

Entertainment, Arts and Sports Law Journal

A publication of the Entertainment, Arts and Sports Law Section of the New York State Bar Association

Remarks from the Chair



2002 has been an exciting and groundbreaking year for the Entertainment, Arts and Sports Law Section, and I am pleased as Chair to be able to report some of our accomplishments and to highlight what 2003 holds in store for us.

In our last issue, I reported that we were exploring a relationship with Volunteer

Lawyers for the Arts. Spearheaded by **Elissa Hecker** and **Elisabeth Wolfe**, we have moved forward with this relationship and the early results are excellent. In September, we participated in an EASL/VLA clinic, during which many of our Executive Committee members worked over the course of four hours at VLA advising pro bono clients. Because of the success of this clinic, we intend to organize more of them in the future and open the opportunity to all of our Section’s members.

Currently our Membership Chair, Elisabeth, has also accepted my appointment to serve as our Section’s first Pro Bono Chair. Elisabeth’s recent position with

Musicians On Call is representative of her commitment to public interest law and the assistance of artists and entertainers, and I cannot think of a better candidate to launch this position. Speaking of membership, thanks to a number of Elisabeth’s initiatives as well as the outstanding quality of our programs, *Journal* and Web site, our Section recorded the largest increase in membership over the past year of all sections in the New York State Bar Association except the Young Lawyers. Our last issue of the *Journal* listed all of our newest members, many of whom I hope to meet at upcoming events.

On the subject of events, in just a few months, we will be hosting our Section’s biggest event in years. Members may recall that in our last issue of the *Journal*, I mentioned that we were planning to revive our Section retreat. Due to various scheduling issues, we decided to push the retreat back from last fall to this coming spring. We will be holding the retreat on Friday evening, March 28th, and Saturday, March 29th, in Westchester, which will be a CLE program designed to earn members between 6 and 8 credits. I think it will be a terrific opportunity not only for members to stay current on their areas of practice, but also to meet each other in a

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social setting. We are also working on securing a limited number of partial scholarships for student members. Any interested students should monitor our Web site for further information.

Jay Flemma and **Kenneth Nick** have been chairing this effort, and I encourage members to check our Web site, www.nyeasl.org, for further details. We hope to see many of you there!

Among recent programs our committees have held was one entitled, "Fighting Back: Defensive and Offensive Techniques of Protecting Intellectual Property in Digital Format," hosted by **Jay Kogan** and his Literary Works and Related Rights Committee. Gary Millin of MediaForce Inc. discussed and demonstrated various technological measures and techniques that intellectual property owners can use to detect and prevent unauthorized distribution of digital content, music, software, games, images and movies.

This program provided a wonderful preview of our Annual Meeting program that will focus on digital rights. While many of you will perhaps read this while you are at the Annual Meeting in January 2003, as I write this, **Kenny Nick** and **Ayala Deutsch** are in the early planning stages of what promises to be a very exciting program on a cutting-edge area of the law that

impacts virtually all of the disciplines that make up our Section.

Along with Elisabeth, Kenny has really hit the ground running in his first year on our Executive Committee. Kenny is not only working on our Annual Meeting and Spring Retreat in his capacity as Program Chair, but he also recently hosted a program entitled, "Representing the Entertainer, Artist and Athlete: Everything You Need to Know to Completely Serve Your Client," in which the panelists had a comprehensive discussion of the various roles of being an agent. The speakers focused on the numerous tasks of representatives beyond contract negotiation, including the need to provide or to seek out third-party advice and assistance in areas such as trusts and estates, financial planning, marketing and commercial endorsements.

Finally, law students should be sure to read the details about our Phil Cowan Memorial Scholarship elsewhere in this issue and on our Web site. Given our large number of student members who have actively participated in our events, we are eager to receive what are sure to be a number of quality submissions and to award the first recipient of this scholarship.

I look forward to seeing you soon!

Jeffrey A. Rosenthal



2003 New York State Bar Association Annual Meeting

January 21-25, 2003
New York Marriott Marquis

ENTERTAINMENT, ARTS AND SPORTS LAW
SECTION MEETING

Friday, January 24, 2003

Editor's Note

Creation of the Pro Bono Committee

In addition to all of the varied and interesting submissions that are published in this issue of the *Journal*, we are pleased to highlight the creation of the EASL Section's newest Committee on Pro Bono. It is the goal of this Committee to engage EASL members in opportunities that will enrich the entertainment, arts and sports law communities. Please contact Elisabeth Wolfe at elk-wolfe@aol.com or me at ehecker@harryfox.com if you are interested in joining the Pro Bono Committee.



This initiative is unique, as it grants students the opportunity to *be published and gain exposure* in these highly competitive areas of practice. The *Journal* is among the profession's foremost law journals, thanks to the quality of its submissions. Both the *Journal* and the Web site have wide distribution, as the EASL Section boasts almost 2,000 members nationwide.

To submit an article, please contact me at ehecker@harryfox.com. The next deadline is Thursday, January 30, 2003.

As always, I encourage letters to the Editor and submissions of articles. Please feel free to contact me with any ideas you may have.

Elissa D. Hecker

Law Student Initiative

This issue of the *Journal* is also launching a new initiative that will give law students a chance to publish articles in a special section that will appear in the *Journal* and on our Web site.

The initiative is designed to bridge the gap between students and the entertainment, arts and sports law communities and shed light on students' diverse perspectives in these practice areas.

Law school students who have interest in entertainment, arts or sports law are invited to submit articles. Free membership to the EASL Section will be offered to those students whose articles are accepted for publication.

Elissa D. Hecker is Associate Counsel to The Harry Fox Agency, Inc., licensing subsidiary of The National Music Publishers' Association, Inc., where she is involved with legal, educational and policy matters concerning the world's largest music rights organization and the U.S. music publishing industry trade group. Ms. Hecker is the Vice-Chair of the EASL Section. In addition to membership in the NYSBA, Ms. Hecker is also a member of The Copyright Society of the U.S.A., Chair of the FACE Initiative children's Web site, a member of the Steering Committee of the FACE Initiative and a member of other bar associations.

REQUEST FOR ARTICLES

If you have written an article, or have an idea for one, please contact

Entertainment, Arts and Sports Law Journal Editor
Elissa D. Hecker, Esq.
The Harry Fox Agency, Inc.
711 3rd Avenue
New York, NY 10017
ehecker@harryfox.com

Articles should be submitted on a 3-1/2" floppy disk, preferably in Microsoft Word or WordPerfect, along with a printed original and biographical information.

EASL Makes a Difference in the Community

In the wake of September 11th, it has been refreshing to see firsthand how enthusiastically lawyers in New York have accepted their ethical obligation to provide free services to those in need in the community. However, due to recent funding cuts and government-imposed program restrictions, pro bono efforts are needed now more than ever.

That is why the EASL Executive Committee has decided to take the initiative to promote pro bono work as a Section. After exploring New York-based organizations in the entertainment, arts and sports law fields, the EASL Executive Committee is pleased to announce a collaborative arrangement with Volunteer Lawyers for the Arts (VLA). VLA has been helping artists and arts organizations with their arts and entertainment related legal issues for nearly 30 years.

EASL kicked off our collaboration with VLA on September 25, 2002, when members of the EASL Executive Committee and others recaptured some of the idealism that first drew many of them to the law. Latching onto the notion of community service, EASL Executive Committee members volunteered to counsel artists at a clinic co-sponsored by VLA.

The free clinic provided an opportunity for VLA members to seek advice on their arts-related legal issues. EASL volunteers worked at the clinic from 4 p.m. to 8 p.m. and were matched with clients who were individual artists or arts organizations for half-hour sessions. Fourteen attorneys volunteered throughout the evening, nineteen clients were served and eighteen issues relating to contracts, intellectual property and nonprofit organizations were resolved.

"Spending just a few hours really opened my eyes to what service is all about!" commented volunteer Susannah Sweeney of Stroock Stroock & Lavan. "Seeing the clients smile reminded me why I went to law school in the first place!" Volunteering time provided EASL members with such a sense of personal satisfaction that two more EASL clinics are slated for February 12 and May 14, 2003.

All clinics will be held from 4 p.m. to 7 p.m. at Volunteer Lawyers for the Arts, 1 East 53rd Street, 6th floor. For more information about the EASL/VLA Clinic or to sign up, e-mail Elisabeth Koller Wolfe at elkwolfe@aol.com or Elissa Hecker at hecker@harryfox.com.

Special thanks to the following EASL volunteers who took time out of their busy schedules and devoted time to this event:

Alan Barson
Joshua Bressler
Ayala Deutsch
Lisa Fantino
Jay Flemma
Elissa Hecker
Daniel Marotta
Steve Rodner
Stanley Rothenberg
Susannah Sweeney
Kenneth Swezey
Elisabeth Wolfe

ABOUT VLA PROGRAMS

Our relationship with VLA provides mutual benefits for our Section members. In addition to the opportunity to make a positive impact in the community, EASL Section members will receive the following:

- Discounts to the following CLE classes:
 - Music Licensing Basics
 - Legal Issues in the Music Industry
 - Talent Contract Basics for Film
 - Sports Licensing Basics
 - Legal Issues in the Sports Industry
 - Legal Issues in the Film Industry
 - Trademark Basics
 - Managers in the Arts and Entertainment Industry
- Private career counseling: VLA's Executive Director and senior staff attorneys schedule appointments with members for private career counseling and to review resumes in order to chart and guide members on their desired career paths.
- Discount to VLA's MediateArt Program, an intensive, basic mediation training for artists, arts administrators, attorneys and other professionals with an interest or background in the arts or in intellectual property.

For more information about VLA, please contact Heather Beggs at hbeggs@vlany.org.

EASL Membership Update

By Elisabeth K. Wolfe

As Membership Chair of the EASL Section, I am pleased to announce that this year we had a 14 percent increase in membership! This surge is not surprising, given the fabulous benefits of membership. Members in good standing have access to a variety of valuable resources and benefits designed to keep practitioners updated on the latest developments in the entertainment, arts and sports law fields. Among the many services offered are:

Subscription to the *EASL Journal*. Our Section *Journal* is published three times a year and is full of insightful articles, overviews of issues, and summaries of important cases and decisions that impact our areas of practice. If you are interested in submitting an article to the *EASL Journal*, please contact Elissa Hecker, Editor, at ehecker@harryfox.com.

Access to the EASL Web site, www.nyeasl.org. Our Section Web site features a wealth of information, including a calendar of Section programs, past issues of the *EASL Journal*, membership information, industry news, recent decisions of note and a collection of Internet links to other sites of interest to Section members. The *EASL Journal*, industry news and recent case law are all in a searchable format.

Invitations to exceptional meetings and educational events. You are invited to attend and participate in lunches, panels, talks and meetings, most of which are CLE accredited.

Networking opportunities. You have the opportunity to serve on a wide variety of Section committees, helping you gain valuable professional development and experience.

Our committees are:

- Broadcasting and Cable
- Copyright and Trademark
- Fine Arts

- Legislation
- Literary Works and Related Rights
- Litigation
- Membership
- Motion Pictures
- Music and Recording Industry
- New Technologies
- Pro Bono
- Professional Sports
- Programs
- Rights of Publicity, Privacy and Merchandising
- Theater and Performing Arts
- Young Entertainment Lawyers.

Access to some of the most prominent attorneys in the fields of entertainment, arts and sports law. You have the ability to meet and discuss issues with some of the most highly regarded attorneys in our fields.

Impact legislation. You have a voice in legislative matters under discussion in Albany.

Please visit www.nyeasl.org for more information about the Section, its committees and calendar of events. Please bear in mind that only members of the NYSBA may access the password-protected areas of the Web site.

If you would like more information about our Section activities or ways in which you could become more involved, please feel free to contact me at elkwolfe@aol.com.

Thanks for your support!

Elisabeth K. Wolfe
Membership Chair

**Next *EASL Journal*
Deadline:
Thursday, January 30, 2003**

Up and Running: The Phil Cowan Memorial Scholarship

EASL is pleased to announce that The New York Bar Foundation has approved the creation of a restricted fund for contributions to The Phil Cowan Memorial Scholarship. The Scholarship of \$2,500 will be awarded on an annual basis in Phil Cowan's memory to a law student who is committed to the practice concentrating in one or more of the fields of entertainment, art or sports law.

Eligible Recipients. The recipient of the \$2,500 Scholarship will be selected each year through a writing competition. The writing competition is open to all first- and second-year law students who are members in good standing of the EASL Section and who attend a law school anywhere in New York State, Rutgers University Law School (Newark and Camden campuses) or Seton Hall Law School.

The Competition. Each Scholarship candidate must write an original paper on a legal issue of current interest in the area of entertainment, art or sports law. The paper should be twelve to fifteen pages in length, double-spaced and including footnotes, in *Bluebook* form. The papers should be submitted to designated faculty members of each respective law school. All law schools will screen the papers and submit the three best to the EASL's Phil Cowan Memorial Scholarship Committee. The Committee will read the submitted papers and will make the ultimate decision as to the Scholarship recipient.

Deadlines. All students must submit their papers to their respective law schools for consideration no later than April 30 of each year. The screening faculty at each respective law school must submit the top three papers to the EASL's Scholarship Committee by June 1 of such year. The Scholarship Committee will determine the winner by October 31, and the winner will be

announced, and the Scholarship awarded, at the Annual Meeting, which will take place the following January.

The Scholarship Committee and Prerogatives. The Scholarship Committee is composed of all former Chairs and the current Chair of the EASL Section. Each winning paper will be published in the *EASL Journal* and will be made available to EASL members on the EASL Web site. The Scholarship Committee reserves the right to submit all papers it receives to the *EASL Journal* for publication and to the EASL Web site. The Scholarship Committee also reserves the right *not* to award a Scholarship if it determines, in any given year, that no paper submitted was sufficiently deserving. All rights of dissemination of the papers by EASL are non-exclusive.

Payment of Monies. Payment of Scholarship funds will be made by EASL directly to the law school of the winner, to be credited to the winner's account.

Donations. The Phil Cowan Memorial Scholarship fund is pleased to accept donations. The donations are tax-deductible. All donations should be by check, and be made payable to **The New York Bar Foundation**. Each donation should indicate that it is designated for The Phil Cowan Memorial Scholarship. **All donations should be forward to The New York Bar Foundation, One Elk Street, Albany, New York 12207, Attention: Kris O'Brien, Director of Finance.**

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National Geographic Copyright Cases: Lack of Paperwork Can Bite You Decades Later

By Joel L. Hecker

The failure to reduce an agreement to writing can have ramifications years, even decades, later. As practicing attorneys we all have had clients who have completed deals, assignments or jobs with minimal or no paperwork.

We also have known situations where detailed negotiations ensue, but are overtaken by events such as completion of performance by one side or the other or both, before the paperwork is completed or signed with the result that the final contracts are never completed or executed. They remain simple reminders of what should have been.

This lack of closure can occur as a result of one or more parties moving on to seemingly more pressing business, the desire not to incur additional legal fees, just forgetfulness, the failure to resolve issues concerning future events, or simple inertia. Whatever the reason, as two recent United States District Court decisions, *Faulkner v. National Geographical Society*¹ and *Ward v. National Geographical Society*,² can attest, it can be a very costly error.

Facts

The cases concern ownership of rights to photographs and articles created prior to 1978. Therefore, the works are governed by the 1909 Copyright Act and not the 1976 Copyright Act, which became effective on January 1, 1978. The court was faced with issues of ownership and licensing where often no or insufficient written agreements regarding usage rights were made and where custom and usage was relied upon (which we know is difficult to prove), all governed by an Act of Congress which was superseded over 24 years ago!³

Each plaintiff is a professional photographer and/or writer who claims to have granted to the National Geographic Society (NGS) over the years limited rights to publish various works in or as part of particular stories in the original print version of NGS's *National Geographic Magazine*. They allege that NGS republished plaintiffs' works beyond the rights granted, chiefly in electronic media, in CD-ROM and DVD formats. A subsidiary of NGS entered into an agreement with Mindscape Inc. whereby Mindscape would manufacture, market and distribute CD-ROM products created by NGS, including a digital archive of all past issues of *National Geographic Magazine* from 1888 to 1996, with yearly updates. The products were produced by scan-

ning a copy of each page of each issue of the magazine exactly as it had appeared in print. The products also included a multimedia component and computer storage repository retrieval system for the images. Mindscape was to pay royalties to NGS's subsidiary on sales of the products.

The Analysis

The court, in essence, broke the stories down into three groups.⁴

Proper and Complete Paperwork

The first and simplest concerned one where the defendants conceded that Ward's photograph of John F. Kennedy in the Oval Office was not created as a Work For Hire, and that Ward owned a valid copyright to it. Since Judge Kaplan determined that the defendants' other defenses failed as a matter of law, the court granted summary judgment to the plaintiff on this use. In this instance, the paperwork was clear and the obvious intent of the parties was properly reduced in writing, resulting in the preservation of the plaintiff's rights.

"Some" Paperwork

The second group basically concerned oral understandings and a course of conduct during these years. Judge Kaplan explored the Work For Hire doctrine under the 1909 Copyright Act as well as the doctrine of Implied Contracts. Importantly for the plaintiffs, he determined that an implied-in-fact contract may be based upon industry custom. However, he also determined that NGS had sufficiently established that it owned the copyrights at issue under the doctrine of Work For Hire, since NGS had met the instance and expense requirements of the then-prevailing law. That is, the work was created while the plaintiff was an employee, since the commissioning party could supervise or control the work, and paid for it. To overcome this determination, the plaintiffs were required to raise a genuine issue of fact regarding the existence of an express or implied agreement to the contrary. Since there was no express agreement (that would have been too easy), the Court said that the plaintiffs would have to prove by industry custom that photographers and writers in fact only granted limited rights during the period, while retaining the ownership of the copyrights.

The determination of what the industry custom was and whether plaintiffs could meet their burden of proof

turned to a great extent on the written evidence (sparse as it was). The court found that for some of the stories the plaintiffs had indeed met their burden, at least for purposes of creating a genuine issue of fact sufficient to defeat a summary judgment motion. The court cited to written evidence in the form of letters that may have established or confirmed acts inconsistent with NGS being the owner of the copyrights, such as reserving certain rights to the photographer or paying the photographer for subsequent use of the photographs in question. A copyright owner, the court said, would presumably not have to grant such rights or make such payments if it already owned all rights.

Thus, the existence of at least some paper trail permitted their claims to survive until trial. Whether this paper trail turns out to be sufficient on the ultimate issues at trial is altogether another matter.

Little or No Paperwork

On the other hand, on other stories, the court found that the plaintiffs failed to meet their burden and presented no proof sufficient to establish an implied contract where they retained ownership of the copyrights. For example, an admission that in 1973 NGS imposed upon freelance photographers the requirement that NGS retain all rights resulted in defeating one plaintiff's attempt to use the same industry custom argument to establish such an implied contract.

Summary

The court granted summary judgment to defendants on those stories where the plaintiffs were unable to establish either their copyright ownership, or at the very least, that a genuine issue of fact could exist as to such ownership.

The court granted summary judgment to one plaintiff on the one photograph where his ownership was undisputed, but denied summary judgment on other stories where issues of fact were found to exist. It is clear from the opinions that the lack of a paper trail had a profound effect on the court's analysis.

Conclusion

Clearly, the interested parties in the 1960s and 1970s knew what they were doing at the time and knowingly relied upon their understanding of the then custom and usage in the industry. At the very least, they accepted the existing situation. Assignments were given and completed. Usage rights to the resulting material were granted and payments were made. The parties obvious-

ly never considered, and apparently gave little thought to, the possibility that years later there would be new technology, which would give new life to these photographs and stories, and that their re-use would have significant commercial value. The result of these oversights is complex litigation with an uncertain outcome.

Reducing the understanding of the parties to writing is, however, but half the battle. As an intellectual property practitioner, you must insure that **you also get it right**. Recent litigation, including *Random House v. Rosetta Books*,⁵ where the Second Circuit Court of Appeals analyzed detailed written contracts and held that the author plaintiffs retained rights to license their works for digital publication, are reminders that whatever side you represent, there is no substitute for clarity of language and a complete understanding of the issues, both actual and potential.

The Moral

Make sure that you and your clients know what the deal is, what it should be, and that the "t's" are crossed and the "i's" dotted. Posterity, and especially your client's heirs, will thank you!

Endnotes

1. 97 Civ. 09361 (LAK), 2002 WL 1586965 (S.D.N.Y. July 13, 2002).
2. 208 F. Supp. 429 (S.D.N.Y. 2002).
3. There is another related case before Judge Kaplan, *Hiser v. National Geographic Society*, 99 Civ. 12488 (LAK), where motions for summary judgment concerning acts governed by the 1976 Copyright Act are pending.
4. These lengthy decisions by Judge Kaplan involve significant and varied issues of law, and application of the facts to the law. Any detailed analysis is well beyond the scope and focus of this article. However, they are recommended reading for those who may have clients who are, or may become, similarly situated.
5. 283 F.3d 490 (2d Cir. 2002).

Joel L. Hecker, Of Counsel to Russo & Burke, 600 Third Avenue, New York, NY 10016, practices in every aspect of photography law. He acts as general counsel to the hundreds of professional photographers, stock photo agencies, graphic artists and other photography and content-related businesses he represents nationwide and abroad. He also lectures and writes extensively on issues of concern to these industries. He is a long time member and past Trustee of the Copyright Society of the U.S.A., and is a member of the Entertainment, Arts and Sports Law Section of the NYSBA and of the Copyright and Literary Property Committee of the ABCNY. He can be reached at (212) 557-9600, fax (212) 557-9610 or via e-mail: HeckerEsq@aol.com.

Supreme Court Rejects Focus on Effects of Speech as Basis for Regulating Virtual Child Pornography

By Jonathan Bloom

In *Ashcroft v. Free Speech Coalition*,¹ the U.S. Supreme Court surprised many by striking down portions of the Child Pornography Prevention Act of 1996 (CPPA).² The CPPA expanded the definition of child pornography under federal law so as to include computer-generated “virtual” child pornography and other images created without the use of real children. It did so by defining as child pornography (and, hence, unprotected speech) any visual depiction that “is, or appears to be, of a minor engaging in sexually explicit conduct.”³ In *Free Speech Coalition*, seven justices agreed that the “appears to be” provision was overbroad as applied to images created using youthful-looking adults, while six found it overbroad as applied to virtual images. (Justice O’Connor joined the majority only as to the former.)⁴

The ruling was a significant victory for the mainstream book and magazine publishers and distributors and other media and free-speech organizations that had supported the First Amendment challenge to the CPPA, notwithstanding the risk of appearing to defend child pornography.⁵ These *amici* welcomed the ruling in part because, as the Supreme Court found, the CPPA, although intended to combat “virtual” child pornography, on its face proscribed a substantial amount of constitutionally protected speech with serious literary, artistic, political, or scientific value, including, the Supreme Court found, mainstream movies like “Traffic” and “American Beauty” and even Renaissance paintings depicting scenes from classical mythology.⁶ As the Court observed, the severe criminal penalties imposed under the CPPA were such that “few legitimate movie producers or book publishers . . . would risk distributing images in or near the uncertain reach of this law.”⁷

Although the overbreadth of the “appears to be” language was certainly alarming, this problem was susceptible to at least partial remedy by limiting section 2256(8)(B) to images that are “virtually indistinguishable” from actual children engaging in sexual conduct—which, the legislative history suggests, is what Congress meant to target.⁸ Indeed, bills were promptly introduced following the Supreme Court’s ruling that would do just that.⁹ Yet beyond the CPPA’s overbreadth, the media *amici* were deeply concerned with the broader threat presented by the possibility that the Court would accept as compelling government interests that related to combating the harmful *primary effects* of sexually explicit images created without real children. By contrast, the principal rationale for denying First Amendment protection to traditional child pornogra-

phy is to prevent the harm to children arising out of their participation in the production of the images.

The CPPA was predicated on findings that simulated child pornography, like real child pornography, stimulates the sexual appetites of pedophiles and is used by pedophiles to persuade children to engage in sexual conduct.¹⁰ Congress was also concerned that (i) virtual child pornography was hindering the prosecution of child pornography defendants by permitting defendants to raise reasonable doubt as to whether pornographic materials depicted actual children and (ii) such material was used to fuel the market for traditional child pornography.¹¹ These effects, Congress found, could be caused whether the images are actual or virtual.¹²

It does not discount the gravity of the problem Congress sought to address to observe that had the Supreme Court validated government interests that centered not on the intrinsic characteristics of the images, nor on harm to actual children involved in their production, but rather on the *feared direct effects* or *uses* of the images, it would have endorsed a principle that would have threatened a great deal of controversial nonpornographic speech. If the Constitution permitted Congress to criminalize realistic artistic depictions of children engaging in sexual conduct based on findings as to their harmful direct effects, then Congress could invoke a similar rationale to criminalize other types of creative works that were believed to have harmful effects on readers, viewers, or listeners, as well as on third parties, such as works depicting or describing violence or works perceived as belittling particular racial, ethnic, or religious groups.

In *Free Speech Coalition*, the Supreme Court made clear that Congress’ ability to prohibit speech as a remedy for social ills is narrowly circumscribed, even when the goal is to prevent the sexual exploitation of children. This article focuses on how the lower courts and the Supreme Court in *Free Speech Coalition* evaluated the governmental interests advanced to justify the CPPA and on the importance of the Court’s rejection of those interests as a compelling basis for criminalizing works of the imagination.

Child Pornography Before the CPPA

Proscribing sexually explicit images of children based on their purported effects, as the CPPA did, rep-

resented a dramatic expansion of the rationale for banning child pornography. Prior to *New York v. Ferber*,¹³ the only sexually oriented material that was not protected by the First Amendment was material that was obscene under the three-part test set forth in *Miller v. California*,¹⁴ which required, *inter alia*, that the speech, taken as a whole, lacks serious literary, artistic, scientific, or political value. In *Ferber*, the Court held that child pornography is unprotected speech even if it does not qualify as obscenity under the *Miller* test.¹⁵ That is to say, under *Ferber*, child pornography could be prohibited even if it possessed serious literary, artistic, political, or scientific value.¹⁶ However, *Ferber* expressly limited the definition of child pornography to material created using actual children.¹⁷

The Court in *Ferber* cited five reasons for finding that child pornography is not protected speech, all of which concerned the well-documented harm to children used in the production of sexually explicit images.¹⁸ Making clear that the state's compelling interest did not go beyond protecting children who participated in the creation of the material, the Court stated: "We note that the distribution of descriptions or other depictions of sexual conduct [involving minors], not otherwise obscene, *which do not involve live performance or photographic or other visual reproduction of live performances*, retains First Amendment protection."¹⁹

The Court reinforced the limitation of its holding to depictions of actual minors by observing: "[I]f it were necessary for literary or artistic value, a person over the statutory age who perhaps looked younger could be utilized. Simulation outside of the prohibition of the statute could provide another alternative. . . ."²⁰

Thus, *Ferber* expressly endorsed using adults who appear to be underage as well as using simulations of minors in non-obscene sexually explicit works.

The CPPA exceeded these carefully delineated parameters by (1) banning the use of young-looking adults who appear to be minors unless the creator or purveyor of the material can demonstrate that it did not intend for the adult to be viewed as a minor²¹ and (2) banning the use of computer-simulated or other realistic-looking depictions of children in sexually explicit films, paintings, drawings, or sculptures with serious literary, artistic, political, or scientific value.²²

The District Court's "Secondary Effects" Analysis

Notwithstanding the fact that the CPPA ventured beyond *Ferber* as well as *Miller* in criminalizing the possession and dissemination of images that were created using young-looking adults or that were entirely products of the imagination, the CPPA was upheld by four circuit courts in challenges brought by persons either indicted for or convicted of violating the CPPA.²³ In

each of those cases, the court of appeals held that the government's authority to regulate child pornography was not constrained by the requirement that the material had been produced using actual children.²⁴ In this regard, the First Circuit stated that "concerns about how adults may use child pornography vis-à-vis children and how children might behave after viewing it legitimately inform legislators' collective decision to ban this material."²⁵ All four of the circuit courts that upheld the CPPA, however, found that it was content-based and thus subject to strict scrutiny.²⁶

The only challenge not brought in the context of an actual prosecution was mounted in California district court, spearheaded by the Free Speech Coalition, an adult entertainment industry trade group, and other plaintiffs who feared possible prosecution under the Act.²⁷ The district court, in an opinion by Judge Samuel Conti, held that the CPPA was content-neutral, and subject only to intermediate scrutiny, on the ground that its purpose was to "prevent the secondary effects of the child pornography industry, including the exploitation and degradation of children and the encouragement of pedophilia and molestation of children."²⁸ The court concluded that "[E]ven if no children are involved in the production of sexually explicit materials, the devastating secondary effect that such materials have on society and the well-being of children merits the regulation of such images."²⁹

The court justified its conclusion that the CPPA was not content-specific by asserting that the object of the regulation was not the nature of the materials or the ideas expressed therein, but "the effect of the pornography on innocent children."³⁰

Applying intermediate scrutiny, the court held that the CPPA advanced compelling government interests and did not burden more speech than necessary to protect children from the harms of child pornography.³¹ The court rejected plaintiffs' overbreadth claim, expressing confidence that works such as "depictions used by the medical profession to treat adolescent disorders, adaptations of sexual works like 'Romeo and Juliet,' and artistically-valued drawings and sketches of young adults engaged in passionate behavior" would not be treated as criminal contraband.³²

The Ninth Circuit Rejects "Secondary Effects" Analysis

The Ninth Circuit reversed. The majority opinion, written by District Judge Donald W. Molloy, sitting by designation, followed the First Circuit's ruling in *Hilton* and held that the CPPA was not a content-neutral time, place, and manner restriction. Rather, because it "expressly aims to curb a particular category of expression . . . by singling out the type of expression based on

its content and then banning it," the CPPA was a content-based regulation that was subject to strict scrutiny review.³³

The court of appeals thus properly recognized that the district court's conclusion that the CPPA was content-neutral represented a gross misinterpretation of the secondary effects doctrine. Under settled First Amendment precedent, the government "may impose reasonable restrictions on the time, place or manner of protected speech, *provided the restrictions are justified without reference to the content of the regulated speech . . .*"³⁴ Permissible content-neutral justifications for speech regulations include prevention of the secondary effects of speech. In *City of Renton v. Playtime Theaters, Inc.*,³⁵ for instance, the Court held that a zoning ordinance restricting the proximity of adult movie theaters to churches, parks, or schools was content-neutral because it was justified with reference to the prevention of crime and other undesirable effects associated with adult theaters and was not intended to restrict the content of the speech purveyed by adult theaters.³⁶

Content neutrality requires that the regulation in question not focus on the impact of the content of the speech on its audience—in other words, on its *primary effect*—since "[t]he emotive impact of speech on its audience is not a 'secondary effect.'"³⁷ The Supreme Court relied upon this principle in striking down the portions of the Communications Decency Act of 1996 (CDA) that criminalized the transmission of obscene or indecent messages and the sending or display of patently offensive messages to a person under eighteen years of age, where it held that the purpose of the CDA was "to protect children from the primary effects of 'indecent' and 'patently offensive' speech, rather than any 'secondary' effect of such speech," thus making "time, place, and manner" analysis inapplicable.³⁸

Time, place, or manner restrictions are content-neutral and pass constitutional muster so long as they are narrowly tailored to serve a significant government interest and leave open ample alternative channels for communication of the information.³⁹ Thus, a city ordinance regulating the permissible volume of amplified sound in a public park is a content-neutral time, place, and manner restriction because its purpose—controlling volume—is unrelated to the content of the speech.⁴⁰

Although in *City of Erie v. Pap's A.M.*,⁴¹ the plurality improperly relied upon the secondary effects doctrine (which it conflated with the *O'Brien* incidental effect doctrine) in upholding a total ban on live nude dancing,⁴² the plurality was careful to emphasize that the ordinance "does not attempt to regulate the primary effects of the expression of, *i.e.*, the effect on the audience of watching nude erotic dancing, but rather the secondary effects, such as the impacts on public health, safety, and welfare. . . ." ⁴³

The CPPA clearly failed this content-neutrality test: It focused on the direct impact of works of specified content on viewers—specifically, on its role in whetting the sexual appetites of pedophiles and its effect on the actions of children to whom prohibited works were shown to entice them into sexual activity—as grounds for suppressing speech altogether. As the Ninth Circuit noted, "Congress has not kept secret that one of its motivating reasons for enacting the CPPA was to counter the primary effect child pornography has on those who view it."⁴⁴

The Ninth Circuit's rejection of a content-neutral "secondary effects" analysis of the CPPA signaled a skepticism toward the government's asserted interests that led the court, in applying strict scrutiny, to diverge from the First Circuit and to conclude that those interests were neither compelling nor, indeed, constitutionally permissible. Whereas the First Circuit held in *Hilton* that the government's compelling interest in protecting children permitted it to focus on the effects of child pornography on children, whether or not real children actually participated in its production,⁴⁵ the Ninth Circuit majority emphasized that the state interests endorsed by the Supreme Court in *Ferber* focused specifically on the harm suffered by children used in the production of pornographic images, not on "the effects such images have on others, even if those effects exist."⁴⁶ The court thus concluded that the government's proffered rationales for criminalizing the use of "fictional images that involve no human being" were "not supported by existing case law."⁴⁷

Definitively rejecting the secondary effects doctrine as a valid prism for evaluating the constitutionality of the CPPA, the court stated: "To accept the secondary effects argument as the gauge against which the statute must be measured requires a remarkable shift in the First Amendment paradigm. Such a transformation, how speech impacts the listener or viewer, would turn First Amendment jurisprudence on its head."⁴⁸

It appears that the Ninth Circuit majority was troubled both by the district court's holding that the effect of speech on its listeners or viewers could be defined as a "secondary effect" in order to evade strict scrutiny, as well as by Congress' reliance on prevention of the *primary* effects of speech—the undesirable responses of pedophiles and children—as a compelling state interest to justify suppressing otherwise protected speech.

Of the five circuits confronted with constitutional challenges to the CPPA, only the Ninth Circuit recognized that by criminalizing works of the imagination Congress had employed a means of thought control in order to protect children. However laudable the objective, the court concluded, thought control cannot justify a content-based regulation of speech: "Because the

[CPPA] attempts to criminalize disavowed impulses of the mind, manifested in illicit creative acts, we determine that censorship through enactment of criminal laws intended to control an evil idea cannot satisfy the constitutional requirements of the First Amendment.”⁴⁹

In this regard, the court’s reasoning was consistent with that of the Seventh Circuit in *American Booksellers Association, Inc. v. Hudnut*,⁵⁰ which struck down an Indianapolis ordinance that prohibited the sale of pornography that portrayed women in a submissive or degrading manner. Although the Seventh Circuit accepted the premise of the legislation—that images of women as subordinate “tend to perpetuate subordination”—it rejected reliance on such consequences as a basis for suppressing speech: “If the fact that speech plays a role in the process of conditioning were enough to permit governmental regulation, that would be the end of freedom of speech.”⁵¹

The Supreme Court Affirms

When the Supreme Court granted *certiorari* in *Free Speech Coalition* (which struck down the CPPA) rather than in *Hilton* (which upheld it), there was good reason to believe that the Court would reverse. It did not. Instead, the Court’s majority opinion affirming the Ninth Circuit, written by Justice Kennedy, echoed in crucial respects the Ninth Circuit’s evaluation of the government’s articulated interests. Sounding themes articulated by the Ninth Circuit as well as by the media *amici*, the Court’s discussion of the constitutionality of Congress’ justifications for the CPPA included powerful statements regarding the limits on the government’s ability to control thoughts as a means of combating societal problems.

Engaging in strict scrutiny review (the government did not appeal the Ninth Circuit’s holding that the CPPA was content-specific), Justice Kennedy began his analysis of the government’s asserted interests by noting that many otherwise innocent things, such as cartoons, video games and candy, might be used for immoral purposes but would not be prohibited on that basis.⁵² He continued:

The mere tendency of speech to encourage unlawful acts is not a sufficient reason for banning it. The government “cannot constitutionally premise legislation on the desirability of controlling a person’s private thoughts.” *Stanley v. Georgia*, 394 U.S. 557, 566 (1969). First Amendment freedoms are most in danger when the government seeks to control thought or to justify its laws for that impermissible end. The right to think is the beginning of freedom, and

speech must be protected from the government because speech is the beginning of thought.⁵³

Thus, Kennedy wrote, the government “may not prohibit speech because it increases the chance an unlawful act will be committed ‘at some indefinite future time.’”⁵⁴

The Court was mindful of the fact that although the general proscription against prohibiting speech based on its primary effect (as opposed to its lack of serious value) is not absolute, the circumstances in which speech can be deprived of First Amendment protection based on its primary effect are narrowly circumscribed. For instance, a threat is unlawful only when a reasonable person would foresee that the statement “would be interpreted by those to whom the statement is communicated as a serious expression of intent to inflict bodily harm.”⁵⁵ Similarly, denying First Amendment protection to so-called “fighting words” is premised on the immediate harm caused by their utterance.⁵⁶ Advocacy of violence or lawless action can be punished only if “such advocacy is directed to inciting or producing imminent lawless action and is likely to incite or produce such action.”⁵⁷ None of these categories of speech was implicated by the CPPA.⁵⁸ Instead, the Court found that the government had “shown no more than a remote connection between speech that might encourage thoughts or impulses and any resulting child abuse.”⁵⁹ While it did not completely foreclose the possibility of prohibiting virtual child pornography, the Court held that “[w]ithout a significantly stronger, more direct connection, the Government may not prohibit speech on the ground that it may encourage pedophiles to engage in illegal conduct.”⁶⁰

Implications

The most important lesson of *Free Speech Coalition* in terms of First Amendment doctrine is that regulation of otherwise protected speech on the ground that it *may stimulate improper thoughts or be used as an instrument of crime in the hands of deviant persons*, absent compelling evidence of a causal link to actual harm, is a dangerous incursion on the First Amendment, an invitation to censorship and a return to an approach, long ago discarded as unconstitutional by the Supreme Court, under which sexually explicit speech could be restricted as obscene based on its effect on particularly susceptible persons.⁶¹ *Free Speech Coalition* stands for the proposition that attempting to control evil conduct by banning evil thoughts is fundamentally antithetical to this country’s conception of free speech. As the Supreme Court observed in *Stanley v. Georgia*, “Our whole constitutional heritage rebels at the thought of giving government the power to control men’s minds.”⁶²

Had the Supreme Court come out the other way, the potential implications for freedom of speech would have been far-reaching. A holding that non-obscene sexually explicit images created without actual children could be banned based on their purported effect on certain viewers would have supported the restriction of any type of speech that could be asserted to induce socially undesirable behavior on the part of certain recipients.

This is more than a theoretical concern. Studies purporting to find that depictions of violence may cause young viewers to react aggressively or violently have been cited to justify a number of laws aimed at regulating violent imagery in the interest of protecting minors and society from juvenile crime.⁶³ A St. Louis County ordinance predicated on a legislative finding that “exposure of children to graphic and lifelike violence contained in some video games has been correlated to violent behavior” was recently upheld by a federal trial court.⁶⁴

At the federal level, Congress has considered restrictions on violent imagery, musical lyrics and even written descriptions. These measures include a bill introduced in the House of Representatives in June 1999 that would have made it a crime to expose children to images, sound recordings, or printed descriptions of graphic violence.⁶⁵ Another bill sought to ban the broadcasting of certain violent video programming during hours that children are likely to be in the viewing audience based on Congress’ belief that “violent video programming influences children, as does indecent programming.”⁶⁶ Another bill would have made marketing “adult-rated” movies, video games and music to minors illegal as a “deceptive” trade practice, based on lawmakers’ assertions that “media violence can be harmful to children.”⁶⁷ A bill introduced in June 2002 would punish retailers who fail to enforce the video game industry’s self-imposed rating system in order to “protect[] our children from video games’ sex and violence.”⁶⁸ These legislative efforts highlight the ongoing threat to mainstream speech that is vulnerable to claims that it leads some recipients to engage in aberrant behavior.

Recent experience has painfully shown that grappling with reality inevitably involves confrontation with violence and death, with the unpleasant and disturbing as well as the uplifting aspects of human experience. While the impulse to censor so as to eliminate dangerous influences is understandable, as Judge Posner recently observed:

People are unlikely to become well-functioning, independent minded adults and responsible citizens if they are raised in an intellectual bubble . . .

To shield children right up to the age of 18 from exposure to violent descriptions and images would not only be quixotic, but deforming; it would leave them unequipped to cope with the world as we know it.⁶⁹

In *Herceg v. Hustler Magazine, Inc.*,⁷⁰ the Fifth Circuit eloquently expressed our constitutional commitment to protecting even harmful speech in the interest of permitting freedom of thought to flourish:

The constitutional protection accorded to the freedom of speech and of the press is not based on the naïve belief that speech can do no harm but on the confidence that the benefits society reaps from the free flow and exchange of ideas outweigh the costs society endures by receiving reprehensible or dangerous ideas.⁷¹

The perceived urgency of addressing serious societal problems such as child abuse by pedophiles and juvenile crime makes even purely fictional, creative speech associated with those problems an irresistible target for legislators. Yet unless such laws are tested against rigorous First Amendment standards, we risk compromising the bedrock principles on which our entire free speech edifice rests. The Supreme Court’s forceful rejection of thought control as a permissible aim of government speech regulation may prove to be an important precedent in future clashes between the First Amendment and well-meaning but misguided efforts to use censorship as a tool to solve social problems.

Constitutionality of Pending Legislation

Two weeks after the Supreme Court handed down its ruling in *Free Speech Coalition*, legislation was introduced in the House of Representatives that sought to remedy the constitutional defects the Court had identified. That bill, H.R. 4623 (the Child Obscenity and Pornography Prevention Act of 2002), and its counterpart in the Senate (S. 2511), fail to rectify the core constitutional defects of the CPPA. On the other hand, S. 2520 (the Prosecutorial Remedies and Tools Against the Exploitation of Children Today Act of 2002, introduced by Senator Hatch on May 15, 2002) much more faithfully implements the Supreme Court’s ruling and avoids the overbreadth problems of the CPPA by conforming the definition of the proscribed materials to the obscenity standard.

As noted above, in *Ferber* the Court specifically suggested that using young-looking adults or some type of simulation instead of actual minors would be a consti-

tionally permissible means of avoiding the proscription against child pornography.⁷² In *Free Speech Coalition*, the Court held that *Ferber* “provides no support for a statute that eliminates the distinction [between actual and virtual child pornography] and makes the alternative mode criminal as well.”⁷³ “In contrast to the speech in *Ferber*,” the Court observed, “the CPPA prohibits speech that records no crime and creates no victims by its production.”⁷⁴ As noted above, the Court went on to reject each of the government’s asserted rationales for extending the definition of child pornography beyond the limits authorized by *Ferber*.⁷⁵

In light of the Court’s unambiguous refusal to erase the clear line drawn in *Ferber* between actual and virtual child pornography, merely amending the statutory definition of child pornography to include “a computer image or computer-generated image that is, or *appears virtually indistinguishable from*, that of a minor engaging in sexually explicit conduct,” as H.R. 4623 does,⁷⁶ is insufficient to pass constitutional muster. Although that language would not cover most artistic renderings and would not apply to images of young-looking adults (which are not computer-generated), thus significantly reducing the CPPA’s overbreadth, its coverage of virtual images contravenes the Court’s holding that images that do not “create[] . . . victims by [their] production”⁷⁷ cannot be proscribed.

The House bill attempts to cure this problem by providing an affirmative defense if the alleged offense “did not involve child pornography produced using a minor engaging in sexually explicit conduct.”⁷⁸ However, this defense is constitutionally problematic because it places on the defendant the burden of demonstrating that the images in question are *not* child pornography. Addressing the CPPA’s affirmative defense for nonpossession offenses of images that could be shown to have been produced using adults,⁷⁹ the Court in *Free Speech Coalition* noted that it “raises serious constitutional difficulties by seeking to impose on the defendant the burden of proving his speech is not lawful.”⁸⁰ The Court pointed out that an affirmative defense “applies only after prosecution has begun, and the speaker must prove, on pain of a felony conviction, that his conduct falls within the affirmative defense.”⁸¹

The Court did not decide whether this burden-shifting was in itself unconstitutional, as it held that the CPPA’s affirmative defense was “insufficient, even on its own terms” because (1) it did not apply to possession, as opposed to distribution, offenses and (2) it provided no protection in cases involving computer-generated images, which could not be shown to depict adults.⁸² The Court also pointed out that where the defendant is not the producer of the work, he may have no way of establishing “the identity, or even the existence, of the actors.”⁸³

Unlike the affirmative defense in the CPPA, the affirmative defense provided in H.R. 4623 would apply to virtual images as well as to possession offenses, but it fails to address two of the problems identified in *Free Speech Coalition*: (1) the shifting of the burden of proof and (2) the difficulty of making the required showing faced by defendants who did not create the works.⁸⁴

S. 2520 modifies the “appears to be” provision of the CPPA by adding that the image must be obscene.⁸⁵ This effectively renders the provision superfluous, since obscene images are unprotected in any event, but it clarifies that the bill is not intended to cover works that would be protected under *Ferber*, for example, works that do not depict actual children and possess literary, artistic, political, or scientific merit. The bill also would amend 19 U.S.C. § 2256(8)(D)—the provision applicable to advertising, promotion and distribution—so that it would criminalize images that depict “a minor, or an individual who appears to be a minor,” engaging in specified sexual acts where the image lacks “literary, artistic, political, or scientific value”—again linking the definition of proscribed material to the obscenity definition, thus rectifying the overbreadth and vagueness problems that infected the CPPA.⁸⁶ Thus, unlike the House bill, the Senate bill would, in theory, spare from prosecution the types of mainstream artistic works cited by the Supreme Court in finding the CPPA overly broad.

It is likely that legislation similar to one of the pending bills discussed above will be enacted and will be the subject of a constitutional challenge, either facial or as applied. Congress’s prompt response to *Free Speech Coalition* is testimony to the powerful political imperative to pass laws giving prosecutors additional tools to combat the dissemination of sexually explicit virtual images that are thought to contribute to the sexual abuse of minors. The bills currently being considered in Congress are of varying constitutional merit. The House bill, by failing to recognize that *Free Speech Coalition* placed virtual child pornography—however realistic—beyond the reach of the law if it is otherwise lawful (for example, not obscene), suffers from serious constitutional defects. The Senate bill, which expressly protects images with literary, artistic, political, or scientific value, is a far more faithful implementation of *Free Speech Coalition* and thus far more likely, if enacted, to be upheld.

Endnotes

1. 122 S. Ct. 1389 (2002).
2. 18 U.S.C. § 2251.
3. 18 U.S.C. § 2256(8)(B) (emphasis added). The CPPA also banned depictions that are “advertised, promoted, presented, described, or distributed in such a manner that *conveys the impression* that the material is or contains a visual depiction of a minor engag-

- ing in sexually explicit conduct.” 18 U.S.C. § 2256(8)(D) (emphasis added). Section 2256(8)(C), the provision relating to computer-morphed images—pictures of real children altered so that the children appear to be engaging in sexual activity—was not challenged.
4. The Court also struck down section 2256(8)(D) as overbroad by a 7-2 vote.
 5. An *amicus* brief in support of respondents was filed with the Supreme Court by Weil, Gotshal & Manges LLP on behalf of the Association of American Publishers, Inc., the American Booksellers Foundation for Free Expression, the Freedom to Read Foundation, the International Periodical Distributors Association, the Magazine Publishers of America, the Publishers Marketing Association and the Video Software Dealers Association.
 6. 122 S. Ct. at 1397, 1400.
 7. 122 S. Ct. at 1398.
 8. See S. Rep. No. 104-358, at 7 (1996) (indicating that purpose of phrase “appears to be” was to extend prohibition against child pornography from photographic images of actual minors engaging in sexually explicit conduct to “the identical type of depiction, one which is virtually indistinguishable from the banned photographic depiction”). See *Free Speech Coalition*, 122 S. Ct. at 1412 (Rehnquist, J., dissenting).
 9. H.R. 4623, the Child Obscenity and Pornography Prevention Act of 2002, was introduced on April 30, 2002, and approved by the House on June 25, 2002. An identical Senate bill, S. 2511, was referred to the Senate Committee on the Judiciary on June 26, 2002. An alternative Senate bill, S. 2520, has been introduced by Senators Hatch and Leahy.
 10. See S. Rep. No. 104-358 104th Cong. (1996), at 12-14.
 11. See *id.* at 16-17.
 12. See *id.* at 26 (“‘synthetic’ child pornography, which looks real to the naked eye, will have the same effect upon viewers as ‘traditional’ child pornography”); *id.* at 18 (“the danger to actual children who are seduced and molested with the aid of child sex pictures is just as great when the child pornographer or child molester uses [computer simulations] as when the material consists of unretouched images of actual children”).
 13. 458 U.S. 747 (1982).
 14. 413 U.S. 15, 24 (1973).
 15. In rejecting application of the *Miller* standard to child pornography, the Court in *Ferber* observed that the *Miller* factors “bear no connection to the issue of whether a child has been physically or psychologically harmed in the production of the work.” 458 U.S. at 761.
 16. Following *Ferber*, the Child Protection Act of 1984, Pub. L. No. 98-292, 98 Stat. 204 (1984) (codified as amended at 18 U.S.C. §§ 2251-2253), eliminated the requirement that material be obscene under *Miller* in order to be proscribed.
 17. See *Ferber*, 458 U.S. at 764 (“When a definable class of material . . . bears so heavily and pervasively on the welfare of children engaged in its production . . . it is permissible to consider these materials as without the protection of the First Amendment.”) (emphasis added).
 18. *Id.* at 756-64.
 19. *Id.* at 764-65 (emphasis added).
 20. *Id.* at 763 (emphasis added).
 21. 18 U.S.C. §§ 2252A(c), 2256(8)(B).
 22. 18 U.S.C. § 2256(8)(B). The affirmative defense provided in section 2252A(c), which permitted a defendant to avoid conviction for offenses other than possession by showing that the materials were produced using adults, does not apply to computer-generated or other artistic images. See *Free Speech Coalition*, 122 S. Ct. at 1405.
 23. See *United States v. Fox*, 248 F.3d 394 (5th Cir. 2001); *United States v. Mento*, 231 F.3d 912 (4th Cir. 2000); *United States v. Acheson*, 195 F.3d 645 (11th Cir. 1999); *United States v. Hilton*, 167 F.3d 61 (1st Cir. 1999).
 24. See *Fox*, 248 F.3d at 401-02; *Mento*, 231 F.3d at 918-20; *Acheson*, 195 F.3d at 650; *Hilton*, 167 F.3d at 70, 72.
 25. 167 F.3d at 70.
 26. *Fox*, 248 F.3d at 400; *Mento*, 231 F.3d at 918; *Acheson*, 195 F.3d at 650; *Hilton*, 167 F.3d at 68-69.
 27. The other plaintiffs were Bold Face Type, Inc., the publisher of a book advocating nudism; Jim Gingerich, a painter of nudes and Ron Raffaelli, a photographer specializing in erotic images.
 28. *Free Speech Coalition v. Reno*, No. C 97-0281VSC, 1997 WL 487758 (N.D. Cal. Aug. 12, 1997), at *4.
 29. *Id.*
 30. *Id.*
 31. *Id.* at *6.
 32. *Id.* The court also held that the CPPA was not void for vagueness. *Id.*
 33. *Free Speech Coalition v. Reno*, 198 F.3d 1083, 1090 (9th Cir. 1999).
 34. *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989) (emphasis added) (citation omitted).
 35. 475 U.S. 41 (1986).
 36. 475 U.S. at 47-48.
 37. *Boos v. Barry*, 485 U.S. 312, 321 (1988) (holding that District of Columbia law making it unlawful to display within 500 feet of an embassy any sign that tends to bring the foreign government into “public odium” or “public disrepute” is content-based because its justification focuses on the content of the speech and the direct impact such speech has on its listeners). See also *Reno v. ACLU*, 521 U.S. 844, 868 (1997) (“[t]he purpose of the CDA is to protect children from the primary effects of ‘indecent’ and ‘patently offensive’ speech, rather than any ‘secondary’ effect of such speech. Thus, the CDA is a content-based blanket restriction on speech. . . .”).
 38. *Reno v. ACLU*, 521 U.S. 844, 867-68 (1997).
 39. *Id.*
 40. *Ward*, 491 U.S. at 792.
 41. 529 U.S. 277 (2000).
 42. *Id.*
 43. See *id.* at 291 (“the ordinance prohibiting public nudity is aimed at combating crime and other negative secondary effects caused by the presence of adult entertainment establishments . . . and not at suppressing the erotic message conveyed by this type of nude dancing”).
 44. 198 F.3d at 1091 (quoting *Hilton*, 167 F.3d at 68-69).
 45. *Hilton*, 167 F.3d at 70.
 46. 198 F.3d at 1092.
 47. *Id.*
 48. *Id.* at 1094-95.
 49. 198 F.3d at 1094.
 50. 771 F.2d 323, 334 (7th Cir. 1985), *aff’d*, 475 U.S. 1001 (1986).
 51. 771 F.2d at 330 (quoted in *Free Speech Coalition*, 198 F.3d at 1093). The Ninth Circuit also held that the statutory language “appears to be a minor” and “convey[s] the impression” that the material depicts a minor engaged in explicit sexual activity were “highly subjective” and thus unconstitutionally vague. 198 F.3d at 1095.
 52. 122 S. Ct. at 1402. In that regard, the media *amici*, in their brief to the Ninth Circuit, cited a study which found that “[m]ost pae-

- dophiles seem not attracted by child pornography” and that some use non-pornographic depictions of children such as mail-order clothing catalogues and television programs to stimulate their sexual fantasies. Dennis Howitt, *Pornography and the paedophile: Is it criminogenic?* 68 British J. Med. Psychol. 15, 24 (1995).
53. *Id.* at 15.
 54. *Id.* (citing *Hess v. Indiana*, 414 U.S. 105, 108 (1973)). With respect to the government’s contention that the possibility of producing computer-generated child pornography made it difficult to obtain convictions under the existing child pornography law because it is difficult to prove that images are actual, rather than virtual, child pornography, the Court held that the government “may not suppress lawful speech as the means to suppress unlawful speech.” 122 S. Ct. at 1404.
 55. *Planned Parenthood of the Columbia/Willamette, Inc. v. American Coalition of Life Activists, Inc.*, 290 F.3d 1058, 1077 (9th Cir. 2002) (en banc).
 56. See *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942) (First Amendment does not protect “fighting words—those which by their very utterance inflict injury or tend to incite an immediate breach of the peace”).
 57. *Brandenburg v. Ohio*, 395 U.S. 444, 447 (1969). Courts have construed strictly *Brandenburg’s* requirements of intent, imminence, and likelihood. See, e.g., *Texas v. Johnson*, 491 U.S. 397, 409 (1989) (ban on flag burning not permitted based on its “potential for a breach of the peace”); *Hess v. Indiana*, 414 U.S. 105, 109 (1973) (provocative remarks by a demonstrator to police could not be punished on the ground that they had a mere tendency to lead to violence); *Herceg v. Hustler Magazine, Inc.*, 814 F.2d 1017 (5th Cir. 1987) (magazine’s detailed description of autoerotic asphyxia, which teenager followed in making fatal attempt to perform the act, protected by First Amendment because it did not “incite” the teenager to harm himself); *McCollum v. CBS, Inc.*, 249 Cal. Rptr. 187 (Cal. App. 1988) (dismissing on First Amendment grounds claim that record “Suicide Solution” intentionally incited suicide of listener); *Yakubowitz v. Paramount Pictures Corp.*, 404 Mass. 624, 630-32, 536 N.E.2d 1067, 1071-72 (Mass. 1989); *Byers v. Edmondson*, No. 2001 CA 1184, 2002 WL 1200768 (La. App. 1 Cir. June 5, 2002) (nothing in Oliver Stone film “Natural Born Killers” constituted incitement because it “does not purport to order or command anyone to perform any concrete action immediately or at any specific time”).
 58. See *Free Speech Coalition*, 122 S. Ct. at 1403 (“There is here no attempt, incitement, solicitation, or conspiracy.”).
 59. 122 S. Ct. at 1403.
 60. *Id.* The Seventh Circuit, in an opinion by Judge Richard A. Posner, reached a similar conclusion in *American Amusement Machine Ass’n v. Kendrick*, 244 F.3d 572 (7th Cir. 2001), *cert. denied*, 122 S. Ct. 462 (2001), a First Amendment challenge brought by a trade association of video game manufacturers against an Indianapolis ordinance that limited the access of minors to video games containing either “graphic violence” or “strong sexual content.” Reversing the district court’s holding that “graphic violence” could be regulated to the same extent as “harmful to minors” sexual material, the court held that violent imagery could not be proscribed absent compelling evidence that it incited consumers of the video games to commit violent acts or inflicted psychological harm on children exposed to such images. 244 F.3d at 576.
 61. See *Roth v. United States*, 354 U.S. 476, 489 (1957) (rejecting holding of *Regina v. Hicklin*, L.R. 3 Q.B. 360).
 62. 394 U.S. 557, 565 (1969).
 63. See, e.g., *American Amusement Machine Ass’n*, 244 F.3d at 578 (rejecting psychological studies as support for violent video game ordinance). *But see Interactive Digital Software Ass’n v. St. Louis Co.*, No. 4:00CV2030, 2002 WL 826822, *9 (E.D. Mo. Apr. 91, 2002) (crediting expert testimony and referenced studies as demonstrating causal link between viewing violent video games and aggressive thought and behavior in children). *Cf. Eclipse Enterprises, Inc. v. Gulotta*, 134 F.3d 63, 64 (2d Cir. 1997) (striking down local ordinance barring distribution to minors of trading cards depicting heinous crimes or criminals that legislators considered a contributing factor to juvenile crime).
 64. *Interactive Digital Software Ass’n*, 2002 WL 826822, at *2. The ruling has been appealed to the Eighth Circuit.
 65. See H.R. 2036, 106th Cong. (1999).
 66. See, e.g., H.R. 1005, 107th Cong. (2001).
 67. See S. 792, 107th Cong. (2001).
 68. H.R. 4645, 108th Cong. (2002). See Catherine Donaldson-Evans, *Explicit Video Games May Become Illegal*, foxnews.com (June 18, 2002), available at <http://www.foxnews.com/story/0,2933,55689,00.html>.
 69. 244 F.3d at 577.
 70. 814 F.2d 1017 (5th Cir. 1987).
 71. 814 F.2d at 1019.
 72. *Ferber*, 458 U.S. at 763 (“[I]f it were necessary for literary or artistic value, a person over the statutory age who perhaps looked younger could be utilized. Simulation outside of the prohibition of the statute could provide another alternative.”).
 73. *Free Speech Coalition*, 122 S. Ct. at 1402.
 74. *Id.*
 75. See *id.* at 1402-05.
 76. H.R. 4623, 107th Cong., 2d Sess. (2002), Sec. 2(a) (emphasis added).
 77. *Free Speech Coalition*, 122 S. Ct. at 1402.
 78. H.R. 4623, Sec. 2(c).
 79. See 19 U.S.C. § 2252A(c).
 80. 122 S. Ct. at 1404. See also *United States v. X-Citement Video, Inc.*, 513 U.S. 64 (1994) (government must prove that defendant charged with shipping child pornography in interstate commerce knew material depicted a minor).
 81. 122 S. Ct. at 1404.
 82. *Id.* at 1405.
 83. *Id.* at 1404.
 84. *Id.*
 85. S. 2520, 107th Cong., 2d Sess. (2002), Sec. 4(2)(A).
 86. *Id.* at Sec. 4(2)(D) (emphasis added).

Jonathan Bloom is counsel to Weil, Gotshal & Manges LLP. He focuses on First Amendment, art, and intellectual property law. A version of this article appeared in Vol. 20:3 (Fall 2002) of *Communications Lawyer*.

Why Is There Copyright Restoration?

By Alan J. Hartnick

Copyright restoration, as now embodied in 17 U.S.C. § 04(A), is antithetical to the doctrine of the public domain. If one of the purposes of copyright is to enrich the public domain, copyright restoration could be against public policy, or perhaps the Constitution.¹ What is the basis for copyright restoration?

Background

The most important international copyright treaty is the Berne Convention. When the U.S. joined in 1989, we took a blind eye to the significance of Berne Article 18, which stated: “(1) This Convention shall apply to all works which, at the moment of its coming into force, have not fallen into the public domain in the country of origin through the expiry of the term of protection.”

Article 18, the Rule of Retroactivity, has been in the Berne Convention since its beginning in 1886. The effect is diminished by Article 18, paragraph (3), which grants member countries a great deal of latitude.

To avoid Article 18 and moral rights under Berne Convention’s Article 6 *bis*, the Berne Convention Implementation Act of 1988² stated, in section 3(a)(2), that the provisions of the Berne Convention “. . . shall not be enforceable in any action brought pursuant to the provisions of the Berne Convention itself.”

As piracy of intellectual property increased exponentially, as a policy stance, the U.S. determined that intellectual property matters needed to be included on the trade agenda, as that seemed the best way to obtain increased international intellectual property protection. Indeed, this stance worked!

Article 9, Part II, of the TRIPS Agreement, adopted by the U.S. on January 1, 1995, stated that: “1. Members shall comply with Article 1 through 21 of the Berne Convention (1971) and the Appendix thereto. However, Members shall not have rights or obligations under this Agreement with respect to rights conferred under Article 6 *bis* [moral rights] of that Convention or the rights derived therefrom.”

If members must comply with Articles 1 through 21, then Berne Article 18 addressing copyright restoration was included. The purpose of TRIPS was to *increase* U.S. copyright protection by, among other reasons, accepting copyright restoration. The U.S. in NAFTA had restored the copyright in Mexican movies, in Annex 1705.F. To quote from such Annex:

The United States shall provide protection to motion pictures produced in

another Party’s territory that have been declared to be in the public domain pursuant to 17 U.S.C. Section 405. This obligation shall apply to the extent that it is consistent with the Constitution of the United States, and is subject to budgetary considerations.

That is how the Mexican films of Cantinflas were restored to copyright!

Copyright Restoration

TRIPS caused section 104A,³ copyright restoration, to be added to the Copyright Act. Under section 104A, the United States has restored copyright protection for certain foreign works that lost copyright protection in the U.S. because of failure to comply without formalities, or because the works were sound recordings fixed before federal copyright protection was extended on February 15, 1972. The covered works are from a Berne or World Trade Organization country of origin. The owner of copyright of a restored work is determined by the law of the source country of the work. Protection is automatic as of the effective date of January 1, 1996, for *other* than a reliance party.

To enforce rights against a reliance party, one can use a notice of intent or actual notice. There is a one-year grace period after actual or constructive notice. If a reliance author is involved, that is, one who created a derivative work before the enactment of the statute on December 9, 1996, and if the derivative work was authored or published in a non-U.S. Berne or WTO country, the reliance author may continue to exploit the work if he or she pays reasonable compensation to the owner of the restored work, payable voluntarily or by determination of the U.S. District Court.

Who Is the “Reliance Party”?

In *Cordon Holding B.V. v. Northwest Publishing*,⁴ defendant Northwest in the U.S. in 1995 offered reproductions of the works of the Dutch graphic artist Maurits Escher, who had died in 1972. Plaintiff Cordon, as owner of the Escher copyright, submitted a Notice of Intent to Enforce a Restored Copyright on April 23, 1996, which was published in the Federal Register as of August 30, 1996.

Defendant Northwest argued that it exploited the restored copyright work in 1995, *before* the January 1, 1996, effective date of the restored copyright.⁵ Was Northwest a reliance party?

Judge Allen G. Schwartz in *Cordon* strictly construed the Copyright Act, which states that “(4) [t]he term “reliance party” means any person who [A] with respect to a particular work, engages in acts, before the source country of that work becomes an eligible country, which would have violated Section 106 [copyright infringement] if the restored work had been subject to copyright protection. . .”⁶

The source country was the Netherlands. The Netherlands was a member of WTO or Berne on December 8, 1994, and is an “eligible country”⁷ before the statute was enacted on December 8, 1994. Therefore, the allegedly infringing acts must have begun prior to that date.

Because the defendant claimed that it began manufacturing in May 1995, nearly six months after the date in which defendants could be considered “reliance parties,” Judge Schwartz held that defendants were not “reliance parties.” Therefore, Northwest was responsible for all acts commencing on or after the January 1, 1996, restoration date.

Conclusion

Is there a reasonable basis for linking the definition of a “reliance party” to the statutory definition of an “eligible country”? Is there an argument to be made that the strict application of the Copyright Act is unconstitutional as to parties who used public domain material between December 8, 1994, the date of enactment, and January 1, 1996, the effective date?

Congress in 1994 delayed the effective date of copyright restoration to 1996. One purpose was to permit Notices of Intent to be filed with the Copyright Office. However, it did not give leave to anyone’s making infringing copies between the date of enactment (1994)

and the effective date (1996). Any other result would give an unfair benefit to those who would take advantage of the time interval between the date of enactment and the effective date.

On one hand, the U.S. adhesion to Berne Article 18 appears to be posing constitutional objections because of the restriction on the U.S. public domain. On the other hand, there is a value of uniformity in international copyright protection. To conform the duration of U.S. copyright to encompass foreign duration provides certainty and simplicity in international business dealings. Perhaps the constitutional requirement that Congress “promote the Progress of Science” could include foreign authors.

Endnotes

1. In *Gohan v. Ashcroft*, the plaintiff claims that copyright restoration under 514 of the Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4976 (1994), exceeds the Constitution’s bounds. (U.S.D. Ct. of Colo., Civil Action No. 01-B-1854).
2. Pub. L. No. 100-568, 102 Stat. 2853 (1988).
3. The Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809, 4976 (1994).
4. Memorandum Order by Judge Allen G. Schwartz, dated April 8, 2002, U.S. Dist. Ct. S.D.N.Y., 98 Civ. 4797 (Ags); 2002 U.S. Dist. LEXIS 6111.
5. 17 U.S.C. § 104(A)(h)(2)(A).
6. 17 U.S.C. § 104(A)(h)(4)(A).
7. 17 U.S.C. § 104(A)(h)(3)(A) and (B).

Alan J. Hartnick is a partner in the New York City law firm of Abelman, Frayne & Schwab, former President of the Copyright Society and Chair of the Copyright and Trademark Committee of the Entertainment, Arts and Sports Law Section of the New York State Bar Association.



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The Outer Reaches of Copyright Protection: Creative Arts, Style and the Law

By Judith Beth Prowda and Judith Greenberg Finell

Introduction

No artist—visual artist, writer, or composer—creates in a vacuum. Earlier works generally serve as points of departure from which a later artist makes a leap of imagination to create a wholly original work.¹ The history of visual art is replete with examples of artists borrowing themes and styles from one another.² The influence of African sculpture and masks on Picasso's early work, for example, has been well documented.³ Yet this is hardly new. Manet's famous impressionist painting, *Le Déjeuner sur l'Herbe*, was derived from a Raphael-like engraving of classical deities made three centuries earlier. Those figures, just as derivative, stemmed from sources dating from ancient Roman art.⁴

Similarly, a composer of music, like a visual artist, "inherits a usable past and acts by intuitive vision. The product of his vision builds on a stylistic heritage, has a style and import of its own and bequeaths an altered heritage."⁵ Many composers have adopted similar melodic fragments in their works.⁶ American composer John Cage, to many the quintessential musical anarchist, explored randomness in music with the throw of the dice—a technique used by Mozart in the early 1800s.

Style in the Visual Arts

In recent years, courts have grappled with the concept of style in the visual arts, applying copyright principles to decide whether works are substantially similar, which is required in order to prove copyright infringement. The fair use doctrine, codified in section 107 of the Copyright Act of 1976, is an affirmative defense to copyright infringement. The doctrine is an equitable rule of reason, which permits the use of another's work in a reasonable manner. The four non-exclusive fair use factors to be considered are:

1. The purpose and character of the use, including whether that use is of commercial nature or is for non-profit educational purposes;
2. The nature of the copyrighted work;
3. The amount and the substantiality of the portion used in relation to the work as a whole; and
4. The effect of the use on the potential market for or value of the copyrighted work.⁷

*Steinberg v. Columbia Pictures Industries*⁸ was a case involving a well-known cover of *The New Yorker* magazine presenting the myopic view of New Yorkers toward the rest of the world. The court did not protect the artist's "hallmark" graphic style as such, but found that "style is one ingredient of expression."⁹

Since the 1994 landmark Supreme Court case *Campbell v. Acuff-Rose Music, Inc.*,¹⁰ courts have increasingly applied the concept of "transformative use" in balancing society's competing interests (i) on one hand, to provide authors with economic incentives to create, and (ii) on the other hand, to permit limited productive uses of their creations.¹¹ By "transformative use," the Supreme Court was referring to a use which is "productive and [uses] the quoted matter in a different manner or for a different purpose from the original."¹² The Supreme Court noted that in applying the fair use factors, the degree to which a defendant's use is transformative is a crucial, but not determinative, consideration.¹³

In a pre-*Acuff-Rose* decision, *Rogers v. Koons*,¹⁴ sculptor Jeffrey Koons was inspired by a picture postcard of a couple holding eight puppies and created a sculpture of the same subject matter for a 1988 exhibition entitled *Banality Show* at a New York gallery. Koons put forth a fair use parody defense, but the Second Circuit, applying the then current fair use analysis, found that "it is not really the parody flag that [Koons was] sailing under, but rather the flag of piracy."¹⁵ It is interesting to speculate whether a court deciding *Koons* today might find that Koons' sculpture was a fair use parody in light of *Acuff-Rose*—first because Koons' sculpture appropriated elements of Rogers' photograph in order to make a point about the banality of modern life, and second, because Koons' sculpture serves a different market than that of Rogers' photograph. Moreover, under *Acuff-Rose*, the fact that Koons created an expensive work of art no longer carries a presumption against a fair use finding.¹⁶

Trademark law has also proved to be a novel alternative to copyright law in protecting artistic style. In *Romm Art Creations v. Simcha International, Inc.*,¹⁷ a New York district court gave the Lanham Act an unusually broad interpretation, finding that the law of trade dress protected a visual artist's style. Copyright law was not even addressed. Describing the application of trademark law to art as "a rarely visited area of the law," the

court held that the defendant's limited edition prints and fine arts posters were "inherently distinctive" in reflecting the visual artistic style of the plaintiff's artist, and that there was a likelihood of confusion.¹⁸ Style, as such, was protected as trade dress. The court found that there was secondary meaning in the "unique and distinctive style and appearance" of the plaintiff's artist and that the works by the defendant's artist were "slavish imitations."¹⁹ While *Romm Art* has been rejected by other jurisdictions,²⁰ it has been discussed by some courts without disapproval,²¹ and continues to be cited in other cases and secondary sources.²²

Where does one draw the line between the expression in a work of art, which is protected by copyright, and the idea, which is not protected? To what extent does a second artist need to transform the style of an earlier work in order to avoid infringing the style of the first artist? *Steinberg* is unique in that the defendant copied not only Steinberg's "hallmark" style, but also his subject matter. In a post-*Acuff-Rose* era, would a representation of a myopic perspective be substantially similar if a second artist produced a scene of another city? What might be the outcome if the work were in a different medium, as it was in *Koons*? Abstract works of art, especially, defy separation into "idea" and "expression." Would Jackson Pollock's legendary dripping technique or controlled randomness of paint on the canvas be considered an idea or expression? Would a canvas painted in only white by a minimalist artist be protected?

Style in Music

Applying copyright principles to musical style may be even more challenging than to visual art. Musical style refers to the characteristics that a particular musical work shares with other works in the same genre or category. Style is distinguished from content in music in a way similar to (i) the manner in which something is said (style) as opposed to (ii) what is being said (content). Because most music is non-representational in nature, this distinction is difficult to sustain or experience. Aside from dramatic works and lyrics, music is an abstract art form, leaving the lay listener with nothing concrete to study or observe after the sounds have faded away. Consequently, musical plagiarism may be seen as more difficult to prove or defend than art plagiarism, in which the visual evidence can be seen and scrutinized by a judge or jury. In other words, for most laymen, music is heard but not seen.

Related to the idea/expression dichotomy in copyright law, the distinction between style and content in music is an important, though often difficult, one to make. Style can have multiple meanings in music. Like style in art, it can refer to an historical era, a geographical location, and a genre. Style can also describe an

individual composer or even one particular work by that composer. The norms established by musicologists to describe a particular style can only be discovered through careful study of individual works and observation of their shared qualities.

As in the case of visual artworks, it can be difficult to distinguish the idea from expression in a musical composition. To a music listener, the line between content and style is blurry, and often indistinguishable. One reason may be the way in which music is experienced. Many elements occur simultaneously while a musical work is being heard. It may be difficult to isolate particular elements in the music in order to tell whether two musical works are substantially similar in content as opposed to style. In comparing two musical works, there can be a great many similarities that are not necessarily due to copying, but rather are dictated by the shared style of the works, analogous to comparing paintings in the cubist style by Braque and Picasso. It is therefore critical to establish whether the similar material is generic or individualistic in nature. Confusion sometimes arises in music because the key elements for determining style and content are the same.

The main elements of musical compositions are: Melody (pitch plus duration), harmony (chords), structure, form and lyrics, if any. The way in which these elements are used determines style, yet the specific elements themselves also determine content. To illustrate, the actual pitch and duration of each melodic note and the succession of melodic notes determine the melody of a musical work. Melody is only one element of the music's content. But the composers' choices in selecting these notes are often dictated by the tradition of the style that they have adopted.²³

For example, in the song "Jingle Bells" in the key of C major, the first three phrases contain the pitches: (i) E-E (ii) E-E-E (iii) E-G-C-D-E. These pitches, and their duration, constitute the melodic content of the opening three phrases of the song, set to the words: (i) "Jingle bells" (ii) "Jingle bells" (iii) "Jingle all the way." Similarly, the chord that accompanies these pitches, which would, in the key of C major be the C major chord, constitutes the harmonic content of the phrases.²⁴ The structure of the song is determined by how many sections the song contains, and whether these sections contain repeated or differing material. In the case of "Jingle Bells," the specific structure is an alternating verse and chorus (refrain) section. While this structure is specific to this song, it derives from the tradition within popular songs of alternating verses and choruses. The lyrics are also part of the content here, but their combination, selection, and even subject matter, are dictated to some extent by the traditional style of Christmas carols shared with hundreds of other songs within the genre. This song exemplifies the marriage of style and content

that challenges attorneys, judges and juries when the need arises to interpret and identify similarities between musical works.

Sometimes the musical content and the process by which it is created are so merged as to be indistinguishable from one another. An extreme example of this phenomenon is a work entitled "4'33"" by the American experimental composer John Cage, who died in 1992. In his endeavor to achieve ultimate freedom in musical expression, Cage produced this piece in three movements, intending that no sounds be produced. Cage wrote his piece after an experiment in soundproofed chambers at Harvard in which he tried to produce pure silence. Realizing that this was impossible, Cage focused instead on the sounds that fill the void, even if the only sound is that of a person's heartbeat.²⁵ The composition requires a performer—usually a pianist, though not specified by Cage—to sit quietly with an instrument for 4 minutes and 33 seconds.²⁶ At its premiere in Woodstock, New York, on August 29, 1952, pianist David Tudor signaled the beginning of each movement (three silences of 30, 143 and 100 seconds) by gently opening and closing the piano lid.²⁷ Subsequently, Cage composed another "silent" piece, "0'00"," presented for the first time in Tokyo in 1962. Any sounds, noises, coughs, chuckles, groans and growls produced by the listeners were regarded as integral to the piece itself, so that the criticism leveled that one could not discuss what could not be heard was invalidated by the uniqueness of Cage's art. Is this content or concept? Idea or expression? Where does one draw the line between content and style, idea and expression, in music?

In less extreme cases, musical rhythm depends on silences as well as sounds. Rests between notes are as much part of the expression as are the notes themselves, and rests do add drama to music. In the case of syncopated Latin dance music, for example, the rests have a powerful presence.²⁸ Few would argue that the rests deserve less protection than the tones in the context of a melodic line. Other works by Cage and his followers involve throwing dice to determine which pitches, rhythms and sections are being performed in compositions referred to as "chance" or "aleatoric" music. In this music, the process becomes the idea, but the idea becomes the content. Perhaps the sheer randomness in Cage's music is analogous to Pollock's dripping of paint on canvas.

Composers have been using randomness to create their music for centuries. Mozart was credited in 1806 in London with devising "Mozart's Musical Game," in which a series of waltzes and other works could be composed by a throw of the dice. Should the music that resulted from this process be defined as an idea or expression? In music that changes each time it is per-

formed, where do the elements of originality and independent creation come in? Is it the idea of the work, for example, the directions to the performers as to the choices offered to them, that is the music itself, or rather is it the sounds that result from their individual choices, ever changing as the work is re-performed? This question often arises in improvisational jazz, where the roles of composer and performer often merge.

If another composer writing after Cage were to write a piece in which a pianist sat on the stage performing nothing for exactly 4 minutes, 33 seconds, would there be a copyright infringement? Arguably so. Would the outcome be different if the later silent work were 4 minutes, 32 seconds (one second shorter than Cage's piece)? Perhaps. If infringement were found, what would the second composer have appropriated—the style or the content of Cage's longer silent work? What if the later silent work were only one minute in duration?

That was precisely the issue in a recent controversy involving British pop music composer and producer Mike Batt. In an album of the Planets, a group of eight musicians that performs popular versions of classical music, Batt introduced a one-minute silence as a divider between acoustical and electronic parts, and called it "One Minute Silence," crediting it to "Batt/Cage."²⁹ Batt sent this album to the Mechanical Copyright Protection Society (MCPS). MCPS credited the work to John Cage. Batt read a small story in the newspaper and was unhappy about the payment of royalties for silence. In response, Peters Edition, John Cage's publisher, produced a concert in London last summer in which the parties performed their respective silent pieces. Discussions continued between Peters Edition and Batt, but the matter never went to court. Both sides gained a great deal of valuable publicity. While Peters Edition received no money directly, Batt made a substantial donation to the John Cage Trust.³⁰ Subsequently, Batt released a single, entitled "One Minute Silence" and registered copyrights on many other silent compositions, ranging in length from one second to ten minutes, including works that are one second shorter, and one second longer than Cage's work.³¹

Whether or not Batt's silence would be considered fair use under *Acuff-Rose* if this case were brought in the U.S. is an interesting question—one that may not settle the score, but surely one that is bound to generate much noise in the future.

Conclusion

It is ironic that the very laws that protect creative artists and their works are also those that they so often thwart. They really cannot help themselves. For it is in the very nature of the creative personality to break

down boundaries, to charge outside the limits and to risk it all for a single moment of expression. As the law rushes to provide yet newer protections and restrictions, creative artists again dare to step outside their protective shield—as they must. And together edge toward their positions: Creator and protector, reluctant allies teetering on their own exquisite high wire.

Endnotes

1. See Ralph E. Lerner & Judith Bresler, 2 Art Law 873 (2d ed. 1997).
2. For a scholarly discussion on artistic tradition and appropriation, see the Introduction to H.W. Janson, *History of Art* (5th ed. 1995).
3. About 40 postcards were recently found in Picasso's archives and exhibited at the Museum of Fine Arts in Houston in a show entitled, *Picasso and Photography: The Dark Mirror*. The postcards are turn-of-the-century images by Edmond Fortier, a photographer based in Dakar, Senegal. They depict West African women "bare-breasted, alone and in groups, balancing bowls on their heads, arms raised or akimbo," which influenced Picasso's works leading up to and including *Les Femmes d'Alger*. Michael Kimmelman, *Photographs that Fed Picasso's Vision*, N.Y. Times, Jan. 11, 1998, at AR 45.
4. Judith Beth Prowda, *Application of Copyright and Trademark Law in the Protection of Style in the Visual Arts*, 3-4 Colum.-VLA J.L. & Arts, 269, 276 (Spring/Summer 1995).
5. *The New Grove Dictionary of Music and Musicians* 316 (1980) (from the definition of "style").
6. This view was illustrated at the keyboard by violinist and composer Albert Markov at a meeting of the Fine Arts Committee of the Entertainment, Arts and Sports Law Section of the New York State Bar Association on Mar. 21, 2002. Mr. Markov played phrases by Beethoven, Tchaikovsky, Rossini, Sarasate and Senaille, demonstrating the same initial four pitches, though in differing rhythms. Judith Greenberg Finell was the speaker at that meeting, addressing the topic, *Musical Style or Content? The Ongoing Challenge for Copyright Advisors and Litigators*.
7. 17 U.S.C. § 107.
8. *Steinberg v. Columbia Pictures Industries*, 663 F. Supp. 706 (S.D.N.Y. 1987).
9. *Id.* at 712.
10. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). The Supreme Court found that the 2 Live Crew rap version of Roy Orbison's "Oh Pretty Woman," was fair use parody. The Supreme Court remanded the case to the trial court to determine whether or not Luther Campbell had excessively copied protectable elements of Orbison's original song. The Supreme Court also required a market analysis as to whether or not 2 Live Crew's rap version harmed the potential market, derivative or otherwise, of the original. Ultimately, the case was settled.
11. See Judith Beth Prowda, *Parody and Fair Use in Copyright Law: Setting a Fairer Standard in Campbell v. Acuff-Rose Music, Inc.*, 17 Comm. & the L. 3, at 53 (1995).
12. Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105 (1990).
13. *Acuff-Rose*, 510 U.S. at 579.
14. *Rogers v. Koons*, 751 F. Supp. 474, 480 (S.D.N.Y. 1990), *aff'd*, 960 F.2d 301 (2d Cir. 1992), *cert. denied*, 113 S. Ct. 365 (1992).
15. *Id.* at 480.
16. *Acuff-Rose*, 510 U.S. at 584.
17. *Romm Art Creations v. Simcha International, Inc.*, 786 F. Supp. 1126 (E.D.N.Y. 1992).
18. *Id.* at 1129.
19. *Id.* at 1136.
20. *Leigh v. Warner Bros.*, 10 F. Supp. 2d 1371, 1382 (S.D. Ga. 1998) (*Bird Girl* sculpture used in the book and movie of *Midnight in the Garden of Good and Evil* was not protectable because "trademark law should not be used to protect [] visual style.").
21. *Hoffman v. Kleinhandler*, 1994 WL 240335 (S.D.N.Y. May 31, 1994) [No. 93 Civ. 568 (PKL)].
22. See Alan J. Hartnick, *Is Artistic Style Protectable?*, N.Y.L.J., Feb. 28, 2000, at 2.
23. Judith Greenberg Finell, *Using an Expert Witness in a Music Copyright Case*, N.Y.L.J., May 4, 11 & 18, 1990.
24. "Jingle Bells," music and words by J. Pierpont, first published under the title, "One Horse Open Sleigh," on Sept. 16, 1857, by Oliver Ditson & Co., Boston. The song was republished in 1859 under the revised title "Jingle Bells, or the One Horse Open Sleigh." James Fuld, *The Book of World-Famous Music* 313 (3d ed. 1985).
25. Matthew Connolly, *Come On, Feel the Silence*, Times (London), July 30, 2002, at 2, 16.
26. *The Concise Edition of Baker's Biographical Dictionary of Musicians* 152-54 (8th ed. 1994).
27. Dan Gilgoff, *Fifty years ago, John Cage played the sound of silence*, U.S. News & World Rep., Aug. 12, 2002, at 38.
28. "Syncopation" is defined as a deliberate disturbance of the normal pulse of meter, accent and rhythm. It results in a "jerky" uneven rhythm that drives the melody onward. George Gershwin's "I Got Rhythm" is an example of a syncopated melody. *Harvard Dictionary of Music* 827 (Willi Apel, ed., 2d ed. 1972).
29. Ben Greenman, *The New Yorker*, *The Talk of the Town*, "Dept. of Derivation," Sept. 30, 2002, at 48. There are precedents for this scenario. Frank Zappa made a recording of "4'33'" for which he paid royalties to Cage. Zappa's point was apparently not whether or not silence can be copyrighted, but whether or not his was actually a performance of Cage's piece. Monahan, *You can't copyright silence—there's too much of it about*, Daily Telegraph (London), Sept. 28, 2002, at 11.
30. *Id.*
31. Telephone interview by Judith Greenberg Finell with Nicholas Riddle, Managing Director, Peters Edition, London, and Executive Chairman, C.F. Peters, New York, Oct. 9, 2002.

Judith Beth Prowda is Chair of the Fine Arts Committee of the Entertainment, Arts and Sports Law Section of the New York State Bar Association. She is an attorney in New York focusing on copyright, entertainment and art law. She is also a violinist with The Lawyers' Orchestra of the Association of the Bar of the City of New York. She may be reached at jbprowda@hotmail.com.

Judith Greenberg Finell is a musicologist and president of Judith Finell MusicServices Inc., a consulting firm in Scarsdale, New York, a suburb of New York City. Ms. Finell has served as an expert witness and consultant in various litigations involving copyright infringement. She may be reached at judifinell@aol.com.

Purple Beasts and Lewd Tunes: Economic Reasoning and Copyright

By Michael A. Einhorn, Ph.D.

This article will apply economic reasoning to illustrate some economic concepts in a number of prominent copyright decisions. I do not wish to suggest that court decisions necessarily comport with economic principles without regard to other considerations. However, economic theory can be used to assess market harm and estimate damages. Moreover, it facilitates ordered thinking, helps conceptualize problems and permits nuanced decisions. Economics would provide no small gain if used more frequently in copyright cases.

Economics is concerned with the production of goods and services, which implicate in copyright law both original works and secondary uses that may be licensed, infringing, or fair use. A key distinction among the infringing uses inheres in the difference between (1) superseding works that directly supplant sales of the original,¹ (2) derivatives² that recast copyright material to a new medium “that creators of original works would in general develop or license others to develop [in] traditional, reasonable, or likely to be developed markets”³ and (3) transformative works that “add something new, with a further purpose or different character, altering the first with new expression, meaning, or message.”⁴ Examples of derivative works include, *inter alia*, abridgements, translations, screenplays and reproductions to new media; transformative works may include parodies, satires, criticisms and news reports.

Each form of infringement may present a distinct market harm to the primary rights owner. Substantially similar copies may supersede direct sales of copyrighted product. Derivative works may interfere with an owner’s actual or potential ability to produce related work or license others to do the same. Transformative works may avoid paying license fees but are less likely to affect adversely direct sales or derivative markets. This article explores the implications of proper economic reasoning in each.

Superseding Goods and Economic Sense

Among superseding goods, two products may be said to occupy the same market if they can reasonably be expected to substitute for one another. In antitrust cases, where the potential for product substitution must be assessed to identify relevant market borders, the Supreme Court held that two products were economic

substitutes if they have similar functional attributes⁵ or positive cross-price elasticity of demand.⁶ Both considerations implicate the tastes of consumers who actually make their products function and respond to changes in respective prices.

Potential market harm in markets generally can be related to market characteristics, product attributes and consumer tastes. Among *extrinsic considerations*⁷ that can be identified in copyright cases, potentially infringing products may be gauged for sufficient similarity to underlying works; extrinsic considerations may include, *inter alia*, product design, material, subject matter, and setting. By contrast, *intrinsic considerations* focus on the response and impressions of the intended audience and therefore entail more subjective considerations.⁸ Intrinsic considerations would include customer demographics, tastes and conceivable responses in differences in quality or price. While the potential for infringement among superseding goods can be found when the two works are sufficiently similar,⁹ the ultimate determinant of market borders in copyright cases must be the anticipated behavior of prospective buyers.

The Ninth Circuit contended in 1976 that extrinsic tests merit analytic dissection and expert testimony, while intrinsic tests cannot.¹⁰ Given the advances in statistical and survey techniques now used in expert testimony, this distinction is no longer valid (if it ever was). Economists, market analysts, psychologists, and other applied social scientists may now deploy technical research procedures to define intended market scope based on anticipated behavior and product overlap. From here, experts can project anticipated responses to the introduction of a similar product.

In 1991, the Fourth Circuit performed a thoughtful market analysis in *Lyons Partnership L.P. v. Morris Costumes, Inc.*,¹¹ where the court heard an appeal of a copyright infringement matter that involved the commercial use of a dinosaur costume that bore a striking resemblance to the famous dinosaur “Barney.” Plaintiff Lyons Partnership owned all intellectual property rights to “Barney” and limited its appearance to actors trained in the proper choreography and behavior for the role. Defendant Morris Costumes operated a costume establishment in North Carolina that rented dinosaur costumes that resembled three characters on the TV show, including a “Barney” model called “Duffy.”

The district court denied the plaintiff's request for injunctive relief and damages.¹² Claims were barred by applicable statutes of limitations and the doctrine of laches, and the court found that the evidence failed to support the idea that Duffy and Barney were sufficiently similar to cause confusion among the adult population that actually rented costumes.

The Circuit Court reversed the lower court on appeal and remanded with instructions that the lower court enter an injunction.¹³ In focusing on the perceptions of the adults who actually rented the costume, the lower court adopted an exclusive focus that was too narrow to the ends of the case.¹⁴ Rather, the lower court should have considered the nature of the intended audience; similarity of child-oriented works "must be viewed from the perspective of the child audience for which the products were intended."¹⁵ The Circuit Court ruled that "the relevant question that courts must ask in determining whether a work has been copied is not whether society as a whole would perceive the works to be similar in an aesthetic sense, but rather whether the works are so similar that the introduction of the alleged copy into the market will have an adverse effect on the demand for the protected work."¹⁶

Considering the intended audience of young children, the evidence confirmed that youngsters often could not tell the difference between Duffy and Barney.¹⁷ If children could not often tell the difference between costumes, purchasing adults could expectedly substitute between the two on a number of occasions.¹⁸ Consequently, "the economically important views are those of the young children . . . Even if adults can easily distinguish between Barney and Duffy, a child's belief that they are one and the same could deprive Barney's owners of profits."¹⁹ Economic damages were also imagined for Lyons' reputation if the actor failed to act in the appropriate "Barney-like" fashion.

This basic approach in market definition was repeated in a similar case resolved in the District of Colorado, *Medias & Company, Inc. v. Ty, Inc.*²⁰ The court here considered two children's products that were similar to Beanie Baby stuffed animals. Using the "abstraction-filtration-comparison" test,²¹ the court abstracted from the infringing product the ideas and concepts not protected by copyright and compared the filtered residual to the original work. Considering again the anticipated emotional responses of young children and the purchasing behavior of their parents, the defendant's products were found to be sufficiently similar to warrant a preliminary injunction.

Both courts pass the litmus test for sound economic reasoning. Each made a studied consideration of market determinants, which include product characteristics,

intended consumers, the practical nature of decision-making and the implicated likelihood of substitution. Each step of the process admits room for important evidence and obliges litigants to undertake as a first step the market definition needed to prove potential damage.

If actual damages are to be measured per 17 U.S.C. § 504, a number of historic cases illustrate the importance of market definition and expected consumer behavior. In *RSO Records, Inc. v. Peri*,²² the plaintiff was awarded total defendant revenues in a counterfeiting case where infringing goods directly competed with originals and a one-for-one sales displacement was reasonably conjectured. In *Stevens Linen Associates, Inc. v. Mastercraft Corp.*,²³ the court found that infringing and original goods were of different quality and refused to rule similarly that all defendant revenues would have otherwise been earned by the plaintiff. In *Manufacturers Technologies, Inc. v. CAMS*,²⁴ the court excluded from compensation infringing sales that would not have otherwise been made since program copies were priced lower than originals. However, the court included additional compensation to allow for damages from negative word of mouth and for a portion of nonavoidable overhead expenses. Each contrasting example exhibits a recognition of actual market reality, as expected by likely substitution and the damages that may result.

Getting It Wrong

If there were a derby among cases where courts failed to consider markets properly, the notorious *MCA v. Wilson*²⁵ would notch a high finish. Appearing in an adult musical *Let My People Come* in the New York nightclub The Village Gate, actors performed and recorded "The Cunnilingus Champion of Company C," which was a bawdy rendition of the famed "Bugle Boy" that used the same underlying melody.²⁶

Upholding the district court, the Second Circuit ruled in 1982 that "Champion" was an infringement after finding that the two songs qualified as competitors in the entertainment field. In the court's economic consideration, both songs were performed on the stage, sold as recordings and sold in printed copies, and were therefore market rivals that could displace one another.²⁷ Testimony, accepted as credible by the trial court, indicated that Champion was made to sound like Bugle Boy to create publicity.

By economic standards, these songs were evidently not competitors among discerning listeners. Real economic competition between two products depends upon the willingness of prospective buyers to interchange them. Judge Mansfield's dissent made the proper points:

The issue is not whether the parody uses the same media as the copyrighted work—most parodies do—but whether it is ‘capable of serving as a substitute for the original’ (A. Latman, *The Copyright Law*, 215 (5th ed. 1979)), which depends on demand and product overlap rather than on the market in which the two products are vended. Applying this correct standard, it is eminently clear that the two works respond to wholly differing demands and that a customer for one would not buy the other in its place. A raucous and explicitly sexual satire is not a substitute for the innocence of Bugle Boy.²⁸

Invoking Latman, Mansfield correctly defined the standard for market competition.

More than a decade later, Alan Katz and Chris Wrinn wrote *The Cat NOT in the Hat*, a book that depicted the events of the O.J. Simpson affair.²⁹ Nothing was taken from original Seuss but trademarked illustrations (most famously, the elongated hat) and the poetic style of the original writer. After the district court enjoined book covers and illustrations based on trademark violations, the Ninth Circuit in 1995 went further on the appeal to establish market harm to the copyright. While Katz and Wrinn took none of Seuss’ words and the plaintiff did not attempt to prove displaced sales, the court inferred market harm to the Seuss estate resulting from commercial harm resulting from damaged goodwill and reputation.³⁰ Unsubstantiated as a practical matter by any empirical evidence, this potential loss was held to outweigh unrecovered expenses that redounded unambiguously to the book publisher.³¹ Here, too, imagined market harm has no relation to likely consumer behavior; there was no evidence presented, nor does it seem likely that the Seuss book would have lost readership or goodwill among its primary intended audience of schoolchildren, teachers and parents.³²

Derivative Works

I do not wish to suggest that infringing works that cannot be demonstrated to supersede or displace original works in primary markets should necessarily be free to use copyrighted material for all conceivable derivative uses. Generally speaking, there is sufficient economic reason to believe that superseding and basic derivative acts may lead often enough to irreparable market harm to justify as proper deterrents the use of injunctions and punitive statutory damages, even at the cost of some suppressed works. Superseded businesses (such as record labels) may be hurt to the core by repeat

infringement, which can be geographically distributed and greatly enabled by digital technology. In this kind of market, economic damages would be difficult for plaintiffs to measure and courts to confirm. Measuring economic damages to copyright owners in actual and potential markets for derivative products would be more difficult still, as these markets may take time to congeal.

The importance of the derivative market for potential licenses was directly recognized in *On Davis v. The Gap, Inc.*³³ Without paying a license fee, the defendant clothing manufacturer created pictorial advertisements where clothing models wore Gap clothing and the plaintiff’s distinctive eyewear, which acted as a central visual draw to the advertisements. The district court granted a summary judgment to the defense, ruling that the plaintiff was not eligible for damages since no sale of eyeglasses or licenses was actually displaced.

After acknowledging that Davis earned no less revenue than otherwise,³⁴ Judge Leval in the Second Circuit considered the additional revenues that would have resulted under a proper license.³⁵ As a legal matter, the court saw no reason why the statutory term “actual damages” should not reasonably cover the market value of the unpaid owner’s fee³⁶ and held that damages—though sometimes estimated through uncertain techniques and counterfactual exercises³⁷—may include estimated unpaid revenues. Indeed, copyright owners have agents who regularly establish license rates that can be readily extended to this purpose.³⁸

Transformative Uses and Reasonable Royalties

In contrast to basic derivatives, the case for enjoining any truly transformative use is questionable for purposes not protected by the present fair use doctrine of 17 U.S.C. § 107. Exemplary transformative uses may include, *inter alia*, parodies that target existing work and satires that use previous works as weapons to target social and political institutions at large.³⁹ Courts now tend to protect some parodies as fair (i.e., uncompensated) uses, while satires more often are not.⁴⁰ In addition to a scholastic distinction, the more important satirical criticisms are the more hindered.

Indeed, a number of prominent legal authorities (including Circuit Court judges Alex Kozinski and Pierre Leval) have suggested that the copyright system is prone to too many injunctions; a feasible alternative system would institute reasonable royalties that courts may mediate or arbitrate.⁴¹ The idea also found its way to the Supreme Court in *Campbell v. Acuff-Rose*, which acknowledged that the “goals of copyright law, ‘to stimulate the creation and publication of edifying matter,’ are not always best served by automatically granting

injunctive relief when parodists are found to have gone beyond the bounds of fair use.”⁴² Moreover, the potential role for reasonable royalties appeared in two major decisions in 2001—*New York Times Co. v. Tasini* and *Greenberg v. National Geographic Society*.⁴³

Though not protected parodies that target original works, both the bawdy reuse of “Bugle Boy” and the tasteless reuse of Dr. Seuss implicated some unique comedic skill. Audiences found both works humorous because they are “dark works” that make a mental connection to well-known public works associated with light entertainment and childhood. The humor of “Champion” and “Juice” then relies upon the existence of their artistic forebears; it is difficult to call this plagiarism, which may suppress demand for the original, or plunder the original entirely.

As a general rule, economies gain from the production of unanticipated new products that no original creator might reasonably have conceived. Both culture and polity benefit when artists and writers can transform images of recognized cultural icons to present, criticize or cast a humorous interpretation on institutions, values, or media presentations.⁴⁴ Finally, there are clear free speech considerations in transformative works that make a satiric or critical point.⁴⁵

The production of transformative products that would enable social gains is now endangered by the two-chamber Russian roulette of the present legal system. Often enough, infringing works are generally enjoined out of existence and fair use works “get published and the copyright owner gets to pay the attorney’s fees.”⁴⁶ However nuanced the fair use doctrine may appear, “all it can do is choose between these two blunt responses.”⁴⁷

From an economic perspective, the uncertainty of the scholastic process in the present law may undermine investments in critical works of real social value, a paramount loss in any democracy. Courts can increase economic efficiency and elevate public discourse by ensuring that transformative works get produced and original owners get paid. Furthermore, so long as copyright owners do get paid, there is no compelling economic reason to continue fair use for any commercial application.

Due to the idiosyncratic applications of transformative works, negotiations in a transformative market will be “one on one” and therefore prone to lengthy process.⁴⁸ As Justice Souter implied,⁴⁹ courts—if empowered—could estimate benchmark royalties to facilitate market exchange. The benchmark solution might have been reasonably applied in *The Wind Done Gone* case, *SunTrust v. Houghton Mifflin*,⁵⁰ where plaintiffs contended that Alice Randall’s new book took

excessively from Margaret Mitchell’s *Gone with the Wind*.⁵¹ Defendants argued that the book was a critique of antebellum slavery and a protected parody. The two federal courts debated seriously whether to issue a preliminary injunction to stop publication.

Had they appropriate authority, the two courts might have actually arrived at a reasonable economic solution. Recognizing that the copyright owners administered a well-established market for licensed derivatives, including two sequels,⁵² the district court stated that “the fair price to be paid for the right to publish a sequel to the work has already been set by two publishers who have agreed to pay, or paid, substantial advances and royalties for the right to create its sequels.”⁵³ If the sequel market does not provide acceptable standards, this author researched hypothetical benchmarks using external data made available by the RoyaltySource Intellectual Property Database.⁵⁴ Illustrative licensing data from RoyaltySource would suggest that characters or plots of existing works are appropriately licensed with royalties between 8 and 10 percent, with negotiable upfronts.⁵⁵

Admittedly, a number of uses may go poorly compensated for lack of a good measure or other relevant evidence (although nothing seems as extreme as the present domain of free use and injunction). However, the licensing vacuum will have opportunity to fill out only if the courts enforce exchangeable property rights. This would provide the greatest opportunity and incentive for owners and agents to “thicken” their licensing operations and would widen the number of comparable standards in any dispute. Indeed, the capacity for a market to fill out a license rate was the topic of another well-reasoned dissent in *Williams and Wilkins Co. v. United States*.⁵⁶

Endnotes

1. *Folsom v. Marsh*, 9 F. Cas. 342 (No. 4,901) (CCD Mass. 1841).
2. 17 U.S.C. § 101.
3. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 592, 114 S. Ct. 1164, 127 L.E. 2d 500 (1994).
4. *Id.* at 579; see also Leval, *infra* note 41, at 1111.
5. *United States v. Du Pont & Co.* 351 U.S. 377, 393.
6. *Brown Shoe Co. v. United States*, 370 U.S. 294, 325 (1962).
7. *Sid & Marty Krofft Television Productions, Inc. v. McDonalds Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).
8. *Id.* at 1164; *International Luggage Registry v. Avery Products Corp.*, 541 F.2d 830, 831 (9th Cir. 1976); *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1, 18-19 (9th Cir. 1933). *Twentieth Century Fox Film Corp. v. Stonesifer*, 140 F.2d 579, 582 (9th Cir. 1944).
9. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250, 23 S. Ct. 298, 47 L. Ed. 460 (1903) (circus posters); *Sunset House Distrib. Corp. v. Doran*, 304 F.2d 251, 252 (9th Cir. 1962) (plastic Santa Claus); *King Features Syndicate v. Fleischer*, 299 F. 533, 534 (2nd Cir. 1924) (doll).

10. *Krofft*, 562 F.2d 1157.
11. 243 F.3d 789 (4th Cir. 2000).
12. *Id.* at 796.
13. *Id.* at 801.
14. *Id.*
15. *Id.*, citing *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731, 733 (4th Cir. 1990).
16. *Id.* at 802.
17. *Id.* at 802-3.
18. *Id.*; *Sid & Marty Krofft Television Productions, Inc. v. McDonalds Corp.*, 562 F.2d 1166 (9th Cir. 1977); *Ideal Toy Corp. v. Fab-Lu Ltd.*, 261 F. Supp. 238, 241-42, (S.D.N.Y. 1966), *aff'd*, 360 F.2d 1021 (2d Cir. 1966) (“Youngsters . . . make their wishes known for the [products] they desire . . . In their enthusiasm . . ., they certainly are not bent upon ‘detecting disparities’ or . . . observing upon inspection such fine details as the point at which the necks are molded.”).
19. *Id.* at 803.
20. *Medias & Co., Inc. v. Ty, Inc.* 106 F. Supp. 2d 1132 (D. Colo. 2002).
21. *Country Kids’ N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1284 (10th Cir. 1996). “At the abstraction step, we separate the ideas (and basic utilitarian functions) which are not protectable from the particular expression of the work. Then, we filter out the non-protectable components of the product from the original expression. Finally, we compare the remaining protected elements to the allegedly copied work to determine if the two works are substantially similar.” *Id.* at 1284-85. *See also Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2nd Cir. 1930), *cert. denied*, 282 U.S. 902, 51 S. Ct. 216, 75 L. Ed. 795 (1931) (“Upon any work, . . . a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out . . . There is a point in this series of abstractions where they are no longer protected, since otherwise [the copyright owner] could prevent use of his ideas.”).
22. 596 F. Supp. 849, 225 U.S. P.Q. 407 (S.D.N.Y. 1984).
23. 656 F.2d 11, 210 U.S. P.Q. 865 (2d Cir. 1981).
24. 728 F. Supp. 75, 15 U.S. P.Q.2d 1623 (D. Conn. 1989). *See also Regents of the Univ. of Minnesota v. Applied Innovations*, 685 F. Supp. 698, 5 U.S.P.Q. 2d 1689 (D. Minn. 1987), *aff'd*, 876 F.2d 626 (8th Cir. 1989).
25. *MCA v. Wilson*, 677 F.2d 180 (2nd Cir. 1982).
26. *Id.* at 184; 425 F. Supp. at 448.
27. 677 F.2d at 185.
28. Mansfield, Dissent, *Id.*, 188-190.
29. *Dr. Seuss Enterprises v. Penguin Books* 109 F.3d 1394 (1995).
30. *Id.* at 1403.
31. *Id.* at 1406.
32. The Seuss decision is criticized in T. Ochoa, *Dr. Seuss, The Juice, and Fair Use: How the Grinch Silenced a Parody*, 45 J. Copyr. Soc’y 546 (1998); G. K. Jung, *Dr. Seuss Enterprises v. Penguin Books*, 13 Berkeley Tech. L.J. 119 (1998); M. L. Shapiro, *An Analysis of the Fair Use Defense in Dr. Seuss Enterprises v. Penguin*, 28 Golden Gate U. L. Rev. 1 (1998); J.M. Vogel, *The Cat in the Hat’s Latest Bad Trick*, 20 Cardozo L. Rev. 287 (1998).
33. 246 F.3d 152 (2nd Cir. 2001).
34. *Id.* at 166.
35. “It seems entirely reasonable to conclude that the owner has suffered damages to the extent of the infringer’s taking without paying what the owner was legally entitled to exact a fee for.” *Id.* at 165.
36. *Id.*
37. *Id.* at 166–67.
38. *Id.* at 167.
39. *Campbell v. Acuff-Rose Music*, 510 U.S. 579.
40. *Id.*
41. P.N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1132 (1990) (“there may be a strong public interest in the publication of the secondary work [and] the copyright owner’s interest may be adequately protected by an award of damages for whatever infringement is found.”); A. Kozinski & C. Newman, *What’s So Fair about Fair Use?*, J. Copyr. Soc’y 513, 525 (2000) (“The best way to promote production of valuable intellectual works is to give authors and inventors the ability to demand and receive compensation for the values they create. . . . The best way to do this is to grant property rights that give their products exchange value.”).
42. *Campbell*, at 578, n.10.
43. The Supreme Court concluded in *New York Times Co. v. Tasini*: “If necessary, the court and Congress may draw on numerous models for distributing copyrighted works and remunerating authors for their distribution.” 533 U.S. 483, 519; 121 S. Ct. 2381, 2393-4; 150 L. Ed. 2d 500, 541 (2001). In *Greenberg v. National Geographic Society*, the Eleventh Circuit remanded to the district court: “In assessing the appropriateness of injunctive relief, we urge the court to consider alternatives, such as mandatory license fees, in lieu of foreclosing the public’s computer-aided access to this educational and entertaining work.” 244 F.3d 1267, 1276 (11th Cir. 2001).
44. For example, “the referent in Post-Modern art [Jasper Johns’ flags, Andy Warhol’s soup cans] is no longer nature, but the closed system of fabricated signs that make up our environment.” N.A. Voegtli, *Rethinking Derivative Rights*, 63 Brooklyn L. Rev. 1213. An economic discussion of appropriation art appears in W. Landes, *Copyright, Borrowed Images, and Appropriation Art: An Economic Approach*, J. of Leg. Stud. (2001). *see also Rogers v. Koons*, 960 F.2d 301; *United Feature Syndicate, Inc. v. Koons*, 817 F. Supp. 370; and *Campbell v. Koons*, 91 Civ. 6055.
45. The Supreme Court held that restraining the form of expression by enjoining transformative work suppresses content as well. *Cohen v. California*, 402 U.S. 15 (1971).
46. *Id.*
47. *Id.*
48. From an economic perspective, bargaining difficulties may recede when markets are “thick”; i.e., populated by many buyers and sellers and/or subject to a repetitive process that can discipline behavioral frictions that interfere with efficient exchange. Hagglng, holdout, cheating and other transactional difficulties are more likely when markets are “thin.”
49. *Campbell v. Acuff-Rose Music*, 510 U.S. 579.
50. 268 F.3d 1257 (11th Cir. 2001).
51. *Id.* at 1259.
52. *SunTrust Bank v. Houghton Mifflin*, 136 F. Supp. 2d 1357, 1363 (2001).
53. *Id.* at 1373-4, n.12.
54. A professional service provided by AUS Consultants, Moorestown, NJ (<http://www.royaltysource.com>). Reported information in the RoyaltySource database is gathered from public financial records, news releases, and other articles and references. The service also publishes the Licensing Economics Review. I am indebted to David G. Weiler, Managing Director, for facilitating the use of the RoyaltySource database.
55. In 1999, Brighter Child Interactive acquired rights to use the characters from the television program “Adventures with Kanga

Roddy" in connection with its interactive software production. In 1997, Kideo Productions Inc. acquired the rights to publish personalized storybooks using Disney Standard Characters for a \$25,000 upfront and a 10 percent royalty rate. The license contract specified a \$20,000 upfront payment plus a royalty amount based on 8 percent of net revenues. In the same year, ClubCharlies.com Inc. acquired screenplay rights to an original story plot entitled, "The Misadventures of Charlie Chance"; rates were \$150,000 upfront and 10 percent of net revenues.

56. 487 F.2d 1345 (Ct. Cl. 1973). The decision held in 1973 that photocopying by the defendant's National Institute of Health and National Library of Medicine was fair use because it was unclear "whether a . . . clearinghouse system can be developed without legislation, and if so whether it would be desirable." *Id.* at 1360-61. In his dissent, Chief Judge Cowen argued that a plaintiff award "may very well lead to a satisfactory agreement between the parties for a continuation of the photocopying by the defendant upon payment of a reasonable royalty to plaintiff." *Id.* at 1372.

Michael A. Einhorn (meinhorn@lecg.com) is a Principal in the New York office of LECG, where he is active in Media, Entertainment, Intellectual Property, and Antitrust. He is also an Adjunct Professor of Communications and Media in the Graduate School of Business at Fordham University, a Research Fellow at the Institute of Tele-Information at Columbia University, and a frequent lecturer in Continuing Legal Education programs. He has testified, counseled, published articles, or lectured on music rights, fair use, data mining, damages, valuation, hyperlinking, file-sharing, and digital rights management. An earlier version of this paper was presented to the Section for Intellectual Property Law, American Bar Association, June 29, 2002.



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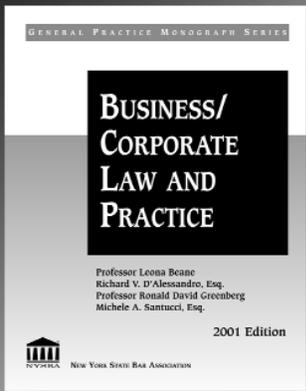
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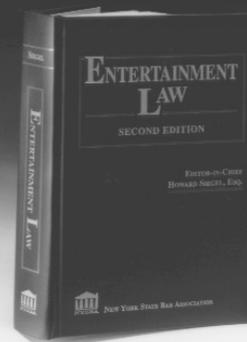
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Broadcasting and Cable

Douglas P. Jacobs
600 Third Avenue
New York, NY 10016
(212) 973-8910

Copyright and Trademark

Alan J. Hartrick
150 East 42nd Street, 26th Floor
New York, NY 10017
(212) 949-9022

Fine Arts

Judith B. Prowda
15 West 75th Street, Apt. 5C
New York, NY 10023

Legislation

Steven H. Richman
32 Broadway, 7th Floor
New York, NY 10004
(212) 487-5338

Literary Works & Related Rights

Jay Kogan
1700 Broadway
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Litigation

Peter A. Herbert
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New York, NY 10110
(212) 921-8399

Membership

Elisabeth K. Wolfe
25 Central Park West, Apt. 4E
New York, NY 10023
(917) 769-4339

Motion Pictures

Mary Ann Zimmer
40 West 57th Street, Suite 2104
New York, NY 10019
(212) 974-7474

Music and Recording Industry

Daniel C. Marotta
277 Broadway, Su. 1310
New York, NY 10007
(212) 349-1200

New Technologies

David G. Sternbach (Co-Chair)
235 East 45th Street
New York, NY 10017
(212) 210-9791

Kenneth N. Swezey (Co-Chair)
40 West 57th Street, 21st Floor
New York, NY 10019
(212) 974-7474

Pro Bono

Elisabeth K. Wolfe
25 Central Park West, Apt. 4E
New York, NY 10023
(917) 769-4339

Professional Sports

Ayala Deutsch
645 5th Avenue
New York, NY 10020
(212) 407-8696

Programs

Kenneth A. Nick
600 5th Avenue, 4th Floor
New York, NY 10020
(212) 313-2416

Publications

Elissa D. Hecker
711 3rd Avenue
New York, NY 10017
(212) 834-0156

Rights of Publicity, Privacy and Merchandising

Joshua R. Bressler
125 Broad Street
New York, NY 10004
(212) 558-7393

Theatre and Performing Arts

James Henry Ellis
36 Butler Road
Scarsdale, NY 10583
(914) 725-5514

Young Entertainment Lawyers

Jennifer Unter
101 W. 73rd Street, Apt. 3A
New York, NY 10023
(212) 541-8641



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Entertainment, Arts and Sports Law Section
New York State Bar Association
One Elk Street
Albany, NY 12207-1002

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Entertainment, Arts and Sports Law Journal

Editor

Elissa D. Hecker
The Harry Fox Agency, Inc.
711 3rd Avenue
New York, NY 10017

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