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**JURIES AND THE DEVELOPMENT OF FAIR USE STANDARDS**

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**I. GOOGLEPLEX LITIGATION**

Recent years have witnessed two blockbuster cases in the federal courts of appeals addressing copyrightable subject matter, both brought against the same defendant. In *Garcia v. Google Inc.*,<sup>1</sup> the Ninth Circuit wrestled with whether a performance qualifies as a protectable work of authorship. In *Oracle America, Inc. v. Google*

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1. 743 F.3d 1258 (9th Cir. 2014), *amended*, 766 F.3d 929 (9th Cir. 2014), *vacated*, 771 F.3d 647 (9th Cir. 2014), *substituted opinion*, 786 F.3d 733 (9th Cir. 2015) (*en banc*).

*Inc.*,<sup>2</sup> the Federal Circuit confronted the scope of copyright protection for Application Program Interface packages (APIs), another knotty issue. Thus has the “Googleplex litigation” upheaved copyright doctrine.<sup>3</sup>

Having previously written at length about the former case,<sup>4</sup> I would like to turn my attention to the latter. In that endeavor, Peter Menell’s magisterial article is invaluable.<sup>5</sup> With consummate skill, it charts the litigation through its numerous stages, including the first trial and Google’s initial victory in the district court, to the subsequent appeal to the Federal Circuit and its reversal, and finally through retrial and renewed appeal. More importantly, it traces the implicated legal issues back to their roots in the study produced in 1978 by the Commission on New Technological Uses (CONTU). As he pointedly observes, the CONTU framework that Congress adopted provides that “when specific computer instructions, ‘even though previously copyrighted, are the only and essential means of accomplishing a given task, their later use by another will not amount to an infringement.’”<sup>6</sup>

Prof. Menell’s exhaustive analysis, demonstrating that APIs should not attract copyright, concomitantly exposes the flaws in the Federal Circuit’s ruling to the contrary in *Oracle v. Google*.<sup>7</sup> Most powerfully, he mines the Ninth Circuit’s rulings in *Sega Enters. Ltd. v. Accolade, Inc.*<sup>8</sup> and *Sony Computer Entm’t, Inc. v. Connectix Corp.*<sup>9</sup> to reveal that, far from being limited to their pronouncements about the scope of defenses, those cases hold that certain subject

2. 810 F. Supp. 2d 1002 (N.D. Cal. 2011); 847 F. Supp. 2d 1178 (N.D. Cal. 2012); 872 F. Supp. 2d 974 (N.D. Cal. 2012), *rev’d*, 750 F.3d 1339 (Fed. Cir. 2014).

3. The case of *Garcia v. Google* “represented the most significant judicial foray into copyright subject matter to occur in more than a decade,” impelling this writer to revise the entire chapter of his treatise devoted to this subject matter. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2A.04[C]. Together, “the two pieces of what can be called ‘the Googleplex litigation’ raise the issue of copyright subject matter to the fore.” *Id.* (footnote omitted).

4. See David Nimmer, *Innocence of Copyright: An Inquiry into the Public Interest*, 63 J. COPYRIGHT SOC’Y 367 (2016). As disclosed therein, this writer, together with Professors Balganesh, Hughes, and Menell, filed a brief *amici curiae* before the *en banc* Ninth Circuit in *Garcia v. Google*.

5. Peter S. Menell, *Rise of the API Copyright Dead?: An Updated Epitaph for Copyright Protection of Network and Functional Features of Computer Software*, 31 HARV. J.L. & TECH. (SPECIAL ISSUE) 305 (2018).

6. *Id.* at 384–85 (quoting NAT’L COMM’N ON NEW TECH. USES OF COPYRIGHTED WORKS, FINAL REPORT 1, 20 (1979)).

7. Distilled to its essence, the proposition is that APIs function as the levers and gears of particular digital machines — and that machinery stands outside of copyright protection. *Id.* at 433–38.

8. 977 F.2d 1510 (9th Cir. 1992), *as amended* (Jan. 6, 1993).

9. 203 F.3d 596 (9th Cir. 2000).

matter stands outside of copyright protection<sup>10</sup> — a conclusion that the Federal Circuit crucially overlooked, notwithstanding its nominal fidelity to Ninth Circuit law, when according protection to APIs.<sup>11</sup>

As a result of the Federal Circuit's erroneous reversal in favor of Oracle regarding subject matter, the case returned to the court below. At the district court level, a subsequent trial unfolded, which Google again won, this time on the basis of fair use.<sup>12</sup> That jury verdict forms the basis for a second appeal to the Federal Circuit, which is still pending.<sup>13</sup> These issues raise to the surface matters regarding jury determinations of fair use, and how they fit into the greater web of the law — a matter about which Prof. Menell and I have engaged in dialogue for over a decade.<sup>14</sup> The matter is thus ripe for exploration herein.

It may seem anomalous, at first blush, for a jury to be the body that adjudicates this key copyright defense. After all, every one of the “great fair use cases” in the field has emerged from judges, who are trained in the law — not from an ad hoc body of laypeople wholly lacking background in the ins and outs of copyright. On investigation, however, fair use trials have been far from rare — and not all of them have been bench trials.

Part II below sets the stage and then investigates past decisions by juries of contested fair use trials. Part III evaluates the interplay between judge and jury, along with the role of appellate judges considering jury verdicts, in the context of sound development of copyright precedent. Part IV concludes with observations for when to turn to juries and when to cabin their pronouncements.

## II. FAIR USE AND JURIES

### A. *The Seventh Amendment in Theory*

As out of step as it may seem with modern sensibilities seeking out expertise in every field, the Founding Fathers exalted decision by laypeople: “In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be

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10. The bulk of discussion in both *Sega v. Accolade* and *Sony v. Connectix* deals with fair use. Nonetheless, both cases cabin their fair use discussion with preliminary observations as to scope — matters that are not dicta and bear intimately on the scope of copyright protection. As Menell encapsulates the matter, their “fair use ruling is merely icing on the pro-interoperability/pro-functionality cake.” Menell, *supra* note 5, at 429–31.

11. Although *Sega v. Accolade* and *Sony v. Connectix* are adduced above for their baseline conclusions regarding copyright subject matter, those cases also shed further light on the current fair use inquiry. *See infra* Section II.A.

12. Menell, *supra* note 5, at 410.

13. One of the parties’ briefs in the pending appeal is cited below. *See infra* note 91.

14. *See infra* Section III.B.1.

preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.”<sup>15</sup> Litigation claiming copyright infringement falls within that paradigm.<sup>16</sup> The result is that, when a plaintiff sues a defendant for copyright infringement and the latter defends the conduct as fair use,<sup>17</sup> either party may demand that the case proceed to trial before a jury.

#### *B. Posture of Past Fair Use Decisions*

The first case under the Copyright Act of 1976 to reach the Supreme Court posed the question of fair use. *Universal City Studios, Inc. v. Sony Corp. of Am.* arose only after “three years of litigation, five weeks of trial, and careful consideration of extensive briefing by both sides.”<sup>18</sup> Nonetheless, the fact-finder in that instance was Judge Ferguson, not a jury. The second fair use copyright case to reach the Court under the current Act, *Harper & Row, Publishers, Inc. v. Nation Enters.*, arose in a similar pattern — a non-jury trial consuming six days.<sup>19</sup> The third one in that progression, *Stewart v. Abend*,<sup>20</sup> resulted from cross-motions for summary judgment.<sup>21</sup> *Acuff-Rose Music, Inc. v. Campbell*,<sup>22</sup> the final Supreme Court judgment adjudicating fair use, arose out of a successful defense motion for summary judgment.<sup>23</sup> The common denominator of all four cases from *Sony* to *Campbell* is that no jury was empaneled to consider the dispute in any of them.

Other cases abound in which judges, not juries, reach fair use determinations. The Ninth Circuit, for instance, handed down fair use rulings in both *Sega Enters. Ltd. v. Accolade* and *Sony v. Connectix* on appeal from trial court rulings at preliminary injunction hearings.<sup>24</sup> There is no opportunity at all for a jury determination at an injunction hearing. Scores of other decisions have arisen out of injunctions, thereby eliminating any jury input.

15. U.S. CONST., amend. VII.

16. See *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340 (1998), discussed in *infra* Section III.B.1.

17. 17 U.S.C. § 107 (2012).

18. 480 F. Supp. 429, 432 (C.D. Cal. 1979), *rev’d in part*, 659 F.2d 963, 976 (9th Cir. 1981), *rev’d*, 464 U.S. 417 (1984).

19. 557 F. Supp. 1067 (S.D.N.Y. 1983), *rev’d*, 723 F.2d 195 (2d Cir. 1983), *rev’d*, 471 U.S. 539 (1985).

20. 495 U.S. 207 (1990).

21. *Id.*

22. 972 F.2d 1429 (6th Cir. 1992), *rev’d*, 510 U.S. 569 (1994).

23. The Sixth Circuit “conclude[d] that the district court erred in granting summary judgment to defendants.” *Id.* at 1439.

24. See *supra* Part I.

When a case does proceed in district court, it can be resolved at three stages — on a motion to dismiss, at summary judgment, or at trial. Besides *Sony* and *Nation*, the two bench trials that wended their way up to the Supreme Court,<sup>25</sup> we have also already seen *Abend* and *Campbell*, two summary judgment motions that similarly ended up on review there.<sup>26</sup> That procedural vehicle also, by definition, eliminates any jury input. Among the scores of fair use decisions that courts have handed down, summary judgment is the most common posture.<sup>27</sup>

What about motions to dismiss? Given that fair use is a defense,<sup>28</sup> the traditional view was that it could not be adjudicated on a motion to dismiss, which evaluates solely the four corners of the plaintiff's complaint.<sup>29</sup> Nonetheless, that understanding itself proved wobbly earlier this decade, when a court decided that, on a motion to dismiss, it could view both the plaintiff's and the defendant's works, as appended to the complaint, thereby reaching its own determination based merely on the bare works themselves.<sup>30</sup> That decision dismissed the complaint filed by the copyright owner of "What What (In the Butt)", holding usage of that song and music video in an episode of *South Park* to constitute fair use as a matter of law.<sup>31</sup>

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25. See cases cited *supra* notes 18–19.

26. See cases cited *supra* notes 20–22.

27. For a comprehensive list of fair use cases decided under the early years of the current Act, see Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549, 554 (2008). For a roundup of the next five-year window, see Neil Weinstock Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715 (2011).

28. Even that proposition is debated. The Ninth Circuit recently went out of its way to deny that fair use is an affirmative defense. *See Lenz v. Universal Music Corp.*, 815 F.3d 1145, 1151 (9th Cir. 2015), *cert. denied*, 137 S. Ct. 416 (2016), and *cert. denied*, 137 S. Ct. 2263 (2017). Nonetheless, that ruling arose outside the context of copyright infringement, so it may not govern in that context. *See 4 NIMMER & NIMMER, supra* note 3, § 13.05[H][2]. Previous statements exist to the contrary. *See Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1239 (11th Cir. 2010) ("the fair use of copyrighted work is an affirmative defense and should be pleaded as such"); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 599 (1994) (Kennedy, J., concurring) ("Fair use is an affirmative defense").

29. *See Red Bull GmbH v. RLED, LLC*, 515 F. Supp. 2d 641, 648 (M.D.N.C. 2007). For instance, when John McCain sought to dismiss Jackson Browne's infringement suit for using the song *Running on Empty* in a political advertisement mocking rival candidate Barack Obama, the court denied the motion to dismiss as premature. *See Browne v. McCain*, 611 F. Supp. 2d 1073, 1076 (C.D. Cal. 2009).

30. *See Brownmark Films, LLC v. Comedy Partners*, 800 F. Supp. 2d 991 (E.D. Wis. 2011).

31. *Id.* at 993–95. The same result pertained in later cases exposing a fake Muslim convert to Christianity, another repurposing a photograph from a political campaign as a statement in favor of the opposing candidate, and a case inverting a cheery sitcom into an Off-Broadway play "overdosed with Chekhovian angst." 4 NIMMER & NIMMER, *supra* note 3, § 13.05[A][5][a].

*C. Need to Resolve Contested Issues*

Given the plenitude of cases resolving fair use in the posture of summary judgment — and more recently based on simply viewing the rival works themselves in the context of a motion to dismiss — what need is there for a trial at all, let alone one in which a jury serves as fact-finder? The answer is that neither dismissal nor summary judgment may be entered when the parties dispute material issues of fact.<sup>32</sup>

The Supreme Court has called fair use “a mixed question of law and fact.”<sup>33</sup> At this point, the question becomes what material issues of fact could exist in the context of a fair use dispute. In theory, an endless panoply could arise:

- (1) *Questions of historical fact.* The third fair use factor looks to “the amount and substantiality of the portion used in relation to the copyrighted work as a whole.”<sup>34</sup> When both works are in evidence (such as in the *South Park* case noted above), no ambiguity may exist on that score. But the copyright owner’s rights may be violated through unauthorized public performance,<sup>35</sup> in which no copy exists of the evanescent activity in which defendant engaged.<sup>36</sup> To the extent that the plaintiff contends that the defendant appropriated  $X\%$  of her work whereas the latter counters that he only used a fraction of  $X$ , a live dispute requires the fact-finder to determine the historical fact at issue.<sup>37</sup>
- (2) *Questions of intent.* In criminal law, it is commonplace for the jury’s reconstruction of historical fact to encompass a determination of what was in the accused’s head.<sup>38</sup> The same inquiry into intent may unfold in a fair use trial. The

32. See *Urbont v. Sony Music Entm’t*, 831 F.3d 80, 91 (2d Cir. 2016).

33. *Nation*, 471 U.S. at 560. Quotations of that formulation are legion, including in such cases as the Ninth Circuit’s ruling in *Sega v. Accolade*, the Second Circuit’s in *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013), and the Federal Circuit’s in *Oracle v. Google*, 743 F.3d at 1258.

34. 17 U.S.C. § 107(3) (2012).

35. 17 U.S.C. § 106(4) (2012).

36. See *Range Rd. Music, Inc. v. East Coast Foods, Inc.*, 668 F.3d 1148 (9th Cir. 2012) (holding infringement proven by lay testimony about defendant’s musical performance). Later, we will see a jury resolving fair use in a case against an “interactive theatrical experience.” *Keeling v. Hars*, 809 F.3d 43, 45 (2d Cir. 2015), cited *infra* note 192.

37. Cases brought by the American Society of Composer, Authors, and Publishers (ASCAP) and Broadcast Music, Inc. (BMI), of which *Range Rd.*, 668 F.3d at 1148, was an example, are among the most common fact patterns of litigated copyright disputes. See collection of citations in 2 NIMMER & NIMMER, *supra* note 3, § 8.19[B].

38. The term in that field is *mens rea*. See Jed S. Rakoff, *Copyright Damages: A View from the Bench*, 62 J. COPY. SOC’Y 377, 378 (2015).

second fair use factor investigates “the nature of the copyrighted work,”<sup>39</sup> for which the Supreme Court has ruled that a special solicitude attaches to “confidential writings not intended for dissemination.”<sup>40</sup> It accordingly may become vital to determine the author’s intent in that regard.<sup>41</sup> Moving from the plaintiff’s to the defendant’s side of the ledger, the intent of the secondary user may also come into play.<sup>42</sup>

- (3) *Questions of what might have been.* The fourth fair use factor examines “the effect of the use upon the potential market for or value of the copyrighted work.”<sup>43</sup> At this point, we leave the indicative of the previous two investigations of actual history to enter the subjunctive mood — what *would* have happened in an alternative world? In other words, but for the defendant’s infringement, would the plaintiff have been able to exploit her work within the realm that defendant actually occupied? A great deal of ink has been spilled trying to avoid the circular reasoning of characterizing the plaintiff’s potential market as consisting of the very exploitation in which the defendant engaged — no matter how far afield it may be from the plaintiff’s plans.<sup>44</sup> To avoid that vice, the Second Circuit has limited consideration of potential effects to “traditional, reasonable, or likely to be developed markets.”<sup>45</sup> The possibility is therefore rife for rival parties to advance materially different positions as to what is traditional, what is reasonable, and what markets are likely to be developed<sup>46</sup>
- (4) *Questions of fair use policy.* The previous inquiry moved from the indicative to the subjunctive. Going further still, questions arise that are normative or political in nature — how far should copyright policy constrain future

39. 17 U.S.C. § 107(2) (2012).

40. Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 554 (1985).

41. One case concluded that there was no violation of the “first publication right” inasmuch as the copyright owner never intended to publish the subject materials. *Online Pol’y Grp. v. Diebold, Inc.*, 337 F. Supp. 2d 1195, 1203 n.13 (N.D. Cal. 2004).

42. An appellate case concluded that a plagiarism detection service for high school papers “did not have the ‘intended purpose’ or ‘incidental effect’ of supplanting plaintiff’s rights to first publication.” *A.V. ex rel. Vanderhye v. iParadigms, LLC*, 562 F.3d 630, 641 (4th Cir. 2009) (quoting *Nation*, 471 U.S. at 562) (emphasis in original).

43. 17 U.S.C. § 107(4) (2012).

44. See, e.g., Chris McElwain, *Fact in the World: The Referential Model of Fair Use*, 58 J. COPY. SOC’Y 855, 878 (2011).

45. *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 930–31 (2d Cir. 1994).

46. We will see some examples of these subjunctive considerations in the cases cited below. See *infra* Section II.D.2.iii.

developers?<sup>47</sup> What is the optimal policy to be adopted as a matter of fair use?<sup>48</sup> These considerations arose in the trial of *Oracle v. Google*, so are considered in the next section.<sup>49</sup>

Two propositions must be added to that enumeration. First, it was prefaced by the words that these examples could arise *in theory*. Separate from theory is sound practice. As we will see later,<sup>50</sup> the final inquiry into *fair use policy* differs in kind from the previous three categories. Disputed issues of material fact could arise in any of those first three categories that prevent summary judgment. As to the last category, by contrast, it typically should not preclude summary judgment when standing alone.<sup>51</sup> In other words, it is only when one of the first three categories is contested that a jury trial must result — at which juncture the further question arises whether the jury should be asked to adjudicate these matters of fair use policy.

Second, the particular run-down of the four issues above is merely illustrative. Although it did not touch on the first fair use factor looking at “the purpose and character of the use,”<sup>52</sup> sub-components of that inquiry can engage each of the investigations that have just been catalogued:

- (1) Historical questions can arise as to whether the utilization in question was truly commercial<sup>53</sup> or did not deserve that label.<sup>54</sup>

47. See Fred von Lohmann, *Fair Use as Innovation Policy*, 23 BERKELEY TECH. L.J. 1 (2008).

48. Although fair use is one of the most often litigated issues within copyright cases — generating scores of published opinions — even more scholarly articles are published in the field, setting forth their authors’ policy visions. See Beebe, *supra* note 27, at 565 n.65.

49. See *infra* Section II.D.1.

50. See *infra* Section II.D.2.iv.

51. In every case, the plaintiff can aver that fair use policy favors her position, whereas the defendant can maintain the opposite with equal sincerity. Absent any open questions of historical fact, intent, or what might have been, it is highly debatable to empanel a jury just to allow both parties to ventilate their opposing theories of justice and good copyright policy, applied to their particular case. See *infra* Section II.D.2.iv.

52. 17 U.S.C. § 107(1) (2012).

53. The Supreme Court previously condemned “every commercial use of copyrighted material [as] presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright” before later retreating from that formulation. See 4 NIMMER & NIMMER, *supra* note 3, § 13.05[A][1][c].

54. One court even considered an unsponsored television broadcast as a “commercial” use, given that a television station may gain at least indirect commercial benefit from the ratings boost occasioned by an unsponsored program. See *Roy Export Co. Establishment of Vaduz Liechtenstein, Black Inc., A.G. v. Columbia Broad. Sys., Inc.*, 503 F. Supp. 1137 (S.D.N.Y. 1980), *aff’d*, 672 F.2d 1095 (2d Cir. 1982). The same court later held a magazine published for sale by a nonprofit organization to be commercial. See *Lish v. Harper’s Magazine Found.*, 807 F. Supp. 1090, 1101 (S.D.N.Y. 1992). Around the same time, it also characterized scientific research undertaken internally in the library arm of a petroleum company as commercial. See *Am. Geophysical Union v. Texaco, Inc.*, 802 F. Supp. 1, 16

- (2) Questions of intent apply to the extent that courts wish to delve<sup>55</sup> into the motivation underlying the defendant's copying<sup>56</sup> — the House Report, for example, gives special latitude under the first factor to a maligned defendant who wishes to counter the plaintiff's "unfair, inaccurate, or derogatory information."<sup>57</sup>
- (3) Inquiries into what might have been rise to the fore in the context of transformativeness,<sup>58</sup> a crucial element of the first fair use factor.<sup>59</sup>
- (4) Finally, questions of fair use policy are also implicated under the first factor.<sup>60</sup>

#### *D. The Seventh Amendment in Practice*

The previous section has confronted material factual disputes that could arise in theory. It is time to bring those ruminations down to earth — how many cases actually arise in which a jury is required to resolve contested issues of historical fact or the like? The answer is — not many. But the celebrated case that launched our inquiry is one, so it is best to start there.

##### *1. Oracle v. Google*

Unlike this article, which attempts to impose a coherent framework on a welter of cases, each individual piece of litigation

(S.D.N.Y. 1992), *aff'd*, 60 F.3d 913 (2d Cir. 1994). Ample basis arises in each instance to contest the historical facts giving rise to those conclusions.

55. The Supreme Court set forth this "bad faith exception" to fair use, albeit later authority has questioned its salience. *See infra* text accompanying note 248.

56. For instance, one court looked into "whether the paraphrasing and copying was done in good faith or with evasive motive." MCA, Inc. v. Wilson, 677 F.2d 180 (2d Cir. 1981).

57. H.R. REP. NO. 94-1476, at 73 (1976); *see also* Hustler Mag., Inc. v. Moral Majority, Inc., 796 F.2d 1148 (9th Cir. 1986). That circumstance entails investigating both the plaintiff's and the defendant's mental states, multiplying the potential disputes as to material facts. *See generally* 4 NIMMER & NIMMER, *supra* note 3, § 13.05[A][1][d].

58. We will see an example below drawn from *Oracle v. Google*. *See infra* Section II.D.1.

59. *See generally* 4 NIMMER & NIMMER, *supra* note 3, § 13.05[A][1][b].

60. On the one hand, the first factor directs attention to "whether such use is of a commercial nature," diminishing the scope of fair use if so. 17 U.S.C. § 107(1) (2012). But, on the other, its preamble gives heightened fair use protection to "criticism, comment, news reporting, teaching." 17 U.S.C. § 107 (2012). Thus arises the need to reconcile those strands when they push in opposite directions. As Judge Leval observed, "[i]n fact, publishers of educational textbooks are as profit-motivated as publishers of scandal-mongering tabloid newspapers. And a serious scholar should not be despised and denied the law's protection because he hopes to earn a living through his scholarship." *Salinger v. Random House, Inc.*, 650 F. Supp. 413, 425 (S.D.N.Y. 1986), *rev'd*, 811 F.2d 90 (2d Cir. 1987). *See generally* 4 NIMMER & NIMMER, *supra* note 3, § 13.05[A][1][a].

emerges out of its own maelstrom of activity, in which opposing litigants reach ad hoc decisions as to what is likely to help their case. They reach that decision, moreover, in the heat of the moment, based on an incomplete understanding of what future developments might take place in the case that could undermine the basis on which today's course of action is planned. *Oracle v. Google* is no exception. Far from implementing any overarching vision of copyright policy, each side made choices based on the imperfect information then available, projecting how the case would unfold in the future and what stance would most likely benefit its interests.

In terms of major flashpoint, the parties agreed that the crucial issue of copyright subject matter would be remitted to Judge Alsup alone. The jury therefore had no role in determining whether APIs should be included within the scope of protection.<sup>61</sup> By contrast, the parties agreed to submit to the jury subsidiary issues in the case, including copyright infringement, whether any copying was de minimis, and the defenses of fair use and equitable estoppel.<sup>62</sup>

At the first trial, the jury hung on whether Google's infringement of the APIs constituted fair use.<sup>63</sup> It further split on the special interrogatories relating to Google's equitable estoppel defense.<sup>64</sup>

The Federal Circuit panel came close to resolving the fair use defense in Oracle's favor, noting that, in many respects, "Google does not debate Oracle's characterization of its conduct, nor could it on the record evidence."<sup>65</sup> Nonetheless, the court concluded:

On balance, we find that due respect for the limit of our appellate function requires that we remand the fair use question for a new trial. First, although it is undisputed that Google's use of the API packages is commercial, the parties disagree on whether its use is "transformative." Google argues that it is, because it wrote its own implementing code, created its own virtual machine, and incorporated the packages into a smartphone platform. For its part, Oracle maintains that Google's use is not transformative because: (1) "[t]he same code in Android... enables programmers to invoke the same pre-programmed

61. "Thus, the most salient copyright issue — the copyrightability of APIs — was not going to be tried to the jury." Menell, *supra* note 5, at 375–78.

62. *Id.* More specifically, the jury was going to provide factual input for Judge Alsup's assessment of equitable estoppel. *See id.*

63. Menell, *supra* note 5, at 378–86.

64. *Id.* (The jury held "that Sun/Oracle engaged in conduct that they knew or should have known would reasonably lead Google to believe that it would not need a license to use the Java API SSO, but that Google had not proven that it reasonably relied on such conduct.").

65. Oracle Am., Inc. v. Google Inc., 750 F.3d 1339, 1376 (Fed. Cir. 2014).

functions in exactly the same way;” and (2) Google’s use of the declaring code and packages does not serve a different function from Java. While Google overstates what activities can be deemed transformative under a correct application of the law, we cannot say that there are no material facts in dispute on the question of whether Google’s is “transformative,” even under a correct reading of the law. As such, we are unable to resolve this issue on appeal.<sup>66</sup>

The panel added that Google’s quest to achieve interoperability could also weigh in its favor under the fair use calculus, depending on the facts,<sup>67</sup> and that material disputes existed over the scope of the potential market.<sup>68</sup>

When the second jury trial actually unfolded, that theoretical structure proved difficult to vindicate. “Oracle devoted much of its trial time to exposing emails sent among Google engineers suggesting that they thought that the Java APIs were copyright-protected.”<sup>69</sup> Google responded with testimony from its co-founder Larry Page that Google never believed that it needed a license for the APIs, as they were “free and open.”<sup>70</sup> Both of those aspects fall under the rubric set forth above of questions of intent. Nonetheless, each of those aspects is irrelevant to a fair use defense.<sup>71</sup> To quote Prof. Menell’s understatement, “[t]he connection of some lines of questioning to copyright law’s fair use factors was often tenuous.”<sup>72</sup>

What about *questions of historical fact*? Although these issues could theoretically arise in fair use cases,<sup>73</sup> in practice they tend to be rare — the parties disagree markedly not about what happened, but about its implications for fair use. *Oracle v. Google* proves the point. The high-stakes second jury trial ventilated many issues — but

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66. *Id.*

67. *Id.* at 1377.

68. “Oracle argues that, when Google copied the API packages, Oracle was licensing in the mobile and smartphone markets, and that Android’s release substantially harmed those commercial opportunities as well as the potential market for a Java smartphone device. Because there are material facts in dispute . . . , remand is necessary.” *Id.*

69. Menell, *supra* note 5, at 391–410.

70. Menell, *supra* note 5, at 404–05. Further nesting inapposite considerations, Oracle called Stefano Mazzocchi “to rebut Google’s argument that Sun acceded to others’ use of the Java APIs.” *Id.* at 400–04.

71. The elements of copyright infringement consist of the plaintiff’s ownership plus the defendant’s copying — the defendant’s mental state is relevant neither to the plaintiff’s *prima facie* case nor to the defendant’s fair use defense. See 4 NIMMER & NIMMER, *supra* note 3, § 13.08[B]. Thus were both Oracle’s evidence and Page’s response non-probatative to the jury’s determination.

72. Menell, *supra* note 5, at 391–410.

73. *See supra* Section II.C.

alternative spins about what happened in the past were not among them.

By contrast, *questions of what might have been* did occupy the parties. Oracle's economics expert, Prof. Adam Jaffe, testified that Android "very likely would not have been successful" had Google not copied the 37 APIs at issue.<sup>74</sup> Google's rebutting economics expert, Dr. Greg Leonard, responded that those 37 APIs were not "central to Android's success" and that, had Google instead programmed in a different language than Java, its product would have fared comparably well.<sup>75</sup>

Moving finally to *questions of fair use policy*, that category was equally at play. Peter Bicks, Oracle's lead counsel, framed the battle in moralistic terms with a refrain of "You don't take people's property without permission and use it for your own benefit."<sup>76</sup> Deriding Google's "fair use excuse," he sounded the theme that fair use presupposes good faith and fair dealing, whereas Google had played by its own self-serving rules.<sup>77</sup>

Robert Van Nest, Google's lead counsel, countered with a focus on Google's hard work and large investment in building a transformative smartphone platform.<sup>78</sup> He characterized Android as "precisely the kind of thing that fair use was intended to encourage."<sup>79</sup> Sounding his own moralistic theme, he inveighed: "Now Mr. Ellison wants to shut it down and put it in his pocket. That is not fair, not right, and not what copyright was intended to allow."<sup>80</sup>

## 2. Additional Cases

It is time to broaden our perspectives beyond APIs, as we can only learn so much from a single case. Let us turn to cases involving pianists, Rastafarians, nude dancing at a wet t-shirt contest, anti-pornography ordinances, and depictions of the musical groups Sex Pistols and The Four Seasons (not to mention a funkadelic groove).

74. Menell, *supra* note 5, at 400–04. He gilded that subjunctive lily by opining further that Java was "'poised to enjoy continued success' in the mobile marketplace." *Id.* But, he continued, "because of network effects, the market quickly tipped toward the Android platform and Sun was unable to recover." *Id.*

75. *Id.* at 404–405.

76. Hammering away at the same theme, he added, "you don't take 'shortcuts' at other people's expense." *Id.*

77. *Id.* We will return later to whether a "bad faith exception" to fair use exists. See *infra* text accompanying note 248.

78. Menell, *supra* note 5, at 393–95. He also "sought to sow the seed of a new fair use factor or sub-factor: compliance with industry norms surrounding APIs." *Id.*; see also text accompanying *infra* note 247.

79. Menell, *supra* note 5, at 393–95. Similarly, he later contended, "Android is exactly the kind of thing the fair use doctrine was supposed to protect." *Id.* at 405–10.

80. *Id.*

Their collective lesson is that juries may be called upon to weigh in on a welter of issues — but that there are still some boundaries beyond which judges impose their own will, regardless of the jury's determination.

*i. Ergonome v. Compaq*

I once represented at the appellate level a company who had prevailed below in its battle against an overreaching individual. Stephanie Brown was a concert pianist who wrote *The Hand Book* (THB) about proper ergonomic hand position. Brown and her husband secured a meeting with Compaq Computer Corporation to explore the company's potential purchase of a license to bundle THB with every new computer sale. But no deal was struck and Compaq instead provided purchasers with a work it had previously created in-house covering the same subject matter, the *Safety and Comfort Guide*.

After being threatened with suit for copyright infringement, Compaq filed for declaratory relief.<sup>81</sup> A seven-day trial produced a verdict of non-infringement.<sup>82</sup> The jury concluded that any copying was de minimis and also constituted fair use. The judge likewise ruled in favor of Compaq based on laches and equitable estoppel. In light of Brown's<sup>83</sup> "trial strategy of extortion by unreasonably aggressive and obstructive litigation practices,"<sup>84</sup> she was ordered to pay \$2.8 million in attorney's fees to Compaq.<sup>85</sup>

In affirming the fair use verdict, the Fifth Circuit cited no contested evidence.<sup>86</sup> Compaq admitted that it included the *Guide* along with sales of its computers, making the transaction commercial.<sup>87</sup> The plaintiffs admitted that they discontinued sales of *The Hand Book* six months before Compaq began distributing its

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81. See Compaq Comput. Corp. v. Ergonome, Inc., 137 F. Supp. 2d 768 (S.D. Tex. 2001), aff'd, 387 F.3d 403 (5th Cir. 2004).

82. *Id.*

83. The facts have been simplified. Brown and her husband did business under the corporate name Ergonome. In the text, she is used as a metonym for all three parties aligned on her side.

84. *Id.* at 415 (Pickering, C.J., specially concurring).

85. 387 F.3d at 411 (majority opinion). It is anomalous, to say the least, for a small claimant to be ordered to pay millions of dollars to a major corporation. That result inured only because of the long saga of Brown's abusive tactics — including the filing of a frivolous bankruptcy petition in order to avoid paying fees. *Id.* at 415 (Pickering, C.J., specially concurring).

86. *Id.* at 403–16.

87. Nonetheless, the Fifth Circuit sustained the district court's refusal to admit evidence for plaintiff's unsupportable theory that only her copyrighted expression saved Compaq from massive exposure to liability based on Repetitive Stress Injury. As both the trial and appellate courts concluded, the "true reason for seeking to introduce the evidence was to paint Compaq as a 'bad' company" and thereby taint the jury. *Id.* at 409 (majority opinion). The prayer to recover \$800 million on that basis was nothing short of "preposterous." *Id.* at 416 (Pickering, C.J., specially concurring).

*Guide*, thereby negating an adverse impact on its potential market.<sup>88</sup> In these and other respects, the material facts were conceded rather than contested.

In brief, this case presented neither contested questions of historical fact nor questions of intent.<sup>89</sup> Insofar as the appellate summary shows (and my own memory is in accord), the disputed facts also did not go to questions of what might have been. They dealt with questions of fair use policy only in the sense that each side argued that the defense, properly construed, favored its own position.<sup>90</sup>

#### *ii. Donna Corbello*

After the second trial of *Oracle v. Google* in which the jury ruled in its favor, Google filed its brief with the Federal Circuit.<sup>91</sup> Its introduction leads off with the proposition: “No court has ever overturned a jury’s determination on fair use. This is no time to start.”<sup>92</sup> Fate evidently does not appreciate efforts to box it in. Within a month, a court in another case did what Google claims had never before happened — it overturned a jury’s determination regarding fair use.

Tommy DeVito, one of the band members from the Four Seasons, co-wrote his memoirs along with Rex Woodard, an avid fan of the group.<sup>93</sup> DeVito gave a license in the joint work to his fellow band member Bob Gaudio, who allegedly used it in the hit play *Jersey Boys*. After an attempted “cover-up” of that unilateral grant, a lawsuit followed from Woodard’s widow, Donna Corbello.<sup>94</sup> After several

88. *Compaq*, 387 F.3d at 411 (majority opinion). The husband, moreover, conceded that “the potential market for THB was essentially thwarted by an uncontrollable market phenomenon.” *Id.*

89. The excluded evidence was purportedly offered for that purpose. *See supra* note 87. The plaintiffs quoted from the Supreme Court’s *Nation* opinion analyzing the first factor in terms of whether “the sole motive of the use is monetary gain.” But the district and appellate courts effectively shut down an inquiry into underlying “motivation” after the defendant had already conceded its commercial “intent.” *Id.* at 409.

90. *See infra* Section II.D.2.iv.

91. Brief for Google Inc., Oracle Am., Inc. v. Google Inc., Nos. 17-1118, -1202 (Fed. Cir. May 22, 2017).

92. *Id.* at 1.

93. “Rex Woodard was an attorney, author, and avid *Four Seasons* fan who finally met Defendant and founding *Four Seasons* member Tommy DeVito for an interview on December 9, 1981 as a result of the publicity generated from an article Woodard had written about the band in *Goldmine* magazine earlier that year that focused on the years between the band’s breakup in 1970 and its reconstitution in 1975.” Corbello v. DeVito, 832 F. Supp. 2d 1231, 1233 (D. Nev. 2011).

94. The facts set forth in the above paragraph emerge from the various district court opinions. *See id.*; Corbello v. DeVito, 844 F. Supp. 2d 1136 (D. Nev. 2012).

district court rulings and a Ninth Circuit reversal, the case was set for trial.<sup>95</sup>

Upon remand, the judge believed that the defendants “were entitled to a directed verdict on the fair use issue but did not want to risk a retrial in the case of reversal . . .”<sup>96</sup> Opining that the “fair use issue was properly a jury question,”<sup>97</sup> the court held a fifteen-day trial. The jury denied fair use, ruling in the plaintiff’s favor. At that point, the judge re-examined the evidence and concluded that the “[d]efendants [were] entitled to a judgment as a matter of law on the fair use issue.”<sup>98</sup>

The resulting opinion treated the evidence as univocal, not disputed. The “evidence at trial indicated that before the Play debuted, the Work had no market value,” particularly inasmuch as all concerned “had been unable to find any company interested in publishing the Work despite their various attempts to do so between 1990 and 2005, because interest in the Four Seasons was not great enough to make sales of the Work profitable.”<sup>99</sup> Thus did the uncontested evidence align the fourth factor against fair use.<sup>100</sup>

In terms of the third factor, the court noted that the play “consists of over 50% musical works (by running time) in which Plaintiff has no copyright, and the remainder of which (the non-musical script of the Play) is comprised of less than 1% of creative expression found in the Work and uses less than 1% of the Work.”<sup>101</sup> The opinion’s exhaustive parsing of the substantiality of the two works reveals no hint of any contrary evidence on which the jury could have relied.<sup>102</sup> The court ruled the first factor in plaintiff’s favor<sup>103</sup> and the second factor against her, again based on an uncontradicted record.<sup>104</sup> Specifically, the court concluded,

A work that is only unpublished because it is unpublishable despite great efforts, however, is an atypical situation. Such a work is not unavailable to the public because of a deliberate choice by the copyright owner, but because it is not commercially

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95. The appellate reversal of rulings below is set forth in *Corbello v. DeVito*, 777 F.3d 1058 (9th Cir. 2015).

96. *Corbello v. DeVito*, No. 2:08-cv-00867-RCJ-PAL, 2017 U.S. Dist. LEXIS 91164, at \*30 (D. Nev. June 13, 2017).

97. *Id.*

98. *Id.*

99. *Id.* at \*31.

100. “If anything, the Play has increased the value of the Work. The fourth, most important factor strongly favors a finding of fair use.” *Id.*

101. *Id.* at \*32.

102. *Id.* at \*32–51.

103. *Id.* at \*32, 52–55.

104. *Id.* at \*33–34.

viable. In this case, the unpublished nature of the Work does not overshadow its biographical nature. The Court finds that this factor weighs in favor fair use.<sup>105</sup>

Thus, like the *Ergonomie* case discussed previously, no real disputes of material fact marked the jury trial here.

### *iii. Richard Prince*

Not every case pertinent to our inquiry involves a jury determination. In fact, some cases in which no such empanelment took place still bear heavily on the discussion. Two cases involving Richard Prince fit that description — as well as another relying on one of the early rulings involving Prince.

After the *Corbello* ruling emerged in June 2017, *Graham v. Prince* was handed down the following month.<sup>106</sup> To better understand it, we turn first to the case’s “prequel,”<sup>107</sup> *Cariou v. Prince*.

Professional photographer Patrick Cariou spent six years living among the Rastafarian community in Jamaica, to gain their trust and take their portraits. Although the resulting coffee table book made little money, at least it earned him plans with a Manhattan gallery owner to exhibit and sell his haunting prints.<sup>108</sup> But then appropriation artist Richard Prince used Cariou’s photos without authorization as the basis for his *Canal Zone* show at the Gagosian gallery. Mixing in multiple images of white women prominently displaying their naked busts juxtaposed against Cariou’s black men, Prince also air-brushed an electric guitar into the arms of a traditional Rastafarian standing in a jungle clearing and placed lozenges over most people’s eyes.<sup>109</sup> The resulting show netted Prince and his gallery over \$18 million; it also caused the cancellation of Cariou’s own show, as the display had been “done already” at a rival gallery.<sup>110</sup>

Those extreme facts eminently warranted Judge Batts’ grant of summary judgment to Cariou on all counts.<sup>111</sup> But a panel of the Second Circuit reversed.<sup>112</sup> I have previously criticized the *substance*

105. *Id.*

106. 265 F. Supp. 3d 366 (S.D.N.Y. 2017).

107. *Id.* at 377.

108. *Cariou v. Prince*, 784 F. Supp. 2d 337, 343–44 (S.D.N.Y. 2011).

109. *Id.* at 349; *Cariou v. Prince*, 714 F.3d 694, 699 (2d Cir. 2013).

110. *Cariou*, 784 F. Supp. 2d at 344.

111. She denied the fair use defense as a matter of law. *Id.* at 353–54.

112. *Cariou*, 714 F.3d at 712.

underlying that ruling as a matter of fair use doctrine.<sup>113</sup> Here, I would like to elaborate on two equally egregious aspects of a *procedural* nature.

- (1) One who searches the Internet today can find all of the images from Cariou's book, presented there in high-resolution scans, available free of charge. The reason is not that Cariou uploaded them; nor is it that Prince put them there, and was upheld in that conduct under the fair use doctrine. Instead, the reason is that the Second Circuit Court of Appeals saw fit to publish the entire range of photographs as to which Cariou claimed injury by posting the lot to the Internet as an "appendix" to its opinion, duly including the URL in the *Federal Reporter* to guide viewers there.<sup>114</sup> In effect, the judiciary expropriated Cariou's oeuvre as a punishment for his losing.<sup>115</sup>
- (2) Judge Batts had determined all 30 works in issue to be unfair as a matter of law.<sup>116</sup> The panel reversed on all 30 counts.<sup>117</sup> As to 25 of them, the majority substituted its own contrary determination, holding them to be transformative as a matter of law.<sup>118</sup> As to the remaining five, by contrast, the majority could "not say with certainty at this point whether those artworks presented a 'new expression, meaning, or

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113. See 4 NIMMER & NIMMER, *supra* note 3, § 13.05[B][6]. For the Second Circuit's later citation to that critique, see *infra* note 225.

114. "Images of the Prince artworks, along with the Yes Rasta photographs incorporated therein, appear in the Appendix to this opinion." *Cariou*, 714 F.3d at 699 n.3. See *Patrick Cariou v. Richard Prince, 11-1197 Appendix*, U.S. COURT OF APPEALS FOR THE SECOND CIRCUIT, <http://www.ca2.uscourts.gov/docs/opn1197/11-1197apx.html> [https://perma.cc/3KLS-Q77V].

115. The panel majority considered the defendant to be a prince among the "glitterati" who rubbed shoulders with him. The opinion lists at length the wealthy and famous individuals invited to a dinner Gagosian hosted in conjunction with the *Canal Zone* opening, including "musicians Jay-Z and Beyoncé Knowles, artists Damien Hirst and Jeff Koons, professional football player Tom Brady, model Gisele Bundchen, Vanity Fair editor Graydon Carter, Vogue editor Anna Wintour, authors Jonathan Franzen and Candace Bushnell, and actors Robert DeNiro, Angelina Jolie, and Brad Pitt." *Cariou*, 714 F.3d at 709. The court also notes that Prince sold "eight artworks for a total of \$10,480,000, and exchanged seven others for works by painter Larry Rivers and by sculptor Richard Serra." *Id.* By contrast, it dismissed the plaintiff as only slightly higher than carion, continuing that "Cariou on the other hand has not actively marketed his work or sold work for significant sums, and nothing in the record suggests that anyone will not now purchase Cariou's work . . . as a result of the market space that Prince's work has taken up." *Id.*

116. *Cariou*, 784 F. Supp. 2d at 353–54.

117. *Cariou*, 714 F.3d at 712.

118. *Id.* at 706.

message.”<sup>119</sup> It therefore remanded to the district court for reconsideration.<sup>120</sup>

What metric justifies the distinction between the 25 certain instances and the five contested ones? The opinion offers no systematic rationale or description. I confess to only confusion when I examine the subject images and try to divine the dividing line. For that reason, I have conducted an experiment together with Prof. Menell: At numerous conferences of copyright lawyers and of federal judges interested in intellectual property,<sup>121</sup> we have juxtaposed various images — without revealing how the majority actually ruled — and asked the audience which deserve judgment as a matter of law versus which require remand. The results have been dismal — if our auditors had made random guesses, they would have been far closer to the court’s actual result than they achieved by trying to reason with us from features of the various photographs and by positing rationales why some might be automatically fair whereas others might require further fact-finding.

That baleful state of affairs is exactly as one member of the Second Circuit panel anticipated. Ninth Circuit Judge Wallace, sitting by designation, dissented on this basis — he would have remanded the entire case to the district court, rather than short-circuiting the process as to 25 of the works from the *Canal Zone* exhibition.<sup>122</sup> That jurist was just as confused as our audience was when trying to work out “the fact- and opinion-intensive decisions on the twenty-five works that passed the majority’s judicial observation.”<sup>123</sup> His dissent sums up this confusion best:

Indeed, while I admit freely that I am not an art critic or expert, I fail to see how the majority in its appellate role can “confidently” draw a distinction between the twenty-five works that it has identified as constituting fair use and the five works that do not readily lend themselves to a fair use determination. This, mind you, is done on a summary judgment review with no understanding of what additional evidence may be presented on remand. I also fail to see a principled reason for remanding to the district court only the five works the majority identifies as close calls, although I agree that they must be sent

<sup>119</sup> *Id.* at 711.

<sup>120</sup> *Id.* at 712.

<sup>121</sup> The conferences in question include annual gatherings of thirty to forty federal judges at Berkeley, as discussed further below, *see infra* Section III.B.1.

<sup>122</sup> *Id.* at 712 (Wallace, J., concurring in part and dissenting in part).

<sup>123</sup> *Id.* at 714.

back to the trial court. If the district court is in the best position to determine fair use as to some paintings, why is the same not true as to all paintings? Certainly we are not merely to use our personal art views to make the new legal application to the facts of this case.<sup>124</sup>

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When those chicks next returned to roost, it was hardly a migration — instead, *Graham v. Prince* was the same darn thing all over again. A professional photographer took an image entitled *Rastafarian Smoking a Joint*,<sup>125</sup> Richard Prince cropped it slightly and added to it the nonsense phrase “Canal Zinian da lam jam”<sup>126</sup> and then placed the appropriated product at the Gagosian Gallery.<sup>127</sup> He was sued for copyright infringement and responded with a fair use defense.<sup>128</sup>

Given that the case arose against the backdrop of Prince’s prior victory, Judge Stein had to be acutely aware of the dangers of reversal should he follow in Judge Batts’ footsteps by ruling in the plaintiff’s favor. His opinion is therefore replete with numerous evidentiary gaps that the parties would have to fill in:

Given Prince’s use of essentially the entirety of Graham’s photograph, defendants will not be able to establish that Untitled is a transformative work without substantial evidentiary support. This evidence may include art criticism, such as the articles accompanying defendants’ briefing, which the Court may not consider in the context of this motion [to dismiss].<sup>129</sup>

Although the Court does not now have sufficient factual information to conclude whether or not defendants have actually usurped the market for

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124. *Id.* at 713–14.

125. *Graham v. Prince*, 265 F. Supp. 3d 366, 371 (S.D.N.Y. 2017).

126. Prince himself labeled that phrase “gobblygook.” *Id.* at 380. His counsel speculated that it could be a reference to the “prior litigation” over Prince’s *Canal Zone* show. *Id.* at 380 n.11.

127. *Id.* at 372.

128. Even before suit was filed, he believed himself immune, by virtue of his previous victory. Prince tweeted photographs of his *New Portraits* works, accompanied by the message: “You can’t sue me if its [sic] not for sale. You can call me asshole lazy shit. But you can’t sue me.” *Id.* at 374 n.7.

129. *Id.* at 382.

*Rastafarian Smoking a Joint*, this factor cannot weigh in defendants' favor at the motion to dismiss stage because plaintiff has adequately pled that the "target audience and the nature of Prince's . . . work is the same as Graham's original."<sup>130</sup>

Prince may ultimately show that his work actually "appeals to an entirely different sort of collector" than Graham's, but plaintiff's allegations raise a question of fact about the market for each artist's work that cannot be resolved at the motion to dismiss stage.<sup>131</sup>

Defendants' contention that art collectors would never consider buying Prince's appropriation art in lieu of Graham's photograph may well be proven correct once the facts are fully developed, but, at the motion to dismiss stage, the Court is required give deference to plaintiff's allegations.<sup>132</sup>

At this stage, the "market effects" factor cannot weigh in favor of defendants because there are plausible allegations that the Untitled artwork — as well as the Catalog in which it was printed and distributed — share the same audience and nature as Graham's photograph.<sup>133</sup>

[Declining to convert the motion to dismiss to a motion for summary judgment,], discovery will be necessary to uncover evidence about the purposes and circumstances under which each of the allegedly infringing works were created, to ascertain whether certain of the works were commercial in nature, and to identify the markets for Graham's and Prince's works.<sup>134</sup>

Given the Second Circuit's resolution in *Cariou v. Prince* in which 25 works were deemed fair as a matter of law and another five indistinguishable variations were held to require trial for their resolution, it is hardly surprising that the sequel of *Graham v. Prince*

130. *Id.* at 384 (brackets omitted).

131. *Id.* (citation omitted).

132. *Id.* at 385.

133. *Id.*

134. *Id.* at 386.

enumerated all the above bases as standing in the way of summary disposition.<sup>135</sup> Thus does this case go further than any predecessor in setting up the need for a jury trial of fair use.

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It is also worth considering a nuanced opinion that followed Judge Batts' *Cariou* ruling, but preceded her appellate reversal.<sup>136</sup> After a photographer put out a book subtitled *A Photographic Record of the Sex Pistols Tour*, a rival artist appropriated some images, cropped and tinted them, added "grittiness," and otherwise added his own modest imprint.<sup>137</sup> Based on this "marginal artistic innovation," Judge Gee entered summary judgment to deny fair use.<sup>138</sup> But, in the same case, she ruled that a jury would reach the ultimate determination regarding a separate work, in which the defendant distorted the plaintiff's work and imposed graffiti, stars, and a logo on it.<sup>139</sup> Like the two Prince cases discussed above, this case did not actually impanel a jury.<sup>140</sup> Yet all three cases contain judicial pronouncements that bear heavily on our investigation into the proper role of juries in determining fair use in copyright cases.

#### *iv. Other Cases*

A final quartet of copyright cases deserves brief mention. They arose in disparate postures, with little in common save that a jury resolved each of them.

In 1976, the City Council of Santa Ana, California, passed an ordinance declaring adult movies to be public nuisances.<sup>141</sup> They sent an agent to Mitchell Brothers' theater to surreptitiously take photographs "every few seconds of the visual screen images while a tape recorder recorded the entire soundtrack of the films."<sup>142</sup> Based on that record, the Council labeled the Mitchell Brothers' theater a nuisance and began abatement proceedings against it.<sup>143</sup>

Taking the bull by the horns, the theater owners charged the Council with copyright infringement, precipitating a counterclaim for

135. *Id.* at 371 ("[T]he affirmative defense of fair use requires the Court to engage in a fact-sensitive inquiry . . .").

136. See *Morris v. Young*, 925 F. Supp. 2d 1078, 1086 (C.D. Cal. 2013).

137. *Id.* at 1081.

138. *Id.* at 1085.

139. *Id.* at 1088.

140. To be clear, the ruling was on a motion for summary judgment. Judge Gee's partial denial meant that a jury would need to be empaneled when the remaining part of the case proceeded to trial.

141. *Jartech, Inc. v. Clancy*, 666 F.2d 403, 404 (9th Cir. 1982).

142. *Id.* at 405 (emphasis added).

143. *Id.*

obscenity and seeking to forfeit the films as contraband.<sup>144</sup> A jury rendered special verdicts as to the plaintiffs' complaint:

- (1) each defendant was responsible for the copying of five movies to which the plaintiffs held a copyright; (2) the use made by the defendants of the copy of the films was a fair use; (3) each film was obscene; and, (4) the profits realized by the defendants as a result of the infringement of the copyright for each film was "none."<sup>145</sup>

Ruling (2) from this early case in the annals of the 1976 Act shows that jury determinations as to fair use are nothing new.

Moving to the current century, the MPAA's high profile battle against peer-to-peer ("P2P") music "sharers" resulted in two sets of jury trials. Although Jamie Thomas-Rasset was held culpable by three separate juries,<sup>146</sup> she waived the fair use defense.<sup>147</sup> By contrast, Joel Tenenbaum, a physics Ph.D. student at Boston University, and his appointed counsel, Harvard Law School Professor Charles Nesson, vigorously asserted that defense<sup>148</sup> as an integral part of their effort to turn the resulting trial into an "open-ended referendum on 'fairness.'"<sup>149</sup> They urged this proposition not only judicially, but also to the "court of public opinion."<sup>150</sup>

<sup>144.</sup> *Id.*

<sup>145.</sup> *Id.*

<sup>146.</sup> The first jury deliberated for five minutes before ruling against her. *See Capitol Records Inc. v. Thomas*, 579 F. Supp. 2d 1210 (D. Minn. 2008). After the district court threw out the third verdict, 799 F. Supp. 2d 999 (D. Minn. 2011), the court of appeals reversed to reinstate the first verdict, 692 F.3d 899 (8th Cir. 2012).

<sup>147.</sup> *See Capitol Records Inc. v. Thomas-Rasset*, 680 F. Supp. 2d 1045, 1061 (D. Minn. 2010) (second verdict).

<sup>148.</sup> Although fair use became the "capstone of the defense," it occurred only belatedly to Prof. Nesson, who did not initially plead it and previously "assured the Court that he would seek no further amendments because Tenenbaum wanted an immediate trial." *Sony BMG Music Entm't v. Tenenbaum*, 672 F. Supp. 2d 217, 219 (D. Mass. 2009), *aff'd in part*, 660 F.3d 487 (1st Cir. 2011).

<sup>149.</sup> *Id.* at 226. The court characterized Tenenbaum's view of fair use as, "not a legal doctrine tethered to the particular purposes of copyright, but a sweeping referendum on 'fairness.' It encompasses every possible inequity that might be found in the facts of this case, and owes little to precedent except — according to the defendant — its infinite elasticity." *Id.* at 237 (citation omitted). Judge Gertner was not wholly unsympathetic to that ploy. Indeed, she confessed to being "very, very concerned there is a deep potential for injustice in the Copyright Act," particularly because it "routinely threatens teenagers and students with astronomical penalties for an activity whose implications they may not have fully understood." *Id.* She further implored Congress "to amend the statute to reflect the realities of file sharing." *Id.* It may be added that Chief Judge Davis weighed in to like effect in the parallel case. *See Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210, 1227 (D. Minn. 2008) ("The Court would be remiss if it did not take this opportunity to implore Congress to amend the Copyright Act to address liability and damages in peer-to-peer network cases."). Despite that plea for future reform, based on her obligation to follow

That trial raised questions of historical fact, when Mr. Tenenbaum denied any wrongdoing and even suggested that the files in question might have been shared by others, including a visitor to the family home, family friend (possibly a visitor from Burkina Faso), foster son, or burglar. But those efforts collapsed when Mr. Tenenbaum ultimately confessed to uploading and downloading copyrighted sound recordings on various peer-to-peer networks.<sup>151</sup> As a result, Judge Gertner directed a verdict on liability, leaving for the jury only the issue of statutory damages — meaning that the jury never even considered fair use in the ultimate analysis.<sup>152</sup>

Another series of highly publicized cases arose at the same time when Bridgeport Music filed over 800 copyright infringement claims, some of which it later conceded to be without substance.<sup>153</sup> Some of the remaining cases went to trial, with a jury rejecting Universal Music's fair use defense<sup>154</sup> that the usage in question was intended as an homage or tribute to funkadelic legend George Clinton.<sup>155</sup>

Coming up to the present, Catherine Balsley served as anchor for a CBS television affiliate; while on vacation, she “entered a ‘wet t-shirt’ contest at a bar and ultimately danced nude,” only later to discover that *Hustler* published photographs of her “in various states of undress.”<sup>156</sup> After losing her position as anchor when the story broke, she purchased the copyright from the photographer in order to pursue copyright infringement litigation against Larry Flynt’s holding company, the publisher of *Hustler*.<sup>157</sup> A jury rejected the fair use

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binding law at present, she declined to allow Prof. Nesson to convert the jurors into voters for a binding referendum on whether they liked copyright law.

150. *Tenenbaum*, 672 F. Supp. 2d at 219.

151. See Affidavit in Support of Motion to Dismiss and in Support of Motion for Summary Judgment at 2, *Sony BMG Music Entm't v. Tenenbaum*, 672 F. Supp. 2d 217, 219 (D. Mass. 2009) (No.07-CV-11446-NG).

152. *Tenenbaum*, 660 F.3d at 490.

153. See Bridgeport Music, Inc. v. Universal-MCA Music Publ'g, Inc., 481 F.3d 926, 928 (6th Cir. 2007) (“Bridgeport conceded that its claims against the appellants were without merit, barred by the statute of limitations, or, more typically, some combination of both.”). The dispute over fees ultimately cost more than the original litigation, in which “neither side has covered themselves in glory . . . .” Bridgeport Music, Inc. v. Universal-MCA Music Publ'g, Inc., 583 F.3d 948, 952 (6th Cir. 2009).

154. See Bridgeport Music v. UMG Recordings, 585 F.3d 267 (6th Cir. 2009). Prof. Netanel singles out this decision among fair use cases decided between 2006 and 2010. During that interval, “a total of 82 reported opinions expressly addressed the definition of transformative use beyond simply quoting the language in *Campbell*. Of these, only three stated that altered expression without different expressive purpose can qualify as transformative.” Netanel, *supra* note 27, at 747. He continues by citing this 2009 case as “the single outlier decision between 2006 and 2010, noting that “the Sixth Circuit found the defendant’s song to be ‘certainly transformative’ because it had ‘a different theme, mood, and tone’ from the plaintiff’s composition, but then declined to overturn a jury’s verdict rejecting the defendant’s fair use defense.” *Id.* at 747 n.138 (quoting 585 F.3d at 278).

155. *Bridgeport v. UMG*, 585 F.3d at 278.

156. Balsley v. LFP, Inc., 691 F.3d 747, 755 (6th Cir. 2012).

157. *Id.*

defense after hearing all of the evidence — including an expert who testified on behalf of defendant as to the amount of profits.<sup>158</sup> The jury specifically rejected willfulness<sup>159</sup> to award the plaintiff \$135,000.<sup>160</sup>

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The foregoing list is hardly exhaustive.<sup>161</sup> A jury may consider fair use and render a verdict on which judgment is duly entered; failing post-trial motions or an appeal, the result never percolates into the case law.<sup>162</sup> Some jury verdicts regarding fair use have resulted in unpublished opinions that do not reveal enough to draw the necessary conclusions for slotting them into the instant survey. For instance, in *N.Y. Univ. v. Planet Earth Found.*,<sup>163</sup> a jury awarded NYU a half-million dollars for breach of contract, simultaneously rebuffing a counterclaim against it for copyright infringement based on its finding of fair use.<sup>164</sup> The unpublished opinion fails to describe the parties' dispute, revealing only that whether "NYU's display of copyrighted material at a fund-raiser was of a commercial nature" presented an issue that "is the jury's to decide."<sup>165</sup>

Another case reviewing the propriety of jury instructions simply sets forth the following:

Therefore, if you find that Ms. Liu owns a valid copyright for the China REVUP computer program, and further, that Computer Language Research and Mr. McNerthney's actions do not constitute a fair

158. *Id.* at 756.

159. It credited the defense of good faith/advice of counsel. *Id.* at 757. But this defense arises independently of fair use.

160. *Id.* The appellate decision largely subjects allegations of jury tainting, all of which it rejects, to a heightened standard due to defendants' failure to object at trial. *See id.* at 764–66 (noting, for example, references to Larry Flynt's failure to attend the trial; to the fact that defense counsel was a woman; and to the fact that plaintiff's counsel conceded that his client's behavior was a mistake, but added that he would be proud if his daughter, like plaintiff, was able to stick up for what she believes in).

161. Additional cases cited elsewhere in this article include the *Bateman* case, *infra* note 181; the *Keeling* case, *infra* note 192; the *Lowry*'s case, *infra* note 208; and the *Cisco* case, *infra* note 219. None of those cases contains actionable lessons for the current study, as will become apparent when each is discussed below.

162. Under those circumstances, the case-management decision to place the fair use determination in the jury's hands deprives the public of the underlying reasoning and leaves the resolution without precedential value. But that same result injures even when the parties waive trial by jury, to the extent that the judge issues a simple judgment without elaborating the reasons motivating the decision. In short, judges who wish to contribute to stare decisis must follow up the judgment with a reasoned opinion, regardless of whether a jury has served.

163. 163 Fed. App'x 13 (2d Cir. 2005).

164. *Id.*

165. *Id.* at 14.

use as I will describe to you, then I instruct you that you must also find that Price Waterhouse and Computer Language Research infringed Ms. Liu's copyright when Mr. McNeirthney copied the SKY REVUP program onto his computer.

If you find that Patrick McNeirthney's use of NewRevUp32 was not a fair use, plaintiff may not recover profits arising from the sale of McNeirthney's 1996 version of RevUp32 without also proving that his version was substantially similar to the derivative NewRevUp32 in which Liu claims a copyright.<sup>166</sup>

And even published opinions are sometimes so parsimonious in their descriptions as to likewise fall outside this survey.<sup>167</sup>

### III. EXPANDING OUR FIELD OF VISION

In 1998, Judge John Newman dissented from the view that "juries can be counted on to understand the differences between the Lanham Act and the Copyright Act."<sup>168</sup> His rationale resonated greatly with me at the time:

My view that juries have a difficult time understanding the principles of such unfamiliar fields of law as copyright and trademark is based on the fact that judges, including myself, have difficulty fully grasping the subtleties of these doctrines, even though we deal with them far more often than do juries.<sup>169</sup>

#### *A. Elitist Disdain for Jury Determinations of Fair Use*

Judge Newman's 1998 words hit home for me inasmuch as I also found the fair use doctrine highly challenging, notwithstanding that I devoted my whole professional life to studying copyright law. As

<sup>166</sup> Liu v. Price Waterhouse LLP, No. 97 CV 3093, 2000 U.S. Dist. LEXIS 16762, at \*14, \*18 (N.D. Ill. Oct. 27, 2000).

<sup>167</sup> An example is one case where a photographer sued a magazine for inclusion of a photo in the Forbes 400 listing; the decision states simply: "The jury ruled for Walker, rejected Forbes' fair use defense, and awarded damages in the amount of \$ 5,823." *Walker v. Forbes, Inc.*, 28 F.3d 409, 410 (4th Cir. 1994).

<sup>168</sup> *Samara Bros., Inc. v. Wal-Mart Stores*, 165 F.3d 120, 136 n.5 (2d Cir. 1998) (Newman, J., dissenting in part), *rev'd on other grounds*, 529 U.S. 205 (2000).

<sup>169</sup> *Id.*

such, I viewed with suspicion the notion that juries could be called upon to return a verdict on the subject. Instead, it seemed to me, sound development of copyright doctrine, not to mention the need for uniformity and adherence to precedent, demanded that a judge rather than a jury duly adjudicate the legal aspect of fair use.

Scholarship produced at the same time championed the view that independent judicial review was necessary in the domain of *substantial similarity*, in order to protect the First Amendment interests that pervade the law of copyright.<sup>170</sup> Along with substantial similarity, the question of *fair use* presents the quintessential copyright doctrine about which the most cases arise, with the greatest challenge to doctrinal harmony.<sup>171</sup> The need to safeguard First Amendment values is just as pronounced in fair use cases as in substantial similarity cases.<sup>172</sup> Parallel considerations therefore demanded independent judicial review for fair use, it seemed to me then, rather than reliance on the “black box” of a jury verdict.<sup>173</sup>

In sum, my view at the time was that Judge Newman was wise to point out that “juries have a difficult time understanding the principles of such unfamiliar fields of law as copyright. . . .”<sup>174</sup> Taking citizens off the street and asking them to render judgment in an unfamiliar and technical arena, based on elaborate instructions orally conveyed to them one time only, seemed like a fool’s errand — it struck me that laymen were not fit to discharge the duties that were challenging even to specialists in the field. (The phenomenon may therefore reflect “specialist suspicion” more than “elitist disdain.”)

In particular, it struck me as impossible to cobble together the necessary jury instructions encapsulating one of the most “troublesome” and indeterminate doctrines in all of the law.<sup>175</sup> The court could quote the four factors set forth in the statute<sup>176</sup> — but each

170. See Eugene Volokh & Brett McDonnell, *Freedom of Speech and Independent Review in Copyright Cases*, 107 YALE L.J. 2431 (1998).

171. See the citations collected in 4 NIMMER & NIMMER, *supra* note 3, §§ 13.03, 13.05.

172. See *Golan v. Holder*, 565 U.S. 302 (2012); *Eldred v. Ashcroft*, 537 U.S. 186 (2003); *Nation*, 471 U.S. at 559.

173. As the same commentator cited above pointed out in the same year, parallel considerations can resonate out to other copyright domains, as well. See Mark Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147 (1998).

174. *Samara Bros., Inc. v. Wal-Mart Stores*, 165 F.3d 120, 136 n.5 (2d Cir. 1998) (Newman, J., dissenting in part), *rev’d on other grounds*, 529 U.S. 205 (2000).

175. See *Dollar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2d Cir. 1939) (describing fair use as “the most troublesome [doctrine] in the whole law of copyright”); *Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 144 (S.D.N.Y. 1968) (describing fair use as “so flexible as virtually to defy definition”); see generally David Nimmer, “*Fairest of Them All*” and *Other Fairy Tales of Fair Use*, 66 L. & CONTEMP. PROBS. 263, 263 (2003).

176. See 17 U.S.C. § 107 (2012).

is subject to sub-factors,<sup>177</sup> and the enumeration changes constantly with developments in the jurisprudence.<sup>178</sup> Essentially, in order to be apprised of what is relevant, the jury would need to review and digest centuries of copyright history culminating in the latest version of a comprehensive compendium charting the current development of fair use doctrine.<sup>179</sup> That exercise seemed out of reach.<sup>180</sup> Indeed, cases decided during that era posed fiendishly difficult exercises parsing the language of fair use jury instructions.<sup>181</sup>

### B. Learning to Love the Seventh Amendment

#### 1. The Proper Role for Juries

In the interim, my thought process has evolved such that it now stands at the opposite pole. Two circumstances unfolded since 1998 that have caused me to see Judge Newman's aperçu in a new light.

The first stems from a Supreme Court case decided that same year. In *Feltner v. Columbia Pictures Television, Inc.*,<sup>182</sup> a unanimous Supreme Court ruled that the Seventh Amendment requires a jury to

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177. We have already seen above that the first fair use factor encompasses an inquiry into commerciality; intent; transformativeness; and fair conduct by the plaintiff. *See supra* Section II.C. The last sub-factor is itself disputed, and has fallen into and out of favor. See text accompanying *infra* note 248.

178. For a case posing challenges to how the jury instructions conveyed the sub-factor under the second fair use factor of whether the subject work was "unpublished" see *Bosch v. Ball-Kell*. No. 03-1408, 2007 U.S. Dist. LEXIS 63785, at \*4–5 (C.D. Ill. Aug. 29, 2007). That case also posed inquiries under the fourth factor. *Id.* at \*5–6.

179. In codifying the fair use doctrine in the 1976 Act, Congress "endorse[d] the purpose and general scope of the judicial doctrine of fair use" while perpetuating the doctrine's common law character. H.R. REP. NO. 94-1476, at 66 (1976). Congress noted that "there is no disposition to freeze the doctrine in the statute, especially during a period of rapid technological change." *Id.* It continued, stating that "[b]eyond a very broad statutory explanation of what fair use is and some of the criteria applicable to it, the courts must be free to adapt the doctrine to particular situations on a case-by-case basis." *Id.* *See generally* Peter S. Menell, *The Mixed Heritage of Federal Intellectual Property Law and Ramifications for Statutory Interpretation*, in INTELLECTUAL PROPERTY AND THE COMMON LAW 63, 75 (Shyamkrishna Balganesh ed., 2013).

180. From experience, I can state that the treatise discussion devoted to fair use is subject to the most constant revision of the entire set. *See* 4 NIMMER & NIMMER, *supra* note 3, § 13.05.

181. One case is particularly relevant as a predecessor to *Oracle v. Google*, inasmuch as it arose in the context of fair use of computer software. In *Bateman v. Mnemonics, Inc.*, the Eleventh Circuit vacated the copyright verdict based on improper jury instructions: "[t]he district court gave no instruction on whether the application program/SBCOS interface at issue in this case was a constraint that rendered the interface either unprotectable or subject to a fair use analysis." 79 F.3d 1532, 1546 (11th Cir. 1996). Judge Birch faulted the district court for failing to assemble jury instructions sufficient to illuminate all the applicable circumstances. *Id.* ("When this instruction is considered together with the 'Nimmer instruction,' which was limited to nonliteral similarity, it is clear that the court failed to instruct the jury that compatibility, whether it pertains to originality or fair use analysis, is a consideration that applies at the literal level.").

182. 523 U.S. 340 (1998).

fix the appropriate amount of statutory damages to be awarded to a prevailing plaintiff.<sup>183</sup> Consonant with the 1998 sensibility discussed above, I reacted with alarm to that ruling. A large body of case law existed as of that date, calibrating awards in the case at bar against past precedent, taking into account any relevant differences in circumstances. To take but one domain, a large body of cases is filed by performance rights organizations, such as ASCAP. As of 1998, courts had examined past precedent to come up with a consistent body of case law awarding statutory damages in calibrated amounts against bars and restaurants that had failed to take out the requisite ASCAP license.<sup>184</sup> A jury simply would not be able to undertake that classically judicial role. Chaos loomed before us, I feared.

Experience over the past two decades has debunked my fears. ASCAP and BMI have not slackened off from bringing infringement suits to enforce their rights, in which they still routinely ask for statutory damages.<sup>185</sup> Parties typically waive their right to a jury trial, so judges continue to adopt the same precedential evaluation of the proper figure to award, under the circumstances.<sup>186</sup> But when juries have been called upon to award statutory damages outside of the music performance context, they have proven able to produce figures<sup>187</sup> that appellate courts ultimately approve.<sup>188</sup> Notwithstanding my initial misgivings, the system has worked.<sup>189</sup>

The second factor emerges from the Federal Judicial Center's (FJC) annual Intellectual Property Seminars in Berkeley, California, held every year since around 1998. Under Prof. Menell's baton, about 40 judges per year have spent three to four days at Boalt Hall,

<sup>183.</sup> *Id.* at 355.

<sup>184.</sup> See 2 NIMMER & NIMMER, *supra* note 3, § 8.19[B] (citing cases through 1998).

<sup>185.</sup> *Id.* (citing cases since 1998).

<sup>186.</sup> *Id.*

<sup>187.</sup> In one of the early post-*Feltner* cases, the jury awarded \$275,000. See *Yurman Design, Inc. v. PAJ, Inc.*, 93 F. Supp. 2d 449, 461–462 (S.D.N.Y. 2000). The district court sustained the award “as both a specific and general deterrent to future infringement” by a willful defendant. *Id.* at 462. The Second Circuit affirmed. 262 F.3d 101, 113–14 (2d Cir. 2001). Moving closer to the present, a district court sustained a jury’s verdict of 13 awards at the maximum of \$150,000 apiece. See *Virtual Studios, Inc. v. Beaulieu Grp.*, 987 F. Supp. 2d 769, 776 (E.D. Tenn. 2013).

<sup>188.</sup> Besides the *Yurman* case just cited, we can look back to the two P2P cases cited earlier. See *supra* Section II.D.2.iv. As to both Jamie Thomas-Rasset and Joel Tenenbaum, the appellate courts vindicated the jury verdicts. See *Capitol Records Inc. v. Thomas-Rasset*, 692 F.3d 899, 907–10 (8th Cir. 2012); *Sony BMG Music Entm’t v. Tenenbaum*, 660 F.3d 487, 508–09 (1st Cir. 2011).

<sup>189.</sup> This is not to say that it cannot be improved. Sensible policies have been urged to alter the permissible ranges for awarding statutory damages. See Peter S. Menell, *Reflections on Re-Equilibrating Copyright for the Internet Age*, 61 J. COPY. SOC’Y 235, 300–01 (2014); Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439 (2009). The point here is that, whatever limits Congress sets, juries are able to exercise their discretion in order to return sustainable verdicts within that range.

conducted through copyright law along with patents and trademarks. Each year, we have devoted a large segment of the copyright presentation to fair use.

In that context, Prof. Menell and I have experienced a fascinating give-and-take with the assembled appellate judges, district judges, and magistrate judges. Our concern with the purity of copyright doctrine and its incremental development in a precedential system initially led us to resist jury determinations of fair use, apart from their role in pinpointing areas in which dispute has arisen as to historical facts. When we articulated that proposition over the course of years, we consistently met an implacable wall of resistance. If there are issues in the case that require a jury to be impaneled, the judges have told us countless times, then that jury must be meaningfully empowered. It is anathema, in the minds of our judicial interlocutors, to have a jury sit through a whole trial, only to be asked a few cherry-picked questions at the end so that the judge can resolve all the hard questions. Instead, the jury's investment of time must be respected by an equal investment of judicial trust in its ability to render a meaningful assessment of the case.

That viewpoint is not restricted to the judges who happen to be present over the years at the FJC seminar. In opposition to the 1998 articles previously cited that call for divesting juries of a role in fair use in order to preserve First Amendment values, a new view can also be found in the literature — that juries themselves furnish a First Amendment safeguard. Put simply, this view argues that

[i]t is time, then, to return to the original conception of fair use — as a fact-intensive inquiry most appropriate for the jury. Judges must recognize anew the factual nature of the fair use inquiry. They must appreciate that fair use inferences are laden with social value judgments that are best left to juries.<sup>190</sup>

What about the problem ventilated above concerning proper jury instructions?<sup>191</sup> More recent decisions have alleviated that concern, as well. When a stage play called *Point Break Live!* made fun of actor

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190. Ned Snow, *Judges Playing Jury: Constitutional Conflicts in Deciding Fair Use on Summary Judgment*, 44 U.C. DAVIS L. REV. 483, 556 (2010). To support the above notion that his view represents a “return to the original conception of fair use,” this commentator synthesizes the historical record to conclude, “from the outset of the fair use doctrine in the mid-1700s to the mid-1900s, fair use represented a triable issue of fact for a jury.” *Id.* at 528. See also Ned Snow, *Proving Fair Use: Burden of Proof as Burden of Speech*, 31 CARDOZO L. REV. 1781, 1790 (2010).

191. See *supra* Section III.A.

Keanu Reeves in the movie *Point Break*,<sup>192</sup> the case presented to the jury that species of fair use known as parody.<sup>193</sup> Far from instructing the jury on the most recent exegesis of each statutory fair use factor, Judge Grisea omitted the enumeration altogether in his charge.<sup>194</sup> Instead, he boiled the defense down to five brief summary paragraphs.<sup>195</sup> After a five-day trial, the jury vindicated the fair use defense.<sup>196</sup> The Second Circuit affirmed.<sup>197</sup> The procedural posture of this case was particularly convoluted — but the jury was able to carry out its role admirably.<sup>198</sup> This experience further defangs my earlier fears.

This progression leads to a currently revised conclusion, as the opinions of hundreds of federal judges gathered across the years in Berkeley should not be discounted lightly.<sup>199</sup> The counsel of their council has caused me to no longer focus principally on Judge Newman's observation that "juries have a difficult time understanding the principles of such unfamiliar fields of law as copyright" so much as on his following observations that "judges, including myself, have difficulty fully grasping the subtleties of these doctrines, even though we deal with them far more often than do juries."<sup>200</sup> Of course, I must

192. The court described the defendant's work as "an irreverent, interactive theatrical experience." *Keeling v. Hars*, 809 F.3d 43, 45 (2d Cir. 2015). "A central conceit of the PBL parody is that the Keanu Reeves character is selected at random from the audience and reads his lines from cue cards, thereby lampooning Reeves's reputedly stilted performance in the movie." *Id.*

193. The Supreme Court's 1994 *Campbell* case cited above is the granddaddy authority for this branch. Actually, the issue should have been resolved in 1957 — but Justice Douglas' improper recusal delayed the matter for decades. See Robert Brauneis, *Parodies, Photocopies, Recusals, and Alternate Copyright Histories: The Two Deadlocked Supreme Court Fair Use Cases*, 68 SYRACUSE L. REV. 7 (2017).

194. *Keeling*, 809 F.3d at 47 ("Now, it is sometimes said that the judge in instructing a jury on fair use is supposed to refer to a list of factors. The list of factors is a list of factors without much content or meaning. And what I am trying do with you now is to refer to the necessary factors but I hope put a little more content on the discussion.").

195. *See id.* at 46–47 (setting forth full quotation).

196. *Id.* at 46.

197. *Id.* at 52 (concluding that the district court's failure to enumerate the four statutory factors did not constitute plain error).

198. Normally, a jury that accepts the fair use defense rules for the defendant. In this unusual case, by contrast, it was the *plaintiff* who urged a fair use defense. 809 F.3d at 47. In particular, Jamie Keeling claimed that her parody of the movie qualified as fair use and further that the resulting stage play constituted a separately copyrightable work, on which basis she sued Eve Hars for continuing to mount the play even after their contract had expired. *Id.* Hars defended on the basis that the appropriation from the movie rendered the play unprotected, given that the Act mandates that copyright "does not extend to any part of the work in which such material has been used unlawfully." 17 U.S.C. § 103(a) (2012). The jury therefore had to make a threshold determination as to fair use and a later determination as to Keeling's own originality en route to awarding her \$250,000. 809 F.3d at 47.

199. Of course, having previously changed my mind, I must acknowledge the possibility of later discarding today's conclusion.

200. *Samara Bros., Inc. v. Wal-Mart Stores*, 165 F.3d 120, 136 n.5 (2d Cir. 1998) (Newman, J., dissenting in part).

include myself among those who have difficulty fully grasping the subtleties of these doctrines. The Seventh Amendment empowers the citizenry, serving as a bulwark against decisions imposed from above by government functionaries — even those wearing black robes. Fortified by that shedding of elitism, it no longer seems like such a bad idea to let the jury decide fair use.<sup>201</sup>

## 2. The Proper Role for Courts

Of course, it does not follow that anything goes. The jury must reach a reasonable interpretation — as must judges.

When a case is decided on summary judgment, the question is whether the district judge assessed the uncontested facts properly, under an accurate interpretation of governing law. Similar considerations apply to decisions by district judges on motions to dismiss<sup>202</sup> and motions for preliminary injunctions.<sup>203</sup> When there is a bench trial, the question is whether the conclusions of fact are borne out by the evidence, again under the appellate court's articulation of the law.

Shifting gears, what change occurs when the decision below has been rendered by a jury? In principle, the exercise remains the same. The jury's product cannot be accepted uncritically — instead, the question is still whether its conclusions are borne out by the evidence.<sup>204</sup> In a motion for judgment as a matter of law following the verdict, the district judge thus still faces the same constraints as exist in other postures that channel the ruling into a principled decision. Later, if an appeal arises from the judgment rendered after a jury verdict, the same safeguards follow to place the case into the fabric of governing precedent.

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201. To reiterate, “fair use inferences are laden with social value judgments that are best left to juries.” See text accompanying *supra* note 190.

202. In this context, the facts are not only uncontested, but the only facts that matter are those that appear on the face of the complaint and information that it annexes into the record.

203. The facts may be contested by the parties at the injunction hearing, but the district judge can evaluate the probability of success on the merits, given the evidence that is introduced — and the appellate court can evaluate the proceedings below based on fidelity to those principles.

204. Conflicting evidence in a given case might cause a judge to rule, on balance, for one party — whereas the jury might have ruled in favor of the other. As long as there was some factual support for the winning party’s position, the verdict can stand.

## IV. RETROSPECTIVE AND THE WIDE ARC

### *A. The Past*

The sensibility of jury-deference<sup>205</sup> makes sense out of the jury cases discussed above. If copyright infringement arises ancillary to open issues in a nuisance abatement action against a porn theater, then the same jury that decides these issues should also be entrusted to reach a fair use determination (as in the Mitchell Theaters case).<sup>206</sup> If the only issue is copyright infringement, but there are open questions in the case relating to issues other than fair use — for instance, whether the infringement took place willfully, such that the level of statutory damages could be elevated — then, again, the same jury that decides the other issues should also resolve fair use (as in the news anchor's wet t-shirt case).<sup>207</sup> If the only matter on the table is fair use, but that question itself requires resolving disputed facts<sup>208</sup> — such as whether defendant composed his own work as an homage to an illustrious predecessor — then the jury should not only answer the historical question but should also reach the ultimate decision whether the usage was fair (as in the Bridgeport Music case).<sup>209</sup>

Nonetheless, there are limits here. To the extent that defendants wish to urge fair use as a device to register their opposition to copyright laws, their position does not warrant judicial disposition (as in the peer-to-peer cases).<sup>210</sup> Reverting to the possible bases for jury intervention, questions of fair use policy do not invite open-ended justification for any and all conduct. Only when a defendant's usage colorably falls into one of the fair use categories can the matter be presented to a jury for resolution. In other words, it must arguably embody the requisite transformation, parody, criticism, news reporting, or other feature on which fair use could be vindicated.<sup>211</sup>

205. See *supra* Section III.B.2.

206. See *Jartech, Inc. v. Clancy*, 666 F.2d 403 (9th Cir. 1982).

207. See *Balsley v. LFP, Inc.*, 691 F.3d 747, 755 (6th Cir. 2012).

208. As noted above, those instances are rare. See *supra* Sections II.D.2.i–ii. Nonetheless, it does arise on occasion. One case, for instance, required a jury to resolve conflicting testimony, including whether the defendant printed out only one copy of the subject email, and did so only for personal use. See *Lowry's Reports, Inc. v. Legg Mason, Inc.*, 302 F. Supp. 2d 455, 461–62 (D. Md. 2004).

209. See *Bridgeport Music v. UMG Recordings*, 585 F.3d 267 (6th Cir. 2009). The issue in that case was the defendant's intent in composing, whether tribute or rip-off. As previously noted, a question of intent is one subset of questions of historical fact, namely what was in a given individual's head at a certain past time. See *supra* Section III.I.C.

210. See, e.g., *Capitol Records Inc. v. Thomas*, 579 F. Supp. 2d 1210 (D. Minn. 2008). Per several judges' fervent pleas, however, the position could be urged to Congress. See *supra* note 149.

211. The reason that the word "arguably" appears above is to convert a blanket statement that "it must embody . . ." to the more nuanced "it must be such that a reasonable factfinder could determine that it embodies . . ." Reverting to the sentiment that "fair use inferences

Once it does, then a jury should be asked to resolve contested questions of historical fact, questions of intent, and questions of what might have been.

It was noted above that opposing litigants reach ad hoc decisions as to what is likely to help their case, rather than attempting to vindicate good copyright policy as a global matter. The same constraints apply to judges — more exigent to them than contributing to the sensible development of coherent precedent is the immediate pressure of the docket. A good illustration emerges from the *Compaq* litigation discussed above.<sup>212</sup> Faced with a recalcitrant party who abused the litigation process, Judge Melinda Harmon could have rested her ruling against that individual on the basis of equitable estoppel. But summary judgment to that effect would have given Stephanie Brown the opportunity to appeal, with all presumptions weighted in her favor as the losing party. Instead, Judge Harmon sagely decided to empanel a jury.<sup>213</sup> Once the jury ruled against Brown, the final judgment became essentially bullet-proof. Indeed, the Fifth Circuit did not even reach the estoppel ruling, instead hanging its hat solely on the fair use verdict, as to which the record contained at least some evidence in support — which is all that is required.<sup>214</sup>

Thus viewed, the jury is an insurance policy for the judge. Of course, the gambit does not always work. In the *Corbello* case, Judge Robert C. Jones believed that the defendants “were entitled to a directed verdict on the fair use issue.”<sup>215</sup> Nonetheless, having been previously reversed in this very case, he “did not want to risk a retrial in the case of reversal” for a second time, so he empaneled a jury.<sup>216</sup> When that jury ruled in favor of fair use, he reluctantly threw out the verdict and issued a lengthy opinion specifying why his review of the evidence inexorably led him to conclude the opposite.<sup>217</sup> Although that posture is not as invulnerable on review as he might have wished, at least it vindicates his view of the proper result as a matter of copyright doctrine.

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are laden with social value judgments that are best left to juries,” if there is room for dispute over the implicated social values, a jury is warranted. *See supra* note 201. If there is no room for that dispute — such as a binding referendum on whether the jurors like copyright law — then there is no need for a jury. *See supra* note 149.

212. *See supra* Section II.D.2.i.

213. *Id.*

214. *Id.* It is to be noted that the same overlap of equitable estoppel and fair use also unfolded in *Oracle v. Google*. *See supra* Section II.D.1.

215. *See supra* Section II.D.2.ii.

216. *Id.*

217. *Id.*

*B. The Present*

Jury determinations of fair use in copyright cases seem to have entered their heyday. *Oracle v. Google* represents perhaps the most famous exemplar of all time — and even since that recent ruling, the *Graham* and *Corbello* cases indicate increased ferment in the field.<sup>218</sup> Moreover, another jury trial in a copyright case posing a fair use defense is simultaneously wending its way on appeal to the Federal Circuit.<sup>219</sup> With all these developments simultaneously unfolding, the contested questions that go into the complex “mixed issue of fact and law”<sup>220</sup> that is fair use thus seem destined only to multiply in the future.

Indeed, the lengthy quotations set forth above from *Graham v. Prince* reveal an unprecedented array of contested facts standing in the way of summary disposition.<sup>221</sup> From an exploration into whether Prince’s appropriation was transformative — which itself could require art criticism — to questions about whether the defendants have actually usurped the plaintiff’s market and who the two target audiences are, to whether the opposing parties appeal “to an entirely different sort of collector,” to whether the plaintiff’s “art collectors would never consider buying Prince’s appropriation art in lieu of Graham’s photograph,” to whether the two “share the same audience,” and finally to uncovering “the purposes and circumstances under which each of the allegedly infringing works were created,” the case bodes an epic jury battle.<sup>222</sup>

Insofar as *Graham* and the other recent cases represent a reaction to evolving fair use doctrine, their heightened sensitivity to defer to a jury is appropriate. Indeed, the Second Circuit’s ruling in *Cariou v. Prince* appears to signal just such a doctrinal realignment.<sup>223</sup> Nonetheless, on closer inspection, there is reason to doubt that we are

218. Another recent jury disposition of fair use comes from the Second Circuit, namely the *Keeling* case. *See supra* note 192.

219. In another mammoth battle of the computer industry arising over Ethernet switches, the court denied summary judgment and set the question of fair use for trial. *See Cisco Sys. v. Arista Networks, Inc.*, No. 14-cv-05344-BLF, 2016 WL 4440239 (N.D. Cal. Aug. 23, 2016). Its opinion spent pages reviewing the third fair use factor, *id.* at \*5–6, and marshalling the parties’ contradictory factual allegations concerning whether Arista copied “the heart of the work,” *id.* at \*6.

When the trial took place, the jury ultimately ruled that Arista infringed on Cisco’s copyright “but that the infringement was excused by the *scènes à faire* [sic] affirmative defense.” *Cisco Sys. v. Arista Networks, Inc.*, No. 14-cv-05344-BLF, 2017 WL 4771009, at \*1 (N.D. Cal. May 10, 2017). Evidently, the jury did not reach the analytically separate matter of fair use.

220. *See* cases cited *supra* note 33.

221. *See supra* Section II.D.2.iii.

222. *Id.*

223. *Id.*

in the midst of a paradigm shift that will increase the number of fair use cases submitted to jury panels.

There are two related flaws in *Cariou v. Prince*, one substantive and the other procedural. In terms of substance, that decision pushes the pendulum too far in defendants' favor. The opposite reaction has already begun. Judge Easterbrook has signaled the Seventh Circuit's disagreement with *Cariou*<sup>224</sup> and the Second Circuit itself has gingerly begun the process of retreating from that case's high tide.<sup>225</sup> In terms of substance, therefore, there is reason to predict that future courts will not long look to *Cariou* as the precedent that needs to be followed.

The related flaw arises out of procedure. As treated above, there is no principled way to apply the majority's ruling, given the split panel's failure to differentiate meaningfully between works that require jury determination and those that do not. For that reason, Judge Stein resolved *Graham* in the only way cognizable given the circumstances — by elaborating the long list of contested facts set forth above.<sup>226</sup>

Nonetheless, what is important for current purposes is to focus on how much *Graham* does *not* differ from past fair use cases — except that it fell within the particular orbit of *Cariou* given its tightly overlapping circumstances (appropriation by Richard Prince with minimal changes of a plaintiff's photographs of Rastafarians and its subsequent display at the Gagosian Gallery). *Graham* raises the question of how transformative the work in question was — the same question that essentially every fair use case since *Campbell* has confronted.<sup>227</sup> In that context, it had no greater need to hear from art critics than did past fair use cases, the overwhelming majority of which have been litigated to completion without any jury input.<sup>228</sup>

As to the balance of circumstances that Judge Stein elaborated, previous fair use cases likewise resolved all of them absent juries. Consider that, before Richard Prince, there was Jeff Koons. That earlier appropriation artist sometimes won his Second Circuit

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224. "We're skeptical of *Cariou*'s approach." *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756, 758 (7th Cir. 2014).

225. "Insofar as *Cariou* might be thought to represent the high-water mark of our court's recognition of transformative works, it has drawn some criticism." *TCA TV Corp. v. McCollum*, 839 F.3d 168, 181 (2d Cir. 2016) (citing *Kienitz*, 766 F.3d at 758, and NIMMER & NIMMER, *supra* note 3, § 13.05[B][6] at 13.224.20).

226. See *supra* Section II.D.2.iii.

227. See *Beebe*, *supra* note 27; *Netanel*, *supra* note 27.

228. See *Cheffins v. Stewart*, 825 F.3d 588, 600 (9th Cir. 2016) (McKeown, J., concurring) (recognizing that fair use cases under the Copyright Act have forced judges "to devote themselves to . . . critiquing paintings and sculptures"); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403 (9th Cir. 1997) (rejecting proffered literary criticism for fair use defense as "pure shtick" and "post-hoc characterization of the work").

appeals<sup>229</sup> and sometimes lost them.<sup>230</sup> But the common feature of both his victories and defeats is that they arose out of summary judgments, not jury determinations<sup>231</sup> — notwithstanding that those cases posed equally pointed questions as to whether the artworks in question usurped the plaintiff's market, whether they appealed to an entirely different sort of collector, whether the parties shared the same audience, and what were the pertinent purposes and circumstances under which the defendants' works were created.

As previously noted, savvy trial judges choose from an array of possibilities in the manner that best serves their docket.<sup>232</sup> Thus, Judge Stein set the above case for trial not because it raised unique facts requiring trial — but instead because of its resemblance to an outlier case in which a majority of the appellate panel had determined that a jury was needed.

### C. The Future

Given that Prof. Menell's magnum opus began with Yogi Berra, that sage is often credited with another saying that provides a fitting capstone: "It's tough to make predictions, especially about the future."<sup>233</sup> Without predicting, therefore, this final section merely draws together the various threads that have been woven above, to clothe some final thoughts about *Oracle v. Google* as it wends its way towards a second appellate resolution.

According to the first Federal Circuit opinion, a jury was needed on remand to resolve open issues of material fact.<sup>234</sup> Nonetheless, as we have seen, the resulting trial posed essentially no questions of historical fact.<sup>235</sup> Although it did pose some *questions of intent*, those specifics did not implicate fair use doctrine, so also did not require trial by jury.<sup>236</sup> The verdict did, however, implicate *questions of what might have been*, and to that extent at least partially vindicated the remand.<sup>237</sup>

229. See *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006).

230. See *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992).

231. "The district court (Louis L. Stanton, Judge) granted summary judgment to the defendants on the ground that Koons's appropriation of Blanch's photograph was fair use. We affirm." *Blanch v. Koons*, 467 F.3d at 246. See also *Rogers v. Koons*, 960 F.2d at 314 (the summary "judgment of the district court is affirmed in all respects.").

232. See *supra* Section IV.A.

233. *The Perils of Prediction*, THE ECONOMIST (May 31, 2007), <http://www.economist.com/node/9253918>, [<https://perma.cc/T43W-9T4M>]. Admittedly, I have used a variation on that epigram before. See David Nimmer, *Time and Space*, 38 IDEA 501, 538 (1998). My excuse is that, as discussed above, I have changed a great deal since 1998 — so it is really a "new me" who is invoking it now.

234. *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1354, 1376 (Fed. Cir. 2014).

235. See *supra* Section II.D.1.

236. See *supra* note 71 and accompanying text.

237. Recall Prof. Jaffe's and Dr. Leonard's opposing testimony. See *supra* Section II.D.1.

In addition, the trial raised more than a few questions of fair use policy. As set forth above, that factor, standing alone, does not warrant trial by jury — the lesson from the peer-to-peer jury trials is that the fair use doctrine is not a free-standing referendum.<sup>238</sup> In other words, if there are no doctrinal hooks on which to hang a fair use defense, then there is no cause to put questions of fair use policy before the jury.<sup>239</sup>

Nonetheless, if a jury is sworn for other appropriate reasons, these issues may inevitably percolate into the mix. Thus, given the proper invocation in *Oracle v. Google* of the foregoing questions of what might have been, it was hardly surprising for the trial to be marked by policy questions ranging from Oracle’s “You don’t take people’s property without permission and use it for your own benefit” to Google’s “Now Mr. Ellison wants to shut it down and put it in his pocket. That is not fair, not right, and not what copyright was intended to allow.”<sup>240</sup> Once fair use was validly at play, no categorical bar precludes arguing questions of ultimate value to the jury.<sup>241</sup> In brief, no irremediable prejudice arose from the courtroom arguments of opposing counsel as just summarized.

Also worth emphasis is that this case shares some marked features with one of the cases examined above. In *Corbello*, after being reversed once, Judge Jones did not wish to take matters into his own hands and therefore presented the issue of fair use to a jury.<sup>242</sup> Judge Alsup faced the same dynamic in *Oracle v. Google* — after the Federal Circuit reversed him and called the fair use issue open, he was understandably loath to take matters into his own hands. Thus did he empanel a second jury, which duly vindicated fair use.<sup>243</sup>

The jury verdict itself carries no precedential significance.<sup>244</sup> Nonetheless, Judge Alsup’s rejection of two post-trial motions to set it

238. See *supra* Section II.D.2.iv. Note the parallel effort to paint the defendant as a “bad” company. See *supra* note 87.

239. See *supra* Section IV.A.

240. See *supra* Section II.D.1.

241. See *supra* note 201.

242. See *supra* Section IV.A. It was only after the verdict was erroneous by his lights that he set it aside. *Id.*

243. As previously sketched regarding these two cases considered in depth above, in *Corbello*, the district court initially ruled in favor of defendant on summary judgment, which was reversed on appeal; after the later jury denied fair use, the judge tossed the verdict, consistent with his earlier stance. In *Oracle v. Google*, the district court initially ruled in favor of defendant on summary judgment, which was reversed on appeal; after the later jury vindicated fair use, the judge ratified the verdict, consistent with his earlier stance.

244. Menell, *supra* note 5, at 414–16. Prof. Menell makes the further point that “the jurors departed without comment, leaving the public and the appellate court without a clear understanding of how the fair use balance was struck.” *Id.* at 410. Although the point may be well-taken as to the public, it does not apply to the court system — even if the jurors had held extensive press conferences followed by sworn statements detailing the bases for their verdict, nothing would emerge germane to Judge Alsup’s or the Federal Circuit’s subsequent review. See Fed. R. Ev. 606(b)(1). (noting that a juror may not testify about —

aside does set the stage for appellate review, at which point this decision may be slotted into its appropriate pigeon-holes within the ongoing development of fair use stare decisis.<sup>245</sup> Those proceedings can address such important aspects of fair use as:

- (1) Whether the appellate court agrees with Judge Alsup that the jury could reasonably have found that Google's usage caused no harm to the market for the copyrighted works beyond "the tailspin already predicted within Sun";<sup>246</sup>
- (2) Whether there should be a new fair use factor or sub-factor: compliance with industry norms surrounding APIs;<sup>247</sup>
- (3) Whether there is continuing viability<sup>248</sup> of looking into the propriety of the defendant's conduct as part of the fair use calculus<sup>249</sup> — even though the Supreme Court once harped on that factor,<sup>250</sup> it later retreated.<sup>251</sup> Judge Leval has argued persuasively against it,<sup>252</sup> a stance that has garnered some judicial support.<sup>253</sup>

As important as those facets may be, they should not obscure the larger lessons imparted by Prof. Menell's comprehensive overview of this case.<sup>254</sup> Sound development of copyright law requires investigation not only of any future ruling as to fair use, but also of the Federal Circuit's first ruling regarding copyright's subject matter.<sup>255</sup> Jury verdicts may play a salutary role in resolving

nor may a judge receive evidence of — "any statement made or incident that occurred during the jury's deliberations," the effect of anything on any juror's vote, or any juror's "mental processes concerning the verdict or indictment").

245. See *supra* Section III.B.2.

246. Menell, *supra* note 5, at 410–14.

247. Menell, *supra* note 5, at 393–95; see also *supra* note 78.

248. This matter of the "bad faith exception" to fair use has been raised above. See *supra* notes 55, 77, 177. It recurs below as well. See *infra* note 255.

249. Judge Alsup explained that he erred on Oracle's side in allowing an instruction on that issue, given its cloudy footing. See Menell, *supra* note 5, at 410–16.

250. *Nation*, 471 U.S. at 562 ("propriety of the defendant's conduct").

251. *Campbell*, 510 U.S. at 585 n.18.

252. See Pierre Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1126–27 (1990).

253. See *NXIVM Corp. v. Ross Inst.*, 364 F.3d 471, 479 (2d Cir. 2004); *id.* at 475 (Dennis Jacobs, J., concurring) ("Fair use is not a doctrine that exists by sufferance, or that is earned by good works and clean morals.").

254. See generally Menell, *supra* note 5.

255. One of the fascinating themes in Prof. Menell's article is how "the Federal Circuit's exclusive jurisdiction over federal patent law cases produces a dual body of regional circuit law." *Id.* at 415. He also demonstrates how the Federal Circuit followed its own ruling in *Atari v. Nintendo* rather than the Ninth Circuit's binding holding in *Sega v. Accolade*. *Id.* The point could be added that the former case is unusually hospitable to one matter noted above, namely the "bad faith exception" to fair use. See *Atari Games Corp. v. Nintendo of Am., Inc.*, 975 F.2d 832, 843 (Fed. Cir. 1992). Given how contested that bad faith exception

individual fair use cases, but the larger skein of the law requires fidelity to the basic principles underlying copyright protection — matters that cannot be vindicated when confined to the issue of fair use.<sup>256</sup> It is to be hoped that the important issues that *Oracle v. Google* raises will ultimately make their way to the Supreme Court for final disposition.<sup>257</sup>

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has become, *see* text accompanying *supra* note 248, this consideration increases the magnitude of Prof. Menell's vector expressing concern over Federal Circuit jurisdiction.

256. As aptly observed, "The fair use doctrine is an especially poor vehicle for resolving API copyright disputes." Menell, *supra* note 5, at 471–73.

257. Over 20 years ago, the Court accepted certiorari on what was billed as the "software case of the century." 4 NIMMER & NIMMER, *supra* note 3, § 13.03[F][3][e][ii]. But *Lotus v. Borland* fizzled — rendering *Oracle v. Google* of that much greater moment. *See* Menell, *supra* note 5, at 438–42.