

SOME OPEN QUESTIONS ABOUT INTELLECTUAL
PROPERTY REMEDIES

by
*Michael Traynor** and *Katy Hutchinson***

This Essay addresses four questions about intellectual property remedies. It assesses the implications of eBay Inc. v. MercExchange, L.L.C. for relief sought in infringement actions, asks whether the Due Process Clause imposes a limit on statutory damages, asks whether monetary compensation should be considered as a remedial factor in fair use analysis, and discusses the use of attribution in fair use analysis and its impact on remedies.

ESSAY BASED ON
SYMPOSIUM KEYNOTE ADDRESS

It is a special pleasure to return to Lewis & Clark Law School and to be here with you and Dean Robert Klonoff, a distinguished reporter on the ALI's Principles of the Law of Aggregate Litigation. Professor Lydia Loren on your faculty is a fellow adviser on the Copyright Principles Project chaired by Professor Pamela Samuelson at the University of California at Berkeley, who is organizing a conference there next April to commemorate the 300th anniversary of the Statute of Anne.¹ This Essay raises three open questions about intellectual property remedies and one question about the scope of copyright protection that in turn would affect remedies.

* Michael Traynor, a California lawyer and senior counsel at Cobalt LLP in Berkeley, California, is an adviser on the Copyright Principles Project and President Emeritus of the American Law Institute. This Essay is adapted from his keynote speech at the Lewis & Clark Law School Fall Forum on Intellectual Property Remedies on October 2, 2009.

** Katy Hutchinson, a second year law student at The University of Texas School of Law, also served between 2005 and 2008 on the staff of Senator Patrick Leahy, Chair of the U.S. Senate Committee on the Judiciary, working on proposed copyright legislation and other matters, and as a summer law clerk at the Copyright Office in 2009.

¹ Statute of Anne (Copyright Act), 1709, 8 Ann., c. 19 (Eng.), available at http://avalon.law.yale.edu/18th_century/anne_1710.asp. For the conference website, see <http://www.law.berkeley.edu/institutes/bclt/statuteofanne/about.html>.

1. What are the implications of the Supreme Court's decision in *eBay Inc. v. MercExchange, L.L.C.* for treating infringements henceforth as subject primarily to a rule of liability with attendant monetary relief instead of a rule of property with attendant injunctive relief?
2. Does the Due Process Clause impose a limit on statutory damages and, if so, what are the implications of that limit for class action cases?
3. Should monetary compensation be considered as a remedial factor in fair use analysis, for example, in the *Google Books Case*?
4. Should attribution become a right in the United States or a possible factor in fair use analysis, and, if so, what remedies should attend its violation?

These four questions also suggest the broader question of whether there is an area between exclusive rights enforceable by injunction on the one hand and the freely accessible public domain on the other,² one that might be developed by remedial law. In brief, in appropriate cases, might the optimum remedy for infringement be a reasonable payment of money for access to intellectual property rights? Creative Commons now creates such an intermediate area on a voluntary basis, subject to a minimum requirement of attribution. Should the law of remedies provide a complementary approach? The time is ripe for new thinking about remedies in intellectual property cases.

First, in *eBay Inc. v. MercExchange, L.L.C.*, the Supreme Court held that in patent cases, courts have discretion to grant or not grant injunctions even if the plaintiff at trial has established that the defendant infringed its patent.³ It invoked the traditional four-part test for injunctions under which the plaintiff seeking the injunction must show:

- (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.⁴

Earlier, in *New York Times Co. v. Tasini*, the Supreme Court pointedly suggested using monetary relief instead of an injunction as an appropriate remedy for copyright infringement.⁵

These cases raise the fundamental question of whether infringements should be treated primarily as subject to a rule of liability

² For a critical analysis, see Anupam Chander & Madhavi Sunder, *The Romance of the Public Domain*, 92 CAL. L. REV. 1331 (2004); Peter Lee, *Toward a Distributive Commons in Patent Law*, 2009 WIS. L. REV. 917 (2009).

³ 547 U.S. 388, 394 (2006).

⁴ *Id.* at 391.

⁵ 533 U.S. 483, 505 (2001).

rather than a rule of property, with significantly different consequences for remedial relief,⁶ not only in patent and copyright cases but also in trademark and trade secret cases.⁷ There also is a question whether the four-part test for injunctive relief applies at the preliminary injunction stage.⁸

In patent cases, the federal courts have begun to treat seriously the burden the plaintiff must meet to obtain injunctive relief under the traditional four-part test.⁹ Plaintiffs, even if they establish infringement, can no longer assume that injunctive relief will be virtually automatic or that the patent will be treated as a property right that, when violated, must be accompanied by an injunction, rather than as a liability right that, when violated, will lead to monetary relief.

In copyright cases, a recent survey states that “[o]verall, the lower courts have applied traditional equitable principles almost seventy-five percent of the time since *eBay*,” and that “all but twice, the required framework still led courts to uphold strong property rules for copyright owners.”¹⁰ The two cases in which an injunction was denied “show that severe hardship to the infringer and a strong public interest in denying an injunction can lead courts to adopt liability rules.”¹¹

There also is strong reason to think that the four-part test will and should also apply at the preliminary injunction stage when actual infringement has yet to be established and the rights of the parties have not yet been settled by trial.¹² Indeed, the First Amendment reinforces

⁶ Mark A. Lemley & Philip J. Weiser, *Should Property or Liability Rules Govern Information?*, 85 TEX. L. REV. 783, 785 (2007). The authors build on the classic article, Guido Calabresi & A. Douglas Melamed, *Property Rules, Liability Rules, and Inalienability: One View of the Cathedral*, 85 HARV. L. REV. 1089 (1972). See also Peter Lee, *The Evolution of Intellectual Infrastructure*, 83 WASH. L. REV. 39, 102–20 (2008); Doug Rendleman, *The Trial Judge’s Equitable Discretion Following eBay v. MercExchange*, 27 REV. LITIG. 63 (2007).

⁷ See, e.g., Karl F. Jorda, *Patent and Trade Secret Complementariness: An Unsuspected Synergy*, 48 WASHBURN L.J. 1 (2008); Marc C. Levy & Katie R. Schwalb, *The Presumption of Irreparable Harm in Trademark Cases*, INTELL. PROP. LITIG., Summer 2009, at 6; Sandra Rierson, *IP Remedies After eBay: Assessing the Impact on Trademark Law*, 2 AKRON INTELL. PROP. J. 163, 170–71 (2008).

⁸ See Pamela Samuelson & Krzysztof Bebenek, *Why Plaintiffs Should Have to Prove Irreparable Harm in Copyright Preliminary Injunction Cases*, 5 J. LAW & POL’Y INFO. SOC’Y (forthcoming 2009), available at <http://ssrn.com/abstract=1495343>; Joseph F. Shea et al., *The Standard for Preliminary Injunctions Should Be Abandoned*, INTELL. PROP. LITIG., Summer 2009, at 3.

⁹ Regarding patent cases, see, for example, sources cited *supra* note 6. Regarding copyright cases, see, e.g., Richard Dannay, *Copyright Injunctions and Fair Use: Enter eBay—Four-Factor Fatigue or Four-Factor Freedom?*, 55 J. COPYRIGHT SOC’Y U.S.A. 449, 460 (2008).

¹⁰ Jake Phillips, *eBay’s Effect on Copyright Injunctions: When Property Rules Give Way to Liability Rules*, 24 BERKELEY TECH. L.J. 405, 423 (2009).

¹¹ *Id.* at 423–24.

¹² See, e.g., *Hologic, Inc. v. Senorx, Inc.*, No. C-08-00133 RMW, 2008 WL 1860035 (N.D. Cal. Apr. 25, 2008); *Torspo Hockey Int’l, Inc. v. Kor Hockey Ltd.*, 491 F. Supp. 2d 871, 873 (D. Minn. 2007); *Sun Optics, Inc. v. FGX Int’l, Inc.*, No. 07-137-SLR, 2007

the idea that at the beginning of a case, preliminary injunctive relief should not be presumptively awarded.¹³

The *Restatement Third of Unfair Competition*, which the ALI published in 1995, addresses remedial issues for trademark and trade secret cases.¹⁴ It states that “injunctive relief will ordinarily be awarded against one who is liable to another for . . . infringement of the other’s trademark.”¹⁵ Although monetary relief, such as compensatory damages or restitution of unjust enrichment, is also available in trademark infringement cases,¹⁶ the principal remedy customarily has been an injunction. Trademarks, unless abandoned or otherwise defeated, are not attended by a term limit, as are patents and copyrights. Injunctions protect not only the trademark holder’s exclusive right but also the public interest in preventing deception and confusion.¹⁷ Although the Supreme Court’s four-part test is not limited to patent cases and seems likely to apply to trademark cases, we expect that the indefinite lifetime of the trademark, the traditional use of injunctions, and the public interest factors will continue to support injunctions as a principal remedy against trademark infringement.¹⁸

For trade secret cases, which are governed primarily by state law and can be brought in state courts as well as federal courts when there is subject matter jurisdiction, the ALI stated that “injunctive relief may be awarded to prevent a continuing or threatened appropriation of another’s trade secret,” and it provided for monetary relief through compensatory damages or restitution of gain.¹⁹ The formulation for injunctive relief, however, is markedly different from the one for trademarks. In using the word “may” instead of “will ordinarily be awarded,” the ALI emphasized the discretionary nature of the injunction.

It also addressed the temporary nature of injunctive relief in trade secret cases, saying it “should be limited to the time necessary to protect the plaintiff from any harm attributable to the appropriation and to

WL 2228569 (D. Del. Aug. 2, 2007); *but see* Salinger v. Colting, 641 F. Supp. 2d 250, 268 n.6 (S.D.N.Y. 2009), *appeal docketed*, No. 09-2878-cv (2d Cir. July 6, 2009). These cases and others are discussed in Samuelson & Bebenek, *supra* note 8.

¹³ See Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 229–31 (1998); Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537, 2621 & n.588 (2009). “Indeed, if any presumption about harm is appropriate in transformative use cases, it should probably run in favor of irreparability of harm to the defendants’ free expression and speech interests under First Amendment case law which treats preliminary injunctions as presumptively unconstitutional prior restraints on speech.” Samuelson & Bebenek, *supra* note 8 (manuscript at 2).

¹⁴ RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 35–37 (trademarks), 44–45 (trade secrets) (1995).

¹⁵ *Id.* § 35(1).

¹⁶ *Id.* §§ 36–37.

¹⁷ *Id.* § 35(2)(e) cmt. b.

¹⁸ See Rierson, *supra* note 7, at 169–82. Professor Rierson also analyzes the impact of *eBay* on claims for injunctions in trademark dilution cases. *Id.* at 173, 182–84.

¹⁹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 44(1), 45(1).

deprive the defendant of any economic advantage attributable to the appropriation.”²⁰ In shorthand terms, it referred to what is often called the “head start injunction.” Again, although the four-part test may apply, especially in the federal courts, we predict that *eBay* will not require major changes for injunctive relief in trade secret cases.

Before turning to the next open question, we suggest a cautionary word about moving too quickly to a regime of monetary relief versus injunctive relief, or to a rule of liability versus a rule of property. Intellectual property rights are important. Historically, they have connoted the right to exclude others, although the principal remedies provided in the Statute of Anne were forfeitures and fines,²¹ and “[c]ourts were first empowered to award injunctions in copyright cases in 1819, according ‘to the course and principles of equity.’”²² Exclusivity, especially for a limited time, can be important to foster creativity and the progress of science and the useful arts, as contemplated by the Constitution.²³ In the United States, with our strong sense of independence and autonomy, we are also reluctant to impose involuntary exchanges on property owners. Our opposition to forced exchanges, to “taking without asking,” for example, is reflected in the ALI’s current work on the *Restatement Third of Restitution and Unjust Enrichment*, now nearing completion in elegant drafts by the reporter, Professor Andrew Kull.²⁴ In the important case of *eBay, Inc. v. Bidder’s Edge, Inc.*, in which the district court granted a preliminary injunction to eBay against the use by the defendants of invasive means to capture its auction information, the analysis was based primarily on the property theory of trespass.²⁵ The case was settled on appeal, so no determinative appellate decision was handed down. We are inclined to proceed gradually in the typical common law way as the remedial law unfolds and develops in resolving the choices between monetary relief and injunctive relief in intellectual property cases, or in facilitating a combination of relief. Scholars are already tackling the subject. Professor Peter Lee, for example, has proposed “a two-tiered system in which courts continue to

²⁰ *Id.* § 44(3).

²¹ Statute of Anne, 1709, 8 Ann., c. 19, § I (Eng.).

²² H. Tomás Gómez-Arostegui, *What History Teaches Us About Copyright Injunctions and the Inadequate-Remedy-at-Law Requirement*, 81 S. CAL. L. REV. 1197, 1205 n.20 (2008) (quoting Act of Feb. 15, 1891, ch. 19, 3 Stat. 481) (noting that “[s]ubsequent amendments retained the same or similar language”). Professor Gómez-Arostegui, who is on the faculty of Lewis & Clark Law School, concludes after a painstaking and thorough review of court records and other sources that “[t]he Chancery never denied nor dissolved an injunction on the ground the plaintiff had an adequate remedy at law, nor did it grant a demurrer or plea on that basis either,” and that “the common-law courts played no real remedial role during the entire 230 years of copyright enforcement before 1789.” *Id.* at 1279–80.

²³ U.S. CONST. art. I, § 8, cl. 8.

²⁴ See, e.g., RESTATEMENT (THIRD) OF RESTITUTION AND UNJUST ENRICHMENT § 37 cmt. c (Preliminary Draft No. 10, 2009).

²⁵ 100 F. Supp. 2d 1058, 1069 (N.D. Cal. 2000).

protect ordinary inventions serving a non-infrastructure role with a property rule (via injunctive relief) but protect patented inventions serving as infrastructure with a liability rule (via royalties) in certain circumstances.”²⁶ Professor Gómez-Arostegui questions the authority of the federal courts to substitute prospective monetary relief for injunctive relief in copyright cases.²⁷

Assuming that the courts retain authority and discretion to deny an injunction and provide monetary relief instead, they should also consider the public interest as well as other interests beyond the competition between traditional rights holders and free access seekers. For example, in the *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.* case,²⁸ the amicus brief for emerging technology companies, which the Court cited,²⁹ urged the Court to consider the interests of emerging and potential rights holders, not just traditional and existing rights holders, and cautioned against creating a technology-blocking precedent.³⁰

It will be useful to look at other areas of law where the choice between injunctive relief and monetary relief has been presented. As just one example, in the infamous *Boomer v. Atlantic Cement Co.* case in the New York Court of Appeals, monetary relief instead of injunctive relief was afforded to property owners who established that emissions from the defendant’s factory were a nuisance.³¹ Environmentalists may justly consider the case a disaster for the public interest and that judicially compelled monetary exchanges over environmental nuisances are an inadequate substitute for the relief and power of a permanent injunction.³²

Second, on due process, under the Copyright Act, statutory damages are available for “willful” infringements up to a limit of \$150,000 for each work infringed.³³ The Supreme Court held that statutory damages are subject to jury trial.³⁴ There are some notorious recent examples of large

²⁶ Lee, *supra* note 6, at 102.

²⁷ H. Tomás Gómez-Arostegui, *Prospective Compensation in Lieu of a Final Injunction in Patent and Copyright Cases*, 78 *FORDHAM L. REV.* (forthcoming 2010) (manuscript at 3–4), available at <http://ssrn.com/abstract=1355464>.

²⁸ 545 U.S. 913 (2005).

²⁹ *Id.* at 929. One of the authors (Traynor) was among the authors of the amicus brief who later published an article developing these ideas. Matthew D. Brown et al., *Secondary Liability for Inducing Copyright Infringement After MGM v. Grokster: Infringement-Prevention and Product Design*, *J. INTERNET L.*, Dec. 2005, at 21.

³⁰ Brief of Amici Curiae Emerging Technology Companies in Support of Respondents, *Metro-Goldwyn-Mayer Studios, Inc.*, 545 U.S. 913 (No. 04-480).

³¹ 257 N.E.2d 870, 873 (N.Y. 1970).

³² See, e.g., J. William Futrell, *The Transition to Sustainable Development Law*, 21 *PACE ENVTL. L. REV.* 179, 193 (2003) (“*Boomer* . . . overruled a century of jurisprudence in which courts protected the right of numerous smaller property owners to enjoin the destructive actions of their neighbors.”).

³³ 17 U.S.C. § 504(c) (2006).

³⁴ *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340 (1998).

six and seven figure verdicts against defendants who have downloaded songs in violation of the owner's copyright.³⁵

In the recent and leading insurance case of *State Farm Mutual Automobile Insurance Co. v. Campbell*, the Supreme Court considered whether a \$145 million punitive damages award was excessive compared to the \$1 million compensatory damages award, and whether the disparity violated the Due Process Clause of the Fourteenth Amendment.³⁶ The Court held that “[w]e decline again to impose a bright-line ratio which a punitive damages award cannot exceed. Our jurisprudence and the principles it has now established demonstrate, however, that, in practice, few awards exceeding a single-digit ratio between punitive and compensatory damages, to a significant degree, will satisfy due process.”³⁷

Professor Pamela Samuelson and her colleague Tara Wheatland recently addressed the implications of the Supreme Court's due process decisions to the problem of statutory damages in copyright cases.³⁸ Their essential conclusion is that:

[T]he Supreme Court has applied due process excessiveness reviews to a wide variety of sanctions—not just to punitive damages, but also to civil fines, forfeitures, criminal penalties, and other deprivations of liberty or property. . . . Thus, the fact that Congress has included a statutory damage provision in U.S. copyright law does not, in itself, insulate this law, or particular awards of statutory damages in specific copyright cases, from due process review.³⁹

It is time to consider a change to the current regime of statutory damages that will take appropriate account of the digital age and consequent exposure of users to multiple infringement claims.

Now imagine a copyright class action case involving potentially thousands of claimants, each claiming the maximum amount of statutory damages for infringement of one or multiple works. In a class of a thousand claimants with each claimant seeking \$150,000 in statutory damages for infringement of one work, the exposure of the defendant would be to an award of \$150 million plus costs and attorney's fees.⁴⁰

³⁵ See, e.g., Alex Ebert, *Download Damages: \$1.9 million*, STAR TRIB., June 19, 2009, at A1 (reporting jury verdict finding Jammie Thomas-Rasset liable for \$1.92 million in damages for copyright infringement of twenty-four songs); Jonathan Saltzman, *Student Must Pay \$675k for Songs*, THE BOSTON GLOBE, August 1, 2009, at 1 (reporting jury verdict finding Joel Tenenbaum liable for \$675,000 in damages for copyright infringement of thirty songs). In a recent development, the judge in Thomas-Rasset's second damages trial reduced the jury award of \$1.92 million to \$54,000. The Recording Industry Association of America, however, declined to accept that compromise, which triggered a third trial on the damages issue for Thomas-Rasset.

³⁶ 538 U.S. 408, 412 (2003).

³⁷ *Id.* at 425.

³⁸ See Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439 (2009).

³⁹ *Id.* at 492.

⁴⁰ See 17 U.S.C. § 504 (2006).

Class actions, although they have not been common in copyright cases due primarily to the frequent lack of common questions, are occurring. A few years ago, one of us (Traynor) served as lead counsel for the defense in *Ryan v. Carl Corp.*, a copyright class action brought by freelance authors on behalf of a large class against a document delivery service.⁴¹ The issues in *Ryan* paralleled those in *New York Times Co. v. Tasini*.⁴² The district court denied a preliminary injunction, and also certified to the Ninth Circuit an important and unresolved issue of law.⁴³ After the case was briefed and ready for argument before the Ninth Circuit, the parties reached a reasonable settlement, which the district court approved. Until that settlement occurred, however, the defendants were exposed to potential liability in the hundreds of millions of dollars, and depending on the actual size of the class, which we did not know up front, and the number of works allegedly infringed, which also was uncertain, the exposure might have reached a half-billion dollars or more.

Procedural aggregation combined with remedial overreach is a serious problem. The ALI's new Aggregate Litigation project comments that some courts may deny class certification or condition certification upon an agreement by the plaintiffs to limit aggregate damages.⁴⁴ Perhaps Congress will also cap aggregate damages.⁴⁵

Third, fair use is an all or nothing kind of defense. If the defendant establishes that its use of the plaintiff's copyrighted work was fair use, it escapes liability. If it fails to establish fair use, it is exposed to an injunction and to monetary liability, including statutory damages. In the case involving Roy Orbison's song, "Pretty Woman," and the claim of fair use by 2 Live Crew in a parody, the Supreme Court, in dicta,⁴⁶ suggested the possibility of damage awards instead of injunctive relief in fair use cases as it did in *Tasini*.⁴⁷ In the Ninth Circuit, a dissenting judge once

⁴¹ 23 F. Supp. 2d 1146 (N.D. Cal. 1998).

⁴² 533 U.S. 483 (2001).

⁴³ *Ryan*, 23 F. Supp. 2d at 1148.

⁴⁴ PRINCIPLES OF THE LAW OF AGGREGATE LITIGATION § 1.03 cmt. d. (Proposed Final Draft April 1, 2009). "Some courts have declined to certify class actions despite the predominance of common questions of law and fact. They have found that class litigation is not superior to ordinary litigation—the one thing that the court can be confident the legislature wished to enable by way of minimum damages—because it threatens defendants with insolvency, equips plaintiffs with excessive settlement leverage, encourages litigation too strongly, raises significant due-process concerns, and distorts the remedial scheme of the statute." *Id.* "In addition to the courts that have denied certification, some have sought to limit the reach of the statutory damages. Rather than disallow aggregation entirely, some suggest that courts should offer named plaintiffs a choice: they may accept a decision to deny their motion for class certification and challenge that decision on appeal, or they may obtain certification by agreeing to limit aggregate damages to the largest amount consistent with legitimate objectives of justice, due process, and deterrence." *Id.*

⁴⁵ See Truth in Lending Act, 15 U.S.C. § 1640(a)(2)(B) (2006).

⁴⁶ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 n.10 (1994).

⁴⁷ *Tasini*, 533 U.S. at 483.

proposed that a documentary video maker should be able to use video footage subject to compensating the rights holders, but his suggestion was not followed by his colleagues on the panel.⁴⁸

A number of observers of the *Google Books Case*⁴⁹ suggest that had Google not settled subject to court approval, it might have prevailed on its defense of fair use.⁵⁰ We do not venture a view on fair use as an all or nothing defense in that case. Google made two critical and probably pragmatic gambles: first, that it would prevail on fair use, and second, that even if it did not establish a complete defense of fair use, it would be able to defeat an injunction and instead pay some monetary relief via a licensing or similar scheme. Numerous objectors opposed the initial proposed settlement⁵¹ and the amended proposed settlement is also contested.⁵² The case presents the questions whether a massive taking without asking can be accomplished via such a class action settlement and, if not, whether monetary relief can serve as an appropriate remedial factor in fair use analysis.

Fourth, the Berne Convention provides that “[i]ndependently of the author’s economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work.”⁵³ This right lasts for the author’s lifetime and “shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of

⁴⁸ See *Elvis Presley Enters., Inc. v. Passport Video*, 357 F.3d 896, 898–900 (9th Cir. 2004) (Noonan, J., amended dissent); *Elvis Presley Enters., Inc. v. Passport Video*, 349 F.3d 622 (9th Cir. 2003).

⁴⁹ Class Action Complaint, *Authors Guild v. Google, Inc.* (Google Books Case), No. 05 CV 8136 (S.D.N.Y. Sep. 20, 2005), 2005 WL 2463899. This class action was coordinated for discovery and other related purposes with a separate action brought by publishers. Complaint, *McGraw-Hill Cos., v. Google Inc.*, No. 05 CV 8881 (S.D.N.Y. Oct. 19, 2005).

⁵⁰ See, e.g., James Boyle, *A Copyright Black Hole Swallows Our Culture*, FIN. TIMES, Sept. 6, 2009, at 7 (“In my view, Google had a good argument that the scanning was ‘fair use’, allowed by law.”); Pamela Samuelson, *The Audacity of the Google Book Search Settlement*, HUFFINGTON POST, Aug. 10, 2009, http://www.huffingtonpost.com/pamela-samuelson/the-audacity-of-the-googlb_255490.html (“Google’s attack on Mitgang and the Authors Guild as class representatives would likely have succeeded because most authors of books in the Michigan library are academic researchers likely to think, as I do, that scanning books to make indexes and snippets is fair use.”).

⁵¹ E.g., Letter from Roberta Cooper Ramo, President, The American Law Inst., & Maury B. Poscover, President, ALI-ABA Board of Directors, to Denny Chin, District Judge, Southern District of N.Y. (Aug. 31, 2009) (on file with author) (objections as nonprofit publishers).

⁵² See Posting of James Grimmelmann to The Laboratorium, http://laboratorium.net/archive/2010/02/20/gbs_fairness_hearing_report (Feb. 20, 2010, 18:52 EST) (discussing the recent hearing before Judge Chin and providing a summary of each individual’s testimony); Posting of James Grimmelmann to The Laboratorium, http://laboratorium.net/archive/2010/02/21/gbs_fairness_hearing_report_part_ii (Feb. 21, 2010, 17:49 EST) (same).

⁵³ Berne Convention for the Protection of Literary and Artistic Works, art. 6bis(1), Sept. 9, 1886, S. TREATY DOC. No. 99-27, 1161 U.N.T.S. 3 (1986).

the country where protection is claimed.”⁵⁴ The United States joined the Berne Convention in 1988, and in the Berne Convention Implementation Act, Congress stated that U.S. obligations under that act “do not expand or reduce any right of an author of a work, whether claimed under Federal, State, or the common law,” and identified as one such right, the right “to claim authorship of the work.”⁵⁵ According to the legislative history, Congress believed that existing U.S. law already provided adequate protection of attribution rights, found in “various provisions of the Copyright Act and Lanham Act, various state statutes, and common law principles such as libel, defamation, misrepresentation, and unfair competition.”⁵⁶

The TRIPS agreement, which the United States joined 6 years later, incorporates the Berne Convention’s substantive requirements in Article 9 but provides that “Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6*bis*” of the Berne Convention.⁵⁷ In short, protection of moral rights, including the right of attribution, is not required under TRIPS.

Contrary to Congress’s assertions, and in part due to the TRIPS exception, U.S. protection for moral rights currently lags behind the level of protection found internationally. As Professor Rebecca Tushnet notes in a recent article, “[d]espite the international obligations of the United States, current copyright law provides only minimal direct protection for authors’ rights to be recognized as authors of particular works.”⁵⁸ The two primary examples in federal copyright law are the Visual Artists Rights Act (VARA),⁵⁹ and § 1202 of the Digital Millennium Copyright Act, which provides protection for the integrity of copyright management systems.⁶⁰

Just two years after the United States joined the Berne Convention and one year after the implementation legislation was passed, Congress passed VARA.⁶¹ It mirrors the Berne language in allowing creators a right “to claim authorship,”⁶² but it is limited to “work[s] of visual art,” which the Copyright Act provides do not include, among other limitations, works made for hire.⁶³ Although VARA provides authors with both attribution and integrity rights, the purpose of the law (as envisioned by

⁵⁴ *Id.* at art. 6*bis*(2).

⁵⁵ Berne Convention Implementation Act of 1988 § 3(b)(1), Pub. L. No. 100-568, 102 Stat. 2853 (codified as amended at 17 U.S.C. §§ 101, 205, 301, 407 (2006)).

⁵⁶ S. REP. NO. 100-352, at 9 (1988), *reprinted in* 1988 U.S.C.C.A.N. 3706, 3714.

⁵⁷ Agreement on Trade-Related Aspects of Intellectual Property Rights pt. II, art. 9, § 1, Dec. 15, 1993, 33 I.L.M. 81, 87.

⁵⁸ Rebecca Tushnet, *Naming Rights: Attribution and Law*, 2007 UTAH L. REV. 789, 789 (2007).

⁵⁹ Visual Artists Rights Act of 1990, 17 U.S.C. § 106A (2006).

⁶⁰ 17 U.S.C. § 1202 (2006).

⁶¹ Visual Artists Rights Act of 1990, Pub. L. No. 101-650, § 603(a), 104 Stat. 5128 (codified at 17 U.S.C. § 106A).

⁶² 17 U.S.C. § 106A(a)(1)(A).

⁶³ 17 U.S.C. § 101 (2006).

its sponsors) was primarily directed at integrity, not attribution. The Digital Millennium Copyright Act provides that a person may not “intentionally remove or alter any copyright management information,”⁶⁴ and defines “copyright management information” to include not only identifying information about the copyright owner but the author as well.⁶⁵ Although 17 U.S.C. § 1202 provides some protection to authors for attribution, it falls short even of the limited protection offered by VARA and “gives authors no guarantee that statutory protection of copyright management information will cover their names.”⁶⁶

Should the Copyright Act provide a broader right of attribution? There is a thicket of subsidiary issues involved in the analysis of this question, all of which can provoke litigation. Should the name of the author appear on a work? Should there be provisions to prevent misattribution? Given the rejection by the Supreme Court in the *Dastar Corp. v. Twentieth Century Fox Film Corp.* case of a claim that the Lanham Act prevents the unaccredited copying of an uncopyrighted work,⁶⁷ what are the intersections between copyright law and trademark law, particularly for copyrighted works? If there is an attribution right, can it be contractually waived, given especially that waiver would be routinely demanded by people with negotiating positions far stronger than most creators, thereby undermining and often eviscerating the right? What works should be accompanied by a right of attribution and how would the right be enforced? Should it be limited in time as it is under VARA (to the lifetime of the author) or extended to the full copyright term, in keeping with other exclusive rights and international norms? What about works made for hire?

It is easy to envision the simple example of a law professor citing and quoting briefly from another professor’s law review article or failing to do either. Existing norms and customs of behavior point to the propriety and importance of proper citation and, consequently, attribution. But consider three examples, one of a book, the second of a movie, and the third of a poster based on a photograph, that help show the complexities:

First, the *O.J. Simpson* book: O.J. Simpson, with assistance, wrote a work called *If I Did It, Here’s How It Happened*.⁶⁸ The Goldman family, having won a judgment against him, gained control of the rights.⁶⁹

As described by Professor Tushnet, they redesigned the cover “to obscure the *If*; changed the subtitle to *Confessions of the Killer*; removed

⁶⁴ 17 U.S.C. § 1202(b)(1).

⁶⁵ *Id.* § 1202(c)(2)–(3).

⁶⁶ Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 HOUS. L. REV. 263, 285 (2004).

⁶⁷ 539 U.S. 23, 37 (2003).

⁶⁸ Edward Wyatt, *O. J. Simpson Writes a Book He’ll Discuss On Fox TV*, N.Y. TIMES, Nov. 15, 2006, at C4. The final version of the book was published as: GOLDMAN FAMILY, *IF I DID IT: CONFESSIONS OF THE KILLER* (2007).

⁶⁹ Tushnet, *supra* note 58, at 790.

Simpson's name from the cover; and added disparaging commentary."⁷⁰ Should Simpson have a moral or legal right to attribution and to a remedy?

Second, the author of a movie. Consider the many credits you now see at the end of a movie. Giving such credits is the norm and probably a good practice. Should the law require it and give a remedy for violating it? The Ninth Circuit considered the question of who constitutes an author for a motion picture in *Aalmuhammed v. Lee*, and suggested several possible players who could be considered authors, including the producer, director, screenwriter, and editor.⁷¹ Many works today are the product of collaborative efforts. Indeed, one of the reasons for treating some works as made for hire is to vest rights in one copyright owner.

Third, a poster based on a photograph: A recent and dramatic example is Shepard Fairey's "Hope" poster of President Obama, based on a photograph for the Associated Press (AP). In litigation with AP, Fairey claims that he made a transformative, and hence a fair, use of the photograph.⁷² There is also a question whether AP or the photographer owns the photograph. Although Fairey has now acknowledged the original photograph and "has admitted that he lied about which photograph from The Associated Press he used as his source,"⁷³ there is a question whether he, as well as other users who claim a transformative use, should attribute the original source from the outset.⁷⁴ If they believe in good faith that they are making a non-infringing transformative use, why should they mask the identity of the creator of the original work?

It is possible that the concept of attribution is gaining more of a foothold in U.S. creative culture. The best example is Creative Commons, which describes itself as "a nonprofit corporation dedicated to making it easier for people to share and build upon the work of others, consistent

⁷⁰ *Id.*

⁷¹ 202 F.3d 1227, 1232 (9th Cir. 2000).

⁷² See, e.g., Jonathan Melber, *The AP Has No Case Against Shepard Fairey*, HUFFINGTON POST, Feb. 8, 2009, http://www.huffingtonpost.com/jonathan-melber/the-ap-has-no-case-again_b_165068.html. See also Randy Kennedy, *Artist Sues The A.P. Over Obama Image*, N.Y. TIMES, Feb. 10, 2009, at C1.

⁷³ Liz Robbins, *New Wrinkle in Obama Poster Dispute*, N.Y. TIMES, Oct. 18, 2009, at A26. This report also notes that "Mr. Fairey's lawyers said they intended to withdraw when he could find new counsel." *Id.*

⁷⁴ See, e.g., Alissa Quart, *Expensive Gifts: What Does Free Culture Cost?*, COLUM. JOURNALISM REV., July–Aug. 2009, at 22–23 ("'[P]ayment' for the use of journalistic or creative works is not just about the money anymore, at least for independent writers and artists. It's about money *and* a parallel currency that may be as valuable to some as money: attribution by name, or even collaborative attribution."). A vivid example, going back to 1935, is the attribution by Professor Paul S. Taylor to the photography of Dorothea Lange. See Richard Steven Street, *The Documentary Eye: How Economist Paul S. Taylor Pioneered the Use of Photography as Social Documentary*, CAL. MAG., May–June 2009, available at <http://alumni.berkeley.edu/news/california-magazine/may-june-2009-go-bare/documentary-eye>.

with the rules of copyright.⁷⁵ Creative Commons offers six main licenses with varying restrictions, but all six of the main licenses contain two primary restrictions:

[A] requirement that if the work is publicly distributed, displayed or performed, a copy of the Creative Commons license . . . must be included . . . [and] the second restriction common to all six licenses is one requiring attribution and specifying the manner in which the attribution should be accomplished.⁷⁶

The least restrictive license allows the user to manipulate the original in any manner so long as the author is credited.⁷⁷ As of 2008, approximately 130 million works have been licensed under Creative Commons,⁷⁸ which certainly suggests user support for attribution as a condition of using another's work.

Our preliminary view—still in formation and subject to revision—is that we are asking too much of the law to establish and enforce a right of attribution in the United States at this juncture. We remain open to the view, however, that we may have much to learn from foreign countries and that it might be possible to articulate such a right and attendant remedies in a statute.

There also are serious questions of remedies that bear on the question of whether a right should be created. For example, a permanent injunction against further distribution of a work without sufficient attribution seems like a drastic remedy. Arriving at an appropriate monetary remedy, however, also presents problems of valuing the loss to be compensated or the gain to be restored. And, claims by numerous creators for proper attribution to them for their role will raise varied issues of proof, apportionment of creative responsibility, and entitlement to attribution.

There is an alternative, however, that seems worth exploring: to consider, on a case by case basis, whether reasonable attribution was made (or attempted) by a defendant who asserts a fair use defense. We do not mean to suggest that the fair use statute⁷⁹ be amended to add a fifth statutory factor,⁸⁰ but rather to suggest that, in appropriate cases, courts consider the presence or absence of attribution. In parody cases, there is implicit attribution because the parody conjures up the original.

⁷⁵ CreativeCommons.org, About, <http://creativecommons.org/about>; see Lydia Pallas Loren, *Building a Reliable Semicommons of Creative Works: Enforcement of Creative Commons Licenses and Limited Abandonment of Copyright*, 14 GEO. MASON L. REV. 271 (2007) (for a detailed discussion about Creative Commons licenses).

⁷⁶ Loren, *supra* note 75, at 291.

⁷⁷ CreativeCommons.org, Licenses, <http://creativecommons.org/about/licenses>.

⁷⁸ CreativeCommons.org, History, <http://creativecommons.org/about/history>.

⁷⁹ 17 U.S.C. § 107 (2006).

⁸⁰ See Greg Lastowka, *Digital Attribution: Copyright and the Right to Credit*, 87 B.U. L. REV. 41, 84–85 (2007).

In our law professor example, suppose the professor violates citation norms, quotes a crucial passage from another professor's published article or work in process without any quotation marks and without citation or other attribution, and then, when sued for copyright infringement, claims fair use. If the analysis is otherwise close, might it make a difference that the professor violated the usual norms, and even though copyright liability is essentially liability without fault, might it make a difference whether he violated them intentionally or not?

We have touched on four open questions, the implications of *eBay Inc. v. MercExchange, L.L.C.*, the Due Process Clause and statutory damages, the idea of monetary compensation as a factor in fair use analysis, and attribution. Other contributors to this symposium develop various subjects in depth, including more detailed attention to some of these open questions, and we commend their articles to the reader.⁸¹ We expect that when the 300th anniversary of the Statute of Anne takes place next year, and as human creativity and technology continue to advance, the copyright law also will continue to afford a rich variety of open questions to challenge courts, lawyers, and scholars.

⁸¹ See Business Law Forum, *Intellectual Property Remedies*, 14 LEWIS & CLARK L. REV. 451 (2010).