

No. 18-877

In The
Supreme Court of the United States

—◆—
FREDERICK L. ALLEN, *et al.*,

Petitioners,

v.

ROY A. COOPER, III,
as Governor of North Carolina, *et al.*,

Respondents.

—◆—
**On Writ Of Certiorari To The
United States Court Of Appeals
For The Fourth Circuit**

—◆—
**BRIEF OF *AMICI CURIAE* AMERICAN LIBRARY
ASSOCIATION, ASSOCIATION OF COLLEGE AND
RESEARCH LIBRARIES, ASSOCIATION OF
RESEARCH LIBRARIES, SOCIETY OF AMERICAN
ARCHIVISTS, AND SOFTWARE PRESERVATION
NETWORK IN SUPPORT OF RESPONDENTS**

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TABLE OF CONTENTS

	Page
INTEREST OF <i>AMICI CURIAE</i>	1
SUMMARY OF ARGUMENT	3
ARGUMENT.....	6
I. State-Run Libraries and Archives Have Not Abused State Sovereign Immunity	6
II. Copyright Holders Have Sufficient Means of Enforcing Their Rights Against State- Run Libraries and Archives	9
III. Elimination of the Sovereign Immunity for Copyright Claims Would Endanger Digital Preservation Efforts by State-Run Librar- ies and Archives	14
A. Library and Archival Collections are Vulnerable to Fire, Flooding, Deteriora- tion, and Obsolescence	15
B. Libraries and Archives Have Initiated Digital Preservation Efforts.....	22
C. Copyright Constrains Digital Preserva- tion Activities.....	24
1. Section 108 is Insufficient.....	26
2. Fair Use is Not Certain.....	27
3. Copyright Damages Can Be Draco- nian	31
CONCLUSION	35

TABLE OF AUTHORITIES

	Page
CASES	
<i>Ass'n for Info. Media & Equip. v. Regents of the Univ. of Cal.</i> , No. CV 10-9378 CBM (MANx) (C.D. Cal. 2011)	13
<i>Authors Guild v. Google, Inc.</i> , 804 F.3d 202 (2d Cir. 2015)	28, 29
<i>Authors Guild, Inc. v. HathiTrust</i> , 755 F.3d 87 (2d Cir. 2014)	<i>passim</i>
<i>A.V. ex rel. Vanderheye v. iParadigms, LLC</i> , 562 F.3d 630 (4th Cir. 2009).....	28, 29
<i>Cambridge Univ. Press v. Albert</i> , 906 F.3d 1290 (11th Cir. 2018).....	4, 12
<i>Cambridge Univ. Press v. Becker</i> , 863 F. Supp. 2d 1190 (N.D. Ga. 2012), <i>aff'd in part, rev'd in part</i> , <i>Cambridge Univ. Press v. Patton</i> , 769 F.3d 1232 (11th Cir. 2014).....	11, 12
<i>Cambridge Univ. Press v. Becker</i> , No. 1:08-cv-1425, 2016 WL 3098397 (N.D. Ga. Mar. 31, 2016), <i>aff'd in part, rev'd in part</i> , <i>Cambridge Univ. Press v. Albert</i> , 906 F.3d 1290 (11th Cir. 2018)	12
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<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994)	28
<i>Chavez v. Arte Publico Press</i> , 204 F.3d 601 (5th Cir. 2000)	6

TABLE OF AUTHORITIES – Continued

	Page
<i>Coyle v. Univ. of Ky.</i> , 2 F. Supp. 3d 1014 (E.D. Ky. 2014)	6
<i>De Romero v. Inst. of Puerto Rican Culture</i> , 466 F. Supp. 2d 410 (D.P.R. 2006).....	7
<i>Eldred v. Ashcroft</i> , 537 U.S. 186 (2003).....	24
<i>Ex Parte Young</i> , 208 U.S. 129 (1908)	4, 9
<i>Flack v. Citizens Mem. Hosp.</i> , No. 6:18-cv-3236, 2019 WL 1089128 (W.D. Mo. Mar. 7, 2019).....	6
<i>Fox News Network, LLC v. TVEyes, Inc.</i> , 883 F.3d 169 (2d Cir. 2018)	30
<i>Golan v. Holder</i> , 565 U.S. 302 (2012)	24
<i>Hairston v. N.C. Agric. & Tech. State Univ.</i> , No. 04-1203, 2005 WL 2136923 (M.D.N.C. Aug. 5, 2005)	7
<i>InfoMath v. Univ. of Ark.</i> , 633 F. Supp. 2d 674 (E.D. Ark. 2007).....	7
<i>Issaenko v. Univ. of Minn.</i> , 57 F. Supp. 3d 985 (D. Minn. 2014)	6
<i>Jacobs v. Memphis Convention & Visitors Bureau</i> , 710 F. Supp. 2d 663 (W.D. Tenn. 2010).....	6
<i>Kelly v. Arriba Soft Corp.</i> , 336 F.3d 811 (9th Cir. 2003)	28, 29, 30
<i>Mktg. Info. Masters, Inc. v. Bd. of Trustees of the Cal. State Univ. Sys.</i> , 552 F. Supp. 2d 1088 (S.D. Cal. 2008).....	6
<i>Perfect 10, Inc. v. Amazon.com, Inc.</i> , 508 F.3d 1146 (9th Cir. 2007).....	28, 29, 30

TABLE OF AUTHORITIES – Continued

	Page
<i>Reiner v. Canale</i> , 301 F. Supp. 3d 727 (E.D. Mich. 2018)	6
<i>Romero v. Cal. Dep’t of Transp.</i> , No. 08-8047, 2009 WL 650629 (C.D. Cal. Mar. 12, 2009).....	6
<i>Salerno v. City Univ. of N.Y.</i> , 191 F. Supp. 2d 352 (S.D.N.Y. 2001)	7
<i>Whipple v. Utah</i> , No. 10-811, 2011 WL 4368568 (D. Utah Aug. 25, 2011).....	6
 STATUTES	
17 U.S.C. § 101	24
17 U.S.C. § 102(a).....	30
17 U.S.C. § 107	3, 5, 10
17 U.S.C. § 108	5, 26
17 U.S.C. § 108(b).....	26
17 U.S.C. § 108(c)	26, 27
17 U.S.C. § 303	25
17 U.S.C. § 504(b).....	31
17 U.S.C. § 504(c)(1).....	31
17 U.S.C. § 504(c)(2).....	5, 31
20 U.S.C. § 1092(a)(1)(P).....	8
 RULE	
Sup. Ct. R. 37.6	1

TABLE OF AUTHORITIES – Continued

	Page
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Jody Rosen, <i>The Day the Music Burned</i> , <i>N.Y. Times Mag.</i> (June 11, 2019), nytimes.com/2019/06/11/magazine/universal-fire-master-recordings.html	18, 19, 22
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TABLE OF AUTHORITIES – Continued

	Page
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Michael E. Ruane, <i>Weathering the 200-year storm</i> , Wash. Post B1 (July 12, 2019)	18
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TABLE OF AUTHORITIES – Continued

	Page
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TABLE OF AUTHORITIES – Continued

	Page
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Statement of Keith Kupferschmid, Chief Executive Officer, Copyright Alliance, Before the United States Senate Committee on Rules and Administration, Sept. 26, 2018 (supporting S. 1010), <i>available at</i> https://copyrightalliance.org/wp-content/uploads/2018/09/CA-S-1010-Register-Bill-Testimony-FINAL-9-26-18.pdf	8
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TABLE OF AUTHORITIES – Continued

	Page
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INTEREST OF *AMICI CURIAE*¹

The American Library Association (“ALA”), established in 1876, is a non-profit professional organization of more than 57,000 librarians, library trustees, and other friends of libraries dedicated to providing and improving library services and promoting the public interest in a free and open information society.

The Association of College and Research Libraries (“ACRL”), the largest division of the ALA, is a professional association of academic and research librarians and other interested individuals. It is dedicated to enhancing the ability of academic library and information professionals to serve the information needs of the higher education community and to improve learning, teaching, and research.

The Association of Research Libraries (“ARL”) is an association of 124 research libraries in North America. ARL’s members include university libraries, public libraries, government and national libraries. ARL programs and services promote equitable access to and effective use of recorded knowledge in support of teaching and research.

¹ Pursuant to Supreme Court Rule 37.6, *amici* affirm that no counsel for a party authored this brief in whole or in part, that no party or counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief, and that no person other than *amici*, their members, or their counsel made such a monetary contribution. All parties have filed blanket consents with the Clerk of this Court consenting to the filing of briefs by *amici curiae*.

Collectively, these three library associations (*amici* library associations) represent over 100,000 libraries in the United States employing over 350,000 librarians and other personnel.

The Society of American Archivists (“SAA”) is the oldest and largest organization of archivists in North America. It serves the education and information needs of its members, including more than 6,000 individual archivists and institutions, and provides leadership to help ensure the identification, preservation, and use of the nation’s historical record. To fulfill this mission, SAA exerts active leadership on significant archival issues by shaping policies and standards, and serves as an advocate on behalf of both professionals who manage archival records and the citizens who use those records.

The Software Preservation Network (“SPN”) is a non-profit organization established to advance software preservation through collective action. Its 20 institutional members are libraries, museums, and archives on the cutting edge of software preservation. Half of SPN’s membership consists of state institutions.

Many of the libraries and archives represented by these organizations are run by state governments and thus enjoy sovereign immunity. All states have state archives and state libraries. Additionally, all state-run colleges and universities have libraries, and many have archives.² The elimination of sovereign immunity with

² In Hawaii, the state government also operates the public library system.

respect to copyright claims would have a negative impact on the digital preservation activities of these state-run collecting institutions. As discussed below in greater detail, digital technology offers libraries an unprecedented ability to preserve the valuable works in their collections. These digital preservation activities implicate the Copyright Act's reproduction and distribution rights, forcing libraries to rely upon the fair use right, 17 U.S.C. § 107, in order to engage in the preservation activities. However, the precise boundaries of the preservation activities permitted by fair use are not certain. Sovereign immunity currently allows state-run libraries and archives to manage this uncertainty by limiting their exposure to damages liability. The elimination of sovereign immunity would expose these collecting institutions to significant damages liability, potentially resulting in a dramatic decrease in digital preservation activity. This will place our cultural heritage at risk.



SUMMARY OF ARGUMENT

1. For the past twenty years, state-run libraries and archives have understood that sovereign immunity shields them against damages liability for copyright infringement. Nonetheless, these collecting institutions have not abused that immunity to pirate the works of copyright holders. To the contrary, during this twenty-year period, they have spent approximately \$30 billion purchasing copyrighted materials.

Libraries also educate university faculty and students on compliance with copyright.

2. Notwithstanding sovereign immunity, copyright holders can still pursue injunctive relief against state officials under *Ex Parte Young*, 208 U.S. 129 (1908). This injunctive relief provides copyright holders with an effective means of vindicating their rights. The handful of litigated cases concerning the allegedly infringing actions of state-run libraries demonstrates the effectiveness of this relief. *See Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87 (2d Cir. 2014); *Cambridge Univ. Press v. Patton*, 769 F.3d 1232 (11th Cir. 2014); *Cambridge Univ. Press v. Albert*, 906 F.3d 1290 (11th Cir. 2018).

3. Even though state-run libraries and archives do not abuse their sovereign immunity, the protection against damages liability enables these collecting institutions to engage in essential digital preservation projects.

A. Library and archival collections are at risk from catastrophic disasters such as floods and fires. Such disasters have destroyed rare published materials and one-of-a-kind masters of sound recordings. Library and archival collections are also vulnerable to degradation from humidity, light, physical or chemical deterioration, and pests. Further, the increasing obsolescence of storage and viewing technologies limits researchers' ability to use the collections.

B. Digital technology offers libraries and archives an unprecedented ability to preserve the valuable works

in their collections. Accordingly, most U.S. collecting institutions have launched digitization projects. For some types of media, such as certain audio and video formats, digitization must occur within the next twenty years, before the materials become unusable.

C. Copyright potentially limits the scope of these preservation efforts. Most of the works in library and archival collections are still in copyright, and preservation activities implicate the Copyright Act's reproduction and distribution rights. Due to the difficulty of obtaining permissions from a large universe of rights holders, libraries and archives must rely upon copyright limitations in order to engage in the preservation activities.

1. 17 U.S.C. § 108 provides specific preservation exceptions for libraries and archives. Enacted in the era of photocopiers, these exceptions do not adequately address the needs of digital preservation.

2. Decisions over the past decade applying the fair use right, 17 U.S.C. § 107, particularly *HathiTrust*, provide libraries and archives with a high degree of confidence that digital preservation of their collections is a fair use. Nonetheless, this confidence is less than certainty; the decisions on which the libraries rely are clustered in three circuits. Moreover, the precise boundaries of the access libraries can provide to the preserved works is unclear.

3. The Copyright Act allows the recovery of statutory damages as high as \$150,000 per work infringed. 17 U.S.C. § 504(c)(2). A large library's collection could

hold 10 million works still in-copyright. The heavy penalties provided by the Copyright Act, multiplied by the large number of works the library would seek to preserve, means that the library's preservation program could theoretically subject it to billions of dollars of copyright damages. By eliminating the possibility of devastating damages, sovereign immunity encourages state-run libraries and archives to engage in cutting-edge preservation projects, to the benefit of students, researchers, and the public at large. At the same time, the possibility of injunctive relief ensures that collecting institutions undertake these expensive projects in a manner respectful of copyright.

ARGUMENT

I. State-Run Libraries and Archives Have Not Abused State Sovereign Immunity.

For the past twenty years, the lower courts have consistently held that the Copyright Remedy Clarification Act is unconstitutional.³ Thus, for the past twenty

³ *Chavez v. Arte Publico Press*, 204 F.3d 601, 607 (5th Cir. 2000); *Flack v. Citizens Mem. Hosp.*, No. 6:18-cv-3236, 2019 WL 1089128, at *3 (W.D. Mo. Mar. 7, 2019); *Reiner v. Canale*, 301 F. Supp. 3d 727, 749 (E.D. Mich. 2018); *Issaenko v. Univ. of Minn.*, 57 F. Supp. 3d 985, 1007-08 (D. Minn. 2014); *Coyle v. Univ. of Ky.*, 2 F. Supp. 3d 1014, 1017-19 (E.D. Ky. 2014); *Whipple v. Utah*, No. 10-811, 2011 WL 4368568, at *20 (D. Utah Aug. 25, 2011); *Jacobs v. Memphis Convention & Visitors Bureau*, 710 F. Supp. 2d 663, 669 (W.D. Tenn. 2010); *Romero v. Cal. Dep't of Transp.*, No. 08-8047, 2009 WL 650629, at *3-5 (C.D. Cal. Mar. 12, 2009); *Mktg. Info. Masters, Inc. v. Bd. of Trustees of the Cal. State Univ. Sys.*,

years, libraries and archives at state colleges and universities, as well as state archives and libraries, have understood that they are immune from damages liability for copyright infringement.⁴ Nonetheless, these collecting institutions have not exploited this immunity to ride roughshod over copyright. Instead, these institutions have spent an estimated thirty billion dollars purchasing copyrighted works.⁵

Moreover, libraries at state colleges and universities play a central role in educating faculty and students concerning compliance with copyright law. Libraries host informational material concerning copyright on their websites.⁶ *E.g.*, UCLA Library, *Learn*

552 F. Supp. 2d 1088, 1092 (S.D. Cal. 2008); *InfoMath v. Univ. of Ark.*, 633 F. Supp. 2d 674, 680-81 (E.D. Ark. 2007); *De Romero v. Inst. of Puerto Rican Culture*, 466 F. Supp. 2d 410, 414 (D.P.R. 2006); *Hairston v. N.C. Agric. & Tech. State Univ.*, No. 04-1203, 2005 WL 2136923, at *8 (M.D.N.C. Aug. 5, 2005); *Salerno v. City Univ. of N.Y.*, 191 F. Supp. 2d 352, 355-56 (S.D.N.Y. 2001).

⁴ In this brief, references to libraries also include archives.

⁵ See Nat'l Ctr. for Educ. Statistics, U.S. Dep't of Educ., *Academic Libraries: 2012*, at 12 (2014); Nat'l Ctr. for Educ. Statistics, U.S. Dep't of Educ., *Academic Libraries: 2010*, at 13 (2011); Nat'l Ctr. for Educ. Statistics, U.S. Dep't of Educ., *Academic Libraries: 2008*, at 13 (2009); Nat'l Ctr. for Educ. Statistics, U.S. Dep't of Educ., *Academic Libraries: 2006*, at 13 (2008); Nat'l Ctr. for Educ. Statistics, U.S. Dep't of Educ., *Academic Libraries: 2004*, at 12 (2006); Nat'l Ctr. for Educ. Statistics, U.S. Dep't of Educ., *Academic Libraries: 2000*, at 38 (2003); U.S. Inst. of Museum and Library Serv., *State Library Administrative Agencies Survey: Fiscal Year 2016*, at 15 (2017).

⁶ The Higher Education Opportunity Act requires institutions that receive federal funding for student financial aid to inform students that the illegal distribution of copyrighted materials may subject them to criminal and civil penalties and describes the

About Copyright, <https://www.library.ucla.edu/support/publishing-data-management/scholarly-communication-resources-education/learn-about-copyright>. Librarians conduct classes on copyright for faculty and students. *E.g.*, Univ. of Tex. Libraries, *Copyright Crash Course*, <https://guides.lib.utexas.edu/copyright>. Librarians also provide guidance to faculty and students on specific copyright issues. *E.g.*, Univ. Libraries, Ohio St. Univ., *Copyright Services*, <https://library.osu.edu/site/copyright/about/>. Librarians do not instruct faculty members, who are state employees, to ignore copyright because of state sovereign immunity.

This is not to suggest that collecting institutions and rights holders always see eye-to-eye. They often disagree on copyright legislation pending in Congress. *Compare* Testimony of Jonathan Band, Counsel, Library Copyright Alliance, Before the United States Senate Committee on Rules and Administration, Sept. 26, 2018 (opposing the Register of Copyrights Selection and Accountability Act, S. 1010), *available at* https://www.librarycopyrightalliance.org/wp-content/uploads/2019/03/Senate_Register_Testimony.pdf, *with* Statement of Keith Kupferschmid, Chief Executive Officer, Copyright Alliance, Before the United States Senate Committee on Rules and Administration, Sept. 26, 2018 (supporting S. 1010), *available at* <https://copyrightalliance.org/wp-content/uploads/2018/09/CA-S-1010-Register-Bill-Testimony-FINAL-9-26-18.pdf>. They engage in fierce

steps that institutions will take to detect and punish illegal distribution of copyrighted materials. 20 U.S.C. § 1092(a)(1)(P). Often the institutions' libraries fulfill this obligation.

negotiations concerning licenses to online journals. Alex Fox & Jeffrey Brainard, *University of California boycotts publishing giant Elsevier over journal costs and open access*, Science (Feb. 28, 2019), <https://www.sciencemag.org/news/2019/02/university-california-boycotts-publishing-giant-elsevier-over-journal-costs-and-open>. On a handful of occasions, rights holders have sued universities for the allegedly infringing activities of their libraries.

II. Copyright Holders Have Sufficient Means of Enforcing Their Rights Against State-Run Libraries and Archives.

The adjudicated disputes between state-run libraries and copyright holders involve complex issues concerning the application of the Copyright Act of 1976 to digital technologies, not flagrant acts of piracy. These cases demonstrate that copyright holders have a means of vindicating their rights against state actors under *Ex Parte Young*, 208 U.S. 129 (1908).

In *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87 (2d Cir. 2014), the Authors Guild sued HathiTrust, a consortium of research universities that operated a digital repository. The Authors Guild also named as defendants a HathiTrust member not entitled to sovereign immunity (Cornell University) and the presidents of four state-run HathiTrust members (University of Michigan, University of California, University of Wisconsin, and Indiana University). The HathiTrust Digital Library (“HDL”) contains electronic copies of more

than ten million books in HathiTrust members' collections digitized by Google in the course of the Google Books Project.⁷ The Authors Guild sued for declaratory judgment and injunctive relief. Both the district court and the Second Circuit found that the copies made by HathiTrust were permitted by the fair use right, 17 U.S.C. § 107.⁸

⁷ HDL created and maintained four copies of its entire database (one on the primary server at the University of Michigan, another at the mirror server at the Indiana University, and two encrypted back up tapes at two secure locations on the University of Michigan campus). 755 F.3d at 92. The copy of each work contains the full-text of the work in machine readable format, as well as images of each page of the work as they appear in the print version. Thus, HDL holds eight permanent copies of each work. *Id.* In addition to preserving the books in the repository, HDL enables full-text search of the books and provides full-text access to people with print disabilities.

⁸ 17 U.S.C. § 107 provides:

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies of phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

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

Notwithstanding state sovereign immunity, the Authors Guild was able to have a federal court adjudicate a copyright infringement claim based on the actions of four state-run universities. If it had prevailed on the merits, the Authors Guild would have succeeded in shutting HDL down. Its interests would have been completely vindicated.

In ongoing litigation, three academic publishers are challenging the electronic course reserve system managed by the library at Georgia State University (“GSU”), which allows students to access sections of books that instructors place on reserve as supplemental reading. The named defendants are members of the GSU Board of Regents and GSU officials. After the publishers filed their complaint, GSU adopted a more rigorous fair use policy that would govern its electronic reserve system. Not satisfied with the new policy, the publishers continued their litigation. The district court conducted a bench trial with respect to 74 claimed infringements that occurred after GSU’s adoption of its new fair use policy. The district court found that publishers failed to establish a *prima facie* case of infringement in 26 instances, that fair use applied in 43 instances, and that GSU infringed copyright in five instances. *Cambridge Univ. Press v. Becker*, 863 F. Supp. 2d 1190 (N.D. Ga. 2012), *aff’d in part, rev’d*

(4) the effect of the use upon the potential market for or value of the copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

in part, *Cambridge Univ. Press v. Patton*, 769 F.3d 1232 (11th Cir. 2014).

The publishers appealed to the Eleventh Circuit, which found errors in aspects of the district court's fair use analysis. *Cambridge Univ. Press v. Patton*, 769 F.3d 1232 (11th Cir. 2014). On remand, the district court found that GSU prevailed on its fair use defense for 44 of the 48 instances. *Cambridge Univ. Press v. Becker*, No. 1:08-cv-1425, slip op. at 18, 2016 WL 3098397 (N.D. Ga. Mar. 31, 2016), *aff'd in part, rev'd in part*, *Cambridge Univ. Press v. Albert*, 906 F.3d 1290 (11th Cir. 2018).

The publishers appealed again, and once more the Eleventh Circuit found errors in the district court's fair use analysis. *Cambridge Univ. Press v. Albert*, 906 F.3d 1290 (11th Cir. 2018). The case is now before the district court again on the second remand. After two reversals, there can be little doubt that the district court will find more infringements than in its previous two decisions.

The GSU litigation demonstrates once again that notwithstanding state sovereign immunity, copyright holders are able to pursue copyright infringement actions against a state actor. The mere filing of a lawsuit caused GSU to adopt a new fair use policy. The district court twice found that under the new policy, GSU infringed the copyright in some of the publishers' works. The litigation continues because the publishers hope

to get an even better result than in the first two rounds before the district court.⁹

These cases prove the falsity of the contention of Petitioners' *amici* that "[s]tates are currently free to infringe copyrights with impunity." Recording Industry Association of America ("RIAA") Br. at 3. Furthermore, the paucity of cases brought against state-run libraries and archives belies the assertion that infringement by state actors is a "serious and accelerating problem." *Id.*¹⁰

⁹ In *Ass'n for Info. Media & Equip. v. Regents of the Univ. of Cal.*, No. CV 10-9378 CBM (MANx) (C.D. Cal. 2011), the district court dismissed the complaint in part on sovereign immunity grounds, but noted that "Plaintiffs are not precluded from asserting their claim for injunctive relief or their claim for damages against Defendants in their individual capacities." The court also found that fair use permitted the claimed infringement: UCLA Library's uploading of a DVD of "The Plays of William Shakespeare" to its server so that it could be streamed to UCLA faculty and students.

¹⁰ In support of its assertion that infringement by state actors is "picking up speed at an alarming rate," RIAA Br. at 18, RIAA cites a list of 170 copyright cases filed against states between 2000 and 2019. *Id.* Thus, in a 19-year period, each state allegedly infringed approximately three times, or about once every five years. This is hardly a torrent of infringement, considering that over 5,000 copyright infringement suits were filed nationwide in 2015, and just under 4,000 in 2016. *Copyright Infringement Litigation Fell 22% in 2FY 2016*, TRAC Reports (Nov. 21, 2016), <https://trac.syr.edu/tracreports/civil/445/>.

III. Elimination of the Sovereign Immunity for Copyright Claims Would Endanger Digital Preservation Efforts by State-Run Libraries and Archives.

Even though state-run libraries and archives do not abuse their sovereign immunity, this immunity enables these collecting institutions to fulfill their mission in the twenty-first century. Digital technology provides libraries an unprecedented ability to engage in preservation on a mass scale. This preservation ensures that future generations of Americans will have access to their cultural heritage. Digital preservation requires reproduction and distribution that libraries and archives believe to be permitted by fair use. However, because of the uncertainty inherent in fair use's case-by-case approach, the precise boundaries of what preservation activities fair use permits is not free from doubt. And because of the heavy penalties provided by the Copyright Act, and the large number of works a library or archives would seek to preserve, a collecting institution's preservation program could theoretically subject it to billions of dollars of copyright damages. By eliminating the possibility of devastating damages, sovereign immunity encourages state-run libraries and archives to engage in state-of-the-art preservation projects, to the benefit of students, researchers, and the public at large. At the same time, the possibility of injunctive relief ensures that collecting institutions undertake these expensive projects in a manner that respects copyright.

A. Library and Archival Collections are Vulnerable to Fire, Flooding, Deterioration, and Obsolescence.

The works in library and archival collections are under constant threat. The fire at the Library of Alexandria in 48 B.C. symbolizes the loss of knowledge caused by the destruction of a repository of works. But disasters, both natural and man-made, have struck at libraries and archives throughout history. The Twentieth Century alone saw massive destruction of collecting institutions due to wars, floods, and fires. United Nations Educational, Scientific, and Cultural Organization, *Memory of the World: Lost Memory—Libraries and Archives Destroyed in the Twentieth Century* (1996).

Although U.S. libraries and archives escaped damage during the World Wars,¹¹ they still fell victim to fires and floods. Flooding in 1937 destroyed hundreds of libraries in Ohio, West Virginia, Indiana, Illinois, and Mississippi. *Memory of the World* at 8. In 1951, the Michigan State Library was seriously damaged by water pumped into the State Office Building to extinguish a fire. *Id.* at 15. In 1966, 70,000 rare books which had escaped destruction in Europe during World War II burned in a fire at the Jewish Theological Seminary Library in New York. Another 150,000 were damaged by the water used to extinguish the fire. *Id.* at 16. In 1968, a fire destroyed the library at the Holyoke Community College in Massachusetts. *Id.* at 17. The

¹¹ The Library of Congress was burned during the British occupation of Washington D.C. during the War of 1812. Michael Harris, *History of Libraries in the Western World* 196 (1999).

following year, a fire destroyed 40,000 volumes at the Indiana University Library. *Id.* In 1972, the flooding in the wake of a hurricane destroyed the rare book and manuscript collection at the Corning Museum of Glass. *Id.* In 1973, a fire at the National Personnel Records Center in St. Louis destroyed more than 16 million Official Military Personnel Files, including the files of 80 percent of the Army personnel discharged between 1912 and 1960, and 75 percent of the Air Force personnel discharged between 1947 and 1964. Nat'l Archives and Records Admin., *The 1973 Fire, National Personnel Records Center*, <https://www.archives.gov/personnel-records-center/fire-1973>. In 1975, the Case Western Reserve University library flooded, damaging 40,000 books and 50,000 maps. Parul Zaveri, *Damage to Libraries due to Water Related Disasters*, *Library Philosophy and Practice* (2014), digitalcommons.unl.edu/libphilprac/1165. A water main break at the Stanford University Library caused major damage to 40,000 books in 1978. *Memory of the World* at 17. In 1986, arson caused the destruction of the Los Angeles Central Library, resulting in the loss of 400,000 volumes, water damage to 700,000, and smoke damage to over 1 million volumes. *Id.* at 18.¹² The Colorado State University library faced a catastrophic flood in 1997, submerging half of the library's collection. Approximately 500,000 bound journals, government documents, and microforms were damaged irreversibly, and the entire collection of bound volumes and science monographs was damaged. Zaveri, *supra*.

¹² This fire is the subject of the best-selling book by Susan Orlean, *The Library* (2018).

This century has been no kinder to libraries and archives than the last. War has destroyed numerous libraries in Iraq, Syria, and Afghanistan, and civil strife has damaged libraries in Egypt, Mali, Lebanon, the Philippines, and Bosnia-Herzegovina. In 2018, the fire in the National Museum of Brazil destroyed the museum's archive of audio recordings of indigenous languages, some of which are no longer spoken. Ed Yong, *What Was Lost in Brazil's Devastating Museum Fire*, *The Atlantic* (Sep. 4, 2018), <https://www.theatlantic.com/fire/569299/>.

U.S. libraries have also continued to face serious flooding. During a severe summer storm in 2000, four feet of water flooded the lower level of the North Dakota State University library, causing extensive damage to the collection. Zaveri, *supra*. Flash floods sent a fifteen-foot-high wall of water through the ground floor of the library of the University of Hawaii at Manoa in October 2004, soaking 230,000 rare maps and aerial photographs. *Id.* Hurricane Katrina in August 2005 destroyed the library at Tulane University. The basement of the library was submerged for three weeks under eight feet of water. A total of 700,000 items in the collection, including print volumes, archival folders, recordings, microfilm reels and cards, were damaged. Additionally, 23 public libraries in Louisiana were destroyed, 33 suffered severe damage and 37 more had moderate damage. In Mississippi, the hurricane destroyed 43 school libraries and eight public libraries. *Id.* Construction in an adjacent building caused a steam pipe to burst and the fire sprinklers to discharge

in the basement of Sterling Memorial Library at Yale University in January 2006. This damaged 4,500 documents in the Southeast Asian collection, including the special collection of Cambodian newspapers. *Id.* Heavy flooding in Iowa in 2008 damaged the collections of the University of Iowa library, the National Czech and Slovak Museum and Library, and the African American Museum of Iowa. *Id.*¹³ In May 2018, a fire at the Kansas State University Library caused soot and smoke damage to most of the library's collection of 1.5 million books. Newsletter, Kan. St. Univ., *One year after devastating fire, Hale Library renovation is underway* (May 20, 2019), <https://www.k-state.edu/media/newsreleases/2019-05/haleupdate52019.html>.

Corporate-run archives are also vulnerable. In 2008, a fire at the sound recordings library of Universal Music Group ("UMG") in Universal City, California, destroyed the masters of 500,000 song titles. Jody Rosen, *The Day the Music Burned*, N.Y. Times Mag. (June 11, 2019), [nytimes.com/2019/06/11/magazine/](https://www.nytimes.com/2019/06/11/magazine/)

¹³ Record-breaking rainfall in the Washington, DC area on June 25, 2006, caused flooding of the National Archives' transformer vaults and sub-basement areas. Fortunately, the flooding did not affect any original records. Press Release, Nat'l Archives and Records Admin., National Archives Building in Washington, DC, Reopens (July 15, 2006), <https://www.archives.gov/press/press-releases/2006/nr06-124.html>. In response to the flooding, the National Archives installed self-rising fiberglass floodgates in 2009. The floodgates prevented any flooding during the July 8, 2019 storm that dropped three inches of rain in a single hour. Michael E. Ruane, *Weathering the 200-year storm*, Wash. Post B1 (July 12, 2019).

universal-fire-master-recordings.html.¹⁴ The incinerated masters included recordings by performers such as Louis Armstrong, Duke Ellington, Ella Fitzgerald, Al Jolson, Bing Crosby, Judy Garland, Billie Holiday, Patsy Cline, Chuck Berry, Muddy Waters, Bo Diddley, Aretha Franklin, Buddy Holly, Count Basie, Dizzy Gillespie, Benny Goodman, the Andrews Sisters, Ray Charles, Sammy Davis Jr., Burl Ives, Loretta Lynn, Merle Haggard, B.B. King, Quincy Jones, Burt Bacharach, Joan Baez, Neil Diamond, Sonny and Cher, the Mamas and the Papas, Joni Mitchell, Cat Stevens, the Carpenters, Gladys Knight and the Pips, Elton John, Eric Clapton, the Eagles, Aerosmith, Steely Dan, Sting, Janet Jackson, Queen Latifah, Sheryl Crow, and Eminem. *Id.* The fire has been described as “the biggest disaster in the history of the music business.” *Id.*¹⁵

¹⁴ A master is the original recording of a song by a performing artist from which all subsequent recordings are made. “A master is the truest capture of a piece of recorded music. . . . Sonically, masters can be stunning in their capturing of an event in time. Every copy thereafter is a sonic step away.” Rosen, *supra*, at 11 (quoting Adam Block, former president of Legacy Recordings).

¹⁵ In 1978, a fire at the Atlantic Records storage facility in Long Branch, N.J. destroyed 5,000 tapes of session reels, alternate takes, and unreleased masters of artists such as Aretha Franklin, Ray Charles, and John Coltrane. Rosen, *supra*, at 23-24. In 2004, a broken water main at UMG’s warehouse in New Jersey flooded a vault with 350,000 master tapes, including the entire Motown catalog. Fortunately, a rapid \$12 million recovery and restoration effort saved these tapes. This flood prompted UMG to move some of its masters from the Universal Studios backlot to Pennsylvania, thereby preventing the 2008 fire from being even more destructive. Rosen, *supra*, at 27-28.

Although these catastrophic fires and floods are the most visible threats to library and archival collections, acidified paper, light, heat, humidity, chemical deterioration, machine obsolescence, termites, and dust are just as pernicious in the long run to collecting institutions' books, magazines, records, films, and magnetic tapes. *Memory of the World* at i, 20-21.¹⁶ High quality paper which may last 1000 years in moderate conditions may deteriorate within 100 to 200 years in humid conditions. *Id.* at 21. Low quality paper such as is used for newspapers and stationery has a significantly shorter lifespan. *Id.* Some kinds of ink fade, other kinds "eat" paper. *Id.* Most of the motion pictures created in first half of the twentieth century were filmed on an unstable, highly flammable cellulose nitrate film base. Because the studios did not store them properly, many of these films have crumbled into dust. It is estimated that 90 percent of all American silent films and 50 percent of American sound films made before 1950 have disintegrated. Nat'l Film Pres. Bd., *A Study of the Current State of American Film Preservation* (1993). Further, preservationists have discovered that the "safety film" that replaced the nitrate film is

¹⁶ In the two years prior to a survey performed by the Institute of Museum and Library Services, 56 percent of the institutions experienced loss or damage from water or moisture; 41 percent from physical or chemical deterioration; 35 percent from light; 27 percent from pests; 44 percent from handling; 24 percent equipment obsolescence; 20 percent from vandalism; 10 percent from natural disaster; and 2 percent from fire. U.S. Inst. of Museum and Library Serv., *Protecting America's Collections: Results from the Heritage Health Information Survey* 18 (2019).

susceptible to color fading and the “vinegar syndrome”—an irreversible film base decay. *Id.*

Early sound recordings were made on wax cylinders, which melt and break easily. They are susceptible to mold, and multiple playbacks degrade sound quality by wearing out the cylinders’ grooves. Half the titles recorded on cylinder records have not survived. Statement of Gregory Lukow, Chief, Packard Campus for Audio Visual Conservation, Library of Congress, Before the Subcommittee on Courts, Intellectual Property and the Internet, U.S. House of Representative Committee on the Judiciary, April 2, 2014 at 6, *available at* <https://docs.house.gov/meetings/JU/JU03/20140402/102046/HHRG-113-JU03-Wstate-LukowG-20140402.pdf> (hearing on preservation and reuse of works). Many radio broadcasters recorded their programs on lacquer-coated aluminum discs. Nat’l Recording Pres. Bd., *The State of Recorded Sound Preservation in the United States: A National Legacy at Risk in the Digital Age* 17 (2010). Unfortunately, the lacquer coating that carries the recorded content is prone to crack and separate from the disc’s aluminum base. Furthermore, during World War II, due to the rationing of aluminum, glass was used to make disc blanks. Many recordings on glass discs have been lost to breakage. *Id.* The shellac phonorecords used in the mass production of commercial sound recordings in the first half of the Twentieth Century, while relatively stable, are susceptible to warpage, breakage, groove wear, and surface contamination. More modern tape-based storage formats for audio and video content are even more vulnerable; over

time, tapes deteriorate and become unplayable. Rosen, *supra*, at 33.

Compounding the problem of the fragility of storage media is the obsolescence of the playback devices for that media. As new formats become popular, it becomes more difficult to source spare parts to refurbish and repair legacy machines. Mike Casey, *Why Media Preservation Can't Wait: The Gathering Storm*, 44 IASA J. 15 (2015). Further, “the knowledge of how to repair old players becomes scarce.” *Id.*

Even “born digital” materials such as computer programs are subject to the risk of loss, corruption, and destruction. Storage formats become obsolete, and the hardware capable of running them become unavailable. Further, data decay occurs due to various failures in storage media. The electrical charges in solid-state media such as flash memory and solid-state drives can leak because of imperfect insulation. Bits stored on magnetic media such as hard disk drives and floppy discs can lose their magnetic orientation. Humidity can also cause the physical deterioration of magnetic media. Similarly, data stored on optical media such as compact discs and digital versatile discs can decay from the physical decomposition of the storage medium. *Recorded Sound Preservation* at 45.

B. Libraries and Archives Have Initiated Digital Preservation Efforts.

Notwithstanding the problem of data decay, digital technology provides an unprecedented opportunity

to preserve our cultural heritage. Lukow, *supra*, at 1. Digital technology enables the making of higher quality copies at lower cost than ever before. These copies can be stored in searchable databases that allow users to locate works far more effectively and efficiently. Searchable databases also enable users to detect patterns across a large number of works, opening new fields of research. Matthew Sag, *The New Legal Landscape for Text Mining and Machine Learning*, 66 J. Copyr. Soc. USA __ (forthcoming 2019); Michael Carroll, *Copyright and the Progress of Science: Why Text and Datamining is Lawful*, 53 U.C. Davis L. Rev. __ (forthcoming 2019). These databases of preserved works consume far less space than the original copies. Additionally, backup repositories and databases can be created and stored in separate locations to ensure their survival.

For these reasons, libraries and archives throughout the United States have embarked on mass digitization projects to preserve their collections. *Protecting America's Collections* at 38. Fully 96 percent of large or medium-sized libraries are digitizing parts of their collections, and 78 percent are preserving some of their born-digital materials. *Id.* at 51. Similarly, 87 percent of archives are digitizing their collections. *Id.* at 49.¹⁷

There is an urgency to these preservation efforts. Because of the ongoing degradation of storage media and the rapidly advancing obsolescence of playback

¹⁷ However, only 52 percent of small libraries are digitizing parts of their collections. *Id.* at 51.

devices, preservationists estimate that there is a fifteen to twenty-year window of opportunity to digitally preserve legacy audio and video recordings. Library of Cong., *National Recording Preservation Plan 7* (2012), (“studies have concluded that many analog audio recordings must be digitized within the next 15 to 20 years—before sound carrier degradation and the challenges of acquiring and maintaining playback equipment make the success of these efforts too expensive or unattainable”).

C. Copyright Constrains Digital Preservation Activities.

Although many libraries and archives engage in digital preservation, copyright constrains these activities. Because of the length of the term of copyright protection, many works published¹⁸ after 1924 are still in copyright.¹⁹ Moreover, many unpublished works, such

¹⁸ Under 17 U.S.C. § 101, a work is published if copies of it have been distributed to the public.

¹⁹ The rules relating to copyright term are extraordinarily complex. This Court has considered the constitutionality of the retroactive extension of copyright term in *Eldred v. Ashcroft*, 537 U.S. 186 (2003) and *Golan v. Holder*, 565 U.S. 302 (2012). Further complicating matters are the special copyright rules pertaining to sound recordings. There is no federal reproduction right in sound recordings created in the United States prior to 1972. However, there is a digital performance right in these pre-1972 sound recordings. Moreover, there is full copyright protection for foreign pre-1972 sound recordings. Additionally, there is copyright protection for the musical compositions or other works recorded in the sound recording. Digital preservation of a sound recording of

as letters and business records, created after 1899 are still in copyright.²⁰ 17 U.S.C. § 303. Obtaining permission to digitize the billions of works in the collections of U.S. libraries and archives is an impossibility. For many archival works, there is simply no way to determine the identity of the rights holder. For older published works, it can be challenging—and costly—to determine the chain of title to the current rights holder.²¹

Accordingly, collecting institutions engage in digital preservation activities either: 1) with respect to older works which are in the public domain; or 2) with respect to newer works under an applicable limitation on copyright. While the older works in the public domain are of great historical and cultural significance, they represent a relatively small portion of the works libraries and archives have collected.²² Thus, digital

music invariably requires reproduction of the musical composition.

²⁰ For many works in archives, it is unclear whether they are published or unpublished, making it difficult for archivists to determine whether they are in the public domain or still under copyright.

²¹ Most transfers of copyright ownership are not recorded at the Copyright Office. If the author retained the copyright, the copyright might now be owned by grandchildren or great grandchildren. If the author transferred the copyright to a publisher, the publisher may no longer be operating and may have dispersed its assets.

²² An estimated 20 percent of published books are in the public domain. See Jonathan Band, *The Long and Winding Road to the Google Books Settlement*, 9 John Marshall Rev. of Intell. Prop. L. 227, 228 (2009).

preservation of the vast majority of the works in their collections must rely on an applicable limitation on copyright.

1. Section 108 is Insufficient.

When it enacted the Copyright Act in 1976, Congress included specific exceptions for preservation by libraries and archives—17 U.S.C. § 108(b) for unpublished works and 17 U.S.C. § 108(c) for published works. These exceptions are of limited utility for digital preservation, however, because they allow only the making of three copies of a work, while digital preservation invariably involves far more intermediate and backup copies. *See* Lukow, *supra*, at 8. The HathiTrust Digital Library (“HDL”), for example, contains eight “permanent” copies of each work in its collection.²³ In addition, its servers made temporary copies of each work in their random-access memory in the course of creating the permanent copies. Further, each time the permanent copies are accessed during the course of a search, additional temporary copies are made. Finally, HDL creates permanent copies of works in its collection needed by students and researchers with print disabilities.

²³ *See* note 7, *supra*. Disaster preparedness practices have evolved since the adoption of section 108 in 1976. It is now understood that copies must be stored in different geographic threat zones (e.g., hurricanes vs. earthquakes vs. fires). Copies also need to be stored in different formats to mitigate against hardware failures.

The exception for preservation of published works, 17 U.S.C. § 108(c), is inadequate for digital preservation in other respects. First, section 108(c) allows a library or archives to make a copy only *after* the copy in its collection is damaged or deteriorating, or the format in which the work is stored has become obsolete.²⁴ This means that a library may not make a digital copy when its original copy is still in good condition. The digital copy, therefore, will be of low quality or incomplete. See Lukow, *supra*, at 8.²⁵ Second, section 108(c) allows a library or archives to make a copy only if, after a reasonable effort, it has determined that an unused replacement copy cannot be obtained at a fair price. This places a significant administrative burden on collecting institutions.

2. Fair Use is Not Certain.

As a result of the limitations of section 108, libraries and archives must principally rely on the fair use right to engage in digital preservation of works still in copyright. The fair use jurisprudence over the past decade gives collecting institutions a high degree of confidence that digital preservation of their collections is a fair use. Nonetheless, this confidence is less than

²⁴ For this reason, section 108(c) arguably does not address preservation of copies in a collection, but just replacement of copies that are no longer useable. Section 108 Study Group, *The Section 108 Study Group Report* 18 (2008).

²⁵ For example, because aging film warps and shrinks and thus cannot lie flat, digital reproductions wobble and are often out-of-focus.

certainty. Moreover, the precise boundaries of the access permitted to the preserved works is unclear.

As noted above, the Second Circuit in *HathiTrust* ruled that fair use permitted a consortium of libraries to create and maintain a database of electronic copies of over ten million books. In finding that HathiTrust's provision of full-text search functionality was a fair use, the court relied heavily on the Court's decision in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), particularly *Campbell's* focus on the importance of transformative use under the first fair use factor, the purpose and character of the use. The *HathiTrust* court concluded that "creation of a full-text searchable database is a quintessentially transformative use," because it "does not 'supercede the objects or purposes of the original creation,'" 755 F.3d at 97 (quoting *Campbell*, 510 U.S. at 579). The *HathiTrust* court also relied on two Ninth Circuit decisions concerning Internet search engines—*Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003) and *Perfect 10, Inc., v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007)—as well as a Fourth Circuit decision involving a plagiarism detection database—*A.V. ex rel. Vanderheye v. iParadigms, LLC*, 562 F.3d 630 (4th Cir. 2009). A year after *HathiTrust*, another Second Circuit panel reaffirmed *HathiTrust's* holdings in *Authors Guild v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015).

The *HathiTrust* court did not explicitly rule that digital preservation *per se* was a fair use. However, it observed that "[b]y storing digital copies of the books, the HDL preserves them for generations to come, and

ensures that they will still exist when their copyright terms lapse.” 755 F.3d at 103. Moreover, any library or archives that engaged in a mass digitization project for preservation purposes would invariably provide search functionality, which *HathiTrust* (and *Google*, *Arriba Soft*, *Perfect 10*, and *iParadigms*) explicitly found legitimated the creation and maintenance of full-text and full-image databases. *See also* Sag, *supra*; Carroll, *supra*.

This cluster of circuit court decisions provides libraries and archives with a high degree of confidence that courts would find their digital preservation activities to be fair uses. Nonetheless, these decisions come from three circuits, and it is possible that courts in other circuits may come to different conclusions.²⁶

More significantly, there is far less clarity concerning the access collecting institutions may provide to the digitally preserved copies. In *HathiTrust*, HDL provided users with no access to the text of the stored books. Rather, HDL provided a user with just the page numbers of books where her search term appeared, and the user had to find the original books in the university library in order to read their text. The only

²⁶ For example, a court in another circuit might wrongly decide that it would need to consider a library’s digital preservation project on a work-by-work basis, rather than finding that the project as a whole satisfies fair use. That is the approach adopted by the Eleventh Circuit in the GSU case discussed above. To be sure, the case is distinguishable because the GSU electronic course reserve system provided students with access to the full text of the stored chapters of in-print books, thereby arguably displacing license fees.

exception to this rule was users with print disabilities; the *HathiTrust* court found that fair use permitted HDL to provide such users with the full text in an accessible format.

In contrast to HDL, Google Books displayed a limited amount of text in response to a search query: three “snippets” measuring one-eighth of a page each. The Google court found this limited display constituted fair use. Conversely, in *Fox News Network, LLC v. TVEyes, Inc.*, a different Second Circuit panel found that fair use did not permit a search database of television news broadcasts to provide users with access to ten-minute clips. 883 F.3d 169 (2d Cir. 2018). In both *Arriba Soft* and *Perfect 10*, the Ninth Circuit allowed the display of entire images, but in reduced size and resolution.

Given this array of holdings, and the enormous variety of works and potential users, a library or archives must make a complex set of fair use determinations concerning the level of access to provide to its digitally preserved copies. For example, could a library provide more access to works that are out of commercial distribution, or that never were commercially distributed? Should it provide access only on the library premises, or off-site to accredited researchers? Should it treat the distinct categories of works listed in section 102(a) differently? Looming over these determinations is the threat of significant copyright damages.

3. Copyright Damages Can Be Draconian.

The Copyright Act allows the recovery of statutory damages in the amount of up to \$150,000 per work infringed. The heavy penalties provided by the Copyright Act, multiplied by the large number of works a library or archives would seek to preserve, means that a collecting institution's preservation program could theoretically subject it to billions of dollars of copyright damages. By eliminating the possibility of devastating damages, sovereign immunity encourages state-run libraries and archives to engage in projects designed to preserve our cultural heritage before it is lost.

The Copyright Act allows the recovery of actual damages and any additional profits of the infringer attributable to the infringement. 17 U.S.C. § 504(b). Alternatively, the infringer can recover statutory damages of between \$750 and \$30,000 per work infringed, "as the court considers just." 17 U.S.C. § 504(c)(1). In cases of willful infringement, the court has the discretion to increase the award of statutory damages to \$150,000 per work infringed. 17 U.S.C. § 504(c)(2).

U.S. collecting institutions hold approximately 12 billion works, including 1 billion books, almost 5 billion photographs, 4.3 billion unbound documents, 32 million motion pictures, 24 million sound recordings, and 25 million art objects. *Protecting America's Collections* at 16.²⁷ A large research library could hold well over

²⁷ There may be as many as 250 million audio recordings that are considered preservation-worthy but have not yet been digitized. Bertram Lyons, *Quantifying the Need: A Survey of Existing*

12.5 million works, potentially subjecting it to statutory damages of between \$7.5 billion and \$1.5 trillion for digitizing its collection (assuming that 80 percent of its collection is in-copyright).

A court must reduce the statutory damages to zero when the infringer is a non-profit library or archives and it “believed and had reasonable grounds for believing” that its reproduction of the copyrighted work “was a fair use under section 107.” 17 U.S.C. § 504(c)(2). Significantly, this safe harbor applies only to infringement of the *reproduction* right, not the *distribution*, *performance*, or *display* rights. Thus, the research library could still be liable for statutory damages for distributing, transmitting, or displaying the works it preserved, regardless of whether it believed and had reasonable grounds for believing that fair use permitted it to provide such access.

Moreover, the research library would still be liable for actual damages for its infringement of the reproduction right. With 10 million infringed works, the actual damages could be significant, even if only a fraction still had commercial value.

This is where sovereign immunity comes in. Sovereign immunity would protect a state-run research library from the risk of a court imposing statutory damages for the library’s infringement of distribution right if the court found that fair use did not allow the

Sound Recordings in Collections in the United States 2 (2014), <https://www.avpreserve.com/wp-content/uploads/2017/07/QuantifyingTheNeed.pdf>.

access the library provided to its digitized collection; or of a court imposing actual damages for any infringement of the reproduction right incidental to the library's digital preservation activities.

Because of the potential for catastrophic damages without sovereign immunity, the state-run research library might be overly cautious in its fair use analysis. For example, until a court in its circuit rules that library digitization is a fair use, the library might decide not to digitize in-copyright works, thereby placing important parts of its collection at risk. Or, if the library proceeds to digitize in-copyright works, it might keep its digitized copies in a "dark archive," allowing no access until a work enters the public domain. This restriction of access could undermine the library's fulfillment of its mission of increasing access to knowledge.²⁸ See Lukow, *supra*, at 2.

At the same time, the possibility of a court issuing an injunction is sufficient to ensure that the research library would conduct digitization projects in a responsible manner. Even though the cost of digitization has decreased, it remains extremely expensive, especially for large collections or collections of fragile works. Additionally, because of the problem of data decay discussed above, digitization is not a one-time cost. Once the library digitizes its collection, it needs to expend significant additional resources to ensure that the digitized copies remain sound. Having borne the cost of

²⁸ For this reason, it is unlikely that a library would go to the effort of digitizing its collection, just to keep it in a dark archive.

digitization and subsequent maintenance, the library would not want to adopt reckless access policies that would jeopardize its substantial investment. Accordingly, the threat of injunctive relief is reason enough for libraries and archives to apply fair use carefully.

Of course, not all libraries and archives with culturally significant collections are state run. Private university libraries with collections of rare or unique items do not enjoy sovereign immunity. Nor do public libraries run by municipalities. However, many of the most important collections of our cultural heritage are housed in state-run libraries and archives, and they are on the cutting edge of digital preservation efforts.²⁹ It is no accident that the University of Michigan Library was the first library to partner with Google in the Google Books Project; and that the HDL database is stored at the University of Michigan and Indiana

²⁹ In 2013, Indiana University (“IU”) launched the Media Digitization and Preservation Initiative (“MDPI”), targeting the audio and video recordings in its collection that were on obsolete formats that were actively degrading. To date, the MDPI has digitized 320,000 audio and video recordings, which represents 88 percent of IU’s holdings in these media types that it considers to have significant research value. MDPI also has digitized 13,000 film reels out of a total of 96,000 in IU’s collection. *Media Digitization and Preservation Initiative*, Ind. Univ., <https://mdpi.iu.edu/index.php>.

The University of California, Santa Barbara, has digitized and made available for download or streaming its collection of 10,000 cylinder recordings, including 650 personal wax cylinder recordings made by individuals in their homes. Univ. of Cal., Santa Barbara, *About the UCSB Cylinder Audio Archive*, <http://cylinders.library.ucsb.edu/overview.php>.

University. They were willing to take risks that private libraries would not.



CONCLUSION

For the foregoing reasons, the Court should affirm the decision below.

Respectfully submitted,
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