

2015

Legally Speaking--Google Books: It Ain't Over 'til the Librarian Sings

William Hannay

Schiff Hardin, LLP, whannay@schiffhardin.com

Bryan M. Carson

Western Kentucky University, bryan.carson@wku.edu

Jack Montgomery

Western Kentucky University Libraries, jack.montgomery@wku.edu

Bruce Strauch

The Citadel, stauchb@citadel.edu

Follow this and additional works at: <https://docs.lib.purdue.edu/atg>



Part of the [Library and Information Science Commons](#)

Recommended Citation

Hannay, William; Carson, Bryan M.; Montgomery, Jack; and Strauch, Bruce (2015) "Legally Speaking--Google Books: It Ain't Over 'til the Librarian Sings," *Against the Grain*: Vol. 27: Iss. 6, Article 22.

DOI: <https://doi.org/10.7771/2380-176X.7235>

This document has been made available through Purdue e-Pubs, a service of the Purdue University Libraries. Please contact epubs@purdue.edu for additional information.



LEGAL ISSUES



Section Editors: **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>
Bryan M. Carson, J.D., M.I.L.S. (Western Kentucky University) <bryan.carson@wku.edu>
Jack Montgomery (Western Kentucky University) <jack.montgomery@wku.edu>

Legally Speaking — Google Books: It Ain't Over 'til the Librarian Sings

by **William M. Hannay**¹ (Partner, Schiff Hardin LLP, Chicago, IL) <whannay@schiffhardin.com>

On October 16, 2015, the U.S. Court of Appeals for the Second Circuit handed down its opinion dismissing the **Authors Guild's** copyright case against **Google Inc.**² What does it all mean for librarians?

History of the *Google Books* case

Let's make a quick trip through the history of this long-running litigation. It all began in 2004 when **Google** announced the initiation of its "Google Print" project and its "Library Project" (now generally called "Google Books"). A few months later in 2005, the **Authors Guild**, several individual authors, and various publishers filed a lawsuit in New York City against **Google**, seeking to enjoin the project from going forward.

As litigation sometimes does, the proceedings began to drag out as the parties filed various motions with the court and engaged in preliminary investigations (known as "discovery"). The parties also began negotiations over a possible settlement in 2006. After extended discussions, the parties filed a proposed settlement agreement on October 28, 2008. Notice of the proposed settlement was widely circulated and produced hundreds of objections. The parties then modified the proposal and, on November 13, 2009, filed a proposed Amended Settlement Agreement with the trial court.

After notice of the amended settlement was circulated in early 2010, another flood of objections was filed, including one from the U.S. Department of Justice which alleged that, if the proposed settlement was adopted, substantial anticompetitive effects would result. On March 22, 2011, U.S. District **Judge Chin** rejected the amended settlement as not "fair, adequate, and reasonable."

The parties went back to the drawing board but were unable to reach a settlement that was likely to pass muster with the court. So the case resumed its litigation posture, and on May 31, 2012, **Judge Chin** certified a class of plaintiff-authors and allowed them to proceed to trial.³ But a little over a year later, the U.S. Court of Appeals for the Second Circuit vacated the class certification and ordered **Judge Chin** to consider whether or not **Google** had a legitimate "fair use" defense. He did so, and on November 14, 2013, **Judge Chin** granted summary judgment to **Google** on its fair use defense.

The **Authors Guild** filed an appeal which, almost two years later in October 2015, resulted in affirmance of the District Court's judgment.

Where Are We Now that the Case is Over?

Is it actually over? Plaintiffs could possibly file a petition for a writ of certiorari with the U.S. Supreme Court, but the likelihood of the Court accepting the case for review — and actually reversing it — seems low.

But the truth of the matter is that, assuming the case is over, the legal result of the case is both extremely sweeping and at the same time extremely narrow. While millions of individual books have been copied and made part of the Google Books project, all that the Second Circuit has approved are the narrow word search and "snippet" features of the project. The court's opinion is limited to this specific conduct, and there is no court authorization for **Google** to do anything more than that.

On a book-by-book basis, therefore, very little of the works are actually made available to users of the system.

A Reminder of what *Google* is doing

Google has made digital copies of millions of books that were submitted to it for that purpose by major libraries. Over 20 million have been scanned since 2004 (at an average cost of \$10 per book). In turn, **Google** has established a publicly-available search function for the digital copies.

Specifically, an Internet user can use this function to search — without charge or advertising — to determine whether the book contains a specified word or term. The result of the search is that the user can see "snippets" of text containing the searched-for terms.

In addition, participating libraries (i.e., those that have made their books available to **Google** for scanning) are given a limited right to download and retain digital copies of the books that they submitted.

Google's Search Function is Quite Limited

The search function in Google Books is quite limited. Only the first usage of the searched-for term on a given page is displayed, for example. Overall for each book containing the search term, a maximum of three "snippets" containing the term are displayed. (A snippet is a horizontal segment comprising ordinarily an eighth of a page highlighting the term.)

It appears that the Google Books system cannot be fooled into providing more quotations. In particular, a researcher cannot increase the number of snippets revealed on the system simply by repeating the entry of the same search term or by entering searches from different computers.

Moreover, one snippet per page and one page out of ten containing the term are randomly "blacklisted" by **Google** and cannot be displayed. Further, no snippet views of certain books such as dictionaries, cookbooks, and short poems are permitted.

The Second Circuit's Ruling

In analyzing "fair use," the Court of Appeals applied the four-part statutory test contained in Section 107 of the *Copyright Act of 1976*. That *Act* provides that in determining whether a use is "fair," the factors to be considered must include:

- (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.

Focusing heavily on the first factor (i.e., the purpose and character of the use), the Court of Appeals upheld **Google's** making of a digital copy to provide a search function as fair use because it is "transformative." It augments public knowledge by making available information *about* authors' books. By contrast, **Google** does not provide the public

continued on page 50

with a substantial “substitute” for the substance of the matter protected by the authors’ copyrights in the original works. The same is true, at least under present conditions, of Google’s provision of the “snippet” function. The search tool permits a researcher to identify those books, out of millions, that do – as well as those that do not — use the terms selected by the researcher.

While **Google** is a for-profit entity, the court held that profit motivation does not in these circumstances justify denial of fair use. In any event, **Google** does not charge for the search and snippet functions. (Whether a court might view matters differently if **Google** were to attempt to monetize these services by charging for them is a question for another day.)

Legal Precedent: *Campbell v. Acuff-Rose Music*

The Second Circuit devoted considerable attention to interpreting the Supreme Court’s 1994 decision on fair use in *Campbell v. Acuff-Rose Music*.⁴ There, a music group called “2 Live Crew” recorded a parody of **Roy Orbison’s** 1964 hit “Pretty Woman” without obtaining a license. The rights holder had sued and lost before the District Court, but won a reversal before the Court of Appeals for the Second Circuit. The appellate court held that the commercial nature of the parody rendered it presumptively unfair under Section 107. The Supreme Court disagreed, however, and reinstated the trial court’s dismissal of the claim. The Court held that a commercial parody may be fair use if it is “transformative.”

A Caveat Re: “Transformative”

Following the Supreme Court’s reasoning in *Campbell*, the Second Circuit held that **Google’s** use of the copied books was transformative. However, the court issued a strong caveat narrowing the reach of that defense. Speaking for the court, **Judge Pierre Leval** (who is considered something of an expert on copyright law) stated:

“The word ‘transformative’ cannot be taken too literally as a sufficient key to understanding the elements of fair use. It is rather a suggestive symbol for a complex thought, and does not mean that any and all changes made to an author’s original text will necessarily support a finding of fair use.”

Derivative Works and “Transformations”

Last year, the Second Circuit had given narrow approval to libraries’ pooling of the digital copies of their books provided to them by **Google** after scanning. Some 80 universities and libraries had submitted over ten million digitized books into the **HathiTrust** repository which permits patrons to search for files for particular terms (but does not provide snippets). Patrons with print disabilities (such as blindness) are provided full-text access to the books.

In its 2014 *HathiTrust* decision,⁵ the Second Circuit distinguished between “derivative works” (which are not entitled to a “fair use” defense) and transformative works (which may be). The court said that “[p]aradigmatic examples of derivative works include the translation of a novel into another language, the adaptation of a novel into a movie or play, or the recasting of a novel as an eBook or an audiobook.” In *Google Books*, the court explained that, “[w]hile such changes can be described as transformations, they do not involve the kind of transformative purpose that favors a fair use finding.”

The Key to *Google Books* is the Limited Nature of *Google’s* Use

The court perceived that the specialized use by **Google** of the copyrighted work distinguished it from unfair and improper uses. By asking solely whether the work contains a word of interest, **Google’s** search function in effect treats the book as a mere compilation of data rather than exploiting its expressive content. The following quotes from *HathiTrust* and *Google Books* illustrate this perspective:

“[T]he result of a word search is different in purpose, character, expression, meaning, and message from the page (and the book) from which it is drawn.” — *HathiTrust*

“[T]he purpose of **Google’s** copying of the original copyrighted books is to make available significant information about those books.” — *Google Books*

This transformation is made greater by the “snippet” function, in the court’s view. “Snippet view adds important value to the basic transformative search function.”

“Merely knowing that a term of interest appears in a book does not necessarily tell the searcher whether she needs to obtain the book, because it does not reveal whether the term is discussed in a manner or context falling within the scope of the searcher’s interest.”

For Transformation, *Google* Needed to Copy the Whole Book

In order to achieve these transformative search functions, **Google** needed to copy the whole book. But importantly, though **Google** in effect makes an unauthorized digital copy of the entire book, it does not reveal that digital copy to the public. The amount and substantiality of what is made accessible to a public is very limited.

Google has constructed the snippet feature in a manner that substantially protects against its serving as a substitute for authors’ books. In the court’s words:

“**Google** safeguards from public view the digitized copies it makes and allows access only to the extent of permitting the public to search for the very limited information accessible through the search function and snippet view. The program does not allow access in any substantial way to a book’s expressive content.”

Recall that *Google* Tried to Get a Lot More than This.

The actual use made of the copyrighted works is far narrower than **Google** envisioned a decade ago. Consider the failed 2009 amended settlement: it would have allowed **Google** to make substantially more extensive use of its scans of copyrighted books than the current arrangement. There, **Google** sought the right to:

- (1) sell subscriptions to an electronic books database;
- (2) sell online access to individual books; and
- (3) sell advertising on pages from books.

The amended settlement (if it had been approved) would have effectively granted **Google** a monopoly over digital books, and, in particular, orphan books.

But none of these uses exist in the current arrangement.

Libraries’ Use of Their Digitized Books is as Restricted as *Google*

Reading *HathiTrust* and *Google Books* together, it is clear that the participating libraries must use their digital copies to enable only the kinds of searches that the Second Circuit has held to be fair uses in connection with **Google’s** offer of such searches to the Internet public: i.e., word searches and snippets.

Libraries may not freely disseminate or allow patrons to access the full-text of digital copies and defend by claiming “fair use.” (Only the narrow category of print-disabled patrons may have access to the full text of the digitized books.)

Can Libraries Be Liable for Copyright Infringement?

With respect to the digital copies that **Google** has created (and returned to them), if libraries were to misuse them in an infringing manner, those libraries may be liable to authors for copyright infringement.

Also, libraries might incur liability by negligent mishandling of, and failure to protect, their digital copies, leaving them unreasonably vulnerable to hacking.

A Musical Aside

All this suggests to me a **Rodgers & Hart** song from their 1940 musical *Pal Joey* (which I have “transformed” for fair use purposes):

If they asked me, I could scan a book,
That you could read upon a Kindle or Nook.
You could search the preface inside and out
So you’d know what data’s about.
And the simple secret of the plot
Is just to limit what we disclose a lot.
Then the world discovers as our case ends
On what our fair use law depends.



continued on page 51

Now it's Your Turn to Talk ...

It is important to hear from librarians about Google Books, because in the end, the essential question to be answered is whether the Google Books project has been worth all the effort to create it (and to fight about it). So, I would like to know what you have to say on the following questions:

Is Google Books being used by libraries and library patrons in a productive (and proper way)?

Is the world (at least the library world) a better place for its creation?

Share your answers with the author at <whannay@schiffhardin.com>. 🌱

Endnotes

1. **Mr. Hannay** is a partner in the Chicago-based law firm **Schiff Hardin LLP** and an Adjunct Professor at **IIT/Chicago-Kent** law school. He is a regular speaker at the **Charleston Conference** and a contributor to *Against the Grain*.
2. *Authors Guild et al. v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015).
3. On October 4, 2012, the **Association of American Publishers** and **Google** announced that they had settled the publishers' part of the Google Books litigation. See <http://www.publishers.org/press85/>. The settlement provides access to publishers' in-copyright books and journals digitized by **Google** for its Google Library Project. Other terms — including monetary payments, if any — were not disclosed.
4. 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994).
5. *Authors Guild v. HathiTrust*, 755 F.3d 87, 95 (2d Cir. 2014).

Cases of Note — Register Your Copyright Without Delay

Column Editor: **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>

LA RESOLANA ARCHITECTS, PA. V. CLAY REALTORS ANGEL FIRE AND ANGEL FIRE HOME DESIGN. UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT. 416 F.3d 1195; 2005 U.S. App. LEXIS 15319.

This is about that oddity of the author having copyright when the work is fixed in a tangible medium but having to register before suit can be brought.

La Resolana Architects met with **Clay Realtors** to discuss building townhouses at the famous Angel Fire, New Mexico ski resort. Architectural drawings were shown that were done specifically for the site, but no agreement was reached. This was in 1996-97.

In 2003, an architect from **La Resolana** was at the site and noticed a very similar set of townhouses being sold by **Clay**. Teeing up for a lawsuit, **La Res** applied to register their copyright, sent in apps, fees, etc. Before confirmation of the registration, **La Res** filed suit.

Clay moved for dismissal because **La Res** lacked a certificate of copyright registration. **La Res** replied all the stuff had been received, and copyright was approved for registration on Jan. 22, 2004.

Why do lawyers do these kind of delaying things? Do they imagine the other side will get bored and go away?

The district court held for **Clay**. And up we go to the Tenth Circuit.

So which is it?

Subject matter jurisdiction gives a court power to adjudicate a case. The **1976 Copyright Act** merged a confusing mix of state and federal law into a single and exclusive Federal system. All state law was preempted.

Protection was made easier by granting it the moment an original idea “leaves the mind” and is put into a tangible medium. See 17 U.S.C. § 102(a) (“Copyright protection subsists ... in original works of authorship fixed in a tangible medium”).

Registration

Registration is simple. Provide a copy of the work, an application and a fee. The Register of Copyrights then checks the work to determine if it is copyrightable. If it is, then “the Register shall register the claim and issue to the applicant a certificate of registration.” 17 U.S.C. § 410(a).

But the protection is always there from that moment of tangible medium. “[R]egistration is not a condition of copyright infringement.” 17 U.S.C. § 408(a). In fact, registering is entirely voluntary.

But if you want to sue ...?

The big benefit of registering is you are allowed to sue in federal court for infringement. 17 U.S.C. § 411(a). And the certificate of registration serves as prima facie evidence of the copyright's validity.

Now, about our case ...

“[N]o action for infringement of the copyright ... shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.”

And even if the registration has been refused, you may still sue with a copy of the complaint served on the Register of Copyrights. *Id.* 411(a).

The word “preregistration” was added in 2005. But this was not part of the statute when this action was filed.

Nothing in the language even suggests that receipt by the Copyright Office is sufficient. Registration is not automatic. It can be refused. You must have registration or refusal before filing suit. And you're trying to establish your prima facie case for copyright.

But despite the plain language ...

Gosh darn it, the courts are divided between the “Registration approach” and the

“Application approach.” The Registration approach can be found in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637, 640-41 (2d Cir. 1958). And there's the nice “the examination would be meaningless if filing and registration were synonymous.” *Robinson v. Princeton Review, Inc.*, 1996 U.S. Dist. LEXIS 16932.

But **Mel Nimmer** and various courts think application is sufficient. After all, the owner can sue whether the application is rejected or not. See **Melville B. Nimmer, Nimmer on Copyright**, Vol. 2 § 7.16[B][1][a], p. 7-154-56. See also, *Lakedreams v. Taylor*, 932 F.2d 1103, 1108 (5th Cir. 1991).

They note that an infringer can run amok while the Copyright Office sifts through piles of applications. The owner can sue and move towards a court date while waiting for the certificate.

And yet ...

Do you really need a paper certificate to sue? The fact of registration can exist before the certificate goes out. And it's the fact of registration that gives the court jurisdiction.

Nonetheless ...

The Tenth Circuit sticks with the registration requirement. The creative soul ought to get busy and register without waiting for someone to infringe.

Plus you could have the odd circumstance of presumption of validity upon application, then have the

certificate refused, and the presumption flips back.

And they affirm the dismissal of the complaint.

And the billable hours go up for lawyers. 🌱

