

1990

Testimony: Joint Hearing on H.R. 4263 & S. 2370

Roger J. Miner '56

Follow this and additional works at: http://digitalcommons.nyls.edu/intellectual_prop



Part of the [Intellectual Property Law Commons](#)

Recommended Citation

Miner '56, Roger J., "Testimony: Joint Hearing on H.R. 4263 & S. 2370" (1990). *Intellectual Property*. 3.
http://digitalcommons.nyls.edu/intellectual_prop/3

This Article is brought to you for free and open access by the Speeches and Writings at DigitalCommons@NYLS. It has been accepted for inclusion in Intellectual Property by an authorized administrator of DigitalCommons@NYLS.

**SUMMARY OF STATEMENT OF HON. ROGER J. MINER
TO BE SUBMITTED AT JOINT HEARING ON JULY 11, 1990**

The addition of the words "whether published or unpublished" to section 107 of Title 17, the "fair use" statute, is unnecessary, if intended to permit fair use of unpublished material; incompatible with the existing statute, if intended to afford equal dignity to published and unpublished matter; and ineffective to resolve the policy concerns articulated by the sponsors. The amendment is unnecessary if its only purpose is to permit fair use of unpublished material. The present statute allows the fair use of any copyrighted work, although the nature of the work is one of the fair use factors to be considered. The other factors are purpose and character of the use; the amount and substantiality of the portions used; and the effect of the use upon the potential market. No court ever has said that unpublished material cannot be the subject of fair use.

Read in the context of section 107 as it stands, the amendment appears to be intended to raise unpublished material to the level of published material in the application of fair use doctrine. If this is the intention of the amendment, then the amendment is inconsistent with the fair use factor just referred to, the nature of the work. This factor tells us that there is an important distinction between published and unpublished works, and the courts have offered far less fair use protection to unpublished works. The important reason for the distinction lies in the right of an author to control the first public appearance of his or her work. Even in its present form, the statute allows fair use of an unpublished work stolen from an author. The amendment indicates no disapproval of such a use.

The concerns of the sponsors relate to the stringent restrictions imposed by the courts on the use of unpublished material by historians, researchers and biographers. An examination of court decisions reveals that the unpublished nature of a work has been a key factor in defeating fair use claims. The recently-ratified Berne Convention seems to set up another barrier against the fair use of unpublished material. Nevertheless, there seems to be no reason to allow the heirs of historical figures long departed to forestall the use of material created generations earlier but recently discovered by a scholar conducting research in some remote archive. The solution to that problem does not lie in this bill.

I propose a solution that is compatible with the provisions of the Berne Convention, that would eliminate the difficulties encountered by courts in deciding fair use claims involving unpublished works, and that would accommodate the needs of scholars to gain access to material of historical and public interest. I would limit fair use to published and publicly disseminated material. I would define publicly disseminated material to include any letters sent without a requirement of confidentiality and any documents, including letters, that have been in existence for a certain period of years without having been copyrighted. For the rest, I would rely on the freedom of access to facts and ideas contained in the undissemated material. In this way, the balance between the rights of authors and the rights of society would be maintained.

PREPARED STATEMENT OF HON. ROGER J. MINER
UNITED STATES CIRCUIT JUDGE
UNITED STATES COURT OF APPEALS
SECOND CIRCUIT, TO BE PRESENTED AT A JOINT HEARING
OF THE HOUSE SUBCOMMITTEE ON COURTS,
INTELLECTUAL PROPERTY, AND THE ADMINISTRATION
OF JUSTICE, THE SENATE SUBCOMMITTEE
ON PATENTS, COPYRIGHTS AND TRADEMARKS AND
THE SENATE SUBCOMMITTEE ON THE CONSTITUTION

WEDNESDAY, JULY 11, 1990

I am happy to accept your invitation to comment on H.R. 4263 and S. 2370, identical bills providing for the amendment of section 107 of Title 17 of the United States Code, the "fair use" statute. The amendment merely would add the words "whether published or unpublished" following the phrase "fair use of a copyrighted work." The bills are driven by concerns arising from recent court decisions said to unduly restrict the use of unpublished, copyrighted material. I am the author of one of those decisions. One sponsor has expressed the hope that the proposed legislation will "forestall the adoption of a broad and inflexible rule against fair use of unpublished material."

The perception here seems to be that there is a court-fueled trend toward depriving scholars and historical researchers of the use of letters, diaries and other unpublished writings vital to their work. According to the House sponsor, the "amendment would clarify that section 107 applies equally to unpublished as well as published works." If that is its purpose, it is inconsistent with the unamended portion of section 107. I respectfully suggest, moreover, that the fair use doctrine cannot and should not be applied to published and unpublished material equally. I think that the statement should be amended to limit fair use to published and publicly disseminated works, a proposal advanced in my article: Exploiting Stolen Text: Fair Use or Foul Play in the October 1989 issue of the Journal of the Copyright Society of the U.S.A. With an appropriate definition of "publicly disseminated" added to the statute, the concerns of the sponsors would be allayed, the purposes of the fair use doctrine would be fulfilled, and societal interests would be served.

It is important first to examine what fair use is and what it is not. Fair use, known as fair abridgement in early English law, permits the limited use of a copyrighted work without liability for infringement of the copyright. It has been characterized as an equitable rule of reason and is necessary for such purposes as criticism, comment, news reporting, teaching, scholarship and research. Fair use is not a doctrine to be invoked in order to gain access to facts and ideas embodied in copyrighted work, because the protection of copyright does not

extend to facts and ideas. It extends only to expression. There thus is struck, in the words of the Supreme Court, "a definitional balance between the First Amendment and the Copyright Act." Fair use, then, is a limited right to use the expression of another. Whether a use is fair is largely committed to the judgment of the courts, broadly guided by the factors set out in section 107 of Title 17.

I suggest that the proposed amendment to section 107 bears close examination in light of the second fair use factor, which remains undisturbed by the amendment. That factor, the nature of the copyrighted work, requires the courts to take into account whether the work is published or unpublished. History and precedent tell us that the scope of fair use is narrower in the case of an unpublished copyrighted work than it is in the case of a published copyrighted work. The amendment seems to offer equal dignity to both types of works and therefore is inconsistent with the present application of the fair use doctrine. One can only guess at the confusion that would be engendered by the co-existence of these incompatible provisions.

If the purpose of the bill is simply to assure that fair use can be made of unpublished copyrighted material, it is unnecessary. Fair use of unpublished material already is permitted. Section 107 allows the fair use of any copyrighted work although, as previously noted, the nature of the work is a factor to be considered by the courts in applying the doctrine. Also to be considered, of course, are the other three statutory factors: the purpose and character of the use, the amount and substantiality of the portions used, and the effect of the use upon the potential market.

There is some indication in the legislative history of section 107 of an intention to restate existing fair use doctrine and not to change it in any respect. A persuasive case can be made that the then existing doctrine prohibited the fair use of unpublished but not voluntarily disseminated works. The statute as enacted did not make the distinction, leaving it to the courts to weigh the unpublished nature of the work in the fair use balance. For good reason, the courts have chosen to afford far less fair use protection to those who use unpublished material than to those who use published material. It is, after all, an author's right to control the first public appearance of his or her work. An author must have the right to refine, revise and discard a work prior to publication. The ability of an author to withhold a work from public dissemination just as long as he or she deems it proper to do so implicates notions of privacy, freedom to refrain from speaking and control of material. At bottom here is a substantial property interest.

Essential to an understanding of the effect of the proposed amendment is the fact that the unpublished material for which a claim of fair use is made sometimes is stolen material. In Harper & Row v. Nation Enterprises, the leading case on fair use, the Supreme Court spoke of the exploitation of a "purloined manuscript," the manuscript being the memoirs of President Gerald Ford. In Salinger v. Random House, the biographer gained access to certain letters written by J.D. Salinger lodged in a library by promising not to copy them. New Era Publications v. Henry Holt and Co. involved the use of the writings of L. Ron Hubbard apparently acquired from the Church of Scientology by misappropriation or conversion. There is nothing in the present statute or in the cases interpreting it to indicate that purloined material cannot be the subject of fair use. That the exploited text is stolen simply is not a factor to be considered in applying the fair use doctrine under section 107 as it stands. The amendment proposed, which seeks only to elevate the status of unpublished material, does nothing to rectify this situation and actually exacerbates it.

The concerns of historians and researchers in regard to the stringent restrictions on the use of unpublished material is understandable. It is especially understandable to me, because my wife is an historian who has undertaken considerable original research. Although no court has said that unpublished material never can be the subject of fair use, it is clear that the unpublished nature of a work is a key factor in defeating a fair use claim. It makes no sense, however, to allow the heirs of historical figures long departed to forestall, by the simple expedient of obtaining a copyright, the use of material created generations earlier and discovered in some remote archive by a scholar researching original sources. The solution to the problem thus posed is not, in my view, to elevate unpublished works to equal standing with published works in the fair use analysis. As I have demonstrated, such an approach would encourage the use of purloined material, deprive authors of important rights and encroach upon interests that should be protected. Moreover, the recently-ratified Berne Convention seems to exclude the use of unpublished material altogether. It allows only "quotations from a work which already has been made available to the public, provided that their making is compatible with fair practice."

I propose a solution that is compatible with the provisions of the Berne Convention, that would eliminate the difficulties encountered by courts in deciding fair use claims involving unpublished works, and that would accommodate the needs of scholars to gain access to material of historical and public interest. I would limit fair use to published and publicly disseminated material. I would define publicly disseminated

material to include any letters sent without a requirement of confidentiality and any documents, including letters, that have been in existence for a certain period of years without having been copyrighted. For the rest, I would rely on the freedom of access to facts and ideas contained in the undisseminated material. In this way, the balance between the rights of authors and the rights of society would be maintained.

It always should be remembered, as the Supreme Court has reminded us, that "[b]y establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas." It also should be recognized that strict application of the copyright law could defeat incremental progress, to the detriment of the public good. The fair use doctrine was designed to avoid that result.

ROGER J. MINER
Circuit Judge
United States Court of Appeals
Second Circuit

Albany Chambers:

U.S. Courthouse
Box 858
Albany, New York 12201
Telephone: (518) 472-2480

New York City Chambers:

U.S. Courthouse, Room 426
Foley Square
New York, New York 10007
Telephone: (212) 791-9108

EXPERIENCE:

Judge, U.S. Court of Appeals, Second Circuit (1985-present);
Judge, U.S. District Court, Northern District of New York
(1981-1985);
Justice, New York State Supreme Court, Third Judicial
District (1976-1981);
District Attorney, Columbia County (1968-1975);
Assistant District Attorney, Columbia County (1964);
Corporation Counsel, City of Hudson (1961-1964);
Partner, Miner & Miner, Hudson, New York (1959-1975);
Adjunct Professor of Law, New York Law School (1986-present);
Lecturer, State University of New York at Albany,
Graduate Program in Court Systems Management (1985);
Adjunct Associate Professor, Faculty of Criminal Justice,
Columbia Greene Community College, State University
System (1974-1979);
Lecturer, New York State and local Bar Associations;
Trial and Appellate Moot Court Judge for various law schools
and U.S. Attorney General's Advocacy Institute;
Lecturer, Education Programs for local police agencies.

EDUCATION:

New York Law School -- LL.B. cum laude, 1956
Managing Editor, Law Review
Moot Court Team
Nathaniel L. Goldstein Award for
Excellence in Constitutional Law
Law Forum Association Award
Emory University Law & Economics Institute for Federal Judges;
Judge Advocate General's School, University of Virginia (military
law program); Brooklyn Law School (Graduate Studies); Columbia
College; State University of New York (B.S.).

MILITARY SERVICE:

U.S. Army (1956-1959) -- First Lieutenant, Judge Advocate
General's Corps; Active duty in Japan and Korea;
Commendation Medal; Honorably discharged from Army Reserve
in 1964 with rank of Captain, JAGC.

BAR ADMISSIONS:

New York (1956); U.S. Court of Military Appeals (1956); Republic of Korea (1958); U.S. District Courts, Southern and Eastern Districts of New York (1959).

AWARDS & HONORS:

LL.D Syracuse University; LL.D. New York Law School; Charles W. Froessel Award for Valuable Contribution to the Law; New York Law School Alumni Association -- Distinguished Alumnus Award; New York Law School Dean's Medal for Distinguished Professional Service; New York Law School Law Review -- Dedication of 30th Volume (30 N.Y.L. Sch. L. Rev. 693 (1985)); Albany Jewish Federation Award; Columbia County Man of the Year 1984; Abraham Lincoln Award; Outstanding Elk Award; Kiwanis Award for Community Service; Rotary Club, Police Officers, and County Magistrates Awards; Who's Who in American Law; Who's Who in America.

OFFICIAL COMMITTEES:

Judicial Conference of the United States, Committee on Federal-State Jurisdiction; Chairman, State/Federal Judicial Council of New York; Second Circuit Committee on the Bicentennial of the United States Constitution; Chairman, Second Circuit Historical Committee; Chairman, Subcommittee on the 100th Anniversary of the United States Court of Appeals, Second Circuit; Northern District Historical Committee (1981-1985).

PROFESSIONAL ORGANIZATIONS:

American Law Institute; American Bar Association; New York State Bar Association; American Judicature Society; American Society of Writers on Legal Subjects (Scribes); Federal Judges Association; Federal Bar Council; Association of Trial Lawyers of America; Association of the Bar of the City of New York; Columbia County Bar Association; New York Supreme Court Justices Association (1976-1981); Association of Trial Judges, Third Judicial District (1979-1981); New York District Attorneys Association (1968-1975); National District Attorneys Association (former member); President, Albany Law School American Inn of Court (1987-1988); New York State Trial Lawyers Association; Columbia County Magistrates Association.

OTHER ORGANIZATIONS:

Supreme Court Historical Society; Columbia County Historical Society; New York Law School Alumni Association (honorary director); United Way of Columbia County (former director); Isaiah Lodge B'nai B'rith; Congregation Anshe Emeth; Temple Israel; Hudson Lodge of Elks (past exalted ruler); National Lawyers Club.

PUBLICATIONS:

- "Exploiting Stolen Text: Fair Use or Foul Play," 37 J. Copyright Soc'y 1 (1989), reprinted in AIPLA Bull. 37 (Oct.-Nov. 1989);
- "Confronting the Communication Crisis in the Legal Profession," 34 N.Y.L. Sch. L. Rev. 1 (1989);
- "Appellate Practice in the United States Court of Appeals for the Second Circuit," N.Y. St. B.A. Comm. on Continuing L. Educ., Appellate Practice Coursebook (Fall 1989, Fall 1988);
- "The Consequences of Federalizing Criminal Law," 4 Crim. Just. 16 (Spring 1989) (ABA Journal of the Section of Criminal Justice);
- "Federal Criminal Appellate Practice in the Second Circuit," N.Y. St. B.A. Comm. on Continuing L. Educ., Federal Court Practice Coursebook (Spring, 1989, Spring 1988);
- "Lawyers Owe One Another," Nat'l L.J., Dec. 19, 1988, at 13, col. 1;
- "The Don'ts of Oral Argument," 14 Litigation 3 (Summer 1988) (ABA Journal of the Section of Litigation);
- "The Tensions of a Dual Court System and Some Prescriptions for Relief," 51 Alb. L. Rev. 151 (1987) (11th Annual Lewis H. Case Memorial Lecture);
- "Should Lawyers be More Critical of Courts?," Judicature 134 (1987), reprinted in Trial, May 1988, at 82 & Case & Comment, May-June 1988, at 40;
- "Federal Courts, Federal Crimes, and Federalism," 10 Harv. J.L. & Pub. Pol'y 117 (1987);
- "Preemptive Strikes on State Autonomy: The Role of Congress," 99 The Heritage Lectures (1987);
- "Federal Civil Appellate Practice in the Second Circuit," N.Y. St. B.A. Comm. on Continuing L. Educ., Federal Court Practice Coursebook (Spring 1987);
- "Federal Courts at the Crossroads," 4 Const. Commentary 251 (1987);
- "Research in Judicial Administration: A Judge's Perspective," 12 Just. Syst. J. 8 (1987);
- "Trials and Federal Rules of Evidence," N.Y. St. B.A. Comm. on Continuing L. Educ., Federal Court Practice Coursebook (Spring 1986);
- "Victims and Witnesses: New Concerns in the Criminal Justice System," 30 N.Y.L. Sch. L. Rev. 757 (1985);
- "A Judge's Advice to Today's Law Graduates," N.Y. St. B.J., Nov. 1985, at 6;
- "The United States District Court for the Northern District of New York -- Its History and Antecedents," Federal Bar Council, Second Circuit Redbook (Supp. 1984-1985);
- Book Review, N.Y. St. B.J., July 1984, at 47 (reviewing The Remarkable Hands (M. Nelson ed. 1983));
- "Handling the Social Security Disability Case -- The View from the Bench," N.Y. St. B.A. Comm. on Continuing L. Educ., Federal Court Practice Coursebook (Winter 1983);
- "Magistrates as Defendants in Federal Court," The Magistrate, Winter 1982, at 11.