

The Confusing Transformation Of Copyright Laws

By Andy Stroud

In an early published opinion concerning copyright

infringement, Justice Story considered whether the Reverend Charles W. Upham violated copyright laws by using copies of President Washington's letters in his book, "The Life of Washington." Reverend Upham had taken the letters verbatim from an already-published book, "The Writings of President Washington." Justice Story acknowledged that, in certain instances, authors could use passages of a previous work for purposes of "fair and reasonable criticism," such as in a book review, but if the use went beyond fair and reasonable review, "with a view not to criticize but to supercede the use of the original work," then that would constitute an act of copyright piracy. *Folsom v. Marsh*, 9 F. Cas. 342, 344-345 (Cir. Ct. Mass. 1841). Justice Story established a multifactor test to determine whether the subsequent use was a "fair use," which did not constitute a violation of copyright laws. Justice Story stated that courts should "look to the nature and objects of the selections made, the quantity and value of the materials used and the degree in which the use may prejudice the sale or diminish the profits or supersede the objects of the original work." *Marsh*, 9 F. Cas. at 348. Ultimately, Justice Story found that Reverend Upham had engaged in copyright piracy, although Justice Story entertained "no doubt" that Reverend Upham considered his use of Washington's letters "a perfectly lawful and justifiable use." 9 F. Cas. at 348.



Little has changed in the over 150 years since *Folsom v. Marsh* in our attempts to determine whether a subsequent use of original material constitutes a fair use or an infringing use. In fact, when Congress passed the United States Copyright Act in 1976 (17 U.S.C. 100 et seq.), Congress codified essentially the same factors for determining "fair use" as outlined by Justice Story in *Marsh*. See 17 U.S.C. 107. And so the test established by Justice Story became the guiding principle for determining modern day fair use.

At least until 1990, when the Honorable Pierre N. Leval, now a Judge on the Second Circuit Court of Appeals, published his article "Commentary: Toward a Fair Use Standard" in the Harvard Law Review. 103 Harv. L. Rev. 1105 (1990). In his article, Judge Leval contended that the Copyright Act's fair use factors failed to provide courts with sufficient guidance to determine whether a subsequent use of original material was fair or foul. Judge Leval posited that when applying fair use factors, courts too often forgot to consider the broader purposes of the Copyright Act, and specifically the purposes of the fair use doctrine which he asserted "protects secondary creativity as a legitimate

concern of the copyright." 103 Harv. L. Rev. at 1110. Focusing on the first factor of the fair use test, which requires consideration of the "purpose and character" of the secondary use, Judge Leval asserted that the real question to be considered is whether the subsequent use is "transformative" of the original use. That is, the subsequent use must be "productive and must employ the quoted material in a different manner or for a different purpose from the original." *Id.* at 1111.

Judge Leval's assertion that the transformative nature of a work is essential to a determination of fair use was approved in dicta by the Supreme Court in *Campbell v. Acuff-Rose*, 510 U.S. 569 (1994). As a result, the fair use test has changed more in the past decade than in the entire century before. This change is not for the better. Now, almost any time I send a cease and desist letter regarding copyright infringement of one of my clients' works, I receive a letter in response from opposing counsel asserting that because his client's new work is "transformative" of my client's original work, the new work constitutes a fair use. Every time I get such a letter, I curse the name of the Hon. Pierre N. Leval, and shake my head in wonder as to how the copyright laws have become so confounding.

The question of whether a subsequent work is "transformative" of the original should have no place in the lexicon used to determine fair use. Indeed, the concept of transformation, and even the word "transform" itself, appears in a completely different section of the Copyright Act, which pertains to derivative works. A "derivative work," over which the original author has exclusive control, is defined under the Copyright Act as "a work based upon one or more pre-existing works, such as a translation, musical arrangement, art reproduction, abridgement, condensation, . . . or any other form in which a work may be recast, transformed or adapted." 17 U.S.C. 106(2) (emphasis added). If a subsequent work is "transformative" of a pre-existing work, then the second work is a derivative work and the second author may be held liable for copyright infringement. However, the fact that a second work is allegedly "transformative" of the pre-existing work has little or nothing to do with the question of fair use.

The confusion created by Judge Leval's misappropriation of the concept of transformation into the fair use context is well demonstrated by reconsidering *Folsom v. Marsh* in light of today's misguided jurisprudence. In *Marsh*, Justice Story made clear that the Reverend Upham had, indeed, transformed the preexisting work. Whereas the preexisting work was just a collection of Washington's letters in several volumes, Reverend Upham had created a work "formed upon a plan different" from that of the pre-existing work. Reverend Upham had incorporated Washington's letters into his narrative so that "Washington is made mainly to tell the story of his own life . . . with such connecting lines in the narrative, as may illustrate and explain the times and circumstances, and occasions of writing them." *Marsh*, 9 F. Cas. at 345. In the era of copyright law today, Reverend Upham's counsel would argue that the

Reverend's work was "transformative" of the prior work, giving Washington's letters new life, meaning and insight, so that his use of Washington's letters constituted the essence of fair use. And, if I were representing the author of the prior work, I would point to section 106 of the Copyright Act and proclaim that if the Reverend's work did transform my client's pre-existing work, then the Reverend's work was an unauthorized derivative work and the Reverend should be held liable for copyright infringement.

If Justice Story were alive, we know what his decision would be. But in this transformed era of copyright law, I could not advise my client with certainty as to how the court would rule in the case of *Folsom v. Marsh* today. It would depend upon whether the court found Reverend Upham's use to be transformative for purposes of fair use, or whether the court found that the second work transformed my client's work so that it was a derivative work instead. If one of the purposes of law is to create greater certainty of outcome, we have taken substantial steps backward in just the last fourteen years when it comes to application of the fair use doctrine.

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