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Litigating the Right to Be a Scholar

ROBERT SPOO

This essay is an elaboration of remarks prepared for a plenary panel entitled "Joyce and Copyright" at the Austin James Joyce Conference in June 2007.[1] I had originally planned to call the panel "Carol Loeb Shloss versus One Estate Called the Estate of James Joyce." My thought was to evoke a parallel, grandiose perhaps, to Morris L. Ernst's famous legal challenge to the official seizure of a single imported copy of *Ulysses*, branded by the federal government as obscene under the Tariff Act. Both lawsuits—the one orchestrated by Ernst on behalf of Random House and the action filed by Professor Shloss some seventy-five years later—could reasonably be viewed as efforts to liberate James Joyce's words from a misuse of the law. For the brandishing of copyrights to stifle lawful use of literary or biographical materials is, in principle, as significant a threat to the public interest as the invocation of a federal statute to suppress an important novel. In both cases, the parties urging suppression sought to wrap themselves in the prestige of reigning orthodoxies: the government argued that the forfeiture and destruction of a copy of *Ulysses* were needed to protect family values; the Joyce Estate insisted that prohibiting dissemination of writings by James and Lucia Joyce was necessary to preserve family privacy.

The title "Joyce and Copyright," adequate though it was for its purpose, savors of an earlier period when some of us were working to establish copyright and fair use as analytical and rhetorical tools for thinking about the propertization of modernism and its effects on the traditional functions of scholarship.[2] It remains just as true today, of course, that the expansion of copyrights, both in scope and duration, is leading many to question whether this law that plays such an important role in our culture has become a victim of its own unprecedented growth. When a room becomes very crowded, we move instinctively toward the nearest open

window. Copyright crowding has led to greater reliance on fair use—demonized by some as the "other" of copyright,[3] when in fact it serves exactly the same purposes—and to the rise of a new legal defense, "copyright misuse," which takes misbehaving copyright holders to task for trying to extend a limited monopoly beyond its legal bounds.

One way of marking the difference between the "Joyce and Copyright" years and today is that we have begun to move from theory to practice. Scholars who felt the lash of unsympathetic copyright owners and received no balm from their timorous publishers needed a language and analytical framework for assessing their predicament and its possible solutions. Some years were spent ascertaining the metes and bounds of the right to be a scholar. Essays were written; experts were consulted. These years saw the release of the "Statement Regarding Scholarly Use of Twentieth-Century Literary Materials," which grew out of a meeting between lawyers and Joyce scholars at the Harry Ransom Humanities Research Center in 1995;[4] articles on the copyright status of *Ulysses*;[5] a special issue of the *James Joyce Quarterly* devoted to "Joyce and the Law";[6] Paul Saint-Amour's important book, *The Copyrights*, published in 2003;[7] and, in 2006, the IJJF-sponsored fact-finding panel and its web-published FAQs about copyright, fair use, and what could then be publicly ascertained of the permissions policies and practices of the James Joyce Estate.[8]

But with the lawsuit brought by Professor Shloss we did more than meet real threats with patient analysis; we took a practical step. It is one lawyer's story of that lawsuit that I offer here. And, for reasons noted later in this essay, the story is not yet concluded. To begin with the obvious: Professor Shloss is the author of this legal odyssey, and the authoress of the book—*Lucia Joyce: To Dance in the Wake* (New York: Farrar Straus & Giroux, 2003)—that has existed, like Penelope's web, at the center of the odyssey. I will touch briefly on the following topics: facts, courage, the lawsuit, its settlement, and the most recent development in the case, attorneys' fees.

FACTS

A worthwhile lawsuit requires worthy facts. Not every unfairness can be redressed by the legal system. As a plaintiff, Professor Shloss brought worthy, litigable facts to her case. From the mid-1990s on, her research on Lucia Joyce had been hampered by opposition from the Joyce Estate. After all, she had chosen a subject that has consistently been at the heart

of the Estate's demand for privacy—an unusual sort of demand, it must be said, made on behalf of deceased persons, concerning documents that reside in archives that anyone may visit, and to be enforced through the ill-fitting machinery of copyright law. One form the Estate's opposition took was assertive letters sent to Professor Shloss, her publisher, her publisher's president, her publisher's lawyer, her university's provost, and, finally, to her Stanford lawyers after she expressed the intention of publishing a website that would contain materials that she and her publisher had cut from her Lucia book following the Estate's threats.[9] These letters, whose vigorous style many Joyceans are familiar with, became important evidence in the case. The letter-writing and other conduct alleged in Professor Shloss's Complaint—including allegations that the Estate or its intermediaries attempted to interfere with her physical access to certain archival materials and to prohibit her from quoting from Lucia Joyce's medical records, over which the Estate holds no copyright[10]—these allegations and others formed the bedrock factual contentions in the case. Of course, the price of having a factually rich case is having had to undergo the facts in the first place. This takes me to my second topic.

COURAGE

Some lawsuits—such as those brought to remedy the infliction of physical or psychological pain—permit a monetary recovery for what lawyers call "pain and suffering." It's an odd sort of remedy: pain soothed by cash. But a copyright claimant, as such, cannot recover for pain and suffering; much less can a plaintiff such as Professor Shloss, who simply sought an injunction to prevent *future* pain and a declaration that she had a right to go on being the kind of scholar that she had been trained to be. (In fact, Professor Shloss might have included allegations of tortious interference with contract or intentional infliction of emotional distress, but she chose not to do so. This case was not about monetary compensation.) Yet in a real and unavoidable way, it was about pain and suffering, and Professor Shloss was required to revisit many painful experiences, first with her lawyers so that we could help build her case, and later in the funhouse mirror of her opponents' arguments.

Professor Shloss has shown great courage throughout this lawsuit. Being a litigant is not an easy thing, even if you are doing something as seemingly straightforward as asking the court for a declaration of fair use. Attorneys' fees aside, the emotional costs of a lawsuit are high; whichever

side of the "v." you occupy, plaintiff or defendant, there is psychological strain, the knowledge that a smart adversary is working hard to make your position appear threadbare before a tribunal. In this case, the Estate was not content to try to show that Professor Shloss's legal contentions were wrong; it launched attacks on her qualities as a scholar and her motivations as a plaintiff. It asserted in court papers that her lawyers were seeking "to air their views and test their theories in a public forum."[11] One of the Estate's lawyers—from the large, prestigious firm of Jones Day—even spent two days at the Harry Ransom Center studying a Lucia Joyce manuscript for the purpose of creating a lengthy motion exhibit analyzing Professor Shloss's transcriptions of the document.[12] All of this has been tough on Professor Shloss, and my hat has been off to her since she took the step of suing.

THE LAWSUIT

Professor Shloss's Complaint, which named the Joyce Estate and trustee Seán Sweeney as defendants, was filed close to Bloomsday of 2006 in the federal district court for the Northern District of California.[13] Many Joyceans learned of it during the Symposium in Budapest from a *New Yorker* article by D.T. Max.[14] The lawsuit sought, among other things, a judicial declaration concerning fair use, copyright misuse, and the U.S. public-domain status of the 1922 first edition of *Ulysses*. The proposed website containing materials cut from Professor Shloss's book was to be confined to U.S. Internet addresses so that it could be downloaded only in this country. This decision was made because a U.S. court would be reluctant to decide the case under multiple bodies of national law with which the court was not familiar—British fair dealing, for example—or to issue orders that would not necessarily be recognized by foreign courts.

A cutting-edge contention of Professor Shloss's lawsuit was that the Joyce Estate was guilty of having engaged in copyright misuse—an attempt to extend its monopoly power beyond its proper economic sphere by using copyrights to try to shut down scholarly discussion, prevent use of public-domain materials, and interfere with Professor Shloss's access to physical documents in libraries and archives. If Professor Shloss could prove copyright misuse, the Estate might be disabled from enforcing its copyrights against her, at least until the Estate had purged the misconduct and its effects.[15]

Once the Estate had secured representation by the Los Angeles office of the Jones Day firm, a lengthy period followed as both parties' lawyers discussed preliminary issues: personal jurisdiction over the Estate and Mr. Sweeney, scheduling, possible settlement, and so on. It was not until November of 2006 that the Estate made a significant move. On November 17, the Estate filed a motion to dismiss Professor Shloss's lawsuit in its entirety. Along with this motion, the Estate alternatively moved, in the event the action was not dismissed, to have certain allegations and claims stricken from Professor Shloss's Complaint. The Estate was particularly eager to strike allegations that the Estate had engaged in copyright misuse and that the 1922 *Ulysses* is in the public domain in the United States.

The essential assertion in the Estate's motion was that Carol Shloss had no real and reasonable fear, now or ever, of being sued by the Joyce Estate for copyright infringement. As strange as that may sound to those who know anything of the facts, we had to treat the argument as a serious one, because federal law does not permit a United States court to entertain a lawsuit unless there is a genuine, concrete dispute between the parties. If it turned out that Professor Shloss had never had a reasonable apprehension of suit, the court would not have the power to go on refereeing a hypothetical controversy.

Professor Shloss's attorneys responded with opposition papers that placed before the court, along with other evidence, numerous letters that Stephen James Joyce had written targeting Professor Shloss's book project, including letters to her publisher announcing that the Estate was "willing to take any necessary action" to enforce its copyrights; that the Estate's "record in legal terms is crystal clear" and that it was "prepared to put [its] money where [its] mouth is"; that the Shloss book would be published at "your risk and peril" (*à vos risques et périls*) and that "there are more ways than one to skin a cat."[16]

In a 19-page order, Judge James Ware denied the Estate's motion to dismiss, holding that these communications from the Estate, as alleged, "occurred regularly over a period of nine years, from 1996 to 2005, and easily left [Shloss] with a reasonable apprehension of copyright liability when she filed this suit in 2006."[17] The court pointedly remarked that "[t]his case is not a mere '"academic" war' or a '"hypothetical" case,' as [the Estate asserts]."[18] The court also refused to dismiss or strike Professor Shloss's copyright misuse claim, holding that "[the Estate's] alleged actions significantly undermined the copyright policy of 'promoting invention and creative expression,' as [Shloss] was allegedly intimidated

from using (1) non-copyrightable fact works such as medical records and (2) works to which [the Estate] did not own or control copyrights, such as letters written by third parties."[19] Professor Shloss had also properly alleged, Judge Ware said, copyright misuse "based on [the Estate's] actions vis-à-vis third parties," a ruling that permitted Professor Shloss's allegations about the Estate's treatment of *other* Joyce scholars to remain in the case.[20] Having denied the Estate's motion to dismiss, the court rejected all of the Estate's motion to strike except as to one paragraph of Professor Shloss's Complaint containing certain background allegations. Professor Shloss had defeated literally 99% of the Estate's combined motions. This set the stage for settlement.

SETTLEMENT

It was never Professor Shloss's wish to settle her lawsuit; settlement was triggered by the Estate's actions in the case. At the hearing on the motion to dismiss, the Estate's lawyers stated in open court that the Estate was considering filing a "covenant not to sue" Professor Shloss for any of the material contained in her website.[21] Later, the Estate made this intention even clearer. A covenant is a formal, binding promise. Had the Estate filed such a promise with the court, Judge Ware would have had little choice but to dismiss the case upon the Estate's motion because a federal court, once again, is constitutionally forbidden to entertain a lawsuit where there is no longer a genuine dispute between the parties.

A covenant would have rendered the case moot because it would have given Professor Shloss all the practical relief she had sued for. The question then became, what *more* could she obtain if she accepted dismissal after settlement than if she waited for dismissal after a covenant? The answer can be found in the public settlement agreement: not only can Professor Shloss publish her website (which can be found at www.lucia-the-authors-cut.info/), but she can also reproduce it in print form within the United States—something she did not ask for in her Complaint.[22]

Some have expressed puzzlement that this case did not go to a final judgment and create a major precedent for other scholars and copyright users. Chalk it up to the Estate's choice not to litigate the case any further. It is true that the lawsuit did not generate a momentous public legal decision like Judge John M. Woolsey's opinion in *United States versus One Book Called* Ulysses.[23] But even precedent has its limits. Judge Woolsey's opinion was the law only of the Southern District of New York, strictly

speaking. Even after it was affirmed by the Second Circuit Court of Appeals,[24] its writ ran only to the federal districts of New York, Connecticut, and Vermont. Yet the Woolsey opinion shows that a case can have symbolic resonance and practical consequences far beyond its official reach. A just lawsuit can arouse public indignation against a misuse of law or power, and can offer the edifying example of an individual standing up to that misuse. It can also make a point about the costs of behaving badly. Much of our social order functions without the formal interventions of law.[25] A Texas publisher in 1935, though lacking the official protection of the Woolsey decision, might have drawn inspiration and courage from that case to issue a progressive new novel. A publisher today might find in the Shloss case the message that scholarly fair use is real and vital enough for at least one academic and her attorneys to have cared enough to go to law over it. (The Schloss case has nevertheless generated two significant published decisions touching on copyright misuse and attorney's fees. These decisions are discussed and cited herein.)

If we seek a parallel for the settlement of *Shloss v. Estate of James Joyce*, we might look to the consent decree that James Joyce obtained from a New York state court against the booklegger Samuel Roth in 1928. Like the Shloss settlement, that consent decree resulted from a court-approved agreement of the parties that Roth would cease using Joyce's name in connection with any advertising or publications.[26] And, as with the Shloss settlement, the Roth consent decree bound only the parties to the case. Although in his address to the International P.E.N. Congress in 1937 James Joyce tried to characterize the Roth decree as something like a global precedent for authors' moral rights, he was speaking to writers, not lawyers.[27] The pirate next door was free to take his chances *de novo*. But Joyce's lawsuit and the international protest he instigated against Roth[28] may have had more than a little to do with the relative absence of unauthorized printings of *Ulysses* after the Random House edition appeared in 1934. Despite the doubtful copyright status of the 1922 text in the United States, competitors in the American publishing world appear to have respected a sort of "courtesy copyright" in *Ulysses*.[29] That's an example of order without law—the ripple effect of Joyce's campaigns against piracy and obscenity law. A lawsuit as right and resonant as *Shloss v. Estate of James Joyce* may have a long career of moral, if not legal, authority.

ATTORNEYS' FEES

The nature of Professor Shloss's settlement—a court-approved and court-enforceable settlement giving her all the practical relief she had sought,

and more—permitted her, we thought, to ask the court to order the Joyce Estate to pay her legal fees. *Pro bono* assistance can be entitled to compensation if the governing statute—here, the Copyright Act—permits fees to be awarded to the "prevailing party."[30] So we moved for fees, and on May 30, 2007, Judge Ware granted our motion in a five-page opinion, holding that Professor Shloss was the prevailing party because "by the Settlement Agreement, [she] achieved a material, judicially sanctioned alteration in the parties' legal relationship."[31] The court explained that

> [Shloss] secured via Settlement Agreement the essence of the relief she had sought: the ability to publish the Electronic Supplement online for access within the United States, without threat of suit from [the Estate]. Moreover, [Shloss] secured further relief not even requested in her First Amended Complaint: that is, the ability to publish her Electronic Supplement in *print* format, without fear of suit from [the Estate]. In return, [Shloss] agreed only to dismiss her claims with prejudice; she did not agree to pay [the Estate] money or to limit her conduct. [The Estate's] contention that they are the "prevailing party" because [Shloss] agreed to dismiss her claims with prejudice is untenable.[32]

What does this order do? It tells us in no uncertain terms that Carol Shloss "prevailed" on the basis of the results she obtained. Is it precedent on questions of fair use and copyright misuse? No. Is it precedent on the attorneys' fees issue? Yes. Judge Ware's order has become a published opinion, as has his order denying the Estate's motion to dismiss. Bear in mind, however, that Judge Ware has ruled on the *fact* of fees; the parties still have to litigate the *amount* of fees.

We are very pleased with the results of this lawsuit and are proud to have helped Carol Shloss bring it. It's not every day that the right thing happens. This day, it did.

NOTES

1. The views expressed in this essay are my own and not necessarily those of any law firm for which I have worked; the Stanford Law School's Center for Internet and Society, its Cyberlaw Clinic and Fair Use Project; Professor Carol Loeb Shloss; or the editors of *Joyce Studies Annual.*

2. Paul K. Saint-Amour describes modernism as "that which is still propertized." Paul K. Saint-Amour, Review of William M. Landes and Richard Posner, *The Economic Structure of Intellectual Property Law* (Cambridge, Massachusetts: Harvard University Press, 2003), in *Modernism/modernity* 12 (2005): 511.

3. Sometimes, content owners reject the concept of fair use entirely. The late Jack Valenti, President of the Motion Picture Association of America, was asked during an interview, "Do consumers have a fair use right to remix a few seconds of a Hollywood movie into a home movie project?" Valenti replied: "There is no fair use to take something that doesn't belong to you. That's not fair use. If you're a professor in a classroom, you show 'Singing in the Rain' to your class. You can fast forward it, and there's no performance fee for that. That's fair use. Now, fair use is not in the law. People are taking fair use and changing it to unfair use and claiming that it's fair use." J.D. Lasica, "The Engadget Interview: Jack Valenti" (August 30, 2004; found at www.engadget.com/2004/08/30/the-engadget-interview-jack-valenti/; last accessed Oct. 14, 2008). If Valenti was quoted accurately, he was very confused about fair use. Not only does fair use most definitely exist "in the law" (see Section 107 of the U.S. Copyright Act—17 U.S.C. § 107), but the type of classroom use he described in the interview is permitted by a provision entirely *separate* from the fair-use provision: Section 110 (Exemption of Certain Performances and Displays).

4. "Statement Regarding Scholarly Use of Twentieth-Century Literary Materials," *James Joyce Quarterly* 33.1 (Fall 1995): 13–16.

5. See, for example, Robert Spoo, "Copyright Protectionism and Its Discontents: The Case of James Joyce's *Ulysses* in America," *The Yale Law Journal*, 108 (December 1998):633–67. Cited hereafter as Spoo, "Copyright Protectionism."

6. "Joyce and the Law," guest eds. Robert Spoo and Joseph Valente, *James Joyce Quarterly* 37.3/4 (Spring/Summer 2000).

7. Paul K. Saint-Amour, *The Copywrights: Intellectual Property and the Literary Imagination* (Ithaca, New York: Cornell University Press, 2003).

8. "James Joyce: Copyright, Permissions, and Fair Use FAQ" (found at http://english.osu.edu/research/organizations/ijjf/copyrightfaqs.cfm) (last accessed Oct. 14, 2008). Also printed in the *James Joyce Quarterly* 44.4 (Summer 2007): 753–84.

9. See Professor Shloss's Amended Complaint against Seán Sweeney and the Estate of James Joyce, paragraphs 15–16, 47–63, 79–84 (found at http://cyberlaw.Stanford.edu/node/5045) (last visited October 6, 2007).

10. See Shloss Amended Complaint, paragraphs 48, 53.

11. Defendants' Motion to Dismiss, or in the Alternative to Strike, Carol Loeb Shloss's Amended Complaint, 20.

12. Declaration of Anna E. Raimer in Support of Defendants' Reply to Plaintiff's Opposition to Defendants' Motion to Dismiss, or in the Alternative to Strike, Carol Loeb Shloss's Amended Complaint, 1, Exhibit B.

13. The Complaint was docketed as case number CV 06-3718.

14. D. T. Max, "The Injustice Collector: Is James Joyce's grandson suppressing scholarship?" *The New Yorker*, 19 June 2006, pp.34–43. http://www.newyorker.com/archive/2006/06/19/060619fa_fact

15. Copyright misuse is discussed and adjudicated in an increasing number of judicial decisions. See, for example, *Intel Corp. & Dell Inc. v. Commonwealth Scientific & Industrial Research Organization*, 455 F.3d 1364, 1368 (Fed. Cir. 2006); *Assessment Technologies of Wisconsin, LLC v. WIREdata, Inc.*, 350 F.3d 640, 647 (7th Cir.

2003); *Practice Management Information Corp. v. American Medical Association*, 121 F.3d 516, 520 (9th Cir.1997); *In re Napster, Inc. Copyright Litigation*, 191 F. Supp. 2d 1087, 1103 (N.D. Cal. 2002). The doctrine of copyright misuse is analyzed in William F. Patry and Richard A. Posner, "Fair Use and Statutory Reform in the Wake of *Eldred*," *California Law Review*, 92 (2004): 1658–59.

16. These statements by Mr. Joyce appear in his letter to Professor Shloss, dated August 8, 2003, and his letter to Leon Friedman, an attorney for Farrar Straus & Giroux, dated November 21, 2002. These letters and others by Mr. Joyce were included in their entirety with Professor Shloss's Opposition to Defendants' Motion to Dismiss for Lack of Subject Matter Jurisdiction and Motion to Strike. The Opposition, which quotes from the letters in the context of factual and legal argument, may be found at http://cyberlaw.stanford.edu/system/files/Shloss+Brief+FINAL.pdf. (last accessed Oct. 14, 2008).

17. *Shloss v. Sweeney*, 515 F. Supp. 2d 1068, 1077 (N.D. Cal. 2007).

18. *Shloss v. Sweeney* at 1079.

19. *Shloss v. Sweeney* at 1080.

20. *Shloss v. Sweeney* at 1081.

21. At the hearing, the attorney for the Joyce Estate stated: "Your Honor, certainly negotiating a covenant is something that the Estate has considered. . . . [I]t doesn't seem that the Estate should have to give that covenant. That doesn't mean it won't." Transcript of Proceedings Before the Honorable James Ware, January 31, 2007, 17.

22. A copy of the Settlement Agreement, signed by the parties on March 16 and 19, 2007, may be found at http://cyberlaw.stanford.edu/node/5045 (last visited Oct. 14, 2008).

23. 5 F. Supp. 182 (S.D.N.Y. 1933).

24. *United States v. One Book Entitled Ulysses by James Joyce*, 72 F.2d 705 (2d Cir. 1934).

25. See generally Robert C. Ellickson, *Order Without Law: How Neighbors Settle Disputes* (Cambridge, Massachusetts: Harvard University Press, 1991).

26. The text of the Roth consent decree, dated December 27, 1928, is reproduced at pages 185–86 of *Letters of James Joyce*, vol. III, ed. Richard Ellmann (New York: Viking Press, 1966). Cited hereafter as *Letters III*.

27. James Joyce, "An Address to the Fifteenth International P.E.N. Congress" (1937), reprinted in *The Critical Writings of James Joyce*, ed. Ellsworth Mason and Richard Ellmann (New York: Viking Press, 1959), 274–75.

28. The text of the international protest, dated February 2, 1927, is reproduced at pages 151–53 of *Letters III*.

29. The "courtesy copyright" that grew up around *Ulysses* is discussed in Spoo, "Copyright Protectionism," 656–59.

30. See 17 U.S.C. § 505.

31. *Shloss v. Sweeney*, 515 F. Supp. 2d 1083, 1086 (N.D. Cal. 2007).

32. *Shloss v. Sweeney* at 1085–86.