



The Making-Available Right and the *Barker* Case: Improving the Rationale for a Sound Result

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Electra Entertainment Group, Inc. v. Barker is a lawsuit alleging that the defendant used the file-sharing program KaZaA to infringe copyrights in popular music. Recently, a federal court in the Southern District of New York released a decision that denied the *Barker* defendant's motion to dismiss the complaint.¹ This ruling in *Barker* centers on an extremely important question: Does the unauthorized "sharing" or "making available" of a copyrighted file on a public file-sharing network infringe the exclusive rights of a U.S. copyright owner? Many thought that *Barker's* ruling on this question might be definitive. But *Barker* turned out to be a rather equivocal ruling.

On one hand, *Barker* holds that an unauthorized "offer to distribute" can infringe the existing exclusive rights of a copyright owner, and it also holds that Plaintiffs can plead that the Defendant made such an offer by having audio files in her KaZaA shared folder. *Barker* thus offers little solace to any users of share-downloaded-files-by-default file-sharing programs like KaZaA, LimeWire, or uTorrent.

On the other, *Barker's* dicta states that "the Court hesitates in equating this avenue of liability with the with the contourless 'make available' right proposed by Plaintiff." *Barker* tries to effectuate this hesitation by holding that the sharing or making-available of a file infringes copyrights only if the file is shared or made-available "for purposes of further distribution." *Barker* may thus imply that while you do infringe by unauthorized "sharing" that makes a file available to one or two hundred thousand strangers who use KaZaA, you might not infringe by posting the same file on a web server so it is indexed and made available to about a billion strangers. This seems like a strange result.

Ordinarily, it might be premature to react to a ruling like that in *Barker*. After all, it denies of one of the most preliminary of motions—a motion to dismiss the complaint. Rulings on such motions are usually cursory, and they rarely reflect the command of the relevant facts and law that courts (and parties) acquire as a case progresses. In short, even if *Barker's* rationale is troubling, its result is not, and the *Barker* Court will have

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¹ Case No. 05-CV-7340 (KMK), 2008 U.S. Dist. LEXIS 25913 (Mar. 31, 2008).

many chances to refine its initial ruling. Nevertheless, for two reasons, the *Barker* decision warrants detailed analysis.

First, questions about whether U.S. copyright law provides a making-available right have serious international implications. *Barker* and three other recent decisions question whether users of file-sharing programs infringe U.S. copyrights by “sharing” or “making available” copyrighted files.² *Barker* treats the making-available right as if it were a radical, suspect notion—the “contourless “make available” right proposed by Plaintiff.”³ In fact, this “contourless” right is an explicit international norm for copyright protection—a norm to which at least 64 nations, including the United States, the European Union (the EU) and most other developed nations, have long acceded.

This norm was developed in the mid-1990s, when the U.S. and the EU led an international effort to develop Internet-age norms for international copyright protection. As a result, the World Intellectual Property Organization (“WIPO”) promulgated two treaties, the WIPO Copyright Treaty (the “WCT”), and the WIPO Performances and Phonograms Treaty (the “WPPT”). Both require signatories to provide copyright owners with a making-available right. For example, Article 8 of the WCT states:

[A]uthors of literary and artistic works shall enjoy the exclusive right of authorizing any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them.

The United States helped develop this “making-available” right. Indeed, WIPO called it a “making-available right” to ensure that countries like the United States could implement this obligation through their already-broad distribution rights.

During the last 10 years, the United States has acceded to *eight* international agreements that require the U.S. to provide a making-available right. These eight agreements were implemented through *seven* enacted statutes in which the President and the Congress—advised by the relevant expert agencies—concluded that existing U.S. law *did provide* this right. So the making-available right is not just one “proposed by Plaintiff.” It is one that seven U.S. statutes find that Plaintiff possesses. Cases like

² Two of these three decisions are very preliminary. *London-Sire Records, Inc. v. Doe 1*, No. 04cv12434-NG (D. Mass. March 31, 2008) discussed potential problems with a making-available claim when assessing Plaintiff’s ability to prove actionable harm during a five-factor balancing test used to rule on a motion to quash. *Atlantic Recording Corp. v. Brennan*, Civ. No. 3:07cv232(JBA), 2008 U.S. Dist. LEXIS 23801, *7 (D. Conn. Feb. 13, 2008) denied a motion for a default judgment because a “potential” defense asserting that Plaintiffs lacked a making available right would suffice to preclude entry of default “even if not ‘ultimately persuasive at this stage.’” The third decision, *Atlantic Recording Corp. v. Howell*, No. CV-06-02076-PHX-NVW, 2008 U.S. Dist. LEXIS 35284 (D. Ariz. Apr. 29, 2008), denied Plaintiffs’ motion for summary judgment in a stunningly result-driven decision that critiques and virtually overrules three Ninth Circuit decisions. When they raise arguments not addressed more fully in *Barker*, this paper will address arguments raised in *London-Sire*, *Brennan*, and *Howell*.

³ *Barker*, 2008 U.S. Dist. LEXIS 25913 at *24.

Barker thus raise serious questions about U.S. compliance with international law and the good faith or competence of the Executive and Legislative Branches of its government.

Second, cases like *Barker* can affect far more than just the international relations of the United States. Regrettably, copyright infringement is just one of the many illegal activities facilitated by piracy-adapted file-sharing programs and networks. For example, the architecture that made some file-sharing networks attractive venues for copyright infringers also made them attractive to distributors of malicious programs⁴ and to pedophiles who “share” child pornography. For example, as of April of 2008, the Lexis database includes over fifty reported cases involving such “sharing” of child pornography, and many similar cases may soon confront more courts. Such cases often involve very dangerous members of the file-sharing “community.”⁵

And make no mistake: these child-pornography cases may have the same root cause as *Barker*—copyright infringement. Distributors of file-sharing programs could always have kept pedophiles from exploiting their networks. For example, they could have (1) actually enforced real “zero-tolerance” policies against users who share child pornography; (2) used notice-and-takedown systems to deter the sharing of child pornography; or (3) used more sophisticated versions of the file-hashing algorithms that they already use to ensure that no user could share any known child pornography.⁶ Nevertheless, some distributors chose not to take such measures.

The distributors themselves can explain why, but one explanation suggests itself. Courts have found that distributors of many file-sharing programs intended to

⁴ See, e.g., Stevie Smith, *McAfee Uncovers Significant P2P Media-File Attack*, THE TECHHERALD (May 12, 2008) <http://www.thetechherald.com/article.php/200820/954>.

⁵ These cases often involve truly abhorrent files, conduct, and defendants. See *United States v. Park*, 4:06CR3097, 2008 U.S. Dist. LEXIS 19688, (D. Neb. March 13, 2008); *State v. McKinney*, 699 N.W.2d 460, 464, 468 (S.D. 2005); *Zaratti v. State*, No. 01-04-01019-CR, 2006 Tex. App. LEXIS 7828 (Tex. Ct. App. 2006); *United States v. O'Rourke*, CR-05-1126-PHX-DGC, 2006 U.S. Dist. LEXIS 1044 (D. Ariz. Jan. 12, 2006); *United States v. Postel*, 524 F. Supp.2d 1120, 1123 (N.D. Iowa 2006); *United States v. Cartier*, Case No. 2:06-cr-73, 2007 U.S. Dist. LEXIS (D.N.D. Sept. 14, 2007).

⁶ P2P-based discontinuation of service-based, notice-and-takedown-based, or filtering-based solutions to child pornography on file-sharing networks are quite possible—unless program distributors choose to make them impossible. See Kristyn Maslog-Lewis, *Sharman Exec Calls Child Porn Unstoppable* (Dec. 9, 2004) (http://news.com.com/Sharman+exec+calls+child+porn+unstoppable/2100-1027_3-5486666.html) (reporting that KaZaA's alleged “zero-tolerance policy” for pedophiles was unenforced and unenforceable); *Universal Music Australia Pty Ltd v. Sharman License Holdings Ltd*, 2005 FCA 1242, *slip op.* at 82, 85 (Fed. Ct. of Australia Sept. 5, 2005) (same); Adam Fiske, *Route 183* (Feb. 16, 2008) (a former lead developer of LimeWire admits that LimeWire could have become “a p2p-enabled YouTube using DMCA [notice-and-takedown] protections”) <http://adamfisk.wordpress.com/2008/02/16/limewire-arista-riaa-deposition-recap/>; *MGM Studios, Inc. v. Grokster, Ltd.*, 518 F. Supp. 2d 1197, 1236-37 (C.D. Cal. 2007) (discussing filtering technologies). I have been told that some distributors actually have offered to implement file-hash-based filtering of images or videos known to encode child pornography, but law-enforcement agencies were unwilling or unable to disclose the file hashes of interest. If so, then further discussion seems warranted. I understand why law-enforcement agencies might be reluctant to disclose known child pornography file hashes to distributors of file-sharing programs, but important public benefits might flow from efforts to find some reasonable way to do so.

encourage and profit from infringing uses of their programs and networks.⁷ Unfortunately, measures that deter pedophiles from sharing obscene files could also deter the sharing of *infringing* files. So distributors could not adopt such measures if they wanted the “ability to get all the music” and “no product costs to acquire music.”⁸ As a result, child molestation, like multiple breaches of personal, corporate, national, and military security, may be just one more side effect of perpetuating copyright piracy.⁹

But whatever their causes, these design decisions will force many courts to decide whether the “sharing” or “making available” of various files violates federal law. In cases like *Barker*, the files shared were allegedly copyrighted, so courts must decide whether the sharing of such files violates the *civil* copyright act. In other cases, the files shared were child pornography, so courts must decide whether the sharing of such files violates *criminal* statutes that make it illegal to “distribute” child pornography.¹⁰

So far, courts adjudicating child-pornography cases have strongly tended to find that the sharing or making available such files “distributes” them. The Seventh Circuit held: “The notion that [defendant] could knowingly make his child pornography available for others to access and download without this qualifying as ‘distribution’ does not square with the plain meaning of the word.”¹¹ Another appellate court said, “We hold that ‘sharing’ child pornography files using peer-to-peer file-sharing software constitutes ‘distribution of child pornography....’”¹² The Tenth Circuit also rejected defendant’s claim “that he did not ‘distribute’ child pornography when he downloaded images and videos... and stored them in a shared folder on his computer accessible by other users of the network”:

[Defendant] may not have actively pushed pornography on Kazaa users, but he freely allowed them access to his computerized stash of images and videos and openly invited them to take, or download, those items. It is something akin to the owner of a self-serve gas station. The owner may not be present at the station,... [b]ut the owner has a roadside sign letting

⁷ *MGM Studios, Inc. v. Grokster*, 545 U.S. 913 (2005). To be clear, the problem of bad-actor service-providers affirmatively divesting themselves of control in order to try to avoid vicarious liability is only one of a larger set of issues relating to the online application of vicarious liability doctrines. Well-intentioned service providers, for example, might argue that they are reluctant to employ imperfect, but potentially useful, infringement-deterrence mechanisms because of the uncertainties surrounding the application of vicarious liability to mechanisms other than notice-and-takedown.

⁸ *MGM Studios, Inc. v. Grokster, Ltd.*, 454 F. Supp. 2d 966, 981 (C.D. Cal. 2006).

⁹ See Thomas D. Sydnor II, et al., *Filesharing Programs and “Technological Features to Induce Users to Share* (USPTO 2007) http://www.uspto.gov/web/offices/dcom/olia/copyright/oir_report_on_inadvertent_sharing_v1012.pdf.

¹⁰ Compare 17 U.S.C. § 106(3) with 18 U.S.C. §§ 2252-2252A.

¹¹ *United States v. Carani*, 492 F.3d 867, 876 (7th Cir. 2007); see also *United States v. Clawson*, 408 F.3d 556, 558 (8th Cir. 2005) (holding that “the ‘ordinary meaning’ of the term ‘distribute’ showed that defendant distributed child pornography to a minor by letting her know that it was stored in a place where she could retrieve it at will); *United States v. McVey*, 476 F. Supp.2d 560, 562 (E.D. Va. 2007) (interpreting distribution to “include acts such as posting material involving the sexual exploitation of a minor on a website for public viewing”); *State v. Perry*, 697 N.E.2d 624, 628 (Ohio 1998) (“Posting software on a bulletin board where others can access and download it is distribution.”).

¹² *United States v. Christy*, 65 M.J 657 (Army Ct. Crim. App. 2007).

all passersby know that, if they choose, they can stop and fill their cars for themselves.... [W]e do not doubt for a moment that the gas station owner is in the business of “distributing” ... gasoline.¹³

Consequently, decisions about whether the “sharing” or “making available” of copyrighted files infringes express *civil* rights to authorize public distribution of works will be highly relevant to courts interpreting *criminal* statutes that contain similar language.

Cases like *Barker* thus have important domestic and international implications. This paper argues that courts should reject the narrowing constructions in *Barker* and instead hold that both law and policy show that copyright owners do, and should, have a making-available right—and that prosecutors do, and should, have the power to imprison pedophiles who “share” violent child pornography.

I. Law: Defendant Barker Infringed Plaintiffs’ Copyrights If She Made Their Works Available over a File-Sharing Network.

Courts should hold that the existing exclusive rights granted by the U.S. Copyright Act do include a “making-available” right that is infringed by the unauthorized “sharing” of copyrighted works over file-sharing networks. To determine whether the Copyright Act grants such a right, courts must determine whether “sharing” files on a file-sharing network like KaZaA infringes one or more of “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 on the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) ... to perform the copyrighted work publicly;
- (5) ... to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.¹⁴

¹³ *United State v. Shaffer*, 472 F.3d 1219, 1220, 1223 (10th Cir. 2007); see *United States v. Griffin*, 482 F.3d 1008, 1011 (8th Cir. 2007) (noting that the “government asserted that [defendant’s] use of KaZaA with knowledge of its capabilities constituted distribution” and affirming the finding that defendant “distributed child pornography by making images of child pornography available to others via [KaZaA].); *United States v. Darway*, No. 06-4077, 2007 Fed. App. 0789N (6th Cir. 2007) (finding “without merit” defendant’s claim “that there is a legal distinction between merely making material available to others and affirmatively distributing such material”); *United States v. Postel*, 524 F. Supp.2d 1120, 1125 (N.D. Iowa 2006) (“Defendant also intended to ... distribute child pornography to others by offering his collection ... to the public ... via the LimeWire computer program.”); *United States v. Abraham*, Cr. No. 05-344, 2006 U.S. Dist. LEXIS 81006 (W.D. Pa. 2006) (holding that the “ordinary meaning” of “distribute” and “distribution” indicated that defendant distributed child pornography by using BearShare “to make the movie image at issue available to other users on the Gnutella network”).

¹⁴ 17 U.S.C. § 106.

While this paper will focus on a particular exclusive right—the right “to do or to authorize” distribution of works to the public—much of its reasoning could also apply as to other rights, particularly the exclusive rights “to do or to authorize” reproduction, performance, or display. For three reasons, courts should conclude that these existing U.S. exclusive rights provide a making-available right.

First, the plain meaning of the statutory term “to authorize” indicates that KaZaA users “authorize” the distribution of copyrighted files by placing them in a “share folder” where they will be automatically fingerprinted; catalogued in a remote database by name, metadata, and fingerprint; and made available to many thousands of strangers for on-demand downloading.

Second, as the child-pornography cases indicate, the “sharing” or making available of files by users of file-sharing programs not only “authorizes” distribution, the plain meaning of words like “distribute” and “distribution” also shows that it is a critical part of the distribution process itself.

Third, principles of statutory construction require courts to adopt permissible constructions of the Copyright Act that provide a making-available right. Only such constructions respect the 204-year-old principle that “an act of congress ought never to be construed to violate the law of nations if any other possible construction remains”¹⁵ and the principle that courts will defer to the political Branches of the government when they enact legislation implementing the international obligations of the United States.

Granted, cases like *Barker* might seem to raise fairly novel questions about whether these interpretive principles apply when Congress and the President interpret a previously existing statute (like the Copyright Act of 1976) in order to implement subsequent international agreements (like the 1996 WIPO Copyright Treaty). But such questions are neither novel nor difficult. Indeed, they were, in effect, resolved nearly 25 years ago in *Chevron U.S.A., Inc. v. Natural Resources Defense Council, Inc.*¹⁶ Courts will—and should—defer to reasonable statutory interpretations that the Executive and Legislative Branches adopt when they use formal law-making processes to implement international agreements concluded under the Treaty and Foreign-Commerce Powers conferred by the Constitution.

A. “Sharing” Files on a File-Sharing Network or Posting Them on a Website “Authorizes” Their Distribution to the Public.

Section 106 of the Copyright Act gives copyright owners the exclusive right “to authorize” the reproduction or distribution of their works. Ordinarily, one who “authorizes” others to act “*permit[s]* a thing to be done in the future.”¹⁷ A user of file-

¹⁵ *Murray v. Charming Betsy*, 6 U.S. (2 Cranch) 64 (1804).

¹⁶ 467 U.S. 837 (1984).

¹⁷ BLACK’S LAW DICTIONARY 169 (rev. 4th ed. 1968); accord WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 147 (1993) (defining “authorize” as “endowing formally with a power or right to act, *usu. with*

sharing software who downloads or places a file in their shared folder sends the following message to several remote databases: “I have file X, here is the content it encodes and the data you need to find it on my computer and copy it onto yours.” This “authorizes” others to download that file—and it does so regardless of whether others later exercise the discretionary privilege thus granted.

Nevertheless, *Barker* argued that the “sharing” or “making” available of files does not infringe copyright owners’ exclusive rights “to authorize” the reproduction and distribution of their works. *Barker* noted that a sentence in the Committee Reports on the Copyright Act of 1976 stated, “Use of the phrase “to authorize” is intended to avoid any questions as to the liability of contributory infringers.” This sentence led *Barker* to conclude that when Congress expressed its intent for “authorize” to *include* contributory infringers, it thus implied intent to *exclude* all other classes of cases otherwise within the ordinary meaning of “authorize”—including cases in which infringing acts were authorized, but perhaps not completed.¹⁸

Barker’s interpretation of “to authorize” impermissibly constricts its ordinary meaning. For example, imagine two cases in which Person A performs the same act. In one case, Person A authorizes Person B to infringe, and we know that Person B later performed the authorized infringing act. In this case, contributory can attach, so *Barker* argues that this case falls within the intended scope of the statutory term “authorize.” But suppose Person A authorizes Person B to infringe and we do not know whether Person B later performed the authorized infringing act. In this case, contributory liability would not attach, so *Barker* argues that this case falls beyond the intended scope of the statutory term “authorize.” So the same act of Person A both does and does not “authorize”—depending upon what is known about the subsequent acts of third parties.¹⁹ Even courts adopting this interpretation of “authorize” admit that they reject its ordinary or plain meaning.²⁰

While *Barker* is not the first case to adopt this interpretation of “authorize,” the other usual “supporting” precedents are very weak. For example, in *Venegas-Hernandez v. Asociacion de Compositores Y Editores De Musica Latinoamericana*, the First Circuit chose to interpret “authorize” narrowly, (rather than normally), because it thought that nothing important turned on its choice.²¹ In *Subafilms, Ltd. v. MGM-Pathe Comm. Co.*, Ninth Circuit *dicta* suggested a similarly narrow construction, but *Subafilms* actual held

discretionary privileges”); *id.* at 146; *County of Washington v. Gunther*, 452 U.S. 161, 169 & n.9 (1981) (citing the Black’s and Webster’s definitions of “authorize” to interpret the statutory term “authorize”).

¹⁸ *Barker*, 2008 U.S. Dist. LEXIS 25913 at *32-36.

¹⁹ *Latin American Music Co. v. Archdiocese of San Juan of the Roman Catholic & Apostolic Church*, 499 F.3d 32, 34-35 (1st Cir. 2007) (“to prove infringement [under *Venegas*] a claimant must show an ‘infringing act after the authorization’”).

²⁰ *Venegas-Hernandez v. Asociacion de Compositores Y Editores De Musica Latinoamericana*, 424 F.3d 50, 57 (1st Cir. 2005) (“Looking only at the statutory language, one might well think that authorization alone could well be infringement.”); *id.* (“the authorizing person could (as a matter of language) be treated as an infringer subject to statutory damages even if no infringing act ... actually occurred”); *id.* at 58 (“Admittedly, the better bare-language reading would allow the claims in question....”).

²¹ *Id.* at 59.

that you cannot infringe if you “authorize” *noninfringing* acts—and it reserved the question of whether “liability might attach when a party authorizes an act that *could* constitute infringement, but the ‘attempted’ infringement fails.”²² When the Ninth Circuit answered that question, it twice concluded that users of file-sharing programs who share files infringe the distribution right.²³

In any case, the validity of such narrowing interpretations turns on whether courts can reasonably infer that Congress intended for them to adopt such a strained interpretations from the source cited in *Barker*, and *Venegas*—from one sentence of legislative history construed in isolation. For five reasons, they cannot: Doing so relentlessly confounds Supreme Court holdings, ordinary principles of statutory interpretation, the expressed intent of Congress, and context.²⁴

First, this narrowing construction conflicts with a Supreme Court decision. *New York Times Co. v. Tasini* held that certain publishers infringed copyrights because, *inter alia*, “[they], through contracts licensing the production of copies in the Databases, ‘authorize’ reproduction and distribution of the Articles.”²⁵ While such acts alone would not have made these publishers contributorily or vicariously liable, they showed direct infringements of the exclusive rights to “authorize” reproduction and distribution.

Second, even absent *Tasini*, courts usually cannot use legislative history to narrow the ordinary meaning of a statutory term: “[I]n interpreting a statute a court should always turn first to one, cardinal canon before all others. We have stated time and again that courts must presume that a legislature says in a statute what it means and means in a statute what it says there.”²⁶ This “cardinal canon” matters *only* if a statute’s legislative

²² *Subafilms, Ltd. v. MGM-Pathe Comm. Co.*, 24 F.3d 1088, 1094 n. 8 (9th Cir. 1994) (en banc). Several cases have analyzed and rejected *Subafilms dicta* construction of “authorize.” See *Curb v. MCA Records, Inc.*, 898 F. Supp. 586 (M.D. Tenn. 1995); *Expeditors Int’l v. Direct Line Cargo Mgmt. Servs.*, 995 F. Supp. 468 (D.N.J. 1998). *Barker* dismisses these cases as “*sui generis*” because they involved domestic “authorization” of potentially infringing acts that were performed overseas. See *Barker*, 2008 U.S. Dist. LEXIS 25913 at *35. But they are no more “*sui generis*” than *Subafilms*: It involved the same basic fact pattern, but reached a different result.

²³ *Perfect 10, Inc. v. Google, Inc.*, 508 F.3d 1146, 1162 (9th Cir. 2007) (“distribution rights ...were infringed by Napster users ... when they used the Napster software to make their collections available to all other Napster users”); *A&M Records v. Napster, Inc.*, 239 F.3d 1004, 1014 (9th Cir. 2001)(“Napster users who upload file names to the search index for others violate plaintiffs’ distribution rights.”) (*cited in Barker*, 2008 U.S. Dist. LEXIS 25913 at *26).

²⁴ See, e.g., *Curb v. MCA Records, Inc.*, 898 F. Supp. 586, 593-94 (M.D. Tenn. 1995) (holding that an interpretation of “authorize” that ties “the authorization right solely to a claim of justiciable contributory infringement appears contrary both to well-reasoned precedent, statutory text, and legislative history”).

²⁵ 533 U.S. 483, 498 (2001). The language quoted from *Tasini* is not *dicta*, though it is one of several alternative bases for finding a direct infringement. See also *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 435 n.17 (1984) (“an infringer is not merely one who uses a work without authorization by the copyright owner, but also one who authorizes the use of a copyrighted work without actual authority from the copyright owner”) (*dicta*).

²⁶ *Connecticut Nat. Bank v. Germain*, 503 U.S. 249, 253-54 (1992); see *Ardestani v. INS*, 502 U.S. 129, 135-36 (1991) (the “‘strong presumption’ that the plain meaning of the statute expresses congressional intent is rebutted only in the ‘rare and exceptional circumstances’ ... when a contrary legislative intent is clearly expressed”) (citations omitted); see also *Whitfield v. Hall*, 543 U.S. 209, 215 (2004).

history could fairly suggest a narrower or broader interpretation: “[I]f the statutory text and legislative history are consistent, this primary rule is unnecessary because the result will be the same regardless of whether a court follows the rule or not. Therefore, the primary rule matters only where there is a contradiction between statutory text and the legislative history.”²⁷ Indeed, the very Committee Reports cited in *Barker* argue that Section 106 should be generously construed, and limited only by the text of the Act itself: “The approach of the bill is to set forth the copyright owner’s exclusive rights *in broad terms* in section 106, and then to provide various limitations, qualifications, or exemptions in the 12 sections that follow.”²⁸

Third, if courts could reject plain meaning *inarguably* contradicted by legislative history, they could not do so by finding “contradictions” not clearly presented.²⁹ But courts that narrow the meaning of “authorize” do just that. By quoting one sentence of a Committee Report, these courts ignore the preceding sentence and the example of “authorizing” liability in the next sentence:

The exclusive rights ... are “to do and to authorize” any of the activities specified in the five numbered clauses. Use of the phrase “to authorize” is intended to avoid any questions as to the liability of contributory infringers. For example, a person who lawfully acquires an authorized copy of a motion picture would be an infringer if he or she *engages in the business of renting it to others for purposes of unauthorized public performance*.³⁰

Anticipating *Tasini*, the Report illustrates “authorizing” liability through an example that *presumes neither a completed public performance nor a completed rental*. In other words, the Report means exactly what it says: The term “authorize” does “avoid any questions as to the liability of contributory infringers”—because its plain meaning encompasses traditional contributory infringers, traditional vicarious infringers, and even those who authorize infringing acts that may not subsequently occur.

Fourth, even if a lone, ambiguous and quickly contradicted sentence of legislative history *could* narrow the ordinary meaning of a statutory term, the sentence cited in *Subafilms*, *Venegas*, and *Barker* cannot do so. To divine narrowing intent from it, one must infer that when the Committee Report *expressed* intent for “authorize” to *include* contributory infringers, it thus *implied* intent to *exclude* all other classes of cases otherwise within the plain meaning of “authorize.” In other words, one must apply *expressio unius est exclusio alterius*—the doctrine asserting that words expressing intent to include *can* imply intent to exclude—to one sentence in a committee report.

²⁷ *Olden v. LaFarge Corp.*, 383 F.3d 495, 506 (6th Cir. 2004).

²⁸ H.R. Rep. 1476, 94th Cong. 2nd Sess. at 61; S. Rep. No. 94-493, 94th Cong. 1st Sess. at 57.

²⁹ See, e.g., *Consumer Product Safety Comm’n v. GTE Sylvania, Inc.*, 447 U.S. 102, 108 (1980) (unanimous opinion) (“Absent a clearly expressed legislative intention to the contrary” the plain meaning of statutory text “must ordinarily be regarded as conclusive.”); accord, *Ardestani v. INS*, 502 U.S. 129, 135 (1991).

³⁰ H.R. Rep. 1476, 94th Cong. 2nd Sess. at 61 (emphasis added).

At least twice, the Supreme Court has *unanimously* rejected attempts to deny a term its plain meaning by applying *expressio unius* to committee reports. In *Standefer v. United States*, the Court was “unwilling to ‘apply... [*expressio unius*] to the language employed in a *committee report*’” because this “would permit an omission in the legislative history to nullify the plain meaning of a statute.”³¹ In *Whitfield v. Hall*, the Court rejected a similar attempt: “It would be a strange canon of statutory construction that would require Congress to state in committee reports or elsewhere in its deliberations that which is obvious on the face of the statute.”³² Such holdings preclude courts from inferring implied intent to exclude from committee reports expressing intent “to set forth the copyright owner’s exclusive rights *in broad terms* in section 106, and then to provide various limitations, qualifications, or exemptions in the 12 sections that follow.”³³

Fifth, and finally, even if courts could deny statutory text its plain meaning by inferring implied exclusionary intent from ambiguous inclusory language in committee reports, they could not do so here. As one treatise notes, *expressio unius* is not really a “rule” or “canon” of statutory construction, but a way of concluding that implicit intent to exclude can be reasonably inferred from both text and context.³⁴ Here, context forecloses a narrowing interpretation of “authorize.” Indeed, it shows why Congress would give “authorize” its ordinary meaning, and, nevertheless, mention “contributory liability” in its committee reports.

In context, *Barker’s* narrowing interpretation of “authorize” fails because it proves too much: If the committee reports’ mention of “contributory liability,” signaled intent to exclude forms of liability not mentioned, then vicarious liability for infringement would also have been excluded. But it was not.³⁵ Moreover, context also explains why Congress used the term “authorize” in the Copyright Act of 1976, why it gave this term its ordinary meaning and why it still mentioned “contributory liability” (but not vicarious liability) in its Committee Report.

Congress first defined the all the exclusive rights granted by U.S. copyright law as rights “to do and to authorize” in the Copyright Act of 1976. One of the goals of that Act was to move U.S. copyright law toward the international norms for copyright protection set forth in the Berne Convention.³⁶

This explains why the Copyright Act of 1976 used the term “authorize” to define all of its exclusive rights. The Berne Convention has *always* used the word “authorize” to describe the scope of the exclusive rights of copyright owners: Its original text of 1886 requires that authors be granted “the exclusive right of making or authorizing the

³¹ *Standefer v. United States*, 447 U.S. 10, 20 n.12 (1980) (emphasis in original, citation omitted).

³² *Whitfield v. Hall*, 543 U.S. 209, 216 (2004) (citation omitted); *see also id.* (noting that the ordinary meaning of statutory text cannot be narrowed by “mere silence in the legislative history”).

³³ H.R. Rep. 1476, 94th Cong. 2nd Sess. at 61; S. Rep. No. 94-493, 94th Cong, 1st Sess. at 57.

³⁴ REED DICKERSON, *THE INTERPRETATION AND APPLICATION OF STATUTES* 234-35 (1975).

³⁵ *See, e.g., MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913, 930 (2005) (describing contributory and vicarious liability as “well established in the law”).

³⁶ H.R. Rep. 1476, 94th Cong. 2nd Sess. at 135-36 (noting that the Copyright Act of 1976 increased the term of copyright protection to that “required for adherence to the Berne Convention”).

translation of their works....” All subsequent versions of the Berne Convention consistently use the term “authorize” to describe the scope of other exclusive rights that signatories must provide – as do TRIPS and the WCT and WPPT. Because neither the Berne Convention nor any of the rest of these treaties defines “authorize,” they give the term its ordinary meaning.³⁷

Consequently, when the Copyright Act of 1976 defined its exclusive rights as rights “to do and to authorize,” it conformed the scope of U.S. exclusive rights to those required by the Berne Convention. Congress also confirmed that “authorize” in the Copyright Act has the ordinary meaning accorded by the Berne Convention when it concluded, in the Berne Convention Implementation Act of 1988, “The amendments made by this Act, *together with the law as it exists on the date of the enactment of this Act*, satisfy the obligations of the United States in adhering to the Berne Convention and no further rights or interests shall be created for that purpose.”³⁸ This statement could only be true if “authorize” had its ordinary meaning. Congress thus had good reason both to use the term “authorize” in the Copyright Act of 1976 and to give it its ordinary meaning.

Nevertheless, Congress also had good reason to mention “contributory liability” in its Committee Reports. Indeed, when the Committees mentioned “contributory liability” but not “vicarious liability,” this suggests that they intended “authorize” to have an unusually broad meaning. The right-or-ability-to-control trigger for vicarious liability ensures that the ordinary meaning of “authorize” readily encompasses such cases.³⁹ But contributory liability can be imposed far more broadly, as a result of any “personal conduct that encourages or assists the infringement.”⁴⁰ The Committees might thus have been concerned that “authorize” might be misconstrued to narrow or reject *Gershwin’s* then-emerging standard for contributory liability.

In summary, *Barker’s* narrow interpretation of “authorize” is simply impermissible—at every level of analysis. It overrules the Supreme Court. By inferring implied narrowing intent from ambiguous legislative history, it violates the first principle of statutory construction. It takes one sentence of a Committee Report out of context. It construes that isolated sentence by invoking the *expressio unius* doctrine that the Supreme Court has twice rejected unanimously. It also ignores the larger context that strongly refutes any claim that Congress intended to narrow the ordinary meaning of “to authorize.”

Moreover, even were *Barker’s* unnatural narrowing construction of “authorize” permissible, it alone could not deny copyright holders a making-available right. Even if only the term “distribute” is given its ordinary meaning, then the Copyright Act provides a making-available right.

³⁷ See VIENNA CONVENTION ON THE LAW OF TREATIES, Art. 31 (1969).

³⁸ Pub. Law 100-568, 102 Stat. 2853 (1988) (emphasis added).

³⁹ See *Gershwin Pub. Corp. v. Columbia Artists Management, Inc.*, 443 F.2d 1159, 1162 (2nd Cir. 1971) (test for vicarious liability).

⁴⁰ *A&M Records v. Napster, Inc.*, 239 F.3d 1004, 1020 (9th Cir. 2001); see also *Gershwin Pub. Corp. v. Columbia Artists Management, Inc.*, 443 F.2d 1159, 1162 (2nd Cir. 1971) (test for contributory liability requires culpable mental state and an act that “materially contributes” to another’s infringing acts).

B. Persons Making Copyrighted Files Available on File-Sharing Networks or a Website Infringe the Exclusive Right to “Distribute” Works to the Public.

Whenever the statutory term “distribute” is undefined, it has its plain or ordinary meaning. For example, in the child-pornography case *Shaffer*, the Court begins its analysis of whether a KaZaA user “distributes” files by “sharing” them by noting that the relevant provision of the Criminal Code “does not itself define the term ‘distribute,’ so we look to how the term is understood as a matter of plain meaning.”⁴¹ *Shaffer* then correctly concludes that the process of distributing anything would be understood to include steps prior to a final transfer. Similar reasoning has led courts construing the Copyright Act to find that acts like importing, indexing for public use, or making available on the Internet infringe the distribution right.⁴² For example, in *Playboy Ent., Inc. v. Chuckleberry Pub., Inc.*, the Southern District of New York held a defendant in contempt of an injunction prohibiting infringement because it made plaintiff’s works available on a web site to which U.S. customers had access.⁴³

Nevertheless, *Barker* distinguishes *Shaffer* by holding that “distribute” in the Copyright Act has a meaning *narrower* than its ordinary meaning.⁴⁴ *Barker* states, “[T]he definition of ‘distribute’ is *synonymous* with the [Copyright Act’s] definition of ‘publication.’”⁴⁵ *Barker* thus holds that all the elements of a “publication” must be plead: “[L]iability under Section 106(3) requires that Plaintiffs ... affirmatively plead that Defendant made an offer to distribute, and that the offer to distribute was for the purpose of further distribution, public performance or public display.”⁴⁶

As *Barker* notes, this requirement to plead and prove that works were made available “for purposes of further distribution” will not help users of file-sharing programs, like KaZaA, that “share” downloaded files by default.⁴⁷ But this requirement could be a problem for efforts to deter infringing uses of the web or FTP and IRC clients. In these

⁴¹ *United States v. Shaffer*, 472 F.3d 1219, 1223 (10th Cir. 2007).

⁴² See, e.g., *Palmer v. Braun*, 376 F.3d 1254, 1258 (11th Cir. 2004) (holding that importing 25 copies for subsequent sale infringes the Section 106(3) distribution right); *Hotaling v. Church of Jesus Christ of Latter-Day Saints*, 118 F.3d 199, 203 (4th Cir. 1997); see also *Perfect 10, Inc. v. Google, Inc.*, 508 F.3d 1146, 1162 (9th Cir. 2007) (“distribution rights ... were infringed by Napster users ... when they used the Napster software to make their collections available to all other Napster users”); *A&M Records v. Napster, Inc.*, 239 F.3d 1004, 1014 (9th Cir. 2001) (“Napster users who upload file names to the search index for others violate plaintiffs’ distribution rights.”); *Playboy Ent., Inc. v. Chuckleberry Pub., Inc.*, 939 F. Supp. 1032, 1039 (S.D.N.Y. 1996) (holding defendant in contempt of an injunction prohibiting infringement because making plaintiff’s works available on a web site infringed the distribution right); *Marobie-Fl, Inc. v. Nat’l Ass’n of Fire and Equip. Distribs. And Northwest Nexus, Inc.*, 983 F. Supp. 1167, 1173 (N.D. Ill. 1997) (holding that making files available on a website infringes the distribution right); *Playboy Ent., Inc. v. Russ Hardenburgh, Inc.*, 982 F. Supp. 503, 513 (N.D. Ohio 1997) (holding that making files available on a computerized bulletin-board service infringes the distribution right); *Playboy v. Frena*, 839 F. Supp. 1552, 1556 (M.D. Fla. 1993) (same).

⁴³ 939 F. Supp. 1032, 1039 (S.D.N.Y. 1996).

⁴⁴ *Barker*, 2008 U.S. Dist. LEXIS 25913 at *29 n.9.

⁴⁵ *Id.* at *26, *28 (emphasis added).

⁴⁶ *Id.* at *29; accord *id.* at *29 n.9.

⁴⁷ *Id.* at *29.

contexts, copyright enforcement under *Barker* might thus have to be heavily dependent upon federal *criminal* enforcement supported by wiretapping powers.

Consequently, it is important to note that a small change to *Barker's* interpretation of the relationship between the Copyright Act's distribution right and its definition of publication can avoid these problems and better accord with both statutory text and precedent. The Act's distribution right and its definition of "publication" are not *entirely* "synonymous"—the distribution right, while often similar, is broader.

For example, in *Harper & Row*, the Supreme Court did not equate "publication" and "distribution": It called "publication" a "subsidiary right"—that is, one subsumed within the broader exclusive right to distribute.⁴⁸ Recognizing publication as a "subsidiary right" clarifies the relationship between "publication" and distribution: Acts that constitute "publication" also constitute "distribution," but acts that do not constitute "publication" can still constitute "distribution."

Indeed, the very language cited in *Barker*—the "for purposes of further distribution" requirement in the Act's definition of "publication"—shows why publication is a narrower concept than distribution. Courts hold that the Copyright Act's definition of "publication" codifies the concept of "publication" that courts evolved through pre-1976 case law.⁴⁹ Consequently, while the Copyright Act of 1976 does not itself further define the phrase, "for purposes of further distribution," a large body of case law does. This phrase perpetuates a still-critical distinction that courts developed between "general" and "limited" publications.

Distinguishing "general" from "limited" publications lets courts ensure that getting a work commercially published need not tend to void its copyright. Before the 1976 Act—as in the few sections of the 1976 Act in which "publication" still appears—publication acted as "a dividing line between common law and statutory protection."⁵⁰ Before "publication," a work was protected by a perpetual, common-law state copyright; after "publication," a work was either protected by a statutory federal copyright, or (if formalities were not observed), deemed an unprotected public-domain work.

But then a problem arises: Ordinarily, you "publish" a work if you make copies of it available to a significant number of strangers. But to get a work "published" by a commercial publisher, new authors usually had to send review copies to a significant number of strangers at various publishing houses. So if an undiscovered author sent copies of her brilliant new book to various publishers, she might thus "publish" the work, void its copyright, and be deemed to have given it away for free.

⁴⁸ *Harper & Row, Pubs., Inc. v. Nation Ent.*, 471 U.S. 539, 549 (1985); see also Black's Law Dictionary 1469 (8th ed. 2004) (defining "subsidiary" as "subordinate").

⁴⁹ E.g., *John G. Danielson, Inc.*, 322 F.3d 26, 36 (1st Cir. 2003) (citing M.B. NIMMER & D. NIMMER, NIMMER ON COPYRIGHTS § 4.04, at 4-20 (2001)) *Atlantic Recording Corp. v. Howell*, No. CV-06-02076-PHX-NVW, 2008 U.S. Dist. LEXIS 35284 at *20 (Apr. 29, 2008).

⁵⁰ *Harper & Row, Pubs., Inc. v. Nation Ent.*, 471 U.S. 539, 552 (1985) (citation omitted).

To avoid this Catch-22, courts distinguished “general” publications—those that permitted further or indiscriminate distribution—from “limited” publications that restrained further distribution. A publication was considered “general” if the distributing party put no legal or practical restraint upon a potential recipient’s ability to further copy or redistribute the work.⁵¹ For example, in *American Visuals Corp. v. Holland*, the Second Circuit held that plaintiff lost his copyrights through general publication by “placing a number of copies in a hotel lobby for unsupervised distribution and a lack of restriction on recipients in their right to pass on copies to others.”⁵² Publications were thus for the “purpose” of further distribution unless the author imposed some legal or practical restraint on further distribution of distributed copies of the work. In the Copyright Act’s definition of “publication,” the phrase “for purposes of further distribution” preserves this distinction between “general” and “limited” publications. Consequently, “limited” publications do not constitute “publications”—even if they do involve distributing copies of the work to members of the public. That is why *Harper & Row* calls “publication” a “subsidiary” right subsumed within the broader distribution right.

Recognizing publication as a subsidiary right subsumed within a broader right to distribute also better respects ordinary principles of statutory construction and answers the objections to *Barker’s* analysis raised in cases like *London-Sire* and *Howell*. Congress defined “publication” in Section 101 of the Copyright Act, so if it had wanted in Section 106 to grant an exclusive right of “publication,” it could have done so explicitly. Because it did *not* do so, the meanings of “publication” and “distribute” must have been meant to differ: “[T]he fact that Congress has prescribed two different standards in the same Act certainly implies that it intended them to have significantly different meanings.”⁵³ Construing “publication” as a subsidiary right subsumed within the distribution right explains why Congress did not enact an exclusive right of publication in Section 106.

Moreover, it is also telling that Congress *removed* all express references to any analog of “publication” from the definition of the exclusive rights in the Copyright Act of 1976. That was a stark departure from prior practice: Previously, in every U.S. copyright act ever enacted—from the Copyright Act of 1790 through to the Copyright Act of 1909—Congress had used analogs of “publication” to define an exclusive right. As the Supreme Court noted in an analogous context, “The deliberate selection of language so differing from that used in the earlier Acts indicates that a change of law was intended.”⁵⁴ Indeed, the GENERAL GUIDE TO THE COPYRIGHT ACT OF 1976 published by the Copyright Office cites the following as one of the “primary advantages” of the then-new Act:

⁵¹ *American Visuals Corp. v. Holland*, 239 F.3d 740, 745 (2nd Cir. 1956).

⁵² See, e.g., *id.* at 744-45 (citing cases); see also *id.* at 744 (noting, however, that in borderline cases, courts should “treat the concept of ‘publication’ as to prevent piracy”).

⁵³ *INS v. Cardoza-Fonseca*, 480 U.S. 421, 448 (1987). This principle has particular significance under the Copyright Act because Sections 203 and 407 do refer to a “right of publication” or an “exclusive right of publication.” 17 U.S.C. §§ 203(a)(3), 407(a).

⁵⁴ *Brewster v. Gage*, 280 U.S. 327, 337 (1930)

Reduce the legal significance of “publication.”

The concept of “publication” is outdated; undue reliance on this concept has been one of the most serious defects with the Act of 1909.⁵⁵

Construing “publication” as a subsidiary right subsumed within the distribution right effectuates such congressional intent.

Finally, the preceding discussion not only clarifies the relationship between distribution and publication, it also shows why it should be easy for most plaintiffs to plead or prove that a particular offer to distribute was one made “for purposes of further distribution.” This requirement can be readily pleaded and proved in almost all Internet-related contexts because the classes of “offers to distribute” that are “for purposes of further distribution” are very broad.

As noted above, publications are deemed “general,” and thus for the “purpose” of further distribution, unless an author imposes some legal or practical restraint on further distribution of distributed copies of her work.⁵⁶ As a result, courts that equate distribution and publication still recognize a distribution right that will be implicated by virtually any use of the Internet, including distribution through file-sharing programs, web sites, or FTP programs.⁵⁷ In all such cases, the absence of any legal or practical restraint upon further copying and distribution of the work at issue should satisfy any applicable for-purposes-of-further-distribution requirement. Consequently, there is no good reason—either legal or practical—why questions about whether a given video file was “distributed” by someone who “shared” it or “made it available” through KaZaA should depend upon whether that video contained child pornography.

C. Courts Construing the Copyright Act Can Neither Dismiss Domestic and International Law as “Subsequent Legislative History” Nor Disregard Administrative Interpretations of the Act.

Even if courts construing the Copyright Act could reasonably adopt *Barker’s* narrowing interpretations of “authorize” and “distribute,” they would still have to acknowledge what *Venegas* repeatedly conceded: Broader interpretations of those terms would also be reasonable. At best, courts deciding whether the Copyright Act grants a making-available right are thus deciding whether to adopt a reasonable interpretation of the Act that would grant such a right or a reasonable interpretation of the Act that would deny such a right.

⁵⁵ Marybeth Peters, GENERAL GUIDE TO THE COPYRIGHT ACT OF 1976 2:1 (Copyright Office 1977); see also Copyright Office, *Supplementary Register’s Report on the General Revision of the U.S. Copyright Law*, 91 (1965) (noting that under the proposed revised Copyright Act “publication” “no longer has the paramount importance that attaches ... under the present law”).

⁵⁶ See *supra* n. 51 and accompanying text.

⁵⁷ See, e.g., *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, (S.D.N.Y. 2002) (“posting music files, software or phonographs on a webpage.... has been held in numerous instances to constitute publication”).

To its credit, *Barker* is the only one of the four recent decisions questioning or denying whether U.S. law provides a making-available right that acknowledges the full implications of such a holding. In a footnote, *Barker* claims that courts deciding whether the Copyright Act confers a making-available right neither can nor should consider a simple fact: If the Copyright Act does not grant such a right, then the United States would be violating at least eight international agreements—two treaties and six Free Trade Agreements (FTAs)—that it has purportedly implemented. *Barker* dismisses these eight agreements and their seven implementing statutes as irrelevant “subsequent legislative history.” It also denies that the “opinion” of the Copyright Office “should influence the Court’s interpretation of Section 106(3) [of the Copyright Act].”⁵⁸

Here again, *Barker* errs. When possible, courts interpret statutes so as to avoid conflicts with the international obligations of the United States. For example, in *Lauritzen v. Larsen*, the Supreme Court interpreted a statute according to “the long-headed admonition of Mr. Chief Justice Marshall that ‘an act of congress ought never to be construed to violate the law of nations if any other possible construction remains.’”⁵⁹ Courts recognize that Congress and the President can decide to enact statutes that violate international agreements.⁶⁰ But such decisions can severely disrupt international trade and trigger retaliation. Consequently, courts will, when possible, construe U.S. statutes to accord with U.S. international obligations:

For us to run interference in such a delicate field of international relations there must be present the affirmative intention of Congress clearly expressed. It alone has the facilities necessary to make fairly such an important policy decision where the possibilities of international discord are so evident and retaliative action so certain.⁶¹

⁵⁸ *Barker*, 2008 U.S. Dist. LEXIS 25913 at *21 n.7.

⁵⁹ *Lauritzen v. Larsen*, 345 U.S. 571, 578 (1953) (quoting *Murray v. Charming Betsy*, 6 U.S. (2 Cranch) 64 (1804)); accord *United States v. Yousef*, 327 F.3d 56 (2d Cir.) (per curiam) (“While it is permissible for United States law to conflict with customary international law, where legislation is susceptible to multiple interpretations, the interpretation that does not conflict with ‘the law of nations’ is preferred.”).

⁶⁰ *Chae Chan Ping v. United States*, 130 U.S. 581, 599-602 (1889).

⁶¹ *Benz v. Compania Naviera Hidalgo, S.A.*, 353 U.S. 138, 147 (1957); see also, e.g., *Trans World Airlines, Inc. v. Franklin Mint Corp.*, 466 U.S. 243, 281(1984) (“There is... a firm and obviously sound canon of construction against finding implicit repeal of a treaty in ambiguous congressional action.”); *Weinberger v. Rossi*, 456 U.S. 25, 31-32 (1982) (avoiding constructions of statutes that “would have had foreign policy implications”); *Washington v. Washington State Comm. Passenger Fishing Vessel Ass’n*, 443 U.S. 658, 690 (1979) (“we have been extremely reluctant to find congressional abrogation of treaty rights”); *Menominee Tribe v. United States*, 391 U.S. 404, 412-13 (1968) (“the intention to abrogate or modify a treaty is not to be lightly imputed”); *McCulloch v. Sociedad Nacional de Marineros de Honduras*, 372 U.S. 10, 21 (1963) (“such highly charged international circumstances brings to mind the admonition ... that ‘an act of congress ought never to be construed to violate the law of nations if any other possible construction remains’”); *Pigeon River Improvement, Slide & Boom Co. v. Charles W. Cox, Ltd.*, 291 U.S. 138, 160 (1934); *MacLeod v. United States*, 229 U.S. 416, 434 (1913) (a “statute should be construed in the light of the purpose of the Government to act within the limitation of the principles of international law, the observance of which is so essential to the peace and harmony of nations, and it should not be presumed that Congress proposed to violate the obligations of this country”).

This principle should lead courts to adopt any reasonable interpretation of the Copyright Act that grants a making-available right. At least eight adopted and implemented international agreements require the U.S. to provide such a right:

- The WIPO Copyright Treaty: “[A]uthors of literary and artistic works shall enjoy the exclusive right of authorizing any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them.”⁶²
- The WIPO Performances and Phonograms Treaty: “Producers of phonograms shall enjoy the exclusive right of authorizing any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them.”
- Six Bilateral or Multilateral Free Trade Agreements (“FTAs”): The U.S. has entered into six FTAs (five bilateral and one multilateral) that explicitly require the parties to provide making-available rights. For example, the U.S.-Australia FTA states in Article 17.5: “[E]ach Party shall provide to authors the exclusive right to authorize or prohibit the communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access those works from a place and at a time individually chosen by them.”⁶³

Barker neither denies that these agreements exist nor that courts usually interpret statutes to accord with the international agreements of the United States. Nevertheless, *Barker* seems to conclude that two factors render these agreements and this interpretive principle irrelevant to a court deciding whether the Copyright Act of 1976 grants a making-available right.

Barker first asserts that the WIPO Treaties and the FTAs are not “self-executing,” and thus do not trigger the principle that courts should prefer reasonable interpretations of statutes that accord with the international obligations of the United States.⁶⁴ The former claim begs the question, but the latter claim is simply wrong.

⁶² WIPO’s commentary on the WCT explains that it uses the “neutral” term “making available” because various nations planned to different exclusive rights to implement this obligation. Some, like the United States, planned to implement it through their existing distribution rights. Others, however, planned to implement it through different rights because their existing distribution rights were too narrow. MIHALY FICSOR, GUIDE TO THE COPYRIGHT AND RELATED RIGHTS TREATIES ADMINISTERED BY WIPO 208-09, CT-8.6 to 8.10 (World Intellectual Property Organization 2003).

⁶³ U.S.-Australia Free Trade Agreement, Art. 17.5, p. 17-12
http://www.ustr.gov/assets/Trade_Agreements/Bilateral/Australia_FTA/Final_Text/asset_upload_file148_5168.pdf.

⁶⁴ *Barker*, 2008 U.S. Dist. LEXIS 25913 at *21 n.7.

To be sure, self-executing and non-self-executing international agreements differ materially. For example, Section 111(3) of *The Restatement of the Foreign Relations Law of the United States* notes that the class of “international agreements of the United States” includes a subclass that is “non-self-executing’ ... in the absence of necessary implementation” and that such agreements “will not be given effect as law in the absence of necessary implementation.”⁶⁵ While the implementing acts for the WIPO Treaties and the FTAs certainly show that *some* of their provisions were non-self-executing, cases like *Barker* raise the question of whether courts should give any weight to the seven Congressional and Presidential determinations that interpreted their making-available provisions to be self-executing:

Some provisions of an international agreement may be self-executing and others not self-executing.... There can, of course, be instances in which the United States Constitution, or previously enacted legislation, will be fully adequate to give effect to an apparently non-self-executing international agreement, thus obviating the need of adopting new legislation to implement it.⁶⁶

Labeling the making-available obligations of the WIPO Treaties and FTAs as “non-self-executing” thus begs the real question: Unless judges presume that Congress and the President acted incompetently or deceptively, the seven treaty- or FTA-implementing statutes enacted before *Barker necessarily* disagree with that conclusion. The question is whether those seven enacted determinations by two co-equal Branches of the federal government should affect subsequent judicial interpretations of the Copyright Act.

More importantly, courts construing statutes in light of international agreements ignore distinctions between the subclasses of “international agreements of the United States.” The *Restatement* says, “Where fairly possible, a United States statute is to be construed so as not to conflict with international law or an international agreement of the United States.”⁶⁷ The *Restatement* recognizes no exception to this principle for “non-self executing” international agreements. In other words, courts will not use their interpretative authority in order to create unnecessary conflicts between the domestic laws and international agreements of the United States.⁶⁸

Barker also asserts that since the WIPO Treaties and FTAs were adopted and implemented after the Copyright Act of 1976 was enacted, these agreements and their implementing legislation are the sort of unreliable “subsequent legislative history” that

⁶⁵ *Restatement of the Law, Third, Foreign Relations Law of the United States*, § 111(3) (1987). In other words, even if obligations imposed by a non-self-executing international agreements were not inherently legally binding, they might still be relevant to courts deciding how to interpret statutes.

⁶⁶ *Id.* at comment h.

⁶⁷ *Id.* at § 114.

⁶⁸ Cases like *Barker* do not require courts to resolve a broader question that neither precedent nor the *Restatement* seem to squarely address: Should courts interpreting domestic statutes try to conform U.S. law to non-self-executing international agreements that Congress and the President have not yet implemented through domestic legislation? I suspect that the answer is “no”; in such a case, there may be no “conflict” to trigger the interpretive preference in Section 114 of the *Restatement*.

courts generally ignore. But the Supreme Court has unanimously distinguished enacted laws from subsequent legislative history: “Subsequent legislation declaring the intent of an earlier statute is entitled to great weight in statutory construction’ ... [because] Congress has proceeded formally through the legislative process.”⁶⁹

The eight international agreements at issue here were implemented through domestic legislation: Congress and the President have now enacted seven laws concluding that then-existing U.S. law conferred the making-available right required by the WCT, the WPPT, and the FTAs. For example, when the U.S. implemented the WCT and WPPT, both USPTO and the Copyright Office testified that the then-existing exclusive rights granted by the Copyright Act provided a making-available right.⁷⁰ Congress and the President concurred.⁷¹ As a result, none of the detailed provisions of the WIPO Copyright and Performances and Phonograms Treaties Implementation Act of 1998 purport to implement the making-available obligations imposed by these treaties.⁷²

The six FTAs also required the President and Congress to conclude that then-existing U.S. law provided a “making-available right.” To enter into an FTA, the President must

⁶⁹ *Consumer Product Safety Comm’n v. GTE Sylvania, Inc.*, 447 U.S. 102, 118 n.13 (1980) (quoting *Red Lion Broadcasting Co. v. FCC*, 395 U.S. 367, 380-81 (1969)); see also *Federal Housing Admin. v. The Darlington, Inc.*, 358 U.S. 84, 90 (1958) (while not conclusive, “[s]ubsequent legislation which declares the intent of an earlier law... is entitled to weight when it comes to the problem of construction”); *United States v. Stanoff*, 260 U.S. 477, 480 (1923) (“a statute purporting to declare the intent of an earlier one might be of great weight in assisting a Court”) (dicta); *Stockdale v. The Ins. Cos.*, 87 U.S. 323, 331 (1874) (“it may be taken to be established, that a legislative body may be statute declare the construction of previous statutes so as to bind the courts in reference to all transactions occurring after the passage of the law”); *United States v. Freeman*, 44 U.S. 556, 564-65 (1845) (“if it can be gathered from a subsequent statute in pari materia, what meaning the legislature attached to the words of a former statute, they will amount to a legislative declaration of its meaning, and will govern the construction of the first statute); *Alexander v. Mayor of Alexandria*, 9 U.S. 1, 7-8 (1809) (Marshall, J.) (“if a subsequent act on the same subject affords complete demonstration of the legislative sense of its own language, the rule ... requiring that the subsequent should be incorporated into the foregoing act, is a direction to courts in expounding the provisions of the law”).

⁷⁰ See *WIPO Copyright Treaties Implementation Act and Online Copyright Liability Act, Hearing on H.R. 2281 & H.R. 2180 Before the House Subcommittee on Courts and Intellectual Property of the Committee on the Judiciary*, 105th Cong. 87 (1997) (statement of Bruce Lehman, Assistant Secretary of Commerce and Commissioner of Patents and Trademarks); *Hearing on WIPO Copyright Treaties Implementation Act (H.R. 2281) and On-Line Copyright Liability Limitation Act (H.R. 2180) before the Subcomm. On Courts, the Internet and Intellectual Property of the House Comm. On the Judiciary*, 105th Cong., 1st Sess., Sept. 16, 1997 (testimony of Marybeth Peters, the Register of Copyrights); see also *Piracy of Intellectual Property on Peer-to-Peer Networks: Hearing before the Subcomm. On Courts, the Internet and Intellectual Property of the House Comm. On the Judiciary*, 107th Cong. 114-115 (2002) (testimony of Marybeth Peters).

⁷¹ H.R. 105-551, pt.1, 105th Cong., 2nd Sess. at 9 (“The [WCT and WPPT] treaties do not require any change in the substance of copyright rights or exceptions in U.S. law.”); S. Rep. 105-190, 105th Cong., 2nd Sess. at 10-11 (noting the making-available obligations in the WCT but concluding “that in order to adhere to the WIPO treaties, legislation is necessary in two primary areas—anticircumvention of technological protection measures and protection of the integrity of rights management information”).

⁷² See *Digital Millennium Copyright Act*, § 101, Pub. L. 105-304, 112 Stat. 2860; see also *id.* at preamble (describing the whole act as one “[t]o amend title 17, United States Code, to implement the World Intellectual Property Organization Copyright Treaty and Performances and Phonograms Treaty, and for other purposes”).

submit the negotiated agreement to Congress along with a Statement of Administrative Action (SAA) and proposed implementing legislation that conforms U.S. law to the FTA obligations. Congress then approves the SAA when it enacts the FTA's implementing legislation. Consequently, Congress has now enacted—and the President has signed—six sets of FTA-implementation legislation predicated upon six congressionally approved SAAs recording six Presidential conclusions that then-existing U.S. law provided the making-available right expressly required by six FTAs.⁷³

For example, Chapter 16, Article 16.4.2(a), of the U.S.-Singapore FTA requires each Party to provide copyright owners with a making-available right.⁷⁴ In the SAA for this FTA, the President concluded, “No statutory or administrative changes will be required to implement Chapter 16.”⁷⁵ When considering the SAA and its proposed implementing legislation, Committees of both houses of Congress specifically praised the Agreement's making-available obligation: one noted that it “aimed at protecting music, videos, software, or text from widespread unauthorized sharing via the Internet.”⁷⁶ Congress then passed, and the President signed, the United States-Singapore Free Trade Agreement Implementation Act, in which Congress specifically approved “the statement of administrative action proposed to implement the Agreement...”⁷⁷ Both Congress and the President thus concluded—through an *unusually formal* legislative process—that no statutory changes were needed to implement the U.S.-Singapore FTA's making-available obligation.

Consequently, the interpretive issue in *Barker* is only unusual because the statutes that implemented the WCT, the WPPT and the FTAs necessarily interpret a *previously enacted* statute—the Copyright Act of 1976.⁷⁸ Precedents like *Lauritzen* show that if international agreements required the United States to provide a making-available right when the Copyright Act of 1976 was enacted, then courts would adopt possible interpretations of the Act that provided such a right. These precedents also show that if Congress and the President had amended the Act in order to grant the making-available

⁷³ See An Act To implement the United States-Bahrain Free Trade Agreement, PL 109-169, Title I, Sec 101 (a) (2), 119 Stat. 3581 (2006); An Act To implement the Dominican Republic-Central America-United States Free Trade Agreement, PL 109-53, Title I, Sec 101 (a) (2), 119 Stat. 463 (2005); An Act To implement the United States-Morocco Free Trade Agreement, PL 108-302, Title I, Sec 101 (a) (2), 118 Stat. 1104 (2004); An Act To implement the United States-Australia Free Trade Agreement, PL 108-286, Title I, Sec 101 (a) (2), 118 Stat. 920 (2004); An Act To implement the United States-Chile Free Trade Agreement, PL 108-77, Title I, Sec 101 (a) (2), 117 Stat. 910 (2003); An Act To implement the United States-Singapore Free Trade Agreement, PL 108-78, Title I, Sec 101 (a) (2), 117 Stat. 949 (2003); See also, e.g., *Report of the Senate Committee on Finance on the United States-Bahrain Free Trade Agreement Implementation Act*, S. Rep. 109-199, 109th Cong., 1st Sess. at 5 (Dec. 8, 2005) (describing the role of the SAA in implementing an FTA).

⁷⁴ See U.S.-Singapore Free Trade Agreement at Art. 16.4.2(a) http://www.ustr.gov/assets/Trade_Agreements/Bilateral/Singapore_FTA/Final_Texts/asset_upload_file708_4036.pdf.

⁷⁵ See Statement of Administrative Action at 34, U.S.-Singapore Free Trade Agreement Implementation Act (2003) <http://waysandmeans.house.gov/media/pdf/singapore/hr2739SingaporeSAA7-15-03.pdf>.

⁷⁶ H.R. 108-225, pt.2, 108th Cong., 1st Sess. at 3; see also S. Rep. 108-117, 108th Cong., 1st Sess. at 17.

⁷⁷ Pub. L. 108-78 at § 101(a)(2), 117 Stat. 948.

⁷⁸ Most of the reported cases required courts to interpret statutes enacted *after* the United States had acceded to the relevant international agreement. See, e.g., *Lauritzen v. Larsen*, 345 U.S. 571 (1953).

right required by the WCT, the WPPT and the FTAs, then courts should adopt reasonable interpretations of the amending language that would grant such a right.

Barker thus raises a closely related question: *If* Congress and the President have seven times implemented international agreements by enacting legislation that necessarily interprets the previously enacted Copyright Act to grant a making-available right—and *if* possible interpretations of the Copyright Act, (for example, one that gives “to authorize” its plain meaning), would grant such a right—then should subsequent judicial interpretations of the Copyright Act adopt interpretations that grant such a right?⁷⁹ Or, to restate the question more generally: If Congress and the President enact implementing legislation that reasonably interprets an existing statute to grant a right required by an international agreement, should courts defer to interpretations that provide the required right?

Section 114 of *The Restatement of the Foreign Relations Law of the United States* shows that the answer to this question is “yes,” and the rationale for its rule explains why. Courts favor statutory constructions that accord with international agreements not only because the Constitution assigns the Treaty and Foreign Commerce Powers to the President and Congress, but also because these powers cannot be exercised effectively unless other nations can believe that Congress and the President will execute these powers competently and in good faith:

The statute should be construed in the light of the purpose of the Government to act within the limitation of the principles of international law, the observance of which is so essential to the peace and harmony of nations, and it should not be assumed that Congress proposed to violate the obligations of this country to other nations, which it was the manifest purpose of the President to scrupulously observe and which were founded upon the principles of international law.⁸⁰

As a result, courts will not needlessly infer that Congress or the President have exercised their foreign-commerce-related powers incompetently or duplicitously. As the Supreme Court recently noted, “this rule of construction promotes “a harmony particularly needed in today’s interdependent commercial world.”⁸¹

⁷⁹ Questions like this are not novel, but courts have rarely had to decide whether they should construe statutes in light of subsequent international agreements. The most analogous case is probably *Cook v. United States*, 288 U.S. 102 (1933). During Prohibition, U.S. agents—using authority like the Tariff Act of 1922—were seizing alcohol carried in British ships that ventured within 12 miles of the U.S. The resulting international tensions were resolved in a 1924 Treaty between the U.S. and Britain. *Id.* at 107. After the Tariff Act of 1930 re-enacted, unchanged, the language of the Tariff Act of 1922, U.S. agents again seized alcohol carried by a British ship, and the Supreme Court had to decide whether the verbatim re-enactment of the 1922 language abrogated or modified the 1924 Treaty. The Court found that it did not, relying on both the principle favoring statutory interpretations that accord with international agreements and administrative practice interpreting the re-enacted statute. *Id.* at 120.

⁸⁰ *MacLeod v. United States*, 229 U.S. 416, 434 (1913).

⁸¹ *F. Hoffmann-La Roche Ltd. v. Empagran S.A.*, 542 U.S. 155, 164-65 (2004).

Cases like *Barker* implicate this principle of intra-governmental comity and international good faith: In 2008, a federal judge who holds that the Copyright Act does not provide a making-available right necessarily holds that the Legislative and Executive Branches of the government of the United States—the world’s leading producer and exporter of copyrighted expressive works—have implemented *eight* copyright-related international agreements incompetently or duplicitously. As the *en banc* Ninth Circuit noted, such holdings “might disrupt Congress’s efforts to secure a more stable international intellectual property regime ... [and] might undermine Congress’s objective of achieving ‘effective and harmonious’ copyright laws among all nations.”⁸²

The rule favoring statutory interpretations that accord with international agreements also avoids a structural problem that arises from the nature of the judicial power itself. To implement the WIPO Treaties and the FTAs, the President and Congress had to determine whether the Act’s then-existing exclusive rights provided the making-available right required by these eight agreements.⁸³ When doing so, Congress and the President could not survey the preferred interpretive views of federal judges: Federal courts cannot give advisory opinions.⁸⁴ Consequently, Congress and the President, advised by their expert agencies, had to interpret the Copyright Act themselves. Cases like *Barker* thus raise the question of whether every federal district judge—eight international agreements and a decade later—can reject a reasonable interpretation of the Copyright Act that has guided eleven years of U.S. foreign policy whenever he or she finds a different interpretation more persuasive.⁸⁵

This structural problem makes the interpretive issue in *Barker* look familiar: Analogous questions about the deference due to Executive-Branch interpretations of *existing statutes* arise routinely in domestic administrative law. Just as Congress and the President must interpret previously enacted statutes in order to execute the Treaty and Foreign Commerce Powers delegated to them by the Constitution, so to must administrative agencies interpret previously enacted statutes in order to exercise their delegated lawmaking powers. Both contexts implicate the same structural problem: Statutes are often ambiguous, so years or even a decade of laws based on reasonable statutory interpretations could be undone if case-and-controversy-bound judges can intervene long after the fact and impose their own preferred constructions.

⁸² *Subafilms, Ltd. v. MGM-Pathe Comms. Co.*, 24 F.3d 1088, 1097 (9th Cir. 1994) (*en banc*).

⁸³ There are very good reasons why Congress and the President should not amend existing statutes just to ensure that they explicitly provide rights that these Branches conclude are already present. Doing so could well be understood to imply a narrow construction of the existing statute. *Cf. Stone v. INS*, 514 U.S. 386, 397 (1995) (“When Congress acts to amend a statute, we presume it intends its amendment to have real and substantial effect.”).

⁸⁴ See, e.g., *Alabama State Fed. of Labor v. McAdory*, 325 U.S. 450, 461 (1945).

⁸⁵ *McCulloch v. Sociedad Nacional d Marineros de Honduras*, 372 U.S. 10, 17 (1963) (“the presence of public questions particularly high in the scale of our national interest because of their international complexion is a uniquely compelling justification for prompt judicial resolution of the controversy over the Board’s power”).

In U.S. administrative law, courts resolved this structural problem in *Chevron U.S.A., Inc. v. Natural Resources Defense Council, Inc.*⁸⁶ *Chevron* held that when an agency interprets such an existing statute while executing delegated law-making authority, “a court may not substitute its own construction of a statutory provision for a reasonable interpretation made by the administrator of an agency.”⁸⁷

In a modern, global economy, there is an even more powerful case for *Chevron*-like deference to reasonable statutory interpretations that the Executive Branch and Congress adopt when implementing international agreements. Congress and the President must interpret existing statutes in order to determine whether, or to what extent, they must amend existing laws or enact new ones in order to implement the international agreements of the United States. When they do so through formal legislative processes, federal courts should not deny these co-equal, elected Branches the interpretive deference that they would grant to any unelected agency administrator.

Finally, courts construing the Copyright Act err if they deny that the interpretations of the federal agencies charged with interpreting the Copyright Act “should influence” judicial interpretation of the Act.⁸⁸ In *United States v. Mead*, the Supreme Court held that even when courts are not bound to defer to agencies’ statutory interpretations, they must still give them due deference: “The weight accorded to an administrative judgment in a particular case will depend upon the thoroughness evident in its consideration, the validity of its reasoning, its consistency with earlier and later pronouncements, and all those factors which give it power to persuade, if lacking power to control.”⁸⁹

Here, the relevant expert agencies have repeatedly concluded that the Copyright Act provides a “making-available” right. The U.S. Copyright Office has done so, and it administers almost all of the Copyright Act and advises both Congress and agencies about domestic and international copyright law.⁹⁰ The U.S. Patent & Trademark Office has also done so, and it administers parts of the Copyright Act and advises the President and other agencies about domestic and international copyright law.⁹¹ Courts should not lightly dismiss considered administrative interpretations of the Copyright

⁸⁶ 467 U.S. 837 (1984).

⁸⁷ *Id.* at 844.

⁸⁸ *Barker*, 2008 U.S. Dist. LEXIS 25913 at *21 & n.7.

⁸⁹ 533 U.S. 218, 227 (2001); see also *Alaska Dept. of Environmental Conservation v. EPA*, 540 U.S. 461, 487 (2004) (“Cogent ‘administrative interpretations not the products of formal rulemaking nevertheless warrant respect.’”) (citation omitted).

⁹⁰ See 17 U.S.C. § 701(b)(1)-(2); *Sumitomo Shoji America, Inc. v. Avagliano*, 457 U.S. 176, 184-85 (1982) (“the meaning attributed to treaty provisions by the Government agencies charged with their negotiation and enforcement is entitled to great weight”). Moreover, when the Copyright Office interpreted the Copyright Act of 1976 to provide a making available right, it did so through a person uniquely qualified to speak to the issue, Register of Copyrights Marybeth Peters. Before Ms. Peters was appointed Register, she had been a Copyright Office employee since 1966, she had served as the Copyright Office Training Officer for the 1976 Copyright Act, personally trained other Copyright Office personnel in its meaning and application, and authored the GENERAL GUIDE TO THE COPYRIGHT ACT OF 1976 (Copyright Office 1977). See Copyright Office, *Marybeth Peters Named New Register of Copyrights* (July 29, 1994). <http://www.loc.gov/today/pr/1994/94-123.html>.

⁹¹ See 17 U.S.C. § 1002(a)-(b); 35 U.S.C. § 35 U.S.C. § 2(b)(8)-(9).

Act—particularly those that have seven times proved persuasive to both the President and Congress.

II. Policy: An Enforceable Making-Available Right Will Protect Both Copyrights and Individual Internet Users.

It is difficult to read some of the recent making-available cases without suspecting that some courts are struggling with questions of policy that transcend any questions about statutory interpretation. Consider, for example, the recent decision in *Atlantic Recording Co. v. Howell*.⁹²

Howell seems to strain mightily to reach a desired result. Three recent Ninth Circuit decisions state that an entity making files available to the public violates the distribution right; all of these cases discuss online file-sharing and two cite the *Hotaling* case approvingly and discuss it at length.⁹³ To distinguish these cases, *Howell* had to repeatedly ignore or reject the reasoning of the Ninth Circuit.

First, *Howell* confronted *Napster*, which stated, “Napster users who upload file names to the search index for others to copy violate plaintiffs’ distribution rights.”⁹⁴ *Howell* critiqued *Napster*, claiming, “The [Ninth Circuit] cited no precedent and offered no analysis in explanation of [its] statement.”⁹⁵ But *Howell* neglected to note that the Ninth Circuit had since *twice* re-affirmed that *Napster* meant what it said.⁹⁶

Next, *Howell* tried to distinguish the Ninth Circuit’s more recent *Amazon* and *Google* decisions. Having just distinguished the Ninth Circuit’s statement in *Napster* as a lone sentence of *obiter dicta*, *Howell* then relied on another lone sentence of *dicta* in *Amazon* and *Google* and concluded that this sentence “contradicts *Hotaling* and casts doubt on the single unsupported line from *Napster*....”⁹⁷ In *Google* and *Amazon*, the Ninth Circuit disagreed:

Hotaling held that the owner of a collection of works who makes them available to the public may be deemed to have distributed copies of the works. Similarly the distribution rights of the plaintiff copyright owners

⁹² *Atlantic Recording Corp. v. Howell*, No. CV-06-02076-PHX-NVW, 2008 U.S. Dist. LEXIS 35284 (Apr. 29, 2008).

⁹³ See *A&M Records v. Napster, Inc.*, 239 F.3d 1004, 1014 (9th Cir. 2001); *Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d 701, 718-19 (9th Cir. 2007) (*amended in Google, Inc. v. Perfect 10, Inc.*, 508 F.3d 1146, 1162-63 (9th Cir. 2007)).

⁹⁴ *Howell*, 2008 U.S. Dist. LEXIS 35284 at *13 (*quoting A&M Records v. Napster, Inc.*, 239 F.3d 1004, 1014 (9th Cir. 2001)).

⁹⁵ *Id.*

⁹⁶ See *Google, Inc. v. Perfect 10, Inc.*, 508 F.3d 1146, 1162 (9th Cir. 2007) (“the distribution rights of the plaintiff copyright owners were infringed by Napster users (private individuals with collections of music files stored on their home computers) when they used the Napster software to make their collections available to all other Napster users”) (*amending Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d 701, 719 (9th Cir. 2007) (same)).

⁹⁷ *Howell*, 2008 U.S. Dist. LEXIS 35284 at *13.

were infringed by Napster *users* (private individuals with collections of music files stored on their home computers) when they used the Napster software to make their collections available to all other Napster users.

This “deemed distribution” rule does not apply to Google. Unlike the participants in the *Napster* system or the library in *Hotaling*, Google does not own a collection of [plaintiff’s] full-sized images and does not communicate these images to the computers of people using Google’s search engine. Though Google indexes these images, it does not have a collection of stored full-sized images it makes available to the public. Google therefore cannot be deemed to distribute copies of these images under the reasoning of *Napster* or *Hotaling*.⁹⁸

Next, citing no precedent and offering no supporting analysis, *Howell* then proclaimed “there is no basis for attempt liability in the [Copyright Act], no matter how desirable such liability may be as a matter of policy.” *Id.* at 11. But if we agree, (and the *Howell* Court seems to), that attempt liability is desirable as “a matter of policy” then the plain meaning of the phrase “to do and to authorize” does provide such a basis.⁹⁹

Finally, *Howell* concludes with a disturbingly familiar flourish and quotation of *dicta*:

This court is not unsympathetic to the difficulty that Internet file-sharing systems pose to owners of registered copyrights. Even so, it is not the position of this court to respond to new technological innovations by expanding the protections received by copyright holders beyond those found in the Copyright Act.

The judiciary’s reluctance to expand the protections afforded by the copyright without explicit legislative guidance is a recurring theme. [See, e.g., *Teleprompter Corp. v. Columbia Broadcasting Sys., Inc.*, 415 U.S. 394 (1974); *Fortnightly Corp. v. United Artists Tel., Inc.*, 392 U.S. 390 (1968); *White-Smith Music Pub. Co. v. Apollo Co.*, 209 U.S. 1 (1908)...] Sound policy, as well as history, supports our consistent deference to Congress when major technological innovations alter the market for copyrighted materials. Congress has the constitutional authority and the institutional ability to accommodate fully the varied permutations of competing interests that are inevitably implicated by such new technology. In a case like this, in which Congress has not plainly marked our course, we must be circumspect in construing the scope of rights created by a legislative

⁹⁸ See, e.g., *Google, Inc. v. Perfect 10, Inc.*, 508 F.3d 1146, 1162 (9th Cir. 2007) (citations omitted, emphasis in original).

⁹⁹ See 17 U.S.C. § 106 (granting rights “to do or to authorize” reproduction, distribution to the public, etc.).

enactment which never contemplated such a calculus of interests.¹⁰⁰

For three reasons, no court—particularly one adjudicating a case involving infringing uses of file-sharing programs—should scribe these disturbingly familiar words.

First, courts should give the *Sony dicta* quoted in *Howell* no more effect than its authors did. Were courts truly incompetent to determine how copyrights are implicated by new technologies, then the *Sony* majority should have been bound to apply the secondary-liability tests prevailing in 1976—and to do so even if this let a few copyright holders control lines of business substantially unrelated to copyright infringement. Nevertheless, the *Sony* majority went on to change the law of secondary liability in a way that it hoped would “strike a balance between a copyright holder’s legitimate demand for effective—not merely symbolic—protection... and the rights of others to engage in substantially unrelated areas of commerce.”¹⁰¹

Second, the *Sony dicta* quoted in *Howell* is flatly anachronistic: It urges courts to perpetuate—in the name of “deference to Congress,” the very sort of interpretative practices that Congress sought to end in the Copyright Act of 1976. Cases like *White-Smith*, *Fortnightly*, and *Teleprompter* do show that the Copyright Act of 1909 and its predecessors had often left courts guessing about whether newly developed technologies implicated the exclusive rights granted by those Acts. “What is meant by a copy?” asked the Court in *White-Smith Music Publishing Co. v. Apollo Co.*, and it found nothing in the then-existing act or the ordinary meaning of the word to suggest that a “copy” included a player-piano role that would be unintelligible to almost all human viewers.¹⁰² A similar problem drove the result in *Fortnightly*: “[I]t is clear that the petitioner’s [cable television] systems did not ‘perform’ the respondent’s copyrighted works in any conventional sense of that term, or in any manner that could have been envisioned by the Congress that enacted the law in 1909.”¹⁰³

The narrowly drafted provisions of the Copyright Act of 1909 and its predecessors thus led to a game of “technology catch-up”: Sometimes, acts that seemed like they *should* have been within the scope of the rights that a copyright holder *should* possess did not fall within the scope of the rights granted by a reasonable interpretation of the then-existing copyright act. When that happened, Congress tended to resolve the resulting problem by splitting the baby and granting rights to fees from compulsory licenses, rather than exclusive rights. As a result, the Copyright Office had been urging Congress

¹⁰⁰ *Howell*, No. CV-06-02076-PHX-NVW, 2008 U.S. Dist. LEXIS 35284 at *29-30 (Apr. 29, 2008) (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 431 (1984)),

¹⁰¹ *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 442 (1984).

¹⁰² 209 U.S. at 29.

¹⁰³ *Fortnightly Corp. v. United Artists Tele., Inc.*, 392 U.S. at 396; see also Tim Wu, *The Copyright Paradox*, 2005 Sup. Ct. Rev. 229, 254 (“The Court in [*White-Smith*, *Fortnightly*, and *Teleprompter*] made it clear that the Copyright Act, as written, had no answers to the problem presented....”).

since 1903 to restate copyrights in technology-neutral terms that would clarify their application as to yet-undiscovered technologies.¹⁰⁴

In the Copyright Act of 1976, Congress did just that: It thus drafted the Act so show that the rights it granted were intended to apply equally to new technologies not contemplated when the Act was enacted. Three aspects of the Act are particularly germane.

In the Act, Congress first defined the basic principles of copyright protection in technology-neutral terms and expressed its intent that those principles should apply *even as to technologies not then invented*. In Section 102 it stated, “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*.”¹⁰⁵ Section 101 defines “copies” and “phonograms,” the triggers of the reproduction and distribution rights, as material objects “fixed by any method *now known or later developed*, from which the [work or sounds] can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”¹⁰⁶ These changes were specifically intended reverse the outcome of a future iteration of *White-Smith*.¹⁰⁷

Congress also reframed some of the exclusive rights granted by the Act more broadly. In particular, the right to “vend” or sell works became a broader right to distribute works to the public, and Congress clarified that one can “perform” works “directly or by means of any device or process....”¹⁰⁸ These changes would reverse the outcome of future iterations of *Teleprompter* and *Fortnightly*.¹⁰⁹

Finally, the structure of Chapter One of the Act provides further guidance about the intended and respective roles of courts and legislature under the Act. The first nine sections of Chapter One try to define “default” principles of copyright in future-proof, technology-neutral terms.¹¹⁰ In the remaining fifteen sections, Congress codified a vast array of context-or-technology-specific limitations and exceptions to the preceding

¹⁰⁴ See Thorvald Solberg, *Copyright Law Reform*, 35 Yale L. J. 48, 61-62 (1925) (reprinting the conclusions of U.S. Copyright Office, Report on Copyright Leg. (Dec. 1, 1903)); see also Staff of the House Comm. On the Judiciary, 87th Cong., Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law 11 (Comm. Print 1961) (urging enactment of a new copyright law “broad enough to include not only those forms in which copyrightable works are now being produced, but also new forms which are invented or come into use later”).

¹⁰⁵ 17 U.S.C. § 102(a) (emphasis added).

¹⁰⁶ 17 U.S.C. § 101 (emphasis added).

¹⁰⁷ H.R. Rep. No. 94-1476, 94th Cong., 2nd Sess. at 52 (1976) (specifically criticizing the “artificial and largely unjustifiable distinctions derived from cases such as *White-Smith*”); accord S. Rep. No. 94-473, 94th Cong., 1st Sess. at 51 (1976).

¹⁰⁸ 17 U.S.C. at §§ 101, 106(3).

¹⁰⁹ See H.R. Rep. No. 94-1476, 94th Cong., 2nd Sess. at 63 (1976) (noting that under the new definitions of “perform” local and network broadcasters and cable systems are performing works when they transmit or retransmit them); accord S. Rep. No. 94-473, 94th Cong., 1st Sess. at 59 (1976).

¹¹⁰ See 17 U.S.C. at §§ 101-107.

default principles.¹¹¹ The message is clear: Courts must apply the default principles of copyright to new technologies or unanticipated circumstances until Congress decides whether to grant an exception or limitation from those principles.¹¹²

A recent law review article asks, “Should copyrights be construed as ... requiring courts to protect existing property interests from unauthorized uses made possible by new technologies and new markets?”¹¹³ On its face, the Copyright Act of 1976 answers this question: “Yes.” If an unauthorized use falls within the scope of any exclusive right “to do or to authorize” granted by the Act and no limitation or exception applies, then the Act makes the use infringing, regardless of the novelty of the technology or “market” involved.

Third, a recent Ninth-Circuit district court last concluded a piracy-empowering opinion with a very similar lament and a quote of this *Sony dicta* in *MGM Studios, Inc. v. Grokster, Ltd.*¹¹⁴ When that district court decision was appealed to the Ninth Circuit, various *amici*, including an association of Internet luminaries, urged the Ninth Circuit to affirm, quoting the same *dicta* and arguing that the district court decision was correct.¹¹⁵ The Ninth Circuit agreed, and affirmed the district court decision.¹¹⁶

And then, the Supreme Court granted *certiorari* in *Grokster*. Then some of these same Internet luminaries changed their tune: They thus filed a *new amicus* brief arguing that the Supreme Court should *reverse* the Ninth Circuit for doing what these Internet luminaries told it to do.¹¹⁷ In *MGM Studios, Inc. v. Grokster, Ltd.*, all nine Justices of the United States Supreme Court agreed, and reversed the judgment of the Ninth Circuit.

In the aftermath of *Grokster*, it is very strange to see persons like Tenise Barker being defended by *amici* like the Electronic Frontier Foundation (EFF), the Computer and Communications Industry Association (CCIA) and the US Internet Industry Association (USIIA). In *Grokster*, these very *amici* were defending deliberate, for-profit piracy by drawing targets on the foreheads of people like Tenise Barker and calling for copyright owners to open fire.

Grokster involved two defendants who distributed file-sharing programs functionally identical to the KaZaA program allegedly used by Tenise Barker. Nor was it difficult to discern that the corporate distributors of these programs intended to be in the business of for-profit copyright piracy. Prior to *Grokster*, every case involving any distributor of a

¹¹¹ See *id.* at §§ 108-122.

¹¹² See *infra* n. 28.

¹¹³ Raymond Shih Ray Ku, *Grokking Grokster*, 2005 WIS. L. REV. 1217, 1247 (2005).

¹¹⁴ 259 F. Supp. 2d 1029 (C.D. Cal. 2003), *aff'd*, 380 F.3d 1154 (9th Cir. 2004), *rev'd*, 545 U.S. 913 (2005).

¹¹⁵ Brief Amicus Curiae of the Computer and Communications Industry Association and NetCoalition, *MGM Studios, Inc. v. Grokster, Ltd.*, Nos. 03-55894 & 03-56236 (9th Cir. Sept. 26, 2003).

¹¹⁶ *MGM Studios, Inc. v. Grokster, Ltd.*, 380 F.3d 1154 (9th Cir. 2004), *rev'd*, 545 U.S. 913 (2005).

¹¹⁷ Brief of the Digital Media Association, NetCoalition, the Center for Democracy and Technology and the Information Technology Association of America at 20, *MGM Studios, Inc. v. Grokster, Ltd.*, No. 04-480 (Jan. 24, 2005).

functionally similar file-sharing program had found evidence of such intent.¹¹⁸ In *Grokster* itself, every Justice found “clear,” “replete,” “unmistakable,” and “unequivocal” evidence that Grokster’s distributors intended to induce infringing use of their program.¹¹⁹ Indeed, the distributors of Grokster and Morpheus executed their intent so effectively that 97% of the files actually selected for downloading by users of their programs were, or were highly likely to be, infringing.¹²⁰

And were such evidence insufficiently obvious to potential *amici*, the distributors of Grokster and Morpheus gave them another hint: Citing their “concern about the possibility of a criminal investigation,” they refused to let any *amici* look at the complete record of their conduct.¹²¹ Consequently, these distributors could be defended only by *amici* willing to file without knowing what sort of potentially criminal conduct they might be defending.

In *Grokster*, many of today’s pro-Barker *amici* defended these distributors anyway. They argued that the *Grokster* defendants should not be liable for the intended consequences of their own acts—even if they did intend to profit from copyright piracy by encouraging or duping children, students and ordinary consumers into infringing copyrights. But such extreme arguments begged an obvious question: If copyright owners cannot sue even corporations intentionally pursuing piracy-based versions of the “business model” of Bill Sykes, the villain of OLIVER TWIST, how can they enforce their rights?

In *Grokster*, Tenise Barker’s *amici* thus offered the same answer: Courts could let for-profit corporate inducers go free, because copyrights could be enforced by suing many thousands of people like Tenise Barker:

- **EFF (on behalf of the distributors of Morpheus):** “[T]he [music] industry and the Government can readily pursue direct infringers.... The record industry has sued more than 8,000 users, whose liability for statutory damages is daunting.... The Government has filed criminal charges, and obtained guilty pleas, against infringing users of peer-to-peer software.... The Internet, while enabling copying, also “facilitates detection” of misuse, leading even the movie industry to sue direct infringers.”
- **CCIA:** Copyright owners can deter infringing uses of “P2P networks” without suing their distributors because “the Recording Industry Association of America (RIAA) has begun to sue individual file traders engaged in large scale

¹¹⁸ *A & M Records, Inc. v. Napster Inc.*, 114 F. Supp. 2d 896, 9002-03 & n.7 (N.D. Cal. 2000); *In re Aimster Copyright Litig.*, 334 F.3d 643, 650-51 (7th Cir. 2003); *MGM Studios, Inc. v. Grokster, Ltd.*, 259 F. Supp. 2d 1029, 1046 (C.D. Cal. 2003); *MGM Studios, Inc. v. Grokster, Ltd.*, 380 F.3d 1154, 1164, 1166 (9th Cir. 2004).

¹¹⁹ *MGM Studios, Inc. v. Grokster Ltd.*, 545 U.S. at 938-40.

¹²⁰ *MGM Studios, Inc. v. Grokster Ltd.*, 454 F. Supp. 2d at 985.

¹²¹ Brief for the United States as Amicus Curiae Supporting Petitioners at 3 n.1, *MGM Studios, Inc. v. Grokster, Ltd.*, No. 04-480 (Jan. 24, 2005).

infringement.... [T]his strategy appears to have caused a decrease in file trading.”

- **USIIA:** “[Copyright owners] have been victimized by ... individuals’ use of peer-to-peer file-sharing software for unlawful copying and distribution of copyrighted sound recordings and motion pictures. This wanton disregard of intellectual property rights should be stopped. Internet *amici* have complied with lawfully issued subpoenas obtained by copyright owners in their campaign to identify more than 8,400 individuals alleged to have engaged in direct infringement through the misuse of peer-to-peer file-sharing software. That effort to punish and deter the direct infringers themselves is bearing fruit and requires no alteration of existing copyright law.”¹²²

Such arguments should seem odd: One rarely sees Industry A arguing that Industries B and C should inflict severe forms of harm upon consumers who make very foreseeable uses of the products and services of Industry A. As Buffalo Springfield might say, there’s something happening here, and what it is ain’t exactly clear. But neither is it difficult to clarify. For two reasons, the interests of individual internet users and *some* device distributors and online service providers can differ profoundly.

First, widespread online piracy reduces the need for the costly, risky innovation needed to create compelling *lawful* applications, services and devices. Here, for example, is how Professor Lawrence Lessig—no friend to copyrights or copyright industries—characterized the relationship between Internet usage and copyright piracy when he urged the government to nationalize the production of expression:

The appeal of file-sharing music was the crack cocaine of the Internet’s growth. It drove demand for access to the Internet more powerfully than any other single application. It was the Internet’s killer app.... It no doubt was the application that drove demand for bandwidth.¹²³

Lessig thus argued that, to date, copyright piracy has been the Internet’s “killer app.” So were it effectively deterred, many online service providers that want to grow their businesses would have to make risky investments in order to replace it with *lawful* “killer apps.” While some providers are doing just that, others might rather profit from the infringing acts of their customers while simultaneously (1) advocating copyright enforcement against their customers, and (2) arguing that such enforcement should be

¹²² Brief of Respondents at 45, *MGM Studios, Inc. v. Grokster, Ltd.*, No. 04-480 (March 1, 2005) (filed by EFF on behalf of StreamCast Networks); Brief *Amici Curiae* of [CCIA] and NetCoalition at 16-17 & nn.7-8, *MGM Studios, Inc. v. Grokster, Ltd.*, Nos. 03-55894 & 03-56236 (9th Cir. Sept. 26, 2003); Brief of Internet *Amici* ... in Support of Affirmance at 3 & n.4, *MGM Studios, Inc. v. Grokster, Ltd.*, No. 04-480 (March 1, 2005); accord Brief of Amicus LimeWire, Inc., Free Peers, Inc., and Raphael Manfredi at *MGM Studios, Inc. v. Grokster, Ltd.*, Case No. CV 01-08541SVW (PjWx) (C.D. Cal. Oct. 15, 2002).

¹²³ LAWRENCE LESSIG, *FREE CULTURE* 296 (2004); see also, e.g., Mem. of StreamCast Networks, Inc. et al. in Supp. Of Mot. For Partial Summary Judgment at 24, *MGM Studios, Inc. v. Grokster, Ltd.*, (C.D. Cal. Feb. 25, 2002) (“a primary use of the Internet – and a reason for widespread adoption of high-speed Internet access– is precisely the ability to seek and obtain infringing content”).

made as difficult and expensive as possible—even if this only ensures that entire families must be bankrupted in order to impose penalties sufficiently severe and frequent to generate deterrence.¹²⁴

Second, the outcome of cases like *Grokster* and *Barker* will affect whether providers of online services choose to reduce—or increase—the potential for copyright enforcement against individual users of their services. Cases like *Barker* are a carefully chosen, avoidable tragedy, but they might have been far more common but for a clever piece of social engineering enacted in the Digital Millennium Copyright Act (the DMCA).

Until recently, cases like *Barker*—cases in which copyrights are being enforced against ordinary consumers—were essentially unprecedented.¹²⁵ Even today, such lawsuits are a narrowly confined phenomenon: Ordinary consumers who “share” an infringing song on YouTube may receive a takedown notice, but, to date, they have not been sued.

Nor is it difficult to see why infringement lawsuits against individual Internet users are rarely necessary. An online service provider could be subject to potentially severe liability were it held liable for the infringing acts of users of its service. In the DMCA, Congress thus created “safe harbors” that grant immunity from monetary damages to qualifying providers of access, caching, hosting, or information-location services.¹²⁶ But these safe harbors have a price: Qualifying service providers must take steps that deter infringing uses of their services and ensure that measurers short of a lawsuit can resolve conflicts between their customers and copyright owners. These usually include 1) having and enforcing a policy of terminating service users who infringe repeatedly, and 2) disabling access to allegedly infringing materials or uses identified in a compliant “takedown” notice.

But while these DMCA safe-harbor requirements can sharply reduce, or even eliminate, the need for infringement lawsuits against consumers, the safe harbors themselves are *optional*: Providers *choose* whether to comply with them. They can also choose not to comply. In *Grokster*, for example, the defendants chose *not* to comply with the safe-harbors; indeed, they did all they could to maximize the potential for infringing uses of their programs and to ensure that copyright owners would have no means to deter them *except* by suing consumers.

¹²⁴ Brief of *Amicus Curiae* ...[CCIA]..., at 9 & n.7, *MGM Studios, Inc. v. Grokster, Ltd.*, No. 04-480 (March 1, 2005) (arguing that copyright holders can deter Internet infringement by trying to impose really huge statutory damages upon families that do get caught infringing in order to compensate for “the low likelihood” that any given family will be sued). Alternatively, they could also, like CCIA, urge the government to nationalize the production and distribution of expressive works—though not the production and distribution of computers and communications. See *id.* at 16 & n.55 (claiming that the government can “legitimiz[e] the sharing of copyrighted works” by nationalizing the production and Internet distribution of expressive works) (citing WILLIAM W. FISHER III, *PROMISES TO KEEP* (2004)).

¹²⁵ See Brief of *Amicus Curiae* Law Professors in Support of Respondents, at 8, *MGM Studios, Inc. v. Grokster, Ltd.*, No. 04-480 (March 1, 2005).

¹²⁶ See 17 U.S.C. § 512(a)-(d).

Consequently, the efficacy of the DMCA safe harbors and their conflict-reduction mechanisms can change over time: If it turns out that service providers can rarely, if ever, be held liable for the infringing acts of users of their services, then providers have no good reason to comply with the safe harbors. This may explain why groups like CCIA and USIIA would throw Tenise Barker under the copyright-enforcement bus in *Grokster* and then defend her in *Barker*.

In effect, *Grokster* raised the question of whether *any* hosting or information-location service could *ever* be held liable for the infringing acts of third-party users of its service. Had the Supreme Court affirmed the lower-court decisions—had it held that not even malign intent combined with 97% actual infringing use could make an online-service provider liable for the infringing acts of users of its service—then it would have become almost inconceivable that any online service provider could ever be liable for the infringing acts of third-party user of its services. Service providers would thus have lost almost all incentives to comply with the DMCA safe-harbor requirements.

Though this tactic failed, by the time it did so, specially designed piracy machines like KaZaA, Grokster, and Morpheus had become very widely distributed. Many cases like *Barker* thus became inevitable. In these cases, defendants like Tenise Barker are performing functions analogous to those of web-hosting services. In effect, a program like KaZaA turns a home computer into a server that makes files available to many other users of the Internet. Predictably, *amici* like CCIA and USIIA want liability for such acts to be construed as narrowly as possible.

Courts should reject such demands. Instead, courts should hold that recognition of a making-available right is necessary as a matter of law, and sound as a matter of policy. The recognition of such a right will reinforce the incentives that will prompt responsible content providers and online-service providers to devise creative, lawful means to protect the investments of artists and the safety of individual internet users while halting the distribution of malicious programs and violent child pornography.

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