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1984 AND BEYOND: TWO DECADES OF COPYRIGHT LAW

Tyler T. Ochoa†

During the past two decades, engineers, authors, publishers, consumers, lawyers and academics have witnessed extraordinary developments in the technological landscape, often leading to equally dramatic developments in the law of copyright. Many of these developments have been chronicled (or foreshadowed) in the pages of the Santa Clara Computer and High Technology Law Journal.¹ To celebrate the Journal's 20th Anniversary,² this essay will place a number of articles which have appeared in the Journal in their historical context by taking a look back on how the law of copyright has changed during the past twenty years.

I. COPYRIGHT IN THE SUPREME COURT

In 1984, the Supreme Court issued its first written opinion in a case involving fair use;³ and it came in response to a new technological development: the manufacture and sale of home

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1. For example, the Journal's first issue featured an article on copyright law. See Colin Tapper, *Copyright in Computer Programs: An International Perspective*, 1 SANTA CLARA COMPUTER & HIGH TECH. L.J. 13 (1985). In addition, Volume 20 will be featuring a symposium devoted to copyright issues.

2. Technically, the Journal did not publish its first issue until 1985. However, the Journal was founded during the fall semester in 1984, and 2004 marks the completion of the 20th volume of the Journal. (Initially, both issues in each volume were published during the same calendar year; in recent years, however, the two issues have been published in the same academic year but in different calendar years. The transition was made in 1999, which saw the publication of both issues of Volume 15 and the first issue of Volume 16.) As the editors have chosen to celebrate the 20th Anniversary in 2004, I will use the year 1984 as my point of reference, both as a convenient dividing line in the history of copyright and for its Orwellian symbolic value.

3. Two previous efforts ended in affirmances by an equally divided Court. See *Benny v. Loew's, Inc.*, 239 F.2d 532 (9th Cir. 1956) (holding that parody was "no defense" to copyright infringement), *aff'd by an equally divided Court sub nom.* *Columbia Broad. Sys. v. Loew's, Inc.*, 356 U.S. 43 (1958); *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (Ct. Cl. 1973) (holding that photocopying and distribution of journal articles to patrons on request by government libraries was a fair use), *aff'd by an equally divided Court*, 420 U.S. 376 (1975).

videotape recorders. In *Sony Corp. of America v. Universal City Studios, Inc.*,⁴ a 5-4 majority of the Court held that unauthorized home videotaping of broadcast movies for time-shifting purposes was a fair use,⁵ and also held that a manufacturer of recording equipment that was “capable of substantial noninfringing uses” could not be held liable for infringement by individual users.⁶ The following year, in *Harper & Row, Publishers, Inc. v. Nation Enterprises*,⁷ the Court held 6-3 that unauthorized publication of excerpts from former President Gerald Ford’s memoirs two weeks before its publication in book form was not a fair use.⁸ Neither case presented a typical fair use situation, and many commentators criticized the reasoning of both decisions.⁹

A decade later, in *Campbell v. Acuff-Rose Music, Inc.*,¹⁰ the Court surprised observers by holding unanimously that 2 Live Crew’s raunchy rap parody of the popular song “Pretty Woman” could qualify as a fair use.¹¹ The Court established a new standard of “transformative use” to be used in assessing the first fair use factor¹² (“Purpose and Character of the Use”¹³), and it disavowed *Sony*’s dictum that “every commercial use of copyrighted material is presumptively . . . unfair.”¹⁴ *Campbell* has been characterized as “rescuing” fair use from the uncertainty engendered by *Sony* and

4. 464 U.S. 417 (1984).

5. *Id.* at 447-55.

6. *Id.* at 434-42. This portion of the Supreme Court’s opinion in *Sony* shaped the entire development of third-party liability for infringement during the next two decades. *See infra* notes 75-79 and accompanying text.

7. 471 U.S. 539 (1985).

8. *Id.* at 549-69.

9. *See, e.g.*, L. Ray Patterson, *Free Speech, Copyright, and Fair Use*, 40 VAND. L. REV. 1, 65 (1987) (“*Sony* and *Harper & Row* are more sound in their results than in their reasoning.”); Lloyd L. Weinreb, *Fair’s Fair: A Comment on the Fair Use Doctrine*, 103 HARV. L. REV. 1137, 1138 (1990) (“The Court’s error in both [*Sony* and *Harper & Row*] was its effort to justify its decision by principles that, removed from the specific factual context, make no sense.”); *see also* William W. Fisher III, *Reconstructing the Fair Use Doctrine*, 101 HARV. L. REV. 1659, 1668-86 (1988); Jessica D. Litman, *Copyright, Compromise and Legislative History*, 72 CORNELL L. REV. 857, 896-99 (1987).

10. 510 U.S. 569 (1994).

11. For an extensive analysis of the history and legal treatment of parody and satire, including a discussion of the *Campbell* case, see Tyler T. Ochoa, *Dr. Seuss, the Juice and Fair Use: How the Grinch Silenced a Parody*, 45 J. COPYRIGHT SOC’Y U.S.A. 546 (1998). *See also* Lisan Hung, Note, *The Supreme Court Holds That Parody May Be a Fair Use Under Section 107 of the 1976 Copyright Act*, 10 SANTA CLARA COMPUTER & HIGH TECH. L.J. 507 (1994).

12. *Campbell*, 510 U.S. at 578-79.

13. 17 U.S.C. § 107(1)(2000).

14. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984); *see also Campbell*, 510 U.S. at 583-85.

Harper & Row.¹⁵ While some lower courts have had difficulty applying *Campbell*'s more liberal approach to parody,¹⁶ others have relied on *Campbell* to permit both humorous parody¹⁷ and satirical social criticism.¹⁸

In another landmark decision, the Court unanimously held in *Feist Publications, Inc. v. Rural Telephone Service Co.*¹⁹ that the telephone white pages were uncopyrightable. The Court held that "originality" was a Constitutional requirement;²⁰ that facts were not copyrightable because they were discovered rather than created, and were therefore not "original" to the author;²¹ that a compilation of facts was copyrightable only if it featured an original selection and arrangement of facts;²² and that the "sweat of the brow" doctrine, which postulated that copyright was a reward for the time, labor and money invested in compiling a work, was not a valid basis for copyright protection.²³ While *Feist*'s rejection of "sweat of the brow" did not eliminate copyright for computer databases,²⁴ it narrowed the scope of copyright in such works to such an extent that other means

15. See Pierre N. Leval, *Campbell v. Acuff-Rose: Justice Souter's Rescue of Fair Use*, 13 CARDOZO ARTS & ENT. L.J. 19 (1994); see also Lloyd L. Weinreb, *Fair Use*, 67 FORDHAM L. REV. 1291, 1292 (1999) (*Campbell* "restored" the status quo after the "disastrous" decisions in *Sony* and *Harper & Row*).

16. See *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997) (holding that *The Cat NOT in the Hat!*, a satire of the O.J. Simpson trial written and illustrated in the style of Dr. Seuss, was not a parody and was not a fair use). For criticism of the *Dr. Seuss* decision, see Ochoa, *supra* note 11, at 585-620.

17. See *Leibovitz v. Paramount Pictures, Inc.*, 137 F.3d 109 (2nd Cir. 1998) (holding that movie poster for *The Naked Gun 33-1/3: The Final Insult*, in which head of actor Leslie Nielsen was superimposed onto body of nude, pregnant woman, was a parody of plaintiff's photo of Demi Moore on cover of *Vanity Fair* and was a fair use).

18. See *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257 (11th Cir. 2001) (holding that *The Wind Done Gone*, a critical retelling of Margaret Mitchell's *Gone With the Wind* from the point of view of a mulatto half-sister of Scarlett O'Hara, used parody to criticize racial stereotypes in the original and was a fair use).

19. 499 U.S. 340 (1991).

20. *Id.* at 346.

21. *Id.* at 347-48.

22. *Id.* at 356-59.

23. See *id.* at 352-54, 359-61.

24. See Gerard J. Lewis, Jr., *Copyright Protection for Purely Factual Compilations Under Feist Publications, Inc. v. Rural Telephone Service Co.: How Does Feist Protect Electronic Data Bases of Facts?*, 8 SANTA CLARA COMPUTER & HIGH TECH. L.J. 169 (1992).

Feist also may affect whether original typeface designs are subject to copyright protection. For an extensive analysis, see Terrence J. Carroll, *Protection for Typeface Designs: A Copyright Proposal*, 10 SANTA CLARA COMPUTER & HIGH TECH. L.J. 139 (1994).

of protection, such as shrinkwrap and click-on licensing, became more attractive alternatives.²⁵

In 2003, the Court disappointed public domain advocates²⁶ by holding in *Eldred v. Ashcroft*²⁷ that Congress did not violate the “limited times” restriction of the Copyright Clause or the First Amendment in extending all existing and future copyrights by 20 years.²⁸ Although *Eldred* did not succeed in rolling back copyright terms, it did foster a movement to recognize the importance of the public domain,²⁹ a movement that has been compared to the nascent environmental movement in the 1950s.³⁰ As a result, some have expressed the hope that public opinion may make it more difficult for Congress to enact similar extensions in the future.³¹

25. See, e.g., *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447 (7th Cir. 1996) (holding that shrinkwrap license accompanying database on CD-ROM is enforceable and was not preempted by the Copyright Act). For a contrary view, see Mark A. Lemley, *Intellectual Property and Shrinkwrap Licenses*, 68 S. CAL. L. REV. 1239 (1995).

26. I place myself in this category. See Tyler T. Ochoa, *Patent and Copyright Term Extension and the Constitution: A Historical Perspective*, 49 J. COPYRIGHT SOC’Y U.S.A. 19 (2001); Tyler T. Ochoa & Mark Rose, *The Anti-Monopoly Origins of the Patent and Copyright Clause*, 49 J. COPYRIGHT SOC’Y U.S.A. 675 (2002).

27. 537 U.S. 186 (2003).

28. *Id.* at 199-208. Dissenting, Justice Stevens found the majority opinion inconsistent with the history and theory of U.S. copyright law, *id.* at 223-40, while Justice Breyer demonstrated that the present value of an extended copyright is now virtually equivalent to that of a perpetual copyright, *id.* at 253-57.

The Court’s holding in *Eldred* was mitigated somewhat by the subsequent unanimous ruling in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S. Ct. 2041 (2003), which held that the Lanham Act could not be used to hinder the distribution of a formerly copyrighted work that had entered the public domain by requiring attribution to the former copyright owner. For background on the case, see Tyler T. Ochoa, *Introduction: Rights of Attribution, Section 43(a) of the Lanham Act, and the Copyright Public Domain*, 24 WHITTIER L. REV. 911 (2003) and Tyler T. Ochoa, *Brief Amici Curiae of Intellectual Property Law Professors in Support of Petitioner*, 24 WHITTIER L. REV. 931 (2003).

29. See Symposium, Panel II: *Mickey Mice? Potential Ramifications of Eldred v. Ashcroft*, 13 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 771, 795-96 (2003) (remarks of Wendy Seltzer) (“[T]he *Eldred* case is important because it helped to catalyze a movement, a movement that builds upon . . . the ideas of James Boyle and environmentalism for the Net.”).

30. See James Boyle, *A Politics of Intellectual Property: Environmentalism for the Net?*, 47 DUKE L.J. 87, 108-112 (1997); Seth Shulman, *Intellectual-Property Ecology*, TECH. REV., March 2002, at 87; see also Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215, 260 & n.299 (2003).

31. See Symposium, *supra* note 29, at 792 (remarks of Wendy Seltzer) (“[W]hat I see as an immediate ramification of the *Eldred* case is that [it] will not happen again. Now we have a public watching what is happening in the copyright arena, [a] public concerned about the expansion of copyright and the trend toward copyright as property and as control, and a public that will be fighting these battles beyond *Eldred*.”).

In its other opinions in the past two decades, the Court has issued major pronouncements on ownership of copyrighted works,³² on the renewal and termination provisions,³³ on importation of gray market goods,³⁴ and on remedies for infringement.³⁵

II. COPYRIGHT AND COMPUTER SOFTWARE³⁶

One year after enactment of the Copyright Act of 1976, the first highly successful mass-produced personal computer, the Apple II, was introduced.³⁷ It was followed by the IBM Personal Computer in 1981,³⁸ and the Apple Macintosh in 1984.³⁹ By 1984, courts had

32. See *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (Section 201(c) did not give newspaper publishers privilege to include individual articles in electronic database without the permission of individual authors); *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989) (construing “work made for hire” provisions of Copyright Act of 1976). See also Colby B. Springer, Note, *Ownership of Electronic Publishing Rights in Collective Works*: *New York Times Co. v. Tasini*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 341 (2002). For a comparative law perspective on the *Tasini* case, see Giuseppina D’Agostino, *Copyright Treatment of Freelance Work in the Digital Era*, 19 SANTA CLARA COMPUTER & HIGH TECH. L.J. 37 (2002).

A recurring related issue is ownership of copyright in faculty work product. See Roberta Rosenthal Kwall, *Copyright Issues in Online Courses: Ownership, Authorship and Conflict*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1 (2001); Cory H. Van Arsdale, Note, *Computer Programs and Other Faculty Writings Under the Work-For-Hire Doctrine: Who Owns the Intellectual’s Property?*, 1 SANTA CLARA COMPUTER & HIGH TECH. L.J. 141 (1985).

33. See *Stewart v. Abend*, 495 U.S. 207 (1990) (owner of copyright in derivative work created during initial term could not continue to exploit the derivative work during the renewal term without permission of the owner of copyright in the source material); *Mills Music, Inc. v. Snyder*, 469 U.S. 153 (1985) (assignee who licensed derivative works during initial term was entitled by statute to continue to receive royalties from the exploitation of those works after termination of the assignment by the author).

34. See *Quality King Distribs., Inc. v. L’Anza Research Int’l, Inc.*, 523 U.S. 135 (1998) (first-sale doctrine permits the reimportation of copies made in the U.S. and sold abroad). For an overview of the problem, see Darren E. Donnelly, Comment, *Parallel Trade and International Harmonization of the Exhaustion of Rights Doctrine*, 13 SANTA CLARA COMPUTER & HIGH TECH. L.J. 445 (1997).

35. See *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340 (1998) (Seventh Amendment requires right to jury trial on all issues concerning statutory damages); *Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994) (prevailing plaintiffs and prevailing defendants must be treated alike for purposes of recovering attorneys fees).

36. See *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340 (1998) (Seventh Amendment requires right to jury trial on all issues concerning statutory damages); *Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994) (prevailing plaintiffs and prevailing defendants must be treated alike for purposes of recovering attorneys fees).

37. See MICHAEL MORITZ, *THE LITTLE KINGDOM: THE PRIVATE STORY OF APPLE COMPUTER 185-94* (1984), at <http://www.apple-history.com> (last visited Sept. 26, 2003); at <http://www.blinkenlights.com/pc.shtml> (last visited Sept. 26, 2003).

38. See JAMES CHOSKY & TED LEONSIS, *BLUE MAGIC: THE PEOPLE, POWER AND POLITICS BEHIND THE IBM PERSONAL COMPUTER* 110 (1988), at <http://www.blinkenlights.com/pc.shtml> (last visited Sept. 26, 2003).

largely disposed of the so-called “first generation” of software copyright cases,⁴⁰ which established that computer software was copyrightable in both its source code and object code form,⁴¹ that operating system software was copyrightable,⁴² and that copyright for software was not barred by the idea/expression dichotomy as a “process, system or method of operation.”⁴³

During the next decade, copyright law would wrestle with the so-called “second generation” of computer software cases, which dealt with the much more difficult question of whether and how far copyright for computer software would extend beyond literal copying to protect the “structure, sequence and organization” of both source code and screen displays.⁴⁴ A 1986 case, *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*,⁴⁵ took the position that the ultimate purpose or function of a program was its “idea,” and that everything

39. See <http://www.apple-history.com> (last visited Sept. 26, 2003). The Macintosh was introduced to the world during the 1984 Super Bowl in a now-famous television commercial (directed by Ridley Scott) depicting an Orwellian-inspired world of ideological conformity being challenged by a lone athlete with a sledgehammer. See OWEN W. LINZMAYER, APPLE CONFIDENTIAL: THE REAL STORY OF APPLE COMPUTER, INC. 87-92 (1999). The commercial is available online at <http://www.uriah.com/apple-qt/1984.html> (last visited Sept. 26, 2003). For an analysis of the impact of the TV commercial, see Ted Friedman, *Apple's 1984: The Introduction of the Macintosh in the Cultural History of Personal Computers*, at <http://www.duke.edu/~tlove/mac.htm> (last visited Sept. 26, 2003).

40. See Peter S. Menell, *An Analysis of the Scope of Copyright Protection for Application Programs*, 41 STAN. L. REV. 1045, 1048 (1989).

41. See, e.g., *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1246-49 (3rd Cir. 1983). Many of the early computer software cases involved the issue of whether videogames (which were analyzed as audiovisual works) were “fixed” in a tangible medium of expression. See, e.g., *Midway Mfg. Co. v. Artic Int'l, Inc.*, 704 F.2d 1009, 1011-12 (7th Cir. 1983); *Williams Elecs., Inc. v. Artic Int'l, Inc.*, 685 F.2d 870, 874-77 (3rd Cir. 1982); *Stern Elecs., Inc. v. Kaufman*, 669 F.2d 852, 854-57 (2d Cir. 1982); cf. *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614-20 (7th Cir. 1982) (analyzing substantial similarity of Pac-Man and K.C. Munchkin video games).

42. *Franklin Computer*, 714 F.2d at 1249-54; *Apple Computer, Inc. v. Formula Int'l, Inc.*, 562 F. Supp. 775, 779-83 (C.D. Cal. 1983), *aff'd*, 725 F.2d 521 (9th Cir. 1984). A few years later, a district court relied on these cases in holding that microcode was copyrightable. See *NEC Corp. v. Intel Corp.*, 10 U.S.P.Q. 2d 1177 (N.D. Cal. 1989). For arguments on this issue, see F. Thomas Dunlap, Jr., *NEC v. Intel: A Challenge to the Developing Law of Copyright in the Protection of Computer Programs*, 3 SANTA CLARA COMPUTER & HIGH TECH. L.J. 3 (1987); Robert C. Hinckley, *NEC v. Intel: Will Hardware Be Drawn Into the Black Hole of Copyright?*, 3 SANTA CLARA COMPUTER & HIGH TECH. L.J. 23 (1987).

43. 17 U.S.C. §102(b)(2000); see *Franklin Computer*, 714 F.2d at 1249-52; *Formula Computer*, 725 F.2d at 523-25.

44. See generally Menell, *supra* note 40; Paul R. Lamoree, *Expanding Copyrights in Software: The Struggle to Define “Expression” Begins*, 4 SANTA CLARA COMPUTER & HIGH TECH. L.J. 49 (1988).

45. 797 F.2d 1222 (3rd Cir. 1986).

else contained in the program was “expression.”⁴⁶ While some cases took a more restrictive view,⁴⁷ by 1991 a majority of decisions had taken a similar expansive view of the scope of copyright protection.⁴⁸ The state of the law at this time was comprehensively summarized in a trio of articles in the Journal.⁴⁹

In 1992, however, the tide began to turn against expansive copyright protection for computer software. The Second Circuit’s influential opinion in *Computer Associates Int’l, Inc. v. Altai, Inc.*,⁵⁰ established a three-part abstraction-filtration-comparison analysis for assessing the scope of copyright protection in computer programs.⁵¹ Also in 1992, the Ninth Circuit held that copying committed in the course of reverse engineering a computer program in order to determine how it functioned was a fair use.⁵² In 1994, the Ninth

46. *Id.* at 1236-40.

47. *See, e.g.*, *Plains Cotton Coop. Ass’n v. Goodpasture Computer Serv., Inc.*, 807 F.2d 1256, 1262 (5th Cir. 1987); *Synercom Tech., Inc. v. Univ. Computing Co.*, 462 F. Supp. 1003, 1012-14 (N.D. Tex. 1978).

48. *See, e.g.*, *Johnson Controls, Inc. v. Phoenix Control Systems, Inc.*, 886 F.2d 1173, 1175-76 (9th Cir. 1989); *Lotus Dev. Corp. v. Paperback Software Int’l*, 740 F. Supp. 37, 53-68 (D. Mass. 1990); *Broderbund Software, Inc. v. Unison World, Inc.*, 648 F. Supp. 1127, 1133 (N.D. Cal. 1986); *SAS Inst., Inc. v. S & H Computer Systems, Inc.*, 605 F. Supp. 816, 825-26, 830 (M.D. Tenn. 1985). For a spirited defense of the *Whelan* approach, see Carl A. Sundholm, *High Technology Jurisprudence: In Defense of “Look and Feel” Approaches to Copyright Protection*, 8 SANTA CLARA COMPUTER & HIGH TECH. L.J. 209 (1992); Carl A. Sundholm, Comment, *Computer Copyright Infringement: Beyond the Limits of the Iterative Test*, 3 SANTA CLARA COMPUTER & HIGH TECH. L.J. 369 (1987).

49. *See* Evan Finkel, *Copyright Protection for Computer Software in the Nineties*, 7 SANTA CLARA COMPUTER & HIGH TECH. L.J. 201 (1991); Evan Finkel, *Update To: Copyright Protection for Computer Software in the Nineties*, 8 SANTA CLARA COMPUTER & HIGH TECH. L.J. 99 (1992); Walter G. Duflock, Comment, *“Look and Feel”: A Proposed Solution to the Diverging Views Between the Software Industry and the Courts*, 8 SANTA CLARA COMPUTER & HIGH TECH. L.J. 447 (1992).

Other countries were also wrestling with these issues during the same time period. *See, e.g.*, Daniel A.D. Hunter, *Protecting the “Look and Feel” of Computer Software in the United States and Australia*, 7 SANTA CLARA COMPUTER & HIGH TECH. L.J. 95 (1991); Henry Hong Liu, *Legal Aspects of Software Regulation in China: The Computer Software Protection Regulations*, 9 SANTA CLARA COMPUTER & HIGH TECH. L.J. 469 (1993).

50. 982 F.2d 693 (2d Cir. 1992).

51. *Id.* at 706-12. The “filtration” step involved ignoring similarities based on efficiency, compatibility requirements, industry standards, widely accepted programming practices, and elements in the public domain. *Id.* at 707-10.

52. *See* *Sega Enters., Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1520-27 (9th Cir. 1992). This ruling was reaffirmed and extended in *Sony Computer Entertainment, Inc. v. Connectix Corp.*, 203 F.3d 596, 602-08 (9th Cir. 2000). *See also* Stephen J. Davidson, *Reverse Engineering and the Development of Compatible and Competitive Products Under United States Law*, 5 SANTA CLARA COMPUTER & HIGH TECH. L.J. 399 (1989); Kathleen Gilbert-Macmillan, Comment, *Intellectual Property Law for Reverse Engineering Computer Programs in the European Community*, 9 SANTA CLARA COMPUTER & HIGH TECH. L.J. 247 (1993); Jonathan

Circuit rejected a claim that Microsoft's Windows operating system infringed the "look and feel" of the screen displays of the Apple Macintosh and Lisa operating systems.⁵³ And in 1996, an equally-divided U.S. Supreme Court affirmed the controversial First Circuit ruling in *Lotus Development Corp. v. Borland International, Inc.*,⁵⁴ that the entire "menu command hierarchy" of the Lotus 1-2-3 spreadsheet program was an uncopyrightable "method of operation."⁵⁵

The 1990s also saw a reversal in policy concerning the patentability of computer software. Initially, both the U.S. Patent and Trademark Office (USPTO)⁵⁶ and the U.S. Supreme Court⁵⁷ had indicated that software was not patentable subject matter⁵⁸, causing software developers to rely primarily on copyright protection. In 1995, however, under the influence of the U.S. Court of Appeals for the Federal Circuit,⁵⁹ the USPTO reversed course, announcing "that computer programs embodied in a tangible medium, such as floppy

Owens, Comment, *Software Reverse Engineering and Clean-Rooming, When Is It an Infringement?*, 9 SANTA CLARA COMPUTER & HIGH TECH. L.J. 527 (1993); Symposium Review, *Innovation, Software and Reverse Engineering*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 121 (2001).

53. *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435 (9th Cir. 1994). See also Rodger R. Cole, Note, *Substantial Similarity in the Ninth Circuit: A "Virtually Identical" "Look and Feel"?*, 11 SANTA CLARA COMPUTER & HIGH TECH. L.J. 417 (1995).

54. 49 F.3d 807 (1st Cir. 1995), *aff'd by an equally divided Court*, 516 U.S. 233 (1996). See also Jason A. Whong & Andrew T.S. Lee, Note, *Lotus v. Borland: Defining the Limits of Software Copyright Protection*, 12 SANTA CLARA COMPUTER & HIGH TECH. L.J. 207 (1996); Howard C. Anawalt, Note Follow-up, *Part One: Borland and the Blizzard of '96*, 12 SANTA CLARA COMPUTER & HIGH TECH. L.J. 489 (1996).

55. *Lotus Dev. Corp.*, 49 F.3d at 815-19; see *id.* at 821-22 (Boudin, J., concurring). See also Howard C. Anawalt & Carol A. Kunze, *Brief Amicus Curiae in Lotus Development Co. v. Borland Int'l, Inc.*, 116 S.Ct. 804 (1996), *reprinted in* 12 SANTA CLARA COMPUTER & HIGH TECH. L.J. 501 (1996).

56. See U.S. Patent and Trademark Office, Examination of Patent Applications on Computer Programs, 33 Fed. Reg. 15,609 (Oct. 21, 1968), *rescinded*, 34 Fed. Reg. 15,724 (Oct. 9, 1969).

57. See *Gottschalk v. Benson*, 409 U.S. 63 (1972) (method of programming a general-purpose digital computer to perform certain mathematical algorithm was not patentable subject matter); see also *id.* at 72 (quoting Report of the President's Commission on the Patent System (1966)); *Parker v. Flook*, 437 U.S. 584, 595 (1978) ("Difficult questions of policy concerning the kinds of [computer] programs that may be appropriate for patent protection and the form and duration of such protection can be answered by Congress. . .").

58. An important qualification was that a process could be patented even if some of steps included the use of a programmed general-purpose digital computer. See *Diamond v. Diehr*, 450 U.S. 175 (1981); Examination of Patent Applications on Computer Programs, 33 Fed. Reg. at 15,610.

59. See, e.g., *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994) (holding that a programmed general-purpose computer could be patentable subject matter).

diskettes, are patentable subject matter.”⁶⁰ These changes, coupled with the courts’ increasing skepticism of broad copyright protection for computer software,⁶¹ led to a sharp decline in software copyright litigation and a sharp increase in the number of software patents issued and litigated during the past decade.

III. COPYRIGHT AND THE INTERNET⁶²

The rapid commercialization of the Internet in the early 1990s⁶³ led to the first suits for making copyrighted works available over the Internet. The first such reported case was a criminal prosecution of an MIT student who set up an electronic bulletin board and posted computer software for others to download for free.⁶⁴ The court dismissed the charges, because the defendant had not acted (as the statute then required) “for purpose[s] of commercial advantage or private financial gain.”⁶⁵ In response, Congress enacted the No

60. *In re Beauregard*, 53 F.3d 1583, 1584 (Fed. Cir. 1995) (quoting Commissioner of U.S. Patent and Trademark Office). The USPTO’s position was subsequently embodied in its Examination Guidelines for Computer-Related Inventions, 61 Fed. Reg. 7478, 7482 (Feb. 27, 1996), *reprinted in* 17 J. MARSHALL J. COMPUTER & INFO. L. 311, 323 (1998) (a “computer-readable medium encoded with a computer program” is patentable subject matter).

61. *See supra* notes 50-55 and accompanying text.

62. Although the history of the Internet can be traced back to the 1960s, two key dates roughly coincide with the founding of the Journal: January 1, 1983, the date on which computers connected to ARPANET were required to adopt the TCP/IP protocols; and 1984, when the domain name system was introduced, replacing numeric Internet addresses with alphanumeric domain names. *See* JANET ABBATE, *INVENTING THE INTERNET* 140-42, 189-90 (1999); CHRISTOS J.P. MOSCHOVITIS, ET AL., *HISTORY OF THE INTERNET: A CHRONOLOGY, 1843 TO THE PRESENT* 109-10, 118 (1999).

63. Between 1989 and 1991, Tim Berners-Lee of CERN (*Conseil European pour la Reserche Nucleaire*, or European Organization for Nuclear Research) invented the World Wide Web by defining the standards for Hypertext Markup Language (HTML), the Hypertext Transfer Protocol (HTTP), and Uniform Resource Locators (URLs). *See* TIM BERNERS-LEE, *WEAVING THE WEB: THE ORIGINAL DESIGN AND ULTIMATE DESTINY OF THE WORLD WIDE WEB BY ITS INVENTOR* 21-51 (1999); JAMES GILLIES & ROBERT CAILLIAU, *HOW THE WEB WAS BORN: THE STORY OF THE WORLD WIDE WEB* 180-221 (2000). In April 1993, CERN’s directors announced that WWW technology could be freely used by anyone without charge, leading to its widespread adoption. *See* BERNERS-LEE, *supra* at 74; GILLIES & CAILLIAU, *supra* at 261. Because of its relative ease of use, the World Wide Web opened the doors to commercialization of the Internet in a way that had not previously been possible.

For a sample of the legal issues raised by the Internet and the World Wide Web, *see* Sheldon Burshtein, *Surfing the Internet: Copyright Issues in Canada*, 13 SANTA CLARA COMPUTER & HIGH TECH. L.J. 385 (1997); Lisa M. Byerly, Comment, *Look and Feel Protection of Web Site User Interfaces: Copyright or Trade Dress?*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 221 (1998).

64. *See United States v. LaMacchia*, 871 F. Supp. 535 (D. Mass. 1994).

65. *Id.* at 540, *quoting* former 17 U.S.C. § 506(a). This portion of the former statute is now in 17 U.S.C. § 506(a)(1)(2003).

Electronic Theft Act,⁶⁶ which permitted criminal liability to be imposed based on the retail value of the works copied.⁶⁷

In 1995, Congress passed the Digital Performance Right in Sound Recordings Act,⁶⁸ which granted a limited right of public performance to sound recording copyright owners for the first time.⁶⁹ That same year, Santa Clara student Adam Segal wrote a prescient article analyzing both the potential for authorized distribution and the risks of unauthorized copying of digitized music on the Internet.⁷⁰ Although Segal's article was published when MIDI was the standard format for computer sound recording playback,⁷¹ much of what he anticipated came to pass when free software based on the MP3 compression format became available in 1998.⁷² "Ripping" software enabled individuals to copy their CDs to the hard disks of their computers and to convert those files into MP3 format for faster transfer over the Internet.⁷³ Portable MP3 players allowed people to download songs from their computer and to carry those music files

66. See Pub. L. No. 105-147, 111 Stat. 2678 (1997).

67. See 17 U.S.C. § 506(a)(2). See Greg Short, Comment, *Combatting Software Piracy: Can Felony Penalties for Copyright Infringement Curtail the Copying of Computer Software?*, 10 SANTA CLARA COMPUTER & HIGH TECH. L.J. 221 (1994).

68. Pub. L. No. 104-39, 109 Stat. 336 (1995). The DPRSRA was later amended by Title IV of the Digital Millennium Copyright Act of 1998 (see Pub. L. No. 105-304, 112 Stat. 2860 (1998)) and is codified (as amended) at 17 U.S.C. §§ 106(6), 114(d) and 115(c)(3)(2003). For commentary, see David Nimmer, *Ignoring the Public, Part I: On the Absurd Complexity of the Digital Audio Transmission Right*, 7 UCLA ENT. L. REV. 189 (2000); Eric D. Leach, *Everything You Always Wanted to Know About Digital Performance Rights But Were Afraid To Ask*, 48 J. COPYRIGHT SOC'Y U.S.A. 191 (2000).

69. See 17 U.S.C. § 106(6) ("in the case of sound recordings, [the exclusive right] to perform the copyrighted work publicly by means of a digital audio transmission").

70. See Adam P. Segal, Comment, *Dissemination of Digitized Music on the Internet: A Challenge to the Copyright Act*, 12 SANTA CLARA COMPUTER & HIGH TECH. L.J. 97 (1996). Segal's article was cited by the New York Court of Appeals in a case involving a claim of defamation against an Internet service provider. See *Lunney v. Prodigy Servs. Co.*, 94 N.Y.2d 242, 250, 701 N.Y.S.2d 684, 687 (1999).

71. See Segal, *supra* note 70, at 103. MIDI stands for Musical Instrument Digital Interface. *Id.* at 103 n.24.

72. See Rebecca J. Hill, Comment, *Pirates of the 21st Century: The Threat and Promise of Digital Audio Technology on the Internet*, 16 SANTA CLARA COMPUTER & HIGH TECH. L.J. 311 (2000).

MP3 is short for Moving Picture Experts Group, Audio Layer III. The MP3 compression algorithm was patented in Germany in 1989, but the first successful MP3 player, the AMP MP3 Playback Engine, was not released until 1997. Later, a Windows interface was added to create Winamp. "In 1998, when Winamp was offered up as a free music player, the MP3 craze began: Music fiends all over the world started MP3 hubs, offering copyrighted music for free." Christopher Jones, *MP3 Overview, Behind the Music: The History of MP3*, at <http://hotwired.lycos.com/webmonkey/00/31/index3a.html> (July 27, 2000).

73. *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1011 (9th Cir. 2001).

with them.⁷⁴ Then, in 1999, Napster, a website offering software and an indexing and search capability for peer-to-peer file sharing, came online.⁷⁵ When sued by the record industry, Napster claimed the benefit of the *Sony* doctrine on the ground that it was capable of substantial noninfringing uses;⁷⁶ but ultimately it was enjoined on grounds of contributory infringement and vicarious liability.⁷⁷

Napster's demise barely left a dent in the phenomenon of peer-to-peer file sharing as other programs rose to take its place. Some, like Aimster, were based on similar technology and were enjoined,⁷⁸ but others, like Grokster, Morpheus and KaZaA, do not maintain their indexes on a central server, making them both more difficult to shut down and arguably bringing them within the *Sony* doctrine.⁷⁹ In the meantime, the popularity of peer-to-peer file sharing has pushed the recording industry to begin to adopt new business models for authorized distribution of copyrighted recordings over the Internet.⁸⁰

IV. THE DIGITAL MILLENNIUM COPYRIGHT ACT

In 1995, a Clinton Administration Task Force issued a "White Paper" summarizing how copyright law could be applied to the Internet and recommending certain changes to increase copyright protection.⁸¹ The Task Force's conclusions and recommendations were highly controversial and were initially rejected by Congress.⁸²

74. See *Recording Indus. Ass'n. of Am. v. Diamond Multimedia Sys., Inc.*, 180 F.3d 1072 (9th Cir. 1999) (holding that Diamond Rio portable MP3 player did not violate the Audio Home Recording Act).

75. See *The History of Napster: A Napster Timeline*, at <http://web.utk.edu/~smarcus/History.html> (last visited Oct. 9, 2003).

76. *Napster*, 239 F.3d at 1020.

77. *Id.* at 1019-24. See also *A&M Records, Inc. v. Napster, Inc.*, 284 F.3d 1091 (9th Cir. 2002) (affirming modified preliminary injunction ordering Napster to disable its service).

78. See *In re Aimster Copyright Litig.*, 334 F.3d 643 (7th Cir. 2003) (affirming preliminary injunction).

79. See, e.g., *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 259 F. Supp. 2d 1029 (C.D. Cal. 2003) (distinguishing *Napster* on this ground). The *Grokster* case is currently on appeal before the U.S. Court of Appeals for the Ninth Circuit.

80. For an examination of such a model in the context of digital images rather than music, see Jonathan A. Franklin, *Digital Image Reproduction, Distribution and Protection: Legal Remedies and Industrywide Alternatives*, 10 SANTA CLARA COMPUTER & HIGH TECH. L.J. 347 (1994).

81. See INFORMATION INFRASTRUCTURE TASK FORCE, INTELLECTUAL PROPERTY AND THE NATIONAL INFORMATION INFRASTRUCTURE: THE REPORT OF THE WORKING GROUP ON INTELLECTUAL PROPERTY RIGHTS 7 (1995). For a criticism, see Sean R. Calvert, Note, *A Digital World Out of Balance*, 13 SANTA CLARA COMPUTER & HIGH TECH. L.J. 545 (1997).

82. See Pamela Samuelson, *The U.S. Digital Agenda at WIPO*, 37 VA. J. INT'L L. 369, 373, 429 (1997).

In 1996, however, the Clinton Administration took its proposals to the Diplomatic Conference of the World Intellectual Property Organization,⁸³ and succeeded in getting some of them included in the WIPO Copyright Treaty⁸⁴ and the WIPO Performances and Phonograms Treaty.⁸⁵ New legislation “implementing” the two treaties was then introduced in Congress,⁸⁶ and was enacted in 1998 (together with a number of other measures) in the Digital Millennium Copyright Act.⁸⁷

Title I of the DMCA added several new causes of action to Title 17 of the United States Code, in addition to the action for infringement provided in the Copyright Act itself.⁸⁸ Section 1201(a)(1) prohibits the circumvention of technological protection measures (such as encryption and password protection) used to control access to a copyrighted work.⁸⁹ Section 1201(a)(2) prohibits manufacturing, importing, offering, providing or trafficking in any product or service designed, produced or marketed for the purpose of circumventing such measures or that has only limited uses other than circumvention;⁹⁰ and Section 1201(b) similarly prohibits products or services that circumvent copy-protection technology.⁹¹ To date these provisions have been upheld against constitutional challenge on the ground that they violate the First Amendment.⁹²

83. *Id.* at 369-70, 430.

84. *See* WIPO Copyright Treaty (adopted Dec. 20, 1996; entered into force March 6, 2002), available at www.wipo.org/treaties/ip/wct/index.html (last visited Oct. 14, 2003).

85. *See* WIPO Performances and Phonograms Treaty (adopted Dec. 20, 1996; entered into force May 20, 2002), available at www.wipo.org/treaties/ip/wppt/index.html (last visited Oct. 14, 2003).

86. For a description of and critique of the implementing legislation, see Pamela Samuelson, *Intellectual Property and the Digital Economy: Why the Anti-Circumvention Regulations Need to be Revised*, 14 BERKELEY TECH. L.J. 519, 531-37 (1999).

87. *See* Pub. L. No. 105-304, 112 Stat. 2860 (1998).

88. *See* 17 U.S.C. § 501(a)(2003). In addition to the three causes of action mentioned in the text, Title I of the DMCA also added two causes of action for knowingly providing false “copyright management information,” 17 U.S.C. § 1202(a), and for removing or altering copyright management information, 17 U.S.C. § 1202(b).

89. 17 U.S.C. § 1201(a)(1)(2003). For a discussion of one possible application of the anti-circumvention provisions, see Howard C. Anawalt, *Using Digital Locks in Invention Development*, 15 SANTA CLARA COMPUTER & HIGH TECH. L.J. 363 (1999).

90. 17 U.S.C. § 1201(a)(2)(2003).

91. *Id.* § 1201(b).

92. *See* *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 445-58 (2nd Cir. 2001); *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111, 1125-37 (N.D. Cal. 2002).

A current controversy is the extent to which the anti-circumvention provisions apply to software embedded in useful articles. *Compare* *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 253 F. Supp. 2d 943 (E.D. Ky. 2003) (laser printer toner cartridges) *with*

Title II of the DMCA enacted a limitation of liability for Internet service providers. Title II adopted and modified the approach taken in *Religious Technology Center v. Netcom On-Line Communication Services, Inc.*,⁹³ in which the court held that Netcom was not liable for direct infringement,⁹⁴ despite the fact that its servers had in fact been used to disseminate messages containing excerpts of the works in question.⁹⁵ The court ruled that the automated technical processes that made the Internet possible would not be subject to strict liability for copying;⁹⁶ instead, such conduct would be judged according to established standards for contributory infringement⁹⁷ and vicarious liability.⁹⁸ Concerned that the *Netcom* standards would result in excessive liability, ISPs lobbied Congress to adopt four “safe harbors” for Internet service providers, codified at 17 U.S.C. §512.⁹⁹ The four “safe harbors” cover reproductions made in the course of transitory network communications;¹⁰⁰ system caching;¹⁰¹ storage of material for third-parties;¹⁰² and providing information location tools (such as search engines and hyperlinks).¹⁰³ In order to qualify for two of the safe harbors, however, the service provider must not have actual or constructive knowledge that the material or activity in question is infringing;¹⁰⁴ and in order to qualify for three of them, the service

Chamberlain Group, Inc. v. Skylink Technologies, Inc., 68 U.S.P.Q. 2d 1009 (N.D. Ill. 2003) (garage door openers).

93. 907 F. Supp. 1361 (N.D. Cal. 1995).

94. *Id.* at 1372-73.

95. *Id.* at 1368-69.

96. *Id.* at 1368-70.

97. *Id.* at 1373-75.

98. *Id.* at 1375-77.

99. For a detailed analysis of the legislative history of these provisions, see Irina Y. Dmitrieva, *I Know It When I See It: Should Internet Providers Recognize Copyright Violation When They See It?*, 16 SANTA CLARA COMPUTER & HIGH TECH. L.J. 233, 244-53 (2000).

100. 17 U.S.C. § 512(a)(2003).

101. *Id.* § 512(b).

102. *Id.* § 512(c).

103. *Id.* § 512(d). A related question is whether copying by Internet search engines constitutes a fair use. See Daniel Ovanezian, Comment, *Internet Search Engine Copying: Fair Use Defense to Copyright Infringement*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 267 (1998). The Ninth Circuit has held that fair use protects a visual search engine making and displaying “thumbnail” versions of images available on the Internet. See *Kelly v. Arriba Soft Corp.*, 280 F.3d 934 (9th Cir. 2002), *superseded*, 336 F.3d 811 (9th Cir. 2003). For an analysis of the superseded opinion, see Khoi D. Dang, Note, *Kelly v. Arriba Soft Corp.: Copyright Limitations on Technological Innovation on the Internet*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 389 (2002).

104. Dmitrieva, *supra* note 99, at 242. This article analyzes in detail what type of evidence will be sufficient to demonstrate actual or constructive knowledge on the part of an Internet service provider. *Id.* at 253-61.

provider must immediately disable access to material claimed to be infringing *before* the alleged infringer is given notice and an opportunity to be heard.¹⁰⁵

V. INTERNATIONAL COPYRIGHT.

Another important trend during the past two decades has been the degree to which U.S. copyright law has been integrated into the world community.¹⁰⁶ The United States had refused to join the Berne Convention, the major international treaty concerning copyright protection, for more than a century after its adoption in 1886.¹⁰⁷ It was not until March 1, 1989, that the United States finally acceded to the Berne Convention.¹⁰⁸ In order to comply with the Convention's prohibition on the imposition of formalities,¹⁰⁹ the Berne Convention Implementation Act¹¹⁰ eliminated the registration requirement for most works of foreign origin¹¹¹ and eliminated the notice requirement altogether.¹¹² In 1990, Congress partially implemented Article 6*bis* by providing very limited moral rights for the first time in the Visual

105. See 17 U.S.C. §§ 512(b)(2)(E), (c)(1)(C), (d)(3) (2003). The "notice-and-take-down" procedure is set forth in §§ 512(C)(3) and (g). For commentary, see Elizabeth G. Thornburg, *Going Private: Technology, Due Process, and Internet Dispute Resolution*, 34 U.C. DAVIS L. REV. 151, 168-73, 194-95, 199 (2000).

106. See Alan S. Gutterman, *International Intellectual Property: A Summary of Recent Developments and Issues for the Coming Decade*, 8 SANTA CLARA COMPUTER & HIGH TECH. L.J. 335 (1992).

107. See PAUL GOLDSTEIN, *INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE* 23 (Oxford U. Press 2001). The major obstacles to U.S. adherence were the Berne Convention's prohibition on formalities (such as notice, deposit and registration) and its minimum duration of life-plus-50-years, which the U.S. did not adopt until January 1, 1978.

108. See Berne Convention and "Berne Implementation Act of 1988," 53 Fed. Reg. 48748 (Dec. 2, 1988) ("As stated in the instrument of accession, the Convention shall enter into force for the United States of America on March 1, 1989").

109. See Berne Convention for the Protection of Literary and Artistic Works, 1971 Paris Text, art. 5(2) ("The enjoyment and exercise of these rights shall not be subject to any formality").

110. Pub. L. No. 100-568, 102 Stat. 2853 (1988).

111. See Joint Explanatory Statement on Amendment to S. 1301, 134 CONG. REC. S14549-01 (Oct. 5, 1988) (explaining the proposed "two-tier" system of registration). This provision was later generalized to include all works other than those first published in the United States or those works by U.S. authors first published in a foreign nation with whom the U.S. does not have copyright relations. See 17 U.S.C. § 411(a) and § 101 (2003) (definition of "United States work"). However, the U.S. continues to require registration as a prerequisite for the recovery of both statutory damages and attorney's fees. 17 U.S.C. § 412 (2003).

112. See S. REP. NO. 100-352, at 12-13, *reprinted in* 1988 U.S.C.C.A.N. 3706, 3717-18; 17 U.S.C. §§401(a), 402(a) (2003).

Artists Rights Act,¹¹³ and in 1994, Congress implemented Article 18 by restoring the copyrights of works of foreign origin which had fallen into the public domain in the United States for failure to comply with various formalities.¹¹⁴

Another aspect of the internationalization of copyright has been the degree to which copyright (along with other types of intellectual property) is now the subject of multilateral trade agreements.¹¹⁵ In 1994, at the Uruguay Round of the General Agreement on Tariffs and Trade (GATT), the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) was adopted, making the provisions of the Berne Convention (except Article 6*bis*) enforceable between nations under the dispute-resolution mechanism of the World Trade Organization.¹¹⁶ In a supreme irony, in 2000 the United States, which had fought hard to bring intellectual property under the auspices of the WTO, became the first nation to be found in violation of the copyright provisions of TRIPS for adopting a provision that exempted most restaurants and bars from having to pay royalties for playing copyrighted music over the radio.¹¹⁷

The internationalization of copyright is also implicated in the international reach of the Internet.¹¹⁸ Under existing law, the “country of origin” of a work (which may, in turn, depend on the country in which the work was first “published”)¹¹⁹ may affect both whether

113. Pub. L. No. 101-650, Title VI, 104 Stat. 5089 (1990), *codified at* 17 U.S.C. § 106A (2003).

114. 17 U.S.C. § 104A (2003); *see also* Adam P. Segal, *Zombie Copyrights: Copyright Restoration Under the New § 104A of the Copyright Act*, 13 SANTA CLARA COMPUTER & HIGH TECH. L.J. 71 (1997).

115. *See generally* David Nimmer, *GATT's Entertainment: Before and NAFTA*, 15 LOYOLA L.A. ENT. L. REV. 133 (1995).

116. *See* TRIPS Agreement, art. 9(1), art. 64. The exception concerning Article 6*bis* was insisted upon by the United States, for the obvious reason that we knew we were not in full compliance with Article 6*bis*. *See* Tyler T. Ochoa, *Introduction: Rights of Attribution, Section 43(a) of the Lanham Act, and the Copyright Public Domain*, 24 WHITTIER L. REV. 911, 926-27 (2003).

117. *See* United States – Section 110(5) of U.S. Copyright Act, Report of the Panel, WT/DS160/R (WTO June 15, 2000), *available at* www.wto.org/english/tratop_e/dispu_e/dispu_e.htm#disputes (last visited Oct. 14, 2003).

118. *See, e.g.*, *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 243 F. Supp. 2d 1073 (C.D. Cal. 2003) (holding that U.S. court has personal jurisdiction over defendant, a corporation organized under the laws of the island-nation of Vanuatu and doing business principally in Australia, based on effects of distributing file-sharing software over Internet website on California plaintiffs).

119. *See* Berne Convention, art. 5(4) (defining “country of origin”); *see also* 17 U.S.C. § 104A(h)(8) (2003) (defining “source country”).

copyright protection is afforded and the ownership of the copyright.¹²⁰ Similarly, the scope of copyright protection and questions of licensing and infringement often depend on the country in which the alleged use occurs.¹²¹ The ubiquity of the Internet, however, threatens to make distinctions based on national borders meaningless in an online world. When a work is posted on a website, where is that work “published”? What is the “country of origin”? Which countries’ laws should apply? These questions were addressed by Professor Jane Ginsburg of Columbia University School of Law in the First Annual Distinguished Lecture in High Technology Law at Santa Clara in 1998. Her thoughts were subsequently committed to writing in an influential article that appeared in the Journal (and is reprinted in this 20th Anniversary Issue), *The Cyberian Captivity of Copyright: Territoriality and Authors’ Rights in a Networked World*.¹²²

VI. 1984 AND BEYOND.

In 1984, George Orwell imagined a world in which Big Brother was always watching what ordinary citizens did.¹²³ While the Internet has not yet evolved into an omnipresent surveillance system, the Internet does make it possible to track the movements of individuals in cyberspace with relative ease. This was amply demonstrated in 2003 when the recording industry sought subpoenas from Internet service providers to identify individuals allegedly engaged in - unauthorized peer-to-peer file-sharing,¹²⁴ and then used those records

120. See, e.g., Berne Convention, art. 3(1); 17 U.S.C. §§ 104(b), 104A(b) (2003); *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 84 (2nd Cir. 1998) (holding that “Russian law determines the ownership and essential nature of the copyrights alleged to have been infringed”).

121. See, e.g., *Itar-Tass*, 153 F.3d at 84 (“United States law determines whether those copyrights have been infringed in the United States and, if so, what remedies are available.”); *Corcovado Music Corp. v. Hollis Music, Inc.*, 981 F.2d 679 (2nd Cir. 1993) (applying U.S. law to determine renewal rights of Brazilian parties, despite existence of contract between the parties written in Portuguese and executed in Brazil).

122. C. Ginsburg, *The Cyberian Captivity of Copyright: Territoriality and Authors’ Rights in a Networked World*, 15 SANTA CLARA COMPUTER & HIGH TECH. L.J. 347 (1999).

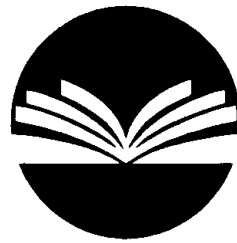
123. See GEORGE ORWELL, 1984 (1949).

124. See *In re Verizon Internet Servs., Inc.*, 240 F. Supp. 2d 24 (D.D.C. 2003) (subpoena provision of 17 U.S.C. § 512(h) applies to all internet service providers, not just to those “hosting” allegedly infringing material); *In re Verizon Internet Servs., Inc.*, 257 F. Supp. 2d 244 (D.D.C. 2003) (subpoena provision of 17 U.S.C. § 512(h) satisfies “case or controversy” requirement and does not violate First Amendment).

to file the first wave of lawsuits against individuals who allegedly made large numbers of copyrighted works available to others.¹²⁵

Over the past twenty years, the authors and editors of the Journal have attempted to analyze and explain these and other significant developments in the law of copyright. As copyright law continues to evolve in response to technological developments and international influences, we can expect both scholars and practitioners to continue to turn to the pages of the Journal for guidance on emerging legal issues.

125. See Jon Healey, James S. Granelli and Joseph Menn, *Song Swappers Face the Music*, L.A. TIMES, Sept. 9, 2003, at A1.



Jane C. Ginsburg, *The Cyberian Captivity of Copyright: Territoriality and Authors' Rights in a Networked World*

Originally Published:

15 SANTA CLARA COMPUTER & HIGH TECH. L.J. 347 (1999)

This Article discusses the transition and consequences of copyright exploitation's movement from a legal regime rooted in a territorially bounded analog world towards an unbounded digital world. In particular, this article discusses copyright ownership, nationality, infringement and licensing, and the ways each of these concepts were grounded on principles of territoriality.

Exemplary citations to the original article include:

Bruce A. Lehman, *Global Intellectual Property in the Twenty-First Century*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 9 (1996).

Timothy D. Howell, *Intellectual Property Pirates: Congress Raises the Stakes in the Modern Battle to Protect Copyrights and Safeguard the United States Economy*, 27 ST. MARY'S L. J. 613 (1996).