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# Recognizing the Derivative Works Right as a Moral Right: A Case Comparison and Proposal

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# RECOGNIZING THE DERIVATIVE WORKS RIGHT AS A MORAL RIGHT: A CASE COMPARISON AND PROPOSAL

*Deidré A. Keller*<sup>†</sup>

*“All writers since immemorial time have been borrowers.”\**

*“Th[e] utilitarian view of copyrights . . . , embraced by Jefferson and Madison, stands in contrast to the ‘natural rights’ view underlying much of continental European copyright law . . . .”\*\**

## CONTENTS

INTRODUCTION..... 512

I. A CASE COMPARISON: DOES THE DERIVATIVE WORKS RIGHT ALLOW COPYRIGHT OWNERS TO CONTROL DERIVATIVE USES?..... 518

    A. *Arguments Propounded by the Plaintiffs:*  
        *How Copyright Owners See the Derivative Works Right*..... 520

    B. *Arguments Propounded by the Defendants:*  
        *How Secondary Users See the Derivative Works Right*..... 525

    C. *The Decisions of the District Courts:*  
        *Trial Courts Construe the Derivative Works Right as a Mechanism for Control*..... 527

    D. *The Decisions of the Appellate Courts:*  
        *The Eleventh Circuit’s First Amendment Decision Dressed Up in Fair Use Clothes Versus the Second Circuit’s Focus on Irreparable Harm to the Exclusion of Considering Defendant’s First Amendment Arguments*..... 534

II. A BRIEF HISTORY OF COPYRIGHT IN THE UNITED STATES:  
    A STUDY IN ACCRETION ..... 539

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† Assistant Professor of Law at Ohio Northern University Pettit College of Law. Thanks are due to Llewellyn Gibbons, Shine Tu, Liam O’Melinn, and Michael Lewis, who graciously provided comments on prior drafts of this Article. Thanks are also due to the members of the faculty here at ONU, especially Stephen Veltri and Joanne Brant, without whose encouragement this Article may have been nothing more than an idea, and to Cathy Lesser Mansfield whose comment on the idea that became this Article reminded me that authors write for reasons that are not pecuniary in the least. A prior draft of the Article was presented at and benefitted from the comments of the participants at the Ohio Legal Scholarship Workshop in May 2012. Finally, I would like to thank Amy Jeffries, James Walker, and Christopher Mosley for their research assistance. All errors and omissions are mine alone.

\* HORACE G. BALL, *THE LAW OF COPYRIGHT AND LITERARY PROPERTY* 1 (1944).

\*\* *Golan v. Holder*, 132 S. Ct. 873, 901 (2012) (Breyer, J., dissenting).

III. IN SEARCH OF A MOTIVATING PRINCIPLE: WHY DO WE PROTECT COPYRIGHT AND HOW DOES THIS INFORM OUR UNDERSTANDING OF THE APPROPRIATE CONTOURS OF THE DERIVATIVE WORKS RIGHT?.....	542
IV. HOW DO WE SOLVE THE PROBLEM OF THE DERIVATIVE WORKS RIGHT?.....	545
A. <i>What Is the Problem of the Derivative Works Right?</i> .....	545
B. <i>What are Moral Rights?</i> .....	548
V. A PROPOSED SOLUTION: UNDERSTANDING THE DERIVATIVE WORKS RIGHT AS A MORAL RIGHT.....	549
A. <i>The Contours of the New Section 106B</i> .....	551
B. <i>Considering the Implications of the New Section 106B: Hypothetical Resolutions of SunTrust and Salinger</i> .....	552
CONCLUSION.....	552

## INTRODUCTION

All authors build upon the work of those who came before them. Perhaps the most revered copyright scholar of the twentieth century, Melville Nimmer, noted as much in opining that the musical and movie *West Side Story* was, at some level of abstraction, a retelling of Shakespeare’s *Romeo and Juliet*.<sup>1</sup> Were *Romeo and Juliet* protected by the Copyright Act of 1976, the heirs of Shakespeare might well have a case for infringement of the derivative works right.

Copyright owners marshal the derivative works right to exert control over use of their works.<sup>2</sup> In such cases, courts tend to find in favor of the owners and, thereby, deprive the public of new works.<sup>3</sup> This Article will engage in a close reading of the cases concerning *Gone with the Wind*<sup>4</sup> and *The Catcher in the Rye*<sup>5</sup> in order to better understand the degree of control asserted by copyright owners and enforced by courts.

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1. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03 (rev. ed. 2012).
  2. *See, e.g.*, Complaint ¶ 37, Warner Bros. Entm’t v. RDR Books, 575 F. Supp. 2d 513 (S.D.N.Y. 2008) (No. 1:07-cv-09667-RPP) (“While Ms. Rowling has permitted some fan sites certain latitude to make use of the material in her books, these sites are generally free to the public and exist to enable fans to communicate, rather than to create an unauthorized derivative work in order to turn a quick and easy profit based on her own creativity. Ms. Rowling never gave anyone permission to publish and offer for sale a 400-page *Harry Potter* ‘lexicon’.”).
  3. *E.g.*, Warner Bros., 575 F. Supp. 2d 513 (finding for the plaintiff at the conclusion of a bench trial and awarding a permanent injunction and statutory damages).
  4. MARGARET MITCHELL, *GONE WITH THE WIND* (1936).
  5. J.D. SALINGER, *THE CATCHER IN THE RYE* (1951).

The term “derivative work” is defined broadly in the Copyright Act as “a work based upon one or more preexisting works, such as a translation, . . . dramatization, fictionalization, motion picture version, . . . abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted.”<sup>6</sup> Section 106(2) reserves to the copyright owner the exclusive right “to prepare derivative works based upon the copyrighted work.”<sup>7</sup> As such, the derivative works right is the only right in the copyright bundle represented by 17 U.S.C. § 106 that overtly limits the creation of new works.<sup>8</sup> The other rights articulated in § 106 limit reproduction,<sup>9</sup> distribution,<sup>10</sup> performance,<sup>11</sup> display,<sup>12</sup> and digital audio transmission<sup>13</sup> of the *original work*.<sup>14</sup> This renders the derivative works right the most problematic of the rights in the bundle because by limiting the creation and dissemination of new works it arguably implicates the First Amendment and runs counter to the purpose of copyright articulated in the Constitution, “To promote the Progress of Science and useful Arts.”<sup>15</sup> This is so whether one understands that purpose as providing incentives for creation or dissemination of new works.<sup>16</sup>

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6. 17 U.S.C. § 101 (2006).

7. 17 U.S.C. § 106(2).

8. Many commentators have noted that given the fact that the standard for infringement—substantial similarity—is the same in the context of infringement of the reproduction right and the derivative works right, the derivative works right may be seen as superfluous. See 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.09[A] (rev. ed. 2012) (“The best indication of the superfluity of the adaptation right lies in the fact that those infrequent cases under the 1909 Act that invoked the comparable right to ‘make any other version,’ generally also invoked an alternative ground of infringing copying.” (footnote omitted)).

9. 17 U.S.C. § 106(1).

10. 17 U.S.C. § 106(3).

11. 17 U.S.C. § 106(4).

12. 17 U.S.C. § 106(5).

13. 17 U.S.C. § 106(6).

14. Some commentators have noted that courts tend to conflate infringement of the derivative works right with infringement of the reproduction right. See, e.g., Jed Rubenfeld, *The Freedom of Imagination: Copyright’s Constitutionalality*, 112 YALE L.J. 1, 50–52 (2002) (discussing cases in which a claim of infringement of the derivative works right was asserted and considered).

15. U.S. CONST. art. I, § 8, cl. 8; see also Joseph P. Bauer, *Copyright and the First Amendment: Comrades, Combatants, or Uneasy Allies?*, 67 WASH. & LEE L. REV. 831, 894–99 (2010).

16. See *Golan v. Holder*, 132 S. Ct. 873, 888 (2012) (“Evidence from the founding, moreover, suggests that inducing *dissemination*—as opposed to creation—was viewed as an appropriate means to promote science.”);

This Article will demonstrate that copyright owners alleging infringement of the derivative works right and courts enforcing that right are often seeking to vindicate something other than an economic right—a moral right.<sup>17</sup> Moral rights, in this context, refers to the nonpecuniary interests recognized by many countries to be held by authors of creative works, specifically, the rights of attribution, disclosure, integrity, and withdrawal.<sup>18</sup> These rights are seen as protecting an author’s personality interests in his creation.<sup>19</sup> As such, it is difficult to see how such rights are related to the utilitarian mandate embodied in the Constitution.<sup>20</sup> Therefore, moral rights ought to be

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*see also id.* at 900 (Breyer, J., dissenting) (“[C]opyright’s grants of limited monopoly privileges to authors . . . [are] private benefits . . . conferred for a public reason—to elicit new creation.”). The major theoretical disagreement between Justice Ginsburg writing for the majority and Justice Breyer’s dissent turns upon the issue of whether the “Progress of Science” language in Article I, Section 8, Clause 8 of the Constitution requires Congress to legislate to promote creation or dissemination. *See* Pamela Samuelson et al., *The Copyright Principles Project: Directions for Reform*, 25 BERKELEY TECH. L.J. 1175, 1181 (2010) (asserting that copyright is intended to incentivize both creation and dissemination).

17. The issue of whether authors ought to be imbued with any exclusive rights with respect to derivative works has been previously considered. *See, e.g.*, John M. Olin, Note, “Recoding” and the Derivative Works Entitlement: Addressing the First Amendment Challenge, 119 HARV. L. REV. 1488, 1497–1501 (2006) (discussing the consequences of a public right to recode).
18. *See generally* Martin A. Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 554 (1940) (discussing the development of the moral rights doctrine).
19. *See* Edward J. Damich, *The Right of Personality: A Common-Law Basis for the Protection of the Moral Rights of Authors*, 23 GA. L. REV. 1, 4 (1988) (“The crucial link between the American right of personality and the concept of moral rights is that works of art are expressions of the creative personality of the author, and insofar as these works continue to embody the author’s personality, acts done to them that impair their ability accurately to reflect the author’s personality should be actionable.”); Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 CARDOZO ARTS & ENT. L.J. 81, 81 (1998) (“Property rights, it was observed, are a means to protect the personality interest or ‘personhood’ of individuals; this seemed especially true with intellectual property rights that are draped over creations of the human mind. Along these lines, personhood proponents could understandably be found in the vanguard of ‘moral rights’ for authors . . .”).
20. ROBERTA ROSENTHALL K WALL, *THE SOUL OF CREATIVITY: FORGING A MORAL RIGHTS LAW FOR THE UNITED STATES* 24 (2010) (“[T]he scant history of the Copyright Clause fails to reflect an explicit concern with recognizing the personal rights of authors as an independent end. On the contrary, the evidence suggests that the Framers’ primary

distinguished from the pecuniary rights at the heart of copyright. There is an argument, of course, that such rights are not worthy of protection in the first instance.<sup>21</sup> But since courts enforce such rights in the guise of enforcing the derivative works right, this Article will presume that such rights are worthy of protection while arguing that in the absence of Constitutional justification and given the personal nature of moral rights, they should receive more limited protection.<sup>22</sup>

To accomplish these goals, § 106(2) of the Copyright Act of 1976 should be repealed and replaced with a more limited grant of rights subject to a compulsory license.<sup>23</sup> This new § 106(2) will protect a copyright owner's economic interest in derivative works. In addition, to the extent that the moral rights of literary authors are found to be worthy of protection, a new § 106B should be adopted. The moral right protected by the proposed § 106B should not apply to works made for hire, should be inalienable, and should be limited in duration to the lifetime of the author.

While neither *Eldred v. Ashcroft*<sup>24</sup> nor *Golan v. Holder*<sup>25</sup> centered on the derivative works right, both had implications for secondary uses of copyrighted works. In *Eldred v. Ashcroft*, the Supreme Court held

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policies were influenced heavily by the utilitarian goals of promoting progress, safeguarding public access, and protecting the public domain as the mechanism ensuring access to information and facts in expressive works.”).

21. See Amy M. Adler, *Against Moral Rights*, 97 CAL. L. REV. 263, 279 (2009) (arguing that the protection of moral rights may deter creation).
22. See *infra* Part I; see also Thomas P. Heide, *The Moral Right of Integrity and the Global Information Infrastructure: Time for a New Approach?*, 2 U.C. DAVIS J. INT'L L. & POL'Y 211, 230 n.84 (1996) (discussing recourse available through state moral rights statutes).
23. The idea of a compulsory license associated with § 106(2) has been suggested before. See Robert J. Morrison, *Deriver's Licenses: An Argument for Establishing a Statutory License for Derivative Works*, 6 CHI.-KENT J. INTELL. PROP. 87 (2006) (discussing compulsory licenses as the best way to strike a balance between removing the permission right and keeping the right to receive payment for use). Moreover, the Copyright Act of 1976 already includes compulsory licenses in other contexts. See, e.g., 17 U.S.C. § 115 (2006) (providing for compulsory licenses to create new versions of existing sound recordings provided certain conditions are met). Determining whether the proposal would pass the Berne three-step test is beyond the scope of this Article. For a recent discussion of whether a compulsory licensing proposal passes the test, see Jason Iuliano, *Is Legal File Sharing Legal? An Analysis of the Berne Three-Step Test*, 16 VA. J.L. & TECH. 464 (2011).
24. *Eldred v. Ashcroft*, 537 U.S. 186 (2003).
25. *Golan v. Holder*, 132 S. Ct. 873 (2012).

that the Copyright Term Extension Act (CTEA)<sup>26</sup> passed constitutional muster.<sup>27</sup> The CTEA extended the copyright term from the life of the author plus fifty years to the life of the author plus seventy years.<sup>28</sup> This effectively postponed the availability of works for use by those wishing to create derivatives. In *Golan v. Holder*, the Supreme Court upheld the constitutionality of the Uruguay Round Agreements Act (URAA)<sup>29</sup> which removed from the public domain works that were previously available for use by secondary authors.<sup>30</sup> In both *Eldred* and *Golan*, the petitioners alleged that Congress exceeded the scope of authority granted to it in Article I, Section 8, Clause 8 of the Constitution (the Copyright Clause) and that the statutes in question infringed upon the First Amendment.<sup>31</sup> In both cases, the Court deferred to Congress's determination that the legislation in question "serve[d] the objectives of the Copyright Clause."<sup>32</sup> In *Golan*, the Court also clarified its statement from *Eldred* that heightened First Amendment scrutiny would be appropriate only in cases in which Congress altered the "traditional contours of copyright." The *Golan* Court limited the phrase "traditional contours of copyright" to the idea/expression dichotomy and the affirmative defense of fair use.<sup>33</sup> While this clarification had been long awaited,<sup>34</sup> this limitation significantly curtailed the arguments available to parties seeking to assert First Amendment challenges to new copyright legislation.<sup>35</sup>

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26. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, § 102(b), (d), 112 Stat. 2827, 2827–28 (1998) (amending 17 U.S.C. §§ 302, 304).
  27. *Eldred*, 537 U.S. at 222.
  28. Sonny Bono Copyright Term Extension Act § 102, 112 Stat. 2827, 2827 (1998) (codified at 17 U.S.C. § 302).
  29. Pub. L. 103-465, 108 Stat. 4809 (1994) (codified at 17 U.S.C. § 104A).
  30. *Golan*, 132 S. Ct. at 878 (2012). For the Court's discussion of the impact of the URAA on authors of derivative works, see *id.* at 883.
  31. *Eldred*, 537 U.S. at 193–94; *Golan*, 132 S. Ct. at 878.
  32. *Golan*, 132 S. Ct. at 889; see also *Eldred*, 537 U.S. at 198.
  33. *Golan*, 132 S. Ct. at 890.
  34. See, e.g., William McGinty, *First Amendment Rights to Protected Expression: What Are the Traditional Contours of Copyright Law?*, 23 BERKELEY TECH. L.J. 1099, 1100 (2008) ("Because the judiciary has rendered toothless the Copyright Clause's limits on Congressional power, the First Amendment is the last hope for anyone arguing that the Constitution places substantive limits on Congress's ability to pass copyright laws.").
  35. See generally David L. Lange, Risa J. Weaver & Shiveh Roxana Reed, *Golan v. Holder: Copyright in the Image of the First Amendment*, 11 J. MARSHALL REV. INTELL. PROP. L. 83 (2011) (advancing the idea that the Tenth Circuit's decision upholding the URAA ought to be reversed

In Part I, this Article will compare the cases concerning *Gone with the Wind* and *The Catcher in the Rye* in order to focus the inquiry on the derivative works right itself. While some of the existing literature proposes deploying strengthened First Amendment arguments in derivative works cases,<sup>36</sup> such arguments have proven largely ineffective in copyright infringement litigation.<sup>37</sup> Other scholars argue that fair use, properly applied, can function as a limit on the derivative works right.<sup>38</sup> Unfortunately, this strategy has also been unsuccessful.<sup>39</sup> Part I of this Article will undertake a review not only of the opinions but also the arguments advanced by the parties in the *Gone with the Wind* and *Catcher* cases to consider how copyright owners and secondary users understand the derivative works right and to determine which arguments appear to resonate in the opinions at the district and appellate court levels. This comparison will serve to develop the issues inherent in infringement determinations in the context of allegedly infringing derivative works and to demonstrate an attempt, on the part of both parties and courts, to vindicate a moral right, namely, the right of integrity.

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on First Amendment grounds, after the Tenth Circuit's decision but prior to the Supreme Court's decision).

36. See, e.g., Rubinfeld, *supra* note 14, at 48 (arguing that courts ought to consider the freedom of imagination inherent in the First Amendment in making decisions with regard to derivative works).
37. See, e.g., Lish v. Harper's Magazine Found., 807 F. Supp. 1090, 1105 (S.D.N.Y. 1992) (holding that the idea/expression dichotomy and fair use are sufficient to protect any First Amendment interests not fully alleviated by the ability to quote purely factual information); Ass'n of Am. Med. Colleges v. Princeton Review, Inc., 332 F. Supp. 2d 11, 20 (D.D.C. 2004) ("The First Amendment does not require that copyrighted works be published or made available to particular persons").
38. See, e.g., David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. REV. 139 (2009) (arguing for a more structured rule-based approach to fair use to preemptively clarify which uses are fair); see also Arlen W. Langvardt & Tara E. Langvardt, *Caught in the Copyright Rye: Freeing First Amendment Interests from the Constraints of the Traditional View*, 2 HARV. J. SPORTS & ENT. L. 99, 139 (2011) (arguing for courts to apply the fair use analysis in a way that is more sensitive to First Amendment concerns); Jason Mazzone, *Administering Fair Use*, 51 WM. & MARY L. REV. 395, 399 (2009) (proposing an administrative agency to review copyright infringement and fair use issues); Gideon Parchomovsky & Kevin A. Goldman, *Fair Use Harbors*, 93 VA. L. REV. 1483, 1488–89 (2007) (arguing for the introduction of bright-line rules articulating that certain minimal levels of copying are per se fair uses).
39. See, e.g., Castle Rock Entm't, Inc. v. Carol Publ'g Grp., Inc., 150 F.3d 132, 146 (2d Cir. 1998) ("[W]e therefore reject defendants' fair use defense."). For a cogent argument that fair use has never operated in American jurisprudence as an effective limitation on the rights of copyright owners, see John Tehranian, *Et Tu, Fair Use? The Triumph of Natural-Law Copyright*, 38 U.C. DAVIS L. REV. 465, 492–502 (2005).

In Part II, the Article will engage in a brief historical account of the evolution of copyright protection in the United States by way of tracing how the various changes impacted the protection afforded *Gone with the Wind* and *Catcher*. In Part III, the Article will consider the justifications for copyright in the existing literature. Part IV will pose the question of how we might solve the problems associated with the derivative works right and outline the existing literature on the protection of moral rights in the United States. Finally, in Part V, this Article proposes revising 17 U.S.C. § 106(2) and adopting a new § 106B. These revisions to the statute will serve three main purposes. First, they will render transparent the personhood interest often sought to be vindicated by copyright owners under the current § 106(2). Second, they will act as a restraint on the power of copyright owners to deny authorization for derivative works except in the limited circumstances where an individual author is asserting his or her moral rights. Finally, these revisions will bring the derivative works right more in line with the constitutional and historical moorings of copyright in the United States.

I. A CASE COMPARISON: DOES THE DERIVATIVE WORKS  
RIGHT ALLOW COPYRIGHT OWNERS TO CONTROL  
DERIVATIVE USES?

Margaret Mitchell's *Gone with the Wind*, first published in 1936 and the recipient of a 1937 Pulitzer Prize, is set against the backdrop of the Civil War.<sup>40</sup> Its climax takes place in Atlanta during the siege as General Sherman's troops are approaching.<sup>41</sup> In 2001, *Gone with the Wind* found itself at the center of a very different battle—a suit for copyright infringement.<sup>42</sup> Nearly ten years later, J.D. Salinger's novel about a troubled teenager's inner turmoil, *The Catcher in the Rye*, would also find itself at the center of a copyright infringement suit.<sup>43</sup>

In *SunTrust v. Houghton Mifflin, Co.*,<sup>44</sup> the owners of the *Gone with the Wind* copyright alleged that Alice Randall's first novel, *The*

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40. *1937 Winners*, THE PULITZER PRIZES, <http://www.pulitzer.org/awards/1937> (last visited Oct. 30, 2012).

41. MITCHELL, *supra* note 4, at 353–55.

42. Complaint ¶ 2, *SunTrust Bank v. Houghton Mifflin Co. (SunTrust I)*, 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01-CV-701) [hereinafter *SunTrust Complaint*].

43. Complaint ¶ 1, *Salinger v. Colting (Salinger I)*, 641 F. Supp. 2d 250 (S.D.N.Y. 2009) (No. 09 Civ. 5095) [hereinafter *Salinger Complaint*].

44. *SunTrust Bank v. Houghton Mifflin Co. (SunTrust I)*, 136 F. Supp. 2d 1357 (N.D. Ga. 2001).

*Wind Done Gone*,<sup>45</sup> infringed upon that copyright (this case is referred to interchangeably throughout as “*SunTrust*” or the “*Gone with the Wind* case”). In *Salinger v. Colting*,<sup>46</sup> the dispute centered on whether Fredrik Colting’s first novel, *60 Years Later: Coming Through the Rye*,<sup>47</sup> infringed the copyright of *Catcher in the Rye* (this case is referred to interchangeably throughout as “*Salinger*” or the “*Catcher* case”). In both cases, the copyright owners alleged infringement of the derivative works right and copying of characters.<sup>48</sup> In both cases, the defendants answered by raising the affirmative defenses of fair use and the First Amendment.<sup>49</sup> The Northern District of Georgia preliminarily enjoined the publication of *The Wind Done Gone*.<sup>50</sup> Ten years later, the Southern District of New York preliminarily enjoined *60 Years Later*.<sup>51</sup> Both the Eleventh Circuit and the Second Circuit vacated the issued injunctions, but for vastly different reasons.<sup>52</sup> The resolution of both cases would ultimately turn on the issue of fair use.<sup>53</sup>

All of these similarities notwithstanding, these cases would come to vastly different ends. Randall’s novel would go on to publication,<sup>54</sup>

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45. ALICE RANDALL, *THE WIND DONE GONE* (2001).
  46. *Salinger v. Colting* (*Salinger I*), 641 F. Supp. 2d 250 (S.D.N.Y. 2009).
  47. JOHN DAVID CALIFORNIA, *60 YEARS LATER: COMING THROUGH THE RYE* (2009).
  48. SunTrust Complaint, *supra* note 42, ¶ 3; Salinger Complaint, *supra* note 43, ¶¶ 70, 76–83.
  49. Answer and Affirmative Defenses at 8, *SunTrust I*, 136 F. Supp. 2d 1357 (No. 1:01-CV-701-CAP) [hereinafter SunTrust Answer and Affirmative Defenses]; Amended Answer and Counterclaim at 1213, *Salinger I*, 641 F. Supp. 2d 250 (No. 09 Civ. 05095 (DAB)) [hereinafter Salinger Amended Answer and Counterclaim].
  50. Order at 51, *SunTrust I*, 136 F. Supp. 2d 1357 (No. 1:01-CV-701-CAP).
  51. Memorandum and Order at 37, *Salinger I*, 641 F. Supp. 2d 250 (No. 1:09-cv-05095 (DAB)).
  52. *See SunTrust Bank v. Houghton Mifflin Co. (SunTrust III)*, 268 F.3d 1257, 1276 (11th Cir. 2001) (holding that the plaintiff was not entitled to an injunction because *The Wind Done Gone* had a valid fair-use defense); *see also Salinger v. Colting (Salinger II)*, 607 F.3d 68, 74–75 (2d Cir. 2010) (vacating the injunction and remanding for a determination of whether the plaintiff demonstrated irreparable harm as required by the Supreme Court’s holding in *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006)).
  53. *See SunTrust III*, 268 F.3d at 1276 (“[B]ased upon our analysis of the fair use factors we find, at this juncture, [*The Wind Done Gone*] is entitled to a fair-use defense.”); *Salinger II*, 607 F.3d at 83 (“Defendants are not likely to prevail in their fair use defense.”).
  54. Press Release, Houghton Mifflin Harcourt, Settlement Reached Regarding *The Wind Done Gone* (May 9, 2002), available at [http://www.houghtonmifflinbooks.com/features/randall\\_url/may9pr.shtml](http://www.houghtonmifflinbooks.com/features/randall_url/may9pr.shtml).

while Colting's novel would end up the subject of a permanent injunction against publication or sale in the United States.<sup>55</sup> A close examination of these cases teaches that very similar cases may come to divergent ends because the fair use doctrine, relied upon by courts and scholars alike to protect freedom of expression in the copyright context,<sup>56</sup> is highly unpredictable.<sup>57</sup> The purpose of this case comparison is to refocus the discussion away from rehabilitating the fair use doctrine or, alternatively, strengthening First Amendment protections, and to consider instead the contours of the derivative works right, how it is deployed by copyright owners, and how it is handled by courts.

*A. Arguments Propounded by the Plaintiffs:  
How Copyright Owners See the Derivative Works Right*

The arguments espoused by the plaintiffs in *SunTrust* and *Salinger* are strikingly similar. They amount to an assertion that the copyright owner ought to have control over all derivative uses,<sup>58</sup> even where the copyright owner has refused to license uses such as the use in question, as was the case in *SunTrust*,<sup>59</sup> and even where the copyright owner has stated publically that he would never license any derivative uses, as was the case in *Salinger*.<sup>60</sup>

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55. Permanent Injunction and Final Order on Consent at 1, *Salinger I*, 641 F. Supp. 2d 250 (No. 09 Civ. 05095 (DAB)).
56. In *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003), the Supreme Court stated, “copyright law contains built-in First Amendment accommodations.” In discussing those accommodations, the Court went on to say “the ‘fair use’ defense allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances.” See generally Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970) (discussing the conflict between copyright law and the First Amendment).
57. See generally Rebecca Tushnet, *Copyright as a Model for Free Speech Law: What Copyright Has in Common with Anti-Pornography Laws, Campaign Finance Reform, and Telecommunications Regulation*, 42 B.C. L. REV. 1 (2000) (pointing out the conflict between copyright law and the First Amendment). But see Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549 (2008) (conducting an empirical analysis of all of the fair use opinions over the referenced period and finding that the decisions are not as unpredictable as the scholarship would suggest).
58. Nothing in the statutory language requires such a broad reading. Rather, the statute reserves to the copyright owner the explicit right to “prepare derivative works.” 17 U.S.C. § 106(2) (2006).
59. *Infra* Part I.B.
60. *Infra* Part I.B.

Both cases began with allegations of infringement of the derivative works right and of the copyright in characters.<sup>61</sup> Neither complaint included an allegation that the copyright owner had registered the allegedly infringed characters.<sup>62</sup> Rather, the plaintiffs relied upon the registrations for the novels in question to demonstrate that they owned valid and subsisting copyrights in the characters that populate the novels.<sup>63</sup> In *SunTrust*, while the specific allegations of infringement of the derivative works right and characters are asserted in the “Facts” section of the complaint,<sup>64</sup> SunTrust’s actual allegation of copyright infringement states, “Defendant . . . has willfully infringed upon the Mitchell Trusts’ rights by reproducing, displaying, manufacturing, distributing, promoting, advertising and selling its infringing work ‘The Wind Done Gone’ without the permission . . . of the Mitchell Trusts . . . .”<sup>65</sup> This is a blanket assertion that amounts

61. SunTrust Complaint, *supra* note 42, ¶ 3; Salinger Complaint, *supra* note 43, ¶¶ 70, 76–83.
62. See SunTrust Complaint, *supra* note 42, ¶ 2. Salinger Complaint, *supra* note 43, ¶ 1. The statute requires registration prior to pursuing a civil infringement action: “no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.” 17 U.S.C. § 411(a) (2006). In *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237, 1241 (2010), the Supreme Court held that the requirement embodied in § 411(a) was not a jurisdictional requirement but rather a claims processing rule. In any event, character registration has seemingly never been required by courts. See, e.g., *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1293–97 (C.D. Cal. 1995) (holding that the James Bond character is copyrightable and protected as expressed in sixteen James Bond films despite the fact plaintiffs did not have a copyright in the character itself).
63. In *Salinger v. Colting (Salinger I)*, 641 F. Supp. 2d 250 (S.D.N.Y. 2009), the plaintiff alleged only that Holden Caulfield is a copyrighted character, infringed by the defendant’s work. Plaintiff’s Memorandum in Support of Application for Preliminary Injunction at 14, *Salinger I*, 641 F. Supp. 2d 250 (No. 1:09-cv-05095-DAB) [hereinafter *Salinger Preliminary Injunction Memo*] (“Salinger owns a valid copyright in [the novel] *Catcher*. That copyright protects the character of Holden Caulfield who pervades that novel; it is, in fact his story.” (citation omitted)). For an illuminating discussion of the issues associated with copyright protection for fictional characters, see Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, and Gregory S. Schienke, Comment, *The Spawn of Learned Hand—A Reexamination of Copyright Protection and Fictional Characters: How Distinctly Delineated Must the Story Be Told?*, 9 MARQ. INTELL. PROP. L. REV. 63 (2005). See also *Warner Bros. Entm’t, Inc. v. X One X Prods.*, 644 F.3d 584 (8th Cir. 2011), for a recent treatment of this issue by a court.
64. SunTrust Complaint, *supra* note 42, ¶¶ 10–31.
65. *Id.* ¶ 35.

to accusing the defendant of infringing all of the relevant rights granted to a copyright owner by 17 U.S.C. § 106. Since the consequences flowing from infringement of any of the § 106 rights are the same, this blanket assertion is, arguably, entirely appropriate.

The arguments asserted by the plaintiffs in these cases do diverge in one notable manner. In *SunTrust*, the plaintiff asserted that defendant's unauthorized derivative work interfered with the plaintiff's ability to license derivative works as it had in the past.<sup>66</sup> Furthermore, the plaintiff argued that it had already licensed a derivative work, not yet completed at the time of the litigation, the completion of which was allegedly threatened by the defendant's actions.<sup>67</sup> To the contrary, the plaintiff in *Salinger* argued that the defendant was interfering with "his constitutionally based right *not* to publish derivatives of works he ha[d] previously authored and published, *i.e.*, the privacy underpinning of the Copyright Clause."<sup>68</sup> It appears the plaintiff in *Salinger* was asserting the right of privacy said to be inherent in the right of first publication.<sup>69</sup> At the appellate level, this argument is more refined. The plaintiff relied primarily on the right to privacy in arguing that he has the right to refuse to

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66. Memorandum of Law in Support of Plaintiff's Motion for a Temporary Restraining Order and Preliminary Injunction at 2, *SunTrust Bank v. Houghton Mifflin Co. (SunTrust I)*, 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01-CV-701) [hereinafter *SunTrust Motion for Temporary Restraining Order and Preliminary Injunction*] ("Because 'The Wind Done Gone' is an unauthorized sequel, its publication will diminish, or preclude outright, the ability of the Mitchell Trusts to authorize and control future derivative works. Moreover, future publishers will not pay for rights that Houghton Mifflin has taken for free." (emphasis added)).
67. See *SunTrust Complaint*, *supra* note 42, ¶ 15. The referenced sequel, *Rhett Butler's People*, was published in November 2007, despite the publication of *The Wind Done Gone* six years earlier. See Stephen L. Carter, *Almost a Gentleman*, N.Y. TIMES, Nov. 4, 2007, at G14 (book review).
68. *Salinger Preliminary Injunction Memo*, *supra* note 63, at 29; see also *id.* at 8 ("While Salinger's copyright in *Catcher* could no doubt be put to lucrative use if he chose to author or allow an adaptation, sequel, or any other derivative work, he has instead chosen—as is his right—not to further exploit his copyright.").
69. See Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 200 (1890) ("[The right to privacy] is entirely independent of the copyright laws . . . . The aim of those statutes is to secure to the author, composer, or artist the entire profits arising from publication; but the common-law protection enables him to control absolutely the act of publication, and in the exercise of his own discretion, to decide whether there shall be any publication at all. . . . [T]he common-law right [to privacy] is lost *as soon as* there is a publication."). For a recent case considering the viability of the privacy interest represented by copyright, see *Smith v. NBC Universal*, 86 U.S.P.Q2d (BNA) 1579 (S.D.N.Y. 2008).

create or license derivative works.<sup>70</sup> The plaintiff further argued that failure on the part of the court to protect this right would abridge the plaintiff's First Amendment right not to speak and, thereby, constitute irreparable harm.<sup>71</sup> While these allegations in *Salinger* are markedly different, as a factual matter, from the allegation in *SunTrust*, both amount to an assertion of essentially the same right—that is, the right of copyright owners “to control the fate of their works and characters.”<sup>72</sup>

This right to control appears to embody the plaintiffs' understanding of the essential feature of the right granted by 17 U.S.C. § 106(2). Some language utilized by the plaintiffs in these cases is illustrative. In *SunTrust*, the plaintiff argued that in the absence of

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70. See Brief for Plaintiff-Appellee at 47, *Salinger v. Colting (Salinger II)*, 607 F.3d 68 (2d Cir. 2010) (No. 09-2878-cv) [hereinafter *Salinger Appellate Brief*] (“Defendants never so much as acknowledge the existence of Salinger’s right *not* to publish or his right *not* to authorize derivatives. Both the right of first publication and the adaptation right stem from one of the constitutional underpinnings of copyright law, namely the right of privacy, *i.e.*, the right not to publish.” (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 554 (1985))). It is important to note that *Harper & Row* had only to do with the right of first publication and nothing to do with the derivative works right.
71. *Id.* at 50 (“Salinger’s constitutionally based right *not* to publish derivatives is not the type of injury that can adequately be remedied by monetary damages; it is exactly the kind of damage that courts traditionally find irreparable. Indeed, this Court has reversed a lower court for *failing* to issue a preliminary injunction in a case involving the right *not* to speak, citing the many cases to that effect.”). See generally David B. Gaebler, *First Amendment Protection Against Government Compelled Expression and Association*, 23 B.C. L. REV. 995 (1982) (arguing that negative First Amendment interests should be driven by interest in individual selfhood); Anna M. Tarushio, Note, *The First Amendment, The Right Not To Speak And The Problem Of Government Access Statutes*, 27 FORDHAM URB. L.J. 1001 (2000) (arguing that the principal of autonomy protects the right to be silent); Robert A. Sedler, *The First Amendment Right to Silence* (Nov. 9, 2007) (unpublished research paper, available at <http://ssrn.com/abstract=1031505> (arguing that the freedom of speech and the freedom of association together create a right of silence). As an interesting aside, some countries do recognize a moral right to refuse to disseminate one’s work. See generally Carl H. Settlemeyer III, Note, *Between Thought and Possession: Artists’ Moral Rights and Public Access to Creative Works*, 81 GEO. L.J. 2291 (1993) (noting that European copyright law aims to protect the moral rights).
72. *SunTrust* Motion for Temporary Restraining Order and Preliminary Injunction, *supra* note 66, at 3; see also *id.* at 16–17 (“The Mitchell Trusts, as copyright owner, have the exclusive right to authorize derivative works *and to control the fate of their characters.*” (emphasis added)).

interlocutory relief, “[t]he Mitchell Trust will have been deprived of its most basic right to create and authorize derivative works and to *control the way its copyrighted characters are portrayed*.”<sup>73</sup> Similarly, in *Salinger*, the plaintiff asserted that “Salinger has an *absolute right* to decide when, whether, and how to resurrect the life that he breathed into Holden Caulfield in another work and/or at some different age.”<sup>74</sup> What is interesting about the divergence of these arguments is that the plaintiff in *SunTrust* clothes its argument in the language of utilitarianism:

If Defendant is permitted to publish this unauthorized derivative work, the result will be that anyone could tell the story of “Gone With the Wind” from another point of view or create sequels or prequels populated by the Mitchell characters without any compensation to the Mitchell Trusts. Nothing would have a more dramatic or detrimental effect on the potential market for the sequels and other authorized derivative works.<sup>75</sup>

But Salinger’s insistence that he will never license a derivative of *Catcher* renders his meager attempt to resort to utilitarianism all but empty.<sup>76</sup> The plaintiff in *Salinger* went so far as to assert that

the harm to Salinger here is not solely (if at all) to his “pride”, but rather to his copyright interests, economic as well as “reputational”. The economic injury to the potential market for derivatives, discussed above, is an interest Salinger is entitled to protect. *Amici* characterize the nature of that injury as a “moral right”, and discount it because U.S. copyright laws do not take moral rights into account. It is specious to argue that U.S. copyright laws and particularly the equitable fair use

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73. *Id.* at 31–32 (emphasis added); Transcript of Motion for Temporary Restraining Order Before the Honorable Charles A. Pannell United States District Judge at 27, *SunTrust I*, 136 F. Supp. 2d 1357 (No. 1:01-CV-701-CAP) [hereinafter Temporary Restraining Order Transcript] (“The reason that the—the copyright holder has this basic right, this right—the exclusive right to authorize derivative works is that that permits him . . . to control the fate of his characters, to be able to determine how these characters will be used.”).

74. Salinger Preliminary Injunction Memo, *supra* note 63, at 27 (emphasis added).

75. SunTrust Motion for Temporary Restraining Order and Preliminary Injunction, *supra* note 66, at 27.

76. See Salinger Preliminary Injunction Memo, *supra* note 63, at 26–27. The memo attempted to focus the court’s inquiry on the “*potential* market” rather than any actual plans by Salinger to use the Holden Caulfield character. And it cited *Salinger v. Random House, Inc.*, 811 F.2d 90, 99 (2d Cir. 1987), for the proposition that “Salinger has the right to change his mind. He is entitled to protect his *opportunity* to sell” his works.

defense are not flexible enough to encompass some consideration of moral rights . . . .<sup>77</sup>

Given the current state of the law, these articulations of absolute control, even in the absence of reasonable utilitarian motivations, may well be accurate. The question here is whether copyright ought to grant such an expansive right of control.

*B. Arguments Propounded by the Defendants:  
How Secondary Users See the Derivative Works Right*

The defendants in both *SunTrust* and *Salinger* answered the plaintiffs' assertions of control with claims of fair use and First Amendment protection for their secondary uses.<sup>78</sup> Their answers advanced the notion that some uses of copyrighted works ought not to require the permission of the copyright owner. In fact, in both *Salinger* and *SunTrust* no such permission would be forthcoming. The Mitchell Trusts would never allow the publication of a work that included homosexuality or miscegenation.<sup>79</sup> Randall's work breached

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77. Salinger Appellate Brief, *supra* note 70, at 55.

78. The defendants in *SunTrust* asserted, among others, the following affirmative defenses:

Defendant's right to publish *The Wind Done Gone* is protected by the First Amendment of the United States Constitution. A restraining order or injunction impeding promotion and/or publication of *The Wind Done Gone* would be an unconstitutional prior restraint. . . . In the event the Court or jury finds that *The Wind Done Gone* copies copyrightable expression from *Gone With the Wind*, any such copying is a fair use of that expression under 17 U.S.C. § 107.

*SunTrust* Answer and Affirmative Defenses, *supra* note 49, at 8. Similarly, defendants in *Salinger* raised affirmative defenses:

Salinger's claims for copyright infringement are barred in whole or in part because [*Coming Through the Rye*] is a fair use of [*Catcher in the Rye*]. . . . Any grant of the relief requested by Salinger would infringe on Defendants' rights under the First Amendment . . . .

Salinger Amended Answer and Counterclaim, *supra* note 49, ¶¶ 99–100, 106. Note that the defendants in *SunTrust* also asserted the defense of copyright misuse. See *SunTrust* Answer and Affirmative Defenses, *supra* note 49, at 8 (“Plaintiff's actions in bringing this lawsuit constitute copyright misuse.”).

79. *SunTrust Bank v. Houghton Mifflin Co. (SunTrust III)*, 268 F.3d 1257, 1282 (11th Cir. 2001) (referencing Pat Conroy's attestation indicating that in negotiations with the copyright owner over the licensing of a sequel authored by Conroy, the Estate insisted that there be no mention of homosexuality or miscegenation).

both of these conditions.<sup>80</sup> Similarly, Salinger had stated that the story of Holden Caulfield began and ended with *Catcher*, and he remained committed to that notion.<sup>81</sup> Furthermore, he refused to license or create any derivative of any of his copyrighted works.<sup>82</sup>

The defendants' claims of fair use and reliance upon the First Amendment, if successful, would have meant that the uses these defendants made of the copyrighted works in question were beyond the control of the copyright owner. The issuance of injunctive relief would, of course, bear out the opposite meaning.

The tension here, between the plaintiffs' assertion of control and the defendants' counterassertion that their uses ought not to be controlled by copyright owners, is obvious. The question is which of these assertions wins the day. It is argued by many,<sup>83</sup> and was decided by the district courts in both *Salinger* and *SunTrust*, that this question ought to be decided by reference to the freedom of expression safeguards alleged to be inherent to copyright, namely, the idea/expression dichotomy and fair use doctrine.<sup>84</sup> Examinations of the opinions in these cases will demonstrate that the idea/expression dichotomy is hardly engaged in any meaningful way.<sup>85</sup> Rather, the

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80. *Id.* (“In light of [the Estate’s stance against homosexuality and miscegenation], the *The Wind Done Gone’s* transformation of Ashley Wilkes into a homosexual, its depiction of interracial sex, and its multiple mulatto characters take on additional relevance.”).
81. In 1980, Salinger stated that “[t]here’s no more to Holden Caulfield. Read the book again. It’s all there. Holden Caulfield is only a frozen moment in time.” Salinger Appellate Brief, *supra* note 70, at 6.
82. *Id.* (“Salinger has always declined [to permit adaptations of his works].”).
83. See, e.g., Lackland H. Bloom, Jr., *Copyright Under Siege: The First Amendment Front*, 9 COMPUTER L. REV. & TECH. J. 41 (2004) (arguing that the emergence of new digital technologies should not open up to criticism traditional judicial interpretations of the interplay between copyright and freedom of speech).
84. See *SunTrust Bank v. Houghton Mifflin Co. (SunTrust I)*, 136 F. Supp. 2d 1357, 1385 (N.D. Ga. 2001) (“With respect to copyright protection, however, the First Amendment does not license an infringing author to trample on legally recognized rights.” (citations omitted)); *Salinger v. Colting (Salinger I)*, 641 F. Supp. 2d 250, 255 (S.D.N.Y. 2009) (“At the Constitutional level, while the Copyright Clause and the First Amendment are intuitively in conflict, they were drafted to work together to prevent censorship such that the balance between the First Amendment and copyright is preserved, in part, by the idea/expression dichotomy and the doctrine of fair use.” (internal quotation marks omitted)).
85. See Defendant Houghton-Mifflin Co.’s Response in Opposition to Plaintiff’s Motion for a Temporary Restraining Order and Preliminary Injunction at 6, *SunTrust I*, 136 F. Supp. 2d 1357 (No. 1:01-CV-701-CAP) (“An ‘axiom of copyright law’ is that it protects the original way

decisions are focused steadfastly on the fair use doctrine. This focus is maintained in spite of the fact that the defendants in both *SunTrust* and *Salinger* alleged that the issuance of an injunction would constitute an unlawful prior restraint in clear violation of the First Amendment.<sup>86</sup> Both district court decisions disregarded the asserted First Amendment defense, evidencing a determination that either the defendants' use constituted fair use or constituted infringement.

C. *The Decisions of the District Courts: Trial Courts Construe the Derivative Works Right as a Mechanism for Control*

In both *SunTrust* and *Salinger* the district courts granted preliminary injunctive relief.<sup>87</sup> In both cases, the courts' decisions focused not on infringement, which was summarily decided,<sup>88</sup> but rather on fair use.<sup>89</sup> Both district courts held that the secondary uses were not parodies and were not transformative enough to constitute a fair use.<sup>90</sup> The language the district courts used in coming to these

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in which ideas are expressed, but not the ideas.”). When the defendant in *SunTrust* raised the idea/expression dichotomy in asserting a lack of substantial similarity between *The Wind Done Gone* and protectable elements of *Gone with the Wind*, the Court soundly rejected the defendant's argument, finding actionable substantial similarity. *SunTrust I*, 136 F. Supp. 2d at 1368. In *Salinger*, the only mention of the idea/expression dichotomy is in reference to its role in preventing a conflict with the First Amendment. *Salinger I*, 641 F. Supp. 2d at 255.

86. See *SunTrust Answer and Affirmative Defenses*, *supra* note 49, at 8 (“A restraining order or injunction impeding promotion and/or publication of *The Wind Done Gone* would be an unconstitutional prior restraint.”); *Salinger Amended Answer and Counterclaim*, *supra* note 49, at 13 (“Any grant of the relief requested by *Salinger* would infringe on Defendants' rights under the First Amendment of the Constitution of the United States of America . . .”).
87. See *SunTrust I*, 136 F. Supp. 2d at 1386 (“[D]efendant is hereby PRELIMINARILY ENJOINED from further production, display, distribution, advertising, sale, or offer for sale of the book *The Wind Done Gone*.”); *Salinger I*, 641 F. Supp. at 269 (“[T]he Court preliminarily enjoins Defendants from manufacturing, publishing, distributing, shipping, advertising, promoting, selling, or otherwise disseminating any copy of *60 Years* . . .”).
88. See *SunTrust I*, 136 F. Supp. 2d at 1370 (“[T]he court finds as a matter of fact that the substantial similarities between the two works involve actionable copyrightable elements . . .”); *Salinger I*, 641 F. Supp. 2d at 254 (“Plaintiff has shown that there is substantial similarity between *Catcher* and *60 Years* . . . such that it was an unauthorized infringement of Plaintiff's copyright.”).
89. *SunTrust I*, 136 F. Supp. 2d at 1370–84; *Salinger I*, 641 F. Supp. 2d at 254–68.
90. *SunTrust I*, 136 F. Supp. 2d at 1381; *Salinger I*, 641 F. Supp. 2d at 260–61.

conclusions demonstrates that the interest at issue here is seen as something other than, or perhaps more than, utilitarian.

In *SunTrust*, the court's statements during the temporary restraining order/preliminary injunction hearing are illuminating. Judge Pannell, in response to defense counsel's argument that issuance of a preliminary injunction would constitute an impermissible prior restraint under the First Amendment, said:

Well, if you carried that—I don't have any idea how many copyright cases I handled on the Superior Court, but I handled a lot of trespass cases. And I've had cases where a fellow would just take a bulldozer and start across another man's land because that was the easiest way to get there and it would save him a lot of money. And then when we got to court, the bulldozer guy would whine that if we enjoined him from going across the man's pasture, it was going to cost him a lot of money.

Well, we didn't give him much truck on that argument because it wasn't his land to begin with, number one. Number two, he was obviously a trespasser. Number three, he can just find another way, and that is his tough luck. . . .

So, if your client has trespassed on their copyright, I don't see the balance of the harm to your client really coming into play, because you are a trespasser.<sup>91</sup>

This conflation of copyright with real property is problematic because the consequence of treating copyright as if it is interchangeable with tangible, real property is overprotection.<sup>92</sup> Said another way, treating copyright infringement as akin to trespass upon real property disregards the constitutional and historical framework in which statutory copyright has developed and imposes the theoretical framework surrounding real property in its place.<sup>93</sup> This conflation ignores the speech interests at issue in copyright cases and the inherent differences between real property and copyrighted works.<sup>94</sup>

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91. Temporary Restraining Order Transcript, *supra* note 73, at 68.

92. See WILLIAM PATRY, *MORAL PANICS AND THE COPYRIGHT WARS* 109–20 (2009) (explaining that the main difference between tangible property and copyrights arises from *ex ante* physical limitations on rights in the former and expansive, abstract *ex post* rights in the latter).

93. Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1031 (2005) (“[F]ree competition is the norm. Intellectual property rights are an exception to that norm, and they are granted only when—and only to the extent that—they are necessary to encourage invention.”).

94. See L. RAY PATTERSON & STANLEY F. BIRCH, JR., *A UNIFIED THEORY OF COPYRIGHT* (Craig Joyce ed., 2009), *printed in* 46 Hous. L.

As a practical matter, it gives the court a shortcut from infringement to injunctive relief that is contrary to the statutory language and to Supreme Court precedent.<sup>95</sup>

The trespasser quotation taken from the transcript for the temporary restraining order hearing foreshadows the court's ultimate decision. In the decision, the court resolved the tension between copyright and the First Amendment as follows: "With respect to copyright protection, . . . the First Amendment does not license an infringing author to trample on legally recognized rights. . . . The competing public interests of access to Ms. Randall's work and preserving a copyright holder's ownership interests, on balance, favor preserving the plaintiff's copyright interests."<sup>96</sup> That the limited statutory copyright prevailed over the Constitution's guarantee of free expression seems to be of little moment. Examining the court's understanding of the degree of control given to copyright owners by the Copyright Act may explain this apparent supremacy of the Copyright Act over the First Amendment.

Although nothing in the language of § 106(2) of the Copyright Act supports an exclusive right to absolute control by the copyright owner, the district court in *SunTrust* seems to have agreed with the plaintiff's assertion that the right includes not only the right to license or create derivative works but also the right to *control* derivative works. For example, the court stated that "the licensing, creation, *and control* over derivative uses is an important economic incentive to the creation of the original."<sup>97</sup> For this proposition the court cited *Campbell v. Acuff-Rose*, where the Supreme Court stated that "licensing of derivatives is an important economic incentive to

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REV. 215, 239 (2009) ("The property right that is copyright, then, is necessarily a limited right, because copyright cannot constitutionally inhibit the public's right to know and learn.").

95. See 17 U.S.C. § 502(a) (2006) (concerning remedies for copyright infringement). The statutory language is permissive: "Any court having jurisdiction of a civil action arising under this title *may* . . . grant temporary and final injunctions on such terms as it may deem reasonable . . ." *Id.* (emphasis added). The Supreme Court recognized the permissive nature of this grant. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 n.10 (1994) ("[C]ourts may also wish to bear in mind that the goals of copyright law, to stimulate the creation and publication of edifying matter, are not always best served by automatically granting injunctive relief when parodists are found to have gone beyond the bounds of fair use." (citation and internal quotation marks omitted)).
96. *SunTrust I*, 136 F. Supp. at 1385 (citing *In re Capital Cities/ABC, Inc.*, 918 F.2d 140, 143–44 (11th Cir. 1990)).
97. *Id.* at 1383 (emphasis added).

the creation of originals.”<sup>98</sup> In *SunTrust*, the Supreme Court’s pronouncement is broadened to include factual situations, such as the one here, where the plaintiff would never have licensed the defendant’s use. This broadening is manifest in the court’s inclusion of the word “control,” which appears nowhere in the Supreme Court’s *Campbell* decision and, in fact, contravenes the Supreme Court’s ultimate decision in that case, which held that certain derivative uses cannot be controlled by copyright owners. Specifically, the Supreme Court stated:

The market for potential derivative uses includes *only those that creators of original works would in general develop or license others to develop*. Yet the unlikelihood that creators of imaginative works will license critical reviews or lampoons of their own productions removes such uses from the very notion of a potential licensing market.<sup>99</sup>

Copyright owners have the exclusive right to prepare and license derivatives.<sup>100</sup> This right does not extend to controlling uses a copyright owner would never prepare or license.

The district court’s issuance of injunctive relief also disregarded Supreme Court precedent. The *SunTrust* court gave little credence to the defendant’s argument that monetary damages could compensate the plaintiff: “Allowing the defendant to prevail on this basis would, ‘in effect, make any copyright holder an involuntary licensor of the copyright to any entity that could be relied on to pay damages.’ Such a policy would undoubtedly weaken the integrity of a copyrighted work.”<sup>101</sup> This statement simply cannot be reconciled with the *Campbell* Court’s earlier assertion:

Because the fair use enquiry often requires close questions of judgment as to the extent of permissible borrowing in cases involving parodies (or other critical works), courts may also

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98. *Id.* (citing *Campbell*, 510 U.S. at 593). The *Campbell* Court cited the statutory provision enumerating the derivative works right, 17 U.S.C. § 106(2). See *Campbell*, 510 U.S. at 593. It is undoubtedly circular reasoning to assert that the existence of a statutory provision evidences the fact that this right acts as an incentive. It is much more reasonable to say that Congress presumably anticipated that it will incentivize creators. Without some empirical evidence that it does, the existence of the statutory right is neither justification nor evidence that it provides an incentive.

99. *Campbell*, 510 U.S. at 592 (emphasis added).

100. 17 U.S.C. § 106(2) (2006).

101. *SunTrust I*, 136 F. Supp. 2d at 1384 (citation omitted) (quoting *Paramount Pictures Corp. v. Carol Publ’g Grp.*, 11 F. Supp. 2d 329, 338 (S.D.N.Y. 1998)).

wish to bear in mind that the goals of the copyright law, “to stimulate the creation and publication of edifying matter,” are not always best served by automatically granting injunctive relief *when parodists are found to have gone beyond the bounds of fair use*.<sup>102</sup>

The facts presented in the *SunTrust* case seem to be precisely the circumstances the *Campbell* Court foresaw. The *SunTrust* court did find that *The Wind Done Gone* “contain[ed] transformative parody that criticize[d]” *Gone with the Wind*, but went on to hold that “it does so no more than any other sequel to an original work.”<sup>103</sup> In other words, although the court recognized the parodic elements in *The Wind Done Gone*, it ultimately held that those elements were not sufficient to constitute fair use. This is precisely the set of circumstances the *Campbell* Court envisioned when it stated that the automatic grant of injunctive relief may sometimes be inappropriate. The *SunTrust* court’s divergence from *Campbell* shows that it viewed “the integrity of [the] copyrighted work” as primary and the defendant’s asserted defenses—fair use and the First Amendment—as secondary.<sup>104</sup>

A similar dynamic is at play in the district court’s decision in *Salinger v. Colting*. In the “Introduction” to its opinion, the Southern District of New York summarily held that “Plaintiff has shown that there is substantial similarity between *Catcher* and *60 Years*, as well as between the character Holden Caulfield from *Catcher*, and the character Mr. C from *60 Years*, such that it was an unauthorized infringement of Plaintiff’s copyright.”<sup>105</sup> This summary determination obscures the determination of which exclusive right in the copyright bundle was infringed. It is entirely unclear whether the court’s determination that there is substantial similarity between *Catcher* and *60 Years* is a finding that the exclusive right to copy the novel was infringed or that, as the plaintiff alleged, the exclusive right to prepare derivative works was infringed.<sup>106</sup> This is perhaps unsurprising because currently the consequences for infringing either right are

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102. *Campbell*, 510 U.S. at 578 n.10 (emphasis added) (citation omitted) (quoting Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1134 (1990)).

103. *SunTrust I*, 136 F. Supp. 2d at 1378.

104. *Id.* at 1384.

105. *Salinger v. Colting (Salinger I)*, 641 F. Supp. 2d 250, 254 (S.D.N.Y. 2009).

106. *Id.* For a comprehensive discussion of the issues associated with determining infringement of the derivative works right by reference to the substantial similarity test, see generally Paul Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. COPYRIGHT SOC’Y U.S.A. 209 (1983).

exactly the same. But when one considers the constitutional basis for copyright, it becomes clear that there should be some distinction between the consequences that flow from copying a protected work and those that accrue from creating a new work based on a protected work.<sup>107</sup> Treating an author of a secondary work the same way one treats a copier denies the fact that the secondary work is itself a work of authorship and has the bizarre consequence of utilizing the Copyright Act to restrict the distribution of a work which would otherwise be protected by it.<sup>108</sup> It is difficult to understand how such a result is justified in the context of the utilitarian objectives ascribed to copyright.<sup>109</sup>

Having made this summary determination of infringement, the remainder of the court's opinion considered whether Colting's use can properly be categorized as a fair use.<sup>110</sup> The vast majority of this consideration focused upon whether Colting's use was sufficiently transformative.<sup>111</sup> Ultimately, this question is shorthand for whether Colting's use is one which ought to require the permission of the copyright owner. In the face of assertions on the record that Salinger would never license this derivative use or any other, the Southern District of New York held that

although Salinger has not demonstrated any interest in publishing a sequel or other derivative work of *Catcher*, the Second Circuit has previously emphasized that it is the "potential market" for the copyrighted work and its derivatives that must be examined, even if the "author has disavowed any intention to publish them during his lifetime," given that an author "has the right to

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107. *See* *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 n.10 (1994) (citing *Leval*, *supra* note 102, at 1132) (recognizing that cases presenting something other than simple piracy require distinct treatment).

108. *See* 17 U.S.C. § 103(a) (2006) ("The subject matter of copyright as specified by section 102 includes . . . derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.").

109. *See infra* Part III (discussing the motivating principles behind copyright protection).

110. *See Salinger I*, 641 F. Supp. 2d at 254–68 (analyzing plaintiff's alleged fair use in terms of the purpose and character of the use, the nature of the copyrighted work, the amount and substantiality of the portion used in relation to the copyrighted work as a whole, and the effect of the use upon the potential market for or value of the copyrighted work).

111. *Id.* at 256–63 (ultimately finding a lack of transformative elements in *60 Years Later*).

change his mind” and is entitled to protect his *opportunity* to sell his [derivative works].<sup>112</sup>

The court then went on, just as the Northern District of Georgia had in *SunTrust*, to broaden the Supreme Court’s statement in *Campbell* that the licensing of derivatives acts as an important economic incentive to the creation of original works:

[S]ome artists may be further incentivized to create original works due to the availability of the right *not* to produce any sequels. This might be the case if, for instance, an author’s artistic vision includes leaving certain portions or aspects of his character’s story to the varied imaginations of his readers, or if he hopes that his readers will engage in discussion and speculation as to what happened subsequently. Just as licensing of derivatives is an important economic incentive to the creation of originals, so too will the right *not* to license derivatives sometimes act as an incentive to the creation of originals.<sup>113</sup>

The court here merged the idea of economic incentives that copyright is recognized as intending to provide with the more general idea of incentivizing authors.<sup>114</sup> There is no question that the incentive associated with the “right *not* to license” is not economic. Clearly, the refusal to license or create a derivative work means that this right in the copyright bundle is not being economically exploited. While incentivizing authors in ways that are not economic may well be a laudable goal, it is difficult to reconcile a right not to license with the accepted utilitarian objectives of copyright.

In both *SunTrust* and *Salinger*, we see the district courts broadening the Supreme Court’s pronouncements from *Campbell* to encompass the factual situations presented. In *SunTrust*, this is done by recharacterizing the derivative works right to include not only creation and licensing but also control. In *Salinger*, it is accomplished by broadening the idea of economic incentive to encompass the right not to license or create derivatives, a right which plainly is motivated by something other than economics. In both cases, the district courts found in favor of the plaintiffs and issued preliminary injunctions. These cases diverge at the appellate court level and, at least initially, on the courts’ considerations of the First Amendment.

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112. *Id.* at 268 (quoting *Salinger v. Random House, Inc.*, 811 F.2d 90, 99 (2d Cir. 1987)(alteration in original)).

113. *Id.*

114. See *infra* Part III (discussing the motivating principle behind copyright protection).

*D. The Decisions of the Appellate Courts: The Eleventh Circuit's First Amendment Decision Dressed Up in Fair Use Clothes Versus the Second Circuit's Focus on Irreparable Harm to the Exclusion of Considering Defendant's First Amendment Arguments*

In both *SunTrust v. Houghton Mifflin* and *Salinger v. Colting*, the defendants appealed the issuance of the preliminary injunctions.<sup>115</sup> Both defendants asserted that the preliminary injunction constituted a prior restraint in violation of the First Amendment, and both asserted that their uses were fair uses beyond the control of the copyright owner.<sup>116</sup> Both defendants prevailed on appeal.<sup>117</sup> Initially, the *SunTrust* defendant's victory appeared to be a victory for the First Amendment.<sup>118</sup> Ultimately, though, the *SunTrust* court recast its decision as one based upon fair use, finding that Randall's novel was a parody of *Gone with the Wind*.<sup>119</sup> In contrast, the *Salinger* defendant's reliance upon the First Amendment was almost entirely ignored by the Second Circuit.<sup>120</sup> Instead, the Second Circuit, relying on recent Supreme Court precedent, reversed and remanded for a determination of whether the plaintiffs would be irreparably harmed in the absence of preliminary injunctive relief.<sup>121</sup> The Southern District of New York's finding that *60 Years Later* was not a fair use of *Catcher* would remain

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115. Notice of Appeal, *SunTrust Bank v. Houghton Mifflin Co. (SunTrust I)*, 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01-CV-701-CAP); Notice of Appeal, *Salinger I*, 641 F. Supp. 2d 250 (No. 1:09-cv-05095-DAB).
116. Brief of Appellant Houghton Mifflin Co. at 18–35, 39, *SunTrust Bank v. Houghton Mifflin Co. (SunTrust III)*, 268 F.3d 1257 (11th Cir. 2001) (No. 01-122-00-HH) (“Considered in light of the First Amendment and the transformative uses made by [*The Wind Done Gone*] of [*Gone with the Wind*], the district court’s injunction is an unconstitutional prior restraint.”); Brief for Defendants-Appellants at 26, 37–57, *Salinger v. Colting (Salinger II)*, 607 F.3d 68 (2d Cir. 2010) (No. 09-2878-cv) (“Stopping the presses on this book, even for a short period of time, is a prior restraint that the First Amendment cannot tolerate.”).
117. *SunTrust Bank v. Houghton Mifflin Co. (SunTrust III)*, 268 F.3d 1257 (11th Cir. 2001); *Salinger v. Colting (Salinger II)*, 607 F.3d 68 (2d Cir. 2010).
118. *SunTrust Bank v. Houghton Mifflin Co. (SunTrust II)*, 252 F.3d 1165 (11th Cir. 2001).
119. *SunTrust III*, 268 F.3d at 1272 (“We have already determined that [*The Wind Done Gone*] is a parody . . .”).
120. *Salinger II*, 607 F.3d at 76 (“[W]e need not decide whether the preliminary injunction issued by the District Court constituted an unconstitutional prior restraint on speech.”).
121. *Salinger II*, 607 F.3d at 84 (citing *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006)).

intact.<sup>122</sup> Examining this divergence aids in understanding the varying positions that persist with regard to the degree of control over derivative uses understood to reside in copyright owners.

The day the *SunTrust* appeal was argued before the Eleventh Circuit, the court vacated the injunction issued by the Northern District of Georgia, stating, “It is manifest that the entry of a preliminary injunction in this copyright case was an abuse of discretion in that it represents an unlawful prior restraint in violation of the First Amendment.”<sup>123</sup> But five months later the Eleventh Circuit vacated that per curiam opinion and replaced it with an opinion recasting its previously unequivocal free speech statement in the guise of an assessment of the fair use factors.<sup>124</sup> That opinion cited the Court of Appeals for the District of Columbia Circuit’s opinion in *Eldred v. Reno* for the proposition that “[i]n copyright law, the balance between the First Amendment and copyright is preserved, in part, by the idea/expression dichotomy and the doctrine of fair use.”<sup>125</sup> Of course, the D.C. Circuit had gone much further, stating that “copyrights are categorically immune from challenges under the First Amendment.”<sup>126</sup> It is little wonder, then, that the remainder of the Eleventh Circuit’s substitute opinion was clothed in the framework of fair use.

Although this new opinion from the Eleventh Circuit privileged the fair use defense over the First Amendment, it is nonetheless clear that the First Amendment concerns expressed in the prior per curiam opinion remained present. The court said, “To approach these issues in the proper framework, we should initially review the history of the Constitution’s Copyright Clause and understand its relationship to the First Amendment.”<sup>127</sup> In stark contrast, the Second Circuit, in *Salinger v. Colting*, avoided the prior restraint issue altogether: “We

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122. *Id.* at 83 (“More serious is Defendants’ assertion of a fair use defense. And at this preliminary stage, we agree with the District Court that Defendants will not likely be able to make out such a defense.”).

123. *SunTrust Bank v. Houghton Mifflin Co. (SunTrust II)*, 252 F.3d 1165, 1166 (11th Cir. 2001).

124. *See SunTrust Bank v. Houghton Mifflin Co. (SunTrust III)*, 268 F.3d 1257 (11th Cir. 2001).

125. *Id.* at 1263 (citing *Eldred v. Reno*, 239 F.3d 372, 375 (D.C. Cir. 2001)); *see Eldred*, 239 F.3d at 375 (“The first amendment objection . . . was misplaced ‘[i]n view of the First Amendment protections already embodied in the Copyright Act’s distinction between copyrightable expression and uncopyrightable facts and ideas, and the latitude for scholarship and comment traditionally afforded by fair use.’”) (second alteration in original) (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1984))).

126. *Eldred*, 239 F.3d at 375.

127. *SunTrust III*, 268 F.3d at 1260.

agree that *eBay* abrogated parts of this Court’s preliminary injunction standard in copyright cases . . . . In light of that holding we need not decide whether the preliminary injunction issued by the District Court constituted an unconstitutional prior restraint on speech.”<sup>128</sup> The remainder of the Second Circuit opinion concerned itself primarily with demonstrating that *eBay*, which reversed the Federal Circuit’s presumption of irreparable harm in the context of issuance of a permanent injunction in a patent infringement case, applied with equal force in the context of the issuance of a preliminary injunction in this copyright infringement case.<sup>129</sup> In fact, the Second Circuit’s de novo consideration of the substance of *Salinger*’s copyright infringement claim begins and ends on the second-to-last page of the opinion. The court noted for reasons of judicial economy “that there is no reason to disturb the District Court’s conclusion as to the factor it did consider—namely, that *Salinger* is likely to succeed on the merits of his copyright infringement claim.”<sup>130</sup>

While the defendant’s First Amendment assertions went largely unheeded in *Salinger*, the Second Circuit did consider the First Amendment interests of the plaintiffs in its analysis of whether the plaintiffs had demonstrated that, in the absence of injunctive relief, they would be irreparably harmed.<sup>131</sup> As to the asserted First Amendment interests, the court said that “a defendant . . . has a core First Amendment interest in the freedom to express himself or herself, so long as that expression does not infringe the plaintiff’s copyright.”<sup>132</sup> This, of course, harkens back to the supremacy of copyright over the First Amendment observed in the district court opinions in both *Salinger* and *SunTrust*. The court then turned its attention to the First Amendment rights of the plaintiffs: “The plaintiff’s interest is, principally, a property interest in the copyrighted material. But . . . a copyright holder might also have a First Amendment interest in *not* speaking.”<sup>133</sup> The most obvious

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128. *Salinger v. Colting (Salinger II)*, 607 F.3d 68, 76 (2d Cir. 2010).

129. *Id.* at 77–78 (“We hold today that *eBay* applies with equal force (a) to preliminary injunctions (b) that are issued for alleged copyright infringement. First, nothing in the text or the logic of *eBay* suggests that its rule is limited to patent cases. On the contrary, *eBay* strongly indicates that the traditional principles of equity it employed are the presumptive standard for injunctions in any context.” (citing *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391–94 (2006))). Further, the court noted that the *eBay* Court’s reliance on copyright decisions constituted further evidence that *eBay* should apply in the copyright context. *Id.* at 77.

130. *Id.* at 83.

131. *Id.* at 81.

132. *Id.*

133. *Id.* (citation omitted).

critique of the court's assertion that the plaintiffs here have a right not to speak, protected by the First Amendment, is, of course, that the copyright holder is not being made to speak. It simply cannot be sustained that the publication of *60 Years Later* would be tantamount to government compulsion to express a particular viewpoint.<sup>134</sup> Rather, it is Colting, the author of *60 Years Later*, who, as a result of the issued injunction, is being made not to speak. This critique is further developed by a review of the cited precedent.

For the proposition that "a copyright holder might also have a First Amendment" right not to speak, the Second Circuit cited the Supreme Court's decision in *Harper & Row Publishers, Inc. v. Nation Enterprises*.<sup>135</sup> In *Harper & Row*, the Supreme Court considered whether *The Nation's* use of relatively short excerpts from the memoirs of President Ford to scoop an article slated to be run by another magazine prior to the release of the memoirs constituted fair use.<sup>136</sup> In coming to the conclusion that *The Nation's* use was not a fair use, the Court stated that "freedom of thought and expression 'includes both the right to speak freely and the right to refrain from speaking at all.'" <sup>137</sup> The Court went on to say, "Courts and commentators have recognized that copyright, and the right of first publication in particular, serve this countervailing First Amendment value."<sup>138</sup> Even if this premise is accepted as true, the facts of *Salinger* simply do not comport with the Supreme Court's holding in *Harper & Row*. Salinger had long since published *Catcher*, so any right of first publication was properly exercised. Moreover, it is difficult to comprehend how Colting's novel can be perceived as a compulsion of speech from Salinger. The Second Circuit's ultimate statement that "infringement of the right *not* to speak, 'for even minimal periods of time, unquestionably constitutes irreparable injury'" is plainly at odds with both the facts of the case and the precedent upon which it relies.<sup>139</sup> The court firmly rooted its decision that Salinger has the right to choose not to license or create derivative works and has the

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134. See, e.g., *Wooley v. Maynard*, 430 U.S. 705, 714 (1977) (holding that a New Hampshire statute requiring the display of the state motto "Live Free or Die" infringed upon Petitioner's right not to speak). The Court held "the right of freedom of thought protected by the First Amendment against state action includes both the right to speak freely and the right to refrain from speaking at all." *Id.*

135. *Salinger II*, 607 F.3d at 81 (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985)).

136. *Harper*, 471 U.S. 539.

137. *Id.* at 559 (quoting *Wooley*, 430 U. S. at 714).

138. *Harper*, 471 U.S. at 560.

139. *Salinger II*, 607 F.3d at 81 (quoting *Elrod v. Burns*, 427 U.S. 347, 373 (1976)).

right, by extension, to control the publication of derivative works by others in the First Amendment's protection of the right not to speak. And the court saw no need to revisit the specious argument that such a right, which is clearly lacking in an economic basis, is founded on copyright. The Eleventh Circuit, having found no similar First Amendment protection for the copyright owners of *Gone with the Wind*, went on to consider whether the Copyright Act itself establishes such a right.<sup>140</sup> In his concurrence, Judge Marcus answered this query unequivocally in the negative.<sup>141</sup>

Marcus's concurrence is notable for its treatment of the *SunTrust* plaintiff's admitted practice of exercising editorial control over licensed derivative works.<sup>142</sup> Marcus viewed this exercise as an attempt to "preserve *Gone With the Wind*'s reputation, or protect its story from 'taint'" and emphatically dismissed any role copyright law may play in such an endeavor, stating that SunTrust "may not now invoke copyright to further that goal."<sup>143</sup> He stated his opinion on this issue succinctly: "[I]t is not copyright's job to 'protect the reputation' of a work or guard it from 'taint' in any sense except an economic one . . . ."<sup>144</sup> Marcus took this a step further, generalizing to copyright owners as a class, stating that copyright "should not also afford them windfall damages for the publication of the sorts of works that they themselves would never publish, or worse, grant them a power of indirect censorship."<sup>145</sup> Marcus's concurrence, like the Eleventh Circuit's majority decision, holds that the plaintiff's refusal to create or license certain derivatives simply cannot be maintained by reference to copyright's utilitarian objectives.<sup>146</sup> Marcus's lack of ambiguity in this regard lends clarity to the fair use analysis that is so often lacking.

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140. *SunTrust Bank v. Houghton Mifflin Co. (SunTrust III)*, 268 F.3d 1257, 1276 (11th Cir. 2001) ("[SunTrust] has failed to show, at least at this early juncture in the case, how the publication of [*The Wind Done Gone*], a work that may have little to no appeal to the fans of [*Gone with the Wind*] who comprise the logical market for its authorized derivative works, will cause it irreparable injury. To the extent that Suntrust will suffer monetary harm from the infringement of its copyright, harms that may be remedied through the award of monetary damages are not considered 'irreparable.'").

141. *Id.* at 1282–83 (Marcus, J., concurring).

142. *Id.*

143. *Id.* at 1282.

144. *Id.* at 1280.

145. *Id.* at 1283.

146. For the majority's in-depth discussion of the history of copyright in the United States and its evidence of utilitarian purposes, see *id.* at 1260–63.

II. A BRIEF HISTORY OF COPYRIGHT  
IN THE UNITED STATES: A STUDY IN ACCRETION

Salinger's *Catcher*, written in 1951, will be protected by copyright until December 31, 2046.<sup>147</sup> At the time of its writing, under the provisions of the Copyright Act of 1909, *Catcher* would have been eligible for an initial term of twenty-eight years and a potential renewal term of twenty-eight years—a maximum of fifty-six years of copyright protection.<sup>148</sup> Assuming the renewal term was exercised, *Catcher* would have passed into the public domain in 2007, two years prior to the publication of Colting's novel. *Gone with the Wind* will remain under copyright until December 31, 2031, although, at the time of its publication in 1936, it too would have been afforded a maximum of 56 years protection. It would have passed into the public domain in 1992, nearly ten years before the writing of Randall's *The Wind Done Gone*.

Since the publication of *Gone with the Wind* and *Catcher*, the copyright term has been extended twice.<sup>149</sup> Under the 1976 Act, the copyright term in a work already in its renewal term as of the effective date of the Act was “extended to endure for a term of seventy-five years from the date copyright was originally secured.”<sup>150</sup> Under that formulation, *Gone with the Wind* would have passed into the public domain on January 1, 2012 and the copyright on *Catcher* would have ended on December 31, 2026. But Congress passed the Copyright Term Extension Act, which became effective October 27, 1998, extending these dates by an additional twenty years.<sup>151</sup>

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147. 17 U.S.C. § 304(b) (2006) (“Any copyright still in its renewal term at the time that the Sonny Bono Copyright Term Extension Act becomes effective shall have a copyright term of 95 years from the date copyright was originally secured.”).

148. Copyright Act of 1909, ch. 320, §§ 23–24, 35 Stat. 1075, 1080–1081 (1909) (repealed 1976), *reprinted in* COPYRIGHT ENACTMENTS: LAWS PASSED IN THE UNITED STATES SINCE 1783, COPYRIGHT OFFICE BULLETIN No. 3, at 73–74 (1973).

149. Copyright Act of 1976, Pub. L. No. 94-553, § 304(b), 90 Stat. 2541, 2574; Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, § 102(d)(1)(B), 112 Stat. 2827, 2828 (1998) (codified at 17 U.S.C. § 304(b) (2006)). In addition to these extensions, nine interim extensions for works copyrighted between September 19, 1906, and December 31, 1918 were passed between 1962 and 1974. *See* U.S. COPYRIGHT OFFICE, CIRCULAR 92, COPYRIGHT LAW OF THE UNITED STATES 141 n.7 (2011), *available at* <http://www.copyright.gov/title17/92chap3.html>.

150. 17 U.S.C. § 304(b).

151. Sonny Bono Copyright Term Extension Act § 102(d)(1)(B).

Before the writing of both *Gone with the Wind* and *Catcher*, Congress had already twice extended the copyright term. Under the 1790 Act, an author was afforded a term of fourteen years with a potential renewal term of fourteen years.<sup>152</sup> The renewal could be exercised only if the author was living at the end of the initial term.<sup>153</sup> A little over forty years later, Congress passed the Copyright Act of 1831, extending the initial term to twenty-eight years with a potential renewal term of fourteen years that could be exercised by a living author, or a widow or child of a deceased author.<sup>154</sup>

In addition to these term extensions, the scope of copyright protection has also gradually increased over time.<sup>155</sup> Of particular interest for this Article is the adoption and steady expansion of the adaptation right. The Copyright Act of 1790 included no adaptation right; it granted authors only the “right and liberty of printing, reprinting, publishing and vending” their works.<sup>156</sup> It was not until 1870 that Congress adopted a very limited adaptation right with regard to books.<sup>157</sup> In passing this legislation, Congress effectively overturned decisions like the one in *Stowe v. Thomas* where the Eastern District of Pennsylvania held that the German translation of Harriet Beecher Stowe’s *Uncle Tom’s Cabin* did not constitute copyright infringement.<sup>158</sup> The 1909 Act significantly broadened the adaptation right:

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152. Copyright Act of 1790 § 1, *reprinted in* COPYRIGHT ENACTMENTS, *supra* note 148, at 22.

153. *Id.*

154. Copyright Act of 1831 §§ 1–2, *reprinted in* COPYRIGHT ENACTMENTS, *supra* note 148, at 27.

155. “Scope” in this context refers to when the author means to make reference to both the categories of works that constitute copyrightable subject matter and the rights inherent in the copyright bundle. The original Copyright Act protected only maps, charts, and books. Copyright Act of 1790 § 1, *reprinted in* COPYRIGHT ENACTMENTS, *supra* note 148. In contrast, the current Copyright Act protects “original works of authorship fixed in any tangible medium of expression” and lists eight non-exclusive categories of copyrightable works: (1) literary works, (2) musical works, (3) dramatic works, (4) pantomimes and choreographic works, (5) pictorial, graphic, and sculptural works, (6) motion pictures and other audiovisual works, (7) sound recordings, and (8) architectural works. 17 U.S.C. § 102 (2006).

156. Copyright Act of 1790 § 1, *reprinted in* COPYRIGHT ENACTMENTS, *supra* note 148, at 22.

157. Copyright Act of 1870 § 86, *reprinted in* COPYRIGHT ENACTMENTS, *supra* note 148, at 37 (“authors may reserve the right to dramatize or to translate their own works.”).

158. *Stowe v. Thomas*, 23 F. Cas. 201, 208 (E.D. Pa. 1853) (No. 13,514).

To translate the copyrighted work into other languages or dialects, or make any other version thereof, if it be a literary work; to dramatize it if it be a nondramatic work; to convert it into a novel or other nondramatic work if it be a drama; to arrange or adapt it if it be a musical work; to complete, execute, and finish it if it be a model or design for a work of art . . . .<sup>159</sup>

The 1976 Act again considerably expanded the adaptation right, introducing the term “derivative work” into copyright’s statutory scheme for the first time.<sup>160</sup> Under the 1976 Act, copyright holders have the exclusive right “to prepare derivative works based upon the copyrighted work,”<sup>161</sup> and the term “derivative work” is broadly defined as “a work based upon one or more preexisting works, such as a translation, . . . dramatization, fictionalization, motion picture version, . . . abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted.”<sup>162</sup> This steady growth of the adaptation right is the reason the *SunTrust* and *Salinger* plaintiffs can utilize the current derivative works right to argue that they are entitled to control all derivative uses during the copyright term. The current broad scope of the adaptation right is why the plaintiffs can refuse to deal and, as such, it begs the question of whether the current right is in line with the historical and constitutional purposes of copyright.<sup>163</sup>

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159. Copyright Act of 1909 § 1(b), *reprinted in* COPYRIGHT ENACTMENTS, *supra* note 149, at 64.

160. Copyright Act of 1976, Pub. L. No. 94-553, § 106(2), 90 Stat. 2541, 2546 (codified as 17 U.S.C. § 106(2) (2006)); Pamela Samuelson, *The Quest for a Sound Conception of Copyright’s Derivative Work Right*, 101 GEO. L.J. (forthcoming 2013) (manuscript at 2), *available at* <http://ssrn.com/abstract=2138479>.

161. 17 U.S.C. § 106(2).

162. 17 U.S.C. § 101.

163. *See* Rubinfeld, *supra* note 14, at 53–54 (arguing that the broad derivative works right conflicts with the First Amendment by suppressing acts of imagination).

III. IN SEARCH OF A MOTIVATING PRINCIPLE:  
WHY DO WE PROTECT COPYRIGHT AND HOW DOES THIS  
INFORM OUR UNDERSTANDING OF THE APPROPRIATE  
CONTOURS OF THE DERIVATIVE WORKS RIGHT?

Understanding why copyright is protected is necessary to understand the appropriate parameters of copyright protection. The reasons for protecting copyright are multifaceted and nuanced.<sup>164</sup> In both the cases and the scholarship, such varied justifications as utilitarianism and personhood are proffered.<sup>165</sup> The utilitarian argument posits that the protection of copyright serves the public good by incentivizing creators who enrich the public domain.<sup>166</sup> Personhood theory asserts that creative works are an expression of the author's personality, and, therefore, the author's interest in the work is more than pecuniary—it is dignitary.<sup>167</sup> In Europe, personhood theory is often asserted as the theoretical basis for moral rights.<sup>168</sup>

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164. See generally Samuel E. Trosow, *The Illusive Search for Justificatory Theories: Copyright, Commodification and Capital*, 16 CAN. J.L. & JURISPRUDENCE 217 (2003) (discussing the traditional philosophical justifications underlying copyrights and their consistency with modern copyright expansion).

165. William Fisher, *Theories of Intellectual Property*, in NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROPERTY 168 (Stephen R. Munzer ed., 2001).

166. See, e.g., *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The copyright law, like the patent statutes, makes reward to the owner a secondary consideration. . . . The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors . . . .” (internal quotation marks omitted)); L. Ray Patterson & Craig Joyce, *Copyright in 1791: An Essay Concerning the Founders’ View of the Copyright Power Granted to Congress in Article I, Section 8, Clause 8 of the U.S. Constitution*, 52 EMORY L.J. 909 (2003) (arguing that the Founders viewed the Copyright Clause as regulatory rather than proprietary and advancing the policies of promoting learning, providing public access, and protecting the public domain).

167. See, e.g., *Gilliam v. Am. Broad. Cos.*, 538 F.2d 14 (2d Cir. 1976) (reversing the district court’s denial of injunctive relief and finding that the plaintiffs were likely to prevail on their claims including a claim that defendant’s editing of their work constituted actionable mutilation of the work); see also Margaret Jane Radin, *Property and Personhood*, 34 STAN. L. REV. 957, 1014 n.202 (1982) (mentioning the development of the *droit moral* (moral right) claim aimed at giving artists the right to protect their works from alteration and destruction).

168. KWALL, *supra* note 20, at 5 (“In other countries, the intrinsic dimension of the creative process is recognized independently of the external commodity through moral rights laws that protect the personal, as opposed to the economic, rights of authors.”).

In addition to utilitarianism and personhood theory, the theory that copyright serves to reward authors for their labor is still occasionally referenced by courts. Although the Supreme Court soundly rejected this theory in 1991 in *Feist Publications, Inc. v. Rural Telephone Co.*,<sup>169</sup> the Court's recent decision in *Golan v. Holder*, at least arguably, breathed new life into this theory. The *Golan* Court said that the Uruguay Round Agreements Act<sup>170</sup> gave authors "nothing more than the benefit of their labors during whatever time remains before the normal copyright term expires."<sup>171</sup>

Finally, the idea that copyright is protected because it is property tends to make its way into decisions as well.<sup>172</sup> But this fails to advance the discussion because it does not explain what property is or why we protect it. Property is itself a legal regime in search of a motivating principle.<sup>173</sup> This question has been addressed by a long line of scholars who have come to diverse conclusions, including (1) property protects that which one takes control of by investing one's labor into it<sup>174</sup> and (2) personal property exists to maximize the wealth of society.<sup>175</sup> Margaret Jane Radin is known for her personality theory of property, which seeks to justify property rights in the first instance and to delineate circumstances in which certain property interests should be privileged over others.<sup>176</sup> In yet another attempt to justify the protection of personal property, Oliver Wendell Holmes Jr., in an oft-cited passage, said:

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169. *Feist Publ'ns, Inc. v. Rural Tel. Co.*, 499 U.S. 340, 349 (1991) ("The primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts.'" (alteration in original) (quoting U.S. CONST. art. I, § 8, cl. 8)).

170. Uruguay Round Agreements Act, Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976 (1994) (amending 17 U.S.C. § 104A).

171. *Golan v. Holder*, 132 S. Ct. 873, 893 (2012).

172. *See, e.g.*, *Salinger v. Random House, Inc.*, 811 F.2d 90, 94–95 (2d Cir. 1987) (recognizing that owners of copyrights for unpublished materials nonetheless hold literary property rights).

173. *See generally* ERIC T. FREYFOGLE, ON PRIVATE PROPERTY 89–104 (2007) (discussing the various rationales and tensions underlying property as a concept).

174. *See, e.g.*, RICHARD SCHLATTER, PRIVATE PROPERTY (1951) (reviewing the theoretical history of property and suggesting that labor theory persists in both socialist and capitalist economies).

175. *See, e.g.*, Harold Demsetz, *Toward a Theory of Property Rights*, 57 AM. ECON. REV. 347, 350 (1967) ("[P]roperty rights develop to internalize externalities when the gains of internalization become larger than the cost of internalization.").

176. *See generally* Radin, *supra* note 167.

It is in the nature of man's mind. A thing which you have enjoyed and used as your own for a long time, whether property or an opinion, takes root in your being and cannot be torn away without your resenting the act and trying to defend yourself, however you came by it. The law can ask no better justification than the deepest instincts of man.<sup>177</sup>

As noted above, each of these theories has a corollary in the intellectual property literature. While the utilitarian theory has predominated the discourse,<sup>178</sup> this Article engages the idea that justifications for copyright are more nuanced<sup>179</sup> and, moreover, that the touchstone for our copyright policy ought to always be the Constitution.<sup>180</sup>

Getting back to the historical beginnings of copyright in this country requires that we acknowledge that the Copyright Act of 1976 represents an exercise of Congress's limited powers as vested by the Constitution.<sup>181</sup> The Copyright Clause of the Constitution reads: "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>182</sup> Along with the Supreme Court in both *Eldred v. Ashcroft* and *Golan v. Holder*, a great many scholars have considered whether the current iteration of the Copyright Act is in keeping with the Constitution's directive.<sup>183</sup> The purpose of this Article is much less ambitious. It is to utilize this constitutional framework as I consider the problems presented by the derivative works right as demonstrated by the comparison of the *Gone with the Wind* case to the *Catcher* case. The difference in the outcomes of these two cases demonstrates that the degree of protection copyright affords tends to defy predictability. A better understanding of why we protect copyright will assist in determining how we ought to protect copyright.

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177. O. W. Holmes, *The Path of the Law*, 10 HARV. L. REV. 457, 477 (1897).

178. KWALL, *supra* note 20, at 23.

179. *See generally* Alfred C. Yen, *The Interdisciplinary Future of Copyright Theory*, 10 CARDOZO ARTS & ENT. L.J. 423 (1992) (calling for greater incorporation of moral right rationales into copyright law while preserving aspects of the utilitarian economic model).

180. PATTERSON & BIRCH, *supra* note 94, at 258.

181. *See id.* at 241–79 (detailing both the historical underpinnings of the Copyright Clause and the structure of the Copyright Act of 1976).

182. U.S. CONST. art. I, § 8, cls. 1, 8.

183. *See, e.g.*, Peter A. Jaszi, *Goodbye to All That—A Reluctant (and Perhaps Premature) Adieu to a Constitutionally-Grounded Discourse of Public Interest in Copyright Law*, 29 VAND. J. TRANSNAT'L L. 595 (1996) (suggesting that a new constitutional framework is needed to combat copyright expansion by the courts and legislature).

While utilitarianism is often identified as the predominant theory underlying the American system of copyright, there is no question that the other theories are also deployed by parties and referenced by courts. There is a great deal of scholarship that longs for copyright's return to its utilitarian beginnings.<sup>184</sup> Utilitarianism, while important, is not and cannot be the sole justification for protecting an author's interest in his or her creative works.<sup>185</sup> Rather, as seen in the case comparison above, the way that the derivative works right is deployed by copyright owners and understood by many courts demonstrates the intuitive appeal of moral rights concepts.<sup>186</sup> It follows that the appropriate way to vindicate such a right is through legislative protection rather than attempting to protect it within the guise of rights that make up part of the copyright bundle. Therefore, if we maintain that the copyright bundle represented by 17 U.S.C. § 106 ought to be directed at the protection of a copyright owner's economic rights and, therefore, justified by utilitarian concepts, the derivative works right in its current form is unjustifiable and should be repealed and replaced with a much more limited adaptation right. Further, if we accept that an author's moral right of integrity ought to be protected, the statute should provide that protection transparently and in a more limited fashion.

#### IV. HOW DO WE SOLVE THE PROBLEM OF THE DERIVATIVE WORKS RIGHT?

##### A. *What Is the Problem of the Derivative Works Right?*

Much has been written about the problems presented by the expansive definition of the term "derivative work" in the Copyright Act of 1976.<sup>187</sup> Succinctly, the major contentions are that the derivative works right (1) places the Copyright Act in direct conflict with the First Amendment and the Copyright Clause of the

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184. See, e.g., PATTERSON & BIRCH, *supra* note 94, at 392 ("[T]he communications revolution . . . requires a return to fundamentals. . . . [C]opyright has only one purpose: to promote learning. But it has multiple functions to fulfill that purpose: to encourage the creation, dissemination, and use of learning materials.").

185. See Madhavi Sunder, *IP<sup>3</sup>*, 59 STAN. L. REV. 257, 263 (2006) ("[T]raditional law and economics analysis fails to capture fully the struggles at the heart of . . . intellectual property law conflicts."); Yen, *supra* note 179 (noting the importance of combining the utilitarian economic model with other justifications for copyright).

186. See *supra* Part I.

187. See, e.g., Naomi Abe Voegtli, *Rethinking Derivative Rights*, 63 BROOK. L. REV. 1213, 1218–32 (1997) (noting problems of interpretation).

Constitution,<sup>188</sup> (2) undercuts the idea/expression dichotomy,<sup>189</sup> and (3) inserts uncertainty on the part of secondary users in light of the fact that the vast majority of derivative works cases are decided on the basis of the notoriously unpredictable fair use doctrine.<sup>190</sup> The statutory definition of “derivative work” is so expansive that, arguably, it unhinges copyright from its constitutional and historical moorings.

It has long been asserted that the statutory monopoly of copyright is held in check by two principles inherent in copyright law: the idea/expression dichotomy and the fair use doctrine.<sup>191</sup> The idea/expression dichotomy is the principle that copyright does not protect the ideas embodied in copyrightable works but rather the expression in which those ideas are conveyed.<sup>192</sup> The idea/expression

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188. See Christina Bohannon, *Taming the Derivative Works Right: A Modest Proposal for Reducing Overbreadth and Vagueness in Copyright*, 12 VAND. J. ENT. & TECH. L. 669, 689 (2010) (“The derivative works right demands greater First Amendment scrutiny because it prohibits speaking as well as copying.”); John M. Newman, Note, *Holden Caulfield Grows Up: Salinger v. Colting, the Promotion-of-Progress Requirement, and Market Failure in a Derivative-Works Regime*, 96 IOWA L. REV. 737, 747 (2011) (noting the clash between copyright and the First Amendment).

189. See, e.g., Dennis S. Karjala, *Harry Potter, Tanya Grotter, and the Copyright Derivative Work*, 38 ARIZ. ST. L.J. 17, 23 (2006) (noting that courts sometimes mistakenly disregard this dichotomy).

190. See Alfred C. Yen, *When Authors Won't Sell: Parody, Fair Use, and Efficiency in Copyright Law*, 62 U. COLO. L. REV. 79, 88 (1991) (referring to the nebulous character of the fair use doctrine).

191. See Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and the Press?*, 17 UCLA L. REV. 1180, 1203–04 (1970) (arguing that copyright is held in check by the idea/expression dichotomy and also positing that the limited duration of copyright is a factor in checking the copyright monopoly). It is important to note that at the time Nimmer was writing the copyright term was twenty-eight years with a potential renewal term of twenty-eight years. *Id.* at 1194.

192. The idea/expression dichotomy was first recognized by the Supreme Court in *Baker v. Selden*, 101 U.S. 99, 104 (1880), which noted that the “essence” of the work—and that part of it that copyright protects—lies in its “statement.” This doctrine, like many other copyright doctrines, comes to American jurisprudence from England. The late eighteenth-century cases of *Millar v. Taylor*, (1769) 98 Eng. Rep. 201 (K.B.) 229; 4 Burr. 2303, 2355 (Yates J., dissenting), and *Donaldson v. Beckett*, (1774) 1 Eng. Rep. 837 (H.L.) 840; 2 Brown 129, 135, are noted as the basis of doctrine in English jurisprudence. Like the fair use doctrine, idea/expression was first codified in the Copyright Act of 1976, 17 U.S.C. § 101 (2006). For a full explication of the history of the doctrine and how it functions in American jurisprudence, see Edward Samuels, *The Idea-Expression Dichotomy in Copyright Law*, 56 TENN. L. REV. 321, 325 (1989).

dichotomy is codified in the Copyright Act at 17 U.S.C. § 102(b).<sup>193</sup> The fair use doctrine was originally a judge-made privilege allowing uses of copyrighted works in those instances in which allowing the use would further the purposes of copyright.<sup>194</sup> The fair use doctrine was codified for the first time in the 1976 Act at 17 U.S.C. § 107.<sup>195</sup> The expansive definition of the derivative works right provided in the 1976 Act and, more specifically, the way that right is utilized by parties and understood by some courts, calls into question the longstanding notion that the idea/expression dichotomy and fair use doctrine can properly contain the copyright monopoly.

The argument advanced here is that the derivative works right, as it is currently deployed and understood, cannot be justified by the

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193. 17 U.S.C. § 102(b) (2006) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”).

194. The doctrine of “fair abridgement” was recognized in England as early as 1761 in the case of *Dodsley v. Kinnersley*, (1761) 27 Eng. Rep. 270 (K.B.) 271. “Fair abridgement” was imported into American jurisprudence in the case of *Folsom v. Marsh*, 9 F. Cas. 342, 345, 348 (C.C.D. Mass. 1841) (No. 4901). The terminology “fair use” entered American jurisprudence in *Lawrence v. Dana*, 15 F. Cas. 26, 61 (C.C.D. Mass. 1869) (No. 8136). See also *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 475 n.27 (1984) (describing the history of the fair use doctrine in American case law).

195. 17 U.S.C. § 107 (2006):

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include —

- (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;
- (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.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

accepted utilitarian justifications for copyright law. To the extent that the interest intuitively protected by the derivative works right is deserving of protection, a separate justification and different parameters are required.

The idea that the derivative works right is justified by utilitarian considerations has been advanced<sup>196</sup> and refuted.<sup>197</sup> Any claim that the derivative works right ought to be protected because it is property fails for all of the reasons that the argument to protect copyright because it is property fails.<sup>198</sup> Specifically, the derivative works right is unlike any right we comprehend as a part of the bundle of rights associated with tangible property. As demonstrated above, the right to an injunction in the context of asserted infringement of the derivative works right has been analogized to the right of a landowner to exclude trespassers.<sup>199</sup> This analogy is unavailing because, as compared to all five of the other rights encompassed in the copyright bundle, the right to exclude as applied to realty is a right to disallow another from having control over or access to some particular commodity. It is not, and has never been understood as, the right to disallow another from having access to or control over a different (though perhaps related) commodity. The preceding case comparison demonstrated that the copyright owners in the cases concerning *Gone with the Wind* and *Catcher* understood the derivative works right as something other than a pecuniary right—something akin to the moral right of integrity.

### B. *What are Moral Rights?*

The phrase “moral rights” refers to a suite of rights intended to protect an author’s nonpecuniary interests in his or her creation.<sup>200</sup>

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196. William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 353–57 (1989) (discussing the issue from the perspective of transaction costs, among related principles).

197. Stewart E. Sterk, *Rhetoric and Reality in Copyright Law*, 94 MICH. L. REV. 1197, 1217 (1996) (“Landes and Posner argue that giving derivative rights to the original owner reduces transaction costs by requiring a publisher who wants to bring out a new translation of a previously translated work to deal with only one copyright holder rather than two. On this point, they are simply wrong. If the copyright in the original did not extend to derivative works, the publisher of the translation would not have to obtain the original author’s consent.” (citing Landes & Posner, *supra* note 196)).

198. See *supra* Part III.

199. See *supra* note 92.

200. See Susan P. Liemer, *Understanding Artists’ Moral Right, A Primer*, 7 B.U. PUB. INT. L.J. 41, 44 (1998) (describing moral rights and arguing that they protect the integrity of the “creative process”).

These rights include, but are not necessarily limited to, the rights of attribution, disclosure, withdrawal, and integrity.<sup>201</sup> The right of attribution is defined as the right to have one's work identified as such.<sup>202</sup> The right of disclosure is the right of an "author to determine publication or nonpublication of his or her work."<sup>203</sup> The limited right of withdrawal is the right, recognized only rarely outside of France, to retract a previously published work.<sup>204</sup> Finally, the right of integrity is defined as "the right of authors to preserve their work from alteration, mutilation, or even, in some circumstances, excessive criticism."<sup>205</sup> One commentator stated that the right of integrity "recognizes the work as an extension of the author's personality."<sup>206</sup> This right is said to safeguard the author's creative vision by guaranteeing the integrity of his or her text.<sup>207</sup> This interest is demonstrably personal in nature, and as a result, where the right is recognized, it is generally seen as inalienable.<sup>208</sup>

## V. A PROPOSED SOLUTION: UNDERSTANDING THE DERIVATIVE WORKS RIGHT AS A MORAL RIGHT

If one accepts the proposition that an author ought to have the right to protect the integrity of his or her work, as the copyright owners in both *Salinger* and *SunTrust* asserted and as the trial courts and the Second Circuit confirmed, there is no question that the Copyright Act of 1976, while it may be contorted to address such a claim, was not intended to do so.<sup>209</sup> The existing, expansive, exclusive derivative works provision is unjustifiable as a utilitarian mechanism.<sup>210</sup> The problems it presents for the freedom of expression

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201. *Id.* at 46.

202. Settlemeyer, *supra* note 71, at 2304.

203. Richard Fine, *American Authorship and the Ghost of Moral Rights*, 13 BOOK HIST. 218, 222 (2010).

204. Jeffrey M. Dine, Note, *Authors' Moral Rights in Non-European Nations: International Agreements, Economics*, Mannu Bhandari, *And The Dead Sea Scrolls*, 16 MICH. J. INT'L L. 545, 551 (1995) ("The right of withdrawal is the least exercised moral right. Its formal existence is rare outside France and countries that derive their law from France.").

205. Fine, *supra* note 203, at 223.

206. Heide, *supra* note 22, at 214.

207. Lior Zemer, Essay, *Moral Rights: Limited Edition*, 91 B.U. L. REV. 1519, 1524 (2011).

208. *Id.* ("Due to the special connection between the author's personality and the work, civil law systems have traditionally regarded moral rights as inalienable . . .").

209. KWALL, *supra* note 20, at 25–27.

210. See *supra* notes 197–98 and accompanying text.

of secondary users cannot be justified by whatever minimal economic incentive it provides to copyright holders. Repealing it and replacing it with a more limited adaptation right subject to a compulsory license would protect the pecuniary interests in adaptation. That more limited right might mirror the exclusive adaptation right delineated in the Berne Convention for the Protection of Literary and Artistic Works: “Authors of literary or artistic works shall enjoy the exclusive right of authorizing adaptations, arrangements and other alterations of their works.”<sup>211</sup>

A new § 106B aimed at protecting an author’s integrity right would plainly state its intent and justification as the protection of an author’s work from distortion, mutilation, or other modification which is prejudicial to his or her reputation.

It is important to note that nothing in this proposal is intended to deny copyright protection for derivative works. Derivative works would continue to be protected to the same extent as provided for under current law.<sup>212</sup> Copyright owners will still be able to create derivatives, copyright those derivatives, and profit from them. All this proposal aims to do is limit the *exclusive* right to create and license derivative works, as broadly defined by the 1976 Act. The practical effect of this change is that secondary users seeking to create derivative works will not need the permission of the copyright owner and will not be liable to the copyright owner who refuses to deal. In fact, it will be possible for any party to create a derivative work upon payment of the license fee so long as the limited right of integrity represented by the new § 106B is not infringed.

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211. Berne Convention for the Protection of Literary and Artistic Works, art. 12, July 24, 1971, S. Treaty Doc. No. 99-27, Hein’s No. KAV 2245. Note that Article 8 also provides for an exclusive right of translation. *Id.* art. 8.

212. *See* 17 U.S.C. § 103 (2006):

- (a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.
- (b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

A. *The Contours of the New Section 106B*

Consider the fact that under current law, works created after January 1, 1978 will be protected by copyright, including the expansive derivative works right, for the life of the author plus seventy years.<sup>213</sup> Under this formulation, the copyright in *Catcher* would last until the end of 2080—nearly 130 years. Margaret Mitchell died thirteen years after the publication of *Gone with the Wind*. Consider the absurdity of the fact that the derivative works right has subsisted in her estate for more than sixty years and will continue to subsist in her estate for another twenty years. Likewise, for the next thirty-five years, the derivative works right associated with *Catcher* will be owned exclusively by Salinger’s heirs or the beneficiaries named in his will. It is unfathomable that ownership of such a right by the author’s next of kin or successors in interest encourages innovation more than allowing the right to pass into the public domain would. The new moral right proposed here would last for the lifetime of the author, would not be transferable but would be waivable, would not apply to works made for hire, and would be subject to the fair use doctrine.

The contours of the Visual Artists Rights Act (VARA) are instructive.<sup>214</sup> In 1990, Congress passed VARA to afford visual artists certain “rights of attribution and integrity.”<sup>215</sup> For works created after the effective date of VARA, the rights of attribution and integrity created by VARA “endure for a term consisting of the life of the author.”<sup>216</sup> VARA is the sole explicit recognition of moral rights in the federal statutory scheme.

The limitation to the lifetime of the author is appropriate for the same reason that the right created ought not to be transferable. That is, as noted by Professor Kwall in her recent work *The Soul of Creativity*, “[a]n author’s external work embodies her personal meaning and intended message and thus is reflective of her individual, intrinsic, creative process. No one, not even her spouse and children, can substitute a personal judgment regarding the substance of the author’s meaning and message.”<sup>217</sup> This is the basis for Kwall’s assertion that “moral rights protection should expire upon the death of the author.”<sup>218</sup> Moreover, limitation to the lifetime of the author makes sense because once the author is deceased protection of his or

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213. 17 U.S.C. § 302 (2006).

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

215. 17 U.S.C. § 106A(a).

216. 17 U.S.C. § 106A(d)(1).

217. Kwall, *supra* note 20, at 160.

218. *Id.*

her reputation is a nonissue. Finally, works made for hire should be ineligible for protection under the new § 106B because the right sought to be vindicated here, that is, the author's right to maintain the integrity of his or her work from distortion that would harm the author's reputation, is inherently personal. It would be anathema to confer such a right on a corporate entity.

*B. Considering the Implications of the New Section 106B:  
Hypothetical Resolutions of SunTrust and Salinger*

Under the proposal made here, both *SunTrust* and *Salinger* would have been resolved much more expeditiously. As an initial matter, the plaintiff in *SunTrust* would not have had standing to bring its suit because the right it would have had to rely upon would have expired upon Mitchell's death. Even if suit were brought, no claim would lie under the Copyright Act, and the copyright owner would be left to resort to claims of trademark infringement.<sup>219</sup> Likewise, in *Salinger*, the author would have had a claim that likely would have settled early in recognition of the right imbued by § 106B, or it would have expired upon Salinger's death.<sup>220</sup>

## CONCLUSION

The Supreme Court's recent decision in *Golan v. Holder* all but forecloses First Amendment arguments in the context of copyright. This leaves alleged infringers to resort to arguments based upon fair use. The case comparison undertaken here illustrates the unpredictability inherent in proceeding under the fair use banner. The cases concerning *Gone with the Wind* and *Catcher* are factually similar and yet come to very different ends. This Article suggests that one reason for this disparity is that the interest often sought to be vindicated by copyright owners under the guise of the derivative works right is personal rather than pecuniary. With that in mind, the Article proposes that Congress repeal the existing § 106(2) and replace it with a limited adaptation right subject to a compulsory license and a moral right of integrity. This would introduce transparency, disallow successors in interest from refusing to deal, and

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219. SunTrust Complaint, *supra* note 42, at 15–17.

220. J.D. Salinger died while the Appeal to the Second Circuit was pending. See *Salinger v. Colting (Salinger II)*, 607 F.3d 68, 70 n.1 (2d Cir. 2010) (“We note that Plaintiff-Appellee J.D. Salinger died during the pendency of this appeal. In a February 18, 2010 order, we granted the motion of Colleen M. Salinger and Matthew R. Salinger, trustees of the J.D. Salinger Literary Trust, to be substituted for Salinger as Appellees. For reasons of convenience, however, we will continue to refer to Salinger as ‘Plaintiff’ or ‘Appellee’ in this opinion.”).

have the added benefit of reining copyright in by reference to its constitutional and historical background.



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