

**United States Response to  
Questionnaire Concerning Boundaries and Interfaces  
With Respect to Copyright and Related Rights**

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*Authors' Note:* The U.S. Copyright Act is contained in Title 17 of the United States Code and is available on the U.S. Copyright Office website, <<http://www.copyright.gov>>. Statutory references in this response are to Title 17, unless otherwise indicated.

**1. The Subject Matter of Protection – Works**

1.1 *How do your legislators or caselaw define a literary work? In particular, how is speech protected? Is ex tempore speech a literary work and what are the conditions for protection?*

U.S. federal copyright protection attaches only to works of authorship “fixed in a tangible medium of expression.” 17 U.S.C. § 102(a). Unrecorded *ex tempore* speech, musical compositions and dramatic compositions thus fall outside the scope of the statute.<sup>2</sup> Those creations can be the subject matter of state laws against unfair competition, misappropriation, or other torts. The fixation requirement may derive from the constitutional empowerment of Congress to protect the “writings” of “authors”: “writings” may imply that the work must have assumed concrete form as a prerequisite to protection, but no court has in fact yet so held.

1.2 *For short works – headlines in a newspaper, phrases (including slogans), book titles, for example; are these covered by statute? Does case-law provide guidance on protection? Is this issue dealt with by de minimis rules? [In the EU discuss Infopaq and how the case is accommodated in national law].*

Although the Copyright Act does not impose a quantity threshold, both caselaw and Copyright Office practice deny protection to short phrases, book titles, and similarly skimpy expressions. See 37 C.F.R. § 202.1(a) (1999):

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<sup>2</sup> 17 U.S.C. § 1101 protects the rights of performers to authorize the fixation, transmission and distribution of their live musical performances. That protection accrues to the performer and the performance, however, rather than to the work per se.

The following are examples of works not subject to copyright and applications for registration of such works cannot be entertained: (a) Words and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents. . . .

For caselaw examples, see, e.g., *CMM Cable Rep. v. Ocean Coast Props.*, 97 F.3d 1504 (1st Cir. 1996) (short phrases not protectable); *Magic Marketing v. Mailing Serv. of Pittsburgh*, 634 F. Supp. 769 (W.D. Pa. 1986) (same). But see *Swirsky v Carey*, 376 F.3d 841 (9th Cir. 2004) (song's seven-note sequence protectable).

1.3 *How does your legislation define an artistic work? A closed and defined list of works? Open-ended definitions for greater flexibility?*

Section 101 of the Copyright Act defines “pictorial, graphic or sculptural works” to

include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

A “useful article” is defined as

an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a “useful article.”

Thus, the list is not closed, but the “separability” requirement for “useful articles” precludes protection for most works of applied art.

1.4 *Have court decisions provided any rulings on the availability of copyright protection for contemporary forms or types of artistic expression e.g.*

- *surveillance art, installations, collage.*

No decisions were found concerning copyrightability of images taken by security cameras. Decisions protecting collages: see, e.g., *Olde Mill Co. v. Alamo Flag, Inc.*, 2010 U.S. Dist. LEXIS 97179 (E.D. Va. 2010) (“Obama collage,” made up of an image of President Obama surrounded by a number of bumper stickers, slogans, campaign buttons, and other items.); *Primal Lite, Inc. v. Midwest Importers of Cannon Falls*, 1990 U.S. Dist. LEXIS 7785 (N.D. Cal. 1990) (sculptural collage). But see *Inkadinkado, Inc. v. Meyer*, 68 U.S.P.Q.2d (BNA) 1540 (D. Mass. 2003) (collage consisting of elements

taken from the public domain will receive only “thin” copyright protection as a compilation). (Most cases involving collages concern the appropriation of elements from prior works – often photographs – for incorporation into defendant’s collage.)

- *performance art*

To the extent that “performance art” entails unfixed performances, the creations would not be covered by federal copyright law.<sup>3</sup> A recorded performance could be protected as an audiovisual work or as a sound recording.

- *conceptual art*

Given the principle that copyright does not protect ideas (17 U.S.C. § 102(b)), “conceptual art” would seem by its nature (or concept?) to fall outside the scope of protectable subject matter. Nonetheless, judicial decisions appear to accept the possibility of copyright coverage of “conceptual art,” but neither define the term, nor focus on the potential conflict with the principle of non protection of ideas. The cases, however, have concerned specific sculptural works, rather than abstract concepts. See *Poe v. Missing Persons*, 745 F.2d 1238 (9th Cir. 1984) (artist’s representation of a swimsuit was not a “useful article” but a “work of conceptual art” protectable by copyright); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (citing to Prof. Nimmer’s suggestion that Christo’s “Running Fence” was an example of protectable “conceptual art”). On the other hand, in a recent decision whose reasoning may be open to question, the Seventh Circuit Court of Appeals in *Kelly v Chicago Park District* (7<sup>th</sup> Cir. Feb 15, 2011), ruled that a living wildflower display, albeit perhaps a “work of postmodern conceptual art” was not copyrightable because it lacked human authorship and was insufficiently “fixed.” Regarding authorship, the court stated that “natural forces – not the intellect of the gardener – determine the[] form, growth and appearance” of the seedlings that would become the displayed wildflowers. While the court acknowledged that a landscape architect’s plan for a garden could be a copyrightable work of authorship fixed in a tangible medium of expression, the resulting garden is not “fixed” because “it is not stable or permanent enough . . . Seeds and plants in a garden are naturally in a state of perpetual change . . . The essence of a garden is its vitality not its fixedness. It may endure from season to season, but its nature is one of dynamic change.”

- 1.5 *Are there any judicial decisions/academic opinions on other forms of expression, whether protected or not (e.g., perfumes)?*

The caselaw has concerned the copyrightability of the designs of perfume bottles or of photographs of the bottles, not of the scent itself.<sup>4</sup>

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<sup>3</sup> *But see supra* note 2.

<sup>4</sup> See Thomas G. Field, Jr., *Copyright Protection for Perfumes*, 45 IDEA: J.LAW & TECH. 19 (2004), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=573881](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=573881).

- 1.6 *Is there case-law related to the protection of sporting events (soccer game, marathon race, ice skating competition, etc)? What is the basis of the protection? (dramatic or choreographic work, other?)*

While the recorded broadcast of a sporting event is protectable as an audiovisual work (see H.R. Rep. No. 1476, 94<sup>th</sup> Cong, 2d Sess. at 52 (1976)), the event itself is not within the scope of copyright. See, e.g., *National Basketball Assn v Motorola Inc.*, 105 F.3d 841, 856 (2d Cir. 1987). It is possible that some gymnastic displays, such as floor exercises, and figure-skating routines, might be considered choreography. But team sports, such as football and baseball matches, would not be covered. Professor Goldstein has criticized the non recognition of copyright in the “movements of players on the field” as inconsistent with general copyright principles.<sup>5</sup>

## 2. **Creativity – the Originality Standard**

### 2.1 *How does your legislation set out the requisite originality standard?*

The relevant statute, the Copyright Act of 1976, as amended, provides for copyright protection of “original works of authorship fixed in any tangible medium of expression.”<sup>6</sup> The statute, however, neither defines the term “original” nor supplies the applicable originality standard.

That standard has been furnished by case law. In a landmark case from 1991, *Feist Publications, Inc. v. Rural Telephone Service Co.*, the U.S. Supreme Court held that originality is constitutionally required in order for copyright protection to attach to a work. Originality has two elements: first, the work must be independently created by its author, as opposed to having been copied from another work; second, the work must possess “some minimal degree of creativity.”<sup>7</sup>

While this formulation supplies the requisite standard for originality in U.S. law, it leaves open certain questions, such as what creativity consists of and how its presence should be ascertained.<sup>8</sup> Nevertheless, these issues are mitigated by the Supreme Court’s forceful statement that the “requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, no matter how crude, humble or obvious it might be.”<sup>9</sup>

In a handful of cases since *Feist*, however, courts have found works presented to them to be unoriginal on a variety of grounds and, therefore, unprotectable. For example, in a recent case, a court concluded that plain digital wire-frame computer models of cars –

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<sup>5</sup> See PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 2.12.1 (3d ed. 2011).

<sup>6</sup> 17 U.S.C. § 102.

<sup>7</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345-46 (1991).

<sup>8</sup> See, e.g., Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801, 840-43 (1993) (discussing different possible methods of determining originality under *Feist*).

<sup>9</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. at 345 (citation and internal quotation marks omitted). Although the Supreme Court used the term “obvious” in this statement, obviousness does not serve as a benchmark for protection under U.S. copyright law.

unadorned by “lighting, angle, perspective, and other ingredients associated with an original expression” – owed their origin to the defendant-manufacturers’ cars and, accordingly, were insufficiently original.<sup>10</sup> Originality was likewise lacking where the allegation of infringement involved a site plan for development that set forth “the existing physical characteristics of the site” and employed no originality but only “standard cartographic features.”<sup>11</sup> Another court held that coloring a pre-existing census map blue and shading it for three-dimensional effect were insufficiently creative contributions.<sup>12</sup> A few notable originality cases have involved photography. In one case, a court held that photographic transparencies of old masters’ public domain paintings, which reproduced the paintings “as exact[ly] as science and technology permit[ted],” were “slavish copies” and hence not original.<sup>13</sup> And “purely descriptive” photographs that served the “purely utilitarian purpose of displaying examples of [a] product to potential consumers” (in that case, motorcycle accessories) lacked a creative spark.<sup>14</sup>

As is discussed further in response to Questions 2.2, 2.3, and 2.4 below, originality is also highly relevant to the scope of protection a work receives. So, for example, where a plaintiff’s glass jellyfish sculpture was largely based on the physical features of actual jellyfish and the technical aspects of the glass-in-glass medium, the court made clear that copyright would protect against “only virtually identical copying.”<sup>15</sup>

## 2.2 *Does the legislation or case-law suggest a different test of originality is imposed for different kinds of work?*

As a general matter, the legislation and case law do not explicitly provide for a variable test of originality that depends on the type of work under consideration. The requirements described in response to Question 2.1 above, namely, independent creation and a modicum of creativity, apply across the board to all works. Nevertheless, certain refinements in the application of originality – both with respect to the means of assessing originality and the scope of protection – should be noted with respect to two categories of works, derivative works and compilations.

First is the category of derivative works. A derivative work is defined as “a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other

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<sup>10</sup> Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc., 528 F.3d 1258, 1265-66 (10th Cir. 2008) (internal quotation marks omitted).

<sup>11</sup> Sparaco v. Lawler, Matusky, Skelly, Eng’rs LLP, 303 F.3d 460, 467 (2d Cir. 2002).

<sup>12</sup> Darden v. Peters, 488 F.3d 277, 287 (4th Cir. 2007); *see also* 37 C.F.R. § 202.1(a) (proscribing the award of copyright for “mere variations of . . . coloring”).

<sup>13</sup> Bridgeman Art Library, Ltd. v. Corel Corp., 25 F. Supp. 2d 421, 427 (S.D.N.Y. 1998), *aff’d on reh’g*, 36 F. Supp. 2d 191, 196-97 (S.D.N.Y. 1999).

<sup>14</sup> Custom Dynamics, LLC v. Radiantz LED Lighting, Inc., 535 F. Supp. 2d 542, 549 (E.D.N.C. 2008).

<sup>15</sup> Satava v. Lowry, 323 F.3d 805, 812 (9<sup>th</sup> Cir. 2003).

modifications which, as a whole, represent an original work of authorship, is a ‘derivative work.’”<sup>16</sup>

Derivative works pose a special problem in copyright law, as courts are compelled to determine whether a work that is based on an earlier work possesses enough original contributions of its own to merit copyright protection. Any such original contributions of the derivative work are all that may be protected under its copyright.<sup>17</sup> Accordingly, the courts have developed a comparative test that examines whether the derivative work reflects nontrivial or distinguishable variations from the underlying work.<sup>18</sup> At one point, courts appeared to require that a derivative work manifest more originality than the underlying work.<sup>19</sup> The higher standard was thought necessary to ensure that any protection for the derivative work remain distinct from that for the underlying work.<sup>20</sup> More recently, however, courts have declined to apply a higher standard of originality for derivative works.<sup>21</sup>

Second is the category of compilations. A compilation is defined as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term ‘compilation’ includes collective works.”<sup>22</sup>

Although compilations may be based on copyrightable or non-copyrightable pre-existing material,<sup>23</sup> compilations raise issues similar to those discussed in connection with derivative works. Thus, courts are asked to make similar determinations about what copyrightable contributions a compiler has made to the underlying subject matter. The statutory language, quoted in the foregoing paragraph, directs courts to focus on selection, coordination, or arrangement decisions that might permit even a large amount of non-copyrightable material to comprise a work subject to copyright. These works are discussed further in response to Questions 2.3 and 2.4.

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<sup>16</sup> 17 U.S.C. § 101.

<sup>17</sup> See 17 U.S.C. § 103(b):

The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

<sup>18</sup> See, e.g., *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 520-21 (7<sup>th</sup> Cir. 2009) (citing cases).

<sup>19</sup> See, e.g., *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7<sup>th</sup> Cir. 1983) (requiring an “assur[ance of] a sufficiently gross difference between the underlying and the derivative work” and that a “derivative work must be substantially different from the underlying work to be copyrightable”).

<sup>20</sup> See, e.g., *Gracen v. Bradford Exch.*, 698 F.2d at 304-05.

<sup>21</sup> See, e.g., *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d at 521 (rejecting any heightened standard under *Gracen* for derivative work protection); *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d at 1266 n.7 (10<sup>th</sup> Cir. 2008) (calling for single standard for originality).

<sup>22</sup> 17 U.S.C. § 101. A “collective work” is “a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.” *Id.*

<sup>23</sup> See, e.g., 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 3.02 (2010).

- 2.3 *For compilations/collections is the standard identical to that provided for in relation to works? [For common law jurisdictions there are significant differences on the standard e.g. IceTV (Aust) CCH (Canada). How has “sweat of the brow” been treated in recent case-law?]*

The standard of originality that applies to compilations and collections is not different from that applicable to other works, although the statutory language (see response to Question 2.2 above) prescribes a focus on selection, coordination, and arrangement in determining whether a compilation as a whole is original. Furthermore, as will be discussed in response to Question 2.4 below, the scope of protection for a compilation varies, and the copyright in a factual compilation is said to be “thin.”<sup>24</sup> “Sweat of the brow” has been explicitly rejected as a test for copyright protection.<sup>25</sup>

- 2.4 *Does your legislation/case law recognise copyright protection for collections such as television listings, yellow pages/white pages telephone directories? If yes, what is protected (headings, content, or both?) If not, why is protection denied (e.g. spin-off theory, competition law considerations).*

The copyright statute provides copyright protection for compilations and collective works,<sup>26</sup> and case law furnishes the nature and scope of that protection. In the *Feist* case, the U.S. Supreme Court rejected copyright protection for an alphabetized directory of white page listings.<sup>27</sup> The Court in that case examined two possible subjects of protection: the listings themselves (that is, the content), and the selection, coordination, and arrangement of the listings. With respect to the former, it concluded that the names, towns, and telephone numbers that comprised the listings were facts and, as such, were not original or copyrightable. The Court also held that the selection, coordination, and arrangement of the listings were unoriginal, since the selection of which subscriber information to include in the listings (names, etc.), as well as their coordination and arrangement according to alphabetical order, were “most basic” and “inevitable.”<sup>28</sup>

Accordingly, the existence and extent of protection for collections and directories depends on the application of these principles to the particular work under consideration, as a result of which there is some variation across the board. Nevertheless, a few operating principles may be stated. To the extent that the content of such a work is factual in nature or is the product of automated or randomized – rather than authored – processes, such content is less likely to be protected. So, for example, yellow page listings that reflected how subscribers categorized their businesses were unprotectable

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<sup>24</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. at 349.

<sup>25</sup> *Id.* at 354-61.

<sup>26</sup> See 17 U.S.C. §§ 101-103 (providing for copyright protection for “collective works” and “compilations”). For definitions of these terms, see response to Question 2.2 above.

<sup>27</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340.

<sup>28</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. at 345-47, 361-63. The Court also noted that the selection of which categories of subscriber information to publish was dictated by state law and, for that reason, may also have failed the originality bar. *Id.* at 363.

facts.<sup>29</sup> Likewise, serial numbers for hardware parts were not protected because the numbers were “rigidly dictated by the rules” of the plaintiff’s numbering system and not the product of creativity.<sup>30</sup>

On the other hand, where the content can be characterized as predictions or valuations, then the content may be protected. So, for example, the following have been protected: used car valuations, where the valuations were the predictions of the compilation’s editors rather than mechanically derived from historical fact;<sup>31</sup> long and short descriptions of dental procedures that were the product of creative classification;<sup>32</sup> and prices listed in a wholesale coin price guide, where the prices were the product of “creativity and judgment” and represented the plaintiff’s “best estimate of the value of the coins.”<sup>33</sup>

Regardless of whether the individual listings themselves are original, if originality in the selection, coordination, or arrangement of the listings can be distilled, then the work as a whole may be protected. So, for example, a yellow pages directory was protected where the selection of businesses to be included required judgment about which would be of greatest interest to the Chinese-American community, and the arrangement included categories not found in an ordinary yellow pages directory (such as bean curd shops).<sup>34</sup> A guide to used car valuations was protected on the grounds of original selection and arrangement, such as the “division of the national used car market into several regions, with independent predicted valuations for each region depending on conditions there found.”<sup>35</sup> A guide to baseball cards was protected based on the creative selection involved in choosing the 5000 (out of 18,000) premium cards,<sup>36</sup> and a baseball pitching

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<sup>29</sup> *BellSouth Adver. & Publ’g Corp. v. Donnelley Info. Publ’g, Inc.*, 999 F.2d 1436, 1441 (11<sup>th</sup> Cir. 1993) (en banc).

<sup>30</sup> *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 282 (3d Cir. 2004) (en banc). The part numbers were also rejected on the ground that they were short phrases, subject matter for which copyright protection has historically been denied. *Id.* at 285; *see also* *ATC Distrib. Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 709 (6<sup>th</sup> Cir. 2005) (same).

<sup>31</sup> *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 67-68 & n.8 (2d Cir. 1994). A later decision of the same court noted that the protection of the individual valuations in *CCC Info. Servs.* was arguably dicta, since the compilation as a whole was protected, but it did not overrule the point. *See* *N.Y. Mercantile Exch., Inc. v. IntercontinentalExchange, Inc.*, 497 F.3d 109, 115 n.5 (2d Cir. 2007).

<sup>32</sup> *Am. Dental Ass’n v. Delta Dental Plans Ass’n*, 126 F.3d 977, 979 (7<sup>th</sup> Cir. 1997). The court noted that use of the taxonomy’s nomenclature as a system for filling in blank dental forms would be permitted under the copyright law, *see* 17 U.S.C. § 102(b), but that copying the taxonomy itself would not. *Am. Dental Ass’n*, 126 F.3d at 981.

<sup>33</sup> *CDN Inc. v. Kapes*, 197 F.3d 1256, 1260 (9<sup>th</sup> Cir. 1999).

<sup>34</sup> *Key Publ’ns, Inc. v. Chinatown Today Publ’g Enters., Inc.*, 945 F.2d 509, 513-14 (2d Cir. 1991). The Supreme Court itself indicated its approval of protection for a phone directory as a whole, premised in part on original content found in yellow page advertisements. *See* *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. at 361.

<sup>35</sup> *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d at 67. The court noted, as further original contributions, the following: “(1) the selection and manner of presentation of optional features for inclusion; (2) the adjustment for mileage by 5,000 mile increments (as opposed to using some other breakpoint and interval); (3) the use of the abstract concept of the “average” vehicle in each category as the subject of the valuation; and (4) the selection of the number of years’ models to be included in the compilation.” *Id.* (footnote omitted).

<sup>36</sup> *Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984).

form was protected on the basis of the selection of nine statistical categories.<sup>37</sup> In addition, a taxonomy of dental procedures, as a way of “*describing* items in a body of knowledge or practice,” was protected against copying.<sup>38</sup>

It is important to underscore, however, that protection of the work as a whole based on original selection, coordination, or arrangement of the underlying content in no way creates protection for that content.<sup>39</sup> Accordingly, such content – if it is purely factual, for example, and not itself subject to copyright – may be freely extracted from its copyrightable context and copied by a subsequent work as long as the original selection, coordination, or arrangement in the earlier work has not been copied.<sup>40</sup>

Not every selection, coordination, or arrangement decision will give rise to an original and protectable compilation. Where these decisions are “a matter of convention and strict industry standards,” such as the inclusion of facts about real property included in a title commitment document<sup>41</sup> or of parallel citations for cases included within a judicial opinion,<sup>42</sup> the work is unlikely to be protected on those grounds. This is also the case where the selection, coordination, or arrangement is made according to a garden-variety principle of decision-making<sup>43</sup> or where the only objective is to include “the entire relevant universe” of information about a topic.<sup>44</sup> Heading structure, to the extent highly commonplace or reflective of industry practices, such as yellow page headings for “Attorneys” or “Banks,” will not be protected.<sup>45</sup>

The main goal with respect to the protection of compilations is to provide enough of an incentive so that people will undertake to create valuable and educational compilations of public domain materials and yet, at the same time, ensure that second-comers are not restricted from building upon those materials. Accordingly, where protection is denied, the reasoning is largely grounded in competition theory. Thus, “a subsequent compiler remains free to use the facts contained in another’s publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement.”<sup>46</sup> (It is important to note, however, that where only one or an extremely limited number of ways of selecting, coordinating, or arranging the underlying material is

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<sup>37</sup> *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991).

<sup>38</sup> *Am. Dental Ass’n v. Delta Dental Plans Ass’n*, 126 F.3d at 980.

<sup>39</sup> *See* 17 U.S.C. § 103(b).

<sup>40</sup> *See, e.g., Key Publ’ns, Inc. v. Chinatown Today Publ’g Enters., Inc.*, 945 F.2d at 515-16.

<sup>41</sup> *See, e.g., Mid Am. Title Co. v. Kirk*, 59 F.3d 719, 722 (7<sup>th</sup> Cir. 1995).

<sup>42</sup> *Matthew Bender & Co. v. West Publ’g Co.*, 158 F.3d 674, 685 (2d Cir. 1998).

<sup>43</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. at 362; *ATC Distrib. Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d at 711-12 (arrangement according to headings reflected insufficient originality); *Matthew Bender & Co. v. West Publ’g Co.*, 158 F.3d at 683 (determining that reference to a case according to the litigants’ names was garden-variety and not protectable); *BellSouth Adver. & Publ’g Corp. v. Donnelley Info. Publ’g, Inc.*, 999 F.2d at 1442 (alphabetized listings not protectable arrangement).

<sup>44</sup> *Warren Publ’g, Inc. v. Microdos Data Corp.*, 115 F.3d 1509, 1518 (11<sup>th</sup> Cir. 1997) (en banc).

<sup>45</sup> *BellSouth Adver. & Publ’g Corp. v. Donnelley Info. Publ’g, Inc.*, 999 F.2d at 1444.

<sup>46</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. at 349; *see also Southco, Inc. v. Kanebridge Corp.*, 390 F.3d at 286 (expressing concern that numerical sequences would be locked up by first-comers); *Matthew Bender & Co. v. West Publ’g Co.*, 158 F.3d at 687-88 (expressing concerns about competition).

possible, then even those contributions may be denied protection on the ground of merger. Merger exists where there is only one or so few ways of expressing an idea that protecting the expression would also impermissibly protect the idea.<sup>47)</sup>

### 3. Achieving Access for the visually impaired

3.1 *Does your national legislation provide exceptions or limitations in favour of the visually impaired? For wider categories of disabled persons? On what condition: is there a remuneration right or right to compensation?*

Section 121 of the U.S. Copyright Act provides limitations in favor of the visually impaired and wider categories of disabled persons.<sup>48</sup>

For the benefit of “blind or other persons with disabilities,” the portion of the statute commonly referred to as the Chafee Amendment, sections 121(a)-(b), (d), limits the exclusive reproduction and distribution rights provided by section 106 of the Act, stating that “it is not an infringement of copyright for an authorized entity to reproduce or distribute copies or phonorecords of a previously published, nondramatic literary work if such copies or phonorecords are reproduced or distributed in specialized formats exclusively for use by blind or other persons with disabilities.”<sup>49</sup> The persons covered under the exception are defined, in reference to previous legislation, as “blind and . . . other physically handicapped readers certified by competent authority as unable to read normal printed material as a result of physical limitations.”<sup>50</sup> The exception is not conditioned on remuneration or compensation to the copyright holder.<sup>51</sup> However, there is a requirement that any copies or phonorecords made under the exception “bear a notice that any further reproduction or distribution in a format other than a specialized format is an infringement” and “include a copyright notice identifying the copyright owner and date of the original publication.”<sup>52</sup>

Section 121 also codifies a portion of the Individuals with Disabilities Education Improvement Act of 2004 (IDEIA) that provides a further, more limited exception designed to facilitate the publication of “print instructional materials for use in elementary or secondary schools” in specialized formats.<sup>53</sup> Print instructional materials are defined, in reference to the Individuals with Disabilities Education Act, as “printed textbooks and related printed core materials that are written and published primarily for use in elementary school and secondary school instruction and are required by a State educational agency or local educational agency for use by students in the classroom.”<sup>54</sup>

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<sup>47</sup> See, e.g., Warren Publ’g, Inc. v. Microdos Data Corp., 115 F.3d at 1518 n.27.

<sup>48</sup> 17 U.S.C. §121 (2006).

<sup>49</sup> *Id.* §121(a).

<sup>50</sup> 2 U.S.C. § 135a; 17 U.S.C. §§ 121(a), (d)(2).

<sup>51</sup> 17 U.S.C. §§ 121(a)–(b).

<sup>52</sup> *Id.* § 121(b).

<sup>53</sup> S. REP. NO. 108-85, at 19 (2003); Individuals with Disabilities Education Improvement Act of 2004, Pub. L. No. 108-446, § 306, 118 Stat. 2647, 2807 (codified at 17 U.S.C. §§ 121(c)–(d)).

<sup>54</sup> 17 U.S.C. §121(d)(3); Individuals with Disabilities Education Act § 674(e)(3), 20 U.S.C. §1474(e)(3)(c).

Notwithstanding the exclusive rights provided by section 106, it provides that publishers who already have the right to publish such print instructional materials in print formats may make certain kinds of electronic files for those materials available to the National Instructional Materials Access Center, so long as state or local educational agencies require such materials to be included and the copies are only used to reproduce or distribute the materials in specialized formats.<sup>55</sup>

3.2 *What kind of works are or would be subject to limitations or exceptions? Literary works only? Works and performances fixed in sound recording? Will the visually impaired or other beneficiaries of the exceptions or limitations obtain copies of covered works directly, or only via libraries or other institutions?*

The exception provided by the Chafee Amendment applies only to previously published, nondramatic literary works.<sup>56</sup> Additionally, it does not cover “standardized, secure, or norm-referenced tests or related testing material” or parts of computer programs that are not “in conventional human language (including descriptions of pictorial works) and displayed to users in the ordinary course of using the computer programs.”<sup>57</sup> The copies or phonorecords reproduced or distributed under the exception must be in a “specialized format exclusively for use by blind or other persons with disabilities.”<sup>58</sup> In the context of the Chafee Amendment, the statute defines such formats as “Braille, audio, or digital text which is exclusively for use by blind or other persons with disabilities.”<sup>59</sup> The further exception instituted by IDEIA for elementary and secondary school print instructional materials also includes under the definition “large print formats when such materials are distributed exclusively for use by blind or other persons with disabilities,” but large print formats are not included under the more wide-ranging Chafee Amendment.<sup>60</sup>

The reproduction and distribution allowed by the Chafee Amendment may only be undertaken by “an authorized entity,” defined by the statute as “a nonprofit organization or a governmental agency that has a primary mission to provide specialized services relating to training, education, or adaptive reading or information access needs of blind or other persons with disabilities.”<sup>61</sup> The further exception instituted by IDEIA allows for distribution of electronic files by publishers of elementary and secondary school print instructional materials only to the National Instructional Materials Access Center.<sup>62</sup>

3.3 *Are the exceptions and limitations confined to the reproduction of the work? If making available or adaptation is possible, on what conditions?*

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<sup>55</sup> 17 U.S.C. § 121(c).

<sup>56</sup> *Id.* § 121(a).

<sup>57</sup> *Id.* § 121(b)(2).

<sup>58</sup> *Id.* §§ 121(a), (b)(1)(a).

<sup>59</sup> *Id.* § 121(d)(4)(A).

<sup>60</sup> *Id.* § 121(d)(4)(B).

<sup>61</sup> *Id.* §§ 121(a), (d)(1).

<sup>62</sup> *Id.* § 121(c).

The exceptions and limitations are confined to reproduction and distribution of the work.<sup>63</sup>

3.4 *Has your Government expressed a view on support for international initiatives (e.g. World Blind Council Treaty)?*

The United States expressed support for international initiatives in a statement delivered to WIPO on December 15, 2009 in the context of discussions prompted by the treaty proposed by the World Blind Union.<sup>64</sup> In that statement, the United States indicated that it was engaged in studying the problems encountered by persons with print disabilities and the possibilities for increasing their access to copyrighted works.<sup>65</sup> Professing a commitment to “policies that ensure everyone has a chance to get the information and education they need and to live independently as full citizens in their countries,” it expressed a belief that “the time has come for WIPO Members to work toward some form of international consensus on basic, necessary limitations and exceptions in copyright law for persons with print disabilities.”<sup>66</sup> It acknowledged that such consensus could take multiple possible forms, “including a model law endorsed by the SCCR, a detailed Joint Recommendation to be adopted by the WIPO General Assemblies, and/or a multilateral treaty,” and that it was open to all of these options.<sup>67</sup>

However, the United States expressed a preference for an initial Joint Recommendation that might serve as “a step toward the development of a treaty establishing basic copyright limitations and exceptions for persons with print disabilities.”<sup>68</sup> It also identified “cross-border distribution of special format materials made for persons with print disabilities” as the “most pressing problem” and asserted that the “first goal should be to reach international consensus on the free exportation and importation” among all countries of such special format materials.<sup>69</sup> It posited as two possible, but not exclusive, solutions to this problem “the establishment of a properly-limited international rule of exhaustion in relation to special format copies made under existing national law exceptions for persons with print disabilities” and “an international legal norm that trusted intermediaries and non-profit organizations working for persons with print disabilities must be able to exchange special format copies without fear that copyright law bars such activities.”<sup>70</sup>

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<sup>63</sup> *Id.* § 121.

<sup>64</sup> United States Delegation to WIPO, *Statement on Copyright Exceptions and Limitations for Persons with Print Disabilities*, U.S. COPYRIGHT OFFICE (Dec. 15, 2009), <http://www.copyright.gov/docs/sccr/statement/us-intervention12-15-09.pdf>.

<sup>65</sup> *Id.* at 3.

<sup>66</sup> *Id.* at 1, 3.

<sup>67</sup> *Id.* at 3.

<sup>68</sup> *Id.* at 4.

<sup>69</sup> *Id.*

<sup>70</sup> *Id.*

Noting that further international consensus on specific limitations and exceptions is likely to take longer to achieve than consensus on this one area, it set out some guidelines for the larger project.<sup>71</sup> These include acknowledging the diversity of national laws and successful exceptions, ensuring flexibility for countries in crafting their own exceptions and limitations to meet changing conditions, acknowledging the role of market practices and that “mandatory exceptions are most needed to address market failures,” and constructing any exceptions within the framework of existing international copyright treaties.<sup>72</sup>

The United States went a step further at the Twentieth Session of the SCCR in June 2010, putting forward a Draft Consensus Instrument addressing the cross-border distribution problem.<sup>73</sup> The proposed Instrument is restricted to special formats, and it covers only persons with print disabilities.<sup>74</sup> It elucidates how exportation and importation of “special format copies” of published works “for persons with print disabilities” should be allowed.<sup>75</sup> For physical Braille format copies made under exceptions or limitations of the country’s copyright law, no permission would be required for exportation.<sup>76</sup> The same would be true of any other special format copy, but only if exportation is made to a “trusted intermediary.”<sup>77</sup> The proposed Instrument provides a detailed definition of “trusted intermediaries,” which will, *inter alia*, establish policies to determine the eligibility of users.<sup>78</sup> It also allows for countries to limit the exportation provision “to published works which, in the applicable special format, cannot be otherwise obtained in the country of importation within a reasonable time and at a reasonable price.”<sup>79</sup> The provision on importation is a mirror of the exportation provision.<sup>80</sup> While the Instrument is much more limited than the expansive treaty proposed by the African Group, in drafting its definitions the United States “borrowed heavily from the World Blind Union draft treaty and the national laws of many countries.”<sup>81</sup>

3.5 *On an extra-legal basis, are there any market initiatives, or business practices, that your national group are aware of?*

One of the primary extra-legal initiatives in this area is the work being done in large part by the DAISY Consortium to establish global technical standards for files that allow access by visually impaired persons with aim of achieving interoperability of these

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<sup>71</sup> *Id.* at 5.

<sup>72</sup> *Id.*

<sup>73</sup> Proposal by the Delegation of the United States of America, *Draft Consensus Instrument*, SCCR/20/10 (June 10, 2010).

<sup>74</sup> *Id.* art. 1.

<sup>75</sup> *Id.* arts. 2–3.

<sup>76</sup> *Id.* art. 2(A).

<sup>77</sup> *Id.* art. 2(B).

<sup>78</sup> *Id.* art. 1.

<sup>79</sup> *Id.* art. 2.

<sup>80</sup> *Id.* art. 3.

<sup>81</sup> WIPO Standing Committee on Copyright and Related Rights, *Draft Report*, SCCR/20/13 Prov., ¶ 112 (August 6, 2010).

formats and increased access.<sup>82</sup> The WIPO Stakeholder's Platform has also been acknowledged by the United States as playing a role in facilitating access for blind and other persons with disabilities.<sup>83</sup> While the Stakeholder's Platform is also studying technological solutions, its most prominent project currently concerns trusted intermediaries.

A collaborative effort between the private sector and public interest organizations, the Trusted Intermediary Global Accessible Resources (TIGAR) project “will enable publishers to make their titles easily available to trusted intermediaries,” which “will create accessible formats and share them amongst each other and with specialized libraries” and allow persons with print disabilities “to search for content across distributed networks.”<sup>84</sup> In remarks at a meeting held by the U.S. Copyright Office and U.S. Patent and Trademark Office, a representative of the Association of American Publishers also pointed out that the evolution of digital file formats for persons with print disabilities and those for the general market appear to be converging to the point where the same format may be attractive to both regular consumers and persons with print disabilities, creating the possibility of “a legitimate, viable market for accessible books to be produced in the first instance.”<sup>85</sup>

#### 4. **Access to the Internet as a Human Right**

##### 4.1 *Does your legislation/constitution/case-law define access to the Internet as a specific [or human] right?*

There is no U.S. constitutional provision, statute or case or declaring Internet access a human right. In fact, sections 512(j)(1)(A)(ii) and (B)(i) of the Copyright Act allow a copyright holder to seek an injunction ordering a service provider to terminate the

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<sup>82</sup> See Copyright Office Notice of Inquiry and Request for Comments on the Topic of Facilitating Access to Copyrighted Works for the Blind or Other Persons with Disabilities, 74 Fed. Reg. 52,507, 52,508-09 (Oct. 13, 2009); COMMENT OF GEORGE KERSCHER/DAISY CONSORTIUM (Apr. 28, 2009), <http://www.copyright.gov/docs/sccr/comments/2009/kersch.pdf>; *About Us*, DAISY CONSORTIUM, [http://www.daisy.org/about\\_us](http://www.daisy.org/about_us) (last visited Jan. 26, 2011).

<sup>83</sup> Copyright Office Notice of Inquiry and Request for Comments on the Topic of Facilitating Access to Copyrighted Works for the Blind or Other Persons with Disabilities, 74 Fed. Reg. at 52,509. The Stakeholders' Platform was established at the invitation of the WIPO Secretariat, which “invited various stakeholders representing copyright rightholders’ and [visually impaired persons’] interests to participate in a number of meetings, with the aim of exploring the concrete needs, concerns and suggested approaches to achieving the goal of facilitating access to works in alternative formats for people with disabilities.” *Stakeholders*, WIPO VISION IP, <http://visionip.org/stakeholders/en/> (last visited Dec. 23, 2010).

<sup>84</sup> Stakeholders' Platform Launches Project to Facilitate Access by VIPs to Published Works, PR/2010/668 (Oct. 23, 2010), *available at* [http://www.wipo.int/pressroom/en/articles/2010/article\\_0043.html](http://www.wipo.int/pressroom/en/articles/2010/article_0043.html).

<sup>85</sup> U.S. COPYRIGHT OFFICE & U.S. PATENT AND TRADEMARK OFFICE, PUBLIC MEETING: FACILITATING ACCESS TO COPYRIGHTED WORKS FOR THE BLIND OR OTHER PERSONS WITH DISABILITIES (May 18, 2009), *available at* <http://www.copyright.gov/docs/sccr/transcripts/scr5-18-09.pdf> (statement of Allan Adler, Association of American Publishers). A software trade association expressed a similar view in a Comment to the U.S. Copyright Office. COMMENT OF THE SOFTWARE & INFORMATION INDUSTRY ASSOCIATION (Nov. 13, 2009), <http://www.copyright.gov/docs/sccr/comments/2009/comments-2/keith-kupferschmid-software-information-industry-association.pdf>.

account of a copyright infringer (though these provisions do not speak to the complete termination of Internet access).

However, courts have also acknowledged the importance of Internet access to the free speech guarantees in the First Amendment to the U.S. Constitution. One of the first such judicial acknowledgements was in *ACLU v. Reno*,<sup>86</sup> a case that held that provisions of the Communications Decency Act prohibiting transmission of obscene or indecent communications via telecommunications devices to minors were overbroad content-based restrictions on speech, and thus violated the First Amendment. In its opinion, the district court cited the important role of the Internet in spreading information and political speech.<sup>87</sup>

For this reason, courts are reluctant to impose broad governmental restrictions on Internet access. They have most frequently addressed this issue in the context of convicted child pornographers who have been released from prison and whose post-release conditions include broad restrictions on Internet access.<sup>88</sup>

4.2 *Are there any specific restrictions or limitations on this right [Europe: it is not necessary to refer to ECHR but any national decisions or rulings on ECHR should be mentioned]?*

Not applicable. See the response to Question 4.1, above.

## 5. Orphan Works

5.1 *Are there extant legislative provisions allowing access/use in relation to orphan works? What kinds of work are involved? Performances?*

There is currently no legislative provision in U.S. law that specifically addresses the problems created by orphan works. There are, however, sections of the Copyright Act that can reduce the risk for users of orphan works. For example:

Section 108(h) permits libraries, archives and nonprofit educational institutions to use (i.e., reproduce, distribute, display or perform) copyrighted works that are in the last twenty years of their copyright protection. This exception applies only to works that are no longer being exploited commercially and that cannot be obtained at a reasonable price.

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<sup>86</sup> 929 F. Supp. 824 (E.D. Pa. 1996), *aff'd*, 521 U.S. 844 (1997)

<sup>87</sup> 929 F. Supp. at 877-878.

<sup>88</sup> *See, e.g.*, U.S. v. Scott, 316 F.3d 733 (7th Cir. 2003) (rejecting a supervised release condition of no Internet access without prior permission from probation officer as overbroad and insufficiently tailored to the defendant's offense, given the important speech interests at stake); U.S. v. Sofsky, 287 F.3d 122 (2d Cir. 2002) (rejecting as too broad a categorical ban on Internet and computer access without probation officer's approval); U.S. v. Peterson, 248 F.3d 79 (2d Cir. 2001) (rejecting ban on purchase, possession or use of computer with Internet access by defendant as overbroad); U.S. v. White, 244 F.3d 1199 (10th Cir. 2001) (remanding for clarification of scope a lower court's prohibition on defendant's possession of computer with Internet access during post-release supervision period).

Copyright owners can provide notice to the Copyright Office that the work is available commercially for a reasonable price, in which case the exception does not apply.

Section 115 of the Copyright Act provides a statutory license for making phonorecords of nondramatic musical compositions. Once a phonorecord of a nondramatic musical work has been released in the United States with the authority of the copyright owner, any person who wishes to make a phonorecord of the same musical work to distribute to the public for private use may do so, provided he complies with the terms of the statutory license. One of the requirements is that prospective users notify the copyright owner of their intent to seek a license, but if the owner is not identifiable, it is sufficient to file a notice of intent to use with the Copyright Office. (Most users do not use the statutory license but instead contract directly with music publishers or their representatives, but the statutory license does provide a mechanism for moving forward if the copyright owner cannot be located.)

Under section 504(c)(2) of the Copyright Act, statutory damages may be mitigated in some cases where the court finds the infringement was not willful. Where the infringer proves he or she was not aware and had no reason to believe that his or her acts constituted an infringement of copyright, the court in its discretion may reduce the award of statutory damages to a sum of not less than \$200. Furthermore, the statute directs the courts to waive statutory damages in any case where an infringer believed and had reasonable grounds for believing that his or her use of the copyrighted work was a fair use under section 107 of the Act, provided the infringer is: (i) an employee or agent of a nonprofit educational institution, library, or archives acting within the scope of his or her employment, or the institution itself, that infringed by reproducing the work in copies or phonorecords; or (ii) a public broadcasting entity which, or a person who, as a regular part of the nonprofit activities of a public broadcasting entity, infringed by performing a published nondramatic literary work or by reproducing a transmission program embodying a performance of such a work.

5.2 *On what conditions? Is there a remuneration right or right to compensation? Is there a court or administrative procedure to be satisfied prior to use?*

See the response to Question 5.1.

5.3 *Are there proposals for the introduction of, or changes to, orphan works provisions?*

In 2006, two different bills concerning orphan works were introduced in the U.S. Congress, but neither passed. In 2008, re-drafted bills were introduced in both chambers of Congress, S. 2913 (The Shawn Bentley Orphan Works Act of 2008) and H.R. 5889 (The Orphan Works Act of 2008). The Senate passed its version of the bill, but the House of Representatives failed to vote on its version, so the bill did not become law.

Despite the fact that these bills did not become law, it is likely that they will be reintroduced (perhaps in modified form) in the future. Below is a description of their salient points.

The House and Senate versions of the bill were similar in many respects. Potential users would have to perform a “qualifying search” in good faith to find the copyright owner. A “qualifying search” is defined as one that entails diligent searching “reasonable and appropriate under the facts relevant to that search.”<sup>89</sup> The Register of Copyrights was directed to develop recommended practices for conducting and documenting searches for different categories of works, which must be followed for a search to qualify.

Both bills envisioned the creation of an electronic database to facilitate the search for pictorial, graphic and sculptural works, which would contain the name of all authors of a work, the name of the copyright owner (if different), the title of the work, a picture of the work and a way to search the database by both text and image, and security measures to protect against unauthorized access.

The bills provided that if a user followed the requirements, the owner of an infringed work who later came forward could receive only “reasonable compensation” for the use of the work. If the infringer were a nonprofit educational institution, library or archives or a public broadcasting entity which (i) used the work without any purpose of direct or indirect commercial advantage, and (ii) ceased using the work after receiving notice of the claim for infringement and investigating that claim for its veracity, no compensation was due. Courts would have the power to enjoin further use of the work if the copyright owner came forward. However, if the infringer had prepared or commenced preparation of a work that transformed or integrated an infringed work, no injunction against continued use of that new work could be issued. However, the infringer would be required to pay reasonable compensation for use of the first work and ascribe credit to the author if he or she desires.

There were also some differences between the bills. Most notably, the House bill mandated that the Register of Copyrights create a Notice of Use registry. Any person wishing to use an orphan work would be required to submit a notice indicating the type of work being used; a description of the work being used; a summary of the search conducted to date; any identifying elements that the user found regarding the work (such as title, recognized author or current owner); a certified statement that the user has performed a qualifying search in good faith; and the name of the user and a description of how the work will be used. Copyright owners could, therefore, search this database to see if their works were being exploited without their knowledge. The House bill also exempted from the protections of the bill infringing uses that were part of a useful object offered for sale or other distribution to public. The Senate bill did not contain such a provision.

## 6. Graduated Response Laws or Agreements

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<sup>89</sup> H.R. 5889, 110th Cong. (2008), proposed § 514(b)(2)(A)(ii)(I).

6.1 *Within the specific context of p2p filesharing of audio-visual works and sound recordings, does your national law contain laws (or proposed laws) providing for a graduated response “solution”? On what conditions? Three strikes, etc.?*

U.S. law contains no explicit provision for a graduated response policy. Rather, it provides a framework for the market to implement such a policy through inter-industry negotiations between content owners and various types of online service providers.<sup>90</sup>

The legal framework to address service providers’ obligations regarding copyright enforcement under U.S. law is 17 U.S.C. § 512. Enacted in 1998 as part of the Digital Millennium Copyright Act (DMCA),<sup>91</sup> section 512 was a compromise between copyright owners and telecommunications operators on issues pertaining to copyright enforcement online. It sets forth four safe harbors for online service providers,<sup>92</sup> codified in sections 512(a) to 512(d). These safe harbors protect four types of online activities from monetary liability under copyright law,<sup>93</sup> provided that the service providers meet certain threshold conditions.<sup>94</sup> Section 512(a) affords a safe harbor for –

transmitting, routing, or providing connections for, material through a system or network controlled or operated by or for the service provider, or by reason of the intermediate and transient storage of that material in the course of such transmitting, routing, or providing connections ....<sup>95</sup>

Section 512(a) of the DMCA thus sets forth a safe harbor from copyright monetary liability for ISPs, such as broadband providers or other Internet access providers. ISPs that qualify for the safe harbor remain exposed only to limited injunctive relief.<sup>96</sup> Therefore, under the DMCA, ISPs are not obliged – nor even strongly incentivized – to play an active role in copyright enforcement, including employing a “graduated response” policy.

It is possible, however, to read into the DMCA’s obligation to terminate repeat infringers under section 512(i) a variation of a “graduated response” policy. One of the main preconditions of section 512(i) for the application of the section 512(a) safe harbor (as well as the other safe harbors section 512 affords), is that service providers adopt and

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<sup>90</sup> Section 512 employs the broad term “service provider” which encompasses both providers of access to the Internet (covered by § 512(a)) and host service providers (§ 512(c)) as well as providers of other services, such as caching and searching, see § 512(k).(1). For purposes of this response to the ALAI Dublin Questionnaire, we will use the term “ISP” in connection with § 512(a) access providers, and the term “webhost” in connection with § 512(c) host service providers.

<sup>91</sup> 17 U.S.C. § 512 (2006).

<sup>92</sup> As defined in § 512(k)(1)(2000).

<sup>93</sup> Section 512(a) protects services that provide Internet access; §512(b) applies to temporarily storing infringing materials; §512(c) protects hosting services; and §512(d) applies to “information location tools,” such as links to content on other sites.

<sup>94</sup> The threshold requirements are fixed in 17 U.S.C. § 512(i) and in the specific safe harbors, § 512 (a)-(d).

<sup>95</sup> 17 U.S.C. § 512(a) (2006).

<sup>96</sup> *Id.* § 512(j).

publish policies that provide for termination in appropriate circumstances of repeat infringers. As the section reads:

The limitations on liability established by this section shall apply to a service provider only if the service provider (A) has adopted and reasonably implemented, and informs subscribers and account holders of the service provider's system or network of, a policy that provides for the termination in appropriate circumstances of subscribers and account holders of the service provider's system or network who are repeat infringers. . . .<sup>97</sup>

In this sense, the most criticized component of a “graduated response” policy, namely, termination of users’ connection, has been part of U.S. law as early as 1998.<sup>98</sup>

Section 512(i) may further provide a basis for a precursory “three strikes” rule or some variant of that practice. The statute provides no definition of “repeat infringers”<sup>99</sup> and no guidelines regarding what “appropriate circumstances” for termination of access might be.<sup>100</sup> Because ISPs are not obliged to affirmatively seek users’ infringements,<sup>101</sup> perhaps copyright owners’ notices of infringement may serve the function of informing ISPs of infringements, and thus create “appropriate circumstances” for termination of users’ accounts. If they could, then the system is quite similar to a “three strikes” rule, because after a number of notifications, the users’ service will be cut off.

Indeed, a number of courts have held that section 512(a) ISPs should have a system to receive complaints of infringement from copyright owners, although the DMCA itself creates such an obligation only for webhosts, which are covered under section 512(c).<sup>102</sup> But courts then reached inconsistent conclusions regarding whether notices from copyright owners can establish “appropriate circumstances” for termination of users. One district court ruled that “an internet service provider who receives repeat notifications. . . , but does not terminate its relationship with the client, has not reasonably implemented a

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<sup>97</sup> *Id.* § 512(i)(1)(A).

<sup>98</sup> *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1101 (W.D. Wash. 2004) (holding that a qualifying termination policy conveys to users “who repeatedly or flagrantly abuse their access to the [I]nternet through disrespect for the intellectual property rights of others” that they face “a realistic threat of losing that access.”) (quoting H.R. Rep. No. 105-551, pt. 2, at 44 (1998)).

<sup>99</sup> *See Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d at 1100 (“[t]he key term, ‘repeat infringer,’ is not defined”); Mark A. Lemley & R. Anthony Reese, *Reducing Digital Copyright Infringement Without Restricting Innovation*, 56 STAN. L. REV. 1345, 1420 (2004) (“No one seems to know what makes one a ‘repeat infringer’”).

<sup>100</sup> *See Perfect 10, Inc. v. Cybernet Ventures, Inc.*, 213 F. Supp. 2d 1146, 1176 (C.D. Cal. 2002) (“[T]he language of the [DMCA] and the legislative history of [§ 512(i)] are less than models of clarity.”).

<sup>101</sup> 17 U.S.C. § 512(m). *See also Perfect 10, Inc. v. Cybernet Ventures, Inc.*, 213 F. Supp. 2d at 1177.

<sup>102</sup> *See, e.g., Perfect 10, Inc. v. CCBill LLC*, 481 F.3d 751, 758 (9th Cir. 2007), modified, 488 F.3d 1102 (9th Cir. 2007) (holding that § 512(i) requires “a working notification system”); *Corbis Corp. v. Amazon.com*, 351 F.Supp. 2d, at 1102 (same); *Ellison v. Robertson*, 357 F.3d 1072, 1080 (9th Cir. 2004) (holding that a reasonable jury could conclude that a termination policy is not reasonable where an ISP turns a blind eye to notices of infringement).

repeat infringer policy.”<sup>103</sup> This decision was reversed, however – though on other grounds.<sup>104</sup> Other cases concluded that notices from copyright owners do not, in themselves, provide evidence of infringement because they could be erroneous.<sup>105</sup>

The interpretation that copyright owners’ notifications can establish “appropriate circumstances” for termination essentially reads a “three strikes” rule (or some near variant) into section 512(i). Yet, even under this interpretation it would be unclear what precisely would constitute a “strike,” and how many “strikes” would make a user a repeat infringer. Moreover, as stated above, this interpretation has been rejected by most of the few courts who considered it.<sup>106</sup>

Interpreting section 512(i) to mean “graduated response” is a rather risk-averse stance, at least from the viewpoint of ISPs. But it is a possible reading of the law, and may result in behavior which is consistent with a practice of “graduated response.”<sup>107</sup>

Beyond this interpretation of section 512(i), Congress did not impose obligations on ISPs seeking to enjoy the section 512 safe harbors which could be translated into a “graduated response” requirement. However, Congress did aim to encourage cooperation regarding copyright enforcement between ISPs and copyright owners. One of the explicit goals of the DMCA was to “preserve strong incentives for service providers and copyright owners to cooperate to detect and deal with copyright infringements that take place in the digital networked environment.”<sup>108</sup> This statement reflects the spirit of the U.S. Government’s approach to this day.<sup>109</sup>

Indeed, as will be discussed in the response to Question 6.6 below, in recent years, private arrangements between ISPs and copyright owners have begun to take place in the United States, and some of them probably culminated in practices similar to a “graduated response” policy. Although in one sense this practice developed *despite* the strong protection granted to ISPs under the DMCA, the DMCA has actually laid the groundwork for this development in important ways, as described below.

#### i. Section 512(a) conditions

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<sup>103</sup> Perfect 10, Inc. v. CCBill, LLC, 340 F. Supp. 2d 1077, 1088 (C.D. Cal. 2004), *rev'd on other grounds*, Perfect 10, Inc. v. CCBill, LLC, 481 F. Supp. 2d 751.

<sup>104</sup> *Id.*

<sup>105</sup> Corbis Corp. v. Amazon.com, 351 F. Supp. 2d at 1105-06; UMG Recordings, Inc. v. Veoh Networks Inc., 665 F. Supp. 2d 1099, 1118 (C.D. Cal. 2009).

<sup>106</sup> *See supra* note 98.

<sup>107</sup> Annemarie Bridy, *Graduated Response and the Turn to Private Ordering in Online Copyright Enforcement*, 89 ORE. L. REV. 81, 95 (2010).

<sup>108</sup> H.R. Rep. No. 105-796, at 72 (1998).

<sup>109</sup> Office of the U.S. Intellectual Prop. Enforcement Coordinator, 2010 Joint Strategic Plan on Intellectual Property Enforcement 17 (2010), available at [http://www.whitehouse.gov/sites/default/files/omb/assets/intellectualproperty/intellectualproperty\\_strategic\\_plan.pdf](http://www.whitehouse.gov/sites/default/files/omb/assets/intellectualproperty/intellectualproperty_strategic_plan.pdf) (“The Administration believes that it is essential for the private sector, including content owners, Internet service providers, advertising brokers, payment processors and search engines, to work collaboratively ... to seek practical and efficient solutions to address infringement...”).

One method by which section 512 encourages negotiations that may result in “graduated response” stems from the change of focus in the business model of ISPs – from mere conduits to services that are increasingly involved in content management.<sup>110</sup>

Section 512(a) was designed to shield from liability passive carriers that are not involved in managing the transmitted content. To qualify under section 512(a), the ISP needs to meet five conditions: (1) the transmission must not be initiated by the ISP itself; (2) the transmission must be automatic, and involve no selection of the information by the ISP; (3) the ISP must not select the recipient of the transmission; (4) the ISP must not host the information except transiently, as necessary to transmit it; and (5) the ISP must not modify the information.<sup>111</sup> Essentially, these conditions ensure that the ISP is neutral in routing and transmitting the information that is passing through its pipelines.

Today, however, the business model of ISPs is shifting away from neutrality, and may cost ISPs their safe harbor protection.<sup>112</sup> For reasons unrelated to copyright, broadband providers have recently begun to deploy “intelligent” routers within their networks, which are giving them the ability to inspect and monitor the traffic they carry.<sup>113</sup> The more involved ISPs become with monitoring content, the less applicable section 512 appears.<sup>114</sup> The possible exposure to liability might compel ISPs to cooperate with copyright owners on copyright enforcement, and even to negotiate “three strikes” policies.<sup>115</sup>

## ii. Section 512(h) limitations

The limitations of section 512(h) have also provided an incentive to copyright owners to pursue agreements with ISPs in order to indirectly contact their subscribers.

Section 512(h) permits a copyright owner to obtain a subpoena outside the framework of litigation to require a service provider to identify an alleged infringer.<sup>116</sup> However, two courts interpreting section 512(h) concluded that it does not apply to ISPs that function as mere conduits of information and do not host the information on their sites.<sup>117</sup> As a result,

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<sup>110</sup> Paul Ohm, *The Rise and Fall of Invasive ISP Surveillance*, 2009 U. ILL. L. REV. 1417, 1432-37 (2009).

<sup>111</sup> 17 U.S.C. § 512(a).

<sup>112</sup> Bridy, *supra* note 107 at 106.

<sup>113</sup> Peter K. Yu, *The Graduated Response*, 62 FLA. L. REV. 1373, 1387 (2010).

<sup>114</sup> Rob Frieden, *Internet Packet Sniffing and Its Impact on the Network Neutrality Debate and the Balance of Power Between Intellectual Property Creators and Consumers*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 633, 645 (2008) (“The output of affordable deep packet inspection and other technologies now available to ISPs raises questions whether non-neutral network operation disqualifies ISPs for a safe harbor exemption from liability for carrying copyright infringing traffic provided by § 512 of the DMCA.”).

<sup>115</sup> Bridy, *supra* note 107, at 103-06. *See also* response to Question 6.6.

<sup>116</sup> 17 U.S.C. § 512(h).

<sup>117</sup> *Recording Indus. Ass'n of Am., Inc. v. Verizon Internet Servs., Inc.*, 351 F.3d 1229, 1237 (D.C. Cir. 2003) (“the text of § 512(h) and the overall structure of § 512 clearly establish ... that § 512(h) does not authorize the issuance of a subpoena to an ISP acting as a mere conduit for the transmission of information sent by others.”); *In re Charter Commc'ns, Inc.*, 393 F.3d 771, 771 (8th Cir. 2005).

copyright owners wishing to contact direct infringers, or file a suit against them, must first initiate John Doe lawsuits in order to learn their identities.<sup>118</sup>

Agreements with ISPs could be more efficient than initiating John Doe lawsuits. Indeed, to deal with this legal reality, private arrangements with ISPs have emerged and led first and foremost to agreements to forward infringement notices to subscribers, as further explored in the response to Question 6.6.

### Specific Arrangements

In addition to the general framework of the safe harbor for ISPs from copyright liability under U.S. law that was discussed above, two specific arrangements pertaining to nonprofits and educational institutions are worth mentioning here.

#### i. Section 512(e)

Section 512(e) provides a safe harbor from monetary copyright liability to ISPs that are also nonprofit educational institutions. Section 512(e) provides that an infringing act of a faculty member or a graduate student employed by the institution will not be attributed to the institution if, among other things –

the institution has not, within the preceding 3-year period, received more than 2 notifications described in subsection (c)(3) of claimed infringement by such faculty member or graduate student, and such notifications of claimed infringement were not actionable under subsection (f). . .

While not a “graduated response” policy, section 512(e) attributes importance to notices of infringement, providing that once three or more notices have been received, the safe harbor will be removed and liability may attach to an ISP with respect to the infringing activities of the particular faculty member or graduate student employee. In this sense, it is not a “three strikes and you’re out” strategy, but rather a policy of “three strikes (within three years) and you’re deprived of the DMCA-protected status.”

#### ii. The Higher Education Opportunity Act

The Higher Education Opportunity Act of 2008 (HEOA) conditions the receipt of federal financial aid on certification that the participating institution “has developed plans to effectively combat the unauthorized distribution of copyrighted material, including through the use of a variety of technology-based deterrents.”<sup>119</sup>

Similarly to the DMCA, the HEOA does not mandate a “graduated response” policy, but provides a framework within which a “graduated response” can be applied, if higher education institutions elect to implement such a policy to combat online infringement. It

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<sup>118</sup> See, e.g., *Sony Music Ent. v. Does 1-40*, 326 F.Supp.2d 556, 564 (S.D.N.Y. 2004); *Virgin Records Am., Inc. v. Doe*, No. 5:08-CV-389-D, 2009 WL 700207 (E.D.N.C. Mar. 16, 2009).

<sup>119</sup> 20 U.S.C. § 1094(a)(29)(A) (Supp. II 2009); see also 34 C.F.R. § 668.14 (2010).

is unclear, however, precisely what effect the HEOA has had. The standard it defines is somewhat ambiguous, and some institutions were already in compliance with its guidelines prior to its enactment.<sup>120</sup>

In sum, the practice of “graduated response” in the United States, to the extent applied, largely takes the form of private arrangements rather than a regulatory involvement compelling the establishment of this practice.

Private ordering of the matter actually fits well within the agenda of the entertainment industry.<sup>121</sup> Rather than seeking an affirmative ruling mandating ISPs’ cooperation, the lobbying efforts of the industry have been focused on requesting government agencies to facilitate voluntary cooperation or avoid rules that would hinder such cooperation<sup>122</sup> (such as strong net neutrality principles, which could prohibit ISPs from intervening, prioritizing or blocking users’ transmissions). The most recent attempt at affirmative legislation has been the unsuccessful effort to include an amendment to declare ISP monitoring of copyright violations to be reasonable network management in the 2009 Economic Stimulus Plan.<sup>123</sup> Notably, even this bill would have constituted merely a rule that would allow voluntary negotiations with ISPs to occur. Despite this general agenda to regulate the matter via private arrangements, music industry representatives have emphasized publicly that if voluntary agreements with ISPs cannot be reached, they will pursue legislation mandating cooperation.<sup>124</sup>

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<sup>120</sup> Sara Lipka, *New Rules Will Push Colleges to Rethink Tactics Against Student Pirates*, THE CHRONICLE, Feb. 13, 2009, <http://chronicle.com/article/New-Rules-Will-Push-Colleges/7760>; Jeff Young, *MPAA Sends Letter to Thousands of Colleges About Copyright Rules*, THE CHRONICLE, Dec. 6, 2010, <http://chronicle.com/blogs/wiredcampus/mpaa-sends-letter-to-thousands-of-colleges-about-copyright-rules/28552>.

<sup>121</sup> Anne Broache, *RIAA: No Need to Force ISPs by Law to Monitor Piracy*, CNET NEWS, Jan. 30, 2008, [http://news.cnet.com/8301-10784\\_3-9861460-7.html](http://news.cnet.com/8301-10784_3-9861460-7.html) (quoting Cary Sherman, the RIAA’s President, stating that the RIAA is “much more interested in finding a marketplace way” to get ISPs to be more proactive, rather than trying to “relegislate” it). See also BSA Position on Appropriate Measures to Deter Online Piracy of Content, Business Software Alliance, <http://www.bsa.org/country/Public%20Policy/online-content-piracy.aspx> (last visited Dec. 29, 2010) (advocating for bypassing Congress to pursue a “voluntary industry-led approach.”).

<sup>122</sup> In the Matter of A National Broadband Plan For Our Future: Comments of the Motion Picture Ass’n of Am., Inc. in Response to the Workshop on the Role of Content in the Broadband Ecosystem Before the Fed. Commc’ns Comm’n, GN Docket No. 09-51, at 21 (2009), available at <http://www.mpaa.org/Resources/b55c4e2c-3510-424d-b12f-6719b86552ea.pdf>; The Internet Freedom Preservation Act of 2008: Hearing on H.R. 5353 Before the H. Subcomm. on Telecomms. and the Internet of the H. Comm. on Energy and Commerce, 110th Cong., at 1 (2008) (written statement of Mitch Bainwol, Chairman and CEO, RIAA), available at <http://76.74.24.142/F382DD78-ECE4-2026-BD0C-33C4ED1A0D44.pdf> (“If effective marketplace solutions cannot be reached soon, however, then government regulation may well be necessary.”).

<sup>123</sup> See Proposed Amendment to H.R. 1, 111th Cong., available at [http://www.publicknowledge.org/pdf/GRA09175\\_xml.pdf](http://www.publicknowledge.org/pdf/GRA09175_xml.pdf).

<sup>124</sup> See Declan McCullagh, *Music, Movie Lobbyists Push to Spy on Your Net Traffic*, CNET NEWS, Aug. 18, 2008, [http://news.cnet.com/8301-13578\\_3-10019622-38.html](http://news.cnet.com/8301-13578_3-10019622-38.html) (“A representative of the recording industry said ... that her companies would prefer to enter into voluntary ‘partnerships’ with Internet service providers, but pointedly noted that some governments are mandating such surveillance ‘if you don’t work something out.’”); Recording Indus. Ass’n of Am., RIAA CEO Encourages ISPs to Work with Music Industry to Address Digital Theft, RIAA News Room (May 6, 2008),

A more detailed discussion of the status of agreements between ISPs and copyright owners is provided in response to Question 6.6 below.

6.2 *Do such proposals include an educational aspect – enhancing awareness of intellectual property protection, as well as measures to (1) make Internet access more secure in order to prevent illegal activity; (2) – favour availability of legal services?*

The DMCA itself contains no educational aspects or additional measures. However, market initiatives address educational aspects as well.

The Arts + Lab initiative, for example, is a collaborative effort between ISPs and copyright owners dedicated to the notion of private ordering of ISP involvement in copyright enforcement.<sup>125</sup> The group emphasizes the concept of educating consumers about the dangers of “net pollution – a spam, malware, computer viruses and illegal file trafficking,”<sup>126</sup> though the exact application of this idea is yet to be seen.

In higher education institutions, new regulations issued under the HEOA specifically require participating institutions to—

develop[] and implement[] written plans to effectively combat the unauthorized distribution of copyrighted material by users of the institution’s network, without unduly interfering with educational and research use of the network, that include –  
...  
(B) Mechanisms for educating and informing its community about appropriate versus inappropriate use of copyrighted material....<sup>127</sup>

Higher education institutions’ copyright policies vary, but many developed extensive educational programs even prior to the HEOA and its regulations.<sup>128</sup> These policies have included, for example, on and off-line orientation tutorials, lectures, and videos. Disciplinary actions against offenders have often included remedial education programs in addition to fines and community service.<sup>129</sup>

The regulations issued under the HEOA further require that institutions –

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[http://www.riaa.com/newsitem.php?news\\_month\\_filter=5&news\\_year\\_filter=2008&resultpage=2&id=445DBB88-3C46-F2B7-784F-8B1B1B7F5FAA](http://www.riaa.com/newsitem.php?news_month_filter=5&news_year_filter=2008&resultpage=2&id=445DBB88-3C46-F2B7-784F-8B1B1B7F5FAA) (asserting that “government action may be necessary” if ISPs do not embrace a marketplace solution).

<sup>125</sup> About Us, Arts+Labs, [http://www.artsandlabs.com/about\\_us/About\\_Us.aspx](http://www.artsandlabs.com/about_us/About_Us.aspx) (last visited Dec. 31, 2010).

<sup>126</sup> *Id.*

<sup>127</sup> 34 C.F.R. § 668.14(30)(i)(B) (2010).

<sup>128</sup> *See supra* note 120.

<sup>129</sup> Audible Magic, a company that offers “HEOA compliance solutions” reports that its tools are currently in use at more than fifty institutions. *See CopySense Customers--Colleges & Universities*, Audible Magic, <http://www.audiblemagic.com/clients-partners/copysense.asp> (last visited Jan. 2, 2011).

[W]ill, in consultation with the chief technology officer or other designated officer of the institution –

...

(C) To the extent practicable, offer legal alternatives for downloading or otherwise acquiring copyrighted material, as determined by the institution....<sup>130</sup>

Institutions have explored a variety of legal services to offer students, such as Napster 2.0, CDigix, and Ruckus, some even prior to these regulations. Unfortunately, many of these services closed down or stopped providing services to colleges.<sup>131</sup>

6.3 *Is there a court procedure and/ or administrative agency that oversees the proceedings or authorises interruption or termination of internet access?*

As discussed in the responses to Questions 6.1 and 6.6, measures of “graduated response” have been developed in the marketplace with no direct regulatory intervention. As a result, no regulatory body was designated to supervise “graduated response” practices.

Indeed, the terms of use for major broadband providers typically contain a provision reserving the right to terminate access for any user who infringes copyrights,<sup>132</sup> and a number of providers have publicly acknowledged using it.<sup>133</sup> Users’ signatures on the terms of services have provided the authority for terminating users. No supervision is required under current law.

The law in this area may still be evolving. AT&T, a dominant U.S. ISP, has declared that it will not disconnect any subscriber without an express court order.<sup>134</sup> In a

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<sup>130</sup> 34 C.F.R. § 668.14(30)(ii) (2010).

<sup>131</sup> Sara Lipka, *Razing Ruckus*, THE CHRONICLE, Feb. 9, 2009, <http://chronicle.com/blogs/wiredcampus/razing-ruckus/4520>.

<sup>132</sup> See, e.g., Comcast Acceptable Use Policy For High-Speed Internet Services, Comcast.net, <http://www.comcast.com/Corporate/Customers/Policies/HighSpeedInternetAUP.html> (last updated Jan. 1, 2009) (“It is Comcast's policy in accordance with the DMCA and other applicable laws to reserve the right to terminate the Service provided to any customer or user who is either found to infringe third party copyright ... or who Comcast, in its sole discretion, believes is infringing these rights...”); Verizon Internet Access Terms of Service, Attachment A, §3, Verizon, [http://my.verizon.com/central/vzc.portal?\\_nfpb=true&\\_pageLabel=vzc\\_help\\_policies&id=TOS](http://my.verizon.com/central/vzc.portal?_nfpb=true&_pageLabel=vzc_help_policies&id=TOS) (last updated Jan. 17, 2010) (“[I]t is the policy of Verizon to suspend or terminate, in appropriate circumstances, the Service provided to any subscriber or account holder who is deemed to infringe third party intellectual property rights...”); AT&T High Speed Internet Terms of Service §5(b), AT&T, <http://www.att.net/csbellsouth/s/s.dll?spage=cg/legal/att.htm&leg=tos> (last updated June 14, 2009) (“AT&T may ... terminate or suspend your Member Account and Sub Accounts ... if ... you ... engage in conduct that is a violation of any law, regulation or tariff (including, without limitation, copyright and intellectual property laws).”).

<sup>133</sup> See Nate Anderson, *Verizon: We're Not Cutting Off Users Over Copyright Claims*, ARS TECHNICA, Jan. 21, 2010, <http://arstechnica.com/tech-policy/news/2010/01/verizon-uh-we-arent-cutting-off-users-over-copyright-claims.ars> (reporting that Verizon first admitted to and then denied having “cut some people off”).

<sup>134</sup> Nate Anderson, *AT&T wants 3 strikes tribunal, government website blacklist*, ARS TECHNICA (2010), <http://arstechnica.com/tech-policy/news/2010/04/att-calls-for-us-3-strikes-tribunal-web-censorship.ars>.

recommendation document it submitted to the Intellectual Property Enforcement Coordinator in 2010, AT&T has suggested that the government establish an adjudication body for implementation of a “graduated response” policy, arguing that ISPs are ill-equipped to undertake this task.<sup>135</sup>

6.4 *Is it possible to assess the effectiveness of the implementation of these measures, both as a matter of stemming piracy, and with respect to the development of legal services?*

Because U.S. policy is sporadic and still in early stages of development, it is difficult to evaluate not only the success of these measures, but even their scope. As will be discussed below in the response to Question 6.6, ISPs do not publicize their agreements with content owners, which creates hurdles to assessing the effectiveness of such measures.

ISPs report the effectiveness of another measure: forwarding infringement notices of rights holders to subscribers, without even taking any additional steps.<sup>136</sup> As will be discussed in the response to Question 6.6, ISPs argue that these efforts have indeed borne fruit in reducing the scope of illegal trafficking in protected works.

6.5 *Is there any case-law on the possible (own initiative) use of blocking or filtering technology by an ISP, as distinct from situations where an ISP is required by a court or administrative agency to terminate subscribers access (i.e. injunctive relief)?*

There is no case law in the United States on ISP filtering for copyright purposes. Cases concerning ISP monitoring information outside of the copyright context, as well as cases involving filtering (or lack thereof) for copyright purposes by services other than ISPs, will be discussed below. While it may be possible to learn from these cases by comparison, filtering for copyright purposes by ISPs may present a different set of challenges.

An important U.S. case that involved an ISP monitoring its users’ content involved Comcast, one of the country’s major broadband providers, interfering with BitTorrent traffic. In fact, Comcast interfered with the traffic for reasons unrelated to copyright purposes; apparently it was attempting to reduce congestion on its broadband network. In 2007, several subscribers to Comcast’s service discovered that the company was interfering with their BitTorrent traffic, and when the suspicions were confirmed, the Federal Communication Commission (FCC) initiated an investigation. Comcast argued that it was merely engaging in legitimate network management, but as a response to the public outcry, it entered an agreement with BitTorrent in which it agreed to apply

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<sup>135</sup> AT&T, *Request of IPEC for Public Comments Regarding the Joint Strategic Plan*, Letter to U.S. Intellectual Property Enforcement Coordinator, March 24, 2010, available at <http://attpublicpolicy.com/wp-content/uploads/ATT-Comments-for-Joint-Strategic-Plan-3-24-10.pdf>.

<sup>136</sup> *Id.* at 1.

“protocol agnostic” network management techniques.<sup>137</sup> The FCC investigation culminated on August 1, 2008 in an unprecedented ruling that Comcast had “unduly interfered with Internet users' rights” and an order that the company end its discriminatory practices, disclose its network management practices, and provide details about the practices that will replace them.<sup>138</sup> Comcast appealed the ruling in the U.S. Court of Appeals for the District of Columbia. The court ruled that the FCC lacked authority under the Communications Act of 1934 to enforce network neutrality rules over broadband Internet providers.<sup>139</sup>

Currently, it is unclear how wide the scope of “net neutrality” – which prevents ISPs from interfering or prioritizing Internet content – would be,<sup>140</sup> and how strongly it could be enforced.<sup>141</sup> It is assumed, however, that the FCC is not likely to prevent ISPs’ monitoring of networks for copyright-related reasons.<sup>142</sup>

A few additional cases pertain to filtering – or lack thereof – by services other than ISPs. Section 512 explicitly provides that webhosts incur no obligation to monitor their site ex ante in order to qualify under its safe harbors.<sup>143</sup> Courts thus cannot draw conclusions from the lack of filtering if services are covered by section 512.<sup>144</sup> On the other hand, utilizing filtering can serve as an indicator of a good faith effort to hinder infringements.<sup>145</sup> In *UMG v. Veoh*,<sup>146</sup> the defendant – a webhost for video files which was covered under section 512 – attempted to install filtering. While the copyright-owner plaintiff deemed the effectiveness of the filter insufficient, and despite the availability of superior alternatives, installing the filter served as an indication that the defendant had good intent and made an effort to curtail infringement on its site.<sup>147</sup>

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<sup>137</sup> Press Release, Comcast, Comcast and BitTorrent Form Collaboration to Address Network Management, Network Architecture and Content Distribution (Mar. 27, 2008), available at <http://www.comcast.com/About/PressRelease/PressReleaseDetail.aspx?PRID=740>.

<sup>138</sup> Press Release, FCC, Commission Orders Comcast to End Discriminatory Network Management Practices (Aug. 1, 2008), [http://hraunfoss.fcc.gov/edocs\\_public/attachmatch/DOC-284286A1.pdf](http://hraunfoss.fcc.gov/edocs_public/attachmatch/DOC-284286A1.pdf).

<sup>139</sup> *Comcast Corp. v. F.C.C.*, 600 F.3d 642, 661 (C.A.D.C. 2010).

<sup>140</sup> The newly issued FCC net neutrality rules are not yet in effect and must be first approved by Congress. See *Preserving the Open Internet, Broadband Industry Practices*, 74 Fed. Reg. 62638, 62661 (proposed Nov. 30, 2009) (to be codified at 47 C.F.R. pt. 8).

<sup>141</sup> Bridy, *supra* note 107, at 113-116.

<sup>142</sup> *Id.* at 132 (“The FCC ... is unlikely to intervene in the name of net neutrality to prevent this private (re)ordering by, for example, prohibiting content blocking or filtering by ISPs.”).

<sup>143</sup> 17 U.S.C. § 512(m) (2000).

<sup>144</sup> *Viacom Inc. v. YouTube, Inc.*, 718 F.Supp.2d 514 (S.D.N.Y. 2010), appeal pending.

<sup>145</sup> See also Tim Wu, *The Copyright Paradox*, 2005 SUP. CT. REV. 229, 247 (suggesting that voluntary filtering may effectuate a safe harbor from liability for inducement of copyright infringement).

<sup>146</sup> *UMG Recordings, Inc. v. Veoh Networks Inc.*, 665 F. Supp.2d at 1103.

<sup>147</sup> It remains debatable whether showing good intent is required to establish a website's eligibility for coverage under the DMCA. Compare *Viacom v. Youtube*, 718 F. Supp.2d at 525-26, with *Arista Records LLC v. USENET.com, Inc.*, 633 F. Supp.2d 124, 142 (S.D.N.Y. 2009) and *Columbia Pictures Indus. v. Fung*, 2009 U.S. Dist. Lexis 122661 \*-37-\*40 (C.D. Cal. Dec. 21, 2009). See also Jane C. Ginsburg, *Separating the Sony Sheep from the Grokster Goats: Reckoning the Future Business Plans of Copyright-Dependent Technology Entrepreneurs*, 50 ARIZ. L. REV. 577 (2008).

Outside of the protecting wings of section 512(c), however, failing to filter may support a finding of derivative liability under the theory of inducement.<sup>148</sup> In *MGM v. Grokster*,<sup>149</sup> copyright owners litigated – and prevailed – against a peer-to-peer file-sharing system which was used predominantly to infringe copyrights, and was ineligible for the DMCA protection. While the Supreme Court noted that failure to install filtering cannot by itself suffice to establish contributory liability,<sup>150</sup> it viewed the failure to deploy filtering as evidence of the defendants’ unlawful intent,<sup>151</sup> which in turn tipped the scales towards holding the defendants secondarily liable for inducing infringement.<sup>152</sup>

In principle, developments in the realm of webhosts may apply to ISP filtering of copyrighted content. It may, however, be problematic to extend the lessons of these decisions to the context of ISPs, because, as mentioned above, the notion of ISPs monitoring users’ behavior raises concerns which in the U.S. are folded into the net neutrality debate.

6.6 *Are there private agreements among copyright owners and internet service providers that function similarly to “3-strikes” laws?*

As mentioned above, with the exception of higher education institutions, most of the arrangements in these issues are being done in the market via private ordering. Indeed, various collaborations between ISPs and copyright owners occur in the shadow of the law, and some ISPs apparently employ a graduated response to curtail copyright infringement.

In the past two years various content owner groups such as the Recording Industry Association of America (RIAA), the Motion Picture Association of America (MPAA) and others have engaged in negotiation with ISPs to develop greater cooperation with respect to illegal online file-sharing activities.<sup>153</sup>

Many agreements require ISPs to forward infringement notices to consumers. Verizon, a major U.S. ISP, is reportedly party to agreements under which it forwards notices of infringement on behalf of Disney and other parties, presumably in return for the right to

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<sup>148</sup> See Jane C. Ginsburg & Sam Ricketson, *Inducers and Authorisers: A Comparison of the US Supreme Court's Grokster Decision and the Australian Federal Court's KaZaa Ruling*, 11 MEDIA & ARTS L. REV. 1, 7-8 (2006).

<sup>149</sup> *MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005).

<sup>150</sup> *MGM v. Grokster*, 545 U.S. at 946, n.12 (“[I]n the absence of other evidence of intent, a court would be unable to find contributory infringement liability merely based on a failure to take affirmative steps to prevent infringement, if the device otherwise was capable of substantial noninfringing uses.”).

<sup>151</sup> *Id.* Justice Breyer was reluctant to draw conclusions from the absence of filtering tools. See *id.* at 958.

<sup>152</sup> Whether inducement is an independent source for derivative liability or part of contributory liability is unclear. Compare Charles W. Adams, *Indirect Infringement from a Tort Law Perspective*, 42 U. RICH. L. REV. 636 (2008) with *Perfect 10 v. Amazon.com, Inc.*, 487 F.3d 701, 731 (9th Cir. 2007).

<sup>153</sup> See, e.g., Recording Indus. Ass’n of Am., *supra* note 124 (announcing “constructive discussions with a number of ISPs about ways to address the piracy problem, including mechanisms like graduated response”).

transmit certain programming over its network.<sup>154</sup> AT&T has even created an automated system for forwarding infringement notices, which it claims is highly effective.<sup>155</sup> Some agreements arguably provide for a “graduated response” scheme.<sup>156</sup>

ISPs are generally equivocal about these agreements, and may even deny cooperating with copyright owners.<sup>157</sup> Policies of ISPs generally do not disclose their “network management” practices.<sup>158</sup> Representatives of major ISPs including Comcast, Cox, and AT&T have publicly denied cooperation with the RIAA, but at least one of them has disclosed that it had suspended the accounts of a small fraction of users.<sup>159</sup> AT&T declared publicly that it will not terminate users’ access without a court order,<sup>160</sup> but it too forwards notices of infringement to subscribers.<sup>161</sup>

The intent to maintain the framework of private ordering in this field is reiterated in the Joint Strategic Plan on Intellectual Property Enforcement. The Strategic Plan was issued by the U.S. Intellectual Property Enforcement Coordinator (IPEC), a position which was created last year as part of the Enforcement of Intellectual Property Rights Act of 2008.<sup>162</sup> Among other things, the Strategic Plan calls for the government to continue “facilitating cooperation” in “the business community to reduce Internet piracy.”<sup>163</sup>

To conclude, akin to similar trends globally, the entertainment industry in the United States has pursued an agenda of “graduated response.”<sup>164</sup> Yet unlike other places abroad, the domestic campaign so far has focused on inter-industry negotiations with ISPs, in the shadow of the law. This creates a transparency issue which prevents us from learning more about the scope and effectiveness of these arrangements.

## 7. Private Agreements and UGC

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<sup>154</sup> Nate Anderson, *Verizon to Forward RIAA Warning Letters (But That's All)*, ARS TECHNICA, Nov. 13, 2009, <http://arstechnica.com/tech-policy/news/2009/11/verizon-to-forward-riaa-warning-letters-but-thats-all.ars>.

<sup>155</sup> AT&T, *supra* note 135.

<sup>156</sup> *See supra* note 153.

<sup>157</sup> *See* Chloe Albanesius, *Comcast, Others Deny 'Three Strikes' Piracy Plan*, PCMAG.COM, Mar. 27, 2009, <http://www.pcmag.com/article2/0,2817,2343977,00.asp>.

<sup>158</sup> Preserving the Open Internet, Broadband Industry Practices, 74 Fed. Reg. at 62648, available at <http://openregs.com/regulations/view/100712#>.

<sup>159</sup> Sarah McBride, *Relationship Status of RIAA and ISPs: It's Complicated*, WALL ST. J., Mar. 26, 2009, <http://blogs.wsj.com/digits/2009/03/26/relationship-status-of-riaa-and-isps-its-complicated/>.

<sup>160</sup> Greg Sandoval, *AT&T Exec: ISP Will Never Terminate Service on RIAA's Word*, CNET NEWS, Mar. 25, 2009, [http://news.cnet.com/8301-1023\\_3-10204514-93.html](http://news.cnet.com/8301-1023_3-10204514-93.html).

<sup>161</sup> AT&T, *supra* note 135.

<sup>162</sup> Act of October 13, 2008, Public Law No. 110-403, S. 3325, § 301, 122 Stat. at 4265, 110th Cong., 2d Session.

<sup>163</sup> *See also supra* note 109. A report that came out in February 2011 reinforces this view. *See* 2010 IPEC ANNUAL REPORT ON INTELLECTUAL PROPERTY ENFORCEMENT 27-28 (2010) available at [http://www.whitehouse.gov/sites/default/files/omb/IPEC/ipiec\\_annual\\_report\\_feb2011.pdf](http://www.whitehouse.gov/sites/default/files/omb/IPEC/ipiec_annual_report_feb2011.pdf) (“Since the release of the Strategy, the IPEC has facilitated and encouraged dialogue among the different private sector Internet intermediaries that contribute to the dynamic nature and functioning of the Internet.”)

<sup>164</sup> Sarah McBride & Ethan Smith, *Music Industry to Abandon Mass Suits*, WALL ST. J., Dec. 19, 2008, at B1, available at <http://online.wsj.com/article/SB122966038836021137.html>.

7.1 *Are there private agreements among copyright owners and hosts of UGC content sites regarding the filtering of content posted to the sites? Are there inter-industry statements of “best practices” regarding filtering? Have government authorities in your country undertaken initiatives to encourage the adoption of such accords?*

In recent years, private arrangements have emerged between content owners and webhosts, where, among other things, webhosts undertook to deploy filtering mechanisms, and in return, rights holders agreed not to sue them for copyright infringement.

Probably the widest private arrangement thus far is the “User Generated Content Principles” (UGC Principles). The UGC Principles were established in 2007 by leading content producers (including Disney, Sony, Viacom and others) and services (including, among others, Microsoft and MySpace) as a series of “best practices” for UGC sites to further protect copyright owners, beyond what the DMCA requires.<sup>165</sup> The UGC Principles aim at four objectives: (i) elimination of infringing content, (ii) encouragement of original and authorized user-generated content, (iii) accommodation of fair use<sup>166</sup> and (iv) protection of legitimate interests of user privacy.<sup>167</sup> The agreement obligates services *inter alia* to employ filtering systems in order to curtail copyright infringement on their sites.<sup>168</sup> By defining “best practices,” the UGC Principles may cause a noncomplying site to be viewed in litigation processes as an outlier, rather than as a law-abiding compliance-oriented company.<sup>169</sup>

Another important example of private ordering of filtering on UGC sites is Google’s Video Identification System, which flags to rights holders verbatim copies of their works and allows them to require removal of the copies or monetize them by sharing ad revenues with Google.<sup>170</sup> Today, Google’s Video Identification System applies across the board. It began, however, as a program available to YouTube’s business partners only and was unavailable to rights holders that were not willing to enter an agreement with YouTube.

So far, government authorities have not undertaken initiatives to encourage the adoption of the UGC Principles or any other filtering system.

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<sup>165</sup> See Principles for User Generated Content Services, <http://www.ugcprinciples.com/>.

<sup>166</sup> Fair use is an affirmative defense to copyright infringement in U.S. law. See 17 U.S.C. § 107. See also *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590, 114 S.Ct. 1164, 1177, 127 L.Ed.2d 500 (1994). The activist group Electronic Frontier Foundation (EFF) has proffered a different set of principles (“EFF Principles”), designed to ensure that the filtering systems implemented by host sites appropriately accommodate fair use. See Electronic Frontier Foundation, Fair Use Principles for User Generated Video Content, <http://www.eff.org/issues/ip-and-free-speech/fair-use-principles-usergen>.

<sup>167</sup> *Id.*

<sup>168</sup> Principles for User Generated Content Services § 3, <http://www.ugcprinciples.com/>.

<sup>169</sup> Ian C. Ballon, 4 E-COMMERCE AND INTERNET LAW § 49.05[2] (2010-2011 update).

<sup>170</sup> Following the suit by Viacom, the YouTube filter, which was previously available only to Google’s partner, became available for all rights holders. See *Viacom, Brief of Appeal in Viacom Inc. v. YouTube, Inc.*, 10-3270 (2nd Cir. 2010).

## 7.2 *How is the filtering to be accomplished?*

Host sites of UGC content have experimented with various types of filtering. Today, most sites utilize third party software, with the exception of Google, which utilizes its own system for YouTube. The most recent and popular technology is fingerprinting, a technique which allows software to identify characteristic components of a file. The system creates a file-fingerprinting database and compares user-uploaded files to that database to seek a match.<sup>171</sup>

Audio fingerprinting has been around for a while (for example, All Media Guide's LASSO, New Media Lab, Audible Magic Corporation, AudioID, Last.fm). Video fingerprinting is a newer technology, poised to supersede its predecessors. These predecessors include hash value comparisons (which can only identify full equality between files and is thus vulnerable to minor modifications or even changes in quality) and digital watermarking, which requires embedding information into the original file in order to prevent its copying.<sup>172</sup>

In addition, some anti-piracy solutions offer automated software that travels the web and identifies copyrighted texts, instead of UGC-specific filtering.<sup>173</sup> While filtering across the web may be more effective than a service-specific scheme (since in the latter, users may simply migrate to alternative sites), the obvious downside of it is that the cost is shouldered by copyright owners alone.

## 7.3 *Have there been any cases concerning such agreements or “best practices”?*

Thus far, there have not been any relevant cases other than those discussed above.

## 7.4 *Outside the existence of such accords, have courts themselves imposed remedies requiring measures such as “take down, stay down”?*

Courts have not required measures such as “take down, stay down” to be employed by webhosts.<sup>174</sup> Yet, implementing a “take down, stay down” policy may be useful for webhosts to show goodwill to tackle copyright infringement.<sup>175</sup>

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<sup>171</sup> See Brad Stone & Miguel Helft, *New Weapon in Web War over Piracy*, N.Y. TIMES, Feb. 19, 2007, available at: <http://www.nytimes.com/2007/02/19/technology/19video.html>.

<sup>172</sup> June M. Besek, *Anti-Circumvention Laws and Copyright: A Report from the Kernochan Center for Law, Media and the Arts*, 27 COLUM. J.L. & ARTS 385, 447 (2004). For more on video filtering, see Kevin J. Delaney et al., *Policing Web Video with “Fingerprints,”* WALL ST. J., Apr. 23, 2007, at B.3.

<sup>173</sup> See, e.g., *Attributor, 24/7 Protection for your Articles, Books and Video Games*, <http://www.attributor.com/solutions/solutions.php>.

<sup>174</sup> See *Viacom Inc. v. YouTube, Inc.*, 718 F. Supp.2d at 528-29 (holding that YouTube was not required to take down works that infringe the same work that was subject to a take-down notice). YouTube, however, did apply a fingerprinting tool which removed an offending video automatically if it matched some portion of a reference video submitted by a copyright owner who had designated this service. *Id.* at 528.

In *Io Group v. Veoh Networks*,<sup>176</sup> for example, a copyright owner of adult content sued a video hosting site for direct and derivative copyright infringement. The plaintiff attempted to disqualify Veoh Networks from the DMCA safe harbor by contending that Veoh Networks had no reasonable repeat infringer policy per the requirement of section 512(i).<sup>177</sup> To refute this argument, Veoh Networks successfully showed that it had adopted technology that enabled Veoh Networks to terminate access to any other identical files and prevent additional identical files from being uploaded by any user.<sup>178</sup> This practice, essentially “take down, stay down,” served as one of a few indications that Veoh Networks had “a working notification system and a procedure for dealing with copyright infringement notices.”<sup>179</sup>

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<sup>175</sup> In 2007 MySpace voluntarily applied a “take down stay down” policy. See AudibleMagic, *MySpace Launches "Take Down Stay Down" Copyright Protection*, <http://audiblemagic.com/news/press-releases/pr-2007-05-11.asp>, May 11, 2007. See also Wu, *supra* note 145.

<sup>176</sup> *Io Group, Inc. v. Veoh Networks, Inc.*, 586 F.Supp.2d 1132 (N.D.Cal.2008).

<sup>177</sup> See response to Question 6.1.

<sup>178</sup> *Io Group, Inc. v. Veoh Networks, Inc.*, 586 F. Supp.2d at 1144.

<sup>179</sup> *Id.*