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Cases of Note -- Vicarious Copyright Liability - Grok Out

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are the copyright concerns it should address for the Web publication?

ANSWER: This can be handled quite simply by revising the copyright transfer form. On that form, the journal should indicate that some papers will appear in print while others will appear only on the journal Website. Then on the copyright transfer form, require that the author transfer the reproduction and distribution rights for both printed and electronic versions. Additional considerations might include what other uses of the article the journal is willing to permit the author. For example, (1) may the author post the article on his or her own Website; (2) if author Website posting is permitted, is there a period of time before the work can be posted, e.g., six months; (3) may the author publish the paper that is published only on the Website in another journal; (4) if yes, only in a printed journal or in another e-journal; (5) may the author reuse the paper as a book chapter; (6) what rights does the author have to reproduce the article in photocopies and distribute to classes; and (7) may the faculty author post the article on a password protected Website for students. Additionally, does the journal want the author to credit the journal Website in any permitted uses? I encourage publishers to grant these rights back to the author.

QUESTION: *How can a library stop a patron from burning CDs? The library asks no questions and places no limits on the number of CDs a patron reproduce.*

ANSWER: It is important not to assume that CD burning is copyright infringement. It may not be. For example, if a patron owns a copy of a CD and makes a duplicate for use in his or her car, it is not infringement under the **Audio Home Recording Act** which is sections 1001-1010 of the **Copyright Act** — even the **Recording Industry Association of America** agrees. (<http://www.minidisc.org/ahra.html>) Or the patron may have a subscription to **Audible.com** which permits subscribers to download audible books to CD and other devices. In other words, the copying may be permitted by the law, by a license agreement or as a fair use.

The only duty of the library is to post the notices on reproduction equipment as required under section 108(f)(1) and for the library itself to follow the law. Just as the library does not inquire about the use a patron will make of a photocopy, it should not inquire about copies in other media.

QUESTION: *An art museum is trying to put together an online gallery consisting of images of the paintings in its collection. Is artwork automatically copyrighted because it is considered to be unpublished? Does your chart concerning published works apply to artwork? (<http://www.unc.edu/~uncnlg/public-d.htm>) Most of the collection mainly consists of pre-1950 artwork.*

ANSWER: Works created before 1978 are covered by the **1909 Copyright Act**, and fed-

eral copyright applied only to published works. When the work in question is a painting, what does "publication" mean? Publication certainly has a more consistent meaning for books, journals, and the like. The central question is whether display in a gallery or museum constituted publication. Unfortunately, it was not consistently applied from federal circuit to circuit. The majority view was that public display was equivalent to publication, however. For paintings produced between 1923 and 1963 that are considered to be published, the copyright had to be renewed or they entered the public domain after the first 28 years of protection.

Prior to 1978, the majority of courts held that sale of the original work transferred the copyright in that work unless the parties otherwise agreed. So, the museum may actually own the copyright in many of the works in its collection. Moreover, if no claim of copyright was made on the original painting, and there was no effort made by the artist, museum or gallery to prevent public copying, courts in some circuits have held that the work has become public domain.

Generally the "When Works Pass into the

Public Domain" chart does apply, but it is not 100% accurate for pre-1978 paintings, depending on the circuit and whether the museum actually acquired the copyright when the original work was purchased either by the museum or by a donor who then gave the painting to the museum.

QUESTION: *A faculty in the university has produced a song cycle based on the poetry of Gustavo Adolfo Becquer, a 19th century, Spanish poet. The library has not been able to find any answers concerning his copyrights. It has written publishers, but has received no response. Becquer died in 1870; could his work still be under copyright?*

ANSWER: His poetry is public domain. Even in Spain where the copyright term was life of the author plus 50 years, the copyrights would have expired in 1920. Thus, the faculty member is free to prepare a derivative work based on his poems. If the faculty member contributes enough original work, which it sounds as if he has, then derivative work is eligible for copyright protection even though the underlying work is in the public domain. No one can copy the faculty member's song cycle, but others are free to write their own song cycles based on **Becquer's** poetry.

Cases of Note — Vicarious Copyright Liability — Grok Out

by **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>

Metro-Goldwyn-Mayer Studios and every other bloated movie/ music conglomerate v. Grokster Ltd., StreamCast Networks Inc. and a quarter page list of other outfits that sell peer-to-peer software, United States Court of Appeals for the Ninth Circuit, 380 F.3d 1154; 2004 U.S. App. LEXIS 17471 (2004).

And now for all you peer-to-peer music thieves out there, the resounding **Grokster** victory over a class of 27,000 companies, conglomerates, combines and song writers that own nearly every single movie and piece of music in the US of A.

The lead sentence of the opinion approaches the sublime. At least for legal writing. "From the advent of the player piano, every new means of reproducing sound has struck a dissonant chord with musical copyright owners..."

Grokster and **StreamCast** distribute software that permits teenagers with body piercings, tattoos and their caps turned backwards to share computer files. And this can be used to copy digitized music and movies.

Your typical Internet transaction has a "client" personal computer making contact with a "server" that hosts a Web page. The server is a

centralized source. And that of course was where **Napster** went awry, but more about that later.

With peer-to-peer there is no central server. Every computer connects with the others that use similar software and is both server and client.

If this seems like peer-to-peer for dummies you can really sink your teeth into **Yochai Benkler**, *Coase's Penguin, or, Linux and The Nature of the Firm*, 112 Yale L.J. 369, 396-400 (2002); **Jesse M. Feder**, *Is Betamax Obsolete?: Sony Corp. of America v. Universal City Studios, Inc. in the Age of Napster*, 37 Creighton L. Rev. 859, 862-68 (2004).

Napster operated a centralized indexing software with all its files on it. The client would send a search request and **Napster** would locate the desired song and transmit it.

StreamCast uses **Gnutella** open-source software. Our outlaw teenager sends a search request to all computers in the network for that desired song. Open-source means the software is in the public domain. Yes, he even gets that for free.

A Dutch company **KaZaa BV** developed "supernode" architecture whereby numerous computers operate as indexing servers and our teen accesses the nearest one. This was marketed as "**FastTrack**" and was initially used by both **Grokster** and **StreamCast**. Following a spat with **KaZaa**, **StreamCast** developed its

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variety of Gnutella called "**Morpheus**."

The only importance of burdening you with this is that **Grokster** and **StreamCast** folks can't communicate with one another. They're each in their own virtual worlds. Which limits the theft in some minimal way.

Now, along with all the music stealing, our users can share heavy partying photos, recycled term papers or public domain works. Stealing of course is the biggest part of the traffic, estimated at around 90%.

While the big boys have been in the news bringing college misfits to book for copyright infringement, this suit was against the above two companies and others for secondary liability — to wit: **contributory copyright infringement** and **vicarious copyright infringement**.

Contributory copyright infringement

To show this, you need (1) direct infringement by a primary infringer — the outlaw teen; (2) knowledge of the infringement by **Grokster**; and (3) material contribution to the infringement by **Grokster**. (1) is a given, so the issue is (2), knowledge.

And How Is It That You Know Stuff?

The controlling case here is *Sony Corp. of America v. Universal City Studios, Inc.* 464 U.S. 417 (1984) dating to the days when the

movie industry was trying to shut down video tape recorders.

And how quaint and long ago that battle seems.

The Supreme Court said no constructive knowledge of infringement if you could show the product was "capable of substantial" or "commercially significant noninfringing uses." This was derived from the "staple article of commerce" doctrine found in patent law. *Id.* at 440-42.

The Ninth Circuit had already applied this in *A&M Records v. Napster*, 239 F.3d 1004 (9th Cir. 2001) ("*Napster I*"). As there were substantial legit uses of **Napster**, so constructive knowledge was out and the music owners had to show defendant had reasonable knowledge of specific infringing files. *Id.* at 1027.

On remand of *Napster I* the district court required plaintiffs to inform **Napster** of specific files which **Napster** would then block. This was appealed as *A&M Records v. Napster*, 284 F.3d 1091 (9th Cir. 2002) ("*Napster II*"). The 9th Circuit upheld the district court, leaving the burden on plaintiffs of providing names of particular files before **Napster** was bound to act.

What Did Grokster Know and When Did It Know It?

There is no issue of fact whatsoever that **Grokster** has substantial noninfringing uses. The Court cites the band **Wilco** who were jacked around by their record company so they put an album out for free downloading and got so much buzz going that the record

company offered them a new contract.

A **Google** search turns up **Wilco** as being once alt.country but now something else that music commentators can't quite define based on much raved over hits like "Summerteeth" and "Yankee Hotel Foxtrot." None of which means a thing to me.

The Court notes that thousands of other bands have debuted their work through free downloads. As well as noting **Project Gutenberg** with its public domain literary works and the **Prelinger Archive** with movies.

The only response to this by the bloated big boys was that **Grokster** was mostly used for theft. But that's not the standard for constructive knowledge.

Your heart and presumably your brain is pure if you produce a product with virtuous uses.

The Seventh Circuit has read *Sony* differently. In *re Aimster Copyright Litig.*, 334 F.3d 643, 651 (7th Cir. 2003) added a new factor of "probability" of infringing use. But the Ninth Circuit said they were bound by their holding in *Napster I* and could only overturn their own precedent by the entire court sitting *en banc*. And they weren't impressed by *Aimster* anyhow. So it's the reasonable knowledge of specific infringement standard.

And On To Material Contribution

Remember we're not dealing with a central server with an index of available files.

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Napster provided the site for big-time infringement; **Grokster** *et al* don't do this. It's the users who provide file storage and index maintenance. With both the **Gnutella** and **KaZaa** networks, the software owners could keep exchanging files even with **Grokster** and **StreamCast** shut up shop entirely.

Okay, Then How About Vicarious Copyright Infringement?

And once again there are three elements: (1) direct infringement by a primary party; (2) direct financial benefit to **Grokster**; (3) right and ability to supervise the infringers. *Napster I*, 239 F.3d at 1022.

This theory grew out of agency law's *respondet superior*. The idea is if you have the right to control someone's bad behavior, you should be liable if you don't.

Right and Ability to Supervise

There is a historic split here between the "dance hall operator" who can control what music is played and the "landlord" who has no control over what his tenants are doing behind closed doors. *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 261, 262-63 (9th Cir. 1996).

With **Grokster** and **StreamCast**, there is no registration or log-in procedure. There is no ability to block what the users are doing. They are landlords and not dance hall operators.

Turning a "Blind Eye" to Infringement

As a last gasp, the music companies argue that **Grokster** should not be permitted to turn a blind eye to all that theft going on out there. The Ninth Circuit said there was no separate "blind eye" theory of vicarious liability. And anyhow, what is **Grokster** supposed to do if it has no ability to supervise?

But Public Policy Oughta Do Something About This

The Ninth Circuit said we live in a "quick-silver technological environment" and courts are not capable of fixing the direction of innovation. *AT&T v. City of Portland*, 216 F.3d 871, 876 (9th Cir. 1999). Old markets will always be roiled by new technology — tape recorders, copiers, video recorders, PCs, karaoke machines and MP3 players.

The Supreme Court spoke clearly in *Sony-Betamax* that Congress was the body to adjust copyright law in response to changing technology. Indeed it says it right there in Art. I of the Constitution that Congress has the power to promote arts and science. "When, as here, the Constitution is permissive, the sign of how far Congress has chosen to go can come only from Congress. 464 U.S. at 456 (quoting *Deepsouth Packing Co. v. Laird Corp.*, 406 U.S. 518, 530 (1972)).

And speaking of quicksilver, as we go to press, **BitTorrent** is in the news as the latest nightmare for Hollywood. With this jim-dandy bit of software, you can now copy a full length movie in two hours rather than the twelve required by **KaZaa**.

Biz of Acq — Ten Years After: How Positions with a Serials Emphasis have Changed a Decade after the World Wide Web

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Column Editor's Note: The author describes and compares advertisements of professional library positions with serials responsibilities, posted ten years apart. He notes many changes in titles, duties and general emphasis, and relates these differences to trends in serials librarianship over the past decade. — **AF**

Introduction

External factors have changed and challenged the ways in which libraries process serials. In her 1997 article, **Ann W. Copeland** notes a number of factors that confronted serials librarianship from 1980 to 1995, including the implementation of **AACR2** in 1981, proliferation of bibliographic utilities that provided MARC format data such as **OCLC** and **RLIN**, and retrospective conversions undertaken as a part of the transition from print to online catalogs.¹

Still more changes have had an impact on the ways in which libraries process serials since the mid-1990s. Most notable is the proliferation of e-journals in the wake of the development of the World Wide Web in 1994. E-journals and databases that provide access to electronic versions of journal articles now account for a considerable and growing portion of library expenditures and subscriptions. At the author's institution, over three quarters of the journal titles to which the **Miami University Libraries** provide access have at least some issues available electronically. A cursory review of journal literature or **SERIALST** postings reveals challenges associated with these resources that include:

- **Check-in and claiming** — libraries must decide if and how they will check in e-journals and deal with failure to provide timely access. Availability of products with embargos that may last from a few months to several years complicates this process.
- **Determining holdings** — libraries are no longer in the driver's seat for initiating and terminating subscriptions; aggregators may add or remove access

to individual titles or entire collections of titles.

- **Centralized access points** — faculty and students used to be able to walk into libraries and see what titles were available, and in many cases browse through areas devoted to current issues. As the number of titles available electronically overtakes the number of print titles, libraries are struggling with ways to present a similar sense of available titles, and current issues in particular. The use of markup languages and metadata offers one method of meeting this need.

Possible Approaches

In the past decade, as many of the changes noted in **Copeland's** article have now become old hat and the proliferation of e-journals has accelerated, how have positions with a serials emphasis changed?

Any attempt to provide a snapshot of position responsibilities entails certain risks and benefits. Relying on self-reported surveys about duties and the amount of time devoted to them presents several difficulties. The age of info-glut, particularly in email, provides formidable obstacles to obtaining a reliable and balanced sample. In addition, while obtaining self-reported results may provide enlightening or provocative comments, self-reported information is by nature subjective and unreliable, since it is inherently difficult to specify what tasks we do and to quantify the time devoted to them—particularly if trying to make a comparison over an extended period of time.

Relying on a sample of position descriptions can be tricky as well. In addition to the challenge of gathering a representative sample, the accuracy of position descriptions is variable in quality. Position descriptions may not be updated frequently while the position is occupied.² Moreover, significant re-writes are more likely to occur when the position is vacant, because vacant positions provide the opportunity to re-envision what the position does and what qualifications are needed for that position independent of the interests, strengths,

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