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**Re: Comments of Professor Jane C. Ginsburg – Study on the Right of Making Available;
Request for Additional Comments
Docket No. 2014–2**

In response to the U.S. Copyright Office’s July 15, 2014 Federal Register Notice soliciting further comments on the “Right of Making Available,” I submit these additional comments solely on my own behalf as an intellectual property law scholar. I will address the following issues raised in the Notice:

1. To what extent does the Supreme Court’s construction of the right of public performance in *Aereo* affect the scope of the United States’ implementation of the rights of making available and communication to the public?
2. How should courts consider the requirement of volitional conduct when assessing direct liability in the context of interactive transmissions of content over the Internet, especially in the wake of *Aereo*?
3. To what extent do, or should, secondary theories of copyright liability affect the scope of the United States’ implementation of the rights of making available and communication to the public?
4. How does, or should, the language on “material objects” in the Section 101 definitions of “copy” and “phonorecord” interact with the exclusive right of distribution, and/or making available and communication to the public, in the online environment?
5. What evidentiary showing should be required to prove a copyright infringement claim against an individual user or third-party service engaged in unauthorized filesharing? Should evidence that the defendant has placed a copyrighted work in a publicly accessible shared folder be sufficient to prove liability, or should courts require evidence that another party has downloaded a copy of the work? Can the latter showing be made through circumstantial evidence, or evidence that an investigator acting on the plaintiff’s behalf has downloaded a copy of the work?

Analysis

1. To what extent does the Supreme Court’s construction of the right of public performance in *Aereo* affect the scope of the United States’ implementation of the rights of making available and communication to the public?

As set out and developed in my initial Comments of April 7, 2014, the WCT “making available” right applies to the *offering* to the public of on-demand access to a work in the form of a stream or of a download. The WCT text is clear that the right covers the offer of individualized access to works, because it specifies the “making available to the public of [authors’] works in such a way that members of the public *may access* these works from a place *and at a time individually chosen by them*” (emphasis supplied). Because the text does not distinguish between access to digital copies and access to performances, compliance with the WCT requires a member state to cover both kinds of access (streaming and downloading), and to cover not only actual transmissions of streams and downloads, but also the offering to communicate the work as a stream or a download, to members of the public separated both in space and in time. The Supreme Court’s *Aereo* opinion (*ABC v. Aereo*, 134 S. Ct. 2498 (2014)) addresses only the public performance right; to the extent U.S. implementation of the “making available” right involves the right of distribution and offers to download, *Aereo* provides no direct guidance.

In light of the requirements of WCT art. 8, I understand the question posed in the Copyright Office’s point 1 to raise three issues: Whether the Supreme Court’s *Aereo* opinion

A. Has clarified that the communications to the public comprehended within the section 106(4) and (6) public performance rights (and, implicitly, the section 106(5) public display right) may be a-synchronous;

B. Identifies “the public” and “members of the public” consistently with their meaning in WCT art. 8; and

C. Construes the public performance right in a way that encompasses offers to transmit performances or instead limits the right to actual transmissions. With regard to this issue, the latter interpretation would mean that the U.S. does not comply with its international obligations, while the former removes an important impediment to U.S. compliance with international norms.

A. A-synchronicity

The *Aereo* decision clearly establishes that the public performance right extends to a-synchronous transmissions. The U.S. Copyright Act defines “[t]o perform or display a work ‘publicly’” in relevant part as:

by transmitting or otherwise communicating a performance or display of the work . . . to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time *or at different times*.¹

1 17 U.S.C.A. § 101 (West, current through P.L. 113-66) (emphasis supplied).
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The Second Circuit in *Aereo* had understood the “it” in the Transmit Clause to mean the particular transmission communicated to the recipient, and in the case of individualized transmissions, had held that because only one person was “capable of receiving” that transmission, the performance was not “public.” Rejecting this reading, the Supreme Court clarified that the object of the right was the performance of the *work*, not a particular transmission of a performance, and ruled that

[A]n entity may transmit a performance through one or several transmissions, where the performance is of the same work. That is because one can “transmit” or “communicate” something through a *set* of actions. Thus one can transmit a message to one’s friends, irrespective of whether one sends separate identical e-mails to each friend or a single e-mail to all at once. So can an elected official communicate an idea, slogan, or speech to her constituents, regardless of whether she communicates that idea, slogan, or speech during individual phone calls to each constituent or in a public square.

The fact that a singular noun (“a performance”) follows the words “to transmit” does not suggest the contrary. One can sing a song to his family, whether he sings the same song one-on-one or in front of all together. Similarly, one’s colleagues may watch a performance of a particular play--say, this season’s modern-dress version of “Measure for Measure”--whether they do so at separate or at the same showings. By the same principle, an entity may transmit a performance through one or several transmissions, where the performance is of the same work.

The *Transmit Clause must permit this interpretation*, for it provides that one may transmit a performance to the public “whether the members of the public capable of receiving the performance . . . receive it . . . at the same time or at different times.” §101. Were the words “to transmit . . . a performance” limited to a single act of communication, members of the public could not receive the performance communicated “at different times.” Therefore, in light of the purpose and text of the Clause, we conclude that when an entity communicates the same contemporaneously perceptible images and sounds to multiple people, it transmits a performance to them regardless of the number of discrete communications it makes. . . . So whether *Aereo* transmits from the same or separate copies, it performs the same work; it shows the same images and makes audible the same sounds. Therefore, when *Aereo* streams the same television program to multiple subscribers, it “transmit[s] . . . a performance” to all of them.²

To stick with Shakespeare (albeit in paraphrase), the “*work’s* the thing”: not the temporal coincidence of its performances. The Supreme Court therefore has corrected a significant error in the Second Circuit’s construction of the Transmit Clause, an error which, had it persisted, would have placed the U.S. out of compliance with respect to on-demand communications, where transmissions would inevitably occur at different times.

B. “The public”

i. Meaning of “the public” in the Berne Convention and the WCT

² American Broadcasting Cos., Inc. v. *Aereo*, Inc., --- U.S. --- 134 S. Ct. 2498, 2509 (2014) (emphasis in third paragraph supplied).

The Berne Convention and WIPO Copyright Treaty mandate protection for two kinds of public communications of works: performances *in public*, and “communication” of the work *to the public* by transmission. The first kind, covered in Berne Convention articles 11, 11ter, 14 and 14bis, concerns performances in places open to the public; the public is present at these performances and therefore apprehends them directly. The second kind, “communication to the public,” provided-for in the cited Berne Convention articles as well as in Berne Convention art. 11bis and WCT art 8 and WPPT arts. 10 and 14, reaches members of the public through the intermediary of any manner of wired or wireless transmission. Neither Convention defines “the public.” But the concept implies its opposite: some performances or communications by transmission will be “private” in nature. The “private” quality of the performance or communication may be ascertained by the size of the potential audience; if only an insubstantial number of persons have the opportunity to attend the performance in person (public performance) or to receive it via transmission (communication to the public), it follows that the Berne Convention and WCT rights would not be engaged.

It is important to emphasize “potential” audience: a performance in a place open to the public is a public performance, even if an insubstantial number of people in fact attend. Similarly, a transmission offered to the public at large does not become “private” if only a few members of the public in fact receive (or watch or listen to) it.³ The WCT “gives greater indication than does the Berne Convention that the relevant ‘public’ is comprised of ‘members’, and, accordingly, need not be populous, although the greater the numbers to whom a work is made available, the more apparent the conclusion that the making available was to ‘the public’. But simply offering the work on an indiscriminating basis, so that a member of the public may access the work, should come within the scope of the right. Even more restricted offers, such as to all university students, or to all aficionados of obscure Australian or Estonian poetry, appeal to an audience potentially too large for a ‘family circle’ or similar exclusion.”⁴ Put another way, different kinds of works may have different “publics;” the potential audience for a Hollywood action film may be far greater than the potential audience for a European “art” film (in which nothing happens), but both are directed toward persons whose only relationship to the copyright owner and to each other is their predilection for that type of work.

The Berne Convention and the WIPO Treaties leave to member states the precise demarcation of the line between public and private communications. For example, member states may exclude from the scope of the right performances or communications to a “family circle,”⁵ or enlarge the “private” zone to cover not only family but also its “social acquaintance,”⁶ or define “the public” to mean “an indeterminate number of potential recipients [which] implies, moreover, a fairly large number of persons.”⁷ But wherever a member state sets the dividing line, one may infer that the “public” character of a communication turns on the opportunity for a substantial number of unrelated persons to receive the work being communicated.

³ Accord, H.R. Rep. No. 94-1476, at 65 (1976) (an infringer communicates a performance to the public, whether or not the “members of the public capable of receiving” it are “operating [their] receiving apparatus at the time of the transmission”).

⁴ Sam Ricketson & Jane C. Ginsburg, *International Copyright and Neighboring Rights: The Berne Convention and Beyond*, para. 12.58 (2006).

⁵ See, e.g., France Code de la propriété intellectuelle, art. L 122-5(1) («Les représentations privées et gratuites effectuées exclusivement dans un cercle de famille») («private and free performances effectuated exclusively in a family circle»)

⁶ See, e.g., 17 U.S.C. sec. 101.

⁷ ECJ, *ITV Broadcasting Ltd. and Others v. TVCatchup Ltd.*, C-607/11 [2013], para. 32 (elaborating on the meaning of “public” in InfoSoc Directive art. 3(1)).

Commercial benefit furnishes another dividing line between public and private communications: if members of the public are invited to pay to receive the communication, it is unlikely to be private in nature.⁸ But one should beware the negative inference: it does not follow that a not-for-profit communication is therefore not “to the public;” many non commercial performances nonetheless are amply “public.”⁹ Rather, the commercial nature of the performance is a one-way street, furnishing an indicium of the “public” character of the communication, but not concomitantly permitting a characterization of a non commercial communication as not “to the public.”

ii. The meaning of “the public” in *Aereo*

The Supreme Court in *Aereo* elaborated on the meaning of a performance “to the public.” The Court emphasized that “an entity does not transmit to the public if it does not transmit to a substantial number of people outside of a family and its social circle.”¹⁰ The Court distinguished *Aereo*, which it viewed as akin to a traditional cable television retransmission service, from “an entity that transmits a performance to individuals in their capacities as owners or possessors”; such a service “does not perform to ‘the public,’ whereas an entity like *Aereo* that transmits to large numbers of paying subscribers who lack any prior relationship to the works does so perform.”¹¹

The Court’s reference to “owners or possessors” is, at best, very imprecise; the service’s customer is unlikely to be an owner of “the work” because “the work” is the incorporeal object whose “owner” is the author or other copyright owner. Presumably, based on the submissions by the amici, including the United States, the Court was positing the request by a customer of a remote storage service to play back a digital copy that she was entitled, by express or implied license, or under the fair use doctrine, to deposit in a digital storage locker. In that event, even if multiple customers separately stored the same content with the service, the latter’s subsequent on-demand play back of performances of the same work to those customers would not be a transmission to “the public” by the service or the customer: “[T]he term ‘the public’ . . . does not extend to those who act as owners or possessors of the relevant product.”¹² “Product” in this context apparently includes a license to access the stored content. When a digital storage service plays content acquired and stored by customers back to those customers, then, there is no public performance.

However, in addition to the customer’s entitlement of access (which the Court treated as a possessory relationship) to the customer-stored content, the Court introduced a further

⁸ See Ricketson & Ginsburg, para 12.02, suggesting that the “public” character of the performance or communication should be assessed in light of its economic impact: “The dividing line between ‘public’ and ‘private’ is not always easy to draw, and the Convention contains no specific guidance in this regard. However, the following general principle can be derived from a study of the structure of the Convention. Articles 11, 11*bis*, 11*ter*, 14, and 14*bis* deal with certain of the author’s pecuniary rights, that is, some of the ways in which she can exploit her work. Accordingly, the rights of public performance and of communication to the public must refer to the author’s capacity to authorize performances of the work before or communications of the work to a substantial number of unrelated persons. The larger and more disparate the audience, the greater the impact on the author’s ability to exploit the work in relation to her ‘public’, that is, those who are willing to pay for the benefit of hearing or seeing the work performed.”

⁹ See, e.g., 17 U.S.C. sec. 110 (covering a variety of non commercial public performances, and providing exemptions from liability; the exemptions do not put in question the “public” character of the performances, rather they absolve the performing entity from obtaining permission or paying to engage in the public performance).

¹⁰ *Aereo*, 134 S. Ct. at 2511.

¹¹ *Id.*, at 2510.

¹² *Id.*

consideration: “And we have not considered whether the public performance right is infringed when the user of a service pays primarily for something other than the transmission of copyrighted works, such as the remote storage of content.”¹³ The Court appears to be focusing on the nature of the commercial relationship between the customer and the service. Remote storage services are transmitting content to members of the public (their subscribers) when they play back the files requested by the users.¹⁴ Unlike pay (or listen)-on-demand, however, the service for which the members of the public are paying is not the opportunity to receive transmissions of performances of particular works offered by the service, but rather to store whatever content the users post, whatever its source, and make it accessible remotely. The customers pay the same subscription fees whatever the content they store and access. Thus, while there is a public that pays in dollars or in subjection to advertising¹⁵ (or other costs of “free” commercial services), the public is not specifically paying for transmissions of performances of any given copyrighted works.

Whether a service is performing “publicly,” then, appears to turn on the nature of the service for which customers are paying. The service’s customers are certainly members of the public, but the same act by the service – transmitting a performance of a given work – may or may not be a public performance depending on the existence of some kind of possessory relationship between the individual members of the public and a copy of or a license to use the content, and depending on whether the service is primarily offering streaming access to specified copyrighted works.

iii. Consistency with international norms

A reformulation of the Court’s statement that “an entity does not transmit to the public if it does not transmit to a substantial number of people outside of a family and its social circle,”¹⁶ as an affirmative assertion – that an entity that transmits [a performance of a work] to a substantial number of people outside of a family and its social circle is publicly performing the work – seems to conform to international norms. But if the “public” character of a transmission of a performance also depends on the relationship of the customer of the transmission entity to the copyrighted work (owner of a copy; licensee of an access right), is this gloss also consistent with international norms? As discussed above, the treaties permit certain inferences concerning the size and nature of a communication’s potential audience, but do not introduce distinctions based on any possessory relationship of the members of the public to the content of the work. That said, the inquiry into the nature of the service implied by the Court’s attention to the kind of service (storage v. transmission of particular works) for which the members of the public who constitute its customers are paying is not necessarily inconsistent with international norms.

To ask whether the service is offering to transmit performances of particular copyrighted

¹³ *Id.*, at 2511.

¹⁴ Arguably, if the customer is requesting playback of content she selected and stored in “her” cloud locker, the service’s role in the communication might be too passive, limited to the technical relay of the content, to be deemed the party who “performs” the content. See *Aereo*, 134 S.Ct. at 2507 (“In other cases involving different kinds of service or technology providers, a user’s involvement in the operation of the provider’s equipment and selection of the content transmitted may well bear on whether the provider performs within the meaning of the Act.”). See also *infra* these comments at point 2 (discussing “volition”).

¹⁵ The analysis would be different, however, if the service targeted advertising to the played-back content. At that point, the “commercial relationship” between the service and the consumer would focus on particular works; the service would have foregone the content-neutrality that justifies a conclusion that the service is not publicly performing the played-back works.

¹⁶ *Aereo*, 134 S. Ct. at 2511.

works to members of the public, or whether these transmissions instead are ancillary to some other service (storage) that does not trigger the right of communication to the public (though it may implicate the right of reproduction), is to focus on the economic dimension of the communication. The above-cited articles of the Berne Convention and the WCT all concern exploitations of the work; they confer on the author the exclusive rights to authorize various kinds of exploitations (or, in the case of art. 11bis(2), the right to be remunerated for certain retransmissions). It may follow that “the public” should correspond to “the group which the copyright owner would otherwise contemplate as its public for the performance of its work.”¹⁷ Arguably, the essence of a performance “to the public” is that it is occurring in circumstances where the owner is entitled to expect payment for the work’s authorized performance because the performing entity is exploiting the work.¹⁸ In *Aereo*, the Court’s emphasis on the resemblance between *Aereo*’s retransmission service and a traditional cable television retransmission service reflects a determination that if the Copyright Act entitles broadcasters to payment for cable retransmission, then broadcasters are also entitled to payment for cable-like retransmissions. By contrast, copyright owners are not entitled to expect payment when members of the public view legitimately-acquired copies of films at home; arguably it should make no difference whether the home-viewed copy is stored at home, or stored remotely.

Thus, the Court’s focus on a possessory relationship between the member of the public and the source copy for the transmission enjoys some support as a matter of construction of the right of communication to the public in the Berne Convention and WIPO Copyright Treaties. Nonetheless, the analysis is problematic because it appears to make the public character of a work turn on a prior analysis of infringement: if the author is entitled to control the exploitation, then a third party’s exploitation is “to the public,” but if the author is not entitled to expect payment, then the communication is not to the public. As a result, the question of the *prima facie* application of exclusive rights may become improperly conflated with the question of copyright exceptions. But as section 110 of the Copyright Act demonstrates, a communication, for example in the course of online education, may be a “public performance” yet be subject to a narrow exemption from liability. For example, if the TEACH Act exceptions in section 110(2) apply, the copyright holder is not entitled to expect payment, but there is no question that the transmissions are to (a defined segment of) the public. *Aereo* itself did not invite this confusion of the public character of a performance with liability for infringement, but if one is to understand the Court’s attention to the nature of the service as implying a distinction between uses that the copyright owner may control (because, for want of a better term, they “feel” like they belong in the public performance camp) and uses that the copyright owner may not (because they “feel” like acts transpiring in private), then it becomes important to bear in mind that a communication can be “to the public” even if, by virtue of an exception, it falls outside the copyright owner’s rights.

C. Actual transmissions or offers to transmit

The *Aereo* opinion construes the Transmit Clause component of the definition of “to perform publicly” in a way which often appears to assume that actual transmissions have occurred (as was the case with the *Aereo* service). It does not, however, therefore follow that the Court has excluded offers to transmit from the scope of the statutory exclusive right. First, while the Court

¹⁷ *Telstra Corp. v Australasian Performing Right Ass’n* (1997) 191 CLR 140, 199. See also Ricketson & Ginsburg, *supra*, para 12.02.

¹⁸ See, e.g., *Telstra Corp. v Australasian Performing Right Ass’n* (1997) 191 CLR 140, 198-99. This characterization, however, runs the risk of circularity.

emphasized that “an entity does not transmit to the public if it does not transmit to a substantial number of people outside of a family and its social circle,”¹⁹ it elsewhere equated Aereo’s offering of its service to an infringement of the public performance right. Hence: “We must decide whether respondent Aereo, Inc., infringes this exclusive right [of public performance] by selling its subscribers a technologically complex service that allows them to watch television programs over the Internet at about the same time as the programs are broadcast over the air. We conclude that it does.”²⁰ What triggers the infringement is the “selling” of a service that “allows” subscribers to view the programs; the court does not require that a subscriber consummate the infringement by viewing an actual transmission.

Second, as the following analysis shows, the Court’s statements make sense only if the scope of the right includes offers to transmit performances of works. If one disregards the Court’s characterization of the infringement as occurring “by selling” a service that “allows” its subscribers to view live television, and instead takes literally the Court’s statement that “an entity does not transmit to the public if it does not transmit . . .”, it would follow there is no transmission to “the public” if the service does not in fact communicate the performance of the work to a substantial number of people. But therefore to characterize the communication as “private” is questionable: if performances of a work are offered to the public, for example, on a pay-per-view basis, the characterization of the performances as “to the public” should not turn on how many members of the public accept the offer and in fact request a transmission of the performance. If one were to understand the Court’s statement as meaning actual, rather than offered, transmissions, then the “public” nature of a performance could not be ascertained without post-hoc head-counting. Not only does such an interpretation introduce uncertainty for copyright owners and exploiters alike, but it promotes the kinds of baroque copyright-avoiding business models the Court discredited. Given the Copyright Act’s inclusion in the public performance right of discrete transmissions to the public that are separated in time, were only actual transmissions to trigger the public performance right, then the service might be permitted to make an “insubstantial” number of transmissions to paying subscribers before the number of transmissions tipped over into communicating the performance of the work to a “substantial” number of unrelated persons. If the service is in effect allowed up to, say, fifty “free” transmissions, then one might imagine the creation of a plethora of separately constituted subsidiary services each catering to no more than fifty members of the public. But if such a scenario seems unlikely to “fool” any trial judge as to the nature of the service, that is because we sense that a judge, aware of the Supreme Court’s rejection of Aereo’s attempt to render “private” the communications Aereo offered to the public at large, would focus on the offer to transmit, rather than on the actual communication of a transmission.

Moreover, although the Court conflated the two kinds of “public” in the statutory definition of “to perform publicly” – performance *in* public (where a substantial number of persons other than a circle of family and its social acquaintance is gathered); performance by transmission *to* the public – the Transmit Clause does not in fact require that the “members of the public” capable of receiving the transmission of the performance be numerous. Indeed, what matters, in determining whether the audience for a transmission is “the public,” is *capacity* by “members of the public” to receive the transmission, not actual receipt.²¹ Those who are “capable of receiving” the

¹⁹ *Aereo*, 134 S.Ct. at 2511.

²⁰ *Id.* at 2503. Similarly, *id.* at 2504: “Considered alone, the language of the Act does not clearly indicate when an entity “perform[s]” (or “transmit[s]”) and when it merely supplies equipment that allows others to do so. But when read in light of its purpose, the Act is unmistakable: An entity that engages in activities like Aereo’s performs.” Those activities include not only transmitting the content, but offering the service to subscribers.

²¹ As discussed above, “the public” could be the public at large, or smaller subsets, such as the fans of a particular

performance by transmission are those to whom the transmission is offered. Under this reading, the offer of streaming access triggers the public performance right; it is not necessary to await actual transmission, even to one member of the public, to ascertain if the right has been engaged.

2. How should courts consider the requirement of volitional conduct when assessing direct liability in the context of interactive transmissions of content over the Internet, especially in the wake of *Aereo*?

A. “Volition” and the public performance right

The *Aereo* majority’s silence on the matter of “volition” in the face of the dissenters’ emphatic interpolation of a “volition” predicate might suggest that the majority considers “volition” irrelevant to the assessment of whether the defendant has publicly performed a work. The majority’s analysis of whether *Aereo* “perform[s] at all”²² distinguishes between the mere provision of equipment and “engag[ing] in activities like *Aereo*’s.”²³ The majority underscored Congress’ rejection in the 1976 Act of the Court’s *Fortnightly* and *Teleprompter* precedents, in which the Court had held that traditional cable television retransmission services were merely providing equipment that the customers might themselves have installed (given the Court’s rather fanciful evocation of the customers’ acts), and not “performing” the works that the services retransmitted to their customers. According to *Aereo*, a service “performs” copyrighted works, rather than simply supplying equipment, when it “uses its own equipment, housed in a centralized warehouse, outside of its users’ homes,” to transmit performances of works to viewers, even when that equipment “may . . . emulate equipment a viewer could use at home.”²⁴ The majority therefore appears to stress the service’s active engagement in the transmission, rather than any specific “volition” with respect to the particular content transmitted, or with respect to the decision to commence any particular transmission. The end user may be choosing what copyrighted work to view or hear, and when and where to receive it, but the entity that offers the user those choices is “performing” the works, even when it merely responds automatically to the end-user’s choice.

Indeed, the majority’s rejection of the dissent’s characterization of *Aereo*’s service as “a copy shop that provides its patrons with a library card,”²⁵ underscores the irrelevance of the customer’s selection of which programming to watch to the determination of whether the service has “performed” the works it transmits. The court also declined to attribute any significance to the additional layer of consumer intervention involved in *Aereo*’s system relative to cable systems: while cable systems retransmit *sua sponte*, *Aereo* does not activate the subscriber’s antenna without the subscriber’s request. Adopting a pragmatic perspective, the Court announced that “this difference means nothing to the subscriber. It means nothing to the broadcaster.”²⁶

Nonetheless, the Court did not completely discount the role of the user in the determination of “who performs” a work: “a user’s involvement in the operation of the provider’s equipment and

performer, or devotees of cooking shows; what matters is that the potential audience be otherwise unrelated to the copyright owner or to each other.

²² *Id.* at 2504 (internal quotation marks omitted).

²³ *Id.*

²⁴ *Id.* at 2507.

²⁵ *Id.*, citing dissenting opinion, 134 S. Ct. at 2514. The dissent’s analogy, and its purported distinction from pay-per-view services (which the dissent acknowledges do “perform” the user-selected works, *id.* at 2513-14) is in any event highly problematic. The key distinction, for the dissent, is that video on demand services “choose the content” (*id.* at 2513, emphasis in original). But libraries choose the books that comprise their collections.

²⁶ *Id.* at 2507.

selection of the content transmitted may well bear on whether the provider performs within the meaning of the Act.”²⁷ This statement is a far cry from adopting the kind of “volition” predicate urged by the dissent (or, for that matter, by the Second Circuit in *Cablevision*), but it nonetheless suggests that when the service is less “cable-like” than *Aereo*, the majority’s distinction between providing the equipment that enables a performance, and actually “performing” remains uncertain.

In any event, it should be clear, even under the dissent’s characterization, that specific “volition” as to the transmission of particular content is not required for the communication to be considered a “public performance.” All Justices agree that video on demand services are “performing,” and it should not matter how automated the process: once the service assembles the selection of the programs from which the consumer may choose and then offers them commercially to the public, the service has gone beyond merely providing transmission facilities. For the majority, cable and cable-like services still “perform” even though they did not originate the selection of programming offered to the users (the broadcasters did, though the cable operators select the source broadcast stations whose content they retransmit), and even though the users ultimately choose which programs to watch, by turning a knob on the television, or clicking on a website. (Of course, the last feature of user involvement is common to on-demand transmissions, too.) If on-demand services occupy one end of the “who performs” continuum, and cable-like services stand at an intermediate – but still “performing” – point, some services that offer remote storage (but are entirely agnostic as to the content users store) might be located at the other end.

B. “Volition” and the reproduction right

There is another reason to interpret *Aereo* as blunting the pertinence of a “volition” prerequisite to copyright-triggering acts. While *Aereo* addressed only the public performance right, the “volition” analysis, as derived from the Second Circuit’s *Cablevision* decision, threatens significantly to curtail the effectiveness of the reproduction right as well. Indeed, if one reads *Aereo* to have no purchase on the reproduction right, the opportunities for eluding that decision’s import are readily apparent. Suppose that instead of retransmitting programming in approximately real time, an *Aereo*-like service, responding automatically to user demand, recorded the entirety of a broadcast program and then transmitted the file to the user to be viewed or heard only following (and not simultaneously with) the download of the file. *Aereo* specified that “to transmit a performance of (at least) an audiovisual work means to communicate contemporaneously visible images and contemporaneously audible sounds of the work.”²⁸ And the Court cited with approval the Second Circuit decision that declined to characterize a transmission in the nature of a download as a “performance.”²⁹

In this scenario, there is no public performance, because the service is not transmitting a performance, it is distributing a copy. (In a more elaborate version of the scenario, the service would record and transmit the programming in 10-minute increments, so that the user can watch the program only 10 minutes after “real time.”) Except that, if the *Cablevision* “volition” predicate pertains, the copyright-implicating actor would not be the service, it would be the user. (On-demand services that deliver non contemporaneously perceptible files which the users choose from among a collection of works assembled by the service presumably should satisfy any “volition” requirement on the part of the service with respect to the reproduction and distribution rights.) The

²⁷ *Id.*

²⁸ *Id.* at 2508.

²⁹ *US v ASCAP*, 627 F.3d 64, 73 (2d Cir. 2010).

Aereo court declined to project the effect of its decision on remote time-shifting services,³⁰ but one may query whether the posited service is offering “time-shifting” (which may or may not be a public performance) or another Rube Goldberg-like work-around the public performance right.

C. Volition and other iterations of the reproduction and public performance rights: Does an RS-DVR service make works available within the meaning of the WIPO Copyright Treaties?

Aereo avoided ruling on whether RS-DVR services were “publicly performing” the works they retransmitted, but the question remains whether the *Cablevision* precedent, if its volition analysis is in any respect still good law, places the U.S. in tension with its obligation to implement the making available right. If the activities of services like *Cablevision* and *Aereo* (in its time-shifting incarnation) are considered to make available the content of the copied and retransmitted works within the meaning of the WIPO Treaties, then the U.S. should not (for non-US works) be free to exclude those services from the reach of the public performance and reproduction rights. RS-DVR services, through a two-step process of transmission on demand, arguably engage in two series of acts covered by the making available right, first by communicating a copy of the work to the user’s storage device, and subsequently by transmitting it to the user for contemporaneous viewing.

Several foreign authorities interpreting national or EU norms, have ruled that the services “make” the copies (thus violating the reproduction right)³¹ and/or make the works available to their subscribers.³² The EU Information Society Directive has implemented the WIPO Treaties’ making available right verbatim, see art. 3; EU judicial and administrative interpretations and the interpretations of member state courts therefore are probative of the application of the making available right to RS-DVR services, but cannot yet be said to constitute controlling “state practice” within the meaning of art. 31(3)(b) of the Vienna Convention on the Law of Treaties.

The WIPO Treaties may therefore allow member states some leeway in determining who is the “maker” of a copy, or the “performer” of a work; a “volition” predicate may not always be inconsistent with the U.S.’ international obligations. Conformity with international norms may depend on the degree of specificity of any “volition” requirement. For example, while a *Cablevision*-style volition predicate that requires specific agency as to each work transmitted may effectively eviscerate the making available right, a volition predicate that looked to the operation and economic impact of the service as a whole might not violate the U.S.’ obligations.

30 134 S. Ct. at 2511.

31 See, e.g., *Singtel Optus v National Rugby League Investments (No 2)* [2012] FCA 34 (Aus.); *Wizzgo v. Metropole Television et autres*, Paris Court of Appeals, decision of 14 December 2011, http://www.legalis.net/spip.php?page=jurisprudence-decision&id_article=3297 (France) (automated “remote video recorder” service qualifies neither for transient copying nor for private copying exceptions because service, not the end-user, is the maker of the user’s individual copy); *Rokuraku II* (Supreme Court 2011) (Japan) (copies for individualized storage at subscriber request held to be “made” by the service), the decision is discussed in Takashi B. Yamamoto, ‘Legal Liability for Indirect Infringement of Copyright in Japan’ <http://www.itlaw.jp/yearbook35.pdf>. *Contra*, *Record TV Pte Ltd v MediaCorp TV Singapore Pte Ltd* [2011] 1 SLR 830 (Singapore) (following *Cablevision*).

32 Tribunale Amministrativo Regionale, Lazio Roma, sez. II, 02.3.2012, n. 2157, pp. 41-44 (Italy) (remote DVR makes works available under the meaning of the 2001 EU Information Society Directive). See also *Shift.tv*, BGH (German Supreme Court), I ZT 152/11, 11 April 2013 (remote DVR service’s transmission of original signal to subscribers’ individual storage boxes violates broadcasters’ retransmission right); *ManekiTV* (Supreme Court 2011) (Japan), in Yamamoto, *supra* (personalized transmissions by service held public transmissions).

The *Aereo* decision's reference to a possessory relationship between the user and a copy of the work as a basis for distinguishing remote storage (and perhaps RS-DVR) services offers another means to reconcile an absence of copyright liability with international norms. If the user was lawfully entitled to store a copy on the service's facilities (and the service did not initially offer the content to the user), then the service's retransmission of a performance of the work from that copy might be deemed to come within the Agreed Statement to WCT art. 8's exclusion on the ground that "the mere provision of physical facilities for enabling or making a communication does not in itself amount to communication."

3. To what extent do, or should, secondary theories of copyright liability affect the scope of the United States' implementation of the rights of making available and communication to the public?

Arguably, the U.S. could remain in compliance with its international obligations even were services such as *Aereo* or *Cablevision* not deemed directly to infringe the public performance or reproduction rights, so long as these services were fully and consistently subject to secondary liability. In theory, the threat of secondary liability would drive the services to take licenses from the copyright owners, and the making available right thus would be respected. But relying on secondary liability to fill the gaps in U.S. implementation is problematic, yielding at best uncertain results. Secondary liability requires a showing of primary infringement, and it is not clear that the end-user's acts, whatever their degree of facilitation or inducement by the service, will violate U.S. copyright law. With respect to the public performance right, if the transmission to the end user is "performed" by the end user, rather than by the service, there can be no basis for secondary liability because the user's transmission to herself is not "to the public" and therefore does not infringe. With respect to the reproduction right, if the "maker" of the copy is the end-user, the copy might be deemed a fair use. Even if the user-"made" copy would have been considered infringing under U.S. law, U.S. law might not apply to the making of a copy stored on a server outside the U.S. Under the Ninth Circuit's decision in *Subafilms, Ltd. v. MGM-Pathe Commc'ns Co.*,³³ unauthorized acts occurring outside the U.S. do not infringe U.S. copyright law. Thus, a service might evade the application of U.S. law (at least respecting the reproduction right) by providing extraterritorial storage facilities.

4. How does, or should, the language on "material objects" in the Section 101 definitions of "copy" and "phonorecord" interact with the exclusive right of distribution, and/or making available and communication to the public, in the online environment?

Were one starting afresh, it might make more sense to limit the distribution right to physical objects, as does the WCT art. 6 and Agreed Statement ("the expressions 'copies' and 'original and copies,' being subject to the right of distribution . . . under the said Article[], refer exclusively to fixed copies that can be put into circulation as tangible objects"), and the EU Information Society Directive, art. 4 and recital 28 ("exclusive right to control distribution of the work incorporated in a tangible article"). Communication of digital iterations of works, whether in the form of downloads or of streams, could come within an express right of communication and making available to the public. But the current positive law in the U.S. assigns the dissemination of downloads to the distribution right (see discussion in my April 7, 2014 Comments, pp. 3-5), and the "umbrella solution" devised at the 1996 WIPO Diplomatic Conference was designed to

³³ 24 F.3d 1088 (9th Cir. 1994).

accommodate U.S. law.³⁴

Unless Congress thoroughly revisits the distribution and public performance rights, the statutory right “to distribute copies or phonorecords of the copyrighted work” must include the act of causing copies to be made in “material objects” including hard drives and servers,³⁵ lest there be a gap in the rights comprising the U.S. implementation of the making available right. As Judge Gertner concluded, “while the statute requires that distribution be of ‘material objects,’ there is no reason to limit ‘distribution’ to processes in which a material object exists throughout the entire transaction -- as opposed to a transaction in which a material object is created elsewhere at its finish.”³⁶ An interpretation of Section 106(3) that required that the work be incorporated in a material object throughout the process of distribution would leave a gap because the remaining spokes of the “umbrella solution” – the public performance right – require a “performance,” i.e., a contemporaneously viewable or audible dissemination (as the Supreme Court reaffirmed in *Aereo*). Thus, the delivery of a digital file that could not be viewed or heard simultaneously with its communication would not be covered under section 106(4); if it is not covered under section 106(3) either, then U.S. coverage of the making available right would be manifestly incomplete.

5. What evidentiary showing should be required to prove a copyright infringement claim against an individual user or third-party service engaged in unauthorized filesharing? Should evidence that the defendant has placed a copyrighted work in a publicly accessible shared folder be sufficient to prove liability, or should courts require evidence that another party has downloaded a copy of the work? Can the latter showing be made through circumstantial evidence, or evidence that an investigator acting on the plaintiff’s behalf has downloaded a copy of the work?

For the reasons set out in the responses to Points 1 and 4, as well as in my April 7, 2014 comments, if the U.S. is to rely on the distribution right to complete its implementation of the international “making available” norm, then the distribution right must be interpreted to encompass not only actual distributions but also offers to distribute copies. Proof of an offer to distribute, whether by means of a website (whether the work is downloadable directly from the website or by means of targeted links supplied by the website), or of placement of a digital file of copyrighted work in a publicly accessible shared folder, should suffice to establish a violation of the distributing right because the work has been made available to the public. As a result, neither circumstantial evidence allowing an inference of actual distribution, nor downloads by a private investigator should be necessary to establish a violation of the right.

Respectfully submitted,



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³⁴ For extensive discussion of the “umbrella solution,” by the coiner of the term, see; Mihaly Ficsor, *The Law of Copyright and the Internet* (Oxford 2002) at 204-09, 496-509.

³⁵ See analysis of Judge Gertner in *London-Sire Records v. Does*, 542 F. Supp. 2d 153, 169-75 (D.Mass. 2008).

³⁶ *Id.* at 173.