Copyright vs. Public Records: A Primer

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"I don't know the key to success, but the key to failure is trying to please everybody."

- Bill Cosby

Bill Cosby is known for taking a complex scenario and then humorously explaining it to an audience in simple terms. The above quote by the comedian reflects this: generally, he doesn't claim to know the intricacies on how to succeed, but simply claims that aiming to please everyone means certain failure. This paper, seemingly unrelated to the above quote, deals with the intersection of a complex set of laws from two areas, federal copyright law and state public records law. Many parties may be involved in a situation where these two bodies of law insect, including local governments, homeowners, architects, private corporations. In addition, the law in this area is indeed murky. Courts have so far refused to answer the issue of pre-emption at the heart of the matter: whether federal copyright law pre-empts state public records law during a public records request. Similar to the words of Bill Cosby, this paper doesn't claim the key to success; although, hopefully, local government attorneys will be better prepared avoid failure while pleasing the parties involved.

I. The Problem Scenario

As stated above, the intersection of copyright and public records law may result a conflict. Take the following simple example: an architect creates blueprints for the purpose of the building a house on a piece of property. As part of the building permit approval process, these blueprints are submitted to the local development board. The creator of the blueprints places a notice of copyright on the blueprints and submits them to the development board. After some time, an individual comes in to the development board and makes a request under a state public record law, such as the following:

> Except as otherwise specifically provided by this section or by laws specifically enacted to provide otherwise, all public records shall be open to inspection and copying by any citizen of the State of Arkansas during the regular business hours of the custodian of the records.[1]

The city is now stuck with an all too common dilemma – rights protected under federal Copyright law versus a citizen's right to inspect and copy public records. Assuming that the blueprints can be classified as "records", should the custodian of the public record:

1) allow inspection and provide copies of the record (with or without notifying the holder of the copyright),

2) allow inspection and not provide copies, but permitting the requesting party to make copies on their own;

3) allow inspection and completely prohibit copies to be made; or

4) prohibit inspection and copies.

Before providing guidance to the local attorney who is faced with the decision whether or not to release copyrighted public records, a preliminary (but rudimentary) discussion of copyright law is required.

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[1] Ark. Code Ann. §25-19-105 (2006).

II. Copyright Basics

A discussion of copyright law will address reproduction and distribution of documents -- federal copyright law does not generally concern *access and inspection* to documents.[2] The source of copyright law is based in the U.S. Constitution, which states "The Congress shall have the power . . . . [T]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."[3] This authority, in turn, resulted in to numerous federal statutes and treaty laws which draw out the specifics of how copyrighted material is to be treated in the United States.

Section 102 of the Copyright Act[4] grants Congress the power to provide copyright protection in original works of authorship including, but not limited to, pictorial works and architectural drawings.[5] It should be noted that neither registration[6] with the Copyright

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[2] *See, e.g.*, *Progressive Animal Welfare Soc. v. University of Washington*, 125 Wash.2d 243, 884 P.2d 592 (Wash. 1994), where the court stated "[C]opyright protection does not ensure confidentiality. Instead, it only protects against unauthorized copying, performance, or creation of derivative works. To put the matter concisely, copyright protection does not preclude inspection of copyrighted material."

[3] U.S. Const. art. I, § 8, cl. 8.

[4] 17 U.S.C. §§ 101, *et seq*.

[5] 17 U.S.C.A. § 102 states in part: Copyright protection subsists...in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:
(1) literary works
(2) musical works, including any accompanying words;
(3) dramatic works, including any accompanying music;
(4) pantomimes, and choreographic works;
(5) *pictorial*, graphic, and sculptural works;
(6) motion pictures and other audiovisual works;
(7) sound recordings; and
(8) *architectural* works. (emphasis added)

[6] Registration does have strong advantages such as:
1) providing a public record of the copyright,
2) any infringement suits require registration for works of U.S. origin,
3) if work is registered within 5 years of publication, prima facie evidence in court to the validity of the copyright is established,
4) if registration occurs within 3 months after publication, statutory damages and attorney's fees will be available to copyright owner

Office nor publication is required to secure a copyright; a copyright in a work automatically exists when the work is "fixed in" a copy or phonorecord for the first time. In short, this means a work must be in the form of some material object (or visually/audibly perceived through aid of a machine).[7]

A copyright gives the owner of a copyright the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work the public by sale or other transfer of ownership, or by rental, lease, or lending;

* * * *

(5) to display the work publicly, in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial[8], graphic, or sculptural works. . . .[9]

III. Who can Claim a Copyright?

It may first be necessary to ascertain the holder of a copyright. Generally, a copyright of a work becomes the property of the author of the work; however, in specific and limited statutory situations, such as "work for hire"[10], a nonauthor may claim a

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[7] United States Copyright Office, "Copyright Basics", pg 3.

[8] 17 U.S.C.A. § 101 (2003) "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans.

[9] 17 U.S.C.A § 106 (2007). (emphasis added).

[10] 17 U.S.C.A. § 101. A "work for hire" is:
1) a work prepared by an *employee* within the scope of his or her employment; or
2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work,

copyright. Refer to the problem scenario described previously. The young couple hired an architect to create blueprints in order to build their dream house. The blueprints were created, and further, the couple provided their unique ideas to be incorporated into the blueprints. The house is constructed to the exact specifications of the blueprints. A few years later, the couple notice that what they thought was their unique design has now been released by the architect to developers who have built numerous replicas of their dream house. The couple comes into their respective local government planning office demanding to make copies of the blueprints. Not only does this couple demand copies of the blueprints, but they state that since their home was the first home based on the blueprints and that since their own unique ideas are incorporated into the blueprints, they have rights to the prints. Who owns the copyright?

The Supreme Court of the United States in *Community for Creative Non-Violence v. Reid,*[11] stated that "[t]o determine whether a work is for hire, under the [Copyright] Act, a court should first ascertain, using principles of general common law of agency, whether the work was prepared by an employee or an independent contractor."[12] This requires a consideration of factors, such as: 1) control by the employer of the work (such as location of work environment, provision of equipment by employer); 2) control by employer over employee (such as employer's ability to have employee perform other tasks, hire assistance,

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as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, *if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire*. For the purpose of the foregoing sentence, a "supplementary work" is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an "instructional text" is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities. (emphasis provided).

[11] 490 U.S. 730, 109 S.Ct. 2166 (1989).

[12] *Id.* at 751, 2178.

create the employee's schedule); and 3) status and conduct of the employer (such as providing employee with certain benefits or withholding tax).[13] In our problem scenario, the relationship between the young couple and the architect will not be an employer-employee relationship, but rather, the architect will be hired as an independent contractor. Unless the parties "expressly agree in a written statement"[14] that the blueprints will be a product of a work for hire, the copyright will stay with the architect. Even if the work for hire exception does not apply, could the couple still claim a copyright because they own the house that was the first building built from the blueprints? Probably not, as the Copyright Act states:

> Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied. Transfer of ownership of any material object, including the copy or phonorecord in which the work is first fixed, does not of itself convey any rights in the copyrighted work embodied in the object; nor, in the absence of an agreement, does transfer of ownership of a copyright or of any exclusive rights under a copyright convey property rights in any material object.[15]

Although the young couple's house was the first physical manifestation of the blueprints, and the young couple own the house, there is no copyright transferred to the young couple from the architect. The Copyright Act expressly states that a mere material embodiment of a work does not transfer ownership of the copyright, even when the transfer is the very object where the work is first fixed. The inquiry does not end here, as the doctrine of "fair use" may come into play.

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[13] *Id.*, See also Circular 9, US Copyright Office, "Works Made for Hire Under the 1976 Copyright Act" 2004, available at www.copyright.gov/circs/circ09.pdf
[14] 17 U.S.C.A. § 101, *infra*
[15] 17 U.S.C.A. § 202 (2003).

IV. Fair Use

The rights afforded to an author who obtains a copyright are not unlimited. Sections 107 through 118 of the Copyright Act[16] detail limitations on exclusive rights. The doctrine of "fair use", developed from common law, but codified at 17 U.S.C.A. § 107, is the most applicable to the instant situation and states:

> [T]he fair use of a copyrighted work, including such use by reproduction in copies or 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 non-profit educational purposes;
> 2) the nature of the copyrighted work;
> 3) the amount and sustainability of the portion used in relation to the copyrighted work as a whole; and
> 4) the effect of the use upon the potential market for or value of the copyrighted work.

In short, a review under the fair use doctrine requires an inquiry as to the particular purpose for reproduction, and if the purpose can be labelled as "fair", the owner of the copyright will be limited in claiming infringement. It has been held that the scope of the fair use doctrine is wider when the fair use claimed relates to issues of public concern,[17] and, as discussed in detail below, many courts have used the doctrine to avoid dealing with the potential conflict between public records and copyright.

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[16] 17 U.S.C.A. § 101, *et seq.* Limitations on exclusive rights include: fair use, reproduction by libraries, exemption of certain performances/displays, secondary transmissions, and ephemeral recordings.

[17] *Nat'l Rifle Ass'n v. Handgun Control Federation*, 15 F.3d 559 (6th Cir.1994).

V. Public/Open Records Laws

1. Is the Copyrighted Material a Record? (Part I)

a. Freedom of Information Act (FOIA)

For consistency's sake and due to the dearth of state caselaw in this area, the inspection and copying provisions of the U.S. Freedom of Information Act[18] ("FOIA") will be examined in parallel to dealing with particular state provisions. Be sure to consult all sources of law as most states and many local jurisdictions will have their own public records laws. As the United States Supreme Court states, "[t]he basic purpose of the [FOIA] is to ensure an informed citizenry, vital to the functioning of a democratic society, needed to check against corruption and to hold the governors accountable to the governed."[19] The FOIA grants public access to records by providing that "each agency, upon any request for records which (i) reasonably describes such records and (ii) is made in accordance with published rules stating the time, place, fees (if any), and procedures to be followed, shall make the records promptly available to any person."[20] Unlike many state public records laws, the FOIA does not expressly state that the government must provide copies; however, language in the FOIA is deemed to require more than simple inspection:[21]

> In order to carry out the provisions of this section, each agency shall promulgate regulations, pursuant to notice and receipt of public comment, specifying the schedule of fees applicable to the processing of requests . . .
>
> I) fees *shall* be limited to reasonable standard charges for document search, *duplication*, and review, when records are requested for commercial use;

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[18] The Freedom of Information Act, 5 U.S.C. §552 (2002).
[19] *NLRB v. Robbins Tire & Rubber Co.*, 437 U.S. 214, 242, 98 S.Ct. 2311, 57 L.Ed.2d 159 (1978). (citations omitted).
[20] 5 U.S.C. § 552 (a)(3).
[21] See *Perry v. Block*, 684 F.2d 121, 124 n. 14 (D.C. Cir. 1982) where the court states "[i]t is beyond peradventure, however, that a mere opportunity to inspect does not meet the disclosure responsibility imposed by the FOIA."

II) fees shall be limited to reasonable standard charges for *document duplication* when records are not sought for commercial use...
III) for any request not described in (I) and (II), fees shall be limited to reasonable standard charges for document search and *duplication*.[22]

b. Caselaw

At the federal level, the case that is the closest to directly dealing with the problem scenario is *Weisberg v. Dept. of Justice*.[23] Henry Weisberg submitted a FOIA request to obtain pictures taken at the scene of Dr. Martin Luther King's assassination. The pictures, in the possession of the FBI, had been copyrighted by TIME, Inc., the employer of the photographer who took the pictures. The FBI notified TIME of the request, and although TIME had no objection to any access to the documents, it asserted that a violation of its copyright would occur if the pictures were duplicated. When the FBI notified Weisberg that the photos had to be obtained from TIME directly, Weisberg brought a FOIA claim to obtain copies directly from the FBI.

As a threshold issue, the court addressed whether the photographs could be categorized as "agency records" -- with the FBI claiming that a copyright would preclude inclusion as an agency record, and therefore, taking the photos out of the scope of the FOIA. Relying on *Forsham v. Harris*, 445 U.S. 169, 100 S.Ct. 978 (1980), the court confirmed the definition of "agency records" to be "all books, papers, maps, photographs, or other documentary materials regardless of physical form of character, made or received by an agency of the United States Government under Federal law or in connection with the

[22] 5 U.S.C. §552(a)(4)(A)(i). (emphasis provided). See also,*Weisberg v. USDOJ*, 631 F.2d 824, 829 n. 32 where "the Government acknowledges, however, that in specifying applicable charges for fulfilling FOIA requests, the Act would seem to presume that records must be duplicated on request."

[23] *Weisberg v. Dept of Justice*, 631 F.2d 824 (D.C. Cir. 1980).

transaction public business."[24] In the *Weisberg* case, the court stated that the photographs *did* in fact plainly "reflect the . . . operation, or decision-making function of the agency,"[25] noting that the photographs "permit[ted] evaluation of the FBI's performance in investigating the King assassination."[26] Unfortunately, the court did not progress past the confirmation that copyrighted records could be classified as an agency record. The court skirted the issue of the proper relationship between the FOIA and copyright laws, and instead vacated the district court's judgment and remanded the case for lack of proper joinder.[27]

Like many states' public records law, the FOIA also contains certain limitations where disclosure is exempted through statute. Two provisions, commonly called Exemption 3 and Exemption 4, have been used by parties to argue that copyrighted material should not fall under the FOIA disclosure rules. The exemptions provide, in part:

> (b) This section [referring to 5 U.S.C. §552] does not apply to matters that are --
> (3) specifically exempted from disclosure by statute . . . provided that such statute (A) requires that matters be withheld from the public in such a manner as to leave no discretion on the issue, or (B) established particular criteria for withholding or refers to particular types of matters to be withheld;
> (4) trade secrets and commercial or financial information obtained from a person and privileged or confidential . . . .

As stated earlier, the *Weisberg* court refused to address the relationship between the FOIA and copyright laws, and, in addition, did not expand a discussion of Exemptions 3 or 4. One aspect to note in Exemption 3 is that for any other statute to be exempted from FOIA provisions, it must be an "explicit nondisclosure" statute.[28] No caselaw has suggested

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[24] The Supreme Court linked the definition of a "record" from the Records Disposal Act, 44 U.S.C. §3301, to the FOIA.
[25] *Weisberg*, citing *SDC Development Corp. v. Mathews*, 542 F.2d 1116 (9th Cir. 1976).
[26] *Id.* at 828.
[27] *Id.* at 831.
[28] *See Irons & Sears v. Dann*, 606 F.2d 1215, 1220 (D.C. Cir. 1979), *cert. denied*, 444 U.S. 1075 (1980).

that federal copyright law is a nondisclosure statute; in fact, the public is free to view and inspect registered copyrighted documents in the Copyright Office itself![29] The caselaw available has suggested "FOIA does not provide any specific exemption for copyrighted materials, nor does the copyrighted act meet the exemption standards under 5 U.S.C. §552(b)(3)."[30]

However, if the copyright information also doubles as a trade secret under the FOIA Exemption 4, then disclosure of the copyrighted information could be limited.[31] In the limited situation where a court has addressed copyright and the FOIA Exemption 4, a record is confidential "if disclosure is likely to have either of the following effects: (1) to impair the Government's ability to obtain necessary information in the future; or (2) to cause substantial harm to the competitive position of the person from whom the information was obtained."[32] In *Gilmore v. U.S. Dept of Energy*,[33] a member of the public brought a FOIA action against the Department of Energy (DOE) for the purpose of obtaining all records relating to a copyrighted video-conferencing software used by DOE. The court, using the two factors above, found Exemption 4 to preclude releasing the copyrighted information to the public. The Court stated:

> [D]isclosure of CLERVER [software] to Gilmore so that he can distribute CLERVER on the Internet will cause substantial commercial

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[29] *See* 17 U.S.C. §705(b). For further discussion on this topic, please see *OIP Guidance*, Vol. IV, No. 4, 1983 FOIA Update, "Copyrighted Materials and the FOIA". Available at http://www.usdoj.gov/oip/foia_updates/vol_iv_4/page3.htm.

[30] *St. Paul's Benev. Educational and Missionary Institute v. U.S.*, 506 F. Supp. 822 (D.C.Ga., 1980) *citing*, *National Parks and Conservation Association v. Kleppe*, 178 U.S.App.D.C. 379, 547 F.2d 673 at 686 (D.C. Cir. 1976)

[31] *See Public Citizen Health Research Group v. Food and Drug Admin*, 704 F.2d 1280, 1288 (C.A.D.C. 1983) where the court defined "trade secret, solely for the purpose of FOIA Exemption 4, as a secret, commercially valuable plan, formula, process, or device that is used for the making, preparing, compounding, or processing of trade commodities and that can be said to be the end product of either innovation or substantial effort."

[32] *GC Micro Corp. v. Defense Logistics Agency*, 33 F.3d 1109, 1112 (9th Cir. 1994) (quoting *National Parks & Conservation Ass'n v. Morton*, 498, F.2d 765 (D.C.Cir.1974)).

[33] 4 F.Supp.2d 912 (N.D.Cal.1998).

> harm . . . if the technology is freely available on the Internet, there is no reason for anyone to license CLERVER . . . and the value of [holder's] copyright effectively will have been reduced to zero. There also can be no doubt that corporations will be less likely to enter into joint ventures with the government to develop technology if that technology can be distributed freely through FOIA, irrespective of any intellectual property rights retained by the corporations."[34]

2. Is the Copyrighted Material a Record? (Part II)

a. Caselaw at the State Level & Doctrine of Fair Use

Examining the definition of "record" and its exceptions is not unique to the FOIA; it has also been the subject under review in state courts. The definition of "record" under Wisconsin statute is:

> Record means any material on which written, drawn, printed, spoken, visual or electromagnetic information is recorded or preserved, regardless of physical form or characteristics, which has been created or is being kept by an authority. . . . [R]ecord does not include . . . *materials to which access is limited by copyright, patent, or bequest. . . .*[35]

In a recent case, *Zellner v. Cedarburg School District*,[36] the Supreme Court of Wisconsin discussed the definition of "record" in a factually unique case. Zellner was a school teacher at a public high school and was terminated after a hearing produced evidence that he visited pornographic websites on his work computer. A complete analysis of Zellner's computer was performed by the school district, and authorities prepared a CD-ROM containing adult images obtained from the computer's hard drive, as well as a memo containing a description of the images, "search words" and website addresses. A local newspaper requested these two items under Wisconsin's Open Records Law. Zellner opposed the public records request on the position that the photos in the CD-ROM and the description of the pictures on the memo were not "records", as the copyright exception contained within the definition of

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[34] *Id.* at 923.
[35] Wis. Stat. § 19.32(2) (2007). (quotations removed). (emphasis provided).
[36] *Zellner v. Cedarburg School District*, 731 N.W.2d 240 (2007).

"record" would apply in this case. After determining that Zellner had standing[37] to assert the copyright protection, the court addressed whether the copyright exception in the state law would preclude the CD-ROM and memo from being categorized as a record.

The court ruled that the copyright exception to the definition of "record" did not apply in this situation.[38] The court proclaimed the phrase "limited by copyright" was not ambiguous; however, it noted at the same time that copyright protection was not unlimited. The court focused on the fact that "federal law recognizes a 'fair use' exception to copyright infringement"[39] and on the "nature of the copyrighted work, and the effect of the use upon the potential market for, or value of, the copyrighted work."[40] In this case, the images on the CD-ROM and the website addresses were freely available on the Internet; further, the school district would not profit in anyway from the distribution of the images. This lead to the result that providing copies to the newspaper would indeed constitute a fair use of the material.

Courts in the State of Washington have heard arguments that most closely reflect the problem scenario presented in this paper. In *Lindberg v. County of Kitsap*[41], the Lindbergs sought copies from the Kitsap County Department of Community Development of site, drainage, and erosion control plans for a proposed residential development. The documents, prepared by a private engineering firm, were stamped with a copyright by a licensed engineer. The county informed the Lindbergs that the federal Copyright Act pre-empted

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[37] *Id*. at 245-46.
[38] *Id.* The court did address other exceptions to Wisconsin's Open Records Law, such as limiting release of records when a current investigation into a possible criminal offense of misconduct exists. In this case, Zellner had already been terminated when the request was made for the CD-ROM and memo, so the investigation had concluded.
[39] *Id.* at 247.
[40] *Id.*
[41] *Lindberg v. County of Kitsap*, 133 Wash.2d 729, 948 P.2d 805 (Wash. 1997).

state law, and that Kitsap would allow inspection of the documents, but would not authorize copying of the documents without permission of the copyright owners.

The State of Washington's public records copying provision states in part:

> [P]ublic records shall be available for inspection and copying, and agencies shall, upon request for identifiable public records, make them promptly available to any person . . . . [A]gencies shall not deny a request for identifiable public records solely on the basis that the request is overbroad. Agencies shall not distinguish among the persons requesting records, and such persons shall not be required to provide information as to the purpose for the request except to establish whether inspection and copying would violate RCW 42.56.070(9) or other statute which exempts or prohibits disclosure of specific information or records to certain persons . . . .[42]

In Washington, there is no explicit exception for copyrighted material; however, various exceptions to disclosure exist in law, such as: "[v]aluable formulae, designs, drawings, computer source code or object code, and research data obtained by any agency within five years of the request for disclosure when disclosure would produce private gain and public loss."[43]

In *Lindberg*, the issue of federal pre-emption of state law was, like *Zellner*, not addressed; rather, the court skirted the issue by examining whether the reasoning for using the copyrighted material would constitute a fair use. In this case, the Lindbergs requested copies of the documents to be used "in preparation for their comments and criticism on the residential development proposals in public hearings and appeals."[44] The court concluded that this was indeed a fair use under copyright law. The County did raise the position that neither the court nor the county had the authority to perform a fair use analysis because state law expressly states that "persons [who make a public records

[42] Wash. Rev. Code. §42.56.080 (2007).
[43] Wash. Rev. Code. §42.56.270 (2007).
[44] *Id.* at 745

request] shall not be required to provide information as to the purpose for the request . . . ."[45] Unfortunately, the court refused to address the argument.[46]

3. Advisory Opinions

The dearth of caselaw[47] on the issue of copyrighted records has prompted concerned local government attorneys to request guidance from their respective state attorney general or other state commissions. Here is a review of a few opinions; which may provide guidance to practitioners facing the issue.

a. Connecticut

Connecticut's Freedom of Information Commission has directly addressed the question of copyrighted blueprints. Specifically, the question discussed was whether "copyrighted blueprints and plans are exempt from the Freedom of Information Act's copying provisions and, if not, whether the copying of such documents by the town's building official would constitute a copyright infringement."[48] The commission noted the importance of the issue stating that while federal copyright law "does not make anyone specifically liable for infringement committed by another...[federal copyright law] does not preclude responsibility for contributory infringement."[49] The commission's decision echoed the existing caselaw discussed in this paper, stating:

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[45] Wash. Rev. Code §42.17.270 (1997).
[46] *Lindberg* at 746, 814, where the court stated "This is an issue raised for the first time on appeal and which does not involve fundamental rights. It need not be considered by this Court and we do not.
[47] It must be noted that these exists another set of case law and AG opinions that deal with similar sounding, but significantly different situation: a situation where the public entity itself claims a copyright and wants to preserve its effort expending in creating a product (for example, county spends money on mapping county lines, borders, roads, etc and a private company aims to copy the maps through a public records request and publish the maps for profit.
[48] Conn. Freedom of Info. Comm'n, Op. 62 (1985).
[49] Op. #62 citing *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911).

> [A]rchitectural blueprints and plans that are properly copyrighted under federal statute are generally exempt from the copying provisions of the Freedom of Information Act under superseding authority of [the Copyright Act]. In some cases, however, the fair use doctrine . . . may permit copyright of such records without constituting an infringement . . . for example, reproduction for the purposes of safety inspections, education, legislative or judicial proceedings or news reporting could all be interpreted as permissible under [federal copyright law].[50]

b. Texas

The Comptroller of Public Accounts from Austin, Texas, requested a written opinion from the state Office of the Attorney General (OAG) when a public records request was made for "all documents produced by [a private company] . . . which deal with the economic future of the Austin, Texas area."[51]

The city had a subscription contract with a private company for services and part of the contract aimed to protect the company's copyright and other commercial property rights." The OAG proclaimed that:

> [T]he custodian of public records must comply with the copyright law and is not required to furnish copies of such records that are copyrighted. Members of the public have the right to examine copyrighted materials held as public materials and to make copies of such records unassisted by the state. Of course, one so doing assumes the risk of a copyright infringement suit. [52]

c. Colorado

In Colorado, the Attorney General has released an opinion that "[S]ome as-built drawings or other architectural drawings in government files might be protected by copyright. While the custodian may allow inspection of such copyrighted material, the custodian ordinarily will not copy such materials or allow others to copy them.[53] The

[50] *Id*.
[51] Tex. Op. Att'y Gen. JM-672 (1987).
[52] *Id*. at 2.
[53] Colo. Op. Att'y Gen. No. 01-1, n.9 (2001).

Attorney General's opinion notes that state public records law dictate that "a custodian *may* furnish copies"[54], not that it is forced to make copies.

d. Florida

In Florida, the Attorney General's Advisory Opinion states that "custodians may release for inspection and copying architectural and engineering plans that must be filed with the agency pursuant to law. Such custodians, however, should advise individuals seeking to copy such records of the limitations of the federal copyright law and the consequences of violating its provisions."[55] One interesting note is that while the AG's office did not fully address the pre-emption of federal copyright law over state law, and admits that "federal law provides that a state is not immune from suit for copyright infringement",[56] it did utilize language from the United States Supreme Court:

> [I]t has not been widely thought that the federal antitrust, bankruptcy, or copyright statutes abrogated the State's sovereign immunity. This [United States Supreme] Court never has awarded relief against a State under any of those statutory schemes . . . . [A]lthough the copyright and bankruptcy laws have existed practically since out nation's inception . . . there is no established tradition in the lower federal courts of allowing enforcement of those federal statutes against the States.[57]

e. New York

A request was made under New York's Freedom of Information Law for "emergency medical response protocols." In this case, particular sections of the protocols were protected by copyright and distribution through an exclusive license. New York's Freedom of Information Law is based loosely off the federal FOIA, and contains a provision similar to Exemption 4 of the FOIA ("trade secret" discussion - see above). In

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[54] *Id.*
[55] Fla. Op. Att'y Gen. 97-84 (1997).
[56] *Id.* at 4.
[57] Op. 97-84 citing *Seminole Tribe of Florida vs. Florida*, 517 U.S. 44, 116 S.Ct. 1114, 1185 fn.16 (1996).

this case, New York's Committee for Open Government focused on whether the protocols would constitute, similar to the FOIA Exemption 4, a "trade secret or was submitted to the agency by a commercial enterprise, or was derived from information obtained from a commercial enterprise and . . . if disclosed, would cause substantial injury to the competitive position of the subject enterprise."[58] This, the advisory opinion reasoned, required a congruent examination of the fair use doctrine under federal copyright law as well as New York's "trade secret" provision. The opinion noted the trade secret exception:

> [S]tands as a viable means of protecting commercial valuable copyrighted works where FOIA disclosure would have a substantial adverse effect on the copyright holder's potential market. . . .Exemption 4 and the Copyright Act actually embody virtually congruent protection, because such an adverse economic effect will almost always preclude a 'fair use' copyright defense . . . Thus, Exemption 4 should protect such materials in the same instances in which copyright infringement would be found.[59]

In this case, the opinion stated that granting permission for the reproduction of the copyrighted software would indeed cause a great deal of harm to the copyright holder by compromising the competitive position of the product. The opinion concluded by stating that the trade secret provision in New York law would preclude reproduction of the work.

V. What Steps to Take?

By this point, the lack of clarity of the relationship between federal copyright law and public records law is evident. The courts that have been faced with this fundamental issue have consistently refused to meet it head-on. Instead, courts have done one (or a combination) of the following: the copyrighted material will be deemed not to be a "record",

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[58] N.Y. Comm. on Open Gov. – Staff Advisory Opinion to Mr. Michael A. Kless (1998). Available at http://www.dos.state.ny.us/coog/f11109.htm.

[59] *Id.* (quoting *Copyrighted Materials and the FOIA*, FOIA Update, Vol. IV, No.4 (1983)). Available at http://www.usdoj.gov/oip/foia_updates/Vol_IV_4/page3.htm.

the fair use doctrine will limit the copyright, or a procedural issue (such as joinder) will preclude the case from resolution. Some state Attorney Generals have released opinions, and as seen above, the opinions depend heavily on the state law (see differences between Texas and Florida). In addition, if working under the federal FOIA (or similar state law provision), the FOIA Exception 4 may apply to the public record under examination. What can a local attorney do to alleviate the confusion?

One possible tool is to add a disclaimer to public records request forms. It is important to ensure that when material is disclosed to a member of the public, the recipient is notified that further copying or reproduction might not be allowed and that they should contact the copyright holder for permission if intending to use the disclosed material in violation of any copyright. This could include a disclaimer such as the following:

> **The copyright law of the United States (Title 17, United States Code) governs the making of photographs or other reproductions of copyrighted material. Under certain conditions specified in the law, libraries and archives are authorized to furnish a photocopy or other reproduction. One of these specified conditions is that the photocopy or reproduction is not to be "used for any purpose other than private study, scholarship or research." If a user makes a request for, or later uses, a photocopy or reproduction for purposes in excess of "fair use", that user may be liable for copyright infringement. [Custodian/Locality] does not indemnify nor hold harmless users of material produced pursuant to a FOIA request, nor release such users from copyright infringement, nor grant exclusive use rights with respect to such material.**[60]

In addition to providing a disclaimer, the following is a minimum standard checklist that one must go through when questioning whether to release a copyrighted record:

[60] Adapted from New Mexico Commission of Public Records – State Records Center & Archives – Conditions for Publication/Reproduction. Available at http://www.nmcpr.state.nm.us.

- Is it a Record? – Note the definition of "record". A state may copy federal law or may have its own unique definitions.
- Note exemptions to the definition of "record' – Some states have extensive categories of document types that are labelled as confidential/non-disclosable.
- If the requested material is a "record", is it covered by copyright? – Some states, as part of the legal definition of "public record", specifically exclude material "limited by copyright" from the definition. This *does not* necessarily preclude *all* copyrighted material. For example, the "fair use" doctrine is a valid limitation on copyright under particular statutory scenarios. In addition, some states will include "trade secret" or "competitive advantage" provisions, thereby preventing sensitive copyrighted material to be reproduced.
- Consider more than just what the courts say – Clearly, courts are hesitant to approach the pre-emption issue. However, the lack of court action may result in the guidance through a state AG opinion, or an advisory opinion by the local open government/freedom of information committee.

Obviously, one of the primary motivations for taking the proper precautions is to avoid litigation. A custodian of a copyrighted public record must consider the options carefully, and with a slight variation of the tones of Bill Cosby, hopefully success can be achieved (and thus, failure avoided!) while pleasing all parties involved.