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Article

BEYOND FAIR USE: EXPANDING COPYRIGHT MISUSE TO PROTECT DIGITAL FREE SPEECH

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***84 Introduction**

In *Reno v. ACLU*, Supreme Court Justice John Paul Stevens famously heralded the unprecedented “vast democratic forums of the Internet,”¹ where “any person . . . can become a town crier with a voice that resonates farther than it could from any soapbox.”² The same technologies that allow realization of a free speech advocate’s fondest dream, however, can herald a copyright holder’s worst nightmare. The ability to quickly create and disseminate high-quality digital copies of expression on the Internet has raised cries of alarm by rights holders. In response, Congress has crafted powerful new legal tools to combat online infringement in the 1998 Digital Millennium Copyright Act (DMCA).³ Unfortunately, these tools, as well as the more traditional ones available to copyright owners, have been used online not only to combat piracy, but also to stifle criticism, thus chilling the important emerging democratic forums celebrated by Stevens.

Already, a number of cases have arisen involving corporate, religious, and other organizations that claim copyright in leaked or intercepted internal documents to avoid their public disclosure online.⁴ For example, in late 2003, in an attempt to curb growing criticism of electronic voting security, software vendor Diebold used copyright law to try to prevent web publication of thousands of internal e-mails, leaked or intercepted from the company, which detailed security lapses and failure to comply with state certification procedures.⁵ Cases like this are likely to increase in incidence in the future. They present an even greater challenge to copyright law than the much-maligned online file sharing infringement lawsuits⁶ because they involve efforts to vindicate privacy or economic interests that are not vested in the marketability of the copied works themselves and thus fall outside the traditional utilitarian structure of United States copyright law.

***85** These cases clearly also raise important First Amendment issues, as copyright is wielded as a sword rather than as a shield, to silence speakers who are engaged in criticism rather than in economic piracy, and against whom the owner often could not sustain an unlawful interception, misappropriation of trade secrets, or invasion of privacy claim. Criticism and critical dissemination of information, rather than more traditional, commercially motivated copyright infringement and unlawful acts of acquisition, are targeted.

Courts have been relatively hostile to outright balancing of free speech arguments against copyright claims, citing a trumping “copyright exception” to the First Amendment grounded both in the history of the two constitutional provisions and in the important utilitarian incentive copyright provides for free expression.⁸ Although the Supreme Court has hinted that a reexamination of the copyright exception eventually may be necessary, it thus far has been tempered only by existing judicially crafted doctrines that limit copyright, the most important of which has been fair use.⁹ So far, however, for reasons that I explore below, fair use has proved inadequate to protect the critical First Amendment interests at stake. In this piece, I propose that another equitable limiting doctrine, misuse--recently introduced from patent into copyright law--be expanded as a device to protect speech.

This piece is organized as follows: Part I presents the growing conflict between free speech and copyright protection. I begin by examining the traditional rationale for copyright law. I then turn to the impact of new digital technologies on free speech and on copyright and explain why these technologies are putting pressure on the supposed copyright exception to the First Amendment. In Part II, I explore a class of recent cyberlaw cases where the tensions between copyright and free speech have been revealed to be particularly acute, namely those where the public forums of the Internet are used to disseminate portions of unpublished works for the purpose of non-commercial criticism or disclosure. I explain why existing free speech safeguards embodied in the two major copyright-limiting doctrines, the idea or fact/expression dichotomy and fair use, so far have proved inadequate to protect the free speech interests at stake in these cases. Part III examines the possible application of another, more novel limiting doctrine, misuse, introduced from patent to copyright law, to this problem. I argue that misuse's equitable roots and emphasis on safeguarding the public policy rationale of intellectual property law make it particularly appropriate for policing the boundaries of copyright law. While I acknowledge and address three possible criticisms of the misuse doctrine I argue, in conclusion, that misuse offers an important new tool to protect digital speech.

***86 I. The Growing Conflict Between Copyright and Free Speech**

As a result of the growth of cheap and effective reprography and distribution technologies, particularly the Internet, “the information infrastructure has run headlong into intellectual property law.”¹⁰ Because the same information infrastructure allows for important exercises of First Amendment rights, an increasing number of cases in the online context have pitted copyright against free speech interests.¹¹

A. The Logic of Copyright

The United States Constitution authorizes Congress to grant authors a monopoly over their expression “for limited Times” in order to “promote the Progress of Science and useful Arts.”¹² By contrast to the copyright regimes of many European nations, American law does not extend copyright protection as a moral right, that is, on the ground that a work of authorship is an extension of its author's personality.¹³ Copyright law instead is a “utilitarian response to a public goods problem,” namely, that it is cheaper to copy expression than to create it.¹⁴ “By establishing a marketable right to the use of one's expression,” that is, by allowing the author to exclude unauthorized copiers, “copyright supplies the economic incentive to create and disseminate ideas.”¹⁵

While the quid pro quo embedded in copyright law is distinct from that in patent law,¹⁶ both assume a “bargain” between the author (or inventor) and the public. *87 “The economic philosophy” of patent and copyright law alike, “is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors.”¹⁷ Public welfare here is presumed to be advanced by broad dissemination of works. In patent law, public disclosure of an invention--via the patent application process--is a prerequisite to protection.¹⁸ In the modern copyright regime, publication is no longer a condition of protection, but according to the Supreme Court, remains its “desired objective.”¹⁹

In order to protect the very public interests that animate copyright law in the first place, protection is limited in scope: the “creative activity of authors and inventors,”²⁰ not simply “every commercially valuable activity,”²¹ is copyrightable. Although neither the U.S. Copyright Office nor the courts will assess the creative merits of a work, “sweat of the brow” alone without some element of originality is insufficient to earn copyright.²² According to the Supreme Court, appropriation by others of uncopyrighted or uncopyrightable work “is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.”²³ American copyright law thus does not protect against plagiarism per se,²⁴ nor does it guarantee an author the moral rights enshrined in the Berne Convention, namely “the right to claim authorship of the work and to object to any distortion, mutilation *88 or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.”²⁵

The monopoly power of copyright is further restrained by judicially crafted limiting doctrines. The first major limiting doctrine, the idea/expression dichotomy, which at times resembles a judicial test of copyrightability, holds that copyright in expressive matter does not protect underlying ideas or facts contained in a copyrighted work of authorship.²⁶ When the underlying ideas or facts “merge” with the expression, that is, where there is only one or a very limited number of expression(s) available, even the expressive matter will be denied protection.²⁷ While the idea/expression dichotomy offers a sort of threshold for copyright protection, it is invoked only as a defense against a finding of infringement rather than as a

freestanding claim of invalidity.²⁸

A second limiting doctrine, fair use, offers an affirmative defense to copyright infringement where “rigid application of the copyright statute . . . would stifle the very creativity which that law is designed to foster,”²⁹ or where an author’s consent to “reasonable and customary” uses of copyrighted work may be implied.³⁰ In the first instance, the Supreme Court recently has focused on whether the claimed fair use is “transformative,” that is, whether it “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.”³¹ With regard to the question of “reasonable and customary” uses, scholars have developed a “market failure” rationale for fair use, arguing that fair use is permissible where the transactional costs associated with securing a license to use a work are prohibitive.³² Examples include home users who “time shift” by taping *89 their favorite television programs using a video cassette recorder or a university researcher who photocopies an academic article.³³

Originally a judge-crafted equitable doctrine, fair use was codified by Congress in the 1976 Copyright Act, which enumerates a four-factor test looking to: (1) the purpose and character of the use; (2) the character of the copied work; (3) the amount and substantiality of the part of the work used in relation to the work as a whole; and (4) the effect of the use on the market(s) for the work or on its value.³⁴ These factors were intended by Congress to be “illustrative and not limitative.”³⁵ Nonetheless, courts have been reluctant to introduce new factors; instead, they have resized the four existing ones in Procrustean fashion to fit the facts of individual cases. The four factors “are to be explored, and the results weighed together, in light of the purposes of copyright.”³⁶

B. The Difference Technology Makes.

Through the Internet, it has become “easy and cheap to reach a worldwide audience,”³⁷ for expressive or informational purposes, or some combination of the two. Small speakers, once barred from mainstream media by lack of money or influence or because their message was unpopular, now have a global forum where a multitude of viewpoints can be heard coming from vastly different voices.³⁸ Moreover, the Internet has broadened not only who may speak but also how they may speak. Unlike traditional print or broadcast media, Internet interactivity and connectivity allow for rapid back-and-forth exchange. Features such as frames, hypertext linking, message boards, and comment boxes facilitate and structurally mimic dialogue. These and other technologies also allow for a conversation between texts, images, and sounds as well as between people. Because page space, broadcast time, and other constraints of traditional media do not apply,³⁹ speakers can “show not tell,” adding new layers to speech through intertextuality. For example, an entertainment reviewer might punctuate her review with sound or video clips; a political critic might thread his commentary about a recent Supreme Court decision with *90 lengthy excerpts; or a journalist might make available a full-text copy of an important government report. Indeed, in many cases, the simple act of indexing or otherwise making content available online, sometimes with little or no accompanying text, can be understood as a statement by the compiler—take, for example, the ubiquitous “links” section on most websites or some web logs, which catalogue stories of interest with little additional comment. Combining the Internet’s roles as opinion forum and informational hub, access to common content fosters new forms of conversation and persuasion.

A problem arises, however, when the content an online speaker wishes to comment on is protected by copyright. The speaker can choose not to use the copyrighted content, to seek permission from its author, or to use it without the author’s permission, gambling that the unauthorized use will qualify as a fair use should she be sued for copyright infringement. The more critical or controversial the comment, the more important the speaker may feel it is that her audience can actually view the content for themselves. Yet this circumstance may be one in which the work’s author is unlikely to grant permission. The speaker also may feel that providing the content to her audience is particularly necessary when it is not otherwise generally available to the public. Again, however, the author may decline permission for precisely this reason. In fact, the author may be unwilling to authorize use under any circumstances. In the offline context, the speaker might have the option of simply sharing with others her copy of the copyrighted work without infringing copyright. In order to reach the much larger audience online, however, the speaker likely will have to violate the author’s reproduction right by creating a digital copy. Further, through the normal operations of the Internet, additional copies of the copyrighted content will be made as the website is hosted and viewed. Indeed, some courts have held that even viewing a copyright-protected web document in an Internet browser window constitutes infringement of the owner’s reproduction right because in the process a copy is stored in the user’s Random Access Memory (RAM).⁴⁰

To be fair, the same technologies that allow the speaker to bypass mainstream media outlets to reach an audience of millions online enable large scale unauthorized copying intended to steal from rather than to criticize the author of copyrighted

content. Prior to the Internet, a counterfeiter “needed the same sort of production and distribution facilities that the copyright owner did.”⁴¹ Although many end users made a few unauthorized copies for personal use or for family or friends, these did not significantly threaten the copyright owner’s market.⁴² Today, anyone with a *91 networked computer and a scanner or burner drive can quickly reproduce and freely distribute high quality digital copies online that are reasonable substitutes for lawful copies.

As a consequence, copyright owners have asked for and received new legal procedures designed to facilitate online copyright enforcement. In 1998, Congress enacted the Digital Millennium Copyright Act (DMCA).⁴³ Section 512(c) of the DMCA creates a “notice-and-take-down” procedure whereby Internet service providers (ISPs) are immunized from secondary liability for copyright infringement, if upon proper notice by the copyright owner that infringing materials are being hosted, they immediately take down or block access to them.⁴⁴ Under section 512(g), the subscriber, whom the ISP must inform of any removal or disabling actions taken pursuant to section 512(c), may issue counter notice stating that the copyright owner misidentified or was mistaken about the allegedly infringing materials.⁴⁵ Unless the copyright owner files for a court order against the subscriber, the ISP must replace or enable access to the materials within ten to fourteen days of receiving counter notification.⁴⁶ Increasingly, copyright owners are using section 512 and other legal procedures to target individual end users instead of large scale counterfeiters or intermediaries.⁴⁷

It is all fine and good, we might think, for copyright owners to attack piracy intended to cut into the market for their copyrighted work. But what if the targeted material serves an important First Amendment speech purpose? And what if the copyright holder seeks not to protect the copyrighted work as an economic asset but instead to suppress unflattering information or to silence criticism? Surely, there must be ways of distinguishing free speech use from mere piracy. At the very least, given both the risks of online piracy and the critical importance of the Internet as a democratic speech forum, shouldn’t some balancing of the copyright owner’s intellectual property rights against the speaker’s First Amendment rights take place? This question is arising with increasing frequency.⁴⁸

*92 But traditionally, courts have been reluctant to engage in such balancing at all, citing a copyright exception to the First Amendment grounded in the notion that copyright law’s contribution to the marketplace of ideas outweighs the detriment of its constraint on unfettered speech.⁴⁹ This so-called “copyright exception” provides rights owners with powerful forms of injunctive relief against critical speech, including the informal notice-and-take-down procedure of the DMCA as well as more traditional judicial temporary restraining orders and preliminary injunctions. In contrast to the agonizing over prior restraints in non-copyright speech cases, preliminary injunctive relief issues more or less as a “matter of course” where copyright infringement is alleged.⁵⁰

C. A Copyright Exception to the First Amendment

1. Rationales

On their face, both copyright and the First Amendment can be seen as speech-promoting laws.⁵¹ Copyright law incentivizes speech by allowing authors to capture the economic value created by their works of authorship, while the First Amendment protects speakers against efforts to punish unpopular speech. But copyright law, by allowing individuals a limited monopoly over certain forms of expression, and thereby preventing other individuals from using them freely, may conflict with unfettered free speech.⁵² When this happens, the Supreme Court has held that free speech generally must give way, articulating three primary justifications for its position.

First, without engaging in any extended historical analysis, the Supreme Court has read the temporal proximity in passage of the First Amendment (1788) and the first Copyright Act (1790) as signaling the founders’ acceptance of the compatibility of limited copyright monopoly with free speech values.⁵³ Thus, according to the Court, no express balancing of copyright and free speech rights is necessary.

*93 Second, the Supreme Court has suggested that limitations on free speech-related use of copyrighted material are inherent in the utilitarian framework of American copyright law. Copyright law, it is argued, by providing economic incentives to produce new works of authorship, enriches the marketplace of ideas more than it impoverishes it through the allowance of a narrowly drawn, limited monopoly.⁵⁴ If the First Amendment extended a right to freeloader on another’s expression, the author might be disinclined to create the work of authorship in the first place or to share it with the public.⁵⁵

Finally, the Supreme Court has held that free speech interests are adequately protected through the two major copyright-limiting doctrines: the idea/expression dichotomy and fair use.⁵⁶ According to the Court, the 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,”⁵⁷ and fair use allows sufficient “latitude for scholarship and comment.”⁵⁸

2. Harper & Row v. Nation Enterprises.

The leading Supreme Court case articulating the copyright exception to the First Amendment revolved around the memoirs of former president Gerald Ford.⁵⁹ In 1977, Ford contracted with publisher Harper & Row to publish his “as yet unwritten memoirs,” including material on the Watergate crisis, Ford’s pardon of Nixon, and his “reflections on this period of history, and the morality and personalities involved.”⁶⁰ Two years later, as the memoirs neared completion, Harper & Row entered into an agreement with Time magazine to publish an exclusive 7,500-word excerpt from the forthcoming book approximately one week before it hit bookstores.⁶¹

*94 In April 1979, about two weeks before the Time article was to appear, The Nation published a 2,250-word article including “quotes [totaling approximately 300 words], paraphrases, and facts drawn exclusively from the manuscript,” which had been provided to it by an unidentified third party.⁶² Time cancelled its contract and Harper & Row brought suit for copyright infringement.⁶³ In response, The Nation argued, first, that most of the material it used was factual matter rather than copyrightable expression, and second, that given the brevity of the actual quotations, the First Amendment importance of the topic, and the lack of impact on the market for the book, its use was “fair.”⁶⁴ The case went to the Supreme Court after the Second Circuit Court of Appeals reversed the trial court’s finding of infringement.⁶⁵

The Supreme Court held that The Nation’s publication of the Ford excerpt was not fair use, focusing on two critical, interrelated points: first, under the second prong of the received test, the Court emphasized that “the fact that the plaintiff’s work is unpublished . . . is a factor tending to negate the defense of fair use.”⁶⁶ Here, the Court also held, in contradiction to generally accepted copyright doctrine, that factual works were deserving of greater protection than “works of fiction or fantasy.”⁶⁷ Second, under prongs one (nature of use) and four (market effect), the Court found that The Nation’s “use had not merely the incidental effect but the intended purpose [and effect] of supplanting the copyright holder’s commercially valuable right of first publication.”⁶⁸ The Court further suggested, under prong one, that the magazine acted in bad faith by using a “purloined manuscript.”⁶⁹ It held that despite their relative brevity in relation to the book as a whole, the quoted passages were among “the most powerful passages” in “the most interesting and moving parts of the entire manuscript,” weighing against fair use under prong three (amount and substantiality of use).⁷⁰ In its conclusion, the Court noted that because “any copyright infringer may claim to benefit the public by increasing public access to the copyrighted work,” First Amendment-related arguments for public interest copying did not support a finding of fair use.⁷¹

*95 Writing for the three dissenters in the case, Justice Brennan did not dispute the potentially deleterious effect of The Nation’s copying on Ford’s market, but instead, invoking the idea/expression dichotomy, claimed that very little protected expression, as opposed to unprotected, chronologically ordered facts, had been copied.⁷² Moving on to the fair use test, he argued that the purpose of The Nation’s use--news reporting-- supported a finding of fair use under prong one,⁷³ while the factual nature of the quoted matter as well as its brevity weighed in favor of fair use under prongs two (the nature of the copied work)⁷⁴ and three (amount and substantiality of use).⁷⁵ If The Nation’s use had a negative market impact, he reasoned, Harper & Row had “no right to set up copyright as a shield from competition in that market because copyright does not protect information.”⁷⁶ Finally, Brennan argued that the majority’s “categorical presumption” against fair use of unpublished works was unsupported by case or statutory law.⁷⁷

Following the Court’s decision in Harper & Row, Congress amended the Copyright Act’s fair use provision. While it did not alter the enumerated fair use factors, Congress did make express the applicability of fair use to unpublished as well as published works.⁷⁸ Regardless, Harper & Row subsequently has been widely cited in support of the propositions that unpublished works are peculiarly immune to fair use scrutiny,⁷⁹ and that no further First Amendment analysis need be applied.⁸⁰ As precedent, it arguably has allowed owners to claim the strongest copyright protection in works that offer the least in terms of public benefit and in which there may be the strongest public interest in free speech disclosure.

*96 3. Criticisms

Always disputed, the copyright exception recently has been the subject of considerable criticism.⁸¹ Historians and judges have

questioned the Court's historical account of founders' intent, pointing to the antimonopolist sentiments of Thomas Jefferson and others,⁸² as well as to evidence showing rampant piracy, limited copyright registration, and absence of infringement litigation in the early republic.⁸³ More importantly, changes in reprography and distribution technology, and expansion of the copyright regime since the founding period, further render resort to founders' intent problematic. The term of copyright protection has expanded significantly, from fourteen years in 1790 to life of the author plus seventy years today.⁸⁴ Works previously exempted from copyright, including derivative works, are now protected.⁸⁵ Moreover, such formalities as registration and notice have been abolished, making copyright protection automatic from the moment a qualifying work of authorship is fixed in a tangible medium.⁸⁶ Citing the utilitarian framework of American copyright law, some critics have asked whether the present copyright regime overcompensates authors at a high price to the public.⁸⁷ Copyright law, it is argued, provides a greater monopoly than is necessary to incentivize production of *97 works of authorship⁸⁸ while impoverishing the public domain that is vital to future creativity.⁸⁹

A pruning back of copyright limiting doctrines also has occurred. While the Supreme Court struck a significant victory for the idea/expression dichotomy in *Feist Publications, Inc. v. Rural Telephone Service, Co.* in 1991, where it held that a telephone directory's listings were non-original facts that could be used freely by others without infringement or misappropriation,⁹⁰ several subsequent lower court decisions have allowed protection of factual matter against copying on state or common law contract or tort grounds.⁹¹ Despite its apparent flexibility, fair use has also undergone retrenchment as first the Supreme Court and now lower courts increasingly have emphasized that a use must be transformative in order to be "fair."⁹² As one scholar has observed, this analysis often involves a "quasi-moral" evaluation of the alleged infringer's creative worthiness.⁹³ In theory, the transformative nature of a use is only one subsection of one prong of the four-prong fair use test, but many courts now are treating it as a deciding factor,⁹⁴ seriously disadvantaging other large classes of First Amendment significant use.

The market failure rationale for fair use also has contracted in response to the growth of electronic media, where transaction barriers for licensing many works of authorship have diminished.⁹⁵ (This assumes, of course, that the author is willing to transact, which may be incorrect where the proposed use is critical.) Other shifts brought about by electronic media have consequences as well. Thanks to the ease and visibility of infringement on the Internet, copyright owners are increasingly targeting individual copyright infringers as opposed to major counterfeiters or larger *98 entities alleged to be secondarily liable, such as device makers or intermediaries.⁹⁶ This pattern, which has been noted in other areas of Internet-related law, including libel, involves a "role reversal" of sorts because, in contrast to earlier non-Internet litigation, the plaintiff is likely to be a large organizational entity and the defendant an individual.⁹⁷ In the fair use context, this can make a huge difference. By its nature, fair use is indeterminate.⁹⁸ As an affirmative defense, whether a use is "fair" can be determined only within the context of infringement litigation, and the defendant bears the burden of proof.⁹⁹ Thus, individual Internet users with limited resources may be silenced by the mere threat of litigation long before a fair use analysis is brought to bear on any First Amendment interests.

4. Limits of the Copyright Exception?

The Supreme Court recently suggested possible limits on the reach of the copyright exception, holding that further First Amendment scrutiny above that afforded by copyright limiting doctrines is unnecessary "when . . . Congress has not altered the traditional contours of copyright protection."¹⁰⁰ This passage suggests that the further copyright claims veer from the traditional incentive structure of copyright, the more First Amendment scrutiny is warranted--or perhaps even demanded. The Supreme Court has yet to find an instance, however, where the traditional contours of copyright protection have been altered. In *Eldred v. Ashcroft*, the Court declined to hold that the twenty-year extension of the copyright term under the Sonny Bono Copyright Term Extension Act¹⁰¹ worked such an alteration.¹⁰² But in the same decision, the Court also rejected the appellate court's finding of a categorical immunity of copyright from the First Amendment,¹⁰³ which seems to leave *99 the door open for a future reassessment of the balance between intellectual property and free speech rights.¹⁰⁴

II. Troubling Cases

Lacking a pronouncement by the Court that the copyright exception to the First Amendment is overturned, greater accommodation of free speech likely will have to occur through existing copyright limiting doctrines. The idea/expression dichotomy and fair use, while obvious candidates for this role, have so far proved inadequate, as becomes apparent when recent case law is taken into account. Between 1995, when the Internet first became a household word, and the present date, four notable Internet cases have pitted the First Amendment against copyright in ways that promise to provide a blueprint for

significant future litigation using copyright claims against critical speakers. Already, hundreds of cease-and-desist letters along similar lines have been mailed to Internet speakers or to ISPs.¹⁰⁵ While these cases are not without pre-Internet analogues, proliferation of aggressive copyright claims has the potential to significantly chill the important new opportunities for free speech afforded online.

A. The Cases.

1. Religious Technology Center v. Netcom On-Line Communication Services, Inc.¹⁰⁶ and Religious Technology Center v. Lerma.¹⁰⁷

The first two cases were filed in 1995 by Scientologist organizations Religious Technology Center (RTC) and Bridge Publications, Inc. (BPI), against two former members and longtime critics of the sect, Dennis Erlich and Arnoldo P. Lerma.¹⁰⁸ Both were alleged to have violated copyright and trade secret laws by posting unpublished Scientologist training and scriptural works on alt.religion.scientology, an Internet newsgroup devoted to critical commentary on the church.¹⁰⁹ Erlich claimed that the documents he posted had either been previously posted anonymously on the Internet or he had received them anonymously *100 through the mail.¹¹⁰ Lerma had obtained 136 pages of “instructions for progressing through levels of spirituality, or thetans” from publicly available federal court records.¹¹¹ Both men’s homes were raided and their computer equipment seized.¹¹² Erlich and Lerma’s ISPs were also accused of secondary copyright infringement.¹¹³

Part way into Lerma, RTC joined the Washington Post and two of its reporters as defendants to the suit after they cited portions of the contested scriptural documents in an article on the case.¹¹⁴ These claims eventually were dismissed by the court, which held that the scriptural documents at issue were not trade secrets and that the newspaper had likely engaged in fair use.¹¹⁵ The claims against Lerma’s ISP were also dismissed from the suit. But in October 1996, the court granted RTC’s motion for summary judgment on copyright infringement, rejecting Lerma’s fair use claims.¹¹⁶ Following the court’s ruling that triable issues of fact existed regarding the contributory infringement claim,¹¹⁷ Erlich’s ISPs settled the suit in August 1996 without admitting any wrongdoing.¹¹⁸ In early 1999, Erlich also settled the claims against him.¹¹⁹

*101 2. Intellectual Reserve, Inc. v. Utah Lighthouse Ministry, Inc.¹²⁰

In October 1999, Intellectual Reserve, a corporation that manages the intellectual property assets of the Mormon Church, sued Jerald and Sandra Tanner, who had placed approximately 17 of 160 pages of the Church Handbook of Instruction on their Utah Lighthouse Ministry (ULM) website.¹²¹ Descendants of old Mormon families, the Tanners had become born-again Christians and self-appointed gadflies of the church beginning in the 1960s, and had established ULM in 1983 to “document problems with the claims of Mormonism and compare [the Church of Jesus Christ of Latter-day Saints] doctrines with Christianity.”¹²² The Handbook posted by the Tanners was created by the Mormon Church in 1998 “solely for use by general and local Church officers to administer the affairs of the Church.”¹²³ Its distribution was “limited to these Church officers,” who were required to “promptly” give their copies of the Handbook to their successors when they were released from office.¹²⁴ Although the Tanners offered some works for sale on their website, the partial Handbook was made available to the public free alongside other documents critical of the Mormon Church.¹²⁵

After the court ordered the Tanners to remove the Handbook from their website, they linked from the ULM site to other websites hosting copies of the Handbook.¹²⁶ Intellectual Reserve then argued that the couple contributed to copyright infringement of those who browsed other websites hosting the Handbook.¹²⁷ The court agreed, and issued a preliminary injunction barring the links. It rejected the defendants’ free speech claims, holding that “the First Amendment does not give defendants the right to infringe on legally recognized rights under the copyright law.”¹²⁸ In November 2000, the parties settled the lawsuit out of court.¹²⁹ The Tanners *102 maintained that they had done no wrong in making fair use of the Handbook, but lacked the funds to pursue further litigation against Intellectual Reserve.¹³⁰

3. Online Policy Group v. Diebold, Inc.¹³¹

In October 2003, electronic voting manufacturer Diebold sent a cease-and-desist letter to the Online Policy Group (OPG), a non-profit ISP.¹³² Diebold demanded that OPG remove links on a website, for which it provided services, to electronic archives containing approximately fifteen thousand embarrassing e-mails leaked or unlawfully intercepted from the company, detailing errors and security lapses in electronic voting machines as well as failures by Diebold to comply with state certification regulations.¹³³ Diebold also sent a notice-and-take-down letter to OPG’s upstream Internet service provider,

Hurricane Electric, asking it to take down the link in accordance with section 512(i)(1)(A).¹³⁴ Both OPG and Hurricane claimed they couldn't simply disable the allegedly infringing link.¹³⁵ To unilaterally comply with Diebold's request, OPG would have to deny service to the entire website, while Hurricane would be forced to disconnect all of OPG's users, an estimated 77,000 individuals.¹³⁶ OPG filed for declaratory and injunctive relief against Diebold, claiming that the e-mail archive constituted fair use and that Diebold had asserted invalid copyright claims.¹³⁷ It was joined by two Swarthmore College undergraduates, Nelson Chu Pavlovsky and Luke Thomas Smith, who had posted the Diebold e-mail archive on their Swarthmore Coalition for the Digital Commons student organization website, hosted by Swarthmore, in October 2003.¹³⁸ Shortly thereafter, Pavlovsky and Smith learned that Diebold had sent a notice-and-take-down letter to Swarthmore College, and on October 22, 2003, the college disabled *103 access to the e-mail archive.¹³⁹ In early December 2003, after receiving a considerable amount of negative press coverage, Diebold promised not to pursue copyright infringement litigation against any Internet posters of the e-mail archive.¹⁴⁰ The company maintained that its "legal position was and continues to be correct," but "to help refocus the public debate on that central issue [the accuracy of voting], and recognizing that a considerable amount of the stolen e-mail archive is now widely available on the Internet," withdrew its cease-and-desist letters.¹⁴¹

B. A Common Pattern

While distinct in several procedural aspects, Netcom, Lerma, ULM, and Diebold present a common pattern: each involves a small Internet user threatened with suit, or sued, for copyright infringement after posting online, for critical purposes, complete or substantial selections of documents owned by a large corporate or religious organization. In each case, the documents in question had not been publicly distributed, nor did the corporation ever intend to make them available to the public. In fact, the stated purpose of each lawsuit was to keep the documents at issue from the public in order to advance privacy interests or economic interests extraneous to those in publication of the copyrighted matter. Although some form of unlawful interception was alleged to have occurred in each case, ultimately the only legal issue was whether the posting of the documents infringed copyright, because trade secret claims were not brought (ULM, Diebold) or were dismissed (Netcom, Lerma).

In response to these copyright claims, each alleged infringer raised First Amendment, idea/expression dichotomy (which are sometime collapsed under prong three), or fair use arguments. In two of the four cases, Netcom and Lerma, the court explicitly rejected the defendants' fair use arguments. In ULM, only the issue of injunctive relief was considered by the court. The defendants did not raise a fair use defense, likely as a result of inexperienced counsel, but did present First Amendment arguments, which the court rejected.¹⁴² In the fourth case, Diebold, the court never reached the merits of the case after Diebold voluntarily withdrew its *104 threats of infringement litigation after forcing OPG to go to court at considerable cost.

1. Testing Fair Use.

The common facts presented in these cases were not favorable to a fair use defense for reasons that point to significant limitations on the fair use doctrine as it has developed.

i) The purpose and character of the use.

Ironically, the first problematic aspect is the critical purpose of the use. Criticism is one of several categories of use specifically mentioned as eligible for fair use protection in section 107 of the Copyright Act.¹⁴³ While the Netcom court found in Erlich's favor that his "intended purpose was criticism or comment,"¹⁴⁴ in Lerma, Lerma's critical purpose was held against him. Because Lerma was not "neutral," the court reasoned that his postings were not primarily "for the public benefit."¹⁴⁵ This finding, which seems surprising on its face, may stem from the Lerma court's association of "public benefit" criticism with more conventional media outlets, such as the Washington Post, which it had dismissed from the case.¹⁴⁶ But such reasoning fails to embrace the new democratic possibilities of the Internet. A fuller First Amendment analysis might have addressed this issue, but such an analysis is precisely what fair use in its existing shape does not allow for.

A second problem derives from the defendants' wholesale copying with minimal or no commentary. Erlich and Lerma both argued that their acts of posting the documents to some extent spoke for themselves,¹⁴⁷ and that their use should be evaluated in view not only of "an individual posting" but also as part of an "ongoing debate" on the newsgroup.¹⁴⁸ These arguments were rejected by the courts, which found the uses to be at best only "minimally transformative."¹⁴⁹ Focus on *105 transformative effect, while perhaps appropriate to more creative uses, undervalues the public interest value of disclosure in

these cases, particularly when the fact that the copyright owner has not and does not intend to publish the works is taken into account. At the same time, the courts' narrow focus on the copy itself, rather than on its critical context, failed to appreciate the unique intertextual nature of the Internet.

One would think the fact that each critical use was made without commercial motive would weigh heavily in favor of the alleged infringers. After all, this factor should distinguish speakers from mere pirates and in at least some cases diminish the possibility of harm to the copyright owner's economic assets. According to the Erlich court, however, the use's noncommercial nature tipped prong one only "slightly" in Erlich's favor, and in its conclusion, it reiterated as the basis of its finding against fair use that there was only "minimum added criticism or commentary."¹⁵⁰ By contrast, in *Lerma*, the court held that under prong one "the noncommercial character of *Lerma's* copying and posting does not outweigh *Lerma's* nonneutral and non-scholarly motives."¹⁵¹

Because the defendants posted works that were not publicly available, the plaintiffs in each of these cases also alleged that they had been unlawfully intercepted, and that the defendants' bad faith precluded a finding of fair use. The case law offers little clarity on this issue. *Harper & Row* had held that the "propriety of the defendant's conduct," or lack thereof, should weigh against a finding of fair use.¹⁵² But the Supreme Court refused to consider bad faith in its next major fair use analysis in *Campbell*.¹⁵³ The Second Circuit Court of Appeals has recently held that knowledge that "access to the manuscript was unauthorized or was derived from a violation of law or breach of duty" should weigh against fair use.¹⁵⁴ The Federal Circuit has gone so far as to suggest that in order to invoke fair use, the defendant must possess an authorized copy.¹⁵⁵ The unwillingness of the copyright owner to authorize use at any price, as is often the case where the intended use is ***106** critical, did not prevent the court in *Netcom* from imputing bad faith and holding that it weighed against fair use.¹⁵⁶

ii) The Nature of the Copyrighted Work

This prong of the fair use test is used to assess the copyrighted work along two axes: whether it is primarily factual or informational versus expressive (a subfactor similar to the idea/expression dichotomy), and whether it is published or unpublished.¹⁵⁷ In each case here, the matter at issue was sufficiently informational to raise questions about its status as a creative work of authorship, but not so much so as to favor fair use. As the *Lerma* court recognized, scriptural or religious instructive works are difficult to classify because they may be viewed differently by believers versus nonbelievers.¹⁵⁸ Moreover, believers, who see scripture as factual in a religious context, may still argue that it is expressive in a legal context in order to secure stronger copyright protection.¹⁵⁹ Outside the copyright arena, it is difficult to imagine that the internal e-mails in *Diebold* would qualify as creative works. However, the statutory creativity requirement is sufficiently minimal to guarantee at least thin copyright protection. The argument might be made in these cases that the expression at issue is sufficiently newsworthy so as to qualify as a sort of fact for speech purposes. Indeed, this argument was raised in *Harper & Row*, where it was rejected by the Supreme Court.¹⁶⁰

From the defendants' perspective in these cases, the fact that the copied works were not published was of critical importance.¹⁶¹ Without the works publicly available for inspection, the speakers' audiences would have no way to verify for themselves the veracity of the criticisms being raised. Moreover, the Internet afforded a means for the speakers to provide the works for inspection at a relatively low cost, adding a new dimension to their speech that would not be available in the offline context. For the courts, too, the fact that the works were unpublished was key to a finding that the use was not fair. Here, the courts rather predictably followed *Harper & Row*, without taking into account subsequent Congressional action to unequivocally ***107** extend fair use to unpublished works. Nor did they attempt to distinguish *Harper & Row* from the present cases on the basis of an important factual difference. The *Harper & Row* Court ultimately justified its decision by invoking the classic incentive structure of copyright law: "Where an author and publisher have invested extensive resources in creating an original work and are poised to release it to the public, no legitimate aim is served by preempting the right of first publication."¹⁶² But what if the author is not only not "poised to release" a work to the public, but also has no intention of doing so now or ever? Focused as they were on the behavior of the defendants rather than that of the copyright owners, the courts simply did not consider this distinction important.

iii) Amount and Substantiality of the Use

Perhaps the most critical fact in these cases was the amount and substantiality of the use--word for word copying of significant portions of the copyrighted texts--combined with the lack of transformative comment found under prong one. Although the Supreme Court held in *Sony* that copying an entire work should not automatically preclude fair use,¹⁶³ the *Lerma* court, for example, cited approvingly appellate court precedent holding that "whatever may be the breadth of the

doctrine of 'fair use,' it is not conceivable to us that the copying of all, or substantially all, of a copyrighted [work] can be held to be a 'fair use.'"¹⁶⁴ Again, the same issues that make substantial copying most important from a free speech perspective--full and accurate disclosure of otherwise unavailable documents--are most stigmatizing from a fair use perspective.

iv) Market Effect

In other contexts, consonant with the economic incentive structure of copyright law, the Supreme Court has held market effect to be the most important element of the fair use test.¹⁶⁵ The problem presented in these cases is that because the works at issue were unpublished, and indeed were never intended to be published, there is no market effect to examine. Diebold, for example, could not show that publication of the e-mails had harmed its own, nonexistent market for them. Instead, it claimed merely that the posters had misappropriated "private, proprietary material" whose value "was in its non-publication."¹⁶⁶ Diebold further argued, rather incredibly, that if the e-mails were of "public importance," as the poster alleged, they must have some "market value," and also suggested that it could sell *108 them to competitors, though it offered no examples of other companies having done this and expressed no intention of doing so itself.¹⁶⁷ Rather than holding the lack of a market against the copyright owner, however, some courts have held that it is a neutral factor or "tips slightly" in favor of the alleged infringer as in *Lerma*.¹⁶⁸ Thus, even though the most important fair use factor weighed in their favor, the defendants were found ineligible to benefit from the defense.

C. The Failings of Fair Use

In theory, fair use should be sufficiently flexible to allow for a weighing of the equities in cases like these where copyright infringement and free speech interests conflict. By the same measure, the incorporation of fair use into the Copyright Act should merely expand the frequency of its application. In practice, however, a critical drawback of the statutory codification of the fair use doctrine may have been the loss of precisely the equitable flexibility that made it attractive to begin with. Congress made clear at the time of its statutory adoption that fair use was to be neither more nor less broad than it was in the prior case law.¹⁶⁹ Thus, while the scope of statutory copyright protection has expanded, fair use has remained at best fixed, leaving it particularly ill-suited to deal with technological change. This is unfortunate because, as Dan Burk has noted of misuse, an equitable doctrine ideally should be applied to "legal claims that might be technically legitimate, but which would lead to socially perverse outcomes."¹⁷⁰ Put somewhat differently, robust equitable doctrines may be needed to provide a safety valve even after the legislature has seen fit to incorporate safeguards into statutory law. The codification of fair use--a major victory at the time-- has led to its calcification, severely limiting its usefulness in new battles over the limits of copyright.

There is another, different problem. So long as both the alleged infringer and the copyright owner are engaged in public dissemination of the types of creative works traditionally encouraged by copyright law, the fair use doctrine, as it is now formulated, can help us to determine such questions as whether the alleged infringer is making a socially valuable contribution to the public; if this contribution is equal in value to or more valuable than that of the copyright owner; and to what extent the two contributions can coexist in the marketplace of ideas. As we have seen, however, fair use does not do as well when either or both the alleged infringer and the copyright holder are operating outside the traditional framework of copyright law. For example, it has become fairly evident that fair use undervalues such *109 noncreative or nontransformative, but otherwise highly social beneficial uses as dissemination of information. Fair use is also inadequate when it comes to differentiating between more or less legitimate assertions of copyright by owners. Certainly, assessment of the "nature" of the copyrighted work under prong two of the fair use test may offer some clues in this regard, as may examination of the market for the work under prong four. But because fair use today offers at best an artificial and asymmetrical weighing of the equities, fair use also undervalues bad conduct by the copyright owner. Because fair use has ceased to serve as a truly equitable doctrine, even as statutory copyright protection has expanded, a supplement is needed.

III. Misuse

Misuse is an equitable doctrine that has recently been introduced from patent law into copyright law. Where fair use focuses on the defensibility of the actions of the alleged infringer, misuse scrutinizes the conduct of the copyright owner. Closely related to the defense of "unclean hands," misuse holds that a rights holder, who has attempted to leverage his or her intellectual property rights beyond its proper scope, or in a manner inconsistent with the grant of statutory protection, has no recourse against any infringer until the misuse is "purged," that is, until its effects are reversed.¹⁷¹ While in the patent law

context it has come to be increasingly associated with antitrust concerns,¹⁷² copyright misuse retains a more equitable feel. Thus, while its contours remain at present uncertain as a limiting doctrine, copyright misuse has the potential to protect important First Amendment interests that are underserved by current fair use analysis.¹⁷³

A. The History of Patent Misuse

An equitable patent misuse doctrine was first embraced by the Supreme Court in cases involving infringement actions by companies that had engaged in anticompetitive “tying,” or forcing customers of their patented machines also to purchase *110 associated products.¹⁷⁴ Tying may constitute an antitrust violation in itself, and indeed in much prior case law, misuse was used to prevent the legitimate monopoly conferred on rights holders by patent law from becoming an illegitimate monopoly under antitrust law.¹⁷⁵ However, in a series of cases decided between 1917 and 1944, most famously in *Morton Salt*, the Court made clear that no violation of antitrust law was necessary to find patent misuse.¹⁷⁶ Instead, a patent infringement suit might be “rightly dismissed . . . for want of equity” and as “contrary to public policy,” because “[t]he patentee, like . . . other holders of an exclusive privilege granted in the furtherance of a public policy, may not claim protection of his grant by the courts where it is being used to subvert that policy.”¹⁷⁷

Until the mid-1980s, courts continued to ask whether a patentee’s conduct was in harmony with patent policy rather than if it violated antitrust law; consequently, “patent misuse expanded to encompass a wide range of anticompetitive activities.”¹⁷⁸ In 1986, the Federal Circuit, the special patent appeals court created in 1982, proposed requiring a showing of anticompetitive effect, except for categories of conduct that previously had been expressly condemned as misuse by the Supreme Court.¹⁷⁹ In 1988, Congress passed a patent misuse act mandating a showing of market power for tying to constitute misuse.¹⁸⁰ Since that time, the Federal Circuit has generally moved toward greater reliance on antitrust analysis in non-tying misuse cases as well, although this is not uniformly the case.¹⁸¹

B. Copyright Misuse

Even as the reach of the patent misuse doctrine has receded, the copyright misuse doctrine has expanded in scope and importance. *Morton Salt* noted the analogous use of equitable principles in copyright law,¹⁸² but no discrete copyright misuse doctrine developed as it did in patent law. The Fourth Circuit became the first court to extend misuse to copyright law in *Lasercomb America, Inc. v. Reynolds*, which involved a software vendor who required licensees to agree not to participate *111 in development of competing software for ninety-nine years.¹⁸³ Over the next decade, other circuits followed suit.¹⁸⁴ Courts have long looked to patent law to guide the evolution of copyright law, a notable example being the Supreme Court’s adoption of the substantially noninfringing use doctrine to limit the secondary liability of video recording device manufacturers in *Sony Corp. of America v. Universal City Studios, Inc.*¹⁸⁵

Perhaps not coincidentally, copyright misuse first emerged in the context of computer software, which is protected under both copyright and patent law, and often is subject to the types of licensing agreements that may raise anticompetitive concerns.¹⁸⁶ But the *Lasercomb* court, echoing *Morton Salt*, took pains to emphasize the equitable rather than anticompetitive concerns animating the misuse doctrine:

[W]hile it is true that the attempted use of a copyright to violate antitrust law probably would give rise to a misuse of copyright defense, the converse is not necessarily true--a misuse need not be a violation of antitrust law in order to comprise an equitable defense to an infringement action. The question is not whether the copyright is being used in a manner violative of antitrust law (such as whether the licensing agreement is “reasonable”), but whether the copyright is being used in a manner violative of the public policy embodied in the grant of a copyright.¹⁸⁷

Copyright misuse has continued to arise with relative frequency in the software context, and some circuits have retained an anticompetitive focus in their misuse analysis, but several recent opinions¹⁸⁸ suggest movement toward broader, public policy-oriented application consistent with misuse’s equitable origins.

For example, in *In re Napster, Inc. Copyright Litigation*, the District Court for the Northern District of California found that “[r]ecently, courts have displayed a greater willingness to find copyright misuse” on both anticompetitive and public *112 policy grounds, noting the Ninth Circuit’s preference for the latter approach.¹⁸⁹ The court opined that there was a “public

interest” in allowing Napster to further develop its misuse defense.¹⁹⁰

In *Video Pipeline, Inc. v. Buena Vista Home Entertainment, Inc.*,¹⁹¹ the Third Circuit declined to find either fair use or misuse where a subsidiary of the Walt Disney Company refused to license movie trailers for certain online uses, including critical uses, but the court entered into a lengthy discussion of potential applications of the misuse doctrine. The court emphasized the “underlying policy rationale for the misuse doctrine set out in the Constitution’s Copyright and Patent Clause: ‘to promote the Progress of Science and useful Arts.’”¹⁹² It further recognized that a rights owner might attempt to use copyright in ways that impermissibly restrained others’ expression “without engaging in anti-competitive behavior or implicating the fair use and idea/expression doctrines.”¹⁹³ As an example of potential misuse, the court cited *Rosemont Enterprises, Inc. v. Random House, Inc.*,¹⁹⁴ a case in which the reclusive millionaire Howard Hughes purchased copyright in a series of articles about his life for the purpose of bringing an infringement suit against an unauthorized biographer. The appellate court reversed a preliminary injunction granted to Hughes, citing his “unclean hands.”¹⁹⁵

Even Judge Posner, who in the past has been a strong advocate of an anticompetitive approach to copyright misuse,¹⁹⁶ suggested broader public policy-oriented application of the misuse doctrine in *Ty, Inc. v. Publications International, Ltd.*, in which the court found publication of critical Beanie Baby collector’s guides to be fair use.¹⁹⁷ Posner noted that “Ty doesn’t like criticism” and that it had used copyright licensing to “reserve to it the right to veto any text” in authorized guides.¹⁹⁸ He concluded his discussion by remarking, “We need not consider [because the defense was not raised] whether such . . . [conduct] might constitute copyright misuse, endangering Ty’s copyrights.”¹⁹⁹

***113 C. Expanding Misuse to Protect Free Speech.**

Despite recent judicial approval of expanded use of the copyright misuse doctrine, as the court noted in *Napster*, “[t]he scope of the defense of copyright misuse has not been significantly tested . . . [and] remains largely undeveloped, with little case law to aid this court in its inquiry.”²⁰⁰ It should be acknowledged that, by their nature, equitable doctrines may be somewhat slippery. Nonetheless, it is critical, if public policy misuse is to have some traction, that it be developed along lines capable of general application. While articulating an actual set of workable public policy misuse standards is beyond the purview of this paper, I do want to offer some preliminary thoughts on how a misuse analysis, applied to protect free speech interests, might proceed. It is helpful to begin by broadly categorizing the functional roles misuse might play in copyright law.

In an influential early article on copyright misuse, Brett Frischmann and Dan Moylan identified three such functions: a corrective function, a coordination function, and a safeguarding function.²⁰¹ By “corrective function,” Frischmann and Moylan referred to the potential for misuse to fill gaps or address ambiguities in statute law, particularly in response to changing technology.²⁰² Thus, misuse might assist, for example, in adapting copyright to the unique possibilities of the Internet. In listing the coordination function, Frischmann and Moylan nodded to misuse’s past role in negotiating the boundaries between intellectual property and antitrust law.²⁰³ In the future, however, misuse also might be used to help coordinate copyright and other areas of law that are increasingly implicated in infringement suits of the type described here, namely privacy and trade secret law. Most relevant to free speech analysis, however, is what Frischmann and Moylan described as misuse’s safeguarding function, that is, as a means not only of balancing the equities between parties, but also of safeguarding “the public policy underlying the statutory scheme where internal statutory protections are lacking.”²⁰⁴

This safeguarding function should offer the starting point of a free speech-oriented misuse defense in copyright cases such as those discussed here. The key question posed is not whether the copyright at issue is being used in a manner that is technically legal, but rather as the *Lasercomb* court put it, “whether the copyright is being used in a manner violative of the public policy embodied in the grant of a copyright.”²⁰⁵ Recall from *Morton Salt* that conduct not strictly barred by either the *114 relevant intellectual property statute or by other statutory law may still constitute misuse because it is “contrary to public policy.”²⁰⁶ This is consistent with the historic role of equity in mitigating the abuses or oversights of the law.²⁰⁷

To determine whether public policy copyright misuse has occurred, the public policy rationale underlying copyright law must be revisited. By drawing upon my discussion above and looking to legislative history and precedent, four broad statements about the traditional framework of U.S. copyright law can be made. First, the objective of U.S. copyright law is to promote the public welfare by creating incentives for wide dissemination of ideas, not to validate the inherent or unalienable rights of individual authors to their intellectual property. These incentives should be roughly proportional to the objective sought. Second, the goal of copyright, as the Supreme Court repeatedly has recognized, is best realized through publication. Otherwise, the public cannot derive benefit from the copyrighted work. Third, the incentives copyright provides, and the

corresponding interests that it recognizes, are economic ones. Copyright does not function by according privacy or other personality interests. Fourth, copyright incentivizes creation of, and protects economic interests that are vested in, creative works of authorship, not just any economically or socially valuable activity. Thus, copyright should not be used to vindicate economic interests unrelated to the marketability of the protected work itself.

These framing principles of copyright law help guide us toward questions that may reveal whether public policy-related misuse is taking place. Among others, we might ask: Is the work of the kind protected by copyright law? Is the work published? If not, will it be published in the foreseeable future or is publication the owner's desired objective? Is any interest asserted in nonpublication to allow for further development of the creative work or to protect other interests? Is copyright asserted to protect the economic value vested in the creative work as opposed to other noneconomic values or a business model? Is the purpose of the copyright infringement to quash criticism? In weighing such considerations, some commentators have suggested that public policy-related misuse might adopt over time a division between per se and rule of reason misuse violations modeled on anticompetitive misuse decisions.²⁰⁸ It is too early to pass judgment on this approach. For now, I simply suggest these factors as possible components of a quasi totality of the circumstances balancing test. It is certainly possible that in many infringement *115 cases both fair use and misuse defenses will be raised and that the various factors of each doctrine will be thrown together.

The question remains of what would it take for a copyright owner to "purge" misuse of a copyright in a fashion analogous to that in patent law?²⁰⁹ Under the patent doctrine, until the misuse is purged, the copyright owner has no recourse against infringement, not only which is alleged of the defendant, but also by any other person.²¹⁰ The parallel is relatively straightforward where discrete anticompetitive practices (for example, unduly restrictive licensing terms) are at issue. But where public policy misuse is alleged, depending upon the factual circumstances, it may be much less clear how such a purge is to be effected. Should this aspect be eliminated altogether in public policy cases, or should it be addressed on a case-by-case basis? Existing copyright misuse case law largely has avoided this problem.²¹¹ It has been suggested in the trademark context--where a latent misuse doctrine also exists--that cancellation of the misused mark may be appropriate.²¹² Although cancellation is a strong remedy, a grant of a compulsory license might be a particularly appropriate response in cases where the misuse alleged is copyright-based suppression of criticism. Refusal by courts to grant injunctive relief that would act as prior restraint on speech would represent a move in this direction, but a problem would exist insofar as statutory damages in many cases would exceed the cost of a fair market value-based license. As misuse expands, more thought will need to be given to this issue.

D. Drawbacks of the Misuse Doctrine.

In addition to questions about its application, the misuse doctrine may inspire other concerns, of which three warrant particular mention here.

***116 1. Institutional Competence**

When discussing misuse, the inevitable question arises, why not simply lobby legislators to change the copyright statute to provide greater accommodations for critical speech? One answer is that recent legislative developments including those discussed here--for example, copyright term extension-- overwhelmingly have favored copyright owners. This pronounced trend has led to charges that "[a]gain and again, Congress has been willingly captured by the publishing and motion picture industries" and other copyright holders.²¹³ One scholar has further observed that Congressional discourse about copyright tends to focus on commercial concerns rather than constitutional ones, leading to neglect of such issues as the proper limits of protection or making space for competing public interests.²¹⁴ As a result, advocates of copyright reform increasingly have taken their case to the courts.

Regardless of existing barriers to legislative change, courts have an important role to play in shaping copyright law through such judge-made doctrines as misuse. This is particularly true, as here, where speed and flexibility in responding to new technologies is critical. And as with fair use, the misuse doctrine--even if it were to be codified at some future point-- will likely always rely heavily on courts' case-by-case determinations.²¹⁵ By their very definition, equitable doctrines are intended, in specific instances, to prevent technically correct, but unjust, applications of law that legislators may be unable to anticipate or provide for when they write statutes.

Historically, courts have been critical in delimiting the boundaries of statutory copyright in order to protect socially beneficial

copying and reprographic technologies. Development of the fair use doctrine offers an obvious example. More than a century of experimentation by the courts in individual cases was needed before Congress finally codified the fair use doctrine in the 1976 Copyright Act.²¹⁶ The Supreme Court's holding in *Sony v. Universal*²¹⁷ that a patent doctrine--substantial *117 noninfringing use²¹⁸--should apply to copyright law has proved critical in protecting emerging technologies, such as the videotape recorder and, most recently, peer-to-peer file sharing networks,²¹⁹ against aggressive rights enforcement. Although it remains relatively untested, courts' recent signaling of receptiveness to the misuse doctrine suggests its real potential to join these other doctrines in protecting the public interest. While codification of the misuse doctrine may be a desirable end at some future date, for now, courts seem the appropriate forum to better define its contours and test its application.

2. The Persistence of Uncertainty

Another drawback of the misuse doctrine is that, as with fair use, it offers only an affirmative defense to charges of copyright infringement.²²⁰ Further, although it is possible that categories of per se misuse might develop over time, case-by-case balancing of some sort likely will continue to be important. And, at present, even greater uncertainty surrounds misuse's application than that of fair use. As such, misuse will offer little security in the short term to persons of limited means who want to use copyrighted works online for free speech purposes. It has been suggested that copyright misuse might be asserted as an affirmative claim, a strategy several plaintiffs have pursued so far using declaratory judgment actions, but none successfully.²²¹ Over time, copyright misuse is likely to become more of a known entity and exert a greater deterrent effect on illegitimate assertions of copyright as censorship. It is possible that the doctrine may even be used in the future to affirmatively combat such assertions. In the meantime, the expansion of misuse *118 would give alleged infringers the opportunity to turn the tables in cases where copyright is being used to silence criticism rather than to preserve legitimate economic interests in the relevant work of authorship. Moreover, there is nothing to stop misuse--which focuses on the copyright owner's actions--from being used in conjunction with fair use--which focuses on the alleged infringer's actions--allowing for a more symmetrical balancing of equities between the two.²²²

3. Privacy

Another concern about expansion of the misuse doctrine relates to privacy. I have spoken disparagingly throughout about the use of copyright to vindicate privacy concerns, and the expansion of misuse I have laid out would seek to limit privacy-related copyright claims. Undoubtedly, at least some protection of privacy is a good thing. Further, privacy is an issue more people are becoming more concerned about in light of the same digital data reproduction and dissemination technologies that have had such import for free speech and copyright. The question, then, is not whether privacy should be protected at all--it should--but whether it should be protected through copyright law.

At least two critical objections to protecting privacy under the guise of copyright can be raised. First, this approach does not serve the legitimate goals of copyright protection, that is, creation and dissemination of creative works. Second, it fails to allow for adequate balancing of privacy against other interests. Because I have addressed the first point at length, I will focus here on the second. In contrast to allowance of corporate copyright in "works for hire," privacy rights as such generally have been denied to corporations.²²³ Not coincidentally, the same utilitarian United States copyright framework that rejects a personality-based notion of copyright allows corporations to claim full protection, while the European system, which recognizes both moral and economic rights of authorship, grants the former only to real persons.²²⁴ Allowing corporations to surreptitiously claim privacy-like rights through copyright thus upsets the accepted balance struck by both existing copyright and privacy protection law.

Similarly, given the copyright exception to the First Amendment, by using copyright rather than privacy law to vindicate privacy-like interests, copyright owners can avoid greater accommodation of First Amendment interests. Many common law and state privacy torts, for example, are limited by "newsworthy," *119 "of legitimate concern to the public," or "true-facts" defenses as well as by an expectation of privacy standard.²²⁵ In *Bartnicki v. Vopper*,²²⁶ the United States Supreme Court held that a third party was not barred from publishing content unlawfully intercepted by another so long as it was of "public importance": "[P]rivacy concerns give way when balanced against the interest in publishing matters of public importance . . . a stranger's illegal conduct does not suffice to remove the First Amendment shield from speech about a matter of public concern."²²⁷ Likewise, protection of trade secrets--perhaps one analogue to corporate privacy--is tempered by First Amendment concerns once they are made publicly available regardless of the means of disclosure.²²⁸ There is a problem, then, when copyright owners use copyrighted works like trade secrets by withholding them from the public, and yet demand far greater protection than trade secret law would allow once they are publicly exposed. In patent law, by contrast, patent owners may choose patent protection or trade secret protection, but not both; more than one year of "secret use" of an

invention bars patentability.²²⁹ Whether a similar balance between privacy for purposes of development and eventual publication could be struck in copyright law is unclear.

In 1890, Samuel Warren and Louis Brandeis first argued for recognition of a copyright-like “right to privacy” barring publication of unpublished manuscripts against the author’s wishes unless the documents were of “public or general interest.”²³⁰ Warren and Brandeis made clear, however, that such a right was distinct from statutory copyright,²³¹ which was neither a proper nor sufficient means to protect privacy.²³² More than 100 years later, the then-novel right advocated by Warren and Brandeis has become widely accepted. New digital technologies mean that privacy interests increasingly may conflict with free speech rights as much as copyright *120 can.²³³ Hints of this conflict already are apparent in American case law,²³⁴ as well as in Europe, where privacy protections are more stringent.²³⁵ How it will be resolved remains uncertain, although an early round, Bartnicki,²³⁶ seemed to favor the First Amendment over privacy. In any case, it is key that legal approaches to privacy be principled ones that carefully weigh various costs in ways that copyright law is not equipped to do. In the long term, misuse in its coordination as well as safeguarding functions may serve both privacy and copyright law by discouraging an imprudent marriage between the two.

Conclusion

Unless checked, inappropriate assertions of copyright threaten to stunt the growth of the Internet as a uniquely democratic free speech forum where small speakers can reach audiences, previously available only to big media, in new ways. Development of the same reprography and transmission technologies that enable these unprecedented opportunities for speech also can threaten the intellectual property rights of copyright owners, as well as the privacy interests of citizens more broadly, in ways that must be acknowledged and addressed. Now more than ever, it is critical to find ways to distinguish legitimate from illegitimate uses of copyrighted material. Cases involving digital sampling and file sharing, for example, have inspired a heated social debate about how to mediate competing claims to the creative and economic assets embodied in copyrighted works.²³⁷ I have suggested that less agonizing need take place in cases where copying is made for First Amendment critical, rather than creative or economic, purposes, and where the interests asserted by the owners of the copied works under the rubric of copyright law do not fit within its traditional incentive structure. Unfortunately, while the accepted rationales for fair use--to maximize creativity and to correct for market *121 failure--may help assess the value of digital sampling and file sharing, they offer little guidance here. Because the Supreme Court has so far rejected weighing more explicitly First Amendment purposes when evaluating copying, the remaining alternative may be to turn our focus to the conduct of the copyright owner rather than the alleged infringer. By allowing us to do precisely that, misuse promises not only to promote a better balancing of the equities in individual cases, but also to police the boundaries between copyright and free speech law in ways protective of both.

Footnotes

¹ Reno v. ACLU, 521 U.S. 844, 868 (1997).

² Id. at 870.

³ 17 U.S.C. §§ 512, 1201 (2000).

⁴ See *infra* Part II.

⁵ Online Policy Group v. Diebold, No. C 03-04913 JF, 2004 WL 2203382, at *1 (N.D. Cal. Sept. 30, 2004).

⁶ An expansive literature exists treating the legal implications of efforts to protect copyrighted works against illegal online distribution. See, e.g., Kevin Michael Lemley, Protecting Consumers from Themselves: Alleviating the Market Inequalities Created by Online Copyright Infringement in the Entertainment Industry, 13 Alb. L.J. Sci. & Tech. 613 (2003); Symposium, Beyond Napster: Debating the Future of Copyright on the Internet, 50 Am. U. L. Rev. 355 (2000).

- 7 Eugene Volokh, Freedom of Speech and Intellectual Property: Some Thoughts After Eldred, 44 *Liquormart*, and Bartnicki, 40 *Hous. L. Rev.* 697, 713 (2003).
- 8 See *infra* Part I.C.
- 9 17 U.S.C. § 107 (1999).
- 10 Computer Sci. and Telecomms. Bd., Nat'l Acads., *The Digital Dilemma: Intellectual Property in the Information Age* 4 (2000). See also John D. Shuff & Geoffrey T. Holtz, *Copyright Tensions in a Digital Age*, 34 *Akron L. Rev.* 555 (2001).
- 11 See, e.g., *Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001) (involving conflicting copyright and free speech claims relating to online posting of DeCSS computer code); *Veeck v. S. Bldg. Code Cong. Int'l, Inc.*, 241 F.3d 398 (5th Cir. 2001), *rev'd and remanded en banc*, 293 F.3d 791 (5th Cir. 2002), *cert. denied*, 539 U.S. 969 (2003) (same conflicts arising from posting of model building codes on Internet).
- 12 U.S. Const. art. I, § 8, cl. 8.
- 13 Article 6bis of the Berne Convention recognizes two moral rights of authorship, the right to attribution and the right to integrity: “the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.” Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, Article 6bis(1), 25 U.S.T. 1341, 828 U.N.T.S. 221, (last revised Sept. 28, 1979) [hereinafter Berne Convention]. According to the Convention, these moral rights exist “independently of the author’s economic rights” and persist “even after the transfer of said rights.” *Id.* Although the United States is a signatory of the Berne Convention, it has resisted moral rights. For a useful discussion of the history and concept of moral rights, their codification in the Berne Convention, and the United States’s position, see Natalie C. Suhl, *Moral Rights Protection in the United States Under the Berne Convention: A Fictional Work?*, 12 *Fordham Intell. Prop. Media & Ent. L.J.* 1203 (2002).
- 14 Mark Lemley & R. Anthony Reese, *Reducing Digital Copyright Infringement Without Restricting Innovation*, 56 *Stan. L. Rev.* 1345 (2004).
- 15 *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985).
- 16 *Eldred v. Ashcroft*, 537 U.S. 186, 216 (2003).
- 17 *Mazer v. Stein*, 347 U.S. 201, 219 (1954); see also *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).
- 18 *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124, 142 (2001) (“The disclosure required by the Patent Act is the *quid pro quo* of the right to exclude.”) (internal quotations omitted).
- 19 *Eldred*, 537 U.S. at 216.
- 20 *Sony*, 464 U.S. at 429 (emphasis added).
- 21 1 *Nimmer on Copyright* § 2.09(F) (2002) (stating that copyright does not protect non-copyrightable subject matter simply because it is economically valuable); *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (“Creative work is to be

encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the other arts. The immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good." (emphasis added); *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932) ("In creating this right, the Congress did not reserve to the United States any interest in the production itself, or in the copyright, or in the profits that may be derived from its use The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors.").

22 *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359-60 (1991).

23 *Id.* at 350. For a critical discussion of Feist's holdings, see Jane C. Ginsburg, No "Sweat" ? Copyright and Other Protection of Works of Information after *Feist v. Rural Tel.*, 92 *Colum. L. Rev.* 338, 341-350 (1992).

24 Laurie Stearns, *Copy Wrong: Plagiarism, Process, Property, and the Law*, 80 *Cal. L. Rev.* 513, 524-25 (1992).

25 Berne Convention, *supra* note 13, Article 6bis(1).

26 See *Baker v. Selden*, 101 U.S. 99, 105 (1879) ("The description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself."); see also *Mazer v. Stein*, 347 U.S. 201, 217 (1954).

27 4 *Nimmer on Copyright* § 13.03(B)(3) (explaining merger doctrine).

28 *Id.*

29 *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 550 n.3 (1985) (quoting *Iowa State Univ. Research Found., Inc. v. Am. Broad. Cos.*, 621 F.2d 57, 60 (2d Cir. 1980)).

30 *Id.* at 550.

31 *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (quoting Pierre N. Leval, *Toward a Fair Use Standard*, 103 *Harv. L. Rev.* 1105, 1111 (1990)).

32 Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors*, 82 *Colum. L. Rev.* 1600, 1645 (1982) ("If transaction costs would inhibit transfers where consent is likely, fair use is an appropriate response."). Gordon recently has argued for a broader reading of what constitutes a market failure. Wendy J. Gordon, *Excuse and Justification in the Law of Fair Use: Transaction Costs Have Always Been Part of the Story*, 50 *J. Copyright Soc'y U.S.A.* 149, 150-51 (2003).

33 The example is drawn from Paul Goldstein, *Fair Use in a Changing World*, 50 *J. Copyright Soc'y U.S.A.* 133, 135 (2003).

34 17 U.S.C. § 107 (2000).

35 17 U.S.C. § 101; *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 448 n.31 (1984).

36 *Campbell*, 510 U.S. at 578.

- 37 Ashcroft v. ACLU, 535 U.S. 564, 595 (2002) (Kennedy, J., concurring).
- 38 See, e.g., Leonard Witt, Internet Freedom: Weblogs change face of “public journalism,” Atlanta J.-Const., Dec. 24, 2003, at A13.
- 39 See, e.g., Jack M. Balkin, Digital Speech and Democratic Culture: A Theory of Freedom of Expression for the Information Society, 79 N.Y.U. L. Rev. 1, 7 (2004) (“[T]he digital revolution drastically lowers the costs of copying and distributing information. Large numbers of people can broadcast and publish their views cheaply and widely.”).
- 40 See, e.g., MAI Sys. Corp. v. Peak Computer, Inc., 991 F.2d 511, 518-19 (9th Cir. 1993), cert. denied, 510 U.S. 1033 (1994); Triad Sys. Corp. v. S.E. Express Co., 31 U.S.P.Q.2d (BNA) 1239, 1242-44 (N.D. Cal. 1994); Advanced Computer Servs. of Michigan, Inc. v. MAI Sys. Corp., 845 F. Supp. 356, 362-64 (E.D. Va. 1994).
- 41 Lemley & Reese, supra note 14, at 1373.
- 42 Id. at 1373-74.
- 43 Pub. L. No. 105-304, 112 Stat. 2860 (1998).
- 44 17 U.S.C. § 512(c) (2004).
- 45 Id. § 512(g).
- 46 Id.
- 47 See, e.g., Katie Dean, RIAA Legal Landslide Begins, Wired, Sept. 8, 2003 (discussing the Recording Industry Association of America (RIAA) “suing 261 people it accuses of illegally distributing about 1,000 copyright music files each, using peer-to-peer networks”), at <http://www.wired.com/news/digiwood/0,1412,60345,00.html>; Katie Dean, RIAA Strikes Again, Wired, Jan. 21, 2004 (reporting that the RIAA was suing 532 more individuals for infringement), at <http://www.wired.com/news/digiwood/0,1412,61989,00.html>.
- 48 See, e.g., Pamela Samuelson, Copyright and Freedom of Expression in Historical Perspective, 10 J. Intell. Prop. L. 319, 322 (2003) (noting scholars who recognize “expansions in the scope of rights that copyright owners enjoy and contractions of fair use rights and other limitations on copyright create the potential for more conflicts between copyright and the First Amendment”).
- 49 See, e.g., Alfred C. Yen, Eldred, The First Amendment, and Aggressive Copyright Claims, 40 Hous. L. Rev. 673 (2003) (discussing the copyright exception and suggesting the need to find greater accommodation for free speech interests in copyright jurisprudence).
- 50 For a comparison of injunctive relief in the two contexts, see Mark A. Lemley & Eugene Volokh, Freedom of Speech and Injunctions in Intellectual Property Cases, 48 Duke L.J. 147 (1998).
- 51 See, e.g., Eldred v. Ashcroft, 537 U.S. 186, 244 (2003) (Breyer, J., dissenting).
- 52 Volokh, supra note 7, at 698 (“Intellectual property rules-- copyright law, trademark law, right of publicity law, and trade secret law--are speech restrictions: They keep people from publishing, producing, and performing the speech that they want to publish, produce, and perform. The laws may be well motivated and beneficial, but they are speech restrictions nonetheless, as many courts

have acknowledged.”).

53 See, e.g., *Eldred*, 537 U.S. at 219 (“The Copyright Clause and First Amendment were adopted close in time. This proximity indicates that, in the Framers’ view, copyright’s limited monopolies are compatible with free speech principles.”).

54 See, e.g., Rebecca Tushnet, *Copyright as a Model for Free Speech Law: What Copyright Has in Common With Anti-Pornography Laws, Campaign Finance Reform, and Telecommunications Regulation*, 42 B.C. L. Rev. 1, 35-67 (2000) (“Copyright poses a serious First Amendment problem. It restricts speech pervasively and powerfully, and its contours are ill-defined. Its saving grace is that it is better for free speech than its absence would be.”).

55 See, e.g., *Eldred*, 537 U.S. at 221 (“The First Amendment securely protects the freedom to make ... one’s own speech; it bears less heavily when speakers assert the right to make other people’s speeches.”).

56 *Id.* at 219-20.

57 *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985) (quoting from *Harper & Row Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 203 (2d Cir. 1983)).

58 *Id.* at 560.

59 *Harper & Row*, 471 U.S. at 539.

60 *Id.* at 542.

61 *Id.* at 542-43.

62 *Id.* at 543.

63 *Id.*

64 *Id.* at 543-44.

65 *Harper & Row*, 471 U.S. at 543-44.

66 *Id.* at 551 (citing 3 *Nimmer on Copyright* § 13.05).

67 *Id.* at 563.

68 *Id.* at 562.

69 *Id.* at 563.

70 *Id.* at 565 (quoting in part *Time* editor who testified).

71 Harper & Row, 471 U.S. at 569.

72 Id. at 584-86 (Brennan, J., dissenting).

73 Id. at 590-94.

74 Id. at 594-98.

75 Id. at 598-600.

76 Id. at 603.

77 Harper & Row, 471 U.S. at 595-96.

78 Act of Oct. 24, 1992, Pub. L. No. 102-492, 106 Stat. 3145 (1992) (adding “The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors” to §107 of the Copyright Act) (codified at 17 U.S.C. § 107).

79 See, e.g., Kate O’Neill, *Against Dicta: A Legal Method for Rescuing Fair Use From the Right of First Publication*, 89 Cal. L. Rev. 369, 407-36 (2001) (referencing this case as the first Supreme Court case that pitted the interests of the press and their readers against manuscript draftees).

80 See, e.g., *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003) (stating where Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary).

81 E.g., Jed Rubenfeld, *The Freedom of Imagination: Copyright’s Constitutionality*, 112 Yale L.J. 1 (2002) (offering a stinging critique of the copyright exception).

82 *Eldred*, 537 U.S. at 246 (Breyer, J., dissenting) (noting that Madison, like Jefferson and others, warned against the dangers of monopolies).

83 See, e.g., John Tebbel, *A History of Book Publishing in the United States: the Creation of an Industry 1630-1865* 142 (1972); Lyman Ray Patterson, *Copyright in Historical Perspective* 207 (1968).

84 See *Eldred*, 537 U.S. at 194-95 (discussing the historical extension of copyright term).

85 Compare 17 U.S.C. § 104(a) (1976) with 17 U.S.C. § 104(a) (1909).

86 See, e.g., Shira Perlmutter, *Freeing Copyright From Formalities*, 13 Cardozo Arts & Ent. L.J. 565 (1993) (discussing how many of the formalities in copyright law have been eliminated).

87 This argument was forcefully raised by the petitioners and their amici in *Eldred*. They argued that recent copyright term extensions were “a windfall, not an incentive” and failed to benefit the public. Brief for Petitioners at 23, *Eldred v. Ashcroft*, 537 U.S. 186

(2003) (No. 01-618), available at <http://eldred.cc/legal/supremecourt.html>; see also Brief of Amici Curiae 17 Economics Professors at 3, *Eldred v. Ashcroft*, 537 U.S. 186 (2003) (No. 01-618) (“Taken as a whole, it is highly unlikely that the economic benefits from copyright extension under the CTEA outweigh the additional costs.”), available at <http://eldred.cc/legal/supremecourt.html>.

88 Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 *Harv. L. Rev.* 302 (1970) (positing that copyright protection may not be needed to spur the creation of socially beneficial works of authorship). *Contra* Barry Tyerman, *The Economic Rationale for Copyright Protection for Published Books: A Reply to Professor Breyer*, 18 *UCLA L. Rev.* 1100, 1102-03 (1971) (arguing in response to Breyer that “existing federal copyright structure provides a relatively efficient, and, most importantly, time-proven system for ensuring both that authors find it intellectually and financially profitable to write, and that the American publishing industry is capable of producing a broad spectrum of book titles”).

89 See, e.g., Lawrence Lessig, *Free Culture: How Big Media Uses Technology and the Law to Lock Down Creativity* (2004).

90 499 U.S. 340, 350 (1991).

91 See, e.g., *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447 (7th Cir. 1996); *eBay, Inc. v. Bidder’s Edge, Inc.*, 100 F. Supp. 2d 1058 (N.D. Cal. 2000).

92 See, e.g., Matthew D. Bunker, *Eroding Fair Use: The “Transformative” Use Doctrine After Campbell*, 7 *Comm. L. & Pol’y* 1 (2002).

93 *Id.* at 21.

94 *Id.* at 17.

95 Goldstein, *supra* note 34, at 136-37; Edmund W. Kitch, *Can the Internet Shrink Fair Use?*, 78 *Neb. L. Rev.* 880, 882 (1999).

96 See Dean, *supra* note 49.

97 See Margo E. K. Reder & Christine Neylon O’Brien, *Corporate Cybersmear: Employers File John Doe Defamation Lawsuits Seeking the Identity of Anonymous Employee Internet Posters*, 8 *Mich. Telecomm. & Tech. L. Rev.* 195, 210 (2002).

98 Goldstein, *supra* note 34, at 134 (explaining why fair use is an indeterminate doctrine).

99 See, e.g., 4 *Nimmer on Copyright* § 13.05[A][4] (stating defendant “bears the burden of proof on the fair use affirmative defense”). In order to gain injunctive relief, in many jurisdictions, the plaintiff technically must demonstrate a likelihood of success on the merits, including overcoming any fair use defenses. *Id.* § 13.05[C][2] (“In the context of a preliminary injunction, by contrast, the burden rests on the plaintiff.”). In practice, injunctive relief is almost always granted as a matter of course.

100 *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003) (emphasis added).

101 Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified at 17 U.S.C. §§302-304).

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

103 Id. (“[T]he D.C. Circuit spoke too broadly when it declared copyrights ‘categorically immune from challenges under the First Amendment.’”) (citations removed).

104 The Court’s cryptic pronouncement has led to considerable speculation, and guarded optimism, among scholars. See, e.g., Yen, *supra* note 51.

105 Berkman Center for Internet & Society, Chilling Effects Clearinghouse: Cease and Desist Database (cataloguing a number of these letters), at <http://www.chillingeffects.org/dmca512/search.cgi> (last visited on Nov. 6, 2004).

106 923 F. Supp. 1231 (N.D. Cal. 1995).

107 897 F. Supp. 260 (E.D. Va. 1995) (denying RTC’s motion for temporary restraining order and preliminary injunction).

108 *Id.*; Netcom, 923 F. Supp. at 1231.

109 Netcom, 923 F. Supp. at 1239; Lerma, 897 F. Supp. at 261. It is somewhat unclear whether Lerma posted the documents on alt.religion.scientology or on his website or both.

110 Netcom, 923 F. Supp. at 1239-40.

111 See Mike Allen, Dissidents Use Computer Network to Rile Scientology, N.Y. Times, Aug. 14, 1995, at A12.

112 *Id.* (reporting seizure of 400 computer disks and computer equipment estimated to be worth around \$3,500); RTC v. Lerma, 908 F. Supp. 1353, 1362 (E.D. Va. 1995) (vacating writ of seizure against Lerma); Netcom, 923 F. Supp. at 1261-62 (vacating writ of seizure against Erlich and ordering that all articles seized be returned).

113 Lerma, 897 F. Supp. at 260-61 (naming Digital Gateway Systems as a co-defendant); RTC v. Lerma, 908 F. Supp. at 1361; Netcom, 923 F. Supp. at 1240 (addressing liability of Erlich’s bulletin board service and ISP).

114 Lerma, 897 F. Supp. at 262.

115 See Richard Leiby, Scientology Fiction: The Church’s War Against Its Critics--and Truth, Wash. Post, Dec. 25, 1994, at C1 (discussing the church’s actions against critics); Marc Fisher, Church in Cyberspace: Its Sacred Writ Is on the Net. Its Lawyers Are on the Case., Wash. Post, Aug. 19, 1995, at C1 (discussing Lerma case); Lerma, 897 F. Supp. at 262-67 (denying RTC’s request for a temporary restraining order and preliminary injunction for impoundment against the Washington Post).

116 RTC v. Lerma, 40 U.S.P.Q.2d (BNA) 1569, 1571 (E.D. Va. 1996) (granting summary judgment for RTC).

117 RTC v. Netcom On-Line Communications, Inc., 907 F. Supp. 1361 (N.D. Cal. 1995).

118 Benjamin Pimentel, Netcom Settles Scientology Copyright Suit, S.F. Chron., Aug. 5, 1996, at A22.

119 Reports of the settlement appeared on alt.religion.scientology in early May 1999. See, e.g., Posting of Rod Keller to alt.religion.scientology, May 2, 1999 (ARS Week in Review, vol. 4, issue 5, reporting postings related to settlement), available at <http://www.xenu.net/archive/WIR/>. A Stipulated Final Judgment and Permanent Injunction was entered in the case on May 3,

1999. Judge Ronald M. Whyte, Stipulated Final Judgment and Permanent Injunction, *RTC v. Netcom On-Line*, Civ. No. C-95-20091 RMW (N.D. Cal. May 3, 1999) (No. 1207).

120 75 F. Supp. 2d 1290 (D. Utah 1999).

121 *Id.*

122 Defendants' Motion to Dismiss, *Intellectual Reserve v. Utah Lighthouse Ministries*, Case No. 2:99 CV 808C (D. Utah filed Nov. 12, 1999), available at <http://www.techlawjournal.com/courts/lds/19991112mot.htm> (last visited Nov. 11, 2004); Utah Lighthouse Ministry website, <http://www.utlm.org/>.

123 Plaintiff's Verified Complaint at 4, ULM, 75 F. Supp. 2d 1290 (No. 2:99 CV 808C) (Oct. 13, 1999), available at <http://legal.web.aol.com/decisions/dlip/iricomplaint.pdf> (last visited on Nov. 6, 2004).

124 *Id.*

125 See Press Release, Utah Lighthouse Ministry, Settlement of LDS Church v. Utah Lighthouse Ministry (Nov. 30, 2000), at <http://www.utlm.org/underthecoveroflight/pressreleasesettlement.htm> (last visited on Nov. 6, 2004) ("We did not sell the material and we made no profit from its posting. The [Church of Jesus Christ of Latter-Day Saints] did not sell the material and lost no income because of our posting.").

126 ULM, 75 F. Supp. 2d at 1292.

127 *Id.* at 1295.

128 *Id.*

129 Press Release, *supra* note 128.

130 *Id.* ("We did not violate any copyright law We have agreed to put this matter behind us. Our resources are better spent for their intended purpose: to examine the claims of the [Church of Jesus Christ of Latter-Day Saints] and contrast those teachings with Christianity.").

131 72 U.S.P.Q.2d (BNA) 1200 (N.D. Cal. 2004).

132 See First Am. Compl. at P 14, OPG, 2004 U.S. Dist. LEXIS 19697 (Nov. 14, 2003), at http://www.eff.org/legal/ISP_liability/OPG_v_Diebold/First_Amended_Complaint.pdf (last visited Nov. 6, 2004).

133 *Id.* at PP 14-20; John Schwartz, File Sharing Pits Copyright Against Free Speech, *N.Y. Times*, Nov. 3, 2003, at C1 (stating that Diebold demanded removal of 15,000 email messages and memorandums that appeared to document security flaws and "last-minute software changes that, by law, are generally not allowed after election authorities have certified the software for an election").

134 First Am. Compl. at PP 24-25.

135 Id. at PP 20, 26.

136 Id.

137 Id. at PP 66-73.

138 Id. at PP 1-44.

139 See, e.g., Schwartz, *supra* note 133.

140 No company--whether an ISP, a software developer, or any type of company--wants its internal conversations openly broadcast, and I am sure your internal business correspondence includes information involving the unique capabilities and insights that you feel are important to the successful operation of your company. The correspondence between individuals within our company often contains information concerning unique software, features and capabilities that provide Diebold with a potential advantage in a competitive marketplace. This type of information constitutes Diebold's work product and important intellectual property. Letter from Robert J. Urosevich, Diebold President, to Will Doherty, OPG President (Dec. 3, 2003), available at <http://sims.berkeley.edu/~jhall/nqb/archives/000050.html> (withdrawing cease-and-desist letter).

141 Id. at PP 6-7.

142 ULM, 75 F. Supp. 2d at 1295.

143 17 U.S.C. § 107 (1999).

144 RTC v. Netcom On-line Comm. Servs., Inc., 923 F. Supp. 1231, 1243 (N.D. Cal. 1995).

145 RTC v. Lerma, 40 U.S.P.Q.2d at 1574.

146 Id. (rejecting Lerma's description of himself as a "news reporter" and unfavorably comparing him to the Washington Post).

147 Erlich, for example, contended that "he post[ed] Hubbard's works verbatim to ensure that his audience knows that he knows what he is talking about, to verify the accuracy of writings attributed to Hubbard, to overcome the Scientologists' conditioned rejection of anything that is not actually Hubbard's words, and to point out inconsistencies in Hubbard's writings." Netcom, 923 F. Supp. at 1243.

148 See *id.*

149 Id. ("Erlich's use is only minimally transformative since, unlike the typical critic, Erlich adds little new expression to the Church's works."). The court in Lerma also expressed skepticism about the defendant's claim that his work was transformative--or at least sufficiently transformative to constitute fair use. 1996 U.S. Dist. LEXIS 15454, at *14 ("He claims to be performing academic work of a 'transformative' nature, providing materials which 'add new value to public knowledge and understanding, thereby advancing the goals of copyright as set forth in the Constitution.' That argument does not justify the wholesale copying and republication of copyrighted material.") (citations removed).

150 Id. at *23. See also RTC v. Netcom On-Line Comm. Servs., Inc., 907 F. Supp. 1361, 1378 (N.D. Cal. 1995) ("[T]he court has already found that Erlich was not likely entitled to his own fair use defense, as his postings contained large portions of plaintiffs'

published and unpublished works quoted verbatim with little added commentary.”).

151 RTC v. Lerma, 40 U.S.P.Q.2d at 1575.

152 Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 562-63 (1985). See Netcom, 923 F. Supp. at 1243.

153 Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 585 n.18 (1994).

154 NXIVM Corp. v. Ross Inst., 364 F.3d 471, 478 (2d Cir. 2004).

155 Atari Games Corp. v. Nintendo of Am., Inc., 975 F.2d 832, 843 (Fed. Cir. 1992).

156 Netcom, 923 F. Supp. at 1245.

157 RTC v. Lerma, 40 U.S.P.Q.2d at 1575.

158 Id. at 1575.

159 See, e.g., Thomas F. Cotter, Gutenberg’s Legacy: Copyright, Censorship, and Religious Pluralism, 91 Cal. L. Rev. 323, 345-47 (2003) (discussing cases where spiritual groups who believed core texts to be true or supernatural revelations nonetheless tried to argue they were expressive works of authorship in court).

160 Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 556 (1985).

161 Compare these cases, for example, with those involving postings of copyrighted material that has been published and is relatively accessible. Here, the argument for fair use arguably is much stronger. See, e.g., L.A. Times v. Free Republic, CV 98-7840 MMM (AJWx), 2000 U.S. Dist. LEXIS 5669 (C.D. Cal. Mar. 31, 2000) (finding that posting of major newspaper articles on the internet did not constitute fair use).

162 Harper & Row, 471 U.S. at 556-57.

163 Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 449-50 (1984).

164 RTC v. Lerma, 40 U.S.P.Q.2d at 1576 (citing *Wihtol v. Crow*, 309 F.2d 777, 780 (8th Cir. 1962)).

165 Harper & Row, 471 U.S. at 566.

166 Diebold Opp’n to Mot. for Prelim. Inj., OPG v. Diebold, No. 03-4913JF, 2004 U.S. Dist. LEXIS 19697, at *3, *13 (N.D. Cal. Nov. 12, 2003).

167 Id. at *13.

168 RTC v. Lerma, 40 U.S.P.Q.2d at 1578.

169 It was Congress's intent "to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way." H.R. Rep. No. 94-1476, at 66 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5680.

170 Dan L. Burk, Anticircumvention Misuse, 50 UCLA L. Rev. 1095, 1123 (2003).

171 Id. at 1114-15.

172 See Robin C. Feldman, The Insufficiency of Antitrust Analysis for Patent Misuse, 55 Hastings L.J. 399, 399 (2003) ("The history and conceptual overlap of patent law and antitrust law have left the doctrine of misuse hopelessly entangled with antitrust doctrines.").

173 See generally OPG v. Diebold, Inc., No. C 03-04913 JF, 2004 U.S. Dist. LEXIS 19697 (N.D. Cal. Sept. 30, 2004); RTC v. Lerma, 40 U.S.P.Q.2d (BNA) 1569 (E.D. Va. 1996). Interestingly, a misuse defense was raised in both Lerma and Diebold, although as framed it was more akin to an abuse of process argument. Thus, the court in Lerma held that the defendant had failed to show how the public policy underlying copyright law was implicated. Lerma, 40 U.S.P.Q.2d at 1579. The court in Diebold did not directly reach the misuse argument, although EFF's request for attorneys fees was granted on the ground that Diebold had improperly invoked the procedures of the DMCA in violation of § 512(f) of the Copyright Act. Diebold, 2004 U.S. Dist. LEXIS 19697, at *30-31.

174 See generally Morton Salt Co. v. G.S. Suppiger Co., 314 U.S. 488 (1942); Carbice Corp. of Am. v. Am. Patents Dev. Corp., 283 U.S. 27 (1931); Motion Picture Patents, Co. v. Universal Film Mfg. Co., 243 U.S. 502 (1917).

175 See Robert Patrick Merges & John Fitzgerald Duffy, Patent Law and Policy 1350 (2002).

176 314 U.S. at 494.

177 Id.

178 Robin C. Feldman, Should We Breathe New Life Into Patent Misuse? at *20 (2003) (unpublished paper), at http://www.law.berkeley.edu/institutes/bclt/ipsc/papers/IPSC_2003&uscore;Feldman.pdf (last visited Nov. 9, 2004). See also Burk, supra note 170, at 1116-17.

179 Feldman, supra note 178, at *20-*21.

180 35 U.S.C. § 271(d)(5) (2000).

181 Feldman, supra note 178, at *30.

182 314 U.S. at 493-94.

183 911 F.2d 970 (4th Cir. 1990).

184 These include the Second, Third, Fifth, Seventh, Eighth, Ninth, and Federal Circuits. Ramsey Hanna, Misusing Antitrust: The

Search for Functional Copyright Misuse Standards, 46 Stan. L. Rev. 401, 405 (1994). See also Alcatel USA, Inc. v. DGI Techs., Inc., 166 F.3d 772 (5th Cir. 1999); Practice Mgmt. Info. Corp. v. Am. Med. Ass'n, 121 F.3d 516 (9th Cir. 1997).

185 464 U.S. 417, 439 (1984).

186 See, e.g., Hanna, supra note 188, at 409-10 (discussing why misuse may have arisen in the software context).

187 Lasercomb, 911 F.2d at 978 (emphasis added).

188 See, e.g., Assessment Techs. of WI, L.L.C. v. WIREDATA, Inc., 350 F.3d 640, 647 (2003) (“The argument for applying copyright misuse beyond the bounds of antitrust, besides the fact that confined to antitrust the doctrine would be redundant, is that for a copyright owner to use an infringement suit to obtain property protection, here in data, that copyright law clearly does not confer, hoping to force a settlement or even achieve an outright victory over an opponent that may lack the resources or the legal sophistication to resist effectively, is an abuse of process.”).

189 191 F. Supp. 2d 1087, 1102-03 (N.D. Cal. 2002).

190 Id. at 1112.

191 342 F.3d 191 (3d Cir. 2003), cert. denied, 540 U.S. 1178 (2004).

192 Id. at 204.

193 Id. at 205.

194 366 F.2d 303 (2d Cir. 1966).

195 Id. at 313.

196 USM Corp. v. SPS Techs., Inc., 694 F.2d 505, 512 (7th Cir. 1982) (“If misuse claims are not tested by conventional antitrust principles, by what principles shall they be tested?”).

197 292 F.3d 512, 520 (7th Cir. 2002).

198 Id.

199 Id.

200 In re Napster, 191 F. Supp. 2d at 1103.

201 Brett Frischmann & Dan Moylan, The Evolving Common Law Doctrine of Copyright Misuse: A Unified Theory and Its Application to Software, 15 Berkeley Tech. L.J. 865, 872 (2000).

202 Id. at 874.

203 Id. at 876.

204 Id. at 877.

205 *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 978 (4th Cir. 1990).

206 *Morton Salt v. G.S. Suppiger Co.*, 314 U.S. 488, 494 (1942).

207 These abuses included “its slowness, its expense, its inefficiency, its technicality, its abuse by the mighty.” Theodore F.T. Plucknett, *A Concise History of the Common Law* 689 (1956).

208 See, e.g., *In re Napster*, 191 F. Supp. 2d at 1105 (“Additional confusion arises because while courts have repeatedly stated that misuse is different from antitrust, they still rely on antitrust-like inquiries in determining what licensing agreements violate public policy. Of the cases reviewed by the court, all mimic the per se rules of antitrust in holding that the relevant licensing agreements constitute copyright misuse because they are unduly restrictive on their face.”).

209 For a discussion of approaches to “purging” misuse in patent law, see *Merges & Duffy*, *supra* note 178, at 1353. They do note that “in some cases, it is impossible to purge the misuse.”

210 See *B.B. Chem. Co. v. Ellis*, 314 U.S. 495, 498 (1942) (purge occurs where a patentee “has fully abandoned its present method of restraining competition in the sale of unpatented articles and that the consequences of that practice have been fully dissipated”).

211 The exception is *In re Napster*, 191 F. Supp. 2d at 1087. There, Judge Marilyn Hall Patel suggested, without deciding the issue, that copyright misuse might simply defer rather than defeat the rights owner’s ability to seek infringement damages dating to the period of misuse. “Misuse limits enforcement of rights, not remedies The doctrine does not prevent plaintiffs from ultimately recovering for acts of infringement that occur during the period of misuse. The issue focuses on when plaintiffs can bring or pursue an action for infringement, not for which acts of infringement they can recover.” *Id.* at 1108. To my knowledge, this approach would be inconsistent with the body of existing law of patent and copyright misuse. It also might constrain the utility and flexibility of the copyright misuse doctrine in dealing with the types of cases I have suggested.

212 Stephen J. Davidson & Nicole A. Engisch, “Trademark Misuse” in *Domain Name Disputes*, 13 *Computer Lawyer* 13, 18 (1996) (citing *Phi Delta Theta Fraternity v. J.A. Buchroeder & Co.*, 251 F. Supp. 968, 974 (W.D. Mo. 1966)).

213 See, e.g., Marci A. Hamilton, *Copyright Duration Extension and the Dark Heart of Copyright*, 14 *Cardozo Arts & Ent. L.J.* 655 (1996). See also Aaron Burstein, Will Thomas DeVries & Peter S. Menell, *The Rise of Internet Interest Group Politics*, 19 *Berkeley Tech. L.J.* 1, 11 (2004) (discussing copyright extension legislation as the “result of heavy lobbying by major copyright owners”).

214 See Peter Jaszi, *Goodbye to All That--A Reluctant (and Perhaps Premature) Adieu to a Constitutionally-Grounded Discourse of Public Interest in Copyright Law*, 29 *Vand. J. Transnat’l L.* 595 (1996).

215 Professor Goldstein makes similar arguments about fair use, demonstrating how it has been contingent upon technological developments and also how it entails a case-by-case “weighing of the benefits to be secured from excusing a particular use against those to be secured from barring it.” Goldstein, *supra* note 34, at 134.

216 For a brief discussion of the history of fair use, see Laura G. Lape, *Transforming Fair Use: The Productive Use Factor in Fair Use*

Doctrine, 58 Alb. L. Rev. 677 (1995).

217 Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 439 (1984).

218 This doctrine protects parties that otherwise would be found secondarily liable rather than direct infringers.

219 The Ninth Circuit, citing Sony, recently held that decentralized and “supernode” peer-to-peer networks were shielded from liability because they were capable of substantial noninfringing uses. *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster Ltd.*, 380 F.3d 1154, 1160-61 (9th Cir. 2004) (listing example of musical artists distributing their works for free and of public domain literary texts being made available for download). But see *In re Aimster Copyright Litig.*, 334 F.3d 643, 653 (7th Cir. 2003) (citing *In re Aimster Copyright Litig.*, 252 F. Supp. 2d 634, 653 (N.D. Ill. 2002) (finding that defendant peer-to-peer network service could not avail itself of the substantial non-infringing use defense because it “provided no evidence whatsoever ... that Aimster is actually used for any of the stated noninfringing purposes” or that it was unable to limit infringing uses)).

220 See, e.g., *Ass’n of Am. Med. Colls. v. The Princeton Rev., Inc.*, 332 F. Supp. 2d 11, 18 (D.D.C. 2004) (“Courts have generally recognized misuse of copyright as a defense to copyright infringement and not as an affirmative claim.”).

221 Indeed, a claim of this nature was raised in the Diebold case, but dismissed by the judge after Diebold promised not to pursue infringement actions against the claimants. See *First Am. Compl., Online Policy Group v. Diebold, Inc.*, No. C-03-04913 JF, 2004 WL 2203382, at *n.4 (N.D. Cal. Sept. 30, 2004), available at http://www.eff.org/legal/ISP_liability/OPG_v_Diebold/First_Amended_Complaint.pdf (last visited on Nov. 9, 2004) (“Defendants engaged in the misuse of their copyrights [including in the cease-and-desist letters] ... by claiming that publication of the e-mail archive [by defendants] ... constituted copyright infringement when they knew it did not.”).

222 For a discussion in the software context of how fair use and misuse might be used together, see Eric Douma, *Fair Use and Misuse: Two Guards at the Intersection of Copyrights and Trade Secret Rights Held in Software and Firmware*, 42 *IDEA* 37 (2002).

223 Robert G. Bone, *A New Look at Trade Secret Law: Doctrine in Search of Justification*, 86 *Cal. L. Rev.* 241, 286-88 (1998). See also, e.g., *Great Falls Tribune v. Mont. Pub. Serv. Comm’n*, 82 P.3d 876, 883 (Mont. 2003) (denying state constitutional privacy right to corporations).

224 See Catherine L. Fisk, *Authors at Work: The Origins of the Work-for-Hire Doctrine*, 15 *Yale J.L. & Human.* 1, 68 (2003).

225 See, e.g., Marc A. Franklin & Robert L. Rabin, *Tort Law and Alternatives: Cases and Materials* 1106-07 (7th ed. 2001) (discussing defenses to privacy tort actions); *Restatement (Second) of Torts* § 652D (1965) (offering overview of privacy-related torts).

226 532 U.S. 514 (2001).

227 *Id.* at 534-35.

228 See Pamela Samuelson, *Resolving Conflicts Between Trade Secrets and the First Amendment*, at *5 (Mar. 20, 2003) (unpublished manuscript, at <http://www.sims.berkeley.edu/~pam/papers/TS%201st%CCC20A%CCC203d%20dr.pdf>).

229 35 U.S.C. § 102(b) (2000).

230 Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 *Harv. L. Rev.* 193, 214 (1890) (“The right to privacy does not prohibit any publication of matter which is of public or general interest.”).

- ²³¹ Id. at 200-01 ([T]he right of privacy “is entirely independent of the copyright laws, and their extension into the domain of art. The aim of those statutes is to secure to the author, composer, or artist the entire profits arising from publication The statutory right is of no value, unless there is a publication”).
- ²³² Id. at 201 (noting that the right of privacy, to be efficacious, must protect facts as well as expression which copyright law does not do).
- ²³³ See, e.g., Seth F. Kreimer, Sunlight, Secrets, and Scarlet Letters: The Tension Between Privacy and Disclosure in Constitutional Law, 140 U. Pa. L. Rev. 1, 6-7 (1991); Paul M. Schwartz, Free Speech vs. Information Privacy: Eugene Volokh’s First Amendment Jurisprudence, 52 Stan. L. Rev. 1559 (2000); Nadine Strossen, Protecting Privacy and Free Speech in Cyberspace, 89 Geo. L.J. 2103 (2001).
- ²³⁴ See, e.g., *Bartnicki v. Vopper*, 532 U.S. 514, 540 (2001) (holding public interest in disclosure of matters of public importance outweighed privacy interests of individuals whose conversation was illicitly recorded) (Breyer, J., concurring).
- ²³⁵ *In re Lindqvist*, No. C-101/01, Eur. Ct. of Justice (Nov. 6, 2003), was the first case interpreting a national enactment of the European Union’s Data Protection Directive, E.U. Directive 95/46. The European Court of Justice, Europe’s highest court, denied that the directive intrinsically violated freedom of expression and emphasized the duty of member states to find “proportionality” and “balance” between privacy and free expression in its implementation. “[I]t is for the authorities and courts of the Member States not only to interpret their national law in a manner consistent with Directive 95/46 but also to make sure they do not rely on an interpretation of it which would be in conflict with the fundamental rights protected by the Community” Id.
- ²³⁶ 532 U.S. at 540.
- ²³⁷ See, e.g., Lemley & Reese, *supra* note 14, *passim*.