Legally Speaking -- Fair Use and The Common Law of Copyrights

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Cases of Note
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Rolex carried all the factors of the Polaroid test. Since the marks were registered, there’s a presumption of arbitrary or suggestive or to have acquired secondary meaning. See Arrow Fastener Co., Inc. v. Stanley Works, 59 F.3d 384, 393 n. 6 (2d Cir. 1995). And Rolex advertised heavily and kept the quality of its product first rate. All that adds to strength.

Jones used the Rolex and Polo marks and sold in the same markets. There is a big history of counterfeit Rolexes causing confusion.

Indeed, many people I know go out to bars wearing fake Rolexes with no purpose other than to create confusion. And to find true love at closing time.

God-awful Bad Faith

True, Jones’ website says his are replicas, and that “[by] purchasing one of these replicas, the buyer[s] agrees not to sell or represent them as genuine.”

You can see the bar scene. “Sorry, li’l dawg. I’m bound by contract to confess here’s a fake piece of crap and I don’t have two nickels to rub together. All that aside, I got a pow’ful need for your love.”

Yes, that confession will not happen. So, we’ve got the old post-sale confusion which is just as bad under the Laudau Act as point-of-sale confusion. Nabisco Inc. v. PF Brands Inc., 191 F.3d 208, 218 (2d Cir. 1999).

Trademark Dilution


“Blurring” occurs when Jones uses or modifies the Rolex trademark on his goods “raising the possibility that the mark will lose its ability to serve as a unique identifier” of the Rolex product. Federal Express Corporation v. Federal Express, Inc., 201 F.3d 168, 175 (2d Cir. 2000).

Which is a pretty cute move by the espresso seller, even if an infringement.

And, of course, there are a bunch of elements: (1) senior mark must be famous; (2) must be distinctive; (3) junior use must be a commercial use in commerce; (4) must begin after senior mark has become famous; (5) must cause dilution of the distinctive quality of the senior mark. Nabisco Inc. v. PF Brands, Inc., 191 F.3d 208, 215 (2d Cir. 1999).

And Jones rang the bell on each and every one.

And Rolex can take a breather until the next fraud comes along.

Legally Speaking — Fair Use and The Common Law of Copyrights

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To paraphrase Shakespeare, “He who steals my purse steals trash, but he who steals my good words makes me poor indeed.” The Federal Copyright Statute, state statutes, and the common law protect the use of an individual’s words. Authors, publishers, and librarians need to be aware of some significant differences between the Federal copyright statute and the common law of copyrights. This article will discuss the Fair Use of materials that have not been formally copyrighted under the Federal copyright statute, but which qualify for copyright protection under state common law. These materials include ideas, conversations, letters, unpublished manuscripts, lectures and lecture notes, etc. In my column in the next issue of Against the Grain, I will delve more deeply into the copyright laws pertaining to unpublished manuscripts, lectures and lecture notes.

There is no Federal common law of copyrights; instead, common law copyright is a function of state laws and can therefore vary from state to state. This discussion of common law copyright will cover some basic principles in a general way rather than dealing with the laws of specific states. However, most of the principles that I will discuss exist in the majority of jurisdictions.

The Relationship between State Common Law and the Federal Copyright Statute: Has State Law been Pre-empted?

One issue that needs to be addressed in dealing with copyright is the relationship between the statutory law and the common law. Sometimes when a Federal statute is passed, the Federal laws occupy the field so completely that the states lose the ability to create law in that area. This is called Federal pre-emption. A recent example of an area in which the Federal law has pre-empted the states is the area of security for passenger airports and passenger airlines. The states no longer have the ability to create security laws for airports, the Federal government now enacts all airport security laws.

Most scholars do not believe that the Federal statute has totally pre-empted state copyright law. According to Section 103(b) of the Copyright Act: “Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to subject matter that does not come within the subject matter of copyright as specified by Sections 102 and 103, including works of authorship not fixed in any tangible medium of expression.” The same section of the Federal copyright statute goes on to say that common law and state copyright law apply to “activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by Section 106.” The prevailing interpretation of Section 103(b) has been that Congress did not totally pre-empt common law copyright, and that the rights granted by the common law can coexist with the rights granted by the statute.

Common Law Copyright and the Fair Use Doctrine

Although the copyright laws prohibit the reproduction of copyrighted works, there is a provision for limited copying known as “Fair Use.” Fair Use allows us to make reproductions for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research. This applies to both published and unpublished works under the Federal copyright statute.

Fair Use is a defense that can be used when an individual has been accused of copyright infringement. Because the Fair Use doctrine is based on the Federal copyright statute rather than on common law, there have been several cases which indicate that there is no such thing as Fair Use under the common law. These cases suggest that the Fair Use only applies to the Federal copyright statute.

In the debate over common law Fair Use, the case that is most often cited is Stanley v. CBS. The Stanley case involved the idea for a radio show that was submitted to the net.

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work by the plaintiff. Although Stanley's idea did not fall under the protection of the Federal copyright statute, the idea was covered by state common law copyright. The plaintiff had created an original work of authorship, had fixed the work in a tangible medium, and had shown his idea (in the tangible medium) to the broadcasting company. The company claimed that the abstract idea was not worthy of protection. According to the dissenting opinion:

Abstract ideas are common property freely available to all. What men forge out of these ideas with skill, industry, and imagination, into concrete forms uniquely their own, the law protects as private property. It gives the special form the stamp of recognition; it does so to stimulate creative activity. It does something more to stimulate creative activity: it assures all men free utilization of abstract ideas in the process of crystallizing them in fresh forms. For creativeness thrives on freedom; men find new implications in old ideas when they range with open minds through open fields.

Although the California Supreme Court did not mention the term "Fair Use," the ability to apply abstract ideas is one of the basic principles of the Fair Use Doctrine. However, the majority opinion did not agree with the concept that abstract ideas are available for anyone. According to the majority opinion:

[Stanley] did not write a story or a play. He does not claim originality in the handling of any dramatic plot. He does claim to have originated a plan for a radio program, and to have written and recorded the formal script for the proposed program. Such a plan, together with its script, if truly original, may constitute a protectible [sic] "product of the mind" [quoting California Civil Code, § 980].

In effect, the Court stated that the "abstract idea" itself was protected by the common law. Under the statute, using such an "abstract idea" would constitute Fair Use. As a result of the Stanley decision, there are many questions about the status of the Fair Use doctrine in common law. The treatise Nimmer on Copyright states that "[A] minimal amount of copying falling short of substantial similarity does not constitute an infringement of common law copyright." However, there is only one case cited which maintains that there is a right of Fair Use for common law copyrights. This case is Hemingway v. Random House, Inc. In the Hemingway case, author A. E. Hotchner wrote a book entitled Papa Hemingway: A Personal Memoir. The book included the text of many conversations between Hotchner and Hemingway, as well as quotations from some of Hemingway's writings. Hemingway's widow and his estate sued Hotchner and the publisher, Random House. The suit contended that the book violated Hemingway's common law copyright and constituted unfair competition with the works of Ernest Hemingway. In this case, the court was specifically concerned with the common law copyright given to unpublished works. The plaintiffs claimed that "65% of the contents of Papa Hemingway" consists of "literary matter created and expressed by Ernest Hemingway." The plaintiffs were talking about both the published words of Hemingway from his books, and the unpublished conversations that the author had with Hemingway. (In effect, the plaintiffs were claiming that every time Hotchner quoted Hemingway saying "good morning," the author was using Hemingway's words without permission.) The court was not persuaded by the
plaintiff’s argument, and stated in the opinion that: “In works of this nature, authors and publishers are not prohibited from making some use of quotations from the creations of others. Before an action may be maintained, there must be a showing of a significant appropriation of plaintiff’s property—significant both in volume and impact. In this regard, the Federal law of copyright and the State law of common-law copyright are in accord [citations omitted].”

The decision in the Hemingway case went on to discuss the concept of Fair Use. According to the opinion, “Where there is a mere minor use of fragments of another’s work, especially in historical, biographical, or scholarly works, such appropriation is characterized as a ‘fair use,’ and is permitted.” The Hemingway opinion also quoted the case of Rosemont Enterprises v. Random House. In the Rosemont case, the 2nd Circuit Court of Appeals stated that “Biographies, of course, are fundamentally personal histories and it is both reasonable and customary for biographers to refer to and utilize earlier works dealing with the subject of the work and occasionally to quote directly from such works. This practice is permitted because of the public benefit in encouraging the development of historical and biographical works and their public distribution.” [citations omitted]

Recently there have been some suggestions that Fair Use is actually a constitutional principle, and therefore applies to common law state copyright law as well as to the Federal copyright statute. The Hemingway court considered the constitutional status of Fair Use in the context of unpublished and unprepared conversations, since one of the Plaintiff’s claims was that Ernest Hemingway’s conversations were subject to common law copyright. According to the Hemingway opinion:

Were anyone to have common law copyright in his mere conversations (as opposed to prepared lectures or speeches), then the same right would have to extend to everyone. The effect on the freedom of speech and press would be revolutionary. It is a basic tradition of our society that, subject to certain limits not here pertinent, what any man says or does may be reported, quoted or written about in the interest of maintaining the freedom of access to all kinds of information which may be of legitimate interest. It is generally left to writers and publishers to determine what is of such interest. Only in rare cases does the law interfere with the freedom, and then only to protect some paramount interest, such as the national security, or the individual’s right to be free from malicious falsehood or invasion of privacy. The limitation drawn to protect such interests have [sic] generally been as narrow as the courts could make them.

The constitutional arguments in favor of Fair Use do not apply only to the area of common law copyright. Several cases have dealt with the constitutional issue within the context of statutory copyright. One decision that discussed the constitutional background of Fair Use was the “Betamax case,” Sony Corporation of America Et Al v Universal City Studios, Inc. The Sony case involved the question of whether VCRs were legal and whether viewers—without violating copyright—could legally record TV programs on a VCR in their own homes for their own use. The U.S. Supreme Court decided that VCRs are indeed legal. The Court used as its basis the doctrine of Fair Use continued on page 63

1. The correct quote is:
   Good name in man and woman, dear my lord.
   Is the immediate jewel of their souls:
   Who steals my purse steals trash; 'tis something, nothing:
   'Twas mine, 'tis his, and has been slave to thousands;
   But he that filches from me my good name
   Robs me of that which no enriches him
   And makes me poor indeed.
   —Iago in Othello, Act III, sc. 3, line 158-61.
   Available online at http://www.nytimes.com/samuelson/copyright/beyond/articles/public.html. See also, Quote from Nimmer on Copyright.
   3. 17 U.S.C. §103(b)(1). See also, Samuels at 139.
   9. The copyright law protects "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. §102.
   10. Stanley, Dissenting Opinion by Justice Traynor at 672-73.
   15. Hemingway at 464.
   25. Luther R. Campbell AKA Luke Skywalker, Et Al., v. Acuff-Rose Music, Inc., 510 U.S. 569; 114 S. Ct. 1164; 127 L. Ed. 2d 500 (1994). But cf. Harper & Row v. Nation Enterprises, 471 U.S. 539; 105 S. Ct. 2218; 85 L. Ed. 2d 588 (1985). (“[T]here was no basis in the First Amendment for a rule giving the fair use doctrine broader scope in cases involving a public figure’s manuscript, and, . . . the second magazine’s article was not a ‘fair use’ of the manuscript, in view of its intended commercial purpose of supplanting the copyright holders’ valuable right to control first publication, the unpublished nature of the work, the central importance of the quoted expressions in the memoirs and in the article, and the adverse impact of the article on the contract with the first magazine and on the marketability of first serialization rights in general.”)
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and the First Amendment. According to the Sony case, “the purpose of this use served the public interest in increasing access to television programming, an interest that is consistent with the First Amendment policy of providing the fullest possible access to information through the public airwaves.”  
[Citation omitted]  
The Supreme Court has also found that parody, which is protected by the First Amendment, is allowed by the Fair Use doctrine. According to Professor David Lange of Duke Law School, “Fair use gives the Constitution breathing space between the limits on expression inherent in copyright, and the freedom of expression guaranteed by the First Amendment.” This quotation is actually an application of Professor Lange’s thesis, since it came from a lecture covered by state common law copyright. While I would not be able to quote Professor Lange under the Stanley case, one of the main points of Professor Lange’s presentation was that there is a constitutional problem with a view of copyright so strict that reasonable quotations are not allowed. Under the Hemingway case, the protections of Fair Use still exist even though the copyright is common law rather than statutory.

Summary

The common law of copyright is an area about which most people are not immediately concerned. Although most common law copyrights now fall under the Federal statute, many copyrights can still be protected under both federal law and the common law. For some issues, the common law may give even greater protection. Certainly the Federal statute has not totally preempted the field of copyright law.

Although there is some discussion of whether the Fair Use doctrine is available as a defense under common law copyright, many scholars and courts feel that Fair Use is included in the common law. Some researchers even believe that the First Amendment constitutionally requires the principles embodied in the Fair Use Doctrine. These scholars believe that Fair Use comes under the Freedom of Expression clause, and that denial of Fair Use in a courtroom would amount to a governmental denial of free expression.

The Stanley and Hemingway cases point out only a few of the potential problems with common law copyrights. If the Federal Copyright Statute does not apply (when materials are unpublished and not covered by Federal copyright law), then the courts must decide whether state common law copyright applies and whether the Fair Use Doctrine applies. Ernest Hemingway once said that “I only know that what is moral is what you feel good after and what is immoral is what you feel bad after.” After reading this article, you should have some tools other than your own feelings to help you analyze the status of Fair Use for works protected under common law copyright.

Questions & Answers — Copyright Column

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QUESTION: A colleague at my university is publishing a textbook. She is planning to use samples of folktales, poetry, etc., and is in the process of getting permission. Should she be unsuccessful in obtaining permission, she wants to substitute works that are in the public domain. The library has located some examples of fairy tales and poetry that were published well before 1923 but the anthologies in which they appear were published later, some as far back as the 1940s but many in more recent compilations. Is the date of the anthology the relevant date?

ANSWER: No, the critical date is the date of first publication of the poem or tale. Reproduction in a new anthology does not change the underlying copyright date for the individual piece. On the other hand, anthologies are copyrighted, but the copyright is in the compilation and not in each individual piece. Additionally, the anthology copyright covers any new materials added such as a new preface, editorial comments and the like.

QUESTION: A work for an online news service produces abstracts of copyrighted articles and stores and publishes them online. Does a content owner have any legal grounds on which to prohibit abstracts of that content, whether the work is available online or in print? Does it make a difference that the news service is provided free and for non-commercial purposes plus includes appropriate attribution of the original source? Could the service simply include a link to the site on which the item originally appeared even if access to some of these requires a subscription fee?

ANSWER: Abstracts that are condensations or relatively full summaries of the contents of a copyrighted work probably do require permission since they are derivative works by being summaries or condensations of the original work. If, however, the abstract is merely descriptive of the contents, then there is no problem. For example, “This article discusses these four topics, has a chart on X that appears on page Y, and is written by this expert.”

To link to an online article that the news service abstracts, no permission is required under the conditions described in the question. The fact that the online news service is not for profit is very important. The fact that a link to the content on a publisher’s webpage requires a password in order to access to the content is no problem. Many such lists of links include password protected ones; the user at least knows the item is online and then can decide whether to subscribe in order to obtain the full-text content.

QUESTION: Now that the library is receiving many CDs that accompany books, is there a problem with making backup copies to keep in technical services for replacement should the originals disappear from the back of the books? The practice has been to make copies of disks that accompany books, place the copies with the books and keep the original disks as archival copies. Since these copies are not for general distribution, but rather as a safeguard in case of loss, is this fair use?

ANSWER: Although some libraries have routinely made backup copies of many types of sonprint works, the statute is clear. One may make a backup copy only of computer programs without permission from the copyright holder. Other materials have no backup copy provision. Software is covered by section 117 of the Copyright Act, but it is limited to computer programs.

A library certainly could seek permission for duplicating CDs as a way to guard against accidental loss or destruction.

QUESTION: A faculty member who teaches a number of music courses in which the students have to listen to a wide

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