

No. 11-697

IN THE
Supreme Court of the United States

SUPAP KIRTSANG, DBA BLUECHRISTINE99,
Petitioner,

v.

JOHN WILEY & SONS, INC.,
Respondent.

**On Writ of Certiorari to the
United States Court of Appeals
for the Second Circuit**

**BRIEF OF THE ASSOCIATION OF ART
MUSEUM DIRECTORS, THE ART INSTITUTE
OF CHICAGO, THE J. PAUL GETTY TRUST,
MUSEUM ASSOCIATES DBA LOS ANGELES
COUNTY MUSEUM OF ART, THE MUSEUM OF
MODERN ART, THE SAN FRANCISCO
MUSEUM OF MODERN ART, THE SOLOMON
R. GUGGENHEIM FOUNDATION,
THE WHITNEY MUSEUM OF AMERICAN ART,
*ET AL. AS AMICI CURIAE IN
SUPPORT OF PETITIONER***

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The Association of Art Museum Directors, the Art Institute of Chicago, the J. Paul Getty Trust, Museum Associates dba Los Angeles County Museum of Art, the Museum of Modern Art, the San Francisco Museum of Modern Art, the Solomon R. Guggenheim Foundation, the Whitney Museum of American Art, and twenty-two other United States museums of art submit this *amicus* brief in support of Petitioner.¹

INTEREST OF *AMICI CURIAE*

Amici are art museums and an organization of art museum directors.² The mission of art museums is to serve the public through art and art education by making available, to a wide audience, works that convey the full range of human artistic expression. The decision below threatens this mission. Art museums have long depended on Section 109 of the Copyright Act to develop and display their permanent collections and to assemble and present special exhibitions of art. In particular, Section 109(c) allows museums to publicly display artwork “lawfully made under this title” without having to obtain the copyright owner’s permission. Section 109(a) similarly allows museums to acquire “lawfully made” works of art for their permanent collections and to borrow and loan such works for display in special exhibitions. Displaying, acquiring, borrowing, and loaning art are at the core of what museums do. The Second Circuit, however, by ruling that “lawfully made under this

¹ No counsel for any party authored this brief in whole or in part, and no counsel for a party or any party made a monetary contribution intended to fund the preparation or submission of this brief. All parties have consented to filing this brief, and letters reflecting their consent have been filed with the Clerk.

² A description of *amici* is set forth in the attached Appendix.

title” means lawfully made in the United States, set a precedent that could end Section 109’s application to works of art of foreign origin. The copyrighted works potentially affected – modern, postwar, and contemporary artwork created outside of this country – are crucial to museum collections and exhibitions. Under the Second Circuit’s reasoning, merely hanging a foreign-made painting on the walls of a museum, buying and importing a sculpture that was created outside the country, or loaning either to another institution for exhibition to the public, could give rise to claims of copyright infringement. The decision below has the potential to disrupt the mission of American museums and interfere with the public’s access to art.

SUMMARY OF ARGUMENT

The decision below should be reversed for two reasons.

1. The decision below could have serious repercussions for American museums and their ability to exhibit art. Most U.S. art museums have permanent collections that were acquired through purchases, gifts, and bequests, and on which they draw for exhibitions to the public. Museums also present special exhibitions, largely made up of works not in their collections, through loans from private collectors, galleries, and other institutions. For all these activities museums depend on the protections afforded by Section 109. Section 109(c) provides that the owner of a particular copy “lawfully made under this title” is entitled to *display* that copy publicly without the copyright owner’s permission. Section 109(a) similarly allows museums to buy, borrow, loan, and sell such “lawfully made” artworks.

By confining Section 109(a)'s "lawfully made under this title" to copies manufactured in the United States, the Second Circuit set a precedent that, if extended, could limit Section 109(c) and cause museums to lose their ability to display foreign-made, copyrighted works of art to the public. Museums could also lose the ability under Section 109(a) to acquire, borrow, loan, and sell such artwork. The decision below potentially affects large swaths of modern, postwar, and contemporary art on display in American museums today.

As a result, the decision below could harm the viewing public and the museum community. Every museum that hangs a painting of foreign origin in its galleries potentially is a copyright infringer. The most basic of museum functions – exhibiting art – could give rise to infringement claims. Museums would have to fall back on untested defenses like fair use, but would lose the certainty that Section 109 has long provided. To avoid the risk of liability, museums could be forced to seek licenses from copyright owners. But clearing rights will be expensive and in many cases impossible. The cost of having to find copyright owners and negotiate individual licenses will be high, and museums likely will be unable to locate the copyright owner in every instance even after a diligent search. Copyright owners, who have no obligation to grant licenses, could demand sizeable royalty payments and non-monetary concessions like control over curatorial decisions. Where museums are unable to secure permissions, they would face an untenable choice: running the risk of copyright infringement liability or not making art available to the public or even acquiring art, whether by gift, bequest, or purchase. Reversal is warranted to avoid

these unintended consequences for the viewing public and the museum community.

2. The Second Circuit overlooked a fundamental point of law. Section 104 of the Copyright Act provides that all works eligible for protection under U.S. law are “subject to protection under this title.” The text of the statute must be given effect. A work that is “subject to protection under this title” is subject to the full range of rights *and* limitations that the statute affords – including Section 109’s limitations on copyright. The lower court erred by finding the statute ambiguous. It is not. A work that is eligible for Section 104 protection, and any copy of that work, is subject to Section 109’s limitations on the exclusive distribution and public display rights regardless of where they were made.

Amici’s reading has broad applicability. It would maintain effective Section 109 protections for museums with respect to foreign-made works of art and, more broadly, would ensure that the limitations of Section 109 apply to *every* work in which there is U.S. copyright protection without regard to where a copy of the work may have been manufactured.

At a minimum, the proper construction of Section 109 is one that treats works of U.S. and foreign origin the same. Absent clear statutory language to the contrary, a party that seeks to avail itself of the benefits of U.S. copyright law protections must also be subject to all the limitations of that law, regardless of where it made copies of the works at issue.

ARGUMENT**I. THE DECISION BELOW THREATENS THE ABILITY OF MUSEUMS TO EXHIBIT ART CREATED OUTSIDE THE UNITED STATES****A. Foreign-Made Art Plays an Essential Role in the Mission of this Nation's Museums**

The mission of museums in this country is to serve the public through art and art education. Museums do this in a number of ways. Most art museums have permanent collections, which they acquire through purchases, gifts, and bequests, and from which they draw for exhibitions and educational programs. Art museums also present special exhibitions, which can be drawn from a museum's permanent collection, works owned by others, or a combination of both. Museums regularly borrow works of art from other institutions, private collectors, and galleries, and they rely on one another for loans of art.³ All these activities allow art museums to reach a large audience. In 2008, an estimated 51.1 million visitors, or 23% of American adults, attended an art museum or gallery in the United States.⁴

³ Occasionally, a museum will deaccession a work – *i.e.*, permanently remove it from the museum's collection – and dispose of it by transferring ownership. AAMD and its members have developed policies and procedures to govern the deaccessioning of works. See Association of Art Museum Directors, *AAMD Policy on Deaccessioning* (June 9, 2010), available at http://aamd.org/papers/documents/FinalDeaccessioning_Report_6_25_10.pdf.

⁴ Nat'l Endowment for the Arts, *2008 Survey of Public Participation in the Arts*, 25-26 (Nov. 2009), available at <http://www.nea.gov/research/2008-SPPA.pdf> (measuring the

American museums believe that art conveys the rich complexity of human experience, and they are committed to selecting and presenting works of art across a broad range of time periods, geographies, and artistic perspectives. Showing modern, postwar, and contemporary art is essential to this.⁵ Such works are a significant part of museum collections and exhibitions in this country. Many modern, postwar, and contemporary works originate from outside the United States. *Amici* hold works created by Constantin Brancusi, Alexander Calder, Marc Chagall, Salvador Dalí, Lucian Freud, Alberto Giacometti, Frida Kahlo, Anselm Kiefer, Yves Klein, Yayoi Kusama, René Magritte, Henri Matisse, Joan Miró, Piet Mondrian, Pablo Picasso, Gerhard Richter, Diego Rivera, Rachel Whiteread, and other influential artists of the twentieth and twenty-first centuries. Foreign-made art is not exclusively made by foreigners. American artists working abroad have created many influential works. Cy Twombly, for example, settled in Italy in 1957 where he worked for decades and became one of the most important painters of the postwar era.⁶

Many works created outside the United States are iconic and have shaped the history of art as we know it. Picasso's *Les Femmes d'Alger (O. J. R. M.)*, with its then-scandalous subject matter and radical break from traditional composition and perspective, broke norms

number of Americans over the age of eighteen who visit museums).

⁵ *Amici* emphasize these works because older works are likely to have fallen into the public domain and no longer are protected by copyright.

⁶ See Randy Kennedy, *American Artist Who Scribbled a Unique Path*, N.Y. TIMES, July 5, 2011.

of artistic expression and was crucial to the genesis of modern art.⁷ Brancusi's *Bird in Space*, a series of sixteen marble and bronze sculptures, is a work of inspired abstraction that strips away a bird's individualizing features to realize the artist's intent of capturing "the essence of flight."⁸ Brancusi's work was instrumental in expanding what courts at the time accepted as "art."⁹ Richter's *Woman Descending the Staircase*, which the artist created by projecting a photograph on a canvas and rendering the image with paint, addresses the way photography and painting create impressions of beauty, elegance, and

⁷ See *Les Demoiselles d'Avignon*, MUSEUM OF MODERN ART, http://www.moma.org/collection/object.php?object_id=79766 (last visited July 3, 2012).

⁸ See *Bird in Space*, METROPOLITAN MUSEUM OF ART, <http://www.metmuseum.org/Collections/search-the-collections/210006973> (last visited July 3, 2012); *Bird in Space*, LOS ANGELES COUNTY MUSEUM OF ART, <http://collectionsonline.lacma.org/mwebcgi/mweb.exe?request=record;id=159125;type=101> (last visited July 3, 2012); *Bird in Space*, GUGGENHEIM MUSEUM, <http://www.guggenheim.org/new-york/collections/collection-online/show-full/piece/?object=76.2553.51&search=&page=&f=Title> (last visited July 3, 2012); *Bird in Space*, MUSEUM OF MODERN ART, http://www.moma.org/collection/object.php?object_id=81033 (last visited July 3, 2012).

⁹ When a number of Brancusi's works, including *Bird in Space*, were shipped to the United States in 1926 for display at an exhibition in New York, customs officials refused to allow the works to enter duty-free because they considered the works "manufactures of metal" subject to an importation tax, rather than art. On appeal, the Customs Court ruled that the pieces were works of art despite the fact that they did not strictly imitate natural objects. *Brancusi v. United States*, 54 Treas. Dec. 428 (Cust. Ct. 1928).

glamour.¹⁰ For years, these and many other works of foreign origin have engaged viewers and challenged their perceptions of aesthetics, society, and what it means to be art.

American museums curate and present exhibitions of countless foreign-made works of art every day. In addition to showing such works through their permanent collections, *amici* recently have exhibited or will exhibit:

- *Art of Another Kind: International Abstraction and the Guggenheim, 1949–1960*, which features works drawn from the museum’s collection and explores the affinities and differences between artists working continents apart in a period of great transition and rapid creative development.¹¹
- *The Last Harvest: Paintings of Rabindranath Tagore*, which followed one of the most important cultural icons in India and Bangladesh who helped shape the modern Indian identity.¹²
- The works of Yayoi Kusama, who is among Japan’s most prominent contemporary artists and whose art spans a variety of media

¹⁰ See *Woman Descending the Staircase*, ART INSTITUTE OF CHICAGO, <http://www.artic.edu/aic/collections/artwork/147003> (last visited July 3, 2012).

¹¹ *Art of Another Kind: International Abstraction and the Guggenheim, 1949-1960*, GUGGENHEIM MUSEUM, <http://www.guggenheim.org/new-york/exhibitions/on-view/art-of-another-kind> (last visited July 3, 2012).

¹² *The Last Harvest: Paintings of Rabindranath Tagore*, ART INSTITUTE OF CHICAGO, <http://www.artic.edu/aic/collections/exhibitions/Tagore/index> (last visited July 3, 2012).

including painting, drawing, sculpture, film, performance, and immersive installation; the photographs of Daido Moriyama, whose gritty depictions of Japanese urban life incorporate high contrast, graininess, and tilted vantages to convey the fragmentary nature of modern realities; and *Tokyo 1955-1970*, which follows Tokyo's transformation from the capital of a war-torn nation into an international center for arts, culture, and commerce, eventually becoming home to some of the most important art being made at the time.¹³

- *The Steins Collect: Matisse, Picasso, and the Parisian Avant-Garde*, which explored the collections of Gertrude, Leo, Michael, and Sarah Stein, American expatriates living in Paris whose art collections and social networks were instrumental in shaping Modernism.¹⁴

Foreign-made modern, postwar, and contemporary works of art are an essential part of American museum collections and exhibitions. They are crucial to the mission of museums to make a wide range of

¹³ *Yayoi Kusama*, WHITNEY MUSEUM OF AMERICAN ART, <http://whitney.org/Exhibitions/YayoiKusama> (last visited July 3, 2012); *Fracture: Daido Moriyama*, LOS ANGELES COUNTY MUSEUM OF ART, <http://www.lacma.org/art/exhibition/fracture-daido-moriyama> (last visited July 3, 2012); *Tokyo 1955-1970*, MUSEUM OF MODERN ART, <http://www.moma.org/visit/calendar/exhibitions/1242> (last visited July 3, 2012).

¹⁴ Press Release, *The Steins Collect*, SAN FRANCISCO MUSEUM OF MODERN ART, http://www.sfmoma.org/about/press/press_exhibitions/releases/862 (last visited July 3, 2012). The exhibition originated at SFMOMA and then traveled to Paris and the Metropolitan Museum of Art in New York.

art available to the public. If the decision below stands, museums in the United States that display these works are at risk.

**B The Decision Below Threatens the
Section 109 Limitations on which
Museums Depend**

The decision below impacts more than foreign-made editions of textbooks. It establishes a precedent that could eliminate the express limitations in Section 109 with respect to all foreign-made copyrighted works, including large swaths of modern, postwar, and contemporary art on display in this nation's museums.

As a general matter, museums do not own the copyrights to the works and objects in their collections. That is because ownership of a copyright is distinct from ownership of any material object in which the work is embodied. 17 U.S.C. § 202. The artists who created those works, the artists' heirs, or foundations typically control those rights. Moreover, many works of art are embodied in only one object – a singular painting, drawing, or sculpture. For purposes of the copyright law, the “original” of a work of art is deemed a “copy.” See 17 U.S.C. § 101 (“Copies’ are material objects . . . in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. *The term ‘copies’ includes the material object . . . in which the work is first fixed.*”) (emphasis added).

Museums then depend on Section 109 in two respects. Section 109(c), which the decision below does not discuss, provides that “the owner of a particular copy lawfully made under this title . . . is entitled, without the authority of the copyright owner, to *display that copy publicly*, either directly or by the projection of no more than one image at a time, to viewers present at the place where the copy is located.” 17 U.S.C. § 109(c) (emphasis added). Section 109(c) thus expressly limits a copyright owner’s right to control a museum’s public display of artwork in its possession. See 17 U.S.C. § 106(5) (“the owner of copyright under this title has the exclusive rights . . . in the case of . . . pictorial, graphic, or sculptural works, . . . to display the copyrighted work publicly”). Section 109(c) “adopts the general principle that the lawful owner of a copy of a work should be able to put his copy on public display without the consent of the copyright owner.” H.R. Rep. No. 94-1476, at 79 (1976).¹⁵ As a result, a museum ordinarily does not need permission to show the public a copyrighted painting, drawing, sculpture, or any other object in its collection or in a special exhibition.

Museums also rely on Section 109(a). This provision allows museums to make uses that otherwise would implicate copyright owners’ exclusive rights of distribution. Museums acquire works of art for their

¹⁵ “As a general principle, we believe that anyone who owns a copy of a work should be free to put that copy on public display without first obtaining authorization from the owner of copyright in that work. Thus, for example: the owner of a painting should be able to hang it in a public gallery” STAFF OF H. COMM. ON THE JUDICIARY, 89TH CONG., COPYRIGHT LAW REVISION PART 6 – SUPPLEMENTARY REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW: 1965 REVISION BILL 30 (Comm. Print 1965).

permanent collections through purchases, either with their own funds or funds given by others, or through donations or bequests. Museums also regularly borrow and loan works that are incorporated into special exhibitions. Many loaned works of art travel internationally. All these uses implicate copyright owners' distribution rights because of the Copyright Act's Section 106(3), which provides that "the owner of copyright under this title has the exclusive rights . . . to distribute copies . . . of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending." Section 109(a) then expressly limits the distribution right: museums need not obtain copyright permissions to buy, borrow, loan, or sell works of art because of the protections that Section 109(a) affords.¹⁶

Together, Section 109(a) and Section 109(c) enable essential museum functions – the development and public display of permanent collections and special exhibitions of art. The decision below however confines Section 109(a)'s "lawfully made under this title" to works made in the United States. By doing so, it sets a precedent for similarly limiting Section 109(c). If "lawfully made under this title" means only copies lawfully made in the United States, museums could lose their ability under Section 109(c) to display foreign-made copyrighted works of art to the public,

¹⁶ Museums would argue that a museum that borrows a work of art from another institution, collector, or gallery, or that lends a work to another museum, is not engaged in a distribution of "copies . . . to the public." *See* 17 U.S.C. § 106(3). Regardless of whether such uses are distributions for purposes of Section 106(3), Section 109(a) permits them without the copyright owner's permission.

and under Section 109(a) to acquire, borrow, loan, and sell foreign-made works.

C. The Decision Below Puts at Risk Museums' Ability to Exhibit Foreign-Made Works of Art to the Public

The lower court's construction of Section 109 could have serious unintended consequences: if the decision below is upheld, every museum that exhibits a foreign-made painting, drawing, or sculpture under copyright is a potential infringer. To be clear, museums would not concede liability if infringement claims were brought.¹⁷ But the decision below could open museums across the country to copyright infringement lawsuits and claims for damages, attorneys' fees, and injunctions – costs that would have a chilling effect on how museums, already operating under tight budgets, manage their collections and exhibitions.

Without the protection of Section 109's limitations on the exclusive rights of public display and distribution, museums will be forced to decide whether to seek permission to exhibit, acquire, borrow, lend, and sell foreign-made artwork in order to avoid claims that they are infringing the copyright owners' exclusive rights. Having to clear rights for these basic museum functions will be extremely time-consuming, costly, and burdensome. As a practical matter it will be difficult, and in many cases impossible, to secure the rights. Leaving aside the question of how much a license would cost, museums would be forced to spend a great deal of time and energy locating copyright

¹⁷ Museums would assert all meritorious defenses – for example, that their display of art is fair use. *See, e.g.*, 17 U.S.C. § 107.

owners and negotiating rights, diverting scarce resources from other important museum functions and potentially delaying acquisitions, loans, and exhibitions. In many instances, it may be impossible for museums to locate copyright owners. Many artworks and objects are “orphan” works whose copyright owners cannot be found even after a reasonably diligent search, as they lack clear facts about their authorship, country of origin, date of creation, publication, and copyright duration.¹⁸ If the copyright owner’s identity or a work’s ownership status cannot be ascertained, museums will be left in legal limbo.

Even where the copyright owner of a work of art can be found, there is no guarantee the museum would be able to secure a license. A copyright owner could decide not to grant a license for any reason – for example, because he or she objected to the venue or curatorial aspects of the exhibition – or for no reason at all. Alternatively, the copyright owner could demand a sizeable royalty payment to allow the use to occur. What is the price a museum would have to pay for a copyright license to publicly display a work of art? To borrow, purchase, or receive a donated work? There is no precedent. The price is entirely at the discretion of the copyright owner: it will be as low or as high as he or she is willing to

¹⁸ See J. Paul Getty Trust, *et al.*, *Initial Comments to Orphan Works Notice of Inquiry* (Mar. 24, 2005), available at <http://www.copyright.gov/orphan/comments/OW0610-ArtMuseums.pdf>; Los Angeles County Museum of Art, *Initial Comments to Orphan Works Notice of Inquiry* (Mar. 25, 2005), available at <http://www.copyright.gov/orphan/comments/OW0644-LACMA.pdf>; Whitney Museum of American Art, *Initial Comments to Orphan Works Notice of Inquiry* (May 6, 2005), available at <http://www.copyright.gov/orphan/comments/reply/OWR0090-WhitneyMuseum.pdf>.

accept. With such bargaining power, the copyright owner could demand non-monetary compensation, like control over how the work is displayed, the content of the exhibition, or to whom the work is sold.

As such, the Second Circuit's decision places museums' curatorial freedom at risk. Regardless of the amount of a fee or the conditions attached to a license, this much is clear: today, American museums pay no copyright fees to exhibit, purchase, borrow, lend, or sell art, and they exercise broad freedom to make curatorial decisions. If the decision below is allowed to stand, museums conceivably could be forced to divert significant portions of their budgets – now spent on paying staff, running educational programs, and acquiring art – to clearing rights that never before existed. Museums may be forced to change what art they exhibit and how, to comply with copyright demands.

Ultimately, the cost of clearing rights in foreign-made works may be beyond what museums can afford. This places museums in an untenable position. They could, on the one hand, proceed with unlicensed uses of their collections. That opens them up to copyright infringement lawsuits and potentially devastating awards of damages and attorneys' fees. Or museums could avoid exhibiting or acquiring foreign-made works entirely, focusing their efforts instead on those works in which they have rights. Either way, the public loses. Spurring a cottage industry of litigation against this nation's museums hardly serves the public. The alternative – withholding art from public view – likewise serves no benefit.

The lower court’s construction of “lawfully made under this title” has the potential to disrupt core museum functions, undermine the mission of this nation’s museums to make art of all kinds widely available, and deprive the American public of access to foreign-made modern, postwar, and contemporary art. Reversal is warranted to avoid these consequences.

II. ALL WORKS PROTECTED BY U.S. COPYRIGHT, AND THEIR COPIES, ARE SUBJECT TO SECTION 109’S LIMITATIONS ON RIGHTS

A. Section 104 Expressly Makes Works “Subject to Protection under this Title” Regardless of Where their Copies Were Manufactured

Section 104 sets forth the criteria under which a work of authorship is protected under the copyright law of the United States.¹⁹ All works that satisfy the

¹⁹ Section 104 provides, in relevant part:

(a) *Unpublished Works*. – The works specified by sections 102 and 103, while unpublished, ***are subject to protection under this title*** without regard to the nationality or domicile of the author.

(b) *Published Works*. – The works specified by sections 102 and 103, when published, ***are subject to protection under this title*** if—

(1) on the date of first publication, one or more of the authors is a national or domiciliary of the United States, or is a national, domiciliary, or sovereign authority of a treaty party, or is a stateless person, wherever that person may be domiciled; or

(2) the work is first published in the United States or in a foreign nation that, on the date of first publication, is a treaty party

criteria of Section 104 are “subject to protection under this title.” 17 U.S.C. § 104. The words of the statute must be given effect and are crucial here. A work that is “subject to protection under this title” is subject to all the contours of copyright protection – all the rights that attach to it under Section 106 of the Copyright Act, all the remedies available to the copyright owner for infringement of that work under Sections 501 through 513, and all the limitations on those rights and remedies under Sections 107 through 122. Section 104 makes the full range of U.S. copyright protections and limitations applicable to *all* eligible works, and it makes no distinction based on where a work or a copy of it was manufactured. All works eligible for protection under U.S. law, and all copies of those works, are subject to the limitations on the distribution and public display rights set forth in Section 109, regardless of where they were made.

The Second Circuit erred by not embracing this statutory reading. The court acknowledged that the wording of Section 104(b)(2) made it “possible to interpret § 109(a)’s ‘lawfully made under this title’ language to mean, in effect, ‘any work that is subject to protection under this title.’” *John Wiley & Sons, Inc. v. Kirtsaeng*, 654 F.3d 210, 219-20 (2d Cir. 2011). The court further recognized that Petitioner here

17 U.S.C. § 104 (emphasis added). Subsections (3), (4), (5), and (6), which are not repeated here for the sake of brevity, make subject to U.S. copyright protection, respectively, sound recordings first fixed in a treaty party, works incorporated into buildings and structures located in the United States and treaty parties, works first published by the United Nations or the Organization of American States, and works within the scope of a Presidential proclamation. 17 U.S.C. § 104(b)(3), (4), (5), (6).

would prevail if it adopted this definition of Section 109(a). *Id.* at 220 n.38. But rather than apply Section 104 as determinative of the issue, the court instead treated Section 104 as only one aspect of the statute that could be used to interpret the meaning of Section 109(a)'s "lawfully made under this title." Finding that alternative readings were possible, the court concluded that the text of Section 109(a) was "utterly ambiguous." *Id.* at 220. Confronted with what it viewed as ambiguous text, the court then relied on two arguments, not grounded in the text of the Copyright Act, to find for Respondent: it found that Section 602(a)(1) would have no force in the vast majority of cases if Petitioner's argument were adopted, and it relied on dicta found in *Quality King*. *Id.* at 221.

The court erred in its first step when it found Section 109 ambiguous. The statute is not ambiguous. Section 104 establishes that all eligible works – and by extension, all copies thereof – are subject to all the protections, remedies, and limitations of the U.S. copyright law, including Section 109. The Second Circuit should have ended its analysis there. *See Conn. Nat'l Bank v. Germain*, 503 U.S. 249, 254 (1992) ("When the words of a statute are unambiguous, then, this first canon is also the last: 'judicial inquiry is complete.'") (quoting *Rubin v. United States*, 449 U.S. 424, 430 (1981)). Simply put, if a work is eligible for protection under U.S. law, and the copyright owner seeks to enforce its rights under U.S. law, the works at issue – and all copies thereof – are

subject to the same limitations imposed by the law regardless of where they were manufactured.²⁰

B. *Amici's* Reading Preserves Museums' Ability to Rely on Section 109 and Comports with *Quality King*

Amici's reading of Section 104 has broad applicability. It is coterminous with U.S. copyright law protection: every work that is protected under the Copyright Act is also subject to the *limitations* of Section 109. To use artwork as an example, if a painting is “unpublished,” it is “subject to protection under this title” including the limitations of Section 109. *See* 17 U.S.C. § 104(a). If the painter who created the work was a national or domiciliary of the United States or of a “treaty party,” the painting is subject to protection under this title and Section 109. *See* 17 U.S.C. § 104(b)(1). (A treaty party includes any country that is a party to the Berne Convention, the Universal Copyright Convention, the WTO Agreement, the WIPO Copyright Treaty, and any other copyright treaty to which the United States is party²¹ – virtually every country on Earth.) If the painting was first published in the United States or in a foreign nation that is a treaty party, once again, it is subject to protection under the Copyright Act and the limitations of Section 109. *See* 17 U.S.C. § 104(b)(2). Indeed, a work that falls outside of Section 104 has

²⁰ Under this reading, Respondent's foreign editions are subject to the limitations of Section 109. Each of Respondent's eight copyrighted works at issue were first published in the U.S. Special Joint Appendix 1, 3, 5, 8, 10, 12, 14, 16. By operation of Section 104(b)(2), the works “are subject to protection under this title.”

²¹ 17 U.S.C. § 101 (definitions of “treaty party” and “international agreement”).

no U.S. rights for its owner to enforce, making moot the question whether Section 109 would apply in such a circumstance.

Amici's reading of the statute also accords with *Quality King*. There, the Court ruled that the importation right granted in Section 602(a) is limited by Section 109 (and indeed Sections 107 through 120). *Quality King Distribs., Inc. v. Lanza Research Int'l, Inc.*, 523 U.S. 135, 150 (1998). While the concurrence opined that the Court was not resolving cases in which the allegedly infringing imports were manufactured abroad, *Quality King*, 523 U.S. at 154, the majority opinion certainly left open the possibility that all copies of works protected under U.S. law are subject to Section 109's limitations regardless of where they were made. There is no reason to carve out a judicial exception from the rule that every work protected under the Copyright Act is subject to all the limitations on copyright contained in the statute.

C. Section 109 Must Be Construed to Give Effect to Section 104's Equal Treatment of Foreign and Domestic Works

Further highlighting the problems with the ruling below is that the Second Circuit failed to give effect to Section 104's mandate to treat foreign and domestic works equally. At a minimum, the text of Section 104 establishes the proper analytic framework for interpreting Section 109's "lawfully made under this title." Courts have recognized that the wording of Section 104 supports a construction that applies Section 109 to foreign-made copies. See *John Wiley & Sons*, 654 F.3d at 219-20 & n.38; *Pearson Educ., Inc. v. Liu*, 656 F. Supp. 2d 407, 412 (S.D.N.Y. 2009). More than that, Section 104 sets the principle that all

copyright owners whose works are eligible for protection under U.S. law should receive the same copyright protections and limitations, and that eligible foreign works should receive no more or less favorable treatment unless there is clear language in the statute to the contrary.

Congress uses explicit language in the few instances where it has decided to treat foreign works differently than domestic works. When Congress implemented the WIPO Copyright and Performances and Phonograms Treaties, it exempted foreign works from the requirement that they be registered as a prerequisite for filing an infringement action. Congress amended Section 411(a) to provide that “no civil action for infringement of the copyright in any *United States work* shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.” 17 U.S.C. § 411(a) (emphasis added).²² Section 109(a) does not so clearly give preferential treatment for foreign-made copies, even though Congress could have chosen the words “lawfully made in the United States” instead of “lawfully made under this title.” Indeed when it enacted the 1976 Act, Congress

²² The Copyright Act as enacted in 1976 provided that “no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title.” 17 U.S.C. § 411(a) (1976). The Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853, 2859, amended this provision of the 1976 Act, which, in turn, was amended by the WIPO Copyright and Performances and Phonograms Treaties Implementation Act of 1998, Pub. L. No. 105-304, 112 Stat. 2860, 2863.

confirmed the principle of general applicability embodied in the text of the Section 109.²³

Absent a clear Congressional statement to the contrary, the words of Section 109(a) should be construed to give foreign- and U.S.-made copies the equal treatment that Section 104 contemplates. *See Pearson*, 656 F. Supp. 2d at 413 (“[w]hen Congress considered the place of manufacture to be important, . . . the statutory language clearly expresses that concern”) (quoting *Sebastian Int’l, Inc. v. Consumer Contacts (Pty) Ltd.*, 847 F.2d 1093, 1098 n.1 (3d Cir. 1988)). “Lawfully made under this title” must refer to the lawfulness of a copy’s manufacture as a func-

²³ “Section 109(a) *restates and confirms the principle that*, where the copyright owner has transferred ownership of a particular copy or phonorecord of a work, the person to whom the copy or phonorecord is transferred is entitled to dispose of it by sale, rental, or other means.” H.R. Rep. No. 94-1476, at 79 (emphasis added). “Section 109(b) [subsequently renumbered 109(c)] *adopts the general principle* that the lawful owner of a copy of a work should be able to put his copy on public display without the consent of the copyright owner.” *Id.* (emphasis added). Moreover, there is no indication that Congress intended to exempt foreign-made copies from Section 109. Congress has often considered and has thus far failed to enact a resale royalty right – that is, the right of a copyright owner to receive royalties from the resale of a work of art. *See* Visual Artists’ Residual Rights Act of 1978, H.R. 11403, 95th Cong. (1978); Visual Artists Rights Amendment of 1986, H.R. 5722, 99th Cong. (1986); Visual Artists Rights Amendment of 1986, S. 2796, 99th Cong. (1986); Visual Artists Rights Act of 1987, H.R. 3221, 100th Cong. (1987). Such a right arguably could arise if foreign-made artwork were exempted from Section 109. The legislature’s consideration of such legislation, and the absence in the debates with respect thereto of any assertion that such a right already exists in the Copyright Act (if only for non-United States works), suggests that the Congress understood that no such right exists.

tion of United States copyright law, not to the place the copy was manufactured. *Id.* at 412.

CONCLUSION

The Court should reverse the decision below and find that a copy that was made and acquired abroad and then imported into the United States can always be distributed and publicly displayed within the United States without permission so long as the copyright owner authorized the first distribution abroad.

Respectfully submitted,

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APPENDIX

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The Association of Art Museum Directors – The Association of Art Museum Directors (“AAMD”) is a non-profit professional association organized under the laws of Washington, D.C. The AAMD’s general nature and purpose is to support its members, consisting of more than 200 directors of art museums located throughout the United States, Canada, and Mexico, in the contribution of art museums to society.

The Art Institute of Chicago – Founded in 1879, the Art Institute of Chicago is one of the largest encyclopedic art museums in the country. Its mission is to collect, preserve, and interpret works of art from the world’s diverse artistic traditions for the inspiration and education of the public and for the advancement of research in visual culture.

The J. Paul Getty Trust – Based in the Los Angeles area, the J. Paul Getty Trust operates the J. Paul Getty Museum, which seeks to further knowledge of the visual arts and to nurture critical seeing by collecting, preserving, exhibiting, and interpreting works of art of the highest quality. The Museum strives to provide its visitors with access to the most innovative research in the visual arts while they enjoy a unique experience in viewing works of art at its two sites: the J. Paul Getty Museum at the Getty Center, which houses European paintings, drawings, sculpture, illuminated manuscripts, decorative arts, and European and American photographs, and the J. Paul Getty Museum at the Getty Villa, a museum and educational center dedicated to the study of the arts and cultures of ancient Greece, Rome, and Etruria.

Museum Associates dba Los Angeles County Museum of Art – The mission of the Los Angeles County Museum of Art, founded in 1965, is to serve the public through the collection, conservation, exhibition, and interpretation of significant works of art from a broad range of cultures and historical periods, and through the translation of these collections into meaningful educational, aesthetic, intellectual, and cultural experiences for the widest array of audiences. Museum Associates is a nonprofit public benefit corporation organized under the laws of California, which operates the Los Angeles County Museum of Art.

The Museum of Modern Art – Founded in 1929 as an educational institution, the Museum of Modern Art in New York is dedicated to being the foremost museum of modern art in the world and manifests this commitment by establishing, preserving, and documenting a permanent collection of the highest order that reflects the vitality, complexity, and unfolding patterns of modern and contemporary art; by presenting exhibitions and educational programs of unparalleled significance; by sustaining a library, archives, and conservation laboratory that are recognized as international centers of research; and by supporting scholarship and publications of preeminent intellectual merit.

The San Francisco Museum of Modern Art – Founded in 1935, SFMOMA was the first museum on the West Coast devoted to modern and contemporary art, and from the outset has championed some of the most innovative and challenging art of its time. Its mission is to assemble unparalleled collections, create exhilarating exhibitions, and develop engaging

public programs, guided by its commitment to foster creativity and embrace new ways of seeing the world.

The Solomon R. Guggenheim Foundation – The Solomon R. Guggenheim Foundation, founded in 1937, is a non-profit education corporation chartered by the New York State Board of Regents, which operates the Solomon R. Guggenheim Museum in New York City, and maintains an international network of museums comprised of the Peggy Guggenheim Collection in Venice, Italy, the Guggenheim Museum Bilbao in Bilbao, Spain, and the Deutsche Guggenheim in Berlin, Germany. Founded on a collection of early modern masterpieces, the Guggenheim Museum in New York is an ever-growing institution devoted to the art of the 20th century and beyond.

The Whitney Museum of American Art – Founded in New York City in 1930, the Whitney collects, exhibits, preserves, researches, and interprets art of the United States in the broadest global, historical, and interdisciplinary contexts, with a special focus on living artists. The Whitney's signature exhibition, the Biennial, is a leading survey of the most recent developments in American art.

Additional United States museums – The following twenty-two United States museums also have an interest in this appeal and join this brief as *amici*: the Asian Art Museum, Chong-Moon Lee Center for Asian Art and Culture; the Cedar Rapids Museum of Art; the Cleveland Museum of Art; the Columbus Museum; the Currier Museum of Art; the Dallas Museum of Art; the Farnsworth Art Museum; the Flint Institute of Arts; the Georgia Museum of Art; the Hunter Museum of American Art; the Indiana University Art Museum; the Michael C. Carlos

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Museum; the Milwaukee Art Museum; the Mint Museum; the Museum of Latin American Art; the Nasher Museum of Art at Duke University; the Palmer Museum of Art; the Philbrook Museum of Art; the Portland Art Museum; the Timken Museum of Art; the Toledo Museum of Art; and the Walker Art Center.