

# Copyright Fair Use From 1841 to 2021: What It Means for Copyright Protections Versus Free Speech Exceptions

By Sara Gold



Sara Gold is an associate attorney at Eastman IP, an intellectual property prosecution and litigation firm in Southern California. This article is dedicated to her father, Dr. Corey Gold, who modeled excellence and always supported her in her personal and intellectual pursuits. He will be dearly missed.

Congress has the power to recognize exclusive copyrights under Article I of the Constitution. But under the First Amendment to the Constitution, Congress shall make no law abridging the freedom of speech. To reconcile these two oppositional constitutional rights, there exists the doctrine of copyright fair use, under which certain unauthorized uses of copyrighted material, those that are considered to have redeeming societal value, are not punishable under copyright law.

Under the Copyright Act, fair use is determined by balancing the following four factors: (1) the purpose and nature of the defendant's use; (2) the nature of the copyrighted work; (3) the amount and substantiality of the copied portion of the copyrighted work; and (4) the effect of the defendant's use on the potential market for the copyrighted work.<sup>1</sup>

Nowadays, courts routinely refer to fair use as an "affirmative defense" to copyright infringement and accordingly place the burden of proof for each of the four factors on the defendant. However, from its inception, fair use was not always postured as the defendant's burden to prove, showing how its current classification as an affirmative defense is far from self-evident.

Given the inherent unpredictability of the multi-factored fair-use calculus, the allocation of the burden of proof has significant practical implications for expression and creativity. For example, the placement of the burden affects whether defendants are reasonably likely to be able to defend fair uses, particularly at summary judgment when there is limited evidence on both sides. This, in turn, affects creators' risk assessment as to whether to engage in arguably fair uses to begin with.

The 1967 House Report that is often cited as the basis for labeling fair use as an affirmative defense states that "it would be undesirable to adopt a special rule placing the burden of proof on one side or the other."<sup>2</sup> But contrary to this principle, the current affirmative defense of fair use inherently places the burden on the

putative copyright infringer to show that the balance of the four fair-use factors shows fair use. On the other hand, making the absence of fair use part of the plaintiff's prima facie case of infringement, and thus requiring copyright plaintiffs to wholly disprove fair use to prevail, creates the same problem of favoring one party over the other—when both copyright protection and free speech are important to protect. The history and language of the Copyright Act shows that the burden of production for the fair-use factors is more flexible than commonly believed. As this "At Sidebar" discusses, a shifting of the typical burden of production could achieve a more equal balance between the interests of copyright holders and creative users.

## History of Copyright Fair Use

While U.S. copyright law has its roots in the English common law dating back to the 1700s, Justice Joseph Story's decision in *Folsom v. Marsh* in 1841 is widely regarded as the first U.S. copyright decision addressing fair use.<sup>3</sup> In *Marsh*, Justice Story evaluated whether the defendant was entitled to republish letters written by the late George Washington that had already been published in the plaintiff's anthology.<sup>4</sup> Although the term "fair use" was not used, Justice Story outlined the precursor to the present-day fair-use factors and stated these were relevant to the "question of piracy," that is, the determination of whether "the substance of one work has been copied from another."<sup>5</sup> Subsequent decisions in the 1800s and 1900s continued to regard the fair-use inquiry as definitional to infringement rather than as a separate defense required to be proven by the defendant.<sup>6</sup> Later scholars have interpreted these decisions to suggest that common-law fair use was originally intended as "part and parcel with the criteria for determining infringement" rather than as an affirmative defense to be proven by the defendant.<sup>7</sup>

Copyright fair use was rarely referred to as an "affirmative defense" prior to the passage of the modern Copyright Act in 1976. Fair use appears to have been

first referred to as an “affirmative defense” to copyright infringement in the late 1960s. Even then, the first reported federal decision that briefly referred to fair use as an “affirmative defense” also characterized fair uses as “outside the limits of copyright protection,” which more closely aligns with the interpretation of fair use as a definitional limitation on infringement rather than as a true affirmative defense.<sup>8</sup>

Concurrent with the passage of the modern Copyright Act, the House of Representatives issued a report stating that the Act was intended “to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way.”<sup>9</sup> Significantly, the Copyright Act itself does not label fair use as an affirmative defense; rather, it provides that the fair use of a copyrighted work is “not an infringement” of copyright.<sup>10</sup> Based on this statutory language and the preceding history, a “growing chorus of scholars” interpret the statute as indicating that the absence of fair use is an element that the plaintiff must prove as part of its *prima facie* showing of infringement.<sup>11</sup>

Regardless, fair use has become widely regarded as an affirmative defense in modern copyright law, which seems reasonable given that a defendant must raise fair use in response to infringement allegations. The U.S. Supreme Court first referred to fair use as an affirmative defense in 1985 and then expressly stated in its famous 1994 *Campbell* fair-use decision that the proponent of fair use bears the burden of proof for this affirmative defense.<sup>12</sup> As a result, federal courts steadfastly continue to regard fair use as an affirmative defense and place the burdens of persuasion and production for all factors on the defendant.<sup>13</sup>

### Issues With Fair Use as an Affirmative Defense

Although posturing fair use as an affirmative defense is rational in some ways, there are some resulting problems. Some scholars lament how placing the burden of proof on the defendant makes it unduly challenging and expensive for defendants to defend their fair uses in court.<sup>14</sup> The affirmative defense status is especially influential in summary judgment proceedings, where fair-use issues are very often decided.<sup>15</sup>

The fourth fair-use factor is especially burdensome because it requires the defendant to show that it has *not* unreasonably encroached on the plaintiff’s “potential market” for the copyrighted work.<sup>16</sup> As the plaintiff’s potential market is inevitably abstract, a key evidentiary issue is determining the scope of the plaintiff’s “traditional, reasonable, or likely to be developed markets.”<sup>17</sup> Currently, defendants must prove that these potential markets do *not* include the accused work, which is essentially trying to prove a negative.<sup>18</sup> Critics point out that proving such a negative is nearly impossible and that in most cases, the plaintiff is in the best position to produce evidence relating to its own potential markets.<sup>19</sup> Courts acknowledge that in the absence of compelling evidence on this factor, often regarded as the most outcome-determinative fair-use factor, the defendant is unlikely to be able to succeed.<sup>20</sup>

The few judicial attempts to reallocate the burden of production for this factor to offset the above-discussed difficulties have received mixed reactions from reviewing courts. In *Cambridge University Press v. Patton*, the lower court—while still recognizing the defendant’s ultimate burden of persuasion—placed the burden of production on the plaintiff to show that digital licenses for the copyrighted works were reasonably available.<sup>21</sup> The Eleventh Circuit Court of Appeals affirmed, holding that such reallocation was appropriate because “Plaintiffs—as publishers—can reasonably

be expected to have the evidence as to availability of licenses for their own works.”<sup>22</sup> Likening the reallocation to the burden-shifting paradigm in employment discrimination litigation, the court noted that the defendant would still have the burden of persuasion on remand to show no market harm in response to any evidence produced by the plaintiff of a potential market.<sup>23</sup>

The Ninth Circuit Court of Appeals ruled oppositely in the recent high-profile *Dr. Seuss Enterprises v. ComicMix LLC* case. Here, the lower court granted summary judgment to the defendant on its fair-use defense, partly on the basis that the *plaintiff* had failed to produce evidence sufficient to show by preponderance of the evidence that the accused work was likely to “substantially” harm the market for the original Dr. Seuss book.<sup>24</sup> The Ninth Circuit Court of Appeals overturned the decision.<sup>25</sup> Noting that “the Supreme Court and our circuit have unequivocally placed the burden of proof on the proponent of the affirmative fair use defense,” the Ninth Circuit called the lower court’s burden-shifting erroneous and reversed summary judgment.<sup>26</sup>

Although the Ninth Circuit Court of Appeals correctly noted that the lower court’s burden-shifting contradicted precedent, the sensibility of adopting some sort of burden-shifting in this context cannot be ignored. So that neither copyright nor free speech is considered more important than the other in the context of fair use, perhaps courts could utilize a burden-shifting scheme at summary judgment resembling the *McDonnell Douglas* framework that applies to employment discrimination claims, as suggested by the Eleventh Circuit.

### The Possible Solution: Adopting a Burden-Shifting Scheme to Equalize the Playing Field

One way of equalizing the burden would be to shift the burden of production for the second and fourth factors to the plaintiff at summary judgment, leaving the burden of production for the first and third factors with the defendant. Under this scheme, the plaintiff’s showing of *prima facie* infringement would trigger the defendant’s obligation to set forth “*prima facie* fair use” based on factors one and three under Section 107. Thus, to show “*prima facie* fair use,” the defendant would need to initially show that the purpose and character of the accused work (factor one), combined with the amount and substantiality of the portion used in relation to the copyrighted work (factor three), embodies fair use. These are the two factors that directly relate to the defendant’s work and, therefore, the defendant logically should have more of an ability to weigh in on them at the summary judgment stage.

If the court does not believe the defendant has shown “*prima facie* fair use,” the court cannot grant summary judgment in the defendant’s favor, though the defendant may still be able to prove fair use later at trial. However, if the defendant can show “*prima facie* fair use,” the burden of production shifts to the plaintiff to produce evidence tending to show that the nature of the copyrighted work (factor two) and/or the effect of the accused work on the plaintiff’s potential market (factor four) make the defendant’s use unfair. These two factors directly relate to the plaintiff’s work, and, therefore, the plaintiff is in the best position to weigh in on them at summary judgment, particularly the market harm factor.

If the plaintiff cannot produce evidence on either factor, these factors would become neutral and weigh neither for nor against the defendant, placing greater weight on the defendant’s *prima facie* fair-

use case. This would solve the present problem of the defendant being penalized at summary judgment for failure to produce evidence on market harm when, as discussed above, the plaintiff typically has the greater ability to produce such evidence.<sup>27</sup>

Like under *McDonnell Douglas*, the ultimate burden of persuasion would remain with the defendant to show that the totality of the factors favors fair use in accordance with fair use's traditional status as an affirmative defense.<sup>28</sup> However, shifting the burden of production for the fourth factor to the plaintiff would hopefully eliminate the problem of defendants failing to prevail due to inability to show that their work would have *no* harmful effect on the copyrighted work's potential market—particularly given that such a truth is difficult to prove in the negative.

But to ensure that plaintiff copyright holders are not unduly disadvantaged by bearing the burden of production for the market harm factor, courts should employ a relatively expansive interpretation of what the “potential market” for the copyrighted work might consist of. “Traditional, reasonable, or likely to be developed markets” should consist of the full universe of the copyright owner's untapped potential markets, even if the copyright owner has not personally entered those markets, in order to preserve the copyright owner's traditional choice of which markets to exploit.<sup>29</sup> Underscoring this principle, the Supreme Court has stated that fair use disfavors practices that, while perhaps not substantially harmful in isolation, would have an adverse aggregate effect on the plaintiff's potential markets were these practices to become widespread.<sup>30</sup> Any potential disadvantage to defendants of applying an overbroad scope of the plaintiff's potential markets should be offset by the placement of the burden of production on the plaintiff to produce evidence of the existence of and harm to said markets.

Ultimately, the text of the Copyright Act does not mandate that the burden of production or persuasion be placed on any particular party. Therefore, absent an amendment to the Copyright Act instituting a burden of production shift, greater awareness around this option could perhaps persuade more courts and judges to utilize their discretion to implement such burden-shifting to further the interests of justice.<sup>31</sup> Ultimately, the goal of a burden-shifting scheme would be to recognize that the rights of copyright holders and the rights of creative users are equally important in the abstract, such that no one party should bear an unduly disproportionate burden in defending its own right, either of copyright or of fair use. ☺

## Endnotes

<sup>1</sup>17 U.S.C. § 107.

<sup>2</sup>Lydia Pallas Loren, *Fair Use: An Affirmative Defense?* 90 WASH. L. REV. 685, 700 (2015) (citing H.R. REP. NO. 90-83, at 37 (1967)).

<sup>3</sup>Ned Snow, *The Forgotten Right of Fair Use*, 62 CASE W. RES. L. REV. 135, 144-47 (2011).

<sup>4</sup>The Court ultimately found infringement. *Folsom v. Marsh*, 9 F. Cas. 342, 349 (C.C.D. Mass. 1841) (No. 4901).

<sup>5</sup>*Id.* at 344.

<sup>6</sup>Snow, *supra* note 3, at 148-49. Ironically, an 1847 copyright case citing Justice Story's rationale was premised on the alleged infringement of one of Justice Story's own treatises. The Court found that the defendant had infringed Justice Story's copyright by copying portions of the treatise verbatim. *See Story v. Holcombe*, 23 F. Cas. 171, 175 (C.C.D. Ohio 1847) (No. 13497).

<sup>7</sup>Snow, *supra* note 3, at 147. *See also id.* at 146 (“Throughout *Folsom*

*v. Marsh*, Justice Story set forth principles that guide today's fair-use doctrine as inquiries that determine infringement.”); Loren, *supra* note 2, at 702.

<sup>8</sup>*See Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 132, 144 (S.D.N.Y. 1968).

<sup>9</sup>Amanda Reid, *Deciding Fair Use*, 2019 MICH. ST. L. REV. 601, 609 (2019) (citing H.R. REP. NO. 94-1476, at 66 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5680).

<sup>10</sup>17 U.S.C. § 107.

<sup>11</sup>Reid, *supra* note 9, at 617-18; Loren, *supra* note 2, at 698 (“If fair use is ‘not an infringement,’ then the plaintiff has not met its burden to demonstrate a prima facie case of *infringement* without overcoming the argument that the use is a fair use.”) (italics in original); Shyamkrishna Balganes, *Copyright As Market Prospect*, 166 U. PA. L. REV. 443, 498-99 (2018) (noting that labelling fair use as an affirmative defense “sits somewhat oddly with the plain language of the copyright statute”); Snow, *supra* note 3, at 163.

<sup>12</sup>*Harper & Row, Publishers v. Nation Enters.*, 471 U.S. 539, 561 (1985); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994).

<sup>13</sup>*E.g., Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179, 1191 (Fed. Cir. 2018) (no fair use); *Brammer v. Violent Hues Prods., LLC*, 922 F.3d 255, 262 (4th Cir. 2019) (no fair use); *Fox News Network, LLC v. TVEyes, Inc.*, 883 F.3d 169, 176 (2d Cir. 2018) (no fair use).

<sup>14</sup>*Cf. Reid, supra* note 9, at 616; Haochen Sun, *Copyright and Responsibility*, 4 HARV. J. SPORTS & ENT. L. 263, 312 (2013).

<sup>15</sup>David Nimmer, *Juries and the Development of Fair Use Standards*, 31 HARV. J. OF L. & TECH. 563, 567 (2018).

<sup>16</sup>17 U.S.C. § 107(4).

<sup>17</sup>*Ringgold v. Black Ent. TV, Inc.*, 126 F.3d 70, 81 (2d Cir. 1997); *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1179 (9th Cir. 2013).

<sup>18</sup>Matthew Africa, *The Misuse of Licensing Evidence in Fair Use Analysis: New Technologies, New Markets, and the Courts*, 88 CAL. L. REV. 1145, 1178 (2000).

<sup>19</sup>*Id.*; Loren, *supra* note 2, at 707; Sun, *supra* note 14, at 312 (“The burden of proving the absence of market harm is troublesome for users, as it is not easy for them to obtain data about copyright holders' market and examine the market impact of their uses on copyright holders.”).

<sup>20</sup>Sun, *supra* note 14, at 312 & n.185; Reid, *supra* note 9, at 616 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994) (“Since fair use is an affirmative defense, its proponent would have difficulty carrying the burden of demonstrating fair use without favorable evidence about relevant markets.”)).

<sup>21</sup>*Cambridge Univ. Press v. Becker*, 863 F. Supp. 2d 1190, 1237 (N.D. Ga. 2012).

<sup>22</sup>*Cambridge Univ. Press v. Becker*, 769 F.3d 1232, 1279 (11th Cir. 2014). *See also, e.g., Red Label Music Publ'g, Inc. v. Chila Prods.*, 388 F. Supp. 3d 975, 987 (N.D. Ill. 2019) (Seventh Circuit district court following *Cambridge*).

<sup>23</sup>*Cambridge*, 769 F.3d at 1279-80.

<sup>24</sup>*Dr. Seuss Enters., L.P. v. ComicMix LLC*, 372 F. Supp. 3d 1101, 1120-22 (S.D. Cal. 2019).

<sup>25</sup>*Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 458-60 (9th Cir. 2020).

<sup>26</sup>*Id.* at 458-60, 463.

<sup>27</sup>Courts citing *Campbell v. Acuff-Rose Music* tend to rule that a silent record regarding market harm militates this factor against fair use.

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international law documents should not be diminished. Rather, to remain a part of the “civilized world” we must adhere to the ideals proclaimed in these important documents. ☉

## Endnotes

<sup>1</sup>85 Fed. Reg. 80274 (Dec. 11, 2020).

<sup>2</sup>*Pangea Legal Servs., et al. v. DHS, et al.*, Case No. 20-cv-09253-JD (N.D. Cal. 2021).

<sup>3</sup>See THE BIDEN’S ADMINISTRATION’S ENFORCEMENT PRIORITIES: BACKGROUND AND LEGAL CONSIDERATIONS (2021), <https://crsreports.congress.gov>.

<sup>4</sup>Memorandum From Acting Secretary Pekoske, Review of and Interim Revision to Civil Immigration Enforcement and Removal Policies and Priorities (Jan. 20, 2021), [https://www.dhs.gov/sites/default/files/publications/21\\_0120\\_enforcement-memo\\_signed.pdf](https://www.dhs.gov/sites/default/files/publications/21_0120_enforcement-memo_signed.pdf).  
<sup>5</sup>27 I&N Dec. 316 (A.G. 2018). In *Diaz-Reynoso v. Barr*, No. 18-72833, 2020 WL 4557855 (9th Cir. Aug. 7, 2020), where the Guatemalan petitioner applied for withholding of removal because she had been persecuted by her partner on account of her membership in the particular social group “indigenous women in Guatemala who are unable to leave their relationship,” a Ninth Circuit panel held that *Matter of A-B-* does not categorically bar the granting of domestic-violence-based asylum claims. The court explained how “despite the general and descriptive observations set forth in the opinion, *Matter of A-B-* did not announce a new categorical exception to withholding of removal for victims of domestic violence or other private criminal activity, but rather it reaffirmed the Board’s existing framework for analyzing the cognizability of particular social groups, requiring that such determinations be individualized and conducted on a case-by-case basis.” *Id.* The court held that in *Matter of A-B-*, the attorney general barred any mention of the harm feared in the proposed social

group, did not better define the issue of circularity, and simply stated that a particular social group must exist independently of the harm asserted. Also, in *De Pena-Paniagua v. Barr*, 957 F.3d 88, 94 (1st Cir. 2020), the First Circuit held there is no categorical rule precluding asylum or withholding of removal applicants from establishing membership in a particular social group defined in material part as women “unable to leave” a domestic relationship.

<sup>6</sup>THE BIDEN’S ADMINISTRATION’S ENFORCEMENT PRIORITIES, *supra* note 3.

<sup>7</sup>Convention Relating to Status of Refugees, July 28, 1951, 19 U.S.T. 6259, 189 U.N.T.S. 150 (entered into force Apr. 22, 1954).

<sup>8</sup>Protocol Relating to the Status of Refugees, Jan. 31, 1967, 19 U.S.T. 6223, 606 U.N.T.S. 267 (entered into force Oct. 4, 1967).

<sup>9</sup>Refugee Act of 1980, Pub. L. 96-212, 94 Stat. 102 (1980).

<sup>10</sup>UNITED NATIONS HIGH COMMISSIONER FOR REFUGEES, HANDBOOK ON PROCEDURES AND CRITERIA FOR DETERMINING REFUGEE STATUS UNDER THE 1951 CONVENTION AND THE 1967 PROTOCOL RELATING TO THE STATUS OF REFUGEES (Feb. 2019), <https://www.unhcr.org/en-us/publications/legal/5ddfdcd47/handbook-procedures-criteria-determining-refugee-status-under-1951-convention.html>.

<sup>11</sup>Convention against Torture and Other Cruel, Inhuman or Degrading Treatment or Punishment, Dec. 10, 1984, 1465 U.N.T.S. 85 (enacted into U.S. law on Oct. 21, 1998, through the FY 1999 Omnibus Consolidated and Emergency Supplemental Appropriations Act, Pub. L. 105-277, 112 Stat. 2681-822, 105th Cong. 2d Sess. (1998)).

<sup>12</sup>8 U.S.C. § 1158(a)(2)(B).

<sup>13</sup>8 U.S.C. § 1231(b)(3).

<sup>14</sup>8 U.S.C. § 1158(b)(2).

<sup>15</sup>8 C.F.R. § 208.18(a)(7).

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See, e.g., *Viper Nurburgring Record LLC v. Robbins Motor Co.*, No. 5:18-cv-04025, 2019 U.S. Dist. LEXIS 152931, at \*27-28 (D. Kan. Sept. 9, 2019). See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 594 (1994) (“[I]t is impossible to deal with the fourth factor except by recognizing that a silent record on an important factor bearing on fair use disentitled the proponent of the defense . . . to summary judgment.”); cf. *Seuss Enters., L.P. v. ComicMix LLC*, 256 F. Supp. 3d 1099, 1109 (S.D. Cal. 2017) (defendant’s motion to dismiss based on fair use denied where first and fourth factors were “in equipoise”).

<sup>28</sup>Keeping the ultimate burden of persuasion with the defendant makes sense in order to avoid the “danger of the plaintiff not being able to capture the full value of his or her work if forced to face weak or even frivolous defenses that would coerce him or her to settle disputes.” Shifting the burden of persuasion to the plaintiff, on the other hand, could “reduce the potency of the property right as it would render it difficult to defend in practice against a multitude of trespassers.” Apostolos G. Chronopoulos, *Strict Liability and Negligence in Copyright Law: Fair Use as a Regulation of Activity Levels*, 97 NEB. L. REV. 384, 408-09 (2018). But see Loren, *supra* note 2, at 708 (commenting that “[t]he need to shift the burden of production is an indication that the burden of persuasion has not been properly allocated”).

<sup>29</sup>See Brief of the Copyright Alliance as Amicus Curiae Supporting

Petitioner at 13-15, *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443 (9th Cir. 2020) (No. 19-55348).

<sup>30</sup>*Harper & Row, Publs. v. Nation Enters.*, 471 U.S. 539, 568 (1985) (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984)); *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 613 (2d Cir. 2006); *VHT, Inc. v. Zillow Grp., Inc.*, 918 F.3d 723, 744 (9th Cir. 2019). See also Matthew Sag, *Copyright and Copy-Reliant Technology*, 103 NW. U. L. REV. 1607, 1653 (2009) (“The aggregation of any harm that is likely to result from widespread use is relevant in evaluating the fourth factor.”).

<sup>31</sup>See Chronopoulos, *supra* note 28, at 409-10.