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Taming the Derivative Works Right: A Modest Proposal for Reducing Overbreadth and Vagueness in Copyright

Christina Bohannon

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Taming the Derivative Works Right: A Modest Proposal for Reducing Overbreadth and Vagueness in Copyright

*Christina Bohannon**

ABSTRACT

The Supreme Court recently decided United States v. Stevens, a case challenging the constitutionality of a federal statute that punishes commercial depictions of animal cruelty, such as videos of dog fights. Concluding that the statute prohibited a good deal of speech that was unrelated to eradicating illegal animal cruelty, the Court held that the statute was substantially overbroad and therefore invalid under the First Amendment.

This case and other First Amendment cases help to shed light on the problems of overbreadth and vagueness in copyright law, particularly the derivative works right. The copyright holder's derivative works right prohibits others from making any work "based upon a copyrighted work" that "modifies, transforms, or adapts" the copyrighted work in any way. Because all new expression must necessarily borrow from existing expression to some degree, the derivative works right sweeps a good deal of speech within its

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prohibition. While the fair use doctrine purports to protect some of this new expression, fair use is vague and unpredictable in application, particularly when it intersects with the derivative works right.

This Article compares the Copyright Act to the dogfighting statute and other statutes to demonstrate considerable overbreadth and vagueness in the scope of the copyright protection. It argues for a narrowing interpretation of copyrights that will substantially mitigate these First Amendment concerns.

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United States v. Stevens, the “dogfighting” case, is the Supreme Court’s most recent pronouncement on First Amendment overbreadth.¹ There, the Court considered a First Amendment challenge to a statute that punishes depictions of animal cruelty, such as videos of dogfights. The statute, 18 U.S.C. § 48,² punished by both fine and potential imprisonment anyone who “knowingly creates, sells, or possesses a depiction of animal cruelty with the intention of placing that depiction in interstate or foreign commerce for commercial gain.”³

The Supreme Court held that the statute violated the First Amendment.⁴ First, it held that video depictions of animal cruelty are protected speech, rejecting the Government’s argument that such

1. *United States v. Stevens*, 559 U.S. ___, 2010 WL 1540082 (2010).
 2. 18 U.S.C. § 48 (2006).
 3. 18 U.S.C. § 48(a).
 4. *Stevens*, 2010 WL 1540082, *12-14.

depictions should constitute a new category of unprotected speech akin to obscenity, child pornography, and fighting words.⁵

Second, it held that the statute was substantially overbroad.⁶ The Court noted that “[t]he legislative background of § 48 focused primarily on the interstate market for ‘crush videos.’”⁷ Those videos depict a woman crushing a live animal to death with her foot or high heel, appealing to the deviant sexual interest of some viewers.⁸ Because these women typically cannot be identified for direct prosecution for animal cruelty, Congress saw a need to criminalize crush videos in order to dry up the market for the cruelty itself.⁹ While the Court reserved judgment on whether a statutory prohibition of crush videos alone would be a constitutional means of reducing animal cruelty,¹⁰ it held that § 48 was “alarming” in its breadth.¹¹ “To begin with, the text of the statute’s ban on a ‘depiction of animal cruelty’ nowhere requires that the depicted conduct be cruel.”¹² Rather, “[t]hat text applies to ‘any . . . depiction’ in which ‘a living animal is intentionally maimed, mutilated, tortured, wounded, or killed.’” The Court observed that the words “maimed,” “mutilated,” and “tortured” might inherently “convey cruelty,” but that the words “wounded” and “killed” do not suggest any such limitation.¹³ Therefore, the statute could have applied to depictions of activities such as hunting or bullfighting.

Moreover, the Court indicated that people would have difficulty determining whether the statutory ban applied to their activities. Although the statute applied only when the depicted conduct was illegal, “the depicted conduct need only be illegal in ‘the State in which the creation, sale, or possession [of the video or other depiction] takes place, regardless of whether the . . . wounding . . . or killing took place in [that] State.’”¹⁴ Consequently, the Court explained that “[a] depiction of entirely lawful conduct runs afoul of the ban if that depiction later finds its way into another State where the same

5. *Id.* at *6-7.

6. *Id.* at *14.

7. *Id.* at *4.

8. *See id.* (citing H.R. REP. NO. 106-397, at 2 (1999)).

9. H.R. REP. NO. 106-397, at 2 (1999), at 3.

10. *See Stevens*, 2010 WL 1540082, at *14 (“We therefore need not decide whether a statute limited to crush videos or other depictions of extreme animal cruelty would be constitutional.”).

11. *Id.* at *9.

12. *Id.*

13. *Id.*

14. *Id.* at *9.

conduct is unlawful.”¹⁵ Thus, the statute would have applied to video depictions of the humane slaughter of a cow that was lawful in the jurisdiction where it occurred but unlawful in the jurisdiction where a person was later discovered in possession of the video.

The statute included an exception for depictions with “serious religious, political, scientific, educational, journalistic, historical, or artistic value.”¹⁶ Yet, this clause did not save the statute. The Court explained: “*Most* of what we say to one another lacks ‘religious, political, scientific, educational, journalistic, historical, or artistic value’ (let alone serious value), but it is still sheltered from government regulation. Even [w]holly neutral futilities . . . come under the protection of free speech as fully as do Keats’ poems or Donne’s sermons.”¹⁷ In addition, at oral argument, Justice Breyer said that the language of the exceptions clause is vague and that people will not know what conduct “falls within this exemption.”¹⁸ Therefore, people “won’t know whether or not they can make this particular film, picture, or other. That’s the overbreadth argument.”¹⁹

This Article deals with another area of law in which people “[do not] know whether or not they can make this particular film, picture, or other.”²⁰ That area of law is copyright, and in particular, the broad swath of copyright law in which the derivative works right intersects with the fair use doctrine. While the challenged dogfighting statute may not seem to have much in common with these provisions of the Copyright Act, there are many similarities from a First Amendment perspective. Many of the concerns involving overbreadth and vagueness under the dogfighting statute are of serious concern in copyright law as well. Part I of this Article attempts to highlight the similarities between the Copyright Act and statutes such as the dogfighting statute and to demonstrate overbreadth and vagueness in the Copyright Act. Part II argues that the Supreme Court’s idiosyncratic approach to First Amendment scrutiny of copyright law has masked these concerns, and therefore that direct First Amendment scrutiny is not likely to be a useful tool for resolving

15. *Id.* at *9-10.

16. 18 U.S.C. § 48(b) (2006).

17. *Stevens*, 2010 WL 1540082, at *12 (emphasis in original).

18. *Id.* at 12-13. Justice Breyer stated his concern with vagueness as follows:

You take these words, which are a little vague, some of them, ‘serious religious, political, scientific, educational, journalistic, historical, or artistic value,’ and you say that’s a standard that a judge or prosecutor will apply. And people have to understand it because they have to know what to do to avoid the risk of being prosecuted.

Id.

19. *Id.* at 13.

20. *Id.*

them. It concludes by making a few suggestions regarding statutory interpretation of the Copyright Act that can help to reduce overbreadth and vagueness in its scope.

I. THE COPYRIGHT ACT AS OVERBROAD AND VAGUE SPEECH REGULATION

A. Copyright is Speech Regulation

In determining whether conduct constitutes speech, the question a court asks is whether the conduct (1) is intended to communicate a message and (2) is likely to communicate a message to those who see or hear it.²¹ If it is intended to communicate a message, then the question is whether the message constitutes *protected* speech. The Court has held that some speech, such as obscenity or fighting words, is not protected because the likelihood of harm is so apparent and the speech is of little value otherwise.²²

In *Stevens*, the Third Circuit held that the dogfighting videos were speech, and were not unprotected speech like obscenity or fighting words.²³ It said that dogfighting videos and other depictions of animal cruelty might be made for a variety of reasons, and that they often communicate a message.²⁴ The Supreme Court agreed, rejecting the Government's proposed rule that "[w]hether a given category of speech enjoys First Amendment protection depends upon a categorical balancing of the value of the speech against its societal costs."²⁵ The Court described the Government's "free-floating test for First Amendment coverage" as "startling and dangerous."²⁶ It explained that First Amendment coverage is robust and mandatory except in very limited circumstances, not subject to open-ended balancing.²⁷

21. See *Texas v. Johnson*, 491 U.S. 397, 404 (1989) (citing *Spence v. Washington*, 418 U.S. 405, 410-11 (1974)).

22. See, e.g., *Paris Adult Theatre I v. Slaton*, 413 U.S. 49 (1973) (holding that state may prevent the exhibition of particular obscene material); *Chaplinsky v. New Hampshire*, 315 U.S. 568 (1942) (holding that fighting words are unprotected speech).

23. *United States v. Stevens*, 533 F.3d 218, 232 (3d Cir. 2008) ("We disagree with the suggestion that the speech at issue here can appropriately be added to the extremely narrow class of speech that is unprotected.").

24. *Id.* at 221, 224-32 (observing that the videos are often accompanied by narration and concluding that "the speech restricted by [the statute] is protected by the First Amendment").

25. *Stevens*, 2010 WL 1540082, *6.

26. *Id.*

27. *Id.*

Likewise, it is now widely recognized that the Copyright Act regulates speech.²⁸ Arguably, some “pure” verbatim copying constitutes speech.²⁹ In at least some cases, when a person selects from among copyrighted works the material with which she most identifies or disagrees and copies the expression, the copyist is communicating a message. It does not matter that the expression did not originate with the copyist; it is the copyist’s use of or association with that expression that can constitute the message. For instance, in *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston*, the Supreme Court held that parade organizers’ decisions regarding which groups (and therefore which messages) to include in their parade constituted protected speech.³⁰ Likewise, the Supreme Court suggested at the *Stevens* oral argument that the verbatim reproduction of a dogfight can constitute a message when used by People for the Ethical Treatment of Animals (PETA) or some other organization to show why dogfighting should be banned or when used by another organization to show why dogfighting is a worthwhile sport.³¹

The communicative aspect of copying is most obvious, however, when the copying is done in order to create a new work of authorship,

28. See, e.g., DAVID L. LANGE & H. JEFFERSON POWELL, *NO LAW: INTELLECTUAL PROPERTY IN THE IMAGE OF AN ABSOLUTE FIRST AMENDMENT* (2009); NEIL WEINSTOCK NETANEL, *COPYRIGHT’S PARADOX* (2008); Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354 (1999); Paul Goldstein, *Copyright and the First Amendment*; 70 COLUM. L. REV. 983 (1970); Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147 (1998); Lawrence Lessig, *Lecture, Copyright’s First Amendment*, 48 UCLA L. REV. 1057 (2001); Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1 (2001); Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180 (1970); Jed Rubenfeld, *The Freedom of Imagination: Copyright’s Constitutionalality*, 112 YALE L.J. 1 (2002); Rebecca Tushnet, *Copy this Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535, 546 (2004); Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 LIQUORMART, and Bartnicki, 40 HOUS. L. REV. 697 (2003); Christina Bohannon, *Copyright Infringement and Harmless Speech*, 61 HASTINGS L.J. (forthcoming 2010), available at <http://ssrn.com/abstract=1367624> [hereinafter Bohannon, *Harmless Speech*].

29. See Tushnet, *supra* note 28, at 546 (arguing that emphasis on transformativeness inquiry has “limited our thinking” about fair use and that pure copying also advances First Amendment values); Volokh, *supra* note 28, at 726 (arguing that copied speech has as much First Amendment value to listeners as original speech); Bohannon, *Harmless Speech*, *supra* note 28, at nn. 180-88 and accompanying text (arguing that copying serves First Amendment goals of protecting autonomy and marketplace of ideas).

30. 515 U.S. 557, 572-73 (1995) (“Since every participating unit affects the message conveyed by the private organizers, the state courts’ application of the statute produced an order essentially requiring petitioners to alter the expressive content of their parade.”); see also *Miami Herald Publ’g Co. v. Tornillo*, 418 U.S. 241, 258 (1974) (newspaper’s editing of others’ speech for inclusion in paper is First Amendment speech).

31. See *infra* note 46 and accompanying text.

or a derivative work. By statutory definition, a derivative work is one that changes the form of an existing work or “modifies, transforms, or adapts” the work in some way.³² When a person “modifies, transforms, or adapts” a copyrighted work, he or she nearly always adds original expression, and such original expression constitutes speech.³³

The more difficult question is whether copying constitutes *protected* speech. If copying is harmful speech like defamatory statements or fighting words, then it might not be protected under the First Amendment.³⁴ The Supreme Court has held that copyright law and the First Amendment are compatible because the Framers intended for copyright law to be “the engine of free expression” by providing economic incentives to create and disseminate works of authorship.³⁵ If copying harms those incentives, then it is detrimental to both copyright and First Amendment values and might not be protected. Thus, there are potential speech interests on both sides of copyright infringement cases.³⁶

To the extent that copyright protection prohibits copying that does *not* reduce copyright holders’ incentives to produce copyrighted works, it stifles downstream creativity without furthering the constitutional interests underlying either copyright law or the First Amendment.³⁷ Thus, the fact that copyright law plays a role in

32. See 17 U.S.C. § 101 (2006) (definition of “derivative work”).

33. Even scholars who do not believe that the First Amendment protects verbatim copying have argued that the First Amendment should protect transformative copying. See, e.g., NETANEL, *supra* note 28, at 45-46 (arguing that transformative copying is communicative whereas most verbatim copying is not); Rubinfeld, *supra* note 28, at 48-52 (arguing that the First Amendment protects “freedom of imagination” and therefore applies only where the user of a copyrighted work adds original expression to the work); Symposium, *Copyright and Freedom of Expression*, 30 COLUM. J.L. & ARTS 319, 330 (2007) (arguing that pure copying does not constitute First Amendment speech and that First Amendment applies only to those cases, like transformative copying, “that do involve expression of the infringer”).

34. *United States v. Stevens*, 533 F.3d 218, 224 (3d Cir. 2008) (listing categories of speech previously held to be unprotected).

35. See *Eldred v. Ashcroft*, 537 U.S. 186, 218-20 (2003).

36. See David McGowan, *Why the First Amendment Cannot Dictate Copyright Policy*, 65 U. PITT. L. REV. 281, 295-96 (2004) (arguing that First Amendment scrutiny does not help to resolve copyright infringement cases because “First Amendment values are on both sides”).

37. Bohannon, *Harmless Speech*, *supra* note 28, at 33:

Copyright law is consistent with the First Amendment to the extent that copyright law encourages free expression by granting exclusive rights over expressive works. But as we have seen, copying—even a good deal of copying that violates a copyright holder’s rights—also has speech value. Insofar as copyright law prohibits copying that does *not* diminish a copyright holder’s incentives to create or distribute expressive works, it prohibits or chills some speech without providing offsetting gains to speech elsewhere. Such cases present false conflicts between copyright law and the First Amendment, where there is a speech interest in allowing the copying but no copyright (or speech) interest in prohibiting it.

enhancing speech should not render copied speech completely unprotected or displace First Amendment scrutiny altogether. Instead, courts should assess whether a defendant's copying is likely to harm the government interest underlying copyright law, i.e., whether the defendant's copying is likely to reduce a copyright holder's incentives to create and disseminate copyrighted works.³⁸ As will be shown herein, derivative uses are exactly the kind of uses that often add new expression without causing any demonstrable harm to those incentives.³⁹ As a result, the Copyright Act's protection against such uses must be subject to First Amendment concerns about overbreadth and vagueness in speech regulations.

B. Copyright's Derivative Works Right Is Excessively Broad

A law is unconstitutionally overbroad if, while permissibly regulating some speech or conduct, it also regulates substantially more speech than the Constitution allows. In *City Council of Los Angeles v. Taxpayers for Vincent*, the Supreme Court held that "substantial overbreadth" will cause a statute to be invalidated.⁴⁰ Although acknowledging that "substantial overbreadth is not readily reduced to an exact definition," the Court explained that it is not enough "that one can conceive of some impermissible applications."⁴¹ Rather, "there must be a realistic danger that the statute itself will significantly compromise recognized First Amendment protections of parties not before the Court."⁴² Following this rule, the Court has refused to find substantial overbreadth in cases where a statute's prohibitions of protected speech do not "amount to more than a tiny fraction of the materials within the statute's reach."⁴³ By contrast, a statute is constitutionally overbroad if it is "susceptible of regular application to protected expression."⁴⁴

38. See *id.* ("First Amendment scrutiny mediates between the speech interests 'on both sides' by requiring courts to determine in each case whether the defendant's particular use is likely to cause harm to the incentives to create or distribute copyrighted works.").

39. See *infra* Part I.B.

40. 466 U.S. 789, 800-01 (1984) (upholding municipal ordinance that made it unlawful to post signs on public property).

41. *Id.* at 800.

42. *Id.* at 801.

43. See, e.g., *New York v. Ferber*, 458 U.S. 747, 773 (1982) (upholding state law prohibition on child pornography despite statute's occasional application to material with serious literary, scientific, or educational value).

44. *City of Houston v. Hill*, 482 U.S. 451, 467 (1987) (invalidating ordinance that prohibited interrupting police officers engaged in performing their official duties).

Under both the dogfighting statute and the Copyright Act's derivative works right, the category of prohibited speech is very broad. The dogfighting statute defined the prohibited "depiction of animal cruelty" as

[A]ny visual or auditory depiction, including any photograph, motion-picture film, video recording, electronic image, or sound recording of conduct in which a living animal is intentionally maimed, mutilated, tortured, wounded, or killed, if such conduct is illegal under Federal law or the law of the State in which the creation, sale or possession takes place.⁴⁵

As some members of the Court pointed out at oral argument, this language was broad enough to prohibit depictions of bullfighting and hunting even though the underlying conduct was lawful where performed.⁴⁶ Thus, the prohibitions on speech were broader than necessary to achieve the legitimate purpose of preventing unlawful cruelty to animals. Indeed, Justice Kennedy observed that "without the exceptions clause," the statute "would be wildly overbroad."⁴⁷

Likewise, the Copyright Act's prohibition on preparing derivative works is excessively broad. The derivative works right prohibits preparing new works "based upon the copyrighted work, including a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted."⁴⁸ As Judge Kozinski of the Ninth Circuit has observed of the derivative works right definition, "[t]he statutory language is hopelessly overbroad, . . . for [e]very book in literature, science and art, borrows and must necessarily borrow, and use much which was well known and used before."⁴⁹

By its terms, the derivative works right definition does not actually require that the defendant incorporate any copyrightable expression, but only that the defendant's work is "based on an existing copyrighted work."⁵⁰ The statute also does not define many of the illustrative examples of derivative works such as "fictionalization" or "dramatization."⁵¹ Given that a derivative work must only be "based

45. 18 U.S.C. § 48(c)(1) (2006).

46. Transcript of Oral Argument at 10-11, Stevens, 2010 WL 1540082 (No. 08-769).

47. *Id.* at 15.

48. 17 U.S.C. § 106(2).

49. *Micro Star v. FormGen Inc.*, 154 F.3d 1107, 1110 (9th Cir. 1998) (quoting *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436)); *see also* 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 3.01 (LexisNexis 2009).

50. *See* 17 U.S.C. § 101 (2006) (definition of "derivative work").

51. *See* 17 U.S.C. § 101 (enumerating examples of derivative works but failing to provide accompanying definitions).

on” an existing work and that it gives the copyright holder the exclusive right of “fictionalization,” the derivative works right would seem to prohibit taking facts from a non-fiction historical work and making a fictional work out of them. Under this interpretation, Dan Brown’s *The Da Vinci Code* would infringe the historical work *Holy Blood, Holy Grail*, even if it took no copyrighted expression.⁵² Yet, under the idea/expression dichotomy, codified at § 102(b), ideas and facts are not copyrightable; only the author’s expression may be copyrighted. Some judicial decisions have attempted to resolve this ambiguity by applying a narrowing interpretation that limits the derivative works right to uses that actually incorporate copyrighted expression.⁵³

In addition to giving copyright holders the exclusive right to convert a copyrighted work into many different forms and media, the derivative works definition includes catch-all language giving copyright holders the exclusive right over “any other form in which [their] work may be recast, transformed, or adapted.”⁵⁴ Arguably, this is the most troublesome part of the definition. The illustrative examples in the statutory definition of derivative works are the most foreseeable types of derivative works—clearly, those are the ones that Congress (and the interest groups that assisted in drafting the derivative works right) anticipated.⁵⁵ By contrast, the catch-all language, as it has been interpreted, applies not only to new forms of the copyright holder’s own expression but also to the use of copyrighted expression in the preparation of new works of authorship with new meaning or message.⁵⁶ Thus, the catch-all language is broad

52. Dan Brown was sued in England for breach of copyright by the authors of *Holy Blood, Holy Grail*, who claimed “Brown copied their book’s central theme.” *Court Rejects Da Vinci Copy Claim*, BBC News, Apr. 7, 2006, <http://news.bbc.co.uk/2/hi/entertainment/4886234.stm>. The London High Court found no breach of copyright even though Brown “did use the previous book to write certain parts of [the *Da Vinci Code*]”—namely, the idea that “Jesus and Mary Magdalene had a child and the bloodline survives to this day.” *Id.* Brown opined that a novelist “must be free to ‘draw appropriately’ from historical works”—or at least from works that claim to be historical or factual. *Id.*

53. See *Micro Star*, 154 F.3d at 1110 (citing *Litchfield v. Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1984), for rule that violation of derivative works right requires substantial incorporation of copyrighted expression).

54. 17 U.S.C. § 101.

55. *Id.* (specifying the following examples: “translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation”).

56. See *Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.*, 150 F.3d 132, 145–46 (2d Cir. 1998) (finding that a *Seinfeld* show trivia book infringed television show); *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997) (affirming preliminary injunction where defendants wrote “Cat NOT in the HAT” about the O.J. Simpson trial which “broadly mimic[ked] Dr. Seuss’ characteristic style”).

enough to apply to a number of other kinds of works, including guide books, trivia books, satires, parodies, etc. Copyright holders are often not in a good position to produce these kinds of works because they would not be a credible source of works critical to their own in the marketplace. Indeed, they are often unwilling to produce these kinds of works, and are unable to see the myriad of ways in which someone might innovate on the content of their works.⁵⁷ As a result, the derivative works language prohibits uses from which copyright holders ordinarily do not expect to profit, which means that it prohibits uses from which copyright holders do not derive any incentive to create their works. Indeed, as Judge Posner has observed, many of these uses actually enhance the copyright holder's sales and are therefore complements rather than substitutes.⁵⁸ As such, copyright law prohibits uses that are very unlikely to harm a copyright holder's incentives to produce the original work or foreseeable derivative works. Such a broad statutory prohibition is overbroad with regard to copyright's legitimate purpose.

It should be noted that most, if not all, of the foregoing critique regarding the scope of the derivative works right applies equally to the reproduction right. The reproduction right generally prohibits the copying of copyrighted expression.⁵⁹ There is substantial overlap between the reproduction right and the derivative works right because copying done in order to create a derivative work also violates the reproduction right.⁶⁰ In light of this overlap, it might seem a mistake to attribute too much independent significance to the derivative works right.

57. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 572–73 (1994) (noting that the copyright owner refused to license its work to a rap music group for purposes of parody); *Bridgeport Music, Inc. v. UMG Recordings, Inc.*, 585 F.3d 267, 272, 275–76 (6th Cir. 2009) (finding infringing use in hip-hop artist's sampling of certain elements of the original funk song, including "repetition of the word 'dog' in a low tone of voice at regular intervals"); *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 802 (9th Cir. 2003) (recognizing Mattel's extensive efforts to create an "impressive marketing success" in Barbie but dismissing Mattel's assertions that the parodist could have made the same social commentary without using Barbie).

58. See, e.g., *Ty, Inc. v. Publ'ns Int'l Ltd.*, 292 F.3d 512, 517–19 (7th Cir. 2002) (holding that uses that increase sales of original work, or economic complements, are generally fair while uses that supplant sales of original work, or economic substitutes, are generally not fair); see also Christina Bohannon, *Copyright Harm, Foreseeability, and Fair Use*, 85 WASH. U. L. REV. 969, 1028–29 (2007) (citing anecdotal evidence of derivative works that increase sales, sometimes dramatically, of original works on which they are based) [hereinafter Bohannon, *Foreseeability*].

59. 17 U.S.C. § 106(1) (2006).

60. H.R. REP. NO. 94-1476, at 62, reprinted in 1976 U.S.C.C.A.N. at 5675 ("The exclusive right to prepare derivative works . . . overlaps the exclusive right of reproduction to some extent . . . [T]o constitute a violation of [the derivative works right], the infringing work must incorporate a portion of the copyrighted work in some form."); see also *Montgomery v. Noga*, 168 F.3d 1282, 1292 (11th Cir. 1999) (quoting House Report).

Yet, the derivative works right expands the scope of copyright protection in two very important ways. First, it has an expansive effect on the scope of the reproduction right. One articulation of the standard for infringement of the reproduction right is that infringement occurs when, in comparing the defendant's allegedly infringing work to the copyright holder's original work, "the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same."⁶¹ When a defendant has changed a copyrighted work and added his or her own expression, an ordinary observer might perceive that the aesthetic appeal of the resulting work is not the same as that of the original work. Yet, the derivative works right essentially precludes taking account of such differences by giving the copyright holder the exclusive right to "modify, transform, or adapt" the copyrighted work. As such, it lowers the threshold of overall similarity that can constitute a prima facie violation of the reproduction right.⁶² This effect is perhaps best understood by observing that, under earlier versions of the Copyright Act, which contained a reproduction right but no derivative works right, new works that borrowed from existing copyrighted works were not deemed infringing when they also contained new material sufficient to render them new works of authorship.⁶³

Second, the derivative works right affects fair use analysis in a way that tends to shrink the scope of fair use protection for transformative works. The fourth factor of fair use considers the effect of the defendant's copying on the market for the copyrighted work.⁶⁴ But, what constitutes the "market" for the copyrighted work is a moving target. Courts have to decide which markets the copyright holder is entitled to control. For instance, the Supreme Court has said that the fourth factor takes into account harm to markets that the

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

62. See, e.g., *Horgan v. Macmillan, Inc.*, 789 F.2d 157, 162-63 (2d Cir. 1986) (lower court held that unauthorized photographs did not infringe copyrighted choreography because still photographs cannot take the "flow" of the choreography, but Second Circuit reversed and remanded for a determination of whether there was "substantial similarity" between the photographs and the choreography without regard to whether the differences in medium made it impossible to recreate the choreography from the still photographs).

63. See BENJAMIN KAPLAN, *AN UNHURRIED VIEW OF COPYRIGHT 10* (1966) (in late eighteenth and early nineteenth centuries, the rule for infringement was that if the allegedly infringing work was itself deemed "a work of authorship, it could not at the same time infringe"); John Tehranian, *Et Tu, Fair Use? The Triumph of Natural-Law Copyright*, 38 U.C. DAVIS L. REV. 465, 466 (2005) (early copyright law did not "preclude[] transformative uses of a protected work because such uses were considered accretive to progress in the arts.").

64. See 17 U.S.C. § 107 (2006).

copyright holder “would in general develop or license others to develop,”⁶⁵ while the Second Circuit has described those markets as “traditional, reasonable, or likely to be developed markets.”⁶⁶ Moreover, the fourth factor “enquiry ‘must take account not only of harm to the original [work] but also of harm to the market for derivative works.’”⁶⁷ Thus, the derivative works right expands the type and number of markets that the copyright holder is entitled to control, making it more likely that a defendant’s copying will be deemed to supplant one of those markets. For these reasons, although the reproduction right covers most of the uses that the derivative works right covers, the derivative works right plays a significant role in defining the universe of speech that is regulated under the Copyright Act. Thus, the excessively broad copyrights that result require First Amendment scrutiny.

C. Copyright’s Fair Use Doctrine is Vague

A third similarity between the dogfighting statute and the Copyright Act is that both statutes have relied to a large extent on an exceptions clause to save the statute from unconstitutionally prohibiting protected speech.⁶⁸ The dogfighting statute stated that its prohibition on depictions of animal cruelty “does not apply to any depiction that has serious religious, political, scientific, educational, journalistic, historical, or artistic value.”⁶⁹ In *Stevens*, the Third Circuit expressed concern over using an affirmative defense to save an otherwise overbroad statute from being held unconstitutional: “In the free speech context, using an affirmative defense to save an otherwise unconstitutional statute presents troubling issues. ‘The Government raises serious constitutional difficulties by seeking to impose on the defendant the burden of proving his speech is not unlawful.’”⁷⁰ While the parties agreed that the statute had been interpreted as requiring the Government to bear the burden of proving that a depiction of animal cruelty did *not* fall within the exceptions clause of the statute, the court observed that “the legislative history of the statute specifically states that [t]he defendant bears the burden of proving

65. *Campbell*, 510 U.S. at 592.

66. *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 930 (2d Cir. 1994).

67. *Campbell*, 510 U.S. at 590 (quoting *Harper & Row Pubs., Inc. v. Nation Enters.*, 471 U.S. 539, 568 (1985)); *see also SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1274 (11th Cir. 2001) (same).

68. *See supra* Introduction.

69. 18 U.S.C. § 48(b) (2006).

70. *United States v. Stevens*, 533 F.3d 218, 231 n.13 (3d Cir. 2008).

the value of the material by a preponderance of the evidence.”⁷¹ The court stated that “[v]iewing the exceptions clause as an affirmative defense poses an even greater threat to chill constitutional speech than the interpretation of § 48 offered by the Government in this case.”⁷²

It is particularly problematic to rely on an affirmative defense to protect speech when the scope of the defense is vague. In the *Stevens* oral argument, Justice Kennedy emphasized to the Government the importance of the vagueness determination as applied to that statute’s exceptions clause: “This statute without the exceptions clause would be wildly overbroad. So you say it’s not overly broad because of the exception or the savings clause. . . . But it seems to me that the exceptions must be then tested as to whether or not they are vague.”⁷³ Additionally, several of the Justices pressed the government on how to draw the line between what the exception clause protected and what it did not. They asked, for instance, whether any video depiction of bullfighting would have historical value and whether any depiction of animal cruelty could be perceived as a political statement advocating either for or against such cruelty.⁷⁴ As Justice Breyer said, the point is that “people have to understand it because they have to know what to do to avoid the risk of being prosecuted.”⁷⁵

Justice Breyer’s statement succinctly describes the void-for-vagueness doctrine under which a law is unconstitutionally vague if ordinary people cannot understand what the law permits and what it prohibits.⁷⁶ Because the void-for-vagueness doctrine is grounded in due process, unnecessarily vague laws will often be held invalid

71. *Id.* (quoting H.R. REP. NO. 106-397, at 8 (1999)).

72. *Id.*

73. Transcript of Oral Argument at 15, *Stevens*, 2010 WL 1540082 (No. 08-769).

74. For instance, at oral argument, Justice Roberts asked the following regarding the dogfighting videos:

How can you tell these aren’t political videos? You do have, with organizations, PETA and others, depictions of the same sort of animal cruelty that is used to generate support for efforts to prohibit it. Why aren’t these videos the exact opposite, you know, efforts to legalize it, and, in each case, it would fall under the political exemption?

Id. at 8.

75. *Id.*

76. See *United States v. Williams*, 553 U.S. 285, 304 (2008) (statute is unconstitutionally vague if it “fails to provide a person of ordinary intelligence fair notice of what is prohibited, or is so standardless that it authorizes or encourages seriously discriminatory enforcement”); *Kolender v. Lawson*, 461 U.S. 352, 357 (1983) (a law must be written “with sufficient definiteness that ordinary people can understand what conduct is prohibited”); *Connally v. Gen. Constr. Co.*, 269 U.S. 385, 391 (1926) (a law is unconstitutionally vague if people “of common intelligence must necessarily guess at its meaning”).

whether or not they regulate speech.⁷⁷ When it comes to laws that regulate speech, courts are particularly wary of vagueness because of a concern that vague laws will chill protected speech.⁷⁸ The Supreme Court has observed that the threat of punishment or liability can be a powerful deterrent to the exercise of free speech, and “[b]ecause First Amendment freedoms need breathing space to survive, government may regulate in the area only with narrow specificity.”⁷⁹

Similar concerns surrounding the threat of copyright-infringement liability exist for authors of creative works. The question of what constitutes copyright infringement is notoriously vague.⁸⁰ As an initial matter, *prima facie* infringement depends on the open-ended question of whether the defendant’s allegedly infringing work is “substantially similar” to the copyright holder’s work.⁸¹ The Second Circuit has observed that “[l]ike the analysis of a fair use claim, an inquiry into the substantial similarity between a copyrighted work and the allegedly infringing work must be made on a case-by-case basis, as there are no bright-line rules for what constitutes substantial similarity.”⁸² Thus, the test for infringement of copyright is vague and determinations must be made “ad hoc.”⁸³

Moreover, once a court finds substantial similarity, the defendant might raise fair use as a defense. The fair use doctrine in § 107 of the Copyright Act states that, notwithstanding the copyright holder’s exclusive rights, “the fair use of a copyrighted work, including such use by reproduction in copies of phonorecords or by any other means . . . , for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.” This provision goes on to provide four factors that must be considered in determining whether a use is fair, including:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;

77. *Williams*, 553 U.S. at 304 (“Vagueness doctrine is an outgrowth not of the First Amendment, but of the Due Process Clause . . .”).

78. *NAACP v. Button*, 371 U.S. 415, 432 (1963) (“[S]tandards of permissible statutory vagueness are strict in the area of free expression.” (citations omitted)).

79. *Id.* at 433 (citing *Cantwell v. Connecticut*, 310 U.S. 296, 311 (1940)).

80. *See, e.g., Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (describing infringement test as “vague”).

81. *See, e.g., Saturday Evening Post Co. v. Rumbleseat Press, Inc.*, 816 F.2d 1191, 1198-99 (7th Cir. 1987).

82. *Sandoval v. New Line Cinema Corp.* 147 F.3d 215, 217 (2d Cir. 1998).

83. *Peter Pan*, 274 F.2d at 489.

(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(4) the effect of the use upon the potential market for or value of the copyrighted work.⁸⁴

The fair use doctrine is, if anything, an even poorer vehicle for protecting speech than the exceptions clause of the dogfighting statute. First, as the Third Circuit noted, courts applying the dogfighting statute have put the burden on the Government to show that the exceptions clause does not apply.⁸⁵ By contrast, courts treat fair use as an affirmative defense, even though the language of § 107 simply says that fair use “is not an infringement of copyright” and does not otherwise say or indicate that it is a defense.⁸⁶ Consequently, the alleged copyright infringer bears the burden to show why his speech should be protected. As the Third Circuit observed in *Stevens*, using an affirmative defense to avoid constitutional overbreadth is problematic.⁸⁷ Thus, so long as fair use is treated as an affirmative defense, it seems inappropriate to rely on it too heavily to protect the use of copyrighted expression in speech. Yet, that is what the Supreme Court did in *Eldred v. Ashcroft*.⁸⁸ The *Eldred* Court refused to apply First Amendment scrutiny to the Copyright Term Extension Act, relying instead on copyright’s own “traditional contours,” including the idea/expression dichotomy and fair use doctrine, to protect against speech concerns that might arise from the extended duration of copyright protection.⁸⁹

Second, the statutory terms used in the fair use provision and the dogfighting exceptions provision are strikingly similar, thus raising similar interpretive issues. Under the dogfighting exceptions clause, courts had to determine whether a particular depiction of animal cruelty possessed scientific, educational, journalistic or other value.⁹⁰ Likewise, in applying the fair use provision, courts must consider whether copying was done for research, teaching, news reporting, or similar purposes.⁹¹ Interpreting the scope of these privileged fair use categories has proved challenging, as courts must

84. 17 U.S.C. § 107 (2006).

85. *United States v. Stevens*, 533 F.3d 218, 231 n.13 (2008).

86. 17 U.S.C. § 107; *Campbell*, 510 U.S. at 590.

87. *See supra* notes 80-82.

88. *Eldred*, 537 U.S. 186 (2003).

89. *Id.* at 218-21 (“To the extent such assertions [of the right to use copyrighted material] raise First Amendment concerns, copyright’s built-in speech safeguards are generally adequate to address them. . . . [W]hen, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.” (citations omitted)).

90. 18 U.S.C. § 48(b) (2006).

91. 17 U.S.C. § 107.

assess, for instance, whether copying by a researcher necessarily constitutes research, and whether copying by or for a teacher necessarily falls into the category of teaching. Indeed, except in very limited circumstances, it is impossible to rely on those categories at all because courts frequently find uses of copyrighted material infringing even when they clearly fall within the privileged categories of criticism, comment, news reporting, teaching, scholarship, or research.⁹² Nor are these categories exhaustive of the purposes for which people may make fair use of copyrighted works.⁹³

In large part, this uncertainty arises because § 107 also requires courts to consider the four factors listed above to determine whether the challenged use of a work constitutes a fair use.⁹⁴ Courts have observed that the multi-factor test is vague and leads to unpredictability in fair use cases. For instance, in *Campbell v. Acuff-Rose Music*, which involved the rap group 2 Live Crew's parody of Roy Orbison's song "Pretty Woman," the Supreme Court interpreted the "purpose and character" factor as affording greater protection for parody than for satire,⁹⁵ but as the Eleventh Circuit has observed, "the Supreme Court's definition of parody in *Campbell* . . . is somewhat vague."⁹⁶ Indeed, the *Campbell* Court itself acknowledged that there is no bright line between parody and satire.⁹⁷ Although it distinguished between parody and satire by defining parody as commentary on a particular work and satire as broader social commentary, the Court conceded that "parody often shades into satire

92. Oftentimes, courts reach the conclusion that a use falling within one of the privileged categories is still infringing by purporting to look not at the general purpose of the use but at the more specific or immediate purpose. For instance, the *Texaco* court said that, although Texaco employees used copies of journal articles for scientific research, the more immediate purpose was simply to have archival copies in individual researchers' offices. See *Texaco*, 60 F.3d at 924-25. Similarly, the *Harper & Row* Court said that, although *The Nation* magazine used the memoirs in the course of news reporting generally, its more specific purpose was to "scoop" pre-publication excerpts of the memoirs from *Time* magazine, which had paid for the exclusive right to run the story. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 544, 568-69 (1985).

93. See, e.g., *Campbell*, 510 U.S. at 577 (fair use categories have an "illustrative and not limitative function" (internal citations omitted)); *Ringgold v. Black Entmt. Television, Inc.*, 126 F.3d 70, (2d Cir. 1997) (same).

94. 17 U.S.C. § 107.

95. *Campbell*, 510 U.S. at 580-81 (reasoning that parody of a particular copyrighted work necessitates borrowing from the original work while social satire "can stand on its own two feet").

96. *SunTrust*, 268 F.3d at 1268 ("On the one hand, the [*Campbell*] Court suggests that the aim of parody is 'comic effect or ridicule,' but it then proceeds to discuss parody more expansively in terms of its 'commentary' on the original." (quoting *Campbell*, 510 U.S. at 580)).

97. *Campbell*, 510 U.S. at 580-81.

when society is lampooned through its creative artifacts.”⁹⁸ Moreover, “[a]s vague, broad and far reaching as these [four] factors are, the Supreme Court has noted that they are not exclusive and that the fair use doctrine is an ‘equitable rule of reason.’”⁹⁹ Courts even inject a good faith requirement occasionally, despite the absence of any mention of good faith in the statute.¹⁰⁰ Thus, “no generally applicable definition [of fair use] is possible, and each case raising the question must be decided on its own facts.”¹⁰¹ As a result, “[t]he search for a coherent, predictable interpretation applicable to all cases remains elusive,”¹⁰² and authors of creative works are left with a vague standard incapable of predicting a priori whether use of an existing work will be deemed a fair use.

As one might expect with such a vague doctrine, outcomes under the fair use doctrine are very unpredictable. In the last three major Supreme Court fair use cases, the judgments were reversed at every level. In *Harper & Row Publishers v. The Nation Enterprises*, a case involving the unauthorized use of unpublished memoirs in a news magazine, the district court found no fair use; the Second Circuit found fair use and reversed; and the Supreme Court found no fair use and reversed again.¹⁰³ *Sony Corp. v. Universal City Studios* involved a fair use claim for the home videotaping of television programs.¹⁰⁴ There, the district court found fair use; the Ninth Circuit found no fair use and reversed; and the Supreme Court found fair use and reversed again.¹⁰⁵ Similarly, in *Campbell*, the district court found fair use; the Sixth Circuit found no fair use and reversed; and the Supreme Court found likely fair use, reversed, and remanded.¹⁰⁶

98. *Id.* at 581.

99. *Am. Geophysical Union v. Texaco Inc.*, 802 F. Supp. 1, 11 (S.D.N.Y. 1992) (quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990)).

100. Compare *Harper & Row*, 471 U.S. at 562 (“Fair use presupposes good faith and fair dealing.” (internal quotations and citation omitted)), with *Campbell*, 510 U.S. at 585 n.18 (citing conflicting authorities as to whether good faith is relevant to fair use analysis but holding that even if good faith is a factor, the fact that the defendant proceeded to use copyrighted material after requesting and being denied permission is not indicative of bad faith).

101. *Harper & Row*, 471 U.S. at 560; see also *Wright v. Warner Books, Inc.*, 953 F.2d 731, 740 (2d Cir. 1991) (“The fair use test remains a totality inquiry, tailored to the particular facts of each case.”).

102. *Basic Books, Inc. v. Kinko’s Graphics Corp.*, 758 F. Supp. 1522, 1530 (1991) (describing disagreement among “[c]ourts and commentators . . . on the interpretation and application of the four factors”).

103. *Harper & Row*, 471 U.S. at 543-46 (describing procedural history of case).

104. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 420 (1984).

105. *Id.* at 420-21 (describing procedural history of case).

106. *Campbell*, 510 U.S. at 572 (describing procedural history of case).

The problem with fair use is not simply that there are hard cases in which it is difficult to determine whether a use is infringing or fair. The uncertainty that comes in applying a law to difficult facts can arise under the clearest of legal standards and is not what renders a statute unconstitutionally vague.¹⁰⁷ Fair use is vague because no one knows conceptually or definitionally what fair use is or is supposed to be. As Professor Barton Beebe has noted, “we continue to lack any systematic, comprehensive account of our fair use case law.”¹⁰⁸

Other scholars have noted that this vagueness is likely to deter uses of copyrighted works. Shyamkrishna Balganesh has argued that “[t]he uncertainty of the standard, if anything, is likely to deter potential users . . . from treading too close to the boundaries of impermissible copying.”¹⁰⁹ Likewise, David Fagundes has observed: “Fair use thus epitomizes the muddied entitlement, and this uncertainty has skewed the scope of the defense in favor of owners at the expense of users. . . . The predictable result is overdeterrence, as users tend to wilt in the face of threats of liability, however dubious.”¹¹⁰ Along the same lines, Jason Mazzone has explained that

The failure of Congress and of the courts to provide clear guidance on the meaning of fair use permits copyright owners to leverage the vagueness of the law and persuade prospective users that virtually any unauthorized use constitutes copyright

107. See *United States v. Williams*, 553 U.S. 285, 305-06 (2008).

108. Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005*, 156 U. PA. L. REV. 549, 552-53 (2008) (arguing that empirical study of all copyright cases indicates that while “leading cases” approach to fair use might be problematic, “as a whole, the mass of nonleading cases has shown itself to be altogether worthy of being followed”). This uncertainty has prompted some commentators to argue that the existing vague standards might be replaced by or supplemented with bright-line rules or presumptions for particular kinds of uses. See David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. REV. 139, 178 (2009) (arguing for “crystallizing fair use by incorporating determinate benchmarks for legitimate takings [through] a fairly straightforward formula: take standards, and replace them with rules”); Gideon Parchomovsky & Kevin A. Goldman, *Fair Use Harbors*, 93 VA. L. REV. 1483, 1484-91 (2007) (noting that fair use is unpredictable and suggesting nonexclusive, bright-line rules defining per se fair uses); Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537, 2587 (2009) (“Uncertainties about the scope of fair use for learning-related purposes have led to some efforts to develop fair use guidelines for common educational and research uses.”).

109. Shyamkrishna Balganesh, *Foreseeability and Copyright Incentives*, 122 HARV. L. REV. 1569, 1620 (2009) (stating that “[f]ew argue that fair use needs to be eliminated because its contextual ex post uncertainty interferes with creator incentives”).

110. Fagundes, *supra* note 108, at 152 (explaining that users are overdeterred by uncertainty in the fair use doctrine because “[d]irect copyright infringement remains a strict liability offense, and even a relatively minor unauthorized use can result in major liability if the owner has registered the work and chooses to claim statutory damages”).

infringement-and that if the use is not paid for it will result in a lawsuit and substantial damages.¹¹¹

This vagueness and uncertainty can have an enormous chilling effect on the broad category of speech that incorporates and builds on copyrighted material.¹¹² Given this state of affairs, individual authors, as well as other intermediaries such as publishers and copyshops, cannot tell which uses are infringing and which ones are fair.¹¹³ As such, copyright law is a prime example of impermissible speech regulation: it is vagueness in the extreme, the antithesis of “narrow specificity,” and a serious threat to breathing space for free expression.

II. REDUCING OVERBREADTH AND VAGUENESS IN THE COPYRIGHT ACT

A. *The Supreme Court’s Reluctance to Apply First Amendment Scrutiny to Copyright Law*

The Supreme Court’s *Eldred* decision masks the problems of overbreadth and vagueness that exist in copyright law today by obviating the kind of First Amendment analysis that would bring these problems to light. The decision makes it very unlikely that courts will subject the derivative works right to direct First Amendment scrutiny. The Court held that so long as traditional contours including the idea/expression dichotomy and fair use doctrine are preserved, heightened First Amendment scrutiny is inapplicable.¹¹⁴ In light of the foregoing discussion, this is a particularly perverse ruling because it seems to require maintaining the status quo of fair use in all of its vagueness. Without heightened

111. Jason Mazzone, *Administering Fair Use*, 51 WM. & MARY L. REV. 395, 398 (2009) (proposing an administrative agency to review copyright infringement and fair use issues according to Congressional regulations).

112. Mazzone has argued that “[f]air use law . . . exists at one extreme as a body of vague statutory language,” and that because “[n]either Congress nor the courts have supplied sufficient clarity to guide prospective users of copyrighted works,” the resulting uncertainty causes tension with First Amendment principles. *Id.* at 401.

113. Given the potential damages from copyright liability, they will either forgo the use of the copyrighted work—which will often mean forgoing altogether the creation of a new work—or pay a license fee to avoid the risk of litigation. This licensing then becomes proof in later cases of the copyright holders’ entitlement to control these uses, which leads to de facto larger reproduction and derivative works rights than the statute actually provides. See James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property*, 116 YALE L.J. 882 (2007) (risk aversion in users of copyrighted works leads to licensing for non-infringing uses, and evidence of licensing reinforces subsequent arguments that the copyright holders are entitled to control those uses); see also Mazzone, *supra* note 111 (discussing ability of copyright holders “to leverage the vagueness” of fair use to obtain license fees).

114. *Eldred*, 537 U.S. at 218-21.

First Amendment scrutiny, the Copyright Act will be treated as ordinary economic legislation, subject only to rational basis review.¹¹⁵ The Court indicated that how much copyright protection is necessary or reasonable is an economic judgment best left to Congress because there is no clear evidence of how much copyright protection is optimal.¹¹⁶

Arguably, the derivative works right, along with recent developments in fair use doctrine, are sufficiently different from the Copyright Term Extension Act (CTEA) at issue in *Eldred* to warrant different First Amendment treatment. Although the *Eldred* Court did not apply heightened First Amendment scrutiny to the CTEA, the Court was careful to say that copyright law is not “categorically immune” from First Amendment scrutiny.¹¹⁷ Furthermore, the two reasons the Court gave for not applying heightened First Amendment scrutiny to the CTEA are not as persuasive when applied to the derivative works right. These two reasons are: (1) copying is not the same thing as speaking—when people copy others’ speeches, they are not afforded the same First Amendment protection as if they were speaking themselves;¹¹⁸ and (2) the CTEA extended the *duration* of protection but not the *scope* of protection, and therefore did not change the traditional contours of copyright, including the idea/expression dichotomy and fair use.¹¹⁹

The derivative works right demands greater First Amendment scrutiny because it prohibits speaking as well as copying. As currently interpreted, the right applies even when the copyist adds sufficient new expression to create a new work that does not compete with the original work.¹²⁰

115. *Id.* at 204-05, 205 n.10.

116. *Id.* at 205-08 (“In sum, we find that the CTEA is a rational enactment; we are not at liberty to second-guess congressional determinations and policy judgments of this order, however debatable or arguably unwise they may be.”).

117. *Id.* at 221 (disagreeing with D.C. Circuit’s statement that copyright law is “categorically immune from challenges under the First Amendment” (quoting *Eldred v. Reno*, 239 F.3d 372, 375 (D.C. Cir. 2001))).

118. *Id.* (“The First Amendment securely protects the freedom to make—or decline to make—one’s own speech; it bears less heavily when speakers assert the right to make other people’s speeches.”).

119. *Id.* at 220 (explaining that the CTEA extends the scope of copyright but “supplements these traditional First Amendment safeguards” by providing additional limited exemptions for certain businesses and institutions using copyrighted material).

120. See, e.g., *New Line Cinema Corp. v. Bertlesman Music Group, Inc.*, 693 F.Supp. 1517, 1529-30 (S.D.N.Y. 1988) (granting preliminary injunction where defendant’s music video “Nightmare on My Street” did not compete with plaintiff’s movie “Nightmare on Elm Street” but did compete with plaintiff’s derivative work in the market for rap music videos).

Moreover, the derivative works right alters the scope of copyright protection. The extent to which the derivative works right alters the traditional contours of copyright under *Eldred* might depend on what time period in copyright's history is considered copyright's "traditional" baseline.¹²¹ Under the first Copyright Act, enacted in 1790, it seems that copyright did not protect derivative uses at all but only protected the copying and sale of the original copyrighted work in its original form.¹²² As Professor Lawrence Lessig has argued,

If I took your novel and made a play based upon it, or if I translated it or abridged it, none of those activities were regulated by the original [1790] copyright act. . . . It is this derivative right that would seem most bizarre to our framers, though it has become second nature to us.¹²³

Other scholars such as Benjamin Kaplan have argued that as of the early 1800's, the rule continued to be that if the defendant's work added new material sufficient to be considered a new work of authorship, it would not be deemed infringing.¹²⁴ Indeed, the *Folsom v. Marsh* decision of 1841 shows that as of that time, the question of whether abridgements infringed was still a difficult one.¹²⁵

Beginning in 1870, Congress enacted a series of amendments that added rights over specific derivative uses such as dramatizations and translations.¹²⁶ What is different about the derivative works right in the current Copyright Act is that it does not apply only to abridgements, translations, and other forms of the copyrighted work. It also applies to derivative works that are different in their nature, purpose, or message.¹²⁷ With regard to First Amendment concerns, this expansion represents a fundamental shift in copyright. For one thing, by creating liability for new works of authorship, the derivative works right clearly prohibits new speech, not just slavish copying.

121. It should be noted that the use of a "traditional" baseline for fair use or for copyright generally is particularly perverse given that copyright is forward-looking in its purpose to encourage innovation. The forms that copyrighted expression take today are much different than they were even 50 years ago, let alone at the time of enactment of the earliest copyright laws. It is not clear how effective a traditional approach can be for regulating digital content or the Internet, for example.

122. Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124, 124.

123. LAWRENCE LESSIG, *FREE CULTURE* 138 (2004).

124. See KAPLAN, *supra* note 63.

125. *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841) (No. 4,901) (listing four factors, which later formed the basis of the modern fair use doctrine, that must be considered in determining whether an abridgement of copyrighted materials was infringing).

126. See, e.g., Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212 (giving copyright owners only "the right to dramatize or to translate their own works") (repealed 1952).

127. See, e.g., *SunTrust*, 268 F.3d 1257 (derivative work involving unauthorized parodic sequel to *Gone With the Wind*),

What is more, because the content of these derivative works differs substantially from the original works on which they are based, copyright holders are often unlikely to foresee these uses or rely on the ability to control these uses in deciding whether to create or disseminate the copyrighted work. Because these uses fall outside copyright holders' anticipated markets, it seems very unlikely that allowing such derivative uses will decrease the copyright holders' incentives to produce copyrighted works. Put another way, it seems very unlikely that allowing these uses will harm the government's speech-enhancing purpose in enforcing copyright law.

Eldred's traditional contours approach is incapable of addressing the enormous First Amendment concerns arising from copyright law and produces a good deal of confusion besides. The main problem with this approach is that the scope of copyright protection has been constantly expanding since the first Copyright Act.¹²⁸ As the scope of copyright protection expands, the potential scope of fair use shrinks. Thus, at what point in time should the snapshot of fair use be taken for the traditional baseline? If courts use the fair use doctrine as it was first articulated by Justice Story in 1841, then must the law not also revert to the scope of the reproduction and derivative works rights as they existed at that time? One suspects that many copyright critics would happily make that trade, as the overall scope of copyright protection at that time was more limited than it is today. For example, Justice Story engaged in a lengthy "fair abridgment" (now called "fair use") analysis regarding whether the verbatim copying of hundreds of letters was infringing.¹²⁹ Yet today, this amount of copying would clearly violate the reproduction and derivative works rights, and any claim to fair use would seem preposterous.¹³⁰

Moreover, the fair use doctrine, traditional or modern, cannot adequately protect against overbreadth in the derivative works right because the derivative works right itself creates confusion regarding the scope of fair use. As part of traditional common law fair use analysis, a court would consider things like whether the defendant's

128. See *infra* notes 132-36.

129. See *Folsom*, 9 F. Cas. at 345. Although the copied letters comprised approximately one-third of the defendant's work, Justice Story observed that the defendant had "produced an exceedingly valuable book" and had "selected only such materials, as suited his own limited purpose as a biographer." *Id.* at 348-49. Thus, he expressed "regret" that the finding of infringement "may interfere, in some measure, with the very meritorious labors of the defendants." *Id.* at 349.

130. By way of comparison, in *Harper & Row*, the Supreme Court found infringement and no fair use when the defendant copied approximately 300 words of copyrighted material from the plaintiff's lengthy memoirs. *Harper & Row*, 471 U.S. at 544-45.

use substantially changed the work or instead merely “superseded” the original, and whether the defendant’s use was likely to harm the copyright holder’s expected markets.¹³¹ The 1976 Copyright Act codified those factors in § 107, and the legislative history of the Act confirms that Congress intended to codify the common law of fair use and not to change or reduce fair use protection in any way.¹³² Modern courts applying § 107 have held that “transformative” uses are more deserving of fair use protection because they do not merely “supersede” the original work.¹³³ As previously discussed, however, the derivative works right changes those assessments by giving the copyright holder the exclusive right to “transform” his or her work and adding derivative markets to those that the copyright holder is entitled to control.¹³⁴ In addition, courts recognize as a market harm those licensing fees that the copyright holder might have obtained for the defendant’s particular use, even if the use does not supplant the copyright holder’s existing works.¹³⁵ Courts sometimes recognize this harm even when the defendant’s use is not one that the copyright holder would ordinarily make, and even when the defendant’s use increases sales of the copyright holder’s existing or anticipated works.¹³⁶

B. The Limitations of First Amendment Scrutiny as a Means of Reducing Overbreadth and Vagueness

Even if a court were to apply First Amendment scrutiny, however, it would be unlikely to hold that the Copyright Act is unconstitutional for overbreadth or vagueness. Striking down a

131. See *Folsom*, 9 F. Cas. at 348 (determining fair use requires court to “look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work”).

132. See 17 U.S.C. § 107 (2006); H.R. REP. NO. 94-1476, at 65 (1976).

133. See *Campbell*, 510 U.S. at 579 (“The central purpose of this investigation is to see, in Justice Story’s words, whether the new work merely ‘supersede[s] the objects’ of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is ‘transformative.’” (citations omitted)).

134. See *supra* Part I.B.

135. See *Texaco*, 60 F.3d at 930-31.

136. See *Princeton Univ. Press v. Mich. Document Servs., Inc.*, 99 F.3d 1381, 1386-87 (6th Cir. 1996); *Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc.*, 772 F.2d 505, 511-12 (9th Cir. 1985).

statute for overbreadth is “strong medicine,”¹³⁷ and courts are likely to do it only in extreme cases. In *United States v. Williams*, the Court explained that the overbreadth doctrine “seeks to strike a balance” between the social costs associated with an overbroad statute’s deterrent effect on “the free exchange of ideas” and the social cost of “invalidating a law that in some of its applications is perfectly constitutional.”¹³⁸ Thus, the “statute’s overbreadth must be substantial, not only in an absolute sense, but also relative to the statute’s plainly legitimate sweep.”¹³⁹

Clearly, the Copyright Act is “perfectly constitutional” as applied in many cases.¹⁴⁰ Yet, the Act also seems to be “substantially overbroad” in that it is “susceptible of regular application to protected expression.”¹⁴¹ Given the frequency and extent to which people use copyrighted materials to engage in speech, those applications “amount to more than a tiny fraction of the material’s within the statute’s reach.”¹⁴²

The problem with applying this kind of scrutiny to the Copyright Act is that determining whether the Act is overbroad requires making a determination about its appropriate scope. As the Court indicated in *Eldred*, determining exactly how much copyright protection should be afforded to copyright holders is difficult for Congress, let alone the courts.¹⁴³ Following *Eldred*, it is impossible to see the Court going down the road toward evaluating the Copyright Act for overbreadth and vagueness.

Moreover, courts are loathe to strike down statutes as overbroad or vague if limiting interpretations are available. In the case of the dogfighting statute, it seems that no limiting interpretation was possible without rewriting the entire statute. The statute applied to videotapes in which an animal was “maimed, mutilated, tortured, wounded, or killed.” Yet, not all killing of animals is unlawful (e.g., lawful hunting), and so the Court found the statute overbroad relative to Congress’s legitimate purpose of reducing unlawful cruelty to

137. See, e.g., *United States v. Williams*, 553 U.S. 285, 293 (2008); *L.A. Police Dept. v. United Reporting Publ’g Corp.*, 528 U.S. 32, 39 (1999); *New York v. Ferber*, 458 U.S. 747, 769 (1982).

138. 553 U.S. at 292 (explaining requirement of “substantial” overbreadth).

139. *Id.*

140. See *supra* note 138.

141. *City of Houston v. Hill*, 482 U.S. 451, 467 (1987) (invalidating ordinance that prohibited interrupting police officers engaged in performing their official duties).

142. See, e.g., *Ferber*, 458 U.S. at 773 (upholding state law prohibition on child pornography despite statute’s occasional application to material with serious literary, scientific, or educational value).

143. *Eldred*, 537 U.S. at 212-13.

animals. At oral argument, the lawyer for the Government contended for a narrow interpretation of the statute on the ground that “hunting is not considered animal cruelty,”¹⁴⁴ but Justice Scalia responded that “[k]ill’ has one meaning, . . . [a]nd you . . . cannot limit that meaning just because in addition to killing you also prohibit torturing and other things.”¹⁴⁵ Thus, it appears there was no way to save the statute.

As the next section discusses, however, there are reasonable interpretive techniques that courts may employ to avoid overbreadth in the derivative works right and vagueness in the fair use doctrine. Thus, using limiting interpretations is a more promising avenue than constitutional invalidation for limiting overbreadth and vagueness in the Copyright Act.

C. Proposals for Using Statutory Interpretation to Avoid Overbreadth and Vagueness in the Copyright Act

Courts frequently use limiting interpretations, where possible, to avoid holding a statute unconstitutional. For instance, in *Williams*, the Court used the canon of statutory interpretation known as *noscitur a sociis* to limit the reach of a child pornography statute.¹⁴⁶ The statute punished “Any person who . . . knowingly . . . advertises, promotes, presents, distributes, or solicits” materials containing child pornography.¹⁴⁷ Writing for the Court, Justice Scalia observed that the statute’s purpose is to “penalize[] speech that accompanies or seeks to induce a transfer of child pornography . . . from one person to another.”¹⁴⁸ Because “[o]ffers to engage in illegal transactions are categorically excluded from First Amendment protection,”¹⁴⁹ the statute was constitutional with regard to many, if not most, of its applications. Nevertheless, the defendant argued that the statute was overbroad.¹⁵⁰

In interpreting the statute, the Court stated that “the statute’s string of operative verbs—’advertises, promotes, presents, distributes, or solicits’—is reasonably read to have a transactional connotation.”¹⁵¹

144. Transcript of Oral Argument at 17, Stevens, 2010 WL 1540082 (No. 08-769).

145. *Id.* at 18.

146. *United States v. Williams*, 553 U.S. 285, 294 (2008) (applying “the commonsense canon of *noscitur a sociis*—which counsels that a word is given more precise content by the neighboring words with which it is associated” (italics in original)).

147. *Id.* at 289-90 (quoting 18 U.S.C. § 2252A(a)(3)(B) (2000)).

148. *Id.* at 294.

149. *Id.* at 297.

150. *Id.* at 292.

151. *Id.* at 294.

It explained that “[f]or three of the verbs, this is obvious: advertising, distributing, and soliciting are steps taken in the course of an actual or proposed transfer of a product.”¹⁵² And although “taken in isolation, the two remaining verbs—‘promotes’ and ‘presents’—are susceptible of multiple and wide-ranging meanings,” the Court reasoned that “[i]n context, . . . those meanings are narrowed by the commonsense canon of *noscitur a sociis*—which counsels that a word is given more precise content by the neighboring words with which it is associated.”¹⁵³ Thus, the Court interpreted the term “promotes” to refer to the act of “recommending purported child pornography to another person for his acquisition” and the term “presents” to refer to the act of “showing or offering the child pornography to another person with a view to his acquisition.”¹⁵⁴ In this way, the Court was able to limit the reach of the statute to speech connected with unlawful attempts to transfer child pornography. The Court also engaged in lengthy statutory construction of other terms related to knowledge, intent, and the definition of “sexually explicit conduct.”¹⁵⁵ Once it had interpreted the statute, the Court held that the statute was not overbroad because “offers to provide or requests to obtain child pornography are categorically excluded from the First Amendment.”¹⁵⁶

The derivative works right and fair use doctrine are capable of reasonable interpretations that would reduce overbreadth and vagueness in the scope of copyright protection. Currently, the derivative works right covers the preparation of new works “based upon the copyrighted work, including a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted.”¹⁵⁷ There are two ways in which the derivative works right should be narrowly interpreted. First, courts should ensure that violation of the derivative works right requires not only that the allegedly infringing work is based upon the copyrighted work but also that it substantially incorporates copyrighted expression from that work. Many courts already limit the derivative works right in this way, but all courts should do so consistently.¹⁵⁸ This requirement is the only way to

152. *Id.*

153. *Id.*

154. *Id.* at 294-95

155. *Id.* at 295-97.

156. *Id.* at 299.

157. 17 U.S.C. § 101 (2006).

158. *See supra* note 63.

maintain the idea/expression dichotomy; otherwise, copyright holders could prevent others from borrowing uncopyrightable ideas from their works in making new works. It is critical to maintain the idea/expression dichotomy, as it is one of the doctrines that the *Eldred* Court explicitly relied on to protect First Amendment values in copyright law.

Second, the catch-all language in the derivative works right must be interpreted more narrowly. As previously discussed, the language, "any other form in which a work may be modified, transformed, or adapted," renders the derivative works right overbroad.¹⁵⁹ Courts currently interpret this language as applying to nearly all uses of copyrighted material that change the copyrighted work in some way, including uses that change not merely the form but also the content or message. This interpretation is not necessarily the best one, even on the definition's own terms. The definition begins with a list of illustrative derivative uses, such as "translation, musical arrangement, fictionalization, dramatization, motion picture version" and then the catch-all language adds "or *any other form* in which a work may be recast, transformed, or adapted."¹⁶⁰ Although the open-ended language, "any other form," may be interpreted broadly, it should be interpreted under the principle *noscitur a sociis* in light of the more specific examples that precede it. Those examples reflect common forms of a copyright holder's own expression, not new works containing very different expression. For instance, works such as satire, parody, guide books, trivia books, etc. are conspicuously absent from the list of statutory examples; yet the catch-all language is clearly broad enough to include those types of works. A narrower and more reasonable interpretation of the language would cover the conversion of the copyright holder's own expression into other forms or media but would not cover subsequent works comprised largely of new substantive content. That is, this interpretation would include common forms of the copyright holder's own expression that are similar to the listed examples, but would not include works that borrow from a copyrighted work to create a work with different content.

It is possible that adopting this limiting interpretation of the derivative works right could lead courts to rethink the scope of the reproduction right as well, at least as applied to derivative uses. After all, while the reproduction right covers most derivative uses as part of its general prohibition on copying, it is the derivative works right that

159. See *supra* Part I.B.

160. 17 U.S.C. § 101.

was specifically intended to address copying for the purpose of creating new works. Even if courts do not reinterpret the reproduction right, however, narrowing the derivative works right will nevertheless reduce overbreadth and vagueness by changing the way in which the derivative works right intersects with fair use. First, it will reduce ambiguity in copyright law's use of the term "transform." Currently, the derivative works right gives to the copyright holder the right to make "any other form of a work that modifies, *transforms*, or adapts" his or her work, while the fair use doctrine gives defendants greater protection if they transform the copyrighted work.¹⁶¹ By limiting the derivative works right to uses that transform the work into other forms or media, and allowing fair use to operate on uses that transform the content or purpose of the work, this confusing tension can be largely avoided.

Second, the narrower derivative works right will provide a useful limit on the market effects that courts consider in analysis of the fourth fair use factor. Currently, application of this factor is confusing because copyrights are so broad that copyright holders can claim that they are entitled to a licensing fee for almost any copying in any market. The factor can even be circular, because if copying constitutes fair use, then no license would be required. Under the proposed derivative works definition, courts should limit the markets that the copyright holder is entitled to control to markets for various forms of the copyright holder's expression and should exclude from the copyright holder's control markets for new expressive works, such as satire. Courts have already essentially adopted this approach for parody, holding that copyright holders are not entitled to licensing fees for a parody, unless the parody causes market harm to another market that the copyright holder is entitled to control.¹⁶² This change in the fair use analysis could operate against claims of infringement of either the reproduction right or the derivative works right and would help to reduce both overbreadth and vagueness in the Act.

Finally, reducing overbreadth and vagueness in copyright law requires courts to take proof of harm more seriously in fair use analysis. Currently, although courts consider the effect on the market for the copyrighted work in the fourth fair use factor, harm is not a strict requirement. Moreover, because fair use is treated as an affirmative defense, the burden of proof is on the defendant to show

161. *Campbell*, 510 U.S. at 591.

162. *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806 (9th Cir. 2003) (finding the defendant's parody "could only reasonably substitute for a work in the market for adult-oriented artistic photographs of Barbie" and that "it [is] safe to assume that Mattel will not enter such a market or license others to do so").

the absence of harm. In addition, given the copyright holders' broad exclusive rights, the concept of harm becomes circular as the defendant's refusal to pay a licensing fee in any particular case may be said to harm the copyright holder by depriving her of payments she might otherwise enjoy. Thus, courts sometimes find that the fourth factor of fair use favors the plaintiff where there is no little or no likelihood that the defendant's derivative work would compete with the plaintiff's original work and no "evidence that the plaintiff has tapped, or even intends to tap, a derivative market."¹⁶³ In other cases, courts find that the fourth factor favors the plaintiff based purely on speculation that the defendant's work might cause harm to the market for derivative works at some point in the future.¹⁶⁴

A harm requirement is crucial both for effectuating copyright's purpose to "promote the Progress of Science"¹⁶⁵ as well as for protecting speech that borrows from copyrighted materials.¹⁶⁶ If there is no meaningful likelihood that the defendant's use will harm the copyright holder's incentives to produce or disseminate her work, then imposing liability impedes creative progress and speech without serving the government's purpose underlying copyright law.¹⁶⁷ An effective harm requirement will require a change in the burden of proof. In cases involving close copying of the copyright holder's work in adjacent or expected markets (such as the markets for new forms of the work that are listed as examples in the definition of derivative works), harm may be presumed. In other cases, where harm is more speculative, the burden should be on the copyright holder to prove actual harm or a meaningful likelihood of harm.¹⁶⁸ Because the Copyright Act does not say that fair use is an affirmative defense, courts may adopt this burden of proof without statutory amendment. Such a reallocation of the burden of proof should help to reduce the

163. See *Blanch v. Koons*, 467 F.3d 244, 258 (2d Cir. 2006); *Castle Rock Entm't*, 150 F.3d at 145-46.

164. See, e.g., *Warner Bros. Entm't, Inc. v. RDR Books*, 575 F. Supp. 2d 513, 554 (S.D.N.Y. 2008) (noting, for instance, that "[a]lthough there is no supporting testimony," the defendant's LEXICON reference guide to J.K. Rowling's HARRY POTTER series could possibly have an effect on future works, such as musical productions or "print publications of [the] songs and poems" that appear in the HARRY POTTER books).

165. See Bohannan, *Foreseeability*, *supra* note 58 (arguing for a harm-based approach to fair use).

166. See Bohannan, *Harmless Speech*, *supra* note 28 (arguing that harm requirement is an important step toward reducing tension between copyright law and the First Amendment).

167. See *id.*

168. See Bohannan, *Foreseeability*, *supra* note 58, at 1028 (proposing that "when the defendant's use does not fall within one of the plaintiff's foreseeable uses or is not otherwise likely to cause lost sales" the burden should be assigned to the copyright owner to "prove that such harm has occurred or is likely to occur").

chilling effect caused by overbreadth and vagueness in the Copyright Act.

III. CONCLUSION

United States v. Stevens is the most recent Supreme Court case to address overbreadth in speech regulation. By striking down the challenged dogfighting statute, the decision should raise awareness of overbreadth, as well as the associated doctrine of vagueness, in other areas of speech regulation. The striking similarities between the dogfighting statute and the Copyright Act discussed in this Article serve to highlight problems of overbreadth in the derivative works right and vagueness in the fair use doctrine. While the Supreme Court is unlikely to invalidate these provisions on First Amendment grounds, the limiting interpretations and other changes suggested here would reduce the First Amendment problems that lie at the intersection of the derivative works right and fair use by providing a clearer and more sensible line between the two.

