

# The U.S. Making-Available Right: Preserving the Rights “To Publish” and “To Perform Publicly”

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## EXECUTIVE SUMMARY

Recently, courts, litigants, policymakers and commentators have debated whether existing U.S. copyright laws based upon the Copyright Act of 1976 grant to copyright owners the “making-available right” required by the *WIPO Copyright Treaty* (the *WCT*) and the *WIPO Performances and Phonograms Treaty* (the *WPPT*). For example, Article 14 of the *WPPT* states: “Producers of phonograms shall enjoy the exclusive right of authorizing the making available to the public of their phonograms, by wire or wireless means, in such a way that members of the public may access them from a place and at a time individually chosen by them.” The United States has acceded to and purportedly implemented this, and all other, requirements imposed by the *WCT* and the *WPPT*.

Under the *WCT* and *WPPT*, a “making-available right” is an exclusive right to offer copies or streams of a copyrighted work over the Internet or a similar network to members of the public who can then decide whether to access, copy, stream, or otherwise experience the work. Such a right could be infringed by either a person posting a work on a public web-streaming site or by someone “sharing” it with other members of the public through peer-to-peer file-sharing programs like BitTorrent, Grokster, LimeWire, or KaZaA. Nevertheless, during the last decade, some judges and commentators have argued that existing U.S. copyright laws do not provide the making-available right required by the *WCT*, the *WPPT*, other treaties, and at least thirteen purportedly enacted-and-implemented bilateral or multilateral Free Trade Agreements. Three recent developments confirm the persistence of these debates.

- On December 23, 2013, in *Diversey v. Schmidly*, the U.S. Court of Appeals for the Tenth Circuit, while holding that a university library infringed the distribution rights in a previously unpublished doctoral dissertation when the copy on its shelves was indexed in the library’s catalog information system, noted a “dissensus, particularly among district courts about the applicability of [such a holding] to cases of Internet file-sharing.”<sup>1</sup>
- On January, 14, 2014, the Subcommittee on Courts, Intellectual Property and the Internet of the House Committee on the Judiciary held a hearing on *The Scope of Copyright Protection*. At this hearing Professor and multi-volume-treatise author David Nimmer testified that “a *prima facie* case of infringing a copyright owner’s distribution right does not require proof of ‘actual distribution,’ namely, someone downloading a concrete file that another previously uploaded

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\* Mr. Sydnor is a Consulting Intellectual Property Fellow to the Innovators Network and the Association for Competitive Technology. This analysis is a preliminary draft of a potential law-review article on U.S. making-available rights. It is being provided in draft form to the U.S. Copyright Office in response to its request for public comments on the U.S. implementation of its making-available-right obligations. *Study on the Right of Making Available; Comments and Public Roundtable*, 79 Fed. Reg. 10571 (Feb. 25, 2014). Updated versions of this draft or updated versions of it will also be made available on the Social Science Research Network. Its final version will be dedicated to Mr. Sydnor’s family, his parents, former Register of Copyrights Marybeth Peters, and to Andrew Diversey, the *pro se* Plaintiff who argued and won a making-available case—on the briefs—in a federal court of appeals. See *Diversey v. Schmidly*, 738 F.3d 1196 (10<sup>th</sup> Cir. 2013).

<sup>1</sup> 738 F.3d 1196, 1202 n.7 (2013).

[to a P2P file-sharing network]. But Professor Glen Lunney testified that if a user of a P2P file-sharing program uploads and infringing file, then “[u]nder existing [U.S. copyright] law, the copyright owner must show a download to establish an infringing distribution....”

- On February 25, 2014, the U.S. Copyright Office announced a *Study on the Right of Making Available; Comments and Public Roundtable* that requested public comment on whether existing U.S. copyright law provides the making-available right required by the WCT and WPPT and whether Congress should amend existing U.S. copyright laws to better clarify whether existing laws provide such an exclusive right.

These are recent examples of continuing “dissensus” or concern about the U.S. implementation of its making-available-right obligations, and they are troubling. The awkward term “making-available right” arose from a compromise reached during the Diplomatic Conferences that produced the World Intellectual Property Organization’s 1996 “Internet Treaties,” the *WCT* and the *WPPT*. When negotiating these treaties, their U.S. and European proponents had two goals. First, they wanted to confirm that copyright owners retain, on the Internet, their traditional exclusive rights to decide whether and when to publicly disseminate copies or to publicly perform or display their works. Second, they wanted to make this duty “self-executing,” (*i.e.*, a duty that existing national copyright laws would already satisfy), regardless of whether a given nation’s copyright laws granted European-style communication-to-the-public rights or American-style distribution/publication/public-performance rights. The Diplomatic Conference that promulgated the *WCT* and *WPPT* thus adopted the term “making available” because the U.S. and other negotiators concluded that, under the Copyright Act of 1976, U.S. distribution and public-performance rights were fundamentally exclusive rights to make copies or performances available to members of the public.

Were they wrong, then the United States—now the world’s leading net exporter of many types of copyrighted works—could be accused of violating many major multinational copyright treaties and agreements that it has supposedly adopted and implemented since 1910, including the *Buenos Aires Convention*, the *Universal Copyright Convention*, the *Berne Convention for the Protection of Literary and Artistic Works*, the World Trade Organization’s *Agreement on Trade-Related Aspects of Intellectual Property Rights*, the *WIPO Copyright Treaty*, and the *WIPO Performances and Phonograms Treaty*. In addition, the U.S. could also be accused of violating specialized treaties like the 1971 *Geneva Convention on the Protection of Phonograms*, and at least thirteen multilateral or bilateral Free Trade Agreements (“FTAs”), like the recently-enacted FTA between the United States and the Republic of Korea.

This article thus seeks to help to resolve debate about whether existing U.S. copyright laws implement its making-available-right obligations by providing the first comprehensive analysis of the intended meaning of the two terms used in Section 106 of the Copyright Act of 1976 that could provide U.S. making-available rights. The first derives from the “chapeau” language of Section 106 that grants copyright owners exclusive rights “to do and to authorize” acts specified in subsections of 106. The second derives from Section 106(3), which grants an exclusive right “to distribute copies or phonorecords... to the public....”

Discerning the intended meaning of these two critical terms does not require complex or controversial feats of statutory interpretation. The intended meaning of both terms can be discerned by applying a “cardinal rule of statutory construction” long used by the Supreme Court to discern the intended

meaning of undefined statutory terms.<sup>2</sup> This cardinal rule can be called the plain-meaning rule, and it has two components. If a statute uses an undefined term that was a “term of art” that had acquired a specialized legal meaning under prior law, then courts presume that this term was intended to retain its familiar, specialized meaning when used as an undefined term in a subsequent statute on the same topic.<sup>3</sup> If a statute uses an undefined term that had not acquired a specialized meaning under prior law, then courts presume that this undefined term was intended to have its ordinary, dictionary-definition meaning.<sup>4</sup> Either presumption can be rebutted in “exceptional circumstances... when a contrary legislative intent is clearly expressed.”<sup>5</sup>

Nevertheless, correctly applying the two-pronged plain-meaning rule to undefined terms used in a federal statute requires careful study not only of the statute’s text, but also careful study of preceding law on the same subject and the statute’s own legislative history. Prior law on the same subject must be studied to determine whether an undefined term should be presumed to have been intended to retain a specialized meaning. The text, legislative history, and other aids to interpreting the statute must also be studied to determine whether a presumption favoring a specialized or ordinary meaning has been rebutted by “contrary legislative intent... clearly expressed.” When interpreting the Copyright Act of 1976, significant effort is required to correctly apply the two-pronged plain-meaning rule to discern the intended meanings of “to authorize” and “to distribute copies... to the public...” in § 106 of the Act.

The 1976 Act itself is complex, and its many sections are interrelated. The prior law that must be studied to determine whether its undefined terms were presumptively intended to have specialized or ordinary meanings is the complex, confusing and increasingly obscure system of dual state/federal copyright protection reflected in older statutes and decisions like the federal Copyright Act of 1909. The legislative history that must be studied to determine whether presumptions favoring specialized or ordinary meanings could be overcome is the voluminous, 20-year history of the Fourth General Revision of U.S. copyright law that produced the 1976 Act.

Moreover, 38 years after the 1976 Act was enacted, increasingly few scholars, jurists, government officials or practicing attorneys are still intimately familiar with pre-1976 U.S. copyright law or the details of the Fourth General Revision. Fortunately, from 2009 through 2012, three analyses of the making-available-right debate compiled increasingly detailed accounts of the relevant pre-1976 U.S. copyright law and the history of the Fourth General Revision. Each improved upon its predecessors, and this analysis also seeks to further improve, and even to complete, this re-education process.

Once the necessary re-education efforts have been undertaken, the plain-meaning rule can then be readily applied to interpret the 1976 Act, determine the intended meanings of “to authorize” and “to distribute copies... to the public...” and resolve the making-available-right debate. The U.S. negotiators of the *WCT* and *WPPT* were correct: Existing U.S. copyright laws do implement *WCT* and *WPPT* making-

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<sup>2</sup> *Molzof v. United States*, 502 U.S. 301, 307 (1992) (unanimous opinion) (*quoted in* *FAA v. Cooper*, 132 S. Ct. 1441, 1449 (2012)).

<sup>3</sup> *See, e.g., Neder v. United States*, 527 U.S. 1, 21 (1999); *Morrisette v. United States*, 342 U.S. 246, 263 (1952).

<sup>4</sup> *See, e.g., Ardestani v. INS*, 502 U.S. 129, 135-36 (1991); *see also* *United States v. Clintwood Elkhorn Mining Co.*, 553 U.S. 1, 10 (2008); *S.D. Warren Co. v. Maine Dept. Env'tl. Prot.*, 540 U.S. 370, 376 (2006) (holding that when an undefined statutory term is not a “term of art,” it has its “natural or ordinary meaning”).

<sup>5</sup> *Ardestani*, 502 U.S. at 135-36; *cf. Johnson v. United States*, 130 S. Ct. 1265, 1271 (2010) (refusing to “force term-of-art definitions into contexts where they plainly do not fit and produce nonsense”).

available-right obligations that were designed to be self-executing under then-existing U.S. copyright laws. They do so for two reasons that can be summarized as follows.

*First*, the § 106 term “to authorize” implements U.S. making-available-right obligations because, under prior U.S. copyright laws, “to authorize” had its ordinary meaning of “to permit.”

- “To authorize” neither had nor acquired any specialized meaning when it was used to prescribe the scope of the exclusive right granted in § 1(c) of the Copyright Act of 1909.
- “To authorize” had no specialized meaning when it was used to define the scope of the exclusive rights required by the U.S.-ratified 1971 version of the *Universal Copyright Convention*.
- Using the ordinary meaning of “to authorize” to define the scope of all of the exclusive rights granted in § 106 also enabled the drafters of the 1976 Act to conform the scope of U.S. copyrights to those required by the then-leading multinational copyright treaty, the *Berne Convention for the Protection of Literary and Artistic Works*.
  - As early as 1925, bills proposing to conform U.S. copyright laws to the requirements of the *Berne Convention* adopted the *Berne-Convention* practice of using the ordinary meaning of “to authorize” to define the scope of required exclusive rights.
  - The U.S.-ratified 1971 version of the *Universal Copyright Convention* also adopted the *Berne-Convention* practice of using the ordinary meaning of “to authorize” to define the scope of required exclusive rights.
  - The precise term used to define the scope of all exclusive rights granted in § 106, “to do and to authorized,” derived from the most ambitious of the efforts to enact *Berne-Convention*-compliant U.S. copyright laws, the 1940 “Shotwell Bill” that, after World War II, continued to influence the Fourth General Revision and the drafters of the 1976 Act.
- The legislative history of the 1976 Act supports the conclusion that “to authorize” was intended to have its ordinary meaning, and it certainly does not clearly express any contrary legislative intent.
  - During the early-1960s legislative hearings preceding the introduction of the 1965 copyright-reform bills, critical witnesses relied on the ordinary meaning of “to authorize” when advocating its use to define the scope of exclusive rights in a reformed copyright act.
  - The Committee Reports on the bills that became the 1976 Act cannot be lawfully interpreted to have expressed any contrary legislative intent when they noting that re-defining exclusive rights as rights “to authorize” was intended to “avoid any questions as to the liability of contributory infringers,” a class of infringers readily encompassed by the ordinary meaning of “to authorize.”

*Second*, the § 106(3) term “to distribute... copies... to the public” implements U.S. making-available-right obligations because, under prior U.S. copyright laws, the indispensable exclusive right to publish cumulatively protected by federal and state copyright laws had acquired an unusual, specialized meaning: it was a right to distribute copies of a work to the public that was triggered when copies of the work were made available to members of the public.

- Because the 1976 Act created a unitary system of copyright protection to replace the preceding systems of dual state/federal copyright protection, its drafters could not re-convey the preceding federal right “to publish” because it had never protected elements of the publication right previously protected by state copyright laws, including critical rights to make limited-purpose publications to subsets of the public and the right to make the first publication of a work to the public generally.
- But by incorporating into § 106(3) the specialized term of art that had long described the cumulative scope of prior state and federal publication rights, “to distribute copies... to the public,” the drafters of the 1976 Act could confirm their intent to create a comprehensive, unitary federal publication right.
- Prior law and legislative history also show that replacing the partial 1909-Act right “to publish” with a broader right “to distribute copies... to the public” also enabled the drafters of the 1976 Act to avoid perpetuating distinctions between “investive” and “divestive” publications that had caused the scope of the preceding federal right “to publish” to become unpredictable and incoherent in close cases.
- The text of the Sound Recording Amendments Act of 1971 also confirms that the drafters of the 1976 Act interpreted a right “to distribute” to encompass publication/making-available rights even when not modified by the § 106 term “to do or to authorize.”
- Sections 407 and 203(a)(3) enacted text of the 1976 Act refer to the § 106(3) distribution right as “the exclusive right of publication” and “the right of publication.” The enacted text of the 1976 Act thus confirms that its drafters equated the § 106(3) distribution right with a comprehensive publication/making-available right.
- Sections 506(a) and 506(a)(1)(C) of the current copyright act are subsequently enacted legislation—not subsequent legislative history—that re-interpreted the § 106(3) distribution right to encompass a making-available right.
- The legislative history of the 1976 Act repeatedly, consistently, and explicitly equates the § 106(3) distribution right with a comprehensive publication/making-available right.
- In 1971, a “minor amendment” to the pending reform bills added a second sentence to the § 101 definition of “publication” stating that “offering to distribute copies... to a group of persons for purposes of further distribution...” constitutes a “publication.” This merely confirmed that under the 1976 Act, as under prior law, only *general* publications are “publications” for purposes of notice, registration and term. In context, this “minor amendment” cannot prove that the distribution right does not encompass a making-available right.

The text of § 106 and § 106(3) has also been consistently interpreted to provide publication/making-available rights by every President, Congress, treaty-ratifying Senate, House or Senate Judiciary Committee, Register of Copyrights, Under Secretary for Intellectual Property, State Department official, U.S. Trade Representative, or U.S. Supreme Court decision that addressed this precise question. The preceding factors explain why.

Moreover, this plain-meaning-focused approach to resolving debates about the U.S. implementation of its making-available-right obligations has other advantages. In the case of the 1976 Act, its results seem dispositive. It focuses on correctly applying what the Supreme Court has unanimously held to be a “cardinal rule of statutory construction.” It also avoids unnecessary collateral disputes about more controversial approaches to examining legislative history. Finally, it also provides an internally coherent

approach to interpreting the intended meaning of both “to authorize” and “to distribute copies... to the public....” These two critical terms in § 106 of the 1976 Act are infinitives enacted into law at the same time in the same section of the same statute. This approach applies the same principles to interpret both terms; any permissible approach to statutory interpretation must do in this context.

## BACKGROUND

Debates about whether U.S. laws provide the broad making-available right required by the WIPO Internet Treaties implicate fundamental interests of copyright owners and the United States. In the Information Age, copyrights lose much of their value unless they give their owners the exclusive right to decide whether and how to make their works available to over 1 billion Internet users.

The vitality of copyrights also has profound economic significance for the United States. The expression, innovation, and reputations protected by copyrights, patents and trademarks may be the only areas in which the United States enjoys a positive balance of trade with *every other country*. Never again will the United States be the world’s leading manufacturer and exporter of television *sets*. But the United States can continue to be the world’s leading creator and exporter of television *programs*—if copyrights remain enforceable.

The making-available-right debate also has profound trade implications. The United States has ratified or enacted—and purportedly implemented—at least seventeen international agreements that require the U.S. to provide copyright owners with a making-available right. Violations of most of these agreements can be punished by trade sanctions levied by the World Trade Organization. This makes it critical to determine whether the U.S. complies with its many duties to provide making-available rights.

Until recently, the importance of this question tended to be overlooked or underestimated by courts, commentators, and multi-volume treatises on U.S. copyright law. Fortunately, from 2009 through 2012, three commentators began the task of assessing the U.S. implementation of its making-available-right obligations more systematically by conducting more detailed analyses of the text of the 1976 Act, its voluminous legislative history, and the prior law that the 1976 Act was intended to replace—the formalistic, intricate system of dual state/federal copyright protection that prevailed during the first 188 years of U.S. copyright law.

The first of these efforts began in February of 2009 when David Carson, then General Counsel of the U.S. Copyright Office, delivered his Manges Lecture, *Making the Making-Available Right Available*, which was published in 2010.<sup>6</sup> In March of 2009, I published *The Making-Available Right under U.S. Law*.<sup>7</sup> In 2010 and 2011 Professor Peter Menell published drafts of what became his 2012 article, *In Search of Copyright’s Lost Ark: Interpreting the Right to Distribute in the Internet Age*.<sup>8</sup> While some of Professor

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6. David O. Carson, *Making the Making Available Right Available*, 33 Colum. J.L. & Arts 135 (2010).

<sup>7</sup> Thomas D. Sydnor II, *The Making-Available Right under U.S. Law* (Progress & Freedom Found. 2009) available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1367886](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1367886).

<sup>8</sup> Peter S. Menell, *In Search of Copyright’s Lost Ark: Interpreting the Right to Distribute in the Internet Age*, 59 J. COPYRIGHT SOC’Y U.S.A. 1 (2012), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1679514](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1679514). Professor Menell’s *Lost Ark* paper is excellent and important, but its citation to my 2009 paper made two errors. First, *Lost Ark* wrongly claimed that my 2009 paper had “placed primary emphasis on deference to... international agreements.” That claim is simply wrong. Second, *Lost Ark* also wrongly claimed that I had analyzed the “ordinary”

Menell's analyses were similar his predecessors, he also made invaluable original contributions by refining prior analyses and recovering critical testimony from the early-1960s legislative hearings .

While Professor Menell's *Lost Ark* article significantly improved upon the works of his predecessors, aspects of its analyses of the origins of both the § 106(3) right "to distribute... copies... to the public" and the § 106 chapeau text, "to do or to authorize," suggested a need for further analysis. In particular, it seemed unlikely that testimony at legislative hearings could fully explain a change in practice as significant as the decision to re-define the scope of all exclusive rights granted in § 106 of the 1976 Act as rights "to do and to authorize" specified acts.

Consequently, this article supplants my 2009 paper and attempts to further improve upon prior analyses, particularly in four important respects. *First*, it attempts to trace the origins of "to do and to authorize" and "to authorize" back to their original sources in prior U.S. and international copyright law.<sup>9</sup> *Second*, it stresses that the drafters of the 1976 Act could not have created a unitary system of federal copyright protection by re-granting Copyright Act of 1909's exclusive right "to publish," because that federal right had never protected critical aspects of the overall publication right then protected only by state copyright laws. *Third*, it seeks to better explain the meaning of the "minor amendments" to the 1971 copyright reform bills that produced § 101 of the 1976 Act's three-sentence definition of "publication." *Fourth*, it better segregates analyses of potential alternative bases for concluding that existing U.S. copyright law provide making-available rights, including *Charming-Betsy/GTE-Sylvania* deference, the ordinary meaning of "to distribute," the precedential value of the Supreme Court's alternative holding in *Tasini*, and a "deemed-distributed" presumption.

## ANALYSIS

The WIPO Internet Treaties and all recent U.S. Free Trade Agreements inarguably require the U.S. to provide authors with an exclusive right to make copies or performances of their works available over the Internet—regardless of whether the work was made available because it was downloaded or streamed from a website or copied into the "shared" folder of a file-sharing program like Grokster, KaZaA, LimeWire, or Frostwire.<sup>10</sup> For at least 40 years, many U.S. Presidents, Congresses, judges, Registers of

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meaning of "to distribute" by citing federal child-pornography-sentencing cases without noting that they "operate under a specific definition of 'distribution' set forth in .... 18 U.S.C. § 2G2.2, Application Note 1." Menell, *supra* n. [CROSS REF] at n.124. In fact, my paper replied explicitly to claims that child-pornography cases do not rely upon the ordinary meaning of "distribute." See Sydnor, *supra* note [CROSS REF] at 43 n.170. It thus avoided citing any child-pornography-related cases that did not rely on the ordinary meaning of "distribute" of "distribution." See *id.* at 43 n.171. Indeed, courts adjudicating some child-pornography sentencing cases have distinguished the cases that I cited because they did not rely upon 18 U.S.C. § 2G2.2's special definition of "distribution." *E.g.*, *United States v. Rogers*, 666 F. Supp. 2d 148, 151 n.3 (D. Me. 2009). Professor Menell was thus wrong to claim that my 2009 paper had cited cases that did not fairly support claims that the ordinary meaning of "to distribute" could encompass the act of making-available. *Accord*, Carson, *supra* note [CROSS-REF] at 154 & n.73; *cf.* *United States v. Probel*, 214 F.3d 1285, (11<sup>th</sup> Cir. 2000) (equating the 18 U.S.C. § 2G2.2 definition of "distribution" with its ordinary meaning).

<sup>9</sup> To his credit, Copyright Office General Counsel David Carson has consistently stressed the long-term importance of making-available rights as to streaming, even when the currently pending cases involved file-sharing and the distribution of copies. See, Carson, *supra* note [XREF] at 151.

<sup>10</sup> See Carson, *supra* note [CROSS REF], at 144 (citing "authoritative commentators" like Professors Jane Ginsburg and Silke von Lewinski).

Copyrights, Assistant Secretaries for Intellectual Property, and U.S. Trade Representatives have consistently concluded that U.S. copyright laws provide such “making-available” rights.<sup>11</sup> But recently, a few federal trial judges have held that U.S. copyright laws do not provide making-available rights.<sup>12</sup>

The critical questions that should resolve debate about whether U.S. law provides an Internet-era making-available right can be highlighted by tracing the evolution of the language that U.S. copyright acts have used to define two core rights of copyright owners. These are the rights of reproduction and publication.<sup>13</sup>

During the first 188 years of U.S. copyright law, the statutory language defining these rights barely changed. In the Copyright Act of 1790, gerunds defined rights of “reprinting” and “publishing” that were unchanged after the First General Revision of U.S. copyright law produced the Copyright Act of 1831. After the Second General Revision, they became “reprinting,” “copying” and “publishing” rights in the Copyright Act of 1870. After the Third General Revision, they were restated in the infinitive mode as exclusive rights “to reprint,” “to publish” and “to copy” in the Copyright Act of 1909.<sup>14</sup>

None of these minor changes, (like the shift from the 1790 gerund “publishing” to the 1909 infinitive “to publish”) altered the scope of the exclusive rights granted. Consequently, from 1790 to 1978, U.S. copyright laws rights provided a “making-available right” in cases involving the distribution of copies: That was the essence of an exclusive right of “publishing” or “to publish”: It was the exclusive right to distribute copies of a work to the public, which occurred when those copies were offered or made available to the public.<sup>15</sup>

But from 1955 through 1976, the Fourth General Revision of U.S. copyright law produced our current copyright act, the Copyright Act of 1976. In the 1976 Act, the statutory language used to define the exclusive rights generally and the publication right in particular changed significantly. In § 106 of the 1976 Act, all copyrights became exclusive rights “to do and to *authorize*” listed acts. In § 106(3), the exclusive right “to publish” became a right “to distribute copies or phonorecords of the copyrighted

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<sup>11</sup> See *infra* [XREF].

<sup>12</sup> See *Capitol Records, LLC v. ReDigi Inc.*, 934 F. Supp. 2d 640, 651 n.6 (S.D.N.Y. 2013) (dicta) (claiming that past decisions from the district had “cast significant doubt” upon the “make-available” interpretation of the distribution right); *Ent. Group, Inc. v. Barker*, 551 F. Supp. 2d 234, 243-44 (S.D.N.Y. 2008) (holding that a making-available right exists only when a digital file is made available for *further* re-distribution); *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153, 169 (D. Mass. 2008) (dicta) (claiming that “defendants cannot be liable for violating the plaintiffs’ distribution right unless a “distribution” actually occurred”);

<sup>13</sup> See ARTHUR W. WEIL, *AMERICAN COPYRIGHT LAW* 69 (1917) (“[I]t may be doubted whether a copyright can be conceived to exist which does not involve these rights.”); see also, e.g., *American Tobacco Co. v. Werckmeister*, 207 U.S. 284, 291, 293 (1907) (holding that U.S. copyright laws were intended to protect “the property which the author has in the right to publish his production, the purpose of the statute being to protect this right...”)

<sup>14</sup> Copyright Act of 1790, ch. 15, § 1, 1 Stat. 124, 124 (1790); Copyright Act of 1831, ch. 16, § 1, 4 Stat. 436, 436 (1831); Copyright Act of 1870, ch. 230, § 86, 16 Stat. 198, 212 (1870); Copyright Act of 1909, Pub. L. No. 60-349, §§ 1(a), 35 Stat. 1075, 1075 (1909).

<sup>15</sup> See *infra* [CROSS REF]; see also Carson, *supra* note [CROSS REF], at 157 (“Prior to the 1976 Copyright Act, the right that we now call the distribution right was a right to publish.”).

work to the public by sale or other transfer of ownership, or by rental, lease, or lending...,” (though other sections of the 1976 Act still called this the “exclusive right of publication”).<sup>16</sup>

Debates about whether U.S. law still provides a making-available right thus focus upon two questions of statutory interpretation. *First*, why did the Copyright Act of 1976 redefine the exclusive rights of copyright owners as rights “to do and to authorize,” language that sounds like it would encompass a making-available right in cases involving the distribution of copies or the streaming of public performances? *Second*, why did the Copyright Act of 1976 restate the familiar exclusive right “to publish” as a right “to distribute copies... to the public,” potentially ambiguous language that might or might not encompass a making-available right? Efforts to answer these questions follow.

**I. The Most Reasonable Interpretations of “To Authorize” and “To Distribute...Copies... to the Public” Each Provide Copyright Owners with a Making-Available Right.**

In relevant part, § 106 of the Copyright Act of 1976 states:

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;...

(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;....<sup>17</sup>

The existence of a U.S. making-available right turns upon the interpretation of two terms used in § 106: the infinitive “to authorize” that defines the scope of all exclusive rights, and the infinitive “to distribute” that defines the scope of the distribution right that replaced the publication right granted since 1790.<sup>18</sup> Debates about a U.S. making-available right are thus debates about how these undefined statutory terms should be interpreted.

In their details, statutory interpretation and construction remain central to the judicial function and quite controversial. Supreme-Court Justices routinely disagree with each other on fine questions of statutory interpretation. Moreover, most “canons” of statutory interpretation are really just guidelines to careful reading that can misfire if applied too loosely or rigidly. The enterprise of statutory interpretation thus does not always produce dispositive answers about what laws mean. Indeed, this potential indeterminacy is why *Charming Betsy* deference can be important: It can prevent a judge from holding that the United States has violated a century’s worth of international agreements simply because that judge might interpret § 106 somewhat differently than the Executive Branch that wields the Treaty Power and the Legislative Branch that wields the Foreign Commerce Power.

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<sup>16</sup> 17 U.S.C. §§ 106, 106(3), 407(a); *see also id.* at § 203(a)(3).

<sup>17</sup> 17 U.S.C. § 106(1)-(4).

<sup>18</sup> 17 U.S.C. §§ 106, 106(3) (emphasis added). The Act defines neither of these terms.

Nevertheless, no one need invoke *Charming Betsy* deference in order to show that the “best” or most reasonable interpretations of “to authorize” and “to distribute” should provide the making-available rights required by the international obligations of the United States. Statutory interpretation can be complex in its details and nuances, but not in its basic principles. In this case, uncontroversial, basic principles of statutory interpretation can resolve the making-available-right debate convincingly.

The relevant statutory terms in § 106, “to authorize” and “to distribute copies” are both infinitives enacted simultaneously in the same section of the same statute. Because neither term is defined in the 1976 Act, it is important to apply what can be called the “plain-meaning rule” to determine whether each was intended to have its “ordinary meaning” or a “specialized meaning.” A given term’s “ordinary meaning” is its dictionary-definition meaning.<sup>19</sup> A “specialized meaning” is any meaning broader or narrower than a given term’s ordinary meaning. Any term having a specialized meaning could thus be called a legal “term of art” because its meaning in the law differs from its meaning in ordinary speech.<sup>20</sup>

When a statutory term is undefined, courts apply “a cardinal rule of statutory construction” by examining prior law to determine whether the term was intended to have an ordinary or a specialized meaning.<sup>21</sup> If an undefined statutory term had no specialized meaning under prior law, then it presumptively retains its ordinary, dictionary-definition meaning.<sup>22</sup> But if an undefined statutory term had acquired a specialized meaning under prior statutory or common law, then it presumptively retains that meaning.<sup>23</sup> Either presumption can be rebutted, but only “in rare and exceptional circumstances... when a contrary legislative intent is clearly expressed.”<sup>24</sup>

Together, these principles presume that statutes must be interpreted in the way that would have been expected by an informed legislator carefully reading the text of a pending bill in light of existing law. Undefined terms that informed legislators should have understood as familiar “terms of art” are presumed to retain their specialized meanings. Otherwise, courts presume that legislators would have understood undefined terms to have their ordinary, dictionary-definition meanings.

These presumptions thus serve a critical role in promoting interpretive consistency and deterring abuse. They do not tell federal judges what to do when all or almost all relevant evidence—textual and contextual, intrinsic and extrinsic—suggests the same interpretation. In such cases, all judges acting in good faith should correctly interpret the provision. Rather, these presumptions effectuate the Constitution’s structural premise of separated powers by ensuring that when the available evidence is arguably equivocal—as it often is—the Judicial Power of interpretation cannot be used to usurp the Legislative Power just because some credible, relevant evidence does favor the interpretation that might best advance the policy preferences of a particular federal judge or appellate panel.

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<sup>19</sup> *E.g.*, *Logan v. United States*, 552 U.S. 23, 31 (2007) (unanimous opinion).

<sup>20</sup> *E.g.* *Buchanan Bd. & Care Home, Inc. v. W. Va. Dept. of Health & Human Servs.*, 532 U.S. 598, 615 (2001).

<sup>21</sup> *Molzof v. United States*, 502 U.S. 301, 307 (1992) (unanimous opinion) (*quoted in* *FAA v. Cooper*, 132 S. Ct. 1441, 1449 (2012)).

<sup>22</sup> *See, e.g.*, *Ardestani v. INS*, 502 U.S. 129, 135-36 (1991); *see also* *United States v. Clintwood Elkhorn Mining Co.*, 553 U.S. 1, 10 (2008); *S.D. Warren Co. v. Maine Dept. Env’tl. Prot.*, 540 U.S. 370, 376 (2006) (holding that when an undefined statutory term is not a “term of art,” it has its “natural or ordinary meaning”).

<sup>23</sup> *See, e.g.*, *Neder v. United States*, 527 U.S. 1, 21 (1999); *Morrisette v. United States*, 342 U.S. 246, 263 (1952).

<sup>24</sup> *Ardestani*, 502 U.S. at 135-36; *cf.* *Johnson v. United States*, 130 S. Ct. 1265, 1271 (2010) (refusing to “force term-of-art definitions into contexts where they plainly do not fit and produce nonsense”).

Moreover, focusing on these basic principles will not drag the making-available-right debate into collateral disputes about the application of more arcane or controversial principles of statutory interpretation—particularly controversies about when it is appropriate for courts to derive a *new* specialized meaning for an undefined statutory term solely from legislative history. As might be expected from the 20-year duration of the Fourth General Revision of U.S. copyright law, the legislative history of the 1976 Act sometimes contains critical information about what that Act was intended to do. This analysis examines that legislative history for the uncontroversial purpose of assessing whether it supports (or fails to clearly overrule) the presumptions favoring the ordinary or specialized meanings of undefined statutory terms.

By contrast, opponents of a U.S. making-available right have tended to make controversial and incoherent uses of legislative history. Consider, for example, the district-court decision in *Capitol Records, Inc. v. Thomas*.<sup>25</sup> When interpreting “to authorize” in § 106, it derived a narrow “specialized” meaning from one ambiguous sentence of legislative history, but when interpreting “to distribute” in § 106(3), it ignored the far more clear and consistent legislative history confirming that “to distribute” in § 106(3) was intended to retain the specialized meaning that it had acquired during the preceding 186 years of U.S. copyright law by claiming courts cannot use legislative history to deny a term its ordinary meaning.<sup>26</sup> Even before it was vacated, that decision had no persuasive or even precedential value. District courts bound to follow it could obey its holding that relied upon legislative history to deny a term its ordinary meaning only by ignoring its holding that courts cannot use legislative history to deny a term its ordinary meaning.

By contrast, consistently and correctly applying the presumptions favoring the ordinary or specialized meanings of undefined statutory terms can end the making-available-right debate. These basic, binding principles of statutory interpretation show that two provisions of § 106 of the 1976 Act provide the making-available rights required by the WIPO Internet Treaties and other international obligations of the United States.

*First*, in § 106, the undefined statutory term “to authorize” should provide a making-available right if it retains its ordinary meaning. Context and other intrinsic evidence reveal little about the intended meaning of “to authorize.” Fortunately, that term was used in its ordinary, dictionary-definition sense in three critical sources of prior law: (a) in § 1(c) of the U.S. Copyright Act of 1909; (b) in the *Universal Copyright Convention*, the only major, multilateral, global copyright treaty to which the U.S. had acceded when the 1976 Act was enacted; and (c) in the *Berne Convention on the Protection of Literary and Artistic Works*, the major, multilateral, global copyright treaty to which the U.S. subsequently acceded, and which now provides the truly global norms for copyright protection enforced by the World Trade Organization. Consequently, “to authorize” presumably retained its ordinary meaning in the 1976 Act, and no “contrary legislative intent” has been “clearly” expressed. The term “to authorize” thus provides a making-available right.

*Second*, in § 106(3), the undefined statutory term “to distribute copies... to the public” should provide a making-available right if it retains the specialized meaning that it had developed during the preceding 186 years of U.S. copyright law. Under prior law, an exclusive right of publication was a right to distribute copies of a work to the public, which was held to occur when copies of the work were made

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<sup>25</sup> *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210 (D. Minn. 2008).

<sup>26</sup> *Compare id.* at 1220 (relying on legislative history to narrow the ordinary meaning of “to authorize”), with *id.* at 1221 (proclaiming that legislative history cannot be used to alter a statutory term’s ordinary meaning).

available to the public.<sup>27</sup> Prior law, other sections of the 1976 Act, the Act’s legislative history, and the Supreme Court have thus consistently equated the § 106(3) distribution right to a “right of publication.” The term “to distribute copies” thus presumably retained its specialized meaning in the 1976 Act, and no “contrary legislative intent” has been “clearly expressed....” The term “to distribute” thus provides a making-available right.

**A. “To Authorize” Provides a Making-Available Right Because It Was Intended to Have Its Ordinary Meaning.**

The 1976 Act became the first copyright act in U.S. history to define copyrights as exclusive rights “to do and to authorize” acts like reproducing copies, distributing copies or publicly performing works.<sup>28</sup> Indeed, this change was so important that the drafters of the 1976 Act sacrificed grammar to incorporate it.

Like the 1909 Act, the subsections of § 106 use the infinitive mode to define individual exclusive rights as rights “to reproduce,” “to distribute,” or “to perform... publicly...” But each of these rights is also a right “to do and to authorize” the specified act. The resulting exclusive rights do not make grammatical sense when read literally. For example, the § 106(3) distribution right is, literally, the exclusive right “to do and to authorize... to distribute copies... to the public...” When 20 years of drafting and study produce a major statute whose most important operative section forsakes ordinary grammar in order to incorporate a term never before used during the preceding 186 years of relevant U.S. law, that change was obviously indispensable to its drafters.

Moreover, to date, no one has denied that if “to authorize” has its ordinary meaning, then U.S. copyrights would encompass the act of making copies or performances available to over 1 billion Internet users. Indeed, the Supreme Court, copyright cases, and dictionaries usually use “authorize” flexibly, in its ordinary sense of “to permit.”<sup>29</sup> Acts like copying a file to the shared folder of a file-sharing program or posting a file on a public web site surely “authorize” its distribution within the ordinary meaning of the term.

Basic rules of statutory interpretation also prove that “to authorize” was intended to have its ordinary meaning in § 106 of the 1976 Act. The 1976 Act does not define “to authorize” and the term retained its ordinary meaning under the Copyright Act of 1909 and the two major multilateral copyright treaties that used “to authorize” or “authorizing” to define the scope of required exclusive rights. Consequently, “to authorize” was presumptively intended to have its ordinary meaning in the 1976 Act. Several courts

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<sup>27</sup> See *infra* nn. [XREF].

<sup>28</sup> 17 U.S.C. § 106.

<sup>29</sup> See *Washington County v. Gunther*, 452 U.S. 161, 169 (1981). For similar definitions of “authorize,” see *United States v. Pavcak*, 411 F.3d 655, 661 (6<sup>th</sup> Cir. 2005); *The Confederated Salish and Kootenai Tribes v. United States*, 343 F.3d 1193, 1196 (9<sup>th</sup> Cir. 2003); *Int’l Union of Electrical, Radio and Machine Workers v. Westinghouse Elec. Corp.*, 631 F.2d 1094, 1100 n.8 (3d Cir. 1980); see also BLACK’S LAW DICTIONARY 133 (6<sup>th</sup> ed. 1990); *Jalbert v. Grautski*, 554 F. Supp. 2d 57, 69-70 (D. Mass. 2008) (holding that a copyright owner implicitly “authorized” a defendant’s acts because his mother, who was acting as his agent, seemingly approved of them). Similar uses of authorize are common. See, e.g., *New York Times Co. v. Tasini*, 533 U.S. 483, 489 (2001) (using “authorize” in the sense of “to permit”); Carson, *supra* note [CROSS REF], at 158-159 (citing more authorities).

have so concluded.<sup>30</sup> Nevertheless, questions about the intended meaning of “to authorize” warrant further scrutiny for three reasons.

*First*, in § 106, the term “to do and to authorize” defines the scope of all of the exclusive rights defined in subsections (1) through (6). The term “to authorize” could thus provide a making-available right regardless of whether a site was making copies available for distribution to the public, or streaming performances of a work to the public.<sup>31</sup> Streaming is already becoming an increasingly common means of disseminating works over the Internet, and some predict that it will ultimately become ubiquitous.<sup>32</sup> Consequently, it may be increasingly important to determine whether “to authorize” enables existing U.S. law to provide a making-available right in the contexts of both downloading and streaming.<sup>33</sup>

*Second*, the broad interpretive discretion that the common-law American judicial system vests in federal judges is constrained, in part, by the judicial duty of reasoned decisionmaking.<sup>34</sup> Consequently, an analysis of the meaning of “to authorize” should explain why, after 186 years of contrary practice, the

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<sup>30</sup> *Expeditors Int'l v. Direct Line Cargo Mgmt. Servs.*, 995 F. Supp. 468, 477 (D.N.J. 1998) (holding that “to authorize” has its ordinary meaning); *Curb v. MCA Records, Inc.*, 898 F. Supp. 586, 593-94 (M.D. Tenn. 1995) (holding that denying “to authorize” its ordinary meaning “appears contrary both to well-reasoned precedent, statutory text, and legislative history”); see *ITSI T.V. Prods., Inc. v. California Auth. of Racing Fairs*, 785 F. Supp. 854, 860 (E.D. Cal. 1992) (“it appears to this court that Congress created a new form of ‘direct’ infringement when it amended the Act to include the words ‘to authorize’”) (dicta), *aff'd in other part and rev'd in other part*, 3 F.3d 1289 (9<sup>th</sup> Cir. 1993); see also Phanesh Koneru, *The Right “To Authorize” in U.S. Law: Questions of Contributory Infringement and Extraterritoriality*, 37 IDEA 87 (1996); Michael W. Ballance, Note, *Third-Party Innocence: Domestic Authorization of Foreign Copyright Infringement and Subafilms, Ltd. v. MGM-Pathe Communications Co.*, 20 N.C. J. In'l L. & Com. Reg. 435, 446 (1995) (“The phrase ‘to authorize’ both encompasses the doctrine of contributory infringement as a third-party theory of liability and establishes a direct cause of action against illegal authorizers.”).

<sup>31</sup> To be sure, even in cases involving Internet streaming, the U.S. might be able to argue that it can implement its making-available-right obligations by providing a reproduction right and a distribution right triggered by the making-available of copies for distribution to the public. Streaming services will almost inevitably involve the creation of server copies and the distribution of at least temporary version of those copies to members of the public. Internet streaming services will thus tend to implicate reproduction, distribution and public-performance rights. Nevertheless, in practice, enforcing copyrights would be much simpler if the § 106(4) right “to do and to authorize” public performances separately provides a making-available right.

<sup>32</sup> See generally, PAUL GOLDSTEIN, *COPYRIGHT’S HIGHWAY: FROM GUTENBERG TO THE CELESTIAL JUKEBOX* (2d ed. 2003). Professor Goldstein’s “celestial jukebox” might now be described as a form of personal-area-networking in which authorized content is streamed on demand to any device that authenticates a given user’s right to access a particular work. While we may still be years away from this sort of highly flexible, ubiquitous personal-area networking, it remains an obvious long-term goal for both content creators and distributors.

<sup>33</sup> This article will not examine in detail so-far-unarticulated claims that a making-available right for streaming could also be derived from the term “...to perform the copyrighted work publicly...” 17 U.S.C. § 106(4). As in the case of the § 106(3) term “to distribute... copies,” the term “to perform... publicly” could have been used by the drafters of the 1976 Act as a term of art that encompassed the making-available of performances of works to the public. See, e.g., *Buck v. Jewell-LaSalle Realty Co.*, 283 U.S. 191, 195 (1931) (holding that a hotel owner that had “made available” performances of copyrighted works to hotel guests that had infringed public-performance rights). Nevertheless, arguments for interpreting “to perform... publicly” to retain a specialized meaning seem less powerful than the arguments for “to distribute... copies,” retaining the specialized meaning that equated it with publication/making-available. This article thus reserves arguments about “to perform... publicly” for another day.

<sup>34</sup> See, e.g., RUGGERO J. ALDISERT, *LOGIC FOR LAWYERS* 9 (3<sup>rd</sup> ed. 1997) (“Without a reasoning process adhering to rules of logic to support conclusions, judicial decisions would have nothing more than... orders and judicial fiat” and “anathematic to the spirit of our democracy....”); see also *id.* at 7-22 (collecting other supporting authorities)..

1976 Act became the first in American history to more broadly define the exclusive rights of copyright owners as rights “to do and to authorize.”

*Third*, in the case of “to authorize,” the common-law precedential system has badly misfired and generated the “*Venegas* interpretation” of “to authorize.” This pratfall-ridden interpretation erroneously derived a specialized, narrow meaning for “to authorize” by misreading an ambiguous sentence of legislative history and some judicial *dicta* from a case that had actually reserved the question of whether “authorizing” infringing acts can infringe copyrights. But until *Venegas* is thoroughly debunked, some courts will mistakes it for a reasoned analysis of the intended meaning of “to authorize.”

The next two subsections will address these issues. The first will show that by breaking with 186 years of prior practice and granting exclusive rights “to do and to authorize,” Congress ensured that the copyrights granted by the 1976 Act could comply with those required by both the *Universal Copyright Convention* and the *Berne Convention on the Protection of Literary and Artistic Works*. Those were the two multinational treaties that, (as of 1965), might have become the basis for truly global norms for copyright protection, and both—just like one subsection of the Copyright Act of 1909—used the undefined terms “to authorize” or “authorizing” in their ordinary sense when defining the scope of exclusive rights.

The second will show that the “*Venegas* interpretation” of “to authorize” is illogical and unlawful. It mistook blatant *dicta* for a judicial holding; its analysis of legislative history is woefully incomplete; and it treated one ambiguous sentence of legislative history as the “contrary legislative intent... clearly expressed” required to overcome the presumption favoring ordinary meaning. *Venegas* and its progeny are thus too flawed to have any persuasive value.

### **1. Exclusive Rights “To Authorize” Implemented Both of the Leading Multilateral Copyright Treaties That Might Have Set Global Norms.**

It is not difficult to apply the plain-meaning rule to discern the intended meaning of “to do and to authorize” in § 106. Neither “to do and to authorize” nor “to authorize” had acquired any specialized meaning under prior law, so both terms must be presumed to have been intended to have their ordinary, dictionary-definition meanings—absent the contrary legislative intent, clearly expressed, that the 20-year legislative history of the 1976 Act clearly fails to express.

But merely stating this result does not explain why “to authorize” in § 106 was intended to have its ordinary, dictionary-definition meaning. On its face, the text of § 106 shows that the drafters of the 1976 Act considered this then-novel means of defining the scope of the exclusive rights of copyright owners to be important enough to justify a radical departure from 186 years of prior drafting practices. Nevertheless, the origins and the intended purposes of “to authorize” are fully clarified by neither the text of the 1976 Act itself nor by its legislative history. Indeed, the brief discussions of “to authorize” in the most important documents in the 1976 Act’s legislative history are ambiguous enough that they merely suggest that “to authorize” was intended to have its ordinary meaning. For example, the 1965 *Supplemental Register’s Report on the General Revision of U.S. Copyright Law* states:

The right “to do” something is probably broad enough to include the right ‘to authorize’ that the thing be done, but we have added the phrase ‘to authorize’ in order to avoid possible questions as to the liability of contributory infringers. One example cited was of a person who legally acquires an authorized print of a copyrighted motion picture but who then engages in the business of renting it to others for purposes of unauthorized

public performance. There should be no doubt that this kind of activity constitutes infringement.<sup>35</sup>

The *Committee Reports* on the bills that became the 1976 Act are even more terse:

Use of the phrase “to authorize” is intended to avoid any questions as to the liability of contributory infringers. 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.<sup>36</sup>

Both the *Supplementary Register’s Report* and the *Committee Reports* share two ambiguities. *First*, while these reports say that defining copyrights as rights “to authorize” would “avoid any avoid any questions as to the liability of contributory infringers,” neither explicitly states whether “to authorize” was also intended to encompass actors other than contributory infringers, as its ordinary meaning would. *Second*, the example cited in these reports asserted that “to authorize” would impose liability if a legal copy of a film was being made available for infringing public performances—a case arguably not encompassed by pre-1976 contributory-liability rules.<sup>37</sup>

Fortunately, in *Lost Ark*, Professor Menell’s *Lost Ark* identified less ambiguous legislative history relevant to the intended meaning of “to authorize.” Professor Menell’s evidence strongly undermines claims that legislative history gave “to authorize” a previously unknown specialized meaning that encompassed only cases in which pre-1976 courts would have imposed contributory liability. But this evidence alone does not adequately explain why the exclusive rights granted by § 106 of the 1976 Act broke with grammar and 186 years of U.S. copyright law to become rights “to do and to authorize.” Consequently, Professor Menell’s analyses of this earlier legislative history should be studied carefully.

**a. *Lost Ark* traces the origins of “to authorize” back to September 14, 1961.**

Professor Menell concluded that the idea of using the term “to authorize” to define the scope of U.S. exclusive rights “traces back to the September 14, 1961 hearings on the 1961 Register’s Report.”<sup>38</sup> On that day, Edward A. Sargoy, the head of the ABA subcommittee on copyright reform, suggested that unauthorized exhibitions of films could be better deterred were copyrights to become exclusive rights “to authorize” certain acts:

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<sup>35</sup> *Supplementary Register’s Report on the General Revision of the U.S. Copyright Law*, at 16 (House. Comm. Print 1965). The *Supplementary Register’s Report* correctly asserts that an exclusive right “to do” an act should encompass all steps in the process of doing that act and would thus encompass the act of authorizing. Nevertheless, it seems unnecessary to separately analyze the intended meaning of “to do” because it can be incorporated into the analysis of whether the undefined phrase used to state the scope of all exclusive rights, “to do and to authorize” was intended to have its ordinary meaning.

<sup>36</sup> *E.g.*, H.R. Rep. 1476, 94<sup>th</sup> Cong. 2<sup>nd</sup> Sess. at 61.

<sup>37</sup> In the example given by the *Committee Reports*, the mere act of “engag[ing] in the business of renting” an authorized copy of a film “to others for purposes of unauthorized public performance” triggers an infringement of the authorization right. Under pre-1976 contributory liability rules, contributory liability would not have been incurred unless an unauthorized public performance had actually occurred.

<sup>38</sup> Menell, *supra* note [CROSS REF], at 42.

[I]n view of the great expense and difficulty in attempting to prove exhibition infringements in order to hold these bootleggers who are renting for these unauthorized exhibition purposes, [there might] be a provision such as the Canadian and British laws have whereby “to authorize” any of the exclusive rights is a species of infringement.<sup>39</sup>

Professor Menell noted that that Sargoy’s proposal to define copyrights as rights “to authorize” was not incorporated in the Preliminary Draft of a new revision bill circulated in late 1962. But Professor Menell then noted that during 1963 hearings on proposed exclusive-rights language, the General Counsel of ASCAP, Mr. Finklestein, had again suggested that copyrights should encompass authorization rights:

Suppose ASCAP, or BMI, or any of the other licensing organizations authorizes its licensees to perform a certain work. I doubt whether that would be an act of contributory infringement, but I think that there should be liability there. It would seem to me that the mere authorization to make the use of the copyrighted work, that particular work, ought to subject the person making the authorization to liability even though he may not be a contributory infringer.<sup>40</sup>

Professor Menell then noted that in 1964, Copyright Office General Counsel Abe Goldman stated, “At our Panel meeting it was suggested that we insert [‘to authorize’] and the subcommittee of the ABA... also suggested that this phrase be inserted. We have followed those suggestions.”<sup>41</sup> Professor Menell thus concluded that “Mr. Finklestein’s proposal made its way into the 1964 [copyright reform] bill,” into the 1965 *Supplementary Report of the Register*, into the *Committee Reports*, “and ultimately into the final version of Section 106.”<sup>42</sup>

This account of how “to authorize” entered U.S. copyright law is helpful, but unconvincing. It is helpful because the legislative history first identified in *Lost Ark* significantly advances efforts to understand the intended meaning of “to authorize.” In particular, it should preclude any claim that the 1976 Act’s legislative history “clearly expressed” intent for “to authorize” to acquire some narrow, previously unknown specialized meaning. To the contrary, the testimony of Messrs. Sargoy, Finklestein and Goldman shows that the experienced copyright experts assisting in the drafting of the 1976 Act used the term “to authorize” in its ordinary sense.

But it is problematic to focus so closely upon legislative history when both Supreme-Court precedents and Mr. Sargoy’s own testimony tell us to look to prior law to see whether “to authorize” was intended to have an ordinary or specialized meaning. Under Supreme-Court precedents like *Ardestani* and *Morrisette*, prior law—not legislative history—determines whether an undefined term presumptively

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<sup>39</sup> *Copyright Law Revision: Part 2, Discussion and Comments on Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, at 24 (House Comm. Print, 88th Cong., 1st Sess. 1963) (quoted in Menell, *supra* note [CROSS\_REF] at 42-43 & n.189); see also J.A.L. STERLING, *WORLD COPYRIGHT LAW* 998 (2<sup>nd</sup> ed. 2003) (citing British law to show that “the term [authorization] can refer to a purported exercise of a right by a person who is not entitled to give the respective permission”); *Falcon v. Famous Players Film Co.* [1926] 2 K.B. 474 (U.K.).

<sup>40</sup> *Copyright Law Revision: Part 3, Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft*, at 122-23 (1964) (emphasis added) (quoted in Menell, *supra* note [CROSS\_REF] at 43 & n.191).

<sup>41</sup> See *Copyright Law Revision Part 5, 1964 Revision Bill with Discussions and Comments* (Sept. 2, 1965), House Committee Print, 89th Cong., 1st Sess. at 57 (quoted in Menell, *supra* note [CROSS\_REF] at 43-44 & n.194).

<sup>42</sup> Menell, *supra* note [CROSS\_REF] at 43.

had an ordinary or a specialized meaning: legislative history alone could overturn the teachings of prior law only in “rare and exceptional circumstances....”

Nevertheless, such precedents also suggest that in a few cases, the “strong” presumption favoring the ordinary meaning of an undefined statutory term could become much stronger. Suppose that an undefined statutory term was used in prior law, not as a term of art, but in its ordinary, dictionary-definition sense. Were such a term then used as an undefined statutory term in a subsequent statute on the same subject, then both the *Ardestani* and *Morrisette* presumptions would trigger. The ordinarily “strong” presumption favoring ordinary meaning should then become even stronger.

Such is the case with “to authorize.” Mr. Sargoy did not claim that his 1961 testimony or any other element of the legislative history of the 1976 Act had invented the idea of using “to authorize” to define the scope of the exclusive rights of copyright owners. Instead, he traced his proposal to the usual source from which ordinary or specialized meaning is derived—to prior law. Mr. Sargoy attributed his proposal to “British laws,” which had long used “authorize” to define the scope of copyrights and had long held that “[t]he word ‘authorize’ should be understood in its ordinary dictionary sense....”<sup>43</sup>

Nor were those British (and Canadian) laws unusual. British and Canadian copyright laws used “authorize” to define the scope of copyrights for the same reason as many other developed nations: Britain and Canada had long acceded to the world’s leading multilateral copyright treaty, and that treaty had long used the undefined term “authorize” to define the scope of the exclusive rights of copyright owners. That treaty, first promulgated in 1886, was the *Berne Convention for the Protection of Literary and Artistic Works*, which was sometimes called the “*International Copyright Convention*.”<sup>44</sup>

**b. Sargoy’s 1961 testimony and other evidence shows that “to authorize” actually traces back to prior law—including the 1886 *Berne Convention*.**

Looking back beyond the 1976 Act’s legislative history to prior law—as Mr. Sargoy’s testimony and cases like *Morrisette* require—proves that the idea of using “authorize” to define the scope of exclusive rights long predates September 14, 1961. Since at least 1886, American legislators and copyright experts had known that the laws of most developed nations, (including Britain and Canada), had defined copyrights as exclusive rights “to authorize” certain acts: Since 1886, “authorize” had defined the scope of the exclusive rights required by the world’s leading multilateral copyright treaty, the *Berne Convention*.<sup>45</sup>

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<sup>43</sup> *Falcon v. Famous Players Film Co.* [1926] 2 K.B. 474, 491 (U.K.).

<sup>44</sup> *Berne Convention for the Protection of Literary and Artistic Works* art. 5(2), Sept. 9, 1886, 25 U.S.T. 1341, 828 U.N.T.S. 221 (revised July 24, 1971). English translations of the exclusive-rights provisions of the *Berne Convention* interpret them to provide rights “to authorize” or rights of “authorizing.” Compare THORVALD SOLBERG, *INTERNATIONAL COPYRIGHT UNION: BERNE CONVENTION 1886 20-21* (Gov. Printing Office 1908) (interpreting the translation rights granted under the 1908 Berlin Revision as rights “to authorize”), with *id.* at 31 (interpreting the translation rights granted in 1886 and 1896 as rights of “authorizing”). As in the case of the U.S. shift from the 1790 gerund “publishing” to the 1909 infinitive “to publish,” *Berne-Convention* shifts from gerunds to infinitives suggest no intent to modify the substantive scope of the right.

<sup>45</sup> In fact, the importance of the *Berne Convention* to copyright law was called to the attention of Congress in 1885, by then-President Grover Cleveland. See THORVALD SOLBERG, *COPYRIGHT IN CONGRESS, 1789-1904 231-32* (Gov. Printing Office 1905); see also Thorvald Solberg, *The International Copyright Union*, 36 *Yale L.J.* 68 (1926-27) (summarizing the U.S. role in the development of the *Berne Convention*).

Since at least 1909, American copyright law had, in one case, followed this *Berne-Convention* practice and used “to authorize” to define the scope of an exclusive right. Section 1(c) of the Copyright Act of 1909 created a then-new exclusive right, “To deliver or authorize the delivery of the copyrighted work in public for profit if it be a lecture, sermon, address, or similar production...”<sup>46</sup> The House Report on the bill that became the Copyright Act of 1909, H.R. 28192, stated, “[Section 1(c)] is new, but is believed to be a wise provision, and it needs no explanation.”<sup>47</sup> But this new right could require “no explanation” only if “to authorize” was used in its ordinary sense. Section § 1(c) subsequently produced few or no reported decisions, so “[t]o... authorize” never acquired any specialized meaning under prior U.S. copyright law.<sup>48</sup>

Nor was § 1(c) of the 1909 Act the only domestic source from which U.S. legislators could have become acquainted with the practice of defining exclusive rights as rights “to authorize.” Since at least 1925, U.S. legislators had been proposing to define all U.S. exclusive rights as rights “to authorize” so the U.S. could join the *Berne Convention*.<sup>49</sup> Indeed, from the early 1920s to the early 1940s, Congress had hosted a series of sometimes-almost-successful proposals to accede to the *Berne Convention* or to conform U.S. copyright laws to the requirements of the *Berne Convention*.<sup>50</sup>

The last, and most ambitious, of these efforts to reform U.S. copyright laws so the U.S. could join the *Berne Convention* was initiated in 1938 by Columbia University law professor James Shotwell, Chairman of the National Committee of the United States of America on International Intellectual Cooperation.<sup>51</sup> In 1940, after two intensive years of study and negotiations with Congress and interested parties, the so-called “Shotwell Bill” was introduced in the Senate. It proposed that the exclusive rights granted by a *Berne*-compliant U.S. copyright act should become rights “to do and to authorize...”:

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<sup>46</sup> Copyright Act of 1909, Pub. L. No. 60-349, §§ 1(c), 35 Stat. 1075, 1075 (1909)

<sup>47</sup> H.R. Rep. No. 2222, 60th Cong., 2d Sess. 7 (1909); S. Rep. No. 1108, 60th Cong., 2d Sess. 7 (1909).

<sup>48</sup> A review of the LEXIS Federal Court Cases Combined, database revealed no published judicial decisions interpreting § 1(c). See Phanesh Koneru, *The Right “To Authorize” in U.S. Law: Questions of Contributory Infringement and Extraterritoriality*, 37 IDEA 87, 99 (1996) (“The Copyright Act does not define ‘authorization’ and apparently, no court has made a serious effort to define it.”). Nevertheless, the § 1(c) right must have been enforced, or its enforcement must have been threatened, often enough that in 1952, Congress re-enacted § 1(c), expanded its scope, and limited the damages available against good-faith infringements of the right by broadcasters. See Pub. L. No. 82-575, 66 Stat. 752 (1952).

<sup>49</sup> H.R. 11258, 68<sup>th</sup> Cong. § 12(a) (1925) (proposing an exclusive right “to authorize” any public use of a work). This was the so-called “Perkins Bill” drafted by Register of Copyrights Thorvald Solberg at the request of the Authors’ League of America. See ABE A. GOLDMAN, STUDY NO. 1: THE HISTORY OF U.S.A. COPYRIGHT LAW REVISION FROM 1901 TO 1954 5 (Comm. Print 1960).

<sup>50</sup> See ABE A. GOLDMAN, STUDY NO. 1: THE HISTORY OF U.S.A. COPYRIGHT LAW REVISION FROM 1901 TO 1954 4-12 (Comm. Print 1960).

<sup>51</sup> Shotwell strongly believed in using international law, agreements and organizations to prevent both injustice and war. See *generally*, HAROLD JOSEPHSON, JAMES T. SHOTWELL AND THE RISE OF INTERNATIONALISM IN AMERICA (Fairleigh Dickenson U. Press 1974).

Copyright under this act shall consist of the exclusive right to do and to authorize the doing of all or any of the acts specified in the in the following subsections in any form or manner and by any method or means now or hereafter known or devised....<sup>52</sup>

Moreover, the Shotwell Bill that had defined copyrights as exclusive rights “to do and to authorize” played an important role during the Fourth General Revision that produced the 1976 Act. After World War II, Zechariah Chafee, Jr., luminary of both First-Amendment and copyright law, had re-opened the question of what a “thoroughgoing revision” of U.S. copyright law should try to achieve in two influential law-review articles. In *Reflections on the Law of Copyright: I*, Chafee praised the Shotwell Bill for “conferring on the copyright owner the exclusive right *to do and to authorize* the doing of any of the listed acts “in any form or manner and by any method or means now or hereafter known or devised.”<sup>53</sup>

Later, in 1975, Register of Copyrights Barbara Ringer testified that the Shotwell bill had been an important influence on the Copyright Office during the Fourth General Revision:

[W]e got together all of the revision bills that had been introduced, going back to the 1920’s, and most importantly, the product of a very major effort that had been conducted just before World War II, which produced what is known as the Shotwell bill.... It had produced an excellent bill for the 1940’s but it died when the war came. I don’t think that speaks to any fault in the bill itself....<sup>54</sup>

All of this was well known to Messrs. Sargoy, Finklestein, and Goldman, to the Copyright Office, to Members of Congress, and to the Executive Branch.<sup>55</sup> But that raises a question: If conforming the scope of U.S. exclusive rights to those required by the *Berne Convention* was the obvious benefit of using the undefined term “to authorize” to define the scope of exclusive rights in a revised copyright act, then why was this not stated explicitly when the term “to do and to authorize” was adopted in the early-to-mid 1960s?

There was a good reason—one that arose after *another* major, multinational, (and then-recent), copyright treaty used “to authorize” to define the scope of exclusive rights. During the early-to-mid 1960s, the U.S. was leading a complementary (and potentially competing) effort in international copyright-norm setting, the *Universal Copyright Convention*, (the “UCC”).<sup>56</sup> After World War II, the U.S. was frustrated by preceding decades of never-quite-successful efforts to enact fully *Berne*-compliant

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<sup>52</sup> S. 3043, 76<sup>th</sup> Cong. § 2 (1940). As a result, by 1961, the phrase that would define the scope of the exclusive rights in the 1976 Act—“to do and to authorize”—was celebrating the 21<sup>st</sup> anniversary of its introduction into the *Congressional Record*.

<sup>53</sup> Zechariah Chafee, Jr. *Reflections on the Law of Copyright: I*, 45 Colum. L. Rev. 503 (1945); see also GREAT AMERICAN LAW REVIEWS (Robert. C. Berring, ed. 1985) (including both parts of Chafee’s *Reflections on the Law of Copyright*); see generally, DONALD L. SMITH, ZECHARIAH CHAFEE JR.: DEFENDER OF LIBERTY AND LAW (Harvard U. Press 1986).

<sup>54</sup> *Id.* at 1784-85

<sup>55</sup> *E.g.*, *Summary of Proceedings*, 1955 A.B.A. SEC. PAT. TRADEMARK & COPYRIGHT L. PROC. 19 (1955) (“Mr. Sargoy dealt in particular upon the so-called Shotwell Committee Bill which was introduced in 1940...”); Herman Finklestein, *Copyright Law—A Reappraisal*, 104 U. PA. L. REV. 1025, 1056 (1955-56) (discussing the Shotwell Bill); ABE A. GOLDMAN, STUDY NO. 1: THE HISTORY OF U.S.A. COPYRIGHT LAW REVISION FROM 1901 TO 1954 10-11 (Comm. Print 1960) (same).

<sup>56</sup> Universal Copyright Convention, Sept. 6, 1952, 6 U.S.T. 2732, 216 U.N.T.S. 132, revised by the Universal Copyright Convention, July 24, 1971, 25 U.S.T. 1341, 943 U.N.T.S. 178.

copyright laws. Through the United Nations Educational, Scientific and Cultural Organization, (UNESCO), the U.S. thus led a long-proposed effort to develop a “bridge” treaty that would let both the Member States of the *Berne Union* and countries whose laws did not comply with the *Berne Convention’s* minimum standards form multilateral copyright relations based upon the *Berne-Convention* premise of national treatment and much weaker minimum standards.<sup>57</sup> In 1952, those efforts produced the *UCC*.<sup>58</sup>

The 1952 version of the *UCC* achieved the remarkable feat of attracting the participation of both non-*Berne*-compliant nations and the members of the *Berne Union*. But in 1952, the *UCC* was a skeletal agreement: Like the 1886 version of the *Berne Convention*, it provided for little more than national treatment, some limits on permissible formalities, and an exclusive right “to authorize” translations. Unlike the *Berne Convention*, the *UCC* also took a scattershot, least-common-denominator approach to minimum standards for copyright protection.

Indeed, loose minimum standards were the *UCC’s* reason for being: Many countries found it hard to join the *Berne Convention* because of its demanding minimum standards: In effect, the drafters and revisers of the *Berne Convention* had asked what protections a sound copyright system should provide and set minimum standards accordingly.<sup>59</sup> By contrast, the *UCC* set a much lower bar by asking what protections most fairly developed countries could agree to provide. To an extent, the *Berne Convention* Members thus bet on the superiority of their more demanding approach by participating in the *UCC*: while the *UCC* was formally intended only as complementary “bridge” to the *Berne Convention*, the *UCC* certainly could have evolved into a competing source of international norms that could have supplanted the *Berne Convention*.<sup>60</sup>

But during the early-to-mid 1960s, the long-term vitality of the *UCC* remained profoundly unclear.<sup>61</sup> This left those participating in U.S. domestic copyright-reform efforts in an awkward position. On the one hand, whenever they could do so, conforming a revised U.S. copyright act to *Berne-Convention* norms would be prudent and pragmatic. On the other, too much talk of conforming U.S. law to *Berne-Convention* norms could have undermined the prospects of the *UCC*. Participants in the Fourth General

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<sup>57</sup> See Arpad Bogsch, *Co-Existence of the Universal Copyright Convention with the Berne Convention*, in *Universal Copyright Convention Analyzed*, 141, 144 (Theodore R. Kupferman & Mathew Foner, eds., 1955) (discussing the origins of the *UCC*).

<sup>58</sup> See S. Exec. Doc. No. 83-5 (1954) (ratifying the *UCC* because the U.S. had “found it impossible to subscribe to the [*Berne Convention*]... because it embodied concepts at variance with American Copyright Law” like formality-free protection, moral rights, and copyright-restoration obligations); but cf. Orrin G. Hatch, *Better Late than Never: Implementation of the 1886 Berne Convention*, 22 *Cornell Int’l L.J.* 171, 174, 176 (1984) (arguing that the protectionist “manufacturing” clause was a major unstated reason for U.S. inability to join the *Berne Convention*).

<sup>59</sup> See, e.g., G. B. Crewe, *National Treatment as the Basis for a Universal Copyright Convention*, 3 *UNESCO COPYRIGHT BULLETIN* no. 1 at 6 (1969) (the chief U.K. delegate to the 1948 Brussels Conference argues that the *Berne Convention* must remain “the standard *par excellence* of copyright protection”)

<sup>60</sup> Orrin G. Hatch, *Better Late Than Never: Implementation of the 1886 Berne Convention*, 22 *CORNELL INT’L L.J.* 171, 177 (1989) (quoting a U.S. official describing the *UCC* as “a bridge leading to ultimate adherence to *Berne*”).

<sup>61</sup> By 1963, the question of how to incorporate newly independent and developing countries into the *UCC* and the *Berne Convention* was already delaying efforts to revise the *UCC*. See, Kelsey Martin Mott, *The Relationship between the Berne Convention and the Universal Copyright Convention*, 11 *Pat. Trademark & Copy. J. Res. & Ed.* 306, 325-26 (1966-67).

Revision seem to have balanced these conflicting concerns as best they could.<sup>62</sup> Fortunately, by the time the 1976 Act was passed, two factors had vastly reduced any relevant tensions between the *Berne Convention* and the *UCC*.

*First*, by the end of 1971, coordinated review and revision processes had made the *Berne Convention* and the *UCC* more similar in scope and content, though the *UCC* still retained its lowest-common-denominator approach to minimum standards.<sup>63</sup> Nevertheless, its 1971 version required member states to protect many of the same exclusive rights protected in the 1971 version of the *Berne Convention*. And like the *Berne Convention*, the 1971 *UCC* defined those exclusive rights as rights “to authorize” various acts. By the time the 1976 Act was enacted, defining U.S. exclusive rights as rights “to do and to authorize” thus reconciled U.S. copyrights with the requirements of *both* of the major multilateral copyright treaties, including the one that the U.S. had already ratified.

*Second*, by 1975, it had also become clear that the *UCC* would never challenge the *Berne Convention*: the credibility of the *UCC* lay in ruins for an ironic reason. Even in the 1880s, the drafters of the *Berne Convention* had always hoped to develop truly global norms for copyright protection. As a result, they had always actively solicited the accession of two “countries of the first rank”—the United States and Russia.<sup>64</sup> But in 1973, the *UCC* became the first multinational copyright treaty to secure the accession of not only the United States, but also the second of those “countries of the first rank”—the state then known as the Union of Soviet Socialist Republics (the “USSR”).

But the USSR’s communist dictators did not join the *UCC* to support U.S. diplomacy or because they had suddenly realized that copyrights can promote commercial investment in the production of expression and create an independent creative sector driven by private investment and the preferences of private audiences. Rather, they joined the *UCC* because its loose approach to minimum standards might have let them suppress publication and dissemination in the West of the works of Soviet dissidents, like a most unwelcome book entitled *The Gulag Archipelago*.<sup>65</sup>

While the resulting uproar caused the USSR to back down from this threat, it also discredited the *UCC*. It did not cease to exist, but neither did it recover from the realization that really loose minimum standards could vest copyrights in a work’s author—or in an author’s State censor. In the 1976 Act,

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<sup>62</sup> For example, the 1965 *Supplementary Report of the Register of Copyrights* cited the *UCC* at least twelve times, but the *Berne Convention* only three times, and never when discussing the scope of exclusive rights.

<sup>63</sup> In addition to substantive revisions, the 1971 revisions to the *UCC* and the *Berne Convention* also addressed ongoing questions about how copyrights and other intellectual-property rights should be enforced in developing nations. See generally, SAM RICKETSON, *THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886—1986* 593-629 (Kluwer 1987); Melville B. Nimmer, *Implications of the Prospective Revisions of the Berne Convention and the United States Copyright Law*, 19 *Stan. L. Rev.* 499 (1967).

<sup>64</sup> THORVALD SOLBERG, *INTERNATIONAL COPYRIGHT UNION: BERNE CONVENTION 1886* 31 (Gov. Printing Office 1908).

<sup>65</sup> See, e.g., Robert J. Jinnett, *Adherence of the U.S.S.R. to the Universal Copyright Convention: Defenses under U.S. Law to Possible Soviet Attempts at Achieving International Censorship*, 8 *CORNELL INT’L L.J.* 71 (1974-1975); Michael A. Newcity, *The Universal Copyright Convention as an Instrument of Repression: The Soviet Experiment*, 9 *J. INT’L L. & ECON.* 285 (1974); Jeffrey Lee Ross Jr., *Soviet Accession to the Universal Copyright Convention: Possible Implications for Future Foreign Publication of Dissidents’ Works*, 4 *GA. J. INT’L & COMP. L.* 404 (1974).

Congress thus enacted provisions intended to protect both foreign authors and U.S. citizens from the potentially dangerous effects of the *UCC*.<sup>66</sup>

Afterwards, the U.S. and the world shifted decisively towards the more-demanding *Berne Convention*. By 1988, the U.S. had acceded to the *Berne Convention*.<sup>67</sup> In 1994, Berne's drafters then achieved their century-old goal of creating truly global norms for copyright protection: In the *Agreement on Trade-Related Aspects of Intellectual Property Rights*, the *Berne-Convention* norms for copyright protection became *de jure* global norms enforced by the World Trade Organization.<sup>68</sup>

In conclusion, the history just summarized clarifies the true origins of the term "to do and to authorize" in § 106 of the 1976 Act. It also makes a broader point: During the 20<sup>th</sup> Century, the U.S. simultaneously pursued *two* equally important copyright-reform efforts. One was a domestic effort to reform and improve upon the idiosyncratic, outdated and technology-specific Copyright Act of 1909. The other was an international effort to improve the multilateral copyright relations of the United States and to develop a truly global set of international norms for copyright protection. Legislative history is hardly needed to explain why those efforts had to be closely coordinated.

*Berne-Convention* and *UCC* norms thus best explain why "to authorize" repeatedly entered U.S. copyright law and why the 1976 Act adopted the *Berne*-focused Shotwell Bill's proposal to define U.S. copyrights as exclusive rights "to do and to authorize." They should also foreclose any serious claim that the drafters of the 1976 Act could have intended for "to authorize" to have only some specialized and unnaturally narrow meaning. That would eliminate the major benefit of adopting the Shotwell-Bill proposal to redefine U.S. copyrights as exclusive rights "to do and to authorize."

**c. Interpreting "To Authorize" in Light of the *Berne Convention*, the *UCC*, and § 1(c) of the Copyright Act of 1909.**

Supreme-Court precedents—including cases interpreting the Copyright Act of 1976—strongly presume that Members of Congress would conclude that an undefined term like "to authorize" was intended to have its ordinary meaning *unless* it was already a legal term of art that had developed some specialized meaning under prior law. The preceding analysis identified three sources of prior law to which Congress might have looked: (1) the *Berne Convention*, (2) the *Universal Copyright Convention*, and (3) Section 1(c) of the Copyright Act of 1909.

Fortunately, all three sources seem to derive from the *Berne Convention* practice of using "authorize" to define the scope of exclusive rights, so all three support the same conclusion: Under prior U.S. copyright law, the *Berne Convention* and the *UCC*, "to authorize" was consistently accorded its ordinary meaning.

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<sup>66</sup> See 17 U.S.C. § 201(e). The *UCC* suffered another crippling blow in 1983, when the U.S. withdrew from UNESCO, the body that administered the *UCC*. See Orrin G. Hatch, *Better Late Than Never: Implementation of the 1886 Berne Convention*, 22 CORNELL INT'L L.J. 171, 177-78 (1989).

<sup>67</sup> See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853; see also *FINAL REPORT OF THE AD HOC WORKING GROUP ON U.S. ADHERENCE TO THE BERNE CONVENTION*, reprinted in *U.S. Adherence to the Berne Convention: Hearings Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary*, 99th Cong., 1st & 2d Sess. 504-05 (1985-86).

<sup>68</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights Annex 1C, Part II, Apr. 15, 1994, 33 I.L.M. 1197 (1994); see also Silke von Lewinski, *The Role and Future of the Universal Copyright Convention*, E-COPYRIGHT BULLETIN (UNESCO Oct.-Dec. 2006) (discussing the continued but limited role of the *UCC*).

Neither the *Berne Convention* nor the *UCC* define the term “to authorize” and undefined terms in treaties are presumed to retain their ordinary meanings.<sup>69</sup> Under both treaties, the practice of using “to authorize” to define the scope of exclusive rights began with the exclusive right of translation protected in their first promulgated versions. In the case of translation, most authors would be personally incapable of “doing” the actual translating. Consequently, the translation right was framed as one “to authorize”: it was the exclusive right to decide who would be permitted to perform the act protected by the right—the act of translation.<sup>70</sup> The term was thus used in its broad, ordinary sense.

Nothing changed when “to authorize” was again used to define the scope of new exclusive rights added in later revisions of both treaties.<sup>71</sup> For example, one authority defines the *Berne-Convention* concept of authorization as follows: “[A]uthorization’ refers to permission for doing a certain act.”<sup>72</sup> Similarly, Australia held the distributors of the file-sharing program KaZaA liable for “authorizing” infringing uses of their program and network, even though their terms of service prohibited infringing uses.<sup>73</sup>

The same conclusion follows under § 1(c) of the 1909 Act. Prior law and legislative history confirms that “to authorize” was used in its ordinary sense in § 1(c) of the 1909 Act; it acquired no clear established specialized meaning from judicial decisions issued between 1909 and 1952; and it was re-enacted unchanged in 1952—just before the formal processes of the Fourth General Revision began.<sup>74</sup> This creates a “strong presumption” that “to authorize” was intended to have its ordinary meaning when used as an undefined statutory term in § 106 of the 1976 Act.

Finally, because the use of “to authorize” to define exclusive rights derives, in part, from practice under the *Berne Convention*, it is important to consider whether the term’s interpretation is affected by § 104(c) of the current Copyright Act: “Any rights in a work eligible for protection under this title that derive from this title... shall not be expanded or reduced by virtue of, or in reliance upon, the provisions of the *Berne Convention*, or the adherence of the United States thereto.”<sup>75</sup>

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<sup>69</sup> See Vienna Convention on the Law of Treaties, art. 31(1), (4) 23 May 1969, 1155 U.N.T.S. 331 (discussing ordinary and specialized meanings of undefined terms in treaties); RESTATEMENT (THIRD) OF FOREIGN RELATIONS LAW § 325 (1987) (“An international agreement is to be interpreted in good faith in accordance with the ordinary meaning to be given to its terms in their context and in the light of its object and purpose.”).

<sup>70</sup> WORLD INTELLECTUAL PROPERTY ASSOCIATION, GUIDE TO THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS 53 (1978).

<sup>71</sup> See, e.g., *id.* at 66 (“The primary right is to authorize the broadcasting of a work.... What matters is the emission of signals; it is immaterial whether or not they are in fact received”).

<sup>72</sup> J.A.L. STERLING, WORLD COPYRIGHT LAW 998 (2<sup>nd</sup> ed. 2003) (citing U.K. law); *accord* *Falcon v. Famous Players Film Co.* [1926] 2 K.B. 474, 491 (U.K.) (“The word ‘authorize’ should be understood in its ordinary dictionary sense of ‘sanction, approve, and countenance.’”); Sam Ricketson & Jane C. Ginsburg, *Inducers and Authorisers: A Comparison of the US Supreme Court’s Grokster Decision and the Australian Federal Court’s KaZaa Ruling*, 10 (2006). (Columbia Pub. Law & Legal Theory Working Papers, Paper 0698) available at [http://lsr.nellco.org/columbia\\_pllt/0698](http://lsr.nellco.org/columbia_pllt/0698) (“‘Authorization’... has been interpreted by courts in both Australia and the UK as having its ordinary dictionary sense of ‘sanction, approve and countenance’”).

<sup>73</sup> *Universal Music Austl. Pty Ltd. v. Sharman License Holdings Ltd.*, [2005] F.C.A. 1242, available at [http://www.austlii.edu.au/?au/cases/cth/federal\\_ct/2005/1242.html](http://www.austlii.edu.au/?au/cases/cth/federal_ct/2005/1242.html).

<sup>74</sup> See Act of July 17, 1952, Pub. L. No. 82-575, 61 Stat. 653.

<sup>75</sup> 17 U.S.C. § 104(c).

This provision was added by the Berne Convention Implementation Act of 1988 because that Act's name was an overstatement: the Act arguably did not implement at least two requirements imposed by the *Berne Convention*.<sup>76</sup> The first were the "moral rights" required by Article 6bis of the *Berne Convention*. The second—and by far the more important—were the so-called "copyright restoration" obligations imposed by the "Rule of Retroactivity," Article 18 of the *Berne Convention*.<sup>77</sup>

Fortunately, the case for U.S. compliance with moral-rights obligations was strengthened by the Visual Artists Rights Act of 1990, and copyright-restoration obligations were enacted in the Uruguay Round Amendments Act of 1994.<sup>78</sup> While these pieces of subsequently enacted legislation redressed the concerns that had prompted § 104(c), the provision itself remained. Nevertheless, with the exception of the moral-rights obligations imposed by Article 6bis, § 104(c) should now be irrelevant in any case involving obligations imposed by Articles 1 through 21 of the *Berne Convention*. In 1994, those provisions were incorporated into an international agreement as to which § 104(c) is explicitly inapplicable, the WTO-enforceable *Agreement on Trade-Related Aspects of Intellectual Property Rights*.<sup>79</sup>

Fortunately, even were it still relevant and interpreted broadly, § 104(c) should have no practical effect upon the interpretation of "to authorize," or "to distribute" in § 106 of the 1976 Act. For example, assume, *arguendo*, that, as applied to the *Berne Convention* alone, § 104(c) not only indicates that this treaty is to be treated as non-self-executing, but also that courts cannot apply *Charming-Betsy* deference or other rules of statutory interpretation that would otherwise require them to adopt reasonable interpretations of the U.S. Copyright Act because they would implement provisions of the *Berne Convention*.

If so, then the preceding analysis remains valid. It neither presumed that the *Berne Convention* was self-executing nor relied upon *Charming-Betsy* deference. Indeed, using then-available prior law (like the *Berne Convention*) to understand how a legislator or executive in 1976 would have understood the term "to authorize" is the only way to ensure that "rights in a work ... shall not be expanded *or reduced* by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto."<sup>80</sup> Consequently, § 104(c) in no way undermines the presumption favoring the ordinary meaning of "to authorize."

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<sup>76</sup> Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853.

<sup>77</sup> See Ralph Oman, *The United States and the Berne Union: An Extended Courtship*, 3 J.L. & TECH. 71, 92 (1989) ("The Copyright Office believes Congress must address the retroactivity issue...."). During the period from 1920 to 1940, this "restoration" obligation, arguably more than any other, had consistently hobbled U.S. efforts to join the *Berne Convention*. Simply put, restoration ensured that a given U.S. copyright industry's attitude toward the *Berne Convention* could vary constantly, depending upon whether one or more of its major participants was then commercially exploiting a U.S.-public-domain work in which copyrights might be restored, were the U.S. to join the *Berne Convention*.

<sup>78</sup> Visual Artists Rights Act, Pub. L. No. 101-650, 104 Stat. 5128 (1990); Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809, 4973 (1994).

<sup>79</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights, Annex 1C, Part II, Art. Apr. 15, 1994, 33 I.L.M. 1197 (1994)

<sup>80</sup> 17 U.S.C. § 104(c) (emphasis added). Moreover, even an impermissibly extreme interpretation of § 104(c) cannot materially affect the best interpretation of "to authorize." Assume, *arguendo*, that § 104(c) were interpreted as a "gag order" that prohibited judges or litigants interpreting our Copyright Act to acknowledge the existence of the

At this point, analysis of the best interpretation of “to authorize” could conclude. When implicated, the presumption favoring the ordinary meaning of an undefined statutory term like “to authorize” can be “rebutted only in rare and exceptional circumstances... when a contrary legislative intent is clearly expressed.”<sup>81</sup> In light of the overwhelming evidence favoring the ordinary meaning of “to authorize,” no “rare and exceptional circumstances” or “contrary legislative intent... clearly expressed” exist.

## 2. The Narrow *Venegas* Interpretation of “To Authorize” Is Implausible and Impermissible.

The preceding analysis would resolve the entire making-available-right debate—but for what could be called the “*Venegas* interpretation” of “to authorize.”<sup>82</sup> Because “to authorize” was repeatedly used in its ordinary sense in prior domestic and international copyright law, “Only ‘the most extraordinary showing of contrary intentions’ in the legislative history [of the 1976 Act could] justify a departure from that language.”<sup>83</sup> But in *Venegas-Hernandez v. ACEMLA*, the U.S. Court of Appeals for the First Circuit held that one sentence extracted from the voluminous legislative history of the 1976 Act proved that “to authorize” was not intended to have its ordinary meaning.

But the *Venegas* interpretation takes one ambiguous sentence of legislative history out of context in order to give “to authorize” a *specialized meaning* previously unknown to law or ordinary English. In effect, the *Venegas* interpretation asserts that the 20-year process of drafting the 1976 Act was intended to grant copyright owners exclusive rights “to do or to contribute to the doing of” certain acts, but Congress somehow forgot all of the familiar terms that could have expressed that intent unambiguously. Instead, it granted exclusive rights “to do or to authorize” certain acts—thus using a term never before associated with contributory liability to express only the idea of contributory liability.

That seems implausible. Indeed, this odd interpretation of “to authorize” arose when *dicta* met error. It was first suggested in Ninth-Circuit *obiter dicta* in *Subafilms, Ltd., v. MGM-Pathe Comms. Co.*, a case holding only that one cannot infringe copyrights by “authorizing” *noninfringing* acts.<sup>84</sup> Nevertheless, *Subafilms* did suggest in passing that one sentence plucked from the legislative history of the 1976 Act could suggest that “to authorize was simply a convenient peg on which Congress chose to hang the antecedent jurisprudence of third party liability.”<sup>85</sup> But this suggestion was *dicta*: *Subafilms* expressly reserved the question of whether “liability might attach when a party authorizes an act that *could*

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*Berne Convention*. Even that overbroad interpretation of § 104(c) would not affect the *results* of the preceding analysis. Two permissible means of assessing the intended meaning of “to authorize”—the *UCC* and prior U.S. copyright laws—would still prove that “to authorize” was intended to have its ordinary meaning when used to define the scope of exclusive rights.

<sup>81</sup> *Ardestani v. INS*, 502 U.S. 129, 135-35 (1991).

<sup>82</sup> See *Venegas-Hernandez v. ACEMLA*, 424 F.3d 50, 57-58 (1<sup>st</sup> Cir. 2005). The *Venegas* interpretation also appeared in an older district court case. *SBK Catalogue Partnership v. Orion Pictures Corp.*, 723 F. Supp. 1053, 1065 (D.N.J. 1989); see also *id.* at 1062 n.9 (noting that the defendants had repeatedly failed to support objections to this interpretation with any “legal precedent”).

<sup>83</sup> *United States v. Albertini*, 472 U.S. 675, 680 (1985) (quoting *Garcia v. United States*, 469 U.S. 70, 75 (1984)).

<sup>84</sup> 24 F.3d 1088, 1094 (9<sup>th</sup> Cir. 1994) (en banc) (holding that a defendant could not be “liable for merely ‘authorizing’ conduct that, had the authorizing party chosen to engage in itself, would have resulted in no liability under the Act”).

<sup>85</sup> *Id.* at 1093.

constitute infringement, but the ‘attempted’ infringement fails.”<sup>86</sup> And when the Ninth Circuit finally addressed that reserved question, it twice found that “sharing” a copyrighted file infringes the distribution right.<sup>87</sup> Unfortunately, in 2005, the long-abrogated *Subafilms dicta* on “to authorize” generated a precedent when *Venegas-Hernandez v. ACEMLA* mistook it for the law of the Ninth Circuit.<sup>88</sup>

*Venegas* was the sort of hard case that tends to make bad law. In *Venegas*, unappealing Plaintiffs acquired fractional interests in the copyrights in their fathers’ songs by suing their mother and getting an unanticipated interpretation of Puerto Rico’s law of intestate succession. After suing their mother, the *Venegas* Plaintiffs then sued the music-licensing organization that had contracted with their mother in good faith. They argued that “to authorize” showed that this licensing organization had infringed their copyrights even if it had acted reasonably and no unlicensed performances had occurred. In *Venegas*, the First Circuit ruled against these Plaintiffs by mistaking *Subafilms’ dicta* for a holding that had narrowly interpreted “to authorize.”

*Venegas* thrice admitted that this narrowing interpretation of “to authorize” was very strained. “Admittedly, the better bare-language reading would allow the claims in question....” “Looking only at the statutory language, one might well think that authorization alone could well be infringement.” “[T]he authorizing person could (as a matter of language) be treated as an infringer subject to statutory damages even if no infringing act ... actually occurred.”<sup>89</sup> Nevertheless, *Venegas* adopted *Subafilms’* narrow interpretation for two reasons: “Occasionally, and we think this true here, the case is so close and the stakes low enough that maintaining uniformity [between circuits] tips the balance.”<sup>90</sup>

*Venegas* should have no persuasive value in the making-available-right debate. The *Venegas* Panel did not know that it was choosing between interpretations of “to authorize” that could cause the world’s leading exporter of copyrighted works to violate over a dozen international agreements. In such a situation, the “stakes” are not “low,” and *Subafilms* itself had warned against judicial interpretations of the 1976 Act that “might disrupt Congress’s efforts to secure a more stable international intellectual property regime unless Congress otherwise clearly has expressed its intent.”<sup>91</sup>

Consequently, the *Venegas* attempt to “maintain uniformity” backfired. *Venegas* failed to realize that the *Subafilms* interpretation of “to authorize” was *dicta*.<sup>92</sup> And it failed to realize that in *Napster*, (and

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<sup>86</sup> *Id.* at 1094 n.8.

<sup>87</sup> *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1162 (9<sup>th</sup> Cir. 2007) (“distribution rights ...were infringed by Napster users ... when they used the Napster software to make their collections available to all other Napster users”); *A&M Records v. Napster, Inc.*, 239 F.3d 1004, 1014 (9<sup>th</sup> Cir. 2001) (same).

<sup>88</sup> 424 F.3d 50, 58-59 (1<sup>st</sup> Cir. 2005).

<sup>89</sup> *Venegas-Hernandez v. ACEMLA*, 424 F.3d 50, 57-58 (1<sup>st</sup> Cir. 2005).

<sup>90</sup> *Id.* at 59.

<sup>91</sup> *Subafilms, Ltd. v. MGM-Pathe Comms. Co.*, 24 F.3d at 1097; *see also*, *Golan v. Holder* 132 S. Ct. 873, 889 n.28 (2012) (concluding that the case for “an isolationist reading of the Copyright Clause that is in tension with... America’s international copyright relations over the last hundred or so years” had been “persuasively refut[ed]”) quoting Graeme W. Austin, *Does the Copyright Clause Mandate Isolationism?* 26 COLUM. J. L. & ARTS 17, 59 (2002)).

<sup>92</sup> *Compare Venegas*, 424 F.3d at 55 (refusing to “attribute too much” to *dicta* in a Supreme-Court decision because the Court had “refused to decide” the relevant question), *with Subafilms, Ltd., v. MGM-Pathe Comms. Co.*, 24 F.3d 1088, 1094 n.8 (9<sup>th</sup> Cir. 1994) (en banc) (refusing to decide whether “liability might attach when a party authorizes an act that *could* constitute infringement, but the ‘attempted’ infringement fails”).

later in *Perfect Ten*) the Ninth Circuit had confronted *Subafilms'* reserved question and found that making copies of works available infringes the distribution right. *Venegas* thus created a circuit split by narrowly interpreting “to authorize” in order to “maintain [inter-circuit] uniformity.”

These origins notwithstanding, at least four district courts have adopted the *Venegas* interpretation of “to authorize.”<sup>93</sup> One treatise even hailed *Venegas* as “putting an end to what was already a closed question.”<sup>94</sup> But the reasoning of *Venegas* is profoundly flawed. The *Venegas* interpretation of “to authorize” reads in isolation one sentence in the *Committee Reports* on the bills that became the Copyright Act of 1976: “Use of the phrase ‘to authorize’ is intended to avoid any questions as to the liability of contributory infringers.”<sup>95</sup>

The problem with this sentence is not its source—the Supreme Court has repeatedly relied upon these *Committee Reports* to interpret the 1976 Act.<sup>96</sup> Rather, the problem is that this sentence neither expressed nor implied intent to narrow the ordinary meaning of “to authorize.” Giving “to authorize” its ordinary meaning would also “avoid any questions as to the liability of contributory infringers.” Consequently, when the *Committee Reports* on the 1976 Act expressly identified one class of cases that “to authorize” would encompass, they neither rejected the term’s ordinary meaning nor expressed any intent to exclude any other classes of cases that this term would ordinarily encompass.<sup>97</sup>

Nevertheless, *Venegas* held that this sentence *meant* what it did not *say* by implicitly invoking the doctrine of *expressio unius est exclusio alterius*, which means that the enumeration of two or more classes of included cases *may* imply intent to exclude non-enumerated classes.<sup>98</sup> *Venegas* used *expressio unius* to reason that when the *Committee Reports* expressed intent for “to authorize” to encompass cases in which courts would have imposed contributory liability, this *implied* an otherwise unstated intent that “to authorize” should encompass *only* such cases—even though its ordinary

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<sup>93</sup> *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210, 1220-21 (D. Minn. 2008); *Atlantic Recording Co. v. Howell*, 554 F. Supp. 2d 976, 987 (D. Ariz. 2008); *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153, 173 (D. Mass. 2008); *Elektra Ent. Group, Inc. v. Barker*, 551 F. Supp. 2d 234, 245-46 (S.D.N.Y. 2008).

<sup>94</sup> 6 WILLIAM F. PATRY, PATRY ON COPYRIGHTS § 21:43 (2008). It is dishonest to claim that *Venegas* put “an end to what was already a closed question.” *Venegas* itself was admirably honest about thrice admitting that was denying “to authorize” its ordinary meaning because it believed that “the stakes were low enough” to follow a deficient analysis of legislative history and a misreading of *Subafilms*. See 424 F.3d at 57-58; cf. Carson, *supra* note [CROSS REF], at 159 (explaining why “the court’s reasoning in [*Venegas*] is dubious” and “highly questionable”).

<sup>95</sup> H.R. Rep. 1476, 94<sup>th</sup> Cong. 2<sup>nd</sup> Sess. at 61 (emphasis added).

<sup>96</sup> See, e.g., *Eldred v. Ashcroft*, 537 U.S. 186, 209 n.16 (2003) (“the authoritative source for finding the Legislature’s intent lies in the Committee Reports”); *Harper & Row, Pubs. v. Nation Ent.*, 471 U.S. 539, 552 (1985) (quoting the Committee Reports to show that the Copyright Act protects rights of publication and first publication).

<sup>97</sup> See *Smith v. United States*, 508 U.S. 223, 230 (1993) (warning of “the significant flaw” in a claim that since the phrase “uses a firearm” was intended to encompass cases in which the firearm was used as a weapon, “the phrase also excludes any other use”); compare 4 WILLIAM F PATRY, PATRY ON COPYRIGHT § 13:9 (2008) (discussing the fallacy of affirming the consequent), with 6 *id.* at § 21.43 (committing the fallacy of affirming the consequent when interpreting “to authorize”).

<sup>98</sup> See REED DICKERSON, THE INTERPRETATION AND APPLICATION OF STATUTES 234-35 (1975). It turns out to be telling that the sentence relied upon by *Venegas* fails to meet these minimum standards for applying *expression unius* because it enumerated only a single class of cases that “to authorize” was intended to encompass. See also *Pauley v. Bethenergy Mines, Inc.*, 501 U.S. 680, 703 (1991) (“the principle *expressio unius est exclusio alterius* ‘is a questionable one in light of the dubious reliability of inferring specific intent from silence’”) (quotation omitted).

meaning is much broader. For the following reasons, this interpretation of “to authorize” is impermissible.

**Courts cannot invoke *expressio unius* to interpret committee reports:** The Supreme Court has twice unanimously forbidden attempts to deny statutory terms their ordinary meaning by using *expressio unius* to interpret committee reports. In *Standefer v. United States*, the Supreme Court was “unwilling to ‘apply... [*expressio unius*] to the language employed in a committee report” because this “would permit an omission in the legislative history to nullify the plain meaning of a statute.”<sup>99</sup> In *Whitfield v. Hall*, the Court again rejected the “strange canon of statutory construction that would require Congress to state in committee reports... that which is obvious on the face of the statute.”<sup>100</sup> *Standefer* thus prohibited the *Venegas* interpretation of “to authorize,” and *Whitfield* abrogated it.

**As a whole, the *Committee Reports* reveal no intent to narrowly interpret “to authorize”:** Even were it not clear error to use *expressio unius* to interpret a sentence in a committee report, it would still be error to divine otherwise-unspoken intent by applying *expressio unius* to the sentence about “to authorize” and contributory liability.

At best, *expressio unius* recognizes that the enumeration two or more classes of included cases *may* imply intent to exclude non-enumerated classes.<sup>101</sup> Consequently, it cannot be used to imply narrowing intent from a sentence in Committee Reports if other sentences in those Reports expressed intent to cover classes of cases not enumerated in that sentence. For three reasons, the *Committee Reports* on the bills that became the 1976 Act thus prohibit the narrowing construction that *Venegas* adopted.

*First*, the example of “authorizing” liability given in the next sentence of these *Reports* forecloses any claim that there is “contrary legislative intent... clearly expressed” that narrowed the ordinary meaning of “to authorize.” This example asserts that “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.”<sup>102</sup>

In this example, the movie has not been rented to others—it has only been made available for rental. A modern analog would be the operator of a commercial video-streaming website who obtains a lawful copy of a film and then makes it available via streaming to his paying subscribers “for purposes of unauthorized public performance....” Moreover, Professor Menell’s re-discovery of Mr. Sargoy’s testimony shows that this example of “authorizing” liability derived from testimony proposing that “to authorize” should be used to define the scope of exclusive rights and should be given the ordinary meaning accorded the term under British law. The *Committee Reports* thus reveal no “contrary legislative intent... clearly expressed” that could narrow the ordinary meaning of “to authorize.”

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447 U.S. 10, 20 n.12 (1980) (emphasis in original, citation omitted).

<sup>100</sup> 543 U.S. 209, 216 (2004) (citation omitted); *see also id.* (noting that the ordinary meaning of statutory text cannot be narrowed by “mere silence in the legislative history”).

<sup>101</sup> *See* REED DICKERSON, THE INTERPRETATION AND APPLICATION OF STATUTES 234-35 (1975) (“Without contextual support... there is not even a mild presumption [favoring the application of *expressio unius*].”).

<sup>102</sup> *E.g.*, H.R. Rep. 1476, 94<sup>th</sup> Cong. 2<sup>nd</sup> Sess. at 61 (emphasis added).

*Second*, the *Reports* also told courts to keep imposing *vicarious liability*—a form of secondary liability *not enumerated* in the *Venegas* sentence about “to authorize” and “contributory infringers.”<sup>103</sup> That precludes any inference “to authorize” was meant to encompass only forms of liability enumerated in that sentence. For example, even the *Subafilms dicta* adopted in *Venegas* asserted “that ‘to authorize’ was simply a convenient peg on which Congress chose to hang the antecedent jurisprudence of third party liability”—not just contributory liability. That alone forecloses any possibility of inferring intent to exclude from the *Committee Reports’* sentence about “to authorize” and contributory liability.

*Third*, the *Reports* also expressed Congress’ intent “to set forth the copyright owner’s exclusive rights *in broad terms* in section 106, and then to provide various limitations, qualifications, or exemptions in the 12 sections that follow.”<sup>104</sup> The *Committee Reports* themselves thus assert that Congress intended to express the exclusive rights of copyright owners in broad terms in Section 106 and to narrow or limit them only as prescribed in the statute itself—not in its *Committee Reports*.

**As a whole, the legislative history of the 1976 Act does not reveal “clearly expressed” legislative intent to narrow the ordinary meaning of “to authorize”:** Here, the legislative history identified in Professor Menell’s *Lost Ark* paper becomes critical. *Venegas* quoted an ambiguous sentence of legislative history as if it were the only one relevant to the interpretation of “to authorize.”<sup>105</sup> But Professor Menell disproved that claim. In fact, “to authorize” was incorporated into the copyright-revision bills that became the 1976 Act after the General Counsel of ASCAP proposed to define exclusive rights as rights “to authorize” because that would impose liability upon a licensing organization like ASCAP in cases just like *Venegas*:

Suppose ASCAP, or BMI, or any of the other licensing organizations authorizes its licensees to perform a certain work. I doubt whether that would be an act of contributory infringement, but I think that there should be liability there. It would seem to me that the mere authorization to make the use of the copyrighted work, that particular work, ought to subject the person making the authorization to liability even though he may not be a contributory infringer.<sup>106</sup>

Finklestein’s 1963 testimony captures the dispute in the 2005 *Venegas* case. Granted, testimony from hearings held during the critical period between 1961 and 1965 probably is entitled to less weight than sentences taken from more important documents like the 1965 *Supplementary Report* of the Register of Copyrights or the 1975 *Committee Reports* on the bills that became the Copyright Act of 1976. But it does raise two questions that seem to answer themselves:

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<sup>103</sup> *E.g.*, H.R. Rep. 1476, 94<sup>th</sup> Cong. 2<sup>nd</sup> Sess. at 159-60; *see also* *United States v. Vonn*, 535 U.S. 55, 65 (2002) (“as we have said before, the canon that expressing one item of a commonly associated group or series excludes another left unmentioned is only a guide, whose fallibility can be shown by contrary indications that adopting a particular rule or statute was probably not meant to signal any exclusion of its common relatives”). In other words, if the sentence in question cannot support an inference of intent to exclude “vicarious liability,” the most common relative of “contributory” liability,” then it cannot support any less-closely related inference of intent to exclude.

<sup>104</sup> *E.g.*, H.R. Rep. 1476, 94<sup>th</sup> Cong. 2<sup>nd</sup> Sess. at 61.

<sup>105</sup> *See Venegas*, 424 F.3d at 57 (noting that the critical question presented was “whether a music publisher’s unauthorized grant of a license to a third party to perform or copy a copyrighted work is an act of infringement where there is no adequate proof that the third party ever undertook an infringing act”).

<sup>106</sup> Copyright Law Revision: Part 3, Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft, at 122-23 (1964).

- First, given that *Venegas* and its progeny overrode ordinary meaning based upon a misreading of *Subafilms* and an ambiguous sentence of legislative history, don't they lack any persuasive value now that *Lost Ark* has shown that their legislative-history analyses overlooked the only legislative history that was directly on point?
- Second, if an undefined term was incorporated into a statute after its proponents argued that it would impose liability in a classes of cases *broader* than those that would have been encompassed by then-existing contributory-liability doctrines, then how can subsequent legislative history stating the obvious—that such a term would also impose liability in the narrower class of cases encompassed by then-existing contributory-liability doctrines—qualify as the sort of “contrary legislative intent... clearly expressed” that could rebut the strong presumption favoring the dictionary-definition meaning of an undefined statutory term that had acquired no specialized meaning under prior law?<sup>107</sup>

**Legislators who intended *only* to codify contributory liability would not have used “to authorize”:** The *Venegas* interpretation of “to authorize” also impunes the competence of the Legislative and Executive Branches. *Venegas* presumed that not even the 12 years separating the 1964 revision bills that first used “to authorize” from the bills that were enacted as the Copyright Act of 1976 enabled the Copyright Office, Congresses, and Presidents to recall the familiar words that would have unambiguously expressed the intent that *Venegas* implied from an ambiguous sentence. *Venegas* adopted *dicta* claiming, “[W]e believe that ‘to authorize’ was simply a convenient peg on which Congress chose to hang the antecedent jurisprudence of third party liability.” But “to authorize” was never a “convenient” peg on which to hang *only* “the antecedent jurisprudence of third party liability.”

If Congress, in 1964 or 1976, had intended to follow “to do” with a term that would *only* codify contributory liability, then it would presumably have done again what it had just done when re-codifying the Patent Act: It would have again used a variant of “contributory.”<sup>108</sup> Obvious ways to effectuate such intent would include “to do or to contribute to the doing of” or “to do, directly, contributorily or vicariously....”

But no competent Member of Congress who only wanted to codify contributory and vicarious liability would have followed “to do” with “to authorize.” Experts proposing that term had repeatedly argued that in copyright laws, its ordinary meaning imposed liability more broadly. Nor had “to authorize” developed any specialized meaning under prior U.S. copyright laws, under multilateral treaties or in “the antecedent jurisprudence of third-party liability.” Consequently, competent legislators who *only* intended to codify contributory or secondary liability would not have used “to authorize.”

That is why the *Committee Reports* must be interpreted as unanimous decisions like *Standefer* and *Whitfield* require. If noting one effect of using “to authorize” to define exclusive rights still let the term serve other then-familiar purposes inherent in its ordinary meaning—purposes like implementing the

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<sup>107</sup> See *supra* note [XREF].

<sup>108</sup> See 35 U.S.C. § 271(c) (defining a class of “contributory infringers”).

*Universal Copyright Convention* and bringing U.S. copyrights closer to those required by the *Berne Convention*—then its use is easily explained.<sup>109</sup>

**The Supreme Court has held that the 1976 Act did not codify contributory liability:** *Venegas* asserts that the words “to authorize” *codified* pre-1976 standards for contributory liability.<sup>110</sup> But in *Sony Corp. of Am., Inc. v. Universal City Studios, Inc.*, the Supreme Court rejected claims that the Copyright Act “codified” the standards for secondary liability.<sup>111</sup> Consequently, *Sony* could radically narrow the prior scope of contributory liability, at least as to an ill-defined class of defendants.<sup>112</sup> But if “to authorize” had codified the antecedent jurisprudence of contributory liability, then *Sony* was unlawful. In *Edmonds v. Compagnie Generale Transatlantique*, the Court held that after an admiralty statute incorporated antecedent, judge-made rules on comparative fault, courts could no longer significantly alter them: “Once Congress has relied upon conditions that the courts have created, we are not as free as we would otherwise be to change them.”<sup>113</sup>

**Courts can distinguish *Venegas* in true “making-available” cases:** For the reasons just discussed, *Venegas* is hopelessly flawed. Nevertheless, it is a precedent, and until the meaning of “to authorize” is reviewed by the U.S. Supreme Court or the *en banc* First Circuit, both First-Circuit district courts and appellate panels must follow *Venegas*, when it is a binding precedent.

Nevertheless, courts can avoid being bound by *Venegas* by noting that the international obligations of the United States do not require the U.S. to provide a making-available right in cases like the one imagined by Mr. Finklestein in 1963 and presented to the First Circuit in the 2005 *Venegas* case. In *Venegas*, the defendant “authorized” its licensees to perform the plaintiffs’ copyrighted songs, but it did not give those licensees the practical ability to do this on demand.

That is potentially significant. The WIPO Internet Treaties and U.S. FTAs require the U.S. to provide a making-available right to owners of copyrighted works when “members of the public may access them from a place and at a time individually chosen by them.”<sup>114</sup> Such a right is not implicated if confusion about the law of intestate succession causes an honest licensing organization to mistakenly tell its licensees that they can legally perform particular songs: Such a mistake does not actually let the public access any particular work. Consequently, *Venegas* is arguably distinguishable when a user of a file-sharing program like KaZaA or LimeWire or a website operator actually has enabled “members of the

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<sup>109</sup> See *Berne Convention for the Protection of Literary and Artistic Works* art. 9, Sept. 9, 1886; 25 U.S.T. 1341, 828 U.N.T.S. 221; *Vienna Convention on the Law of Treaties*, art. 31(1), (4) 23 May 1969, 1155 U.N.T.S. 331 (discussing ordinary and specialized meanings of undefined terms in treaties).

<sup>110</sup> The leading antecedent precedent on indirect liability appears to be *Gershwin Pub. Corp. v. Columbia Artists Management, Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971).

<sup>111</sup> *Sony Corp. of Am., Inc. v. Universal City Studios, Inc.*, 464 U.S. 417, 434, 435 n.17 (1984) (holding that the “Copyright Act does not expressly render anyone liable for infringement committed by another,” but that contributory liability was an established common-law doctrine) (*quoted in MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913, 930 (2005) (calling indirect liability a “common law” doctrine).

<sup>112</sup> *Sony Corp. of Am., Inc. v. Universal City Studios, Inc.*, 464 U.S. 417, 442 (1984) (recognizing a capacity-for-substantial/commercially-significant-noninfringing-use defense to contributory liability).

<sup>113</sup> 443 U.S. 256, 273 (1979).

<sup>114</sup> See *supra* n. [CROSS REF]

public” to access particular works “a place and at a time individually chosen by them.” Indeed, the First Circuit itself has so suggested.<sup>115</sup>

Granted, that narrowly interprets the precedential value of *Venegas*. Consequently, making-available-right opponents may claim that “as a matter of language” a broader interpretation of *Venegas* should be favored by those “looking only at the [judicial] language” or those concerned about its “better bare-language reading.”<sup>116</sup> In other words, they may argue that the ordinary meaning of *Venegas* should not be discarded as lightly as *Venegas* discarded the ordinary meaning of “to authorize.” Judges can accord such arguments whatever persuasive value the act of self-immolation may be perceived to convey.

For all of these reasons, the *Venegas* interpretation of “to authorize” is unlawful, unreasonable, and unpersuasive. The presumption favoring ordinary meaning should thus prevail, and “to authorize” should provide a U.S. making-available right in cases involving the streaming of public performances or the public distribution of copies.

#### **B. “To Distribute” Provides a Making-Available Right Because It Retains the Specialized Meaning It Acquired Under Prior U.S. Copyright Laws.**

Even if “to authorize” in Section 106 were interpreted to have some unnaturally narrow meaning that precludes it from providing making available rights, existing U.S. copyright laws could still provide such rights if the drafters of the 1976 Act’s § 106(3) right “to distribute copies... to the public” intended for that right to be infringed when copies are made available for distribution to the public over networks like the Internet. Again, applying the Supreme-Court’s plain-meaning rule in order to answer this critical question requires analysis of the meaning of “to distribute copies... to the public” under prior law.

If an undefined statutory term acquired a specialized meaning under prior law, then courts presume that it was intended to retain that specialized meaning. For example, in *United States v. Morrisette*, the Court held that under such circumstances Congress “presumably knows and adopts the cluster of ideas that were attached to each borrowed word in the body of learning from which it was taken....”<sup>117</sup> In 1992, the Court again applied *Morrisette* and Justice Frankfurter’s restatement of it: “if a word is obviously transplanted from another legal source, whether the common law or other legislation, it brings the old soil with it.”<sup>118</sup> The Court has also repeatedly applied this principle to interpret the 1976

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<sup>115</sup> See *Latin American Music Co. v. Archdiocese of San Juan*, 499 F.3d 32, 47 (1<sup>st</sup> Cir. 2007) (dicta) (discussing *Venegas* but concluding that making songs available on a website “might be infringing acts”).

<sup>116</sup> See *Venegas*, 424 F.3d at 57-58.

<sup>117</sup> 342 U.S. 246, 250 (1952) (quoted in *Molzof v. United States*, 502 U.S. 301, 307 (1992) (calling this a “cardinal rule of statutory construction”) (unanimous decision). *Morrisette* is particularly important because it reflects the principles of statutory interpretation prevailing during the drafting and enactment of Section 106—“the most relevant time for determining a statutory term’s meaning.” *MCI Telecoms. Corp. v. AT&T*, 512 U.S. 218, 228 (1994) (citing *Perrin v. United States*, 444 U.S. 37, 42-45 (1979)).

<sup>118</sup> *Evans v. United States*, 504 U.S. 255, 260 n. 3 (1992) (quoting Frankfurter, *Some Reflections on the Reading of Statutes*, 47 Colum. L. Rev. 527, 537 (1947)); see also *Bradley v. United States*, 410 U.S. 605, 609 (1973) (“the law uses familiar legal expressions in their familiar legal sense”) (citation omitted); *Corning Glass Works v. Brennan*, 417 U.S. 188, 201-02 (1974) (“the legislative history reveals that Congress incorporated words having a specialized meaning within the field regulated”); *Standard Oil Co. v. United States*, 221 U.S. 1, 59 (1911) (“where words are employed in a statute which had at the time a well known meaning at common law or in the law of this country they are presumed to have been used in that sense unless the context compels to the contrary”); 2A NORMAL J.

Act.<sup>119</sup> And it continues to apply it today: in 1999, *Neder v. United States* held that “where Congress uses terms that have accumulated settled meaning... a court must infer... that Congress means to incorporate the established meaning of those terms.”<sup>120</sup>

This principle, combined with the principle that statutory text must be interpreted in context, can even answer a critical question about § 106(3). During the first 186 years of federal copyright law, every federal copyright act granted copyright owners either an exclusive right of “publishing” or an exclusive right “to publish.” Consequently, by 1965, terms like “publishing” and “to publish” had fairly well-defined meanings that encompassed a making-available right. So why, from at least 1965 through 1976, would the government’s copyright-law experts conclude that a revised act should grant an “exclusive right of publication” by *replacing* the antecedent exclusive right “to publish,” with an exclusive right “to distribute copies”?

Taken out of context, one cannot blame generalist judges for doubting that this would be how Congress would express its intent to re-confer (and expand) copyright’s familiar right “to publish.” But context, prior law and *Morrisette* show why the Copyright Office and Congress chose to re-confer a publication right by granting an exclusive right “to distribute copies.. to the public....” And 186 years of prior copyright law can even explain why they chose to use different, but nearly synonymous, words to re-confer the exclusive right “to publish” that had been granted by every prior U.S. copyright law.

**1. By 1976, U.S. copyright law had long equated publishing, distributing copies to the public, and making-available.**

The case for deriving a making-available right from a specialized meaning of “to distribute” turns upon whether this was a term of art under prior U.S. copyright laws. Indeed, this history shows why it is highly unlikely that any developed country would enact a copyright law that denied copyright owners a making-available right. Simply put, a making-available right is synonymous with a right “to publish” or to distribute copies of a work to members of the public, and an exclusive right “to publish” copies of copyrighted works is fundamental to the very idea of copyrights.

For example in *American Tobacco Co. v. Werckmeister*, the Court concluded that U.S. copyright laws were intended to protect “the property which the author has in the right *to publish* his production, the purpose of the statute being to protect this right...” In other words, “the purpose of the copyright law is...to secure... the right *to publish* the production...”<sup>121</sup> As one treatise put it, “Thus it has been said that a copyright involves the right of publication and reproduction.... Indeed, it may be doubted whether a

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SINGER, J.D. SHAMBLE SINGER, STATUTES AND STATUTORY CONSTRUCTION § 47:30, at 482-82 (7<sup>th</sup> ed. 2007) (concluding that a specialized meaning can attach whenever a term has been judicially interpreted).

<sup>119</sup> See *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 739 (1989) (holding that an undefined term in the Copyright Act had a specialized meaning: “where Congress uses terms that have an accumulated settled meaning under common law, a court must infer... that Congress means to incorporate the established meaning of these terms”); *Harper & Row, Pubs. v. Nation Ent.*, 471 U.S. 539, 554 (1985).

<sup>120</sup> 527 U.S. 1, 21 (1999).

<sup>121</sup> 207 U.S. 284, 291, 293 (1907) (emphasis added); *accord id.*, at 291 (defining copyrights as the “property which arises from the privilege of publishing and selling to others copies of the thing produced”); see also *Stephens v. Cady*, 55 U.S. 528, 530 (1852) (“The copy-right is.... an incorporeal right to print and publish....”).

copyright can be conceived to exist which does not involve these rights.”<sup>122</sup> In his 1961 *Report to Congress on the general revision of U.S. copyright law*, the Register of Copyrights repeatedly made the same point.<sup>123</sup>

Consequently, it is profoundly unlikely that Congress (and the Copyright Office) would have *silently* withdrawn this critical right of publication/offering/making-available. Such “silence is most eloquent, for such reticence while contemplating an important and controversial change in existing law is unlikely.... At the very least, we would expect some hint of a purpose to work such a change, but there was none.”<sup>124</sup>

From the beginning, copyright law’s concept of “publication” meant making a work available to the public. Terms like “publishing” and “publication” were not defined in early U.S. copyright acts, but their ordinary meaning equated them with making-available. Noah Webster’s 1828 *American Dictionary of the English Language* defined “publication” as the “act of offering a book or writing to the public by sale or gratuitous distribution.”<sup>125</sup> And when this principle was challenged, courts consistently held that works were published when copies were made available to the public.<sup>126</sup> One treatise said that the federal right “to publish” subsequent copies of an already published work “means the right, not only to communicate a work to the public or any part thereof, but also the right to determine when, where, and how, and on what terms and conditions, such publications shall be made.”<sup>127</sup> Another treatise explained that publication had to turn on making-available, not a completed transfer: “[I]t is sufficient if [the book] be offered to the public. The act of publication is the act of the author, and cannot be dependent upon the act of the purchaser.”<sup>128</sup>

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<sup>122</sup> ARTHUR W. WEIL, *AMERICAN COPYRIGHT LAW* 69 (1917); *see also, e.g.*, WILLIAM W. ELLSWORTH, *COPY-RIGHT MANUAL* 6 (1862) (“The property of an author, as claimed, is an exclusive right to publish....”).

<sup>123</sup> *Register’s Report on the General Revision of the U.S. Copyright Law*, at 19 (House Comm. Print 1961) (historically, copyright “meant the exclusive right of the copyright owner to make and publish copies); *id.* at 22 (concluding that the “twofold right to make and publish copies” is “the historical basis of copyright”); *see* BARBARA A. RINGER & PAUL GITLIN, *COPYRIGHTS* 21 (1965) (future Register of Copyrights Barbara Ringer describes “publishing rights” as “the very essence of the protection implied in the word ‘copyright’”).

<sup>124</sup> *Edmonds v. Compagnie Generale Transatlantique*, 443 U.S. 256, 266-67 (1979).

<sup>125</sup> 2 NOAH WEBSTER, *AMERICAN DICTIONARY OF THE ENGLISH LANGUAGE* (1828); *see also* D. FENNING, *THE ROYAL ENGLISH DICTIONARY* (5<sup>th</sup> ed. 1775) (defining “to publish” as “to put forth to sale”); 2 THOMAS SHERIDAN A *COMPLETE DICTIONARY OF THE ENGLISH LANGUAGE* (3<sup>rd</sup> ed. 1790) (defining “to publish” as “to put forth a book”); 2 JOHN ASH, *THE NEW AND COMPLETE DICTIONARY OF THE ENGLISH LANGUAGE* (2d ed. 1795) (defining “publication” as “that which is made public”); SAMUEL JOHNSON, *A DICTIONARY OF THE ENGLISH LANGUAGE* (11<sup>th</sup> ed. 1799) (defining “to publish” as “to put forth a book into the world”); 2 JOHN BOUVIER, *A LAW DICTIONARY* (1843) (defining “publication” as “the act by which a thing is made public”).

<sup>126</sup> *See, e.g., Meier Glass Co. v. Anchor Hocking Glass Corp.*, 95 F. Supp. 264, 268 (W.D. Pa. 1951); *D’Ole v. Kansas City Star*, 94 F. 840, 842 (C.C.W.D. Mo. 1899); *Chapman v. Ferry*, 18 F. 539, 541 (C.C.D. Or. 1883); *The Jewelers’ Mercantile Agency, Ltd. v. The Jewelers’ Weekly Pub. Co.*, 49 N.E. 872, 875 (Ct. App. N.Y. 1898); *see generally* EATON S. DRONE, *A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS* 291 (1879) (“The requirements of [publication] are met when the book is publicly offered for sale.”).

<sup>127</sup> ARTHUR W. WEIL, *AMERICAN COPYRIGHT LAW* 71 (Callaghan & Co. 1917).

<sup>128</sup> E.J. MACGILLIVRAY, *A TREATISE UPON THE LAW OF COPYRIGHT*, 261 (1902).

But during the late 1800s, U.S. copyright law evolved a specialized meaning for “publication.”<sup>129</sup> Indeed, it was this specialized meaning that caused European and U.S. copyright laws to diverge so a “making-available right” would become the “umbrella solution” during the Diplomatic Conference that promulgated the 1996 WIPO Internet Treaties.<sup>130</sup>

Under U.S. law, “to publish” came to mean—not just any means through which a work could be made available to the public—but by the offering of copies. At the start of the Fourth General Revision, the Copyright Office would thus summarize the state of U.S. law as follows: “[P]ublication under the [copyright] statute has generally been confined to the distribution of... copies of the work...”<sup>131</sup>

But in Europe, “publication” was usually defined more consistently with its ordinary meaning. Many European nations would thus conclude that a work could be “published” through any means by which knowledge of the work might be communicated to the public. Eaton Drone, a leading commentator on U.S. copyright law, agreed that European practices better reflected the ordinary meaning of publication.<sup>132</sup>

But Mr. Drone also realized that the U.S. system of “dual” copyright protection required a different result. Under this “dual” system, works of all types could usually enjoy perpetual, formality-free *common-law* copyright protection—until they were “published.” But once “publication” occurred, all common-law copyrights, and indeed, all copyrights, would terminate unless (1) the work was of a type that could be protected under federal law, and (2) the author of the work strictly complied with all the federal formalities—registration, deposit, notice, renewal, and (perhaps) manufacturing.

Consequently, in the United States, a broad, ordinary-meaning-based interpretation of “publication” would have exposed far more categories of works to harshness of the federal formalities. Worse yet,

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<sup>129</sup> See generally, Melville B. Nimmer, *Copyright Publications*, 56 COLUM. L. REV. 185, 185 (1956) (in U.S. copyright law, publication became “a legal word of art”).

<sup>130</sup> See MIHALY FICSOR, GUIDE TO THE COPYRIGHT AND RELATED RIGHTS TREATIES ADMINISTERED BY WIPO 208-09, CT-8.6 to 8.10 (WIPO 2003); Mihaly Ficsor, *The Spring 1997 Horace S. Manges Lecture—Copyright for the Digital Era* *The WIPO “Internet” Treaties*, 21 COLUM-VLA J.L. & ARTS. 197, 207-215.

<sup>131</sup> William S. Strauss, *Protection of Unpublished Works* at 29 (1957) reprinted in Senate Comm. on the Judiciary, 86th Cong., Study No. 29, *Copyright Law Revision* (Comm. Print 1961) (“publication under the [copyright] statute has generally been confined to the distribution of... copies of the work”); see also Hearing on S. 1006 Before the S. Comm. on the Judiciary, 89<sup>th</sup> Cong. 111 (1965) (statement of the ABA Chairman for Revision of Copyright Law) (“the judicial definition has been that a work is published when it is reproduced on visual copies for sale or for general distribution to the public”). Indeed, under U.S. law, a since-abrogated 1907 case once held that a copy must be human-readable to be a “copy” within the meaning of federal copyright laws preceding the 1976 Act. See *White-Smith Pub. Co. v. Apollo Co.*, 209 U.S. 1 (1907). Consequently, in the U.S., pre-1972 sound recordings, (including many iconic rock songs), are still protected by perpetual, state-law copyrights because no “copy” of *Hey Jude* has ever been “published,” within the meaning of pre-1972 federal copyright laws—even though most federal judges could probably sing along to many “uncopied,” (and thus “unpublished”), songs.

<sup>132</sup> EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS 115 (1879) (“to publish a thing is to make it public by any means or in any manner of which it is capable of being communicated to the public.”).

because new categories of works had been added rather slowly to federal copyright acts, broad judicial interpretations of “publish” would destroy many valuable copyrights in many types of works.<sup>133</sup>

U.S. courts thus developed a *specialized* interpretation of “publication”: a work was “published” only if *copies* of the work were distributed to the public generally, which occurred when those copies were made available to the public. For example, in *American Tobacco Co. v. Werckmeister*, the Supreme Court held that an author had not published a painting that he had displayed to the public because he had displayed it in a venue that forbade the making of copies of displayed paintings. Consequently, there had been no publication because the opportunity to obtain copies of the work had not been made available to the public.<sup>134</sup>

By the mid-20<sup>th</sup> Century, U.S. copyright law had thus defined “publication” as the distribution of copies of a work to the public.<sup>135</sup> And such distribution occurred when copies of the work were offered/made available to the public.<sup>136</sup> “To publish” had thus evolved a *specialized* meaning in U.S. copyright law.

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<sup>133</sup> For example, suppose that the Supreme Court had held that any work was “published” whenever knowledge of it was communicated to the public in any way. For many works, that would mean that they lost common-law copyright protection because they had been “published”—and at a date when even formality-ridden federal protection was unavailable. See, e.g., *Davies v. Bowes*, 209 F. 53, 55 (S.D.N.Y. 1913) (existence of copyrights depends on the statute in force at the time of publication).

<sup>134</sup> 207 U.S. 284, 291, 293 (1907); see, e.g., ARTHUR W. WEIL, *AMERICAN COPYRIGHT LAW* 152 (1917) (“the definition [of publication] contained in the present United States Act is limited to the case of works of which copies are reproduced for sale or distribution”); EATON S. DRONE, *A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS* 285 (1879).

<sup>135</sup> See generally COMPENDIUM OF COPYRIGHT OFFICE PRACTICES 3.1.1.II (Copyright Office 1967) (“a general publication may be defined as the act of making one or more copies of a work available to the general public... usually by means of... a public distribution”); BARBARA A. RINGER & PAUL GITLIN, *COPYRIGHTS* 5 (1965) (a future Register of Copyrights concludes that “free distribution of one or more copies to the public will publish a work”); Hearing on S. 1006 Before the S. Comm. on the Judiciary, 89<sup>th</sup> Cong. 111 (1965) (statement of John Shulman, ABA Chairman for Revision of Copyright Law) (“the judicial definition has been that a work is published when it is reproduced on visual copies... for general distribution to the public”); ALAN LATMAN, *HOWELL’S COPYRIGHT LAW* 63 (1962) (“the public distribution of copies is the prototype of publication”); William S. Strauss, *Protection of Unpublished Works at 29 (1957) reprinted in Senate Comm. on the Judiciary, 86th Cong., Study No. 29, Copyright Law Revision (Comm. Print 1961)* (“publication under the [copyright] statute has generally been confined to the distribution of... copies of the work”); RICHARD WINCOR, *HOW TO SECURE COPYRIGHT* 9 (1950) (“Publication consists of... distributing [copies] to the public...”); RICHARD C. DEWOLF, *AN OUTLINE OF COPYRIGHT LAW* 29 (1925) (“Publication may take place by... distribution, though none of [the copies] leaves the hand of the dealer.”); see also *Hirshon v. United Artists Corp.*, 243 F.2d 640, 644 (D.C. Cir. 1957) (“The terms ‘reproduced for sale’ and ‘published’ are apparently used interchangeably”); *D’Ole v. Kansas City Star Co.*, 94 F. 840, 842 (C.C.W.D. Mo. 1899) (“In copyright law, [publishing] is ‘the act of making public a book; that is offering or communicating it to the public by sale or distribution of copies.’”); *American Inst. of Architects v. Fenichel*, 41 F. Supp. 146, 147 (S.D.N.Y. 1941) (“Publication means to issue copies to the public”); *National Geographic Soc’y v. Classified Geographic, Inc.*, 27 F. Supp. 655, 659 (D. Mass. 1939) (holding that publishing a work means “offering it or communicating it to the public by sale or distribution of copies”); Benjamin Kaplan, *Publication in Copyright Law*, 103 U. Penn. L. Rev. 469, 478 (1955) (equating “to publish” with “to disseminate copies”); cf. *Advisers, Inc. v. Wiesen-Hart, Inc.*, 238 F.2d 706, 707 (6<sup>th</sup> Cir. 1956) (per curiam).

<sup>136</sup> See generally COMPENDIUM OF COPYRIGHT OFFICE PRACTICES 3.1.1.II (Copyright Office 1967) (“publication may be defined as the act of making one or more copies of a work available to the general public”); ALAN LATMAN, *HOWELL’S COPYRIGHT LAW* 63 (1962) (“placing on sale of an edition is sufficient, even if only a single copy is involved”); Melville B. Nimmer, *Copyright Publications*, 56 Colum. L. Rev. 185, 187 (1956) (publication occurred when copies of a work were “sold, ... given away, or otherwise made available to the general public... even if a sale

U.S. copyright regulations and statutes soon treated publishing, distributing, and making-available as synonymous.<sup>137</sup>

As a result, during the Fourth General Revision, the Copyright Office used these three concepts interchangeably.<sup>138</sup> One 1957 study explained, “[P]ublication under the [copyright] statute has generally been confined to the distribution of... copies of the work...”<sup>139</sup> In 1961, the Register of Copyrights would tell Congress, “Under our present copyright law ‘publication’ means making copies of a work available to

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or other such disposition does not in fact occur”); STANLEY ROTHENBERG, LEGAL PROTECTION OF LITERATURE, ART AND MUSIC 71 (1960) (“if the work is offered to the general public, publication occurs”); RALPH R. SHAW, LITERARY PROPERTY IN THE UNITED STATES 86 (1950) (publication “refers primarily to the act of printing or reproducing and offering for sale”); *id.* (“exposure of a single copy of a manuscript where any member of the general public might have access to it, ... even though there is no evidence that anyone has actually had access to it... has been ruled a general publication”); *id.* at 87-88 (“if a book is offered gratuitously to the general public, it will constitute publication”); LEON H. AMDUR, COPYRIGHT LAW AND PRACTICE 350 (1936) (“A work... is said to be published when one or more copies... are made available to the public.”); RICHARD C. DEWOLF, AN OUTLINE OF COPYRIGHT LAW 29 (1925) (“publication of a work... means simply the placing of copies at the disposal of the public, whether by sale or by gift”); ARTHUR W. WEIL, AMERICAN COPYRIGHT LAW 127 (1917) (“The public offer of copies of a work for sale is a publication, even though the attention of the public is not called to such offer or works”); RICHARD R. BOWKER, COPYRIGHT, ITS HISTORY AND LAW 53 (1912) (“Publication depends upon a sale or offer to the public....”); E.J. MACGILLIVRAY, A TREATISE UPON THE LAW OF COPYRIGHT, 261-62 (1902) (“leaving copies in a place to which the public have access... is publication”); EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS 291 (1879) (“to constitute a publication, it is essential that the work shall be exposed to sale, or gratuitously offered to the general public”); *see also Osgood v. A.S. Aloe Instrument Co.*, 83 F. 470, 471 (C.C. E.D. Mo. 1897) (plaintiff’s book was “offered for sale... and therefore, within the meaning of the law, ‘published’”); *Falk v. Gast Lithographic & Engraving Co.*, 54 F. 890, 893 (2d Cir. 1893) (a published edition is one “offered to the public”); *Ladd v. Oxnard*, 75 F. 703, 730 (C.C. D. Mass. 1896) (holding that a work is published when “offered gratuitously to the public”); *Meier Glass Co. v. Anchor Hocking Glass Corp.*, 95 F. Supp. 264, 268 (W.D. Pa. 1951) (an offer to sell “constituted a general publication”); *Shapiro, Bernstein & Co. v. Miracle Record Co.*, 91 F. Supp. 473, 475 (N.D. Ill. 1950) (when copies of “a musical composition are available for purchase in every city, town, and hamlet, certainly the dissemination of the composition to the public is complete”); *National Geographic Soc’y v. Classified Geographic, Inc.*, 27 F. Supp. 655, 659 (D. Mass. 1939) (publishing a work means “offering it or communicating it to the public by sale or distribution of copies”); *Macmillan Co. v. King*, 223 F. 862, 867 (D. Mass. 1914) (offering copies to a limited group of persons temporarily infringed the plaintiff’s right “to publish” his work); *Werckmeister v. Springer Lithographic Co.*, 63 F. 808, 812 (S.D.N.Y. 1894) (a published edition is one “‘offered to the public’”) (citation omitted); *Vernon Abstract Co. v. Waggoner Title Co.*, 107 S.W. 919, 922 (Civ. App. Tex. 1908) (“offering to furnish” abstract sheets to the public published them); *The Jewelers’ Merchantile Agency, Ltd., v. The Jewelers’ Weekly Pub. Co.*, 155 N.Y. 241, 254 (Ct. App. N.Y. 1898) (“if a book be put within reach of the general public... it is published”).

<sup>137</sup> *See* Copyright Act of 1909, Pub. L. 349 § 62, 35 Stat. 1075, 1087 (defining “date of publication” as “the earliest date when copies of the first authorized edition were placed on sale, sold or publicly distributed”); COMPENDIUM OF COPYRIGHT OFFICE PRACTICES 3.1.1.II (Copyright Office 1967) (“a general publication may be defined as the act of making one or more copies of a work available to the general public”); 37 C.F.R. § 201.6(f) (1939); 37 C.F.R. § 202.2(a) (1959); *see also Patterson v. Century Prods., Inc.*, 93 F.2d 489, 492 (2d Cir. 1937) (quoting Copyright Office rules that equate publishing with the distribution of copies).

<sup>138</sup> *See, e.g., McFarland v. Scott*, 512 U.S. 849, 858 (1994) (holding that different terms have the same meaning when they “are used interchangeably in legal parlance”).

<sup>139</sup> William S. Strauss, Protection of Unpublished Works at 29 (1957) reprinted in Senate Comm. on the Judiciary, 86th Cong., Study No. 29, Copyright Law Revision (Comm. Print 1961).

the public.”<sup>140</sup> Consequently, as of 1976, 186 years of U.S. copyright laws and judicial decisions had taught both the Copyright Office and Congress that a right “to publish” was a right “to distribute copies of a work to the public,” which occurred when copies were made available to the public.

This specialized meaning—and cases like *Morrisette*—explain why Congress and the Copyright Office would conclude that a right “to distribute copies” would encompass an publication/making-available right. But a question remains: why, after 186 years, would Congress switch synonyms and define the relevant exclusive right as a right “to distribute copies” rather than a right “to publish”? Prior law and the history of the Fourth General Revision explain why commentators, courts, the Copyright Office, and Congress all concluded that a revised copyright act should provide an exclusive right “to publish”—but *without* using an analog of the word “publication.”

## **2. By granting an exclusive right “to distribute...copies... to the public,” the 1976 Act could protect aspects of the publication right once protected by state-law copyrights.**

A critical question has long troubled commentators on the U.S. implementation of its making-available-right obligations: if the 1976 Act’s § 106(3) distribution right was intended to preserve the making-available-right-granting rights of “publishing” or “to publish” granted by every federal copyright act enacted since 1790, then why didn’t § 106(3) of the 1976 Act just re-confer the exclusive right “to publish” granted by the Copyright Act of 1909?

Fortunately, the best answer to this critical question has been overlooked or understated by modern commentators. The 1976 Act created, for the first time in U.S. legal history, a system of purely *federal* copyright protection that replaced—and, in most cases, preempted—preceding regimes of dual state/federal copyright protection.<sup>141</sup> This fundamental change in the scope of federal copyright protection ensured that the drafters of the 1976 Act could not create an effective, unitary federal system of copyright protection by re-granting the 1909 Act’s exclusive right “to publish.”

The preceding section of this article shows that pre-1976 state and federal copyright laws had *cumulatively* protected an exclusive right to publish by distributing copies of a work to members of the public, a right implicated or infringed when copies of a work were made available to members of the public. But critical elements of this exclusive right “to publish” were protected only by state copyright laws—not by the exclusive *federal* right “to publish” conferred by the Copyright Act of 1909. For example, the exclusive right “to publish” provided by the 1909 Act protected neither the right to make the first “general” publication of a work nor the right to make “limited” publications of it.

The narrow scope of the preceding federal right “to publish” thus created critical problems for the drafters of the 1976 Act. The text of the 1976 Act—when read in context with prior federal and state copyright laws—shows that its drafters resolved those problems in the best way available to them. Instead of re-granting the partial, federal exclusive right “to publish” conveyed by the 1909 Act and its predecessors, they adopted the term of art that had long defined the combined scope of prior State and federal publication rights and granted an exclusive federal right “to distribute... copies... to the public....”

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<sup>140</sup> *Register’s Report on the General Revision of the U.S. Copyright Law*, at 39 (House Comm. Print 1961); see also *Supplementary Register’s Report on the General Revision of the U.S. Copyright Law*, at 79 (House. Comm. Print 1965) (“a work has been published if ‘copies’ have been made unconditionally available to the public”).

<sup>141</sup> See 17 U.S.C. §

That strategy was effective. In its 1985 decision, *Harper & Row, Pubs. v. Nation Ent.*, the Supreme Court found that past legislation, judicial practice and legislative history proved that publication was “an important subsidiary right” now subsumed within the exclusive right of distribution.<sup>142</sup> The Court also held that the distribution right now encompassed the right of first publication previously protected only by state-law copyrights:

[The Copyright Act of 1976] also recognized for the first time a distinct statutory right of first publication, which had previously been an element of the common-law protections afforded unpublished works. The Report of the House committee on the Judiciary confirms that “Clause (3) of section 106, establishes the exclusive right of publications.... Under this provision the copyright owner would have had the right to control the first public distribution of an authorized copy... of his work.”<sup>143</sup>

In summary, the drafters of the 1976 Act could not have created a comprehensive, unitary system of purely federal copyright protection by re-granting the 1909 Act’s exclusive right “to publish.” Instead, they had to re-state the limited pre-1978 federal exclusive right “to publish” in a way that would encompass the critical aspects of the prior U.S. publication rights that had been previously protected by state-law copyrights. That is precisely what § 106(3) of the 1976 Act did.

Moreover, while this was the critical advantage of replacing the 1909 Act’s exclusive right “to publish” with an exclusive right “to distribute copies... to the public,” there was another advantage: doing so also avoided perpetuating the incoherence that had long affected prior federal judicial interpretations of the meanings of “to publish” and “publication.”

### **3. An exclusive right “to distribute...copies... to the public” also avoided the incoherence associated with prior federal interpretations of “publication” and “to publish.”**

Under the pre-1978 federal copyright law of the United States, “publication” and its analogs were “perhaps the most important single concept under the present law”; they played the “central role” and

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<sup>142</sup> 471 U.S. 539, 549 (1985); see also BLACK’S LAW DICTIONARY 1469 (8<sup>th</sup> ed. 2004) (defining “subsidiary” as “subordinate”).

<sup>143</sup> *Harper & Row*, 471 U.S. at 552. At least two courts have wrongly claimed that *Harper & Row* means only that the distribution right encompasses a right of *first* publication, not a *general* publication right. See *Atlantic Recording Corp. v. Howell*, 554 F. Supp. 2d 976, 984 (D. Ariz. 2008); *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153, 168 (D. Mass. 2008). That is absurd. *Harper & Row* relied upon and quoted legislative history stating that the distribution right protects a right of “first publication” because it “establishes the exclusive right of publication.” 471 U.S. 539, 552 (1985). Moreover, under *Morrisette*, a *general* right of publication is indicated. As *Harper & Row* notes, historically, the concept of “distributing copies” was associated with a federal right “to publish” that *did not* protect a work’s first publication, only a right to publish additional copies of a previously published work. See 471 U.S. at 552; see, e.g., ARTHUR W. WEIL, AMERICAN COPYRIGHT LAW 71 (1917) (“Hence the right [‘to publish’] so given by the [federal copyright] statute instead of being the right first to publish is, in reality, the right to continue, or not, to publish after initial publication....”). Neither prior law nor logic can insert a right of *first* publication into § 106(3) unless it is encompassed within the *general* “exclusive right of publications” cited by *Harper & Row*, by the drafters of the 1976 Act, and in § 407(a) of the 1976 Act. As Professor Menell notes, Congress even removed a reference to the “right of first publication” from drafts of § 203(a)(3), which now refers to the “right of publication.” Menell, *supra* note [CROSS] at 42.

could have an “all-embracing importance.”<sup>144</sup> But as a result, federal judicial decisions interpreting the meanings of these terms had become incoherent.

Before 1978, “publication” and its analogs served too many functions in federal copyright law: 1) it was an exclusive right, 2) it terminated common-law copyrights, 3) it established eligibility for federal copyrights, 4) it defined the term of copyright protection, and 5) it triggered the federal deposit, registration and notice requirements that could void all copyrights.<sup>145</sup> As a result, while courts had agreed on a *definition* of “publication,” they applied it *inconsistently*—the same definition applied to the same facts could produce different results, depending on whether a finding of publication would tend to secure or destroy copyright protection.<sup>146</sup>

But courts and commentators had also identified a way to end this incoherence: a revised act should use synonyms for publication so their interpretations or definitions could be adapted to the contexts in which they were used. The term “publication” would then serve fewer and more congruent functions.<sup>147</sup> The Register’s 1961 *Report* thus proposed “to retain the exclusive rights... to make and publish copies” but to create a new concept (“public dissemination”) to trigger deposit, registration and notice requirements, and to preserve state-law protection for “undisseminated” works.<sup>148</sup> But this proposal was widely opposed: its new concept of “public dissemination” created many new uncertainties while perpetuating all the complexities of a dual state/federal system of copyrights.

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<sup>144</sup> S. Rep. No. 94-473, 94<sup>th</sup> Cong. 1<sup>st</sup> Sess. at 113, 121; *see, e.g.*, ALAN LATMAN, *HOWELL’S COPYRIGHT LAW* 61 (1962) (“publication has been properly characterized as being at the heart of our present copyright system”).

<sup>145</sup> *See, e.g.*, Benjamin Kaplan, *Publication in Copyright Law*, 103 U. Penn. L. Rev. 469, 489 (1955) (describing functions served by publication and its analogs under the Copyright Act of 1909).

<sup>146</sup> Courts rationalized this practice by distinguish between “investive” and “divestive” publications. *E.g.*, *American Visuals Corp. v. Holland*, 239 F.2d 740, 743 (2d Cir. 1956); *see also Second Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, at 312 (House Comm. Print 1975) (“‘Publication,’ ... represents [existing law’s] most serious defect.... [T]he courts have given ‘publication’ a number of diverse interpretations, some of them radically different.... [T]he results in individual cases have become unpredictable and often unfair.”).

<sup>147</sup> *See American Visuals Corp. v. Holland*, 239 F.2d 740, 742 n.2 (2d Cir. 1956) (“Such confusion could perhaps be avoided by using different words in the different contexts.”); Benjamin Kaplan, *Publication in Copyright Law*, 103 U. Penn. L. Rev. 469, 489-90 (1955). Note that *American Visuals* presumes that the use of different words need not change the law’s meaning. *See ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447, 1452 (7<sup>th</sup> Cir. 1996) (Easterbrook, J.) (“To propose a change a law’s *text* is not necessarily to propose a change in the law’s *effect*. New words may be designed to fortify the current rule with a more precise text that eliminates uncertainty.”) (emphasis in original).

<sup>148</sup> *Register’s Report on the General Revision of the U.S. Copyright Law*, at v (House Comm. Print 1961). PATRY ON COPYRIGHTS claims that this *Report* proposed to narrow the 1909 Act rights to print, reprint, publish, copy and vend to a single reproduction right. *See 4 id.* at § 13.8. That is wrong: this *Report* actually proposed that a revised act “should continue to accord to copyright others the exclusive rights to exploit their works by (1) making and publishing copies....” *Register’s Report* at 24 (emphasis added); *see also id.* at 21-22 (describing the “twofold right to make and to publish copies” as “the historic basis of copyright”). Patry was thus mystified as to why the Register’s 1965 *Supplementary Report* recanted the single reproduction right allegedly proposed in 1961 by adding a distribution right. Like the Register himself, readers of the 1961 *Report* will discern neither a mystery nor a recantation. *See Supplementary Register’s Report on the General Revision of the U.S. Copyright Law*, at 15 (House Comm. Print 1965) (“In very general terms the 1961 *Report* recommended that, ‘..., the statute should continue to accord to copyright owners the exclusive rights to exploit their works by (1) making and publishing copies.... Section 106(a) of the bill follows all of these recommendations....”). PATRY ON COPYRIGHTS too often decays into mere fabulism.

Consequently, the Register's 1965 *Supplementary Report* reversed his 1961 proposal: it used "publication" as its trigger for deposit, registration, notice and term and it proposed a unitary system of federal copyright protection for both published and unpublished works. But these changes also ensured that if "publication" continued to define an exclusive right, then its definition would again become either incoherent or ill-adapted in one of these contexts. The 1965 *Supplementary Report* thus proposed a new exclusive right "to distribute copies... to the public."<sup>149</sup>

In other words, both the 1961 and the 1965 *Reports* presumed that "publish" could no longer be used as both an exclusive right and a trigger for formalities. The preceding century-and-a-half of U.S. copyright law had proven this. To define "publication" for purposes of term and notice, Congress would have had to, (and did) perpetuate the judge-made distinction between "general" and "limited" publications.<sup>150</sup> Under prior law, "limited publication" let an author distribute copies of her work to some members of the public *without* causing a "publication." Indeed, when "publication" triggers notice obligations, a fairly broad limited-publication doctrine is *essential*. Without it, having colleagues review a manuscript or submitting it to a few potential publishers could cause a "publication" that forfeited all copyrights.<sup>151</sup>

But when federal and state courts interpreted the scope of the antecedent exclusive right "to publish"—be it the state-law right of first publication or the federal right of subsequent publication—a broad limited-publication exception was inappropriate: I should be able to submit *my own* manuscript to the scrutiny of selected peers or publishers without "publishing" it, but I should not be able to do that with *your* manuscript without *your* permission. Courts thus found that when they were unwanted, even very limited publications infringed the publication right.<sup>152</sup> As a result, if publication was the trigger for formalities and notice *and* an exclusive right, its definition would have had to have remained incoherent or become maladapted to one context or the other. Worse yet, this problem of incoherence that had emerged under the 1909 Act would have been exacerbated once a unitary system of federal copyright protection encompassed the broader right of "first publication" once protected by state law.

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<sup>149</sup> *Supplementary Register's Report on the General Revision of the U.S. Copyright Law*, at 15 (House. Comm. Print 1965).

<sup>150</sup> Courts hold that in the second sentence of the § 101 definition of "publication," the phrase "for purposes of further distribution..." perpetuates the judge-made distinction between general and limited publications. *See, e.g., John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 36 (1<sup>st</sup> Cir. 2003); *Jalbert v. Grautski*, 554 F. Supp. 2d 57, 69 n.15 (D. Mass. 2008); *Logicom Inclusive, Inc. v. W. P. Stewart & Co.*, 72 U.S.P.Q.2d 1632 (S.D.N.Y. 2004). As a result, courts still look to pre-1976 cases when applying this distinction.

<sup>151</sup> *See, e.g., Berry v. Hoffman*, 189 A. 516, 519 (Pa. Super. 1937).

<sup>152</sup> *See, e.g.,* HORACE G. BALL, *THE LAW OF COPYRIGHT AND LITERARY PROPERTY* 349-350 (1944) (the exclusive right "to publish" could be infringed even by limited publications) (*citing Ladd v. Oxnard*, 75 F. 703 (C.C. D.Mass. 1896); *Macmillan Co. v. King*, 223 F. 862 (D. Mass. 1914)); *see also Stanley v. Columbia Broadcasting Sys., Inc.*, 221 P.2d 73, 78 (Cal. 1950) ("common law rights in unpublished works are of a wider and more exclusive nature") (emphasis in original; citation omitted); *O'Neill v. General Film Co.*, 157 N.Y.S. 1028 (N.Y. App. Div. 1916) (holding that defendant's offer to distribute a film adapted from plaintiffs' unpublished play infringed his right to publish); *Baker v. Libbie*, 97 N.E. 109, 109 (Mass. 1912) (holding that defendant's offer to sell a copy of plaintiffs' unpublished work infringed her common-law right to publish) BARBARA A. RINGER & PAUL GITLIN, *COPYRIGHTS 21* (1965) (future Register of Copyrights Barbara Ringer argues that even a publication "limited" for purposes of notice and term could entitle an author to sue for infringement); ARTHUR W. WEIL, *AMERICAN COPYRIGHT LAW* 71 (1917) (the right "to publish means... the right to determine when, where, and how, and on what terms and conditions, such publication shall be made"); *cf. Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 299-300 (3d Cir. 1991) (finding that an *unwanted* gratuitous distribution to one party for a limited purpose infringed the distribution right).

The Register's 1965 *Report* thus reversed the proposal in his 1961 *Report*. In 1961, "to publish" had been retained as an exclusive right, but replaced as the trigger for notice, term, and divestiture of state-law copyrights. In the 1965 *Supplementary Report*, "publication" again became the trigger for the formalities, dual copyright protection was eliminated, and the exclusive right became one "to distribute copies" to the public.<sup>153</sup>

As Professor Menell's *Lost Ark* paper correctly notes, testimony from the Copyright Office and Mr. Sargoy during 1963 hearings confirms that "to distribute copies" was still accorded the specialized meaning that had made it a synonym for publication, and thus a means to encompass the broader meaning that publication had acquired when used to define an exclusive right. But here, the "lost ark" is the specialized meaning that "to distribute copies" had acquired under prior law. Without that, and without the preceding proposals to substitute synonyms for "publication" so that basically synonymous terms could be adapted to the broader or narrower meanings that their uses required, the 1963 testimony could seem merely confusing.

Under cases like *Morrisette*, use of "to distribute copies... to the public"—the term used to define publication—could avoid incoherence while signaling intent to encompass a publication/making-available right. Consequently, the Register described the distribution right interchangeably as a right of "publication," a "publishing" right, and a "public distribution right," and concluded that this language still gave authors all rights granted previously, including "the exclusive rights to exploit their works by ... making and publishing copies."<sup>154</sup> Congress agreed: a 1967 Committee Report on a materially identical bill stated, "The five fundamental rights that the bill gives to copyright owners—the exclusive rights of reproduction, adaptation, *publication*, performance, and display—are stated generally in section 106."<sup>155</sup>

By 1975, "publication" thus served fewer, less significant, and more congruous purposes: the analogous exclusive right was one "to distribute copies"; dual state/federal copyrights were eliminated; notice was required only when copies had been "publicly distributed," and "publication" defined the term of some copyrights. Nevertheless, the Committee Reports on the new Act still stressed that the right "to distribute" encompassed a right to publish: they described the distribution right as a right of "publication," and a right of "publishing." The Reports stated: "Clause (3) of section 106 establishes the exclusive right of publications" that gives copyright owners the right "to control... public distribution" of copies of their works—but such control would be exist only if the distribution right could be infringed before distributions were completed.<sup>156</sup>

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<sup>153</sup> *Supplementary Register's Report on the General Revision of the U.S. Copyright Law*, at 15 (House. Comm. Print 1965).

<sup>154</sup> *Id.* at 15, 16, 19; see also *Second Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, at 89 (House Comm. Print 1975) ("distribution occurs when a library makes copies of such [copyrighted] materials available to other libraries or groups of users"); *Diversey v. Schmidly*, 738 F.3d 1196, (10<sup>th</sup> Cir. 2013); *Hotaling v. Church of Jesus Christ of Latter-Day Saints*, 118 F.3d 199, 203 (4<sup>th</sup> Cir. 1997) (same).

<sup>155</sup> H.R. Rep. No. 90-83, at 24 (1967); see also *id.* at 23 (describing the distribution right as a "publication" right); *id.* at 25 ("Clause (3) of section 106 establishes the exclusive right of publication"); *accord*, S. Rep. No. 93-983 at 110-112 (1974) (same).

<sup>156</sup> See S. Rep. No. 94-473, 94<sup>th</sup> Cong. 1<sup>st</sup> Sess. at 57-58 (referring to "exclusive rights of...publication" to "rights of ... publication," to "rights of ... publishing" and "the exclusive right of publication"); H.R. Rep. No. 1476, 94<sup>th</sup> Cong. 2<sup>nd</sup> Sess. at 61-62 (same).

**4. The text, subsequent history and legislative history of the 1976 Act confirm that the distribution right encompasses a publication/making-available right.**

In rare cases, statutory text, subsequently enacted legislation, and extrinsic evidence like legislative history could overcome the plain-meaning rule's presumption that an undefined term like "to distribute" was intended to retain the specialized meaning under prior law that equated it with a *comprehensive* publication or "making-available" right. But in the case of the 1976 Act, these sources strongly tend to confirm that the distribution right was intended to retain this specialized meaning. The following sources of supportive intrinsic and extrinsic evidence of legislative intent are particularly important.

**The *Phonograms Convention* and the *Sound Recording Amendments Act of 1971*:** These may provide perhaps the best intrinsic evidence of the intended meaning of the distribution right because they show that the drafters of the 1976 Act concluded that the text of the § 106(3) distribution right—without the addition of "to do and to authorize"—implemented an express legal duty to provide a right against the unauthorized "offering" of copies to the general public

Before 1976, the United States had led efforts to negotiate, and had then ratified and implemented, the *Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms*. The *Phonograms Convention* required the U.S. to protect producers of sound recordings from "any act by which duplicates of a phonogram are *offered*... to the general public..."<sup>157</sup>

In 1971, the State Department urged Congress to enact sound-recording legislation before the Fourth General Revision concluded so the United States could accede to and ratify the new *Phonograms Convention*.<sup>158</sup> Congress thus enacted the Sound Recordings Amendment Act of 1971 (the "SRAA"). The SRAA implemented the *Phonograms Convention* by granting an exclusive right "to reproduce and distribute to the public by sale or other transfer of ownership, or by rental, lease, or lending, reproductions of the copyrighted work if it be a sound recording..."<sup>159</sup> The SRAA thus proves that Congress concluded that a distribution right *unmodified by the term "to authorize"* encompasses offers to distribute copies. Congress thus interpreted the §106(3) distribution right to encompass offers to distribute copies, and therefore, a making-available right.

**Sections 407 and 203:** Section 407 of the 1976 Act impose the deposit obligation upon "the owner of copyright or of *the exclusive right of publication* in a work published in the United States..." and Section 203 prescribes rules for calculating the period for terminating a transfer of copyrights that depend upon whether a transfer "covers the right of publication."<sup>160</sup> Consequently, *the text of the Act itself* confirms that Section 106 confers an "exclusive right of publication," i.e., a making-available right.

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<sup>157</sup> Art 1(d), 2, Oct. 29, 1971, 25 U.S.T. 309, 866 U.N.T.S. 67 (emphasis added); see also *Second Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, at 218-19 (House Comm. Print 1975) (discussing the *Phonograms Convention* and the enactment of the SRAA).

<sup>158</sup> See H.R. Rep. No. 487, 92<sup>nd</sup> Cong. 11 (1971).

<sup>159</sup> Sound Recording Amendment of 1971, Pub. L. 92-40 § 1(f), 85 Stat. 391. The SRAA's exclusive-right language was adapted from S. 644, the then-pending version of the general revision bill. See H.R. Rep. 487, 92<sup>nd</sup> Cong. at 10 (statement of the Librarian of Congress). But S. 644's "to do and to authorize" language was *not* incorporated into the SRAA.

<sup>160</sup> 17 U.S.C. §§ 407, 203(a)(3) (emphasis added).

This intrinsic evidence of intent in the text of the 1976 Act echoes its legislative history, which also repeatedly equated the distribution right with a publication right, and thus, a making-available-right.<sup>161</sup>

**Section 506(a) & 506(a)(1)(C):** These sections state, “Any person who willfully infringes a copyright shall be [criminally] punished... if the infringement was committed... by the distribution of a work... by making it available on a computer network accessible to members of the public....” Congress could rationally enact § 506(a)(1)(C) *only if* the Copyright Act granted a making-available right.<sup>162</sup> Otherwise, it would be meaningless.<sup>163</sup>

**The Section 101 definition of “publication”:** During the making-available-right debate, no piece of intrinsic evidence has caused more confusion than the 1976 Act’s three-sentence definition of “publication.” Resolving this confusion is important. Only the 1976 Act’s definition of “publication” can be mistaken for textual or intrinsic evidence that the distribution right was intended to encompass only completed distributions—not offers to distribute.

Section 101’s enacted definition of “publication” is a three-sentence summary of the judge-made definition of “general publication” that had developed over the preceding 186 years of U.S. copyright law.<sup>164</sup> Its first sentence closely tracks the language of the distribution right; its second sentence

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<sup>161</sup> See, *supra*, nn.[XREF 158-59].

<sup>162</sup> Section 506(a)(1)(C) was enacted in the Family Entertainment and Copyright Act of 2005, 109 Pub. L. 9, 119 Stat. 218 (2005). But § 506(a)(1)(C) is not “subsequent legislative history.” Rather, it is subsequent *legislation* that acts as a “legislative interpretation” of Section 106(3). See, e.g., *Great Northern Ry Co. v. United States*, 315 U.S. 262, 277 (1942) (relying upon a statute enacted in 1906 to interpret a statute enacted in 1875 because “[i]t is settled that ‘subsequent legislation may be considered to assist in the interpretation of prior legislation upon the same subject’) (quotation and citations omitted); see also Carson, *supra* note [CROSS REF], at 161 (criticizing *In re Napster, Inc.*, 377 F. Supp. 2d at 804-05 for equating subsequently enacted legislation with “subsequent legislative history” that is “of little, if any, relevance”).

<sup>163</sup> Copyright Office General Counsel David Carson has thus argued that § 506(a)(1)(C) is “[p]erhaps the most compelling evidence that we have a making available right.” Carson, *supra* note [CROSS REF], at 160. Nevertheless, two district courts have wrongly cited § 506(a)(1)(C) to show that the Copyright Act does *not* grant a making-available right. See *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210 (D Minn. 2008); *In re Napster, Inc. Copyright Litig.*, 377 F. Supp. 2d 796, 805 (N.D. Cal. 2005). Both cases wrongly imagined § 506(a)(1)(C) to create a form of *criminal* copyright infringement that can be incurred without a civil infringement of the exclusive rights granted in Section 106. For example, *In re Napster*, 377 F. Supp. 2d at 804-805, claimed that nothing in § 506(a)(1)(C) suggests “that Congress even considered the scope of civil liability for copyright infringement when enacting the statute.” That is just wrong: Amendments to § 506(a) *must* “consider the scope of civil liability for copyright infringement” because infringement is an express prerequisite to *any* violation of § 506(a).

<sup>164</sup> Courts and commentators conclude, “The statutory definition of publication... ‘in general constitutes a codification of the definition evolved by case law’ before the 1976 Act.” *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 36 (1<sup>st</sup> Cir. 2003) (quoting 1 M.B. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT § 4.04, at 4-20 (2001)); *Jalbert v. Grautski*, 554 F. Supp. 2d 57, 69 n.15 (D. Mass. 2008); *Siegel v. Time Warner, Inc.*, 496 F. Supp. 2d 1111, 1150 (C.D. Cal. 2007); *Logicom Inclusive, Inc. v. W. P. Stewart & Co.*, 72 U.S.P.Q.2d 1632 (S.D.N.Y. 2004). Its first sentence defines publication as the distribution of copies to the public. The “offering” language in its second sentence equates distribution with making-available, and “for purpose of further distribute” perpetuates the judicial distinction between “general” and “limited” publications. For example, one district court held that a making-available right exists only when copies are made available “for purposes of further distribution.” See *Ent. Group, Inc. v. Barker*, 551 F. Supp. 2d 234, 243-44 (S.D.N.Y. 2008). But a publication was a “general publication,” (i.e. one “for purposes of further distribution”), if the distributor imposed no practical restraints on further dissemination. See, e.g., *American Visuals Corp. v. Holland*, 239 F.2d 740, 742 n.2 (2d Cir.

contains the phrase “offering to distribute copies... for purposes of further distribution...”; and its third sentence confirms that “publication” still occurs only when *copies* are distributed publicly:

“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.<sup>165</sup>

Confusion has arisen when courts that have not studied prior law note that § 106(3) and the § 101 definition of “publication” are similar, but not identical. Most making-available-right cases have focused on their similarities and concluded that the distribution right and the definition of “publication” are basically similar in scope.<sup>166</sup> Some cases have fixated on their differences, mistaken minor aids to statutory interpretation for rigid rules, and treated those differences as textual proof that Congress really did intend to retract the essential right of publication and repudiate the just-ratified *Geneva Phonograms Convention*.<sup>167</sup>

The latter cases are wrongly decided, but understandable. They arose because generalist judges who quite reasonably saw mere words rather than terms of art noted that the text of § 106(3) differs from the text of § 101 because the former contains neither the word “publication” nor the phrase “offering... for purposes of further distribution....” Such observations have led some courts to make two related errors.

In a few cases, courts have wrongly concluded that if Congress had intended for the 1976 Act’s distribution right to be similar in scope to its publication definition, then Congress would have used the term “publication” not only as a trigger for then-divestive formalities like registration and notice, but also to define the § 106(3) exclusive right. That claim sounds reasonable in the abstract—until you recall that 186 years of such practice had just convinced the drafters of the 1976 Act to abandon it.

For example, in *London-Sire Records, Inc. v. Brennan*, the Court claimed that Congress’ decision not to use an analog of the term “publication” in Section 106(3) “must be given consequence.”<sup>168</sup>

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1956) (finding a general publication because “plaintiff placed no limitation on who could inspect, retain or receive, through any of the original distributees, a copy of his work”); *White v. Kimmell*, 193 F.2d 744, 747 (9<sup>th</sup> Cir. 1952) (finding a general publication because recipients of copies of plaintiffs’ work could make additional copies for “others”); *Larowe-Loisette v. O’Laughlin*, 88 F. 896, 898 (C.C.S.D.N.Y. 1898) (finding a general publication when copies were sold only to persons who agreed not to disclose “any part” of the ideas expressed to third parties). Consequently, any form of public Internet distribution would be “for purposes of further distribution,” within the meaning of the Act.

<sup>165</sup> 17 U.S.C. § 101.

<sup>166</sup> *Agee v. Paramount Comms., Inc.*, 59 F.3d 317, 325 (2d Cir. 1995); *Ford Motor Co. v. Summit Motor Prods., Inc.* 930 F.2d 277, 299 (3<sup>rd</sup> Cir. 1991); *Elektra Ent. Group, Inc. v. Barker*, 551 F. Supp. 2d 234, 243 (S.D.N.Y. 2008); *Warner Bros. Records, Inc. v. Payne*, No. W-06-CA-051, 2006 WL 2844415, at \*3 (W.D. Tex. July 17, 2006); *Interscope Records v. Duty*, No. 05-CV-3744-PHX-FJM, 2006 U.S. Dist. LEXIS 20214, at \*7 (April 14, 2006); see also HARRY G. HENN, COPYRIGHT LAW 165 (2d ed. 1988).

<sup>167</sup> *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210 (D. Minn. 2008); *Atlantic Recording Co. v. Howell*, 554 F. Supp. 2d 976 (D. Ariz. 2008); *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153 (D. Mass. 2008).

<sup>168</sup> 542 F. Supp. 2d 153, 169 (D. Mass. 2008).

Unfortunately, that claim conjoins errors of law and logic: Congress used a then-familiar synonym for “publication” in § 106(3), and that decision should be given the “consequence” that the use of synonyms would indicate: The 1976 Act’s concepts of publication and distribution are generally synonymous, but the distribution right can encompass limited publications that would not qualify as “publications” under § 101.<sup>169</sup>

For example, *Brennan* correctly noted that “[i]t is *generally presumed* that Congress acts intentionally and purposefully’ when it ‘includes particular language in one section of a statute but omits it in another.’”<sup>170</sup> But that weak presumption can become misleading in a particular context: sometimes different terms “are used interchangeably in legal parlance.”<sup>171</sup> Prior copyright law ensured that the terms, “to publish copies,” “to distribute copies to the public,” and “to make copies available to the public” were essentially synonymous. “Congress, needless to say, is permitted to use synonyms in a statute.”<sup>172</sup> It makes no sense to presume that the use of one of three generally synonymous terms was intended to change the long-established meaning of the other two.

More fundamentally, *Brennan*’s argument is a *non sequitur*. The context provided by prior U.S. copyright laws and the history of the 1976 Act shows that Congress did act purposefully when it used a synonym for publication to restate and expand the 186-year old federal right of subsequent publication. This context even resolves the question of whether the terms used were intended to be mostly or entirely synonymous.

Under the 1909 Act, the meaning of publication had become incoherent because its meaning had to vary to produce sensible results in diverse contexts. Commentators, courts, the Copyright Office and Congress thus sought to end this incoherence by using synonyms in different contexts.<sup>173</sup> Distribution of copies to the public and publication are generally synonymous concepts.<sup>174</sup> Nevertheless, synonyms were used in § 101 and § 106(3) to give courts the flexibility to adapt these basically synonymous terms to the needs of the differing contexts in which each was used. Consequently, there may be cases in which unwanted “limited” publications that would not qualify as “publications” within the meaning of § 101 would still infringe the § 106(3) distribution right, particularly if a work was previously unpublished.

Some other courts and commentators have claimed that the structure of the 1976 Act’s definition of “publication” and its distribution right show that the distribution right does not encompass a publication right. They argue that if the first sentence of the “publication” definition that tracks the language of § 106(3) perpetuated the judge-made association between publishing, distributing copies, offering copies

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<sup>169</sup> The right to make such “limited” distributions of copies of a still-not-generally published work to *some* members of the public for limited purposes remains essential. Indeed, Congress eventually enacted a special “preregistration” process to provide enhanced protection to not-yet-generally published works being prepared

<sup>170</sup> *E.g.*, *City of Chicago v. Environmental Defense Fund*, 511 U.S. 328, 337 (1994) (emphasis added, citation omitted).

<sup>171</sup> *See, e.g.*, *McFarland v. Scott*, 512 U.S. 849, 858 (1994) (holding that different terms have the same meaning when they “are used interchangeably in legal parlance”).

<sup>172</sup> *Tyler v. Cain*, 533 U.S. 656, 664 (2001); *see also Wachovia Bank v. Schmidt*, 546 U.S. 303, 314 (2006) (treating “located” and “established” as synonymous because they meant the same thing when a statute was enacted).

<sup>173</sup> *See, e.g.*, *American Visuals Corp. v. Holland*, 239 F.2d 740, 742 n.2 (2d Cir. 1956) (“confusion [about ‘publication’] could perhaps be avoided by using different words in the different contexts”)

<sup>174</sup> *See, e.g.*, *Ford Motor Co. v. Summit Motor Prods., Inc.* 930 F.2d 277, 299 (3<sup>rd</sup> Cir. 1991).

and making copies available to the public, then the definition's second sentence (about offers to distribute "for purposes of further dissemination") would become impermissible "surplusage" because it would merely state explicitly principles already implicit in the first sentence.<sup>175</sup> Their arguments fails for three reasons.

*First*, while offers to distribute were encompassed by the first sentence of the § 101 definition of "publication," the second sentence's "for-purposes-of-further-distribution...." limitation ensures that the second sentence is not "surplusage": it affirms congressional intent to preserve the concept of "limited publications"—the class of offers to distribute and actual distributions that were never considered "publications" for purposes of notice, registration, deposit and term.<sup>176</sup> This is what courts have held that the second sentence does.<sup>177</sup> This also explains why the second sentence would have been added to the definition of "publication," but not to § 106(3): this ensured that publications that were "limited," (and thus not "publications" for purposes of notice, term, and registration) could still infringe the distribution right.

*Second*, this unnecessary-at-best effort to "avoid surplusage" also neglected the Supreme Court's constant reminders that statutory terms must always be interpreted "in context and with a view to their place in the overall statutory scheme."<sup>178</sup> Avoiding surplusage is not a fetish; some statutes do contain surplusage—including the § 101 definition of "publication." Its third sentence restates principles obviously implicit in its first sentence: both the words in the first sentence and the history of U.S. copyright law indicate that public performances and displays are not "publications" within the meaning of U.S. copyright law.<sup>179</sup>

Worse yet, straining to reduce alleged surplusage in the second sentence of the § 101 definition of "publication" merely creates real surplusage in several operative provisions of the 1976 Act.<sup>180</sup> For example, under the 1976 Act, interpreting the § 106(3) distribution right not to provide a publication right in order to *reduce* alleged "surplusage" in the § 101 definition of publication renders meaningless both the provision of § 407 that imposes deposit obligation upon an owner of the "exclusive right of

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<sup>175</sup> See *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210, 1220 (D. Minn. 2008); *Atlantic Recording Corp. v. Howell*, 554 F. Supp. 2d 976, 984-85 (D. Ariz. 2008); see also 4 WILLIAM F. PATRY, PATRY ON COPYRIGHTS § 13.9 (2008).

<sup>176</sup> See, *supra*, n.[XREF]; see also 4 WILLIAM F. PATRY, PATRY ON COPYRIGHTS § 13.9 (2008) (discussing, pedantically diagramming, and then committing the fallacy of affirming the consequent when analyzing the relationship between 1976 Act's distribution right and its definition of "publication").

<sup>177</sup> See, e.g., *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 36 (1<sup>st</sup> Cir. 2003) (collecting cases).

<sup>178</sup> *Davis v. Michigan Dept. of Treasury*, 489 U.S. 803, 809 (2000).

<sup>179</sup> The third sentence states, "A public performance or display of a work does not in itself constitute publication." It thus expressed a *limitation*—and one *not* expressed in §106(3). Does this mean that under § 106(3), public performances *are* distributions? Of course not: the third sentence just expressed what the first sentence had already clearly implied.

<sup>180</sup> *Arlington Central School Dist. v. Murphy*, 548 U.S. 291, 299 n.1 (2006); see, e.g., *Lamie v. United States Tr.*, 540 U.S. 526, 536 (2004) ("our preference for avoiding surplusage is not absolute").

publication” and the provision of § 203 that can extend the period in which artist can terminate the transfer of copyrights that include “the right of publication...”<sup>181</sup>

*Third*, were the intended relationship between the “publication” definition and the distribution right ambiguous, then we can determine whether legislative history clarified it. Doing so forecloses any serious claim that the “minor” 1971 amendment that added the second sentence of the “publication” definition was intended to stealthily retract a previously granted publication/making-available right.

A distribution right and a definition of “publication” appeared in 1964, in the first bills introduced during the Fourth General Revision.<sup>182</sup> In those bills, the distribution right granted an 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,” and “publication” was defined as “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.”<sup>183</sup> In his 1965 *Supplementary Report*, the Register described the scope of the distribution right as “virtually identical with the definition of “publication”” and concluded that this congruity would implicate prior case law defining “publication,” unless specifically repudiated.<sup>184</sup> The distribution right and “publication” thus remained virtually identical for seven years, through the close of the 91<sup>st</sup> Congress and 1970.<sup>185</sup>

In 1971, the general revision bill pending at the end of the 91<sup>st</sup> Congress was reintroduced as S. 644 with only “minor amendments”—including the addition of the second sentence of the definition of “publication.”<sup>186</sup> That belated and humble origin shows that this sentence was a minor clarification and forecloses serious claims that this sentence could have been intended to retract a publication right. As a result, the second sentence of the definition of “publication” is not textual proof that Congress *really did intend* to repudiate the *Phonograms Convention* by enacting the first U.S. Copyright Act to deny a right of publication. To quote the Supreme Court, “Congress, we have held, does not alter the fundamental

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<sup>181</sup> 17 U.S.C. §§ 203(a)(3), 407(a). See *United States v. Atlantic Research Corp.*, 551 U.S. 128, 127 S. Ct. 2331, 2337 (2007) (“It is appropriate to tolerate a degree of surplusage rather than adopt a textually dubious construction that threatens to render [an] entire provision a nullity.”); *Hawaiian Airlines, Inc. v. Norris*, 512 U.S. 246, 253-54 (1994) (refusing to avoid surplusage by creating it elsewhere).

<sup>182</sup> See S. 3008, 88<sup>th</sup> Cong. §§ 5(a)(3), 54 (1964); H.R. 11947, 88<sup>th</sup> Cong. §§ 5, 54 (1964).

<sup>183</sup> The one-sentence definition of “publication” used from 1964 to 1970 also re-confirms that Congress and the Copyright Office intended for the text of the distribution right—and the congruent one-sentence definition of “publication”—to *retain* the specialized meanings both had developed under prior law. Simply put, this definition of “publication” *had to be* intended to perpetuate antecedent jurisprudence in order to, for example, perpetuate the indispensable distinction between limited and general publication.

<sup>184</sup> *Supplementary Register’s Report on the General Revision of the U.S. Copyright Law*, at 15, 16, 19 (House. Comm. Print 1965). PATRY ON COPYRIGHTS claims that the Register’s 1965 Supplemental report erred by equating distribution and publication. 4 *id.* at § 13.8. Given both *Morrisette* and the congruence of the relevant language in 1965, the Register was correct, and the treatise is wrong—again. As always, it is again wrong in a way that would reduce copyright protection.

<sup>185</sup> See S. 1006, 89<sup>th</sup> Cong. §§ 101, 106(a)(3) (1965); H.R. 4347, 89<sup>th</sup> Cong. §§ 101, 106(a)(3) (1965); S. 597, 90<sup>th</sup> Cong. §§ 101, 106(3) (1967); H.R. 2512, 90<sup>th</sup> Cong. §§ 101, 106(3) (1967); H.R. Rep. No. 90-83, at 24-26 (1967) (discussing the exclusive right of “publication”); S. 543, 91<sup>st</sup> Cong. §§ 101, 106(3) (1969).

<sup>186</sup> H.R. Rep. No. 94-1476 at 48 (1976); S. Rep. No. 94-473 at 48 (1975). The third sentence of the present definition was added, without comment, in the amendment in the nature of a substitute to S. 1361 favorably reported by the Senate Committee on the Judiciary on July 3, 1974. S. Rep. No. 93-983 at 5 (1974).

details of a regulatory scheme in vague terms or ancillary provisions—it does not, one might say, hide elephants in mouseholes.”<sup>187</sup>

In conclusion, the combination of legal history, prior law, prior jurisprudence, legislative history, and statutory text discussed above shows that “to distribute” encompasses a making-available right. It should also suggest that 21<sup>st</sup> Century debates about a making-available right may be—ironically enough—a side-effect of the successes achieved during the Fourth General Revision by the drafters of the 1976 Act.

Before the 1976 Act became effective in 1978, all prior U.S. copyright laws had expressly granted copyright owners *part* of the exclusive right “to publish” that was central to the very idea of copyrights. Nevertheless, throughout the Fourth General Revision, the very people most familiar with this long tradition—the government’s administrative and legislative experts on copyright law—repeatedly and effortlessly concluded that replacing the venerable right “to publish” with a right “to distribute copies” would re-confer and expand “the exclusive right of publications.”

These experts had lived their professional lives under the Copyright Act of 1909, which generally resembled preceding acts. Under the 1909 Act, “publication” was “perhaps the most important single concept”; it played the “central role” and could have an “all-embracing importance.”<sup>188</sup> To these experts, nothing could have seemed more familiar or obvious than the tripartite, specialized meaning of “publication” that U.S. copyright law had devised: “to publish” meant “to distribute copies to the public,” which occurred when copies were publicly offered or made available to members of the public.

Nevertheless, during the Fourth General Revision, both the Copyright Office and Congress concluded that under a revised copyright law, “‘publication’ should no longer play the central role assigned to it under the [1909 Act].”<sup>189</sup> The Copyright Act of 1976 achieved that goal: under that Act, questions about the meaning of “publication” have—until now—rarely played a significant role. Consequently, over 36 years later, the tripartite association between publishing copies, distributing copies and making copies available *should* seem less obvious to practitioners and judges to whom it has so rarely mattered. Fortunately, cases like *Morrisette* and *Neder* ensure that we need not mistake the limits of our current intuitions for the intentions of the drafters of the Copyright Act of 1976.

## **II. Alternative Interpretations of Section 106 Can Also Provide a Making-Available Right.**

The preceding analyses argued that the best or most reasonable interpretations of “to authorize” and “to distribute” provide making-available rights. Were those analyses to prove unpersuasive to a particular judge, there would still be at least four other alternative means to conclude that § 106 of the 1976 Act provides making-available rights.

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<sup>187</sup> *Whitman v. American Trucking Ass’n*, 531 U.S. 457, 468 (2001) (citing *MCI Telcoms. Corp. v. AT&T*, 512 U.S. 218, 231 (1994)); see also *FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 159-60 (2000)).

<sup>188</sup> S. Rep. No. 94-473, 94<sup>th</sup> Cong. 1<sup>st</sup> Sess. at 113, 121.

<sup>189</sup> *Id.*

**A. *Charming-Betsy* Deference Requires Courts To Adopt Any Reasonable Interpretation of § 106 That Could Provide the Making-Available/Publication Rights Required by at Least Sixteen International Agreements.**

For 205 years, cases like *Murray v. Charming Betsy* have required courts to adopt any reasonable interpretation of a U.S. statute that implements an international obligation of the United States.<sup>190</sup> Since 1910, at least sixteen purportedly implemented international agreements have required the U.S. to provide making-available rights. For 208 years, cases like *Talbot v. Seemans* have held that courts must defer whenever an enacted statute interprets a prior law.<sup>191</sup> Ten of the agreements just noted were Free Trade Agreements implemented by the domestic enactment of laws that interpreted the 1976 Act to grant a making-available right. Both international agreements and domestic implementing legislation thus require courts to adopt reasonable interpretations of the Copyright Act that provide a making-available right.

In *Eldred v. Ashcroft*, the Supreme Court refused to adopt “an isolationist reading of the Copyright Clause that is in tension with America’s international copyright relations over the last hundred or so years.”<sup>192</sup> Ordinarily, courts avoid “isolationist” interpretations of domestic laws through the so-called *Charming-Betsy* doctrine.<sup>193</sup> For example, in *Lauritzen v. Larsen*, the Supreme Court applied “the long-headed admonition of Mr. Chief Justice Marshall that ‘an act of congress ought never to be construed to violate the law of nations if any other possible construction remains.’”<sup>194</sup>

*Charming-Betsy* deference does not, however, require courts to conform U.S. law to international law. To the contrary, it recognizes that the elected Branches must decide whether to obey or violate international norms or agreements, and that courts must defer to such choices, *if a violation was intended*.<sup>195</sup> *Charming-Betsy* deference thus implements two fundamental principles of domestic constitutional law.

First, *Charming-Betsy* deference implements separation-of-powers principles: It prevents unelected judges from intruding upon the exercise of the Treaty and Foreign Commerce Powers that the Constitution grants to the President and Congress. Were courts free to reject a reasonable interpretation of a domestic law in favor of one that would violate an international obligation of the

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<sup>190</sup> 6 U.S. 64, 118 (1804) (Marshall, J.).

<sup>191</sup> 5 U.S. 1, 33, 34 (1801) (Marshall, J.).

<sup>192</sup> 537 U.S. 186, 206 n.13 (2003); *accord* *Golan v. Holder* 132 S. Ct. 873, 889 n.28 (2012) .

<sup>193</sup> *See Murray v. Charming Betsy*, 6 U.S. 64, 118 (1804) (Marshall, J.).

<sup>194</sup> *Lauritzen v. Larsen*, 345 U.S. 571, 578 (1953) (quotation omitted).

<sup>195</sup> *See, e.g., Chae Chan Ping v. United States*, 130 U.S. 581, 599-602 (1889) (interpreting a statute to abrogate treaty obligations). Some scholars favor an “internationalist” interpretation of *Charming Betsy* that would, in effect, require the Executive and Legislative Branches to expressly state their intent to violate international obligations. *See, e.g.,* Ralph G. Steinhardt, *The Role of International Law as a Canon of Domestic Statutory Construction*, 43 Vand. L. Rev. 1103 (1990). But most scholars argue that *Charming Betsy* implements purely domestic principles of comity and separation-of-powers that require courts to let the political branches abrogate international obligations *when they clearly intend to do so*. *See, e.g.,* Curtis A. Bradley, *The Charming Betsy Canon and Separation of Powers*, 86 Geo. L.J. 479 (1998). The latter, narrower interpretation of the *Charming-Betsy* doctrine suffices to resolve the making-available-right debate.

United States, courts could usurp the powers of other Branches, disrupt international trade, and trigger trade wars:

For us to run interference in such a delicate field of international relations there must be present the affirmative intention of Congress clearly expressed. It alone has the facilities necessary to make fairly such an important policy decision where the possibilities of international discord are so evident and retaliative action so certain.<sup>196</sup>

*Second, Charming Betsy* deference—like the rule favoring constitutional constructions of statutes—also implements a principle of comity: When possible, it presumes that neither the President nor the Congress negligently or deliberately violate or ignore the international obligations of the United States. It does so because other nations must trust the President and Congress to exercise their Powers competently and in good faith:

The statute should be construed in the light of the purpose of the Government to act within the limitation of the principles of international law, the observance of which is so essential to the peace and harmony of nations, and it should not be assumed that Congress proposed to violate the obligations of this country to other nations....<sup>197</sup>

*Charming-Betsy* deference thus promotes “a harmony particularly needed in today’s interdependent commercial world.”<sup>198</sup> As the *en banc* Ninth Circuit noted, a different approach could “disrupt Congress’s efforts to secure a more stable international intellectual property regime ... [and] might undermine Congress’s objective of achieving ‘effective and harmonious’ copyright laws among all nations.”<sup>199</sup> *Charming-Betsy* deference thus requires courts to adopt any reasonable interpretation of the 1976 Act that grants a making-available right and complies with at least *fourteen* adopted-and-implemented international agreements that require a making-available right.<sup>200</sup>

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<sup>196</sup> *Benz v. Compania Naviera Hidalgo, S.A.*, 353 U.S. 138, 147 (1957); see also, e.g., *Weinberger v. Rossi*, 456 U.S. 25, 31-32 (1982) (interpreting the term “treaty” to encompass non-ratified international agreements because a narrower interpretation “would have had foreign policy implications”); *McCulloch v. Sociedad Nacional de Marineros de Honduras*, 372 U.S. 10, 21 (1963) (“such highly charged international circumstances brings to mind the admonition ... that ‘an act of congress ought never to be construed to violate the law of nations if any other possible construction remains’”) (quoting *Pigeon River Improvement, Slide & Boom Co. v. Charles W. Cox, Ltd.*, 291 U.S. 138, 160 (1934)).

<sup>197</sup> *MacLeod v. United States*, 229 U.S. 416, 434 (1913) (applying *Charming Betsy* deference); see also, e.g., *Washington v. Washington State Comm. Passenger Fishing Vessel Ass’n*, 443 U.S. 658, 690 (1979) (same); *Menominee Tribe v. United States*, 391 U.S. 404, 412-13 (1968) (same).

<sup>198</sup> *F. Hoffmann-La Roche Ltd. v. Empagran S.A.*, 542 U.S. 155, 164-65 (2004).

<sup>199</sup> *Subafilms, Ltd. v. MGM-Pathe Comms. Co.*, 24 F.3d 1088, 1097 (9<sup>th</sup> Cir. 1994) (en banc); see also *Brown v. Duchesne*, 60 U.S. 183, 197 (1857) (rejecting interpretations of domestic intellectual-property laws that would “seriously embarrass the commerce of the country with foreign nations”).

<sup>200</sup> Because this paper focuses on the interpretation of § 106 of the 1976 Act, it does not discuss the various proclamations and bilateral treaties that let the United States maintain some international copyright relations outside of the Western Hemisphere and before its accession to the 1952 *Universal Copyright Convention*. By the era of the Fourth General Revision, U.S. policymakers knew that broad, multilateral agreements were needed to both simplify and strengthen the international copyright relations of the United States. Consequently, during the drafting of the 1976 Act, the requirements of the major multilateral agreements would have been far more important to Congress, the Copyright Office, and the Executive Branch.

For present purposes, these international agreements can be divided into two groups: (1) those to which the United States acceded before the Copyright Act of 1976 was enacted; and (2) those to which the United States acceded after the Copyright Act of 1976 was enacted.

Before the Copyright Act of 1976 was enacted, the United States had acceded to and purportedly implemented three major multilateral treaties that required the U.S. to provide publication/making-available rights.

- The first was the 1910 *Buenos Aires Convention* that created multilateral copyright relations between the United States and many countries in Central and South America.<sup>201</sup> Section 4 of this *Convention* stated: “The copyright of a literary or artistic work, includes for its author or assigns the exclusive power of disposing of the same, of *publishing*, assigning, translating or authorizing its translation and reproducing it in any form whether wholly or in part.”<sup>202</sup>
- The second was the 1971 revision of the 1952 *Universal Copyright Convention*, which required the United States to provide exclusive rights “to authorize” reproduction, translations, and public performances.
- The third was the *Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms* (the “*Phonograms Convention*”), which required signatories to protect producers of sound recordings against “any act by which duplicates of a phonogram are *offered*... to the general public or any section thereof.”<sup>203</sup>

After the 1976 Act was enacted, the U.S. ratified or enacted at least thirteen more international agreements that required the U.S. to provide making-available rights. In 1988, the United States acceded to the *Berne Convention for the Protection of Literary and Artistic Works*, which also requires signatories to provide making-available rights to holders of copyrights in certain types of works.<sup>204</sup> In 1994, the *Agreement on Trade-Related Aspects of Intellectual Property Rights* (“*TRIPS*”) made compliance with relevant Berne-Convention obligations enforceable through WTO dispute-resolution proceedings and trade sanctions.<sup>205</sup>

But by 1994, it was also obvious that the Berne norms had to be updated in light of the Internet. The United States thus led efforts to negotiate, promulgate, ratify, and implement the *WIPO Copyright Treaty* (“*WCT*”) and the *WIPO Performances and Phonograms Treaty* (“*WPPT*”)—both of which require signatories to provide making-available rights. After the *WCT* and *WPPT* were promulgated, they were

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<sup>201</sup> Convention on Literary and Artistic Copyrights, Aug. 11, 1910, 38 Stat. 1785, 155 L.N.T.S. 179 (Buenos Aires Convention) [hereinafter Buenos Aires Convention].

<sup>202</sup> *Id.* at § 4.

<sup>203</sup> Art 1(d), 2, Oct. 29, 1971, 25 U.S.T. 309, 866 U.N.T.S. 67 (emphasis added). Because the Phonograms Convention focuses on copyrights in sound recordings, the making-available right it requires must have been conferred in the first *three* subsections of Section 106 of the 1976 Act.

<sup>204</sup> See Berne Convention Implementation Act of 1988, Pub. L. 100-568, § 2(1), 102 Stat. 2853, 2853 (1988); Berne Convention for the Protection of Literary and Artistic Works, arts. 11, 14, Sept. 9, 1886, 25 U.S.T. 1341, 828 U.N.T.S. 221.

<sup>205</sup> See Marrakesh Agreement Establishing the [WTO], Art. II, §2, 1867 U.N.T.S. 154, 33 I.L.M. 1144 (Apr. 15, 1994); Uruguay Rounds Agreements Act, Pub. L. 103-465, 108 Stat. 4809 (1994). To avoid claims that this analysis ignores the effects of 17 U.S.C. § 104(c), it counts the *Berne Convention* and the *TRIPS Agreement* as one agreement.

ratified by the Senate, but the President could only deposit instruments of ratification with WIPO *after* the U.S. enacted legislation implementing those Treaties.<sup>206</sup> Both Houses of Congress thus drafted implementing bills and produced several committee reports.<sup>207</sup> The Register of Copyrights testified that existing exclusive rights implemented the Treaties' making-available-right obligation.<sup>208</sup> Both Co-Chairs of the U.S. Delegation to the Diplomatic Conference that promulgated the WCT and WPPT gave similar testimony.<sup>209</sup>

The relevant House and Senate Committees then agreed that existing law provided a making-available right.<sup>210</sup> Both Houses of Congress and the President then agreed, and the WIPO Copyright and Performances and Phonograms Treaties Implementation Act of 1998 was enacted in the Digital Millennium Copyright Act of 1998 (the "DMCA").<sup>211</sup> On September 14, 1999, concluding that U.S. law fully implemented both WIPO Treaties, President Clinton submitted the U.S. ratifications of the WCT and WPPT.<sup>212</sup>

Nevertheless, even after the WCT and WPPT were promulgated, widely adopted and implemented, compliance with these treaties was not a TRIPS obligation subject to dispute resolution in the WTO. The U.S. thus used Free Trade Agreements to compensate for this potential weakness. Eventually, the United States negotiated and adopted ten bilateral or multilateral FTAs that required parties to provide a making-available right—or face trade sanctions in the WTO.<sup>213</sup>

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<sup>206</sup> See S. Treaty Doc. No. 105-17, § (c)(1) (Oct. 21, 1998). Consequently, if Section 106 of the 1976 Act does not grant making-available rights, then the United States is not a even party to these Treaties.

<sup>207</sup> See *Davidson & Assocs. v. Jung*, 422 F.3d 630, 639-40 & n.10 (8<sup>th</sup> Cir. 2005) (discussing this history).

<sup>208</sup> *Hearing on WIPO Copyright Treaties Implementation Act (H.R. 2281) and On-Line Copyright Liability Limitation Act (H.R. 2180) before the Subcomm. On Courts, the Internet and Intellectual Property of the House Comm. On the Judiciary*, 105<sup>th</sup> Cong., 1<sup>st</sup> Sess., Sept. 16, 1997 (testimony of Marybeth Peters, the Register of Copyrights) (citing and summarizing then-existing cases addressing on-line liability for copyright infringement); see also *Piracy of Intellectual Property on Peer-to-Peer Networks: Hearing before the Subcomm. On Courts, the Internet and Intellectual Property of the House Comm. On the Judiciary*, 107<sup>th</sup> Cong. 114-115 (2002) (Letter from Marybeth Peters).

<sup>209</sup> *Hearing on WIPO Copyright Treaties Implementation Act (H.R. 2281) and On-Line Copyright Liability Limitation Act (H.R. 2180) before the Subcomm. On Courts, the Internet and Intellectual Property of the House Comm. On the Judiciary*, 105<sup>th</sup> Cong., 1<sup>st</sup> Sess., Sept. 16, 1997 (testimony of Bruce Lehman, Assistant Secretary of Commerce for Intellectual Property); *WIPO Copyright Treaty (WCT) (1996) and WIPO Performances and Phonograms Treaty (WPPT) (1996), before the Comm. On Foreign Relations*, Exec. Rpt. 105-25, 105<sup>th</sup> Cong., 2<sup>nd</sup> Sess. at 29-30, Oct. 14, 1998 (testimony of Alan P. Larson, Assistant Secretary of State for Economic and Business Affairs).

<sup>210</sup> H.R. 105-551, pt.1, 105<sup>th</sup> Cong., 2<sup>nd</sup> Sess. at 9 ("The ...treaties do not require any change in the substance of copyright rights or exceptions in U.S. law."); S. Rep. 105-190, 105<sup>th</sup> Cong., 2<sup>nd</sup> Sess. at 10-11 ("to adhere to the WIPO treaties, legislation is necessary in two primary areas—anticircumvention of technological protection measures and protection of the integrity of rights management information").

<sup>211</sup> See 105 P.L. 304, §§ 101-05, 112 Stat. 2860 (1998); see also *id.* at preamble (describing the act as one "[t]o amend title 17, United States Code, to implement the World Intellectual Property Organization Copyright Treaty and Performances and Phonograms Treaty").

<sup>212</sup> See, e.g., *WIPO, Ratification by the United States of America*, at [http://www.wipo.int/edocs/notdocs/en/wct/treaty\\_wct\\_10.html](http://www.wipo.int/edocs/notdocs/en/wct/treaty_wct_10.html).

<sup>213</sup> See An Act To implement the United States-Oman Free Trade Agreement, PL 109-283, Title I, Sec 101 (a) (2), 120 Stat. 1191 (2006); An Act To implement the United States-Bahrain Free Trade Agreement, PL 109-169, Title I,

As a result, at least sixteen adopted, ratified-or-enacted, and purportedly implemented international agreements now require the United States to provide making-available rights. These agreements trigger *Charming-Betsy* deference and require courts to adopt reasonable interpretations of the 1976 Act that provide a making-available right.

The 1910 *Buenos Aires Convention*, the 1971 *Geneva Phonograms Convention* and the 1971 version of the *UCC* inarguably trigger *Charming-Betsy* deference. Courts have routinely applied *Charming-Betsy* deference when relevant statutes (like the Copyright Act of 1976) were enacted *after* the United States had ratified international treaties (like the *Geneva Phonograms Convention*). *Charming-Betsy* deference is thus “a firm and obviously sound canon of construction against finding implicit repeal of a treaty in ambiguous congressional action.”<sup>214</sup> For example, It seems highly implausible that, in the 1976 Act, the Executive Branch that negotiated the *Geneva Phonograms Convention*, the Senate that ratified it, and the House of Representatives that wields the Foreign Commerce Power *unambiguously* snubbed the 75 other nations that had acceded, or would later accede, to this Convention.<sup>215</sup>

Deference is also required by the *purportedly implemented* international agreements ratified *after* 1976—the *Berne Convention/TRIPS Agreement*, the *WCT*, the *WPPT*, and the ten FTAs—that should also trigger *Charming-Betsy* deference.<sup>216</sup> While the Supreme Court has yet to address this precise question, circuit courts have repeatedly held that *Charming-Betsy* deference requires courts to adopt reasonable interpretations of statutes that satisfy subsequently assumed international obligations.<sup>217</sup>

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Sec 101 (a) (2), 119 Stat. 3581 (2006); An Act To implement the Dominican Republic-Central America-United States Free Trade Agreement, PL 109-53, Title I, Sec 101 (a) (2), 119 Stat. 463 (2005); An Act To implement the United States-Morocco Free Trade Agreement, PL 108-302, Title I, Sec 101 (a) (2), 118 Stat. 1104 (2004); An Act To implement the United States-Australia Free Trade Agreement, PL 108-286, Title I, Sec 101 (a) (2), 118 Stat. 920 (2004); An Act To implement the United States-Chile Free Trade Agreement, PL 108-77, Title I, Sec 101 (a) (2), 117 Stat. 910 (2003); An Act To implement the United States-Singapore Free Trade Agreement, PL 108-78, Title I, Sec 101 (a) (2), 117 Stat. 949 (2003). The United States has just enacted three more FTAs with the Republic of Korea, Columbia, and Panama that required the parties to provide making-available rights to copyright owners. See United States-Panama Free Trade Agreement Implementing Legislation, PL 112-43, 125 Stat. 497 (2011); United States-Columbia Free Trade Agreement Implementing Legislation, PL 112-42, 125 Stat. 462 (2011); United States-Korea Free Trade Agreement Implementing Legislation, PL 112-41, 125 Stat. 428 (2011).

<sup>214</sup> *Trans World Airlines, Inc. v. Franklin Mint Corp.*, 466 U.S. 243, 281(1984).

<sup>215</sup> See, WIPO, Contracting Parties, Phonograms Convention, at [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=18](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=18).

<sup>216</sup> Naturally, international agreements cannot trigger *Charming-Betsy* deference until the United States has actually ratified or entered into those agreements. See *Quality King Distribs. v. L’Anza Research Int’l*, 523 U.S. 135, 153-54 (1998) (giving no weight to the terms of *unratified* trade agreements).

<sup>217</sup> In the Supreme Court’s most relevant case, *Cook v. United States*, 288 U.S. 102 (1933), a subsequent international agreement did override the interpretive effect of an earlier statute. During Prohibition, U.S. agents invoked the Tariff Act of 1922 to seize alcohol carried in British ships that approached the U.S.; until this practice was prohibited by a 1924 Treaty between the U.S. and Britain. *Id.* at 107. Later, the Tariff Act of 1930 re-enacted the Tariff Act of 1922 without change, which would indicate intent to ratify prior seizure practices. *E.g.*, *National Lead Co. v. United States*, 252 U.S. 140, 146-47 (1920). After U.S. agents again seized alcohol from a British ship, the Supreme Court had to decide whether the 1930 re-enactment of the 1922 statutory language had abrogated the 1924 Treaty. The Court invoked the *Charming-Betsy* doctrine to find that it did not. *Id.* at 120.

For example, many U.S. tariff laws were enacted before the U.S. adopted the *expressly* non-self-executing General Agreement on Tariffs and Trade (GATT) and subsequent implementing legislation.<sup>218</sup> Nevertheless, courts have invoked *Charming-Betsy* deference to avoid interpretations of *pre-existing* U.S. tariff and antidumping laws that would conflict with GATT: “For [a court] to read a GATT violation into the [pre-existing] statute, over Commerce’s objection, may commingle powers best kept separate.”<sup>219</sup>

Nevertheless, one district court has suggested, in *dicta*, that the making-available-right obligations imposed by the *WCT* and *WPPT* are “non-self-executing,” and implied that this somehow affects the application of the *Charming-Betsy* deference.<sup>220</sup> For three reasons, that is wrong.

*First*, black-letter law shows that courts accord *Charming-Betsy* deference *regardless* of whether a given international obligation was self-executing. For example, the *Restatement* of U.S. foreign-relations law distinguishes between self-executing and non-self-executing agreements, but not when describing *Charming-Betsy* deference: “Where fairly possible, a United States statute is to be construed so as not to conflict with international law or an international agreement of the United States.”<sup>221</sup>

*Second*, while some provisions of the WIPO Internet Treaties were *not* self-executing, their making-available-right provisions *were* intended to be self-executing under then-existing U.S. copyright laws. The *Restatement* provides:

Some provisions of an international agreement may be self-executing and others not self-executing.... There can, of course, be instances in which the United States Constitution, or previously enacted legislation, will be fully adequate to give effect to an apparently non-self-executing international agreement, thus obviating the need of adopting new legislation to implement it.<sup>222</sup>

*Third*, even if courts withheld *Charming-Betsy* deference *until* Congress enacted legislation to implement a non-self-executing international agreement, it would make no sense to withhold such deference *after* Congress and the President purport to have implemented the agreement in domestic law. At that point, the comity and separation-of-powers principles underlying *Charming Betsy* are implicated.

Indeed, the domestic implementation of these agreements also triggers a second deference principle. Since 1801, the Supreme Court has repeatedly held that when Congress and the President enact a

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<sup>218</sup> See 19 U.S.C. § 3512(a)(1).

<sup>219</sup> *Federal Mogul Corp. v. United States*, 63 F.3d 1572, 1582 (Fed. Cir. 1995) (holding that when the Executive Branch had interpreted a pre-GATT statute to avoid a conflict with GATT, the *Charming Betsy* rule and “foreign policy repercussions” required the trial court to defer to the GATT-compliant interpretation); see also *Allegheny Ludlum Corp. v. Armco, Inc.*, 367 F.3d 1339, 1345, 1348 (Fed. Cir. 2004); *Luigi Bormioli Corp. v. United States*, 304 F.3d 1362, 1368 (Fed. Cir. 2002); *Caterpillar Inc. v. United States*, 941 F. Supp. 1241, 1247-48 (C.I.T. 1996).

<sup>220</sup> *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210, (D. Minn. 2008).

<sup>221</sup> *Restatement of the Law, Third, Foreign Relations Law of the United States*, § 114 (1987).

<sup>222</sup> *Id.* at comment h. Congress knows this, and that is presumably why 17 U.S.C. § 104(c) seems to do more than merely state that courts should treat the *Berne Convention* as non-self-executing. Nevertheless, Congress has never enacted similar language when ratifying the WIPO Internet Treaties, other copyright treaties or enacting any FTA. Such practices thus show that *Charming-Betsy* deference was intended to apply to these other treaties and FTAs, regardless of whether they are self-executing.

statute that explicitly or implicitly interprets a prior statute, courts must defer to the interpretation inherent in the subsequent legislation.<sup>223</sup> For example, in *Consumer Product Safety Commission v. GTE Sylvania, Inc.*, the Court held, “‘Subsequent legislation declaring the intent of an earlier statute is entitled to great weight in statutory construction’ ... [because] Congress has proceeded formally through the legislative process.”<sup>224</sup> Consequently, *enacted* legislative interpretations are *not* disfavored “subsequent legislative history.”<sup>225</sup>

To be sure, when international agreements of the United States have been implemented by domestic legislation, it may not matter whether deference derives from *Charming Betsy* or *GTE*. For example, Congress and the President necessarily interpreted the text of Section 106(3) of the Copyright Act to grant a making-available right when ratifying and implementing the Geneva Phonograms Convention, the Berne Convention, the WCT, and the WPPT. In such cases, it hardly matters whether judicial deference derives from *Charming Betsy* or *GTE*.

Nevertheless, *GTE* and *Charming-Betsy* deference overlap only partially. For example, unusually explicit legislative processes used to implement the seven bilateral or multilateral FTAs that require a making-available right. Each FTA implementation enacted *a subsequent law* that interpreted the 1976 Act to provide a making-available right. Courts interpreting the Act would have to consider the effects of these *enacted* domestic laws even were they *required to ignore* international agreements.

To enter into an FTA, the President must submit to Congress, (1) a proposed agreement, (2) a Statement of Administrative Action (SAA) describing which U.S. laws must be amended to implement the agreement, and (3) proposed legislation that would implement all non-self-executing obligations

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<sup>223</sup> *Talbot v. Seemans*, 5 U.S. 1, 33, 34 (1801) (Marshal, J.); see *Alexander v. Mayor of Alexandria*, 9 U.S. 1, 7-8 (1809) (“if a subsequent act on the same subject affords complete demonstration of the legislative sense of its own language, the rule ... requiring that the subsequent should be incorporated into the foregoing act, is a direction to courts in expounding the provisions of the law”); see also *Consumer Product Safety Comm’n v. GTE Sylvania, Inc.*, 447 U.S. 102, 118 n.13 (1980) (“Subsequent legislation declaring the intent of an earlier statute is entitled to great weight in statutory construction...” (citations omitted)); *Red Lion Broadcasting Co. v. FCC*, 395 U.S. 367, 380-81 (1969) (same); *Federal Housing Admin. v. The Darlington, Inc.*, 358 U.S. 84, 90 (1958) (“[s]ubsequent legislation which declares the intent of an earlier law... is entitled to weight when it comes to the problem of construction”); *Great Northern Ry Co. v. United States*, 315 U.S. 262, 277 (1942) (relying upon a statute enacted in 1906 to interpret a statute enacted in 1875 because “[i]t is settled that ‘subsequent legislation may be considered to assist in the interpretation of prior legislation upon the same subject’”) (quotation and citations omitted); *United States v. Stewart*, 311 U.S. 60, 64 (1940) (“The later act can therefore be regarded as a legislative interpretation of the earlier act...” (citations omitted)); *United States v. Stafoff*, 260 U.S. 477, 480 (1923) (“a statute purporting to declare the intent of an earlier one might be of great weight in assisting a Court”) (dicta); *Cope v. Cope*, 137 U.S. 682, 688 (1891) (“These several acts of Congress, dealing as they do with the same subject matter, should be construed not only as expressing the intention of Congress at the dates the several acts were passed, but the later acts should also be regarded as legislative interpretations of the prior ones.”); *Stockdale v. The Ins. Cos.*, 87 U.S. 323, 331 (1874) (“it may be taken to be established, that a legislative body may by statute declare the construction of previous statutes so as to bind the courts in reference to all transactions occurring after the passage of the law”); *United States v. Freeman*, 44 U.S. 556, 564-65 (1845) (“if it can be gathered from a subsequent statute in *pari materia*, what meaning the legislature attached to the words of a former statute, they will amount to a legislative declaration of its meaning, and will govern the construction of the first statute”).

<sup>224</sup> 447 U.S. 102, 118 n.13 (1980).

<sup>225</sup> See *id.* at 117-18 (explaining the distinction between subsequent legislation and unreliable subsequent legislative history); but see *Elektra Ent. Group, Inc. v. Barker*, 551 F. Supp. 2d 234, 242 n.7 (S.D.N.Y. 2008) (overlooking this distinction).

assumed by the U.S. in the agreement.<sup>226</sup> Congress itself then approves the SAA when it passes the FTA's implementing legislation, which the President then signs. Consequently, Congress has now enacted—and the President has now signed—at least ten sets of FTA-implementation legislation predicated upon ten congressionally approved SAAs recording ten Presidential conclusions that then-existing U.S. law provided a making-available right.<sup>227</sup>

For example, Chapter 16 of the U.S.-Singapore FTA requires each Party to provide copyright owners with a making-available right.<sup>228</sup> In the SAA for this FTA, the Executive Branch concluded, “No statutory or administrative changes will be required to implement Chapter 16.”<sup>229</sup> When considering the SAA and proposed implementing legislation, Committees of both houses of Congress praised the Agreement's making-available-right obligation.<sup>230</sup> Congress then passed, and the President signed, the United States-Singapore Free Trade Agreement Implementation Act, which approved “the statement of administrative action proposed to implement the Agreement...”<sup>231</sup> Both Congress and the President thus concluded—through an *unusually formal* legislative process—that existing U.S. law implemented the U.S.-Singapore FTA's making-available obligation.

The FTA-implementation acts are thus subsequent laws that interpret the 1976 Act to grant a making-available right. In *GTE*, the Supreme Court unanimously held that courts must give interpretations expressed or implicit in subsequent *legislation* “great weight” when interpreting an antecedent statute.<sup>232</sup>

The need for *GTE* deference can also arise from purely domestic legislation. For example, in the Family Entertainment and Copyright Act of 2005, Congress amended the criminal-copyright-infringement statute, § 506, by adding § 501(a)(1)(C).<sup>233</sup> Sections 506(a) and 506(a)(1)(C) now make it a crime to willfully infringe a copyright in “a work being prepared for commercial distribution, by making it available on a computer network accessible to members of the public...” Congress could rationally enact § 506(a)(1)(C) only *if* it interpreted the Copyright Act to grant a making-available right. Otherwise, § 506(a)(1)(C) would be a nullity: unless you can infringe one or more of the Section 106 exclusive rights in a work by “making it available on a computer network accessible to members of the public...,” you cannot violate § 506(a)(1)(C). This entire provision should not be nullified if any reasonable interpretation of § 106 could give it effect.

In conclusion, courts must now defer to any reasonable interpretation of the Copyright Act that would provide making-available rights. Consequently, the making-available right debate is effectively over: U.S.

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<sup>226</sup> See 19 U.S.C. §§ 3805, 3830(b).

<sup>227</sup> See *supra*, n.210.

<sup>228</sup> See U.S.-Singapore Free Trade Agreement at Art. 16.4.2(a) [http://www.ustr.gov/assets/Trade\\_Agreements/Bilateral/Singapore\\_FTA/Final\\_Texts/asset\\_upload\\_file708\\_4036.pdf](http://www.ustr.gov/assets/Trade_Agreements/Bilateral/Singapore_FTA/Final_Texts/asset_upload_file708_4036.pdf).

<sup>229</sup> See Statement of Administrative Action at 34, U.S.-Singapore Free Trade Agreement Implementation Act (2003) <http://waysandmeans.house.gov/media/pdf/singapore/hr2739SingaporeSAA7-15-03.pdf>.

<sup>230</sup> H.R. Rep. 108-225, pt.2, at 3; see also S. Rep. 108-117, at 17.

<sup>231</sup> Pub. L. 108-78 at § 101(a)(2), 117 Stat. 948 (2003).

<sup>232</sup> *Consumer Product Safety Comm'n v. GTE Sylvania, Inc.*, 447 U.S. 102, 118 n.13 (1980).

<sup>233</sup> See 109 Pub. L. 9, 119 Stat. 218 (2005).

making-available rights can be derived from perfectly reasonable interpretations of either “to authorize” in § 106, or “to distribute” in § 106(3).

**B. *Tasini* and Other Precedents May Require Courts to Hold That the Copyright Act Provides a Making-Available Right.**

This paper does not try to analyze in detail when relevant judicial precedents will bind any particular court. Many federal courts will find that relevant precedents indicate that the Copyright Act provides a making-available right.<sup>234</sup> A few may find that *potentially* relevant precedents indicate that the Act does

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<sup>234</sup> *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1162 (9th Cir. 2007) (“distribution rights ...were infringed by Napster users ... when they used the Napster software to make their collections available to all other Napster users”); *A&M Records v. Napster, Inc.*, 239 F.3d 1004, 1014 (9th Cir. 2001) (“Napster users who upload file names to the search index for others violate plaintiffs’ distribution rights.”); *Hotaling v. Church of Jesus Christ of Latter-Day Saints*, 118 F.3d 199, 203 (4th Cir. 1997) (holding that making a work available in a public library infringes the distribution right); *Agee v. Paramount Comms., Inc.*, 59 F.3d 317, 325 (2d Cir. 1995) (equating distribution with “publication”); *Ford Motor Co. v. Summit Motor Prods., Inc.* 930 F.2d 277, 299 (3rd Cir. 1991) (“‘Publication’ and... section 106(3), then, are for all practical purposes synonymous”); *Elektra Ent. Group, Inc. v. Barker*, 551 F. Supp. 2d 234, 243 (S.D.N.Y. 2008) (holding that “to distribute” encompasses offers to distribute); *Atlantic Recording Corp. v. Anderson*, No. H-06-3578, 2008 WL 2316551, at \*8 (S.D. Tex. March 12, 2008) (making files available “on KaZaA constituted a ‘distribution’ for the purposes of ...copyright infringement”); *Advance Magazine Pubs., Inc. v. Leach*, 466 F. Supp. 2d 628, 638 (D. Md. 2006) (“Defendant operates... an online database of literary works, and by making available... Plaintiff’s publications, he has infringed its right to distribute”); *Artista Records, LLC v. Greubel*, 453 F. Supp. 2d 961, 969 (N.D. Tex. 2006) (“the courts have recognized that making copyrighted works available to others may constitute infringement by distribution”); *Elektra Ent. Group, Inc. v. Brimley*, No. CV205-314, 2006 WL 2367135, at \*2 (S.D. Ga. Aug. 15, 2006) (“use of a peer to peer [network] to share music files infringes copyright”); *Warner Bros. Records, Inc. v. Payne*, No. W-06-CA-051, 2006 WL 2844415, at \*3 (W.D. Tex. July 17, 2006) (equating distribution and publication); *Interscope Records v. Duty*, No. 05-CV-3744-PHX-FJM, 2006 U.S. Dist. LEXIS 20214, at \*7 (April 14, 2006) (“the right of distribution is synonymous with the right of publication”); *Columbia Pictures Inds. v. T & F Ent., Inc.*, 68 F. Supp. 2d 833, 839 (E.D. Mich. 1999) (finding *prima facie* copyright infringement because defendants “held... video cassettes out for distribution to the general public”); *Expeditors Int’l v. Direct Line Cargo Mgmt. Servs.*, 995 F. Supp. 468, 477 (D.N.J. 1998) (holding that “to authorize” has its ordinary meaning); *Marobie-FI, Inc. v. Nat’l Ass’n of Fire and Equip. Distribs. And Northwest Nexus, Inc.*, 983 F. Supp. 1167, 1173 (N.D. Ill. 1997) (holding that making files available on a website infringes the distribution right); *Playboy Ent., Inc. v. Chuckleberry Pub., Inc.*, 939 F. Supp. 1032, 1039 (S.D.N.Y. 1996) (holding that the defendant violated an injunction because making plaintiff’s works available on a web site infringed its distribution right); *Playboy Ent., Inc. v. Russ Hardenburgh, Inc.*, 982 F. Supp. 503, 513 (N.D. Ohio 1997) (holding that making files available for downloading infringed the distribution right); *The Walt Disney Co. v. Video 47, Inc.*, 972 F. Supp. 595, 602 (S.D. Fla. 1996) (holding that defendants infringed by “holding out for rental” unauthorized videotapes); *Curb v. MCA Records, Inc.*, 898 F. Supp. 586, 593-94 (M.D. Tenn. 1995) (holding that an interpretation of “authorize” that ties “the authorization right solely to a claim of justiciable contributory infringement appears contrary both to well-reasoned precedent, statutory text, and legislative history”); *Playboy v. Frena*, 839 F. Supp. 1552, 1556 (M.D. Fla. 1993) (holding that making files available on an Internet BBS infringes the distribution right); *Wildlife Int’l, Inc. v. Clements*, 591 F. Supp. 1542, 1546 (S.D. Ohio 1984) (holding that defendant infringed copyrights “by selling or offering to sell... 22 copyrighted works”). I disagree with *Lost Ark’s* claim that pre-1998 distribution cases “retain little, if any, precedential value” after the 1998 enactment of the so-called “safe-harbor” provisions codified a 17 U.S.C. § 512. See Menell, *supra* note [CROSS REF] at 9. These “safe harbors” expressly limit only *remedies* for infringement—they do not narrow the scope of liability for infringement—a fact that has important implications for discussions about foreign rogue websites. See 17 U.S.C. § 512(j)(1)(B)(ii).

not provide a making-available right.<sup>235</sup> But all federal district and circuit courts should be bound by the alternative holding in the Supreme Court’s 2002 decision in *New York Times Co. v. Tasini*.<sup>236</sup>

In *Tasini*, the Court twice held that the plaintiffs’ distribution rights in 21 articles were infringed because their “Print Publishers” had authorized the operators of the LEXIS/NEXIS database to make copies of plaintiffs’ articles available to the public—*without any evidence that any of plaintiffs’ articles were ever accessed or downloaded by database users*.<sup>237</sup> *Tasini* thus held that making plaintiffs’ works available online infringed their distribution rights and made their Print Publishers liable for “authorizing” these infringements.

The Supreme Court has long directed lower federal courts to treat its alternative holdings as binding precedents even if “the other reason was more dwelt upon... argued and considered...”<sup>238</sup> Nevertheless, *Tasini*’s holding on the distribution right does not explain *why* making plaintiffs’ articles available online infringed their § 106(3) distribution rights. Consequently, this paper analyzes “to authorize” and “to distribute” without relying upon *Tasini*: it is intended to explain the result in *Tasini* by showing why § 106 rights “to authorize” and “to distribute” are infringed when a work is made available over the Internet.<sup>239</sup> Nevertheless, no federal court can ignore any binding Supreme-Court precedent.<sup>240</sup>

### C. The Ordinary Meaning of “To Distribute” Can Encompass Offers to Distribute.

Opponents of a making-available right tend to argue that “to distribute” should have its “ordinary meaning.” They thus argue that when Congress replaced the antecedent exclusive right “to publish” with an exclusive right “to distribute copies... to the public,” the latter term was to be read as one plucked from the dictionary, not as the “to distribute copies... to the public” that had acquired a specialized meaning during the preceding 186 years of U.S. copyright law.

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<sup>235</sup> See *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210 (D. Minn. 2008), *vacated on other grounds*, 692 F.3d 899 (8<sup>th</sup> Cir. 2012); *Atlantic Recording Co. v. Howell*, 554 F. Supp. 2d 976 (D. Ariz. 2008); *but cf. Atlantic Recording Co. v. Howell*, 2008 U.S. Dist. LEXIS 113242 (Aug. 29, 2008) (granting default judgment and striking Defendant’s answer as terminating sanctions for deliberate destruction of evidence).

<sup>236</sup> 533 U.S. 483, 506 (2002). Much of the debate in *Tasini* focused on the interpretation of the “collective works” limitation on copyright protection. See 17 U.S.C. § 201(c). But *Tasini* also held that the defendants had infringed the plaintiffs’ copyrights, see 533 U.S. at 498-506. *Tasini*’s rulings on infringement are thus holdings, not *dicta*. Indeed, at oral argument, the *Tasini* Court focused in particular upon the specific issue of when infringing acts first occurred. See Transcript of Oral Argument at 31-32, *New York Times Co. v. Tasini*, No. 00-201, (March 28, 2001).

<sup>237</sup> See, e.g., Brief for Petitioners at n.34, *New York Times Co. v. Tasini*, No. 00-201 (Jan. 5, 2001). These holdings found the defendants directly—not contributorily—liable for infringement. See *Tasini*, 533 U.S. at 504. They also mean that no precedential value remains in *Brode v. Tax Management, Inc.*, 1990 WL 25691 (N.D. Ill. Feb. 1, 1990) (holding that plaintiff could not show infringement absent evidence that his work “was ever ‘called up’ on LEXIS or ‘printed out’”); *but see*, 4 WILLIAM F. PATRY, PATRY ON COPYRIGHTS § 13:11.50 (2008) (citing *Brode* as a precedent on the making-available-right debate but not *Tasini*).

<sup>238</sup> *Richmond Screw Anchor Co. v. United States*, 275 U.S. 331, 341 (1928).

<sup>239</sup> Those seeking a more detailed analysis of *Tasini* can consult my paper on the subject. See *Thomas and Tasini: Did the Making-Available-Right Debate End before It Began?* (Progress & Freedom Found. 2008).

<sup>240</sup> Compare *Thomas*, 579 F. Supp. 2d at 1222 (ignoring *Tasini*’s holding on infringement of the distribution right because the Court’s “primary” holding related to reproduction), with *id.* at 1223-25 (mistaking *obiter dicta* associated with the second of three alternative holdings for binding precedent).

That seems implausible. But even assuming, *arguendo*, that it were true, nothing would change: were “to distribute” given its “ordinary meaning”—and construed in context—then it would provide a making-available right.

When an undefined statutory is intended to have its “ordinary meaning,” courts usually discern that meaning by analyzing dictionary definitions—and context: “the meaning of statutory language, plain or not, depends on context.”<sup>241</sup> But this “ordinary meaning” may still be materially ambiguous or vague: a term’s dictionary definitions may differ materially, it may have multiple definitions, or its otherwise unambiguous definition may be vague as applied to a particular case or class of cases.

The latter problem—vagueness—affects attempts to rely only on dictionary definitions of “distribute” to resolve the making-available-right debate. Distributing a given copy of a work to the public is usually a multi-step process that ends once possession has been transferred to a member of the public. The central question about an ordinary-meaning-based § 106(3) is whether making copies available to the public, (a step necessary, but antecedent, to a completed transfer of copies to the public), can infringe an exclusive right “to distribute.” Dictionary definitions of “distribute” may not resolve this question.<sup>242</sup> If the distribution of copies to the public is usually a multi-step process, then when is the §106(3) distribution right infringed? Dictionary definitions of “distribute” rarely answer this question definitively.

Nevertheless, most appellate courts confronting this question have held that one “distributes” something by making it available to others. For example, *United States v. Clawson*, “applying the ordinary meaning of the term ‘distribute,’” held that a defendant had distributed child pornography by making it available so a minor could access it.<sup>243</sup> *United States v. Carani* held that a defendant using a file-sharing program had distributed child pornography by “sharing” it with other users: “The notion that [defendant] could knowingly make his child pornography available for others to access and download without this qualifying as ‘distribution’ does not square with the plain meaning of the word.”<sup>244</sup> *United*

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<sup>241</sup> *King v. St. Vincent’s Hospital*, 502 U.S. 215, 212 (1991); see, e.g., *Washington County v. Gunther*, 452 U.S. 161, 169 (1981) (dictionary definitions); 2A NORMAN J. SINGER, J.D. SHAMBIE SINGER, STATUTES AND STATUTORY CONSTRUCTION § 47:27 (7<sup>th</sup> ed. 2007) (same).

<sup>242</sup> See Menell, *supra* note [XREF] at 49 (“the dictionary definition of ‘distribute’ does not communicate a single meaning”).

<sup>243</sup> 408 F.3d 556, 558 (8<sup>th</sup> Cir. 2005). *Thomas* tried to dismiss *Clawson* and other child-pornography cases by arguing that “distribute” may have a specialized, broader meaning under 18 U.S.C. § 2252A. See *Thomas*, 579 F. Supp. 2d at 1218. But *Clawson* found the “ordinary” meaning of distribute sufficient to cover making-available. 408 F.3d 556, 558 (8<sup>th</sup> Cir. 2005).

<sup>244</sup> 492 F.3d 867, 876 (7<sup>th</sup> Cir. 2007); see also *United States v. Sewell*, 513 F.3d 820, 822 (8<sup>th</sup> Cir. 2008) (affirming a finding that a KaZaA user “distributed child pornography by making images of child pornography available to others.”); *United States v. Shaffer*, 472 F.3d 1219, 1223 (10<sup>th</sup> Cir. 2007) (affirming liability for knowing distribution of child pornography based upon the “plain meaning” of “distribute”); *United States v. Caparotta*, 890 F. Supp. 2d 200, 204 (E.D.N.Y. 2012) (“Considering the plain meaning of ‘distribute,’... placing of child pornography in the shared folder accessible to others via a P2P program on the internet constitutes ‘distribution’...”); *United States v. Christy*, 65 M.J. 657 (Army Ct. Crim. App. 2007) (“We hold that ‘sharing’ child pornography files using peer-to-peer file-sharing software constitutes ‘distribution of child pornography...’”); *United States v. McVey*, 476 F. Supp.2d 560, 562 (E.D. Va. 2007) (interpreting distribution to “include acts such as posting material involving the sexual exploitation of a minor on a website for public viewing”); *United States v. Abraham*, 2006 U.S. Dist. LEXIS 81006 at \*19-21 (W.D. Pa. Oct. 24, 2006) (upholding knowing distribution conviction based upon dictionary definitions of “distribute”); *State v. Wenger*, 292 S.W. 191, 198-99 (Tex. Ct. App. 2009) (relying upon the dictionary definition of

*States v. Brummels* held that interpreting “distribution” to encompass all steps in “the process of getting goods from the manufacturer to the consumer... comports with the ordinary, contemporary, common meaning of ‘distribution.’”<sup>245</sup> Unless all of these cases, (and others), were unreasonably and wrongly decided, then the “ordinary meaning” of “distribute” is, at the very least, vague or ambiguous as applied to cases implicating the making-available right.

But even if the ordinary meaning of “to distribute” could be vague in theory, it is not *in context*. As used in the 1976 Act, “to distribute” must have been intended to encompass a making-available right. In practice, “[a]mbiguity is a creature not of definitional possibilities but of statutory context.”<sup>246</sup> In other words, a term that has two meanings is neither ambiguous nor vague if context proves that one of its meanings was inherently implausible.<sup>247</sup> Here, two pieces of context foreclose ordinary-meaning-based interpretations of “to distribute” that would deny a making-available right.

**“To distribute” must be construed in context with the rest of § 106:** No legitimate interpretation of “to distribute” can ignore the rest of the text of § 106.<sup>248</sup> It grants an “exclusive right... to distribute copies” to the public. The term “exclusive right” should foreclose interpretations of “to distribute” that deny a making-available right. The distribution right resulting from such interpretations is a liability rule, not an exclusive right: so construed, it would not exclude me from distributing copies of an author’s work to the public, it would simply let that author sue me *after* the damage was done.

Moreover, “Congress’ use of a verb tense is significant in construing statutes.”<sup>249</sup> The exclusive right of distribution granted in § 106 must be understood in two ways. *First*, it is an exclusive right “to distribute,” and this use of the infinitive mode “is equivalent to ‘in order to’... or ‘for the purpose of’...”<sup>250</sup> *Second*, it is also an exclusive right “to do” distribution to the public, and interpreting “distribution” to encompass all steps in “the process of getting goods from the manufacturer to the consumer... comports with the ordinary, contemporary, common meaning of ‘distribution.’”<sup>251</sup> In either sense, the words used show that the distribution right encompasses steps in the distribution process *preceding* the final transfer that completes it—a point confirmed by the explicit references to publication rights in § 203 and § 407.

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“distribution”); *State v. Perry*, 697 N.E.2d 624, 628 (Ohio 1998) (“Posting software on a bulletin board...is distribution.”).

<sup>245</sup> 15 F.3d 769, 773 (8<sup>th</sup> Cir. 1994).

<sup>246</sup> *Brown v. Gardener*, 513 U.S. 115, 118 (1994) (quoted in *FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 132 (2000)).

<sup>247</sup> For example, in *Deal v. United States*, the Petitioner showed that “the word ‘conviction’ can, according to the dictionary, have two meanings.” 508 U.S. 129, 131 (1993). Nevertheless, the Court held that “conviction,” interpreted in context, was unambiguous: “[A]ll but one of the meanings [of ‘conviction’] is ordinarily eliminated by context.” *Id.* at 131-32.

<sup>248</sup> *But see Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210, 1216-17 (D. Minn. 2008) (concluding that the narrowest definition of “distribute” would not convey a making-available right).

<sup>249</sup> *United States v. Wilson*, 503 U.S. 329, 333 (1992).

<sup>250</sup> *United States v. O’Hara*, 143 F. Supp. 2d 1039, 1041-42 (E.D. Wis. 2001).

<sup>251</sup> *United States v. Brummels*, 15 F.3d 769, 773 (8<sup>th</sup> Cir. 1994).

**The context surrounding the 1976 Act proves that Congress intended the distribution right to encompass a publication right:** Even if a narrow interpretation of “to distribute” in § 106(3) might not be inconsistent with the language of that subsection examined in isolation, statutory text cannot be construed in a vacuum. “[T]he words of a statute must be read in their context, with a view to their place in the overall statutory scheme.”<sup>252</sup> As discussed previously, an interpretation of “to distribute” that does not encompass a making-available right, nullifies multiple substantive provisions of the Copyright Act of 1976.<sup>253</sup>

But such an interpretation generates even more serious problems. The Supreme Court has repeatedly held that a given statute is “the product of a period, and, ‘courts, in construing a statute, may with propriety recur to the history of the times when it was passed.’”<sup>254</sup> When these principles are applied to the interpretation of “to distribute,” it cannot be reasonably interpreted to deny copyright owners the publication/making-available right that they had long enjoyed.

The drafters of the Act could not have intended that result. At least from 1790 to 1978, the United States provided authors with an exclusive right to publish/distribute-to-the-public/make-available copies of their works—and did so even during the many decades in which the United States was a net *importer* of expressive works. So why would the President and Congress—just when the United States had become a world-leading net *exporter* of expressive works—finally enact a copyright law that denied now-successful American authors their previously unquestioned exclusive right “to publish”?

Context then sharpens this question. In the early 1970s, the Executive and Legislative Branches had led the effort to promulgate the *Geneva Phonograms Convention*, which required signatories to protect owners of sound recordings from “any act by which duplicates of a phonogram are offered, directly or indirectly, to the general public or any section thereof.”<sup>255</sup> So why would the Congress and President of the United States—the country that would benefit most from the *Phonograms Convention*—promptly enact a copyright law that violated its central substantive obligation?

These questions show that arguments against interpreting the distribution right to encompass a making-available right—even those that profess the sanctity of “ordinary meaning”—actually attribute to the 1976 Act a truly *extraordinary* meaning: one that confounds history, common sense and the national interest as it would have been understood by the Act’s drafters. Even if *permissible in the abstract*, an ordinary-meaning-based interpretation of “to distribute” that would deny a making-available right is *unreasonable* when the words in the Act are interpreted in context, as the Supreme Court requires.

Indeed, the copious history of the Fourth General Revision and the Copyright Act of 1976 reveals neither intent to deny copyright owners their fundamental right to control the publication of copies of their works nor intent to repudiate the just-ratified Phonograms Convention. As the Supreme Court once noted, such “silence is most eloquent, for such reticence while contemplating an important and

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<sup>252</sup> *Davis v. Michigan Dept. of Treasury*, 489 U.S. 803, 809 (1989).

<sup>253</sup> See, *supra*, n.160 and accompanying text.

<sup>254</sup> *Great Northern Ry. Co. v. United States*, 315 U.S. 262, 273 (1942) (quoting *United States v. Union Pac. R. Co.*, 91 U.S. 72, 79 (1875)).

<sup>255</sup> Art 1(d), 2, Oct. 29, 1971, 25 U.S.T. 309, 866 U.N.T.S. 67.

controversial change in existing law is unlikely.... At the very least, we would expect some hint of a purpose to work such a change, but there was none.”<sup>256</sup>

#### **D. “Deemed Distributed” Presumptions Might Also Provide Something Like a Making-Available Right.**

Some courts and commenters have argued that a deemed-distributed presumption could obviate the need to decide whether the current U.S. Copyright Act provides copyright owners with the making-available rights required by about fifteen international agreements.<sup>257</sup> A “deemed-distributed presumption” would hold that works made readily available to the public over a file-sharing network or the Internet can be presumed to have been distributed to the public unless the defendant proves otherwise.<sup>258</sup> I have three concerns about deemed-distributed presumptions.

*First*, § 106, correctly interpreted, should provide the *exclusive* making-available right required by the international obligations of the United States. By contrast, a rebuttable evidentiary presumption might be held inadequate to implement obligations that expressly require the United States to provide an exclusive right.

*Second*, the 1976 Act was the first U.S. copyright act deliberately framed in technology-neutral terms and expressly intended to be applied by courts even to technologies wholly unanticipated by its drafters. It seems inconsistent with this explicit statutory directive to create evidentiary presumptions to avoid deciding what exclusive rights the Act was intended to confer.

*Third*, while a deemed-distributed presumption might seem like a convenient way to avoid resolving the making-available-right debate, it has no basis in statutory text. It could also raise larger questions. In effect, such a presumption asserts that governments can reasonably presume that any content made available on the Internet has been accessed within their territorial jurisdiction. The long-term consequences of advocating such a presumption are probably not predictable, but they could be significant. The doctrine of judicial restraint may thus counsel federal judges to just decide what exclusive rights our 38-year-old Copyright Act actually granted.

For these reasons, a deemed-distributed presumption seems like a tolerable-at-best means to resolve—or further defer resolution of—the making-available-right debate.

### **CONCLUSION**

In conclusion, a making-available right can be derived from both “to authorize” and “to distribute.” And while these conclusion require some analysis and the careful study of prior U.S. copyright laws, the

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<sup>256</sup> *Edmonds v. Compagnie Generale Transatlantique*, 443 U.S. 256, 266-67 (1979).

<sup>257</sup> See, e.g., Robert Kasunic, *Making Circumstantial Proof of Distribution Available*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1145 (2008).

<sup>258</sup> E.g., *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153, 166-69 (D. Mass. 2008) (concluding that Section 106 does not provide an exclusive making-available right, but relying upon an evidentiary presumption to hold that the plaintiffs adequately pled a distribution); *Arista Records, Inc. v. Mp3Board, Inc.*, 2002 WL 1997918 (S.D.N.Y. 2002) (recognizing a deemed-distributed evidentiary presumption but denying summary judgment because the plaintiffs had not yet provided evidence to show that they were entitled to invoke it).

principles being implemented are simple: if an undefined statutory term had no specialized meaning under prior law, (like “to authorize”), then it was probably meant to have its ordinary meaning; but if an undefined statutory term had a specialized meaning under prior law, (like, “to distribute”), then it was probably meant to retain that meaning. The Copyright Act of 1976 is not, nor was it ever intended to be, the first in U.S. history to violate more than a dozen international agreements by denying copyright owners their indispensable right of publication—their right to distribute copies of their work to the public, which is implicated whenever copies of those works are made available to the public.