

First Amendment Constraints on Copyright After *Golan v. Holder*



Melville B. Nimmer Memorial Lecture, UCLA School of Law
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ABSTRACT

Each year, the UCLA School of Law hosts the Melville B. Nimmer Memorial Lecture. Since 1986, the lecture series has served as a forum for leading scholars in the fields of copyright and First Amendment law. In recent years, the lecture has been presented by many distinguished scholars. The *UCLA Law Review* has published these lectures and proudly continues that tradition by publishing an Article by this year's presenter, Professor Neil Weinstock Netanel.

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INTRODUCTION

In writing about copyright and the First Amendment, I stand on the shoulders of one particular giant among giants: Mel Nimmer. In 1970, Professor Nimmer published a path-breaking article in the UCLA Law Review entitled *Does Copyright Abridge First Amendment Guarantees of Free Speech and Press?*¹ In that article, Nimmer identified the tension between copyright and freedom of speech as “a largely ignored paradox.”² As he dramatically queried:

The first amendment tells us that “Congress shall make no law . . . abridging the freedom of speech, or of the press.” Does not the Copyright Act fly directly in the face of that command? Is it not precisely a “law” made by Congress which abridges the “freedom of speech” and “of the press” in that it punishes expressions by speech and press when such expressions consist of the unauthorized use of material protected by copyright?³

Golan v. Holder,⁴ decided in January 2012, marked the second time in a decade that the U.S. Supreme Court has had occasion to consider Professor Nimmer’s “largely ignored paradox.” On each occasion, the Court rejected a First Amendment challenge to a Copyright Act amendment that expanded copyright protection at the expense of the public domain. Indeed, the Court more than simply rejected the challenges. In both *Golan* and its predecessor *Eldred v. Ashcroft*,⁵ the Court ruled that even applying First Amendment scrutiny to those amendments was unnecessary and unwarranted.⁶

Not surprisingly, commentators sympathetic to the *Golan* petitioners have largely depicted the ruling as a “grave disappointment”—a far-reaching repudiation of First Amendment limits on Congress’s power to diminish the public domain.⁷ Yet *Golan* and *Eldred* impose potentially significant First Amendment

1. Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180 (1970).

2. *Id.* at 1181.

3. *Id.*

4. 132 S. Ct. 873 (2012).

5. 537 U.S. 186 (2003).

6. *Golan*, 132 S. Ct. at 890–91; *Eldred*, 537 U.S. at 219–21.

7. See, e.g., MSLEVINE, *Golan v. Holder*: In Praise of Breyer’s Dissent, MPUBLISHING BLOG (Jan. 25, 2012), <http://www.publishing.umich.edu/2012/01/25/Golan-holder-breyer> (referring to *Golan* as a “grave disappointment”); see also Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1, 11 (2013) (concluding that the Supreme Court’s ruling in *Golan* gives lower courts carte blanche to “mechanistically apply statutory language to infringement claims while turning a blind eye to independent First Amendment consideration”); Lyle Denniston, *From Plyler v. Doe to Trayvon Martin: Toward*

constraints on copyright protection even while granting fairly broad First Amendment immunity to Copyright Act amendments. They do so by effectively adopting Professor Nimmer's answer to the query he posed about the tension between copyright and the First Amendment.

Nimmer argued that the tension between copyright and the First Amendment can be satisfactorily resolved, even if it cannot be eliminated. His proffered solution was a method for balancing speech and non-speech interests that he labeled "definitional balancing."⁸ Nimmer found nascent examples of definitional balancing in then-recent Supreme Court decisions on the questions of whether the laws of libel, invasion of privacy, and obscenity constituted an abridgement of speech in violation of the First Amendment.⁹ As Nimmer described that methodological approach, a court considering whether a given law unconstitutionally abridges speech weighs the non-speech interests that the law aims to serve against the speech interests that the law burdens. Based on that assessment, the court then propounds generally applicable rules governing which types of speech may give rise to liability under the law in question and which must enjoy a First Amendment privilege.¹⁰

Following Nimmer's prescient analysis, courts have continued to employ some form of definitional balancing in imposing First Amendment constraints on private causes of action arising under a broad array of legal doctrines, ranging from common law defamation, invasion of privacy, and intentional infliction of emotional distress to federal trademark and wiretapping statutes.¹¹ They have held repeatedly that, while the private cause of action may generally make speech the gravamen of the specified tortious conduct, certain categories of speech enjoy absolute First Amendment immunity from the applicable civil liability. In such cases, the law in question must include limits and safeguards to avoid chilling the First Amendment-protected speech.

In that vein, Nimmer argued in his 1970 article that copyright law already contains a de facto definitional balance, a balance that acceptably accounts for both First Amendment interests and the economic motivation for creation that underlies copyright. Nimmer located that definitional balance primarily (although

Closing the Open Society, 69 WASH. & LEE L. REV. 1799, 1815–16 (2012) (stating that following *Golan*, "[t]he risk to an open society of creative expression is now beyond dispute"); cf. Jennifer E. Rothman, *Liberating Copyright: Thinking Beyond Free Speech*, 95 CORNELL L. REV. 463 (2010) (arguing that courts have firmly rejected scholars' calls for greater First Amendment scrutiny of copyright and thus that scholars need to proffer other constitutional limits on copyright).

8. See Nimmer, *supra* note 1, at 1184–93.

9. *Id.* at 1184.

10. *Id.* at 1184–85.

11. See *infra* notes 20–47 and accompanying text.

not exclusively) in the idea/expression dichotomy: the rule that copyright law does not preclude copying the ideas or facts contained in an author's work but rather accords authors exclusive rights only in the particular literal form in which they express their ideas.¹² Nimmer subsequently reasoned that the fair use privilege is also a vital safeguard for First Amendment interests within copyright law.¹³

In *Golan* and *Eldred*, I argue, the Court likewise recognized the idea/expression dichotomy and fair use privilege as the linchpins of copyright law's definitional balance: the internal doctrines that delimit certain categories of First Amendment-protected speech and impose constraints on copyright holder entitlements in order to avoid chilling that speech. Read together, the twin rulings set out a clear definitional rule to resolve the tension between copyright and the First Amendment. First Amendment scrutiny of copyright law is unwarranted so long as the idea/expression dichotomy and fair use privilege—what the Court describes in each ruling as copyright law's "built-in First Amendment accommodations"¹⁴—remain "undisturbed."¹⁵ But it is also by virtue of those built-in First Amendment accommodations that copyright law satisfies First Amendment scrutiny. Following *Golan* and *Eldred*, neither Congress nor the courts may eviscerate copyright law's idea/expression dichotomy or fair use privilege without running afoul of the First Amendment.

In setting out that definitional rule, *Golan* and *Eldred* serve to reinforce First Amendment limits on copyright in two principal ways. First, the twin rulings require that courts interpret and apply copyright law's "built-in First Amendment accommodations" in a manner that provides ample breathing space for First Amendment-protected speech. *Golan* and *Eldred*, I argue, bring the First Amendment to bear on copyright law much as courts have done in applying definitional balancing to the laws of defamation, intentional infliction of emotional distress, privacy, trademark, and other statutory and common law causes of

12. Nimmer, *supra* note 1, at 1189–93. Nimmer pointed to copyright's limited term and to the merger doctrine (the rule that copyright will not protect expression when it is the only means of expressing an idea) as additional First Amendment safeguards that contribute to copyright law's de facto definitional balance. *Id.* at 1193–1200.

13. Brief of the Gannett Co., Inc. et al. as Amici Curiae in Support of Respondents at 21, *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985) (No. 83-1632), 1984 WL 565765, at *21 [hereinafter Brief of the Gannett Co., Inc.].

14. *Golan v. Holder*, 132 S. Ct. 873, 890 (2012); *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003).

15. *Golan*, 132 S. Ct. at 890–91 (holding that heightened First Amendment review was unwarranted when the statute in question "leaves undisturbed the 'idea/expression' distinction and the 'fair use' defense").

action.¹⁶ In such instances, courts have repeatedly ruled that the First Amendment requires introducing or reinforcing free speech safeguards within those doctrines to avoid chilling “uninhibited, robust, and wide-open” debate on matters of public concern.¹⁷

Second, although *Golan* and *Eldred* upheld the Copyright Act amendments at issue before them, the twin rulings leave other provisions of the Copyright Act, as well as recently proposed legislation, vulnerable to First Amendment challenge. *Golan* held that the Copyright Act amendment before it was immune from First Amendment scrutiny because the amendment left the idea/expression dichotomy and fair use defense “undisturbed.”¹⁸ As interpreted by some lower courts, however, the Digital Millennium Copyright Act of 1998 (DMCA)¹⁹ prohibits circumventing digital encryption to gain access to expressive content even in order to engage in fair use. As *Golan* strongly suggests, that diminution of the fair use defense should raise serious First Amendment concerns. Further, proposed legislation that would impose broad liability on internet intermediaries for facilitating access to websites that contain infringing content would also stifle protected fair use and other non-infringing expression. *Golan* suggests, at the very least, that such provisions can and should be subject to First Amendment scrutiny to ensure that they do not unduly chill protected speech.

This Article proceeds in four Parts. In Part I, I set out the role and import of definitional balancing in First Amendment jurisprudence. Part II then briefly recounts the Supreme Court’s rulings on the First Amendment challenges in *Golan* and *Eldred*. Part III explicates how those twin rulings bear on judicial interpretation and application of the idea/expression dichotomy and fair use privilege. Part IV examines the potential First Amendment vulnerability of the DMCA’s anticircumvention provisions and of legislation that would impose broad liability on internet intermediaries without carving out protections for fair use and other noninfringing speech.

16. See the definitional balancing cases cited *infra* note 32.

17. See, e.g., *Snyder v. Phelps*, 131 S. Ct. 1207, 1215 (2011) (quoting *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 270 (1964)) (holding that the First Amendment protects picketing in a public place on a matter of public concern in a situation that would otherwise constitute intentional infliction of emotional distress).

18. *Golan*, 132 S. Ct. at 890–91.

19. Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended in scattered sections of 17 U.S.C.).

I. DEFINITIONAL BALANCING IN CONTEXT

As we have seen, Professor Nimmer sought to resolve the tension between copyright and the First Amendment through a method for balancing between speech and non-speech interests that he labeled “definitional balancing.”²⁰ As Nimmer described it, courts and commentators applying that method weigh the objectives and policy considerations that underlie the speech-burdening legal doctrine against those that underlie the First Amendment in order to set out generally applicable definitional rules governing which forms of speech the legal doctrine in question may constitutionally burden and which it may not.²¹ As such, he argued, definitional balancing is preferable both to the absolutist approach, which would strike down any law involving speech, and to ad hoc balancing, which determines which of the conflicting interests demands greater protection in the particular circumstances before the court.²²

Nimmer’s prime example of definitional balancing was the Supreme Court’s ruling in *New York Times v. Sullivan*.²³ In that case,²⁴ the Court famously held that, while defamatory falsehoods generally fall entirely outside the realm of First Amendment protection, there is a narrow category of defamatory statements that enjoy an absolute First Amendment privilege against liability for defamation. That privileged category consists of false statements directed at the official conduct of a public official and made without “actual malice”—that is, without knowledge that the statement was false or reckless disregard of whether it was false or not.²⁵ In such cases, defamed public officials are left without a remedy unless they can prove actual malice.

Similarly, Nimmer argued, copyright law already contains a de facto definitional balance. Following his assessment of copyright law’s objectives as balanced against the First Amendment interests at stake, Nimmer located that definitional balance primarily in the idea/expression dichotomy, but also in copyright’s limited term and the merger doctrine, the rule that copyright will not protect expression when it is the only means of expressing an idea.²⁶ Nimmer subsequently argued that the fair use privilege also plays a crucial role in that definitional balance by serving as a vital safeguard for First Amendment interests

20. See Nimmer, *supra* note 1, at 1184.

21. *Id.* at 1184–85.

22. *Id.* at 1183–84.

23. *Id.* at 1184 (referring to *New York Times Co. v. Sullivan* as “to date the most impressive example of this approach”).

24. *N.Y. Times Co. v. Sullivan*, 376 U.S. 254 (1964).

25. *Id.* at 279–80.

26. Nimmer, *supra* note 1, at 1189–1200.

within copyright law.²⁷ In short, the internal copyright doctrines that Nimmer identified make it possible for copyright law to coexist with the First Amendment. The idea/expression dichotomy, limited term, merger doctrine, and fair use privilege do not merely delimit exceptions and limitations to copyright holder rights within copyright law; they also serve to define speech that enjoys a First Amendment privilege against copyright infringement liability.

Whatever was the place of definitional balancing in First Amendment jurisprudence when Professor Nimmer penned his seminal article on copyright and free speech in 1970, it is not the dominant approach that courts take in First Amendment cases today. Beginning in the early 1970s, courts began to assess the constitutionality of speech-burdening regulations by categorizing the regulation as either a content-based or content-neutral speech restriction.²⁸ Content-based restrictions impose differential burdens on speech because of the speech's perceived communicative impact.²⁹ They typically target speech to suppress a particular viewpoint or the discussion of a disfavored subject matter. With the exception of certain "low-value" speech, content-based restrictions are ordinarily subject to strict judicial scrutiny and are rarely upheld.³⁰ Content-neutral restrictions, on the other hand, limit expression without regard to viewpoint or subject matter conveyed and without regard to the communicative impact of the speech's content per se. Content-neutral speech regulation includes, for example, reasonable restrictions on the time, place, and manner of speech. Content-neutral restrictions are typically subject to some form of intermediate scrutiny. Courts usually sustain such restrictions so long as the restriction is narrowly tailored to serve a significant governmental interest unrelated to the content of speech.³¹

Yet, despite the emergence and continuing dominance of the content-based/content-neutral distinction in First Amendment jurisprudence, there remains a discrete category of cases in which courts regularly apply some fashion of

27. Brief of the Gannett Co., Inc., *supra* note 13, at 21. In his 1970 article, Nimmer took the contrary position that (1) the scope and extent of fair use falls entirely within the discretion of Congress, (2) fair use properly applies only when the user's copying does not materially impair the marketability of the work that is copied, and (3) copyright law would meet First Amendment muster even without fair use. Nimmer, *supra* note 1, at 1200–04.

28. See Geoffrey R. Stone, *Free Speech in the Twenty-First Century: Ten Lessons From the Twentieth Century*, 36 PEPP. L. REV. 273, 278–80 (2009) (chronicling the emergence of the content-based/content-neutral distinction as a central facet of First Amendment jurisprudence).

29. For an illuminating taxonomy and analysis of the Supreme Court's distinction between content-based and content-neutral speech regulation, see Leslie Kendrick, *Content Discrimination Revisited*, 98 VA. L. REV. 231 (2012).

30. *Id.* at 256.

31. See, e.g., *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989).

definitional balancing. Following on *New York Times Co. v. Sullivan*, these often involve laws providing for private causes of action that make the defendant's speech the grounds for potential liability. In addition to the common law of defamation, they include laws governing the right of privacy, right of publicity, trademark, false endorsement, intentional infliction of emotional distress, tortious interference with a business, unlawful wiretapping, and misappropriation of trade secrets.³² In this category of cases, courts do not ask whether the law in question is a content-based or content-neutral speech regulation. Nor do they determine an appropriate level of First Amendment scrutiny based upon such a categorization.³³ Instead, courts considering First Amendment defenses to those private causes of action ask whether certain types of speech that would otherwise give rise to civil liability must, rather, enjoy a privilege under the First Amendment. In delimiting First Amendment privileges for certain types of speech, courts have imposed significant restrictions on private causes of action to ensure that the First Amendment-protected speech will not be chilled. These include, for example, the requirement, set out in *New York Times v. Sullivan*, that a public official cannot prevail in a defamation claim absent proof that the defendant made the defamatory statement with actual malice.

The Supreme Court's 2011 decision in *Snyder v. Phelps* provides another instructive illustration of the definitional balancing approach.³⁴ In that case, the father of a soldier who had been killed in active duty in Iraq brought a claim for intentional infliction of emotional distress against members of a Baptist church

32. See, e.g., *Snyder v. Phelps*, 131 S. Ct. 1207 (2011) (intentional infliction of emotional distress); *Bartnicki v. Vopper*, 532 U.S. 514 (2001) (private right of action for damages under wiretapping laws); *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46 (1988) (intentional infliction of emotional distress); *NAACP v. Claiborne Hardware Co.*, 458 U.S. 886 (1982) (tortious interference with a business); *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 574–78 (1977) (holding that the First Amendment does not trump right of publicity in the broadcast of an entire act but suggesting that the First Amendment could limit the right in other circumstances); *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974) (defamation of private persons); *Time, Inc. v. Hill*, 385 U.S. 374 (1967) (right of privacy); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000) (trademark); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 971–76 (10th Cir. 1996) (right of publicity); *Rogers v. Grimaldi*, 875 F.2d 994, 998–99 (2d Cir. 1989) (false endorsement and false advertising); *Herceg v. Hustler Magazine, Inc.*, 814 F.2d 1017 (5th Cir. 1987) (civil action for incitement); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 31 n.2 (1st Cir. 1987) (trademark); *Ford Motor Co. v. Lane*, 67 F. Supp. 2d 745 (E.D. Mich. 1999) (trade secrets).

33. *But see* *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 536–37 (1987) (treating a sui generis statute that granted the U.S. Olympics Committee the exclusive right to use the Olympics name and symbol for the promotion of theatrical and athletic events as a content-neutral time, place, and manner restriction for which the “appropriate inquiry is thus whether the incidental restrictions on First Amendment freedoms are greater than necessary to further a substantial governmental interest”).

34. *Snyder*, 131 S. Ct. 1207.

who picketed near the soldier's military funeral to convey the message that God punishes the United States and its military for tolerating homosexuality. The Court upheld the picketers' First Amendment defense on the grounds that their speech was on a matter of public concern and that such speech enjoys First Amendment protection even if the speaker knowingly caused the plaintiff severe emotional distress. In so holding, the Court did not ask whether the state law of intentional infliction of emotional distress is a content-based or content-neutral speech regulation and thus whether it must be subject to strict or intermediate scrutiny. Rather, it simply ruled, reiterating long established precedent, that "speech on public issues occupies the highest rung of the hierarchy of First Amendment values, and is entitled to special protection."³⁵ Significantly, the Court distinguished speech on public issues from private speech. As the Court noted, "restricting speech on purely private matters does not implicate the same constitutional concerns as limiting speech on matters of public interest," and thus state law may generally make private speech grounds for an intentional infliction of emotional distress claim without First Amendment impediment.³⁶

The definitional balancing approach extends to claims brought under federal statute as well those arising under state common law. Notably, courts considering First Amendment defenses to federal trademark infringement claims have repeatedly carved out specific privileges to trademark infringement or have interpreted trademark law to comport with First Amendment strictures rather than defining trademark law as a content-based or content-neutral speech regulation.³⁷ In one line of cases, courts have held that the use of a trademark in a literary or artistic work is protected First Amendment speech unless the trademark has no relevance to the work or explicitly misleads consumers as to the work's source.³⁸ Another line of cases holds that noncommercial uses of a trademark are First Amendment-protected speech and thus enjoy a privilege against trademark

35. *Id.* at 1215 (quoting *Connick v. Myers*, 461 U.S. 138, 145 (1983)) (internal quotation marks omitted).

36. *Id.*

37. See Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMUL REV. 381 (2008) (criticizing that approach and calling on courts to define trademark law as a content-based speech regulation).

38. See, e.g., *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099–1101 (9th Cir. 2008) (applying that test to hold that the First Amendment protected the use of a trademark in a video game); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901–02 (9th Cir. 2002) (holding that the defendant's use of a trademark in a song title was privileged under the First Amendment); *Rogers v. Grimaldi*, 875 F.2d 994, 998–99 (2d Cir. 1989) (applying the test to protect the use of a celebrity's name in a film's title against a claim of false endorsement and false advertising).

infringement claims.³⁹ A third line of cases gives First Amendment considerations weight in applying the multifactor test for determining whether consumers are likely to be confused by the defendant's use of the trademark.⁴⁰ None of those lines of cases asks whether trademark law's speech restrictions might be justified under strict or intermediate scrutiny. Rather they simply assume that certain uses of trademarks are First Amendment-protected speech and thus enjoy an absolute privilege from civil liability under trademark law.

In sum, consistently with Professor Nimmer's proffered method for balancing speech and non-speech interests, the cases that consider First Amendment defenses to various private causes of action take a "definitional-absolutist" approach to freedom of speech, to borrow Frederick Schauer's appellation for Nimmer's method.⁴¹ The cases set out firm, either-or definitional rules for particular legal doctrines. They define certain speech as enjoying an absolute First Amendment privilege against the relevant private cause of action. All other speech, however, may be fully subject to civil liability under the legal doctrine in question without any First Amendment protection, except as required to avoid chilling protected speech.

As Professor Schauer explains, that definitional-absolutist approach does not necessarily follow from definitional balancing.⁴² Rather, definitional balancing could be applied in a more nuanced fashion, one that would require a two-step analysis: the first determining whether the First Amendment covers the speech in question and the second defining what degree and type of protection

39. See, e.g., *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 677–80 (9th Cir. 2005) (holding that the defendant's use of a trademark in the name and content of its website to criticize the trademark holder is a noncommercial use protected by the First Amendment); *Taubman Co. v. Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003) (stating that the Lanham Act, the federal trademark statute, is constitutional because it only regulates commercial speech, which is entitled to reduced protection under the First Amendment).

40. See, e.g., *Lamparello v. Falwell*, 420 F.3d 309, 314–15 (4th Cir. 2005) (stating that the "likelihood-of-confusion test [for trademark infringement] generally strikes a comfortable balance between the First Amendment and the rights of [trade]mark holders" (internal quotation marks omitted)); *Mattel, Inc.*, 296 F.3d at 900 (noting in passing that the likelihood of confusion test generally strikes a comfortable balance between the trademark owner's property rights and First Amendment interests); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 494–95 (2d Cir. 1989) (stating that the Lanham Act must be construed narrowly when First Amendment values are at stake and thus that somewhat greater risk of confusion must be tolerated when a trademark owner seeks to enjoy artistic expression such as a parody).

41. Frederick Schauer, *Categories and the First Amendment: A Play in Three Acts*, 34 VAND. L. REV. 265, 274 (1981); see also Norman T. Deutsch, *Professor Nimmer Meets Professor Schauer (and Others): An Analysis of "Definitional Balancing" as a Methodology for Determining the "Visible Boundaries of the First Amendment"*, 39 AKRON L. REV. 483 (2006) (assessing commentators' views and judicial applications of definitional balancing).

42. Schauer, *supra* note 41, at 275–76.

the First Amendment accords that speech. In other words, even if a given type of speech, such as speech on matters of public concern, enjoys First Amendment protection, there could remain the question of whether a law that burdens such speech should be subject to strict or intermediate scrutiny. Say that we view the tort of intentional infliction of emotional distress as a content-neutral speech regulation—one designed not to suppress particular messages but to protect vulnerable individuals from egregious conduct undertaken with the aim of causing them severe emotional distress. Following a two-step analysis, we might then apply a form of intermediate scrutiny, conceivably to countenance imposing civil liability on those who intentionally inflict emotional distress on mourning family members by picketing at a funeral even if the picketers are speaking on a matter of public concern.

Professor Schauer argues that the nuanced approach would be at once more tenable and normatively preferable to definitional absolutism.⁴³ The definitional-absolutist approach tends to carve out a narrow category of protected speech given that the consequence of finding First Amendment protection is an absolute privilege. In contrast, a two-step approach would enable courts to provide some measure of First Amendment protection to a broader range of speech than does the definitional-absolutist approach.

Professor Schauer's thoughtful admonition has largely fallen on deaf ears, however. In the definitional balancing cases, courts have steadfastly eschewed a more nuanced two-step analysis. Rather, they have repeatedly adhered to the either-or absolutist approach.

The Supreme Court's ruling in *Bartnicki v. Vopper* is a telling example.⁴⁴ *Bartnicki* involved a civil claim against media defendants for their intentional disclosure of a cellular telephone conversation on a matter of public concern, a conversation that had been intercepted by a third party in violation of federal and state wiretapping statutes. In ruling for the media defendants, the Court first noted its agreement with the petitioner-plaintiffs that the wiretapping statutes were content-neutral speech regulations, designed to protect the privacy of communications, not to suppress particular ideas or views.⁴⁵ But the Court then completely ignored that content-neutral categorization. Rather, it set out and applied the general, high-absolutist proposition that "if a newspaper lawfully obtains truthful information about a matter of public significance then state officials may not constitutionally punish publication of the information, absent a

43. *Id.* at 276.

44. *Bartnicki v. Vopper*, 532 U.S. 514 (2001).

45. *Id.* at 526.

need . . . of the highest order.”⁴⁶ Citing the rule in *New York Times v. Sullivan* and other cases upholding First Amendment protection of criticism of public officials even in the face of defamatory conduct, the *Bartnicki* Court concluded that “parallel reasoning requires the conclusion that a stranger’s illegal conduct does not suffice to remove the First Amendment shield from speech about a matter of public concern.”⁴⁷

Not surprisingly, Nimmer’s proffered method has impacted copyright law as well. The Supreme Court expressly adopted definitional balancing in a copyright case in its 1985 decision *Harper & Row, Publishers, Inc. v. Nation Enterprises*.⁴⁸ In *Harper & Row*, defendant Nation Enterprises obtained a prepublication manuscript of former President Ford’s memoirs and published a news story, quoting about 300 words from the some 200,000-word manuscript, about Ford’s reasons for pardoning Richard Nixon. In rejecting *The Nation*’s claim that its quotations were privileged fair use, the Supreme Court took the position that copyright law may impose civil liability upon a news organization for copying statements containing truthful information. Copyright may do so without conflicting with the First Amendment because it gives authors an exclusive right only in form of expression and not the ideas or facts expressed. As the Court explained, “copyright’s idea/expression dichotomy ‘strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author’s expression.’”⁴⁹

Eldred v. Ashcroft and *Golan v. Holder* presented a different type of constitutional claim than that before the court in *Harper & Row* and the other definitional balancing cases. The twin rulings involved facial challenges to Copyright Act amendments rather than as applied, First Amendment defenses to civil liability claims. Nonetheless, as I discuss in the next Part, the Court has drawn upon and effectively embraced the definitional balancing approach in those twin rulings. Indeed, each ruling expressly invokes *Harper & Row*’s reference to copyright’s “definitional balance,”⁵⁰ even if each rejects *Harper & Row*’s characterization of that balance to include only copyright’s idea/expression dichotomy and not the fair use privilege. As such, the twin rulings carry potentially significant ramifications for copyright law. In line with the definitional absolutism that has characterized the definitional balancing approach in the Supreme Court

46. *Id.* at 528 (alteration in original) (quoting *Smith v. Daily Mail Publ’g Co.*, 443 U.S. 97, 103 (1979)).

47. *Id.* at 534–35.

48. 471 U.S. 539 (1985).

49. *Id.* at 556 (alteration in original) (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 203 (2d Cir. 1983)).

50. *Golan v. Holder*, 132 S. Ct. 873, 890 (2012); *Eldred v. Ashcroft*, 537 U.S. 186, 190 (2003).

and lower courts, *Eldred* and *Golan* herald robust, if pointed, First Amendment constraints on copyright law.

We now turn to *Eldred* and *Golan* and to explicating their considerable import for copyright litigation and legislation.

II. *ELDRED AND GOLAN*

*Eldred v. Ashcroft*⁵¹ concerned a constitutional challenge to the Sonny Bono Copyright Term Extension Act of 1998 (CTEA).⁵² The CTEA amended the Copyright Act to extend the copyright term for an additional twenty years. That term extension applied not only prospectively to works created after the CTEA's effective date but also retrospectively to subsisting copyrights in existing works.

In *Golan v. Holder*,⁵³ the Court heard a constitutional challenge to Section 514 of the Uruguay Round Agreements Act of 1994 (URAA).⁵⁴ In Section 514, Congress amended the Copyright Act to accord copyright protection to certain foreign works that had previously been in the public domain in the United States. Previously public domain works that are now in copyright as a result of Section 514 include, among others, music by Shostakovich, Stravinsky, and Prokofiev; literature by Virginia Woolf and C.S. Lewis; films by Federico Fellini and Alfred Hitchcock; and art by Pablo Picasso.⁵⁵

In both cases, the petitioners argued that the statutory provisions in question exceeded Congress's enumerated power under the Copyright Clause and contravened the First Amendment. In each case, the Supreme Court rejected both constitutional challenges. Our focus here is just the First Amendment challenge.

A. *Eldred v. Ashcroft*

In *Eldred*, a group of archivists and publishers of public domain material sought to enjoin the Attorney General from enforcing the CTEA. The *Eldred* petitioners argued that copyright law is a content-neutral speech regulation and thus that the CTEA should be subject to intermediate scrutiny under the standard set forth in a number of prior cases, including, most definitively, in the two

51. 537 U.S. 186 (2003).

52. Pub. L. No. 105-298, 112 Stat. 2827 (codified as amended in scattered sections of 17 U.S.C.).

53. 132 S. Ct. 873 (2012).

54. Pub. L. 103-465, 108 Stat. 4809.

55. See Petition for Writ of Certiorari at 3, *Golan*, 132 S. Ct. 873 (No. 10-545), 2010 WL 4232641, at *3.

previous Supreme Court decisions in *Turner Broadcasting System, Inc. v. FCC*.⁵⁶ As the Court restated the standard for intermediate scrutiny in *Turner II*: “A content-neutral regulation will be sustained under the First Amendment if it advances important governmental interests unrelated to the suppression of free speech and does not burden substantially more speech than necessary to further those interests.”⁵⁷

The *Eldred* petitioners trained their First Amendment challenge on the CTEA’s retrospective extension of copyright duration to copyrights in already existing works.⁵⁸ Under those provisions, even holders of copyrights in old works about to enter the public domain, like the Mickey Mouse cartoon character, received an additional twenty years of exclusive rights. The *Eldred* petitioners argued that the only important governmental interest previously recognized by the Supreme Court as sufficient to sustain copyright’s speech restrictions—providing incentives to authors to create original works—is irrelevant once a work has been created. As the petitioners put it: “No matter what we offer Hawthorne or Hemingway or Gershwin, they will not produce anything more.”⁵⁹ The petitioners then argued that the other interests that the government advanced in support of the term extension—including providing greater income to author’s heirs, harmonizing U.S. copyright law with that of other countries, and preserving old works—were illegitimate, hypothesized after the fact, or insufficiently substantial to justify the burden that the law imposed on speech.

By a seven-to-two majority, the Supreme Court rejected the petitioners’ First Amendment challenge. It did so without considering whether the CTEA constituted content-neutral speech regulation or met the *Turner* test for intermediate scrutiny. Rather, the Court held that when “Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”⁶⁰ It then concluded, with meager explanation, that Congress’s extension of the copyright term for subsisting copyrights did not so alter copyright’s traditional contours.⁶¹

It is far from apparent what the “traditional contours of copyright protection” might be. Certainly, today’s copyright protection as set out in the Copyright

56. *Turner Broad. Sys., Inc. v. FCC (Turner II)*, 520 U.S. 180 (1997); *Turner Broad. Sys., Inc. v. FCC (Turner I)*, 512 U.S. 622 (1994).

57. *Turner II*, 520 U.S. at 189.

58. *Eldred v. Ashcroft*, 537 U.S. 186, 199 (2003).

59. Brief for Petitioners at 22, *Eldred*, 537 U.S. 186 (No. 01-618), 2002 WL 32135676, at *22 (arguing that retrospective extension does not “[P]romote[] the Progress of Science” as required by the Copyright Clause (internal quotation marks omitted)).

60. *Eldred*, 537 U.S. at 221.

61. *Id.* at 219–21.

Act of 1976⁶² bears scant resemblance to the copyright law in force during the time of the Framers. Indeed, our current Copyright Act provides for a far longer copyright term, grants copyright protection to many more types of expressive works, imposes markedly fewer prerequisites for enjoying copyright protection, and accords copyright holders more exclusive rights than did U.S. copyright law through much of the nineteenth century.⁶³ Viewed in that light, very little of today's Copyright Act would fall within copyright law's "traditional contours."

The *Eldred* Court's summary conclusion that the CTEA did not alter the traditional contours of copyright protection was apparently based on its finding, set out in its discussion of Congress's authority to enact the CTEA under the Copyright Clause, that "Congress, from the start, has routinely applied new definitions or adjustments of the copyright term to both future works and existing works not yet in the public domain."⁶⁴ Aside from that, the *Eldred* Court provided no definition of copyright's traditional contours or any hint of what type of legislation would alter them.

What the Court did explain is why, in its view, First Amendment scrutiny is unnecessary when Congress has not altered copyright's traditional contours (whatever those contours might be). The Court first opined that since the Copyright Clause and the First Amendment were adopted close in time, the Framers must have perceived that copyright's limited monopolies are compatible with free speech principles.⁶⁵ As I have discussed elsewhere, it is hard to take this argument seriously.⁶⁶ After all, the essential point of the First Amendment is to impose limits on powers that Congress would otherwise have under the Constitution. Just because the Constitution gives Congress the power to legislate in a given area does not mean that any legislation the Congress enacts pursuant to that enumerated power passes First Amendment muster. Not surprisingly, therefore, the First Amendment has been held repeatedly to override legislation enacted by Congress pursuant to other enumerated congressional powers in the

62. Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101–810 (2006)).

63. The 1790 copyright statute provided only for an exclusive right to copy books, maps, and charts, lasting for fourteen years unless renewed for a second fourteen-year term. *See* Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124, 124 (repealed 1831). The Copyright Act of 1976 provides for a bundle of exclusive rights (including the right to reproduce copies, make derivative works, publicly perform, and publicly display the work), which last for the life of the author plus seventy years, in a broad range of original works of authorship. *See* 17 U.S.C. §§ 102(a), 106, 302 (2006). Further, the 1790 copyright statute imposed registration and deposit requirements as a condition to enjoying copyright protection. The Berne Convention Implementation Act of 1988 eliminated those requirements and the copyright notice requirement.

64. *Eldred*, 537 U.S. at 213.

65. *Id.* at 219.

66. NEIL WEINSTOCK NETANEL, *COPYRIGHT'S PARADOX* 178–79 (Oxford Univ. Press 2008).

Constitution, all of which were adopted with the very same temporal proximity to the First Amendment as the Copyright Clause.⁶⁷

Further, our current free speech jurisprudence, which is largely a product of precedent from the second half of the twentieth century, bears no more resemblance to the free speech principles extant at the time of the Framers than current copyright law bears resemblance to the first copyright statute, the Act of May 31, 1790.⁶⁸ Hence the temporal proximity of the Copyright Clause and First Amendment suggests at the very most that the Framers saw no conflict between the narrow, short-term copyright enacted under the first copyright statute and the understanding of the First Amendment that prevailed at the Founding. It says nothing about whether legislation that further extends the scope or duration of copyright beyond that provided under the Copyright Act of 1976 comports with twenty-first century First Amendment doctrine.

Second, the *Eldred* Court underscored that “copyright’s purpose is to *promote* the creation and publication of free expression.”⁶⁹ As the Court observed, quoting from its oft-cited statement in *Harper & Row, Publishers, Inc. v. Nation Enterprise*: “[T]he Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one’s expression, copyright supplies the economic incentive to create and disseminate ideas.”⁷⁰ Accordingly, the Court surmised, copyright law promotes First Amendment values and thus generally warrants no First Amendment scrutiny.

Like the temporal proximity argument, the notion that copyright promotes speech is grossly insufficient to support copyright law’s qualified immunity from First Amendment scrutiny. Much speech-burdening regulation might be characterized as speech enhancing: campaign finance restrictions arguably prevent well-heeled speakers from drowning out others, and time, place, and manner regulations ward off the cacophony that might result from concurrent demonstrations in the same place.⁷¹ But the fact that speech-burdening regu-

67. See, e.g., *Thompson v. W. States Med. Ctr.*, 535 U.S. 357 (2002) (striking legislation enacted under Commerce Clause); *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533 (2001) (striking legislation enacted under spending power); *Regan v. Time, Inc.*, 468 U.S. 641 (1984) (striking portions of legislation enacted under Congress’s power to “provide for the Punishment of counterfeiting”); *United States v. Grace*, 461 U.S. 171 (1983) (striking legislation enacted under Federal District Clause); *Lamont v. Postmaster Gen.*, 381 U.S. 301 (1965) (striking legislation enacted under Post Office Clause).

68. Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1831).

69. *Eldred*, 537 U.S. at 219.

70. *Id.* (alteration in original) (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985)).

71. See Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 187–88 (1998).

lation might also enhance some speech does not generally absolve the regulation of First Amendment scrutiny. Indeed, the Supreme Court recognized that the broadcaster must-carry rules at issue in *Turner* aimed to achieve two important free speech objectives: to “preserve access to free television programming” for those without cable and to promote “the widespread dissemination of information from a multiplicity of sources.”⁷² Yet the *Turner* Court still asked whether the must-carry rules “burden substantially more speech than necessary to further those interests.”⁷³

Finally, the *Eldred* Court emphasized that “copyright law contains built-in First Amendment accommodations”: the idea/expression dichotomy and the fair use doctrine. Since copyright extends only to expression, “every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication.”⁷⁴ For its part, “the ‘fair use’ defense allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances.”⁷⁵

The Court’s invocation of the idea/expression dichotomy and free use doctrine better explains why copyright law might generally be immune from First Amendment scrutiny as compared to the other of the Court’s purported explanations. The idea/expression dichotomy and fair use privilege indeed ameliorate the tension between copyright and free speech. As Nimmer concluded, they help to constitute copyright law’s de facto definitional balance.

Yet copyright’s purported free speech safeguards do not *eliminate* that tension. Even if copyright law leaves ideas and facts available for public exploitation, it still prevents speakers from copying or, in many cases, building upon existing expression to convey their message. And in First Amendment jurisprudence, it is generally axiomatic that speakers must sometimes use particular locution in order to make their point. As the Court has long recognized, “we cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process.”⁷⁶ Further, as the *Eldred* Court conceded, fair use allows speakers to copy expression only in “certain circumstances.” As I will shortly discuss, whether fair use truly accommodates the First Amendment thus depends on how that doctrine is interpreted and applied.

72. *Turner I*, 512 U.S. 622, 646, 662 (1994).

73. *Turner II*, 520 U.S. 180, 185 (1997).

74. *Eldred*, 537 U.S. at 219.

75. *Id.*

76. *Cohen v. California*, 403 U.S. 15, 26 (1971) (striking down the disturbing-the-peace conviction of an individual who entered a courthouse wearing a jacket bearing the words, “Fuck the Draft”). Professor Nimmer represented the defendant before the Supreme Court.

B. *Golan v. Holder*

Section 514 of the URAA did not merely extend the copyright term for subsisting copyrights. It restored to copyright works that were already in the public domain. The *Golan* petitioners—orchestra conductors, musicians, publishers, and others who had formerly freely performed and distributed such public domain works—argued that the URAA thereby altered the traditional contours of copyright law. The Tenth Circuit Court of Appeals agreed. The URAA, it opined, “contravened a bedrock principle of copyright law that works in the public domain remain in the public domain.”⁷⁷

However, the Supreme Court rejected the petitioners’ First Amendment challenge by a six-to-two majority, with Justice Kagan taking no part in the case. The *Golan* Court expressly recognized that “some restriction on expression is the inherent and intended effect of every grant of copyright.”⁷⁸ But it held, nevertheless, that First Amendment scrutiny of the URAA was unwarranted.

In so holding, the Court essentially recapitulated the three explanations that it had set out in *Eldred* for why First Amendment scrutiny is not to be applied when Congress leaves copyright’s traditional contours unaltered. The *Golan* Court repeatedly quoted and relied upon what it termed its “pathmarking decision in *Eldred*.”⁷⁹ Yet *Golan* placed even greater emphasis on copyright law’s twin built-in First Amendment safeguards: the idea/expression distinction and fair use defense. According to *Golan*, these very doctrines are, in fact, what the *Eldred* Court meant by copyright’s traditional contours.⁸⁰

The Court thus chided the initial Tenth Circuit opinion in the case for incorrectly giving “an unconfined reading to our reference in *Eldred* to ‘traditional contours of copyright.’”⁸¹ Rather, the Court held, there is no call for heightened review in this matter because “Section 514 leaves undisturbed the ‘idea/expression distinction’ and the ‘fair use’ defense.”⁸² The copyright restoration provisions of

77. *Golan v. Gonzales*, 501 F.3d 1179, 1192 (10th Cir. 2007). On remand the district court ruled that Section 514 violated the First Amendment to the extent it suppressed the plaintiffs’ right to continue to use works they exploited while the works were in the public domain. *Golan v. Holder*, 611 F. Supp. 2d 1165 (D. Colo. 2009). However, on appeal back to the Tenth Circuit, the Court of Appeals ruled that Section 514 met the intermediate scrutiny test for content-neutral speech regulations and thus did not violate the First Amendment. *Golan v. Holder*, 609 F.3d 1076 (10th Cir. 2010). It was from that second Tenth Circuit ruling that the Supreme Court granted certiorari.

78. *Golan v. Holder*, 132 S. Ct. 873, 889 (2012).

79. *Id.*

80. *Id.* at 890.

81. *Id.* at 890 n.29 (quoting *Golan*, 501 F.3d at 1189).

82. *Id.* at 890–91. The Court added that Congress had also mitigated the impact of the copyright restoration by deferring the date from which the enforcement of restored copyrights would run and providing certain accommodations for those who had previously exploited foreign works that had

Section 514, in other words, escape First Amendment scrutiny because they did not alter those traditional contours, now expressly defined as coterminous with copyright's built-in First Amendment accommodations.

In presenting the idea/expression dichotomy and fair use privilege both as copyright's vital built-in First Amendment accommodations and as the traditional contours that render it immune from First Amendment scrutiny, *Golan* appears to firmly embrace the definitional balancing approach. In *Golan* as in *Eldred*, the Court declined to apply the content-based/content-neutral distinction to copyright law.⁸³ Rather, consonant with courts' application of definitional balancing in other cases involving private causes of action, *Golan* addresses the tension between copyright and the First Amendment by distinguishing between speech that the First Amendment protects and speech that falls outside of First Amendment protection. *Golan* thus points toward an either-or definitional rule applicable to copyright law. It recognizes that, in general, copyright law may permissibly burden infringing speech. But the ruling then appears to carve out a narrow type of speech that enjoys an absolute First Amendment privilege from copyright infringement liability: copying the facts or ideas from the author's work or copying the work in a manner that constitutes fair use.

Granted, *Golan* does not expressly mandate that copyright law must allow such speech in the way that *New York Times Co. v. Sullivan*⁸⁴ mandated that the law of defamation must privilege false statements about public officials made without actual malice. But in *Golan*, the Court did not have to mandate that copyright law be modified to include a First Amendment privilege to copy facts and ideas and to engage in fair use because, as the Court emphasized, copyright law already includes those built-in First Amendment accommodations. Following Nimmer's formulation, copyright law already contains a de facto definitional balance, thus obviating the need to impose a new definitional rule.

Moreover, *Golan* was not faced with a situation in which the idea/expression dichotomy or fair use were allegedly impaired, and had no reason to consider such

been in the public domain before the restoration took effect. *Id.* at 891. But the Court gave no indication that Congress's mitigation was required for Section 514's immunity from First Amendment scrutiny, given that Section 514 leaves copyright law's traditional contours in place.

83. In contrast, the lower courts in *Golan* did apply that distinction. The first Tenth Circuit ruling instructed the district court to assess whether the copyright restoration amendment was content-based or content-neutral. *Golan*, 501 F.3d at 1196. The district court then categorized the copyright restoration amendment as a content-neutral speech regulation, a categorization with which both parties agreed. It then ruled that the legislation failed the test of intermediate scrutiny. *Golan v. Holder*, 611 F. Supp. 2d 1165, 1170–72 (D. Colo. 2009). On appeal, the Tenth Circuit reversed, confirming that the restoration amendment was a content-neutral speech regulation but holding that it survived intermediate scrutiny. *Golan v. Holder*, 609 F.3d 1076, 1083–94 (10th Cir. 2010).
84. 376 U.S. 254 (1964).

a counterfactual scenario. Thus while *Golan* expressly holds that the URAA was immune from First Amendment scrutiny because it did not disturb the idea/expression dichotomy or the fair use defense, the Court did not state—or have reason to state—that a Copyright Act amendment that abolished one or both of those built-in First Amendment accommodations would necessarily fail First Amendment scrutiny. It is not impossible, under *Golan*, that such an amendment would be subject only to intermediate scrutiny as a content-neutral speech regulation, in line with Professor Schauer’s proffered two-step approach to definitional balancing.

As we have seen, however, that two-step approach would fly in the face of the definitional absolutism that characterizes definitional balancing in both the Supreme Court and lower courts. It also would be inconsistent with the considerable weight that both *Eldred* and *Golan* give to the role that the idea/expression dichotomy and fair use defense play as copyright’s built-in First Amendment accommodations and to each ruling’s reliance on *Harper & Row*’s explicit adoption of definitional balancing. A far more plausible reading of *Golan*, then, is one that situates the ruling within the either-or definitional balancing methodology that the Supreme Court and lower courts have repeatedly applied to private causes of action that target speech.

On that reading, *Golan* strongly suggests that it is by virtue of the idea/expression dichotomy and fair use privilege that copyright law not only is immune from First Amendment scrutiny but also comports with First Amendment requirements. Following *Golan*, Congress may apparently extend and expand copyright law as it wishes, without giving rise to First Amendment scrutiny, so long as it leaves the idea/expression dichotomy and fair use defense “undisturbed.” But if a Copyright Act amendment were to eliminate, eviscerate, or otherwise disturb the idea/expression dichotomy or fair use defense, the amendment should be stricken down as failing to pass First Amendment muster, the same fate that would befall a state defamation statute that purported to remove the First Amendment privileges pronounced by *New York Times* and its progeny.

Perhaps Congress might enact some alternative provision that adequately accommodates constitutional protections of free speech in the absence of applying the idea/expression dichotomy or fair use defense to particular areas; I consider that possibility below in connection with the triennial rulemaking providing for temporary fair use-like exceptions to the Digital Millennium Copyright Act anticircumvention prohibitions.⁸⁵ However, a Copyright Act amendment that simply eliminated or substantially weakened the First Amendment protections

85. See *infra* notes 161–165 and accompanying text.

embodied in the idea/expression dichotomy or fair use defense as generally applied in copyright law would not withstand First Amendment scrutiny. Especially when viewed against the definitional absolutism that characterizes cognate cases, the Court's repeated invocation of those doctrines as vital First Amendment safeguards in *Eldred* and *Golan* strongly suggests that copyright law must privilege the speech that those doctrines make noninfringing lest copyright law unconstitutionally abridge freedom of speech.

In sum, *Golan* imposes potentially significant First Amendment constraints on copyright protection, notwithstanding that it narrowly defines the traditional contours of copyright protection. First, *Golan* suggests that Congress may not expand or extend copyright protection in a way that avoids or diminishes the idea/expression distinction or fair use defense, at least without providing some alternative First Amendment protection. In addition, and perhaps less obviously, *Golan* fortifies and gives First Amendment import to the idea/expression dichotomy and the fair use defense in traditional copyright infringement litigation. It is to that latter point that we now turn.

III. SIGNIFICANCE FOR COPYRIGHT LITIGATION

Courts applying definitional balancing have imposed First Amendment barriers to a wide variety of private causes of action, including claims under the laws of defamation, right of privacy, right of publicity, trademark, false endorsement, intentional infliction of emotional distress, tortious interference with a business, unlawful wiretapping, trade secret, and, in certain contexts, even property rights in chattel and land.⁸⁶ Yet virtually no courts have recognized First Amendment defenses to copyright infringement actions.⁸⁷ Like *Golan's* and *Eldred's* rejections of First Amendment scrutiny for facial challenges to copyright legislation, courts justify copyright's anomalous treatment by reference to copyright law's internal First Amendment safeguards. Following Nimmer's 1970 article, they posit that copyright's de facto definitional balance obviates the need to impose further First Amendment constraints.

Yet unlike *Golan* and *Eldred*, some courts invoke only the idea/expression dichotomy as the reason why external First Amendment limits on copyright

86. See *supra* note 32 (citing definitional balancing cases).

87. I am aware of only two cases in which courts have ruled in favor of First Amendment defenses to copyright enforcement without being subsequently vacated. Both are district court decisions. One was upheld on appeal on non-First Amendment grounds: *Triangle Publ'ns, Inc. v. Knight-Ridder Newspapers, Inc.*, 445 F. Supp. 875 (S.D. Fla. 1978), *aff'd on other grounds*, 626 F.2d 1171 (5th Cir. 1980). The other is unreported: *Holliday v. Cable News Network*, N.Y. L.J., Jan. 21, 1994, at 5 (C.D. Cal. June 11, 1993).

holder rights are unnecessary. Most notably, in *Harper & Row*⁸⁸ the Supreme Court rejected *The Nation's* argument that fair use must be broadly construed to avoid questions of First Amendment violation and insisted that copyright's internal First Amendment protections are embodied solely "in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas."⁸⁹ The *Harper & Row* majority opined that fair use, far from serving as a critical free speech safeguard, is merely an equitable doctrine "predicated on the author's implied consent to 'reasonable and customary' use."⁹⁰ Accordingly, the Court held that *The Nation's* copying from former President Ford's manuscript in a news story was not a fair use.

In so holding, the *Harper & Row* majority reversed the Second Circuit, which, in ruling that *The Nation's* copying to authenticate its news story was fair use, had reasoned: "To decide otherwise would be to ignore those values of free expression which have traditionally been accommodated by the [Copyright] statute's 'fair use' provisions."⁹¹ Of note, the Supreme Court's view of fair use as implied consent rather than an internal First Amendment safeguard also stood in sharp contrast to the argument that Professor Nimmer presented in an amicus brief on behalf of the Los Angeles Times, New York Times, Washington Post, and other leading newspapers: "The doctrine of fair use—like the statutory doctrines used to define what is and is not copyrightable [namely, the dichotomy between copyrightable expression and uncopyrightable facts and ideas]—seeks to reconcile the tension between First Amendment and copyright interests. . . . And just as the statutory doctrines defining what is and what is not protected by copyright should be construed so as to avoid questions of First Amendment violations, so should the statutory fair use doctrine."⁹²

On that score, *Golan* and *Eldred* vindicate the First Amendment understanding of fair use set out by the Second Circuit and Professor Nimmer in *Harper & Row*. They make clear that fair use, no less than the idea/expression dichotomy, is a linchpin of First Amendment protection within copyright law. *Golan* even marshals the Supreme Court's ruling in *Harper & Row* to support *Golan's* statement that both the idea/expression dichotomy and fair use defense "are recognized in our jurisprudence as 'built-in First Amendment accommodations.'"⁹³ Yet *Golan* selectively—and misleadingly—quotes from *Harper &*

88. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985).

89. *Id.* at 560.

90. *Id.* at 550.

91. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 208 (2d Cir. 1983).

92. Brief of the Gannett Co., Inc., *supra* note 13, at 21.

93. *Golan v. Holder*, 132 S. Ct. 873, 890 (2012) (quoting *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003)).

Row to portray that earlier ruling as one that actually recognized fair use as a First Amendment accommodation.⁹⁴ In so doing, the Court, unfortunately, follows a repeated practice in its fair use rulings of attempting to maintain an appearance of consistency with earlier Supreme Court precedent, even though it is actually rejecting the earlier precedent and pronouncing new rules.⁹⁵ In any event, following *Golan*, to the extent that *Harper & Row* and other cases have suggested that fair use is not a vital First Amendment safeguard, they are no longer good law.

Moreover, *Eldred* and, especially, *Golan* make clear that courts must construe and apply the idea/expression dichotomy and fair use defense in line with First Amendment strictures. If the idea/expression dichotomy and fair use defense are the built-in First Amendment accommodations that are required for copyright law to pass First Amendment muster, they must protect First Amendment rights in substance, not just in name.⁹⁶ When *Golan* states that the idea/expression distinction and fair use are copyright's traditional contours and First Amendment accommodations, it invokes the idea/expression distinction and fair use privilege as currently codified in the Copyright Act, not whatever emaciated variations Congress might someday wish to enact under the same doctrinal label. And if copyright's definitional balance could be upended by Congress's vitiation of the idea/expression dichotomy or fair use privilege, so could it be undermined by judicial interpretations that fail to give sufficient weight to those doctrines' First Amendment import. As Professor Nimmer argued in his amicus brief, such insufficiently solicitous judicial interpretations would thus give rise to questions of First Amendment violations.⁹⁷

94. The full sentence in *Harper & Row* from which *Golan* selectively quotes is:

In view of the First Amendment protections already embodied in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas, and the latitude for scholarship and comment traditionally afforded by fair use, we see no warrant for expanding the doctrine of fair use to create what amounts to a public figure exception to copyright.

Harper & Row, Publishers, Inc., 471 U.S. at 560. The comma after the word "ideas" indicates, and the context of that statement in the rest of the opinion makes even more clear, that for the *Harper & Row* Court, the First Amendment protections were embodied only in the idea/expression distinction, while the "latitude for scholarship and comment" was simply a feature of the traditional common law of fair use, not a First Amendment protection. *See id.*

95. *See* Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549, 596–97 (2008) (criticizing the Court for causing lower court confusion in fair use cases by purporting to "reconstrue" precedent that it "should have explicitly rescinded and replaced").

96. *See generally* Joseph P. Liu, *Copyright and Breathing Space*, 30 COLUM. J.L. & ARTS 429 (2007) (arguing, similarly, that the idea/expression dichotomy and fair use must be interpreted and applied to avoid chilling First Amendment protected speech).

97. Brief of the Gannett Co., Inc., *supra* note 13.

Yet, despite Nimmer's sage admonition, courts have been inconsistent, at best, in interpreting and applying the idea/expression dichotomy and fair use defense in a manner that truly safeguards First Amendment rights.

A. Idea/Expression Dichotomy

With the idea/expression dichotomy, the First Amendment concern centers on the standard for determining when a defendant has infringed the plaintiff's copyright. At its origins, copyright law gave the copyright holder the exclusive right to make exact or nearly exact copies of the copyrighted work and nothing more. But over time, courts have greatly expanded the scope of the copyright protection. Today, even if I neither copy nor even closely paraphrase any of your descriptions, scenes, characters, or dialogue, I can infringe your copyright if I copy the overall look and feel of your work, including its mood, sequencing, settings, and broad incidents of plot. As *Nimmer on Copyright* muses: *West Side Story*, a Broadway musical about a tragic romance between a boy and girl belonging to rival ethnic groups in New York City, might well infringe the copyright in Shakespeare's *Romeo and Juliet* (if *Romeo and Juliet* were not in the public domain), given that *West Side Story* copies *Romeo and Juliet*'s essential sequence of events and the interplay of its characters.⁹⁸ This is so even though *West Side Story* copies none of Shakespeare's actual scenes, settings, characters, or dialogue.⁹⁹

The initial First Amendment problem posed by copyright's expansion to encompass nonliteral copying is that there is no hard-and-fast line distinguishing copyrightable look and feel from noncopyrightable idea. For example, it would be perfectly plausible to argue that given the level of abstraction and generality that *West Side Story* copies from *Romeo and Juliet*, its authors copied only Shakespeare's ideas, not his copyrightable expression. Neither the Copyright Act nor case precedent provides a definitive test for determining what constitutes idea and what constitutes expression. As Judge Learned Hand quite accurately put it early in his career on the Second Circuit: "Nobody has ever been able to fix that boundary [between idea and expression], and nobody ever can."¹⁰⁰ And thirty years later, at the end of Judge Hand's illustrious career on the bench, nothing had changed his mind: "Obviously, no principle can be stated as to when an imitator has gone beyond copying the 'idea,' and has borrowed its 'expression.' Decisions must therefore inevitably be ad hoc."¹⁰¹

98. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A][1][b] (2012).

99. *Id.*

100. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

101. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (emphasis omitted).

The indeterminacy of where expression ends and idea begins has long been a fault line in copyright doctrine. That is bad enough. But if the idea/expression dichotomy is what saves copyright from running afoul of the First Amendment, we now have a problem of constitutional dimensions. If, in forbidding the copying of the overall look and feel of a copyrighted work, copyright law in fact chills a speaker's use of ideas or facts in that work, copyright law raises serious First Amendment concerns.¹⁰²

Following *Golan*, Judge Hand's acquiescence in the arbitrary, ad hoc character of the idea/expression dichotomy is no longer acceptable from a First Amendment perspective. Rather, it is incumbent on courts to err on the side of finding that the defendant has copied ideas, not expression. If it is plausible to characterize a defendant's nonliteral copying as the copying of idea, it should be deemed so and thus not infringing. As in the constitutionalized laws of defamation, privacy, intentional infliction of emotional distress, trademark, and others, courts must provide breathing space for the dissemination of ideas and information, whatever their source. In copyright, as in other areas of the law, courts must apply prophylactic rules, bending over backwards to insure that copyright does not chill First Amendment-protected speech.¹⁰³

The second First Amendment problem related to the idea/expression dichotomy is that even if judges are able faithfully to filter out First Amendment-protected idea from copyright-protected expression, the standard test for infringement invites the factfinder to bring ideas back into the mix in determining whether the defendant infringed. Say a defendant has copied a number of elements from the plaintiff's work, only some of which are copyrightable. How do we know whether defendant has copied sufficient copyrightable expression to have infringed the copyright? One might think that we would first identify and disregard all of the defendant's copying of ideas, facts, and other noncopyrightable elements of the plaintiff's work and then compare what is left. Our sole question for determining infringement, after all, should be: Which, if any, *copyrightable* elements of the plaintiff's work did the defendant copy?

Yet, the predominant test for determining copyright infringement does not do that. The so-called audience or ordinary observer test, rather, focuses on the jury's spontaneous and immediate reactions to the plaintiff's and defendant's

102. See Alred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept and Feel,"* 38 EMORY L.J. 393 (1989) (arguing that the ad hoc character of the idea/expression dichotomy creates a chilling effect on constitutionally protected speech).

103. Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 85 (2001).

works.¹⁰⁴ In fact, the jury may be specifically instructed *not* to examine the works hypercritically or with meticulous scrutiny and *not* to extract ideas and other noncopyrightable elements when assessing whether the defendant has in fact copied only copyrighted expression. As courts have repeatedly stated, it is wrong to overdissect the works.¹⁰⁵ Rather, the factfinder must look to holistic similarities, finding infringement on the basis of whether the defendant's work conveys the same overall impression as the plaintiff's work conveys.

Granted, some courts apply a "more discerning observer" test if both unprotected and protected elements have been copied.¹⁰⁶ That test is supposed to require similarity of protectable expression, not idea. But even these courts do not always unequivocally rule out giving some weight to copying unprotectable elements as needed for the jury to measure its spontaneous reaction to each work's overall look and feel. As the Second Circuit has admonished: "In applying [the more discerning observer] test, a court is not to dissect the works at issue into separate components and compare only copyrightable elements."¹⁰⁷

The audience test has never been directly considered or applied by the Supreme Court. But *Nimmer on Copyright* cogently argues that the test runs contrary to the Supreme Court's seminal ruling in *Feist Publications, Inc. v. Rural Telephone Service Co.*¹⁰⁸ As *Nimmer* notes: "In *Feist*, the Court took a copyrighted work and eliminated from the substantial similarity calculus all material therein not subject to copyright. The result was to appreciate that the defendant copied only uncopyrightable elements from plaintiff's work, and therefore to deny liability."¹⁰⁹ In so holding, the Court emphasized that in order to serve copyright's constitutional end of promoting the progress of science and the useful arts, "copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work."¹¹⁰ As

104. See 4 NIMMER & NIMMER, *supra* note 98, § 13.03[E][1][a]; Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J. COPYRIGHT SOC'Y U.S.A. 719 (2010).

105. See, e.g., *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 180 (1st Cir. 2013) ("The court must 'be careful not to over-dissect the plaintiff's work, causing it to ignore the plaintiff's protectable expression.' Likewise, in making the holistic assessment, the court 'should take pains not to focus too intently on particular unprotected elements at the expense of a work's overall protected expression.'" (citation omitted)); *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977); *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1, 18–19 (9th Cir. 1933) (laying out the traditional audience test under which the spontaneous and immediate reaction of the audience is determinative).

106. See, e.g., *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001) (internal quotation marks omitted).

107. *Id.*

108. 499 U.S. 340 (1991).

109. 4 NIMMER & NIMMER, *supra* note 98, § 13.03[E][1][b].

110. *Feist Publications, Inc.*, 499 U.S. at 349–50.

Nimmer recognizes, by failing to meticulously remove the defendant's copying of ideas and information from consideration in assessing infringement, the audience test thus deviates from copyright's fundamental purpose.

To the extent that it allows consideration of unprotectable ideas and information, the audience test runs afoul of the First Amendment as well. The First Amendment guarantees speakers' right to copy, build upon, and reformulate ideas and information from existing works. Per *Golan*, the idea/expression dichotomy safeguards that First Amendment right by providing that "every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication."¹¹¹ A test for infringement that fails to adhere rigorously to the distinction between uncopyrightable idea and copyrightable expression belies the distinction's role as a built-in First Amendment accommodation and casts an unacceptable chill on protected speech.¹¹²

The Ninth Circuit has propounded a nominally different approach, one that, at least in principle, does a far better job than the audience test of enabling speakers to build freely on ideas in copyrighted works (even if it does not purport to address the indeterminacy of defining what counts as idea and what counts as expression). This approach requires that a copyright infringement plaintiff satisfy both the "extrinsic test" and the "intrinsic test."¹¹³ The intrinsic test is essentially the audience test and is always determined by the jury. However, the extrinsic test is supposed to require similarity of specific identifiable, copyrightable elements as determined by analytic dissection and expert testimony. As such, the extrinsic test provides an opportunity for the court to determine that, regardless of how an audience might spontaneously react, the defendant has not infringed as a matter of law. Unfortunately, the Ninth Circuit has applied the extrinsic test inconsistently in practice; indeed, successive Ninth Circuit panels have repeatedly complained of "the turbid waters of the extrinsic test."¹¹⁴ Nonetheless, by re-

111. *Golan v. Holder*, 132 S. Ct. 873, 890 (2012) (quoting *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003)).

112. See *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 179 (1st Cir. 2013) (citing *Golan* as well as *Feist* in support of the proposition that "assessing substantial similarity requires close consideration of which aspects of the plaintiff's work are protectable").

113. See *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1077 (9th Cir. 2006). Some form of the Ninth Circuit's extrinsic/intrinsic test for infringement has been applied by some courts in the Fourth, Eighth, and Eleventh Circuits as well. See, e.g., *Herzog v. Castle Rock Entm't*, 193 F.3d 1241, 1257 (11th Cir. 1999); *Dawson v. Hinshaw Music Inc.*, 905 F.2d 731, 733 (4th Cir. 1990); *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120 (8th Cir. 1987).

114. See *Swirsky v. Carey*, 376 F.3d 841, 848 (9th Cir. 2004) (internal quotation marks omitted); *Metcalfe v. Bochco*, 294 F.3d 1069, 1071 (9th Cir. 2002) (internal quotation marks omitted). To add to the confusion, early cases stated that the extrinsic test serves to determine the "similarity of general ideas," while the intrinsic test is meant to determine similarity of protectable expression. See, e.g., *Olson v. Nat'l Broad. Co.*, 855 F.2d 1446, 1449 (9th Cir. 1988); *Sid & Marty Krofft*

quiring rigorous analysis and a finding of similarity of identified copyrightable elements, the extrinsic test presents a potential model for courts to bring First Amendment interests to bear on the determination of copyright infringement.¹¹⁵

B. Fair Use

Like the idea/expression dichotomy, fair use doctrine as it has been actually developed, interpreted, and applied by the courts sometimes falls glaringly short of safeguarding freedom of speech. For about a decade—beginning with the Supreme Court’s ruling in *Harper & Row, Publishers, Inc. v. Nation Enterprises*¹¹⁶ in 1985 and continuing through the mid-1990s—courts applied an exceedingly narrow, market-centered understanding of fair use.¹¹⁷ That market-centered view arose from *Harper & Row*’s insistence that fair use is not a free speech safeguard that must be interpreted to ameliorate the tension between copyright and the First Amendment. *Harper & Row*, recall, posited that fair use is merely an equitable doctrine designed to allow uses only when the copyright owner’s consent to the use may be implied. Under that view, fair use is an anomalous exception to copyright. It should not be available unless the copyright owner would have agreed to license the use but was prevented from doing so by some market failure, such as when the costs of transacting for a license exceed any reasonable license fee. As *Harper & Row* put it, fair use is inappropriate unless a “reasonable copyright owner [would] have consented to the use” given the “importance of the material copied . . . from the point of view of the reasonable copyright owner.”¹¹⁸

In line with this approach, *Harper & Row* announced that the fourth factor—harm to the potential market for the copyrighted work—is “undoubtedly the single most important” factor for fair use analysis.¹¹⁹ It also set forth a presumption that any commercial use would cause market harm and thus could not be a fair use.¹²⁰ Further, *Harper & Row* and its progeny defined “commercial use”

Television Prods., Inc. v. McDonald’s Corp., 562 F.2d 1157, 1164 (9th Cir. 1977). The Ninth Circuit subsequently held that the extrinsic test applies to the similarity of both expression and ideas. See *Shaw v. Lindheim*, 919 F.2d 1353, 1356 (9th Cir. 1990) (referring, confusingly, to the similarity of protected ideas).

115. Cf. Eugene Volokh & Brett McDonnell, *Freedom of Speech and Independent Judgment Review in Copyright Cases*, 107 YALE L.J. 2431 (1998) (arguing that the First Amendment also requires that appellate courts independently review the factual bases for lower courts’ findings that the defendant infringed the plaintiff’s copyright, rather than deferring to the factfinder absent clear error).

116. 471 U.S. 539 (1985).

117. See Neil Weinstock Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715, 734–36 (2011).

118. *Harper & Row, Publishers, Inc.*, 471 U.S. at 549–50.

119. *Id.* at 566.

120. *Id.* at 562.

in circular fashion, not as a use for profit, but as using the copyrighted work without paying the customary price for that use¹²¹—even though, of course, in fair use analysis the question to be answered is supposed to be whether any price must be paid. In sum, the market-centered approach, having emptied the fair use privilege of its First Amendment import, effectively read the first three fair use factors out of the Copyright Act for many cases.¹²²

In 1994, however, in the seminal case *Campbell v. Acuff-Rose Music, Inc.*,¹²³ the Supreme Court announced a new, more expansive approach to fair use, and it is that approach that is dominant today.¹²⁴ In so doing, *Campbell* repudiated *Harper & Row's* market-centered approach, including *Harper & Row's* elevation of the fourth factor and presumption that commercial uses are not fair uses.¹²⁵ Under *Campbell*, the key to determining fair use is whether the use in question is “transformative.”¹²⁶ As lower courts have subsequently made clear, a use is transformative if the defendant uses the plaintiff’s work for a new expressive purpose that conveys a different message from that for which the original was created.¹²⁷ For example, the use of an artistic or literary work to criticize the original work, its author, or some general social phenomenon; to serve as biographical or historical information; or to serve as an information location tool as part of a lexicon or internet search engine is likely to be transformative so long as those purposes are different from the one for which the original was created.

Following *Campbell*, numerous courts have held that even copying an entire work can be a fair use so long as it is reasonably necessary for a transformative purpose.¹²⁸ Further, the Second Circuit has held and the Ninth Circuit has suggested that a finding that the use is transformative effectively trumps the fourth factor, that of potential market harm.¹²⁹ If the use is transformative, the copyright

121. *Id.*

122. The first three statutory fair use factors are (1) the purpose and character of the use, (2) the nature of the copyrighted work, and (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole. 17 U.S.C. § 107 (2006).

123. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

124. See Netanel, *supra* note 117, at 736–40.

125. *Id.* at 722–23. *Campbell* repudiated *Harper & Row* without explicitly rescinding it, just as *Golan* later countermanded *Harper & Row's* negation of fair use’s role as a free speech safeguard, without explicitly overruling that decision. See Beebe, *supra* note 95, at 596–97 (criticizing the Court for purporting to “reconstrue what it should have explicitly rescinded and replaced” in *Campbell* and *Harper & Row*).

126. *Campbell*, 510 U.S. at 579.

127. See Netanel, *supra* note 117, at 746–48.

128. See *id.* at 748 (finding that a startling number of recent cases have held that the use was transformative when the defendant copied the plaintiff’s work in its entirety).

129. See *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1165 (9th Cir. 2007) (declining to consider the possibility that the defendant’s highly transformative use would harm a potential

holder may not prevent the use by proactively licensing such transformative uses and then claiming that the defendant is harming copyright holder's potential market. Put another way, for purposes of fair use analysis, the "potential market" does not include markets for transformative uses.

In sum, the transformative use approach is considerably more solicitous of a speaker's need to copy expression to convey a new message effectively than the market-centered approach. As such, the transformative use approach does a significantly better job of serving as a First Amendment safeguard than did the market-centered approach.

That is all well and good, except that courts have yet expressly to anchor the transformative use approach in the First Amendment.¹³⁰ In addition, the transformative use approach as currently formulated might not extend to uses that fall within the same broad category of expressive purpose,¹³¹ such as entertainment or art, but which nonetheless use the copyrighted work as raw material to convey a very different message. Many remixes, mash-ups, and fan fiction derivative works convey very different messages and aim to reach a very different audience than do the works from which they copy. Yet many such new, creative works serve the same broad purpose of entertainment as the works they use as raw material, and thus might not receive favored treatment as transformative uses unless they target

market for the plaintiff's work when the plaintiff failed to present sufficient evidence that it already suffered market harm from the use); *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 614-15 (2d Cir. 2006) ("[A] copyright holder cannot prevent others from entering fair use markets merely 'by developing or licensing a market for parody, news reporting, educational or other transformative uses of its own creative work'" (quoting *Castle Rock Entm't, Inc. v. Carol Publ'g Grp., Inc.*, 150 F.3d 132, 145 n.11 (2d Cir. 1998))).

130. A number of lower courts have emphasized the interrelatedness of fair use and the First Amendment protection of free speech, even if they do not specifically invoke the transformative use approach in that connection. *See, e.g.*, *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1264 (11th Cir. 2001) ("First Amendment privileges are also preserved through the doctrine of fair use."); *Cariou v. Prince*, 784 F. Supp. 2d 337, 346 (S.D.N.Y. 2011) ("[T]he balance between the First Amendment and copyright is preserved, in part, by the idea/expression dichotomy and the doctrine of fair use." (quoting *Suntrust Bank*, 268 F.3d at 1263) (internal quotation marks omitted)); *Online Policy Grp. v. Diebold, Inc.*, 337 F. Supp. 2d 1195, 1200 (N.D. Cal. 2004) (stating that that the tension between copyright and the First Amendment is "ameliorated in part by various copyright doctrines," including fair use); *Wojnarowicz v. Am. Family Ass'n*, 745 F. Supp. 130, 147 (S.D.N.Y. 1990) ("[T]he breadth of fair use varies and where vital First Amendment concerns are implicated, as here, that breadth expands and accords greater protection to what might otherwise constitute an infringement.").
131. On the eve of this Article's publication, the Second Circuit issued a ruling that appears to recognize as "transformative" a use that conveys a different aesthetic message within the same broad category of expressive purpose. *See Cariou v. Prince*, No. 11-1197-CV, 2013 WL 1760521, at *6 (2d Cir. Apr. 25, 2013) (ruling that an artist's paintings and collages of the plaintiff's photographs were transformative because they "manifest an entirely different aesthetic" from the photographs), *rev'g in part and vacating in part* 784 F. Supp. 2d 337. It remains to be seen whether that more liberal interpretation will prevail.

the copied works for explicit criticism or comment. Finally, even under the transformative use approach, the defendant bears the burden of proving fair use. That allocation of burden of proof runs squarely against the standard First Amendment rule that the burden of proof as to constitutionally relevant facts must lie on the party who would stifle the speech, not the speaker herself.¹³² Hence, even the transformative use approach requires refinement if fair use is to fully serve as an effective First Amendment safeguard.¹³³

IV. VULNERABLE COPYRIGHT LEGISLATION

In *Golan*, the Supreme Court carved out a broad realm of immunity for copyright legislation from facial First Amendment challenges. It held that heightened First Amendment review is unwarranted when the statute in question “leaves undisturbed the ‘idea/expression’ distinction and the ‘fair use’ defense.”¹³⁴ But *Golan* makes clear that any Copyright Act provision that does eradicate, vitiate, or otherwise disturb either of copyright’s internal free speech accommodations would give rise to First Amendment scrutiny and serious First Amendment concern. As a result, current provisions of the Copyright Act—the anticircumvention provisions of the Digital Millennium Copyright Act—are vulnerable to First Amendment challenge, as is proposed legislation that would impose far-reaching liability on internet intermediaries for users’ infringements. I consider each in turn.

A. DMCA Anticircumvention

Say that I want to produce and post on YouTube a remix of short clips from Hollywood movies featuring femme fatales who are smoking cigarettes, clips that I wish to compile to show how Hollywood has made smoking seem sexy and has contributed to increased smoking among women. Given my critical, anti-smoking message, I would have a strong argument that my remix is fair use under the transformative use approach that predominates today. But let’s assume that some

132. See Ned Snow, *Proving Fair Use: Burden of Proof as Burden of Speech*, 31 CARDOZO L. REV. 1781 (2010); Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 LIQUORMART, and Bartnicki, 40 HOUS. L. REV. 697, 719–22 (2003).

133. One could argue as well that fair use doctrine could and should ameliorate the speech burdens wrought by copyright’s lengthy term by permitting uses of orphan works (works for which the copyright owner is unknown) or even of old works that are out-of-print. See William F. Patry & Richard A. Posner, *Fair Use and Statutory Reform in the Wake of Eldred*, 92 CALIF. L. REV. 1639, 1650–52 (2004); Jennifer M. Urban, *How Fair Use Can Help Solve the Orphan Works Problem*, 27 BERKELEY TECH. L.J. 1379 (2012).

134. *Golan v. Holder*, 132 S. Ct. 873, 890–91 (2012).

footage that I wish to include in my remix is available only on DVDs that are encrypted with Content-Scrambling System technology, or “CSS,” which is designed to prevent anyone from copying that footage or from viewing it on devices other than those that copyright holders have authorized. In that event, how am I to copy the clips and combine them to create my remix?

Well, there is software called DeCSS, which enables users to circumvent the restrictions imposed by CSS. The problem for me, however, is that the Digital Millennium Copyright Act makes it illegal for anyone to make or distribute software that is designed primarily to be used for circumventing technological controls on copyrighted material.¹³⁵ It is also illegal to use the software to circumvent the CSS technology. Unlike the manufacture and distribution prohibition (often called the “anti-device prohibition” because it bans devices primarily used for circumvention), the ban on the act of circumvention itself applies only to circumventing technological-protection measures that control access to a copyrighted work, not those that prevent unauthorized copying of a work.¹³⁶ However, courts have effectively treated measures that control both access and copying (what commentators have termed “hybrid measures”), as an access control, thus prohibiting their circumvention.¹³⁷ Courts have likewise defined CSS, which controls both viewing and copying, as such a hybrid measure that may not be circumvented.¹³⁸

Given the rampant piracy of copyrightable works in digital format and the emergence of potential markets for online access to those works, it is understandable that Congress would enact far-reaching provisions designed to protect the integrity of technological-protection measures. As some courts have interpreted the DMCA, however, those provisions make no exception for circumventing access controls or hybrid technological-protection measures when needed to engage in fair use.¹³⁹ That interpretation might seem surprising, given that the

135. See 17 U.S.C. §§ 1201(a)(2), (b) (2006).

136. See *id.* § 1201(a)(1)(A) (prohibiting the circumvention of technological measures that control access).

137. See R. Anthony Reese, *Will Merging Access Controls and Rights Controls Undermine the Structure of Anticircumvention Law?*, 18 BERKELEY TECH. L.J. 619, 640–47 (2003).

138. *Murphy v. Millennium Radio Grp. LLC*, 650 F.3d 295, 300 (3d Cir. 2011) (stating that DVD encryption controls access as well as copying and thus that its circumvention is actionable under the DMCA); *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 435–39 (2d Cir. 2001); *Realnetworks, Inc. v. DVD Copy Control Ass’n*, 641 F. Supp. 2d 913, 935 (N.D. Cal. 2009).

139. See, e.g., *Realnetworks, Inc.*, 641 F. Supp. 2d at 942 (“[F]air use can never be an affirmative defense to the act of gaining unauthorized access . . .”); *United States v. Elcom Ltd.*, 203 F. Supp. 2d 1111, 1124 (N.D. Cal. 2002); *Universal City Studios, Inc. v. Reimerdes*, 111 F. Supp. 2d 294, 322 (S.D.N.Y. 2000) (“If Congress had meant the fair use defense to apply to [anticircumvention cases], it would have said so.”), *aff’d sub nom. Corley*, 273 F.3d 429; see also *MDY Indus., LLC v. Blizzard Entm’t, Inc.*, 629 F.3d 928, 950 n.12 (9th Cir. 2010) (leaving “open the question [of] whether fair use might serve as an affirmative defense to a prima facie violation of § 1201”).

DMCA expressly provides that nothing in the anticircumvention provisions “shall affect rights, remedies, limitations, or defenses to copyright infringement, including fair use, under this title.”¹⁴⁰ But courts have read that provision to preserve fair use only as a defense to a claim for traditional copyright infringement. In that view, there is no defense to an alleged violation of the anticircumvention prohibition, even when the defendant circumvents a hybrid measure in order to engage in copying that would qualify as a fair use.

The leading case to adopt that view is *Universal City Studios, Inc. v. Corley*,¹⁴¹ decided by the Second Circuit in 2001, prior to Supreme Court’s rulings in *Golan* and *Eldred*. *Corley* held both that there is no fair use defense to violation of the DMCA and that the absence of such a fair use defense poses no First Amendment conflict.¹⁴² The appellants, who had posted DeCSS software on their website, argued that the DMCA unconstitutionally eliminates fair use as defense to its anticircumvention and anti-device provisions. The Second Circuit flatly rejected what it referred to as “this extravagant claim.”¹⁴³ It did so first on the grounds that the “Supreme Court has never held that fair use is constitutionally required.”¹⁴⁴ After *Golan* and *Eldred*, that statement is no longer good law. As those rulings make clear, the availability of the fair use defense is a necessary condition for copyright law to survive a First Amendment challenge.

However, in *Corley* the Second Circuit made a further argument for rejecting the appellants’ First Amendment challenge that does warrant consideration. “Fair use,” the court stated, “has never been held to be a guarantee of access to copyrighted material in order to copy it by the fair user’s preferred technique or in the format of the original.”¹⁴⁵ In other words, neither fair use nor the First Amendment requires that a user be able to use digital technology to make the best quality copy of copyrighted material. One who wishes to make fair use of a movie or TV show on a DVD could simply comment on its content, quote excerpts from its screenplay, or record the relevant portions through what is called “screen capture”—such as by pointing a video camera at a TV or computer monitor as the DVD is played.

140. 17 U.S.C. § 1201(c)(1); see Pamela Samuelson, *Intellectual Property and the Digital Economy: Why the Anti-circumvention Regulations Need to Be Revised*, 14 BERKELEY TECH. L.J. 519, 539–40 (1999) (stating that DMCA’s statement that the anticircumvention provisions shall not affect fair use might implicitly recognize that circumventing a technological protection measure for purposes of engaging in fair use would be lawful).

141. 273 F.3d 429.

142. See *id.* at 429.

143. *Id.* at 458.

144. *Id.*

145. *Id.* at 459.

This argument raises a fascinating question: Even if fair use secures a given speaker's right to copy copyrighted material for a particular use, does that necessarily mean that the speaker is entitled to make a direct digital copy? Might, rather, the speaker be relegated to screen capture or some other technique, even if it might be more difficult and expensive and might result in a copy of lesser quality than direct digital copying? The case law does not provide a definitive answer. But in light of *Golan* and other cases, the more plausible argument is that there must be a fair use defense to the DMCA anticircumvention prohibition, lest the DMCA run afoul of the First Amendment.

First of all, in a recent report on the impact of the DMCA anticircumvention provisions, the U.S. Register of Copyrights found that screen capture is often not an adequate substitute for using digital technology to make direct digital copies of portions of movies and of TV shows.¹⁴⁶ Despite some improvements in recent years, screen capture technology often results in "diminished . . . clarity and depth, and may exhibit some degree of pixelation."¹⁴⁷ As a result, it might not be possible to engage in fair use effectively without making a direct digital copy of the relevant portion of a movie or TV show. As high school educators testified before the Copyright Office, "using lower-quality material can dilute the emotional impact and the force of the message, thus weakening the effect and educational value of the use."¹⁴⁸ And as the Register similarly found, "diminished quality likely would impair the criticism and comment contained in noncommercial videos."¹⁴⁹ In that vein, the Register concluded, the ability to make direct digital copies can sometimes be pivotal to engaging in fair use for purposes of film criticism, documentary films, nonfiction multimedia ebooks, teaching about film and the subjects covered in films, and producing noncommercial videos, such as remix and mash-up videos.¹⁵⁰

Further, there is a line of cases in which courts have held that government restrictions on expressive media that speakers wish to use to convey their message is an unconstitutional abridgement of freedom of speech. Most recently, in its May 2012 decision *American Civil Liberties Union v. Alvarez*,¹⁵¹ the Seventh

146. MARIA A. PALLANTE, REGISTER OF COPYRIGHT, SECTION 1201 RULEMAKING: FIFTH TRIENNIAL PROCEEDING TO DETERMINE EXEMPTIONS TO THE PROHIBITION ON CIRCUMVENTION 108 (Oct. 2012) [hereinafter REGISTER'S REPORT].

147. *Id.* at 133; *see also* Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies, 77 Fed. Reg. 65,260, 65,268 (Oct. 26, 2012) (codified at 37 C.F.R. pt. 201.40).

148. REGISTER'S REPORT, *supra* note 146, at 122.

149. *Id.* at 133.

150. *Id.* at 133–35.

151. 679 F.3d 583 (7th Cir. 2012), *cert. denied*, 133 S. Ct. 651 (2012).

Circuit considered a First Amendment challenge to Illinois prosecutors' planned use of a state eavesdropping statute to bring felony indictments against individuals who make audiovisual recordings of police officers performing their duties in public places and speaking at a volume audible to bystanders.¹⁵² The district court had held that there is no First Amendment right to make an audio recording.¹⁵³ Rather, the police watchdogs could write down the words of the police in shorthand or simply remember them for later transcription.

The Seventh Circuit reversed. Audio and audiovisual recordings, it held, "are media of expression commonly used for the preservation and dissemination of information and ideas and thus are 'included within the free speech and free press guaranty of the First and Fourteenth Amendments.'"¹⁵⁴ As the court explained:

The act of *making* an audio or audiovisual recording is necessarily included within the First Amendment's guarantee of speech and press rights as a corollary of the right to disseminate the resulting recording. The right to publish or broadcast an audio or audiovisual recording would be insecure, or largely ineffective, if the antecedent act of *making* the recording is wholly unprotected By way of a simple analogy, banning photography or note-taking at a public event would raise serious First Amendment concerns; a law of that sort would obviously affect the right to publish the resulting photograph or disseminate a report derived from the notes.¹⁵⁵

In support of its ruling, the Seventh Circuit cited a long line of cases holding that laws that foreclose an entire a medium of expression in a particular context inevitably burden the expression itself, and thus give rise to First Amendment scrutiny.¹⁵⁶ Such expressive media includes, among others, residential signs, ink and paper, spending money on political campaigns, tattoo parlors, amplification equipment, and the Internet.¹⁵⁷ Government regulation of digital recording

152. *Id.*

153. *Id.* at 589.

154. *Id.* at 595 (quoting *Burstyn v. Wilson*, 343 U.S. 495, 502 (1952)).

155. *Id.* at 595–96.

156. *Id.* at 595–97.

157. *See, e.g.*, *Reno v. Am. Civil Liberties Union*, 521 U.S. 844 (1997) (Internet); *City of Ladue v. Gilleo*, 512 U.S. 43 (1994) (residential signs); *Ward v. Rock Against Racism*, 491 U.S. 781 (1989) (holding that a municipal ordinance restricting the decibel level at rock concerts passed the First Amendment scrutiny applicable to content-neutral speech regulation); *Minneapolis Star & Tribune Co. v. Minn. Comm'r of Revenue*, 460 U.S. 575 (1983) (paper and ink); *Buckley v. Valeo*, 424 U.S. 1 (1976) (campaign spending); *Anderson v. City of Hermosa Beach*, 621 F.3d 1051 (9th Cir. 2010) (tattoo parlors). *But see* *Kovacs v. Cooper*, 336 U.S. 77 (1949) (holding that a local ordinance barring sound trucks from broadcasting in a loud and raucous manner did not raise a First Amendment concern).

technology that severely burdens constitutionally protected fair use likewise raises serious First Amendment concerns.

Further, as my colleague Eugene Volokh has convincingly demonstrated, the freedom of the press—now seen as inextricably intertwined with freedom of speech—has long stood for the freedom of any individual to use the technology of mass communication, not the protection of the press as a particular industry.¹⁵⁸ Government regulation that suppresses individuals' use of communication technology may thus give rise to First Amendment scrutiny on that score as well. Indeed, in enacting the DMCA, Congress recognized that the anticircumvention provisions could be interpreted to burden freedom of speech and of the press. The DMCA declares that nothing in the anticircumvention provisions "shall enlarge or diminish any rights of free speech or the press for activities using consumer electronics, telecommunications, or computing products."¹⁵⁹ The First Amendment would obviously invalidate any statutory diminution of the constitutional right of freedom speech or of the press regardless of that statutory declaration. But the declaration provides yet another ground for insisting that the DMCA anticircumvention provisions be interpreted in line with First Amendment strictures.

Granted, simply because government regulation of communication technology gives rise to First Amendment scrutiny does not mean that it is always stricken down, particularly when the government regulation is content neutral. Nonetheless, the DMCA's prohibition of the use of circumvention technology needed to engage in effective, constitutionally protected fair use would seem to run afoul of the First Amendment. The recent Register of Copyrights's finding that direct digital copying is required in some instances to engage in effective fair use belies the suggestion of early judicial rulings that the ability to copy "the old fashioned way, by hand or by re-typing, rather than by 'cutting and pasting' from existing digital media" is sufficient for the DMCA to pass First Amendment muster.¹⁶⁰ Under *Golan*'s definitional balancing approach, fair use copying should enjoy an absolute privilege against liability under the DMCA.

Yet our assessment of whether there must be a fair use defense to the anticircumvention provisions for the DMCA to pass First Amendment muster must also consider the statutory background for the Register's finding. The DMCA provides for a three-year exemption from the anticircumvention prohibitions for those whom the Librarian of Congress finds must circumvent tech-

158. See Eugene Volokh, *Freedom for the Press as an Industry, or for the Press as a Technology? From the Framing to Today*, 160 U. PA. L. REV. 459 (2012).

159. 17 U.S.C. § 1201(c)(4) (2006).

160. *United States v. Elcom Ltd.*, 203 F. Supp. 2d 1111, 1131 (N.D. Cal. 2002).

nological protection measures in order “to make noninfringing uses . . . of a particular class of copyrighted works.”¹⁶¹ The Register made her findings in the context of the Librarian’s triennial rulemaking proceedings. And in the latest triennial rulemaking issued in October 2012, the Librarian, indeed, issued a three-year exemption from the anticircumvention prohibition for circumventing technological protection measures on movies and television programs (including CSS) as needed to engage in various enumerated types of fair use. Among the fair uses of movies and television programs covered by the exemption are those pertaining to film criticism, teaching about film and the subjects covered in films, and producing documentary films, nonfiction multimedia ebooks, and noncommercial videos. The question that then arises is whether the Librarian’s triennial rulemaking and consequent three-year exemption from the anticircumvention prohibition as needed to engage in fair use are sufficient for First Amendment purposes. Must courts also recognize a fair use defense to the anticircumvention prohibitions, or does the triennial rulemaking serve as an adequate substitute?

The answer is that the triennial rulemaking does not suffice; a fair use defense to the anticircumvention prohibitions should be required for the DMCA to pass First Amendment muster. First, the Librarian’s rulemaking is necessarily limited to a generalized determination regarding categories of uses of entire classes of copyrightable works.¹⁶² In providing a three-year exemption, the Librarian makes a determination that a given type of use of a particular class of work is primarily fair use and that the anticircumvention provisions adversely affect persons’ ability to make such noninfringing uses. But fair use—and the First Amendment—requires an individualized determination. There may be numerous instances of a need to circumvent in order to engage in fair use that do not fall within one of the exempt classes.

In the latest rulemaking, for example, the Librarian declined to exempt the act of circumventing CSS in order to copy short clips of existing movies and television shows for inclusion in fictional, as opposed to documentary, films.¹⁶³ The Librarian adopted the Register’s finding that there was insufficient evidence that copying another’s work in a fictional film, the purpose of which is typically for entertainment, is likely to be a fair use.¹⁶⁴ Given his mandate, the Librarian’s position is understandable. It might well be that including clips in fictional films

161. 17 U.S.C. § 1201(a)(1)(C).

162. See Elizabeth F. Jackson, *The Copyright Office’s Protection of Fair Uses Under the DMCA: Why the Rulemaking Proceedings Might Be Unsustainable and Solutions for Their Survival*, 58 J. COPYRIGHT SOC’Y U.S.A. 521, 531 (2011).

163. Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies, *supra* note 147, at 65,266.

164. *Id.* at 65,268.

are far less often a transformative fair use than when clips are inserted in documentaries. But including a clip from another movie in a fictional film might *sometimes* be fair use, such as when it serves the purpose of parody or social criticism. And unless fictional-film producers can rely on the fair use defense in such cases, they will be relegated to same screen capture technology that the Register found is often inadequate for effective fair use.

Second, the triennial rulemaking only exempts the act of circumvention. The DMCA's device prohibitions remain in full force regardless of any determination by the Librarian that circumvention is needed to engage in fair use. As a result, even persons legally entitled to circumvent might be unable to do so because it remains illegal to manufacture or distribute software and other devices that users need to circumvent regardless of whether the user is exempted from the anticircumvention prohibition. The DMCA prohibits the manufacture or distribution of any technology or device that "is primarily designed or produced for the purpose of circumventing" a technological-access or copy-control measure.¹⁶⁵ It does not exempt technologies or devices that are primarily or substantially used, or that may be required, to engage in circumvention that is permitted by the Librarian's triennial rulemaking.

Putting together the need to circumvent and make digital copies in order to engage in fair use, First Amendment protection for using technologies of expression, and the inadequacy of the triennial rulemaking in enabling all fair uses that require circumvention to be effective, the DMCA, I would argue, is vulnerable to First Amendment challenge following *Golan*. At the very least, *Golan* strongly suggests that courts must recognize an appropriate fair use defense to violations of the DMCA anticircumvention and device prohibitions.

B. Intermediary Liability

In addition to its anticircumvention prohibitions, the DMCA included a safe harbor from copyright liability for internet service providers.¹⁶⁶ In enacting the safe harbor, Congress sought to balance competing concerns regarding the dangers of massive internet piracy versus the prospect that internet service providers facing the risk of liability for their subscribers' copyright infringements—on a theory of contributory or vicarious liability—might "hesitate to make the necessary investment in the expansion of the speed and capacity of the

165. 17 U.S.C. §§ 1201(a)(2), (b) (devices that circumvent access controls and devices that circumvent copy controls).

166. Digital Millennium Copyright Act of 1998, Pub. L. No. 105-304, § 202, 112 Stat. 2860, 2877–86 (codified as 17 U.S.C. § 512).

Internet.¹⁶⁷ The DMCA safe harbor was the product of a carefully calibrated compromise, following intensive negotiations, between the copyright and telecommunications industries.¹⁶⁸ Yet the copyright industries are, today, unhappy with how the DMCA safe harbor has been applied and interpreted by a number of courts. They have lobbied for legislation, notably the highly controversial and now-defunct Stop Online Piracy Act,¹⁶⁹ that would impose broad liability on internet intermediaries for facilitating access to infringing content. Copyright owners have also argued in court for interpretations of the DMCA safe harbor that would effectively impose on internet service providers affirmative duties to police and filter out allegedly infringing content.¹⁷⁰

Coincidentally, the Supreme Court issued its ruling in *Golan v. Holder* on the same day as Wikipedia and other internet sites went dark to protest what they regarded as SOPA's threat to online speech.¹⁷¹ While *Golan* does not specifically address the SOPA controversy, it leaves in place traditional First Amendment constraints on imposing liability on media and other speech intermediaries who provide platforms, access, and financial support for illegal content. *Golan* further suggests that any proposed legislation that would impose sweeping liability on intermediate intermediaries for facilitating access to infringing content must be subject to First Amendment scrutiny to ensure that it does not unduly chill fair use and other protected speech.

Internet intermediaries and other third parties—internet service providers, advertisers, search engines, and payment processors—make it possible for internet communications to thrive. Web sites, blogs, and user-generated content sites, like YouTube, need internet service providers to make those sites readily accessible to users over the internet and need search engines that enable users to find them. Bloggers, site operators, and others who wish to earn revenue or recover costs from their communications rely on advertisers and payment processors.

167. S. REP. NO. 105-190, at 8 (1998).

168. JESSICA LITMAN, *DIGITAL COPYRIGHT* 134–35 (Prometheus Books 2006) (describing the arduously parsed compromise between content and telecommunications industry representations).

169. Stop Online Piracy Act, H.R. 3261, 112th Cong. § 103(a)(1)(B) (2011).

170. *See, e.g.*, Supplemental Brief in Support of Petition for Rehearing and Rehearing *En Banc* per June 7 Order at 7–8, 14–17, *UMG Recordings, Inc. v. Shelter Capital Partners LLC*, Nos. 09-55902 & 09-56777 (9th Cir. June 28, 2012) (arguing that the DMCA safe harbor should be unavailable if the internet service provider (1) is aware of facts or circumstances from which infringing activity is generally apparent and fails to police to uncover specific acts of infringement or (2) would be liable for its users' infringement under the common-law standard for vicarious liability).

171. *See SOPA Petition Gets Millions of Signatures as Internet Piracy Legislation Protests Continue*, WASH. POST, Jan. 20, 2012, http://www.washingtonpost.com/business/economy/sopa-petition-gets-millions-of-signatures-as-internet-piracy-legislation-protests-continue/2012/01/19/gIQAHaAyBQ_story.html; *see also* Jonathan Weisman, *Web Rises Up to Deflect Bills Seen as Threat*, N.Y. TIMES, Jan. 19, 2012, at A1.

Were such third parties to face unconstrained strict liability for any infringing content that they might be deemed to support and facilitate, they would have a strong incentive to overpolice, to bend over backwards to desist from providing their services for any content that might possibly be infringing.¹⁷² They might, for example, remove links or prevent transmissions from an entire website or affiliated series of websites alleged to contain some infringing content, rather than seek to target just the content itself. They might also target any content that copies from other works without regard to whether those works are protected by copyright or to whether that copying is fair use, the copying of ideas and information, or truly infringing. The result would be what one commentator has aptly labeled “censorship by proxy”: Risk-averse internet intermediaries would block fair use, content that copies only ideas and information, and other noninfringing First Amendment-protected speech.¹⁷³

Courts have long recognized that imposing liability for illegal content on intermediaries and on other third parties who did not produce that content may result in third-party overpolicing and thus violate the First Amendment. In *Smith v. California*,¹⁷⁴ decided in 1959, the Supreme Court invalidated a California statute that made it a crime for bookstore owners to stock books that were later judicially determined to be obscene, even if the owner did not know of the books' contents. The Court held that the statute contravened the First Amendment, reasoning that “if the bookseller is criminally liable without knowledge of the contents, . . . he will tend to restrict the books he sells to those he has inspected; and thus the State will have imposed a restriction upon the distribution of constitutionally protected as well as obscene literature.”¹⁷⁵

Likewise, in *Denver Area Educational Telecommunications Consortium, Inc. v. FCC*,¹⁷⁶ decided in 1996, the Supreme Court held unconstitutional provisions of the Cable Television Consumer Protection and Competition Act of 1992, which required cable networks to place “patently-offensive” leased-channel programs on a separate channel and to block that channel absent a specific written request to view it. Among the reasons the Court gave in support of its holding, the Court found that the requirement would likely encourage cable networks to overpolice. Networks might simply ban any potentially troublesome programming rather

172. See generally Assaf Hamdani, *Who's Liable for Cyberwrongs?*, 87 CORNELL L. REV. 901 (2002) (discussing the problem of internet service provider liability and thus resulting perverse incentive of overdeterrence).

173. Seth F. Kreimer, *Censorship by Proxy: The First Amendment, Internet Intermediaries, and the Problem of the Weakest Link*, 155 U. PA. L. REV. 11 (2006).

174. 361 U.S. 147 (1959).

175. *Id.* at 153.

176. 518 U.S. 727 (1996).

than bearing the “costs and burdens” of monitoring programs for “patently offensive” content, setting up separate channels to house that content, and responding to viewer requests.¹⁷⁷

*New York Times Co. v. Sullivan*¹⁷⁸ was also, in large part, about sharply limiting the exposure of speech intermediaries—this time in the form of newspapers—for displaying other speakers’ allegedly defamatory content.¹⁷⁹ The defamation action against the *New York Times* centered on a civil rights organization’s advertisement that appeared in the paper, not the *Times*’s own reporting or editorial content. The Court recognized that the *Times* accepted such advertisements with only limited fact checking, but applied the actual malice standard to protect the newspaper from liability for defamation arising from its display of third-party content that allegedly defamed a public official. To deny First Amendment protection to the newspaper for such speech, the Court held, “would discourage newspapers from carrying ‘editorial advertisements’ of this type, and so might shut off an important outlet for the promulgation of information and ideas by persons who do not themselves have access to publishing facilities—who wish to exercise their freedom of speech even though they are not members of the press.”¹⁸⁰ In so holding, the Court emphasized that imposing liability on intermediaries is especially troublesome since risk-averse intermediaries will “tend to restrict the public’s access to forms of the printed word which the State could not constitutionally suppress directly.”¹⁸¹

The communication of speech on the internet relies not on a single type of intermediary like bookstores, cable networks, or newspapers but on a wide spectrum of access providers, search engines, and platforms. In that realm, Congress has enacted a statutory First Amendment safeguard that sharply limits intermediary liability and thus effectively eliminates the incentive for internet intermediaries to overpolice. Section 230 of the Communications Decency Act of 1996 provides that “[n]o provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another

177. *Id.* at 753–54. Courts have also held unconstitutional legislation requiring cable television operators to choose between specified methods of blocking children’s access to sexually oriented programming and legislation requiring internet service providers to filter out child pornography, because both types of legislation effectively induced the intermediaries to choose to block access to First Amendment-protected speech as well. *United States v. Playboy Entm’t Grp., Inc.*, 529 U.S. 803, 811 (2000) (cable operator); *Ctr. for Democracy & Tech. v. Pappert*, 337 F. Supp. 2d 606, 650–51, 656 (E.D. Pa. 2004) (internet service provider).

178. 376 U.S. 254 (1964).

179. See Rebecca Tushnet, *Power Without Responsibility: Intermediaries and the First Amendment*, 76 GEO. WASH. L. REV. 986, 1005–06 (2008) (describing this facet of the *Sullivan* case).

180. *Id.* at 266.

181. *Id.* at 278–79 (quoting *Smith v. California*, 361 U.S. 147, 153–54 (1959)).

information content provider.”¹⁸² In other words, broadband companies that deliver internet communications cannot be held liable for the content of those communications. Nor can operators of websites, blogging services, search engines, user-generated content sites, or social networking sites be held liable for content or information that users post on such sites or over those networks.

The Section 230 privilege applies to a broad array of communications torts.¹⁸³ As such, it obviates the need for direct First Amendment scrutiny of internet service provider liability in those areas. That is not to say that internet service provider liability would be constitutionally permissible were Congress to terminate the Section 230 privilege. That would depend on the definitional balancing rules that courts have applied to the relevant communications torts. But as it stands, the Section 230 privilege safeguards the First Amendment interest in preventing government regulators or litigants enforcing private rights of action from enlisting intermediaries to censor by proxy.

Significantly for our purposes, the Section 230 privilege does not extend to copyright or to alleged infringements of other intellectual property rights. Internet service providers are not left entirely exposed to potential liability for users’ copyright infringements, however. The Copyright Act contains a safe harbor from internet service provider liability, enacted as part of the DMCA.¹⁸⁴

The safe harbor provisions are complex and, in some respects, ambiguous. They have spawned considerable litigation, including a still-pending billion-dollar copyright infringement action brought by Viacom against YouTube, which turns on whether YouTube fit within the safe harbor in its early years or whether it faces liability for the massive number of infringements committed by its users.¹⁸⁵ But, basically, the safe harbor provisions place the burden of policing copyright infringement on the copyright holder, not the internet service provider. The safe harbor, the DMCA provides, is not conditional on “a service provider monitoring its service or affirmatively seeking facts indicating infringing activity.”¹⁸⁶ In

182. 47 U.S.C. § 230(c)(1) (2006).

183. *See, e.g.*, *Johnson v. Arden*, 614 F.3d 785, 792 (8th Cir. 2010) (holding that an internet service provider was immune from a state defamation claim); *Universal Commc’n Sys., Inc. v. Lycos, Inc.*, 478 F.3d 413, 419 (1st Cir. 2007) (affirming immunity of an internet message board operator against allegedly false and defamatory postings by pseudonymous posters); *Batzel v. Smith*, 333 F.3d 1018, 1032–33 (9th Cir. 2003) (holding that even if an operator of internet services could have reasonably concluded that the information was sent for internet publication, he was immunized from liability for the defamatory speech as a provider or user of interactive computer services under the CDA).

184. 17 U.S.C. § 512 (2006).

185. *Viacom Int’l, Inc. v. YouTube, Inc.*, 676 F.3d 19 (2d Cir. 2012) (remanding to the district court for further findings).

186. 17 U.S.C. § 512(m)(1).

return, the internet service provider must comply with a notice and takedown procedure, in which copyright holders can provide written notice to the service provider of specific infringing content on the provider's site (or to which the provider is linking if the provider is a search engine).

Importantly, in sending the notice, the copyright holder must affirm on penalty of perjury that it owns the copyright in the allegedly infringed work and that it has a good-faith belief that the use is infringing.¹⁸⁷ Upon its receipt of a compliant DMCA takedown notice, the provider must promptly remove the content (or link). However, the service provider must also notify the person who posted the content, who then has the opportunity to file a counter-notice asserting that the content is not, in fact, infringing. The provider must then reinstate the content pending a further notice from the copyright holder that the copyright holder has filed an action seeking a court order to restrain the alleged infringement.¹⁸⁸

The DMCA safe harbor provisions thus provide for individualized consideration of whether specific content is infringing. They also set out a mechanism for the user to resist the removal of noninfringing content. As the Ninth Circuit has noted, that individualized consideration and opportunity for the accused infringer to be heard has First Amendment import: "Accusations of alleged infringement have drastic consequences: A user could have content removed, or may have his access terminated entirely. If the content infringes, justice has been done. But if it does not, speech protected under the First Amendment could be removed."¹⁸⁹

Even with those First Amendment protections in place, the DCMA notice and takedown procedure has sometimes been flagrantly abused. A nontrivial number of takedown notices are sham claims used to silence critics or wholesale notices generated by automated search technology that sweeps noninfringing fair uses as well as infringing uses into its net.¹⁹⁰ But the DMCA notice and takedown

187. *Id.* § 512(c)(3).

188. *Id.* § 512(g).

189. *Perfect 10, Inc. v. CCBill LLC*, 488 F.3d 1102, 1112 (9th Cir. 2007) (holding that a copyright holder's takedown notice that did not comply with the statutory requirements was not effective).

190. Annemarie Bridy, *Is Online Copyright Enforcement Scalable?*, 13 VAND. J. ENT. & TECH. L. 695, 715 (2011) (noting that "notices of infringement have been used to censor speech that copyright owners find offensive and to suppress unlicensed uses of copyrighted works that are colorably fair"); Neil Weinstock Netanel, *Impose a Noncommercial Use Levy to Allow Free Peer-to-Peer File Sharing*, 17 HARV. J.L. & TECH. 1, 12–13 (2003) (noting numerous instances in which risk-averse internet service providers and search engines have removed subscriber content in the face of takedown notices' dubious copyright infringement claims); Wendy Seltzer, *Free Speech Unmoored in Copyright's Safe Harbor: Chilling Effects of the DMCA on the First Amendment*, 24 HARV. J.L. & TECH. 171, 210–20 (2010) (describing numerous examples of error and abuse in sending takedown

procedure at least provides some recourse for speakers whose noninfringing speech has been removed.¹⁹¹ In addition to the possibility of filing a counter-notice, the DMCA provides that a speaker who suffers a wrongful takedown may recover damages from the copyright holder upon a showing that the takedown notice contained material misrepresentations.¹⁹² And according to one district court ruling, the copyright holder's failure to consider whether the allegedly infringing content is a fair use flies in the face of the holder's sworn statement that it has a good-faith belief that the use is infringing. This failure thus constitutes a potentially actionable material misrepresentation, at least when the use in question is unequivocally a fair use.¹⁹³

Despite having agreed to the compromise that was codified in the DMCA, the copyright industries continue to insist that internet service providers—and other third parties—must bear primary responsibility for policing the Internet for infringement. Copyright industries have lobbied for legislation that would effectively supersede the DMCA safe harbor provisions. In particular, the Stop Online Piracy Act, which has been shelved for the time being, would have presented a combination of requirements and inducements for internet service providers, search engines, payment processors, and advertisers to cease providing access, service, linking, and funds to websites alleged to be “committing or facilitating the commission” of an online copyright infringement (even if much of the content on those websites would be neither infringing nor facilitating others' infringements).¹⁹⁴

In addition, copyright industry litigants have asserted that service providers must implement proactive filtering technology in order to enjoy the DMCA safe

notices); Jennifer M. Urban & Laura Quilter, *Efficient Process or “Chilling Effects”? Takedown Notices Under Section 512 of the Digital Millennium Copyright Act*, 22 SANTA CLARA COMPUTER & HIGH TECH. L.J. 621 (2006) (presenting the results of a study of nearly 900 takedown notices collected by the Chilling Effects project and finding that a large number of such notices present spurious claims).

191. *But see generally* Seltzer, *supra* note 190 (arguing that the DMCA notice and takedown procedures nevertheless constitute an unconstitutional prior restraint on speech since they encourage service providers to remove allegedly infringing content prior to a judicial determination of the copyright infringement allegation).

192. 17 U.S.C. § 512(f).

193. *Lenz v. Universal Music Corp.*, 572 F. Supp. 2d 1150, 1154–55 (N.D. Cal. 2008). *But cf.* *Lenz v. Universal Music Corp.*, No. 5:07-CV-03783-JF, 2013 WL 271673 (N.D. Cal. Jan. 24, 2013) (holding, in denying both sides' cross-motions for summary judgment, that willful blindness or subjective bad faith intent is required for liability for material misrepresentation).

194. Stop Online Piracy Act, H.R. 3261, 112th Cong. §§ 102(a), (c), 103, 104 (2011); Michael A. Carrier, *SOPA, PIPA, ACTA, TPP: An Alphabet Soup of Innovation-Stifling Copyright Legislation and Agreements*, 11 NW. J. TECH. & INTELL. PROP. 21 (2013); Mark Lemley et al., *Don't Break the Internet*, 64 STAN. L. REV. ONLINE 34, 37–38 (2011).

harbor.¹⁹⁵ Courts have thus far rejected that assertion, but a number of service providers, including YouTube, have voluntarily implemented content filters that use metadata provided by copyright holders to automatically block putatively infringing content. Those filters cannot always distinguish between infringing and noninfringing content. In the summer of 2012, for example, YouTube's filter erroneously took down the official live stream of the Democratic National Convention, replacing it with a notice over a black screen indicating that the blocked video contained content from Associated Press, Dow Jones, New York Times Digital, and several other copyright holders, "one or more of whom have blocked it in your country on copyright grounds."¹⁹⁶

Legislation that requires or provides incentives to intermediaries to engage in wholesale filtering or policing of copyright infringements without providing for an expeditious procedure for individualized consideration and reinstatement of noninfringing content would run afoul of the First Amendment.¹⁹⁷ So would legislation requiring that payment intermediaries withhold payments to websites that purportedly contain infringing material.¹⁹⁸ Such legislation poses an unacceptable danger of intermediary overpolicing. It would result in the chilling and suppression of fair use copying and other First Amendment-protected speech, not just the removal of copyright-infringing material.

195. See, e.g., Reply Brief for Plaintiffs-Appellants at 5, *Viacom Int'l, Inc. v. YouTube, Inc.*, 676 F.3d 19 (2d Cir. 2012) (No. 10-3270) (contending that YouTube should not benefit from the DMCA safe harbor because it could have curbed its users' infringements by deploying reasonably priced and commercially available digital fingerprint filtering technology but implemented filtering only as part of revenue deals with specific content partners).

196. Britney Fitzgerald, *YouTube Pulls Michelle Obama's Democratic National Convention Speech in 'Error'*, HUFFINGTON POST (Sept. 5, 2012, 5:18 PM), http://www.huffingtonpost.com/2012/09/05/youtube-pulls-michelle-obama-speech_n_1857708.html.

197. Of note, the European Court of Justice has ruled that an injunction requiring an Internet Service Provider to install and maintain a blanket copyright filtering system would violate the freedom to receive or impart information guaranteed by the Charter of Fundamental Rights of the European Union because the filtering system might fail adequately to distinguish between lawful and unlawful content. Case C-70/10, *Scarlet Extended SA v. Société Belge des Auteurs, Compositeurs et Éditeurs SCRL (SABAM)* ¶¶ 50-52 (Nov. 24, 2011), <http://curia.europa.eu/juris/document/document.jsf?text=&docid=115202&pageIndex=0&doclang=EN>.

198. Prohibiting or restricting payment for communication has long been treated as an abridgement of speech, giving rise to First Amendment scrutiny. See, e.g., *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 105 (1991) (invalidating New York's "Son of Sam" law, which prevented criminals from profiting from publishing deals by impounding the receipts).

CONCLUSION

At superficial glance, the Supreme Court's ruling in *Golan* might seem to shut the door on First Amendment constraints on copyright. However, *Golan* maintains and, in some respects, fortifies those constraints. *Golan* makes clear that copyright law's idea/expression dichotomy and fair use privilege both have constitutional import. Indeed, in line with the definitional balancing approach that *Golan* appears to embrace, *Golan* strongly suggests that copyright law would not withstand First Amendment scrutiny but for those built-in First Amendment accommodations. Courts must, accordingly, interpret and apply the idea/expression dichotomy and fair use privilege in a manner consistent with their vital First Amendment role. Further, following *Golan*, statutory provisions that disturb copyright's built-in First Amendment accommodations, or that otherwise abridge noninfringing speech, lie vulnerable to First Amendment challenge. In short, far from abrogating the tension between copyright and the First Amendment, *Golan* reaffirms that copyright law poses a First Amendment paradox that cannot be ignored.