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Fairly Used: Why Google's Book Project Should Prevail Under the Fair Use Defense

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Fairly Used: Why Google's Book Project Should Prevail Under the Fair Use Defense

Cover Page Footnote

The author would like to thank Britton Payne, Gregory Maskel, Halia Barnes, and the staff of the Fordham IPLJ. The author would also like to thank her husband Jonathan Costantino and their family.

Fairly Used: Why Google's Book Project Should Prevail under the Fair Use Defense

By Melanie Costantino*

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INTRODUCTION

Feeling lucky? Go to Google.com, and enter “Google Print” in the search engine and hit the famous “I’m Feeling Lucky” button.¹ From there, you will be whisked away to a new screen (similar to

¹ Google Home Page, <http://www.google.com> (last visited Sept. 15, 2006).

Google.com's famously blank home page), where you can "[s]earch the full text of books (and discover new ones)."² At that point, enter any term—for starters, let's try "Abraham Lincoln." Within a fraction of a second you will be brought to a results page that lists over 14,000 entries about the former president.³ The works retrieved by this search range from "Abraham Lincoln: The Life of America's Sixteenth President," by Kate Petty, which is a 48-page book for young students,⁴ to "The Life of Abraham Lincoln," by J.G. Holland, which was published in 1866.⁵

The Google Book Search⁶ can make searching, and learning, fun and accessible to the average web user. The project also helps users find out whether a particular book exists, and how to either purchase or borrow the book from a local library so that it can be read in its entirety.⁷

Google describes this initiative as its "man on the moon" endeavor.⁸ However, there have been several legal attacks on the program. First, the Authors Guild⁹ filed a class action lawsuit¹⁰

² Google Book Search Home Page, <http://books.google.com> (last visited Sept. 15, 2006).

³ *Id.* (enter "Abraham Lincoln" into the search engine) (last visited Sept. 17, 2006).

⁴ *Id.* (follow hyperlink to book title).

⁵ *Id.* (follow hyperlink to book title). Since this book is defined as a work within the public domain, the work may be viewed in its entirety. *Id.*

⁶ Initially, Google Book Search was called "Google Print." The name was changed in 2005 to Google Book Search. See History of Google Book Search, <http://www.books.google.com/googlebooks/newsviews/history.html> (last visited Oct. 8, 2006).

⁷ Google Book Search Program Basics, <http://books.google.com/googlebooks/about.html> (last visited Sept. 15, 2006). Google offers many options for finding or buying the book, including a "Find this book in a Library" link, where users can enter their zip code, and find the particular book in a library near them. *Id.* (follow "Learn More" link).

⁸ See Google Book Search: All The World's Books at Your Fingertips, <http://books.google.com/googlebooks/vision.html> (last visited Sept. 15, 2006) (describing the Google Book Search program as Google's "man on the moon initiative").

⁹ According to The Authors Guild web site, the organization is the "nation's leading advocate for writers' interests in effective copyright protection, fair contracts and free expression." AG: The Authors Guild, <http://www.authorsguild.org/?p=50> (last visited Sept. 1, 2006).

¹⁰ See generally Complaint, *The Authors Guild v. Google Inc.* (S.D.N.Y. Sept. 20, 2005) (No. 05 Civ. 8136), available at <http://files.findlaw.com/news.findlaw.com/hdocs/docs/google/aggoog92005cmp.pdf> [hereinafter Authors Guild Complaint]. In the

for what it called “massive copyright infringement” by Google.¹¹ The complaint states that the “authors’ works are contained in certain public and university libraries, and have not been licensed for commercial use,”¹² and that Google “has infringed, and continues to infringe, the electronic rights of the copyright holders of those works.”¹³ The Authors Guild also alleges that Google “derives approximately 98 percent of its revenues directly from the sale of advertising, and would unlikely be unable to offer its search engine and other services to the public free of charge without a continued stream of advertising revenues.”¹⁴ The Authors Guild adds that Google will “display the Works on its website for [] commercial purposes.”¹⁵ The relief the Authors Guild seeks on behalf of its class includes an award of statutory damages, plaintiffs’ actual damages and/or defendant’s profits, permanent injunctive relief, costs and attorney’s fees, and other further relief as “the Court finds just and proper.”¹⁶ In addition to the Authors Guild, the Association of American Publishers (“AAP”) initiated a suit against Google on October 19, 2005, alleging direct copyright

complaint, the organization stated that it “has associational standing to pursue claims for injunctive and declaratory relief on behalf of its members” and that “[i]ndividual participation of the authors is not required to determine whether Google’s copying and planned display of the authors’ copyrighted works for commercial use is in violation of the Act and to provide injunctive and declaratory relief to the Guild and the authors.” *Id.* at 5. *But see* Authors Guild v. Google: A Skeptical Analysis, <http://www.authorslawyer.com/wef/aggoogle.shtml> (last visited Sept. 1, 2006) (discussing what it considers several procedural flaws with the Authors Guild Complaint, including the numerosity of the class). The author states that “[t]he Class can’t be that big for a very simple reason: the right to do what Google appears to be doing may have been licensed to a third party, which in turn may not object to Google’s conduct.” *Id.* The Authors Guild initially defined its class as “all persons or entities that hold the copyright to a literary work that is contained in the library of the University of Michigan.” *Id.* at 6.

¹¹ Authors Guild Complaint, *supra* note 10, at 2.

¹² *Id.*

¹³ *Id.*

¹⁴ *Id.* at 8–9. *But see* Google Book Search FAQs, <http://books.google.com/googlebooks/common.html> (last visited Sept. 15, 2006) (explaining, in questions five and six, that neither Google nor any library receive money if a book is bought by one of its recommended retailers, and that “there are currently no ads [i]n library books”).

¹⁵ See Authors Guild Complaint, *supra* note 10, at 10.

¹⁶ See Authors Guild Complaint, *supra* note 10, at 13.

infringement by the Google Books Library Project.¹⁷ The AAP seeks injunctive relief, declaratory relief, and repayment for lawyers' fees."¹⁸

In its answer, Google denies all of the allegations set forth in the Authors Guild complaint, and also sets forth sixteen affirmative defenses.¹⁹ Among the affirmative defenses, Google asserts that the Authors Guild does not have standing in federal court;²⁰ the Guild failed to state a claim upon which relief could be granted;²¹ the Guild's claims should not be decided as a class action;²² Google is protected by the First Amendment;²³ the Guild may not have complete copyright control;²⁴ and that Google has a license to

¹⁷ See Press Release, Association of American Publishers, Publishers Sue Google Over Plans to Digitize Books (Oct. 14, 2005) (on file with The Association of American Publishers), available at <http://www.publishers.org/press/releases.cfm?PressReleaseArticleID=292> (last visited Feb. 20, 2006); see generally Complaint, The McGraw Hill Cos., Inc., et. al. v. Google Inc. (S.D.N.Y. October 19, 2005) (No. 05 Civ. 8881), available at <http://www.publishers.org/press/pdf/40%20McGraw-Hill%20v.%20Google.pdf> [hereinafter AAP Complaint]. The AAP represents five major publishing companies, including The McGraw-Hill Companies, Pearson Education, Penguin Group (USA), Simon & Schuster and John Wiley & Sons. Association of American Publishers—Members, <http://www.publishers.org/member/members.cfm#13> (last visited Sept. 1, 2006). Other groups have also been critical of the project, including the Association of American University Presses (AAUP). See Letter from Peter Givler, Executive Director, AAUP, to Alexander Macgillivray, Senior Intellectual Property and Product Counsel at Google, Inc. (on file with author), available at http://www.businessweek.com/bwdaily/dnflash/may2005/nf20050523_9039.htm.

¹⁸ See AAP Complaint, *supra* note 17, at 13.

¹⁹ See Answer, The Authors Guild v. Google Inc. (S.D.N.Y. Nov. 30, 2005) (No. 05 CV 8136 (JES)) [hereinafter Google Answer], available at <http://www.unc.edu/courses/2006spring/law/357c/001/projects/jsieman/AGanswer.pdf>.

²⁰ *Id.* at 3. In order for a plaintiff to have standing in federal court, it must allege "personal injury fairly traceable to the defendant's allegedly unlawful conduct and likely to be redressed by the requested relief." *Allen v. Wright*, 468 U.S. 737, 751 (1984). Additionally, "[t]he injury alleged must be, for example, distinct and palpable." *Id.* The argument here would be that the personal injury may not be "distinct and palpable" enough to fulfill this part of the standing inquiry. Part V of this note discusses how there may not be a defined injury, and, if anything, Google Book Search may help authors search for an audience.

²¹ Google Answer, *supra* note 19, at 6.

²² *Id.* at 6.

²³ *Id.* at 6.

²⁴ *Id.* at 6–8.

“scan, copy, and/or display some or all of the Plaintiff’s works or portions thereof.”²⁵

Google’s Vice President of Product Management, Susan Wojcicki, said that “Google [Book Search’s] chief beneficiaries will be authors whose backlist, out of print and lightly marketed new titles will be suggested to countless readers who wouldn’t have found them otherwise,” and that “Google doesn’t show even a single page to users who find copyrighted books through this program (unless the copyright holder gives us permission to show more).”²⁶ Wojcicki also stated that Google “respects copyright” and “fair use.”²⁷ At the time of the writing of this note, the Authors Guild and AAP lawsuits were pending in the Southern District of New York.²⁸

This Note argues that Google should prevail in its lawsuits because the Book Project qualifies as a fair use pursuant to 17 U.S.C. § 107. Part I of this Note describes what the Google Book Search Library Project is, as well as a brief overview of how search engines work. Part II discusses the legal standards for copyright infringement pursuant to the Copyright Act. Part II also discusses the statutory provisions for fair use exemption provided in 17 U.S.C. § 107. Part III describes the differences between how the Second and Ninth Circuits have interpreted section 107(4), the fourth—and most significant—factor of the fair use analysis, which pertains to the effect on the potential market for the original

²⁵ *Id.* at 8.

²⁶ Statement by Susan Wojcicki, Vice President of Product Management, Google, Google Print and the Authors Guild (Sep. 20, 2005) (on file with author), available at <http://googleblog.blogspot.com/2005/09/google-print-and-authors-guild.html>. See also Google Answer, *supra* note 19.

²⁷ See Wojcicki Statement, *supra* note 26. The statement further asserted that “Google Print, like an electronic card catalog, indexes book content to help users find, and perhaps buy, books. This ability to introduce millions of users to millions of titles can only expand the market for authors’ books, which is precisely what copyright law is intended to foster.” *Id.* Google temporarily halted the project from August to November 2005, while it made some revisions to its library project web site. See Margaret Kane, *Google Pauses Library Project*, CNET NEWS.COM, Aug. 12, 2005, http://news.com.com/Google+pauses+library+project/2100-1025_3-5830035.html?tag=nl.

²⁸ The Authors Guild Complaint demands a jury trial, as well as injunctive, declaratory, statutory, and compensatory relief. See Authors’ Guild Complaint, *supra* note 10, at 1, 13–14. The AAP, however, only demands injunctive and declaratory relief, as well as payment for legal fees. See AAP Complaint, *supra* note 17, at 13.

work. Part IV examines how Google's use of the material falls squarely within the protections of the fair use defense. Part V of this note discusses the public policy implications of this decision on the future of electronic copyright, and ultimately, how the Google Book Project enhances the need for libraries and books.

I. GOOGLE BOOK SEARCH

A. *About the Google Book Search Project*

The Google Book Search Project allows users to enter search terms and find books that match their criteria.²⁹ Once books that fit the search criteria are found, users are subsequently provided with a list of places where they can buy or borrow those books.³⁰

There are three ways users can look at book excerpts: Snippet View, Limited Preview View, or Full Book View.³¹ Under the default Snippet View, users will only see the book title, publisher information, and a few short phrases or sentences about the book.³² Unless a publisher tells Google otherwise, the Snippet View is the way in which books will be presented to users.³³ The Limited Preview selection allows users to see either one or a few pages of a book that is retrieved in a search.³⁴ In order for a book to be presented in this way, the publishers or authors give Google permission.³⁵ Thirdly, there is the Full Book View.³⁶ This view is typically allowed for books that are in the public domain.³⁷ Books

²⁹ See Google Book Search Program Basics, *supra* note 7.

³⁰ See *id.*

³¹ See *id.* There is also a fourth view, the "No Preview Available" view, in which users may see card catalog information about a book, but no "snippets" from the book. See *id.* Additionally, using that view, users may be able to find out where they can borrow or purchase that particular book. See *id.*

³² See *id.* (click the link titled "Snippet View").

³³ See *id.*

³⁴ See *id.* (click the link titled "Limited Preview").

³⁵ See *id.*

³⁶ See *id.*

³⁷ See Google Book Search Program Basics, *supra* note 7.

that are entered into the Google database may be removed at any time.³⁸

The works within Google's book database come from two sources: The Google Books Partner Program, and the Google Books Library Project.³⁹ The Google Books Partner Program is a program which helps publishers and authors promote their books.⁴⁰ Works that are entered into Google's Books Library Project program are scanned in their entirety,⁴¹ then displayed via the Book Project's Sample Pages View.⁴²

The second part of the Google Book Search Project is the Google Books Library Project.⁴³ This part of the project involves scanning entire books into Google's databases for the use of the Book Search Engine.⁴⁴ Unless a publisher informs Google that it does not want its books included in the search engine, or the book is out of copyright, the books are entered into Google's database and can be viewed via the Snippet View.⁴⁵ Works will only be

³⁸ See Google Book Search: Partner Program, <http://books.google.com/googlebooks/publisher.html> (last visited Sept. 17, 2006).

³⁹ See Google Book Search Program Basics, *supra* note 7.

⁴⁰ This program is part of the Google Book Search project, *see* Google Book Search Program Basics, *supra* note 7, however, it is not the main focus of this comment, because authors opt into this program. See Google Book Search Tour: Promote your books on Google—for free, http://books.google.com/services/print_tour/ (last visited Sept. 15, 2006).

⁴¹ University of Michigan News Service, Google Library Partnership, <http://www.umich.edu/news/index.html?BG/google/index> (last visited Sept. 15, 2006).

⁴² See Google Book Search Program Basics, *supra* note 7.

⁴³ See Google Book Search: An Enhanced Card Catalog of The World's Books, <http://books.google.com/googlebooks/library.html> (last visited Sept. 16, 2006).

⁴⁴ See University of Michigan News Service, *supra* note 41. Google further states that its vision for the project is to create a "world" where "all books are online and searchable." See Google Book Search: An Enhanced Card Catalog of The World's Books, *supra* note 43; *see also* Google Book Search: All The World's Books at Your Fingertips, *supra* note 8. Google states that the Book Project is "a book-finding tool, not a book-reading tool." Google Book Search: All The World's Books at Your Fingertips, *supra* note 8. Further, Google states that it only shows "the full pages of books if the copyright holders have given us permission or if the book is out of copyright. Otherwise we show bibliographic information about the book plus at most a few sentences of your search term in context." *Id.*

⁴⁵ See Google Book Search: An Enhanced Card Catalog of The World's Books, *supra* note 43. The page also has links contains examples of the Snippet View, the Sample Page View and the Full Book View.

available using the Sample Pages View if an author or publisher grants Google permission.⁴⁶ In all cases, a user will be informed about where he or she may purchase or borrow the books.⁴⁷

Google obtained the works incorporated in the Book Search database from libraries that have partnered with Google in this program.⁴⁸ The participating libraries include the University of California, University of Michigan, Harvard University, Oxford University, Stanford University, and the New York Public Library.⁴⁹ While the extent of each of the libraries' involvement may differ, the premise remains the same: Google takes either current digital copies of the works, or digitizes the work for the use of its search engine.⁵⁰ Google also seeks to accommodate the libraries' interests, by cooperating in the selection of books to be

⁴⁶ See Google Book Search Program Basics, *supra* note 7.

⁴⁷ See Google Book Search Program Basics, *supra* note 7. Typically, users are limited in the number of pages they may view before being asked for a Google login to continue searching. Google Book Search Help—Frequently Asked Questions, <http://books.google.com/googleprint/help.html> (last visited Sept. 15, 2006).

⁴⁸ See Google Book Search Library Partners, <http://books.google.com/googlebooks/partners.html> (last visited Sept. 15, 2006). This Note will explain *infra* how the Google Book Project, should be protected as a fair use of copyrighted material. Alternatively, in instances where a “license agreement is silent on providing copies to external users, then the library may make either printed or digital copies for external users.” American Association of Law Libraries Guidelines on the Fair Use of Copyrighted Works by Law Libraries, available at http://www.aallnet.org/about/policy_fair.asp (last visited Sept. 16, 2006).

⁴⁹ See Google Book Search Library Partners, *supra* note 48 (providing comments from Google's major library partners). See also Harvard University, Harvard-Google Project, <http://hul.harvard.edu/hgproject/faq.html> (last visited Sept. 15, 2006); Bodleian Library—University of Oxford, <http://www.bodleian.ox.ac.uk/google> (last visited Sept. 15, 2006). Stanford University and University of Michigan have allowed for books covered under copyright to be considered as part of the program. See Stanford Google Library Project FAQ, http://www-sul.stanford.edu/about_sulair/special_projects/google_sulair_project_faq.html (last visited Sept. 15, 2006); University Of Michigan/Google Digitization Partnership FAQ, Aug. 2005, <http://www.lib.umich.edu/staff/google/public/faq.pdf> (last visited Sept. 15, 2006).

⁵⁰ See University of Michigan Cooperative Agreement [hereinafter UM Agreement], available at <http://www.lib.umich.edu/mdp/um-google-cooperative-agreement.pdf>, at 3; see also *id.* at 4 (denoting that Google may delay transferring “Digitized Selected Content” if there may be a dispute with a third party).

digitized, as well as by offering special handling of books in accordance with the universities' specific requirements.⁵¹

B. Google's Plans for Database Security

Google has assured participants of the program that the authors' books are hosted on its secure servers, and users can only see a limited number of pages from their books. Additionally, copy, save and print functions are disabled. Further, Google assures that while books may be scanned in their entirety, they are only available for searching and discovering, and not for downloading.⁵² Authors or publishers may request that the works be removed from the Google Book Search database at any time.⁵³

C. How Search Engines Work—A Primer

In order to understand the Google Book Search, how it works, and why full books must be scanned in order to fully accomplish its purpose, it is important to understand how search engines work. In general, there are three different types of search engines: crawler-based search engines, human-powered directories, and hybrid search engines, which are search engines that are a combination of the prior two.⁵⁴ To start, website editors use "meta tags" to guide search engines in choosing its website as a search result.⁵⁵ Meta tags "allow the owner of a page to specify key words and concepts under which the page will be indexed."⁵⁶

⁵¹ See UM Agreement, *supra* note 50, at 3. It is interesting to note that libraries are allowed to copy works from their collections for the purposes of preservation, or make digital copies of them, pursuant to the Library Exception. See 17 U.S.C. § 108 (2000). However, the statute is unclear as to whether a library may outsource the copying of works to another party, as they are doing with Google here. See *id.*

⁵² Google Book Search—News & Views—Facts & Fiction, http://books.google.com/googlebooks/newsviews/facts_fiction.html (last visited Sept. 17, 2006).

⁵³ See Google Book Search—Partner Program, <http://books.google.com/googlebooks/publisher.html> (last visited Sept. 17, 2006).

⁵⁴ See Danny Sullivan, *How Search Engines Work*, SEARCHENGINEWATCH.COM, Oct. 14, 2002, <http://searchenginewatch.com/webmasters/article.php/2168031>.

⁵⁵ See Curt Franklin, *How Internet Search Engines Work*, HOWSTUFFWORKS.COM, <http://computer.howstuffworks.com/search-engine1.htm> (last visited Sept. 17, 2006).

⁵⁶ *Id.* There is a danger "in over-reliance on meta tags, because a careless or unscrupulous page owner might add meta tags that fit very popular topics but have nothing to do with the actual contents of the page. To protect against this, spiders will

Conversely, website editors can restrict their website from being found by major search engines by using a tool called Robot Exclusion Protocol.⁵⁷ Robot Exclusion Protocol is entered into the meta tag section at the top of a web page.⁵⁸ The goal of this protocol is to tell a search engine program “to leave the page alone—to neither index the words on the page nor try to follow its links.”⁵⁹

1. Types of Search Engines

a) Crawler-based Search Engines

Crawler-based search engines “crawl” or “spider” the web to find terms that users request and find web sites that fit that particular request.⁶⁰ First, the “crawler,” or “spider” visits a web page, reads it, then follows links to other pages within the site.⁶¹ “Everything the spider finds goes into the . . . index,” which “is like a giant book containing a copy of every web page the spider finds” during the second step.⁶² Finally, the search engine’s software “sifts through the millions of pages recorded in the index to find matches,” and then ranks them according to relevancy.⁶³ Spiders typically start where they detect heavily-used servers and high-trafficked web pages, and from there, begin indexing the words on the pages and following every link found within the site.⁶⁴ Most search engines are crawler-based.⁶⁵

correlate meta tags with page content, rejecting the meta tags that don’t match the words on the page.” *Id.* According to Webopedia.com, a spider is “[a] program that automatically fetches Web pages. Spiders are used to feed pages to search engines. It’s called a spider because it *crawls* over the Web. Another term for these programs is *webcrawler*.” What is Spider?, Webopedia.com, <http://www.webopedia.com/TERM/s/spider.html> (last visited Sept. 17, 2006).

⁵⁷ Franklin, *supra* note 55.

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ Sullivan, *supra* note 54. See What is Spider?, *supra* note 56 and accompanying text for a definition of “spider.”

⁶¹ Sullivan, *supra* note 54.

⁶² *Id.*

⁶³ *Id.*

⁶⁴ Franklin, *supra* note 55.

⁶⁵ See Sullivan, *supra* note 54.

b) Human-powered Directories

A human-powered directory requires a web site manager to submit a short directory for his entire site to the management of the search engine web site.⁶⁶ The search engine would only look for matches in the descriptions that have been submitted.⁶⁷ The Google Book Search engine would best be compared to this type of search engine, since its content is derived primarily from what authors and publishers give to Google, or what Google gets from its participating libraries.⁶⁸

c) Hybrid Search Engines

Hybrid search engines are a fusion between both the crawler-type and human-powered directories. Hybrid search engines combine the properties of a search engine with the properties of a directory.⁶⁹ Today, search engine sites, such as Google and MSN Search, use hybrid search engines in order to help optimize user results.⁷⁰

⁶⁶ See Sullivan, *supra* note 54.

⁶⁷ See *id.*

⁶⁸ See Google Book Search Program Basics, *supra* note 7. The Authors Guild Complaint alleges that Google had also announced plans to display the works on its commercial Web site, Google.com. See Authors Guild Complaint, *supra* note 10, at 7. If this is true, then what would ultimately be created is a “Hybrid Search Engine,” which would present both human-entered and crawler-based results. See Sullivan, *supra* note 54.

⁶⁹ See Tips Sheets—Web Site Registration 101: Search Engines and Directories, http://www.chin.gc.ca/English/Digital_Content/search_engine_tips.html (last visited Sept. 17, 2006).

⁷⁰ See Sullivan, *supra* note 54. The web site states that “[u]sually, a hybrid search engine will favor one type of listings over another. For example, MSN Search is more likely to present human-powered listings from LookSmart. However, it does also present crawler-based results . . . especially for more obscure queries.” See Sullivan, *supra* note 54. For an interesting comparison about how Google rates among its competitor web sites, including Yahoo!, see the U.C. Berkeley—Teaching Library Internet Workshops: The Best Search Engines, <http://www.lib.berkeley.edu/TeachingLib/Guides/Internet/SearchEngines.html> (last visited Sept. 17, 2006). See The Google Page Rank Algorithm, <http://www.rankforsales.com/google-page-rank.html> (last visited Sept. 17, 2006), for a brief primer as to how Google’s search engine makes it the leader among other search engines.

II. COPYRIGHT INFRINGEMENT AND THE FAIR USE STANDARD

Considering the Authors Guild and the AAP both claim the Book Search Project is copyright infringement, in order to evaluate the merits of the Google Book Project, it is necessary to define copyright infringement.⁷¹ There are three forms of copyright infringement: direct infringement, contributory infringement and vicarious infringement.⁷² For the purposes of this Note, only direct copyright infringement will be discussed.

A. *Direct Copyright Infringement*

Copyright protection extends to “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”⁷³ “[C]opyright . . . does not extend to any idea, procedure, process, system, method of operation, concept, principle or discovery, regardless of the form in which it is described, explained, illustrated or embodied in such work.”⁷⁴ A copyrighted work’s owner has exclusive rights to “reproduce the copyrighted work in copies or phonorecords . . . prepare derivative works based upon the copyrighted work,” and “distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending.”⁷⁵ Copyright “vests initially in the author or authors of the work.”⁷⁶ For a plaintiff to have a copyright infringement action, there are two elements that need to be shown: ownership of the copyright by the plaintiff and copying by the defendant.⁷⁷ In certain instances,

⁷¹ Authors Guild Complaint, *supra* note 10, at 2; see AAP Complaint, *supra* note 17, at 2.

⁷² UO Copyright Website: Copyright Principles in Action, http://darkwing.uoregon.edu/~copyright/Docs_Html/III_DEF.htm (last visited Sept. 17, 2006).

⁷³ 17 U.S.C. § 102 (2000). Works of authorship may include literary works, musical works, dramatic works, and sound recordings, among others. *Id.*

⁷⁴ *Id.*

⁷⁵ *Id.* § 106.

⁷⁶ *Id.* § 201.

⁷⁷ 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.01 (2d ed. 1978). See also *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) (stating that a prima facie case for copyright infringement requires two elements:

case law suggests that when copyright infringement occurs in an insubstantial, or de minimis manner, the action is not supported.⁷⁸

Upon consideration of the first element—ownership, the copyright registration certificate constitutes prima facie evidence in favor of the plaintiff.⁷⁹ Generally, this conclusion of law, intertwined with fact, is fairly simple to overcome.⁸⁰

The second element of copyright infringement—copying by the defendant—has been considered by courts in two stages.⁸¹ First, courts will determine whether the defendant, in creating its work, used the plaintiff's material as "a model, template, or even inspiration."⁸² If this is found, courts will find as a matter of fact, that copying may have occurred.⁸³ However, a factual finding of copying is not dispositive, and a court will also need to find whether "such copying as took place gives rise to liability for infringement."⁸⁴ A court will have to show that the defendant's copy is substantially similar to the plaintiff's original work.⁸⁵ To show that, the plaintiff must prove that the defendant had "access and the similarity must relate to the same work, not to two separate works authored by plaintiff."⁸⁶ While proof of access may be a difficult procedural burden for a plaintiff, it is not

"ownership of a valid copyright," and "copying of constituent elements of the work that are original").

⁷⁸ See NIMMER, *supra* note 77, § 8.01(G); see *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2003) (application of the de minimis standard is limited to cases where the use is so trifling under the circumstances that "the average audience would not recognize the appropriation").

⁷⁹ See NIMMER, *supra* note 77, § 13.01(A).

⁸⁰ See *id.* ("[T]he only evidence required of the plaintiff to establish *prima facie* ownership, in addition to the registration certificate, is evidence of plaintiff's chain of title from the original copyright registrant. Furthermore, once the plaintiff has established his ownership prima facie, the burden then shifts to the defendant to counter this evidence."). See NIMMER, *supra* note 69, § 13.01(A).

⁸¹ See NIMMER, *supra* note 77, § 13.01(B).

⁸² See *id.*

⁸³ See *id.*

⁸⁴ See *id.* (citations omitted). Not only is evidence of copying important, but there must be a demonstration that the copying "extended to plaintiff's protectible expression." *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1358 (N.D. Ill. 1989).

⁸⁵ See NIMMER, *supra* note 77, § 13.01(B) (citations omitted).

⁸⁶ See *id.* (citations omitted).

insurmountable.⁸⁷ In evaluating a defendant's claim that the work was in fact original, and not copied, courts may look to defendant's relevant knowledge, training, and other instances of copying.⁸⁸ Courts have tried to alleviate plaintiff's burden by imposing "a high standard of proof of independent creation where the plaintiff has clearly established access and probative similarity."⁸⁹

For a Plaintiff to meet the "substantial similarity" threshold, he must show that the copying "quantitatively and qualitatively sufficient to support the legal conclusion that infringement . . . has occurred."⁹⁰ The "qualitative" element focuses on the copying of the expression, and the quantitative element considers how much of the copyrighted work is copied.⁹¹ One case that illustrates the difference between qualitative and quantitative aspects of copyright infringement is *Castle Rock Entertainment, Inc. v. Carol Publishing Group*.⁹² In that case, the Second Circuit determined that the qualitative element was met because the defendant "crossed the de minimis threshold"⁹³ where the defendant made a trivia quiz that copied fragments of the television sitcom, *Seinfeld*, the same way "that a collection of *Seinfeld* jokes or trivia would copy fragments of the series."⁹⁴ The court also deemed the qualitative component to be met because the *Seinfeld* Aptitude Test ("SAT") did not merely copy a series of unprotected facts, but rather the nuances and creative expression of the show.⁹⁵

⁸⁷ See generally *Lisa Frank, Inc. v. Impact Int'l, Inc.*, 799 F. Supp. 980, 986, 990 (D. Ariz. 1992) (explaining that plaintiff was able to overcome the burden by producing a tape that documented defendant's admission to copying).

⁸⁸ See *NIMMER*, *supra* note 77, § 13.01(B) (citations omitted). Note that if a defendant had copied work from another person other than the plaintiff in an action, it is "irrelevant in plaintiff's infringement claim that the defendant may have infringed the copyright in such other work." See *id.* (citations omitted).

⁸⁹ See *id.*

⁹⁰ *Castle Rock Entm't v. Carol Publ'g Group, Inc.*, 150 F.3d 132, 138 (2d Cir. 1998).

⁹¹ *Id.* at 138 (citations omitted).

⁹² See *id.* at 132.

⁹³ See *id.* at 138. The defendants in *Castle Rock* copied "643 fragments from 84 individually copyrighted *Seinfeld* episodes." *Id.*

⁹⁴ *Id.* The court considers the entire series of *Seinfeld* as one work encompassing all of its episodes; thus, the de minimis analysis should not be done on a episode-by-episode basis. *Id.*

⁹⁵ *Id.* at 138–39. The defendants in this case also presented three other alternative tests for determining substantial similarity, including the "ordinary observer test," the "total

Not all copying is indicative of copyright infringement, and in some cases, it does not militate against a finding of fair use. Additionally, upon consideration of the copyright statute's affirmative defense of fair use, wholesale copying may be justified.⁹⁶ For example, in *Feist Publications, Inc. v. Rural Telephone Service Co.*,⁹⁷ the Supreme Court reversed the finding of liability, even though the defendant had lifted facts from plaintiff's publication, because the constituent elements that defendant copied were not themselves original.⁹⁸ In *Campbell v. Acuff-Rose Music, Inc.*,⁹⁹ copying was not considered "excessive in relation to parodic purpose merely because the portion taken was the original's heart."¹⁰⁰ Moreover, in *Sony*, the Supreme Court found that copying an entire work does not preclude a finding of fair use.¹⁰¹ Finally, in *Sega Enterprises v. Accolade, Inc.*,¹⁰² the Ninth Circuit again ruled that wholesale copying by defendant did not militate against a finding of fair use.¹⁰³

B. The Fair Use Defense, 17 U.S.C. § 107

Courts recognize that certain acts of copying are defensible pursuant to the fair use statute, 17 U.S.C. § 107.¹⁰⁴ The preamble of Section 107 protects copying for use in "criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research."¹⁰⁵ The statute does not define *what*

concept and feel test," the "fragmented literal similarity test," and the "comprehensive nonliteral similarity" test, but the court found that these tests did not help its case. *See id.* at 139-41.

⁹⁶ 17 U.S.C. § 107 (2000).

⁹⁷ 499 U.S. 340 (1991).

⁹⁸ *See id.* at 344, 361. "The first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence." *Id.* at 347.

⁹⁹ 510 U.S. 569 (1994).

¹⁰⁰ *Id.* at 588. The court reasoned that the entire song was needed by 2 Live Crew in order to create its new work, which was a parody. *Id.* at 588-89. Thus, not more than what was necessary was used. *Id.*

¹⁰¹ *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 449-50 (1984).

¹⁰² No. 92-15655, 1993 U.S. App. LEXIS 78 (9th Cir. Jan. 6, 1993).

¹⁰³ *Id.* at *49. Both *Campbell* and *Sega* will be discussed in more detail *infra*.

¹⁰⁴ NIMMER, *supra* note 77, § 13.05; *see also* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 799 (9th Cir. 2003) (noting that Fair Use defense permissible because new works "rarely spring forth in a vacuum").

¹⁰⁵ 17 U.S.C. § 107 (2000).

a fair use of copyrighted material may be, but rather, it lists a series of factors that must be considered to determine if a defendant's work should be protected as a fair use.¹⁰⁶ The fair use inquiry requires a court to look at all of the particular circumstances surrounding a particular case, as well as a consideration of all of the evidence.¹⁰⁷ How much weight a court decides to accord to a particular factor is typically entirely at the judge's discretion; however the fourth factor of the analysis, the effect on the market by the defendant's work, is accorded the most weight.¹⁰⁸

1. Section 107(1): Purpose and Character of the Use

The first fair use factor—section 107(1)—assesses the purpose and character of the use, including whether or not the use “is of a commercial nature or is for nonprofit educational purposes.”¹⁰⁹ This factor has two elements that must be considered: first, whether the work is commercial or non-commercial in nature, and second, whether the defendant's new work is transformative. “The

¹⁰⁶ The text of 17 U.S.C. § 107 is as follows:

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

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

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

¹⁰⁷ *Harper & Row v. Nation Enters., et. al.*, 471 U.S. 539, 555–60 (1985); *see also* *Cambell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994) (stating that the court's finding of fair use “is not to be simplified with bright-line rules,” but rather a “case-by-case analysis”). The court also noted that each factor should not be considered in a vacuum, but rather it is a balancing test. *Id.* at 578.

¹⁰⁸ *See Harper & Row*, 471 U.S. at 566 (“[t]his last factor is undoubtedly the single most important element of fair use.” (citation omitted)).

¹⁰⁹ 17 U.S.C. § 107(1).

crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.”¹¹⁰ Works that are educational or artistic may receive a higher level of protection than those works that are primarily commercial in nature.¹¹¹

The line between what is commercial use and what is contemplated under section 107(1) is fuzzy at best.¹¹² Many courts—including the Second Circuit and the Supreme Court—have accorded more emphasis on whether the allegedly infringing work is of a transformative nature.¹¹³ The Court in *Campbell* found that merely because a work is “educational and not for profit does not insulate it from a finding of infringement;” conversely, more than the commercial character of a use would not necessarily bar a finding of fairness.¹¹⁴

¹¹⁰ *Harper & Row*, 471 U.S. at 562. The Supreme Court has also held that “commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright.” *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984); *see also* *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1015 (9th Cir. 2001) (stating that “[c]ommercial use is demonstrated by a showing that repeated and exploitative unauthorized copies of copyrighted works were made to save the expense of purchasing authorized copies”).

¹¹¹ *See* *Wright v. Warner Books, Inc.*, 953 F.2d 731, 736 (2d Cir. 1991) (stating that “there is a strong presumption that factor one favors the defendant if the allegedly infringing work fits the description of uses described in section 107”); *Castle Rock Entm’t v. Carol Publ’g Group*, 150 F.3d 132, 141–43 (2d Cir. 1998) (discussing that the *Seinfeld* Aptitude Test is considered commercial in nature). *But see* *Sony* 464 U.S. at 449 (court found that taping programs on a VCR by a private individual must be characterized as a noncommercial, nonprofit activity).

¹¹² *See* *Campbell*, 510 U.S. at 584 (stating that “nearly all of the illustrative uses listed in the preamble paragraph of § 107, including news reporting, comment, criticism, teaching, scholarship, and research . . . ‘are generally conducted for profit in this country’ . . . ‘[n]o man but a blockhead ever wrote, except for money’” (quoting 3 *Boswell’s Life of Johnson* 19 (G. Hill ed. 1934))).

¹¹³ *See* *Castle Rock Entm’t v. Carol Publ’g Group*, 150 F.3d 132, 142 (2d Cir. 1998). *But see* *Harper & Row*, 471 U.S. at 554–55 (stating that an author has a right to control his marketing of his work, and that his “right to choose when he will publish is no less deserving of protection”).

¹¹⁴ *Campbell*, 510 U.S. at 584. Justice Souter continues to say that if commerciality carried “presumptive force against a finding of fairness, the presumption would swallow nearly all of the illustrative uses listed in the preamble paragraph of Section 107, including new reporting, comment, criticism, teaching, scholarship, and research, since

The second part of section 107(1) considers whether the new work is “transformative” or consumptive.¹¹⁵ To this end, courts have held that creation does not occur “in a vacuum.”¹¹⁶ A work may be considered transformative if the defendant’s work does more than “merely supersede[]’ the original work;” it also must add “something new, with a further purpose or different character, altering the first with new . . . meaning [] or message.”¹¹⁷ The more transformative the new work, the less significantly other factors, such as the commercialism of the use, will weigh against a finding of fair use.¹¹⁸ A defendant’s use is considered consumptive, as opposed to transformative, if the work “merely supersede[s] the object of the original . . . instead [of] add[ing] something new, with a further purpose or different character.”¹¹⁹ Moreover, this prong of section 107(1) also looks at whether the secondary use adds any value—whether in form, function, aesthetics or understanding—to the original.¹²⁰ A secondary work does not need to transform an original work’s expression to have a transformative purpose.¹²¹

these activities ‘are generally conducted for profit in this country.’” *Id.* at 584 (citing *Harper & Row*, 471 U.S. at 592).

¹¹⁵ See *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 818 (9th Cir. 2003).

¹¹⁶ *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 799 (9th Cir. 2003); see also *Campbell*, 510 U.S. at 579 (stating that “the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works”).

¹¹⁷ *Castle Rock*, 150 F.3d at 142 (citing *Campbell*, 510 U.S. at 579).

¹¹⁸ *Campbell*, 510 U.S. at 579.

¹¹⁹ *Arriba Soft*, 336 F.3d at 818 (citing *Campbell*, 510 U.S. at 579).

¹²⁰ *Castle Rock*, 150 F.3d. at 142 (“If ‘the secondary use adds value to the original—if [copyrightable expression in the original work] is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings—this is the very type of activity the fair use doctrine intends to protect for the enrichment of society’” (citing Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990)); see also *Campbell*, 510 U.S. at 579 (“the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works”); *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 800 (9th Cir. 2003) (holding parody sufficiently transformative, and stating “whether a work is a parody is a question of law, not a matter of public majority opinion”).

¹²¹ See NIMMER, *supra* note 77, § 13.05[A][1][b]. But see *Castle Rock*, 150 F.3d at 143 n.8 (contemplating how quickly the judge or his law clerk could conjure up a *Star Wars* trivia question and holding that the *Seinfeld* Aptitude Test was not a transformative use because the quiz book “transform[ed] an original work into a new mode of presentation, such works—unlike works of fair use—take expression for purposes that are not ‘transformative’”).

2. Section 107(2): Nature of the Copyrighted Work

When considering this factor of the fair use analysis, courts examine the defendant's use of the work as well as the nature of the plaintiff's original work. Typically, "the more creative a work, the more protection it should be accorded from copying; correlatively, the more informal or functional the plaintiff's work, the broader should be the scope of the fair use defense."¹²² While this factor takes into account that "fair use is more difficult to establish when the former works are copied,"¹²³ a work is accorded more protection under this factor if it is a product of "diligence," rather than merely "a catalog, index or other compilation."¹²⁴ Out of all of the factors, this one usually "recedes into insignificance in the greater fair use calculus."¹²⁵

3. Section 107(3): Amount and Substantiality of the Portion Used

Upon consideration of this factor, courts consider the quantity and substantiality of the plaintiff's work.¹²⁶ Overall, "[t]here are no absolute rules as to how much of a copyrighted work may be copied and still be considered a fair use."¹²⁷ This factor is not

¹²² NIMMER, *supra* note 77, § 13.05[A][2][a]. *But see* Maxtone-Graham v. Burtchaell, 803 F.2d 1253, 1263 (2d Cir. 1986) (holding that excerpted interview quotes from one book and used in derivative work is not unforeseeable, and also, something that merits some form of consideration in fair use analysis).

¹²³ *Campbell*, 510 U.S. at 586 (holding that section 107(2) was "[n]ever likely to help much in separating the fair use sheep from the infringing goats in a parody case, since parodies almost invariably copy publicly known, expressive works"); *see also* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 350–51 (1991) ("factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement . . . [not] the facts themselves"). *But see* Fin. Info., Inc. v. Moody's Investors Serv., Inc., 751 F.2d 501, 510 (2d Cir. 1984) (court refused to allow fair use copying by a rival factual work).

¹²⁴ NIMMER, *supra* note 77, at 107, § 13.05[A][2][a]. *See* MCA, Inc. v. Wilson, 677 F.2d 180, 182 (2d Cir. 1981) (stating that upon consideration of section 107(2), courts may consider not only if the work required some sort of creativity or information beyond the first work, but also whether "it represented a substantial investment of time and labor made in anticipation of a financial return."). *But see* Feist, 499 U.S. at 352–53 (holding no copyright infringement merely for product of "industrious collection").

¹²⁵ NIMMER, *supra* note 77, § 13.05[A][2][a]. *See also* *Campbell*, 510 U.S. at 586.

¹²⁶ Harper & Row Publishers, Co. v. Nation Enters., 471 U.S. 539, 564–65 (1985).

¹²⁷ *Maxtone-Graham*, 803 F.2d at 1263.

considered based on how much the copyrighted work is made up of the allegedly infringing work.¹²⁸ The proper analysis of this factor includes both qualitative and quantitative elements.¹²⁹

In *Harper & Row, Inc. v. Nation Enterprises*, the defendant used about 13 percent of plaintiff's work;¹³⁰ however, it was described by the court as "essentially the heart of the book."¹³¹ Courts have ruled against defendants under this factor in instances where it copied 300 words of a 200,000-word work,¹³² or excerpted one minute and fifteen seconds from plaintiffs' one hour and twelve minute motion picture (among other clips excerpted from other motion pictures in order to compile a highlight reel of a prominent actor) based on the same premise described in *Harper & Row*.¹³³

The Supreme Court in *Campbell* recognized that "the extent of permissible copying varies with the purpose and character of the use."¹³⁴ The *Campbell* Court permitted wholesale copying of copyrighted work because it was necessary in order to produce a

¹²⁸ *Harper & Row*, 471 U.S. at 564–65. See *Wright v. Warner Books*, 953 F.2d 731, 738 (2d Cir. 1991). See also *New Era Publ'ns Int'l ApS v. Carol Publ'g Group*, 904 F.2d 152, 158–59 (2d Cir. 1990) (holding in favor of defendant upon analyzing this factor of the fair use analysis, despite the fact that 2.7 percent of defendant's work is made up of roughly 5 to 8 percent of plaintiff's works, because the quotes were used "primarily as a means for illustrating the alleged gap between the official version of [L. Ron] Hubbard's life and accomplishments, and what the author contends are the true facts").

¹²⁹ *Harper & Row*, 471 U.S. at 564–65.

¹³⁰ *Id.* at 548. In *Harper & Row*, the defendant, *Nation Magazine*, used roughly 13 percent of the 7,500-word excerpt of letters written by President Gerald R. Ford about the end of the Nixon administration. *Id.* at 543. The *Nation* magazine article was roughly 2,250 words in length. *Id.* This "scoop" resulted in *Time* magazine cancelling this piece. *Id.* The magazine was awarded \$12,500 in damages due to this incident. *Id.* at 544, 568.

¹³¹ *Harper & Row*, 471 U.S. at 565. Note that this factor takes on a greater significance if the original work had not been published. See *id.* at 553.

¹³² *Id.* at 598.

¹³³ *Roy Exp. Co. Establishment v. Columbia Broad. Sys., Inc.* 503 F. Supp. 1137, 1145 (S.D.N.Y. 1980). Cf. *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936) (holding that "no plagiarist can excuse the wrong by showing how much of his work he did not pirate") (Learned Hand, J.).

¹³⁴ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586–87 (1994); see *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 449–50 (1984) (holding that copying of an entire work "does not have its ordinary effect of militating against a finding of fair use" when considering the time-sharing issue and taping missed television programs for private viewing).

parody.¹³⁵ The Ninth Circuit implemented the reasoning analogous to *Campbell* in order to justify wholesale copying in non-parody cases. For example, in *Kelly v. Arriba Soft Corp.*,¹³⁶ a copyright infringement case involving use of thumbnails¹³⁷ in a search engine, the court found that section 107(3) of the fair use analysis “neither weighs for nor against either party because, although Arriba did copy each of Kelly’s images as a whole, it was reasonable to do so in light of Arriba’s use of the images.”¹³⁸ The Ninth Circuit stated that it was “necessary for Arriba to copy the entire image to allow users to recognize the image and decide whether to pursue more information about the image or the originating web site.”¹³⁹ The Ninth Circuit also determined that “[i]f Arriba only copied part of the image, it would be more difficult to identify it, thereby reducing the usefulness of the visual search engine.”¹⁴⁰

In *Sega*, the plaintiff, a manufacturer of video games and the Genesis gaming system, sued defendant Accolade for copying its computer programming used when creating its own game programs. The Court found in favor of the defendant on the issue of fair use, stating that the computer programs incorporate “functional elements which do not merit [copyright] protection.”¹⁴¹ The court paralleled the information that is used to construct a computer program to the reasoning of *Feist*, in that while the expression of the computer game may be original, “computer

¹³⁵ *Campbell*, 510 U.S. at 586–87.

¹³⁶ *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003).

¹³⁷ According to Wikipedia.com, thumbnails are “reduced-size versions of pictures, used to make it easier to scan and recognize them, serving the same role for images as a normal text index does for words.” WIKIPEDIA, *Thumbnail*, <http://en.wikipedia.org/wiki/Thumbnail> (last visited Apr. 20, 2006). The article also noted that in the instances where a Web site automatically scales down a picture to thumbnail size, the programs typically “reduce large pictures to a small size, the result may not be a quality thumbnail.” *Id.*

¹³⁸ *Arriba Soft*, 336 F.3d at 821.

¹³⁹ *Id.* See also *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 804 (9th Cir. 2003) (holding that photographer was “justified in the amount of Mattel’s copyrighted work that he used for his photographs,” because using “a lesser portion of the Barbie doll is completely without merit and would lead to absurd results”).

¹⁴⁰ *Arriba Soft*, 336 F.3d at 821.

¹⁴¹ *Sega Enters. v. Accolade, Inc.*, 1993 U.S. App. LEXIS 78, at *52 (9th Cir. Jan. 6, 1993).

programs are distributed for public use in object code form.”¹⁴² The court also reasoned that to copyright computer programs, and not let other software developers benefit from this code, would undermine the “fundamental purpose of the Copyright Act—to encourage the production of original works by protecting the expressive elements of those works while leaving the ideas, facts, and functional concepts in the public domain for others to build on.”¹⁴³ Additionally, “where the ultimate (as opposed to direct) use is . . . limited . . . the factor is of very little weight.”¹⁴⁴

4. Section 107(4): Potential Effect on the Market

This factor has been described by the Supreme Court as being the most important factor in the fair use analysis.¹⁴⁵ However, it is not a substitute for considering the other factors of the fair use analysis.¹⁴⁶ This factor looks at whether an alleged infringer’s work usurps the demand for plaintiff’s work.¹⁴⁷ A transformative work “is less likely to have an adverse impact on the market of the original than a work that merely supersedes the copyrighted work.”¹⁴⁸

The Second Circuit has held that this factor calls for a balancing “between the benefit the public will derive if the use is permitted and the personal gain the copyright owner will receive if the use is denied.”¹⁴⁹ Moreover, the Second Circuit held that “[t]he less adverse effect that an alleged infringing use has on the

¹⁴² *Id.* at *51.

¹⁴³ *Id.*

¹⁴⁴ *Sega Enters. v. Accolade, Inc.*, 977 F.2d 1510, 1527 (9th Cir. 1992).

¹⁴⁵ *Harper & Row Publishers, Co. v. Nation Enters.*, 471 U.S. 539, 566 (1984) (stating that section 107(4) is “undoubtedly the single most important element of fair use”). Even if this factor is considered the most important factor in the fair use analysis, it cannot work in lieu of an evaluation of all four of section 107’s factors. NIMMER, *supra* note 77, § 13.05[A][4].

¹⁴⁶ *See Am. Geophysical Union v. Texaco, Inc.*, 60 F.3d 913, 926 (2d Cir. 1993).

¹⁴⁷ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590–91 (1994); *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 821 (9th Cir. 2003).

¹⁴⁸ *Arriba Soft*, 336 F.3d at 821. The theory behind this is that if the use is considered transformative under section 107(1), then it is “less likely” that the new work would take business away from the original work. *Id.*

¹⁴⁹ NIMMER, *supra* note 77, § 13.05[A][4] (citing *MCA, Inc. v. Wilson*, 677 F.2d 180 (2d Cir. 1981)).

copyright owner's expectation of gain, the less public benefit need be shown to justify the use."¹⁵⁰

Upon interpreting section 107(4) in *Campbell*, the Supreme Court looked at whether 2 Live Crew's parody of the Roy Orbison hit "Oh, Pretty Woman" would usurp the market for the original work.¹⁵¹ Because 2 Live Crew's rap version of the Orbison song was transformative, the Court determined that "market substitution is at least less certain, and market harm may not be so readily inferred."¹⁵² To that end, in *Mattel, Inc. v. Walking Mountain Productions*,¹⁵³ the Ninth Circuit held that the artist's work was sufficiently transformative and did not see any danger to the potential market for Barbie dolls (young girls) through a photographer's parody work, which used Barbie dolls to portray his message about women's roles in society (strictly for cynical adults).¹⁵⁴

III. THE DEBATE OVER SECTION 107(4)

The problem with analyzing the fourth fair use factor is that in every fair use case a "plaintiff suffers a loss of a *potential* market if that potential is defined as the theoretical market for licensing the very use at bar."¹⁵⁵ However, the measure as to how closely

¹⁵⁰ *Id.*

¹⁵¹ *Campbell*, 510 U.S. at 571, 591. The court in *Campbell* found that because the second use was "transformative," the new work would not subsume the market for the old work. *Id.* at 591. The Circuit Court came to the same conclusion, that the 2 Live Crew song "was clearly intended to ridicule the white-bread original" and "reminds us that sexual congress with nameless streetwalkers is not necessarily the stuff of romance and is not necessarily without its consequences . . . there is no hint of wine and roses." *Campbell v. Acuff-Rose Music, Inc.*, 972 F.2d 1429, 1442 (6th Cir. 1992) (reversed on other grounds).

¹⁵² *Campbell*, 510 U.S. at 591.

¹⁵³ 353 F.3d 792 (9th Cir. 2003).

¹⁵⁴ See *Mattel*, 353 F.3d at 805 (disbelieving that Mattel, a children's toy company, would ever want to develop or license of dolls that were "sexualized figures"). The Second Circuit had a similar holding in *Mattel, Inc. v. Pitt*, where Barbie dolls dressed in S&M gear (called "Dungeon Dolls") would also not usurp the market for Barbie dolls. *Mattel, Inc. v. Pitt*, 229 F. Supp. 2d 315, 323 (S.D.N.Y. 2002).

¹⁵⁵ NIMMER, *supra* note 77, § 13.04[4]. See also Britton Payne, Comment, *Digital Advances and Market Impact in Fair Use Analysis*, 17 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 279 (2006).

attenuated the effect on the market is to the damage done to the plaintiff based on defendant's alleged infringement has been interpreted differently by the Second and the Ninth Circuits. The Second Circuit has held that every potential use by the author must be preserved—no matter how attenuated or far off into the future the use may be.¹⁵⁶ The Ninth Circuit also considers the potential uses by the author; however, on two occasions the court limited the potential market to what is either actually or reasonably foreseeable.¹⁵⁷ Both Circuits' holdings will be discussed at length.

A. *Second Circuit View:*

Broad View of the Potential Effect on the Market

In *Salinger v. Random House, Inc.*,¹⁵⁸ the Second Circuit held that a biographer of author J.D. Salinger did not make a fair use of the author's private letters.¹⁵⁹ The biographer, Ian Hamilton, sought to write a biography of Salinger's life.¹⁶⁰ As part of his research, Hamilton used excerpts of private letters written by Salinger.¹⁶¹ Hamilton found nearly all of the letters at Harvard, Princeton and the University of Texas libraries.¹⁶² After reading the first completed draft of the biography, Salinger objected to the publication of the book twice.¹⁶³ In the second draft of the book, more than 200 words from all of the letters were still quoted, and Salinger was able to identify 59 instances where the second draft contained passages that quote or closely paraphrase portions of his unpublished letters.¹⁶⁴ "These [infringing] passages drew upon 44 of the copyrighted letters"¹⁶⁵

¹⁵⁶ See *Salinger v. Random House, Inc.*, 811 F.2d 90, 99 (2d Cir. 1987) (discussing how potential uses by an author may be protected, and how authors have the right to "change their mind[s]").

¹⁵⁷ See discussion *infra* Part III.B.

¹⁵⁸ 811 F.2d 90.

¹⁵⁹ *Id.* at 92.

¹⁶⁰ *Id.*

¹⁶¹ *Id.*

¹⁶² *Id.* at 93.

¹⁶³ *Id.*

¹⁶⁴ *Id.*

¹⁶⁵ *Id.*

In its analysis of Hamilton's use of Salinger's letters in his book, the Court held against a finding of fair use.¹⁶⁶ In analyzing the fourth component of fair use, the Second Circuit found that J.D. Salinger's right to profit off of his letters—even if he had publicly declared that he would never publish his private letters—must be preserved. The court supported this reasoning in two ways. First, it said that section 107(4) looked at the *potential* market for the copyrighted work.¹⁶⁷ The court reasoned that there was a potential market for the letters in that Salinger may someday want to profit off of his work, even though Salinger had said on several occasions that he would not want to publish these private letters.¹⁶⁸ According to the court, if even a “few” readers would refrain from purchasing Salinger's letters in the future, it would be enough to militate a finding of fair use upon consideration of this factor.¹⁶⁹

Additionally, the Second Circuit reasoned that Salinger's right to publish the letters should not be taken away from him—despite how he vowed he would never want to publish or make money from them.¹⁷⁰ According to the court: “[t]he fact that their author has disavowed any intention to publish them during his lifetime” has not lessened “the effect on the market.”¹⁷¹ “First, the proper inquiry concerns the ‘potential market’ for the copyrighted work,” and “[s]econd, Salinger has the right to change his mind.”¹⁷² The author “is entitled to protect his opportunity to sell his [work].”¹⁷³

In later cases, the Second Circuit continued to follow this broad interpretation of the term “potential market” in section 107(4).¹⁷⁴ For example, in *Castle Rock*, the Court held that the defendant's

¹⁶⁶ See generally *id.*

¹⁶⁷ *Id.* at 99.

¹⁶⁸ *Id.*

¹⁶⁹ *Id.* “Perhaps few readers of the biography would refrain from purchasing a published collection of the letters if they appreciated how inadequately Hamilton's paraphrasing has rendered Salinger's chosen form of expression.” *Id.*

¹⁷⁰ *Id.*

¹⁷¹ *Id.*

¹⁷² *Id.*

¹⁷³ *Id.*

¹⁷⁴ See generally *Castle Rock Entm't v. Carol Publ'g Group*, 150 F.2d 132 (2d Cir. 1998).

creation of the “Seinfeld Aptitude Test” usurped a licensing opportunity, and was a potential way for the plaintiff to profit, had it wished to pursue it.¹⁷⁵ While the Second Circuit recognized that Seinfeld trivia books had not been created by Castle Rock Entertainment at the time of the litigation, the court recognized that copyright law “must respect” the “creative and economic choice” of the creator of the original work.¹⁷⁶

However, in a contrary opinion, *Mattel, Inc. v. Pitt*,¹⁷⁷ the Second Circuit ruled that there was no potential for market harm because Mattel was unlikely to develop or license others to develop a product in the “adult” doll market.¹⁷⁸ Similar to the Ninth Circuit’s holding in *Mattel v. Walking Mountain Prods.*, the court in *Pitt* found that the new work would not reasonably be a substitute for Barbie, and did not appeal to the same audience.¹⁷⁹ The court in *Walking Mountain* also found that there was a public interest in allowing a photographer to use Barbie images in its art, since “[i]t is not in the public’s interest to allow Mattel complete control over the kinds of artistic works that use Barbie as a reference for criticism and comment.”¹⁸⁰

¹⁷⁵ *Id.* at 145. “The SAT is likely to fill a market niche that Castle Rock would in general develop.” *Id.* (citing *Castle Rock*, 955 F. Supp. 260, 271–72 (S.D.N.Y. 1997). “Moreover, as noted by the district court, this ‘Seinfeld trivia game is not critical of the program, nor does it parody the program; if anything, SAT pays homage to Seinfeld.’” *Id.*

¹⁷⁶ *Id.* at 145–46; see also *Am. Geophysical Union v. Texaco, Inc.*, 60 F.3d 913, 930 (2d Cir. 1994) (holding that “[o]nly an impact on potential licensing revenues for traditional, reasonable or likely to be developed markets” should be considered as a relevant fourth factor). The court in *Castle Rock* stated that if the SAT had been more critical of the *Seinfeld* series (e.g. if the book “‘expose[d]’ the ‘nothingness’ or otherwise comment[ed] upon, criticize[d], [or] educate[d] the public about . . . *Seinfeld* and contemporary television culture”) it may have been protected under *Campbell*. *Castle Rock Entm’t v. Carol Publ’g Group*, 150 F.3d 132, 146 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994)).

¹⁷⁷ 229 F. Supp. 2d 315 (S.D.N.Y. 2002). Mattel brought an infringement action against an artist who designed Barbie dolls that were altered and given sadomasochistic attire and themes. *Id.* at 322–23. The line of figures were called “Dungeon Doll[s].” *Id.* at 319.

¹⁷⁸ *Id.* at 324.

¹⁷⁹ *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806 (9th Cir. 2003).

¹⁸⁰ *Id.*

B. Ninth Circuit View:

Actual or Foreseeable Market Harm Should Be Considered

In *Arriba Soft*, the Ninth Circuit found that thumbnails used by Arriba would not affect the potential, nor the actual, market for the copyrighted work.¹⁸¹ In that case, the defendant engaged in wholesale copying of larger pictures so that it could create lower-resolution thumbnail pictures to assist its users find out about different photographers' work.¹⁸² The court found that even though defendant engaged in wholesale copying, it would not detract from the value of the work, nor the users' desire to purchase a larger, clearer picture of the work.¹⁸³ The Ninth Circuit noted that the Arriba website was designed merely to find the photographs, but in order to obtain a "clear, full-sized image," a user would have to go to plaintiff's website.¹⁸⁴ The court justified the reasoning that a user would want a better-resolution copy of a picture from the plaintiff's site because of the "unique context of photographic images," and that the "quality" and "appearance of photographic images accounts for virtually their entire aesthetic value."¹⁸⁵

In *Perfect 10 v. Google*, a California District Court sought to define when a plaintiff would suffer a loss of a market due to an infringing use.¹⁸⁶ In November 2004, Perfect 10 sued Google for copyright infringement, and in August 2005, Perfect 10 requested an injunction to stop Google from what it characterized as copying, displaying and distributing over 3,000 of its copyrighted photos.¹⁸⁷

¹⁸¹ Kelly v. Arriba Soft, 336 F.3d 811, 821 (9th Cir. 2003).

¹⁸² *Id.*

¹⁸³ *Id.* "Even if users were more interested in Kelly's image itself rather than the information on the web page, they would still have to go to Kelly's site to see the full-sized image." *Id.* Further, the Ninth Circuit held that the "thumbnails would not be a substitute for the full-sized images because the thumbnails lose their clarity when enlarged," and that if a "user wanted to view or download a quality image, he or she would have to visit Kelly's web site." *Id.*

¹⁸⁴ *Id.* at 821–22. The court also held that it would be "extremely unlikely that users would download thumbnails for display purposes, as the quality full-size versions are easily accessible from Kelly's web sites." *Id.* at 821 n.37.

¹⁸⁵ *Id.* at 821 n.37.

¹⁸⁶ See generally *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828 (C.D. Cal. 2006).

¹⁸⁷ *Id.* at 830–31. See also Declan McCullah, *Nude-Photo Site Wins Injunction Against Google*, CNET.com, Feb. 22, 2006, <http://news.com.com/Nude-photo+site+wins+>

Perfect 10 argued that users who paid the \$25.50 subscription fee would then reproduce the copyrighted images on web sites that would be found via a Google image search.¹⁸⁸ Upon a given image search, Google would incorporate these pirated images and index them as thumbnails.¹⁸⁹ Perfect 10 objected to Google's display of these thumbnail images because these images could be easily downloaded onto cellular phones, which Perfect 10 argued would usurp their business for cell phone wallpaper images.¹⁹⁰ Google argued that the use of the images in the search engine constituted a fair use under section 107 consistent with the *Arriba Soft* holding.¹⁹¹

On February 17, 2006, the Central District of California granted a temporary injunction against Google, finding that Google's "creation and public display of 'thumbnails' likely do directly infringe [Perfect 10's] copyrights."¹⁹² In his 48-page order, Judge Matz noted that Google provides "an enormous public benefit,"¹⁹³ and that the "court is reluctant to issue a ruling that might impede the advance of internet technology."¹⁹⁴ Nevertheless, Google's display of the images did not constitute a fair use.¹⁹⁵ Upon consideration of section 107(1), the court determined that Google's use of the images was commercial in nature because the photos would drive increased user traffic and subsequently, increase advertising revenue.¹⁹⁶ Further, the court

injunction+against+Google/2100-1030_3-6041724.html?tag=nl. Perfect 10.com is a web site that touts "the most beautiful natural women. Perfect10.com, <http://www.perfect10.com> (last visited May 16, 2006).

¹⁸⁸ *Perfect 10*, 416 F. Supp. 2d at 832, 852. See also McCullah, *supra* note 187.

¹⁸⁹ *Perfect 10*, 416 F. Supp. 2d at 832–33.

¹⁹⁰ *Id.* at 832 (stating that Perfect 10 had a licensing agreement with Fonestarz Media Limited, a United Kingdom company, "for the worldwide sale and distribution of [Perfect 10] reduced-size copyrighted images for download and use on cell phones [and] it has sold, on average, approximately 6,000 images per month in the United Kingdom").

¹⁹¹ *Id.* at 836.

¹⁹² *Id.* at 831.

¹⁹³ *Id.* at 851.

¹⁹⁴ *Id.*

¹⁹⁵ *Id.* "[E]xisting judicial precedents do not allow such considerations to trump a reasoned analysis of the four fair use factors." *Id.*

¹⁹⁶ *Id.* at 846–47. It is important to note that the court in the Perfect 10 order distinguished the *Arriba Soft* decision because of how "Google offers and derives commercial benefit from its AdSense program." *Id.* Further, the court stated that

determined that Google's use of the images were consumptive rather than transformative, since Google not only provides the same images through the same medium as Perfect 10, but also its use of the thumbnails were found to "supersede [the] use of [Perfect 10's] images, because mobile users can download and save the thumbnails displayed by Google Image Search onto their phones."¹⁹⁷ However, the court did note that Google's use of the images in order to create a search engine index was presumptively not transformative in nature.¹⁹⁸

Upon consideration of the fourth Fair Use factor, the court distinguished this case from *Arriba Soft* because the images were used for more than just enhancing the search engine function—the images were downloadable, thus posing an *actual* threat to Perfect 10's ability to sell cell phone images.¹⁹⁹ The court held that thumbnail reproductions of images may only be considered a fair

"Google's thumbnails lead users to sites that directly benefit Google's bottom line." *Id.* at 847. At the time this Note was drafted, Google Book Project did not have banner ads on any of its search result pages, nor did it allow pages on third party sites to carry Google-sponsored advertising. *Perfect 10* discusses Google's advertising program. *See id.* at 834. *See also* Google Book Search, http://books.google.com/books?q=Elephant+Man&btnG=Search+Books&as_brr=0 (last visited Sept. 14, 2006) (exemplifying that there are no banner advertisements on a Google Book Search results page).

¹⁹⁷ *Id.* at 849. "[T]o the extent that users may choose to download free images to their phone rather than purchase [Perfect 10's] reduced-size images, Google's use supersedes [Perfect 10's]." *Id.*

¹⁹⁸ *Id.* The court reconciled this point by stating that Google does not profit from "providing adult content, but from locating, managing, and making information generally more accessible, and therefore more attractive to advertisers." *Id.* at 848. Upon consideration of the second fair use factor, the court relied heavily on the *Arriba Soft* decision, and found this factor weighed in favor of Perfect 10, because the work not only was deemed to be "creative," but also, because the work had been published in print and on the web. *Id.* As to the third fair use factor, the Court did not favor either party, recognizing that although Google did not copy a greater than necessary amount of the pictures from Perfect 10 so that it could operate its search engine, the pictures were copied in their entirety. *Id.* at 850.

¹⁹⁹ *Id.* at 850–51. The "cell phone image-download market may have grown even faster but for the fact that mobile users of Google Image Search can download the Google thumbnails at no cost." *Id.* at 851. Further, "[c]ommon sense dictates that such users will be less likely to purchase the downloadable [Perfect 10] content licensed to Fonestarz." *Id.* *But see* *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 821 (9th Cir. 2003). The thumbnails on defendant's site in that case "would not be a substitute for the full-sized images because the thumbnails lose their clarity when enlarged. *Id.* If a user wanted to view or download a quality image, he or she would have to visit Kelly's website." *Id.*

use if the new product is transformative in nature, e.g. providing a service to the world by assisting users in their search of the Internet, as expressed by the Ninth Circuit in *Arriba Soft*.²⁰⁰

IV. GOOGLE PRINT PROJECT QUALIFIES AS FAIR USE PURSUANT TO SECTION 107

In order to have a prima facie case for copyright infringement, the copyright holder must show ownership of the copyright in the work, and that the original elements of the work were copied.²⁰¹ There is no argument that these two elements exist in the present case. Whether or not the copying was transferred to the same medium or to a digital medium does not change the fact that copying has occurred.²⁰² Since Google asserts that it is not making any changes to the documents, the prima facie case for copyright infringement may be made. In response, Google may use the affirmative defense of fair use.

If a prima facie case for copyright infringement is made, Google should prevail based on its affirmative defense of fair use.²⁰³ Google has sufficiently transformed the use of the book, and, because of this transformation of the use, it does not have an effect on the potential market for the original copyrighted work. While Google uses the entire work in the scanning project, it is necessary in order for Google to carry out its mission. Moreover, if anything, Google's use of the works enhances the potential market for the books it showcases in its search engine.

A. *Preamble of Section 107 Covers Google Project in Broad Terms*

The preamble of section 107 states that the use of a copyrighted work "for purposes such as . . . scholarship or research

²⁰⁰ See Edward Wyatt, *Ruling May Undercut Google in Fight Over Its Book Scans*, N.Y. TIMES, Feb. 25, 2006, at C4. The article debates whether *Perfect 10* will aggravate Google's Book Search program, or if this case is an outlier that only applies to the facts of this case. *Id.* For a critique of the *Perfect 10* decision, see Payne, *supra* note 155.

²⁰¹ See *supra* note 77 and accompanying text.

²⁰² See *Arriba Soft*, 336 F.3d at 819.

²⁰³ See *supra* Part II.B.

is not an infringement of copyright.”²⁰⁴ Google has been explicit as to what the program is intended to do: assist with research and scholarship.²⁰⁵ Google asserts that its goal is to “make it easier for people to find relevant books—specifically books they wouldn’t find any other way such as those that are out of print . . .”²⁰⁶ The fact that Google is working with libraries is further evidence that Google’s goal is to promote accessibility to a wide array of information.²⁰⁷ Moreover, according to a recent survey, library-goers believe that Internet search engines are just as effective as a librarian.²⁰⁸ If librarians are employed to assist with scholarship, and an Internet search engine may make a librarian’s job easier and scholarship more effective, then the Google Print Project fits squarely within the interpretation of scholarship, and should be protected under the Copyright statute.²⁰⁹ It would be a disservice to the community for the Google program not to be interpreted as a

²⁰⁴ 17 U.S.C. § 107 (2000). The American Heritage Dictionary defines scholarship as “(1) The methods, discipline, and attainments of a scholar or scholars,” and “(2) Knowledge resulting from study and research in a particular field.” THE AMERICAN HERITAGE DICTIONARY 1559 (4th ed. 2000). Courts have struggled with the definition of “scholarship” and “fair use.” See *Newport-Mesa Unified Sch. Dist. v. Cal. Dep’t of Educ.*, 371 F. Supp. 2d 1170 (C.D. Cal. 2005) (copies of test protocols were a fair use because the copies were for a nonprofit educational use). *But see Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913 (2d Cir. 1994) (court finds against fair use because the nature of the research was primarily commercial).

²⁰⁵ See Google Book Search—News & Views—Facts & Fiction, *supra* note 52.

²⁰⁶ Google Books Library Project, <http://books.google.com/googlebooks/library.html> (last visited Sept. 12, 2006).

²⁰⁷ See *id.*; *supra* notes 48–51 and accompanying text. See also Michelle M. Wu, *Why Print and Electronic Resources Are Essential to the Academic Law Library*, 97 LAW LIBR. J. 233 (2005). This article discusses the need for electronic databases as well as libraries for actual books. See generally *id.* The author argues that since many “electronic documents are fleeting, ephemeral,” *id.* at 238, advanced digitalization technology can keep resources “accessible for use by future generations.” *Id.* at 241. The author also underscores the need for books, yet the need for a flexible resource such as an electronic database or the World Wide Web as a place where electronic works can easily be found and saved. *Id.* at 235. “Print unquestionably preserves information for future generations, but if libraries do not master and understand the media that their users prefer, the current generation may devalue the library to the point where it does not survive to serve future users.” *Id.* at 248.

²⁰⁸ Roy Tennant, *The Library Brand*, THE LIBRARY JOURNAL, Jan. 15, 2006, at 38.

²⁰⁹ See *supra* notes 207–208.

form of scholarship, especially since search engines such as Google have been praised as being accurate and convenient.²¹⁰

B. The Fair Use Factors

1. Purpose And Character of Use

a) Commercial or Not-for-profit?

This factor has two prongs that must be considered: whether the work is commercial in nature or not-for-profit, and whether the resulting work is transformative.²¹¹ There is no question that Google has for-profit or commercial motives, as it is a for-profit enterprise. The Supreme Court in *Harper & Row* determined that the commercial motive issue focuses on whether or not the alleged infringer “stands to profit from *exploitation* of the copyrighted material.”²¹²

While Google will presumably profit from users viewing search results, it does not seek to usurp the author’s original intent or message.²¹³ The profits that Google seeks to reap from this program would be gained through increased page viewership.²¹⁴ However, for the Author’s Guild or the AAP to attribute Google’s increased viewership to one or more of their members is far too attenuated and not within the spirit of either *Arriba Soft* or *Perfect 10*, both of which call for a direct link.²¹⁵ Also, in order for Google to create a project of this breadth, it needs, at the very least,

²¹⁰ Cf. Tennant, *supra* note 208. “[R]espondents pretty much equally trust the information they found using Internet search engines and the information they received from their library.” *Id.* “Respondents indicated that search engines deliver better quality and quantity of information than librarian-assisted searching—and at greater speed.” *Id.* (citing ONLINE COMPUTER LIBRARY CENTER, INC., *Perceptions of Libraries and Information Resources: A Report to the OCLC Membership* 6-5 (OCLC, Inc. 2005), available at http://www.oclc.org/reports/pdfs/Percept_all.pdf (last visited Sept. 12, 2006)).

²¹¹ See *supra* Part II.B.1., and accompanying notes.

²¹² See *Harper & Row v. Nation Enters.*, 471 U.S. 539, 562 (1985) (emphasis added).

²¹³ See Wojcicki Statement, *supra* note 26, and accompanying text.

²¹⁴ See *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828, 846–47 (C.D. Cal. 2006); see also *supra* notes 196, 198 and accompanying text.

²¹⁵ See *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828, 846–47 (C.D. Cal. 2006); see also *supra* notes 196, 198 and accompanying text.

to cover the costs of creating and maintaining this program.²¹⁶ Additionally, this project will make authors' works more widely discoverable.²¹⁷ In a sense, Google is acting as a marketing mechanism for these books, which is especially important for books that may be nearing the end of their period of copyright protection.²¹⁸

It is possible that the biggest adversaries of the Google Book Search project are the authors of books that are not commercially successful. However, there is evidence that online access to snippets of books actually drives content usage and sales for the books that are the least popular.²¹⁹ According to a recent study, 27 percent of page views resulting from a Google Book Search come from books generating only 2 percent of unit sales, while 47 percent come from books generating only 9 percent of sales.²²⁰ In other words, Google's Book Search engine is giving books that are either unpopular or out of print new life, and the search engine technology that Google has implemented is assisting users even with the most obscure requests.²²¹ This study provides some evidence that Google's efforts are not hurting authors, but are actually doing quite the opposite—giving unpopular books a new audience.²²²

²¹⁶ See *supra* notes 48–49 and accompanying text (demonstrating the breadth of the Google Book Project by exemplifying Google's agreements with individual libraries). See also History of Google Book Search, *supra* note 6 (timeline of Google Book project).

²¹⁷ See Tim O'Reilly, *Long Tail Evidence from Safari and Google Book Search*, O'REILLY RADAR, May 15, 2006, http://radar.oreilly.com/archives/2006/05/long_tail_evidence_from_safari_1.html. The study sought to show how there is an inverse relationship between the popularity of a book and the percentage of page views it may receive. *Id.* For example, the top 10 percent of print titles deliver 53 percent of all unit sales. *Id.* Upon analyzing the results with the Google Book Search, the top tier of books only generates 17 percent of Google Book Search page views. *Id.*

²¹⁸ See *id.*; Google Book Search FAQs, <http://books.google.com/googlebooks/common.html> (last visited Sept. 13, 2006). Responses to questions 3 and 4 discuss Google's goal to make books more discoverable, especially books whose copyrights have expired or never existed. *Id.*

²¹⁹ See O'Reilly, *supra* note 217.

²²⁰ *Id.*

²²¹ See *id.*

²²² See *id.*

b) Is Resulting Work Transformative?

The second part of the section 107(1) analysis considers whether the allegedly infringing work is transformative in nature.²²³ The key to evaluating this factor is to determine if the allegedly infringing work adds a new meaning, message or function through its use of the allegedly infringed material.²²⁴ Further, whether a use should be considered transformative depends on whether the new use may serve the public interest.²²⁵ The more the allegedly infringing work is transformed from the original, the less the commercialism prong of the section 107(1) test will matter.²²⁶

Because the Google Book Search is not a tool for reading books, but rather, a tool for finding books,²²⁷ it is sufficiently transformative. Like a dictionary or a telephone directory, indices are important to make huge amounts of information more manageable. To that end, what Google has done is not merely copy the work, but rather it has converted the author's work into something that is searchable.²²⁸ In *Arriba Soft*, the Ninth Circuit deemed thumbnail pictures to be a transformative use of the images, because the second work was used in order to aid the function of the search engine.²²⁹ The use of the scanned books in order to fulfill the purposes of the Google Print Project is equally necessary.²³⁰ In order to create useful search index results, Google must have the original works in their entirety.²³¹ Moreover, using

²²³ See *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 818 (9th Cir. 2003).

²²⁴ See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

²²⁵ *Religious Tech. Ctr. v. Netcom On-line*, 907 F. Supp. 1361, 1379 (N.D. Cal. 1995) (citing *Sega v. Accolade*, 977 F.2d 1510, 1523 (9th Cir. 1992)).

²²⁶ *Arriba Soft*, 336 F.3d at 818.

²²⁷ See *Google Book Search—News & Views—Facts & Fiction*, *supra* note 52 (stating “[s]ome of our critics believe that somehow Google Book Search will become a substitute for the printed word. To the contrary, our goal is to improve access to books—not to replace them. Indeed, we’re working closely with publishers to develop new tools and opportunities for selling books online”).

²²⁸ See *id.*

²²⁹ *Arriba Soft*, 336 F.3d at 821–22.

²³⁰ See *id.*; see also *supra* Part I.C.

²³¹ See *id.* (discussing the search engine primer, which explains that in order for the search engines to pick out terms that are pertinent, the full text must be available and coded for the “spiders” to find items specifically within the Print Program’s database).

the most conservative display page that the Google Print Project will provide (e.g. the Snippet View), only a few sentences surrounding the search term will be presented.²³² If a user's interest is piqued by those few sentences, he may either purchase the book or find out where to borrow it.²³³ Google is the liaison between the user and the bookstore or library. It does not seek to be an author, book editor, seller, or distributor.²³⁴ Thus, if the end use is fair, the means to find that information is also fair.²³⁵

While the holding of *Perfect 10* does not on its face appear to support Google Book Search,²³⁶ dicta presented by the court supports the underlying goals of the project. The transformative nature of the Google Book Project would withstand the reasoning set forth in the *Perfect 10* order. In *Perfect 10*, the court held that the use of thumbnails by Google was consumptive rather than transformative, and this factor weighed in favor of *Perfect 10*.²³⁷ This is because the thumbnails in this specific case were too similar in size, shape, and resolution to the images *Perfect 10* offered to its Fonestarz subscribers, which is a realized market.²³⁸ In fact, the court stated that when a full-sized image is converted into a thumbnail, roughly 98 percent of the information from the original image is lost in the transformation process, thus reconfirming that thumbnails are typically a transformative use, such as that in *Arriba Soft*.²³⁹

Using this reasoning, Google Book Search's use of the snippets is sufficiently transformative, and not consumptive as defined in

²³² See Google Book Search Program Basics, *supra* note 7.

²³³ Google Book Search Program Basics, *supra* note 7.

²³⁴ See *supra* Part I.A. and accompanying notes.

²³⁵ See *Sega Enters. v. Accolade, Inc.*, 977 F.2d 1510, 1518 (9th Cir. 1992) (holding that "disassembly of copyrighted object code is, as a matter of law, a fair use of the copyrighted work if such disassembly provides the only means of access to those elements of the code that are not protected by copyright and the copier has a legitimate reason for seeking such access").

²³⁶ See generally *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828 (C.D. Cal. 2006).

²³⁷ *Id.* at 849.

²³⁸ See *id.* The court did say that the images on Google's Image Search did not usurp the market for *Perfect 10*'s larger images. *Id.* at 850.

²³⁹ See *id.* at 847 n.13.

Perfect 10.²⁴⁰ There is no current market for the display of single pages (or portions of pages) of an author's work. Further, the distillation of a work down to a few sentences withholds more than 98 percent of the information available in the original work. For example, a novel that is 200 pages long has roughly 80,000 to 150,000 words.²⁴¹ A fifty word segment²⁴² of an 80,000 word novel represents less than 0.5 percent of the work.²⁴³ Also, unlike the images in the Google Image Search, it is not possible to download or copy the display pages resulting from a Google Book Search.²⁴⁴

Additionally, Google Book Search serves the public interest in that the proliferation of the Internet and search engines provides "great value to the public."²⁴⁵ In *Perfect 10*, Judge Matz stated: "[G]iven the exponentially increasing amounts of data on the web, search engines have become essential sources of vital information for individuals, governments, non-profits, and businesses who seek to locate information."²⁴⁶ Thus, courts should find in favor of Google on this factor of the fair use defense.

2. Nature of the Copyrighted Work

The copyrighted works in this program are primarily works of non-fiction.²⁴⁷ While fictitious work merits the greatest amount of copyright protection, non-fiction work merits similarly high

²⁴⁰ See *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828, 847 (C.D. Cal. 2006) (citing *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 816 (9th Cir. 2003)) ("A consumptive use is one in which defendant's 'use of the images merely supersede[s] the object of the originals . . . instead [of] add[ing] a further purpose or different character.'")

²⁴¹ See Tameri Guide For Writers, <http://www.tameri.com/format/wordcounts.html> (last visited Sept. 12, 2006) (offers chart showing word length requirements for most publishers).

²⁴² For the purposes of this Note, I approximate that the few sentences shown in the Snippet View of a Google Book Search amounts to fifty words or less.

²⁴³ See Tameri Guide for Writers, *supra* note 241.

²⁴⁴ See *supra* Part I.B.

²⁴⁵ *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828, 849 (C.D. Cal. 2006).

²⁴⁶ *Id.* See also Tennant, *supra* note 208 and accompanying text.

²⁴⁷ See Jonathan Band, *The Google Print Library Project: A Copyright Analysis*, 242 ARL BIMONTHLY REPORT 6, 7 (Oct. 2005), available at <http://www.arl.org/newsltr/242/ARLBR242google.pdf>.

protection as long as it is a product of “diligence.”²⁴⁸ This factor would not weigh in favor of either party, or it may weigh slightly in favor of the publishers and authors because the books that are being used in the project are copyrighted works.²⁴⁹

3. Amount and Substantiality of the Work Used

This factor takes into account the amount and the quality of the plaintiff’s work that was used in the allegedly infringing work.²⁵⁰ The courts are split about how much of a copyrighted work may be allowed before there is no finding of fair use.²⁵¹ In *Arriba Soft*, the court found that copying pictures to be used as thumbnails for a search engine “neither weigh[ed] for nor against either party.”²⁵² If Arriba only used part of an image (e.g. cropped the image), there would be greater difficulty in identifying the image, “thereby reducing the usefulness of the visual search engine.”²⁵³ The reasoning used by the *Arriba Soft* court directly correlates to the Google case because books in their entirety must be searchable for the Google Book Search to fully serve its purpose as a productive research tool.²⁵⁴

Case law in the Supreme Court, the Ninth Circuit and the Second Circuit has, in limited instances, allowed for full copying to occur if it was necessary to carry out a transformed purpose.²⁵⁵ Here, the transformed purpose is to find books, not read books.²⁵⁶ The proposition that Google should copy an entire work in order to promote its search engine may be supported by the Ninth Circuit holding in *Arriba Soft*, and the dicta in *Perfect 10*, where the court

²⁴⁸ See *supra* notes 123–124 and accompanying text.

²⁴⁹ See *supra* Part II.B.2.

²⁵⁰ See *Harper & Row Publishers Co. v. Nation Enters.*, 471 U.S. 539, 564–65 (1985).

²⁵¹ See *supra* Part II.B.3.

²⁵² *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 821 (9th Cir. 2003).

²⁵³ *Id.*

²⁵⁴ See *supra* notes 227–235.

²⁵⁵ See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586–87 (1994); *Arriba Soft*, 336 F.3d at 821; *Wright v. Warner Books*, 953 F.2d 731, 738 (2d Cir. 1991); *New Era Publ’ns Int’l ApS v. Carol Publ’g Group*, 904 F.2d 152, 158–59 (2d Cir. 1990).

²⁵⁶ See *Google Book Search—News & Views—Facts & Fiction*, *supra* note 52.

recognized that Google did not copy more than necessary in order to make its search engine index useful.²⁵⁷

Google does not tout itself as an editor of books; rather, it is a company that creates indices in order to assist web users to find information in an organized fashion.²⁵⁸ In order to obtain a pertinent snippet from a book, Google's programmers must be allowed to enter as many effective search terms as possible.²⁵⁹ Based on how search engines work, programmers need to use the scan of an entire book, and enter the appropriate hypertext so that it will be an effective search tool.²⁶⁰ Thus, this factor should weigh in favor of Google.

4. Effect of Use upon Potential Markets

There are two major considerations that courts must make under this factor of the fair use analysis. First, the Book Search will not usurp the market for purchasing, borrowing, or reading books. Second, it seems implausible that publishers would be able to create a search engine with the breadth or impartiality that

²⁵⁷ See generally *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003); *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828 (C.D. Cal. 2006).

²⁵⁸ Consider *N.Y. Times v. Tasini*, 533 U.S. 483 (2001), where the Supreme Court made a distinction between authors' original work and the derivative work of a compilation or collection. The court held that a "publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a [previous] edition of an encyclopedia in a [later] revision of it; the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work." *Id.* at 496-97 (citing H.R. REP. NO. 94-1476, at 122-23 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5738).

Using the same logic, Google would be negating its fair use defense if it began using only portions of books, rather than books in their entirety. Arguably, the edited works that Google would create for the Book Project would create new, unauthorized copies of the works without the authors' permission. Further, this editing, without authorization from the publisher, could also (perhaps unintentionally) change the message of the work, which could ultimately create a market for an edited work from which the original author or publisher would not profit. Copying only selected parts of a book, as opposed to copying the book in its entirety, would add labor that would undermine the very object of the fair use defense.

²⁵⁹ See *supra* Part I.C. (explaining how search engines compile and search their databases).

²⁶⁰ See *id.*

Google has been able to create. Both considerations will be discussed at length.

a) Google Book Project Does Not Usurp Market for Books

The effect on the potential book market hinges on whether or not the secondary use of the material is a transformative use.²⁶¹ In this case, Google has transformed the use of the original work into something where the purpose is different than the purpose of the original. As discussed *supra*, Google's Book Project is sufficiently transformative in that it is not about *reading* books, but rather about *finding* books.²⁶² In order to read the entire book, a user will have to visit her local library or buy the book, possibly from one of the recommended book sellers.²⁶³ While the holdings of *Arriba Soft* and *Perfect 10* are different, both courts agreed that a "potential market" should be reasonably foreseeable, and not speculative.²⁶⁴ Moreover, Google has coded the program in such a way that it would be impossible to read or download an entire book through the Book Search mechanism.²⁶⁵

In *Perfect 10*, the Court found against Google because, in that specific instance, there was a market for the smaller images that was not merely *potential*, but *actual*.²⁶⁶ Perfect10.com had a contract for the sale of the photos with UK company Fonestarz, and it could measure a loss of business due to users' downloading of thumbnail images from Google rather than from Perfect10.com.²⁶⁷ Furthermore, the court in *Perfect 10* was careful to carve out an exception to their ruling, and noted that the creation of an index by a search engine in most other instances, including that in *Arriba Soft*, is presumptively a fair use because the images (or in the present case, the snippets) are merely a way of displaying

²⁶¹ See *Kelly v. Arriba Soft*, 336 F.3d 811, 821 (9th Cir. 2003).

²⁶² See Google Book Search Program Basics, *supra* note 7 ("Search full text of books to find ones that interest you *and learn where to buy or borrow them.*" (emphasis added)).

²⁶³ See Google Book Search—News & Views—Facts & Fiction, *supra* note 52.

²⁶⁴ See *supra* Part III.B. (discussing the *Arriba Soft* and *Perfect 10* decisions and analysis of the "actual or foreseeable market harm" factor of the fair use analysis).

²⁶⁵ See Google Book Search—News & Views—Facts & Fiction, *supra* note 52.

²⁶⁶ *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828, 850–51 (C.D. Cal. 2006).

²⁶⁷ *Id.*

and conveying information to the user.²⁶⁸ In the present case, there is no existing market for random snippets of authors' works. Google Book Search is also nothing like *Harper & Row* or *Castle Rock*,²⁶⁹ since the viewable quotes are merely random, explanatory notes about a particular book.²⁷⁰

If anything, the Google Print Project promotes the sale of books rather than interfering with the sale of books. Google clearly lists locations where the book can be purchased on the left-hand rail of each book search page.²⁷¹ Because the book cannot be fully accessed in the Google Book Search, it is reasonable that a user may want to either borrow the work, or purchase it to read it in its entirety.²⁷² Considering this logic, the project promotes exposure to books, and converts the books into a searchable

²⁶⁸ *Id.* at 855.

²⁶⁹ See *Harper & Row Publishers, Co. v. Nation Enters.*, 471 U.S. 539, 566 (1984); *Castle Rock Entm't v. Carol Publ'g Group*, 150 F.3d 132 (2d Cir. 1998).

²⁷⁰ *Perfect 10*, 416 F. Supp. 2d at 855. One legal scholar expressed concern that the Google Book Search may make excerpts available that would give away the "punch line" of a book, thus usurping sales of that particular work. See generally *Zacchini v. Scripps-Howard Broad. Co.*, 376 N.E.2d 582 (where court held that the broadcast of a film of appellee's entire act posed a substantial threat to the economic value of that performance, because if the public could see the act for free on television, they would be less willing to pay to see it). However, there is an intuitive distinction between intentionally reporting the climax of a circus act, which, in turn, results in a direct correlation in lost revenues for the "human cannonball" performance, as in *Zacchini*, and the random appearance of a crucial passage of a book due to a search engine result. Even if, for instance, a Google Book Search result yielded something to the effect of "The Butler did it!" it is impossible to believe that this "spoiler" will, in effect, ruin the market for this particular book. The author of the paper posits that any "spoiler" the Google Book Search may reveal, is just as or even more innocuous than any "spoiler alert" in an entertainment magazine or television program.

Additionally, to find Google liable for revealing the climax of a book without intent—meaning, the "spoiler" results from a random search and subsequently, Google is found strictly liable—runs counter to First Amendment jurisprudence. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 347 (1974) (holding that private individuals may receive damages for defamatory remarks "so long as they do not impose liability without fault").

²⁷¹ See Google Book Search Program Basics, *supra* note 7.

²⁷² See *id.* According to a recent article, e-book authors and publishers are not as concerned with piracy, as they are with obscurity. See Mark J. McGarry, *The End User: E-Books Spur Sales*, INTERNATIONAL HERALD TRIBUNE, Aug. 6, 2005, available at <http://www.iht.com/articles/2005/08/05/business/ptend06.php>.

medium. This use of the copyrighted works is sufficiently transformative, and thus, does not affect the market for books.

b) Market for Book-Searching Engines Would Not Be Usurped

As of September 2006, there is no evidence that the publishers of the books plan to create a search engine that would compete with Google's Print Project plan.²⁷³ The transaction costs to contact each author or publisher individually, as opposed to working with libraries, would pose an undue burden on Google, and would undermine the character of Google's fair use.

Opt-in participation versus opt-out participation by authors would ultimately create a search engine that is not as comprehensive, nor as impartial as the one that Google has constructed. Fair use is an affirmative defense; there is no requirement that a subsequent user of material ask for permission prior to using it fairly. To require Google to conduct the project by contacting publishers as opposed to the libraries hinders the educational, scholarship, and research purposes that section 107 seeks to protect.²⁷⁴ Preventing Google from working directly with libraries also undermines the definition of fair use, pursuant to *Campbell*, *Sony* and *Sega*.

V. CONCLUSION

On balance, the Google Book Search should be considered a "fair use" under section 107 of the Copyright Act. The key to this analysis is that the search engine does not offer a substitute for buying or borrowing books; rather, it offers users an opportunity to

²⁷³ *But see* Edward Wyatt, *HarperCollins Will Create a Searchable Digital Library*, N.Y. TIMES, Dec. 13, 2005, at E8 (discussing HarperCollins' plans to offer a digital database of its books).

²⁷⁴ *See* 17 U.S.C. § 107 (2000). Consider this hypothetical: Publisher X, who is involved in one of these lawsuits, states that there is a "potential market" for an online card catalog, that he wants to create himself. If publishers acted independently to create their own searchable catalogs, the result would be that each publisher's catalog would list only its own works. A website showcasing only one publisher's works is antithetical to the goals of scholarship and research because it would be impossible to do a universal search, as can be done in a library.

find books that may have become buried in the back archives of a university or public library.

The Google Book Search does more than just expose users to new books. It will, in time, promote further use of libraries. It has been widely reported that fewer people are visiting libraries and librarians are struggling to increase the number of visitors so that they can justify their large budget allocations for library improvements and to increase its circulation. It is possible that the way to encourage more library visitors is through technological improvements both within the library and on the World Wide Web.²⁷⁵ As discussed *supra*, Tennant notes that “respondents pretty much equally trust the information they found using Internet search engines and the information they received from their library,” and that “[r]espondents indicated that search engines deliver better quality and quantity of information than librarian-assisted searching-and at greater speed.”²⁷⁶ Thus, if an Internet search engine can deliver both the expertise and wisdom of the library shelves with efficiency, as well as fall in line with current trends of library usership, then the Google Print Project has important social objectives that must be encouraged. Finally, to prohibit this program from continuing would ultimately discourage the creation of more innovative Internet search engines. Google’s pioneering search engine technology is a development that is important to society.

²⁷⁵ See Tennant, *supra* note 208.

²⁷⁶ *Id.*