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KERNOCHAN CENTER FOR LAW, MEDIA AND THE ARTS KERNOCHAN CENTER NEWS

COLUMBIA UNIVERSITY SCHOOL OF LAW

SPRING 2009

First Kernochan IP Fellow Joins Center

Eva Subotnik, a 2003 alumna of Columbia Law School, was selected as the first Kernochan Center Fellow in Intellectual Property and joined the Center's staff in January. Eva will spend the next eighteen months working on Center activities and pursuing her own research goals. Before coming to the Center, she was an associate at Debevoise & Plimpton LLP and clerked for The Hon. Bruce M. Selya on the First Circuit Court of Appeals and The Hon. Alvin K. Hellerstein in the Southern District of New York.

Eva hopes to explore the ways in which authors work together and contribute to creative works and the ways in which the law informs authors' decisions to collaborate. Prompted by her interest in technological advances and her conceptualization of the ties between technology and authorship, Subotnik looks forward to having the opportunity to think, teach and write about an area of the law in constant transition. She is also excited about working on Kernochan Center projects.

"I hope to contribute the perspective and research and writing skills I have

gained from corporate practice and clerking, as well as my genuine enthusiasm for thinking about intellectual property law trends and problems," she said.

Subotnik, the daughter of two academics, says she has always been interested in a career in teaching. Having encountered copyright and trademark issues through her hobbies of photography and jewelry design, Eva thought that she wanted to pursue a career in intellectual property law when she came to CLS in the Fall of 2000. She took copyright with Professor Jane Ginsburg, internet law with Professor Eben Moglen, and genetics law with Professor Harold Edgar, and focused on the relevant treaties in an international trade law course. Following graduation, both during her clerkships and at Debevoise, she sought out opportunities to work on IP matters. Highlights include research on a longstanding patent infringement dispute, trademark filings with the USPTO, and advising entertainment industry clients on transactional and litigation matters.

Eva graduated from Columbia Col-



Eva Subotnik '03

lege and was on the COLUMBIA LAW REVIEW while in Law School. Between college and law school, she was a paralegal in the Manhattan D.A.'s office, a journalist in Jerusalem and a bartender in London. She regularly plays bluegrass guitar in and around New York City and her home state of Rhode Island.

2009 Manges Lecturer Looks at the 'Making Available' Right

On February 3, 2009, David O. Carson, General Counsel of the U.S. Copyright Office, delivered the 22nd annual Horace S. Manges Lecture. Carson opened his talk, entitled "Making the Making Available Right Available," by reflecting on the growing visibility of the copyright law over the past decade, particularly in the context of peer-to-peer file sharing. In the wake of the recent announcement by the RIAA that it would wind down its campaign of lawsuits against individual users of these services, Carson admitted disappointment that file sharing is still rampant. Against this backdrop, he considered whether protection of a "making available" right – that is, of a copyright owner's exclusive right to make his or her work available to the public "in

such a way that members of the public may access the work from a place and at a time individually chosen by them" – exists under U.S. copyright law, and the purposes such a right might serve.

Carson traced the history of a making available right to international law, namely, the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty. After discussing the key provisions and relevant history, he concluded that it was clear that peer-to-peer file sharing violates the making available right protected under these treaties. Carson claimed that the U.S. negotiators of the treaties, as well as most lawyers in the Copyright and Patent and Trademark Offices, believed that U.S. law already recognized this right. Legislative sources

also reflect that Congress and President Clinton understood that existing U.S. law, as supplemented by the DMCA, would put us in compliance with our treaty obligations.

Focusing on whether the Copyright Act does in fact provide for a making available right, Carson first reasoned that the reproduction right does not cover the activity at issue. For example, where a file sharer obtains an original copy through legitimate means, such as from iTunes, the reproduction right is not implicated by virtue of the user's actions in "sharing" that file with thousands of additional users. Furthermore, even in the case of file sharing based on an illegally obtained first copy, a determination that

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Annual Symposium Analyzes Secondary Liability

The Honorable Alex Kozinski, Chief Judge of the United States Court of Appeals for the Ninth Circuit, delivered the keynote address at the Center's 2009 Symposium held on January 23rd. The day-long event focused on various aspects of secondary liability under the Copyright Act and on the related topic of filtering infringing content.

Judge Kozinski opened his remarks with a reference to John Perry Barlow's 1996 Declaration of the Independence of Cyberspace, which envisioned the internet as an independent realm untouchable by the laws of the bricks and mortar world. The problem with this conception, argued Judge Kozinski, is that online offenders rely on real-world institutions to secure real-world benefits. Secondary liability serves as a tool for holding institutions liable in certain circumstances, especially where it is difficult (or impossible) to prosecute direct offenders. Under the law, the Judge said, institutions should be held accountable when they provide the tools for violations but essentially look the other way. The costs associated with our policy of internet anonymity, he suggested, could be shifted from victims to service providers so that the latter would adopt better precautions.

Still, Judge Kozinski acknowledged that the notion that cyberspace is "different" persists—even though we never contemplated a "television space" or "radio space"—and it continues to play out in the case law, as seen in the Ninth Circuit's

Perfect 10 v. Visa and *Fair Housing Council of San Fernando Valley v. Roommates.com* cases. He postulated that some judges are susceptible to the argument that policing the internet will derail it and stifle innovation. Judge Kozinski conceded that some innovation may be stifled, but maintained that such a rationale is insufficient to exempt innovators from the rule of law. Furthermore, he reasoned that actively fostering a culture of exemption from legal compliance only serves to promote legal defiance. He concluded by underscoring that the conception of cyberspace as a discrete world to be treated differently was misguided, but questioned whether we have the will to overcome that notion.

The first panel of the day delved right into common law developments of secondary liability in copyright. Mark Bartholomew of the University at Buffalo Law School, SUNY, argued that comparing legal regimes can help us better understand secondary liability and its species, including vicarious and contributory liability. He explored the courts' disparate treatment of copyright and trademark claims in this area. Against the backdrop of common law tort origins, Boston College Law School's Fred Yen argued that courts should not analyze contributory liability issues through an intentional tort prism (or its "knowledge with substantial certainty" prong). Rather, they should think about contributory liability as a form

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Carson Looks at 'Making Available' Right

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the reproduction right has been violated may provide only cold comfort to the copyright owner if a court determines that the measure of damages for the infringement is \$.99, the cost of an iTunes copy.

Carson therefore turned to the distribution right, upon which the record companies typically have relied. He noted that in the past year, a number of district courts considered the question of whether the distribution right encompasses a making available right, and reached divergent conclusions. Carson maintained that definitions of "distribute" contemporaneous with the 1976 Act are broad enough to cover the activities entailed in making files available over a peer-to-peer network. As for Section 106(3)'s requirement of a "sale or other transfer of ownership, or...rental, lease, or lending," he argued that appellate precedent in both the peer-to-peer context, and more generally, supports the conclusion that a distribution could occur without proof of an actual sale or transfer of ownership of a copy. He also suggested that the statutory definition of "publication" might inform the contours of the distribution right on this score in an enlightening way.

In addition, Carson pointed out that Section 106 not only protects a copyright owner's exclusive rights "to do," but also "to authorize." By placing a music file in a shared music folder, a person has "authorized" a distribution of copies to occur. Fleshing out this line of argument, he critiqued the view, held by some courts, that the sole purpose of including

the word "authorize" was to codify the doctrine of contributory liability. According to Carson, this interpretation finds only scant support in the legislative history and, in any event, the view that an authorization can by itself constitute an infringement squares with the statutory text and is not, in fact, at odds with the legislative history.

Carson also drew upon Section 506(a)(1)(C), which provides for criminal liability for willful infringement "by the distribution of a work being prepared for commercial distribution, by making it available on a computer network accessible to members of the public." This language, according to Carson, is evidence that Congress views the distribution right to include a making available right. Indeed, he suggested that it was incomprehensible that Congress would have criminalized making works available for downloading if such an act did not even trigger civil liability.

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Kernochan Center Updates

Jane Ginsburg spent the Fall semester at Cambridge University where she co-taught a course on international trademarks with 2007 Manges Lecturer **Lionel Bently**. Professors Bently and Ginsburg first taught the course last Spring at Columbia and are currently working on an international trademark law textbook with Annette Kur of the Max Planck Institute in Munich. This Spring, Professor Ginsburg is in residence at The American Academy in Rome where she is studying 16th century Papal printing privilege grants and applications.

June Besek spoke on a panel entitled "Snapfu! Picturing the Law on Photographs of Preexisting Works" at a seminar hosted by the Copyright Society. Part II of her report for the Library of Congress on pre-1972 sound recordings was published in March 2009. On March 13, she was the introductory speaker at a

full-day conference hosted by the Kernochan Center on the proposed settlement of the Google books litigation. The next issue of the newsletter will describe this conference in detail.

Pippa Loengard was a member of a panel entitled "Maximizing Wealth in Turbulent Times" which was part of a series of discussions held at The 2009 Armory Show - Modern. She discussed ways art collectors can structure asset transfers to charitable organizations under recent changes to the tax law and how recent controversies in the field have affected donors. The event was sponsored by Withers Bergman LLP. Ms. Loengard was also recently named a co-chair of the New York State Bar Association's EASLS Committee on Pro Bono Representation where she will, among other things, oversee its clinical offerings.

Can You Help?

Unfortunately, due to the poor economy, many members of Columbia Law School's graduating class are finding that jobs they thought would start in September 2009 have been deferred for up to a year. Many firms are giving this incoming associate class the opportunity to work for a public-interest organization for the year, with a stipend provided by the firms. If you work for a 501(c)(3) organization or know of such an organization that would be interested in hosting a recent graduate, whether it be for a month or a year, please contact Pippa Loengard at ploeng1@law.columbia.edu or 212-854-9869. Our students appreciate your help and generosity.



Manges Lecture

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In closing, Carson emphasized that, in keeping with the copyright law's purpose of providing incentives to authors to create, the power to stop file sharers from making copyrighted works available is of the utmost importance. Given the practical difficulties in tracking actual transmissions, a making available right can help stem the tide of unauthorized disseminations, which threaten not just the recording industry but other creative industries as well. Further, he said that under the Supreme Court's *Charming Betsy* doctrine, we have an obligation to construe our laws, where fairly possible, so as not to conflict with our treaty obligations. If, in the face of all these reasons, the case law ultimately does not bear out recognition of a making available right, Carson suggested it may be time to urge Congress to adopt explicit legislation.

The text of the Manges Lecture will be published in an upcoming volume of THE COLUMBIA JOURNAL OF LAW & THE ARTS.



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Bruce Rich, Melissa Rich, William P. Farley, June M. Besek, Executive Director of the Kernochan Center, and the 2009 Manges Lecturer, David O. Carson.

The Kernochan Center for Law, Media and the Arts mourns the loss of former Register of Copyrights Barbara Ringer. Ringer served as Register from 1973-1980 and was the principal architect of the 1976 Copyright Act. She was also Acting Register from 1993-1994. Ringer delivered the 3rd Annual Manges Lecture in 1990.

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Secondary Liability Symposium

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of negligence and ask what unintended consequences might flow from precautionary measures intended to reduce infringement. Peter Menell from the UC Berkeley School of Law (Boalt Hall) called for a reexamination of the *Sony Betamax* case under an inducement theory of liability and, surveying the landscape, argued that courts have a constructive role to play in balancing claims of “chilled innovation” against claims of liability.

Tony Reese from the University of Texas at Austin School of Law launched the day’s second panel, which focused on statutory adjustments concerning secondary liability. Subjecting Section 512 to close textual and historical analysis, Reese argued on the one hand that, contrary to conventional thinking, this provision does not simply preserve the status quo under the common law, but actually protects service providers against secondary liability that would have existed under common law principles. With respect to direct liability, on the other hand, Reese maintained that it was unclear whether statutory safe harbors afford any additional protections. Miquel Peguera from the Universitat Oberta de Catalunya (UOC) provided an overview of the European Union counterpart to the DMCA’s safe harbor provisions, as set forth in the EU Electronic Commerce Directive of June 2000. He explained that the Directive applies to different kinds of liability, not just copyright, and among other things, does not provide for notice-and-take-down at the EU level. Rounding out the discussion, Fordham Law’s Sonia Katyal identified Section 512, Section 230 of the Communications Decency Act, and trademark law as statutory sources supporting “piracy surveil-

lance,” that is, private, extrajudicial methods of copyright enforcement. She questioned whether a more harmonized scheme was in order and, more specifically, called for balanced oversight of service providers faced with take-down notices.

The final panel of the day addressed issues relating to filtering infringing content. Terri Southwick of The Walt Disney Company discussed the development of user-generated content principles, which can serve as a case study in compromise among different interest groups to create industry standards that may provide an alternative to legislation or litigation. Sean Varah, of MotionDSP, spoke next about filtering techniques and how user adaptations of content can make copyright infringement detection more difficult. He argued that conflicting business priorities affect the state of the art in filtering technology. Taking up these points, Harvard Law School’s John Palfrey framed the topic in terms of overbreadth and underbreadth concerns, which he described as the big choice when it comes to filtering policies. He also explored the question of whether the existence of better filtering techniques necessarily creates an affirmative obligation to employ those techniques, a notion he rejected.

The Symposium was well attended and well received, with lively question and answer sessions following each panel. The papers will be published in an upcoming volume of THE COLUMBIA JOURNAL OF LAW & THE ARTS.

