UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

CAPITOL RECORDS, INC., et al.,	)	
Plaintiffs,	)	
	)	
v.	)	**Civ. Action No. 03cv11661-NG**
	)	**LEAD DOCKET NO.**
NOOR ALAUJAN,	)	
Defendant.	)	
SONY BMG MUSIC ENTERTAINMENT, et al.,	)	
Plaintiffs,	)	
	)	
v.	)	Civ. Action No. 07CV11446-NG
	)	ORIGINAL DOCKET NO.
JOEL TENENBAUM,	)	
Defendant.	)	

GERTNER, D.J.:

ORDER
July 14, 2009

In its initial survey of the fair use question, the Court has found cause to consider who is the proper decisionmaker on questions of fair use -- the judge or a jury -- quite apart from summary judgment. Many courts have described the fair use doctrine as "an equitable rule of reason" and, in some cases, as an "equitable defense." See, e.g., Weissmann v. Freeman, 888 F.2d 1313, 1324 (2d Cir. 1989) (addressing the "equitable defense of fair use"); Fisher v. Dees, 794 F.2d 432, 435 (9th Cir. 1986) ("The fair use doctrine was initially developed by courts as an equitable defense to copyright infringement."); Clean Flicks of Colorado, LLC v. Soderbergh, 433 F.Supp.2d 1236, 1242 (D. Colo. 2006) ("Section 107 is a partial codification of the equitable defense of fair use as an affirmative defense to copyright infringement that has long been a part of the common law of copyright."); Iowa State Univ. Research Found., Inc. v. Amer. Broadcasting Cos., Inc., 621 F.2d 57, 61 (2d Cir. 1980) (recognizing the fair use doctrine as “entirely equitable”); Sony Corp. of Amer. v. Universal City Studios, Inc., 464 U.S. 417, 448 &

n.31 (1984) (fair use requires a court to apply an "equitable rule of reason"); Harper & Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 550 (1985) (same). Congress itself invoked this language when it adopted 17 U.S.C. 107 in 1976. See H.R. Rep. 94-1476 (describing the doctrine of fair use as "an equitable rule of reason"). It is important to note that Congress set out in Section 107 to preserve the common law regime that developed fair use as a defense to copyright infringement. Id.

If fair use was generally applied in the courts of equity, and arose therein as an equitable defense -- akin to laches, acquiescence, or in pari delicto -- then historically it lay outside the province of the jury and belonged to the judge. Even after the merger of courts of law and equity in the United States, this division of labor persists. See, e.g., Granite State Ins. Co. v. Smart Modular Techs., Inc., 76 F.3d 1023, 1027 (9th Cir. 1996) ("A litigant is not entitled to have a jury resolve a disputed affirmative defense if the defense is equitable in nature."); Smith v. World Ins. Co., 38 F.3d 1456, 1462 (8th Cir. 1994) ("[T]he determination of equitable defenses and equitable remedies is a matter for the court to decide, not the jury."); Stephen N. Subrin, How Equity Conquered Common Law: The Federal Rules of Procedure in Historical Perspective, U. Pa. L. Rev., 909, 970-22 (1987). Absent an express declaration by Congress, codification does not alter the historical allocation of responsibilities between judge and jury -- in short, equitable defenses remain a question for the judge. Cf. Danjaq LLC v. Sony Corp., 263 F.3d 942, 962 (9th Cir. 2001) (finding no right to jury trial on the equitable defense of laches in copyright infringement action); Feltner v. Columbia Pictures Television, 523 U.S. 340 (1998) (finding right to jury trial on infringement claim for statutory damages without addressing equitable defenses). Because the Seventh Amendment preserves and protects those jury rights

enjoyed at the founding, this arrangement does not generally offend the Constitution unless "there are issues common to both the equitable and legal claims." Dollar Sys. Inc. v. Avcar Leasing Sys., Inc., 890 F.2d 165, 170 (9th Cir. 1989) (citing Ross v. Bernhard, 396 U.S. 531, 537-38 (1970)). See generally Nancy Gertner & Judith H. Mizner, The Law of Juries 1:5 (2d ed. 2009).

With respect to fair use, the authorities on this question appear to be conflicting or perhaps imprecise, with some dispute over the origins and equitable nature of the defense. Compare 4 William F. Patry, Patry on Copyright, §10:3 (2009); Pierre N. Leval, Toward a Fair Use Standard, 103 Harv. L. Rev. 1105 (1990), with Weissmann, 888 F.2d at 1324; Fisher, 794 F.2d at 435; Kristine Boylan, Life After Quality King; A Proposal for Evaluating Gray Market Activities Under the Fair Use Doctrine, 27 AIPLA Q.J. 109, 128 (1999). Nonetheless, it is clear that a number of courts have permitted the fair use question to go to a jury -- but without addressing the issue raised here. See, e.g., Jartech, Inc. v. Clancy, 666 F.2d 403 (9th Cir. 1982) (upholding special jury verdict finding that defendants' use of films was fair use); BUC Int'l Corp. v. Int'l Yacht Council, 489 F.3d 1129, 1137 (11th Cir. 2007) (noting that fair use defense was presented to the jury); New York Univ. v. Planet Earth Found., 163 Fed. App'x 13 (2d. Cir. 2005) (upholding jury finding of fair use); Compaq Computer Corp. v. Ergonome Inc., 387 F.3d 403, 410-11 (5th Cir. 2004) (upholding the jury's fair use finding); see also Roy Export Co. Estab. of Vaduz, Liech. Black Inc., v. Columbia Broad. Sys, Inc., 503 F. Supp. 1137 (D.C.N.Y. 1980) (citing Meeropol v. Nizer, 560 F.2d 1061, 1071(2d Cir. 1977) (characterizing fair use as a factual question for the jury to decide)); Harris v. San Jose Mercury News, Inc., No. C 04-05262 CRB, 2006 WL 995151, at *1 (N.D.Cal. Apr. 10, 2006) (recognizing fair use as a mixed-

question of law and fact, yet declaring the issue more appropriately resolved by a jury even where facts were not in dispute).[1]

Because of this ambiguity, the parties are directed to brief the issue for the Court -- namely, whether fair use was historically treated as an equitable defense and, if so, whether it is properly decided by the judge or a jury. The Defendant shall incorporate his response in his opposition to summary judgment, which shall be due by **9:00 a.m.** on **Monday, July 20, 2009**, while the Plaintiffs are directed to file a supplemental response by the same deadline.

SO ORDERED.

Date: July 14, 2009 /S/ NANCY GERTNER
NANCY GERTNER, U.S.D.C.

[1] Although these courts and several others have handed the fair use determination to a jury, see 4 William F. Patry, Patry on Copyright, §10:3 n.4 (2009), it is clear that a strikingly large number of courts decide fair use at summary judgment. Professor Beebe's survey of fair use decisions from Section 107's effective date in 1978 through 2005 catalogs 297 dispositive opinions in which a court resolved an asserted fair use without the aid of a jury. See Barton Beebe, An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005, 156 U. Pa. L. Rev. 549, 584 (2008). In more than half these cases, fair use was decided at summary judgment; in the remainder, the court resolved this question on motion for a preliminary injunction or after a bench trial -- again without a jury. Id. at 554, 570-74 (noting "the remarkable increase in the prevalence of fair use summary judgment opinions that began in the mid-1990s"). This propensity may suggest, as a functional matter, that fair use is an equitable question more appropriately decided by a judge than a jury.