

Objective Limitations or, How the Vigorous Application of “Strong Form” Idea/Expression Dichotomy Theory in Copyright Preliminary Injunction Hearings Might Just Save the First Amendment

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I. INTRODUCTION

Copyright law, by the very nature of the protections it grants authors,¹ possesses at least the potential to restrict speech. This much cannot be rationally denied. However, the First Amendment concerns that accompany a copyright action are often swept away as a matter of course, despite a growing body of scholarship² and opinions³ which

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¹ See, e.g., 17 U.S.C. § 106, 106(a).

² See, e.g., Floyd Abrams, *First Amendment and Copyright*, 35 J. COPR. SOC'Y 1 (1987); Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283 (1979); Charles C. Goetsch, *Parody as Free Speech – The Replacement of the Fair Use Doctrine by First Amendment Protection*, 3 W. NEW ENG. L. REV. 39 (1980); Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970); Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L. J. 147 (1998); Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech And Press?*, 17 UCLA L. REV. 1180 (1970); Hon. James L. Oakes, *Copyrights and Copyremedies: Unfair Use and Injunctions*, 18 HOF-

level strong criticisms of the potential prior restraints problem inherent to the American system of copyright law. The criticism has reached a pitch which the courts can no longer ignore, with high profile cases currently in the system (such as CBS's recent filing of an action against Fox, alleging that Fox's "reality" television program *Boot Camp* infringes CBS's copyright in the wildly popular *Survivor*,⁴ as well as the seemingly never-ending *The Wind Done Gone* action⁵) and more sure to be on the horizon, any competent attorney will be just as sure to exploit what appears to be a growing schism between copyright and First Amendment interests. For the copyright bar, the sky may indeed be falling.

There exists a serious dispute as to whether preliminary injunctions issued in copyright cases are, in fact, prior restraints on speech (and therefore forbidden by the First Amendment).⁶ If we are to assume that the growing weight of scholarship that often decries copyright preliminary injunctions as a prior restraint is in fact sound, then

STRA L. REV. 983 (1990); L. Ray Patterson, *Free Speech, Copyright, and Fair Use*, 40 VAND. L. REV. 1 (1987); David E. Shipley, *Conflicts Between Copyright and the First Amendment After Harper & Row, Publishers v. Nation Enterprises*, 1986 BYU L. REV. 983 (1986); Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept and Feel"*, 38 EMORY L. J. 393 (1989); Mel Marquis, Comment, *Fair Use of the First Amendment: Parody and Its Protections*, 8 SETON HALL CONST. L. J. 123 (1997); Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L. J. 283 (1996); Eugene Volokh & Brett McDonnell, *Freedom of Speech and Independent Judgment Review in Copyright Cases*, 107 YALE L. J. 2431 (1998); Diane Leenheer Zimmerman, *Information as Speech, Information as Goods: Some Thoughts on Marketplaces and the Bill of Rights*, 33 WM. & MARY L. REV. 665 (1992).

³ See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 n. 10 (1994) (stating that the policy aims underlying copyright law are not always best served by injunctive relief); *Religious Tech. Ctr. v. Netcom On-Line Communication Servs., Inc.*, 907 F. Supp. 1361, 1383 (N.D. Cal. 1995) (refusing to grant a preliminary injunction in a copyright case because it would constitute a prior restraint on speech); *Religious Tech. Ctr. v. F.A.C.T.Net*, 901 F. Supp. 1519, 1527 (D. Colo. 1995) (refusing to grant a preliminary injunction on the grounds that it would inhibit discussion of "matters of public concern"); *Suntrust Bank v. Houghton Mifflin Co.*, (*The Wind Done Gone* case) 252 F.3d 1165 (11th Cir. 2001) (refusing to grant a preliminary injunction because it would constitute a prior restraint on speech); *Spense v. Washington*, 418 U.S. 405, 417 (1974) (Rehnquist, J., dissenting) (listing copyright law as an example of a restriction on speech).

⁴ *Survivor Productions LLC et al. v. Fox Broadcasting Co. et al.*, No. 01-CV-3234, complaint filed (C.D. Cal., Apr. 9, 2001). See also, *Reality TV Goes to War in Calif. Courtroom*, 7 no. 20 ANDREWS INTELL. PROP. LITIG. REP. 7 (Apr. 30, 2001).

⁵ *Suntrust Bank v. Houghton Mifflin Co.*, 252 F.3d 1165 (11th Cir. 2001).

⁶ Compare Nimmer, *supra* note 2 (arguing that the First Amendment is not compromised because copyright law protects only the expressive components of a given work and therefore does not lead to the suppression of ideas) and Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283, 303-04 (1996) (arguing that the First Amendment safeguards present in copyright law are ineffective because of their indeterminate nature). See also *infra* notes 54-57 and accompanying text.

the courts must work proactively to conform the system of granting preliminarily injunctive relief in copyright cases to First Amendment standards. The alternative is to risk the possible chaos within the copyright community if (or, indeed, when) the Supreme Court eliminates the favorite remedy of copyright plaintiffs in a broad stroke of judicial review.

This Article seeks to answer the question of how a court may issue a preliminary injunction in a copyright case *without* running afoul of the First Amendment. As such, this Article will give the courts the proactive tool, the *test*, necessary to fix copyright's preliminary injunction problem. The test will prove simple in conception, though sometimes difficult in application, but nonetheless far easier and clearer than the current state of the copyright law.

This Article proposes the application of a new, "strong-form" idea/expression dichotomy theory, which will enable the courts to effectively filter preliminary injunction actions and grant such injunctions only in the cases where a First Amendment interest is not implicated. This new formulation of the idea/expression dichotomy will allow the preliminary injunction to remain a viable remedy in the copyright law, and will conceptually conform an essential element of the copyright jurisprudence to the First Amendment.

This Article will first examine, generally, the First Amendment jurisprudence relating to prior restraints on speech and demonstrate the judiciary's hostility towards prior restraints of speech.⁷ This Article will then briefly analyze the practice of granting preliminary injunctions in copyright cases, showing that the standards applied in this context fall far short of those required in the First Amendment jurisprudence.⁸ Next, this Article will show that copyright preliminary injunctions do, in fact, offend the First Amendment and therefore require a heightened degree of judicial care before the preliminary injunction is granted.⁹ Finally, this Article will provide the courts with the new test that will affect this heightened degree of care; permitting the granting of preliminary relief in a reduced, yet still vast, number of cases, but allowing the courts to avoid violating the First Amendment prohibition on prior restraints on speech.¹⁰

⁷ See generally, *infra* Section 2.

⁸ See generally, *infra* Section 3.

⁹ See *id.*

¹⁰ See generally, *infra* Sections 4 & 5.

II. JUDICIAL HOSTILITY TOWARDS PRIOR RESTRAINTS ON SPEECH

The hostility the courts have shown and continue to show towards prior restraints on speech is nearly absolute.¹¹ Whereas many avenues of constitutional jurisprudence

(First Amendment jurisprudence included) twist and wind their way through multi-faceted and often contradictory balancing tests, a prior restraint on speech, once it has been identified,¹² will face scrutiny of sublime simplicity. Simply stated, the prior restraint will be found invalid except in the most extreme circumstances.¹³ The preliminary injunction, issued by a court to prevent a party from speaking, whether it be orally or in the form of a demonstration or publication, is the most common type of prior restraint in current use.¹⁴ Because of the specter of the prior restraint, preliminary injunctions must overcome a strong presumption of invalidity.¹⁵ Furthermore, preliminary injunctions in speech cases must adhere to the stringent procedural guidelines laid out in *Freedman v. Maryland*, which requires 1) that the party seeking the injunction bear the burden of proving the speech unprotected,¹⁶ 2) that the injunction be “for the shortest fixed period” possible and 3) that a “prompt final judicial decision [be assured].”¹⁷

Both commentators and the courts have routinely criticized preliminary injunctions in speech cases because of several dangers seem-

¹¹ See generally *New York Times Co. v. United States*, 403 U.S. 713 (1971); *Near v. Minnesota*, 283 U.S. 697 (1931).

¹² This task of general prior restraint identification, however, is much less clear and a detailed analysis of it exceeds the scope of this article. See generally John Calvin Jeffries Jr., *Rethinking Prior Restraints*, 92 YALE L.J. 409 (1983).

¹³ See generally *Near v. Minnesota* 283 U.S. 697 (1931); *New York Times Co. v. United States*, 403 U.S. 713 (1971) (per curiam) (the “Pentagon Papers Case”); see also *United States v. Progressive, Inc.*, 467 F. Supp. 990 (W.D. Wis. 1979) (enjoining a magazine from publishing an article that was essentially a “how-to” manual on hydrogen bomb construction, but only after very great deliberation).

¹⁴ The courts have been virulently hostile to anything resembling “licensing systems,” which are denounced roundly in the First Amendment’s legislative history. Further, although subsequent action may be found to operate like a prior restraint, see generally *Near v. Minnesota*, 283 U.S. 697 (1931), the preliminary injunction is the most prevalent form of prior restraint.

Certain features inherent to the granting of preliminary injunctions – for example, the collateral bar rule – make preliminary injunctions fairly easy to identify as being at least *potential* prior restraints. See *supra* notes 23-26 and accompanying text, see also *Alexander v. United States*, 509 U.S. 544, 550 (1993) (“Temporary restraining orders and permanent injunctions . . . are classic examples of prior restraints.”). The same argument is easily made for preliminary injunctions.

¹⁵ See *Near*, 283 U.S. at 716-17.

¹⁶ Traditionally “unprotectable” types of speech include communication detrimental to a war effort, obscenity, incitement to violence or the forcible overthrow of orderly government, and words with the effect of force (i.e. “fighting words”). See *id.*

¹⁷ *Freeman v. Maryland*, 380 U.S. 51, 58-60 (1965).

ingly inherent in the remedy. First, an injunction deserves special hostility because of its effectiveness in suppressing speech.¹⁸ The speech suppressed includes not only that explicitly covered by the injunction itself, but also speech that may be “close” in form or content.¹⁹ This secondary suppression of other speech deserving of constitutional protection has been described as the “chilling effect” and is considered a particularly pernicious feature of preliminary injunctions. As Judge Silberman stated in *Securities & Exchange Comm’n. v. Wall Street Publ’g Inst., Inc.*, [t]he special vice of a prior restraint is that communication will be suppressed, either directly or by inducing excessive caution in the speaker, before an adequate determination that it will be protected by the First Amendment.²⁰

Thus, it is not only the actual suppression of speech but also the potential danger of speakers declining to speak out of fear of punishment that concerns the courts.²¹

The second danger particular to the preliminary injunction is found by an examination of the remedy’s very nature – the speech is suppressed, or at the very least delayed, even though a full trial may show the speech to be constitutionally protected.²² Distilling the argument to its essence, preliminary injunction speech effectively bans speech before a trial on the merits. Worst of all, a court ordered preliminary injunction receives the protection of the collateral bar rule.²³ Under this rule, an enjoined party may not challenge the constitutionality of an injunction when it is issued, but may only violate it (and be charged with contempt of court).²⁴ Unless the injunction may be considered “transparently invalid,” the enjoined party must wait until the final disposition of the case at trial.²⁵ In a speech context, the collateral

¹⁸ See Jeffries, *supra* note 12, at 428.

¹⁹ See *id.*

²⁰ 851 F.2d 365, 370 (D.C. Cir. 1988), *citing* Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations, 413 U.S. 376, 390 (1973).

²¹ A detailed analysis of the potential for prior restraints to “chill speech” is beyond the scope of this article.

²² See Jeffries, *supra* note 12, at 429.

²³ See generally Walker v. City of Birmingham, 388 U.S. 307 (1967).

²⁴ See *id.*; see also United States v. Dickinson, 465 F.2d 496 (5th Cir. 1972) (upholding contempt convictions for two reporters who published in violation of a court order, even though the order was later found to be invalid).

²⁵ This exception allows an enjoined party to violate an injunction without fear of a contempt conviction if the order is “transparently invalid.” See *In re Providence Journal Co.*, 820 F.2d 1342 (1st Cir. 1986) (noting that likelihood of injunction’s enforceability, injunction’s effectiveness in restraining contemplated behavior, and enjoined party’s efforts to obtain “emergency relief” from the appellate courts may all be considered in deciding whether an injunction is “transparently invalid”). However, there exists little other guidance on just how to identify an order may be considered as such. See generally James C. Goodale, *The*

bar rule serves to suppress speech, even if that speech is constitutionally protected, because of the very real (and potentially severe) penalties for violating a preliminary injunction.

The third inherent danger in a preliminary injunction system is the potentially absolute suppression on speech that an injunction affects.²⁶ Compared to a subsequent punishment system, which initially allows the speech to “enter the marketplace of ideas,”²⁷ a preliminary injunction completely prevents the speech from disseminating – a restriction which may become absolute should the speech be found constitutionally unprotected at trial.

To guard against these concerns, the courts have taken a very dim view of preliminary injunctions in most speech cases,²⁸ essentially allowing only the “traditionally proscribable categories” (obscenity, incitement, and fighting words, for example) to be preliminarily enjoined.²⁹ Even in cases dealing with such proscribable speech, the “strong presumption against [the injunction’s] constitutional validity”³⁰ and the procedural safeguards laid down in *Freedman v. Maryland*³¹ still apply. In cases of libel and obscenity, for example, the courts have been extremely hesitant to enjoin even proscribable speech in such cases without a final determination of constitutional protectability.³²

First Amendment scholars also argue that values inherently served by speech are also threatened by preliminary injunctions. Professor Emerson attempted to define these “inherent values” and found that protection of freedom of speech rests upon four premises.³³ First, freedom of speech is necessary to insure “individual self-fulfillment.”³⁴ This argument is akin to the “intrinsic value of free speech” argument offered by Justice Brandeis in *Whitney v. California*, in that freely disseminated speech has a value to the speaker, the listener, and a further

Press Ungagged: The Practical Effect on Gag Order Litigation of Nebraska Press Association v. Stuart, 29 STAN. L. REV. 497, 509-10 (1977) (suggesting that an enjoined party need only appeal the allegedly invalid order right up to the point of violation).

²⁶ See Jeffries, *supra* note 12, at 430.

²⁷ *Id.*

²⁸ See generally *Near v. Minnesota*, 283 U.S. 697 (1931).

²⁹ *Id.* See also *supra* notes 15 & 16 and accompanying text.

³⁰ *Id.*

³¹ See *supra* note 17 and accompanying text.

³² See generally *Vance v. Universal Amusement Corp.*, 445 U.S. 308, 312 (1980) (holding unconstitutional a preliminary injunction against allegedly obscene speech “based upon a showing of probable success on the merits”), see also *Near*, 283 U.S. at 706 (1931) (holding unconstitutional an order preventing a newspaper from printing libelous material, even when the injunction was based upon past libel).

³³ FRANKLIN, ANDERSON, CATE, *CASES AND MATERIALS ON MASS MEDIA LAW* 9 (2000), citing THOMAS I. EMERSON, *THE SYSTEM OF FREEDOM OF EXPRESSION*, 6-9C (1970).

³⁴ *Id.*

value in and of itself because it “make[s] men free to develop their faculties.”³⁵ Second, free speech is “an essential process for advancing knowledge and discovering truth.” As such, speech serves a valuable function to both the individual and to society as a whole.³⁶ This statement may be a more humanistic restatement of Justice Brandeis’ concurrence in *Whitney*, in which he noted “the fitting remedy for evil counsels is good ones.”³⁷ Regardless of the outcome’s “quality,” each citizen will have had a “voice” in the decision to be made.

Emerson’s third value served by free speech, providing an individual with means to influence decision-making, is related to the first, in that it recognizes speech as a personal enabler.³⁸ By constitutionally insuring that each voice may be heard, the First Amendment guards against suppression of both social and political democracy. Indeed, as Professor Meiklejohn has argued: As the self-governing community seeks . . . to gain wisdom in action, it can only find it in the minds of its individual citizens. If they fail, it fails. That is why freedom of discussion for those minds may not be abridged.³⁹

Finally, the fourth value served by freedom of speech is a regulatory one: free speech maintains “the precarious balance between healthy cleavage and necessary consensus” and thereby stabilizes society.⁴⁰ This is a recognition of the sociological platitude that a society must face some ideological conflict or else stagnate. Freedom of speech serves this interest by allowing a guaranteed forum for debate and recognizing that speakers, in discounting “bad” ideas, will likely formulate “good” ones.

³⁵ *Whitney v. California*, 274 U.S. 357, 375 (1927) (Brandeis, J. concurring). As Justice Brandeis goes on to state: “[The Framers of the Constitution] valued liberty both as an end and as a means. They believed liberty to be the secret of happiness and courage to be the secret of liberty.” This statement (phrased less poetically) can be read to stand for the proposition that free speech, as a mechanism for achieving liberty, is as valuable as the goal of liberty itself.

³⁶ Although Emerson focused upon the individual benefit, that “advancing knowledge and discovering truth” have a distinct community benefit can hardly be dismissed.

³⁷ *Id.* This oft cited passage articulates a theory known as the “marketplace of ideas,” which is essentially an extension of Smithian economic theory to the search for truth. Essentially, “marketplace of ideas” theory states that, given equal access, debate, and a rational audience, a true idea (good counsel, as Brandeis puts it) will prevail over a false one (bad counsel). See also *Abrams v. United States*, 250 U.S. 616 (1919).

³⁸ See *id.*; also, see generally Alexander Meiklejohn, *The First Amendment is Absolute*, 1961 S. CT. REV. 245, see also C. EDWIN BAKER, HUMAN LIBERTY AND FREEDOM OF SPEECH, 47-50 (1989), who would argue that Emerson’s first and third points are the only primary values served by speech and that all other effects are derived from those two.

³⁹ MEIKLEJOHN, FREE SPEECH AND ITS RELATION TO SELF-GOVERNMENT 25 (1948).

⁴⁰ See FRANKLIN, ANDERSON, CATE, *supra* note 33, at 9.

Although the broad policy considerations laid out by Emerson, Meiklejohn, and Brandeis describe the general justifications for free speech, it is clear that these policies are likewise not served by easily granted preliminary injunctions. In terms of personal and political enablement, if the government is allowed to suppress speech before it has even been expressed, then it is impossible to argue that an individual's voice can be heard and, thus, impossible to argue that Emerson's "fulfillment" is realized. The same logic applies to the "advancement of knowledge" and "marketplace of ideas" policies – if speech cannot be freely disseminated, then it obviously cannot compete with or add to the speech already in the community.

It is for these reasons that the courts have generally decried the practice of preliminarily enjoining speech and why the Supreme Court has set up the strict procedures to be followed in speech cases in which preliminary injunctions are sought.⁴¹ However, as shown in the following sections, the traditional skepticism of the courts with regards to prior restraints on speech appear to break down within the context of preliminary injunctions in copyright cases.

III. PRELIMINARY INJUNCTIONS IN COPYRIGHT CASES AS PRIOR RESTRAINTS ON SPEECH

Although American copyright law and the First Amendment were both conceived at the same time, the characterization of preliminary injunctions in copyright cases⁴² as prior restraints on speech is a relatively new development. Traditionally, the commentators and courts thought that First Amendment analysis does not apply to copyright cases for a myriad of reasons. First, because technically the interest that copyright deals with directly an intellectual property interest and not "speech," some courts are persuaded that the First Amendment need not even be considered.⁴³ Similarly, courts have noted that copyrights are privately enforced, therefore avoiding the specter (or at least

⁴¹ See *supra* note 17 and accompanying text.

⁴² The court's power to grant preliminary and permanent injunctions is granted in 17 U.S.C. § 502(a) (courts may grant "temporary and final injunctions *on such terms as [they] may deem reasonable* to prevent or restrain copyright infringement") (emphasis added).

⁴³ *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1188 (5th Cir. 1979) ("The First Amendment is not a license to trammel on legally recognized rights in intellectual property."); see also *Near v. Minnesota*, 283 U.S. 697, 716 (1931) (stating in dicta that the "limitations" upon First Amendment applicability existed with regards to the protection of "private rights according to the principles governing the exercise of the jurisdiction of courts of equity"); *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 555-60 (1985) (holding that the First Amendment does not "shield" speech which infringes a valid copyright).

the appearance) of government suppression of speech.⁴⁴ An additional argument is that the subject matter of copyrights is “trivial” and that the First Amendment is more rightly applied to “core” political or informative speech.⁴⁵ A final argument stems from the fact that federal power to grant copyrights was explicitly reserved in the United States Constitution.⁴⁶

Even if one is to assume that preliminary injunctions in copyright cases do not offend the First Amendment, the standards for granting preliminary injunctions within the copyright context are exceedingly low.⁴⁷ Indeed, Melville Nimmer, in his leading treatise on copyright law,⁴⁸ noted that the issuance of preliminary injunctions in copyright cases “is actually quite ordinary, even commonplace.”⁴⁹ In a copyright infringement action, the Ninth Circuit Court in *Triad Sys. Corp. v. Southeastern Express Co.*⁵⁰ noted, “the rules are somewhat different.”⁵¹ This is quite true. In fact, once the party seeking the injunction has proven a reasonable likelihood of success on the merits, the granting of

⁴⁴ *New York Times Co. v. United States*, 403 U.S. 713, 731 n.1 (1971) (listing copyright as a private action which restricts speech without offending the First Amendment, while an identical action by the government might); *see also* *Denver Area Educ. Telecomm. Consortium, Inc. v. F.C.C.*, 518 U.S. 727, 737-38 (1996) (“We recognize that the First Amendment . . . ordinarily does not itself throw into constitutional doubt the decisions of private citizens to permit, or to restrict, speech . . .”) (*emphasis added*); *see generally* *First Unitarian Church of Salt Lake City v. Salt Lake City Corp.*, 146 F. Supp. 2d 1155 (D. Utah C. Div. 2001) (holding that the First Amendment right to associate does not extend onto privately owned property).

⁴⁵ *But see* *Winters v. New York*, 333 U.S. 507, 510 (1948) (“[L]owbrow” entertainment is “as much entitled to the protection of free speech as the best of literature.”). This argument is also problematic because it opens the door for judicial determinations of what is “good” and “bad” speech.

⁴⁶ U.S. CONST. art. I, § 8, cl. 8. *But see* *Time Warner Entertainment Co. v. Does*, 876 F. Supp. 407 (E.D.N.Y. 1994) (holding that Congress’ copyright power in restrained by the Fourth Amendment). The reasoning of the court in *Does* would appear to be even more applicable within the copyright context, as the “Copyright Clause” is contained within the Article I of the U.S. Constitution and the Amendments, by their nature, may be thought to constrain *all* of the original articles (as well as the other Amendments).

The preceding discussion of policies suggesting that copyright should not be subject to the First Amendment (which is *far* from being exhaustive) owes much to Mark A. Lemley and Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 182-97 (1998).

⁴⁷ *See generally* *id.* at 158-65.

⁴⁸ 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT 14-101.

⁴⁹ *Id.* § 14.06(A) at 14-112.

⁵⁰ 64 F.3d 1330, 1335 (9th Cir. 1995).

⁵¹ *See also* *Religious Tech. Ctr. v. F.A.C.T.Net, Inc.*, 901 F. Supp. 1519, 1523 (D. Colo. 1995) (noting that the rules for preliminary injunctions in copyright cases are “somewhat different” than in other cases).

a preliminary injunction is to be expected.⁵² The “balance of hardships” is only considered when there “[exist] serious questions going to the merits.”⁵³ Additionally, the public interest requirement for the granting of preliminary injunctions is generally ignored in copyright cases.⁵⁴ Even arguments invoking a public interest opposed to the granting of the injunction “generally fail.”⁵⁵ The refusal of the courts to consider the balance of hardships and public interests in copyright injunction cases leaves the copyright plaintiff in the enviable position of having to prove only: 1) a likelihood of success on the merits⁵⁶ and 2) the validity of the copyright.⁵⁷

Professors Mark Lemley and Eugene Volokh have persuasively argued, however, that nothing in copyright or constitutional jurisprudence truly justifies this disparate treatment.⁵⁸ “Copyright law restricts speech,” they argue. “[I]t restricts you from writing, painting, publicly performing, or otherwise communicating what you please.”⁵⁹ Proceed-

⁵² See generally *Cadence Design Sys. v. Avant! Corp.*, 125 F.3d 824, 827 (9th Cir. 1997), *Johnson Controls, Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173, 1174 (9th Cir. 1989), *Creative Labs v. Cyrix Corp.*, 42 USPQ2D (BNA) 1872 (ND Cal. 1997).

⁵³ *Apple Computer, Inc. v. Formula Int'l, Inc.*, 775 F.2d 521, 523 (9th Cir. 1984), see also *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206-07 (2d Cir. 1979). Note that the 2nd and 9th Circuits contain Hollywood, Silicon Valley, and New York City, the hotbeds of copyright litigation in this country for a number of years. Furthermore, most other circuits have more or less adopted ruled in accord with the 2nd and 9th Circuit on this matter (the exception being the 5th Circuit).

⁵⁴ See Lemley & Volokh, *supra* note 46 at 161.

⁵⁵ *Id.* at 162. Lemley & Volokh note that “[the] competing public interest in the wide dissemination of information” most likely will not be persuasive in blocking the issuance of an injunction, citing to *West Publ'g Co. v. Mead Data Cent., Inc.*, 616 F. Supp. 1571, 1582 (D. Minn. 1985), *aff'd* 799 F.2d 1279 (8th Cir. 1979), and other circuit court opinions. To the First Amendment scholar, Lemley & Volokh's simple statement above should be extremely troublesome (for obvious reasons).

⁵⁶ NIMMER, *supra* note 48, at 14-101 (“the plaintiff's burden for obtaining a preliminary injunction in copyright cases collapses to showing likelihood of success on the merits.”)

⁵⁷ The registration of a work with the Copyright Office grants the author a presumption of validity. 17 U.S.C. § 410(c) (1994) (registration “shall constitute prima facie evidence of the validity of copyright . . .”); see also *Covington Fabrics Corp. v. Artel Products, Inc.*, 328 F. Supp. 202, 204 (S.D.N.Y. 1971) (holding that the presumption of validity of copyright was not overcome by contradictory expert testimony). It can safely be said that this requirement is essentially pro forma, and, that by placing no real burden of proving validity on the party seeking the injunction, the courts have effectively whittled the preliminary injunction test in copyright cases down to a single prong – likelihood of success on the merits. Any comparison with this preliminary injunction standard with the standard seemingly required by the Federal Rules of Civil Procedure reveals a troubling inconsistency between copyright and the rest of the civil law before the First Amendment is even implicated. See *infra* note 64 and accompanying text.

⁵⁸ See generally Lemley & Volokh, *supra* note 46.

⁵⁹ *Id.* at p. 165-66. Professors Lemley & Volokh's arguments on this point are extremely logical and persuasive, to the point that to restate them here in anything more than the most general terms would rob their work of a good deal of its luster. See also *Spense v. Washing-*

ing from the premise that the general rule from *Freeman v. Maryland*⁶⁰ should be applied in copyright just as it is in “core” speech cases,⁶¹ Professors Lemley and Volokh argue that preliminary injunctions in copyright cases must “*at the very least . . .* be immediately appealable, with the assurance of a prompt decision (not just a prompt hearing) about whether the speech is actually unprotected [by the First Amendment].”⁶² Clearly, no mechanism comparable to that suggested by Professors Lemley and Volokh exists within the existing copyright bar.⁶³ Neither does the preliminary injunction procedure in copyright follow the generally accepted standard for granting injunctions in civil cases, which requires the party seeking the preliminary injunction to prove: 1) a likelihood of success on the merits; 2) that irreparable injury will result if the injunction is denied; 3) that the balance of hardships tips in the moving party’s favor; and 4) that issuing the injunction serves the public’s interest.⁶⁴ Rather, the standard for granting preliminary injunctive relief in copyright cases turns essentially upon a showing of copyright validity and likelihood of success on the merits.⁶⁵

That such a lax standard for granting preliminary injunctive relief in copyright cases would offend the First Amendment seems clear. If we are to assume that Professors Lemley and Volokh are correct in that copyrightable works are indeed deserving of First Amendment protections, then the frequency and the manner in which preliminary injunctions issue stands in stark contrast to the *Freedman v. Maryland* standards.⁶⁶ Requiring only a showing of valid copyright and likelihood of success on the merits clearly falls far short of what has been held in the Supreme Court to be constitutionally required.

Nevertheless, the injunctions continue to issue with an ease (when compared to non-intellectual property cases) that one finds difficult to resolve with the First Amendment.⁶⁷ In proposing a solution to this

ton, 418 U.S. 405, 417 (1974) (Rehnquist, J., dissenting) (listing copyright law as an example of a restriction on speech).

⁶⁰ See *supra* note 17 and accompanying text.

⁶¹ See Lemley & Volokh, *supra* note 46 at 179.

⁶² *Id.* at 180 (emphasis added). Professors Lemley & Volokh go on to make more sweeping recommendations (for example, “preliminary injunctions should be generally prohibited in cases involving nonliteral copying,” *see id.* at 210), the nuances of which exceed the scope of this article. However, at its most basic level, the Lemley & Volokh article argues that a tougher standard for preliminary injunctions in copyright cases is needed – a position that this article wholeheartedly supports.

⁶³ See NIMMER, *supra* note 48, at 14-101.

⁶⁴ 11 ALAN WRIGHT ET AL., *FEDERAL PRACTICE & PROCEDURE* 131-33 (2d ed. 1995).

⁶⁵ See *supra* note 57 and accompanying text.

⁶⁶ *Freedman v. Maryland*, 380 U.S. 51, 59 (1965). See also *supra* note 17 and accompanying text

⁶⁷ Again, this analysis owes much to Lemley & Volokh, *supra* note 46 at 172-78.

problem, Professors Lemley and Volokh advocate a sea change in the law of copyright – a system of judicial analysis that would prevent preliminary injunctions from issuing in all but the most blatant cases of literal infringement.⁶⁸ However, their solution provides the judiciary with no workable standard for discerning when preliminary injunctions could properly issue.⁶⁹ Additionally, Professor Volokh has gone so far as to propose independent judicial review of copyright decisions to avoid offending the First Amendment, a proposal which would effectively eliminate the preliminary injunction as a viable remedy in copyright cases and could foreseeably grind the disposition of even “easy” copyright cases to a halt.⁷⁰

This Article does not propose such sweeping changes to the law of copyright, and offers instead a more moderate approach to the First Amendment problem. Rather than eliminating the preliminary injunction as an effective remedy in copyright cases, this Article instead seeks to formulate a more workable test to be applied in preliminary injunction hearings in order to comport the law of copyright with First Amendment jurisprudence. In light of the lax standard applied in copyright preliminary injunction hearings and the very real possibility that these injunctions, in certain cases, work as prior restraints on speech,⁷¹ the need for this should seem clear. However, the formulation of such a test first requires an analysis of the so-called “idea/expression dichotomy” as it applies in the law of copyright.

IV. A BRIEF OVERVIEW OF IDEA/EXPRESSION DICHOTOMY THEORY

First formulated by the Supreme Court in *Baker v. Selden*,⁷² the idea/expression dichotomy is an integral part of the law of copyright. Stated simply, a copyright in a work protects only the original expression contained in the work, and not the underlying ideas.⁷³ That is to say, any portion of a work determined to be an “idea” is uncopyrightable.⁷⁴ The fear of taking an idea “out of circulation” or “granting a monopoly” over an idea through the operation of copyright laws meant

⁶⁸ See *id.* at 210 & 237-38.

⁶⁹ See *id.*

⁷⁰ See generally Eugene Volokh and Brett McDonnell, *Freedom of Speech and Independent Judgment Review in Copyright Cases*, 107 YALE L.J. 2331 (1998).

⁷¹ See *supra* Sections 2 & 3.

⁷² 101 U.S. 99 (1879).

⁷³ See 17 U.S.C. 102(b).

⁷⁴ See *id.*; also, see generally *Baker*, 101 U.S. at 99.

to be less restrictive,⁷⁵ as well as the “impetus theory” underlying the constitutional grant of copyright power,⁷⁶ underlie this distinction between the copyrightable expression and uncopyrightable ideas that make up every work of authorship.

Although the distinction between “idea” and “expression” is an easy one to make conceptually, and although the policies are easily articulated, the construction of an operable and consistent legal test for what constitutes an “idea” and what constitutes “expression” has vexed the courts and legislature for more than a century.⁷⁷ The most workable test was formulated by Judge Learned Hand in *Nichols v. Universal Pictures Corp.*⁷⁸ Referred to as the “inverted cone” or “continuum of abstraction,” Judge Hand’s theory analyzes the expression and underlying idea as they relate to each other within a given work.⁷⁹ At one end of the continuum, Judge Hand stated that one could define the idea underlying a copyrighted work as the content of the same work in its entirety, identical word for word.⁸⁰ He termed this the “narrow” end of the inverted cone, because there would be very little copyrightable ex-

⁷⁵ The somewhat dramatic use of the word “monopoly” seeks to clearly express the fact that the law grants the copyright owner rather expansive rights to control the dissemination of the copyrighted work. See 17 U.S.C. § 106. If an owner of a valid copyright so desired, they could suppress all works that infringe their own. See *id.* If copyright were granted to ideas, it would be possible for the owner of such a copyright could (theoretically) prevent any other person from expressing, practicing, or perhaps even from *thinking* the same idea. This is clearly not what copyright is intended to do. See *supra* note 76 and accompanying text. See also *Lee v. Runge*, 404 U.S. 887, 892 (1971) (Douglas, J., dissenting from denial of certiorari) (“Serious First Amendment questions would be raised if Congress’ power over copyrights were construed to include the power to grant monopolies over certain ideas.”).

⁷⁶ “Impetus theory” has been read into the constitutional grant of copyright power. U.S. CONST. art. I, § 8, cl. 8 (“Congress may grant copyright[s] . . . to promote the useful arts and sciences”); see also *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127-28 (1932); *Kendall v. Winsor*, 62 U.S. (21 How.) 322, 327-28 (1858). Essentially, the primary policy justification for granting copyright protection is considered to be the economic encouragement (or impetus) to create new works that a copyright guarantees an author. By vesting in the author a series of exclusive rights (the right to produce copies, prepare derivative works, distribute the work, etc.), copyright law secures a means of economic exploitation for a copyright owner and thus provides the economic incentive for persons to invest their time and effort into creative works.

A grant of exclusive monopoly power appears at odds with “impetus theory,” however, in that it allows subsequent authors no room to improve on the works that have come before, but rather restricts access to and use of the work to a degree appropriate to a patent, but inappropriate to copyright.

For an excellent overview of impetus theory as it applies to the law of copyright, see generally William Landes & Richard Posner, *An Economic Analysis of Copyright Law*, 18 J. LEG. STUDIES 325 (1989).

⁷⁷ See *infra* notes 79-100 and accompanying text.

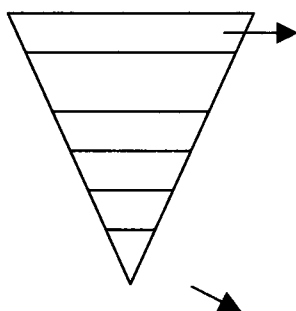
⁷⁸ 45 F.2d 119 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931).

⁷⁹ See *id.*

⁸⁰ See *id.*

pression contained within the work.⁸¹ At the continuum's other extreme, one would define the idea underlying the work as abstractly as possible.⁸² This was termed the "broad" or "wide" end, because the actual expression contained within the work of authorship would be far more substantial than it would be under a "narrow" definition of the underlying idea.⁸³

It may be helpful to examine this doctrine more carefully. Delineating where along Hand's continuum a particular work lies - parsing out just what portion of the work is "idea" and what portion is "expression" - should allow for the exact determination of just what within a given work is indeed copyrightable. In effect, the more "narrowly" one defines an idea along Hand's continuum (that is to say, the more one ties the idea underlying the work to the content of the work itself), the more a work will be considered to be "idea" and, therefore, uncopyrightable. "Narrowing" results in greater proportion of uncopyrightable "idea" within a work, and, ergo, a reduced proportion of copyrightable "expression" within the same work. Inversely, "broadening" or "widening" along Hand's continuum results in a decreased proportion of uncopyrightable "idea" and an increased proportion of copyrightable "expression."



“Broad” Idea – allowing the maximum amount of a work to be considered copyrightable expression.

(As the cone “narrows,” more of the work is considered “idea” and less is considered “expression.”)

“Narrow” Idea – allowing the least amount of a work to be considered copyrightable expression.

Examined in this way, it should become clear that, as the “idea” underlying a work of authorship is defined ever more “narrowly,” the portion of the work that may properly be copyrighted decreases as well,

⁸¹ See *id.* At the “narrowest” end of the spectrum, the “idea” underlying a work would be so closely tailored to the content of the work itself that “expression” would be theoretically nonexistent. See *supra* note 80, *infra* notes 82-83 and accompanying text.

⁸² See *id.*

⁸³ See *id.*

simply because more of the body of the work would effectively become “idea.” This may seem counterintuitive to some – a “narrowing” that results in an increased proportion of underlying idea. It may be helpful to consider the use of the terms “narrowing” and “widening” within the idea-expression dichotomy context as describing the degree of “fit” between a given work of authorship and the underlying idea. A narrow fit, exhibiting a minimal amount of abstraction, would by necessity be tied very closely to the actual words, images, or sounds of a given work. The body (the *expression*) of the work and the idea underlying the work would effectively become one. On the other hand, a wide fit, exhibiting a greater degree of abstraction, would see a much more recognizable fission between the idea and the body of a work. Using this “wider” degree of idea abstraction, the expression and idea components within a given work of authorship are more easily separable.⁸⁴

To illustrate, if Judge Hand’s continuum of abstractions analysis were applied in its strictest form (that is, “narrowly,” or with the *least* possible amount of abstraction) to William Shakespeare’s *Romeo & Juliet*, the “idea” underlying the work would be, literally, the work itself. Each act, scene, character, plot twist, line of dialogue, and punctuation mark would be considered part of the “idea” and, therefore, uncopyrightable. As the obvious consequence, the entire play would likewise be uncopyrightable, because of the prohibition on copyrighting ideas.⁸⁵ At the other extreme, if Judge Hand’s test were applied in its least strict form (“broadly,” or with the *greatest* possible amount of abstraction), then the “idea” would give only the vaguest notion of what the play was about – “love,” perhaps, or “conflict,” and nothing more – and the entirety of the play’s *expression* of that idea, all of the fleshing-out of this vague concept done by the author, would enjoy full copyright protection. In a complete reversal of the preceding situation, the author would enjoy copyright protection for very nearly all of the work. The result of this “broad” definition of the idea would be that works with even a tangential connection to the copyrighted work (the film *Shakespeare in Love*, for example) would almost certainly infringe some part of the original, copyrighted work.

It should now be relatively clear that, in applying Judge Hand’s test, how narrowly or broadly one defines the “idea” underlying a copy-

⁸⁴ It remains very easy, however, to get tangled in the linguistics of Judge Hand’s oftentimes dense theory, especially for those with limited experience in the realm of copyright law. As a simple rule of thumb, it may be useful to remember the following: as you define an idea more “narrowly,” more of a work will be “idea” and less will be copyrightable. (This is, of course, an oversimplification and will not hold true in every case.)

⁸⁵ See *supra* notes 73-75 and accompanying text.

righted work, that is to say, where one places the idea along the continuum, dictates what portion of the work may be properly copyrighted. If the idea were defined “broadly,” most if not all of the work would be copyrightable because, with such a vaguely stated underlying idea, very little of the specific text could rightly be considered “idea.” Accordingly, as an idea is defined with less and less abstraction (or more and more “narrowly”) the degree with which the underlying idea approximates the text of the work itself increases. Accordingly, the portions of the work that express only that which had been deemed to be an “idea” will be uncopyrightable. As the degree of abstraction increases, the amount of the body of the work considered to be uncopyrightable “idea” increases apace and the amount of the work properly copyrightable (the “expression”) decreases.

At first glance, Judge Hand’s test seems logical and simple to apply. Upon closer analysis, however, one should begin to see the problem that has plagued the courts and legislature in their attempts to consistently apply or even describe this test – the inherently difficult and subjective task of defining “idea” versus “expression.”⁸⁶ A presiding judge is given a great deal of latitude in defining just what level of abstraction is attributed to an idea underlying a copyrighted work.⁸⁷ Thus, although Judge Hand’s “inverted cone” provides a clean and objective theoretical test, *application* of his test requires individualized and highly subjective judicial evaluation of an individual work. This sort of “necessary” ad hoc analysis has resulted in widely inconsistent applications of the idea/expression dichotomy among the federal circuits.⁸⁸

⁸⁶ See *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (Judge Hand stated that the “[t]he test for infringement is of necessity vague . . . [and] [d]ecisions must therefore inevitably be *ad hoc*.” (emphasis in original)). As for the difficulty in applying the idea/expression dichotomy, it may be helpful to consider what Professors Prosser and Keeton said about proximate cause (another notoriously confusing legal doctrine): “There is perhaps nothing in the entire field of law which has called forth more disagreement, or upon which the opinions are a welter of confusion. Nor, despite the manifold attempt which have been made to clarify the subject, is there yet any general agreement as to the best approach.” W. PAGE KEETON ET AL., *PROSSER AND KEETON ON TORTS*, FIFTH ED. 263 (1984). The point, of course, is although proximate cause is an inherently difficult doctrine, it still finds widespread usage in the law of torts, just as the inherently difficult idea/expression dichotomy does in the law of copyright.

⁸⁷ See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (2d Cir. 1930) (“wherever [the line separating idea and expression] is drawn, it will seem arbitrary . . .”); see also *Peter Pan Fabrics*, 274 F.2d at 489 (“The test for infringement of a copyright is of necessity vague.”)

⁸⁸ See Yen, *supra* note 2, at 407-20, 432 (analyzing and criticizing a line of Ninth Circuit cases which define the “idea” portion of a copyrighted work so broadly that the idea/expression dichotomy could never be practically applied to limit the scope of a given work’s copyright).

More troubling is the fact that, when the courts even discuss the First Amendment implications of copyright, they often rely on the idea/expression dichotomy to defend the restrictions imposed upon speech by copyright law.⁸⁹ Acknowledging the need “in the copyright sphere . . . [to] draw a line between that speech which may be prohibited under copyright law, and that speech which, despite its copyright status, may not be abridged under command of the first amendment,”⁹⁰ Professor Nimmer noted that, although the First Amendment surely protected the ideas underlying a work, the copying of the expression in a work added little to public discourse.⁹¹ The line between constitutional protectability and unprotectability in copyright cases therefore seems to conceptually turn on whether the speech is an “idea” or merely “expression.”⁹²

This distinction seems logical. The policy aims of the First Amendment (which include insuring the maintenance of a well-informed body politic, a free exchange of ideas, and to prevent “discourage[ing] thought,”⁹³) are served by a system that allows “ideas” to freely disseminate while preventing only the copying of another author’s exact expression. The idea is free to enter the marketplace, to be debated and accepted or rejected or modified, but copying the preexisting form of the expression is prohibited by copyright.⁹⁴ As Professor Nimmer notes, “[t]o reproduce the ‘expression’ of ideas may add *flavor*, but relatively little *substance* . . .”⁹⁵ Theoretically, copyright seems to have a built in mechanism to protect First Amendment interests.

The constitutional problem, however, does not lie with the distinction drawn by Professor Nimmer and the courts, but instead appears in

⁸⁹ *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1170 (9th Cir. 1977) (stating that the application of the idea/expression dichotomy “already serves to accommodate the competing interests of copyright and the first amendment.”) *See also* Yen, *supra* note 2, at 408-11 for a detailed critique of the Ninth Circuit Court’s application of the idea/expression dichotomy in *Krofft*. *See also id.* at 395 n.15, *citing* *Fantasy, Inc. v. Fogerty*, 664 F. Supp. 1345, 1351 (N.D. Cal. 1987) (“The ‘idea/expression’ dichotomy serves to accommodate any 1st Amendment [sic] concerns . . .”)

⁹⁰ NIMMER, *supra* note 48, at 1185.

⁹¹ *See id.* at 1202; also, *see generally* *Lee v. Runge*, 404 U.S. 887 (1971) (Douglas, J., dissenting from denial of certiorari).

⁹² *See* NIMMER, *supra* note 48, at 1189-90.

⁹³ *See supra* notes 34-41 and accompanying text.

⁹⁴ It is worth noting that even the particular expression of a copyrighted work may be directly copied, within certain contexts, according to the “fair-use doctrine.” *See* 17 USC § 107.

⁹⁵ NIMMER, *supra* note 48, at 1192. It is worth noting here that Professor Nimmer did recognize the potential for exceptional cases where the “idea” would lose most or all of its impact if separated from the particular copyrighted expression. *Id.* at 1197-1200 (identifying “news photographs” as an exception and listing the *Zapruder* film and photographs of the *My Lai* massacre as examples).

the application (or lack thereof) of the idea/expression dichotomy in copyright preliminary injunction hearings.⁹⁶ If indeed the proper distinction between constitutionally protectable and unprotectable speech rests on “idea” versus “expression,” then courts must have a reliable mechanism for determining exactly what portion of a work is the constitutionally protected “idea,” and what portion is the unprotectable (and therefore copyrightable) “expression.” However, the current framework for evaluating copyright preliminary injunction motions appears inadequate for constitutional purposes.⁹⁷

V. APPLICATION OF STRONG-FORM IDEA/EXPRESSION DICHOTOMY AND PRELIMINARY, NON-BINDING MERGER DOCTRINE IN COPYRIGHT CASES WHERE PRELIMINARY INJUNCTIONS ARE SOUGHT

Operating from the premise that preliminary injunctions in copyright cases often constitute prior restraints on speech, it is clear that the current system of granting preliminary injunctions after a showing of little more than likelihood of success on the merits is inadequate.⁹⁸ Therefore, a more exacting form of analysis is required before granting such relief. Further, it will not do to eliminate the preliminary injunction from copyright cases altogether.⁹⁹ Instead, a better balance must be struck between the moving party’s interest in protecting their work and the public’s constitutional interest in the free flow of information and ideas.

The idea/expression dichotomy and merger doctrine, properly applied, may strike such a balance. The distinction between idea and expression drawn by the Supreme Court in *Baker v. Selden* and codified in 17 U.S.C. §102(b) has been a leading justification for the disparate

⁹⁶ Indeed, the “notoriously malleable and indeterminate” nature of the idea/expression dichotomy has led at least one scholar to dismiss the test as worthless for purposes of protecting any First Amendment interests that may arise within a copyright case. Netanel, *supra* note 6, at 303-04.

⁹⁷ See *supra* Section 3.

⁹⁸ See *supra* notes 58-65 and accompanying text.

⁹⁹ The necessity of preliminary injunctive relief in copyright cases is premised primarily upon the notions that irreparable injury is presumed and that accurate calculation of damages generally is impossible. See House Comm’n on the Judiciary, 1st Sess., Report on the Register of Copyrights on the General Revision of the U.S. Copyright Law, pt. 1, at 102 (Comm’n Print July, 1961); also, see generally *Stewart v. Abend*, 495 U.S. 207 (1990); Roger D. Blair & Thomas F. Cotter, *An Economic Analysis of Damages Rules in Intellectual Property Law*, 39 WM. & MARY L. REV. 1585, 1615-16 (1998). However, see *Walt Disney Prods. v. Basmajian*, 600 F. Supp. 439, 442 (S.D.N.Y. 1984), and *Am. Metro. Enters. of New York, Inc. v. Warner Bros. Records, Inc.*, 154 U.S.P.Q. 311 (S.D.N.Y. 1967), in which the courts refused to grant preliminary injunctions because actual damages could be adequately calculated.

First Amendment treatment of copyright matters,¹⁰⁰ but the application of the dichotomy has been inconsistent at best. Much of this inconsistency owes to the abstract nature of the idea/expression dichotomy itself – a test “tied to highly particularized facts.”¹⁰¹ Courts are left in the unenviable position of trying to avoid running afoul of the First Amendment by applying a test which is, at best, imprecise, and, at worst, explicitly linked to judicial determinations of artistic merit.¹⁰²

This Article does not seek to objectively define the difference between the tangible expression of an idea and the intangible idea itself, a task better left to the philosophers. Nor does this Article advocate the abandonment of the idea/expression dichotomy test,¹⁰³ but rather suggests a refinement. If Judge Hand’s idea/expression analysis is applied with regularity in hearings for preliminary injunctions, and is applied in a consistently *strict* form (that is, with a “narrow” definition of the underlying idea), this Article asserts that much of the First Amendment problem will dissolve. While this is by no means the perfect theoretical solution to the problem of potential prior restraints on speech in copyright cases, it provides a more stringent test for the party seeking the preliminary injunction to meet and a clearer and more consistent standard for judges to apply.

A. “Strong-Form” Idea/Expression Dichotomy and Its Effects on the Application of Merger Doctrine

Extending the theory offered by Professor Nimmer, preliminary injunctions should not offend the First Amendment so long as all that is enjoined is the individualized expression of an idea, and not the idea itself.¹⁰⁴ Again, however, the proper conceptual threshold at which expression ends and idea begins has been difficult to delineate with any accuracy or consistency.¹⁰⁵ The problem lies not in the test itself,¹⁰⁶ but with the inconsistent judicial application of the test.

¹⁰⁰ See generally NIMMER, *supra* note 48; see also *New York Times Co. v. United States*, 403 U.S. 713 (1971) (per curiam).

¹⁰¹ *Couleur Int’l Ltd. v. Opulent Fabrics, Inc.*, 330 F. Supp. 152, 153 (S.D.N.Y. 1971); see also *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (Judge Hand stated that the “[t]he test for infringement is of necessity vague . . . [and] [d]ecisions must therefore . . . be *ad hoc*.” (*emphasis in original*); also, see generally *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931).

¹⁰² See Amy B. Cohen, *Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitability of Artistic Value Judgments*, 66 IND. L.J. 175, 196 (1990).

¹⁰³ See *supra* note 80 and accompanying text.

¹⁰⁴ See generally NIMMER, *supra* note 48.

¹⁰⁵ See *supra* notes 87-90 and accompanying text.

Turning again to the “abstraction” or “continuum” test in *Nichols*, Judge Hand laid out an “inverted cone.”¹⁰⁷ The narrow end of this cone represents an articulation of the idea underlying a copyrighted work with extreme specificity. At the other extreme, the wide end of the cone represents the most abstract articulation of the idea possible. The practical effect of this system of classification is simply that, as the “idea” underlying the copyrighted work is defined more and more narrowly, the proportion of the work considered uncopyrightable idea increases and consequently, less and less of the work is considered copyrightable expression.

It has been shown that contemporary courts favor the wider end of Judge Hand’s inverted cone, shaping the “idea” component with breadth sufficient to allow the vast majority of any given work to be considered “expression.” Therefore, courts rarely invoke the idea/expression dichotomy to call the validity of a moving party’s entire copyright or their likelihood of success on the merits into question, and, as a consequence, the idea/expression dichotomy is rarely used to preclude issuing a preliminary injunction. This is where the courts have erred. In order to prevent constitutionally protected speech from being suppressed, the courts must apply an idea/expression test that will protect *more* speech than that which is clearly protected, or else run the risk of “chilling” speech.¹⁰⁸ Therefore, a more aggressive constitutional test is needed in copyright cases, at least in the preliminary injunction stage. Such a test must be standardized, to minimize any risk of judicial determinations of artistic merit, and simple in application, to avoid lengthy (and costly) debates on what is and is not protected. It is the position of this Article that the classic idea/expression dichotomy test, *with a modification for purposes of standardization*, could serve well in this capacity.

In applying idea/expression analysis as it now stands, it is the responsibility of each court, in each case, to set just where along Judge

¹⁰⁶ As the Ninth Circuit stated in *Sid & Marty Krofft Television Prods. v. McDonald’s Corp.*, 562 F.2d 1157, 1163 (9th Cir. 1977), “no court or commentator . . . has been able to improve upon Judge Learned Hand’s . . . test articulated in *Nichols*. . . .”

¹⁰⁷ See *supra* notes 78-83 and accompanying text.

¹⁰⁸ See *Boos v. Barry*, 485 U.S. 312, 321-22 (1988) (invalidating a District of Columbia ordinance which prohibited certain types of picketing that, while not unconstitutional on its face, chilled speech by failing to grant it adequate “breathing space.”). See also Frederick Shauer, *Fear, Risk and the First Amendment: Unraveling the “Chilling Effect,”* 58 B.U. L. REV. 685, 705-10 (1978) (arguing that drawing the line of proscribability too close to the constitutional boundary achieves a substantially similar result as actually crossing the boundary). For a lucid discussion of chilling effects in copyright cases specifically, see generally Yen, *supra* note 2, at 424-33.

Hand's continuum the idea underlying a work resides.¹⁰⁹ This may function perfectly well within the context of a full trial on the merits, when the "highly particularized facts" of each situation may be exhaustively considered,¹¹⁰ but it functions poorly when faced with traditional First Amendment prior restraints analysis. Instead of the ad hoc determinations prevalent (and perhaps necessary) in full trials, the rule should be applied in an identical form, with the "idea" defined with an identical degree of abstraction, in every preliminary injunction hearing. This would provide the consistency that constitutional scholars and advocates crave while still maintaining the preliminary injunction as a viable form of relief in the law of copyright. The way in which the proposed idea/expression dichotomy test achieves these aims will become clearer after the following hypothetical and case examples.

The level of abstraction granted to a work's idea must be narrowed along Judge Hand's continuum to the point where much of the *substance* of the work is considered uncopyrightable "idea." Looking to Shakespeare's *Hamlet*, the underlying idea could be defined, according to this framework, as "a prince, whose father is killed and whose uncle is quite the domineering type, attempts to come to grips with the responsibilities thrust upon him. One thing leads to another and there's some killing."¹¹¹ This level of abstraction allows copyright protection for individual variations from the plot line (for example: the author's choice to make the central character male or female, the geographic setting, et cetera.), but would *disallow* copyright protection for many of the core thematic principles of the work. Therefore, the courts should refuse to allow a preliminary injunction for those portions of the work described in this narrow definition of the idea.¹¹² Simply stated, the plot line of the work would be considered uncopyrightable "idea" for the purposes of this analysis.

In practical terms, a preliminary injunction would issue within this new framework only after a judicial finding that, even if the "idea" underlying the work is defined with this lower level of abstraction (i.e. the idea is defined more "narrowly"), the allegedly infringing work nonetheless still copies the *individual expression that is "left over"* in the

¹⁰⁹ See *Peter Pan Fabrics v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

¹¹⁰ The value of the idea/expression dichotomy, as it exists, for aiding in the proper resolution of cases on their merits is a discussion beyond the scope of this article.

¹¹¹ Again, Shakespeare is not exactly my forte.

¹¹² It is important to recognize that the application of idea/expression dichotomy analysis will not invalidate the entire copyright – only the portions of a work that are deemed to be "idea" are unprotected. See generally *Baker v. Selden*, 101 U.S. 99 (1879). It is also important to note that this analysis does not consider the potential application of "scenes a faire" doctrine. See *Cohen*, *supra* note 102 at 224.

copyrighted work. The immediate effect of applying this stricter form of idea/expression dichotomy analysis would be an overall reduction in the number of preliminary injunctions issuing. The issuance of preliminary injunctions in cases of literal or near-literal infringement, however, would remain essentially unchanged.¹¹³

Further, this test may be applied within copyright's existing procedural climate with only minimal changes. As noted previously, preliminary injunctions currently issue in copyright cases upon a showing that 1) a valid copyright exists and 2) there is better than a *de minimis* chance of the moving party prevailing on the merits.¹¹⁴ Under the proposed "strong-form" of idea/expression analysis,¹¹⁵ these two points of proof become more demanding. Remember that copyright may never extend to those elements of a work deemed to be "ideas."¹¹⁶ When "strong-form" idea/expression analysis is applied in the preliminary injunction hearing, a greater measure of the copyrighted work is presumed to be indistinguishable from the underlying ideas (for the purposes of the preliminary injunction hearing *only*). Ergo, less of the work may be *presumed* protected by copyright, thereby drastically undercutting one of the two necessary grounds for issuing a preliminary injunction in the context of copyright.¹¹⁷ This analysis is necessary to define the boundaries of just what *is* protected – judges need not concern themselves with that portion of the work found to be "idea." What remains protected (that is, that which is not "idea") should be limited to truly individual details: the phrasing of the dialogue, set directions, character names, and the like. This method would not challenge the presumption of validity that comes with copyright registration;¹¹⁸ it would serve only to *limit* the subject matter to which the presumption effectively extends for the purposes of preliminary injunction hearings. This definition of the scope of copyright protection

¹¹³ Additionally, the treatment of idea/expression issues in cases at trial need not be modified. This Article proposes "strong-form" idea/expression dichotomy theory be used in preliminary injunction hearings only.

¹¹⁴ See *supra* note 57 and accompanying text.

¹¹⁵ "Strong-form" idea/expression analysis does not describe any truly "new" test. Rather, it has been chosen as useful shorthand for a strictly applied version of Judge Hand's "inverted cone" or "continuum of abstractions" test from *Nichols* (that is, an application of the "inverted cone" which, by default, defines the idea underlying any given work with a low degree of abstraction or, in Hand's words, "narrowly").

¹¹⁶ See *supra* note 74 and accompanying text.

¹¹⁷ See *supra* note 57 and accompanying text.

¹¹⁸ See 17 U.S.C. § 410(c); also, see *generally* *Williams Elecs., Inc. v. Artic Int'l, Inc.*, 685 F.2d 870 (3d Cir. 1982).

should regularly be made as a determination of law,¹¹⁹ and should be universally and automatically applied by the presiding judge, regardless of whether either party has filed a motion asking for such analysis.

The parameters of the “expression” and “idea” components defined in the aforementioned step will then serve in determining the likelihood of success on the merits of a subsequent copyright action alleging infringement. At this step of analysis, the judge need only compare the subject matter of the copyrighted work not deemed to be “idea” in the previous step with the parallel subject matter of the allegedly infringing work. If, after fact-based arguments by both sides, these elements are deemed to be substantially similar,¹²⁰ then the court could properly issue a preliminary injunction against the alleged infringer without fear of offending the First Amendment because, quite simply, no *ideas* are being suppressed. The application of this second step differs little from the preliminary analysis that courts currently engage in and requires no meaningful change in judicial methodology.¹²¹ However, the factual comparison to determine likelihood of success on the merits is constitutionally sound only if it occurs *after* the scope of what is protected by copyright is limited as a matter of law (not limited *generally*, but limited with regards to a given work). Put another way, a preliminary injunction may *only* prevent the copying of expression and the courts must be vigilant in preventing the device from mistakenly protecting any idea content. In order to assure that no ideas are suppressed, the courts must determine and refuse to enjoin the uncopyrightable idea portion of any copyrighted work. “Strong form” idea/expression dichotomy analysis will provide the courts with the tool to do just this.

B. *Application of “Strong-Form” Idea/Expression Analysis*

At this time, it may be helpful to see the operation of this new analysis in the context of actual cases. In *Gund, Inc. v. Smile International Inc.*¹²² and *Knickerbocker Toy Co. v. Genie Toys, Inc.*,¹²³ two factually similar cases resulted in two opposite outcomes because of

¹¹⁹ See NIMMER, *supra* note 48, at § 13-27 n.3.2. The delineation between idea and expression in a copyright case is a question of “substantial similarity,” and thus is a blended question of law and fact. See Alan Latman, “Probative Similarity” as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement, 90 COLUM. L. REV. 1187, 1190 (1990). In a preliminary injunction hearing, therefore, allowing the judiciary to mark the line between idea and expression should not present any procedural problems.

¹²⁰ See *generally* Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930).

¹²¹ See *id.*

¹²² 691 F. Supp. 642 (E.D.N.Y. 1988), *aff’d mem.*, 872 F.2d 1021 (2d Cir. 1989).

¹²³ 491 F. Supp. 526 (E.D. Mo. 1980).

dissimilar application of the idea/expression dichotomy.¹²⁴ The plaintiff in *Gund, Inc.* sought a preliminary injunction based on alleged infringement of his design for a toy dog, which could somewhat realistically mimic an actual dog lying down.¹²⁵ The court, perhaps unknowingly, applied a “strong-form” idea/expression test when they defined the “idea” underlying the plaintiff’s copyrighted creation as a “more or less realistic, non-rigid stuffed toy dog that ‘flops’ down on its stomach.”¹²⁶ The court’s definition of the idea underlying the “flopping toy dog” is tied very closely to what the work actually *expresses* (that is to say, the tangible, physical attributes of the toy). Therefore, the *Gund, Inc.* court correctly reasoned that there would be very few ways other than the plaintiff’s to express this exact idea.¹²⁷ Accordingly, the court ruled that, since the idea and expression in this case were effectively “merged,” the defendant had copied only the plaintiff’s unprotectable idea.¹²⁸ Thus, there was no infringement and the court refused to issue the preliminary injunction.¹²⁹

The court in *Knickerbocker Toy Co.*, on the other hand, granted copyright protection to a toy dog dressed as an engineer and explicitly rejected the defendant’s argument that the “idea” of dog dressed as an engineer could only be expressed in a limited number of ways and necessitated copying of certain characteristics of the plaintiff’s design.¹³⁰ Discounting the importance of idea/expression dichotomy analysis, the court ruled that the defendant had infringed the plaintiff’s copyright and could be rightfully enjoined.¹³¹

It is not unlikely that, had the court in *Knickerbocker Toy Co.* defined the idea underlying the plaintiff’s creation as “a toy dog dressed as an engineer,” at least some of the expressive characteristics of the toy would have been subsumed by the “idea.”¹³² In the preliminary injunction context, however, even a definition of “idea” that would re-

¹²⁴ These two cases were also used in Cohen, *supra* note 102 at 215-16, to illustrate artistic value judgments made by the judiciary in applying the idea expression dichotomy.

¹²⁵ *Gund*, 691 F. Supp. at 645.

¹²⁶ *Id.*

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ *Knickerbocker Toy Co.*, 491 F. Supp. at 529.

¹³¹ *Id.*

¹³² Again, it is worth noting that a finding of unprotectability with regards to *some* of the expression contained in a work would not invalidate the entire copyright. See 3 NIMMER ON COPYRIGHT § 13.03(F)(5) at 13-72. In *Knickerbocker Toy Co.*, a final determination of infringement was most likely appropriate given the nearly literal copying that defendant was engaging in. See Cohen, *supra* note 102 at 215 (defendant’s toy was “nearly identical to plaintiff’s copyrighted work with respect to size, shape, color, eyes, nose, mouth, other facial characteristics and clothing.”).

sult in the non-copyrightability of a few elements of a work¹³³ would be inadequate for First Amendment purposes because of possible “chilling effects” on speech.¹³⁴ Likewise, the articulation in *Gund, Inc.*, although it likely resulted the correct outcome, is also likely too “wide” (that is, with too great a degree of abstraction) and would offend First Amendment interests if applied in a preliminary injunction setting.

If we apply the same degree of idea abstraction as was described in *Gund, Inc.*, but alter the copyrighted work considered to a literary work *about* a dog that “flops down on its stomach,” it should become apparent that a great deal of the work would still be protected by copyright.¹³⁵ And, as the analysis of copyright’s preliminary injunction procedure has shown, the simple existence of presumably valid copyright protection goes a very long way towards the issuance of a preliminary injunction.¹³⁶ Instead of relying on the presumptive validity of a registered work, the court’s articulation of the “idea” should strip away as much abstraction as possible, tracking closely the expression of the copyrighted work. Using the facts of *Knickerbocker Toy Co.*, “strong-form” idea/expression dichotomy, properly applied, would define the idea underlying the plaintiff’s toy dog as: a toy representation of a dog, of such and such approximate size, wearing a train conductor’s uniform with such and such pattern. Being “ideas,” these elements would be considered uncopyrightable for the purposes of a preliminary injunction hearing, and no preliminary injunction could properly issue based upon a defendant’s copying of only these “idea” elements. Indeed, when applying such a narrow articulation of the underlying idea, it is unlikely that anything more than literal or near literal copying of the

It is worth noting that *Gund, Inc.* and *Knickerbocker Toy Co.* both deal with subject matter that, in all likelihood, would receive no First Amendment protection in the first place. However, the similarity of facts and the failure to apply a single form of idea/expression dichotomy analysis make them extremely useful in demonstrating the need for a stronger and more consistent articulation of the idea/expression test. Further, the concrete nature of the works – the fact that they are tangible objects, capable of an objective cataloguing of their characteristics and methods of expression – aids in simplifying what can be an admittedly complex and sometimes non-intuitive analysis of what precisely expression is.

¹³³ Continuing from the facts in *Knickerbocker Toy Co.*, had the court defined the idea underlying the plaintiff’s work as “a toy dog dressed as an engineer,” only those elements would be considered “idea” and thus be uncopyrightable. Everything else would be validly copyrightable.

¹³⁴ See *supra* note 21 and accompanying text.

¹³⁵ For example, the degree of idea abstraction applied in *Gund, Inc.* would leave the entirety of the plot, characterizations, location, scenery, and theme well within the copyrightable subject matter of a literary work on the general subject of “a dog that ‘flops’ down on its stomach.”

¹³⁶ See *supra* notes 49-58 and accompanying text.

plaintiff's work would be found to be infringing for the purposes of granting preliminary injunctive relief.¹³⁷

When applied in a First Amendment context, the consistent application of "strong-form" idea/expression dichotomy analysis should go a long way towards removing the "chill" placed upon ideas by the current preliminary injunction system in copyright law.¹³⁸ Applying "strong form" idea/expression dichotomy theory will acknowledge that, in cases where infringement of a valid copyright¹³⁹ is the slightest bit unclear, the courts will err on the side of *not* issuing a preliminary injunction. This will allow the preliminary injunction in copyright to guard against literal and near literal infringement only and steer well clear of offending the First Amendment.

An immediate effect of this would be to allow authors to "stand on the shoulders of giants,"¹⁴⁰ so to speak, without as much fear of immediate lawsuit and the inevitable injunction. Furthermore, the strict nature in which "strong-form" idea/expression dichotomy analysis is applied should assuage fears of judicial artistic value judgments by tailoring the definition of "idea" around the objective characteristics of a work, rather than forcing judges to construct an ephemeral statement of what a work's "concept" or "feel" might be.¹⁴¹ The modified test proposed by this Article should be easier for judges to apply to a copyright case's "highly particularized facts"¹⁴² than the current form of idea/expression analysis, and likely free the judiciary from much of the current scholarly criticism of inconsistent and confusing idea/expression decisions.

Additionally, it is important to note that "strong-form" idea/expression dichotomy theory would not affect a copyright holder's rights at the trial level. Permanent injunctions and awards of damages would

¹³⁷ Note that such items as proportions, colors used, length of hair chosen, and the inclusion of other, "non-essential" accoutrements would remain in the realm of "individual expression" and, therefore, would provide grounds for a preliminary injunction should they be copied.

Again, it is important to remember that this construction of the idea/expression dichotomy test should only be applied in *preliminary injunction hearings when a First Amendment interest is implicated*. This article does not in any way suggest that "strong-form" idea/expression dichotomy analysis is appropriate in all copyright cases, nor even in all copyright preliminary injunction hearings.

¹³⁸ See generally Yen, *supra* note 2.

¹³⁹ More accurately, the question would turn on the likelihood infringement of a valid portion of a copyright.

¹⁴⁰ Letter of Sir Isaac Newton to Robert Hooke, Feb. 5, 1575/1576 as quoted in ROBERT K. MERTON, ON THE SHOULDERS OF GIANTS: A SHANDEAN POSTSCRIPT 31 (1965). See, I can butcher Issac Newton as well as Shakespeare!

¹⁴¹ See generally Yen, *supra* note 2.

¹⁴² See *supra* notes 56 & 87 and accompanying text.

still turn on the same facts and the same law. The rule proposed by this Article would merely restrict the granting of preliminary injunctions in cases involving less than literal or near literal infringement, which is arguably the standard that is required to comport with the Federal Rules of Civil Procedure, let alone the First Amendment.¹⁴³

Finally, it is worth noting that the proposed test will not result in a copyright infringement “free-for-all” within the artistic and literary community. “Strong-form” idea/expression dichotomy theory should benefit the “industry” as a whole by preventing the costly process of waiting out injunctions in cases which are in fact close and should rightly be decided on the merits. The proposed test should work to protect the professional publisher, the established artist, and the emerging talent simultaneously – as Professors Lemley and Volokh point out, “copyright owners are also copyright defendants.”¹⁴⁴ Further, the removal of at least some “lawsuit-phobia” from the artistic and literary community should serve to inspire further creation – the avowed purpose of the Copyright Clause to the United States Constitution.¹⁴⁵

VI. CONCLUSION

If the arguments offered by both scholars and some courts that copyright preliminary injunctions may be prior restraints on speech are valid, then the copyright bar will soon find itself in the perilous position of having its most ubiquitous remedy subject to a “heavy presumption of unconstitutionality.”¹⁴⁶ It is unlikely that the preliminary injunction would survive as a viable legal remedy in such a climate, even in the cases of literal or near-literal infringement where such an injunction would conceivably be appropriate. Although the courts for the most part have chosen to ignore the potential First Amendment problems with our current body of copyright law, the increasing volume of scholarly criticism and judicial skepticism with regards to the potential existence of a “copyright prior restraint” is difficult to ignore just as the cries of “it’s always been this way” become less palatable.

However, if the copyright bar and the courts hearing copyright cases were to take a proactive stance on this matter – admit that a problem exists and show that remedial steps are being taken – it may be possible to dull the current criticism of the preliminary injunction and rescue the remedy before a time of crisis is upon us. The test offered by this Article is one of those steps.

¹⁴³ See Lemley & Volokh, *supra* note 46 at 238-39 and *supra* Section 3.

¹⁴⁴ See *id.* at 239.

¹⁴⁵ See *Zaccinni v. Scripps-Howard*, 433 U.S. 562, 575-76 (1977).

¹⁴⁶ See *generally* *Near v. Minnesota*, 283 U.S. 697 (1931).

By limiting the number of preliminary injunctions that issue to only the “appropriate” cases, that is, those cases in which *individual expression* is copied, critics will be deprived of ammunition. By making it so that a preliminary injunction will issue only in cases of literal or near-literal infringement, the number of cases will be appropriately limited and the necessary “breathing space” will be created for protected speech. And by adopting “strong-form” idea/expression dichotomy analysis in copyright preliminary injunction cases, the copyright bar will assure that only instances of literal or near-literal infringement are enjoined.