Archival Foreclosure: A Scholar's Lawsuit Against the Estate of James Joyce

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Abstract

The increasing scope and duration of copyright protection have had a noticeable impact on archive-based scholarship. More than a few literary estates have hampered scholars' efforts to quote from important documents freely accessible to the public in libraries but not fully usable in published scholarship due to copyright restraints. This paper tells the story of one scholar who fought back by suing the Estate of James Joyce for a judicial declaration that what she planned to do with archival materials was fair use and what the Joyce Estate had been doing to interfere with scholarship was copyright misuse.

Some may view administrative fees or other exactions that libraries and archives demand for scholarly use of the materials they hold physically hostage as a sort of ransom. Despite this colorful, tongue-in-cheek kidnap metaphor, I have not found this issue particularly troublesome. In my experience, scholars and clients do not encounter extortion by the holders of the physical documents. Rather they face extortion or even downright foreclosure by the holders of the intellectual property embodied in those documents—particularly when authors born in the latter part of the nineteenth century or later created the documents, which, therefore, are still potentially protected by copyright.

We witnessed this problem in an acute form in the lawsuit brought by J. D. Salinger against his biographer, Ian Hamilton, and Random House in the 1980s—a case that struck fear in the hearts of many scholars and publishers. There, recipients of unpublished letters from Salinger, or their representatives,

This essay is an elaboration of remarks prepared for the panel entitled "Archival Extortion" at the 2007 Annual Meeting of the Society of American Archivists. The panel examined the limits of physical and copyright ownership. The phrase "archival extortion" does not exactly capture the problem that I will discuss here. Additional material may be found in Robert Spoo, "Litigating the Right to Be a Scholar," forthcoming in *Joyce Studies Annual* (2008).

had donated the letters to university libraries. Neither the recipients nor the libraries were the obstacle (though the libraries' permission forms were a minor issue in the case).[1] Instead, Salinger, the holder of the intangible property rights in the letters, sued the biographer and the publisher, and wielded the blunt instrument of copyright to protect his privacy. Hamilton tried to avoid infringement through paraphrase but found that, as a conscientious and sensitive literary biographer, he could not entirely forgo his subject's rich epistolary expression. After a fair-use victory in the trial court, the court of appeals reversed and held that Hamilton had infringed Salinger's copyright.

That is the chilling paradigm case: a scholar's need to quote from important documents freely accessible to the public but not fully usable in published scholarship. Changes in the copyright law, here and abroad, have contributed to the aggressiveness of copyright owners. The expansion of copyrights, both in scope and duration, leads many to question whether this law, which 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,[2] 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.

Both fair use and copyright misuse were centerpieces of the lawsuit brought in 2006 by Professor Carol Loeb Shloss of Stanford University against the Estate of James Joyce. Like Ian Hamilton, Professor Shloss spent years researching her subject—the sparsely documented life of James Joyce's troubled daughter, Lucia—only to be told by James Joyce's grandson, Stephen James Joyce, that she was forbidden to quote anything by Lucia, her father, or any other Joyce family member. Nearly all of the documents that the Joyce Estate declared off-limits to Professor Shloss and other scholars are either already published or held in collections generally open to the public. These documents are not "private" in

[1] See *Salinger v. Random House, Inc.*, 811 F.2d 90 (2d Cir. 1987).

[2] 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" (30 August 2004), available at http://www.engadget.com/2004/08/30/the-engadget-interview-jack-valenti/, accessed 6 October 2007. 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 describes in the interview is permitted by a provision entirely *separate* from the fair-use provision: Section 110 (Exemption of Certain Performances and Displays).

the sense that they are physically or legally inaccessible. Scholars can learn any of their secrets; they just can't safely quote their findings in articles and books or on the Internet. They can kiss but not tell. And their silence is enforced through the climate of fear that many copyright holders have cultivated over the past two or three decades—decades during which it has been brought home, as never before, how "propertized" the still-copyrighted field of modernism really is.[3]

Professor Shloss finally published her biography, *Lucia Joyce: To Dance in the Wake,* with Farrar Straus & Giroux in 2003, but not before she and her publisher cut numerous quotations after receiving threats from the estate. In an attempt to offer an uncut version, Professor Shloss informed the Joyce Estate in 2005 that she planned to launch a website containing material removed from the book. The estate replied, predictably, that this would constitute copyright infringement, and forbade the project. Professor Shloss then engaged my legal services and those of the Stanford Center for Internet and Society and filed a lawsuit against the estate.

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. For years, her research on Lucia Joyce had been hampered by opposition from the Joyce Estate. After all, she chose a subject consistently at the heart of the estate's demand for privacy—a strange sort of demand, it must be said, made on behalf of deceased persons, concerning documents residing in public archives, and to be enforced through the ill-fitting machinery of copyright law. The estate's opposition first took the form of 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.[4] These letters became important evidence in the lawsuit. The letter-writing and other conduct alleged in Professor Shloss's Complaint—including allegations that the estate or its intermediaries had attempted to interfere with her physical access to certain archival materials and to prohibit her from

[3] Paul K. Saint-Amour describes modernism as "that which is still propertized." Paul K. Saint-Amour, review of *The Economic Structure of Intellectual Property Law,* by William M. Landes and Richard Posner, *Modernism/modernity* 12 (2005): 511.

[4] See Professor Shloss's Amended Complaint against Seán Sweeney and the Estate of James Joyce, ¶¶ 15–16, 47–63, 79–84, at http://cyberlaw.stanford.edu/system/files/Amended+Complaint+Final%5B1%5D.doc, accessed 6 October 2007.

quoting from Lucia Joyce's medical records, over which the estate holds no copyright[5]—these allegations and others formed the bedrock factual contentions in the case. Of course, the price of having a factually rich case is having 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 cannot recover for pain and suffering; nor can a plaintiff like Professor Shloss, who simply sought an injunction to prevent *future* pain and a declaration that she had a right to be the kind of scholar that she had been trained to be. In fact, Professor Shloss might have added 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 the lawsuit. Being a litigant is not easy, 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; on either side of the "v.," plaintiff and defendant suffer psychological strain and know that a smart adversary is working hard to make their 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 the motivations of her lawsuit. It asserted in court papers that her lawyers were seeking "to air their views and test their theories in a public forum."[6] 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.[7] All of this was tough on our client, and my hat has been off to her since she took the step of suing.

[5] See Shloss Amended Complaint, ¶¶ 48, 53.

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

[7] 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.

The Lawsuit

Professor Shloss's Complaint, which named the Joyce Estate and its trustee Seán Sweeney as defendants, was filed close to 16 June (what Joyceans call "Bloomsday") 2006 in the federal court for the Northern District of California.[8] Many learned of it from a *New Yorker* article about Stephen James Joyce by D. T. Max.[9] 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. We made that decision because a U.S. court would be reluctant to entertain 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 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.[10]

Once the estate had secured representation by the Los Angeles office of Jones Day, we engaged with them in a lengthy discussion of preliminary issues: personal jurisdiction over the estate and Mr. Sweeney, scheduling, possible settlement, and so on. In November 2006, the estate first made a significant move by filing a motion to dismiss Professor Shloss's lawsuit in its entirety. In addition, 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 it had engaged in copyright misuse and that the 1922 *Ulysses* is in the public domain in the United States.

The estate's motion asserted that Professor Shloss had no real and reasonable fear, then or ever, of being sued by the Joyce Estate for copyright infringement. As strange as that sounded to those who knew anything of the facts, we had to treat

[8] The Complaint was docketed as case number CV 06-3718.

[9] D. T. Max, "The Injustice Collector: Is James Joyce's Grandson Suppressing Scholarship?," *The New Yorker* 82, 19 June 2006, 34–43.

[10] 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.

the argument as a serious one, because federal law does not permit a United States court to entertain a lawsuit unless a genuine, concrete dispute exists 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.

We 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."[11]

In a nineteen-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."[12] The court pointedly remarked that "[t]his case is not a mere " 'academic' war" or a " 'hypothetical' case," as [the estate asserts]."[13] 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."[14] Professor Shloss had also properly alleged, Judge Ware said, copyright misuse "based on [the estate's] actions vis-a-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.[15] 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 99 percent of the estate's combined motions. This set the stage for settlement.

[11] These statements by Mr. Joyce appear in his letter to Professor Shloss, dated 8 August 2003, and his letter to Leon Friedman, an attorney for Farrar Straus and Giroux, dated 21 November 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., accessed 6 October 2007.

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

[13] *Shloss v. Sweeney*, at 1079.

[14] *Shloss v. Sweeney*, at 1080.

[15] *Shloss v. Sweeney*, at 1081.

Settlement

Professor Shloss never wished to settle her lawsuit; the estate's actions in the case triggered settlement. 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.[16] Later, the estate made this intention even clearer. A covenant is a formal, binding promise. If the estate had 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 a genuine dispute no longer exists 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,[17] but she can also reproduce it in print form within the United States—something she did not ask for in her Complaint.[18]

Some were puzzled that this case did not go to a final judgment and create a legal 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 has not generated a major public legal decision like Judge John M. Woolsey's famous opinion in *United States v. One Book Entitled* Ulysses.[19] 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,[20] 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.[21] A Texas publisher in

[16] 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, 31 January 2007, 17.

[17] Found at http://www.lucia-the-authors-cut.info/, accessed 24 June 2008.

[18] A copy of the Settlement Agreement, signed by the parties on 16 and 19 March 2007, may be found at http://cyberlaw.stanford.edu/system/files/Shloss+Settlement+Agreement.pdf, accessed 6 October 2007.

[19] 5 F. Supp. 182 (S.D.N.Y. 1933). The Shloss case has, however, produced potentially significant published precedent on copyright misuse and attorneys' fees, as discussed herein.

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

[21] See generally Robert C. Ellickson, *Order Without Law: How Neighbors Settle Disputes* (Cambridge, Mass.: Harvard University Press, 1991).

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 Professor Shloss's 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. A lawsuit as right and resonant as *Shloss v. Estate of James Joyce* may have a long career of practical, 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 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."[22] So we moved for fees, and on 30 May 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."[23] 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.[24]

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, the opinion has been officially published in an official legal reporter. Bear in mind that Judge Ware has ruled on the *fact* of fees; the parties still have to litigate the *amount* of fees.[25]

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.

[22] See 17 U.S.C. § 505.

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

[24] *Shloss v. Sweeney*, at 1085–86.

[25] As of this writing, the court is considering Professor Shloss's motion for a clarification of certain points in Judge Ware's order regarding attorneys' fees.