

WILL FAIR USE SURVIVE?

Free Expression in the Age
of Copyright Control

A Public Policy Report
By Marjorie Heins
and Tricia Beckles



**BRENNAN
CENTER
FOR JUSTICE**

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The Brennan Center for Justice, founded in 1995, unites thinkers and advocates in pursuit of a vision of inclusive and effective democracy. The Free Expression Policy Project founded in 2000, provides research and advocacy on free speech, copyright, and media democracy issues. FEPP joined the Brennan Center's Democracy Program in 2004.

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"The Progress of Science and Useful Arts": Why Copyright Today Threatens Intellectual Freedom (2003)

Free Expression in Arts Funding (2003)

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Executive Summary

“Fair use” is a crucial part of our copyright system. It allows any of us to quote and reproduce parts – or sometimes all – of copyrighted works, if the use advances creativity and democratic discussion. There are similar free expression safeguards in trademark law. Together, they assure that the owners of “intellectual property” cannot close down the free exchange of ideas.

These safeguards in our copyright and trademark systems are at risk today. Threatening “cease and desist” letters cause many people to give up their fair use rights. Even more troublesome are “take-down” notices sent by copyright owners to Internet service providers, which pressure them to remove online speech without any court having ruled that it is illegal. Additional hurdles to fair use come from the “clearance culture” in many creative industries, which assumes that almost no quote can be used without permission from the owner. Meanwhile, educational “fair use guidelines,” which are often narrower than fair use law, prevent many teachers from copying material for their classes.

In late 2004, the Brennan Center for Justice began a research project to learn how well fair use and free expression are faring among artists, scholars, and others who make critical contributions to culture and democratic discourse. We conducted focus group discussions, telephone interviews, an online survey, and an analysis of more than 300 cease and desist and take-down letters that have been deposited with the “Chilling Effects” Clearinghouse.

Our discussions with members of PEN American Center, Women Make Movies, the College Art Association, and the Location One Gallery yielded two common themes. The first was that artists and scholars have great interest in, and confusion about, fair use. The second was a need for community support and *pro bono* legal assistance in their dealings with publishers, distributors, and other cultural gatekeepers.

Our analysis of 320 cease and desist and take-down letters from the Chilling Effects Web site indicated that more than 20% either stated weak copyright or trademark claims, or involved speech with a strong or at least reasonable free expression or fair use defense. Another 27% attacked material with possible free expression or fair use defenses. Thus, almost 50% of the letters had the potential to chill protected speech. The materials targeted by the letters ranged from criticism of a Scientology-like “planetary enlightenment” program to parodies of American Express and Mastercard.

Our telephone interviewees included the creator of a parody *New York Times* corrections page, an editor at the *Cape Cod Voice*, and small entrepreneurs using such terms as “Pet Friendly” Travel or “Piggy Bank of America.” Five of them had strong or at least reasonable fair use or First Amendment defenses, and four had possible defenses. Another seven received cease and desist or take-down letters with weak copyright and trademark claims. Yet nine of the 17 people we interviewed acquiesced in the copyright or trademark owners’ demands, or had their material removed because of take-down letters.

290 people filled out the online survey, expressing opinions about, and experiences with, copyright and fair use. Their stories ranged from an artist who made “Homeland Security” blankets to a fan fiction Web site that posted a story called “Gaelic Dreams” and received a cease and desist letter from the “Gaelic Dreams” import company. Numerous teachers and scholars expressed frustration with a clearance culture that locks images out of public view whenever an owner refuses permission or charges too high a price.

What can be done to bolster fair use and free expression in the digital age? Our recommendations include creating a clearinghouse for information, including sample replies to cease and desist letters and take-down notices; a legal support network; outreach to Internet service providers to encourage help for those targeted by take-down letters; and changes in the law to reduce the cost of guessing wrong about fair use.

Introduction

In 1997, the artist Tom Forsythe created “Food Chain Barbie,” a series of photographs depicting the iconic Barbie doll in conjunction with various kitchen appliances. These included “Malted Barbie,” “Fondue à la Barbie,” and “Barbie Enchiladas,” four dolls wrapped in tortillas and lying in a casserole dish. Forsythe said his creations were designed “to critique the objectification of women associated with Barbie, and to lambaste the conventional beauty myth and the societal acceptance of women as objects, because this is what Barbie embodies.”¹

The Mattel Company, owner of Barbie, sued Forsythe for violating its copyrights and trademarks. After four years of hard-fought litigation, a federal court ruled that “Food Chain Barbie” was not illegal; instead, it was protected as a fair use under both copyright and trademark law. “The benefits to the public in allowing such use – allowing artistic freedom and expression and criticism of a cultural icon – are great,” the court said. Allowing Forsythe to use Barbie without permission “serves the aims of the Copyright Act by encouraging the very creativity and criticism that the Act protects.”²

Not all creative spirits are as fortunate as Tom Forsythe. Most controversies over parodies and other “transformative” uses of copyright or trademark-protected materials – and over simple copying for educational, personal, or professional purposes – never get to court. And if they do, the person charged with infringement rarely has access to the substantial *pro bono* legal resources that were crucial to Forsythe’s success.³

In the late 1990s, for example, Fox Broadcasting succeeded in shutting down more than half of *The Simpsons* fan sites that were listed on one database.⁴ Warner Brothers has suppressed sites containing irreverent parodies of such *Looney Tunes* favorites as Bugs Bunny, Daffy Duck, and Tweety, claiming that these “beloved characters” should not be maligned by lascivious humor.⁵ Yet irreverent and

unauthorized commentary is one of the central purposes of fair use.

In 2004, the Brennan Center for Justice began a research project to learn how well fair use and other free expression safeguards in intellectual property, or “IP,” law⁶ are serving the needs of artists, scholars, and the rest of us. This report summarizes our findings, and ends with six recommendations for strengthening free expression and fair use in the digital age.

Free Expression and Fair Use: A (Very) Brief History

Fair use is probably the best-known free expression “safety valve” in our copyright system. Copyright law gives authors, artists, and musicians – or the companies they work for – the “exclusive right” to reproduce, distribute, and perform their works, or to allow others, usually for a fee, to do so.⁷ But fair use is an exception to this monopoly control. It allows anyone to copy, publish, or distribute parts – sometimes even all – of a copyrighted work *without permission*, for purposes such as commentary, news reporting, education, or scholarship.

Fair use is critical to political and cultural life. If permission were required every time a document is copied for personal use, or a quote or image is incorporated into a new work, the costs and logistical difficulties of finding owners, seeking licenses, and paying for them would cripple our ability to share ideas. Education would be severely hampered if teachers had to get permission for every article or picture they copy for classroom use. And copyright owners could censor speech by denying permission to anyone whose views they disliked.

As the Supreme Court has said, every work of “literature, science and art borrows, and must necessarily borrow, and use much which was well known and used before.”⁸ From classical music to jazz and rock ’n roll, Impressionist painting to Pop art, “appropriation” is a building block of creativity. The concept of fair use, and similar

First Amendment protections in trademark law, guarantee breathing space for free expression.

Creative people, of course, are often copyright owners as well as users. That is why IP law is all about the proper *balance* between owners' and users' rights. From the early days of copyright, judges viewed the "exclusive right" as less than absolute, and allowed quoting without the owner's consent. Supreme Court Justice Joseph Story said in one early case: "no one can doubt that a reviewer may fairly cite largely from the original work, if his design be really and truly to use the passages for the purposes of fair and reasonable criticism." Story said the factors to consider are "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."⁹ These are the same basic factors that govern fair use today.

.....
"I had no idea that
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.....

By the mid-20th century, there were many court decisions on fair use. In one case, the comedian Jack Benny was sued for a TV parody of the film melodrama *Gaslight*.¹⁰ Refusing to accept parody as a potential fair use, the courts rejected Benny's defense.

But ten years later, a court held that pictures in a book criticizing the Warren Commission's report on the assassination of President John F. Kennedy were a fair use. The pictures were charcoal sketches copied from amateur film footage of the assassination that had been bought by *Life* magazine and deposited in the National Archives. The judge allowed the fair use defense because of the newsworthiness and public importance of the book.¹¹

Another fair use-friendly result came in a lawsuit filed against Random House by a shell corporation set up by the reclusive millionaire Howard Hughes in order to stop publication of an unauthorized biography that used material from a series of articles in *Look* magazine. (The shell company had purchased the rights from *Look*.) Random House won on its fair use defense – in part, as one judge pointed out, because Hughes's company came to court with "unclean hands."¹²

Groucho Marx made a rhetorical contribution to fair use in the 1940s, when he replied to a cease and desist letter from Warner Brothers, threatening to sue if he did not change the title of his forthcoming movie, *A Night in Casablanca* – a parody of the Humphrey Bogart/Ingrid Bergman classic, *Casablanca*. "Up to the time that we contemplated making this picture," Groucho began, "I had no idea that the city of Casablanca belonged exclusively to Warner Brothers." He asked whether Warner Brothers also claimed exclusive rights to the term "brothers": "Professionally, we were brothers long before you were." Groucho continued with riffs on the Warner brothers' first names, Jack and Harry (Jack and the Beanstalk, Jack the Ripper, Lighthouse Harry, etc.) *A Night in Casablanca* was released; Warner Brothers did not sue.

But movie studios remained aggressive. In the 1970s, the Walt Disney Company won a judgment against irreverent cartoonists whose "bawdy depiction" of Disney characters "as active members of a free thinking, promiscuous, drug-ingesting counterculture" contradicted "the accepted Mickey Mouse world of scrubbed faces, bright smiles, and happy endings."¹³ The judges, although more open to parody as a form of fair use than the court in the Jack Benny case had been, said the cartoonists had copied too much of the original images.

Another court unsympathetic to bawdy parodies rejected a fair use defense when the owner of the song "Boogie Woogie Bugle Boy" sued participants in a theatrical revue called "Let My People Come," which included a raunchy takeoff on the song, titled "Cunnilingus Champion of Company C." The judges were offended by the sexual references, noting that "Bugle Boy" had "its greatest popularity during the tragic and

unhappy years of World War II.”¹⁴ One judge dissented, arguing that “we cannot, under the guise of deciding a copyright issue, act as a board of censors outlawing X-rated performances.”¹⁵

By the time of this decision, Congress had overhauled the copyright law. Section 107 of the 1976 Copyright Act officially incorporated the judge-made doctrine of fair use, “for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research.” The law enumerates four factors to be considered in evaluating a fair use claim:

1. the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
2. the nature of the copyrighted work;
3. the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
4. the effect of the use upon the potential market for or value of the copyrighted work.¹⁶

These four fair use factors are not exclusive – courts will also look to such considerations as bad behavior by one of the parties, the copyright owner’s right to privacy, and whether the motive of the lawsuit is to suppress unwelcome criticism. Nor does a defendant have to win on every one of the four factors: a finding of fair use may rest upon just one, if it is sufficiently persuasive. And despite the third factor – “amount and substantiality of the portion used” – copying an entire work is also sometimes fair, as the language of §107 (“multiple copies for classroom use”) makes clear. The Supreme Court ruled in 1984 that copying complete TV programs for purposes of later home viewing is fair use.¹⁷ As one scholar has pointed out, copying complete texts of articles or speeches, and sharing them as a way of expressing either agreement or dissent, is an essential part of democratic discourse.¹⁸

The first fair use factor looks to how the borrower or copier used the original work. Is the new use creative or “transformative”; does it build on the earlier work to forge something new? Does it serve some other productive purpose such as education or political discussion? Is the copying

for personal edification, commercial use, or the public good?

The second factor asks whether the work that was used is creative; that is, how strongly does it need protection against infringement? Since the purpose of copyright law is to promote “the progress of science and useful arts,”¹⁹ the more the original work serves the creative process, the stronger its claim to protection.

The third factor looks not only to how much of the copyrighted work is used, but also to how central that portion is to the original work. Generally, the less of a work that is copied, the better the chance of fair use; but wholesale copying doesn’t negate fair use where the other factors favor it. And there are no quantitative



“String of Puppies” 1988; Polychromed wood; 42x62x37 inches; © Jeff Koons

rules: in a 1985 case, the Supreme Court ruled that *The Nation* magazine’s copying just 300 words from a full-length book was not fair use; yet the next year, a court found that taking as much as 7,000 words from an out-of-print book for purposes of commentary was fair use.²⁰

The fourth factor asks how much, if at all, the new work will compete economically with the one it borrowed from. It *does not* ask whether the new work, through critique or parody, reduces demand for the original. If that were the test, then the criticism and commentary that is at the heart of fair use would be suffocated. As the Supreme Court put it, “when a lethal parody, like a scathing theater review, kills demand for the original,” this is not the kind of harm recognized by copyright law.²¹

Thousands of fair use cases have been decided since Congress listed the four factors in the 1976 Copyright Act. In 1980, a court found a *Saturday Night Live* parody of the jingle “I Love New York” in a comedy sketch called “I Love Sodom” to be fair use.²² There was a similarly favorable ruling six years later for a parody of the song “When Sonny Gets Blue,” called “When Sonny Sniffs Glue.”²³ But an appeals court in 1997 reversed a finding of fair use where a TV station used a poster depicting a quilt by the artist Faith Ringgold as part of a set decoration, and sent the case back for more factfinding on the first and fourth factors.²⁴ The artist Jeff Koons lost on his fair use defense when he copied a commercial photograph called “Puppies” in the course of creating a three-dimensional sculpture, because, the court said, his sculpture was a “satirical critique of our materialistic society,” rather than a specific *parody* of the “Puppies” photo.²⁵ And although a court in 1973 approved the photocopying of journal articles by government libraries for the purpose of advancing scientific research, this fair use-friendly approach was not extended to research scientists’ copying of articles at a private company.²⁶

Practices That Threaten Free Expression and Fair Use

Taking advantage of fair use has always been difficult because of its unpredictability, the high cost of defending it in court, and the crushing liability that may result if one guesses wrong. But today, there are additional factors that create even more serious threats to free expression and fair use.

Cease and Desist Letters

The first of these is the widespread practice among IP owners of sending “cease and desist” letters to threaten everyone from artists and social critics to commercial competitors with dire punishments for copyright or trademark infringement. The practice is not new, but the aggressiveness and volume of cease and desist letters has increased with the coming of the Internet, where copying is more visible and reaches larger audiences than in the past. In some cases, the recipients of cease and desist letters would qualify for the fair use defense, or

First Amendment protection under trademark law. The letters, needless to say, do not mention these possibilities.

In the mid-1990s, for example, the Republican National Committee sent a cease and desist letter to a pair of artists who expressed their opinion of the party’s “Contract With America” by reproducing its text on a limited edition set of underpants. A reply letter from a New York law firm, defending the artists’ fair use and First Amendment rights, ended that dispute.²⁷ But this did not dissuade the Office of Vice President Dick Cheney in 2002 from sending a letter to Chickenhead Productions, complaining about a parody biography of Cheney’s wife Lynne along with photos on Chickenhead’s whitehouse.org satire site.²⁸ The tenor of the Cheney page could be gleaned from its heading: “The Bush Administration: Courage. Passion. Faith. Petroleum. Xenophobia.”²⁹ In response to the letter, the site adorned the photos of Mrs. Cheney with a red clown nose and labels reading “Censored.” The New York Civil Liberties Union announced that it would go to court if necessary to defend Chickenhead.³⁰

In these extreme examples, the recipients of cease and desist letters were not intimidated. But as our research showed, threats of litigation carrying potentially massive costs do cause many people to relinquish their rights.³¹ If the IP owner sues, even a *weak* copyright or trademark claim can cost a defendant many thousands (potentially hundreds of thousands) of dollars. The pressure to settle is intense. Thus, many recipients compromise their rights in order to end the controversy before huge costs ensue, and often before any lawsuit is filed.

DMCA Take-Down Notices

The Digital Millennium Copyright Act or “DMCA,” passed by Congress in 1998, is a far-reaching law that controls the public’s ability to access and copy materials in digital form. Section 512 of the law provides a “safe harbor” from possible copyright liability for Internet service providers (ISPs) – including search engines – that “expeditiously” remove any material on their servers that a copyright owner tells them in “good faith” is infringing. No legal proceedings are needed.³²

Although §512 does allow an ISP “subscriber” to send a counter-notice contesting the allegation of infringement, the requirements of the counter-notice are detailed and technical, and not every Web speaker is a “subscriber” who can make use of the procedure.³³ Those contributing to ongoing discussions in newsgroups, for example, may not even be aware that their words, images, or links have been removed.

Section 512 is misguided because ISPs should not be liable for copyright infringement in the first place, simply because someone is using their servers to infringe. ISPs are akin to telephone companies or highways: they provide a means of transport. Wrongs committed by users of telephones or drivers on highways are not attributed to those providing the conduits. Section 512 ignores this principle in the interests of helping copyright owners protect their rights, but it provides an insufficient check on overreaching, and creates an unacceptable shortcut around the procedures that are needed to decide whether speech is actually infringing.

Just as with cease and desist letters, so with §512 take-down notices, some of the targeted material has a strong or at least reasonable likelihood of being fair use. Yet copyright holders can churn out take-down letters with little effort, and cause the suppression of speech they don't like without ever going to court. In one egregious example, Diebold, Inc., a manufacturer of voting machines, sent take-down letters to Swarthmore University and other ISPs demanding the removal of student Web postings containing internal emails of Diebold employees that discussed defects in the company's machines. The students sued; the company backed off; and the court ruled that the postings were fair use, noting: “It is hard to imagine a subject the discussion of which could be more in the public interest.”³⁴

The “Clearance Culture”

The notion that every quotation except the most minimal must be licensed and paid for is pervasive in the commercial world of arts and culture. Many publishers expect their authors to obtain permission for all quotes and illustrations. In the music industry, the practice of requiring a license for even the smallest sample

is entrenched.³⁵ As the author and activist David Bollier writes, the free borrowing that was critical to rap music innovation, just as it was to blues and soul music, soon became a threat to the clearance culture, and performers began to pay for licenses, “largely to placate their record labels.”³⁶

Filmmaking is where the clearance culture has most effectively eviscerated fair use. Researchers at American University have reported on the problems of filmmakers in finding rights-holders, being forced by exorbitant license fees to drop valuable material, and being unable to take advantage of fair use because of the rigid requirements of the “errors and omissions” (or “E&O”) insurance policies that are needed for commercial distribution.³⁷ These policies require permission for every snippet of film, photographs, music, or text that is used, in addition to shots of distinctive buildings or products.³⁸ The form makes no mention of fair use.

When we interviewed a leading broker, Dennis Reiff, about practices in the industry, he told us that a good attorney can occasionally negotiate riders to E&O policies for fair use. This is difficult, though, if the film “might have an impact.” That is, if “it's really controversial material,” “if it's really blasting something – like investigative reporting – then that could be a problem, because the person in question may not want to be investigated. And they may want to sue you to stop you from doing it. Which is the most common form of censorship.”

Reiff said that the terms of E&O policies have not changed much in the past 30 years, but the insurance itself was less prevalent then. “Right now you cannot put anything on the air without E&O insurance. There is no cable station, broadcast station, or distribution company that will release anything without E&O insurance.”

Why the change? Reiff attributes it to two factors. The first is the experience of media companies with big defamation cases, such as those brought in the 1980s against CBS by General William Westmoreland, and against *Time* magazine by former Israeli Defense Minister Ariel Sharon.³⁹ Even though these cases had nothing to do with copyright, E&O policies are a package, and if media companies decide to require them for film distribution, then demands for copyright clearance become part of the bargain.

The second reason is increased aggressiveness on the part of copyright owners. “People who owned a library of films from the ’30s, ’40s and ’50s didn’t think it was worth anything,” says Reiff. “Then they discovered in the ’70s, ’80s and ’90s that they are sitting on a gold mine and that people were using their material. And they would aggressively go after those people.”

Similarly with recognizable trademarks or buildings: “if you are filming a commercial in front of the Disney concert hall in Los Angeles, you better get a release from Disney.” If you don’t, “Disney would sue your tushy off.” Even if they don’t win, “it’s very expensive.”⁴⁰

Music is one of the biggest problems in E&O insurance, Reiff says. “Music people tend to be very litigious, and you may think you’ve got a fair use and you can still get sued. Music is a snake pit; in fact, a lot of underwriting companies won’t even go near it.” Sometimes the copyright owner cannot be found, and the filmmaker is forced to eliminate the music she has chosen. “It does stifle creativity when you stop people from doing that. I think that you should be allowed to take a work and do riffs on it, and music is a perfect example.”

Reiff said that 80-90% of filmmakers today get permission for everything. This means that a lot of footage is cut because permissions are unavailable or too expensive, or copyright owners can’t be found. Few films made without permissions can get commercial distribution. As an example, he mentions *LA Plays Itself* – “a wonderful documentary done by a college professor, about how LA is perceived in the movies. It was just wonderfully put together. And dozens of film clips. Didn’t get permission from anybody. It showed at the Film Forum [an independent theater in New York City] for a couple of weeks and then it went away. They couldn’t get E&O insurance.

“I also had a client once do the history of the commercial in America. They had these wonderful old commercials from the ’40s, ’50s and ’60s that were woven into the documentary. He couldn’t get insurance because the people who own the products are still around and they said no. And that was that.”

Negotiated Guidelines

Owners’ and users’ organizations have sometimes negotiated guidelines with specific limits on copying. Frequently used in education, these guidelines offer security to teachers, and near-immunity from suit to the universities that follow them. But they are ringed with arbitrary restrictions. And they ignore the flexibility and equitable nature of fair use.

For example, classroom-use guidelines that were referenced in the legislative history of the 1976 Copyright Act set a series of numerical limits, combined with requirements of “spontaneity” and lack of “cumulative effect,” that do not accurately reflect the flexibility of fair use law. They limit copying to a maximum of 250 words from a poem or 2,500 words from a story or article, *if* the duplication is for only one course, uses not more than one story, poem, or article, or two excerpts, by the same author, *and* is done at the inspiration of the teacher and so spontaneously that it would be unreasonable to expect a timely request for permission.⁴¹ Although these guidelines say that they represent only agreed-upon *minimums* and do not define the legal limits on fair use, this *caveat* is often forgotten. Certainly, they create strong incentives not to go beyond them.

Worse, some courts have cited the Classroom Guidelines as legal authority.⁴² And several lawsuits have been settled when copy shops, and in one case a major university, agreed to follow them, thus essentially transforming their floors into ceilings.⁴³

In the 1990s, the government convened a Conference on Fair Use (CONFU) in order to come up with guidelines for educational fair use of digital images and other material affected by new technology. CONFU met for years, but failed to reach consensus on any of its proposed guidelines. Organizations of scholars and libraries found them too confining.⁴⁴ Nevertheless, they have been adopted by some universities, and are available online for anyone seeking answers on fair use. Unfortunately, their answers in many cases *shrink* fair use.

In all, there are seven sets of educational fair use guidelines, covering classroom copying,

music, distance learning, interlibrary loans, off-air recordings of broadcast programs, digital images, and educational multimedia.⁴⁵ Their appeal – in the face of an urgent need for guidance on fair use – is understandable. But in the interests of security and uniformity, they relinquish the breadth and flexibility of fair use, and undermine the educational process.

Activism and Alternatives

Activists have begun to defend fair use in inventive ways. One of the most creative initiatives came from the music group Negativland, which in 1990 produced a parody that mixed about 30 seconds from a song by the rock band U2 with outtakes from a radio show and its own vocals and lyrics. The cover art for this album included a U-2 spy plane along with the letter U, the number 2, and “Negativland.” In the course of the lawsuit that followed, Negativland persuaded U2, but not the radio host, of its right to appropriate their work for transformative purposes. Negativland continues to produce musical parodies without seeking copyright permission.⁴⁶

Other activists have created Web sites such as “DownhillBattle.org,” “Rhizome,” and the “Barbie Liberation Organization,” which encourage creative appropriation, provide community support, and organize fair use protests, such as Downhill Battle’s February 2004 posting of “DJ Danger Mouse”’s *Grey Album*,⁴⁷ or a similar one-day download in 2005 of *Eyes on the Prize*, a powerful 14-part documentary of the civil rights movement, which has been out of circulation because its time-limited copyright licenses have expired.⁴⁸

Another group, which publishes the feisty *Stay Free!* magazine, organized an “Illegal Art” exhibition in 2002, which contained many inventive works of parody and critique – including Ashley Holt’s “Notmickey” (a reproduction of the famous Disney-owned

mouse with the words “Don’t sue!”) and Wally Wood’s “Disney Memorial Orgy,” showing some of the cartoon characters in compromising positions.⁴⁹ Many of the works in the show were probably not illegal at all, but would qualify as fair use.

One featured work in “Illegal Art,” a parody of the green circular Starbucks logo that changed the coffee company’s attractive siren into a greedy “Consumer Whore,” became the subject of a lawsuit in 2000. The case settled when the artist agreed not to display, reproduce, publish, distribute, or sell his design, except on his Web site, and only if unaccompanied by advertising or the sale of any product such as a comic book or T-shirt.⁵⁰ The settlement of course did not bind the organizers of “Illegal Art,” and despite some cease and desist letters, no suits were filed to stop the show.⁵¹



Kieron Dwyer,
“Starbucks’ Consumer Whore”

Other activists such as Public Knowledge, a Washington DC-based policy center, provide information and legal advocacy on major IP issues including fair use. The media democracy group FreePress.org reproduces news articles on the assumption that its nonprofit, educational purpose qualifies the reproductions as fair use.⁵² And the Chilling Effects Web site, begun in 2002, invites members of the public and ISPs to deposit cease and desist and take-down letters in order to spread awareness of the problem; law students post explanations of the relevant law.

Legal activists and student law clinics have also helped counteract IP owners. When attorneys for the Lyons Partnership, owners of Barney, the purple dinosaur, wrote to the Electronic Frontier Foundation complaining about a Web page that describes “threats of violence toward Barney,” and “unsavory and unwholesome content that you have associated with its trademark and service mark,”⁵³ they received a spirited response. EFF’s lawyers expressed alarm at the number of “baseless threat letters that have been sent by your firm and others under the guise of trademark and copyright protection,” and explained that “the article to which you object is a blatant,

unvarnished parody of Barney” and “presents no likelihood that anyone would confuse it with the original character or song lyrics.” EFF noted: “your distaste for the material, even when strangely phrased as a ‘threat of violence’ against an imaginary character, is plainly not the correct standard for legal liability under copyright or trademark law.” The letter closed by reminding Lyons’s lawyers of federal court rules punishing frivolous litigation.⁵⁴

Despite the effectiveness of groups like EFF, some activists feel that the uncertainty of the law, and the high cost of guessing wrong about fair use, reduce its usefulness, and have chosen to focus on other ways of reining in overzealous copyright control. Creative Commons, for example, provides sample licenses that copyright owners can adopt to permit freer use of their works.⁵⁵ It shows that alternatives to heavy copyright control are possible, but it depends on the willingness of the owner. Likewise, legislation requiring compulsory licenses for reasonable fees would be a way to prevent copyright owners from refusing permission because they don’t like the content of the borrower’s speech; but they assume the need for a license. Fair use works on the opposite principle – that it should not cost money or require compliance with any procedures to make reasonable use of words and images that are part of our culture. Fair use is irreplaceable precisely because it *does not* depend on payment, procedures, or permission.

Our Research

Our study was designed to find out how well fair use and similar free expression safeguards in IP law are working. How do artists, scholars, and political commentators react to cease and desist letters and other threats? And what might be done to secure fair use and free expression in our increasingly “pay per view” culture?

We used a variety of research methods. First, we conducted four focus groups, moderated discussions in which 7-12 individuals talked about their attempts to grapple with fair use, their experiences with cease and desist letters and

permissions, and their needs as both copyright owners and users. Many fascinating stories emerged from these discussions. We summarize them in chapter 2.

Next, we examined all the cease and desist and take-down letters that had been deposited with the Chilling Effects Web site for one full year, 2004. We analyzed the letters to see what kind of infringement claims were made; to assess, to the extent possible, how many of them targeted expression that might qualify for a fair use or First Amendment defense; and to learn how many of the recipients acquiesced in the letters’ demands. We summarize the results, along with many of the more interesting cases, in chapter 3.

We followed up on our analysis of the cease and desist and take-down letters by asking the ChillingEffects.org administrators to contact those depositors who had left contact information, to see if they would be willing to be interviewed by telephone. We wanted to learn about their reactions to the letters, their knowledge of fair use, their feelings about the incident, and the outcome of the controversy. Seventeen people volunteered to be interviewed. We recount their stories and analyze their legal situations in chapter 4.

Finally, we posted an online survey and asked arts organizations to publicize it. In all, we received and analyzed 290 completed surveys describing attitudes about, and experiences with, copyright and fair use from both the owners’ and users’ perspectives. We report and analyze these stories in chapter 5.

Our research was not strictly “scientific.” It would have been a daunting – perhaps impossible – task to create a truly random sample of artists or others affected by fair use, and then to design a survey methodology yielding statistical results that accurately reflected the percentages of individuals who received cease and desist letters, acquiesced in their demands, and had reasonable fair use defenses. Nevertheless, we collected and analyzed a great deal of information. We hope that the results will illuminate the fair use problem and contribute to effective solutions.

CHAPTER 1

The Legal Landscape

This chapter gives an overview of fair use and free expression under IP law.⁵⁶ Readers who aren't familiar with the legal principles will find it useful, even though it's too brief to be considered definitive. Those who are already familiar with the law might want to skip to chapter 2.

The Supreme Court and Fair Use

In 1984, eight years after Congress overhauled the copyright law, the Supreme Court first weighed in on fair use. The entertainment industry had sued Sony in an attempt to stop distribution of video cassette recorders because they could be used for unlawful copying. But they could also be used to copy TV shows for later home viewing, which the Court said was a fair use – fortunately for all concerned, since the industry was to earn huge profits on the sale and rental of home videos in the decade that followed. In the course of defending personal, noncommercial copying of TV programs as fair use, the Court made a broad statement which it later repudiated: that “every commercial use of copyrighted material” is presumptively unfair.⁵⁷

The next fair use case came a year later. *The Nation* magazine had “scooped” former President Gerald Ford’s not-yet published memoirs in an article that focused on Ford’s pardon of his predecessor, Richard Nixon, who had resigned the presidency in 1974, under threat of indictment for his involvement in the Watergate burglary. *The Nation*’s scoop caused *Time* magazine to renege on a contract for “first serial rights” with the publisher of the memoirs, Harper & Row.

Even though *The Nation* had reported news of great political interest, and took only 300 words from Ford’s book, the Supreme Court rejected its fair use defense. The Court said those 300 words were the heart of the memoirs, that *The Nation*’s scoop interfered with the market

for the Ford memoirs, which “is undoubtedly the single most important element of fair use,” and that an author’s “right to control the first public appearance of his expression” is a “key” factor weighing against quoting a work before it is published.⁵⁸

Seven years later, Congress amended §107 of the copyright law to make clear that “the fact that a work is unpublished” shall not “bar a finding of fair use.”⁵⁹ And the Supreme Court itself soon abandoned the idea that the fourth factor – the market for the original work – is necessarily the most important. The case involved the rap music group 2 Live Crew, which had requested and been denied permission to use music from the Roy Orbison song, “Oh, Pretty Woman,” in a raunchy parody. An appeals court, following the statement in the *Sony* case that every commercial use is presumptively unfair, had ruled against 2 Live Crew without much consideration of the other fair use factors. The Supreme Court reversed.

The Court noted that 2 Live Crew’s creation, although not great art, was a genuine parody of the Orbison song that commented on “the naiveté of the original” by rejecting “its sentiment that ignores the ugliness of street life.”⁶⁰ By its nature, the Court said, parody must “conjure up at least enough” of the original “to make the object of its critical wit recognizable.” To the extent that a parody, or any other new work commenting on an earlier one, is transformative, superseding the original creation with something new, it has a strong claim to fair use.⁶¹

As for the commercialism of 2 Live Crew’s recording, the Court said that just as “the mere fact that a use is educational and not for profit does not insulate it from a finding of infringement,” neither does “the commercial character of a use” bar a finding of fairness. If it did, then “nearly all of the illustrative examples” in the fair use statute would be meaningless, for news reporting, comment, scholarship, and research are usually done for pay, and as Samuel

Johnson said: “No man but a blockhead ever wrote except for money.”⁶²

Finally, in contrast to its earlier overemphasis on the fourth fair use factor – the effect of the copying on the market for the original work – the Court now gave it no more weight than any of the others.⁶³ It sent the case back to the lower courts to make the final decision on fair use.

Fair Use and the Problem of Unpredictability

Asserting fair use has always been difficult because of its unpredictability. Each case turns on its particular facts. Since the four factors are malleable and partly subjective, even a rigorous analysis of each of them doesn’t necessarily predict the result.

For example, even though the Supreme Court recognized 2 Live Crew’s parody of “Oh, Pretty Woman” as a probable fair use, other rap music borrowings have not fared as well. One of the early court decisions on sampling, in fact, did not even mention fair use – the court simply quoted the Old Testament (“thou shalt not steal”) and left it at that.⁶⁴ Some later decisions recognized the importance of borrowing to musical creation,⁶⁵ but the legal uncertainty surrounding sampling, along with the clearance culture, has greatly undermined the creativity of hip hop artists.

Fan sites and fan fiction also exist in legal limbo. Fan sites’ musings, gossip, photos, reviews, plot summaries, transcripts, and use of copyrighted characters in new (and sometimes risqué) fictions mix original commentary with borrowed material in a way that should have a strong claim to fair use. Yet entertainment companies generally view any copying – and sometimes even paraphrases – as infringement.

The decided cases aren’t typical of fandom because they tend to involve highly commercial efforts to exploit copyrighted works. A court ruled in 1993, for example, that a book consisting largely of detailed summaries of episodes from the *Twin Peaks* TV show did not qualify for fair use. A book of “Seinfeld” trivia met the same fate; in both cases, the courts found much more

direct copying than transformative use, and a for-profit motive that interfered with the copyright owners’ potential market for “derivative works.”⁶⁶ But when novelist Alice Randall copied plot elements and characters from *Gone With the Wind* for purposes of parody and critique, an appeals court found that the fair use defense was available, and reversed an injunction that had suppressed the book.⁶⁷

Political commentary also has a strong claim to fair use. One court accepted the defense where a cult de-programmer got hold of a private seminar’s course manual, hired two experts to critique it, and then posted their reports, which quoted the manual, on his Web site.⁶⁸ But a newspaper that published six standardized tests in their entirety in order to stir public debate about their educational value lost on fair use; the judge thought that the paper could have made its point by quoting only parts of the tests.⁶⁹ And a satirical look at the O.J. Simpson case, rendered in the doggerel rhyme scheme of the *Dr. Seuss* books and borrowing some of their signature images, was ruled ineligible for fair use largely because it wasn’t a true parody – it did not ridicule Dr. Seuss but simply copied his style and characters to tell a version of the Nicole Simpson murder story.⁷⁰

Similarly with news reporting, even though it is specifically mentioned in the fair use law, judges’ conclusions are hard to predict. When a TV station broadcast 30 seconds of video footage documenting the Los Angeles police beating of a civilian, an appeals court said this took the heart of the video and affected owner’s ability to market it; it reversed a lower court ruling in favor of fair use.⁷¹ When Reuters distributed the same tapes to its subscribers without authorization, the courts balanced the factors and again found no fair use.⁷² But when Court TV used parts of the footage to promote its coverage of a trial of some of the officers involved in the beating, the court found fair use.⁷³ And a newspaper that published a nude photo of Miss Universe Puerto Rico without authorization was engaged in fair use because, according to the court, the photo was “particularly newsworthy.”⁷⁴

In 2000, copyright expert David Nimmer independently analyzed the four factors in every federal court case on fair use since the Supreme

Court’s “Oh, Pretty Woman” decision in 1994, and came to a sobering conclusion. Nimmer found virtually no correlation between his objective four-factor inquiry and the courts’ ultimate rulings on fair use, or on any of the factors. That is, he found that judges tend to “align the four factors” to fit the result that they think best, rather than evaluating them objectively. Nimmer concluded that “had Congress legislated a dartboard rather than the particular four fair use factors embodied in the Copyright Act, it appears that the upshot would be the same. . . . It is largely a fairy tale to think that the four factors determine resolution of concrete fair use cases.”⁷⁵

Other scholars have been equally vocal about the unpredictability of fair use. Michael Madison describes the doctrine as “so fragmented as to make it useless as a predictive device,” and abstract “to the point of incoherence.”⁷⁶ Kenneth Crews says: fair use “has been derided as among the most hopelessly vague of legal standards”; it causes “ample confusion among lawyers and laypersons alike, who often need to understand its nuances and live by its tenuous and fragile principles.”⁷⁷

Nevertheless, Crews adds, fair use “is an essential element of effective communication and education,” and “a crucial bridge for the widespread sharing of ideas.”⁷⁸ Although the bottom-line issue is always whether an unauthorized use is basically fair, the four factors, and the examples listed in the statute, are still the best guide to how that fairness question should be resolved.

Free Expression, Fair Use, and Trademark Law

Trademarks and “service marks” – those ubiquitous slogans, signs, and symbols that pervade our culture – are governed by a separate legal doctrine from copyright. Yet the free expression problems that arise with overly zealous attempts to enforce trademark rights are similar to the fair use dilemmas in copyright law; and often, companies make both types of claims.

Trademark is governed by state law and the federal Lanham Act, whose basic purpose is to

protect consumers by enabling them to rely on well-known marks to identify quality goods and services. The law prohibits businesses from trying to pass off shoddy products using the good names of established brands.

The first requirement for a federal trademark suit, therefore, is that someone has improperly used, “in commerce,” a logo, set of words, or other “registered mark” in connection with the “sale, offering for sale, distribution, or advertising of any goods or services.”⁷⁹ “Commerce” has a broad meaning, but sometimes a court will find that a borrowing doesn’t pass this minimal threshold. For example, an advocacy group’s use of the term “Star Wars” to oppose the Reagan Administration’s military defense plans was held not to be “in commerce.”⁸⁰

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“It is largely a fairy tale to think that the four factors determine resolution of concrete fair use cases.”

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The second requirement is that the borrowing create a “likelihood of confusion” with the trademark owner. If consumers will probably not be confused about the source of the product or service, there is no trademark infringement. In many cases, the courts don’t need to address fair use or other possible defenses because there is no real likelihood of confusion. A good example comes from a suit brought by Hormel Foods, makers of Spam, against the producers of a film comedy with a porcine Muppet character called “Spa’am.”⁸¹ Likewise, when Fox Broadcasting sued Al Franken for borrowing its slogan, “fair and balanced” in his book *Lies and the Lying Liars Who Tell Them: A Fair and Balanced Look at the Right*, a federal judge found the suit “wholly without merit,” because “there is no likelihood of confusion as to the origin and sponsorship of the book.”⁸²

But confusion is a malleable concept, which means that courts may overlook free expression

concerns when a defendant lacks the charm of a Muppet. The pornographic movie *Debbie Does Dallas* was found to cause confusion because it used the trademarked costumes of the Dallas Cowboys cheerleaders. (The court’s bias was apparent in its description of the movie’s “gross and revolting” content.⁸³) On the other hand, *New York* magazine’s use of trademarked elements of the *Old Farmers Almanac* in a sexually tinged Christmas issue was held not to create any serious confusion. The court found not only that the magazine “made it sufficiently clear” that the reference to the *Almanac* was a joke, but that *New York*’s First Amendment right “of commentary and artistic expression” outweighed any harm to the *Almanac* that might arise “even if there was some confusion as to source or origin.”⁸⁴

Trademark law also has two fair use defenses, but they are narrower and more specific than the freewheeling fair use factors of copyright. The first, “classic” or “descriptive” fair use, occurs when a phrase or image is used simply to describe, rather than to identify, a product

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– for example, describing a cereal other than “Kellogg’s All Bran” as consisting of “all bran,” or describing a fish batter with words similar to the trademarked “Fish-Fri.”⁸⁵

The second, or “nominative fair use” defense, arises when a trademark is used to identify a product or service, but not to deceive the public or sow confusion. One way to understand the difference is that classic fair use occurs when somebody uses the contested trademark

to describe his own goods or services, and nominative fair use occurs where the mark is used to refer to the goods or services of its owner, as in comparative advertising or appropriationist art.

Thus, Tom Forsythe’s “Food Chain Barbies” were nominative fair use.⁸⁶ When a former *Playboy* model used the *Playboy* trademark in promotional material describing her career, she also qualified for nominative fair use.⁸⁷ And when New Kids on the Block sued *USA Today* for using their name in connection with a telephone poll asking readers to identify their favorite member of the group, the court said it was nominative fair use because the paper used only as much of the mark as was necessary to identify the group, and there was no suggestion of sponsorship or endorsement.⁸⁸

Because these fair use defenses are narrower than their copyright law cousin, the First Amendment also comes into play in trademark cases. (In copyright cases, the Supreme Court has said, no First Amendment scrutiny is needed unless Congress changes the “traditional contours” of the law, which already includes fair use and other free expression safeguards.⁸⁹) Courts confronting First Amendment-trademark dilemmas usually balance the owner’s (and public’s) interest in avoiding confusion against the rights of artists, satirists, or other commenters to use the trademarks in making their point. Or, in a variation on this theme, courts apply the “likelihood of confusion” test stringently, in deference to the free speech rights at stake.

So, for example, in two of the many lawsuits brought by Mattel to try to stop unauthorized uses of Barbie – one involving Forsythe’s culinary parodies; the other a rock ’n roll song that mocked the pulchritudinous doll – the artists’ First Amendment rights weighed heavily in the balance.⁹⁰ Another court found that a comic book parody of bodybuilding ads had First Amendment protection that outweighed the slim likelihood of confusion with an actual bodybuilding company.⁹¹

And when the actress Ginger Rogers sued distributors of Federico Fellini’s *Ginger and Fred* – a movie about two itinerant cabaret performers – the court found little likelihood that

the public would be confused about whether Ms. Rogers sponsored the film, and added that, in any event, whatever confusion there might be was outweighed by the First Amendment right to choose the title for a creative work. The Lanham Act, the court said, should apply to artistic works “only where the public interest in avoiding confusion outweighs the public interest in free expression.”⁹² Quoting a Vietnam War era Supreme Court case, the judges added: “we cannot indulge the facile assumption that one can forbid particular words without running a substantial risk of suppressing ideas in the process.”⁹³

Not all First Amendment defenses fare so well. In 1994, Anheuser-Busch won a suit against political parodists who attacked its environmental record with mock advertisements featuring “Michelob Oily.” The phony ads concluded with the remark: “at the rate it’s being dumped into our oceans, lakes and rivers, you’ll drink it oily sooner or later.” Taking a tone-deaf approach to the parody, the judges emphasized that the defendants “possessed no knowledge that any Anheuser-Busch product actually contained oil.” They dismissed the parodists’ free expression defense; then decided there was a serious likelihood of confusion based on a survey conducted in St. Louis shopping malls.⁹⁴

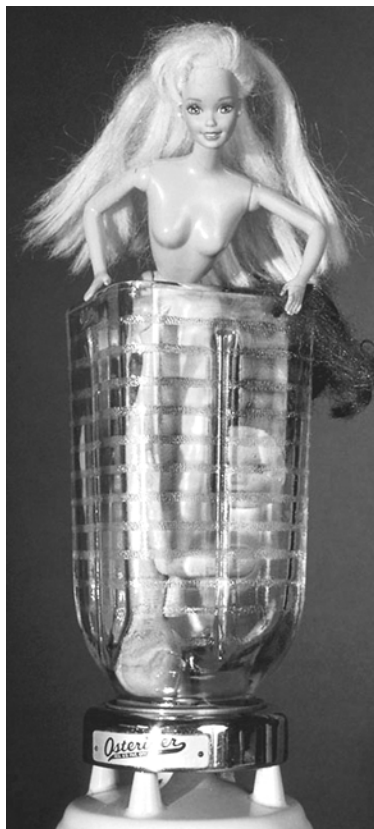
In 1995, Congress added a new prohibition to the law: “trademark dilution.” Its purpose is to prevent the weakening of a mark by blurring its “distinctive quality,” or the “tarnishment” of a mark by disparaging it or associating it with shoddy or unsavory goods. No likelihood of confusion is required.⁹⁵ As applied to such misleading labels as “Tylenol snowboards” or “Harry Potter dry cleaners,”⁹⁶ the ban on trademark dilution presents few free expression problems. But applied to political

critiques that necessarily “tarnish” a company’s identifying signs and symbols, it threatens First Amendment rights.

The dilution law does have free expression safeguards: allowances for comparative advertising, news reporting and commentary, and any “noncommercial” use of a mark. But courts have sometimes been slippery about the noncommercial use exception; one judge stretched to find that a Web site critical of Jews for Jesus was commercial because it had *impact* on the group’s commercial activities.⁹⁷

On the other hand, the court in one Barbie Doll case, citing First Amendment concerns, read the “noncommercial use” exemption to protect parodies and other critiques.⁹⁸ Another court dismissed a suit by Rev. Jerry Falwell against a critic using the URL www.falwell.com, noting that Congress “did not intend for trademark laws to impinge the First Amendment rights of critics and commentators.”⁹⁹

One further amendment to the trademark law goes by the cumbersome name of the Anticybersquatting Consumer Protection Act,¹⁰⁰ and prohibits Internet domain names that are “identical or confusingly similar” to each other, but only where there is a “bad faith intent to profit” from the confusingly similar name. This limitation gives free speech protection to dissidents who register “thiscompanysucks.com” or similar monikers without a profit motive, but simply to criticize corporate malfeasance. Thus, both dissatisfied customers and social critics have been allowed to use URLs very similar to the companies they critique. As one judge noted, Internet surfers are by now “inured to false starts,” and they will keep searching if they come upon a “.sucks” or similar gripe site when they are looking for something else.¹⁰¹



Tom Forsythe, “Every Barbie for Herself”

But a different judge found sufficient hostility and bad faith to prove a cybersquatting violation when critics of the animal rights group PETA registered the domain name “peta.org” (for “People Eating Tasty Animals”).¹⁰² This decision has been criticized for its overly broad reading of the Lanham Act’s “in commerce” requirement,¹⁰³ but there was certainly evidence of bad faith, because peta.org’s operators had registered more than 50 domain names and evidenced a clear intent to sell this one to PETA.¹⁰⁴

Many accusations of cybersquatting are not resolved in court but through a Uniform Domain Name Dispute Resolution Policy, or “UDRP,” established by the Internet Corporation for Assigned Names and Numbers (“ICANN”). One advocate says that although the UDRP is much cheaper than litigation, it is a risky

alternative for cybercritics, because it is “run by organizations biased in favor of trademark holders.” Nevertheless, he notes there are many UDRP decisions that favor the “gripe site” owner.¹⁰⁵

For example, UDRP arbitrators ruled in favor of fan sites using the name of the deceased rap star Tupac Shakur, and the Nintendo game “Legend of Zelda.” In the first case, the UDRP allowed the fan site to keep its domain name because it contained legitimate commentary, was noncommercial, was established in good faith, and included a statement disclaiming any relationship with the official site. In the “Legend of Zelda” case, the arbitrator found no legitimate purpose and a confusingly similar domain name, but no bad faith, so the 15 year-old fan site owner prevailed.¹⁰⁶

CHAPTER 2

Quoting Sartre, Using Prokofiev, Painting “Molotov”: The Focus Groups

To learn how artists, writers, and scholars experience the tension between IP ownership and free expression, we conducted four focus group discussions, with members of PEN American Center, Women Make Movies, the College Art Association, and Location One Gallery in New York City. Each discussion reflected different concerns, but there were also common themes – in particular, the difficulty of getting accurate information about fair use, and adequate help in protecting free expression and fair use rights. The participants expressed differing opinions about what constitutes fair use, not all of them accurate. They also described confusing, frustrating, and sometimes exhilarating experiences.¹⁰⁷

PEN American Center

Seven writers participated in the focus group, which met on February 28, 2005. Roxana Robinson writes short stories, novels, and biography. Andrew Hultkrans writes on music and is interested in sampling. Daniel Meltzer writes fiction, drama, and newspaper columns, and is planning a book about broadcast journalism. Betty Fussell writes nonfiction, including “a lot on the history of food, cookbooks, and recipes.” Hannah Pakula writes historical biographies. Hazel Rowley is also a biographer; her subjects have included the writers Christina Stead, Richard Wright, and most recently, Simone de Beauvoir and Jean-Paul Sartre. The seventh participant, who writes fiction, nonfiction, and poetry, asked to remain anonymous.

Roxana Robinson encountered a fair use problem with her first book, the novel *Summer Light*. She quoted two lines of the popular song “Don’t Stand So Close to Me,” by The Police – “and my editor said, ‘you have to get permission.’ So I have to call Hollywood. I don’t

know how I got the number, but I get this man who’s audibly tan and I say, ‘I’m hoping that you’ll give me permission.’ He said, ‘yeah, you can have permission and it’ll be \$5,000.’ I said, ‘that’s double my advance. This is a small literary novel.’ I said, ‘I can’t pay that.’ He said, ‘it’s a very popular song.’ I said, ‘I know, but the book doesn’t depend on including these words, so if you make it \$5,000, I’m not going to include them.’ There was a long pause, and he said, ‘would my mother like this book?’ I said, ‘yes; I absolutely guarantee it.’ He said, ‘okay. Send a copy to me and a copy to my mother and you can have it.’”

This experience was lucky for Robinson, but was the publisher correct that her brief quotation required permission? Industry practice may dictate permission for just two lines, but there is no such firm rule in the law.

Our anonymous participant had a different approach, at least at the start of his career: “Since I have a doctorate in English and I began writing in the golden age of deconstruction, my intellectual life had at its foundation the notion that I could steal creatively. In my first book, it didn’t even occur to me that you have to ask permission to quote poetry when you were doing a service to make commentary on it.¹⁰⁸ That was naïve. And I realized that you can’t even quote a popular song without getting permission. I’ve paid a lot of fees. But there are many things I haven’t published because I haven’t had the heart to bother asking permission.”

Betty Fussell added: “I grit my teeth – it is simply insane, and every book I have done, of the ten, I have come across fair use issues. Once I quoted two lines from A. A. Milne, “What can be the matter with Mary Jane?/It must be we’re having rice pudding again.”¹⁰⁹ This was a little cookbook, and to my astonishment, I had to pay \$250. That opened my eyes. It also infuriated me on principle.”

Roxana Robinson described her second book, a biography of Georgia O’Keeffe. “She had just died; there were three lawsuits going on [battling over her estate]. Everyone was at each other’s throats. So I was incredibly careful. I had to type out every single quote I wanted to use of her letters, and send those to the Georgia O’Keeffe Foundation. One member of the Foundation was completely opposed to my writing the book, and he would not give me any permissions at all that he was responsible for.

“I was told by my publisher that fair use was 15% of whatever the text was. Those numbers are branded in my brain. 15% of the letter, or perhaps 15% in the page of the book I was quoting from, called *Georgia O’Keeffe* by Georgia O’Keeffe. So I had to go through that book and practically count the words on every page and allow myself 15% of that. I felt that I was skating on the edge of this dangerous chasm and if I fell, I could be sued.

“At one point, late in the process, I discovered a trove of letters that no one had ever seen, between O’Keeffe and, probably, her first romantic lead. I wasn’t going to have time to clear them through the O’Keeffe Foundation. But I thought it would be too much for the man who owned them to suddenly see them spread out in this biography. So I was very careful about those, just because of internal conscience. Which I think now was foolish. I think I should have used them just as much as I wanted to. But as a biographer, I was very conscious of the other side. You are using other people’s lives, or other people’s works or thoughts, and so it is a really difficult question to balance.”

Hazel Rowley described a different experience with her Richard Wright biography. “I took an immense risk because Ellen Wright, his widow, had sued a previous biographer, Margaret Walker. I had been warned that Ellen Wright was very difficult. I knew I would get nowhere by fronting up to her at the beginning, saying ‘Will you sign this form giving me permission to quote from unpublished letters?’ So I wrote the whole biography, four years of work, taking the risk that she might not give me permission to quote from unpublished material. I spent three months in the Beinecke Library at Yale, which has a massive amount of exciting material. It would

have killed the book if she’d refused. If there’s one thing worse than being a white Australian woman writing about a black American man, it would have been not to be able to bring his voice in. So the risk I took, when I look back, was enormous.

“Ellen Wright was savage about Margaret Walker, who had quoted letters from Wright to Walker. Of course, Walker, the recipient of the letters, did not own the copyright. So Ellen Wright sued her, but she lost.¹¹⁰ I came along a few years later with my biography. I wrote the book the way I wanted to write it, just as if she’d given me permission to quote from unpublished letters. I sent her some articles I published along the way, which she liked. When I’d finished, I went to Paris to see Ellen, and had lunch with her. Halfway through the lunch, I casually said I would need copyright permission from her. She asked whether the publisher would pay for the permissions. I said, ‘Sadly, not.’ She asked me to send a word count to Wright’s literary agent. She said she thought I had done a good job, and my book would revive interest in Wright. She would discuss the price with Wright’s agent, but she’d try to keep it low. She understood that I didn’t have much money. To my amazement, she never asked to see the manuscript. I didn’t mention that some of the unpublished letters I had managed to find were not among those in the Beinecke Library; indeed, they were love letters that Ellen Wright would find deeply hurtful. Ellen gave permission, for a very reasonable fee.

“I had a fellowship for two months to study at the Beinecke and took an immense amount of notes. I think American copyright law takes into account that there is no point in giving scholars access to material if they can’t quote it even minimally. I boned up on fair use. It is certainly not 15%, in my understanding. It is far more minimal than that. The most I allowed myself from the love letters were eight words a letter, ten words maybe, in a letter of a page or two. Publishers never seem to know much about it. It’s quite extraordinary. It’s more a matter of ringing around talking to any copyright people who know something. And looking on the Internet. It’s inordinately difficult to find out.”

Rowley’s last book was about Sartre and Beauvoir. “Sartre’s published estate is mostly

owned by Gallimard [the French publisher]. But the unpublished estate is in the hands of the woman whom Sartre adopted when she was in her 20s, Arlette Elkaïm Sartre. And Beauvoir's adopted daughter is the executor for the Beauvoir estate. When I started out on the book, I was told again, just as I was with Ellen Wright: 'There's no way you're going to get anything from Arlette.'

"I'm writing the book for Harper Collins, and from the outset my understanding was that I would have fair use of the unpublished material I got to see from Sartre. Any letters – and I got hold of hundreds – I could just do the slightest quoting, and some loose paraphrase. One woman gave me 550 pages of Sartre's handwritten letters to her mother. I quoted up to 30 lines, thinking that's all I can get away with. I paraphrase very loosely, always in my voice. My understanding is that loose paraphrasing is fine.

"I have since discovered that copyright law is different in France. I wanted the book to be published in France as soon as possible. Gallimard wanted it, but insisted that they would need the consent of the two adopted daughters. I said: 'Consent for what?' But Gallimard, which makes massive posthumous royalties from the Sartre and Beauvoir estates, did not want to risk falling out with the two heirs and literary executors. I soon found out that in France there's this thing called *le droit moral*.¹¹¹ And they do not have fair use for unpublished material. You cannot quote and you cannot paraphrase, even loosely, without permission.

"So the manuscript was sent to both daughters, and the Beauvoir daughter says fine, and the Sartre daughter says to Gallimard: 'If you publish that book, I'll take away the entire Sartre estate from you.' In other words, Gallimard won't be publishing this book. Then Arlette told me that even interviews with her or with Sartre, I'd have to cut out all the quotes. Well, luckily on that score I was safe. The interviewer has the copyright on them. But she also said I would have to take out all paraphrasing from the letters. Harper Collins' lawyer was at first very laid back and said, 'we'll publish it as is, and we'll show up the French.' But my editor at Harper Collins said, 'Hazel, we can't have two editions. We have sold subsidiary rights to

England, for example. They've bought in good faith with the understanding that they can distribute that book at least to English-speaking bookshops in Paris.' She says if it's smuggled into France in any way, even through Amazon, the English publisher could get sued and they can sue HarperCollins US, and everybody's very unhappy, and therefore, I have to make these cuts.

"I'm refusing to make the cuts. I'm saying I worked within American law, and that the book is fine in this country.

"I don't think you can be a biographer without being a fiercely determined kind of person. And the fact that I got to see these letters from various women around Europe is in itself fairly amazing. So I'm not going to give up a fight just like that.¹¹²

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"This is a subject that works us all up, isn't it?"

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"I find the whole copyright thing enormously arbitrary. Some people charge you \$350 for five lines. Some charge you nothing for several pages. There are no rules, so you're always in a rather stupid, mendicant position as a permission seeker. Harper Collins did tell me that they had someone that would do it for me, but I didn't feel like paying several thousand dollars for somebody else to do it. Also, I frequently managed to negotiate the prices down. I can't imagine the person to whom Harper Collins contracts out this job doing that for me.

"But oh my god, the problems you can have! I have quoted quite a bit of Nelson Algren [Beauvoir's lover at one time] – previously published material. The Algren copyright holder is a literary agent in New York. Over the months, he did not answer my emails, he did not answer phone calls, he did not answer letters. I had to approach him through intermediaries. He asked to see the entire manuscript. He wanted to check that I'd portrayed Algren sufficiently positively. It's really insulting. This is a subject that works us all up, isn't it?"

Betty Fussell agreed: “As everything has tightened up, the definition of intellectual property applies to everything. Have I fought publishers on this! Because it was the publishers who were saying you have to get permission for any reference to a recipe. And I said, ‘that’s not true.’ I got somebody to look up the law in the Copyright Office. It says that how-to manuals of instruction are exempt from copyright. Because it’s shared knowledge. How to fix a bicycle tire – that cannot be copyrighted. And recipes are the same.¹¹³ The nature of recipes is shared oral knowledge.”

Women Make Movies

Nine members of Women Make Movies met on April 14, 2005. Jason Wulkowicz is a documentary filmmaker who, with his wife, is working on their first independent film. Faith Pennick is a director and producer of documentary and narrative films. Laura Poitras and Samantha Farwella are also documentary filmmakers. Michelle Coe is the Production Assistance Program Coordinator of Women Make Movies. The four other filmmakers asked to remain anonymous.

Our four anonymous participants were also the most specific in describing experiences with fair use. Their desire for confidentiality may reflect the particular difficulties faced by documentary filmmakers, whose work typically includes historical photos, relevant visual art and music, and trademarked logos or snatches of song played on a radio in the course of filming. Yet they are running a risk any time they fail to get clearance. As one of the group recalled, “Going to film school, it was drilled into my head you have to get people to sign everything. You have to get festival rights, get this, get that; it’s just automatic. No discussion of fair use in film school.”

Having learned little or nothing about fair use during their professional training, and working in a field with an intense clearance culture, these artists were struggling to understand fair use. Wulkowicz expressed the experience of several in the group: his first independent film is “about the women who worked behind the scenes in the golden age of television.” When he worked for

others, he said, licensing was mostly “somebody else’s problem. Now, dangerous new waters. We finished shooting, so we’re in editing now. We’re making decisions about what we can and can’t use, and another factor that comes into it. With the fair use side of things, do you purposely alter your work so that you have somebody commenting on what’s being seen, just so that you can use it, as fair use?”

He explained: “If you have somebody who worked on a Studio One broadcast, and it’s part of a montage of a series of works that this woman has directed, but she doesn’t mention each one specifically, or talk about that episode, then it seems like it’s harder to argue fair use, and so, in order to try and tell a story about this period, do you need to make everything into a little vignette: ‘oh, I remember when so and so tripped on a hammer?’”

“We’re thinking fair use as a last resort, ’cause it’s too tricky, and because as soon as you ask for permission, you don’t want to just say, ‘well, we’re going to do fair use anyway.’ Our first approach is to ask permission.”

Faith Pennick was also in post-production, “on a documentary that I directed called *Silent Choices*,” and was dealing with the copyright issues for the first time. She thought perhaps fair use applied to “a spontaneous news event and you’re there with a camera. Then, as far as the people or things that are in the frame of what you capture, people can’t say, ‘Well, you can’t use that, ’cause I didn’t sign.’” Then she asked, “or is that different from fair use? If you’re trying to get footage for something, as opposed to using the footage that you shot without getting release forms signed?”

One of our anonymous participants had a clearer understanding, based on an experience with PBS: “If your use of the material is commenting on the subject of that material, it’s fair use. For instance, I worked on a PBS show that was about independent film, and we showed a clip from every filmmaker’s work, because we were commenting on that work. We were interviewing them or having discussion about it. We did not get clearances. Our lawyer looked at it and felt it was fair use.”

One of her colleagues responded, based on readings she had found on the Internet: “If it’s

used for non-commercial purposes. It also has to be sort of short and can't be a reproduction of the whole image or the whole sound. And it can't lessen the commercial value of something. These are things that I've been reading."

"I have a lot of fair use," she added. "I'm working on a film about a painter who was a member of the Russian *avant garde*, and half the story is constructed images with photo montage. So I take segments from various photos – PhotoShop and After Effects give you a lot of freedom. If you take an image from a photograph, take a little section and start to manipulate it or take it out of context, is that fair use? The technology has presented all kinds of possibilities for artists."

"I also had a music situation – music that I wanted to use, and one of the composers was Shostakovich. I wanted to use segments from pieces. These are synchronization rights – I would hire the pianist to do the performance.¹¹⁴ I thought it would be a piece of cake. No way. It was extremely complicated. Different publishers publish Shostakovich. I had to figure out which publisher has the right to license Shostakovich in North America. It's Schirmer, by the way."

"One of the clearinghouse people I talked to said, 'Maybe you can get away with fair use, if it's educational. Is this meant for an educational audience?' And I just didn't want take the risk. I was just like, 'I'll just stick with public domain.' If I was caught, it would be really expensive. I did talk to someone at Schirmer's, and she gave me their typical prices, and it's like 15 cents per DVD copy, for a minimum of \$5,000 for five years, and you have to add on to that the non-theatrical rights. There are layers, and it was just too much."

"Let's say I wanted to use the Shostakovich Preludes – 30-second segments from seven of them. In terms of fair use, is that a small enough segment? Or do you judge per Prelude as a composition? That was unclear to me. Fifteen cents times seven times \$5,000 for five years, and now I have another layer of the non-theatrical, and also they mentioned film festival rights, and that was just North America. And then if it had any potential somewhere else, in terms of public television, whatever, that's a whole 'nother thing."

"I also wanted to use Prokofiev, but I found a public domain publisher, so that was great."

Another member of the group admitted that she "had no idea" about fair use. She wanted to copy from a Frank Capra film about World War II, part of the *Why We Fight* series.¹¹⁵ She hired somebody to trace the rights, and "it turned out that Capra was hired by the government, so I didn't have to pay for the right to use three seconds of it."¹¹⁶ But the film was for PBS, which requires E&O insurance. "That requires you to have a lawyer, and that adds up. I had to hire my own lawyer to get the E&O insurance. It cost me \$250, and he got it in writing that this particular piece was public domain."

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*"The technology has presented
all kinds of possibilities
for artists."*
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"I had another experience, with *The Wizard of Oz*, just in case you ever think of using it. I was making my own experimental documentary, and I was going to use maybe 10 seconds. It was the first film I saw when I was a little girl, and it left such an impression on me. I called the Turner Library in Atlanta; the minimum fee is \$5,000 for one minute. Any more than that, a lot more. I decided that was not an important experience after the \$5,000 price tag. I never even learned that expression fair use. I just thought: copyright – call right away."

Another participant, who just completed her first feature, said she had "cleared a lot of the rights myself because I didn't have money to have anyone help me. Actually, I find if you go to the artist first, and you get their blessing, the label will often follow. My current film is about a bipolar artist who tried to take her life, and there's some music in it. She was in a music video in 1991. I needed that footage, which comes at a wonderful time in the film. I knew I needed to get it, and I actually almost did think about fair use for that. But I got a little scared, so I waited, and lined up all these other little successes to say,

well, this and this person gave it for free. I got very fond of that music and couldn't bear not to use it, and found the person through various sources, and he said he wanted to see it. It took him a month and a half to watch; then he called and said, 'Tough film, but, yeah, go ahead and use it.'

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“The technology is changing. We have digital, we have online. It's changing and we have to change with it.”

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Samantha Farwella expressed the same uncertainty. “My feature film was a documentary, with a lot of music, and I knew most of the musicians, so I went right to them even if they had labels, and I got the stuff that I needed. The other film I made, about 9/11, I used some of my own footage, but other stuff was just all over the place. I assumed it was illegal. I used found footage from two films, *Atomic Café* and *Baraka*. I used “Idioteque,” which is a Radiohead song. I actually wrote to Radiohead and never heard back from them. A lot of times people just don't respond to you if you're not that big. I still put the film in about ten festivals. They're all ‘Ladyfests,’ so it's not really on the radar.

“I didn't want to make a profit from it, but it's frustrating, because the big guys like Sony can take away people's rights. It works both ways for them, basically. They can sue you for using – and then, if you give them your music, they make profits off it, so I think in certain aspects, we need to look at different levels of control, maybe letting some control go for some of us.

“The technology is changing. We have digital, we have online. It's changing and we have to change with it. We need to find new avenues and I think Creative Commons is something that everyone should look at. It's a place where they take out the middleman. You can authorize others to use your work. A friend of mine put his song on there, and then another person put a

violin to it, and then somebody put audio to it, and it just keeps going.

“In fact, I have a question for anyone here. My feature film that I thought I was very meticulous in getting permissions on, there are two scenes in it. One is where someone is driving in the car, and he starts singing ‘Tomorrow,’ from *Annie*. Just a couple of bars. And I'm thinking now: ‘uh-oh. Does it count as incidental use? Do you want to risk that?’”

“Incidental use” came up repeatedly in this focus group. Laura Poitras described her film *Flag War*. “A character was singing; a radio was playing the background. We worked with the clearance house, Diamond Time. They looked through it, and what we were told was, ‘incidental’ – it's a balance between how much it pushes the story forward and how much it happens to just be circumstantial. The radio comes on, and you go with it and you're using it to push your story along, as opposed to something that just had happened in the moment. They said you probably want to clear it. The cost was prohibitive. So, we lowered the volume way down.”

Diamond Time's distinction between incidental use and “pushing the story along” has some legal support. When artist Faith Ringgold sued Black Entertainment Television for using a poster of her “Church Picnic” story quilt as part of a set decoration, a federal court ruled that the use was not “incidental”; the station had used the work “for precisely the decorative purpose” that the judges thought Ringgold had in creating it.¹¹⁷ On the other hand, a court found that a news broadcast's use of about one minute of a song played by a band during a parade was fair use precisely because it was central to the story.¹¹⁸ An image or quotation does not have to be incidental or irrelevant to the story to qualify as fair use; indeed, the less incidental the borrowing is, the more necessary it may be to “conjuring up” the original work. Incidental uses might, however, qualify as *de minimis* – that is, not even significant enough to raise an issue of copyright infringement.¹¹⁹

Equally problematic as incidental music in documentary films is the appearance of brand-name logos and other trademarks. One participant commented: “They're everywhere. I

cut a scene from a film because there was a big cup with this gas station trademark on it, but the problem is, you can't go into a store, you can't buy anything that doesn't have a logo on it. So they don't give you the option of having a cup with no logo, but I was like, 'oh god, I didn't realize that cup had this huge logo in the side of the frame.'"

Why did she think this would create a problem? "Because the subject of the film was coming clean about an addiction. It's a very heavy scene. It's not pretty in any way, and I don't think they would have wanted to be associated with it."

But as another member of the group commented: "That's the environment in which we work. You can't just put somebody in a chamber."¹²⁰

Often the filmmaker resolves the problem by blurring the logo. Wulkowicz said: "Maybe you could use it until you're told you have to blur it. But you see everything being blurred now, because for the first time, we're able to do that technically without it being a big deal."

The College Art Association

Ten people participated in the College Art Association focus group on May 10, 2005. Brian Hughes is a graduate student in art and education; Jonathan Talbot is a collage artist; Barbara Levy is an artist and gallery owner; Eric Gray is a photographer; Tony White is an assistant professor, artist, and librarian. Joy Garnett is a painter who has long used found photographs in her work. Sandra Camomile is a professor of digital art and a studio artist who also appropriates found objects. Alysa Cardone is an assistant professor in visual and performing arts at a community college in the Bronx. Frima Fox Hofrichter is a professor and art historian. One participant asked to remain anonymous.

Brian Hughes began the conversation: "I had a show at my school where I took images of Picasso's 'Weeping Woman' off the Web, and using the thumbnails, remixed them. It's just me, the thumbnails, and PhotoShop. One of my confusions with that was, okay, this is fine with the work I do; I can justify this as research. But I was curious if I can slap a Creative Commons license on my remix images and encourage others to keep going. The boundaries were unclear for me where I became a user of another person's copyrighted images."

Jonathan Talbot explained that he'd worked in the music industry; some of his music "even made the charts," which "doesn't mean I've ever seen a penny for it. When I went into the visual arts,

I looked at my experience in the music business, the fact that copyright protection had not helped me at all to get the money that was due me, because it was never quite enough money to pay the attorneys to get it for me. So I became a painter. Then I became a collage artist. And now I expropriate everything. I have taken a good look at how Picasso expropriated. And I guess that if I'm to pick a role model, Picasso's a good one.

"I've only asked once for permission. That was a Joseph Cornell piece which I like, and I have done 50 or 75 compositions based on it, not on the imagery but on the geometrical layout. And in teaching, I want to show people how art evolves. So I show them what I did with this Joseph Cornell piece. I put it in PowerPoint. And I thought I better ask the Joseph Cornell folks if I could use it. They sent back a very nice letter that said, 'By all means as long as you're just using it to teach people.'

"I guess I should add one caveat: I'm aware that Rauschenberg got sued and lost.¹²¹ And when I explain to people that there are things



Marcel Duchamp, "The Urinal"; © 2005 Artists Rights Society (ARS), New York / ADAGP, Paris / Succession, Marcel Duchamp

you can do with the pages of *Time* and *Newsweek*, in terms of transferring images, I tell them that they better get permission first. I try to cover my behind, but I never get permission.”

Sandra Camomile added: “[Marcel] Duchamp happens to be one of my huge influences, and I think that his appropriation of the urinal definitely steps on somebody’s design work. When I pull images off the Internet, I’m using found objects.”

Joy Garnett uses a similar process, drawing inspiration from photographs, often anonymous ones, for the imagery in her paintings. “Part of the subject of my work is the relationship between found sources, such as photographs, and the transformative act of painting. Originally, I had gone from science imagery to declassified government imagery. None of that was problematic. Then I did a project where I started pulling images from the mass media, mostly from the Web. I mounted a show in January 2004 of about eleven paintings, of decontextualized figures pulled from news wires and Web sites. The show was called ‘Riot,’ and the theme was people in extreme emotional states. It was all kinds of people – fighter pilots and guardian angels; skinheads rioting. The sources are forgotten; that’s part of the process.

“One of the paintings, kind of the centerpiece for the show, was a picture of a guy in a beret with a cross around his neck, and he’s throwing a Molotov cocktail; he has a ponytail and he looks like a hippie. And he’s really big; it’s a big painting. So we made that the invitation card, and we sent it out.

“Halfway through my show, I get this email from an acquaintance. The subject line was the name of a famous Magnum photographer, and the content of the email was, ‘She’s coming to my studio next week. Your card is on the wall. I assume you asked her permission.’

“And I was like, ‘What are you talking about?’ He sent me the URL to Magnum, and I found the original image that my fragment, which I had found on some anarchist Web site, was from. It was a 25 year-old photograph by Susan Meiselas that was part of a famous book she had done in 1981, called *Nicaragua*. I wrote back saying, ‘I didn’t even know. How could I ask her

permission? I wouldn’t have asked her permission anyway.’ I mean, implicit in that would be that for every moment of my creative process, I would have to be concerned with finding the authors of these photographs, contacting them for permission, and dealing with their attitudes about permission.

“I didn’t contact her. A week after the show came down, my gallery and I – we have images on our Web sites – we each get a cease and desist from Susan Meiselas’s lawyer saying that this painting ‘Molotov’ is a derivative work based on her copyrighted photograph, that I had pirated the photograph, and that I had to sign a retroactive licensing agreement that would sign over all of my rights to the painting to Susan Meiselas in accordance with Magnum copyright derivative works formalities. And if I wanted to show, sell, or reproduce the image again, it wouldn’t just require a credit line to her, it would require that I got her prior written permission.¹²²

“I was completely flipped out. So I did two things. I contacted a really good copyright lawyer. And I went on to my discussion group at Rhizome,¹²³ where only moments earlier we’d been discussing the *Grey Album* and sampling – this whole area of fair use remixing, licensing, and being sued. They were incensed on my behalf. In the meantime, I went to my lawyer, who was also incensed. He thought that this was silly, that in terms of the four factors of fair use, it could be argued either way, but the main thing was I had used only a portion of the original. Whether or not an artwork is available commercially is not the whole issue. It’s also creative. It’s commentary. This comes under fair use. It didn’t in any way change the market value of the original.

“So we wrote a very brief letter saying that I was sorry; that I was not aware that I had chosen her photograph; that I was not interested in using seminal iconic famous photographs; that I was interested in photographs that had been lost. I suppose I was guilty of not recognizing her photograph. But it was famous in 1981, and I was little then. I wasn’t around during the Sandinistas. I also mentioned that I was hurt by being accused of copyright infringement when in fact I had transformed the work, and

that painting is all about quoting, referencing, copying. And I have my precedents in the contemporary art world, painters who use photography. So we I said I would not sign the form giving her rights to my work, because I have something to protect as well.¹²⁴ And in fact, that's when I began to get mad, instead of feeling like maybe I'd done something wrong. We sent out this letter, and discussion is still raging on Rhizome.

"A few days later I get a 12-page very aggressive response from the lawyer saying that instead of waiving their licensing fee, now I have to pay \$2,000. And that there was all this caselaw, as though she'd cut and pasted from Copyright 101. It didn't make any sense, and I didn't think it related to what I had done. But it was incredibly intimidating and my lawyer agreed. He was surprised that we got that kind of response because our letter was very polite and reasonable, and it was an apology.¹²⁵

"Now I believe that the whole thing was just a scare tactic to get me to take the stuff off the Web. And it worked. I called my lawyer and said I was taking my images off the Web site because I didn't want them to go to my Internet provider. I didn't want my Web site pulled. This is what I was really afraid of, because I use that site to send images to galleries, to writers, to critics.

"But here's the punch line. Seconds before I took the images off, people on Rhizome grabbed my images in solidarity. They uploaded my pages to their Web sites; then one of these artists takes my painting and flips it. He puts it up on his site, and now it's a derivative work based on my work. And everyone started making digital collage based on the Molotov image. It all turned into protest art. For the next five months, this image went global. So there are a couple of morals to this story. The idea that you can control what's going on right now in the digital realm with the older paradigm of copyright control is gone. The ideas of the new technology are part of our culture whether or not we're aware of it."¹²⁶

At the end of this story, Talbot remarked: "It seems to me you've created a wonderful situation, because I can only imagine her trying to pay her lawyer to send the same kind of letters to those thousands of people. She could never have done it. So you took it out of your personal role and

made it a worldwide thing, and you've covered your behind."



Joy Garnett, "Molotov"

Garnett replied, "Well, they did it for me. It was nice. But it was not about me. It was about the issue."

Publishing is another area fraught with difficulty for these scholars and artists. Frima Fox Hofrichter, an author of art books, said that when she has needed images, she has always sought permission, unless the publisher took care of it. Years ago, when she was writing about a then little-known 17th century artist, Judith Leyster, two collectors denied permission to reproduce specific works, "and I did not use them," even though "other art historians said I could have used them."

What made her decide not to?

"Because I asked. And I thought once I asked, then I was obligated to follow what they said, which is why people don't want to ask."¹²⁷

To this, Talbot replied: "One of my reasons for not asking is that I sell little collages for \$400, which may have 30 images in them. I don't make time to go asking questions for something which sells for \$400. Sometimes I get only \$200. If I'm

going to start writing letters for a \$200 item, I'm out of business."

Alysa Cardone described a similar dilemma in teaching. "I teach Web design, both on the high school and college level. I get a lot of projects that are what I would call fan sites. One of my groups right now is doing an *animé* site. How can they put together a Web site without using somebody else's images? It's all about *animé*. These are the issues that, as a teacher, I get very confused about. I got really worried, because the younger they are, the less they understand about stealing from the Web."

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"...sometimes, in the cause of educating people who have no money, I do copy material."

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Cardone surfed the Web for guidance. "I started searching in Google, and I found a consortium on digital rights at the University of Texas Web site.¹²⁸ I took what I thought would work for them, that they could understand. I condensed it, and put it at the end of my syllabus. I made them read it out loud the first day of class.

"And of course, as the semester goes on, I have an *animé* site. I have an e-commerce site that's using brand images, because how do you teach e-commerce marketing without them? They can't invent new products. I mean, we only have 15 weeks. So I bent the guidelines a little, but it's staying in the classroom right now.

"But my school is going to put up some of these on their Web site, to entice people into our new Web design program. And I'm really confused because what if they put up this great site, and it's all re-purposed content that they had no permission to use? Is my school going to be liable for this?"

"Another big area of concern is grants. I'm a recipient of a grant, and we're photographing and creating an oral history for this community in the Bronx, Mott Haven. The legal counsel at my school is way more concerned about human subject survey information and photo releases. But I have to make an online gallery out of this. What happens when I put all these pictures on the Web, and anybody can download them? That's a concern because I'm having these people that I'm photographing sign all these documents, and I have no control once I put that stuff up, what happens to it. We could invest in watermarking technology, but we have no extra money."

Cardone also talked about classroom use. "I do photocopy tutorials and use them in my classes. At one point, I only used stuff that was available in the public library, so that they could go and research the book themselves. But then I stopped doing that, because when I'm dealing with new releases of software, they're not in the library yet. And I need the latest tutorials. I can't force them to buy all these books. They have no money. I teach in the South Bronx. They don't even have cameras when they take my photography class. So sometimes, in the cause of educating people who have no money, I do copy material."

She doesn't think that such copying would qualify as fair use, because "my photocopy center won't do it out of the book. I have to make a flat copy on paper because they think it's an infringement if they copy out of the book. So I know that it's probably not fair use, but in the interest of education – and I'm not making any money; I'm just trying to help them."¹²⁹

Does she hold students strictly to the guidelines? "Well, I started to think about that, because I really like their site, and I want to put it up as an example of what you can do as a class. They took a Twinkie, for example, and they outlined it, and put the little *animé* character sitting on a Twinkie. Twinkie's a registered trademark. But if you look on the Web, fan sites are like that. This is a very typical fan site and this is the kind of thing that my students want to create. And in my opinion, the more interested they are in the subject matter, the more they're going to engage in it, and the more they're going to learn."

Talbot commented: “Here’s the headline: Hostess sues penniless Bronx student.”

Another participant exclaimed: “Well, it’s parody. I mean, really!”

Cardone added: “Where we work influences how we deal with this. When I worked in private publishing, it was totally not appropriate ever to use an image in the wrong way. In education, it’s a little different. You don’t want to give people the idea that it’s okay to trace and collage for money. But if I’m not making money, then it’s probably okay as long as I cite or I use things appropriately. I don’t know. How does everybody else feel about this?”

From the other side of the copyright divide, Barbara Levy described seeing images very similar to ones she had created, of a sunrise over Great South Bay in Long Island. “And I was shocked – I thought, did he just move the camera a little bit to the left, a little to the right, did he crop my thing and move the yellow somewhere else? There were six or seven images that were almost identical to six or seven images of mine. My immediate response was, oh I’m paranoid. Two people can have the same idea at the same time. But I didn’t like it.”

Eric Gray responded: “If somebody was to use my image and credit me, I’d be like, ‘Thank you. No problem.’ If they were to not credit me, then I’d start having a big problem because I would like to be recognized for it. But in photography, it’s hard to find a truly unique image. Your example, I’ve seen that image about a hundred times, I’m sorry to say. The sun and the ocean, it is a universal thing.”

What about documentary photography, which might include billboards or other objects that display trademarked logos as part of the scene? Gray thought that “if it’s in the public forum, it’s fair to have a picture taken of it” – at least, as long as it is not the main subject of the photo. Cardone gave an example: “My student took a picture of the building on 42nd Street with all the clocks and different time zones, and an MTA bus going past it, blurry, and there was an ad on the side of the bus that said, ‘The first time.’ It was a really profound picture. It had the speed of the traffic, the ad with that statement, and then this building which is very

recognizable. But if she wanted to exhibit that, I don’t know how easy that would be. It is not a picture of the ad. It’s a statement about time in the city.”

Sandra Camomile said: “I also teach students in a digital world, and I feel I have a responsibility to give them information on how to protect themselves, and possibly companies that they are going to work for. So this is what I tell them. If they’re going to take images from the Internet and use somebody else’s work, they have to manipulate the image enough that the artist will not be able to recognize that image as their own. I have them show me the original, and I look at what they’ve done. And there have to be significant changes before I would say, ‘yeah I think you’d be okay.’ I don’t know this for certain, though.”

“I’ve heard percentages, like it needs to be changed 75%. I’ve heard 80%, 90%, 95%. I’ve looked for information. It seems to be a moving target. So I give them the advice that if the artist can’t recognize the work, then you’re going to be okay. Otherwise, you could put your company into bankruptcy. You could put yourself into bankruptcy with legal fees. And I tell them that right now copyright and fair use are uncertain. And you don’t want to become the test case.”¹³⁰

Tony White has also been educating himself about copyright law, “but what I find discouraging is, the more you learn about copyright and fair use, the more of a chilling effect it has on your creative expression. Greater education about this topic, for artists, seems to have a chilling effect.”

The meeting ended with a word of caution from Eve Sinaiko, publications director of the College Art Association: “I heard around this table a fair amount of misinformation – not that anyone did this deliberately. But be careful about asking each other for advice on points of law.”

“From CAA’s point of view, we are aware that for both artists who create art and scholars who write about it and study it, there are enormous tensions and increasing difficulties in this realm. Misunderstandings of the law, fear of the law, excessively aggressive uses of the law, or reluctance to assert the law on both sides are

causing problems for our communities. And we as an organization are looking for ways to improve that situation.”

Location One Gallery

We met with ten artists at Location One Gallery on May 19, 2005. Carol Jacobsen is a video artist and professor. Erika Block is a playwright, theater director, and student at New York University’s ITP (Interactive Telecommunications Program). James Robinson said: “I’m not sure if I’m an artist, but I work in publishing and a lot of the work I’ve been doing

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“we swim in a remix culture”
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recently has been creative ways of publishing text.” Nayda Collazo-Llorens works in various media and is an artist in residence at Location One. Heather Wagner and Sebastien Sanz de Santamaria are also artists at Location One; Sanz de Santamaria is part of the arts collective, Flux Factory. Ursula Endlicher works with new media and the Internet. Clay Shirky is a writer and Web publisher who teaches at ITP. Jamie Allen is a sound artist and musician. One participant, a recent ITP graduate, asked to remain anonymous.

The most striking aspect of this focus group was that the artists were able to invoke fair use more readily than the authors and filmmakers in our previous discussions. As Shirky said, “we swim in a remix culture,” where seeking permission for every item that goes into the mix is neither practical nor logical. Jamie Allen likewise doesn’t think of copyright “as a necessary aspect of art”; “I don’t think of ideas that I produce as being mine per se.” Our anonymous participant said that she applies markedly different standards to her use of sound samples, “which I freely appropriate as an artist,” and to copying in her day job, where “I have to watch that stuff diligently for a media company and it’s like everything has to be approved and did we pay for it?”

Carol Jacobsen added that “artists traditionally, and contemporary artists especially, are appropriating; and a lot of us do see our ideas as contagious, and want them to be contagious. So we’re not as concerned” about copyright. But as a teacher, she recognizes “a concern on campuses today about academic integrity – cheating and copying and those kinds of issues. “And I’m realizing ‘Gee, in the art world we kind of appropriate everything.’”

“In class, we talk about the fact that if it’s in the public domain, and if it’s commercial or news, maybe it’s more accessible and okay – especially if it’s short clips. But I do urge students to think about it, especially if they’re borrowing from an artist or an independent source. I should probably have a lawyer come to every video class I teach to talk about some of these issues. I do talk about the fact that if we’re showing their videos on campus, there should be no problem. But if they send their videos with appropriated material to a film festival, they may have a problem.

“I know the university is concerned about copyright issues. We can’t make course packs without sending for permission for every article, and so many professors I know run to the copy machine and make copies themselves, or to the few little shops that don’t require copyright. I have sought permission from *Art in America* and different magazines, and they charge and arm and a leg, even for articles that I wrote!”

Clay Shirky was particularly incensed about the educational use issue. “NYU has a phenomenally restrictive fair use policy, occasioned, I believe, by our proximity to the major media outlets – we’re such a high visibility target in the town where all seven major media companies are headquartered. If you’re looking for somebody to sue, we’d be on your list.

“It certainly has not been as restrictive in other places that I’ve taught. NYU’s policy is that it’s fair use is if a student is in your office and you think of something they should read and you take a book off the shelf and take it down the hall – anything more premeditated than that must go through copyright clearance. They make no real distinction between large and small extractions of information. NYU’s position is that we’re going to artificially create a safe harbor by creating this

phenomenally limited circumscription around what the professor is allowed to do. And that is mainly a way to force upon the professor the risk of fair use. Most professors don't actually abide by that policy, because it gets in our way of dealing with our students. What it means is if I'm ever sued, NYU won't lift a finger."¹³¹

Ursula Endlicher uses the Internet for all aspects of her work, both gallery installations and online art. One recent project dealt with spam: "I pulled in a lot of text and names [from spam emails] – all the information I'd gathered over the years – and I displayed it in an interactive piece. As you enter a room, you have what I call an identity ticker – it assigns the names of people who have sent me spam. Who are they? They're probably not people; they're probably computer-generated programs. I use the text that was in the body of the email. It gets randomly triggered by a user who comes in." She did not question the legality of the project, because, she says, of the "weirdness" of spam.

Heather Wagner created a project using Internet icons and images. "For a while, I was grabbing the little icons that are on Google news every day. Under each heading there's a different icon – U.S. news, sports news, international. So every day I was grabbing them and making a little collage of what was the top news. It didn't occur to me that if I ever printed it or showed it someplace, I would need to get anyone's permission. It's just stuff that's out there – a picture of Bush, or the Pope or something. Whereas if it were by a person who created the image with some artistic intention, I wouldn't think I could just grab it."

In an installation piece, Wagner used the text of the Samuel Beckett monologue, *Not I*. She thought about seeking permission, but was told that the Beckett estate is "notoriously bad. Don't even try." The estate requires scrupulous adherence to Beckett's stage directions, even down to "the measurements of how far upstage the actors can be." In Wagner's version, there were no actors at all: "I had a computer voice read the play, and then had it trigger visual things." Although Wagner thought her appropriation was probably illegal, there is certainly an argument that the fair-use factors would favor her transformative use of this iconic 20th century text.

Erika Block has had experience in theater, and describes her knowledge of fair use as "sort of old school – how many minutes of music can you use without getting rights?" She said that she has "freely used music, sounds, and verses in production," adding: "I'm religious about giving attribution; and I figure that working for a little nonprofit, where 3,000 people are going to see the show, is really different from a commercial project with larger audiences."

She has also used samples in digital artwork. A current project called "Dirty Little Stories" is a digital montage, adapted from a theater piece, using clips of dialog from classic film noir. "For the theater production, we basically rented VCR tapes and created digital recordings. I integrated the clips with original photos into an interactive montage." She is aware of the copyright implications, but doesn't know the answers. "Some of them are really quick clips; some of them are longer. Is it two minutes for music fair use? There's some number. I can't even remember it. Do you know the answer? I have to decide if it's worth using that material before I go further with distributing this work. I think I would probably use it and give attribution."

James Robinson's recent project, "The Quotomatic," calls upon a digital archive of quotations using a supermarket bar code scanner. "Instead of quoting a price for an object, it gives you a quotation. It recognizes what the object is, like a can of corn, and then it'll search Bartleby.com, which is an online archive of 80,000 quotations. It looks for a quote that is relevant to a can of corn. Then prints it out on a mailing label.

"I'm sure a lot of the work in the archive is copyrighted, but I'm not concerned with that. I'm not even really concerned with fair use. That's changed a bit since I came to ITP, where I had artistic license. Having worked in the publishing world, I've come to the conclusion that copyright is a political tool. Once you get into the legal game, it's over."

Robinson elaborated by describing his involvement with BaseballLibrary.com, an online archive of baseball history. "We had a feature that we were doing for CBS Sports Line called 'Believe It or Else.' We received a cease and desist letter from the 'Ripley's Believe It

or Not' people. So we took it down, although CBS wanted to stand up to them. That sort of dispute, to me, is the big boys' play. It's like, 'can we get two million or, you know, three hundred grand?' Because you've got to pay the lawyers."

.....

"... if someone wants to make us famous by just grabbing our clips and putting them someplace else, that's great."

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Another issue that arose is copying for informational purposes. Nayda Collazo-Llorens has published text on her own Web site "that has been written either about my work or shows I've been in. And I've always mentioned where it's taken from. These are essays relevant to my work. My Web site is a documentation of my projects, so whenever there's text in a catalog or a review from a newspaper, be it about my work or about the shows I've been in, I've included

those. I'm assuming that's fine. But truly, I have no idea, and I haven't cared enough to find out." Likewise, Sebastien Sanz de Santamaria said that his Flux Factory collective posts reviews on its Web site: "When I uploaded an entire article from the *New York Times*, I just thought, 'I hope I'm not doing something wrong,' I would think that, as we are the subject of the reviews, it would be accepted."

How do they feel when somebody else copies their work? Clay Shirky uses Creative Commons licenses, but he tries to stop outright plagiarism. "One time, some guy from Singapore stole a bunch of my articles. It wasn't fair use, because it was the whole article. I went directly to the guy. And that was enough – it disappeared, because it was embarrassing to him. He was doing it to increase his credibility, not to derive money from it. And so if his credibility was damaged by being discovered, that was enough of a remedy."

Heather Wagner mentioned a bandmate who was reluctant to post digital clips of the band's music for fear that it might be stolen. "To me, that's literally insane. If they do, if they post it to a P2P site, then as Clay says, if someone wants to make us famous by just grabbing our clips and putting them someplace else, that's great."

CHAPTER 3

The “Curse of Avatar” and Other Controversies from the Chilling Effects Clearinghouse

The Chilling Effects Clearinghouse began in 2002 when Wendy Seltzer, a fellow at the Berkman Center for Internet & Society, realized that the Internet’s vast potential for people “to express their views, parody politicians, celebrate their favorite movie stars, or criticize businesses”¹³² was being threatened by the widespread practice of sending cease and desist letters, or take-down notices under the Digital Millennium Copyright Act (the DMCA). These letters usually demanded the suppression of material that the senders claimed violated their IP rights. Many of these letters were not legally justified, but were nonetheless effective against non-lawyers and non-commercial sites. Seltzer and other cyber-activists began ChillingEffects.org in order “to document the chill” by collecting examples of cease and desist and take-down letters, and linking them to FAQs “that explain the allegations in plain English.”¹³³

The more than 1,000 letters that have been deposited with Chilling Effects provide information about what kinds of copyright or trademark infringement claims are made, the number of those claims that are legally weak or even frivolous, and the number that target Web pages or newsgroup postings which might be considered fair use or have a First Amendment defense. Following up on the information in the Clearinghouse can both amplify these findings and tell us how often cease and desist or take-down letters have a chilling effect, how often they are resisted, and what factors contribute to the different outcomes.

The first part of our study analyzed the letters on the Chilling Effects site for one full year, 2004. Of the 332 letters in the database for that year,¹³⁴ 320 related to IP issues. The other 12, which we eliminated from our analysis, concerned defamation or child pornography.

Eighty-two percent, or 263 of the letters in the sample of 320, were DMCA take-down notices received by ISPs. The remaining 18% were cease and desist letters sent directly by copyright or trademark owners to individuals or organizations. Many of the letters contained multiple allegations – for example, copyright infringement, trademark infringement, unfair competition, violation of trade secrets, improper use of a Web address or domain name.

Google contributed the great majority of the 2004 take-down notices (245). As a journalist recounts, Google became concerned that take-down notices from the Church of Scientology regarding an anti-Scientology site called “Operation Clambake”¹³⁵ were depriving Web surfers of information critical of the religion. The company “realized that didn’t serve its public very well, but they were looking for something to help minimize their legal risk, and Chilling Effects was there to help.”¹³⁶ Google decided to forward the take-down notices to Chilling Effects while removing the listings from its index in accordance with the DMCA, and, in their place, inserting a link to the notice on the Chilling Effects site.

Most of the take-down letters to Google concerned search-result links to Web sites, newsgroups, or blogs. The leading sender in this category was Star’s Edge International, a psychological improvement and “planetary enlightenment” organization that offers a self-discovery course called Avatar.¹³⁷ Star’s Edge sent 32 take-down letters to Google in 2004, complaining that Avatar’s copyrighted lectures and course materials were posted by participants in such online discussion groups as “alt.clearing.avatar,” “nl.scientology,” and “alt.religion.scientology.”

The American Pool Players Association sent the second largest number of letters to Google in 2004 – a total of 20. These letters demanded the removal from discussion group postings of pages from the Association’s manual. They did not indicate how much of the manual was reproduced, whether it was more than uncopyrightable formulas and instructions,¹³⁸ or to what extent the postings also contained criticism or commentary that would strengthen a fair use defense. But they did refer to subject lines in the postings such as “Bud Light Pool League” and “Re Bud-Lite Handicaps,” which suggest that commentary probably did accompany some of the quotes from the manual. Other subject lines such as “Pool and Billiards Frequently Asked Questions” could indicate copying without commentary.

MIR Internet Marketing, which sells Web optimization products, was the third most frequent sender of take-down notices in 2004, with a total of 15. MIR claimed that it owned the copyright in phrases used on competitors’ Web sites, and demanded that Google remove links to those sites when these phrases were typed into a search query. In one instance, the words MIR claimed to own were: “improve your brand visibility, find new customers, or improve.” In other letters, MIR said it owned the phrases “naturally attract visitors by winning top ranking on the major search engines” and “not a process of manipulation.”¹³⁹ Google complied with the demands, and posted in place of the excised links: “In response to a complaint we received under the Digital Millennium Copyright Act, we have removed 1 result(s) from this page. If you wish, you may read the DMCA complaint for these removed results.” There followed a link to the ChillingEffects site.

The multiple take-down notices from Star’s Edge, MIR, and the Pool Players Association illustrate the repetitive nature of many copyright or trademark conflicts. They show the persistence of some owners in trying to squelch what they perceive as infringement, and the equal persistence of Web publishers and discussion group contributors in quoting copyright-protected material.

Analysis of the 2004 Letters in the Chilling Effects Clearinghouse

We divided the 2004 letters into five categories: (1) those that seemed to state legitimate claims for copyright or trademark infringement; (2) those that, by contrast, seemed to state weak claims; (3) those that targeted expression with a strong claim to fair use, or an analogous First Amendment defense under trademark law; (4) those targeting speech with less strong, but still reasonable claims to a fair use or First Amendment defense; and (5) those with possible fair use or First Amendment protection, but where we couldn’t make a judgment without more information.

For each letter, we used Google to search for the material that was targeted in order to amplify our judgment about the legal strength of the IP owners’ claim and the likelihood of a fair use or First Amendment defense. In many cases, the targeted material was no longer accessible, but sometimes we were able to gather additional information from telephone interviews or responses to our online survey.

In making our judgments, we adhered to the legal precedents. Of course, this is no simple task: the four fair use factors in copyright law are broad and general, and trademark law is also full of ambiguities. Nevertheless, there were clear differences among the materials targeted by the 320 letters. One major criterion was whether the material involved commentary, criticism, or other transformative use of the copyright or trademark-protected work. The other examples given in the fair use law itself – scholarship, research, news reporting, and classroom use – were equally important, but less frequently encountered in our 320-letter sample. We also considered how much of the IP-protected material was copied or quoted, and whether the use was commercial and likely to compete with the market for the original.

The ultimate legal result in any of these controversies, had they gone to court, would have turned on a much more detailed set of facts than we could assemble in evaluating

320 separate cease and desist and take-down letters. Our judgments are not definitive legal predictions. But in many situations, a simple look at the material in question gives a good sense of the likely strength of an IP claim or a fair use defense.

In the first of our five categories, legitimate copyright or trademark claims, we placed many letters complaining about copying by commercial competitors. These seemingly legitimate claims ranged from a complaint by the Bhaktivedanta Book Trust that another site was displaying its artwork without permission to Ovulation-Calendar.com's protest that a competing manufacturer had copied its "texts, descriptions, interfaces, images, and computer codes."¹⁴⁰ Other apparently legitimate claims involved texts describing architectural designs, National Health Scotland's "ReadySteadyBaby" Web site, PaddleAsia Company's description of its birdwatching tours, poetry texts used on posters, and Web links to unauthorized copies of photographs owned by the Brazilian version of *Playboy* magazine.¹⁴¹

We also categorized as legitimate all but one complaint about distribution or sharing of copyrighted music, movies, or software.¹⁴² Of our 320-letter sample, 23 targeted file-sharing and another 14 concerned circumvention of software locks. Some might question our judgment as too conservative because nonprofit copying for private enjoyment is fair use in some circumstances. But we assumed that most of the file-sharing was large-scale and as such, not fair use under the Supreme Court's 2005 decision in the *Grokster* case.¹⁴³

Finally, we placed ten of the 32 Star's Edge letters in the "legitimate claims" category. Judging by their subject lines – for example, "Here it is! The Avatar Course for FREE!" – the postings targeted by these ten letters likely consisted of full texts of copyrighted course materials. Arguably, even full-text postings could be fair use in the context of a critical discussion group,

but we doubt that the legal precedents would support such a claim.¹⁴⁴

Weak trademark and copyright claims, our second category, commonly involved assertions of control over nondistinctive phrases, or situations in which there was little likelihood of confusion.¹⁴⁵ We put 37 cease and desist or take-down letters in this category. Examples included the use of common terms like "penisimprovement" or "Pet Friendly" in a way that would not likely cause consumer confusion.¹⁴⁶ Where we found weak claims, we did not go on to analyze whether the targeted words or images might also qualify for a fair use or First Amendment defense. Indeed, a fair use defense only arises after an owner has stated a legitimate copyright or trademark claim.

Our third category consisted of letters targeting speech that we thought had a strong fair use or First Amendment defense. Examples included



Tracey Thompson at *Pet Friendly Travel*, "Cyrus"

a parody of the *New York Times*'s online corrections page; a site mocking American Express called "American Expressway"; and an "Internet Infidels" site containing parodies of pro-Creationism cartoons.¹⁴⁷ We found 17 letters in this category, including four of the 32 sent by Star's Edge; among the subject lines of the targeted discussion

group postings in those four cases were "Look Who Is Talking," "Harry Palmer the NUT or the CLONE of Hubbard," and "The Curse of Avatar: Harry Shows His True Sleazy Colors" (*sic*) (referring to Harry Palmer, Avatar's founder).¹⁴⁸

Our fourth category – a reasonable but not strong claim to fair use or analogous First Amendment protection – consisted of 13 items. Examples included two fan sites and an image of "The Wild Christmas Reindeer" that seemed small enough to qualify as a fair-use "thumbnail" reproduction.¹⁴⁹

Finally, we placed 86 items in the category of "possible claim to fair use, but not enough information to tell." This category included a site offering a "recognizable portion" of the

“Paris Hilton Sex Tape”¹⁵⁰ (how much was copied would be relevant in determining fair use), a site containing recipes for Cuban dishes (since it was taken down, we did not know whether copyrighted text was copied along with lists of ingredients, which are not protected),¹⁵¹ and “harrypottergalleon.com” (we could not find this site, and could not tell from the cease and desist letter whether it was simply a fan site using “Harry Potter” as part of its domain name or whether it was capitalizing on the name by selling mugs, T-shirts, and the like).¹⁵²

Also in the “need more information” category were five take-down notices from the proprietor of “www.royalty.nu,” a site specializing in monarchies from Genghis Khan to the British Royals. The site owner claimed that his articles on King George III, “Bad Queen Caroline,” “The Real Prince Dracula,” and other aristocrats were reprinted on Google’s “alt.gossip.royalty” discussion group.¹⁵³ Whether the copying constituted fair use would depend, among other things, on how much was taken and whether it was transformed or enhanced by surrounding commentary.¹⁵⁴ The group was presumably nonprofit – an important factor, but not in itself dispositive of Royalty.nu’s copyright claim.

We categorized 18 of the Star’s Edge letters as having a “possible claim to fair use – more information needed,” since it appeared that at least some of the material in the targeted messages consisted of criticism and commentary. Typical of this category were postings with such subject lines as “Harry Palmer talking about Feel Its (clarified),”¹⁵⁵ as well as material from *The Source Code* by Eldon Braun, a publication that reproduced Avatar materials. In 2003, Palmer and Star’s Edge had obtained a court injunction against Braun’s distribution of *The Source Code*,¹⁵⁶ but the injunction only bound Braun and his agents – not individuals participating in discussion groups. Without more information about how much was copied from *The Source Code* and what commentary accompanied it, we couldn’t judge whether these postings might have qualified as fair use.

Our total of strong or reasonable fair use or First Amendment defenses, combined with material that probably did not amount to

copyright or trademark infringement in the first place, was 67 items out of 320. Thus, more than a fifth of the letters in our sample threatened to chill expression that probably did not violate IP laws. Another 86 letters – or about 27% of the sample – targeted material that was possibly fair use or First Amendment protected, and thus might well have threatened free expression. The total of letters with a likely or possible chilling effect was thus 153 – almost half of the sample.

Looking at the type of expression that was potentially chilled, we found the biggest category, with 48 letters out of 153, consisted of commercial sites, many of them using nondistinctive terms.¹⁵⁷ The two other big categories were fandom or other sites relating to pop culture or sports (33 letters) and sites commenting on religious beliefs or spiritual improvement groups (31 letters). There were 12 targeted sites that we classified as artistic expression, 20 that we categorized as political speech, news, or commentary, and five that we classified as scholarship, science, or health. (It was impossible to classify the speech targeted by the remaining four letters.)

Our next step was to try to determine the outcome of the controversy in the 153 cases where we thought free expression might be at risk. Of the 17 instances where the targeted expression had a strong claim to fair use or First Amendment protection, we found that five items were removed, 10 were not removed, one was probably removed (we could no longer find it, but we also did not find the usual Google disclaimer), and one was partially removed (the image in question was no longer in the Google image gallery, but the Web page still existed).

For the categories of reasonable and possible fair use, we found that most of the material was removed or partially removed (or, in one case, the operator of the targeted Web site ended up paying the writer of the demand letter a licensing fee). For the 37 targeted items that were likely not infringing in the first place, the number of removals was 18, with two likely removals and four partial removals; 10 items were not removed.¹⁵⁸

Examples of Weak IP Claims

The examples below illustrate the range of IP claims that that we thought were weak, often because the terms in dispute were not very distinctive or because we saw little likelihood of confusion. Of course, the outcome of each case, had it gone to court, would have depended on more detailed evidence. Nevertheless, the examples are instructive. In many cases, they show IP owners trying to monopolize the use of common English words.

- In January 2004, Time Warner sent a letter to Web Inceptions, Inc., which operated a site called “PrivateLessons.Info.” Time Warner claimed exclusive ownership of the trademark “Private Lessons” and demanded that Web Inceptions immediately cease all use of the term.¹⁵⁹ When we searched for PrivateLessonsInfo, it was still being operated by Web Inceptions, with a headline stating that the domain name was for sale.¹⁶⁰
- In December 2004, the dating site Match.com sent a cease and desist letter to a company that had registered the domain name “springfield match.com.” A visit to the targeted site yielded a page that read: “Coming Soon – Springfield Match.com,” which by its romantic typeface suggested that this would indeed be a dating site, and that its creators were not deterred by Match.com’s letter.¹⁶¹
- In August 2004, ZC Investments, which does business as the Canyon Ranch resort, demanded that Taylor Canyon Ranch in Arizona stop using the term “Canyon Ranch.”¹⁶² Although there are plenty of ranches with canyons in America, so that the likelihood of confusion seems remote, this demand was apparently successful – we could not find a Web site for Taylor Canyon Ranch in 2005.
- In July 2004, Scholastic, Inc. complained that RedHouseBooks.com infringed its “Red House” trademark. Scholastic contended that since 1981, it had been using the term Red House for its catalogs of books, posters, and other products. It demanded a transfer of the domain name, delivery, “for destruction,” of all documents on which “RedHouseBooks.com” appeared, and a detailed accounting of all sales and revenues.¹⁶³ As of mid-2005, however,

RedHouseBooks.com was still active, selling first editions by modern authors, “famous and forgotten,” and out-of-print books on social movements of the 1960s.¹⁶⁴

- In December 2004, “MassMutualSuks.com” received a cease and desist letter from MassMutual. Despite the letter’s threats of legal action, MassMutualSuks.com was still online in 2005, although it was simply a placeholder.¹⁶⁵
- The Muzak company had more success with a cease and desist letter to muzak.smoe.org, even though the site had nothing to do with elevator music. In response to the letter, muzak.smoe.org changed its URL to www.smoe.org. The owner explained: “if you’re wondering – yes, there is a reason why we changed our series’ name. It has to do with a certain concern which supplies elevator music to the masses, and a cease and desist letter we received therefrom. Ain’t legalities grand?”¹⁶⁶

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Time Warner claimed exclusive ownership of the trademark “Private Lessons”

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- Finally, the Intel Corporation claimed that a group called PROgressive INTELLigence violated its trademark by using the term “PRO-INTELL” on its Web site. Intel’s letter had a conciliatory tone, and invited negotiations over reasonable use of “Prointell.” The letter explained that “we are ... obligated by law to protect our mark; otherwise we risk losing our trademark rights.”¹⁶⁷ The PROgressiveINTELLigence site is still up, with a disclaimer that it “is not sponsored by, affiliated with, or related to Intel Corporation in any way.”

Examples of Strong or Reasonable Fair Use Defenses

- In February 2004, Chick Publications, Inc. wrote to a Web hosting company demanding the removal of religious parodies from “www.

howardhallis.com,” a comedy and comic-book site.¹⁶⁸ After notification from the ISP, Hallis deleted the parody artwork, and wrote ruefully: “Taken down due to legal stuff. ... Sorry folks. Cthulhu destroys all that you love!” He added: “I myself don’t agree with Chick’s fundamentalist Christianity ... The piece was done in fun, but you got to realize that the laws can censor you.”

A reader responded:

i was very impressed by your “Cthulhu Chick Tract” – i thought it was hilarious, and a nice spoof on the original (which i consider intellectually insulting).

i am sorry that you had to take the page down. However, i am also surprised, as i thought that “fair use” laws allowed the modification of copyrighted material for parody purposes.¹⁶⁹

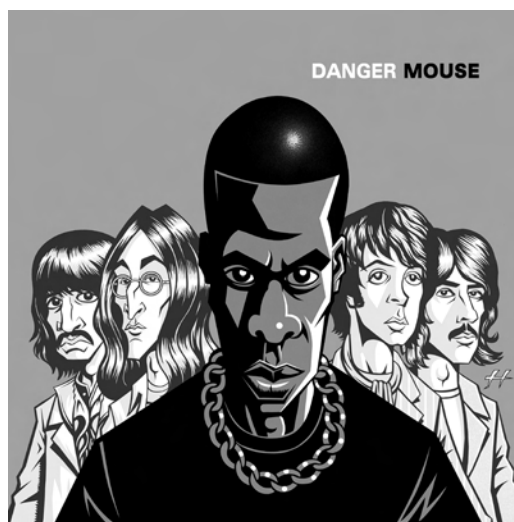
We agreed with the reader. The religious parodies would have had a strong fair use defense.

- An April 2004 letter to Google from AirTran Airways demanded the removal of links to pages on *2600.com: The Hacker Quarterly*, a site that critiqued AirTran’s poor safety record. AirTran complained that *2600* had reproduced its Web pages “in their entirety, or in substantial, verbatim excerpts”¹⁷⁰ One page, dated September 24, 1997 and headlined “So We Killed a Few People, Big Deal,” contained a parody press release that began:

ValuJet Airlines today changed its name to AirTran Airlines and along with its merger partner AirTran Airways introduced a new business strategy designed to bring dismemberment to a broader travel audience. The airline said that its objective is to make air travel more attractive to business travelers and even more convenient for suicidal maniacs.¹⁷¹

Another page, headlined “Hacked,” reproduced an AirTran Web page and suggested that ValuJet’s merger with AirTran was intended to distract public attention from a 1996 ValuJet crash that killed 110 people.¹⁷² These pages are still up. Their use of copyrighted and trademarked material created little likelihood of confusion and had a strong claim to fair use.

- The operator of netfunny.com received a letter from American Express in April 2004, demanding that he stop using the terms “American Expressway” and “Membership



Justin Hampton, Cover of Danger Mouse’s Grey Album

Has Its Privileges” because they are “virtually identical to our client’s American Express mark” and are “likely to cause consumers to be confused, mistaken, or deceived as to the source of origin of your services.”¹⁷³ A visit to netfunny.com shows that its American Express parody is still posted, with a link to a site where “you can read about an effort by American Express to get this joke deleted.” On that page, blogger Brad Templeton writes that he received a “one of those bullying ‘cease and desist’ letters from American Express’s law firm,” and proceeded to post another parody, this time of Amex’s lawyers, concluding: “After all, Being Giant and Intimidating has its Privileges. ... American Express Lawyers: Don’t leave your home page without them.”¹⁷⁴

Contrary to Amex’s claim, there was little likelihood of confusion here, and netfunny’s First Amendment defense was a strong one.

- A February 2004 email from the Discovery Channel to what was probably a fan site demanded the removal of a TV program’s logo, text, and photographs. The email acknowledged that “you are using the trademarks and photographs to facilitate commentary about Discovery’s programs,” but explained: “if Discovery permits

your unauthorized use of its intellectual property, Discovery may have trouble preventing future egregious infringements by competitors and persons intending to trade off the goodwill of Discovery.¹⁷⁵ We categorized this probable fan site as having a reasonable fair use defense because the copied material was accompanied by commentary.

- Another fan site, for the TV show *Caroline in the City*, included transcripts from the show's episodes, plot summaries, and fan fiction. The operator received a cease and desist letter from CBS-TV in January 2004, claiming both copyright and trademark infringement. Although the letter noted that "you may not have been aware of the applicable laws," and said CBS was "quite happy to know" that *Caroline in the City* had loyal fans, it threatened legal action if the material was not removed. The letter went on: "please understand that it doesn't bring us any pleasure to send legal letters to our fans."¹⁷⁶

We thought the site had a reasonable fair use defense because its transcripts and summaries were posted in the context of commentary, were not for profit, and were more likely to increase than interfere with the market for the TV show.¹⁷⁷ However, the owner removed the transcripts and fan fiction, explaining that she had received a cease and desist letter. This resulted in an outcry from fans, and a few months later, a new owner re-posted summaries of episodes, but not the transcripts. She wrote: "woo, I got rid of that depressing letter Ann posted a few months ago. And if you look closely on the left, you're in for a little surprise: The dearly missed section is back!!" There was also a disclaimer explaining that the site is nonprofit and has no connection with the producers of the show.¹⁷⁸

- Seven letters from Capitol Records/EMI in February 2004 warned against any distribution of DJ Danger Mouse's *Grey Album*, a "mash-up" using the rapper Jay Z's then-recently released *Black Album* mixed with songs such as "Julia," "Happiness is a Warm Gun," and "Rocky Raccoon" from the Beatles's 1968 *White Album*. Hundreds of Web sites had announced that they would post the album on "Grey Tuesday," February 24, 2004, as a gesture of protest against a copyright system that fails to acknowledge

the importance of mixing and sampling to musical creation. The letters demanded not only that *The Grey Album* not be distributed but that recipients identify "any third parties" who had supplied them with copies, provide an accounting "of all units of *The Grey Album* that have been distributed via your website," and "make payment to Capitol in an amount to be discussed."¹⁷⁹

Danger Mouse himself, Brian Burton, had agreed to Capitol's demands, and so did some recipients of the threatening letters. But DownhillBattle.org, coordinator of Grey Tuesday, reported that "for 24 hours, over 170 sites made the album available in protest, defying legal threats."¹⁸⁰ To the letter from EMI that Downhill Battle itself received, the group responded that "your efforts to suppress music stifle creativity and harm the public interest; we will not be intimidated into backing down. Downhill Battle has a fair-use right to post this music under current copyright law and the public has a fair-use right to hear it."¹⁸¹

The Electronic Frontier Foundation (EFF) posted a legal memo that bolstered the protesters' claim to a fair use defense. Distribution of *The Grey Album*, EFF said, was for a noncommercial purpose; downloads would not "substitute for purchases of *The White Album* or other recordings of the Lennon-McCartney songs on the album"; *The Grey Album* was "a transformative use of *The White Album*, not a wholesale copy"; and the postings were intended as "a commentary on the use of copyright law to stymie new kinds of musical creativity."¹⁸² Although some copyright experts might consider EFF's analysis to be a stretch for fair use, certainly *The Grey Album* was a creative and transformative use of the Beatles' material – a major factor in fair use cases.

Summary and Conclusions

The chart below summarizes the impact of the 153 letters in the Chilling Effects database for 2004 that either targeted material with a fair use/First Amendment defense or that stated a weak IP claim.

These numbers indicate, not surprisingly, that the stronger the claim to fair use or other

legitimate borrowing of protected material, the more likely it was that the material would not be removed from public circulation. But a substantial amount of material *was* totally or partially removed in the face of weak copyright or trademark claims (24 out of 37 items). These removals were largely due to the strong pressure placed on ISPs by DMCA take-down letters. Response to cease and desist letters was more variable, at least in the “strong fair use” category, with more than half the group willing to stand up to copyright owners’ threats and risk being sued in order to continue posting their work.

Despite this resistance on the part of some recipients, and despite the relative ease with which content can be re-posted using a new ISP after being blocked because of take-down notices, the 2004 letters in the Chilling Effects database resulted in significant suppression of criticism, commentary, and other likely fair and legal uses of copyright and trademark-protected work. Although some people were intimidated by cease and desist letters into relinquishing their rights, the more consistent problem stemmed from the take-down provisions of the DMCA. Copyright owners may prefer the DMCA procedure because ISPs are easy to find and are more likely to respond with “expeditious” takedowns than are individuals.

Particularly troubling was the frequency of weak claims to exclusive control of common words or trademarked phrases. Most of our 37 weak claims were in this category. Yet more than half of the weak claims resulted in the suppression of speech (including the elimination of valid Web links). In some cases, the sender’s apparent goal

– to force search engines to direct traffic to its site and away from competitors’ sites – succeeded.

On the other hand, more than half of the 2004 letters did seem to state valid claims for copyright or trademark infringement. Many concerned outright copying of large chunks of material from others’ Web sites, often for commercial purposes. In these cases, one might argue that cease and desist, and even take-down, letters are useful because they can stop infringement without the expense of litigation.

Overall, the speech-suppressing effects of cease and desist letters are probably even more pronounced than our analysis suggests, because those who deposited such letters with Chilling Effects are likely to be a more knowledgeable group than the average. Many of them have access to Web resources and online community support. Their level of resistance is therefore likely to be higher and the chill somewhat less than within the universe of letter recipients.

The 263 DMCA take-down letters for 2004 more closely represent a random sample, since Google said it would send all the letters it received to Chilling Effects. Twelve of the 17 items with a strong fair use or First Amendment defense were targeted by take-down letters. At least ten of these were criticism or commentary sites or postings, which suggests that they may have been targeted at least in part because the IP owner did not like the message that they were expressing. This aspect of the analysis demonstrates the censorship power that the law puts in the hands of IP owners.

	Strong Fair Use/ First Amend- ment	Reasonable Fair Use/First Amendment	Possible Fair Use/Not Enough Info	Weak Copyright or Trademark Claim
Acquiesced / Removed	5	0	59 ¹⁸³	18
Did Not Acquiesce/Remove	10 ¹⁸⁴	2	1	10
Likely Removed	1	2	12	2
Partially Removed	1	2	5	4
Undetermined	0	7 ¹⁸⁵	9	3
TOTALS	17	13	86	37

CHAPTER 4

Parodies, Critiques, and “Pet Friendly” Web Sites: The Telephone Interviews

At our request, Chilling Effects asked those depositors who had left contact information if they would participate in telephone interviews. Seventeen people responded, and from late 2004 through early 2005, we interviewed them in order to learn about their knowledge of fair use, their reactions to the cease and desist or take-down letters, the final outcome of the controversies, and their feelings about the experience. Although our interviewees represent a small sample, their experiences illustrate a range of free expression conflicts. Twelve of them published commentary, news, or other information – in five cases, critiquing the individual or organization that complained of infringement. Three others ran small businesses; two ran fan sites.

Of the 17 controversies, seven involved copyright; seven involved trademark (including disputes over a domain name); and three involved both. Ten of the interviewees were confronted with cease and desist letters; four were subject to DMCA take-down notices; two were the targets of both; and one received an invoice for using “a substantial amount” of an article.

Twelve were aware of fair use; five were not. Of the 12 who knew about fair use, five had a basically accurate understanding of the concept. Six were partly accurate; only one was seriously off the mark. He said: “If something is in the public domain, you can use it as long as you don’t profit from it. If it is privately owned, you need to seek permission to use it for any purpose.”¹⁸⁶

Thirteen of our interviewees consulted lawyers, but only six retained them. Three of the lawyers worked *pro bono*; another was paid by a trade organization; and one managed to win the case for the modest fee of \$1,000. Of those who did not retain lawyers, the most common reason, not surprisingly, was cost – not only legal fees, but the possibility of having to pay a judgment if they lost the case. Other significant

considerations, cited by seven interviewees, were fear, intimidation, and the emotional cost of defying an IP owner.

We thought that seven of the cease and desist or take-down letters stated weak copyright or trademark claims. In another five cases, there were strong or at least reasonable fair use or First Amendment defenses. Another four interviewees had possible arguments against the claims in the letters. Only one clearly had a losing case.

But despite the overall weakness of the claims made in the letters, five recipients acquiesced. (All of them felt that had they chosen to fight, or been able to afford an attorney, they would have had a better outcome.) One lost his case; one settled; and two had their posting or link removed by an ISP. Two others who were targets of take-down letters removed the challenged material temporarily, and later were able to reinstate it. In total, nine of the 17 had their material suppressed, even though 12 of them had a strong or reasonable defense, or received letters with dubious IP claims. Although the sample is too small and self-selected to be scientific, it shows a substantial chilling effect from both cease and desist and take-down letters.

Weak Copyright or Trademark Claims¹⁸⁷

Protecting the Voice

The Cape Cod Voice, a fortnightly regional journal, received a cease and desist letter in June 2002 from New York City’s *Village Voice*, asserting both trademark infringement and dilution. The letter concluded: “We hope to resolve this matter amicably ... Our previous experience with the *Bloomington Voice*, *Dayton Voice* and *Tacoma Voice* newspapers – each of which successfully changed its name after our client raised trademark infringement concerns with them – indicates that we can accomplish this goal.”¹⁸⁸

Dan Hamilton, managing editor of the *Cape Cod Voice*, told us that at first the staff did not think the demand was serious. They did a Google search that yielded more than a million Web sites with “Voice” in their names. They then hired a Boston law firm, courtesy of their membership in the New England Press Association. One of the attorneys wrote a reply to the demand letter, pointing out that there was little likelihood of confusion since “my client modifies its use of the word ‘voice’ with the geographic modifier, ‘Cape Cod.’” Then she asked: “Is it your position that no other publication may use the word ‘voice’ in its title? This would seem to be quite a reach, given that a Google keyword search . . . takes just 0.16 seconds to bring up 1,150,000 instances in which the words ‘voice’ and ‘newspaper’ appear together.”¹⁸⁹

A phone conversation between Seth Rolbein of *The Cape Cod Voice* and Greg Goff of *The Village Voice* followed. Rolbein recounted its substance in a memo (later published on *The Cape Cod Voice’s* Web site). First, Goff offered to pay the costs involved in a name change, including new business cards. When asked why *The Village Voice* was bothering to pursue this, he explained: “If we let one go, it makes it impossible to pursue the next one. So we feel we need to be overprotective.” But, Rolbein asked, is *The Village Voice* pursuing “every one of the hundreds of ‘Voices’ out there?”

“We make a distinction among the products we’re aware of that use the word ‘Voice,’” Goff explained. “The ones we don’t pursue are either international, or are dedicated to a cause or ethnic orientation. But ones that are geographic, which we feel are easily confused with our publication, we pursue.”

“How about, for example, *The Houston Voice*?” Rolbein asked.

“Houston is oriented to a gay population,” Goff said. “So that’s kind of on the line.”¹⁹⁰

More correspondence followed. Rolbein pointed out that “there is no confusion between, say, *The Boston Herald* and *The Miami Herald*, *The Washington Post* and *The New York Post*.”

Eventually, *The Village Voice* abandoned the field. *The Cape Cod Voice* then published a series of articles exploring trademark law. In one of

them, Hamilton noted “the new corporate tendency to fire off a scattershot of nasty letters to anyone who, in their opinion, poses even a vague threat to their trademarks.”¹⁹¹ He told us he was “astonished at how easy it is for a large corporation to make an absurd claim about a common English term.”

Pet Friendly

Another questionable cease and desist letter came in 2002 from a pet product manufacturer, Pet Friendly, Inc., which described itself as “the exclusive supplier of rope chew toys to the largest retailer in the world for over a decade.” The letter, to Pet Friendly Travel,¹⁹² asserted that its use of the term “Pet Friendly” amounted to trademark infringement because it “will cause the public to mistakenly assume that your business activities originate from, are sponsored by, or are in some way associated with Pet Friendly, Inc. and its valuable trademark rights.”¹⁹³

Like *The Village Voice’s* claim, this one founders on the commonness of the words – a search on Google yields www.petfriendly.ca (pet-friendly Canadian vacation rentals) and www.petfriendlytravel.com/Pages/states/georgia/georgia.html, among others.

Tracey Thompson, owner of Pet Friendly Travel, told us that she was initially “freaked out” by the letter – “crazed and scared.” After she did some legal research, she “realized they didn’t have a case,” and “it became almost funny.” It was “still a pain,” however, because she had to hire an attorney, and Pet Friendly, Inc. began sending her invoices for \$7,000 per week for the unlicensed use of the name. On the advice of her lawyer, she wrote back disputing the invoices, but they persisted for about a year, amounting, by mid-2003, to \$336,000. By this time, Thompson said, many of the “Pet Friendly” businesses that had received these demands were in touch with each other, and were ignoring the invoices.¹⁹⁴ Pet Friendly Travel is still up and running.

Piggy Bank of America

A woman who makes ceramic piggy banks under the domain name www.piggybankofamerica.com received a cease and desist letter from Bank of America’s legal department in the fall of 2002.¹⁹⁵ “It appears that

you have intentionally targeted Internet users who are attempting to reach Bank of America's web site," the letter began. "It is our opinion that your registration and use of piggybankofamerica.com is a violation of Bank of America's service mark rights and is misleading to the public. ... We demand that you and all other entities associated with you immediately discontinue the use of this domain name and that you promptly transfer to us your registration for this domain name and any others including a variation of Bank of America to us."¹⁹⁶

Our piggy bank maker said she "panicked and felt helpless" upon receiving the letter. One lawyer told her that it would cost \$50,000 if she wanted to contest the Bank's position. She had several sleepless nights and "finally felt like I should just give it up and turn over my ownership to Bank of America." However, she posted information about her case on a message board and was referred to Stanford Law School's Cyberlaw Clinic, which agreed to represent her.

A clinic student wrote a well-researched reply to Bank of America, citing relevant case law to show that there was no likelihood of confusion between the small piggy bank maker and the massive financial institution. One cited case rejected the Hasbro Company's claim against Clue Computing based on Hasbro's trademark for the board game Clue.¹⁹⁷ Another noted that an apple grower using the URL "apple.com" probably does not infringe the trademark of Apple Computer because "APPLE is also a common noun, used by many companies, and the goods offered ... differ significantly."¹⁹⁸ Bank of America responded with an offer to drop its claim if the piggy bank URL could be changed slightly – to "piggybanksamerica.com," for example. The Stanford Clinic replied that "there is absolutely no basis for your complaints against our client," and that she "will not incur the expense, hassle or loss of sales entailed in moving her handmade piggy bank business to another domain name."¹⁹⁹ There the matter rested.

Although this interviewee was able to keep her domain name, she is "still distracted by the notion that one day Bank of America is going to sue." She described her situation as "haunting" and hopes that "there will be laws to protect small businesses that go through such situations."

An Info-Junkie

Ann Bradley, the founder of "eInfoworld.com," began her Web site to post information about psychology, including a book that she sold through the site. When we visited eInfoworld in May 2005, it was mostly devoted to the story of her battle with the International Data Group, or IDG, owner of Infoworld.com, though it also contained links on such subjects as vegetarianism, narcissism, and divorce.

In February 2000, Bradley received a letter from IDG claiming trademark and domain name infringement and demanding that she "immediately" turn over her registration of eInfoWorld.com.²⁰⁰ She wrote a lengthy response that quoted a recent article about "reverse domain name hijacking" – "the

predatory practice of asserting a spurious claim of trademark infringement in order to seize a similar or identical registered address from a legitimate domain holder." She concluded with a threat of her own: "if you want to play Goliath to my David, I will do this the only way I know how. I have put all this information and more up on my website which has not yet been released to the public." She said she would post the information, and publicize it in chatrooms and other forums, "unless IDG Inc. drops this frivolous action against me."²⁰¹

This produced a conciliatory response. A lawyer for IDG asked Bradley to call her so that they could "hopefully resolve" the issue "in an amicable manner that suits both our needs." Following further emails and phone conversations, IDG said that it would not pursue



*Piggybankofamerica.com,
Ceramic Piggy Bank*

legal action as long as eInfoworld “is not used to confuse, mislead or misinform any reader of the source or content of the information on the site,” and “there are no negative statements about IDG or any of its subsidiary companies.”

Bradley complied with the first request, but not the second. Her home page now reads: “eInfoworld is about information. It begins with the story of a domain name fight. IDG does not own eInfoworld.com. Reverse domain hijacking failed. See entire story on this site: taking on a corporate law firm and winning. No lawyers. You never know what you can do until you try.” She added that IDG had recently published *The Dummies’ Guide to Domain Names* (IDG owns the “Dummies” series), and wondered “if they use themselves as a case study.”²⁰²

Star Wars

In 1997, Vermonter Steve Mount created the personal Web site www.Tatooine.com. As he explained, Tatooine is “the planet where everything gets started” in the first film of the *Star Wars* trilogy – “A harsh desert world with twin suns, Tatooine is home to Jawas, Sand People, banthas, krayt dragons, dewbacks, rontos, human settlers, and the aliens, criminals, and smugglers who populate the Mos Eisley Spaceport.”²⁰³ Mount did not intend a fan site, but because he was planning to host a “Mos Eisley Spaceport” bulletin board, he chose a URL with a *Star Wars* theme.

The bulletin board, he told us, “wasn’t *Star Wars* related – it was just a bunch of guys who got online to chat once in a while. We did not use any graphics or images from the movie.” His “Tatooine” site tracked gasoline prices in Vermont, published fiction, poetry, and family photos, described episodes of various TV programs, and hosted Web pages for the 1989 University of Vermont graduating class.²⁰⁴

A cease and desist letter from LucasFilm, owner of *Star Wars*, arrived in January 2000. Although it referred, in boilerplate fashion, to both copyright and trademark infringement, the letter did not point to any copyrighted text or images that Mount had appropriated, beyond the single word Tatooine; it was therefore really only a trademark claim. Failure to respond within ten days, the letter said, “may result in the initiation of legal proceedings.”²⁰⁵

After receiving the letter, Mount told us, he “contacted people visiting my bulletin board,” and others on the Web, “to see if there was any support for me keeping the site.” He also generated publicity; but in the end decided that “it was an expensive proposition to fight this kind of a suit,” and he lacked the resources. “There was a lot of moral support. My arguments were that I was protected under fair use since it was not a commercial site and that the name was derivative of place names and earth.” But “I had to make arguments to LucasFilm and hope they would say ‘oh yeah, you’re right,’ but they weren’t buying it.”

Within a week, they came to an agreement, whose terms, he says, are confidential, beyond the fact that he handed over the domain name and received “certain technical concessions” – for example, “that hits to Tatooine.com, for some period of time, would continue to come to me.”²⁰⁶ Mount said: “I think I could have mounted a good defense if I had the wherewithal, but it wasn’t worth it. Too bad LucasFilm didn’t do anything with the URL; it just links to www.starwars.com. It died an ignominious death – it was sad and disappointing that nothing special was done with www.tatooine.com.”

We think Mount would have had a good chance of keeping “tatooine.com” had this dispute gone to court. His site was noncommercial and not likely to be confused with an official *Star Wars* site, and he had chosen the name in good faith.²⁰⁷

An Unappreciated Baseball Fan

The former owner of a fan site devoted to baseball player Manny Ramirez started the site in the mid-1990s on his college server. It was, he told us, the “first real fan site” where people could support Ramirez and share messages. In January 2002, he acquired www.mannyramirez.com; he moved the content from his college server to the new site in April 2002.

About a year later, he received a letter from the athlete’s attorneys telling him to cease his use of the domain name because it would “cause the public to believe” that the site was operated, sponsored, or authorized by Manny Ramirez.²⁰⁸ He consulted several attorneys, but each required a substantial fee. Ultimately, he

represented himself and settled with Ramirez’s attorneys. He cannot disclose the terms, but since he no longer operates the site, we can infer that he relinquished the domain name. He says that he gained “valuable knowledge that will inform his decisions in this area in the future.” When he first created the site, he “had no clue about the legality, I just put it up as a fan,” and “I didn’t know that I could be taken to court.” He told us that the experience had “soured” him on “superstars,” and called it “unfortunate when lawyers need to get in the way,” since “at the end of the day you are only trying to be a fan.”

The athlete’s claim of trademark infringement was not very strong because there was unlikely to be confusion about sponsorship, the fan site was apparently noncommercial, and the URL was not registered in bad faith. Decisions by UDRP panels have allowed similar or identical names to be used by fans unless the site is simply a placeholder, there is a substantial likelihood of confusion, or the owner is acting in bad faith.²⁰⁹

Preserving Wildlife

In May 2004, Google received a take-down letter alleging copyright infringement on a site devoted to wild animal preservation. The dispute was really about a contract for redesign of the site. The designers, who claimed they had not been paid for their work, evidently thought that getting the site taken down by asserting copyright in the design would generate the desired payment. The site owner did not acquiesce, and a lawsuit was filed. It settled when the site owner paid a portion of the designers’ bill; the court, he told us, threw out the copyright claim. Reflecting on the experience, our interviewee critiqued the DMCA take-down procedure: “just because someone is crying wolf doesn’t mean you have to respond.”

Strong or Reasonable Defenses

The National Debate

One of the most striking examples of an ill-advised cease and desist letter came from *The New York Times* and sought to suppress a parody of the *Times*’s corrections page that appeared on “TheNationalDebate.com.”²¹⁰ Robert Cox, operator of The National Debate,

told us that the conflict began in 2003 when he became concerned that the *Times* required everyone except op-ed columnists to publish corrections; the op-ed writers were permitted to decide this on their own. To protest this policy, he began chronicling errors in op-ed columns and publishing them on a “Columnist Corrections” page.

.....
“...routine elevation
of copyright to a right of
censorship could easily squelch
active debate and criticism
of important ideas.”
.....

Around this time, *Times* columnist Maureen Dowd wrote a column quoting President Bush and, according to Cox, “she manufactured the quote by taking something he actually said and putting in ellipsis dots, materially altering what he said.”²¹¹ Cox phoned the *Times* repeatedly about the Dowd column. “The column was published on Wednesday and was syndicated on Thursday, so there was time to correct before it got printed in other papers. But when I finally reached someone, I received questions like ‘Who are you with?’ and ‘Do you have an ax to grind against Maureen Dowd?’ I spent the next year trying to use my blog and emailing other forums to get the message out – to pressure Dowd to issue a correction.”

A fellow journalist suggested that Cox tweak the *Times* by parodying its corrections page. He took both liberal and conservative op-eds, and wrote fake corrections “in a *Times*-esque style. People in the blogosphere thought it was very funny.”

The *Times* did not. Its March 2004 take-down letter to the ISP Verio demanded that it block the corrections page.²¹² (Cox also received a cease and desist letter.) Verio told Cox that he had to remove the page within 72 hours; otherwise his site would be shut down.

At that point, Cox took to the blogosphere for help and advice. He soon received offers of *pro bono* representation. While his attorney, Ronald Coleman, prepared a response to the *Times*' demand, Cox took down his parody corrections page to avoid having his entire site shut down by Verio.

Coleman's reply to the *Times* expressed amazement that the paper could have "a good faith belief that our client's web page was not protected by the First Amendment as a parody." He quoted the *Times*'s own impassioned editorial three years before, defending the novelist Alice Randall's race-sensitive reworking of *Gone With the Wind* in her novel *The Wind Done Gone*.²¹³ Citing the Supreme Court's "Oh, Pretty Woman" decision, the *Times* had written that Randall's novel necessarily "requires some borrowing from the original," and that "in an era when media conglomerates control the rights to vast amounts of intellectual property, routine elevation of copyright to a right of censorship could easily squelch active debate and criticism of important ideas."²¹⁴ Within hours of receiving this letter, Cox says, the *Times* announced that it would withdraw its complaint.

In the end, Cox agreed to put a sentence on his corrections page making clear that it was a parody. In March 2004, the *Times* announced a new policy requiring corrections of op-ed columns. Cox told us that the experience made him realize the need "to organize other citizens and journalists to resist efforts by any type of government or organization to shut down speech they disagree with." With colleagues, he created the Media Bloggers Association as a means to organize and provide legal defense.²¹⁵

Mastercard's Priceless Image

Brian Martin operates Attrition.org, an acerbic Web site "dedicated to the collection, dissemination, and distribution of information" about the computer security industry. Among the humorous image galleries and spoofs on the site are several, contributed by readers and fans, that parody MasterCard International's advertising campaign using the phrase, "Priceless ... There are some things money can't buy; for everything else there's MasterCard."²¹⁶

In June 2001, Martin received a cease and desist letter from MasterCard claiming exclusive ownership of the "Priceless" trademark and accusing Attrition.org of "blatantly" copying the style of the "Priceless" ads in a manner that was not only infringing, but "often obscene." The letter demanded prompt removal of the material; "otherwise, MasterCard will have no choice but to consider legal action."²¹⁷

Martin publicized the threat in a mood, as he told us, of "hey guys, get a load of this – what are they smoking?" A few of the lawyers on his email list told him that Attrition was "on solid ground," but he did not engage legal counsel. Instead he replied, based on his own research, that MasterCard's trademark claim was groundless because there was no likelihood of confusion; and its copyright claim was equally bad, because parodies are protected as fair use.²¹⁸ MasterCard took no further action, and the ad spoofs remained up for more than a year.

Martin commented: "the biggest irony is that the legal pressure created negative publicity," and "has only spawned more parody," yet MasterCard "still sends out those C&D letters." He has received emails from other recipients "to find out how I responded to this. I told them not to back down; they didn't have to. I did say that I was not a lawyer, but based on experience, they had good cases."

"This kind of issue needs exposure," he concludes. Corporations are "trying to pressure people, trying to use scare tactics and legal tricks." In early 2005, one Priceless parody could still be found on the Attrition site. The image showed a youth thumbing his nose at an overweight police officer. The caption read: "Thumbing our nose at your pompous bullshit: PRICELESS. There are some things only hubris can buy. For everything else, there's *Attrition*."²¹⁹

Latter-Day Saints

Roger Loomis, a former Mormon, established "www.LDS4U.com" as an "unauthorized investigator's guide to The Church of Jesus Christ of Latter-day Saints." The site is not hostile to the Church, but includes discussion and analysis; it seeks to "fairly present both sides and let the

reader arrive at his own conclusions.”²²⁰ Until 2002, it included excerpts from six official Mormon “missionary discussions.”

In July 2002, Loomis’s ISP received a take-down letter from Intellectual Reserve, Inc., the owner of the Church’s missionary discussions. The ISP forwarded the letter to Loomis, directing him to remove the items “ASAP.” Loomis replied directly to the Church’s attorney: “It is my personal belief that these pages were not copyright violations, but I will go ahead and remove them from the Internet as you requested.” Two months later, the attorney demanded that he remove three images as well, one of Joseph Smith, the Mormons’ founder; another of gold plates (important icons in Mormon doctrine), and the third of Gordon Hinckley, the current Church president.²²¹ Again, Loomis complied.

When we asked why he acquiesced, Loomis told us that it was easier to remove the material than to get into a “big battle,” especially since he was worried about paying Intellectual Reserve’s legal fees if he received an unfavorable ruling. The risk of money liability was not worth the “emotional time commitment.” At the same time, he thought that he had a fair chance of prevailing if he had been able to afford a good attorney.

Durango Bill

Bill Butler operates www.durangobill.com (“Durango Bill’s Home Page”), a collection of information on subjects ranging from paleography, the Grand Canyon, number theory, and “the fallacies of Creationism and ‘Intelligent Design Evangelism’” to a description of ways to “fight back against DMCA abuse.” In July 2004, Yahoo, Butler’s ISP, received a take-down notice asserting that durangobill.com was using a logo from Online Christ-Centered Ministries (OCCM) on a Web page titled “Durango Bill’s Example of a Typical Young Earth Creationist.”²²² The page critiqued Jason Gastrich, a Creationist and the apparent proprietor of OCCM. Their disagreements ranged from Butler’s accusation that Gastrich faked his educational credentials to an exchange regarding Gastrich’s claim that the Colorado River flows uphill.²²³

In response to the take-down letter, Yahoo sent Durango Bill a “Notice of Infringement”

instructing him to remove the “Jason Gastrich” page or else Yahoo would shut down his site. Over the following days, Butler repeatedly tried, without success, to contact Yahoo to determine which parts of the page he could delete to comply with the notice. On July 23, his site was shut down. Three days later, he was finally able to reach someone at Yahoo, and was allowed to delete the Gastrich page and post a note explaining what had occurred.



Thumbing our nose at
your pompous bullshit:

PRICELESS.

There are some things only hubris can buy.
For everything else, there's



*Attrition's "Priceless" Parody, by Brian Martin/
Image by Jay Dyson*

Meanwhile, Butler found a Web site that provided a sample DMCA counter-notice.²²⁴ He used the sample to compose a response to Yahoo asserting that his Web site was within fair use. Under the law, Yahoo now had to allow him to re-post his Web page, unless Gastrich filed a lawsuit against him. On August 4, 2004, Gastrich did sue, in California federal court.

Butler retained a lawyer, who moved to dismiss Gastrich’s complaint on the ground that the federal court in California had no jurisdiction over him. (He operates his Web site from his home in Colorado.) The motion succeeded in December 2004. After nearly six months, Butler was able to restore his “Jason Gastrich” page.

“Folded Up Like a House of Cards”

Artist Dee Dreslough was a devotee of science fiction novels by Anne McCaffrey – the *Dragonriders of Pern* series, *Renegades of Pern*, *Planet Pirates*, and many others. In the mid-1990s, Dreslough created a Web site and began taking commissions for original works of art. At the request of fellow McCaffrey fans, she drew dragons and other characters. She told us: “I drew pictures of people and dragons inspired by

her books, but not created by Anne McCaffrey. These were original characters based in her book-worlds created by other fans.” She thought that there were “enough levels of filtration for the work to be allowed.”

Dreslough elaborates on her Web site: “my depictions of Pernese dragons differed from McCaffrey’s own definition of the dragons. My dragons had ears, proto-horns rather than head-knobs, and non-bug eyes, as well as varied hues and stripes in the skin.”²²⁵ She posted her creations on a Web page called “Dee’s Dragonrider Art Gallery.”

In April 1997, McCaffrey’s attorney sent a cease and desist letter citing both copyright and trademark infringement. The letter began by quoting Dreslough’s own Web statements – that her art was inspired by *Dragonriders of Pern*, and that “if mentioning my inspiration is something that can get me sued ... oh well. If I’ve goofed, let me know where to fix and I will.” The letter demanded that Dreslough “remove your art gallery from the Internet immediately,” and promised legal action if she did not comply. It said she was guilty of contributory copyright infringement for every other Web site where a fan had posted one of her Pern-inspired drawings; and closed by mentioning that in previous lawsuits, McCaffrey had won damages “in the middle and low six figures.”²²⁶

Dreslough told us that at first she “felt horrible”; she thought she had “done a bad thing” and offended her literary hero. But she was also distressed that the hero had resorted to legal threats. “If one of our friends-in-common had just told me, ‘Anne’s annoyed by your Web site; take it down,’ I would have done so in an instant.”

Dreslough was frightened by the threats – particularly the massive damages that might accrue based on “contributory” infringement. At the time, she told us, “\$15,000 was all that I made in a year. I couldn’t afford a lawyer to argue the case. I couldn’t even afford a lawyer to have the case researched.” She removed the art from her site and asked all of her fellow fans to do the same.

“I folded up like a house of cards,” she reflected. “When I had to destroy my art, that

really hurt. Did McCaffrey own my art, or did I? I’ll never know, and it doesn’t matter now.”

Possible Defenses

The Avatar Wars

Ronald Cools, a former Avatar follower who was responsible for many of the critical discussion group postings described in chapter 3, told us that his critiques, including copies of Avatar course materials, were meant to expose what he considers a “psycho-cult.” He was not the only Avatar critic who posted course materials. Whatever the mix of commentary and copying in these posts, the result was that throughout 2004, Star’s Edge’s take-down letters did suppress criticism of its program.

Cools, a resident of the Netherlands, also created his own Web site in order to “expose the policies of Star’s Edge and to warn people about the Avatar program.” The Web site explains that he had been involved in Avatar for eight years “and became a licensed ‘Avatar Master’ in 1992. During this time I did not know that Avatar derived directly from Scientology nor that its creator Harry Palmer has been a dedicated Scientologist for many years.” At the bottom of Cools’s site is a disclaimer: “This Web site is not affiliated with Avatar, Star’s Edge Inc, Harry Palmer or/and Scientology. Its objective is to inform the public within the limits of Free Speech.”²²⁷

In February 2005, Cools received his first cease and desist letter from Star’s Edge. It referenced his discussion group postings but not his Web site, and referred to both Netherlands and international law. Someone advised him that since the cease and desist letter was in English and not in Dutch, he did not have to respond. Cools continues to post information about Avatar and Palmer, both on his own site and in discussion groups.

Film Clips and Commentary

The operator of a movie Web site learned in 2004 that his ISP had received a take-down notice from a distribution company complaining that the site contained stills and footage from one of their films without permission. He complied with the demand, even though he was aware of fair use and thought that it gave him a

defense. He believed the company's real quarrel was with his negative review of their movie. He removed the material because he thought it was the "easiest course of action," and did not want the ISP to de-list his site.

Reprints on Blogs

In early 2004, the operator of a blog site on political issues reprinted part of an article in the course of a discussion of Reform Judaism. The article's author sent a letter explaining that he was a freelance writer whose only source of income was payment for his work. He said that the blog had reprinted more than 750 words from his article, and enclosed a bill for \$150. Somehow, this dispute escalated. The blogger refused, and asked his wife, a lawyer, to represent him. He told us that he became too personally invested in the case. Certainly, paying the author \$150 would have been simpler than the eventual settlement of \$1,500. His wife feared that a legal defense would cost upwards of \$50,000, "and to my regret, we paid them off."

Teddy Bear Woes

The proprietor of a teddy bear business contracted with Overture.com to buy a sponsored listing using the search phrase "Vermont Teddy Bear." Two months later, he received a cease and desist letter from the Vermont Teddy Bear Company (VTB), asserting that it had been using the trademark since at least 1985, had sold "hundreds of millions of dollars worth of teddy bears," and had "expended over 100 million dollars" promoting the Vermont Teddy Bear mark.²²⁸

Our interviewee ignored the letter, and did not hear from VTB for another four months, when two emails arrived; again, he did not reply. In January 2005 – shortly before Valentine's Day – he received another letter and a flurry of emails threatening that he would be liable to VTB for all of his profits multiplied by three, in addition to VTB's attorney's fees. At this point, he checked with Overture, "and they said that I was not doing anything wrong." But four days later, they removed his ad. He believes that VTB "put the screws" to Overture. He sought counsel, but the lawyer was indecisive. In the end, he pulled a similar ad that he had bought from Google.

The teddy bear entrepreneur compares his story to David and Goliath: a big company with deep pockets "trying to strongarm me with their beliefs." Although his purpose was apparently to draw potential customers interested in Vermont Teddy Bears to his site, this "initial interest confusion" wouldn't necessarily create liability for infringement.²²⁹

A Technical Violation

Our last interviewee, Charles White, did not have a defense because he picked the wrong suffix for his intended fan site dedicated to the late Grateful Dead star, Jerry Garcia. White bought `jerry.garcia.name` in 2001, but had not begun to build the site when he received a cease and desist letter asserting that "the Estate of Jerome J. Garcia" owned numerous domain names referencing the beloved guitarist, and used them to market "a wide variety of consumer products."²³⁰

Although Jerry Garcia himself might have cringed at such an assertion of private property control, and ordinarily a fan site – or a critical site – acting in good faith can use the name of a company or a celebrity for its URL, the estate's attorneys correctly pointed out that there are specific rules for use of the ".name" domain. As ICANN's Web site explains, registrations using the ".name" ending must either consist of an individual's own name, or the name of a fictional character where the registrant "holds trademark or service mark rights" in that character.²³¹

Thus, Charles White could have relinquished `jerry.garcia.name` and registered a different URL for his fan site, using a .com, .org, or .net ending. Instead, he told us, he refused to transfer the name; "at that point they said they'll go through arbitration." "ICANN asked for my response within 90 days and I wasn't able to do it since I was in the middle of my semester at school. I eventually got a notification about an official decision." He would have liked to mount a defense, but did not have time. "It's one of my less talked-about achievements," he said, "having the ghost of Jerry Garcia come back and haunt me."

Internet Infidels and Homeland Security Blues: The Online Survey

We posted our online survey, entitled “Copyright, Fair Use, and the Impact of Cease and Desist Letters,” on our Web site from the fall of 2004 to spring 2005.²³² Organizations that encouraged their members to fill out the survey included the National Alliance for Media Arts and Culture, the Association of Independent Video and Filmmakers, Women Make Movies, the National Arts Journalism Project, National Video Resources, Independent Feature Project, the Center for Arts and Culture, and the College Art Association. We received 290 completed surveys, of which 58 described controversies, and the remaining 232 gave opinions and comments about fair use and copyright.²³³

The largest category of respondents described themselves as professors or scholars (131). Visual artists were the second biggest category, with 80. The great majority (263) had heard of fair use as a defense to copyright or trademark infringement. 231 said they had relied on fair use in deciding whether to borrow, reproduce, or quote from somebody else’s work. Of the 58 who had been involved in at least one controversy, 14 said they were the owners of IP-protected material; 40 said they were borrowers; two said they were both; and two said they were neither. Only four reported that a lawsuit had been filed.

Twenty-three of the respondents said they had received cease and desist letters; six said they received DMCA take-down notices. 17 of the 23 who received cease and desist letters either acquiesced, partially acquiesced (for example, negotiated a settlement), or learned that an ISP removed the item at issue.²³⁴ Among the recipients of take-down notices, one said that he acquiesced – although this was only temporary – and one learned that an ISP took down the material. Three did not acquiesce and one did not respond to the question.²³⁵

What follows are some of the narratives; in a few instances, we have supplemented the survey responses with information from follow-up emails.²³⁶

Gaelic Dreams and Closeted Gay Artists

- The nonprofit group Internet Infidels operates both an online discussion forum and a site called the “Secular Web” (“a drop of reason in a pool of confusion”).²³⁷ Among the contributions to the discussion forum is an “Answers in Genesis Cartoon Parody Contest,” which invites readers to send in parodies of the cartoon-style lessons in Creationism and other fundamentalist beliefs that are found on the “Answers in Genesis” (AiG) Web site.²³⁸ One parody of AiG’s “CreationWise” comic strip, for example – the Infidels’ “CreationDumbass” cartoon – shows a fundamentalist acknowledging: “I guess I should try reading something else [other than the Bible] for a change.”²³⁹

In January 2004, Infidels received a cease and desist letter from AiG, asserting that both the “CreationWise” parody and another cartoon called “After Eden” infringed AiG’s trademarks. The letter acknowledged that the cartoons were parodies, but insisted that they were nevertheless “likely to cause confusion as to affiliation.”²⁴⁰

Jim Lippard, president of Internet Infidels, felt that AiG “had a legitimate, but exaggerated complaint.” The group responded by removing all AiG trademarks, names of original artists, and copyright notices. The parodies themselves remained on the discussion site, with new ones appearing regularly.

Lippard said that the chilling effect of the cease and desist letter was “minimal, but could have been more significant.” His board discussed

deleting the postings, “which would certainly have been an easier route to take. Had the organization and board members been more risk-averse and less proponents of free speech, a chilling might have occurred.” Asked why Infidels offered any concessions at all, he replied: “We consulted with an attorney who was willing to take our case, but we decided it was better to come to an agreement because AiG brings in \$10M/year in donations to our \$90K/year, and they get their legal services donated to them, while we would have had to pay (though we did get the consultation for free).” He added that AiG “used a highly distorted version of events in their April 2004 fundraising letter.”

- Inya Nest’s fan fiction site, “Stalkers Nest,” contained “a list of current Works in Progress,” along with the names of “FanFic stalkers” whose job was to prod authors for more installments. One of the Works in Progress was called “Gaelic Dreams,” which led to a cease and desist letter in November 2002 from Gaelic Dreams Imports, a company describing itself as “your source for all things Scot and Irish. Now offering Welsh & English imports too!” The letter demanded: “all references to the name ‘Gaelic Dreams’ must be immediately removed from your website.” It warned that Gaelic Dreams Imports would “prosecute any and all who knowingly or through misdirection violate the copyright laws of the U.S. and international community.”²⁴¹

Nest submitted the letter to Chilling Effects, then informed Gaelic Dreams Imports that she had done so. After this, “they didn’t bother me any more.” She believed that Gaelic Dreams Imports was “just trying to threaten without much legal proof behind them. I was glad that my friends suggested that I report them, so that I did feel more secure.” Yet the author of the “Gaelic Dreams” story later renamed the entry, partly because of the import company’s threat.

- Stefan Didak operates World Wide Warning, a site that warns of “fraudulent businesses and activities.”²⁴² Didak began the site as “a result of the displeasure of almost having been defrauded by a con artist and finding myself meeting other people who had similar or worse experiences with said con artist.” The object of

his displeasure, David Waathiq, is described on the site as having “a long trail of defrauded inventors, unpaid creditors and vendors, upset partners, contractors and clients in multiple ongoing schemes where he convinces prospects that he can provide services that in many cases he cannot.”²⁴³

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*“Librarians let people
come in and read back issues
of Consumer Reports”*

.....

In April 2004, Google received a DMCA take-down letter from an attorney, demanding the removal of links and search terms relating to David Waathiq and leading to www.worldwidewarning.net. The letter asserted copyright violations for the use of photographs, graphics, literary work, personal and business documents, and text marketing language.²⁴⁴ It is not clear how Google responded, but a year later, using “David Waathiq” as a search term on Google still led to World Wide Warning’s David Waathiq page, headlined “Professional Con Artist.”

Didak believes that for Waathiq, the DMCA take-down procedure was “a cheap and simple” way to try to stop criticism of his activities. Didak himself never received a cease and desist letter; and no legal action was taken.

- Robin Lionheart posts mirror Web pages of material that, he says, has been “shut down by legal bullying.” One such page mirrored an article entitled “Amway: The Untold Story,” with a summary and excerpts from *Consumer Reports* reviews of Amway products. In February 2002, Lionheart received a cease and desist letter from *Consumer Reports’* attorney, Wendy Wintman, objecting to the summary and excerpts.

Lionheart responded by correcting factual errors in Wintman’s letter and asserting that his quotes and summaries qualified as fair use. An exchange of emails followed, during which Wintman apologized for her mistakes, which

she attributed to the many form letters that she sends, but insisted that “you are giving consumers for free what we charge for as part of our subscription.” Lionheart commented: “Perhaps I should inform her of another ‘commercial’ threat to consumer.org’s business: public libraries. Librarians let people come in and read back issues of *Consumer Reports*.”²⁴⁵



“*Chrissy Homeland Security® Blanket*” 2004, Image courtesy of Chrissy Conant, www.chrissyconant.com

- In March 2003, the artist Chrissy Conant created a three-part sculptural project using the U.S. Department of Homeland Security terms “severe,” “high,” “elevated,” “guarded,” and “low” in colorful chokers, blankets, and wall hangings.²⁴⁶ Conant applied for the trademark “Chrissy Homeland Security® Blanket” and later, for additional trademarks for the wall hangings and chokers. About two years later, she received an email from one Shirley Ivins, who claimed to be the owner of the “Homeland Security Blanket” trademark. This was followed by a cease and desist letter from Ivins’s attorney, demanding not only that Conant stop using the mark, but that she supply an inventory “of all items in your possession that bear the infringing trademarks,” that she destroy all such items, and that she produce an accounting of her sales in order to determine the amount of money that she owed to Ivins. The letter threatened legal action if Conant did not comply “within the time frames set forth.”²⁴⁷

Conant didn’t respond initially, but after receiving another communication from Ivins, “that unless I pulled my blankets out of my retailer locations, she would contact them and tell them that I had infringed upon her trademark,” she consulted an attorney who “had me write a response, telling her that I disagreed with her accusation, and if she threatened my relationships with my vendors, I intended to prosecute my claims against her.” Ivins or her attorney evidently contacted Amazon.com, which told Conant that they had cancelled her listing “because I ‘may’ be in violation of their community rules prohibiting copyright infringement.”

Conant did not go through with her threat to sue for financial reasons. She continues to sell her limited edition blankets and other politically loaded creations directly and through an art gallery and a few museum shops. She has heard nothing further from Ivins, but is annoyed that someone can close down a major venue for sales such as Amazon simply by making an accusation.

- Jonathan Katz, an art historian and expert in lesbian and gay studies, wrote: “I wasn’t involved in controversy, because I knuckled under, but in two cases, I’ve wanted to publish images of artists’ work in the context of an article on the relationship between their work and their sexuality, and both times permission was denied. I felt confident that I was covered under fair use, but the publishers felt otherwise.” The first situation involved the catalog for a Robert Rauschenberg show; the second, an article on Georgia O’Keeffe. The Rauschenberg catalog, accompanying an exhibition at Yale, appeared without images of the artworks, but the O’Keeffe article “turned so centrally on the images that it remains unpublished six years later.”

“Fair use doesn’t protect against lawsuits,” Katz adds, “and publishers are by nature timid. The effect is that publishers refuse to publish work they deem controversial, and for those of us who work in gay and lesbian studies, censorship has therefore become a way of life.”

Katz supplemented his survey answers in a conversation with Eve Sinaiko of the College

Art Association. He told her: “I am not able to publish on Rauschenberg, Twombly, Johns, and other artists because all their work is in copyright, and they withhold permission to reproduce work based on disagreeing with my accompanying text, which identifies their sexuality as central to their achievement.” His book on the post-Abstract Expressionist generation, with 140 images, was accepted by University of Chicago Press, but the publisher insisted on indemnification for any claim of copyright infringement. “I met with an attorney,” Katz said, “who advised me that though I would probably win the case – that is, my fair use position is probably a strong one – the financial resources of these artists are such that the costs to me would be too punishing. As a consequence, I have begun negotiations with another publisher in the hopes that they will not insist on indemnification.”²⁴⁸

Katz concludes that the chilling effect “goes beyond publishing: it influences what museums do.” Recent Twombly and Rauschenberg exhibition catalogs and wall labels did not mention gay issues, even though “the works in question centrally thematized sexuality.”

Political Art and Private Censorship

- A cartoon artist recalled: “It was about 1990 and David Duke, a notorious Klansman, was running for governor of my home state, Louisiana. I did a series of paintings that borrowed Charles Schulz’s Snoopy. It seemed necessary to use a beloved American icon for political reasons. People will pay more attention to a hanged dog than they will to a hanged man.” When the works were exhibited at a New York art gallery, “United Features Syndicate objected. My attorney said parody, and United went away.” His only loss was lawyer fees.
- Another artist wrote that in the mid-1990s, he created a montage of Elvis Presley and Vietnam War photos as part of a work titled “The Hero’s Journey.” It was produced as a series of prints and posted on the Web. He received a cease and desist letter from the archive that owned the original photographs, and replied “with a detailed fair use argument.” He “discussed the matter with a lawyer who showed little interest

.....
“Having shallow pockets and no outside support, I had no choice but to acquiesce.”
.....

in taking on such a corporate entity.” Since he was about to change ISPs, he “agreed to take down the Elvis-in-Vietnam material,” but did not agree to destroy the prints, which were later purchased by a museum in Finland. He reflects: “I made original artworks that commented on the myth of the hero in a contemporary context. Having shallow pockets and no outside support, I had no choice but to acquiesce.”

- A filmmaker reported that in 1994 he filmed a public event during which a high school band played a copyrighted musical work. He received a cease and desist letter and ended up paying a license fee. Outcome: “They were happy. We felt screwed. I’ve been a filmmaker for 25 years, most of them making documentaries. I’ve never seen the climate WORSE for artists trying to get work out that contains copyrighted material. Few if any lawyers, distributors, or insurers are willing to accept fair use as an argument and take a stand.”
- An art historian wrote: “I published an essay on the Mexican artist José Clemente Orozco’s ‘Catharsis’ mural, in the Palace of Fine Arts in Mexico City. I wanted to reproduce an image of the mural, so I contacted the family (as the copyright holders) and the Mexican government [The National Institute of Fine Arts, which oversees image rights]. I was told by one of the surviving children of the artist that he would not grant me permission unless he could review my essay. We proceeded to go back and forth for three months, never getting beyond the first page. I realized that this was a cat and mouse game for him, something that made him feel necessary and involved in scholarship, and that he would never approve of my text on ideological grounds (he insisted, for instance, that I could not refer to Diego Rivera in the article if I wanted to reproduce his father’s work, among other ridiculous things).

“Without his permission, the government would not grant me permission either. The Press and I then decided that it would fall under the category of fair use if I reproduced one of my own ‘tourist’ photographs of the mural. So I did this. The Press also told me that I could publish a detail of the mural, photographed from a book, as that could be treated like a citation. Or, if I could find an image of the work from an out-of-print journal or defunct press, I could photograph that. Both options seemed to me absurd.”

- A scholar described his inability to use a photo taken by David Douglas Duncan of Pablo Picasso watching his daughter Paloma drawing at a table, for a book chapter on Picasso’s interest in his children’s drawings. “It was the only documentation of an essential point I wanted to make, and Duncan decided he didn’t like my point of view and refused to let me use the photo. The publisher was afraid of being sued and took it out.” In other situations, he has managed to convince reluctant copyright holders to grant permission: “I was able to persuade the owners to relent, but if they had elected not to, my publisher was unwilling to use fair use because of the fear of a lawsuit.” This “self-censorship by publishers,” he says, “has significantly impaired my ability to comment on and interpret visual material. It is essential that any visual image that is shown publicly be available for comment and criticism; otherwise we have no free discourse over things that significantly shape our cultural and political views.”

- An art scholar wanted to reproduce paintings by a 17th century Italian artist, which were in the collections of five different museums. “I wanted to show this artist’s work to reinforce my discussion about these paintings in a book. I copied the images from the museums’ Web sites or when they weren’t available online, I scanned them from museum catalogs. I created a composite of four paintings by this artist to illustrate the similarities and differences that were obvious when the works were placed next to each other. The publisher of my book would not accept my fair use statement when I submitted this in place of rights agreements and required that I obtain permission from each of the museums and personally pay for all

license fees. This is just one example of fair use not being honored by publishers. As a visual resources curator, we exercise fair use extensively in order to make images available for use in the classroom and for study. The teaching of art history could not happen without fair use!”

- A film scholar wrote: “I made a still from a video of a feature film available from the university library. My scholarly work describes this still in detail in order to make a particular point. The U.S. copyright holders [that is, movie studios and archive houses] do not produce stills to order, but only the ones they pre-select. The copyright holder’s still would not have served my purpose because it was a few seconds away from the moment I wanted. I was willing to argue fair use, but the publisher was not willing to risk taking on a major Hollywood film house. Our solution was that I hand-traced a photocopy print of the still I had produced, reducing it to a kind of line diagram. The essay is now published, but I regard the solution as a major compromise. I would think twice before writing again on film. It was as if the film house was dictating what I could write about, since the choice of image to be published was not mine if I wanted to reproduce the image as a still photograph.”

- A videographer who is hired to document family histories wrote: “Many times I will lose work to others for not being willing to break copyright law and use a song that is protected. ASCAP and BMI won’t even answer requests for small uses. People want to have certain songs that have been a part of their life, their family, or any other aspect of their world, and I can’t give that to them because large companies won’t even acknowledge my existence to give me permission.” He feels that copyright law should not require clearance in these situations. “There’s no need to stop people from having things that have touched their hearts in documentaries about their lives.”

- Anne Elizabeth Moore describes herself as a “cultural interventionist” who has used images from the Mattel Company’s “American Girl Doll” catalog to create parody gift cards containing political commentary on the materialism of

Mattel's products. Instead of clothes, makeup, or other things that Mattel encourages girls to list on the cards, Moore wrote statements about "what couldn't be purchased that might address young girls' needs better": for example, "healthy body images," "safe and effective birth control," and "equal pay for equal work." She called her project "Operation Pocket Full of Wishes" and attempted to distribute her parody cards at the American Girl Place store in Chicago, but was forcibly ejected.

Knowing Mattel's reputation for litigiousness, she was too intimidated after this incident to include her works as illustrations in three articles that she wrote about Operation Pocket Full of Wishes,²⁴⁹ or in speaking engagements. She writes that her inability to rely on fair use "has severely limited the venues in which my critique of Mattel has appeared."

- Another politically engaged artist, who creates "deconstructive texts," wrote that for one major work, she "borrowed all over the place: literature, schoolbooks, emails, news media, philosophy and websites." Among her found texts were email posts from the "Spoons Collective Deleuze and Guattari List Server," a discussion group dedicated to the authors Felix Guattari and Gilles Deleuze.²⁵⁰ She did not receive a cease and desist letter, but "I did receive 100s, literally, of emails from professors, artists, and writers from all over the world," protesting her quotations.

"I replied to the actual authors of the posts. There were too many to remember. I deleted it all once it was over, about a year later. I continued to receive hate emails for months on the subject. I eventually replaced all controversial sections with quotes from Critical Art Ensemble's essay on the ill effects of copyright."

- Finally, in chapter 3 we described a controversy involving a critic of Chick Publications' Creationism cartoons. One survey participant directed us to another parody of a Chick cartoon, called "Charlie's Ants."²⁵¹ He wrote: "Awaiting

inevitable cease and desist from Chick's lawyers. None yet, but others have received them."

The Copyright Owner's Perspective

- A professor wrote that she had organized an exhibition of another artist's work at her college gallery. The student newspaper reproduced one of the works without permission, but with a caption that said, in effect, "if you want a little nude action, go by the art gallery." The article about the exhibition was equally sophomoric. She "felt that it was important to send the message that visual images are not free for the taking, even for universities citing fair use."

She protested to her dean, who defended the students' free press rights, even though, she said, he had censored art on campus in the past.²⁵² "I was very disturbed that my dean was unwilling to give my concerns a fair hearing. I saw this incident as a part of an ongoing pattern of disregard for the rights of visual artists." So she wrote to the college president, who was more supportive. As a result, the college gallery "has implemented a new policy that any reproduction of art work must originate with the gallery director. Signs stating 'no photography' have been posted outside the gallery."

- An artist and adjunct instructor refused her university's request that she sign over the copyrights in any work she created while in its employ. She notes that her current employer, a junior college, "is now attempting to do the same, even if the work is done outside the college."

- The coordinator of rights clearances at a major museum wrote: "My one concern is the assumption by scholars that anything they publish is educational and therefore falls under fair use, regardless of the status of the publisher or publication. For example, a professor



Anne Elizabeth Moore, "Free Tampons" from Operation Pocket Full of Wishes

reproducing an artwork in a book with a print run of 20,000 is not considered to be educational, but a commercial use.”²⁵³

- “A librarian wrote: “I was once caught in the middle between a professor and a copyright holder. Professor wanted to put five complete photocopies of a single copyrighted book on class reserves in my library (no permissions requested or received). I refused to accept more than one copy for reserves. Around the same time, I attended a copyright symposium in which a librarian colleague stood up and declared that she actively encouraged art students never to request permissions. Her position struck me as irresponsible. I feel that while librarians should be strong defenders of fair use, they should also be willing to defend copyright holders.”
- A teacher commented: “Students routinely take images off Web sites with no sense that they belong to someone else. They also pass software and music on to each other as though everything was seamlessly available. They seem to understand the Internet as an extension of television and it is just there for free. It is disturbing to see an entire generation growing up with a resource that they see as free for the taking.”
- A studio artist wrote that she was not credited for drawings, maps, and text that were used in a PBS special. “I consulted with an art specialist attorney who reviewed my contract, said it was clear and I was correct. It would cost \$10-20,000 to sue them. I couldn’t afford it.”
- Another artist wrote: “Paintings were made directly from my copyrighted artwork, with a little changed in the background, but basically verbatim copies. These then were sold in galleries and until recently on the Web. I did not have enough money to pursue my suit with the other artist.”
- A sculptor complained that one of her installation pieces, consisting of inflatable figures, a tree, and “scientists spinning around the tree” was copied in a work with similar elements. This second sculpture was obviously “influenced by our work, but there is no integrity, no credit given to us as artists for creating such works or for influencing him.”

The problem here is that copyright law does not create ownership of ideas.

Comments on Fair Use

- “I have been told by my school that I am prohibited from showing videos on the life and work of Robert Rauschenberg, Chuck Close, etc. due to the fact that the school is a ‘for profit’ institution. Of course, at colleges and universities with high tuition, endowments, investments, and generous alumni, this is not a problem because they are ‘not for profit.’ Give me a break!”
- “My current institution is extremely vigilant about following copyright law to the letter when it comes to course packets and electronic reserves. Consequently, course packets can easily reach \$100-200. Electronic reserves are likewise not an option, for if the article or text has been used once before, they won’t put it up on the system without press approval. If the press demands money (which most do) for subsequent postings, the college won’t post it. So professors are faced with the following options: (1) we cannot use supplementary materials; (2) we can create a combination of paper and e-reserves, which can be really hard on large classes where lots of students have to share the information; (3) we can charge the student an outrageous amount for a packet of xeroxed essays that they won’t be able to sell back; (4) we can break the law.”²⁵⁴
- “I think that your questions address legal actions, but not the sort of fears that most faculty have about fair use. The Web site on which we post images is only open to students enrolled in a particular class at a particular time. This means that no one else (including other faculty) has access to these images without having to go through the slide librarian. This block is to protect copyright, but it does hamper use by faculty and students.”
- “I am anxious that for-profit entities will eventually put obstacles in the way of my teaching efforts. I am also frustrated that there seems to be a ‘don’t-ask-don’t-tell’ atmosphere around fair use and intellectual property: if you ask whether you have permission to use something, you risk being denied, so better to remain quiet.”
- “Reproducing color images has become so prohibitive for scholarly presses that some have stopped publishing art history books. We are terribly hampered in discussing works of art if

they are reproduced only in black and white, and even securing those images is terribly time-consuming. It would be great if museums would make a blanket allowance for use of images of their holdings so long as the images are not distorted, details are clearly labeled as such, and the scholar would not make a significant profit.”

- “The high cost of securing reproduction rights for photographs of works of art created centuries ago prevents many scholars from fully publishing their research findings. Museums should not be allowed to place such high copyright fees on their photographs of these works, as if they were ‘original creations.’ The works of art are clearly in the public domain and should be accessible for scholars. The current situation is disheartening.”²⁵⁵
- “The question of ownership and fees for art made in the second half of the 20th century remains a concern for those of us who work in this field. For my last book, I sometimes had to pay two or three entities (museum/family/licensing agency) that added up quickly, or the fee requested was simply more than I could handle. This effectively takes material out of circulation, especially if the owner is not sympathetic to one’s project or approach.”
- “I am a strong advocate of fair use for scholarship and believe that it is being endangered by profit motives. Many university presses are dropping art publications due to rising costs and fear of litigation. In the long run, this will adversely affect copyright holders, as their work will not be made known through the critical act of scholarship, and students will not be made familiar with their work in the classroom.”
- “As an art historian, I have to ask for permission to reproduce images. Sometimes the charges are outrageous and sometimes I cannot find the right company or person for permission. It is unfair to have to spend so much time, and sometimes pay an outrageous amount of money, to be able to publish an article.”
- “Cases in which some action occurs, *e.g.*, cease and desist letters being sent or take-down notices issued, are only the tip of the copyright/fair use iceberg. You might have asked about self-

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“Just knowing you may have a good fair use argument doesn’t always give you the courage to use a news clip, when you know the corporation that owns the clip has a posse of attorneys on staff just waiting to pounce.”
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censorship, instances where artists or scholars have declined to use material that should fall within fair use, for fear of being sued. Or cases where creative/intellectual workers do not work entirely for themselves, where someone up the administrative chain has put the kibosh on work for fear of ‘exposure.’”

- “Fair use needs to be better understood by documentary producers. Just knowing you may have a good fair use argument doesn’t always give you the courage to use a news clip, when you know the corporation that owns the clip has a posse of attorneys on staff just waiting to pounce.”
- “The real issue is the limiting effect on documentary filmmakers to address issues of social, political, economic, and cultural significance for educational and noncommercial purposes.”
- “It is getting harder to make historical documentaries, because of the cost of archival photos and footage, and licensing quotes from original historical documents. The definition of fair use should be expanded, not just for use in news programs.”
- “I feel that fair use policies are extremely gray and I’d like to understand them better.”

Conclusion

What can we learn from the fair use research project?

First: artists, scholars, Web publishers, and many others are aware of fair use and sometimes rely on it. But many have only a vague sense of what it means, or mistakenly believe that the law imposes numerical limits on the amount of material they can borrow. There is an urgent need for accurate information.

Second: prevailing practices in an industry have a big effect on the ability to take advantage of fair use. At one extreme is the film world, where a clearance culture and the need for E&O insurance have nearly obliterated fair use. At the other end of the spectrum are the students, Web activists, and artists who freely appropriate copyrighted or trademarked material for creative purposes. Clearly, more support for fair use and free expression is needed in the communities where these principles are most threatened.

Third: whatever the precise percentage of dubious cease and desist or take-down letters that are sent in any given year, substantial numbers of them do state weak claims, or seek to suppress material with a strong or reasonable fair use or First Amendment defense. More than 20% of the letters in the Chilling Effects database for 2004 (67 letters out of 320) were in this category, while another 27% – or 86 letters – had a possible fair use or First Amendment defense. The disconnect between prevailing law and the claims made in many cease and desist or take-down letters is striking.

Finally, many recipients who do not acquiesce in the demands of cease and desist letters are not sued. The experiences of Attrition.org, the Piggy Bank of America, the *Cape Cod Voice*, and dozens of others show that non-acquiescence is alive and well. But many other recipients acquiesce, and the validity of their fair use or First Amendment defenses are never tested.

The counter-argument, of course, is that many people would prefer to receive a cease and desist letter, and settle the conflict, than be confronted with a lawsuit. And a cease and

desist letter, although threatening, in itself has no coercive power. The same cannot be said for DMCA take-down notices, which usually cause the suppression of speech even before there is a chance to negotiate. By conditioning an ISP's immunity from suit on compliance with a take-down notice, §512 of the DMCA creates very strong pressure to remove material merely on the "good faith" representation that it is infringing. As Google's experience with Scientology reflects, §512 is a powerful tool for anyone seeking to suppress criticism. We saw other examples of this phenomenon in the take-down letters targeting the *New York Times* parody correction page, Roger Loomis's Mormon discussion site, and the Chick cartoons parodist. The fact that take-down letters greatly outnumber cease and desist letters on the Chilling Effects site suggests how pervasive the §512 procedure has become.

Activists have risen to the challenge of defending fair use, with days of protest, massive downloads of important works, community support networks, informational Web sites, and *pro bono* legal assistance. These initiatives show that there is widespread support for fair use and free expression, and discontent with overzealous IP enforcement efforts. But larger and more systematic approaches are also needed – approaches that do not malign the importance of copyright and trademark, but that strike a proper balance between IP ownership and users' rights.

What measures could help restore the balance? Section 512 is bad legislation, but it is not about to be repealed. One way to ameliorate its effects is through better use of the counter-notice provision in the law. Informational and advocacy groups should explain the counter-notice procedure and work with ISPs to make sure that anyone whose online speech is targeted by a take-down letter is given adequate help in preparing a counter-notice.

One specific initiative would be to mount a survey of ISPs to learn what their §512 procedures are; then propose standard notices for them to send to their users, which explain how to prepare a counter-notice and provide

sample counter-notice language. ISPs should also dispel the intimidating effect of the requirement in §512 that the sender of the counter-notice consent to be sued, by pointing out that any of us can be sued at any time, whether we consent or not.

Another important initiative would be to make comprehensible information more widely available. Despite the suggestion of a few participants in our research that more information about fair use can produce a chilling effect, knowledge is still better than ignorance. Information about how fair use applies in different contexts can encourage artists, scholars, and the rest of us to assert our rights more fully, and may persuade ISPs (including universities) to resist unjustified demands by IP owners. One effective way to generate such information is through collective action within different disciplines, to articulate their own understandings of fair use.

An example is the *Filmmakers' Statement of Best Practices in Fair Use*, which outlines what filmmakers themselves consider fair use with respect to commentary, sampling popular culture, incorporating background sounds and images, and using archival material.²⁵⁶ Potentially, the *Statement* can be used to persuade distributors, insurers, archive houses, and others involved in film culture to accept the importance of fair use and stop demanding clearances for borrowings that most filmmakers consider fair. Although there is a risk of setting standards more narrow than a court might allow, statements of best practices are better than negotiated guidelines because they reflect the consensus of a creative community and do not contain numerical limits that are inconsistent with the flexibility of fair use law.

Increased community support and *pro bono* legal assistance are also needed. Although consulting legal counsel did not correlate with non-acquiescence in our research, this may be in part because many private attorneys view fair use through the lens of IP owners. Public interest lawyers at the Electronic Frontier Foundation and student IP clinics take a less owner-oriented stance. But there are not enough of them to fill the need. A national legal support backup center combined with a clearinghouse of legal pleadings,

reply letters, and other materials would be a worthy project. Bar associations can help by insisting that educational outreach campaigns of the type recently undertaken by the Copyright Society of the USA deal evenhandedly with fair use.²⁵⁷ And more aggressive use of §512(f) of the DMCA, providing for damages and attorneys' fees where owners have made material misrepresentations in their take-down letters, can help redress the imbalance.

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The disconnect between prevailing law and the claims made in many cease and desist or take-down letters is striking.

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But even knowledge, community support, and legal backup are not enough. A major force contributing to the erosion of fair use is the culture of gatekeeper-intermediaries – publishers, broadcasters, distributors, and many ISPs – who care less about legal niceties or the rights of users than about avoiding expensive lawsuits. This structural problem means that proponents of fair use must not only educate, advocate, and litigate; they must promote alternative technologies that eliminate media bottlenecks. Open access academic journals, open source distribution for creative products, and independent ISPs that are willing to resist DMCA take-down letters are some of the innovations that can help liberate fair use from clearance-culture gatekeepers.

Our conversation with insurance broker Dennis Reiff suggested another remedy. Would it be possible to set up alternative E&O insurance options – perhaps offered on a nonprofit basis by arts service organizations – that would take better account of fair use? Reiff thought it was “a wonderful idea” – but “who would back it? Who is going to file it in all 50 states? There’s a tremendous amount of work involved.”

Reiff thought that instead, the government should be “a little more definitive as to what constitutes a fair use other than this nebulous ‘criticism, comment, news report, teaching, scholarship and research.’” Many of our participants likewise called for specific guidelines. But as we have seen, quantitative limits ignore context and other fair use factors. There does not seem to be any set of bright-line rules that would honor the spirit of fair use while eliminating its unpredictability.

But other changes in the law could reduce its chilling effect. The penalties for copyright infringement should be reduced, and the law should not impose money liability on anybody who reasonably believed her copying was fair.²⁵⁸

An alternative dispute resolution mechanism such as mediation or arbitration – as long as it is voluntary – could also lower the cost of guessing wrong. The law could provide that any borrower who abides by the decision of an arbitrator would not be liable for money damages.

The free expression safeguards in intellectual property law are essential to creativity, culture, and democracy. They are particularly critical today, when the term of copyright control often lasts for well over a century. We hope this report will spark discussion, activism, community support, and policy reform. Although other approaches are welcome and desirable, fair use must be strengthened, not abandoned.

LIBERTY WAITS ON YOUR FINGERS –



KEEP ON BLOGGING!

E! www.eff.org/bloggers/

Electronic Frontier Foundation, “Keep on Blogging!”

Recommendations

- 1 Create a clearinghouse on fair use and other free expression issues in IP law, with information that is easily comprehensible and gives practical guidance. Include clear explanations of the DMCA take-down and counter-notice provisions.
- 2 Survey ISPs on their DMCA take-down procedures; then work with them to assure that anyone whose online speech is targeted gets adequate information and help in preparing a counter-notice.
- 3 Create a national legal support backup center, with a network of *pro bono* attorneys and IP law student clinics, and a clearinghouse of legal pleadings and other resources.
- 4 Work with bar associations to assure that educational outreach campaigns deal evenhandedly with fair use. Investigate the possibility of sanctions against lawyers who send frivolous cease and desist letters.
- 5 Work with arts service organizations to investigate possibilities for alternative errors and omissions insurance and for statements of best practices.
- 6 Investigate opportunities for amending IP law to reduce penalties, to eliminate money damages against anybody who reasonably guesses wrong about a fair use or free expression defense, and to create alternative dispute resolution mechanisms whose decisions, if obeyed, would relieve an accused infringer of money liability.

Endnotes

¹ *Mattel v. Walking Mountain Productions*, 353 F.3d 792, 796 (9th Cir. 2003).

² *Id.*, 806.

³ Forsythe was represented by the ACLU of Southern California and a cooperating law firm. Tom Forsythe, “Food Chain Barbie and the Fight for Free Speech,” *NCAC on the Issues*, Aug. 20, 2004, <http://www.ncac.org/issues/foodchainbarbie.htm>.

⁴ Cecilia Ogbu, “Note: I Put Up a Website About My Favorite Show and All I Got Was This Lousy Cease-and-Desist Letter: The Intersection of Fan Sites, Internet Culture, and Copyright Owners,” 12 *S. Cal. Interdisc. L.J.* 279, 303-07 (2003).

⁵ See Julie Keller, “Buffy Cyberfans Slayed By Fox,” *Eonline.com*, Dec. 23, 1999, www.eonline.com/News/Items/Pf/0,1527,5782.00.html (visited 8/13/05); Letter from Warner Brothers to Jonathon Woodward, Nov. 8 1995, www.io.com/~woodward/@cme/served.txt (visited 8/13/05).

⁶ “Intellectual property” is a fairly recent term covering copyright, trademark, patents, and other legal structures protecting the fruits of intellectual and creative work.

⁷ 17 U.S. Code §106 sets out the rights of copyright owners. Their term of control was 14 years under the first U.S. copyright law, but is now the life of the author plus 70 years, or 95 years for corporations.

⁸ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994), quoting *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845).

⁹ *Folsom v. Marsh*, 9 F. Cas. 342, 344, 348 (C.C.D. Mass. 1841) (ruling that a biography of George Washington took too much of Washington’s letters without consent).

¹⁰ *Jack Benny v. Loews*, 239 F.2d 532 (9th Cir. 1956), affirmed by an equally divided court, 356 U.S. 43 (1958).

¹¹ *Time v. Bernard Geis Associates*, 293 F. Supp. 130 (S.D.N.Y. 1968).

¹² *Rosemont v. Random House*, 366 F.2d 303 (2d Cir. 1966); *id.*, 311-13 (Judge Lumbard concurring) (reversing a preliminary injunction that had prohibited publication of the book).

¹³ *Walt Disney Productions v. Air Pirates*, 581 F.2d 751, 753 (9th Cir. 1978), quoting Note, “Parody, Copyrights, and the First Amendment,” 10 *U.S.F.L. Rev.* 564, 571, 582 (1976).

¹⁴ *MCA, Inc. v. Wilson*, 677 F.2d 180, 184 n. 1 (2d Cir. 1981).

¹⁵ *Id.*, 188, 191 (Judge Mansfield dissenting).

¹⁶ 17 U.S. Code §107.

¹⁷ *Sony Corp. v. Universal City Studios*, 464 U.S. 417 (1984). See also *Bond v. Blum*, 317 F.3d 385 (4th Cir. 2003) (copying by the father in a child custody case of an autobiographical manuscript by his ex-wife’s husband entitled *Self-Portrait of a Patricide*, in support of his motion for sole custody of their children, was fair use).

¹⁸ Rebecca Tushnet, “Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It,” 114 *Yale L.J.* 535 (2004). Tushnet also gives the example of lovers sharing poetry. Having to seek permission before copying a favorite love poem would definitely slow down the mating process.

¹⁹ U.S. Constitution, article I, §8, cl. 8.

²⁰ *Harper & Row v. Nation Enterprises*, 471 U.S. 539 (1985); *Maxtone-Graham v. Burtchaeil*, 803 F.2d 1253 (2d Cir. 1986). The Court in *Harper & Row* explained that an important factor was whether the borrower took the heart of the original work; see chapter 1.

²¹ *Campbell v. Acuff-Rose*, 510 U.S. at 591-92.

²² *Ellsmere Music v. National Broadcasting Co.*, 623 F.2d 252 (2d Cir. 1980).

²³ *Fisher v. Dies*, 794 F.2d 432 (9th Cir. 1986).

²⁴ *Ringgold v. Black Entertainment Television*, 126 F.3d 70 (2d Cir. 1997).

²⁵ *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

²⁶ See *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (Ct. Cl. 1973), affirmed by an equally divided court, 420 U.S. 376 (1975); *American Geophysical Union v. Texaco*, 60 F.3d 913 (2d Cir. 1994).

²⁷ Relevant documents are on file at the American Civil Liberties Union.

²⁸ <http://www.chillingeffects.org/notice.cgi?NoticeID=578> (visited 9/8/05).

²⁹ <http://www.whitehouse.org/administration/lynne.asp> (visited 9/8/05).

³⁰ Benjamin Weiser, “Web Site Hears From Cheney After Parody Involving Wife,” *New York Times*, Mar. 6, 2003, A24.

³¹ Remedies for copyright infringement include either “actual damages” that the owner can prove, or “statutory damages” of anywhere between \$750-\$30,000. Where the court finds the infringement was “committed willfully,” it can increase the statutory damages up to \$150,000, and can order the loser to pay the other side’s attorney’s fees and costs. 17 U.S. Code §§504, 505. Criminal penalties range up to ten years in prison. 18 U.S. Code §2319.

The law does allow a judge to “remit statutory damages in any case where an infringer believed and had reasonable grounds for believing that his or her use

of the copyrighted work was a fair use,” but *only if* the infringer was an employee or agent of certain nonprofit organizations, and the copying fell within specific categories. 17 U.S. Code §§504(c)(2). Courts can also acquit criminal defendants who honestly believed their acts were fair use. *United States v. Moran*, 757 F. Supp. 1046, 1048 (D. Neb. 1991).

³² 17 U.S. Code §512(c)-(g). Other provisions of the DMCA make it a crime to circumvent the digital rights management, or “DRM” technologies that corporate copyright owners have created to stop unauthorized access to, or copying of, their products. Courts have recognized that these “anti-circumvention” provisions threaten fair use – for example, when a film critic wants to circumvent DRM in order to access a film frame to illustrate an article – but they have upheld the law nonetheless. *Universal City Studios v. Corley*, 273 F.3d 429, 459 (2d Cir. 2001); *United States v. Elcom Ltd.*, 203 F. Supp.2d 1125, 1131 (N.D. Cal. 2002).

³³ 17 U.S. Code §512(g) contains detailed requirements for counter-notification, including a statement that the subscriber consents to be sued by the sender of the take-down notice.

³⁴ *Online Policy Group v. Diebold*, 337 F. Supp.2d 1195, 1203 (N.D. Cal. 2004). The court also found that Diebold had knowingly misrepresented that the postings violated copyright law, in violation of §512(f) of the DMCA.

³⁵ See *Bridgeport Music v. Dimension Films*, 410 F.3d 792, 803-04 (6th Cir. 2005) (describing the clearance culture for music sampling).

³⁶ David Bollier, *Brand Name Bullies: The Quest to Own and Control Culture* (2005), 24-26.

³⁷ Pat Aufderheide & Peter Jaszi, “Untold Stories: Creative Consequences of the Rights Clearance Culture for Documentary Filmmakers” (Center for Social Media/Program on Intellectual Property & the Public Interest, American University, 2004), <http://www.centerforsocialmedia.org/rock/finalreport.htm> (visited 6/17/05).

³⁸ Michael C. Donaldson, *Clearance & Copyright* (2003), 209, includes a sample E&O insurance form.

³⁹ Westmoreland sued CBS for a documentary that “charged a conspiracy by the general’s command in 1967 to show progress in the war by understating the size of the enemy”; he withdrew the suit after 18 weeks of trial, including damaging testimony from his former aides. Myron Farber, “The Westmoreland Case: A Broken West Point Tie,” *New York Times*, Feb. 24, 1985, 1:1. Sharon sued *Time* over charges that he encouraged the killing of Palestinians at refugee camps; a jury found that *Time* had made false and defamatory statements, but not deliberately or recklessly; thus, there was no liability. Arnold Lubasch, “Time Cleared of Libeling Sharon But Jurors Criticize Its Reporting,” *New York Times*, Jan. 25, 1985, A1. Even though the defendants won both of these suits, the costs of defending them were enormous.

⁴⁰ Reiff’s description here of industry practice conflicts with a section of the copyright law that allows “the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations” of “an architectural work,” as long as “the building in which the work is embodied is located in or ordinarily visible from a public place.” 17 U.S. Code §120. Thanks to David Nimmer for pointing out that Disney does not own the copyright in the architectural work, Disney Hall.

⁴¹ Ad-Hoc Committee of Educational Institutions and Organizations on Copyright Law Revision Guidelines, “Agreement on Guidelines for Classroom Copying in Not-For-Profit Educational Institutions,” reprinted in House Report No. 94-1476, 94th Cong., 2d Sess. 65-74 (1976).

⁴² E.g., *Basic Books, Inc. v. Kinko’s Graphics Corp.*, 758 F. Supp. 1522, 1535-37 (S.D.N.Y. 1991) (commercial copy center’s reproduction of college course packs was not fair use, and was also outside the Classroom Guidelines); *American Geophysical Union v. Texaco*, 60 F.3d at 919 & n.5 (copying of journal articles by hundreds of company scientists in connection with their research was not fair use; it was not “spontaneous” within the meaning of the Classroom Guidelines, which, although “not considered necessarily binding on courts,” are “persuasive authority marking out certain minimum standards for educational fair uses”); *Princeton University Press v. Michigan Document Services*, 99 F.3d 1381, 1390 (6th Cir. 1996) (photocopying by a commercial copy shop for course packs was not fair use; included in the legislative history of §107, the guidelines represent part of Congress’s “understanding of fair use”). One of the dissenting judges in the *Princeton* case objected to his colleagues’ reliance on guidelines that Congress specifically chose not to enact into law; *id.*, 1412 (Judge Ryan dissenting).

⁴³ See Kenneth Crews, “The Law of Fair Use and the Illusion of Fair Use Guidelines,” 62 *Ohio State L.J.* 599, 639-40 (2001) (describing two settlements in which photocopy shops agreed to adhere to the guidelines, and another case in which New York University did so).

⁴⁴ Organizations that opposed some or all of the CONFU Guidelines include the American Association of State Colleges and Universities, American Council on Education, American Historical Society, American Library Association, Association of American Universities, Association of Research Libraries, Medical Library Association, National Association of State Universities and Land-Grant Colleges, and American Association of Law Libraries. Crews, 62 *Ohio State L.J.* at 610 n. 36.

⁴⁵ *Id.*, 603 n. 4.

⁴⁶ See <http://www.negativevland.com> (visited 7/22/05); Negativland, *Fair Use: The Story of the Letter U and the Numeral 2* (1995); Bollier, *Brand Name Bullies*, 214.

⁴⁷ For more on *The Grey Album*, see chapter 3; for more on Rhizome, see chapter 2.

⁴⁸ See Katie Dean, “Eyes on the Prize hits P2P,” Jan. 27, 2005, <http://www.freepress.net/news/6393> (visited 1/27/05).

⁴⁹ See “Illegal Art: Freedom of Expression in the Corporate Age,” <http://www.illegal-art.org> (visited 7/20/05).

⁵⁰ Stipulated Judgment, *Starbucks Corp. v. Kieron Dwyer*, No C 00 1499 MMC (N.D. Cal. Mar. 28, 2001).

⁵¹ Email from *Stay Free!* editor Carrie McLaren, Aug. 30, 2005.

⁵² See the Free Press site statement at <http://www.freepress.org> (visited 6/30/05).

⁵³ <http://www.chillingeffects.org/copyright/notice.cgi?NoticeID=94>; <http://www.chillingeffects.org/protest/notice.cgi?NoticeID=92> (both visited 3/23/05).

⁵⁴ http://www.chillingeffects.org/html/barney_letter.html (visited 3/23/05). The EFF Barney page was an archive of the online magazine *Computer Underground Digest* and the item in question was called “Barney Bashing.”

⁵⁵ See www.creativecommons.org (visited 6/30/05).

⁵⁶ This chapter focuses on U.S. law. Other countries recognize a similar exception to copyright, called “fair dealing.” For additional information on fair use and the other free expression safety valves in copyright law, see Stanford University Libraries, “Copyright and Fair Use,” <http://fairuse.stanford.edu>; University of Texas, “Fair Use of Copyrighted Materials,” <http://www.utsystem.edu/OGC/IntellectualProperty/copypol2.htm>; Electronic Frontier Foundation, <http://www.eff.org>; Chilling Effects Clearinghouse, <http://www.chillingeffect.org>; and Marjorie Heins, “*The Progress of Science and Useful Arts*”: *Why Copyright Today Threatens Intellectual Freedom* (2003), <http://www.fepproject.org/policyreports/copyright2dexsum.html> (all visited 7/20/05).

⁵⁷ *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 452 (1984).

⁵⁸ *Harper & Row v. Nation Enterprises*, 471 U.S. at 566.

⁵⁹ The amendment reaffirmed *Harper & Row*’s ruling that the unpublished nature of a work is a “key” factor, but repudiated its extension by one court of appeals to say that unpublished works “normally enjoy complete protection against copying.” *Salinger v. Random House*, 811 F.2d 90, 97 (2d Cir. 1987). A second case, rejecting fair use for quotations from unpublished writings by Scientology founder L. Ron Hubbard, heightened the sense of urgency in the publishing world that led to the amendment; see *New Era Publications v. Henry Holt & Co.*, 873 F.2d 576 (2d Cir. 1989); William F. Patry, *The Fair Use Privilege in Copyright Law* (2d ed. 1995), 91; 4 *Nimmer on Copyright* §13.05[A][2][b].

⁶⁰ *Campbell v. Acuff-Rose*, 510 U.S. at 583.

⁶¹ *Id.*, 579, 587-88. The Court relied on an article by Judge Pierre Leval, which argued that transformation is the core of fair use. Pierre Leval, “Toward a Fair Use Standard,” 103 *Harvard L. Rev.* 1105 (1990).

⁶² *Campbell v. Acuff-Rose*, 510 U.S. at 584, quoting 3 *Boswell’s Life of Johnson* 19 (G. Hill ed. 1934).

⁶³ The courts in *Castle Rock Entertainment v. Carroll Publishing Group*, 150 F.3d 132, 145 (2d Cir. 1998), and *American Geophysical Union v. Texaco*, 60 F.3d at 926, noted that the Supreme Court has abandoned its over-emphasis on the fourth factor.

⁶⁴ *Grand Upright Music v. Warner Brothers*, 780 F. Supp. 182, 183 (S.D.N.Y. 1991).

⁶⁵ *Newton v. Diamond*, 388 F.3d 1189, 1192 (9th Cir. 2003); *Williams v. Broadus*, 60 U.S.P.Q.2d (BNA) 1051 (S.D.N.Y. 2001) (both discussing the history of sampling and noting that some samples may be “*de minimis*” – too fleeting to create copyright liability). One court rejected the *de minimis* concept entirely for sampling from sound recordings, but acknowledged there might be a fair use defense. *Bridgeport Music v. Dimension Films*, 410 F.3d 792.

⁶⁶ *Twin Peaks Productions v. Publications Int’l*, 996 F.2d 1366 (2d Cir. 1993); *Castle Rock v. Carroll Publishing*, 150 F.3d 132.

⁶⁷ *SunTrust Bank v. Houghton Mifflin*, 268 F.3d 1257 (11th Cir. 2001).

⁶⁸ *NXIVM Corp. v. Ross Institute*, 364 F.3d 471 (2d Cir. 2004).

⁶⁹ *Chicago School Reform Board v. Substance, Inc.*, 354 F.3d 624, 629 (7th Cir. 2003).

⁷⁰ *Dr. Seuss Enterprises v. Penguin Books*, 109 F.3d 1394 (9th Cir. 1997). This decision has been criticized for ignoring the fact that borrowing in a *satire* may qualify as fair use even if it is not a *parody* of the quoted work, as long as the balance of all the fair use factors favors the borrower.

⁷¹ *Los Angeles News Service v. KCAL-TV*, 108 F.3d 1119 (9th Cir. 1997).

⁷² *Los Angeles News Service v. Reuters Television Int’l*, 149 F.3d 987 (9th Cir. 1998).

⁷³ *Los Angeles News Service v. CBS Broadcasting*, 305 F.3d 924 (9th Cir. 2002).

⁷⁴ *Nunez v. Caribbean Int’l News Corp.*, 235 F.3d 18, 25 (1st Cir. 2000).

⁷⁵ David Nimmer, “‘Fairest of Them All’ and Other Fairy Tales of Fair Use,” 66 *Law & Contemporary Problems* 264, 280-82 (2000).

⁷⁶ Michael Madison, “A Pattern-Oriented Approach to Fair Use,” 45 *William & Mary L. Rev.* 1525, 1577, 1587 (2004).

⁷⁷ Crews, 62 *Ohio State L.J.* at 605-06.

⁷⁸ *Id.*, 607.

⁷⁹ 15 U.S. Code §1114. The “false designation of origin” section of the Lanham Act has the same requirements, 15 U.S. Code §1125(a), and the standards are similar for protection of unregistered marks in state law.

⁸⁰ *Lucasfilm v. High Frontier*, 622 F. Supp. 931, 933-34 (D.D.C. 1985). Some courts categorize parody and editorial use generally as not being “in commerce.” On the other hand, Congress has passed laws barring even noncommercial use of specific words; the Supreme Court upheld such a law when applied to prohibit the Gay Olympic Games from using the term “Olympic.” *San Francisco Arts & Athletics, Inc. v. U. S. Olympic Committee*, 483 U.S. 522 (1987).

⁸¹ *Hormel Foods v. Jim Henson Productions*, 73 F.3d 497 (2d Cir. 1996).

⁸² Transcript of Preliminary Injunction Hearing in *Fox News Network v. Penguin Group*, Aug. 22, 2003, <http://alfrankenweb.com/foxcourt.html> (visited 5/18/05). The judge added that “fair and balanced” is probably not even a valid trademark, “because the words are used so frequently,” and that in any event, Franken had a First Amendment right to make fun of Fox, which trumped any possible claim under trademark law.

⁸³ *Dallas Cowboys Cheerleaders v. Pussycat Cinema*, 604 F.2d 200, 202 (2d Cir. 1979).

⁸⁴ *Yankee Publishing v. New America Publishing*, 809 F. Supp. 267, 272 (S.D.N.Y. 1992).

⁸⁵ Thanks to ChillingEffects.org for these examples; the second comes from *Zatarain's, Inc. v. Oak Grove Smokehouse*, 698 F.2d 786 (5th Cir. 1983). 15 U.S. Code §1115(b)(4) creates the classic or descriptive fair use defense.

⁸⁶ *Mattel v. Walking Mountain Productions*, 353 F.3d at 810-11.

⁸⁷ *Playboy Enterprises v. Welles*, 279 F.3d 796 (9th Cir. 2002).

⁸⁸ *New Kids on the Block v. News America Publishing*, 971 F.2d 302 (9th Cir. 1992).

⁸⁹ *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003); *Harper & Row*, 471 U.S. at 560.

⁹⁰ *Mattel v. Walking Mountain Productions*, 353 F.3d at 807; *Mattel v. MCA Records*, 296 F.3d 894, 904 (9th Cir. 2002).

⁹¹ *Charles Atlas v. DC Comics*, 112 F. Supp.2d 330, 341 (S.D.N.Y. 2000).

⁹² *Rogers v. Grimaldi*, 875 F.3d 994, 999 (2d Cir. 1989).

⁹³ *Id.*, quoting *Cohen v. California*, 403 U.S. 15, 26 (1971).

⁹⁴ *Anheuser-Busch v. Balducci Publications*, 28 F.3d 769, 772, 775 (8th Cr. 1994).

⁹⁵ 15 U.S. Code §1125(c).

⁹⁶ These are examples given in *Mattel v. MCA Records*, 296 F.3d at 903.

⁹⁷ *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 307-08 (D.N.J.) (granting a preliminary injunction), affirmed without opinion, 159 F.3d 1351 (3d Cir. 1998). The finding of commercial impact was based on a link to a site that sold merchandise, and the court’s perception that simply using the Jews for Jesus name would “inhibit the efforts of Internet users” to locate the official site. *Id.*, 308.

⁹⁸ *Mattel v. MCA Records*, 296 F.3d at 903-07.

⁹⁹ *Lamparello v. Falwell*, 420 F.3d 309, 313 (4th Cir. 2005). This court criticized the *Jews for Jesus* decision, and another case involving use of the Planned Parenthood name, for stretching the likelihood of confusion test to include a theory of “initial interest confusion” that cuts trademark law “off from its moorings, to the detriment of the First Amendment.” *Id.*, 317 n. 6. See also *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 28 (1st Cir. 1987) (rejecting a state law trademark dilution claim against a parody of the L.L. Bean catalog, and noting that since the time of Chaucer, parodies have “ridiculed sacred verities and prevailing mores”).

¹⁰⁰ 15 U.S. Code §1125(d).

¹⁰¹ *Strick Corp. v. James B. Strickland, Jr.*, 162 F. Supp.2d 372, 377 (E.D. Pa. 2001).

¹⁰² *People for Ethical Treatment of Animals v. Doughney*, 113 F. Supp.2d 915, 920-21 (E.D. Va. 2000), affirmed, 263 F.3d 359 (4th Cir. 2001).

¹⁰³ See *Bosley Medical Institute v. Kremer*, 403 F.3d 672, 679 (9th Cir. 2005); *Lamparello v. Falwell*, 420 F.3d at 317-18. In *Bihari v. Gross*, 119 F. Supp.2d 309 (S.D.N.Y. 2000), the court held that a Web site critical of an interior design company was entitled to use a similar domain name because the site was not commercial; no reasonable viewer would think it was endorsed by the company being disparaged; the critics were acting in good faith; and the site was entitled to the “descriptive fair use” defense.

¹⁰⁴ *PETA v. Doughney*, 263 F.3d at 362, 368.

¹⁰⁵ Paul Alan Levy, “Legal Perils and Legal Rights of Internet Speakers” (Public Citizen Litigation Group, n.d.), 15. For more on ICANN decisions and “.sucks” sites, see Bollier, *Brand Name Bullies*, 128-30.

¹⁰⁶ *Estate of Tupac Shakur v. Barranco*, Nos. AF-0348a & AF-0348b (UDRP Oct. 28, 2000); *Nintendo of America v. Alex Jones*, No. D2000-0998 (UDRP Nov. 17, 2000).

¹⁰⁷ We have edited the focus group transcripts for coherence and readability. We have not included ellipsis dots, but have scrupulously retained the speakers’ meaning. The transcripts are on file at the Brennan Center.

¹⁰⁸ This is one example of an inaccurate, or at least overbroad, statement by a focus group participant.

¹⁰⁹ Not an exact quote. See Alan Alexander Milne, “Rice Pudding,” <http://ingeb.org/songs/whatisth.html> (visited 5/26/05).

¹¹⁰ *Wright v. Walker*, 953 F.2d 731 (2d Cir. 1991) (holding that Walker’s limited quotations from Richard Wright’s unpublished letters and journals were fair use).

¹¹¹ France recognizes four categories of “moral rights” that differ from U.S. law. The first is the “right of disclosure” – the right to decide whether or not to publish. Under French law, even a paraphrase of an unpublished writing could violate *le droit moral*. See Sheri Falco, “The Moral Rights of *Droit Moral*: France’s Example of Art as the Physical Manifestation of the Artist,” *Archive*, Vol. 2, No. 206 (n.d.), http://www.ibslaw.com/melon/archive/206_moral.html (visited 4/25/05).

¹¹² This dispute was resolved a few weeks after the focus group, when Rowley agreed to some cuts for a separate European edition of the book, *Tête à Tête: Simone de Beauvoir and Jean-Paul Sartre*. Emails with Hazel Rowley, Apr. 2004.

¹¹³ See U.S. Copyright Office, “Recipes,” FL-122 (Jan. 2004), <http://www.copyright.gov/fls/fl122.pdf> (visited 9/7/05) (“mere listings of ingredients as in recipes, formulas, compounds or prescriptions are not subject to copyright protection. However, where a recipe or formula is accompanied by substantial literary expression in the form of an explanation or directions, ... there may be a basis for copyright protection”).

¹¹⁴ Not precisely accurate: “A synchronization or ‘synch’ right involves the use of a recording of musical work in audio-visual form: for example as part of a motion picture, television program, commercial announcement, music video or other videotape.” ASCAP, “Common Music Licensing Terms,” <http://www.ascap.com/licensing/termsdefined.html> (visited 7/19/05).

¹¹⁵ Capra’s *Why We Fight* films for the Army have been described as “some of the most memorable propaganda used by the government during World War II.” Heidi Rickard & Jennifer Bunke, “World War Two,” http://web.uccs.edu/history/student%20presentations/heidi/world_war_two.htm (visited 5/26/05).

¹¹⁶ U.S. Government-produced materials are in the public domain. 17 U.S. Code §105.

¹¹⁷ *Ringgold v. Black Entertainment Television*, 126 F.3d at 78-80 & n. 8. A Library of Congress regulation governing royalties to be paid by public broadcasters for the use of visual works sets a higher rate for “featured” than for “background” displays; it does not mention fair use. 37 Code of Federal Regulations 253.8, cited in *Ringgold*, 77.

¹¹⁸ *Italian Book Corp. v. ABC*, 458 F. Supp. 65, 68 (S.D.N.Y. 1978).

¹¹⁹ *E.g., Gordon v. Nextel Communications*, 345 F.3d 922 (6th Cir. 2003) (use of medical illustrations as

background props for a dental office scene in an advertisement was incidental and *de minimis*).

¹²⁰ The passing use of a trademark in a film scene would not seem to meet the requirement for infringement: that the mark be used in connection with the sale, distribution, or advertising of products or services. 15 U.S. Code §1114.

¹²¹ Not exactly accurate – Rauschenberg chose to settle the suit. See *Artnet News*, Feb. 10, 2000, <http://www.artnet.com/Magazine/news/artnetnews/artnetnews2-10-00.asp> (visited 5/11/05) (describing Rauschenberg’s 1974 mixed-media print “Pull,” “made famous when San Francisco photographer Morton Beebe sued the artist for incorporating two of his photographs in the work without permission”; Rauschenberg claimed that the appropriation was protected by the First Amendment, but settled the case for \$3,000, legal fees, a copy of the print, and an agreement to credit Beebe when the work is exhibited).

¹²² The letter is at <http://firstpulseprojects.com/1stletter-from-bhoffman2.26.04.html> (visited 6/15/05).

¹²³ Rhizome is a nonprofit organization seeking to “provide an online platform for the global new media art community.” The Web site defines a rhizome as “a horizontal, root-like stem that extends underground and sends out shoots to the surface,” and adds: “rhizome is also a figurative term used by Gilles Deleuze and Felix Guattari to describe non-hierarchical networks of all kinds. “About Us,” <http://rhizome.org/info/index.php> (visited 6/10/05).

¹²⁴ The reply letter is at <http://firstpulseprojects.com/letter-to-bhoffman2.27.04.html> (visited 6/15/05). It agrees to credit Meiselas and Magnum on the title of the painting, but not to seek Meiselas’s approval for any reproduction or display.

¹²⁵ The second demand letter is at <http://firstpulseprojects.com/2ndletter-from-bhoffman3.03.04.html> (visited 6/15/05).

¹²⁶ Garnett’s story, with copies of the correspondence with Meiselas’s attorney, and links to the many variations on “Molotov,” can be found at http://www.firstpulseprojects.net/riot_2003/joywar (visited 6/15/05).

¹²⁷ A common assumption, but asking and being refused does not undermine a fair use defense. *Campbell v. Acuff-Rose*, 510 U.S. at 585.

¹²⁸ “CONFU – The Conference on Fair Use,” <http://www.utsystem.edu/OGC/IntellectualProperty/confu.htm> (visited 6/20/05). See pages 6-7 (noting that these guidelines do not accurately reflect the law of fair use).

¹²⁹ Like the “classroom use” guidelines, the practices of copy centers don’t necessarily reflect fair use law. Courts have ruled that the creation of educational course packs by commercial copy shops is not fair use, but this does not mean that copying a few pages from a book would make a copy shop liable. It also leaves open the question of how much nonprofit copying by individual

professors and students for teaching and research purposes would qualify. Compare *Basic Book v. Kinko's*, 758 F. Supp. 1522, and *Princeton University Press v. Michigan Document Services*, 99 F.3d 1381 (both ruling that commercial coursepacks are not fair use), with *Williams & Wilkins v. U.S.*, 487 F.2d 1345 (large-scale copying by a government library to assist scientific research is fair use), and *Duffy v. Penguin Books*, 4 F. Supp.2d 268 (S.D.N.Y. 1998) (photocopying portions of out-of-print books to aid in research is fair use).

¹³⁰ Some courts have said that a musical borrowing is *de minimis* and thus not a copyright infringement to begin with, if “the average audience would not recognize the appropriation.” *Newton v. Diamond*, 388 F.3d at 1193; *Fisher v. Dees*, 794 F.2d at 434 n.2.

¹³¹ NYU’s policy is probably the result of a lawsuit settlement in which the university agreed to abide by negotiated guidelines; see page 6.

¹³² “Chilling Effects Clearinghouse,” <http://www.chillingeffects.org/> (visited 5/10/05).

¹³³ *Id.*

¹³⁴ The number was actually 339, but we did not count seven items. Six of them were not cease and desist or take-down letters, and the seventh was no longer available on the site.

¹³⁵ “Operation Clambake: The Fight Against the Church of Scientology on the Net,” <http://www.Xenu.net> (visited 5/11/05).

¹³⁶ Mark Thompson, “Overzealous Lawyers Beware: Today’s Sites Are Fighting Back,” *USC Annenberg Online Journalism Review*, Sept. 15, 2004, <http://ojr.org/ojr/law/1095284771.php> (visited 4/12/05) (quoting Wendy Seltzer).

¹³⁷ “What is Avatar?,” <http://www.avatarepc.com/html/whatis.html> (visited 4/24/05).

¹³⁸ Because copyright does not protect any “idea, procedure, process, system, [or] method of operation,” the bare formulas and instructions for calculating pool handicaps would not be copyrightable. 17 U.S.Code §102(b).

¹³⁹ [http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1217, 1154, and 1072](http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1217,1154,1072) (all visited 5/11/05). Short phrases are not covered by copyright, but may have trademark protection if they are distinctly enough associated with a particular service or product. U.S. Copyright Office, Circular 34, “Copyright Not Available for Names, Titles, or Short Phrases,” <http://www.copyright.gov/circs/circ34.html> (visited 9/7/05).

¹⁴⁰ [http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1204, 1315](http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1204,1315) (both visited 5/11/05).

¹⁴¹ <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1269> (Haiku houses); 1359 and 1259 (National Health Scotland); 1581 (Paddle Asia); 1531 (poetry); 1221 (Brazilian *Playboy*) (all visited 5/11/05).

¹⁴² The one claim in this category that we classified

as “possible fair use – more information needed” involved the alleged distribution of a Cisco Systems source code on an online discussion group; <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1511> (visited 5/16/05).

¹⁴³ *MGM v. Grokster*, 125 S.Ct. 2764 (2005) (ruling that peer-to-peer networks can be liable for inducing copyright infringement, and assuming that sharing copyrighted works through these networks, even though for personal use, is illegal).

¹⁴⁴ See *Religious Technology Center v. Lerma*, 40 U.S.P.Q.2d (BNA) 1569 (E.D.Va. 1995) (no fair use where a critic of Scientology posted large segments of the Church’s texts without commentary on many of the postings); *Religious Technology Center v. Lerma & Washington Post*, 897 F. Supp. 260 (E.D.Va. 1995) (newspaper’s limited quotation of Scientology materials accompanied by commentary was protected by the First Amendment and fair use); *Religious Technology Center v. Netcom Online Communication Services*, 907 F. Supp. 1361, 1378 (N.D. Cal. 1995) (ISP was protected by fair use, but not the person who posted “large portions” of Scientology works “with little added commentary”); *Religious Technology Center v. F.A.C.T.NET*, 901 F. Supp. 1519, 1524-26 (D.Colo. 1995) (likely fair use defense where the materials were posted in a limited-access online library and “in the context of online dialogue in [a] particular newsgroup”).

¹⁴⁵ Not only are nondistinctive terms unlikely to create consumer confusion about the origin of a particular product or service, but they are often not eligible for trademark protection in the first place. Trademark law classifies marks into four categories, based on how distinctive they are. “Generic” marks get no trademark protection, and the same is true of “descriptive” marks unless they have acquired a “secondary meaning.” “Fanciful” or “arbitrary” marks get the most protection, and “suggestive” marks are second in priority.

1 McCarthy on Trademarks and Unfair Competition §§ 11.1, 11.2 (4th ed. 1996); *Playtex Products v. Georgia Pacific*, 390 F.3d 158, 163 (2d Cir. 2004).

¹⁴⁶ <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1329> (“penisimprovement”); <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=1065> (“Pet Friendly”) (both visited 5/11/05). The owner of www.penisimprovement.com complained that his masthead image had been copied, but the allegedly infringing sites had a different image. For more on “Pet Friendly,” see chapter 4.

¹⁴⁷ For more on the *New York Times* controversy, see chapter 4; for more on “Internet Infidels,” see chapter 5; for more on “American Expressway,” see page 34.

¹⁴⁸ [http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1357, 1386, 1387, 1431](http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1357,1386,1387,1431) (all visited 7/10/05). These letters complained of multiple newsgroup postings, but based on the subject lines, we thought at least one of the postings would have a strong fair use defense.

¹⁴⁹ <http://msophelia.blogspot.com/prancer.jpg> (visited 5/11/05); the take-down letter is at <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1071> (visited 4/7/05). See *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003) (thumbnail reproductions on an Internet search engine were fair use); *Bill Graham Archives v. Dorling Kindersley*, 75 U.S.P.Q.2d 1192 (S.D.N.Y. 2005) (thumbnail images of concert posters in a book on The Grateful Dead were fair use).

¹⁵⁰ <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1330> (visited 3/16/05).

¹⁵¹ <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1089> (visited 4/7/05). See U.S. Copyright Office, FL-122, *supra* note 113.

¹⁵² <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1225> (visited 3/16/05).

¹⁵³ <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1307,1381,1306,1353,1458> (all visited 5/11/05).

¹⁵⁴ In *Los Angeles Times v. Free Republic*, 54 U.S.P.Q.2d (BNA) 1453 (C.D. Cal. 2000), a court ruled that copying complete news articles, even in the context of a nonprofit discussion site, does not qualify as fair use. An important factor in the court's analysis was that the use was not "transformative" – that is, the site did not comment on the articles, but instead used them as sources for general current events discussion.

¹⁵⁵ <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1137> (visited 5/11/05).

¹⁵⁶ See the court order appended to <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1475> (visited 4/24/05).

¹⁵⁷ Although commercial, these sites have First Amendment protection. An entrepreneur has the right to choose a name or use text to convey her ideas and information about her product. Many commercial sites are maintained by artists or craftsmen, and many products contain literary expression or political commentary.

¹⁵⁸ We could not determine the result in the other three cases.

¹⁵⁹ <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=1047> (visited 5/11/05).

¹⁶⁰ <http://www.privatelessons.info> (visited 5/16/05).

¹⁶¹ <http://www.chillingeffects.org/acpa/notice.cgi?NoticeID=1550>; <http://www.springfieldmatch.com> (both visited 5/11/05).

¹⁶² <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=1355> (visited 5/11/05).

¹⁶³ <http://www.chillingeffects.org/acpa/notice.cgi?NoticeID=1364> (visited 5/11/05).

¹⁶⁴ <http://www.RedHouseBooks.com> (visited 5/16/05).

¹⁶⁵ <http://www.chillingeffects.org/udrp/notice.cgi?NoticeID=1539>; <http://www.MassMutualSuks.com> (both visited 5/11/05).

¹⁶⁶ <http://www.chillingeffects.org/acpa/notice.cgi?NoticeID=1437>; http://www.smoe.org/cgi-bin/mj_wwwusr?func=info&clist=hom-announce (both visited 5/16/05).

¹⁶⁷ <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=1530>; <http://www.prointell.com> (both visited 5/11/05). Intel was incorrect. "Abandonment" of trademark rights only occurs when use of the mark "has been discontinued with intent not to resume," or when the owner allows the mark to become "generic." 15 U.S. Code §1127. Failure to "police" the mark is only relevant if the mark "has lost all significance as an indication of origin." 2 *McCarthy on Trademarks and Unfair Competition* §17.05. Similarly, under copyright law, there must be a proven intent to abandon one's rights. *National Comics Pubs. v. Fawcett Pubs.*, 191 F.2d 594, 598 (2d Cir. 1951); *Dam Things From Denmark v. Russ Berrie & Co.*, 290 F.3d 548, 560 (3d Cir. 2002). "Failure to pursue third-party infringers has regularly been rejected as a defense to copyright infringement or as an indication of abandonment." *Capitol Records v. Naxos of America*, 372 F.3d 471, 484 (2d Cir. 2004). The doctrine of abandonment therefore provides no excuse for IP owners to send cease and desist letters in every conceivable case of infringement.

¹⁶⁸ <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1226> (visited 5/16/05).

¹⁶⁹ <http://www.howardhallis.com/bis/cthulhuchick> (visited 4/17/05).

¹⁷⁰ <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1248> (visited 5/16/05).

¹⁷¹ http://www.2600.com/hackedphiles/value_jet/hacked/html/home.html (visited 5/16/05).

¹⁷² http://www.2600.com/hackedphiles/value_jet/ (visited 5/16/05).

¹⁷³ <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1218> (visited 5/16/05).

¹⁷⁴ <http://www.netfunny.com/rhf/jokes/91q2/amexprew.html>; <http://ideas.4brad.com/archives/000064.html> (both visited 5/16/05).

¹⁷⁵ <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1187> (visited 5/16/05).

¹⁷⁶ <http://www.chillingeffects.org/fanfic/notice.cgi?NoticeID=1067> (visited 4/24/05).

¹⁷⁷ This is a controversial prediction; there is not much legal precedent on fan sites. See page 10; Deborah Tussey, "From Fan Sites to Filesharing: Personal Use in Cyberspace," 35 *Georgia L. Rev.* 1129 (2001); Rebecca Tushnet, "Using Law and Identity to Script Cultural Production: Legal Fictions: Copyright, Fan Fiction, and a New Common Law," 17 *Loyola L.A. Entertainment L. J.* 651 (1997).

¹⁷⁸ "Fanfic and Transcript Removal," <http://www.sincereamore.com/board/viewtopic.php?t=462>; "Disclaimer," http://www.sincereamore.com/main_content/disclaimer.html (visited 4/17/05).

- ¹⁷⁹ [http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1123, 1124, 1129, 1131, 1132, 1133, 1142](http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1123,1124,1129,1131,1132,1133,1142) (all visited 5/16/05).
- ¹⁸⁰ <http://www.downhillbattle.org> (visited 4/17/05); see also <http://www.greytuesday.org/> (visited 4/17/05).
- ¹⁸¹ “Response to EMI’s Cease and Desist Letter,” Feb. 23, 2004, <http://www.downhillbattle.org/index.php?p=68> (visited 6/24/04).
- ¹⁸² http://www.eff.org/IP/grey_tuesday.php (visited 5/16/05). EFF also noted that EMI did not have a federal copyright claim because sound recordings weren’t covered by the federal law until 1972; it might have had state law remedies.
- ¹⁸³ Twenty of these resulted from take-down letters from the American Pool Players Association, and 18 from Star’s Edge.
- ¹⁸⁴ Two proprietors of sites that we’ve categorized as “Strong Fair Use - Did Not Acquiesce or Remove” – Robert Cox of the *New York Times* correction page and “Durango Bill,” both described in chapter 4 – did temporarily remove the targeted material in order to avoid having their ISPs take down their sites.
- ¹⁸⁵ All of these related to Danger Mouse’s *Grey Album*.
- ¹⁸⁶ He was mistaken because once something is in the public domain, it can be used for any purpose, whether for-profit or not-for-profit. If work is not in the public domain, part or all of it still might be usable without permission; this is the whole point of fair use.
- ¹⁸⁷ We have edited the interviews in the interests of coherence and readability, but have scrupulously retained the speakers’ meaning. Interview notes are on file at the Brennan Center.
- ¹⁸⁸ <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=445> (visited 5/4/05).
- ¹⁸⁹ See <http://www.capecodvoice.com/vvimages/theme1121.html> (visited 5/4/05) for this letter, along with the rest of the correspondence and *The Cape Cod Voice’s* commentary.
- ¹⁹⁰ <http://www.capecodvoice.com/vvimages/theme1121.html> (visited 5/4/05).
- ¹⁹¹ <http://www.capecodvoice.com/vvimages/theme1121.html> (visited 5/4/05).
- ¹⁹² <http://www.PetFriendlyTravel.com> (visited 5/4/05).
- ¹⁹³ <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=420> (visited 5/4/05).
- ¹⁹⁴ Another Pet Friendly, Inc. cease and desist letter found in the Chilling Effects Clearinghouse targeted Pet Friendly Rentals of California; see <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=1065>. A site with the URL <http://www.pet-friendly-rentals.com> California was still operating in mid-2005 (both visited 5/4/05).
- ¹⁹⁵ This interviewee asked to remain anonymous.
- ¹⁹⁶ <http://www.chillingeffects.org/protest/notice.cgi?NoticeID=460> (visited 5/4/05).
- ¹⁹⁷ *Hasbro v. Clue Computing*, 66 F. Supp.2d 117 (D.Mass.1999), affirmed, 232 F.3d 1 (1st Cir. 2000).
- ¹⁹⁸ *Interstellar Starship Services v. Epix*, 304 F.3d 936, 944 (9th Cir. 2002).
- ¹⁹⁹ The correspondence is on file at the Brennan Center. See the Clinic’s description of the case at http://cyberlaw.stanford.edu/about/cases/udrp_cases.shtml (visited 5/4/05).
- ²⁰⁰ <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=541> (visited 5/4/05).
- ²⁰¹ This and subsequent correspondence between Bradley and IDG are on file at the Brennan Center.
- ²⁰² <http://www.eInworld.com> (visited 5/4/05).
- ²⁰³ <http://www.saltyrain.com/about.html> (visited 5/5/05).
- ²⁰⁴ <http://www.saltyrain.com/tatooine/hoopla.html> (visited 4/23/05).
- ²⁰⁵ <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=159> (visited 5/5/05).
- ²⁰⁶ <http://www.saltyrain.com/tatooine/hoopla.html> (visited 4/23/05).
- ²⁰⁷ See the discussion in chapter 1, pages 11-14.
- ²⁰⁸ <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=841> (visited 4/22/05). This was one of several interviewees who asked to remain anonymous.
- ²⁰⁹ See pages 13-14; Uniform Domain Name Dispute Resolution Policy, Oct. 24, 1999, <http://www.icann.org/dndr/udrp/policy.htm> (visited 7/22/05); P. Landon Moreland & Colby Springer, “Celebrity Domain Names: ICANN Arbitration Pitfalls and Pragmatic Advice,” 17 *Santa Clara Computer & High Tech L.J.* 385 (2001).
- ²¹⁰ <http://www.thenationaldebate.com/blog> (visited 6/14/05).
- ²¹¹ It is open to debate whether Dowd’s editing altered Bush’s meaning. On May 5, 2003, Bush said: “That group of terrorists who attacked our country is slowly, but surely being decimated. Right now, about half of all the top al Qaeda operatives are either jailed or dead. In either case, they’re not a problem anymore.” <http://www.whitehouse.gov/news/releases/2003/05/20030505-4.html> (visited May 11, 2004). In her May 14, 2003 column, Dowd quoted Bush as saying: “That group of terrorists who attacked our country is slowly but surely being decimated. ... They’re not a problem anymore.” “Osama’s Offspring,” *New York Times*, May 14, 2003, A25.
- ²¹² <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1178> (visited 5/19/05).
- ²¹³ See page 10 for a description of *The Wind Done Gone* case.
- ²¹⁴ “Gone With the First Amendment,” *New York Times*, May 1, 2001, A22. Coleman’s letter is at <http://www.chillingeffects.org/responses/notice.cgi?NoticeID=1186> (visited 5/19/05).

215 “MBA Legal Defense Initiative Takes on First Case,” http://www.mediabloggers.org/archives/2005/02/mba_legal_defen.php (visited 5/2/05).

216 “What is Attrition?,” <http://attrition.org/attrition/about.html> (visited 4/24/05).

217 <http://www.chillingeffects.org/protest/notice.cgi?NoticeID=153> (visited 5/3/05). This is one of three cease and desist letters from MasterCard on the Chilling Effects site, all complaining of defamatory or tasteless takeoffs on MasterCard ads: <http://www.chillingeffects.org/protest/notice.cgi?NoticeID=473>; <http://www.chillingeffects.org/trademark/notice.cgi?NoticeID=17> (both visited 5/3/05).

218 Martin’s reply is at <http://attrition.org/news/mc/mc010.txt>; a description of the controversy is at <http://attrition.org/news/mc/> (both visited 5/3/05).

219 “Mastercard Threatens to Sue Attrition,” July 1, 2003, <http://attrition.org/mews/mc/> (visited 4/24/05). At the time Mastercard threatened Attrition, it had already sued Ralph Nader’s 2000 Presidential Primary Committee for using takeoffs on the “Priceless” campaign in its campaign ads. In March 2004, a court dismissed the suit, ruling that there was no likelihood of confusion. *Mastercard Int’l, Inc. v. Nader 2000 Primary Committee*, 70 U.S.P.Q.2d (BNA) 1046 (S.D.N.Y. 2004).

220 <http://www.lds4u.com>; <http://www.lds4u.com/balanced.htm> (both visited 5/3/05).

221 The take-down letter is at <http://www.chillingeffects.org/notice.cgi?NoticeID=352> (visited 5/4/05); the later correspondence is on file at the Brennan Center.

222 <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1340> (visited 4/22/05).

223 See <http://www.durangobill.com/JasonGastrich.html> (visited 4/22/05) for details.

224 “Do It Yourself Counter Notification Letter,” <http://www-2.cs.cmu.edu/~dst/Terrorism/form-letter.html> (visited 4/22/05). This site, operated by a Carnegie Mellon University professor, explains that “one of the favorite tools of both cults and corporations seeking to take embarrassing information off the Internet is to falsely claim violation of a copyright or trademark,” and outlines the DMCA provision for a counter-notification letter. “Most people don’t know how to write such a letter, which is why I’ve put together this helpful form.” Chilling Effects also has a “Build Your Own Counter-Notice” page, <http://www.chillingeffects.org/dmca/counter512.pdf> (visited 9/17/05).

225 “Important Notice,” <http://www.dreslough.com/main/important.htm> (visited 4/25/05).

226 <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=143> (visited 5/3/05).

227 <http://www.AvatarScam.com/> (visited 4/17/2005).

228 <http://www.chillingeffects.org/trademark/notice.cgi?NoticeID=1280> (visited 4/21/05).

229 Compare *1-800 Contacts v. WhenU.Com*, 75 U.S.P.Q.2d (BNA) 1161 (2d Cir. 2005) (using a company’s Web address to trigger pop-up ads is not an unauthorized “use” under trademark law); *Playboy Enterprises v. Netscape*, 354 F.3d 1020 (9th Cir. 2004) (using the terms “playboy” and “playmate” to trigger banner ads might infringe or dilute *Playboy*’s trademarks, depending on the market context, the user’s intent, and other factors). In *GEICO v. Google*, 330 F. Supp.2d 700 (E.D.Va. 2004), a judge initially ruled that Google was not liable for using the GEICO name to sell ads, but might have “contributory” liability for sponsored links using the trademark. After trial, the judge found that advertisers using the trademark in their headings or text did create a likelihood of confusion; the only remaining question was whether Google was contributorily liable. *GEICO v. Google*, 2005 Westlaw 1903128 (Aug. 8, 2005). Overture was also a defendant in this case, but settled with GEICO in late 2004, which might explain why it changed its mind about the teddy bear ads.

230 <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=262> (visited 5/5/05).

231 ICANN, “Domain Name Dispute Resolution Policies,” <http://www.icann.org/udrp/#erdrp> (visited 5/5/05).

232 Because of the length of this report, we are not reprinting the survey, which is available on request from the Brennan Center.

233 Four individuals who had received cease and desist letters nevertheless answered “no” to the survey question whether they had been involved in a “controversy.” We counted them as having been involved in a controversy despite their negative answer to the question. Of the 58 surveys recounting controversies, four described multiple incidents. A few of those who answered the survey were also interviewed by phone or participated in a focus group.

234 Some of these numbers are based on our reading of all of a respondent’s answers, not just the answer to the acquiescence question. For example, a respondent says he did not acquiesce, but then describes a settlement.

235 The person whose ISP took down the material – Bill Butler – was ultimately able to re-post; see chapter 4.

236 We have edited quotations for coherence and readability, but have scrupulously retained the meaning.

237 <http://www.iidb.org/vbb/index.php> (visited 6/1/05).

238 <http://www.answersingenesis.org> (visited 5/25/05).

239 <http://www.iidb.org/vbb/showthread.php?t=66561> (visited 4/12/05).

240 <http://www.chillingeffects.org/protest/notice.cgi?NoticeID=1069> (visited 6/1/05).

241 <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=480> (visited 4/22/05).

242 <http://www.worldwidewarning.net/portal.htm> (visited 6/2/05).

²⁴³ <http://davidwaathiq.worldwidewarning.net/> (visited 6/2/05).

²⁴⁴ <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=1254> (visited 6/2/05).

²⁴⁵ The correspondence can be found at <http://amway.robinlionheart.com/cuthreat.xhtml> (visited 4/16/05).

²⁴⁶ See <http://www.chrissyconant.com> (visited 7/22/05).

²⁴⁷ Letter from attorney Daniel Kirshner to Chrissy Conant, Apr. 20, 2005 (on file at the Brennan Center).

²⁴⁸ The need for art scholars to reproduce complete images as part of their commentary is obvious, but not firmly established as fair use. In *Ringgold v. Black Entertainment Network*, though, the court suggested that if a TV program produced a feature on an artist and included shots of her works, “the case for a fair use would be extremely strong.” 126 F.3d at 79.

²⁴⁹ Anne Elizabeth Moore, “Operation Pocket Full of Wishes,” Mar. 15, 2005, <http://www.inthesetimes.com/site/main/article/2006> (visited 9/9/05).

²⁵⁰ <http://lists.drifline.org/listinfo.cgi/deleuze-guattari-drifline.org> (visited 6/6/05).

²⁵¹ The parody page is at <http://aphid.org/CA/index.php>; the Chick site at http://www.chick.com/reading/tracts/0039/0039_01.asp (both visited 6/2/05).

²⁵² The dean had ordered the removal from a site near a campus theater of a student sculpture that used found objects to represent body parts. Our respondent wrote: “of course, the plumbing pipe as a penis caused the stir. Ironically, the play being performed was *A Midsummer Night’s Dream*. Funny that a plumbing pipe penis was more offensive than a woman sleeping with a donkey!”

²⁵³ This statement reflects a misunderstanding of fair use, because a work can be both educational and commercial. Fair use is not precluded because a work is marketed commercially; see pages 9-10.

²⁵⁴ Professors supplying photocopies in violation of university policies would not necessarily be breaking the law. Some universities may have reacted to court decisions rejecting fair use defenses for commercial copy shops by imposing policies that are more restrictive than fair use law. See pages 6-7 and n. 129.

²⁵⁵ In 1999, a federal court ruled that museum reproductions of works in their collections do not have enough originality to qualify for copyright protection. In other words, these images can be reproduced without asking permission – as long as the work that was photographed is in the public domain. *Bridgeman Art Library v. Corel Corp.*, 36 F. Supp.2d 191 (S.D.N.Y. 1999). But the clearance culture persists: museums and archive houses continue to demand fees and licenses.

²⁵⁶ See <http://www.centerforsocialmedia.org/fairuse.htm>; and for background, Pat Aufderheide & Peter Jaszi, “Recommendations” (Center for Social Media/Program on Intellectual Property & the Public Interest, American University, 2004), <http://www.centerforsocialmedia.org/rock/recommendations.htm> (visited 8/31/05).

²⁵⁷ The “Copyright Kids” section of the Copyright Society’s Web site includes the following discouraging statement: “Unless you are absolutely sure, relying on the doctrine of ‘Fair Use’ to avoid seeking Permission to copy a work is risky.” “Copyright Basics,” <http://www.copyrightkids.org/cbasicsframes.htm> (visited 6/17/05).

²⁵⁸ At present, there is only a very narrow exemption from damages. See n. 31.







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