Rough Work-in-Progress

Toward a First Amendment Based Copyright Misuse

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Abstract:

This Article makes the case for expanding the equitable defense of copyright misuse in cases in which First Amendment interests are at stake. In a certain class of cases, fair use alone is not enough to encourage the optimal amount of speech that is critical of, or comments on, other copyrighted speech. In such cases, the additional equitable defense of copyright misuse can provide the critical speaker both a shield and a sword to use in fighting off non-meritorious copyright claims aimed at stifling speech. This sword and shield defense is necessary because without it critical speakers have only the unwieldy shield of fair use, which, given the expense of employing it against moneyed copyright holders, is often virtually no defense at all. This Article begins in Part I by giving an example of the type of case in which the copyright misuse defense is necessary to protect and promote critical expression. In Part II, the Article sets out the history of copyright misuse and its current state of development. Part III makes the argument for expanding the reach of copyright misuse (or recognizing the appropriate reach of copyright misuse that already exists, depending on one's interpretation of the current case law). Part IV surveys some of the remedies that might be granted when a Court rules that a copyright owner has committed copyright misuse by impinging on First Amendment interests.

I. CAROL SHLOSS V. ESTATE OF JAMES JOYCE

In June 2006 Professor Carol Loeb Shloss sued the Estate of James Joyce for a declaratory judgment that she had the right under fair use to put quotations from Joyce's work on her website to support the theses of her book about James Joyce's[1] daughter titled *Lucia Joyce: To Dance in the Wake*. The Joyce Estate settled favorably to her nine months later. While Professor Shloss's fair use arguments were strong, it is likely that the Estate settled so quickly because of another count in Shloss's complaint—

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[**] Attorney, Howard Rice Nemerovski Canady, Falk & Rabkin, P.C.; former Professor of English, University of Tulsa; former Editor of the James Joyce Quarterly.

[1] James Joyce was an Irish fiction writer and poet, widely considered to be one of the most influential and innovative authors of the twentieth century. He is best known for his short story collection *Dubliners* (1914), and his novels *A Portrait of the Artist as a Young Man* (1916), *Ulysses* (1922), and *Finnegans Wake* (1939). In particular, *Ulysses* is considered by both the public generally and by literary scholars as one of the most important works of the twentieth century.

her count accusing the Estate of copyright misuse. In the section that follows, which is lifted from the legal filings made in that case,[2] we show a detailed example of a case in which copyright was misused to squelch scholarly speech, and how the threat of copyright misuse helped protect that speech.[3]

Carol Loeb Shloss is a professor of English at Stanford University.[4] Her focus is modernism, and especially the work of James Joyce. Throughout her academic career, she has taught or held research positions at numerous universities, including Wesleyan University, Harvard University, and Oxford University.[5] She is the author of four books and has won numerous grants and fellowships, including the 1994 Pew Fellowship for Creative Non-Fiction Writing.[6] The Estate of James Joyce operates under the control of trustee Seán Sweeney and beneficiary and trustee Stephen James Joyce, the grandson of the famous twentieth century author James Joyce. Together, Joyce and the Estate assert ownership of the copyrights in all written works of James Joyce and his daughter, Lucia Joyce. Stephen Joyce is well-known for his aggressive enforcement of these rights, as detailed in the popular press.[7]

A. The Joyce Estate's Fifteen-Year Campaign To Stop Publication Of Shloss's Book

In 1988, Professor Shloss began researching a book about Lucia Joyce.[8] Lucia Joyce, daughter of James Joyce and Nora Barnacle, was born in Trieste, Italy, on July 26, 1907. Lucia began taking dance lessons when she was fifteen, and this became her main interest during her teens and twenties. She started to show signs of emotional distress in 1930. Carl Jung took her in as a patient in 1934. Many other doctors, all with varying diagnoses, worked with her in ensuing years. Apparently against her will and the will of James Joyce, Lucia's mother, Nora, and brother, Giorgio, committed Lucia to a mental hospital when Lucia was 25, beginning her sporadic confinement in psychiatric institutions that would last until her death on December 12, 1982.

People have destroyed documents about Lucia Joyce for over sixty years, apparently due largely to the stigma that previous generations attached to young women who had suffered emotional trauma. As a result, little of the public record remains. This

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[2] The authors of this article were among the primary drafters of the filings in the case. Accordingly, where it is appropriate to repeat descriptions from the pleadings verbatim, quotation marks may be omitted.

[3] We do not ignore that the fact that Professor Shloss had pro bono counsel also helped turn the tables in her favor. But as will be seen, even with all of the advantages she had, the Joyce Estate still fought hard to stop her speech.

[4] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss ¶ 1, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[5] *Id.* ¶ 2.

[6] *Id.* ¶¶ 2-3.

[7] *See, e.g.*, Declaration of Robert Spoo in Opposition to Defendants' Motion to Dismiss, Ex. 3, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006); Amended Complaint ¶¶ 85-105 [Docket No. 14], Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[8] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss ¶ 11, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

dearth of information characterized the special circumstances in which Shloss worked, and it explains the special importance of even small amounts of documentary evidence to her work. Because Professor Shloss intended to show that James Joyce wrote about Lucia in various creative and imaginative ways in *Finnegans Wake*, this documentary evidence is of literary as well as biographical importance.[9]

In connection with her work on her Lucia Joyce project, Shloss traveled the world to learn about and document the life of Lucia, including her early dancing career, history of mental health treatment and her unacknowledged contributions to her father's literary works.[10]

The Estate worked to thwart Shloss's project from the beginning. In 1988, Stephen Joyce destroyed many of Lucia's letters, as he admitted publicly at an international symposium in Venice and in an interview with the *New York Times*.[11] In response to the outrage expressed by Joyce scholars, he taunted them, asking, "What are people going to do to stop me?"[12] Similarly, in 1992, Stephen Joyce succeeded in removing documents regarding Lucia from the Paul Léon Papers in the archives at the National Library of Ireland, even though he had no legal claim to these papers that had been donated to the Irish people.[13] This generated an angry denunciation on the floor of the Irish Senate.[14]

When the Estate could not destroy material, it attempted to block Shloss's access to it. In 1994, Shloss traveled to the University of Buffalo in New York to consult the James Joyce papers in the Special Collections at the Lockwood Memorial Library.[15] But the Library's Director, Robert Bertholf, had already been contacted by "intermediaries" from the Joyce Estate, who warned him that Shloss should not be permitted access to the Library's Joyce materials.[16] Upon arriving, Shloss was told that she could review these materials only if she kept a "low profile."[17] Indeed, the curator expressed fear that the Estate would sue the university if it learned that Shloss had been allowed to see its Joyce materials.[18]

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[9] In the generation of those who knew James and Lucia Joyce personally, those who destroyed or suppressed letters were Maria Jolas, Harriet Shaw Weaver, John Dulanty, Stuart Gilbert, and the family of Charles Joyce.
[10] *Id.* ¶¶ 10-20.
[11] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. A, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[12] *Id.*
[13] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. B, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[14] *Id.*
[15] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss ¶ 17, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[16] Declaration of Robert Spoo in Opposition to Defendants' Motion to Dismiss, Ex. 3 at 41, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[17] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss ¶ 17, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[18] *Id.*

Shloss grew concerned about the situation. She was aware that Stephen James Joyce had vehemently objected to an epilogue in fellow Joyce scholar Brenda Maddox's biography of Nora Joyce, the author's wife, because it described the time Lucia spent in a mental asylum.[19] Fearing legal action, Maddox removed the section even though copies of the book had already been printed.[20]

Shloss decided to write to Stephen Joyce in early 1996 in the hope of avoiding a similar dispute and to ask for Joyce's approval and assistance in her work. This overture was rejected gruffly. In a March 31, 1996 letter, Joyce told Shloss that his "response regarding helping and working with [her] on a book about Lucia is straightforward and unequivocal: it is a definite NO."[21] Joyce also stated that "you do not have our approval/permission to 'use' *any* letters or papers by or from Lucia. . . . [or] our authorization to use *any* letters from my grandfather to anybody which deal with her."[22] Joyce wrote to Shloss again on April 19, 1996. In this letter, he derided what he termed the "Joycean industry" with which he associated Shloss, and reiterated that "[o]n Lucia's dancing career we have nothing to say."[23]

Soon after receiving Joyce's first letter, Shloss wrote to Jane Lidderdale, Lucia's guardian before her death.[24] Worried about the ire Joyce had shown toward her—and the aggressiveness with which he had pursued Brenda Maddox regarding the subject of Lucia—Shloss recognized that she "clearly will have a legal problem [with Joyce] when it comes to publication" of her work.[25]

Despite her fears, Shloss continued her work. In 2001, she signed a contract with the publishing house Farrar Straus & Giroux ("FSG") to publish her book.[26] Upon learning that Shloss's book would soon be published, Stephen Joyce contacted Shloss again.

In an August 8, 2002 letter to Shloss, Joyce reiterated his refusal to give permission for any use of any of the material he controlled, including Lucia's letters, drawings, portraits or caricatures, or any letters from James Joyce to Lucia Joyce.[27]

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[19] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss ¶ 65, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006); *see also* Declaration of Robert Spoo in Opposition to Defendants' Motion to Dismiss, Ex. 3 at 34, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[20] *Id.*

[21] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. C, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006) (emphasis in original).

[22] *Id.* (emphasis added).

[23] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. E, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[24] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, ¶ 24 and Ex. F, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[25] *Id.*

[26] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss ¶ 25, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[27] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. G, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

Joyce attempted to justify this total ban by asserting that he must "safeguard whatever remains of the much abused and invaded Joyce family privacy."[28] Invoking the Estate's history of litigation and intimidation against other authors, Joyce warned that "[o]ver the past few years ***we have proven that we are willing to take any necessary action to back and enforce what we legitimately believe in.***".[29]

Stephen Joyce also began contacting Shloss's publisher directly. On November 4, 2002, Joyce called FSG and harangued editor John Glusman.[30] Joyce announced that he was opposed to the publication of any Lucia-related material, and pointed out that he had "never lost a lawsuit."[31] That same day, Joyce wrote to FSG president Jonathan Galassi and enclosed his previous correspondence with Shloss.[32] Joyce reiterated his opposition to use of any Lucia-related materials he controlled, and invited a response from Galassi.[33]

Rather than waiting for that response, Joyce wrote again to Galassi the very next day. In his November 5, 2002 letter, Joyce again explained that Shloss did not have permission to use any of Lucia's writings. Joyce also claimed that Shloss needed his permission to quote from letters written by Harriet Weaver, Shaw Weaver, Paul Léon, or Maria Jolas and again asserted his opposition to publication of both these and any Lucia-related materials.[34]

FSG responded to Joyce's objections through its attorney, Leon Friedman, on November 6, 2002. Mr. Friedman explained that FSG considered Shloss's use of the Lucia-related material to which the Estate objected to be protected by the Fair Use doctrine and indicated that Joyce's threats would not deter FSG from going forward with publication.[35]

Joyce responded by letter of November 21, 2002. In that letter, his threats became even more pointed. He advised FSG that it should "take . . . very seriously" his

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[28] *Id.*

[29] *Id.* (emphasis added). Joyce also rescinded the one permission he had ever granted Shloss (for a fee) – her use James Joyce's published poem *A Flower Given to My Daughter*. He did so because he viewed Shloss's communications with Estate trustee Sweeney and former Estate lawyer David Monro, not as legitimate efforts to identify copyright ownership and secure rights, but as attempts to bypass him. *See* Shloss Dec., Ex. I.

[30] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss ¶¶ 29-30, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[31] *Id.*

[32] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. I, Case No. CV 06-3718 (JW) (HRL), (N.D. Cal. 2006); Declaration of Jonathan Galssi in Opposition to Defendants' Motion to Dismiss, Ex. 1, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[33] *Id.*

[34] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. J, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006); Declaration of Jonathan Galssi in Opposition to Defendants' Motion to Dismiss, Ex. 2, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[35] Declaration of Leon Friedman in Opposition to Defendants' Motion to Dismiss, Ex. 1, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

earlier letters to Shloss and Galassi, and reiterated his earlier statements that Shloss was not permitted to use any of the Lucia-related materials he had identified.[36] Joyce went on to warn Friedman that FSG "should be aware of the fact that over the past decade ***the James Joyce Estate's 'record', in legal terms, is crystal clear and we have proven on a number of occasions that we are prepared to put our money where our mouth is***."[37] Joyce closed by advising Friedman that in publishing the Lucia-related material Joyce objected to, "you or rather Farrar Straus & Giroux proceed *à vos risques et périls*"—***at your risk and peril—***and that he should "kindly bear in mind ***there are more ways than one to skin a cat***."[38]

Having received no reply from Friedman or FSG, Joyce wrote again on December 31, 2002 to remind Friedman that "[a]s I indicated in my previous letter, ***there are more ways than one to skin a cat!***"[39] Friedman replied on January 2, 2003, informing Joyce that no further correspondence was necessary because the positions of the two parties were clear.[40]

Joyce did not stop there. On May 22, 2003, he wrote to Friedman to "formally inform" him that "Shloss and her publishers are NOT granted permission to use any quotations from anything" that Lucia Joyce "ever wrote, drew or painted."[41] He explained that in his view "fair use does not apply to letters consequently no extracts from letters of any member of the Joyce family can be used in Ms. Shloss' book and I, acting for both the Estate and Family, refuse to grant such permission."[42] In this letter, Joyce went on to assert that he has never "encountered a case where an author, academic or otherwise, and his or her publisher refused to deal with me directly as is the case in this instance."[43] He followed this with an open threat:

> So be it. I am perfectly willing to play the "game" your way but there will be repercussions. This is not a threat but a statement of fact….[44]

Exactly two months later, on July 22, 2003, Joyce wrote Friedman another unsolicited letter to remind Friedman, FSG, and Shloss what was by now clear:

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[36] Declaration of Leon Friedman in Opposition to Defendants' Motion to Dismiss, Ex. 2, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[37] *Id.* (emphasis added).
[38] *Id.* (emphasis added).
[39] Declaration of Leon Friedman in Opposition to Defendants' Motion to Dismiss, Ex. 3, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[40] Declaration of Leon Friedman in Opposition to Defendants' Motion to Dismiss, Ex. 4, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[41] Declaration of Leon Friedman in Opposition to Defendants' Motion to Dismiss, Ex. 5, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006) (emphasis in original).
[42] Declaration of Leon Friedman in Opposition to Defendants' Motion to Dismiss, Ex. 5, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[43] Declaration of Leon Friedman in Opposition to Defendants' Motion to Dismiss, Ex. 5, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[44] Declaration of Leon Friedman in Opposition to Defendants' Motion to Dismiss, Ex. 5, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

> Let me point out and stress, if need be, that the James Joyce Estate and myself as the sole beneficiary owner hold any and all rights, including copyright, to anything and everything that James, Nora . . . , Giorgio (George), Lucia, Helen (Kastor Fleischman) Joyce and myself ever wrote, drew, painted and/or recorded etc. . . .
>
> In virtually all countries/nations and territories the world over there are laws, International Conventions ad Statutory Instruments which will uphold our intellectual property rights, including copyright and moral rights.[45]

B. The Estate's Other Campaigns And Its History Of Litigation

Shloss was not the only target of Joyce's animosity during the period she was researching and writing about Lucia Joyce. Joyce's dispute with Brenda Maddox is but one example of threats and lawsuits against other scholars that were well-known in the Joyce community and which contributed to Shloss's apprehension of suit.

- In 1997, the Estate sued Macmillan Publishers Limited and Joyce scholar Danis Rose for publishing a new edition of *Ulysses* that incorporated a small amount of manuscript material that had remained unpublished until after Joyce's death. Angered by what it regarded as unacceptable changes to the text, the Estate pursued an injunction and compensatory damages against the two defendants in the English High Court, despite "the fact that the passages taken by Dr. Rose . . . are only a few lines or even less than a line here and there."[46]

- In 1998, the Estate filed suit in Ireland against sponsors of a global Bloomsday webcast that included a celebratory reading from *Ulysses*.[47] The Estate claimed the webcast infringed copyright, despite the sponsors' argument that the webcast fell within an exemption in Irish copyright law for works like *Ulysses* that had fallen out of copyright and later been revived pursuant to European Union law.[48] The webcast was sponsored in association with Dublin's James Joyce Centre, a registered charity that promotes awareness of James Joyce and his writings.[49] The webcast, which had been supported by the Prime Minister, President, and other leading politicians of Ireland, did not go forward the

[45] Declaration of Leon Friedman in Opposition to Defendants' Motion to Dismiss, Ex. 6, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[46] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. Q, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[47] Declaration of Robert Spoo, Ex. 1, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[48] Declaration of Robert Spoo, Ex. 1, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).
[49] Declaration of Robert Spoo, Ex. 1, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

following year when sponsors withdrew support out of fear of further litigation.[50]

- In 2000 the Estate initiated a lawsuit against Cork University Press in Ireland.[51] When the Press refused to pay the exorbitant licensing fee demanded by the Estate but continued preparations for publication, the Estate sought, and the Irish High Court granted, a preliminary injunction that caused the Press to have to physically excise the Joyce extracts from printed copies of the anthology.[52]

- Also in 2000, threats by Joyce stopped an Irish composer from using only eighteen words from *Finnegans Wake*, a novel thousands of words long, in his choral piece. Despite the nominal use, Joyce stated that he simply did not like the music and thus deemed even eighteen words too much.[53]

C. The Effect Of The Estate's Conduct On Professor Shloss And Her Publisher

The threats issued by the Estate to Shloss and her publisher, coupled with the Estate's history of belligerence and litigation against other authors and scholars, left Shloss with one conclusion. She believed that if she published the Lucia-related material in her book as written, she and FSG were likely to be sued.[54] As she wrote to her agent Tina Bennett in 2003: "I think there will be a lawsuit, and the suit could be against me individually."[55] And while Professor Shloss thought that she could legally prevail in a suit, the cost of litigation was such that she could not afford to be sued. As she explained to her agent, "It's not a matter of winning or not. The suit itself would ruin us."[56]

FSG's actions left no doubt that it agreed. FSG ultimately required Shloss to cut significant Lucia-related material from her 400-page manuscript over her objection and to her great dismay.[57] In her view, the book she had spent fifteen years on was being

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[50] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. R, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006); Declaration of Robert Spoo, Ex. 1, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[51] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. O, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006); Declaration of David Pierce ¶¶ 3-8, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[52] Declaration of David Pierce ¶¶ 3-8, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[53] Declaration of Robert Spoo, Ex. 4, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[54] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, ¶ 44, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[55] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. K, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[56] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, Ex. K, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[57] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, ¶¶

gutted. The reason was clear. As Stephen James Joyce himself stated in a letter to Stanford University's Provost, FSG required the cuts "***out of concern for copyright litigation.***"[58]

There is no doubt that scholarship suffered as a result of excising a substantial portion of Shloss's primary sources. While reviewers lauded Shloss for her provocative theory, they also criticized her for a lack of documentary support.[59] Thereafter, Shloss was determined to tell the whole story of Lucia Joyce, despite her profound fear of suit and the financial burden it could inflict on her and her husband. Shloss sought out and obtained pro bono representation.[60] In order to tell Lucia's full story—as it existed before FSG's cuts—Shloss created a Website that contained the material FSG had required her to cut, which was ready to be published as of March 2005.[61] On March 9, 2005, Shloss's counsel wrote to Joyce to notify him of Shloss's intention to publish this Website containing the excised material, and to inform him that her right to do so was protected by Fair Use principles.[62]

Shloss's counsel then received an April 8, 2005 letter from the Estate's Irish counsel, McCann Fitzgerald.[63] The Estate's position had not changed. Its counsel again reiterated its "request" that Shloss refrain from publishing the Lucia-related material in dispute.[64] Shloss's counsel responded to McCann Fitzgerald on April 20, 2005, explaining that Shloss planned to release the website to the public on May 10 and asked the Estate to register any objection before that date.[65] The Estate responded through McCann Fitzgerald on May 13. They asserted publication of the Lucia-related materials to be an "***unwarranted infringement of the Estate's copyright***" and "***request[ed] in the strongest possible terms that [the Estate's] legal rights on this issue be respected***."[66]

45-46, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[58] Declaration of John Etchemendy, Ex. A, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[59] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, ¶¶ 47-48, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[60] Shloss first contacted Larry Lessig at Stanford Law School. After reviewing her situation, Lessig agreed that he and his Center for Internet and Society would represent Shloss. Soon thereafter, Robert Spoo joined the case, first with Doerner Saunders and then with Howard Rice. Mark Lemley and his firm, Keker Van Nest also joined the team shortly after the complaint was filed.

[61] Declaration of Carol Loeb Shloss in Opposition to Defendants' Motion to Dismiss, ¶ 49-53, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006); Declaration of David Olson in Opposition to Defendants' Motion to Dismiss, Ex. A, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[62] Declaration of Grace Smith, Ex. 1, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[63] Declaration of Grace Smith, Ex. 3, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[64] Declaration of Grace Smith, Ex. 3, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[65] Declaration of Grace Smith, Ex. 4, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[66] Declaration of Grace Smith, Ex. 5, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal.

After additional correspondence with Shloss's counsel, McCann Fitzgerald reiterated that the Estate denied permission to use any of the material in issue, and rejected the notion that fair use permited its use absent the Estate's consent. Accordingly, McCann the Estate advised that it "***reserves all its rights if your client perseveres with her proposed activities***."[67]

Accordingly, Shloss' dilemma remained. She could remain silent and leave the full story of Lucia she had worked fifteen years to assemble to be lost for all time, or she could risk the possibility of suit and financial ruin by releasing the excised material on the Website she had created and submitted to the Estate. In order to forestall potential damages, she filed suit for declaratory relief on June 12, 2006.

II. HISTORY AND DEVELOPMENT OF COPYRIGHT MISUSE

Professor Shloss's story illustrates the damage that can be caused by what Professor Alfred Yen calls "aggressive copyright claims."[68] These claims are often made against authors producing highly transformative or critical works and essentially assert that copying any language constitutes infringement.[69] Such overzealous assertion of copyrights in cases involving criticism or transformative work ultimately harms society because enforcement results in the silencing of original expression.[70]

Authors faced with aggressive copyright claims are left few options to defend themselves.[71] The two main defenses available are fair use and the idea/expression dichotomy.[72] The fair use defense is defined by statute and allows for the unapproved use of copyrighted material in limited situations.[73] The idea/expression dichotomy is the concept that a copyright does not grant an author exclusive rights to any idea, but instead merely to the particular expression that he or she created.[74] These two doctrines together

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2006) (emphasis added).

[67] Declaration of Grace Smith, Ex. 10, Case No. CV 06-3718 (JW) (HRL) (N.D. Cal. 2006).

[68] Alfred C. Yen, *Eldred, the First Amendment, and Aggressive Copyright Claims*, Houston Law Review, Vol. 40, No. 3, pp. 673-695, (104 on SSRN), Symposium 2003 Available at SSRN: http://ssrn.com/abstract=455980 or DOI: 10.2139/ssrn.455980.

[69] *e.g. Id.*; Jason Mazzone, *Copyfraud*, 81 N.Y.U. L. Rev. 1026, 1052 (2006).

[70] *e.g.*, Alfred C. Yen, *Eldred, the First Amendment, and Aggressive Copyright Claims*, Houston Law Review, Vol. 40, No. 3, pp. 673-695, (108 on SSRN), Symposium 2003 Available at SSRN: http://ssrn.com/abstract=455980 or DOI: 10.2139/ssrn.455980; JuNelle Harris, *Beyond Fair Use: Expanding Copyright Misuse to Protect Free Speech*, 13 Tex. Intell. Prop. L.J. 83, 85 (2004); Jason Mazzone, *Copyfraud*, 81 N.Y.U. L. Rev. 1026, 1030 (2006).

[71] *See* Victoria Smith Ekstrand, *Protecting the Public Policy Rationale of Copyright: Reconsidering Copyright Misuse*, 11 Comm. L. & Pol'y 565, 567-8 (2006).

[72] JuNelle Harris, *Beyond Fair Use: Expanding Copyright Misuse to Protect Free Speech*, 13 Tex. Intell. Prop. L.J. 83, 93 (2004).

[73] 17 U.S.C. §107.

[74] JuNelle Harris, *Beyond Fair Use: Expanding Copyright Misuse to Protect Free Speech*, 13 Tex. Intell. Prop. L.J. 83, 88 (2004).

are sometimes thought to provide all necessary protection against copyright holders infringing on the First Amendment rights of authors.[75]

In reality, however, these defenses are not sufficient to defend authors from aggressive copyright claims.[76] In cases such as Carol Schloss's, the protection of an author's rights is often prohibitively expensive and insufficiently guaranteed under these two defenses because asserting them requires an infringement trial.[77] Furthermore, the defenses have vague boundaries and rely on multipart judicial tests that make determining the likelihood of success difficult.[78] Unfortunately, this means that oftentimes authors are effectively silenced by the threat of litigation regardless of the validity of the accuser's claims.[79]

Furthermore, recent developments in copyright law, namely the Digital Millennium Copyright Act, have exacerbated the situation by providing copyright holders with new tools for banning the use of their works.[80] In stark contrast, the fair use defense remains fixed in its codified form and lacks the flexibility of common law to adapt to new challenges in copyright law.[81] Taken together, the problem with aggressive copyright claims appears to stem from an imbalance between copyright protection and protection of the public domain.[82]

Thus, a need exists to supplement the fair use and idea/expression dichotomy protections for authors, especially in the case of critical works.[83] Copyright misuse is a uniquely suited defense because it focuses on the actions of the copyright holder, unlike the other two defenses that focus squarely on the actions of the allegedly infringing author.[84] The availability of the misuse defense would not only further encourage

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[75] Alfred C. Yen, *Eldred, the First Amendment, and Aggressive Copyright Claims*, 40 Houston L. Rev. 673-695, (104 on SSRN), available at: http://ssrn.com/abstract=455980 or DOI: 10.2139/ssrn.455980.
[76] *See* JuNelle Harris, *Beyond Fair Use: Expanding Copyright Misuse to Protect Free Speech*, 13 Tex. Intell. Prop. L.J. 83, 108 (2004).
[77] *Id.* at 98.
[78] Alfred C. Yen, *Eldred, the First Amendment, and Aggressive Copyright Claims*, Houston Law Review, Vol. 40, No. 3, pp. 673-695, (106-7 on SSRN), Symposium 2003 Available at SSRN: http://ssrn.com/abstract=455980 or DOI: 10.2139/ssrn.455980.
[79] JuNelle Harris, *Beyond Fair Use: Expanding Copyright Misuse to Protect Free Speech*, 13 Tex. Intell. Prop. L.J. 83, 98 (2004); Victoria Smith Ekstrand, *Protecting the Public Policy Rationale of Copyright: Reconsidering Copyright Misuse*, 11 Comm. L. & Pol'y 565, 566 (2006).
[80] *See* Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. Rev. 1095, 1096 (2003).
[81] JuNelle Harris, *Beyond Fair Use: Expanding Copyright Misuse to Protect Free Speech*, 13 Tex. Intell. Prop. L.J. 83, 108 (2004).
[82] Jason Mazzone, *Copyfraud*, 81 N.Y.U. L. Rev. 1026, 1029 (2006).
[83] *See* Victoria Smith Ekstrand, *Protecting the Public Policy Rationale of Copyright: Reconsidering Copyright Misuse*, 11 Comm. L. & Pol'y 565, 569 (2006).
[84] *e.g.*, Note: *Clarifying the Copyright Misuse Defense: The Role of Antitrust Standards and First Amendment Values*, 104 Harv. L. Rev. 1289, 1306 (1991); Kathryn Judge, *Rethinking Copyright Misuse*, 57 Stan. L. Rev. 901, 915 (2004).

authors to create new critical or transformative speech but may also make copyright owners think twice before alleging aggressive copyright claims.[85]

The remainder of this section provides an overview of the history surrounding the copyright misuse doctrine and details its current position as a largely accepted, but officially unapproved defense to an infringement action.

The doctrine of copyright misuse is an equitable defense similar to the common law doctrine of unclean hands.[86] It is based on the notion that courts should deny any relief to a plaintiff if he has come to the court while engaging in improper behavior himself. Correspondingly, a finding of copyright misuse acts to bar the plaintiff from recovering any damages or injunctive relief for so long as the misuse continues.[87] It is important to note that a plaintiff can cure his inequitable behavior and return to court to seek relief against an alleged infringer.[88]

Copyright misuse's roots lie in the analogous doctrine of patent misuse. In the 1942 *Morton Salt Co. v. G.S. Suppiger Co.* case the Supreme Court first recognized patent misuse in a case involving tying arrangements.[89] Tying is the practice of making a license grant contingent on the purchase of some other unpatented good. In *Morton Salt* Suppiger licensed a patented machine for depositing salt tablets into cans and required its licensees to also purchase its salt tablets, which were not covered under the scope of the patent. The Court found that this practice was an impermissible attempt to expand the reach of the patent and denied relief to the plaintiff on these grounds.[90]

Since *Morton Salt* the doctrine of patent misuse has been well refined by both the judicial and legislative branches.[91] While the doctrine relies greatly on antitrust law there are some key differences between the two.[92] The first difference relates to the burden of proof for defendants invoking misuse. Patent misuse requires neither the showing of dominant market position or direct harm to the defendant that is necessary under antitrust

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[85] Kathryn Judge, *Rethinking Copyright Misuse*, 57 Stan. L. Rev. 901, 932-3 (2004).
[86] *e.g.*, Note: *Clarifying the Copyright Misuse Defense: The Role of Antitrust Standards and First Amendment Values*, 104 Harv. L. Rev. 1289, 1295 (1991); Brett M. Frischmann & Daniel Moylan, *The Evolving Doctrine of Copyright Misuse* 1 (July 2006). Available at SSRN: http://ssrn.com/abstract=914535.
[87] John T. Cross & Peter K. Yu, *Competition Law and Copyright Misuse,* MSU Legal Studies Research Paper No. 04-29 19-20 Available at SSRN: http://ssrn.com/abstract=986891.
[88] Jennifer R. Knight, *Copyright Misuse v. Freedom of Contract: And the Winner is...,* 73 Tenn. L. Rev. 237, 261 (2006).
[89] Morton Salt Co. v. G. S. Suppiger Co., 314 US 488 (1942).
[90] Morton Salt Co. v. G. S. Suppiger Co., 314 US 488, 491 (1942).
[91] Brett M. Frischmann & Daniel Moylan, *The Evolving Doctrine of Copyright Misuse* 12 (July 2006). Available at SSRN: http://ssrn.com/abstract=914535.
[92] John T. Cross & Peter K. Yu, *Competition Law and Copyright Misuse,* MSU Legal Studies Research Paper No. 04-29 19 Available at SSRN: http://ssrn.com/abstract=986891.

law.[93] Second, as an equitable defense, misuse simply bars recovery, but does not entitle the defendant to any kind of damages from plaintiff.[94]

The first extension of misuse to copyright law came six years after *Morton Salt* in the case of *M. Witmark & Sons v. Jensen.*[95] This district court case involved another tying arrangement, this time with respect to copyrighted music instead of patented goods. Defendants claimed that motion picture companies unfairly tied licenses for their movies to licenses for the music in them.[96] Defendants instead wanted to negotiate licenses for the music separately with the copyright owners. The court found that the tying arrangement violated both antitrust law and the public policies underlying copyright law.[97] This led to a finding of misuse; however, the court declined to find exactly what factors comprised the misuse finding.[98]

The Supreme Court has yet to rule on the extension of misuse to copyright, but its implicit guidance in several cases indicates possible acceptance.[99] The relevant cases all involve attempts by record or movie producers to block book their copyrighted works. The practice of block booking is very similar to tying; copyright owners make licenses to popular works contingent on the purchase of licenses to less desirable content. Three Supreme Court cases involve such a scenario. In *United States v. Loew's, Inc.* and *United States v. Paramount Pictures, Inc.* the court found the block booking practice to be a violation of antitrust law using logic similar to patent misuse decisions.[100] Finally, in *Broadcast Media, Inc. v. CBS, Inc.* the court considered a Second Circuit finding that Broadcast Media had violated antitrust law and committed misuse.[101] The Court reversed the antitrust finding and subsequently reversed the misuse finding as well because they viewed it as dependent on the antitrust claim.[102]

These cases, while implicitly supporting copyright misuse at least when antitrust violations can be shown, took no explicit steps toward establishing the doctrine. The true breakthrough for copyright misuse occurred with the 1990 case of *Lasercomb America, Inc. v. Reynolds*.[103] Here, the Fourth Circuit considered whether overly restrictive license provisions constituted misuse. Lasercomb America licensed manufacturing die-design software to users with a license provision requiring them to not create a comparable product for 99 years. Holiday Steel, defendant Reynold's employer, created just such a product and was sued for infringement.

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[93] *Id.*
[94] *Id.*
[95] M. Witmark & Sons v. Jensen, 80 F. Supp. 843 (D. Minn. 1948).
[96] *Id.* at 845.
[97] *Id.* at 850.
[98] *Id.*
[99] *See* Victoria Smith Ekstrand, *Protecting the Public Policy Rationale of Copyright: Reconsidering Copyright Misuse*, 11 Comm. L. & Pol'y 565, 573 (2006).
[100] *e.g.*, U.S. v. Loew's, Inc., 371 US 38 (1962); U.S. v. Paramount Pictures, 334 US 131 (1948); *See* Victoria Smith Ekstrand, *Protecting the Public Policy Rationale of Copyright: Reconsidering Copyright Misuse*, 11 Comm. L. & Pol'y 565, 573 (2006).
[101] Broadcast Music, Inc. v. Columbia Broadcasting System, Inc., 441 US 1 (1979).
[102] *Id.* at 24.
[103] Lasercomb America, Inc. v. Reynolds, 911 F.2d 970 (N.C. 1990).

The *Lasercomb* court found that by preventing licensees from entering the product space the plaintiff had impermissibly used its copyright to protect an idea rather than its expression.[104] Importantly, the court ruled that showing an antitrust violation was not essential to establish misuse.[105] A plaintiff need only use his copyright in a manner violative of the public policies underlying copyright law to commit misuse.[106] *Lasercomb* marked the first time a court explicitly found copyright misuse and further denied relief to a plaintiff based on the doctrine. Since the 1990 ruling, several courts have considered similar cases and adopted the Fourth Circuit's interpretation of misuse.

Practice Management v. American Medical Association involved another overly restrictive license provision as a basis for finding misuse.[107] The American Medical Association (AMA) copyrighted a series of codes used for designating medical procedures and licensed their use with the provision that the licensee use no other system of codes. The Ninth Circuit found that AMA had misused its copyright on the same grounds as in *Lasercomb*; specifically they used their copyright to prevent AMA from using a competitor's service.[108] In further support of the landmark decision the court stated that a violation of antitrust law was not necessary to show misuse.[109]

The Fifth Circuit joined the Fourth and Ninth in recognizing copyright misuse in *Alcatel USA, Inc. v. DGI Technologies, Inc.*[110] In this case DGI was sued for infringement because it reverse engineered copyrighted software in order to produce compatible replacement hardware used in Alcatel telephone switches. Alcatel did not possess patents on the telephone switches themselves, but had copyrighted the operating system controlling the switch. The court found that Alcatel misused its copyright in leveraging it to claim patent-like protection over their hardware.[111] This decision lacked the full acceptance of the *Lasercomb* misuse defense present in *Practice Management*. The court cited the public policy basis for misuse established by *Lasercomb*, but ultimately found for misuse based on the anticompetitive practices of Alcatel.[112]

The 1999 *Alcatel* case is closely paralleled by several more recent cases involving the Digital Millennium Copyright Act.[113] As mentioned above, the DMCA has aggravated the problems associated with aggressive copyright claims by providing copyright holders with even more power to stop the fair use of their copyrighted work.[114]

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[104] *Id.* at 978.
[105] *Id.*
[106] *Id.*
[107] Practice Management Information Corp. v. American Medical Ass'n, 121 F.3d 516 (9th Cir. 1997).
[108] *Id.* at 520.
[109] *Id.*
[110] Alcatel USA, Inc. v. DGI Technologies, Inc., 166 F.3d 772 (5th Cir. 1999).
[111] *Id.* at 793.
[112] *Id.* at 793-4.
[113] *See* G. Gervaise Davis III, *The Affirmative Defense of Copyright Misuse and Efforts to Establish Trademark Misuse, and Fraud on the Copyright Office: Establishing Limitations on the Scope of Copyright Owners Rights Based on Several Theories*, 867 PLI/Pat 103, 120 (2006).
[114] Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. Rev. 1095, 1096 (2003).

These DMCA cases do not explicitly rely on the misuse doctrine, but have essentially applied the same theory as used in *Alcatel* to deny plaintiffs relief. One such case is *Chamberlain Group, Inc. v. SKYLINK Techs., Inc.*, a Fifth Circuit case involving garage door openers. SKYLINK produced garage door opener remote transmitters that were compatible with Chamberlain garage door openers.[115] In order to make the units compatible SKYLINK needed to reverse engineer the copyrighted software used by Chamberlain just as DGI did to ensure compatibility with Alcatel hardware. Chamberlain sued alleging a breach of the anticircumvention provisions of the DMCA.[116] The court held that Chamberlain's position effectively granted them patent like protection over their device and could not be permitted.[117] This is the same reasoning as used in *Alcatel*; enforcing plaintiff's claim would mean extending new rights to plaintiff not granted by copyright law and thus runs counter to the public policies underlying copyright law.

While these cases illustrate important precedents in the formation of the copyright misuse doctrine, they all largely relate to business practices. The next three cases also adopt the misuse defense, but their subject matter is slightly more germane to this paper's consideration of misuse in settings where First Amendment interests are at stake.

The 1991 district court case of *QAD, Inc. v. ALN Associates, Inc.* concerned copyrighted software.[118] ALN, accused of creating an infringing product, argued for misuse and alleged that QAD had used software copyrighted by Hewlett Packard in its own program.[119] The court found this to be true and also subscribed to the *Lasercomb* public policy rationale behind copyright misuse.[120] In addition, the *QAD* court directly related copyright misuse to the First Amendment, stating that because copyright derives from freedom of expression a copyright is misused when improperly asserted to inhibit another's expression.[121]

It is important to note that the language of *QAD* makes clear that misuse occurs only when another's expression is *improperly* inhibited. Copyright, by its definition, allows owners to silence others despite the First Amendment in certain situations just as patents allow monopoly powers contrary to antitrust law. This principle is illustrated in *Video Pipeline, Inc. v. Buena Vista Home Entertainment*, where Video Pipeline accused Disney, Buena Vista's owners, of misuse because it included restrictions on criticism of Disney movies in its licensing agreements.[122] In considering the issue the Third Circuit decided that the misuse doctrine as defined by *Lasercomb* was available, but not applicable given the facts.[123] The court felt the restrictions on criticism did not inhibit

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[115] Chamberlain Group, Inc. v. SKYLINK Techs., Inc., 381 F.3d 1178 (5th Cir. 1999).
[116] *Id.*
[117] *See Id.* at 1201.
[118] QAD, Inc. v. ALN Associates, Inc., 770 F. Supp. 1261 (N.D. Ill. 1991).
[119] *Id.* at 1267.
[120] *Id.*
[121] *Id.* at 1265.
[122] Video Pipeline, Inc. v. Buena Vista Home Entertainment, Inc., 342 F.3d 191, 203 (3rd Cir. 2003).
[123] *e.g.*, *Id.* at 206; Neal Hartzog, *Gaining Momentum: A Review of Recent Developments*

licensee expression to such a degree that would constitute misuse, so the assertion of copyright was proper.[124]

In the Seventh Circuit, the case of *Assessment Technologies v. WIREdata* brought the copyright misuse issue to the bench.[125] Assessment Technologies contracted with municipalities to collect and organize property value data. When WIREdata tried to access this information the municipalities refused fearing they would be guilty of infringement. In the subsequent lawsuit the Seventh Circuit ruled that copyright did not protect the raw data and suggested Assessment Technologies may be guilty of copyright misuse because they claimed protection over something clearly not included in the copyright grant.[126] The court opined that copyright holders misuse their copyrights when they improperly assert their rights over defendants who lack the resources to resist.[127]

Taken together these cases show a growing trend for adoption of the misuse defense in the area of copyright.[128] Indeed, the majority of circuits have recognized the copyright misuse defense in some form or another.[129] The cases summarized above describe the evolution of misuse as derived from the *Lasercomb* decision and applying a public policy rationale for the defense. The Supreme Court has yet to decide that misuse is a valid defense, and several circuits still premise misuse on a showing of anticompetitive behavior contrary to the *Lasercomb* decision.[130] However, predominate thinking reflects the ideas of *Lasercomb* that misuse can exist separately from antitrust violations and is a flexible doctrine.[131] Under this interpretation the key inquiry is whether a plaintiff has used his copyright in a manner counter to the public policies

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Surrounding the Expansion of the Copyright Misuse Doctrine and Analysis of the Doctrine in its Current Form, 10 Mich. Telecomm. & Tech. L. Rev. 373, 387 (2004).

[124] Video Pipeline, Inc. v. Buena Vista Home Entertainment, Inc., 342 F.3d 191, 206 (3rd Cir. 2003).

[125] Assessment Technologies of WI, LLC v. WIREdata, Inc., 350 F.3d 640 (7th Cir. 2003).

[126] *Id. at 647.*

[127] *Id.*

[128] Neal Hartzog, *Gaining Momentum: A Review of Recent Developments Surrounding the Expansion of the Copyright Misuse Doctrine and Analysis of the Doctrine in its Current Form*, 10 Mich. Telecomm. & Tech. L. Rev. 373, 391 (2004).

[129] Scott A. Sher, *In Re Napster Inc. Copyright Litigation: Defining the Contours of the Copyright Misuse Doctrine*, 18 Santa Clara Computer & High Tech. L.J. 325, 329-30 (2002) (collecting cases).

[130] *e.g., Id.* at 382; Victoria Smith Ekstrand, *Protecting the Public Policy Rationale of Copyright: Reconsidering Copyright Misuse*, 11 Comm. L. & Pol'y 565, 583 (2006); G. Gervaise Davis III, *The Affirmative Defense of Copyright Misuse and Efforts to Establish Trademark Misuse, and Fraud on the Copyright Office: Establishing Limitations on the Scope of Copyright Owners Rights Based on Several Theories*, 867 PLI/Pat 103, 126 (2006).

[131] *See* Neal Hartzog, *Gaining Momentum: A Review of Recent Developments Surrounding the Expansion of the Copyright Misuse Doctrine and Analysis of the Doctrine in its Current Form*, 10 Mich. Telecomm. & Tech. L. Rev. 373, 402 (2004).

underlying copyright law.[132] Given this definition, misuse should be available in cases where First Amendment interests are at stake.

III. THE CASE FOR COPYRIGHT MISUSE BASED ON FIRST AMENDMENT INTERESTS

As the Shloss v. Joyce case described in Part I makes plain, certain types of work cannot be created, or cannot be created well, without the right to quote the copyrighted works of others. A classic example is the case of someone writing a book review. The review cannot be as compelling or complete without the ability to use quotations from the work that is being reviewed. A paraphrase is simply not as convincing as a quotation. And, of course, if the book review is critical, then the author of the reviewed work likely will not want to give permission for the use of any quotations from the work. Likewise, documentaries, if they are to accurately reflect the world they are filming, will often contain bits and pieces of other people's copyrighted works. And again, critical analysis of a work cannot be done without liberal quotation from the work.

For these reasons the courts recognized an equitable right to fair use,[133] which was later codified by Congress.[134] Fair use gives content creators the right to use the copyrighted work of others "for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research . . . ." [135] If a content creator wants to use a copyrighted work for one of the purposes allowed by Section 107, then the content creator can do so without asking permission or even informing the copyright owner of the use. This all sounds well and good for the efficient allowance of socially-desirable uses of copyrighted works, but the devil is in the details. As has been extensively noted, the four-part test set out in Section 107 for determining whether something is fair use is famously murky, and subsequent case law has not helped to greatly clarify the question.

This puts would-be fair users in an untenable situation. The only way for them to know for sure that their use of copyrighted material is fair is to get a court declaration. The content creator may get a court ruling either by suing for a declaratory judgment, if she has the requisite actual conflict sufficient to meet the declaratory judgment standard, or by using the copyrighted work, getting sued, and having the court determine fair use at that time. Both of these options have obvious drawbacks. In the second case, if the use of each quotation from the copyrighted work is not deemed to be fair, then the user may be liable for copyright damages,[136] and perhaps attorneys' fees.[137] While a user who meets the requirements for bringing a declaratory judgment action may do so and avoid the possibility of damages, the action itself is likely to be quite expensive, and can be made even more so if the copyright holder contests that the jurisdictional requirement for a declaratory judgment action has been met, as did the Joyce Estate in Shloss v. Joyce.

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[132] Lasercomb America, Inc. v. Reynolds, 911 F.2d 970, 978 (N.C. 1990).
[133] [Insert seminal case(s) @]
[134] 17 U.S.C. § 107.
[135] 17 U.S.C. § 107.
[136] 17 U.S.C. § 504.
[137] 17 U.S.C. § 505.

The user of the copyrighted work will have to hire attorneys, file a complaint, withstand any jurisdictional challenge, deal with any discovery the court allows, and then file papers parsing each use of a copyrighted work, and the reasons the use qualifies as fair. Such cases can easily reach six figures in attorneys' fees on each side.

All of this means that aggressive copyright holders can hold the threat of litigation over the heads of potential users to get them to desist from using copyrighted material, or to make them use it only in ways acceptable to the copyright holder. While it is true that to actually litigate a fair use dispute is costly for both sides, it is nearly costless for the copyright holder to threaten suit, or simply to leave the potential user in fear of suit. This tactic is precisely the one used by the Joyce Estate against Shloss and many other scholars, and that has been used by other copyright holders against would-be users of their copyrighted works. Moreover, even if the user sues the copyright holder to have the right to fair use judicially determined, the copyright holder can at that point simply covenant not to sue and walk away from the entire suit with very little cost to itself.[138]

Thus, preventing fair use of copyrighted work can be done quite easily and nearly costlessly by a determined copyright holder. This is especially the case when the potential user is an academic, a typical documentary maker, or any other content creator who is not wealthy enough to absorb the cost of an infringement litigation. In fact, even parties with deep pockets can be intimidated from pursuing fair use. For a typical book publisher, film distributor, music distributor, or the like, the hassle and cost of defending a copyright litigation based on fair use can turn a profitable project into an unprofitable one, or at least into one that is not worth the trouble.[139] Moreover, there is an argument that if using numerous quotations based on fair use would likely draw an infringement suit, then a corporate publisher is obligated by its profit-making duty to shareholders not to make the fair use and risk the suit.

Not only can a copyright holder threaten suit even in the face of a strong fair use argument, the copyright holder can do so for reasons having nothing to do with copyright. Thus, a copyright owner may threaten due to privacy concerns, disagreement with the point the writer is making, dislike of the topic, dislike of the speaker, desire to exert editorial control, etc.[140] There seems to be little under current law to restrict copyright owners who seek to vindicate non-copyright interests through the use of copyright threats. Thus, even though the right of privacy does not apply to dead people in the

[138] This tactic was used by the Joyce Estate in Shloss v. Joyce. The Estate first issued a covenant not to sue that covered some, but not all, of Shloss's website. Then the Estate moved to have Shloss's case dismissed as not meeting the requirements for a declaratory judgment as to the portion of the website not covered by the covenant. When the court denied the Joyce Estate's motion, after considerable effort and expense for both sides in terms of briefing and arguing the motion, the Estate then announced to the Court that if the case did not settle at the scheduled mediation, the Estate would file a complete covenant not to sue and have the case dismissed.

[139] This is, in fact, what happened in Shloss v. Joyce. Once the Joyce Estate contacted Shloss's publisher and threatened to enforce its legal rights if Shloss's book was published, the publisher then cut numerous quotations from the book.

[140] Indeed, the Joyce Estate is reputed to have withheld permissions or threatened copyright enforcement for each of these reasons at one time or another.

United States, many literary estates openly assert their copyrights as means of protecting the privacy of now-deceased writers and artists.

This is a particular problem for scholars seeking to use unpublished letters written by public figures. Instead of having to contend with American privacy law and the balancing that American law has sought to achieve between the interests of the party asserting privacy and the interests of the person seeking to publicize facts, copyright estates can simply protect their privacy interests (or those interests they assume the now-dead author would have) by threatening copyright litigation to stop even clear fair use. The use of copyright to protect privacy interests can be particularly egregious when the privacy interest being asserted is actually that of a child or grandchild who might be embarrassed by certain information about a parent or grandparent. In some of these cases the parent or grandparent author may not have been bothered by the release of unpublished letters, or by provocative analyses of the author's work. It is due to just such thorny issues regarding the will of the deceased, and a respect for the need to be able to discuss important persons, that American privacy law refuses to protect the privacy of the deceased. Thus, estates of deceased artists that use copyright to protect privacy, are actually making an end-run around privacy law. They are using copyright to prevent rather than to encourage the creation and distribution of writings. Because this end-run does not serve any copyright purpose, some remedy should be had against those who make it. Remedies should likewise exist against those who seek to use copyright law to take editorial control of another's work or to cut off certain lines of inquiry in another's work.

The best remedy for such behavior is to allow fair users of copyrighted works who are threatened to assert claims of copyright misuse. This would give the fair user more than the expensive and porous shield of fair use, it would arm her with a sword as well. By allowing those defending copyright claims to assert misuse for disallowed behaviors, the landscape would be shifted so that copyright holders too would now have some potential downside if they excessively assert their copyrights. Such a shift would make some egregious copyright abuses more timid, and would make some fair users a bit bolder.

IV. POSSIBLE REMEDIES FOR COPYRIGHT MISUSE.

[This section to be determined]

[Loss of Copyright for specified period]

[Uneforceability of copyright against specific persons or specific works]

[Compulsory license]