

**“MAKING AVAILABLE” AS DISTRIBUTION: FILE-SHARING
AND THE COPYRIGHT ACT**

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TABLE OF CONTENTS

I. INTRODUCTION.....	274
II. ORIGIN AND STATUTORY ANALYSIS OF THE “MAKING AVAILABLE” DOCTRINE	276
A. <i>Statutory Structure</i>	276
B. <i>The Introduction of the “Making Available” Doctrine — Hotaling</i>	277
C. <i>The RIAA’s Statutory Arguments in Support of the “Making Available” Doctrine</i>	279
1. Does the Plain Meaning of “Distribute” Encompass the “Making Available” Right?.....	279
2. Is “Distribution” Synonymous with “Publication”?	280
3. Does “Authorization” of “Distribution” Imply Primary Liability?.....	282
III. CASES INTERPRETING THE “MAKING AVAILABLE” DOCTRINE.....	283
A. <i>Supreme Court and Circuit Court “Distribution” Cases After Hotaling</i>	283
B. <i>District Court Decisions Prior to 2008</i>	287
C. <i>District Court Decisions in 2008</i>	290
D. <i>Capitol Records Inc. v. Thomas</i>	293
IV. ALTERNATIVES TO THE “MAKING AVAILABLE” DOCTRINE	295
A. <i>There Is No Justification for the Survival of the “Making Available” Doctrine</i>	295
B. <i>The Importance of Limiting the “Making Available” Doctrine</i>	296
C. <i>Secondary Liability Is the Appropriate Form of Liability for Infringing File-Sharers</i>	297
V. CONCLUSION	299

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I. INTRODUCTION

On October 4, 2007, a jury in Minnesota fined Jammie Thomas \$222,000 for sharing twenty-four songs on the KaZaA music-sharing program.¹ The verdict came four years into the extensive program of actions against individual file-sharers conducted by the Recording Industry Association of America (“RIAA”) — the industry group representing record companies.² This was the first case in which a jury had reached a verdict,³ even though the RIAA has “filed, settled, or threatened, legal actions against well over 20,000 individuals.”⁴ In summarizing the case, now Chief Judge Michael J. Davis gave the following jury instruction: “The act of making copyrighted sound recordings available for electronic distribution on a peer-to-peer network, without license from the copyright owners, violates the copyright owners’ exclusive right of distribution, regardless of whether actual distribution has been shown.”⁵ This instruction succinctly identifies the issue considered in this Note, an issue of much debate in the recording industry and the judicial and academic legal communities. Specifically, this Note analyzes whether the “making available” of an electronic file is sufficient to qualify as “distribution” under the Copyright Act, and thus infringes a copyright owner’s exclusive rights.

The “making available” doctrine was first introduced not in reference to Internet file-sharing, but in the completely different context of the catalog of materials held by a library.⁶ The appellate courts have never fleshed out the doctrine in any detail.⁷ Consequently, it has been left to district courts to interpret the doctrine as it relates to file-sharing. Needless to say, some courts have come out in favor of the “making available” doctrine, some against it, and a minority of courts

1. See Special Verdict Form, *Capitol Records Inc. v. Thomas*, No. 06-1497 (MJD/RLE) (D. Minn. Oct. 4, 2007), available at <http://www.muddlawoffices.com/RIAA/Virgin%20Thomas/100%20Special%20Verdict%20Form.pdf>; see also Posting of David Kravets to Threat Level, RIAA Jury Finds Minnesota Woman Liable for Piracy, Awards \$222,000, <http://blog.wired.com/27bstroke6/2007/10/riaa-jury-finds.html> (Oct. 4, 2007, 17:34 EDT) [hereinafter Kravets].

2. E.g., ELECTRONIC FRONTIER FOUNDATION, *RIAA v. THE PEOPLE: FOUR YEARS LATER 2* (2007), available at http://w2.eff.org/IP/P2P/riaa_at_four.pdf. The RIAA has recently announced that it plans to halt its strategy of suing individual file-sharers and instead work directly with ISPs to combat file-sharing. See Sarah McBride & Ethan Smith, *Music Industry to Abandon Mass Suits*, WALL ST. J., Dec. 19, 2008, at B1. This Note refers to record companies generally as the RIAA, even though the cases themselves list the individual record companies as plaintiffs.

3. See Kravets, *supra* note 1.

4. ELECTRONIC FRONTIER FOUNDATION, *supra* note 2, at 2.

5. Jury Instructions at 18, *Thomas*, No. 06-1497 (MJD/RLE) [hereinafter *Thomas* Jury Instructions], available at http://blog.wired.com/27bstroke6/files/jury_instructions.pdf.

6. See *infra* Part II.B.

7. See *infra* Part III.A.

have ducked the issue entirely.⁸ In a thirty-day period in the spring of 2008, district courts in Arizona, Massachusetts, Texas, and New York each issued opinions that offered a different interpretation of the doctrine.⁹

The highly-publicized *Thomas* case took an unusual turn when Chief Judge Davis issued an order on May 15, 2008 stating that the court was considering granting a retrial and asking for briefs on the propriety of the “making available” doctrine in this context.¹⁰ On September 24, 2008, a retrial was granted on the grounds that the distribution jury instruction was invalid.¹¹ Chief Judge Davis dismissed the “making available” doctrine and “implored” Congress to act to address the extreme liability levels facing individual file-sharers.¹² Nevertheless, the RIAA has appealed the decision and continues to bring actions against thousands of private individuals.¹³ Soon, the appellate courts will be called upon to settle the increasing discrepancies among the judicial districts.

This Note argues that the “making available” doctrine has no basis in the text of the Copyright Act, the Act’s legislative history, or appellate jurisprudence, and thus should be abolished. Moreover, the interpretation of the doctrine proposed by the RIAA potentially exposes thousands of inadvertent file-sharers to millions of dollars of liability because of very high mandatory statutory damage levels.¹⁴ This interpretation would give great power to the copyright holder and foster an unfair system of liability that the judiciary would be unable to check. Part II analyzes the text of the statute and the origin of the “making available” doctrine. Part III considers the few appellate cases that have touched upon the distribution right as related to the “making available” doctrine and then analyzes the slew of recent district court decisions that interpret, accept, or reject the doctrine. Part IV argues for the abolition of the doctrine and suggests that secondary liability would be more appropriate for tackling the problem of illegal file-sharing. Part V concludes.

8. See *infra* Parts III.B–C.

9. See *infra* Part III.C.

10. See Order at 3, Capitol Records Inc. v. Thomas, No. 06-1497 (MJD/RLE) (D. Minn. May 15, 2008), available at http://www.ilrweb.com/viewILRPDF.asp?filename=virgin_thomas_080515OrderOralArgument; see also *Thomas* Jury Instructions, *supra* note 5.

11. Memorandum of Law and Order at 44, Capitol Records Inc. v. Thomas, No. 06-1497 (MJD/RLE) (D. Minn. Sept. 24, 2008) [hereinafter *Thomas* Retrial Order], available at http://www.eff.org/files/filenode/capitol_v_thomas/10112270717.pdf.

12. *Id.* at 37, 41; see *infra* Part III.D.

13. See *infra* note 150 and accompanying text.

14. See *infra* notes 158–60 and accompanying text.

II. ORIGIN AND STATUTORY ANALYSIS OF THE “MAKING AVAILABLE” DOCTRINE

A. Statutory Structure

The cornerstone of United States copyright law is the set of exclusive rights granted to the owner of a copyrighted work in § 106 of the Copyright Act of 1976. The three primary rights that are reserved to the copyright owner are the rights to reproduce, to prepare derivative works, and to distribute copies of the copyrighted work.¹⁵ Section 106 confers upon a copyright owner the exclusive right “to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending.”¹⁶ At first glance, the distribution right appears incredibly broad: the text of § 106(3) alone would appear to give a copyright owner the power to limit the distribution of a copyrighted work at any point in time, even with respect to an authorized copy that he has sold. For example, under this reading of the distribution right, a record company could prevent the purchaser of a CD from selling that CD to someone else. The “first-sale doctrine,” however, heavily limits the distribution right.¹⁷ The owner of a copy of a copyrighted work “is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy.”¹⁸ This language specifically limits *only* the distribution right of § 106(3).¹⁹ The legislative history of the Act clari-

15. 17 U.S.C. § 106 (2006). In its entirety, the section reads as follows:

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

Id.

16. *Id.* § 106(3).

17. *See id.* § 109(a); *see also* 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.12 (2008).

18. 17 U.S.C. § 109(a).

19. “Notwithstanding the provisions of *section 106(3)*, the owner of a particular copy or phonorecord lawfully made under this title, or any person authorized by such owner, is

fies this: “As section 109 makes clear . . . the copyright owner’s rights under section 106(3) cease with respect to a particular copy or phonorecord once he has parted with ownership of it.”²⁰ If the purchaser of the legitimate copy makes and distributes an unauthorized copy, then the distribution right is certainly violated. However, in those circumstances, the reproduction right would be violated as the purchaser has made an unauthorized copy, an exclusive right of the copyright owner, and thus in this scenario § 106(3) is not doing any additional work that § 106(1) is not. As the legislative history of the Act summarizes, the two purposes of the distribution right independent of the reproduction right are (1) to ensure an author has “the right to control the first public distribution of an authorized copy or phonorecord of his work,” and (2) to protect against the “unauthorized public distribution of copies or phonorecords that were unlawfully made,” even if the distributor did not himself make the copies.²¹

The prototypical scenario this Note considers is a file-sharer who stores an authorized, original copy of a publicly-released song on the hard drive of his computer — for example, an electronic track downloaded from Apple’s iTunes Music Store that does not have Digital Rights Management (DRM) protection.²² The file-sharer then makes the file available for copying on an electronic network of some kind but does nothing to “push” the specific file to others. Rather, if another network user so desires, he can access the file and make an identical copy of it on his computer.

Clearly, the first purpose of the distribution right is inapplicable as the song is already publicly-released — the “right of first distribution” has been exercised. Therefore, it is in the interpretation of the second purpose of the right that the “making available” doctrine has arisen.

B. The Introduction of the “Making Available” Doctrine — Hotaling

In 1997, the Fourth Circuit introduced the “making available” doctrine in *Hotaling v. Church of Jesus Christ of Latter-Day Saints*.²³

entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord.” *Id.* (emphasis added).

20. H.R. REP. NO. 94-1476, at 62 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5674. This is the House Report recommending the passage of the 1976 Copyright Act, explaining the purpose of the distribution right.

21. *Id.*

22. See Press Release, Apple, Apple Unveils Higher Quality DRM-Free Music on the iTunes Store (Apr. 2, 2007), <http://www.apple.com/pr/library/2007/04/02itunes.html>. The RIAA has changed its position on whether a copy made for personal use is an infringing use. See, e.g., Robert Kasunic, *Making Circumstantial Proof of Distribution Available*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1145, 1146 & nn.5–8 (2008). In the situation described here, this layer of complexity is avoided as the electronic file is the original, authorized copy.

23. 118 F.3d 199 (4th Cir. 1997).

There, the defendant library had made unauthorized reproductions of a work copyrighted by Hotaling and had made them available to the public.²⁴ Hotaling, however, did not bring an infringement suit until more than three years after she discovered the copies had been made.²⁵ One reason why the second purpose of the distribution right lay dormant for so long is that, generally, when an unauthorized copy of a work is distributed, the plaintiff can bring an action under § 106(1) for unauthorized *reproduction* against the copier. The statute of limitations under the Copyright Act, however, is three years from the date of discovery of infringement, and thus Hotaling was barred from bringing a reproduction claim, meaning the court had to consider the *distribution* right.²⁶ The district court granted the library's motion for summary judgment, but the Fourth Circuit found in favor of Hotaling on appeal, holding that the library had infringed her exclusive right to distribute.²⁷ The court first noted that "distributing unlawful copies of a copyrighted work does violate the copyright owner's distribution right and, as a result, constitutes copyright infringement."²⁸ Hotaling conceded that there was no evidence "showing specific instances within the limitations period in which the libraries loaned the infringing copies to members of the public," as the library did not keep records.²⁹ The defendant argued that "holding a work in a library collection that is open to the public constitutes, at most, an offer to distribute the work" and that "to establish distribution . . . the evidence would need to show that a member of the public accepted such an offer."³⁰ Rejecting this argument, the court in *Hotaling* held that merely making available the unlawful copy to the public was sufficient to constitute infringement.³¹ The court explained itself further: if a plaintiff were required to show that there had been an actual act of distribution, then he would be "prejudiced by a library that does not keep records of public use, and the library would unjustly profit by its own omission."³²

24. *Id.* at 201.

25. *Id.*

26. *Id.*; see 17 U.S.C. § 507(b) (2006) ("No civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued."); see, e.g., *Roley v. New World Pictures, Ltd.*, 19 F.3d 479, 481 (9th Cir. 1994) ("A cause of action for copyright infringement accrues when one has knowledge of a violation or is chargeable with such knowledge.").

27. *Hotaling*, 118 F.3d at 202.

28. *Id.* at 203.

29. *Id.*

30. *Id.*

31. *Id.* ("When a public library adds a work to its collection, lists the work in its index or catalog system, and makes the work available to the borrowing or browsing public, it has completed all the steps necessary for distribution to the public.").

32. *Id.*

C. The RIAA's Statutory Arguments in Support of the "Making Available" Doctrine

Given the lack of justification for the introduction of the "making available" doctrine in the *Hotaling* opinion, it is instructive to consider its possible basis in the Copyright Act. "Distribution" is not defined in the Act itself other than by the language of § 106(3),³³ and the "making available" language is not included in the Act with regard to the distribution right. In the file-sharing context, the RIAA has advanced three statutory arguments in favor of equating "distribution" in § 106(3) with "making available." Before considering the development of the jurisprudence since *Hotaling*, it is worth considering each argument individually.

1. Does the Plain Meaning of "Distribute" Encompass the "Making Available" Right?

The first argument proposed by the RIAA is that the exclusive right of distribution inherently encompasses the "making available" doctrine.³⁴ In other words, if a file-sharer makes a file available to be downloaded online, then he has violated the distribution right by "invading the sphere of activity that Section 106 gives the copyright owner the exclusive right to control."³⁵ Such an argument is nonsensical when the language of § 106(3) is considered in full.³⁶ The exclusive right is the right to distribute copies of the work "by sale or other transfer of ownership, or by rental, lease, or lending."³⁷ Clearly then, some transfer of possession of a copy is required, otherwise there is no distribution. Under a plain reading of the statute, if no actual distribution has occurred, there is no infringement. In our prototypical scenario, there is only ever one authorized copy on the file-sharer's computer; before there can be a distribution, *someone* must make a copy of the original, authorized copy.³⁸

33. See 17 U.S.C. §§ 101, 106(3) (2006).

34. See Plaintiffs' Supplemental Brief Pursuant to May 15, 2008 Order at 8, *Capitol Records Inc. v. Thomas*, No. 06-1497 (MJD/RLE) (D. Minn. June 30, 2008) [hereinafter *Thomas* RIAA Brief], available at http://www.eff.org/files/filenode/capitol_v_thomas/Thomas%20-%2020080630%20Plfs%20brief.pdf.

35. *Id.*

36. See, e.g., *Thomas* Retrial Order, *supra* note 11, at 14 (dismissing the plain language argument with very little discussion).

37. 17 U.S.C. § 106(3).

38. Brief Amici Curiae of Electronic Frontier Foundation et al. in Support of Defendant Jammie Thomas at 3, *Capitol Records Inc. v. Thomas*, No. 06-1497 (MJD/RLE) (D. Minn. June 20, 2008) [hereinafter *Thomas* EFF Brief], available at http://www.eff.org/files/filenode/capitol_v_thomas/20080620EFFAmiciBrief.pdf.

2. Is “Distribution” Synonymous with “Publication”?

The RIAA’s second statutory argument is that the term “distribution,” although not itself defined in the Act, is synonymous with the term “publication,” which *is* defined in the Act to include “offer[s] to distribute.”³⁹ The RIAA then equates the making available of a file by a file-sharer with an “offer to distribute” and thus a violation of the exclusive right of distribution.⁴⁰

As a simple examination of the definitions of “distribution” and “publication” demonstrates, the RIAA’s attempt to equate the two terms falls flat. Section 101 defines “publication” as follows:

“Publication” is the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.⁴¹

Compare this definition with that of the exclusive right of “distribution” defined in § 101:

[T]he owner of copyright . . . has the exclusive rights to do or authorize any of the following: . . . (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending.⁴²

To the extent that distribution is defined when it is introduced in § 106, the definition is indeed identical to the first sentence of the definition of “publication” in § 101. There is no doubt that the “publication” definition *includes* “distribution.” The RIAA, however, argues that “distribution” *equals* “publication,” which cannot be the case because the “publication” definition includes both “distribution” and “offering to distribute.” Since “offering to distribute” is not a nullity, the two terms logically cannot be equated.

The RIAA cites various authorities to suggest “publication” and “distribution” are equivalent and interchangeable. In *Harper & Row*,

39. 17 U.S.C. § 101; *see, e.g., Thomas RIAA Brief, supra* note 34, at 12–15.

40. *See Thomas RIAA Brief, supra* note 34, at 15.

41. 17 U.S.C. § 101.

42. *Id.* at § 106(3).

Publishers, Inc. v. Nation Enterprises,⁴³ a case concerning traditional first publication rights and fair use, the Supreme Court described the distribution right as a “distinct statutory right of first publication.”⁴⁴ The Court cited House Report 1476 as legislative history in support of its interpretation: “Clause (3) of section 106, establishes the exclusive right of publications Under this provision the copyright owner would have the right to control the first public distribution of an authorized copy . . . of his work.”⁴⁵ The Court used the term “publication” in the traditional sense — the defendant in *Harper & Row* had published (i.e., printed and sold widely) excerpts of President Ford’s diaries in the magazine *The Nation*.⁴⁶ Although the Court’s reasoning does equate distribution with the exclusive right of publication, House Report 1476 is not discussing the novel, technical definition of “publication” that the 1976 Act introduced. Such usage does not implicate an offer to distribute. The “distribution” right is referred to as the “publication” right in House Report 1476, but only in the traditional sense of the word.

Helpfully, House Report 1476 later clarifies the technical definition of “publication” the Act was introducing.⁴⁷ In the section discussing the duration of copyright, House Report 1476 explicitly states that under the new law “‘publication’ would no longer play the central role assigned to it under the [pre-1976] law.”⁴⁸ Instead, “publication” would have significance under other provisions in the Act, “including those on Federal preemption and duration.”⁴⁹ The “offer to distribute” language is included in the definition for one very specific purpose — to limit the duration of copyright in special kinds of works. Whereas copyright protection generally subsists for the “life of the author and 70 years after the author’s death,” it exists “in the case of an anonymous work, a pseudonymous work, or a work made for hire . . . for a term of 95 years from the year of its first publication, or a term of 120 years from the year of its creation, whichever expires first.”⁵⁰ Discussing this section of the Act, House Report 1476 explains that the definition of publication “also makes clear that, when copies or phonorecords are *offered* to a group of wholesalers, broadcasters, motion picture theaters, etc., publication takes place if the purpose is

43. 471 U.S. 539 (1985).

44. *Id.* at 552 (noting that the distribution right was introduced in the Copyright Act of 1976 and that prior to 1976, any right of publication was a common law right only).

45. *Id.* (quoting H.R. REP. NO. 94-1476, at 62 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5674 (alteration in original)).

46. *Id.* at 543.

47. H.R. REP. NO. 94-1476, at 138, *reprinted in* 1976 U.S.C.C.A.N. at 5754.

48. *Id.*

49. *Id.*

50. 17 U.S.C. § 302(a), (c) (2006).

‘further distribution, public performance, or public display.’”⁵¹ In other words, Congress *deliberately* limited the term “publication” in its application under the Act (with the traditional right having been replaced by “distribution”); the “offering to distribute” language is included simply to start the timer running for purposes of anonymous work copyright duration.⁵² The RIAA’s interpretation, and that of any court that has equated publication with distribution, is inherently flawed: the exclusive right in the Act was intentionally drafted using the “distribution” language, and “publication” was defined to include “offering to distribute” for a different purpose.⁵³

3. Does “Authorization” of “Distribution” Imply Primary Liability?

The RIAA’s third argument confuses the matters even further. The RIAA argues that the distribution right is violated because, in making files available on the Internet, the file-sharer is “authoriz[ing] . . . reproduction and distribution” — exclusive rights that also rest with the copyright owner.⁵⁴ Looking to standard dictionary definitions of “authorize,” the RIAA argues that file-sharers “permitted, sanctioned, enabled, and empowered [other] KaZaA users to help themselves to copies of those works.”⁵⁵

There is nothing inherently wrong with this argument, but it implicates a completely different theory of copyright liability. A file-sharer who “authorizes” another to reproduce a file may indeed be secondarily liable for the reproducer’s liability.⁵⁶ The RIAA, however, argues for the imposition of primary liability on the authorizing file-sharer, against the weight of all legislative history and judicial interpretation.⁵⁷ Indeed, the very same section of House Report 1476 that the RIAA cites when analyzing the definition of “publication” clarifies the meaning of “authorization” as it is used in § 106:

Use of the phrase ‘to authorize’ is intended to avoid any questions as to the liability of contributory in-

51. H.R. REP. NO. 94-1476, at 138, *reprinted in* 1976 U.S.C.C.A.N. at 5754 (emphasis added).

52. *See also* Brief of Copyright Law Professors as Amici Curiae in Support of Defendant at 10–13, *Capitol Records Inc. v. Thomas*, No. 06-1497 (MJD/RLE) (D. Minn. June 13, 2008), available at http://www.eff.org/files/filenode/capitol_v_thomas/20080613LawProfAmici.pdf.

53. *See, e.g., Thomas* RIAA Brief, *supra* note 34, at 9. The RIAA cited the Register of Copyrights as supporting their position, but the difficulty lies in the confusion of the vernacular use of “publication” and the reason for the specific definition as used in the Act. *See* sources cited *infra* note 111.

54. *Thomas* RIAA Brief, *supra* note 34, at 15; *see* 17 U.S.C. § 106.

55. *Thomas* RIAA Brief, *supra* note 34, at 16 (internal quotation marks and alterations omitted).

56. *See infra* Part IV.C.

57. *See infra* Part IV.C.

fringers. For example, a person who lawfully acquires an authorized copy of a motion picture would be an infringer if he or she engages in the business of renting it to others for purposes of unauthorized public performance.⁵⁸

The RIAA does not argue, however, that a file-sharer is a “contributory infringer,” because there is no question that doing so would require a showing of primary liability⁵⁹ — precisely what the RIAA is trying to avoid. Against the force of legislative history, the RIAA argues that the use of the term “authorize” will result in primary liability on the part of file-sharers. In declining to follow the RIAA’s interpretation, the First Circuit noted recently that “most (perhaps all) courts that have considered the question have taken the view that a listed infringing act (beyond authorization) is required for a claim.”⁶⁰ The RIAA has cited the very same case in its brief for the opposite proposition that “the better bare-language reading” of § 106 would be to confer a “making available” right, consigning the court’s actual holding to a footnote.⁶¹

III. CASES INTERPRETING THE “MAKING AVAILABLE” DOCTRINE

A. Supreme Court and Circuit Court “Distribution” Cases After *Hotaling*

Having discussed the main arguments surrounding the “making available” interpretation, this Note now considers the published opinions that have discussed the distribution right in the context of the distribution of an unauthorized copy. Only one Supreme Court case and two Ninth Circuit cases have touched on the doctrine, and these decisions are worth considering in detail.

Supreme Court: In *New York Times Co. v. Tasini*,⁶² the Supreme Court decided a case that bears some superficial resemblance to the prototypical file-sharing scenario. Indeed, some commentators have

58. H.R. REP. NO. 94-1476, at 61 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5674.

59. See *infra* Part IV.C.

60. *Venegas-Hernández v. Asociación de Compositores y Editores de Música Latino-Americana*, 424 F.3d 50, 57 (1st Cir. 2005) (citing 2 PAUL GOLDSTEIN, COPYRIGHT § 6.3.2, at 6:44 (2d ed. 2005)); see also 3 NIMMER & NIMMER, *supra* note 17, § 12.04[D][1] nn.415, 416 (collecting cases); 4 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 13:9 (2008).

61. *Thomas RIAA Brief*, *supra* note 34, at 16 (citing *Venegas-Hernandez*, 424 F.3d at 58); see *id.* at n.7 (describing the *Venegas* court’s reasoning as “peculiar and patently incorrect”).

62. 533 U.S. 483 (2001).

suggested that this ruling alone should be dispositive of the outcome of *Thomas* and similar cases.⁶³

In *Tasini*, the plaintiff freelance authors had written articles for print publication in defendant periodicals.⁶⁴ Without the permission of the authors, the periodicals allowed “two computer database companies [to place] copies of the freelancers’ articles . . . into three [electronic] databases.”⁶⁵ The databases were available online for subscribers to download, but neither party presented evidence that any subscribers had in fact downloaded copies of the articles.⁶⁶ Nonetheless, the Supreme Court “[held] that the Electronic Publishers infringed plaintiffs’ distribution rights absent any showing that third-party users of their databases had actually accessed or downloaded the articles at issue.”⁶⁷ Thomas Sydnor of the Progress & Freedom Foundation — an organization partly funded by record companies that submitted an amicus brief in favor of the RIAA in *Thomas* — has argued that this situation closely parallels the situation in the file-sharing cases.⁶⁸

This is an oversimplification. The Supreme Court did not consider whether plaintiffs’ distribution rights had been infringed independently of the reproduction right, as it found that merely sending copies of the articles to the database constituted reproduction in violation of the authors’ exclusive rights.⁶⁹ Indeed, the term “distribution” or a variant thereof appears twenty-five times in Justice Ginsburg’s majority opinion, and in twenty-three of those instances it is coupled with “reproduction.”⁷⁰ It is clear that the Court considered the exclusive rights to have been violated together. When Justice Ginsburg did separate the terms, she described the electronic databases themselves as “reproductions,” the sale of the articles from the databases to the

63. *E.g.*, THOMAS D. SYDNOR II, THE PROGRESS & FREEDOM FOUND., *THOMAS AND TASINI: DID THE MAKING-AVAILABLE DEBATE END BEFORE IT BEGAN?* (2008), <http://pff.org/issues-pubs/ps/2008/ps4.13thomasandtasini.pdf>.

64. *Tasini*, 533 U.S. at 487.

65. *Id.*

66. See Brief for Petitioners at 48 n.34, *Tasini*, 533 U.S. 483 (No. 00-201), 2001 WL 27573 (“In fact, far from showing that the copies in dispute were regularly used to access their individual Articles as such, at no point in this litigation did respondents ever demonstrate that, apart from their own searches, anyone had ever used the periodical copies in dispute to do so.”); see also SYDNOR, *supra* note 63, at 4.

67. SYDNOR, *supra* note 63, at 5 (citing *Tasini*, 533 U.S. at 498, 505).

68. *Id.*, (“[T]he facts in *Tasini* are closely analogous to those in the file-sharing cases.”); The Progress & Freedom Foundation, <http://www.pff.org/about/supporters.html> (last visited Dec. 19, 2008).

69. See *Tasini*, 533 U.S. at 488, 498. At oral argument, Laurence Gold, on behalf of the authors, argued that “the first act of infringement of any substance is the putting of the article files as separate article files on the Nexis database and making it available in this system to be accessed, printed out, downloaded . . .” Transcript of Oral Argument at 32, *Tasini*, 533 U.S. 483 (No. 00-201), available at http://www.supremecourtus.gov/oral_arguments/argument_transcripts/00-201.pdf.

70. See *Tasini*, 533 U.S. at 486–506.

public as "distribution," and the contracts for the licensing of such sales as "authoriz[ation]" of distribution.⁷¹

Thus, the analogy to file-sharing is flawed because the prototypical file-sharer has the legal ownership and rights to the copy he is "making available." In *Tasini*, the Court found that the existence of the database itself (then made available to the public) was infringing, as it contained unauthorized reproductions.⁷² Furthermore, Justice Ginsburg was likely not considering the implications of separating the reproduction and distribution rights in any great detail, given the insignificance to the holding in the case.

Ninth Circuit: In *A&M Records, Inc. v. Napster, Inc.*, the Ninth Circuit noted that "Napster users who upload file names to the search index for others to copy violate plaintiffs' distribution rights."⁷³ This statement appears to be squarely in line with the proposed RIAA interpretation, and the RIAA has quoted it extensively.⁷⁴ However, it is significant that the *A&M* court also collapsed its discussion of "distribution" into that of "reproduction," and thus the distribution issue was not dispositive. The case was an appeal of a preliminary injunction granted in favor of record company copyright owners and turned on issues of secondary liability.⁷⁵ Though Napster did not appeal the issue of the direct infringement of its users, the court briefly investigated whether there was direct infringement of "at least one exclusive right."⁷⁶ The court noted that the district court had found, and Napster had "pretty much acknowledged," that Napster users were uploading and downloading copyrighted music, which together clearly violate a copyright owner's reproduction and distribution rights.⁷⁷ It is likely, then, that in this short section demonstrating prima facie infringement, the court did not thoroughly consider the implications of its reasoning when it separated the Napster users' actions into uploading (described

71. *Id.* at 498. The other time the term "distribution" appears separately is in a discussion of possible models of distribution, not a legal interpretation of the term. *Id.* at 505.

72. See also The Patry Copyright Blog, Progress and Freedom Foundation Jammie Thomas Brief, <http://williampatry.blogspot.com/2008/06/progress-and-freedom-foundation-jammie.html> (June 24, 2008, 22:32 EDT) (arguing that *Tasini* has "no relevance whatsoever to the issues in *Thomas*"). It is noteworthy, however, that elsewhere in the opinion the Court notes that it would "reach the same conclusion if the Times sent intact newspapers to the Electronic Publishers" and that the case is "not ultimately about what is sent between Publishers in an intermediate step of Database production; it is about what is presented to the general public in the Databases." *Tasini*, 533 U.S. at 501 n.9.

73. *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1014 (9th Cir. 2001).

74. See *infra* Parts III.B–C.

75. See *Atl. Recording Corp. v. Howell*, 554 F. Supp. 2d 976, 982 (D. Ariz. 2008) ("The central issue in the case was secondary liability for the creators of the Napster file-sharing system.").

76. *A&M Records*, 239 F.3d at 1013. Such direct infringement is a requirement of finding secondary liability, and such a showing is required for a preliminary injunction. *Id.* at 1013 & n.2.

77. *Id.* at 1014 (citing Transcript of Proceedings, *A&M Records, Inc. v. Napster, Inc.*, Nos. 99-5183, 00-0074 (N.D. Cal. July 26, 2000), 2000 WL 1009483).

as “distribution”) and downloading (described as “reproduction”).⁷⁸ As in *Tasini*, the court considered both exclusive rights to have been infringed, and thus did not need to clarify the elements of the distribution right; reproduction was obvious and apparent.

Six years later, Judge Ikuta of the Ninth Circuit revisited these cases in *Perfect 10, Inc. v. Amazon.com, Inc.*⁷⁹ First, the court quoted the district court in its reasoning “that distribution requires an ‘actual dissemination’ of a copy,” and noted that such reasoning was “consistent with the language of the Copyright Act.”⁸⁰ In dicta, however, Judge Ikuta went on to interpret *Hotaling* and *A&M Records* as having introduced a “deemed distribution” rule.⁸¹ She reasoned that *Hotaling* stood for the proposition that “the owner of a collection of works who makes them available to the public may be deemed to have distributed copies of the works,”⁸² and that, similarly, “the distribution rights of the plaintiff copyright owners were infringed by Napster users . . . when they used the Napster software to make their collections available to all other Napster users.”⁸³ Nonetheless, the *Perfect 10* court found that the “deemed distribution” rule did not support a finding of distribution infringement because there the defendant did not itself communicate the images to the end-user; rather, it catalogued them and enabled the end-user to obtain the image directly from the copyright owner’s server.⁸⁴ Judge Ikuta’s unnecessary dicta espousing the “deemed distribution” rule was the first time the theory was solidified, and she likely finessed the position simply to distinguish the situation the court was facing without fully considering the ramifications of her reasoning.⁸⁵

In summary, the appellate courts have done little to explain the purpose of or justification for the “making available” doctrine. It was introduced in *Hotaling* in a different context from file-sharing with little statutory basis, likely motivated by sympathy for the plaintiff, against whom the statute of limitations had run on a clear cause of action.⁸⁶ *Tasini* and *A&M Records* each only discussed distribution apart from reproduction briefly and in dicta, and *Perfect 10* tried to make sense of these decisions by refining the doctrine further to dis-

78. *Id.*

79. 487 F.3d 701 (9th Cir. 2007).

80. *Id.* at 718 (citing *Perfect 10, Inc. v. Amazon.com, Inc.*, 416 F. Supp. 2d 828, 844 (C.D. Cal. 2006)).

81. *Id.* at 718–19.

82. *Id.* (citing *Hotaling v. Church of Jesus Christ of Latter-Day Saints*, 118 F.3d 199, 203 (4th Cir. 1997)).

83. *Id.* at 719 (citing *A&M Records*, 239 F.3d at 1011–14) (emphasis omitted).

84. *Id.*

85. *Id.* at 718 (finding likely infringement of the public display right). Only one other court has discussed the “deemed distribution” rule, and even then only at the preliminary injunction stage. See *Fonovisa, Inc. v. Does 1–9*, No. 07-1515, 2008 WL 919701, at *2 (W.D. Pa. Apr. 3, 2008); see also *infra* note 113 and accompanying text.

86. See *Hotaling*, 118 F.3d at 205; see also *supra* notes 23–32 and accompanying text.

tinguish them.⁸⁷ No Supreme Court or circuit court case has addressed the “making available” doctrine in any detail with respect to file-sharing. As a result, district courts have been left to decide how to interpret the doctrine.

B. District Court Decisions Prior to 2008

One of the first district courts to consider the “making available” doctrine and its applicability to file-sharing was the Southern District of New York in the 2002 case, *Arista Records, Inc. v. MP3Board, Inc.*⁸⁸ The RIAA moved for summary judgment against the defendant website operator on secondary liability grounds, but the court denied the motion. In doing so, the court noted that there was a material issue of fact as to the question of primary infringement on the part of MP3Board’s users, stating that “the record companies must show that an unlawful copy was disseminated ‘to the public.’”⁸⁹ The court distinguished *Hotaling* on the grounds that, in that case, it was impossible to prove use by the public because the library had not kept records of use, whereas the record companies in *MP3Board* failed to show that they did not have access to such data.⁹⁰

In 2005, the District Court for the Northern District of California decided *In re Napster, Inc. Copyright Litigation*,⁹¹ a case decided after the Ninth Circuit’s *A&M Records v. Napster* preliminary injunction opinion discussed above.⁹² This opinion was the first to discuss the “making available” doctrine as applied to file-sharing at length. The court first distinguished *Hotaling* on factual grounds and criticized its reasoning. The opinion noted that in *Hotaling*, it was uncontroverted that the library had an infringing copy in its possession, whereas in the case at bar, “[t]he infringing works never resided on the Napster system”; it was in fact the Napster users who uploaded and downloaded the copies.⁹³ Beyond this, the court criticized *Hotaling* as contrary to authority and “inconsistent with the text and legislative history of the Copyright Act.”⁹⁴ The court agreed that “distribution” was equated with “publication” under the 1976 Act but recognized the limit imposed by the definition of “publication”: an offer to distribute is only publication (and thus an infringing act in the court’s view) if made

87. See *supra* notes 62–85 and accompanying text.

88. No. 00 Civ. 4660 (SHS), 2002 WL 1997918 (S.D.N.Y. Aug. 29, 2002).

89. *Id.* at *4 (citing *Hotaling*, 118 F.3d at 203 and *A&M Records*, 239 F.3d at 1014). Secondary liability requires a finding of primary liability. See *id.* at *3; *infra* Part IV.C.

90. *MP3Board*, 2002 WL 1997918, at *4.

91. 377 F. Supp. 2d 796 (N.D. Cal. 2005).

92. See *supra* notes 73–78 and accompanying text. Following the Ninth Circuit decision and the preliminary injunction that resulted, Napster ceased operating and sought bankruptcy. See *In re Napster*, 377 F. Supp. 2d at 799.

93. *In re Napster*, 377 F. Supp. 2d at 803.

94. *Id.*

with the intention of “further distribution, public performance, or public display.”⁹⁵ Thus, the court did not equate publication with the act of “making available” a file on a networked computer, as in our prototypical case.

In 2007, four district court opinions were issued, each denying the defendants’ motions to dismiss.⁹⁶ The file-sharer in each case argued that there could be no liability, as the RIAA had not demonstrated sufficiently that works were actually disseminated to the public.⁹⁷ In *Interscope Records v. Duty*, the District Court of Arizona noted that “distribute” is not defined under the Copyright Act, but found that it is “synonymous with the right of publication.”⁹⁸ Citing the Ninth Circuit *A&M Records* decision, the court concluded by noting that “the mere presence of copyrighted sound recordings in Duty’s share file *may* constitute copyright infringement,”⁹⁹ effectively as an offer to distribute. Nevertheless, the court stressed that its decision was not final, as it had “an incomplete understanding of the [KaZaA] technology at [that] stage” in the proceedings.¹⁰⁰

Following similar logic, the Western District of Texas also refused to “rule out” the possibility of the “making available” doctrine in *Warner Brothers Records, Inc. v. Payne*.¹⁰¹ The court distinguished *In re Napster* on the grounds that in *Payne* the defendant had the infringing copies on his computer, and it disagreed with *MP3Board* in that the court thought that proving the existence of file-sharing may be as difficult as in *Hotaling*.¹⁰² Once again, however, the court noted that “a more detailed understanding of the [KaZaA] technology [was] necessary.”¹⁰³

The Northern District of Texas in *Fonovisa, Inc. v. Alvarez* added little to the analyses of these courts, citing prior opinions and noting that “at this stage of the proceedings, Plaintiff’s ‘making available’

95. *Id.* at 804 (finding that “publication” occurs when “‘further distribution, public performance, or public display’ is ‘contemplated’”); see 17 U.S.C. § 101 (2006).

96. See *Arista Records LLC v. Greubel*, 453 F. Supp. 2d 961, 972 (N.D. Tex. 2006); *Fonovisa, Inc. v. Alvarez*, No. 1:06-CV-011-C ECF, 2006 WL 5865272, at *4 (N.D. Tex. July 24, 2006); *Warner Bros. Records, Inc. v. Payne*, No. W-06-CA-051, 2006 WL 2844415, at *4 (W.D. Tex. July 17, 2006); *Interscope Records v. Duty*, No. 05-CV-3744-PHX-FJM, 2006 WL 988086, at *5 (D. Ariz. Apr. 14, 2006).

97. E.g., *Duty*, 2006 WL 988086, at *2.

98. *Id.* (citing *Ford Motor Co. v. Summit Motor Prod., Inc.*, 930 F.2d 277, 299 (3d Cir. 1991)); see *supra* Part II.C.2.

99. *Duty*, 2006 WL 988086, at *2 (emphasis added).

100. *Id.* at *2 n.3.

101. 2006 WL 2844415, at *4.

102. *Id.* at *3 (“Additionally, the same evidentiary concerns that were present in *Hotaling* are also present in a case involving peer-to-peer file sharing programs As Plaintiffs note, “[p]iracy typically takes place behind closed doors and beyond the watchful eyes of a copyright holder.”) Cf. *supra* note 86 and accompanying text.

103. *Warner Bros. Records, Inc. v. Payne*, No. W-06-CA-051, 2006 WL 2844415, at *4 (W.D. Tex. July 17, 2006).

theory *may* impose a possible ground for liability.”¹⁰⁴ Three months later, the same court referenced the aforementioned decisions in *Arista Records LLC v. Greubel*.¹⁰⁵ Observing that the facts were closer to *Hotaling, Duty, Payne, and Alvarez* than *In re Napster*, the court once again declined to grant defendant’s motion to dismiss while reserving judgment on the “making available” doctrine.¹⁰⁶

None of these cases resulted in further litigation, indicating that the file-sharers most likely settled out of court after their motions to dismiss were denied.¹⁰⁷ By not dismissing the “making available” doctrine outright, these districts may have suggested to the RIAA that the doctrine had traction and allowed it to build a list of precedents it could reference in later cases.

The first district court to explicitly uphold the “making available” doctrine with regard to file-sharing was the District of Maine in *Universal City Studios Productions LLLP v. Bigwood*.¹⁰⁸ The analysis, however, was brief, and the issue was not dispositive on the outcome of the case, as the court found evidence of both reproduction and distribution.¹⁰⁹ The court simply paralleled the sparse reasoning of *A&M Records v. Napster*, finding that the defendant had violated the reproduction right by downloading files and had violated the distribution right by uploading files and making them available.¹¹⁰

The only other district court to indicate distinct approval of the “making available” doctrine was the Eastern District of Pennsylvania in *Motown Record Co. v. DePietro*, where the court in dicta discussed the doctrine:

While neither the United States Supreme Court nor the Third Circuit Court of Appeals has confirmed a copyright holder’s exclusive right to make the work available, the Court is convinced that 17 U.S.C. § 106 encompasses such a right based on its reading of the statute, the important decision in [*A&M Records v. Napster*] and the opinion offered by the Register of Copyrights, Marybeth Peters, in a letter

104. No. 1:06-CV-011-C ECF, 2006 WL 5865272, at *2 (N.D. Tex. July 24, 2006).

105. 453 F. Supp. 2d 961 (N.D. Tex. 2006).

106. *Id.* at 968–72.

107. *See, e.g.*, Joint Stipulation of Dismissal with Prejudice, *Greubel*, 453 F. Supp. 2d 961 (No. 4:05–CV–531–TRM), 2007 WL 605532.

108. 441 F. Supp. 2d 185, 190–91 (D. Me. 2006).

109. *Id.*

110. *Id.* (citing *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1014 (9th Cir. 2001); *Hotaling v. Church of Jesus Christ of Latter-Day Saints*, 118 F.3d 199, 203 (4th Cir. 1997)); *see supra* notes 73–78 and accompanying text.

related to Congressional hearings on piracy of intellectual property on peer-to-peer networks.¹¹¹

C. District Court Decisions in 2008

In late 2007, then, most of the district court cases appeared to rule favorably for the RIAA, either because they left open the possibility of the “making available” doctrine or explicitly supported it, albeit in dicta.¹¹² However, in the first four months of 2008, six further district court opinions were handed down that considered the “making available” doctrine. Two of the opinions favored the RIAA’s position, one of which was another denial of a defendant’s motion to dismiss in line with *Duty*, *Payne*, *Alvarez*, and *Greubel*.¹¹³ The other opinion is the most favorable towards the RIAA to date: the Southern District of Texas’s opinion in *Atlantic v. Anderson* for the first time granted summary judgment in favor of the RIAA when it failed to show that any files had in fact been transferred.¹¹⁴ The court did not engage in a thorough analysis, rather it simply accepted the argument that “distri-

111. *Motown Record Co. v. DePietro*, No. 04-CV-2246, 2007 WL 576284, at *3 (E.D. Pa. Feb. 16, 2007) (citing Letter from Marybeth Peters, Register of Copyrights, to Representative Howard L. Berman, Representative from the 28th Dist. of Cal. (Sept. 25, 2002)). The court denied the record company’s motion for summary judgment on the grounds that it had not sufficiently identified the plaintiff as the infringing user. *Id.* A number of other courts have noted that opinion letters from the Copyright Office are not binding. *See, e.g., Thomas Retrial Order*, *supra* note 11, at 15.

112. A number of other cases touched on the “making available” doctrine even more remotely; for example, by noting that district courts had divergent views on the doctrine but declining to express an opinion, or by grouping the reproduction and distribution rights together. *See, e.g., Interscope Records v. Leadbetter*, No. C05-1149-MJP-RSL, 2007 WL 1217705, at *3-4 (W.D. Wash. Apr. 23, 2007) (“[T]he Court does not need to reach the issue of whether defendant’s listing the file names . . . constitutes direct copyright infringement under § 106(3), because plaintiffs have submitted proof showing that at least 8 of the copyrighted files were actually disseminated”); *Sony Pictures Home Entm’t Inc. v. Lott*, 471 F. Supp. 2d 716, 722 (N.D. Tex. 2007) (noting that the defendant had both downloaded and uploaded files and thus violated *both* the reproduction and distribution rights); *Maverick Recording Co. v. Goldshteyn*, No. CV-05-4523 (DGT), 2006 WL 2166870, at *3 (E.D.N.Y. July 31, 2006) (“[T]he ‘making available’ argument need not be decided here.”). The *Lott* court did, however, impose an injunction on the defendant, enjoining him from “mak[ing] any of plaintiffs’ copyrighted motion pictures available for distribution to the public.” *Lott*, 471 F. Supp. 2d at 724. Even though this court did not analyze or explicitly endorse the “making available” doctrine, and the pro se defendant in the case did not raise the issue as a possible defense, the RIAA has still used it as support for the argument. *See, e.g., Plaintiffs’ Memorandum of Law in Opposition to Motion by Defendant Doe #3 to Vacate the Order Granting Expedited Discovery, to Dismiss the Complaint, to Quash the Subpoena and to Dismiss for Improper Joinder* at 8, *Fonovisa, Inc. v. Does 1-9*, No. 07-1515 (W.D. Pa. Mar. 5, 2008), 2008 WL 2141905.

113. *Fonovisa Inc. v. Does 1-9*, No. 07-1515, 2008 WL 919701, at *2 (W.D. Pa. Apr. 3, 2008) (“Determination of whether a ‘distribution’ occurred, however, depends on the factual circumstances of the case. At this stage of the litigation, the Court finds that Plaintiffs have alleged sufficient facts regarding ‘distribution,’ which must be taken as true”); *see also supra* notes 96-106 and accompanying text.

114. *Atl. Recording Corp. v. Anderson*, No. H-06-3578, 2008 WL 2316551, at *7-8 (S.D. Tex. Mar. 12, 2008).

bution” was synonymous with “publication,” before citing *A&M Records v. Napster* in support of the proposition that “availing unauthorized copies of sound recordings for download using an online file-sharing system (such as a peer-to-peer network, as is the case here) constitutes an offer to distribute those works, thereby violating a copyright owner’s exclusive right to distribution.”¹¹⁵ This analysis stretches the reasoning in *A&M Records v. Napster*, a decision which, as Part II.C of this Note demonstrates, did not consider the reproduction right separately from the distribution right or the “making available” doctrine.¹¹⁶ One likely reason for the court’s failure to address contrary precedents and arguments regarding the “making available” doctrine was the defendant’s failure to raise the issue in his brief.¹¹⁷ Regardless of the quality of the defendant’s representation, however, the RIAA now has a seemingly strong precedent on which it can rely — and rely it does.¹¹⁸

Nevertheless, in February 2008, the first decision since *In re Napster* was handed down that considered and rejected all the theories proposed by the RIAA regarding the “making available” doctrine.¹¹⁹ The District Court of Connecticut, denying the RIAA’s motion for a default judgment, noted that the allegation of infringement based on the “making available” doctrine was “problematic” because, “without actual distribution of copies . . . there is no violation [of] the distribution right.”¹²⁰

On March 31, 2008, two further opinions were issued, both of which rejected the “making available” doctrine.¹²¹ The Southern District of New York, in *Elektra Entertainment Group, Inc. v. Barker*, accepted the RIAA’s argument that “distribution” and “publication” are synonymous, but declined to equate the “making available” doctrine with “offering to distribute” copies “to a group of persons for purposes of further distribution.”¹²² The court observed that, in introducing the “making available” doctrine, the *Hotaling* court “did not

115. *Id.* at *7 (citing *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1014 (9th Cir. 2001)).

116. See *supra* notes 73–78 and accompanying text.

117. See Defendant Abner Anderson’s Response to Plaintiffs’ Motion for Summary Judgement [sic] and Brief in Support, *Atl. Recording Corp. v. Anderson*, No. H-06-3578 (S.D. Tex. Jan. 30, 2008), 2008 WL 887881.

118. See, e.g., *Thomas* RIAA Brief, *supra* note 34, at 15 (quoting *Anderson*, 2008 WL 2316551, at *8 for the proposition that it is “self-evident that placing works in a shared folder . . . constituted a distribution” (internal quotation marks omitted)).

119. *Atl. Recording Corp. v. Brennan*, 534 F. Supp. 2d 278 (D. Conn. 2008).

120. *Id.* at 282 (quoting 4 PATRY, *supra* note 60, at § 13:9). The court also cited *Perfect 10* in its favor without explaining the discrepancy. *Id.* (citing *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1162 (9th Cir. 2007)); see *supra* notes 79–85 and accompanying text.

121. *Elektra Entm’t Group, Inc. v. Barker*, 551 F. Supp. 2d 234 (S.D.N.Y. 2008); *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153 (D. Mass. 2008).

122. *Barker*, 551 F. Supp. 2d at 241.

cite any precedent” and was “apparently motivated by equitable principles.”¹²³ Further, considering the definition of “publication” in depth, the court noted that the RIAA did not allege as part of its “making available” theory that there was an offer to distribute “for purposes of further distribution.”¹²⁴ Even after accepting the erroneous publication-distribution interchangeability theory, the court still did not accept the “making available” doctrine.¹²⁵ The court also agreed with the argument set forth in Part II.C.3 of this Note that “Section 106 does not create an infringeable right of authorization independent of the expressly enumerated rights” in that section.¹²⁶

The same day, the District Court of Massachusetts, in *London-Sire Records, Inc. v. Doe 1*, considered whether the RIAA had made a prima facie case of actionable harm with its “making available” theory.¹²⁷ The court discounted two of the RIAA’s arguments. First, it rejected the RIAA’s “authorization” argument on the grounds that it only applies to contributory infringers.¹²⁸ Second, it pointed out that, contrary to the Fifth Circuit’s reasoning in *Hotaling*, “[m]erely because the defendant has ‘completed all the steps necessary for distribution’ does not necessarily mean that a distribution has actually occurred. It is a ‘distribution’ that the statute plainly requires.”¹²⁹ Judge Gertner then thoroughly analyzed the RIAA’s publication-distribution argument and rejected it on the grounds that a plain-reading of the statute necessitates that the terms have different meanings.¹³⁰

On April 29, 2008, the District Court of Arizona handed down *Atlantic Recording Corp. v. Howell*, which contained the most thorough analysis of the issues to date.¹³¹ The court dismissed the arguments surrounding the Ninth Circuit precedents of *A&M Records* and *Perfect 10*, noting those cases’ approval of *Hotaling* to be “cursory,” and instead agreed “with the great weight of authority that § 106(3) is not violated unless the defendant has actually distributed an unauthorized copy of the work to a member of the public.”¹³² Citing authority for

123. *Id.* at 243.

124. *Id.* at 244–45.

125. *Id.* at 241; see *supra* Part II.C.2; see also The Patry Copyright Blog, The Recent Making Available Cases, <http://williampatry.blogspot.com/2008/04/recent-making-available-cases.html> (Apr. 3, 2008, 22:29 EDT) (contrasting *Brennan*, *London-Sire*, *Barker*, and disapproving of the *Barker* court’s acceptance of the publication-distribution interchangeability theory).

126. *Barker*, 551 F. Supp. 2d at 246–47. Nonetheless, the *Brennan* court denied the file-sharer defendant’s motion to dismiss because “Plaintiffs have adequately alleged that . . . Defendant distributed Plaintiffs’ copyrighted works.” *Id.* at 245.

127. *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153 (D. Mass. 2008).

128. *Id.* at 166.

129. *Id.* at 168.

130. *Id.* at 168–69.

131. *Atl. Recording Corp. v. Howell*, 554 F. Supp. 2d 976, 981–87 (D. Ariz. 2008).

132. *Id.* at 983; see *id.* at 982–83.

the proposition that the “use of different words or terms within a statute demonstrates that Congress intended to convey a different meaning for those words,” the court refused to equate “distribution” with “publication.”¹³³ Finally, the court dismissed the “authorization” argument, noting that “distribution” might not be the correct exclusive right to consider in the infringement analysis.¹³⁴ Rather, the court indicated that it might favor secondary liability for a file-sharer who simply makes available a file and the means for copying it to other users.¹³⁵

D. Capitol Records Inc. v. Thomas

Despite many actions before and after, only one case brought by the RIAA against an individual alleged file-sharer ever reached the stage of a jury trial and judgment. On October 4, 2007, after hearing two days of testimony and deliberating for nearly five hours, a jury sitting in the District Court of Minnesota awarded \$220,000 in favor of a group of record companies that brought suit against Jammie Thomas.¹³⁶ The jury found that Thomas willfully infringed the copyright of 24 songs and awarded damages of \$9250 per song.¹³⁷ The case received national and international press attention¹³⁸ and was heralded as setting a number of precedents in favor of the RIAA.¹³⁹ With regard to the “making available” doctrine, one commentator noted that the “RIAA did not have to prove that others downloaded the files. That was a big bone of contention that U.S. District Judge Michael Davis settled in favor of the industry.”¹⁴⁰

In summarizing the case, Chief Judge Davis issued the following jury instruction, which closely paralleled an instruction the RIAA had proposed: “The act of making copyrighted sound recordings available for electronic distribution on a peer-to-peer network, without license from the copyright owners, violates the copyright owners’ exclusive right of distribution, regardless of whether actual distribution has been shown.”¹⁴¹ Thomas moved for a retrial on grounds that the jury award

133. *Id.* at 985 (citing *Padash v. INS*, 358 F.3d 1161, 1169 n.7 (9th Cir. 2004)).

134. *Id.* at 986 (“The recording companies . . . have not proved that a KaZaA user who places a copyrighted work into the shared folder distributes a copy of that work when a third-party downloads it.”).

135. *Id.* at 986–87; see *infra* Part IV.C.

136. See, e.g., Kravets, *supra* note 1.

137. See sources cited *supra* note 1.

138. See, e.g., Sarah McBride, *Music File-Sharing Decision to Have Broad Impact*, WALL ST. J., Aug. 15, 2008, at B4; The search “Jammie /3 Thomas” receives 164 hits on a Westlaw ALLNEWS search for the period between October 1, 2007 and October 8, 2007.

139. E.g., Kravets, *supra* note 1.

140. *Id.*

141. *Thomas* Jury Instructions, *supra* note 5. The instruction submitted by the RIAA was: “The act of distributing and/or making copyrighted sound recordings available for electronic distribution on a peer-to-peer network, without license from the copyright owners, violates

was excessive.¹⁴² However, on May 15, 2008, Chief Judge Davis issued an order stating that he was considering an alternative ground for a new trial — that the jury instruction may have been contrary to precedent.¹⁴³ In response, the MPAA and the Progress & Freedom Foundation submitted amicus briefs in favor of the RIAA; the Intellectual Property Institute, the Electronic Frontier Foundation, and a group of well regarded law professors submitted briefs in favor of Thomas.¹⁴⁴ On September 24, 2008, Chief Judge Davis issued a memorandum of law and order granting a retrial.¹⁴⁵ The opinion thoroughly analyzed the arguments considered in this Note, and Chief Judge Davis decided each in favor of the plaintiff.¹⁴⁶ Chief Judge Davis then proceeded to “take [the] opportunity to implore Congress to amend the Copyright Act to address liability and damages in peer-to-peer network cases.”¹⁴⁷ He argued that it was a “farce” to equate a file-sharer’s actions with those of a corporate actor benefiting from copyright infringement.¹⁴⁸ Statutory damages of the magnitude imposed by his jury were “unprecedented and oppressive.”¹⁴⁹ The RIAA has appealed the decision to the Eight Circuit, urging resolution of the “split in authority.”¹⁵⁰

the copyright owners’ exclusive right of distribution, regardless of whether actual distribution has been shown.” Defendant’s Second Memorandum of Law in Support of Her Motion for New Trial at 2–3, *Capitol Records Inc. v. Thomas*, No. 06-1497 (MJD/RLE) (D. Minn. June 30, 2008) [hereinafter *Thomas* Defendant Brief], available at http://www.eff.org/files/filenode/capitol_v_thomas/Thomas%20-%2020080630%20Thomas%20brief.pdf (quoting Plaintiff’s Instructions Submission, Docket No. 61).

142. Defendant’s Motion for New Trial, or in the Alternative, for Remittitur, *Capitol Records Inc. v. Thomas*, No. 06-1497 (MJD/RLE) (D. Minn. Oct. 15, 2007), 2007 WL 4586690, available at http://www.ilrweb.com/viewILRPDF.asp?filename=virgin_thomas_071015MotiontoSetAsideVerdict.

143. *Thomas* Retrial Order, *supra* note 11, at 2–3. Judge Davis cited *National Car Rental System, Inc. v. Computer Associates International, Inc.*, 991 F.2d 426, 434 (8th Cir. 1993) and *Atlantic Recording Corp. v. Howell*, 554 F. Supp. 2d 976, 983 (D. Ariz. 2008). *National Car Rental* contains language that seems on point: “[i]nfringement of [the distribution right] requires an actual dissemination of either copies or phonorecords.” 991 F.2d at 434 (quoting 2 NIMMER ON COPYRIGHT, *supra* note 17, § 8.11[A], at 8-124.1 (alteration in original)). However, as with many of the cases the RIAA cites, the context of *National Car Rental* is very different — there, the court considered whether the unauthorized use of software is distribution. In that case, there was only one copy of the software at issue, and it was argued that its *use* was distribution.

144. See Electronic Frontier Foundation, *Capitol v. Thomas*, <http://www.eff.org/cases/capitol-v-thomas> (last visited Dec. 19, 2008) (collecting court filings); Ray Beckerman, *Recording Industry vs. The People*, http://recordingindustryvspeople.blogspot.com/2007/01/index-of-litigation-documents.html#Virgin_v_Thomas (last visited Dec. 19, 2008) (collecting additional court filings).

145. *Thomas* Retrial Order, *supra* note 11.

146. *Id.* at 12–37.

147. *Id.* at 41.

148. *Id.* at 41–42.

149. *Id.* at 43.

150. Plaintiffs’ Memorandum in Support of Motion to Certify September 24 Order for Interlocutory Appeal and for Stay of Proceedings Pending Appeal at 1, *Capitol Records Inc. v.*

IV. ALTERNATIVES TO THE “MAKING AVAILABLE” DOCTRINE

A. *There Is No Justification for the Survival of the “Making Available” Doctrine*

Part II of this Note demonstrates that, despite the RIAA’s contentions to the contrary, there is no basis of statutory interpretation on which to argue that the exclusive right of distribution supports the “making available” doctrine. The argument equating “distribution” with “publication” as defined in § 101 has had the most success in the courts,¹⁵¹ but as Part II.C.2 demonstrates, this is contrary to the plain reading of the statute and legislative history. Part III illustrates that the appellate court decisions either adopted the RIAA’s flawed reasoning or failed to make critical factual distinctions, and that the district courts are split on this issue.

Though courts ruling at the preliminary injunction phase generally reserved judgment on the “making available” doctrine, the majority of courts that have reached a decision on the issue have now declined to follow the RIAA’s interpretation. In citing support for its arguments, the RIAA goes to great lengths to stretch the interpretation of both the Copyright Act and judicial precedent. For example, when citing authority for the “making available” jury instruction at issue in *Thomas*, the RIAA cited three cases in addition to *A&M Records* and *Hotaling*:¹⁵² (1) the lower court decision in *Atlantic v. Howell*, which has since been reversed on this very issue;¹⁵³ (2) *Sony Music Inc., v. Scott*, an opinion that is not available on Westlaw, Lexis, PACER, or the Southern District of New York website;¹⁵⁴ and (3) *BMG Music v. Gonzalez*, a Seventh Circuit case from 2005 in which the court noted that “people who post or download music files are primary infringers.”¹⁵⁵ In *Gonzalez*, however, the court did not consider a “making available” argument at all — indeed, the file-sharer in the suit admitted to having downloaded the files, so neither reproduction nor distribution was at issue.¹⁵⁶ This once again demonstrates the RIAA’s habit of using dicta out of context to support its positions. The thoughtful nature of Chief Judge Davis’s order granting a retrial in *Thomas* may

Thomas, No. 06-1497 (MJD/RLE) (D. Minn. Oct. 14, 2008), available at <http://blog.wired.com/27bstroke6/files/jammieappeal.pdf>.

151. See *supra* Parts III.A–C.

152. *Thomas* Defendant Brief, *supra* note 141, at 3 (quoting Plaintiff’s Instructions Submission, Docket No. 61).

153. See *supra* notes 131–35 and accompanying text.

154. The case is cited as *Sony Music Entertainment Inc. v. Scott*, No. 1:03-CV-6886 (BSJ) (S.D.N.Y. Jan. 3, 2006). *Thomas* Defendant Brief, *supra* note 141, at 3 (quoting Plaintiff’s Instructions Submission, Docket No. 61).

155. 430 F.3d 888, 889 (7th Cir. 2005).

156. *Id.* (explaining that the defendant admitted to having downloaded copyrighted material but claimed fair use).

finally put a stop to the adoption by various district courts of RIAA's overbroad interpretation.¹⁵⁷ The courts must stop adopting this misleading reasoning, particularly when the (often pro se) defendants do not have strong representation.

B. The Importance of Limiting the "Making Available" Doctrine

If the "making available" doctrine were accepted as put forward by the RIAA, there would be far-reaching implications for both file-sharers and other parties touched by copyright law. First, the balance would shift in favor of the RIAA, which would no longer need to prove *any* transfer of digital files. Indeed, consider a computer user on a network whose files are accidentally "shared" on the network by the network administrator or otherwise without the knowledge of the user. The computer user is not using a program such as KaZaA that indexes the files and is in no way encouraging other users to download the files; for those reasons, no download in fact takes place. Under the "making available" doctrine, however, the user in this scenario has infringed the distribution right and is liable for damages. The copyright owner could sue and elect statutory damages, in which case the court *must* impose a minimum penalty of "not less than \$200" per act of even unintentional infringement.¹⁵⁸ Furthermore, the "infringer" bears the burden of proving that such infringement was unintentional and thus subject only to the lower, yet still considerable, minimum penalty rather than the standard minimum of \$750 per act of infringement.¹⁵⁹ This formulation of the "making available" doctrine has no place in law and could not be tempered by judicial discretion at the damages stage. Once a court found that a file had been made available, the court would have no choice but to impose potentially significant damages.¹⁶⁰ The RIAA would likely respond that it would never target such unwitting file-sharers and only seeks to sue file-sharers who affirmatively and proactively share copyrighted material. Nevertheless, that is no reason to allow judicial doctrine to develop contrary to the plain meaning of the Copyright Act and in a way that

157. See, e.g., Larry Oakes, *New Trial Granted in Internet Privacy Case*, STAR TRIB., Sept. 25, 2008, at 1B; Sarah McBride, *Music File-Sharing Decision To Have Broad Impact*, WALL ST. J., Aug. 15, 2008, at B1; see also Dmitriy Tishyevich (Bradley Hamburger ed.), *Capitol Records Inc. v. Thomas: District Court Vacates Verdict & Damages in File-Sharing Copyright Infringement Case, Grants New Trial*, HARV. J.L. & TECH. DIG., Oct. 1, 2008, <http://jolt.law.harvard.edu/digest/copyright/capitol-records-inc-v-thomas>.

158. 17 U.S.C. § 504(c)(1) (2006).

159. *Id.* § 504(c)(2).

160. For example, if a defendant is found to have unintentionally committed 1000 acts of infringement by sharing the contents of his iPod — not unrealistic given the storage capacity of current-generation iPods — a judge would be forced to award a minimum of \$200,000 in statutory damages.

would leave millions of people open to billions of dollars of potential liability.

Second, the expansive “making available” doctrine could have implications far outside of the area of file-sharing. The RIAA has already launched a case against XM Satellite Radio, arguing that XM infringed certain copyrights by “distributing Plaintiffs’ copyrighted sound recordings to the public by making available and automatically disseminating to [its] subscribers copies of sound recordings contained in its satellite radio transmissions.”¹⁶¹ This is a clear attempt to avoid the difficulties involved with the statutory public performance right of musical works.¹⁶² Similarly, a group of freelance photographers who held copyrights in photographs appearing in published articles brought suit against a copyright clearing house for making available these articles for profit.¹⁶³

C. Secondary Liability Is the Appropriate Form of Liability for Infringing File-Sharers

The RIAA may argue that the prototypical file-sharer has taken “all the steps necessary for distribution to the public,” just as the *Hotaling* court found the library had done in keeping the unauthorized copy in its records.¹⁶⁴ It is crucial to remember, however, that no unauthorized copy is made until a third party copies the song from the file-sharer’s computer. At this time, the original file-sharer is taking no action other than allowing the file on his computer to be accessed. The third party initiates the copying, and the copy is made onto the third party’s computer. William Patry argues that “third parties are reaching into the individuals’ hard drive and taking an electronic file,” so the original file-sharer is perhaps liable for “contributory infringement of the reproduction right” but not primary infringement of the distribution right.¹⁶⁵ Consider a library with numerous books, a free photocopier, and a sign which reads, “Please feel free to copy as many of our books as you would like.” Though this is not conduct becoming of a library, such “making available” of books to be copied surely does not constitute distribution.

161. Complaint for Declaratory and Injunctive Relief and Damages at 15, *Atl. Recording Corp. v. XM Satellite Radio*, No. 06-CV-3733-DAB (S.D.N.Y. May 16, 2006), available at http://www.eff.org/files/filenode/digitalradio/XM_complaint.pdf.

162. See *Thomas EFF Brief*, *supra* note 38, at 13–14.

163. *Resnick v. Copyright Clearance Ctr., Inc.*, 422 F. Supp. 2d 252, 258–59 (D. Mass. 2006) (rejecting the “making available” doctrine in this context: absent evidence that copies had ever been made, plaintiffs could not prove infringement).

164. *Hotaling v. Church of Jesus Christ of Latter-Day Saints*, 118 F.3d 199, 203 (4th Cir. 1997); see also *Arista Records LLC v. Greubel*, 453 F. Supp. 2d 961, 970 (N.D. Tex. 2006) (citing *Hotaling*, 118 F.3d at 203).

165. 4 PATRY, *supra* note 60, at § 13:11.50.

The court in *Atlantic v. Howell* succinctly noted that, with regard to the KaZaA system, it was impossible “to determine conclusively . . . whether the owner of the shared folder distributes an unauthorized copy (direct violation of the distribution right), or simply provides a third party with access and resources to make a copy on their own (contributory violation of the reproduction right).”¹⁶⁶ A much more appropriate theory of liability would appear to be one of primary liability on the part of the third party (the person who retains the infringing, unauthorized copy) and secondary liability with regard to the original file-sharer (the person who has the original, authorized copy, but who enables the third party to copy it). A number of courts that have rejected the “making available” doctrine have recently begun to consider an alternate formulation.¹⁶⁷ This theory, requiring “circumstantial evidence” that reproduction has taken place in addition to evidence that the file-sharer made the file available, is certainly preferable to the pure “making available” doctrine. Even if a statistical inference was met at the preliminary stages, the file-sharer would be able to present evidence that no such reproduction ever took place, thus avoiding liability.¹⁶⁸ More importantly, it would not expose multitudes of computer users to very high minimum liability levels, merely for having inadvertently “made available” files on a computer network.

It is beyond the scope of this Note to discuss the application of secondary liability in further detail, other than to recognize that courts have consistently held that a finding of secondary liability certainly requires proof of an act of corresponding primary infringement.¹⁶⁹ The two seminal Supreme Court cases discussing secondary liability have held as much, observing that such a theory “of course requires evidence of actual infringement by [primary infringers].”¹⁷⁰

166. *Atl. Recording Corp. v. Howell*, 554 F. Supp. 2d 976, 986 (D. Ariz. 2008).

167. *See, e.g., id.* at 983–84; *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153, 169, 176–177 (D. Mass. 2008). *See generally* Kasunic, *supra* note 22 (arguing that circumstantial evidence should be used in a situation where “making available” is incapable of supporting a claim for direct infringement).

168. *See London-Sire*, 542 F. Supp. 2d at 176.

169. *See, e.g.,* 3 NIMMER & NIMMER, *supra* note 17, § 12.04[A][3][b]–[D][1] & n.415 (“[It is] in keeping with traditional notions of third party liability to confine the inquiry into whether there can be culpable participation in an infringement to those instances when such infringement has in fact occurred.”); *see also* M. Brent Byars, Recent Development, *Bouchat v. Bon-Ton Department Stores, Inc.: Claim Preclusion, Copyright Law, and Massive Infringements*, 21 HARV. J.L. & TECH. 609, 612 n.18 (2008).

170. *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 940 (2005); *see also* *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 434 (1984) (holding that, for plaintiffs to prevail under a secondary liability theory, “they have the burden of proving that users of the Betamax have infringed their copyrights and that Sony should be held responsible for that infringement”).

V. CONCLUSION

The “making available” doctrine does not survive a careful analysis. Courts should not be swept up in the RIAA’s legal wrangling as it twists the text of the statute to meet its needs, selectively citing legislative history and taking quotes from cases completely out of context.

A file-sharer who makes his file available for copying should not be found primarily liable for the eventual infringement. Instead, secondary liability is appropriate, and then only when the plaintiff demonstrates that actual reproduction has taken place. The “making available” doctrine has no place in copyright law, being contrary to any reasonable interpretation of the Copyright Act and rejected by all thoroughly-considered court opinions. It is time for the appellate courts to unite in disposing of this nonsensical doctrine, before the RIAA succeeds in rewriting laws that affect thousands in the growing online community.