

Fair or Foul? Mass Digitization and the Fair Use Doctrine

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I. Introduction

In 2004, Google announced an audacious program, Google Books,¹ to scan the library collections of Harvard, Stanford, the University of Michigan, the University of Oxford, and the New York Public Library and make the collections searchable online.² Google neither sought permission from copyright owners before scanning these works, nor limited the scope of the program to public domain works. Instead, it permitted authors who wished their works to be excluded from the program to “opt out” by identifying the works in question and providing Google with “a small amount of information” about themselves.³

The program envisioned that, once scanned, books would be integrated into an electronically searchable index. A user searching the index would receive a list of links of books responsive to his or her query. Clicking on the link for a particular book would call up information about the book and display relevant excerpts (“snippets” – several lines of text) from the book. In the case of a public domain book, the user would be able to read the entire book online. “Buy This Book” links would direct the user to retail sellers of the book, and the user would also be able to search for libraries holding the book in their collections. The index and search function would be free to users, but Google would collect revenue from advertising appearing on the web pages. Google also agreed to provide each participating library with one digital copy of each scanned book for the library’s use.

Heated debate ensued in the publishing and copyright communities over the legality of the project. Supporters hailed the project as the digital equivalent of trying to recreate the Library of Alexandria. Detractors vilified Google for engaging in what, in their view, amounted to willful copyright infringement on a massive, unprecedented scale. Google defended the program on fair use grounds,⁴ emphasizing the benefits to the public of being able to search for

¹ Google’s press releases and other statements about the program and related elements variously refer to it as Google Books, Google Print and the Library Project. For ease of reference, this paper will use the term “Google Books” to refer to the scanning program and related elements.

² “Google Checks Out Library Books,” at http://www.google.com/press/pressrel/print_library.html (Dec. 14, 2004).

³ “Information for publishers and authors about the Library Project,” at http://books.google.com/googlebooks/publisher_library.html (last visited Mar. 29, 2012).

⁴ “Google Print and the Authors Guild,” at <http://googleblog.blogspot.com/2005/09/google-print-and-authors-guild.html#!/2005/09/google-print-and-authors-guild.html> (Sep. 20, 2005).

and locate books across entire library collections – including out-of-print books and books that were previously only available in far-flung locations. Google underscored the fact that the program would direct users to retailers where they could purchase books, thus “expand[ing] the market for authors’ books, which is precisely what copyright law is intended to foster.”⁵

In 2005, the Authors Guild – an authors’ trade association – and several individual authors filed a class action lawsuit against Google for copyright infringement as a result of Google Books.⁶ In 2008, the parties announced that they had reached a settlement. The settlement consisted of two elements: (1) a release for Google’s past conduct in scanning, indexing and displaying “snippets” of copyrighted books, and (2) permission for Google in the future to reproduce, display and distribute copyrighted books deemed “out of print” in a variety of new commercial products. The court conducted a fairness hearing – required in a class action – and ultimately rejected the settlement, finding that the second element, future permission to exploit “out-of-print” books, established forward-looking business arrangements that far exceeded the dispute before the Court.

During this time, commentators and stakeholders have continued to engage in vigorous debate regarding the applicability of the fair use doctrine to Google Books. Fair use is a complex, often contradictory, sometimes maddening area of copyright law. This paper will address fair use issues as applied to Google Books.

II. Overview of Liability Rules and the Fair Use Doctrine

Section 106 of the Copyright Act reserves to the owner of a copyrighted work the following exclusive rights: reproduction; preparation of derivative works;⁷ distribution; public performance; public display; and the right to publicly perform sound recordings by means of digital audio transmission. Google Books implicates three of these rights: reproduction, distribution and public display. Google reproduced books by scanning them into digital format. It distributed a copy of each scanned book to the library that provided Google with the copy of the book. And it displays “snippets” of the books in response to users’ search queries.

The fair use doctrine is codified at Section 107 of the Copyright Act. Notwithstanding the reservation of rights in Section 106, Section 107 allows certain types of uses of copyrighted works if those uses promote a public benefit without threatening the copyright owners’ economic interests in exploiting the works. Thus, Section 107 of the Copyright Act permits the “fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . .

⁵ *Id.*

⁶ *Authors Guild v. Google, Inc.*, No. 05-08316 (S.D.N.Y. filed Sep. 20, 2005).

⁷ A derivative work is based upon a preexisting work and recasts, transforms, or adapts the preexisting work. 17 U.S.C. § 101. For example, an English-language translation of “Madame Bovary” is a derivative work of Flaubert’s original French-language novel. Similarly, the movie “Spider-Man” is derivative of the comic book of the same name.

scholarship or research.”⁸ Fair use is an “equitable rule of reason” which “permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.”⁹

The preamble of § 107, quoted above, lists six examples (criticism, comment, news reporting, teaching, scholarship, and research) of the types of uses which may give rise to a fair use defense. The list is nonexclusive and is meant to provide “general guidance about the sorts of copying that courts and Congress most commonly had found to be fair uses.”¹⁰

Section 107 establishes four factors which courts analyze to determine whether a particular use constitutes a fair use:

- (1) The purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) The nature of the copyrighted work;
- (3) The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) The effect of the use upon the potential market for or value of the copyrighted work.¹¹

No one factor is dispositive. Courts consider each factor and then weigh them together to determine whether a particular use is fair. The intensely fact-specific nature of the inquiry has yielded a body of case law that often seems contradictory and unpredictable. Some trends, however, are discernible in the morass. The first and fourth factors are by far the most significant in the analysis. One element of the first factor in particular has come to dominate the defense in recent years: transformativeness. This element considers to what extent the secondary user has “transformed” the underlying work such that use serves a new purpose or conveys a new meaning different than that of the original work. If a particular use is deemed transformative, the user’s chances of successfully asserting a fair use defense increase dramatically.

Two Ninth Circuit cases present closely analogous fair use issues to those raised by Google Books. Both involved search engines. In *Kelly v. Arriba Soft*, a photographer sued a search engine for allegedly infringing his photographs by displaying them as low-resolution “thumbnail” images in response to users’ queries.¹² If a user clicked on one of those thumbnails,

⁸ 17 U.S.C. § 107.

⁹ *Stewart v. Abend*, 495 U.S. 207, 236 (1990)(internal citations and quotations omitted).

¹⁰ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577-78 (1994).

¹¹ 17 U.S.C. § 107.

¹² *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003).

the Arriba search engine would direct the user to the full-size image on Kelly's website. *Perfect 10 v. Amazon* also involved the alleged infringement of photographs by a search engine. In that case, the owner of copyright in photographs of nude models sued Google for, *inter alia*, displaying thumbnail images of unauthorized reproductions of those photographs in response to users' search queries. The thumbnail images provided links to the third-party websites hosting the infringing content. Some of these third-party websites participated in Google's AdSense program, pursuant to which Google directed advertising to the site and the site shared the revenues resulting from the advertising with Google. In both *Kelly* and *Perfect 10*, the Ninth Circuit upheld the search engines' reproduction of thumbnail images as a fair use, with the *Perfect 10* panel hewing closely to the rationale in *Kelly*. Because these cases offer a number of important fair use parallels to Google Books, they will be discussed throughout this paper and compared with Google Books.

III. The Purpose and Character of the Use

This factor comprises three elements: whether the use is commercial; whether it is "transformative"; and, on occasion, whether the user has acted in good faith.

A. Commercialism

Section 107 plainly states that the commercial nature of a use is relevant to a determination whether it is fair, and the Supreme Court once famously stated that copying which serves a commercial or profit-making purpose is "presumptively unfair."¹³

The significance of commercialism has declined significantly in recent years, however, with the Supreme Court itself emphasizing that it is not a "hard evidentiary presumption," but merely one element of the inquiry into the first factor which should not be given dispositive weight.¹⁴ Indeed, if commercialism alone were determinative of fair use, "the presumption would swallow nearly all of the illustrative uses listed in the preamble paragraph of § 107, including news reporting, comment, criticism, teaching, scholarship, and research, since those activities 'are generally conducted for profit in this country.'"¹⁵ As the Supreme Court itself quoted Samuel Johnson, "no man but a blockhead ever wrote, except for money."¹⁶

Thus, even a purely commercial use may be fair if other factors weigh in favor of a fair use finding. For example, the Fifth Circuit found that the Miami Herald's reproduction of the

¹³ *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 448-9 (1984).

¹⁴ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 583-84 (1994).

¹⁵ *Campbell*, 510 U.S. at 584 (quoting *Harper & Row*, 471 U.S. at 592 (Brennan, J., dissenting)); see also *American Geophysical Union v. Texaco, Inc.*, 60 F.3d 913, 921 (2d Cir. 1994)(since most secondary users seek some measure of commercial gain from use, unduly emphasizing commercial motivation leads to overly restrictive view of fair use).

¹⁶ *Campbell*, 510 U.S. at 584.

entire cover of TV Guide magazine in an advertisement for its own competing television was a fair use even though the purpose of the advertisement was to obtain a commercial advantage.¹⁷ In so doing, the Fifth Circuit rejected the “per se rule that commercial motive destroys the defense of fair use.”¹⁸ The court found that the circumstances of the use undercut its commercial nature. The TV Guide cover was used in a truthful comparative advertisement, and the court took note of the public interest in disseminating “important information to consumers [which] assists them in making rational purchase decisions.”¹⁹ Thus, even though the Miami Herald used the TV Guide cover expressly for the purpose of gaining a competitive advantage in the market for television guides, the manner in which it did so constituted fair use.

A direct economic benefit is not necessary for a finding of commercialism. In the *Napster* case, file swapping of copyrighted material was commercial because repeated and exploitative unauthorized copies were made to save the expense of buying authorized copies;²⁰ “Napster users [got] for free something they would ordinarily have to buy.”²¹

Moreover, the inquiry into commercialism specifically focuses on whether the user stands to gain from “exploitation of the copyrighted material” itself,²² not whether the new work, as a whole, is commercial in nature.²³ For example, a photographer sued *Hustler* magazine for reproducing two small postcard images in two issues of the magazine. The images appeared in a short section inside the magazine entitled “Bits and Pieces” that commented on quirky or unusual items. Although *Hustler* is a commercial publication, the court found that *Hustler’s* use of the postcards was noncommercial in part because *Hustler* did not use the images, either directly or indirectly, to promote or advertise the magazine. Thus, *Hustler* was not seeking to exploit the images for their commercial value.²⁴

The Ninth Circuit gave indicia of commercialism little weight in *Kelly* and *Perfect 10*. In *Kelly*, the court noted that Arriba operated its search engine for commercial purposes. In *Perfect 10*, the court acknowledged that some of the infringing third-party sites directed advertising revenues to Google as part of its AdSense program, thus rendering Google’s activities commercial in nature. In both cases, however, the court dismissed the commercial nature of

¹⁷ *Triangle Publ’ns, Inc. v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 1171, 1178 (5th Cir. 1980).

¹⁸ *Id.* at 1175.

¹⁹ *Id.* at 1176 n. 13.

²⁰ *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1015 (9th Cir. 2001).

²¹ *A&M Records, Inc. v. Napster, Inc.*, 114 F. Supp.2d 896, 912 (N.D. Cal. 2000).

²² *Harper & Row*, 471 U.S. at 562.

²³ See *Haberman v. Hustler Magazine*, 626 F. Supp. 201, 210-11 (D. Mass. 1996) (citing *Harper & Row*, 471 U.S. at 562).

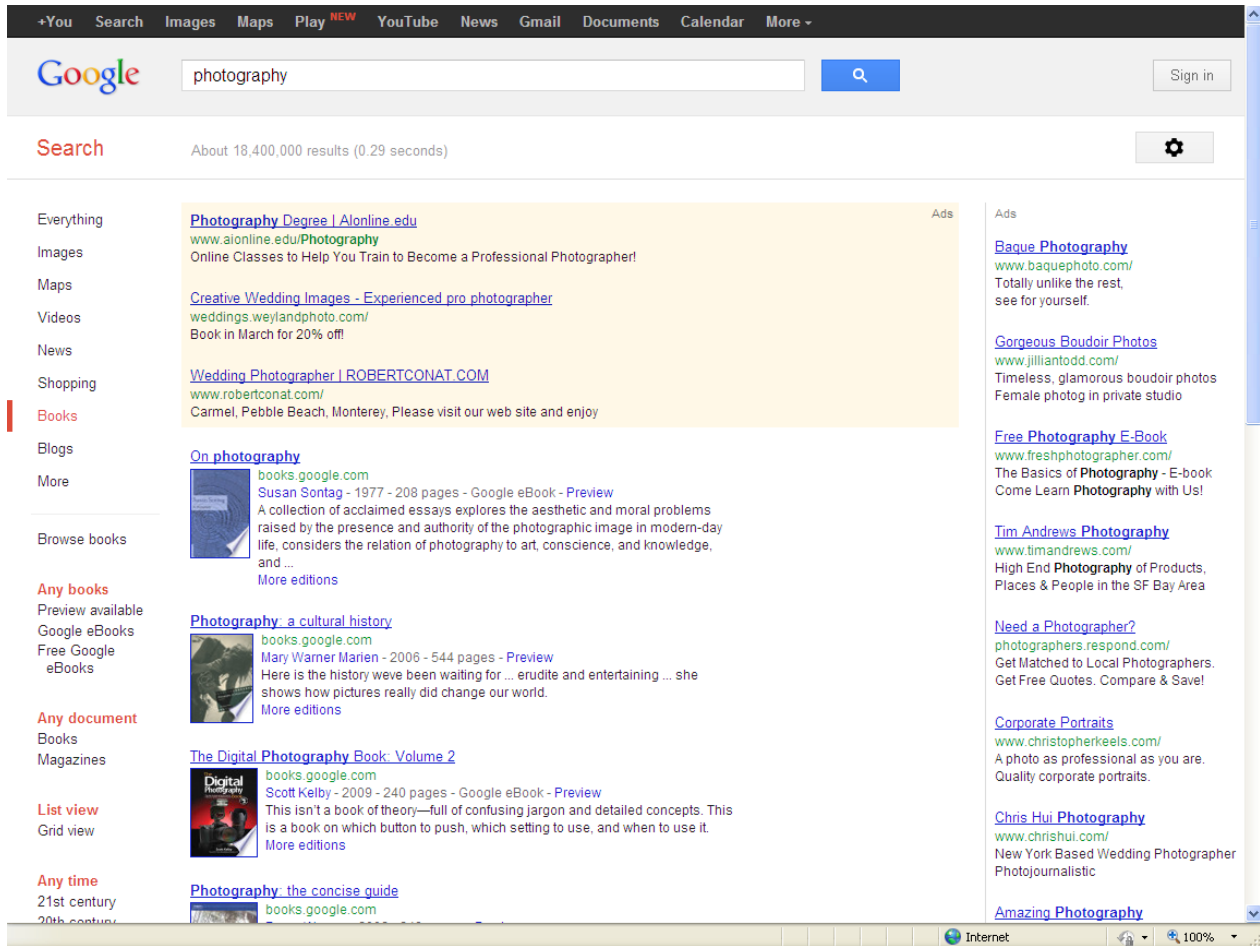
²⁴ *Id.*

these activities with little discussion, finding them outweighed by the fact that Arriba and Google were making transformative uses of the subject photographs.

Google Books involves just such commercial activities as those in *Kelly* and *Perfect 10*. As in *Kelly*, Google operates Google Books for profit. As in *Perfect 10*, Google collects advertising revenues from ads placed alongside users' search results. For example, a user searching for "Brittany spaniels" in Google Books may see ads for "Brittany Spaniel Breeders," "Brittany Puppies," "Brittany Dog Rescue Profiles," and other Brittany-related items:

The screenshot shows a Google search for "Brittany spaniels" with approximately 27,300 results. The search results are displayed in a grid format. On the left side, there is a navigation menu with options like "Everything", "Images", "Maps", "Videos", "News", "Shopping", "Books", and "More". The "Books" section is highlighted. The search results include several book listings from Google Books, such as "Brittany Spaniel Dog" by Local.com, "Brittany Spaniel Breeders" by Ask.com, "Brittany Spaniels" by Julie Murray, "Brittany Spaniels" by Beverly Pisano, "The good, the bad, and the furry: choosing the dog that's right" by Sam Stall, and "Legacy of the Dog: The Ultimate Illustrated Guide" by Tetsu Yamazaki. On the right side, there are several advertisements for "Brittany Spaniel Secrets", "Brittany Puppies", "Brittany Spaniel Breeders", "Brittany Spaniel For Sale", "Brittany Puppies", and "Brittany Dog Rescue Profiles". The browser's address bar shows "Internet" and the page is zoomed to 100%.

A user searching for “photography” may see ads for “Amazing Photography,” “Corporate Portraits,” “Need a Photographer?” and “Gorgeous Boudoir Photos”:



Juxtaposing these targeted ads alongside users’ search results plainly injects a commercial dimension to Google Books. The significance of this commercialism will turn on the extent to which Google Books makes transformative uses of the books in its collection.

B. “Transformative” Uses

The United States Supreme Court has emphasized that the “central purpose” of the first fair use factor is to determine whether the new work merely replaces the original, or whether it makes “transformative” use of the original by adding further creative expression or meaning to it.²⁵ Although not required for fair use, transformative works “lie at the heart of the fair use

²⁵ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)(citations omitted); *see also Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985)(no fair use of verbatim excerpts of former President Ford’s memoirs); *Dr. Seuss*

(continued...)

doctrine's guarantee of breathing space within the confines of copyright."²⁶ The key to transformative use is that it builds upon elements of the original work in creating an entirely new work which conveys a different message and serves a different function than that of the original. "A work is transformative when the new work does not merely supersede the objects of the original creation but rather adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message."²⁷

A transformative use may physically alter the original copyrighted work. For instance, the artist Jeff Koons copied a portion of a fashion photograph of a woman's lower legs, clad in sandals, in a painting which juxtaposed several sets of women's lower legs against food and landscapes.²⁸ Koons altered the appearance of the original photograph, culling out only the legs and feet, discarding the background, inverting the orientation, and making other changes. He intended to "comment on the ways in which some of our most basic appetites – for food, play, and sex – are mediated by popular images . . ."²⁹ The Second Circuit found this use highly transformative because Koons had "sharply different objectives" than the fashion photographer, "using Blanch's image as fodder for his commentary on the social and aesthetic consequences of mass media."³⁰

Such physical changes are not required for a use to be transformative, however. In *Bill Graham Archives v. Dorling-Kindersley Ltd.*, the Second Circuit found that the reproduction without alteration of Grateful Dead concert posters in a biographical work documenting the band's 30-year history was transformative.³¹ The original purpose of the posters was artistic expression and promotion of concerts. In contrast, the posters' reproduction in the biography was of images as historical artifacts to document and represent the occurrence of concerts.

Thus, as the Ninth Circuit stated in *Perfect 10*, "even making an exact copy of a work may be transformative so long as the copy serves a different function than the original work."³² In *Kelly*, although "Arriba made exact replications of Kelly's images, the thumbnails were much smaller, lower-resolution images that served an entirely different function than Kelly's original

(...continued)

Enters., L.P. v. Penguin Books USA, Inc., 109 F.2d 1394, 1400 (9th Cir. 1997)(nontransformative use of Dr. Seuss character cut against fair use); *Pacific & Southern Co. v. Duncan*, 744 F.2d 1490, 1496 (11th Cir. 1984)(no fair use where television news service copied and sold entire news feature).

²⁶ *Campbell*, 510 U.S. at 579.

²⁷ *Perfect 10*, 508 F.3d at 1164 (internal quotations and citations omitted).

²⁸ *Blanch v. Koons*, 467 F.3d 244, 247 (2d Cir. 2006).

²⁹ *Id.*

³⁰ *Id.* at 253.

³¹ *Bill Graham Archives v. Dorling-Kindersley Ltd.*, 448 F.3d 605 (2d Cir. 2006).

³² *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1165 (9th Cir. 2007).

images.”³³ Whereas Kelly’s images were “artistic works intended to inform and engage the viewer in an aesthetic experience . . . Arriba’s search engine functions as a tool to help index and improve access to images on the internet and their related web sites.”³⁴ Similarly, in *Perfect 10*, the court found that the Google search engine made highly transformative uses of Perfect 10’s images, and provided significant benefits to the public. Relying on *Kelly*, the *Perfect 10* panel reasoned:

Although an image may have been created originally to serve an entertainment, aesthetic, or informative function, a search engine transforms the image into a pointer directing a user to a source of information. Just as a parody has an obvious claim to transformative value because it can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one, a search engine provides social benefit by incorporating an original work into a new work, namely, an electronic reference tool. Indeed, a search engine may be more transformative than a parody because a search engine provides an entirely new use for the original work, while a parody typically has the same entertainment purpose as the original work.³⁵

Accordingly, a finding of transformative use will diminish the significance of other considerations, such as commercialism, which might otherwise weigh against the defendant.³⁶ This is consistent with the Copyright Act’s goal of encouraging creative endeavors in science and the arts.³⁷ Indeed, although the *Campbell* Court stated that “such transformative use is not absolutely necessary for a finding of fair use,”³⁸ in practice this factor has become virtually dispositive of the entire fair use analysis.

The dominance of transformativeness in modern fair use analysis means that the outcome of this single element is likely to determine whether Google Books amounts to a fair use. The central question is whether the uses that Google is making of the books at issue supersedes the uses made by the owners of copyright in those books, or whether Google is using the books for a different purpose.

The Ninth Circuit’s reasoning in *Kelly* and *Perfect 10* provides strong support for Google’s claim of transformativeness, and could prove critical to this determination. Books

³³ *Kelly*, 336 F.3d at 818.

³⁴ *Kelly*, 336 F.3d at 818.

³⁵ *Perfect 10*, 508 F.3d at 1165 (internal quotation and citation omitted).

³⁶ *Campbell*, 510 U.S. at 579.

³⁷ *Id.*

³⁸ *Id.*

generally serve to educate or entertain readers. Google Books does not exploit the books in its collection for these purposes. Google Books incorporates works into a new, electronic reference tool which provides users with improved access to books which might otherwise be difficult or impossible to locate. This use does not supersede the uses made by those who own the copyrights in these books. Indeed, Google has asserted that Google Books will substantially benefit the copyright owners, as the program includes links to retailers selling the books in question. Moreover, the benefit to the public of aggregating this information and making it readily available and easily searchable is obvious.

The *Authors Guild* case is not pending in the Ninth Circuit, however. Perhaps not coincidentally, the plaintiffs sued in the Second Circuit, which is not bound to follow Ninth Circuit authority. Thus, the outcome of the Google Books case is far from certain.

The beneficial and nonsuperseding uses made by Google Books as originally envisioned stand in stark contrast to the potential uses described in the proposed settlement in the Authors Guild case. The proposed settlement would have vastly expanded³⁹ the scope of Google Books. Among other things, the proposed settlement would have allowed Google to use out-of-print materials in a variety of ways going far beyond scanning, indexing, and displaying snippets. Without seeking permission of the copyright owner, and without even attempting to locate the copyright owner in some instances, the proposed settlement would have permitted Google to incorporate out-of-print books into new products, including on-line displays of up to 20% of a work; full-text purchases; and subscription products for certain categories of users. These uses would be much more likely to supersede the market for the original books. Of course, these activities are not before the Court in connection with the pending action – which contributed to the court’s rejection of the proposed settlement.

C. Good Faith

The defendant’s good faith is infrequently at issue, but can be important. The Supreme Court has stated that “fair use presupposes good faith and fair dealing,”⁴⁰ but also that good faith is not “central to fair use.”⁴¹ Cases in which this factor have played a role tend to involve overt wrongdoing by the defendant. For example, the *Nation* magazine was unable to rely on fair use to defend its publication of excerpts of President Ford’s unpublished memoirs in part because the *Nation* “knowingly exploited a purloined manuscript” in an effort to “scoop” the publication of

³⁹ An example of the public benefit associated with Google Books presented itself during the drafting of this sentence. Consulting [Grammar Girl](#) on the [propriety of verb splitting](#) led to the related topic of [split infinitives](#). Grammar Girl traces the source of debate over split infinitives to the 1864 book “The Queen’s English” by Henry Alford, and notes that “through the magic of Google Books, you can [see the entry](#) yourself.”

⁴⁰ *Harper & Row*, 471 U.S. at 562.

⁴¹ *Campbell*, 510 U.S. at 585 n. 18.

the memoirs.⁴² Similarly, a sculptor who tore the copyright notice off a photograph before using it as the basis for a sculpture did not act in good faith and the use was not fair.⁴³ “Fair use distinguishes between a true scholar and a chiseler who infringes a work for personal profit.”⁴⁴

In contrast, the Ninth Circuit in *Perfect 10* found that Google’s use of thumbnail images in response to search queries was compatible with good faith. “Google is operating a comprehensive search engine that only incidentally indexes infringing websites. This incidental impact does not amount to an abuse of the good faith and fair dealing underpinnings of the fair use doctrine.”⁴⁵

Google’s actions in connection with the Book Project have engendered heated debate within the publishing community. Critics have assailed Google for taking a unilateral, high-handed approach and deliberately infringing millions of works. The *Authors Guild* court, in rejecting the proposed settlement, noted that “Google engaged in wholesale, blatant copying, without first obtaining copyright permissions.”⁴⁶ Members of the class who objected to the proposed settlement accused Google of taking a “So, sue me” attitude and of “engaging in piracy.”⁴⁷

Being denied permission to use a work, but then using it anyway, does not weigh against fair use.⁴⁸ Nor does failure to seek permission before making fair use of a copyrighted work. Nonetheless, the sheer scope and audacity of Google Books could be sufficient to persuade a court that Google has not acted in good faith. Unlike in *Perfect 10*, Google Books does not “incidentally index” books. To the contrary, Google deliberately went to great lengths to acquire, scan and display the books in question. Accordingly, it is quite possible that a court could find that Google had not acted in good faith, which could tilt the first factor against a finding of fair use.

IV. The Nature of the Copyrighted Work

This factor examines whether the work is primarily factual or creative in nature, and whether it has been previously published.

⁴² *Harper & Row*, 471 U.S. at 562-63.

⁴³ *Rogers v. Koons*, 960 F.2d 301, 309 (2d Cir. 1992).

⁴⁴ *Harper & Row*, 471 U.S. at 563 (internal quotations and citations omitted).

⁴⁵ *Perfect 10*, 508 F.3d at 1164.

⁴⁶ *Authors Guild v. Google*, 770 F. Supp. 2d 666, 679 (S.D.N.Y. Mar. 22, 2011).

⁴⁷ *Id.* at 679 and n.1 thereto.

⁴⁸ *Campbell*, 510 U.S. at 585 n. 18.

When the protected work is primarily informational or factual rather than creative, the scope of permissible fair use is greater.⁴⁹ This is because the risk of restraining the free flow of information is more significant in a factual work.⁵⁰

The books that have been scanned into the Google Book Project are likely to be overwhelmingly creative in nature. Even a book that conveys a significant amount of factual information, such as a biography or history book, will contain vast amounts of copyrightable material. It is highly likely that a court would find the books to be creative and deserving of greater protection than purely factual works.

The scope of protection is also greater with respect to works that have not already been published, because the author has an interest in controlling the work's first publication.⁵¹ In the Ford memoir case, the fact that the memoir was unpublished at the time of the Nation's unauthorized use weighed against a finding of fair use.⁵² In the *Hustler* case discussed above, the photographs had been previously published, which weighed in favor of finding fair use.⁵³

Since Google has obtained the books it has scanned into the Book Project from libraries, it is likely that all or substantially all of the books have been published.

Accordingly, this factor would likely weigh against a finding of fair use. However, this factor is rarely accorded significant weight in the analysis.

V. The Amount and Substantiality of the Portion Used in Relation to the Copyrighted Work as a Whole

Courts assessing this element consider the reasonableness of the amount and substantiality of the portion used in relation to the copyrighted work as a whole.⁵⁴ The analysis involves both qualitative and quantitative aspects of the use.

Quantitatively, the greater the taking, the less likely the use is to be fair. Using an entire work will not necessarily preclude a fair use finding, however, if other factors weigh heavily in favor of fair use. For example, the display of the entire cover image of *TV Guide* in a

⁴⁹ *Consumers Union of United States, Inc. v. General Signal Corp.*, 724 F.2d 1044, 1049 (2d Cir. 1984) (finding Consumer Reports is primarily informational rather than creative).

⁵⁰ *Id.*

⁵¹ *Harper & Row*, 471 U.S. at 564.

⁵² *Id.*

⁵³ *Haberman*, 626 F. Supp. at 211-12.

⁵⁴ *Campbell*, 510 U.S. at 586.

comparative advertisement for a competing television guide was fair because the use served important social policies such as truthful advertising and promoting competition.⁵⁵

Qualitatively, however, if the taking captures the essence or heart of the work, the use may be unfair even if the taking is very small. Thus, in the Ford memoir case, although the actual words quoted were a small portion of the Ford autobiography, the Nation magazine took the “heart of the book” – the most powerful passages about Ford’s pardon of Nixon.⁵⁶ In contrast, the use of ten entire photographs as part of the set decoration in a motion picture was fair because the photographs were largely obscured and not identifiable.⁵⁷

In *Kelly*, the Ninth Circuit found that it was necessary for Arriba to copy entire images in order for users to recognize the images and determine whether they wanted more information about the images. The *Kelly* court thus found that this factor weighed neither in favor of, nor against, a finding of fair use. The Ninth Circuit in *Perfect 10* relied on this reasoning to reach the same conclusion.

The Google Book Project scanned entire books for inclusion in the library. Since the stated purpose was to allow users to conduct full-text searches on the scanned books, Google needed to copy the entire books, just as Arriba needed to display entire images in its search results. Thus, the reasoning in *Kelly* and *Perfect 10* strongly suggests that Google’s taking was reasonable. As with the previous factor, however, courts rarely afford this factor substantial weight.

VI. The Effect of the Use on the Potential Market for or Value of the Copyrighted Work

The fourth factor examines whether the secondary use would permit the user to provide a market substitute for the protected work.⁵⁸ This factor has been characterized as the most important of the four, although in recent years it has become significantly influenced by the element of transformative use. The more transformative a use is, the less likely it is to interfere with the market for the original work.⁵⁹ A finding of commercial use under the first factor does not dictate a finding of market harm under the fourth factor, although the Supreme Court has stated that “when a commercial use amounts to mere duplication of the entirety of an original, it

⁵⁵ *Triangle Publ’ns, Inc. v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 1171, 1176-77 (5th Cir. 1980).

⁵⁶ *Harper & Row*, 471 U.S. at 565.

⁵⁷ *Sandoval v. New Line Cinema Corp.*, 973 F. Supp. 409, 413 (S.D.N.Y. 1997).

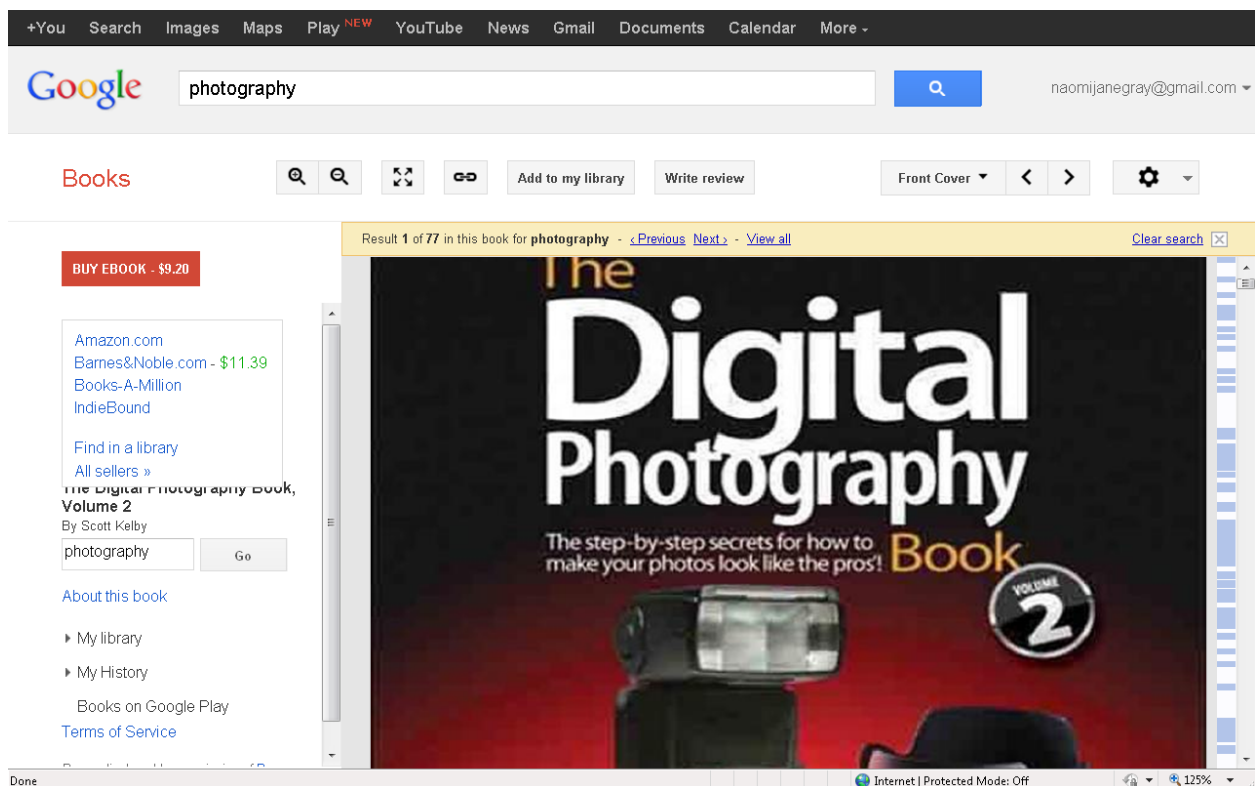
⁵⁸ *Campbell*, 510 U.S. at 590.

⁵⁹ *See, e.g., Campbell*, 510 U.S. at 591.

clearly supersedes the objects of the original and serves as a market replacement for it, making it likely that cognizable market harm to the original will occur.”⁶⁰

The effect of the use on both existing *and potential* markets is relevant. In considering potential markets, the court will consider only markets that the copyright owner of the original work is likely to enter. Thus, for example, “Food Chain Barbie” photographs, which depicted one or more nude Barbie dolls juxtaposed in various absurd and often sexualized poses, were not likely to usurp the market for Barbie dolls, since Mattel is unlikely to enter the market for adult-oriented artistic photos of Barbie.⁶¹

Google has asserted that it has enhanced, rather than interfered with, the market for the original books by directing consumers to retail establishments that sell the books. Google Books displays only “snippets” of a book in response to a search query. In order to purchase a copy of a book, a user must find a third-party seller. Google provides links which a user may employ to do this. For example, a given book might yield a list of links to amazon.com, barnesandnoble.com, or other booksellers.



⁶⁰ *Campbell*, 510 U.S. at 590-91 (internal citations and quotations omitted).

⁶¹ *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

Google Books also offers the option of searching to find the book in a library.

Other aspects of the proposed settlement, however, go far beyond what was originally contemplated by Google Books, and could interfere with potential markets for the original works. For instance, the contemplated settlement would have allowed Google to sell subscriptions to its electronic books database and provide online access to individual books. These could certainly constitute superseding uses, and would likely weigh heavily against a finding of fair use. Of course, as noted above, these issues, which were injected into the dispute in the proposed settlement, are not before the court.

The outcome of this factor is inextricable intertwined with the outcome on transformativeness. If a court were to follow the reasoning in *Kelly* and *Perfect 10* and bless Google Books as making transformative uses of the books in its collection, then it is most likely that the court would also find that Google Books does not interfere with the market for those books. Whether the *Authors Guild* court will do so remains to be seen.

VII. Conclusion

The Google Books dispute is far from over. The *Authors Guild v. Google* case is proceeding, with motions for summary judgment due to be filed on May 4, 2012.

Other mass digitization projects are also underway. One such project is HathiTrust, a partnership of university libraries and research institutions that are combining their digital libraries to create a shared digital repository containing a reported 10 million volumes to date. HathiTrust is also the subject of litigation brought by the Authors Guild. In that case, the Authors Guild recently moved for partial judgment on the pleadings in a motion addressing the interplay between the fair use doctrine and Section 108 of the Copyright Act, which allows libraries and archives to reproduce and distribute works under certain specified circumstances. *Authors Guild v. HathiTrust* may thus generate the first reported opinion on fair use in the context of mass digitization.

Whether these courts follow the reasoning in *Kelly* and *Perfect 10*, or strike a new path through the thicket of fair use jurisprudence, remains to be seen. Regardless of the outcome, it is certain that the copyright community will continue to debate the merits of mass digitization in general, and Google's conduct in particular, for the foreseeable future.