

Creative Content Client Alert

June 2009

*Judge Sotomayor's Record On Copyright And First Amendment Issues**Paul M. Smith and Steven B. Fabrizio, Co-Chairs, Creative Content Group*

Judge Sonia Sotomayor's recent nomination to the United States Supreme Court has attracted substantial attention in the business community. This Client Alert describes the notable decisions in which she wrote or joined copyright or free speech opinions.

Judge Sotomayor has a long track record on copyright and First Amendment issues, but it is not one that reveals clear trends. Her opinions are closely reasoned, free of rhetoric, and highly dependent on the facts presented by the particular case. She has found both for and against copyright holders and creators of expressive works many times. On the whole, it is difficult to predict how she might rule in copyright and First Amendment cases on the Supreme Court.

BACKGROUND

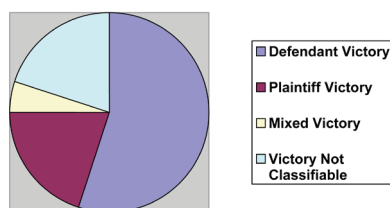
Prior to joining the bench, Judge Sotomayor practiced for eight years at Pavia & Harcourt, an intellectual property firm in New York that primarily represents rights-holders. Her work there appears to have focused on trademark litigation. Notably, she occasionally participated in police raids of warehouses containing knockoff versions of her clients' products.

Judge Sotomayor was then appointed in 1992 by President Bush to a seat on the U.S. District Court for the Southern District of New York.

In 1999, President Clinton appointed her to a seat on the U.S. Court of Appeals for the Second Circuit. During her years on the bench, Judge Sotomayor has heard approximately 30 cases dealing with intellectual property issues, and well over a hundred cases dealing with First Amendment issues.

COPYRIGHT

Of Judge Sotomayor's 30 intellectual property opinions, 20 have dealt with copyright law specifically. As the chart below shows, the defendants, or accused copyright infringers, prevailed in eleven of these decisions, while the plaintiffs, or copyright-holders, prevailed in four.



These numbers might appear to suggest that Judge Sotomayor favors copyright defendants, but many of those decisions involved procedural issues, or satellite concerns, such as attorneys' fees, and thus do not necessarily support an inference that Judge Sotomayor is disposed to rule against rights-holders. Instead, a more nuanced picture of Judge Sotomayor's copyright jurisprudence

emerges from the details of her individual cases. From the cases she has heard, several stand out as descriptive of Judge Sotomayor's moderate approach to copyright law.

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Electronic Databases: *Tasini v. New York Times*

*Tasini*¹ is one of the most widely discussed copyright cases. Judge Sotomayor heard this case as a district court judge, and her decision was overturned by the Second Circuit—a result affirmed by the Supreme Court. Freelance journalists alleged that the *New York Times* and other publications infringed their copyright by allowing their works to be made available through electronic databases like Lexis/Nexis. Judge Sotomayor found for the publishers, concluding that their actions fell under the "revision" privilege of the Copyright Act of 1976. Judge Sotomayor concluded:

[Although] plaintiffs contend mightily that the disputed electronic reproductions do not produce revisions of defendants' collective

works, plaintiffs' real complaint lies in the fact that modern technology has created a situation in which revision rights are much more valuable than anticipated as of the time that the specific terms of the Copyright Act were being negotiated. If Congress agrees with plaintiffs that, in today's world of pricey electronic information systems, Section 201(c) no longer serves its intended purposes, Congress is of course free to revise that provision to achieve a more equitable result. Until and unless this happens, however, the courts must apply Section 201(c) according to its terms, and not on the basis of speculation as to how Congress might have done things differently had it known then what it knows.

The Supreme Court voted 7-2, however, to uphold the reversal of Judge Sotomayor's opinion in this case. Judge Sotomayor's *Tasini* decision suggests that she held a narrow view of the scope of copyright in the face of changing technologies, but that is only a single data point. As the other cases discussed below show, her record is more nuanced.

Copyright Damages

In two cases as a district court judge, Judge Sotomayor discussed the role that damages play in copyright infringement cases. In *Top Rank, Inc. v. Allerton Lounge, Inc.*,² Judge Sotomayor reviewed a magistrate judge's determination concerning statutory damages, and found that they were insufficient to provide a deterrence effect.

A willful infringement, which the Magistrate Judge found, combined with a willful default, however, warrant an award greater and more significant than one which corresponds so closely to an estimated loss to the plaintiff. The Court agrees with the defendants that statutory damages must be

sufficient enough to deter future infringements and should not be calibrated to favor a defendant by merely awarding minimum estimated losses to a plaintiff.

“[S]ubstantial statutory damages are warranted to deter ... future misconduct.”

And in *Peer Int'l. Corp. v. Luna Records, Inc.*,³ Judge Sotomayor entered a damage award against a defendant record company that had failed to pay the compulsory mechanicals royalty to the owners of the musical compositions used on the records. Judge Sotomayor found that a high statutory damage award was necessary to deter future infringement by the defendant.

Congress's provision allowing for a greater award where willful infringements are found, however, indicates that statutory damages serve the dual purposes of the Copyright Act—compensation and deterrence. ... Because of defendant Abel De Luna's willful infringement of plaintiffs' copyrights and his continued infringement after the initiation of this action, I find that substantial statutory damages are warranted to deter him from future misconduct.

Copyrighting “Facts” in Works of Fiction

Judge Sotomayor found in *Castle Rock Entertainment v. Carol Publishing Group*⁴ that the defendant's creation of a trivia book based on the popular TV show “Seinfeld” was a copyright infringement. The defendant argued that it merely contained “uncopyrightable facts” about the show, but Judge Sotomayor found that in works of fiction, the “facts” are themselves part of the copyrighted creative content.

Judge Sotomayor humorously noted that the subject of the case might cause people to conclude that the opinion “is not about anything.”

Trademark Rights in Pre-1972 Sound Recordings

Judge Sotomayor joined an opinion written by Judge Leval in *Oliveira v. Frito-Lay*⁵ holding that Astrud Oliveira, who famously sang “The Girl from Ipanema,” could not use trademark law to find a protectable interest in her 1964 performance of the song. The panel observed that no copyright protection was available for a pre-1972 sound recording performance. The court did hedge in its finding, indicating that a stronger showing of facts might support trademark protection for a “signature performance” of a song.

Substantial Similarity Test

Judge Sotomayor joined in a summary order in *Boone v. Jackson*⁶ finding against the *pro se* plaintiff song writer who alleged copyright violations for the song “Hollaback.” In applying the substantial similarity test, the court emphasized that the songs as a whole, and not just their protectable elements, must be compared. The court noted that aesthetic characteristics or excerpting patterns of public domain material could become protected.

In sum, Judge Sotomayor's copyright jurisprudence is not easily categorized. As a former intellectual property attorney, it is possible that she may turn out to be a strong defender of copyright on the Supreme Court, but her track record in the lower courts is simply too inconclusive to make predictions with any certainty.

FIRST AMENDMENT

Judge Sotomayor has addressed a variety of First Amendment issues during her years on the bench. As with her copyright decisions, no clear trend is visible. The following are several cases of particular note.

Artistic Expression

In *Zieper v. Metzinger*,⁷ Judge Sotomayor joined an opinion holding the district court erred in granting summary judgment on the merits in favor of FBI agents who were alleged to have coerced a filmmaker to get him to remove a film from the web that the government claimed was dangerous. The Court of Appeals found that there was a dispute of fact as to whether the FBI coerced the filmmaker in violation of the First Amendment, but found that the agents had qualified immunity in any case.

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In *Vincenty v. Bloomberg*,⁸ Judge Sotomayor joined an opinion upholding a preliminary injunction barring the enforcement of a ban on persons younger than 21 purchasing or possessing spray paint. The government had argued that the ban was necessary to stop illegal

graffiti and associated crime. Judge Sotomayor's panel affirmed the district court's ruling that the ban was overbroad and impinged on legitimate First Amendment interests in creating legal graffiti and other art.

Commercial Speech

In *New York State Restaurant Association v. New York City Bd. of Health*,⁹ Judge Sotomayor joined an opinion holding that New York City could require restaurants to post information showing the nutritional content of their food. The opinion held that the regulation affected commercial speech, and was subject to rational basis review. It further held that the City's interest in fighting obesity constituted a rational basis for the regulation.

Youth Speech

In *Doninger v. Niehoff*,¹⁰ Judge Sotomayor joined an opinion holding that a school did not abridge a student's First Amendment rights when it barred her from running for school office on the basis of derogatory comments she made about the school on an independent web site. The opinion found that although the speech in question was made outside of school, it was likely to, and in fact did, "reach school property," and therefore could be punished by the school.

In *Guiles v. Marineu*,¹¹ Judge Sotomayor joined an opinion holding that the district court erred in holding that a school district could prohibit a student from wearing a t-shirt that alleged that George W. Bush used drugs. The Court of Appeals found that the t-shirt was not offensive and therefore not permissibly restricted.

Employee Speech

In *Pappas v. Giuliani*,¹² Judge Sotomayor dissented from a panel ruling holding that the police could fire an officer who sent out anonymous racist mailings on his own time to private parties. Sotomayor argued that the totality of the circumstances (anonymous mailings, unlinked to the police department, mailings made outside of work, etc.) weighed in favor of protecting the officer's First Amendment interests

As with her copyright decisions, Judge Sotomayor's First Amendment jurisprudence shows a moderate jurist whose opinions are in the mainstream. It thus remains to be seen how she would approach First Amendment issues as a member of the Supreme Court, but we would not expect any dramatic departures from current jurisprudence.

Endnotes

¹ 972 F. Supp. 804 (S.D.N.Y. 1997)

² 1998 WL 35152791 (S.D.N.Y. 1998)

³ 887 F.Supp. 560 (S.D.N.Y. 1996)

⁴ 955 F. Supp. 260 (S.D.N.Y. 1997)

⁵ 251 F.3d 56 (2d Cir. 2001)

⁶ 206 Fed. Appx. 30 (2d Cir. 2006)

⁷ 474 F.3d 60 (2d Cir. 2007)

⁸ 476 F.3d 74 (2d Cir.2007)

⁹ 556 F.3d 114 (2d Cir. 2009)

¹⁰ 527 F.3d 41 (2d Cir. 2008)

¹¹ 461 F.3d 320 (2d Cir. 2006)

¹² 290 F.3d 143 (2d Cir. 2002)

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