

The Role of Volition in Evaluating Direct Copyright Infringement Claims Against Technology Providers

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I. Introduction

Historically, when the exclusive rights of copyright owners under 17 U.S.C. § 106 were violated, determining the identity of the tortfeasor was not difficult. The relatively straightforward nature of infringement, combined with common law principles of joint and several liability and contributory and vicarious infringement, allowed plaintiffs to enjoin and seek recovery from the appropriate parties involved in infringing acts. But when freestanding technologies such as video tape recorders and connected technologies such as the Internet began to enter the marketplace, the courts found themselves challenged to pinpoint who was directly or indirectly responsible for copying copyrighted works.¹

The question became even more difficult when one of the actors involved had a viable defense (such as fair use): if the party found to be the direct infringer had a meritorious affirmative defense, any alleged indirect infringers arguably also would be absolved. These latter parties would, in turn, have a strong incentive to ensure that rather than becoming direct infringers—either by their own conduct or through principles of joint and several liability—they would at most be potential indirect infringers (and thus able to make arguments unavailable to direct infringers).

Nowhere has the issue of distinguishing direct from indirect infringement been more hotly contested recently than in the context of claimed violations of the reproduction right. From concerns about vast copying over Internet networks to the ability to offer a “remote storage” digital video recording system to the launch of online services claiming to be akin to a virtual used-record store, courts in recent years have had to make tough calls regarding the allocation of liability. In making these calls, courts have focused on the question of volition, i.e., “Who is doing the copying?”

The courts’ application of the concept of volition— and the consequences of that application—may be more prominent in copyright law now than ever before. A review of decisions from the time the concept took hold in 1995 reveals that the principle of volition has been applied inconsistently and is not always well understood. Meanwhile, volition has become central to closely watched lawsuits over ad-skipping recording technologies, “cyberlockers,” and virtual used-record stores. This article examines the challenges presented by the concept of volition, starting with the origin of the concept, then summarizing its evolution and describing how it has been applied in difficult cases standing at the intersection of copyright law and new technology.

II. The Evolution of Volition

A. Incidental Infringement and the Internet: Genesis of Volition in *Netcom*

The scope and contours of volition are best understood by starting with the Internet service provider before enactment of the Digital Millennium Copyright Act of 1998 (DMCA). All of the rulings discussed in this article have roots in the 1995 California district court ruling in *Religious Technology Center v. Netcom On-Line Communication Services, Inc.*,² better known as *Netcom*. *Netcom* was one of the first federal court decisions to address intellectual property rights in cyberspace, and its legacy has been long-lasting despite intervening legislation and case law.

Netcom was a large Internet service provider that offered access to, among other things, online bulletin boards maintained by others. *Netcom*’s co-defendant, Tom Klemesrud, provided a bulletin board system that hosted the online forum called alt.religion.scientology (ARS). Plaintiff Religious Technology Center (RTC) owned the copyrights in various published and unpublished works of L. Ron Hubbard, founder of the Church of Scientology. The gravamen of RTC’s complaint was that former minister and Scientologist-turned-detractor (and additional co-defendant) Dennis Erlich had posted portions of Hubbard’s works on ARS.

RTC asked Erlich to stop posting the works, but he refused. RTC then approached Klemesrud, who asked RTC for proof of copyright ownership before removing Erlich from the forum. RTC rejected the request as unreasonable and instead asked *Netcom* to kick Erlich off the forum. *Netcom* refused. Although *Netcom* observed a policy of suspending accounts of subscribers who violated *Netcom*’s terms and conditions, it took no action against Erlich even after receiving warnings from RTC because “it could not shut out Erlich without shutting out all of the users of Klemesrud’s [bulletin board system].”³

In the ensuing lawsuit, the court was faced with the question of whether *Netcom* was directly liable for copyright infringement. Did *Netcom* itself violate RTC’s exclusive rights of reproduction, public distribution, and public display? The court found that Erlich’s postings to ARS were first transmitted to, and briefly (automatically) stored on, Klemesrud’s computer. Subsequently, preset processes in *Netcom*’s software resulted in the automatic copying of Erlich’s postings from Klemesrud’s computer onto *Netcom*’s computers and then onto the computers of ARS users. The postings were saved on *Netcom*’s and Klemesrud’s system for several days. The court noted, however, that *Netcom* did not “create or control the con-

tent of the information available to its subscribers,” nor did it monitor messages as they were posted.⁴

Within this framework, the court addressed a then-novel question: “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.”⁵ The court clearly was troubled by the possibility that a provider of Internet access could be held directly liable for copyright infringement solely by virtue of “designing or implementing a system that automatically and uniformly creates temporary copies of all data sent through it....”⁶ Under a common-sense approach, if anyone was the direct infringer, it should have been Erlich; Netcom “did not take any affirmative action that directly resulted in copying plaintiffs’ works” other than by utilizing software to automatically forward messages from third-party subscribers to the online community and temporarily storing copies of them.⁷ Indeed, Netcom did “no more than operate or implement a system that is essential if Usenet messages are to be widely distributed.”⁸ In the court’s view, holding Netcom liable as a direct infringer would “lead to unreasonable liability” for online service providers when computer servers act automatically “without any human intervention beyond the initial setting up of the system.”⁹

Invoking policy considerations, the court explained that “[w]here 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,” particularly because the court found unworkable “a theory of infringement that would hold the entire Internet liable for activities that cannot reasonably be deterred.”¹⁰

The court’s solution to avoiding a potentially deleterious outcome was to adopt a gloss on the meaning of direct liability. In an oft-quoted passage, the court introduced the concept of volition, noting that “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.*”¹¹ Within this framework, the court was able to resolve the case without, in its view, endangering the functioning of the Internet. Because Erlich was the party responsible for uploading the works and otherwise making them available to others in the online forum, whereas all Netcom did was to function in its normal operation as an ISP to effectuate the supplier’s wishes, neither “volition or causation” could be attributed to Netcom, which therefore was not subject to direct infringement liability.

Notably, however, the court did not define the element of “volition or causation” other than to note its absence. The confusion over the meaning of this so-called “element” would set the stage for the next phase

of battles over the scope and meaning of direct copyright infringement in the digital age.¹²

B. Volition Under the Microscope: How Much Is Enough?

Shortly after *Netcom*, the DMCA was enacted. The DMCA safe harbors for online service providers arguably laid to rest the *Netcom* court’s concern that all ISPs might become direct infringers inadvertently: under the DMCA, an ISP that meets certain criteria could avoid any liability—direct or indirect—if it took certain steps to remedy infringement taking place on or through its system.¹³ Yet, as a divided Fourth Circuit panel would hold in *CoStar Group, Inc. v. LoopNet, Inc.*,¹⁴ the principle of volition would continue to live in copyright law jurisprudence. A few years thereafter, in *Cablevision*, the Second Circuit would elaborate on what does and does not constitute volition. In doing so, the Second Circuit would embed *Netcom*’s principles in a broader arena of copyright law and set the stage for their appearance in cases involving myriad new technologies, not just Internet services.

1. CoStar and Quantum: The Fourth Circuit defines and refines volition

The alleged direct infringer in *CoStar* was an Internet service provider whose website allowed subscribers to post listings of commercial real estate.¹⁵ What made LoopNet materially different from Netcom was the fact that LoopNet screened content supplied by third parties before it was posted on the site. Specifically, rather than posting everything a user requested be posted, a LoopNet employee would cursorily review the photograph before making it available. The employee would determine whether the photograph did indeed depict commercial real estate and would identify any obvious evidence (such as a text message or copyright notice) that the photograph may have been copied by a third party. If the photograph passed these criteria, the employee would click an “accept” button that would make the photograph available for viewing online. In addition, if LoopNet received a take-down notice, its employee would not only remove the complained-of photograph from the site but also would compare the property shown in the photograph to other photographs in order to determine whether the images were the same.

CoStar, a provider of real estate information, sued LoopNet over its involvement in making copyrighted photographs available on its site. The district court, following *Netcom*, concluded that LoopNet was not directly liable for copyright infringement. On appeal to the Fourth Circuit, CoStar argued that *Netcom*’s volition rule had been abrogated by the DMCA and that the actions of LoopNet’s employees were, in any event, sufficient to establish volition on the part of LoopNet. The court disagreed, reaffirming *Netcom*’s conclusion that merely operating a “machine” did not amount to volitional conduct necessary for direct infringement. The court

explained that infringement “requires *conduct* by a person who *causes* in some meaningful way an infringement[.]” and that the party directly liable is the one “who *actually engages* in infringing conduct[.]”¹⁶ The court further explained:

[S]omething more must be shown than mere ownership of a machine used by others to make illegal copies. There must be actual infringing conduct with a nexus sufficiently close and causal to the illegal copying that one could conclude that the machine owner himself trespassed on the exclusive domain of the copyright owner.”¹⁷

CoStar argued that LoopNet’s involvement in screening its content rose to the level of direct infringement, i.e., that it constituted “sufficient intervening conduct of the ISP.”¹⁸ The court again disagreed, finding that a mere gatekeeping with respect to photographs uploaded by others was not a sufficient basis for imposing liability.¹⁹ In particular, the court explained that the “volitional conduct to block photographs measured by two grossly defined criteria...which takes only seconds, does not amount to ‘copying,’ nor does it add volition to LoopNet’s involvement in storing the copy.”²⁰ If anything, the court noted, LoopNet employees’ involvement would *lessen* the likelihood that copyrighted works would be displayed because it “prevents users from duplicating certain photographs.”²¹ LoopNet’s “perfunctory gatekeeping process” could not be direct infringement, the court held, if it “further[ed] the goals of the Copyright Act...”²²

In a vigorous dissent, Judge Roger L. Gregory took the position that defining “volition” to exclude the actions (albeit laudable) taken by LoopNet was a bridge too far. He argued that the majority “expands the non-volitional defense well beyond *Netcom* and subsequent holdings, and gives direct infringers in the commercial cybersphere far greater protections than they would be accorded in print and other more traditional media.”²³ In Judge Gregory’s view, only a “passive conduit” for copyrighted material avoids being a direct infringer under *Netcom*, and the majority “profoundly deviate[d]” from that approach.²⁴ In a comment that foreshadowed cases to come, Judge Gregory criticized the majority’s characterization of LoopNet as an analog to old technology (in this case, a copy machine) as well as the majority’s focus “on the fact that it is *the subscriber*, not LoopNet, who begins the volitional process, i.e., the subscriber is the initial direct infringer.”²⁵ In Judge Gregory’s view, this distinction was illusory, and the inquiry into “volition” or “causation” required looking at the actions of the specific defendant, not at its relationship to other participants in the alleged infringement. “That another person initiated the process which led to LoopNet’s infringement is of no consequence,” Judge Gregory wrote. “LoopNet remains

the pivotal volitional *actor*, ‘but for’ whose action, the images would never appear on the website.”²⁶

A few years later, the Fourth Circuit limited its *CoStar* holding in *Quantum System Integrators, Inc. v. Sprint Nextel Corp.*²⁷ In that case, the plaintiff, a software licensor, had licensed a data monitoring program to Sprint between 1997 and 2004. In 2006, the parties settled a prior lawsuit concerning Sprint’s purportedly unauthorized use of the software in 2005, but Quantum sued for copyright infringement again in 2007, alleging that Sprint still retained copies of the software on a few computers and that Sprint computers were continuing to copy Quantum’s software into RAM when the computers were turned on. The district court denied Sprint’s motion for judgment as a matter of law, leaving in place the jury’s finding that Sprint was liable for infringing Quantum’s copyright in the software.

On appeal, Sprint argued that “there was no evidence that [it] had engaged in ‘volitional copying’” as defined in *CoStar*.²⁸ The Fourth Circuit held, however, that “Sprint overstates the ‘volitional’ requirement purportedly established by *CoStar*” because *CoStar* “concerned a copyright holder suing an Internet Service Provider...for providing services used by third parties to upload infringing photographs to the Internet.”²⁹ The court found *CoStar* distinguishable because the ISP there had “provided ‘electronic infrastructure designed and managed as a conduit of information and data’ such that ‘the owner and manager of the conduit hardly copies the information and data’” in violation of the Copyright Act.³⁰ Indeed, the court explained that *CoStar* limited the “volition” and “causation” requirement to “the context of the conduct typically engaged in by an ISP.”³¹ Accordingly, *CoStar* was inapposite because the claims against Sprint did “not involve third-party copyright infringement or the ‘automatic copying, storage, and transmission of copyrighted materials...instigated by others,’” nor did they involve “a defendant that engages in ‘conduct typically engaged in by an ISP.’” Rather, the case concerned “copying that, at bottom, was instigated by Sprint’s own employees” and was, in fact, volitional vis-à-vis Sprint employees booting up its computers and copying Quantum’s software into RAM.³²

In sum, the Fourth Circuit’s definition of volition would seem to be limited to cases involving ISPs and the processing of copyrighted content provided by third parties without any instigation of infringement by the ISP. However, under the Second Circuit’s intervening analysis in *Cablevision*, volition would appear to be a more far-reaching concept.

2. ***Cablevision*: Direct and indirect infringement beyond the Internet**

In March 2006, Cablevision announced its intention to launch a service that—to the customer—would look and operate just like a set-top DVR, except that all of the

storage would occur in Cablevision's facilities rather than within the set-top boxes in the homes of Cablevision subscribers.³³ Cablevision argued that—in essence—the net effect of what it called the “Remote Storage DVR” (RS-DVR) would be exactly the same as that of the Betamax video cassette machine at issue in the seminal Supreme Court decision *Sony Corp. v. Universal City Studios, Inc.*³⁴ However, the case was not a modern-day re-do of *Sony* or a case about contributory liability at all. Far from it, at least as stipulated by the parties: the plaintiff motion picture and television program copyright owners agreed not to raise contributory liability theories, and Cablevision agreed not to assert a fair use defense.³⁵

Cablevision argued that it did not directly infringe the plaintiffs' reproduction rights because it was, at most, providing customers with machinery to make copies.³⁶ After a full-day *Markman*-style hearing on how the technology functioned, the district court disagreed that Cablevision was merely a passive actor with respect to its subscribers' copying of programs through the RS-DVR. The court found instead that “[t]he RS-DVR is clearly a service,” and “in providing this service, it is Cablevision that does the copying.”

According to the district court, the RS-DVR was nothing like a stand-alone piece of machinery: it could not function without a continuing relationship between Cablevision and its customers.³⁷ Cablevision would (1) decide which programming channels to make available for recording; (2) provide that content; (3) house, operate, and maintain the rest of the equipment that would make the recording process possible; (4) maintain physical control of the equipment at its “head-end”; (5) monitor the programming streams at the head-end and ensure that the servers were working properly; and (6) determine how much memory to allot to each customer and reserve storage capacity for each customer on a hard drive at its facility, which could be augmented for an additional fee.³⁸ To make the RS-DVR operable, Cablevision had to reconfigure the linear channel programming signals received at its head-end by splitting the aggregated program stream into a second stream, reformatting it, and rerouting it to the server bank. In sum, according to the district court, Cablevision “would be ‘doing’ the copying, notwithstanding that the copying would be done at the customer's behest, and Cablevision would provide the content being copied.”³⁹

The court rejected Cablevision's reliance on *Netcom*, finding that Cablevision was not similar to an ISP, which is “confronted with the free flow of information that takes place on the Internet, which makes it difficult for ISPs to control the content they carry.”⁴⁰ Cablevision, by contrast, had “unfettered discretion in selecting the programming that it would make available for recording through the RS-DVR” and was “the driving force behind the RS-DVR's recording and playback functions.”

The court found this to be “a far cry from the ISP's role as a passive conduit in *Netcom*” and that the copies made to the ISP's computers in *Netcom* were “incidental to the ISP's providing of Internet access,” whereas the copies made through the RS-DVR were “instrumental to the RS-DVR's operation.”⁴¹

On appeal, the Second Circuit came to an entirely different conclusion. As the court put it: “The question is *who* made this copy. If it is Cablevision, plaintiffs' theory of direct infringement succeeds; if it is the customer, plaintiffs' theory fails because Cablevision would then face, at most, secondary liability, a theory of liability expressly disavowed by plaintiffs.”⁴² The court observed that few cases had examined the line between direct and contributory liability and then proceeded to examine that line.⁴³

The court started with the district court's rejection of *Netcom*. Just as the Fourth Circuit in *CoStar* found that *Netcom* survived the DMCA, the Second Circuit found that *Netcom*'s reasoning and conclusions “transcend[ed] the Internet.”⁴⁴ With this principle established, the Second Circuit proceeded to compare the RS-DVR to the Sony VCR—despite the facts that the question of direct versus contributory liability was not presented in *Sony* and that none of the hardware providers (such as Arroyo) were defendants in *Cablevision*, as they had been in *Sony*. The court decided that either the user *or* the supplier of the equipment could be the direct infringer, but not both:

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.⁴⁵

The court then observed that it did not believe an RS-DVR customer was “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.”⁴⁶

The court went on to explain that most of the facts the district court found to be dispositive on the issue of direct liability (such as Cablevision's “continuing relationship” with RS-DVR customers, its control over recordable content, and the “instrumentality” of the system's copying) were “more relevant to the question of contributory liability”—even though, again, contributory liability was not at issue.⁴⁷ The court also emphasized the importance of maintaining “a meaningful distinction between direct and contributory copyright infringement,” which it did not believe the district court had done.⁴⁸ Although the court expressly limited its holding to the facts of the case, it has proven to be an influential ruling.

C. Pushing Buttons and Pointing Fingers: The Continued Confusion Over Liability in the “Volition” Age

After *CoStar* and *Cablevision*, it is little wonder that commentators have hoped that courts would “cabin the excellent decision that Judge Whyte issued in *Netcom* under the law then applicable....”⁴⁹ Despite this wish, it has not come to pass. Instead, following *CoStar* and *Cablevision*, the courts have continued to grapple with how to apply the concept of volition to a variety of technologies—including technologies comparable to the Internet-based technology at issue in *Netcom*. The results have been far from consistent.

For example, when the New York district court addressed direct infringement and volition in *Arista Records LLC v. Usenet.com, Inc.*⁵⁰ on facts similar to those present in *CoStar*, it reached the opposite conclusion from that of the Fourth Circuit in *CoStar*, relying on a combination of the defendants’ knowledge of infringement and control over newsgroups (factors associated with secondary liability). Specifically, in assessing whether the website Usenet.com could be directly liable for infringements of copies of musical works posted to the Usenet network of online bulletin boards, the court found on summary judgment that the defendants acted with the requisite volition: they were not mere “passive providers of a space in which infringing activities happened to occur” but rather were “active participants in the process of copyright infringement” because they (1) were aware that digital songs were popular files shared on their bulletin boards; (2) “took active measures to create servers dedicated to mp3 files”; and (3) “took active steps, including both automated filtering and human review, to remove access to certain categories of content” and exercise control over newsgroups.⁵¹

In contrast, a federal court in Florida rejected *Usenet* in holding that “cyberlocker” Hotfile was not directly liable for copyright infringement.⁵² The court found hotfile.com to be more akin to *Netcom*—a passive system that “allows users to automatically upload or download copyrighted material”—than to Usenet.⁵³

If this were not enough to illustrate the diversity of approaches to volition, in some circuits the law on volition is internally inconsistent or otherwise unsettled. For instance, the First Circuit, in *Society of the Holy Transfiguration Monastery, Inc. v. Gregory*, declined to decide whether “a volitional act *must* be shown to establish direct copyright infringement” because it found that the plaintiff—a monastery that owned the copyrights in English translations of ancient Greek religious texts—would prevail on its direct infringement claims regardless of such a requirement.⁵⁴ The defendant had “act[ed] to ensure that copies of the [infringed] Works were available on his server and posted to his Website.”⁵⁵ However, the Massachusetts district court in *Hearst Stations Inc. v. Aereo, Inc.*⁵⁶ held that volitional conduct could form the basis of

a claim of direct infringement of the reproduction right. In evaluating the plaintiff broadcast network’s motion for a preliminary injunction against an Internet retransmitter of over-the-air cable television signals, the court held that a volition requirement “comports with the general principle that, even with a strict liability statute such as the Copyright Act, the challenged conduct must cause the harm” and that it was “likely that the [Aereo] user supplies the necessary volitional conduct to make the copy.”⁵⁷ Until the Ninth Circuit decided *Fox Broad. Co., Inc. v. Dish Network L.C.C.*,⁵⁸ it appeared that certain district courts within the Ninth Circuit—like the *Gregory* court—declined to follow *Netcom*.⁵⁹

Perhaps nowhere is the confusion regarding volition more apparent than in the recent rulings in *Dish Network and Capitol Records, LLC v. ReDigi Inc.*⁶⁰—both far cries from the ISP in *Netcom*. In *Dish Network* a California district court evaluated whether Dish Network—whose DVR technology allowed viewers to copy entire prime-time television lineups—was directly liable for the copying of broadcasters’ copyrighted programming. In a break from its fellow district courts that had previously declined to address the question of volition, the *Dish Network* court reviewed the line of volition cases from *Netcom* to *Cablevision*. The court analyzed various aspects of Dish Network’s service, including Dish Network’s discretion over (1) the selection of programming available for recording, (2) when recording begins and ends, and (3) the length of time each copy is available for viewing, and compared them to *Cablevision*’s RS-DVR service (among other technological analogues discussed in various cases). The court concluded that while Dish “exercises a degree of discretion over the copying process beyond that which was present in *Cablevision*...the Court is not satisfied that [Dish Network’s “Prime Time Any Time” copying system] has crossed over the line that leads to direct liability.”⁶¹ Accordingly, the court held that Fox had not established a likelihood of success on the merits of its direct copyright infringement claim against Dish Network. On July 24, 2013, the Ninth Circuit affirmed, finding that the district court did not abuse its discretion in finding that the user, not Dish, caused the copies to be made.⁶²

By contrast, the New York district court in *ReDigi* treated *Cablevision* with less deference, placing more emphasis on the defendants’ intent in programming their software and in creating their technological infrastructure. In *ReDigi*, record companies sued a website operator that offered users a service for selling legally purchased “used” digital music files through a web-based platform. A seller would use ReDigi’s software to upload her music files to a cloud-based digital locker. Upon purchase by a buyer, the software would delete the purchased files from the seller’s computer. The court held that ReDigi’s unauthorized transfer of files from a seller’s computer to ReDigi’s cloud-based locker violated the plaintiffs’ reproduction right, even though only one file existed both before and after the transfer. The court found that the

reproduction right necessarily was implicated when a copyrighted work is embodied in a new material object and that digital music files are not “sold” in the traditional sense: they inherently are “embodied in a new material object following their transfer over the Internet,”⁶³ such that the first sale doctrine, which requires the transfer of a unique copy, did not apply.⁶⁴

In evaluating whether ReDigi was a direct infringer, the court found *Cablevision* distinguishable, as ReDigi was instead like the hypothetical defendant alluded to in *Cablevision* whose “contribution to the creation of an infringing copy [is] so great that it warrants holding that party directly liable for the infringement, even though another party has actually made the copy.”⁶⁵ Specifically, the court found that ReDigi had created software with the sole purpose of “build[ing] a list...of protected music purchased on iTunes” and actively chose copyrighted content, which made *ReDigi* indistinguishable from cases in which “human review of content gave rise to direct liability.”⁶⁶ The court found that even though the scanning and uploading processes were automated by ReDigi’s software, the site’s principals had engaged in volitional conduct sufficient to render the case “indistinguishable from those [such as *Usenet*] where human review of content gives rise to direct liability.”⁶⁷ Unlike *Cablevision*, ReDigi and its principals took a “fundamental and deliberate role” by “provid[ing] the infrastructure for its users’ infringing sales and [by] affirmatively brokering sales” of copyrighted digital audio files.⁶⁸ Accordingly, the court granted the plaintiff’s motion for summary judgment on its claims for direct infringement of its distribution and reproduction rights.

III. Conclusion: Is Volition an Ever-Moving Target?

For all the expressed desire to draw lines between direct and indirect liability, the volition doctrine’s meaning and effects remain murky. Based on recent cases, *Netcom* appears to be here to stay, at least for a while. But as the various decisions discussed above show, there has been little explanation of what volition means and hence little predictability as to when and where it will be found. In the Second and Ninth Circuits, *Netcom* principles apply in cases beyond those involving ISPs, but this is less clear in the Fourth and perhaps other circuits. Moreover, some courts focus on the defendant’s specific role, while others examine the acts of multiple parties in relation to one another, along the lines of common law principles of comparative fault or contributory negligence. And, as the networks argued in their August 2013 petition for rehearing en banc in *Dish Network*, the Ninth Circuit’s conception of volition threatens to read joint and several liability out of the Copyright Act and conflicts with principles of direct liability in the law of other circuits.⁶⁹

Even when trying to reason by analogy between old and new technology, the results seem inconsistent. One

could argue that the RS-DVR and Dish’s “Prime Time Anytime” look to the consumer to be functionally similar to the VCR at issue in *Sony*, but that does not explain the rejection of ReDigi’s argument that its service, from the consumer’s perspective, looks like the digital equivalent of a used record store.⁷⁰ Moreover, “Prime Time Anytime” copies all programming—regardless of whether the subscriber wants it—while ReDigi copies only the files that the subscriber wishes to sell. Thus, the outcomes in the two cases—with direct infringement found in the latter but not the former—suggest that control over the actual copying is irrelevant.

These cases illustrate the problem of resolving issues presented by new technology “as best we can in light of ill-fitting existing copyright law.”⁷¹ In some cases, where new technology has a perceived societal benefit that prevails over the arguable rights of copyright owners, Congress has revised the Copyright Act. It did so with the DMCA, the Family Movie Act, and countless other revisions to the statute. An outcome such as the one in *Dish Network*, where the court invoked “volition” to bless technology that arguably would cannibalize the advertising revenues that support the creation of the plaintiffs’ copyrighted television programs, is a far cry from what the court in *Netcom* was concerned about, namely, crippling the Internet. Particularly given calls for the “next great Copyright Act,” the best guidance may come from Justice Blackmun’s dissent in *Sony*, where he wrote that “in the absence of a congressional solution [to problems created by the interaction of copyright law with a new technology], courts cannot avoid difficult problems by refusing to apply the law. We must take the Copyright Act...as we find it, [] and do as little damage as possible to traditional copyright principles...until the Congress legislates.”⁷²

Until then, the Copyright Act “as we find it” remains unsettled when it comes to volition. Provider beware.

Endnotes

1. *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 435 n.17 (1984) (“*Sony*”) (“As the District Court correctly observed, however, ‘the lines between direct infringement, contributory infringement and vicarious liability are not clearly drawn....’”) (citation omitted).
2. 907 F. Supp. 1361 (N.D. Cal. 1995).
3. *Id.* at 1368.
4. *Id.*
5. *Id.* at 1368.
6. *Id.* at 1369.
7. *Id.*
8. *Id.* at 1369-70.
9. *Id.* at 1369.
10. *Id.* at 1372.
11. *Id.* at 1369-70 (emphasis added).
12. The concept of volition as applied to direct liability for copyright infringement is different from the concept of “knowledge,” which is an element of contributory liability—one of the forms of

- secondary liability for copyright infringement. Rather, volition has generally been held to be synonymous with “causation” rather than “knowledge” or “intent.” See, e.g., *Perfect 10, Inc. v. Giganeus, Inc.*, No. CV11-07098 AHM (SHx), 2013 WL 2109963, at *6 (C.D. Cal. Mar. 8, 2013) (“In this Court’s view, the key to understanding the so-called ‘volitional conduct’ requirement is to equate it with the requirement of causation, not intent.”); *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F.3d 121, 130 (2d Cir. 2008) (hereinafter *Cablevision*) (the goal of the volition inquiry is to determine “who made this copy” and to “identify the actor (or actors) whose ‘conduct has been so significant and important a cause that [he or she] should be legally responsible’”) (citations omitted); *CoStar Group, Inc. v. LoopNet, Inc.*, 373 F.3d 544, 549 (4th Cir. 2004) (“While the Copyright Act does not require that the infringer know that he is infringing or that his conduct amounts to a willful violation of the copyright owner’s rights, it nonetheless requires conduct by a person who causes in some meaningful way an infringement.”); *Perfect 10, Inc. v. Cybernet Ventures, Inc.*, 213 F. Supp. 2d 1146, 1168 (C.D. Cal. 2002) (noting that *Netcom* equated volition with causation); *Sega Enters., Ltd. v. MAPHIA*, 948 F. Supp. 923, 932 (N.D. Cal. 1996) (same). But see *Arista Records LLC v. Myxer Inc., f/k/a Visible Techs., Inc.*, Case No. CV 08-3935-GAF (JCx) (2011) (appearing to interpret “volition” as requiring intent).
13. See 17 U.S.C. § 512.
 14. 373 F.3d 544 (4th Cir. 2004).
 15. *Id.* at 547.
 16. *Id.* at 549-50 (emphases in original).
 17. *Id.* at 550.
 18. *Id.*
 19. *Id.* at 556.
 20. *Id.*
 21. *Id.* (emphasis in original).
 22. *Id.* The *CoStar* court further distanced itself from the question of whether LoopNet was violating the reproduction right by calling into question whether the copies were “fixed” in the first place. It noted that the ISP was more like a “conduit” for fast-moving information rather than a copier: “the ISP transmits users’ material but is itself totally indifferent to the material’s content. In this way, it functions as does a traditional telephone company when it transmits the contents of its users’ conversations.” *Id.* at 551. Pointing to the thousands of people and entities involved in the functioning of the Internet, *CoStar* opined that “their conduct is not truly ‘copying’ as understood by the Act; rather, they are conduits from or to would-be copiers and have no interest in the copy itself.” *Id.* The court’s view was not directed toward a concern about the amount of infringement on the Internet, as in *Netcom*, but rather the number of people implicated: “to conclude that these persons are copyright infringers simply because they are involved in the ownership, operation, or maintenance of a transmission facility that automatically records material—copyrighted or not—would miss the thrust of the protections afforded by the Copyright Act.” *Id.*
 23. *Id.* at 557.
 24. *Id.* at 558.
 25. *Id.* at 559 (emphasis in original).
 26. *Id.* at 560 (emphasis in original).
 27. 338 Fed. Appx. 329 (4th Cir. 2009).
 28. *Id.* at 335.
 29. *Id.* at 336.
 30. *Id.* (internal citations and quotation marks omitted).
 31. *Id.* (citations omitted).
 32. *Id.* (citations omitted).
 33. See *Twentieth Century Fox Film Corp. v. Cablevision Systems Corp.*, 478 F. Supp. 2d 607, 609 (S.D.N.Y. 2007).
 34. 464 U.S. 417 (1984).
 35. *Id.* at 618.
 36. *Id.*
 37. *Id.*
 38. *Id.* at 619.
 39. *Id.* at 620.
 40. *Id.*
 41. *Id.*
 42. *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F.3d 121, 130 (2d Cir. 2008).
 43. *Id.*
 44. *Id.* at 131.
 45. *Id.*
 46. *Id.*
 47. *Id.* at 132.
 48. *Id.* Professor Nimmer, author of the leading treatise on copyright law, foreshadowed some of the problems with the Second Circuit’s approach, one of them being that it is more logical to find *Cablevision* the “author of infringement” when *Cablevision* invested millions of dollars to engineer a system for the express and only purpose of creating copies of plaintiff’s copyrighted works, using video-on-demand technology, and to be made by the press of a button on a *Cablevision*-supplied remote control and to be maintained on *Cablevision*’s servers. 4 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 13.08[C], at 13-290.6-7 (2013). Of concern in the context of now-pending cases, Nimmer noted that under the inquiry of whether a party’s involvement was enough to rise to the level of direct liability, “it is hard to imagine more egregious facts than those presented by this very case.” *Id.* In contrast to the RS-DVR, Sony “had no direct involvement with any Betamax purchasers who recorded copyrighted works off the air.” 464 U.S. at 427. The question there was secondary liability—liability that could be imposed on certain parties “who have not themselves engaged in the infringing activity.” *Id.* at 435, 438. Whereas Sony did not “take part in the final act,” *id.* at 436 (quotation omitted), here *Cablevision* arguably had an active or contemporaneous role in the final act leading to infringement. Likewise, it did not provide merely the “means” to infringe; *Cablevision* provided the works themselves in a form processed for recording. Cf. *Sony*, 464 U.S. at 436.
 49. 3 *Nimmer* at § 12B.06, 12B-129.
 50. 633 F. Supp. 2d 124 (S.D.N.Y. 2009).
 51. *Id.* at 148.
 52. *Disney Enterprises, Inc. v. Hotfile Corp.*, 798 F. Supp. 2d 1303 (S.D. Fla. 2011).
 53. *Id.* at 1309.
 54. 689 F.3d 29 (1st Cir. 2013).
 55. *Id.* at 56.
 56. CIV.A. 13-11649-NMG, 2013 WL 5604284 (D. Mass. Oct. 8, 2013).
 57. *Id.* at *7.
 58. *Fox Broad. Co., Inc. v. Dish Network LLC*, 723 F.3d 1067 (9th Cir. 2013).
 59. See *Warner Bros. Entm’t Inc. v. WTV Sys., Inc.*, 824 F. Supp. 2d 1003, 1011 n.7 (C.D. Cal. 2011); see also *Arista Records LLC v. Myxer Inc., f/k/a Visible Techs., Inc.*, Case No. CV 08-3935-GAF (JCx) (2011) (same). This article does not analyze whether these decisions remain good law following *Dish Network*.
 60. 934 F. Supp. 2d 640 (S.D.N.Y. 2013).
 61. *Fox Broad. Co. v. Dish Network, LLC*, 905 F. Supp. 2d 1088, 1102 (C.D. Cal. 2012).
 62. See *supra* n. 58.

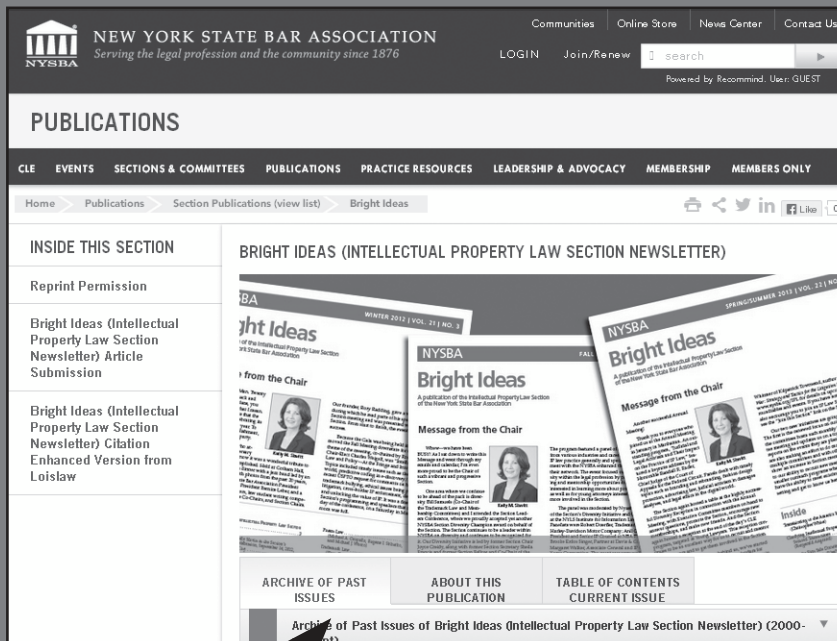
63. 934 F. Supp. 2d at 649.
64. *Id.* at 655.
65. *Id.* at 657 (quoting *Cablevision*, 536 F.3d at 133).
66. *Id.* at 655.
67. *Id.* at 657.
68. *Id.*
69. See Case No. 12-57048, Dkt. No. 98-1 (9th Cir.).
70. Perhaps it was the Copyright Office's rejection of a "digital first sale" defense in its Section 104 report that bolstered the analysis of the issue along straight-line legal principles rather than the appearance of the technology.

71. *Sony*, 464 U.S. at 457.
72. *Id.* at 499 (citations and internal quotations omitted).

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