

## Volition in Violation of Copyright

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Many recent copyright infringement cases have focused on the question of *volition*. As contentious as the matter has become in current copyright doctrine, the issue is relatively new. From the passage of the first Copyright Act in 1790 forward, U.S. copyright cases devoted no discussion to the issue. Two centuries later, however, the advent of the Internet raised this issue, among so many others.

Nothing is totally new under the sun. As far back as enactment of the 1976 Act, concern was expressed lest telephone companies be ensnared in liability, to the extent that their facilities were used in the retransmission of cable signals.<sup>1</sup> Congress adopted the “passive carrier” exemption, releasing from liability those “whose activities with respect to the secondary transmission consist solely of providing wires, cables, or other communications channels for the use of others.”<sup>2</sup> That provision was necessary as telephone companies risked liability in its absence.<sup>3</sup> Nobody at the time raised lack of “volition” as even a theoretical defense to that imputation. Decades later, with the advent of the Internet and online services, those same considerations multiplied along with the explosion of new ways to use “wires, cables, or other communications channels.”

## I. *NETCOM*

### A. NOVEL RULING

The “granddaddy” case here is *Religious Technology Center v. Netcom On-Line Communication Services, Inc.* Plaintiffs owned the copyright to the writings of L. Ron Hubbard, controversial founder of the Church of Scientology. Defendant Dennis Erlich, a former Scientology minister “turned vocal critic of the Church, whose pulpit is now the Usenet newsgroup alt.religion.scientology,”<sup>4</sup> posted to the

1. See U.S. COPYRIGHT OFFICE, A REVIEW OF THE COPYRIGHT LICENSING REGIMES COVERING RETRANSMISSION OF BROADCAST SIGNALS (1997), <https://perma.cc/AS4L-97Q4>.

2. 17 U.S.C. § 111(a)(3) (2018).

3. U.S. COPYRIGHT OFFICE, *supra* note 1, at x (“This provision was intended initially to ensure that telephone companies, whose wires and hardware were used as a conduit for the retransmissions made by cable systems, would not somehow be deemed to be infringers under the new Copyright Act of 1976.”).

4. *Religious Tech. Ctr. v. Netcom On-Line Commc’n Servs., Inc.*, 907 F. Supp. 1361, 1365 (N.D. Cal. 1995).

Internet long verbatim quotes from Hubbard, followed by brief editorials of his own, often of a sarcastic nature.<sup>5</sup> Plaintiffs responded by suing not only him, but also Thomas Klemesrud, operator of the Bulletin Board Service (BBS) that serviced Erlich. They also sued Netcom, Inc., then one of the country's largest Internet Service Providers (ISPs), which provided the facilities linking that BBS to the Internet.<sup>6</sup> Before instituting suit, plaintiffs had demanded of defendants that Erlich be defrocked from their systems, but "Netcom contended that it would be impossible to prescreen Erlich's postings and that to kick Erlich off the Internet meant kicking off the hundreds of users of Klemesrud's BBS."<sup>7</sup> Under the undisputed facts, Netcom's software was such that "Erlich's initial act of posting a message to the Usenet results in the automatic copying of Erlich's message from Klemesrud's computer onto Netcom's computer and onto other computers on the Usenet."<sup>8</sup>

A handful of cases decided shortly before *Netcom* had confronted parallel issues, ruling in favor of the copyright owner without the necessity of showing that the defendant had any knowledge of the copyright—after all, the elements of copyright infringement require a plaintiff to prove only its ownership of the work in question and the defendant's exercise of one of the owner's exclusive rights. *Playboy Enterprises, Inc. v. Frena*, for instance, held liable the operator of a BBS accessible to customers via modem over the telephone lines, by which those customers could obtain high-quality digital photographs to which plaintiff owned the copyright.<sup>9</sup> The decision did not delve into anything related to the defendant's volition. *Sega Enterprises Ltd. v. MAPHIA* shut down a BBS that overtly "encouraged [users] to download Sega games therefrom to avoid having to buy video game cartridges from Sega."<sup>10</sup>

Acting as an outstanding common law judge confronting an evolving technology, Judge Whyte refused to be shackled by preexisting doctrine.<sup>11</sup> He simultaneously acknowledged why traditional principles viewed Netcom, Inc.'s conduct as infringing, along with the need under the circumstances to adopt new standards:

It is not difficult to conclude that Erlich infringes by copying a protected work onto his computer and by posting a message to a newsgroup. However, plaintiffs' theory further implicates a Usenet server that carries Erlich's message to other servers regardless of whether that server acts without any human intervention beyond the initial setting up of the system. It would also result in liability for every single Usenet server in the

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5. See *Religious Tech. Ctr. v. Netcom On-Line Commc'n Servs., Inc.*, 923 F. Supp. 1231, 1247 n.18 (N.D. Cal. 1995).

6. *Netcom*, 907 F. Supp. at 1365–66.

7. *Id.* at 1366.

8. *Id.* at 1367.

9. 839 F. Supp. 1552, 1554 (M.D. Fla. 1993). The same plaintiff brought a series of parallel cases, in which it largely prevailed. See *Playboy Enters., Inc. v. Webworld, Inc.*, 968 F. Supp. 1171, 1173 (N.D. Tex. 1997); *Playboy Enters., Inc. v. Russ Hardenburgh, Inc.*, 982 F. Supp. 503, 505 (N.D. Ohio 1997).

10. 857 F. Supp. 679, 687 (N.D. Cal. 1994).

11. Nonetheless, Judge Whyte misconstrued one aspect of this case, as this writer has explored elsewhere. See David Nimmer, *An Odyssey Through Copyright's Vicarious Defenses*, 73 N.Y.U. L. REV. 162 (1998) (dealing with whether an indirect defendant can assert its own fair-use defense or only that of the directly liable defendant). That issue is entirely orthogonal to current concerns.

worldwide link of computers transmitting Erlich's message to every other computer. . . . Although copyright is a strict liability statute, there should still be some element of volition or causation which is lacking where a defendant's system is merely used to create a copy by a third party.<sup>12</sup>

Having articulated that public policy, he held:

Where the infringing subscriber is clearly directly liable for the same act, it does not make sense to adopt a rule that could lead to the liability of countless parties whose role in the infringement is nothing more than setting up and operating a system that is necessary for the functioning of the Internet. . . . Billions of bits of data flow through the Internet and are necessarily stored on servers throughout the network, and it is thus practically impossible to screen out infringing bits from noninfringing bits.<sup>13</sup>

After absolving Netcom, Inc., of direct infringement liability as a matter of law, Judge Whyte held that material facts remained to be resolved concerning the copyright owner's theory of contributory liability.<sup>14</sup>

## B. BUILDING BLOCKS

In the core part of the decision, Judge Whyte framed the question for resolution as "whether possessors of computers are liable for incidental copies automatically made on their computers using their software as part of a process initiated by a third party."<sup>15</sup> His negative answer to that inquiry hinged on the following elements:

- (1) "It is not difficult to conclude that Erlich infringes by copying a protected work onto his computer and by posting a message to a newsgroup."<sup>16</sup>
- (2) But the same reason that ensnares a user does not necessarily apply to higher level actors: "Netcom's act of designing or implementing a system that automatically and uniformly creates temporary copies of all data sent through it" is analogous to a copy shop.<sup>17</sup>
- (3) It goes too far to implicate "a Usenet server that carries Erlich's message to other servers regardless of whether that server acts without any human intervention beyond the initial setting up of the system."<sup>18</sup>
- (4) "There is no need to construe the Act to make all . . . parties, who . . . do no more than operate or implement a system that is essential if Usenet messages are to be widely distributed."<sup>19</sup>

12. *Netcom*, 907 F. Supp. at 1369–70.

13. *Id.* at 1372–73.

14. The basis here was that "it is fair, assuming Netcom is able to take *simple measures* to prevent further damage to plaintiffs' copyrighted works, to hold Netcom liable for contributory infringement where Netcom has knowledge of Erlich's infringing postings yet continues to aid in the accomplishment of Erlich's purpose of publicly distributing the postings. *Id.* at 1375 (emphasis added). As to those italicized words, see *infra* note 171 and accompanying text.

15. *Netcom*, 907 F. Supp. at 1368.

16. *Id.* at 1369.

17. *Id.*

18. *Id.* To the same effect, "Netcom's and Klemesrud's systems can operate without any human intervention." *Id.* at 1368.

19. *Id.* at 1369–70.

- (5) The bottom-line conclusion is: “The court does not find workable a theory of infringement that would hold the entire Internet liable for activities that cannot reasonably be deterred. Billions of bits of data flow through the Internet and are necessarily stored on servers throughout the network and it is thus practically impossible to screen out infringing bits from noninfringing bits.”<sup>20</sup>

The above ends the court’s discussion of *direct liability*. But there is more to the opinion:

- (6) Turning to *vicarious liability*,<sup>21</sup> the opinion concluded, “There is no evidence that infringement by Erlich, or any other user of Netcom’s services, in any way enhances the value of Netcom’s services to subscribers or attracts new subscribers.”<sup>22</sup> The same consideration applied to Klemesrud’s BBS.<sup>23</sup>
- (7) That facet is also relevant to *contributory infringement*.<sup>24</sup> Judge Whyte distinguished the facts at bar from *Sega v. MAPHIA*, which properly held that “a BBS operator is liable for copyright infringement where it solicited subscribers to upload files containing copyrighted materials to the BBS that were available for others to download” when the “defendant solicited the uploading of such programs and received consideration for the right to download files.”<sup>25</sup>

#### INTERVAL: VOLITION OR CAUSATION?

The most influential aspect of *Netcom* arises out of this sentence: “Although copyright is a strict liability statute, there should still be some element of volition or causation which is lacking where a defendant’s system is merely used to create a copy by a third party.”<sup>26</sup> That reference to “volition” has caused tremendous ferment. Its phrasing in the disjunctive (“volition *or* causation”)<sup>27</sup> yields two possibilities: (a) volition is an alternative to causation, such that either suffices; or (b) the two terms are synonymous, and were simply stated repetitiously as a stylistic matter.<sup>28</sup> The rest of the opinion repeatedly returns

20. *Id.* at 1372–73. The opinion continued, “Because the court cannot see any meaningful distinction (without regard to knowledge) between what Netcom did and what every other Usenet server does, the court finds that Netcom cannot be held liable for direct infringement.” *Id.*

21. On the applicable elements for that theory of liability, see the text accompanying note 65 *infra*.

22. *Netcom*, 907 F. Supp. at 1377.

23. The discussion is as follows: “[T]here are no allegations that Klemesrud’s fee, or any other direct financial benefit received by Klemesrud, varies in any way with the content of Erlich’s postings. Nothing in or attached to the complaint states that Klemesrud in any way profits from allowing Erlich to infringe copyrights.” *Id.* at 1382

24. On the applicable elements for that theory of liability, see the text accompanying note 66 *infra*.

25. *Netcom*, 907 F. Supp. at 1371 (citing *Sega Enters. Ltd. v. MAPHIA*, 857 F. Supp. 679, 683 (N.D. Cal. 1994)).

26. *Id.* at 1369–70.

27. When the opinion later reverts back to this theme, it sets forth a second reference, likewise in the disjunctive: “There are no allegations in the complaint to overcome the missing volitional or causal elements necessary to hold a BBS operator directly liable for copying that is automatic and caused by a subscriber.” *Id.* at 1381–82.

28. A third possibility arises to the extent that “*or*” is interpreted to mean “*and*.” Sometimes,

to *causation*,<sup>29</sup> leaving the imputation that *volition* was adduced simply as an alternative locution.

As summarized in a treatise: “Viewed in this fashion, *Netcom* simply stands for the unremarkable proposition that proximate causation historically underlines copyright infringement liability no less than other torts.”<sup>30</sup> In other words, circumstances might arise in which a defendant is the but-for cause of a given act of infringement, but the chain of causation is too remote to support legal responsibility.<sup>31</sup>

## II. DIGITAL MILLENNIUM COPYRIGHT ACT

### A. DRAFT BILL

By 1998, *Netcom* was among only a handful of cases decided in this sphere. In that year, Congress canvassed those authorities as it considered several bills, ultimately resulting in enactment of the Digital Millennium Copyright Act.<sup>32</sup> An essential component of that omnibus legislation was § 512 of the Copyright Act, designed to provide safe harbors from copyright infringement liability for online service providers.<sup>33</sup>

The House Judiciary Committee promulgated an earlier bill that contained only one overarching provision and was less than one page long. The committee commented about that draft:

As to direct infringement, *liability is ruled out for passive, automatic acts engaged in through a technological process initiated by another*. Thus the bill essentially codifies the result in the leading and most thoughtful judicial decision to date: *Religious Technology Center v. Netcom On-Line Communications Services, Inc.* In doing so, it overrules these aspects of *Playboy Enterprises, Inc. v. Frena*, insofar as that case suggests that such acts by service providers could constitute direct infringement, and

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statutes are finely parsed in that manner. *See In re Sunterra Corp.*, 361 F.3d 257, 262 n.9 (4th Cir. 2004). As we will see presently, some courts have elevated *Netcom* to statutory or quasi-constitutional heights. *See infra* note 171 and accompanying text. In that vein, at least one judge interprets the language to be conjunctive rather than disjunctive. *See infra* note 208 and accompanying text.

29. A later portion of the opinion references “the same problem of *causation* as the reproduction argument. Only the subscriber should be liable for *causing* the distribution of plaintiffs’ work . . . .” *Netcom*, 907 F. Supp. at 1372 (emphases added). The same page sets forth two additional occurrences of “causing.” *Id.*

30. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.08[C][1] (Matthew Bender rev. ed. 2019) [hereinafter NIMMER ON COPYRIGHT]; *see also infra* notes 128, 176, 214 and accompanying text.

31. The discussion below will pose some cases of remote causation breaking the chain. *See infra* Intermezzo.

32. Given the paucity of authority as of 1998, the legislative history cited to only a few decisions: *Netcom*, *MAPHIA*, and the *Playboy* cases discussed above. The only other cases that it cited arose in strange postures—one was for unauthorized dissemination over the Internet of a videotape depicting sex between Bret Michaels and Pamela Anderson Lee, *see Michaels v. Internet Entm’t Grp., Inc.*, 5 F. Supp. 2d 823 (C.D. Cal. 1998); the other was for “clip art” used for and by people in the fire service industry, *see Marobie-FL, Inc. v. Nat’l Ass’n of Fire Equip. Distrib.*, 983 F. Supp. 1167 (N.D. Ill. 1997).

33. For the resulting statutory definition regarding those providers, *see infra* note 71.

provides certainty that *Netcom* and its progeny, so far only a few district court cases, will be the law of the land.<sup>34</sup>

That bill would have created immunity whenever “the storage and transmission [are] carried out through an automatic technological process, without any selection of that material by the provider.”<sup>35</sup>

## B. ENACTED LEGISLATION

Nonetheless, that version failed to win enactment. Instead, after proceeding through the House Commerce Committee and then a Joint House-Senate Committee, a rival bill passed into law which covered eleven pages, with four separate safe harbors rather than the overarching one previously promulgated.<sup>36</sup> Accordingly, the earlier characterization of “codification” is inapplicable to the final text of the law.<sup>37</sup> It imposes much more than the earlier bill in the way of conditions for eligibility.<sup>38</sup> Over the course of its many pages, § 512 incorporates elaborate provisions for notice and takedown, designates agents to receive those notices, provides for disqualification when a “red flag” is waving,<sup>39</sup> and much more.<sup>40</sup>

## C. DIFFERENCES FROM *NETCOM* ELEMENTS

Let us examine how this enactment affects the elements that underlay Judge Whyte’s decision.<sup>41</sup> *Netcom* element (1), holding the direct uploader culpable for copyright infringement, remains undisturbed.

Turning to *Netcom* element (2), the fact that a system creates copies “automatically” can no longer be viewed as negating liability for copyright infringement. Instead, Congress engaged in its own calibrated analysis of how to

34. H.R. REP. NO. 105-551, pt. 1, at 15 (1998), <https://perma.cc/X942-KTPU> (emphasis added) (citations omitted).

35. H.R. 2281, 105TH CONG. § 202 (1998), <https://perma.cc/B79U-44HY>.

36. 17 U.S.C. § 512 (2019). For an analysis of the bill’s progress through these stages, see David Nimmer, *Appreciating Legislative History*, 23 CARDOZO L. REV. 909 (2002) [hereinafter Nimmer, *Appreciating Legislative History*].

37. As this author has previously written:

The potential problems are threefold. First, some features of the final act were completely lacking when the Judiciary and Commerce Committees finalized their consideration. Second, even with respect to features of the law that trace their genealogy back to the subject report, the final language does not necessarily track. Finally, even if the language of a given feature does ultimately follow through to the Digital Millennium Copyright Act, the meaning may be different in the context of a law containing vastly more provisions than the bill then under consideration.

Nimmer, *Appreciating Legislative History*, supra note 36, at 925.

38. See *CoStar Grp., Inc. v. LoopNet, Inc.*, 373 F.3d 544, 554 n.\* (4th Cir. 2004) (“Unlike the earlier version, which would have exempted ISPs unconditionally for direct liability for automatic processes, the enacted law requires ISPs to fulfill certain ‘conditions for eligibility’ for the safe harbors.”).

39. See *infra* note 57.

40. A discussion of all reported cases arising under 17 U.S.C. § 512 in NIMMER ON COPYRIGHT, supra note 30, ch. 12B, currently runs over 200 pages.

41. See supra notes 16–25 and accompanying text.

treat automatic copying. To illustrate, let us examine the caching safe harbor.<sup>42</sup> Rather than viewing non-volitional conduct as a bar at the outset preventing the plaintiff from establishing a *prima facie* case, Congress defined copying that occurs “automatically” as a first step that constitutes infringement but also weighs into the calculus of this new safe harbor. Specifically, Congress provided immunity assuming that a host of requirements were met: One among those many factors was that the storage be “carried out through an automatic technical process for the purpose of making the material available to users of the system or network who . . . request access to the material from the” party who posted it.<sup>43</sup>

That statutory language is crucial.<sup>44</sup> It means that those who engage in an “automatic technical process” have satisfied one element to take advantage of the caching safe harbor—but they still fail to qualify unless they meet all the other elements, including refreshing the cached materials, transmitting hit counts, observing standard communications protocols, and so forth.<sup>45</sup> To consider an “automatic technical process” sufficient by itself to negate liability for copyright infringement is to short-circuit the six other requirements that Congress painstakingly drafted into the law.<sup>46</sup> Instead, those who facilitate access to copies through automatic technical processes have committed a *prima facie* case of copyright infringement<sup>47</sup>—to which the caching safe harbor arises as an affirmative defense, if all of its elements are satisfied.<sup>48</sup>

Congress was capable of dispensing with all those other ingredients (refreshing materials, hit counts, standard protocols, etc.). Indeed, the heart of the House Judiciary Committee’s earlier bill was its immunity for activities “carried out through an automatic technological process.”<sup>49</sup> However, the full Congress rejected that alternative and instead adopted legislation incorporating all the requirements just mentioned. The rejected approach cannot now be adopted as governing law.<sup>50</sup>

*Netcom* element (3) represents the flip side of element (2): Liability extends not to “automatic” activities but only to those involving “human intervention beyond the initial setting up of the system.”<sup>51</sup> Judge Whyte pronounced that distinction to

42. 17 U.S.C. § 512(b) (2018).

43. 17 U.S.C. § 512(b)(1)(C) (2018).

44. It bears adding that Congress equally referenced an “automatically technical process” in the first safe harbor. 17 U.S.C. § 512(a)(2) (2018). The tally is therefore that the final legislation uses the word “automatic” in two of the safe harbors and omits any comparable reference in the other two.

45. 17 U.S.C. § 512(b)(2) (2018).

46. See 17 U.S.C. §§ 512(b)(1)(A), 512(b)(1)(B), 512(b)(2)(A)–512(b)(2)(E) (2018).

47. What about Judge Whyte’s “copy shop” analogy in element (2)? As we will see, the Supreme Court later debunked it. See *infra* text accompanying note 122.

48. If facilitating an “automatic technical process” altogether exonerated a party from liability for the *prima facie* case of copyright infringement, then there would be no cause to reach any affirmative defense. It accordingly renders otiose the subject language in the safe harbor referencing an “automatic technical process.” That construction is to be disfavored. See *Duncan v. Walker*, 533 U.S. 167, 167 (2001) (describing court’s “duty to give effect, where possible, to every word of a statute”).

49. See *supra* Part II.A.

50. See, e.g., *Russello v. United States*, 464 U.S. 16, 23–24 (1983) (“When Congress includes limiting language in an earlier version of a statute but deletes it prior to enactment of the statute, it may be presumed that the limitation was not intended.”).

51. *Religious Tech. Ctr. v. Netcom On-Line Commc’n Servs., Inc.*, 907 F. Supp. 1361, 1369 (N.D.

address the user-uploaded content at issue in that case. When Congress codified that safe harbor, by contrast, it included no *Netcom*-like provision making liability dependent on human intervention. Instead, the safe harbor sets forth an affirmative defense for service providers who make user-posted material available to the public<sup>52</sup> under specified circumstances that arise independently of “human intervention.”<sup>53</sup> Contrary to *Netcom*, the legislative history expressly sets forth that Congress contemplated liability for copyright infringement, and hence the need to afford an affirmative defense, for storing material uploaded by third parties “regardless of whether that server acts without any human intervention beyond the initial setting up of the system.”<sup>54</sup> Specifically, with regard to the linking safe harbor,<sup>55</sup> the reports singled out Yahoo! as the service that then constituted the Internet’s primary search engine, commenting, “Directories such as Yahoo!’s usually are created by people visiting sites to categorize them. It is precisely the *human judgment* and editorial discretion exercised by these cataloguers which makes directories valuable.”<sup>56</sup> That pronouncement stands in marked contrast with the perspective of Judge Whyte, who in 1995 contemplated liability if human intervention was present beyond initially setting up the system. It shows that Congress chose a different expedient in 1998—it legislated a safe harbor that prevails even in the presence of human intervention (unless the circumstances indicate that a “red flag” was waving or that another statutorily prescribed feature was present that would sacrifice the safe harbor).<sup>57</sup>

As to *Netcom* element (4), Judge Whyte concluded as of 1995 that it was necessary to exonerate from infringement liability those who “do no more than operate or implement a system that is essential if Usenet messages are to be widely distributed.”<sup>58</sup> But when Congress passed the law three years later, it concluded the opposite—it decided to add four safe harbors to the statute precisely to protect those same operators, who otherwise would be found culpable of copyright infringement:

[W]ithout clarification of their liability, service providers may hesitate to make the necessary investment in the expansion of the speed and capacity of the Internet. In the ordinary course of their operations *service providers must engage in all kinds of acts that expose them to potential copyright infringement liability*. For example, service providers must make *innumerable electronic copies by simply transmitting information over the Internet*. Certain electronic copies are made to *speed up the delivery of information to users*. Other electronic copies are made in order to *host World Wide Web sites*. Many service providers engage in *directing users to sites in response to inquiries by users* or they volunteer sites that users may find attractive. *Some of these sites might contain infringing material*. In short, by limiting the liability of service

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Cal. 1995).

52. 17 U.S.C. § 512(c)(1) (2018).

53. 17 U.S.C. §§ 512(c)(1)(A)-(C), (c)(2)-(3) (2018).

54. *Netcom*, 907 F. Supp. at 1369. That quotation forms the backbone of *Netcom* element (3). See *supra* text accompanying note 18.

55. 17 U.S.C. § 512(d) (2018).

56. H.R. REP. NO. 105-551, pt. 2, at 58 (1998) (emphasis added); S. REP. NO. 105-190, at 49 (1998) (emphasis added).

57. See 17 U.S.C. § 512(c)(1)(A)(ii) (2018). The “red flag” terminology comes from the legislative history. H.R. REP. NO. 105-551, pt. 2, at 53 (1998); S. REP. NO. 105-190, at 44 (1998).

58. *Netcom*, 907 F. Supp. at 1369–70.

providers, the DMCA ensures that the efficiency of the Internet will continue to improve and that the variety and quality of services on the Internet will continue to expand.<sup>59</sup>

The reference to services “hosting Web sites” that “might contain infringing material,” thereby causing those services to “engage in all kinds of acts that expose them to potential copyright infringement liability,” reflects a regime that is the polar opposite from the one *Netcom* tried to erect. In the final order, it is the word of Congress that governs.

In terms of *Netcom* element (5), considering technology extant as of 1995, Judge Whyte understandably did not wish to adopt “a theory of infringement that would hold the entire Internet liable for activities that cannot reasonably be deterred.”<sup>60</sup> Given the tools at his disposal, he did not have a way to craft appropriate relief, as it was then “practically impossible to screen out infringing bits from noninfringing bits.”<sup>61</sup> But Congress’s arsenal for crafting relief is incomparably larger than that of any judge. As part of § 512, it legislated an elaborate scheme that includes

- placing the onus on copyright holders to serve, in minute particulars, takedown notices to identify infringing content;
- placing the onus on service providers to record with the Copyright Office the names and addresses of agents authorized to receive those takedown notices;
- allowing affected copyright owners to serve counter-notifications, to the extent they wish to contest the allegations of those takedown notices;
- obligating service providers to react expeditiously to takedown notices in order to safeguard copyrighted material, including a “putback” provision in the event of a proper counter-notification;
- mandating the filing of those various notices under penalty of perjury, along with new punishments applicable to those who willfully make false statements in those notifications and counter-notifications;
- articulating applicable requirements for courts to issue subpoenas requiring services to identify unknown users, so that they can be sued;
- and on and on.<sup>62</sup>

In short, Congress incorporated into § 512 the mechanism, which Judge Whyte lacked, “to screen out infringing bits from noninfringing bits.”<sup>63</sup> It created the framework, which again did not exist in 1995, to deter infringing conduct, precisely so that judges would no longer face the unpalatable choice to “hold the entire Internet liable for activities that cannot reasonably be deterred.”<sup>64</sup> The world of § 512 rotates in an entirely different solar system from the one that Judge Whyte inhabited three years before the statute’s enactment.

Moving now to the final *Netcom* elements, which dealt with indirect liability,

59. S. REP. NO. 105-190, at 8 (1998) (emphases added).

60. *Netcom*, 907 F. Supp. at 1372; see also *supra* Part I.B.

61. *Netcom*, 907 F. Supp. at 1372–73; see also *supra* Part I.B.

62. An exhaustive analysis is set forth in 4 NIMMER ON COPYRIGHT, *supra* note 30, ch. 12B.

63. *Netcom*, 907 F. Supp. at 1373; see also *supra* Part I.B.

64. *Netcom*, 907 F. Supp. at 1372; see also *supra* Part I.B.

Congress revamped those aspects as well. Specifically, element (7) concerned vicarious liability, the two components of which at common law were financial interest in the exploitation of copyrighted materials and the right and ability to supervise the infringing conduct.<sup>65</sup> Element (8) dealt with contributory infringement, the two components of which at common law were material contribution to the infringing conduct and knowledge of the infringing conduct.<sup>66</sup> Section 512 judiciously adopted selected ingredients from each of those common law doctrines, forfeiting protection for those who “receive a financial benefit directly attributable to the infringing activity, in a case in which the service provider has the right and ability to control such activity,”<sup>67</sup> as well as for those who had actual knowledge of the infringing conduct or, failing actual knowledge, proceeded in the face of a “red flag.”<sup>68</sup>

But there is also a significant difference in the legislation as passed from the previous doctrines of indirect responsibility at common law: In the world in which *Netcom* arose, a defendant charged with indirect liability who defeated either component of vicarious liability and contributory infringement prevailed outright. By contrast, when § 512 selectively adopted aspects of those common law doctrines, it did so in a new form—it provided that they would no longer serve as a complete defense, but instead would afford a safe harbor limiting available remedies. Accordingly, a defendant who finds shelter under any of the safe harbors is still subject to adverse judgment along with limited injunctive relief,<sup>69</sup> but is not subject to any monetary payment.<sup>70</sup>

#### D. GOVERNING LAW

The synopsis set forth above demonstrates that Congress accepted some conclusions from *Netcom* (for example, holding the individual uploader liable), modified some (for example, regarding indirect liability), and rejected others (for example, the impossibility of screening out infringing bits from non-infringing bits). More importantly, it shows that Congress erected its own elaborate and distinctive structure to govern in this domain. As salutary as the early judicial efforts were, Congress charted its own course to govern the liability of copyright infringement for online service providers that provide access to material uploaded by third parties.<sup>71</sup>

Collectively, the legislative departures from *Netcom*'s ruling in no way imply

65. See *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307 (2d Cir. 1963).

66. See *Gershwin Publ'g Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971).

67. 17 U.S.C. § 512(c)(1)(B) (2018).

68. 17 U.S.C. § 512(e)(1)(A)(i)–(ii) (2018); see also *supra* note 57.

69. The scope of injunctive relief against service providers that qualify for any of the safe harbors is highly circumscribed. See 17 U.S.C. § 512(j) (2018).

70. Each of the four safe harbors establishes that a qualifying “service provider shall not be liable for monetary relief.” 17 U.S.C. § 512(a)–(d) (2018).

71. The first safe harbor, aimed at transmission, is limited to ISPs. See 17 U.S.C. § 512(k)(1)(A) (2018). The final three are broader, encompassing both ISPs and OSPs, namely any “provider of online services or network access, or the operator of facilities therefor.” 17 U.S.C. § 512(k)(1)(B) (2018).

criticism of Judge Whyte. Instead, they reflect that the options open to common law judges are few, whereas the tableau on which Congress can craft legislative distinctions is vast. The fine result reached by a district judge in one of the first cases to be decided in the field, limited to one set of facts, in no way constrained Congress from crafting for the future the best and most comprehensive scheme that it could construct for the entire field.

### III. FOURTH CIRCUIT: *COSTAR*

The succeeding decades after the enactment of § 512 witnessed scores of cases posing the same basic character types as were present in *Netcom*: A copyright owner (*C*) objected to the uploading of its material by a user (*U*), to an online service provider (OSP) connected to the world via an ISP, by which all connected viewers (*V*s) could access the proprietary material.<sup>72</sup> To give the cast of characters distinctive initials, *C* (Religious Technology Center) objected to the uploading by *U* (Erlich) to an OSP (Klemesrud) connected to the world via an ISP (Netcom), by which all connected *V*s could access the material. With evolving technologies, the targeted OSPs largely evolved from the BBS at issue in *Netcom* to websites, and ISPs became universal, as opposed to the Netcoms and AOLs of earlier times,<sup>73</sup> such that every large university, corporation, non-profit, government agency, and others afforded access to the Internet.<sup>74</sup>

To illustrate with prominent examples from the Second and Ninth Circuits, Viacom (*C*) filed suit after various users (*U1*, *U2*, etc.) uploaded episodes and clips from *Family Guy*, *The Daily Show*, and *South Park*, to YouTube (OSP), by which countless individuals (*V1*, *V2*, etc.) could watch those works.<sup>75</sup> By the same token, UMG (*C*) filed suit after various users (*U1*, *U2*, etc.) uploaded recordings by 50 Cent, Avril Lavigne, and Britney Spears, to Veoh, Inc. (OSP), by which countless individuals (*V1*, *V2*, etc.) could listen to those works.<sup>76</sup> In those and countless other suits, no argument arose based on *Netcom*'s volition language;<sup>77</sup> instead, the parties litigated the myriad complex features incorporated into the DMCA's legislative scheme.<sup>78</sup>

The exception, during the first decade after the enactment of the DMCA, was the Fourth Circuit. An opinion by Judge Niemeyer cited to the outdated legislative

72. More precisely than "viewers," those exposed to Hubbard's writings were "readers"; in the case brought by UMG, cited *infra* note 76, those individuals were "listeners." The first term is used here for the sake of uniformity and simplicity.

73. But a case from 2017 returns us to the same Usenet as was at issue in *RTC v. Netcom*. See *infra* Part VI.A.

74. As will be seen below, later plaintiffs focused their fire on OSPs, rather than on ISPs.

75. *Viacom Int'l, Inc. v. YouTube, Inc.*, 676 F.3d 19 (2d Cir. 2012).

76. *UMG Recordings, Inc. v. Shelter Capital Partners LLC*, 718 F.3d 1006 (9th Cir. 2013).

77. Neither of the foregoing cases cites *Netcom* or mentions "volition"; at issue in them were such issues as whether the "red flag" was waving. See *supra* note 57.

78. See *supra* note 40.

history from the House Judiciary Committee<sup>79</sup> regarding *Netcom*,<sup>80</sup> a later opinion in *CoStar Group, Inc. v. LoopNet, Inc.*, also by Judge Niemeyer, acknowledged that error, but continued to proceed as though Congress had codified both *Netcom* and *Playboy v. Frena*.<sup>81</sup> But the important point about those two decisions is that other jurisdictions failed to follow the Fourth Circuit's lead—until the law took a sharp turn at the end of that decade. We reach that 2008 case next.

#### INTERLUDE: VOLITION (A)

We have seen that *Netcom* used the locution “volition or causation” to refer to the latter—but *CoStar* reversed the polarity: Although it mentioned *causation* in passing, the bulk of its analysis inhered in *volition*.<sup>82</sup> That approach enjoys some support among commentators, as well.<sup>83</sup>

### IV. SECOND CIRCUIT

#### A. CABLEVISION

In 2008, the Second Circuit confronted a case falling outside the above framework of Internet exploitation; absent any OSP or any user who uploaded material to be seen by third party viewers, the court had no occasion to invoke § 512. Instead, copyright owners sued the very cable company that was licensed to rebroadcast its television programs over cable channels,<sup>84</sup> alleging that the defendant exceeded its licensed authority by affording viewers a remote-storage digital video recorder (RS-DVR).<sup>85</sup> That RS-DVR was a digital successor to the analog Sony Betamax, a video cassette recorder (VCR) which the Supreme Court determined to be non-infringing in its first case interpreting the current Copyright Act.<sup>86</sup> But the issues posed in this later guise concerned aspects not addressed in that earlier ruling.<sup>87</sup>

79. As described above, the ultimate legislation discarded that approach, in favor of the alternative approach favored by the House Commerce Committee. See *supra* Part II.B.

80. *ALS Scan, Inc. v. RemarQ Cmty., Inc.*, 239 F.3d 619, 620 (4th Cir. 2001).

81. *CoStar Grp., Inc. v. LoopNet, Inc.*, 373 F.3d 544, 553–54 (4th Cir. 2004).

82. *Id.* at 556.

83. According to one scholar, “‘volition’ has become an established feature of copyright law despite the grumblings of treatise writers.” Robert C. Denicola, *Volition and Copyright Infringement*, 37 CARDOZO L. REV. 1259, 1295 (2016). But there may be less to this disagreement than meets the eye. See *infra* note 229.

84. *Cartoon Network, LP v. CSC Holdings, Inc. (Cablevision)*, 536 F.3d 121, 124 (2d Cir. 2008), *cert. denied*, *Cable News Network, Inc. v. CSC Holdings, Inc.*, 557 U.S. 946 (2009).

85. The *Netcom* line of cases involved *C* filing suit after *U1*, *U2*, etc. uploaded material to an OSP to allow *V1*, *V2*, etc. to watch those works; by contrast, in this case, *C* filed suit against a cable provider licensed by *C*, but who allowed *V1*, *V2*, etc. to record individual episodes and themselves watch those episodes later.

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

87. In the earlier case, the Supreme Court addressed two issues: indirect liability for a staple article of commerce, *id.* at 434–42, and fair use via time-shifting, *id.* at 447–56. In the later case, by contrast, the parties stipulated to present neither of those issues, instead limiting themselves to the question of whether a *prima facie* case of direct liability existed. See *Twentieth Century Fox Film Corp. v. Cablevision Sys. Corp.*, 478 F. Supp. 2d 607, 616 (S.D.N.Y. 2007), *rev'd sub nom.* *Cartoon Network, LP v. CSC Holdings*,

Judge Walker followed the above Fourth Circuit authority to uphold *Netcom* as “a particularly rational interpretation” of general copyright principles.<sup>88</sup> Turning to particulars, the complaint alleged violation of two rights belonging to the copyright owners: reproduction and public performance. As to reproduction, the court ruled in the defendant’s favor expressly based on a purported absence of volition:

When there is a dispute as to *the author of an allegedly infringing instance of reproduction*, *Netcom* and its progeny direct our attention to the volitional conduct that causes the copy to be made. There are only two instances of volitional conduct in this case: Cablevision’s conduct in designing, housing, and maintaining a system that exists only to produce a copy, and a customer’s conduct in ordering that system to produce a copy of a specific program. In the case of a VCR, it seems clear—and we know of no case holding otherwise—that the operator of the VCR, *the person who actually presses the button* to make the recording, supplies the necessary element of volition, not the person who manufactures, maintains, or, if distinct from the operator, owns the machine. We do not believe that an RS-DVR customer is sufficiently distinguishable from a VCR user to impose liability as a direct infringer on a different party for copies that are made automatically upon that customer’s command.<sup>89</sup>

Turning to public performance, Cablevision raised two defenses—the first was the same volition argument just considered,<sup>90</sup> and the second maintained that any performance was private.<sup>91</sup> To schematize, the first argument claimed absence of a *performance*, the second that it did not qualify as *public*. The Second Circuit addressed only the latter,<sup>92</sup> which it likewise resolved in the defendant’s favor.<sup>93</sup>

## B. *AEREO*

Media mogul Barry Diller and others studied that decision closely.<sup>94</sup> Under their

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Inc. (*Cablevision*), 536 F.3d 121 (2d Cir. 2008).

88. *Cablevision*, 536 F.3d at 131.

89. *Id.* at 131 (emphases added).

90. *Id.* at 126 (“Cablevision contended, however, that the work was performed not by Cablevision, but by the customer, an argument the district court rejected ‘for the same reasons that [it] reject[ed] the argument that the customer is ‘doing’ the copying involved in the RS-DVR.’”).

91. *Id.* (“Cablevision also argued that such a playback transmission was not ‘to the public,’ and therefore not a public performance as defined in the Copyright Act.”).

92. *Id.* at 134 (“We need not address Cablevision’s first argument further because, even if we assume that Cablevision makes the transmission when an RS-DVR playback occurs, we find that the RS-DVR playback, as described here, does not involve the transmission of a performance ‘to the public.’”).

93. *Id.* at 135.

94. To quote from another case:

Plaintiff Barry Diller is a famous businessman and entrepreneur who was once the Chairman and CEO of Paramount Pictures Corp. and Chairman and CEO of Fox, Inc., and is now the Chairman and Senior Executive of IAC/InterActiveCorp., Expedia, Inc., and TripAdvisor, Inc. At Plaintiff’s direction, IAC backed an internet-based broadcast television technology platform offered by a company called Aereo, Inc., which offers its service in the New York metropolitan area and may expand into Los Angeles.... On the website, Defendants used the graphic of a fit, shirtless man holding a drill in one hand. Plaintiff believes the name “Barry Driller” was chosen because of Plaintiff’s involvement with Aereo’s internet broadcasting service; Defendant David even noted in a news article that he chose the name as a “homage to a great guy” — i.e., Plaintiff Barry Diller.

tutelage, a company named Aereo, Inc., offered the same functionality as Cablevision, Inc., to viewers, but over the Internet rather than via cable. The resulting case of *WNET v. Aereo, Inc.* wended its way back to the Second Circuit.<sup>95</sup> Instead of an RS-DVR, viewers who logged onto Aereo’s website could either take advantage of “the ‘Watch’ function” to see the show live or press “the ‘Record’ button” in order “to save a copy of the program for later viewing.”<sup>96</sup> The ultimate results for viewers were the same as afforded by the prior technology.

At issue in this instance was only the public performance right.<sup>97</sup> The panel resolved the matter before it on the authority of its 2008 precedent. The decision ran through the analysis of *Cablevision* at exhaustive length as controlling resolution of this case.<sup>98</sup> Considering one of the plaintiffs’ argument to distinguish that ruling, the majority made a linchpin of its rebuttal the fact that viewers exercise “volitional control over how the copy is played.”<sup>99</sup> That resolution is scarcely surprising—both *Aereo* and *Cablevision* involved non-party viewers who pressed a button, which efficiently caused the harm about which the plaintiffs complained.<sup>100</sup>

#### INTERMISSION: VOLITION (B)

How much volition does the law require? *Netcom*’s germinal statement begins by acknowledging that “copyright is a strict liability statute.”<sup>101</sup> We can thus envision a spectrum. At the lowest end is strict liability; from there, culpability rises through negligence to wantonness to willfulness, culminating at the other end with malice aforethought.

If the low end requires more than pushing a button—as the Second Circuit ruled in both the above cases—then the high end must demand geometrically more. One would thereby imagine that first degree murder via a gun can be

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Diller v. Barry Driller, Inc., No. CV 12–7200, 2012 WL 4044732 (C.D. Cal. Sept. 10, 2012) (citations omitted).

95. 712 F.3d 676 (2d Cir. 2013). Was molding the technology to fit the *Cablevision* decision visionary craftsmanship or shoddy evasion of the law? It depends on one’s perspective. The dissent derided Aereo’s so-called “technology platform” as “a sham,” continuing: “[I]ndeed, the system is a Rube Goldberg-like contrivance, over-engineered in an attempt to avoid the reach of the Copyright Act and to take advantage of a perceived loophole in the law.” *Id.* at 697 (Chin, J., dissenting). The Second Circuit majority took the contrary perspective. It can be added that Judge Chin, when sitting as a district judge, authored the *Cablevision* decision below, which the Second Circuit reversed. In this later case, after his elevation, he dissented from the majority’s ruling.

96. *Id.* at 681 (majority opinion).

97. *Id.* at 684–86.

98. *Id.* at 686–94.

99. *Id.* at 692. A footnote belabors that focus. After first conceding that “an Aereo user in ‘Watch’ mode will often not exercise volitional control over the playback of the program,” it concludes, “that is not significant because the Aereo user can exercise such control if he wishes to.” *Id.* at 692 n.14.

100. A fascinating sidelight is that more Second Circuit judges opposed the *Aereo* decision than supported it—the majority consisted of Circuit Judge Droney and District Judge Gleeson, with Circuit Judge Chin in dissent. *Id.* at 679. At the next stage, an additional circuit judge joined the latter’s camp. See *WNET v. Aereo, Inc.*, 722 F.3d 500, 501 (2d Cir. 2013) (Chin & Wesley, JJ., dissenting from the denial of rehearing *en banc*).

101. *Religious Tech. Ctr. v. Netcom On-Line Commc’n Servs., Inc.*, 907 F. Supp. 1361, 1370 (N.D. Cal. 1995).

committed exclusively by those who physically pull the trigger. Indeed, as we are now dealing with the other end of the spectrum, the requirement may go even further—perhaps the defendant must have designed and manufactured the gun in question.

Yet criminal law is precisely to the contrary. U.S. prisons are filled with convicted “murderers” located nowhere near the subject gun or even the crime scene—such as those who drove the getaway car for a botched bank robbery, in which someone ended up getting shot.<sup>102</sup>

The Model Penal Code defines murder as taking place when “it is committed recklessly under circumstances manifesting extreme indifference to the value of human life.”<sup>103</sup> Both *Cablevision, Inc.*, and *Aereo, Inc.*, deliberately engineered systems, replete with remotes or apps, designed to facilitate unauthorized viewing of third party content. Transposing the above language to the copyright context, they “manifested extreme indifference to the value of copyrighted content.” Without needing to conclude that they thereby satisfied the highest level of volition, it should be beyond question that they satisfied the lowest level—which is all that even *Netcom* required.

In short, the Second Circuit’s holdings in the above cases, by limiting liability to the human being who pushes the button, created a more exacting standard than actually applies to first degree murder. It is impossible to reconcile that approval with a “strict liability offense.”

## V. SUPREME COURT REVERSAL OF *AEREO*

### A. MAJORITY

The Supreme Court accepted review of *Aereo*. At that juncture, both aspects of the copyright owner’s rights became live—to prevail, the plaintiffs needed to convince the Court that *Aereo, Inc.*, *performed* their works and that it did so *publicly*. The former matter therefore returns us to the issue, bracketed by the Second Circuit’s decision in *Cablevision*, of whether the defendant service or the viewer is the party culpable of infringing the public performance right. But that question regarding the *performance* right returns us to the coordinate issue in *Cablevision* under the *reproduction* right, in which Judge Walker pinned all responsibility on the viewer who pushed the button, absolving the defendant of liability.

The Supreme Court reversed.<sup>104</sup> To do this, it had to answer both questions adversely to the defendant. Specifically, it concluded not only that the performance in question was public,<sup>105</sup> but also that “when *Aereo* merely supplies equipment that

102. See *Fernandez v. State*, 730 So. 2d 277, 279 (Fla. 1999) (“Abreu drove a getaway car in which he waited a few blocks from the crime scene and then transported the perpetrators to his apartment,” for which he “received a life sentence.”).

103. MODEL PENAL CODE § 210.2(b) (AM. LAW INST. 1962).

104. *Am. Broad. Cos. v. Aereo, Inc.*, 573 U.S. 431 (2014).

105. As a subsidiary aspect of whether the matter unfolded “publicly,” the opinion investigated whether “*Aereo*’s subscribers receive performances in their capacities as owners or possessors of the underlying works.” *Id.* at 448. In explicating that aspect, the majority invoked a distinction between car

allows others [to transmit copyrighted works,] the Act is unmistakable: An entity that engages in activities like Aereo’s performs.”<sup>106</sup> That holding is eminently reasonable—both Cablevision, Inc., and Aereo, Inc., invested millions of dollars to engineer a system for the express and only purpose of creating copies of television programming, the vast bulk of which is subject to third parties’ subsisting copyright protection; they furnished to their customers remote controls (Cablevision, Inc.) or apps (Aereo, Inc.) outfitted with a button that, when pressed, caused those copyrighted works to be exploited. As such, it is only logical to identify the responsible entity as those organizations.

One must hasten to add that this conclusion does not disturb the Second Circuit’s conclusions, in both *Cablevision* and *Aereo*, that the home viewers who caused the transmission themselves behaved culpably.<sup>107</sup> Rather, Justice Breyer ruled for the majority that “both the broadcaster and the viewer of a television program ‘perform,’ because they both show the program’s images and make audible the program’s sounds.”<sup>108</sup> But, unlike the two Second Circuit decisions that limited liability to “the person who actually presses the button,” it treated those individuals as jointly culpable with the corporate service that set up the entire system to facilitate their conduct.<sup>109</sup>

## B. DISSENT

Justice Scalia dissented.<sup>110</sup> He invoked what he termed “a simple but profoundly important rule: A defendant may be held directly liable only if it has engaged in volitional conduct that violates the Act.”<sup>111</sup> His dissent purported to root the matter in both text and precedent. On the first score, it averred, “This requirement is firmly grounded in the Act’s text, which defines ‘perform’ in active, affirmative terms: One ‘perform[s]’ a copyrighted ‘audiovisual work,’ such as a movie or news broadcast, by ‘show[ing] its images in any sequence’ or ‘mak[ing] the sounds accompanying it

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dealerships and valet parking attendants. *Id.* at 448–49. We return below to those aspects. *See infra* notes 228–229.

106. 573 U.S. at 438–39. It later formulated the matter thusly: “We conclude that Aereo is not just an equipment supplier and that Aereo ‘perform[s].’” *Id.* at 444.

107. We thereby return to *Netcom* element (1). *See supra* Part I.B.

108. *Aereo*, 573 U.S. at 451.

109. *Cf.* Rebecca Giblin & Jane C. Ginsburg, *We (Still) Need to Talk About Aereo: New Controversies and Unresolved Questions After the Supreme Court’s Decision*, 38 COLUM. J.L. & ARTS 109, 127 (2015) (“While *Aereo* addressed only the public performance right, the majority’s opinion raises questions about the continued application of the ‘volition’ standard to the reproduction right.”).

110. *Aereo*, 573 U.S. at 453 (Scalia, J., dissenting) (arguing that when “subscribers log in, select a channel, and push the ‘watch’ button,” the result is that “Aereo’s subscribers perform but Aereo does not”). The majority’s “both/and” ruling is directly to the contrary—which certainly does not exonerate those individuals from liability. *Id.* at 444 (majority opinion) (noting that viewers “click on a Website” in order to “activate[] machinery that intercepts and reroutes [television signals] to Aereo’s subscribers over the Internet”).

111. *Id.* at 453 (Scalia, J., dissenting). *But cf.* Denicola, *supra* note 83, at 1260 (“Justice Scalia’s ‘profoundly important rule,’ however, is hardly an accepted bedrock of copyright law. As Scalia himself admitted, the Supreme Court had never previously used the word ‘volition’ in the context of copyright infringement.”).

audible.”<sup>112</sup> On inspection, that claim fails. One can *show* or *make audible* material across the full range of human conduct—it can be done maliciously, willfully, recklessly, negligently, accidentally, inadvertently, et cetera.<sup>113</sup> There is no textual warrant for Justice Scalia’s characterization.

In terms of precedent, Justice Scalia added: “Every Court of Appeals to have considered an automated-service provider’s direct liability for copyright infringement has adopted that rule.”<sup>114</sup> As support, he adduced three cases. One is *Cablevision*, which the dissent cites over a half-dozen times in total; that case is the lineal ancestor to the very opinion that the majority reversed, which no longer stands as good law for the reasons explored above.<sup>115</sup> The other two are *CoStar*, considered above,<sup>116</sup> and *Fox Broadcasting Co. v. Dish Network LLC*.<sup>117</sup> Those rulings by the Fourth and Ninth Circuits, respectively, both embody the same faulty logic as *Cablevision*: namely, the rejected proposition that only the human being who pushed the button incurs liability, not the entity that laboriously constructed the entire system to facilitate that copying.<sup>118</sup> In sum, although the dissent accurately summarizes past cases, none survives the majority’s adoption in *Aereo* of “both/and” liability.

### C. REJECTION OF COPY SHOPS ANALOGY AND OF “AUTOMATIC” IMMUNITY

One of the dissent’s bases was the similarity of the defendant’s activities to a copy shop.<sup>119</sup> It will be recalled that Judge Whyte invoked that analogy to deny Netcom’s

112. *Aereo*, 573 U.S. at 453 (Scalia, J., dissenting) (quoting 17 U.S.C. § 101).

113. A search on Google Books shows scores of hits just for the two-word phrase “accidentally show.” The following, contemporary with adoption of the Copyright Act, is typical: “Caution the spectators that they must always be very careful not to accidentally show the torn pieces concealed in their hand as they unfold the napkin.” MARK WILSON, MARK WILSON’S COMPLETE COURSE IN MAGIC 307 (1975).

114. *Aereo*, 573 U.S. at 453 (Scalia, J., dissenting).

115. Justice Breyer specifically cites *Cablevision* as the “prior Circuit precedent” on which the divided panel below relied. *Id.* at 438 (majority opinion).

116. *See supra* note 81.

117. 747 F.3d 1060, 1066–68 (9th Cir. 2014). This case represents a variant of *Cablevision*, in which a cable company that had a licensing relationship with the plaintiff copyright owners exceeded the scope of the license when it offered its viewers the opportunity for delayed viewing of the shows that they were entitled to see when broadcast live.

118. The Fourth Circuit’s ruling in *CoStar* relies on the proposition that a service provider “who owns an electronic facility that responds automatically to users’ input is not a direct infringer.” *CoStar Grp., Inc. v. LoopNet, Inc.*, 373 F.3d 544, 550 (4th Cir. 2004). “Because LoopNet, as an Internet service provider, is simply the owner and manager of a system used by others who are violating CoStar’s copyrights and is not an actual duplicator itself, it is not *directly* liable for copyright infringement.” *Id.* at 546. Those propositions cannot survive Justice Breyer’s later articulation of “both/and” liability. Similarly, the heart of the Ninth Circuit’s ruling in *Fox* is that:

operating a system used to make copies at the user’s command does not mean that the system operator, rather than the user, caused copies to be made. Here, Dish’s program creates the copy only in response to the user’s command. Therefore, the district court did not err in concluding that the user, not Dish, makes the copy.

*Fox*, 747 F. 3d at 1067.

119. *Aereo*, 573 U.S. at 455 (Scalia, J., dissenting).

liability.<sup>120</sup> Many of the subsequent opinions have returned to that theme. The judges who exonerated defendants characterized their conduct as analogous to a copy shop; correlatively, the judges who concluded the opposite expressly dismissed copy shops as convincing analogues.<sup>121</sup> The analogy, therefore, possesses no independent power; it simply serves to confirm whatever antecedent conclusion has already been reached. In any event, the highest articulation of the copy shop analogy comes in the Supreme Court majority's opinion, which rejects its deployment.<sup>122</sup> This aspect of *Netcom* should therefore be considered a dead letter at present.

Regardless how much of Judge Whyte's "volition or causation" is required under governing law, it is now 100 percent clear that Aereo, Inc., possessed the requisite quantum, even though it responded through an automatic process to user requests over the Internet with no further intervention of its own. There is no longer any room to vindicate the stance that a service provider's automatic response to user requests places it outside of liability.<sup>123</sup>

### INTERMEZZO: CAUSATION

Given that proximate causation can form part of copyright analysis, the possibility exists, even after the Supreme Court's *Aereo* ruling, of immunizing a defendant for conduct that may have transpired over the instrumentalities it owns. Specifically, for a defendant to have a valid defense that it bore no responsibility, the chain of causation would need to be broken. Some hypotheticals illustrate:

- An over-the-airwaves radio station adopts a classical format, broadcasting solely musical compositions written before the twentieth century. The subject music is in the public domain, and there is no performance right in the subject sound recordings;<sup>124</sup> hence, management has correctly concluded that no licenses are required under U.S. copyright law for its public performances. But, one day, armed vandals break into the sound booth bearing new releases, which they proceed to play over the air. In this instance, a lawsuit targeting the station's corporate owner and management would fail—the unanticipated crime that unfolded on that day broke the chain of causation, such that defendants were not proximately responsible

120. We revert here to *Netcom* element (2). See *supra* Part I.B.

121. The Fourth Circuit invoked the analogy in the same manner as Judge Whyte. *CoStar*, 373 F.3d at 550 ("When a customer duplicates an infringing work, the owner of the copy machine is not considered a direct infringer."). District Judge Chin employed the analogy to hold *Cablevision, Inc.*, culpable. *Twentieth Century Fox Film Corp. v. Cablevision Sys. Corp.*, 478 F. Supp. 2d 607, 620 (S.D.N.Y. 2007), *rev'd sub nom. Cartoon Network, LP v. CSC Holdings, Inc. (Cablevision)*, 536 F.3d 121 (2d Cir. 2008). The Second Circuit's reversal analyzed the same cases from the opposite perspective to conclude that "the district court's analogy is flawed." *Cablevision*, 536 F.3d at 131.

122. *Aereo*, 573 U.S. at 443 ("[T]he dissent's copy shop argument, in whatever form, makes too much out of too little.").

123. As opposed to such an automatic rule, it is still possible that there could be an implicit defense in the Copyright Act that applies in certain instances, which service providers could invoke in concrete cases. We consider that aspect below. See *infra* note 218.

124. See 17 U.S.C. § 114(a) (2018).

for any infringement that may have ensued.

- A movie theater shows its patrons only licensed films from its locked projection room. One day, as the projectionist is about to tune to the frequency for the day's licensed Fathom Event, a powerful earthquake rocks the building. As fate would have it, the hapless projectionist's arms flail against the controls, tripping a switch that picks up the "dirty feed" of the Super Bowl,<sup>125</sup> before he is knocked unconscious. In this instance, a lawsuit targeting the theater's corporate owner, management, and projectionist for public performance of the audiovisual depiction of the sporting event would similarly fail—the unanticipated Act of God that unfolded on that day likewise broke the chain of causation, such that defendants were not proximately responsible for any infringement that may have ensued.
- On a different register, a company establishes an intranet on which to store its internal documents. Unbeknownst to the company, hackers defeat its robust security and invade the space to set it up as a forum on which to store infringing material and make it available to others. Again, in this instance, a lawsuit targeting the company should fail. The unanticipated breach, like the ones set forth above, broke the chain of causation such that the company was not proximately responsible for the unanticipated infringement that happened to take place over its facilities, without its knowledge, cooperation, or expectation.

## VI. DEFORMING APPLICATIONS

### A. *PERFECT 10 v. GIGANEWS*

#### 1. Application of *Aereo*

In *Perfect 10, Inc. v. Giganews, Inc.*, the plaintiff alleged that the defendant deliberately provided space for users to upload many millions of copyrighted works (including tens of thousands of images belonging to the plaintiff), knowing that infringement would take place on its facilities and structuring its service to benefit thereby.<sup>126</sup> The district court dismissed the complaint at the pleadings stage insofar as it alleged violation of the public display and distribution rights; it granted summary judgment in favor of the defendant for violation of the reproduction right. The Ninth Circuit affirmed on all bases—even taking all the allegations of the complaint as true, it held that the plaintiff failed to state a cause of action.<sup>127</sup>

The Ninth Circuit began its analysis in *Giganews* by emphasizing that volition in this context does not refer to an "act of willing or choosing"; rather, it quoted the treatise formulation of the "unremarkable proposition that proximate causation must

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125. See *Nat'l Football League v. McBee & Bruno's, Inc.*, 792 F.2d 726 (8th Cir. 1986) (granting permanent injunction against St. Louis bars showing "dirty feed" of live football game).

126. 847 F.3d 657 (9th Cir. 2017).

127. Given that the appeal arose from the granting of a motion to dismiss, facts alleged in the complaint were presumed to be true. The appellate decision therefore ruled that Perfect 10's argument "that the district court 'ignored P10's evidence' is irrelevant." *Id.* at 668.

exist in infringement cases no less than in other torts.”<sup>128</sup> It then exonerated Giganews, Inc., of direct infringement based on “the volitional-conduct requirement” articulated in Justice Scalia’s *Aereo* dissent.<sup>129</sup>

Given that the rule of law of any case emerges from its majority decision, with which a dissent by definition disagrees, that reliance cries out for explanation. The Ninth Circuit explained that the *Aereo* Supreme Court majority “can be reconciled with the volitional-conduct requirement.”<sup>130</sup> It proceeded to rule in favor of Giganews, Inc., by quoting *CoStar*’s holding—paraphrasing *Netcom*—that “automatic copying, storage, and transmission of copyrighted materials, when instigated by others, does not render an [Internet service provider] strictly liable for copyright infringement.”<sup>131</sup> Yet Justice Breyer ruled exactly to the contrary—his majority opinion held the defendant directly liable for copyright infringement when, “in *automatic* response to the subscriber’s request, . . . *Aereo*’s system activate[s] an antenna and begin[s] to transmit the requested program.”<sup>132</sup> In short, *Giganews* followed the trail blazed by a 1995 district court ruling instead of governing Supreme Court authority to the contrary.<sup>133</sup>

The Ninth Circuit further concluded that judgment in the defendant’s favor regarding public-display was required on the basis that, “to the extent that [its software] is used to view the infringing images, this is done by the user,” not by the defendant.<sup>134</sup> Again, it is instructive to compare that status with the Supreme Court’s ruling: Defendant *Aereo* likewise offered software such that the viewing was “done by the user”—but the Supreme Court majority explicitly declined to exonerate it as “just an equipment supplier” on that basis and instead held it culpable as a direct infringer.<sup>135</sup>

In sum, even though the Supreme Court majority did not use the term “volition,” it held defendant *Aereo*, Inc., culpable for copyright infringement notwithstanding the Second Circuit’s exoneration of that party based on its purported lack of volition. The case ruled that engineering a system and supplying software for its use cannot allow a party to sidestep responsibility simply because third parties take affirmative steps to commit copyright infringement. Although those third parties may themselves also be culpable,<sup>136</sup> Justice Breyer characterized the liability as “both/and,” not “either/or.”<sup>137</sup> By contrast, *Giganews* reasoned that “to the extent that [the

128. *Id.* at 666 (quoting NIMMER ON COPYRIGHT, *supra* note 30, § 13.08[C][1]).

129. *Id.* at 666–67.

130. *Id.* at 667.

131. *Id.* at 670 (alteration in original) (quoting [as altered] *CoStar Grp., Inc. v. LoopNet, Inc.*, 373 F.3d 544, 555 (4th Cir. 2004)).

132. *Am. Broad. Cos. v. Aereo, Inc.*, 573 U.S. 431, 444 (2014) (emphasis added).

133. The decision dismissed both the reproduction and public distribution counts of the plaintiff’s complaint based on variants of “automatically.” *Giganews*, 847 F.3d at 669–70.

134. *Id.* at 668 (quoting *Perfect 10, Inc. v. Giganews, Inc.*, No. CV 11–7098, 2013 WL 3610706, at \*2 (C.D. Cal. July 10, 2013)).

135. *Aereo*, 573 U.S. at 444.

136. To that extent, there is no question that element (1) of *Netcom* continues to pertain at present. See *supra* Part I.B.

137. The Supreme Court ruled that “both the broadcaster and the viewer of a television program” infringe. *Aereo*, 573 U.S. at 441.

defendant's software] is used to view the infringing images, this is done by the user," and hence exonerated the defendant.<sup>138</sup> Those holdings cannot be reconciled.

## 2. Application of § 512

The action in *Giganews* reverted to Usenet—the same realm that Judge Whyte had confronted in *Netcom* three years before enactment of the Digital Millennium Copyright Act. Remarkably, however, the Ninth Circuit reached its decision in this case without advertent to § 512, the legislation that Congress passed after *Netcom* specifically to regulate this domain.<sup>139</sup> Instead, the court hung its hat on volition as Judge Whyte had defined it in 1995—notwithstanding Congress's deliberate choice, as explicated above, *not* to codify his *Netcom* decision.<sup>140</sup>

*Giganews*'s complaint alleged that "Defendants' service permits their subscribers to search USENET content for specific files. For example, a user interested in finding Perfect 10 works on Defendants' USENET servers might search for the term 'Perfect 10.'"<sup>141</sup> Yet the Ninth Circuit exonerated defendants from liability. To appreciate how this course of action runs afoul of governing law, let us return to the passage from the legislative history quoted above, in which the Senate explained its motivation for passage of § 512: "In the ordinary course of their operations service providers must engage in all kinds of acts that expose them to potential copyright infringement liability. . . . Many service providers engage in directing users to sites in response to inquiries by users."<sup>142</sup>

Because Congress viewed "directing users to sites in response to inquiries by users" as "expos[ing service providers] to potential copyright infringement liability," it legislated the safe harbors of § 512 to protect those service providers who comply with its elaborate specifications. As just quoted from the complaint, *Giganews, Inc.*, engaged in precisely that sort of directing users in response to their inquiries. Holding it outside of potential copyright infringement liability as a matter of law therefore contravenes governing strictures.<sup>143</sup>

Moreover, that approach contradicts prior case law within the Ninth Circuit. Previous cases considered service providers potentially culpable for copyright

138. *Giganews*, 847 F.3d at 668 (quoting *Perfect 10, Inc. v. Giganews, Inc.*, No. CV 11-7098, 2013 WL 3610706, at \*2 (C.D. Cal. July 10, 2013)).

139. Besides one passing reference, *Giganews*, 847 F.3d at 664, this Ninth Circuit opinion does not even mention 17 U.S.C. § 512.

140. See *supra* Part II.B.

141. *Perfect 10, Inc. v. Giganews, Inc.*, No. CV11-07098, 2013 U.S. Dist. LEXIS 71349, at \*5 (C.D. Cal. Mar. 8, 2013) (citations omitted). Given affirmance of dismissal at the pleadings stage, both court levels accepted as true the allegations of the complaint. See *supra* note 127.

142. S. REP. NO. 105-190, at 8 (1998); see also *supra* Part II.C.

143. Given how many millions of copyrighted works were allegedly offered through *Giganews, Inc.*, its exoneration is at odds with a later Ninth Circuit case holding a geometrically smaller Internet site, where users could post celebrity photographs, to answer for copyright infringement and to test the validity of its § 512 defense in that regard. See *Mavrix Photographs, LLC v. LiveJournal, Inc.*, 873 F.3d 1045, 1058 (9th Cir. 2017). It is hard to reconcile this later ruling that the photographs at issue necessitated a trial with the dismissal without any factfinding of the allegations brought against *Giganews, Inc.*, for its use of incomparably more photographs (and other copyrighted material).

infringement even if their functionality occurred “automatically,”<sup>144</sup> therefore proceeding to the essential step of evaluating whether the safe harbor applied.<sup>145</sup> By contrast, in this instance, the Ninth Circuit exonerated Giganews, Inc. by repeatedly noting how the plaintiff’s material was exploited “automatically.”<sup>146</sup> That holding threatens to render § 512 a dead letter.<sup>147</sup>

### 3. Application of *Netcom*

Let us imagine that governing copyright law in the United States is a ruling from the Northern District of California in 1995 rather than later legislation and Supreme Court rulings. Even under that supposition, the Ninth Circuit reached the wrong result in *Giganews*, given crucial differences in the facts presented from those underlying *Netcom*. Recall element (6) addressing vicarious liability<sup>148</sup> in *Netcom*: “There is no evidence that infringement by . . . any other user of [the defendants’] services, in any way enhances the value of [those defendants’] services to subscribers or attracts new subscribers.”<sup>149</sup> In the mid-1990s, copyright infringement amounted to but a tiny trickle among all the Usenet offerings to which Netcom, Inc., then afforded access.

In *Giganews*, by contrast, the defendant’s moniker bespeaks the opposite. Giganews, Inc., true to its name, offered “25,000 *terabytes* of copyrighted materials

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144. The facts of *Giganews* mirror those underlying the famous *Napster* case in several particulars, including the following: “By using a ‘peering process,’ messages posted on one Usenet server can automatically propagate to other Usenet servers, which then propagate the messages to another Usenet server, and so on.” *Giganews*, 847 F.3d at 663. The district court in *Napster* held: “If a user sets the ‘allowable uploads’ function of the MusicShare software above zero, all of the MP3 file names she stores in her user library *automatically* become available to other online Napster users.” *A & M Records, Inc. v. Napster, Inc.*, 114 F. Supp. 2d 896, 905 (N.D. Cal. 2000) (emphasis added). That trial court decision holding Napster liable was largely affirmed on appeal: “The form is then transmitted to a Napster server and *automatically* compared to the MP3 file names listed in the server’s search index. Napster’s server compiles a list of all MP3 file names pulled from the search index which include the same search terms entered on the search form and transmits the list to the searching user.” *A&M Records v. Napster, Inc.*, 239 F.3d 1004, 1012 (9th Cir. 2001) (emphasis added).

145. The district court decision just cited held Napster culpable of copyright infringement, and the Ninth Circuit affirmed that aspect. As to the trial court ruling barring Napster from eligibility for a safe harbor defense, the Court of Appeals reversed, holding that “significant questions” existed under this statute, including: “(1) whether Napster is an Internet service provider as defined by 17 U.S.C. § 512(d); (2) whether copyright owners must give a service provider ‘official’ notice of infringing activity in order for it to have knowledge or awareness of infringing activity on its system; and (3) whether Napster complies with § 512(i) . . . .” *Napster*, 239 F.3d at 1025.

146. On the display right, *Giganews* noted, “The evidence before us shows only that Giganews’s actions were akin to . . . automatically copying, storing, and transmitting materials upon instigation by others.” 847 F.3d at 668. On the distribution right: “Again, there is no indication that the distribution does not happen automatically.” *Id.* at 669. On the reproduction right: “[A]utomatic copying, storage, and transmission of copyrighted materials, when instigated by others, does not render an Internet service provider strictly liable for copyright infringement.” *Id.* at 670 (internal brackets omitted).

147. See *supra* note 48.

148. The complaint against Giganews, Inc., included a count thus denominated. *Giganews*, 847 F.3d at 673–76.

149. *Religious Tech. Ctr. V. Netcom On-Line Commc’n Servs., Inc.*, 907 F. Supp. 1361, 1377 (N.D. Cal. 1995).

without permission.”<sup>150</sup> How much is that? The entire collection of the Library of Congress contains around ten terabytes.<sup>151</sup> It thus seems safe to compute that unlawful access to 25,000 terabytes of copyrighted materials exceeds the sum total of material at issue in every single copyright infringement case ever filed from passage of the Statute of Anne in 1710 through Judge Whyte’s 1995 ruling.

Now let us add into the equation *Netcom* element (7) addressing contributory infringement:<sup>152</sup> Adverting to *Sega v. MAPHIA*, Judge Whyte approved the ruling that “a BBS operator is liable for copyright infringement where it solicited subscribers to upload files containing copyrighted materials to the BBS that were available for others to download” especially when it “received consideration for the right to download files.”<sup>153</sup> With respect to the BBS defendant,<sup>154</sup> he held, “Nothing in or attached to the complaint states that Klemesrud in any way profits from allowing Erlich to infringe copyrights. Plaintiffs are given 30 days leave in which to amend to cure this pleadings deficiency if they can do so in good faith.”<sup>155</sup> It therefore becomes highly relevant to note that the complaint against Giganews, Inc., the OSP parallel to Klemesrud,<sup>156</sup> affirmatively sets forth the decisive allegation missing from that earlier case: “Defendants’ ability to generate revenue is based almost exclusively on demand for the pirated works contained in the alt.binaries\* newsgroups.”<sup>157</sup>

Equally pertinent is that Giganews, Inc., explicitly advertised “that it does not keep track of subscriber downloads, effectively encouraging infringement.”<sup>158</sup> The precise reason that Judge Whyte found the complaint inadequate against the OSP defendant in the earlier case vouchsafes the adequacy of Perfect 10’s complaint against the OSP in the later one. Dismissal of the complaint against Giganews, Inc.,

150. *Giganews*, 847 F.3d at 672 (emphasis added).

151. See *Library of Congress*, WIKIPEDIA, <https://perma.cc/9EL9-DM5Z> (last visited Aug. 21, 2019). Even if that estimate, which dates back to 2000, is an order of magnitude too small, the contrast with 25,000 still remains massively disproportionate.

152. The complaint against Giganews, Inc., included a count thus denominated. *Giganews*, 847 F.3d at 670–73.

153. *Netcom*, 907 F. Supp. at 1371.

154. It should be recalled that the plaintiff in that earlier case sued not only ISP Netcom but also OSP Klemesrud, who operated a BBS. See *supra* Part I.A.

155. *Netcom*, 907 F. Supp. at 1382.

156. In *Giganews*, the plaintiffs failed to target the ISP, which would have been parallel to Netcom, Inc.

157. *Perfect 10, Inc. v. Giganews, Inc.*, No. CV11–07098, 2013 U.S. Dist. LEXIS 71349, at \*6 (C.D. Cal. Mar. 8, 2013). “Plaintiff has pleaded that it owns the copyrights to more than 165,000 images that Defendants have sold and distributed through their service.” *Id.* at \*14. In *Giganews*, alt.binaries\* played a comparable role to alt.religion.scientology in the 1995 case as the locus of alleged copyright infringement. See *supra* Part I.A.

158. *Giganews*, 847 F.3d at 672. The district court noted that “Perfect 10’s evidence [showed] that the Usenet is awash in copyrighted material” and that “staggering amounts of copyrighted works owned by movie producers and television networks are available on Giganews’ servers.” *Perfect 10, Inc. v. Giganews, Inc.*, No. CV11–07098, 2014 U.S. Dist. LEXIS 183590, at \*10–11 (C.D. Cal. Nov. 14, 2014). Amazingly, it applied the defendant’s massive illegality *against* the plaintiff copyright owners, given that the amount of its own copyrighted works that were infringed was relatively minor by comparison. *Id.* That logic is erroneous, as the Ninth Circuit later explicated. See *Glacier Films (USA), Inc. v. Turchin*, 896 F.3d 1033, 1039 (9th Cir. 2018).

was therefore erroneous.

This is not to say that Giganews, Inc., itself inexorably should have been held liable, had the matter proceeded to trial. The point, instead, is that the crux of its responsibility should have been determined based on the vehicle that Congress set up for that purpose: namely, the storage safe harbor set forth in § 512. The Ninth Circuit elided that discussion by rooting its holding in a misguided application of volition.

### B. *VHT v. ZILLOW GROUP*

In the interim, the Ninth Circuit compounded the disconnect between its jurisprudence and the strictures enacted by Congress. In *VHT, Inc. v. Zillow Group, Inc.*, the defendant website afforded access to copyrighted images of homes for sale.<sup>159</sup> The plaintiff sent the defendant “a takedown notice letter with a list of thousands of allegedly infringing photos by residential street address (but not by web address).”<sup>160</sup> That status arises out of the § 512 framework. A takedown notice, once validly served, requires the service provider to “respond[] expeditiously to remove, or disable access to, the material that is claimed to be infringing,” if it wishes to retain its eligibility under the safe harbor.<sup>161</sup> However, that takedown notice itself must contain specified elements, including “information reasonably sufficient to permit the service provider to locate the material.”<sup>162</sup> In this case, a live issue could arise under § 512 whether the takedown notice was rendered invalid by virtue of its lack of web addresses.

When takedown notices are invalid, then the statute treats them as a complete nullity—which, in this case, would afford Zillow protection under the safe harbor even if it threw those notices in the trash and never responded to VHT.<sup>163</sup> By contrast, if the notices were valid, then Zillow had the obligation to take the material down to maintain its eligibility for the safe harbor, regardless of whether the copyright owner responded to, or ignored, further inquiries. An intermediate level is also possible—if the takedown notice were deemed partially compliant, a further inquiry could be posed whether the Copyright Act places on the service provider the obligation to offer an opportunity to cure.<sup>164</sup> In this way and a host of others,<sup>165</sup> the statute minutely regulates how copyright owners are supposed to respond to infringement of their works online by serving takedown notices and the method by which online service providers can avoid liability to those owners (except for limited injunctive relief) by engaging in the prescribed steps of the statutory minuet in response to those takedown notices.

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159. 918 F.3d 723 (9th Cir. 2019). The facts mirror those underlying *CoStar*.

160. *Id.* at 734.

161. 17 U.S.C. § 512(c)(1)(C) (2018).

162. 17 U.S.C. § 512(e)(3)(A)(iii) (2018).

163. *See* 17 U.S.C. § 512(c)(3)(B)(i) (2018).

164. *See* 17 U.S.C. § 512(c)(3)(B)(ii) (2018).

165. For instance, the safe harbor is forfeited if the online service provider fails to appoint an agent for service of takedown notices. *See* 17 U.S.C. § 512(c)(2) (2018). We will see that circumstance in the case discussed below. *See infra* Part VI.C.

How did the Ninth Circuit analyze the situation in this case? Incredibly, its opinion never even mentions § 512, with all its elaborate specifications about takedown notices. Instead, the court reasoned from general principles as to how parties should comport themselves when they send and receive takedown notices. The opinion recites that Zillow responded to the takedown notice by requesting that VHT furnish it with executed license agreements.<sup>166</sup> It then continues: “Instead of responding with the contracts, VHT filed suit. Zillow’s reasonable response to VHT’s single formal inquiry (supplemented in a follow-on email) can hardly be characterized as rising to the level of volitional conduct or turning a blind eye.”<sup>167</sup> This ruling relies on *Giganews* to hold non-volitional, and hence immune, an online provider that promulgated “copyright-protective ‘trumping’ rules” and also, once apprised of infringement, “took affirmative action to address the claims.”<sup>168</sup>

The foregoing logic might hold water in the absence of legislation. But it ignores the actual scheme that Congress adopted in this domain. Rather than looking to the statutory language to determine the effect of an absence of web addresses, the court wove out of whole cloth a requirement to identify “the URL for each image.”<sup>169</sup> It also contravenes the statutory scheme to hold that service provider defendants may put plaintiffs who have served valid takedown notices to the burden of furnishing background contractual entitlements, and that the failure to produce such entitlements material immunizes the defendant as having behaved “non-volitionally.”

Even though the jury had found the defendant culpable for contributory infringement, the Ninth Circuit rejected that verdict. Its basis was that “Zillow did not have appropriately ‘specific’ information necessary to take ‘simple measures’ to remedy the violation.”<sup>170</sup> Whence did it derive that standard? The case quotes the “simple measures” requirement from *Giganews*, tracing it back to *Netcom*.<sup>171</sup> But the supreme law of the land is not what was set forth in a 1995 district court opinion. Violation of copyright is not resolved based on that early case’s pronouncements about either “simple measures” or “volition.”

Nonetheless, there is one respect in which this case is fundamentally dissimilar from *Giganews*. That earlier ruling entirely exonerated its defendant, who even recovered its attorney’s fees as the prevailing party.<sup>172</sup> By contrast, a separate part of the Ninth Circuit’s ruling in this later instance upheld summary judgment against Zillow for infringing almost 4,000 photos, with concomitant liability for statutory damages.<sup>173</sup> At the end of the day, therefore, VHT recovered significant damages—very much in contrast to the denial of all relief to Perfect 10.

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166. VHT, Inc. v. Zillow Grp., Inc., 918 F.3d 723, 734 (9th Cir. 2019).

167. *Id.* at 734.

168. *Id.* at 733–34.

169. *Id.* at 745.

170. *Id.* at 745.

171. *Id.* at 745; *see also supra* note 14.

172. Perfect 10, Inc. v. Giganews, Inc., 847 F.3d 657, 674–76 (9th Cir. 2017).

173. The case absolved defendant of direct infringement with respect to photos displayed on its listing platform. *Zillow*, 918 F.3d at 734. By contrast, when Zillow moderators tagged individual photos, its efforts rendered it volitional and liable for displayed, searchable photos. *Id.* at 736, 738–44.

### C. *BWP MEDIA USA V. T & S SOFTWARE ASSOCIATES*

Two months after *Giganews*, a similar issue arose before the Fifth Circuit. This time, though, § 512 was front and center: In *BWP Media USA, Inc. v. T & S Software Assocs., Inc.*, the defendant failed to designate an agent to receive takedown notices for material on its HairTalk website.<sup>174</sup> Accordingly, it forfeited any right to the safe harbor.<sup>175</sup> The entire case therefore turned on background doctrines of copyright infringement jurisprudence. The court chose to resolve it on the basis of volition.

The Fifth Circuit began its opinion by quoting the same treatise passage rooting volition not in an “act of willing or choosing” but instead as an inquiry into proximate causation.<sup>176</sup> Like *Giganews*, it ruled on the basis of Justice Scalia’s dissent and *Netcom*.<sup>177</sup> But it at least recognized the tension between that 1995 case and Congress’ later adoption of § 512.<sup>178</sup> Yet it rejected plaintiff’s position that “adopting the volitional-conduct requirement would render Section 512(c)’s safe harbor meaningless.”<sup>179</sup> It did so on two bases: by reference to a paragraph of § 512 entitled “Other Defenses Not Affected” and in reliance on *CoStar*.

Let us consider each in turn. The statutory paragraph in question mandates that failure “to qualify for limitation of liability under this section shall not bear adversely upon the consideration of a defense by the service provider that the service provider’s conduct is not infringing under this title or any other defense.”<sup>180</sup> To illustrate via a famous case, when Google declined to respond to Cindy Garcia’s takedown notices regarding *Innocence of Muslims*, it forfeited the safe harbor—but it was still able to prevail based on other defenses, such as a failure of the plaintiff to prove that her copyright interest in the work in question had been infringed.<sup>181</sup>

Sticking to the subject of volition, let us return to the hacker who carved out space in a company’s intranet to make it available for third party infringement, all without the company’s knowledge.<sup>182</sup> That company would have had no reason to designate an agent to receive notifications of infringement, and thus would have been as bereft as HairTalk of any § 512 safe harbor. Nonetheless, a court could validly conclude that the company failed to act volitionally, given that the hack into its premises broke the chain of proximate causation. As such, it could still prevail as defendant, as the quoted statutory paragraph mandates.

Nonetheless, it does violence to that paragraph of § 512 to conclude that the Copyright Act provides immunity to essentially all actors who respond

174. 852 F.3d 436, 438 (5th Cir. 2017).

175. See 17 U.S.C. § 512(e)(2) (2018).

176. *T & S Software*, 852 F.3d at 440 n.1 (quoting *Giganews*, 847 F.3d at 666 (quoting NIMMER ON COPYRIGHT, *supra* note 30, § 13.08[C])).

177. *Id.* at 441–42.

178. *Id.* at 442.

179. *Id.* at 443.

180. 17 U.S.C. § 512(l) (2018).

181. See *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. 2015) (en banc). For an extended analysis of this case, see David Nimmer, *Innocence of Copyright: An Inquiry into the Public Interest*, 63 J. COPYRIGHT SOC’Y U.S.A. 367 (2016).

182. See *supra* Intermezzo.

“automatically” to user requests. That interpretation renders the safe harbor as a whole largely otiose, for the reasons explored at length above.<sup>183</sup>

What remains is the Fourth Circuit’s *CoStar* holding. That case held liable for copyright infringement only the human actor who effectively “pushed the button”—a stance that Justice Breyer emphatically rejected in *Aereo*.<sup>184</sup> Both bases for exonerating the website in this case therefore evaporate.

## VII. THE CORRECT PATH FORWARD

### A. *SPANSKI ENTERPRISES V. TELEWIZJA POLSKA*

In *Spanski Enterprises, Inc. v. Telewizja Polska, S.A.*, the plaintiff licensed American broadcasting rights in content produced by the defendant, Poland’s national public broadcaster.<sup>185</sup> To protect the plaintiff’s rights, the defendant made its programming available on its website’s video-on-demand feature only subject to geoblocking preventing access in the United States.<sup>186</sup> Yet the defendant then intentionally disabled that geoblocking as to over fifty episodes,<sup>187</sup> causing the district court to hold it a willful infringer liable for over three million dollars in statutory damages.<sup>188</sup>

On appeal, the defendant challenged the determination of volitional conduct. There was both a factual and legal component. As to the former, the evidence was insufficient to dislodge the factual finding that one of the defendant’s employees engaged in “a volitional step . . . to give access” by disabling the blocking.<sup>189</sup> Turning to the legal dimension, the defendant urged the proposition adopted by sister circuits that:

[V]olitional conduct is absent where, as here, a website owner “operates an automatic content delivery system that is not itself infringing, the user, not the website owner, selects the content it will view or receive and actuates the delivery system, and the user request is not processed by the website owner’s employees.”<sup>190</sup>

Judge Tatel properly concluded that this argument “cannot be squared with the text

183. See *supra* Part II.C and note 48.

184. The Supreme Court styled the plaintiffs’ burden as: “[T]he Networks must prove that Aereo ‘perform[s]’ copyrighted works, §106(4), when its subscribers log in, select a channel, and push the ‘watch’ button.” *Am. Broad. Cos. v. Aereo, Inc.*, 573 U.S. 431, 453 (2014). The majority’s decision against Aereo, Inc., proves that liability extends past the individual who actually pushes the button.

185. 883 F.3d 904, 907 (D.C. Cir. 2018).

186. *Id.* (“[D]efault territorial access setting assigned to each TVP Polonia episode in the Content Management System was ‘minus America . . .’”).

187. See *Spanski Enters., Inc. v. Telewizja Polska S.A.*, 222 F. Supp. 3d 95, 107–08 (D.D.C. 2016), *aff’d*, 883 F.3d 904 (D.C. Cir. 2018).

188. *Spanski Enters.*, 883 F.3d at 909.

189. *Id.*

190. *Id.* at 910 (omitting brackets added by the Second Circuit) (quoting Appellant’s Brief at 25). That page of the brief first cites *Giganews*, then derives the quoted standard from a previous case on which *Giganews* relied: namely, *Fox Broad. Co. v. Dish Network L.L.C.*, 747 F.3d 1060 (9th Cir. 2013). See *supra* note 118.

of the Copyright Act.”<sup>191</sup> The Act nowhere limits infringing performances to those in which “a third-party end user plays no role in the showing.”<sup>192</sup>

Moving beyond the text, the case held that *Aereo* “forecloses TV Polska’s argument that the automated nature of its video-on-demand system or the end user’s role in selecting which content to access insulates it from Copyright Act liability.”<sup>193</sup> The D.C. Circuit rejected purported distinctions from *Aereo* that were based on: (1) defendant’s own role in creating the content in issue, given that it licensed that content to plaintiff;<sup>194</sup> and (2) an attempt to cabin Justice Breyer’s interpretation in that ruling into “a one-time deal, good for that case only.”<sup>195</sup> *Aereo, Inc.*’s overwhelming resemblance to cable retransmission in no way diminished the Court’s pronouncements in that case from “establish[ing] precedential principles that apply to materially similar factual scenarios arising in future cases,” such as this one.<sup>196</sup>

At that point, defendant launched its parade of horrors about limitless liability threatening YouTube, Facebook, Twitter, T-Mobile, and others.<sup>197</sup> The court responded with exactly the right consideration: “Congress has already provided statutory protection against some of these potential ramifications. See 17 U.S.C. § 512 (providing statutory defenses for service providers charged with infringement).”<sup>198</sup> It is precisely in the realm of that statutory safe harbor that qualifying services can escape liability under the law—at the same time that those who fail to comply are held responsible for their conduct.<sup>199</sup> Congress enacted the Digital Millennium Copyright Act as a compromise between competing interests; this decision gives content to that enactment.

## B. *BWP MEDIA USA V. POLYVORE*

### 1. Concurrences Only

In 2019, the Second Circuit returned to the same domain that it had repeatedly addressed prior to the Supreme Court’s *Aereo* reversal. In *BWP Media USA Inc. v. Polyvore, Inc.*, the defendant ran a website that allowed users “to create and share

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191. *Spanski Enters.*, 883 F.3d at 910.

192. *Id.* As emphasized in the critiques above of *Giganews* and *T & S Software*, whether third parties themselves take affirmative steps to commit copyright infringement cannot decrease the liability of defendant online service providers through whose instrumentality individuals may obtain copyrighted works.

193. *Id.* at 911.

194. *Id.*

195. *Id.* The defendant’s argument, based on language in *Aereo* reserving decision on how its resolution would apply to “other cases involving different kinds of service or technology,” was so fundamentally wrong that “every first-year law student” would spot its error. *Id.*

196. *Id.*

197. *Id.* at 912.

198. *Id.*

199. The opinion then cites cases from *Netcom* to *T & S Software* with the observation, “[o]ur court has yet to decide whether to read such a volitional conduct or proximate cause requirement into the Copyright Act, and we need not do so today.” *Id.*

digital photo collages devoted to fashion, art, and design.”<sup>200</sup> Uploaded images triggered technical processes that resulted in their being displayed automatically.<sup>201</sup> Among the 118 million images thus made available, the plaintiff claimed infringement of celebrity photographs that it owned.<sup>202</sup> After the trial court had granted summary judgment against the plaintiff based on lack of volition on the defendant’s part,<sup>203</sup> the Second Circuit reversed *per curiam*.<sup>204</sup> Each judge on the panel issued a separate opinion concurring in the result,<sup>205</sup> collectively containing over one hundred references to “volition.”

The Constitution is the supreme law of the land.<sup>206</sup> But, as shown above, in the context of volition in copyright cases, Judge Whyte’s 1995 pronouncement in district court has effectively gained that exalted status—including in circuit court language in 2018, as noted above.<sup>207</sup> Part of this 2019 opinion continues the trend—Judge Walker’s concurrence parses the fine points of *Netcom*’s language to give independent content to both components of “volition or causation.”<sup>208</sup>

More globally, Judge Walker returned to *Cablevision* (which he had authored)<sup>209</sup> in order to confront its continued vitality after the Supreme Court’s *Aereo* reversal.<sup>210</sup> Characterizing the Supreme Court majority’s opinion as “confined to the discrete area of television rebroadcasting,”<sup>211</sup> he concluded that “*Aereo* did nothing to disturb *Cablevision*’s volitional conduct requirement and that requirement continues to apply to cases involving ISPs.”<sup>212</sup> Based on *Cablevision*, he opined that “an ISP does not act volitionally when it automatically makes a single copy of content selected by

200. 922 F.3d 42, 44 (2d Cir. 2019) (Walker, J., concurring in the result).

201. *Id.* at 45 (“All posted images were displayed automatically by software—meaning Polyvore employees did not review or interact with user-posted images before they appeared on the site.”).

202. *Id.*

203. *Id.* at 46.

204. After a single paragraph setting forth conclusions, each of the three panel members issued an opinion “concurring in the result.” It should be added that the precise basis for reversal was a dispute over issues of material fact as to “whether Polyvore created multiple copies of BWP’s photos that were not requested by Polyvore users.” *Id.* at 44 (*per curiam*).

205. One opinion was very short, so will not be treated herein. *See id.* at 69 (Pooler, J., concurring in the result). In brief, it rejected “conceptualizing volitional conduct in such a way that an ISP does not act volitionally when it automatically makes one, but not more than one, unrequested copy in response to a user’s request for a copy.” *Id.*

206. *See* U.S. CONST., art. VI, cl. 2.

207. *See supra* text accompanying note 171.

208. *Polyvore*, 922 F.3d at 52 (Walker, J. concurring) (“When the district court in *Netcom* referred to ‘volition or causation’ in stating how direct liability might be limited ‘where a defendant’s system is merely used to create a copy by a third party’ . . . I think it was positing two possibilities, not one.”) (citing *Religious Tech. Ctr. v. Netcom On-Line Comm’n Servs., Inc.*, 907 F. Supp. 1361, 1370 (N.D. Cal. 1995)).

209. He took this occasion to correct use of the term “element” in that earlier opinion. *Id.* at 48 n.4 (“I agree that volitional conduct is not an element of a cause of action for direct liability, but rather a factual component that must be established when the identity of the infringer is in doubt.”).

210. *Id.* at 48–49.

211. *Id.* at 49. This sensibility corresponds to the argument, rejected by Judge Tatel, that *Aereo* was “a one-time deal, good for that case only.” *Spanski Enters. v. Telewizja Polska, S.A.*, 883 F.3d 904, 911 (D.C. Cir. 2018). *See supra* text accompanying note 195.

212. *Polyvore*, 922 F.3d at 49.

the user in response to a user's request."<sup>213</sup>

Judge Newman disagreed on both counts. Instead of giving separate content to "volition" and "causation," his concurrence followed the treatise perspective interpreting *Netcom*'s use of both those terms to refer the unremarkable principle that proximate causation is required in copyright cases.<sup>214</sup> He therefore parted company with Judge Walker's defense of *Cablevision*. In particular, he questioned the statement in that earlier case: "In determining who actually 'makes' a copy, a significant difference exists between making a request to a human employee, who then volitionally operates the copying system to make the copy, and issuing a command directly to a system, which automatically obeys commands and engages in no volitional conduct."<sup>215</sup> His concurrence rejected *Cablevision*'s ruling that only the human being who operates a copying system accrues liability, with the consequence of immunizing an entity that designs or operates a system to make copies by automatically obeying the commands of others.<sup>216</sup> Instead, consonant with Justice Breyer's recognition of "both/and" liability in this sphere, Judge Newman raised the possibility of joint liability for "the developer or operator of a system, activated automatically by a user" along with that user.<sup>217</sup>

## 2. Precedential Value of *Cablevision*

Where does the foregoing disagreement leave *Cablevision*? If it wanted to, Congress certainly had the power to specify different levels of volition with respect to different technologies. It could have required, for instance, negligence to infringe photographs, recklessness to infringe novels, and willfulness to infringe television programs. But Congress manifestly employed no such distinctions when enacting the 1976 Act.

Can one read the Supreme Court's ruling to reflect an interpretation of the Act that Congress intended a generally applicable "volition" requirement, which it then specifically waived in the context of television programs? That hypothetical stance would reconcile the holding in *Aereo* with a still-extant "volition" requirement elsewhere. But, to draw that distinction, proponents would need to root its basis in the statutory text or at least the legislative history of the Act. They have pointed to none, so this conceivable basis evaporates in the light of the Court's actual ruling.<sup>218</sup>

213. *Id.* at 50. Nonetheless, he concluded that a question of material fact existed "whether Polyvore, separate from its users, acted volitionally by making and displaying the additional copies of BWP's images." *Id.* at 52.

214. *Id.* at 62 (Newman, J., concurring); see also NIMMER ON COPYRIGHT, *supra* note 30, § 13.08[C][1].

215. *Polyvore*, 922 F.3d at 65–66 (quoting *Cartoon Network, LP v. CSC Holdings, Inc. (Cablevision)*, 536 F.3d 121, 131 (2008)) (emphasis by Judge Newman).

216. *Id.* at 65. That incorrect approach reflected Second Circuit law from the divided panel's ruling in *Aereo*, until checked by the Supreme Court's reversal. *Id.* Nonetheless, "the status of systems that automatically caused an infringement at a customer's command remained uncertain because the Supreme Court's majority opinion said nothing about volition or causation." *Id.*

217. *Id.* at 66.

218. After discarding a blanket rule immunizing service providers who provide access in automatic response to user requests, the discussion above recognized that it was still possible that there could be an

Justice Breyer examined the conduct of Aereo, Inc., to determine whether it was a direct infringer and reached an affirmative conclusion. The Supreme Court ruled the defendant in violation of copyright law for conduct that unfolded “in automatic response” to user requests. Judge Newman therefore properly applied that ruling to debunk the Second Circuit’s earlier categorical rulings.<sup>219</sup>

At the same time, the Supreme Court acknowledged in *Aereo* that “[i]n other cases involving different kinds of service or technology providers, a user’s involvement in the operation of the provider’s equipment and selection of the content transmitted may well bear on whether the provider performs within the meaning of the Act.”<sup>220</sup> That recognition in no way implies that a different volition standard applies to the public performance of television programming than would apply in all other instances<sup>221</sup>—to the reproduction of literary works such as Hubbard’s writings, for example.<sup>222</sup> It simply recognizes the universally applicable phenomenon that different facts could attract a different result.<sup>223</sup>

Moreover, even if the *Aereo* ruling could somehow be cabined into solely the context of similarity between the defendant and a cable provider of television programming, that limitation would still doom the *Cablevision* ruling. For *Cablevision, Inc.*, was itself a cable provider, whereas *Aereo, Inc.*, was not (it used the Internet).<sup>224</sup> Any disqualification of *Aereo, Inc.*, therefore applies *a fortiori* to *Cablevision, Inc.* No matter how one slices it, the Supreme Court majority opinion leaves no room to vindicate the Second Circuit’s *Cablevision* ruling exonerating the

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implicit rule in the Copyright Act that applies in certain instances, which service providers could invoke in concrete cases to avoid liability when they respond “automatically” to user requests. *See supra* note 123. On examination, we now see that even that lesser standard is lacking.

219. *See supra* Part VII.B.1.

220. *Am. Broad. Cos. v. Aereo, Inc.*, 573 U.S. 431, 444 (2014). For instance, if a company rented a channel over digital fiber to allow physics researchers to send a high-speed data burst of the sender’s choosing to other universities, it is possible that there would be no liability for copyright infringement even if an individual customer abused the service to send an infringing television show over the fiber to a non-university target. That entity might be simply an equipment supplier. *See supra* *Intermezzo* (hypothetical about corporate intranet).

221. As other commentators note, the majority’s search into the history of cable television “does not warrant a negative inference that different providers in different contexts do *not* perform.” Giblin & Ginsburg, *supra* note 109, at 129.

222. The majority declined to limit its rulings to the particulars of cable television technology. Indeed, Justice Breyer rejected the dissent’s claimed “critical difference” between *Aereo, Inc.*, and traditional cable systems: namely, its claim “that *Aereo*’s subscribers, not *Aereo*, ‘select the copyrighted content’ that is ‘performed,’ and for that reason they, not *Aereo*, ‘transmit’ the performance.” *Aereo*, 573 U.S. at 443 (as altered by Justice Breyer, omitting his brackets). Regardless of conceded differences, the Court upheld liability.

223. To reiterate Judge Tatel’s observation, “as every first-year law student learns, a judicial decision resolves only the case before it, so it is unsurprising that the Court declined to hypothesize about how its holding would apply to future cases.” *Spanski Enters. v. Telewizja Polska, S.A.*, 883 F.3d 904, 911 (D.C. Cir. 2018).

224. After losing at the Supreme Court level, *Aereo, Inc.*, along with other companies similarly situated, belatedly tried to qualify under the cable compulsory license. Their efforts failed. *See Fox Television Stations, Inc. v. Aereokiller, LLC*, 851 F.3d 1002, 1015 (9th Cir. 2017); *Fox Television Stations, Inc. v. FilmOn X LLC*, 150 F. Supp. 3d 1, 6–7 (D.D.C. 2015); *Am. Broad. Cos. v. Aereo, Inc.*, 112 U.S.P.Q.2d 1582, 1585–86 (S.D.N.Y. 2014); *FilmOn X, LLC v. Window to the World Commc’ns, Inc.*, 118 U.S.P.Q.2d 1001, 1113 n.14 (N.D. Ill. 2016).

defendant on the basis that only its button-pushing users are culpable of copyright infringement. That holding can no longer stand, given the Supreme Court's rejection of its logic in its follow-on *Aereo* decision.

Nonetheless, it does not follow that Cablevision, Inc., would ineluctably lose if it went to a full trial on the merits under currently governing law. As already noted, the company's RS-DVR in that case was a digital successor to the analog Sony Betamax, which the Supreme Court determined to be non-infringing based on doctrines that stood outside the Second Circuit's purview in the later case.<sup>225</sup> Although the opinion was mistaken to exonerate Cablevision, Inc., based on its putative absence of volition, the resolution remains possible that it would ultimately prevail if all legal doctrines pertinent to its conduct were addressed. For instance, at the end of the day, the company might be able to establish an affirmative defense<sup>226</sup> such as fair use<sup>227</sup> or the absence of a different aspect of the plaintiff's *prima facie* case, such as the *public* aspect<sup>228</sup> of public performance.<sup>229</sup>

225. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 434–42, 447–56 (1984); *see* *Twentieth Century Fox Film Corp. v. Cablevision Sys. Corp.*, 478 F. Supp. 607, 616 (S.D.N.Y. 2007), *rev'd sub nom.*, *Cartoon Network, LP v. CSC Holdings, Inc. (Cablevision)*, 536 F.3d 121 (2d Cir. 2008).

226. As a matter of terminology, confusion has arisen whether fair use should be labeled an “affirmative defense.” *See Lenz v. Universal Music Corp.*, 815 F.3d 1145, 1151 (9th Cir. 2016) (noting that “labeling it as an affirmative defense that excuses conduct is a misnomer”); *Disney Enters. v. VidAngel, Inc.*, 869 F.3d 848, 856 (9th Cir. 2017) (“[I]f the Studios demonstrated a likelihood of success on their copyright infringement and DMCA claims, the burden shifted to VidAngel to show a likelihood of success on its FMA and fair use affirmative defenses.”). That debate over terminology is immaterial to current concerns.

227. Indeed, Judge Newman has adopted that rationale, accepting the holding of *Cablevision*, which he viewed as rooted in time-shifting. *BWP Media USA, Inc. v. Polyvore, Inc.*, 922 F.3d 42, 64 (quoting *Cablevision*, 536 F.3d at 123). That aspect traces back to *Sony*. *See Sony*, 464 U.S. at 434–42, 447–56; *Twentieth Century Fox Film*, 478 F. Supp. at 616. Judge Newman relied on “a thorough and enlightening analysis of the *Sony* decision.” *Polyvore*, 922 F.3d at 63 (citing Peter S. Menell & David Nimmer, *Unwinding Sony*, 95 CAL. L. REV. 941 (2007)).

228. To prevail under 17 U.S.C. § 106(4) (2018), the plaintiff must show that the defendant (a) performed the work in question and (b) did so publicly. *See supra* Part V.A. The *Aereo* Supreme Court majority addressed volition under prong (a). It then invoked prong (b) to contrast car dealers with parking valets, the former acting publicly and the latter privately. *See Am. Broad. Cos. v. Aereo, Inc.*, 573 U.S. 431, 448–49 (2014).

229. Indeed, this writer has highlighted that rationale, based on an elaborate search into how the contrast between dealers and valets plays out in the copyright context. To telescope the matter, viewers who pressed *Aereo*'s app button had no prior relationship to the content in question, thus rendering that company liable. By contrast, viewers who pressed *Cablevision*'s remote-control button did have that prior relationship to the content, by virtue of the license that the plaintiffs had granted to *Cablevision* to provide their programming to those viewers. The result in *Cablevision* is to view its dissemination as noninfringing, by analogy to parking valets. *See NIMMER ON COPYRIGHT, supra* note 30, § 8.14[C][3][c][iii][II]. That stance is not altogether different from another commentator's:

If an owner operates a website that offers unauthorized downloads of popular music, we would have little hesitation in holding the owner directly liable for the reproduction and distribution that occurs when a user clicks on the download button. The fact that the infringement was initiated by the actions of the customer seems insufficient to protect the owner from liability. . . . However, when it is the owner who uses the copier or who selects the works available for downloading from its website, the reproduction of those specific works is more clearly connected to the owner's actions. The volition requirement in copyright law defines the connection between the owner of a copying system and the copied work that is sufficient to justify attributing the copying of that

In any event, we can now appreciate that the circuit court decisions discussed above,<sup>230</sup> which recognized a volition defense, failed to grapple with the full panoply of issues that Judges Tatel and Newman have more recently brought to the fore.<sup>231</sup> Those former decisions are now ripe for reconsideration even within the Fourth and Ninth Circuits. Plus, the Second Circuit's recent divided panel ruling makes it particularly appropriate for that court to disaffirm *Cablevision* explicitly.

### FINALE: THE FUTURE OF CAUSATION

We have seen above scenarios in which proximate causation could qualify as a viable defense.<sup>232</sup> But those hypotheticals about earthquakes and vandals are highly strained. The absence of any real-world decision on point during the past two and a quarter centuries renders the matter of much more theoretical than practical significance.

One may project the passage of future centuries without scenarios such as the above actually being litigated. Instead, *Aereo* answers the questions that are likely to arise regarding proximate causation by establishing a bright line in this regard. Entities, such as *Aereo, Inc.*, and *Cablevision, Inc.*, which engineer complex systems and purvey associated machinery to pick up copyrighted broadcasts through the mere push of a button on a remote or app, in turn connected to the machinery that defendant itself maintains at the head-end, cannot escape liability by deflecting all responsibility onto the individuals who push those buttons. Rather, to the extent that they would avoid being tarred as infringers, those purveyors must establish a different defense.<sup>233</sup>

That ruling achieves parity between copyright plaintiffs and defendants. On the former side, one qualifies as an "author" of copyrightable content by performing the intellectual labor of composition, rather than by pressing the buttons to affix the subject work in a tangible medium of expression. For that reason, a bestselling novelist who dictates, rather than the stenographer who transcribes, qualifies as the copyright proprietor—and even a paralyzed individual who directs underlings how to carve may qualify as the sculptor whom the Copyright Act recognizes as author.<sup>234</sup> On the latter side,<sup>235</sup> *Cablevision's* "author of copyright infringement"<sup>236</sup> should equally attach to the entity that

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work to the owner.

Denicola, *supra* note 83, at 1271–72. For yet a different perspective for how to evaluate these types of services post-*Aereo*, see Giblin & Ginsburg, *supra* note 109, at 134–39.

230. See *supra* part VI.

231. See *supra* parts VII.A, VII.B.1.

232. See *supra* Intermezzo.

233. Some examples are discussed above. See *supra* notes 227, 229.

234. See *Fisher v. Klein*, 16 U.S.P.Q.2d 1795, 1796 (S.D.N.Y. 1990).

235. When investigating authorship, we discover similar puzzles in causation as have been explored above regarding copying: "[C]opyright law chooses to address the question of causation only indirectly (and begrudgingly)." Shyamkrishna Balganes, *Causing Copyright*, 117 COLUM. L. REV. 1, 6 (2017).

236. Recall that the phrase "the author of an allegedly infringing instance of reproduction" traces back to the Second Circuit's *Cablevision* opinion. *Cartoon Network, LP v. CSC Holdings, Inc. (Cablevision)*, 536 F.3d 121, 131 (2d Cir. 2008). See *supra* Part IV.A.

performs the intellectual labor of engineering the copying, rather than being limited to the final individual who happens to press the button.<sup>237</sup> The Supreme Court's *Aereo* ruling brings sanity to the legal scheme by focusing the law's attention on the company that spent millions investing in infrastructure and equipment designed to allow exploitation of copyrighted material by members of the public, rather than on miscellaneous customers who happen to push buttons or spin knobs.<sup>238</sup>

### VIII. CONCLUSION

In 1976, Congress included in the current Copyright Act a provision aimed at carriers “whose activities with respect to the secondary transmission consist solely of providing wires, cables, or other communications channels for the use of others.”<sup>239</sup> Absent inclusion of special language defining their conduct as “not an infringement of copyright,”<sup>240</sup> general principles would have held those passive carriers liable.<sup>241</sup> In 1998, Congress updated the Act to accord the same status to evolving technology. Its amendment that year recognized that, under the architecture of the Internet, “service providers must engage in all kinds of acts that expose them to potential copyright infringement liability” such as by “directing users to sites in response to inquiries by users,” given that those “sites might contain infringing material.”<sup>242</sup> It responded “by limiting the liability of service providers”<sup>243</sup> in four particulars in which they would be liable in the absence of these new safe harbors, including “by reason of the storage at the direction of a user of material that resides on a system or network controlled or operated by or for the storage provider.”<sup>244</sup>

In so acting, Congress considered various proposals, including one that would have codified a 1995 district court decision immunizing systems acting “automatically.”<sup>245</sup> One bill then under consideration furnished immunity whenever “the storage and transmission is carried out through an automatic technological process, without any selection of that material by the provider.”<sup>246</sup> Congress expressly rejected that solution.

237. Many copyright decisions have confronted the issue of joint authorship. *See Childress v. Taylor*, 945 F.2d 500, 501–09 (2d Cir. 1991) (Newman, J.). The question at present falls on the opposite side of the ledger, looking to joint liability. *BWP Media USA, Inc. v. Polyvore, Inc.*, 922 F.3d 42, 66, 69 (Newman, J., concurring) (in the absence of established “clear principles for determining when the developer or operator of a system, activated automatically by a user, is jointly liable with the user for direct infringement,” remanding to determine “whether Polyvore’s system crosses the line”).

238. As the Supreme Court majority noted, “Here the signals pursue their ordinary course of travel through the universe until today’s ‘turn of the knob’—a click on a Website—activates machinery that intercepts and reroutes them to Aereo’s subscribers over the Internet.” *Am. Broad. Cos. v. Aereo, Inc.*, 573 U.S. 431, 444 (2014).

239. 17 U.S.C. § 111(a)(3) (2018).

240. 17 U.S.C. § 111(a)(3) (2018).

241. *See supra* text accompanying note 1.

242. S. REP. NO. 105-190, at 8 (1998); *see also supra* text accompanying note 59.

243. S. REP. NO. 105-190, at 8 (1998); *see also supra* text accompanying note 59.

244. 17 U.S.C. § 512(e)(1) (2018).

245. *See supra* text accompanying note 15.

246. *See supra* text accompanying note 35.

Notwithstanding explicit rejection of that early district court decision, rendered at the outset of the Internet era when copyright infringement was sparse and before Congress had a chance to craft its preferred solution, circuit court decisions over the past several years have treated that 1995 opinion as some sort of *basic law* whose every locution must be parsed and followed.<sup>247</sup> In particular, they have picked up on its stray reference to “volition”<sup>248</sup> as a basis to propagate immunity for services that respond to user requests “automatically.”<sup>249</sup> That approach not only violates the proper method to determine copyright violations, but also contravenes the Supreme Court’s 2014 resolution of a copyright infringement case holding an online service provider in violation by virtue of affording access to copyrighted material “in automatic response” to user requests.<sup>250</sup> Given that the volume of infringing material has increased from a trickle in 1995 to the deluge confronted in those opinions, their approach is singularly inappropriate.<sup>251</sup>

Happily, other circuit court authority has inclined in the opposite direction. Judge Tatel, speaking for the District of Columbia Circuit, along with Judge Newman, concurring in a Second Circuit decision, have illuminated the way forward. Their opinions light the way towards a day when massive copyright violations are held to legal standards and defendants will no longer be able to evade responsibility under the tattered banner of “volition.”

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247. See examples set forth *supra* text accompanying notes 171, 208.

248. See *supra* text accompanying note 26.

249. See the three cases discussed *supra* Part VI.

250. See *supra* text accompanying note 132.

251. The amount of infringement facilitated by one defendant amounted to many thousands of times greater than the whole contents of the Library of Congress—yet the Ninth Circuit held that defendant immune as a matter of law. See *supra* text accompanying note 151.