

Images of Fair Use: A Fair Use Jury Trial

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In August 2006, a federal jury found in favor of the *San Jose Mercury News* in a struggle over the fair use of photographs in newspapers. The struggle arose because of a long-standing practice of the *Mercury News*, and many other major newspapers, of copying photographs from books to illustrate reviews of those books without seeking permission from the publisher or photographer. The case was *Christopher R. Harris v. San Jose Mercury News*, Case No. C 04-05262 CRB.

The case centered on a photograph of Walker Percy taken by Christopher R. Harris, a photographer and photojournalism instructor. Harris snapped the photo while on assignment for *Esquire* magazine in 1982. The photo had previously been published, but in April 2003 it was reproduced in a book by Paul Elie entitled *The Life You Save May Be Your Own: An American Pilgrimage*. The book was about four prominent American Catholic authors, including Walker Percy. Harris's agreement with Elie specified that the photograph could not be used for promotional purposes. (A copy of the photograph appears on the photographer's website at www.southernfineprints.com.)

southernfineprints.com.)

The book was sent to the *Mercury News*, and the *Mercury News* decided to review it. The plaintiff's photo was one of about forty photographs in the book. To illustrate the review, the *Mercury News* reproduced four photographs from the interior of the book, including Harris's photograph of Walker Percy. The version of the Percy photograph used in the review was significantly cropped from Harris's original. The Percy photograph was attributed to Harris in the review, but the attribution did not include a copyright symbol (©), which had accompanied the photo credit in the book.

Harris sued, asserting copyright infringement, violation of section 1202 of the Digital Millennium Copyright Act (removal of "copyright management information"), and unfair competition claims. The *Mercury News* raised defenses of fair use, invalidity of the copyright registration, and implied license. As the result of a variety of pretrial and trial motions, the case was submitted to the jury exclusively on the issue of whether the *Mercury News*'s copying of the photo for the review was fair use.

The case presented the challenge of

explaining to a jury both the importance and the complexities of the fair use doctrine. The *Mercury News*'s closing argument encapsulates the themes of the trial and our efforts to explain a subject that often puzzles, and sometimes produces conflicting responses from, even experienced copyright attorneys. The focus of the closing argument was, therefore, on the importance of fair use and its presence in the daily lives of the jurors. It was vital to make the issues presented by the case as concrete as possible for the jury. To bolster the impact of the arguments, we used a series of images to depict in visual terms what the effect of an adverse decision would be. The following is an edited version of the closing argument (excerpted from the court reporter's transcript).

One unique aspect of this case was the order of closing argument. The court found that there was no dispute as to the elements of infringement: a valid copyright and copying. Noting that the burden was on the *Mercury News* to establish the affirmative defense of fair use, the court reversed the usual order of argument, allowing the defendant to address the jury first and last.

Closing Argument

MR. BOSTWICK: Thank you, your honor.

What I want to make sure you understand, I think, more than anything else, is how important this case is for a lot of

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other people that aren't in this room.

There's an incredible amount riding upon your decision here. Many people are very concerned about what fair use is in our world. And it's extremely important because every modern culture, every society, has adopted some form of copyright protection balanced off against fair use.

And there is no way to have copyright protection that is complete without fair use. Every society has decided in their own way what that balance is, and you are here today helping decide what that balance is in this particular set of circumstances.

I didn't want you to think that it was just a question of the *Mercury News*'s interests and Mr. Harris's interests. What fair use is matters to all of us all the time.

Now, what we would have in our lives if we had copyright and no fair use would be something that you probably don't even think about on a daily basis. Let's see one.

[*The jury was shown a three-panel reproduction of a Calvin and Hobbes cartoon in which a five-year-old boy yells at a television set because of its shallow news coverage.*]

This is a cartoon my children and I used to talk about—Calvin and Hobbes. Very philosophical. Even today if I see something and I think it an interesting idea—and I think this cartoon is, I think that's an interesting idea—I copy it, and I send it to my children.

And I say to them, "This reminds me of . . ." or "What do you think about this?" or "This is what's going

on.” I copy it, and I have; if there’s no fair use, I can’t even put [this] up on this screen today, really. Fair use is something that we do all the time. . . .

Happy Birthday

Now, not too long ago a friend of mine wanted to send something to their grandmother, and she was in a home somewhere in the East Coast. They wanted—her birthday was coming up, her ninety-fifth birthday—they wanted to send something to her to show that everybody was thinking of her and so forth.

They got around a tape recorder, and they sang the song “Happy Birthday” to their grandmother, and they sent it off. They copied and performed “Happy Birthday.” It’s copyrighted; those lyrics are still copyrighted.

You don’t think about that. They didn’t think about that. They didn’t call their lawyer; they didn’t call management; they didn’t try to find out if it was okay.

We all know that’s okay. We know it here, we feel it here. [*Gestures to the heart.*] We understand fair use in our very hearts because we do that kind of thing all the time. Nobody ever said to them, “Hey, watch out! It’s copyright infringement!” But it was if there’s no fair use.

TiVo and Fair Use

Let’s see. The TiVo. I don’t know how many of you are TiVo’ing things, but you’re copying without fair use; your TiVo basically disappears because you’re not supposed to be copying someone else’s creative work. Did you think about that?

Did I think about that? No. We all do it because we know we can do it; we don’t call our lawyers ahead of time.

Let’s look at this review.

[*The jury was shown a blown-up version of the page from the Mercury News showing the review that precipitated Harris’s lawsuit. Approximately one-quarter of the page featured photographs of the subjects of the Elie book (Walker Percy, Dorothy Day, Thomas Merton, and Flannery O’Connor).*]

Without fair use, this is what happens to the review.

[*The jury was shown the same page from which the photographs and the*

quotations from the text of the book gradually disappeared.]

The picture disappears. Those pictures disappear. They’re all gone, and then the quotes are [gone] from the book. They all disappear.

Culture and Fair Use

Without fair use, we cannot talk about our own culture. We can’t talk about anything that is copyrighted in a meaningful way. And what fair use is about is to give us a chance to discuss, to report, to give news of, to criticize, to satire—make satire, a parody—about what’s going on all around us. . . .

So the point here, I think, is that one of the things that we’re asking you to do is to help those people who need the help so that they’re not concerned about this kind of situation, so they’re not concerned that it might be considered copyright infringement and it might not be fair use. We need a clear statement that it is fair use.

I want to talk a little bit, if I can, about the jury instructions. They get read fairly quickly, and, I think, it’s worthwhile to go through them. . . .

If I woke up this morning and sang to my friend at breakfast, “Oh, What a Beautiful Morning,” I’m performing a copyrighted song.

It’s ludicrous to say that would be copyright infringement. We all know that, but that’s what copyright infringement would be if it were all by itself.

Reasonable Under the Circumstances

Now, let’s look at fair use. Fair use starts off with a very long jury instruction—that’s number twenty. I particularly want to call to your attention. . . . [I]f you’re the owner—excuse me, . . . not the owner—of the copyright, that’s the *Mercury News* [and in] some cases all the rest of us, [you] may use the copyrighted work in a reasonable way under the circumstances.

That’s where the balancing comes in. What does *reasonable* mean? That’s what you’re here to decide. Was it reasonable that the *Mercury News* did what they did, and was it under the circumstances reasonable? You can do it without the consent if it would advance

the public interest.

Advancing the public interest means making a culture move forward, recording, reporting to the public about things that are of interest to them. Not just things [they might be] curious about, but things that are important to know that advances the public interest and in every respect. . . .

These are Mr. Harris’s words—this is what, I think, the jury instruction means when it’s talking about advancing public interest—Mr. Harris’s words from his text: “Visual reporting is the marriage of words, images and designs to convey information. The mission of the visual journalist is to tell readers what the information means.” The photos with the review were a marriage with the text to tell the readers what the information means. That advanced the public interest.

“Today’s visual journalist understands that words and pictures form an equal partnership that can deliver the meaning of the complex issues to readers and viewers.” So, what I think Mr. Harris is saying here is that photographs provide meaning and, with the text, combine to give a message. The use of photographs in a book review is, if nothing else, to give a message about a book criticism, comment. . . .

Fair use of copyrighted work, including such use by reproduction by other means for purposes such as that means this. We’re going to give you a few examples. The law gives you some examples. Criticism, comment, news reporting, teaching, scholarship, or research.

So what you’re going to be asked to do is to say, “Well, was this news reporting? Was it criticism? Was it commentary to marry those photos to the text?”

I think it was. It was news reporting. It was also commentary. . . .

The next thing in that particular instruction is that there’s going to be four steps. We’re going to go through each one of those four steps. Got one, two, three, four things you’re supposed to look at. . . .

This is very important because it drives students, lawyers, writers, and everyone else dealing with fair use nuts.

Really does. It's not as if you look at all four factors, and you say, "Well, factor one, that goes this side; factor two, this side; factor three, this side; factor four, that side. That's three to one." You can't give a score to number one, a score to number four. You can't do any of that. You have to do what it says here. In order to determine whether fair use applies, you must balance the various fair use factors. None is definitive or determinative. . . .

Purpose and Character

So, the first factor: the purpose and character of the use. And in evaluating the purpose and character of the use, you have to see whether the use was commercial or whether it was transformative.

And it's clear that if it was not commercial, weigh that in favor of fair use. Nobody can say the *San Jose Mercury News* was not sold. It certainly was sold, and certainly they hope to make money; but they didn't use this photo to make money. They didn't try to make money with the photo. It was not something that was added, like "We're going to sell more of these issues if we put this photo in."

You heard Mr. [Charles] Matthews [*book editor for the San Jose Mercury News*] say he hardly knows exactly what the budget is for photography. His whole idea—and Mr. [Steve] Wasserman [*former book editor of the Los Angeles Times; current head of the New York office of Kneerim & Williams, a literary agency; and expert witness for the Mercury News*] said the same about newspapers who consider themselves to be top-class newspapers, who do book reviews [and] want to do a good job at it—is that they want to illustrate so that their readers understand what's in the book.

That's not a commercial use in that sense of the word. Even though nobody can deny—the *Mercury News*, you don't get for free on the stand. . . .

See this right here about commercial use: it says you should decide whether the defendants stood to profit from the use of the copyrighted photograph.

If a voice came out of the blue to Mr. Matthews and said "Charles, I'm warning you, there's one photograph you

shouldn't use," and he didn't use it, do you think it would have meant any less profit to the *Mercury News*? It wouldn't have. The fact is that they didn't profit from the use of that one photograph.

Is It Transformative?

Now, how do you figure out whether it's transformative? It means if you take it and you use it in a way that is different than its originally intended use. Whether the reproduction merely replaced the original creation. I burn a DVD, I burn a CD, I hand it to you—I'm just replacing what you could have bought. But if I do something different with it—I add something new, a further purpose or a different character—I alter the original use with new expression, meaning, or message.

The book review's use of the photograph wasn't the same as Mr. Harris's. Mr. Harris's photo was for *Esquire* magazine. He carried along a black and white camera with him, and he took one for himself.

And he sold the color photos to *Esquire*, and then this was a work of art. It was something for aesthetic purposes. It was a piece to be looked at, to enjoy for the art of it. When it was used in the *Mercury News*, it was to illustrate a book review and who was in it and what pictures were [in] it. It was a very different use.

I just read your testimony that shows you Mr. Harris will admit the *Mercury News* didn't even use the essential parts of the photograph. . . . He said, "Look, I don't like it when your eye strays off the photograph, so I did certain things. I got a black line under here. I put this over here. It's very important because otherwise your eye will stray off the photograph, so I placed it there. That's art. There's a lamp over there, there's a hallway here, there's this down here—all of that is there for artistic reason."

[*The jury was shown a PowerPoint slide of the original photograph that appeared in the 1982 Esquire magazine article.*

Show the cropping.

[*The jury was shown the version of the photograph that appeared in the Mercury News, which was cropped (as*

it had been in Mr. Elie's book) and did not include the lamp, the hallway, or the fireplace below the mantle.]]

This is what we've got. Right there is the photograph on the left, and it's the original with lamp and all the pieces Mr. Harris says are important. And now you got the one on the right that is the photograph the way it appeared in the *Mercury News*. What has happened is all of the things that Mr. Harris said were important to his art, all of the things that he chose, are gone.

That's because the *Mercury News* wasn't doing it for the same purposes; they were doing it for a very different purpose. They were combining it with three other photos so that they could show the essence of who those four people were that were being dealt with in the book. They wanted to give to the readers information about the book.

Mr. Harris used artistic tricks of the trade that [are] not used in the *Mercury News* because they didn't have the same purpose at all.

Nature of the Work

Now, let's move to the second factor. The second factor—this is maybe the hardest one of all—says it's the nature of the work. In evaluating the nature of the photograph, you consider whether the photograph is factual or creative in nature and whether the work has been previously published.

The evidence is very clear on number two: it had been previously published, at least 290,000 times before. That weighs against fair use—excuse me, for fair use. If it's been published that much, then it weighs for fair use.

Now, whether the photograph is factual or creative is a different point. Harder to figure out, I think. But Mr. Harris says it was creative.

Mr. Harris says on the stand it was creative, but in his book he calls it [an] environmental portrait. . . . He says, "This is an environmental photo, the one I took of Mr. Percy." And he says, "Environmental portraits have as a basis the same quality as the mug shot. That they are representative of who the subject is with the additional artistic aspect of being more creative and infor-

mational, not only of the subject, but of what the subject does or represents.”

That sounds like factual to me. Sounds a little more creative than a mug shot. Even Mr. Harris says it’s a little more creative than a mug shot, but that’s about all. . . .

Amount and Substantiality

Let’s look then at number three. This is a third factor. Again, it’s not easy—the amount and substantiality of the portion used. In evaluating this factor, you’re to consider, among other things, whether the defendant copied the essential elements of the plaintiff’s photograph. The use of an entire copyrighted work does not preclude a finding of fair use, although it may be considered.

You heard Ms. Kalra at the beginning in the opening say they copied the entire photo.

We showed you the cropping. We read you the testimony of Mr. Harris. They didn’t copy the whole thing. And even Mr. Harris complains about the fact they cropped it from the book, so it was cropped once to get into the book, cropped again to get into the *San Jose Mercury News*. But even if they had used the whole thing, that doesn’t by itself mean it’s not fair use.

So the amount [and] substantiality—well, we already saw that looks like they used about 40 percent or 50 percent. But the question is, “Did they use, did they take, the essential elements?”

If you listen to Mr. Harris, they didn’t take the essential elements because they left out all his stuff, his art, his tricks of his trade. They left that out. They were just trying to show what kind of people and what kind of photographs were in the book.

Degree of Harm

Let’s look at the fourth factor, maybe the most difficult of all but also . . . , in some way, the most helpful. In evaluating the effect of the defendant’s use—that’s the *Mercury News*’ use—on the potential market for the photograph, you should consider, among other things, any harm caused by this particular action of the defendant. . . .

The evidence is that he didn’t sell

this photograph often. He was trying to sell it; he would have sold it; he sold licenses to it every time he was asked; he never held it back. He gave it to a book publisher in order to be published on the cover of a book knowing it would be reviewed that way. So the point really is, in all the evidence what you see is that there was no harm by the *San Jose Mercury News*. Mr.

[William] Turnage [*managing trustee of the Ansel Adams Publishing Rights Trust and expert witness for the Mercury News*] and Ms. [Amanda] Doenitz [*independent photography appraiser and expert witness for the Mercury News*]—they say if there was anything, might have been a little help.

And even Ms. [Jane] Kinne [*photographic licensing agent and expert witness for Harris*] says that there wasn’t really any harm to it. If you listen carefully, the fact is that you can’t suddenly just say that there was some value in this photograph that was taken from me because they published it in a review without my permission. You can’t just claim that and then not show any evidence and just speculate as to how much it could have been worth. . . . So the question is, “When you’re looking at it, did it harm the potential market?” The overwhelming evidence is, and if you look at the experts you’re going to see, that there was no market beforehand, and there was no market afterwards.

To talk about rarity simply makes no sense at all. You may recall that I said to him, “Has anyone at all said to you, ‘I don’t want the buy that photograph because it appeared in a book review in the *Mercury News*.’?” He said no.

There’s no evidence of any kind that anybody has said anything to him, to Ms. Kinne, or anyone else that they thought the photograph was worth any less because it appeared in the *Mercury News*. . . .

Importance of the Case

I started by saying to you that it’s a very important case. The reason is that if you should find that this wasn’t fair use, then the fact is that there are many, many people who will become as timid as those who now are afraid to exercise

their rights to use photographs for the discussion, commentary, and criticism that we need so much in our society to be able to share the culture that we have in common. And if we can’t under these kinds of circumstances, where he has not been harmed—if he prevails and it becomes normal that what the *Mercury News* did is not fair use—then this is a lose-lose case. . . .

So what it means is that you’re going to take away—just like you saw the disappearing photos in the review—you are going to take away the possibility of people, not only in book reviews, but in reviews about products and cars and DVD recorders and devices of all kinds: they will not be able to use for fair use purposes an image of some sort without getting permission every time. . . .

And you if allow people to do that kind of thing, then we are much poorer as a society for it. Because we have to be so careful now about what it is we can actually discuss.

I don’t think anybody stopped me from sending the Calvin and Hobbes cartoon, copying on my Xerox and sending it to my children. I don’t think anybody is going to come and take your TiVos out of your house. But I do think you have to take into account that what he’s really saying is it’s his, and he’s the only one that can use it and talk about it and transform it and discuss it and report on the news about it and criticize it. That just is not the way our country has been run, nor should it be run that way.

Thank you.

Plaintiff’s Closing Argument

Mr. Spanner gave a closing argument that stressed that the case was about the *Mercury News*’s failure to obtain permission—not simply about its failure to pay—thereby depriving photographers of the ability to control how their work is used. He emphasized the absence of any direct commentary or criticism on the photograph itself and argued that the purpose of using the photos was simply to provide pictures of the authors discussed in the book review.

He addressed each of the fair use factors, arguing that the *Mercury News*’s use was commercial and not at

all transformative because it had simply copied the photograph from the book for the same purpose, i.e., depicting Mr. Percy. He asserted that the photograph was highly creative and that the version that appeared in the newspaper was immediately recognizable as the same image as the original. He argued that the *Mercury News* used photographs without seeking permission because it could not afford to pay for them. He stressed that under the fourth fair use factor, the effect on the market, what mattered was not just what the *Mercury News* had done, but what would happen if all newspapers did the same. He claimed that would have a devastating effect on the market for Harris's photograph. He asserted that the fact that Harris had only sold two prints of the photograph and had only licensed it a few times was not the result of a lack of a market, but because Harris was "holding back" the photograph to be part of a special collection of photographs offered for sale late in his career.

After the plaintiff's closing, the *Mercury News* gave its rebuttal. Although the rebuttal made several points in response to the plaintiff's arguments, the first few moments of the rebuttal were the most important. Therefore, the *Mercury News* once again returned to the central theme of the importance of fair use, using another image to illustrate this point—this time, Harris's own photograph.

The Rebuttal

MR. BOSTWICK: Sometimes you hear things said in court that you just marvel at. Only sold two photographs because he was holding it back? I can't believe

that they're actually saying that.

If you look at Exhibit 87, it's a letter to Bob Giroux, it's in 1990, and he says, "If you know anyone who wants this, please let me know." That's not holding it back. He tries to minimize that because he says, "I'm not opening it up to a big market." But he wasn't trying to hold it back. It's just hypocrisy to say something like that.

The reason only two sold is because only two people wanted to buy it. He wasn't holding it back. Every time someone asked for it, he gave it to them; and he gave it to them when he knew it was going to be republished on the front of a book and that that front of the book would be republished again by a review. Holding it back? It's almost insulting to hear something like that.

But the best evidence that he doesn't believe much of what he says is the fact that he himself made use of the concept of fair use in this very photograph.

Can we see the disappearing portrait?

This is why I read these things and asked him these questions. That is a work of art. [*The jury was shown Harris's photograph in which Walker Percy is standing in front of a portrait of himself; Mr. Bostwick pointed to the portrait of Percy.*] It's in the background. It was created by someone. That person has the exclusive right to control copying and reproduction. Mr. Harris has reproduced that portrait. That is, if there's no fair use, that is copyright infringement. Using that portrait without fair use would be copyright infringement.

When I asked him why he did it, he said he didn't have to have permission. He didn't ask the portrait painter for

permission; he said he didn't need it. And I asked him why. You may remember why. He said, "Because it was for editorial purposes." What does that mean? What was he meaning? Without being able to admit—to say—that it was, it was fair use. That's why. Because he transformed it, right? But the fact is that if fair use didn't exist, that's what the photograph would look like. [*The jury was shown a copy of the photograph of Walker Percy in which the portrait disappeared and was replaced with a blank white hole in the shape of the portrait.*]

The whole point here is that in order to be able to take photographs like that, you've got to depend upon fair use. He's copied someone else's work, and he's trying to make money on it. . . .

The Verdict

The jury deliberated for only thirty-seven minutes before concluding that copying photographs from books for use in reviews was fair use.