

VOLITION AND COPYRIGHT INFRINGEMENT

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INTRODUCTION

In 2014, the United States Supreme Court released its opinion in *American Broadcasting Companies v. Aereo*, which involved a dispute between the owners of copyrights in broadcast television programs and a company that streamed those programs over the Internet to paying subscribers.¹ The defendant delivered the programming through an elaborate mechanism triggered by a subscriber's website request to view

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¹ See generally *Am. Broad. Cos. v. Aereo, Inc.*, 134 S. Ct. 2498 (2014).

a particular show.² Using a tiny antenna assigned to that subscriber, the defendant captured the over-the-air broadcast, recorded it in a folder on its hard drive designated for that subscriber, and then streamed that specific recording to the subscriber who had requested it.³ The plaintiffs contended that the unauthorized streaming violated their exclusive “right to ‘perform’ their works ‘publicly’”;⁴ the defendant countered that its deliveries of individual copies to specific customers were not transmissions “to the public.”⁵ A six-justice majority held in favor of the plaintiffs, citing the defendant’s “overwhelming likeness” to cable television companies, which clearly “perform” within the meaning of the Copyright Act.⁶ The majority’s “guilt-by-resemblance” argument left Justice Scalia unmoved.⁷ Writing on behalf of three dissenters, he explained why the defendant could not be held directly liable for copyright infringement⁸: “The Networks’ claim is governed by a simple but profoundly important rule: A defendant may be held directly liable only if it has engaged in volitional conduct that violates the Act.”⁹ He cited opinions requiring volitional conduct from three circuit courts of appeals,¹⁰ added a footnote citing to an unpublished opinion from a fourth,¹¹ and concluded that Aereo was not liable for direct infringement because its system “does not relay any program, copyrighted or not, until a subscriber selects the program and tells Aereo to relay it.”¹²

Justice Scalia’s “profoundly important rule,” however, is hardly an accepted bedrock of copyright law. As Scalia himself admitted, the Supreme Court had never previously used the word “volition” in the context of copyright infringement.¹³ Several federal court decisions have expressed uncertainty about the existence of a volition requirement,¹⁴

² *Id.* at 2503.

³ *Id.*

⁴ *Id.* at 2503–04 (citing Copyright Act of 1976, 17 U.S.C. § 106(4) (2012)).

⁵ *Id.* at 2507–08 (citing 17 U.S.C. § 101 for the definition of “publicly”).

⁶ *Id.* at 2507; *see also* 17 U.S.C. § 101 (defining “perform”).

⁷ *Id.* at 2517 (Scalia, J., dissenting).

⁸ Justice Scalia pointedly noted that Aereo’s potential liability under the rules governing secondary liability for the infringing conduct of others was not before the Court. *Id.* at 2514–15.

⁹ *Id.* at 2512 (citing 3 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 9:5.50 (perm. ed., rev. vol. 2013)).

¹⁰ *Id.* at 2512 (citing *Fox Broad. Co., Inc. v. Dish Network L.L.C.*, 747 F.3d 1060 (9th Cir. 2014); *Cartoon Network LP v. CSC Holdings, Inc.*, 536 F.3d 121 (2d Cir. 2008); *CoStar Grp. v. LoopNet, Inc.*, 373 F.3d 544 (4th Cir. 2004)).

¹¹ *Id.* at 2512 n.1 (citing *Parker v. Google, Inc.*, 242 F. App’x 833 (3d Cir. 2007) (per curiam)).

¹² *Id.* at 2514.

¹³ *Id.* at 2513.

¹⁴ *See, e.g.*, *Soc’y of the Holy Transfiguration Monastery, Inc. v. Gregory*, 689 F.3d 29, 55 (1st Cir. 2012) (declining to determine whether a “volitional act” is necessary to establish direct liability for copyright infringement). A few federal district court decisions in California have

and eight circuit courts of appeals have never even mentioned it.¹⁵ The leading treatise on copyright law calls the introduction of a volition element “revolutionary.”¹⁶ It is a startling debate, coming as it does more than two centuries after Congress first imposed liability for copyright infringement.¹⁷ It appears particularly bizarre given the natural inclination to conclude that volition is, of course, required for copyright infringement, as indeed it is for any tort that consists of an affirmative act.¹⁸ The *Restatement (Second) of Torts*, for instance, is adamant that “[t]here cannot be an act without volition.”¹⁹ While vicarious liability for copyright infringement can be premised on omissions,²⁰ direct liability under section 501(a) of the Copyright Act²¹ requires an act that violates one of the exclusive rights granted to copyright owners under section 106.²² Volition as normally understood thus seems an implicit—if typically uncontested—aspect of direct liability. “Volition” as used in copyright law, however, means something else entirely.

The debate over volition in copyright law goes back only twenty years to a 1995 district court decision that considered the potential liability of an Internet access provider for its reproduction, distribution, and display of copyrighted material posted online by a member of the public.²³ Recognizing that a rule imposing direct liability on the access provider for copyright infringement would also implicate every other participant in the global network transmitting the original posting, and

declined to adopt a volition requirement in the absence of clear instructions from the Ninth Circuit. *See Warner Bros. Entm’t v. WTV Sys., Inc.*, 824 F. Supp. 2d 1003, 1011 n.7 (C.D. Cal. 2011); *Arista Records LLC v. Myxer Inc.*, No. CV 08–03935 GAF (JCx), 2011 WL 11660773, at *14 (C.D. Cal. Apr. 1, 2011). Justice Scalia in *Aereo* cited the Ninth Circuit’s subsequent decision in *Fox Broadcasting Co.* as recognizing a volition requirement, although the Ninth Circuit did not use the word “volition” in its opinion. *Aereo*, 134 S. Ct. at 2512 (Scalia, J., dissenting).

¹⁵ An “advanced” search for “volition! and copyright” in Westlaw’s “United States Courts of Appeals” database indicates that there are no decisions in the Fifth, Sixth, Seventh, Eighth, Tenth, Eleventh, District of Columbia, or Federal Circuit Courts of Appeals that discuss volition as a requirement of liability for copyright infringement.

¹⁶ 4 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 13.08[C] (2014); *id.* at 12B.06[B][2][c][i] (“[V]olition’ should not be viewed as a free-standing feature of copyright law.”); *see also* Rebecca Giblin & Jane C. Ginsburg, *We (Still) Need to Talk About Aereo: New Controversies and Unresolved Questions After the Supreme Court’s Decision*, 38 COLUM. J.L. & ARTS 109, 143 (2015) (“Whether or to what extent ‘volition’ is in fact a predicate to a finding of infringement therefore invites debate.”).

¹⁷ *See* Act of May 31, 1790, 1 STAT. 124.

¹⁸ *See* RESTATEMENT (SECOND) OF TORTS § 2 cmt. a (AM. LAW INST. 1965).

¹⁹ *Id.*

²⁰ *See infra* notes 170–71 and accompanying text.

²¹ 17 U.S.C. § 501(a) (2012).

²² *Id.* § 106.

²³ *See generally* *Religious Tech. Ctr. v. Netcom On-Line Commc’n Servs., Inc.*, 907 F. Supp. 1361 (N.D. Cal. 1995).

every potential viewer, the court in *Religious Technology Center v. Netcom On-Line Communication Services* held that the provider lacked the “volition” necessary for liability: “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.”²⁴ “Volition,” however, is an unfortunate label for the court’s concern, which seems directed not at a characteristic of the defendant’s conduct, but instead at whether the defendant has in fact engaged in conduct that is sufficient to meet each of the required elements of liability for copyright infringement.²⁵ The court’s alternative formulation—“causation”—also diverges from its customary meaning, here inquiring into whether the defendant’s conduct has caused the tort,²⁶ rather than its customary focus on whether the tort has caused the harm for which relief is sought.²⁷

The Part I of this Article explains why traditional interpretations of “volition” and “causation” are not useful in understanding the “volition” requirement in copyright law. Part II offers an explanation of “volition” that is more consistent with its function in channeling the analysis of copyright infringement into the distinct categories of direct, vicarious, and contributory liability. Finally, Part III applies that analysis to four situations where the volition requirement has provoked considerable debate.

I. VOLITION AND CAUSATION IN TORT LAW

A. *It Isn’t Actually an Issue of “Volition”*

Volition in its traditional sense is a basic prerequisite of direct liability in tort—at least when the tort consists of an act and not a mere failure to act.²⁸ In a comment entitled “*Necessity of volition*,” the *Restatement (Second) of Torts* takes the position that, without volition, there is no “act”²⁹ for which an “actor”³⁰ can be liable. *Black’s Law Dictionary* defines “volition” as “[t]he ability to make a choice or

²⁴ *Id.* at 1370.

²⁵ *See id.* at 1368–70.

²⁶ *See id.* at 1368–69.

²⁷ *See* RESTATEMENT (SECOND) OF TORTS § 9 (AM. LAW INST. 1965) (defining “legal cause”).

²⁸ *See id.* § 2 cmt. a (“There cannot be an act without volition.”).

²⁹ *Id.*

³⁰ *Id.* § 3 (defining an “actor” as a person “whose conduct is in question as subjecting him to liability”).

determine something.”³¹ The *Oxford English Dictionary* similarly defines the term as “[a]n act of willing or resolving.”³² The *Restatement* comment invokes the volition requirement to exclude liability for conduct such as involuntary muscle contractions, movements during sleep,³³ or conduct resulting from a third party’s use of a person’s body as an instrument to carry out the third party’s own intentions.³⁴ Volition in this traditional sense is not inconsistent with the accepted rule of strict liability for copyright infringement.³⁵ In his treatise on copyright law, Professor Goldstein offers the example of a bookstore that innocently sells a book containing infringing material. Although the store lacks any intent to infringe, selling the book is clearly a volitional act and it will be liable for violating the copyright owner’s distribution right.³⁶ Similarly, volition in its traditional sense is not inconsistent with the cases imposing liability for “subconscious” copying, most frequently on composers of musical works.³⁷ Perhaps a court may one day face a defendant who clicked on a download link as a result of a muscle seizure or whose hand was forced down on the copy button of a photocopier by a third party, but until then, true volition should not be an issue in a copyright infringement case. The requirement of volition as developed since 1995 in a series of Internet-related copyright cases is a distinct concept created for a different purpose.

The defendants in *Religious Technology Center v. Netcom On-Line Communication Services* were the operator of a computer bulletin board service and the service provider that the bulletin board used to access

³¹ *Volition*, BLACK’S LAW DICTIONARY (10th ed. 2014).

³² *Volition*, OXFORD ENGLISH DICTIONARY (2d ed. 1989).

³³ See, e.g., *Ballew v. Aiello*, 422 S.W.2d 396 (Mo. Ct. App. 1967) (dozing passenger who grabbed the steering wheel was not liable to plaintiff in oncoming vehicle since the passenger had not acted with volition).

³⁴ RESTATEMENT (SECOND) OF TORTS § 2 cmt. a (AM. LAW INST. 1965).

³⁵ See, e.g., *Buck v. Jewell-La Salle Realty Co.*, 283 U.S. 191, 198 (1931) (“Intention to infringe is not essential under the act.”); *Fred Fisher, Inc. v. Dillingham*, 298 F. 145 (S.D.N.Y. 1924) (L. Hand, J.); see also, e.g., H.R. REP. NO. 102-997, at 5 (1992) (“Under civil copyright infringement, an intent to infringe is not required, since copyright is a strict liability tort.”). The rule was the same for infringement of common law copyright. See, e.g., *De Acosta v. Brown*, 146 F.2d 408 (2d Cir. 1944). The common law rule is now displaced for most works by section 301 of the Copyright Act of 1976, 17 U.S.C. § 301 (2012).

³⁶ PAUL GOLDSTEIN, 1 GOLDSTEIN ON COPYRIGHT § 7.0.1 (3d ed. Supp. 2013) (“Strict liability is the rule in copyright cases . . .”).

³⁷ See, e.g., *Three Boys Music Corp. v. Bolton*, 212 F.3d 477 (9th Cir. 2000); *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988 (2d Cir. 1983); *Fred Fisher*, 298 F. 145; cf. *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir. 1936) (literary work). The latter two opinions, both written by Learned Hand, speak of “unconscious” copying, but surely must be understood as instances of “subconscious” copying. “Unconscious” copying, if such a thing were possible, would indeed raise questions of volition.

the Internet.³⁸ The plaintiffs owned copyrights in works by L. Ron Hubbard, the founder of the Church of Scientology.³⁹ A former church minister had used the bulletin board to post the works to an online USENET newsgroup.⁴⁰ Disagreeing with two earlier decisions that had imposed direct liability on bulletin board operators in connection with infringing postings by users,⁴¹ Judge Whyte refused to hold the defendants directly liable for infringement of the reproduction right despite the temporary copies of the plaintiffs' works that each had made as part of the Internet transmission process.⁴² He reached the same conclusion with respect to direct liability for the public distribution and display of the works.⁴³ According to the court, it was the subscribing customer who had caused the infringements by engaging the defendants' automated systems.⁴⁴ The bulletin board operator and Internet access provider lacked the "volition" necessary for direct liability.⁴⁵ It was the first reference to "volition" in copyright law.⁴⁶ Subsequent cases have cited an absence of volition to defeat claims of direct infringement against website owners,⁴⁷ search engines,⁴⁸ telecommunications companies,⁴⁹ and providers offering website hosting,⁵⁰ cloud storage,⁵¹ and home⁵² and remote⁵³ digital video recording services. However, the absence of volition did not provide the two defendants in *Netcom* with immunity from contributory or vicarious liability, since those doctrines govern liability for

³⁸ Religious Tech. Ctr. v. Netcom On-Line Commc'n Servs., Inc., 907 F. Supp. 1361, 1366 (N.D. Cal. 1995).

³⁹ *Id.* at 1365.

⁴⁰ *Id.* at 1365–66.

⁴¹ Sega Enters. Ltd. v. MAPHIA, 857 F. Supp. 679 (N.D. Cal. 1994); Playboy Enters., Inc. v. Frena, 839 F. Supp. 1552 (M.D. Fla. 1993).

⁴² *Netcom*, 907 F. Supp. at 1372–73.

⁴³ *Id.* at 1372.

⁴⁴ *Id.* ("Only the subscriber should be liable for causing the distribution of plaintiffs' work, as the contributing actions of the BBS provider are automatic and indiscriminate.>").

⁴⁵ *Id.* at 1381–82 ("There are no allegations in the complaint to overcome the missing volitional or causal elements necessary to hold a BBS operator directly liable for copying that is automatic and caused by a subscriber.>").

⁴⁶ See NIMMER & NIMMER, *supra* note 16, § 13.08[C][1] ("[Volitional conduct] first arose in *Netcom*, a 1995 case from the Northern District of California addressing the then-novel matter of user storage of material available to others. . . . That single reference to 'volition' has caused tremendous ferment." (footnote omitted)).

⁴⁷ See, e.g., CoStar Grp. v. LoopNet, Inc., 373 F.3d 544 (4th Cir. 2004).

⁴⁸ Parker v. Google, Inc., 242 F. App'x 833 (3d Cir. 2007) (per curiam).

⁴⁹ *In re Cellco P'ship*, 663 F. Supp. 2d 363 (S.D.N.Y. 2009).

⁵⁰ See, e.g., Rosen v. Hosting Servs., Inc., 771 F. Supp. 2d 1219 (C.D. Cal. 2010).

⁵¹ Disney Enters., Inc. v. Hotfile Corp., 798 F. Supp. 2d 1303 (S.D. Fla. 2011).

⁵² See, e.g., *In re AutoHop Litig.*, No. 12 Civ. 4155(LTS)(KNF), 2013 WL 5477495 (S.D.N.Y. Oct. 1, 2013).

⁵³ Cartoon Network LP v. CSC Holdings, Inc., 536 F.3d 121 (2d Cir. 2008).

infringements committed by third parties.⁵⁴ Judge Whyte denied their motions for summary judgment on a count of contributory liability, which requires proof that a defendant, “with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another.”⁵⁵ The failure to prevent distribution of the works could constitute substantial participation in the infringement, and there were unresolved issues of fact concerning the defendants’ knowledge of the infringing activities.⁵⁶ Both defendants did win summary judgments on a claim of vicarious liability, which requires proof of “the right and ability to control the infringer’s acts and . . . a direct financial benefit from the infringement.”⁵⁷ Although there were factual issues concerning the ability of the defendants to control the infringing activities, there was no evidence that either defendant derived a direct financial benefit from the user’s infringement.⁵⁸

Volition in its traditional sense presented no obstacle to the imposition of direct liability for copyright infringement in *Netcom*. The defendants made conscious and voluntary choices to deploy the systems that ultimately made infringing reproductions of the plaintiffs’ works.⁵⁹ That the copying or other infringement of the owners’ rights was done by an automated system does not negate volition. Courts have no hesitation saying that a consumer who programs a DVR to automatically record a television show at nine o’clock on a Tuesday evening makes a reproduction of the work, although of course this type of copying is a fair use.⁶⁰ Similarly, several decisions involving copying by web crawlers deployed by Internet search engines have treated the resulting automated copying and display as *prima facie* infringing, although it is likely also a fair use.⁶¹ The argument that the activities of

⁵⁴ See *Religious Tech. Ctr. v. Netcom On-line Commc’n Servs., Inc.*, 907 F. Supp. 1361, 1373 (N.D. Cal. 1995).

⁵⁵ *Id.* at 1373 (quoting *Gershwin Publ’g Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971)). On contributory liability for inducing infringement, see *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005).

⁵⁶ *Netcom*, 907 F. Supp. at 1375.

⁵⁷ *Id.* (citing *Shapiro, Bernstein & Co. v. H. L. Green Co.*, 316 F.2d 304, 306 (2d Cir. 1963)).

⁵⁸ See *id.* at 1376–77.

⁵⁹ See *id.* at 1365–66.

⁶⁰ See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984) (holding that home copying of television programs for the purpose of later viewing is a fair use).

⁶¹ See, e.g., *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007) (finding direct liability for the display and distribution of thumbnail images created by Google’s web crawlers, but holding that it was likely a fair use); *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003) (finding direct liability for reproduction of copyrighted images by a search engine’s web crawlers, but holding that it was a fair use); Nicole Bashor, Note, *The Cache Cow: Can Caching and Copyright Co-Exist?*, 6 J. MARSHALL REV. INTELL. PROP. L. 101, 119 (2006) (“[A]ssume that a search engine programmed a robot to search the Internet and make copies of copyrighted songs or programmed its robots to download music illegally. Surely liability has

automated systems are not the volitional acts of their owners may seem superficially stronger when the systems are triggered by an interaction with a third party. In *Netcom*, the defendants' electronic bulletin board and the servers that enabled Internet transmission would not have reproduced or distributed the plaintiffs' works unless a customer had first uploaded the copyrighted material.⁶² Does third-party intervention negate volition? Defendants who create and deploy an interactive system cannot claim an absence of volition as traditionally understood. In contract law, for example, liability requires a manifestation of assent to a bargain,⁶³ and a manifestation of assent in turn requires "a conscious will to engage in that conduct."⁶⁴ Yet the law has no difficulty in imposing contractual liability on a party whose assent is manifested by the actions of an electronic system interacting with another person who desires to contract.⁶⁵ According to the Uniform Electronic Transactions Act,⁶⁶ "[a] contract may be formed by the interaction of electronic agents of the parties, even if no individual was aware of or reviewed the electronic agents' actions or the resulting terms and agreements."⁶⁷ The theory is straightforward:

An electronic agent, such as a computer program or other automated means employed by a person, is a tool of that person. As a general rule, the employer of a tool is responsible for the results obtained by the use of that tool since the tool has no independent volition of its own.⁶⁸

The same principles apply to copyright. In *New York Times v. Tasini*, the Supreme Court faced a copyright infringement claim brought against the NEXIS electronic news service by freelance writers whose news stories had been transferred to the service by the newspapers that had originally published the stories.⁶⁹ Subscribers to NEXIS could search the electronic database for desired articles and then view, print, or download the results.⁷⁰ Finding that the use exceeded the scope of the newspapers' rights in the works, the Court held that NEXIS had directly violated the writers' exclusive right to distribute copies to the public

not vanished simply because the search engine programmed a robot to do the dirty work for it, even though the robots illegal music downloading was automatic.").

⁶² See *Netcom*, 907 F. Supp. at 1365–66.

⁶³ RESTATEMENT (SECOND) OF CONTRACTS § 17 (AM. LAW INST. 1981).

⁶⁴ *Id.* § 19 cmt. c.

⁶⁵ See UNIF. ELEC. TRANSACTIONS ACT § 14 (UNIF. LAW COMM'N 1999).

⁶⁶ The Act has been enacted by forty-seven states. *Legislative Enactment Status—Electronic Transmissions Act*, UNIFORM L. COMM'N, <http://www.uniformlaws.org/LegislativeMap.aspx?title=Electronic%20Transactions%20Act> (last visited Mar. 1, 2016).

⁶⁷ UNIF. ELEC. TRANSACTIONS ACT § 14(1) (UNIF. LAW COMM'N 1999).

⁶⁸ *Id.* § 2 cmt. 5.

⁶⁹ *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 489 (2001).

⁷⁰ *Id.* at 490.

when it allowed subscribers to use the system to access the plaintiffs' works.⁷¹ Other examples of direct liability for copyright infringement triggered by the interaction of third parties with an electronic system deployed by the defendant are easy to find.⁷² The Copyright Act itself expressly envisions direct liability arising from an interaction between third persons and an electronic system. The owners of copyrights in sound recordings have the exclusive right to perform the works publicly by means of a digital audio transmission.⁷³ Although some forms of digital audio transmissions are eligible for a compulsory statutory license,⁷⁴ a transmission that is "part of an interactive service"⁷⁵ must be expressly licensed by the copyright owner.⁷⁶ Thus, a website offering an interactive service that permits subscribers to select specific sound recordings for transmission must obtain a license in order to avoid liability for the digital performances triggered by the subscribers' interaction with its system.⁷⁷ The conclusions of an administrative task force formed by President Clinton at the dawn of the Internet age provide a further illustration. Charged with examining the implications of the Internet for intellectual property rights, the task force recommended that Internet service providers should be directly liable for copyright infringement committed by their users.⁷⁸ Thus, neither the courts, nor Congress, nor the executive branch apparently believe that a requirement of volition—as traditionally understood—imposes an obstacle to the imposition of direct liability on service providers for infringements resulting from interactions between customers and the

⁷¹ *Id.* at 498 ("LEXIS/NEXIS, by selling copies of the Articles through the NEXIS Database, 'distribute copies' of the Articles 'to the public by sale' . . ." (quoting 17 U.S.C. § 106(3) (2012))).

⁷² *See, e.g.,* Perfect 10, Inc. v. Amazon.com, Inc., 508 F.3d 1146 (9th Cir. 2007) (finding that Internet search engine's display of thumbnail images to users who retrieved the images through an appropriate search was prima facie infringement, but ultimately holding it to be a fair use); Warner Bros. Entm't v. WTV Sys., Inc., 824 F. Supp. 2d 1003 (C.D. Cal. 2011) (holding that the defendant who used DVD players to stream motion pictures selected by its website customers was directly liable for infringement of the copyright owners' public performance right); On Command Video Corp. v. Columbia Pictures Indus., 777 F. Supp. 787 (N.D. Cal. 1991) (holding that a hotel system that used centralized video cassette players to deliver motion pictures to guests' rooms in response to a remote request made through the guests' television systems directly infringed the studios' public performance rights).

⁷³ 17 U.S.C. § 106(6).

⁷⁴ *Id.* § 114(d)(2).

⁷⁵ *Id.* § 114(d)(2)(A)(i).

⁷⁶ *See id.* § 114(d)(3)(A).

⁷⁷ *See* Arista Records, LLC v. Launch Media, Inc., 578 F.3d 148, 161 (2d Cir. 2009) ("[A] webcasting service such as LAUNCHcast is interactive under the statute if a user can either (1) request—and have played—a particular sound recording, or (2) receive a transmission of a program 'specially created' for the user." (citing 42 U.S.C. § 114(j)(7) (2012))).

⁷⁸ WORKING GRP. ON INTELLECTUAL PROP. RIGHTS, INTELLECTUAL PROPERTY AND THE NATIONAL INFORMATION INFRASTRUCTURE 117, 122–23 (1995) [hereinafter WORKING GRP. ON INTELLECTUAL PROP. RIGHTS REPORT]; *see also infra* text accompanying notes 136–38.

electronic systems deployed by the providers. Volition as a limitation on the direct liability of service providers must be understood in a different sense—not as an examination into the voluntariness of the defendant’s actions, but instead as an inquiry into whether the defendant has actually engaged in all of the acts necessary to satisfy the elements of the cause of action for copyright infringement.⁷⁹

B. *It Isn’t Actually an Issue of “Causation” Either*

The court in *Netcom* offered an alternative to “volition” to explain its refusal to hold the service providers directly liable for copyright infringement: “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.”⁸⁰ It reiterated that view when it concluded that “[o]nly the subscriber should be liable for causing the distribution of plaintiffs’ work, as the contributing actions of the [bulletin board service] provider are automatic and indiscriminate.”⁸¹ The court was clearly not using “causation” in its “but-for” sense—“[t]he cause without which the event could not have occurred.”⁸² Without the participation of the service providers, none of the infringements would have happened. Thus, the actions of the defendants in *Netcom* were indeed a “but for” cause of the infringement. “But for” causation, however, is not sufficient for liability, or else the electric utility, Intel Corporation, and Jack Kilby, inventor of the integrated circuit,⁸³ would all have been potential defendants.⁸⁴ Instead, liability requires that a defendant’s conduct be the “legal cause” or “proximate cause” of the violation.⁸⁵

⁷⁹ See discussion *infra* Section II.A.

⁸⁰ *Religious Tech. Ctr. v. Netcom On-Line Comm’n Servs., Inc.*, 907 F. Supp. 1361, 1370 (N.D. Cal. 1995) (emphasis added).

⁸¹ *Id.* at 1372.

⁸² *But-for Cause*, BLACK’S LAW DICTIONARY (10th ed. 2014).

⁸³ *About Jack*, TEX. INSTRUMENTS, <http://www.ti.com/corp/docs/kilbyctr/kilby.shtml> (last visited Feb. 28, 2016).

⁸⁴ See RESTATEMENT (SECOND) OF TORTS § 431 cmt. a (AM. LAW INST. 1965) (explaining that cause in the “philosophic sense” is “necessary, but it is not of itself sufficient”); see also, e.g., *Am. Broad. Cos. v. Aereo, Inc.*, 134 S. Ct. 2498, 2514 (2014) (Scalia, J., dissenting) (“Aereo’s operation of [its television program streaming] system is a volitional act and a but-for cause of the resulting performances, but . . . that degree of involvement is not enough for direct liability.”).

⁸⁵ RESTATEMENT (SECOND) OF TORTS § 9 cmt. a (AM. LAW INST. 1965) (“To become liable to another under the principles of the law of Torts, an actor’s conduct must not only be tortious in character but it must also be a legal cause of the invasion of another’s interest.”). The *Restatement’s* index entry for “Proximate Cause” states, “See Legal Cause.” *Id.* at 544.

Legal or proximate cause focuses on the causal sequence that links the defendant's conduct to harm that impacts a protected interest of the plaintiff.⁸⁶ The Supreme Court recently had occasion to comment on the concept of "proximate cause" in *Lexmark International v. Static Control Components*, when it held that the cause of action for false advertising under section 43(a) of the Lanham Act⁸⁷ was not limited to plaintiffs who were direct competitors of the defendant.⁸⁸ The Court began with a general presumption that statutory causes of action extend only to plaintiffs whose injuries are "proximately caused" by a violation of the statute.⁸⁹ In describing the nature of the necessary connection, the Court said that "the proximate-cause requirement generally bars suits for alleged harm that is 'too remote' from the defendant's unlawful conduct."⁹⁰ Although a competitor injured by false advertising can sue for its losses, the same is not true of the competitor's landlord or electric company.⁹¹ The proximate cause requirement thus examines the link between the "unlawful conduct" and the plaintiff's harm, a point reiterated several times during the Court's discussion.⁹² The *Restatement (Second) of Torts'* analysis of "legal cause" similarly focuses on the connection between the actor's "tortious conduct" and the harm to another.⁹³ As with "volition," however, "causation" as used in the copyright service provider cases means something else entirely.⁹⁴

Unlike "legal" or "proximate" cause, "causation" is not invoked in *Netcom* to evaluate the connection between the tort and the plaintiff's harm, but instead to analyze the connection between the defendant's actions and the commission of the tort.⁹⁵ Judge Whyte was concerned with whether the defendants "caused" the infringement, not whether the infringement "caused" the plaintiff's injury.⁹⁶ With respect to infringement by public distribution and display, the court concluded

⁸⁶ *Id.* § 9 (defining "legal cause" as denoting that "the causal sequence by which the actor's tortious conduct has resulted in an invasion of some legally protected interest of another is such that the law holds the actor responsible for such harm unless there is some defense to liability").

⁸⁷ Lanham Act, ch. 540, § 43(a), 60 Stat. 427, 441 (1946) (codified as amended at 15 U.S.C. § 1125(a) (2012)).

⁸⁸ *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377 (2014).

⁸⁹ *See id.* at 1390.

⁹⁰ *Id.*

⁹¹ *Id.* at 1391.

⁹² *Id.* at 1390 ("[The requirement of proximate cause] reflects the reality that 'the judicial remedy cannot encompass every conceivable harm that can be traced to alleged wrongdoing.' . . . The question it presents is whether the harm alleged has a sufficiently close connection to the conduct the statute prohibits." (quoting *Associated Gen. Contractors of Cal., Inc. v. Cal. State Council of Carpenters*, 459 U.S. 519, 536 (1983))).

⁹³ *See* RESTATEMENT (SECOND) OF TORTS § 9 (AM. LAW. INST. 1965).

⁹⁴ *See* cases cited *infra* note 100.

⁹⁵ *Religious Tech. Ctr. v. Netcom On-Line Commc'n Servs., Inc.*, 907 F. Supp. 1361, 1372 (N.D. Cal. 1995).

⁹⁶ *Id.*

that “[o]nly the subscriber should be liable for causing the distribution,” and the bulletin board operator “should not be seen as causing these works to be publicly distributed or displayed.”⁹⁷ Subsequent decisions have understood *Netcom*’s use of “causation” in precisely this way. For example, responding to a claim of direct infringement against a web-hosting service whose subscribers had posted photographs owned by the plaintiff, the Fourth Circuit expressly adopted *Netcom*’s “volition or causation” requirement and held that the Copyright Act “requires *conduct* by a person who causes in some meaningful way an infringement.”⁹⁸ In a case challenging a cable company’s remote DVR system, the Second Circuit stated that “*Netcom* and its progeny direct our attention to the volitional conduct that causes the copy to be made.”⁹⁹ Other decisions confirm that “causation” in *Netcom* refers to the connection between the defendant’s conduct and the infringement rather than the traditional requirement that the infringement must be the proximate or legal cause of the plaintiff’s injury.¹⁰⁰ Like “volition,” the analysis of “causation” in the service provider cases is actually an interpretation and application of the elements of direct liability for copyright infringement.

II. VOLITION IN COPYRIGHT LAW

A. *Volition and the Defendant’s Relationship to the Infringed Work*

Analysis of volition in copyright cases frequently begins with an analogy to the owner of a copy shop who makes a photocopier available to customers for a fee. In his *Aereo* dissent, Justice Scalia asked whether the defendant’s television streaming service was more like a copy shop’s photocopier or a video-on-demand service.¹⁰¹ The requirement of volition, he assumed, would shield the copy shop owner from direct liability for any infringing reproductions made by customers using the

⁹⁷ *Id.*

⁹⁸ *CoStar Grp. v. LoopNet, Inc.*, 373 F.3d 544, 549 (4th Cir. 2004).

⁹⁹ *Cartoon Network LP v. CSC Holdings, Inc.*, 536 F.3d 121, 131 (2d Cir. 2008).

¹⁰⁰ *See, e.g., Perfect 10, Inc. v. Giganews, Inc.*, No. CV11-07098 AHM (SHx), 2013 WL 2109963, at *6 (C.D. Cal. Mar. 8, 2013) (“Just who caused the copyrighted material to be infringed?”); *Wolk v. Kodak Imaging Network, Inc.*, 840 F. Supp. 2d 724, 742 (S.D.N.Y. 2012) (“Direct liability requires ‘volitional conduct’ that ‘causes’ the infringement.”), *aff’d*, 569 F. App’x 51 (2d Cir. 2014); *In re Cellco P’ship*, 663 F. Supp. 2d 363, 370 (S.D.N.Y. 2009) (“[T]o impose direct liability, there must be a ‘nexus sufficiently close and causal to the illegal [infringement] that one could conclude that the [defendant] himself trespassed on the exclusive domain of the copyright owner.” (alterations in original) (quoting *Cartoon Network*, 536 F.3d at 130)).

¹⁰¹ *Am. Broad. Cos. v. Aereo, Inc.*, 134 S. Ct. 2498, 2513 (2014) (Scalia, J., dissenting).

photocopier.¹⁰² Two circuit courts of appeals had previously employed the same analogy. In *CoStar Group v. LoopNet*, the Fourth Circuit held that a provider of web-hosting services was not directly liable for the posting of infringing photographs by its subscribers, noting that because of the volition requirement, “counsel for both parties agreed at oral argument that a copy machine owner who makes the machine available to the public to use for copying is not, without more, strictly liable under § 106 for illegal copying by a customer.”¹⁰³ In *Cartoon Network v. CSC Holdings*, the Second Circuit justified its holding that the provider of a remote DVR service was not liable for copies made by its customers with the argument that “by selling access to a system that automatically produces copies on command, [defendant] more closely resembles a store proprietor who charges customers to use a photocopier on his premises.”¹⁰⁴ Asked to explain why the copy shop proprietor should escape direct liability, neither a layperson nor an attorney would likely attribute the outcome to a lack of “volition.” The more intuitive response is that the owner didn’t do it, with the “it” presumably referring to the infringement. On the other hand, if the shop owner had herself brought the copyrighted work to the machine and made a copy, the question of liability would seem straightforward. Why are the two situations so obviously different? It may be tempting to say that in the former, it was the customer who initiated the copying by pressing the machine’s copy button, while in the latter it was the shop owner. That simple answer, however, is not in accord with our intuitions in other cases. If an owner operates a website that offers unauthorized downloads of popular music, we would have little hesitation in holding the owner directly liable for the reproduction and distribution that occurs when a user clicks on the download button.¹⁰⁵ The fact that the

¹⁰² *Id.* Reflecting the complexity of the issues in *Aereo*, Justice Scalia ultimately concluded that the defendant’s service “is akin to a copy shop that provides its patrons with a library card.” *Id.* at 2514; *see also infra* text accompanying notes 236–37.

¹⁰³ *CoStar Grp.*, 373 F.3d at 550.

¹⁰⁴ *Cartoon Network LP*, 536 F.3d at 132; *see also, e.g.*, *Gardner v. CafePress Inc.*, No. 3:13-cv-1108-GPC-JLB, 2014 WL 6890934, at *5 (S.D. Cal. Dec. 4, 2014) (“Thus the issue in this case is whether [defendant] is more similar to a copy shop that ‘makes photocopiers available to the public on its premises’ or to a copy shop where customers request a copy from the copy shop’s human employees ‘who then volitionally operate[] the copying system to make the copy.’” (second alteration in original) (quoting *Cartoon Network*, 536 F.3d at 131–32)); *BWP Media USA Inc. v. Hollywood Fan Sites, LLC*, 69 F. Supp. 3d 342, 354 (S.D.N.Y. 2014) (“The ownership of websites used by third parties to commit copyright infringement places the Defendants in a position analogous to that of a ‘store proprietor who charges customers to use a photocopier on his premises’” (quoting *Cartoon Network*, 536 F.3d at 132)).

¹⁰⁵ *See, e.g.*, *United States v. Slater*, 348 F.3d 666 (7th Cir. 2003) (imposing criminal liability for copyright infringement on the operators of a pirate software website); *UMG Recordings, Inc. v. MP3.com, Inc.*, 92 F. Supp. 2d 349, 350 (S.D.N.Y. 2000) (opening the opinion by stating that “[t]he complex marvels of cyberspatial communication may create difficult legal issues[,] but not in this case,” before imposing civil liability on an illegal music streaming site).

infringement was initiated by the actions of the customer seems insufficient to protect the owner from liability. In each of these instances, the owner's "machine" has reproduced a copyrighted work. Copyright infringement, however, requires not just an act of reproduction, but a reproduction of "the copyrighted work."¹⁰⁶ In the case of the copy shop owner who makes a photocopier available to customers, the reproduction of that specific copyrighted work seems attributable to a choice made by the customer. However, when it is the owner who uses the copier or who selects the works available for downloading from its website, the reproduction of those specific works is more clearly connected to the owner's actions. The volition requirement in copyright law defines the connection between the owner of a copying system and the copied work that is sufficient to justify attributing the copying of that work to the owner.¹⁰⁷

The requirement of volition has typically been invoked in contexts like *Netcom*, where a defendant has put in place a mechanism that is used by third parties to reproduce (or perform, display, or distribute)¹⁰⁸ a copyrighted work.¹⁰⁹ The issue to be decided is whether the owner of the system should be directly liable for infringements that result when third parties make use of the system.¹¹⁰ The volition requirement should be interpreted to limit the system owner's direct liability for third-party use to situations where the owner is directly linked to the specific work that has been copied. As Justice Scalia argued in *Aereo*, "since the Act

¹⁰⁶ 17 U.S.C. § 106(1) (2012) (providing the owner of a copyright with the exclusive right to "reproduce the copyrighted work in copies or phonorecords").

¹⁰⁷ See *Aereo*, 134 S. Ct. at 2512 (Scalia, J., dissenting) ("[T]he volitional-act requirement demands conduct directed to the plaintiff's copyrighted material . . ."); Naoya Isoda, *Copyright Infringement Liability of Placeshifting Services in the United States and Japan*, 7 WASH. J.L. TECH. & ARTS 149, 159 (2011) (interpreting *Netcom* as holding that "a service provider should not be liable for direct infringement unless it engages in some *volitional* conduct in relationship to the copying of a particular copyrighted work").

¹⁰⁸ Courts have held that the "volition" requirement is equally applicable to the infringement of each of the exclusive rights granted to the copyright owner in section 106. 17 U.S.C. § 106; see also, e.g., *Perfect 10, Inc. v. Megaupload Ltd.*, No. 11cv0191-IEG (BLM), 2011 WL 3203117, at *4 (S.D. Cal. July 27, 2011), *vacated pursuant to settlement*, No. 11cv0191-IEG (BLM), 2011 WL 10618723 (S.D. Cal. Oct. 11, 2011) ("The element of volitional conduct applies to all exclusive rights under the Copyright Act."); *Arista Records LLC v. Usenet.com, Inc.*, 633 F. Supp. 2d 124, 147 (S.D.N.Y. 2009) ("[T]he volitional-conduct requirement should apply equally to all exclusive rights under the Copyright Act.>").

¹⁰⁹ See *Religious Tech. Ctr. v. Netcom On-Line Commc'n Servs.*, 907 F. Supp. 1361, 1371-74 (N.D. Cal. 1995).

¹¹⁰ When there is no involvement by a third party in the reproduction, volition defenses have been rejected. See, e.g., *Quantum Sys. Integrators, Inc. v. Sprint Nextel Corp.*, 338 F. App'x 329 (4th Cir. 2009) (loading of copyrighted software inadvertently by the defendant's own employees held as sufficient to satisfy the volition requirement); *Live Face on Web, LLC v. Emerson Cleaners, Inc.*, 66 F. Supp. 3d 551 (D.N.J. 2014) (holding that an allegation that defendant operated a website that used infringing software was sufficient to satisfy the volition requirement).

makes it unlawful to copy or perform copyrighted works, not to copy or perform in general, the volitional-act requirement demands conduct directed to the plaintiff's copyrighted material."¹¹¹ In *Netcom*, the bulletin board operator escaped direct liability because its copying was "automatic and indiscriminate."¹¹² Even early cases rejected appeals to *Netcom* by defendants who had a more direct connection to the infringed work.¹¹³

What connection between the system owner and the copied work is sufficient to establish the volition necessary for direct liability? The volition requirement has sometimes been evaluated by asking "who made the copy?" Justice Scalia in *Aereo*, for example, stated that *Aereo*'s transmission "undoubtedly results in a performance; the question is *who* does the performing."¹¹⁴ Similarly, in *Cartoon Network*, when the Second Circuit considered whether a cable television company was liable for copies of programs residing on its remote storage digital video recorder system, the court stated that "[t]he question is *who* made this copy."¹¹⁵ That inquiry, however, seems largely conclusory since both the system owner and the user have participated in the process that resulted in the reproduction or performance and there is no rule of copyright law that would preclude the imposition of direct liability on both parties.¹¹⁶

In *Aereo*, Justice Scalia opined that "[m]ost of the time that issue will come down to who selects the copyrighted content: the defendant or its customers."¹¹⁷ Selection of the copied work by the system owner

¹¹¹ *Aereo*, 134 S. Ct. at 2512 (Scalia, J., dissenting) (citation omitted); *see also, e.g.*, *Cartoon Network LP v. CSC Holdings, Inc.*, 536 F.3d 121, 132 (2d Cir. 2008) (holding that because of the defendant's limited control over content, it was not "sufficiently proximate" to the copying).

¹¹² *Netcom*, 907 F. Supp. at 1372.

¹¹³ *See, e.g.*, *Playboy Enters., Inc. v. Webworld, Inc.*, 968 F. Supp. 1171 (N.D. Tex. 1997) (imposing direct liability on a website owner that sold copies of works that he had obtained from Internet newsgroups).

¹¹⁴ *Aereo*, 134 S. Ct. at 2512 (Scalia, J., dissenting).

¹¹⁵ *Cartoon Network*, 536 F.3d at 130; *see also, e.g.*, *Fox Broad. Co. v. Dish Network L.L.C.*, 747 F.3d 1060, 1067 (9th Cir. 2014) (holding that the district court did not err in concluding that the user of Dish Network's home digital video recorder—not Dish Network itself—made the copies of plaintiff's programs).

¹¹⁶ *See* *Buck v. Jewell-La Salle Realty Co.*, 283 U.S. 191, 198 (1931) (stating that "[n]o reason is suggested why there may not be more than one liability," and rejecting a hotel owner's argument that since the radio station's unlicensed broadcast was an infringing performance, the hotel could not also be liable for an infringing performance when it transmitted the broadcast to its public and private rooms); *see also, e.g.*, *Three Boys Music Corp. v. Bolton*, 212 F.3d 477 (9th Cir. 2000) (holding a composer, a music publisher, and a record company liable for infringement of plaintiff's musical work); *Fitzgerald Publ'g Co. v. Baylor Publ'g Co.*, 807 F.2d 1110 (2d Cir. 1986) (holding a printer and publisher liable for infringement of literary work).

¹¹⁷ *Aereo*, 134 S. Ct. at 2513 (Scalia, J., dissenting); *see also, e.g.*, *Cartoon Network*, 536 F.3d at 132 (rejecting the district court's conclusion that Cablevision should be liable for infringing uses of its remote DVR because of its "unfettered discretion in selecting the programming that it would make available," noting that "Cablevision has no control over what programs are made

can indeed be sufficient to establish the necessary volition, but selection of the work is not a necessary prerequisite to direct liability. For example, a copy shop that produces photocopied “course packs” for college students is liable for any resulting infringements despite the fact that the infringed works were selected by the professors who teach the courses.¹¹⁸ Similarly, absent a license from the copyright owners, Netflix would surely be liable for unauthorized streaming of works that have been selected for viewing by the subscribers to its service.¹¹⁹ The Copyright Act itself envisions the potential liability of a library that makes a copy of a work that has been selected by a patron.¹²⁰

In *Cartoon Network*, the remote DVR case, the Second Circuit emphasized another factor: the distinction between human decision-makers and automated systems.¹²¹ According to the court, “a significant difference exists between making a request to a human employee, who then volitionally operates the copying system to make the copy, and issuing a command directly to a system, which automatically obeys commands and engages in no volitional conduct.”¹²² If a human being functioning as an agent of the defendant makes a decision to copy or perform a particular work, that decision should satisfy the requirement of volition since it directly links the defendant to the infringement of that specific copyrighted work. Thus, the copy shop is liable when its employees reproduce copyrighted works at the request of customers,¹²³ and the library risks liability when an employee copies a work from the library’s collection in response to a request from a patron.¹²⁴ Since copyright infringement is a strict liability tort, there is no need to

available on individual channels or when those programs will air, if at all” (quoting *Twentieth Century Fox Film Corp. v. Cablevision Sys. Corp.*, 478 F. Supp. 2d 607 (S.D.N.Y. 2007))).

¹¹⁸ *Princeton Univ. Press v. Mich. Document Servs., Inc.*, 99 F.3d 1381 (6th Cir. 1996) (en banc).

¹¹⁹ See *Warner Bros. Entm’t v. WTV Sys., Inc.*, 824 F. Supp. 2d 1003 (C.D. Cal. 2011) (holding that the operator of an online DVD “rental” service that streamed movies selected by its customers is liable for violating the copyright owners’ public performance right).

¹²⁰ See 17 U.S.C. § 108(d)–(e) (2012) (establishing the specific criteria necessary to qualify for an exemption from liability for a library’s copying performed at the request of patrons).

¹²¹ See *Cartoon Network*, 536 F.3d at 131.

¹²² *Id.*

¹²³ *Princeton Univ. Press*, 99 F.3d 1381; see also, e.g., *Gardner v. CafePress Inc.*, No. 3:13-cv-1108-GPC-JLB, 2014 WL 6890934 (S.D. Cal. Dec. 4, 2014) (holding that the volition requirement was satisfied when employees of defendant printed images uploaded by customers onto shirts and mugs); *RCA Records v. All-Fast Sys., Inc.*, 594 F. Supp. 335 (S.D.N.Y. 1984) (finding that defendant’s employees made copies of music tapes at the request of customers); cf. *Soc’y of the Holy Transfiguration Monastery, Inc. v. Gregory*, 689 F.3d 29 (1st Cir. 2012) (finding that regardless of whether the law requires a showing of volitional conduct, the defendant, who authorized posting of the copyrighted works on his website, is directly liable for infringement).

¹²⁴ See 17 U.S.C. § 108(d)–(e).

establish that the human actor was aware of the infringement.¹²⁵ If the system is fully automated, however, the actions of the system will not themselves satisfy the volition requirement. Thus, the service providers in *Netcom* were not directly liable for the infringing use of their systems by customers. Providers offering cloud storage¹²⁶ and website hosting services¹²⁷ have been similarly successful in asserting a lack of volition when charged with their customers' infringements. The cable television company in *Cartoon Network* used the same argument to avoid direct liability for the copies made by its customers on its remote DVR system.¹²⁸ However, the case law does not draw a bright line between human decision-making and automation.¹²⁹ Like selection of the work, human intervention can be sufficient, but it is not necessary to establish a connection between the system owner and the copied work that is sufficiently robust to satisfy the volition requirement. For example, Netflix presumably would be directly liable for the unauthorized public performance of an unlicensed movie despite the fact that the streaming process triggered by the subscriber's request is fully automated. Similarly, Internet search engines whose web crawlers retrieve images from websites, which are then displayed in response to search requests, are potentially liable to the owners of the images even though no human being acting on behalf of the search engine has taken any action or decision with respect to those specific works.¹³⁰ A company operating a storage locker for digital music was held liable for automatically uploading album cover art for the music that its users had chosen to

¹²⁵ See 3 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 9:5.50 (perm. ed., rev. vol. 2013) ("The requirement of volitional conduct does not undermine the strict liability nature of copyright, but rather serves to ensure that there is a causal connection between the conduct in question and the person alleged to have violated the copyright owners' Section 106 rights where direct infringement is alleged.").

¹²⁶ See *Disney Enters., Inc. v. Hotfile Corp.*, 798 F. Supp. 2d 1303 (S.D. Fla. 2011); see also *infra* Section III.A.

¹²⁷ See *CoStar Grp. v. LoopNet, Inc.*, 373 F.3d 544 (4th Cir. 2004); *Leonard v. Stemtech Health Scis., Inc.*, No. 08-67-LPS-CJB, 2013 WL 5288266 (D. Del. Sept. 19, 2013); *Rosen v. Hosting Servs., Inc.*, 771 F. Supp. 2d 1219 (C.D. Cal. 2010).

¹²⁸ *Cartoon Network LP v. CSC Holdings, Inc.*, 536 F.3d 121, 131-32 (2d Cir. 2008); see also Carrie Bodner, *Master Copies, Unique Copies and Volitional Conduct: Cartoon Network's Implications for the Liability of Cyber Lockers*, 36 COLUM. J.L. & ARTS 491, 515 (2013) ("Although the Copyright Act does not expressly require a human actor for direct liability, some courts appear to emphasize some degree of actual human involvement as nearly a prerequisite to finding volitional conduct in a claim against an automated service." (footnote omitted)); *infra* Section III.C.

¹²⁹ GOLDSTEIN, *supra* note 36, § 7.0.2 ("It is the concerted steps and their consequences, not the accident of whether those steps were executed by humans or automatons, that is the pivot of liability.").

¹³⁰ See, e.g., *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007). The search engine may of course escape liability if its use is considered fair. *Id.* at 1168; see also *infra* Section III.B.

upload,¹³¹ and the Copyright Act itself imposes liability on an unlicensed automated “interactive service” that enables users to receive a performance of a requested sound recording.¹³²

If selection of the infringed work, or a human decision to copy or perform that work, by the service provider is not a prerequisite to the volition necessary for direct liability, when will a lack of volition preclude liability?¹³³ An analysis of the volition cases indicates that courts are likely to conclude that there is an absence of volition when the only means available for a service provider to prevent the infringement is to police the actions of its individual customers. Thus, volition requires a relationship between the system owner and the copyrighted work that will permit the owner to prevent infringement of the work without the necessity of monitoring the behavior of third parties. When monitoring and policing of third parties is necessary to avoid infringement, liability on the part of the service provider should instead be based on the rules governing contributory and vicarious liability for the infringing conduct of others.

B. *A Duty to Police*

As the court in *Netcom* explained:

The court does not find workable a theory of infringement that would hold the entire Internet liable for activities that cannot reasonably be deterred. Billions of bits of data flow through the Internet and are necessarily stored on servers throughout the network and it is thus practically impossible to screen out infringing bits from noninfringing bits.¹³⁴

¹³¹ *Capitol Records, Inc. v. MP3tunes, LLC*, 48 F. Supp. 3d 703, 720 (S.D.N.Y. 2014) (“It was reasonable for the jury to conclude that MP3tunes’ volitional conduct—creating a feature to automatically retrieve cover art from Amazon.com—caused the unauthorized reproduction of the Labels’ cover art.”).

¹³² See 17 U.S.C. §§ 114(d)(2)(A)(i), (j)(7) (2012).

¹³³ David Nimmer wonders whether “volition” is an element of the cause of action for direct infringement or an affirmative defense to liability. See NIMMER & NIMMER, *supra* note 16, § 13.08[C]. It is neither; the volition requirement is instead part of the interpretation of the traditional elements of direct infringement, such as reproducing the copyrighted work in copies or phonorecords, 17 U.S.C. § 106(1), performing the copyrighted work publicly, *id.* § 106(4), or displaying the copyrighted work publicly. *Id.* § 106(5). The reproduction, performance, or display must be volitional in order to satisfy that element of the cause of action. A typical copyright infringement complaint will include allegations of conduct that satisfies the requirement of volition. *Cf.* NIMMER & NIMMER, *supra* note 16, § 32.04 (analyzing copyright infringement complaints).

¹³⁴ *Religious Tech. Ctr. v. Netcom On-Line Commc’n Servs.*, 907 F. Supp. 1361, 1372–73 (N.D. Cal. 1995).

The court in *Netcom* was acutely aware of the burden that the risk of direct liability would place on Internet service providers. If a service provider is liable for the direct infringement of a work whose sole connection to the provider is that a user has introduced it into the provider's system, the only way to escape the risk of liability would be to monitor the conduct of every customer. Judge Whyte's introduction of the "volition" requirement avoids that result by demanding a stronger connection between the provider and the infringed work as a prerequisite to direct liability.¹³⁵ The purpose of the volition requirement—to avoid imposing on service providers a de facto duty to monitor and police their customers—sheds considerable light on the doctrine's subsequent interpretation and implementation.

The debate over the appropriate liability rules for service providers dates back to the early years of the Internet. In 1993, the Clinton administration created a Task Force to develop telecommunication and information policies that would promote a National Information Infrastructure.¹³⁶ Writing prior to the decision in *Netcom*, the Working Group on Intellectual Property Rights (Working Group) reviewed the arguments mounted by service providers in support of legislative limitations on their direct liability for copyright infringement:

Arguments made by service providers wishing exemption or a higher standard for liability include: that the volume of material on a service provider's system is too large to monitor or screen; that even if a service provider is willing and able to monitor the material on its system, it cannot always identify infringing material; that failure to shield on-line service providers will impair communication and availability of information; that exposure to liability for infringement will drive service providers out of business¹³⁷

The arguments failed to move the Working Group, which recommended against any limitation of liability. Their report concluded that service providers were "in a better position to prevent or stop infringement than the copyright owner. Between these two relatively innocent parties, the best policy is to hold the service provider liable."¹³⁸ The debate continued in the wake of decisions such as *Netcom*, as Congress contemplated a legislative response to the potential liability of Internet service providers.¹³⁹ One congressional proposal included a

¹³⁵ *Id.* at 1369–71.

¹³⁶ WORKING GRP. ON INTELLECTUAL PROP. RIGHTS REPORT, *supra* note 78, at 1.

¹³⁷ *Id.* at 115–16.

¹³⁸ *Id.* at 117.

¹³⁹ Service providers maintained that they should not be required to monitor the traffic on their networks or determine whether a particular use was infringing; Jack Valenti, speaking on behalf of the Motion Picture Association of America, asked who would then be responsible for

codification of *Netcom* that would have precluded the imposition of direct liability against a service provider for transmission or intermediate storage initiated by a third party on an automated system if the provider had no role in selecting the work.¹⁴⁰

In the end, Congress opted for a different approach. Section 512 of the Copyright Act created a series of safe harbors that substantially limit the available remedies for infringement against qualifying service providers.¹⁴¹ However, section 512(l) explicitly states that the failure of a service provider to qualify for a safe harbor “shall not bear adversely upon the consideration of a defense by the service provider that the service provider’s conduct is not infringing under this title or any other defense.”¹⁴² Thus, the rules for direct infringement, including the volition requirement announced in *Netcom*, remain applicable in determining a service provider’s initial liability.¹⁴³ In the context of safe harbors at least, the congressional policy regarding a service provider’s duty to monitor and police its customers is clear: “Nothing in this section shall be construed to condition the applicability of subsections (a) through (d) on—(1) a service provider monitoring its service or

online infringements. See *Two Days of Hearings on NII Bill Consider Provider Liability and Fair Use*, 51 Pat. Trademark & Copyright J. (BNA) 1265 (Feb. 15, 1996).

¹⁴⁰ H.R. REP. NO. 105-551, pt. 1, at 7 (1998); *id.* at 11 (“As to direct infringement, liability is ruled out for passive, automatic acts engaged in through a technological process initiated by another. Thus, the bill essentially codifies the result in the leading and most thoughtful judicial decision to date: *Religious Technology Center v. Netcom On-Line Communications Services, Inc.*, 907 F. Supp. 1361 (N.D. Cal. 1995).”).

¹⁴¹ See 17 U.S.C. § 512 (2012).

¹⁴² *Id.* § 512(l).

¹⁴³ H.R. REP. NO. 105-796, at 73 (1998) (Conf. Rep.), as reprinted in 1998 U.S.C.C.A.N. 639, 649 (“As provided in subsection (l), Section 512 is not intended to imply that a service provider is or is not liable as an infringer either for conduct that qualifies for a limitation of liability or for conduct that fails to so qualify. Rather, the limitations of liability apply if the provider is found to be liable under existing principles of law.”); see also, e.g., *CoStar Grp. v. LoopNet, Inc.*, 373 F.3d 544 (4th Cir. 2004) (volition analysis in *Netcom* remains applicable in determining a service provider’s direct liability despite the enactment of the safe harbor provisions); *Ellison v. Robertson*, 357 F.3d 1072, 1176 (9th Cir. 2004) (“Congress opted ‘to leave current law in its evolving state’” (quoting S. REP. NO. 105-190, at 19 (1998))); *Perfect 10, Inc. v. Cybernet Ventures, Inc.*, 213 F. Supp. 2d 1146, 1174 (C.D. Cal. 2002) (“These ‘safe harbors’ do not affect the question of ultimate liability under the various doctrines of direct, vicarious, and contributory liability.”). The *Nimmer on Copyright* treatise interprets some of the section 512 safe harbors as applicable without regard to volition because the provisions are not limited to automated systems or selections of works. It argues that courts should therefore not apply *Netcom*’s volition analysis in determining initial liability in such cases. NIMMER & NIMMER, *supra* note 16, § 12B.06[B]. However, the volition requirement in *Netcom* is applicable only to direct liability, not contributory or vicarious liability, and thus its continued application would not render any of the safe harbors superfluous. In *Aereo*, Justice Scalia commented that “Congress has enacted several safe-harbor provisions applicable to automated network processes, see, e.g., 17 U.S.C. § 512(a)–(b), but those provisions do not foreclose ‘any other defense,’ § 512(l), including a volitional-conduct defense.” *Am. Broad. Cos. v. Aereo, Inc.*, 134 S. Ct. 2498, 2513 n.2 (2014) (Scalia, J., dissenting).

affirmatively seeking facts indicating infringing activity.”¹⁴⁴ Like *Netcom*, the safe harbor provisions attempt to balance the protection of copyright owners and the promotion of technological innovation by shielding providers from the potentially crippling burden of supervision.¹⁴⁵

When the only connection between a service provider and the infringed work is that a third party has introduced the work into the provider’s system, only monitoring all third-party use can avoid infringements. This is precisely the general circumstance in which courts have invoked the volition requirement to preclude the imposition of direct liability on service providers.¹⁴⁶ On the other hand, when a provider’s connection to the work is sufficiently close to afford more direct control over the copying, distribution, or performance of the work, courts are likely to attribute any resulting infringement to the provider’s volitional conduct.¹⁴⁷ Thus, if no third party has participated in the alleged infringement, defendants rarely invoke the volition requirement; when they do, the issue is quickly resolved in favor of the

¹⁴⁴ 17 U.S.C. § 512(m)(1). The only exception relates to a provider’s obligation to accommodate standard technical measures implemented by copyright owners to protect their works. *Id.*; see also *id.* § 512(i).

¹⁴⁵ See *Religious Tech. Ctr. v. Netcom On-Line Comm’n Servs.*, 907 F. Supp. 1361, 1369–73 (N.D. Cal. 1995). In the context of imposing secondary liability on a provider of file-sharing software, the Supreme Court has spoken of:

[A] sound balance between the respective values of supporting creative pursuits through copyright protection and promoting innovation in new communication technologies by limiting the incidence of liability for copyright infringement. The more artistic protection is favored, the more technological innovation may be discouraged; the administration of copyright law is an exercise in managing the tradeoff.

Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd., 545 U.S. 913, 928 (2005).

¹⁴⁶ See, e.g., *CoStar Grp. v. LoopNet, Inc.*, 373 F.3d 544, 550 (4th Cir. 2004) (“But to establish direct liability under §§ 501 and 106 of the Act, something more must be shown than mere ownership of a machine used by others to make illegal copies.”).

¹⁴⁷ Despite its origins in *Netcom* and other Internet service provider cases, there is no obvious reason to limit the volition requirement to the Internet. See, e.g., *Quantum Sys. Integrators, Inc. v. Sprint Nextel Corp.*, 338 F. App’x 329 (4th Cir. 2009) (applying the volition requirement to the loading of software into computers); *Cartoon Network LP v. CSC Holdings, Inc.*, 536 F.3d 121, 131 (2d Cir. 2008) (“While the *Netcom* court was plainly concerned with a theory of direct liability that would effectively ‘hold the entire Internet liable’ for the conduct of a single user, its reasoning and conclusions . . . transcend the Internet. Like the Fourth Circuit, we reject the contention that ‘the *Netcom* decision was driven by expedience and that its holding is inconsistent with the established law of copyright,’ and we find it ‘a particularly rational interpretation of § 106,’ rather than a special-purpose rule applicable only to ISPs.” (first quoting *Netcom*, 907 F. Supp. at 1372; then quoting *CoStar*, 373 F.3d at 549, 551)); *In re AutoHop Litig.*, No. 12 Civ. 4155(LTS)(KNF), 2013 WL 5477495 (S.D.N.Y. Oct. 1, 2013) (applying the requirement to a home DVR system); cf. *Fox Broad. Co. v. Dish Network L.L.C.*, 747 F.3d 1060, 1067 (9th Cir. 2014) (holding that the supplier of a DVR system must “cause the copying” (citing *Cartoon Network*, 536 F.3d at 130)); see also PATRY, *supra* note 125, § 9:5.50 (“The volitional conduct requirement has been extended well beyond the Internet . . .”).

plaintiffs. For example, when a defendant's employees inadvertently loaded the plaintiff's copyrighted software onto the company's computers, the Fourth Circuit had no difficulty concluding that the copying was volitional.¹⁴⁸ An allegation that a defendant had downloaded the plaintiff's software to its website was also held sufficient to satisfy the requirement of volition,¹⁴⁹ and a defendant that instructed its employees to upload copyrighted music files to its servers was similarly held to have engaged in volitional conduct sufficient for direct liability.¹⁵⁰ The volition requirement is satisfied even if the copying by the defendant's employees is done in response to a request from a third party. Thus, a company that printed images uploaded by customers onto items such as shirts, bags, and mugs was held to have acted volitionally for purposes of direct liability.¹⁵¹ Photocopy shops that reproduce works tendered by customers are subject to direct liability,¹⁵² and a library can be liable for copying done at the request of a patron.¹⁵³ When the system is fully automated and can thus respond to third-party requests without intervention by the provider's employees, the volition requirement can still be satisfied if the provider has pre-selected the content on which its system can operate.¹⁵⁴ Thus, the operators of websites that permit third parties to download or stream copyrighted content that has been chosen by the website operator are subject to direct liability.¹⁵⁵ As noted, the Copyright Act specifically anticipates liability for the digital audio transmission of a sound recording that has been selected by a user from the content offered by an interactive

¹⁴⁸ See *Quantum*, 338 F. App'x at 336; see also *Sater Design Collection, Inc. v. Waccamaw Constr., Inc.*, No. 4:08-cv-4133-TLW-SVH, 2011 WL 666146 (D.S.C. Feb. 14, 2011) (holding that a builder that used copyrighted architectural plans engaged in volitional conduct).

¹⁴⁹ *Live Face on Web, LLC v. Emerson Cleaners, Inc.*, 66 F. Supp. 3d 551 (D.N.J. 2014).

¹⁵⁰ *UMG Recording, Inc. v. Escape Media Grp.*, No. 11 Civ. 8407, 2014 WL 5089743 (S.D.N.Y. Sept. 29, 2014).

¹⁵¹ *Gardner v. CafePress Inc.*, No. 3:13-cv-1108-GPC-JLB, 2014 WL 6890934 (S.D. Cal. Dec. 4, 2014).

¹⁵² See, e.g., *Princeton Univ. Press v. Mich. Document Servs., Inc.*, 99 F.3d 1381 (6th Cir. 1996) (en banc).

¹⁵³ See 17 U.S.C. §§ 108(d)-(e) (2012).

¹⁵⁴ See *Am. Broad. Cos. v. Aereo, Inc.*, 134 S. Ct. 2498, 2513 (2014) (Scalia, J., dissenting) ("Most of the time [volition] will come down to who selects the copyrighted content: the defendant or its customers.").

¹⁵⁵ See, e.g., *Warner Bros. Entm't v. WTV Sys., Inc.*, 824 F. Supp. 2d 1003 (C.D. Cal. 2011) (finding that a website operator streamed movies from pre-selected DVDs); *Arista Records LLC v. Usenet.com, Inc.*, 633 F. Supp. 2d 124 (S.D.N.Y. 2009) (finding that defendant exercised control over the content that could be downloaded from its site); *UMG Recordings, Inc. v. MP3.com, Inc.*, 92 F. Supp. 2d 349 (S.D.N.Y. 2000) (finding that a website streamed music from copied CDs); *Playboy Enters., Inc. v. Webbworld, Inc.*, 968 F. Supp. 1171, 1175 (N.D. Tex. 1997) (holding that a website is liable for providing downloads of copyrighted images, specifically rejecting a defense founded on *Netcom* because the defendant "surely ha[d] control over the images it chooses to sell on the [its] website").

transmission service.¹⁵⁶ In all of these circumstances, the defendant could have avoided the risk of direct liability by policing only its own choices and conduct, without the need to monitor the choices and conduct of third-party users.

Protection under the volition requirement has been reserved for service providers who would otherwise be forced to monitor and police the actions of third parties. That was precisely what instigated the creation of the doctrine in *Netcom*. A contrary holding on direct liability would have forced both the bulletin board operator and Internet access provider—and indeed the operators of every other server connected to the Internet—to monitor the specific works being transmitted by Internet users.¹⁵⁷ The stock example of an unattended photocopier in a library or copy shop provides a similar illustration. In the absence of a volition requirement, the proprietor would be forced to pre-approve every item prior to copying or risk potential liability. Even if the photocopy machine permits patrons to email material directly to the copier, the volition requirement should prevent direct liability since the proprietor would otherwise be forced to monitor the incoming traffic.¹⁵⁸ Similarly, the volition requirement was successfully invoked by a telecommunications company to avoid liability for unauthorized public performances when its system signaled incoming cellphone calls by triggering ringtones that had been downloaded onto the cellphones by users.¹⁵⁹ More significantly, the volition requirement has been invoked to preclude the imposition of direct liability against the providers of cloud storage and web-hosting services for infringements committed by their customers.¹⁶⁰

If a service provider does in fact monitor its customers' use of its system in an effort to limit infringement, is it then sufficiently

¹⁵⁶ See 17 U.S.C. §§ 114(d)(2)(A)(1), (j)(7).

¹⁵⁷ See *Religious Tech. Ctr. v. Netcom On-Line Commc'n Servs.*, 907 F. Supp. 1361, 1372–73 (N.D. Cal. 1995).

¹⁵⁸ Noting that volition is no bar to direct liability in cases like *Princeton University Press v. Michigan Document Services, Inc.*, 99 F.3d 1381 (6th Cir. 1996) (en banc), where the copy shop proprietor itself makes the copies, Professor Paul Goldstein argues that the outcome should be the same even if the copying process is fully automated. GOLDSTEIN, *supra* note 36, § 7.0.2. However, the latter example is difficult to distinguish from an unattended photocopier with email access; to avoid imposing a duty to monitor every use of the system, the proprietor's liability should be determined under the rules applicable to secondary rather than direct liability.

¹⁵⁹ *In re Cellco P'ship*, 663 F. Supp. 2d 363 (S.D.N.Y. 2009).

¹⁶⁰ See, e.g., *CoStar Grp. v. LoopNet, Inc.*, 373 F.3d 544 (4th Cir. 2004) (web hosting); *Disney Enters., Inc. v. Hotfile Corp.*, 798 F. Supp. 2d 1303 (S.D. Fla. 2011) (cloud storage); see also *infra* text accompanying notes 176–90. Although not specifically discussing volition, cases considering the potential liability of file-sharing software providers for the infringing distributions of copyrighted works by users of the software rely on doctrines relating to secondary rather than direct liability. See, e.g., *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005); *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001).

connected to their use to justify the imposition of direct liability for any remaining violations? An affirmative answer would of course act as a deterrent to policing—a point noted by Congress in the course of creating the safe harbor provisions for service providers.¹⁶¹ In the principle case on the issue, *CoStar Group v. LoopNet*, the Fourth Circuit specifically rejected the argument that the volition requirement was satisfied against the operator of a website that allowed customers to post listings for commercial real estate because the operator had blocked photos that did not depict commercial property or that displayed a copyright notice from a third party.¹⁶² The court found that the screening did not “add volition to [defendant]’s involvement in storing the copy.”¹⁶³ Returning to a favored analogy, the court compared the situation “to an owner of a copy machine who has stationed a guard by the door to turn away customers who are attempting to duplicate clearly copyrighted works.”¹⁶⁴ However, if the monitoring appears to be aimed at selecting the content that will be available on the site, the provider’s involvement may be viewed in a harsher light.¹⁶⁵

The fact that a service provider can successfully invoke the requirement of volition to avoid direct liability for copyright infringement does not mean that the provider will escape all responsibility. When the connection between a service provider and the copyrighted work is too attenuated to support a charge that the provider itself has copied or otherwise infringed, its potential liability will turn instead on doctrines of secondary liability that determine when it is appropriate to hold a party liable for infringements committed by others. Thus, the basic function of the volition requirement is to channel the analysis in appropriate cases to the doctrines of contributory and vicarious liability, where issues such as a defendant’s knowledge or

¹⁶¹ H.R. REP. NO. 105-796, at 73 (1998) (Conf. Rep.), as reprinted in 1998 U.S.C.C.A.N. 639, 649 (“This legislation is not intended to discourage the service provider from monitoring its service for infringing material. Courts should not conclude that the service provider loses eligibility for limitations on liability under section 512 solely because it engaged in a monitoring program.”).

¹⁶² See *CoStar*, 373 F.3d 544.

¹⁶³ *Id.* at 556.

¹⁶⁴ *Id.* But see *Playboy Enters., Inc. v. Russ Hardenburgh, Inc.*, 982 F. Supp. 503, 506 (N.D. Ohio 1997) (screening by defendant to bar pornographic or “blatantly” copyrighted material contributed to the rejection of a *Netcom* defense).

¹⁶⁵ See *Capitol Records, LLC v. ReDigi Inc.*, 934 F. Supp. 2d 640 (S.D.N.Y. 2013) (finding that a reseller of digital music selected eligible files from customers’ computers); *Arista Records LLC v. Usenet.com, Inc.*, 633 F. Supp. 2d 124 (S.D.N.Y. 2009) (finding that defendant created servers dedicated to MP3 music files and increased the retention time for certain materials).

inducement of the infringement, or direct financial benefit attributable to the infringement, are relevant.¹⁶⁶

C. Secondary Liability

The volition requirement is not applicable to the imposition of liability under the rules for contributory or vicarious infringement since those doctrines do not focus on whether the defendant has itself infringed a copyright. They turn instead on factors that tie the defendant to the infringing conduct of third persons. For example, following his conclusion in *Netcom* that the absence of volition precluded direct liability against the Internet access provider and bulletin board operator, Judge Whyte proceeded to consider the potential liability of both parties for contributory and vicarious infringement.¹⁶⁷ Quoting the well-known formulation in *Gershwin Publishing v. Columbia Artists Management*, that liability for contributory infringement will be imposed if a defendant “with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another,” he refused both defendants’ requests for summary judgment.¹⁶⁸ The defendants had been notified of the infringing postings, and the plaintiffs had raised a genuine issue of fact as to whether the defendants’ failure to take measures to prevent further distribution of the works constituted “substantial participation” in the infringement.¹⁶⁹ As to vicarious liability, Judge Whyte adopted the traditional rule from *Shapiro, Bernstein & Co. v. H. L. Green Co.*,¹⁷⁰ holding that “[a] defendant is liable for vicarious liability for the actions of a primary infringer where the defendant (1) has the right and ability to control the infringer’s acts and (2) receives a direct financial benefit from the infringement.”¹⁷¹ Although there were genuine issues of fact as to whether the defendants had the right and ability to control the infringing activities, the plaintiffs

¹⁶⁶ *Am. Broad. Cos. v. Aereo, Inc.*, 134 S. Ct. 2498, 2514 (Scalia, J., dissenting) (arguing that the volitional-conduct requirement’s “purpose is not to excuse defendants from accountability, but to channel the claims against them into the correct analytical track”).

¹⁶⁷ *Religious Tech. Ctr. v. Netcom On-Line Commc’n. Servs., Inc.*, 907 F. Supp. 1361, 1373–77 (N.D. Cal. 1995).

¹⁶⁸ *Id.* (footnote omitted) (quoting *Gershwin Publ’g Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971)). The “inducement” form of contributory liability was at the center of the Supreme Court’s decision in *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005), concluding that a distributor of file-sharing software was liable for inducing infringing use.

¹⁶⁹ *Netcom*, 907 F. Supp. at 1375, 1382.

¹⁷⁰ 316 F.2d 304, 306 (2d Cir. 1963).

¹⁷¹ *Netcom*, 907 F. Supp. at 1375.

had failed to allege that the defendants' had received any direct financial benefit from the infringements, and their vicarious liability claims therefore failed.¹⁷² Other decisions similarly recognize the possibility of secondary liability for copyright infringement after concluding that a lack of volition precludes the imposition of direct liability.¹⁷³ Thus, facts not relevant to direct liability, such as knowledge, inducement, and financial gain, determine whether a defendant is secondarily liable for infringements committed by others. However, the Supreme Court made it clear in *Sony v. Universal City Studios* that secondary liability cannot rest solely on the fact that a defendant has provided a product used by others to infringe if the product is "capable of substantial noninfringing uses."¹⁷⁴ As a subsequent Supreme Court decision stated, "*Sony* barred secondary liability based on presuming or imputing intent to cause infringement solely from the design or distribution of a product capable of substantial lawful use, which the distributor knows is in fact used for infringement."¹⁷⁵

III. VOLITION APPLIED

A. *Cloud Storage*

Justice Breyer's opinion in *Aereo*, which imposed direct liability on the defendant for its Internet television delivery system, included an explicit attempt to limit the scope of the decision: "We agree with the Solicitor General that '[q]uestions involving cloud computing, [remote storage] DVRs, and other novel issues not before the Court, as to which

¹⁷² *Id.* at 1377, 1382.

¹⁷³ See, e.g., *Perfect 10, Inc. v. Giganews, Inc.*, No. CV11-07098 AHM (SHx), 2013 WL 2109963 (C.D. Cal. Mar. 8, 2013) (refusing to dismiss claims for contributory and vicarious liability); *Disney Enters., Inc. v. Hotfile Corp.*, 798 F. Supp. 2d 1303 (S.D. Fla. 2011) (finding contributory liability); *Marobie-FL, Inc. v. Nat'l Ass'n of Fire Equip. Distribs. & N.W. Nexus, Inc.*, 983 F. Supp. 1167 (N.D. Ill. 1997) (denying summary judgment on contributory infringement count); *Sega Enters. Ltd. v. MAPHIA*, 948 F. Supp. 923 (N.D. Cal. 1996) (finding contributory liability). Other decisions that refuse to impose direct liability due to the absence of volition have rejected secondary liability claims only after an analysis on the merits. See, e.g., *Parker v. Google, Inc.*, 242 F. App'x 833 (3d Cir. 2007) (per curiam); *Leonard v. Stemtech Health Scis., Inc.*, No. 08-67-LPS-CJB, 2013 WL 5288266 (D. Del. Sept. 19, 2013); see also, e.g., *In re AutoHop Litig.*, No. 12 Civ. 4155(LTS)(KNF), 2013 WL 5477495 (S.D.N.Y. Oct. 1, 2013) (holding that lack of volition precluded liability for direct infringement and that secondary liability was precluded because the users of the defendant's system did not infringe); *In re Cellco P'ship*, 663 F. Supp. 2d 363 (S.D.N.Y. 2009) (same).

¹⁷⁴ *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 442 (1984).

¹⁷⁵ *Metro-Goldwyn-Mayer Studios Inc. v. Gorkster, Ltd.*, 545 U.S. 913, 933 (2005) (holding that a distributor of file-sharing software was liable upon proof of intent to induce infringement).

“Congress has not plainly marked [the] course,” should await a case in which they are squarely presented.”¹⁷⁶ “Cloud computing” can involve the storage and manipulation of a user’s data on a service provider’s central servers; users can often download or stream the stored data from any location with Internet access.¹⁷⁷ Some cloud services such as DropBox or Google Docs are typically used to store academic or business-related data, but others, like Megaupload and Hotfile, have been frequently used to store entertainment-related materials such as music and movies files.¹⁷⁸ Even before Megaupload and its founder Kim Dotcom became the subject of national news as a result of a Justice Department criminal indictment in 2012,¹⁷⁹ the storage website had been the subject of a civil suit brought by an owner of copyrighted works that were accessible on the website.¹⁸⁰ In support of a motion to dismiss a count of direct liability, Megaupload invoked the volitional conduct requirement introduced in *Netcom*.¹⁸¹ Denying the motion to dismiss, the court held that the complaint adequately alleged specific instances of volitional conduct sufficient for direct liability.¹⁸²

Other cases have recited factors such as knowledge and inducement in rejecting volition arguments raised by providers of storage services who have been charged as direct infringers.¹⁸³ However, a suit by motion picture studios against Hotfile, another well-known

¹⁷⁶ *Am. Broad. Cos. v. Aereo, Inc.*, 134 S. Ct. 2498, 2511 (2014) (alterations in original) (quoting Brief of the United States as Amicus Curiae Supporting Petitioners at 34).

¹⁷⁷ See Bodner, *supra* note 128, at 498–504.

¹⁷⁸ *Id.* at 499–501.

¹⁷⁹ See Jonathan Hutchison, *Online Renegade, Wanted in U.S., Shakes Up New Zealand Election*, N.Y. TIMES, Sept. 19, 2014, at A4; Ben Sisario, *U.S. Charges Popular Site with Piracy*, N.Y. TIMES, Jan. 20, 2012, at B1.

¹⁸⁰ See *Perfect 10, Inc. v. Megaupload Ltd.*, No. 11cv0191-IEG (BLM), 2011 WL 3203117 (S.D. Cal. July 27, 2011), *vacated pursuant to settlement*, No. 11cv0191-IEG (BLM), 2011 WL 10618723 (S.D. Cal. Oct. 11, 2011).

¹⁸¹ *Id.* at *4.

¹⁸² *Id.* (“[Megaupload] has created distinct websites, presumably in an effort to streamline users’ access to different types of media . . . ; it encourages and, in some cases pays, its users to upload vast amounts of popular media . . . ; it disseminates URLs for various files throughout the internet; it provides payouts to affiliate websites who maintain a catalogue of all available files; and last, at a minimum, it is plausibly aware of the ongoing, rampant infringement taking place on its websites.” (citations omitted)).

¹⁸³ See, e.g., *Williams v. Scribd, Inc.*, No. 09cv1836-LAB (WMC), 2010 WL 10090006 (S.D. Cal. June 23, 2010) (stating in dicta that awareness of infringing uploads may be sufficient for direct infringement); *Capitol Records, Inc. v. MP3tunes, LLC*, No. 07 Civ. 9931(WHP), 2009 WL 3364036 (S.D.N.Y. Oct. 16, 2009) (denying a motion to dismiss where a cloud storage provider was alleged to have known of infringing material and to have taken steps to increase third-party access); cf. *Arista Records LLC v. Usenet.com, Inc.*, 633 F. Supp. 2d 124 (S.D.N.Y. 2009) (granting summary judgment for direct infringement against a USENET access provider that was aware of infringing music files and that took steps to make the content more accessible).

online storage provider, yielded a quite different result.¹⁸⁴ Holding that the studios had not alleged conduct that satisfied the volition requirement, Judge Jordan dismissed a count of direct infringement, specifically rejecting decisions that find factors like knowledge or encouragement of infringement sufficient to constitute volition.¹⁸⁵ Those factors and others, however, were sufficient to avoid dismissal of the studios' counts against Hotfile alleging contributory, inducement, and vicarious liability.¹⁸⁶ Other courts adopt a similar interpretation of volition, holding that knowledge and encouragement of the infringement are insufficient to establish direct liability.¹⁸⁷

The cases refusing to impose direct liability on storage providers that allow users to upload and retrieve infringing materials are consistent with the underlying purpose of the volition requirement. The service providers have not selected the works that have been introduced into their systems nor have they made specific decisions to copy or perform any particular copyrighted work. The infringements can be prevented only if the providers monitor the choices and conduct of each of their customers. Reliance on factors like knowledge or encouragement of the infringement to satisfy the volition requirement for direct liability threatens to collapse the distinction between direct and secondary liability. The Second Circuit's opinion in *Cablevision*, which declined to impose direct liability on the provider of a remote DVR service, warned against precisely this danger:

If Congress had meant to assign direct liability to both the person who actually commits a copyright-infringing act and any person who actively induces that infringement, the Patent Act tells us that it knew how to draft a statute that would have this effect. Because Congress did not do so, the *Sony* Court concluded that “[t]he Copyright Act does not expressly render anyone liable for infringement committed by another.” Furthermore, in cases like *Sony*, the Supreme Court has

¹⁸⁴ See *Disney Enters., Inc. v. Hotfile Corp.*, 798 F. Supp. 2d 1303 (S.D. Fla. 2011).

¹⁸⁵ *Id.* at 1309. Commentators are similarly at odds. Compare Bodner, *supra* note 128 (questioning the volition limitation on the direct liability of cloud storage providers), with Brandon J. Trout, Note, *Infringers or Innovators? Examining Copyright Liability for Cloud-Based Music Locker Services*, 14 VAND. J. ENT. & TECH. L. 729 (2012) (supporting a volition limitation on direct liability).

¹⁸⁶ *Hotfile*, 798 F. Supp. 2d at 1310–11.

¹⁸⁷ See, e.g., *BWP Media USA Inc. v. Hollywood Fan Sites, LLC*, 69 F. Supp. 3d 342 (S.D.N.Y. 2014) (holding that allegations that a website owner encouraged third-party users to infringe was not sufficient to satisfy the requirement of volition for direct liability); *Perfect 10, Inc. v. Giganews, Inc.*, No. CV11–07098 AHM (SHx), 2013 WL 2109963 (C.D. Cal. Mar. 8, 2013) (dismissing a direct infringement count against a USENET access provider despite allegations that defendant knew of the infringing content, specifically rejecting the contrary result in *Megaupload*); *Sega Enters. Ltd v. MAPHIA*, 948 F. Supp. 923 (N.D. Cal. 1996) (holding that a bulletin board operator's knowledge or solicitation of infringing uploads was insufficient to satisfy the volition requirement).

strongly signaled its intent to use the doctrine of contributory infringement, not direct infringement, to “identify[] the circumstances in which it is just to hold one individual accountable for the actions of another.”¹⁸⁸

Rejecting the factors approach to volition adopted in cases like *Megaupload*, Judge Matz succinctly summarized its risk in *Perfect 10, Inc. v. Giganews, Inc.*: “By focusing on the defendant’s awareness or state of mind—rather than on *who* actually caused the infringement—these cases effectively hold defendants liable for copyright infringement committed by third parties without requiring a full assessment of the additional elements of secondary copyright infringement claims.”¹⁸⁹ The decisions finding insufficient volition for direct liability in the cloud storage cases are also consistent with analogous interpretations of the volition requirement in cases that decline to impose direct liability on defendants who maintain websites open to postings by third parties.¹⁹⁰

B. Search Engines

Cases applying the requirement of volition to the activities of Internet search engines and the commentators who discuss them agree on very little. Search engines such as Google might be subject to direct liability in connection with two distinct aspects of their operation. One issue relates to their actions in indexing and caching Internet websites in preparation for queries from users;¹⁹¹ the other relates to the material they provide in response to those queries.¹⁹² To create their databases, search engines employ software robots—“bots” or “web crawlers”—to make copies of websites that are then processed by indexing software to produce a database capable of responding to search requests from users.¹⁹³ In one early search engine case focusing on the reproductions

¹⁸⁸ *Cartoon Network LP v. CSC Holdings, Inc.*, 536 F.3d 121, 133 (2d Cir. 2008) (alterations in original) (citation omitted) (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 434–35 (1984)).

¹⁸⁹ *Giganews*, 2013 WL 2109963, at *9; see also *CoStar Grp. v. LoopNet, Inc.*, 373 F.3d 544, 549 (4th Cir. 2004) (“This, of course, does not mean that a manufacturer or owner of machines used for copyright violations could not have some *indirect* liability, such as contributory or vicarious liability. But such extensions of liability would require a showing of additional elements such as knowledge coupled with inducement or supervision coupled with a financial interest in the illegal copying.”).

¹⁹⁰ See, e.g., *CoStar*, 373 F.3d 544; *Leonard v. Stemtech Health Scis., Inc.*, No. 08–67–LPS–CJB, 2013 WL 5288266 (D. Del. Sept. 19, 2013); *Rosen v. Hosting Servs., Inc.*, 771 F. Supp. 2d 1219 (C.D. Cal. 2010); *Marobie-FL, Inc. v. Nat’l Ass’n of Fire Equip. Distribs.*, 983 F. Supp. 1167 (N.D. Ill. 1997).

¹⁹¹ See *infra* notes 193–99 and accompanying text.

¹⁹² See *infra* notes 200–07 and accompanying text.

¹⁹³ See PATRY, *supra* note 125, § 10:27.50; Bashor, *supra* note 61, at 107–09.

necessary to create a database of thumbnail images, the defendant conceded that the copying presented a prima facie case of infringement and defended instead on the basis of fair use—a defense ultimately upheld by the Ninth Circuit.¹⁹⁴ However, in *Parker v. Google*, the Third Circuit affirmed a district court's determination that Google's archiving and response to queries "do not include the necessary volitional element to constitute direct copyright infringement."¹⁹⁵ The treatise writers also disagree. William Patry, author of a major treatise on copyright law (and Senior Copyright Counsel to Google), concludes that the automatic archiving by search engines does not satisfy the volition requirement.¹⁹⁶ David Nimmer, distinguishing the Internet access provider in *Netcom*, reaches a different conclusion:

By contrast, in *Parker v. Google*, Google made the initial decision to send the Googlebot to cache many millions of web pages. Its status therefore is less like "the owner of a copying machine who lets the public make copies with it" and more precisely like a copyshop that itself decides to reproduce everything in its collection today in case members of the public would like to acquire those copies in the future.¹⁹⁷

Nimmer's analysis seems correct. Google's connection to the copied works is sufficiently close to justify application of the rules governing direct liability. No third party introduced the works into Google's system. Instead, Google itself made the decision to copy the websites by programming¹⁹⁸ and deploying its web crawlers, and the fact that the process is automated should not in itself negate the volitional nature of the activity.¹⁹⁹ Google's potential liability for the copying done

¹⁹⁴ *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003).

¹⁹⁵ *Parker v. Google, Inc.*, 422 F. Supp. 2d 492, 497 (E.D. Pa. 2006), *aff'd*, 242 F. App'x 833 (3d Cir. 2007) (per curiam).

¹⁹⁶ PATRY, *supra* note 125, § 21:39.

¹⁹⁷ NIMMER & NIMMER, *supra* note 16, § 12B.06[B][2][c][ii] (footnote omitted). Compare Matthew D. Lawless, Comment, *Against Search Engine Volition*, 18 ALB. L.J. SCI. & TECH. 205 (2008) (concluding, as the title implies, that search engines do not act with the requisite volition in creating their searchable databases), with Bashor, *supra* note 61, at 119 ("The best view, however, is to apply the volitional conduct requirement and find it is satisfied by virtue of the back end programming by the search engines. When someone controls a software program, or in this case, a robot, liability should not be lost.").

¹⁹⁸ The web crawlers are programmed, for example, to respond to HTML code used by website owners to indicate that the owner does not want the web crawler to analyze the website, or does not want the search engine to include a cached copy of the site in search results. See, e.g., *Field v. Google Inc.*, 412 F. Supp. 2d 1106, 1112–13 (D. Nev. 2006); Bashor, *supra* note 61, at 108–09.

¹⁹⁹ See Lawless, *supra* note 197, at 222 ("In a world where almost any manual process can be handled automatically, particularly the copying of electronic information, it is inherently problematic to apply only the 'automatic response' element when analyzing volition—otherwise, every would-be-infringer could simply avoid liability by becoming a software developer."); *supra* text accompanying notes 122–32.

to create its database rests solely on its own choices and conduct with respect to the copyrighted material, not on a failure to monitor or police the actions of third parties. Its actions in producing its database are “volitional” as the term should be understood in copyright law.

The second source of potential liability for search engines arises through their interaction with users. Search results typically include a list of links to websites containing a desired search term, usually accompanied by a short excerpt from the site and a cached copy of the site as it existed when copied by the search engine’s robot.²⁰⁰ For image searches, the results include thumbnail images that have been created from the images retrieved by the search engine’s robots and stored on its servers.²⁰¹ The links themselves present no issue of direct infringement since they consist merely of lines of code capable of connecting the user to the host website.²⁰² Even “in-line” links that take the user directly to a full-sized copy of the desired image located on the originating website, and “frame” that image within the search engine’s own website content, do not themselves constitute direct infringement since the image is actually being displayed and distributed by the host site.²⁰³ Although the excerpts that may accompany the links presented in search results are typically too minimal to constitute an infringement,²⁰⁴ the same cannot be said for the cached copies of web pages and the thumbnail images retrieved by users from the search engine’s servers. Two cases have held, however, that a search engine’s automated response to a user’s request for cached copies or thumbnail images lacks the volition necessary for direct liability.²⁰⁵ Here too there is disagreement, with a subsequent case holding that a plaintiff was likely to succeed in its claim that Google’s presentation of thumbnail images in response to users’ search requests constituted prima facie direct infringement, although likely a fair use.²⁰⁶ That result seems more consistent with the purpose of the volition requirement. Although the search process is automated, search engines

²⁰⁰ See, e.g., *Field*, 412 F. Supp. 2d at 1111.

²⁰¹ See, e.g., *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007); *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003).

²⁰² See, e.g., *Perfect 10, Inc. v. Google, Inc.*, 416 F. Supp. 2d 828, 842 (C.D. Cal. 2006) (collecting cases), *rev’d on other grounds sub nom. Perfect 10, Inc.*, 508 F.3d 1146.

²⁰³ *Perfect 10, Inc.*, 508 F.3d at 1159–64.

²⁰⁴ *Cf.*, e.g., *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65 (2d Cir. 1999) (copying the first paragraph of a six-paragraph news story did not produce the “substantial similarity” necessary for infringement).

²⁰⁵ See *Field*, 412 F. Supp. 2d at 1115 (“But when a user requests a Web page contained in the Google cache by clicking on a ‘Cached’ link, it is the user, not Google, who creates and downloads a copy of the cached Web page. . . . The automated, non-volitional conduct by Google in response to a user’s request does not constitute direct infringement under the Copyright Act.”); *Parker v. Google, Inc.*, 422 F. Supp. 2d 492 (E.D. Pa. 2006), *aff’d*, 242 F. App’x 833 (3d Cir. 2007) (per curiam).

²⁰⁶ See *Perfect 10, Inc.*, 508 F.3d at 1159–60, 1163–69.

supply copyrighted works that they have chosen to make available to their users. Since the search engines control the content, there is no need to monitor the choices or conduct of third parties in order to avoid infringement. Like other interactive services offering a library of pre-selected works to customers, the volition requirement should not preclude a prima facie case of direct liability. The conclusion that both the copying that produces a search engine's database and the presentation of results to users are volitional acts sufficient for direct liability shifts the analysis to fair use—an inquiry that is more likely to favor search engines than other interactive services.²⁰⁷

C. Cartoon Network *and the Remote Storage DVR*

The most comprehensive discussion of volition appears in the Second Circuit's opinion in *Cartoon Network v. CSC Holdings*.²⁰⁸ Defendant Cablevision intended to offer a service that allowed customers who did not have a stand-alone digital video recorder to record programming on Cablevision's servers and then play back the shows using a remote control and their home cable box.²⁰⁹ The programming was not sent by the customers to the Cablevision servers. Instead, when a customer requested Cablevision to record a particular program, it was automatically recorded onto a portion of Cablevision's hard drive allocated to that customer simultaneously with the transmission of the cable signal to the customer's home.²¹⁰ The plaintiffs, who owned copyrights in numerous movies and television programs, sued for injunctive relief, arguing that Cablevision directly infringed by reproducing their works on its hard drives and by publicly performing the works when it transmitted the programs to its customers in response to a playback request.²¹¹ The district court granted summary judgment and enjoined the operation of Cablevision's remote storage system.²¹² On appeal, the Second Circuit held that the volition analysis and conclusions in *Netcom* "transcend the Internet" and were equally applicable here to both the reproduction and performance issues.²¹³ As

²⁰⁷ See *id.*; *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003). *But see* Bashor, *supra* note 61, at 120–22 (providing access to cached copies of websites should not be a fair use).

²⁰⁸ 536 F.3d 121 (2d Cir. 2008).

²⁰⁹ *Id.* at 123–24.

²¹⁰ *Id.* at 124–25.

²¹¹ *Id.*

²¹² *Id.* at 125–26.

²¹³ *Id.* at 130–34. The plaintiffs also alleged that the brief storage of programming data by Cablevision on its data buffers prior to any customer request for recording also violated their reproduction rights. The Second Circuit held that because no piece of data resided in the buffer for longer than 1.2 seconds before being automatically overwritten, the data had not been fixed

to the latter, the court found it unnecessary to decide whether the customer or Cablevision performs the copyrighted work during playback since that performance was not “to the public” as required for infringement of the public performance right.²¹⁴ As to the reproductions on Cablevision’s hard drives, the court reiterated that “*Netcom* and its progeny direct our attention to the volitional conduct that causes the copy to be made.”²¹⁵ In support of its conclusion that the program copies were “made” by the customers rather than by Cablevision,²¹⁶ the court offered two analogies: Noting that in the case of a home video cassette recorder, “it seems clear—and we know of no case holding otherwise”²¹⁷—that it is the user and not the manufacturer who makes the copy, Judge Walker wrote that the court does “not believe that an RS–DVR customer is sufficiently distinguishable from a VCR user to impose liability as a direct infringer on a different party for copies that are made automatically upon that customer’s command.”²¹⁸ Later, distinguishing the district court’s reliance on an analogy to a copy shop that makes course packs for college professors, Judge Walker argued:

Here, by selling access to a system that automatically produces copies on command, Cablevision more closely resembles a store proprietor who charges customers to use a photocopier on his premises, and it seems incorrect to say, without more, that such a proprietor ‘makes’ any copies when his machines are actually operated by his customers.²¹⁹

in a tangible medium of expression and thus no “copies” of the plaintiffs’ works had been created by the buffering. *Id.* at 127–30. As a result, it was not necessary for the court to determine whether such pre-request copying by Cablevision satisfied the volition requirement. *Id.* at 130.

²¹⁴ *Id.* at 139 (“Because each RS–DVR playback transmission is made to a single subscriber using a single unique copy produced by that subscriber, we conclude that such transmissions are not performances ‘to the public,’ and therefore do not infringe any exclusive right of public performance.”).

²¹⁵ *Id.* at 131.

²¹⁶ *Id.* at 133 (“[C]opies produced by the RS–DVR system are ‘made’ by the RS–DVR customer, and Cablevision’s contribution to this reproduction by providing the system does not warrant the imposition of direct liability.”).

²¹⁷ *Id.* at 131.

²¹⁸ *Id.* Courts have declined to impose direct liability on the suppliers of in-home DVRs even when they retain some control over the parameters of their customers’ use. *See, e.g.,* Fox Broad. Co. v. Dish Network L.L.C., 747 F.3d 1060 (9th Cir. 2014) (stating that a copyright owner was unlikely to succeed on a claim of direct liability against the supplier of a DVR system despite the supplier’s ability to choose the hours in which a special prime-time copying feature could be used as well as the length of time that the recordings would be retained); *In re AutoHop Litig.*, No. 12 Civ. 4155(LTS)(KNF), 2013 WL 5477495 (S.D.N.Y. Oct. 1, 2013) (holding that there was insufficient proof of a volitional act by the DVR supplier for direct liability).

²¹⁹ *Cartoon Network*, 536 F.3d at 132. Judge Walker disagreed with the result in *Elektra Records Co. v. Gem Electronic Distributors, Inc.*, 360 F. Supp. 821 (E.D.N.Y. 1973), where an electronics retailer was held directly liable for the copying of music tapes done by customers

Both Judge Walker's VCR and photocopier analogies, however, involve instances in which customers introduce copyrighted works that are already in their possession into the owner's copying system. The analogies would be more fully apposite if Cablevision's customers were sending the programs they wished to copy and store from their homes to Cablevision's remote DVR system.²²⁰ Instead, Cablevision, rather than its customers, appears to be supplying the works that are copied and performed by its remote DVR. The competing analogy would thus be a system offering automated but unauthorized streaming or downloading of pre-selected video or music files. In truth, Cablevision's remote DVR system lies between these competing analogies. Unlike the users of a VCR or an unattended photocopier, Cablevision customers do not have prior possession or control of the works and thus they do not themselves introduce the works into the remote DVR. However, unlike unauthorized video-on-demand or music downloading, Cablevision has been licensed by the copyright owners to provide the initial access to the works. The admittedly incomplete analogies to VCRs and photocopiers are more persuasive since the customers—rather than Cablevision—select the content to be copied. It was apparently irrelevant to the court whether the customers made that selection before, after, or simultaneous with their receipt of the authorized transmission of the work.

The Second Circuit's decision to reverse the copyright owners' summary judgment of direct infringement in *Cablevision* seems correct. Cablevision did not pre-select the works that could be copied and performed on its system, nor did it control or confirm through any human decision the choice of works introduced into the system by its customers. Despite the fact that the customers did not yet have physical access to the works when they decided to copy, Cablevision's only option to avoid potential infringement would be to monitor and police the user's choices to copy and perform particular works. The court's insistence on channeling the analysis of Cablevision's liability into the rules governing secondary liability for infringements committed by others²²¹ appears to be justified.²²²

using a machine located on the store's premises. In that case, however, a store employee supplied a copy of the desired music to customers who had purchased blank recording tapes. *Id.* at 823. The decision to participate in the copying of the specific copyrighted work may well justify the imposition of direct liability on both the user and the proprietor, since the proprietor need only monitor its own conduct to avoid such a risk.

²²⁰ The situation would then resemble cloud storage. *See supra* text accompanying notes 176–90.

²²¹ *See Cartoon Network*, 536 F.3d at 132 (“Most of the facts found dispositive by the district court . . . seem to us more relevant to the question of contributory liability.”). The copyright owners in *Cartoon Network*, however, had alleged only direct and not contributory or vicarious liability. *Id.* at 124. Since the copying and playback by Cablevision customers was almost

D. Aereo and Its Tiny Antennae

Aereo delivered broadcast television programming to subscribers over the Internet. When a customer selected a desired program on Aereo's website, the company would dedicate one of its many tiny antennae to that customer and tune it to the broadcast station carrying that show. The data would be stored in a customer-specific folder on Aereo's hard drive and then streamed to the requesting subscriber, but Aereo had no license for the retransmission.²²³ According to the Supreme Court, "[t]his case requires us to answer two questions: First, in operating in the manner described above, does Aereo 'perform' at all? And second, if so, does Aereo do so 'publicly'?"²²⁴ Since the majority ultimately concluded that the transmissions were "to the public,"²²⁵ unlike the Second Circuit in *Cartoon Network*,²²⁶ it could not avoid deciding whether it was the subscriber or the provider who did the performing. The three dissenting justices, led by Justice Scalia,

certainly a fair use, *see Dish Network*, 747 F.3d 1060; *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984), there would be no possibility of secondary liability in any event.

²²² Nimmer and Goldstein, however, both disagree with *Cartoon Network's* analysis of the volition issue. Nimmer finds the district court's determination that Cablevision—rather than the users—was the party who "made" the copies "more compelling than the panel's," although his principal objection is with the continuing application of any volition requirement. NIMMER & NIMMER, *supra* note 16, § 13.08[C]. Professor Goldstein concludes that the court's error "was to assign volition to one actor—the RS-DVR user—when both the cable company and the user were directly implicated in the infringement." GOLDSTEIN, *supra* note 36, § 7.0.2.

²²³ *Am. Broad. Cos. v. Aereo, Inc.*, 134 S. Ct. 2498, 2503 (2014).

²²⁴ *Id.* at 2504.

²²⁵ *Id.* at 2507–11. In its discussion of whether the transmissions were to the public, the majority opinion drew a distinction between "owners or possessors" of works and the general public, "because when an entity performs to a set of people, whether they constitute 'the public' often depends upon their relationship to the underlying work." *Id.* at 2510 ("[A]n entity that transmits a performance to individuals in their capacities as owners or possessors does not perform to 'the public,' whereas an entity like Aereo that transmits to large numbers of paying subscribers who lack any prior relationship to the works does so perform."). Presumably, the possessory interest must be a lawful one derived from sale, license, or a fair use. *See Giblin & Ginsburg, supra* note 16, at 155. Under this analysis the transmissions by Cablevision to its remote DVR users may not be a public performance since those users have a lawful interest in the original licensed transmission of the programming; the subsequent transmission of the stored copy of the program is thus arguably made to the individuals in their capacity as "possessors." A more straightforward example of the distinction may be *Fox Broadcasting Co. v. Dish Network L.L.C.*, No. CV 12–4529 DMG (SHx), 2015 WL 1137593 (C.D. Cal. Jan. 20, 2015), involving the Dish Anywhere service that enabled users to transmit live or recorded television programming from their Dish set-top box over the Internet to their computers and mobile devices. The court held that Dish did not publicly perform the works, noting that it had a license for the initial transmission of the programs to its subscribers. *Id.* at *25. "The ultimate function of Dish Anywhere is to transmit programming that is already legitimately on a user's in-home hardware to a user's Internet-connected mobile device." *Id.* at *12.

²²⁶ *See supra* text accompanying notes 208–22.

concluded that it was the subscriber.²²⁷ The performances were not “the product of Aereo’s volitional conduct” since it did not provide a pre-selected assortment of content.²²⁸ It was the subscriber who chose the shows from whatever broadcasts were available and it was the subscriber who triggered the automated transmission.²²⁹ “In sum, Aereo does not ‘perform’ for the sole and simple reason that it does not make the choice of content.”²³⁰ The majority disagreed in an opinion that did not specifically mention “volition.” It did, however, emphasize that “Aereo is not simply an equipment provider,”²³¹ and that “a user’s involvement in the operation of the provider’s equipment and selection of the content transmitted may well bear on whether the provider performs within the meaning of the Act.”²³² The court’s analysis was cut short by what the majority saw as “Aereo’s overwhelming likeness to the cable companies targeted by the 1976 amendments” to the Copyright Act.²³³ Since cable companies clearly perform under the Copyright Act, so did Aereo.²³⁴ According to at least one subsequent decision, “Aereo did not fundamentally alter the volitional conduct requirement for direct infringement.”²³⁵

Aereo is a difficult case. The company did not directly select the particular works that were transmitted to its customers. Instead, the transmissions were triggered by the customers themselves, who chose the particular programs that they wished to see. Justice Scalia found the situation “akin to a copy shop that provides its patrons with a library card.”²³⁶ That analogy, however, understates the connection between Aereo and the copyrighted works, since it implies that the subscribers are acquiring the works elsewhere and then introducing them into Aereo’s system. Internet search engines are actually a better analogy. Like Aereo, they offer content to their users that they acquire from third-party sources. Their users, like Aereo’s, do not enter any works

²²⁷ *Aereo*, 134 S. Ct. at 2514 (Scalia, J., dissenting).

²²⁸ *Id.*

²²⁹ *Id.*

²³⁰ *Id.*

²³¹ *Id.* at 2506 (majority opinion).

²³² *Id.* at 2507.

²³³ *Id.*; see also *id.* at 2506 (“Aereo’s activities are substantially similar to those of the CATV companies that Congress amended the Act to reach.”); *id.* at 2507 (“[T]he many similarities between Aereo and cable companies, considered in light of Congress’ basic purposes in amending the Copyright Act, convince us that this difference [that Aereo’s system is activated by a subscriber’s request] is not critical here.”).

²³⁴ See *id.* at 2504–07.

²³⁵ *Fox Broad. Co. v. Dish Network L.L.C.*, No. CV 12–4529 DMG (SHx), 2015 WL 1137593 (C.D. Cal. Jan. 20, 2015). The court held that it was the customers and not Dish who performed when the Dish Anywhere feature was used to transmit programs from the customers’ set-top boxes to their computers or mobile devices. *Id.* at *12–14.

²³⁶ *Aereo*, 134 S. Ct. at 2514 (Scalia, J., dissenting).

into the system—their viewing options are limited to the content available on the system. Although the process is automated, search engines display cached websites and thumbnail images that they themselves have chosen to supply to users.²³⁷ They—and Aereo—control the available content, and there is thus no need to monitor and police the conduct of users in order to forestall infringements.²³⁸ Liability for the resulting infringements should be direct, not merely secondary.

CONCLUSION

In the years since its first mention in 1995, “volition” has become an established feature of copyright law despite the grumblings of treatise writers. Created initially as a limitation on the liability of Internet service providers, it is now a generally applicable requirement of direct liability for copyright infringement. Volition in copyright law, however, is much more than an inquiry into the voluntariness of a defendant’s conduct. It is instead an inquiry into whether a defendant has engaged in all of the acts necessary to satisfy the elements of a cause of action for copyright infringement. Volition insures that the owner of a copying system has control not only over the system but also over the act of infringement by demanding a connection between the system owner and the copied work that justifies attributing the copying of that work to the owner. Volition should be understood to require a connection between the system owner and the copyrighted work that is sufficient to permit the owner to control infringements without the necessity of monitoring the behavior of third parties. The doctrine serves a channeling function. When the only means for a system owner to avoid infringement is to monitor and police the conduct of third parties, the owner’s potential liability for any resulting violations should be determined not on the basis of principles governing direct liability, but instead under the rules that determine secondary liability for infringements committed by others.

²³⁷ See *supra* text accompanying notes 200–07.

²³⁸ See *supra* text accompanying notes 205–07. The same argument might be made against Cablevision and its remote DVR, but the initial delivery of the programming in that case was licensed, and subsequent infringements could be prevented only by monitoring and policing the use of those programs by the subscribers.