

AN HISTORICAL SOLUTION TO THE LEGAL CHALLENGES POSED BY PEER-TO-PEER FILE SHARING AND DIGITAL RIGHTS MANAGEMENT TECHNOLOGY.

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ABSTRACT:

US cases concerning Peer-to-Peer technologies (hereafter 'p2p') and Digital Rights Management ('DRM') mechanisms have placed considerable emphasis upon the financial interests of right holders, in particular the markets for their copyright works. The reason for this is historical – courts have often emphasised the interests of the right holder, and furthermore, assumed the interests of the right holder are synonymous with encouraging new creative copyright works. However, in the context of p2p and DRM, the interests of right holders, authors, and content recipients are in pronounced conflict. For this reason, the historically market orientated approach of the courts ultimately over emphasise the interests of right holders. This paper suggests that an alternative historical approach to copyright infringement in the UK can go some way to restoring the copyright balance.

INTRODUCTION.

There has been a trend within recent US copyright cases concerning DRM and p2p networks to place considerable emphasis upon the business and market interests of right holders.¹ In the past, there was not always this emphasis on the right holder. Early UK cases concerning primary infringement, to which some seminal US decisions have referred,² focused on the 'merit' of the potentially infringing work.³ However, there was a

¹ Inter alia *Universal City Studios, Inc. v Reimerdes* 111 F.Supp. 2d 294 (SDNY, 2000); *Universal City Studios, Inc. v Corley* 273 F.3d 429 (2nd Circuit, 2001); *RealNetworks, Inc v Streambox, Inc* WLR 127311 (otherwise unreported, WD Wash., 2000); *A&M Records, Inc. v Napster, Inc* 239 F.3d 1004 (9th Circuit, 2001); *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd.* 125 S.Ct. 2764 (Supreme Court, 2005).

² *Wheaton v Peters* 33 U.S. (Pet. 8) 591 (Supreme Court, 1834); *Folsom v Marsh* 9 F Cas 342 (CCD Mass, 1841); *Stowe v Thomas*, 23 F. Cas. 201 (C.C.E.D. Pa. 1853).

³ *Burnett v Chetwood* (1721) 35 Eng Rep 1008; *Gyles v Wilcox* (1741) Barn C 368; *Hawkesworth v Newbery* (1774) referenced in Kaplan, B., 'An Unhurried View of Copyright', Columbia University Press, New York

competing line of cases that gained increasing influence, and these focused on the existing interests of right holders.⁴ In relation to DRM and p2p, it is that latter approach that predominates today, and this has seen an over emphasis upon the interests of right holders.⁵ This paper assesses whether the ‘merit’ based approach would address this issue.

By way of explanation as to what is meant by ‘over emphasis’, in *Reimerdes*⁶ the US Southern District Court of New York considered a program that could act as a method of circumventing a DRM mechanism under the DMCA.⁷ At the start of his judgment, Judge Kaplan outlined a perceived conflict between right holders and content recipients.⁸ He stated that ‘Congress struck a balance’⁹ between their competing interests. The decision was built on an unquestioned assumption of conflict between the interests of right holders and the interests of content recipients. At no stage did he question a) whether there was necessarily a conflict between the two, and b) whether the balance was being achieved. For Judge Kaplan, the issues concerned had simply been decided by Congress.

A similar conflict between the right holder and content recipient was outlined in the *RealNetworks*¹⁰ case in the Western District of Washington. One of the programs involved in the proceedings was a program distributed by Streambox known as the Streambox VCR. This would permit content recipients to download and store on their computers files normally kept on RealNetworks’ servers. As a result of downloading the files, recipients could view them at any future date and in conjunction with other programs (such as the Streambox Ripper) could edit the content. Justice Pechman pointed out that ‘the Streambox VCR poses a threat to RealNetworks’ relationships with existing and potential customers who wish to secure their content for transmission over the Internet and must decide whether to purchase and use RealNetworks’ technology.’¹¹

(1966) at 12.

⁴ *Sayre v Moore* (1785) the report of which is available within *Cary v Longman* 1 East 357 (1801) at 358; *Trusler v Murray* (KB 1789) 1 Eng Rep. 140, the report of which is also available within *Cary v Longman* at 360; *Longman v Winchester* (1809) 16 Ves Jun 269.

⁵ *Supra* 1.

⁶ *Universal City Studios, Inc. v Reimerdes* (SDNY, 2000) *supra* 1.

⁷ ‘The Digital Millennium Copyright Act’, Pub. L. 105-304, October 28th 1998, 112 Stat. 2860

⁸ *Universal City Studios, Inc. v Reimerdes, ibid.*, at 304.

⁹ *Universal City Studios, Inc. v Reimerdes, ibid.*

¹⁰ *RealNetworks, Inc v Streambox, Inc* (WD Wash., 2000) *supra* 1.

¹¹ *RealNetworks, Inc v Streambox, Inc ibid.*, Para 31 under Findings of Fact.

Focus was purely on the relationship between RealNetworks investments and its customer base. There was not consideration of whether RealNetworks would stand to gain new customers from the use of the Streambox VCR. This failure extends into other fields such as secondary liability. In the Ninth Circuit *Napster*¹² case Judge Beezer, as part of his Fair Use analysis, considered the impact of the Napster file sharing network on the existing market. This follows an established line of cases that require the court to consider the impact of the use on the existing market.¹³ In affirming the judgment of Judge Patel in the District Court, Judge Beezer wrote that Napster harmed the market in two distinct ways – in reducing CD sales among college students, and in creating a barrier to entry into the digital downloading market.¹⁴ Judge Beezer did refer to potential uses of Napster that could come under the Fair Use defence (such as space shifting¹⁵) but these were denied on the facts. In the District Court, Judge Patel did make some references to the extra exposure that some new artists might gain, but that was as far as she went. The new works and extra creativity that Napster could encourage was given short shrift by Judge Patel. She stated that ‘at least on paper, the promotion of new artists constituted an aspect of defendant's [sic] plan as early as October 1999.’¹⁶ Nonetheless, she was highly sceptical, and proceeded to state that the New Artist Program consisted only of a small proportion of Napster use – worse still that it ‘did not become central to defendant's [sic] business strategy until this action made it convenient to give the program top billing.’¹⁷

The lack of consideration of new artists is perhaps surprising considering the importance of the staple article of commerce doctrine in *Napster*. The staple article of commerce doctrine permits a potentially infringing device to exist if there are ‘significantly non-infringing uses’.¹⁸ Importantly, these uses may be considered in light of the quality of

¹² *A&M Records, Inc. v Napster, Inc* (9th Circuit, 2001) *supra* 1 at 1016.

¹³ *Harper & Row Publishers, Inc. v Nation Enterprises*, 471 US 539 (Supreme Court, 1985) at 566-67. Cited by *A&M Records, Inc. v Napster, Inc* (9th Circuit, 2001) *ibid.* at 1016.

¹⁴ *A&M Records, Inc. v Napster, Inc.*, *ibid.*, at 1016.

¹⁵ This refers to the ability to transfer existing works to new machines, analogous to ‘time shifting’ - *A&M Records, Inc. v Napster, Inc* *ibid.*, at 1014.

¹⁶ *A&M Records, Inc. v Napster, Inc* 114 F.Supp.2d 896 (ND Cal., 2000) at 904.

¹⁷ *A&M Records, Inc. v Napster, Inc* (ND Cal., 2000) *ibid.*, at 904.

¹⁸ *Sony Corp. of America v Universal City Studios, Inc.*, 464 U.S. 417 (Supreme Court, 1984).

such uses rather than simply quantity.¹⁹ Nevertheless, the *Napster* judgments focused on quantity. Emphasis was placed on the economic loss to the plaintiff and the volume of infringing files available. Judge Beezer in the Ninth Circuit focused on a specific quote from *Sony*:

‘A challenge to a noncommercial use of a copyrighted work requires proof either that the particular use is harmful, or that if it should become widespread, it would adversely affect the potential market for the copyrighted work.... *If the intended use is for commercial gain, that likelihood [of market harm] may be presumed. But if it is for a noncommercial purpose, the likelihood must be demonstrated.*²⁰

However, it should be noted that Judge Beezer’s judgment has already stressed that there was commercial gain for Napster. Nearly one third of Judge Beezer’s Fair Use analysis looks to the commercial implications of the Fair Use.

The same reasoning is most prominent in the judgment of Justice Souter in *Grokster*²¹ as heard in the Supreme Court. Having mentioned *Sony*, there is merely a token acknowledgement of the encouragement of creativity of certain non-infringing works. Justice Souter, for instance, recognized that some musical performers gained new audiences by distributing their copyrighted works across peer-to-peer networks for free. Furthermore, he noted that non copyright works such as Shakespeare have been distributed across these networks, and that StreamCast gave Morpheus users the opportunity to download the case briefs.²²

Though this would suggest that the network encourages non infringing uses, Justice Souter stresses the volume of infringement in relation to the Appellants:

¹⁹ *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd.* (Supreme Court, 2005) *supra* 1 at 2789 (in reference to *Sony Corp. of America v Universal City Studios, Inc.*, (Supreme Court, 1984) *ibid.*

²⁰ *A&M Records, Inc. v Napster, Inc* (9th Circuit, 2001) *supra* 1 at 1016 (quoting *Sony*, 464 U.S. 417 at 451, emphasis added by Judge Beezer).

²¹ *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd* (Supreme Court, 2005) *supra* 1..

²² *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd* *ibid.* at 2772.

‘MGM's evidence gives reason [sic] to think that the vast majority of users' downloads are acts of infringement, and because well over 100 million copies of the software in question are known to have been downloaded, and billions of files are shared across the FastTrack and Gnutella networks each month, the probable scope of copyright infringement is staggering.’²³

However, an approach that initially appears more receptive to the notion of the encouragement of non infringing uses is present in the concurring judgment of Justice Breyer. He takes a different approach in that he stresses *Sony*²⁴ looks at the quality (actual or potential) of non-infringing use, rather than merely quantity. After stressing that MGM suggested infringement occurred in 90% of uses, he stated that non infringing uses were to account for only a small percentage of Grokster’s users. However, notwithstanding this, he continued, the same was true in the *Sony* case, ‘which characterized the relatively limited authorized copying market as ‘substantial’.’²⁵

Justice Breyer appears to be suggesting that there *should* be a focus on the non infringing uses, but the closest he gets to discussing this in depth is when he writes that the Grokster software ‘... permits the exchange of *any* sort of digital file--whether that file does, or does not, contain copyrighted material.’²⁶ Consequently, those non infringing uses did not receive much attention.

Thus, it still holds true that when the courts openly refer to the business interests of right holders, there is an assumption that right holders would not enter a particular market if a certain act was occurring. For instance, the rationale of District Judge Kaplan’s judgment in *Reimerdes*²⁷ is that there would be no digital videos if there was no DRM in the form

²³ *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd* *ibid.*

²⁴ *Sony Corp. of America v Universal City Studios, Inc.*, (Supreme Court, 1984) *supra* 18.

²⁵ *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd* (Supreme Court, 2005) *supra* 1 at 2789. Note that Judge Beezer in *A&M Records, Inc. v Napster, Inc* (9th Circuit, 2001) *supra* 1 makes a similar observation, that time shifting may necessitate a complete copy (*ibid.* at 1016). However, the point is not made so eloquently, and there is not a link across to infringing works. The statement is kept within the confines of ‘The Portion Used’, the third test of Fair Use.

²⁶ *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd* (Supreme Court, 2005) *ibid.*, at 2789.

²⁷ *Universal City Studios, Inc. v Reimerdes* (SDNY, 2000) *supra* 1.

of CSS.²⁸ In other words, copyright law is being used to protect a publisher's existing interests under the assumption that this encourages new works from that publisher, or others in a similar market position. Indeed, the case law does not even refer to wider notions of authorship, but merely the right holder (typically a publisher) in the given case.²⁹ There is an assumption that the existing market model rewarding publishers rather than creators directly is sufficient. However, there is a difference between encouraging new works and protecting existing business interests. The difference between the interests of commercial right holders and creators is not a distinction clearly drawn in the cases cited immediately above.

The problem is that such an approach then leads to the assumption that damaging the financial interests of right holders is *per se* to discourage new works. The judgment of Justice Souter in the Supreme Court in *Grokster*³⁰ confirms this:

‘The tension between the two values is the subject of this case, with its claim that digital distribution of copyrighted material threatens copyright holders as never before, because every copy is identical to the original, copying is easy, and many people (especially the young) use file-sharing software to download copyrighted works ..[thereby] fostering disdain for copyright protection.’³¹

The two values being referred to are ‘artistic creativity’ and ‘technological innovation.’³² There is the assumption that right holders and technological innovation are in conflict. However, they do not need to be presented as being in conflict. For example, his judgment does not consider how *Grokster* has helped to develop p2p networks, despite mentioning ‘technological innovation.’³³ These networks allow computers to connect

²⁸ *Universal City Studios, Inc. v Reimerdes* (SDNY, 2000) *ibid.*, at 214.

²⁹ Acenbach, K., ‘Grey Area: How Recent Developments in Digital Music Production Have Necessitated the Re-examination of Compulsory Licensing for Sample Based Works’ 6 *North Carolina Journal of Law and Technology* 187 (2004), *supra* 9 and *A&M Records, Inc. v Napster, Inc.* (9th Circuit, 2001) *supra* 1.

³⁰ *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd.* (Supreme Court, 2005) *supra* 1.

³¹ *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd.* (Supreme Court, 2005) *ibid.*, at 2775.

³² *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd. ibid.*, specifically within context: ‘MGM and many of the amici fault the Court of Appeals’ holding for upsetting a sound balance between the respective values of supporting creative pursuits through copyright protection...’ at 2775.

³³ Whilst he highlights the advantages of p2p in *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd. ibid.*, at 2770, he does not develop this further.

together directly, and files are distributed between computers allowing for more efficient networking. In addition, artistic creativity is treated by Justice Souter as being synonymous with current right holders.³⁴ The overall approach of courts, in aligning protection of business interests with creation of new works, is hardly surprising. The lawsuits in question were brought by companies whose interests have been damaged by unauthorised reproduction or circumvention.³⁵

WHY THE PROTECTION OF THE EXISTING INTERESTS OF RIGHT HOLDERS SHOULD NOT BE TREATED AS SYNONYMOUS WITH ENCOURAGING NEW COPYRIGHT WORKS.

The difference between the existing interests of a right holder and the creation of new works are best demonstrated by considering the sorts of things that induce individuals to create. First and foremost is that creativity is not always induced by the desire for financial reward. This was suggested by Stephen Breyer,³⁶ who argued that whilst financial rewards are important, they are not the whole story. He suggested that social circumstance and social standing may be sufficient reward. An individual may wish to simply create for that individual's own internal needs and wants. Nonetheless, Barry Tyerman wrote a particularly damning article which argued Breyer's views were flawed – and he did so by focusing on the financial interests of publishers. He argued that publishers needed a safe haven within which to publish their works, to ensure that they could get a return for their investment.³⁷ However, today the view has changed considerably, with Lawrence Lessig, Siva Vaidhyanathan and William Fisher considering non-economic rewards to be equally relevant.³⁸ Furthermore, they do so by looking beyond the economic interests of the publishers. There is evidence of non economic reward being a significant factor for those who create remixes of existing works. For example, a remake of Star Wars I, known as the 'Phantom Edit,' was distributed free of

³⁴ *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd. ibid.* at 2775.

³⁵ *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd. ibid.*, at 2772, *A&M Records, Inc. v Napster, Inc* (9th Circuit, 2001) *supra* 1 at 1016, and *RealNetworks, Inc v Streambox, Inc* (WD Wash., 2000) *supra* 1 at Para 31 under 'Findings of Fact'.

³⁶ Breyer, S., 'The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs', 84 *Harvard Law Review* 281 (1970).

³⁷ Tyerman, B., 'The Economic Rationale for Copyright Protection For Published Books: A Reply to Professor Breyer', 18 *UCLA Law Review* 1100 (1970-71) at 1108-1113.

³⁸ E.g., Lessig, L., 'Free Culture: How Big Media uses technology and the law to lock down culture and control creativity', Penguin Press, New York (2004), Vaidhyanathan, S., 'Copyrights and Copywrongs: The rise of Intellectual Property and how it threatens creativity', 2nd edition, New York University Press, New York, and Fisher, W., 'Promises to Keep', Stanford Law and Politics, Stanford (2004).

charge over the Internet without the authorisation of the right holder.³⁹ Likewise, remakes of cartoons such as ‘The Simpsons’ and ‘South Park’ are available over the file sharing networks, again not authorised by the right holder. What this serves to show is that there can be a distinction between financial rewards and creativity. Some authors may act out of a desire for economic reward, but this may not be the only factor.

Additionally, there is a line of US academic writing that stresses the importance of famous US works having built upon the works of others. It is often shown that today, such actions *could* constitute copyright infringement. Lawrence Lessig stresses the importance of the ‘*The Jazz Singer*,’ a 1928 film incorporating sound, and how the technique was copied into Walt Disney’s ‘*Steamboat Willie*.’ Likewise, he stresses ‘*Steamboat Willie*’ is a parody of ‘*Steamboat Bill, Jr.*’⁴⁰ Siva Vaidhyanathan in ‘Copyrights and Copywrongs’⁴¹ stresses the importance of Delta Blues music in the development of rock music, with specific reference to Led Zeppelin.⁴² There is also the wider issue of ‘cultural works,’ such as traditional folk music. Anthony McCann suggests that copyright law does not take into account the shared nature of the music.⁴³

Throughout the history of copyrightable works, there is a history of collaborative development.⁴⁴ This collaborative development is not always consistent with the level of protection given by copyright. In the examples given immediately above, today there would most likely be a breach of copyright. Whilst there may have been copyright issues at the time, this did not necessarily prevent the re-use. This paper argues that copyright law should consider these reuses rather than over emphasising the existing interests of right holders. Furthermore, these interests are based upon past and current financial considerations of right holders, rather than potential future right holders.

³⁹ Vaidhyanathan, S., ‘Copyrights and Copywrongs: The rise of Intellectual Property and how it threatens creativity’ *supra* 38 at 77-78.

⁴⁰ Lessig, L., ‘Free Culture: How Big Media uses technology and the law to lock down culture and control creativity’, *supra* 38 at p21-28.

⁴¹ Vaidhyanathan, S., ‘Copyrights and Copywrongs: The rise of Intellectual Property and how it threatens creativity’, *supra* 38.

⁴² Vaidhyanathan, S., ‘Copyrights and Copywrongs: The rise of Intellectual Property and how it threatens creativity’ *ibid.*, at 117-148.

⁴³ McCann, A., ‘Enclosure without and within the Commons’, 14 *Information and Communications Technology Law* 217 (2005).

⁴⁴ Lunsford, A. and Ede, L., ‘Collaborate Authorship and the teaching of writing’, 10 *Cardozo Arts and Entertainment Law Journal* 681 (1992), and the ‘Gowers Review’, HM Treasury, HMSO, London (2006) at 4.86

It would seem an important factor may be the adversarial nature of the legal system, in that a right holder brings an action against another party seeking recompense. However, that in itself does not explain why the legal system places so much emphasis on the right holder's business interests. Another factor could be the structuring of copyright, for which we need to examine the history of copyright law. Recent cases, especially those concerning the DMCA such as *Corley*⁴⁵ and *Reimerdes*,⁴⁶ utilise the protection of business interests as a key element of the balancing exercise. It is posited that this has arisen from a specific line of case law, but that an alternate approach could have developed which would not have placed such an emphasis upon the supposed conflict between right holders and content recipients. To substantiate this, it is suggested that one may turn to early UK case law to observe how an alternate approach could have been possible.

AN ALTERNATIVE APPROACH

Early UK case law relating to copyright was based around the Statute of Anne 1710. Before considering this in depth, it should be borne in mind that US and UK law has purportedly different aims. In the US, copyright law was 'To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.'⁴⁷ In the UK, from which US copyright derives many principles, it has been described as for 'the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, during the Times therein mentioned.'⁴⁸ Whilst the foundations of US and UK law are radically different – US law being based on the idealistic views of the founding fathers, UK law being essentially based around the history of the monopoly of the Stationers' Company – both have developed a notion of balancing.

⁴⁵ *Universal City Studios, Inc. v Corley* (2nd Circuit, 2001) *supra* 1.

⁴⁶ *Universal City Studios, Inc. v Reimerdes* (SDNY, 2000) *supra* 1.

⁴⁷ The United States Constitution, Article I Section 8.

⁴⁸ Statute of Anne 1710, 8 Anne Ch 19., the long title of which is 'An Act for the Encouragement of Learning, by vesting the Copies of Printed Books in the Authors or purchasers of such Copies, during the Times therein mentioned' (hereafter 'the Statute of Anne').

When observing the development of early UK case law, it can be seen that two distinct approaches to balancing developed. Where abridgement or translation had been an issue in proceedings, the Judges tended to focus on the potentially infringing work and whether this contained some element of ‘merit.’ On the other hand, if the case was an infringement proceeding where abridgement or translation was not an issue, then the focus was more narrowly on the degree of similarity. The latter approach was to become dominant, sidelining an approach that would have placed less emphasis on the business interests of right holders.

ABRIDGEMENTS AND TRANSLATIONS.

In the UK, it was only prior to the Copyright Act 1911⁴⁹ that abridgements and translations were not infringements of copyright *per se*. In 1721, Lord Macclesfield in *Burnett v Chetwood*⁵⁰ considered whether a translation of *Archaeologiae Philosophicae* was possible without infringing copyright held under the Statute of Anne. Lord Macclesfield argued ‘a translation might not be the same with the reprinting the original [sic], on account that the translator had bestowed his care and pains upon it, and so not within the prohibition of the Act.’⁵¹ The implication here was that, according to Kaplan (interpreting *Burnett*), ‘if the accused book was a work of authorship, it could not at the same time infringe.’⁵² In *Hawkesworth v Newbery*⁵³ Lord Chancellor Apsley discussed the potentially infringing work as being ‘in the nature of a new work,’⁵⁴ and he stated that an abridgement was ‘not an act of plagiarism upon the original work, nor against any property in it, but an allowable and meritorious work.’⁵⁵ As was noted in *Donaldson v Beckett*,⁵⁶ ‘abridgments [sic] of books, translations, notes, all effectively deprive the

⁴⁹ Copyright Act 1911, 1&2 Geo. V, c.46.

⁵⁰ *Burnett v Chetwood* (1721) *supra* 3.

⁵¹ *Burnett v Chetwood* *ibid.*, at 1009.

⁵² Kaplan, B., ‘An Unhurried View of Copyright’, *supra* 3 at 10. Note that Lord Macclesfield ultimately requests for the injunction on other grounds.

⁵³ *Hawkesworth v Newbery* (1774) *supra* 3.

⁵⁴ *Hawkesworth v Newbery* *ibid.*.

⁵⁵ *Hawkesworth v Newbery* *ibid.*, quoted in Deazley, R., ‘Rethinking Copyright: History, Theory, Language’, Edward Elgar, Oxford (2006) at 26 which in turn is quoting from Lofft, C., Reports of Cases adjudged in the Court of King’s Bench, 12 Geo. 3-14 Geo. 3, Owen, London (1776).

⁵⁶ The Hansard Report of *Donaldson v Beckett*, reported as ‘Proceedings in the Lords on the Question of Literary Property, 14 Geo III 1st Ser. 17 950 (1774).

original author of the fruit of his labours, as direct particular copies, yet they are allowable.’⁵⁷

However, there is an uncertainty apparent as to how to maintain that approach. In *Gyles v Wilcox*,⁵⁸ Lord Chancellor Hardwicke, having briefly referred to the stated aim of the Statute of Anne – “the encouragement of learning,”⁵⁹ began to shift away from the consideration of this aim. This he did initially by stating that the ‘...Act is not to be construed strictly, but according to the Intention of the Legislature: However, the intention must be formed from the words of the Statute.’⁶⁰ What that caused was a shift of focus – the question quickly became ‘Whether the second Book *has been the same* Book with the former?’⁶¹ namely whether the abridgement is ‘a Work of Judgment.’⁶²

Interestingly, in *Gyles*,⁶³ Lord Chancellor Hardwicke stated that he did not wish to become involved in issues of fact.⁶⁴ He leaves the issue of comparing the books to the Master. The structure of the judgment implied that he believed the proper place of the Judge is to consider the broader societal issues of copyright – namely, the ‘encouragement of learning,’ but he is hamstrung by the need to resolve the specific issue of infringement. Throughout his judgment, there is the sense of considerable unease present, as if he feels unable to discuss the societal implications of copyright because of the adversarial nature of the infringement action brought before him.⁶⁵

Whilst the approach in these abridgement cases was to place emphasis upon the ‘merit’ of the potentially infringing work, there is an underlying unease as to how to balance the interests of the author of the original work vis-à-vis the interests of the author of the

⁵⁷ The Hansard Report of *Donaldson v Beckett*, reported as ‘Proceedings in the Lords on the Question of Literary Property, *ibid.*, at 990, per Lord Chief Justice De Grey.

⁵⁸ *Gyles v Wilcox* (1741) *supra* 3.

⁵⁹ *Gyles v Wilcox ibid.* at 368.

⁶⁰ *Gyles v Wilcox ibid.*

⁶¹ *Gyles v Wilcox ibid.*, at 369.

⁶² *Gyles v Wilcox ibid.*

⁶³ *Gyles v Wilcox* (1741) *supra* 3.

⁶⁴ ‘Lord Chancellor said, that the best way was to leave all Matters in Difference to the Arbitration of those two Counsel, and if they should not be able to make an Award, that they then should have Liberty to choose an Umpire’ *Gyles v Wilcox, ibid.* at 370.

⁶⁵ ‘Whether the second Book is the same Book with the former is a Matter of Fact, and a Fact of Difficulty to be Determined. It is hard to say in what Manner the Court ought to determine this Fact; and his Lordship said he could not see how it could be determined but by reading both the Books over, and that it would be hardly proper for him to do....’ *Gyles v Wilcox, ibid.* at 370.

abridgement. This was enhanced by the fact that the approach towards balancing, where there was no abridgement, was quite different from where there was. In these cases, the balancing exercise was more to do with comparison of the works and damage to the original author, than the merit of the infringing work.

Ultimately, abridgements and translations continued to be treated differently until the Copyright Act 1911, which implemented UK obligations under the Berne Convention 1886.⁶⁶ There was a slight sea change occurring in certain cases of infringement which emphasised the author's proprietary interests, and these are discussed in the following section. Later cases such as *Dickens v Lee*⁶⁷, and *Tinsley v Lacy*⁶⁸ began to explicitly criticise the existence of the cases dealing with abridgements, simply because cases dealing with abridgements did not base themselves around protecting existing author's interests. The proprietary approach reached its most prominent form in a report by the 1875 UK Copyright Commission, who vociferously opposed the specific approach used for abridgements due to the harm that occurred to right holder's markets.⁶⁹ However, before considering this in detail, the history of the approach of courts towards infringement – the approach that became dominant - will be considered. The reasons for the decline of the approach based on the 'merit' of the potentially infringing work will be considered thereafter.

CASES HELD TO BE NOT INVOLVING ABRIDGEMENTS OR TRANSLATIONS.

The approach in cases not involving abridgements or translations was typically quite different from those that did. In contrast to *Burnett v Chetwood*,⁷⁰ or *Gyles v Wilcox*,⁷¹ the focus was considerably more upon the damage to the original right holder. For instance, in 1785, one such case was *Sayre v Moore*.⁷² The 'charts that had been copied

⁶⁶ Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, which was revised in Paris on July 24, 1971 and amended in 1979, S. Treaty Doc. No. 99-27 (1986) [The 1979 amended version does not appear in *UNTS* or *ILM*, but the 1971 Paris revision is available at 1161 *UNTS* 30 (1971)].

⁶⁷ *Dickens v Lee* (1844) 8 Jurist 183.

⁶⁸ *Tinsley v Lacy* (1863) 71 Eng Rep 327.

⁶⁹ De Zwart, M., 'A historical analysis of the birth of fair dealing and fair use: lessons for the digital age' [2007] IPQ 60 at 77; Nimmer, D., Silman, S., Skone James, E., Skone James, R. (eds), 'Copinger and Skone James on Copyright', 13th edition, Sweet and Maxwell, London (1991) at 1-39.

⁷⁰ *Burnett v Chetwood* (1721) *supra* 3.

⁷¹ *Gyles v Wilcox* (1741) *supra* 3.

⁷² *Sayre v Moore* (1785) *supra* 4.

were four in number, which Moore had made into one large map.’⁷³ Lord Mansfield declared in relation to an action for infringement in the copyright of a map that:

‘we must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded.’⁷⁴

In *Trusler v Murray*⁷⁵ reference is made to liability where 14 pages of an infringing book of chronology were reproduced in their entirety, and this was sufficient to make the defendant liable. A test that is more similar in nature to current copyright law was put forward in *Longman v Winchester*,⁷⁶ where Lord Chancellor Eldon stated that where there was an infringing publisher, ‘there is no doubt, that this Court would interpose to prevent a mere republication of a work, which the labour and skill of another person had supplied to the world.’⁷⁷ Although the same Lord Chancellor states one year later in *Wilkins v Aikin*⁷⁸ that ‘the question on the whole is, whether this is a legitimate use of the Plaintiff’s publication, in the fair exercise of a mental operation, deserving the character of the original work,’⁷⁹ it has to be stressed that this case has much discussion of what would today be considered issues of independent creation. The key point is that these cases of infringement mark a shift away from a focus on whether a copy is in some form ‘meritorious,’ and instead emphasise what has been reproduced. In the early case of *Burnett*,⁸⁰ a potentially infringing work could avoid liability provided an author ‘had bestowed his care and pains upon it.’⁸¹ This is in stark contrast to later cases such as *Sayre v Moore*.⁸²

⁷³ *Sayre v Moore* *ibid.*, at 360.

⁷⁴ *Sayre v Moore* *ibid.*, at 362.

⁷⁵ *Trusler v Murray* (1789) *supra* 4.

⁷⁶ *Longman v Winchester* (1809) *supra* 4.

⁷⁷ *Longman v Winchester* *ibid.*, at 269.

⁷⁸ *Wilkins v Aikin* (1810) 17 Ves Jun 422.

⁷⁹ *Wilkins v Aikin* *ibid.*, at 426.

⁸⁰ *Burnett v Chetwood* (1721) *supra* 3.

⁸¹ *Burnett v Chetwood* *ibid.*, at 1009.

⁸² *Sayre v Moore* (1785) *supra* 4.

THE RESULT.

The incompatibility of these two approaches was becoming increasingly clear. For instance in *Tinsley v Lacy*⁸³ of 1868, it was stated by Vice Chancellor Sir Page Wood that:

‘The authorities by which fair abridgements have been sanctioned have no application. The court has gone far enough in that direction; and it is difficult to acquiesce in the reason sometimes given, that the compiler of an abridgement is a benefactor to mankind, by assisting in the diffusion of knowledge.’⁸⁴

The approach of earlier courts focusing on the merit of the potentially infringing work simply did not sit well with the notion that the original author should be protected by copyright. Those cases involving abridgements and translations were much less commonplace than those that were not, and momentum was behind those who argued focus should be on the original author.⁸⁵ The consequence was that in 1878 the conflict was specifically addressed by the 1875 UK Copyright Commission:

‘At present an abridgement may or may not be an infringement of copyright, according to the use made of the original work and the extent to which the latter is merely copied into the abridgement. But even though an abridgement may be so framed as to escape being a piracy, still it is capable of doing great harm to the author of the work, by interfering with his market; and it is more likely to interfere with that market and injure the sale of the original work if, as is frequently the case, it bears in its title the name of the original author. We think this should be prevented; and upon the whole we recommend that no abridgements of

⁸³ *Tinsley v Lacy* (1863)71 Eng Rep 327.

⁸⁴ *Tinsley v Lacy* *ibid.*, at 330.

⁸⁵ Vaver, D., ‘Abridgments and Abstracts’, [1995] *European Intellectual Property Review* 225 at 227.

copyright works should be allowed during the term of copyright without the consent of the owner of the copyright.⁸⁶

With the passing of the Copyright Act 1911, abridgement was not mentioned under the heading of 'Fair Dealing'. That part of the Act sought to codify the existing common law. For the reasons given by the UK Copyright Commission, abridgement was subsumed within the broader rules of copyright infringement that ran under the reproduction right and to a lesser degree with the new adaptation rights.⁸⁷ The old approach of looking at the 'merit' of an infringing work had simply become sidelined by cases such as *Dickens*⁸⁸ and *Tinsley*⁸⁹ which emphasised the interests of the author of the original work. The result was that the focus of the balancing exercise centred even more upon the existing interests of a right holder.

THE US BALANCING EXERCISE: WHAT LED TO THE FOCUS ON THE RIGHTS HOLDER?

Early copyright law cases in the US have made reference to equivalent cases in the UK. In the seminal case of *Wheaton v Peters*⁹⁰ in 1834, the US Supreme Court referred to the case of *Donaldson v Beckett*⁹¹ in relation to its general findings⁹² and came to a consistent conclusion. Indeed, as with the UK, by turning to the history of copyright it is possible to find alternative approaches to balancing. Prior to the constitutional convention and Federal Copyright Act of 1790, there were a number of divergent approaches. Some State copyright Acts, such as those of Massachusetts and New Jersey, emphasised knowledge and learning, albeit by securing the author's rights. Five – Connecticut, South Carolina, North Carolina, Georgia and New York - even restricted the market prices of books as it was required 'for the encouragement of learning, that the inhabitants of this

⁸⁶ De Zwart, M., 'A historical analysis of the birth of fair dealing and fair use: lessons for the digital age' *supra* 69 at 77. A discussion of the issues here are also in Roberts, H., 'The Law of Abridgment of Copyrighted Literary Material', 30 *Kentucky Law Journal* 298 (1942).

⁸⁷ The relevant sections were under s1(2)(a), (b) and (c) of the Copyright Act 1911 which were brought together as adaptation under s2(5) and s.2(6)(a) Copyright Act 1956, De Zwart, M., 'A historical analysis of the birth of fair dealing and fair use: lessons for the digital age', *ibid.*, at 78.

⁸⁸ *Dickens v Lee* (1844) 8 Jurist 183.

⁸⁹ *Tinsley v Lacy supra* 83.

⁹⁰ *Wheaton v Peters* (Supreme Court, 1834) *supra* 2.

⁹¹ *Donaldson v Beckett supra* 56.

⁹² *Wheaton v Peters* (Supreme Court, 1834) *supra* 2 at 656, 656, 678, 686 and 690.

State be furnished with useful books, &c., at reasonable prices.’⁹³ The emphasis on learning is perhaps most prominent in the constitutional provision itself, where Patterson focuses on the contributions of Madison and Pinckney, both of whom in their submissions to the Constitutional Convention emphasised knowledge.⁹⁴

However, the focus shifts dramatically in the Federal Copyright Act 1790. Although, similar to the UK’s Statute of Anne in 1710, it begins with a title of ‘An Act for the Encouragement of Learning...’; s.2 of 1790 Act indicates that the purpose of the statute was to protect works from piracy. Patterson submits that the only explanation for such a change is ‘a confusion of ideas, and there is indication of such a confusion.’⁹⁵

Unlike *Gyles*⁹⁶ in the UK, the equivalent US case of *Folsom v Marsh*⁹⁷ (1841) focuses much more upon the market of the original work. This case also concerned abridgement. Justice Story stated that ‘we must often, in deciding questions of this sort, look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.’⁹⁸

These points of analysis were followed in subsequent case law⁹⁹ leading to what became the codification of Fair Use in §107 of the United States Code.¹⁰⁰ In the 1985 case of *Harper & Row v Nation Enterprises*,¹⁰¹ the US Supreme Court stated:

‘We agree with the Court of Appeals that copyright is intended to increase and not to impede the harvest of knowledge.’¹⁰²

⁹³ Patterson, L.R., ‘Copyright in Historical Perspective’ Vanderbilt University Press, Nashville (1968) at 189.

⁹⁴ Patterson, L.R., ‘Copyright in Historical Perspective’ *ibid.*, at 193.

⁹⁵ Patterson, L.R., ‘Copyright in Historical Perspective’ *ibid.*, at 200.

⁹⁶ *Gyles v Wilcox* (1741) *supra* 3.

⁹⁷ *Folsom v Marsh* (CCD Mass, 1841) *supra* 2.

⁹⁸ *Folsom v Marsh ibid.* at 348.

⁹⁹ Cohen, J.E., ‘Copyright in a global information economy’, Aspen Law & Business, New York (2002) at 493, noting that the term ‘Fair Use’ first arose in *Lawrence v Dana* 15 F Cas 26 at 60 (CCD Mass., 1869).

¹⁰⁰ 17 USC §107.

¹⁰¹ *Harper & Row v Nation Enterprises* 471 US 539 (Supreme Court, 1985).

¹⁰² *Harper & Row v Nation Enterprises ibid.*, at 545.

The Supreme Court focused upon its previous ruling in *Sony v Universal City Studios*,¹⁰³ but *Sony* emphasises the interests of the right holder. Despite the fact that *Sony* is often cited as a case which takes into account the wider public interest because it permits time shifting,¹⁰⁴ it is firmly rooted within the conflict between the parties. *Sony* may initially appear to consider wider social issues, but it is not as wide as, say, the UK case of *Gyles*.¹⁰⁵ It was said in *Sony*, in the Supreme Court, that

‘[This] limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after a limited period of exclusive control has expired.’¹⁰⁶

The statement may refer to the public interest, but that interest is met by limiting the granted period of protection. This should be compared to the UK’s *Gyles* case, which as mentioned above, questions whether a potentially infringing work is a ‘Work of Judgment,’¹⁰⁷ and furthermore, also discusses the potential meaning of the phrase ‘encouragement of learning’ as used in the Statute of Anne. *Gyles* considers the wider potential ‘educational’ impact of the new Act, which as explicitly noted by the Lord Chancellor, was *not* to be considered the same as protecting a Monopoly.¹⁰⁸ *Sony*, by contrast, focuses firstly upon a limited period of protection for right holders. This emphasis has led to insufficient consideration of the merit of potentially infringing works.

AN ASSUMPTION THAT PROTECTING THE INTERESTS OF RIGHT HOLDERS IS SYNONYMOUS WITH THE INTERESTS OF PUBLISHERS.

Having now established that there has been increasing emphasis upon existing works rather than the ‘merit’ of the potentially infringing work, focus should now turn to

¹⁰³ *Sony Corp. of America v Universal City Studios, Inc.*, (Supreme Court, 1984) *supra* 18.

¹⁰⁴ E.g. Lessig, L., ‘The Future of Ideas’, Random House, New York (2001) at 195; Biegel, S., ‘Beyond Our Control?’, MIT Press, Cambridge, Massachusetts (2001) at 297-301; statement only of the resulting rule - Litman, J., ‘Digital Copyright’, Prometheus Books, New York (2001) at 131.

¹⁰⁵ *Gyles v Wilcox* (1741) *supra* 3.

¹⁰⁶ *Sony Corp. of America v Universal City Studios, Inc.*, (Supreme Court, 1984) *supra* 18 at 429.

¹⁰⁷ *Gyles v Wilcox* (1741) *supra* 3 at 369.

¹⁰⁸ *Gyles v Wilcox* *ibid.*, at 368.

considering *why* the existing work has been of such importance. Why has the right holder been deemed so important – and who is the right holder?

Even in a case that considers the broader policy implication of copyright, such as *Millar v Taylor*,¹⁰⁹ parties directly representing the author were not present. As Kaplan notes, ‘The fact that publishers, not authors, were at bar, was passed over as usual.’¹¹⁰ The same was true in *Sayre v Moore*.¹¹¹ Lord Mansfield’s judgment states that ‘The [Statute of Anne] secures copy-right to authors and guards against the piracy of words and sentiments,’¹¹² but the case was brought by a plaintiff company who employed an individual whose work could have been infringed,¹¹³ and the defendant was also a publisher.¹¹⁴

This is of critical importance in infringement cases where the balancing exercise is comparing an earlier work to a later work. This is because these cases tend to emphasise the financial implications of permitting an infringement to continue. For instance, in *Sayre* it was stated that ‘...the plaintiffs had originally been at a great expense in procuring materials for those maps,’¹¹⁵ likewise in *Longman v Winchester*¹¹⁶ it was stated that ‘the latter publisher cannot on that account be justified in sparing himself the labour and expense of an actual survey.’¹¹⁷

IN THE UK: THE FOCUS ON THE PUBLISHER

Copyright law has to be seen within the context of previous laws concerning the Stationers’ Company’s Monopoly. The Stationers’ Company, from the sixteenth century through to the collapse of the Licensing Act in 1695, operated within a system of censorship in which the quasi official Stationers’ Company administered the publication of works. ‘Printing was confined to members of the Stationers’ Company and such others

¹⁰⁹ *Millar v Taylor* (1768) 98 Eng Rep 201.

¹¹⁰ Kaplan, B., ‘An Unhurried View of Copyright’ *supra* 3 at 13.

¹¹¹ *Sayre v Moore* (1785) *supra* 4.

¹¹² *Sayre v Moore* *ibid.*, at 361.

¹¹³ ‘Delarcohet, an eminent geographer and engraver, had been employed by the plaintiffs...’ *Sayre v Moore*, *ibid.*

¹¹⁴ ‘Winterfelt, an engraver, said he was actually employed by the defendants to take a draft of the Gulph Passage (in the West Indies) from the plaintiffs maps’ *Sayre v Moore*, *ibid.*

¹¹⁵ *Sayre v Moore*, *ibid.*

¹¹⁶ *Longman v Winchester* (1809) *supra* 4.

¹¹⁷ *Longman v Winchester* *ibid.*, at 271.

as might be authorized by the Queen.’¹¹⁸ The Stationers’ Company was, in some respects, the representative of the original author vis-à-vis the court system and the crown.

The Stationers’ Company and booksellers¹¹⁹ had suffered a serious blow with the failure to renew the Licensing Act. Due to a fall out of favour with Parliament,¹²⁰ the groups put their support behind the notion of the author. In a pamphlet published in 1707, the London booksellers emphasised the negative effect of disorder due to a lack of legal regulation, and the effect this would have on authors:

‘Many learned Men have spent much Time, and been at great Charges, in composing Books, who used to dispose of their Copies upon valuable Considerations, to be printed by the Purchasers...but of late Years such Properties have been much invaded, by other Persons printing the same Books...to the great Discouragement of Persons from writing Matters, that might be of great Use to the Publick, [sic] and to the great Damage of Proprietors.’¹²¹

After further political manoeuvrings, this ultimately paved the way for what was to become known as the Statute of Anne. Though the Statute of Anne referred to ‘Authors or Purchasers’,¹²² it soon became clear that the relationship between the two was

¹¹⁸ Kaplan, B., ‘An Unhurried View of Copyright’ *supra* 3 at 3, and also see Arber, E., (ed) ‘A transcript of the registers of the company of Stationers of London, 1554-1640, privately printed (volume I), London (1967) at xxxi (introduction).

¹¹⁹ It is prudent to explain why the description ‘book sellers’ is initially used, and later the description ‘publishers’. ‘The familiar three-part division of the modern book trade into publisher-wholesaler, printer, and retail bookseller (who might also be wholesalers and/or printers) remained normal during the last quarter of the eighteenth century, but syndicates tended to become smaller as their members gained in financial strength .. and around 1800 a few of the larger men .. began to publish on their own.’ Gaskell, P., ‘A New Introduction to Bibliography’, OUP, Oxford (1972) at 297.

¹²⁰ Deazley, R., ‘Rethinking Copyright: History, Theory, Language’, *supra* 55 at 1-2, Bowker, R., ‘Copyright: Its History and Law’, Houghton Mifflin and Company, Boston and New York (1912) at 22, Kaplan, B., ‘An Unhurried View of Copyright’ *supra* 3 at 89, Patterson, L.R., ‘Copyright in Historical Perspective’ *supra* 93 at 138-140 (without reference to the changing position of the House of Lords, who ultimately decided not to renew the Licensing Act following the lead of the House of Commons), Nimmer, D., Silman, S., Skone James, E., Skone James, R. (eds), ‘Copinger and Skone James on Copyright’, 13th edition, *supra* 69 at 1-29 and Rose, M., ‘Authors and Owners’, Harvard University Press, Massachusetts (1993) at 32-34.

¹²¹ ‘Craigie, John *et al.*, ‘Reports of Cases Decided in the House of Lords, upon Appeal from Scotland, from 1726 – 1822’, Edinburgh 1849-1943. 5 Vols.’ at 313, quoted by Rose, M., ‘Authors and Owners,’ *ibid.*, at 36, with the reference ‘CJ 15:313.’

¹²² As referred to in the long title, and s1 of the Statute of Anne 1710. For the original copy of the Act, see http://copyright-project.law.cam.ac.uk/cgi-bin/kleioc/0010/exec/showThumb/%22uk_1710%22/start/%22yes%22 last accessed on 19th January 2009.

insufficiently articulated. ‘Purchasers’ had put themselves behind the ideal of the ‘Author’, in the full knowledge that authors invariably assigned all their interests to the ‘Purchaser’.¹²³ As Feather states, ‘its most immediate effect was that it ensured the continued dominance of English publishing by a few London Firms, and their continued and ever increasing prosperity’,¹²⁴ and ‘to a large extent the act recognized the role of the company under existing common law (and like the Statute of Monopolies, in many ways codified existing practice).’¹²⁵ Furthermore, the Statute itself did not develop any distinctions between the author and publisher – it merely refers to ‘Authors or Purchasers’.¹²⁶ In many cases the financial damage to a publisher was equated to financial damage to an author.¹²⁷ Even in cases such as *Millar v Taylor*¹²⁸ there was no person specifically representing the interests of the author.¹²⁹

The failure to develop a distinction was a direct product of the historical period. It was common practice for authors to assign works to publishers.¹³⁰ Nor was it necessarily uncommon for authors to assign their works between one another - and for these assignments not to be mentioned within the work itself.¹³¹ It is therefore easy to see how the failure to make a distinction between Purchasers and Authors could have occurred. As we have seen, in infringement actions there has been a predominant trend to associate financial and business interests with creativity – in practice, to place an emphasis on the ‘Purchaser’ rather than the ‘Author’ – and this may be traced back to the Statute of Anne.

¹²³ Kaplan, B., ‘An Unhurried View of Copyright’ *supra* 3, at 8-9 ‘I think it nearer the truth to say that publishers saw the tactical advantage of putting forward authors’ interests together with their own, and this tactic produced some effect on the tone of the statute’.

¹²⁴ Feather, J., ‘The Book Trade in Politics’ 8 *Publishing History* 19 (1980) at 37. Note that Deazley, R., refutes this as ‘[Feather’s analysis does not take sufficient account of those features within the new legislation that conflicted with the interest of the established trade’ (Deazley, R., ‘On the Origin of the Right to Copy’, Hart Publishing, Oxford (2004) at 45). However, it cannot be denied that the London Booksellers retained a monopoly as a result of this act and had put their support behind the notion of the author, see Kaplan, B., ‘An Unhurried View of Copyright’, *ibid.*, Feather, J., at 36 and Deazley, R., ‘On the Origin of the Right to Copy’ at 44.

¹²⁵ May, C., and Sell, S., ‘Intellectual Property Rights: A critical history’, Lynne Rienner, London (2006) at 91.

¹²⁶ The Statute of Anne 1710, 8 Anne Ch 19.

¹²⁷ In relation to the situation in the US, Patterson puts it thus: ‘...because copyright was deemed to be wholly an author’s right, even though it was available as well to the publisher, the lawmakers did not make the necessary distinctions between the publisher’s interest and the author’s interest which would have enabled them to deal directly with the danger of monopoly’ Patterson, ‘Copyright in historical perspective’ *supra* 93at 217.

¹²⁸ *Millar v Taylor* (1768), *supra* 109.

¹²⁹ Kaplan, B., ‘An Unhurried View of Copyright’ *supra* 3 at 13 ‘(The fact that publishers, not authors, were at bar, was passed over in silence, as usual)’.

¹³⁰ Feather, J., ‘The Book Trade in Politics’ *supra* 124.

¹³¹ See Woodmansee, M., ‘On the author effect: Recovering collectivity’, 10 *Cardozo Arts and Entertainment Law Journal* 279 (1992) at 282-3.

THE POSITION IN THE US IN RELATION TO THE AUTHOR / PUBLISHER DIVIDE.

With regard to the United States, the title of the Copyright Act 1790 is similar to the Statute of Anne. It also fails to make the distinction between authors and publishers. As the long title states, this was an act:

‘... for the encouragement of learning, by securing the copies of maps, Charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.’¹³²

Patterson suggests that, in the US, this failure led to an emphasis upon the issue of duration of a copyright. He submits that the duration of copyright increased because the lawmakers ‘attempted to deal with ... [the problem of monopoly] ... indirectly, by limiting the author’s rights – an attempt which failed because the idea of the author’s natural rights led to an expansion of the monopoly of copyright.’¹³³ Patterson goes further and also writes:

‘The ignoring of the publisher’s interest in copyright led to the facile assumption that copyright was concerned with only two major interests, those of the author and the public. The fact that the publisher was ignored did not change the fact that copyright is concerned with three major interests, those of the author, the publisher, and the public.’¹³⁴

The end result is that there is an alignment of the interests of a publisher and the interests of the author. As an aside, it is useful to note that a similar issue has arisen in Canada. This is a strikingly clear example of how there can be a lack of enunciation in case law of the differing interests of the authors and publishers. Canada is a Commonwealth country, and it still often cites UK case law as persuasive authority. In *Théberge v Galerie d’Art du Petit Champlain*,¹³⁵ in the Supreme Court of Canada, Binnie J stated that ‘...the

¹³² Copyright Act 1790, 1 Stat. 124.

¹³³ Patterson, L.R., ‘Copyright in Historical Perspective’, *supra* 93 at 217.

¹³⁴ Patterson, L.R., ‘Copyright in Historical Perspective’, *ibid.*, at 216-217.

¹³⁵ *Théberge v Galerie d’Art du Petit Champlain* [2002] 2 SCR 336, 2002 SCC 34.

initial Copyright Act, 1709 (UK), 8 Ann., c. 21, was passed to assuage the concerns of printers, not authors.¹³⁶ However, the differing interests of printers and authors are not clarified. For instance, pages 23-24 interchangeably use the term ‘creator,’ ‘artists and authors’ and ‘holders of copyrights’ without clarification as to their differences. The following Canadian case, *CCH v Law Society of Upper Canada*,¹³⁷ (also of the Supreme Court of Canada) suffers from the same issue, for instance page 16 of that judgment quotes Binnie J in *Théberge* referring to creators, but then immediately refers to ‘owners and users’ as a way of expressing the copyright balance. Page 17 states that ‘the exceptions to copyright infringement [are] perhaps more properly understood as users’ rights.’¹³⁸ Notwithstanding this, the underlying distinction between a user, creator, and right holder is not clearly defined. As Scassa is hinting at, in reference to the judgment of Linden J.A. in *CCH*, ‘although user’s rights may be a shorthand for many of these interests, it is a shorthand which underplays the range and depth of interests.’¹³⁹ These approaches have serious implications for the copyright balancing exercise, since as outlined above, many cases over emphasise the financial interests of the originator of a work.

THE CONSEQUENCE OF COURTS NO LONGER PLACING SUCH EMPHASIS UPON THE MERIT OF THE POTENTIALLY INFRINGING WORK & CONCLUDING THOUGHTS.

The focus of courts on the existing interests of right holders has led to insufficient consideration that, with the Internet, ‘social interactions are turned into information exchanges on email, chats, and online portals’¹⁴⁰ – interactions that can lead to new thoughts (and by implication, new copyright works). Shneiderman stresses this throughout his work, ‘Leonardo’s Laptop.’¹⁴¹ He posits that many social functions, such as holding discussions and distributing photos, could become inhibited by not focusing on ‘human needs.’¹⁴² The development of technology permits more varied and widespread interactions between individuals. Individuals can utilise and build upon the

¹³⁶ *Théberge v Galerie d’Art du Petit Champlain* *ibid.*, at p.15.

¹³⁷ *CCH Canadian Ltd v Law Society of Upper Canada* [2004] 1 SCR 339, 2004 SCC 13, at p.16.

¹³⁸ *CCH Canadian Ltd v Law Society of Upper Canada* *ibid.*, at p.17.

¹³⁹ Scassa, T., ‘Interests in the Balance’, in Geist, M., ‘In the Public Interest’, Irwin Law, Ontario (2005) at 50

¹⁴⁰ *Chamberlain Group, Inc. v Skylink Technologies, Inc* *ibid.*, at 80.

¹⁴¹ Shneiderman, B., ‘Leonardo’s Laptop’, MIT Press, Massachusetts (2002).

¹⁴² Shneiderman, B., *ibid.*, at 76, Chapter 5 generally and for an exposition of the theory, 81, and 87-99.

works of other individuals in order to more accurately and easily express themselves. While it could be suggested that such social functions will still occur outside of the digital realm,¹⁴³ there are a number of reasons why the law should encourage more reuses of content, even if that content is currently protected by copyright. For instance, philosopher John Locke stressed that all knowledge is based on experience,¹⁴⁴ and the logical conclusion of this is that the more experience an individual can gain, the greater the extent of knowledge – ‘the memory is not always so clear as actual perception.’¹⁴⁵ Likewise, in terms of artists, especially musicians, we may refer to the use of Delta Blues music by Led Zeppelin; and of hip hop music sampling.¹⁴⁶ The Beastie Boys used sampling in their album ‘Paul’s Boutique’, as did Verve in ‘Bitter Sweet Symphony’. The Gowers Report points out, in rather strong terms, ‘ ‘Good artists borrow; great artists steal’ so said Pablo Picasso, borrowing from Igor Stravinsky, or perhaps from T.S. Elliot.’¹⁴⁷ The point is that taking what has gone before does not necessarily result in less creativity, even though there is potential for harm to occur to a right holder. If the law is to encourage such re-use, and to encourage the creation of knowledge that this may bring, it is imperative for the law to make a clear distinction between publishers and authors who may, by refashioning existing works, enter into competition with the publishers unless an appropriate legal framework is set out.

In relation to the historical development of copyright law, it was highlighted that early UK case law focused upon the ‘merit’ of the potentially infringing work. To reassert this approach within the modern context of copyright law could serve to limit the emphasis upon the interests of right holders, and lead to a clearer demarcation between right holders as assignees, and authors as assignors. By way of example, in relation to the Grokster network, it would have required much more emphasis upon the way in which the primary infringers (potential authors) were adding merit to existing copyright works owned by right holders. Such an approach could be mandated by legislation. Statute

¹⁴³ Shneiderman uses digital technology show how distributing photos could occur in the real world, but that digital technology could distribute them more quickly to more people, and permit distribution of those altered versions, Shneiderman, B., ‘Leonardo’s Laptop’ *supra* 141 at 96.

¹⁴⁴ Locke, J., ‘An Essay concerning human understanding’, Book II, Chapter 1 at §2.

¹⁴⁵ Locke, J., ‘An Essay concerning human understanding’, *ibid.*, Book IV, Chapter 1 at §9.

¹⁴⁶ Vaidhyanathan, S., ‘Copyrights and Copywrongs: The rise of Intellectual Property and how it threatens creativity’ *supra* 38 at 117-145; McLeod, K., ‘Freedom of Expression’, Doubleday, New York (2005) at 62-113.

¹⁴⁷ ‘Gowers Review’, *supra* 44 at p.67.

could lay down that courts must question the merit of a potentially infringing work, and to then consider this as part of the balance between right holders and authors before a finding of infringement is reached. A provision could be inserted into the US code requiring this, between 17 USC §106 and §107. This would encourage the courts to consider broader balancing issues.

The ‘merit’ criterion should also not just be limited in its application to primary copyright infringement. The principle could also be applied to secondary liability, by explicitly requiring it in 17 USC §107. In a case such as *Grokster*,¹⁴⁸ this might involve consideration of the merit of the Grokster network in the dissemination of either infringing yet meritorious works, or other non infringing works. Likewise, the court could consider other uses of the network – for instance, how the technology has fed into the development of VOIP and distributed computing. In *Grokster*, the Supreme Court would thus have been required to consider these factors vis-a-vis their finding of inducement of copyright infringement.

In utilising this ‘merit’ based approach, the current tendency of courts to focus on the existing interests of the right holder, with extremely limited consideration of whether this actually encourages new copyright works, will be reduced. No longer will the interests of the publisher or distributor simply be considered analogous to the interests of creators of new copyrightable works. The danger of the current approach is neatly summed up by Hughes:

‘Once we recognize that property is needed to motivate work for the public good, we may transform the reward into a right just as we often convert systematically granted benefits into rights deserved by the recipients. Perhaps we do this because it would be inconsistent and disconcerting to say that some systematically granted benefit is not deserved. Perhaps we just make the transition from instrumental to normative propositions through lack of attention. For example, in the 1954 case *Mazer v. Stein*, the Court said:

¹⁴⁸ *Metro-Golden-Meyer Studios, Inc v Grokster, Ltd.* (Supreme Court, 2005) *supra* 1.

‘The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors . . . Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.’

As *Mazer* demonstrates, it is strikingly easy to move from an instrumental discussion of consequences to an assumption of just rewards.¹⁴⁹

A system focusing more upon the ‘merit’ of the potentially infringing work, rather than one which emphasises the economic loss to the right holder, would be a move to rectifying this concern about the assumption of ‘just reward.’ It would thus break down the assumption that providing protection will increase the creative productivity of the populace. As the late Justice Laddie observed:

‘When these ghosts of the past stand in the path of justice clanking their mediaeval chains, the proper course is for the judge to pass through them undeterred’¹⁵⁰

¹⁴⁹ Hughes, J., ‘The Philosophy of Intellectual Property’ 77 *Georgetown Law Journal* 287 (1988) at 303.

¹⁵⁰ Laddie, H., ‘Copyright: Over-strength, over-regulated, over-rated?’ [1996] *EIPR* 253 at 260, quoting Lord Atkin in *Syndicate v Kleeman* [1941] AC 417.