F.2d 461 (2d Cir. 1975) and the amendment to §303 (adding subsection (b))?

Page 130-31

Lines 130, line 21 to 131, line 2: This reasoning is spurious in light of the extension of 1976 Act duration to works unpublished under the 1909 Act.

Page 131

Lines 26-29: Isn't this inconsistent with §103(b)? ("The copyright in such [derivative] work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.").

Section 47

Page 138

BL §47(a), line 4: Why "could"? If work is "eligible" then nothing more is needed.

Section 48

Page 145

Comment b, line 31: After "United States" add "or Canada."

Section 9.02

Page 155

BL §9.02, line 1: The overall thrust of this section piles up the prerequisites and makes it seem as if injunctions are extraordinary remedies rarely warranting imposition, while in fact injunctions and especially preliminary injunctions are probably the most frequently sought and granted form of copyright infringement remedy

BL §9.02 (c), lines 16-18: The black letter eliminates the “serious questions” standard. See our comment concerning comment c, page 161, below.

Page 161

Comment c, lines 13-17: By leaving “serious questions” out of the black letter, this draft does in fact take a position on the post-*Winter* [*Winter v. NDRC, Inc.*, 555 U.S. 7 (2008)] viability of the “serious questions” criterion.

Lines 19-22: Misleading: The question whether the plaintiff was likely to succeed on the merits was not at issue in *Winter*: “we do not address the lower courts’ holding that plaintiffs have also established a likelihood of success on the merits.” 555 US at 24.

Page 162

Comment c, lines 3-5: Given this acknowledgement, it is not appropriate to remove “serious questions” from §9.02(c). It should be restored as an alternative to likelihood of success on the merits.

Page 168

Comment g, lines 1-2: The formulation is misleading to the extent that the general thrust of this paragraph downplays the “at least” caveat, and makes it seem that all infringement claims require weighing plaintiff’s rights against the public’s “right to access expressive works.” As the “at least” clause illustrates, the case was not a garden-variety, or even genuine, copyright infringement case.

Page 168

Lines 8-12: This is misleading. Garcia didn’t have a copyright interest to enforce so no balance was at issue.

Lines 14-18: This is another case involving the misuse of a copyright claim to protect a completely different interest. It is highly misleading to derive a general rule disfavoring injunctions from these outlier cases.

Section 9.03

Page 196

Comment i, lines 13-16: Query if this is inconsistent with the Second Circuit’s rejection in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, of a “celebrity-plagiarist privilege.” 11 F.4th 26, 43 (2d Cir. 2020).

Section 9.04

Page 227

Comment g, lines 8-15: But the approach is consistent with the legislative history, denominating the innocent infringer defense "exceptional." The defense won't be "exceptional" if it applies to notice-stripped copies available on the internet notwithstanding easy access to notice-bearing copies.

Page 233

Comment j, lines 18-21: One award for parts of compilation: What if the components were separately registered as individual works, but also were included in a compilation? If the compilation was the source of the infringement, only one award, but if the separately-published components were the sources, then as many awards as separate works?

Section 9.05

Page 249

Comment e, lines 1-2: This is inaccurate: prevailing plaintiffs get attorney's fees only if the work was timely registered; prevailing defendants may get attorney's fees even if the work had not been timely registered.