

Before the United States Copyright Office  
Comments on the Right of Making Available

Docket No. 2014-2

**Response of Andrew P. Bridges to the Request for Comments for the Study on the Right of “Making Available.”<sup>1</sup>**

I appreciate this opportunity to comment on the Copyright Office’s study on copyright reform, specifically with respect to what it describes as the “right of making available.” I write in my individual capacity as an attorney with over twenty years of experience in the realm of intellectual property. I regularly represent the interests of entrepreneurs, start-up companies, and mature global companies in copyright, trademark, and Internet- and technology-related cases, both in litigation and in high-stakes counseling matters. Many of my clients have become some of the most successful companies in America, while others have died from being crushed by the costs and risks of intellectual property litigation.

I write purely on my own behalf—not on behalf of my current law firm or any previous law firm, or on behalf of any client. No client, other company, trade organization, or public interest group has proposed that I submit a comment, has suggested any point of view or position for it, or has furnished any consideration for it. Some of my clients may disagree with my views, and I do not speak for them here.

I welcome the Request for Comments’ inquiry into “how the existing bundle of rights under Title 17 covers the making available and communication to the public rights, how foreign laws have addressed such rights, and the feasibility and necessity of amending United States law to strengthen or clarify our law in this area.”<sup>2</sup> While there have been calls to amend the Copyright Act to protect these rights, there is no need to do so. The existing “bundle of rights” codified in Section 106 of the Act sufficiently protects copyright against infringement, even in the context of so-called “digital file sharing.”<sup>3</sup> Any changes would create massive uncertainty and disturb well-settled principles of law.<sup>4</sup> Additionally, existing law accords with treaty obligations, and foreign laws in this realm are consistent with existing United States law or are still unclear. Changing our laws in an effort to “harmonize” them with treaty obligations or with foreign regimes is unnecessary.<sup>5</sup>

A preliminary observation about the focus of the Request for Comments is appropriate. The existence of a “right of making available” is a core assumption underlying the request for

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<sup>1</sup> Prepared by Michael Basile, Marcus Childress, Deborah Goldman, and Ryan Schneer, student attorneys under the supervision of Brandon Butler, Practitioner-in-Residence, Glushko-Samuelsom Intellectual Property Law Clinic at American University Washington College of Law.

<sup>2</sup> Study on the Right of Making Available; Comments and Public Roundtable, 79 Fed. Reg. 10,571 (Feb. 25, 2014) [hereinafter Request for Comments].

<sup>3</sup> See below, Part V.

<sup>4</sup> See below, Part VI.

<sup>5</sup> See below, Part VII.

comments. To what does that refer? The Request for Comments explicitly referred to the language in the WIPO Copyright Treaty (“WCT”) referring to the “right of making available.”<sup>6</sup> While the Request for Comments specifically referred to only Article 8 of that treaty, both Articles 6 and 8 use that terminology.

Article 6 of the WCT refers to “the making available to the public of the original or copies of works through sale or other transfer of ownership.”<sup>7</sup> In the context of the Section 106(3) so-called “distribution right,” Article 6 is the relevant provision.

This comment will focus on the Section 106(3) right of a copyright holder.

**I. Section 106(3) of the Copyright Act fully covers the right, which the WIPO Copyright Treaty specifies, of making available to the public of the original or copies of works through sale or other transfer of ownership.**

Precision in language and focus on actual text are important in discussions of copyright law. The phrase “making available,” out of context, is extraordinarily vague and may allow vastly overbroad interpretation. Arguments by aggressive copyright enforcers, grounded in vague “making available” terminology, have sought significant and unprincipled expansions of the scope of United States copyright law. To the extent the Office invites commentary and debate about the extent to which United States copyright law “covers the making available . . . right,”<sup>8</sup> implying a reference to an internationally recognized right, the debate should be about the extent to which United States copyright law *covers the right of making available to the public of the original or copies of works through sale or other transfer of ownership*. The words beyond “making available” in that formulation, specifically “of the original or copies of works through sale or other transfer of ownership” are significant defining terms and deserve focused attention, not omission through potentially misleading shorthand references to the right.

Properly understood in this manner, current United States copyright law fully recognizes and incorporates *the right of making available to the public of the original or copies of works through sale or other transfer of ownership*. Section 106(3) of the Copyright Act accords to copyright holders the right “to distribute copies or phonorecords of copyrighted works to the public by sale or other transfer of ownership, or by rental, lease, or lending.” The statutory definition of a “copy” includes the original of a work.<sup>9</sup> The language of Section 106(3) covers not only sale or other transfer of ownership but also expands upon the WCT right by adding coverage for “rental, lease, or lending.” There is no need to amend the Copyright Act at the request of those who wish to expand the scope of copyright rights in order to cover the WCT right fully.

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<sup>6</sup> Request for Comments, 79 Fed. Reg. at 10,571 n.1 and accompanying text.

<sup>7</sup> See below, Part VII.

<sup>8</sup> Request for Comments, 79 Fed. Reg. at 10,571.

<sup>9</sup> 17 U.S.C. § 101 (2012) (“‘Copies’ are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term ‘copies’ includes the material object, other than a phonorecord, in which the work is first fixed”).

To recap this point, and for the handy reference of the reader, I repeat here the relevant excerpts of the WIPO Copyright Treaty and Section 106(3) of the Copyright Act for purposes of comparison:

WCT Article 6: the right of making available to the public of the original or copies of works through sale or other transfer of ownership

Copyright Act Section 106(3): the right to distribute copies or phonorecords of copyrighted works to the public by sale or other transfer of ownership, or by rental, lease, or lending.

By its terms, the WCT requires recognition of the right to regulate the “sale or other transfer of ownership” of the “original or copies” of copyrighted works; the Copyright Act creates the right to control the “sale or other transfer of ownership, or [] rental, lease or lending” of “copies and phonorecords” (including the original) of copyrighted works.

## **II. Clear statutory language defines the Section 106(3) right pertaining to “distribution,” and Professor Menell’s proposed interpretation does not supersede or improve upon that clear statutory language.**

Professor Peter Menell’s recent article, *In Search of Copyright’s Lost Ark: Interpreting the Right to Distribute in the Internet Age*,<sup>10</sup> has proposed a reinterpretation of the Section 106(3) right in order to apply the so-called “right to distribute” not merely to Internet transmissions but also even more broadly to the mere reproduction of a file on a person’s computer in a folder that is accessible to the public. The Menell article is important because it influenced the popular treatise *Nimmer on Copyright* to reverse its long-held position on the scope of the Section 106(3) right.<sup>11</sup> Moreover, the Office’s Request for Comments explicitly cited the revised *Nimmer on Copyright* and the Menell article as follows: “More recent research into the legislative history of U.S. law by Professor David Nimmer and Professor Peter Menell has provided additional textual support regarding Congress’s views on the breadth of existing U.S. law and the broad scope of the making available right.”<sup>12</sup> Because of the influence and attention Professor Menell’s article has gained, it deserves a special comment here.

This is not the place to engage in a full critique of Professor Menell’s article and of the reversal of the long-held position of *Nimmer on Copyright*. I simply point out here that the Menell article and the derivative *Nimmer* analysis contain a glaring and fatal flaw: they fail to account for importance of (1) the clear statutory limitation of the “distribution” right to distribution of “copies and phonorecords” of copyrighted works; (2) the clear statutory definitions of “copies” and “phonorecords” in Section 101 of the Copyright Act, which requires

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<sup>10</sup> 59 J. Copyright Soc’y U.S.A. 1 (2011).

<sup>11</sup> See Rick Sanders, *Checking the Sources: Why I Questioned Nimmer on Copyright*, Aaron Sanders PLLC (May 20, 2013), <http://www.aaronsanderslaw.com/blog/checking-the-sources-why-i-took-on-an-indispensable-treatise/>; Rick Sanders, *Will Professor Nimmer’s Change of Heart on File Sharing Matter?*, 15 Vanderbilt J. of Ent. and Tech. Law 857, 865-66 (2013), available at <http://www.jetlaw.org/wp-content/uploads/2013/05/Sanders.pdf>.

<sup>12</sup> Request for Comments, 79 Fed. Reg. at 10,571 n.5.

that they be “material objects”;<sup>13</sup> and (3) the cardinal principle of statutory construction that a clear and unambiguous text of a statute supplies its meaning and governs its application without resort to elaborate and complicated analysis of legislative history. On the last point, Professor Menell defends his approach by citing with approval Learned Hand’s statement “[t]here is no surer way to misread a document than to read it literally.”<sup>14</sup> I suggest that there is no surer way to construe a statute, and no fairer way to guide public expectations, than to apply the unambiguous law that Congress stated. Professor Menell titles his article “In Search of the Lost Copyright Ark.” In the context of the meaning of the Section 106(3) right pertaining to distribution, there is no need to search for the Ark of the Covenant: the Covenant is right in front of our eyes, in the statutory language itself.

The plain language is always the starting point for statutory interpretation.<sup>15</sup> Where the plain language is clear, it is also the ending point.<sup>16</sup> The 1976 Copyright Act was the result of decades of negotiation and deliberation, and Congress has amended its terms over 50 times since.<sup>17</sup> Congress has had ample opportunity to delineate and clarify the scope of the Section 106(3) right in the text of the Act.

Section 106 of the Copyright Act grants copyright owners several exclusive rights. Each right is specific. Some of the specific rights depend upon statutory definitions of key terms in Section 101 of the Copyright Act. Casual shorthand references and interpretations of constituent terms that vary from the specific statutory definitions of those terms cannot substitute for precise statutory language.

Section 106(3) defines the scope of the distribution right with four key elements. They are:

- distribution of
- *copies or phonorecords of a copyrighted work*
- to the public
- *by sale or other transfer of ownership, or by rental, lease or lending.*

As I pointed out above, Section 101 of the Copyright Act defines “copies and phonorecords” as *material objects*. This limits what might otherwise be a broad conception of “distribution,” which in casual language may refer to any type of dissemination of information or a work.

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<sup>13</sup> See Menell, above note 10, at 9 n.27.

<sup>14</sup> See *id.* at 55 n.230.

<sup>15</sup> See *Estate of Cowart v. Nicklos Drilling Co.*, 505 U.S. 469, 475 (1992) (“In a statutory construction case, the beginning point must be the language of the statute”).

<sup>16</sup> See *Conn. Nat’l Bank v. Germain*, 503 U.S. 249, 253-54 (1992) (“We have stated time and again that courts must presume that a legislature says in a statute what it means and means in a statute what it says there. When the words of a statute are unambiguous, then, this first canon is also the last: ‘judicial inquiry is complete.’”)

<sup>17</sup> See U.S. Copyright Office, *Circular 92: Copyright Law of the United States* iii-ix (December 2011), available at <http://www.copyright.gov/title17/circ92.pdf>; see also 17 U.S.C. § 101 *et seq.*

A further limitation of the right is to certain kinds of events or transactions, namely *the sale or other transfer of ownership, or rental, lease, or lending* of those material objects.<sup>18</sup>

A transaction that does not meet each of the four elements, including the material object and the transactional elements, does not implicate the Section 106(3) “distribution” right. For example, Wal-Mart distributes a copyrighted work when it sells physical copies of a DVD or CD. Wal-Mart does not distribute copies or phonorecords of a work if it transmits the work for download or by stream. Nor does Wal-Mart distribute copies or phonorecords (e.g., DVDs or CDs) by sale or other transfer of ownership, or by rental, lease, or lending simply by “making them available” for purchase in the store.

Professor Menell’s article gives very short shrift to the literal terms of the explicit statutory material-object and transaction limitations. Where an Eighth Circuit decision, relying on the previous *Nimmer on Copyright* position, referred to the Section 106(3) right as pertaining to a “material embodiment” of a work, Professor Menell criticized it for “cursory analysis,” and referred to the underlying old *Nimmer on Copyright* statement on which it relied as an “offhand statement,” contending that neither the decision nor the treatise analyzed the statutory text that they applied.<sup>19</sup> Professor Menell proceeded to catalogue a series of cases with varying outcomes, and he summarized them by describing them as “statutory interpretation chaos.”<sup>20</sup> He ascribed the chaos to a range of available interpretations of the word “distribute,” a lack of guidance to courts on why Congress chose the term “distribute,” and a practical effect on statutory interpretation of concerns about potential catastrophic statutory damages awards.<sup>21</sup>

Professor Menell’s article extensively analyzes whether the term “distribute” means not only “distribute” but also “offer to distribute” in order to show that a mere potential transaction, without an actual transaction, suffices to violate the Section 106(3) right. That effort, while itself misguided as a matter of statutory interpretation,<sup>22</sup> is irrelevant in the case of Internet transmissions. This is for the simple reason that Internet transmissions such as email, peer-to-peer transmissions, streaming, and the like do not pass material objects or their ownership from one person to another. They cannot constitute even an offer to do so. The distinction between an actual distribution and an offer to distribute, where neither involves material objects, thus is meaningless in a proper analysis of the Section 106(3) right.

Professor Menell also devotes considerable attention to using the concept of “publication” to explain “distribution” by a claimed equivalence between the concepts. While this effort is also misguided,<sup>23</sup> using “publication” as the touchstone of “distribution” only

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<sup>18</sup> See 17 U.S.C. § 106(3) (2012) (emphasis added).

<sup>19</sup> See Menell, above note 10, at 8-10 nn.25-31.

<sup>20</sup> See *id.* at 19.

<sup>21</sup> See *id.* at 16.

<sup>22</sup> The statutory language of the Copyright Act itself distinguishes between actual “distribution” and an “offer to distribute,” establishing a context that justifies treating them as distinct activities. Section 101 of the Act expressly distinguishes between the two in defining “publication” as “the distribution of copies” or “[t]he offering to distribute copies.”

<sup>23</sup> Judge Gertner’s analysis of “publication” and “distribution” in *London-Sire Records, Inc. v. Doe* 168, 542 F. Supp. 153 (D. Mass. 2008), adroitly addresses this issue.

underscores Professor Menell’s error in omitting consideration of the material object requirement from the Section 106(3) right. The definition of “publication” turns not merely on the word “distribution” but also on the involvement of “copies or phonorecords,” whether by an actual distribution by sale or other transfer of ownership, by rental lease or lending, or by an offer to engage in that act. Professor Menell’s failure to construe those key words and their statutory definitions in the context of “publication” again avoids the key issue and contributes to the fatal flaw in his work.

There is a simple explanation for the “chaos” in interpretations of the Section 106(3) right that Professor Menell describes: few courts have actually focused on the material object requirement inherent in the statutory definition of the terms “copies or phonorecords,” and virtually none have addressed the transactional requirement, namely that a violation of the right must involve “sale or other transfer of ownership, or . . . rental, lease, or lending.” The fact that courts have failed to pay attention to the clear and unambiguous language of the statute does not mean that we must search for a new meaning of the statute. Attention, and adherence, to the statute would eliminate the chaos.

As the practical conclusion of his reinterpretation of the Section 106(3) right, Professor Menell asserts that “putting sound recordings in a shared folder dramatically interferes with an author’s exclusive right to distribute a product.”<sup>24</sup> There is no support in the words of the statute for that radical statement. Again, to violate Section 106(3), a person must distribute *material objects to the public by sale or other transfer of ownership, or by rental, lease, or lending*. The “distribution” right governs actions pertaining to material objects, not the transmission of bits. A bookstore distributes copies by sale when it sells books. A television station does not distribute copies of movies when it broadcasts them, and it does not violate Section 106(3) if it broadcasts a movie without authorization.<sup>25</sup> Similarly, a streaming or download site does not violate the Section 106(3) right by transmitting material over the Internet. As I explain below, however, the fact that the Section 106(3) right does not apply does not mean that the activity is outside the reach of copyright rights; other rights apply to those activities.<sup>26</sup>

### **III. Disregard of the material object limitation of the Section 106(3) right would require support of a “digital first sale” doctrine.**

Professor Menell’s disregard of the material object requirement for the Section 106(3) right may lead to unintended consequences. Commentators have debated whether there is a “digital first sale” doctrine within the scope of Section 109 of the Copyright Act. That Section provides a specific limitation on Section 106(3) by precluding liability under that subsection, in certain circumstances, of “an owner of a particular *copy or phonorecord* lawfully made under this title.” If “copies or phonorecords” does not mean “material objects” in the Section 106(3) right, then it does not mean material objects in the correlative Section 109 limitation. In a prominent case, *Capitol Record, LLC v. ReDigi Inc.*, the court denied a Section 109 defense on the ground that it applies only to material objects, yet the court found a distribution violation

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<sup>24</sup> See Menell, above note 10, at 57.

<sup>25</sup> *Agee v. Paramount Commc’ns, Inc.*, 59 F.3d 317, 325-26 (2d Cir. 1995).

<sup>26</sup> See below, Part V.

notwithstanding the lack of material objects in the distribution.<sup>27</sup> That treatment was inconsistent, because the Section 109 limitation and the Section 106(3) right that it limits should *both* apply *only* where distribution of material objects is at issue. If we dispense with the material object requirement for a Section 106(3) violation, we must dispense with the requirement for the Section 109 limitation and recognize the so-called “digital first sale” doctrine as valid and effective.

#### **IV. Courts that fail to focus on the material object and transactional limitations of Section 106(3) misapply the unambiguous statutory language.**

Courts have mischaracterized the Section 106(3) distribution right in several cases by permitting plaintiffs to prove their case without meeting their burden of proof on all of the statutory elements. The courts that find distribution in online infringement cases have routinely ignored the requirement that a material object change hands or ownership. This requirement renders online file transfers *per se* ineligible for coverage by the distribution right.

Aggressive plaintiffs frequently argue that a violation of the Section 106(3) distribution right flows from evidence that an alleged infringer “made a work available” to the public or “offered to distribute” a work, especially on the Internet. If the plaintiff shows that a defendant has placed a copyrighted work on a file sharing network where a member of the public could conceivably download it, they argue, courts should find that there has been a “distribution” under Section 106(3).

The leading case applying this mode of thinking in an offline context is *Hotaling v. Church of Jesus Christ of Latter-Day Saints*.<sup>28</sup> *Hotaling* dealt with a defendant library that placed photocopies of the plaintiff’s book on a shelf and was held liable for infringing the distribution right.<sup>29</sup> In *Hotaling*, the court reasoned, “[w]hen a public library adds a work to its collection, lists the work in its index or catalog system, and makes the work available to the borrowing or browsing public, it has completed all the steps necessary for distribution to the public. At that point, members of the public can visit the library and use the work.”<sup>30</sup> The court thus treated “use” of a copyrighted work as a distribution infringement. The Supreme Court has noted, however, that copyright “protection has never accorded the copyright owner complete control over all possible uses of his work. Rather, the Copyright Act grants the copyright holder “exclusive” rights to use and to authorize the use of his work in five qualified ways.”<sup>31</sup> The word “qualified” is significant.

For a violation of the distribution right to occur, however, there must be a “sale, other transfer of ownership, . . . rental, lease, or lending.” Absent other evidence, placing a book on the shelf of a library is not sufficient to show that a lending actually occurred; the plaintiffs never

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<sup>27</sup> 934 F. Supp.2d 640, 651, 655 (S.D.N.Y. 2013).

<sup>28</sup> 118 F.3d 199 (4th Cir. 1997).

<sup>29</sup> *Id.* at 202.

<sup>30</sup> *Id.*

<sup>31</sup> *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 432-33 (1984).

proved that anybody checked the book out.<sup>32</sup> It appears that the court implicitly assumed some lending must have occurred because the book sat on a shelf.

The district court's decision *In re Napster, Inc. Copyright Litigation*<sup>33</sup> paved the way for others to adopt *Hotaling*'s faulty reasoning. The dispute in *Napster* was whether operation of a central index that contained information about music files that resided on users' computer file folders was a basis for contributory infringement or vicarious liability.<sup>34</sup> The plaintiffs relied on *Hotaling* to argue that "a copyrighted work is distributed within the meaning of Section 106(3) whenever it is made available to the public without the authorization of the copyright owner."<sup>35</sup> The court rejected this broad articulation of the distribution right on the grounds that Napster did not own a copy of the file.<sup>36</sup> Consequently the court wrote that "to the extent that *Hotaling* suggests that a mere offer to distribute a copyrighted work gives rise to liability under Section 106(3), that view . . . is . . . inconsistent with the text and legislative history of the Copyright Act of 1976."<sup>37</sup>

Nevertheless, the court provided an alternative theory that would allow courts to presume a violation of Section 106(3) when one offers to disseminate music files to a group of persons for purposes of further dissemination, public performance, or public display.<sup>38</sup> The court did not apparently consider the *material object* requirement or the *sale or other transfer of ownership, rental, lease, or lending* requirement of Section 106(3). On appeal, the Ninth Circuit cavalierly ruled that violations of the distribution right occurred when users merely uploaded *file titles, not even the works themselves*, to Napster's server.<sup>39</sup> The court engaged in no analysis of the statutory language of the Section 106(3) right.

Post-*Napster*, some cases went further and followed *Hotaling* directly, applying it to the Internet and computer files context, holding that placing a file in a shared folder is in it of itself sufficient to presume a violation of Section 106(3). In *Universal City Studios, Prods., LLP v. Bigwood*,<sup>40</sup> the court cited *Hotaling* to support the proposition that making a file available to the public over the Internet was sufficient evidence to establish copyright infringement.<sup>41</sup> In *Interscope Records v. Duty*,<sup>42</sup> the court held that "mere presence of copyrighted [works] in [defendant's] share file may constitute copyright infringement." In *Motown Record Co., LP v. DePietro*,<sup>43</sup> the court held that "[a] plaintiff claiming infringement of the exclusive-distribution right can establish infringement by proof of actual distribution or by proof of offers to distribute, that is, proof that the defendant 'made available' the copyrighted work." While illegal

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<sup>32</sup> *ReDigi*, 934 F. Supp. 2d at 202.

<sup>33</sup> 377 F. Supp. 2d 796 (N.D. Cal.2005).

<sup>34</sup> *Id.* at 802–805.

<sup>35</sup> *Id.* at 803.

<sup>36</sup> *Id.* ("[In *Hotaling*,] the library had a copy of the copyrighted work in its 'collection.' Napster did not have works in its 'collection.'").

<sup>37</sup> *Id.*

<sup>38</sup> *Id.* at 804.

<sup>39</sup> *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1009, 1014 (9th Cir. 2001).

<sup>40</sup> 441 F. Supp. 2d 185 (D.Me. 2006).

<sup>41</sup> *Id.* at 190–91.

<sup>42</sup> No. 05-CV-3744, 2006 WL 988086, at \*2 (D. Ariz. Apr. 14, 2006).

<sup>43</sup> No. W-06-CA-051, 2006 WL 2844415, at \*4 (W.D. Tex. July 17, 2006).



reproduction of works onto users' computer hard drives violates Section 106(1), none of these cases required plaintiffs to present an affirmative showing that the defendant had violated all elements of Section 106(3).

**V. Extending the distribution right to cover so-called “digital file sharing” is unnecessary because unlawful “digital file sharing” violates the right of reproduction, public display, or public performance.**

Arguments for recognizing a “making available” right in current law or for adding a standalone right to alleviate the alleged difficulty of proving infringement by digital file sharers are misguided.<sup>44</sup> Every instance of unlawful digital file sharing will violate the reproduction, public display, or public performance right.<sup>45</sup> As such, it is unnecessary to recognize or codify a vague “making available” right to reach such activity.

It is a well-acknowledged principle that digital file transfers result in a reproduction.<sup>46</sup> Citing basic laws of physics, courts have recognized that “[i]t is simply impossible that the same ‘material object’ can be transferred over the Internet. . . . [T]he Internet transfer of a file results in a material object being ‘created elsewhere at its finish.’”<sup>47</sup> Indeed, the Copyright Office has long recognized that “the ultimate product of one of these digital transmissions is a new copy in the possession of a new person.”<sup>48</sup>

Users on either side of these transactions may be held liable as either direct or contributory infringers, providing that all other elements of infringement liability are present. If the user initiated the transfer by sending a digital file, for example by e-mail attachment, he may act volitionally to cause the reproduction of a copyrighted work at the recipient's end. As such, he may be subject to liability for direct infringement. A person who downloads a file to his own storage media through a peer-to-peer network may also violate the reproduction right (again assuming other elements exist), and the sponsor or “uploader” of that file may bear secondary liability for the downloader's reproduction. A person who streams a work or transmits an image to multiple persons may violate public display or performance rights, depending on the circumstances.

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<sup>44</sup> See, e.g., Menell, above note 10, at 5.

<sup>45</sup> While the rights encompassed in Section 106 indeed “are cumulative and may overlap in some cases,” that does not negate the fact that the distribution right is simply not implicated in these cases. See H.R. Rep. No. 94-1476, at 61 (1976).

<sup>46</sup> See *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d at 1014 (9th Cir. 2001) (“Napster users who download files containing copyrighted music violate plaintiffs’ reproduction rights.”); *Capitol Records, LLC v. ReDigi Inc.*, 934 F. Supp. 2d 640, 649-50 (S.D.N.Y. 2013); *London-Sire Records, Inc. v. John Doe I*, 542 F. Supp. 2d 153, 171 (D. Mass 2008) (“When a user on a peer-to-peer network downloads a song from another user, he receives into his computer a digital sequence representing the sound recording. That sequence is magnetically encoded on a segment of his hard disk (or likewise written on other media.) With the right hardware and software, the downloader can use the magnetic sequence to reproduce the sound recording.”); U.S. Copyright Office, *DMCA Section 104 Report 79* (2001), available at <http://www.copyright.gov/reports/studies/dmca/sec-104-report-vol-1.pdf>.

<sup>47</sup> *ReDigi*, 934 F. Supp. 2d at 649-50.

<sup>48</sup> Section 104 Report, above note 46, at 79.

Existing copyright rights apply to this “file sharing” conduct. Therefore the only motivation for a change to the law would be to expand liability to cover activities that are not now infringements.

## **VI. It would be unwise to broaden or otherwise codify a vague and indeterminate “making available” right.**

The Copyright Act has a careful structure, with distinct demarcations among rights and among the application of those rights to various types of works. Copyright serves an important public interest, which the Constitution describes as “promot[ing] the Progress of Science and useful Arts.”<sup>49</sup> The current Register of Copyrights has stressed that copyright is “for the author first and the nation second.”<sup>50</sup> I disagree. The Constitutional purpose is a public benefit, with an important role for authors to be sure, but with the interests of the public ultimately at stake.<sup>51</sup> Copyright is a zero-sum regime: rights for some persons are burdens or limitations on others or on the public domain. If the statutory monopoly of copyright is *for* an author, then it is *against* other authors and *against* the public by limiting their freedom of action or by increasing costs they must bear. Any recognition of a broader and vaguer “making available” right to expand the statutory monopoly of copyright requires proof that it would promote the public purposes of copyright law. While there are those who believe that no possible use of or interaction with a copyrighted work should escape control of a copyright owner, that extreme view flies in the face of the Constitutional purpose. Expansion of the statutory monopoly to embrace such a vague and indeterminate concept would also increase the costs and risks that litigation over boundaries inevitably imposes on the public. As Professor Menell has pointed out, the potential exposure alleged infringers face is massive.<sup>52</sup>

Even if Congress were to codify a vague “making available” right as a “clarification” of the Section 106(3) right pertaining to distribution,<sup>53</sup> this would likely apply to activity that already rightfully falls under the Section 106(1), (4), (5), and (6) rights relating to reproduction, public performance, and public display.<sup>54</sup> The practical result would be to multiply the number of alleged violations—both civil and criminal—that a single user could face for a single action. We have already witnessed an effort to use “making available” arguments to distort civil litigation in the notorious case by record labels against an individual, Jammie Thomas-Rasset, over her illegal download of 24 songs that she kept in a shared-files folder. The plaintiffs sued

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<sup>49</sup> U.S. Const. art. I, § 8, cl. 8.

<sup>50</sup> Judith Saffer, *Profiles in IP Law: An Interview with Register of Copyrights Maria A. Pallante*, 4 *Landslide*, no. 4, 2012.

<sup>51</sup> See Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 *Cornell L. Rev.* 857, 861 (1987) (“The statute was a complicated and delicate compromise”).

<sup>52</sup> Menell, above note 10, at 7 (“[T]he range of possibly recoverable statutory damages for each infringed work extends to \$150,000. Thus, in a case alleging infringement of thirty works, the defendant faces potential exposure of \$4.5 million.”).

<sup>53</sup> See generally *The Scope of Copyright Protection: Hearing before the Subcomm. on Courts, Intellectual Prop. and the Internet of the H. Comm. on the Judiciary*, 113th Cong. (2014) (testimony of Professor David Nimmer), available at <http://docs.house.gov/meetings/JU/JU03/20140114/101642/HHRG-113-JU03-Wstate-NimmerD-20140114.pdf>.

<sup>54</sup> See below, Part V. While these rights may overlap, that doesn’t mean they ought to be entirely usurped by a broader, new right. Cf. H.R. Rep. No. 94-1476, at 61 (1976).

not merely for the violation of the Section 106(1) reproduction right relating to the downloads but also for violation of the Section 106(3) right for allegedly “making available” the songs through their placement in the shared-files folder—even though there was no proof that she ever transmitted any files to any other person. This led to years of complex litigation and a number of different damage awards, ranging from \$54,000 to \$1,500,000.<sup>55</sup> As Judge Davis pointed out, the damages in these cases:

are wholly disproportionate to the damages suffered by plaintiffs. Thomas allegedly infringed on the copyrights of 24 songs—the equivalent of approximately three CDs, costing less than \$54, and yet the total damages awarded is \$222,000—more than *five hundred* times the cost of buying 24 separate CDs and more than *four thousand* times the cost of three CDs. While the Copyright Act was intended to permit statutory damages that are larger than the simple cost of the infringed works in order to make infringing a far less attractive alternative than legitimately purchasing the songs, surely damages that are more than one hundred times the cost of the works would serve as a sufficient deterrent.<sup>56</sup>

Why did the plaintiffs care so much about establishing a “making available” violation apart from the “reproduction” violation? While I had no involvement in the case, I believe that the plaintiffs must have thought that a suggestion (even without proof) that the defendant had “distributed” the files to other persons would justify a massive damages verdict that would seem outrageous for simple downloading.<sup>57</sup>

Additionally, many conceptualizations of “making available” would reach far beyond making it easier for rightsholders to pursue those who engage in digital file sharing. While the courts have rejected the assertion that linking to infringing content is infringing,<sup>58</sup> linking may nonetheless fall into many conceptualizations of “making available.” While the act of linking merely “provides HTML instructions that direct a user’s browser” to a website storing content, and “is not equivalent to showing a copy,” it nonetheless tells a user’s computer how to access the content.<sup>59</sup> One who links may therefore make the content available to someone, in a very broad sense, by giving instructions on how to find it. Such an understanding would not only disrupt well-settled legal principles, it could also potentially criminalize the fundamental building blocks of the Internet.<sup>60</sup>

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<sup>55</sup> See *Capitol Records, Inc. v. Thomas-Rasset*, 692 F.3d 899, 901-02 (8th Cir. 2012).

<sup>56</sup> *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d at 1227 (D. Minn. 2008) (emphasis in original).

<sup>57</sup> *Id.* at 1215 (“Thomas . . . place[d] them in a shared folder . . . available to anyone who wanted them on a computer network dedicated to the illegal distribution of copyrighted works.”).

<sup>58</sup> See *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007).

<sup>59</sup> *Perfect 10 v. Amazon*, 508 F.3d at 1161.

<sup>60</sup> The Internet is a “global Web of linked networks and computers. . . . Links from one computer to another, from one document to another across the Internet, are what unify the Web into a single body of knowledge, and what makes the Web unique.” *ACLU v. Reno*, 929 F. Supp. 824, 831, 836-37 (E.D. Pa. 1996).

Undue expansion of the Section 106(3) right, through a broad conception of “making available,” would also disturb settled expectations in transactions and legal relationships that rest upon existing classifications of rights in Section 106. For example, if a company buys a license to engage in a public performance such as a broadcast, characterizing that act also as a “making available” under Section 106(3) would make the performance licensee liable for violating the “making available” right if the licensee had not had the forethought to anticipate adding Section 106(3) to the scope of the license. Expansion of the Section 106(3) right to cover overlap with other copyright rights would allow licensors of those other rights to demand a second license to cover the same activity. This would wreak havoc in the marketplace.

## **VII. The United States has met its treaty obligations to provide a “making available” right under other enumerated rights.**

The Berne Convention and the WIPO Copyright Treaty provide for the exclusive right to authorize the making available of both physical works and communications of works. Plaintiffs in the United States have argued that the distribution right in Section 106(3) must cover both types of “making available” to comply with the WCT.<sup>61</sup> Consequently, they argue that interpreting this right as falling outside the scope of Section 106(3) would violate our treaty obligations. This argument misinterprets the WCT as well as our canons of interpreting treaty obligations.

The Berne Convention provides no clear distribution right, but it does distinguish a distribution from the rights of “communications to the public” and “reproductions.”<sup>62</sup> Under the Berne Convention, authors have, among others, the right to authorize:

- (i) Reproductions of their works in any manner or form;<sup>63</sup>
- (ii) Broadcasting, rebroadcasting or communication (by wired or wireless means) to the public (not including sound recordings);<sup>64</sup> and
- (iii) Distributions of cinematographic reproductions.<sup>65</sup>

The Berne Convention was not drafted in contemplation of files being transferred over the Internet. While it does not expressly require distribution to be limited to physical copies, it gives signing parties the freedom to limit it as such in their own implementation of the treaty.<sup>66</sup> While Berne provided a communication right, it did not contain a “making available” right. The WCT,<sup>67</sup> signed in 1996, updated some of these rights to take the digital environment into

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<sup>61</sup> See, e.g., *Elektra Entm't Grp., Inc. v. Barker*, 551 F. Supp. 2d 234 (S.D.N.Y. 2008); *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210 (D. Minn. 2008); *Arista Records LLC v. Greubel*, 453 F. Supp. 2d 961 (N.D. Tex. 2006).

<sup>62</sup> The Berne Convention for the Protection of Literary and Artistic Works, September 9, 1886, as revised at Paris on July 24, 1971, 1161 U.N.T.S. 30.

<sup>63</sup> *Id.* at art. 9.

<sup>64</sup> *Id.* at art. 11*bis*(1).

<sup>65</sup> *Id.* at art. 14.

<sup>66</sup> *Id.* at art. 2.

<sup>67</sup> World Intellectual Property Organization Copyright Treaty, Dec. 20, 1996, S. Treaty Doc. No. 105-17 (1997); 36 I.L.M. 65 (1997) [hereinafter WCT].

consideration. It was the WCT that created the “making available” right. WCT gave authors the exclusive right to authorize:

“The making available to the public of the original or copies of works through sale or other transfer of ownership;”<sup>68</sup> and

“any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them.”<sup>69</sup>

Thus, two separate articles provide a “making available” right, each concerning different types of works and activities. Article 6 is titled the “Right of Distribution,” while Article 8 is titled the “Right of Communication to the Public.” The Agreed Statement to Articles 6 and 7 explains that the term “copies” that are subject to the distribution right refers “exclusively to fixed copies that can be put into circulation as tangible objects.”<sup>70</sup> Thus, the treaty clearly separates transfers of ownership of material works from communications of works intangibly over the Internet. It provides a rightsholder the exclusive right to make works available in two different contexts.

Neither treaty provides a single broad “making available” right. “Making available” is either the right to make physical copies available for transfer of ownership, or the right to make communications of works available to the public. Wireless transfers fall under the right of communication.<sup>71</sup> Article 8 expressly states that the right it provides covers situations in which members of the public will access the communication at a different time and place. Such a provision further exemplifies that the right thereunder applies to intangible works dealt with in the digital environment.

Plaintiffs have argued that compliance with WCT requires Section 106(3) to cover all of the “making available” right, but this misinterprets the right.<sup>72</sup> The *Charming Betsy* doctrine is the legal canon which provides that federal statutes must be construed so as not to violate international agreements when other interpretations exist.<sup>73</sup> Under this canon of construction, plaintiffs argue, Section 106(3) must cover all formulations of “making available” so as not to violate treaty obligations. Their reasoning is that by not interpreting Section 106(3) to cover all forms of making available, the U.S. would provide no “making available” right, thereby violating the WCT. That argument conflates the two distinct rights under the WCT into one broad “making available” right.

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<sup>68</sup> *Id.* at art. 6.

<sup>69</sup> *Id.* at art. 8.

<sup>70</sup> WCT, “Agreed statements concerning Articles 6 and 7.”

<sup>71</sup> WCT at art. 8.

<sup>72</sup> See, e.g., *Elektra Entm't Grp., Inc. v. Barker*, 551 F. Supp. 2d 234 (S.D.N.Y. 2008); *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210 (D. Minn. 2008); *Arista Records LLC v. Greubel*, 453 F. Supp. 2d 961 (N.D. Tex. 2006).

<sup>73</sup> *Murray v. The Schooner Charming Betsy*, 6 U.S. 64, 118 (1804).

United States law already recognizes the two distinct rights of Articles 6 and 8.<sup>74</sup> Because Article 6 refers to transfers of ownership, Section 106(3) clearly satisfies this provision. The rights of communication to the public correspond to Sections 106(4)-(6). It is not unreasonable to interpret “communications to the public” as transmissions or public performances. There is no need to interpret Section 106(3) to encompass a “making available” through intangible transmissions; other provisions of Section 106 fulfill the making available of communications under Article 8.

Foreign courts have consistently distinguished transmissions of files from distributions of physical copies.<sup>75</sup> The right at issue in file sharing cases is correctly and consistently analyzed under Article 8’s communication right and the Information Society Directive, which implemented it in the EU.<sup>76</sup> Applying this provision in Internet cases follows the explicit language of Article 8, distinguishing between physical distribution and non-physical communications.

A broad interpretation of Section 106(3) to encompass all of the “making available” right is therefore unnecessary to comply with the WCT. Rather than seeking to enforce such a right under Section 106(3), United States copyright law complies with international treaties by means of other provisions. The treaty provides two distinct rights, and the international community has implemented them accordingly. Establishing that “making available” communications to the public is not a distribution under Section 106(3) would clarify the international rights of copyright holders and provide a more uniform framework for enforcing them.

## **VIII. Conclusion**

For the reasons I have set forth, it would be both unnecessary and unwise to expand Section 106(3) of the Copyright Act to cover vague and indeterminate conceptions flowing from the imprecise shorthand reference to the “right of making available.”

Respectfully submitted,

Andrew P. Bridges  
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<sup>74</sup> 17 U.S.C. § 106(3); 17 U.S.C. § 106(4)-(6).

<sup>75</sup> *See, e.g.*, Case C-607-11, *ITV Broadcasting Ltd. v. TVCatchup Ltd.*, 3 C.M.L.R. 1 (2013); Case C-466/12, *Svensson and others v. Retriever Sverige AB*, 2014 ECR I-\_\_ (2014); Case C-466/12, *OSA - Ochranný svaz autorský pro práva k dílům hudebním, o.s. (OSA) v. Léčebné lázně Mariánské Lázně a. s.*, [2014] ECR I-h (2014).

<sup>76</sup> Council Directive 2001/29/EC, 2001 O.J. (L 167).