

Copyright in Library-Held Materials: A Decision Tree for Librarians*

Scott J. Burnham**

In this article, Professor Burnham helps librarians determine the copyright status of works in the library's collection. With that information, the library is in a better position to decide what uses can be made of the works and to recognize the consequences if the library makes an erroneous decision. Finally, he applies the suggested method to a hypothetical example.

¶1 Librarians are frequently faced with decisions regarding permissible uses of the works in their collections. For example, a patron might wish to copy a work, another library might ask to reproduce a work, or the library might consider posting some of its collection online. The purpose of this article is to help librarians develop a process for deciding the copyright aspect of those determinations and to provide guidance on permissible uses of the works in a library's collection.¹

¶2 In terms of copyright law, the decision-making process involves four lines of inquiry:

1. Does the library own the copyright?
If YES, copyright law permits the library to use the work.
If NO,
2. Is the work in the public domain (not protected by copyright)?
If YES, the library may use the work, and others who have access to it may also use it.
If NO,
3. If someone else owns the copyright, can the library permit the use?
4. If the library's analysis is wrong, what can happen to it?

¶3 In this article, I will examine each of these issues in detail, and then apply the results of this analysis to a hypothetical case to demonstrate how the decision-making process might work in an actual example.

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** Professor of Law, The University of Montana School of Law, Missoula, Montana. This article is based on a presentation given by the author at the Northwest Archivists Annual Conference, May 1999.

1. There are considerations other than copyright that are beyond the scope of this article. Those considerations are discussed in GARY M. PETERSON & TRUDY HUSKAMP PETERSON, ARCHIVES & MANUSCRIPTS: LAW (1985). This article is also confined to American works. On copyright issues, the best sources are PAUL GOLDSTEIN, COPYRIGHT (2d ed. 1996 & Supp. 2004); and MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT (1978 & Supp. 2004).

Does the Library Own the Copyright?

Is the Work Published or Unpublished?

¶4 In making the determinations that follow, we will frequently distinguish between published works and unpublished works. What does it mean that a work has been published? The rule of thumb is that “a general publication occurred ‘when a work was made available to members of the public at large without regard to their identity or what they intended to do with the work.’”² That quote is from a 1999 case involving Martin Luther King Jr.’s “I Had a Dream” speech, which was given in 1963, at a time when publication of a work without notice of copyright divested the work of copyright protection. Because an otherwise unpublished written work is not considered published by oral transmission, the broadcast of the speech—even to hundreds of millions of listeners—was not sufficient to publish it. The problem arose because King’s aides distributed a number of copies of the work without a copyright notice affixed. An earlier 1963 case held that because that distribution was to the press and not to the public, the “limited” publication did not divest the work of copyright protection,³ but the 1999 case found there were so many disputed facts regarding the extent of the distribution and whether it was authorized that the issue could not be decided without a trial.

¶5 Determining whether a work has been published is equally difficult with respect to visual works. It is generally held that display of a work of art in a gallery is not a general publication because the public does not have access to it for all purposes.⁴ On the other hand, when the city of Chicago displayed its monumental Picasso sculpture in a public square with no restrictions on public access, a court held that the work was published.⁵

¶6 Once it has been determined whether the work is published or unpublished, the next step is to determine whether the library is the copyright owner.

The Day of Copyright Liberation: December 31, 2002

¶7 If the library owns the copyright in a work, it can exercise all the rights of a copyright owner, including deciding whether to authorize others to use the work

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2. Estate of Martin Luther King, Jr. v. CBS, 194 F.3d 1211, 1214 (11th Cir. 1999) (quoting American Vitagraph, Inc. v. Levy, 659 F.2d 1023, 1026–27 (9th Cir. 1981), citing Burke v. NBC, 598 F.2d 688, 691 (1st Cir. 1979)).
 3. King v. Mister Maestro, Inc., 224 F. Supp. 101 (S.D.N.Y. 1963). At the time of the speech in 1963, the applicable 1909 Copyright Act provided that a work that was published without proper notice lost copyright protection. This is no longer the case. Works created on or after March 1, 1989, the effective date of the Berne Convention Implementation Act’s amendments to the 1976 Copyright Act, do not require notice for copyright protection. 17 U.S.C. § 401 (2000).
 4. “It appears from the case law that a general publication occurs only in two situations. First, a general publication occurs if tangible copies of the work are distributed to the general public in such a manner as allows the public to exercise dominion and control over the work. Second, a general publication may occur if the work is exhibited or displayed in such a manner as to permit unrestricted copying by the general public.” *Estate of Martin Luther King, Jr.*, 194 F.3d at 1215 (citations omitted).
 5. Letter Edged in Black Press, Inc. v. Pub. Bldg. Comm’n, 320 F. Supp. 1303 (D. Ill. 1970).

in the ways reserved exclusively to copyright owners.⁶ A short while ago, libraries were faced with a decision as to whether to protect their interest as copyright owners or their interest in public access. To explain why they had this choice, it is necessary to provide some background. In the American system, the Constitution gives Congress the power to create a copyright scheme.⁷ Under the federal schemes that were effective prior to 1978, federal copyright protection attached upon publication of the work. Unpublished works were governed by state copyright law, often called common law copyright. That scheme was changed by the Copyright Act of 1976,⁸ which became effective on January 1, 1978. Under the Act, federal copyright protection attaches on creation, not publication, of the work. Beginning January 1, 1978, therefore, common law copyrights became much more scarce.⁹

¶8 The Act also provided for the eventual termination of common law copyrights that were created before the effective date of the Act. Section 303 gave those works the same term of protection as works created after January 1, 1978, with this proviso:

In no case, however, shall the term of copyright in such a work expire before December 31, 2002; and if the work is published on or before December 31, 2002, the term of copyright shall not expire before December 31, 2047.¹⁰

To see how this provision plays out, assume a library owns the copyright in an unpublished poem written by Emily Dickinson, who lived from 1830 to 1886. The work was protected by common law copyright until federal statutory protection attached to it on January 1, 1978. The Act, as amended by the Sonny Bono Copyright Term Extension Act,¹¹ now provides that the term of copyright is life of the author plus seventy years.¹² Because Dickinson died in 1886, the term of copyright protection under the Act would have expired seventy years after her death, in 1956. Since § 303 provides that “[i]n no case, however, shall the term of copyright in such a work expire before December 31, 2002,” the term of federal copyright in this hypothetical work extended to December 31, 2002.¹³ The reader will be quick to note that this means that all the unpublished works by Americans who died prior to 1933 fell into the public domain on December 31, 2002.

6. 17 U.S.C. § 106 (2000).

7. U.S. CONST. art I, § 8, cl. 8.

8. Pub. L. No. 94-553, 90 Stat. 2541 (1976).

9. Common law copyrights did not entirely cease to be created, however. The Act provides that federal copyright attaches when a work is “fixed in any tangible medium of expression.” 17 U.S.C. § 102(a) (2000). A speech, dance, or improvisational routine that is not recorded does not qualify for federal copyright protection, but may still be protected by common law copyright. An exception to prevent trafficking in unauthorized recordings of performances such as rock concerts provides that such recordings are in violation of the Copyright Act. 17 U.S.C. § 1101 (2000).

10. 17 U.S.C. § 303 (2000).

11. Pub. L. No. 105-298, 112 Stat. 2827 (1998).

12. 17 U.S.C. § 302(a) (2000).

13. 17 U.S.C. § 303. It is possible that the common law copyright terminated prior to that date. *See infra* ¶ 31.

¶9 As I imagine librarians celebrating that glorious New Year's Eve, I wonder how many took advantage of another exception. For § 303 also provides that "if the work is published on or before December 31, 2002, the term of copyright shall not expire before December 31, 2047."¹⁴ This exception gave libraries an opportunity to capitalize on the works in which they owned the copyright. In our example, by publishing the Dickinson poem during 2002, the library could have extended the copyright term to December 31, 2047. Yet it appears that few libraries took advantage of this opportunity.

¶10 One factor that may have prevented libraries from publishing large numbers of previously unpublished works is that although § 303 uses the passive voice when providing that the term of copyright is extended "if the work is published," presumably the extension is effective only if *the copyright owner* of the work publishes it. Thus, if a library has the Emily Dickinson poem in its collection but is not the owner of the copyright, the library's publication of the poem prior to December 31, 2002, would not prevent the work from falling into the public domain on that date. In fact, such an act might well constitute copyright infringement.

¶11 Determining copyright ownership can be critical for purposes of § 303 and for other purposes. Let us begin this determination by exploring the important distinction between ownership of the work and ownership of the copyright in the work.

The Distinction between the Copyright and the Material Object

¶12 Copyright is an intangible—the right to do something, basically to copy a work. On the creation of a work, this intangible right attaches to the tangible work. Libraries need to know whether the owner of the object is able to transfer the copyright in the object to the library. In making this determination, it may be helpful to distinguish between works where the copyright in the work could still be merged in the material object in the person's possession, and works where the copyright must be distinct from the material object. For example, if the person has a holographic manuscript, a photographic negative, or an original painting, then the copyright in the work may still be merged in the material object—the manuscript, negative, or artwork. If the person has a printed work, a photographic print, or a reproduction of a painting, however, then the copyright must be distinct from the material object and the person is probably not in a position to transfer the copyright unless the person is the creator of the work.

¶13 Even in the case where the copyright could be merged in the material object, the two are often severed. The classic case where a person is the owner of the material object but is not in a position to transfer the copyright arises with respect to letters. The writer of the letter transfers to the recipient the ownership of

14. *Id.*

the material object (the letter itself), but retains ownership of the copyright in the contents of the letter. Letters are therefore problematic for libraries. If the person transferring ownership to the library happens to be the letter-writer who prudently kept copies of his letters, then the transferor is the initial owner of the copyright.¹⁵ But when the transferor is the recipient of the letter, the transferor did not obtain the copyright and thus cannot grant it to the library. In 1986, author J. D. Salinger sued to enjoin Random House from publishing Ian Hamilton's biography that quoted or paraphrased parts of letters written by Salinger that had been donated by the recipients to the libraries at Harvard, Princeton, and Texas.¹⁶ The court had no difficulty concluding that the copyright in the contents of the letters remained with Salinger.¹⁷ We will return to other aspects of this case later.

Did the Transferor Own the Copyright?

¶14 It is an elementary rule of property law that you can't obtain better title than your transferor has. So the library must ask whether the transferor was in a position to transfer copyright ownership. There are essentially four ways the transferor could have been in a position to grant the copyright:

1. The transferor was the creator of the work. Under copyright law, copyright originally vests in the creator.
2. The transferor possessed a written assignment from the creator or his successors. An owner of any property, including the owner of the intangible right of copyright, is free to transfer ownership.
3. The transferor inherited the work. Under estate law, the copyright may have passed through the creator's estate.
4. The transferor was a creditor. Under bankruptcy law, the copyright may have passed to the owner's creditors.

¶15 Establishing ownership may therefore make for challenging historical research. A classic example is the case that arose some fifty years ago involving ownership of the works of William Clark of Lewis and Clark fame.¹⁸ Sophia V. Foster, the daughter of Civil War General John Henry Hammond and his wife Sophia W. Hammond, died in 1952. When Foster's daughter cleaned out the attic of her mother's house in St. Paul, Minnesota, she found a number of old documents that she gave to

15. See *infra* ¶¶ 14–17.

16. *Salinger v. Random House, Inc.*, 811 F.2d 90 (2d Cir. 1987).

17. *Id.* at 94–95.

18. *First Trust Co. v. Minn. Historical Soc'y*, 146 F. Supp. 652 (D. Minn. 1956), *aff'd sub nom. United States v. First Trust Co.*, 251 F.2d 686 (8th Cir. 1958). A lively account of the events is found in Calvin Tomkins, *Annals of Law: The Lewis and Clark Case*, *NEW YORKER*, Oct. 29, 1966, at 105. Another interesting case involved the manuscript of Mark Twain's *Huckleberry Finn*. In 1910, Twain gave the manuscript to the Buffalo (New York) Public Library. A director of the library apparently took half of it home and it was found in his descendants' attic in 1990. The library successfully claimed ownership of the long-lost document (and presumably also recovered a hefty overdue book fine).

the Minnesota Historical Society. When the documents turned out to be the original notes made by William Clark while on the Voyage of Discovery, the other descendants of the Hammonds claimed that Foster's daughter had no right to give their property away and sued the Historical Society to get them back. The United States then intervened, claiming that after Clark turned the works over to the government, General Hammond must have purloined them. Therefore, the government asserted, they never belonged to the Hammond family but belonged to the federal government.

¶16 The case sent shudders through the archival community, which wondered if it presaged an attempt by the government to assert ownership of government documents in archival collections. The court concluded that the government had no right to the property, finding that the rough notes were Clark's private papers and not government documents. The court also found that the government's allegation that the mere fact that one possesses government documents indicates that the documents were stolen "is too tenuous and speculative to provide a basis for a factual finding of title in the government."¹⁹ This statement must have provided some relief to the holders of government documents, including many libraries. The family and the Minnesota Historical Society eventually resolved the matter.²⁰

¶17 Let us assume the transferor has better luck than Sophia Foster's daughter and can trace the provenance of the copyright in the work. We must now ask whether that party transferred the copyright to the library.

Did the Transferor Grant the Copyright to the Library?

¶18 Even if it can be established that the transferor was in a position to transfer the copyright, it does not necessarily follow that the transferor actually granted the copyright to the library. If the copyright was merged in a material object, and the object was given to the library, the difficult issue to resolve is whether the copyright was severed from the object at the time the library received the object. In other words, when the transferor gave the library the material object, did he or she give the library both the object and the copyright, or only the object?

¶19 The first step is to examine the terms of the grant to the library. A written assignment is necessary to transfer copyright ownership.²¹ The library should therefore be aware if it owns the copyright because it would have secured the document necessary to transfer the copyright. If a transferor intended to transfer ownership of the copyright, but the proper documents were not executed, the

19. *First Trust Co.*, 146 F. Supp. at 668.

20. The works are now housed at Yale University's Beinecke Rare Book and Manuscript Library. You can see the digital images at YALE UNIV., BEINECKE RARE BOOK AND MANUSCRIPT LIBRARY, at http://beinecke.library.yale.edu/dl_crosscollex/ (last visited May 10, 2004) (search for William Clark Field Notes). Curiously, Yale states there that "literary rights, including copyright, belong to the authors or their legal heirs and assigns." YALE UNIV., BEINECKE RARE BOOK AND MANUSCRIPT LIBRARY, WILLIAM CLARK FIELD NOTES, at <http://webtext.library.yale.edu/xml2html/beinecke.field.con.html#a5> (last visited May 10, 2004).

21. 17 U.S.C. § 204 (2000).

assignment can be made retroactively.²² If the grant expressly states that the copyright is or is not granted, that is the end of the inquiry.

¶20 If the grant does not say one way or the other whether the copyright was transferred, the next step is to determine whether the work was published or unpublished, and if it was unpublished, whether it was created prior to or after January 1, 1978, the effective date of the Copyright Act of 1976. If the work was created prior to that date and is unpublished, the copyright owner had a common law copyright. Because common law copyright is state law, the question of whether the copyright was transferred with the object is left to each state. The few cases that have addressed the issue have generally found that the transferor's intent was to transfer the copyright along with the object.²³ Because most states have never addressed this issue, there is some risk in concluding that the library owns the copyright in this situation, but the majority rule appears to be that it does.²⁴

¶21 For published works created before January 1, 1978, federal copyright attached on publication and courts have consistently held that sale of the work did not of itself transfer the copyright in the work.²⁵ For works created on or after January 1, 1978, whether published or not, the Act expressly provides that the conveyance of the material object does not of itself transfer the copyright.²⁶ When receiving works into the collection, it is obviously important for the library to also receive a written grant of copyright if that is the transferor's intention.

¶22 Let us assume that after this analysis has been completed, we have determined that the library does not own the copyright. Then who does? We will first check whether no one owns it, that is, whether the work is in the public domain.

Is the Work in the Public Domain?

¶23 When we say that a work is in the public domain, we mean that it is not protected by copyright. We might here make a distinction between works that were never protected by copyright and works that were once protected or eligible for protection and lost that protection.

Works Never Protected by Copyright

¶24 It takes only a modicum of originality and creativity to create a copyrightable work. Nevertheless, certain works fail to qualify. A helpful list of such works is

22. Although the retroactivity of the agreement may make no difference to the parties, it may affect the rights and claims of third parties. See Scott J. Burnham, *The Interstices of Copyright Law and Contract Law: Finding the Terms of an Implied Nonexclusive License in a Failed Work for Hire Agreement*, 46 J. COPYRIGHT SOC'Y U.S.A. 333, 340-48 (1999).

23. The leading case is *Pushman v. N.Y. Graphic Soc'y*, 39 N.E.2d 249 (N.Y. 1942). Other cases are cited in 3 NIMMER & NIMMER, *supra* note 1, § 10.09[A], at 10-77.

24. This analysis is subject to the possibility that the duration of the common law copyright has terminated. See *infra* ¶ 31.

25. 3 NIMMER & NIMMER, *supra* note 1, § 10.09[A], at 10-77.

26. 17 U.S.C. § 202 (2000).

found in the Copyright Office regulation that enumerates works for which it refuses to register a claim to copyright:

- (a) Words and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents;
- (b) Ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing;
- (c) Blank forms, such as time cards, graph paper, account books, diaries, bank checks, scorecards, address books, report forms, order forms and the like, which are designed for recording information and do not in themselves convey information;
- (d) Works consisting entirely of information that is common property containing no original authorship, such as, for example: Standard calendars, height and weight charts, tape measures and rulers, schedules of sporting events, and lists or tables taken from public documents or other common sources.
- (e) Typeface as typeface.²⁷

An example of such an uncopyrightable work that might be found in a library is the envelope in which a letter was sent, containing the addresses of the recipient and the sender. The object may well have value as an original creation of the author, but it has no claim to copyright.

¶25 Facts are not copyrightable and therefore may be freely copied from the copyrightable work.²⁸ For example, assume the library possesses a letter from J. D. Salinger to Whit Burnett dated June 10, 1943, in which Salinger writes that Wendell Willkie looks “like a guy who makes his wife keep a scrapbook for him.”²⁹ If a user wished to use this material, she could probably write any of the following statements without infringing Salinger’s copyright in the letter:

- J. D. Salinger wrote a letter to Whit Burnett on June 10, 1943.
- J. D. Salinger didn’t like Wendell Willkie.
- J. D. Salinger thought Wendell Willkie was pompous.
- J. D. Salinger wrote a letter to Whit Burnett on June 10, 1943 in which he expressed his dislike of Wendell Willkie, for he thought Willkie was pompous.³⁰

27. 37 C.F.R. § 202.1 (2003).

28. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350–51 (1991) (“Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves.”).

29. This is an actual passage from a letter cited in *Salinger v. Random House, Inc.*, 650 F. Supp. 413, 419 (1986). The case raises the interesting issue of whether publication in a public document such as a court opinion puts the work in the public domain. Salinger’s attorneys were conscious of this issue and asked the court not to print in the records the detailed listing of all the passages used by Hamilton.

30. Hamilton went beyond these bounds, sometimes quoting the material and sometimes paraphrasing it. For example, in his book, he wrote that Salinger says that Willkie looks like “the sort of fellow who makes his wife keep an album of his press cuttings.” *Salinger*, 650 F. Supp. 413 at 419. Hamilton must have received bad advice, for the paraphrases served no purpose. Paraphrasing a copyrightable work not only inaccurately depicts the author’s literary style, but it does not circumvent a claim of copyright infringement. In *Craft v. Kobler*, 667 F. Supp. 120, 126 (S.D.N.Y. 1987), the court spoke approvingly of direct quotation where the commentary “depends on a perception of the style of writing and manner of expression.”

Because the writer is essentially reporting a fact, albeit with some deduction, the copyright owner has no claim.

¶26 Another significant body of works that are in the public domain because they are not protected by copyright is works of the federal government.³¹ Note that this exception does not apply to works of state and local governments, which are generally protected by copyright, with the exception of such public records as statutes and court decisions.

Works That Lost Copyright Protection

¶27 A work originally protected by copyright may have lost that protection for a number of reasons, including the following:

- The work was published without notice.
- The work was published but the owner did not claim a renewal term.
- The work was published and the duration of copyright has expired.
- The work was unpublished and the duration of copyright has expired.

¶28 *The work was published without notice.* As we have seen, federal copyright law formerly required an effective copyright notice on publication. The Copyright Act of 1976 did not initially change that rule. In order to join the Berne Convention,³² an international copyright treaty, however, the United States had to allow copyright to attach with few formalities. After the Berne Convention Implementation Act³³ became effective on March 1, 1989, the copyright protection that attaches to a work on creation is not lost on publication, even if the work is published without notice.³⁴ Works published prior to that date without notice, however, generally lost copyright protection.³⁵

¶29 *The work was published but the owner did not claim a renewal term.* Under the Copyright Act of 1909, the work was eligible for an initial copyright term of twenty-eight years that could be renewed for another twenty-eight years. Registration of the copyright claim with the Copyright Office was not necessary for copyright protection to attach initially, but was necessary for the renewal to be effective. Congress ended the affirmative renewal requirement for works published

31. 17 U.S.C. § 105 (2000).

32. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as last revised July 24, 1971, 25 U.S.T. 1341, 828 U.N.T.S. 221.

33. Pub. L. No. 100-568, 102 Stat. 2853 (1988).

34. The general public does not seem yet aware of this change, thinking, for example, that material posted on the Internet without notice is not protected by copyright. Therefore, even though it is legally unnecessary, as a practical matter the prudent copyright owner should attach a notice using the word copyright or the symbol ©, the name of the copyright owner, and the date. The Act also provides that notice bars a defense of innocent infringement. 17 U.S.C. § 401(d) (2000).

35. There is an exception for works published between January 1, 1978, and February 28, 1989, when it was possible to take steps to restore the lost protection. 17 U.S.C. § 405(a) (2000). Another exception permits copyright to be restored in foreign works that lost American copyright because of failure to comply with the notice requirement. 17 U.S.C. § 104A (2000).

after December 31, 1963.³⁶ Works published between 1964 and 1977 automatically receive a renewal term of sixty-seven years. After 1977, there is only one term. Therefore, if a work was published before January 1, 1964, it is possible to check with the Copyright Office to find out whether the copyright was renewed.³⁷ If it was not, the work is in the public domain.³⁸

¶30 *The work was published and the duration of copyright has expired.* Congress has frequently changed the duration of copyright protection, making it difficult to determine the term of protection for a particular work. As previously mentioned, the 1909 Act made the duration two terms of twenty-eight years, but Congress extended the expiration of that second term until the 1976 Act made the duration life of the author plus fifty years for new works and seventy-five years for works created under the old regime. In 1998, the Sonny Bono Copyright Term Extension Act made the duration life of the author plus seventy years for works created since January 1, 1978. It also made the duration ninety-five years for works in their second term when the Act became effective on October 27, 1998. Because the second term of a work created in 1922 ended in 1997 and was not saved by the Sonny Bono Act, it is in the public domain. The second term of a work created in 1923 ended in 1998, so it was saved by the Act and its expiration date was extended to 2018. Therefore, while works created before 1922 are now in the public domain, we will have to wait until 2018 before additional published works with renewed copyright terms fall into the public domain.³⁹

¶31 *The work was unpublished and the duration of copyright has expired.* Because an unpublished work created before January 1, 1978, was governed by common law copyright, we generally assume that it is *protected* by common law copyright. But that may not be the case. When we talk about common law copyright, we are talking about the power of a state to protect a work. With few excep-

36. The 1964 date is not found in the present version of the Copyright Act, but is a function of earlier versions of a 1992 amendment to § 304. Goldstein explains:

Congress amended the 1976 Act in 1992 to divide works for which renewal registration is required, and those for which it is not, between works for which copyright was secured before January 1, 1964, and works for which copyright was secured between January 1, 1964, and December 31, 1977. Copyrights first secured before January 1, 1964, will enjoy a renewal term only if the author or other designated statutory claimant obtained a renewal registration within one year of the end of the original twenty-eight-year copyright term; absent renewal registration, the work fell into the public domain at the end of the original term. By contrast, copyrights first secured between January 1, 1964, and December 31, 1977, are automatically renewed for a further forty-seven-year term without registration in the twenty-eighth year. Renewal registration, although no longer required for these works, may nonetheless be made.

GOLDSTEIN, *supra* note 1, § 4.9, at 4:152 (footnotes omitted).

37. If the work was published before January 1, 1923, it is not necessary to check, for the work is in the public domain. *See infra* ¶ 30.

38. Unfortunately, Copyright Office records can be electronically searched only for documents recorded after 1977. *See* UNITED STATES COPYRIGHT OFF., SEARCH COPYRIGHT RECORDS: REGISTRATIONS AND DOCUMENTS, at <http://www.copyright.gov/records/> (last visited May 3, 2004).

39. Cynics will point out that the Sonny Bono Act prevented Mickey Mouse, who first appeared in 1928, from falling into the public domain.

tions,⁴⁰ state legislatures have been silent on the issue, so we must generally look to decisions by a court. It is quite possible that a state court might determine that the work is not entitled to copyright protection in perpetuity.⁴¹ The termination of copyright has historically been part of copyright law, in part to further freedom of speech. For example, that unpublished poem by Emily Dickinson mentioned earlier⁴² would have common law protection under the law of Massachusetts. It is up to the courts of Massachusetts to determine whether that copyright was perpetual and, if not, when the copyright in that unpublished work terminated.

If the Library Does Not Own the Copyright and the Work Is Not in the Public Domain, Can the Library Permit the Use?

Locating the Owner

¶32 If the library has established that it probably does not own the copyright and the work is probably not in the public domain, then someone else owns the copyright and has the exclusive rights of a copyright owner.⁴³ In cases not covered by fair use, that person will have to be located in order to secure permission to use the copyrighted work. Who might own it? Recall our earlier discussion of how a person could come to be the owner of a copyright:

1. Under copyright law, copyright originally vests in the author.
2. Under contract law, the author may have assigned ownership of the copyright.
3. Under estate law, the copyright may have passed through the author's estate.
4. Under bankruptcy law, the copyright may have passed to the owner's creditors.

40. California, for example, protects "products of the mind" in CAL. CIV. CODE §§ 980–989 (West 1982 & Supp. 2004). Curiously, section 980(b) provides that the ownership "continues so long as the invention or design and the representations or expressions thereof made by him remain in his possession." CAL. CIV. CODE § 980(b). This passage would suggest that the common law copyright in a letter is lost when the letter is sent, unless the writer keeps a copy. To conform to federal copyright law, the section was amended in 1982 to apply only to a work "that is not fixed in any tangible medium of expression." CAL. CIV. CODE § 980(a)(1).

41. See 1 NIMMER & NIMMER, *supra* note 1, § 1.10[C][1].

42. See *supra* ¶ 8.

43. Those exclusive rights are enumerated in 17 U.S.C. § 106 (2000):
Subject to sections 107 through 120, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

¶33 It is evident that ownership other than by the author can be very hard to trace. To illustrate, let's return to that unpublished poem written by Emily Dickinson. If she did not assign ownership of the copyright during her lifetime and her creditors never acquired it, then it passed as part of her estate. A person who is not aware of the value of literary property, especially intangible property such as a copyright, may make no special provision for that category of property in his or her will. It would therefore pass with the residue of the estate, devised by language such as "all the rest, residue, and remainder of my property I hereby leave to. . . ." If she died intestate, without a will, estate law would determine who became the owner. That process would have to be repeated for each generation of owners. It could be all but impossible to determine who those persons are today. Nevertheless, the library could make a good faith search, such as an Internet search for descendants of the author.

Limitations on the Exclusive Rights of the Copyright Owner

¶34 All is not lost, however, if the library cannot find the copyright owner, or locates an owner who is unwilling to permit copying or distribution of the work. The Copyright Act provides some limits on the exclusive rights of a copyright owner. The most relevant limitations are found in § 107, which permits fair use of a copyrighted work, and § 108, which permits certain uses by libraries and archives. One issue that is not resolved by the Act is whether § 108, because it is addressed specifically to libraries and archives, contains the exclusive exception for libraries and archives, or whether libraries and archives may also claim the general exceptions of § 107. For example, if § 108 expressly permits the library to make one copy for a use enumerated in that section, may the library make two copies and claim fair use under § 107? Publishers have argued that the § 108 uses would not otherwise qualify as fair use under § 107.⁴⁴ Therefore, according to that analysis, a use beyond those specified in § 108 could never be fair use. The libraries and archives argue that since § 108 specifically provides that "[n]othing in this section . . . in any way affects the right of fair use as provided by section 107,"⁴⁵ the right of libraries to claim fair use under § 107 is preserved. I think the libraries and archives have the better of this argument, but it remains an issue that libraries and archives should be aware of.

¶35 When applying the statutory limits on the rights of the copyright owner to a particular case, it may be important for the library to distinguish between use by the library and use by a patron. In the latter case, we will attempt to determine the extent to which the library is responsible for the patron's acts, an issue that is addressed to some extent in sections 107 and 108. In our hypothetical examples, the library might copy the work for a patron; copy and distribute it to another library; or copy, distribute, and display the work online.

44. ASS'N OF AM. PUBLISHERS & AUTHORS' LEAGUE OF AM., PHOTOCOPYING BY ACADEMIC, PUBLIC AND NONPROFIT RESEARCH LIBRARIES 5 (1978).

45. 17 U.S.C. § 108(f)(4) (2000).

*Section 107: Fair Use*⁴⁶

¶36 I often think of fair use as the last refuge of scoundrels, for every copyright infringer, especially in education, feels free to make liberal use of materials under the banner of fair use. The fair use criteria are necessarily vague and context-specific. There are many excellent Web sites that interested parties should consult to assist them in their fair use analysis.⁴⁷ The *Salinger* case is the closest we have to a decided opinion in which the court applied the criteria to a situation involving a library. It is important to note, however, that the issue was whether there was fair use of the works by the patron, Ian Hamilton. The libraries were not defendants in the case and there was no issue concerning their use of the materials.

¶37 Hamilton claimed that his use of some fifty-nine passages from Salinger's letters in a commercially published biography of Salinger would be a fair use. The court found it was not. The court's determination was clearly colored by "special emphasis" on the fact that Salinger's works were unpublished. This fact was significant, for example, because whoever first published the works might have a commercial advantage and that right of first publication belonged to the copyright owner, Salinger.

¶38 One should not conclude, however, that *Salinger* stands for the proposition that a patron may not make fair use of unpublished works in a library.⁴⁸ A number of facts distinguish *Salinger* from other contexts. First of all, the works had substantial commercial value, which may distinguish them from library collections of Civil War letters or homestead journals. Second, Hamilton was using the works for a commercial purpose, a factor that would not be present if the works were used in another context, such as a graduate student's thesis. Third, Hamilton used significant excerpts from a substantial number of the works.

46. Section 107 provides:

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.

17 U.S.C. § 107 (2000).

47. See, e.g., STANFORD UNIV. LIBRARIES, COPYRIGHT & FAIR USE, at <http://fairuse.stanford.edu/index.html> (last visited May 2, 2004); WASHINGTON UNIV. IN ST. LOUIS, COPYRIGHT LAW, at <http://www.wustl.edu/copyright/> (last visited May 2, 2004).

48. The trial judge, Pierre Laval, thoughtfully applied the fair use criteria to the facts and concluded that Hamilton's use was a fair use. See *Salinger v. Random House, Inc.*, 650 F. Supp. 413, 423–26 (S.D.N.Y. 1986).

Finally, it is significant that Congress amended § 107 in 1992 to add the flush language at the end: “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.”⁴⁹ The legislative history indicates that this language was inserted specifically to forestall broad application of the ruling in *Salinger*.⁵⁰

Section 108: Reproduction by Libraries and Archives

¶39 Libraries receive substantial protection under § 108 of the Copyright Act for actions that might otherwise constitute infringement. Because the limitations on the exclusive rights of a copyright holder in § 108 are available only to libraries and archives, we must first ask whether the entity is a library or archive. One expert, Paul Goldstein, states that “[t]he Act defines neither ‘library’ nor ‘archives.’”⁵¹ The Eleventh Circuit, however, in *Pacific & Southern Co. v. Duncan*, stated that “[t]he statute [§ 108] defines an archive with some precision. . . .”⁵² While the statements by Goldstein and the *Pacific & Southern* court may seem contradictory, I think they both make sense. Even though the Act does not expressly define *archives*, we can determine that the benefits of § 108 are available only when three conditions are met:

- the reproduction or distribution is made without any purpose of direct or indirect commercial advantage;⁵³
- the collections of the library or archives are (i) open to the public, or (ii) available not only to researchers affiliated with the library or archives or with the institution of which it is a part, but also to other persons doing research in a specialized field;⁵⁴

and, when the user requests a copy

- the library or archives has had no notice that the copy or phonorecord would be used for any purpose other than private study, scholarship, or research.⁵⁵

49. 17 U.S.C. § 107. In *Sundeman v. Seajay Soc’y, Inc.*, 142 F.3d 194 (4th Cir. 1998), the court held that quotation from an unpublished manuscript was a fair use even though the fact that the work was unpublished weighed against fair use.

50. “The Committee [on the Judiciary] agrees with the Copyright Office that the Second Circuit in *Salinger* went astray in its treatment of the unpublished nature of the work as leading to a diminished likelihood that the fair use defense, as a whole, will in every case not be available.” H.R. REP. NO. 102-836, at 9 (1992), *reprinted in* 1992 U.S.C.C.A.N. 2553, 2561.

51. 1 GOLDSTEIN, *supra* note 1, § 5.2.2 n.120. Goldstein opines that courts will give those terms their historic meaning.

52. 744 F.2d 1490, 1494 n.6 (11th Cir. 1984).

53. 17 U.S.C. § 108(a)(1) (2000). It appears from the history of this provision that the “commercial advantage” refers to the library’s commercial activity, not to the patron’s commercial activity. Thus, the library could make a copy for a patron who intended to make a profit from use of the work, but the library could not charge a substantial amount for making the copy. H.R. REP. NO. 94-1476, at 74-75 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5688-89.

54. 17 U.S.C. § 108(a)(2) (2000).

55. 17 U.S.C. § 108(d)(1) (2000).

From these restrictions, we can deduce that for purposes of § 108, a library or archive is a collection of copyrighted works which the public or persons doing research in a specialized field might wish to copy, presumptively for private study, scholarship, or research, at no cost beyond the cost of copying.

¶40 Note that there is no statutory requirement that the library or archive be “public” or “nonprofit.” Nevertheless, when the defendant in *Pacific & Southern*, doing business as “TV News Clips,” taped television news reports and sold copies to those mentioned in the segments, it went too far in claiming that it was an archive. Even though there is no express definition of archives in the Act, the court was certainly correct in denying that TV News Clips was an archive, for our instrumental description does not fit its activities.

¶41 On the other hand, an attempt was made by the state of New York to compel the issuers of standardized tests to disclose the content of tests by requiring the test agency to deposit the test into an “archive” from which the tests could presumably be copied by the public under § 108. The enabling legislation provided in pertinent part:

Documents submitted to the commissioner pursuant to this section shall be public records and, in collecting this material, the State Education Department shall be considered an archive under Title 17 § 108 U.S.C.⁵⁶

The trial court refused to approve of the scheme, stating that Congress did not intend unpublished materials to be made available under § 108.⁵⁷ It would seem to me that a collection of examinations made available to the public for copying would fit our description of a library. The rationale, however, seems flawed, for parts of § 108 do expressly apply to unpublished works. The better reasoning is that the state’s scheme would run afoul of the section’s requirement that copying be “isolated and unrelated.”⁵⁸

¶42 The final threshold requirement of § 108 is that

the reproduction or distribution of the work includes a notice of copyright that appears on the copy or phonorecord that is reproduced under the provisions of this section, or includes a legend stating that the work may be protected by copyright if no such notice can be found on the copy or phonorecord that is reproduced under the provisions of this section.⁵⁹

56. N.Y. EDUC. LAW § 342(7) (Consol. 1985).

57. *Ass’n of Am. Med. Colleges v. Carey*, 728 F. Supp. 873 (N.D.N.Y. 1990), *rev’d on other grounds sub nom. Ass’n of Am. Med. Colleges v. Cuomo*, 928 F.2d 519 (2d Cir. 1991).

58. 17 U.S.C. § 108(g)(1) (2000) provides:

(g) The rights of reproduction and distribution under this section extend to the isolated and unrelated reproduction or distribution of a single copy or phonorecord of the same material on separate occasions, but do not extend to cases where the library or archives, or its employee—

(1) is aware or has substantial reason to believe that it is engaging in the related or concerted reproduction or distribution of multiple copies or phonorecords of the same material, whether made on one occasion or over a period of time, and whether intended for aggregate use by one or more individuals or for separate use by the individual members of a group;

59. 17 U.S.C. § 108(a)(3) (2000).

If the three requirements applicable to all copying by the library are followed, then the library or archive may reproduce “no more than one copy or phonorecord of a work,”⁶⁰ but may lose that privilege if it “is aware or has substantial reason to believe that it is engaging in the related or concerted reproduction or distribution of multiple copies or phonorecords of the same material.”⁶¹ When is that point reached? Presumably § 108(g), like § 107, is in part an economic response to the fact that when a use cannot be easily metered, the cost of obtaining permission may exceed the value of the copy. In that situation, the use is a fair use. But by the same token, the library or user should obtain permission when the balance tips so that it becomes economically feasible to obtain permission. For example, if a student in my copyright class wants a copy of an article to study and annotate, it is not efficient for that student to obtain permission. If all the students in my class want a copy of the article, however, then I should negotiate for permission. If I tried to finesse the issue by suggesting that each student ask the library for a copy, the copying would violate the owner’s copyright because it is “related and concerted” in the words of § 108(g)(1) rather than “isolated and unrelated.”

¶43 Reproduction by libraries and archives for their own purposes is discussed in subsections (b) and (c) of § 108.⁶² Subsection (b) allows the reproduction of an unpublished work for purposes of preservation, security, or deposit in another library or archive. A significant change to that section was made by the Digital Millennium Copyright Act,⁶³ effective October 28, 1998. The section previously allowed only “facsimile” copies to be made; now digital copies are permitted for use within the library or archive but not for distribution to the public. Subsection (c) allows a published work to be duplicated for purposes of replacement if the existing storage format has become obsolete. One condition is that the library or archive must first make a reasonable effort to find an unused replacement at a fair price.

¶44 Subsection 108(h) provides in pertinent part:

For purposes of this section, during the last 20 years of any term of copyright of a published work, a library or archives, including a nonprofit educational institution that func-

60. 17 U.S.C. § 108(a) (2000). The Copyright Act uses the refrain “copy or phonorecord” because the Supreme Court held in *White-Smith Music Publ’g Co. v. Apollo Co.*, 209 U.S. 1 (1908), that a piano roll (and by analogy any other type of recording of a musical composition) was not a “copy” of the underlying work.

61. 17 U.S.C. § 108(g)(1).

62. Because I am largely concerned with a library copying for patrons rather than for the library itself, this article does not discuss in detail §§ 108(b) and 108(c). Obviously, the issues overlap, as with interlibrary loans. The issue of whether interlibrary loans are “systematic” copying is a thorny one. Fortunately, many issues have been resolved by guidelines adopted by the National Commission on New Technological Uses of Copyrighted Works (CONTU) to govern practices under § 108(g)(2). These guidelines on photocopying and interlibrary arrangements were included in the conference report that accompanied the Copyright Act of 1976. H.R. CONF. RPT. NO. 94-1733, at 71–72 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5810, 5812–13.

63. Pub. L. No. 105-304, § 404, 112 Stat. 2860, 2889–90 (1998).

tions as such, may reproduce, distribute, display, or perform in facsimile or digital form a copy or phonorecord of such work, or portions thereof, for purposes of preservation, scholarship, or research. . . .⁶⁴

This subsection makes sense only in light of the history of copyright term extension. In 1998, the Sonny Bono Copyright Term Extension Act extended the term of copyright for twenty years, for both existing and future works.⁶⁵ The Act was a setback to libraries and archives, for during the twenty years after 1998, no work will go into the public domain as a result of the term of copyright expiring. As a concession to libraries and archives stung by that action, subsection 108(h) was amended to give libraries and archives more expansive use of the works that gained the extra twenty years of copyright protection. The library or archive has this privilege only if none of three conditions applies:

- (A) the work is subject to normal commercial exploitation;
- (B) a copy or phonorecord of the work can be obtained at a reasonable price; or
- (C) the copyright owner or its agent provides notice pursuant to regulations promulgated by the Register of Copyrights that either of the conditions set forth in subparagraphs (A) and (B) applies.⁶⁶

The Copyright Office has issued regulations providing for the notice that copyright owners must provide under § 108(h)(2)(C).⁶⁷ Note that if the library or archive overcomes the hurdles of the three conditions, it may display the work in digital form, that is, make it available on the Internet.

¶45 As an example of the operation of subsection (h), assume a library owns copies of *The Sun Also Rises* by Ernest Hemingway and *Inspirational Poetry* by Miriam Stroebel. Both were published in 1925 with proper copyright notice, and both copyright terms were renewed in 1953. The terms would have ended in 2000, but the Sonny Bono Act added another twenty years; the term now ends December 31, 2020. The library wishes to post both works on its Web site. It first checks with the Copyright Office and finds that the owner of the copyright in the Hemingway work has filed notice that the work is available at a reasonable price. That ends the inquiry; the library may not publish the work. No notice was filed with respect to the Stroebel work, so the library checks *Books in Print* and finds that it is not in print. It then checks with sources for out-of-print works, including those available on the Internet, and finds no available copy. After prudently documenting this search (and making sure that the work is in the last twenty years of its term), the library digitizes the work and posts it on its Web site. The posting must contain a notice of copyright and should state that the work is made available for purposes of preservation, scholarship, or research. It might be prudent to add that unlawful

64. 17 U.S.C. § 108(h)(1) (2000).

65. The Sonny Bono Copyright Term Extension Act was held to be constitutional in *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

66. 17 U.S.C. § 108(h)(2).

67. 37 C.F.R. § 201.39 (2003).

reproduction, distribution, display, or performance of the work by others is prohibited.

¶46 Reproduction by libraries and archives for users is discussed in subsections (d) and (e) of § 108. These subsections, unlike subsections (b) and (c), “do not apply to a musical work, a pictorial, graphic or sculptural work, or a motion picture or other audiovisual work other than an audiovisual work dealing with news,” except for “adjuncts” to works such as illustrations and diagrams.⁶⁸ The copying permitted under these subsections applies in subsection (d) to “no more than one article or other contribution to a copyrighted collection or periodical issue, or to a copy or phonorecord of a small part of any other copyrighted work”⁶⁹ and in subsection (e) to “the entire work, or to a substantial part of it . . . if the library or archives has first determined, on the basis of a reasonable investigation, that a copy or phonorecord of the copyrighted work cannot be obtained at a fair price.”⁷⁰ Both subsections require that:

- (1) the copy or phonorecord becomes the property of the user, and the library or archives has had no notice that the copy or phonorecord would be used for any purpose other than private study, scholarship, or research; and
- (2) the library or archives displays prominently, at the place where orders are accepted, and includes on its order form, a warning of copyright in accordance with requirements that the Register of Copyrights shall prescribe by regulation.⁷¹

The requirements for the contents of the “warning of copyright” are as follows:

Contents. A Display Warning of Copyright and an Order Warning of Copyright shall consist of a verbatim reproduction of the following notice, printed in such size and form and displayed in such manner as to comply with paragraph (c) of this section:

NOTICE

WARNING CONCERNING COPYRIGHT RESTRICTIONS

The copyright law of the United States (Title 17, United States Code) governs the making of photocopies or other reproductions of copyrighted material.

Under certain conditions specified in the law, libraries and archives are authorized to furnish a photocopy or other reproduction. One of these specific conditions is that the photocopy or reproduction is not to be “used for any purpose other than private study, scholarship, or research.” If a user makes a request for, or later uses, a photocopy or reproduction for purposes in excess of “fair use,” that user may be liable for copyright infringement.

This institution reserves the right to refuse to accept a copying order if, in its judgment, fulfillment of the order would involve violation of copyright law.⁷²

68. 17 U.S.C. § 108(i) (2000).

69. 17 U.S.C. § 108(d) (2000).

70. 17 U.S.C. § 108(e) (2000).

71. 17 U.S.C. § 108(d)(1)–(2); 17 U.S.C. § 108(e)(1)–(2).

72. 37 C.F.R. § 201.14(b) (2003). The requirements for “form and manner of use” in 37 C.F.R. § 201.14(c) (2003) are:

(1) A Display Warning of Copyright shall be printed on heavy paper or other durable material in type at least 18 points in size, and shall be displayed prominently, in such manner and

Limitations on the Library's Liability

¶47 Let us look at a concrete example of the potential liability of the library and the user for copyright infringement. Assume that Ian Hamilton requests access to all of the letters of J. D. Salinger in the library. Under § 108(e), the library could make a copy for Hamilton if it (1) determines that a copy of the work cannot be obtained at a fair price, (2) has had no notice that the work would be used for any purpose other than private study, scholarship, or research, and (3) posts the appropriate warning on the photocopier.

¶48 If the library allows a patron access to the work in these circumstances and the patron copies and distributes the work for commercial purposes, is the library liable for that action? Section 108 makes clear that the benefits available to the library or archive under that section are not available to the patron. It would be prudent practice for the library to make sure the patron knows that—or at least to make sure the library can let the copyright owner know it informed the patron—by having the patron sign a form stating that he or she is responsible for any infringing use. For example, subsection (e)(1) states that the copying is permissible only if “the library or archives had no notice that the copy or phonorecord would be used for any purpose other than private study, scholarship, or research.” Presumably Ian Hamilton told the libraries he wanted to copy the Salinger letters for research purposes. Presumably he did not also tell them that Random House had given him a \$100,000 advance to publish that research. If he did, that statement might have constituted notice to the library that he would use the copy for another purpose. The reported case tells us that the libraries prudently had Hamilton sign statements regarding his use of the materials.⁷³ For example, the “Princeton University Library Request for Access to Manuscripts” stated in part:

I understand that Princeton University holds manuscripts for purposes of research and scholarship. I agree not to copy, reproduce, circulate or publish them without the permission of Princeton University Library and of the owner of the literary property rights, if any. I assume all responsibility for any infringement by me of the literary property rights held by others in the material requested.⁷⁴

Again, the libraries were not made parties to that lawsuit, and if they had been, the signed statement would probably have insulated them from liability. But the easiest

location as to be clearly visible, legible, and comprehensible to a casual observer within the immediate vicinity of the place where orders are accepted.

(2) An Order Warning of Copyright shall be printed within a box located prominently on the order form itself, either on the front side of the form or immediately adjacent to the space calling for the name or signature of the person using the form. The notice shall be printed in type size no smaller than that used predominantly throughout the form, and in no case shall the type size be smaller than 8 points. The notice shall be printed in such manner as to be clearly legible, comprehensible, and readily apparent to a casual reader of the form.

73. *Salinger v. Random House, Inc.*, 650 F. Supp. 413, 416 (S.D.N.Y. 1986). The libraries also refused Hamilton permission to quote from the letters. *Id.* at 417. This was also prudent, but probably immaterial. Since the libraries did not own the copyrights, the permission was not theirs to give.

74. *Id.* at 416–17.

way for the library to avoid liability is to take advantage of the invitation in subsection (f)(1):

(f) Nothing in this section—

- (1) shall be construed to impose liability for copyright infringement upon a library or archives or its employees for the unsupervised use of reproducing equipment located on its premises: Provided, That such equipment displays a notice that the making of a copy may be subject to the copyright law. . . .⁷⁵

Under subsection (f)(1), the library is not responsible for the user's use of a photocopier as long as the photocopier "displays a notice that the making of a copy may be subject to the copyright law."⁷⁶ To libraries and archives that wish to avoid liability, the message seems simple: don't do the photocopying for users; provide self-service machines with notices on them, and let users do their own copying. Of course, if the copyright owner has placed contractual restrictions on use by the library, the library must act in accordance with the contract.⁷⁷

¶49 If the library takes all steps to relieve itself of liability, however, the patron may still be liable.⁷⁸ Under subsection (f)(2), the "person who uses" the photocopier could be liable if the use exceeds fair use under § 107:

(f) Nothing in this section—

- (2) excuses a person who uses such reproducing equipment or who requests a copy or phonorecord under subsection (d) from liability for copyright infringement for any such act, or for any later use of such copy or phonorecord, if it exceeds fair use as provided by section 107. . . .⁷⁹

¶50 Let us now look at a worst-case scenario. If a library is found to have exceeded the fair use guidelines of § 107 or the privileges granted by § 108, what can happen to it?

If the Library Is Wrong, Will Terrible Things Happen to It?

¶51 In considering whether a library should make a certain use of a work, we must talk about the potential risk should the use be held to be the infringement of a copyrighted work. What is that risk? I am not talking about the risk of knowingly using a copyrighted work and getting caught. Even if there is little risk, we have a

75. 17 U.S.C. § 108(f)(2) (2000).

76. There is no regulation prescribing the text of this notice. Presumably the text of the notice mandated by 37 C.F.R. § 201.14(b) could be used. *See supra* note 72 and accompanying text.

77. 17 U.S.C. § 108(f)(4) (2000). *But see* David Nimmer et al., *The Metamorphosis of Contract Into Expand*, 87 CAL. L. REV. 17 (1999) (warning that courts should be wary of enforcing onerous licensing agreements).

78. The House Report on § 108 specifically provided: "It is the intent of this legislation that a subsequent unlawful use by a user of a copy or phonorecord of a work lawfully made by a library, shall not make the library liable for such improper use." H.R. REP. NO. 94-1476, at 77 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5691.

79. 17 U.S.C. § 108(f)(2).

legal and moral obligation not to misuse copyrighted works. The risk I am talking about arises in the gray areas. For example, assume your library possesses a Civil War letter from an ordinary soldier. Your analysis shows that as far as you know the work is unpublished. It was given to the library by descendants of the recipient, who probably had no interest in the copyright.

¶52 If the library is considering publishing the letter and can't locate the copyright owner, I think it is fair to ask: What is the worst thing that can happen to us if we make use or allow use of the letter and someone later asserts a copyright infringement claim? For one thing, in spite of the notorious FBI warning, there will be no criminal liability. However, a civil claim can be asserted by the copyright owner.

¶53 What can the copyright owner recover from the library? The Copyright Act provides for the recovery of statutory damages⁸⁰ and attorney's fees.⁸¹ However, these damages and fees cannot be recovered for the infringement of an unpublished work when the infringement occurred before the work was registered with the Copyright Office.⁸² For example, in *Salinger*, where the letters were unpublished, it was too late for Salinger to register the copyright and seek statutory damages and attorney's fees after the alleged infringement took place. Where a work is published, the statutory damages and attorney's fees can't be recovered when the infringement occurred before registration unless registration is made within three months of publication.⁸³ So if the copyright owner has not timely registered, the owner will have to pay his or her own attorney's fees for bringing the action and will not be able to recover those fees from the library. That fact will inhibit most parties from bringing a claim, because the claim cannot be justified economically.

¶54 Furthermore, if registration did occur so that the statutory damages are available, the court has discretion to reduce or remit an award of statutory damages.⁸⁴ If the infringer was an innocent infringer who "was not aware and had no reason to believe that his or her acts constituted an infringement," then the award may be reduced to not less than \$200.⁸⁵ If the infringer is a library or archive, or the employee of a library or archive, then the court must remit the award if the infringer "believed and had reasonable grounds for believing that his or her use of the copyrighted work was a fair use under § 107."⁸⁶ Although the statute is expressly confined to fair use under § 107 and not reproduction by libraries and archives under § 108, the library or archive has a good argument that a use under § 108 is a fair use under § 107, either *per se* or by application of the factors in § 107. Ideally, a library

80. 17 U.S.C. § 504(c) (2000).

81. 17 U.S.C. § 505 (2000).

82. 17 U.S.C. § 412(1) (2000).

83. 17 U.S.C. § 412(2).

84. 17 U.S.C. § 504(c)(2).

85. *Id.*

86. *Id.*

will retain documentation that its staff or its expert consultant, such as an attorney, conducted the analysis and concluded that the use was a fair use. If the plaintiff registered the work before the infringement, then “the court may also award a reasonable attorney’s fee to the prevailing party.”⁸⁷ An interesting question arises if the plaintiff proves infringement, but the defendant proves that the statutory damages should be remitted. In theory the plaintiff may be a prevailing party, but the risk that attorney’s fees might not be awarded would give the owner a disincentive to pursue a claim against a library.

¶55 In the absence of statutory damages, the owner will be able to recover only actual damages.⁸⁸ What is the actual loss? The loss is generally the market value—either what the library profited from the use or what the copyright owner lost because of that use. Generally, what the owner lost is the amount a user would have paid had it negotiated permission for the use.⁸⁹ In the case of the local historian quoting from the letters and journals of homesteaders, or the scholar quoting from the obscure person who is the subject of their thesis, that loss is going to be trivial.

A Hypothetical Case

¶56 Let’s apply what we have learned to a hypothetical situation. Assume my great-great-grandfather Jedediah Burnham lived from 1840 to 1910. He fought in the Civil War and wrote some letters home to his mom, Corintha Sophia Burnham. The bundle of letters sat in various attics for years, and eventually my father gave them to a library in 1980. When Ken Burns, the maker of a Civil War documentary was looking for Civil War material, he found them in the library and copied one on the library’s photocopier in 1995 and another in 2003. In his show, he displayed images of the two letters on screen while an actor read excerpts from them. I decide to pursue a claim for copyright infringement against both Burns and the library. Let’s analyze that claim.

¶57 As we know, the copyright in the contents of the letter belonged initially to Jedediah, the author of the letter, and not to the owner of the physical document, Corintha Sophia. Assuming a chain of title from Corintha Sophia to my father, the physical document probably now belongs to the library. The letter was never published until Burns used it, so statutory copyright was never invested nor divested. At creation, the work was protected by common law copyright under state law. It is quite possible that a state court might determine that the work is not entitled to copyright protection. For example, if Jedediah Burnham were a resident of Massachusetts when he wrote his letters, we might put this question to the courts in Massachusetts: Is it possible that under the law of Massachusetts a letter writ-

87. 17 U.S.C. § 505 (2000).

88. 17 U.S.C. § 504(b) (2000).

89. This “market value” approach was used in *Mackie v. Rieser*, 296 F.3d 909 (9th Cir. 2002).

ten in 1860 by an author now dead for ninety years fell into the public domain prior to 1978? The answer might well be yes.

¶58 Even if the work were initially protected by common law copyright, the Copyright Act of 1976 put an end to common law copyright. The duration of copyright in unpublished works is now the same as for published works—generally life of the author plus seventy years—with the § 303 exception (which should be well-known to librarians) that the term may not expire before December 31, 2002. Because Jedediah died in 1910, the works fell into the public domain on December 31, 2002. After that date, Burns was using works in the public domain. An exception would arise if my family had published the letters before that date. This is an appropriate exception, for then Burns would have realized he was dealing with published material and would prudently have sought permission from the publisher.

¶59 As to the letter Burns used in 2002, let's assume that the state copyright persisted until January 1, 1978, and that on that date federal statutory protection attached to Jedediah's work. The work had not yet fallen into the public domain under § 303. So who was the owner of the copyright at that time? A copyright is intangible personal property. That copyright originally belonged to Jedediah and passed through his estate pursuant to state law. Assuming he was neither a literary man nor a famous person, he probably made no specific disposition of his copyrights in a will or otherwise. If he had a will, the copyright most likely passed with the residue of the estate. If he did not have a will, then the law of the state governed the disposition, which could have been to a spouse, children, a spouse and children, or parents.

¶60 To prove my interest, I would have to do two things, one easy and one hard. The easy part is to construct a family tree showing my connection to Jedediah. The hard part is to trace the disposition of that item of property through each generation from Jedediah to me. For example, if Jedediah left the residue of his estate in equal shares to his four children, each of those children had a 25% interest. If the child who was my ancestor then left the residue of his estate to his wife, who remarried and left the residue of her estate to her husband, then no interest passed down to me. If the ancestor died without a will, I would have to research the estate laws of the appropriate state at the appropriate time to determine how the interest was divided. This all assumes that there was no other disposition of the copyright. Because a copyright is personal property, it is also possible that someone along the chain of title voluntarily sold the copyright just like any other personal property can be sold. It is also possible they lost it involuntarily, such as through a bankruptcy in which all assets were passed to a creditor.

¶61 Let's assume a best case scenario. By tracing my interest through the descendants of Jedediah, I am able to prove conclusively that I own a 1/256th interest in that copyright. As a copyright owner, I am able to bring a claim for infringement. What are the damages? Assuming the work was not registered with the Copyright Office before the infringement, I am unable to recover statutory damages or attorney's fees. Let's assume I am able to prove that Burns' use of the

work, a more valuable use than one made by most scholars, is worth \$1200. I have a good claim for 1/256th of that amount—about \$5.

¶62 What about my claim against the library? Under §108, the library had a right to copy the letters for Burns or to permit him to copy them on a copier that had the proper notice. The library should also have stamped the copies with a copyright legend. If the library knew that Burns intended to use the work for other than research, then the library might lose the § 108 defense. It could probably cover itself, however, by getting Burns to sign an agreement that he would not use the material for other purposes. Even if it lost the § 108 defenses, the library could still argue that its use was permissible as a § 107 fair use. If none of these defenses was successful, then the library was an infringer. But what was the infringement? The library only copied the work; it did not display the work for commercial purposes. Therefore the damages recoverable against the library would probably be insignificant.

Conclusion

¶63 A library may have many occasions to determine the copyright status of works in its collection. If the work was created on or after January 1, 1978, the effective date of the Copyright Act, it should be relatively easy to determine who is the copyright owner and whether a grant of copyright or rights under copyright has been obtained or can be obtained. With older works, particularly unpublished works, the job is unfortunately more complex. If the work has potential value, there is an incentive for the owner to come forward or for the library to trace the ownership itself, so that the copyright issues can be resolved.

¶64 Armed with this overview of copyright law, the library ought to be able to determine whether (1) the library owns the copyright, (2) the work is probably in the public domain, or (3) the copyright in the work is probably owned by someone else. The library is then in a position to balance the interest in public dissemination of the work and the interest in protecting the owner, as well as the interest in protecting itself from liability for copyright infringement. In the first and second instance, because the only limitations on use are those imposed by the library, the balance can tip in favor of the public. In the third instance, without adequate knowledge, a risk-averse institution may give weight to the interest in avoiding liability at the expense of the interest of the public. With knowledge of copyright law, however, the library can take affirmative steps to balance the interests.