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COPYRIGHTS AND COPYREMEDIES: UNFAIR USE AND INJUNCTIONS

Honorable James L. Oakes *

Many areas of law contain doctrinal underpinnings that on closer analysis collapse into themselves. One aspect of the law leads to another, that to a third, and so on, until the observer is back at his starting point and he knows little more than when he started. Analysis, rather than leading to an end result, takes him back to his starting premises.¹ We have long seen this phenomenon in constitutional law as when considering which rights are "fundamental" or which classifications "suspect" in equal protection analysis.² Ten years ago I suggested what I am calling collapsibility (with a nod of acknowledgment to Professor Lance Liebman) in respect to takings law.³ In takings law, two diametrically opposed lines of cases are available to

* Chief Judge, United States Court of Appeals for the Second Circuit. This Article is adapted from the Howard Kaplan Memorial Lecture, delivered by Chief Judge Oakes on May 3, 1989, at the Hofstra University School of Law.

1. See L. Fuller, The Law in Quest of Itself 1 (1940); G. Gilmore, The Death of Contract 3-4 (1974); O. Holmes, The Common Law 13 (1943) (remarking that the distinction between tort and breach of contract is not "found ready made").


the decision maker. The Supreme Court has come close to proving they are collapsible with *Keystone Bituminous Coal Association v. DeBenedictus*, where it held that a state law requiring coal mines to provide support for surface housing was not a taking, the diametric opposite of the oft-cited holding in *Pennsylvania Coal Co. v. Mahon*, where a similar statute was held to be a taking.

Various attempts to break out of the "collapsible" doctrine are regularly made. Thus Judge Posner, for example, by using the tool of economic analysis, has tried to make such a break in respect to property, contract, and tort doctrines, among others. For the working judge, Justice Kaplan has pointed out that it is sometimes better when the judge seeks to formulate a rule of law that is both finely tuned to accommodate the universal interests and demands at play, as well as to do justice or equity in the individual case, to look to the remedy rather than merely to the substantive rule of law — at least to look to the relationship between the substantive rule of law and the remedy or remedies that the courts may afford in a given case. This seems simplistic, yet the history of the common law — the relationship between writ and right — supports its efficacy. For example, because we sense that the right to claim damages for expectation losses is a little less worthy of protection than the right to claim damages for reliance losses, we learn things about the substantive rights of a defrauded securities seller or buyer or an executory con-

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4. Id. at 609-21 (discussing recent Supreme Court takings cases with inconsistent results).
7. R. Posner, *Economic Analysis of Law* (2d ed. 1977). Richard Posner, for example, posits that the long-held differentiation between intentional and unintentional torts is "not a fruitful one." Id. at 120; see also G. Gilmore, *The Ages of American Law* 131 n.35 (1977) (pointing out that Posner has been an influential spokesman for the point of view that both laissez-faire economic theory and the legal structure were sound and, to the extent we have abandoned either, salvation lies in returning to the true faith). But see Leff, *Economic Analysis of Law: Some Realism About Nominalism*, 60 Va. L. Rev. 451 (1974) (making an analogy between Judge Posner's current economic analysis and the hero of an episodic novel, encountering and dissolving one by one the evil dragons of legal analysis).
9. This is a sense that cuts across various fields of law. See, e.g., L. Loss, *Fundamentals of Securities Regulation* 874-75 (2d ed. 1988). But see J. Calamari & J. Perillo, *The Law of Contracts* § 14-4 (3d ed. 1987) (examining different kinds of interests protected by damages, namely, a restitution interest, a reliance interest and an expectation interest, and stating that when the expectancy interest is unavailable, the aggrieved party may recover one or both of the restitution interest and reliance interest).
tractor that we did not previously know. In a way, I suppose, this is but a reflection of judicial pragmatism: one looks at the consequences of a rule — the "workability factor."  

Karl Llewellyn differentiated between "the happy idealists and the black-visaged cynics." The idealists conceive the law "as made up of rules . . . which are conceived to direct the course of action in society," whereas the latter believe that "a right is best measured by effects in life. Absence of remedy is absence of right. Defect of remedy is defect of right." Llewellyn goes on to conclude, preliminarily to be sure, that "[t]he differentiation between substantive law and adjective law is an illusion," while conceding that the presence of this illusion itself has results in human behavior.

To further look at collapsibility and apply a pragmatic test to illustrate my point, I have chosen copyright law. Viewing the law of copyright sporadically, I have been constantly impressed how case after case has seemed to be at the "cutting edge." L. Batlin & Sons, Inc. v. Snyder, is one such case: the Uncle Sam bank case, involving the question of whether a "modicum" of originality is necessary for copyright. Absent this requirement almost everything would be copyrightable. Another case was Financial Information, Inc. v. Moody's Investors Service, involving the copyrightability of compilations of data regarding municipal bonds — their date of issuance, interest rates, and so on. There are also the fascinating "conceptual separability" cases, Kieselstein-Cord v. Accessories by
Pearl\textsuperscript{22} and Brandir International \textit{v.} Cascade Pacific Lumber Co.,\textsuperscript{23} involving the question of whether useful articles, in the one case belt buckles and the other bicycle racks, can be so artistically or otherwise designed that the design is conceptually separable from the useful object — like the artist Christo’s running fence of draped material across a mountain canyon.\textsuperscript{24}

It seems that every case that comes before us in copyright law is a “hard” case. Is this because copyright law is so unformed, so unique, so statutorily affected that we get only “hard” cases? Or is it simply, as my colleague Judge Newman suggests, that copyright law seems to be, in and of itself, fascinating because it is concerned with creativity and the cases involve creative interests asserted by both sides to the dispute?\textsuperscript{25} In any event, he and I agree that copyright law generates hard issues “with uncommon frequency.”\textsuperscript{26}

Because copyright cases involving the doctrine of “fair use” have recently been in such public focus — two going to the Supreme Court and having received wide attention —\textsuperscript{27} that doctrine (and the remedies for unfair use) seems a likely starting place for this endeavor. Because each case involved a claim that copyright impairs free speech, or rather the public’s interest in receipt of information,\textsuperscript{28} there is an extra element of fascination involved. This element is one that has not gone unnoticed by the commentators.\textsuperscript{29} Professor Goldstein in a delightful article asserted:

\begin{itemize}
  \item \textsuperscript{22} 632 F.2d 989 (2d Cir. 1980).
  \item \textsuperscript{23} 834 F.2d 1142 (2d Cir. 1987).
  \item \textsuperscript{24} \textit{See} Glueck, \textit{Christo Drapes Miami Isles in Pink}, N.Y. Times, May 5, 1983, at C19, col. 1 (describing the 1972 work of Christo which suspended a fabric curtain between a pair of Colorado mountain peaks and a 24-mile nylon “running fence” in northern California); see \textit{also} Wilson, \textit{The World According to Christo}, L.A. Times, Sept. 29, 1985 (Calendar), at 90.
  \item \textsuperscript{26} Id. at 460.
  \item \textsuperscript{28} \textit{See} Virginia State Bd. of Pharmacy \textit{v.} Virginia Citizens Consumer Council, 425 U.S. 748, 763-65 (1976) (holding that consumers had a first amendment right to contest a statutory ban on the advertising of prescription drug prices).
  \item \textsuperscript{29} The late Melville Nimmer, whose copyright treatise is happily being carried on as a family venture, wrote extensively about the supposed collision between free speech and copyright. \textsc{Nimmer on Copyright} \textit{§} 1.10[B], [D] (1988). Indeed, his last major work, published just before his untimely death, was on freedom of speech; there he writes at length of the collision. \textsc{Nimmer on Freedom of Speech} \textit{§} 2.05[C] (1984); \textit{see also} W. Patry, \textit{The Fair Use Privilege in Copyright Law} 467 (1985) (arguing that copyright legislation “in the broader sense of expression . . . is [a] vehicle for the dissemination of . . . information” because it assures authors that others will be unable to copy their works (emphasis in original)).
\end{itemize}
The first amendment provides a model for the proper governance of copyright's statutory and enterprise monopolies. The model requires that first amendment objectives be promoted through accommodation of the public's interest in access to a diverse range of intellectual expression with maintenance of the property interest necessary to afford incentive to the creation and dissemination of expression.  

And there is also the Second Circuit's tantalizing and oft-quoted statement that "conflicts between interests protected by the first amendment and the copyright laws thus far have been resolved by application of the fair use doctrine." This sets the scene: "thus far" has a lack of finality — an unsettled state — that goes with what Gilmore has called the "Age of Anxiety" in which our jurisprudence is in today. Perhaps, as Gilmore concluded, "the beginning of wisdom [will] lie ... in [our] recognition that the body of the law, at any time or place, is an unstable mass in precarious equilibrium.

I. FAIR USE — AN EQUITABLE DOCTRINE?

Is fair use an equitable doctrine? Fair use as a concept may be said to have begun seventy-five years after the Statute of Anne, in Sayre v. Moore with Lord Mansfield's charge to the jury — reminiscent of our own copyright clause — in a case involving a sea chart incorporating (and, mercifully to seamen, correcting) the plaintiff's prior charts:

[W]e must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the pro-

32. G. GILMORE, supra note 7, at 68.
33. Id. at 110.
34. An Act for the Encouragement of Learning by vesting the Copies of printed Books in the Authors or Purchasers of such Copies during the Times therein mentioned. 8 Anne, ch. 19 (1710).
36. U.S. CONST. art. I, § 8. "The Congress shall have Power ...; To Promote the Progress of ... useful Arts, by securing for limited Times to Authors ... the exclusive Right to their respective Writings ... ." Id. at cl. 8.
We need not track the concept and its application in the differing contexts of abridgements, maps, legal reports, scholarly books, plays, movies, parodies, and the like. Suffice it to say that in Folsom v. Marsh, Justice Story — emulating Mansfield, perhaps — stated without using the term "fair use" the factors bearing on privilege or excuse for infringement: "the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work."

It is not without significance that Story, wearing another hat as treatise writer on equity jurisprudence, referred to these factors in his treatise. This reflected, perhaps, more the fact that to restrain publication of the alleged infringing work required the aid of a court of equity — here again the importance of the remedy — than it did any conceptualization of the doctrine as "equitable" rather than "legal."

I note that the first reference to the doctrine, which is now fully embodied in the modern statutory equivalent of the Statute of Anne, the 1976 Copyright Act, was apparently in Lawrence v. Dana. Justice Kaplan refers to Judge Clifford's foray in Lawrence as grounded in the thought that fair use was the "sort of taking which on such consideration [of Story's factors] would be held noninfringing." So too with Learned Hand's exposition in Nichols v. Univer-
fair use is simply the converse of infringement.\textsuperscript{47} While fair use may not be indispensable as a separate conceptual doctrine,\textsuperscript{48} it is one now given independent life by our governing statute and \textit{Sony}\textsuperscript{49} and \textit{Harper & Row}\textsuperscript{50} in dealing with the statute.

But to acknowledge its separate existence is not necessarily to say that — even after taking its four non-exclusive \textit{Harper & Row} factors\textsuperscript{51} into account — we have come to the end of any respectable inquiry. These factors\textsuperscript{52} are, of course, (1) the purpose and character of the use, what Judge Leval has called the "justification" for it;\textsuperscript{53} (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for the copyrighted work. But like Justice Kaplan, I would "recur to the point that 'fair use' invokes policy as does the rest of the subject of plagiarism, and in no markedly different sense."\textsuperscript{54} Thus, I do not have the fear that was expressed to me the other day by a distinguished copyright authority, now a federal judge, that "fair use" is subsuming all of copyright law. But now you may see what I meant at the beginning of this article about collapsibility of doctrine in law -- fair use collapses into plagiarism, but what is plagiarism? Both involve policy, but what is policy?

II. THE FAIR USE DOCTRINE AT PRESENT: ITS RELATION TO FIRST AMENDMENT CONCERNS?

Thus, I come to the critical question in determining what is fair use or plagiarism: does the public's right to receive information play any role? Notice that I do not use the phrase free speech or free

\textsuperscript{46} 455 F.2d 119, 121 (2d Cir. 1930), \textit{cert. denied}, 298 U.S. 669 (1936).
\textsuperscript{47} B. Kaplan, \textit{supra} note 37, at 67 n.93 (citing Gorman, \textit{Copyright Protection for the Collection and Representation of Facts}, 76 \textit{Harv. L. Rev.} 1569, 1602-05 & n.136 (1963)).
\textsuperscript{48} Id. at 67-68. This is a sanitized version of saying that there is no doctrine, there is simply a phrase that involves a congeries of policies applicable to different factual contexts. "Fair use," in copyright law, is a rough equivalent to "consideration" in contract law: it has its place, perhaps, but it is hardly an end of analysis. See G. Gilmore, \textit{supra} note 7, at 138 n.30. Thinking otherwise is wooden, cabining, stultifying as it were.
\textsuperscript{51} Id. at 560-61.
\textsuperscript{52} See 17 U.S.C. § 107 (enumerating the factors that determine fair use).
\textsuperscript{54} B. Kaplan, \textit{supra} note 37, at 69-70.
press. The language of our great first amendment,\(^5\) indeed much of the thinking and writing on it, focuses too narrowly on the speaker's right to speak or the press's right to print; on the person who is conveying information. But a whole congeries of cases in the last decade or so have reinforced the view stated by the Supreme Court in 1945, that the premise of the first amendment is that "the widest possible dissemination of information from diverse and antagonistic sources is essential to the welfare of the public."\(^6\) The commercial free speech cases and many others have made this public right to receive information of clear constitutional concern.\(^7\)

Is that public right to be taken into account in determining whether there has been fair use? Here, language from the Supreme Court's majority opinion in *Harper & Row* seems negative: "It is fundamentally at odds with the scheme of copyright to accord lesser rights in those works that are of greatest importance to the public. Such a notion ignores the major premise of copyright and injures author and public alike."\(^8\) *The Nation's* first amendment defense, said the Court, "would expand fair use to effectively destroy any expectation of copyright protection in the work of a public figure."\(^9\) A Second Circuit case, *Roy Export Co. Establishment v. Columbia Broadcasting System, Inc.*,\(^6\) in rejecting a news broadcaster's claim that it had a first amendment right to use portions of Charlie Chaplin's films in the broadcast coverage of Chaplin's death, said that "[n]o Circuit that has considered the question . . . has ever held that the first amendment provides a privilege in the copyright field distinct from the accommodation embodied in the 'fair use' doctrine."\(^1\) Patry has stated that because copyright protects the expression of an idea but not the idea itself, "the only possible conflict between the First Amendment and the Copyright Act lies in the author's expression, viz., his individual characterization, phrasing, or styling of ideas. No court has ever held that the public has a right to know

\(^5\) U.S. Const. amend. I. "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances." *Id.*


\(^9\) *Id.* at 557.

\(^6\) 672 F.2d 1095 (2d Cir.), *cert. denied*, 459 U.S. 826 (1982).

\(^1\) *Id.* at 1099.
expression." But counterbalancing these views are those in Justice Blackmun’s opinion for the four dissenters in Sony, which were not, I might say, disputed by the Sony majority:

The monopoly created by copyright . . . rewards the individual author in order to benefit the public . . . .

There are situations, nevertheless, in which strict enforcement of this monopoly would inhibit the very ‘Progress of Science and useful Arts’ that copyright is intended to promote. An obvious example is the researcher or scholar whose own work depends on the ability to refer to and to quote the work of prior scholars. Obviously, no author could create a new work if he were first required to repeat the research of every author who had gone before him. The scholar, like the ordinary user, of course could be left to bargain with each copyright owner for permission to quote from or refer to prior works. But there is a crucial difference between the scholar and the ordinary user. When the ordinary user decides that the owner’s price is too high, and forgoes use of the work, only the individual is the loser. When the scholar forgoes the use of a prior work, not only does his own work suffer, but the public is deprived of his contribution to knowledge. The scholar’s work, in other words, produces external benefits from which everyone profits.  

Justice Blackmun — remember the minority for which he was speaking held that VCRs were not a fair use — went on to reflect that each of the fair uses to be protected under the legislative history of the 1976 Act “is a productive use, resulting in some added benefit to the public beyond that produced by the first author’s work.” And of course first amendment lawyers and commentators take the strong position: “First Amendment values should not be considered as an alien intruder into copyright law but as a basis for making that law still more responsive to the shared values of our nation.”  

Thus, I will assume for further purposes here, without necessarily agreeing with the proposition, that the fair use doctrine and a

62. W. Patry, supra note 29, at 466.  
64. Id. at 478.  
first amendment "privilege" are mutually incompatible. But I underscore the word "privilege," which I define as a defense. The claim of a first amendment right, including the public's right to knowledge, I will concede for purposes of discussion, is not a defense to an action for copyright infringement.

I submit, however, that having thus defined the substantive right we have not even begun to discuss the correlative remedy. What is the infringed author's remedy? More specifically, does it include an injunction against publication by this infringer? More specifically still, may the considerations mentioned by Justice Blackmun in *Sony* — the "contribution to knowledge" of the public, if you will — be taken into account at the remedial stage? This is a question as yet unanswered, at least by the Supreme Court. My suggested answers follow.

### III. INJUNCTIONS

The answer to the question, what is the infringed author's remedy (as it usually is in law) is that it depends on the circumstances. Let us take the easy cases — the case of piracy or what is called in the garment industry the "knock-off" case — where an opportunistic competitor (another author/publisher) seeks to profit from the words written, the song composed, the film produced by the original author, composer or producer, as the case may be. A pirated or copied edition, record, movie, song or other work needs more than the protection of a suit for damages; it cries out for an injunction. This is true because the "qualified monopoly running for a limited time" (what we call copyright protection) is necessary to prevent freeloaders from stifling the incentive to create and promote the "Progress" of the "useful Arts." 68

Thus, the easy cases readily lead to the grant of an injunction. In the first place, they suggest that "[i]nreparable harm may ordinarily be presumed from copyright infringement." 69 Secondly, damages for infringement may be difficult to assess. 70

67. B. Kaplan, supra note 37, at 75.
68. See supra note 36.
69. Hasbro Bradley, Inc. v. Sparkle Toys, Inc., 780 F.2d 189, 192 (2d Cir. 1985); see Wainwright Sec., Inc. v. Wall Street Transcript Corp., 558 F.2d 91, 94 (2d Cir. 1977) (finding that irreparable harm can be presumed by a showing that reproduction of a work will "materially reduce the demand for [the plaintiff's] services.")
70. See Dynamic Solutions, Inc. v. Planning & Control, Inc., 646 F. Supp. 1329, 1337 (S.D.N.Y. 1986) (finding that it is impossible to estimate the damage that results from the
But as we pass from the easy case toward the harder cases — where the infringer may have been "innocent" in the sense of not knowing or having ground to suspect of the plagiarism of another, the appropriate remedy becomes more difficult to fashion. A good example is where the alleged infringer's purpose is to parody (which by definition is mimicry of an author's characteristic style) with the aim of ridicule, spoof, or just plain humor.

Does copyright infringement per se mean that the equitable considerations ordinarily involved in the issuance of injunctions are to be cast to the winds? An infringed plaintiff may be estopped from obtaining his equitable, or, for that matter, any other remedy. He may have been guilty of laches to the prejudice of the infringer. In such cases the copyright holder may be denied an injunction, even if not damages.

Or the person claiming infringement may come into court with "unclean hands," as two members of the panel held Howard Hughes had done when he sought to suppress an unauthorized biography. After learning that Random House was thinking of publish-
ing an unauthorized biography, Hughes granted one of his Nevada enterprises, Rosemont Enterprises, an exclusive contract to publish his authorized biography and Rosemont purchased the copyrights to some earlier Look magazine articles about Hughes.\textsuperscript{78} When Random House did publish, Rosemont sued to enjoin, claiming copying of the Look articles.\textsuperscript{79} Judges Lumbard and Hays thought the old equitable doctrine of unclean hands should prevent the issuance of an injunction.\textsuperscript{80} Unless I am mistaken, that is still the law of the Second Circuit, even if they also concurred in Judge Moore's broader opinion resting on "the public interest in the free dissemination of information,"\textsuperscript{81} to which I will allude below.\textsuperscript{82}

And the doctrine of \textit{de minimis non curat lex} is still at work: "insignificant" infringements may permit wise exercise of discretion by denying issuance of an injunction.\textsuperscript{83} Thus, in short, the issuance of an injunctive remedy in copyright cases is subject to the same informed discretion of the court that it is in other areas of law. Justice Kaplan pointed this out forcibly some years before passage of the 1976 Act by stating that "courts have sometimes forgotten that an injunction does not go of course; the interest in dissemination of a work may justify a confinement of the remedy to a money recovery."\textsuperscript{84}

The 1976 Act left the grant of an injunction permissive by use of the word "may."\textsuperscript{85} This was done advisedly,\textsuperscript{86} prompting the lead-
ing commentators to agree.\textsuperscript{87} The Supreme Court, in \textit{Harper \\ & Row}, recognized that “rigid application of the copyright statute . . . on occasion . . . would stifle the very creativity which that law is designed to foster.”\textsuperscript{88} And while the Second Circuit's \textit{Salinger v. Random House, Inc.},\textsuperscript{89} did say that “[i]f [an author] copies more than minimal amounts of . . . expressive content, he deserves to be enjoined,”\textsuperscript{90} notice how that sentence is phrased.\textsuperscript{91} Besides referring to expressive content, the pejorative, “deserves to be,” suggests a wrongfulness that goes beyond the ordinary. It does so also in a case that arguably involves underlying or tacit considerations of privacy that raise a whole other set of problems.\textsuperscript{92}

The ultimate question remains: is the public interest in the dissemination of knowledge to be taken into account at all in determining whether an injunction should issue? The question is open, unanswered at least by the Supreme Court. This I believe remains true despite the language of the majority opinion in \textit{Harper \\ & Row} that “[i]t is fundamentally at odds with the scheme of copyright to accord lesser rights in those works that are of greatest importance to

(b) Any such injunction may be served anywhere in the United States on the person enjoined; it shall be operative throughout the United States and shall be enforceable, by proceedings in contempt or otherwise, by any United States court having jurisdiction of that person. The clerk of the court granting the injunction shall, when requested by any other court in which enforcement of the injunction is sought, transmit promptly to the other court a certified copy of all the papers in the case on file in such clerk's office.

\textit{Id.}


\textsuperscript{87} See, e.g., 3 \textsc{Nimmer on Copyright}, \textit{supra} note 29, \S 14.06[B] at 14-56.2 & 17.28.


\textsuperscript{89} 811 F.2d 90 (2d Cir.); \textit{cert. denied}, 484 U.S. 890 (1987).

\textsuperscript{90} \textit{Id.} at 96.

\textsuperscript{91} “Expressive content” is not the same as language, fact, or idea; rather it is related to “expression.” This sentence leaves open the situation referred to by Judge Leval; “it may be ‘the words used by [a] public figure (or the particular manner of expression) that are the facts calling for comment.’” \textsc{New Era Publications Int'l v.Henry Holt and Co., Inc.,} 873 F.2d 576, 592 (1989) (quoting \textsc{New Era Publications Int'l v. Henry Holt and Co., Inc.}, 695 F. Supp. 1493, 1502 (S.D.N.Y. 1988)).

\textsuperscript{92} Compare \textsc{Note, \textbf{Fair Use of Unpublished Materials in the Second Circuit: The Letters of the Law}}, 54 \textbf{BROOKLYN L. REV.} 417, 457-60 (1988) (arguing that the unacknowledged motive of the court in \textsc{Salinger} (to protect his privacy interests) is disturbing because this is not the aim of copyright law) with \textsc{Newman, Copyright Law and the Protection of Privacy, 12 COLUM. J.L. \\ & ARTS} 459, 479 (1988) (asserting that privacy interests should play an important role in copyright law in order to promote and protect the creative process).
the public. Such a notion ignores the major premise of copyright and injures author and public alike.\textsuperscript{93}

I say this because we are talking about the remedy for a conceded infringement. An injunction is, as the Supreme Court recently reminded us in \textit{Weinberger v. Romero-Barcelo},\textsuperscript{94} a drastic remedy. In determining whether to grant an injunction in every field other than copyright, the "public interest" is a factor to be taken into account. The Supreme Court has said: "Courts of Equity may, and frequently do, go much further both to give and withhold relief in furtherance of the public interest than they are accustomed to go when only private interests are involved."\textsuperscript{95}

Injunctive relief should remain a matter of informed discretion in the law of copyright infringement as it does in the law of nuisance, riparian rights, trespass, or other torts.\textsuperscript{96} If we take really hard cases in copyright involving histories or biographies (which are after all personal histories), as stated by my late colleague Judge Moore, "it is both reasonable and customary for [historians or] biographers to refer to and utilize earlier works dealing with the subject of the work and occasionally to quote directly from such works."\textsuperscript{97}

There is, Judge Moore went on to say — and I agree — a "public benefit in encouraging the development of historical and biographical works and their public distribution."\textsuperscript{98} Professor Chaffee said in 1945: "The world goes ahead because each of us builds on the work of our predecessors. 'A dwarf standing on the shoulders of a giant can see farther than the giant himself.'"\textsuperscript{99}

What is the alternative, particularly in an era when, as the \textit{Harper & Row} and \textit{Salinger} cases have forcibly reminded us, unpublished expressions have copyright protection? If injunctions issue woodenly, as a matter of course, only authorized biographies will occur; these will be sanitized — free from allusion to expressive comments of the biographer, be she alive or deceased — just as

\begin{thebibliography}{99}
\bibitem{94} 456 U.S. 305, 311-12 (1982).
\bibitem{96} See New Era Publications Int'l v. Henry Holt, Co., 873 F.2d 576, 596 (2d Cir. 1989); Abend v. MCA, Inc., 863 F.2d 1465, 1478 (9th Cir. 1988).
\bibitem{97} Rosemont Enters., Inc. v. Random House, Inc., 366 F.2d 303, 307 (2d Cir. 1966).
\bibitem{98} Id.
\end{thebibliography}
Howard Hughes wanted his surroundings and his biography,\textsuperscript{100} or apparently as Frank Sinatra wanted his. Only expletive-deleted histories would be published; after all, President Nixon's taped comments to his White House associates were unpublished, although forcibly expressed comments on history in the making. What of interviews with public figures? Is it too farfetched to suggest that these too will, on the threat of a copyright injunction, be able to be controlled, sanitized or "authorized"?

In the end I come down with Professor Goldstein and Justice Kaplan. I come down with the former's view that "[c]opyright doctrine should . . . conform to the general constitutional rule which restricts use of the injunctive remedy against conduct which is consonant with first amendment rights,"\textsuperscript{101} once again with the qualification that those rights encompass the public's right to receive information or knowledge.

And I come down with Justice Kaplan's prescient observation in 1967 that "when copyright has gone wrong in recent times, it has been by taking itself too seriously, by foolish assumptions about the amount and originality open to man as an artificer, by sanctimonious pretensions about the inequities of imitation."\textsuperscript{102}

Justice Kaplan went on to say, and I agree, "I confess myself to be more worried about excessive than insufficient protection."\textsuperscript{103} Finally, I agree with Chateaubriand: "[t]he original writer is not one who imitates nobody, but one whom nobody can imitate."\textsuperscript{104}

**ADDENDUM TO KAPLAN LECTURE**

When the Kaplan Lecture was conceived and during its preparation, *New Era Publications International v. Henry Holt & Co.*\textsuperscript{105} came before the court and the author had hopes that some of the thoughts expressed in the lecture might be incorporated in the opinion.\textsuperscript{106} The panel opinion, however, did not accept the position taken above.\textsuperscript{107} Even while upholding the denial of an injunction on the

\textsuperscript{100} Rosemont, 366 F.2d at 306.
\textsuperscript{101} Goldstein, supra note 30, at 1033.
\textsuperscript{102} B. KAPLAN, supra note 37, at 78.
\textsuperscript{103} Id.
\textsuperscript{104} J. BARTLETT, FAMILIAR QUOTATIONS 419 (15th ed. 1980).
\textsuperscript{105} 873 F.2d 576 (2d Cir. 1989).
\textsuperscript{106} Indeed, I would be less than candid if I did not say that some of the work on the *New Era* case helped sharpen some of the thoughts above expressed.
\textsuperscript{107} See supra notes 95-104 (arguing that the public interest in the dissemination of knowledge is a consideration in determining whether an injunction should issue in copyright
basis of an equitable doctrine, the doctrine of laches, the panel majority, consisting of Judges Miner and Altimari, seemed to the undersigned to go out of its way to repudiate Judge Leval's opinion. Whether one regards the panel majority's comments as dictum, this issue was joined by a petition for rehearing en banc. A petition for rehearing en banc was denied, there being no majority in favor thereof.

Both the opinion concurring in denial of rehearing en banc and the opinion dissenting from it are interesting for what they do and do not do. Judge Miner's concurring opinion again quotes Harper & Row in saying that "[t]he right of first publication encompasses not only the choice whether to publish at all, but also the choices of when, where, and in what form first to publish a work," and maintains that "[t]he case at bar did not present one of those rare situations where fair use might be found." It went on to say that "[o]nly with respect to the fourth [fair use] factor, effect upon the potential market, [17 U.S.C.] § 107(4), did the panel majority disagree with the district judge."

More importantly, Judge Miner's opinion agrees with Judge Newman's that the Second Circuit is not committed to the proposition that the copying of some small amounts of unpublished expression to report facts accurately and fairly can never be fair use. The majority, however, would not have hinged the outcome on the distinction between "factual reportage" and text enlivening. Interest-

108. New Era, 873 F.2d at 580-84.
109. Id. at 585 (Oakes, C.J., concurring).
110. New Era Publications Int'l v. Henry Holt, Co., 884 F.2d 659 (2d Cir. 1989). Another issue, equally important to copyright law perhaps, but having no bearing on the main point made in this Article, was also joined. That other issue was whether expression may be copied to report facts accurately. For an important discussion of that point, see id. at 662-63 (Newman, J., joined by Oakes, C.J. and JJ. Kearse and Winter, dissenting).
111. Judge Miner concurred in the denial in a separate opinion in which Judges Meskill, Pierce, and Altimari joined. Judge Newman dissented from the denial in a separate opinion in which the author with Judges Kearse and Winter joined. Judges Feinberg, Cardamone, Pratt, and Mahoney declined to join either opinion, although, of course, the denial of rehearing en banc does not tell us how any one of them would have voted; all it tells us is that joining the four who dissented, there could have been no more than two of them and possibly either one or none. Only the court itself knows, and our rules do not call for or permit disclosure of the underlying vote. See Fed. R. App. P. 35(a)(b).
113. Id.
114. Id.
ingly, it cites, as does the dissenting opinion, to Consumers Union of United States, Inc. v. General Signal Corp. The majority then goes on to say that Consumers Union was wrongly decided according to Harper & Row because “fair use is never to be liberally applied to unpublished copyrighted material.” This does not provide much reassurance to biographers and journalists despite the dissenting opinion’s comment that “we do not believe that biographers and journalists need be apprehensive that this Circuit has ruled against their right to report facts contained in unpublished writings, even if some brief quotation of expressive content is necessary to report those facts accurately.” Obviously some line-drawing needs to be done, and whether it will be the “brief quotation of expressive content . . . necessary to report . . . facts accurately” of the dissent, or overly liberal application of the fair use doctrine within the concurring opinion is a question for resolution from any given panel which may include one or more of the four who did not express themselves on this issue.

There is also something significant in the opinions with reference to the denial of rehearing en banc. The concurring opinion, in its own words, no longer “precisely tracks the infelicitous language of Salinger: An infringer who ‘copies more than minimal amounts of (unpublished) expressive content . . . deserves to be enjoined.’” Indeed, the concurring opinion says that “[a]ll now agree that injunction is not the automatic consequence of infringement and that equitable considerations always are germane to the determination of whether an injunction is appropriate.” This is reinforced by a quotation of the statute authorizing injunctions, adding emphasis to the statutory word “may.” The concurring opinion then goes on to say that:

The panel majority maintains its view that an injunction would have been a proper remedy in this case except for the controlling

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116. New Era, 884 F.2d at 661.
117. Id. at 663.
118. Id.
119. See id. at 661.
120. Id. (quoting Salinger v. Random House, Inc., 811 F.2d 90, 97 (2d Cir.), cert. denied, 484 U.S. 890 (1987)).
121. Id.
issue of laches, but has proposed to amend its opinion at 873 F.2d 576, 584... to read as follows: "Since [under ordinary circumstances] the copying of 'more than minimal amounts' of unpublished expressive material calls for an injunction barring the unauthorized use, id. at 96, the consequence of the district court's findings seem obvious."123

So now, at least, an injunction is called for only "under ordinary circumstances," and not in every case. Will this be solace to the historians and biographers and journalists who have been concerned about New Era and have written at length in the pages of the New York Law Journal and elsewhere about this case and Salinger?124

I do not know the answer to the question I have just posed, but surely there will be some solace in the dissenting opinion, especially because it was written by Judge Newman who not only has contributed so much penetrating analysis to the law of copyright, but also was the author of the opinion in Salinger. His dissenting opinion, in a footnote, clarifies the sentence in Salinger which states that "[i]f [the biographer] copies more than minimal amounts of (unpublished) expression, he deserves to be enjoined,"125 the sentence which Judge Miner's concurring opinion referred to as "infelicitous."126 Judge Newman clarifies the sentence from Salinger as being

cconcerned with the issue of infringement, not the choice of remedy. Indeed, there was no dispute as to remedy in that case at all once infringement was found, since the infringing work had not been published and the injunction sought and issued in that case required only some deletions from galley proofs. It would have been preferable to have said in Salinger "... he deserves to be found liable for infringement."127

This is a real plus for the publishing business and the writing profes-

126. Id. at 661.
127. Id. at 663 n.1.
sion. It can now be said that Salinger's language — whether or not "infelicitous" — had to do with substance, i.e., whether there was infringement, not remedy and whether that infringement should be enjoined. This is not just because Judge Newman, the author of Salinger, authored the dissenting opinion of New Era which qualified the Salinger language in a footnote. It is because this qualification was made in the en banc context, where three judges, agreeing with Judge Newman's opinion, and four judges concurring in the denial of rehearing en banc supported the qualification and the change of the panel majority opinion to use the additional phrase "under ordinary circumstances." Henceforth, I have little doubt that the offending sentence in Salinger will be treated as going to substance, not remedy, and, consequently, Second Circuit law will be that only under "ordinary" circumstances will an injunction issue. Under extraordinary circumstances it will not.

What are extraordinary circumstances? That remains for future litigation to elucidate. The bigger question is whether first amendment concerns may be taken into account in determining whether an injunction will issue. The question is whether the public interest in the dissemination of knowledge is taken into account at all in determining whether an injunction should issue. The question is clearly open and unanswered by the Supreme Court, as it was before our en banc ratiocinations in New Era and for the reasons stated above. Does it remain open in the Second Circuit? Once again, as stated in New Era, but for the "observation that the fair use doctrine encompasses all claims of First Amendment in the copyright field," that observation "never has been repudiated." Not to quibble, but Roy Export did not make the observation in the language of the panel majority in New Era, a point that escaped the attention of the opinions in reference to the grant or denial of en banc rehearing. What Roy Export said was that "[n]o circuit that has considered the ques-

129. See supra text and accompanying note 123.
130. See supra notes 107-28 and accompanying text.
132. Id.
134. While it surely would have been considered had there been a vote to rehear en banc, since an affirmative vote did not take place, the question of the language in Roy Export was not one up for discussion.
... has ever held that the First Amendment provides a privilege in the copyright field distinct from the accommodation embodied in the 'fair use' doctrine.\textsuperscript{135} This is quite different, I suggest, from saying that the fair use doctrine "encompasses all claims of First Amendment in the copyright field."\textsuperscript{136} But even if it were the same, it goes to the substance of the law of fair use, not to the remedy, as to which only under ordinary circumstances (more than minimal copying of unpublished expressive material) is there a call for an injunction. Where the public's right to receive knowledge is at issue, is that not an extraordinary circumstance? I continue to believe that in the issuance of injunctions, all the equities may be taken into account, one of them involving the public's right to knowledge.

Until the invention of movable type in the mid-Fifteenth Century, plagiarism was necessary for books to be read and well into the Seventeenth Century "originality carried no cachet," Shakespeare taking plots and characters from wherever he pleased without acknowledging sources or permitting anyone to print his works without royalties.\textsuperscript{137} It is only in the Eighteenth Century that "as the idea of the original author took shape, so did its shadow, plagiarism."\textsuperscript{138} But it must be remembered that we are not talking here about plagiarism or piracy, a fundamental distinction that must be kept in mind. Rather, we are talking about the work of historians, biographers and journalists. Professor Schlesinger believes that, "when responsible scholars gain legitimate access to unpublished materials, copyright should not be permitted to deny them use of quotations that help to establish historical points."\textsuperscript{139} I agree in a large sense. What we should be concerned with is the kind of writing and the quality of use that should enter into the choice of a remedy. The finest of fine tuning is essential, something I think Judge Leval in \textit{New Era} attempted to engage in.\textsuperscript{140} What is not necessary, is a wooden-like approach that threatens to enjoin every work that quotes from an unpublished writing of a biography, history-maker or public person in the news.

\textsuperscript{135} \textit{Roy Export}, 672 F.2d at 1099.
\textsuperscript{136} \textit{New Era}, 873 F.2d at 584.
\textsuperscript{138} Id. at 14.
\textsuperscript{139} Schlesinger, \textit{supra} note 124, at A16, col. 4.
Sensitivity to the public interest has always been taken into account in the granting or denial of injunctions. Why that should be true of all but the copyright portion of the law of intellectual property dealing with unpublished material is a question to which I cannot fathom an answer. Why is anyone so afraid of the first amendment as to think that it should not play a role? After all, the Supreme Court has held that the first amendment bars recovery "for the tort of intentional infliction of emotional distress by reason of [publication of satire] without showing in addition that the publication contains a false statement of fact which was made with 'actual malice.'" 141 Copyright law has long recognized "the broad scope permitted parody in First Amendment law." 142 We long ago stated the general proposition that "parody and satire are deserving of substantial freedom — both as entertainment and as a form of social and literary criticism." 143 Indeed, recently, the Second Circuit held that parody and satire were protected against a Lanham Act challenge, in the trademark or unfair competition segment of intellectual property law. 144

The question may be asked, are not legitimate historical, biographical and journalistic works to be given at least an equal place in the law of intellectual property with the satirical and parodistic? One would hope that the ultimate answer would be affirmative, whatever confusion has been cast by the now ever so slightly but importantly qualified Salinger and New Era decisions. In order to accommodate the universal interests served by the law of intellectual property, as well as to do justice or equity in the individual case, we must for a while, until better advised, look to the remedy rather than merely to the substantive rule of law, or at least to the relationship between the two, to see that the law continues to grow commensurate with the times rather than recedes into the past.
