

FINDING TRADITIONAL CONTOURS  
IN THE COMMON LAW

ROUGH WORK-IN-PROGRESS

7/23/08

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INTRODUCTION

Prior to 1972, the Copyright Act did not extend subject matter protection to sound recordings. In 1971, Congress amended the Copyright Act to include sound recordings in copyright’s subject matter protection.<sup>1</sup> The Copyright Act explicitly removes sound recordings fixed before February 15, 1972 (“pre-1972 sound recordings”)<sup>2</sup> from preemption;<sup>3</sup> if they are protected by copyright at all, are protected by state common law – and mostly by the rapidly developing doctrine of common law copyright infringement in New York state.

In 2005, New York’s Court of Appeals in *Capitol Records v. Naxos of America* (“Naxos”),<sup>4</sup> laid down a sweeping pronouncement that common law copyright infringement protected sound recordings from unauthorized reproduction. The scope of New York common law copyright infringement extends to all pre-1972 sound recordings fixed anywhere in the world, whether extraterritorial copyrights that may have subsisted in the works had expired or not.<sup>5</sup> Furthermore, New York considers even “published” sound recordings to be unpublished,

<sup>1</sup> Sound Recording Amendment of 1971, Pub. L. No. 92-140, 85 Stat. 391 (Oct. 15, 1971).

<sup>2</sup> Although pre-1972 sound recordings is not an entirely accurate moniker, I use it herein to refer to sound recordings fixed before February 15, 1972.

<sup>3</sup> 17 U.S.C. § 301(c).

<sup>4</sup> 4 N.Y.3d 540 (N.Y. 2005). The New York Court of Appeals is New York’s highest court.

<sup>5</sup> *Id.* at 563 (“New York provides common-law copyright protection to sound recordings not covered by the federal copyright act, regardless of the public domain status in the country of origin, if the alleged act of infringement occurred in New York.”)

sweeping as many sound recordings into the arms of the common law as possible.<sup>6</sup>

Earlier this year Yoko Ono Lennon and EMI, along with other owners and licensees of the “Imagine” recording by John Lennon filed simultaneous suits in federal and New York state courts for the alleged copyright infringement by the producers of the documentary *Expelled* of the composition and sound recording rights, respectively.

The documentary used 15 seconds of the song to critique its anti-religion message in a larger discussion about the place of religion in academic and scientific debate. It’s a straightforward critical fair use, and largely uninteresting as a matter of federal fair use law.

However, against the backdrop of the *Naxos* decision, the New York case in the *Imagine* litigation raises two major questions: what exactly is the scope of common law copyright infringement, and is it susceptible to First Amendment review? Despite the so-called “scholarly” opinion in *Naxos*, we don’t know the answer to the first question, and can’t begin with the second question until we do.

This article explores the traditional contours of common law copyright infringement in two respects: what constitutes a “reproduction” of a sound recording under common-law copyright infringement, and does the common law recognize some version of fair use? We know from *Eldred* that fair use is a traditional contour of copyright law; is it also a contour of common law infringement, or only of federal copyright law? Common law copyright in sound recordings arose largely as a measure to protect against record piracy. Because of this history, it is unlikely that a short excerpt would even be considered a reproduction under the common law.

The treatment of fair use by New York courts is more of a puzzle – it has only been

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<sup>6</sup> Id. at 560-561.

discussed once, and not at all in the context of sound recordings. This article traces the history of fair use and the history of common law copyright in sound recordings to determine that fair use – or a strict interpretation of the reproduction doctrine – should be a traditional contour of common-law copyright. I also argue that should the courts in this case find that fair use is not a part of the law, that common-law copyright is an impermissible burden on speech imposed by the state and should be subject to First Amendment review. Furthermore, I argue that the definition of traditional contours is not as narrow as previous scholars and courts have suggested; the traditional contours of copyright are more than merely the First Amendment safeguards.

#### *A. Common Law Copyright Infringement*

Common law copyright infringement is somewhat of an odd creature. Although federal preemption and the doctrines surrounding “copyright plus” regimes and state law quasi-IP schemes are quite familiar to copyright scholars, state copyright law that approximates or generally follows the contours of federal copyright protection without an “extra element” is quite rare. The 1976 Copyright Act, almost completely occupies the field;<sup>7</sup> common law copyright is mostly preempted and federal law simply leaves only a narrow gap for state copyright protection schemes. In the post 1976-Act landscape, devoid of registration and notice formalities, bringing unpublished works into the protection of federal law, common law has had only a minor role to play. However, there is one very significant carve-out in the Copyright Act: sound recordings

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<sup>7</sup> Compare 1909 act, § 4; White-Smith. Although the 1909 Act would seem to similarly almost completely occupy the field, the constitutional understanding of “writings” and its limitations on Congress were much more narrow than the contemporary understanding.

fixed prior to February 15, 1972.

1. An Exceedingly Short History of Common Law Copyright to be greatly expanded

The Copyright Act of 1790 was the first federal copyright statute of the United States.<sup>8</sup> The subject matter of the nation’s first copyright act encompassed “maps, charts, and books.”<sup>9</sup> Although multiple states had adopted various copyright statutes, this federal copyright protection pre-empted those early statutes insofar as they were duplicative. It should be noted that the Copyright Act of 1790 did not contain the modern preemption provisions of the 1976 Copyright Act. However, the exercise of a Congressional power such as the one found in the copyright clause,<sup>10</sup> would pre-empt equivalent state laws under the Supremacy Clause.<sup>11</sup>

In *Wheaton v. Peters*,<sup>12</sup> the Supreme Court for the most part resolved lingering questions over the interplay between federal and state copyright laws. Wheaton, the retired Supreme Court reporter, sued his replacement, Peters, for statutory and common-law infringement by republication of material that had appeared in the Wheaton reporters.<sup>13</sup> The Court, in an exceedingly obscure opinion, declared three major principles relevant to this discussion: first, there is no federal common law copyright; second, that decisions and customs of each state determined the extent of common law copyright in each particular state; and third (as

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<sup>8</sup> Act of May 31, 1790, ch. 15, 1 Stat. 124 (Copyright Act of 1790).

<sup>9</sup> *Id.*

<sup>10</sup> art 1 sec 8 cl 8

<sup>11</sup> Art VI, sec 2. See Nimmer §1.01

<sup>12</sup> 33 U.S. (7 Pet.) 591 (1834).

<sup>13</sup> The statutory claim was remanded on formalities issues.

traditionally stated), that publication terminates the exclusive and perpetual right at common law that an author holds in an unpublished work. Almost 150 years later, the Supreme Court confirmed the constitutionality of this bifurcated federal/state copyright regime.<sup>14</sup>

After federal statutory copyright was born, what remained to the protection of the states was subject matter not included in the Copyright Act and its revisions – for the most part unpublished works. Prior to the 1976 Copyright Act, the major component of common law copyright was to protect against the unlawful reproduction, distribution, and performance of unpublished works. Unlawful fixation of an unfixed work is the major remaining component of common law copyright. The vestigial component is the protection of works neither pre-empted nor protected by federal copyright, including pre-1972 sound recordings.

## 2. Federal Copyright and Pre-1972 Sound Recordings

While *Wheaton* settled questions of common law copyright in printed and published works – the states were free to establish regimes protecting unpublished or unfixed works – new media raised new questions in common law copyright.

Despite the development of audio recording technology prior to the twentieth century, before 1971, federal copyright law did not protect sound recordings. The federal copyright statute has not always been so universal in its language, and has often failed to protect works made possible by technological developments in the creative arts. In an early example of this phenomenon, the

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<sup>14</sup> *Goldstein v. California*. The discussion of the *Imagine* litigation, *infra*, reveals how flawed the *Goldstein* court's reasoning was. However, the outcome of the case is probably correct.

Supreme Court in *White-Smith Music* found that piano player rolls were not protected under federal copyright law because they were incapable of being read by a person.<sup>15</sup> Sound recordings, too, were incapable of being read by a person; by logical extension of *White-Smith*, sound recordings were similarly unprotected by the Copyright Act.

The Copyright Act of 1909 quickly followed the Supreme Court's decision in *White-Smith*: Congress partially reversed the decision, establishing an author's exclusive right to mechanically reproduce music.<sup>16</sup> Congress, however, declined to include sound recordings within the scope of the statute. The Act, however, did provide that federal copyright law "shall [not] be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, or to obtain damages therefore."<sup>17</sup> At the very least, Congress had intended that unpublished sound recordings should continue to be eligible for protection by state law regimes; [although by what type of law also unclear] the state of the law regarding *published* sound recordings was less clear.

In the meantime, sound recording technology further developed, and record piracy eventually became rampant. In 1971, Congress estimated that record piracy amounted to at least \$100M annually.<sup>18</sup> Because of the increasingly urgent need to bring sound recordings under the auspices

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<sup>15</sup> See *White-Smith Music Publ. Co. v. Apollo Co.*, 209 U.S. 1, 19 (1908) (the text of the 1790 Act limited copyright subject matter protection to "writings"; piano player rolls were not "copies" of an author's writing – the musical composition - under the Act because a person could not look at the roll and read it).

<sup>16</sup> Copyright Act of 1909, § 1(e).

<sup>17</sup> Copyright Act of 1909, § 2.

<sup>18</sup> H.R.Rep. No. 92-487 (1971), reprinted in 1971 USCCAN 1566.

"While it is difficult to establish the exact volume or dollar value of current piracy

of federal copyright, and the changed beliefs about what constitutes a “writing” protectable by statutory copyright, Congress amended the 1909 Copyright Act to include sound recordings in the classes of works eligible for federal copyright protection.<sup>19</sup> This Sound Recording Amendment was only prospective in nature, so that recordings created prior to February 15, 1972 were not protected by federal law. Federal law would preempt any state law protection for the pre-1972 recordings in 2047.<sup>20</sup> The result of this amendment was not entirely clear and legal developments after the Sound Recording Amendment have not begun to settle the scope of common law copyright in sound recordings.

### *B. The Imagine Litigation*

*Expelled: No Intelligence Allowed* (“*Expelled*”) is a documentary film exploring intelligent design; the role of religion in society, humanity and science; and the need for open debate and free intellectual discourse about these issues in education and our society.

The producers of *Expelled* used 15 seconds of John Lennon’s “*Imagine*” to comment on and criticize the view held by many academics active in the evolution debate that religion is undesirable. To do so, they used a phrase from the admittedly iconic song that suggests that

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activity, it is estimated by reliable trade sources that the annual value of such piracy is now in excess of \$100 million. It has been estimated that legitimate prerecorded tape sales have an annual value of approximately \$400 million.” *Id.* at 1567.

<sup>19</sup> 17 USC § 5[n], added by Pub L. 92-140, 85 U.S. Stat 391 [Act of Oct. 15, 1971]. The statute included as protected classes sound recordings ‘fixed, published, and copyrighted’ on and after February 15, 1972, but did not include within the ambit of federal protection works fixed prior to February 15, 1972. [house report??]

<sup>20</sup> 17 U.S.C. § 301(c). This was later extended to 2067 by the Sonny Bono Act. Pub. L. No. 105-298, 112 Stat. 2827.

religion is detrimental, namely, “nothing to live or die for...no religion too.” The filmmakers use this clip to comment on the social meaning of the song – both explicitly and implicitly – and not to exploit its commercial value.

On April 22, 2008 Yoko Ono Lennon, Sean Ono Lennon, Julian Lennon and EMI Blackwood Music, Inc. – the alleged owners and publisher of the *Imagine* composition rights – sued Premise Media and the other producers and distributors of *Expelled* for federal copyright infringement of the *Imagine* composition.<sup>21</sup>

On the same day, EMI Records and Capitol Records – the owner and exclusive licensee of the *Imagine* Sound recording, respectively - sued the same set of defendants in New York State court on a corresponding set of theories.

The plaintiffs in these federal and state twin cases asked for a preliminary injunction enjoining the defendants from distributing the film. As of this writing, the court in the New York case – *EMI v. Premise* – is still waffling over whether fair use protects the Defendants’ use of *Imagine*.

In *Ono v. Premise*, while the federal district court could have decided on other grounds that an injunction was not warranted, it took just over forty days (a split second on the Southern District of New York’s clock) to decide that the Defendants are “likely to prevail on their fair use defense.”<sup>22</sup> Copyright scholars without a vested interest in the outcome of this litigation have

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<sup>21</sup> The Plaintiffs also sued on a Lanham Act claim, alleging that Defendant’s crediting other composition owners with a notation that permission was granted, while omitting a permission credit to Plaintiffs, falsely suggested that the film was associated with or approved by Plaintiffs in some way.

<sup>22</sup> See opinion/order

commented that the use of copyrighted material in this case is at the core of fair use protection.<sup>23</sup>

Unfortunately, the twin *Imagine* cases also raise the possibility that what is protected by federal fair use law is punished by state law. Most states do not protect sound recordings via common-law copyright infringement. Many states protect against record piracy, i.e., unauthorized duplication of a sound recording.

Although the states protect sound recordings in varying ways, none have jurisprudence as advanced as New York state. The reason for this is intuitively obvious: New York has long been the center of the creative industries, especially publishing and music. Since the 1940s, New York law has produced a steady stream of sound recording decisions.

Despite this history, common law copyright infringement is new even to New York. Although there has been a steady history of decisions protecting owners' exclusive duplication rights in sound recordings, before *Naxos*, a New York court has never stated that common law copyright protects sound recordings.

Although the laws and rulings of other states have certainly influenced New York's decision-making, New York common law is the most influential in the pre-1972 sound recording area, especially in a practical sense. Despite the Goldstein court's belief that jurisdictional experimentation and differences would not cause one state's common law copyright to affect another's, this is emphatically not the case.<sup>24</sup>

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<sup>23</sup> See <http://blogs.wsj.com/law/2008/05/20/updating-the-latest-star-studded-fair-use-flap-starring-yoko-and-ben/> ("Columbia copyright guru Tim Wu told us this: 'I don't think this is a hard case; nor a close case. Playing 15 seconds of a song to criticize it is as fair as fair use gets. With respect to Yoko Ono: if this case isn't fair use, then copyright law has become censorship law.'")

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As long as a court has personal jurisdiction over a party that has engaged a sufficient number of contacts with a state, that court could enjoin the party from extra-jurisdictional behaviors; because most record companies are based out of New York, and most infringers engage in nationwide actions, the law of New York reaches beyond its own borders. One writer has dubbed this the long-arm reach of New York sound recording law.

Certainly statutes like the one at issue in *Goldstein* – prohibiting the unauthorized manufacture of sound recordings – wouldn't necessarily reach outside the state. In that particular instance in-state manufacture and sale of imported of unauthorized duplications were prohibited, but citizens would be free to travel and purchase their own pirate copy in a state that did not prohibit the record piracy. The *Goldstein* court never considered the possibility that common law copyright in one state could eliminate another state's ability to create a less restrictive regime.<sup>25</sup>

The expansion of sound recording protection to common law copyright infringement has serious repercussions. As long as venue and jurisdiction are proper, the owner of a sound recording fixed anywhere in the world could sue not just record pirates, but those engaging in fair uses (or what would be considered so under federal law) or users making personal backup copies of sound recordings. Indeed, because under *Naxos* New York common law protects every

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<sup>25</sup> This presents quite a compelling argument for a uniform federal law governing pre-1972 recordings. The music industry has objected to lobbyists seeking to reform federal sound recording protection – and to the 2067 sunset date of state protections – on a fifth amendment basis. It is possible the Supreme Court might also need to extend *Eldred* to allow fifth amendment review of the congressional alteration of traditional contours. However, as the Court noted in *Eldred*, it has always been the case (and Congress' constitutional prerogative) that federal copyright protection extinguishes state common law copyright. The same is true of a deliberate withholding of such protection. *Sears*.

single historical recording, the public's ability to remaster and preserve sound and musical heritage may be severely chilled.<sup>26</sup>

*C. Traditional Contours of Common Law Copyright?*

The *Naxos* decision has wide-ranging implications; now that litigants are actively taking advantage of New York's advancement of its common law copyright theory,<sup>27</sup> a few of these implications are coming to light. The *Imagine* litigation raises questions about the scope and contours of common law copyright. What are the "traditional contours" of common law copyright? What might limit these contours?

I focus in particular on the *Imagine* litigation because the concept that the plaintiffs advance is so radically different from what the common law has protected in the past – the unauthorized duplication in full of sound recordings. It has never been the case that common law protected the unauthorized duplication of a mere excerpt of a sound recording. As of this writing, no New York court has given its opinion on the matter. If New York's common law copyright will expand to protect against fragmentary uses, does that comport with the traditional contours doctrine advanced in *Eldred*, or does that doctrine strictly apply to federal statutory copyright law? Even if *Eldred* does not apply, are the scope and contours of common law copyright restrained by the First Amendment or other federal limitations nonetheless?

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<sup>26</sup> The *Naxos* decision has already dramatically limited both amateur and professional sound recording preservation efforts.

<sup>27</sup> Currently two other cases besides *EMI v. Premise* have been filed with common law copyright infringement claims.

1. The historical scope of common law copyright

This section is under construction. It will trace the historical scope of common law copyright, including the understanding that the framers held of common law copyright, especially whether the constitution limited common law rights in any way whatsoever. I then turn to the *Naxos* court's understanding of common law copyright. Despite laying fallow for a great number of years, the *Naxos* court draws directly on traditional cases like *Millar v. Taylor* and *Donaldson v. Beckett*. These cases are also very important to the federal common law of copyright (explained *infra*).

2. Sound Recordings and the Publication Doctrine

At the time of the Sound Recording Amendment, it was quite unclear whether or not Congress intended to abrogate states' rights to protect published sound recordings.<sup>28</sup> Litigants, in challenging and defending common law sound recording protection regimes, have relied on the definition of publication to help define the scope of common law copyright. Although the common law publication doctrine isn't the focus of this article, tracing the roots and evolution of publication of sound recordings is extraordinarily useful in determining other components and contours of common law copyright. The doctrine of publication set forth in *Wheaton*, as

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<sup>28</sup> The lack of clarity is easily illustrated by the post-Sound Recording Amendment confusion and litigation.

traditionally understood, is that the act of publication of a copyrighted work divests the copyright owner of his common law rights in the work.<sup>29</sup>

Even prior to the Sound Recording Amendment, the question of whether publication of a sound recording extinguished state common law rights was an issue. Two early cases, one in Pennsylvania, *Waring v. WDAS Broadcasting Station, Inc.*,<sup>30</sup> and one in the Second Circuit, *Capitol Records, Inc. v. Mercury Records Corp.*,<sup>31</sup> held that publication does not divest common law rights in a sound recording. *Capitol v. Mercury* overruled a prior decision, *RCA Manufacturing Co. v. Whiteman*,<sup>32</sup> which held that publication **did** divest common law rights in a sound recording. Applying the Erie Doctrine, the *Capitol v. Mercury* court stated that *RCA* would be controlling except for the New York court decision in *Metropolitan Opera Association v. Wagner-Nichols Recorder Corp.*,<sup>33</sup> which also held that publication did not divest common law rights in a sound recording.<sup>34</sup>

In *Goldstein v. California*,<sup>35</sup> the Supreme Court found that a California criminal law used to convict the defendants of music piracy was valid.<sup>36</sup> The Court noted that in the absence of conflict between federal and state law, the Supremacy Clause did not bar state common law

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<sup>29</sup> 33 U.S. 591 (1834).

<sup>30</sup> 194 A. 631 (Pa. 1937)

<sup>31</sup> 221 F.2d 657 (2d Cir. 1955)

<sup>32</sup> 114 F.2d 86 (2d Cir. 1940)

<sup>33</sup> 101 N.Y.S.2d 482 (N.Y. Sup. Ct. 1950). The decisional basis for this case was clearly unfair competition.

<sup>34</sup> Note that the common law rights consisted of the exclusive right to make and sell “records” in the US.

<sup>35</sup> 412 U.S. 546 (1973).

<sup>36</sup> Specifically, any durational limitations in the copyright clause were not applicable to the states; therefore, common law copyright of unlimited duration was valid. *Id.* at 560-561.

protection for these works.<sup>37</sup> The *Goldstein* court's view that common law protection could persist beyond publication was an alteration of the doctrine set forth in *Wheaton*. Furthermore, the *Wheaton* principle – that publication extinguishes common law copyright – applied only to interpreting federal law.<sup>38</sup> Congress clarified this decision in the 1976 Copyright Act, defining publication of a sound recording as “a public sale” – at least for purposes of federal protection.<sup>39</sup>

The battle over whether or not state copyright protection of pre-1972 sound recordings was extinguished at publication was again fought in California. In 1995, the Ninth Circuit decided that public sale of a pre-1972 sound recording was a publication that divests the owner of common-law copyright protection in the composition.<sup>40</sup> A Sixth Circuit District court followed this interpretation.<sup>41</sup>

The Second Circuit's decisions in *Capitol Records* and *Rosette* were at odds with the Ninth Circuit's *La Cienega* decision and Congress criticized the Ninth Circuit, accusing them of “overturn[ing] nearly 90 years of decisions.”<sup>42</sup> This was not necessarily so; it appears that the *Capitol/Rosette* cases were at least heavily criticized, if not in the minority.

Detail which cases were part of which line – some, like *La Cienega & Rosette*, question whether or not the public sale of a sound recording constitutes a copy/publication of the underlying musical composition. Others, like *Capitol Records*, question whether the

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<sup>37</sup> 412 U.S. 546, 569-70 (1973).

<sup>38</sup> Totally at odds with *Compco/Sears*?

<sup>39</sup> “the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership. 17 U.S.C. § 101.

<sup>40</sup> *La Cienega Music Co. v. ZZ Top*, 53 F.3d 950 (9th Cir. 1995).

<sup>41</sup> . See *Mayhew v. Gusto Records Inc.*, 960 F. Supp. 1302 (M.D. Tenn. 1997) (following *La Cienega*).

<sup>42</sup>

publication/public sale of a sound recording extinguishes common law rights in the sound recording itself.

After the decision in *La Cienega*, Congress amended the 1976 Act to once again clarify the law: “distribution before January 1, 1978, of a phonorecord shall not for any purpose constitute a publication of the musical work embodied therein.”<sup>43</sup> This was certainly a direct answer to the question actually raised in *La Cienega* – whether or not the public sale of a sound recording constituted publication of the underlying musical composition. The appeal in *Mayhew* was heard subsequent to the amendment, and the Sixth Circuit reversed the district court on the basis of the amendment.<sup>44</sup>

In a landmark – but some what confused – decision, *Capitol Records, Inc. v. Naxos of America, Inc.*,<sup>45</sup> the New York State Court of Appeals extended common law copyright protection in New York to all sound recordings created before 1972, fixed anywhere in the world, until federal preemption of all states’ laws concerning sound recordings fixed prior to 1972.<sup>46</sup> The New York State Court of Appeals concluded that sound recordings created before February 15, 1972 are protected by NY common law of copyright and the sale to the public of sound recording does not constitute publication sufficient to divest the owner of common-law

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<sup>43</sup> 17 U.S.C. § 303(b) (1997).

<sup>44</sup> *Matthew v. Allsup*, 166 F.3d 821 (1999).

<sup>45</sup> 830 N.E.2d 250 (N.Y. 2005). Although one commentator has endowed the Naxos opinion with the “scholarly” superlative, see 2-8C Nimmer on Copyright § 8C.03 (Naxos is “a scholarly opinion on the status of sound recording protection under New York state law”), this opinion has been roundly criticized. For an excellent recap of the failures of the New York Court of Appeals to adequately grasp the concepts with which they were grappling, see Patry on Copyright, § 6.34. Patry calls the opinion “historically drenched (but not entirely accurate),” criticizing the court’s ability to “distinguish away prior cases... [leading] to a muddled analysis and considerable assessment of inconsistent historical material.”

<sup>46</sup> *Naxos*, 830 N.E.2d at 264.

copyright protection in the recording.<sup>47</sup> This was a much broader statement of the law than had previously occurred. It was, in essence, an extension of the 303b clarification and a simultaneous extension of essentially common law unfair competition rights in literary property into **copyright** rights in sound recordings in New York.

The history of the doctrine of publication – and its apparent lack of acceptance in the common law copyright of sound recordings – gives us some idea of the scope, in terms of duration, of common law copyright. It is at least perpetual, insofar as it is not abridged by federal law. As a limitation to common law copyright, the doctrine of publication is completely meaningless – unless it allows federal statutory copyright to spring forth and stamp out the common law copyright.

### 3. Fragmentary Reproduction and Common Law Copyright

This section is under construction.

### 4. Fair Use and Common Law Copyright in Sound Recordings

To what extent does fair use come from common law, and to what extent is common law copyright borrowed from federal law?

This section is under construction.

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<sup>47</sup> *Id.*

## 5. Resolving the Imagine Litigation

It appears that fair use is a traditional contour of common law copyright, and that protection of fragmentary uses of a sound recording is not. If this is true, does it mean that altering them automatically triggers first amendment scrutiny? What would have to be true for that to happen?

We know from the doctrine of publication and the federal/state traditional contours interface that there are certainly some traditional contours of common law copyright that are just not part of statutory copyright. Constitutional limitations on Congress' copyright powers create no limits on the contours of common law copyright.<sup>48</sup>

Did the framers also see common law copyright as consonant with the first amendment, or did they expect the first amendment to foreshorten common law's reach? If the framers did understand the First Amendment as Eldred suggests, perhaps it also means that alterations of the framers' understanding of the common law of copyright also automatically trigger First Amendment scrutiny. Even though permitting fragmentary reproduction is not per se a First Amendment safeguard, allowing such uses achieves important First Amendment goals.

If New York decides that fair use is not a part of its common law copyright, or if altering the traditional contours of common law copyright doesn't automatically trigger First Amendment scrutiny in the same way suggested in Eldred, the protections of the First Amendment still apply.

WHAT CAN THIS ANALYSIS TEACH US ABOUT THE TRADITIONAL CONTOURS

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<sup>48</sup> Goldstein

## OF FEDERAL COPYRIGHT LAW? PART E!

*D. The First Amendment and Traditional Contours*

The debate on whether and how much the First Amendment limits copyright is not new, nor has it been settled by recent developments in constitutional copyright jurisprudence.

- review of history, nimmer & Goldstein
- nimmer certainly cited by courts approvingly, but the ideas within not necessarily adopted – most courts forgot the part that copyright does indeed restrict expression
- nimmer’s definitional balance reflected the much narrower copyright of 1970

Historically, courts have not imposed First Amendment–based restrictions on copyright, assuming that copyright’s internal First Amendment safety valves are adequate in protecting First Amendment interests. One court has even gone as far to extrapolate that “copyrights are categorically immune from challenges under the First Amendment.”<sup>49</sup>

Although such a bright-line rule is attractive for its ease of application, this black-and-white view of copyright and the First Amendment was rejected by the Supreme Court in *Eldred v. Ashcroft*.<sup>50</sup> In its review of a challenge to the Sonny Bono Copyright Term Extension Act, it held that where “Congress has not altered the traditional contours of copyright protection . . . First Amendment scrutiny is unnecessary.”<sup>51</sup> Based on this principle, and a lengthy Congressional history of extending copyright terms, the Supreme Court found that a twenty-year

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<sup>49</sup> *Eldred v. Reno*.

<sup>50</sup> “We recognize that the DC circuit spoke too broadly”

<sup>51</sup> at 221

copyright term extension did not violate the “limited times” provision of the copyright clause.

In the Eldred opinion the Court identified two traditional contours – fair use, and the idea/expression dichotomy.<sup>52</sup> Despite the lack of definition or explanation of this concept, or any basis for it whatsoever in the law, few scholars have given traditional contours anything but the lightest of treatments.<sup>53</sup>

This is perhaps because until the Tenth Circuit ruling in *Golan v. Gonzalez* that the URAA altered the traditional contours of copyright, there was little to discuss. Notable exceptions to the dearth of judicial or scholarly exposition of the traditional contours concept include work by Chris Sprigman and Rob Kasunic. Kasunic at least implicitly defines traditional contours as copyright’s internal free speech safeguards. Sprigman defines traditional contours in the same implicit way, suggesting that copyright formalities are an additional traditional contour.

In *Golan v. Gonzales*, the Tenth Circuit has attempted to give some judicial explication of the doctrine, and although its analysis is helpful, it is far from definitive; the traditional contours doctrine has no grounding in law prior to Eldred, and we simply cannot use the Tenth Circuit’s explanation of it as the final word.

However, the *Golan* opinion is intriguing in that it unhitches traditional contours from a strict First Amendment mooring. The Court of Appeals suggested that traditional contours really means traditional contours, not the traditional contours of copyright’s in-built first amendment protections. It seems likely that if the Eldred court wished to limit traditional contours to the two

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<sup>52</sup> The Court did not explicitly limit traditional contours to these two principles. However, the existence of other traditional contours is at issue in the *Golan v. Gonzalez* case. The government declined to petition for cert, instead settling for a remand of the issue.

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named contours, or that traditional contours only meant traditional First Amendment safeguards, the court would have explicitly limited it. Compared with the scanty analysis of the traditional contours concept that copyright scholars have thus far provided, this is quite a provocative suggestion.

*Golan* suggested that traditional contours doctrine has both a functional and historical component: the form or structure of copyright as Congress' historical practice has traditionally defined it. This definition of traditional contours, while a leap forward, contains several assumptions that could be questioned, or at least informed, by closely examining non-federal, non-statutory copyright law.

The first assumption contained in this expression of the traditional contours doctrine – that it is limited to federal law – is not so shocking, and perhaps even true. We could certainly conceive of it as wrong after looking at the second assumption – that Congress defines the traditional contours of copyright when it creates statutory law.

This second assumption is almost certainly wrong. The two named traditional contours of copyright originate not with Congress, but with the courts.<sup>54</sup> Neither the doctrine of fair use, nor the idea/expression dichotomy<sup>55</sup> were even **codified** by Congress until the 1976 Copyright Act. Because the Supreme Court is quite willing to examine the 1790 Copyright Act as part of copyright's tradition, it cannot logically be true that traditional contours extend only so far back

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<sup>54</sup> Some may point to the seemingly congressionally created functional equivalent of unlimited times as a traditional contour via excessive and continuous copyright term extensions. I do not agree with this analysis of *Eldred* and don't find it to be a persuasive rationale in supporting the *Golan* court's assertion.

<sup>55</sup> 56 Tenn. L. Rev. 321 (1989)

as the 1976 Act. Because we must therefore look to the federal common law of copyright<sup>56</sup>, it also makes sense that we might look at the state common law of copyright for guidance in thinking about the traditional contours of statutory copyright.

*E. Common Law Copyright and Traditional Contours in Statutory Copyright*

Should we look to common law copyright for guidance in what might constitute the traditional contours of federal statutory copyright? Or would that be detrimental? The common law includes many concepts not present in statutory copyright and relies on rationales incompatible with the modern Copyright Act. Perhaps we should at least examine those traditional contours of common law copyright not incompatible with the engine of expression ideal and other constitutional copyright mandates.

The history of *Wheaton v. Peters* and the sound recording publication battle make clear that the federal copyright act does not divest common law copyright in author's works from the states - insofar as it is not incompatible with federal copyright law. It is also at least clear, given the common law origins of the traditional contours of copyright named by the Eldred court – that statutory copyright law did not create a tabula rasa on which modern copyright was built. At the same time, the current understanding of fair use and idea/expression dichotomy are informed by modern standards and limited by the First Amendment.

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<sup>56</sup> Note here that I use the “federal common law of copyright” in distinction from “federal common law copyright,” which the Supreme Court affirmed did not exist in *Wheaton v. Peters*. I use the federal common law of copyright to refer to judicially-created doctrines of copyright, like fair use and idea/expression, created in federal courts.

In order to make sense of Eldred – instead of merely disclaiming traditional contours doctrine as impossible to know because it was pulled out of thin air – we must come to some sort of understanding of traditional contours. Although a precise meaning is likely impossible at this stage, the forgoing history suggests that Eldred’s traditional contours refers to all the traditional contours of copyright insofar as they comport with the framers’s understanding of copyright law. This probably means some blend of common law copyright as the framers understood it, but limited by both Copyright Clause and First Amendment concerns. [Also includes the utilitarian viewpoint – but not that of an economist<sup>57</sup>]

The definition of traditional contours should also be flexible, and Eldred itself shows that Supreme Court expects this: the two named traditional contours are the idea/expression dichotomy and fair use. The origins existed in the common law, but those doctrines weren’t yet formalized or developed. Flexibility should also mean that courts should not be allowed to improperly and stingily apply the doctrines either.<sup>58</sup>

#### CONCLUSION

Things to think about next

Fair abridgment

Derivative works

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<sup>57</sup> But perhaps this is going too far – Eldred seems to say (and it seems inaccurately or illogically) that the quid pro quo applies only in the patent context.

<sup>58</sup> I suggest that form over substance might also trigger First Amendment scrutiny.