

11-2020

Fair Use in Sayre v. Moore: A Reply to Oracle

Ned Snow

Follow this and additional works at: https://scholarcommons.sc.edu/law_facpub

 Part of the [Law Commons](#)

FAIR USE IN *SAYRE V. MOORE*: A REPLY TO ORACLE

Ned Snow*

The Supreme Court is now considering the case of Google LLC v. Oracle America, Inc. Oracle has argued that Google infringed its copyright in computer software, but a jury found that Google's use was not infringing under the fair use doctrine. The Federal Circuit reversed the jury verdict under a de novo standard of review. I have argued that this reversal violates the Seventh Amendment.

Seventh Amendment rights depend on whether an issue would have been decided by a jury in English law courts during the late 1700s. My argument is that in the 1785 English case of Sayre v. Moore, the court required a jury to decide an issue that is analogous to fair use, so the Seventh Amendment applies to Google's jury verdict. But some have criticized my interpretation of Sayre, construing it instead to be about other copyright doctrines, such as the fact-expression dichotomy or independent creation. This Essay responds to those criticisms. It analyzes the text of the Sayre opinion and makes observations based on that analysis. The Essay concludes that the issue put to the jury in Sayre was closely analogous to the modern issue of fair use.

INTRODUCTION

The Supreme Court will be deciding a copyright case this term, *Google LLC v. Oracle America, Inc.*, which concerns Google's use of software that Oracle holds a copyright in. A jury found for Google on the issue of fair use, and the Federal Circuit reversed that verdict under a de novo standard of review.¹ Recently I wrote an article and submitted an amici brief arguing that the Federal Circuit's reversal violated the Seventh Amendment.²

Since I wrote the article, some have challenged my interpretation of a key case in the argument—*Sayre v. Moore*.³ *Sayre* is a 1785 English case in which a

* Ray Taylor Fair Professor of Law, University of South Carolina. A draft of this Essay was presented at the Chicago Kent College of Law, 2020 Supreme Court IP Review: Preview of *Google v. Oracle*.

1. Oracle Am., Inc. v. Google LLC, 886 F.3d 1179 (Fed. Cir. 2018).

2. Ned Snow, *Who Decides Fair Use—Judge or Jury?*, 94 WASH. L. REV. 275 (2019); Brief of Amici Curiae Civ Pro, IP & Legal History Professors in support of Petitioner, *Google LLC v. Oracle Am., Inc.*, No. 18-956 (Jan. 7, 2020), https://www.supremecourt.gov/DocketPDF/18/18-956/127739/20200107121121412_39073%20pdf%20Snow.pdf [<https://perma.cc/B7G3-GMWN>].

3. (1785) 102 Eng. Rep. 138, 139–40 n.(b); 1 East 358, 361–62.

jury sitting in a court of law decided an issue closely analogous to fair use. This conclusion is crucial to my Seventh Amendment argument because the constitutional requirement for deference to a jury verdict depends on whether a jury would have heard the issue (or an analogous one) in an English court of law at the time of the Seventh Amendment.⁴ Some, however, have cast doubt on my interpretation. They have suggested that the jury issue in *Sayre* did not concern fair use, but rather dealt with an issue more closely akin to the fact-expression dichotomy,⁵ or alternatively, an issue about whether the defendant did in fact copy from the plaintiff's work.⁶ Respecting these contrary interpretations, I now further analyze the reasoning of *Sayre* to support my interpretation that the issue in *Sayre* is analogous to the modern doctrine of fair use.

Part I sets forth the text of the legal reasoning in *Sayre v. Moore*. Part II provides a textual analysis of that reasoning. Part III makes observations based on the entire passage and the context of the time period.

I. THE OPINION

The issue in *Sayre* concerned whether a defendant, who had copied sea charts of the plaintiff, had infringed the plaintiff's copyright. The case arose in a court of law, and the opinion was written by Lord Mansfield. The entirety of Mansfield's analysis consists of the fifteen sentences quoted below. These sentences, however, do not include the evidence of the case which is recited above the analysis in the opinion. For ease of reference, I have numbered each sentence:

[1] The rule of decision in this case is a matter of great consequence to the country.

[2] In deciding it we must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded.

[3] The Act that secures copy-right to authors guards against the piracy of the words and sentiments; but it does not prohibit writing on the same subject.

[4] As in the case of histories and dictionaries: in the first, a man may give a relation of the same facts, and in the same order of time; in the latter an interpretation is given of the identical same words.

4. See *Feltner v. Columbia Pictures Television, Inc.*, 523 US. 340, 347–48 (1998).

5. See Justin Hughes, *The Respective Role of Judges and Juries in Fair Use*, 58 HOUS. L. REV. 5–7 (forthcoming 2020).

6. See Supplemental Brief of Respondent at 9, *Google LLC v. Oracle Am., Inc.*, No. 18-956 (Aug. 7, 2020), https://www.supremecourt.gov/DocketPDF/18/18-956/149667/20200807132108693_2020.08.07%20Oracle%20Supplemental%20Brief.pdf [<https://perma.cc/JNB9-LLPF>] (“[T]he sole question the court identified for the jury was whether the substantial similarity between maps was due to copying, versus simply reflecting the same geographic elements that anyone is free to document.”).

[5] In all these cases the question of fact to come before a jury is, whether the alteration be colourable or not?

[6] there must be such a similitude as to make it probable and reasonable to suppose that one is a transcript of the other, and nothing more than a transcript.

[7] So in the case of prints, no doubt different men may take engravings from the same picture.

[8] The same principle holds with regard to charts; whoever has it in his intention to publish a chart may take advantage of all prior publications.

[9] There is no monopoly of the subject here, any more than in the other instances; but upon any question of this nature the jury will decide whether it be a servile imitation or not.

[10] If an erroneous chart be made, God forbid it should not be corrected even in a small degree, if it thereby become more serviceable and useful for the purposes to which it is applied.

[11] But here you are told, that there are various and very material alterations.

[12] This chart of the plaintiffs' is upon a wrong principle, inapplicable to navigation.

[13] The defendant therefore has been correcting errors, and not servilely copying.

[14] If you think so, you will find for the defendant; if you think it is a mere servile imitation, and pirated from the other, you will find for the plaintiffs.

[15] Verdict for the defendant.⁷

II. TEXTUAL ANALYSIS

Mansfield starts broad. He sets forth the importance of the case in Sentences 1 and 2, explaining that this case concerns a tension between providing a “reward” to “men of ability” for their “just merits” and allowing for “improvements” that would benefit “the world” and further “the progress of the arts.”⁸ In other words, he identifies a tension between enforcing the copyright so as to reward authors for their labor and allowing others to improve upon existing works so as to further societal progress.

Although these sentences do not speak directly to whether the case concerns fair use, it is notable that fair use does raise this tension that Mansfield identifies (as does the fact-expression doctrine). Notably, though, this tension would not be present if the issue of the case concerned whether the defendant had in fact copied from the plaintiff. The issue of whether copying actually occurred does not raise concern over protecting “improvements” on existing works.

7. (1785) 102 Eng. Rep. 138, 140 n.(b).

8. *Id.*

Hence, Sentence 2 appears inconsistent with an interpretation suggesting that the case deals with whether copying occurred.

In Sentence 3, Mansfield begins reciting the law. He recounts a principle with which no one would disagree: the Act's prohibition of piracy does not prevent two people from independently writing on the same subject. Today we would label this principle *independent creation*.

Mansfield continues this line of thought in Sentence 4. He gives two examples of independent creation: independently created histories and independently created dictionaries. Two men might write historical accounts using the same facts and order of events, and they may also write dictionaries that define the same set of words. There is no doubt that these examples illustrate independent creation.

In Sentence 5, Mansfield poses the question that would come before a jury in these sorts of independent-creation cases: "whether the alteration be colourable or not." Notably, the meaning of *colourable* here is deceptive or specious—an older meaning in the law.⁹ With this understanding, we see that in these independent-creation cases, the jury decides whether a second author has in fact made his own creation or, alternatively, has made some specious changes to the first author's work so as to make it look like it is his own independent creation.

I pause here to ask a question. Why is Mansfield talking about independent creation at all? The opinion's recitation of evidence indicates that the defendant was *not* arguing independent creation. Specifically, in reciting the evidence before the court, the opinion states: "It appeared in evidence that the defendant had taken the body of his publication from the work of the plaintiffs, but that he had made many alterations and improvements thereupon."¹⁰ Likewise, a witness for the defendant had testified: "That there were very material errors in the plaintiffs' maps. . . . That most of these, as well as errors in the foundings, were corrected by the defendant."¹¹ Simply put, this case could not have been about whether copying actually occurred. Rather, it was about whether the defendant made improvements that would suggest against a finding of piracy. Why, then, is Mansfield bringing up the issue of determining whether copying had occurred, i.e., independent creation?

The answer is that Mansfield begins by reciting a principle with which everyone agrees (independent creation), along with its corresponding jury issue (whether a defendant made specious alterations) in order to derive a related but distinct legal principle. He begins his move into this distinct legal principle in Sentence 6.

At first glance, Sentence 6 seems to straightforwardly answer the question posed in Sentence 5: the way to discern between an independent creation and a mere specious alteration is to identify "such a similitude" between the two works at issue that the defendant's must be a "transcript" of the plaintiff's. But then

9. *Colourable*, OXFORD ENGLISH DICTIONARY ONLINE (entry 2.a) ("Intended to deceive or to conceal a true purpose; fraudulent; feigned, pretended, spurious.")

10. (1785) 102 Eng. Rep. 138, 139 n.(b).

11. *Id.* at 140 n.(b).

Mansfield adds a rather telling clause at the end of Sentence 6: “and *nothing more* than a transcript.”¹² This “nothing more” clause is puzzling, for Mansfield has set up that clause so that it will introduce an idea that contrasts with creating a similar transcript. Given that independent creation is the doctrine that Mansfield has taught in the prior three sentences, we would expect Mansfield at this point in Sentence 6 to refer to an independent creation as the contrasting alternative to works that are of “such a similitude.” Yet if the clause were describing an independent creation, it would be describing how a second work would be *less than* a mere transcript. Only if the second work were less than a transcript would the two copies lack sufficient similarity, thereby implying that the second work is an independent creation. Mansfield goes the opposite direction. He gives as a contrast to an infringing transcript the possibility of something “more” being added to the transcript. The word *more* implies that the second work constitutes the transcript plus something else. Putting this together, we see that Mansfield is suggesting that in contrast to copying that is an infringement, copying that adds something else would not be infringing. Stated differently, the nothing-more clause does not contrast with the act of copying, but rather, with the ultimate conclusion of infringement. Mansfield is telling us that adding more to the transcript copy is not infringement.

Sentence 7 continues this principle that Mansfield introduces in the nothing-more clause by provides validating examples. This continuation of thought is apparent as he starts Sentence 7 by stating, “So in the case of prints,” which indicates that he is now applying the principle in Sentence 6 to an example involving prints. That example is informative: “different men may take engravings from the same picture.”¹³ Men may copy the expression (not merely the fact) of a picture to create their own engravings of the picture. Plainly, this example is intended to illustrate the case in which infringement would not occur, or in the words of Sentence 6, where a copy constitutes “more than a transcript.” The reason, then, that men can take expression from an existing picture is because the process of engraving the picture requires them to add something more to the picture.

Perhaps, though, Mansfield is instead illustrating that two men may create their similar engravings independently without infringing, even though they share the same source. That is to say, could Mansfield’s example in Sentence 7 be returning us to independent creation? The answer lies in Sentence 8. There, Mansfield explains that he is now applying “[t]he same principle” from Sentence 7 to the sort of expression under consideration in the case before him, sea charts. He applies that same principle by declaring that whoever intends to create a chart may “take advantage of all prior publications.”¹⁴ In other words, people may copy existing works without infringing. Sentence 8 thus implies that the principle discussed in Sentence 7 could not be an independent creation. In Sentence 7, Mansfield must be talking about copying the prior expression (i.e., the picture).

12. *Id.* (emphasis added).

13. *Id.*

14. *Id.*

Sentence 8 is further notable because it does not suggest that a person must copy only unprotected portions of a prior publication. Mansfield provides no qualification that would exclude copying expression. Therefore, especially when viewed in conjunction with copying a picture (i.e., expression) in Sentence 7, Sentence 8 does not appear to suggest the fact-expression dichotomy.

In Sentence 9, Mansfield begins by reciting the well-established principle that one cannot monopolize a subject matter. From this premise, one might expect Mansfield to explain independent creation. But once again, he goes a different direction. He proceeds to explain that “the jury will decide whether [the defendant’s copying] be a servile imitation or not.”¹⁵ The meaning for *servile* here is “slavish” or “unintelligently close to the . . . original,” as defined in the Oxford English Dictionary.¹⁶ The jury’s inquiry, then, is not into whether copying occurred, but rather, it is into whether copying occurred in a slavish manner. This is not an independent-creation inquiry. Moreover, Sentence 9 implies that *non-slavish* copying would not be infringing. Copying that involves intelligent thought, resulting in a work that is not too close to the original, would seem permissible under the logic of Sentence 9.

In Sentence 10, Mansfield observes value in the sort of use that the defendant has alleged—specifically, the correction of mistakes on a faulty sea chart. This observation of Mansfield is consonant with the first factor of the modern fair use test, which also evaluates the value of the defendant’s use.¹⁷ Sentences 11, 12, and 13 set forth the argument of the defendant that the jury is to consider. That argument is that the defendant made “various and very material alterations” (Sentence 11); that the plaintiff’s charts do not allow for proper navigation (Sentence 12); and that the defendant was correcting errors in those charts rather than slavishly copying (Sentence 13).¹⁸ This argument sounds very much like elements in a modern fair use argument. It touches on the purpose of the defendant’s use (correcting errors), the transformative nature of the use (making various and material alterations), and arguably the nature of the plaintiff’s work (faulty for navigation).¹⁹ Tellingly, these Sentences do not suggest a principle that would recognize less copyright protection in factual information. Nor do they concern independent creation. Taken together, Sentences 10-13 represent the analogue to the modern fair use doctrine.

In Sentence 14, Mansfield charges the members of the jury that if they “think so,” they should find for the defendant.²⁰ Importantly, “think so” refers to the defendant’s arguments set forth in Sentences 11-13. Those arguments, and only those arguments, are the ones that determine whether the defendant should

15. *Id.*

16. *Servile*, OXFORD ENGLISH DICTIONARY ONLINE (entry 6) (“Of imitation (esp. in literature and art), translation, etc.: unintelligently close to the exemplar or original; ‘slavish’. Hence of a person as agent.”).

17. See 17 U.S.C. § 107(1) (examining “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes”).

18. (1785) 102 Eng. Rep. 138, 140 n.(b).

19. See 17 U.S.C. § 107.

20. (1785) 102 Eng. Rep. 138, 140 n.(b).

be held liable for copying. And as mentioned above, those arguments are closely akin to the sort that we would find in today's fair use doctrine.

The last point to note from Mansfield's opinion arises in Sentences 14 and 3. Sentence 14 indicates that if the jury does not accept the defendant's arguments in Sentences 11-13, then that conclusion means the defendant's work is "pirated."²¹ In other words, if the use is not permissibly fair, it is infringing. Keeping this in mind, recall that Sentence 3 sets forth the unremarkable proposition that the Act protects against "piracy." Read together, then, Sentences 14 and 3 make a subtle but important point: the copyright doctrines discussed between Sentences 3 and 14 define whether a defendant has "pirated" a work in violation of the Act. This point matters a lot. It means that the argument that the jury considers in Sentences 11-13 determines whether a legal right has been infringed. That is, the fair use principles are defining the legal right. So not only does Mansfield send the issue to the jury, but he calls out the fact that the issue determines infringement of a legal right. Put more bluntly, if *Sayre* is indeed a fair use case (or its analogue), *Sayre* satisfies the Seventh Amendment historical test.

III. OBSERVATIONS

We thus observe that Mansfield begins with a principle that is undeniable—i.e., independent creation is not a piracy—and ends with a principle that is perhaps less established at the time—i.e., improvements on a plaintiff's work may not be a piracy. Starting with independent creation, he moves to similarity that implies copying, and then transitions to a discussion about copying that adds something valuable to the original. He points out that both principles call for a jury to make a judgment about alterations: the independent-creation principle calls for a judgment about whether alterations are specious, and the non-infringing-improvement principle calls for a judgment about whether alterations are material. In so many words, he is drawing on independent creation to arrive at a principle that recognizes non-infringement based on a defendant's use.

We also observe that in the second half of the opinion, when Mansfield is applying the law to the facts, he engages in a fair use sort of analysis. The first factor of the modern fair use doctrine examines "the purpose and character" of a defendant's use.²² Similarly, Mansfield calls for an examination of whether a defendant's use would be "more serviceable and useful" (Sentence 10).²³ Furthermore, the first fair use factor requires consideration of whether a defendant's use "adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message."²⁴ Mansfield likewise suggests that adding something more to the original, by correcting errors, would not be infringing (Sentences 6-9). In that regard, he asks the jury to consider whether

21. *Id.*

22. See 17 U.S.C. § 107(1).

23. (1785) 102 Eng. Rep. 138, 140 n.(b).

24. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

the defendant made “various and very material alterations” to the original work.²⁵ In short, Mansfield’s analysis posits that a defendant’s copying of the plaintiff’s work could be non-infringing depending on the sort of use made. That sounds a lot like fair use.

Notably, nowhere in the opinion does Mansfield suggest that sea charts receive less protection because of their factual nature. Although he states that “[t]here is no monopoly of the subject here” (Sentence 9),²⁶ he never connects that statement to the factual nature of the charts. There is no mention of the work’s factual nature as a basis for implying less protection or permissible copying. Yet even if we were to construe this statement to mean that the factual nature of the charts suggests against infringement, this construction supports the fair use analysis. The second factor of the modern fair use doctrine examines the nature of the copyrighted work, including whether that work is more factual than creative.²⁷ Hence, if Mansfield were suggesting that the sea charts should receive less protection because they are factual, this falls in line with fair use.

In the end, Mansfield does not treat this case as turning on the factual nature of the sea charts. Yet why not? Sea charts are mostly factual, so the fact-expression dichotomy would seem to be the doctrine that he should have employed. Indeed, it is difficult *not* to think of *Sayre* as a fact-expression case.²⁸ But this is not a modern case. This is a 1785 case. At that time, copyright gained legitimacy from Locke’s labor-desert theory. Indeed, Mansfield recites that theory in Sentence 2: “men of ability” who have “employed their time” should “not be deprived of their just merits” or “the reward of their ingenuity and labour.”²⁹ To be sure, Lockean theory is on the plaintiff’s side of the *Sayre* lawsuit. This means that the strength of the plaintiff’s copyright does not depend on creativity (as it would today under *Feist*) as much as it does sweat of the brow. In other words, the factual nature of the plaintiff’s subject matter does not significantly weaken the copyright protection (and perhaps not even at all)—unlike it would under modern precedent.³⁰ Therefore, it is unsurprising that Mansfield does not rely on the factual nature of sea charts to determine whether the defendant infringed. Instead, he relies on the merits of the defendant’s use—what today we call fair use.

CONCLUSION

Sayre v. Moore applies principles of the modern fair use doctrine to the facts of the case. It is not a case that applies the fact-expression dichotomy or the

25. (1785) 102 Eng. Rep. 138, 140 n.(b).

26. *Id.*

27. See 17 U.S.C. § 107(2) (examining “the nature of the copyrighted work”); *Campbell*, 510 U.S. at 586.

28. See *Feist Pub’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344 (1991).

29. (1785) 102 Eng. Rep. 138, 140 n.(b).

30. This conclusion draws further support from the 1790 Copyright Act, which lists three categories of protectable works: maps, charts, and books. See Copyright Act of 1790, ch. 15, 1 Stat. 124 (amended 1831). The former two categories would receive only thin copyright protection under modern precedent. See *Feist*, 499 U.S. at 344–45, 349.

independent creation doctrine to the facts. The jury was not charged to evaluate whether the defendant used unprotected factual elements of the plaintiff's sea charts. Nor was the jury charged to consider whether the defendant actually copied those charts. Instead, Mansfield charged the jury to consider the value of the defendant's use—correcting errors in faulty sea charts—to determine whether infringement occurred. That is the only issue that the jury considered. And that is fair use.³¹

31. I respond to three additional points raised against my position. First, evidence outside the case suggests that Mansfield employed a "special jury"—a group of merchants—in *Sayre*. See Hughes, *supra* note 5, at 6 (suggesting that the special jury might detract from a Seventh Amendment argument). Does this fact affect the Seventh Amendment analysis? Professors William Luneburg and Mark Nordenberg have concluded that this fact should not affect the analysis. See William V. Luneburg & Mark A. Nordenberg, *Specially Qualified Juries and Expert Nonjury Tribunals: Alternatives for Coping with the Complexities of Modern Civil Litigation*, 67 VA. L. REV. 887, 903 (1981). In their insightful article, they explain: "the special jury was an acceptable form of jury at common law and would, therefore, meet the seventh amendment's historical test." *Id.* at 903–04. They point out that in 1730, Parliament passed a statute allowing any litigant in a criminal or civil case to request a special jury. *Id.* Modern courts have not indicated that a special jury used in the past would be insufficient to trigger a jury right under the Seventh Amendment today.

Second, Professor Hughes calls attention to a statement by the Lord Chancellor in *Gyles v. Wilcox*, (1740) 26 Eng. Rep. 489; 2 Atk. 141. There, a defendant had copied significant portions of a law book and the Lord Chancellor hearing the case in equity refused to send the "factual" issues to a jury. Despite this case having arisen in equity, Professor Hughes cited this as evidence against the argument that fair use was a legal issue to be tried by a jury in law courts. Hughes explained that the case "shows only one of England's most learned jurists opining that with a copyright infringement case, even in the face of a fair abridgment defense and a request from defendant's counsel, '[t]he court [wa]s not under an indispensable obligation to send all facts to a jury.'" Hughes, *supra* note 5, at 11 (quoting *Gyles*, 2 Atk. 141 at 490–91). Respectfully, I disagree that this statement in *Gyles*, which arose in an equitable proceeding, is relevant to the historical test for the Seventh Amendment. The Lord Chancellor's opinion that a judge sitting in equity should decide an issue (rather than send it to a jury) does not suggest that a judge sitting in a court of law should do likewise. Indeed, if anything, the Lord Chancellor's characterization of the issue as factual in nature suggests the opposite conclusion—that if the issue had arisen in a law court, the jury would have needed to decide it.

Third, Oracle has raised doubt over whether the jury actually decided the infringement issue of fair abridgment in the case of *Roworth v. Wilkes*, (1807) 170 Eng. Rep. 889; 1 Camp. 94. Supplemental Brief of Respondent, at 9, *Google LLC v. Oracle Am., Inc.*, No 18-956 (Aug. 7, 2020). As I explained in my earlier article, the case itself does not speak to the issue. Snow, *supra* note 2, at 296 n.157. Instead, the English case of *Campbell v. Scott*, (1842) 59 Eng. Rep. 784, 787; 11 Sim. 31, 40., provides the answer:

Roworth v. Wilkes was a case in which 75 pages of a treatise consisting of 118 pages were taken and inserted in a very voluminous work . . . and, although the matter taken formed but a very small proportion of the work into which it was introduced, the jury found for the Plaintiff, who was the author of the treatise. *Campbell* thus states that in *Roworth*, "the jury found for the Plaintiff," or in other words, the jury decided the infringement issue.